UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

S.M.R INNOVATIONS LTD and Y.M.R TECH LTD,

Patent Owners.

IPR2024-01048

U.S. Patent 10,547,648

PATENT OWNERS' SURREPLY

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PATENT OWNERS' EXHIBIT LIST

Exhibit Number	Description
2001	Second Amended Complaint, Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)
2002	Notices of Deposition of Petitioner's Witnesses in Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)
2003	Notices of Deposition of Patent Owners' Witnesses in Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)
2004	Docket Sheet for Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)
2005	Patent Owners' Preliminary Infringement Contentions in Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)
2006	Petitioner's Invalidity Contentions in Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)

2007	Scheduling Order in Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)
2008	Joint Claim Construction Statement in Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)
2009	Declaration of Karl Ginter
2010	National Center for Education Statistics, Degrees in engineering and engineering technologies conferred by postsecondary institutions, by level of degree and sex of student: Selected years, 1949-50 through 2013-14
2011	National Center for Education Statistics, Degrees in computer and information sciences conferred by postsecondary institutions . . . 1964-65 through 2018-19
2012	Excerpts from the Declaration of Dr. Nathaniel Polish in Support of Defendant Apple Inc.'s Opening Markman Brief, *S.M.R Innovations LTD & Y.M.R Tech LTD v. Apple Inc.*, 6:23-cv-00479-ADA (W.D. Tex.), Dkt. 71-1

2013	Excerpts from the transcript of the deposition of Dr. Nathaniel Polish, conducted in connection with *S.M.R Innovations LTD & Y.M.R Tech LTD v. Apple Inc.*, 6:23-cv-00479-ADA (W.D. Tex.)
2014	Excerpts from *The Cambridge Grammar of the English Language*, Cambridge University Press, Cambridge, UK (2002)
2015	Excerpts from IEEE standard 802.15
2016	Technical Overview, HomeRF Working Group (available at https://www.cazitech.com/Technical%20HomeRF%20Overview.htm)
2017	"Transcoding free voice transmission in GSM and UMTS networks," Stan Sančin, Grega Jakus, Sašo Tomažič, International Conference on Information Society 2011 (available at https://www.eventiotic.com/eventiotic/files/Papers/URL/a0f286ed-6b5d-471a-8f8d-d38bf2728af7.pdf)
2018	Declaration of Cortney S. Alexander

2019	Deposition Transcript of Dr. Sayfe Kiaei

I. Petitioner Fails to Cure the Deficiency in Its Original Combination

The Petition acknowledged that Zhang did not disclose routing a phone call over a local wireless network. Petition, 18. The Petition relied on Pasanen "exclusively to teach the specific use case of receiving a phone call on *Zhang's* cellular phone and passing it through to an audio helper server, or speaker." Reply, 15. The Petition relied on Fillebrown only for its teaching of a central routing device. *Id.*, 15 n.4. Together, the Petition asserted that Zhang-Pasanen-Fillebrown could receive a cellular phone call on Zhang's cellular phone and route it over a local wireless network to another device. Petition, 28, 30-32.

PO's Response explained that Petitioner failed to carry its burden to establish obviousness because, *inter alia*, it failed to establish "why the prior art references would have worked together" (*Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013), and "*how* any specific combination would operate" (*ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012)). Conclusory expert testimony is not sufficient to prove that a POSITA would have been motivated to combine references to achieve the claimed inventions—such an approach "is not sufficient and is fraught with hindsight bias." *Id.* This deficiency applies to Petitioner's arguments on all challenged claims.

Petitioner's Reply only exacerbates the Petition's problems, further demonstrating that Petitioner's flawed, hindsight combination fails to prove the challenged claims obvious. Indeed, Petitioner's expert abandoned a key aspect of his

testimony during his deposition on his supplemental expert declaration, leaving Petitioner's explanation of how its proposed combination would supposedly operate entirely unsupported by record evidence.

A. Petitioner Incorrectly Characterizes PO's Argument as being Grounded in Enablement

Petitioner's Reply did not address any of the cases PO cited regarding the requirement that "a finding of obviousness at the time of invention requires a plausible rational [sic] as to why the prior art references would have worked together." *Broadcom*, 732 F.3d at 1335 (quot. omitted). PO, supported by its expert's testimony, pointed out why the cited references would ***not*** have worked together to accomplish the functionality that Petitioner attributed to the proposed combination. PO Response, 26-35.

