IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION

MAXELL, LTD., Plaintiff, v. SAMSUNG ELECTRONICS CO., LTD., and SAMSUNG ELECTRONICS AMERICA, INC., Defendants.	Civil Action No. 5:23-CV-00092-RWS

DEFENDANTS' RESPONSIVE CLAIM CONSTRUCTION BRIEF

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TABLE OF CONTENTS

Page

I. Introduction 1

II. Legal Standards 1

III. Level of Ordinary Skill in the Art 1

IV. Disputed Claim Terms 2

A. "the processor generates a group of video information based on user preferences determined by the user selections of the video information" ('815 patent: claim 2) 2

B. "character" ('815 patent: claims 1, 21) 3

C. "receiving . . . first video information . . . including second video information that is encrypted" ('815 patent: claim 21) 6

D. "being deleted from the first group of video information" ('815 patent: claim 1) 7

E. "the first group of video information being configured to allow a user to edit" ('815 patent: claim 1) 9

F. "user profile" ('815 patent: claims 1, 21, 23) 11

G. "second camera arranged on an opposite side of the touch display" ('757 patent: claim 1) 14

H. "enabled/disabled" ('757 patent: claim 1) 15

I. "transmission frequency band" ('590 and '241 patents: all asserted claims) 16

J. Mixed apparatus-method claims ('590 patent: claims 1, 5, 11, 12, 16, 17, 24 / '241 patent: claims 1, 5, 6, 10, 11, 26, 27) 16

1. The three indefinite method limitations 16

a. "[W]hen an indication from the user indicates to transmit video information using the first radio communication circuit" 17

b. "the second or third radio communication circuits receive a signal from the internet indicating that an update for an operating system of the video processing apparatus is available" 20

c. The "apparatus executes an update process" 20

K. "wherein . . . when an indication from [the/a] user indicates to transmit video information using the first radio communication circuit, the controller assigns a connection to the first radio communication circuit for transmitting the video" ('590 patent all asserted claims / '241 patent: all asserted claims) 21

L. "first information necessary for an identification of the user" / "second information relating to the identification of the user" ('086 patent: all asserted claims) 24

M. "peripheral device information collation unit" ('161 patent: claims 1 and 3) and "a chronological list of network devices connected to the network" ('161 Patent: claims 1, 3, 6) 29

1. The Agreed Function Is Indefinite 30

2. The Specification Lacks Sufficient Corresponding Structure 33

V. Conclusion 35

TABLE OF AUTHORITIES

Page(s)

Cases

3M Innovative Prop. Co. v. Tredegar Corp.,
725 F.3d 1315 (Fed. Cir. 2013).....27, 28

Abbott Diabetes Care Inc. v. Dexcom, Inc.,
IPR2022-00913, Paper 14 (P.T.A.B. November 3, 2022).....14

AstraZeneca AB v. Mylan Pharms. Inc.,
19 F.4th 1325 (Fed. Cir. 2021).....26

Aylus Networks, Inc. v. Apple Inc.,
856 F.3d 1353 (Fed. Cir. 2017).....24

Blackboard, Inc. v. Desire2Learn, Inc.,
574 F.3d 1371 (Fed. Cir. 2009).....34

Capital Mach. Co. v. Miller Veneers, Inc.,
524 F. App'x 644 (Fed. Cir. 2013).....25

Chef Am., Inc. v. Lamb-Weston, Inc.,
358 F.3d 1371 (Fed. Cir. 2004).....15

Cordis Corp. v. Boston Scientific Corp.,
561 F.3d 1319 (Fed. Cir. 2009).....19

E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.,
849 F.2d 1430 (Fed. Cir. 1988).....8, 25

Hewlett-Packard Co. v. Bausch & Lomb Inc.,
909 F.2d 1464 (Fed. Cir. 1990), *cert. denied*, 493 U.S. 1076 (1990).....21

Intel Corp. v. Qualcomm Inc.,
21 F.4th 801 (Fed. Cir. 2021).....13

Intellectual Ventures I LLC v. T-Mobile USA, Inc.,
902 F.3d 1372 (Fed. Cir. 2018).....33

Interval Licensing LLC v. AOL, Inc.,
766 F.3d 1364 (Fed. Cir. 2014).....33

IPXL Holdings, LLC v. Amazon.com, Inc.,
430 F.3d 1377 (Fed. Cir. 2005).....16, 17, 20, 21

Irdeto Access v. EchoStar Satellite Corp.,
383 F.3d 1295 (Fed. Cir. 2004).....30

In re Katz,
639 F.3d 1303 (Fed. Cir. 2011).....17

Laryngeal Mask Co. v. Ambu A/S,
618 F.3d 1367 (Fed. Cir. 2010).....25, 26, 28

Lone Star Tech. Innovations, LLC v. Asustek Computer Inc.,
No. 6:19-CV-00059-RWS, 2020 WL 6811484 (E.D. Tex. July 31, 2020).....17

MasterMine Software, Inc. v. Microsoft Corp.,
874 F.3d 1307 (Fed. Cir. 2017).....19, 20

Maxell Ltd. v. Apple Inc.,
No. 5:19-CV-00036-RWS, 2020 WL 10456875 (E.D. Tex. Mar. 18, 2020).....1

Maxell Ltd. v. Huawei Device USA Inc.,
297 F. Supp. 3d 668 (E.D. Tex. 2018).....19, 29

Microprocessor Enhancement Corp. v. Tex. Instruments, Inc.,
520 F.3d 1367 (Fed. Cir. 2008).....20

Microsoft Corp. v. Multi-Tech Sys., Inc.,
357 F.3d 1340 (Fed. Cir. 2004).....25

Motion Games, LLC v. Nintendo Co., Ltd.,
No. 6:12-CV-878-JDL, 2015 WL 11170167 (E.D. Tex. Jan. 16, 2015).....20

Nautilus, Inc. v. Biosig Instruments, Inc.,
572 U.S. 898 (2014).....9, 11

North Am. Container, Inc. v. Plastipak Packaging, Inc.,
415 F.3d 1335 (Fed. Cir. 2005).....29

Omega Eng'g, Inc. v. Raytek Corp.,
334 F.3d 1314 (Fed. Cir. 2003).....24

Papst Licensing GmbH & Co., KG v. Samsung Electronics America, Inc.,
924 F.3d 1243 (Fed. Cir. 2019).....9

Pfizer, Inc. v. Ranbaxy Labs. Ltd.,
457 F.3d 1284 (Fed. Cir. 2006).....26

Poly-America, L.P. v. API Indus., Inc.,
839 F.3d 1131 (Fed. Cir. 2016).....27

PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC,
815 F.3d 747 (Fed. Cir. 2016).....8

Raffel Sys., LLC v. Man Wah Holdings Ltd., Inc.,
No. 18-CV-1765, 2020 WL 3184026 (E.D. Wis. June 15, 2020) 26, 27

Reckitt Benckiser Inc. v. Watson Lab'ys, Inc.,
430 F. App'x 871 (Fed. Cir. 2011) 25, 27, 28

Samsung Elecs. Am. Inc. v. Prisua Eng'g Corp.,
948 F.3d 1342 (Fed. Cir. 2020).....11

Schriber-Schroth Co. v. Cleveland Trust Co.,
311 U.S. 211 (1940).....24, 25, 28, 29

SimpleAir, Inc. v. Sony Ericsson Mobile Commc'ns AB,
820 F.3d 419 (Fed. Cir. 2016).....18, 21

Southwall Techs., Inc. v. Cardinal IG Co.,
54 F.3d 1570 (Fed. Cir. 1995).....24

Springs Window Fashions LP v. Novo Indus., L.P.,
323 F.3d 989 (Fed. Cir. 2003).....29

State Farm Mut. Auto. Ins. Co. v. LogistiCare Solutions,
751 F.3d 684 (5th Cir. 2014) 8

Trs. of Columbia Univ. v. Symantec Corp.,
811 F.3d 1359 (Fed. Cir. 2016).....27

Typhoon Touch Techs. v. Dell, Inc.,
659 F.3d 1376 (Fed. Cir. 2011).....33

U.S. Well Sers., Inc. v. Halliburton Co.,
No. 6:21-CV-00367-ADA, 2022 WL 819548 (W.D. Tex. Jan. 17, 2022) 20

UltimatePointer, L.L.C. v. Nintendo Co., Ltd.,
816 F.3d 816 (Fed. Cir. 2016).....20

Visible Connections, LLC v. Zoho Corp,
418 F. Supp. 3d 155 (W.D. Tex. 2019).....17

Wasica Fin. GmbH v. Continental Auto. Sys. Inc.,
853 F.3d 1272 (Fed. Cir. 2017).....13

Statutes

35 U.S.C. § 112.....26

35 U.S.C. § 251.....26, 27

TABLE OF EXHIBITS[1]

