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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

MAXELL, LTD., Plaintiff, v. LG ELECTRONICS INC., LG ELECTRONICS U.S.A. INC. Defendants.	Case No. 5:24-cv-04972-EKL-SVK Hon. Judge Eumi K. Lee **DEFENDANTS' INVALIDITY CONTENTIONS**

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Pursuant to Patent L.R. 3-3, Defendants LG Electronics Inc. and LG Electronics U.S.A., Inc. (collectively, "Defendants" or "LG") provide the following Invalidity Contentions for U.S. Patent Nos.:

- 6,856,760 (the "'760 patent")
- 6,973,334 (the "'334 patent")
- 7,199,821 (the "'821 patent")
- 7,421,188 (the "'188 patent")
- 8,339,493 (the "'493 patent")
- 8,736,729 (the "'729 patent")
- 9,818,449 (the "'449 patent")
- 10,199,072 (the "'072 patent")
- 10,244,284 (the "'284 patent")

Together, these patents are defined as the "Patents-in-Suit" or "Asserted Patents." As of the date of these contentions, Plaintiff Maxell, Ltd. ("Maxell" or "Plaintiff") has asserted the following claims (the "Asserted Claims") of the Patents-in-Suit against LG:

Patent	Asserted Claims
'760 patent	4, 6, 7, 9
'334 patent	4, 6
'821 patent	6
'188 patent	4-6
'493 patent	10, 12-14
'729 patent	3-4
'449 patent	9-12
'072 patent	11-15
'284 patent	18-20

LG provides these Invalidity Contentions for only the Asserted Claims that Plaintiff has identified in its Patent L.R. 3-1 Disclosure of Asserted Claims and Infringement Contentions ("Infringement Contentions"). Defendants' exclusion from these Invalidity Contentions of patent

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claims that Plaintiff has not asserted in its Infringement Contentions is not an admission that those unasserted patent claims are valid. Defendants reserve the right to amend and supplement these Invalidity Contentions in the event that Plaintiff is permitted to later assert any of those currently-unasserted claims by way of amendment or supplementation of its Infringement Contentions.

Defendants expressly reserve the right to amend, correct, and/or supplement these Contentions in accordance with the Procedural Schedule governing these cases.

I. Introduction

A. Preliminary Statement

These Invalidity Contentions are based on information reasonably available to Defendants and of which Defendants are aware at this time. These are not, and are not intended to be, final statements or admissions.

This case is still at an early stage. Discovery has just begun, the Court has not issued its claim construction order, and Plaintiff has so far provided little information and few documents in discovery. Defendants' investigations and discovery into third party sources of prior art are also underway. Defendants reserve all rights to amend, modify, or supplement these contentions: based on information learned through further investigation or discovery following the date of these Invalidity Contentions; in view of Court's construction of the Asserted Claims; in response to any findings as to the priority date of the Asserted Claims; in reaction to positions that Plaintiff or expert witness(es) may take concerning claim construction, infringement, and/or invalidity issues; in response to any disclosure by Plaintiff of amended or supplemental infringement contentions; if Defendants become aware of additional prior art, become aware of additional features of the prior art references cited below, or become aware of any other relevant information through discovery, including non-party discovery, or otherwise; and for any other proper reason. For the avoidance of doubt, Defendants reserve the right to amend these contentions based on further discovery or Court rulings (or any other related reason), including, for instance, the issuance of subpoenas to third parties believed to have knowledge, documentation, and/or corroborating evidence concerning some of the prior art listed below and/or additional prior art. These third parties may include, without limitation, any relevant authors, inventors, developers, designers,

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corporate designees with knowledge, or assignees.

In providing these Invalidity Contentions, Defendants have exceeded the level of detail required by the local rules. By providing such detail, Defendants do not concede that such detail is required or that the omission of similar detail in other areas is a deficiency. Thus, the inclusion of specific detail with respect to some aspects of these Invalidity Contentions does not prejudice any other aspects as to which less detail has been included.

In addition to the charts attached hereto, Defendants expressly incorporate by reference, as if expressly set forth in these Contentions, all invalidity positions, prior art, and claim charts asserted against Plaintiff in any Maxell lawsuit or IPR proceeding by any defendants, prior defendants, petitioners, and potential or actual licensees to the Asserted Patents.

B. General Reservations

These Invalidity Contentions reflect information currently known to Defendants based on their investigation to date. Defendants reserve the right to further revise, supplement, and amend their Invalidity Contentions, including by identifying, charting, and relying on additional references, or by identifying additional or different disclosures in the references identified herein.

The references disclosed herein and discussed in the claim charts attached hereto may disclose the limitations of the Asserted Claims explicitly, implicitly, or inherently, or they may be relied upon to show the state of the art as of the relevant time. The claim charts cite particular teachings and disclosures of the prior art as applied to features of the Asserted Claims. However, persons having ordinary skill in the art generally may view an item of prior art in the context of other publications, literature, products, and understanding. Accordingly, the cited portions are only examples, and Defendants' citations to disclosures in any particular prior art reference are not (and are not intended to be) exhaustive but rather illustrative. Defendants therefore reserve their right to rely on uncited portions of the prior art references and on other publications and expert testimony as aids in understanding and interpreting the cited portions, as providing context, thereto, as additional evidence that the prior art discloses a claim limitation, as evidence of the state of the art at a particular time, as evidence of the obviousness factor of contemporaneous development by others, and as evidence of motivation to combine. Defendants further reserve the

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right to rely on uncited portions of the prior art references, other publications, and testimony (including expert testimony) to establish bases for combinations of certain cited references that render the claims obvious.

Defendants' obviousness contentions and combinations are provided in the alternative to their anticipation contentions and are not to be construed to imply that any prior art reference included in the combinations is not by itself anticipatory. Defendants may present obviousness contentions and combinations in addition and as an alternative to an assertion of anticipation.

Prior art not included in this disclosure, whether known or not known to Defendants, may become relevant. In particular, Defendants are currently unaware of the extent, if any, to which Plaintiff will contend that limitations of the Asserted Claims are not disclosed in the prior art identified by Defendants. To the extent that such an issue arises, Defendants reserve the right to identify additional teachings in the same references or in other references that anticipate or would have made the addition of the allegedly missing limitation obvious.

Defendants also reserve the right to rely upon any documentary or testimonial evidence of the existence of any systems that embodied or practiced the disclosures found in the accompanying invalidity charts, for example as discussed in the prior art references cited herein, as such systems may qualify as prior art under 35 U.S.C. § 102(g).[1]

Defendants base these Invalidity Contentions on their current knowledge and understanding of the Asserted Patents, Plaintiff's Infringement Contentions, and the other facts and information available as of the date of these Invalidity Contentions. Defendants' investigation and analysis of the prior art remains ongoing, including of prior art identified in these disclosures or not yet known to Defendants, of third-party prior art, and of related evidence, documents, information, and witnesses. In particular, Defendants may seek third-party discovery related to the prior art, including documents and testimony related to the prior art. Defendants also have not yet deposed the inventors of the Asserted Patents, and discovery remains ongoing for these patents. Defendants may therefore amend their Invalidity Contentions upon receipt of additional discovery from Plaintiff or third parties and as Defendants' own investigation and analysis continues.

[1] Citations herein refer to the pre-AIA version of Title 35 of the U.S. Code.

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For the avoidance of doubt, Defendants intend to rely on admissions concerning the scope of the prior art relevant to the Asserted Patents found in, *inter alia*: the patent prosecution histories for the Asserted Patents and related patents and/or patent applications (including all prior art cited therein); any deposition testimony of the named inventors on the Asserted Patents and related patents and/or patent applications in this matter or any other matter; evidence and testimony relating to the level of skill in the art; and the papers filed and any evidence submitted by Maxell in connection with this matter.

C. Plaintiff's Inadequate Pat. L.R. 3-1 and 3-2 Disclosures

Defendants provide these Invalidity Contentions consistent with the schedule set forth in the Court's December 5, 2024 Order (ECF No. 118), but do so without waiving any right to receive from Plaintiff full, complete and detailed infringement disclosures as required under Pat. L.R. 3-1 and 3-2. Defendants' compliance with the schedule currently in place should not be viewed as a waiver of their right to seek relief regarding the deficiencies in Plaintiff's disclosures.

Plaintiff's Infringement Contentions are deficient in numerous respects. For example, Plaintiff's Infringement Contentions lack the specificity required under Pat. L.R. 3-1 that would be necessary to fairly provide Defendants notice of Plaintiff's theories, including without limitation: (1) Plaintiff fails to provide claim charts for each Accused Product, as shown by Plaintiff's Appendix 10 to its Infringement Contentions accusing at least 125 mobile products and 165 laptops, but providing no more than 9 total claim charts across 9 patents; (2) Plaintiff fails to support, with specificity and supporting documentary or declaratory evidence, its assertions that there are no material differences between the Accused Products that affect its infringement theories for the uncharted products; and (3) Plaintiff fails to identify where each element of each asserted claim is found within each Accused Instrumentality. Defendants incorporate by reference the letter from Bailey Benedict to Michael Molano, dated January 28, 2025, regarding Plaintiff's deficient Infringement Contentions.

Defendants specifically reserve the right to modify, amend, or supplement their Invalidity Contentions should Plaintiff be permitted to further modify, amend, or supplement its Pat L.R. 3-1 and 3-2 disclosures or produce documents responsive to Defendants' discovery requests.

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D. Priority Applications / Priority Date of Asserted Claims

These Invalidity Contentions, including but not limited to identification of prior art, rely in part on Plaintiff's contention that the Patents-in-Suit are entitled to the following claim(s) of priority, according to Plaintiff's disclosure pursuant to Patent L.R. 3-1(f):

- U.S. Patent No. 6,856,760 allegedly claims a priority date of July 5, 1999, based upon foreign application JP P11-189868.
- U.S. Patent No. 6,973,334 allegedly claims a priority date of November 10, 1998, based upon foreign application JP P10-318689.
- U.S. Patent No. 7,199,821 allegedly claims a priority date of February 27, 2002, based upon foreign application JP 2002-051841.
- U.S. Patent No. 10,244,284 allegedly claims a priority date of November 28, 2007, based upon foreign application JP 2007-306750.
- U.S. Patent No. 8,339,493 allegedly claims a priority date of October 27, 1999, based upon U.S. Application No. 90/014,628 (supposedly based on a Supplemental Declaration Under 37 CFR 1.131 dated October 15, 2021).
- U.S. Patent No. 8,736,729 allegedly claims a priority date of October 27, 1999, based upon U.S. Application No. 90/014,628 (supposedly based on a Supplemental Declaration Under 37 CFR 1.131 dated October 15, 2021).
- U.S. Patent No. 7,421,188 allegedly claims a priority date of March 5, 2002, based upon foreign application JP 2002-107158.
- U.S. Patent No. 9,818,449 allegedly claims a priority date of December 2, 2004, based upon foreign application JP 2004-349264.
- U.S. Patent No. 10,199,072 allegedly claims a priority date of December 2, 2004, based upon foreign application JP 2004-349264.

For the avoidance of doubt, Defendants dispute all of Plaintiff's claims of priority, and the use of Plaintiff's asserted priority dates is not an admission that these dates are correct and/or that the claims of priority are valid. For the sole purpose of providing these Invalidity Contentions, Defendants assume, under objection, that the Asserted Claims may benefit from Plaintiff's asserted

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priority dates. Given Defendants' prior art, Plaintiff's asserted priority dates cannot avoid invalidity.

Defendants, however, reserve the right to amend these Invalidity Contentions to the extent that Plaintiff is permitted to claim priority to an earlier application, assert an earlier conception or reduction to practice date than the priority application filing date, changes its alleged priority dates, or if the Court determines that any of the Patents-in-Suit are not entitled to claim priority to the earlier applications as asserted by Plaintiff.

E. Claim Construction

These Contentions are not intended to include or otherwise reflect Defendants' claim interpretations. Because the Court has not yet construed any of the claims in this litigation, Defendants base these Contentions at least on their present understanding of Plaintiff's view and Plaintiff's application of the claim scope of the Asserted Claims, to the extent that view can be inferred from Plaintiff's actual and/or apparent application of those claims. In other words, Defendants' Invalidity Contentions have, at least in part, relied upon Plaintiff's apparent claim construction positions as set forth in Plaintiff's Infringement Contentions, because the same claim scope must apply for both infringement and invalidity. However, Plaintiff's Infringement Contentions at times contradict the teachings of the Patents-In-Suit, contradict the meaning of the claim terms as would have been understood by a person of ordinary skill in the art, are internally inconsistent, and/or are vague and conclusory concerning how the claim limitations supposedly read on the Accused Products. As a result, Defendants are currently unable to fully discern Plaintiff's complete position regarding the construction of the claim limitations or terms. To the extent that Plaintiff supplements or amends its Infringement Contentions, Defendants reserve the right to modify, amend, and/or supplement these Invalidity Contentions.

By relying on Plaintiff's apparent claim construction positions as set forth in Plaintiff's Infringement Contentions, Defendants do not thereby implicitly or explicitly agree with Plaintiff's implicit or explicit construction(s) of the Asserted Claims. Nothing stated herein shall be construed as an admission or a waiver of any particular construction of any claim term or as an admission that Defendants agree with Plaintiff's apparent interpretation of the claims. For

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example, to the extent that Defendants assert that prior art is anticipatory or renders obvious claims based on the construction apparently applied by Plaintiff to the Asserted Claims, the Invalidity Contentions are not—and should not be interpreted as—adoptions or admissions as to the accuracy of that scope or construction.

Further, nothing stated herein shall be construed as a waiver of Defendants' right to challenge the Court's claim constructions on appeal on any basis. These Invalidity Contentions are not, and shall not be used as, evidence of Defendants' claim construction positions or contentions. Defendants' Contentions may even reflect alternative positions as to claim construction and scope.

By providing these Contentions, Defendants are not waiving nor limiting their rights to make arguments in the future about the proper scope of the claims or to advance alternative constructions to those Plaintiff advocates. Defendants expressly reserve the right to argue for narrower claim constructions during this litigation and to supplement these Contentions after the Court has issued a claim construction ruling.

Furthermore, nothing in these Invalidity Contentions shall be treated as an admission that Defendants' accused products meet any limitation of the Asserted Claims. References to the preamble of a claim in these Invalidity Contentions are not an admission that the preamble is, in fact, a limitation of a claim.

For the purposes of these Contentions, Defendants have made assumptions regarding possible meanings of indefinite claim terms. By making these assumptions, Defendants do not admit that any claim language satisfies 35 U.S.C. § 112. Similarly, the use of asserted claim terms herein should not be understood to mean that such terms, as used in the Asserted Patents or Asserted Claims, are definite or otherwise comply with the conditions of patentability under 35 U.S.C. § 112. Likewise, the use of any terms in any Asserted Claims should not be understood to suggest or imply a common, usual, ordinary, customary, plain, or accepted meaning in the art for any such terms.

Defendants reserve all rights to disclose new or supplemental invalidity contentions, including to address any construction of the claims rendered by the Court, changed theories of

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infringement, and any newly discovered evidence obtained through continued discovery, both formal and informal.

Unless otherwise stated herein, Defendants therefore takes no position on any matter of claim construction in these Invalidity Contentions. Defendants reserve the right to propose any claim construction they consider appropriate and to contest any claim construction they consider inappropriate. Because of the uncertainty of claim construction, Defendants reserve the right to further supplement or modify the positions and information in these Invalidity Contentions, including, without limitation, the prior art and grounds of invalidity set forth herein, after the Asserted Claims have been construed, in accordance with the Patent Rules and the Court's Orders.

F. Doctrine of Equivalents

Plaintiff has provided insufficient contentions regarding its allegations of infringement under the doctrine of equivalents. Plaintiff has not sufficiently provided any contentions that identify the basis for Plaintiff's position regarding each limitation allegedly infringed under the doctrine of equivalents and its alleged equivalent element in the accused products. Should leave to amend be granted to Plaintiff to add to its contentions any specific allegations of infringement under the doctrine of equivalents, Defendants reserve the right to amend or supplement these Invalidity Contentions as appropriate.

G. Ongoing Discovery and Disclosures

Discovery in this case and Defendants' investigation, including Defendants' search for prior art, are ongoing. Some of the relevant prior art and other information is in the possession of third parties, and Defendants are in the process of seeking discovery related to such prior art. For example, Defendant intends to subpoena or otherwise seek discovery from third parties regarding the prior art systems identified in these Invalidity Contentions, in addition to other systems that may be related to the Patents-In-Suit and printed publication references disclosed in these Invalidity Contentions. Defendants expressly reserve the right to amend or modify these Invalidity Contentions based on additional information obtained through continued formal discovery or other means pursuant to Fed. R. Civ. P. 26(e).

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Defendants further reserve the right to revise, amend, or supplement these Contentions, including by identifying, charting, and relying on additional information, references, systems, and devices, should Defendants' further search and analysis yield additional information, references, systems, or devices, consistent with the Local Patent Rules and the Federal Rules of Civil Procedure. In addition, Defendants reserve the right to supplement, amend, and/or alter the positions taken and information disclosed in these Invalidity Contentions including, without limitation, the prior art and grounds of invalidity set forth herein under 35 U.S.C. §§ 101, 102, 103 or 112, to take into account information or defenses that may come to light as a result of Defendants' discovery efforts; additional information obtained as to the alleged priority date(s) of the Asserted Claims; testimony or documents produced by a party or non-party; and positions that Plaintiff may take concerning infringement or invalidity issues. For example, Defendants may seek further discovery from third parties believed to have knowledge, documentation, or corroborating evidence concerning prior art references, including prior art listed herein. Such third parties may include, without limitation, the authors, inventors, assignees, owners, or developers of the references and technologies listed in these disclosures. In particular, Defendants reserve the right to assert invalidity under pre-AIA 35 U.S.C § 102(c), (d), (f), or (g) to the extent that discovery or further investigation yields information forming the basis for such grounds for invalidity.

H. Additional Explanation and Reservations of Rights

The citations to the prior art provided in these contentions are intended to be exemplary, not exhaustive. Defendants have endeavored to cite to the most relevant portions of the identified prior art. Other portions of the identified prior art may additionally disclose, either expressly or inherently, and/or render obvious one or more elements or limitations of the asserted claims. Defendants reserve the right to rely on uncited portions of the identified prior art to establish invalidity. Moreover, Defendants reserve the right to rely on uncited portions of the identified prior art, other art, or expert testimony to provide context to or aid in understanding the cited portions of the identified prior art. Defendants also reserve the right to rely upon treatises,

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published industry standards and similar documents to demonstrate the knowledge of one of ordinary skill in the relevant art.

Defendants further reserve the right to rely upon prior art cited in the file histories of the Patents-In-Suit and related patent applications, including post-issuance proceedings, as invalidating references or to show the state of the art. Defendants also reserve the right to rely upon additional prior art to show the state of the art. Defendants further intend to rely on inventor admissions, and admissions by Plaintiff and others providing testimony on behalf of Plaintiff (e.g., experts or inventors), concerning the scope of the prior art relevant to the Patents-In-Suit found in, *inter alia*: the patent prosecution history for the Patents-In-Suit and any related patents or patent applications, including post-issuance proceedings; any deposition testimony of the named inventors of the Patents-In-Suit; and the papers filed and any evidence submitted by Plaintiff in connection with this litigation, prior litigations, and other proceedings involving the Patents-in-Suit. Hence, Defendants incorporate by reference the relevant testimony of any witnesses who are deposed, provide declarations, or otherwise testify in this lawsuit.

Moreover, Defendants' IPR proceedings are part of the file histories of the Patents-in-Suit and Plaintiff should be estopped from taking positions in this Court contrary to positions it takes before the Patent Trial and Appeals Board. Defendants thus incorporate by reference the declaration(s), report(s) and testimony of any expert witnesses regarding invalidity of the Patents-In-Suit, either here or at the Patent Trial and Appeals Board.

Defendants' factual investigations, including their investigation of prior art and grounds for invalidity, is ongoing. Further, the Defendants' invalidity positions will be the subject of expert testimony. The Defendants reserve the right to supplement these Contentions, including, without limitation, adding additional prior art and grounds of invalidity in accordance with the Federal Rules of Civil Procedure and Procedural Schedule in these cases, or otherwise.

* * * * *

Subject to the foregoing statements and qualifications, as well as all rights reserved in these Contentions, Defendants state that all of the Asserted Claims are invalid under at least one or more of 35 U.S.C. §§ 101, 102, 103, and/or 112.

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II. Identification of Prior Art under pre-AIA 35 U.S.C. §§ 102 and/or 103

The Asserted Claims are invalid because they are anticipated and/or rendered obvious under 35 U.S.C. §§ 102 and 103. If Plaintiff contends or a fact-finder finds that one or more limitations of the Asserted Claims are not disclosed in the prior art identified as anticipatory, Defendants reserve the right to assert obviousness based on the identified references and/or to identify other references that would have rendered obvious the allegedly missing limitation. Furthermore, the obviousness combinations of references provided below and in the accompanying claim charts under 35 U.S.C. § 103 are exemplary only and are not intended to be exhaustive. If Plaintiff challenges the disclosure of any of these references with respect to particular limitations of the Asserted Claims, Defendants reserve the right to supplement these Contentions to assert additional or different bases for obviousness. Defendants reserve the right to use any combination of the references set forth in these contentions to demonstrate the obviousness of the Asserted Claims.

Defendants further incorporate by reference all invalidity positions presented in their filed IPR petitions (including IPR2025-00392; IPR2025-00393; IPR2025-00394; IPR2025-00444; IPR2025-00518; IPR2025-00519; and IPR2025-00520), and any other *inter partes* petition(s) that have been filed or may be filed against any of the Asserted Patents.

Subject to the foregoing statements and qualifications, Defendants identify the prior art in the tables below and in Exhibits A-01 through I-14, that anticipate and/or render obvious one or more of the asserted claims.

Patent	Claim Charts
’760 patent	Exhibits A-01 – A-17
’334 patent	Exhibits B-01 – B-15
’821 patent	Exhibits C-01 – C-11
’188 patent	Exhibits D-01 – D-11
’493 patent	Exhibits E-01 – E-13
’729 patent	Exhibits F-01 – F-15

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Patent	Claim Charts
’449 patent	Exhibits G-01 – G-14
’072 patent	Exhibits H-01 – H-13
’284 patent	Exhibits I-01 – I-14

Each prior art reference identified in Exhibits A-01 through I-14 expressly, implicitly, or inherently anticipates or renders obvious one or more of the claims of the Patents-in-Suit, either alone or in combination with other prior art references (including, without limitation, the references disclosed in in Exhibits A-01 through I-14) and/or the knowledge of those of ordinary skill in the art at the time of the alleged invention.

Additional anticipatory references and obviousness combinations are possible, and Defendants reserve the right to identify any such additional references or use any such additional combinations. In particular, Defendants are unaware of the extent, if any, to which Plaintiff will contend that the claim limitations are not met by the prior art identified by Defendants, or to which Plaintiff will contend that certain prior art references cannot or would not be combined. To the extent that an issue arises with any such limitation, elements, or combinations, Defendants reserve the right to identify other prior art references, disclosures, or combinations that would have made obvious the addition of the allegedly missing claim limitation.

Defendants reserve the right to assert that the Asserted Claims are invalid under 35 U.S.C. § 102(f) in the event Defendants obtain additional evidence that the inventor(s) named in any of the Asserted Patents did not invent the subject matter claimed therein. Should Defendants obtain such evidence, it will provide the name of the person(s) from whom and the circumstances under which the alleged invention or any part of it was derived.

A. Prior Art Patents

Pursuant to Patent L.R. 3-3(a), the table below identifies the prior art patents that Defendants presently assert anticipate and/or render obvious the Asserted Claims of one or more of the Asserted Patents.

