

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

S.M.R INNOVATIONS LTD and Y.M.R
TECH LTD,

Plaintiffs,

v.

APPLE INC.,

Defendant.

Civil Action No. 6:23-cv-00479-DC

JURY TRIAL DEMANDED

DEFENDANT APPLE INC.'S INVALIDITY CONTENTIONS

Pursuant to the June 7, 2024, Joint Motion to Enter Agreed Scheduling Order (ECF. No. 49), Defendant Apple Inc. (“Apple”) provides the following contentions regarding the invalidity of U.S. Pat. Nos. 7,969,990 (“the ’990 Patent”); 8,711,866 (“the ’866 Patent”); 9,699,223 (“the ’223 Patent”); and 10,547,648 (“the ’648 Patent”). Apple’s Invalidity Contentions (“Invalidity Contentions”) address the patents and asserted claims identified in Defendants S.M.R Innovations LTD and Y.M.R Tech LTD’s (collectively, “Defendants” or “SMR”) Infringement Contentions of May 17, 2024.

Apple’s Invalidity Contentions reflect its knowledge and contentions as of this date in the present action. The disclosures are based upon the knowledge, information and/or belief presently available to Apple. Apple’s search for prior art is ongoing, and Apple reserves the right to modify and supplement its Invalidity Contentions, as permitted by this Court’s Order Governing Proceedings, any Court order, and any other applicable rules and statutes, including in the event that additional prior art is identified during the course of discovery and/or in response to any amendment by SMR of its Infringement Contentions or any claim construction issued by the Court. Apple will serve Final Invalidity Contentions at the time directed by the Agreed Scheduling Order.

Each of the asserted claims of the ’990, ’866, ’223, and ’648 Patents is anticipated by and/or obvious in view of the items of prior art identified in Exhibits A1–D2 hereto, alone or in combination, as set forth in those Exhibits. Much of the art identified in the attached Exhibits reflects common knowledge and the state of the art at the time of filing of the ’990, ’866, ’223, and ’648 Patents. Specific examples of anticipation and obviousness, along with exemplary motivations to combine the selected prior art, are set forth below.

I. IDENTIFICATION OF PRIOR ART

A. Prior Art Patents and Applications

Apple identifies the following prior art patents and applications that anticipate and/or render obvious the asserted claims of the '990, '866, '223, and '648 Patents (collectively, the "Asserted Patents") under pre-AIA 35 U.S.C. §§ 102(a), (b), and/or (e) and/or 35 U.S.C. § 103, or provide information relating to the background state of the art at the time the Asserted Patents were allegedly conceived:

Patent Number	Inventor(s)	Exemplary Date	Beg Bates
EP 1 132 847	Han	9/12/2001	APL-SMR 00001519
US 2001/0053134	Fillebrown	12/20/2001	APL-SMR 00001575
US 2002/0062406	Chang	5/23/2002	APL-SMR 00001591
US 2002/0068600	Chihara	6/6/2002	APL-SMR 00001623
US 2002/0076025	Liversidge	6/20/2002	APL-SMR 00001655
US 2002/0102998	Lin	8/1/2002	APL-SMR 00001727
US 2002/0178279	Janik	11/28/2002	APL-SMR 00001735
US 2002/0196378	Slobodin	12/26/2002	APL-SMR 00001755
US 2003/0061493	Angelo	3/27/2003	APL-SMR 00001782
US 5,793,415	Gregory	8/11/1998	APL-SMR 00001789
US 6,144,366	Numazaki	11/7/2000	APL-SMR 00001811
US 6,195,545	Baker	2/27/2001	APL-SMR 00001958
US 6,587,450	Pasanen	7/1/2003	APL-SMR 00001981
US 6,701,162	Everett	3/2/2004	APL-SMR 00001999
US 6,703,930	Skinner	3/9/2004	APL-SMR 00002006
US 7,058,414	Rofheart	6/6/2006	APL-SMR 00002018
US 7,124,166	Brown	10/17/2006	APL-SMR 00002050
US 7,286,502	Rao	10/23/2007	APL-SMR 00002067
US 7,295,809	Moore	11/13/2007	APL-SMR 00002085
US 7,536,182	Zhang	5/19/2009	APL-SMR 00002099
US 7,574,474	Thornton	8/11/2009	APL-SMR 00002115
US 7,580,005	Palin	8/25/2009	APL-SMR 00002129
WO 01/18665	Hendricks	3/15/2001	APL-SMR 00002146

In addition, Apple identifies the prior art patents and applications cited in the following petitions filed before the Patent Trial And Appeal Board relating to SMR's Asserted Patents: IPR2024-01047, -01048, -01049, and -01050, to the extent they are not listed above. To the extent that any of the patents and applications listed above describe systems, apparatuses, or methods that

were implemented, built, used, or reduced to tangible form, Apple reserves the right to rely upon such systems, apparatuses, or methods as independent pieces of prior art.

