

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROAMPAC HOLDINGS INC.,

Petitioner

v.

SIGMA TECHNOLOGIES INTERNATIONAL, LLC,

Patent Owner

Case IPR2025-01143
U.S. Patent No. 11,072,148

**PATENT OWNER'S SUPPLEMENTAL BRIEF ADDRESSING THE
IMPACT OF THE *REVVO* AND *TESLA* DECISIONS ON THESE
PROCEEDINGS IN VIEW OF PETITIONER'S DIFFERENT CLAIM
CONSTRUCTION POSITIONS**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	GOVERNING PRINCIPLES FROM <i>REVVO</i> AND <i>TESLA</i>.....	2
III.	PETITIONER’S POSITION IN THE PETITION	3
V.	THE PETITION IS NONCOMPLIANT WITH RULE 42.104(b)(3)	4
VI.	CONCLUSION	5

TABLE OF AUTHORITIES

Cases

<i>American Airlines, Inc. and Southwest Airlines Co. v. Intellectual Ventures I LLC</i> , IPR2025-01055, Paper 11 at 13 (Nov. 21, 2025)	1, 2, 4
<i>Qualcomm Inc. v. Apple Inc.</i> , 134 F.4th 1355 (Fed. Cir. 2025).....	3, 4
<i>Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.</i> , IPR2025-00632, Paper 20 (Nov. 3, 2025).....	1, 2
<i>Tesla, Inc. v. Intellectual Ventures II LLC</i> , IPR2025-00340, Paper 18 (Nov. 5, 2025).....	1, 2, 3

Rules

37 C.F.R. § 42.104(b)(3).....	2, 4
-------------------------------	------

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	DESCRIPTION
2001	ProAmpac's <i>First Amended Answer and Counterclaims</i> from Parallel Litigation
2002	Declaration of Steven Yializis
2003	Docket Entries from Parallel Litigation (As Of Aug. 27, 2025)
2004	Oral Order Entered 08/14/25 in Parallel Litigation Denying (Without Prejudice) ProAmpac's Motion to Stay Pending IPR
2005	Parallel Litigation <i>Scheduling Order</i> entered 03/14/25
2006	Parallel Litigation <i>Joint Stipulation and [Proposed] Order Substituting Parties and Changing Case Caption</i> (filed 06/25/25)
2007	<i>Defendant/Counterclaim Plaintiff ProAmpac Holdings Inc.'s Initial Invalidity Contentions</i> (served 08/27/25)
2008	Dennis Crouch, <i>Estoppel Gutted: A Pelican's Guide to Patent Litigation</i> , PatentlyO.com (May 7, 2025).
2009	Andrew Zappia, Bryan Smith, and Nicolas Gallo, <i>How IPR Estoppel Ruling May Clash with PTAB Landscape</i> , Law360.com (Jun. 17, 2025).
2010	Scott R. Boalick, Chief Administrative Patent Judge, <i>Guidance on USPTO's Recission of 'Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,'</i> (Mar. 24, 2025), https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf
2011	Coke Morgan Stewart, USPTO Acting Director, <i>Interim Processes for PTAB Workload Management</i> (Mar. 26, 2025), https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf .

Exhibit No.	DESCRIPTION
2012	<i>Apple, Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).
2013	<i>Dabico Airport Sol'ns Inc. v. AXA Power APS</i> , IPR2025-00408, Paper 21, 2025 Pat. App. LEXIS 3168 (P.T.A.B. Jun. 18, 2025) (nonprecedential).
2014	<i>Ecto World, LLC v. RAI Strategic Holdings, Inc.</i> , IPR2024-01280, Paper 13 (P.T.A.B. May 19, 2025) (precedential).
2015	<i>Hospira, Inc. v. Genentech, Inc.</i> , IPR2017-00739, Paper 16 (PTAB Jul. 27, 2017) (informative).
2016	<i>Motorola Sol'ns, Inc. v. Stellar, LLC</i> , IPR2024-01205, Paper 19 (Stewart Mar. 28, 2025).
2017	<i>Samsung Elecs. Co. v. GhengisComm Holdings, LLC</i> , IPR2025-00788, Paper 11 (P.T.A.B. Aug. 25, 2025).
2018	<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A)
2019	Coke Morgan Stewart, USPTO Acting Director, <i>Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews</i> (Jul. 31, 2025), https://www.uspto.gov/sites/default/files/documents/aapa_memo_final_signed.pdf?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term= .
2020	Declaration of Ruoxi Ma, Ph.D.
2021	Curriculum vitae of Dr. Ruoxi (Rachel) Ma
2022	“ <i>Biopolymer Films from Glucomannan: The effects of Citric Acid Crosslinking on Barrier Properties</i> ,” in <i>Journal of Print and Media Research Technology</i> , Research 7(2018)1, 19-25.
2023	“ <i>Screen Printed Moisture Sensor and Its Application on Smart Packaging</i> ,” in <i>The Technical Association of Graphic Arts Proceedings 2021</i> , pgs. 191-203 (focusing on material-layer substrates and substrates/coating surface interactions)