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Patent Number / Patent Publication	Country of Origin	Date of Issue/Publication
CN 1146131 C (Zehavi)	China	Apr. 14, 2004
CN 1222031 A (Kochi)	China	July 7, 1999
EP 0404182 A1 (Saito)	EP	Dec. 29, 1990
EP 0452770 B1 (Suzuki)	EP	July 1, 1998
EP 0496383 A2 (Takahara)	EP	July 29, 1992
EP 0685932 A1 (Eudeline)	EP	Dec. 6, 1995
EP 0735776 A2 (Fujii)	EP	Oct. 2, 1996
EP 0756796 B1 (Arimilli)	EP	Sept. 27, 2000
EP 0802688 A2 (Inoue)	EP	Oct. 22, 1997
EP 0827125 A2 (Watanabe)	EP	Mar. 4, 1998
EP 0837341 A1 (Mannings)	EP	Apr. 22, 1998
EP 0844794 A2 (Matsuo)	EP	May 27, 1998
EP 0849958 A2 (Takashimizu)	EP	June 24, 1998
EP 0860829 A2 (Todaka)	EP	Aug. 26, 1998
EP 0876004 A2 (Norimatsu)	EP	Nov. 4, 1998
EP 0890925 A2 (Deering)	EP	Jan. 13, 1999
EP 0891100 A1 (Amonou)	EP	Jan. 13, 1999
EP 0892557 A1 (Liang)	EP	Jan. 20, 1999
EP 0926888 A2 (Sakaguchi)	EP	June 30, 1999
EP 2270732 A1 (Barton)	EP	Jan. 5, 2011
GB 2316561 A (Welch)	GB	Feb. 25, 1998
JPS 61101850 A (Tezuka)	Japan	May 20, 1986
JPH 01-271796 A (Komata)	Japan	Oct. 30, 1989
JPH 03-148989 A (Tanabe)	Japan	June 25, 1991
JPH 03-280727 A (Takahiko)	Japan	Dec. 11, 1991
JPH 04-10887 A (Haruki '887)	Japan	Jan. 16, 1992
JPH 04-88761 A (Suzuki)	Japan	Mar. 23, 1992
JPH 04-277909 A (Masubuchi)	Japan	Oct. 2, 1992
JPH 05-257987 A (Oba)	Japan	Aug. 10, 1993
JPH 05-343929 A (Yokota)	Japan	Dec. 24, 1993
JPH 06-46321 A (Satoshi)	Japan	Feb. 18, 1994
JPH 06-93631 B2 (Ono)	Japan	Nov. 16, 1994
JPH 06-230861 A (Ohira)	Japan	Aug. 19, 1994
JPH 06-252797 A (Abe)	Japan	Sept. 9, 1994
JPH 07-281798 A (Nobuyoshi)	Japan	Oct. 27, 1995
JPH 08-140104 A (Ikeda)	Japan	May 31, 1996
JPH 08-202982 A (Takashi)	Japan	Aug. 9, 1996
JPH 08-242410 A (Parulski)	Japan	Sept. 17, 1996
JPH 08-321981 A (Tamamura)	Japan	Dec. 3, 1996
JPH 09-46152 A (Sekine)	Japan	Feb. 14, 1997
JPH 09-116357 A (Yanigasawa)	Japan	May 2, 1997
JPH 09-163275 A (Sato)	Japan	June 20, 1997
JPH 09-266412 A (Kimura)	Japan	Oct. 7, 1997
JPH 10-108121 A (Masahiro)	Japan	Apr. 24, 1998
JPH 10-108133 A (Ishikawa)	Japan	Apr. 24, 1998

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Patent Number / Patent Publication	Country of Origin	Date of Issue/Publication
JPH 10-154914 A (Tanemura)	Japan	June 9, 1998
JPH 10-164483 A (Takaichi)	Japan	June 19, 1998
JPH 10-174027 A (Ida)	Japan	June 26, 1998
JPH 10-190381 A (Kumagai)	Japan	July 21, 2998
JPH 10-232992 A (Nojima)	Japan	Sept. 2, 1998
JPH 10-285059 A (Nakayama)	Japan	Oct. 23, 1998
JPH 11-69228 A (Takada)	Japan	Mar. 9, 1999
JPH 11-176137 A (Okada)	Japan	July 2, 1999
JPH 11-191859 A (Sakaguchi)	Japan	July 13, 1999
JPH 11-214043 A (Kuumi)	Japan	Aug. 6, 1999
JPH 11-215429 A (Umezawa)	Japan	Aug. 6, 1999
JPH 11-252468 A (Nishikawa)	Japan	Sept. 17, 1999
JPH 11-275512 A (Shioji)	Japan	Oct. 8, 1999
JPH 11-339056 A (Naito)	Japan	Dec. 10, 1999
JP 2000004445 A (Tanaka)	Japan	Jan. 7, 2000
JP 2000059586 A (Honda)	Japan	Feb. 25, 2000
JP 2000092440 A (Ogura)	Japan	Mar. 31, 2000
JP 2000115800 A (Noguchi)	Japan	Apr. 21, 2000
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US 7,917,557 B2 (Shteyn)	US	Mar. 29, 2011
US 7,970,240 B1 (Chao)	US	June 28, 2011
US 8,032,010 B2 (Kim)	US	Oct. 4, 2011
US 8,112,711 B2 (Ackley)	US	Feb. 7, 2012
US 8,132,204 B2 (Haberman)	US	Mar. 6, 2012
US 8,160,495 B2 (Khedouri)	US	Apr. 17, 2012
US 8,181,218 B2 (Asmussen)	US	May 15, 2012
US 8,539,545 B2 (Kartha)	US	Sept. 17, 2013
US 8,707,354 B1 (Moreau)	US	Apr. 22, 2014
US 8,995,003 B2 (Kim)	US	Mar. 31, 2015
US 9,053,754 B2 (DeYonker)	US	June 9, 2015
US 9,165,282 B2 (Fischer)	US	Oct. 20, 2015
US 9,176,643 B2 (Elia)	US	Nov. 3, 2015
US 9,563,702 B2 (Hannum)	US	Feb. 7, 2017
US 9,690,466 B2 (Coburn)	US	June 27, 2017
US RE 32,632 (Atkinson)	US	Mar. 29, 1988
WO 92/05651 A1 (Timmermans)	WO	Apr. 2, 1992
WO 93/07702 A1 (Wheatley)	WO	Apr. 15, 1993
WO 98/49771 A1 (Sharp)	WO	Nov. 5, 1998
WO 98/57294 A1 (Anderson)	WO	Dec. 17, 1998
WO 98/57300 A2 (Anderson)	WO	Dec. 17, 1998
WO 99/09374 A2 (Knockeart)	WO	Feb. 25, 1999
WO 99/38167 A1 (Kikuchi)	WO	July 29, 1999
WO 01/38993 A1 (Melmon)	WO	May 31, 2001
WO 01/82605 A1 (Kato)	WO	Nov. 1, 2001
WO 01/82609 A1 (Hamada)	WO	Nov. 1, 2001

B. Prior Art Publications

Pursuant to Patent L.R. 3-3(a), the table below identifies the prior art patents that

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Defendants presently assert anticipate and/or render obvious the Asserted Claims of one or more of the Asserted Patents.

Title, Publisher	Author	Date of Publication
3GPP; Technical Specification Group TSG SA; Requirements for service continuity between mobile and WLAN networks; (Release 8) V1.0.0	3GPP	Aug. 2007
A 'Pile' Metaphor for Supporting Casual Organization of Information, SIGCHI Conf. on Human Factors in Computing Systems	Mander	May 1992
A Cooperative Game Framework for Bandwidth Allocation in 4G Heterogeneous Wireless Networks, IEEE International Conference on Communications	Niyato	2006
A Digital Video Camera System, IEEE Transactions on Consumer Electronics, Vol. 36, No. 4	Morimura	Nov. 1990
A Dual Mode Digital Camera for Digital Still Imaging and Video Conferencing, Int'l 1998 Conference on Consumer Electronics	Metz	June 1998
A Family of Digital Cameras Using Still Optimized Sensors, J. Soc. Photogr. Sci. Technol. Japan, Vol. 59, No.1	Parulski	1996
A Flexible Content and Context-based Access Control Model for Multimedia Medical Image Database Systems, 4th Workshop on Multimedia & Security: New Challenges	Tzelepi	2001
A High Resolution CCD Camera for Scientific and Industrial Imaging Applications, SPIE Vol. 818	Martin	1987
A Low-Cost Megapixel Digital Camera Using High-Performance In-Camera Image Processing, IS&T 1998 PICS Conference	Dunsmore	1998
A Multi-service Architecture to Support Mobile IP Applications over Heterogeneous Wireless Networks, IEEE 2003	IEEE	2003
A Technique for the Maintenance of FET Power Amplifier Efficiency Under Backoff, IEEE MTT-S International Microwave Symposium Digest	Geller	June 1998
A Tour Through Cedar, IEEE Software Vol. 1, No. 2	Teitelman	1984
A Triple-Standard Transceiver Architecture For GSM, WCDMA and Wi-Fi Applications, 2005 12th IEEE International Conference on Electronics, Circuits and Systems	Zhang	Dec. 2005
A Utility-Based Network Selection Scheme for Multiple Services in Heterogeneous Networks, 2005 Int'l Conf. on Wireless Networks, Communications and Mobile Computing	Chan	2005

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Title, Publisher	Author	Date of Publication
A VLSI Implementation of Dual AC-3 And MPEG-2 Audio Decoder, IEEE International Conference on Consumer Electronics	Ko	Aug. 1998
ACDSee PowerPack User Guide	ACD Systems	Apr. 25, 2001
Advanced Configuration and Power Interface Specification, Rev. 1.0b	Intel	Feb. 2, 1999
AE, AWB Function for Video Printer, Institute of Image Information and Television Engineers	Sugimori	1991
Agfa ePhoto 1280 User Guide	Agfa	1997
An Analysis of CDMA with Imperfect Power Control, Dept. of EE, Virginia Polytechnic Institute and State University	Cameron	1992
Apple TV (1st Gen) Release Information	Apple	Jan. 9, 2007
Automatic White Balance for Digital Still Camera, Dept. of Comp. Sci. and Info. Engineering, National Taiwan University	Chiou	2000
Automatic White Balance for Digital Still Camera, IEEE Transactions on Consumer Electronics, Vol. 41, No. 3	Liu	Aug. 1995
Canon Elura Digital Video Camcorder Instruction Manual	Canon	1999
Canon PowerShot A5 Digital Camera Reference Guide	Canon	1998
Canon PowerShot Pro70 Digital Camera Hardware Guide	Canon	1998
Canon XL1 Digital Video Camcorder Instruction Manual	Canon	1997
Case-Studies on the Evolution of the Personalized Electronic Program Guide, Personalized Digital Television, Kluwer	Smyth	2004
Casio QV-2000UX, 2000UX/lr Service Manual & Parts List Ver. 1	Casio	Dec. 1999
Casio QV-2000UX/lr LCD Digital Camera User's Guide	Casio	1997
Casio QV-8000SX Service Manual & Parts List Ver. 2	Casio	Oct. 1999
Casio QV-8000SX User Guide	Casio	Sept. 10, 1999
CDMA Reverse Link Open Loop Power Control, Globecom '92, Communications for Global Users, IEEE	Soliman	Dec. 1992
Challenges in Portable RF Transceiver Design, IEEE Circuits and Devices Mag. Vol. 12, Issue 5	Razavi	Sept. 1996
Color Segmentation as an Aid to White Balancing for Digital Still Cameras, Proceedings of SPIE Vol. 4300	Cooper	2001
Development of MPEG Camera, Hitachi Video & Information System Co. Ltd., 1997 IEEE	Kurashige	1997
Digital Cameras Go Mainstream, Photo Marketing Association Report	Miller	Apr. 1997

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Title, Publisher	Author	Date of Publication
Digital cellular telecommunications system (Phase 2+); Feasibility study for evolved GSM/EDGE Radio Access Network (GERAN) (3GPP TR 45.912 version 7.2.0 Release 7), ETSI TR 145 912 V7.2.0	ETSI	June 2003
Digital Still Camera System for Megapixel CCD, IEEE Transactions on Consumer Electronics Vol. 44, No. 3	Nakano	Aug. 1998
Dolby AC-3 and MPEG-2 Audio Decoder IC with 6-Channels Output, IEEE Transactions on Consumer Electronics, Vol. 43, No. 3	Bergher	1997
Epson PhotoPC 650 Megapixel Digital Camera User's Guide	Seiko Epson	1999
Evolving Video Skims into Useful Multimedia Abstractions, SIGCHI Conf. on Human Factors in Computing Systems	Christel	Apr. 1998
Explorer 8300 and 8300HD DVR Getting Started Guide	Scientific Atlanta	2004
Fading Channels: Information-Theoretic and Communications Aspects, IEEE Transactions on Information Theory, Vol. 44, No. 6	Biglieri	Oct. 1998
FIT-Recommending TV Programs to Family Members, Computers & Graphics 28	Goren-Bar	2004
FofoFile: A Consumer Multimedia Organization and Retrieval System, SIGCHI Conf. on Human Factors in Computing Systems	Kuchinsky	May 1999
Full Audio Software Solution for a 16-Bit DSP Core for Digital Audio Decoder LSI, IEEE Transactions on Consumer Electronics, Vol. 44, No. 1	Okabe	Feb. 1998
Getting Started with Your EO Personal Communicator	Olivetti	1992
GIMP Official Handbook, Coriolis ("Kylander")	Kylander	1999
High Resolution CCD Still/Video and Still-Still/Video Systems, SPIE Vol. 1448 Camera and Input Scanner Systems	Kee	1991
High-Performance Digital Color Video Camera, Journal of Electronic Imaging 1(1)	Parulski	Jan. 1992
Hitachi Introduces World's First MPEG Camera in Japan, Hitachi Press Release	Hitachi	Jan. 1997
Hitachi MP-EG1A Instruction Manual ("MP-EG1 Manual")	Hitachi	1997
IconDropper Quick Start Guide	Iconfactory	Oct. 1999
IEEE Std 802.11g-2003, Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) specifications ("IEEE Std 802.11g")	IEEE	2003
Implementation of Dual Band Power Amplifier with High Efficiency in the Real Environment for CDMA Telephone, Electronics Letters, Vol. 34, No. 3	Yun	Feb. 5, 1998

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Title, Publisher	Author	Date of Publication
Integration of Multi-Radio Access in a Beyond 3G Network, IEEE 15th Int'l Symposium on Personal, Indoor and Mobile Radio Communications	Sachs	2004
Investigation of Radio Resource Scheduling in WLANs Coupled with 3G Cellular Network, IEEE Communications Magazine	Luo	June 2003
IP Digital Set Top Box Solutions Brief	Intel	2004
JVC GR-DV1 Instruction Manual	JVC	1996
Kodak Digital Science DC210 Plus Zoom / DC200 Cameras User's Guide	Kodak	1998
Kodak Digital Science DC220 and DC260 Zoom Cameras User's Guide	Kodak	1998
Kodak Professional DCS 300 Series Digital Cameras User's Guide	Kodak	1999
Making Computers Disappear: Appliance Data Services, ACM/IEEE International Conference on Mobile Computing and Networking	Huang	July 2001
Managing Images with Image BOSS, SPIE Vol. 3031	Augustine	May 7, 1997
Microsoft Windows 98 Getting Started Guide Second Ed.	Microsoft	1998
Minolta Introduces Four New Compact Video Camcorders – Master 8-864CS, 8-863S, 8-762CS and 8-761C Models, Minolta Press Release	Minolta	May 9, 1996
Mobile Station-Base Station Compatibility Standard for Dual-Mode Wideband Spread Spectrum Cellular System, TIA/EIA/IS-95-A	TIA/EIA	May 1995
Modeling with Extend™, 1997 Winter Simulation Conference	Rivera	1997
Motorola Moto Q9h Smartphone User Manual	Motorola	2007
Multi-Class Resource Management in a Cellular/WLAN Integrated Network, IEEE Wireless Communications and Networking Conference	Song	2007
Nikon Coolpix 950 Digital Camera Reference Manual	Nikon	May 1999
Nikon E2/E2S Digital Still Camera Instruction Manual	Nikon	1995
Nokia 6131 NFC User Guide	Nokia	2007
Nokia N93 User Guide	Nokia	2006
Nokia N95 8GB User Guide	Nokia	2007
Nokia N95-1 User Guide	Nokia	2007
Nullsoft Winamp 5 Release Information	Nullsoft	2004
Olympus C-2000ZOOM Camedia Digital Camera Instruction Manual	Olympus	2000
On the Capacity of a Cellular CDMA System, IEEE Transactions on Vehicular Technology, Vol. 40, Issue 2	Gilhousen	May 1991
On the System Design Aspects of CDMA Applied to Digital Cellular and Personal Communications Networks, 41st IEEE Vehicular Technology Conference	Salmasi	1991

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Title, Publisher	Author	Date of Publication
Optimized Linear Phase Square-Root Nyquist FIR Filters for CDMA IS-95 and UMTS Standards, Signal Processing, Vol. 93, Issue 4	Ashrafi	Oct. 2012
Panasonic DMR-E60 DVD Recorder Operating Instructions	Panasonic	2003
Panasonic NV-DX100B Instruction Manual	Panasonic	1998
Panasonic PV-DV910 PalmSight Digital Video Camcorder Operating Instructions	Panasonic	1998
Panasonic PV-L759/PV-L859 PalmSight Camcorder Operating Instructions	Panasonic	1999
Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) specifications High-speed Physical Layer in the 5 GHz Band, IEEE Std 802.11a-1999	IEEE	1999
Part 15.3: Wireless Medium Access Control (MAC) and Physical Layer (PHY) Specifications for High Rate Wireless Personal Area Networks (WPANs), IEEE Std 802.15.3™-2003	IEEE	Sept. 2003
PC Data-Compatible MPEG Camera, Hitachi Review, Vol. 46 No. 5	Hitachi	Oct. 1997
Philips Jukebox HDD120 User Manual	Philips	2003
Photoshop 4 for Windows for Dummies, IDG Books	McClelland	1997
Pioneer DVR-510H DVD Recorder	Pioneer	2003
PlayStation Launches on November 17, 2006 in North America, SIE Communications Press Release	Sony	May 8, 2006
Portable Computer Camera with a Color Image Play-back LCD, SPIE Vol. 2416	Tsai	1995
Portable Document Format Reference Manual Ver. 1.2	Adobe Systems	Nov. 27, 1996
Power Management, Byte	Glass	Sept. 1991
Proposed WID on Voice Call Continuity, Tdoc C1-051182, 3GPP TSG-CT1 Meeting #39	Lucent Technologies	Aug. 2005
Prototype Digital Still Camera System, SPIE Vol. 2513	Jang	1995
Real-Time Images Captured by Remote Digital Camera, Graphic Arts Monthly	PC Magazine	Feb. 1999
Remote Vision, Moonlight's FoneCam Lets You Send Real-Time Still Images From Remote Locations Via A Phone Line, PC Magazine	Brown	Jan. 19, 1999
Ricoh RDC-5000 Digital Camera Operation Manual	Ricoh	1999
Rio 600 Digital Audio Player Getting Started Guide	Rio	2000
Sanyo DVR-V100E DVD Recorder+VCR User Manual	Sanyo	1997
Sharp VN-EZ1U MPEG-4 Digital Recorder Operation Manual	Sharp	1999
Single-Chip Video Camera with Multiple Integrated Functions, ISSCC99 / Session 17 /Paper WA 17.4	Ramacher	1999
Sony DCR-DVD100/DVD200/DVD300 Operating Instructions	Sony	2003

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Title, Publisher	Author	Date of Publication
Sony DCR-PC100 Operating Instructions	Sony	1999
Sony DCR-PC100 Review, Imaging Resources	Newell	Nov. 19, 1999
Sony DCR-PC100/PC100E Service Manual	Sony	1999
Sony DCR-TRV900 Digital Video Camera Recorder Operating Instructions	Sony	1998
Sony DSC-F505 Digital Still Camera Operating Instructions	Sony	1999
Sony MVC-FD83 Digital Still Camera Operating Instructions	Sony	1999
Sony MVC-FD83/FD88 Digital Still Camera Service Manual Ver. 1.0	Sony	1999
Sony MVC-FD91 Digital Still Camera Operating Instructions	Sony	1998
Sony MVC-FD91 Digital Still Camera Service Manual Ver. 1.0	Sony	1998
Sony PC Connecting Kit Operating Instructions	Sony	1997
Specification of the Bluetooth System	Bluetooth	Nov. 4, 2004
System Implications of Implementing Auto-Exposure on Consumer Digital Cameras, SPIE Vol. 3650	Sampat	Mar. 1999
System Implications of Implementing Auto-Focus on Consumer Digital Cameras, PICS 1999	Yeh	1999
System Implications of Implementing White Balance on Consumer Digital Cameras, SPIE Vol. 3965	Sampat	May 2000
System on a Chip for Digital Still Camera, IEEE Transactions on Consumer Electronics Vol. 45, No. 3	Okada	Aug. 1999
The Common RRM Approach to Admission Control for Converged Heterogeneous Wireless Networks, IEEE Wireless Communications	Skehill	Apr. 2007
The OpenGL Graphics System Utility Library Ver. 1.3, Silicon Graphics	Chin	Nov. 1998
The TV-Trawler Project, Wiley Periodicals	Rogers	2004
TiVo Hacks, O'Reilly	Krikorian	Aug. 2003
TiVo Home Media Features Guide Series 2	TiVo	2004
TiVo: Making Show Recommendations Using a Distributed Collaborative Filtering Architecture, Industry/Government Track Paper	Ali	Aug. 2004
Toshiba TC81220F, Video Audio Decoder, Transport Stream Processor RISC 32-bit MIPS System CPU Data Sheet	Toshiba	July 22, 1998
Using Thumbnails to Search the Web, Conference on Human Factors in Computing Systems	Woodruff	2001
Video Camera System Using Fuzzy Logic, IEEE Transactions on Consumer Electronics, Vol. 38, No. 3	Haruki	1992
Video CCD Based Portable Digital Still Camera, IEEE Transactions on Consumer Electronics Vol. 41. No. 3	Chan	Aug. 1995

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Title, Publisher	Author	Date of Publication
White Balance in Inspection Systems with a Neural Network, Computer Integrated Manufacturing Systems Vol. 9, No. 1	Yamashina	1996
Windows XP for Dummies, Wiley	Microsoft	Sept. 2001
Wireless Performance Optimization Solutions: Bluetooth and 802.11 Coexistence Product Bulletin	Texas Instruments	2003
WPAN/WLAN/WWAN Multi-Radio Coexistence, IEEE 802.11-07/2738r1	Jokela	Nov. 13, 2007
Xbox 360 Release Details	Microsoft	Nov. 22, 2005
Zenith DVR413 DVR Recorder Installation and Operating Guide	Zenith	2004

C. Prior Art Systems

Pursuant to Patent L.R. 3-3, the table below identifies the prior art sales and public use that Defendants presently assert anticipate and/or render obvious the Asserted Claims of one or more of the Asserted Patents.

System Identification	Date of Offer, Use, or Public Knowledge	Identify of the Person or Entity Making Public Disclosures
Apple iPhone 8	Sept. 2017	Apple
Apple TV	Jan. 2007	Apple
Canon EOS Kiss III	1999	Canon
Canon PowerShot A5	1998	Canon
Canon PowerShot Pro 70	1998	Canon
Canon XL1 Camcorder	1998	Canon
Casio QV-8000SX Digital Camera	Sept. 10, 1999	Casio
Hitachi MP-EG1 MPEG Camera	1997	Hitachi
HP Photosmart C200	1999	HP
IP-Digital Set Top Box	June 2004	Intel
JVC GR-DV1 Digital Video Camera	1996	JVC
Kodak DC215 and DC215 Zoom Cameras	1998	Kodak
Kodak DC220 and DC260 Zoom Cameras	1998	Kodak
Kodak Professional DCS 315 Digital Camera	1999	Kodak
Motorola Moto Q9h Smartphone	2007	Motorola
Motorola PageWriter	1997	Motorola
Mustek MDC-800	1999	Mustek
Nikon CoolPix 950	1999	Nikon
Nokia 6131 Phone	Feb. 2006	Nokia
Nokia N93 Phone	Apr. 2006	Nokia
Nokia N95 Phone	March 2007	Nokia
Nullsoft Winamp 5	Dec. 2003	Nullsoft

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System Identification	Date of Offer, Use, or Public Knowledge	Identify of the Person or Entity Making Public Disclosures
Paging Network / Pagenet VoiceNow	1998	Paging Network Inc.
Panasonic DMR-E60 DVD Video Recorder	2003	Panasonic
Panasonic NV-DX100B Digital Video Camera	1998	Panasonic
Pentax IQ Zoom 120MI	1999	Pentax
Phototelesis RCU-400/RCU-403	1998	Phototelesis Corp.
Phototelesis ATR-403/AVX-3	1998	Phototelesis Corp.
Research In Motion BlackBerry 850	1999	Research In Motion
Research In Motion Inter@ctive Pager 800	1998	Research In Motion
Research In Motion Inter@ctive Pager 900	1996	Research In Motion
Research In Motion Inter@ctive Pager 950	1998	Research In Motion
Research In Motion Inter@ctive Pager 962	1998	Research In Motion
Sharp VN-EZ1 MPEG-4 Digital Recorder	1999	Sharp
Sony DCR-DVD200 Digital Video Camera Recorder	2003	Sony
Sony DCR-PC100 Digital Camera Recorder	Sept. 1999	Sony
Sony DCR-TRV900 Digital Video Camera Recorder	Sept. 1998	Sony
Sony MVC-FD83 Digital Still Camera	June 1999	Sony
Sony MVC-FD91 Digital Still Camera	1998	Sony
Sony PC Connecting Kit Product	1997	Sony
Sony PlayStation 3	Nov. 2006	Sony
Wireless Access SkyWriter	1996	Wireless Access
Xbox 360	Nov. 2005	Microsoft
Zenith DVR413 DVD Recorder	2004	Zenith

Defendants reserve all rights to pursue additional discovery about the systems identified above and to supplement these Invalidity Contentions.

D. Exemplary Bases for Anticipation and/or Obviousness

Pursuant to Patent L.R. 3-3(b), the tables above identify prior art that anticipates the asserted claims expressly or inherently, or that in combination with the knowledge of one of ordinary skill in the art and/or in combination with other references renders the Asserted Claims obvious. The accompanying claim charts set forth the bases for anticipation and obviousness, including charts identifying where exemplary prior art reference disclose, alone or in combination

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with other references, each element of each Asserted Claim on a limitation-by-limitation basis. In some instances, these conclusions are based on Plaintiff's apparent claim constructions, as reflected in its Infringement Contentions. To the extent that a reference or combination of references is found not to disclose an element of the claims, Defendants reserve all rights to combine an anticipatory reference or combination of references with the knowledge of one of ordinary skill in the art or any other reference cited in these Contentions.

Each of the prior art references disclosed in the preceding sections, in Exhibits A-01 through I-14, and/or in Defendants' accompanying document production may be combined with information known to persons skilled in the art at the time of the alleged invention or other such prior art references. Specific combinations of prior art, by way of example, are provided in Exhibits A-01 through I-14 and below in the Motivation to Combine section.

