

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN AIRLINES, INC. AND SOUTHWEST AIRLINES CO.,

Petitioners,

v.

INTELLECTUAL VENTURES II LLC,

Patent Owner.

Case No. IPR2025-01509
U.S. Patent No. 11,032,000

**AUTHORIZED REPLY BRIEF IN SUPPORT OF
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

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PATENT OWNER'S EXHIBIT LIST

Ex. 2001	<i>American Airlines, Inc. and v. Intellectual Ventures II LLC</i> , IPR2025-00785 and IPR2025-00786, Paper 11 (PTAB August 29, 2025) (declining to exercise discretion to deny IPRs).
Ex. 2002	<i>American Airlines, Inc. and v. Intellectual Ventures II LLC</i> , IPR2025-00782 and IPR2025-00931, Paper 12 (PTAB September 19, 2025) (declining to exercise discretion to deny IPRs).
Ex. 2003	<i>American Airlines, Inc. and v. Intellectual Ventures II LLC</i> , IPR2025-00987 and IPR2025-01055, Paper 9 (declining to exercise discretion to deny IPRs).
Ex. 2004	Defendant Southwest Airline Co.'s Preliminary Invalidity Contentions

I. PETITIONERS' STIPULATIONS DO NOT REMOVE THE RISK OF INCONSISTENT CLAIM POSITIONS

Petitioner Southwest Airlines (Southwest) has stipulated "not to pursue before the District Court the indefiniteness arguments complained of by Patent Owner in its discretionary denial brief." Petitioners' Opposition To Patent Owner's Request For Discretionary Denial (Paper #9) ("Opp. Brief"), at 8-9. Southwest's stipulation does not equate to "no risk of inconsistent claim construction positions," because the stipulation does not preclude Southwest from replacing "the indefiniteness arguments complained of by Patent Owner" with another claim construction that is inconsistent with Southwest's positions here. *Id.*, (emphasis added). Nor does the stipulation preclude Southwest from taking any other claim construction position in the district court that it desires. In fact, the Petition (at 8) expressly reserves the right to do just that by stating that "Petitioners reserve the right to address construction of any terms raised at trial, or in the related district court actions."

The Opposition Brief (at 8) relies on *Caption Health v. Univ. of British Columbia*, IPR2025-01422, Paper 15 (Director Dec. 18, 2025), but the present facts are different from that case. There, the Petitioner stipulated to consistent positions.¹

¹ Unlike here, in *Caption Health*, the Petitioner's positions in the district court and the IPR could be reconciled as the Petitioner maintained that the ordinary meaning applied in both forums. The dispute arose from the Petitioner explaining what the ordinary meaning was in one forum and remaining silent in the other, and was resolved by the Petitioner agreeing to apply the same meaning in both forums.

By contrast, in this case, Southwest has expressly reserved the right to replace its indefiniteness position with any claim construction it chooses, regardless of whether it is consistent with the Petition's mappings in these proceedings. Southwest could have offered a straightforward stipulation that it will take consistent claim constructions across both forums, but opted not to do so.

The stipulation offered by American Airlines (American) to "not pursue indefiniteness arguments that are inconsistent with the Petition's contents" is even more flawed. Opp. Brief, 9 (emphasis added). American took two indefiniteness positions with respect to the '000 Patent in the district court. Ex. 1032, 5. American's stipulation is literally meaningless because, in the sentences that follow the stipulation, American makes clear that it intends to maintain those same two indefiniteness positions in the district court because, according to Petitioners, they "are not inconsistent with the Petitions arguments." Opp. Brief, 9 (emphasis added).