B. Prior Art Publications

Apple identifies the following prior art publications that anticipate and/or render obvious the asserted claims of the Asserted Patents under pre-AIA 35 U.S.C. §§ 102(a) and (b) and/or 35 U.S.C. § 103, or provide disclosures regarding the state of the art at the time the inventions claimed in the Asserted Patents were allegedly conceived:

Publication Title	Author(s)	Date	Beg Bates
Specification of the Bluetooth System, Version 1.1	Bluetooth SIG	2/22/2001	APL-SMR_00000435
Protocols for Service Discovery in Dynamic and Mobile Networks	Lee	2002	APL-SMR_00001554
A Situated Computing Framework for Mobile and Ubiquitous Multimedia Access using Small Screen and Composite Devices	Pham	2000	APL-SMR_00001566

To the extent that any of the publications listed above describe systems, apparatuses, or methods that were implemented, built, used, or reduced to tangible form, Apple reserves the right to rely upon such systems, apparatuses, or methods as independent pieces of prior art.

C. Prior Invention Prior Art under 35 U.S.C. §§ 102 (f) and (g)

In its Infringement Contentions, SMR asserted a pre-filing conception date of October 16–18, 2000 for its Asserted Patents. Thus, each prior art patent or publication identified above that was either filed or issued (for patents) or published (for publications) before October 16–18, 2000, necessarily constitutes evidence of prior invention pursuant to 35 U.S.C. § 102(g).

Additionally, although SMR has alleged that the Asserted Patents are entitled to a pre-filing conception date of October 16–18, 2000, it has not produced evidence that would suggest that any claim of the Asserted Patents is, in fact, entitled to such a pre-filing conception date, and based on the facts now known to it, Apple does not believe any such evidence exists. The earliest possible

priority date for the Asserted Patents, based on SMR's filings with the Patent and Trademark Office, is July 25, 2002. As a result, any prior art patent or publication identified above that was either filed or issued (for patents) or published (for publications) in the United States before July 25, 2002, necessarily constitutes evidence of prior invention pursuant to 35 U.S.C. § 102(g).

Further still, SMR's claim to a July 25, 2002, priority date for the Asserted Patents is based on the ability of the Asserted Patents to claim the benefit of the provisional filing date of U.S. Provisional Patent Application No. 60/398,077. As set forth below, however, the asserted claims are not entitled to claim the benefit of this priority date because U.S. Provisional Patent Application No. 60/398,077 does not satisfy the requirements of 35 U.S.C. § 112 with respect to such claims. Thus, each piece of prior art patent or publication identified above that was either filed or issued (for patents) or published (for publications before January 21, 2003), which is SMR's earliest claimed non-provisional filing date, constitutes evidence of prior invention pursuant to 35 U.S.C. § 102(g).

Further still, the asserted claims of at least the '223 and '648 Patents are invalid under 35 U.S.C. § 102(f) because, on information and belief, SMR, having not previously been in possession of the alleged inventions ultimately claimed therein, derived these claims from Apple's commercial products (such as Apple's AirPlay, Call Relay, and/or Continuity features) or the commercial products of one or more of Alphabet Inc. (f/k/a Google); Samsung Electronics Co., Ltd.; LG Electronics, Inc.; and Motorola Mobility LLC, and thereafter falsely claimed, during the prosecution of the '223 and '648 Patents, to have invented them.

II. OBVIOUSNESS

Claims are obvious, and therefore unpatentable, where "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would

have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a).

In *KSR Int’l Co. v. Teleflex Inc.*, the U.S. Supreme Court noted that the obviousness analysis must also allow for consideration of “the inferences and creative steps that a person of ordinary skill in the art would employ.” 550 U.S. 398, 418 (2007). The U.S. Supreme Court mandated that the obviousness analysis allow for “common sense” and “ordinary creativity” without necessarily requiring “precise teachings directed to the specific subject matter of the challenged claim[s].” *Id.* According to the U.S. Supreme Court, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. The U.S. Supreme Court also pointed out that “common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, [and] it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* at 418.

