

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
and SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,
v.

HARBOR ISLAND DYNAMIC, LLC,
Patent Owner.

Case No. IPR2024-01405
U.S. Patent No. 9,245,826

PETITIONER'S SUPPLEMENTAL BRIEF ON CLAIM CONSTRUCTION

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Claim 1 of the '826 patent recites “at least one anchor via disposed in at least one corner of a semiconductor substrate.” In both the IPR and district court, Samsung contends that “disposed in at least one corner” should be given its plain and ordinary meaning, namely, disposed “near to” or “in proximity to” a corner. But in the district court, given that an understanding of the claim’s outer bound may be necessary to adjudicate infringement, Samsung contends that the *outer boundary* of “near” or “proximate to” is indefinite. This is proper under the Director’s guidance.

“[T]he Board’s trial rules do not necessarily prohibit petitioners from taking inconsistent [or alternative] claim construction positions before the Board and a district court.” *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, No. IPR2025-00632, Paper 20 at 3-4 (Director Nov. 3, 2025) (precedential) (quotation omitted). And as the Director has explained, such arguments are permissible where “the limitation prescribed a range and only the outer bounds of the range were unclear.” *Tesla Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 at 3-4 (Director Nov. 5, 2025) (informative). And here, only a “corner[’s]” outer bounds are unclear.

Should the Board disagree, however, Samsung will withdraw its district court indefiniteness challenge to eliminate any potential inconsistencies across proceedings and ensure continued consideration of the instituted IPR.

I. Samsung Developed Consistent, Alternative Claim Construction Positions in the IPR and District Court

In the Petition, Samsung explained that the prior art discloses anchor vias disposed near to a corner. *E.g.*, Pet., 29 (annotating *Conn*'s Fig. 2); Reply, 15-19. Dr. Thompson later explained that the prior art "[places] the anchor via very close to the corner." Ex. 2009 at 39:25-40:14. For example, "Conn envisions [the vias] could be just 60 micrometers [(i.e., width of a human hair)] from the corner." *Id.* Referencing *Conn*'s Figure 2, Dr. Thompson explained that "under any reasonable definition, that would be near the corner of the die." *Id.* at 35:10-36:9. Further construction was not necessary. The IPR was instituted. Paper 9.

Following institution, in the parallel district court litigation, the parties filed a Joint Claim Construction and Prehearing Statement. Ex. 1036; Ex. 1037. Samsung's district court position, supported by Dr. Neikirk, is that "disposed in at least one corner" means "disposed near to or in proximity to a corner," i.e., disposed a certain distance from the at least one corner. Ex. 1038 (Neikirk Decl.), ¶¶48-50. The '826 patent says the distance "may vary depending on the particular application," '826 patent, 6:65-67, but does not provide any way of determining such distance. Neikirk Decl., ¶¶49-50. Thus, the '826 patent "do[es] not inform a POSITA where to draw the boundary for what it means to be 'in' a corner." Neikirk Declaration, ¶50. The district court litigation was stayed prior to any development of Samsung's positions.

Samsung explained this indefiniteness argument in its IPR Reply. According to Samsung, the argument arises from the '826 patent's description that the distance

for a corner anchor via “may vary depending on the particular application,” so it is impossible to ascertain its upper limit. Reply at 6, n.1 (quoting ’826 patent, 6:65-67, 7:3-5). Samsung explained that the IPR does not need to address this issue because the cited prior art teaches anchor vias that are clearly within the range of distance contemplated by the ’826 patent. *Id.* (citations omitted).

II. Samsung Has Provided a Sufficient Explanation for Any Alleged Differences in Claim Construction Positions

Although resolution of the claim’s outer boundary may be necessary to determine infringement, it is not necessary to determine whether the prior art maps to the claims. As Dr. Thompson explained, “under any reasonable definition, all the references I found, a POSITA would say they’re in the corner, and I didn’t need to figure out where the boundary was for how far away from the corner you could be and still be in the corner.” Ex. 2009, 39:25-40:14. The Board should thus still consider whether the prior art anticipates or renders obvious the challenged ’826 patent claims without construing the full claim scope.

Indeed, the law distinguishes between claims with a “wholly undefined claim element”—which “cannot be compared to the prior art for purposes of an invalidity analysis”—and claims whose scope is indefinite but nonetheless can be challenged because the prior art indisputably reads on the claims. *Cochlear Bone Anchored Sol’ns AB v. Oticon Med. AB*, 958 F.3d 1348, 1359-60 (Fed. Cir. 2020). As the

Federal Circuit explained in a related context, “it is not always impossible to adjudicate a prior-art challenge, one way or the other, just because some aspect of a claim renders the claim indefinite.” *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 813 (Fed. Cir. 2021) (citation omitted). The indefiniteness of a limitation “precludes a patentability determination only when the indefiniteness renders it logically impossible for the Board to reach such a decision.” *Id.*; *see also Samsung Elecs. Am., Inc. v. Prisia Eng’g Corp.*, 948 F.3d 1342, 1355 (Fed. Cir. 2020) (“*IPXL*-type indefiniteness ... does not necessarily preclude the Board from addressing the patentability of the claims on section 102 and 103 grounds.” (citations omitted)).

Samsung’s indefiniteness challenge is that the *outer bound* of the corner term is unclear, which does not conflict with the IPR identifying prior art that nonetheless indisputably falls within the bounds of the term. The Director has explained that explanation is a sufficient basis for offering alternative constructions. According to the Director, a Petitioner’s explanation of alternative claim construction positions may be “sufficient . . . if Petitioner ha[s] shown that, notwithstanding the alleged indefiniteness of the claim term, an ordinarily skilled artisan would understand that the asserted art satisfies the claim limitation (*such as if the limitation prescribed a range and only the outer bounds of the range were unclear*).” *Tesla*, IPR2025-00340, Paper 18 at 3-4 (informative) (emphasis added). And this is the case here.

In *Mylan Pharmaceuticals et al. v. Horizon Pharma USA*, IPR2017-01995,

Paper 72 (PTAB Mar. 28, 2019), the Board declined to terminate an IPR in a similar context. Petitioners argued in the IPR that the claimed “target” means “with the goal of obtaining.” *Id.* at 7. But petitioners alternatively argued in district court that “target” is indefinite. *Id.* The district court construed “target” to mean “set as a goal,” but it determined that it could not determine infringement because “the patent provides no discernable standard for drawing the line that distinguishes infringing acts from noninfringing ones.” *Id.* at 7-8. The Board declined to terminate the IPR, explaining that “the district court’s determination is based on applying its claim construction to determine infringement, and we are limited to addressing in an *inter partes* review whether the challenged claims are patentable [based on the limitations of 35 U.S.C. § 311(b)].” *Id.* at 8. Here, as in *Mylan*, uncertainty regarding the claim boundaries does not preclude the Board from applying the claims to the prior art.

III. Samsung’s Practice Is Consistent with the Board’s Rules

As shown above, Samsung does not seek broader IPR constructions while seeking narrower district court constructions, which is discouraged by the Board’s construction rules. *Revvo*, IPR2025-00632, Paper 20 at 4.

IV. Conclusion

The different positions in the IPR and district court are warranted. Should the Board disagree, however, Samsung will withdraw its district court indefiniteness challenge to eliminate any potential inconsistencies across proceedings.

Date: December 3, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Petitioner's Supplemental Brief on Claim Construction** was served on December 3, 2025, via email directed to counsel of record for Patent Owner at the following:

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