

1 Christopher E. Hanba (admitted *pro hac vice*)

Email: chanba@dickinson-wright.com

2 Joshua G. Jones (admitted *pro hac vice*)

Email: jjones@dickinson-wright.com

3 DICKINSON WRIGHT PLLC

4 607 W. 3rd Street, Suite 2500

Austin, Texas 78701

5 Telephone: (512) 770-4200

Facsimile: (844) 670-6009

6 Eric M. Schiffer

7 Email: eschiffer@schifferapc.com

8 SCHIFFER, APC

7545 Irvine Center Drive, Suite 200

9 Irvine, California 92618

Telephone: (949) 533-0485

10 *Attorneys for Plaintiff*

11 *Jonathan E. Jaffe*

12 **UNITED STATES DISTRICT COURT**
13 **CENTRAL DISTRICT OF CALIFORNIA**
14 **SOUTHERN DIVISION**

15 JONATHAN E. JAFFE,

16 Plaintiff,

17 v.

18 ADOBE INC.,

19 Defendant(s).

Case No. 2:23-cv-06224-JWH(MAAX)

20 **PLAINTIFF'S RESPONSIVE CLAIM**
21 **CONSTRUCTION BRIEF**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	ARGUMENT	1
A.	Disputed Terms	1
1.	“a sensor, which is tightly coupled to said memory”	1
2.	“monitoring the integrity of the tight coupling between said memory and said sensor”	4
3.	“said data stream”	5
4.	“appended to said data file”	5
5.	“based on”	6
6.	“said at least one additional parameter being generally representative of a condition under which said data stream was generated”	8
7.	“CamID”	8
8.	“Seq”	9
III.	CONCLUSION	9

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Advanced Aerospace Techs., Inc. v. United States</i> , 124 Fed. Cl. 282 (2015)	8
<i>Andersen Corp. v. Fiber Composites, LLC</i> , 474 F.3d 1361 (Fed. Cir. 2007).....	6
<i>Brooktree Corp. v. Advanced Micro Devices, Inc.</i> , 977 F.2d 1555 (Fed. Cir. 1992).....	7
<i>Classified Cosms., Inc. v. Del Lab'ys, Inc.</i> , 208 F. App'x 939 (Fed. Cir. 2006)	7
<i>DuraSystems Barriers Inc. v. Van-Packer Co.</i> , No. 119-CV-01388-SLD-JEH, 2021 WL 4037826 (C.D. Ill. Sept. 3, 2021)	2
<i>In re Fout</i> , 675 F.2d 297 (CCPA 1982)	7
<i>Myco Indus., Inc. v. BlephEx, LLC</i> , 955 F.3d 1 (Fed. Cir. 2020)	6
<i>O2 Micro International, Ltd. v. Beyond Innovation Technology Co.</i> , 521 F.3d 1351 (Fed.Cir.2008).....	1, 5
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005).....	5, 7
<i>Receivership Est. of AudienceScience Inc. v. Google LLC</i> , No. 5:22-CV-04756-EJD, 2023 WL 8720139 (N.D. Cal. Dec. 18, 2023)	2, 3
<i>Salazar v. AT&T Mobility LLC</i> , 64 F.4th 1311 (Fed. Cir. 2023)	5
<i>Scripps Clinic & Research Found. v. Genentech, Inc.</i> , 927 F.2d 1565 (Fed.Cir.1991).....	6
<i>Summit 6, LLC v. Samsung Elecs. Co.</i> , 802 F.3d 1283 (Fed. Cir. 2015).....	5
<i>Techno View IP, Inc. v. Oculus VR, LLC</i> , 2018 WL 4141032 (D. Del. Aug. 30, 2018)	5
<i>Teleflex, Inc. v. Ficosa N. Am. Corp.</i> , 299 F.3d 1313 (Fed. Cir. 2002).....	4

1	<i>W.L. Gore & Associates, Inc. v. Garlock, Inc.</i> ,	
2	842 F.2d 1275, (Fed.Cir.1988).....	8