Defendants' claim charts are exemplary and are not intended to be exhaustive. Where Defendants identify a particular figure in a prior art reference, the identification should be understood to encompass the caption and description of the figure, as well as any text relating to the figure in addition to the figure itself. Similarly, where an identified portion of text refers to a figure or other material, the identification should be understood to include the referenced figure or other related material as well. It should be recognized that a person of ordinary skill in the art would generally read a prior art reference as a whole and in the context of other publications, literature, and general knowledge in the field. To understand and interpret any specific statement or disclosure in a prior art reference, a person of ordinary skill in the art would rely upon other information, including other publications and general scientific or engineering knowledge. Defendants therefore reserve the right to rely upon other unidentified portions of the prior art references and on other publications and expert testimony to provide context and to aid understanding and interpretation of the identified portions.

Defendants also reserve the right to rely upon other portions of the prior art references, other publications, and the testimony of experts to establish that the alleged inventions would have been obvious to a person of ordinary skill in the art, including the basis of modifying or combining certain cited references. To the extent any limitation is deemed not to be exactly met by an item

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of prior art, then any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge of those skilled in the art. To the extent that an element of an Asserted Claim is not anticipated, the claim is rendered obvious by combination with one or more other prior art references identified in Exhibits A-01 through I-14.

In addition, Defendants incorporate by reference each and every prior art reference or system identified or described in the prosecution of the Asserted Patents and related applications, including the statements made therein by the applicants, as well as the prior art discussed in the specification of each Asserted Patent. Defendants further incorporate by reference all invalidity positions presented in their filed IPR petitions (including IPR2025-00392; IPR2025-00393; IPR2025-00394; IPR2025-00444; IPR2025-00518; IPR2025-00519; and IPR2025-00520), and any other *inter partes* petition(s) that have been filed or may be filed against any of the Asserted Patents.

While Defendants herein provide notice of the prior art references that render obvious the Asserted Claims, including illustrative teachings, suggestions, and motivations to combine such references, Defendants reserve the right to provide more detailed discussions of the references and the corresponding motivations to combine in its forthcoming expert reports.

1. General and Exemplary Non-Limiting Motivations to Combine Applicable to All Patents

Although the Courts in the Northern District of California do not require Defendants to identify motivations to combine and although Defendants contend that no specific motivation to combine is necessary for the references cited herein and/or in the attached Exhibits, Defendants provide in this Section II.D, and its subsections such as this Subsection II.D.1, exemplary and non-limiting motivations to assist Plaintiff in understanding Defendants' asserted obviousness combinations. These exemplary discussions regarding obviousness are illustrative, and not intended to be exhaustive. The general and exemplary non-limiting motivations in this Subsection II.D.1 apply to all Asserted Patents, and are expressly incorporated into Subsections II.D.2-8 below. Because the identified motivations in Subsections II.D.1-8 (as well as elsewhere in this

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document or the attached Exhibits) are illustrative, non-limiting, and only exemplary and because discovery is ongoing, Defendants reserve the right to identify additional and/or alternative motivations, to modify and/or revise motivations, and to withdraw and/or supplement any motivations, in their expert reports.

The U.S. Supreme Court decision in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007) ("*KSR*"), held that a claimed invention can be obvious even if there is no explicit, written teaching, suggestion, or motivation for combining the prior art to produce that invention. Accordingly, no showing of a specific motivation to combine prior art is required to combine the references disclosed in the attached charts, as each combination of art would have no unexpected results, and, at most, would simply represent a known alternative to one of ordinary skill in the art. *See KSR*, 127 S. Ct. at 1739-40 (rejecting the Federal Circuit's "rigid" application of the teaching, suggestion, or motivation to combine test, and instead espousing an "expansive and flexible" approach). The Supreme Court in *KSR* held that a person of ordinary skill in the art ("POSITA") is "a person of ordinary creativity, not an automaton" and "in many cases a person of ordinary skill in the art will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 1742. "In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim." *Id.* at 1741-42. "Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742. In particular, the Supreme Court emphasized the principle that "[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 1739. A key inquiry is whether the "improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The rationale to combine or modify prior art references is significantly stronger when the references seek to solve the same problem, come from the same field, and correspond well. *In re Inland Steel Co.*, 265 F.3d 1354, 1362 (Fed. Cir. 2001). The Federal Circuit allowed two references to be combined as invalidating art when "[the prior art] focus[es] on the same problem

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that the . . . patent addresses. . . . Moreover, both [prior art references] come from the same field. . . . Finally, the solutions to the identified problems found in the two references correspond well." *Id.* at 1364.

In *KSR*, the Supreme Court emphasized that inventions arising from ordinary innovation, ordinary skill, or common sense should not be patentable. *See generally KSR*, 127 S. Ct. 1727. Although a patent challenger is not required to show that one of ordinary skill in the art would have had a specific motivation to combine prior art references, such a showing may be helpful to the obviousness analysis. *Id.*

One of skill in the art would have been motivated to combine the references identified herein and in the accompanying claim charts attached as Exhibits because, for example, the identified combinations fall into one or more of the following categories:

- A combination of elements known in the prior art according to known methods to yield a predictable result;
- A combination that is a simple substitution of one or more known elements for another to obtain a predictable result;
- A combination that involves using a known technique to improve a similar device or method in the same way;
- A combination that involves applying a known technique to a known device or method ready for improvement to yield a predictable result;
- A combination that results from a finite number of identified, predictable solutions with a reasonable expectation of success, such that the solution was one which was "obvious to try";
- A combination that results from known work in one field of endeavor prompting variations of it for use either in the same field or a different field based on design incentives or other market forces in which the variations were predictable to one of ordinary skill in the art; and

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- A teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to modify the prior art reference or to combine the teachings of various prior art references to arrive at the claimed invention.

Further, the Federal Circuit has held that a motivation to combine references may be implicit for patents based on improvements:

> [A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the "improvement" is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal—and even commonsensical—we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him capable of combining the prior art references.

DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1368 (Fed. Cir. 2006). The prior art references identified herein explicitly or implicitly refer to other prior art references, share common authors or inventors, were published in the same journals, presented at the same conferences, were presented as proposals to standards working groups, and/or were developed at common companies, schools, or organizations, all of which would motivate one of skill in the art to combine them. These references are also within the field of the Asserted Patents and are directed to similar subject matter within that field. Additionally, any products, devices, or processes described in the references existed and/or were invented before or during the period in which the claimed inventions were developed, providing further motivation to combine them.

Further, the motivations to combine the teachings of the prior art references disclosed herein are found in the references themselves and: the nature of the problem being solved; the express, implied and inherent teachings of the prior art; the knowledge of persons of ordinary skill in the art; the fact that the prior art is generally directed towards relevant methods and systems; or the predictable results obtained in combining the different elements of the prior art. The following seven non-limiting and exemplary motivations illustrate, without restricting, such motivations.

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First, one of skill in the art would have been motivated to combine one or more of the references identified above with one another because they all relate to common objectives and subject matter. The references share commonalities in terms of their general subject matter, as well as the types of equipment, products, and/or approaches they describe. Moreover, a person of ordinary skill would have been motivated to combine the prior art based on the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. The identified prior art addresses the same or similar technical issues and suggest the same or similar solutions to those issues.

Second, a person of ordinary skill in the art would have understood that the references identified above explicitly or implicitly reference other prior art references, share common authors or inventors, were published in the same journals, presented at the same trade shows, events, and conferences, were presented as proposals to standards working groups, and/or were developed at common companies, schools, or organizations, all of which would motivate one of skill in the art to combine them. A person of ordinary skill in the art would have been motivated to look to, and combine, the teachings of those references with one another.

Third, the references identified above are also within the same field of the Asserted Patents and are directed to similar subject matter within that field. Moreover, many of the references identified above relate more specifically to the same goals, as well as the same or similar approaches of working toward that goal. Additionally, any products, devices, features, designs, or processes described in the references existed and/or were invented before or during the period in which the claimed inventions were developed, providing further motivation to combine them.

Fourth, one or more combinations of the prior art references identified above with other prior art references above would have been obvious because these references would have been combined with one another using: known methods to yield predictable results; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or a teaching, suggestion, or motivation in the prior art generally. In addition, it would have been obvious to try combining the prior art references above because there were only a finite number of predictable solutions and/or because known work in one field of

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endeavor prompted variations based on predictable design incentives and/or market forces either in the same field or a different one. In addition, the combination of prior art references identified above would have been obvious because the combinations represent known potential options with a reasonable expectation of success.

Fifth, additional evidence that there would have been a motivation to combine the prior art references identified above with one another includes, for example, the interrelated teachings of multiple prior art references; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the invention(s); and the background knowledge that would have been possessed by a person having ordinary skill in the art. For example, prior to the alleged priority date of the Asserted Patents, it was well known that there were market, business, and technical demands for the alleged inventions. It was also well known that there existed ways of achieving those goals and similar objectives. It was also well understood how to design systems to meet the above objectives. A skilled artisan seeking to develop such a system would consider existing systems and techniques for increasing their capacity. Given that the references above have common and well-known design features one of ordinary skill in the art would have been motivated to combine these references, with a reasonable expectation of success, to design an improved digital communication.

Sixth, a person of ordinary skill at the time of the alleged invention had reason to combine or modify one or more of the references identified about in light of the knowledge of a person of ordinary skill in the art at the time of the invention and information in the prior art cited herein. They are all directed to features within the same field and one of ordinary skill in the art at the time of the alleged invention would have been motivated to look to these teachings in the field and combine any of these known technologies.

Seventh, many of the references identified above have common design features. One of ordinary skill in the art would have been motivated and found it obvious to combine these references, with a reasonable expectation of success, to improve existing communication systems.

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Defendants reserve all rights to further specify additional motivations to combine the prior art. Defendants may rely on cited or uncited portions of the prior art, other documents, and/or expert testimony to establish that a person of ordinary skill in the art would have been motivated to modify or combine the prior art so as to render the claims invalid as obvious. In addition to the exemplary motivations, suggestions, or reasons to combine described above, Defendants identify additional obviousness combinations and motivations to combine in the sections below, noting that any exemplary motivations, suggestions, or reasons to combine described above and below are not exclusive or exhaustive. Defendants may identify further examples as the case proceeds.

2. '760 Patent

The Asserted Claims of the '760 Patent are directed to methods of recording and reproducing still and moving pictures from a recording medium using standardized encoding techniques such as MPEG and JPEG. The '760 Patent describes a digital camera that can record in either a moving picture photographing mode or a still picture photographing mode depending on a switch setting. '760 Patent at 6:29-7:12. Figure 3 depicts a system block diagram of an exemplary video recording camera of the '760 Patent. *Id.* at 8:31-33. The camera includes switch 116, which indicates the user selection of a recording mode between a moving picture photographing mode and a still picture photographing mode. *Id.* at 9:5-7. When the moving picture photographing mode is selected, compressed moving streams are generated in moving picture compressing unit 105 and recorded on recording medium 114. *Id.* at 9:13-18. At the same time, pictures of a frame representing the moving picture being recorded (e.g., the picture of the start frame) are read from moving picture memory 107 and compressed by screen compressing unit 117 to produce thumbnail-sized (e.g., 160 pixels by 120 pixels) pictures. *Id.* at 9:18-26.

When the still picture photographic mode is selected, still picture file data are generated in fine still picture compressing unit 106 and recorded on recording medium 114. *Id.* at 9:33-36. In addition, a thumbnail picture of the still picture is generated by screen compressing unit 117 and recorded on recording medium 114 as thumbnail file data. *Id.* at 9:40-50.

Moving pictures are compressed using a moving picture encoding standard, such as the MPEG (Moving Picture Expert Group) standard, whereas still pictures are compressed using the

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JPEG (Joint Photographic coding Experts Group) standard. *Id.* at 1:27-61, 8:42-48. In the review mode (e.g., when reproducing the pictures from the recording medium), a list of thumbnail pictures on the recording medium is displayed on a display device. *Id.* at 12:7-20.

The '760 Patent purports to solve problems with "conventional techniques" by encoding still pictures with an encoding method such as MPEG and recording of both moving and still pictures. *Id*. at 2:4-16. However, these were all well known aspects of ordinary digital cameras before the time of the alleged inventions, as even the Asserted Patents suggest.

At least the following references anticipate and/or render obvious, alone or in combination with other references, the asserted claims of the '760 patent:

Exemplary Prior Art References
WO 98/57294 A1 ("Anderson")
U.S. Patent No. 6,683,649 ("Anderson I")
U.S. Patent No. 5,903,309 ("Anderson II")
U.S. Patent No. 4,969,204 ("Jones")
U.S. Patent No. 5,953,506 ("Kalra")
U.S. Patent No. 6,288,743 ("Lathrop")
U.S. Patent No. 5,566,284 ("Wakayama")
U.S. Patent No. 5,724,579 ("Suzuki")
JPH 10-108133 A ("Ishikawa")
Photoshop 4 for Windows for Dummies, IDG Books ("Photoshop 4 for Dummies")
GIMP Official Handbook, Coriolis ("Kylander")
Kodak DC220 and DC260 Zoom Cameras and User's Guide ("DC220/DC260")
Kodak Professional DCS 315 Digital Camera and User's Guide ("DCS 315")
Sony PC Connecting Kit Product and Operating Instructions ("PC Connecting Kit")
ACDSee PowerPack User's Guide ("ACDSee")
U.S. Patent No. 6,441,913 to Anabuki at al. ("Anabuki")
U.S. Pat. App. Pub. No. 2002/0131760 to Hirai et al. ("Hirai")
U.S. Patent No. 6,005,621 to Linzer et al. ("Linzer")
U.S. Patent No. 6,028,603 to Wang et al. ("Wang")
U.S. Patent No. 5,585,933 to Ichige et al. ("Ichige")
U.S. Patent Pub. 2003/0095596 to Shimizu ("Shimizu")

Defendants identify the following exemplary combinations as combinations of prior art showing obviousness for claims 4, 6, 7, and 9 of the '760 patent:

- ACDSee
- Anderson
- Anderson I

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- Anderson II
- DC220/DC260
- DCS 315
- Ishikawa
- Jones
- Kalra
- Kylander
- Lathrop
- PC Connecting Kit
- Photoshop 4 for Dummies
- Suzuki
- Wakayama
- ACDSee in view of Anabuki
- ACDSee in view of Anderson
- ACDSee in view of Anderson I
- ACDSee in view of Anderson II
- ACDSee in view of DC220/DC260
- ACDSee in view of DCS 315
- ACDSee in view of Hirai
- ACDSee in view of Ichige
- ACDSee in view of Ishikawa
- ACDSee in view of Jones
- ACDSee in view of Kalra
- ACDSee in view of Kylander
- ACDSee in view of Lathrop
- ACDSee in view of PC Connecting Kit
- ACDSee in view of Photoshop 4 for Dummies
- ACDSee in view of Shimizu
- ACDSee in view of Suzuki
- ACDSee in view of Wakayama
- ACDSee in view of Wang
- Anderson in view of ACDSee
- Anderson in view of Anabuki
- Anderson in view of Anderson I
- Anderson in view of Anderson II
- Anderson in view of DC220/DC260
- Anderson in view of DCS 315
- Anderson in view of Hirai
- Anderson in view of Ichige
- Anderson in view of Ishikawa
- Anderson in view of Jones
- Anderson in view of Kalra
- Anderson in view of Kylander

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- Anderson in view of PC Connecting Kit
- Anderson in view of Photoshop 4 for Dummies
- Anderson in view of Shimizu
- Anderson in view of Suzuki
- Anderson in view of Wakayama
- Anderson in view of Wang
- Anderson I in view of ACDSee
- Anderson I in view of Anabuki
- Anderson I in view of Anderson
- Anderson I in view of Anderson II
- Anderson I in view of DC220/DC260
- Anderson I in view of DCS 315
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- Anderson I in view of Wakayama
- Anderson I in view of Wang
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- Anderson II in view of Ichige
- Anderson II in view of Ishikawa
- Anderson II in view of Jones
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- Anderson II in view of Lathrop
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- Anderson II in view of Suzuki

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- Anderson II in view of Wang
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- DC220/DC260 in view of Anderson
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- DC220/DC260 in view of Anderson II
- DC220/DC260 in view of DCS 315
- DC220/DC260 in view of Hirai
- DC220/DC260 in view of Ichige
- DC220/DC260 in view of Ishikawa
- DC220/DC260 in view of Jones
- DC220/DC260 in view of Kalra
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- DC220/DC260 in view of Lathrop
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- DC220/DC260 in view of Shimizu
- DC220/DC260 in view of Suzuki
- DC220/DC260 in view of Wakayama
- DC220/DC260 in view of Wang
- DCS 315 in view of ACDSee
- DCS 315 in view of Anabuki
- DCS 315 in view of Anderson
- DCS 315 in view of Anderson I
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- DCS 315 in view of Ishikawa
- DCS 315 in view of Jones
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- DCS 315 in view of Kylander
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- DCS 315 in view of Shimizu
- DCS 315 in view of Suzuki
- DCS 315 in view of Wakayama
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- Ishikawa in view of Anabuki
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- Jones in view of Wakayama
- Jones in view of Wang
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- Kalra in view of Wakayama
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- Photoshop 4 for Dummies in view of Anderson
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- Photoshop 4 for Dummies in view of Jones
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- Photoshop 4 for Dummies in view of Kylander
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- ACDSee in view of DC220/DC260 and Suzuki
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- ACDSee in view of Ishikawa and Wakayama
- ACDSee in view of Ishikawa and Wang
- ACDSee in view of Jones and Anabuki
- ACDSee in view of Jones and Anderson
- ACDSee in view of Jones and Anderson I
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- ACDSee in view of Jones and DC220/DC260
- ACDSee in view of Jones and DCS 315
- ACDSee in view of Jones and Hirai
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- ACDSee in view of Kalra and Anabuki
- ACDSee in view of Kalra and Anderson
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- ACDSee in view of Kylander and Anabuki
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- ACDSee in view of Kylander and Suzuki
- ACDSee in view of Kylander and Wakayama
- ACDSee in view of Kylander and Wang
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- Linzer in view of Anderson I and Kalra
- Linzer in view of Anderson I and Kylander
- Linzer in view of Anderson I and Lathrop
- Linzer in view of Anderson I and PC Connecting Kit
- Linzer in view of Anderson I and Photoshop 4 for Dummies
- Linzer in view of Anderson I and Shimizu
- Linzer in view of Anderson I and Suzuki
- Linzer in view of Anderson I and Wakayama
- Linzer in view of Anderson I and Wang
- Linzer in view of Anderson II
- Linzer in view of Anderson II and Anabuki
- Linzer in view of Anderson II and Anderson
- Linzer in view of Anderson II and Anderson I
- Linzer in view of Anderson II and DC220/DC260
- Linzer in view of Anderson II and DCS 315
- Linzer in view of Anderson II and Hirai
- Linzer in view of Anderson II and Ichige
- Linzer in view of Anderson II and Ishikawa
- Linzer in view of Anderson II and Jones

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- Linzer in view of Anderson II and Kalra
- Linzer in view of Anderson II and Kylander
- Linzer in view of Anderson II and Lathrop
- Linzer in view of Anderson II and PC Connecting Kit
- Linzer in view of Anderson II and Photoshop 4 for Dummies
- Linzer in view of Anderson II and Shimizu
- Linzer in view of Anderson II and Suzuki
- Linzer in view of Anderson II and Wakayama
- Linzer in view of Anderson II and Wang
- Linzer in view of DC220/DC260
- Linzer in view of DC220/DC260 and Anabuki
- Linzer in view of DC220/DC260 and Anderson
- Linzer in view of DC220/DC260 and Anderson I
- Linzer in view of DC220/DC260 and Anderson II
- Linzer in view of DC220/DC260 and DCS 315
- Linzer in view of DC220/DC260 and Hirai
- Linzer in view of DC220/DC260 and Ichige
- Linzer in view of DC220/DC260 and Ishikawa
- Linzer in view of DC220/DC260 and Jones
- Linzer in view of DC220/DC260 and Kalra
- Linzer in view of DC220/DC260 and Kylander
- Linzer in view of DC220/DC260 and Lathrop
- Linzer in view of DC220/DC260 and PC Connecting Kit
- Linzer in view of DC220/DC260 and Photoshop 4 for Dummies
- Linzer in view of DC220/DC260 and Shimizu
- Linzer in view of DC220/DC260 and Suzuki
- Linzer in view of DC220/DC260 and Wakayama
- Linzer in view of DC220/DC260 and Wang
- Linzer in view of DCS 315
- Linzer in view of DCS 315 and Anabuki
- Linzer in view of DCS 315 and Anderson
- Linzer in view of DCS 315 and Anderson I
- Linzer in view of DCS 315 and Anderson II
- Linzer in view of DCS 315 and DC220/DC260
- Linzer in view of DCS 315 and Hirai
- Linzer in view of DCS 315 and Ichige
- Linzer in view of DCS 315 and Ishikawa
- Linzer in view of DCS 315 and Jones
- Linzer in view of DCS 315 and Kalra
- Linzer in view of DCS 315 and Kylander
- Linzer in view of DCS 315 and Lathrop
- Linzer in view of DCS 315 and PC Connecting Kit
- Linzer in view of DCS 315 and Photoshop 4 for Dummies

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- Linzer in view of DCS 315 and Shimizu
- Linzer in view of DCS 315 and Suzuki
- Linzer in view of DCS 315 and Wakayama
- Linzer in view of DCS 315 and Wang
- Linzer in view of Hirai
- Linzer in view of Ichige
- Linzer in view of Ishikawa
- Linzer in view of Ishikawa and Anabuki
- Linzer in view of Ishikawa and Anderson
- Linzer in view of Ishikawa and Anderson I
- Linzer in view of Ishikawa and Anderson II
- Linzer in view of Ishikawa and DC220/DC260
- Linzer in view of Ishikawa and DCS 315
- Linzer in view of Ishikawa and Hirai
- Linzer in view of Ishikawa and Ichige
- Linzer in view of Ishikawa and Jones
- Linzer in view of Ishikawa and Kalra
- Linzer in view of Ishikawa and Kylander
- Linzer in view of Ishikawa and Lathrop
- Linzer in view of Ishikawa and PC Connecting Kit
- Linzer in view of Ishikawa and Photoshop 4 for Dummies
- Linzer in view of Ishikawa and Shimizu
- Linzer in view of Ishikawa and Suzuki
- Linzer in view of Ishikawa and Wakayama
- Linzer in view of Ishikawa and Wang
- Linzer in view of Jones
- Linzer in view of Jones and Anabuki
- Linzer in view of Jones and Anderson
- Linzer in view of Jones and Anderson I
- Linzer in view of Jones and Anderson II
- Linzer in view of Jones and DC220/DC260
- Linzer in view of Jones and DCS 315
- Linzer in view of Jones and Hirai
- Linzer in view of Jones and Ichige
- Linzer in view of Jones and Ishikawa
- Linzer in view of Jones and Kalra
- Linzer in view of Jones and Kylander
- Linzer in view of Jones and Lathrop
- Linzer in view of Jones and PC Connecting Kit
- Linzer in view of Jones and Photoshop 4 for Dummies
- Linzer in view of Jones and Shimizu
- Linzer in view of Jones and Suzuki
- Linzer in view of Jones and Wakayama

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- Linzer in view of Jones and Wang
- Linzer in view of Kalra
- Linzer in view of Kalra and Anabuki
- Linzer in view of Kalra and Anderson
- Linzer in view of Kalra and Anderson I
- Linzer in view of Kalra and Anderson II
- Linzer in view of Kalra and DC220/DC260
- Linzer in view of Kalra and DCS 315
- Linzer in view of Kalra and Hirai
- Linzer in view of Kalra and Ichige
- Linzer in view of Kalra and Ishikawa
- Linzer in view of Kalra and Jones
- Linzer in view of Kalra and Kylander
- Linzer in view of Kalra and Lathrop
- Linzer in view of Kalra and PC Connecting Kit
- Linzer in view of Kalra and Photoshop 4 for Dummies
- Linzer in view of Kalra and Shimizu
- Linzer in view of Kalra and Suzuki
- Linzer in view of Kalra and Wakayama
- Linzer in view of Kalra and Wang
- Linzer in view of Kylander
- Linzer in view of Kylander and Anabuki
- Linzer in view of Kylander and Anderson
- Linzer in view of Kylander and Anderson I
- Linzer in view of Kylander and Anderson II
- Linzer in view of Kylander and DC220/DC260
- Linzer in view of Kylander and DCS 315
- Linzer in view of Kylander and Hirai
- Linzer in view of Kylander and Ichige
- Linzer in view of Kylander and Ishikawa
- Linzer in view of Kylander and Jones
- Linzer in view of Kylander and Kalra
- Linzer in view of Kylander and Lathrop
- Linzer in view of Kylander and PC Connecting Kit
- Linzer in view of Kylander and Photoshop 4 for Dummies
- Linzer in view of Kylander and Shimizu
- Linzer in view of Kylander and Suzuki
- Linzer in view of Kylander and Wakayama
- Linzer in view of Kylander and Wang
- Linzer in view of Lathrop
- Linzer in view of Lathrop and Anabuki
- Linzer in view of Lathrop and Anderson
- Linzer in view of Lathrop and Anderson I

