

**UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK**

VARIA HOLDINGS LLC,

Plaintiff,

v.

APPLE INC.,

Defendant.

Case No. 1:23-cv-07477-RPK-RML

JURY TRIAL DEMANDED

**ORAL ARGUMENT REQUESTED
SERVICE DATE: 6/11/2024**

VARIA HOLDINGS LLC'S OPENING CLAIM CONSTRUCTION BRIEF

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I. INTRODUCTION

The claims of a patent define its scope. In general, the terms used in those claims—the words the inventor chose and the Patent Office approved—should be given their ordinary meaning. While that meaning is informed by how persons skilled in the art would understand those words in light of the intrinsic record—*i.e.*, the context of the claims, the teaching of the specification, and the prosecution history at the Patent Office—the words of the claims themselves still control. It is a bedrock patent law principle that other terms in the specification, and prosecution history arguments that the Patent Office expressly rejected, cannot be forced into the claims to limit the invention. Nor may the scope of the patents be limited to only the exemplary embodiments shown in the specification.

Apple’s claim construction proposals violate these principles by attempting to rewrite and limit the claims to manufacture an infringement defense where none otherwise exists. Apple attempts to rewrite “transceiver,” “transmitter,” and “communication circuitry” to be limited to only a ***single component*** based on rejected prosecution history arguments. Apple further attempts to rewrite various “output” limitations to require ***automatic*** output based on an exemplary embodiment. At heart, Apple’s proposals all embody the same flaw— improperly limiting the claims to deny the terms their ordinary meaning to attempt to distinguish Apple’s accused products. This is improper: “the role of a district court in construing claims is not to redefine claim recitations or to read limitations into the claims to obviate factual questions of infringement and validity but rather to give meaning to the limitations actually contained in the claims.” *Am. Piledriving Equip., Inc. v. Geoquip, Inc.*, 637 F.3d 1324, 1331 (Fed. Cir. 2011). And where the meanings of claim terms are understandable on their face, no construction is needed. Varia submits the Declaration of Jacob Sharony, Ph.D. (“Sharony Decl.”), an expert in radio frequency identification (“RFID”), in support of its claim constructions.

II. BACKGROUND AND TECHNOLOGY OVERVIEW

Varia asserts that Apple infringes multiple claims of U.S. Patent Nos. 8,127,984 (“the ’984

Patent” (Ex.1)), 8,381,974 (“the ’74 Patent” (Ex. 2)), and 9,405,947 (“the ’947 Patent” (Ex. 3)) (collectively, “Asserted Patents”).¹ As described below, the inventions claimed in the Asserted Patents relate to a mobile communications device that can perform telephony and emulate RFID tags.

A. The Patented Inventions Replaced Prior Art RFID Tags with RFID Emulation

Radio frequency identification, or RFID, is a wireless identification technology that can be used wherever identification and/or verification is required. This includes financial transactions such as using a credit card, granting physical access such as opening a door lock, or enabling use such as starting an automobile. In the prior art, this was accomplished by embedding RFID transponders (often called “tags”), into objects such as credit cards, keycards and car keys.

Transponders—derived from a combination of “transmitter” and “responder”—were relatively simple circuits that when placed within a radio field would output a unique identifier. An RFID reader would read the tag by emitting a wireless signal. If the RFID transponder was close enough to the reader, the RFID transponder would send its unique identifier, thereby initiating the payment transaction, access, or other authorization. Prior art RFID transponders were isolated simple circuits that were not integrated with any device electronics, and often required no internal power source—the radio signal from the reader would energize the transponder to emit its signal—their sole function was to return their unique identifier when they were near a reader. Because each RFID transponder could only return a single identification—both as a limitation of their technology, but also by design as a unique identifier—a user would need separate tags or cards for each RFID identification, *e.g.*, one for each credit card, keycard or key. (*See* Sharony Decl. ¶ 30.)

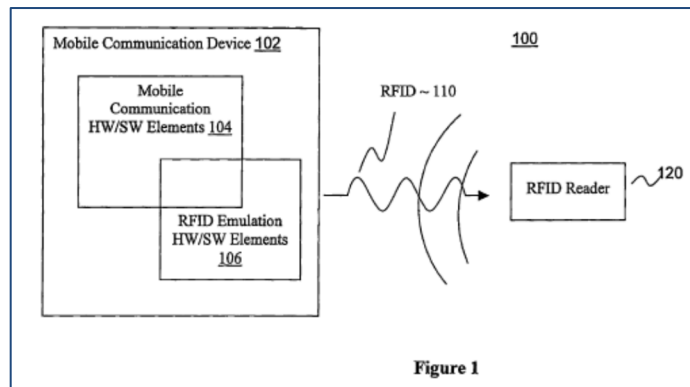
As reflected in their titles, Varia’s patented inventions solved the drawbacks of this prior art through “Emulated Radio Frequency Identification.” Rather than use an RFID transponder, Varia’s

¹ The Exhibits cited in this brief are attached to the Declaration of Natalie D. Lieber (“Ex.”) or the Sharony Decl (“Sharony Decl. Ex.”), filed concurrently with this brief, unless otherwise noted.

patents *emulate* a transponder by using other electronic components such as a “transceiver,” “transmitter,” and/or “communication circuitry.” By integrating these components into the electronics of a mobile communications device, Varia enabled smartphones to replace the collection of credit cards, keycards, car keys, etc., with a singular device that could store and present myriad RFID data on demand. The embodiments of the patent taught how to detect the presence of an RFID reader, and in response, allow the user to present an emulated RFID tag that mimics an RFID transponder. This inventive RFID emulation feature allows a user to enter, store and present any specific RFID data of their choosing using the device’s processor, display and interface, creating a virtual wallet of credit cards and keys on a phone. (See Sharony Decl. ¶ 33.)

