IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

CARBYNE BIOMETRICS, LLC, **Plaintiff,** **vs.** **APPLE INC.,** **Defendant.**	**Civil Action No. 1:23-cv-00324** **JURY TRIAL**

PLAINTIFF CARBYNE BIOMETRICS, LLC'S RESPONSE TO DEFENDANT APPLE INC.'S PROPOSED CLAIM CONSTRUCTIONS

TABLE OF CONTENTS

I. INTRODUCTION 1

II. LEGAL STANDARD.....2

III. LEVEL OF ORDINARY SKILL IN THE ART 3

IV. BACKGROUND 3

A. The Authentication Patents 3

B. The Fraud Patents 4

V. ARGUMENT 5

A. Apple's proposed construction of "configured to" is unnecessary and would confuse a jury ('010 Patent at claim 1; '656 Patent at claim 1; '886 Patent at claim 1; '512 Patent at claims 1, 6, 11, 15, 21; '105 Patent at claims 1, 9; '138 Patent at claim 1) 5

B. "Wherein the virtual likeness of the face was selected by the account holder as part of an enrollment" is not indefinite just because it recites a functional limitation ('886 Patent at claims 1 and 11) 6

C. There is no support in the intrinsic record for limiting "set of images" to "set of photographs" ('886 claims 1, 6, 11) 9

D. Apple's misinterpretation of a past IPR does not support narrowing "restricted interface" absent an explicit disclaimer in the specification ('512 Patent at claims 1, 6, 11, 15, 21; '105 Patent at claims 9, 11, 28, 30; '138 Patent at claims 11, 23).....11

VI. CONCLUSION.....13

TABLE OF AUTHORITIES

Cases **Page(s)**

August Tech. Corp. v. Camtek, Ltd.,
655 F.3d 1278 (Fed. Cir. 2011).....10

Beneficial Innovations, Inc. v. Advance Publications, Inc.,
No. 2:11-cv-229-JRG-RSP, 2014 WL 186301 (E.D. Tex. Jan. 14, 2014) 7

H-W Tech., L.C. v. Overstock.com, Inc.,
758 F.3d 1329 (Fed. Cir. 2014).....8

Hill-Rom Servs., Inc. v. Stryker Corp.,
755 F.3d 1367 (Fed. Cir. 2014).....9, 12

IPXL Holdings, L.L.C. v. Amazon.com, Inc.,
430 F.3d 1377 (Fed. Cir. 2005).....6

K-2 Corp. v. Salomon S.A.,
191 F.3d 1356 (Fed. Cir. 1999).....2

Koninklijke KPN NV v. Telefonaktiebolaget LM Ericsson, et al.,
Case No. 2-22-cv-282, Dkt. 176 (E.D. Tex. Oct. 13, 2023) 5

Liebel-Flarsheim Co. v. Medrad, Inc.,
358 F.3d 898 (Fed. Cir. 2004).....3, 9, 10, 13

MasterMine Software, Inc. v. Microsoft Corp.,
874 F.3d 1307 (Fed. Cir. 2017).....8

Microprocessor Enhancement Corp. v. Texas Instruments Inc.,
520 F.3d 1367 (Fed. Cir. 2008).....7

Omega Engineering, Inc, v. Raytek Corp.,
334 F.3d 1314 (Fed. Cir. 2003).....2

Phillips v. AWH Corp.,
415 F.3d 1303 (Fed. Cir. 2005).....10

RightQuestion, LLC v. Samsung Electronics Co., Case
2:21-cv-238-JRG, Dkt. 75 (E.D. Tex. Apr. 18, 2022) 3

Thorner v. Sony Comput. Entm't Am. LLC,
669 F.3d 1362 (Fed. Cir. 2012).....2

U.S. Surgical Corp. v. Ethicon, Inc.,
103 F.3d 1554 (Fed. Cir. 1997).....2

U.S. Well Servs., Inc. v. Halliburton Co.,
No. 6:21-cv-367-ADA, 2022 WL 819548 (W.D. Tex. Jan. 17, 2022).....7