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- Linzer in view of Lathrop and Anderson II
- Linzer in view of Lathrop and DC220/DC260
- Linzer in view of Lathrop and DCS 315
- Linzer in view of Lathrop and Hirai
- Linzer in view of Lathrop and Ichige
- Linzer in view of Lathrop and Ishikawa
- Linzer in view of Lathrop and Jones
- Linzer in view of Lathrop and Kalra
- Linzer in view of Lathrop and Kylander
- Linzer in view of Lathrop and PC Connecting Kit
- Linzer in view of Lathrop and Photoshop 4 for Dummies
- Linzer in view of Lathrop and Shimizu
- Linzer in view of Lathrop and Suzuki
- Linzer in view of Lathrop and Wakayama
- Linzer in view of Lathrop and Wang
- Linzer in view of PC Connecting Kit
- Linzer in view of PC Connecting Kit and Anabuki
- Linzer in view of PC Connecting Kit and Anderson
- Linzer in view of PC Connecting Kit and Anderson I
- Linzer in view of PC Connecting Kit and Anderson II
- Linzer in view of PC Connecting Kit and DC220/DC260
- Linzer in view of PC Connecting Kit and DCS 315
- Linzer in view of PC Connecting Kit and Hirai
- Linzer in view of PC Connecting Kit and Ichige
- Linzer in view of PC Connecting Kit and Ishikawa
- Linzer in view of PC Connecting Kit and Jones
- Linzer in view of PC Connecting Kit and Kalra
- Linzer in view of PC Connecting Kit and Kylander
- Linzer in view of PC Connecting Kit and Lathrop
- Linzer in view of PC Connecting Kit and Photoshop 4 for Dummies
- Linzer in view of PC Connecting Kit and Shimizu
- Linzer in view of PC Connecting Kit and Suzuki
- Linzer in view of PC Connecting Kit and Wakayama
- Linzer in view of PC Connecting Kit and Wang
- Linzer in view of Photoshop 4 for Dummies
- Linzer in view of Photoshop 4 for Dummies and Anabuki
- Linzer in view of Photoshop 4 for Dummies and Anderson
- Linzer in view of Photoshop 4 for Dummies and Anderson I
- Linzer in view of Photoshop 4 for Dummies and Anderson II
- Linzer in view of Photoshop 4 for Dummies and DC220/DC260
- Linzer in view of Photoshop 4 for Dummies and DCS 315
- Linzer in view of Photoshop 4 for Dummies and Hirai
- Linzer in view of Photoshop 4 for Dummies and Ichige

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- Linzer in view of Photoshop 4 for Dummies and Ishikawa
- Linzer in view of Photoshop 4 for Dummies and Jones
- Linzer in view of Photoshop 4 for Dummies and Kalra
- Linzer in view of Photoshop 4 for Dummies and Kylander
- Linzer in view of Photoshop 4 for Dummies and Lathrop
- Linzer in view of Photoshop 4 for Dummies and PC Connecting Kit
- Linzer in view of Photoshop 4 for Dummies and Shimizu
- Linzer in view of Photoshop 4 for Dummies and Suzuki
- Linzer in view of Photoshop 4 for Dummies and Wakayama
- Linzer in view of Photoshop 4 for Dummies and Wang
- Linzer in view of Shimizu
- Linzer in view of Suzuki
- Linzer in view of Suzuki and Anabuki
- Linzer in view of Suzuki and Anderson
- Linzer in view of Suzuki and Anderson I
- Linzer in view of Suzuki and Anderson II
- Linzer in view of Suzuki and DC220/DC260
- Linzer in view of Suzuki and DCS 315
- Linzer in view of Suzuki and Hirai
- Linzer in view of Suzuki and Ichige
- Linzer in view of Suzuki and Ishikawa
- Linzer in view of Suzuki and Jones
- Linzer in view of Suzuki and Kalra
- Linzer in view of Suzuki and Kylander
- Linzer in view of Suzuki and Lathrop
- Linzer in view of Suzuki and PC Connecting Kit
- Linzer in view of Suzuki and Photoshop 4 for Dummies
- Linzer in view of Suzuki and Shimizu
- Linzer in view of Suzuki and Wakayama
- Linzer in view of Suzuki and Wang
- Linzer in view of Wakayama
- Linzer in view of Wakayama and Anabuki
- Linzer in view of Wakayama and Anderson
- Linzer in view of Wakayama and Anderson I
- Linzer in view of Wakayama and Anderson II
- Linzer in view of Wakayama and DC220/DC260
- Linzer in view of Wakayama and DCS 315
- Linzer in view of Wakayama and Hirai
- Linzer in view of Wakayama and Ichige
- Linzer in view of Wakayama and Ishikawa
- Linzer in view of Wakayama and Jones
- Linzer in view of Wakayama and Kalra
- Linzer in view of Wakayama and Kylander

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- Linzer in view of Wakayama and Lathrop
- Linzer in view of Wakayama and PC Connecting Kit
- Linzer in view of Wakayama and Photoshop 4 for Dummies
- Linzer in view of Wakayama and Shimizu
- Linzer in view of Wakayama and Suzuki
- Linzer in view of Wakayama and Wang
- Linzer in view of Wang

To the extent that Plaintiff contends that any of the references identified in Exhibits A-01 through A-17 do not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background, experience with digital camera systems, and/or prior art, including but not limited to one or more of the prior art references identified above.

A person of ordinary skill in the art would have been motivated to combine or modify any of the references in Exhibits A-01 through A-17 and the list above to include these limitations because, for example, encoding techniques such as JPEG and MPEG were well known and documented in the prior art before the alleged priority date of the Asserted Patents. For example, both Anderson and Anderson I describe a digital video camera capable of capturing and displaying various types of image data including digital video and high resolution still images. *See* Exhibits A-01 through I-14. The digital video camera (DVC) described in Anderson I includes an image device and a computer which enables functionality of video codec performing MPEG-2 encoding on the streaming video during recording and MPEG-2 decoding during playback, which is an advanced version of MPEG I that the '760 Patent discloses. Anderson I at 5:66-6:1. The Anderson I digital video camera also captures still images in addition to video. *Id.* at 6:40-41. When a user initiates the capture function to capture a still or moving image, the captured image is compressed in the JPEG format, and stored as an image file on the storage device. *Id.* at 6:41-52. In the review mode, the DVC enables the user to review the contents of the DVC. *Id.* at 7:50-51. The review mode screen displays a series of object cells 300 that represent the media objects stored on the DVC. *Id.* at 7:60-62, Fig. 4A. In the case of a still image, object cell 300 displays a thumbnail of the media object, which is a small, low-resolution version of the image. *Id.* at 8:7-10. In the case of video segments, object cell 300 displays a representative thumbnail or frame from the video, typically the first frame of the video. *Id.* at 8:10-14. The user may navigate through the object

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displays to select and mark the desired objects and create an ordered list of objects. *Id.* at 8:66-9:6. The ordered list is then saved as a slide show. *Id.* at 9:6-7. When the slide show is presented, each media object comprising the slide show is automatically played back and displayed on display screen. *Id.* at 9:8-13.

A person of ordinary skill in the art would have found it obvious to combine, for example, Anderson and Anderson I to arrive at the purported invention of the '760 patent. Market forces and design incentives, for example, related to digital video cameras make the combination of such a system with any of the references identified in Exhibits A-01 through A-17 predictable to one of ordinary skill in the art. For example, a POSITA would have found obvious recording and displaying a list of thumbnail pictures corresponding to still pictures to improve the multimedia presentation on the digital cameras. Anderson I at 2:34-37. Indeed, Anderson I explicitly describes creating and displaying thumbnails from media objects (e.g., images, video, audio and text) stored in a digital imaging device (e.g., digital camera). A POSITA would have been found obvious to encode still pictures with the MPEG standard instead of JPEG because it is a simple substitution of known techniques.

Moreover, there were a finite number of identified, predictable image file compressing techniques in the prior art. Therefore, replacing any compression technique with any existing techniques (MPEG and JPEG) was a predicable solution that a person of ordinary skill in the art would know had a reasonable expectation of success.

Accordingly, to the extent Plaintiff contends that any reference identified in Exhibits A-01 through A-17 does not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background knowledge of one of ordinary skill in the art and/or by combining any reference identified in Exhibits A-01 through A-17 in view of any of the references identified in the chart above.

3. '334 Patent

The Asserted Claims of the '334 Asserted Patents include various basic components and methods of controlling transmission power and amplifiers in a cellular telephone that were all well known aspects of controlling transmission power in cellular telephones before the time of the

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alleged inventions, as even the Asserted Patents suggest. For example, the Asserted Claims include the basic "receiving," "generating," "converting," and "controlling" steps of signals used in cellular communications systems.

At least the following references anticipate and/or render obvious, alone or in combination with other references, the asserted claims of the '334 patent:

Exemplary Prior Art References
U.S. Patent No. 5,452,473 to Weiland et al. ("Weiland")
U.S. Patent No. 5,548,616 to Mucke et al. ("Mucke")
U.S. Patent No. 5,642,378 to Denheyer et al. ("Denheyer")
U.S. Patent No. 6,236,863 to Waldroup et al. ("Waldroup")
U.S. Patent No. 6,122,491 to Francisco ("Francisco")
Applicant Admitted Prior Art ("AAPA")
Japanese Patent Published Application No. H06-252797 to Abe ("Abe")
U.S. Patent No. 5,056,109 to Gilhousen et al. ("Gilhousen")
Japanese Patent Published Application No. H04-277909 to Masubuchi ("Masubuchi")
Japanese Patent Published Application No. H06-93631 to Ono ("Ono")
U.S. Patent No. 5,589,796 to Alberth et al. ("Alberth")
Japanese Patent Published Application No. H5-343929 to Yokota ("Yokota")
Japanese Patent Published Application No. H09-46152 to Sekine ("Sekine")
PCT International Publication No. WO 93/07702 to Wheatley ("Wheatley")
U.S. Patent No. 5,627,857 to Wilson ("Wilson")
U.S. Patent No. 5,430,760 to Dent ("Dent")
U.S. Patent No. 5,841,768 to Ozluturk et al. ("Ozluturk")
U.S. Patent No. 5,101,173 to DiPiazza et al. ("DiPiazza")
TIA/EIA/IS-95-A, Mobile Station-Base Station Compatibility Standard for Dual-Mode Wideband Spread Spectrum Cellular System, Telecommunication Industry Association ("IS-95")
JP Patent Published Application No. H09266412A to Kimura et al. ("Kimura).
EP Patent Published Application No. 0685932 A1 to Eudeline et al ("Eudeline")
UK Patent Application No. GB 2316561A to Welch et al. ("Welch")

Defendants identify the following exemplary combinations as combinations of prior art showing obviousness for claims 4 and 6 of the '334 patent:

- AAPA
- AAPA in view of Wilson
- AAPA in view of Wilson and Dent
- AAPA in view of Wilson and Ozluturk
- AAPA in view of Wilson and DiPiazza
- AAPA in view of Wilson, Ozluturk, and DiPiazza

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- AAPA in view of Wilson and Kimura
- AAPA in view of Wilson and Weiland
- AAPA in view of Wilson and Mucke
- AAPA in view of Wilson and Denheyer
- AAPA in view of Wilson and Sekine
- AAPA in view of Wilson and Masubuchi
- AAPA in view of Wilson and Alberth
- AAPA in view of Weiland
- AAPA in view of Weiland and Dent
- AAPA in view of Weiland and Ozluturk
- AAPA in view of Weiland and DiPiazza
- AAPA in view of Weiland, Ozluturk, and DiPiazza
- AAPA in view of Weiland and Kimura
- AAPA in view of Weiland and Mucke
- AAPA in view of Weiland and Denheyer
- AAPA in view of Weiland and Sekine
- AAPA in view of Weiland and Masubuchi
- AAPA in view of Weiland and Alberth
- AAPA in view of Mucke
- AAPA in view of Mucke and Dent
- AAPA in view of Mucke and Ozluturk
- AAPA in view of Mucke and DiPiazza
- AAPA in view of Mucke, Ozluturk, and DiPiazza
- AAPA in view of Mucke and Kimura
- AAPA in view of Mucke and Weiland
- AAPA in view of Mucke and Denheyer
- AAPA in view of Mucke and Sekine
- AAPA in view of Mucke and Masubuchi
- AAPA in view of Mucke and Alberth
- AAPA in view of Waldroup
- AAPA in view of Waldroup and Dent
- AAPA in view of Waldroup and Ozluturk
- AAPA in view of Waldroup and DiPiazza
- AAPA in view of Waldroup, Ozluturk, and DiPiazza
- AAPA in view of Waldroup and Kimura
- AAPA in view of Waldroup and Weiland
- AAPA in view of Waldroup and Mucke
- AAPA in view of Waldroup and Denheyer
- AAPA in view of Waldroup and Sekine
- AAPA in view of Waldroup and Masubuchi
- AAPA in view of Waldroup and Alberth
- AAPA in view of Dent
- AAPA in view of Ozluturk

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- AAPA in view of DiPiazza
- AAPA in view of Ozluturk and DiPiazza
- AAPA in view of Kimura
- AAPA in view of Denheyer
- AAPA in view of Sekine
- AAPA in view of Masubuchi
- AAPA in view of Alberth
- Abe
- Abe in view of Wilson
- Abe in view of Wilson and Dent
- Abe in view of Wilson and Ozluturk
- Abe in view of Wilson and DiPiazza
- Abe in view of Wilson, Ozluturk, and DiPiazza
- Abe in view of Wilson and Kimura
- Abe in view of Wilson and Weiland
- Abe in view of Wilson and Mucke
- Abe in view of Wilson and Denheyer
- Abe in view of Wilson and Sekine
- Abe in view of Wilson and Masubuchi
- Abe in view of Wilson and Alberth
- Abe in view of Dent
- Abe in view of Dent and Ozluturk
- Abe in view of Dent and DiPiazza
- Abe in view of Dent, Ozluturk, and DiPiazza
- Abe in view of Dent and Kimura
- Abe in view of Dent and Weiland
- Abe in view of Dent and Mucke
- Abe in view of Dent and Denheyer
- Abe in view of Dent and Sekine
- Abe in view of Dent and Masubuchi
- Abe in view of Dent and Alberth
- Abe in view of Ozluturk
- Abe in view of Ozluturk and DiPiazza
- Abe in view of Ozluturk and Kimura
- Abe in view of Ozluturk and Weiland
- Abe in view of Ozluturk and Mucke
- Abe in view of Ozluturk and Denheyer
- Abe in view of Ozluturk and Sekine
- Abe in view of Ozluturk and Masubuchi
- Abe in view of Ozluturk and Alberth
- Abe in view of IS-95-A
- Abe in view of IS-95-A and Dent
- Abe in view of IS-95-A and Ozluturk

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- Abe in view of IS-95-A and DiPiazza
- Abe in view of IS-95-A, Ozluturk, and DiPiazza
- Abe in view of IS-95-A and Kimura
- Abe in view of IS-95-A and Weiland
- Abe in view of IS-95-A and Mucke
- Abe in view of IS-95-A and Denheyer
- Abe in view of IS-95-A and Sekine
- Abe in view of IS-95-A and Masubuchi
- Abe in view of IS-95-A and Alberth
- Abe in view of Weiland
- Abe in view of Weiland and Dent
- Abe in view of Weiland and DiPiazza
- Abe in view of Weiland, Ozluturk, and DiPiazza
- Abe in view of Weiland and Kimura
- Abe in view of Weiland and Mucke
- Abe in view of Weiland and Denheyer
- Abe in view of Weiland and Sekine
- Abe in view of Weiland and Masubuchi
- Abe in view of Weiland and Alberth
- Abe in view of Mucke
- Abe in view of Mucke and DiPiazza
- Abe in view of Mucke, Ozluturk, and DiPiazza
- Abe in view of Mucke and Kimura
- Abe in view of Mucke and Denheyer
- Abe in view of Mucke and Sekine
- Abe in view of Mucke and Masubuchi
- Abe in view of Mucke and Alberth
- Abe in view of Waldroup
- Abe in view of Waldroup and Dent
- Abe in view of Waldroup and Ozluturk
- Abe in view of Waldroup and DiPiazza
- Abe in view of Waldroup, Ozluturk, and DiPiazza
- Abe in view of Waldroup and Kimura
- Abe in view of Waldroup and Weiland
- Abe in view of Waldroup and Mucke
- Abe in view of Waldroup and Denheyer
- Abe in view of Waldroup and Sekine
- Abe in view of Waldroup and Masubuchi
- Abe in view of Waldroup and Alberth
- Abe in view of DiPiazza
- Abe in view of Kimura
- Abe in view of Denheyer
- Abe in view of Sekine

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- Abe in view of Masubuchi
- Abe in view of Alberth
- Alberth
- Alberth in view of Wilson
- Alberth in view of Wilson and Dent
- Alberth in view of Wilson and Ozluturk
- Alberth in view of Wilson and DiPiazza
- Alberth in view of Wilson, Ozluturk, and DiPiazza
- Alberth in view of Wilson and Kimura
- Alberth in view of Wilson and Weiland
- Alberth in view of Wilson and Mucke
- Alberth in view of Wilson and Denheyer
- Alberth in view of Wilson and Sekine
- Alberth in view of Wilson and Masubuchi
- Alberth in view of Dent
- Alberth in view of Dent and Ozluturk
- Alberth in view of Dent and DiPiazza
- Alberth in view of Dent, Ozluturk, and DiPiazza
- Alberth in view of Dent and Kimura
- Alberth in view of Dent and Weiland
- Alberth in view of Dent and Mucke
- Alberth in view of Dent and Denheyer
- Alberth in view of Dent and Sekine
- Alberth in view of Dent and Masubuchi
- Alberth in view of Ozluturk
- Alberth in view of Ozluturk and Kimura
- Alberth in view of Ozluturk and Weiland
- Alberth in view of Ozluturk and Mucke
- Alberth in view of Ozluturk and Denheyer
- Alberth in view of Ozluturk and Sekine
- Alberth in view of Ozluturk and Masubuchi
- Alberth in view of IS-95-A
- Alberth in view of IS-95-A and Dent
- Alberth in view of IS-95-A and Ozluturk
- Alberth in view of IS-95-A and DiPiazza
- Alberth in view of IS-95-A, Ozluturk, and DiPiazza
- Alberth in view of IS-95-A and Kimura
- Alberth in view of IS-95-A and Weiland
- Alberth in view of IS-95-A and Mucke
- Alberth in view of IS-95-A and Denheyer
- Alberth in view of IS-95-A and Sekine
- Alberth in view of IS-95-A and Masubuchi
- Alberth in view of Weiland

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- Alberth in view of Weiland and Dent
- Alberth in view of Weiland and DiPiazza
- Alberth in view of Weiland, Ozluturk, and DiPiazza
- Alberth in view of Weiland and Kimura
- Alberth in view of Weiland and Mucke
- Alberth in view of Weiland and Denheyer
- Alberth in view of Weiland and Sekine
- Alberth in view of Weiland and Masubuchi
- Alberth in view of Mucke
- Alberth in view of Mucke and DiPiazza
- Alberth in view of Mucke, Ozluturk, and DiPiazza
- Alberth in view of Mucke and Kimura
- Alberth in view of Mucke and Denheyer
- Alberth in view of Mucke and Sekine
- Alberth in view of Mucke and Masubuchi
- Alberth in view of Waldroup
- Alberth in view of Waldroup and Dent
- Alberth in view of Waldroup and Ozluturk
- Alberth in view of Waldroup and DiPiazza
- Alberth in view of Waldroup, Ozluturk, and DiPiazza
- Alberth in view of Waldroup and Kimura
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- Waldroup in view of Wilson and Kimura
- Waldroup in view of Wilson and Weiland
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- Waldroup in view of Weiland
- Waldroup in view of Weiland and Dent
- Waldroup in view of Weiland and Ozluturk
- Waldroup in view of Weiland and DiPiazza
- Waldroup in view of Weiland, Ozluturk, and DiPiazza
- Waldroup in view of Weiland and Kimura
- Waldroup in view of Weiland and Mucke
- Waldroup in view of Weiland and Denheyer
- Waldroup in view of Weiland and Sekine
- Waldroup in view of Weiland and Masubuchi
- Waldroup in view of Weiland and Alberth
- Waldroup in view of Mucke
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- Waldroup in view of Mucke and Ozluturk
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- Waldroup in view of Mucke and Kimura
- Waldroup in view of Mucke and Denheyer
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- Waldroup in view of Dent and Kimura
- Waldroup in view of Dent and Denheyer
- Waldroup in view of Dent and Sekine
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- Waldroup in view of IS-95-A and Mucke
- Waldroup in view of IS-95-A and Denheyer
- Waldroup in view of IS-95-A and Sekine
- Waldroup in view of IS-95-A and Masubuchi
- Waldroup in view of IS-95-A and Alberth
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- Waldroup in view of Denheyer
- Waldroup in view of Sekine
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- Weiland in view of Dent
- Weiland in view of Dent and Ozluturk
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- Weiland in view of IS-95-A and Masubuchi
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- Weiland in view of DiPiazza
- Weiland in view of Kimura
- Weiland in view of Denheyer
- Weiland in view of Sekine
- Weiland in view of Masubuchi
- Weiland in view of Alberth
- Welch
- Welch in view of Wilson
- Welch in view of Wilson and Dent
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- Welch in view of Wilson and Kimura
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- Welch in view of Dent and Denheyer
- Welch in view of Dent and Sekine
- Welch in view of Dent and Masubuchi
- Welch in view of Dent and Alberth
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- Welch in view of Ozluturk and DiPiazza
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- Welch in view of Ozluturk and Weiland
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- Welch in view of IS-95-A and Kimura
- Welch in view of IS-95-A and Weiland
- Welch in view of IS-95-A and Mucke
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- Welch in view of IS-95-A and Sekine
- Welch in view of IS-95-A and Masubuchi
- Welch in view of IS-95-A and Alberth
- Welch in view of Weiland
- Welch in view of Weiland and Dent
- Welch in view of Weiland and Ozluturk
- Welch in view of Weiland and DiPiazza
- Welch in view of Weiland, Ozluturk, and DiPiazza
- Welch in view of Weiland and Kimura

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- Welch in view of Weiland and Sekine
- Welch in view of Weiland and Masubuchi
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- Welch in view of Mucke and DiPiazza
- Welch in view of Mucke, Ozluturk, and DiPiazza
- Welch in view of Mucke and Kimura
- Welch in view of Mucke and Denheyer
- Welch in view of Mucke and Sekine
- Welch in view of Mucke and Masubuchi
- Welch in view of Mucke and Alberth
- Welch in view of Waldroup
- Welch in view of Waldroup and Dent
- Welch in view of Waldroup and Ozluturk
- Welch in view of Waldroup and DiPiazza
- Welch in view of Waldroup, Ozluturk, and DiPiazza
- Welch in view of Waldroup and Kimura
- Welch in view of Waldroup and Weiland
- Welch in view of Waldroup and Mucke
- Welch in view of Waldroup and Denheyer
- Welch in view of Waldroup and Sekine
- Welch in view of Waldroup and Masubuchi
- Welch in view of Waldroup and Alberth
- Welch in view of DiPiazza
- Welch in view of Kimura
- Welch in view of Denheyer
- Welch in view of Sekine
- Welch in view of Masubuchi
- Welch in view of Alberth
- Wheatley
- Wheatley in view of Weiland
- Wheatley in view of Weiland and Dent
- Wheatley in view of Weiland and Ozluturk
- Wheatley in view of Weiland and DiPiazza
- Wheatley in view of Weiland, Ozluturk, and DiPiazza
- Wheatley in view of Weiland and Kimura
- Wheatley in view of Weiland and Mucke
- Wheatley in view of Weiland and Denheyer
- Wheatley in view of Weiland and Sekine
- Wheatley in view of Weiland and Masubuchi
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- Wheatley in view of Mucke and DiPiazza
- Wheatley in view of Mucke, Ozluturk, and DiPiazza
- Wheatley in view of Mucke and Kimura
- Wheatley in view of Mucke and Denheyer
- Wheatley in view of Mucke and Sekine
- Wheatley in view of Mucke and Masubuchi
- Wheatley in view of Mucke and Alberth
- Wheatley in view of Wilson
- Wheatley in view of Wilson and Dent
- Wheatley in view of Wilson and Ozluturk
- Wheatley in view of Wilson and DiPiazza
- Wheatley in view of Wilson, Ozluturk, and DiPiazza
- Wheatley in view of Wilson and Kimura
- Wheatley in view of Wilson and Weiland
- Wheatley in view of Wilson and Mucke
- Wheatley in view of Wilson and Denheyer
- Wheatley in view of Wilson and Sekine
- Wheatley in view of Wilson and Masubuchi
- Wheatley in view of Wilson and Alberth
- Wheatley in view of Dent
- Wheatley in view of Dent and Ozluturk
- Wheatley in view of Dent and DiPiazza
- Wheatley in view of Dent, Ozluturk, and DiPiazza
- Wheatley in view of Dent and Kimura
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- Wheatley in view of Dent and Sekine
- Wheatley in view of Dent and Masubuchi
- Wheatley in view of Dent and Alberth
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- Wheatley in view of Ozluturk and DiPiazza
- Wheatley in view of Ozluturk and Kimura
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- Wheatley in view of Ozluturk and Sekine
- Wheatley in view of Ozluturk and Masubuchi
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- Wheatley in view of IS-95-A and Dent
- Wheatley in view of IS-95-A and Ozluturk
- Wheatley in view of IS-95-A and DiPiazza
- Wheatley in view of IS-95-A, Ozluturk, and DiPiazza

- Wheatley in view of IS-95-A and Kimura
- Wheatley in view of IS-95-A and Weiland
- Wheatley in view of IS-95-A and Mucke
- Wheatley in view of IS-95-A and Denheyer
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- Wheatley in view of Waldroup and Kimura
- Wheatley in view of Waldroup and Weiland
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- Wheatley in view of Denheyer
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- Wheatley in view of Masubuchi
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- Yokota
- Yokota in view of Wilson
- Yokota in view of Wilson and Dent
- Yokota in view of Wilson and Ozluturk
- Yokota in view of Wilson and DiPiazza
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- Yokota in view of Wilson and Denheyer
- Yokota in view of Wilson and Sekine
- Yokota in view of Wilson and Masubuchi
- Yokota in view of Wilson and Alberth
- Yokota in view of Dent
- Yokota in view of Dent and Ozluturk
- Yokota in view of Dent and DiPiazza
- Yokota in view of Dent, Ozluturk, and DiPiazza
- Yokota in view of Dent and Kimura

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- Yokota in view of Dent and Denheyer
- Yokota in view of Dent and Sekine
- Yokota in view of Dent and Masubuchi
- Yokota in view of Dent and Alberth
- Yokota in view of Ozluturk
- Yokota in view of Ozluturk and DiPiazza
- Yokota in view of Ozluturk and Kimura
- Yokota in view of Ozluturk and Weiland
- Yokota in view of Ozluturk and Mucke
- Yokota in view of Ozluturk and Denheyer
- Yokota in view of Ozluturk and Sekine
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- Yokota in view of IS-95-A and Dent
- Yokota in view of IS-95-A and Ozluturk
- Yokota in view of IS-95-A and DiPiazza
- Yokota in view of IS-95-A, Ozluturk, and DiPiazza
- Yokota in view of IS-95-A and Kimura
- Yokota in view of IS-95-A and Weiland
- Yokota in view of IS-95-A and Mucke
- Yokota in view of IS-95-A and Denheyer
- Yokota in view of IS-95-A and Sekine
- Yokota in view of IS-95-A and Masubuchi
- Yokota in view of IS-95-A and Alberth
- Yokota in view of Weiland
- Yokota in view of Weiland and DiPiazza
- Yokota in view of Weiland, Ozluturk, and DiPiazza
- Yokota in view of Weiland and Kimura
- Yokota in view of Weiland and Mucke
- Yokota in view of Weiland and Denheyer
- Yokota in view of Weiland and Sekine
- Yokota in view of Weiland and Masubuchi
- Yokota in view of Weiland and Alberth
- Yokota in view of Mucke
- Yokota in view of Mucke and DiPiazza
- Yokota in view of Mucke, Ozluturk, and DiPiazza
- Yokota in view of Mucke and Kimura
- Yokota in view of Mucke and Denheyer
- Yokota in view of Mucke and Sekine
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- Yokota in view of Waldroup and Ozluturk
- Yokota in view of Waldroup and DiPiazza
- Yokota in view of Waldroup, Ozluturk, and DiPiazza
- Yokota in view of Waldroup and Kimura
- Yokota in view of Waldroup and Weiland
- Yokota in view of Waldroup and Mucke
- Yokota in view of Waldroup and Denheyer
- Yokota in view of Waldroup and Sekine
- Yokota in view of Waldroup and Masubuchi
- Yokota in view of Waldroup and Alberth
- Yokota in view of DiPiazza
- Yokota in view of Kimura
- Yokota in view of Denheyer
- Yokota in view of Sekine
- Yokota in view of Masubuchi
- Yokota in view of Alberth

Additional relevant references and combinations may be disclosed in Exhibits B-01 through B-15, and are fully incorporated herein. To the extent that Plaintiff contends that any of the references identified in Exhibits B-01 through B-15 do not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background, experience with power control systems, and/or prior art, including but not limited to one or more of the prior art references identified above.