Exhibit No.	DESCRIPTION
2024	<i>Method for Formulating Silver-Doped Lanthanum Titanate Photochromic Ink</i> (CN103804986A), issued May 21, 2014.
2025	Friel, John M., and Edwin Nungesser. “ <i>Acrylic Polymers as Coatings Binders.</i> ” Paint and Coating Testing Manual - Fifteenth Edition of the Gardner-Sward Handbook: (MNL 17-2nd), edited by JV Koleske, no. MNL17, ASTM International, 2012, pp. 49–64, https://doi.org/10.1520/MNL12186M .
2026	Gündüz, Güngör. <i>Chemistry Materials and Properties of Surface Coatings: Traditional and Evolving Technologies</i> . DEStech Publications, 2015
2027	<i>Pigment Coating and Surface Sizing of Paper</i> . Vol. bk. 11., Fapet Oy, 2000. Chapter 6: Binders, section Coating binders, @ page 191. This reference covers binders, including latex and acrylic, their functions, properties, and implications for coating formation.
2028	<i>Recycled Fiber and Deinking</i> . Vol. bk. 7, Fapet Oy, 2000. Chapter 11, page 441-504.
2029	District Court Amended Joint Claim Construction Chart

I. INTRODUCTION

When a Petitioner “provides no explanation for its different claim construction positions in the two forums. This alone favors denial of institution.” *American Airlines, Inc. and Southwest Airlines Co. v. Intellectual Ventures I LLC*, IPR2025-01055, Paper 11 at 13 (Nov. 21, 2025); *Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 (Nov. 3, 2025) (precedential) (a petitioner must explain why it takes different claim construction positions in the petition and in district court); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (Nov. 5, 2025) (informative) (a petitioner’s explanation that it could not argue indefiniteness in an IPR is insufficient to show why different claim construction positions are warranted).

In its Petition, Petitioner stated that “no terms need construction to resolve the controversy in this forum” and that “[f]or this Petition, Petitioner applies prior art in a manner consistent with Patent Owner’s allegations of infringement before the district court.” (Petition, 10.) Petitioner thus elected Patent Owner’s constructions, declined to identify *any* term requiring construction, and offered *no* explanation for doing so.

In the district court, however, Petitioner has taken the opposite approach, asserting that numerous terms require construction and that several terms are indefinite. Petitioner has never explained why it advances narrower positions in

district court but a broader approach here. In fact, the Board was first informed of Petitioner's inconsistent claim construction positions in Patent Owner's Preliminary Response (Paper 10 at 12). *See American Airlines v. Intellectual Ventures I LLC*, IPR2025-01055, Paper 11 at 13 (noting that Petitioner is obligated by its duty of candor and good faith pursuant to 37 C.F.R. § 42.11 to inform the Board of different claim construction positions and stating "Patent Owner should not have been the first party to inform the Board as to Petitioner's different claim construction positions in the two forums.")

Under *Revvo* and *Tesla*, a petitioner taking different claim construction positions across forums must explain why alternative positions are warranted. Petitioner has provided no such explanation in the Petition, or any other IPR paper. This unexplained inconsistency reflects noncompliance with 37 C.F.R. § 42.104(b)(3) and warrants denial of institution.

II. GOVERNING PRINCIPLES FROM *REVVO* AND *TESLA*

In *Revvo*, the Director held that "when a petitioner takes alternative positions before the Board and a district court, that petitioner should, at a minimum, explain why alternative positions are warranted." *Revvo* at 3-4. The Director further clarified that, "Simply noting that the petitioner is adopting a patent owner's claim construction proposals from district court, however, is not a sufficient reason for advancing different positions in the two forums." *Id.* at 5. *Revvo* also explained that

when a petition lacks the required explanation, it fails to comply with Rule 42.104(b)(3), and that such failure “would mean a denial of institution.” *Id.*

In *Tesla*, the Director confronted a similar inconsistency where a petitioner argued indefiniteness in district court but urged “plain and ordinary meaning” at the PTAB. The Director held that an assertion that some claim construction positions, such as indefiniteness, are unavailable in an IPR “is not a sufficient explanation” for differing positions. *Tesla* at 3. *Tesla* emphasized that unexplained inconsistencies in claim construction “detracts from... the Office’s goal[.]” *Id.* at 4. Indeed, in *Tesla*, where the “Petitioner argued indefiniteness in the district court and then adopted Patent Owner’s plain and ordinary meaning construction from the district court litigation in its Petition” that “denial of institution is appropriate in this case.” *Id.*

Together, these decisions require a petitioner to explain *in the petition* why it takes different claim construction positions across forums. A conclusory plain-meaning assertion or a reference to procedural differences is insufficient.