The Board should reject Petitioner's effort to dodge the issue by characterizing PO as arguing that "the proposed combination is not enabled." Reply, 17. None of the cases PO cited turned on non-enablement. Likewise, the Board should reject Petitioner's argument that the Petition described the proposed combination in as much detail as the challenged patent. First, the '648 patent's enablement is not before the Board. Second, Petitioner is wrong that the Petition describes the relevant functionality in as much detail as the '648 patent. The '648 patent describes routing an incoming phone call from a cellular phone over a local wireless network. And the '648 patent discloses transforming media to accord with the requirements of a

receiving device, including via a media transformer. *See* Reply, 17 n.5 (citing '648 patent). None of Petitioner's references include such disclosure, and the Petition did not endeavor to fill the gap.

Petitioner is not helped by *Uber Techs., Inc. v. X One, Inc.* because there the challenger's secondary reference actually disclosed the functionality that the challenger proposed to incorporate into the primary reference. 957 F.3d 1334, 1340 (Fed. Cir. 2020). Here, as PO's expert testified, neither Zhang nor Pasanen disclosed the necessary equipment to provide the functionality that Petitioner attributes to the proposed combination. Nor did the Petition cite other references as "glue" to hold the proposed combination together. *InTouch Techs., Inc. v. VGo Communs., Inc.*, 751 F.3d 1327, 1348 (Fed. Cir. 2014). Neither does *Omega Liner Co., Inc. v. Buergofol GMBH*, IPR2023-01372, Paper 85 (Mar. 14, 2025), support Petitioner. There, the Board noted that the reference in question "employ[ed] essentially the same materials … for essentially the same purpose" as the challenged patent. *Id*., 47. That is not the case here. Nothing in Zhang, Pasanen, or Fillebrown discloses receiving a cellular call on a mobile phone and routing it to another device over a local network.

B. Petitioner's New Arguments Highlight the Flaws in Its Proposed Combination

Seeking to cure the Petition's shortcomings, Petitioner newly argues that Zhang's existing (i.e., unmodified) cellular phone implemented several optional features of the HomeRF specification. Reply, 15. Specifically, Petitioner argues that

Zhang discloses an isochronous HomeRF network that implemented DECT to route phone calls between Zhang's cellular phone and helper servers, with Zhang's cell phone constituting the "control point" required to manage HomeRF isochronous networks. Reply, 15, 20-22; EX1037, ¶¶14-19.

As purported support, Petitioner newly introduces the HomeRF specification and the Negus reference. Any effort to add these references into Petitioner's obviousness combination would violate IPR procedures. *See DexCom, Inc. v. WaveForm Technologies, Inc.*, IPR2016-01680, Paper 46, 30-31 (PTAB Feb. 28, 2018).

Further, the HomeRF functionality that Petitioner now attempts to read into Zhang were optional HomeRF features that were not required to implement Zhang's functionality. Zhang does not describe handling interactive voice over a HomeRF network in a way that would require the optional HomeRF features identified in Petitioner's Reply. Zhang uses the term "HomeRF" a single time. EX1004, 4:58. There is no warrant to read all these optional features into Zhang.

1. Zhang does not describe an isochronous HomeRF network

Zhang makes no reference to an *isochronous* HomeRF network. HomeRF can be implemented as either an asynchronous or an isochronous network. EX1038, 199 (disclosing that one HomeRF implementation is "an ad-hoc network" that "support[s] only asynchronous data service"); EX2019, 22:22-26:1, 62. Even Petitioner's expert agreed that a HomeRF network could be implemented without

isochronous nodes ("I-nodes"). EX2019, 36:2-13. And as Petitioner's expert also agreed, the HomeRF specification plainly states that an A-node does ***not*** have to provide the capabilities of an I-node. EX1038, 47; EX2019, 17:11-24. The HomeRF specification expressly states that it "supports many features, some of which are optional." EX1038, 29.

Zhang's failure to disclose an isochronous network is unsurprising because Zhang does not disclose routing phone calls from a mobile device to a helper device. Zhang would not have needed an isochronous network to provide the data-routing functionality it discloses. The HomeRF specification states that the isochronous mode is used mainly to carry interactive voice, whereas the asynchronous mode is used for data. EX1038, 41. Since HomeRF's isochronous mode is primarily used for interactive voice, the isochronous mode would not be necessary to practice Zhang's subject matter. Instead, HomeRF's asynchronous mode would suffice—the HomeRF specification expressly states that it is used for data service. EX1038, 41. Indeed, Zhang's depiction of its "helper environment" in Figure 1 is consistent with Negus's depiction of an *asynchronous* HomeRF network:

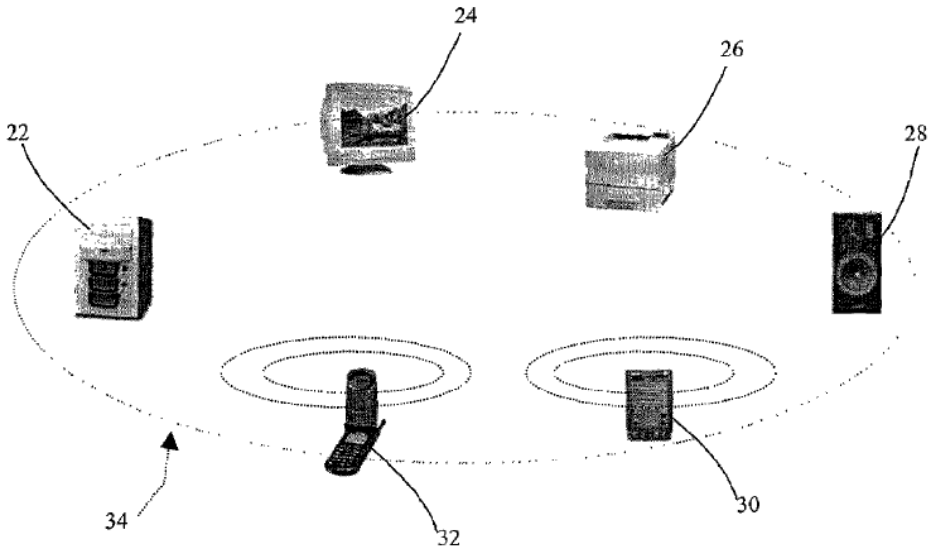


Fig. 1 A Helper Environment

EX1004, Fig. 1; EX1039, 2 (describing the ability of asynchronous devices to communicate without requiring a control point).

2. Zhang does not disclose that its cellular phone can manage DECT communications (or landline calls)

Zhang also provides no support for Petitioner's new assertion that Zhang's cellular phone and helper servers implement the DECT protocol. Reply, 21; EX1037, ¶19. DECT would not be required to implement Zhang's functionality.

The HomeRF specification states that DECT may *optionally* be used to receive a call over the public switched telephone network (PSTN), that is, a landline network, and route it through a control point over an *isochronous* HomeRF implementation. EX1038, 55, 63; EX1039, 4 (stating that HomeRF could use "a subset of the Digital Enhanced Cordless Telecommunications (DECT) standard" to

"***interoperate with the PSTN***"); EX2019, 7:19-25, 8:23-10:10, 60.

Zhang does not mention DECT. Nor does Zhang disclose receiving phone calls over a connection to the PSTN (i.e., landline) telephone network, much less that its *cell phone* could somehow provide a *landline-phone* connection and route landline calls. Thus, there is no basis to simply assume that Zhang's cellular phone or Zhang's helper servers would have utilized HomeRF's optional DECT implementation for routing landline phone calls.

3. Zhang does not disclose the control point required to manage a HomeRF isochronous network

Zhang does not disclose a HomeRF control point, which is an essential device in a HomeRF isochronous network. The HomeRF specification states that a Class-1 Connection Point is required to manage I-nodes. EX1038, 41 (stating that isochronous service "[r]equires the presence of a Connection Point"). A Connection Point is "[a] HomeRF node capable of providing control-point services." *Id.*, 32. The control point "assigns [the isochronous clients] guaranteed bandwidth for bounded latency communication." EX1039, 2.

Zhang says nothing about a control point to implement its invention using HomeRF, undermining Petitioner's assertion that Zhang necessarily discloses a HomeRF isochronous network capable of routing interactive voice. Nothing in Zhang's Fig. 1 shows the presence of a HomeRF control point. This omission in Zhang's Figure 1 (and the remainder of its disclosure) is consistent with an

asynchronous HomeRF implementation. Both the HomeRF specification and Negus state that a control point is unnecessary for data-only service like that Zhang actually discloses. EX1038, 41, 32; EX1039, 2.

Petitioner's supplemental expert declaration asserted that Zhang's cellular phone was this type of control point (i.e., one that manages I-nodes). EX1037, ¶¶12, 15, 17, 19 (identifying Zhang's mobile device as a HomeRF control point); Reply, 21 (citing EX1037, ¶19). However, during his deposition, Petitioner's expert testified that this aspect of his declaration was erroneous. EX2019, 33:20-22, 37:7-20. He rightly abandoned that assertion—it is clear that Zhang's cellular phone could not meet the HomeRF specification's requirements for a control point.

The HomeRF specification says that such a Class-1 control point would provide connectivity to a PSTN and a host PC. EX1038, 48. Zhang's cellular phone is not connected to a PSTN (that is, a traditional landline telephone system (EX1038, 30, 429), either directly or through a Host PC.