A person of ordinary skill in the art would have been motivated to combine or modify any of the references in Exhibits B-01 through B-15 and the list above to include these limitations because every reference relates to solving the same problem (controlling transmission power in a cellular telephone) in the same technological field (cellular telephone). *See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996) (the motivation to combine "may also come from the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem.").

For example, to the extent that any prior art reference is determined not to disclose "a method of controlling cellular telephone used in a CDMA system," power control in CDMA

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systems was well known and documented in the prior art before the alleged priority date of the Asserted Patents. For example, without limitation, each of Mucke, Waldroup, Francisco, Wheatley, Gillousen, IS-95, and Wilson discloses this limitation. *See* Exhibits B-01 – B-15. It would have been obvious to apply prior art transmission power control schemes to the widely known CDMA system to reduce power consumption and/or signal interference in the CDMA system. Market forces and design incentives, for example, related to power control in a CDMA system make the combination of such a system with any of the references identified in Exhibits B-01 through B-15 predictable to one of ordinary skill in the art.

For example, to the extent that any prior art reference is determined not to disclose "converting said first communication signal received from a cell-site station into a voice signal code, converting said voice signal code into an audio signal for driving an acoustic transducer of said cellular telephone, converting an audio input signal from said acoustic transducer into an input voice code signal, converting said input voice code signal into a second communication signal," this limitation would have been obvious to a person of ordinary skill in the art in view of the reference itself and/or other references. For example, without limitation, each of Mucke, Denheyer, and IS-95 discloses this limitation. It would have been obvious that any cellular telephone, to perform the basic voice call function, be capable of converting a communication signal from a base station (cell-site station) into a voice signal code and then to an audio signal to be played by a speaker, and converting an audio signal from a microphone into a voice signal code and then to a communication signal to be sent to the base station.

For example, to the extent that any prior art reference is determined not to disclose "an open-loop power control is performed first and then a close-loop power control is performed," this limitation would have been obvious to a POSITA in view of the reference itself and/or other references. For example, without limitation, each of AAPA, Mucke, Waldroup, Weiland, Wheatley, and Gilhousen discloses this limitation. *See* Exhibits B-01 – B-15. In fact, the Background section of the '334 Patent explicitly explains that this limitation is disclosed in the admitted prior art IS-95. '334 Patent at 1:47-61 ("In this case, the transmitter performs the open-loop power control at first, then it performs the closed-loop power control for the transmitted power

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to converge into a desired value which the cell-site station requires.").

For example, to the extent that to the extent that any prior art reference is determined not to disclose "a function defining a relation between bias data and gain data stored in said memory," this limitation would have been obvious to a person of ordinary skill in the art in view of the reference itself, the AAPA and/or other references. For example, without limitation, each of AAPA, Denheyer, Waldroup, Weiland, Wheatley, DiPiazza, Alberth, discloses this limitation. *See* Exhibits B-01 – B-15. Memory was a ubiquitous, conventional element that was present in virtually all cellular telephones by the mid-1990s. A POSITA would have found it obvious to use a function defining a relation between bias data and gain data in memory in order to precisely adjust the gain and bias data thereby stably controlling transmission power as required by the base station in a CDMA system.

For example, to the extent that any prior art reference is determined not to disclose "bias conditions defined in a ratio to the maximum bias voltage value," this limitation would have been obvious to a person of ordinary skill in the art in view of the reference itself and/or other references. *See* Exhibits B-01 – B-15. Since the bias level will be less than or equal to a known maximum, it would have been readily apparent that it may be expressed as a percentage of the maximum, for example to save space in a memory.

For example, to the extent that any prior art reference is determined not to disclose "said bias condition increases gradually to the maximum value when output intensity increases to the value taken when said cellular telephone is very far from the cell-site station," this limitation would have been obvious to a person of ordinary skill in the art in view of the reference itself and/or other references, to the extent the phrases "increases gradually" and "very far from" are determined to be not indefinite. For example, without limitation, each of Mucke, Denheyer, Francisco, Weiland, and U.S. Patent No. 5,774,797 ("Kawano") discloses this limitation. *See* Exhibits B-01 – B-15. It would have been obvious to apply a gradually increasing bias voltage to the power amplifier, in order to accommodate the increased power requirement without unnecessary power consumption, to maintain amplifier linearity, and/or to reduce signal interference. *See, e.g.*, Mucke at 12:18-27; Francisco at 6:34-58.

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For example, to the extent that any prior art reference is determined not to disclose "said bias condition increases gradually to the maximum value when said output intensity increases within the range of −50 dB to 0 dB," this limitation would have been obvious to a person of ordinary skill in the art in view of the reference itself and/or other references. For example, without limitation, each of Mucke, Waldroup, Francisco, and/or Weiland discloses this limitation. *See* Exhibits B-01 – B-15. It would have been obvious to apply the gradually increasing bias in a range of −50 dB to 0 dB in order to extend the benefit of, for example, reduced power consumption to a broad range specified by the CDMA standard. *See e.g.*, Mucke at 7:52-59.

One of ordinary skill also would have been motivated to combine any of the above references together to yield predictable results, as combining the references would simply entail combining known elements by known methods in the art. In addition, any such combination would involve the simple substitution of one known, equivalent element for another. Such combinations would have been obvious to try because there were only a finite number of predictable solutions. Any such combination would yield predictable results using known techniques and would involve the simple substitution of one known, equivalent element for another.

Moreover, there were a finite number of identified, predictable power control systems in the prior art. Therefore, combining any system with any of the references in Exhibits B-01 – B-15 was a predicable solution that a person of ordinary skill in the art would know had a reasonable expectation of success.

Accordingly, to the extent Plaintiff contends that any reference identified in Exhibits B-01 through B-15 does not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background knowledge of one of ordinary skill in the art and/or by combining any reference identified in Exhibits B-01 through B-15 in view of any of the references identified in the chart above.

4. '821 Patent

Claim 6 of the '821 Patent includes various basic components to perform a white balancing adjustment method that were all well-known aspects of imaging systems before the time of the alleged inventions, as even the Asserted Patents suggest.

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At least the following references anticipate and/or render obvious, alone or in combination with other references, the asserted claim of the ’821 patent:

Exemplary Prior Art References
U.S. Patent No. 5,282,022 to Haruki et al. (“Haruki ’022)
U.S. Patent No. 5,283,632 to Suzuki et al. (“Suzuki ’632”)
U.S. Patent No. 5,402,182 to Sugiura (“Sugiura ’182”)
U.S. Patent No. 5,465,116 to Suzuki (“Suzuki ’116”)
U.S. Patent No. 5,617,141 to Nishimura et al. (“Nishimura”)
U.S. Patent No. 6,480,624 to Horie et al. (“Horie ’624”)
U.S. Patent No. 7,170,633 to Hara et al. (“Hara ’633”)
U.S. Patent No. 6,693,673 B1 to Tanaka et al. (“Tanaka ’673”)
Japanese Patent No. H03-148989 to Tanabe et al. (“Tanabe”)
Japanese Patent No. H04-10887 to Haruki et al. (“Haruki ’887”)
U.S. Patent No. 7,551,209 to Miyao et al. (“the ’209 patent”)

Defendants identify the following exemplary combinations as combinations of prior art showing obviousness for claim 6 of the ’821 patent:

- Hara ’633
- Hara ’633 in view of Haruki ’022
- Hara ’633 in view of Haruki ’022 and Haruki ’887
- Hara ’633 in view of Haruki ’022 and Horie ’624
- Hara ’633 in view of Haruki ’022 and Nishimura
- Hara ’633 in view of Haruki ’022 and Sugiura ’182
- Hara ’633 in view of Haruki ’022 and Suzuki ’116
- Hara ’633 in view of Haruki ’022 and Suzuki ’632
- Hara ’633 in view of Haruki ’022 and Tanabe
- Hara ’633 in view of Haruki ’022 and Tanaka ’673
- Hara ’633 in view of Haruki ’887
- Hara ’633 in view of Haruki ’887 and Horie ’624
- Hara ’633 in view of Haruki ’887 and Haruki ’887
- Hara ’633 in view of Haruki ’887 and Nishimura
- Hara ’633 in view of Haruki ’887 and Sugiura ’182
- Hara ’633 in view of Haruki ’887 and Suzuki ’116
- Hara ’633 in view of Haruki ’887 and Suzuki ’632
- Hara ’633 in view of Haruki ’887 and Tanabe
- Hara ’633 in view of Haruki ’887 and Tanaka ’673
- Hara ’633 in view of Horie ’624
- Hara ’633 in view of Horie ’624 and Nishimura
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- The ’209 Patent

To the extent that Plaintiff contends that any of the references identified in Exhibits C-01 through C-11 do not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background, experience with imaging systems, and/or prior art, including but not limited to one or more of the prior art references identified above.

A person of ordinary skill in the art would have been motivated to combine or modify any of the references in Exhibits C-01 through C-11 and the list above to include these limitations because every reference relates to solving the same problem (accurately adjusting white balance) in the same technological field (image forming). *See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc*., 75 F.3d 1568, 1573 (Fed. Cir. 1996) (the motivation to combine “may also come from the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem.”).

A person of ordinary skill in the art would have been motivated to combine or modify any of the references in Exhibits C-01 through C-11 and the list above to include these limitations because, for example, imaging systems that performed white balancing were well known and documented in the prior art before the alleged priority date of the Asserted Patents. For example, Haruki ’887 and Suzuki ’632 each disclose a white balance adjustment device that utilizes object brightness, object distance, and zoom value information to perform white balancing. *See* Exhibits C-03 and C-09. A person of ordinary skill in the art would have found it obvious to modify Haruki ’887 and/or Suzuki ’887’s white balance adjustment device to select between a finite number of ways to perform white balancing using these parameters, and in view of the knowledge of a POSITA and/or the other cited references (e.g., Tanabe), to arrive at the claimed invention of the

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’821 Patent. For another example, Hara ’633 discloses an imaging apparatus that corrects the white balance of an image based on judging various parameters including object brightness, object distance, and zoom value information. *See* Exhibit C-01. A person of ordinary skill in the art would have found it obvious to modify Hara ’633’s white balance adjustment device to select between a finite number of ways to perform white balancing using these parameters, and in view of the other cited reference (e.g., Tanabe), to arrive at the claimed invention of the ’821 Patent. Indeed, each of the references identified above and shown in the attached charts disclose a device that adjusts white balancing using at least some of the three claimed parameters—object brightness, object distance, and zoom—and it would have been obvious to a person of ordinary skill in the art to modify each reference to incorporate additional processing and functionality based on known techniques, as exemplified in any of the other cited references, to provide more accurate white balancing with a reasonable expectation of success. Any of these combinations merely involve combining known techniques and components for white balancing with a reasonable expectation of success that would have been obvious to try amidst the limited set of available white balancing permutations.

In fact, the claimed basic features of imaging systems have been known for decades. *See, e.g.*, Section II.C, *supra*; Exhibits C-01 – C-11. Market forces and design incentives, for example, related to imaging systems with white balancing make the combination of such a system with any of the references identified in Exhibits C-01 through C-11 predictable to one of ordinary skill in the art.

Moreover, there were a finite number of identified, predictable imaging systems with white balancing in the prior art. Therefore, combining any system with any of the references in Exhibits C-01 through C-11 was a predicable solution that a person of ordinary skill in the art would know had a reasonable expectation of success.

Accordingly, to the extent Plaintiff contends that any reference identified in Exhibits C-01 through C-11 does not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background knowledge of one of ordinary skill in the art and/or by combining any reference identified in Exhibits C-01 through C-11 in view

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of any of the references identified in the chart above.

5. ’188 Patent

The asserted claims of the ’188 patent describe a method for protecting against accidental editing of thumbnail images by restricting a user’s ability to interact with the thumbnail images. The ’188 patent explains, “a thumbnail” representing a file “may be accidentally changed by a misoperation of the user.” ’188 Patent at 1:44-46. The ’188 patent aims “to provide an information editing apparatus capable of preventing an accidental change of a thumbnail image.” *Id.* at 1:48-50. The ’188 patent describes a two-step method to accomplish this objective. First, a “deciding process” performs a check on a so-called “change permission” associated with a thumbnail to determine whether the user may alter the thumbnail. *Id.* at 2:35-45. As the ’188 patent explains, this “change permission” is “information” that “indicat[es] whether a thumbnail image is changeable.” *Id.* at 1:59-63. Second, a “change prohibiting process” then prevents modification of the thumbnail if the associated “change permission” information does not allow modification. *Id.* at 1:65-67. These were all well known aspects of image editing systems before the time of the alleged inventions, as even the ’188 patent suggests.

At least the following references anticipate and/or render obvious, alone or in combination with other references, the asserted claims of the ’188 patent:

Exemplary Prior Art References
JP 2001211421 A (“Yoshida”)
JP 2000307994 A (“Terashita”)
US 2002/0033842 A1 (“Zetts”)
US 6,522,354 B1 (“Kawamura”)
US 2002/0012522 A1 (“Kawakami”)
US 2002/0135607 A1 (“Kato”)
US 5,966,122 A (“Itoh”)
EP 0802688 A2 (“Inoue”)
US 2002/0082484 A1 (“Baba”)
U.S. 6,292,273 B1 (“Dow”)
JP 2001169231 A (Miyasaka)
JPS 61101850 A (“Tezuka”)
JPH 11-275512 A (“Shioji”)
JP 2002033986 A (“Murakami”)
U.S. 6,389,222 B1 (“Ando”)

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Defendants identify the following exemplary combinations as combinations of prior art showing obviousness for claims 4-6 of the '188 patent:

- Baba
- Baba in view of Dow
- Baba in view of Dow and Ando
- Baba in view of Dow and Inoue
- Baba in view of Dow and Itoh
- Baba in view of Dow and Kato
- Baba in view of Dow and Kawakami
- Baba in view of Dow and Kawamura
- Baba in view of Dow and Kazuhiro
- Baba in view of Dow and Miyasaka
- Baba in view of Dow and Murakami
- Baba in view of Dow and Shinichi
- Baba in view of Dow and Shioji
- Baba in view of Dow and Terashita
- Baba in view of Dow and Tezuka
- Baba in view of Dow and Yoshida
- Baba in view of Dow and Zetts
- Baba in view of Inoue
- Baba in view of Inoue and Ando
- Baba in view of Inoue and Dow
- Baba in view of Inoue and Itoh
- Baba in view of Inoue and Kato
- Baba in view of Inoue and Kawakami
- Baba in view of Inoue and Kawamura
- Baba in view of Inoue and Kazuhiro
- Baba in view of Inoue and Miyasaka
- Baba in view of Inoue and Murakami
- Baba in view of Inoue and Shinichi
- Baba in view of Inoue and Shioji
- Baba in view of Inoue and Terashita
- Baba in view of Inoue and Tezuka
- Baba in view of Inoue and Yoshida
- Baba in view of Inoue and Zetts
- Baba in view of Itoh
- Baba in view of Itoh and Ando
- Baba in view of Itoh and Dow
- Baba in view of Itoh and Inoue
- Baba in view of Itoh and Kato
- Baba in view of Itoh and Kawakami
- Baba in view of Itoh and Kawamura

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- Baba in view of Itoh and Kazuhiro
- Baba in view of Itoh and Miyasaka
- Baba in view of Itoh and Murakami
- Baba in view of Itoh and Shinichi
- Baba in view of Itoh and Shioji
- Baba in view of Itoh and Terashita
- Baba in view of Itoh and Tezuka
- Baba in view of Itoh and Yoshida
- Baba in view of Itoh and Zetts
- Baba in view of Kato
- Baba in view of Kato and Ando
- Baba in view of Kato and Dow
- Baba in view of Kato and Inoue
- Baba in view of Kato and Itoh
- Baba in view of Kato and Kawakami
- Baba in view of Kato and Kawamura
- Baba in view of Kato and Kazuhiro
- Baba in view of Kato and Miyasaka
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- Baba in view of Kato and Shinichi
- Baba in view of Kato and Shioji
- Baba in view of Kato and Terashita
- Baba in view of Kato and Tezuka
- Baba in view of Kato and Yoshida
- Baba in view of Kato and Zetts
- Baba in view of Kawakami
- Baba in view of Kawakami and Ando
- Baba in view of Kawakami and Dow
- Baba in view of Kawakami and Inoue
- Baba in view of Kawakami and Itoh
- Baba in view of Kawakami and Kato
- Baba in view of Kawakami and Kawamura
- Baba in view of Kawakami and Kazuhiro
- Baba in view of Kawakami and Miyasaka
- Baba in view of Kawakami and Murakami
- Baba in view of Kawakami and Shinichi
- Baba in view of Kawakami and Shioji
- Baba in view of Kawakami and Terashita
- Baba in view of Kawakami and Tezuka
- Baba in view of Kawakami and Yoshida
- Baba in view of Kawakami and Zetts
- Baba in view of Kawamura
- Baba in view of Kawamura and Ando

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- Baba in view of Kawamura and Dow
- Baba in view of Kawamura and Inoue
- Baba in view of Kawamura and Itoh
- Baba in view of Kawamura and Kato
- Baba in view of Kawamura and Kawakami
- Baba in view of Kawamura and Kawamura
- Baba in view of Kawamura and Kazuhiro
- Baba in view of Kawamura and Miyasaka
- Baba in view of Kawamura and Murakami
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- Baba in view of Kawamura and Shioji
- Baba in view of Kawamura and Terashita
- Baba in view of Kawamura and Tezuka
- Baba in view of Kawamura and Yoshida
- Baba in view of Kawamura and Zetts
- Baba in view of Ando
- Baba in view of Kazuhiro
- Baba in view of Miyasaka
- Baba in view of Murakami
- Baba in view of Shinichi
- Baba in view of Shioji
- Baba in view of Terashita
- Baba in view of Terashita and Ando
- Baba in view of Terashita and Dow
- Baba in view of Terashita and Inoue
- Baba in view of Terashita and Itoh
- Baba in view of Terashita and Kato
- Baba in view of Terashita and Kawakami
- Baba in view of Terashita and Kawamura
- Baba in view of Terashita and Kazuhiro
- Baba in view of Terashita and Miyasaka
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- Baba in view of Terashita and Tezuka
- Baba in view of Terashita and Yoshida
- Baba in view of Terashita and Zetts
- Baba in view of Tezuka
- Baba in view of Yoshida
- Baba in view of Yoshida and Ando
- Baba in view of Yoshida and Dow
- Baba in view of Yoshida and Inoue
- Baba in view of Yoshida and Itoh

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- Baba in view of Yoshida and Kato
- Baba in view of Yoshida and Kawakami
- Baba in view of Yoshida and Kawamura
- Baba in view of Yoshida and Kazuhiro
- Baba in view of Yoshida and Miyasaka
- Baba in view of Yoshida and Murakami
- Baba in view of Yoshida and Shinichi
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- Baba in view of Zetts and Shioji
- Baba in view of Zetts and Terashita
- Baba in view of Zetts and Tezuka
- Baba in view of Zetts and Yoshida
- Dow
- Dow in view of Ando
- Dow in view of Baba
- Dow in view of Baba and Ando
- Dow in view of Baba and Inoue
- Dow in view of Baba and Itoh
- Dow in view of Baba and Kato
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- Dow in view of Baba and Murakami
- Dow in view of Baba and Shinichi
- Dow in view of Baba and Shioji
- Dow in view of Baba and Terashita
- Dow in view of Baba and Tezuka

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- Dow in view of Baba and Yoshida
- Dow in view of Baba and Zetts
- Dow in view of Inoue
- Dow in view of Inoue and Ando
- Dow in view of Inoue and Baba
- Dow in view of Inoue and Itoh
- Dow in view of Inoue and Kato
- Dow in view of Inoue and Kawakami
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- Dow in view of Kato and Kawamura
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- Dow in view of Kato and Miyasaka

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- Dow in view of Kato and Murakami
- Dow in view of Kato and Shinichi
- Dow in view of Kato and Shioji
- Dow in view of Kato and Terashita
- Dow in view of Kato and Tezuka
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- Dow in view of Kawamura and Zetts
- Dow in view of Kazuhiro
- Dow in view of Miyasaka
- Dow in view of Murakami

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- Dow in view of Shinichi
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- Dow in view of Terashita
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- Dow in view of Terashita and Baba
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- Dow in view of Zetts and Kawakami
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- Dow in view of Zetts and Miyasaka
- Dow in view of Zetts and Murakami
- Dow in view of Zetts and Shinichi
- Dow in view of Zetts and Shioji
- Dow in view of Zetts and Terashita
- Dow in view of Zetts and Tezuka
- Dow in view of Zetts and Yoshida
- Inoue
- Inoue in view of Ando
- Inoue in view of Baba
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- Inoue in view of Dow and Zetts
- Inoue in view of Itoh

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- Inoue in view of Itoh and Baba
- Inoue in view of Itoh and Dow
- Inoue in view of Itoh and Kato
- Inoue in view of Itoh and Kawakami
- Inoue in view of Itoh and Kawamura
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- Inoue in view of Kawakami and Kawamura
- Inoue in view of Kawakami and Kazuhiro
- Inoue in view of Kawakami and Miyasaka
- Inoue in view of Kawakami and Murakami
- Inoue in view of Kawakami and Shinichi
- Inoue in view of Kawakami and Shioji

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- Inoue in view of Kawakami and Terashita
- Inoue in view of Kawakami and Tezuka
- Inoue in view of Kawakami and Yoshida
- Inoue in view of Kawakami and Zetts
- Inoue in view of Kawamura
- Inoue in view of Kawamura and Ando
- Inoue in view of Kawamura and Baba
- Inoue in view of Kawamura and Dow
- Inoue in view of Kawamura and Itoh
- Inoue in view of Kawamura and Kato
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- Inoue in view of Kawamura and Kawamura
- Inoue in view of Kawamura and Kazuhiro
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- Inoue in view of Kawamura and Shinichi
- Inoue in view of Kawamura and Shioji
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- Inoue in view of Kawamura and Tezuka
- Inoue in view of Kawamura and Yoshida
- Inoue in view of Kawamura and Zetts
- Inoue in view of Kazuhiro
- Inoue in view of Miyasaka
- Inoue in view of Murakami
- Inoue in view of Shinichi
- Inoue in view of Shioji
- Inoue in view of Terashita
- Inoue in view of Terashita and Ando
- Inoue in view of Terashita and Baba
- Inoue in view of Terashita and Dow
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- Inoue in view of Terashita and Kawamura
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- Inoue in view of Terashita and Murakami
- Inoue in view of Terashita and Shinichi
- Inoue in view of Terashita and Shioji
- Inoue in view of Terashita and Tezuka
- Inoue in view of Terashita and Yoshida
- Inoue in view of Terashita and Zetts
- Inoue in view of Tezuka

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- Inoue in view of Yoshida
- Inoue in view of Yoshida and Ando
- Inoue in view of Yoshida and Baba
- Inoue in view of Yoshida and Dow
- Inoue in view of Yoshida and Itoh
- Inoue in view of Yoshida and Kato
- Inoue in view of Yoshida and Kawakami
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- Inoue in view of Zetts and Shinichi
- Inoue in view of Zetts and Shioji
- Inoue in view of Zetts and Terashita
- Inoue in view of Zetts and Tezuka
- Inoue in view of Zetts and Yoshida
- Itoh
- Itoh in view of Ando
- Itoh in view of Baba
- Itoh in view of Baba and Ando
- Itoh in view of Baba and Dow
- Itoh in view of Baba and Inoue
- Itoh in view of Baba and Kato
- Itoh in view of Baba and Kawakami
- Itoh in view of Baba and Kawamura
- Itoh in view of Baba and Kazuhiro
- Itoh in view of Baba and Miyasaka

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- Itoh in view of Baba and Murakami
- Itoh in view of Baba and Shinichi
- Itoh in view of Baba and Shioji
- Itoh in view of Baba and Terashita
- Itoh in view of Baba and Tezuka
- Itoh in view of Baba and Yoshida
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- Itoh in view of Inoue and Baba
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- Itoh in view of Inoue and Shinichi
- Itoh in view of Inoue and Shioji
- Itoh in view of Inoue and Terashita
- Itoh in view of Inoue and Tezuka
- Itoh in view of Inoue and Yoshida
- Itoh in view of Inoue and Zetts
- Itoh in view of Kato
- Itoh in view of Kato and Ando
- Itoh in view of Kato and Baba
- Itoh in view of Kato and Dow

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- Miyasaka in view of Yoshida and Kawamura
- Miyasaka in view of Yoshida and Kazuhiro
- Miyasaka in view of Yoshida and Zetts
- Miyasaka in view of Yoshida and Murakami
- Miyasaka in view of Yoshida and Shinichi
- Miyasaka in view of Yoshida and Shioji
- Miyasaka in view of Yoshida and Terashita
- Miyasaka in view of Yoshida and Tezuka

Additional relevant references and combinations may be disclosed in Exhibits D-01 through D-11, and are fully incorporated herein. To the extent that Plaintiff contends that any of the references identified in Exhibits D-01 through D-11 do not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background, experience with imaging systems, and/or prior art, including but not limited to one or more of the prior art references identified above.

