

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

STARZ ENTERTAINMENT, LLC,  
STARZ, LLC,  
STARZPLAY MANAGEMENT US, LLC  
and STARZPLAY US, LLC

Plaintiffs/Counter-Defendants,

v.

VL COLLECTIVE IP, LLC and  
VIDEOLABS, INC.,

Defendants/Counter-Plaintiffs.

C.A. No. 21-1448-JLH

**JURY TRIAL DEMANDED**

**JOINT CLAIM CONSTRUCTION BRIEF**

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**JOINT APPENDIX**

| <b>Exhibit</b> | <b>Description</b>                                                                                                                                                                                                                                                                                                   |
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| 1              | U.S. Patent No. 7,233,790 (the “790 patent”)                                                                                                                                                                                                                                                                         |
| 2              | U.S. Patent No. 7,440,559 (the “559 patent”)                                                                                                                                                                                                                                                                         |
| 3              | U.S. Patent No. 8,605,794 (the “794 patent”)                                                                                                                                                                                                                                                                         |
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**I. AGREED UPON CONSTRUCTIONS****A. U.S. Patent No. 8,605,794: “output” / “outputting”**

| <b>Term</b>                                                    | <b>Agreed-Upon Construction</b>                                                                                                                |
|----------------------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------|
| “output” /<br>“outputting”<br><br>(’794 Patent Claims<br>1, 9) | “transmitted, stored together, or passed on to a<br>processing unit” / “transmitting, storing together, or<br>passing on to a processing unit” |

**B. U.S. Patent No. 8,605,794: Preambles**

| <b>Term</b>                                   | <b>Agreed-Upon Construction</b>                                                                                                                                                                       |
|-----------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Preambles<br><br>(’794 Patent Claims<br>1, 9) | The preambles are construed to be limiting. In addition<br>to the other limitations set forth in the preamble, the<br>referenced first data file and second data file cannot be<br>the same data file |

**II. DISPUTED CONSTRUCTIONS****A. U.S. Patent No. 7,233,790: “wireless communication devices” / “wireless device”**

| <b>Term</b>                                                                                             | <b>Starz’s Construction</b>                                                                                                                                 | <b>VideoLabs’ Construction</b>                                                                                                                                                                                        |
|---------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| “wireless<br>communication<br>devices” / “wireless<br>device”<br><br>(Claims 1, 2, 4, 5, 6,<br>7, 8, 9) | “Personal mobile<br>communication and<br>computing devices, such as<br>cellular telephones,<br>personal digital assistants<br>(PDAs) and two-way<br>pagers” | No construction necessary<br><br>Alternatively, if the Court<br>decides to construe the<br>term, “an electronic or<br>electrical device capable of<br>remote wireless<br>communication, including<br>Internet access” |

## 1. Plaintiff's Opening Position

Starz proposes that the terms “wireless communication devices” and “wireless device” be given the definition provided by the patentee in the specification. The ’790 patent provides an express definition of “wireless device[s]”:

*Personal mobile communication/computing devices, such as cellular telephones, personal digital assistants (PDAs) and two-way pagers, have become commonplace in many countries. These devices **are** referred to collectively herein as “mobile devices” or “**wireless devices**”.*

Ex. 1, 1:22-26.

Where, as here, a patent’s specification “reveal[s] a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess,” “the inventor’s lexicography governs.” *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc). When a term “is set off by quotation marks” it is a “strong indication” that the term has been given a special definition. *Sinorgchem Co., Shan-dong v. Int’l Trade Comm’n*, 511 F.3d 1132, 1136 (Fed. Cir. 2007). Moreover, the definition’s use of “is” or “are” signifies that the patentee is serving as its own lexicographer. *See id.*

These indicia of the patentee acting as its own lexicographer are present in the ’790 patent’s definition of “wireless device, i.e.,” “[p]ersonal mobile communication and computing devices, such as cellular telephones, personal digital assistants (PDAs) and two-way pagers.” Starz proposes the same definition. A POSITA would

understand “wireless communication devices” to be synonymous with the “wireless devices” because the specification provides that “wireless devices” are also “communication” devices, as shown above. *See* Ex. 1, 1:22-26.

Starz’ construction is also supported by other intrinsic evidence. For example, the title of the ’790 Patent makes clear that the claimed wireless devices are “Wireless **Mobile** Devices” (*see* Ex. 1, Title).<sup>1</sup> *Ruckus Wireless, Inc. v. Innovative Wireless Sols., LLC*, 824 F.3d 999, 1003 n.2 (Fed. Cir. 2016) (A title of a patent may be used to “aid in claim construction”).

Moreover, the specification of the ’790 patent repeatedly references the technology of personal **mobile** devices. *See, e.g.*, Ex. 1, 1:40-45 (there is an increasing demand among users of **mobile** devices for new types of digital content); 1:45-59 (it is desirable to have a centralized store from which **mobile** device users can acquire many different types of digital content); 2:7-15 (discussing difficulty for content suppliers to keep up with changes in mobile device capabilities); 8:37-45 (“An actual device is a particular make and model of client device, such as ‘Nokia 63100’” mobile phone). A POSITA would understand the specification’s “[e]xtensive, consistent usage” of terminology specific to mobile devices to mean that “wireless devices” are limited to “personal **mobile** communication and computing devices, such as cellular telephones, personal digital assistants (PDAs)

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<sup>1</sup> Emphases added throughout unless otherwise indicated.

and two-way pagers.” *See Saffran v. Johnson & Johnson*, 712 F.3d 549, 560 (Fed. Cir. 2013).

Furthermore, the requirement that a “wireless device” be a “mobile” device is consistent with the ’113 patent’s prosecution history.<sup>2</sup> In response to a prior art rejection, the patentee stated that “[i]n contrast to the method of claim 1,” the prior art reference failed to mention a problem associated with digital products being accessed “by *mobile devices*.” Ex. 5, 16-17 (Dec. 16, 2020 Resp. to NFOA).

Because the specification “explains and defines” “wireless device” “without ambiguity or incompleteness,” “there is no need to search further for the meaning of the term.” *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1478 (Fed. Cir. 1998). Yet, VideoLabs erroneously attempts to do just that. VideoLabs first asserts that “no construction is necessary” for this claim term. However, this is improper when, as here, “reliance on a term’s ‘ordinary’ meaning does not resolve the parties’ dispute.” *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co., Ltd.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008).

VideoLabs alternatively asserts that the term should mean “an electronic or electrical device capable of remote wireless communication, including Internet access.” But VideoLabs’ construction deviates from the definition expressly set forth

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<sup>2</sup> As noted by VideoLabs in footnote 5 below, the ’790 and ’113 patents share a common specification.

in the specification, by which—as discussed above—“wireless devices” are “*mobile* devices,” not generic devices that are capable of remote wireless communication. VideoLabs’ proposed definition should be rejected because it is overly broad and lacks foundation in the intrinsic record.

## 2. Defendant’s Answering Position

Starz’s proposed construction improperly narrows the claim scope to exclude embodiments from the specification<sup>3</sup> and contrary to the claim term’s plain meaning. Starz’s proposed construction should be rejected.

Starz contends that the ’790 patent provides an express definition of “wireless devices,” but to do so, Starz must show that the inventors clearly intended to define the term through lexicography. *See Thorner v. Sony Computer Ent. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012); *Wasica Fin. GmbH v. Cont’l Auto Sys., Inc.*, 853 F.3d 1272, 1281 (Fed. Cir. 2017). Absent a clear disavowal in the specification or the prosecution history, “[t]he patentee is free to choose a broad term and expect to obtain the full scope of its plain and ordinary meaning ... .” *Thorner*, 669 F.3d at 1367. Lexicography requires a “clear expression of intent necessary for a patentee to act as its own lexicographer.” *Medicines Co. v. Mylan, Inc.*, 853 F.3d 1296, 1306 (Fed. Cir. 2017). Starz fails to make the requisite showing.

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<sup>3</sup> The ’790 and ’113 patents share a common specification.

Starz points to a single statement from the specification as the alleged lexicography in question:

Personal mobile communication/computing devices, such as cellular phones, personal digital assistants (PDAs) and two-way pagers have become commonplace in many countries. These devices are referred to collectively herein as “mobile devices” or “wireless devices.”

Op. Br. at 2 (quoting ’790 patent at 1:22-26). Starz then seeks to ascribe special meaning to this statement, alleging that indicia such as the use of quotation marks, use of the terms “is” or “are,” and the title of one of the two patents signify the patentee acts as its own lexicographer.<sup>4</sup> Op. Br. at 2-3. However, the full specification demonstrates that the statement Starz relies on is not intended to be lexicographical.

For example, the specification describes “digital content,” “digital product,” “content,” and “product” as “software and/or data embodying things such as games and other applications, applets or the like; images; screensavers; wallpaper; ring tones; etc., particularly (*but not necessarily exclusively*) those designed for use in mobile devices ... .” Ex. 1 at 3:48-54.<sup>5</sup> The specification goes on to make clear that assumptions are made in the specification “[t]o facilitate description,” but that the

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<sup>4</sup> Starz’s discussion of indicia also includes an apparent misquote of the ’790 patent with respect to the definition of “wireless device,” appending an “i.e.” without citation. Op. Br. at 2. To be clear, the ’790 patent specification does not use an “i.e.” to define “wireless device” as suggested by Starz.

<sup>5</sup> Emphases added throughout (unless otherwise noted).

techniques of the '790 patent are not limited to mobile devices as Starz would have it:

***To facilitate description***, it is henceforth *assumed* herein that the customers are users of mobile devices and, therefore are subscribers of w[ire]less devices (although that need not be the case); thus, customers are henceforth called “subscribers” herein. ***Note, however, that the techniques described herein need not be limited to wireless services subscribers or mobile client devices.***

Ex. 1 at 4:26-32. The same goes for Starz’s argument that the title of the '790 patent should be interpreted to limit the scope of the claims of the '790 patent—to say nothing of the '113 patent (Title: Domain-Based Management of Distribution Of Digital Content From Multiple Suppliers To Multiple Wireless Services Subscribers)—despite the clear disclosures of the specification suggesting the patentee intended nothing of the sort. *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1312 (noting “[t]he near irrelevancy of the patent title to claim construction” and that “the purpose of the title is not to demarcate the precise boundaries of the claimed invention but rather to provide a useful reference tool for future classification purposes”); *Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091, 1111 (Fed. Cir. 2000) (“the bar on importing limitations from the written description into the claims applies no less forcefully to a title”).

Starz next argues that the specification of the '790 patent references technology associated with personal mobile devices, Op. Br. at 3-4, but again ignores

the disclosures of the specification in its attempt to improperly restrict the claim scope. As noted previously, the specification is unequivocal that “the techniques described herein need not be limited to wireless services subscribers or *mobile* client devices.” Ex. 1 at 4:30-32. The specification goes on to say the following with respect to its embodiments:

Although the present invention has been described with reference to *specific exemplary embodiments*, it will be recognized that the invention is not limited to the embodiments described, but can be practiced with modification and alteration within the spirit and scope of the appended claims. *Accordingly, the specification and drawings are to be regarded in an illustrative sense rather than a restrictive sense.*

Ex. 1 at 15:11-18. Starz’s citation of *Saffran* is unavailing in light of the clear intent of the patentee in the specification to not disavow claim scope beyond mobile devices. *See Thorner*, 669 F.3d at 1366 (“It is likewise not enough that the only embodiments, or all of the embodiments, contain a particular limitation. We do not read limitations from the specification into claims; we do not redefine words. Only the patentee can do that.”).

Starz further argues that the prosecution history of the ’113 patent requires that a “wireless device” in the ’113 (and ’790) patent be a “mobile” device. Op. Br. at 4. But Starz misreads patentee’s argument in overcoming the cited prior art rejection. The distinction drawn by patentee against the Mineo reference cited by the examiner was that Mineo, while “silent as to ‘wireless,’ appears to depict wired

connections between the service users (101) and the network (201).” Ex. 5 at 16 (emphasis in original). This is consistent with the aforementioned disclosures of the specification, which make clear that the claimed techniques “need not be limited to wireless services subscribers or mobile client devices.” Ex. 1 at 4:30-32. The excerpt cited by Starz simply notes that the “digital products” of the claimed method *can* be accessed by mobile devices, not that they *must* be accessed by mobile devices only, which is consistent with the specification of the ’790 and ’113 patents.