Ex. No.	Description
A	Excerpt from Declaration of Dr. Guidash in IPR2024-00717 ('757 Patent)
B	Excerpt from Infringement Contentions dated May 24, 2024, Appendix 5 ('815 Patent)
C	Dr. Bederson Claim Construction Declaration
D	Definition of "character" from Microsoft Computer Dictionary (5th Edition, 2002) (SAM-MAX-00327344)
E	Definition of "character" from Wiley Electrical and Electronics Engineering Dictionary (2004) (SAM-MAX-00327355)
F	Definition of "character" from Webster's Computer Dictionary (10th Edition, 2003) (SAM-MAX-00327351)
G	Definition of "character" from American Heritage Science Dictionary (2005) (SAM-MAX-00327348)
H	Transcript of June 11, 2024 Deposition of Dr. Singh Deposition
I	Excerpt from Declaration of Bederson in IPR2024-00777 (Patent '815), Paragraph 151
J	Transcript of June 6, 2024 Deposition of Dr. Bederson Deposition
K	Excerpt from IPR2018-01432, Paper 32 (Final Written Decision), Pages 13-15
L	U.S. Patent No. 9,384,783
M	*Ex Parte* Reexamination, No. 90/014,651, Sept. 14, 2021, Response to Office Action
N	U.S. Patent No. 7,945,850
O	Excerpt from Samsung's P.R. 3-3 and 3-4 Invalidity Contentions and Disclosures (Mar. 7, 2024)
P	*Ex Parte* Reexamination, No. 90/014,651, June 14, 2021, Non-Final Office Action
Q	U.S. Patent Application Publication No. 2006/0203758 A1 to Tee *et al*.
R	*Ex Parte* Reexamination, No. 90/014,651, Declaration of Tim A. Williams, Ph.D. in Response to July 14, 2021 Non-Final Office Action
S	Reissue Application of U.S. Patent No. RE48,830, Jan. 29, 2019, First Preliminary Amendment
T	Reissue Application of U.S. Patent No. RE48,830, Jan. 22, 2020, Non-Final Office Action
U	Reissue Application of U.S. Patent No. RE48,830, June 22, 2020, Response to Office Action
V	Transcript of June 25, 2024 Deposition of Dr. Jon Weissman
W	Mr. McNair's Claim Construction Declaration
X	Dr. Shields' Claim Construction Declaration
Y	*Abbott Diabetes Care Inc. v. Dexcom, Inc.*, IPR2022-00913, Paper 14

[1] References to Exhibits 1-49 in this brief refer to exhibits attached to Maxell, Ltd.'s Opening Claim Construction Brief (Dkt. No. 73). All emphasis is added unless otherwise noted.

I. INTRODUCTION

Samsung's proposed constructions of seven of the disputed claim terms are squarely premised upon the dictates of the intrinsic evidence, with six of the constructions being premised upon the plain meaning of the express claim language, and the seventh being premised upon Maxell's unequivocal disclaimer of claim scope. In each of those cases, it is Maxell, not Samsung, that seeks to modify the claim scope—in some cases to find infringement where it plainly does not exist, in other cases to avoid the invalidity of its claims.

As shown below, five of the disputed claim terms are indefinite due to Maxell's failure to comply with basic requirements of patentability. Two terms fail to comply with the strict requirements for reciting means-plus-function claims, a third term fails for improperly including method steps in an apparatus claim, and two terms fail the Supreme Court's requirement that a claim inform those of skill in the art of the scope of the claims with reasonable certainty.

In addition, Samsung has agreed to adopt two of Maxell's proposed plain and ordinary meaning constructions, thereby narrowing the scope of the disputes to be addressed by the Court.

II. LEGAL STANDARDS

This Court is well familiar with the law governing claim construction. *See, e.g.*, *Maxell Ltd. v. Apple Inc.*, No. 5:19-CV-00036-RWS, 2020 WL 10456875, at *1-3 (E.D. Tex. Mar. 18, 2020). As such, Samsung will not repeat those principles here, but does cite the authority most relevant to the claim terms at issue in the discussion below.

III. LEVEL OF ORDINARY SKILL IN THE ART

A person of ordinary skill in the art ("POSITA") at the time of the alleged inventions of the asserted patents would have had the following education and experience. Additional education or experience might substitute for these requirements. As to '757 patent, a POSITA would have a Bachelors' degree in electrical or computer engineering or a comparable field of study, plus

approximately two to three years of professional experience with camera technology. Ex. A, ¶¶ 27-30. As to the '815, '590, '241, '086 and '161 patents, Samsung agrees to the proposed definitions of a POSITA in Maxell's opening brief. Op. Br. at 3, 17, 26, and 30–31.

IV. DISPUTED CLAIM TERMS

A. "the processor generates a group of video information based on user preferences determined by the user selections of the video information" ('815 patent: claim 2)

Samsung's Proposed Construction	Maxell's Proposed Construction
Plain and ordinary meaning, which is generating a group of video information that includes (i) only video information that has previously been selected by a user, (ii) only video information that has not previously been selected by a user, and (iii) a mix of video information including video information that has been previously selected by a user and video information not previously selected by a user	Plain and ordinary meaning

Samsung's claim-based construction represents the full range of this term's plain and ordinary meaning because it identifies all three possible types of "a group of video information" that could possibly be formed "based on user preferences determined by user selections of the video information": (i) a group that includes only videos previously selected by a user; (ii) a group that includes only previously unselected videos; and (iii) a group that includes both.

Samsung's construction aligns with the meaning that Maxell employed in its infringement contentions, which identify: (i) a group of video information including information previously selected by the user, which corresponds to group type (i) in Samsung's construction (Ex. B, p. 169 ("User's Preferences are indicated based on user selections of three videos and selecting 'Copy' or 'Move' to album")); and (ii) a group of video information including "recommended" videos, which is information not previously selected by user that corresponds to group type (ii) in Samsung's construction (*id*. at p. 676 ("Netflix provides recommendations with a list based on a user's watch history that corresponds to user selections.")). Group type (iii) was included in Samsung's

construction in response to Maxell's assertion during the meet and confer process that Netflix's recommendations were not limited to previously unselected videos.

Notably, Maxell's opening brief never argues that any of these three group types is incorrect, nor does it identify any video information incorrectly excluded from Samsung's construction. There is thus no dispute that Samsung's construction is correct.

B. "character" ('815 patent: claims 1, 21)

Samsung's Proposed Construction	Maxell's Proposed Construction
A letter, number, punctuation mark, or other symbol or control code that is represented to a computer by one unit of information	Plain and ordinary meaning

Samsung's construction should be adopted because: (1) it correctly reflects the term's specialized plain and ordinary meaning in the computer field, (2) this specialized meaning is consistent with how the '815 patent uses the term, and (3) the construction correctly differentiates the claimed character from the very different and unclaimed concept of complex graphical elements that a lay juror might mistakenly conflate with this term.

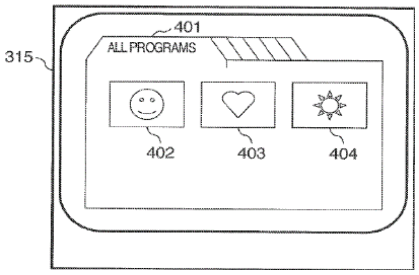
In the field of computing and digital communications, a "character" is a basic unit of information represented by an encoding standard, such as ASCII or Unicode. Ex. C, ¶ 53. The encoding standards assign unique identifiers to each character consisting of a single unit of information (an 8-bit byte; or a 16-bit (2 bytes) or 32-bit (4 bytes) word), allowing consistent representation across digital platforms. *Id*. *Some symbols*, like an asterisk ("*") or a pound sign ("#"), also are "characters" because they are represented by a code stored in a single unit of information in one of the encoding standards. *Id*. However, *most symbols*, like the comic book "character" Batman, are not also "characters" because they do not have an assigned encoding standard code and require a large number of bytes to represent their visual properties. *Id*.

This well-understood meaning of "character" in the field of computing and digital

communications is reflected in the four technical dictionary definitions cited by Samsung, which consistently describe a "character" as a letter, number, punctuation mark, or other symbol or control code. Ex. C, ¶ 54 (citing Exs. D-G). These definitions also all agree that a character is represented to a computer by one unit of information. *Id*. Samsung's construction also is consistent with the three technical dictionaries cited by Maxell, which define "character" as a unit of data, often a letter or number. Ex. C, ¶¶ 56-59 (citing Exs. 4-6). Moreover, the two dictionary Maxell cited definitions that include a "symbol" (Exs. 5-6) do so consistently with Samsung's construction. Ex. C, ¶¶ 58-59. This alignment supports the conclusion that a symbol that also is a character consists of a standardized symbol like an asterisk or a pound sign, and excludes non-standardized graphics like an image of a Batman character. *Id*. at ¶ 60.