Next, while the HomeRF specification teaches that a control point could either be integrated into a Host PC or be a separate device (EX1038, 59), in either case, the control point *must* provide a connection to a host PC. EX1038, 48 ("It provides connectivity to … a host PC"). Zhang's cellular phone is not described as being connected to a host PC. Nor does Zhang's cellular phone itself constitute a "PC," as that term was used in the HomeRF specification and the relevant period. *See* EX1038, 40.

Zhang's cell phone also fails to satisfy other requirements of a HomeRF control point. For example, the HomeRF specification states that an "integrated CP [i.e., one that is integrated into a PC] is still required to support mandatory CP procedures, ***even when the PC appears to be switched off***. Refer to section 12.7."). EX1038, 59 (emphasis added). Those mandatory operations include, for example, handling incoming and outgoing calls, power-management support, and connection point negotiation. *Id.*, 431-32. Zhang does not describe that its cellular phone possessed any such capability when powered on, much less when powered off. Moreover, it would make no sense to use a cell phone as a connection point in an isochronous HomeRF network because the entire network would collapse when the cell phone's owner carried it away from the environment where the network was located because the control point is required to manage the network. EX1039, 2; EX2019, 33:8-20.

A HomeRF control point also must be capable of assigning timeslots to other devices to provide them guaranteed bandwidth for bounded latency communication in a TDMA scheme. EX1038, 55, 274-75; *see also* EX1039, 2-3. Zhang does not disclose that its cellular phone provided such capability. Nor was there any reason for it to do so. The HomeRF specification indicates that this functionality is primarily for interactive voice service, and Zhang does not disclose that its cellular phone can route phone calls to another device. So Zhang's cellular phone would not need this capability of a HomeRF control point.

During the deposition of Petitioner's expert, he retracted his declaration's assertion that Zhang's cellular phone was a HomeRF control point. He referred to his identification of Zhang's cellular phone as the control point in both Paragraphs 12 and 19 of his supplemental declaration as an error and stated that it should say simply "HomeRF." EX2019, 33:20-22, 37:7-20. But that "correction" is nonsensical—it makes no sense to say that the control point in an isochronous HomeRF network would be "HomeRF." The control point is a specific device that manages a HomeRF network. EX1039, 3. Now that Petitioner's expert has abandoned his position that Zhang's cellular phone was a HomeRF control point, Petitioner is left without any contention that Zhang discloses the control point required to manage an isochronous HomeRF network capable of handling interactive voice. Again, Zhang's silence makes sense because it is undisputed that Zhang does not disclose routing phone calls. It had no need for a Class-1 HomeRF control point.

For the foregoing reasons, the Board should reject Petitioner's new effort to read into Zhang's cellular phone and its helper servers all the optional functionality of the HomeRF specification for handling interactive voice. *See In re Rijckaert*, 9 F.3d 1531, 1533-34 (Fed. Cir. 1993) (BPAI erred in finding that functionality was implicitly taught by a prior-art reference based on assertion that the functionality was known in the art as an optimal condition).

II. Claims 1 & 15 Require Signaling a Device that was Identified as Available

A. Petitioner's Argument Ignores the Plain Language of the Claims

Petitioner wrongly states that "a natural read of the [claim] language covers a mobile device signaling a device indicating available media content and the device's [subsequent] response indicating it is available to handle the media." Reply, 2-3. This argument disregards the express language of claim 1(d) and disconnects it from the context of the claims, including claim 1(b). The flow and logic of claim 1 demonstrate that claim 1(d) requires signaling the specific one or more devices that the mobile device identified as available. The same is true of claim 15.

B. The Specification's Scenario 3 Does Not Support Petitioner

PO's Response noted that the specification describes a mobile device identifying an available receiving device before selecting a device to receive content or taking action to route a phone call, citing the specification's Scenario 3B. EX1001, 11:61-67. Petitioner's argument that this example does not specify *how* the mobile device identified the nearby phone as available is irrelevant. Petitioner does not dispute that Scenario 3B describes identifying an available device before the mobile device takes any action regarding available content (e.g., signaling the nearby device about that content).