A person of ordinary skill in the art would have been motivated to combine or modify any of the references in Exhibits D-01 through D-11 and the list above to include these limitations because, for example, image editing systems were well known and documented in the prior art before the alleged priority date of the Asserted Patents. In fact, the claimed basic features of image editing systems have been known for decades. *See, e.g.*, Section II.C, *supra*; Exhibits D-01 – D-11. Market forces and design incentives, for example, related to image editing systems make the combination of such a system with any of the references identified in Exhibits D-01 through D-11 predictable to one of ordinary skill in the art.

For example, a POSITA would have found obvious integration of video management and editing/erasure protection features from one image editing systems, such as Yoshida, Terashita, Dow, and the other references listed above into the other image editing systems. All of these references are in the field of digital image management and focus on protecting stored images from unwanted deletion or modification. Yoshida, for example, teaches a "image management method and device suitable for a digital camera" with a "configuration [that] may be such that the user can select either a mode in which the representative image is changed or a mode in which the representative image is not changed." Yoshida at [0001], [0216]. Likewise, Terashita describes a

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"information processing device and method as well as media" that has "[a]n AV content attribute record," which records metadata for an image and includes "the setting to prevent accidental deletion." Terashita at [0001], [0054]. Dow teaches a handheld image capture device with functionality to delete images. Dow at Abstract.

An exemplary motivation to combine these references would be to enhance Yoshida, Terashita, and Dow's delete or edit functionality with more nuanced approaches to protecting content from deletion as described in these references and others (such as Murakami or Tezuka). The resulting combinations would result in a more flexible and user-friendly system that can better protect important images while still allowing for efficient memory management. Specifically, incorporating Murakami's erasure protection features into Yoshida, Terashita, and Dow's systems would allow users to protect certain images from accidental deletion, addressing a key concern in digital image management.

Further, making these combinations would have merely involved combining prior art elements—for example, a multimedia management system for preventing accidental erasure or editing within prior art image editing systems (such as Yoshida, Terashita, or Dow)—according to known methods to yield predictable results. The combination would have been predictable and foreseeable because each of these references relies, like the '188 patent itself, on conventional computer hardware operating in conventional ways. In fact, the '188 patent describes the relevant hardware by using generic, exemplary language. For example, the '188 patent explains the "program" implementing the allegedly novel method "is recorded on an information recording medium including a flexible disk, a hard disk, and the like and the program is read and exercised by a general-purpose microcomputer and so on." *Id.* at 18:32-37. The '188 patent does not disclose any novel computer components or combination of components. Terashita likewise generically refers to a "personal computer 1" as an exemplary system implementing its teaching. Terashita at [0018]; *see also* Yoshida at [0022] ("The image management device of the present invention is applicable to various image information processing devices."). Thus, combining the references would have been no more than the use of a known technique to improve similar a device in the same way.

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Accordingly, to the extent Plaintiff contends that any reference identified in Exhibits D-01 through D-11 does not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background knowledge of one of ordinary skill in the art and/or by combining any reference identified in Exhibits D-01 through D-11 in view of any of the references identified in the chart above.

6. '493 and '729 Patents

The Asserted Claims of the '493 and '729 Asserted Patents include various basic components and methods to use electric cameras. These were all well known aspects of imaging systems before the time of the alleged inventions, as even the Asserted Patents suggest.

At least the following references anticipate and/or render obvious, alone or in combination with other references, the asserted claims of the '493 and '729 patents:

Exemplary Prior Art References
U.S. Patent No. 5,444,482 to Misawa et al. ("Misawa '482")
U.S. Patent No. 6,292,218 to Parulski et al. ("Parulski '218")
U.S. Patent No. 5,440,343 to Parulski et al. ("Parulski '343")
U.S. Patent No. 6,563,535 to Anderson ("Anderson '535")
Canon XL1 Digital Video Camcorder Instruction Manual ("XL1 Manual")
Hitachi MP-EG1 MPEG Camera and Instruction Manual ("MP-EG1")
U.S. Patent No. 6,342,921 to Yamaguchi et al. ("Yamaguchi '921")
Kurashige et al., Development of MPEG Camera, Hitachi Video & Information System Co. Ltd., 1997 IEEE ("Kurashige")
U.S. Patent No. 6,690,881 to Tomita et al. ("Tomita '881")
U.S. Patent No. 6,700,607 to Misawa ("Misawa '607")
U.S. Patent No. 6,963,361 to Kawahara et al. ("Kawahara '361")
U.S. Patent No. 7,903,162 to Juen ("Juen '162")
U.S. Patent No. 6,340,989 to Oda ("Oda '989")
U.S. Patent No. 6,266,086 to Okada et al. ("Okada '086")
U.S. Patent No. 5,986,698 to Nobuoka ("Nobuoka '698")
U.S. Patent No. 5,864,363 to Giefing et al. ("Giefing '363")
U.S. Patent No. 6,144,366 to Numazaki et al. ("Numazaki '366")
Sony Digital Camera Recorder DCR-PC100, Operating Instructions and Service Manual Ver. 1.0 ("DCR-PC100")
Sony Digital Video Camera Recorder DCR-TRV900 and Operating Instructions ("DCR-TRV900")
JVC GR-DV1 Video Camera and GR-DV1 Instruction Manual ("GR-DV1")
Sony MVC-FD83 Digital Still Camera, Operating Instructions and Service Manual Ver 1.0 ("MVC-FD83")

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Exemplary Prior Art References
Sony MVC-FD91 Digital Still Camera, Operating Instructions and Service Manual Ver 1.0 (“MVC-FD91”)
Panasonic NV-DX100B Digital Video Camera and Instruction Manual (“NV-DX100B”)
Casio QV-8000SX Digital Camera and User’s Guide (“QV8000SX”)

Defendants identify the following exemplary combinations as combinations of prior art showing obviousness for claims 10, 12, 13, and 14 of the ’493 patent, and/or claims 3 and 4 of the ’729 patent:

- DCR-PC100
- DCR-PC100 in view of Anderson ’535
- DCR-PC100 in view of Anderson ’535 and Juen ’162
- DCR-PC100 in view of Anderson ’535 and Kawahara ’361
- DCR-PC100 in view of Anderson ’535 and Kurashige
- DCR-PC100 in view of Anderson ’535 and Misawa ’482
- DCR-PC100 in view of Anderson ’535 and Misawa ’607
- DCR-PC100 in view of Anderson ’535 and Nobuoka ’698
- DCR-PC100 in view of Anderson ’535 and Oda ’989
- DCR-PC100 in view of Anderson ’535 and Okada ’086
- DCR-PC100 in view of Anderson ’535 and Parulski ’218
- DCR-PC100 in view of Anderson ’535 and Parulski ’343
- DCR-PC100 in view of Anderson ’535 and Tomita ’881
- DCR-PC100 in view of Anderson ’535 and XL1 Manual
- DCR-PC100 in view of Anderson ’535 and Yamaguchi ’921
- DCR-PC100 in view of Juen ’162
- DCR-PC100 in view of Juen ’162 and Kawahara ’361
- DCR-PC100 in view of Juen ’162 and Kurashige
- DCR-PC100 in view of Juen ’162 and Misawa ’482
- DCR-PC100 in view of Juen ’162 and Misawa ’607
- DCR-PC100 in view of Juen ’162 and Nobuoka ’698
- DCR-PC100 in view of Juen ’162 and Oda ’989
- DCR-PC100 in view of Juen ’162 and Okada ’086
- DCR-PC100 in view of Juen ’162 and Parulski ’218
- DCR-PC100 in view of Juen ’162 and Parulski ’343
- DCR-PC100 in view of Juen ’162 and Tomita ’881
- DCR-PC100 in view of Juen ’162 and XL1 Manual
- DCR-PC100 in view of Juen ’162 and Yamaguchi ’921
- DCR-PC100 in view of Kawahara ’361
- DCR-PC100 in view of Kawahara ’361 and Kurashige
- DCR-PC100 in view of Kawahara ’361 and Misawa ’482
- DCR-PC100 in view of Kawahara ’361 and Misawa ’607

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- DCR-PC100 in view of Kawahara ’361 and Nobuoka ’698
- DCR-PC100 in view of Kawahara ’361 and Oda ’989
- DCR-PC100 in view of Kawahara ’361 and Okada ’086
- DCR-PC100 in view of Kawahara ’361 and Parulski ’218
- DCR-PC100 in view of Kawahara ’361 and Parulski ’343
- DCR-PC100 in view of Kawahara ’361 and Tomita ’881
- DCR-PC100 in view of Kawahara ’361 and XL1 Manual
- DCR-PC100 in view of Kawahara ’361 and Yamaguchi ’921
- DCR-PC100 in view of Kurashige
- DCR-PC100 in view of Kurashige and Misawa ’482
- DCR-PC100 in view of Kurashige and Misawa ’607
- DCR-PC100 in view of Kurashige and Nobuoka ’698
- DCR-PC100 in view of Kurashige and Oda ’989
- DCR-PC100 in view of Kurashige and Okada ’086
- DCR-PC100 in view of Kurashige and Parulski ’218
- DCR-PC100 in view of Kurashige and Parulski ’343
- DCR-PC100 in view of Kurashige and Tomita ’881
- DCR-PC100 in view of Kurashige and XL1 Manual
- DCR-PC100 in view of Kurashige and Yamaguchi ’921
- DCR-PC100 in view of Misawa ’482
- DCR-PC100 in view of Misawa ’482 and Misawa ’607
- DCR-PC100 in view of Misawa ’482 and Nobuoka ’698
- DCR-PC100 in view of Misawa ’482 and Oda ’989
- DCR-PC100 in view of Misawa ’482 and Okada ’086
- DCR-PC100 in view of Misawa ’482 and Parulski ’218
- DCR-PC100 in view of Misawa ’482 and Parulski ’343
- DCR-PC100 in view of Misawa ’482 and Tomita ’881
- DCR-PC100 in view of Misawa ’482 and XL1 Manual
- DCR-PC100 in view of Misawa ’482 and Yamaguchi ’921
- DCR-PC100 in view of Misawa ’607
- DCR-PC100 in view of Misawa ’607 and Nobuoka ’698
- DCR-PC100 in view of Misawa ’607 and Oda ’989
- DCR-PC100 in view of Misawa ’607 and Okada ’086
- DCR-PC100 in view of Misawa ’607 and Parulski ’218
- DCR-PC100 in view of Misawa ’607 and Parulski ’343
- DCR-PC100 in view of Misawa ’607 and Tomita ’881
- DCR-PC100 in view of Misawa ’607 and XL1 Manual
- DCR-PC100 in view of Misawa ’607 and Yamaguchi ’921
- DCR-PC100 in view of Nobuoka ’698
- DCR-PC100 in view of Nobuoka ’698 and Oda ’989
- DCR-PC100 in view of Nobuoka ’698 and Okada ’086
- DCR-PC100 in view of Nobuoka ’698 and Parulski ’218
- DCR-PC100 in view of Nobuoka ’698 and Parulski ’343

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- DCR-PC100 in view of Nobuoka ’698 and Tomita ’881
- DCR-PC100 in view of Nobuoka ’698 and XL1 Manual
- DCR-PC100 in view of Nobuoka ’698 and Yamaguchi ’921
- DCR-PC100 in view of Oda ’989
- DCR-PC100 in view of Oda ’989 and Okada ’086
- DCR-PC100 in view of Oda ’989 and Parulski ’218
- DCR-PC100 in view of Oda ’989 and Parulski ’343
- DCR-PC100 in view of Oda ’989 and Tomita ’881
- DCR-PC100 in view of Oda ’989 and XL1 Manual
- DCR-PC100 in view of Oda ’989 and Yamaguchi ’921
- DCR-PC100 in view of Okada ’086
- DCR-PC100 in view of Okada ’086 and Parulski ’218
- DCR-PC100 in view of Okada ’086 and Parulski ’343
- DCR-PC100 in view of Okada ’086 and Tomita ’881
- DCR-PC100 in view of Okada ’086 and XL1 Manual
- DCR-PC100 in view of Okada ’086 and Yamaguchi ’921
- DCR-PC100 in view of Parulski ’218
- DCR-PC100 in view of Parulski ’218 and Parulski ’343
- DCR-PC100 in view of Parulski ’218 and Tomita ’881
- DCR-PC100 in view of Parulski ’218 and XL1 Manual
- DCR-PC100 in view of Parulski ’218 and Yamaguchi ’921
- DCR-PC100 in view of Parulski ’343
- DCR-PC100 in view of Parulski ’343 and Tomita ’881
- DCR-PC100 in view of Parulski ’343 and XL1 Manual
- DCR-PC100 in view of Parulski ’343 and Yamaguchi ’921
- DCR-PC100 in view of Tomita ’881
- DCR-PC100 in view of Tomita ’881 and XL1 Manual
- DCR-PC100 in view of Tomita ’881 and Yamaguchi ’921
- DCR-PC100 in view of XL1 Manual
- DCR-PC100 in view of XL1 Manual and Yamaguchi ’921
- DCR-PC100 in view of Yamaguchi ’921
- DCR-TRV900
- DCR-TRV900 in view of Anderson ’535
- DCR-TRV900 in view of Anderson ’535 and Juen ’162
- DCR-TRV900 in view of Anderson ’535 and Kawahara ’361
- DCR-TRV900 in view of Anderson ’535 and Kurashige
- DCR-TRV900 in view of Anderson ’535 and Misawa ’482
- DCR-TRV900 in view of Anderson ’535 and Misawa ’607
- DCR-TRV900 in view of Anderson ’535 and Nobuoka ’698
- DCR-TRV900 in view of Anderson ’535 and Oda ’989
- DCR-TRV900 in view of Anderson ’535 and Okada ’086
- DCR-TRV900 in view of Anderson ’535 and Parulski ’218
- DCR-TRV900 in view of Anderson ’535 and Parulski ’343

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- DCR-TRV900 in view of Anderson ’535 and Tomita ’881
- DCR-TRV900 in view of Anderson ’535 and XL1 Manual
- DCR-TRV900 in view of Anderson ’535 and Yamaguchi ’921
- DCR-TRV900 in view of Juen ’162
- DCR-TRV900 in view of Juen ’162 and Kawahara ’361
- DCR-TRV900 in view of Juen ’162 and Kurashige
- DCR-TRV900 in view of Juen ’162 and Misawa ’482
- DCR-TRV900 in view of Juen ’162 and Misawa ’607
- DCR-TRV900 in view of Juen ’162 and Nobuoka ’698
- DCR-TRV900 in view of Juen ’162 and Oda ’989
- DCR-TRV900 in view of Juen ’162 and Okada ’086
- DCR-TRV900 in view of Juen ’162 and Parulski ’218
- DCR-TRV900 in view of Juen ’162 and Parulski ’343
- DCR-TRV900 in view of Juen ’162 and Tomita ’881
- DCR-TRV900 in view of Juen ’162 and XL1 Manual
- DCR-TRV900 in view of Juen ’162 and Yamaguchi ’921
- DCR-TRV900 in view of Kawahara ’361
- DCR-TRV900 in view of Kawahara ’361 and Kurashige
- DCR-TRV900 in view of Kawahara ’361 and Misawa ’482
- DCR-TRV900 in view of Kawahara ’361 and Misawa ’607
- DCR-TRV900 in view of Kawahara ’361 and Nobuoka ’698
- DCR-TRV900 in view of Kawahara ’361 and Oda ’989
- DCR-TRV900 in view of Kawahara ’361 and Okada ’086
- DCR-TRV900 in view of Kawahara ’361 and Parulski ’218
- DCR-TRV900 in view of Kawahara ’361 and Parulski ’343
- DCR-TRV900 in view of Kawahara ’361 and Tomita ’881
- DCR-TRV900 in view of Kawahara ’361 and XL1 Manual
- DCR-TRV900 in view of Kawahara ’361 and Yamaguchi ’921
- DCR-TRV900 in view of Kurashige
- DCR-TRV900 in view of Kurashige and Misawa ’482
- DCR-TRV900 in view of Kurashige and Misawa ’607
- DCR-TRV900 in view of Kurashige and Nobuoka ’698
- DCR-TRV900 in view of Kurashige and Oda ’989
- DCR-TRV900 in view of Kurashige and Okada ’086
- DCR-TRV900 in view of Kurashige and Parulski ’218
- DCR-TRV900 in view of Kurashige and Parulski ’343
- DCR-TRV900 in view of Kurashige and Tomita ’881
- DCR-TRV900 in view of Kurashige and XL1 Manual
- DCR-TRV900 in view of Kurashige and Yamaguchi ’921
- DCR-TRV900 in view of Misawa ’482
- DCR-TRV900 in view of Misawa ’482 and Misawa ’607
- DCR-TRV900 in view of Misawa ’482 and Nobuoka ’698
- DCR-TRV900 in view of Misawa ’482 and Oda ’989

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- DCR-TRV900 in view of Misawa ’482 and Okada ’086
- DCR-TRV900 in view of Misawa ’482 and Parulski ’218
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- DCR-TRV900 in view of Misawa ’482 and Tomita ’881
- DCR-TRV900 in view of Misawa ’482 and XL1 Manual
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- DCR-TRV900 in view of Misawa ’607
- DCR-TRV900 in view of Misawa ’607 and Nobuoka ’698
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- DCR-TRV900 in view of Misawa ’607 and Okada ’086
- DCR-TRV900 in view of Misawa ’607 and Parulski ’218
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- DCR-TRV900 in view of Misawa ’607 and Tomita ’881
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- DCR-TRV900 in view of Misawa ’607 and Yamaguchi ’921
- DCR-TRV900 in view of Nobuoka ’698
- DCR-TRV900 in view of Nobuoka ’698 and Oda ’989
- DCR-TRV900 in view of Nobuoka ’698 and Okada ’086
- DCR-TRV900 in view of Nobuoka ’698 and Parulski ’218
- DCR-TRV900 in view of Nobuoka ’698 and Parulski ’343
- DCR-TRV900 in view of Nobuoka ’698 and Tomita ’881
- DCR-TRV900 in view of Nobuoka ’698 and XL1 Manual
- DCR-TRV900 in view of Nobuoka ’698 and Yamaguchi ’921
- DCR-TRV900 in view of Oda ’989
- DCR-TRV900 in view of Oda ’989 and Okada ’086
- DCR-TRV900 in view of Oda ’989 and Parulski ’218
- DCR-TRV900 in view of Oda ’989 and Parulski ’343
- DCR-TRV900 in view of Oda ’989 and Tomita ’881
- DCR-TRV900 in view of Oda ’989 and XL1 Manual
- DCR-TRV900 in view of Oda ’989 and Yamaguchi ’921
- DCR-TRV900 in view of Okada ’086
- DCR-TRV900 in view of Okada ’086 and Parulski ’218
- DCR-TRV900 in view of Okada ’086 and Parulski ’343
- DCR-TRV900 in view of Okada ’086 and Tomita ’881
- DCR-TRV900 in view of Okada ’086 and XL1 Manual
- DCR-TRV900 in view of Okada ’086 and Yamaguchi ’921
- DCR-TRV900 in view of Parulski ’218
- DCR-TRV900 in view of Parulski ’218 and Parulski ’343
- DCR-TRV900 in view of Parulski ’218 and Tomita ’881
- DCR-TRV900 in view of Parulski ’218 and XL1 Manual
- DCR-TRV900 in view of Parulski ’218 and Yamaguchi ’921
- DCR-TRV900 in view of Parulski ’343
- DCR-TRV900 in view of Parulski ’343 and Tomita ’881

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- DCR-TRV900 in view of Parulski ’343 and XL1 Manual
- DCR-TRV900 in view of Parulski ’343 and Yamaguchi ’921
- DCR-TRV900 in view of Tomita ’881
- DCR-TRV900 in view of Tomita ’881 and XL1 Manual
- DCR-TRV900 in view of Tomita ’881 and Yamaguchi ’921
- DCR-TRV900 in view of XL1 Manual
- DCR-TRV900 in view of XL1 Manual and Yamaguchi ’921
- DCR-TRV900 in view of Yamaguchi ’921
- GR-DV1
- GR-DV1 in view of Anderson ’535
- GR-DV1 in view of Anderson ’535 and Juen ’162
- GR-DV1 in view of Anderson ’535 and Kawahara ’361
- GR-DV1 in view of Anderson ’535 and Kurashige
- GR-DV1 in view of Anderson ’535 and Misawa ’482
- GR-DV1 in view of Anderson ’535 and Misawa ’607
- GR-DV1 in view of Anderson ’535 and Nobuoka ’698
- GR-DV1 in view of Anderson ’535 and Oda ’989
- GR-DV1 in view of Anderson ’535 and Okada ’086
- GR-DV1 in view of Anderson ’535 and Parulski ’218
- GR-DV1 in view of Anderson ’535 and Parulski ’343
- GR-DV1 in view of Anderson ’535 and Tomita ’881
- GR-DV1 in view of Anderson ’535 and XL1 Manual
- GR-DV1 in view of Anderson ’535 and Yamaguchi ’921
- GR-DV1 in view of Juen ’162
- GR-DV1 in view of Juen ’162 and Kawahara ’361
- GR-DV1 in view of Juen ’162 and Kurashige
- GR-DV1 in view of Juen ’162 and Misawa ’482
- GR-DV1 in view of Juen ’162 and Misawa ’607
- GR-DV1 in view of Juen ’162 and Nobuoka ’698
- GR-DV1 in view of Juen ’162 and Oda ’989
- GR-DV1 in view of Juen ’162 and Okada ’086
- GR-DV1 in view of Juen ’162 and Parulski ’218
- GR-DV1 in view of Juen ’162 and Parulski ’343
- GR-DV1 in view of Juen ’162 and Tomita ’881
- GR-DV1 in view of Juen ’162 and XL1 Manual
- GR-DV1 in view of Juen ’162 and Yamaguchi ’921
- GR-DV1 in view of Kawahara ’361
- GR-DV1 in view of Kawahara ’361 and Kurashige
- GR-DV1 in view of Kawahara ’361 and Misawa ’482
- GR-DV1 in view of Kawahara ’361 and Misawa ’607
- GR-DV1 in view of Kawahara ’361 and Nobuoka ’698
- GR-DV1 in view of Kawahara ’361 and Oda ’989
- GR-DV1 in view of Kawahara ’361 and Okada ’086