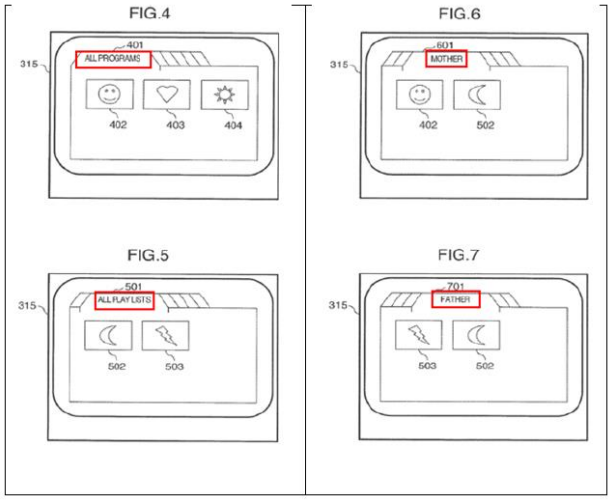
The '815 patent uses "character" consistently with the foregoing meaning in the computer field. Ex. C, ¶ 52. The specification describes displaying video information menus via a "menu display tag" (401) and thumbnails (402-404), as illustrated in Fig. 4 shown here. '815 patent, 5:61-6:40, Figs. 5-7; Ex. C, ¶ 45. The "menu display tags," also referred to in the '815 patent as simply "tags," are graphical images of a file folder with a tab on which appear textual labels such as "ALL PROGRAM INFORMATION" or "MOTHER." Ex. C, ¶ 46. Notably, the specification's sole mention of the word "character" is to indicate that users can select a folder by moving the cursor over the characters (*i.e.*, the individual letters spelling, *e.g.*, "ALL PROGRAMS") on the file folder tabs. '815 patent, 6:14-18; Ex. C, ¶¶ 47-48. Thus, the '815 patent refers to the graphical image of a file folder as a "tag" or "menu display tag," to other graphical images as "thumbnails," and to the individual letters on the tab as a "character" or "tag

FIG.4



character." *Id*. at ¶¶ 49, 51. For example, thumbnail 402 in Fig. 4 above is a smiley face, 403 is a heart, and 404 is a sun. *Id*. at ¶ 51; '815 patent, Figs. 4-7; 5:61-6:18. Importantly, the specification never refers to these graphical images as characters. That is to be expected to one of skill in the art, because complex visuals require many bytes of information to depict their shapes, shades, and other features, do not have specific representations in standard text representation systems, and are not considered "characters" in the context of UI design or computer science. Ex. C, ¶¶ 51, 60.

Maxell's expert, Dr. Singh, confirms this interpretation. He testified the red box annotations to Figs. 4-7 in his declaration, reproduced here, indicate the location of character(s) such as "MOTHER" and "FATHER." Ex. H, 63:20-22; 69:19-21. This confirms file folder tabs like tag 401 are not characters.



Maxell's references to lexicography and disclaimer (Op. Br. at 6) are irrelevant because Samsung's construction is the ordinary meaning to a POSITA in this field of art. And contrary to Maxell's arguments that Samsung's patent (U.S. Patent No. 9,342,238) shows no construction is necessary because the patent uses the term "character" (Op. Br. at 6), that patent actually defines the term, as Dr. Singh admitted. Ex. H, 60:21-24; Ex. 7, 2:25-28, 2:62-64, 8:13-16, 7:14-20. Maxell's comment about Samsung not seeking a construction of this term in its IPR petition also should be given no weight because Dr. Bederson's IPR declaration simply used the meaning of the "character" within the cited prior art. Ex. I, ¶ 151.

C. "receiving . . . first video information . . . including second video information that is encrypted" ('815 patent: claim 21)

Samsung's Proposed Construction	Maxell's Proposed Construction
Plain and ordinary meaning, which is that the second video information is in encrypted form at the time it is received	Plain and ordinary meaning

Samsung's proposed construction is undoubtedly the plain and ordinary meaning of this claim term. The first limitation of claim 21 of the '815 patent reads: "a network interface ***receiving*** first video information wirelessly ***from a device external*** to the information processing apparatus, the ***first video information being received including*** second video information ***that is encrypted***." '815 patent, claim 21 (col. 13:5-10). The plain English meaning of this "receiving" step—a meaning that Maxell now wants to change—is that the network interface receives encrypted second video information from the external device. As just shown, the claim specifically recites "information being received including . . . information that is encrypted." Although this unambiguous, plain meaning reading of these easily understood English words should itself control, Samsung's expert, Dr. Bederson, confirms that this is the correct reading to one of skill in the art. Ex. C, ¶¶ 29-31. Notably, Maxell submitted no expert declaration regarding this term.

Maxell argues Samsung's construction injects a temporal limitation into the claims, *i.e.*, that the second video information is received in encrypted form, which means Maxell contends the claim does ***not*** require receiving encrypted second video information. Op. Br. at 8. But the claim language itself recites receiving second video information from the external device "that is encrypted." Thus, Samsung is not injecting a temporal limitation into the claim, because that temporal limitation already is in the claim. Rather, Maxell is trying to change the claim's plain meaning by *deleting* this temporal limitation, without citing any supporting intrinsic evidence.

D. "being deleted from the first group of video information" ('815 patent: claim 1)

Samsung's Proposed Construction	Maxell's Proposed Construction
Reversing a registration (i.e., unregistering) of video information from the first group	Plain and ordinary meaning

Samsung's construction—which is the same as the PTAB's construction of a substantively identical limitation in an *inter partes* review of a parent of the '815 patent (the "'783 IPR")—is true to the intrinsic evidence. Maxell's arguments to narrow this limitation to only the deletion of data (Op. Br. at 9) conflict with the intrinsic evidence and were rejected by the PTAB when it found the claims unpatentable in the '783 IPR. The Court should adopt the PTAB's construction for two independent reasons: (1) it is substantively correct; and (2) it is binding on Maxell.

The '815 patent is a continuation of U.S. Pat. No. 9,384,783 ("'783 patent") and the two patents thus share an identical specification. '815 patent, p. 2. The '815 patent limitation being construed here is part of a limitation (the "No Deletion Limitation") that is substantively identical to claim 2 of the '783 patent" (differences noted within brackets):

> wherein, [upon/even if] one video information stored on the recording medium included in both the first group of video information and the second group of video information [being/is] deleted from the first group of video information, the one video information continue[s] to be included in the second group of video information

'815 patent, 9:11-16; Ex. L, 9:15-20. In the '783 IPR, the PTAB construed this limitation to mean "reversing a registration (i.e., unregistering) of video information from the first group," further noting that "delet[ing]" video information from a group "does not necessarily require deleting underlying AV data." Ex. K, at 14-15. As Maxell does now (Op. Br. at 9), Maxell argued in the '783 IPR that this limitation is narrowly directed to deleting underlying video data consistent with its theory that an identical copy of the same video is stored in each group of which the video is a member. Ex. K, at 13-14. However, in reviewing the intrinsic evidence, the PTAB rejected

Maxell's multiple copy theory and noted that the claimed deletion is "from the first group of video information," which the PTAB correctly concluded indicates "the deletion may relate to group membership, rather than to the underlying data themselves." *Id*. at 14. The PTAB also correctly noted this "interpretation is consistent with the only instances of the word 'delete' in the specification of the '783 patent." *Id*. (citing Ex. L ('783 patent) Figs. 6, 7, 6:4-7, 6:16-18, 6:26-31, 9:16-21); *see also* '815 patent, 6:25-28. The PTAB further correctly concluded this construction is consistent with the language of the No Deletion Limitation as a whole, "because deletion from a group is contrasted with inclusion in a group" through registration. Ex. K, at 14. "Thus, deleting data from the folder may be interpreted as the opposite action from registering such data to the folder." *Id*. The PTAB's well-reasoned construction—which rests on the claim language and specification—should be adopted here for the same reasons.

Maxell asserts the PTAB's construction should not be given weight because the construction was under the broadest reasonable interpretation (BRI) standard. Op. Br. at 9. However, this argument ignores that the PTAB's construction wholly aligns with the *Phillips* standard because the construction focused exclusively on the claim language and the specification. *See PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, 815 F.3d 747, 756 (Fed. Cir. 2016) (finding that the BRI construction was the same as it would have been under *Phillips*).

A second reason to adopt the PTAB's construction is that Maxell is collaterally estopped from disputing it because: (1) the claim construction issue decided in the '738 IPR is identical to the issue here; (2) the issue was fully litigated by Maxell in the '738 IPR; (3) the determination of that issue was necessary to the outcome of the '738 IPR; and (4) there are no special circumstances that would render estoppel inappropriate or unfair. Ex. K, at 13-15, 33. *State Farm Mut. Auto. Ins. Co. v. LogistiCare Solutions*, 751 F.3d 684, 689 (5th Cir. 2014) (collateral estoppel standard);

Papst Licensing GmbH & Co., KG v. Samsung Electronics America, Inc., 924 F.3d 1243, 1250-53 (Fed. Cir. 2019) (applying collateral estoppel to prior PTAB claim construction decision).

E. "the first group of video information being configured to allow a user to edit" ('815 patent: claim 1)

Samsung's Proposed Construction	Maxell's Proposed Construction
Indefinite	Plain and ordinary meaning

The term "configured to edit" is indefinite because it fails to inform those skilled in the art about the scope of the invention with reasonable certainty, for at least two reasons. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014) (claim is indefinite when it fails to inform those skilled in the art of the claim's scope with reasonable certainty). First, the term is unclear whether (1) the group of video information, (2) the video information itself, or (3) both are to be edited. Ex. C, ¶¶ 62-63. Second, the unrebutted opinion of Dr. Bederson establishes that those skilled in the art do not know what it means for digital information—be it a group of video information or the video information itself—to be configured to edit, and the specification provides no explanation. *Id*. at ¶ 75. Maxell attempts to avoid an invalidity finding by effectively rewriting the term under the guise of plain meaning by arguing that *an apparatus* is configured for editing the information (Op. Br. at 11), but this attempt fails on its face both because it is contrary to the claim language (which says that it is the video information that is configured, not an apparatus) and because the term does not recite any editing apparatus.

Turning to the first issue, it is unclear whether this claim refers to editing both individual items of "video information" ***and*** the "group of video information" ***or*** just one of these. As explained by Dr. Bederson, the specification discloses ***both*** being edited, and claims directed to editing ***both*** are in the file history. Ex. C, ¶¶ 64-74. Maxell does not dispute this but chooses to only cite the specification's examples of editing groups of information while wholly ignoring its

teaching of editing individual items of information. Op. Br. at 11.