Petitioner's argument that Scenario 3A somehow supports its position is also misplaced. In this example, a mobile phone detects that a first nearby device is busy, then detects that a second nearby device is available, and finally routes the call to

that available device. EX1001, 11:46-60. Petitioner wrongly argues that "[b]ecause this example signals a device before identifying it as available, it directly contradicts PO's ordered steps theory." Reply, 4. Petitioner apparently asserts that claim 1(d) is satisfied in Scenario 3A by the person pointing his cell phone at a nearby device and the cell phone detecting that the nearby device is busy. That assertion fails because detecting that the nearby device is busy does not involve the cell phone signaling that busy device about the availability of media content (as required by claim 1(d)).[1]

C. The Prosecution History Confirms PO's Position

Petitioner ignores the context of the inventors' amendment during prosecution in arguing that the amendment has nothing to say about the relationship between claims 1(b) and 1(d) or claims 15(b) and 15(d). The Examiner asked the inventors to clarify whether claim 1(d) and the similar limitation in claim 15 referred to "the one or more available devices [recited earlier in the claim] or ***different one or more devices***." EX1002, 240 (emphasis added). In response, the inventors stated that they "amended the claim to recite '*one or more available devices*' and ***not 'one or more***

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[1] Petitioner's observation that PO's expert agreed in deposition that Scenario 3A is consistent with the claim is of no moment. Scenario 3A *is* consistent with claim 1; the cell phone detects an available device before signaling the device about media content.

devices.'" EX1002, 261 (emphasis added). The inventors' response also applied to claim 15. *Id.*, 262.

The inventors' amendment confirms that the wireless signaling of claim 1(d) is directed specifically at the one or more available devices identified in claim 1(b). If the inventors intended claim 1(d) to encompass signaling devices about the availability of media content before identifying availability, it would have made more sense to amend the claim to simply recite "wirelessly signaling one or more devices." The inventors expressly rejected that approach. PO's expert testified that based on the inventors' comments, a POSITA would have shared PO's interpretation of this claim language. EX2009, ¶¶37, 41.

D. Claim 1(d)'s Reliance on Claim 1(b) for Antecedent Basis for "the One or More Available Devices" Supports PO

Petitioner concedes that binding precedent holds that antecedent basis can be useful when determining a logical order. Reply, 5. While Petitioner mischaracterizes PO's argument as advocating a "simple" antecedent-basis test, PO actually explained that antecedent basis, the flow of the claim, the specification, the prosecution history, and PO's expert testimony collectively warrant PO's position.

Petitioner makes no effort to distinguish much of the case law discussed in PO's Response, including *Meade Instruments Corp. v. Yamcon, Inc.*, 197 Fed. Appx. 929, 933-34 (Fed. Cir. Aug. 25, 2006); *Warner-Lambert Co. v. Apotex Corp*., 316 F.3d 1348, 1356 (Fed. Cir. 2003); *Mformation Techs., Inc. v. Research in Motion*

Ltd., 764 F.3d 1392, 1398 (Fed. Cir. 2014); and *Function Media, L.L.C. v. Google Inc.*, 708 F.3d 1310, 1320 (Fed. Cir. 2013).

And where Petitioner did address PO's cases, it simply rehashed arguments that PO's Response refuted. Specifically, Petitioner argues that in both *Hytera* and *Wi-Lan*, "sequencing was inherent because the method steps recited an exclusive one-to-one relationship between elements in two different steps." Reply, 6. But as PO's Response explained, nowhere did *Hytera* indicate that its holding depended on a conclusion that the two steps—"preparing to transmit a particular payload type in a timeslot" and "determining whether the timeslot is a current desired timeslot for the TDMA system"—recited an exclusive one-to-one relationship. *Hytera Communs. Co. v. Motorola Sols., Inc.*, 841 Fed. Appx. 210, 218 (Fed. Cir. Jan. 19, 2021). Petitioner's Reply does not show otherwise. Rather, *Hytera's* express language indicated that the Federal Circuit considered antecedent basis key to its interpretation. The court rejected the argument that "the antecedent basis is not meaningful," holding that "the fact that the 'determining step says 'the' when it could have said 'a' reinforces our conclusion that it is meant to come after the 'preparing' step." *Id.*

Similarly, as PO's Response explained, nowhere did *Wi-Lan* indicate that it would be impossible for the steps to be performed in the opposite order (absent antecedent basis). *See Wi-Lan, Inc. v. Apple Inc.*, 811 F.3d 455 (Fed. Cir. 2016). In fact, the Federal Circuit examined the specification to determine whether it "depicts

or discusses the possibility of combining before randomizing," showing that it believed this was at least possible. *Id.* at 462. Petitioner failed to dispute that *Wi-Lan's* conclusion relied heavily on antecedent basis. *Id*.

The one case Petitioner cites, *Apple Inc. v. Seven Networks, LLC*, No. IPR2020-00156, Paper 10 (PTAB June 15, 2020), involved much different facts. In *Seven Networks*, there was no meaningful argument that step 11.5 had to be performed after steps 11.3 and 11.4. *Id.* at 32. In contrast, here, the logical reading of "wirelessly signaling the one or more available devices" is that it refers to the one or more available devices that had already been identified. This is confirmed by the inventors' express statements in response to the Examiner's question.