TABLE OF EXHIBITS[1]

Ex.	Description
A	U.S. Patent No. 9,972,010
B	U.S. Patent No. 10,713,656
C	U.S. Patent No. 11,526,886
D	U.S. Patent No. 10,929,512
E	U.S. Patent No. 11,475,105
F	U.S. Patent No. 11,514,138
G	U.S. Patent Application No. 16/893,237 File Wrapper
H	Webster's New World Dictionary® of Computer Terms (5th Ed. 1994)
I	Jargon an Informal Dictionary of Computer Terms (1993)
J	Dictionary of Computer and Internet Terms (8th Ed. 2003)
K	*Samsung Electronics Co., Ltd. et al v. RightQuestion, LLC*, IPR2022-00251, Paper 11 (Patent Owner Preliminary Response) (PTAB Mar. 14, 2022)
L	*Samsung Electronics Co., Ltd. et al v. RightQuestion, LLC*, IPR2022-00251, Paper 1 (Petition for IPR) (PTAB Dec. 1, 2021)
M	*RightQuestion, LLC v. Samsung Electronics Co., Ltd. et al*, Case No. 2-21-cv-238, Dkt. 39 (Joint Claim Construction Statement) (E.D. Tex. Jan. 14, 2022)

[1] Exhibits A through J were submitted as exhibits to Apple's Opening Brief. *See* Dkt. No. 42-2 to 42-9.

I. INTRODUCTION

Apple urges constructions of four terms that a POSITA—and even a layperson—could easily understand. Apple's proposed constructions do not give "clarity," as Apple claims, but invite confusion. The Court should reject Apple's proposed constructions and give all the disputed terms their plain and ordinary meanings.

"Configured to." Apple asks the Court to construe "configured to" across all the Asserted Patents[2] as "not merely being capable of being configured but rather actually being configured." The parties agree that "configured to" requires more than being "capable of" being configured. So no construction is needed, and Apple's proposed construction would be unhelpful and confusing.

"Virtual likeness." Apple contends that "wherein the virtual likeness of the face was selected by the account holder as part of an enrollment" creates an indefinite mixed apparatus-method claim. But that language describes functional limitations and passive actions by the device. No action by a user is required to infringe. The system is functionally limited by the requirement that the user must have a virtual likeness, but infringement occurs when a device is able to render the virtual likeness. The cases Apple cites do not apply here because they address infringement, not claim construction.

"Set of images." The Court should not limit "set of images," describing the captured biometric information for determining whether a user is alive, to "set of photographs." "Images"

[2] U.S. Patent Nos. 10,929,512 ("the '512 Patent"); 11,475,105 ("the '105 Patent"); 11,514,138 ("the '138 Patent") (collectively "the Authentication Patents"); 9,972,010 ("the '010 Patent"); 10,713,656 ("the '656 Patent"); and 11,526,886 ("the '886 Patent") (collectively "the Fraud Reduction Patents") (the Authentication and Fraud Reduction Patents are collectively referred to as "the Asserted Patents")

is well understood. Apple's proposal to substitute the term "photographs" for "images" improperly narrows the term and lacks intrinsic support.

"Restricted interface." Apple asks the Court to construe the term as "a physical or software interface with limited accessibility." Apple claims that, in a past IPR, Carbyne's predecessor (RightQuestion) argued that this term needed construction. Not so. In the IPR, RightQuestion argued only that the Petitioner (Samsung) failed to carry its burden of showing that the prior art taught a "restricted interface." That aside, Apple's proposed limiting construction lacks the required specification support.