To enable this RFID emulation, additional components needed to be added. At the same time, some existing circuitry within a smartphone could be repurposed to support RFID emulation. Varia’s patents teach leveraging and supplementing the existing telephony infrastructure of a smartphone with dedicated internal RFID components to enable mobile wallet/RFID emulation.² Ex. 1 at col. 3 ll. 50-55 (“embodiments of the present invention advantageously leverage on existing elements of mobile communication device 102, and supplement them, to enable mobile communication device 102 to be able to provide a RFID, emulating a RFID transponder, as well as facilitating user communication”). Figure 1 of Varia’s patents shows there is only partial, not total, overlap of the components performing telephony and RFID emulation in the patented inventions. *Id.* at Fig. 1; col. 3:42-49. Such overlap may include, *e.g.*, the processor and other electronic components of the device, as illustrated in Figure 3. *Id.* at Fig. 3; col. 3 5:8-30. (See Sharony Decl. ¶ 34.)

² The Asserted Patents share a common specification but have different claims. Only citations to the specification of the ’984 Patent (Ex. 1) are provided here despite identical disclosure in the ’974 and ’947 Patent specifications.



B. '984 and '974 Patents

The related '984 and '974 Patents claim priority to the same original application—*e.g.*, they are based on the same technology disclosed in the original application and treated as if filed on the same day—and are directed to methods and devices for emulating RFID tags using a mobile communications device. To accomplish this, the claimed inventions recite a “transceiver” or “transmitter” of the mobile communications device configured to output RFID transponder data or RFID signals upon detection of a “proximal RFID reader.” *See, e.g.*, Ex. 1 at cl. 13 and 32; Ex. 2 at cl. 8 and 12.

C. '947 Patent

The '947 Patent claims priority to the same original application as the '984 and '974 Patents and is directed to methods and devices for emulating RFID tags using a mobile communications device. To accomplish this, the claimed inventions recite “communications circuitry” and/or other “circuitry” of the mobile communications device configured to output RFID transponder data when the mobile communications device determines it is in the “operational space” of an RFID reader. *See, e.g.*, Ex. 3 at claims 1 and 9.

III. RELEVANT LEGAL STANDARDS

Claim construction is a fundamental issue in any patent infringement litigation—it is the process by which a court determines the scope and meaning of disputed patent claims. Claim construction is a question of law reserved for the court. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 391

(1996). Claim language is typically given its “ordinary and customary meaning as understood by a person of ordinary skill in the art [“POSA”]” “at the time of the invention.” *Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). A POSA is a fictional, objective person who has the average knowledge, skill, and expertise in the claimed invention’s technical field. *See Phillips*, 415 F.3d at 1313-14. It is well-settled that a court, in interpreting a patent claim, should look to the intrinsic evidence—*i.e.*, the patent claims, the specification, and the prosecution history (the patentee’s back and forth with the Patent Office)—with the language of the claims being of primary import. *Id.* “[T]he role of a district court in construing claims is not to redefine claim recitations or to read limitations into the claims to obviate factual questions of infringement and validity but rather to give meaning to the limitations actually contained in the claims.” *Am. Piledriving Equip.*, 637 F.3d at 1331.

“The specification need not describe every embodiment of the claimed invention and the claims should not be confined to the disclosed embodiments—even when the specification discloses only one embodiment.” *Woods v. DeAngelo Marine Exhaust, Inc.*, 692 F.3d 1272, 1283 (Fed. Cir. 2012) (internal citations omitted). “We do not read limitations from the specification into the claims; we do not redefine the words.” *Thorner*, 669 F.3d at 1366. “[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments.” *Phillips*, 415 F.3d at 1323.

The “only two exceptions to [the] general rule” that claim terms are construed according to their plain and ordinary meaning are when the patentee acts as his own lexicographer or disavows the full scope of the claim term either in the specification or during prosecution. *Thorner*, 669 F.3d at 1365. To disavow the full scope of a claim term, the patentee’s statements in the prosecution history must represent “a clear disavowal of claim scope.” *Id.* at 1366. When “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). Limiting statements do not give rise to disclaimer “where those statements were clearly and expressly rejected by the Patent Office.” *Galderma Labs, L.P. v. Amneal Pharms. LLC*, 806 F. App’x 1007, 1010-11 (Fed. Cir. 2010) (finding claim meanings were not limited by arguments that Patent Office expressly rejected).

IV. DISPUTED CLAIM CONSTRUCTIONS FOR THE ’984 AND ’974 PATENTS

A. “Transceiver” (’984 Patent, cl. 1, 9, 13; ’974 Patent, cl. 1, 6, 8) and “Transmitter” (’984 Patent, cl. 21, 32; ’974 Patent, cl. 12)

Varia’s Construction (“Transceiver”)	Apple’s Construction (“Transceiver”)
The components responsible for transmitting and receiving signals in a mobile communications device that are integrated into the electronics of the device	A single component within the mobile communication[s] device that includes common circuitry for transmitting and receiving both RFID and voice signals to/from an antenna

Varia’s Construction (“Transmitter”)	Apple’s Construction (“Transmitter”)
The components responsible for transmitting signals in a mobile communications device that are integrated into the electronics of the device	A single component within the mobile communication[s] device that includes common circuitry for transmitting both RFID and voice signals to an antenna

The parties appear to agree that “transceiver” involves transmitting and receiving signals, and that “transmitter” involves transmitting signals. The key differences between the parties’ proposed constructions are: (1) whether “transceiver” and “transmitter” are limited to a single component with common circuitry for both RFID and voice signals; and (2) whether “transceiver” and “transmitter” are integrated into the device electronics. As explained below, “transceiver” and “transmitter” may be implemented using multiple, separate components for RFID and voice signals, so long as those components are integrated into the mobile device’s electronics.

1. The Terms Are Not Limited To a Single Component With Common Circuitry For Transmitting RFID and Voice

Nothing in the claims requires that “transceiver” or “transmitter” be limited to a single

component or otherwise have “common circuitry for ... both RFID and voice signals.” “Transceiver” and “transmitter” should each be construed to include the use of separate and multi-component embodiments for RFID and voice. This is consistent with the broad usage of the terms in the intrinsic evidence, including the claims, the specification, and the prosecution history. According to the claims of the ’984 and ’974 patents, the mobile communications device outputs signals for RFID emulation and voice calls through a “transceiver” (See Ex. 1 cl. 1, 9, 13; Ex. 2 cl. 1, 6, 8) or a “transmitter” (Ex. 1 cl. 21, 32; Ex. 2, cl. 12). The specification teaches *separate* components responsible for outputting RFID signals and voice call signals (Ex. 1 at Fig. 1) (disclosing “mobile communication . . . elements” and “RFID emulation . . . elements”). See Sharony Decl. ¶¶ 42, 45, 51. Moreover, some dependent claims expressly require that “transceiver” includes separate units for voice calls and RFID signals. See Ex. 1 at cl. 2, Ex. 2 at cl. 2 (“transceiver comprises a first . . . unit configured to process RFID signals and a second . . . unit configured to process RFID signals.”).