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- GR-DV1 in view of Kawahara ’361 and Parulski ’218
- GR-DV1 in view of Kawahara ’361 and Parulski ’343
- GR-DV1 in view of Kawahara ’361 and Tomita ’881
- GR-DV1 in view of Kawahara ’361 and XL1 Manual
- GR-DV1 in view of Kawahara ’361 and Yamaguchi ’921
- GR-DV1 in view of Kurashige
- GR-DV1 in view of Kurashige and Misawa ’482
- GR-DV1 in view of Kurashige and Misawa ’607
- GR-DV1 in view of Kurashige and Nobuoka ’698
- GR-DV1 in view of Kurashige and Oda ’989
- GR-DV1 in view of Kurashige and Okada ’086
- GR-DV1 in view of Kurashige and Parulski ’218
- GR-DV1 in view of Kurashige and Parulski ’343
- GR-DV1 in view of Kurashige and Tomita ’881
- GR-DV1 in view of Kurashige and XL1 Manual
- GR-DV1 in view of Kurashige and Yamaguchi ’921
- GR-DV1 in view of Misawa ’482
- GR-DV1 in view of Misawa ’482 and Misawa ’607
- GR-DV1 in view of Misawa ’482 and Nobuoka ’698
- GR-DV1 in view of Misawa ’482 and Oda ’989
- GR-DV1 in view of Misawa ’482 and Okada ’086
- GR-DV1 in view of Misawa ’482 and Parulski ’218
- GR-DV1 in view of Misawa ’482 and Parulski ’343
- GR-DV1 in view of Misawa ’482 and Tomita ’881
- GR-DV1 in view of Misawa ’482 and XL1 Manual
- GR-DV1 in view of Misawa ’482 and Yamaguchi ’921
- GR-DV1 in view of Misawa ’607
- GR-DV1 in view of Misawa ’607 and Nobuoka ’698
- GR-DV1 in view of Misawa ’607 and Oda ’989
- GR-DV1 in view of Misawa ’607 and Okada ’086
- GR-DV1 in view of Misawa ’607 and Parulski ’218
- GR-DV1 in view of Misawa ’607 and Parulski ’343
- GR-DV1 in view of Misawa ’607 and Tomita ’881
- GR-DV1 in view of Misawa ’607 and XL1 Manual
- GR-DV1 in view of Misawa ’607 and Yamaguchi ’921
- GR-DV1 in view of Nobuoka ’698
- GR-DV1 in view of Nobuoka ’698 and Oda ’989
- GR-DV1 in view of Nobuoka ’698 and Okada ’086
- GR-DV1 in view of Nobuoka ’698 and Parulski ’218
- GR-DV1 in view of Nobuoka ’698 and Parulski ’343
- GR-DV1 in view of Nobuoka ’698 and Tomita ’881
- GR-DV1 in view of Nobuoka ’698 and XL1 Manual
- GR-DV1 in view of Nobuoka ’698 and Yamaguchi ’921

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- GR-DV1 in view of Oda ’989
- GR-DV1 in view of Oda ’989 and Okada ’086
- GR-DV1 in view of Oda ’989 and Parulski ’218
- GR-DV1 in view of Oda ’989 and Parulski ’343
- GR-DV1 in view of Oda ’989 and Tomita ’881
- GR-DV1 in view of Oda ’989 and XL1 Manual
- GR-DV1 in view of Oda ’989 and Yamaguchi ’921
- GR-DV1 in view of Okada ’086
- GR-DV1 in view of Okada ’086 and Parulski ’218
- GR-DV1 in view of Okada ’086 and Parulski ’343
- GR-DV1 in view of Okada ’086 and Tomita ’881
- GR-DV1 in view of Okada ’086 and XL1 Manual
- GR-DV1 in view of Okada ’086 and Yamaguchi ’921
- GR-DV1 in view of Parulski ’218
- GR-DV1 in view of Parulski ’218 and Parulski ’343
- GR-DV1 in view of Parulski ’218 and Tomita ’881
- GR-DV1 in view of Parulski ’218 and XL1 Manual
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- Yamaguchi ’921 in view of Misawa ’607
- Yamaguchi ’921 in view of Misawa ’607 and Nobuoka ’698
- Yamaguchi ’921 in view of Misawa ’607 and Oda ’989
- Yamaguchi ’921 in view of Misawa ’607 and Okada ’086
- Yamaguchi ’921 in view of Misawa ’607 and Parulski ’218
- Yamaguchi ’921 in view of Misawa ’607 and Parulski ’343
- Yamaguchi ’921 in view of Misawa ’607 and Tomita ’881
- Yamaguchi ’921 in view of Misawa ’607 and XL1 Manual
- Yamaguchi ’921 in view of Nobuoka ’698
- Yamaguchi ’921 in view of Nobuoka ’698 and Oda ’989
- Yamaguchi ’921 in view of Nobuoka ’698 and Okada ’086
- Yamaguchi ’921 in view of Nobuoka ’698 and Parulski ’218
- Yamaguchi ’921 in view of Nobuoka ’698 and Parulski ’343
- Yamaguchi ’921 in view of Nobuoka ’698 and Tomita ’881
- Yamaguchi ’921 in view of Nobuoka ’698 and XL1 Manual
- Yamaguchi ’921 in view of Oda ’989
- Yamaguchi ’921 in view of Oda ’989 and Okada ’086
- Yamaguchi ’921 in view of Oda ’989 and Parulski ’218
- Yamaguchi ’921 in view of Oda ’989 and Parulski ’343
- Yamaguchi ’921 in view of Oda ’989 and Tomita ’881
- Yamaguchi ’921 in view of Oda ’989 and XL1 Manual
- Yamaguchi ’921 in view of Okada ’086
- Yamaguchi ’921 in view of Okada ’086 and Parulski ’218
- Yamaguchi ’921 in view of Okada ’086 and Parulski ’343
- Yamaguchi ’921 in view of Okada ’086 and Tomita ’881
- Yamaguchi ’921 in view of Okada ’086 and XL1 Manual
- Yamaguchi ’921 in view of Parulski ’218
- Yamaguchi ’921 in view of Parulski ’218 and Parulski ’343
- Yamaguchi ’921 in view of Parulski ’218 and Tomita ’881
- Yamaguchi ’921 in view of Parulski ’218 and XL1 Manual
- Yamaguchi ’921 in view of Parulski ’343
- Yamaguchi ’921 in view of Parulski ’343 and Tomita ’881
- Yamaguchi ’921 in view of Parulski ’343 and XL1 Manual
- Yamaguchi ’921 in view of Tomita ’881
- Yamaguchi ’921 in view of Tomita ’881 and XL1 Manual
- Yamaguchi ’921 in view of XL1 Manual

To the extent that Plaintiff contends that any of the references identified in Exhibits E-01 through E-13 and F-01 through F-15 do not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background, experience with imaging systems, and/or prior art, including but not limited to one or more of the prior art

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references identified above.

A person of ordinary skill in the art would have been motivated to combine or modify any of the references in Exhibits E-01 through E-13 and F-01 through F-15 the list above to include the asserted claim limitations of the '493 and '729 patents at least based on the reasons described in the because every reference relates to solving the same problem (accurately adjusting white balance) in the same technological field (image forming). *See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc*., 75 F.3d 1568, 1573 (Fed. Cir. 1996) (the motivation to combine "may also come from the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem.").

A person of ordinary skill in the art would have been motivated to combine or modify any of the references in Exhibits E-01 through E-13 and F-01 through F-15 and the list above to include the asserted claim limitations of the '493 and '729 patents because, for example, electric cameras were well known and documented in the prior art before the alleged priority date of the Asserted Patents. In fact, the claimed basic features of communication systems have been known for decades. *See, e.g.*, Section II.C, *supra*; E-01–E-13 and F-01-F-15. Market forces and design incentives, for example, related to electric cameras make the combination of such a system with any of the references identified in Exhibits E-01 through E-13 and F-01 through F-15 predictable to one of ordinary skill in the art.

For example, a POSITA would have found it predictable to combine the teachings of Misawa '482 and Parulski '218 because both Misawa '482 and Parulski '218 pertain to electronic digital cameras for recording movies and still images. A POSITA would have, in particular, found it obvious to (1) replace Misawa '482's 640-pixel by 480-pixel image sensor with Parulski '218's 768-pixel by 512-pixel image sensor, (2) add an LCD, as taught in Parulski '218, to Misawa '482's camera and use a motion mode, as taught in Parulski '218, for previewing on the LCD an image to be captured in a still image mode, and (3) use a line-skipping process as taught in Parulski '218 to obtain the movie picture image generated in Misawa '482's movie picture mode.

A POSITA would have been motivated, for example, to replace Misawa '482's image sensor with Parulski '218's image sensor to improve the quality of images obtained from the image

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sensor and improve the quality of these images when displayed on a high-resolution display or printed on a high-quality printer. Parulski '218 at 5:5–7. Moreover, a POSITA would have been motivated, for example, to replace Misawa '482's 4:3 aspect ratio image sensor with Parulski '218's 3:2 aspect ratio image sensor so that the aspect ratio of the image sensor would match the aspect ratios of the standard 35-millimeter film format and standard 4-inch by 6-inch still prints. Parulski '218 at 5:57–62. This modification would have been predictable and would have had a reasonable expectation of success because both Misawa '482's and Parulski '218's image sensors are CCDs and thus operate under the same principles and because Parulski '218's image sensor, as used in Misawa '482, would have been used for the same purpose as taught in Parulski '218—to record images. Misawa '482 at 3:17–19; Parulski '218 at 3:38–47, 5:49–53.

A POSITA would have been motivated, for example, to add an LCD, as taught in Parulski '218, into Misawa '482's electronic digital camera so that the LCD could (1) present a user a preview of an image to be captured in Misawa '482's still picture mode without using complex circuitry, (2) play back previously recorded images without an external monitor, and (3) provide status information or a reconfigurable push-button menu to the user. *See* Parulski '218 at 1:27–34, 2:24–53, 3:33–38, 7:41–48; Misawa '482 at 1:33–39. A POSITA would have likewise been motivated to use a preview mode processing circuit and a line-skipping process, as taught in Parulski '218, to achieve "a relatively less complex digital image processing technique" and "a higher data rate" in the motion mode, to avoid unnecessarily producing high-resolution imagery for Parulski '218's low-resolution LCD, and to enable more rapid processing of image data. Parulski '218 at 4:61–5:1, 5:15–24. And because Parulski '218 teaches using an image sensor that has more vertically arranged lines (e.g., 512 lines) than the images for monitoring (e.g., 204 lines), a POSITA would have been motivated to use a line-skipping process to eliminate at least some of the vertically arranged lines from the image sensor in forming the monitoring images. Parulski '218 at 5:49–52, 7:41–48. Parulski '218 teaches using its LCD and its motion mode in a digital camera that captures still imagery, and thus incorporating an LCD and a motion mode into Misawa '482's camera would have been predictable and would have had a reasonable expectation of success. Parulski '218 at 3:29–33; Misawa '482 at 1:9–14, 1:54–58.

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Third, a POSITA would have been motivated to use a line-skipping process, as taught in Parulski '218, to generate the movie picture image in Misawa '482's movie picture mode so that obtaining a 4:3 aspect ratio movie picture image from Parulski '218's 3:2 aspect ratio image sensor would produce fewer geometric distortions, would preserve visual information captured by the image sensor, and would have reduced storage requirements. Parulski '218 at 6:45–50, 7:33–40. And because Misawa '482 and Parulski '218 both teach that image sensors having more vertically arranged lines (480 lines, as taught in Misawa '482, and 512 lines, as taught in Parulski '218) than the movie picture images (240 lines, as taught in Misawa '482), a POSITA would have been motivated to use a line-skipping process to eliminate at least some of the vertically arranged lines from the image sensor in forming the movie picture images. Misawa '482 at 7:13–15; Parulski '218 at 5:49–52, 7:41–48. These modifications to Misawa '482 would have been predictable and would have had a reasonable expectation of success as Parulski '218 teaches using its line-skipping mode with an image sensor like the one taught in Misawa '482 to achieve an aspect ratio akin to the aspect ratio of the movie picture captured in Misawa '482.

Modifications of the other primary references would have been obvious in a similar vein. While some aspects of the Misawa '482 and Parulski '218 combination have been articulated above, the IPR petitions challenging the '493 and '729 patents include additional aspects of the combination and motivations to combine, which are incorporated by reference. Additionally, the rationales provided for the other grounds rendering the claims of the '493 and '729 patents obvious should be understood as incorporated by reference. Similarly, while the above discussion lays out in some detail aspects of the Misawa '482 and Parulski '218 combination, a POSITA would have found it obvious to arrive at the claimed elements based on any of the primary references appearing in the appended claim charts and/or knowledge of a POSTIA. For example, each of the primary references in the appended claim charts disclose image sensors that would have been obvious to replace with the disclosed image sensors in any of the other references performing the same functionality in the same way. Similarly, for any of the references that do not disclose a localized display unit on the electric camera, it would have been obvious to provide an LCD display (e.g., as disclosed in Parulski '218, as explained above) to provide an improved user interface and

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provide improved preview and play-back functionality. Further, the mixing/culling in any of the primary references would have been obvious to modify based on mixing/culling in any of the other disclosed references, or based on the knowledge of a POSITA, because such a combination involves combining known elements according to known methods to yield a predictable result and also require a simple substitution of one or more known elements for another to obtain a predictable result. Further, for any of the references that do not disclose functionality to change the view angle of the image, it would have been obvious to incorporate view angle change functionality (e.g., as disclosed in Parulski '218, as explained above) to provide an improved user interface and allow users to compose an image to their liking before capturing the image. These modifications, all limited to image processing for electric cameras, involve conventional techniques implemented in known manners, and thus, would have a reasonable expectation of success. Further, the implementation of image-instability adjustment (e.g., as disclosed in Kawahara '361) to the image processing of the charted references would have been obvious to try to improve a similar device in the same way. The references themselves provide teachings suggesting the benefits and feasibility of implementing image-instability, such that a person of ordinary skill in the art would have been motivated to try to implement this known solution in a known device ready for improvement. All motivations to combine, or reasons a POSITA would have found a limitation obvious based on their knowledge, discussed in the IPR petitions challenging the validity of the '493 and '729 patent claims should be understood as incorporated by reference here, and as being equally applicable to the obviousness of the asserted claim limitations based on the other prior art references appearing in Exhibits E-01 through E-13 and F-01 through F-15.

Accordingly, to the extent Plaintiff contends that any reference identified in Exhibits E-01 through E-13 and F-01 through F-15 does not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background knowledge of one of ordinary skill in the art and/or by combining any reference identified in Exhibits E-01 through E-13 and F-01 through F-15 in view of any of the references identified in the chart above.

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7. ’449 and ’072 Patents

The Asserted Claims of the ’449 and ’072 Asserted Patents are directed to managing data, such as multimedia digital data files (e.g., audio and videos files) that a user may want to reproduce. *See, e.g.*, ’072 Patent at Abstract, 1:30-54.[2] The ’449 and ’072 Patents use a “management” scheme with hierarchical levels, and provides a summary of a “management state of AV da-ta on a recording medium” in Figure 1. Figure 1 depicts a management state of AV data on a recording medium in an exemplary recording and reproducing device. ’072 Patent at 3:46-49. Reference numeral 101 designates AV data, and each of Program #1 to Program #3 is present on the recording unit. *Id.* at 3:49-52. Reference numeral 102 designates a third management hierarchical level (Management Level 3), wherein Program Information #1 to Program Information #3 indicate the whole reproduction ranges of Program #1 to Program #3, respectively. *Id.* at 3:56-58. Management Level 3 also includes Program Information #2a to Program Information #3a, each of which indicates a reproduction range of the whole or a part of a program arbitrarily specified by the user. *Id.* at 3:59-63. Reference numeral 103 designates a second management hierarchical level (Management Level 2), which includes Play List Information #1 to Play List Information #n. *Id.* at 4:4-8. Each play list information indicates a reproduction sequence of arbitrary program information pieces in Management Level 3. *Id.* at 4:8-10.

Reference numeral 104 designates a first management hierarchical level (Management Level 1) including a plurality of unified information pieces. *Id.* at 4:12-16. Original Unified Information contains Program Information #1 to Program Information #3 on Management Level 3. *Id.* at 4:16-20. Play List Unified Information contains Play List Information #1 to Play List Information #n on Management Level 2. *Id.* at 4:23-25. User-Defined Unified Information #1 to User-Defined Unified Information #m contain one or more from among play list information pieces on Management Level 2 and program information pieces on Management Level 3. *Id.* at 4:29-33.

[2] The ’449 patent and ’072 patents share the same specification. Although citations to the ’072 patent is used herein, corresponding disclosures are also found in the ’449 patent and are expressly incorporated herein.

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The ’449 and ’072 Patents purport to solve problems with “conventional technique[s]” by allowing users to have more control over manipulation and rearranging of their content. ’072 Patent at 2:24-3:6. The primary example used in the specification is with respect to “play lists.” *See, e.g., id.* at Abstract. In particular, the ’449 and ’072 Patent uses an example where there is a first playlist for a “mother” and a second playlist for a “father.” ’072 Patent at 6:17-38. As shown in FIGS. 6 and 7, two menu areas (“601” Mother and “701” Father) each display a list of thumbnail images (402, 502) and (503, 502) corresponding to “play list information” #1 and #2, respectively. Each menu has a first area that indicates a group, classified as “Mother” or “Father” in this example, and a second area, which displays thumbnails of data corresponding to the group. ’072 Patent at FIGS. 6-7. The specification explains that if the father and mother each have the same video on their respective lists (*e.g.* 502), the father can delete the video from his list without that video being automatically deleted from the mother’s list. *See*’072 Patent at 6:17-38. These were all well known aspects of imaging systems before the time of the alleged inventions, as even the Asserted Patents suggest.

At least the following references anticipate and/or render obvious, alone or in combination with other references, the asserted claims of the ’449 and ’072 patents:

Exemplary Prior Art References
U.S. Patent Application Publication No. 2001/0056434 to Kaplan et al. (“Kaplan”)
U.S. Patent Application Publication No. 2004/0201691 to Bryant et al. (“Bryant”)
U.S. Patent No. 6,091,778 to Sporer et al. (“Sporer”)
ACDSee PowerPack User’s Guide (“ACDSee”)
EP Patent Pub No. 2270732A1 to Barton et al. (“Barton”)
U.S. Patent Pub No. 2005/0160458 to Baumgartner et al. (“Baumgartner”)
U.S. Patent No. 7,970,240 to Chao et al. (“Chao”)
U.S. Patent No. 6,571,390 to Dunn et al. (“Dunn”)
U.S. Patent Pub No. 2002/0174430 to Ellis et al. (“Ellis”)
U.S. Patent Pub No. 2004/0177319 to Horn et al. (“Horn”)
U.S. Patent Pub No. 2003/0086568 to Kato et al. (“Kato”)
U.S. Patent Pub No. 2004/0170386 to Mikawa et al. (“Mikawa”)
U.S. Patent Pub No. 2005/0251807 to Weel et al. (“Weel”)
U.S. Patent Pub. No. 2004/0096191 to Seo et al. (“Seo”)
Panasonic DMR-E60 DVD Video Recorder and Operating Instructions (“DMR-E60”)
Sony DCR-DVD200 Digital Video Camera Recorder and Operating Instructions (“DCR-DVD200”)
Zenith DVR413 DVD Recorder and Operating Guide (“DVR413”)

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Defendants identify the following exemplary combinations as combinations of prior art showing obviousness for claims 9, 10, 11, and 12 of the ’449 patent, and/or claims 11-15 of the ’072 patent:

- ACDSee
- ACDSee in view of Barton
- ACDSee in view of Barton and Baumgartner
- ACDSee in view of Barton and Bryant
- ACDSee in view of Barton and Chao
- ACDSee in view of Barton and DCR-DVD200
- ACDSee in view of Barton and DMR-E60
- ACDSee in view of Barton and Dunn
- ACDSee in view of Barton and DVR413
- ACDSee in view of Barton and Ellis
- ACDSee in view of Barton and Horn
- ACDSee in view of Barton and Kaplan
- ACDSee in view of Barton and Kato
- ACDSee in view of Barton and Kawakami
- ACDSee in view of Barton and Melmon
- ACDSee in view of Barton and Mikawa
- ACDSee in view of Barton and Seo
- ACDSee in view of Barton and Sporer
- ACDSee in view of Barton and Weel
- ACDSee in view of Baumgartner
- ACDSee in view of Baumgartner and Barton
- ACDSee in view of Baumgartner and Bryant
- ACDSee in view of Baumgartner and Chao
- ACDSee in view of Baumgartner and DCR-DVD200
- ACDSee in view of Baumgartner and DMR-E60
- ACDSee in view of Baumgartner and Dunn
- ACDSee in view of Baumgartner and DVR413
- ACDSee in view of Baumgartner and Ellis
- ACDSee in view of Baumgartner and Horn
- ACDSee in view of Baumgartner and Kaplan
- ACDSee in view of Baumgartner and Kato
- ACDSee in view of Baumgartner and Kawakami
- ACDSee in view of Baumgartner and Melmon
- ACDSee in view of Baumgartner and Mikawa
- ACDSee in view of Baumgartner and Seo
- ACDSee in view of Baumgartner and Sporer
- ACDSee in view of Baumgartner and Weel

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- ACDSee in view of Bryant
- ACDSee in view of Bryant and Barton
- ACDSee in view of Bryant and Baumgartner
- ACDSee in view of Bryant and Chao
- ACDSee in view of Bryant and DCR-DVD200
- ACDSee in view of Bryant and DMR-E60
- ACDSee in view of Bryant and Dunn
- ACDSee in view of Bryant and DVR413
- ACDSee in view of Bryant and Ellis
- ACDSee in view of Bryant and Horn
- ACDSee in view of Bryant and Kaplan
- ACDSee in view of Bryant and Kato
- ACDSee in view of Bryant and Kawakami
- ACDSee in view of Bryant and Melmon
- ACDSee in view of Bryant and Mikawa
- ACDSee in view of Bryant and Seo
- ACDSee in view of Bryant and Sporer
- ACDSee in view of Bryant and Weel
- ACDSee in view of Chao
- ACDSee in view of Chao and Barton
- ACDSee in view of Chao and Baumgartner
- ACDSee in view of Chao and Bryant
- ACDSee in view of Chao and DCR-DVD200
- ACDSee in view of Chao and DMR-E60
- ACDSee in view of Chao and Dunn
- ACDSee in view of Chao and DVR413
- ACDSee in view of Chao and Ellis
- ACDSee in view of Chao and Horn
- ACDSee in view of Chao and Kaplan
- ACDSee in view of Chao and Kato
- ACDSee in view of Chao and Kawakami
- ACDSee in view of Chao and Melmon
- ACDSee in view of Chao and Mikawa
- ACDSee in view of Chao and Seo
- ACDSee in view of Chao and Sporer
- ACDSee in view of Chao and Weel
- ACDSee in view of DCR-DVD200
- ACDSee in view of DCR-DVD200 and Barton
- ACDSee in view of DCR-DVD200 and Baumgartner
- ACDSee in view of DCR-DVD200 and Bryant
- ACDSee in view of DCR-DVD200 and Chao
- ACDSee in view of DCR-DVD200 and DMR-E60
- ACDSee in view of DCR-DVD200 and Dunn

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- ACDSee in view of DCR-DVD200 and DVR413
- ACDSee in view of DCR-DVD200 and Ellis
- ACDSee in view of DCR-DVD200 and Horn
- ACDSee in view of DCR-DVD200 and Kaplan
- ACDSee in view of DCR-DVD200 and Kato
- ACDSee in view of DCR-DVD200 and Kawakami
- ACDSee in view of DCR-DVD200 and Melmon
- ACDSee in view of DCR-DVD200 and Mikawa
- ACDSee in view of DCR-DVD200 and Seo
- ACDSee in view of DCR-DVD200 and Sporer
- ACDSee in view of DCR-DVD200 and Weel
- ACDSee in view of DMR-E60
- ACDSee in view of DMR-E60 and Barton
- ACDSee in view of DMR-E60 and Baumgartner
- ACDSee in view of DMR-E60 and Bryant
- ACDSee in view of DMR-E60 and Chao
- ACDSee in view of DMR-E60 and DCR-DVD200
- ACDSee in view of DMR-E60 and Dunn
- ACDSee in view of DMR-E60 and DVR413
- ACDSee in view of DMR-E60 and Ellis
- ACDSee in view of DMR-E60 and Horn
- ACDSee in view of DMR-E60 and Kaplan
- ACDSee in view of DMR-E60 and Kato
- ACDSee in view of DMR-E60 and Kawakami
- ACDSee in view of DMR-E60 and Melmon
- ACDSee in view of DMR-E60 and Mikawa
- ACDSee in view of DMR-E60 and Seo
- ACDSee in view of DMR-E60 and Sporer
- ACDSee in view of DMR-E60 and Weel
- ACDSee in view of Dunn
- ACDSee in view of Dunn and Barton
- ACDSee in view of Dunn and Baumgartner
- ACDSee in view of Dunn and Bryant
- ACDSee in view of Dunn and Chao
- ACDSee in view of Dunn and DCR-DVD200
- ACDSee in view of Dunn and DMR-E60
- ACDSee in view of Dunn and DVR413
- ACDSee in view of Dunn and Ellis
- ACDSee in view of Dunn and Horn
- ACDSee in view of Dunn and Kaplan
- ACDSee in view of Dunn and Kato
- ACDSee in view of Dunn and Kawakami
- ACDSee in view of Dunn and Melmon

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- ACDSee in view of Dunn and Mikawa
- ACDSee in view of Dunn and Seo
- ACDSee in view of Dunn and Sporer
- ACDSee in view of Dunn and Weel
- ACDSee in view of DVR413
- ACDSee in view of DVR413 and Barton
- ACDSee in view of DVR413 and Baumgartner
- ACDSee in view of DVR413 and Bryant
- ACDSee in view of DVR413 and Chao
- ACDSee in view of DVR413 and DCR-DVD200
- ACDSee in view of DVR413 and DMR-E60
- ACDSee in view of DVR413 and Dunn
- ACDSee in view of DVR413 and Ellis
- ACDSee in view of DVR413 and Horn
- ACDSee in view of DVR413 and Kaplan
- ACDSee in view of DVR413 and Kato
- ACDSee in view of DVR413 and Kawakami
- ACDSee in view of DVR413 and Melmon
- ACDSee in view of DVR413 and Mikawa
- ACDSee in view of DVR413 and Seo
- ACDSee in view of DVR413 and Sporer
- ACDSee in view of DVR413 and Weel
- ACDSee in view of Ellis
- ACDSee in view of Ellis and Barton
- ACDSee in view of Ellis and Baumgartner
- ACDSee in view of Ellis and Bryant
- ACDSee in view of Ellis and Chao
- ACDSee in view of Ellis and DCR-DVD200
- ACDSee in view of Ellis and DMR-E60
- ACDSee in view of Ellis and Dunn
- ACDSee in view of Ellis and DVR413
- ACDSee in view of Ellis and Horn
- ACDSee in view of Ellis and Kaplan
- ACDSee in view of Ellis and Kato
- ACDSee in view of Ellis and Kawakami
- ACDSee in view of Ellis and Melmon
- ACDSee in view of Ellis and Mikawa
- ACDSee in view of Ellis and Seo
- ACDSee in view of Ellis and Sporer
- ACDSee in view of Ellis and Weel
- ACDSee in view of Horn
- ACDSee in view of Horn and Barton
- ACDSee in view of Horn and Baumgartner