Seven Networks also discussed additional cases in which the Federal Circuit *did* find that claim language mandated an order. Those cases support PO. This includes, for example, *E-Pass Techs., Inc. v. 3Com Corp.*, 473 F.3d 1213 (Fed. Cir. 2007). *E-Pass* held that the claim required steps to be performed in an order where the steps "refer to the completed results of the prior step," such as "transferring a data set …; [and] storing *said transferred* data set." *Id.* at 1222. Likewise, the '648 patent's claim 1(d) refers to the completed results of claim 1(b).

E. Petitioner's Argument Regarding the Antecedent Basis for "Media Content" is Misplaced

Petitioner tries to distract from the issue by arguing that claim 1 is "confusing" in its use of antecedent basis for the term "media content." The antecedent basis for

"media content" does not impact whether the logical flow of claim 1(b) and 1(d)—and of claim 15(b) and 15(d)—indicates that the one or more available devices that are wirelessly signaled are the one or more available devices that were identified by the mobile device.

Moreover, Petitioner fails to establish that claim 1(d)'s reference to "an availability of a media content at the mobile device" must be "the same media content" referenced in the preamble. As Petitioner acknowledges, claim 1(d)'s reference to "a media content" does not rely for antecedent basis on the preamble's reference to media content. Therefore, "a media content" in claim 1(d) need not be the same media content referenced in the preamble. Consistent with the deposition testimony of PO's expert referenced by Petitioner, it is entirely logical that the preamble refers to the invention's intended purpose—allowing a mobile device to inform another device about availability of media content (e.g., phone calls)—whereas claim 1(d) refers to informing the device about specific media (e.g., a particular incoming call). Petitioner does not show any implausibility in this interpretation.

III. Petitioner's Combination Fails to Account for Claims 1(d) and 15(d)

The Petition failed to establish that the proposed combination satisfies claim 1(d) and claim 15(d) because the alleged wireless signaling by Zhang relied on by the Petition occurs before Zhang has identified the signaled devices as available. Petitioner's Reply mischaracterizes Zhang by stating that Zhang's "'service query'

step queries whether the identified devices are free and available to service the request." Reply, 9. That is wrong. It is only in Zhang's later "service request" step that a device is queried about its availability to service a request. PO Response, 20-21 (citing EX1004, 7:22-25, 7:58-60).

A. Claim 1(b) and Claim 15(b) Require Identifying a Device as Available

Petitioner now argues that claim 1(b) and 15(b) merely require identifying devices and some of them might happen to be available. That is not how the Petition interpreted this language. Petition, 15. The claim language specifically recites identifying *available* devices. It is not satisfied by identifying a device that is unavailable. Petitioner's self-serving attempt to salvage its obviousness combination should be rejected.

PO's Response submitted evidence from the Cambridge Grammar of the English Language showing that there is no meaningful difference between "identifying one or more available devices" and "identifying one or more devices as available." PO Response, 15-17; EX2014, 528. Petitioner provides no responsive evidence, relying instead on attorney argument that PO's evidence is irrelevant because, supposedly, "in the phrase 'identifying one or more devices as available, '*available* acts upon the verb *identifying*." Reply, 11. This assertion is inconsistent with basic precepts of English grammar (and the only record evidence). EX2014, 4. As PO's evidence demonstrated, the word "available" is an adjective under either

phrasing. Contrary to Petitioner's naked assertion, an adjective does not "act on" a verb. "Available" is an adjective that modifies the noun that follows it (i.e., "devices"). *In re Cray Inc.*, 871 F.3d 1355, 1362 (Fed. Cir. 2017) (observing that in the phrase "regular and established place of business," "'regular' and 'established' are adjectives modifying the noun 'place'"); *Wis. Cent. Ltd. v. United States*, 585 U.S. 274, 277-78 (2018) (in the phrase "money remuneration," "the adjective 'money' modifies the noun 'remuneration.' So 'money' limits the kinds of remuneration that will qualify for taxation").

Petitioner's reliance on the '648 patent's Scenario 3A is unavailing. Petitioner argues that "[b]ecause this example involved signaling a device before identifying it as available, it aligns with the Board's interpretation." Reply, 12. Not so. In Scenario 3A, the mobile phone identifies a nearby device as unavailable. As Petitioner concedes, it then identifies a different device that ***is*** available before routing the call to that device. EX1001, 11:46-60. This is consistent with PO's interpretation of the claim—the mobile phone identifies a device that is available before taking action regarding available content.