For the reasons discussed above, a person having ordinary skill in the art (“PHOSITA”) would not understand the claim term to be limited to “personal mobile communication and computing devices” or “cellular telephones, personal digital assistants (PDAs) and two-way pagers” and Starz’s proposed construction should be rejected as it improperly seeks to restrict the claim scope. To the extent the Court finds the claim term requires construction, VideoLabs’ proposed construction should be adopted.

### **3. Plaintiff’s Reply Position**

VideoLabs’ argument—which focuses on different terms and generic catch-all language—attempts to divert attention away from the fact that the patentee provided an express definition of “wireless devices” in the specification. That the patentee concisely and directly gave this express definition in a “single statement” does not detract from its lexicographic effect. A definition need only be given once;

VideoLabs’ case law does not hold otherwise. Rather, VideoLabs’ case law supports Starz’s position. For example, in *Thorner v. Sony Computer Entertainment America LLC*, lexicography was not found because the proposed construction was based on *embodiments* rather than express definition; however, the court contrasted that scenario with other language that *is* lexicographic – language that is similar to that used in the ’790 patent. 669 F.3d 1362, 1367-68 (Fed. Cir. 2012). For example, the court explained that:

[I]n *3M Innovative Properties Co. v. Avery Dennison Corp.*, we held that the patentee acted as its own lexicographer when the specification stated: “‘**Multiple embossed’ means** two or more embossing patterns are superimposed on the web to create a complex pattern of differing depths of embossing.”

*Id.* at 1366.<sup>6</sup> The court’s example from *3M* shares the same indicia that VideoLabs attempts to minimize here: the use of quotation marks and a word or phrase expressly signifying definition. *See* Op. Br. at 2-3; Ans. Br. at 6. This point is made even more explicitly in *Medicines Co. v. Mylan Inc.*, the other case VideoLabs relies on. There, the court declined to give a statement lexicographic effect because it departed from the common format the patentee used to define other terms, specifically: “the defined term in quotation marks, followed by the terms ‘refers to’ or ‘as defined herein.’” *Meds. Co. v. Mylan, Inc.*, 853 F.3d 1296, 1306 (Fed. Cir. 2017).

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<sup>6</sup> Emphases added throughout (unless otherwise noted).

Here, as in the examples of lexicographic effect provided in VideoLabs' cited cases, the patentee placed "wireless devices" in quotation marks and stated that it "refer[s] to" "Personal mobile communication and computing devices, such as cellular telephones, personal digital assistants (PDAs) and two-way pagers." *See* Op. Br. at 2-3 (citing Ex. 1, 1:22-26).

VideoLabs' remaining arguments are similarly misplaced. For example, VideoLabs points to a citation stating that "digital content" may "not necessarily exclusively" be designed for use in mobile devices. Ans. Br. at 6 (citing Ex. 1, 3:48-54). But "digital content" is not the claim term under consideration here; rather, the issue is the construction of "wireless devices."

To support its overbroad construction that a "wireless device" as understood in the '790 patent can be *any* electrical device capable of wireless communication, VideoLabs attempts to elevate generic language above both the express definition and the specification's repeated, consistent references to personal mobile device technology. *See* Ans. Br. at 6-8; Op. Br. at 2-4. VideoLabs relies on language claiming that the "techniques described [in the specification] need not be limited to wireless services subscribers or mobile client devices" (Ex. 1, 4:26-32), and that the specification is to be regarded "in an illustrative sense rather than a restrictive sense" (Ex. 1, 15:11-18).

VideoLabs’ argument is flawed for several reasons. First, VideoLabs downplays the immediately preceding sentence in the specification, which provides that a “user of a mobile device” is “*therefore*” a “subscriber of wireless [sic] services.” (Ex. 1, 4:26-32). Thus, this passage equates *mobile devices* – and only mobile devices – with wireless devices. And, it does not disclose any embodiment or technology other than *personal mobile devices*—so VideoLabs’ contention that Starz’s construction excludes a disclosed embodiment is baseless. *See* Op. Br. at 3-4. Thus, whatever impact the generic language that VideoLabs references may have, it certainly does not re-define or broaden the specification’s express definition of the term “wireless devices” or “wireless communication devices” – which is the sole issue under consideration.

Finally, VideoLabs mischaracterizes the ’113 patent’s prosecution history. The patentee did not, as VideoLabs asserts, “simply note[]” that digital products can be accessed by mobile devices. Ans. Br. at 9. While the patentee did distinguish Mineo’s wired connections from the claimed “wireless services subscribers,” the patentee went on to state *why* this was an “important distinction.” Ex. 5, 16. Specifically, the patentee explained that having wireless services subscribers addressed the problems described in the patent from which the ’113 patent was reissued (U.S. Patent No. 7,299,033 at 1:58-2:33). *Id.* Such problems include “the fact that different *mobile devices* often require different content packaging formats

and provisioning protocols” and that “it is difficult for content suppliers to keep up with the constant changes in device capabilities for the many *mobile devices* in the marketplace.” Ex. 11, 1:58-2:33; *see also* Ex. 1, 1:60-2:37; Ex. 4, 1:66-2:42 (identifying the same problems). The patentee then drew the distinction that in comparison to claim 1, “Mineo does not mention a problem with packaging and provisioning digital products that is caused by the fact that the digital products can be accessed by *mobile devices* with different packaging and provisioning requirements.” Ex. 5, 16-17. It was therefore emphasized—and not merely “note[d]”—that the prior art did not deal with technological issues discussed in the ’033 patent that were tied to “mobile devices.”

In sum, Starz’s proposed definition is the express definition given by the patentee in the specification. VideoLabs’ attempt to elevate generic language—which on its face does not even purport to redefine “wireless device” or “wireless communications device”—cannot prevail over the specification’s express definition.

#### **4. Defendant’s Sur-Reply Position**

Starz contends VideoLabs attempts to divert attention away from what Starz argues is an express definition of “wireless devices.” Reply at 9. But it is Starz that attempts to divert attention from the disclosures throughout the specification that make clear the inventors did not intend to limit the claim term in the manner which Starz proposes. Starz complains VideoLabs proposes a construction of

“wireless device” that “can be *any* electrical device capable of wireless communication,” but does not explain why the inventors are not entitled to the full scope of the invention described in the specification, which Starz attempts to denigrate as “generic language.”

Moreover, Starz attempts to apply an express definition to the claim term “wireless communication devices,” even though that claim term appears nowhere in the single specification excerpt on which Starz relies. Ex. 1 at 1:22-26. Other courts have considered and rejected, under similar facts, the same limiting strategy Starz attempts here. *See, e.g., Blackberry Ltd. v. Facebook, Inc.*, 2019 WL 8883451, at \*14 (C.D. Cal. Apr. 5, 2019) (finding that, absent “a clear indication that the inventors sought to limit the plain meaning of the phrase,” the term “wireless communication device” was not limited to “small-screen mobile device[s],” even where the patent title at issue was “Previewing a New Event on a Small Screen Device” and the specification stated “[w]ireless devices are *usually* small.”<sup>7</sup>) (emphasis in original).

**B. U.S. Patent No. 7,233,790: “content” / “digital content” / “product” / “digital product”**

| <b>Term</b>                                                   | <b>Starz’s Construction</b>                                                                  | <b>VideoLabs’ Construction</b>                                                       |
|---------------------------------------------------------------|----------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------|
| “content” / “digital content” / “product” / “digital product” | “Software and/or data embodying a file for purchase by a wireless services subscriber and/or | No construction necessary<br><br>Alternatively, if the Court decides to construe the |

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<sup>7</sup> Emphases added throughout (unless otherwise noted).

|                              |                                |                                                                                      |
|------------------------------|--------------------------------|--------------------------------------------------------------------------------------|
| (Claims 1, 2, 4, 5, 6, 8, 9) | telecommunications subscriber” | term, “software and/or data embodying a file for delivery or purchase by a customer” |
|------------------------------|--------------------------------|--------------------------------------------------------------------------------------|

### 1. Plaintiff’s Opening Position

Starz proposes that these claim terms be given a construction that is consistent with the intrinsic evidence. The specification of the ’790 patent explains that:

“[T]he terms ‘digital content’, ‘digital product’, ‘content’, and ‘product’ are used *interchangeably* and *mean software and/or data embodying things such as games and other applications, applets or the like; images; screensavers; wallpaper; ring tones; etc.*”

Ex. 1, 3:48-53.

The parties agree that the terms refer to software or data embodying a file. The parties disagree on whether: (i) it must be “for purchase” or mere delivery, and (ii) the purchaser/recipient must be “wireless services subscriber and/or telecommunications subscriber” or a mere customer.

A POSITA would understand that “products” (and, therefore, content, digital content and digital products) are “for purchase.” The specification provides that the purported inventions are directed to “[a] network server system includ[ing] a download manager that manages the publication [and] *purchase . . . of digital products . . .* to wireless services subscribers,” wherein “[p]roduct suppliers can publish and manage their products on the server system via a computer network and *make their products* available to the subscribers *for purchase* or licensing” (which

is a type of purchase). Ex. 1, Abstract. The specification expressly uses these terms “*interchangeably*” (Ex. 1, 3:48-53), therefore “content,” “digital content” and “digital products” also must be “for purchase.”

Moreover, the specification describes components of the invention that are responsible for the “purchase” of the content or products. *See, e.g.*, Ex. 1, 4:65-5:4, 6:32-7:3 (“The delivery manager 31 is the download managers interface to the various subscribers and is responsible for *delivering purchased digital content* to subscribers . . . The business & operations manager 33 is mainly responsible for managing domain information and processes for charging subscribers for *purchases of content*.”), 7:4-22, 7:31-45 (“The device capability manager 37 is responsible for device recognition . . . recognition of devices and their capabilities is used for a variety of purposes,” e.g., “to select the appropriate implementations of *products that are purchased*, and to select the appropriate provisioning model for provisioning a *purchased product* in a client device.”).

Starz’s construction is also consistent with extrinsic evidence, such as a technical dictionary which defines a “product” as “an entity conceived and *developed for the purpose of competing in a commercial market*.” Ex. 6, 424 (*Microsoft Computer Dictionary* (5th ed. 2002)); *see also id.* (products include “software, peripherals, and accessories in the computing arena.”).

Starz’s construction also requires purchase “*by a wireless services subscriber and/or telecommunications subscriber*,” because it tracks with the claim language of both the ’790 and ’113 patents. *See, e.g.*, Ex. 1, cl. 1 (“A method of providing access to content . . . for use in wireless communication devices used *by* a plurality of *wireless services subscribers* . . .”); Ex. 4, cl. 1 (“operating the server system . . . such that the digital products are accessible to the plurality of *wireless services subscribers* . . .”). The specification also explains that products are intended for purchase by wireless services subscribers. *See e.g.*, Ex. 1, 4:1-6 (“Digital content suppliers . . . *can make their products available to wireless services subscribers* through the download manager for purchase or licensing.”); *see also* Ex. 1, Abstract.

VideoLabs’ primary assertion that no construction is necessary should be rejected because “reliance on [the] term’s ‘ordinary’ meaning does not resolve the parties’ dispute” at issue. *O2*, 521 F.3d at 1361. VideoLabs’ alternative assertion—that the term should mean “software and/or data embodying a file for delivery or purchase by a customer”—is inconsistent with the intrinsic evidence discussed above.

VideoLabs asserts that the file can be for “*delivery or* purchase.” However, as discussed, the specifications disclose the “purchase” of commercial products—but not any scenario in which the products merely would be available for delivery. In fact, independent claim 10 of the ’113 patent *requires* “specifying for each of the

domains a *currency* in which digital products is to be expressed to wireless subscribers for purposes of wireless services subscribers obtaining digital products.” Ex. 4, cl. 10, 16:20-23. If purchasing the products were unnecessary, there would be no need to specify a particular currency.