III. PETITIONER’S POSITION IN THE PETITION

Petitioner’s claim construction position *in the Petition* is clear:

“Here, **no terms need construction** to resolve the controversy in this forum... For this Petition, Petitioner applies prior art in a manner consistent with Patent Owner’s allegations of infringement before the district court.” (Petition, 10. Emphasis added.)

Under *Qualcomm*, “[Petitioner] should be held to the phrasing of its petition

because an IPR petitioner is the ‘master of its own petition.’” *Qualcomm Incorporated v. Apple Inc.*, 134 F.4th 1355,1367 (Fed. Cir. 2025). The Petition identifies **no** term requiring construction, offers **no** express construction, and provides **no** explanation. Furthermore, Petitioner has made no attempt to cure this inconsistency and, despite multiple opportunities to do so, Petitioner is silent.

IV. PETITIONER’S DISTRICT COURT POSITIONS

Taking a contrary district court position, Petitioner argues that the claims require numerous narrowing constructions to avoid infringement and several terms are indefinite. Briefly, for example, Petitioner in the district court construes *inter alia* “polymer layer” as “continuous polymer layer” and “an aluminum layer deposited on the fourth surface” as “vacuum depositing aluminum onto the fourth surface.” [Amended Joint Claim Construction Chart, EX2029.] These are not superficial differences. They are substantive narrowing constructions that Petitioner asserts impact non-infringement. Yet **none** are acknowledged in the Petition.

V. THE PETITION IS NONCOMPLIANT WITH RULE 42.104(b)(3)

Under 37 C.F.R. § 42.104(b)(3), *petitioners* must clearly articulate *in the petition* “[h]ow the challenged claim is to be construed.” Here, Petitioner has provided no explanation for its different claim construction positions in the two forums. Under *Revvo* and *Tesla*, “[t]his alone favors denial of institution.” *American Airlines*, at 13.

VI. CONCLUSION

Both *Revvo* and *Tesla* establish that petitioners taking different claim construction positions before the Board and in district court must explain, *in the petition*, why those differing positions are warranted, and that unexplained inconsistencies result in noncompliance with Rule 42.104(b)(3) and support denial of institution.

Petitioner did not provide any explanation in the Petition, or anywhere else, despite advancing extensive narrowing and indefiniteness positions in district court. Consistent with *Revvo* and *Tesla*, this failure reinforces that the Board should assess the Petition in light of Petitioner's noncompliance with § 42.104(b)(3) and deny institution.

Patent Owner does not raise any issue outside the authorized scope of this supplemental briefing. Patent Owner also reserves the right to respond to any new explanation Petitioner may offer for the first time in its own supplemental brief.

This 25th day of November, 2025.

Respectfully submitted,

/s/ Michael J. Curley
Michael J. Curley
Registration No. 63,251
Quarles & Brady LLP
One South Church Avenue
Suite 1800
Tucson, Arizona 85701
michael.curley@quarles.com
Phone: (520) 770-8768

Attorney for Sigma Technologies Int'l, LLC

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6 (e), the undersigned certifies that the foregoing Patent Owner's Supplemental Brief Addressing the Impact of the *Revvo* and *Tesla* Decisions on the Proceedings in View of Petitioner's Different Claim Construction Positions is being served on counsel of record by filing the document through the Patent Trial and Appeal Case Tracking System (P-TACTS), with a copy served via electronic mail to the following email address, as authorized in Petitioner's Mandatory Notices:

Walter D. Davis, Jr.
walter.davis@blankrome.com

Domingo M. Llagostera
domingo.llagostera@blankrome.com

Megan R. Wood
megan.wood@blankrome.com

Jonathan M. Hernandez
jonathan.hernandez@blankrome.com

Dated: November 25, 2025

/s/ Michael J. Curley
Michael J. Curley
Registration No. 63,251
Attorney for Sigma Technologies Int'l, LLC