Petitioner appears to suggest that Scenario 3A satisfies claim 1(d) by signaling a device before identifying it as available. Reply, 15. That is not the case. Claim 1(d) requires signaling the one or more available devices about an availability of a media content at the mobile device. In Scenario 3A, the mobile phone's action in identifying whether a nearby device is busy or available does not involve signaling

that nearby device about an availability of media content. As Petitioner acknowledges, it is only after the mobile device determines that a nearby device is available that it signals that device about the phone call.

B. Petitioner Fails to Justify the Institution Decision's Alternative Mapping

Petitioner also fails to justify the Institution Decision's preliminary conclusion that Zhang satisfies claims 1(d) and 15(d) even under PO's interpretation. That aspect of the Institution Decision relied on a mapping of Zhang to the claim language that Petitioner did not rely on. PO Response, 23-24. Petitioner's Reply does not contend otherwise.

While Petitioner argues that a petitioner must be allowed to respond to a new claim construction adopted by the Board or proposed by the patent owner, Petitioner does not address the binding precedent (1) observing that the Federal Circuit has "reprimanded the Board for finding a claim unpatentable based on theories not presented in the petition" (*Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1377 (Fed. Cir. 2023)); and (2) rejecting the proposition that "the Board is free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR" (*In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016)). That other cases have held that a petitioner, in limited circumstances, can present argument in response to a new proposed construction does not somehow broaden the Board's authority as proscribed by Federal-Circuit precedent.

Moreover, Petitioner too broadly describes its ability to present new theories on reply. First, Petitioner concedes that it *does not actually agree* with the alternative interpretation; instead, it continues to believe its original interpretation is correct. Reply, 13. Second, there is no reason Petitioner could not have presented an argument under this interpretation in its Petition. Third, a petitioner's ability to respond to a patent owner's arguments does not relieve the petitioner of its obligation to identify its proposed theories of invalidity *in the petition*. The "governing regulation states that a Petition must identify '[t]he supporting evidence relied upon to support the challenge *and the relevance of the evidence to the challenge raised*, including identifying specific portions of the evidence that support the challenge.'" *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1368 (Fed. Cir. 2015) (quoting 37 C.F.R. § 42.104(b)(5)) (emphasis added). Thus, the Federal Circuit has affirmed the Board's refusal to consider a reply argument that depended "on previously unidentified portions of a prior-art reference to make a meaningfully distinct contention." *Id.* at 1367. That is what Petitioner attempts to justify here (but even worse, Petitioner does not agree with the claim interpretation underlying its new contention).

C. Petitioner Incorrectly Tries to Attribute a New Construction of "Available" to PO that Petitioner Itself Disagrees With

Petitioner makes a last-ditch effort to attribute to PO a construction of "available" that PO never proposed and that Petitioner explicitly disagrees with.

Reply, 13. This is the same sort of shenanigans that Petitioner attempted in IPR2024-01049 and IPR2024-01050. The Board properly rejected Petitioner's tactic in those proceedings, and it should do so here. *See, e.g., Apple Inc. v. S.M.R Innovations LTD*, IPR2024-01049, Paper 8 at 11-13 (PTAB Jan. 27, 2025).

As an initial matter, Petitioner confusingly states that "[t]he Petition construed 'available' to mean 'devices that are free and able to receive a routed signal' consistent with the position taken in litigation, and the Board adopted this interpretation in the ID." Reply, 13. The Petition's Claim Construction section states that "Petitioner applies the plain and ordinary meaning" to all terms. Petition, 4. PO took the same approach, consistent with its litigation position. EX2008, 2. The Institution Decision stated that "[t]he parties do not propose any express claim construction" and determined that no express construction was necessary "apart from that discussed in our below analysis." Institution Decision, 10. Nowhere did the Institution Decision indicate that the Board applied anything other than plain meaning for "available." While PO argued that claim 1(d) and 15(d) required signaling the one or more available devices that were identified as recited in claim 1(b) and 15(b), that argument (responding to the unpatentability arguments raised in the Petition) relied on the plain meaning of "available." Likewise, while PO submitted expert testimony in support of its argument, PO's expert did not opine on the construction of "available."