To the extent that applicable law requires evidence of motivation to combine, motivation exists to combine the references included in these Invalidity Contentions with each other. Generally, motivation to combine any of these references with others exists within the references themselves, as well as within the knowledge of those of ordinary skill in the art at the relevant time. Apple further contends that motivation to combine exists for all of the following categories of references:

- References which describe the same project or system;
- References written by or created by the same author(s) or inventor(s) regarding the same or related subject matter;
- References which specifically incorporate or refer to the teachings of another reference; and

- References addressing the same problem or seeking to reach the same objective—e.g., creating user or device identifiers in order to authorize software upgrades.

Appendix A provides exemplary citations for specific motivations to combine particular references or particular classes, groups, or types of references.

As set forth in Exhibits A1–D2, the asserted claims of the Asserted Patents are obvious over (a) the individual references described therein, taken alone; (b) the individual references described therein, in view of the background knowledge held by a person having ordinary skill in the art; and (c) the combinations of references disclosed therein. Apple may rely upon a subset of the references or all of the references depending upon the Court’s claim construction and Apple’s further investigation. Apple’s contentions that the references in Exhibits A1–D2, respectively, in the disclosed combinations, render the asserted claims of the Asserted Patents obvious under 35 U.S.C. § 103 are in no way an admission or suggestion that each reference does not independently anticipate the asserted claims under 35 U.S.C. § 102.

III. CHARTS SETTING FORTH APPLE’S THEORIES REGARDING ANTICIPATION AND OBVIOUSNESS OF THE ASSERTED PATENTS

As set forth above, each of the asserted claims of the Asserted Patents is anticipated by and/or obvious in view of one or more of items of prior art identified above. Apple has attached charts identifying the prior art that it contends anticipates and/or renders obvious the asserted claims of the Asserted Patents as follows:

- Exhibits A1–A6 provide Apple’s theories regarding how the references illustrated above anticipate or render obvious all asserted claims of the ’990 Patent;
- Exhibits B1–B6 provide Apple’s theories regarding how the references illustrated above anticipate or render obvious all asserted claims of the ’866 Patent;

- Exhibits C1–C2 provide Apple’s theories regarding how the references illustrated above anticipate or render obvious all asserted claims of the ’223 Patent;
- Exhibits D1–D2 provide Apple’s theories regarding how the references illustrated above anticipate or render obvious all asserted claims of the ’648 Patent; and
- Appendix A provides information about combinations of prior art references that render obvious certain limitations or elements present in the asserted claims of the Asserted Patents, as well as motivations to make the combinations in question.

Further still, the claims of the Asserted Patents contain multiple variations of the same elements, arranged in different groupings and permutations. Therefore, a reference or combination of references that renders obvious claims of one Asserted Patent also renders obvious claims of other Asserted Patents that include all, a subset, or a related set of limitations. By way of example, Exhibits A1–A6 and B1–B6 also provide theories regarding how the references illustrated therein anticipate or render obvious all asserted claims of the ’648 Patent; and Exhibits A1, A2, A4–A6, B1, B2, B4–B6, and D2 also provide theories regarding how the references illustrated therein anticipate or render obvious all asserted claims of the ’223 Patent.

The Court has not yet construed the asserted claims and, thus, has not determined whether the preambles of any of these claims are limiting. Apple’s statements herein should not be construed as taking a position as to whether the claim preambles are limiting. Apple reserves the right to take such a position at a later time, such as during claim construction. For the sake of

completeness, however, where asserted claims include substantive limitations within their preambles, Apple has addressed the preambles in its Invalidity Charts.

Each chart identifies by citation the disclosures within the prior art references that teach the relevant claim elements, limitations, and/or rationale supporting the combinations. While Apple has identified citations in the references for the claim limitations, each and every disclosure of the same limitation in the same reference is not necessarily identified. In an effort to focus the issues, Apple cites only the portions of the references that it presently deems most relevant, even when a reference may contain additional support for or disclosure of a particular claim element.

Where Apple cites a particular figure in a prior art reference, the citation should be understood to encompass any text referring or relating to that figure, in addition to the figure itself. Conversely, where a cited portion of text refers to a figure, the citation should be understood to include the figure as well.

