

BEFORE THE PATENT TRIAL AND APPEAL BOARD
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trial No.: IPR 2015-01644

In re: U.S. Patent No. 6,785,065

Patent Owner: Toshiba Samsung Storage Technology Korea Corporation

Petitioners: LG Electronics, Inc., and LG Electronics U.S.A., Inc.

Inventors: Byung-youn Song and Kyung-sik Shin

For: OPTICAL PICKUP ACTUATOR DRIVING METHOD AND APPARATUS
THEREFOR

* * * * *

PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. § 42.120

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Toshiba Samsung Storage Technology Korea Corporation (“patent owner” or “PO”) submits this response to the petition. Petitioner has the burden of proving unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). Petitioner has not met its burden for the reasons explained below. *See also* Ex. 2003 (Bogy Decl.) at ¶¶ 48-89.

I. CLAIM CONSTRUCTIONS

PO respectfully submits that the broadest reasonable construction standard should not apply in IPRs. Instead, the PTAB should construe claim terms in IPRs using the same *Phillips* standard used by district courts in litigations. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc).

The IPR procedure was designed to be a surrogate for litigation, where the broadest reasonable construction (BRC or BRI) standard does not apply. *See, e.g.*, H.R. Rep. No. 112-98, at 46-47. IPRs are in effect adjudications that test patent validity using the fixed meaning of legally operative property rights; they are not examinations in which the scope of patent claims is fluid and changeable. In IPRs, just like district court litigation, the applicant-and-examiner back-and-forth is absent. There is no robust right to amend, and there is no guaranteed ability to resolve claim scope ambiguity. Indeed, patentees do not have a right to amend their claims in an IPR; instead, they must seek permission from the Board – permission that in practice rarely has been granted. Even when permission is granted, the ability to amend is severely limited and subject to strict rules. As the

dissent in *In re Cuozzo Speed Techs.*, *infra*, noted, all hallmarks justifying use of the broadest reasonable interpretation standard are absent from IPR proceedings. An IPR cannot be a surrogate for litigation when it uses a different claim construction standard that leads to different results. Further, it is respectfully submitted that 37 C.F.R. 42.100(b), which directs the PTAB to give claim terms the broadest reasonable construction rather than the *Phillips* standard, is not a valid exercise of the USPTO's rulemaking authority. PO respectfully submits that the *Phillips* standard of claim interpretation should apply.

The PTAB has taken the position that in IPRs, claim terms in an unexpired patent are to be given their broadest reasonable construction in light of the specification of the patent in which they appear. *See In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1277-79 (Fed. Cir. 2015), *cert granted sub nom. Cuozzo Speed Techs., LLC v. Lee*, 84 U.S.L.W. 3218 (U.S. Jan. 15, 2016) (No. 15-446). But even under this standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art, in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). The “broadest reasonable interpretation” does not mean the “broadest possible interpretation.” As the Federal Circuit has held, a proposed construction is “unreasonably broad” when it does not “reasonably reflect the . . . disclosure” and thus is inappropriate. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010).

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