

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES – GENERAL

Case No. SA CV 17-00596-DOC-JDE

Date: April 18, 2022

Title: XR COMMUNICATIONS, LLC V. D-LINK SYSTEMS, INC. ET AL.

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PRESENT:

THE HONORABLE DAVID O. CARTER, JUDGE

Dajanae  
Carrigan/Karlen  
Dubon  
\_\_\_\_\_  
Courtroom Clerk

Not Present

\_\_\_\_\_  
Court Reporter

ATTORNEYS PRESENT FOR  
PLAINTIFF:  
None Present

ATTORNEYS PRESENT FOR  
DEFENDANT:  
None Present

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**PROCEEDINGS (IN CHAMBERS): ORDER GRANTING IN PART  
DEFENDANTS’ CORRECTED  
MOTION FOR JUDGMENT ON  
THE PLEADINGS [286]**

Before the Court is Defendants D-Link Systems, Inc., Belkin International, Inc., Netgear, Inc., Aruba Networks, LLC, and Ubiquiti Inc. (collectively, “Defendants”) Corrected Motion for Judgment on the Pleadings on Asserted Claims 3, 4, 5, and 12 of the ’728 Patent (Dkt. 286).

**I. Background**

**A. Facts**

Plaintiff XR Communications, LLC d/b/a Vivato Technologies (“Plaintiff” or “XR” or “Vivato”) asserts United States Patents Nos. 7,729,728 (“the ’728 Patent”), 8,289,939 (“the ’939 Patent”) and 10,594,376 (“the ’376 Patent”) (collectively, “the patents-in-suit”). The patents-in-suit relate to Wi-Fi/802.11 wireless communications.

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## B. Procedural History

Plaintiff filed its Complaint on April 3, 2017 (Dkt. 1). Plaintiff filed its First Amended Complaint on June 23, 2017 (Dkt. 19), and its Second Amended Complaint on July 6, 2017 (Dkt. 21). On October 2, 2017, this and related cases were consolidated (Dkt. 30). On April 10, 2018, the case was stayed pending *inter partes* review (Dkt. 153). The stay was lifted on March 1, 2021 (Dkt. 193).

On November 24, 2021, Defendants moved for judgment on the pleadings with respect to the '231 patent (Dkt. 252), which the Court granted on January 1, 2022 (Dkt. 274).

Defendants filed the instant Motion for Judgment on the Pleadings with respect to several claims of the '728 Patent on February 17, 2022 (Dkt. 286). Plaintiff opposed ("Opp'n") (Dkt. 287) on February 28, 2022, and Defendants filed their Reply on March 14, 2022 (Dkt. 290). The Court heard arguments on the Motion on March 28, 2022.

## II. Legal Standard

"After the pleadings are closed—but early enough not to delay trial—a party may move for judgment on the pleadings." Fed. R. Civ. P. 12(c). Like a motion to dismiss under Federal Rule of Civil Procedure 12(b)(6), a motion under Rule 12(c) challenges the legal sufficiency of the claims asserted in the complaint. *See id.* Indeed, a Rule 12(c) motion is "functionally identical" to a Rule 12(b)(6) motion, and courts apply the "same standard." *Dworkin v. Hustler Magazine, Inc.*, 867 F.2d 1188, 1192 (9th Cir. 1989) (explaining that the "principal difference" between Rule 12(b)(6) and Rule 12(c) "is the timing of filing"); *see also U.S. ex rel. Cafasso v. Gen. Dynamics C4 Sys.*, 637 F.3d 1047, 1054 n.4 (9th Cir. 2011). Therefore, all allegations of fact by the party opposing the motion are accepted as true, and the complaint is construed in the light most favorable to the non-moving party. *McGlinchey v. Shell Chem. Co.*, 845 F.2d 802, 810 (9th Cir. 1988).