Moreover, VideoLabs impermissibly substitutes the broader term “customers” for the more specific term “wireless services subscribers” that is used in the claims and specification. The specification distinguishes between customers and wireless services subscribers, explaining that “customers” may be “users of mobile devices and . . . subscribers of w[i]r[e]less services,” *but need not be*. Ex. 1, 4:26-32. Yet, the claims require that the content be made available specifically to the subset of *wireless services subscribers*, rather than any and all “customers.” *See, e.g.*, Ex. 1, cls. 1, 2. Indeed, “customer” appears nowhere in the language of the claims for either the ’790 or ’113 patent.

## 2. Defendant’s Answering Position

As was the case with the previous term, Starz’s proposed construction improperly narrows the claim scope to exclude embodiments from the specification and contrary to the claim term’s plain meaning. Starz’s proposed construction should be rejected.

As noted in Starz’s Opening Brief, the parties’ dispute: (1) whether the claimed content and/or products must be “for purchase” or can also be “for delivery”;

and (2) whether the recipient must be a “wireless services subscriber.” Starz is wrong on both counts as to what a PHOSITA would understand about the scope of the claimed content and/or products. Starz does not rely on an alleged express definition or lexicography for the “content” / “product” claim terms, but repeats the same mistakes here as it does for the “wireless device” term, ignoring specification disclosures that are at odds with its proposed construction.

Starz first argues that a PHOSITA would understand that “products” in the ’790 patents are limited to those that are “for purchase,” citing the abstract of the patent, noting that the terms “digital content,” “digital product,” “content,” and “product” are used interchangeably in the specification, and then jumping to the conclusion that all of these items must be “for purchase.” Op. Br. at 15-16. There are at least two problems with Starz’s argument that are fatal to its construction. First, Starz grossly misrepresents the quoted abstract. Below is the first excerpted portion of the abstract, with emphasis on the portions excluded by Starz in ellipses:

A network server system includes a download manager that manages the publication, purchase *and delivery* of digital products [or content] ... to wireless services subscribers ... .”

Ex. 1 at Abstract. From the outset, the specification is at odds with Starz’s argument that the claimed content/products must be “for purchase” only.

Starz then compounds its error by asserting that “licensing” must be a type of purchase. Op. Br. at 15-16. This assertion is easily rebutted. Looking first at the

intrinsic evidence, the specification says the following about the term “purchase” as used in the ’790 patent:

*For convenience the terms “purchase” or “buy” are used to mean either actual purchase or any other conventional way in which a subscriber can acquire rights to use the digital content (e.g., by acquiring a license).*

Ex. 1 at 3:56-60. This distinction makes clear that the patentee did not intend for the claimed content/products to be limited solely being for *actual* purchase. Elsewhere, the specification refers to “purchase” set off by quotation marks when discussing it in the context of product licenses, further reaffirming the interchangeable use of the terms and that the patentee did not intend to limit the claim scope to “actual purchase.” Ex. 1 at 7:15-19 (“The personal vault stores, on a subscriber-by-subscriber basis, information to facilitate digital rights management (DRM), ***such as product licenses and/or other “purchase” information*** of the products purchased by each subscriber.”)

Looking to extrinsic evidence, a PHOSITA would readily understand that there are other conventional ways to acquire rights to content and products (including digitally), including by acquiring a license. Free or open source licensing models not requiring “actual purchase” of content or products, such as Linux and Creative Commons license, were readily available at the time the ’790 patents was filed. *See, e.g.* Ex. 9 (History – Creative Commons). Dictionaries define a “license” as “permission to act,” “freedom to act,” “to permit or authorize especially by formal

license” or simply “to give permission or consent to.” Ex. 12 (*License*, Merriam-Webster.com, <https://www.merriam-webster.com/dictionary/licensing>). There is simply no requirement in the ’790 patent that a license (or any other conventional means of acquiring rights to content) be limited to “actual purchase.” Even the dictionary definition Starz relies on only states that products are “developed for the purpose of competing in a commercial market.” Op. Br. at 16. This is true, but it does not follow that products must be for “actual purchase” to compete in a commercial market. The “freemium” business model, which is premised on offering a product for free and then relying on marketing “premium” features at cost, precedes the filing of the ’790 patent, as evidenced by the millions of AOL disks distributed for free in the 1990s, giving rise to the dominant internet service provider at the time.

Starz’s citations to components in certain embodiments or arguments that the claimed content/products be limited to “actual purchase” because of claim language ignores that limitations are not imported from the specification into the claims, and that the specification uses “purchase” interchangeably with licensing and other ways excluding actual purchase to acquire rights to content. *See* Ex. 1 at: 56-60. Notwithstanding Starz’s citation of certain embodiments or components directed to the purchase of content, there is no exclusion in the ’790 patent of delivery (without purchase) of content using the claimed techniques.

Turning to the question of whether a purchaser/recipient must be a “wireless services subscriber and/or telecommunications subscriber,” that inquiry is again readily resolved by looking to the specification. As noted previously, the specification has the following to say about “customers” in the ’790 patent:

*To facilitate description*, it is henceforth *assumed* herein that the customers are users of mobile devices and, therefore are subscribers of w[ire]less devices (although that need not be the case); thus, customers are henceforth called “subscribers” herein. *Note, however, that the techniques described herein need not be limited to wireless services subscribers or mobile client devices.*

Ex. 1 at 4:26-32.

For the reasons discussed above, a PHOSITA would not understand the claim term to be limited to “actual purchase” or “wireless services subscribers” only and Starz’s proposed construction should be rejected as it improperly seeks to restrict the claim scope. To the extent the Court finds the claim term requires construction, VideoLabs’ proposed construction should be adopted.

### 3. Plaintiff’s Reply Position

VideoLabs’ criticisms of Starz’s arguments miss the mark; indeed, its arguments prove Starz’s positions.

VideoLabs first argues that the following portion of the abstract supports a construction under which digital products need not be purchased:

“A network server system includes a download manager that manages the publication, ***purchase and*** delivery of

digital products from multiple suppliers to wireless services subscribers . . .”

Ans. Br. at 19 (citing Ex. 1, Abstract). However, this language uses the conjunctive, “and,” therefore the patent explains that a purchase is a necessary element of a digital product. VideoLabs effectively replaces the “and” with an “or,” such that delivery alone can define digital products and content. That argument is baseless and directly defies the language in the patent.

VideoLabs next injects a straw man argument about what constitutes an “*actual* purchase” and attempts to distinguish an “actual purchase” from a “purchase.” Ans. Br. at 20; *see also, e.g., id.* at 20 (“Free or open source licensing models not requiring ‘actual purchase’”); 21 (“no requirement . . . that a license . . . be limited to ‘actual purchase’”); 21 (“Starz’s citations . . . that the claimed content/products be limited to ‘actual purchase’”<sup>8</sup>); 22 (“a PHOSITA would not understand the claim term to be limited to ‘actual purchase’”). Tellingly, VideoLabs never even defines what it contends an “actual purchase” is.

Nevertheless, VideoLabs appears to be arguing that “free or open source licensing” is a form of “purchase,” as required by Starz’s construction and the portions of the patent that Starz relies upon. However, VideoLabs’ argument fails

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<sup>8</sup> To be clear, contrary to this assertion, in its opening brief Starz did not even cite the phrase “actual purchase”—which is undefined in the patents and appears only at Ex. 1, 3:56-60.

for several reasons. First, VideoLabs fails to cite any intrinsic evidence supporting the idea that the claimed content would be available through open source licensing—much less that making it so available would constitute a “purchase.”

Second, VideoLabs relies only on unsupported attorney argument, citing no intrinsic or extrinsic evidence, when contending that Linux was a free or open source licensing model “readily available at the time the ’790 patent was filed,” and that the “‘freemium’ business model . . . precedes the filing of the ’790 patent, as evidenced by the millions of AOL disks distributed for free in the 1990s.” Ans. Br. at 20-21. Such unsupported attorney argument cannot override the intrinsic evidence.

Third, the only extrinsic evidence VideoLabs relies on actually cuts against its own arguments. VideoLabs references a webpage discussing the history of “Creative Commons.” As a threshold matter, according to this webpage, Creative Commons’ “first project” was released in December 2002—and therefore would not have been within the knowledge of a POSITA as of the June 2002 provisional application priority date that VideoLabs relies on for the ’790 patent.<sup>9</sup> Ex. 9. Moreover, the webpage states that “Creative Commons licenses are *not designed for software*, but rather for other kinds of creative works . . .” *Id.* VideoLabs’ own proposed construction admits, however, that the claimed content is a type of

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<sup>9</sup> Either VideoLabs is abandoning its position that the priority date should be June 28, 2002, or it cannot rely on Creative Commons as being within the knowledge of a POSITA at the time it asserts the invention was filed.

software, which places its extrinsic evidence at odds with its proposed construction. Furthermore, the Creative Commons reference does not purport to define what a “purchase” is—it merely describes that non-software licenses may be given for free in a context untethered to the patents. Nothing therein defines giving something, much less software, for free to be the same thing as a purchase.

Finally, in support of its argument that the purchaser/recipient can be any “customer,” VideoLabs resorts again to the generic language discussed above, stating that the techniques described in the patent “need not be limited to wireless services subscribers.” Ans. Br. at 22 (citing Ex. 1, 4:26-32; Ex. 4, 4:24-30). But the claims themselves are expressly limited to “wireless services subscribers,” and the specification distinguishes between customers and wireless services subscribers. Ex. 1, cl. 1-2, 4-6, 8-9; Ex. 4, cl. 1, 30, 34; Ex. 1, 4:26-32; Ex. 4, 4:24-30. VideoLabs cannot broaden the scope of the claims from “wireless services subscribers” specifically, to any “customers” generally.

For the reasons discussed herein, the Court should reject VideoLabs’ proposed construction and adopt Starz’s proposed construction.

#### **4. Defendant’s Sur-Reply Position**

Starz’s arguments fail to wrestle with the clear disclosures of the specification, which differentiate between “purchase” and “licensing,” reiterating the claimed content or products need not be for actual purchase. *See, e.g.*, Ex. 1 at Abstract

(“Product suppliers can publish and manage their products on the server system via a computer network and make their products available to the subscriber for purchase *or licensing.*”)

With respect to Starz’s arguments concerning whether the purchaser/recipient must be a “wireless services subscriber,” the specification is unequivocal: “customers are henceforth called ‘subscribers’ herein,” but “the techniques described herein need not be limited to wireless services subscribers or mobile client devices.” Starz’s arguments to the contrary should be rejected.

**C. U.S. Patent No. 7,233,790: “implementation”**

| <b>Term</b>                                    | <b>Starz’s Construction</b>                                                                                                        | <b>VideoLabs’ Construction</b>                                                                                                                                                                                               |
|------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| “implementation”<br><br>(Claims 1, 2, 4, 8, 9) | “One or more binary files (or “binaries”), software applications, and/or executable files representing a product” <sup>10,11</sup> | No construction necessary<br><br>Alternatively, if the Court decides to construe the term, “one or more binary files (or “binaries”), software files, software applications, and/or executable files representing a product” |

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<sup>10</sup> Starz: This proposal is different from Starz’s proposal set forth in the Joint Claim Construction Chart. This construction was proposed by Starz to VideoLabs on September 7, 2022, as part of an ongoing meet and confer. VideoLabs rejected this proposal.

<sup>11</sup> VideoLabs: Starz’s proposal was first presented to VideoLabs on September 7, 2022, the day before Starz’s opening brief was due.

## **1. Plaintiff's Opening Position**

The only difference between Starz's proposed construction and VideoLabs' proposed, alternative construction is whether an "implementation" can be a "software file[].".

An "implementation" cannot include a "software file[]" because "software file" is overly broad, vague, and lacks any support in the intrinsic evidence. While a POSITA would understand that the terms "software" and "file," taken individually, were well known in the art, the vague concept of a "software file[]" lacks a common meaning to a POSITA. *See, e.g.,* Ex. 6, 211, 489 (*Microsoft Computer Dictionary* (5th ed. 2002)) (defining "file" and "software," but not "software file"). This lack of clarity is not remedied by the specification, which never mentions or describes "software files." A POSITA would therefore be unable to understand this term with reasonable certainty, so any attempts to ascertain the full scope of VideoLabs' proposed construction would become mere guesswork. Therefore, to the extent VideoLabs' construction includes "software files," it must be rejected.

## **2. Defendant's Answering Position**

Starz argues that an "implementation" cannot include a "software file[]" because "software file" is broad, vague, and lacks support in the intrinsic evidence. As Starz concedes, the terms "software" and "file" were readily known to a PHOSITA at the time of filing of the '790 patent. "Software files" are readily

understood by a PHOSITA to encompass independent files used to record or store information, that are not necessarily binaries, software applications, or executable files. *See, e.g., Payton v. Kale Realty, LLC*, 164 F. Supp. 3d 1050, 1054 (N.D. Ill. 2016) (“a separate software file, such as an Excel spreadsheet”); *In re Volkswagen “Clean Diesel” Marketing, Sales Practices, and Products Liability Lit.*, 2017 WL 2214655, at \* 74 (N.D. Cal. May 17, 2017) (identifying .HEX files as “software files”); *Princeton Digital Image Corp. v. Hewlett-Packard Co.*, 2015 WL 1408754, at \* 1 (S.D.N.Y. Mar. 26, 2015) (.cat files”); *Ford Motor Co. v. Versata Software, Inc.*, 2019 WL 355638, at \* 1 (E.D. Mich. Jan. 29, 2019) (.jar files); *U.S. v. 50.44 Bitcoins*, 2016 WL 3049166, at \*2 n.4 (May 31, 2016); (bitcoin “wallet”); *Evolution, Inc. v. Suntrust Bank*, 2004 WL 2278559, at \*13 (D. Kan. Sept. 29, 2004) (.hlp files). Moreover, Starz’s assertion that the specification lacks support for “software file” is incorrect. While the specification does not mention the specific term “software file,” it includes multiple disclosures concerning the combination of “software” and/or “data” to implement claimed techniques and components.

For the reasons discussed above, a PHOSITA would not understand the claim term to exclude “software files” and Starz’s proposed construction should be rejected as it improperly seeks to restrict the claim scope. To the extent the Court finds the claim term requires construction, VideoLabs’ proposed construction should be adopted.

### 3. Plaintiff's Reply Position

Although the question in dispute is whether “implementation” includes “software files,” VideoLabs admits that the specification does not mention the term “software files.” Ans. Br. at 28. Rather, VideoLabs argues that “software files” should be included in the construction because a POSITA would “readily understand” that “software files” encompasses independent files used to record or store information, that are not necessarily binaries, software applications, or executable files. Ans. Br. at 27-28. However, VideoLabs fails to cite any intrinsic or extrinsic evidence for this assertion—because there is none. VideoLabs merely string cites inapposite case law in which the phrase “software files” was used. None of these cases shed light on what a POSITA would have understood at the time of the invention.<sup>12</sup>

For example, *Payton v. Kale Realty, LLC* was a case from **2015**, involving a violation of the Telephone Consumer Protection Act. 164 F. Supp. 3d 1050, 1053 (N.D. Ill. 2016). One attorney referenced an Excel spreadsheet as a “software file” when discussing the application of a federal regulation. *See id.* at 1054 (citing Dkt.

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<sup>12</sup> The '790 patent was filed on June 19, 2003. VideoLabs asserts that it is entitled to the priority date of the provisional application filed on June 28, 2002. For purposes of arguing this section only, Starz assumes 2002 is the appropriate timeframe for assessing the understanding of a POSITA. For avoidance of doubt, Starz does not concede that June 28, 2002 is the appropriate priority date for the '790 patent.

143 at ¶ 26). This bears no relevance to the question of whether a *POSITA in 2002* would have a reasonably certain understanding of the term “software file” in the context of the ’790 patent.

*In re Volkswagen “Clean Diesel” Marketing, Sales Practices, and Products Liability Litigation* was a **2017** decision involving a violation of the Clean Air Act, in which the reference to .HEX files as “software files” appears in an Appendix to an issued consent decree. No. 16-cv-00295, 2017 WL 2214655, at \*1, \*3, \*74 (N.D. Cal. May 17, 2017).

The court’s reference to .jar files as “software files” in the introduction of the **2019** decision in *Ford Motor Co. v. Versata Software, Inc.* was part of a summary of the defendant’s copyright infringement counterclaims. No. 15-cv-10628, 2019 WL 355638, at \*1 (E.D. Mich. Jan. 29, 2019) (citing ECF #244 ¶¶ 172-173 (counterclaims filed in **2017**, in which the actual phrase used was “software programs”)).

The report and recommendation, from **2016**, in *United States v. 50.44 Bitcoins* involved a civil forfeiture action. No. 15-3692, 2016 WL 3049166, at \*1, \*2 n.4 (D. Md. May 31, 2016) (quoting another court’s uncited reference from **2014** that a bitcoin wallet is a software file).

In *Evolution, Inc. v. Suntrust Bank*—a copyright, contract, and trade secrets case from **2004**—the reference to .hlp files as “software files” was a quotation of

language taken directly from a license agreement. No. 01-2409, 2004 WL 2278559, at \*1, \*13 (D. Kan. Sept. 29, 2004).

Finally, in *Princeton Digital Image Corp. v. Hewlett-Packard Co.*—the only patent case VideoLabs cites—the reference to .cat files as “software files” was made only as part of the court’s analysis in **2015** regarding whether certain accused products fell under the scope of a settlement agreement. No. 12-cv-779, 2015 WL 1408754, at \*1, \*8 (S.D.N.Y. Mar. 26, 2015). Thus, even in that patent case, the Court was not construing claim language under the applicable rules for doing so. *See Innova/Pure Water, Inc. v. Safari Water Filtration Sys.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004) (“A court construing a patent claim seeks to accord a claim the meaning it would have to a person of ordinary skill in the art at the time of the invention.”).

Furthermore, VideoLabs provides no evidence that Excel spreadsheets, .HEX files, .jar files, bitcoin wallets, .hlp files, or .cat files mentioned in the case law it cites (discussed above) even qualify as “software files” under VideoLabs’ own (unsupported) definition for the term.

Finally, while VideoLabs admits that “software files” is not a term that is used or defined in the patent, VideoLabs claims that there are “multiple disclosures concerning the combination of ‘software’ and/or ‘data’ to implement claimed techniques and components.” Ans. Br. at 28. Not only does VideoLabs fail to cite

any such disclosures, but the assertion wholly lacks any argument about how these unidentified combinations would permit a POSITA to understand the meaning of the term “software files,” such that it can be included in the construction of “implementation.”

For these reasons, VideoLabs has failed to establish that a POSITA would have understood the term “software files” with reasonable certainty in the context of “implementation,” and the Court should adopt Starz’s proposed construction.

#### **4. Defendant’s Sur-Reply Position**

That the specification does not expressly include the term “software file” has no bearing on whether it is appropriately included in the proposed construction of a claim term. A PHOSITA would readily understand “software files” to encompass independent files used to record or store information, not necessarily binaries, software applications, or executable files. Notwithstanding when the cases citing examples of software files were decided, the relevant question for a PHOSITA is when the underlying *patents* were issued. *See, e.g., Princeton Digital Image Corp. v. Hewlett-Packard Co.*, 2015 WL 1408754, at \* 1 (S.D.N.Y. Mar. 26, 2015) (U.S. Patent Nos. 4,813,056 (issued March 14, 1989), 4,860,103 (issued August 22, 1989)).

**D. U.S. Patent No. 7,440,559: “download”**

| <b>Term</b>                     | <b>Starz’s Construction</b>                                                                             | <b>VideoLabs’ Construction</b>                                                                                        |
|---------------------------------|---------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------------------------|
| “download”<br><br>(Claims 2, 4) | Plain and ordinary meaning, <i>i.e.</i> , “Copy and store in memory of the terminal for subsequent use” | No construction necessary<br><br>Alternatively, if the Court decides to construe the term, “transfer to the terminal” |

**1. Plaintiff’s Opening Position**

A POSITA at the time of the invention of the ’559 patent would understand the plain and ordinary meaning of “download” to be “*copy and store in memory* of the terminal for subsequent use”—not merely to transfer to a terminal. For example, claim 2 recites that “the terminal comprises *a memory*,” wherein “the processor is configured to send, to the terminal, a response to the content status that instructs the terminal to at least one of delete at least one piece of content from the *memory* of the terminal, or *download* at least one piece of content from the source.” Ex. 2, cl. 2. Therefore, a POSITA would understand that when a piece of content is downloaded from the source, it is stored in the memory of the terminal, from which it can later be deleted. This understanding is further supported by the specification of the ’559 patent, which states that “[t]he memory typically *stores* content transmitted from, or received by, the terminal, digital broadcast receiver, and/or digital broadcaster”), and that, “[u]pon downloading the content . . . the terminal *can*

*store the content in memory* . . . such as *for subsequent use* by a user of the terminal.” *Id.*, 6:57-65, 13:61-64.

Moreover, the specification also describes a “content status,” *i.e.*, a message sent from the user’s terminal to the source of content, which “can include any of a number of different pieces of information regarding the terminal 10 and the contents stored therein.” *Id.*, 12:18-20. The specification discloses that this status information can include “information regarding the remaining *storage* capacity of the *memory* of the terminal,” as well as “a listing of the pieces of content stored in *memory*, the time that the terminal received or otherwise downloaded each piece of content in *memory*; the time (if any) that the terminal utilized each piece of content in *memory* and/or the manner that the terminal utilized each respective piece of content in *memory*.” *Id.*, 12:20-30. A POSTIA would understand that it would not have been necessary to include this information in the content status message if content were merely transferred, but not stored in the memory of a user’s terminal, as part of a download.

Starz’s proposed construction is also supported by the extrinsic record. Prior art can “assist in ascertaining the meaning of a term to a person skilled in the art” (*Arthur A. Collins, Inc. v. N. Telecom Ltd.*, 216 F.3d 1042, 1044–45 (Fed. Cir. 2000)) and, here, the prior art shows that a POSITA would understand “download” to mean “copy and store in memory of the terminal for subsequent use.” For example, the

prior art explains that downloading media is separate and distinct from, for example, streaming media content, wherein, at the relevant time period, downloading media content meant that the content file needed to be downloaded in full prior to use by a user. *See, e.g.,* Ex. 7, 1 (Franc Kozamernik, *Media Streaming Over the Internet: An Overview of Delivery Technologies*, EBU Technical Review, Oct. 2002) (noting that “[t]here are two modes for the transmission of media over the Internet,” *i.e.*, “download mode” and “streaming mode,” wherein, in “download mode,” “the user can play the downloaded file only after the whole file has been downloaded from a server to his/her computer. . .”); *see also* Ex. 8, 1 (College of DuPage, *Introduction to Streaming Media*, Nov. 2001) (“With streaming technology, users can watch and listen to media while it is being sent to their browser, instead of waiting for it to completely download and then playing it. Before streaming technology was available, a user might wait an hour (or more!) to completely download a short media file.”). Thus, a POSITA at the time would have understood that “downloading” content required copying in memory and storing it for use.

VideoLabs’ assertion that no construction is necessary should be rejected because the parties disagree on the plain and ordinary meaning. *See* O2, 521 F.3d at 1361. VideoLabs alternatively asserts that “download” should mean “transfer to the terminal.” However, VideoLabs’ construction is overly broad, and fails to account for the term’s meaning at the time of the invention—including the distinction

between downloading and transferring. *See Phillips*, 415 F.3d at 1313 (“[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question ***at the time of the invention***”). As set forth above, a POSITA at the relevant time would understand that “download” was different from “transfer[ring] to the terminal” (e.g., via streaming).

## 2. Defendant’s Answering Position

Starz’s construction purports to be the plain and ordinary meaning of “download,” Op. Br. at 33, but seeks to add an additional limitation not found in the plain meaning or the specification: “store in memory . . . for subsequent use.”<sup>13</sup> *See* Op. Br. at 33. Starz’s proposed addition contradicts the specification and the extrinsic evidence and should be rejected.

The specification repeatedly distinguishes between storing and downloading. ’559 patent at 13:61-64 (“**Upon downloading the content**, as shown in block 120, **the terminal can store the content in memory** (e.g., non-volatile memory 96), such as **for subsequent use** by a user of the terminal.” (emphasis added)), 11:10-12 (“The content flow manager, in turn, can control the flow of content, or more particularly the **downloading** and **storage** of content . . . .” (emphasis added)); Fig. 6 (showing

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<sup>13</sup> While Starz’s construction uses the term “copy” instead of “transfer,” it does not appear that Starz intends “copy” to mean anything different than “transfer.” *See* Op. Br. at 35-36. Regardless, “transfer” better conforms to the specification and extrinsic definitions of “download.” *See infra* § II.D.2.

distinct steps of “Download New Content” and “Store New Content”). This demonstrates that downloading and storing are distinct actions. *See Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1347 (Fed. Cir. 2003) (“[T]he use of a different word to describe the isolation of PRRS virus from infected tissue samples-‘recover’-suggests that “isolate” does not refer solely to this process.”).

And a full review of the specification shows that it uses “download” to mean “transfer” or “receive”<sup>14</sup> — neither of which require storing. ’559 patent at 1:30-36 (“However, at these transfer rates it may be difficult to handle exceedingly high data intensive tasks such as . . . **transferring very large data files to mobile terminals.** ***In this regard, attempts at downloading large data files*** may lead to inconveniently long downloading times that can be undesirably costly for users.”); ’559 patent at 11:56-61 (“As shown in block 100, a method of controlling storage of content generally includes the terminal 10 ***downloading or otherwise receiving***, at one or more points in time, one or more pieces of content from a content source . . . .” (emphasis added)), 12:23-27 (“the status information can include . . . the time that

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<sup>14</sup> For purposes of this dispute, the plain meaning of “download” encompasses both “transfer” and “receive,” which are merely two sides of the same action: transferring when viewed from a server-side perspective and receiving when viewed from a client-side perspective. VideoLabs used “transfer” because Claim 2 recites “download” in a server-side context. ’559 patent at claim 2 (“download at least one piece of content *from the source* [a server]” (emphasis added)).

the terminal *received or otherwise downloaded* each piece of content in memory . . . .” (emphasis added)), 10:45-48 (“As explained in the background section, the terminal 10 typically *downloads* content in accordance with a pull technique, whereby the terminal *receives* content in response to a request for such content.”).

The specification also explains that “download[ing]” can be done “in any of a number of different manners” and can use “any of a number of different techniques for downloading content.” ’559 patent at 13:55-61. Thus, the specification uses “download” broadly to refer to the full scope of its plain meaning. *See Anchor Wall Sys., Inc. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1308 (Fed. Cir. 2003) (“[V]aried use of a disputed term in the written description attests to the breadth of a term.”).

Further, technical dictionaries from the time of the patent confirm that “download” only requires transferring data — not storing it at the client:

- Download — “To transfer data from a network location to the user’s computer.” Ex. 10 (Webster’s New World Dictionary of Computer Terms (Tenth Edition)).
- Download — “In communications, to transfer a copy of a file from a remote computer to the requesting computer by means of a modem or network. 2. To send a block of data, such as a PostScript file, to a dependent device, such as a PostScript printer.” Ex. 6 (Microsoft Computer Dictionary (Fifth Edition)).

There is no question that downloading, as used in the ’559 patent and as understood by a PHOSITA, simply means transferring, and does not require “storing.”

Starz appears to have reached its proposed construction from two unrelated parts of the specification. First, the specification states “for example, the memory typically *stores* content transmitted from, or received by, the terminal, digital broadcast receiver, and/or digital broadcaster.” ’559 patent at 6:62-65 (cited at Op. Br. at 33, emphasis in Op. Br.). Second, the specification states that “[u]pon downloading the content, as shown in block 120, the terminal *can store the content in memory* (e.g., non-volatile memory 96), such as *for subsequent use* by a user of the terminal.” ’559 patent at 13:61-64 (cited at Op. Br. at 33-34, emphasis in Op. Br.). From these two statements, Starz argues that “download” means “copy and store in memory of the terminal for subsequent use.” Op. Br. at 33-34.

Starz’s construction does not follow from its evidence. “To act as its own lexicographer, a patentee must clearly set forth a definition of the disputed claim term other than its plain and ordinary meaning and must clearly express an intent to redefine the term.” *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014) (internal quotations omitted); *Thorner*, 669 F.3d at 1365. Starz’s alleged lexicographic statements do not use any definitional language or convey any sense that they intend to define “download” — the first quote does not even use the word “download” and the second discusses what happens *after* content is downloaded. Further, the statements use language that underscores they are not definitional: “for example,” “typically,” “can,” and “such as.” ’559 patent at 4:15-18, 6:38-42. There

is no clear lexicography defining “download” to include “store,” precluding Starz’s proposed construction.

Starz next argues that “a POSITA would understand that when a piece of content is downloaded from the source, it is stored in the memory of the terminal, from which it can later be deleted” because claim 2 states that the terminal is instructed to “delete at least one piece of content from the *memory* of the terminal, or *download* at least one piece of content from the source.” Op. Br. at 33 (emphasis in original). But the fact that content is deleted “from the memory” does not mean that downloading requires “stor[ing] in the memory” — at most it means that content must be stored at some point, not that the storing is a part of “downloading” or that it is claimed at all. If anything, the fact that content is deleted “from the memory” shows that the inventors knew how to describe when content is stored in memory and chose not to for the “download” term.

Starz next points to the specification’s discussion of a “content status,” but its arguments do not support its construction. Op. Br. at 34. Starz argues that the fact that a “content status” can include various information about what is stored in memory means that a “POSTIA [sic] would understand that it would not have been necessary to include this information in the content status message if content were merely transferred, but not stored in the memory of a user’s terminal, as part of a download.” *Id.* Starz’s argument is no more than attorney supposition as to why the

“content status” is included in the claims, and should be afforded no weight. Indeed, whether the claimed “content status” is “necessary” or beneficial is a question of damages, not claim construction. Moreover, there are other claim elements that discuss “stored” content, and there is thus no basis to shoehorn “storing” into “download.”

Finally, Starz points to two pieces of extrinsic evidence that it alleges show that “downloading” is different than “streaming” because “downloading media content meant that the content file needed to be downloaded in full prior to use by a user.” Op. Br. at 34-35. But whether downloading and streaming are different, and whether the file must be downloaded in full before initial use, has nothing to do with whether downloading requires “stor[ing] in memory of the terminal for subsequent use.” And Starz’s assertion is not even correct, as one of its articles explains that “downloading” also includes “progressive download,” which means “the media starts playing a few seconds after the download starts” so that “the user can watch the video while it is downloading.” Ex. 7 at 2. Starz’s extrinsic evidence does not show that a PHOSITA would understand downloading to require storing. Regardless, Starz’s two internet articles cannot override the specification’s clear disclosure that “downloading” and “storing” are distinct.

### 3. Plaintiff's Reply Position

VideoLabs' arguments for the construction of this term are rife with contradiction. For example, VideoLabs claims that the specification equates "download" with "transfer" or "receive." Ans. Br. at 37-38. VideoLabs emphasizes language such as "downloading *or otherwise* receiving" and "received *or otherwise* downloaded" to conclude that the functions connected by the term "or otherwise" are the same. *Id.* (citing Ex. 2, 11:56-61, 12:23-27). However, VideoLabs conveniently ignores similar use of "or otherwise" when connecting the terms "received" and "stored." *See, e.g.,* Ex. 2, 2:40-44 ("As will be appreciated, in various instances, user preferences, capabilities of the mobile terminal and/or previous contents *stored or otherwise received* by the mobile terminal can have an affect [sic] on the flow of new content to the mobile terminal."). If VideoLabs is correct that "downloading or otherwise receiving" means that downloading is the same as receiving, then it also must be true that storing is the same as receiving. Therefore, by its own logic, downloading must mean storing. As such, Starz's proposed construction remains consistent with the intrinsic evidence.

VideoLabs next places improper and out-of-context reliance on certain definitions from technical dictionaries. Ans. Br. at 38 (citing Ex. 10; Ex. 6). For example, the Webster's dictionary's definition of "download" focuses on distinguishing it from an upload, not whether it requires storing. *See* Ex. 10, 118

(defining “download” and explaining that “[t]he contrasting process, upload, occurs when data is sent from the user’s computer to a network location.”). However, other definitions appearing on the same page support Starz’s position by specifically including storage in memory:

- Downloading — “Transferring a copy of a file from a distant computer *to a disk in one’s computer* using data communication links.”
- Downloadable font — “[T]ransferred . . . to the printer’s *memory*”
- Downloading utility — “[T]ransfers . . . to a printer’s *random access memory (RAM)*”

*Id.* The same distinctions apply to VideoLabs’ citation of the Microsoft Computer Dictionary. Ex. 6, 175 (defining “download” but directing the reader to “*Compare upload*”) (emphasis in original); *see also id.* (defining “downloadable font” as “A set of characters stored on a disk and sent (*downloaded*) to a printer’s memory . . .”).

Finally, VideoLabs is incorrect that the difference between downloading and streaming is irrelevant. Downloading and streaming were understood by POSITAs to be distinct processes, with downloading involving copying and storing a full content file in a user’s terminal before it could be used. Op. Br. at 35 (citing Ex. 7, 1; Ex. 8, 1). The European Broadcast Union’s (EBU) technical overview of the concepts make this distinction clear:

“For example, *if downloaded* from <http://www.mp3.com>, *an MP3 audio file* encoded at 128 kbit/s and of 5 min duration *will occupy 4.8 MB of the user’s hard disk.*”

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“The following is a summary of the main features of *streaming*: . . . It *occupies no space on the user’s hard disk*. The user does not get a copy of the media file – that stays on the streaming server.”

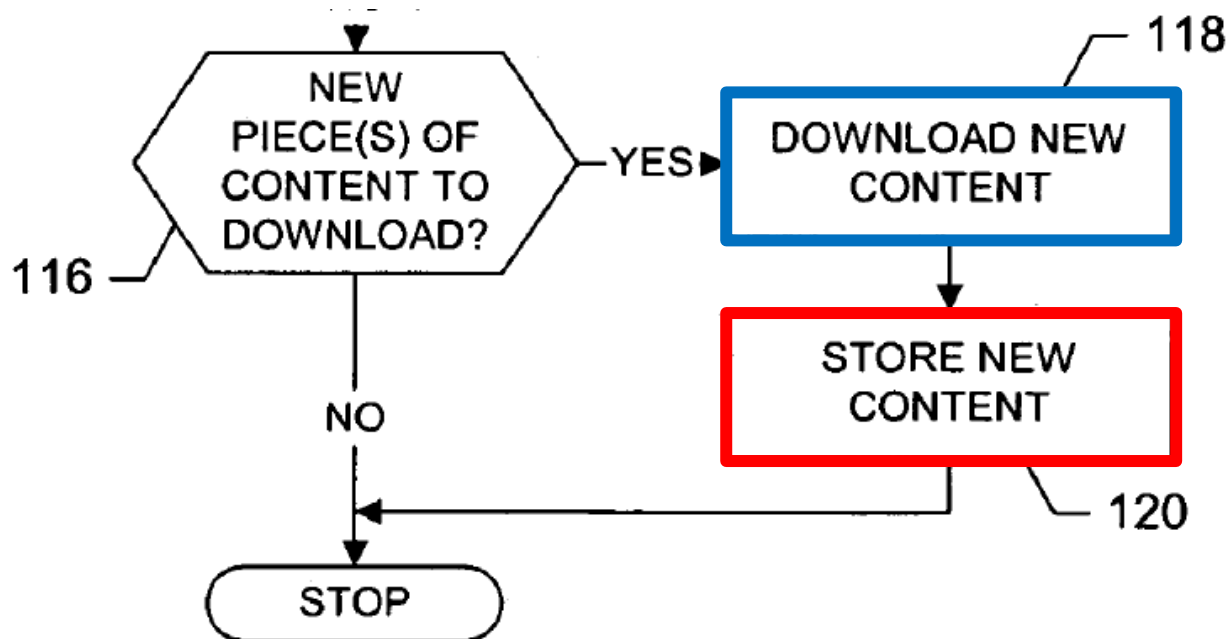
Ex. 7, 1, 3. As Starz previously explained, a POSITA would have understood that by using the term “download,” the inventors did not envision the mere transfer of content as VideoLabs proposes, but rather that the content must be stored in the memory of the user’s terminal as part of the download. Op. Br. at 34-35. Compounding its error, VideoLabs points to the concept of “progressive download” disclosed in the article. Ans. Br. at 41. However, VideoLabs is incorrect that downloading “includes” progressive download, such that the claimed downloading encompasses scenarios that do not require full storage in memory prior to use. Ex. 7, 2 (“a third approach: progressive download . . . *is neither streaming nor download-and-wait*”).