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- ACDSee in view of Horn and Bryant
- ACDSee in view of Horn and Chao
- ACDSee in view of Horn and DCR-DVD200
- ACDSee in view of Horn and DMR-E60
- ACDSee in view of Horn and Dunn
- ACDSee in view of Horn and DVR413
- ACDSee in view of Horn and Ellis
- ACDSee in view of Horn and Kaplan
- ACDSee in view of Horn and Kato
- ACDSee in view of Horn and Kawakami
- ACDSee in view of Horn and Melmon
- ACDSee in view of Horn and Mikawa
- ACDSee in view of Horn and Seo
- ACDSee in view of Horn and Sporer
- ACDSee in view of Horn and Weel
- ACDSee in view of Kaplan
- ACDSee in view of Kaplan and Barton
- ACDSee in view of Kaplan and Baumgartner
- ACDSee in view of Kaplan and Bryant
- ACDSee in view of Kaplan and Chao
- ACDSee in view of Kaplan and DCR-DVD200
- ACDSee in view of Kaplan and DMR-E60
- ACDSee in view of Kaplan and Dunn
- ACDSee in view of Kaplan and DVR413
- ACDSee in view of Kaplan and Ellis
- ACDSee in view of Kaplan and Horn
- ACDSee in view of Kaplan and Kato
- ACDSee in view of Kaplan and Kawakami
- ACDSee in view of Kaplan and Melmon
- ACDSee in view of Kaplan and Mikawa
- ACDSee in view of Kaplan and Seo
- ACDSee in view of Kaplan and Sporer
- ACDSee in view of Kaplan and Weel
- ACDSee in view of Kato
- ACDSee in view of Kato and Barton
- ACDSee in view of Kato and Baumgartner
- ACDSee in view of Kato and Bryant
- ACDSee in view of Kato and Chao
- ACDSee in view of Kato and DCR-DVD200
- ACDSee in view of Kato and DMR-E60
- ACDSee in view of Kato and Dunn
- ACDSee in view of Kato and DVR413
- ACDSee in view of Kato and Ellis

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- ACDSee in view of Kato and Horn
- ACDSee in view of Kato and Kaplan
- ACDSee in view of Kato and Kawakami
- ACDSee in view of Kato and Melmon
- ACDSee in view of Kato and Mikawa
- ACDSee in view of Kato and Seo
- ACDSee in view of Kato and Sporer
- ACDSee in view of Kato and Weel
- ACDSee in view of Kawakami
- ACDSee in view of Melmon
- ACDSee in view of Mikawa
- ACDSee in view of Mikawa and Barton
- ACDSee in view of Mikawa and Baumgartner
- ACDSee in view of Mikawa and Bryant
- ACDSee in view of Mikawa and Chao
- ACDSee in view of Mikawa and DCR-DVD200
- ACDSee in view of Mikawa and DMR-E60
- ACDSee in view of Mikawa and Dunn
- ACDSee in view of Mikawa and DVR413
- ACDSee in view of Mikawa and Ellis
- ACDSee in view of Mikawa and Horn
- ACDSee in view of Mikawa and Kaplan
- ACDSee in view of Mikawa and Kato
- ACDSee in view of Mikawa and Kawakami
- ACDSee in view of Mikawa and Melmon
- ACDSee in view of Mikawa and Seo
- ACDSee in view of Mikawa and Sporer
- ACDSee in view of Mikawa and Weel
- ACDSee in view of Seo
- ACDSee in view of Sporer
- ACDSee in view of Weel
- Barton
- Barton in view of ACDSee
- Barton in view of ACDSee and Baumgartner
- Barton in view of ACDSee and Bryant
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- Kato in view of Mikawa and Melmon
- Kato in view of Mikawa and Seo
- Kato in view of Mikawa and Sporer
- Kato in view of Mikawa and Weel
- Kato in view of Seo
- Kato in view of Sporer
- Kato in view of Weel

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- Mikawa
- Mikawa in view of ACDSee
- Mikawa in view of ACDSee and Barton
- Mikawa in view of ACDSee and Baumgartner
- Mikawa in view of ACDSee and Bryant
- Mikawa in view of ACDSee and Chao
- Mikawa in view of ACDSee and DCR-DVD200
- Mikawa in view of ACDSee and DMR-E60
- Mikawa in view of ACDSee and Dunn
- Mikawa in view of ACDSee and DVR413
- Mikawa in view of ACDSee and Ellis
- Mikawa in view of ACDSee and Horn
- Mikawa in view of ACDSee and Kaplan
- Mikawa in view of ACDSee and Kato
- Mikawa in view of ACDSee and Kawakami
- Mikawa in view of ACDSee and Melmon
- Mikawa in view of ACDSee and Seo
- Mikawa in view of ACDSee and Sporer
- Mikawa in view of ACDSee and Weel
- Mikawa in view of Barton
- Mikawa in view of Barton and ACDSee
- Mikawa in view of Barton and Baumgartner
- Mikawa in view of Barton and Bryant
- Mikawa in view of Barton and Chao
- Mikawa in view of Barton and DCR-DVD200
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- Mikawa in view of Barton and Dunn
- Mikawa in view of Barton and DVR413
- Mikawa in view of Barton and Ellis
- Mikawa in view of Barton and Horn
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- Mikawa in view of Barton and Kato
- Mikawa in view of Barton and Kawakami
- Mikawa in view of Barton and Melmon
- Mikawa in view of Barton and Seo
- Mikawa in view of Barton and Sporer
- Mikawa in view of Barton and Weel
- Mikawa in view of Baumgartner
- Mikawa in view of Baumgartner and ACDSee
- Mikawa in view of Baumgartner and Barton
- Mikawa in view of Baumgartner and Bryant
- Mikawa in view of Baumgartner and Chao
- Mikawa in view of Baumgartner and DCR-DVD200

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- Mikawa in view of Baumgartner and DVR413
- Mikawa in view of Baumgartner and Ellis
- Mikawa in view of Baumgartner and Horn
- Mikawa in view of Baumgartner and Kaplan
- Mikawa in view of Baumgartner and Kato
- Mikawa in view of Baumgartner and Kawakami
- Mikawa in view of Baumgartner and Melmon
- Mikawa in view of Baumgartner and Seo
- Mikawa in view of Baumgartner and Sporer
- Mikawa in view of Baumgartner and Weel
- Mikawa in view of Bryant
- Mikawa in view of Bryant and ACDSee
- Mikawa in view of Bryant and Barton
- Mikawa in view of Bryant and Baumgartner
- Mikawa in view of Bryant and Chao
- Mikawa in view of Bryant and DCR-DVD200
- Mikawa in view of Bryant and DMR-E60
- Mikawa in view of Bryant and Dunn
- Mikawa in view of Bryant and DVR413
- Mikawa in view of Bryant and Ellis
- Mikawa in view of Bryant and Horn
- Mikawa in view of Bryant and Kaplan
- Mikawa in view of Bryant and Kato
- Mikawa in view of Bryant and Kawakami
- Mikawa in view of Bryant and Melmon
- Mikawa in view of Bryant and Seo
- Mikawa in view of Bryant and Sporer
- Mikawa in view of Bryant and Weel
- Mikawa in view of Chao
- Mikawa in view of Chao and ACDSee
- Mikawa in view of Chao and Barton
- Mikawa in view of Chao and Baumgartner
- Mikawa in view of Chao and Bryant
- Mikawa in view of Chao and DCR-DVD200
- Mikawa in view of Chao and DMR-E60
- Mikawa in view of Chao and Dunn
- Mikawa in view of Chao and DVR413
- Mikawa in view of Chao and Ellis
- Mikawa in view of Chao and Horn
- Mikawa in view of Chao and Kaplan
- Mikawa in view of Chao and Kato

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- Mikawa in view of Chao and Seo
- Mikawa in view of Chao and Sporer
- Mikawa in view of Chao and Weel
- Mikawa in view of DCR-DVD200
- Mikawa in view of DCR-DVD200 and ACDSee
- Mikawa in view of DCR-DVD200 and Barton
- Mikawa in view of DCR-DVD200 and Baumgartner
- Mikawa in view of DCR-DVD200 and Bryant
- Mikawa in view of DCR-DVD200 and Chao
- Mikawa in view of DCR-DVD200 and DMR-E60
- Mikawa in view of DCR-DVD200 and Dunn
- Mikawa in view of DCR-DVD200 and DVR413
- Mikawa in view of DCR-DVD200 and Ellis
- Mikawa in view of DCR-DVD200 and Horn
- Mikawa in view of DCR-DVD200 and Kaplan
- Mikawa in view of DCR-DVD200 and Kato
- Mikawa in view of DCR-DVD200 and Kawakami
- Mikawa in view of DCR-DVD200 and Melmon
- Mikawa in view of DCR-DVD200 and Seo
- Mikawa in view of DCR-DVD200 and Sporer
- Mikawa in view of DCR-DVD200 and Weel
- Mikawa in view of DMR-E60
- Mikawa in view of DMR-E60 and ACDSee
- Mikawa in view of DMR-E60 and Barton
- Mikawa in view of DMR-E60 and Baumgartner
- Mikawa in view of DMR-E60 and Bryant
- Mikawa in view of DMR-E60 and Chao
- Mikawa in view of DMR-E60 and DCR-DVD200
- Mikawa in view of DMR-E60 and Dunn
- Mikawa in view of DMR-E60 and DVR413
- Mikawa in view of DMR-E60 and Ellis
- Mikawa in view of DMR-E60 and Horn
- Mikawa in view of DMR-E60 and Kaplan
- Mikawa in view of DMR-E60 and Kato
- Mikawa in view of DMR-E60 and Kawakami
- Mikawa in view of DMR-E60 and Melmon
- Mikawa in view of DMR-E60 and Seo
- Mikawa in view of DMR-E60 and Sporer
- Mikawa in view of DMR-E60 and Weel
- Mikawa in view of Dunn
- Mikawa in view of Dunn and ACDSee

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- Mikawa in view of Dunn and Barton
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- Mikawa in view of Dunn and Bryant
- Mikawa in view of Dunn and Chao
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- Mikawa in view of Dunn and DMR-E60
- Mikawa in view of Dunn and DVR413
- Mikawa in view of Dunn and Ellis
- Mikawa in view of Dunn and Horn
- Mikawa in view of Dunn and Kaplan
- Mikawa in view of Dunn and Kato
- Mikawa in view of Dunn and Kawakami
- Mikawa in view of Dunn and Melmon
- Mikawa in view of Dunn and Seo
- Mikawa in view of Dunn and Sporer
- Mikawa in view of Dunn and Weel
- Mikawa in view of DVR413
- Mikawa in view of DVR413 and ACDSee
- Mikawa in view of DVR413 and Barton
- Mikawa in view of DVR413 and Baumgartner
- Mikawa in view of DVR413 and Bryant
- Mikawa in view of DVR413 and Chao
- Mikawa in view of DVR413 and DCR-DVD200
- Mikawa in view of DVR413 and DMR-E60
- Mikawa in view of DVR413 and Dunn
- Mikawa in view of DVR413 and Ellis
- Mikawa in view of DVR413 and Horn
- Mikawa in view of DVR413 and Kaplan
- Mikawa in view of DVR413 and Kato
- Mikawa in view of DVR413 and Kawakami
- Mikawa in view of DVR413 and Melmon
- Mikawa in view of DVR413 and Seo
- Mikawa in view of DVR413 and Sporer
- Mikawa in view of DVR413 and Weel
- Mikawa in view of Ellis
- Mikawa in view of Ellis and ACDSee
- Mikawa in view of Ellis and Barton
- Mikawa in view of Ellis and Baumgartner
- Mikawa in view of Ellis and Bryant
- Mikawa in view of Ellis and Chao
- Mikawa in view of Ellis and DCR-DVD200
- Mikawa in view of Ellis and DMR-E60
- Mikawa in view of Ellis and Dunn

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- Mikawa in view of Ellis and DVR413
- Mikawa in view of Ellis and Horn
- Mikawa in view of Ellis and Kaplan
- Mikawa in view of Ellis and Kato
- Mikawa in view of Ellis and Kawakami
- Mikawa in view of Ellis and Melmon
- Mikawa in view of Ellis and Seo
- Mikawa in view of Ellis and Sporer
- Mikawa in view of Ellis and Weel
- Mikawa in view of Horn
- Mikawa in view of Horn and ACDSee
- Mikawa in view of Horn and Barton
- Mikawa in view of Horn and Baumgartner
- Mikawa in view of Horn and Bryant
- Mikawa in view of Horn and Chao
- Mikawa in view of Horn and DCR-DVD200
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- Mikawa in view of Horn and Dunn
- Mikawa in view of Horn and DVR413
- Mikawa in view of Horn and Ellis
- Mikawa in view of Horn and Kaplan
- Mikawa in view of Horn and Kato
- Mikawa in view of Horn and Kawakami
- Mikawa in view of Horn and Melmon
- Mikawa in view of Horn and Seo
- Mikawa in view of Horn and Sporer
- Mikawa in view of Horn and Weel
- Mikawa in view of Kaplan
- Mikawa in view of Kaplan and ACDSee
- Mikawa in view of Kaplan and Barton
- Mikawa in view of Kaplan and Baumgartner
- Mikawa in view of Kaplan and Bryant
- Mikawa in view of Kaplan and Chao
- Mikawa in view of Kaplan and DCR-DVD200
- Mikawa in view of Kaplan and DMR-E60
- Mikawa in view of Kaplan and Dunn
- Mikawa in view of Kaplan and DVR413
- Mikawa in view of Kaplan and Ellis
- Mikawa in view of Kaplan and Horn
- Mikawa in view of Kaplan and Kato
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- Mikawa in view of Kaplan and Melmon
- Mikawa in view of Kaplan and Seo

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- Mikawa in view of Kaplan and Sporer
- Mikawa in view of Kaplan and Weel
- Mikawa in view of Kato
- Mikawa in view of Kato and ACDSee
- Mikawa in view of Kato and Barton
- Mikawa in view of Kato and Baumgartner
- Mikawa in view of Kato and Bryant
- Mikawa in view of Kato and Chao
- Mikawa in view of Kato and DCR-DVD200
- Mikawa in view of Kato and DMR-E60
- Mikawa in view of Kato and Dunn
- Mikawa in view of Kato and DVR413
- Mikawa in view of Kato and Ellis
- Mikawa in view of Kato and Horn
- Mikawa in view of Kato and Kaplan
- Mikawa in view of Kato and Kawakami
- Mikawa in view of Kato and Melmon
- Mikawa in view of Kato and Seo
- Mikawa in view of Kato and Sporer
- Mikawa in view of Kato and Weel
- Mikawa in view of Kawakami
- Mikawa in view of Melmon
- Mikawa in view of Seo
- Mikawa in view of Sporer
- Mikawa in view of Weel

To the extent that Plaintiff contends that any of the references identified in Exhibits G-01 through G-14 and H-01 through H-13 do not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background, experience with imaging systems, and/or prior art, including but not limited to one or more of the prior art references identified in the chart above.

A person of ordinary skill in the art would have been motivated to combine or modify any of the references in Exhibits G-01 through G-14 and H-01 through H-13 and the list above to include these limitations because, for example, systems for managing data, such as multimedia digital data files were well known and documented in the prior art before the alleged priority date of the Asserted Patents. In fact, the claimed basic features of these data management systems have been known for decades. *See, e.g.*, Section II.C, *supra*; Exhibits G-01 – G-14 and H-01 – H-13.

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Market forces and design incentives, for example, related to data management systems make the combination of such a system with any of the references identified in Exhibits G-01 through G-14 and H-01 through H-13 predictable to one of ordinary skill in the art.

For example, a POSITA would have found obvious integration of video processing circuit, such as the video processing circuit of Sporer, into video editing systems (such as Kaplan), to enhance the system "for use with digital cameras" or other "interface devices that allow video tape images to be digitized and downloaded to computers." Kaplan at [0058]; *see also* Kaplan at [0037]. In particular, including video processing circuitry in Kaplan's system, (as Sporer describes), would enable the combined system to "capture full-rate motion video information" and "playback full-rate motion video" by "using the system memory of a computer as a data buffer for holding compressed video data from the circuit." Sporer, 3:66-4:5. A POSITA would have been motivated, for example, to include in Kaplan's system, "a video and audio encoder/decoder (codec) 62 for encoding and decoding MPEG format video and audio," as Sporer teaches, where Kaplan already describes such files as being stored and played on its computer. Sporer, 6:6-8; Kaplan at [0050] ("display images representing movies saved in … MPEG multimedia file formats"); *see also* Sporer, 5:59-6:17. Indeed, Kaplan directly refers to the existence of an increasing multitude of digital video formats and to the difficulty of organizing computer files containing multimedia content. Kaplan at [0002]-[0003].

A POSITA would have found it obvious to include a video processing circuit, as Sporer teaches, where such circuity would include, among other components, an encoder that receives video data input from external devices (e.g., Kaplan's camcorder) and processes that data for storage. Sporer at 4:66-5:10 ("a computer readable and writable non-volatile recording medium 80"; "The disk should have sufficient size to hold the video information to be edited") 5:59-6:37, 11:50-12:7 ("The video information in the system memory is then copied to disk into a data file"). Kaplan teaches transferring videos and images from external devices (e.g., digital cameras and interface devices that allow video tape images to be transferred to computers), where files are "downloaded to computers." Kaplan at [0058]. A POSITA would have understood that, in the combination device, input video data from the external devices would be processed (e.g., encoded)

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using video processing circuitry, as Sporer teaches, and then stored in Kaplan's recording medium ("hard disks, flash memory cards, CD-ROMs, optical storage devices, or magnetic storage devices"), as both Sporer and Kaplan teach. Kaplan at [0034]; Sporer, 4:66-5:10, 5:59-6:37, 11:50-12:7.

Combining the teachings of the references listed above would have merely involved combining prior art elements—for example, a multimedia management system per Kaplan and components (e.g., codecs) for processing certain types of input multimedia data per Sporer—according to known methods to yield predictable results. A POSITA would have been motivated to combine these teachings to realize the implementation details (of Sporer) for receiving and processing video data from external devices, as Kaplan describes. For example, a POSITA would have been motivated to include video codecs, such as an MPEG codec, for encoding video data received from external devices (e.g., camcorder or other interface devices) into a format that can be played back on Kaplan's computer (and the systems of the other references listed above). Kaplan at [0050] ("display images representing movies saved in … MPEG multimedia file formats"); *see also* Boston at [0077] ("When show is encoded, it is converted to a compressed format suitable for storage or transmission; when it is decoded it is converted to a non-compressed (raw) format suitable for presentation.").

The combination of these references would have been predictable and foreseeable because the references disclose computing systems that can store, process, and play back multimedia files from external video devices (Kaplan at [0004], [0037], [0058]; Sporer, Abstract, 4:4-10, FIG. 1) and the references describe the use of standard encoding techniques (e.g., MPEG files) (Kaplan at [0050]; Sporer, 5:59-6:17), and 2) the combination merely involves incorporating known features that are explicitly disclosed in the references and would have been understood by a POSITA as likely present, but not explicitly disclosed in other references. The combination is predictable, at least in part, because elements of the combined system would each perform similar functions they had been known to perform prior to the combination. *Id*. For example, the computer of Kaplan would still perform the same functions, including storing, manipulating, and displaying

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multimedia content and receiving such content from external devices, as it did prior to the combination with Sporer. *Id.*

Further, a POSITA would have also looked to references such as Bryant that disclose user-customizable metadata for video and image data including, for example groups that enables subsequent organization. *See, e.g.*, Bryant at [0003]-[0005], [0029]. Bryant explains that, by using multimedia according to its systems and methods, a particular user's "affective information" can be captured, which can be stored with video images. Bryant at [0029]-[0034]. "A POSITA would have recognized that inclusion of the richer metadata in Bryant would have improved the Kaplan system, allowing for more effective (e.g., more detailed or more personalized) organization and retrieval of multimedia information." The teachings of Bryant itself motivate the combination. *Id.*

With Bryant's robust disclosure of user-customizable metadata, such as "groups" (e.g., Animals, Sports), the corresponding areas of the interface menu in Kaplan could be updated. *See* Bryant at FIGS. 8, 9A-9C. For instance, a POSITA would have used the display arrangement and controls set forth in Bryant's FIGS. 9A-9C, which would allow for more effective (e.g., more detailed or more personalized) organization and retrieval of multimedia information in the primary art references listed above. Bryant at [0100] ("[T]he user optionally resets images that are no longer considered favorites. This is accomplished using the favorites level selection area 860."). For instance, the metadata of Bryant would be useful with respect to the search functions in Kaplan. *See* Kaplan at [0065]-[0066]. Additionally, Bryant explicitly teaches other user-customizable features, such as, for example, options for sorting thumbnails. Bryant at [0094]. In particular, Bryant teaches a GUI screen that "includes sort options that are selected using a sort items text box 844 and a pull-down arrow icon 846 to select a desired sort option from a list, including sort by date, caption, or keyword" in addition to a "reverse order checkbox … to reverse the display of the thumbnail images." *Id.* A POSITA would have included as such sort options as one of the "functions associated with the user interface" in Kaplan. Kaplan at [0040]. Indeed, Kaplan describes its interface with reference to the "most popular operating system available today," "Microsoft Windows," and explains that its "interface for controlling functions of the multimedia management system [] include[s] operational options that correspond to common features of the

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Windows operating system." Kaplan at [0040]. With its emphasis on user-customization and control, Bryant itself further motivates the combination.

Modifications of the other primary references would have been obvious in a similar vein. That is, the primary references disclose digital cameras or other interface devices that allow video data to be digitized and downloaded that would have been obvious to replace with other disclosed video processing circuitry performing the same functionality in the same way. Similarly, for any of the references that do not disclose video processing circuits, it would have been obvious to provide a video processing circuit (e.g., as disclosed in Sporer, as explained above) to provide an improved such circuitry. And any reference that lack the flexible metadata to organize videos into groups and playlists would have looked to Bryant's teachings of such metadata Such combinations involve combining elements known in the prior art according to known methods to yield a predictable result and also require a simple substitution of one or more known elements for another to obtain a predictable result. The references themselves provide teachings suggesting the benefits and feasibility of implementing image-instability, such that a person of ordinary skill in the art would have been motivated to try to implement this known solution in a known device ready for improvement.

Further, the references use conventional components and programming, such that combinations would have been straightforward and yielded predictable results. For instance, both Kaplan and Bryant use standard hardware, including Windows-based programming. *See* Kaplan at [0037]-[0038]; Bryant at [0037]-[0040]. Additionally, given that Kaplan already included metadata, such as Favorites, adding additional metadata fields such as those taught by Bryant would have been a straight forward application of known programming techniques. A POSITA would have known how to modify any data structures and user interfaces to include additional metadata because modifying data structures and user interfaces was well within their skill, and they had already created those data structures and user interfaces to create the system of Kaplan in the first place. Thus, combining the references would have been no more than the use of a known technique to improve similar a device in the same way.

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Accordingly, to the extent Plaintiff contends that any reference identified in Exhibits G-01 through G-14 and H-01 through H-13 does not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background knowledge of one of ordinary skill in the art and/or by combining any reference identified in Exhibits G-01 through G-14 and H-01 through H-13 in view of any of the references identified in the chart above.

8. '284 Patent

The Asserted Claims of the '284 Patent include various basic components and methods to control simultaneous radio connections over which digital information (*e.g.*, video data) is sent and received. These were all well known aspects of videotelephony before the time of the alleged inventions, as even the Asserted Patents suggest.

At least the following references anticipate and/or render obvious, alone or in combination with other references, the asserted claims of the '284 patent:

Exemplary Prior Art References
ETSI TR 145 912 V7.2.0, Digital cellular telecommunications system (Phase 2+); Feasibility study for evolved GSM/EDGE Radio Access Network (GERAN) (3GPP TR 45.912 version 7.2.0 Release 7) ("TR 45.912")
IEEE Std 802.11a-1999, Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) specifications High-speed Physical Layer in the 5 GHz Band ("IEEE Std 802.11a")
IEEE Std 802.15.3™-2003, Part 15.3: Wireless Medium Access Control (MAC) and Physical Layer (PHY) Specifications for High Rate Wireless Personal Area Networks (WPANs) ("IEEE Std 802.15.3")
Malyan et al, A Multi-service Architecture to Support Mobile IP Applications over Heterogeneous Wireless Networks, IEEE 2003 ("Malyan")
Nokia 6131 Phone and User Guide ("Nokia 6131")
Nokia N93 Phone and User Guide ("N93")
Nokia N95 Phone and User Guides ("N95")
TR 22.937 v. 1.0.0, 3rd Generation Partnership Project; Technical Specification Group TSG SA; Requirements for service continuity between mobile and WLAN networks; (Release 8) ("TR 22.937")
U.S. