Microsoft Corporation (Petitioner)
v.
Proxense, LLC (Patent Owner)

Petitioner's Demonstratives

Case No. IPR2024-00405
U.S. Patent No. 10,073,960
Case No. IPR2024-00407
U.S. Patent No. 9,679,289
Before Thu A. Dang, David C. McKone, and Norman H. Beamer
Administrative Patent Judges

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Exhibit 1037
Microsoft v. Proxense
IPR2024-00407

Table of Contents

- **Overview of Proceedings**
- **Claim Construction Dispute**
  - In Dispute - "Local Secured Information", "Integrated RDC," "Integrated Wireless Communication Interface" and "Enablement Signal" Claim Terms
- **IPR (Petition) Challenge: Unpatentability over Prior Art**

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Overview of Proceedings

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Asserted Grounds

960

Ground	Claim(s)	35 U.S.C. § 102/103
1A	1-20	Giobbi-157 in view of Giobbi-139
1B	1-20	Giobbi-157 in view of Giobbi-139 and Dua
2A	1-8, 10-11, and 14-19	Broadcom
2B	1-20	Broadcom in view of Giobbi-157

960 Pet., 1-2.

289

Ground	Claim(s)	35 U.S.C. § 102/103
1A	1-20	Giobbi-157 in view of Giobbi-139
1B	1-20	Giobbi-157 in view of Giobbi-139 and Dua
2A	1-8, 10-11, and 14-19	Broadcom
2B	1-20	Broadcom in view of Giobbi-157

289 Pet., 1-2.

FISH

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

The ’289 and ’960 Patent Overview

The ’960 Patent is directed to “a hybrid device” that includes a personal digital key (PDK) and a receiver-decoder circuit (RDC) coupled in communication with each other. MS-1001, 2:32-54. The integrated PDK communicates wirelessly with an external RDC and the integrated RDC communicates wirelessly with at least one external PDK within its proximity zone. MS-1001, 4:33-59. The specification discloses that the integrated PDK is capable of storing local, secured financial information or secured biometric information for authenticating a user. MS-1001, 3:58-4:16. Similarly, the external PDK is also capable of storing information. MS-1001, 4:33-59. For example, in one embodiment, the integrated PDK carries credentials such as credit card or account information that are used to enable services associated with the external RDC. MS-1001, 5:36-44. A user can make a purchase with the hybrid device provided that they are in possession of the external PDK and in proximity to the hybrid device. If so, the external PDK wirelessly connects to the integrated RDC and authorizes the integrated PDK to enable a transaction by sharing credit card or account information with the external RDC. *Id.*; MS-1003, ¶¶[26]-[27].

960 Pet., 4-5; similar to 289 Pet., 4-5.

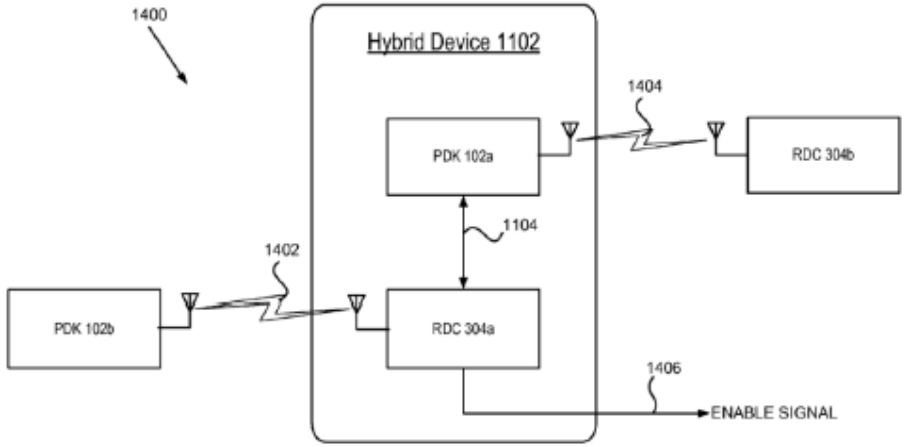


FIG. 14

MS-1001(960 and 289), FIG 14 (cited by 960 POR, 24 and 289 POR, 24).

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

’289 Patent Claims 1 and 14

1. A hybrid device comprising:

an integrated, secure memory storing local, secured information; and

an integrated reader-decoder circuit (RDC) for communicating wirelessly with at least one external device within a proximity zone, the integrated RDC communicatively coupled to the integrated, secure memory for communication with the integrated, secure memory,

wherein one or more of (a) the integrated RDC communicating wirelessly with the at least one external device within the proximity zone and (b) the local, secured information stored by the integrated, secure memory enables one or more of an application, a function, and a service.

MS-1001(289), Claim 1.

14. A method comprising:

creating a first wireless link between an integrated receiver-decoder circuit (RDC) of a hybrid device and an external device, the hybrid device including an integrated, secure memory and the integrated RDC, wherein the integrated, secure memory stores local, secured information;

receiving a first signal, at the integrated RDC, via the first wireless link, from the external device; and

generating an enablement signal enabling one or more of an application, a function and a service.

MS-1001(289), Claim 14.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

’960 Patent Claims 1 and 14

1. A device comprising:
a battery;
an integrated, secure memory storing local, secured information; and
an integrated, wireless communication interface for communicating wirelessly with at least one external device within a proximity zone, the integrated, wireless communication interface communicatively coupled to the integrated, secure memory and coupled to draw power from the battery,
wherein one or more of (a) the integrated, wireless communication interface communicating wirelessly with the at least one external device within the proximity zone enables one or more of an application, a function, and a service and (b) the local, secured information stored by the integrated, secure memory enables one or more of an application, a function, and a service.

MS-1001(960), Claim 1

14. A method comprising:
creating a first wireless link between an integrated, wireless communication interface of a device and an external device, the device including a battery, an integrated, secure memory, and the integrated, wireless communication interface, wherein the integrated, secure memory stores local, secured information and the integrated, wireless communication interface is powered by the battery;
receiving a first signal, at the integrated, wireless communication interface, via the first wireless link, from the external device; and
generating an enablement signal enabling one or more of an application, a function and a service.

MS-1001(960), Claim 14

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Claim Construction Dispute

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Main Dispute - Claim Construction

Microsoft Corporation ("**Petitioner**" or "**Microsoft**") submits this Petitioner Reply in response to the Patent Owner's Response ("**POR**") in IPR2024-00407, which challenges the validity of U.S. Patent No. 9,679,289 ("the '289 patent"). In its POR, Proxense, LLC ("**Proxense**" or "**Patent Owner**") does not dispute the characterizations of the prior art, or the combinations advanced in the Petition against claims 1-20 ("**the Challenged Claims**"). Instead, Proxense advances and heavily relies on very narrow constructions of various limitations of the Challenged Claims based on a legally unsupported belief that these limitations trigger 35 U.S.C. § 112(f) ("means plus function," "112(f)," "112(6)," or "MPF"). Having narrowly construed the claims, Proxense then argues that the Petition's invalidity challenge fails to meet these claim limitations, so construed. In doing so, Proxense sidesteps the substance of the 35 USC § 103 invalidity challenge in the Petition and entirely rests its arguments on overly narrow constructions, asserting that the now-narrowed limitations fail to be met by Gobbi-157, Giobbi-139, or any combination thereof.

289 Reply, 1; 960 Reply, 1.

Independent claims 1 and 14 each recite "enabling one or more of an application, a function, and a service." For the reasons stated above, claims 1 and 14 invoke 35 U.S.C. § 112, ¶ 6, such that the algorithm represented by control logic 250 and defining "local, secured information" performs the function of "enabling one or more of an application, a function and service. The Petition fails to establish Giobbi 157, Giobbi 139, or Dua, alone or in combination, "enables an application, a function, and a service" using the algorithm. Consequently, the Petition fails to establish claims 1 and 14, and the claims dependent thereon, are invalid and unpatentable.

289 POR, 29-30; 960 POR, 30.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Claim Terms in Dispute

Claim Term	Microsoft Proposed Construction	Proxense Proposed Construction
Integrated RDC communicating wirelessly with the at least one external device within the proximity zone. -289	RDC – "a component or collection of components capable of wirelessly receiving data in an encrypted format and decoding encrypted data for processing" 960 Pet., 3-4; 289 Pet., 3-5; 289 Reply, 5	**Why MPF?** – "None of these structures are recognized …as sufficiently *definite* structures for performing the ["enabling one or more of an application, a function and a service"] function." 289 POR, 7. "…the recited structures for performing the function are nothing more than the generic abilities of general-purpose computers or meaningless nonce words." 289 POR, 7. "But a 'processor and transceiver amount to nothing more than a general-purpose computer." *HTC Corp. v. IPCom GmbH & Co.*, KG, 667, F.3d 1270, 1280 (Fed. Cir. 2012) 289 POR, 21. **MPF Construction** – "RDC" performing the "enabling one or more of an application, a function and a service" consistent with "the algorithm of control logic 250" 960 POR, 21-22; 289 POR, 22.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Claim Terms in Dispute

Claim Term	Microsoft Proposed Construction	Proxense Proposed Construction
Integrated wireless communication interface communicating wirelessly with the at least one external device within the proximity zone. -960	Encompasses an RDC – "a component or collection of components capable of wirelessly receiving data in an encrypted format and decoding encrypted data for processing" 960 Pet., 3-4, 35-36; 289 Pet., 3-5; 289 Reply, 5	**Why MPF?** – "None of these structures are recognized …as sufficiently *definite* structures for performing the ["enabling one or more of an application, a function and a service"] function." 960 POR, 7. "…the recited structures for performing the function are nothing more than the generic abilities of general-purpose computers or meaningless nonce words." 960 POR, 7. "But a 'processor and transceiver amount to nothing more than a general-purpose computer." *HTC Corp. v. IPCom GmbH & Co.*, KG, 667, F.3d 1270, 1280 (Fed. Cir. 2012) 960 POR, 21. **MPF Construction** – "wireless communication interface communicating wireless with the at least one external device within a proximity zone" performing the "enabling one or more of an application, a function and a service" consistent with "the algorithm of control logic 250" 960 POR, 20-22;.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Claim Terms in Dispute

Claim Term	Microsoft Proposed Construction	Proxense Proposed Construction
Integrated, secure memory storing local, secured information	Encompasses a "personal digital key". 960 Pet., 3-4, 28; 289 Pet., 3-5, 28.	**Why MPF?** – "None of these structures are recognized …as sufficiently *definite* structures for performing the ["enabling one or more of an application, a function and a service"] function." 289 POR, 7. "…the recited structures for performing the function are nothing more than the generic abilities of general-purpose computers or meaningless nonce words." 960 POR, 7; 289 POR, 7. "'computer-readable media or storage devices amount to nothing more than a general-purpose computer." *Rain Computing v. Samsung Electronics America*, 989 F.3d at 1008 (Fed. Cir. 2021), 960 POR, 9-10; 289 POR, 9. **MPF Construction** – "local, secured information stored by the integrated, secure memory" performing the "enabling one or more of an application, a function and a service" consistent with "the algorithm of the control logic 250" 960 POR, 8-9; 289 POR, 19.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Claim Terms in Dispute

Claim Term	Microsoft Proposed Construction	Proxense Proposed Construction
Enablement signal	Ordinary and Customary Meaning. 960 Pet., 3-4, 55-56; 289 Pet., 3-5, 55-57.	**Why MPF?** – "None of these structures are recognized …as sufficiently *definite* structures for performing the ["enabling one or more of an application, a function and a service"] function." 289 POR, 7. "…the recited structures for performing the function are nothing more than the generic abilities of general-purpose computers or meaningless nonce words." 960 POR, 7; 289 POR, 7. "The term 'enablement signal' is not a structure recognized by those of ordinary skill in the art for performing the ["enabling function], rather, it is meaningless nonce merely reciting the function it performs." 960 POR, 22; 289 POR, 22. **MPF Construction** – "generating an enablement signal" performing the "enabling one or more of an application, a function and a service" consistent with "the algorithm of control logic 250". 960 POR, 22; 289 POR, 27.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Claim Construction Dispute Roadmap

- **Proxense's Alleged Means Plus Function (MPF) Constructions Are Inconsistent with Constructions It Advanced in Co-pending Litigation**
  - Microsoft Litigation
  - Samsung Litigation
  - Apple Litigation
  - Google Litigation
  - Proxense's assertion of consistency with litigation is not credible
- **Proxense's Alleged MPF Constructions Apply Wrong Legal Framework**
- **Proxense's Alleged MPF Constructions of "Local Secured Information," "Integrated RDC," and "Enablement Signal" Claim Terms Should Be Rejected**
  - Proxense has not met burden to rebut the presumption against MPF treatment
  - "Local secured information" term recites structure, making MPF inappropriate
  - "Integrated RDC" term recites structure, making MPF inappropriate
  - "Integrated wireless communication interface" term recites structure, making MPF inappropriate
  - Generating "enablement signal" step recites structure/act, making MPF/SPF inappropriate.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

14

Claim Construction Dispute

Proxense's Alleged MPF Constructions Are Inconsistent with Constructions It Advanced in Co-pending Litigation

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

15

Microsoft Litigation – Proxense Claim Construction Inconsistency

> As shown by its own evidence, Proxense's position at the PTAB deviates substantially from the position it adopted in the co-pending Microsoft litigation. EX-2005-2008; EX-2012. Nowhere in its briefing for the Microsoft litigation did Proxense ever assert that any of the terms of the '960 patent—or for that matter, any other of the asserted patents—were subject to interpretation under 112(f). *Id.*

960 Reply, 4; similar to 289 Reply, 4.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

16

Microsoft Litigation – Proxense Claim Construction Inconsistency

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
WACO DIVISION

PROXENSE, LLC,

Plaintiff,

v.

MICROSOFT, CORP.,

Defendant.

Civil Action No. 6:23-cv-00319-ADA

PLAINTIFF PROXENSE, LLC's RESPONSIVE CLAIM CONSTRUCTION BRIEF

EX-2006; (960 Reply, 4; 289 Reply, 4).