In other words, the Asserted Patents use the terms “transceiver” and “transmitter” to refer to multi-component embodiments. Thus, a POSA would understand that “transceiver” and “transmitter” are not limited to a single component. Sharony Decl. ¶¶ 42, 51. Varia’s proposed construction is consistent with these teachings, and Apple’s proposed construction is contradictory and would exclude the very examples taught in the Asserted Patents. Apple’s proposal therefore violates a fundamental claim construction principle that claim terms should not be construed to omit disclosed embodiments. See *Nobel Biocare Servs. AG v. Intradent USA, Inc.*, 903 F.3d 1365, 1381 (Fed. Cir. 2018), *as amended* (Sept. 20, 2018) (“[T]here is a strong presumption against a claim construction that excludes a disclosed embodiment.”); *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1333 (Fed. Cir. 2013) (“This court has clarified that an interpretation which ‘excludes a [disclosed] embodiment from the scope of the claim is rarely, if ever, correct.’”).

Varia’s proposed constructions are consistent with how the Patent Office interpreted the claim

language during the '984 Patent prosecution. The Patent Office confirmed that the specification “illustrate[s] the **RFID and voice circuitry** can be *separate* hardware/software.” Sharony Decl. Ex. D (June 22, 2010 Final Rejection) at 11 (emphasis added). The Patent Office stated “the elements of the device responsible for the RFID and voice communication are interpreted as being part of the transceiver” (*Id.*) and that “such **components** . . . including . . . RFID components and voice components . . . **together are interpreted as the ‘transceiver’** of the device.” (*Id.* at 3-4 (emphasis added)). Sharony Decl. ¶¶ 43-44, 52. Varia’s proposed construction is consistent with this record—Apple’s is not.

Apple’s proposed construction is flawed for several reasons. First, nothing in the claims requires “transceiver” or “transmitter” to be limited to a single component with “common circuitry for . . . both RFID and voice signals,” and Apple’s proposed construction would improperly read out embodiments and examples taught by the Asserted Patents. Moreover, the Patent Office expressly rejected the argument that “transceiver” be limited to a single component with common circuitry for RFID and voice. The Patent Office initially rejected that argument when it observed that “the claims do not recite ‘single component.’” Sharony Decl. Ex. G (October 13, 2010 Advisory Action) at 2. Subsequently, the Patent Office confirmed that “the *sum total* of the communications circuitry is the transceiver” (Sharony Decl. Ex. E (Mar. 31, 2011 Non-Final Rejection) at 5 (emphasis added)) and that “transceiver” includes “*separate* . . . sections responsible for **voice call signal transmission and RFID transmission.**” (*Id.* at 4 (emphasis added)). See Sharony Decl. ¶ 47.

With respect to “transmitter,” the Patent Office likewise expressly rejected the argument that it is limited to a single component with common circuitry for both RFID and voice signals. The Patent Office confirmed it interpreted “transmitter . . . as comprising the circuitry capable of performing the RFID and . . . voice.” Sharony Decl. Ex. E (Mar. 31, 2011 Non-Final Rejection) at 10. Moreover, the Patent Office admonished that “if Applicant[] wants a special meaning/definition of transceiver/transmitter of the device, that such limitations should be placed in the claim body.” *Id.* But

no such amendments to the claim limitations were ever made.³ Ultimately, no claims were allowed on the basis of any single component or common circuitry arguments that the Patent Office rejected. *See* Sharony Decl. ¶¶ 47-48, 55-55.

Because Applicant’s “single component” arguments were clearly and expressly rejected, there can be no disclaimer here as a matter of law. *Galderma*, 806 F. App’x at 1010-11 (purported limiting statements made by an applicant did not give rise to disclaimer “where those statements were clearly and expressly rejected by the Patent Office.”); *Bausch & Lomb Inc. v. Vitamin Health, Inc.*, No. 12-cv-6498T, 2015 WL 13574354, at *7 (W.D.N.Y. Jan. 15, 2015) (because alleged disclaimer was rejected by Patent Office, it was not made for the purpose of obtaining the patent, and could not be used to limit claim scope); *Vertical Tank, Inc. v. BakerCorp.*, No. 1:18-cv-00145, 2019 WL 2207668, at *11 (E.D. Cal. May 22, 2019) (“Courts have refused to find a disclaimer was made where the purported disclaimer was **rejected** by the patent office”) (emphasis in original).

Furthermore, Varia’s proposed constructions are consistent with technical dictionary definitions showing that “transceiver” and “transmitter” do not require a single component or common circuitry for transmitting and/or receiving. *See* Sharony Decl. ¶¶ 46, 54. Although such extrinsic evidence carries less weight than the patents’ intrinsic record, and cannot be used to change the meaning of a term, here it confirms the usage of the terms in their ordinary meaning and corroborates the evidence and conclusions discussed above. *Phillips*, 415 F.3d at 1317-18 (“We have especially noted the help that technical dictionaries may provide to a court ‘to better understand the underlying technology’ and the way in which one of skill in the art might use the claim terms.”) (citations omitted).

³ Subsequent to the March 31, 2011 Non-Final Rejection, the claims were amended only once before they issued by Amendment dated November 1, 2011. That Amendment did not introduce any changes limiting “transceiver” or “transmitter” to a single component with common circuitry for RFID and voice. The claims as they appeared before and after that Amendment are reproduced in Exhibit 4.

2. The Intrinsic Record Establishes That the “Transceiver” and “Transmitter” Components Are Integrated Into the Device Electronics

The parties separately dispute whether the recited “transceiver” and “transmitter” are integrated in to the mobile device’s electronics. The specification teaches that they are. For example, the specification teaches that components of the transceiver and transmitter are controlled by the device’s processor. *See* Ex. 1 at Figs. 3 and 4; Sharony Decl. ¶¶ 34, 42, 51. The Patent Office confirmed such integration when it observed that “separate outputs of . . . the transceiver . . . are tied/linked controlled by the same central processing/circuitry.” Sharony Decl. Ex. D (June 22, 2010 Final Rejection) at 4; Sharony Decl. ¶¶42-43, 51. Apple’s proposed construction is flawed because it does not specify any connection to the device electronics, let alone integration. Apple’s proposal for a “single component . . . that includes common circuitry for . . . RFID and voice signals,” is unsupported by the claim language or specification. *See* Sharony Decl. ¶¶ 42, 47, 51, 55.