Even more disturbing is the fact that, in its Supplemental Disclosure of Proposed Terms and Claim Elements for Construction (Ex. 1032), American identified numerous terms in the '000 Patent for construction by the district court but failed to construe those same terms in these proceedings. For example, in the district court, American identified the following terms as requiring construction: "different resources" (claims 1 and 13), "other physical channels" (claims 1 and 13), "a processor" and "the processor" (claims 1, 2 and 4), "a receiver" and "the receiver"

(claims 1, 2 and 4) and "a transmitter" and "the transmitters" (claim 1). Ex. 1032, 5. By contrast, the Petition makes no mention of any constructions for these same terms. Again, American could have offered a straightforward stipulation that it will take consistent claim constructions across both forums, but opted not to do so. On the contrary, based on the evidence, American appears firmly committed to maintaining all of its inconsistent claim construction positions across both forums. As a result, Petitioners' assertion that "there is no risk of inconsistent claim construction positions between the Parallel Litigations and this proceeding" rings hollow. Opp. Brief, 9.

II. AMERICAN'S INDEFINITENESS POSITIONS ARE NOT CONSISTENT WITH THE PETITION

The Opposition Brief (at 9) cites to *IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1383 (Fed. Cir. 2005) in support of its allegation that American's indefiniteness positions are "not inconsistent with the Petition's arguments," but does not elaborate on this citation, or explain why the holding in *IPXL* renders American's indefiniteness positions "not inconsistent with the Petition's arguments."

In *IPXL*, the Federal Circuit affirmed a district court's finding that a claim was indefinite because "it attempts to claim both a system and a method for using that system." *IPXL*, 430 F.3d 1377, 1383. There, the Court stated:

Whether a single claim covering both an apparatus and a method of use of that apparatus is invalid is an issue of first impression in this

court. The Board of Patent Appeals and Interferences ("Board") of the PTO, however, has made it clear that reciting both an apparatus and a method of using that apparatus renders a claim indefinite under section 112, paragraph 2. ... The Board correctly surmised that, as a result of the combination of two separate statutory classes of invention, a manufacturer or seller of the claimed apparatus would not know from the claim whether it might also be liable for contributory infringement because a buyer or user of the apparatus later performs the claimed method of using the apparatus. *Id.* Thus, such a claim "is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved" and is "ambiguous and properly rejected" under section 112, paragraph 2. *IPXL*, 430 F.3d 1377, 1384 (citations omitted).

The Opposition Brief does explain why the holding in *IPXL* renders American's indefiniteness positions "not inconsistent with the Petition's arguments." While the Opposition Brief does not refer to the Court's decision in *Samsung Elecs. Am. v. Priusa Eng'g Corp.*, 948 F.3d 1342, 1355 (Fed. Cir. 2020), the Court there found that indefiniteness under *IXPL* "does not necessarily preclude an analysis of whether a claim is obvious "regardless of whether it is treated as being directed to an apparatus or a method" (emphasis added). However, in order for that exception to have applied here, the Petition would have needed to explain how each challenged claim is obvious "regardless of whether it is treated as being directed to an apparatus or a method." That would have required the Petition: (i) to explain how Petitioners construed each challenged claim as being directed to an apparatus as well as being directed to a method, and (ii) then demonstrate that the prior art maps to each claim regardless of whether it is treated as an apparatus and method. 37 C.F.R.

42.104(b)(3)-(4). The Petition includes no such analysis. The Petition does not even allege -- let alone demonstrate -- that any challenged claim is met by the prior art "regardless of whether it is treated as being directed to an apparatus or a method," as required by *Samsung*. Thus, *Samsung* is clearly inapplicable here.

In any event, American is still taking inconsistent claim construction positions. In the Petition, American offered no construction for the same terms that it continues to allege are indefinite in the district court, while "reserv[ing] the right to address construction of any terms raised at trial, or in the related district court actions." Petition, 8. That type of double-talk, combined with the deficient stipulations offered by the present Petitioners, falls short of the straightforward position Director Squires set forth in *Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 (Squires November 3, 2025) (precedential) that Petitioners will "be required to choose a single claim construction that best captures the meaning the patent claim." *Id.*

III. CONCLUSION

For these reasons, the Director should deny institution.

Respectfully submitted,

Dated: January 16, 2026

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **AUTHORIZED REPLY BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** was served via email (as consented to by counsel) on January 16, 2026 to lead and backup counsel of record for Petitioner as follows:

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