1 **I. INTRODUCTION**

2 Adobe has not met its burden to demonstrate that any of the eight disputed claim terms
 3 require a construction by the Court and has certainly failed to demonstrate by clear and convincing
 4 evidence that four of the disputed terms are indefinite. Adobe relies on its expert to argue that
 5 certain terms are infinite, which Jaffe has demonstrated should not be decided during claim
 6 construction, and also argues that its constructions will clarify terms for the jury. However,
 7 nowhere does Adobe even argue that the patentees has acted as their own lexicographer or have
 8 disavowed the full scope of the claims. Adobe also failed to demonstrate any dispute as to claim
 9 scope under *O2 Micro* that would necessitate a construction by this Court. *See O2 Micro*
 10 *International, Ltd. v. Beyond Innovation Technology Co.*, 521 F.3d 1351 (Fed.Cir.2008).
 11 Therefore, Adobe’s indefiniteness arguments and alternative constructions should be rejected and
 12 the disputed terms should be given their plain and ordinary meaning.

13 **II. ARGUMENT**

14 **A. Disputed Terms**

15 **1. “a sensor, which is tightly coupled to said memory”**

16 Defendant’s brief makes clear that its arguments are more appropriate for summary
 17 judgment rather than claim construction. Defendant heavily relies on its expert, Dr. Surati, to
 18 support its arguments of indefiniteness as to this term. For example, Dr. Surati states that “tightly
 19 coupled” is not a term of art and that a POSITA “would not be able to ascertain with reasonably
 20 certainty the point at which a sensor that is ‘coupled’ to a memory becomes ‘tightly coupled.’”
 21 Adobe Br. at 12. Dr. Surati further admits, in describing the prosecution history of the ’828 Patent
 22 that “[a] person of ordinary skill in the art might understand this passage to mean that the processor
 23 and memory are ‘tightly coupled’ because they are connected by conductive traces or leads, but
 24 such a person would not understand this to define the full scope of the term.” *Id.* at 16. There is
 25 no support or evidence for these statements beyond Dr. Surati’s opinion. As Plaintiff argued in its
 26 opening brief, indefiniteness considerations should be determined at the summary judgment stage
 27 where the defendant relies on expert testimony rather than the specification alone given the
 28

1 evidentiary considerations of indefiniteness and the fact that indefiniteness must be demonstrated
 2 by clear and convincing evidence. Jaffe Br. at 4. Given Adobe’s reliance on expert testimony for
 3 its argument that a POSITA could not ascertain when a sensor that is coupled to memory become
 4 tightly coupled, or that a POSITA would could not understand that a memory and sensor coupled
 5 by conductive traces or leads as defining the full scope of the term, Adobe’s indefiniteness
 6 arguments would be more properly considered during summary judgment. *DuraSystems Barriers*
 7 *Inc. v. Van-Packer Co.*, No. 119-CV-01388-SLD-JEH, 2021 WL 4037826, at *6 (C.D. Ill. Sept.
 8 3, 2021).

9 Moreover, Adobe has not demonstrated that this term is indefinite by clear and convincing
 10 evidence. Defendant supports its position with two primary arguments. First, Defendant asserts
 11 that “tightly coupled” is a term of degree and there is nothing in the claims or specification to
 12 enable a POSITA to determine when a sensor coupled to memory becomes “tightly coupled” to
 13 memory. However, Defendant’s argument demonstrates that “tightly coupled” is not a term of
 14 degree at all. As Defendant argues, either components are tightly coupled or they are coupled.
 15 There is no degree such as a loose coupling and Defendant does not argue there is. The patent
 16 specification makes this clear by describing that “[t]here can be nothing that can possibly alter the
 17 recording before the authentication information is generated.” ’828 Patent at 3:18-20. The file
 18 history supports the specification by stating “[t]here can be nothing that can possibly alter the
 19 recording before the authentication information is generated.” Jaffe Br. at Ex. B Jaffe-
 20 ADOBE000311. These scenarios obviously differ from a mere coupling where an image can be
 21 altered prior to the authentication information being generated.

