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 SUR-REPLY CLAIM CONSTRUCTION BRIEF

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I. INTRODUCTION

Microsoft still fails to present any evidence or argument sufficient to overturn the constructions that were ordered by this Court previously, in *Proxense v. Samsung*, for each of the disputed terms. Instead, Microsoft misinterprets the intrinsic record and falsely accuses Proxense of misrepresenting that these claim terms were previously construed. They clearly were, as further demonstrated below. The Court should adopt Proxense's proposed constructions as they comport with the intrinsic record and the Court's prior construction of these terms.

II. CONSTRUCTION OF DISPUTED TERMS

A. Family A

1. "access message" (730:1, 15; 954, 1; 905:1)

Proxense's Construction	Microsoft's Construction
Adopts the Court's Construction in *Proxense v. Samsung*: A signal or notification enabling or announcing access	a message enabling access

Microsoft proposes a construction that both impermissibly excludes embodiments from the specifications and reads limitations into the claims. *Compare* Reply Br. at 2 *with Oatey Co. v. IPS Corp*., 514 F. 3d 1271, 1276 (Fed. Cir. 2008); *Paymaster Techs., Inc. v. United States*, 180 F. App'x 942, 949 (Fed. Cir. 2006) (concurrence). But when reading the plain language of the claims with respect to an "access message" and taking into account disclosed embodiments in the specification, the Court's prior construction is clearly proper since an "access message" enables access, announces access, or both.

Microsoft's proposed construction is contrary to basic claim construction principles. Courts "normally do not interpret claim terms in a way that excludes embodiments disclosed in the specification." *Oatey Co. v. IPS Corp*., 514 F. 3d 1271, 1276 (Fed. Cir. 2008). Likewise, it is a "well-established principle of claim construction that explicit limitations in one claim will not be read into another claim that does not include them." *Paymaster Techs., Inc. v. United States*,

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180 F. App'x 942, 949 (Fed. Cir. 2006) (concurrence). Claim 1 of the 730 Patent is describing the environment that the claims operate in such that the claimed method only requires receiving one or more messages from an agent wherein the agent is allowing access. *See also INVT SPE LLC v. Int'l Trade Comm'n*, 46 F.4th 1361, 1374-75 (Fed. Cir. 2022) ("the claimed device…operates in an environment that involves actions of another device"); *01 Communique Lab'y, Inc. v. LogMeIn, Inc*., 687 F.3d 1292, 1297 (Fed. Cir. 2012) ("[a]s a general rule, the words 'a' or 'an' in a patent claim carry the meaning of 'one or more.'") (internal citation omitted). Not only does Microsoft's construction read limitations into the claim, but it also excludes the disclosed embodiment in which the biometric key receives the access message to indicate to the user authentication has completed as to announce access or where multiple types of access messages are received and sent.

The shared specification presents embodiments in which the "access message" enables access, announces access, and both enables and announces access. For example, the system and method presented in Figures 3 and 4 disclose a message sent from the third party trusted authority to enable access to an application or resource. As shown in Figure 3, "a system for providing authentication information for a biometrically verified user … comprises an authentication module 310 in communication with biometric key 100, a trusted key authority 320, and an application 330". 730 Patent, 5:3-7. A "method 400 for authenticating a biometrically verified user using a trusted key authority (e.g., authority 320)" is shown in Figure 4. 730 Patent, 5:61-63. Figure 4 sets forth use of the "Biometric Key 100", "Authentication Module 310", and "Trusted Key Authority 320" and ends with "Allow[ing] Access To The Application" at step 470. "[A]uthentication module 310 serves as a gatekeeper to application 330 by requiring the code indicating successful biometric verification of the user prior to allowing access to the application." 730 Patent, 5:16-19. "The key performs biometric verification of the user 440… If biometric verification of the user is successful, the key provides its code over secure communication

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channels." 730 Patent, 6:22-25. "[A]uthentication module 310 provides the code to trusted key authority 320 in order to verify that it belongs to a legitimate key… Authentication module 310 can send a message to application 330, or otherwise allow access to the application responsive to successful authentication by trusted key authority 320." 730 Patent, 5:23-26; and *see also* 730 Patent, 6:28-31 ("Responsive to successful authentication of the key, access is allowed 470 to the application.").