II. LEGAL STANDARD

"Claim construction is a matter of resolution of disputed meanings and technical scope, to clarify and when necessary to explain what the patentee covered by the claims, for use in the determination of infringement. It is not an obligatory exercise in redundancy." *U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997). During claim construction, "[c]ourts do not rewrite claims; instead, [they] give effect to the terms chosen by the patentees." *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1364 (Fed. Cir. 1999). So courts generally give terms "their ordinary and customary meanings as understood by a person of ordinary skill in the art when read in the context of the specification and prosecution history." *Thorner v. Sony Comput. Entm't Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012) (citation omitted). And they indulge a "heavy presumption that claim terms carry their full ordinary and customary meaning." *Omega Engineering, Inc, v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003) (internal quotes omitted). Although the specification may suggest that certain embodiments are preferred, "it is improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that

the patentee intended the claims to be so limited." *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004).

III. LEVEL OF ORDINARY SKILL IN THE ART

The POSITA "would have had a bachelor's degree in electrical engineering, computer engineering, computer science, or a related field, and approximately 2 years of experience working with secure computing systems or a related field." *RightQuestion, LLC v. Samsung Electronics Co., Case* 2:21-cv-238-JRG, Dkt. 75 at 6 (E.D. Tex. Apr. 18, 2022) (citing *id*. at Dkt. No. 49-4 (Dr. Jones Decl.) ¶ 24). No differences between this description and Apple's, *see* Opening Br. 4, materially affect the dispute.

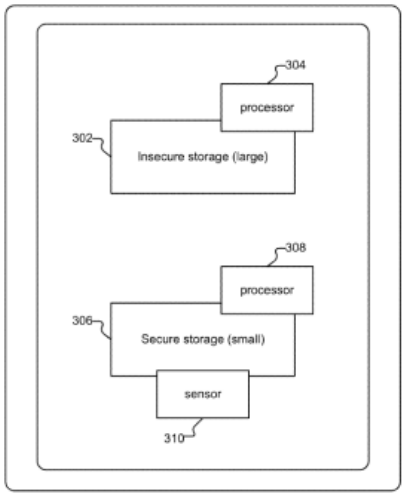
IV. BACKGROUND

A. The Authentication Patents[3]

The Authentication Patents claim systems and methods for providing credentials to an external resource using a combination of novel hardware architecture and software. *See generally* Ex. D ('512 Patent) at 1:35–44, Fig. 1–3. They promote security by deterring users from using poor quality or recycled passwords. *Id*. at 1:35–44. To achieve this goal, users must feel comfortable using complex, unique passwords. But users likely have hundreds of credentials for their various accounts, making it difficult to use a strong password for each account. So the Authentication Patents disclose a novel hardware architecture that enables users to use the device's biometric sensor to safely store and retrieve credentials.

[3] Unless otherwise noted, for the Authentication Patents citations are to the '512 Patent.

For example, Figure 3 shows an embodiment of the hardware architecture used to store and retrieve credentials. Ex. D ('512 Patent) at 1:55–56, 3:66–67, Fig. 3. Mobile phone 300 includes a large insecure storage 302 attached to a fast processor 304. A smaller but secure storage 306 is attached to a dedicated processor 308 and a sensor 310, which can be a camera or a fingerprint reader. *Id*. at 3:67–4:4. "Users (and applications) can read from and write to the insecure storage area. However, users cannot access the secure storage area and the fast processor can "only communicate with the dedicated processor/sensor via a restricted API." *Id*. at 4:5–8. By limiting what can access the secure storage area, the device safely stores all a user's most important credential information so that a user can use and easily retrieve strong passwords.



B. The Fraud Patents[4]

The Fraud Patents claim systems and methods for preventing or reducing fraud in electronic transactions by "increasing the likelihood (either real or perceived by the fraudster) that the fraudulent act will be detected." Ex. C ('886 Patent) at 4:57–59. When a user tries to transact online, the invention captures "contextual information comprising location data" and "a set of biometric information, wherein capturing the set of biometric information comprises capturing, using a camera, a set of images." *Id.* The system displays a rendering of a virtual likeness of a user as a method to reduce fraud by humanizing the virtual transaction. *Id.* at 5:14-16, cl. 1. Fraud-detection analysis is then performed to determine whether an electronic

[4] The Fraud Patents share a common specification. Unless otherwise noted, citations for Fraud Patents are to the '886 Patent.

transaction can proceed, based, at least in part, on an analysis of the set of images to confirm that the user is alive. *Id.* The '886 Patent discloses multiple embodiments for collecting and analyzing the captured images. For example, "taking multiple photographs in rapid succession[] can be employed to make sure that the fraudster isn't using camera 112 to photograph a printed picture," *id.* at 9:1–3, or "a fingerprint of the user can be captured," *id.* at 9:27–28.

V. ARGUMENT

A. Apple's proposed construction of "configured to" is unnecessary and would confuse a jury ('010 Patent at claim 1; '656 Patent at claim 1; '886 Patent at claim 1; '512 Patent at claims 1, 6, 11, 15, 21; '105 Patent at claims 1, 9; '138 Patent at claim 1)

The Court should reject Apple's proposed construction of "configured to" as "not merely being capable of being configured but rather actually being configured" because it is unnecessary. The parties agree that the plain meaning of "configured to" requires more than being "capable of" being configured. Laypeople and those skilled in the art would share this understanding, making a construction of "configured to" unnecessary.

Courts give "configured to" its plain meaning when, as here, the parties do not dispute the term's plain meaning. For example, in *Ahern Rentals, Inc. v. EquipmentShare.com, Inc.*, the alleged infringer argued that "configured to" means not just "capable of" or "suitable for" configuration, and the patentee never disagreed. No. 2:20-cv-333-JRG, 2021 WL 4891379, at *11 (E.D. Tex. Oct. 19, 2021). Since the parties agreed that "configured to" requires more than just being "capable of" or "suitable for" configuration, the court gave "configured to" its plain and ordinary meaning. *Id.*; *see also Koninklijke KPN NV v. Telefonaktiebolaget LM Ericsson, et al.*, Case No. 2-22-cv-282, Dkt. 176 at 33–36 (E.D. Tex. Oct. 13, 2023) (giving "configured for" its plain meaning when the parties agreed that "'configured for' requires more than capability"); *Impinj, Inc. v. NXP USA, Inc. f/k/a NXP Semiconductors USA, Inc.*, Case No: 6-21-cv-530, Dkt.

56 at 5 (W.D. Tex. Feb. 10, 2022) (describing "configured to" as "plain and ordinary" and refusing the defendant's construction of "made or designed to perform a specific function"). Here too, the parties agree that "configured to" requires more than being "capable of" configuration. Because the parties agree on that plain, easily understood meaning, no construction is needed.

Apple's proposed construction would confuse the jury for three reasons. First, Apple's proposed construction is circular because it uses the term ("configured to") to define itself. Second, it inserts a negative example (*not* just capable of being configured) into the definition. Third, it injects unexplained levels of configuration that are relative to each other and mutually exclusive. Because a POSITA would understand "configured to" as written, the Court should not risk promoting confusion.

In sum, no dispute needs to be resolved. The parties agree that "configured to" means more than "capable of," and Apple's proposed construction would invite confusion. The Court should give "configured to" its plain and ordinary meaning without construction.

B. "Wherein the virtual likeness of the face was selected by the account holder as part of an enrollment" is not indefinite just because it recites a functional limitation ('886 Patent at claims 1 and 11)

The term "wherein the virtual likeness of the face was selected by the account holder as part of an enrollment" recites functional-limitation language that describes the virtual likeness rendered in the user interface. Thus, it is not indefinite. Reading the claims together with the specification, a POSITA would understand that infringement occurs when a device able to render a virtual likeness is manufactured. Apple's cases do not compel a contrary conclusion.

The '886 Patent's reference to "select[ion] by an account holder" does not improperly mix method and apparatus limitations. A claim can be indefinite if it claims both an apparatus and method steps for using the apparatus. *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d

1377, 1384 (Fed. Cir. 2005). "[M]ixed method-apparatus claims are indefinite when it is unclear whether infringement occurs 'when one creates a system that allows the user to [perform the step] . . . or . . . when the user actually [performs the step].'" *U.S. Well Servs., Inc. v. Halliburton Co.*, No. 6:21-cv-367-ADA, 2022 WL 819548, at *9 (W.D. Tex. Jan. 17, 2022) (quoting *IPXL*, 430 F.3d at 1384).

But an apparatus claim does not improperly mix forms just by including "functional limitations that describe a structure by reciting its capabilities." *Beneficial Innovations, Inc. v. Advance Publications, Inc.,* No. 2:11-cv-229-JRG-RSP, 2014 WL 186301, at *2 (E.D. Tex. Jan. 14, 2014). When an apparatus claim is "clearly limited to a [system] possessing the recited structure and *capable* of performing the recited functions," it is not indefinite. *Microprocessor Enhancement Corp. v. Texas Instruments Inc.*, 520 F.3d 1367, 1375 (Fed. Cir. 2008). "Specifically, claims are not indefinite mixed method-apparatus claims when the functional language of a claim merely describes the structure and capabilities of the claimed apparatus." *U.S. Well Servs.*, 2022 WL 819548, at *9 (citing *UltimatePointer, L.L.C. v. Nintendo Co.*, 816 F.3d 816, 827 (Fed. Cir. 2016)).

The disputed claims here do not improperly mix apparatus and method forms. First, the disputed claims recite a functional limitation that describes a structure by reciting its capabilities. They recite a structure for "rendering, in one or more interfaces, a virtual likeness of a face associated with an account holder, wherein the virtual likeness of the face was selected by the account holder as part of an enrollment." Ex. C at cl. 11 (computer program); *see also id.* cl. 1 (apparatus). The requirement that "the virtual likeness of the face" be "selected by the account holder as part of enrollment" describes how the claimed structure functions. The system does not generate a virtual likeness on its own. It needs to take a photo of the user or pull from external

sources. *Id.* at 5:49–51, 7:10–11. But infringement occurs as soon as a device is manufactured that functions in the described manner—that is, the device is able to render the selected virtual likeness.

Second, selection of the virtual likeness is passive. "Selected by" merely describes the "virtual likeness" rendered *by the device*. The device—not the user—performs the only action described in the claim. Thus, "[w]hile these claims make reference to user selection, they do not explicitly claim the user's acts of selection, but rather, claim the system's capability to receive and respond to user selection." *See MasterMine Software, Inc. v. Microsoft Corp.*, 874 F.3d 1307, 1316 (Fed. Cir. 2017) (so reasoning for a claim reciting a module in a software application, wherein the module "receives from the user a selection of one or more of the user-selectable database fields"). Here, the patent claims the system's capability to receive and react to the selected virtual likeness by rendering that virtual likeness. It does not claim the act of selecting the virtual likeness.

Apple's cases do not apply here. Two of Apple's cases address infringement, not claim construction. *See* Opening Br. at 9 (citing *Desenberg v. Google, Inc.*, 392 F. App'x 868, 871 (Fed. Cir. 2010) (holding that a method claim required all steps to be performed by a user in an infringement analysis); *Acceleration Bay LLC v. Elec. Arts Inc.*, No. 1:16-cv-454-RGA, 2019 WL 1376036, at *5 (D. Del. Mar. 27, 2019) (holding that infringement was not established where some steps occur outside the United States)). Apple's only claim-construction case is unlike this one. *See* Opening Br. at 9-10 (citing *H-W Tech., L.C. v. Overstock.com, Inc.*, 758 F.3d 1329, 1335–36 (Fed. Cir. 2014)). In *H-W Technology*, the user's "select[ing] one of said variety of offers" was claimed by the patent and required for infringement. 758 F.3d at 1333, 1335.

Here, in contrast, the virtual likeness is merely a functional limitation as to what the device can render.

In sum, the disputed claims are not indefinite. They do not improperly mix apparatus and method forms but properly recite a functional limitation describing the structure by reciting that it can render a virtual likeness selected by a user.

C. There is no support in the intrinsic record for limiting "set of images" to "set of photographs" ('886 claims 1, 6, 11)

For the claim limitation "wherein capturing the set of biometric information comprises capturing, using a camera, a set of images," Apple proposes swapping "images" for the narrower "photographs" used to describe embodiments in the specification. Opening Br. 10–11. The Court should reject Apple's proposed construction because "set of photographs" improperly narrows "set of images" and lacks intrinsic support. Instead, the Court should adopt the term's plain and ordinary meaning.

The plain and ordinary meaning applies unless "a patentee set out a definition and acts as his own lexicographer" or "disavows the full scope of the claim term either in the specification or during prosecution." *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014). But "it is improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited." *Liebel-Flarsheim Co.*, 358 F.3d at 913; *see also Hill-Rom*, 755 F.3d at 1371 (finding no disclaimer of the full claim scope where the intrinsic record included no words of exclusion or restriction for the disputed term).

Apple identifies no intrinsic support for limiting "set of images" to "set of photographs." The specification includes no words of exclusion or restriction suggesting that the patentee intended to limit "images" to "photographs." *See* Ex. C ('886 Patent) at 8:56–9:7. And the

patentee did not act as his own lexicographer. The specification does not define "set of images." It instead describes an embodiment in which a purchaser photographs himself or provides a photograph, and an analysis of the photograph is performed as part of an electronic transaction to determine whether the object of the photograph is alive. Ex. C at 8:62–66. One "[t]echnique[] for confirming that the object being photographed is alive" that can be employed in "some embodiments" includes "taking multiple photographs in rapid succession" to ensure a fraudster is not using a "printed picture" or that "a certain amount of flesh tone [is] present." *Id*. at 8:66–9:6. But the specification does not define "set of images" as limited to the techniques using "photographs" that this embodiment employs. Without clear direction from the specification, the Court should not read limitations from an embodiment into the claims. *See Liebel-Flarsheim Co.*, 358 F.3d at 913.

The claims also make clear that the term "images" is broader than "photographs." The dependent claims recite a system (claim 4) and method (claim 9) "wherein the image comprises at least one of a photograph or an avatar." By specifying that the "image" may be comprised of a "photograph," these claims establish that the two words are not interchangeable and that "image" is a broader categorization that includes "photograph." "Because claim terms are normally used consistently throughout the patent," "set of images" in the independent claims is also broader than and inclusive of a "set of photographs." *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005).

Finally, Apple's file-history argument also fails. "[I]t is particularly important not to limit claim scope based on statements made during prosecution '[a]bsent a clear disavowal or contrary definition.'" *August Tech. Corp. v. Camtek, Ltd.*, 655 F.3d 1278, 1286 (Fed. Cir. 2011) (citations omitted). Here, the applicant did not restrict the term "images" to "photographs" during

prosecution. In fact, the applicant did the opposite by expanding the limitation for collecting biometric information from a "photograph of the user" to a "set of images" during the amendment process. For example, dependent claims 4 and 12 of the applicant's preliminary amendment to U.S. Application No. 16/893,237 led to the '886 Patent. Those claims recited the system now in claim 1 and the method now in claim 2 "wherein the set of captured biometric information is associated with at least one of a fingerprint, an audio sample, and a photograph of the user." Ex. G at 10–11. The applicant later withdrew these dependent claims, however, and added the "set of images" limitation following an interview with the examiner to discuss remedying a § 101 rejection in which the examiner "suggested bringing in elements from the parent application [for the '010 Patent] directed towards the concept of fraud detection on the ***images*** to determine if the user is alive." *Id.* at 29, 63–66. The applicant amended the independent claims to what are now claims 1, 6, and 11 of the '886 Patent, which recite a "set of biometric information [that] comprises capturing, using a camera, a set of images." *Id.* at 63. Thus, the applicant and examiner understood that "photographs" and "images" were not interchangeable. The applicant chose "images" in the independent claims of the '886 Patent, confirming that he chose not to limit this term to "photographs."

In sum, Apple's narrowing argument lacks intrinsic support, and so the Court should give "set of images" its plain and ordinary meaning.

D. Apple's misinterpretation of a past IPR does not support narrowing "restricted interface" absent an explicit disclaimer in the specification ('512 Patent at claims 1, 6, 11, 15, 21; '105 Patent at claims 9, 11, 28, 30; '138 Patent at claims 11, 23)

The Court should reject Apple's proposed construction of "restricted interface" as "a physical or software interface with limited accessibility" because it lacks support in the

specification. "Restricted interface" is readily understood by a POSITA and easy to explain to jurors. It needs no construction and it should be given its plain meaning.

Apple's only argument is that a construction is needed because Carbyne's predecessor (RightQuestion) sought one in a past IPR against the '512 Patent. Not so. In that IPR, RightQuestion argued that the petitioner (Samsung) failed to show that the cited prior art taught restricted interfaces:

> Petitioner later states the processors communicate via a "local interface, data bus, or another network." Pet. 28. None of these are a "restricted interface" and [P]etitioner has not offer a single piece of evidence to the contrary. Indeed, Petitioner's "expert" does not even opine on whether a POSITA would have viewed a local interface, data bus, or another network as a restricted interface. *See* Ex. 1002 at ¶¶ 100–101.

Ex. K (Patent Owners Preliminary Response to IPR2022-00251) at 38. RightQuestion did not propose a construction or restrict the scope of a restricted interface. RightQuestion simply pointed to Samsung's failure to meet its IPR burden. In fact, neither side thought "restricted interface" needed construction in either the IPR or RightQuestion's district-court case against Samsung. *See* Ex. L (IPR2022-00251 Petition) at 7 ("Petitioner does not believe that any term requires explicit construction to resolve the issues presented in this Petition"); Ex. K (Patent Owners Preliminary Response to IPR2022-00251); Ex. M (*RightQuestion, LLC v. Samsung Electronics Co., Ltd. et al*, Case No. 2-21-cv-238, Dkt. 39 (Joint Claim Construction Statement) (E.D. Tex. Jan. 14, 2022)).

Regardless, a construction is unwarranted here or permitted under Federal Circuit precedent. Apple seeks to limit "restricted interface" to "a physical or software interface with limited accessibility." Opening Br. 13. But Apple identifies no definition or disavowal (nor can it) that would justify limiting the ordinary meaning of "restricted interface." *See Hill-Rom Servs., Inc.*, 755 F.3d at 1371. Moreover, no intrinsic or extrinsic evidence defines "restricted interface"

or limits it to a physical or software interface. Nor does Apple identify differences between a physical or software interface, or explain why those words would clarify "restricted interface." As intrinsic evidence, Apple cites the use of "restricted interface" in "some embodiments" from the '105 Patent. Opening Br. 14-15. But even if those were the preferred embodiments, "it is improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited." *Liebel-Flarsheim.*, 358 F.3d at 913.

As for the extrinsic evidence, Apple cites dictionary definitions of "interface" but cites no definition of "restricted" or "restricted interface." And Apple offers no expert testimony that a POSITA would understand "restricted interface," based on these dictionary definitions, to mean "a physical or software interface with limited accessibility." At any rate, without the required disclaimer in the specification or prosecution history, there is no reason to narrow "restricted interface" to "a physical or software interface with limited accessibility."

At bottom, Apple rests its construction on a misinterpretation of an IPR, and Apple's proposed construction lacks the required specification disclaimer. The Court should deny Apple's request to clarify "restricted interface" and should give it its plain and ordinary meaning.

VI. CONCLUSION

The Court should refuse Apple's proposed constructions and give the disputed terms their plain and ordinary meanings.

Dated: October 25, 2023.

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the above and foregoing document has been served on all counsel of record via the Court's ECF system on October 25, 2023.

/s/ Joshua W. Budwin
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