22 This Court has recognized that even facially descriptive terms (such as “similar” and “too
 23 early” and “late enough”) may not be “true term[s] of degree based on the patent’s specific
 24 context.” *Receivership Est. of AudienceScience Inc. v. Google LLC*, No. 5:22-CV-04756-EJD,
 25 2023 WL 8720139, at *7 (N.D. Cal. Dec. 18, 2023). For example, in *Receivership*, this Court
 26 found “recently” to not be a term of degree because the term was “not being used in isolation as
 27 descriptive terms conveying general temporal recency; instead, they are mentioned in the context
 28 of compiling a user's browsing or page request history.” *Id.* The Court also cited the Federal

1 Circuit, which held that the term “similar” was not a term of degree where it was not used “in
2 isolation as a term of degree but in the context of a self-referential or self-repeating geometric
3 pattern for configuring microphones in an array.” *Id.* citing *ClearOne, Inc. v. Shure Acquisition*
4 *Holdings, Inc.*, 35 F.4th 1345 (Fed. Cir. 2022). Likewise, in this case, “tightly coupled” is not
5 used as a term of degree in isolation, but instead in the context of determining whether the sensor
6 and memory are coupled in such a way the data stream cannot be altered before authentication
7 information is generated.

8 However, even if “tightly coupled” is a term of degree, a POSITA can easily determine
9 when a sensor is tightly coupled to memory in the context of the claims. As described above,
10 Defendant’s own expert admits that the prosecution history describes a sensor and memory being
11 tightly coupled when connected via conductive traces or leads. Defendant and its expert also cited
12 the specification and prosecution history which support that a sensor is tightly coupled to memory
13 where the data stream cannot be altered before authentication information is generated. Adobe Br.
14 at 13, 16.

15 Defendant’s second argument is that the above-cited specification and prosecution history,
16 which support the position that a sensor is tightly coupled to a memory when they are coupled
17 such that the data stream cannot be altered before authentication information is generated, cannot
18 be correct because the claims themselves supposedly contemplate that the tight coupling must be
19 monitored and is also capable of being compromised. *Id.* at 16. Defendant misunderstands the
20 claim language. Claim 1 of the ’828 Patent first describes that the invention utilizes a “sensor,
21 which is tightly coupled to said memory, to generate at least one internal and unique parameter.”
22 ’828 Patent at 20:62-64. This “tight coupling” is monitored and cannot be altered before
23 authentication information is generated. This is described in the next step of Claim 1 which states
24 “monitoring the integrity of the tight coupling between said memory and said sensor when said at
25 least one internal and unique parameter is generated, and, if said integrity is compromised, then
26 also providing an indication of said compromised integrity.” *Id.* at 20:65-21:2. The “at least one
27 internal and unique parameter,” as described through the rest of ’828 Patent, is authentication
28 information. Therefore, Claim 1 describes that it is monitoring the tight coupling to see if the data

1 stream is being altered *after* the authentication information is generated. In other words Claim 1
 2 describes: 1) a sensor and memory that are tightly coupled and thus coupled in such a way that the
 3 data stream cannot be altered before the authentication information is generated; 2) the integrity
 4 of this tight coupling is monitored when the authentication information is generated, and if the
 5 integrity is compromised, then an indication of compromised integrity is provided. Claim 1 does
 6 not describe monitoring the integrity of the tight coupling *before* the authentication information is
 7 generated and is thus wholly consistent with the specification and prosecution history.

8 As argued above, Adobe has not met its burden of demonstrating the indefiniteness of this
 9 term by clear and convincing evidence. While Adobe argues that Jaffe has failed to show that no
 10 construction is necessary for this term, and has not provided extrinsic evidence or expert testimony
 11 to support his position, it is Adobe’s burden to demonstrate that construction is necessary, which
 12 it has not done. *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002) (there
 13 is a “heavy presumption that a claim term takes on its ordinary meaning”). Furthermore, Adobe
 14 provides no argument to support its alternative construction simply stating that it “is consistent
 15 with the specification and the applicants’ statements during prosecution, and it would provide
 16 some means of understanding this inherently uncertain term.” Adobe Br. at 17. As Jaffe
 17 demonstrated in his opening brief, Adobe’s construction simply removes “tightly” from the term,
 18 substitutes “coupled” for “connection,” and improperly imports a limitation that the sensor and
 19 memory be connected “within a device.” Jaffe Br. at 6. Therefore, Adobe’s alternative
 20 construction should be rejected and this term should require no construction.