TABLE OF CONTENTS

I. INTRODUCTION 1
II. THE CLAIMED INVENTIONS 1
III. LEVEL OF ORDINARY SKILL IN THE ART 2
IV. AGREED CONSTRUCTIONS 2
V. CONSTRUCTION OF DISPUTED TERMS 3
A. FAMILY A 3
1. "access message" (730:1, 15; 954, 1; 905:1) 3
2. "wherein the biometric data and the scan data are both based on a fingerprint scan by the user" (730:5) 8
B. FAMILY B 10
1. "personal digital key" (042:10) 10
2. "receiver-decoder circuit" (042:10; 289:14, 16) 12
VI. CONCLUSION 15

EX-2006, TOC; (960 Reply, 4; 289 Reply, 4).

1. "personal digital key" (042:10)

Proxense's Construction	Microsoft's Construction
Adopts the Court's Construction in *Proxense v. Samsung*: An operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user.	a device that includes an antenna, a transceiver for communicating with the RDC and a controller and memory for storing information particular to a user

2. "receiver-decoder circuit" (042:10; 289:14, 16)

Proxense's Construction	Microsoft's Construction
Adopts the Court's Construction in *Proxense v. Samsung*: A component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing.	a circuit that wirelessly receives encrypted data from the PDK and decodes it

EX-2006, 10-12; (960 Reply, 4; 289 Reply, 4).

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Microsoft Litigation – Proxense Claim Construction Inconsistent with Markman Order

Claim Term	Microsoft's Proposed Construction	Proxense's Proposed Construction	Court's Final Construction
"receiver-decoder circuit" ('042 Patent, claim 10; '289 Patent, claim 14)	A circuit that wirelessly receives encrypted data from the PDK and decodes it	Adopt the construction from *Proxense v. Samsung*, 6:21-cv-00210: A component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing.	A component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing
"personal digital key" ('042 Patent, claim 10)	A device that includes an antenna, a transceiver for communicating with the RDC and a controller and memory for storing information particular to a user	Adopt the construction from *Proxense v. Samsung*, 6:21-cv-00210: An operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user.	An operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user

EX2012 (289 Reply, 3; 960 Reply, 3.)

FISH

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

18

Samsung Litigation - Proxense Claim Construction Inconsistency

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

PROXENSE, LLC,

Plaintiff,

vs.

SAMSUNG ELECTRONICS, CO., LTD. AND SAMSUNG ELECTRONICS AMERICA, INC.,

Defendant.

Case Nos. 6:21-cv-00210-ADA

JURY TRIAL DEMANDED

SAMSUNG'S OPENING CLAIM CONSTRUCTION BRIEF

EX-2009 ; (960 Reply, 4-5; 289 Reply, 4-5).

TABLE OF CONTENTS

		Page
I.	INTRODUCTION	1
II.	LEGAL STANDARD	2
III.	DISPUTED TERMS	3
B.	The '188/'700 patent family	11
1.	"hybrid device" (188:1-12,15,20) (700:1-13, 16)	11
2.	"personal digital key" (188:1,10) (700:1,11)	15
3.	"biometric information" (188:1,4,10,13)(700:4,14)	18
4.	"financial information" (188:5-6, 14, 17) (700:1,5-6,11,15,18)	20
5.	"receiver-decoder circuit" (188:1,10)(700:1,11)	21
6.	"inheritance information" (188:9,18)(700:9,19)	24
7.	"enablement signal" (188:10-12, 17)(700:11-13,18)	26
IV.	CONCLUSION	27

EX-2009, TOC; (960 Reply, 4-5; 289 Reply, 4-5).

2. "personal digital key" (188:1,10) (700:1,11)

Samsung's Proposed Construction	Proxense's Proposed Construction
"a device that includes an antenna, a transceiver for communicating with the RDC and a controller and memory for storing information particular to a user"	An operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user.

5. "receiver-decoder circuit" (188:1,10)(700:1,11)

Samsung's Proposed Construction	Proxense's Proposed Construction
"a device that provides a wireless interface to the PDK"	A component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing.

1. "hybrid device" (188:1-12,15,20) (700:1-13, 16)

Samsung's Proposed Construction	Proxense's Proposed Construction
Indefinite	A device comprising an integrated personal digital key (PDK) and an integrated receiver-decoder circuit.

7. "enablement signal" (188:10-12, 17)(700:11-13,18)

Samsung's Proposed Construction	Proxense's Proposed Construction
No construction needed. Alternatively, "a signal that authorizes"	A message that enables or authorizes.

EX-2009, 11, 15, 21, 26 (960 Reply, 4-5; 289 Reply, 4-5).

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Samsung Litigation – Proxense Claim Construction Inconsistent with Markman Order

Claim Term	Proxense's Proposed Construction	Samsung's Proposed Construction	Court's Final Construction
"hybrid device" (Claims 1-12,15, 20).	A device comprising an integrated personal digital key (PDK) and an integrated receiver decoder circuit.	Indefinite	No construction needed, plain and ordinary meaning.
"Personal digital key" (Claims 1, 10).	An operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user.	A device that includes an antenna, a transceiver for communicating with the RDC and a controller and memory for storing information particular to a user.	An operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user
"receiver-decoder circuit" (Claims 1, 10).	A component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing.	A device that provides a wireless interface to the PDK.	A component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing.
"enablement signal" (Claims 10-12, 17)	A message that enables or authorizes	No construction needed.	No construction needed.

EX2001 (289 Reply, 3-6; 960 Reply, 3-6.)

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

20

Samsung Litigation – No Endorsement by Samsung Court of MPF Treatment

> Notably, despite being tasked with characterizing similar limitations, neither the District Court nor any of the two parties asserted that these similar limitations invoke 112(f) treatment, much less demand implementation details of the described algorithm implemented by control logic 250. Proxense's belated attempt to burden the claims with this narrow requirement should be rejected as it is nothing more than a thinly veiled attempt to improperly import specification details into the claims to avoid addressing the teachings of the prior art.

960 Reply, 7; 289 Reply 7.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

21

Samsung Litigation - Proxense's MPF interpretation Not Supported by Samsung Court

The District Court was asked to construe the term "hybrid device", which Samsung alleged was indefinite. Consistent with Patent Owner's proposed claim construction, the District Court construed a "hybrid device" to be a "device comprising an integrated personal digital key (PDK) and an integrated receiver-decoder circuit [(RDC)]." Ex. 2002, at 25. The District Court then construed each of the terms PDK and RDC. A PDK was construed by the District Court to be an "operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user." Ex. 2002, at 27. But as noted above, such a construction is nothing more than a general-purpose computer. The District Court also construed the term RDC as a "component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing." Ex. 2002, at 36. Such a construction, as also noted above, is also nothing more than a general-purpose computer. Accordingly, the District Court effectively construed the term "hybrid device" to be a combination of two general-purpose computers.

960 POR, 27-28; 289 POR 27-28.

enabling one or more of an application, a function and a service." Thus, the claims at issue before the District Court recited the same functions at issue here (*i.e.*, "enabling one or more of an application, a function, and a service") performed by the what the District Court had construed to be general-purpose computers. "If the function is performed by a general-purpose computer or microprocessor, then the second step generally further requires that the specification disclose the algorithm that the computer performs to accomplish that function." *Rain Computing*, 989 F.3d at 1007. Should an adequate structure not be found within the specification, then the claim is

960 POR, 28; 289 POR 28.

22

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Samsung Litigation – Proxense MPF Interpretation Not Supported by Samsung Court

b. The Court's Analysis

The Court finds that the term is not indefinite and should receive the construction of "A device comprising an integrated personal digital key (PDK) and an integrated receiver-decoder circuit." A POTISA could reasonably ascertain the scope of the claim because the claims explain the required operation of the "hybrid device." Claims 1 and 10 of the 188 Patent and claims 1 and 11 of the 700 Patent state, "one or more of the integrated RDC and integrated PDK enabling one or more an application, a function and a service." An application, function, or service is "enabled" by a PDK when it receives information from a PDK in exchange for an access key. Similarly, an RDC "enable[es] one or more of an application, a function, and a service" when it forwards such a message to the application, function, or service. The claimed "hybrid device" carries out these functions. Dependent claim 2 of the 188 patent further limits claim 1, reciting "one or more of the

EX-2002, 26 (960 Reply. 5-7; 289 Reply 5-7) (960 POR 28-29; 289 POR 28-29).

Accordingly, the Court finds that the "hybrid device" term is not indefinite and should receive the construction of "A device comprising an integrated personal digital key (PDK) and an integrated receiver-decoder circuit."

EX-2002, 27(960 POR 27-29; 289 POR 27-29).

provided any construction for the term "enabled." *Id.* Although Patent Owner points to the district court's Memorandum in Support of Claim Construction Order (*Id.* (citing Ex. 2002, 26)) to support its contention that the district court construed the term "enabled," this portion of the district court's Memorandum merely discusses that "hybrid device" is not indefinite, and discusses exemplary operations of the "hybrid device" from which a POSITA "could reasonably ascertain the scope of the claim." *See* Ex. 2002, 26. That is, a determination of whether a term is indefinite is not the same things as construing a claim term. Thus, the district court's determination that "hybrid device" is not indefinite did not construe that term, much less provide a construction of "enabled" recited in the claim. Accordingly, although the referenced portion of the district court's Memorandum indicates that a POSITA could reasonably ascertain the scope of the claim (*id.*), nothing in the Memorandum provides a definition of "enabled" limited to "exchanging an access key for information held within a service block of a PDK," as Patent Owner contends. Prelim. Resp. 19.

960 Inst. Dec., 12 (960 Reply. 5-7);similar to 289 Inst. Dec., 13 (289 Reply 5-7).

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Apple Litigation - Proxense Claim Construction Inconsistency

UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

PROXENSE, LLC,

Plaintiff,

v.

APPLE INC.,

Defendant.

Civil Action No. 6:24-cv-00143-ADA

JURY TRIAL REQUESTED

DEFENDANT'S OPENING CLAIM CONSTRUCTION BRIEF

MS-1019, 1 (960 Reply 3, 16; 289 Reply 2, 16).

TABLE OF CONTENTS

		Page
I.	INTRODUCTION	1
II.	ASSERTED PATENTS	1
III.	AGREED CLAIM TERMS	2
IV.	PERSON OF ORDINARY SKILL IN THE ART	2
V.	DISPUTED CLAIM TERMS	3
A.	"tamper proof format" ('730 patent claims 1 and 8; '954 patent claim 1)	3
1.	The Intrinsic Record Confirms That the Claimed Tamper Proof Format Prevents Any Changes to the Stored Data	4
2.	The Extrinsic Evidence Confirms Apple's Construction of "Tamper Proof Format"	6
3.	Proxense's Proposed Construction Should Be Rejected	7
B.	"access message" ('730 patent claims 1 and 8; '954 patent claim 1)	9

MS-1019, 2 (960 Reply 3, 16; 289 Reply 2, 16).

Exhibit 1 – Undisputed Terms

The parties have agreed to the following constructions:

8,352,730; 8,886,954; 10,698,989 Patents		
Patent Claims	**Terms, Phrases or Clauses**	**Agreed Construction**
'042 patent claims 1, 6 '289 patent claims 1, 11	"personal digital key (PDK)"	an operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user

Patent Claims	**Terms, Phrases or Clauses**	**Agreed Construction**
'042 patent claims 1, 6 '289 patent claims 1, 11	"receiver-decoder circuit (RDC)" "reader-decoder circuit (RDC)"	a component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing

MS-1019, 30 (960 Reply 3, 16; 289 Reply 2, 16).

FISH

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

24

Apple Litigation – Proxense Claim Construction Inconsistency

Claim Term	Undisputed terms
"Personal digital key" '042 patent claims 1, 6 '289 patent claims 1, 11	An operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user
"receiver-decoder circuit (RDC)" "reader-decoder circuit (RDC)" '042 patent claims 1, 6 '289 patent claims 1, 11	a component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing

MS-1019 (289 Reply, 3; 960 Reply, 3.)

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

25

Google Litigation - Proxense Claim Construction Inconsistency

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

PROXENSE, LLC,
Plaintiff,

v.

GOOGLE LLC,
Defendants.

§
§
§
§
§
§
§
§

W-23-CV-00320-ADA

Order

EX-2004, 1 (960 Reply 4-5 289 Reply 3-5).

Claim Term	Google's Proposed Construction	Proxense's Proposed Construction	Court's Final Construction
"receiver-decoder circuit" ('042 Patent, claim 10; '289 Patent, claim 14)	a collection of circuit components capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing	A component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing.	A component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing
"personal digital key" ('042 Patent, claim 10)	a collection of circuit components that includes an antenna, a transceiver, and a controller and memory for storing information particular to a user	An operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user.	An operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user

EX 2004, 30 (960 Reply 4-5 289 Reply 3-5).

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Google Litigation – Proxense Claim Construction Inconsistent with Markman Order

Claim Term	Google's Proposed Construction	Proxense's Proposed Construction	Court's Final Construction
"receiver-decoder circuit" ('042 Patent, claim 10; '289 Patent, claim 14)	A collection of circuit components capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing	A component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing.	A component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing
"personal digital key" ('042 Patent, claim 10)	a collection of circuit components that includes an antenna, a transceiver, and a controller and memory for storing information particular to a user	An operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user.	An operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user

EX2004 (289 Reply, 3; 960 Reply, 3.)

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

27

Proxense's Assertion of Claim Construction Consistency Is Not Credible - 960

II. PROXENSE'S CONSTRUCTION WAS EXPRESSLY STATED IN ITS INFRINGEMENT CONTENTIONS

The Reply is flat wrong in its assertion that Patent Owner's position deviates from that position adopted in the co-pending *Proxense v. Microsoft* litigation.