Second, even if the claim were narrowed (as Maxell wishes) to a group of digital information being configured to edit, the more fundamental problem is that a POSITA does not know what this means. As Dr. Bederson explains, while any digital information—including individual items of video information or groups of such items—can be edited, nothing in the '815 patent explains what it means for a video information "to be[] configured to allow a user to edit," which is what the claim requires. Ex. C, ¶¶ 75-78. Notably, Maxell's expert Dr. Singh offers no explanation of what this could mean in his declaration. Ex. 1, *passim*.

Maxell attempts to avoid these problems by effectively rewriting this claim term by arguing that it "simply describes *an information processing apparatus that has the capability* to allow a user to edit first group of video information . . ." Op. Br. at 11 (italics added). However, the claim recites that it is the "video information" that is configured to be edited, not that some apparatus exists that can be configured to edit the information, so Maxell's proposed rewrite conflicts with the claim. Moreover, nothing in this claim limitation recites an apparatus. '815 patent, 8:59-67. Critically, when Maxell's expert, Dr. Singh, was questioned at deposition as to what exactly in this claim is being configured to allow a user to edit—an apparatus or a group of video information—he conceded that it is information that is to be configured for editing:

> Q. My question is: What is the thing that is being configured to allow a user to edit? Is that an apparatus or is it a group of video information?
>
> A. It is the group of video information on the apparatus.

Ex. H, 79:17-21. This admission contradicts Maxell's attempt to save this claim by effectively replacing the existing language with a processing apparatus with editing capabilities.

Maxell's reliance on paragraph 62 of Dr. Bederson's declaration from Samsung's IPR petition and his deposition testimony about that paragraph also fails. Maxell mischaracterizes Dr.

Bederson's declaration as a statement that "he is 'reasonably certain' as to the meaning of this term." Op. Br. at 10. However, what Dr. Bederson actually says is that while the claim limitation is unclear as to whether the video information is configured to edit something, or whether video information is itself to be edited, he assumed it is the video information that is edited, and his deposition testimony is consistent with that. Ex. 9, 56:11-57:11. He then goes on to explain—in the portion of his declaration Maxell ignores that addresses the actual issue now before this Court—that the claim does not identify whether it is (1) the group of video information, (2) the video information itself, or (3) both, that are edited. Ex. C, ¶¶ 62-63.

Samsung's IPR petitions also do not "end the inquiry." Op. Br. at 10. It is this Court, not the PTAB, that has the responsibility to determine whether a claim is indefinite, and indefiniteness does not preclude an IPR. *Samsung Elecs. Am. Inc. v. Prisua Eng'g Corp.*, 948 F.3d 1342, 1350, 1352-53, 1355 (Fed. Cir. 2020) (stating, "[w]e reject Samsung's contention that the IPR statute authorizes the Board to cancel challenged claims for indefiniteness," and remanding to the PTAB for consideration of obviousness despite indefiniteness).

F. "user profile" ('815 patent: claims 1, 21, 23)

Samsung's Proposed Construction	Maxell's Proposed Construction
Indefinite	Plain and ordinary meaning

This term is indefinite because a POSITA cannot discern with reasonable certainty whether a "user profile" must include something more than the information already recited elsewhere in the claims and therefore cannot determine the scope of the claim. *Nautilus*, 572 U.S. at 911.

The terms "user profile" and "profile" are not used in the specification. This is not surprising because the "user profile" claim term was not added during prosecution until January 9, 2020, almost 15 years after the first application to which the '815 application claims priority. Ex. C, ¶ 79. The '815 patent mentions terms like "Mother" and "Father" on file folders in Figs. 6 and

7, which Maxell contends are usernames. Op. Br. at 12. But those usernames correspond to the separately recited "first character" and "second character" in the claims. *Id.*; *see also* Ex. 1, ¶ 33. The specification also discloses that the file folders can contain thumbnails representing programs and playlists for those users. '815 patent, Figs. 6, 7, 6:19-40. But playlists and programs are both forms of video information as recited in the claims, and neither is specific to a user, and so also cannot be the claimed "user profiles." Ex. H, 114:12-115:12, 103:19-104:22. The file folders of Figs. 6 and 7 represented by the data structures of Figs. 8 and 9 are the separately recited "first area" and "second area" in the claims. *See* Ex. 1, ¶ 33.

Significantly, these items of information are the only things that Maxell and its expert identify as constituting a user profile. Op. Br. at 12, Ex. 1, ¶¶ 69-76. When Dr. Singh was pressed at deposition to identify some other component of a user profile disclosed in the '815 patent, he could identify only one other item, a "use frequency" of a video as described at 8:23-26, but later admitted that he did not know if the '815 patent discloses that this "use frequency" information was specific to a user and thus could not determine whether it was part of a user profile. Ex. H, 89:21-90:15, 98:3-103:16. Accordingly, the only items of information disclosed in the '815 patent that Maxell could identify as possibly constituting a "user profile" are already separately recited elsewhere in the claim as the first and second characters, the first and second display areas, and video information represented by thumbnails.

The failure of the '815 patent to disclose anything other than items that are already separately claimed as being something other than the claimed "user profile" leaves a POSITA unable to determine what "user profile" means. Ex. C, ¶¶ 79-85. And if the "user profile" term is read narrowly to include just those items, then "user profile" is superfluous because satisfying these other separate claim limitations would by itself necessarily mean there is a user profile. A

construction that renders claim language superfluous is highly disfavored. *Wasica Fin. GmbH v. Continental Auto. Sys. Inc.*, 853 F.3d 1272, 1288 n. 10 (Fed. Cir. 2017). Alternatively, if the "user profile" term is broad enough to include other items not recited in the claims and not disclosed in the written description, then the term lacks written description because neither that term nor any other item of a user profile is disclosed in the patent. Ex. C, ¶¶ 79-85. The dictionary definitions cited by the parties do not resolve this dilemma because they list examples of information that could be in a user profile, but do not indicate whether there is any minimum informational requirement that must be present to constitute the ***claimed*** user profile. This term is thus indefinite because a POSITA cannot determine with any reasonable certainty whether a collection of information that includes only information recited elsewhere in the claims is sufficient to constitute the claimed "user profile," or whether more is required and, if so, what.

Maxell points to Samsung's IPR petitions in an attempt to avoid indefiniteness. Op. Br. at 12. Samsung's IPR petitions (PR2024-00735 and IPR2024-00777) asserted a plain meaning construction and identified in the cited prior art not only the separately claimed items discussed above, but also additional elements in the prior art that conceivably could constitute a user profile, such as the user's MPAA rating shown in Figure 8 of prior art U.S. Patent No. 7,650,361 ("Wong"). Thus, although the claim term is indefinite, Samsung cited information in the prior art of such a breadth that it would satisfy the claim term, whatever it might mean. Accordingly, the indefiniteness of this claim term does not render it logically impossible to render an unpatentability determination in the Samsung IPR petitions. *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 813 (Fed. Cir. 2021) (indefiniteness precludes patentability determination in an IPR "only when the indefiniteness renders it logically impossible for the Board to reach such a decision."). Moreover, as shown above, the PTAB cannot determine indefiniteness and there is nothing improper in

asserting different constructions in an IPR petition and a district court proceeding. Ex. Y, *Abbott Diabetes Care Inc. v. Dexcom, Inc.*, IPR2022-00913, Paper 14 at 14 (P.T.A.B. November 3, 2022).

Finally, while Maxell cites Samsung's use of "user profile" in two Samsung patents, Samsung's use of that term is distinguishable from the situation here because, unlike the '815 patent, the specification of those patents actually uses that term. Ex. 12, 2:52; Ex. 13, 4:55.

G. "second camera arranged on an opposite side of the touch display" ('757 patent: claim 1)

Samsung's Proposed Construction	Maxell's Proposed Construction
Plain and ordinary meaning, which is that the second camera is located on a side of the touch display that is opposite a side of the touch display on which the first camera is located	Plain and ordinary meaning, which Maxell argues for the first time in its opening brief means "an arrangement of two cameras such that one camera is on the same side as the touch display and the second camera is opposite to the touch display" (Op. Br. at 15)

Both parties contend their constructions reflect the plain meaning, but the constructions are significantly different. The plain language of claim 1 requires a first camera located on one side of the touch display, and a second camera located on the opposite side of the touch display: "a first camera arranged on a same side of the touch display . . . a second camera on an opposite side of the touch display." '757 patent, 16:15-19. The claim thus addresses the relative positions of three components: the first and second cameras and the touch display. The claim dictates relative positions like a sandwich, with the first camera located on one side of the touch display, and with the second camera located on the other side of the touch display (with neither necessarily in contact with the touch screen), such that the two cameras are located on opposite sides of the touch display. Samsung's construction requires just that and nothing more.

While Maxell's construction arguably correctly states that the second camera must be located to one side of ("opposite to") the touch display, Maxell rewrites the required relative positioning by permitting the first camera and the touch screen to be merely located together on

the same side of the claimed recording device (*e.g.*, a phone) *regardless* of whether the first camera is located on the front or rear side of the touch display. For example, under Maxell's construction, both the first and second cameras could be located on the same side (the rear side) of the touch display, as long as the first camera and the touch display were both located somewhere near the front of the phone and the second camera was located near the back of the phone.

Nothing in the patent permits Maxell's claim rewrite. Claim 1 expressly requires a first camera "arranged on a same side ***of*** the touch display," not merely "arranged on a same side [of the claimed recording device] ***as*** the touch display" as Maxell's construction incorrectly posits. Claim 1's express recitation that both cameras are located on a "side of the touch display" and that the second camera is arranged "on an opposite side ***of*** the touch display" confirms the two cameras must be located on opposite "sides" of the touch display, rather than permitting the first camera to be simply located somewhere near the touch display as Maxell's construction permits.

Maxell cites Fig. 4 as somehow supporting its construction. Op. Br. at 14. However, because Fig 4(a) depicts a top-down view of the phone, it lacks any depth perspective and one cannot tell where the front camera is relative to the touch screen 141 depth-wise. Accordingly, nothing in Fig. 4 modifies the plain meaning of claim 1.

Maxell's request to replace the preposition "of" with the preposition "as" is similar to *Chef America* where the plaintiff asked the Court to replace one preposition with another ("to" for "at"). *Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1373-74 (Fed. Cir. 2004). The Federal Circuit held that it could not because the Court is not permitted to redraft claims. *Id*. at 1374.

H. "enabled/disabled" ('757 patent: claim 1)

Samsung's Proposed Construction	Maxell's Proposed Construction
Plain and ordinary meaning	Plain and ordinary meaning

Samsung agrees to adopt Maxell's proposed construction.

I. "transmission frequency band" ('590 and '241 patents: all asserted claims)

Samsung's Proposed Construction	Maxell's Proposed Construction
Plain and ordinary meaning	Plain and ordinary meaning

Samsung's proposed construction would have required a device to transmit and receive information on the same set of frequencies, while Maxell's proposed plain and ordinary meaning encompasses the use of different frequencies to transmit and receive information. Based on the record as developed by Maxell, Samsung withdraws its narrower construction.

J. Mixed apparatus-method claims ('590 patent: claims 1, 5, 11, 12, 16, 17, 24 / '241 patent: claims 1, 5, 6, 10, 11, 26, 27)

Samsung's Proposed Construction	Maxell's Proposed Construction
Indefinite for being directed to mixed "apparatus-method claims"	Not indefinite. Apparatus claims

Asserted claims 1, 5, 11, 12, 16, 17 and 24 of the '590 patent and claims 1, 5, 6, 10, 11, and 27 of the '241 patent are indefinite because they impermissibly recite mixed apparatus-method claims so it is unclear when infringement occurs. *IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005).

1. The three indefinite method limitations

'590 patent claim 1 recites the following three method steps (in italics, numbers added):

> wherein the controller controls assignment of connection for each of the first and second radio communication circuits in response to receiving an indication from a user such that *[1] when an indication from the user indicates to transmit video information using the first radio communication circuit*, the controller assigns a connection to the first radio communication circuit for transmitting the video information,
>
> . . .
>
> wherein *[2] the second or third radio communication circuits receive a signal from the internet indicating that an update for an operating system of the video processing apparatus is available,* and *[3] the video processing apparatus executes an update process* such that an updated operating system of the video processing apparatus is stored in the video processing apparatus after execution of the update process.

'590 patent, claim 1 (at 1:59-67, 2:7-14).

Claims 11, 12, 16 and 17 of the ’590 patent depend upon claim 1 and therefore include these limitations. Independent claim 5 of the ’590 patent (which Maxell uses as its sole representative claim in its opening brief), independent claim 23 of the ’590 patent (upon which asserted claim 24 depends), and independent claims 1 and 25 of the ’241 patent (and dependent claims 5, 6, 10, 11, 26 and 27 which depend therefrom) recite limitations similar to the six above-quoted claim 1 limitations and they are not distinguishable from claim 1 for purposes of this *IPXL* analysis. ’590 patent, claim 5, 2:16-21, 43-54, 61-67; ’241 patent, claim 1, 21:13-16, 25-32 and claim 25, 24:43-45, 53-59; Op. Br. at 20, 22.

a. “[W]hen an indication from the user indicates to transmit video information using the first radio communication circuit”

The first “wherein” limitation recited above includes the method step of “when an indication from ***the user indicates*** [to transmit video information using] the first radio communication circuit.” ’590 patent, claim 1. This requires that the user perform the act of indicating. Thus, the claim limitation here, as in *IPXL* and *In re Katz*, 639 F.3d 1303 (Fed. Cir. 2011), is directed to user action, rather than to apparatus capability, and thus improperly recites a method step within an apparatus claim. *IPXL*, 430 F.3d at 1384 (claim to “*system* . . . [including an input means] wherein . . . *the user uses the input means*” is indefinite); *Katz,* 639 F.3d at 1318 (claim to system “with an interface means for providing automated voice messages” where “callers digitally enter data” is indefinite); *see also Visible Connections, LLC v. Zoho Corp*, 418 F. Supp. 3d 155, 166 (W.D. Tex. 2019) (claim to application that “receives from the user a selection of one or more the user-selectable database fields, and generates a database query” is indefinite); *Lone Star Tech. Innovations, LLC v. Asustek Computer Inc.*, No. 6:19-CV-00059-RWS, 2020 WL 6811484, at *14 (E.D. Tex. July 31, 2020) (the phrase “a viewer of said real time digital video image display device operating said master control device . . .” rendered the claim indefinite).

The reexamination file history confirms that user action is required by this limitation. Original claims 1 and 5 required that the controller "control[] assignment of connection … in response to receiving an indication from a user." Ex. M, at 3, 5. In response to the Examiner's rejection over the "Tee" reference, Maxell distinguished its claim from Tee due to Tee ***not*** disclosing a user action. *Id.* at 21 (arguing that Tee could not be a section 103 reference because it lacked an "indication from a user that directs the controller to control assignment of connection for any of Tee's transceivers 202 or 203."). According to Maxell, "Tee's initiation of a video download … ***involves no indication from the user*** to use a particular one of the available transceivers, much less any control that assigns a connection on the basis of such user indication." *Id.* at 23. Maxell therefore represented to the Patent Office that this claim limitation must include a user action, and even amended the claim to add the "when" clause to more clearly require a user action. *Id.* at 3. Thus, Maxell's own amendments and arguments confirm that this claim limitation is not simply a capability of an apparatus—it is an action performed by a user.

Moreover, when Maxell wanted to recite a "capable of" claim limitation, it knew how to do so and did so. For example, the asserted claims recite "a first radio communication circuit capable of transmitting" and "a second radio communication circuit capable of connecting." *See* '590 patent, claim 1 (emphasis added). In the limitation at issue here, by contrast, Maxell chose not to recite a controller "capable of" the recited action. *Id.* By using different language, Maxell should be presumed to intend a different meaning. *See SimpleAir, Inc. v. Sony Ericsson Mobile Commc'ns AB*, 820 F.3d 419, 431 (Fed. Cir. 2016).

Maxell's other arguments also lack merit. First, Maxell's observation that patent examiners allowed these claims carries no weight because every patent that has been found indefinite by a court was approved by an examiner. Second, Maxell's expert opinion consists of a single

conclusory sentence, bereft of any analysis, and thus should be given no weight. Op. Br. at 19; Ex. W, ¶ 52. *Maxell Ltd. v. Huawei Device USA Inc.*, 297 F. Supp. 3d 668, 679 (E.D. Tex. 2018) ("an expert's conclusory, unsupported assertions as to a term's definition are not useful."). Third, Samsung's own patents are of no consequence to this action. Op. Br. at 23-24. Maxell's patents are different patents, with different claims, specifications and file histories, and the issue here is whether the Maxell (not the Samsung) patent claims are invalid. Fourth, the use of "such that" in this limitation does not convert the method step to an apparatus limitation. Maxell's reliance on *Cordis Corp. v. Boston Scientific Corp.* is misplaced because it merely stated that "functional language can be a claim limitation." 561 F.3d 1319, 1335 (Fed. Cir. 2009).

Fifth, none of the cases cited by Maxell applies to the facts of this case. Op. Br. at 19-22. Maxell relies most heavily on *MasterMine Software, Inc. v. Microsoft Corp.*, 874 F.3d 1307, 1315 (Fed. Cir. 2017). However, as discussed above, Maxell made claim amendments and repeated arguments to the Patent Office that the claim limitation here requires user action, while there was no such distinction in *MasterMine*. Moreover, the claims at issue in *MasterMine* did not include the "capable of" language that is present in other limitations of the subject claims of the '590 patent, by which, as discussed above, Maxell made clear which limitations were and were not "capable of" limitations. Ex. N, (U.S. Patent No. 7,945,850).

Furthermore, while the claim in *MasterMine* recited that the "reporting module" "receives from the user a selection" and "generates a database query as a function of the user selected database fields," it did not include the temporal cause-and-effect present in the asserted claims here. The '590 patent claims require that the "controller controlling the assignment of connection . . . in response to receiving an indication from a user such that when an indication from the user indicates to transmit video information using the first radio communication circuit, the controller

assigns a connection to the first radio communication circuit for transmitting the video information." '590 patent, claim 1. That means that the controller will not assign a connection until it receives *an indication from the user*. Such a cause-and-effect did not exist in *MasterMine*.

Other cases that Maxell cites also are distinguishable as none of the claims in those cases involved user action or an apparatus performing an action in response to any user action. *See, e.g.*, *U.S. Well Sers., Inc. v. Halliburton Co.*, No. 6:21-CV-00367-ADA, 2022 WL 819548, at *9 (W.D. Tex. Jan. 17, 2022); *Microprocessor Enhancement Corp. v. Tex. Instruments, Inc.*, 520 F.3d 1367, 1371-72, 1375 (Fed. Cir. 2008); *UltimatePointer, L.L.C. v. Nintendo Co., Ltd.*, 816 F.3d 816, 819, 827 (Fed. Cir. 2016); *Motion Games, LLC v. Nintendo Co., Ltd.*, No. 6:12-CV-878-JDL, 2015 WL 11170167, at *4-5 (E.D. Tex. Jan. 16, 2015). Nor did any of those claims include "capable of" language for some limitations but not others, as is the case here, nor file histories in which the patentee made clear that user action was required, as also is the case here.

b. "the second or third radio communication circuits receive a signal from the internet indicating that an update for an operating system of the video processing apparatus is available"

The "circuits receive" limitation recites a method step and is a second, independent basis of indefiniteness under *IPXL*. The claims separately recite what the radio circuits are "capable of." '590 patent, claim 1 (". . . the second radio communication circuit capable of connecting by radio to an internet or a home network to transmit and receive information …"). In contrast, the "circuits receive" step specifies an action—a signal is sent by and received from a source on the Internet. Maxell did not address this limitation in its opening brief notwithstanding Samsung identifying it as a basis for its *IPXL* defense. Ex. O, at 135.

c. The "apparatus executes an update process"

The "apparatus executes an update process" limitation clearly recites a method step and these claims are indefinite under *IPXL* on this third independent ground. Here again, there is no

"capable of" claim language and, instead, the claim affirmatively requires that the apparatus execute an update process, making clear that the patentee required this step to be performed. *SimpleAir, Inc.*, 820 F.3d at 431. This limitation does not merely reflect the capability of a component, because it is directed to the claimed "apparatus" as a whole and to what it ***does*** not what it ***is***. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990), *cert. denied*, 493 U.S. 1076 (1990). Maxell did not address this limitation in its opening brief despite Samsung identifying it as a basis for invalidity under *IPXL*. Ex. O, at 135.

K. "wherein . . . when an indication from [the/a] user indicates to transmit video information using the first radio communication circuit, the controller assigns a connection to the first radio communication circuit for transmitting the video" ('590 patent: all asserted claims / '241 patent: all asserted claims)

Samsung's Proposed Construction	Maxell's Proposed Construction
Plain and ordinary meaning, which requires the user, not the controller, to select the particular radio for assignment	Plain and ordinary meaning

Independent claims 1 and 23 of the '590 patent, and independent claims 1 and 25 of the '241 patent, recite that "when an indication from [the/a] user indicates to transmit video information using the first communication circuit, the controller assigns a connection to the first radio communications circuit for transmitting the video." Independent claims 5 and 9 of the '590 patent and independent claim 17 of the '241 patent recite substantively indistinguishable limitations. '590 patent, claim 5 (2:46-54), claim 9 (3:30-38); '241 patent, claim 17 (23:7-13).

The ordinary meaning of this limitation requires that the controller *assign* a connection to the first radio communication circuit previously selected ("indicated") *by the user*. The limitation recites "the controller assigns a connection to ***the*** first radio communication circuit for transmitting the video." Here, the phrase "the first radio communication circuit" finds its antecedent basis in the immediately preceding claim phrase "when an indication from a user indicates to transmit

video information using ***the*** first radio communication circuit." '590 patent, 1:62-67. Thus, the plain meaning reading of this limitation requires the user to first select ("indicate") the radio and then the controller assigns that radio.

Samsung's construction does not impose a "negative limitation" as Maxell contends (Op. Br. at 24-25), but rather simply reflects the express claim requirements. Maxell also is incorrect that Samsung's construction conflicts with the specification. Op. Br. at 25. Just the opposite is true, as the portion of the specification cited by Maxell discloses that the controller assigns the radio indicated by the user. '590 patent, 8:35-38 ("in response to an indication by the user"). Indeed, in the "example" provided by the specification—which Maxell wholly ignores—the user indicates transmitting video via modem 1002, and the controller then sends a control signal implementing that choice. *Id*. at 8:38-47.

While the plain claim language itself supports Samsung's construction, the prosecution history includes a clear and unmistakable disavowal of Maxell's current reading of the claim. Representative claim 1 of the original '590 patent, prior to reexamination, recited "the controller controls assignment of connection for each of the first and second radio communication circuit in response to receiving an indication from a user." '590 patent, 1:59-62 (normal font). During reexamination, original claim 1 was rejected over Tee. Ex. P, at 22. Tee discloses the user manually indicating that the controller should execute "display select program 260," and in response the controller automatically selects and assigns a radio circuit for video transmission. Ex. Q, at [0034] (executes select program 260 "in response to manual inputs entered by the operator"), [0036] (controller assigns "appropriate one of transceivers 202 and 203"). Thus, Tee expressly discloses the original limitation, because Tee's controller assigns the first radio communication circuit in response to an indication from the user.

To overcome the Tee rejection, Maxell added the limitation at issue. '590 patent, 1:62-67 (italics); Ex. M, at 3. Concurrently, Maxell repeatedly told the Patent Office that Tee's user indication to run select program 260 was distinguishable from the amended claim because the user in Tee did ***not*** indicate the "particular radio" for the controller to assign. Ex. M, at 15 ("the user indication of Tee does not identify ***a particular transceiver*** for assignment"), 23 ("Tee[]…involves no indication from the user to use ***a particular one*** of the available transceivers"), 24 (arguing the user indicating to use display select program 260 "has nothing to do with a user indicating ***a particular radio communication circuit*** to be used"), 26 ("Tee is completely silent about the user indicating ***whether to use transceiver 201, 202, or 203***."), 27 note 2 (Tee's display select program "has nothing to do with a user indicating ***a particular radio communication circuit*** to be used…"). Maxell also repeatedly told the Patent Office that Tee's user-indication to run select program 260 caused Tee's controller to "automatically" select a radio for assignment, rather than the user doing so as required by the amended claim. *Id.* at 23 ("Tee discloses that control processor 210 assigns a connection to transceiver 202 or 203 **automatically**") (emphasis in original); *see also*, *id.* at 27 ("the controller in Tee assigns the connections to a selected one of the available transceivers ***automatically***"). Maxell further argued that it would not have been obvious to modify Tee's "automatic" assignment to require the user indicate the particular radio. *Id.* at 28 ("Tee's solution of ***automatically*** assigning"). Maxell's reexamination expert supported each of Maxell's arguments. Ex. R, ¶¶ 67-75. Accordingly, it is crystal clear that Maxell repeatedly told the Patent Office—to save its claims from rejection—that its amended claims required the user to select the particular radio the controller would assign.

Maxell's claim amendment adding the requirement that the controller assign the radio indicated by the user, and its repeated statements to the Patent Office distinguishing that

requirement from prior art in which the controller (not the user) selected the radio, constitutes a clear and unequivocal disavowal of Maxell's currently proposed reading of the claim that the controller selects the radio rather than the user. Op. Br. at 25 (Maxell asserting that "the controller will have to select the first communication circuit"). *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220-21 (1940) ("[a] claim in a patent as allowed must be read and interpreted with reference to claims that have been canceled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent."); *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003) (Prosecution disclaimer "preclud[es] patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution."); *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1360 (Fed. Cir. 2017) ("Ultimately, the doctrine of prosecution disclaimer ensures that claims are not 'construed one way in order to obtain their allowance and in a different way against accused infringers.'") (quoting *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995)). Notably, while prosecution disclaimer can occur by either amendment or disclaimer—it was both here. *Aylus*, 856 F.3d at 1359.

L. "first information necessary for an identification of the user" / "second information relating to the identification of the user" ('086 patent: all asserted claims)

Samsung's Proposed Construction	Maxell's Proposed Construction
Information sufficient for the identification of the user, but not including information about a user's fingerprint / information related to the identification of a user, but not including information about a user's fingerprint	Plain and ordinary meaning

Maxell is precluded from recapturing claim scope—information about a user's fingerprint—that it squarely disclaimed during prosecution through claim cancellations and claim amendments. "It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been canceled or rejected,

and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent." *Schriber-Schroth*, 311 U.S. at 220-21; *Reckitt Benckiser Inc. v. Watson Lab'ys, Inc.*, 430 F. App'x 871, 873, 876-77 (Fed. Cir. 2011) (construction "properly accounted for" applicants' disavowed claim coverage through cancelling and adding claims); *Laryngeal Mask Co. v. Ambu A/S*, 618 F.3d 1367, 1372-73 (Fed. Cir. 2010) (improper to read a feature into a construction when the claims were amended to delete that feature).