21 **2. “monitoring the integrity of the tight coupling between said memory** 22 **and said sensor”**

23 The Parties recognize that the Court’s indefiniteness ruling as to the “tightly coupled” term
 24 will determine whether this term is indefinite as well. However, Jaffe points out that Adobe has
 25 provided no argument to support its alternative construction “determining whether physical access
 26 has been gained to the connection between said memory and said sensor.” As Jaffe argued in his
 27 opening brief, Adobe’s proposal imports limitations and unnecessarily substitutes words such that
 28

1 the construction will only serve to confuse the jury. Given Adobe has offered no argument in
2 support, its proposed construction should not be adopted.

3 **3. “said data stream”**

4 Defendant confirms in its brief that there is no reason to construe this term. Adobe
5 proposes that its “construction merely clarifies that each reference to ‘said data stream’ refers back
6 to the ‘data stream’ that was stored in the first step of the method.” Adobe Br. at 18. Again, Adobe
7 has not identified a dispute as to claim scope under *O2 Micro* as to the scope of the term “said data
8 stream” and has not identified any other reason under *Phillips* that this term requires a construction.
9 In the cases that Adobe cites, there is a dispute between the parties as to the scope of the claims
10 which requires clarification of what the “said” term indicates. For example, in *Salazar v. AT&T*
11 *Mobility LLC*, there was a dispute as to whether there were multiple microprocessors that were
12 each capable of performing a different claimed function. 64 F.4th 1311, 1315 (Fed. Cir. 2023). In
13 *Summit 6, LLC v. Samsung Elecs. Co.*, while recognizing that “said” terms are anaphoric phrases,
14 the Federal Circuit affirmed the district court’s decision declining to construe the term that
15 contained the “said client device” phrase because the term was “comprised of commonly used
16 terms; each is used in common parlance and has no special meaning in the art . . . [and therefore]
17 the plain and ordinary meaning of the disputed claim language is clear.” 802 F.3d 1283, 1291
18 (Fed. Cir. 2015). And in *Techno View IP, Inc. v. Oculus VR, LLC*, the Court simply settled the
19 parties’ dispute as to whether “storing” and “determining” steps of a method claim had to occur in
20 the order recited in the claims. 2018 WL 4141032, at *3 (D. Del. Aug. 30, 2018).

21 In this case, Adobe has not identified a similar dispute as to claim scope and the terms are
22 clear on their face. Adobe’s addition of “stored previously,” will only serve to confuse the jury
23 because there is no baseline as to what was previously stored or when it was previously stored. In
24 other words, the data stream was stored previously to what? Adobe’s construction provides no
25 answer and should therefore be rejected.

26 **4. “appended to said data file”**

27 There is no support for Adobe’s proposed construction which changes the clear meaning
28 of the word “appended” to “contained in.” There is no support for Adobe’s position that “the

1 patent specification repeatedly and uniformly states that the first signature is stored in the same
 2 data file as the data stream.” Adobe Br. at 20. In support, Adobe cites the ’828 Patent at 7:27-30,
 3 which states the “digital signature 132 . . . is computed and made part of the file.” But, being
 4 “made part of the file” is not the same thing as being “contained in the same data file.”

5 Adobe’s other citations to the specification all refer to Figure 7A and the Signa2
 6 embodiment. But, this term should not be limited to the Signa2 embodiment. *Myco Indus., Inc.*
 7 *v. BlephEx, LLC*, 955 F.3d 1, 15 (Fed. Cir. 2020) (“claim construction...focuses on the recited
 8 limitations of the claims, not on the features of a commercial embodiment of the invention.”).
 9 Indeed, Adobe’s proposed construction is inconsistent with Figure 7A, which does not describe
 10 any digital signature being contained within the data file and, instead, describes information, such
 11 as the random string, which can be a part of the digital signature in some embodiments, as being
 12 “made part of the file.” *Id.* at 8:55-56; 20:23-26.

13 While Adobe complains that the “appended to” language is ambiguous because “it could
 14 mean, for example, that the first signature is included in the data file (i.e. added to the file) or that
 15 it is attached to the file somehow” that is precisely what the plain meaning of “append” is. *See*
 16 Ex. A, <https://www.merriam-webster.com/dictionary/append>. Adobe has not met its burden to
 17 demonstrate that Jaffe acted as his own lexicographer to change the plain meaning of “appended
 18 to” to “contained in.” In fact, the specification supports the plain meaning. Therefore, Adobe’s
 19 construction should be rejected.

20 **5. “based on”**

21 Adobe argues the “based on” limitation is indefinite for two reasons, both presented
 22 through its expert: 1) “based on” is an open-ended term and 2) Claim 1 cannot be rewritten to
 23 avoid indefiniteness. As to the first point, “[o]pen-ended claims are not inherently improper; as
 24 for all claims their appropriateness depends on the particular facts of the invention, the disclosure,
 25 and the prior art.” *Andersen Corp. v. Fiber Composites, LLC*, 474 F.3d 1361, 1376 (Fed. Cir.
 26 2007) quoting *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1572
 27 (Fed.Cir.1991). Furthermore, Adobe’s expert, Dr. Surati, makes clear that he understands that the
 28 second signature is “based on” not only the data stream but on other inputs as well. Adobe Br. at

23. Dr. Surati also made clear in his expert report that “the term ‘based on’ must mean that the second signature is generated using at least the data stream, but potentially other data (e.g., the same parameter(s) used for the first signature).” Jaffe Br., Ex. B at ¶ 83. These parameters are clearly described in the specification as “representative of at least one condition under which the digital sample was acquired.” ’828 Patent at 1:54-57. The specification then provides several examples of a parameter such as “date, time, latitude, longitude, altitude, roll, pitch, yaw, and compass heading, [as well as] camera identification, image sequence number, flash status, lens zoom factor, counter vibration status, focus status and focus quality.” *Id.* at 2:67-3:6. A POSITA would clearly understand this term in the context of the claims and the specification, as illustrated by Dr. Surati, and therefore this term is not indefinite.

As to Adobe’s second argument, the claim does not require being rewritten as Dr. Surati’s understanding of the “based on” term demonstrates. While Adobe asks that Claim 1 be read in isolation, the claim “must always be read in light of the specification.” *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) quoting *In re Fout*, 675 F.2d 297, 300 (CCPA 1982). The specification makes clear that the second signature is based on the same parameters as the first signature. The specification describes that the “sample is stored in memory together with the at least one parameter and the digital signature.” ’828 Patent at 1:57-59. This describes the first signature in Claim 1. The specification goes on to describe the second signature, which is the authenticating signature: “Authenticity of the stored image is determined by creating a new signature from the stored image *and at least one parameter*, and then comparing the two signatures to determine if they are the same.” *Id.* at 59-62. (emphasis added).

Adobe’s argument that the second signature cannot be “based on” the same parameters as the first signature because this would render the claim inoperable is misplaced because such arguments go to failure of the patent to meet the utility or enablement requirements of the patent statute. *Classified Cosms., Inc. v. Del Lab’ys, Inc.*, 208 F. App’x 939, 941 (Fed. Cir. 2006); *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed. Cir. 1992) (“If the claimed subject matter is inoperable, the patent may indeed be invalid for failure to meet the utility requirement of § 101 and the enablement requirement of § 112.”).

1 Given the specification's clear teaching that the second signature is based on the data
 2 stream and the at least one parameter, and Adobe's expert's clear demonstration of his
 3 understanding that the second signature is based on these same inputs, this term is not indefinite.

4 **6. "said at least one additional parameter being generally representative
 5 of a condition under which said data stream was generated"**

6 Defendant provides only its expert, Dr. Surati, to argue that this term is indefinite and the
 7 argument is simply that Dr. Surati disagrees that CamID and Seq can be a "parameter being
 8 generally representative of a condition under which said data stream was generated." Defendant
 9 does not argue that the eight other parameters specifically mentioned in Claim 5 (GPS coordinates,
 10 zoom settings, AutoFocus status, focus quality sampling, roll, pitch and yaw values, compass
 11 headings, flash status, and a Security Value) can be such parameters. But Adobe argues because
 12 its expert disagrees that CamID and Seq can be such parameters, the term must be indefinite. Even
 13 if Adobe's premise is correct that CamID and Seq are not such parameters (and Adobe has
 14 presented no intrinsic support for this position while only citing its expert's conclusory opinion)
 15 Adobe cites no analogous case where the patentee has provided numerous concrete examples to
 16 support a term but the term was nevertheless indefinite because an example was found not to
 17 support the term.