The Preliminary Infringement Contentions filed July 24, 2024 (submitted herewith as Ex. 2015) including Ex. E (submitted herewith as Ex. 2016), detailed the alleged infringement of U.S. Patent No. 9,679,289 Patent by Microsoft. With regards to the asserted infringement of claim 14 of the 289 Patent, Patent Owner stated:

960 POSR, 1.

EXHIBIT LIST

No.	Exhibit Description
2001	Claim Construction Order in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*, No. 6.21-CV-00210-ADA
2002	Memo In Support of Claim Construction Order in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*
2003	Markman Transcript from *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*
2004	Claim Construction Order in *Proxense, LLC v. Google LLC*, No. 6:23-cv-00320-ADA
2005	Opening Claim Construction Brief in *Proxense, LLC v. Microsoft Corporation*, No. 6:23-cv-00319-ADA
2006	Responsive Claim Construction Brief in *Proxense, LLC v. Microsoft Corporation*
2007	Reply Claim Construction Brief in *Proxense, LLC v. Microsoft Corporation*
2008	Sur-reply Claim Construction Brief in *Proxense, LLC v. Microsoft Corporation*
2009	Opening Claim Construction Brief in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*
2010	Reply Claim Construction Brief in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*
2011	Joint Claim Construction Order
2012	Claim Construction Order- *Proxense, LLC v. Microsoft Corp.*, No. 6:23-cv-00319
2013	*Intentionally Left Blank*
2014	Declaration of Markus Jakobsson
2015	PLAINTIFF'S PRELIMINARY INFRINGEMENT CONTENTIONS, *Proxense, LLC v. Microsoft Corp.*, No. 6:23-cv-00319-ADA
2016	Ex. E. PLAINTIFF'S PRELIMINARY INFRINGEMENT CONTENTIONS, *Proxense, LLC v. Microsoft Corp.*, No. 6:23-cv-00319-ADA

960 POSR, Exhibit List.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Proxense's Assertion of Claim Construction Consistency Is Not Credible - 289

II. PROXENSE'S CONSTRUCTION WAS EXPRESSLY STATED IN ITS INFRINGEMENT CONTENTIONS

The Reply is flat wrong in its assertion that Patent Owner's position deviates from that position adopted in the co-pending *Proxense v. Microsoft* litigation.

The Preliminary Infringement Contentions, filed July 24, 2024 (submitted herewith as Ex. 2017), including Ex. E (submitted herewith as Ex. 2018),detailed the alleged infringement of the 289 Patent by Microsoft. With regards to the asserted infringement of claim 14, Patent Owner stated:

289 POSR, 1.

EXHIBIT LIST

No.	Exhibit Description
2001	Claim Construction Order in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*, No. 6.21-CV-00210-ADA
2002	Memo In Support of Claim Construction Order in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*
2003	Markman Transcript from *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*
2004	Claim Construction Order in *Proxense, LLC v., Google LLC*, No. 6:23-cv-00320-ADA
2005	Opening Claim Construction Brief in *Proxense, LLC v. Microsoft Corporation*, No. 6:23-cv-00319-ADA
2006	Responsive Claim Construction Brief in *Proxense, LLC v. Microsoft Corporation*
2007	Reply Claim Construction Brief in *Proxense, LLC v. Microsoft Corporation*
2008	Sur-reply Claim Construction Brief in *Proxense, LLC v. Microsoft Corporation*
2009	Opening Claim Construction Brief in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*
2010	Reply Claim Construction Brief in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*
2011	Joint Claim Construction Statement, *Proxense, LLC v. Microsoft Corp.*, No. 6:23-cv-00319-ADA
2012	Plaintiff's Preliminary Claim Construction in *Proxense, LLC v. Apple, Inc.*, No. 6:24-cv-00143-ADA
2013	Defendant's Preliminary Claim Construction in *Proxense, LLC v. Apple, Inc.*, No. 6:24-cv-00143-ADA
2014	Declaration of Markus Jakobsson
2015	Plaintiff's Preliminary Claim Construction in *Proxense, LLC v. Apple, Inc.*, No. 6:24-cv-00143-ADA
2016	Claim Construction Order - *Proxense v. Microsoft Corporation*, No. 6:23-cv-319
2017	PLAINTIFF'S PRELIMINARY INFRINGEMENT CONTENTIONS, *Proxense, LLC v. Microsoft Corp.*, No. 6:23-cv-00319-ADA
2018	Ex. E, PLAINTIFF'S PRELIMINARY INFRINGEMENT CONTENTIONS, *Proxense, LLC v. Microsoft Corp.*, No. 6:23-cv-00319-ADA

289 POSR, Exhibit List.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Proxense's Assertion of Claim Construction Consistency Is Not Credible

More disturbing, Petitioner is taking advantage of the estoppel effect of the District Court's construction of "hybrid device" on Proxense:

> Claims 1 and 10 of the 188 Patent and claims 1 and 11 of the 700 Patent state, 'one or more of ***the integrated RDC*** and ***integrated PDK enabling one or more an application, a function and a service***.' An application, function, or service is 'enabled' by a PDK when it ***receives information from a PDK in exchange for an access key***. Similarly, ***an RDC 'enables*** one or more of an application, a function, and a service' ***when it forwards such a message to the application, function, or service***. The claimed "hybrid device" carries out these functions.

Ex. 2002, at 26.

Abiding by the District Court's prior construction, Patent Owner asserted infringement allegations fully adopting and limited to the above construction. Instead of challenging the construction before the District Court, Petitioner waited until these proceedings by asserting constructions broader than the District Court's to invalidate the 960 Patent. If Patent Owner had attempted the same with its infringement allegations, Petitioner would have asserted that Patent Owner was collaterally estopped. Accordingly, Petitioner takes shelter behind the above construction before the District Court, while disregarding it here to invalidate the 960 Patent. The Board should not allow Microsoft to take such an inconsistent position before it.

960 POSR, 2; similar to 289 POSR, 2.

No.	Exhibit Description
2001	Claim Construction Order in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*, No. 6.21-CV-00210-ADA
2002	Memo In Support of Claim Construction Order in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*

960 POSR, Exhibit List; 289 POSR, Exhibit List.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Claim Construction Dispute

Proxense's Alleged MPF Constructions Apply Wrong Legal Framework

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

31

Patent Owner Alleges Claim Features Are MPF

Determining whether the Petition raises sufficient grounds of invalidity requires construing independent claims 1 and 14. Independent claim 1 recites that function of "enabling one or more

960 POR, 3; 289 POR, 4.

A. Claims 1 and 14 Invoke 35 U.S.C. § 112, Paragraph 6

Independent claims each recite the function of "enabl[ing] one or more of an application, a function, and a service." Accordingly, it must be determined if each of claims 1 and 14 recite a sufficiently definite structure for performing that function, other than a general-purpose computer. Here, the claims do not recite a sufficiently definite structure for performing the function, but rather a general-purpose computer. Therefore, the claims invoke 35 U.S.C. § 112, ¶ 6, and the claims must be construed to cover only the structure, material, or acts described in the specification as corresponding to the claimed structure. With respect to claims 1 and 14, the structure is the algorithm the general-purpose computer is programmed to perform.

960 POR, 4; similar to 289 POR, 4.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

32

Proxense's Proposed Legal Framework Is Incorrect

III. THE CLAIMS INVOKE § 112(F) BECAUSE THEY RECITE GENERAL PURPOSE COMPUTERS PERFORMING A CLAIMED FUNCTION

The law has been consistent and clear: to claim a means for performing a specific computer-implemented function and then to disclose only a ***general purpose computer*** as the structure designed to perform that function amounts to pure functional claiming. *Aristocrat,* 521 F.3d 1328 at 1333 (Fed. Cir. 2008). In this instance, the structure corresponding to a 35 U.S.C. § 112(f) claim limitation for a computer-implemented function must include the algorithm needed to transform the **general purpose** computer disclosed in the specification. *Aristocrat,* 521 F.3d at 1333; *Finisar Corp. v. DirecTV Group, Inc.,* 523 F.3d 1323, 1340 (Fed. Cir. 2008); *WMS Gaming, Inc. v. Int'l Game Tech.,* 184 F.3d 1339, 1349 (Fed. Cir. 1999); *Rain Computing, Inc. v. Samsung Electronics America Co.,* 989 F.3d 1002, 1007-8 (Fed. Cir. 2021). Microsoft has cited nothing challenging this well settled law.

960 POSR, 3; 289 POSR, 3.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Case Law Identified By Proxense to Support Its Proposed Legal Framework

- *Rain Computing v. Samsung Electronics America*, 989 F.3d 1002, 1005 (Fed. Cir. 2021)
  - "Once it has been determined that 112(6) is invoked, the construction of the claim term attributed for performing the function must be determined, which occurs in two steps.
    - 'The first step in construing a means-plus-function claim is to identify the claimed function. After identifying the function, we then determine what structure, if any, disclosed in the specification corresponds to the claimed function…'" 289 POR, 5-6
    - "When the structure disclosed for performing the function is a general-purpose computer, as here, the second step requires identifying an algorithm disclosed in the specification for accomplishing the function." 289 POR, 5-6.
  - "However, 'computer-readable media or storage devices amount to nothing more than a general-purpose computer." 289 POR, 9.
- *HTC Corp. v. IPCom GmbH & Co. KG*, 667 F.3d 1270, 1280 (Fed. Cir. 2012)
  - "But a 'processor and transceiver amount to nothing more than a general-purpose computer." 289 POR, 21, 25.
- *Ergo Licensing, LLC v. CoreFusion 303, Inc.*, 673 F.3d 1361 (Fed. Cir. 2012)
  - "Furthermore, 'controlling access to one or more software application packages to which the user has a subscription requires more than merely plugging in a general purpose computer." 289 POR, 9.
- *Aristocrat,* 521 F.3d 1328 (Fed Cir. 2008)
  - "The law has been consistent and clear: to claim a means for performing a specific computer-implemented function, and then to disclose only ***a general purpose computer*** as the structure designed to perform that function, amounts to pure functional claiming." 289 POSR, 3.
- *Aristocrat*, 521, F.3d at 1333, *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008); *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999); *Rain Computing Inc. v. Samsung Electronics Co.*, 989 F.3d 1002, 1007-1008 (Fed. Cir. 2021)
  - "In this instance the structure corresponding to a 35 USC 112(f) claim limitation for a computer-implemented function must include the algorithm needed to transform the **general purpose computer** disclosed in the specification." 289 POSR, 3.

**Annotations added

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

34

Board Already Rejected Proxense's Proposed Constructions and Legal Framework In Related IPR

Indeed, the Board has already reviewed these thin arguments in the parallel proceeding and found Proxense's arguments unpersuasive. MS-1034, 11-19. Specifically, the Board already agreed that the terms are "not used as 'generic terms or black box recitations of structure or abstractions.'" MS-1034, 13 (citing *Dyfan, LLC v. Target Corp.*, 28 F.4th 1360, 1367 (Fed. Cir. 2022)). Additionally, the Federal Circuit caselaw is replete with examples where similar claim language was deemed to implicate structure and, therefore, not invoke 112(f).

960 Reply, 2; 289 Reply, 2.

We are unpersuaded by Patent Owner's contentions. In particular, we are unpersuaded that "enabling" may be defined by way of means-plus-function analysis. Prelim. Resp. 14. As Petitioner points out, "none of the claims of the '289 patent recite the disputed limitation in 'means-plus-function' or 'step-plus-function' format." Prelim. Reply 2. As Petitioner contends, when a disputed claim limitation does not employ "means for" language, the presumption is that each of the terms conveys sufficiently definite structure or act and, thus, is not subject to § 112 ¶ 6. *Id.*; *see also Dyfan*, 28 F.4th at 1367.

MS-1034, 11-19, 960 Reply, 2; 289 Reply, 2.

Although this presumption is rebuttable and can be overcome if the challenger demonstrates that the claim term fails to recite sufficiently definite structure (*see Raining Computing v. Samsung Electronics America*, 998 F.3d 1002, 1005 (Fed. Cir. 2021)), we are unpersuaded that Patent Owner has demonstrated that claim terms "wireless communication interface," "local secured information," and "enablement signal" fail to recite sufficiently definite structure. That is, Patent Owner has not sufficiently demonstrated that the terms could not be understood by person of ordinary skill in the art "to have a sufficiently definite meaning as the name for structure for the claimed functions." Prelim. Sur-reply 1. We agree with Petitioner that the terms are "not used as 'generic terms or black box recitations of structure or abstractions.'" Prelim. Reply 3; *see Dyfan*, 28 F.4th at 1368. As Petitioner points out, "when a 'structure-connoting term . . . is coupled with a description of the 'term's' operation' § 112 ¶ 6 does not apply." *Id.*; *accord Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1320 (Fed. Cir. 2004); *Dyfan*, 28 F.4th at 1368.

MS-1034, 11-19, 960 Reply, 2; 289 Reply, 2.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Proxense's POR Assertions Maintain Incorrect Legal Framework

Review of claims 1-20 of U.S. Patent No. 10,073,960 B1 (the "960 Patent") filed by Petitioner, Microsoft Corporation ("Microsoft").

Proxense respectfully submits claims 1-20 are patentable over the instituted grounds, as each of the grounds relies on combinations of references failing to show *all* elements of the claimed invention. Specifically, the asserted references, either alone or in combination, fail to show the algorithm disclosed in the specification allowing any of "local, secured information stored by the integrated, secure memory," an "integrated RDC communicating wirelessly with [] at least one external device within the proximity zone," and an "enablement signal" to perform the function "enabling one or more of an application, a function and a service" as recited independent claims 1 and 14. Claims 1 and 14 each invoke 35 U.S.C. § 112, ¶ 6, by reciting the function of "enabling one or more of an application, a function and a service" is performed by general purpose computers, such that the disclosed structure for performing the function is the special purpose computer programmed to perform the algorithm disclosed in the specification. The Petition has not demonstrated claims 1-20 are unpatentable because none of the grounds demonstrate this algorithm in any of the asserted references.

960 POR, 1.

Review of claims 1-20 of U.S. Patent No. 9,679,289 B1 (the "289 Patent") filed by Petitioner, Microsoft Corporation ("Microsoft").

Proxense respectfully submits claims 1-20 are patentable over the instituted grounds, as each of the grounds relies on combinations of references failing to show *all* elements of the claimed invention. Specifically, the asserted references, either alone or in combination, fail to show the algorithm disclosed in the specification allowing any of "local, secured information stored by the integrated, secure memory," an "integrated RDC communicating wirelessly with [] at least one external device within the proximity zone," and an "enablement signal" to perform the function "enabling one or more of an application, a function and a service" as recited independent claims 1 and 14. Claims 1 and 14 each invoke 35 U.S.C. § 112, ¶ 6, by reciting the function of "enabling one or more of an application, a function and a service" is performed by general purpose computers, such that the disclosed structure for performing the function is the special purpose computer programmed to perform the algorithm disclosed in the specification. The Petition has not demonstrated claims 1-20 are unpatentable because none of the grounds demonstrate this algorithm in any of the asserted references.

289 POR, 1.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

36

Claim Construction Dispute

Proxense's Alleged MPF Constructions of "Local Secured Information", "Integrated RDC," "Integrated Wireless Communication Interface" and "Enablement Signal" Claim Terms Should Be Rejected

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

37

Claim Construction Dispute

Proxense Has Not Met Burden to Rebut The Presumption Against MPF Treatment

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

38

Proxense Bears Burden to Overcome Presumption That MPF Does Not Apply for Non-"means-for" claims

B. Applicable Law

To determine whether § 112 ¶ 6 applies to a claim limitation, we must inquire whether the words of the claim are understood by persons of ordinary skill in the art to have a ***sufficiently definite meaning as the name for structure. If those words lack a sufficiently definite meaning, § 112 ¶ 6 applies***. If the limitation uses the word 'means,' there is a rebuttable presumption that § 112 ¶ 6 applies. If not, there is a rebuttable presumption that the provision does not apply. But that

Raining Computing v. Samsung Electronics America, 989 F.3d 1002, 1005 (Fed. Cir. 2021) (citing *Williamson v. Citrix, LLC*, 792 1139 (Fed. Cir. 2015); 960 POR, 4-5; 289 POR, 4-6.

A. Overview

The courts have established, the use of the word "means" within a claim triggers a rebuttable presumption that 112(f) applies. *Williamson*, 1349. Conversely, the absence of "means" creates a rebuttable presumption that 112(f) does not apply. *Id.* The parties agree that the term "means" does not appear in the claims, and thus, the presumption is that 112(f) does not apply. POR, 4-5. Notably

960 Reply, 7; 289 Reply, 7.

Under this court's guidance in *Williamson*, we begin by asking whether the claim limitation employs the word "means." *Williamson*, 792 F.3d at 1348. If it does not, we apply a rebuttable presumption that the term conveys sufficiently definite structure and is not subject to § 112, ¶ 6. *Id.* A challenger can rebut the presumption by demonstrating "that the claim term fails to 'recite sufficiently definite structure' or else recites 'function without reciting sufficient structure for performing that function.'" *Id.* (quoting *Watts v. XL Sys., Inc.*, 232 F.3d 877, 880 (Fed. Cir. 2000)). The "essential inquiry is not merely the presence or absence of the word 'means' but whether the words of the

MTD Products Inc. v. Iancu, 933 F. 3d 1336, 1343-44 (Fed. Cir. 2019) (citing *Williamson v. Citrix, LLC*, 792 1139 (Fed. Cir. 2015); 960 POR, 4-5; 289 POR, 4-6.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Proxense Bears MPF Burden

But Proxense's attempt to distinguish the prior art through invocation of 112(f) for limitations in the Challenged Claims that do not recite "means for" or "step for" places on Proxense a burden to produce evidence to overcome the rebuttable presumption that these limitations are not 112(f) limitations. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339 (Fed. Cir. 2015) *citing Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583 (Fed. Cir. 1996) and *Watts v. XL Sys.*, 232 F.3d 877, 880 (Fed. Cir. 2000). Proxense has failed to meet its burden.

960 Reply, 1-3; 289 Reply, 1-3.

Proxense's proposed constructions for the following limitations, which lack "means for" and "step for" language, should be denied because Proxense has failed to overcome the rebuttable presumption against 112(f) treatment of these

960 Reply, 1-3; 289 Reply, 1-3.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Proxense MPF Burden Not Met – Did Not View Claim Terms As A Whole

interface" are ignored by Proxense. MS-1001, claims 1 and 14; POR, 7-27. And yet these supporting elements speak to structure with respect to achieving the function of "enabl[ing] one or more of an application, a function, and a service." MS-1032, ¶¶4-7. Instead, Proxense separates the terms "an integrated, secure memory storing local, secured information," "an integrated, wireless communication interface," and "enablement signal" from the context of each claim and insists that these are not structures "recognized by those of ordinary skill in the art to provide a sufficiently definite structure for performing the function." POR, 7-9. 20-23, 27-29.

960 Reply, 9; *similar to 289 Reply. 9.

This separation of claim terms is improper. *MTD Products Inc. v. Iancu*, 933 F. 3d 1336, 1343-44 (Fed. Cir. 2019). The claims should be viewed as a whole and Proxense incorrectly isolates each claim term, such as "memory" and "wireless communication interface," and assesses them out of context with respect to a function ("enables one or more of an application, a function, and a service").

960 Reply, 9; 289 Reply 8-9.

960

In addition, even if the claims recite a nonce term followed by functional language, other language in the claim "might inform the structural character of the limitation-in-question or otherwise impart structure" to the claim term. *Williamson*, 792 F.3d at 1351. In assessing whether the claim limitation is in means-plus-function format, we do not merely consider the introductory phrase (e.g., "mechanical control assembly") in isolation, but look to the entire passage including functions performed by the introductory phrase. *See Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364 (Fed. Cir. 2003). The ultimate question is whether "the claim language, read in light of the specification, recites sufficiently definite structure to avoid § 112, ¶ 6." *Media Rights Techs. Inc. v. Capital One Fin. Corp.*, 800 F.3d 1366, 1372 (Fed. Cir. 2015) (citing *Robert Bosch, LLC v. Snap-On Inc.*, 769 F.3d 1094, 1099 (Fed. Cir. 2014)).

MTD Products Inc. v. Iancu, 933 F. 3d 1336, 1343-44 (Fed. Cir. 2019) (960 Reply, 9; 289 Reply 8-9).

***Similar to 289: instead of "an integrated, wireless communication interface" recites "integrated receiver-decoder circuit (RDC)"**

FISH

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Proxense MPF Burden Not Met – Did Not View Claim Terms As A Whole

ignored by Proxense. MS-1001, claims 1 and 14; POR, 7-27. And yet these supporting elements speak to structure with respect to achieving the function of "enabl[ing] one or more of an application, a function, and a service." MS-1032, ¶¶4-7. Instead, Proxense separates the terms "an integrated, secure memory storing local, secured information," "an integrated reader-decoder circuit," and "enablement signal" from the context of each claim and insists that these are not structures "recognized by those of ordinary skill in the art to provide a sufficiently definite structure for performing the function." POR, 7-9. 19-23, 27-29.

289 Reply, 9.

This separation of claim terms is improper. *MTD Products Inc. v. Iancu*, 933 F. 3d 1336, 1343-44 (Fed. Cir. 2019). The claims should be viewed as a whole and Proxense incorrectly isolates each claim term, such as "memory" and "reader-decoder circuit," and assesses them out of context with respect to a function ("enables one or more of an application, a function, and a service"). The

960 Reply, 9; 289 Reply 8-9.

289

In addition, even if the claims recite a nonce term followed by functional language, other language in the claim "might inform the structural character of the limitation-in-question or otherwise impart structure" to the claim term. *Williamson*, 792 F.3d at 1351. In assessing whether the claim limitation is in means-plus-function format, we do not merely consider the introductory phrase (e.g., "mechanical control assembly") in isolation, but look to the entire passage including functions performed by the introductory phrase. *See Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364 (Fed. Cir. 2003). The ultimate question is whether "the claim language, read in light of the specification, recites sufficiently definite structure to avoid § 112, ¶ 6." *Media Rights Techs. Inc. v. Capital One Fin. Corp.*, 800 F.3d 1366, 1372 (Fed. Cir. 2015) (citing *Robert Bosch, LLC v. Snap-On Inc.*, 769 F.3d 1094, 1099 (Fed. Cir. 2014)).

MTD Products Inc. v. Iancu, 933 F. 3d 1336, 1343-44 (Fed. Cir. 2019) (960 Reply, 9; 289 Reply 8-9).

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

42

Proxense MPF Burden Not Met - No Commonly Recognized "nonce" Terms in the Claims, and Even if There Were, They Should Still be Viewed In Context

even if the claim terms are "nonce terms" (which Petitioner does not concede), the terms should be viewed in the context of the claim as a POSITA would understand them. *Id.* For example, in *MTD Products. Inc.*, the Federal Circuit stated that claims should be viewed in their entirety and that "other language in the claim 'might inform the structural character of the limitation-in-question or otherwise impart structure.'" *MTD Products Inc.* (citing *Williamson*, 1351).

960 Reply, 10; 289 Reply 9-10.

As described in more detail below, each of the claim terms would have been understood by a POSITA to implicate such structure, i.e., structure that stores and/or communicates access information to other connected components. Unlike *Rain Computing*, in which the claims invoked the well-known nonce term "module", there are no such terms in these claims to invoke 112(f). See also MS-1033 (Proxense's reply claiming "verification unit" does not invoke 112(f).). A POSITA, therefore, would not have concluded that the claim terms are so lacking in structure as to require invocation of 112(f). MS-1032, ¶¶4-7.

960 Reply, 12; 289 Reply 12.

One way to demonstrate that a claim limitation fails to recite sufficiently definite structure is to show that, although not employing the word "means," the claim limitation uses a similar "nonce word that can operate as a substitute for 'means' in the context of § 112, para. 6." *Id.* at 1350. Generic terms like "module," "mechanism," "element," and "device" are commonly used as verbal constructs that operate, like "means," to claim a particular function rather than describe a "sufficiently definite structure." *Id.* Our case law is replete with guidance on whether or not a particular claim term is a "nonce" term. *See, e.g., Zeroclick, LLC v. Apple Inc.*, 891 F.3d 1003, 1008 (Fed. Cir. 2018) (holding that "program" and "user interface code" are not nonce words because they are "used not as generic terms or black box recitations of structure or abstractions, but rather as specific references to conventional graphical user interface programs or code"); *Williamson*, 792 F.3d at 1350 (noting that "module" is a nonce term because it "sets forth the same black box recitation of structure for providing the same specified function as if the term 'means' had been used"). In each case, a critical question is whether "the claim term is used in common parlance or by persons of skill in the pertinent art to designate structure," including either a particular structure or a class of structures. *Skky, Inc. v. MindGeek, s.a.r.l.*, 859 F.3d 1014, 1019 (Fed. Cir. 2017) (citing *TecSec, Inc. v. Int'l Bus. Machs. Corp.*, 731 F.3d 1336, 1347 (Fed. Cir. 2013)) (holding that the claim term "wireless device means" does not invoke § 112, ¶ 6 because it denotes a class of structures).

MTD Products Inc. v. Iancu, 933 F. 3d 1336, 1343-44 (Fed. Cir. 2019)
(960 Reply, 9, 16, 21; 289 Reply 9, 16, 20) .

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Proxense MPF Burden Not Met – Fails to Consider Claims as a Whole

Claim 1 recites multiple elements that clearly impart structure ("A device comprising: a battery . . .an integrated, secure memory . . . an integrated, wireless communication interface for communicating wirelessly . . . [and]coupled to the integrated, secure memory and coupled to draw power from the battery, wherein . . . the local, secured information stored by the integrated, secure memory enables one or more of an application, a function, and a service") MS-1001, Claim 1 (emphasis added).

960 Reply, 10.

secured information . . .an integrated reader-decoder circuit (RDC) for communicating wirelessly . . .[and] coupled to the integrated, secure memory for communication . . . wherein . . . the local, secured information stored by the integrated, secure memory enables one or more of an application, a function, and a service") MS-1001, Claim 1 (emphasis added).

289 Reply, 10.

As shown below, Proxense fails to overcome this presumption that 112(f) does not apply because the "words of the claim are understood by [POSITAs] to have a sufficiently definite meaning as the name for structure." *Williamson*, 1349. Nor are the claim terms "black box recitations of structure or abstractions." *Dyfan*, 1368.

960 Reply, 8; 289 Reply, 8.

In identifying the function of "enables one or more of an application, a function, and a service," a POSITA would not only have considered the structure implicated by, for example, the terms "integrated, secure memory" and "integrated, wireless communication interface" themselves, but also the structure implicated by the connectivity between these components set forth in the claim as a whole. By

960 Reply, 10.

In identifying the function of "enables one or more of an application, a function, and a service," a POSITA would not only have considered the structure implicated by, for example, the terms "integrated, secure memory" and "integrated, reader-decoder circuit" themselves, but also the structure implicated by the connectivity between these components set forth in the claim as a whole. By

289 Reply, 10.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

44

Proxense MPF Burden Not Met – Fails to Consider Claims as a Whole

For example, the specification envisions the "enabling" function as implicating multiple distinct components connected to each other, not merely the "memory" and/or the "interface" in isolation. That is, the specification describes embodiments where the "memory" and/or the "interface" are operating in concert with *other* connected device elements/components to enable an application, function, or service by storing and/or communicating access information (e.g., one or more PINs or passwords for an application) to those *other* device elements/components for authentication. MS-1001, 14:23-52, 15:6-28, 15:29-16:17, 19:31-58. In this manner, the "memory" and/or the "interface" perform the "enabling" function by simply being one of multiple elements/components implicated in the process to enable an application, function, or service. Indeed, the

960 Reply, 11-12; similar to 289 Reply, 10-12.

implicated in the process to enable an application, function, or service. Indeed, the ultimate decision to enable or disable the application, function, or service is not performed by the "memory" and/or the "interface" themselves but rather is performed by one or more distinct, connected elements/components that authenticate the access information received from the "memory" and/or "interface." After all, it would make little sense for the mere storage and/or communication of a PIN or password by the "memory" and/or "interface" to be sufficient to enable an application, function, or service without actually verifying that the PIN or password is valid. Given this disclosure, a POSITA would recognize that the "memory" and/or the "interface" can, for example, perform the "enabling" function by providing structure that stores and/or communicates access information to other connected components for authentication to enable the function, application, or service.

960 Reply, 11-12; similar to 289 Reply, 10-12.

45

FISH

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Proxense MPF Burden Not Met – Provides Only Conclusory Expert Statements

Claim 1 attributes the function of the "enabling one or more of an application, a function and service" to "local, secured information stored by the integrated, secure memory." "§ 112 para. 6 will apply if the challenger demonstrates that ***the claim term fails to recite sufficiently definite structure*** or else recites function without reciting sufficient structure for performing that function." *Raining Computing*, 989 F.3d at 1005 (emphasis added). The term "local, secured information stored by the integrated, secure memory" is not a structure recognized by those of ordinary skill in the art to provide a sufficiently definite structure for performing the function of "enabling on or more of an application, a function and a service". Jakobsson Decl., ¶¶ 18 and 36. Accordingly, claim 1 invokes § 112, ¶ 6.

960 POR., 8; 289 POR, 7-8.

In support of this assertion, Proxense provides evidence in the form of simple, conclusory statements by its expert, Dr. Jakobsson, coupled with a flawed characterization of a transcript of *Markman* analysis from previous litigation against Samsung ("Samsung litigation")—of which the ultimate *Markman* order contained no 112(f) limitations. EX-2001. But these arguments should be given little weight, not only because of their largely conclusory nature but also because the language of the claims would have been recognized as implicating structure to a POSITA, as explained in more detail below.

960 Reply, 2; 289 Reply, 2.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Proxense's Identified Limitations for MPF Treatment

Review of claims 1-20 of U.S. Patent No. 10,073,960 B1 (the "960 Patent") filed by Petitioner, Microsoft Corporation ("Microsoft").

Proxense respectfully submits claims 1-20 are patentable over the instituted grounds, as each of the grounds relies on combinations of references failing to show *all* elements of the claimed invention. Specifically, the asserted references, either alone or in combination, fail to show the algorithm disclosed in the specification allowing any of "local, secured information stored by the integrated, secure memory," an "integrated RDC communicating wirelessly with [] at least one external device within the proximity zone," and an "enablement signal" to perform the function "enabling one or more of an application, a function and a service" as recited independent claims 1 and 14. Claims 1 and 14 each invoke 35 U.S.C. § 112, ¶ 6, by reciting the function of "enabling one or more of an application, a function and a service" is performed by general purpose computers, such that the disclosed structure for performing the function is the special purpose computer programmed to perform the algorithm disclosed in the specification. The Petition has not demonstrated claims 1-20 are unpatentable because none of the grounds demonstrate this algorithm in any of the asserted references.

960 POR, 1.

Review of claims 1-20 of U.S. Patent No. 9,679,289 B1 (the "289 Patent") filed by Petitioner, Microsoft Corporation ("Microsoft").

Proxense respectfully submits claims 1-20 are patentable over the instituted grounds, as each of the grounds relies on combinations of references failing to show *all* elements of the claimed invention. Specifically, the asserted references, either alone or in combination, fail to show the algorithm disclosed in the specification allowing any of "local, secured information stored by the integrated, secure memory," an "integrated RDC communicating wirelessly with [] at least one external device within the proximity zone," and an "enablement signal" to perform the function "enabling one or more of an application, a function and a service" as recited independent claims 1 and 14. Claims 1 and 14 each invoke 35 U.S.C. § 112, ¶ 6, by reciting the function of "enabling one or more of an application, a function and a service" is performed by general purpose computers, such that the disclosed structure for performing the function is the special purpose computer programmed to perform the algorithm disclosed in the specification. The Petition has not demonstrated claims 1-20 are unpatentable because none of the grounds demonstrate this algorithm in any of the asserted references.

289 POR, 1.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Claim Construction Dispute

"Local, Secured Information" Claim Term Recites Structure, Making MPF Inappropriate

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

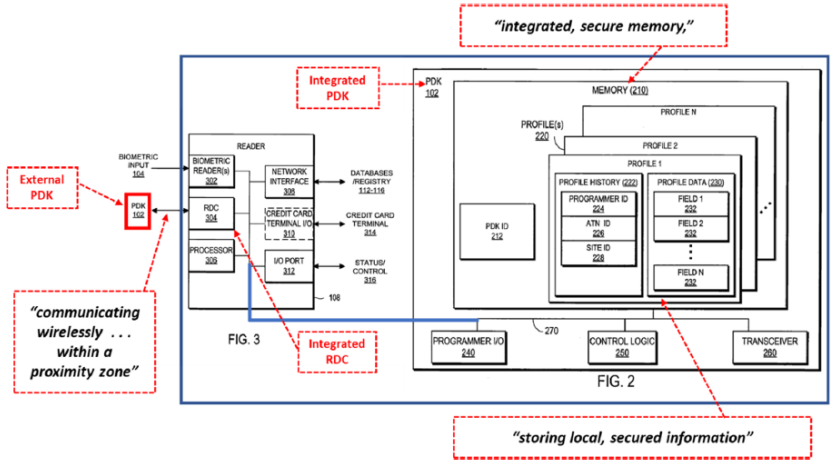
48

"Local, secured information stored by the integrated, secure memory"

Ground 1A

Giobbi-157 discloses a "Personal Digital Key (PDK)," which is an example of an ***integrated secure memory***. MS-1005, ¶[0011] ("A portable physical device, referred to herein as a Personal Digital Key or 'PDK,' stores one or more profiles (e.g., a biometric profile) ["***secured information***"] in a tamper-proof ["***secure***"] memory"). As discussed above, Giobbi-157 also discloses that its PDK is ***integrated*** into a device, such as a cell phone. MS-1005, ¶[0035] ("The PDK 102 can be standalone as a portable, physical device or can be integrated into commonly carried items … such as a cell phone"); *see supra*, §III.A.1, [1.pre]. Accordingly, the device of the Giobbi-157-Giobbi-139 combination includes an "***integrated, secure memory***." Additionally, Giobbi-157's PDK stores information in ***local*** storage as the PDK is integrated into the device. MS-1005, ¶¶[0011], [0027]-[0028]; MS-1003, ¶[59].

960 Pet., 28; similar to 289 Pet., 28-29.



MS-1005, FIGS. 2-3 (modified to incorporate Giobbi-139's teachings).

960 Pet., 29; similar to 289 Pet., 29.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

"Local, secured information stored by the integrated, secure memory"

definite structure. MS-1032, ¶¶8-13. For example, *memory* is defined as the "capacity of a computer or integrated computer system for short and medium-term retention of digital data" and speaks to a broad class of structures used to retain data for various purposes. MS-1020, 5[2]; *EnOcean GmbH v. Face Int'l Corp.*, 742 F.3d 955, 960 (Fed. Cir. 2014) (a term is " . . . a corresponding structure, as long as the class of structures is identifiable by a person of ordinary skill in the art."). For

960 Reply, 13; 289 Reply, 13.

Further, the claims here recite more than just a "memory," rather, an "integrated, secured memory." MS-1032, ¶11; *Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1374 (Fed. Cir. 2003) ("An adjectival qualification ('digital') placed on an otherwise sufficiently definite structure ('detector') does not make the sufficiency of that structure any less sufficient for purposes of § 112, P 6. Instead, it further narrows the scope of those structures covered by the claim and makes the term more definite."). First, an "integrated" memory would have been understood to represent a subclass of memory structures that store information locally to the device ("integrated"). *Id.*; Pet., 28-29, 35; MS-1032, ¶11. Second, "secure" memory denotes a further subclass of memory structures, including tamper-proof memory structures. *Id.* Finally, in the context of short-range communication

960 Reply, 15; 289 Reply, 15-16.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

"Local, secured information stored by the integrated, secure memory" and the "enabling" Limitation

For example, the specification envisions the "enabling" function as implicating multiple distinct components connected to each other, not merely the "memory" and/or the "interface" in isolation. That is, the specification describes embodiments where the "memory" and/or the "interface" are operating in concert with *other* connected device elements/components to enable an application, function, or service by storing and/or communicating access information (e.g., one or more PINs or passwords for an application) to those *other* device elements/components for authentication. MS-1001, 14:23-52, 15:6-28, 15:29-16:17, 19:31-58. In this manner, the "memory" and/or the "interface" perform the "enabling" function by simply being one of multiple elements/components implicated in the process to enable an application, function, or service. Indeed, the

960 Reply, 11-12; similar to 289 Reply, 10-12.

implicated in the process to enable an application, function, or service. Indeed, the ultimate decision to enable or disable the application, function, or service is not performed by the "memory" and/or the "interface" themselves but rather is performed by one or more distinct, connected elements/components that authenticate the access information received from the "memory" and/or "interface." After all, it would make little sense for the mere storage and/or communication of a PIN or password by the "memory" and/or "interface" to be sufficient to enable an application, function, or service without actually verifying that the PIN or password is valid. Given this disclosure, a POSITA would recognize that the "memory" and/or the "interface" can, for example, perform the "enabling" function by providing structure that stores and/or communicates access information to other connected components for authentication to enable the function, application, or service.

960 Reply, 11-12; similar to 289 Reply, 10-12.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

"Local, secured information stored by the integrated, secure memory" and the "enabling" Limitation

Nor does "information" being stored in memory make "memory" any less concrete. In fact, not only does memory connote structure, but a POSITA would have recognized that memory can "enable[]one or more of an application, a function, and a service" by storing information, such as access information, necessary to access or otherwise invoke that application, function, or service. MS-1032, ¶10; *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 703-05, 48 USPQ2d 1880, 1886–87 (Fed. Cir. 1998) ("Even though the term 'detector' does not specifically evoke a particular structure, it does convey to one knowledgeable in the art a variety of structures known as 'detectors.'"). For example, as Dr. Traynor explains, the '960 patent

960 Reply, 14-15; similar to 289 Reply, 14-15.

known as 'detectors.'"). For example, as Dr. Traynor explains, the '960 patent describes RFID systems, and an RFID tag is a structure such as a microchip that stores information in memory and responds through an antenna when probed. MS-1001, 2:3-29; MS-1032, ¶10; MS-1023, 3. Accordingly, the information of the RFID tag is stored in memory and used to enable a function. *Id.* Thus, a POSITA would have understood that the "local, secured information" stored in the memory is capable of enabling functions like the information stored in memory in an RFID tag. *Id.*

960 Reply, 11-12; similar to 289 Reply, 10-12.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

"Local, secured information stored by the integrated, secure memory"

III. THE CLAIMS INVOKE § 112(F) BECAUSE THEY RECITE GENERAL PURPOSE COMPUTERS PERFORMING A CLAIMED FUNCTION

> The law has been consistent and clear: to claim a means for performing a specific computer-implemented function and then to disclose only a ***general purpose computer*** as the structure designed to perform that function amounts to pure functional claiming. *Aristocrat,* 521 F.3d 1328 at 1333 (Fed. Cir. 2008). In this instance, the structure corresponding to a 35 U.S.C. § 112(f) claim limitation for a computer-implemented function must include the algorithm needed to transform the **general purpose** computer disclosed in the specification. *Aristocrat,* 521 F.3d at 1333; *Finisar Corp. v. DirecTV Group, Inc.,* 523 F.3d 1323, 1340 (Fed. Cir. 2008); *WMS Gaming, Inc. v. Int'l Game Tech.,* 184 F.3d 1339, 1349 (Fed. Cir. 1999); *Rain Computing, Inc. v. Samsung Electronics America Co.,* 989 F.3d 1002, 1007-8 (Fed. Cir. 2021). Microsoft has cited nothing challenging this well settled law.

960 POSR, 3; 289 POSR, 3.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

MPF

“Integrated RDC” Claim Term Recites Structure, Making MPF Inappropriate

FISH.

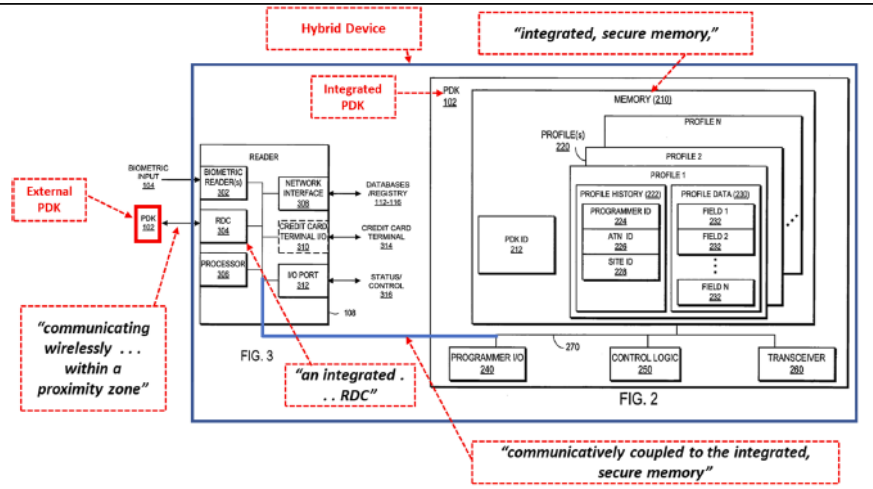
DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

54

"Integrated RDC communicating wirelessly with [] at least one external device within the proximity zone"

§§I.C.3, III.A.1-3. In particular, Giobbi-157 teaches that "the RDC 304 wirelessly receives data from the PDK 102 in an encrypted format and decodes the encrypted data for processing." MS-1005, ¶[0050]. Giobbi-157 also discloses an integrated RDC "***communicating wirelessly***" with "***at least one external device within a proximity zone***." MS-1005, ¶¶[0026]-[0044] ("The Reader 108 wirelessly communicates with the PDK 102 when the PDK 102 is within a proximity zone of the Reader 108"); *see supra* §III.A.1. As described above, the hybrid device includes

289 Pet., 30-31.



MS-1005, FIGS. 2-3 (modified to incorporate Giobbi-139's teachings).