During the deposition of PO's expert, Petitioner's counsel repeatedly asked

him about the meaning of the term "available," notwithstanding the objections by PO's counsel that it was outside the scope of his direct testimony. *See, e.g.,* EX1036, 73:3-76:6. PO's expert also affirmed in his deposition that he had not offered a construction for the term "available." *Id.*, 105:7-9. And Petitioner's counsel stated in response to PO's objections that he was "not asking [PO's expert] to define 'availability' with these questions." EX1036, 76:1. While Petitioner now endeavors to present this deposition testimony as having been adopted by PO as a construction of "available," it can provide no citation to PO adopting a construction based on that testimony. To the contrary, PO's counsel objected to that testimony as outside the scope of direct testimony. And, as Petitioner itself acknowledges, it disagrees with the construction it now attempts to attribute to PO. Reply, 13-14. The Board should disregard and reject this naked gamesmanship.

IV. Claim 5

Petitioner does not meaningfully dispute that its original section on claim 5 failed to account for claim 5's recitation. Instead, it now presents a new theory for how Zhang allegedly satisfies claim 5. Notably, Petitioner's Reply does not cite the Petition's original discussion of claim 5 (or the passages of Zhang cited therein). The Board should reject this new, untimely theory. *See In re Magnum Oil*, 829 F.3d at 1380.

While Petitioner tries to justify its citation to its 23-page analysis of claim 1, it ignores the case law cited by PO condemning similar efforts. *See Apple Inc. v.*

ContentGuard Holdings, Inc., IPR2015-00440, Paper No. 13 at 5 (PTAB Dec. 21, 2015) (rejecting internal cross-reference to 16-page section of petition). The one case Petitioner cites involved disparate facts. In *Bruker Spatial Biology, Inc. v. 10X Genomics, Inc.*, IPR2024-00526, Paper 14, 23 (PTAB Aug. 23, 2024), the petition addressed three dependent claims (claims 56, 67, and 68) by providing pinpoint citations to two other specific claim elements (not to an analysis of an entire independent claim). The two cross-referenced sections each constituted about one page of text. *See Bruker Spatial Biology, Inc. v. 10X Genomics, Inc.*, IPR2024-00526, Paper 2, 29-30, 40-41, 45, 51-52, (PTAB Jan. 30, 2024). That is hardly comparable to what Petitioner did here.

V. Claim 6

Petitioner relied on its combination of Zhang-Fillebrown-Pasanen for claim 6. In discussing claim 8 (for which it introduced Rofheart into the combination), Petitioner asserted that "*Zhang-Fillebrown-Pasanen* would have been modified per *Rofheart's* teachings to select a device to route the phone call to (e.g., wireless audio interface)." Petition, 60. Thus, Petitioner admitted that its proposed combination of Zhang-Fillebrown-Pasanen did not have this capability. Yet its argument that Zhang-Fillebrown-Pasanen would have provided a user the ability to choose to route a call while it is ongoing necessarily depends on the user having this very control. *See* Petition, 33.

While Petitioner's Reply briefly references Zhang's seamless-mobility

embodiment, PO's expert testified that the seamless-mobility embodiment refers to transitioning between helper servers *without user invention*. Reply, 42; EX2009, ¶¶90-91. Petitioner's Reply provides no response to that testimony.

Moreover, the Reply wrongly asserts that the Petition established that Zhang requires routing an ongoing phone call. Petitioner has conceded that Zhang does not disclose routing a phone call at all, much less routing an ongoing phone call. Petition, 18, 30. Instead, as PO's Response explained, Petitioner effectively relied on "common sense" to modify Zhang-Pasanen-Fillebrown to include functionality not provided in any of those references. PO cited Federal Circuit law observing that common sense typically cannot "supply a missing claim limitation." *Avendi S.A.R.l. v. Apple Inc.*, 832 F.3d 1355, 1361 (Fed. Cir. 2016). Petitioner provides no response.

VI. Claim 19

Petitioner admits that under its proposed combination, "*Zhang's* audio helper device is modified pursuant to *Skinner* such that a user is informed (e.g., via ringing) ***when the call is routed from Zhang's mobile device***." Reply, 25 (emphasis added). This is not what claim 19(d) requires: "third program instructions executable by the processor to inform the user of said device about ***an availability of a media content at the mobile device*** with one or more of the following: flash light, ring, and play a loudspeaker sound." EX1001, 14:46-50 (emphasis added). Petitioner's own description of its combination demonstrates that the ringing indicates that ***the call is already available at the helper device***; not the mobile device. Thus, its proposed

combination does not satisfy claim 19(d).

Dated: September 15, 2025 Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), Patent Owners certify that the foregoing Patent Owners' Response contains 5,584 words, excluding the portions exempted by 37 C.F.R. § 42.24(a)(1), as measured by the word-processing software used to prepare the document.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a) and (b), I certify that on the date indicated below, a true and accurate copy of the foregoing document was served on the following counsel for Petitioner via e-mail, pursuant to Petitioner's consent to e-mail service:

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