

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

DH INTERNATIONAL LTD.,

Patent Owner.

PTAB Case No. IPR2024-01322

Patent No. 9,022,294

**PATENT OWNER'S PRE-INSTITUTION SUR-REPLY TO PETITIONER'S
PRE-INSTITUTION REPLY**

On January 10, 2025, the Board authorized Petitioner filing of a five-page reply to Patent Owner's Preliminary Response (POPR) and Patent Owner's filing of a five-page sur-reply addressing the construction of an "activation cue," "data conveyance switching element," and "close proximity." The Board also admonished the parties not to introduce new evidence into the record or raise new arguments that go beyond the issues authorized.

I. CLAIM CONSTRUCTION

A. Activation Cue.

Petitioner failed to provide any claim construction for "activation cue" in its Petition. However, it was foreseeable that Patent Owner would construe this claim element claim. Therefore, Petitioner's new claim construction is raising a new argument which the Board admonished the parties not to do.

Petitioner states that the "activation cue is in the form of a data communication of a specific type which will be recognized by electronic device 10 as an activation cue." Ex. 1001, 9:24-27." Reply, 1. However, Petitioner failed to provide the complete quote. The full quote states, "This activation cue is in the form of a data communication of a specific type which will be recognized by electronic device 10 as an activation cue, for example a predetermined bit sequence." Exh.

1001, 9:24-27. The “activation cue” claim element is a “specific type” that is “predetermined.” Further, when describing “cue receiver 19,” the ’294 patent explains that “[c]ue receiver ... can be of any type suitable for receiving an activation cue from data exchange device.” Exh. 1001, 12:60-62. Patent Owner in the POPR did use the term “intended as” when discussing that the “activation cue” was predetermined as provided for in the specification. If an “activation cue” is predetermined, then it is intended to be an “activation cue,” otherwise, how can it be predetermined? A determination of an activation cue being anything but predetermined would read the term “activation cue” out of the claims and improperly broaden the claim to any communication received at a cue receiver rather than an “activation cue” being received.

The specification calls for an “activation cue” to be a specific type of message and is a claim element. Nowhere in the ’294 patent does it describe or teach general messages that are not intended to be an “activation cue” being used as an “activation cue,” as asserted by Petitioner.

The claim construction provided by the Patent Owner in the POPR is a proper claim construction that should be adopted by the Board. *See* POPR, 9.

B. Data Conveyance Switching Element.

Petitioner provided a conditional claim construction in the Petition for “data conveyance switching element” if the claim term was subject to construction under 35 U.S.C. § 112, sixth paragraph (pre-AIA). *See* Pet., 6. No 35 U.S.C. § 112, sixth paragraph issues exist with this claim term. Therefore, the condition required to use Petitioner’s claim construction has not been met, and Petitioner’s claim construction is not to be used. Further, it was foreseeable that Patent Owner would construe the claim term. Therefore, any construction provided by Petitioner is an impermissible new argument.

Pettitioner’s Reply states “Patent Owner argues the term data conveyance switching element ‘should be given its plain meaning, which is the switching of the data.’ POPR, 10.” Reply, 2. Petitioner asserts:

... [a] device allowing data to be conveyed” should be considered for the construction. Data conveyance is simply moving the data. The element is “data conveyance switching element.

Switching data must be in the construction, or the claims will simply be a “data conveyance element.” Petitioner’s asserted construction reads “switching” out of the element.

Patent Owner requests that the Board adopt Patent Owner’s construction of “data conveyance switching element” provided in the POPR because it is supported by the specification. *See* POPR, 10-11.

C. Close Proximity

Petitioner did not provide a construction for “close proximity” in the Petition; and the argument provided in the Reply is an improper new argument. Petitioner asserts that Patent Owner’s claim construction of “close proximity” is unduly narrow. *See* Reply, 4. The Petition further states that “by stating that ‘any other suitable data exchange device’ may be used, the specification suggests that ‘close proximity’ for a given system depends on the selected data exchange device and its configuration.” Reply, 4. Petitioner’s construction reads out the term “proximity” from “close proximity.” “Close proximity” is a more precise term than simply “close.” Furthermore, “close proximity” is not dependent on implementation, as the claims require the proximity transceiver that is in close proximity of the first external data exchange. *See* Exh. 1001, 19:62-67.

Petitioner also asserts the use of Bluetooth in a way that is opposite to the proper operation as defined in the Bluetooth specification cited by Petitioner's reference as explained by Patent Owner. *See* POPR, 24. For the Board to adopt a claim construction that has close proximity to simply depend on implementation or be the extreme range of reception of the cue receiver of the activation cue would read out the complete claim term "a close proximity."

Patent Owner asks the Board to adopt the claim construction of the POPR because Petitioner did not provide a construction, and Patent Owner's construction is supported by the specification. *See* POPR, 12.

II. CONCLUSION

For these reasons and those asserted in the Patent Owner's Preliminary Response (POPR), the Board should accept the Patent Owner's constructions because Petitioner failed to provide any claim constructions in the Petition for the Patent Owner's foreseeable claim terms.

Dated: January 24, 2025

Respectfully Submitted

By: *Robert Hart*

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies Patent Owner DH International Ltd. served this PATENT OWNER'S PRE-INSTITUTION SUR-REPLY on the counsel of record for Petitioner Google LLC by filing this document through the P-TACTS, as well as delivering a copy via electronic mail to the following:

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By: /s/ *Robert Hart*
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