B. “Communication Circuitry” (’947 Patent, cl. 16, 26)

Varia’s Construction	Apple’s Construction
The combination of circuits responsible for outputting voice call and RFID signals, and receiving RFID signals, that are integrated into the electronics of the device	A single component within the mobile communication[s] device that includes common circuitry for transmitting and receiving both RFID and voice signals to/from an antenna

The parties appear to agree that “communication circuitry” involves outputting/transmitting RFID and voice signals, and receiving RFID signals. The key differences between the parties’ proposed constructions are: (1) whether “communication circuitry” is limited to a single component with common circuitry for transmitting and receiving both RFID and voice, and (2) whether the communication circuitry is integrated into the device electronics. As explained below, “communication circuitry” encompasses separate components integrated into the device electronics. The dispute here is similar to the dispute involving “transceiver” and “transmitter,” but Apple’s position here is even more tenuous because the rejected prosecution history arguments about “transceiver” and “transmitter” were

never made with respect to “communication circuitry” and the term circuitry itself is a plural term that Apple is trying to impermissibly limit to one component.

Varia’s proposed construction is supported by the claims themselves and the intrinsic record. The ’947 Patent claims specify that “communication circuitry” means the circuitry that [output[s] or transmit[s] “a voice call signal,” “output[s] an RFID signal,” and receives “an RFID probing signal.” Ex. 3 at cl. 16 and 26. Further, the ’947 Patent specification teaches that components responsible for outputting RFID and voice signals are integrated into the device electronics. *Id.* at Figs. 1 and 4; Sharony Decl. ¶ 59. In addition, Varia’s proposed construction is consistent with the patent prosecution history. In the related ’984 Patent prosecution history, the Patent Office confirmed that “communications circuitry” includes “separate . . . sections responsible for voice call signal transmission and RFID transmission.” Sharony Decl. Ex. E (Mar. 31, 2011 Non-Final Rejection) at 4; Sharony Decl. ¶ 60.

Apple’s construction is flawed because it is divorced from the words of the claims themselves and the teachings of the specification. Nothing in the claims or specification limits “communication circuitry” to a single component or otherwise requires that “communication circuitry” include common circuitry for RFID and voice. *See* Sharony Decl. ¶¶ 58-62. Indeed, the words “common circuitry” do not appear anywhere in the claims or the intrinsic record. Furthermore, Varia’s proposed construction is consistent with a technical dictionary definitions showing that “circuitry” does not require a single component or common circuitry for transmitting and/or receiving. *See* Sharony Decl. ¶ 61.

C. “Switchable Mobile Communication[s] Device” (’984 Patent, Claims 1, 13, 21, 32; ’974 Patent, Claims 1, 8, 12)

Varia’s Construction	Apple’s Construction
No Construction Required In the alternative, to the extent the preamble is limiting: mobile communication[s] device capable of changing states	Mobile communication[s] device configured to switch between an RFID state and a voice call signal state

The term “switchable mobile communication[s] device” appears only in the preamble of the claims—the introductory phrase before the patent claim is recited—and is not a limitation itself; it merely states an intended purpose or use for the invention. Therefore, it does not require construction. To the extent the term is found to be a limitation requiring construction, the parties appear to agree that a “mobile communication[s] device” can output signals in an RFID state *and* a voice call state. The key difference between the parties’ constructions is whether those RFID and voice call states must be exclusive of each other. As explained below, the RFID and voice call states are not mutually exclusive.

As an initial matter, there is no basis here to depart from the well-settled rule that “[g]enerally, a preamble is not limiting.” *Summit 6, LLC v. Samsung Electronics Co., Ltd.*, 802 F.3d 1283, 1292 (Fed. Cir. 2015) (citation omitted). “[W]hether to treat a preamble as a claim limitation is determined on the facts of each case in light of the claim as a whole and the invention described in the patent.” *TomTom, Inc. v. Adolph*, 790 F.3d 1315, 1323-24 (Fed. Cir. 2015) (quotation omitted) (district court erred in determining a preamble was limiting where preamble did not “recite essential structure or steps, or give necessary life, meaning, or vitality to the claim”). “[A] preamble is not limiting where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.” *Id.* (quotation omitted). “[I]t is assumed that the preamble language is duplicative of the language found in the body of the claims or merely provides context for the claims, absent any indication to the contrary in the claims, the specification or the prosecution history.” *Symantec Corp. v. Computer Assocs. Int’l, Inc.*, 522 F.3d 1288, 1289 (Fed. Cir. 2008).

Here, the intrinsic record establishes that the “switchable mobile communication[s] device” simply provides context for the claims. *See* Sharony Decl. ¶ 65. Each of the independent claims of the ’984 and ’974 Patents specify that the claimed invention can output “voice call signals” and “RFID transponder [data/signals].” Ex. 1 at cl. 1, 13, 21, 32; Ex. 2 at cl. 1, 8, 12. A person of ordinary skill in the art would understand that separate RFID and voice call outputs of a shared device, with shared electronics/processing, would encompass the capability to change states of the device—including outputting either RFID, or voice call signals, or RFID and voice call signals—as both outputs are controlled by the electronics of the device. *See* Sharony Decl. ¶ 67.

If the term is found to be limiting, “switchable mobile communications device” is clear from its face, readily understandable to a POSA, and requires no construction. Sharony Decl. ¶ 65. To the extent the Court determines that construction would be appropriate, the term should be construed as a “mobile communication[s] device capable of changing states.” Varia’s proposed construction is consistent with the context of the claims. Nothing in the claims requires that the states must be exclusive of each other. *See* Sharony Decl. ¶¶ 66-69.

