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*.	Case No. 5:23-cv-00092-RWS **JURY TRIAL DEMANDED**

PLAINTIFF MAXELL, LTD.'S
OPENING CLAIM CONSTRUCTION BRIEF

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I. INTRODUCTION

Maxell's proposed constructions provide interpretations that are consistent with the plain and ordinary meaning of the terms. In contrast, Samsung fashions constructions inconsistent with the terms' plain meaning, attempting to unduly narrow the claim scope by excluding disclosed embodiments or unjustifiably importing limitations from the specification. "There are 'only two exceptions to [the] general rule' that claim terms are construed according to their plain and ordinary meaning: '(1) when a patentee sets out a definition and acts as his own lexicographer, or (2) when the patentee disavows the full scope of the claim term either in the specification or during prosecution.'" *Maxell Ltd. v. Huawei Device USA Inc.*, 297 F. Supp. 3d 668, 679 (E.D. Tex. 2018) (internal citations omitted). Neither exception is present here. Yet, Samsung seeks to construe terms such as "character," "user profile," "enabled/disabled," and "transmission frequency band," not to discover the proper construction of the terms, but to further its non-infringement and invalidity agenda. This approach is improper. "A claim is construed in the light of the claim language, the other claims, the prior art, the prosecution history, and the specification, *not* in light of the accused device. . . claims are not construed 'to cover' or 'not to cover' the accused device." *See SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1118 (Fed. Cir. 1985) (emphasis in original). Thus, Samsung's proposals should be rejected, and Maxell's adopted.

II. SUBJECT MATTER OF THE ASSERTED PATENTS

The asserted patents generally fall into six areas of technology: video recording/management systems for user dedicated video playlist organization (11,017,815 ("the '815 Patent")), voice/touch activated camera control and photography (11,223,757 ("the '757 Patent")), video transmitting and receiving apparatus with multiple wireless communication circuits (10,129,590 ("the '590 Patent") and 11,445,241 ("the '241 Patent")), smart home network (8,037,161 ("the '161 Patent")), portable terminal implementing enhanced security based on touch

operations (8,982,086 ("the '086 Patent")), and image processing including face detection and reproduction of images based on the face detection (10,176,848 ("the '848 Patent")). Additional descriptions of the patents are provided in Section IV.

III. LEGAL STANDARDS

This Court knows well the legal standards governing claim construction. *See, e.g.*, *Maxell*, 297 F. Supp. 3d at 677-681; *see also Maxell Ltd. v. Apple Inc.*, Case 5:19-cv-0036 (E.D. Tex. 2019) (Dkt. No. 136). As such, Maxell will not recount those principles for the Court here, but will rely on authority where appropriate in discussions for the terms below.

IV. DESCRIPTION OF THE ASSERTED PATENTS AND THE PROPER CONSTRUCTION OF THE DISPUTED TERMS

A. <u>The '815 Patent</u>

1. Background of the '815 Patent

The '815 Patent, which has a priority date of December 2, 2004, is directed to improving the storing, management, and reproduction of digital data in an information processing apparatus. *See* Decl. Karan Sher Singh ("Ex. 1") ¶ 29 (citing the '815 Patent, 2:63-3:6). Specifically, at the time the '815 Patent was filed, while systems existed to allow a user to group digital data in a playlist, those "playlists were not optimized for multiple users." *Id.* ¶ 30 (citing '815 Patent, 2:28-47). For example, different users "could not customize their views with select playlists and programs." *Id.* The '815 Patent solved these problems by providing an information processing apparatus using which a user can select and manage playlists using hierarchical levels of information management and using user-dedicated folders/storage on the same device. *Id.* ¶¶ 31-34 (citing the '815 Patent, 2:35-39, 6:25-40. Figs. 4-7). In particular, the '815 Patent discloses generating readily understandable user interfaces using display tags or characters and multiple segregated display areas to allow multiple users to organize, store, and reproduce digital content

within their playlists on the same device. *Id.* Thus, "when a plurality of users use a single recording medium, it becomes possible to manage reproduced contents that meet respective users' tastes by using one user-defined unified information every user." *Id.* ¶ 34 (citing the '815 Patent, 4:35-39).

2. Level of Ordinary Skill in the Art for the '815 Patent

For the '815 Patent, a person of ordinary skill in the art ("POSITA") has a working knowledge of user interfaces and/or content management systems, gained through a Bachelor of Science in Electrical Engineering or an equivalent degree and one year of experience in the field of user interfaces and/or content management systems.

3. Disputed Terms in the '815 Patent

a) "the processor generates a group of video information based on user preferences determined by the user selections of the video information"

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

Where the ordinary meaning of claim language is readily understood by one of ordinary skill in the art, claim construction "involves little more than the application of the widely accepted meaning of commonly understood words." *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (*en banc*). In these situations, no construction is needed. *U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997). This is the situation here because, in plain English, this term identifies a component—processor—with the capability to perform a function—generating a group of video information—based on a condition—user preferences determined by the user selections of the video information. The intrinsic evidence also supports plain and ordinary meaning because, consistent with the claim language, it discloses the concept of "a plurality of

users desire to **generate, select and manage** respective **favorite play list** information pieces" and to "provide a recording and reproducing device in which the user can select and manage arbitrary playlists" such that "when a plurality of users use a single recording medium, it becomes possible to manage reproduced contents that meet respective users' tastes by using one user-defined unified information every user."[1] *See* '815 Patent, 2:41-52, 4:35-29; *see also* Ex. 1 ¶¶ 52-56 (explaining that the patent discloses the ability of multiple users, such as "mother" and "father" to select video information and generate playlists). The fact that Samsung itself agrees that this term should be given its "plain and ordinary meaning" (Dkt. No. 66 at 24), should settle the dispute and the Court should hold that no construction is necessary. *See Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001) ("unless compelled to do otherwise, a court will give a claim term **the full range of its ordinary meaning** as understood by an artisan of ordinary skill"); *see also Nitride Semiconductors Co., v. Lite-On Tech. Corp.*, No. W-21-CV-00183-ADA, 2022 WL 17347782, at *3, 7 (W.D. Tex. Nov. 30, 2022) (proper construction is the plain and ordinary meaning where defendants argued that their proposed construction was consistent with the ordinary meaning).

Instead, Samsung is seeking to avoid liability of infringement via the *Markman* process (*see* Dkt. No. 66 at 24-25) by rewriting a twenty-one word claim element into a sixty-plus word, three-part narrowed claim element rife with unnecessary adverbs and temporal and negative limitations. This is nonsensical because "a party wishing to alter the meaning of a clear claim term must overcome the presumption that the ordinary and accustomed meaning is the proper one, **demonstrating why such alteration is required**." *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1362-63 (Fed. Cir. 1999). Samsung cannot overcome such a presumption because it has not identified any intrinsic evidence to support its construction, let alone the presence of lexicography,

[1] All instances of **bold** correspond to emphasis added by Maxell.

disavowal, or disclaimer. *See Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012); *see also Maxell*, 297 F. Supp. 3d at 735, 709 (finding a construction of plain and ordinary meaning because Defendant had "not identified language of lexicography, disavowal, or disclaimer").

Samsung's approach to claim construction in its *inter partes review* (IPR) petitions also supports a finding that no construction is necessary, and further exposes Samsung's intention of construing the term against the accused products to avoid infringement. Although there are no limits on number of terms proposed for construction in IPR proceedings, Samsung seeks no construction for this term in the two IPR Petitions that it has filed for the '815 Patent. *See* IPR2024-00735, Petition ("Ex. 2") at 18-22 and IPR2024-00777, Petition ("Ex. 3") at 5-9.

In sum, there is no justification to expand a plainly written claim element to add unnecessary excess verbiage. *See DSW, Inc. v. Shoe Pavilion, Inc.*, 537 F.3d 1342, 1347 (Fed. Cir. 2008) ("[A]bsent contravening evidence from the specification or prosecution history, plain and unambiguous claim language controls the construction analysis"). Accordingly, Samsung's proposed construction should be rejected.

b) "character"

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

The same is true for "character." As Maxell's expert confirmed, it is a readily understood term, and no construction is needed. *See* Ex. 1 ¶¶ 42-45; *see also Phillips*, 415 F.3d at 1314; *see also U.S. Surgical*, 103 F.3d at 1568. The claims and specification of the '815 Patent also indicate no deviation from "character's" plain and ordinary meaning. For example, the claims recite that a display displays "a first area including a first character associated with a first group of video information . . . and a second character associated with a second group of video information . . . ."