Therefore, the Court should reject VideoLabs’ proposed construction, and adopt Starz’s proposed construction for this term.

#### 4. Defendant’s Sur-Reply Position

Starz’s proposed construction mandates downloading includes storing, yet its Reply ignores the fact the specification explicitly distinguishes between downloading and storing as separate, distinct actions. Opp. at 36-37; Reply at 42-44. For example, Figure 6 separately shows downloading and storing (annotated in

blue and red below). It makes no sense to say downloading must include storing when storing is a different action that happens after downloading.



Ex. 2 at Fig. 6; *see id.* at 13:51-64.

Notwithstanding the specification's clear distinction, Starz argues storing is a part of downloading because the specification uses the phrases "downloading or otherwise receiving" and "stored or otherwise received." Reply at 42 (quoting Ex. 2 at 11:56-61, 12:23-27, 2:40-44, emphasis omitted). From those statements, Starz argues downloading means receiving and receiving means storing and thus, transitively, downloading must mean storing. *Id.* Starz's argument does not hold water. Even assuming these statements are limiting, the fact "storing" is one thing that can happen during "receiving" does not mean receiving (or downloading) inherently requires storing. Indeed, the specification's recitation of "stored or

otherwise received” shows there are “other[]” ways content is “received” without storing.<sup>15</sup> Ex. 2 at 2:40-44.

Starz next tries to distinguish VideoLabs’ dictionary definitions of “downloading.” Reply at 42-43. Starz first argues the definitions do not speak to whether downloading “requires storing,” but only differentiate downloading from uploading. *Id.* But the fact the definitions do not explicitly mention storing is the point — they do not mention storing because definitionally downloading does not require storing. Starz next points to a definition of downloading that mentions “[t]ransferring . . . *to a disk in one’s computer* . . . .” Reply at 43 (quoting Ex. 10 at 118, emphasis in brief). But even there, “downloading” only means “transferring”—any “storing” that might occur next is not part of the definition. Starz next argues that definitions of other words — “downloadable font” and “downloading utility” — mention storing in memory. Reply at 43. But those different terms do not control the construction of “download.” If anything, the fact that these definitions explicitly mention storing, while the definitions of download do not, highlights that downloading does not require storing.

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<sup>15</sup> Contrary to Starz’s assertion, Reply at 42, this is consistent with VideoLabs’ opposition brief. Just as receiving can include storing, receiving can also encompass downloading. Opp. at 37, n.14. That does not mean that downloading and storing are the same thing.

Finally, Starz again claims downloading requires storing because one article contrasts downloading (which it says requires transferring the entire file before playing it) with streaming (where the file “plays out while parts of the content are being received and decoded”). Reply at 43-44 (citing Ex. 7). But even if Starz were correct as to what that article shows (it is not), extrinsic evidence “may not be used to vary, contradict, expand, or limit the claim language from how it is defined, even by implication, in the specification or file history.” *Novartis Pharms. Corp. v. Abbott Labs.*, 375 F.3d 1328, 1335 (Fed. Cir. 2004). The specification is unequivocal that “download” does not include “store,” and Starz’s extrinsic evidence cannot change that.

Moreover, the article does not support Starz’s position. As VideoLabs explained previously, the article describes a type of downloading called “progressive download or pseudo-streaming,” where the file is not stored before it is played. Ex. 7 at 2; Opp. at 41. While Starz argues downloading does not include progressive downloading because the article distinguishes the two, it actually distinguishes progressive downloading from “*download-and-wait*,” not “downloading” in general. Reply at 43-44; Ex. 7 at 2; *see id.* (“For the user, it [progressive downloading] looks like streaming but, in effect, it is downloading.”).

- E. U.S. Patent No. 8,605,794: “assignment rule for assigning each one of the content-related second data segments to one of the content-related first data segments” / “assignment rule for assigning each one of the content-related second data segments to each one of the content-related first data segment” / “assignment rule” / “the assignment rule is not based on a timestamp” (collectively, the “assignment rule limitations”)<sup>16</sup>**

| <b>Term</b>                                                             | <b>Starz’s Construction</b> | <b>VideoLabs’ Construction<sup>17</sup></b>                                                                                                                                                                                                                                                 |
|-------------------------------------------------------------------------|-----------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| The assignment rule limitations<br><br>(Claims 1, 3, 9, 16, 17, 20, 21) | Indefinite                  | “assignment rule for assigning each one of the content-related second data segments to one of the content-related first data segments, wherein the assignment is not performed by using exact timing information for the data segments (e.g., by using data segment timestamp information)” |

### **1. Plaintiff’s Opening Position**

The term “assignment rule” is indefinite because it “fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *See Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). Every disclosure

<sup>16</sup> Starz: Starz addresses the indefiniteness of this claim term at claim construction because VideoLabs has proposed a specific construction. Starz reserves the right to present indefiniteness arguments for other terms at a subsequent time.

<sup>17</sup> VideoLabs: VideoLabs proposes a construction for the first two identified terms in the chart, which appear in claims 1 and 9, respectively. VideoLabs’ position is that none of the assignment rule claim terms are indefinite.

in the '794 patent specification related to an “assignment rule” specifically discusses a “*predefinable* assignment rule.” *See, e.g.*, Ex. 3, 2:28-3:3, 3:29-39, 5:10-21, 5:59-6:42, 7:4-20; Abstract (discussing a “predeterminable assignment rule”). Nothing in the specification describes or defines any assignment rule that is not “predefinable.”

Independent claims 1 and 9 refer simply to an “assignment rule.” Then, dependent claims 16 and 17 expressly *add* a limitation for those claims that “the assignment rule is predefinable.” Therefore, the “assignment rule” recited in independent claims 1 and 9 must be broader than a “predefinable” assignment rule. *See Littelfuse, Inc. v. Mersen USA EP Corp.*, 29 F.4th 1376, 1380 (Fed. Cir. 2022) (“By definition, an independent claim is broader than a claim that depends from it”). Because the specification fails to describe any “assignment rule” outside of a “predefinable assignment rule,” the patent fails to provide clear guidance as to the outer bounds of “assignment rule” so as to give notice to the “public of the boundaries between infringing and innocent activity.” *See CUPP Cybersecurity, LLC v. Trend Micro, Inc.*, No. 3:18-cv-1251, 2021 WL 5865393, at \*7 (N.D. Tex. Dec. 10, 2021) (finding terms to be indefinite). The intrinsic record provides no objective boundaries of this term to a POSITA, therefore the assignment rule limitations are indefinite. *See Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370–71 (Fed. Cir. 2014).

VideoLabs disregards the foregoing and asserts instead that “assignment rule” should mean “assignment rule for assigning each one of the content-related second data segments to one of the content-related first data segments, wherein *the assignment is not performed* by using exact timing information for the data segments (e.g., *by using data segment timestamp information*).” Once again, VideoLabs improperly conflates narrower language in the dependent claims with broader language in the independent claims—thereby eradicating the clearly drawn distinction between the dependent and independent claims. Specifically, dependent claims 20 and 21 add the requirement that “the assignment rule is *not based on a timestamp*.” Ex. 3, cls. 20, 21. VideoLabs’ construction—which would import the “not based on a timestamp” limitation into independent claims 1 and 9—“would not merely render the dependent claims superfluous, but would mean that those claims would have no scope at all, a result that should be avoided when possible.” *Littelfuse*, 29 F.4th at 1380. VideoLabs’ construction also violates the doctrine of claim differentiation, which presumes that dependent claims are “of narrower scope than the independent claims from which they depend.” *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1242 (Fed. Cir. 2003).

## 2. Defendant's Answering Position<sup>18</sup>

Starz argues that these claim terms necessarily encompass the use of assignment rules that are not predefinable, and that because there are purportedly no examples in the specification of this type of assignment rule, the claims are indefinite. Op. Br. at 48-49. Starz's argument fails because the correct inquiry is whether the claims, read in light of the intrinsic evidence, "fail to inform, with reasonable certainty, those skilled in the art about the *scope* of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014) (emphasis added).

A term is not indefinite merely because a defendant breaks the term into two categories and asserts there are no examples of one of the categories – as Starz does here with predefinable and non-predefinable assignment rules. If that were so, every claim would be indefinite.

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<sup>18</sup> VideoLabs: The '794 patent describes improved techniques for synchronizing audio and video data segments when streaming content. Prior methods used the timestamps stored within the audio and video data segments to order and align the segments, which is resource intensive. See '794 patent, 1:56-2:12, 2:42-43. The patent addresses that problem by using an assignment rule to interrelate the audio and video segments. See, e.g., 3:67-5:4, Fig. 1. For example, the assignment rule could dictate that each sequential audio segment is aligned with every second video segment (e.g., if the segments are constructed so that every audio segment is twice as long as each video segment). See *id.* By creating relationships between the data segments, assignment rules enable the quick and efficient alignment of segments.

What matters is the scope of the actual claim term, which is “assignment rule.” There is no reasonable dispute about its scope: it encompasses *all* assignment rules. Starz’s assertion that a constituent component of this term is ambiguous is irrelevant.

As a matter of logic, assignment rules can either be predefinable or not predefinable; those are the only two options. Starz alleges that claims 1 and 9 of the ’794 patent encompass both types of assignment rules. The PHOSITA does not need to be able to distinguish between predefinable and non-predefinable assignment to determine whether something falls within the scope of these claims, because *all* assignment rules fall within their scope (assuming they otherwise meet the requirements of being an assignment rule).

The indefiniteness case Starz cites further highlights why its argument misses the mark. In *CUPP Cybersecurity, LLC v. Trend Micro, Inc.*, No. 18-CV-1251-M, 2021 WL 5865393, at \*7 (N.D. Tex. Dec. 10, 2021), the court analyzed the claim term “file transfer speeds” and found that, while there was some guidance as to what it encompassed (transfer speeds of tens of megabytes per second), the patentee had failed to establish that the PHOSITA would understand the upper and lower bounds of the term with sufficient specificity. The court was thus assessing the outer bounds

of a discrete claim limitation, unlike here, where the supposedly indefinite term (non-predefinable assignment rule) *does not even appear in any claim*.<sup>19</sup>

To make *CUPP* analogous to the present situation, the claim at issue would need to have been “any transfer speeds,” and the defendant would need to have argued that this term was indefinite because it necessarily encompassed the term “file transfer speeds,” which the specification did not sufficiently describe. Such an argument surely would have failed, as must Starz’s argument here. Indeed, if the premise of Starz’s argument were accepted, then it could be applied to make any claim term indefinite, as it is always possible to identify some sub-component of a claim term that is allegedly not thoroughly discussed in the specification.

The Court need not consider this issue any further. But in any case, the specification provides sufficient guidance about what makes an assignment rule predefinable or not. Assignment rules are defined when the data files that comprise media content (e.g., an audio data file and a video data file that comprise a movie) are fragmented into content-related data segments (e.g., audio data segments and video data segments). *See* ’794 patent, 4:9-53, 5:5-6:42, 6:50-7:20, Figs. 1-5. Thus, if the audio segments are fragmented to be twice as long as the video segments, then

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<sup>19</sup> It is not clear if Starz is asserting that dependent claims 16 and 17 are indefinite. Op. Br. at 49. In all cases, given that Starz’s argument is premised on its view that these dependent claims are limited to predefinable assignment rules (*id.*), and that Starz does not allege that predefinable assignment rules are indefinite, it would be nonsensical for Starz to argue that claims 16 and 17 are indefinite.

as shown in Figure 1, to keep them synchronized, the assignment rule dictates that every audio segment is output with every second video segment. '794 patent, Fig. 1. The assignment rules shown in Figures 1 and 5 are predefinable, since they could be (and were) defined as part of the fragmentation process.

Conversely, an assignment rule would not be predefinable if it cannot be defined when the data files are fragmented. For example, software that filters out sensitive content (e.g., content not suitable for children) could be running at a client device and, upon sensing such content, create an ad hoc assignment rule that outputs certain data segments while skipping over or swapping out other data segments. The real-time assignment rules this software generates are not predefinable, as they depend on specific settings of client-side software that are unknown to the fragmenter.

Thus, the specification *does* describe, with reasonable certainty, what it means for an assignment rule to be predefinable as opposed to *ad hoc*. Starz's concocted indefiniteness argument thus fails for this reason as well.

Starz does not offer a competing construction, and so VideoLabs' construction should be adopted. VideoLabs' construction is also necessitated by statements made by the patentee during prosecution.

Specifically, the patentee distinguished the Shin reference based on the fact that it aligned data segments using exact timing information, stating:

Shin discloses a method for synchronizing content segments with metadata in response to user requests. Shin, col. 2, lines 31-35. The content data and metadata ***each include time information for synchronization***. Shin, col. 2, lines 33-36. In response to user content requests, a synchronizer determines reference time points from the time information contained within the content data and the metadata. Shin, col. 2, lines 35-40 and col. 8, lines 1-6. ***The synchronizer then determines a relative time point and synchronizes the content data and metadata based on the determined time point.*** Shin, col. 2, lines 42-45.

The Examiner equates the relative time point of Shin to “an assignment rule” of claim 1. However, this time point does not assign “each second data segment to a first data segment.” On the contrary, Shin at best determines ***a point in time in content and metadata so that they are synchronized***. Segments of one type of data are not assigned to segments of the other type; rather, ***a synchronization time is calculated***.

D.I. 64-1, Ex. 5, 2012/04/11 Amendment, pp. 8-9 (emphasis added). The Examiner agreed with these arguments and withdrew its rejection based on Shin. D.I. 64-1, Ex. 6, 2012/11/29 Final Rejection, p. 6 (“Applicant’s arguments . . . have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.”). The patentee thus persuasively argued that the claimed “assignment rule” does not encompass aligning the data segments based on exact timing information, thereby triggering prosecution disclaimer. *Tech. Properties Ltd. LLC v. Huawei Techs. Co.*, 849 F.3d 1349, 1357-59 (Fed. Cir. 2017).

The patentee distinguished the Rosenau reference on a similar basis. D.I. 64-2, Ex. 7, 2012/11/29 Response After Final Rejection, pp. 13-15 (“The

synchronization [in Rosenau] is done by utilizing a *system time clock*. The synchronization is based on the *timing information* parsed from a data stream.”) (emphasis added). The Examiner accepted this argument as well and reiterated this distinction in the Notice of Allowance. D.I. 64-2, Ex. 9, 2013/08/01 Notice of Allowance, p. 5 (“The above discussion can be summarized as *the frame synchronization is based on the timing information* parsed from a data stream, which is loaded into a system time clock counter and incremented according to the clock frequency.”) (emphasis added).

Accordingly, VideoLabs’ construction correctly reflects the scope of the claims as necessitated by prosecution disclaimer. The doctrine of claim differentiation cannot undo this disclaimer, as Starz incorrectly asserts. *E.g.*, *GPNE Corp. v. Apple Inc.*, 830 F.3d 1365, 1371 (Fed. Cir. 2016) (“Claim differentiation is ‘not a hard and fast rule,’ but rather a presumption that will be overcome when the specification or prosecution history dictates a contrary construction.”). Indeed, were it possible for this disclaimer to be negated by the doctrine, then the claim scope VideoLabs forfeited to obtain its patent would be restored. That cannot be the correct result.

### 3. Plaintiff’s Reply Position

VideoLabs’ arguments misstate the indefiniteness issue presented. VideoLabs frames the issue for the Court as determining the differences between

“predefinable” and “non-predefinable” assignment rules. However, the actual issue is that the specification provides no guidance for a POSITA to understand the full scope of what an “assignment rule” is, because a “predefinable assignment rule”—the only type of assignment rule discussed in the specification—must be something different than an “assignment rule.” Op. Br. at 48-49. VideoLabs’ failure to address the interaction between the respective scopes of the independent claims (requiring an “assignment rule”) and dependent claims (requiring an “assignment rule” that is also “predefinable”) leaves the meaning of “assignment rule” in the independent claims open and unbounded. *See* Op. Br. at 48-50.

The misunderstanding manifests itself with VideoLabs’ attorney argument that the “only two options” are for assignment rules to be either predefinable or not predefinable. Ans. Br. at 52. VideoLabs fails to cite any evidence for this asserted dichotomy, yet asks the Court to accept it as truth. In an attempt to fill in the gaps left by the patentees, VideoLabs’ attorneys now provide their own definition for a non-predefinable assignment rule. Ans. Br. at 54. However, they cite no evidence supporting their argument that “an assignment rule would not be predefinable if it cannot be defined when the data files are fragmented.” *Id.* This is pure attorney argument that should not be afforded any weight.

Finally, VideoLabs relies on an excerpt from the prosecution history for the ’794 patent, which distinguished certain prior art relating to timestamping in

response to an examiner's § 102 rejection. Ans. Br. at 54-56. However, this excerpt sheds no light on the indefiniteness issue under § 112. The issue here is whether a POSITA would understand the scope of the invention (*Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014)), which is not even discussed in the cited excerpt. Notably, if VideoLabs is asserting that a prosecution disclaimer requires the “assignment rule” of claims 1 and 9 to—by definition—*not be based on a timestamp* (as seems to follow from its argument), then these claims lack any difference in scope from claims 20 and 21, respectively. This renders claims 20 and 21 invalid for a lack of claim differentiation.

For these reasons, the Court should find the assignment rule limitations indefinite.

#### **4. Defendant's Sur-Reply Position**

In reply, Starz does not argue against VideoLabs' proposed construction. *See* Reply at 56-58. Specifically, Starz does not disagree with VideoLabs' explanation of how the patentee disclaimed certain claim scope to overcome references during prosecution or dispute that VideoLabs' construction reflects the appropriate scope of the disclaimer. *See id.*; Ans. Br. at 54-56. Nor does Starz argue the disclaimer is superseded by the doctrine of claim differentiation. *See id.* VideoLabs' construction is thus unopposed and should be adopted.

Starz does assert that, if VideoLabs’ construction is adopted, then claims 20 and 21 are indefinite because they allegedly do not differentiate upon the claims from which they depend (claims 1 and 9, respectively). Reply at 58. This argument is untimely, as it was raised for the first time in reply, and so should be disregarded. In all cases, Starz’s single, conclusory sentence on this issue is insufficient to carry its burden of showing by clear and convincing evidence that claims 20 and 21 — which require that “the assignment rule is not *based on* a timestamp” — necessarily fail to further distinguish upon claims 1 and 9 — which, with VideoLabs’ construction, require that “the assignment is not performed *by using exact timing information for the data segments* (e.g., by using data segment timestamp information).”

Starz also argues that the term “assignment rule” in claims 1 and 9 is indefinite.<sup>20</sup> But as VideoLabs explained, Starz’s argument is doomed because it fails to point out any actual ambiguity with the *scope of a claim*. Ans. Br. at 51-53. Starz’s argument is instead premised on its allegation that a *component* of a claim term is not sufficiently described in the specification. See Op. Br. at 49 (asserting that “[n]othing in the specification describes or defines any assignment rule that is not ‘predefinable,’” even though claims 1 and 9 encompass *all* assignment rules, not

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<sup>20</sup> Starz also does not dispute, and therefore concedes, that claims 16 and 17 are not indefinite. Ans. Br. at 53 n.19 (explaining why Starz’s indefiniteness argument does not apply to claims 16 or 17).

just non-predefinable assignment rules). Focusing on the definiteness of part of a claim term is simply the wrong analysis. *See Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014).

Starz does not meaningfully dispute VideoLabs' response to Starz's indefiniteness argument. Starz takes issue with VideoLabs' statement that, as a matter of logic, assignment rules are predefinable or not. Reply at 57. But Starz does not explain why this framework is purportedly incorrect or offer a plausible alternative. *Id.* Starz also (incorrectly) alleges that VideoLabs fails to address the scopes of independent claims 1 and 9 as compared with dependent claims 16 and 17, but does not explain why this would matter (if it were correct). *Id.* And, critically, Starz does not dispute VideoLabs' explanation of why these claims are definite. Ans. Br. at 51-53.

Starz instead attempts to dismiss VideoLabs' explanation of why the patent adequately describes assignment rules as "pure attorney argument," unsupported by evidence. Reply at 57. Starz is incorrect. VideoLabs cites to the patent specification's explanation that assignment rules are predefinable when they can be defined as part of the data file fragmentation process. Ans Br. at 53-54. If the assignment rules cannot be defined then, such as because they are defined closer to when the data segments are rendered, then they are not predefinable. *Id.* This distinction is straightforward, as it rests on whether the defining can happen prior to

a certain point in time or not. And because this point in time is only used for determining whether assignment rules are predefinable, even if there were some ambiguity about *when* it is, that is irrelevant to the scope of claims 1 and 9, which encompass *all* assignment rules.

Starz also improperly attempts to shift the burden of proof on indefiniteness to VideoLabs. Reply at 57-58. The law is quite clear that *Starz* must prove, by clear and convincing evidence, that any claims are invalid. *Microsoft Corp. v. I4I Ltd. P'ship*, 564 U.S. 91, 95 (2011). Hence, if attorney argument is insufficient to prevail, then Starz's indefiniteness argument necessarily fails, as Starz did not even cite any passages of the patent's written description in support of its position.

**F. U.S. Patent No. 8,605,794: “content-related . . . data segments”**

| <b>Term</b>                                                     | <b>Starz's Construction</b>                                                                | <b>VideoLabs' Construction</b>                                                                                                                    |
|-----------------------------------------------------------------|--------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------|
| “content-related . . . data segments”<br><br>(Claims 1, 3, 7-9) | “segments of content data that have a syntactical meaning within the respective data file” | “data segments ordered in a file such that they will present the file's contents in their intended presentation order when rendered sequentially” |

**1. Plaintiff's Opening Position**

Once again, Starz requests that a claim term merely be given the definition set forth by the patentee in the patent. The meaning of “content-related . . . data segments” is clear from the specification of the '794 patent, which expressly states that “[t]he term ‘content-related’ is understood to mean that first and second data

segments have a syntactical meaning within the respective data file.” Ex. 3, 4:14-17.

This is the definition proposed by Starz.

VideoLabs’ definition contravenes the specification’s express definition, and also lacks support in the specification. Under VideoLabs’ definition, the data segments must be “ordered in a file such that they will present the file’s contents in their *intended presentation* order when rendered *sequentially*.” It is unclear what VideoLabs means by “intended presentation.” To the extent this means that the content-related data segments need only be ordered in such a way that they can be output according to their chronological sequence, such a construction is erroneous. The ’794 patent’s claims already require “sequentially outputting . . . the content-related first data segments and the content-related second data segments *according to their chronological sequence*.” Ex. 3, cl. 1; *see also id.*, cls. 9, 22. VideoLabs’ proposed construction would improperly render these other claim limitations superfluous.

Moreover, the fact that data segments are “content-related” does not require a sequential order. Rather, “content-related” references “content” (not order), and thus a syntactical meaning within the respective data file, as the patentee’s own definition confirms. *See* Ex. 3, 4:14-17. Therefore, VideoLabs’ proposed construction should be rejected.

## 2. Defendant's Answering Position

The parties agree that the patentees acted as their own lexicographers and set forth a definition of “content-related . . . data segments,” Op. Br. at 61-62, but disagree on that definition. VideoLabs’ proposed construction accurately reflects the meaning the inventors ascribed to the term and expresses it clearly so that it can be consistently applied by the parties and understood by the jury. Starz’s proposed construction, by contrast, omits key aspects of the term’s definition, is vague, and invites juror confusion and attorney disagreement when it is applied to the accused products. It fails to capture the patentees’ intent and invites future disputes about claim scope.

The ’794 patent sets forth the meaning of “content-related . . . data segments” in the Detailed Description section of the specification:

The term “content-related” is understood to mean that first and second data segments have *a syntactical meaning within the respective data file*, such as e.g. *a plurality of succeeding second data segments represent the speech signal of a specific speaker within a dialog sequence*. Furthermore, *sections of the data file* can also be understood thereby, such as e.g. *individual images of a video sequence*. In the following description data segments always refer to content-based data segments.

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By the first data segments S1 is meant *data segments of the first data file D1 which have a content-related meaning for the first data file D1* such as e.g. *individual images in a video sequence or individual spoken words in an audio sequence*.

In this case the chronological sequence identifies that sequence of individual first data segments S1 in which, for example, the latter are played back visually or made audible. For example, *one data segment contains the word “Good” and a further data segment the word “Morning”, so the data segment containing “Good” is output first, and then the data segment containing “Morning”.*

’794 patent, 4:14-22, 49-60 (emphasis added). The specification thus makes clear, through its use of consistent and repeated language, that for “content-related . . . data segments,” *succeeding* data segments within a data file are ordered so as to present the content in its intended *sequence* when rendered. *VirnetX Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1317-19 (Fed. Cir. 2014); *Alloc, Inc. v. ITC*, 342 F.3d 1361, 1368-71 (Fed. Cir. 2003).

Thus, if a speaker in a movie scene says “Good Morning,” the corresponding audio data segments for that sequence will be ordered within the audio data file so that the “Good” audio segment is before the “Morning” data segment. Similarly, for the corresponding video sequence, the video data segment where the speaker mouths the word “Good” comes before the segment where the speaker mouths “Morning.” It is this purposeful ordering of data segments that makes them “content-related” and provides them with a “syntactical meaning” within their data file. VideoLabs’ proposed construction captures these relationships between the data segments and their files by including their sequential, chronological nature, while Starz’s does not.

The claims further support VideoLabs’ construction. Independent claims 1 and 9 require outputting the data segments “sequentially” and “according to their chronological sequence.” ’794 patent, claims 1, 9. It is only by organizing data segments within their data files in the intended presentation order — *i.e.*, the “Good” audio segment is before the “Morning” audio segment — that outputting the segments sequentially will also result in the segments being output chronologically. The examples in the specification further buttress this lexicography. *See, e.g.*, Figs. 1-2, 4:23-5:9 (processing the data segments in each data file sequentially, which maintains the chronological order of the content); Fig. 5, 6:4-27 (same).

Starz incorrectly claims that VideoLabs’ construction would render the claim limitation “according to their chronological sequence” superfluous. Op. Br. at 62. That the data segments are ordered chronologically *within their data files*, which is what VideoLabs’ construction requires, does not obviate the need to ensure that the segments are *output* sequentially and chronologically. Indeed, a benefit of the patent is that it uses assignment rules to quickly order and align the data segments, even if, for example, the segments arrive at a device out of order and need to have their original ordering restored. Exs. 13-15 (explaining that data packets transmitted over the Internet can arrive out of order); ’794 patent, 1:34-37, 2:36-46.

VideoLabs’ definition of “content-related . . . data segments” also makes sense in view of the problem the invention solved. While some media

synchronization techniques are used to *create* content for the first time — for example, splicing together various film sequences and audio samples to generate a movie — the ’794 patent is used to *maintain* the proper order of previously-existing content — e.g., re-assembling the audio and video data segments that make up a television broadcast. See ’794 patent, 1:34-2:3, 3:65-4:8 (describing known problems with traditional television broadcasts and other “data streams” that have an intended, chronological order that needs to be maintained by the device receiving the content). VideoLabs’ construction thus unambiguously captures the meaning that was assigned to the term by the inventors.

By contrast, Starz’s construction fails to inform the fact-finder of the metes and bounds of the term. It is not readily apparent what “syntactical meaning” means, and Starz’s brief sheds no light on what it believes these words to convey. Op. Br. at 61-62. Indeed, “syntactical meaning” is inherently context-based; certain rules of syntax govern the English language, while a very different syntax applies in the context for computer programming languages. Starz’s construction provides no guidance on what context or rules undergird the “syntactical meaning.”

Tellingly, Starz is unable to describe the meaning of its construction other than by using the words of the claim term being construed. *Id.* at 62 (“Rather, ‘content-related’ references ‘content’ (not order), and thus a syntactical meaning within the respective data file, as the patentee’s own definition confirms.”). This

circularity reveals that Starz’s construction is really no construction at all, but merely replaces one set of allegedly ambiguous words with another. This itself is a reason to deny Starz’s construction. Additionally, adopting the vague words “syntactical meaning” as part of the construction would fail to resolve the parties’ dispute about claim scope — when it is clear such a dispute exists. *See O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008).

### **3. Plaintiff’s Reply Position**

VideoLabs does not dispute that the patentees acted as lexicographers and provided their own definition for the term “content-related . . . data segments.” Ans. Br. at 63. The patentees provided this definition in no uncertain terms, stating that “[t]he term ‘content-related’ is understood to mean that first and second data segments have a syntactical meaning within the respective data file.” Ex. 3, 4:14-17. Yet, in attempt to avoid this express definition, VideoLabs makes the remarkable argument that the language *its own patent* uses to define “content-related . . . data segments” is vague, ambiguous, invites confusion, and fails to shed light on the bounds of the term. Ans. Br. at 63 (“Starz’s proposed construction . . . is vague, and invites juror confusion and attorney disagreement when it is applied to the accused products”), 66 (“Starz’s construction fails to inform the fact-finder of the metes and bounds of the term.”), 67 (“Starz’s construction . . . replaces one set of allegedly ambiguous words with another.”). If VideoLabs is to be taken for its word here, then

the term should be found indefinite. *See Halliburton Energy Servs. v. M-I LLC*, 514 F.3d 1244, 1251 (Fed. Cir. 2008) (“Even if a claim term’s definition can be reduced to words, the claim is still indefinite if a person of ordinary skill in the art cannot translate the definition into meaningfully precise claim scope.”).

VideoLabs’ attorneys now seek to replace the language *the patentees chose* to define the term with their own understanding about what a limited number of exemplary embodiments in the specification purportedly describe. Ans. Br. at 63-65. According to VideoLabs, the express definition in the patent should be ignored, and the term construed only according to the descriptions of exemplary embodiments (identified by the phrase “such as e.g.”). Ans. Br. at 63-64 (citing Ex. 3, 4:14-22, 49-60). Both the logic and its application are flawed, as VideoLabs’ proposed construction is improperly focused on what they assert ***can be done with*** a content-related data segment, rather than the relevant question of what a content-related data segment ***is***.

For instance, VideoLabs relies on an example in which a data segment containing the word “Good” is output before the data segment containing the word “Morning.” Ans. Br. at 63-64 (citing Ex. 3, 4:14-22, 49-60). But the order in which data segments are eventually output says nothing about what the data segments ***are***. Contrary to VideoLabs’ unsupported assertions, the passage never discloses that if a speaker in a movie says “Good Morning,” then the data segments must have been

“ordered within the audio data file so that the ‘Good’ audio segment is before the ‘Morning’ data segment.” Ans. Br. at 64. Indeed, VideoLabs itself explains that sequential outputting is achieved by *what is done to* a data segment. *See, e.g.*, Ans. Br. at 65 (“Independent claims 1 and 9 require outputting the data segments ‘sequentially’ and ‘according to their chronological sequence.’”); *id.* (“the patent . . . uses assignment rules to quickly order and align the data segments”). Imposing that eventual outcome onto the construction of the term itself is improper. *See, e.g.*, *Meds. Co.*, 853 F.3d at 1306 (explaining that a proposed construction was problematic “because it amounts to a mere recitation of the results obtained from ‘efficient mixing’ rather than a definition of what the efficient mixing process is.”); *Halliburton Energy Servs.*, 514 F.3d at 1255 (rejecting a proposed construction that was in part “functional, i.e., . . . defined ‘by what it does rather than what it is.’”). The end result, as Starz has already explained, is that VideoLabs’ construction would render superfluous the other limitations of the claim that require and result in sequential outputting. Op. Br. at 62.

Therefore, the Court must reject VideoLabs’ proposed construction and adopt the definition the patentees gave to the term.

#### **4. Defendant’s Sur-Reply Position**

Starz had two chances to explain its understanding of “syntactical meaning” but both times failed to do so. Op. Br. at 61-62; Reply at 67-69. Starz’s construction

does not clarify the scope of the disputed claim term — the purpose of claim construction — and so must be rejected.

Starz nevertheless insists its opaque proposal should be adopted because it allegedly reflects definitional words taken directly from the patent. Reply at 67-68. But Starz’s construction picks out only the first part of the first sentence of the patent’s definition (the words before the comma) and actively ignores the rest. ’794 patent, 4:14-22, 49-60. Starz’s construction thus fails to account for the patent’s actual, full definition of the term, in particular the explanation of what it means for data segments to have “syntactical meaning” within a data file. Ans. Br. at 63-67. Indeed, neither party contends “syntactical meaning” has a well-known meaning to those skilled in the art; its meaning must thus be derived from the intrinsic evidence. *Id.*; see *VirnetX, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1317-19 (Fed. Cir. 2014) (“As an initial matter, we note that there is no dispute that the word ‘secure’ does not have a plain and ordinary meaning in this context, and so must be defined by reference to the specification.”). Yet only VideoLabs analyzes the intrinsic evidence regarding “syntactical meaning” and sets forth a construction capturing its meaning.

Unable to defend its construction other than by insisting (wrongly) that it reflects the patentee’s definition, Starz spends its Reply attacking VideoLabs’ construction. Starz’s criticisms are based on mischaracterizations of VideoLabs’ construction and supporting arguments.

Starz first asserts that VideoLabs calls the definition of “content-related . . . data segments” vague and ambiguous, and so the term is indefinite. Reply at 67-68. Not so. VideoLabs calls *Starz’s construction* vague and ambiguous. Ans. Br. at 66-67. Starz surely knows this, but nevertheless attempts to redirect VideoLabs’ criticisms of Starz’s construction because Starz is unable to refute them.

Starz also alleges that VideoLabs’ construction is improperly based on exemplary embodiments. Reply at 68. First, VideoLabs does not insert exemplary language or embodiments verbatim into its construction. VideoLabs instead takes the *meaning* conveyed by examples and incorporates it into the term’s definition. That is completely proper. See *ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1374-76 (Fed. Cir. 2009). Second, the parties are actually in agreement that exemplary language of the ’794 patent *can* be definitional. For the term “output,” the parties’ agreed-upon construction is based on specification language that comes *after* the words “for example.” D.I. 69, at 4; ’794 patent, 2:43-46. Yet for the term “content-related . . . data segments,” Starz ignores the definitional language after the words “such as” — which is analogous to “for example” — while VideoLabs’ construction takes it into account. ’794 patent, 4:14-22, 49-60.

Finally, Starz argues VideoLabs’ construction describes what can be “done with” content-related data segments instead of what they are. Reply at 68-69. To the contrary, VideoLabs’ construction describes what it means for data segments to

be “content-related.”<sup>21</sup> Specifically, VideoLabs’ construction clarifies that “content-related” means succeeding data segments are *ordered* so as to present the content in its intended sequence when rendered. Other language in claims 1 and 9 govern how the data segments are output — i.e., what is “done with” them — such as the requirements that the data segments be output “sequentially” and “according to their chronological sequence.” ’794 patent, claims 1, 9. But those requirements for how data segments are used are not part of VideoLabs’ construction of “content-related . . . data segments.” The cases Starz cites that reject a proposed construction because they describe the results achieved by a claim term rather than the claim term itself are thus inapposite.

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<sup>21</sup> Both parties’ constructions include the words “data segments,” and so are focused on clarifying what it means for data segments to be “content-related,” not describing what data segments are.

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