During prosecution of the reissue of the '086 patent's parent patent, United States Patent No. RE48,830, which has the same specification as the '086 patent,[2] the applicant tried and failed to obtain a claim covering "fingerprint" information. The applicant submitted proposed independent claims 8 and 21 to the Patent Office that recited language similar to that of disputed claim 1 of the '086 patent. Ex. S, at 5, 7, 8. However, those two proposed claims differed from claim 1 in one important respect—they recited storing information "***corresponding to a fingerprint of the user***." *Id*. The Examiner rejected proposed claims 8 and 21 for lack of written description, finding that "[t]here is no support for storing information related to a fingerprint, as the specification discloses storing information as to the fingertip or finger pad." Ex. T, at 5. In response, the applicant canceled claims 8 and 21 (Ex. U, at 5, 7), effecting a clear disclaimer of "information related to a fingerprint" from the scope of the asserted claims. *Schriber-Schroth*, 311 U.S. at 220-21; *Reckitt Benckiser*, 430 F. App'x at 876.

In the same office action, the Examiner also separately rejected proposed claims 8-34 as

[2] As the Federal Circuit holds, "[t]he prosecution history regarding [disclaimer of] a claim term is pertinent when interpreting the same term in both later-issued and earlier-issued patents in the same family." *Capital Mach. Co. v. Miller Veneers, Inc.*, 524 F. App'x 644, 649 (Fed. Cir. 2013) (citing *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004)); *see also E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1439 (Fed. Cir. 1988) ("Statements made during reissue are relevant prosecution history when interpreting claims.").

impermissibly broad and containing new matter on reissue in violation of 35 U.S.C. § 251. Ex. T, at 4-6. The applicant responded by (1) canceling dependent claim 20, which recited the informational processing apparatus according to the rejected independent claim 8 (which had included the rejected fingerprint limitation), and (2) amending independent claim 1 to include certain matter originally covered by the withdrawn dependent claim 20. Ex. U, at 3-5, 7. Critically, in amending claim 1 to add limitations from withdrawn claim 20, the applicant did not include any claim language about fingerprint information. Because claim 20 depended from claim 8, claim 20 included all limitations of claim 8, including the "fingerprint" limitation. *Pfizer, Inc. v. Ranbaxy Labs. Ltd.*, 457 F.3d 1284, 1291 (Fed. Cir. 2006) (citing 35 U.S.C. § 112 ¶ 4).

The applicant's omission of the "fingerprint" language from claim 20 in amending claim 1 constitutes a further disclaimer of "fingerprint" information from the scope of the claims. Because the applicant knew how to claim "fingerprint information," but chose not to do so in amending claim 1 to add subject matter from claim 20, the scope of claim 1 cannot include "fingerprint" information. *See AstraZeneca AB v. Mylan Pharms. Inc.*, 19 F.4th 1325, 1333-34 (Fed. Cir. 2021) (where it is clear from other claims that the patentee knew how to broaden claim terms, the patentee's failure to include broadening language in other claims "provides … support for construing [the claim term at issue] narrowly."); *Laryngeal*, 618 F.3d at 1372-73 (after applicant amended a claim to remove a term from a claim limitation, "it would be improper to read [that term] back into the [claim limitation]").

Maxell attempts to avoid a disclaimer finding by citing the applicant's generic statements that it "respectfully disagree[d] with all rejections in the present Office Action" and that it amended the claims "only to expedite prosecution." Op. Br. at 29. But boilerplate statements like these cannot avoid a disclaimer resulting from the applicant's clear actions. *Raffel Sys., LLC v. Man*

Wah Holdings Ltd., Inc., No. 18-CV-1765, 2020 WL 3184026, at *8 (E.D. Wis. June 15, 2020) (finding disclaimer and noting that an applicant's "boilerplate" language during prosecution explaining that an amendment was made "without prejudice to or disclaimer of subject matter" carries little to no weight if it is "not tailored specifically to the scope of" the claim term at issue); *see also Reckitt Benckiser*, 430 F. App'x at 873, 876 (finding disclaimer even though the claims were "cancelled to facilitate prosecution").

Maxell argues the applicant did not cancel claims 8 and 20 and amend claim 1 to overcome written description and new matter rejections, but rather to overcome section 251 rejections for claim broadening. Op. Br. at 29. This is incorrect. None of the claim 8-20 limitations the Examiner rejected as improperly broad recited "fingerprint" information. *See* Ex. T, at 3-5. If the applicant had canceled claim 20 and amended claim 1 to overcome the Examiner's broadening rejection, there would have been no reason to omit the "fingerprint" limitation from claim 1, because the "fingerprint" limitation was not part of the subject matter the Examiner found impermissibly broad. Instead, the only reason the applicant omitted claim 20's "fingerprint" limitation from amended claim 1 was the written description and new matter rejections.

Maxell contends the applicant's *statements* do not constitute disclaimer. Op. Br. at 30. But the law is clear that explicit disavowal is not required to limit claims. *See Trs. of Columbia Univ. v. Symantec Corp.*, 811 F.3d 1359, 1363-64 (Fed. Cir. 2016); *Poly-America, L.P. v. API Indus., Inc.*, 839 F.3d 1131, 1136 (Fed. Cir. 2016) ("While disavowal must be clear and unequivocal, it need not be explicit."). Rather, disavowal may apply regardless of whether the applicant makes an affirmative statement. *Id.*; *see also Raffel Sys., LLC*, 2020 WL 3184026, at *8 (finding disclaimer based on applicant's actions without any affirmative statement). Maxell relies on *3M Innovative Prop. Co. v. Tredegar Corp.*, but in that case, the defendant was attempting to stretch

the disclaimer beyond what the applicant actually said in prosecution. 725 F.3d 1315, 1325-26 (Fed. Cir. 2013). That is not the situation here. ***The issue here*** is whether the claim cancellations and amendments operate as a disclaimer. The answer is that they do. *Schriber-Schroth*, 311 U.S. at 220-21; *Reckitt Benckiser*, 430 F. App'x at 876; *Laryngeal*, 618 F.3d at 1372-73.

Maxell emphasizes that the patent specification contains "over a **hundred** references to a user's finger and of identifying an input from the finger using a group of sensors or a sensor whose capacitance varies upon contact with the user's finger." Op. Br. at 27 (emphasis in original). But rather than supporting Maxell's argument that the claims encompass "fingerprints," these many references instead underscore Samsung's point. Detecting touches from a user's finger as described in the specification (such as using sensors to detect a finger contacting the screen) is fundamentally different than detecting the unique ridges, loops, and whorls of a fingerprint. The Examiner confirmed this difference by rejecting "fingerprint" claims for lacking written description support despite the many references to a user's "finger" in the specification. Ex. T, at 5, 6. Indeed, the specification never discloses detecting a fingerprint; on the contrary, the patent defines "finger tip input" and "finger pad input" only by reference to the "small" and "wider" contact areas of the fingers, not the fingerprints. '086 patent, 3:3-13. By adding claim limitations reciting "finger of a user" while cancelling "fingerprint" claims, the applicant disclaimed the latter.

Maxell's reliance on Dr. Wobbrock's opinions is equally unavailing. Op. Br. at 27-28. If the specification—which ***never*** uses the word "fingerprint"—somehow disclosed the use of fingerprints as Dr. Wobbrock claims, the applicant surely would have cited these disclosures in response to the Examiner's rejection of the fingerprint claims for lacking written description support. The applicant did not. Moreover, ***regardless*** of what the specification discloses, prosecution history estoppel dictates that claims "cannot by construction be read to cover what

was thus eliminated from the patent." *Schriber-Schroth*, 311 U.S. at 220-21. Indeed, Maxell cites no authority for the proposition that a disclosure in the specification can override prosecution disclaimer, and the law is to the contrary, including when a claim construction based on the prosecution disclaimer excludes preferred embodiments. *North Am. Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 1346 (Fed. Cir. 2005) ("[W]e have previously explained that limitations may be construed to exclude a preferred embodiment if the prosecution history compels such a result."); *Springs Window Fashions LP v. Novo Indus., L.P.*, 323 F.3d 989, 996 (Fed. Cir. 2003) ("we have adopted claim constructions excluding an embodiment when the prosecution history requires the claim construction because of disclaimer").

M. "peripheral device information collation unit" ('161 patent: claims 1 and 3) and "a chronological list of network devices connected to the network" ('161 Patent: claims 1, 3, 6)

The parties agree that the "peripheral device information collation unit" (the first of these two related claim terms, hereafter the "collation unit") is a means-plus-function ("MPF") term. The parties also agree on the identification of the stated function of the collation unit. Op. Br. at 31 (table stating "Agreed Function"). What remains for the Court to decide is: (1) whether that agreed function is, as Samsung demonstrates, indefinite; and (2) regardless of whether the agreed function is indefinite, whether, as Samsung demonstrates, there is a lack of corresponding structure in the patent specification for the function. *Maxell Ltd. v. Huawei Device USA Inc.*, 297 F. Supp. 3d 668, 680 (E.D. Tex. 2018) (the first step in construing a MPF term is to determine its function, and the second step is to determine the corresponding structure). The second of these two related claim terms ("a chronological list of network devices connected to the network," hereafter "chronological list") comes into play because the patent defines "home network information"—which is part of the agreed function of "collation unit"—as the "chronological list" claim term, and, as Samsung demonstrates, the "chronological list" claim term is indefinite.

1. The Agreed Function Is Indefinite

The agreed function of the "collation unit" limitation expressly requires collation and storage of "home network information." Op. Br. at 31 (table stating "Agreed Function"). The claims expressly define "home network information" as "a chronological list of network devices connected to the network" (the second of these two related claim terms). '161 patent, 11:52-53 (claim 1: "home network information, which is a chronological list of network devices connected to the network"), 12:18-19 (claim 3: same), 12:59-61 (claim 6: same)). Importantly, the parties' experts agree the "chronological list" term has no plain meaning in the art apart from the patent. Ex. X, ¶ 37; Ex. V, 28:6-15. Maxell's "plain meaning" construction is thus clearly wrong.

When a term has no plain meaning in the art, its meaning must be found in the specification. *Irdeto Access v. EchoStar Satellite Corp.*, 383 F.3d 1295, 1300 (Fed. Cir. 2004). The "chronological list" term is indefinite because the specification includes conflicting and ambiguous statements that not even Maxell's expert can reconcile into a coherent explanation of what the term means. For example, "the network" in the "chronological list" term refers to the "home network," and the "Summary of the Invention" refers to the "home network to be managed at home," but Dr. Weissman asserts a home network nevertheless can include a local area network in an office building. '161 patent, 1:63-64; Ex. V, 9:10-17:23.

More fundamentally, the '161 patent fails to inform a POSITA with reasonable certainty as to whether the chronological lists illustrated in the patent are simply (1) "lists of device names in a particular order" (as Maxell now argues in its opening brief at p. 10) or instead are (2) chronologically ordered lists of *events* corresponding to network devices, and if so, what events must be included on the chronological list. Maxell's construction is broad and includes a list of ***device names*** in which each network device is listed ***only once*** regardless of how many times the device enters, leaves, or transmits a message on the network. Ex. V, 121:20-127:7. Maxell cites

Fig. 4 in purported support of this broad construction. Op. Br. at 35. But Fig. 4 lists each device ***multiple times***, and the specification describes Fig. 4 at col. 6:48-51 as a list of ***events*** (a list of log information indicating the order in which devices receive periodic "alive packets" from other devices) rather than as a list of device names. Indeed, Dr. Weissman admitted in deposition that the lists in Figs. 4 and 5 are network ***events***. '161 patent, 6:48-52; Ex. V, 38:18-39:6. Maxell's reliance on Fig. 4 and the passage of the specification at 6:48-51 therefore fails.

Maxell also cites paragraphs 56-59 of Dr. Weissman's declaration. Op. Br. at 35. Dr. Weissman posits that specification col. 6:36-42 provides "multiple examples of how home network information includes an ordering of items one after another based on network devices 'currently connected to the LAN 2' ***or*** 'were found to be connected to the LAN2.'" Ex. V, ¶ 59. But in deposition, Dr. Weissman first identified this passage as meaning something entirely different, *i.e.*, that his "best guess" was that this passage made some distinction between collecting home network information directly versus indirectly (a distinction that he could not articulate), and he then later admitted that "currently connected to the LAN 2 or were found to be connected to the LAN 2" simply reflects the temporal distinction that earlier entries on the list of Fig. 4 referred to past events whereas the later entries referred to current events. Ex. V, 56:1-57:21; 63:3-65:1. Thus, not even Maxell's expert can determine from the specification whether the chronological list term is a broad one that can include just one entry for each device on a network, or must be a list of network events in which devices can be listed more than once as shown in Figs. 4 and 5.

Moreover, even if the "chronological list" is a list of events, it still would be unclear which events the claim requires be on that list. In this regard, Dr. Weissman states the specification treats the "chronological list," "peripheral device information" and "home network information" as synonyms. Ex. V, 20:12-20; 22:15-23:17; '161 patent, 6:26-29. The specification describes three

types of the events as peripheral device information, network devices (1) joining/participating on the network, (2) leaving/departing from the network, and (3) periodically transmitting "alive" messages on the network. '161 patent, 4:65-5:34, 6:30-63; Ex. X, ¶¶ 40-47. Confusingly, col. 4:65-5:4 indicates (because it uses the term "for instance") that these types of events might be just examples of what might constitute peripheral device information, but col. 5:29-34 states that, rather than just being examples, all three of these types of events are to be recorded as peripheral device information: "[a]s mentioned earlier, the peripheral device information to be recorded includes the device information about the peripheral devices connected to the LAN 2 and the information indicating the participation of the peripheral devices in the LAN 2 and the departure of the peripheral devices from the LAN 2." Dr. Weissman admitted that the "as mentioned earlier" in this passage refers to col. 4:65-5:4 discussed above, which contradictorily suggests these are just examples. Ex. V, 99:19-100:15.

Another example of ambiguity is the specification identifying a UPnP "alive" message as an example of "peripheral device information" (which, as discussed above, Dr. Weisman equates with the "chronological list"). Ex. V, 130:2-4; '161 patent, 5:10-16, 6:43-48; Ex. X, ¶¶ 42-44. But if a single UPnP alive message—which does not represent an event and instead simply identifies the device—is an example of peripheral device information, that means a single UPnP alive message is a chronological list of network devices connected to the network. But when asked if the transmission of a single UPnP "alive" message constitutes a transmission of a "chronological list of network devices connected to the network" as recited in claim 1, Dr. Weissman denied it because an alive message only includes a single piece of information for the device. Ex. V, 132:18-133:1. This is another example of Maxell advancing an inconsistent argument.

The specification is also ambiguous because it does not make clear whether the

"chronological list" recorded by each device must include information about the device itself in addition to information about other devices. The specification teaches that each device must record information about itself at col. 5:16-18, but Dr. Weissman believes the patent indicates this is optional despite also admitting that without each device recording information about itself the match threshold would have to be set to zero (which would effectively disable whatever security might otherwise be realized through practice of claims, thereby defeating a primary objective of the patent as discussed at col. 2:24-29). Ex. V, 86:10-89:22

Accordingly, the specification does not provide sufficient information to allow a POSITA to determine the meaning of "home network information, which is a chronological list of network devices connected to the network"—a term with no plain meaning in the art—with the required reasonable certainty. The agreed function of the "collation unit" is therefore indefinite, and the "collation unit" term is thus indefinite regardless of whether sufficient structure is disclosed. *Intellectual Ventures I LLC v. T-Mobile USA, Inc.*, 902 F.3d 1372, 1381 (Fed. Cir. 2018); *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1369, n.4 (Fed. Cir. 2014).

2. The Specification Lacks Sufficient Corresponding Structure

The "collation unit" is a software-implemented MPF limitation, and Maxell does not dispute the specification must thus disclose an algorithm sufficient to enable a POSITA to provide an operative software program for the claimed function. *Typhoon Touch Techs. v. Dell, Inc.*, 659 F.3d 1376, 1385 (Fed. Cir. 2011). The specification fails to do so. As explained in detail by Dr. Shields, the specification describes the *result* of a collation of two trivial examples of chronological lists of network events shown in Fig. 5, but does not disclose the algorithm used to achieve the result, leaving a POSITA unsure how to perform the collation. Ex. X, ¶¶ 69-105.

Maxell asserts three "alternative algorithms" are disclosed at col. 5:62-6:29. Op. Br. at 32-33. This is incorrect. The third "algorithm" that Maxell contends is disclosed in this passage is

"checking whether the collated sets of peripheral device information exhibit the same tendency." Op. Br. at 32. When Dr. Weissman was asked to identify where in 5:62-6:27 the steps of an algorithm for doing so were disclosed, he could not. Ex. V, 108:17-109:6. Instead, he pointed to col. 8:42-52 as disclosing that algorithm. But when asked where an algorithm was disclosed in that passage, Dr. Weissman was again unable to do so, claiming instead that a POSITA would understand what needed to be done and "would know how to write such an algorithm." *Id*. at 110:16-112:14. But, as a matter of law, the fact that a POSITA would know how to write such an algorithm does not satisfy the requirement for disclosing structure in the specification—the algorithm must itself be disclosed in the specification. *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1382-85 (Fed. Cir. 2009) (rejecting plaintiff's argument that the specification's disclosure was sufficient because a POSITA could write a software program based upon information known in the art, where the specification did not disclose the particular structure).

The second "algorithm" Maxell argues is disclosed at col. 5:62-6:27 is "determining the degree of agreement between the collated sets of peripheral device information." Op. Br. at 32. Just as with the third "algorithm," no actual algorithm for doing so is disclosed in the cited passage. To the extent this passage refers to the discussion of collation in connection with Fig. 5, that discussion is inadequate for the reasons explained by Dr. Shields. Ex. X, ¶¶ 69-105.

And finally, with respect to the first "algorithm" allegedly disclosed at col, 5:62-6:27, "checking whether the collated sets of peripheral device information are identical with each other" (Op. Br. at 32), no steps for performing that algorithm are disclosed in that passage and neither Maxell nor Dr. Weissman identifies anything else in the specification that disclose such steps. Moreover, the so-called "further details" in paragraphs 88, 92, and 94 of Dr. Weissman's declaration discussed in Maxell's brief (Op. Br. at 33-34) are devoid of actual steps of a collation

algorithm (*e.g.*, step S704 of Fig. 7 simply states "compare information A and Information X to calculate a rate of agreement without specifying the steps for calculating the rate of agreement). Furthermore, paragraph 96 of Dr. Weissman's declaration referenced in Maxell's brief at page 34 discusses an unclaimed alternative embodiment that uses a listing of "network device connection status prevailing at a particular point in time" rather than a chronological list. Such a list cannot be chronological because it represents the connection status of all devices at the same point in time.

V. CONCLUSION

For the foregoing reasons, Samsung respectfully requests that the Court adopt its proposed claim constructions.

Dated: July 10, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on this 10th day of July, 2024, all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document by electronic mail.

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