See '815 Patent, Claims 1, 21. The specification then discloses display areas in Figures 4-7 that display "tags" and "menu display tags" including characters such as "ALL PROGRAMS, "ALL PLAYLISTS," "MOTHER," and "FATHER." *See id.* at Figs. 4-7; *see also* Ex. 1 ¶ 46 (citing '815 Patent, 6:14-18, and explaining the specification provides description of "character" consistent with the plain and ordinary meaning).

Extrinsic evidence also confirms that the '815 Patent uses the term "character" consistent with its plain and ordinary meaning. *See* Ex. 1 ¶ 43 (Dr. Singh providing dictionary definitions of "character" from McGraw-Hill Dictionary of Scientific and Technical Terms (Ex. 4), Dictionary of Multimedia (Ex. 5), and Newton's Telecom Dictionary (Ex. 6)). Each of the dictionary definitions confirm that character has a plain and ordinary meaning consistent with the usage in the '815 Patent claims and specification, and no construction is necessary.

Samsung's own conduct confirms that "character" needs no construction. For example, in its own Patent directed to a "Character Input Apparatus," Samsung uses the same terminology as in the '815 Patent. *See e.g.,* U.S. Patent No. 9,342,238 (Ex. 7), claims 1, 12 (reciting "touch display screen . . . configured to display **characters**," "displaying the first character," and "displaying the **second character**"); *see also* Ex. 7 at 8:13-16 ("characters may, for example, be . . . characters, symbols, figures, and numbers"). Also, like with the above term, Samsung did not seek any construction for this term in its IPR Petitions. *See* Ex. 2 at 18-22 and Ex. 3 at 5-9. Moreover, the same Samsung expert—Dr. Bederson—that opines here that a construction is necessary, applied the plain and ordinary meaning to character for his analysis. IPR2024-00777, Decl. Benjamin Bederson ("Ex. 8") ¶ 72. Samsung cannot overcome the presumption that the ordinary and accustomed meaning of character is the proper one because there is no evidence of lexicography, disavowal, or disclaimer. *See Thorner*, 669 F.3d at 1365; *Maxell*, 297 F. Supp. 3d at 735.

Samsung's proposed construction is improper because it unduly narrows the claim scope.

Samsung attempts to improperly narrow the term "character" by adding superfluous language such as "one unit of information," and "control code." The '815 Patent, however, does not recite any of "one unit," "unit of information," or "control code." Samsung's expert also confirms that characters can be displayed with multiple bytes of information and can even include emojis. *See* Bederson Dep. Tr. ("Ex. 9") at 49:19-50:18 (testifying that "like other symbols" emoji would be considered a character). There is no justification to inject such terminology into the '815 Patent claims. Thus, "character" requires no construction, and Samsung's proposal should be rejected.

c) "receiving . . . first video information . . . including second video information that is encrypted"

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

The term "receiving . . . first video information . . . including second video information that is encrypted" is readily understandable. Samsung's own expert agrees. Ex. 9 at 28:6-15 (testifying that he does not have an opinion on lexicography, "the words in this claim term are simple . . . a POSITA would understand their meaning from their plan and ordinary meaning.") Yet, Samsung again attempts to append unnecessary language into its construction to unduly narrow the claim. Samsung identifies no intrinsic evidence to support its narrowing, thus admitting that there is no lexicography, disavowal, or disclaimer. (Dkt. No. 66 at 14-15). *See Maxell*, 297 F. Supp. 3d at 735. Samsung admits that this term should be given its plain and ordinary meaning, and, like with "character," Samsung and its expert seeks no construction for this term in its IPR Petitions. *See* Ex. 2 at 18-22; *see also* Ex. 3 at 5-9; Ex. 8 ¶¶ 72-81. Thus, Samsung's own conduct belies its proposed construction.

Samsung's proposed construction is improper because it: (1) rearranges the claim terms; and (2) includes a temporal limitation of "at the time." First, Courts do not rewrite the claim

language by rearranging existing claim terms. *See K-2*, 191 F.3d at 1364 ("[c]ourts do not rewrite claims; instead, we give effect to the terms chosen by the patentee"); *see also Synqor, Inc. v. Cisco Sys.*, No. 11-cv-54, 2014 WL 1338712, at *11 (E.D. Tex. Jan. 2, 2014) ("[c]onsidering Defendants' construction generally rewords the claims and in light of the acknowledgements of the parties, the Court finds these terms need no construction at this time"); *Dogleg Right Partners, LP. V. Taylor Made Golf Co.*, No. 07-cv-533, 2011 WL 1100145, at *12 (E.D. Tex. Mar. 22, 2011) (holding that a construction that merely rewords claims "will not assist the jury").

Second, the claims of the '815 Patent do not recite the term "at the time," and Samsung's attempt to inject this temporal limitation into the claims with no support in the record should be rejected. Samsung's position is also internally inconsistent with its expert. While Samsung argues that "at the time" should be added to the claim language, its expert argues that receiving video information in encrypted form is nowhere to be found in the '815 Patent's file history. *See* Decl. Benjamin Bederson ("Ex. 10") ¶ 34. Thus, Samsung seems to be advocating for a construction for which its expert is arguing that there is no written description support. This is nonsensical.

In sum, this term, like the terms before it, does not require any construction, and Samsung's proposed construction should be rejected.

d) "being deleted from the first group of video information"

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

Similarly, no construction is necessary for "being deleted from the first group of video information" because the plain language of this term is readily apparent. For example, claims 1 and 9 recite that "upon 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 deleted** from the first group of video information, the one video information **continues to be included** in the

second group of video information." '815 Patent, Claims 1, 9. Thus, conveying to a POSITA that when one video information is deleted from the first group of video information, it continues to be included in the second group of video information. The claim's plain language is also consistent with the language in the '815 Patent, which states that the mother and father can "freely register and **delete** data to be reproduced" from the folders "dedicated" to themselves. *Id.* at 6:25-40.※

Thus, claims of the '815 Patent and specification consistently use the term "delete" to indicate that data can be deleted from a group of video information and rewriting these terms based on Samsung's whims would be contrary to the canons of claim construction. *See K-2*, 191 F.3d at 1364 ("[c]ourts do not rewrite claims; instead, we give effect to the terms chosen by the patentee"); *see also Synqor,* 2014 WL 1338712, at *11.

Like it does with the preceding three terms, Samsung proposes a construction which includes terminology such as "reversing" or "unregistering" found nowhere in the intrinsic record. Samsung's sole reason for proposing this construction is a statement by the PTAB in an IPR proceeding addressing a different claim of a related patent under a **different** claim construction standard. In particular, the PTAB stated: "**under the broadest reasonable interpretation** standard, we determine that 'delet[ing]' video information from the first group includes reversing a registration (*i.e.*, unregistering) of video information from the first group." IPR2018-01432, Paper 32 (Ex. 11) at 14-15. But the PTAB also stated that its interpretation does not **exclude** deleting; it just "does not **necessarily** require deleting underlying AV data." *Id.* Thus, the PTAB provided a construction that is also inclusive of deletion but because it is under a broader standard, it goes beyond the plain and ordinary meaning of the terms. This Court, however, is not bound by this construction. *See SkyHawke Techs., LLC v. Deca Int'l Corp.*, 828 F.3d 1373, 1376 (Fed. Cir. 2016) (holding that the PTAB's claim construction decision was not binding on the trial court);

see also GREE, Inc. v. Supercell Oy, No. 2:19-cv-00071-JRG-RSP, 2020 WL 2476497, at *7 (E.D. Tex. May 12, 2020) (same).

Applying *Phillips*, the Court should reject Samsung's proposed construction and hold no construction is necessary.

e) "the first group of video information being configured to allow a user to edit"

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

Despite Samsung arguing that this term is indefinite, its own expert admits that in the context of the '815 Patent, he is "reasonably certain" as to the meaning of this term. Ex. 10 ¶ 62; *see also* Ex. 9 at 56:11-57:11 ("I think it's reasonably certain that a POSITA would understand [this claim term] in the way that I explained.") Samsung also had no issue applying this term in its IPRs. *See* Ex. 2 at 18-22; Ex. 3 at 5-9. This should end the inquiry because the claim term is "reasonably certain" to a POSITA. *See Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014); *see also Howmedica Osteonics Corp. v. Tranquil Prospects, Ltd.*, 401 F.3d 1367, 1371 (Fed. Cir. 2005) ("[t]he definiteness of a patent claim depends on whether one skilled in the art would understand the bounds of the claim when read in light of the specification.")

This term "simply denotes providing an apparatus that has the capability to allow a user to edit a group of video information, such as, adding or deleting video information from a group or a playlist." Ex. 1 ¶ 50. For example, claim 1 recites "[a]n information processing apparatus comprising . . . a processor for controlling the display to display: a first area including a first character associated with **a** first group of video information . . . , **the** first group of video information being configured to allow a user to edit." *See* '815 Patent, Claim 1. Samsung is expected to argue that it is unclear on whether this claim limitation requires editing of video information **or** the first group of video information itself. But, the claim specifically uses

antecedent basis to recite "the first group of video information" when claiming the concept of allowing a user to edit, not "the video information." There is no ambiguity.

The specification of the '815 Patent further underscores this unambiguous understanding. As an example, the '815 Patent discloses that a "user's editing manipulation" includes adding audio-video data and/or increasing or decreasing programs in a playlist, *i.e.*, group of video information. Ex. 1 ¶¶ 52-53 (citing '815 Patent at 2:8-14, 3:66-4:5). The '815 Patent also explains that "user #1" (*e.g.*, mother) "can use the menu display tag for mother 601 as a folder dedicated to herself, and freely **register** and **delete data** to be reproduced" by adding or deleting data from a folder dedicated to the user. '815 Patent, 6:21-28; *see also* Ex. 1 ¶ 54. An additional example of "first group of video information being configured to allow a user to edit" is disclosed to be a user (*e.g.*, father) altering reproduction sequence of playlists. Ex. 1 ¶ 55 (citing '815 Patent at 6:31-40, Figs. 6-7). Thus, reading the claims and the patent, a POSITA would understand with reasonable certainty that the plain and ordinary meaning of this term simply describes an information processing apparatus that has the capability to allow a user to edit first group of video information by, *e.g.*, adding data, deleting data, and/or rearranging data within that group. Ex. 1 ¶¶ 51-55.

Accordingly, Samsung's indefiniteness argument should be rejected, and the term should be accorded its plain and ordinary meaning.

f) "user profile" / "user profiles"

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

Like the term "being deleted from the first group of video information," Samsung takes a term readily understood to a POSITA—user profile—and alleges that the term is indefinite. Samsung's own conduct and extrinsic evidence contradicts its contention. For example, Samsung identifies numerous dictionary definitions confirming that the term "user profile" was well-

understood. *See* Dkt. No 66 at 22-24 (identifying consistent definitions of "user profile" from three different dictionaries); *see also* Ex. 1 ¶¶ 59-63 (Dr. Singh identifying the same). Further, in both IPR petitions concerning the '815 Patent, Samsung proposed a construction of "user profile(s)" under the same claim construction standard as this Court, thus admitting that this term would be readily understandable to a POSITA. *See* Ex. 2 at 22; *see also* Ex. 3 at 8 ("[t]hese limitations should be construed as requiring data representing distinctive features and characteristics of a user.") Moreover, as explained by Dr. Singh, Samsung has used the term "user profile" in its own patents. *See* Ex. 1 ¶ 64 (citing to U.S. Patent Nos. 8,176,068 (Ex. 12) and 8,843,467 (Ex. 13) and explaining Samsung's use of user profile consistent with the term's plain and ordinary meaning).

Samsung is also expected to argue that this term is indefinite because "user profile" is not included verbatim in the specification. But this is not sufficient for a finding of indefiniteness. *See Capital Sec. Sys., Inc. v. NCR Corp.*, 725 F. App'x 952, 956-57 (Fed. Cir. Mar. 7, 2018) ("although the term . . . does not appear verbatim in the specification, the term is not indefinite when considered in the context of the claims and the specification"). In particular, as explained by Dr. Singh, while the specification does not use the term "user profile," it discloses user "dedicated" folders where each user can store its playlists according to his/her preferences. Ex. 1 ¶¶ 70-72 (citing the '815 Patent, 6:21-40 and Figs 1, 6-7 where "mother" and "father" are shown to have user dedicated folders supporting their profiles). Further, the '815 Patent also discloses that these user dedicated folders are possible by the use of hierarchical data directories with a "Root" directory followed by "user-defined unification information" and "contents of user-defined information" grouped to "meet respective users' tastes by using one user-defined unified information [for] every user." *See* '815 Patent, 4:35-39; *see also* Ex. 1 ¶¶ 74-76 (citing to Figs. 8 and 9 and corresponding descriptions to show how the '815 Patent discloses the concept of a user profile consistent with the usage of root directories and folders used to implement user profiles by

a POSITA in Windows NT at that time). Indeed, these disclosures in the '815 Patent also meet Samsung's IPR construction of "user profile" because the '815 Patent discloses a requiring data representing distinctive features (*e.g.*, dedicated folders for mother and father implemented with user-defined information) and characteristics of a user (*e.g.*, names of the user (*e.g.*, mother/ father)).

Thus, POSITA would have understood that the '815 Patent discloses the implementation and usage of user profiles to manage playlists by a "father" and "mother" in user dedicated folders and, therefore, would have understood the "bounds of the claim" with reasonable certainty. *Howmedica*, 401 F.3d at 1371. Accordingly, "user profile" is not indefinite.

B. <u>The '757 Patent</u>

1. Background of the '757 Patent

At the time of the priority date of the '757 Patent, September 12, 2013, devices such as smartphones began incorporating at least two cameras: one camera on the same side as the touchscreen display, facing the user, and a second camera on the opposite side from the touchscreen display. *See* '757 Patent, 2:1-6, Fig. 4. Additionally, the different cameras could be activated using different inputs such as pressing a physical button or touching an icon on a touchscreen display. *Id.*, 1:19-27, 1:33-44. But when using a voice command, the smartphone would immediately start a photographing process and thereby capture the user speaking the command, rather than an intended pose. *Id.* at 2:23-29, 9:23-33. The '757 Patent describes a solution to this problem by controlling the camera functions to delay the start of the photographing process after the recognition of a voice command. *Id.* at 2:29-31, 9:33-41. Further, depending on which camera was enabled and which type of input is used to enable the camera for initiating the photographing process, the device is configured with an arrangement of specific components including a controller that is used to control the various photographic processes and associated

timing operations. *Id.* at 2:32-37, 9:48-55, Fig. 9. Thus, the patent enables the photographing of a subject with a natural pose while also improving the usability of the device. *Id*. at 2:40-45, 3:9-15.

2. Level of Ordinary Skill in the Art for the '757 Patent

For the '757 Patent, a POSITA has a working knowledge of computing devices with touch and voice inputs, gained through a Bachelor of Science in Electrical Engineering or an equivalent degree and one year of experience in the field of computing devices with voice and touch interfaces. Additional education or experience might substitute for the above requirements.

3. Disputed Terms in the '757 Patent

a) "second camera arranged on an opposite side of the touch display" / "second camera being arranged on an opposite side of the touch display"

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

Both parties agree that this term should be given its plain and ordinary meaning. (Dkt. No. 66 at 20). Samsung, however, urges this Court to rewrite this term to include "located on a **side** of the touch display" when the unaltered claim language makes clear that the second camera is arranged on an opposite side of the touch display. But, "[c]ourts do not rewrite claims." *See K-2*, 191 F.3d at 1364; *see also Synqor,* 2014 WL 1338712, at *11.

The intrinsic evidence makes clear that no construction is necessary and that the plain and ordinary meaning of this claim term is abundantly clear. Specifically, claim 1 of the '757 Patent recites "a first camera arranged on a same side of the touch display" and "a second camera arranged on an opposite side of the touch display." '757 Patent, Claim 1. Further, Figs. 4(a) and 4(b) of '757 Patent include drawings showing a first camera 123 arranged on a same side of touch display 141 and second camera 124 arranged on an opposite side of touch display 141. *Id.*, Figs. 4(a)-4(b). "[T]he specification 'is always highly relevant to the claim construction analysis. Usually, it is

dispositive; it is the single best guide to the meaning of a disputed term.'" *See Phillips*, 415 F.3d at 1315 (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). Here, both the claims and specification make clear that the plain and ordinary meaning is 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. No further construction is necessary.

b) "enabled" / "disabled"

Maxell's Proposed Construction	Samsung's Proposed Construction
Plain and ordinary meaning	Powered [on/off]

Samsung wants the Court to rewrite "enabled" / "disabled" to "powered [on/off]." This is improper. The intrinsic record confirms that "enabled" and "disabled" are recited in the claims consistent with their plain and ordinary meaning. For example, claim 1 recites "control such that a first standby time of a case where the first camera is enabled and the second camera is disabled is longer than a second standby time of a case where the second camera is enabled and the first camera is disabled." Thus, confirming that the terms "enabled" and "disabled" are used to refer to operational states of the claimed first and second cameras. This is consistent with the description in the specification as well. *See e.g.,* '757 Patent, Abstract ("after input of the command voice to be different in accordance with the **enabled imaging unit**"); *see also id.*, 2:60-3:7 (reciting "enabled" in association with imaging unit five times); 11:7-15 ("the camera function executing unit 104b **enables the first imaging unit**").

The extrinsic evidence also supports Maxell's position that no construction is necessary because numerous dictionaries provide definitions that are consistent with this term conveying an operating state of a device. *See e.g.*, A Dictionary of Computing (Ex. 14) at 172 ("[t]o selectively activate a device or function"); *see also* Newton's Telecom Dictionary (Ex. 15) at 473 ("enable . . . to set various hardware and software parameters so that the central computer will recognize those

parameters and start doing what you want"); Dictionary of Computing (Ex. 16) at 124 ("enable . . . to use an electronic signal to start a process"; "enabling signal . . . a signal that starts a process or allows one to take place").

Similarly, numerous Samsung patents also use this terminology including in the claims consistent with the plain and ordinary meaning. *See e.g.*, U.S. Pat. Nos. 9,935,942 (Ex. 17), 14:31-32 and claim 1 ("if the change **enable/disable** information indicates a changed **state**"); 9,870,490 (Ex. 18), claim 1 ("generate a command to **enable** or **disable** the transceiver"); 10,368,001 (Ex. 19), claim 1 ("timing controller is configured to **enable** the gyroscope sensor by activation of the flag signal and to **disable** the gyroscope sensor by de-activation of the flag signal"); 10,509,530 (Ex. 20), claim 3 ("change a state of the lock window into an **enable** or **disable state**"); 10,194,316 (Ex. 21), claim 2 (" identification module while being in an **enabled state or a disabled state**").

Thus, the '757 Patent claims and specification, technical dictionaries, and Samsung's own patent claims confirm that the term enabled/disabled has a plain and ordinary meaning and no construction is necessary. There is no support in the intrinsic record for Samsung's proposed narrowing of this term and requiring enabled/disabled to mean powered on/off. Such a limiting construction would require ignoring caselaw emphasizing adherence to the plain and ordinary meaning of the terms and discouraging the rewriting of claims. *See K-2*, 191 F.3d at 1364.

Accordingly, no construction is necessary for enabled/disabled.

C. <u>The '590/'241 Patents</u>

1. Background of the '590/'241 Patents

The '590 Patent has a priority date of November 28, 2007 and is directed to a technique for establishing multiple wireless connections between a plurality of apparatuses "such as a camera

and a cellular" device. *See* '590 Patent at Abstract.[2] Conventional techniques prior to this patent connected video processing apparatuses with each other by establishing analog connections to transmit video and audio signals. Decl. Bruce McNair ("Ex. 22") ¶ 30 (citing '590 Patent at 1:19-23). The inventors realized a need for simultaneous video transmission and connection to the Internet or a home network using multiple radio communication circuits that would not interfere. Ex. 22 ¶¶ 31-32. Thus, the '590 Patent disclosed and claimed techniques whereby a video processing apparatus can include multiple radio communication circuits implementing different transmission schemes, such that these circuits could be controlled to transfer video to another apparatus via one of the circuits, while another circuit could be used to allow the apparatus to connect to the Internet or a home network. *Id.*; *see also* '590 Patent, Fig. 4. The patent also teaches that a controller is used to "variably control the radio transmission assignment" for the multiple radio communication circuits "in response to an indication from [a] user." Ex. 22 ¶ 34 (citing '590 Patent, 8:35-38). This technique can facilitate communications "in a situation wherein the user issues an indication to transmit video information by radio… while acquiring information from the Internet." *Id.*

2. Level of Ordinary Skill in the Art for the '590/'241 Patents

For the '590/'241 Patents, a POSITA would have at least a Bachelor's degree in Electrical Engineering, Computer Engineering, or a related field, with at least one year of experience in the field of wireless communications.

3. Disputed Terms in the '590/'241 Patents

a) "transmission frequency band"

Maxell's Proposed Construction	Samsung's Proposed Construction
Plain and ordinary meaning	set of frequencies used to transmit information

[2] The '241 Patent is a family member of the '590 Patent and has the same specification. While the scope of the claims of the '590 and '241 Patents is different, for the purposes of the disputes herein, the parties agree that the Court can address the disputes for both patents by addressing the disputes with respect to the '590 Patent.

Like with the enabled/disabled dispute above, Samsung again requests that the Court rewrite "transmission frequency band" with no support in the intrinsic record. This term is well understood in the electrical engineering context as it relates to wireless communications. Ex. 22 ¶¶ 44-45 (citing eight different technical dictionaries each describing the term consistently as a range/interval of frequencies; *see e.g.*, McGraw-Hill Dictionary of Scientific and Technical Terms (Ex. 23) at 854). The '590 Patent also describes the claimed "transmission frequency band" consistent with its plain and ordinary meaning by providing examples of four bands of frequencies as "Band A" (0-10 MHz), "Band B" (10-20 MHz), "Band C" (20-30 MHz), and "Band D" (30-40 MHz). Ex. 22 ¶¶ 48-49 (citing to the '590 Patent, Fig. 11). The same is true with respect to Samsung's own patents where it also uses the same terminology to describe a range or interval of frequencies in claims. Ex. 22 ¶ 47; *see also* Exs. 24-27 (reciting and using "frequency band" consistent with its plain and ordinary meaning repeatedly in numerous claim elements of numerous Samsung patents).

None of the '590 Patent, dictionary definitions, or Samsung's patents use the term "set of frequencies" to define the term transmission frequency band, which is included in Samsung's proposed construction. To the contrary, the evidence confirms that the term "transmission frequency band" has a plain and ordinary meaning and no construction is necessary. Adopting Samsung's proposed construction would unnecessarily rewrite the claim without any reason for doing so. Samsung's proposed construction should be rejected. *See K-2*, 191 F.3d at 1364.

b) **Allegedly mixed apparatus-method claims ('590 Patent, claims 1, 5, 11-12, 15-20, 23-25; '241 Patent, claims 1, 5-6, 9-14, 25-27)**

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

Samsung alleges that all of the apparatus claims of the ’590 and ’241 Patents are indefinite under *IPXL* because they supposedly recite mixed apparatus-method claims. *See IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005). As described below in detail, Samsung’s argument should be rejected for at least two reasons. First, the claims are directed to an apparatus that include components having the capability to perform certain actions when a particular condition is met. Such claims are not indefinite. *MasterMine Software, Inc. v. Microsoft Corp.*, 874 F.3d 1307, 1316 (Fed. Cir. 2017) (claims reciting a component receiving user input and performing a function based on the user input are not mixed apparatus-method claims).

It is expected that Samsung will argue that the apparatus claims of the ’590 and ’241 Patents are indefinite under *IPXL* because they supposedly recite both an apparatus and a method of using that apparatus. Samsung, however, is intentionally misinterpreting the claim language to inject a “method step” where none exists. Samsung’s arguments should be rejected because the claims are directed to the apparatus’s capability to respond to a user selection, not to a use of the apparatus.

First, between the reexamination of the ’590 Patent and the examination of the ’241 Patent—four different USPTO Examiners have examined these claims and allowed them without issuing any indefiniteness rejection. *See* Notice of Intent to Issue *Ex Parte Reexamination Certification* for the ’590 Patent (Ex. 28) at 26 and ’241 Patent at 1. Second, Samsung’s expert fails to rebut Maxell’s expert that “a POSITA would understand [that these claims are] . . . directed to an apparatus that has different components and the claim recites the capabilities of these components under various conditions.” Ex. 22 ¶ 52. Third, the Federal Circuit has distinguished *IPXL* and confirmed that claiming controller capability in this manner is permissible and definite. *See MasterMine*, 874 F.3d at 1316 (“While these claims make reference to user selection, they do not explicitly claim the user’s act of selection, but rather, claim the system’s **capability** to receive and respond to user selection”). In particular, a comparison of the claims of the ’590/’241 Patents

with the claims found to be indefinite in *IPXL* and the claims found to be definite in *MasterMine* confirm that the claims of the '590/'241 Patents are closest to the claims at issue in *MasterMine* that the Federal Circuit found to be valid and distinguishable from the claims at issue in *IPXL*:

The '590 Patent exemplary claim	***IPXL* claim language**	***MasterMine***
"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 when an **indication from the user indicates** to use the first radio communication circuit, the **controller assigns** a connection to the first radio communication circuit . . . ," The '590 Patent, claim 5.	"The system of claim 2 [including an input means] wherein the predicted transaction information comprises both a transaction type and transaction parameters associated with that transaction type, and the **user uses the input means** to either change the predicted transaction information or accept the displayed transaction type and transaction parameters." *IPXL Holdings*, 430 F.3d at 1384.	"wherein the **reporting module** installed within the CRM software application presents a set of user-selectable database fields as a function of the selected report template, **receives from the user a selection** of one or more of the user selectable database fields, and **generates a database query as a function of the user selected** database fields" *MasterMine*, 874 F.3d at 1315

In *MasterMine*, the Federal Circuit explained that claims reciting a "reporting module" that "receives from the user a selection" and then "generates a database query" based on the received user selection is definite and distinguishable form *IPXL* because

> [t]hough claim 8 includes active verbs—presents, receives, and generates—these verbs represent **permissible** functional language used to describe **capabilities of the "reporting module"** . . . [T]he claims at issue here merely claim that the system "possess[es] the recited structure [which is] capable of performing the recited functions" . . . . These claims are also **distinguishable from** those at issue in ***IPXL*** *Holdings* . . . , as the claims here do not claim activities performed by the user. While these claims make reference to user selection, **they do not explicitly claim the user's act of selection**, but rather, claim **the system's capability to receive and respond to user selection**. The limitations at issue here ("receiv[ing] from the user a selection" and "generat[ing] a database query as a function of the user selected database fields") focus on the capabilities of the system, whereas the claims in *IPXL Holdings* ("the user uses the input means") . . . focus on specific actions performed by the user.

874 F.3d at 1315-1316 (internal quotations omitted). Similar to the claims that were found to be definite in *MasterMine*, the apparatus claims of the '590/'241 Patents claim the capability of the controller to receive and respond to the user selection. This is clear from the plain language of the claims that recite that the "controller controls assignment of connection . . . in response to receiving

an indication from a user such that when an indication from the user indicates to use the first radio communication circuit, the controller assigns a connection." Like the reporting module in *MasterMine* that receives a user selection and generates a database query in response to receiving the user selection, the controller in the '590/'241 Patents claims receives an indication from a user and when the user indication is received, the controller assigns a connection to the first radio communication circuit. Unlike the claims at issue in *IPXL*, there is no recitation in the '590/'241 Patents apparatus claims of a "user" that "uses the input means." This capability of the controller is also made clear by the use of the phrase "such that" in the '590/'241 Patent claims, making it explicitly clear that the clause coming after "in response to receiving an indication from a user" is describing the functional capabilities of the controller such that the controller can assign a connection when a user indication is received. *See Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319, 1335 (Fed. Cir. 2009) (holding that "such that" corresponds to functional language in a claim).

In short, the claims here, like those in *MasterMine*, are not indefinite because they "merely use permissible functional language to describe the capabilities of the claimed system." *See MasterMine*, 874 F.3d at 1316; *see also UltimatePointer, L.L.C. v. Nintendo Co.*, 816 F.3d 816, 827 (Fed. Cir. 2016) ("[T]he 'data generating' limitations only indicate that the associated structures have this capability (for example, the image sensor and processor in claim 1) and do not require that any data be actually generated by the user.").

Courts reject indefiniteness arguments similar to Samsung's where, as here, the claims simply refer to the claimed invention's capabilities. For example, in *U.S. Well Sers., Inc. v. Halliburton Co.*, the parties disputed whether the phrases "performing/performs electric motor diagnostics to prevent damage" and "performs electric motor diagnostics" recited a method step in a system claim. No. 6:21-CV-00367-ADA, 2022 WL 819548, at *9 (W.D. Tex. Jan. 17, 2022).

The *Halliburton* court noted that "claims are not indefinite mixed method-apparatus claims when the functional language of a claim merely describes the structure and capabilities of the claimed apparatus." *Id.* In reaching this conclusion, the court recognized that "the claims are not directed at any user action" and instead simply recited "a programmed capability." *Id.* at *11.

So too with the claims of the '590 and '241 Patents. Instead of expressly requiring user action, they simply recite programmed capability in the form of the assigning connection "in response to receiving an indication from a user … when an indication from the user indicates to transmit video information." *See, e.g.*, '590 Patent, claim 5. Nothing in the claim language requires an affirmative step on the part of a user; it simply recites functionality of the claimed controller. Indeed, since *IPXL*, the Federal Circuit and other courts have restricted that holding significantly:

- Claim language "logic pipeline stage performing … and producing …" not indefinite under *IPXL* (*Microprocessor Enhancement Corp. v. Tex. Instruments, Inc.*, 520 F.3d 1367, 1371 (Fed. Cir. 2008));
- Claim language requiring "said image sensor generating data…" not indefinite under *IPXL* (*UltimatePointer,* 816 F.3d at 826); and
- Claim language "processing means controls a function" not indefinite under *IPXL* (*Motion Games, LLC v. Nintendo Co.,* No. 12-CV-878, 2015 WL 11170167, at *4 (E.D. Tex. Jan. 16, 2015), *report and recommendation adopted*, No. 12-CV-878, 2015 WL 11170729 (E.D. Tex. Apr. 22, 2015)).[3]

Thus, unlike the claim in *IPXL*, claims 1, 5, 11-12, 15-20, and 23-25 of the '590 Patent and claims 1, 5-6, 9-14, and 25-27 of the '241 Patent do not require that "the user uses" any particular feature or component. Instead, the '590 and '241 Patents' claims merely recite a structure (a controller) with the capability to control assignment of a connection when a certain condition is

[3] *See also RightQuestion, LLC v. Samsung Elecs. Co.,* No. 21-cv-00238, 2022 WL 1154611, at *8-10 (E.D. Tex. Apr. 18, 2022) ("wherein the user is logged in to the external resource…" not indefinite under *IPXL*); *GPNE Corp. v. Apple, Inc*., No. 12-cv-02885-LHK, 2013 WL 4446819, at *18-20 (N.D. Cal. Aug. 13, 2013) (claim language requiring "interface [configured/controlled] by the at least one processor to [transmit and receive terms]" not indefinite under *IPXL*), *aff'd* 830 F.3d 1365 (Fed. Cir. 2016); *Huawei Technologies Co. v. T-Mobile US, Inc*., No. 2:16-cv-00055, 2017 WL 2190103, at *16-19 (E.D. Tex. May 17, 2017) (distinguishing claims from *IPXL*); *Corning Optical Commc'ns. Wireless, Ltd. v. SOLiD Inc*., No. 5:14-cv-03750-PSG, 2015 WL 5096472, at *8-11 (N.D. Cal. Aug. 19, 2015) (same).

met. Because infringement plainly occurs when one makes, uses, imports, offers to sell, or sells a device with this capability, *IPXL* does not apply to the '590 and '241 Patents' claims.

In light of the extensive examination of the '590 and '241 Patents, the unrebutted testimony of Maxell's expert, and the clear similarities to the claim language found definite in *MasterMine*, Samsung cannot meet its burden of showing by clear and convincing evidence that these claims are indefinite. Accordingly, these terms should be afforded their plain and ordinary meaning.

Moreover, Samsung cannot sincerely contend that claims that are directed to an apparatus's capability to respond to a user selection are indefinite when Samsung itself has repeatedly argued that claims with similar language as the apparatus claims of the '590/'241 Patents are allowable and/or patentable. *See e.g.*, Ex. 22 ¶¶ 53-64 (Mr. McNair identifying at least ten exemplary apparatus claims in Samsung's patents for whom Samsung obtained a favorable result at the USPTO by arguing that such claims were patentable/allowable). These examples are provided below and even include the same language of "controller controlling" and "user input":

Samsung Pat. No. & Ex. No.	**Similar Claim language as the '590/'241 apparatus claims**
9,445,001 (Ex. 29)	Claim 20: "an input unit **receiving user input**" and "a **controller controlling** processing of an image output **when the request is received** through the input unit." Ex. 22 ¶¶53-54 (citing Ex. 29 at claim 20).
9,436,753 (Ex. 30)	Claim 13: "a display that . . . displays, **in response to user selecting** one of the plurality of individual notice information" and "a processor that **receives an input** . . . , and controls the storage and the display to display"
10,594,797 (Ex. 31)	Claim 6: "wherein the **electronic device receives user input** while the user interface is being presented **and transmits**, to the server, data for controlling the at least one peripheral device **in response to the user input**, and the server controls the peripheral device based on the received data"
9,088,712 (Ex. 32)	Claim 19: "wherein, **in response to a command being received** from a user, the **control unit makes the first and second GUIs disappear** from the display screen and **controls the OSD unit** and **the display unit** to generate and display" Claim 22: "wherein, **in response to user input being** received with the quick-view image displayed in the second area, the **control unit sets the quick-view image** as a new reference image and **controls the display unit** to display the live-view image"
8,947,581 (Ex. 33)	Claim 1: "an **information deriving unit** that, when the second focusing mode is selected, **derives focus aid (FA)** information . . . **in response to user input** resulting from the user manually adjusting the position of the focus lens"
8,576,798 (Ex. 34)	Claim 6: "an **input unit receiving user input** information that is user selected, wherein the **controller controls the communication unit** to transmit a file in the broadcast mode to the external data communication apparatus **according to the user input**."

9,483,936 (Ex. 35)	Claim 1: "a **controller** which, **in response to a user's selection** of the shortcut key, **simultaneously displays** on the touch screen a second manipulation UI" Claim 9: "wherein, **if the user touches**, clicks, or flicks a button or the shortcut key displayed on the touch screen, the controller executes corresponding function."
8,928,614 (Ex. 36)	Claim 27: "a touch screen . . . **receiving a touch event input**" and "a **controller controlling** a first mode executing the function of the function key **when the touch event input** is released"

Each of these exemplary claims in Samsung's patents have the same structure as the claims of the '590/'241 Patents, *i.e.*, a component [controller] that is capable of performing a function [controls / controlling] based on a condition [user indication / user input]. *See e.g.*, Ex. 22 ¶¶ 53-64. As an example, the file history of U.S. Pat. No. 10,594,797, confirms that Samsung argued for a favorable order at the USPTO by seeking an allowance of such apparatus claims by asserting that they were allowable, *i.e.*, compliant with all statutory requirements including the requirement of definiteness under 35 U.S.C. § 112. *See* Remarks (Ex. 37) at 11, September 10, 2019 ("reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited"). Now, Samsung is arguing that these same type of apparatus claims should be invalidated for being indefinite because they have been asserted against Samsung. Samsung cannot have it both ways. Thus, Samsung's contention of indefiniteness should be rejected for this additional reason.

c) "wherein when an indication from 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"

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

Both parties agree that this term should be given its plain and ordinary meaning. (Dkt. No. 66 at 21). Yet, Samsung proposes a construction that includes a negative limitation that directly contradicts the language of the claim. In particular, Samsung argues that the plain language of this claim must recite "the user, **not the controller**, to select the particular radio." This is nonsensical

when the claim language itself makes clear that it is **the controller** that assigns the connection to the first radio communication circuit. *See* '590 Patent, Claim 1. In particular, the controller will have to select the first radio communication circuit in order to be able to assign it the connection. This plain and ordinary meaning is consistent with the intrinsic record as well because the '590 Patent makes clear that "[t]he controller 132 and the transmission rate assignment controller 1001 may variably control the radio transmission assignment to the modems 1002 and 1003 in response to an indication from the user." *See id*., 8:35-38; *see also* Fig. 4 showing controller 132 selecting particular radio modems 5001, 5005, 5006, 5007 by providing input to transmission assignment control 1001.

Thus, there is no justification for including a negative limitation in the plain and ordinary meaning of this term. Absent explicit disavowal, negative limitations are generally disfavored. *See Omega Eng'g, Inc. v. Raytek Corp*., 334 F.3d 1314, 1332-33 (Fed. Cir. 2003). And "the standard for disavowal is exacting, requiring clear and unequivocal evidence that the claimed invention includes or does not include a particular feature." *Poly-America, L.P. v. API Indus., Inc.,* 839 F.3d 1131, 1136 (Fed. Cir. 2016). Because no clear and unequivocal evidence of disavowal has been set forth by Samsung, its proposed construction should be rejected.

D. <u>The '086 Patent</u>

1. Background of the '086 Patent

The '086 Patent, which has a priority date of February 9, 2011, discloses a portable terminal where "[w]hen the user's finger contacts with the touch panel, capacitance of the sensor 4 changes and the sensor 4 outputs a signal according to the change." *Id*., 3:17-20, Fig. 2. The portable terminal is able to detect the variations in the capacitance of the sensor based on a touch and determine the region of the finger (*e.g.*, end or pad) that causes the change in capacitance. *Id.,* Fig. 8. Using a group of capacitance sensors to distinguish between types of input entered by a user's

finger enable the portable terminal to execute a variety of operations associated with different types of inputs. *Id*., 7:42-44, Fig. 12B. One example of such operation includes an "enhanced security function that incorporates a four-digit password and a difference in the contact range" with respect to the capacitive sensors being touched by different portions of the user's finger. *Id*., 6:16-35. The portable terminals "can thus handler user's highly confidential information" and the "[b]urden[] on the user for memorization can thus be alleviated." *Id.*, 7:50-60.

2. Level of Ordinary Skill in the Art for the '086 Patent

For the '086 Patent, a POSITA would have at least a Bachelor's degree in Electrical Engineering, Computer science, or a related field, with at least one year of experience in the field of computing devices with touch interfaces.

3. Disputed Terms in the '086 Patent

a) "first information necessary for an identification of the user" / "second information relating to the identification of the user"

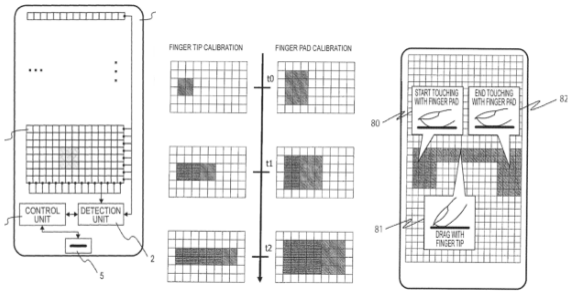
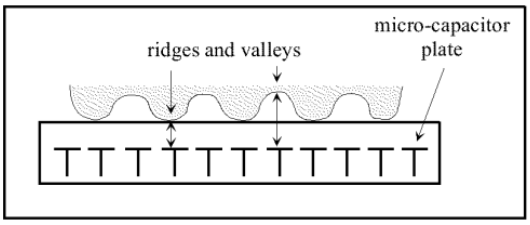
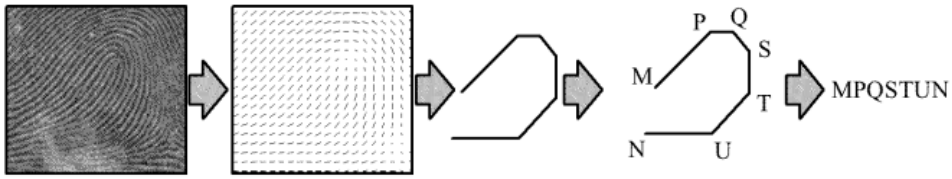
Maxell's Proposed Constructions	Samsung's Proposed Constructions
Plain and ordinary meaning	information sufficient for the identification of the user, but not including information about a user's fingerprint information related to the identification of a user, but not including information about a user's fingerprint[4]

For both of these terms, no construction is necessary as the claims recite identification information without putting any specific restrictions on the type of identification information that is used to identify the user. This is consistent with the description of "identification information" in the specification. For example, when providing examples of "identification information" the specification broadly states that this information includes "letters, figures, and symbols." Decl. Jacob Wobbrock ("Ex. 38") ¶ 60 (citing '086 Patent, 1:40-45). In contrast, Samsung's proposals

[4]While no construction is necessary, consistent with prior cases, Maxell is willing to agree to the first part of Samsung's proposed constructions without the negative limitations.

seek to wedge the same unjustifiable negative limitation into both claim terms, namely that the information cannot "include[e] information about a user's fingerprint." Absent an explicit disavowal, however, negative limitations are generally disfavored. *See Omega Eng'g*, 334 F.3d at 1332-33; *see also Maxell*, 297 F. Supp. 3d at 735 (standards for finding disavowal are "exacting."). Here, Samsung has not met the "exacting" standard required to justify limiting the claim with a negative limitation. Nowhere in the specification or in the file history of the '086 Patent is there any disclaimer that excludes using a user's fingerprint.

Instead, the '086 Patent includes 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." *See* '086 Patent, 3:30-32; *see also id.* at Figs. 3, 4A, 4B, 8, 10A, 10B, and 11A. The specification does not state anywhere that this finger is used without fingerprints, or that the disclosed examples of identification information of "letters, figures, and symbols" cannot include fingerprints. Indeed, the specification discloses using capacitive sensors to detect touch, and there is no disclosure in the specification that these capacitive sensors are detecting the user's touch **without** detecting "information about a user's fingerprint." To the contrary, as explained by Dr. Wobbrock, reading the disclosures about the capacitive sensors and the broad descriptions of the password, a POSITA would agree that the use of fingerprints is encompassed in the detection of different portions of the finger. *See* Ex. 38 ¶¶ 60-66 (citing to *Handbook of Fingerprint Recognition* ("Ex. 39") to explain how Figure 2.10 of the Handbook describes similar capacitive sensing as the specification of the '086 Patent and Figure 5.7 of the handbook shows how the disclosed "letters, figures, and symbols" correspond to fingerprint information.) For example, as explained by Dr. Wobbrock, the disclosures in the *Handbook of Fingerprint Recognition* confirm that the '086 Patent discloses fingerprint information as being identification information:

’086 Patent	*Handbook of Fingerprint Recognition*
 Figs. 2, 5A, and 8 “a group of sensors or a sensor whose capacitance varies upon contact with the user's finger.” ’086 Patent, 3:17-32	 *Capacitive*: this is the most common method used today within the silicon-based sensor arena (Tsikos (1982); Edwards (1984); Knapp (1994); Inglis et al. (1998); Setlak (1999); Lee et al. (1999); Dickinson et al. (2000); Morimura, Shigematsu, and Machida (2000); Hashido et al. (2003)). A capacitive sensor is a two-dimensional array of micro-capacitor plates embedded in a chip (see Figure 2.10). Ex. 39 at 67
 Ex. 39 at 245 describing fingerprint information as “letters, figures, and symbols.”	

Samsung’s negative limitations would not only exclude fingerprint information but any type of information **about** a user’s fingerprint including “even the change in capacitance caused by a user’s touch,” a concept that is explicitly disclosed in the ’086 Patent at 3:17-20, 3:30-35. Ex. 38 ¶ 65. But a “claim interpretation that excludes a preferred embodiment from the scope of the claim ‘is rarely, if ever, correct.’” *See Globetrotter Software, Inc. v. Elan Comput. Grp., Inc.*, 362 F.3d 1367, 1381 (Fed. Cir. 2004) (quoting *Vitronics,* 90 F.3d at 1583).

The only justification that Samsung is expected to provide for its negative limitations was based on its interpretation of the file history of related RE48830 E1. But, no disclaimer exists in this file history that would justify imposing these negative limitations to claims of the ’086 Patent. During prosecution of RE48830 E1, the USPTO issued a Non-Final Rejection asserting that “Claims 1-34 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251” because the new claims allegedly “broadens” aspects of the previously issued claim. *See* Non-Final Rejection (Ex. 40), at 3-4, January 22, 2020. The Non-Final Rejection also included a

variety of other rejections including a rejection of claims 8, 9, 14, 21, 22, and 27 for lack of written description because there was allegedly "no support for storing information related to a fingerprint." *Id.* at 5. But rejections at the USPTO alone do not create a disavowal of claim scope. *See Alfred E. Mann Found. For Sci. Rsch. V Cochlear Corp.*, 841 F.3d 1334, 1341 (Fed. Cir. 2016) ("an examiner's unilateral statement does not give rise to a clear disavowal of claim scope by the applicant"). The whole context needs to be examined, and this context shows that Applicant **canceled** claims 8-34 in view of the rejection based upon the **alleged defective reissue declaration** under 35 U.S.C. § 251 and "[o]nly to expedite prosecution of the present application." *See* Amendment ("Ex. 41") at 7, dated July 22, 2020. These claims were not canceled in response to the lack of written description rejection by the USPTO (*i.e.*, the fingerprint issue).

To the contrary, Applicant repeatedly and consistently asserted that it did not agree with the USPTO's rejection, it was not acquiescing to any of the rejections, and that it canceled the claims in view of the rejection for a defective reissue declaration under 35 U.S.C. § 251. *See* Ex. 41 at 6-7 ("Applicant respectfully **disagrees** with all the rejections . . . . Applicant has amended the claims . . . to obtain reissue in an efficient and expedited matter." "Previously added claims 8-34 have also been canceled, **without prejudice, reserving right to prosecution** in a reissue continuation/divisional.") Indeed, claims 8-34 were canceled "to expedite allowance of claims 1-7 and to overcome the alleged impermissible broadening, **not** because Applicant agreed with the Examiner's rejections under **35 U.S.C. §112** and **not** because Applicant agreed to **disclaim claim scope** of claims 8-34." Comments on Statements Of Reasons For Allowance (Ex. 42) Oct. 8, 2021.

Thus, taken in totality, a unilateral rejection by the USPTO does not rise to the level of disavowal, which is what Samsung must establish to justify its negative limitations. In fact, when the events of the entire prosecution history are considered in totality, it is clear that Applicant cancelled claims in view of the rejection to the reissue declaration and in an attempt to get the

remaining claims allowed in an expedited manner. Applicant even added "a finger of a user" to these remaining claims, which was allowed by the Examiner, and a finger of a user includes fingerprints. Ex. 41 at 3. To disavow or disclaim the full scope of a claim term, the patentee's statements in the specification or prosecution history must amount to a "clear and unmistakable" surrender. *See Cordis Corp.*, 561 F.3d at 1329. And "[w]here an applicant's statements are amenable to multiple reasonable interpretations, they **cannot be deemed clear and unmistakable**." *3M Innovative Props. Co. v. Tredegar Corp.,* 725 F.3d 1315, 1326 (Fed. Cir. 2013). In view of the foregoing, Samsung's proposal to inject negative limitations should be rejected as Samsung cannot meet the exacting standard of establishing disavowal.

E. <u>The '161 Patent</u>

1. Background of the '161 Patent

At the time of the priority date of the '161 Patent, March 23, 2006, additional network devices were being included in homes and in order to allow such devices to communicate, conventional solutions would require the devices to be physically present in the same location or registered in advance to a group management server. *See* '161 Patent, 2:3-23. To allow for a more flexible manner of permitting the devices to mutually exchange information, the inventors of the '161 Patent proposed a solution whereby devices in the home network judge whether they belong to the same network by storing information about the other devices connected to the home network and communicating these stored lists with each other. Decl. Jon Weissman ("Ex. 43") ¶¶ 33-35. The devices use a network belonging judgment process to determine that the other network device belongs to the same home network by comparing the received list with the stored list. *Id.* (citing '161 Patent, 6:1-53). If the stored and received lists match, then the devices can mutually exchange information without being physically present when exchanging content.

2. Level of Ordinary Skill in the Art for the '161 Patent

For the ’161 Patent, a POSITA would have at least a Bachelor’s degree in Electrical Engineering, Network Engineering, or a related field, with at least two years of experience in the field of networking and/or Internet of things (IoT). *See* Ex. 43 ¶ 40.

3. Disputed Terms in the ’161 Patent

a) “peripheral device information collation unit”

Maxell’s Proposed Construction	Samsung’s Proposed Construction
Agreed Function: collates the home network information received from the other network device through the peripheral device information reception unit with the home network information stored in the peripheral device information storage unit and judges whether other network device belong to the same network as the local network device	
Proposed structure: CPU 20 operating in conjunction with ROM 22 and/or RAM 21 included within or external to the network device for executing one of the comparison and judging algorithm as disclosed in ’161:5:62–6:29, or equivalent thereof	**Proposed structure:** indefinite for lack of corresponding structure because an algorithm that is performed by the central processing unit . . . is not adequately described. *See* Dkt. No. 66 at 5-6 for complete proposal.

The parties agree that this term is a means-plus-function term and agree on the function corresponding to this term. Further, Samsung also appears to agree that the structural components identified in Maxell’s proposed construction are correct because they are supported by the ’161 Patent and also similar to the four agreed-to structures for four additional means-plus-function terms for this claim. *See* Dkt. No. 66 at 3-4; *see also* Ex. 43 ¶¶ 75-80 (citing ’161 Patent, 4:38-51 and Figs 2 and 3 to explain that the ’161 Patent discloses the structure of “CPU 20, which provides overall control over the network device 3; a RAM (Random Access Memory) 21 and a ROM (Read Only Memory) 22, which store data and programs . . . The CPU20 reads a program stored in the ROM 22, loads the read program into the RAM 21, and executes various functions, which are described later.”)

Samsung, however, alleges that this term is indefinite because: (1) the disclosed algorithm in the ’161 Patent is not adequately described; and (2) the term—addressed on pages 34-35 below—“chronological list of network devices connected to the network” that is part of the agreed function is indefinite. *See* Dkt. No. 66 at 5-6. Samsung is wrong on both accounts.

"[A] patentee [can] express that algorithm in any understandable terms including as a mathematical formula, in prose, or as a flow chart, or in any other manner that provides sufficient structure." *See Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008) (citation omitted). Here, the '161 Patent discloses that in order to perform the agreed-to function, the '161 Patent discloses **three** alternative comparison and judging algorithms by using an "or" with the disclosure. Ex. 43 ¶ 85. For example, the '161 Patent discloses that "the peripheral device information collation unit 35 judges whether the local device and remote device belong to the same home network by[: (1)] checking whether the collated sets of peripheral device information are identical with each other, [(2)] determining the degree of agreement between the collated sets of peripheral device information, **or** [(3)] by checking whether the collated sets of peripheral device information exhibit the same tendency." *Id.* (citing '161 Patent, 5:67-6:7); *see also id.* ¶¶ 93-94 (citing Fig. 7, a "flowchart" illustrating the judging process, and the related disclosure of Fig. 7). %

These disclosed "algorithms are simple comparisons of two datasets." Ex. 43 ¶ 86. This is also confirmed by Samsung because they agreed to the function that requires "collat[ion] of the **home network information received** from the other network device through the peripheral device information reception unit with the **home network information stored**." *Id.* The '161 Patent claims, agreed-to function, and specification all consistently describe algorithms that perform a comparison between two datasets (received home network information with stored home network information) whereby the result of the comparison is used to provide a judgment on whether a particular network device belongs to the same network. As disclosed in the alternative algorithms, the comparison algorithms can provide three determinations: (1) identical data sets; (2) degree of agreement; or (3) same tendency. *Id.* Thus, the '161 Patent describes algorithms by providing inputs to such algorithms, *i.e.*, received home network information and stored home network

information, function of such algorithms *i.e.*, comparison, and outputs of such algorithms, *i.e.*, identical/degree of agreement/same tendency. As explained by Dr. Weissman, a POSITA would have been well-aware of a variety of "compare" functions that would have been available to execute the disclosed algorithms. *Id.* ¶ 87 (explaining that such compare functions were being taught in undergraduate studies in the Department of Computer Science).

In fact, Samsung's own expert admits that there were "well-known mechanisms for comparing and scoring similar strings using characters like the Hamming Distance, the Levenshtein Distance, the Damerau-Levenshtein Distance, Jaro Distance, or Jaro-Winkler Distance, among many others" that could be used to implement the disclosed algorithms. Decl. Clay Shields ("Ex. 44") ¶ 103; *see also id.* ¶ 82 (admitting that the '161 Patent appears to use "a primitive algorithm known as longest common substring.") And it is well-established law that a patentee "need not disclose details of structures well known in the art" so long as some structure is disclosed. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339-40 (Fed. Cir. 2016). "The fact that this algorithm relies, *in part*, on techniques known to a person of skill in the art does not render the composite algorithm insufficient under § 112 ¶ 6." *Id.* at 1340. Under Samsung's own expert's admissions, a POSITA can simply use "well-known mechanisms" along with the disclosed CPU operating in conjunction with ROM and/or RAM and execute the disclosed comparison algorithms to perform the claimed functions. *See Atmel Corp. v. Info. Storage Devices*, 198 F.3d 1374, 1382 (Fed. Cir. 1999) ("the knowledge of one skilled in the particular art may be used to understand what structure(s) the specification discloses, or that even a dictionary or other documentary source may be resorted").

Moreover, while not necessary, the '161 Patent provides even more details with various examples on how the three algorithms can be implemented in alternative ways by using reference values (Ex. 43 ¶ 88 (citing the '161 Patent, 6:4-29)), data entries in consecutive fields to determine

whether there is a match (Ex. 43 ¶ 92 (citing '161 Patent, 8:42-52)), UDN columns for comparison (Ex. 43 ¶ 94), "history of network device connections" for comparison (*id.* ¶ 96), and/or duration a particular device has been part of the network (*id.* ¶ 88).

In view of the above disclosures and the consistent opinions of Maxell and Samsung's experts that the disclosed comparison functions could be implemented by well-known techniques, the '161 Patent discloses sufficient structures for implementing the claimed "peripheral device information collection unit," and Maxell's proposed construction should be adopted.

b) a chronological list of network devices connected to the network[5]

Maxell's Proposed Construction	Samsung's Proposed Construction
Plain and ordinary meaning	Indefinite or alternatively—as disclosed on May 31, 2024 and not included in the Joint CC PHS)—"home network information" must "include, for each device that is a member of a local area network, a list with an entry for each time any device joins the local area network, transmits a message on the local area network, or leaves the local area network"

No construction is necessary for the term "a chronological list of network devices connected to the network" because it is being used in the '161 Patent claims and specification consistent with its plain and ordinary meaning. In particular, as explained by Dr. Weissman, there is "nothing indefinite about the term 'chronological list,' as it simply denotes an ordering of items one after another on a list." Ex. 43 ¶ 52. For example, numerous dictionaries confirm that chronological list has a well-known plain and ordinary meaning. *See id.* (citing American Heritage Dictionary (Ex. 45) and Random House Webster's College Dictionary (Ex. 46) to explain that chronological list has a well-known meaning). Moreover, Samsung itself uses similar terms in its

[5] In the Joint CC PHS, Maxell had agreed to brief this term in combination with the "collation unit" term because Samsung was arguing that the collation unit term is indefinite due to the incorporation of this term. On May 31, 2024, Samsung belatedly disclosed an additional alternative proposed construction for this term. *See* Ex. 44 ¶ 67. The belated disclosure by Samsung requires the Court to address an additional disputed term, which increases the number of disputed terms to 14. Samsung has refused to withdraw this proposed construction. Therefore, Maxell addresses this **14th** term herein, but it maintains that this is improper. *See* Order, Dkt. No. 68.

own patents and patent claims confirming that this term is definite and has a plain and ordinary meaning. Ex. 43 ¶ 53; *see also* Exs. 47-49 (reciting "chronological" in Samsung's patent claims).

The intrinsic evidence also confirms that the '161 Patent uses this term consistent with its plain and ordinary meaning and consistent with how Samsung has used this term in its own patents. '161 Patent, 6:49-51 ("FIG. 4 lists log information that indicates device names (UDNs) 42 in plain text format in chronological order 41"); *see also* Ex. 43 ¶¶ 56-59. As shown in Fig. 4, the '161 Patent simply uses this terminology to show a sequence of network devices whose device names are listed. Ex. 43 ¶¶ 60-63 (citing Fig. 4 and '161 Patent 6:48-51). There is nothing in the intrinsic record that justifies a rewriting of the claim or that supports a finding of indefiniteness as proposed by Samsung. Ex. 43 ¶ 68. Importing multiple examples from the '161 Patent specification—as set forth in Samsung's proposed construction— is improper where the '161 Patent explicitly discloses that one example of a chronological list can simply be a list of device names in a particular order. *See* '161 Patent, Fig. 4.

Thus, the '161 Patent claims and specification, technical dictionaries, and Samsung's own patent claims confirm that there is no ambiguity for the term "a chronological list of network devices connected to the network," and this term has a plain and ordinary meaning. No construction is necessary. *See K-2*, 191 F.3d at 1364; *see also Synqor,* 2014 WL 1338712, at *11.

V. CONCLUSION

As shown above, Samsung has only one goal in this claim construction process: rewrite well-known terms to limit the scope of the claims and create confusion where no ambiguity exists. Accordingly, Maxell respectfully requests that Samsung's proposed constructions be rejected and Maxell's proposed constructions be adopted.

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CERTIFICATE OF SERVICE

I hereby certify that all counsel of record who are deemed to have consented to electronic service are being served this 20th day of June, 2024, with a copy of this document via the Court's CM/ECF system.

/s/ Jamie B. Beaber
Jamie B. Beaber