Persons of ordinary skill in the art read a prior art reference as a whole, and in the context of other publications and literature. Apple may rely on portions of a charted reference that are not specifically cited at a later time to explain, clarify, or support its contentions regarding the disclosures of that reference. Apple may rely on portions of the prior art references that are not specifically cited, other publications, and expert testimony to provide context, and as aids to understanding and interpreting the portions of references that are cited. Apple may also rely on portions of the prior art references that are not specifically cited, other publications, and the testimony of experts to establish that a person of ordinary skill in the art would have been motivated to modify or combine certain of the cited references so as to render the claims obvious.

In addition, as set forth below, Apple contends that certain limitations of the asserted claims either are indefinite or are not enabled by any disclosure in the Asserted Patents. Apple's citations

to portions of a prior art reference as disclosing a claim limitation for obviousness purposes is not a concession that the limitation, as received in any of the Asserted Patents, is definite. In some cases, Apple's citations with respect to a limitation that Apple has elsewhere contended is indefinite identify prior art disclosures whose scope the parties do not dispute fall within the claim or would fall within the claim under any plausible interpretation thereof; the term may still be indefinite, however, because a person of skill would not be able to understand with reasonable certainty the term's outer bounds. In other cases, Apple's citations to prior art disclosures with respect to a limitation that Apple has elsewhere contended is indefinite are made based on SMR's apparent interpretation of the scope of the claim if it is not indefinite, with which Apple disagrees.

Further, Apple's citations to certain portions of a prior art reference as disclosing a claim limitation for obviousness purposes is not a concession that a disclosure in the '990, '866, '223, or '648 Patents with an equivalent level of detail did or would suffice to enable that element to a person of ordinary skill in the art. As an initial matter, a reference that anticipates the asserted claims of any of the '990, '866, '223, or '648 Patents is presumed to be enabled regardless of whether an equivalent disclosure in the asserted patent would have qualified as enabling. Further, most of the prior art references cited by Apple provide a more detailed disclosure than is present in the Asserted Patents, and, therefore, such references are enabling while the disclosures of Asserted Patents are not. For the remaining references, the citations in Exhibits A1–D2 show that, to the extent SMR contends that the disclosures of the Asserted Patents are enabling, the disclosures of the prior art are equally or more detailed and are therefore enabling as well.

IV. INELIGIBLE SUBJECT MATTER

The asserted claims of the Asserted Patents are each directed to patent-ineligible subject matter because each such claim is directed to an abstract idea and does not contain an inventive concept that amounts to substantially more than a claim directed to the abstract idea itself. The

claims are thus invalid under 35 U.S.C. § 101 and the two-step test set forth in *Alice Corp. v. CLS Bank International*, 573 U.S. 208, 217–18 (2014).

At *Alice* step one, the asserted claims of the Asserted Patents are generally directed to the abstract idea of identifying available recipients for routing media, alone or in combination with the further abstract idea of routing media to the identified recipients in some manner. The '223 and '648 Patents recite nothing more than receiving media content, like a phone call, at a mobile device and then identifying available devices nearby to route the media to. The additional limitations that the '990 and '866 Patents' claims add to this concept, such as transforming or cloning media before routing it, do nothing to move the claims beyond this general abstract idea. The Federal Circuit has repeatedly held claims about directing streams of audio or video data to a selected recipient to be abstract. *See, e.g., Two-Way Media v. Comcast Cable Communications*, 874 F.3d 1329 (Fed. Cir. 2017) (abstract claims required “functional results of ‘converting,’ ‘routing,’ [and] ‘controlling,’” but did “not sufficiently describe how to achieve these results in a non-abstract way”); *Affinity Labs of Texas, LLC v. Amazon.com, Inc.*, 838 F.3d 1266, 1269 (Fed. Cir. 2016) (“the concept of delivering user-selected media content to portable devices is an abstract idea”). District courts have also found claims directed to receiving audio or video streams and routing them to compatible recipients to be abstract. *24/7 Customer, Inc. v. LivePerson, Inc.*, No. 15-cv-02897-JST, 2017 WL 2311272, at *6 (N.D. Cal. May 25, 2017) (invalidating claims about “routing a call to ‘the best matched agent’” because “*any* potential solution . . . would involve” generic functions of “identifying the caller’s mode of communication and routing the call to an agent who uses the same form of communication”).