18 Whether CamID and Seq are parameters "being generally representative of a condition
 19 under which said data stream is generated" is "an issue of infringement, not claim indefiniteness."
 20 *Advanced Aerospace Techs., Inc. v. United States*, 124 Fed. Cl. 282, 306 (2015) (citing *W.L. Gore*
 21 *& Assocs., Inc. v. Garlock, Inc.*, 842 F.2d 1275, (Fed. Cir. 1988) (holding that whether a 50-degree
 22 or 60-degree angle falls outside of the scope of "generally vertical" or "generally perpendicular"
 23 as an issue of infringement, not indefiniteness)). Dr. Surati provides no explanation for why these
 24 examples cannot be parameters that are "representative of a condition under which said data stream
 25 is generated." Therefore, Adobe's non-infringement position should be rejected.

26 **7. "CamID"**

27 Adobe again does not meet its burden to demonstrate that this term requires a construction.
 28 Adobe also offers no support for its importation of a limitation that the CamID must be "set by the

1 manufacturer.” CamID is described in the specification as “camera identification” (Figure 2A),
 2 “camera identifier” (6:60), and “camera identification code” (8:36). While two of the examples
 3 state that the CamID is “set at the factory,” this is not the same as “set by the manufacturer” and
 4 the specification and claims do not expressly limit the CamID to being set by the factory. *Id.* at
 5 6:60-61, 8:36-37. Defendant has not demonstrated why CamID would not be readily
 6 understandable by a jury and its construction should therefore be rejected.

7 **8. “Seq”**

8 Defendant’s construction of Seq should be rejected because it limits Seq to an image
 9 sequence. However, the specification does not indicate that the Seq is so limited. One example
 10 of “Seq 120 is the sequence number for unique image identification, automatically incremented.”
 11 Ex. A at 8:41-44. The Seq could therefore be any sequence number used for unique image
 12 identification. Figure 2A further describes Seqnum as a “sequence number” rather than an “image
 13 sequence number” and Figure 6 describes “append Sequence Number to Image” when discussing
 14 the Seq. Therefore, the full scope of the Seq to which Plaintiff is entitled encompasses more than
 15 an image sequence number. Again, the Seq is expressly described in the claims and requires no
 16 further construction to aid the jury. Therefore, Defendant’s construction should be rejected.

17 **III. CONCLUSION**

18 For the foregoing reasons, the Court should find the disputed terms have their plain and
 19 ordinary meaning and require no express construction, reject Defendant’s constructions, and find
 20 that none of the disputed claim terms are indefinite.

1 Dated: July 1, 2024

Respectfully submitted,

2 DICKINSON WRIGHT PLLC

3 /s/ Christopher E. Hanba

Christopher E. Hanba (*pro hac vice*)

chanba@dickinsonwright.com

Joshua G. Jones (*pro hac vice*)

jjones@dickinsonwright.com

DICKINSON WRIGHT PLLC

607 W. 3rd Street, Suite 2500

Austin, Texas 78701

Telephone: (512) 770-4200

Facsimile: (844) 670-6009

Eric M. Schiffer

eschiffer@schifferapc.com

SCHIFFER, APC

7545 Irvine Center Drive, Suite 200

Irvine, CA 92618

Telephone: (949) 533-0485

Attorneys for Plaintiff

Jonathan E. Jaffe

15 **CERTIFICATE OF SERVICE**

16 I hereby certify that on July 1, 2024, I caused the foregoing to be served on counsel of
17 record for Plaintiffs and Counter-Defendants by electronic mail.

19 Dated: July 1, 2024

/s/ Christopher E. Hanba

Christopher E. Hanba