289 Pet., 31.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

"Integrated RDC communicating wirelessly with [] at least one external device within the proximity zone"

In *EnOcean GmbH v. Face Int'l Corp.*, the claim term "receiver" did not invoke 112(f), because, "receiver" was reasonably well understood in the art as a name for structure. *EnOcean GmbH v. Face Int'l Corp.*, 958-960. Similar to "receiver" the term "reader-decoder circuit" was reasonable well understood as a name for structure. The claims at question in *EnOcean* were:

> Claim 37: "a signal *receiver for receiving* a first electromagnetic signal transmitted by said first signal transmitter;"
>
> Claim 38: "a *receiver for receiving* a first radiofrequency signal transmitted by said first signal transmitter;"
>
> Claim 43: "a *receiver adapted to receiving* a radiofrequency telegram transmitted by said radio frequency transmission stage;"

289 Reply, 19-20.

The court relied on expert testimony and cited precedent where terms like "height adjustment mechanism," "computing unit," "circuit," "digital detector," and "detent mechanism" had been found to connote sufficient structure. *Id.* Similarly "integrated reader-decoder circuit" recites sufficient structure, because a POSITA would have understood that the components of the device of claim 1 have a "sufficiently definite meaning as the name for structure" for performing its function. *Williamson*, 1349; MS-1032, ¶18.

289 Reply 20.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

"Integrated RDC" and the "enabling" Limitation

For example, the specification envisions the "enabling" function as implicating multiple distinct components connected to each other, not merely the "memory" and/or the "RDC" in isolation. That is, the specification describes embodiments where the "memory" and/or the "RDC" are operating in concert with *other* connected device elements/components to enable an application, function, or service by storing and/or communicating access information (e.g., one or more PINs or passwords for an application) to those *other* device elements/components for authentication. MS-1001, 14:15-44, 14:65-15:20, 15:21-16:9, 19:24-51. In this manner, the "memory" and/or the "RDC" perform the "enabling" function by simply being one of multiple elements/components implicated in the process to enable an application, function, or service. Indeed, the ultimate decision to enable

289 Reply, 10-12.

enable an application, function, or service. Indeed, the ultimate decision to enable or disable the application, function, or service is not performed by the "memory" and/or the "RDC" themselves but rather is performed by one or more distinct, connected elements/components that authenticate the access information received from the "memory" and/or "RDC." After all, it would make little sense for the mere storage and/or communication of a PIN or password by the "memory" and/or "RDC" to be sufficient to enable an application, function, or service without actually verifying that the PIN or password is valid. Given this disclosure, a POSITA would recognize that the "memory" and/or the "RDC" can, for example, perform the "enabling" function by providing structure that stores and/or communicates access information to other connected components for authentication to enable the function, application, or service.

289 Reply, 10-12.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

"Integrated RDC" and the "enabling" Limitation

A POSITA also would have readily recognized that an RDC is a type of wireless communication interface that is used to "enable . . . an application, a function, and a service" by enabling wireless communication of information, such as access information, to access or otherwise invoke that application, function, or service. As explained by Dr. Traynor, use of a reader-decoder circuit and other similar interfaces for "short range communications between wireless devices was common for enabling an application, a function, or a service." Pet., 6, 9, 11, 34; MS-1032, ¶17. And the class of structures implicated by the recited RDC and

289 Reply, 18-19.

MS-1032, ¶17. And the class of structures implicated by the recited RDC and specification would have been readily recognized by a POSITA to include, in addition to the noted RFID tags, garage door openers, television remotes, and gate openers. MS-1032, ¶17. Each of these devices communicates wirelessly with at least one external device within range (e.g., a proximity zone) to enable an application, function, or service. Specifically, Dr. Traynor provides examples of Common Access Cards (CACs) able to wirelessly communicate with card readers to allow access and SpeedPass being able to wirelessly authorize payment. MS-1032, ¶¶16-17.

289 Reply, 18-19.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

"Integrated RDC communicating wirelessly with [] at least one external device within the proximity zone"

III. THE CLAIMS INVOKE § 112(F) BECAUSE THEY RECITE GENERAL PURPOSE COMPUTERS PERFORMING A CLAIMED FUNCTION

The law has been consistent and clear: to claim a means for performing a specific computer-implemented function and then to disclose only a ***general purpose computer*** as the structure designed to perform that function amounts to pure functional claiming. *Aristocrat,* 521 F.3d 1328 at 1333 (Fed. Cir. 2008). In this instance, the structure corresponding to a 35 U.S.C. § 112(f) claim limitation for a computer-implemented function must include the algorithm needed to transform the **general purpose** computer disclosed in the specification. *Aristocrat,* 521 F.3d at 1333; *Finisar Corp. v. DirecTV Group, Inc.,* 523 F.3d 1323, 1340 (Fed. Cir. 2008); *WMS Gaming, Inc. v. Int'l Game Tech.,* 184 F.3d 1339, 1349 (Fed. Cir. 1999); *Rain Computing, Inc. v. Samsung Electronics America Co.,* 989 F.3d 1002, 1007-8 (Fed. Cir. 2021). Microsoft has cited nothing challenging this well settled law.

289 POSR, 3.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

POSR Statements

B. The Claims Recite the Wireless Communication Interface Performs a Logical Operation, Not a Physical Operation

> ***The district court misstated the law***, however, when it stated that disclosure of a processor and ***transceiver*** alone was sufficient to provide structure to these claims. The processor and transceiver amount to nothing more than a general-purpose computer. We have 'consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor.' *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed.Cir. 2008). General-purpose 'computers' or 'processors' can be 'programmed to perform very different tasks in very different ways.' *Id.* Accordingly, 'simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to `the corresponding structure, material, or acts' that perform the function, as required by section 112 paragraph 6.' *Id.*

289 POSR 5-6.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Claim Construction Dispute

"Integrated wireless communication interface" Claim Term Recites Structure, Making MPF Inappropriate

FISH.

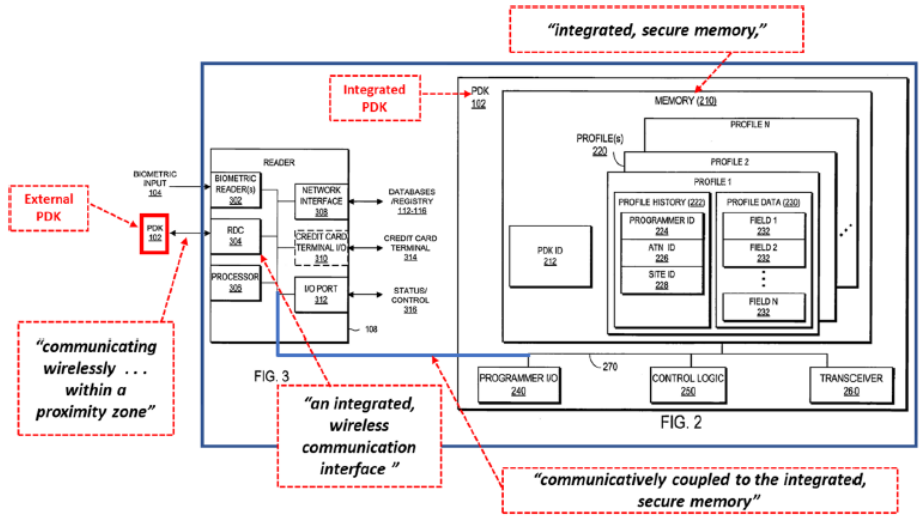
DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

61

"Integrated wireless communication interface"

Giobbi-157 teaches that "the RDC 304 wirelessly receives data from the PDK 102 in an encrypted format and decodes the encrypted data for processing" ("***an integrated, wireless communication interface for communicating wirelessly with at least one external device***"). MS-1005, ¶[0050]. Giobbi-157 also discloses an integrated RDC "***communicating wirelessly***" with "***at least one external device within a proximity zone***." MS-1005, ¶¶[0026]-[0044] ("The Reader 108 wirelessly communicates with the PDK 102 when the PDK 102 is within a proximity zone of the Reader 108"); *see supra* §III.A.1. As described above, the Giobbi-157-

960 Pet., 29-30.



MS-1005, FIGS. 2-3 (modified to incorporate Giobbi-139's teachings).

960 Pet., 30.

FISH

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

"Integrated wireless communication interface"

In *EnOcean GmbH v. Face Int'l Corp.*, the claim term "receiver" did not invoke 112(f), because, "receiver" was reasonably well understood in the art as a name for structure. *EnOcean GmbH v. Face Int'l Corp.*, 958-960. Similar to "receiver" the term "wireless communication interface" was reasonable well understood as a name for structure. The claims at question in *EnOcean* were:

> Claim 37: "a signal *receiver for receiving* a first electromagnetic signal transmitted by said first signal transmitter;"
> Claim 38: "a *receiver for receiving* a first radio frequency signal transmitted by said first signal transmitter;"
> Claim 43: "a *receiver adapted to receiving* a radiofrequency telegram transmitted by said radio frequency transmission stage;"

960 Reply, 19-20.

The court relied on expert testimony and cited precedent where terms like "height adjustment mechanism," "computing unit," "circuit," "digital detector," and "detent mechanism" had been found to connote sufficient structure. *Id.* Similarly "integrated wireless communication interface" recites sufficient structure, because a POSITA would have understood that the components of the device of claim 1 have a "sufficiently definite meaning as the name for structure" for performing its function. *Williamson*, 1349; MS-1032, ¶18.

960 Reply, 19-20.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

63

"Integrated wireless communication interface" and the "enabling" Limitation

For example, the specification envisions the "enabling" function as implicating multiple distinct components connected to each other, not merely the "memory" and/or the "interface" in isolation. That is, the specification describes embodiments where the "memory" and/or the "interface" are operating in concert with *other* connected device elements/components to enable an application, function, or service by storing and/or communicating access information (e.g., one or more PINs or passwords for an application) to those *other* device elements/components for authentication. MS-1001, 14:23-52, 15:6-28, 15:29-16:17, 19:31-58. In this manner, the "memory" and/or the "interface" perform the "enabling" function by simply being one of multiple elements/components implicated in the process to enable an application, function, or service. Indeed, the

960 Reply, 11-12.

implicated in the process to enable an application, function, or service. Indeed, the ultimate decision to enable or disable the application, function, or service is not performed by the "memory" and/or the "interface" themselves but rather is performed by one or more distinct, connected elements/components that authenticate the access information received from the "memory" and/or "interface." After all, it would make little sense for the mere storage and/or communication of a PIN or password by the "memory" and/or "interface" to be sufficient to enable an application, function, or service without actually verifying that the PIN or password is valid. Given this disclosure, a POSITA would recognize that the "memory" and/or the "interface" can, for example, perform the "enabling" function by providing structure that stores and/or communicates access information to other connected components for authentication to enable the function, application, or service.

960 Reply, 11-12.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

"Integrated wireless . . ." and the "enabling" Limitation

A POSITA also would have readily recognized that a "wireless communication interface" is often used to "enable . . . an application, a function, and a service" by enabling wireless communication of information, such as access information, to access or otherwise invoke that application, function, or service. As explained by Dr. Traynor, use of a "wireless communication interface" for "short range communications between wireless devices was common for enabling an application, a function, or a service." Pet., 6, 9, 11, 34; MS-1032, ¶17. And the

960 Reply, 18-19.

an application, a function, or a service." Pet., 6, 9, 11, 34; MS-1032, ¶17. And the class of structures implicated by the recited "wireless communication interface" would have been readily recognized by a POSITA to include, in addition to the noted RFID tags, garage door openers, television remotes, and gate openers. MS-1032, ¶17. Each of these devices communicates wirelessly with at least one external device within range (e.g., a proximity zone) to enable an application, function, or service. Specifically, Dr. Traynor provides examples of Common Access Cards (CACs) able to wirelessly communicate with card readers to allow access and SpeedPass being able to wirelessly authorize payment. MS-1032, ¶¶16-17.

960 Reply, 18-19.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

"Integrated wireless communication interface"

III. THE CLAIMS INVOKE § 112(F) BECAUSE THEY RECITE GENERAL PURPOSE COMPUTERS PERFORMING A CLAIMED FUNCTION

The law has been consistent and clear: to claim a means for performing a specific computer-implemented function and then to disclose only a ***general purpose computer*** as the structure designed to perform that function amounts to pure functional claiming. *Aristocrat,* 521 F.3d 1328 at 1333 (Fed. Cir. 2008). In this instance, the structure corresponding to a 35 U.S.C. § 112(f) claim limitation for a computer-implemented function must include the algorithm needed to transform the **general purpose** computer disclosed in the specification. *Aristocrat,* 521 F.3d at 1333; *Finisar Corp. v. DirecTV Group, Inc.,* 523 F.3d 1323, 1340 (Fed. Cir. 2008); *WMS Gaming, Inc. v. Int'l Game Tech.,* 184 F.3d 1339, 1349 (Fed. Cir. 1999); *Rain Computing, Inc. v. Samsung Electronics America Co.,* 989 F.3d 1002, 1007-8 (Fed. Cir. 2021). Microsoft has cited nothing challenging this well settled law.

960 POSR, 3.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

POSR Statements

B. The Claims Recite the Wireless Communication Interface Performs a Logical Operation, Not a Physical Operation

> ***The district court misstated the law***, however, when it stated that disclosure of a processor and ***transceiver*** alone was sufficient to provide structure to these claims. The processor and transceiver amount to nothing more than a general-purpose computer. We have 'consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor.' *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed.Cir. 2008). General-purpose 'computers' or 'processors' can be 'programmed to perform very different tasks in very different ways.' *Id.* Accordingly, 'simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to `the corresponding structure, material, or acts' that perform the function, as required by section 112 paragraph 6.' *Id.*

960 POSR, 5-6.

67

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Claim Construction Dispute

"Generating an Enablement Signal" Step Recites Structure/Act, Making MPF/SPF Inappropriate

68

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

“Enablement signal” [claim 14] .

Additionally, Giobbi-139 discloses and shows in FIG. 14 devices that include RDC’s can “effectively enabl[e]/disabl[e] the device itself.” MS-1006, ¶[0088-0090]. Thus the PDK of the device, when brought within range of an external RDC, can “***enable[] at least in part on a device external to the device and communicatively coupled to an external, wireless communication interface***” a “***application***,” “***function***,” or “***service***” on that device with “an external RDC.” MS-1003, ¶[98].

960 Pet., 57;
*similar to 289 Pet., 58.

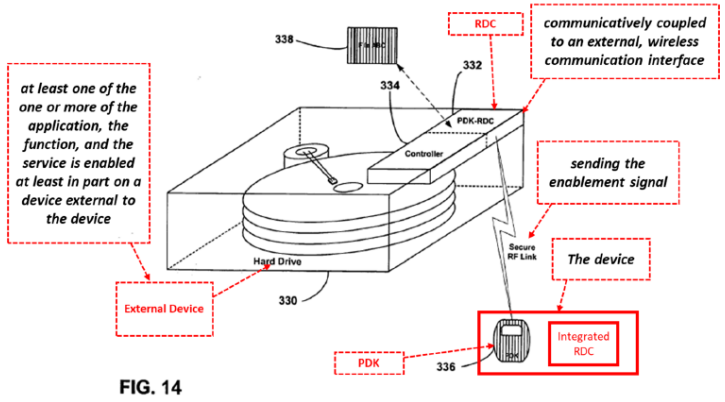


FIG. 14

MS-1006, FIG. 14.

960 Pet., 58; *similar to 289 Pet., 58.

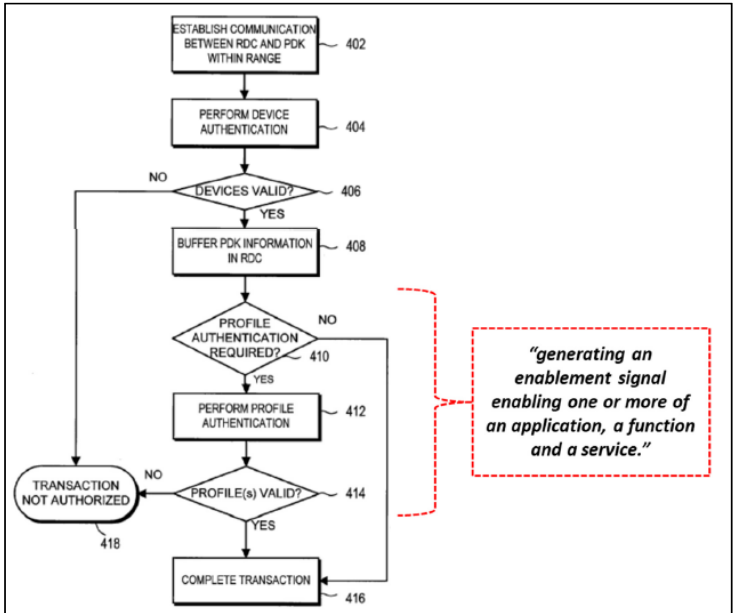


FIG. 4

MS-1005, FIGS. 4.

960 Pet., 56; 289 Pet., 57.

***Similar to 289: instead of “an integrated, wireless communication interface” recites “integrated receiver-decoder circuit (RDC)”**

FISH.
DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

"Enablement signal" [claim 14] is Not a Nonce Term

The use of signals to enable functions was well known. MS-1022, 3, (definition: "activate - To start an operation, usually by application of an appropriate enabling signal." (emphasis added)); MS-1032, ¶¶19-22. Further, the Federal Circuit in *Greenberg* determined that defining an element in functional terms "is not sufficient to convert a claim element containing that term into a 'means for performing a specified function' within the meaning of section 112(6)." 1583. In *Greenberg*, the court determined "detent mechanism," is not overly vague or devoid of structure but is named for the action it performs. *Id.* ("Many devices take their names from the functions they perform. The examples are innumerable, such as 'filter,' 'brake,' 'clamp,' 'screwdriver,' or 'lock.'"). Similarly "enablement signal" derives its name "from the function [it] perform[s]"—in fact the claim itself states this by reciting: "an enablement signal enabling one or more of an application, a function and a service."

960 Reply, 21-22; 289 Reply 21-22.

Further definitions establishing the well-known nature of the term "enablement signal" include:

1. *The Dictionary of Science and Technology*: "enabling signal" is defined as "*noun* a signal that starts a process or allows one to take place." MS-1026, 3.
2. *McGraw-Hill Dictionary of Scientific and Technical Terms*: "enable" is defined as "[t]o initiate the operation of a device or circuit by applying a trigger signal or pulse." MS-1027, 3.
3. *The Dictionary of Computing*: "enable" is defined as "[t]o selectively activate a device or function. . . selective operation can be achieved by an enabling action—such as a signal . . ." MS-1028, 3.

960 Reply, 23; 289 Reply, 22-23.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

If 112(f), then Step Plus Function

b) If 112(f) is applied at all, the correct analysis of claim 14 should be Step Plus Function

While means-plus-function analysis may, in rare and exceptional circumstances, be relevant to method claims—such as when the claim explicitly incorporates structural language—this is not the default approach and does not apply here. By focusing exclusively on means-plus-function, Proxense has failed to properly analyze the functional language of the method claim within its appropriate legal framework, rendering their argument both inapplicable and incorrect.

In a method claim, the mere use of "-ing" verbs does not invoke 112(f), as decided in *O.I. Corp. v. Tekmar Co.*, where the court addressed the application of 112(f) to claims, including step-plus-function and means-plus-function limitations. 115 F.3d 1576, 1583 (Fed. Cir. 1997). Similarly, in *Seal-Flex, Inc. v. Athletic Track & Court Constr.*, the court considered whether 112(f) applied to process claims. 172 F.3d 836 (Fed. Cir. 1999). It established two key principles: (1) the absence of "steps for" in a method claim creates a presumption that 112(f) does not apply; and (2) if a claim limitation expresses both a function and an act, 112(f) is not invoked. *Id.*

289 Reply, 23-24 ; similar to 960 Reply, 24-25.

Applying these principles, the '289 Patent claim—"generating an enablement signal enabling one or more of an application, a function, and a service"—describes both the function ("enabling one or more of...") and the act ("generating an enablement signal"). This aligns with *Masco Corp. v. United States*, where the court held that method claims do not invoke 112(f) when a function is performed by an act (e.g., "driving a lever" by "transmitting a force"). 303 F.3d 1316, 1327 (Fed. Cir. 2002).

Thus, under *Seal-Flex* and *Masco*, the '289 claims maintain the presumption that 112(f) does not apply.

289 Reply, 23-24; similar to 960 Reply, 24-25.

FISH

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

POSR - Response

C. The Enablement Signal Cannot Be Sidestepped with Step Plus Function

Petitioner next attempts to sidestep the issue by asserting that step-plus-function analysis somehow is different than a means-plus-function analysis. Paper 15, at 24-25. Yet, it only cites cases predating *Williamson v. Citrix*, without offering any reasoning why step-plus function claims are any different. In fact, Microsoft's primary case, *Masco Corp. v. United States*, 303 F.3d 1316, (Fed. Cir. 2002), was explicitly overruled by *Williamson*. *Williamson*, 792 F.3d at 1349 ("A few years later, we reiterated *Lighting World*'s characterization of the presumption as a 'strong one that is not readily overcome' in *Inventio AG v. ThyssenK*

1358 (Fed. Cir.2011). In *Flo Healthcare Solution*

960 Reply, 6-7; 289 Reply 6-7.

1358 (Fed. Cir.2011). In *Flo Healthcare Solutions, LLC v. Kappos*, 697 F.3d 1367, 1374 (Fed. Cir.2012), decided just a year after *Inventio*, we raised the bar even further, declaring that '[w]hen the claim drafter has not signaled his intent to invoke § 112, ¶ 6 by using the term `means,' we are unwilling to apply that provision *without a showing that the limitation essentially is devoid of anything that can be construed as structure*' (emphasis added), citing ***Masco Corp. v. United States*, 303 F.3d 1316, 1327 (Fed.Cir.2002)**, a case involving the different term 'step for' and the unusual circumstances in which § 112, para. 6 relates to the functional language of a method claim.... Our consideration of this case has led us to conclude that such a heightened burden is unjustified and that we should abandon characterizing as 'strong' the presumption that a limitation lacking the word "means" is not subject to § 112, para. 6.") (emphasis added). Accordingly, Petitioner's position that means and step plus functions limitations should be treated differently was specifically refuted in *Williamson*.

Regardless, Patent Owner's Response provided a step-plus-function analysis, which Petitioner ignores. *See* Paper 11, at 22-25.

960 Reply, 6-7; 289 Reply 6-7.

14. A method comprising:
creating a first wireless link between an integrated, wireless communication interface of a device and an external device, the device including a battery, an integrated, secure memory, and the integrated, wireless communication interface, wherein the integrated, secure memory stores local, secured information and the integrated, wireless communication interface is powered by the battery;
receiving a first signal, at the integrated, wireless communication interface, via the first wireless link, from the external device; and
generating an enablement signal enabling one or more of an application, a function and a service.

MS-1001(960), Claim 14.

14. A method comprising:
creating a first wireless link between an integrated receiver-decoder circuit (RDC) of a hybrid device and an external device, the hybrid device including an integrated, secure memory and the integrated RDC, wherein the integrated, secure memory stores local, secured information;
receiving a first signal, at the integrated RDC, via the first wireless link, from the external device; and
generating an enablement signal enabling one or more of an application, a function and a service.

MS-1001(289), Claim 14.

FISH.
DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

POSR - Response

Petitioner further contends that an "enabling signal" is known in the art as "a signal that starts a process or allows one to take place." Paper 15, at 23. However, as noted in Patent Owner's Response, the limitations of claim 14 expressly state receipt of a signal is insufficient to enable an application, a function, and a service. The first element of claim 14 is "creating a first wireless link," which is followed by "receiving a first signal." But the link and the first signal do not "enable one or more of an application, a function and service." Claim 14, rather, recites "generating an enablement signal enabling one or more of an application, a function and service." Accordingly, by the express language of claim 14, the mere receipt of a signal starting a process or receipt of a signal via a wireless link is insufficient to perform the function of "enabling one or more of an application, a function and service."

960 POSR, 7; similar to 289 POSR, 7.

14. A method comprising:
creating a first wireless link between an integrated, wireless communication interface of a device and an external device, the device including a battery, an integrated, secure memory, and the integrated, wireless communication interface, wherein the integrated, secure memory stores local, secured information and the integrated, wireless communication interface is powered by the battery;
receiving a first signal, at the integrated, wireless communication interface, via the first wireless link, from the external device; and
generating an enablement signal enabling one or more of an application, a function and a service.

MS-1001(960), Claim 14.

14. A method comprising:
creating a first wireless link between an integrated receiver-decoder circuit (RDC) of a hybrid device and an external device, the hybrid device including an integrated, secure memory and the integrated RDC, wherein the integrated, secure memory stores local, secured information;
receiving a first signal, at the integrated RDC, via the first wireless link, from the external device; and
generating an enablement signal enabling one or more of an application, a function and a service.

MS-1001(289), Claim 14.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Invalidity Challenge 1

Claims 1-20 are Unpatentable Over Giobbi-157 in view of Giobbi-139 (with or without Dua)

74

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Invalidity Challenge 1

Overview of Giobbi-157 and Giobbi-139

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

75

Giobbi-157:

Giobbi-157 is directed at a system and method to "provide efficient, secure and highly reliable authentication for transaction processing and/or access control applications." MS-1005, Abstract, ¶¶[0011]-[0014]. The disclosure further explains that a "transaction includes enabling access to secure physical or digital assets (e.g., unlocking a door, opening a vault, providing access to a secured hard drive, etc.)." MS-1005, ¶[0063]. This process is accomplished using "secure and tamperproof memories" to store information for "identification and authentication." MS-1005, ¶[0036], *see also* ¶¶[0026]-[0029], [0035]-[0048]. Giobbi-157 is a continuation in part of a prior application and claims priority to five provisional applications. MS-1005, Cover, ¶[0002]; MS-1003, ¶[30].

960 Pet., 6; similar to 289 Pet. 7-8.

Giobbi-157 discloses a Personal Digital Key (PDK) that "stores one or more profiles (e.g., a biometric profile) in a tamperproof memory that is acquired in a secure and trusted process." MS-1005, ¶[0063], *see also* ¶¶[0026]-[0029], [0035]-

960 Pet., 6; similar to 289 Pet. 8.

Giobbi-157 teaches that its RDC can authenticate a PDK and then enable a "transaction," the "transaction includ[ing] enabling access to secure physical or digital assets (e.g., unlocking a door, opening a vault, providing access to a secured hard drive, etc.)." MS-1005, ¶¶[0057]-[0058], [0063], FIG. 4; MS-1003, ¶[33].