Further underscoring their abstractness, the asserted claims are analogous to a longstanding practice in the physical world. Specifically, SMR’s claims are analogous to a manager receiving a

customer's call and identifying which of her employees is in the office and is available and able to assist the customer. The manager either personally transfers the customer's call to the chosen employee (or a conference room with multiple employees) or asks a receptionist to help do so.

The Asserted Patents fare no better at *Alice* step two. Beyond the abstract idea of identifying available recipients for routing media, none of the claims recite any element or combination of elements beyond "well-known, routine, conventional activities previously known to the industry." *Alice*, 573 U.S. at 225 (quotation omitted). Rather, the claims recite only conventional elements, such as "mobile device[s]," that perform routine functions, such as "wirelessly communicating information" and "receiving" media. But adding "conventional steps, specified at a high level of generality," to an abstract idea does not make it patentable. *Alice*, 573 U.S. at 222. Not only do the asserted claims recite conventional components, but they combine them in a conventional way. Identifying available recipients before signaling them or routing media to them is a conventional order of steps for routing a phone call or media as shown by the longstanding practice of routing calls between colleagues in an office. Moreover, the Federal Circuit has found this order of steps to be conventional. *Two-Way Media*, 874 F.3d at 1339 (finding "first processing the data, then routing it" to be a "conventional ordering of steps"). Because the claims fail both steps of the *Alice* test, they are patent-ineligible and thus invalid under § 101.

Further details regarding Apple's defense relating to the unpatentability of the asserted claims of the Asserted Patents may be found in Apple's Motion to Dismiss Pursuant to Fed. R. Civ. P. 12(b)(6) and 35 U.S.C. § 101 (ECF. No. 21) and its Reply in support of that motion (ECF. No. 23), which Apple incorporates herein by reference. While Apple's Motion to Dismiss is directed specifically to the '223 and '648 Patents, the '990 and '866 Patents are directed to the same basic abstract idea, and the arguments in the Motion to Dismiss apply to them as well.

V. INDEFINITENESS

The asserted claims of the Asserted Patents are invalid under 35 U.S.C. § 112 as indefinite because they do not apprise, with reasonable certainty, a person of ordinary skill in the art at the time of the claimed invention of the scope of the claims. For completeness, in the Invalidity Charts, Apple has attempted to identify the disclosures that most closely correspond to SMR's apparent reading of those elements of the asserted claims that Apple contends are indefinite. Apple's identification of these disclosures corresponding to these limitations reflects Apple's best efforts to ascertain what SMR asserts that these limitations could possibly mean. This identification is not an admission that these elements are definite or that their metes and bounds could reasonably have been ascertained by a person of ordinary skill in the art.

The asserted claims of the '990 Patent are invalid as indefinite because they contain at least the following limitations:

- “an announcer device . . .”;
- “associated with said mobile communication device”;
- “surrounding equipment”;
- “thereby to enable receipt of rerouted data from said surrounding equipment”;
- “a scout device . . .”;
- “compatible equipment in the vicinity”;
- “thereby to reroute data from said mobile communication device to a selected one of said surrounding equipment”;
- “reroute data” / “rerouting”;
- “a media transformer, associated with said scout device, for transforming media into a form that accords with said determined media type requirements . . .”;
- “a plurality of types correspond[ing] to said media type requirements”;
- “allowing a user to select one of said media type requirements for transforming”;

- “a media cloner, associated with said media transformer, for making multiple copies of a single incoming data stream . . .”;
- “. . . operable to transmit at least status information to respective surroundings”;
and
- “a cellular telephone comprising the apparatus of claim 1.”

The asserted claims of the '866 Patent are invalid as indefinite because they contain at least the following limitations:

- “an announcer device . . .”;
- “thereby to enable receipt of rerouted data from said surrounding media handling devices”;
- “a scout device . . .”;
- “thereby to reroute streaming data between said streaming device and a selected one of said surrounding media handling devices”;
- “reroute data” / “rerouting”;
- “a media transformer, configured to transform media into a form that accords with respective determined media type requirements . . .”;
- “wherein there are a plurality of said types”;
- “. . . there being a plurality of said media type requirements”;
- “allowing a user to select one of said media type requirements for transforming”;
and
- “a media cloner, associated with said media transformer, for making multiple copies of a single incoming data stream, thereby to enable said apparatus to redirect said single incoming data stream to a plurality of locations, at least some of said multiple copies being transformed via said media transformer.”

