

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED,
Petitioner

v.

NETWORK SYSTEM TECHNOLOGIES, LLC,
Patent Owner

Case: IPR2024-01081
U.S. Patent No. 7,373,449

**PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE**

TABLE OF AUTHORITIES

Cases

<i>Allen Med. Sys. Inc. et al. v. Mizuho Orthopedic Sys, Inc.</i> , IPR2022-00919, Paper 12 (PTAB Nov. 2, 2022)	3
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37 C.F.R. § 42.104	2, 3, 4
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Petitioner files this Reply pursuant to email authorization of August 2, 2024.

Patent Owner (“PO”) argues that the Board should deny institution because the claim construction of “communication manager” Petitioner agreed to apply in this IPR is “inconsistent” with Petitioner’s district court argument that the term is indefinite. Paper 9 at 22-24. This argument fails for at least three reasons.

First, PO is not even arguing that the term needs construction in this IPR. Paper 9 at 17 (PO stating “the Board need not decide whether ‘communication manager’ is governed by § 112”); Paper 9 at 16 (citing PO district court contentions (Ex-1032) stating “communication manager” is “not subject to Section 112, ¶6”). “The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019). Here, there is no controversy requiring resolution, as the Board recognized in the Samsung IPR. IPR2024-00338, Paper 10 at 22-23.

Second, PO erroneously contends that “in this proceeding, Qualcomm states that it disagrees with [the Samsung IPR] claim construction.” Paper 9 at 23. That is not correct. Petitioner Qualcomm expressly stated that for the purpose of this IPR it “agrees” to the claim constructions applied in the Samsung IPR. Petition at 16.

Third, there is nothing improper about Petitioner maintaining its argument *before the district court* that a claim term is indefinite. The Board has repeatedly

held that a Petitioner’s district court indefiniteness argument (an argument that cannot be raised in an IPR) is not a reason to deny institution. *E.g., Dish Network LLC et al. v. Digital Broadcasting Solutions, LLC*, IPR2023-00976, Paper 8 at 7-9 (PTAB Dec. 11, 2023) (instituting review, explaining that “[e]ven if Patent Owner argues that Petitioner has asserted that certain claims are indefinite in the related litigation, Petitioner is nonetheless adopting Patent Owner’s interpretations as the basis for requesting review of the challenged claims here”); *Hospira, Inc. et al. v. Amgen Inc.*, IPR2021-00528, Paper 7 at 6-10 (PTAB Aug. 17, 2021) (instituting review, rejecting a patent owner’s argument that the Petitioner’s district court indefiniteness positions mean it does not comply with the requirements of 37 C.F.R. § 42.104(b)(3) and explaining that “Petitioner’s willingness to adopt Patent Owner’s proposed constructions for purposes of this proceeding is sufficient to satisfy the requirements of § 42.104(b)(3)”); *Sony Elecs. Inc. v. Jawbone Innovations, LLC*, IPR2023-01352, Paper 9 at 47–48 (PTAB Mar. 7, 2024). Like in *Dish Network*, *Hospira*, and others, Petitioner here has “agree[d]” to adopt the constructions applied in the Samsung IPR as the basis for requesting review.

The only two cases PO cites are inapposite. In each of *Hologic* and *CareFusion*, the Petitioner did not expressly agree to apply the proposed constructions for the purpose of that IPR. *See Hologic*, IPR2018-00019, Paper 21 at 5-6; *CareFusion*, IPR2016-01456, Paper 9 at 7. As the Board has explained, a

petitioner is not required to advance a construction it explicitly agrees with, so long as it identifies a construction it agrees to apply in that IPR proceeding. *E.g.*, *Allen Med. Sys. Inc. et al. v. Mizuho Orthopedic Sys, Inc.*, IPR2022-00919, Paper 12 at 15-18 (PTAB Nov. 2, 2022) (distinguishing *Hologic* and *CareFusion*); *see also Western Digital Corp. v. SPEX Tech. Inc.*, IPR2018-00084, Paper 14 (PTAB Apr. 25, 2018) (distinguishing *CareFusion*).

Here Petitioner complied with 37 C.F.R. § 42.104(b) by “agree[ing] to apply the claim terms as applied in the Samsung IPR” for the purpose of this IPR. Petition at 16; *see also id.* at 35-38 and n.6. As the Board found in the Samsung IPR, the Petition explained that “‘the Board does not need to construe any claim term for purposes of evaluating the prior art,’ i.e., that ‘the claim terms require no express construction.’” IPR2024-00338, Paper 10 at 23. The Board also explained that Samsung asserts alternatively that if the Board determines § 112’s means-plus-function provision applies to “communication manager,” “its structure is ‘circuit’” identifies “‘the specific portions of the specification that describe the structure’ corresponding to the claimed function.” *Id.* at 24 (citing Samsung Petition at 33 n.3). Because Petitioner “agreed” to adopt and apply the constructions applied in the Samsung IPR, this Petition complies with Section 42.104(b) for the same reasons the Samsung Petition complies.

Dated: August 5, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing
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