Varia’s proposed construction is also consistent with the Patent Office’s construction of a similar “switching” limitation during prosecution of the related ’947 Patent. “When construing claim[s] in patents that derive from the same parent application and share common terms, ‘we must interpret the claims consistently across all asserted patents.’” *Capital Mach. Co. v. Miller Veneers, Inc.*, 524 Fed. App’x. 644, 647 (Fed. Cir. 2014) (quoting *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1293 (Fed. Cir. 2005)). During prosecution of the ’947 Patent, the Patent Office construed then-pending terms “switching . . . from a first state to a second state” to mean “the change of state . . . as using the mobile device (phone with embedded RFID) in different states.” Sharony Decl. Ex. J (July 22, 2014 Final Rejection) at 3. The Patent Office expressly rejected the argument that the states are mutually exclusive of each other: “simply put, the claims do not require that the first and second states are

exclusive of each other. Therefore, when the phone is enabled and then when used an RFID transponder, this is interpreted as *first and second states and switching* from use to another.” *Id.*; Sharony Decl. ¶¶ 68-69. To the extent Apple’s proposed construction requires *exclusive* states, it is improper as contradictory to the express discussion in the prosecution history.

Because the mutually exclusive state argument was clearly and expressly rejected, it cannot be used to limit the claim scope here. *Galderma*, 806 F. App’x at 1010-11; *Bausch & Lomb*, 2015 WL 13574354, at *7; *Vertical Tank*, 2019 WL 2207668, at *12-13. Apple’s proposed construction is flawed because it implies that the RFID and voice call states are mutually exclusive. Apple’s construction is inconsistent with the language of the claims and the prosecution history. *See* Sharony Decl. ¶¶ 68-69.

D. The “outputting” limitations (’984 Patent, Claims 9, 13, 21, 32; ’974 Patent, Claims 6, 8, 12; ’947 Patent, Claims 1, 9, 16, 26)

Claim Term	Varia’s Construction	Apple’s Construction
“on detection of the RFID reader by the mobile communication device, outputting by the transceiver second RFID transponder data” / “output . . . RFID transponder data . . . upon the mobile communications device determining proximal presence of one or more RFID readers” / “output first RFID transponder data . . . in response to detection by the mobile communication device of the proximal RFID reader” / “on detection of the proximal RFID reader, output RFID transponder data as an RFID signal” / “on detection of the RFID reader, outputting, by the transceiver, the RFID transponder data as a radio frequency signal” / “the RFID signal is output in response to the mobile communication device determining the mobile communication device is in an operational space of the RFID reader” / “the outputting of the RFID signal comprises outputting the RFID signal in response to determining the mobile communication device is within the proximal presence of the RFID reader” / “output an RFID signal . . . in response to detection of the proximal presence of the RFID reader external to the mobile communication device” / “in response to determining the mobile communication device is in the operational space of the RFID reader . . . , output an RFID signal”	Plain and Ordinary Meaning	The [RFID transponder data / RFID signal] is outputted automatically whenever the mobile communication[s] device is within the [operational space / proximal presence] of the RFID reader

Apple proposes grouping the nine separate “outputting” limitations listed above together and

construing them *identically* to require *automatic* output of RFID [transponder data / signal]. The words of the “outputting” limitations are readily understandable to a POSA and require no construction. The words of the “outputting” limitations describe exactly what is meant—outputting RFID [transponder data / signal] in response to the claimed event, which varies based on the given claim at issue, *e.g.*, detection of the RFID reader, determining the proximal presence of an RFID reader, determining the mobile communication device is in the operational space of the RFID reader, etc. Sharony Decl. ¶ 98. Crucially, nothing in the claims or specification requires that “outputting” be limited to automatic output of RFID [transponder data / signal]. Accordingly, Apple’s attempt to limit these terms to automatic RFID output must be rejected.

The broad usage of “outputting” in the intrinsic evidence and the context of the claims supports Varia’s construction. The specification teaches the invention relates to *emulating* output of either an active or passive RFID transponder—not a prior art transponder, such as one that automatically returns a signal. *See, e.g.*, Ex. 1 at 3:57-59 (“mobile communication device 102 is equipped to provide RFID, emulating an active and/or passive RFID transponder”). Further, the specification discloses embodiments where user action is needed to output RFID data. *Id.* at 4:54-58 (“During operation, in response to a user instruction, typically after the user has selected the RFID to be outputted from a number of RFIDs stored in device 102, block 203, device 102 outputs the selected RFID as instructed, emulating an active RFID transponder, block 204.”). *See* Sharony Decl. ¶ 99. A POSA would understand that that selection of specific RFID data to output by a user can also be used to emulate a passive transponder. *Id.*; Ex. 1 at 4:59-62 (“For the embodiment, one RFID . . . may also be selected/designated as a default RFID, the output of which may be emulated in a passive manner.”).

Despite this, Apple’s proposal improperly reads out embodiments that require user action before outputting RFID data. Apple’s proposal therefore violates a fundamental claim construction principle that claim terms should not be construed to omit disclosed embodiments. *See Nobel*, 903 F.3d at 1381

(Fed. Cir. 2018), *as amended* (Sept. 20, 2018) (“[T]here is a strong presumption against a claim construction that excludes a disclosed embodiment.”); *Broadcom*, 732 F.3d at 1333 (Fed. Cir. 2013) (“This court has clarified that an interpretation which ‘excludes a [disclosed] embodiment from the scope of the claim is rarely, if ever, correct.’”). As explained above, the Asserted Patents disclose embodiments in which the outputting of RFID is not automatic, but Apple seeks to improperly read those out.

Moreover, the Patent specification recites the narrower language “outputs the designated RFID automatically” (Ex. 1 at col. 5 at l. 3), while the asserted claims recite the broader “outputting” limitations without the “automatic” modifier. Thus, the Patents themselves provide guidance that the “outputting” limitations should be construed broadly. Had the Patentee wished to limit the “outputting” limitations to “automatic outputting” it simply could have recited the same instead of the broader “outputting” claim limitations. The Patentee certainly was aware of the term “outputs the designated RFID automatically,” but still chose to use the broader term “outputting” in the asserted claims. *See Legends, Inc. v. Upper Deck Co. LLC*, No. H-09-3463, 2010 WL 4817050, at *10 (S.D. Tex. Nov. 17, 2010) (refusing to limit scope of “database” to be a computer-only database but rather having it encompass any collection of information, the court noting that the specification described some embodiments as using a “computer database” while the claims themselves notably omitted the term “computer”). *Varia’s* proposal does not exclude automatic outputting, but its inventions are broader and include user-selection as well, as evidenced by the specific language used in the claims as well as the embodiments taught in the specification. For these reasons, the Court should reject Apple’s proposal. *See Sharony Decl.* ¶ 100.