The asserted claims of the '223 Patent are invalid as indefinite because they contain at least the following limitations:

- “a media data stream transmitted according to a streaming protocol”;
- “a plurality of devices, identified as compatible to handle said media content”;

- “wirelessly announce an availability for accepting a routed media via said local wireless communication network”;
- “said selected compatible device”;
- “. . . said selecting comprises carrying out a selection between devices found to be available, based on a predetermined user profile”;
- “transmitting said media content to a plurality of copies”;
- “a form that accords with a media type requirement of said selected device”;
- “before said causing said media data stream is constantly received and presented . . . before said scanning is performed”; and
- “a scouting detector adapted to”

The asserted claims of the '648 Patent are invalid as indefinite because they contain at least the following limitations:

- “available devices compatible to handle the media content”;
- “an intermediate routing device”;
- “indirectly routing messages or media content”;
- “the signaling received from the one or more device”; and
- “setting up a wireless communication link between the at least one of the one or more available devices.”

VI. LACK OF ENABLEMENT

The asserted claims of the Asserted Patents that are set forth below are invalid under 35 U.S.C. § 112 ¶ 1 because the specifications do not enable a person of ordinary skill in the art to practice the claims without undue experimentation. In particular, the specifications of the Asserted Patents do not enable the full scope that SMR has asserted those claims to have in its Infringement Contentions.

The asserted claims of the '990 Patent are invalid for lack of enablement because they contain at least the following limitations:

- “a mobile communication device comprising . . . an announcer device associated with said mobile communication device, and configured for indicating to surrounding equipment that said mobile communication device is available to receive rerouting, thereby to enable receipt of rerouted data from said surrounding equipment”;
- “a mobile communication device comprising . . . a scout device . . . configured for scanning surroundings . . . to identify and determine availability of compatible equipment in the vicinity, thereby to reroute data from said mobile communication device to a selected one of said surrounding equipment, wherein said rerouting comprises setting up a bidirectional communication link between said mobile communication device and said selected surrounding equipment . . . said bidirectional link carrying streaming data over both directions of said first link direction and said second link direction”;
- “a mobile communication device comprising . . . a media transformer, associated with said scout device, for transforming media into a form that accords with said determined media type requirements”;
- “a mobile communication device comprising . . . a media cloner, associated with said media transformer, for making multiple copies of a single incoming data stream”; and
- “a cellular telephone comprising the apparatus of claim 1.”

The asserted claims of the '866 Patent are invalid for lack of enablement because they contain at least the following limitations:

- “[an] apparatus being mobile and comprising . . . an announcer device configured to indicate to surrounding media handling devices that said streaming device is available to receive streaming data, thereby to enable receipt of rerouted data from said surrounding media handling devices”;
- “[an] apparatus being mobile and comprising . . . a scout device configured to scan surroundings of said streaming device to identify surrounding media handling devices as being compatible to handle given media . . . thereby to reroute streaming data between said streaming device and a selected one of said surrounding media handling devices . . . said apparatus configured to set up a bidirectional wireless communication link between said streaming device and a respective one of said media handling devices, said bidirectional link carrying streaming data over either direction as required of said bidirectional link”;
- “[an] apparatus being mobile and comprising . . . a media transformer, configured to transform media into forms that accord with respective determined media type requirements”; and

- “[an] apparatus being mobile and comprising . . . a media cloner, associated with said media transformer, for making multiple copies of a single incoming data stream, thereby to enable said apparatus to redirect said single incoming data stream to a plurality of locations, at least some of said multiple copies being transformed via said media transformer.”

