

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 APPLICANT ADMITTED
PRIOR ART**

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Under Ground 2B, “*Conn* in view of knowledge of POSA and Applicant Admitted Prior Art (AAPA)” renders claims 8 and 18 obvious. Pet., 23. At the oral hearing on January 6, 2026, the Board directed the parties to submit supplemental briefing on whether Ground 2B’s reference to AAPA complies with *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367 (Fed. Cir. 2022) (*Qualcomm I*), and *Qualcomm Inc. v. Apple Inc.*, 134 F.4th 1355 (Fed. Cir. 2025) (*Qualcomm II*) (collectively, *Qualcomm*). Ground 2B is consistent with both decisions and proper under the relevant statute, 35 U.S.C. § 311(b).

Ground 2B, unlike the petitions considered in *Qualcomm I & II*, does not make AAPA the “basis” of the ground. Rather, under Ground 2B, AAPA supplies a missing claim limitation—a limitation that Patent Owner does not contend was novel to the alleged invention. This approach is consistent with other Federal Circuit decisions applying *Qualcomm II*, including *Shockwave Med., Inc. v. Cardiovascular Sys., Inc.*, 142 F.4th 1371 (Fed. Cir. 2025).

I. Ground 2B’s Use of AAPA Differs from *Qualcomm I & II*

Section 311(b) specifies that “[a] petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and *only on the basis of prior art consisting of patents or printed publications.*” 35 U.S.C. § 311(b) (emphasis added); *Qualcomm II*, 134 F.4th at 1361. Ground 2B is consistent with § 311(b), as well as

the Federal Circuit’s analysis of § 311(b) under *Qualcomm I & II*.

In *Qualcomm I*, the Federal Circuit held that AAPA cannot form the “basis” of a ground for inter partes review under § 311(b). 24 F.4th at 1374. And in *Qualcomm II*, the Federal Circuit rejected the Board’s prior “in combination” rule—which categorically treated grounds as compliant with § 311(b) so long as AAPA was combined with prior art patents or printed publications—and clarified that “[r]eliance on AAPA in combination with prior art patents or printed publications does not automatically render the AAPA as not included in the basis of a ground.” 134 F.4th at 1360, 1367. Instead, the Federal Circuit explained that whether AAPA forms the “basis” of a ground should be determined by examining the petition’s statements. *Id.* at 1368. The Court “recognize[d] that there are *instances* in which a petition may rely in part on AAPA, such as to indicate the general knowledge of a person of ordinary skill in the art, without contravening § 311(b).” *Id.* at 1365 (emphasis in original) (citation omitted).

As to the grounds at issue in *Qualcomm*, the Court found that AAPA forms the “basis” of them because each petition included a table of grounds that expressly labeled AAPA as the “basis” for its challenge. *Id.* at 1366-68. An example from one petition is shown below:

Ground	'674 Patent Claims	Basis for Rejection
Ground 1	1, 2, 5-7	§103: Steinacker in view of Doyle and Park
Ground 2a	1, 2, 5, and 6,	§103: Applicants Admitted Prior Art (AAPA) in view of Majcherczak
Ground 2b	7	§103: AAPA in view of Majcherczak and Matthews

Qualcomm petition (IPR2018-01315, Paper 2 at 2).

Unlike the *Qualcomm* petitions, Ground 2B here does not use AAPA as a “basis.” The petition’s table of grounds does not identify AAPA as part of the basis for Ground 2B:

B. Challenges

Ground	Challenged Claims	Basis	Prior Art
1	1, 2, 4, 5, 7, 9, 11, 12, 14, 15, 17, 19	§102	<i>Conn</i>
2	2A 1, 2, 4-7, 9, 11, 12, 14-17, 19	§103	<i>Conn</i> in view of knowledge of a person of ordinary skill in the art (POSA)
	2B 8, 18	§103	<i>Conn</i> in view of knowledge of POSA and Applicant Admitted Prior Art (AAPA)

Pet., 23; Pet., 54 (listing heading for Ground 2B). Ground 2B is fundamentally different from *Qualcomm* because the *Qualcomm* petitions rely on AAPA as a primary/base reference, while Ground 2B uses AAPA solely to modify *Conn*—an approach that is permissible in an IPR. *Shockwave*, 142 F.4th at 1378 (citing *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1337 (Fed. Cir. 2020)). Thus, Ground 2B differs from *Qualcomm II*.

II. Ground 2B's Use of AAPA Is Similar to *Shockwave*

Ground 2B's reliance on AAPA is one of the instances recognized by the *Qualcomm* Court as permissible in an IPR. In *Shockwave*, decided shortly after *Qualcomm II*, the Federal Circuit held that an "IPR petition did not violate § 311(b)" where it "properly relied on general background knowledge to supply missing claim limitations (which [the patent owner] does not argue were novel to the invention) and used AAPA as evidence of that general background knowledge." 142 F.4th at 1380. The Federal Circuit reached this conclusion even though the underlying petition (as here) had referenced the "AAPA" in its listings of grounds:¹

Ground	Reference(s)	Challenged Claims
1	§ 103 Levy as modified by AAPA in combination with Mantell, Uchiyama or Willneff	1-6,11, 14-16
2	§ 103 Levy as modified by AAPA in combination with Mantell, Uchiyama or Willneff, and in further view of Hayes	7, 12
3	§ 103 Levy as modified by AAPA in combination with Mantell, Uchiyama or Willneff, and in further view of Duchamp	8, 12

Shockwave petition (IPR2019-00405, Paper 1 at 6 (excerpt)).

Like *Shockwave*, Ground 2B's reference to "Knowledge of POSA" indicates

¹ In *Shockwave*, the Federal Circuit acknowledged that the Board's final written decision modified petitioner's listings of grounds by listing the AAPA under "Reference(s)/Basis," but it noted that the pertinent analysis should be based on the petitioner's, not the Board's, statements. *Shockwave*, 142 F.4th at 1379.

an intent to rely on general background knowledge to supply missing claim limitations. Ground 2B's additional reference to "AAPA" is not to introduce teachings beyond what a POSA would already know, but rather to highlight that the '826 patent itself acknowledged claims 8 and 18 as well known to a POSA. *Compare Shockwave*, 142 F.4th at 1379 ("Here CSI used AAPA only to show, as the [] patent itself acknowledged, that the ... [claim limitation] was well known in the prior art"), *with* Pet., 54 ("AAPA discloses the three-layer backside metal stack in claim 8 had been used as a conventional method of adhering a backside metal layer to a substrate."). Ground 2B further identifies disclosures in the prior art *Cronin* and *Sharma* references to show "the multi-layer backside metal stack was a mature technique dating back to the 1980s."² Pet., 55. Patent Owner never disputed that this was already well known. The result is that Ground 2B is consistent with Federal Circuit precedent allowing the use of AAPA in an IPR.

III. Conclusion

Accordingly, the Board should find that claims 8 and 18 are unpatentable under Ground 2B.

² Thus, the Petition also complies with the requirement of 37 C.F.R. § 42.104(b)(4) that "[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon."

Respectfully submitted,

Dated: January 14, 2026

By: / Joshua L. Goldberg /
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Petitioner's Supplemental Brief on Applicant Admitted Prior Art** was served on January 14, 2026, via email directed to counsel of record for Patent Owner at the following:

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