V. APPLE’S INDEFINITENESS ALLEGATIONS FOR THE OTHER DISPUTED TERMS ARE BASELESS AND WRONG

Patents are presumed valid. 35 U.S.C. § 282 (“Each claim of a patent . . . shall be presumed valid independently”). Accordingly, Apple bears the burden of proving any allegation of invalidity by

clear and convincing evidence. *Id.*; *Microsoft Corp. v. i4i Ltd.*, 564 U.S. 91, 102 (2011) (“[B]y the time Congress enacted § 282 . . . the presumption of patent validity had long been a fixture of the common law. According to its settled meaning, a defendant raising an invalidity defense bore ‘a heavy burden of persuasion,’ requiring proof of the defense by clear and convincing evidence.”). Apple has failed to carry that burden here, especially on the preliminary record and prior to expert reports.

A. Indefiniteness Should Not Be Decided at the Claim Construction Stage

The test for indefiniteness is whether “a patent’s claims, viewed in the light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014). It is improper to rely on “claim language, standing alone” to allege indefiniteness. *Nature Simulation Sys. Inc. v. Autodesk, Inc.*, 50 F.4th 1358, 1364 (Fed. Cir. 2022).

Under the Joint Case Management Plan, Apple’s opening expert report on invalidity is due 90 days after the Court’s claim construction ruling. Dkt. 20 at 3. That opening expert report would also include Apple’s indefiniteness support, since it is an issue on which they bear the “burden of proof.” *Id.* Varia will then proffer expert testimony on validity 30 days after Apple’s opening expert report. To force the issue of invalidity now contradicts the parties’ agreed-upon discovery plan and would deprive the Court of testimony of those skilled in the art, which is the lynchpin of the indefiniteness analysis.

In these circumstances, district courts routinely defer the ruling on indefiniteness in light of the high burden of proof required and the importance of expert testimony to revealing the perspective of those skilled in the art. *See, e.g., Merck Sharp & Dohme Corp. v. Teva Pharms. USA, Inc.*, No. 17-6921, 2019 WL 943532, at *6 (D.N.J. Feb. 26, 2019); *Junker v. Med. Components, Inc.*, No. 12-4605, 2017 WL 4922291, at *2 (E.D. Pa. Oct. 31, 2017). The Court should similarly defer the issue here until summary judgment or trial here where the inquiry can be performed with the benefit of a full evidentiary record, such as the expert depositions and expert reports. *See Par Pharm. Inc. v. Sandoz, Inc.*, No. 3:18-

cv-14895, 2020 WL 1130387, at *8 (D.N.J. Mar. 9, 2020). Moreover, Apple’s invalidity contentions to date have only comprised conclusory statements that:

Further, each Asserted Claim identified below (and each Asserted Claim that depends therefrom) is invalid under § 112, ¶ 2 because it fails to inform, with reasonable certainty, those skilled in the art about the scope of the claimed invention. As used in the Asserted Claims, these limitations would not have a single, reasonably discernible meaning to a POSA.

See, e.g., Ex. 5 at 63. This falls short of the clear and convincing evidence necessary to support an indefiniteness finding, and to permit Apple to augment their theories and evidence on the fly with their responsive brief—months before *Vaira* is due to offer expert testimony on the issue—would significantly prejudice *Varia* and contravene the spirit, if not also the letter, of the parties’ Case Management Plan.

B. Even if the Court Addresses Indefiniteness Now, Both Intrinsic and Extrinsic Evidence Support that a POSA Would Understand the Terms with Reasonable Certainty

In any event, the partial record adduced to date demonstrates that a POSA would understand the meaning and scope of the disputed terms with reasonable certainty. Notably, the Patent Office had no concerns about the clarity of the claim language, either in evaluating the patent claims for definiteness under § 112 directly, or in comparing the scope of the claims to the prior art during prosecution. *See Sonix Tech. Co. v. Publ’s Int’l, Ltd.*, 844 F.3d 1370, 1379-80 (Fed. Cir. 2017) (finding compelling that “the USPTO did not express any uncertainty as to the scope of [the disputed term], or encounter any apparent difficulty in applying the term to the references”).

1. “Operational Space” (’947 Patent, Claims 1, 9, 16, 26)

Varia’s Construction	Apple’s Construction
Plain and ordinary meaning In the alternative, to the extent construction is required: the area surrounding an RFID reader in which a conventional RFID transponder will respond to an RFID probing signal from the RFID reader	Indefinite

A POSA would readily understand the term “operational space” when read in light of the claims, specification, and prosecution history, as the *Nautilus* standard dictates. *See* Sharony Decl. ¶¶ 71-75. As detailed in Section II.C, the ’947 Patent is directed to a method of emulating RFID that involves, *inter alia*, determining the device is in the “operational space” of an RFID reader based upon receipt of an RFID probing signal. The specification teaches that when the mobile communications device determines it “is within the operational space of such an RFID reader” the device “outputs the designated RFID.” Ex. 3 at 5:8-12, Fig. 2, and cl. 1, 9, 16, 26. *See* Sharony Decl. ¶ 72.

The ’947 Patent prosecution history provides further support that “operational space” would be readily understood by those skilled in the art. *See* Sharony Decl. ¶¶ 72-75. There, Applicants affirmed that:

[a]s will be appreciated by those of ordinary skill in the art and detailed in the declaration by Roger Stewart filed along with the present response, the operational space of an RFID reader refers to ‘the area surrounding an RFID reader in which a conventional RFID transponder will respond to an RFID probing signal from the RFID reader.’ This operational space may be different for different types of RFID signals....

Sharony Decl. Ex. K (Jan 21, 2015 Response to Office Action) at 10.