The asserted claims of the '223 Patent are invalid for lack of enablement because they contain at least the following limitations:

- . . . “scan[ning] said local wireless communication network using said mobile device to identify a plurality of devices, identified as compatible to handle said media content, said plurality of devices are wirelessly connected to said local wireless communication network and wirelessly announce an availability for accepting a routed media via said local wireless communication network”;
- “selecting, based on a user interaction made with said mobile device and while said media data stream is streamed to said mobile device from said external source according to said streaming protocol, one of said plurality of devices;”
- “transmitting said media content to a plurality of copies so as to perform said routing to a number of said plurality of devices . . . wherein said selecting comprises carrying out a selection between devices found to be available, based on a predetermined user profile”;
- “a scouting detector adapted to scan said local wireless communication network to identify a plurality of devices, identified as compatible to handle said media content, said plurality of devices are wirelessly connected to said local wireless communication network and wirelessly announce an availability for accepting a routed media via said local wireless communication network”;
- “. . . wherein said mobile apparatus is one of a cell phone, a handheld device, and a personal digital assistant (PDA)”;
- “. . . wherein said media content is one of voice data, bidirectional voice data, bidirectional audio data, bidirectional video data, a game session, an interactive game session, a television broadcast, and a radio broadcast”; and
- “second program instructions executable by the processor to scan said local wireless communication network using said mobile device to identify a plurality of devices, identified as compatible to handle said media content, said plurality of devices are wirelessly connected to said local wireless communication network and wirelessly announce an availability for accepting a routed media via said local wireless communication network.”

The asserted claims of the '648 Patent are invalid for lack of enablement because they contain at least the following limitations:

- “using the mobile device for . . . wirelessly communicating information to an intermediate routing device connected to the LAN for indirectly routing messages or media content to at least one of the one or more available devices via said intermediate routing device”;
- “using the mobile device for . . . wirelessly signaling the one or more available devices indicating an availability of a media content at the mobile device”;
- “. . . routing the phone call to the one or more available devices while the phone call is ongoing using the mobile device”;
- “[a] mobile apparatus . . . comprising . . . wherein the controller is adapted to wirelessly signaling the one or more available devices indicating an availability of the media content at the mobile device”;
- “. . . wherein the media content is audio content selected from a group consisting of: a phone call data, bidirectional voice data, bidirectional audio data and a radio broadcast;” and
- “second program instructions executable by the processor to wirelessly receive signal from the mobile device indicating an availability of a media content at the mobile device.”

VII. LACK OF WRITTEN DESCRIPTION

Apple contends that the asserted claims of the Asserted Patents that are set forth below are invalid under 35 U.S.C. § 112 ¶ 1 because the specifications of those patents do not describe the claimed alleged invention in sufficient detail that one skilled in the art can reasonably conclude that the named inventor had possession of the claimed alleged invention, based on SMR’s apparent interpretation of those claims, as reflected in its May 17, 2024, Infringement Contentions.

The asserted claims of the '990 Patent are invalid for lack of written description because they contain at least the following limitations:

- “compatible equipment in the vicinity”;
- “said scout device is operable to determine media type requirements of said compatible equipment”;

- “a form that accords with said determined media type requirements”;
- “a plurality of types correspond to said media type requirements”; and
- “a user interface for allowing a user to select one of said media type requirements.”

The asserted claims of the '866 Patent are invalid for lack of written description because they contain at least the following limitations:

- “a scout device configured to scan surroundings . . . to identify surrounding media handling devices as being compatible to handle given media”;
- “said scout device further being configured to determine media type requirements of said compatible media handling devices”;
- “to transform media into forms that accord with respective determined media type requirements”;
- “a plurality of said types” / “a plurality of said media type requirements”; and
- “a user interface for allowing a user to select one of said media type requirements for transforming”

The asserted claims of the '223 Patent are invalid for lack of written description because they contain at least the following limitations:

- “a media data stream transmitted according to a streaming protocol”;
- “scanning said local wireless communication network using said mobile device to identify a plurality of devices, identified as compatible to handle said media content”;
- “selecting, based on a user interaction made with said mobile device and while said media data stream is streamed to said mobile device from said external source according to said streaming protocol, one of said plurality of devices;”
- “causing a routing . . . via said wireless communication link for streaming said media data stream according to said streaming protocol”;
- “transmitting said media content to a plurality of copies”;
- “wherein said setting up compris[es] transforming said media content into a form that accords with a media type requirement”;

- “. . . wherein before said causing said media data stream is constantly received and presented by said mobile device while being delivered by said external source before said scanning is performed”;
- “wherein said controller is adapted to instruct the routing of said media stream content to said selected device via said wireless communication link for streaming said media data stream according to said streaming protocol”;
- “. . . wherein said media content is one of voice data, bidirectional voice data, bidirectional audio data, bidirectional video data, a game session, an interactive game session, a television broadcast, and a radio broadcast”; and
- “third program instructions executable by the processor to select, based on a user interaction made with said mobile device and while said media data stream is streamed to said mobile device from said external source according to said streaming protocol . . .”; and
- “fifth program instructions executable by the processor to cause a routing of said media data stream of media content to said selected device via said wireless communication link streaming said data stream of media content according to said streaming protocol . . .”