As with Rule 12(b)(6) motions, "[g]enerally, a district court may not consider any material beyond the pleadings . . . [but] material which is properly submitted as part of the complaint may be considered." *Hal Roach Studios, Inc. v. Richard Feiner & Co.*, 896 F.2d 1542, 1555 n.19 (9th Cir. 1990) (citations omitted). Similarly, "documents whose contents are alleged in a complaint and whose authenticity no party questions, but which are not physically attached to the pleading, may be considered in ruling on a Rule 12(b)(6) motion to dismiss," or on a Rule 12(c) motion without converting the motion

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into a motion for summary judgment. *Branch v. Tunnell*, 14 F.3d 449, 454 (9th Cir. 1994), *overruled on other grounds by Galbraith v. Cty. of Santa Clara*, 307 F.3d 1119 (9th Cir. 2002). If the documents are not physically attached to the complaint, they may be considered if their “authenticity . . . is not contested” and “the plaintiff’s complaint necessarily relies” on them. *Parino v. FHP, Inc.*, 146 F.3d 699, 705–06 (9th Cir. 1998), *superseded by statute on other grounds by Abrego Abrigo v. The Dow Chem. Co.*, 443 F.3d 676 (9th Cir. 2006).

The Court, however, need not accept as true allegations contradicted by judicially noticeable facts, *see Shwarz v. United States*, 234 F.3d 428, 435 (9th Cir. 2000), and it “may look beyond the plaintiff’s complaint to matters of public record” without converting the Rule 12(c) motion into a motion for summary judgment, *Shaw v. Hahn*, 56 F.3d 1128, 1129 n.1 (9th Cir. 1995). Nor must the Court “assume the truth of legal conclusions merely because they are cast in the form of factual allegations.” *Fayer v. Vaughn*, 649 F.3d 1061, 1064 (9th Cir. 2011) (per curiam) (internal quotation marks omitted). Mere “conclusory allegations of law and unwarranted inferences are insufficient” to defeat a motion for judgment on the pleadings. *Adams v. Johnson*, 355 F.3d 1179, 1183 (9th Cir. 2004).

### III. Discussion

The Patent Trial and Appeal Board (“PTAB”) has conducted *inter partes* reviews (“IPRs”) involving the ’728 Patent as well as its parent patent, United States Patent No. 7,062,296 (“the ’296 Patent”). Defendants argue that just as this Court applied collateral estoppel to bar Plaintiff from asserting invalid claims of the ’231 patent, it should now apply collateral estoppel to bar Plaintiff’s assertion of Claims 3, 4, 5, and 12 of the ’728 Patent, which Defendants argue are “materially the same” as the claims invalidated in the IPR proceedings. Mot. at 1.

Plaintiff responds that collateral estoppel does not apply because: (1) the asserted claims are materially different than the claims that were previously adjudicated in administrative proceedings; and (2) the administrative proceedings relied upon by Defendants involved a different claim construction standard and a lower burden of proof than applies here in district court.

#### A. Timeliness of Plaintiff’s Claim Construction Arguments

The Court first addresses Defendants’ claim that “[i]n an attempt to avoid the[] [PTAB] findings that apply equally to the virtually identical language of the new and old

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claims, XR makes belated claim construction arguments that it did not raise during the claim construction phase of this case.” Reply at 1. Defendants argue:

The crux of XR’s argument is that the PTAB did not find that the uplink transmissions of the prior art at issue in the IPRs were sent *in response to* a probe message. Opp. at 5-6. But this is not required by the claims. The phrase “in response to” does not appear in the claims, and nothing in asserted claims 3, 4, 5 or 12 requires “the uplink transmission” or “uplink transmittable messages” to be transmitted by the receiving device *in response to* a probing signal. It certainly is not based on a plain and ordinary reading of the claims. Instead, XR’s argument is therefore premised on a misreading of the claims or a claim construction argument according to which XR reads this limitation into the claims. But XR did not preserve this claim construction argument.

*Id.* at 3.

Defendants argue that “XR was on notice of Defendants’ collateral estoppel position because every Defendant raised the affirmative defense of collateral estoppel in its Answer and attached all the relevant IPR filings as exhibits,” and Defendants therefore conclude that “XR has waived the claim construction position it puts forth in its response.” *Id.* (citation omitted). Effectively, Defendants argue that Plaintiff has waived any claim construction arguments that Plaintiff did not present during disclosures and briefing on claim construction in the above-captioned case. At the March 28, 2022 hearing, Defendants reiterated that any claim construction issues should have been raised during the claim construction proceedings before the Special Master.

The Federal Circuit has noted that claim construction arguments can be waived. *See Cent. Admixture Pharmacy Servs., Inc. v. Advanced Cardiac Solutions, P.C.*, 482 F.3d 1347, 1356 (Fed. Cir. 2007) (“The district court found that ACS waived any argument with respect to this term by failing to raise it during the claim construction phase. We agree. Since ACS has not preserved this argument before the district court, we do not reach it here.”); *see also Fenner Invest., Ltd. v. Microsoft Corp.*, 632 F. Supp. 2d 627, 638 (E.D. Tex. 2009) (in granting summary judgment, finding that because an argument was “contrary to the claim construction order and was not raised prior to or even following the claim construction hearing it is waived”) (citing *Cent. Admixture*), *aff’d*, 369 F. App’x 132 (Fed. Cir. Mar. 15, 2010). For example, the Court may find waiver where a party proposes a narrow interpretation after claim construction proceedings have been held. *See Spigen Korea Co. Ltd v. Ispeaker Ltd.*, No. 2:16-CV-08559-DOC, 2018 WL 6038300, at \*19 (C.D. Cal. July 16, 2018).

In the present case, Defendants filed their Answer on August 11, 2021, and this Answer attaches the IPR decisions that Defendants rely upon for their collateral estoppel arguments. *See* Dkt. 228.

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Defendants filed the present Motion on February 18, 2022, after the parties filed their opening claim construction briefing on November 30, 2021 (Dkts. 256, 257), after the parties filed their responsive claim construction briefing on December 30, 2021 (Dkts. 272, 273), after the Special Master conducted a claim construction hearing on January 18, 2022 (Dkt. 279), after the Special Master entered a Special Master Report and Recommendation on Claim Construction on January 27, 2022 (Dkt. 280-1), and after Defendants filed their objections thereto (Dkt. 284).

The interpretation of the claims by Plaintiff in its Opposition to Defendants’ present Motion is *responsive to the arguments presented by Defendants* in their Motion, which Defendants filed *after the conclusion of claim construction proceedings* with the Special Master (and indeed after the deadline for filing objections to the Special Master’s claim construction recommendations<sup>1</sup>). Accordingly, the Court finds that Plaintiff’s claim interpretation arguments are not untimely.

**B. Collateral Estoppel**

Defendants argue that “[n]ewly-asserted claims 3–5 and 12 of the ’728 patent are virtually identical to claims 5–7 of the ’296 patent that were previously invalidated by the PTAB [(Patent Trial and Appeal Board)],” and that “independent claims 1 and 7 of the ’728 patent—from which the newly-asserted claims depend—are simply method claims corresponding to the apparatus claim 16 of the ’728 patent also previously invalidated by the PTAB, with any differences in claim language being immaterial to the issue of validity.” Mot. at 1–2. Defendants further argue that “XR had a full and fair opportunity to litigate [these issues in the IPR proceedings], and the [PTAB] reached a final judgment on the merits.” *Id.* at 23–25.

Plaintiff responds that the legal standards in IPR proceedings are different from the legal standards that apply in district court litigation and, moreover, Plaintiff argues

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<sup>1</sup> Defendant’s pending motion is a “Corrected” Motion filed on February 18, 2022, which followed the filing of an original Motion on February 17, 2022. (*Compare* Dkt. 286 *with* Dkt. 285.) February 17, 2022 was the deadline for filing any objections to the Special Master Report and Recommendation on Claim Construction. *See* Fed. R. Civ. P. 53(f)(2). Even assuming for the sake of argument that Plaintiff had any meaningful opportunity to review Defendants’ original motion (Dkt. 285) before the end of the February 17, 2022 deadline for filing claim construction objections, any such objection by Plaintiff based on Defendants’ original motion (Dkt. 285) would likely have been outside the scope of the Special Master Report and Recommendation on Claim Construction. That is, Federal Rule of Civil Procedure 53(f)(2), as applicable in this instance, provided an opportunity for the parties to object to the recommended claim constructions, not an opportunity to introduce new claim construction arguments.

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that Claims 3, 4, 5, and 12 of the '728 Patent are materially different from the claims that were at issue in the IPR proceedings. Opp'n at 1. Plaintiff also notes that, "in federal courts, accused infringers must prove each patent claim invalid by clear and convincing evidence, whereas petitioners in IPRs only need to establish unpatentability by a preponderance of the evidence." *Id.* at 3 (citing *Aylus Networks Inc. v. Apple Inc.*, 856 F.3d 1353, 1360–61 (Fed. Cir. 2017)).

At the March 28, 2022 hearing, Defendants reiterated their arguments and also emphasized, for example, *Chrimar Systems Inc. v. Ruckus Wireless, Inc.*, No. 16-CV-00186, -558, -624, -897, 2020 WL 4431787 (N.D. Cal. July 31, 2020), as an example of applying the principle that "[i]f the differences between the unadjudicated patent claims and adjudicated patent claims do not materially alter the question of invalidity, collateral estoppel applies." *Id.* at \*5 (quoting *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013)).

Defendants also submitted a Notice of Pendency of Other Actions or Proceedings regarding ongoing IPR proceedings regarding the '728 Patent and the '376 Patent and in which the USPTO has entered an office action rejecting certain claims of the '728 Patent. *See* Dkt. 293, March 23, 2022 Notice. Plaintiff responded that this recent office action is irrelevant because collateral estoppel can arise only from a *final* determination. Defendants replied that this office action demonstrates that Defendants are not alone in their belief that the asserted claims in the present case are not materially different from the claims that have been invalidated in the past.

The law of the regional circuit applies to the general procedural question of whether issue preclusion (or collateral estoppel) applies in a patent infringement suit. *Soverain Software LLC v. Victoria's Secret Direct Brand Mgmt., LLC*, 778 F.3d 1311, 1314 (Fed. Cir. 2015). The requirements for collateral estoppel in the Ninth Circuit are: (1) the issue necessarily decided at the previous proceeding is identical to the one which is sought to be relitigated; (2) the first proceeding ended with a final judgment on the merits; and (3) the party against whom collateral estoppel is asserted was a party or in privity with a party in the first proceeding. *Hydranautics v. FilmTec Corp.*, 204 F.3d 880, 885 (9th Cir. 2000).

In contrast, Federal Circuit law applies to questions of substantive patent law. *See, e.g., In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 803 (Fed. Cir. 2000). The Federal Circuit has held that "an invalidity finding, whether from a district court or the [Patent Trial and Appeal] Board, has a collateral estoppel effect on all pending or co-pending actions." *XY, LLC v. Trans Ova Genetics*, 890 F.3d 1282, 1294 (Fed. Cir. 2018).

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The Federal Circuit has noted that “the collateral-estoppel effect of an administrative decision of unpatentability generally requires the invalidation of related claims that present identical issues of patentability.” *MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1376–77 (Fed. Cir. 2018).

“If the differences between the unadjudicated patent claims and adjudicated patent claims do not materially alter the question of invalidity, collateral estoppel applies.” *Id.* (citations omitted); *see NetAirus Techs., LLC v. Apple Inc.*, No. 2:13-CV-03780-JAK, 2016 WL 5898640, at \*2 (C.D. Cal. Mar. 23, 2016) (“Under Federal Circuit precedent, the key inquiry in determining the collateral estoppel effect of a previous adjudication is whether specific issues related to a patent’s validity were determined there. Collateral estoppel only applies to unadjudicated claims if the differences between the unadjudicated and adjudicated patent claims do not materially alter the question of invalidity.”) (citations omitted); *cf. Aspex Eyewear, Inc. v. Zenni Optical Inc.*, 713 F.3d 1377, 1381 (Fed. Cir. 2013) (“Aspex states that the newly-asserted claims contain limitations that were not previously construed and applied. However, every claim asserted against Zenni contains the same ‘retaining mechanism’ limitation, in the same context, that the Federal Circuit in *Altair III* found dispositive of non-infringement. The Zenni and Altair products are materially identical. In such circumstances, the assertion of different claims in a subsequent suit does not create a new ‘issue’ to defeat preclusion.”).

Defendants also submit that the PTAB acknowledged that the “phased array antenna” in asserted Claims 3–5 and 12 of the ’728 Patent is equivalent to the “smart antenna” in the previously adjudicated Claims 5–7 of the ’296 Patent. *See* Dkt. 228-18 at 14–15. Further, Plaintiff does not appear to challenge that the “receiving device” recited in asserted Claims 3–5 and 12 of the ’728 Patent is equivalent to the “second device” recited in adjudicated Claims 5–7 of the ’296 Patent. Defendants submit that the specification of the ’728 Patent confirms this equivalence. *See* ’728 Patent at 1:17–3:67 (referring to “receiving device,” “second device,” and “client device”).

### 1. Claims 4 and 12

With respect to Claim 4 of the ’728 Patent, Defendants argue:

According to XR, the antecedent basis of the “uplink transmission” is recited in claim 1 and refers to messages received in response to a probing signal. However, claim 1 discloses receiving two types of messages and uses different claim language for each: (i) an uplink transmission, and (ii) uplink transmittable messages. Limitation 1[b] discloses “receiving an uplink transmission from the receiving device.” This limitation has nothing to do with active probing. Separately, limitations 1[e] and 1[f] disclose actively probing the receiving device and receiving uplink transmittable messages in response to the probing message.

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Reply at 5–6.

As to Claim 12 of the '728 Patent, Defendants argue: “While claim 12 depends from claim 7 instead of claim 1, it has the same scope as claim 4 of the '728 Patent and, as Defendants previously explained, previously invalidated claim 6 of the '296 Patent contains the same additional limitation. *See* Mot. at 20–21.” Reply at 7. Defendants further argue that “XR, much like it did for claim 4, points to the wrong antecedent basis and its proposed construction contradicts the claim language and the specification.” *Id.* at 8. At the March 28, 2022 hearing, Defendants argued that Plaintiff is improperly conflating the “uplink transmission” and the “uplink transmittable messages” recited in these claims.

Plaintiff responds that whereas “claims 4 and 12 [of the '728 Patent] each require a ‘feedback’-based methodology to determine the current position of receiving devices based on probe response messages coming from the receiving device,” “the Petitioners in the IPR proceedings had no argument that determining the current position of receiving devices from uplink transmitted probe response messages was satisfied by the prior art.” Opp’n at 5–7. Plaintiff further argues:

Defendants assert that the claims from a different patent—the '296 Patent—are materially the same as the adjudicated '728 Patent claims. Mot. at 20. However, the problem is that Defendants cannot identify any claim from the '296 Patent that requires “determining a current position of the receiving device” from the uplink transmissions received in response to probing signals—and this materially alters the question of invalidity, as shown below.

*Id.* at 8. Plaintiff submits that “none of the prior art analyzed by the PTAB—including [the] Hovers, Jetzek, Reudink, and Antonio [references]—involved probing signals as a means of determining current position of receiving devices.” *Id.* at 9; *see id.* at 9–11.

Moreover, Plaintiff argues:

[C]laim 4, which depends from claim 1, requires *actively probing* the receiving device, *gathering signal parameter information* from *uplink transmittable messages* that are received as feedback from the receiving devices in response to the probing message, and “*determining a current position of the receiving device . . . from the uplink transmission* that is received from the receiving device.” Thus, because of the antecedent basis (as with claims 7 and 12), the “uplink transmission” recited in claim 1 that is received in response to the probing signal must itself be used to determine current device position as recited in dependent claim 4. '728 Patent, cl. 1, 4[.]

Similarly, the method of claim 12, which depends from claim 7, requires “determining information about a current position of the receiving device . . . from *the* uplink transmission,” which refers to the “uplink transmitted probe response message” recited in



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claim 7. '728 Patent, cl. 7, 12. The “uplink transmission” refers to “*the* uplink transmitted probe response message” recited in claim 7 that is received in response to the probe message. '728 Patent, cl. 7, 12.

[D]etermining current position of the receiving device using uplink transmissions received in response to probing signals is materially different from the previously adjudicated claims, and the difference materially alters the question of validity.

*Id.* at 6.

Plaintiff’s arguments demonstrate a claim construction dispute (regarding the proper antecedent basis for “the uplink transmission”) that precludes entry of judgment on the pleadings as to Claims 4 and 12 of the '728 Patent.

Also, the difference between the claim construction standard in the IPR proceedings and the claim construction standard that is applicable in the above-captioned litigation weighs further against applying collateral estoppel where, as here, the parties have differing interpretations of the asserted claims. *See, e.g., SkyHawke Techs., LLC v. Deca Int’l Corp.*, 828 F.3d 1373, 1376 (Fed. Cir. 2016) (“Because the Board applies the broadest reasonable construction of the claims while the district courts apply a different standard of claim construction as explored in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), the issue of claim construction under *Phillips* to be determined by the district court has not been actually litigated.”); *Papst Licensing GmbH & Co., KG v. Samsung Elecs. Co., Ltd.*, 403 F. Supp. 3d 571, 602 (E.D. Tex. 2019) (“The parties do not present, and the Court has not found, any binding precedent addressing whether a finding of invalidity under the preponderance of the evidence standard in an IPR collaterally estops invalidity arguments for separate, unadjudicated claims under the clear and convincing standard in a district court.”).

As to Defendants’ argument that the prior art cited in the IPR proceedings invalidates these claims even under Plaintiff’s interpretation of the claims, Reply at 8–11, this is a factual issue not appropriate for resolution on a Rule 12(c) motion. *See, e.g., McGlinchey*, 845 F.2d at 810.

Accordingly, the Court DENIES Defendants’ motion as to Claims 4 and 12.

## 2. Claim 5

As to Claims 3 and 5 of the '728 Patent, Plaintiff argues that “[adjudicated] claim 7 of the '296 patent does not include the requirement in claim 5 of the '728 patent (which depends from claim 1) requiring *actively probing* and *gathering signal parameter*

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*information*, which are limitations not found in claim 7 of the '296 patent or claim 1 of the '296 patent (from which claim 7 depends).” Opp’n at 12. Plaintiff further contends:

The Petitioners never alleged, and the PTAB never found, that Hovers, Jetzek, Reudink, or Antonio disclosed *actively probing* receiving devices, *gathering signal parameter information* from uplink transmissions in response to the probing signal, and *comparing* information determined from “the uplink transmission” (i.e., the uplink transmission in response to the probing signal) to corresponding beam association threshold information to determine if the receiving device should operatively associate with the different beam downlink. Indeed, Defendants’ motion includes purely conclusory, attorney argument and no substantive analysis of '728 claim 5 and these material differences to claim 7 of the '296 patent. Mot. at 21–22. Whether claim 5 is novel poses a materially different question of patentability, which precludes collateral estoppel.

Opp’n at 12.

Defendants argue that, as with Claim 4, “XR reiterates its incorrect argument that the ‘uplink transmission’ is received in response to a probing signal.” Reply at 6. Further, Defendants argue that “XR does not dispute the PTAB’s findings that the prior art in both the Aruba IPRs and the Ruckus IPRs discloses all the limitations of claim 5. XR’s argument that the PTAB never found that this specific combination was invalid is irrelevant.” *Id.* at 7 (footnote omitted).

As Plaintiff argues, neither Claim 7 of the '296 Patent nor Claim 1 of the '296 Patent (from which Claim 7 depends) recites “actively probing.” Also, Plaintiff’s antecedent basis argument is present here as well in Plaintiff’s arguments regarding differences between Claim 5 of the '728 Patent (based on limitations in Claim 1 of the '728 Patent, from which Claim 5 depends) and the adjudicated claim relied upon by Defendants, namely adjudicated Claim 7 of the '296 Patent. In particular, Plaintiff argues that the PTAB did not find any prior art disclosure of “comparing information determined from ‘the uplink transmission’ (i.e., the uplink transmission in response to the probing signal) to corresponding beam association threshold information to determine if the receiving device should operatively associate with the different beam downlink.” Opp’n at 12 (emphasis omitted).

As the Court noted above, the difference between the IPR claim construction standard and the claim construction standard applicable in this litigation weighs against applying collateral estoppel where, as here, the parties have differing interpretations of the asserted claims. *See, e.g., SkyHawke*, 828 F.3d at 1376; *Papst*, 403 F. Supp. 3d at 602.

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Plaintiff's arguments therefore demonstrate that Defendants' Motion for judgment on the pleadings should be denied as to Claim 5 of the '728 Patent. As to Defendants' argument that the prior art cited in the IPR proceedings invalidates this claim even under Plaintiff's interpretation of the claims, Reply at 8–11, this is a factual issue not appropriate for resolution on a Rule 12(c) motion. *See McGlinchey*, 845 F.2d at 810. Accordingly, the Court DENIES Defendants' motion as to Claim 5.

**3. Claim 3**

As Defendants reiterated at the March 28, 2022 hearing, Plaintiff does not present any specific argument as to Claim 3 of the '728 Patent. As Defendants argue: "XR . . . only raises arguments for claim 5 of the '728 Patent and then simply says that 'claim 3 is similarly flawed.' Opp'n at 12. For this reason, XR should be deemed to have waived the ability to argue that claim 3 is not invalid based on its new-found claim construction argument." Reply at 4.

Although Plaintiff discusses Claim 5 of the '728 Patent as an "example" in a section of Plaintiff's brief that identifies Claims 3 and 5, Claim 3 of the '728 Patent recites "uplink transmittable messages," not "the uplink transmission" as in the "example" of Claim 5. Plaintiff thus does not rebut Defendants' assertion that "dependent claim 3 of the '728 patent (which depends from claim 1) and [adjudicated] claim 5 of the '296 patent each claim the same features of (i) actively probing over the beam and the different beam; and (ii) gathering signal parameter information from uplink transmittable messages (iii) received through the phased array/smart antenna: . . . ." Mot. at 19.

Plaintiff's general reliance on the difference in burdens of proof between the IPR proceedings and the present district court litigation is insufficient to avoid judgment on the pleadings as to Claim 3 of the '728 Patent. That is, Plaintiff has not persuasively demonstrated that the difference in the legal standards for invalidity necessarily precludes applying collateral estoppel *in the absence of any demonstration of material differences* between the asserted claim and the previously adjudicated claim relied upon by Defendants' Motion. This finding as to Claim 3 of the '728 Patent is consistent with the above-discussed Federal Circuit decisions. *See, e.g., MaxLinear*, 880 F.3d at 1376–77 ("If the differences between the unadjudicated patent claims and adjudicated patent claims do not materially alter the question of invalidity, collateral estoppel applies." (internal citations omitted)).

Accordingly, the Court GRANTS Defendants' motion as to Claim 3.

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**4. Claims 1 and 7**

At the March 28, 2022 hearing, Defendants proposed that the Court should also find that collateral estoppel applies to Claims 1 and 7 of the '728 Patent. Although the parties' briefing on the present motion addresses Claims 1 and 7 of the '728, the briefing does so in relation to Defendants' arguments as to Claims 3, 4, 5, and 12, and Defendants' have not moved for judgment on the pleadings as to Claims 1 and 7. *See* Dkt. 286; *see also* Mot. at 24–25. The Court therefore DENIES Defendants' request for judgment on the pleadings as to Claims 1 and 7 of the '728 Patent.

**C. Supplemental Claim Construction**

Defendants argue that further claim construction would be inappropriate because Plaintiff's interpretation is contrary to the plain language of the claims. Reply at 4.

The Northern District of California, for example, has discussed presentation of evidence and argument regarding claim terms that have not been construed:

Where, as here, parties did not seek construction of the terms at issue, courts give those terms their ordinary and customary meaning . . . to a person of ordinary skill in the art in question at the time of the invention. At trial, parties may introduc[e] evidence as to the plain and ordinary meaning of terms not construed by the Court to one skilled in the art, so long as the evidence does not amount to argu[ing] claim construction to the jury.

*Apple, Inc. v. Samsung Elecs. Co.*, No. 12-CV-00630-LHK, 2014 WL 660857, at \*3 (N.D. Cal. Feb. 20, 2014) (internal citations and quotation marks omitted). As a further example, another court in this district applied these principles as follows:

The appropriateness of evidence related to a term's plain and ordinary meaning is generally judged in the context of the trial. In this context, a dispute over a patent involving trampolines, allowing an expert to testify that the file history of the '350 Patent "states that when a user jumps on a trampoline, 'the force of the *vertical* component levied on the frame is much greater than that of the horizontal component'" seems appropriate. . . . Mr. Smith does not plan to "discuss the finer points of . . . claim-construction canons," but rather "offers the perspective and understanding of a person of ordinary skill in the art who has reviewed the entire intrinsic record." . . . Mr. Smith is therefore permitted to testify as to his understanding of the plain and ordinary meaning of "stress" in this context.

*Sportspower Ltd. v. Crowntec Fitness Mfg., Ltd.*, No. 8:17-CV-02032-JLS, 2020 WL 7347860, at \*3–\*4 (C.D. Cal. Nov. 18, 2020) (citing *Apple*, 2014 WL 660857, at \*3) (internal citation and quotation marks omitted). This discussion in *Sportspower* is notable

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for its explanation that the parties’ experts would not be debating “the finer points of . . . claim-construction canons.” *Id.*

In the same vein, the Northern District noted in *Apple* that “[a]rguing claim construction to the jury is inappropriate because it risks confusion and the likelihood that a jury will render a verdict not supported by substantial evidence.” *Apple*, 2014 WL 660857, at \*3. Indeed, the Federal Circuit has found that “[w]hen the parties raise an actual dispute regarding the proper scope of these claims, the court, not the jury, must resolve that dispute.” *O2 Micro*, 521 F.3d at 1360; *see id.* at 1362 (“When the parties present a fundamental dispute regarding the scope of a claim term, it is the court’s duty to resolve it.”).

Here, the parties present competing interpretations of not-previously-construed terms based, at least in part, on a disagreement regarding the proper antecedent basis for “the uplink transmission.” This is not a factual question for the jury. It is a legal question of claim construction. *See id.*

Accordingly, the Court REFERS this matter to the Special Master for whatever supplemental claim construction proceedings the Special Master deems appropriate to resolve the claim construction issues raised by Plaintiff in response to Defendants’ Motion as to Claims 4, 5, and 12 of the ’728 Patent.

#### **IV. Disposition**

For the reasons given above, Defendants’ Corrected Motion for Judgment on the Pleadings on Asserted Claims 3, 4, 5, and 12 of the ’728 Patent is hereby GRANTED IN PART as follows: the Court GRANTS Defendants’ Motion as to Claim 3 of the ’728 Patent, and DENIES Defendants’ Motion as to Claims 4, 5, and 12 of the ’728 Patent.

Further, the Court REFERS this matter to the Special Master for whatever supplemental claim construction proceedings the Special Master deems appropriate to resolve the claim construction issues raised by Plaintiff in response to Defendants’ Motion as to Claims 4, 5, and 12 of the ’728 Patent.

The Clerk shall serve this minute order on the parties.

Initials of Deputy Clerk: dca/kdu