Furthermore, the fact that the USPTO Examiner had no apparent difficulty understanding “operational space,” including in initially rejecting the claims as anticipated and/or obvious over the prior art, is compelling evidence that the term would be readily understood by those skilled in the art and requires no construction by the Court. *See Sonix Tech.*, 844 F.3d at 1379-80. For example, the Examiner initially rejected claims of the ’947 Patent as anticipated over prior art reference “Zalewski” that purportedly disclosed, *inter alia*, a “mobile communications device [that] determines whether it is in range of the RFID reader based on the RFID probing signal . . . if it is in the operational space the mobile communication device outputs data.” *See* Sharony Dec. Ex. L (Aug. 14, 2015 Non-Final Rejection) at 3. The invention of the ’947 Patent was eventually distinguished because the prior art did not teach, *inter alia*, “outputting of the RFID signal in response to determining of being in the

operational space of the RFID reader based on receipt of the probing signal” (Sharony Dec. Ex. M (Apr. 28, 2016 Notice of Allowance) at 10), but at no point during prosecution did the Examiner express any uncertainty as to the meaning or scope of the claims in view of the “operational space” term in particular.

Accordingly, no construction is necessary for the term, as it is easily understandable to those of skill in the art. But should the Court construe the term, “operational space” should be construed as “the area surrounding an RFID reader in which a conventional RFID transponder will respond to an RFID probing signal from the RFID reader,” consistent with the specification, the prosecution history, and the ordinary meaning of the terms. *See* Sharony Decl. ¶ 75.

2. “Proximal Presence” / “Proximal RFID Reader” (’984 Patent, Claims 9, 13, 21, 32, ’974 Patent, Claims 6, 8, 12)

Varia’s Construction	Apple’s Construction
Plain and ordinary meaning In the alternative, to the extent construction is required: the device is within the area surrounding an RFID reader in which a conventional RFID transponder will detect an RFID probing signal from the reader	Indefinite

A POSA would readily understand the terms “proximal presence” and “proximal RFID reader” when read in light of the claims, specification, and prosecution history, as the *Nautilus* standard dictates. *See* Sharony Decl. ¶ 77. As detailed in Section II.A, the ’947 Patent is directed to a method of emulating RFID that involves, *inter alia*, monitoring for/detecting the device is in the proximal presence of a proximal RFID reader. The specification teaches that “[e]mulation of a passive RFID transponder includes detecting for proximal presence of a RFID reader.” Ex. 1 at Abstract. In addition, claim 16 of the related ’947 Patent specifies that “detection of the proximal presence of the RFID reader external to the mobile communication device based upon receipt of the RFID probing signal.” Ex. 3 at cl. 16; Sharony Decl. ¶¶ 78-79; *Capital Mach.*, 524 Fed. App’x at 647 (“When construing claims in patents

that derive from the same parent application and share common terms, ‘we must interpret the claims consistently across all asserted patents.’”).

The prosecution history of the ’984 Patent provides further support that these terms would be readily understood by those skilled in the art. That the USPTO Examiner had no apparent difficulty understanding “proximal presence” and “proximal RFID reader,” including in initially rejected the claims as anticipated and/or obvious over prior art, is compelling evidence that the terms would be readily understood by those skilled in the art and require no construction. *See Sonix Tech.*, 844 F.3d at 1379-80. For example, the Examiner initially rejected the ’984 Patent claims as obvious over prior art reference “Zalewski” that purportedly disclosed, *inter alia*, a “cover 100 . . . monitoring for proximal presence of the RFID reader.” *See Sharony Decl. Ex. D* (Jun. 22, 2010 Final Rejection) at 3. The invention of the ’984 Patent was eventually distinguished over the prior art, but at no point during prosecution did the Examiner express any uncertainty as to the meaning or scope of the claims in view of the “proximal presence” or “proximal RFID reader” terms in particular. In fact, the term “proximal RFID reader” was first introduced by the Examiner via an Examiner’s Amendment dated November 1, 2011. *See Sharony Decl. Ex. N* (Nov. 1, 2011 Notice of Allowability) at 4.

Accordingly, no construction is necessary for the terms, as they are easily understandable to those of skill in the art. But should the Court construe these terms, “proximal presence” and “proximal RFID reader” should be construed as “the device is within the area surrounding an RFID reader in which a conventional RFID transponder will detect an RFID probing signal from the RFID reader,” consistent with the specification, the prosecution history, and the ordinary meaning of the terms. *See Sharony Decl.* ¶¶ 76-81.

3. “[Facilitate / facilitating] the user” / “[facilitate / facilitating] a user” (’984 Patent Claims 6, 26; ’974 Patent Claims 4, 15; ’947 Patent Claims 5, 21)

Varia’s Construction	Apple’s Construction
Plain and ordinary meaning In the alternative, to the extent construction is required, the terms should be construed in the context of the claims in which they appear: enabling a user to select [RFID transponder data / RFID data] to output from the RFIDs stored in the device	Indefinite

Apple alleges that the terms “[facilitate / facilitating] the user” / “[facilitate / facilitating] a user” are indefinite on two separate grounds: (1) that the scope cannot be ascertained with reasonable certainty; and (2) that claims reciting these terms are invalid as indefinite for lack of antecedent basis. Apple is incorrect, and each of its arguments is addressed below.

(a) A POSA Would Readily Understand the Terms

A POSA would readily understand the terms “[facilitate / facilitating] the user” / “[facilitate / facilitating] a user” when read in light of the claims and specification, as the *Nautilus* standard dictates. *See* Sharony Decl. ¶ 87. The disputed terms appear in claims directed to “facilitating a user in selecting the RFID data from a plurality of the RFID data using the mobile communication device.” *See, e.g.*, Ex. 3 at cl. 5.

As detailed in Section II.A, the inventions of the Asserted Patents are directed to a method of emulating RFID that involves, *inter alia*, allowing a user to present any RFID data of their choosing using the device’s processor, display, and interface, creating a virtual wallet of credit cards and keys on a phone. For example, the specification teaches that “mobile communication device 102 is equipped with hardware and/or software elements 106 to facilitate provision or transfer of a key/identifier in a form [sic] a radio frequency signal 110, which may be read, e.g. by a radio frequency identifier (RFID) reader 120.” Ex. 1 at 3:34-39. As a further example, the specification teaches that “[e]mulation of an

active RFID transponder includes facilitating selection of the data and instruction to output by a user.”

Ex. 1 at Abstract. The specification further teaches:

[d]uring operation, in response to a user instruction, typically after the user has selected the RFID to be outputted from a number of RFIDs stored in device 102, block 203, device 1023 outputs the selected RFID as instructed, emulating an active RFID transponder, block 204. . . .

As illustrated in FIG. 6b, for the embodiment, the user interface further includes screen 612 enumerating a list of RFID management options 624, such as ‘add’, ‘edit’ or ‘delete’ RFIDs. List 614 may be displayed for example, among other situations, in response to a users selection of ‘option’ 604 of screen 602.

Ex. 1 at 4:54-58; 7:42-46. A POSA would understand that selection of specific RFID data can also be used with emulation of a passive transponder in the mobile communications device. *See Sharony Decl.* ¶¶ 88-93; Ex. 1 at 4:59-62 (“For the embodiment, one RFID . . . may also be selected/designated as a default RFID, the output of which may be emulated in a passive manner.”).

The prosecution history of the ’984 Patent provides further support that these terms would be readily understood by those skilled in the art. That the USPTO Examiner had no apparent difficulty understanding these terms, including in initially rejecting the claims as anticipated, is compelling evidence the terms would be readily understood by those skilled in the art and require no construction. *See Sonix Tech.*, 844 F.3d at 1379-80. For example, the Examiner initially rejected claims of the ’984 as obvious over Zalewski that purportedly disclosed, *inter alia*, a device with a “plurality of data” that “facilitates the user in selecting data . . . in order to help the user communicate data.” Sharony Decl. Ex. D (Jun. 22, 2010 Final Rejection) at 5. The invention of the ’984 patent was eventually distinguished over the prior art, but at no point during prosecution did the Examiner express any uncertainty as to the meaning or scope of the claims in view of these terms. *See Sharony Decl.* ¶ 94.

Accordingly, no construction is necessary, as the terms are easily understandable to those skilled in the art. *See Innovative Display Techs. v. Hyundai Motor Co.*, No. 2:14-cv-201, 2015 WL 2090651, *19-20 (E.D. Tex. 2015) (“facilitate better mixing of light rays” was not indefinite where specification

taught configuring light sources to improve mixing, and construing term to have its plain meaning). But should the Court construe these terms, they should be construed as “enabling a user to select [RFID transponder data / RFID data] to output from the RFIDs stored in the device,” consistent with the specification, the prosecution history, and the ordinary meaning of the terms. Sharony Decl. ¶¶ 86-95.

(b) Apple’s Antecedent Basis Argument Lacks Merit

Apple argues that claims reciting “[facilitate / facilitating] *the* user” (984 Patent cl. 6 and 26, and ’974 Patent cl. 4 and 15) are indefinite because they do not adhere to patent claim drafting technicalities that each term must have an explicit antecedent basis. To provide an explicit antecedent basis, “a claim must introduce a given term using an indefinite article (*e.g.*, ‘a’ or ‘an’) before referring to it in definite form, using ‘the’ or ‘said.’” *Comcast Cable Comms., LLC v. Spring Comms. Co.*, 38 F. Supp. 3d 589, 616 (E.D. Pa. 2014). In other words, Apple argues that the claims are invalid because they recite “*the* user” instead of “*a* user.”

Apple’s argument is incorrect. As explained above, a POSA would readily understand the terms “[facilitate / facilitating] the user” when read in light of the claims and specification, as the *Nautilus* standard dictates. Sharony Decl. ¶¶ 87, 93. Moreover, it is a “well-settled rule that claims are not necessarily invalid for lack of antecedent basis.” *Microprocessor Enhancement Corp. v. Texas Instruments, Inc.*, 520 F.3d 1367, 1376 (Fed. Cir. 2008); *Energizer Holdings, Inc. v. Int’l Trade Comm’n*, 435 F.3d 1366, 1370-71 (Fed. Cir. 2006) (“[D]espite the absence of explicit antecedent basis, ‘[i]f the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.’”) (quotation omitted). “[A]n antecedent basis can be present by implication.” 435 F.3d at 1366 (citing *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987)).

Here, a POSA would understand that the “[facilitate / facilitating] *the* user” limitations refer to *a* user of the claimed mobile communications device—even absent compliance with grammatical rules. See Sharony Decl. ¶ 93. Accordingly, no construction is necessary, as the terms are easily

understandable and not indefinite. *See Stragent LLC v. Intel Corp.*, No. 6:11-cv-421, 2013 WL 4829897, at *3-*4 (E.D. Tex. 2013) (finding “the crossbar switch” not indefinite where a POSA would know to treat “the crossbar switch” as “a crossbar switch”). But should the Court construe these term, Varia’s proposal is consistent with the specification and ordinary meaning. Sharony Decl. ¶ 95.

4. “The RFID reader” (’974 Patent Claim 6)

Varia’s Construction	Apple’s Construction
Plain and ordinary meaning	Indefinite
In the alternative, to the extent construction is required: an RFID reader	

Apple argues that ’974 Patent claim 6, which recites “the RFID reader” is invalid as indefinite because it lacks an explicit antecedent basis. Similar to the above, Apple argues this term is indefinite because it recites “*the* RFID reader” instead of “*an* RFID reader.”

Apple’s argument is incorrect. A POSA would readily understand the term “the RFID reader” when read in light of the claims and specification, as the Nautilus standard dictates and thus the claim term is not indefinite. *See* Sharony Decl. ¶¶ 83-85. Here, a POSA would understand “the RFID reader” to refer to an RFID reader. *Id.*; *Microprocessor*, 520 F.3d at 1376; *Energizer Holdings*, 435 F.3d at 1370-71. Accordingly, no construction is necessary, as the term is easily understandable to those of skill in the art and not indefinite. *See Stragent*, 2013 WL 4829897, at *3-*4. But should the Court construe this term, Varia’s proposed construction is consistent with the specification and ordinary meaning of the term.

VI. CONCLUSION

For the foregoing reasons, Varia respectfully requests that the Court reject Apple’s proposed constructions and adopt Varia’s plain meanings and constructions in their entirety.

Dated: June 11, 2024
New York, New York

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of this document has been served on all counsel of record *via* email on June 11, 2024.

/s/ Natalie D. Lieber

Natalie D. Lieber