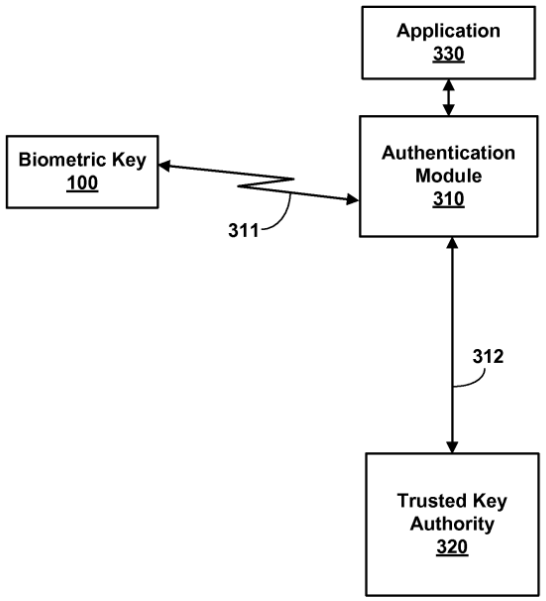

FIG. 3

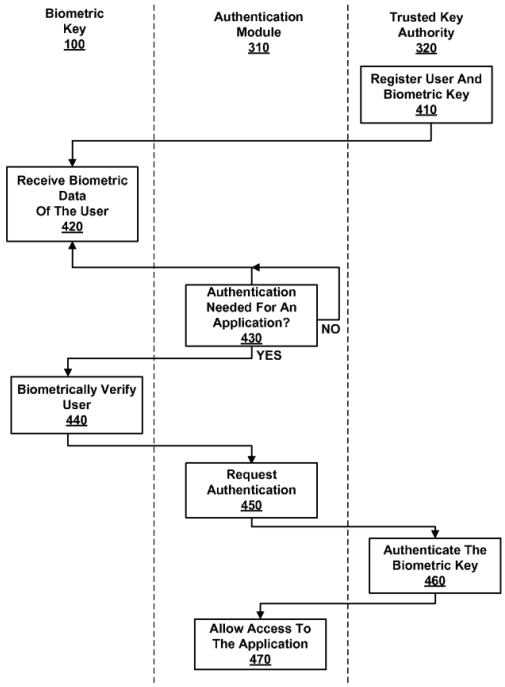

FIG. 4

In these embodiments, the access messages received by the application or authentication unit may enable access or both announce access and enable access. *See* 730 Patent, 6:28-31 ("Responsive to successful authentication of the key, access is allowed 470 to the application. In the slot machine example, a new pop-up window can be spawned to indicate successful age verification.").

In other disclosed embodiments, the message sent from the third party trusted authority is received by the biometric key to indicate successful authentication and thus announce access. 730 Patent, 3:33-34 ("In one embodiment, LED 130 can also confirm that user verification and/or authentication has completed.").

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Microsoft's proposed construction would thus exclude a claimed embodiment. Claim 1 of the 730 Patent does not specify the recipient of the access message—it does not mention whether the access message is received at an authentication unit, at an application, or at the biometric key. Rather, the claim only recites: "receiving an access message ***from the agent allowing the user to access an application***." 730 Patent, Claim 1 (emphasis Added). Notwithstanding this language and the disclosed embodiments in the specification, Microsoft argues that the Court should abandon its previous construction and interpret "allowing the user access to an application" as modifying the received "access message" rather than the agent from which the access message is received. All the claim requires is receiving an "access message."

Aside from excluding various embodiments, Microsoft's construction would also artificially import limitations from claim 15 of the 730 Patent and/or claim 1 of the 954 Patent into claim 1 of the 730 Patent. Claim 15 of the 730 Patent recites "**the authentication unit** receiving an access message from the agent allowing the user to access the application." Likewise, claim 1 of the 954 Patent recites "receiving, **at an application**, an access message from the trusted authority", thereby also limiting the access message to one enabling or enabling and announcing access. Importing these additional limitations into claim 1 of the 730 Patent would impermissibly exclude the disclosed embodiment in which the biometric key receives an access message announcing access.

2. "wherein the biometric data and the scan data are both based on a fingerprint scan by the user" (730:5)

Proxense's Construction	Microsoft's Construction
Adopts the Court's Construction in *Proxense v. Samsung*: No construction needed, plain and ordinary meaning	Invalid under §112 ¶4

Rather than present a cogent argument, Microsoft incorrectly alleges that Proxense "misrepresents this Court's order from *Proxense-Samsung*, presenting ***Proxense's arguments*** as

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if it ***was the Court's opinion***." Reply Br. at 10 (emphasis in original). Microsoft asserts that Proxense's citation to the Court's opinion "comes from the Court's description of Proxense's argument, not the Court's holding." *Id*. at 11. But had Microsoft read the full order, it would have realized that Proxense cited to the "The Court's Analysis" section of the claim construction opinion, not "The Parties' Positions" section. The relevant portion of "The Court's Analysis" section on page 24 is reproduced below with the part cited by Proxense emphasized in bold italics:

> The Court, however, finds that no construction is necessary for this term and that it should receive its plain and ordinary meaning. Claim 5 of the '730 Patent ***properly narrows the scope of "biometric data" to a single "fingerprint". The plain and ordinary meaning of "palm print" would be understood to include some combination of prints from the heel and/or flat of the hand, with multiple fingerprints and/or a thumb print (see, e.g., 730 Pat. 3:4–11, expanding exemplary biometric data from "fingerprint" to additional metrics like an entire "palm print"; id. at 3:29–33, indicating that biometric data capture could include thumb or other fingerprints)***.

Substantively, the parties' dispute for this term comes down to whether a "fingerprint" is a subset of a palm print or hand geometry. This determination has already been made by this Court which found that claim 5 "properly narrows the scope of 'biometric data' to a single 'fingerprint'" and that the plain and ordinary meaning of "palm print" would be understood to "include some combination of prints from the heel and/or flat of the hand, with multiple fingerprints and/or a thumb print." *Proxense v. Samsung*, ECF 149 at 24. This determination is supported at least by the FBI's definition of "palm print," which is the "area extending from the top of the wrist bracelet to the tips of the fingers" as illustrated in the figure below:

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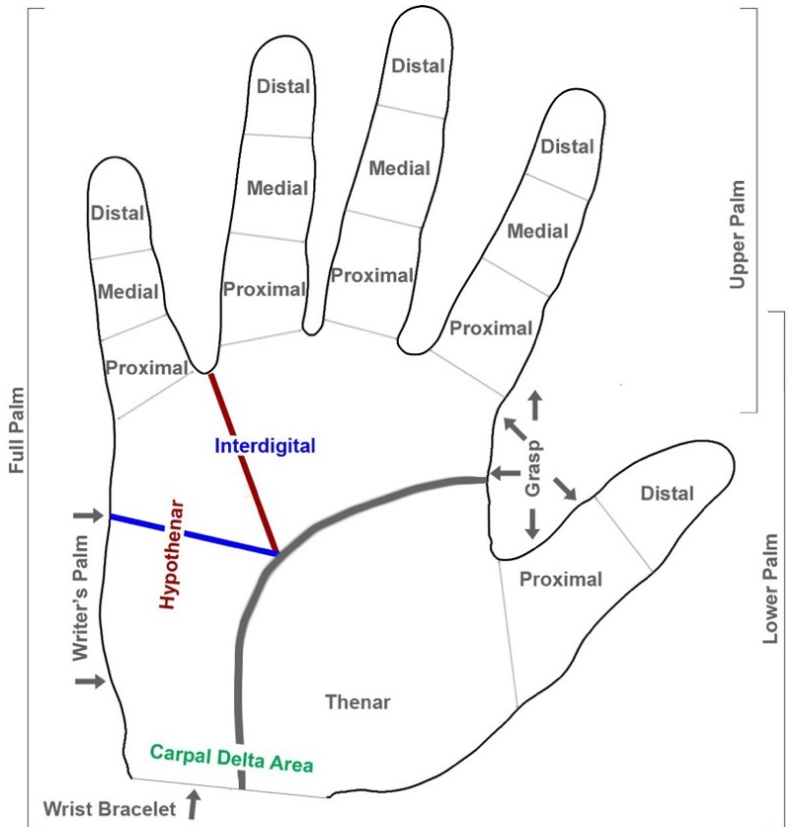

Ex. A at 2. The U.S. Department of Justice also supports this plain and ordinary meaning via a 2004 document titled "Fast Capture Fingerprint/Palm Print Technology." That reference states that a palm print includes "the entire palmar friction ridge skin area, including the extreme sides of the palms and the ***extreme tips, sides, and lower joints of the fingers***." Ex. B at 6 (emphasis added). Accordingly, a POSITA would understand that a "fingerprint" is a subset of a palm print or hand geometry.

In its reply, Microsoft argues that the Family A patents "repeatedly and consistently distinguish 'fingerprint' from 'palm print' and 'hand geometry.'" Reply Br. at 6. That is incorrect. The patents simply list **examples** of biometric data which can include a fingerprint, palm print, geometry, and other types of biometric data for "other embodiments within the spirit of the present invention [that] can perform biometric verification." 730 Patent 3:4-11; 954 Patent 3:58-65; 905 Patent 3:60-67. The patents do not explicitly contradict the plain and ordinary meaning of "palm print" or disavow a fingerprint from being a subset of a palm print or hand geometry. *See Teleflex,*

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Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1325 (Fed. Cir. 2002) ("The patentee may demonstrate an intent to deviate from the ordinary and accustomed meaning of a claim term by including in the specification expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope."); *see also Home Diagnostics, Inc. v. LifeScan, Inc.*, 381 F.3d 1352, 1358 (Fed. Cir. 2004) ("Absent a clear disavowal or contrary definition in the specification or the prosecution history, the patentee is entitled to the full scope of its claim language.").

Further, the extrinsic evidence Microsoft cites in its Ex. G does not controvert the plain and ordinary meaning of "palm print" as that reference does not teach that a fingerprint is **not** a subset of a palm print. In fact, Figure 8-5 from Ex. G supports a "palm print" as including fingerprints by showing a person placing their palm, ***which includes their fingers***, on a "palm reader" or scan:

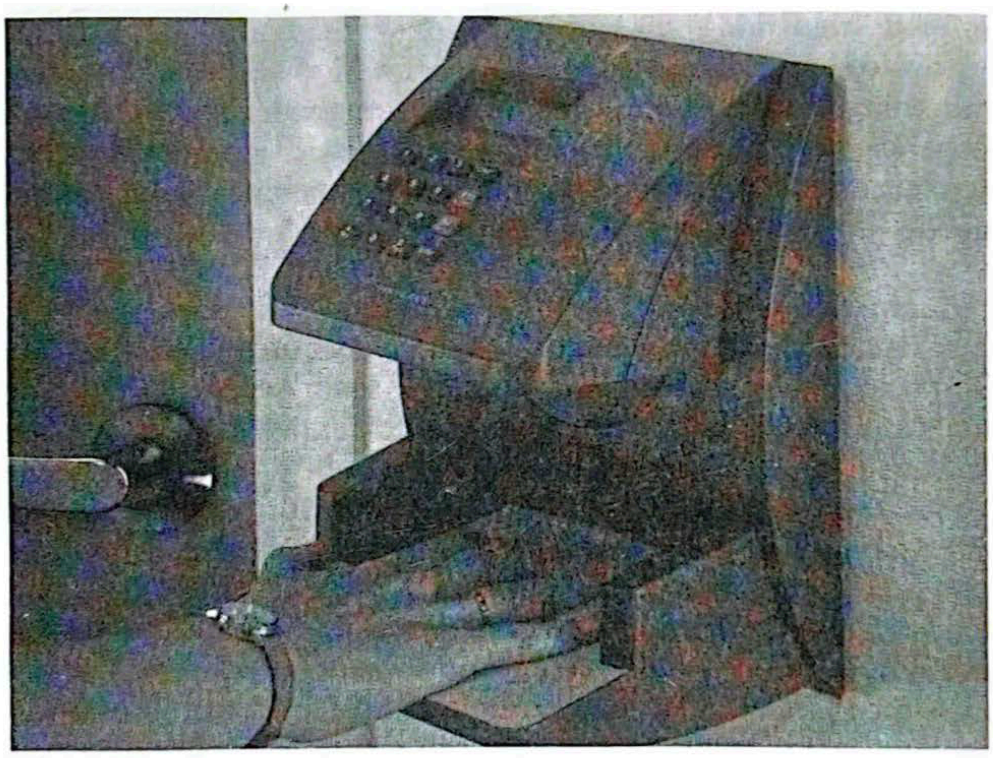

Figure 8-5. Palm reader. Reprinted with permission. IR Safety and Security-Americas Copyright 2003. All Rights Reserved

Microsoft also attempts to confuse the plain and ordinary meaning of "palm print" by citing

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dictionary definitions for the word "palm." However, those dictionary definitions are irrelevant as they are not in the context of the Family A Patents' invention, which relate to biometric data such as a "palm print." As well, Microsoft's attempt to dismantle the actual term into separate components not appearing in the claims via a dictionary reference is disfavored by Courts. *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 784, 791 (Fed. Cir. 2021) ("[W]e note that it is not always appropriate to break down a phrase and give it an interpretation that is merely the sum of its parts."); *see also Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999) ("Proper claim construction . . . demands interpretation of the entire claim in context, not a single element in isolation.").

In addition, Microsoft cites cases that it alleges to counter the presumption that "an examiner would not introduce an indefinite term into a claim when he/she chooses to amend the claim for the very purpose of putting the application in a condition for allowance" when performing an Examiner's Amendment. *Tinnus Enterprises, LLC v. Telebrands Corp.*, 733 F. App'x 1011, 1020 (Fed. Cir. 2018). However, the cases are immaterial; they do not involve an Examiner's Amendment *nor* provide ways in which an Examiner Amendment's presumption of validity can be refuted. Accordingly, these cases and Microsoft's attempt to rebut this presumption should be disregarded.

There is no need for the Court to re-construe this term. Microsoft has not shown any evidence—intrinsic or extrinsic—that suggests that a POSITA would *not* understand "'palm print' . . . to include some combination of prints from the heel and/or flat of the hand, with multiple fingerprints and/or a thumb print." *Proxense v. Samsung*, ECF 149 at 24. Accordingly, the scope of claim 5 is readily understood by a POSITA and is not indefinite.

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B. Family B

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

Microsoft again makes a false accusation *in lieu* of an argument and alleges that Proxense deleted words from "The Parties' Position" section of the *Proxense v. Samsung* Claim Construction Opinion to "repackage its argument as the Court's holding." Reply Br. at 13. Not so. Proxense again cited directly from "The Court's Analysis" section on page 30 of its Opinion – *not* from "The Parties' Position" section. The relevant portion of "The "Court's Analysis" section on page 30 is reproduced below with the part cited by Proxense emphasized in bold italics:

> The Court finds that "personal digital key" should be construed as "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." This construction properly reflects the patent's recitation of the elements comprising a personal digital key, which can be an operably connected collection of components integrated into a hybrid device, such as a cell phone. Several examples from the specification show that Samsung's construction is incorrect. In such embodiments where the hybrid device/PDK function is integrated into a cell phone (e.g., with a SIM card), ***the transceiver and/or antenna of the PDK is provided by the cell phone, and the memory and controller of the PDK are provided by the SIM card.***

On the merits, Microsoft's position here is self-contradictory. Microsoft's reply states that the PDK "need not be [a] 'stand-alone'" device, ***but then*** argues for its construction to be a "device." Reply Br. at 12. Microsoft cannot have it both ways. An acknowledgement that the PDK need not be a stand-alone device comes with the understanding that elements of the PDK can be provided by other components, such as a cell phone or SIM card, as disclosed in the specification. In embodiments where the hybrid device/PDK function is integrated into a cell phone (e.g., with

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a SIM card), "the transceiver and/or antenna of the PDK is ***provided by the cell phone***, and the memory and controller of the PDK are ***provided by the SIM card***." *Proxense v. Samsung*, ECF 149 at 30 (emphasis added). Thus, ***all elements*** of the PDK need not be integrated into another product as a prepackaged, stand-alone "device."

Microsoft next argues that "Proxense cites no affirmative evidence to support its construction" and that "[n]othing in the '042 Patent states or suggests that a PDK is a 'collection of elements.'" Reply Br. at 13. That is incorrect. Specifically, Proxense's construction is pulled directly from the specification in that the PDK has at a minimum "an antenna and a transceiver for communicating with a RDC (not shown) and a controller and memory for storing information particular to a user." 042 Patent 13:46-49. With respect to the "collection of elements" part of its construction, Proxense already detailed the support found within the specification. *See* Resp. Br. at 11. For example, the specification explains that the function of a PDK can be implemented in a cell phone where a "hybrid device" has the form factor of a SIM card, and "is merely inserted in place of a conventional SIM card to provide this functionality." 042 Patent 14:24-32. In another example, the PDK function can become part of a cell phone by connecting via "internal integration or an access port," such that the transceiver and antenna of the PDK are again those of the cell phone into which it is integrated, that is, "the PDK function becomes part of the cell phone" and "the PDK enabled phone uses the back channel to perform other validation/update functions via the cellular infrastructure." 042 Patent 15:40-52.

In sum, Microsoft presents a construction for "personal digital key" that is identical to the one this Court ***rejected*** in *Proxense v. Samsung* but does not provide any new credible evidence or argument that would justify departing from the Court's prior construction. Accordingly, Proxense respectfully requests that the Court adopt its prior construction from *Proxense v. Samsung*.

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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

Microsoft's main argument in its reply is that the RDC should be construed as a "circuit" instead of a "component or collection of components" because the word "circuit" is part of the term. Reply Br. at 14. That is not a compelling argument that justifies disturbing the Court's prior construction of the term in *Proxense v. Samsung*, especially because a POSITA would recognize that a circuit, in this context, is a "component or collection of components."

Microsoft's "circuit" argument appears to be yet another self-serving attempt to obtain a construction in line with its primary non-infringement position that the RDC is a "single entity" or a "discrete entity, rather than a collection of components." Op. Br. at 19 ("The embodiments of RDC in the specifications of the '042 and '289 Patents also show that an RDC is ***a single entity (a circuit)*** rather than a collection of components.") (emphasis added). But again, this Court already rejected Microsoft's argument, finding that a construction that attempts to limit the RDC to a singular device would be "overly limiting" in view of the multiple examples in the specification that do not require the RDC to be a distinct, solitary device. *Proxense v. Samsung*, ECF 149 at 38. Proxense respectfully requests that the Court adopt its prior construction in *Proxense v. Samsung*.

III. CONCLUSION

For the foregoing reasons, the Court should adopt Proxense's proposed constructions.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I, David L. Hecht, hereby certify that on December 27, 2023, I served a true and correct copy of the foregoing **PLAINTIFF PROXENSE, LLC's SUR-REPLY CLAIM CONSTRUCTION BRIEF** and all ancillary documents attached thereto to counsel of record via ECF.

/s/ David L. Hecht
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