The asserted claims of the '648 Patent are invalid for lack of written description because they contain at least the following limitations:

- “identifying one or more available devices compatible to handle the media content and connected to the LAN”;
- “wirelessly communicating information to an intermediate routing device connected to the LAN for indirectly routing messages or media content to at least one of the one or more available devices via said intermediate routing device”;
- “setting up a wireless communication link between the at least one of the one or more available devices based on a user interaction made with the mobile device or the one or more available devices”;
- “a controller adapted to identify one or more available devices connected to a local area network (LAN) and compatible to handle the media content”;
- “wherein the controller is adapted to instruct communicating wirelessly information to an intermediate routing device connected to the LAN for indirectly routing messages or media content to at least one of the one or more available devices via said intermediate routing device”;

- “. . . wherein the media content is audio content selected from a group consisting of: a phone call data, bidirectional voice data, bidirectional audio data and a radio broadcast”; and
- “first program instructions executable by a processor to wirelessly communicating information to an intermediate routing device connected to a local area network (LAN) for indirectly receive messages or media content routed from one or more available devices connected to the LAN via the intermediate routing device.”

VIII. PRIORITY

Although the Asserted Patents each claim priority to United States Provisional Patent Application No. 60/398,077 (“the ’077 Provisional”), filed July 25, 2002, the asserted claims are not entitled to the priority date of the ’077 Provisional because each such claim contains one or more limitations that are not described by the ’077 Provisional in a manner sufficient to enable a person of ordinary skill in the art to practice the claimed invention without undue experimentation. These limitations include the limitations identified in Section VI above. Further, the asserted claims are not entitled to the priority date of the ’077 Provisional because each such claim contains one or more limitations that are not described by the ’077 Provisional in a manner sufficient to convey to a person of ordinary skill in the art that the inventors were in possession of the invention claimed. These limitations include the limitations identified in Section VII above.

Further, to the extent SMR relies on the originally-filed claims (or such claims as subject to any preliminary amendment entered concurrently with filing) of the nonprovisional applications that ultimately issued as the ’866 and ’648 Patents as providing written description support for any limitation or element claimed, or as providing support for the asserted breadth of any limitation or element claimed, the claims in question are not entitled to claim priority to any earlier-filed application. In such a case, the following Apple products qualify as prior art to the asserted claims under pre-AIA 35 U.S.C §§ 102(a), (b), and (g) and render those claims invalid based on SMR’s interpretation of the claims as set forth in its May 17, 2024, Infringement Contentions:

- (1) AirPlay, as implemented in, for instance, iOS versions 4.2 and 5 on the iPhone 4S, with respect to the asserted claims of the '866 Patent; and
- (2) AirPlay, as implemented in, for instance, iOS versions 5 through 10 on the iPhone 4S, 5, 5S, 6 / 6 Plus, 6S / 6S Plus, SE, and 7 / 7 Plus, with respect to the asserted claims of the '648 Patent.

IX. DOCUMENT PRODUCTION

Pursuant to the Court's Scheduling Order, Apple has already produced or is producing herewith the following documents:

- All prior art referenced in Apple's Invalidity Contentions: These documents have been produced at Bates numbers APL-SMR_00000435–APL-SMR_00002202; and
- Technical documents sufficient to show the operation of the accused products: Documents sufficient to show the operation of the functionality SMR has accused of infringement have been produced at Bates numbers APL-SMR_00000019–APL-SMR_00000434 and APL-SMR_00002203–APL-SMR_00002268. Apple's production is based on its present understanding of the functionalities and features SMR is attempting to accuse of infringement, as set forth in SMR's May 17, 2024, Infringement Contentions. The nature and detail of the information Apple has produced to date is commensurate with the detail provided in SMR's May 17, 2024, Infringement Contentions. Apple reserves the right to supplement its production when additional information regarding SMR's contentions becomes available to it, including through discovery, through supplements or updates to SMR's contentions, or through the production of expert reports by SMR.

Date: July 17, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that on July 17, 2024, the foregoing document was served upon all counsel of record via electronic mail.

/s/ Michael T. Pieja
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