960 Pet., 9; similar to 289 Pet., 10.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Giobbi-157:

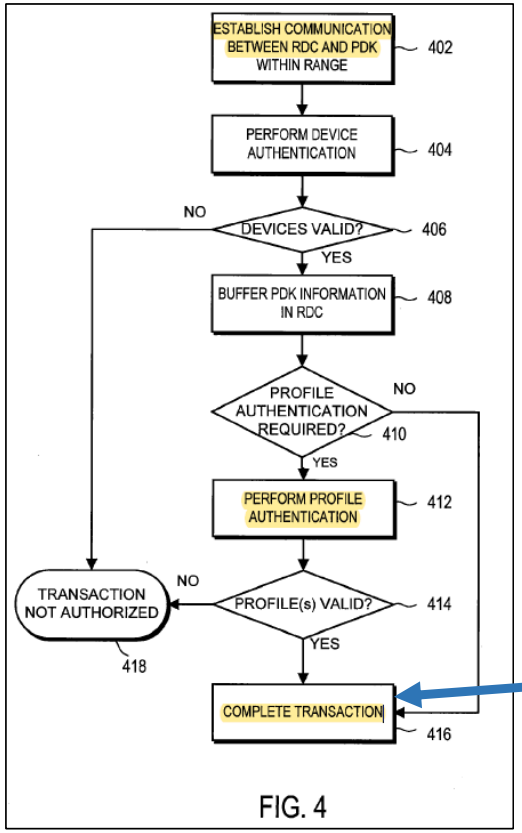


FIG. 4

MS-1005, FIG. 4 (960 Pet., 9; 289 Pet., 10)

[0028] The credibility of the system **100** is ensured by the use of a PDK **102** that stores trusted information. The PDK **102** is a compact, portable uniquely identifiable wireless device typically carried by an individual. The PDK **102** stores digital information in a tamper-proof format that uniquely associates the PDK **102** with an individual.

MS-1005, ¶28 (960 Pet., 6; 289 Pet., 29).

[0050] The RDC **304** provides the wireless interface to the PDK **102**. Generally, the RDC **304** wirelessly receives data from the PDK **102** in an encrypted format and decodes the encrypted data for processing by the processor **306**. An

MS-1005, ¶50 (960 Pet., 7; 289 Pet., 18).

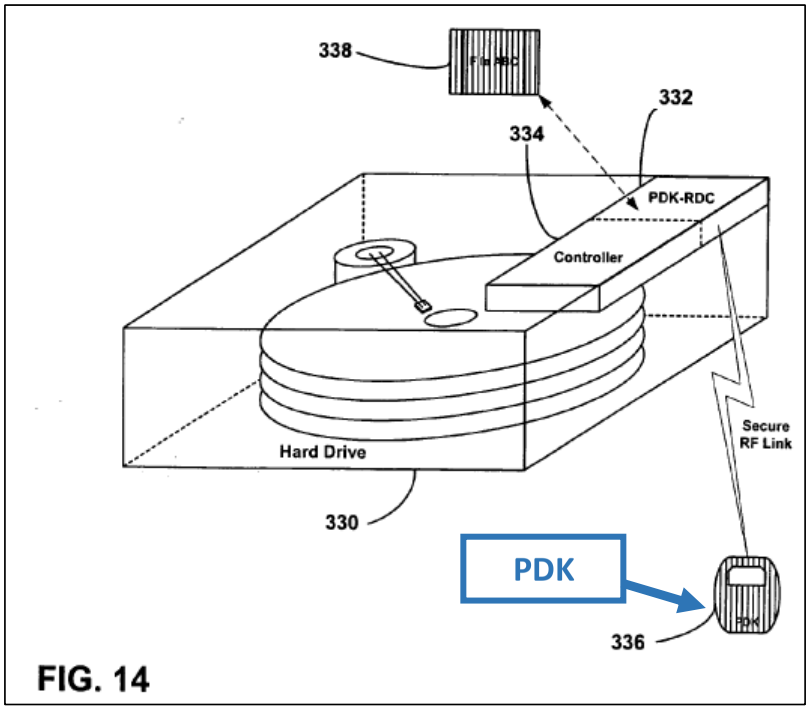
transaction is not authorized **418**. In one embodiment, completing **416** the transaction includes enabling access to secure physical or digital assets (e.g., unlocking a door, opening a vault, providing access to a secured hard drive, etc.). In another embodiment, completing **416** the transac-

MS-1005, ¶63 (960 Pet., 9; 289 Pet., 7).

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Giobbi-157:



MS-1006, FIG. 14 (960 Pet., 58; 289 Pet., 58) (Annotated for legibility)

[0078] Referring to **FIGS. 12 and 13** for Drive-Level protection, when implemented, a PDK hard drive **330** will only function when the associated PDK-Key **336** is within range. The drive's controller **334** is disabled whenever the PDK-Key **336** is not present. The contents of files stored on the drive **330** are not encrypted. The Drive-Level protection feature is designed to protect the hard drive's owner by locking access to the PDK hard drive **330** whenever the associated PDK-Key **336** is not present (i.e. when the owner momentarily steps away from the computer, if the computer is stolen, etc.).

MS-1006, ¶78 (960 Pet., 10; 289 Pet., 11).

78

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Giobbi-139:

Giobbi-139 shares the same goal of securing physical or digital access as Giobbi-157, disclosing a "Personal Digital Key Digital Content Security System" which prevents "unauthorized use and protect[s] the digital content stored on computers from being wrongfully accessed, copied, and/or distributed." MS-1006, Abstract, ¶[0010]. Like the Giobbi-157 publication, Giobbi-139 discusses the use of RDCs to communicate with PDKs to enable access and functions on devices. MS-1006, ¶¶[0010], [0071]-[0078]. The disclosure of Giobbi-139 further teaches that an RDC can be incorporated into **a cell phone** and that the RDC "is an integrated circuit able to process PDK-Key information, as well as encrypt/decrypt PDK-compliant digital content." MS-1006, ¶[0077], [0088] ("This embodiment involves integrating RDCs into…PDAs, cell phones [etc.]"); MS-1005, ¶[0035]; MS-1003, ¶[36].

960 Pet., 10; similar to 289 Pet., 11.

Giobbi-139 teaches the PDK and RDC relationship as being flexible and capable of being integrated with existing equipment. MS-1006, ¶¶[0087]-[0099]. Giobbi-139 also teaches that an RDC can be acquired independently and integrated into a device. MS-1006, ¶¶[0088]-[0090]. The integrated RDC could then be used to secure the device and can even "enable/disable" the device based on communication with a PDK. MS-1006, ¶¶[0087]-[0090]. When using a PDK to secure a device with an integrated RDC, "[t]his security mechanism protects any data stored on such devices in the event they are ever stolen, left unattended, or even purposely 'disabled' to prevent access to sensitive content (i.e. preventing minors from accessing adult files, websites, etc.). MS-1006, ¶[0090]. When the associated PDK-Key(s) is not present, these devices and their storage means are locked and disabled." *Id.*; MS-1003, ¶[37].

960 Pet., 11; similar to 289 Pet., 12.

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

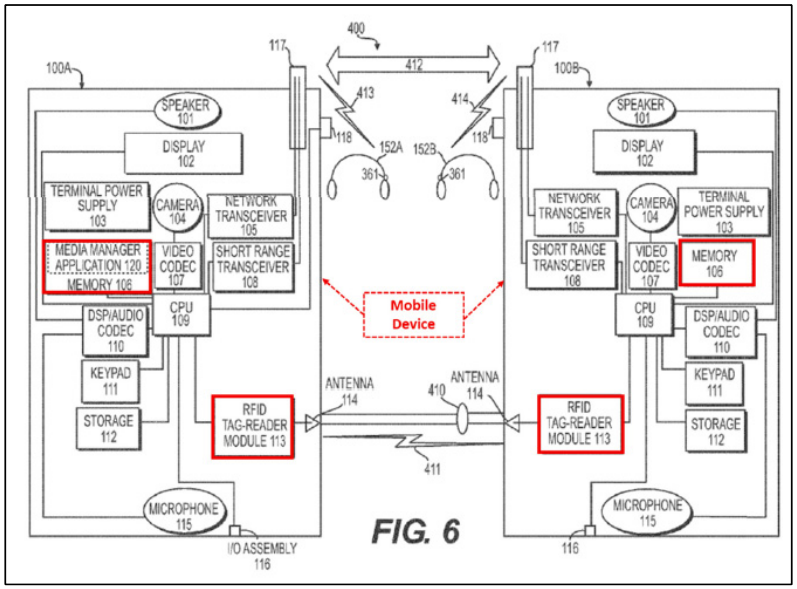
Invalidity Challenge 1

Overview of Dua

80

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

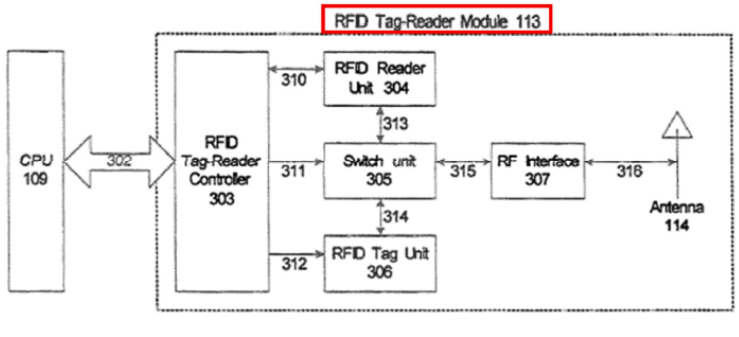
Dua:



MS-1007, FIG. 6; 960 Pet., 21; similar to 289 Pet. 22.

Dua employs an RFID system to secure data and applications on its device using an RFID "electronic key" (e.g., for point-of-sale transactions). MS-1007, 12:51-64. Dua uses an RFID Tag as an electronic "key" and an RFID Reader as the electronic "lock." *Id.* Specifically, Dua discloses that its device uses RFID Tag-Reader Module (shown above in FIG. 4A), that includes both an RFID Reader Unit 304 and RFID Tag Unit 306. MS-1007, 13:22-48, FIGS. 4A, 6; MS-1003, ¶[41].

960 Pet.,22; similar to 289 Pet., 23.



MS-1007, FIG. 4A; 960 Pet., 22; similar to 289 Pet., 23.

FISH.
DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

81

Invalidity Challenge 2

Claims 1-8, 9-11, 14-19 are rendered obvious by Broadcom, and Claims 1-20 are rendered obvious by Broadcom in view of Giobbi-157

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

82

Invalidity Challenge 2

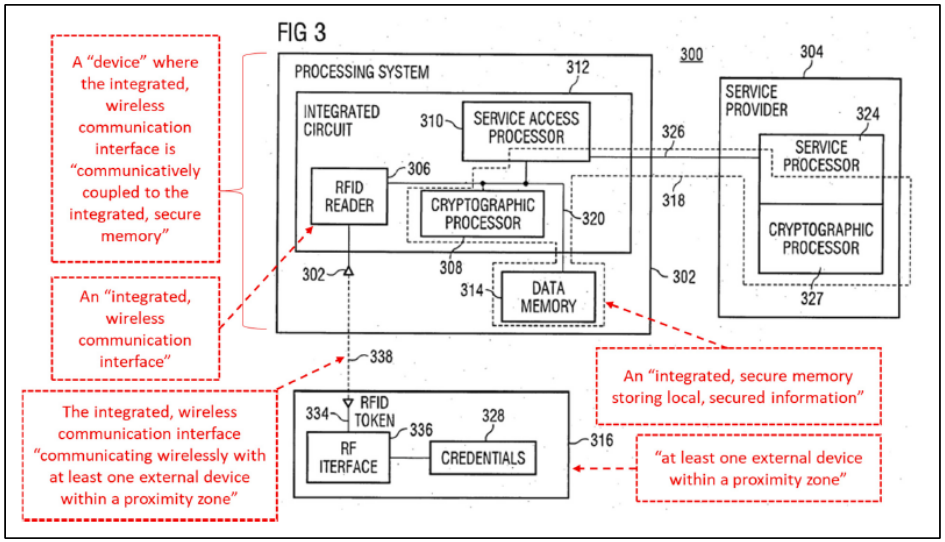
Overview of Broadcom

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

83

Broadcom:



MS-1008, FIG. 3; 960 Pet., 66.

Broadcom discloses a system for secured access to a service based on a wireless device coming withing the proximity of a reader. MS-1008, Abstract; ¶¶[0009]-[0016]; MS-1003, ¶[105]. Broadcom teaches that a user's credentials can be stored on an RFID token, and this token and the associated authentication credentials may be read by an RFID reader located in an Access Device. *Id.* The Access Device (including the RFID reader) can authenticate the RFID token and permit access to the secured service after authentication. *Id.*

960 Pet., 61.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Invalidity Challenges

Patent Owner has not contested the disclosure of the Prior Art

FISH.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

85

Patent Owner has not contested the disclosure of the Prior Art

which challenges the validity of U.S. Patent No. 10,073,960 ("the '960 patent"). In its POR, Proxense, LLC ("**Proxense**" or "**Patent Owner**") does not dispute the characterizations of the prior art, or the combinations advanced in the Petition against claims 1-20 ("**the Challenged Claims**"). Instead, Proxense advances and heavily relies on very narrow constructions of various limitations of the Challenged Claims based on a legally unsupported belief that these limitations trigger 35 U.S.C. § 112(f) ("means plus function," "112(f)," "112(6)," or "MPF"). Having narrowly construed the claims, Proxense then argues that the Petition's invalidity challenge fails to meet these claim limitations, so construed. In doing so, Proxense sidesteps the substance of the 35 USC § 103 invalidity challenge in the Petition and entirely rests its arguments on overly narrow constructions, asserting that the now-narrowed limitations fail to be met by Gobbi-157, Giobbi-139, or any combination thereof.

960 Reply, 1; 289 Reply, 1.

Independent claims 1 and 14 each recite "enabling one or more of an application, a function, and a service." For the reasons stated above, claims 1 and 14 invoke 35 U.S.C. § 112, ¶ 6, such that the algorithm represented by control logic 250 and defining "local, secured information" performs the function of "enabling one or more of an application, a function and service. The Petition fails to establish Giobbi 157, Giobbi 139, or Dua, alone or in combination, "enables an application, a function, and a service" using the algorithm. Consequently, the Petition fails to establish claims 1 and 14, and the claims dependent thereon, are invalid and unpatentable.

960 POR, 30; 289 POR, 29-30.

98

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE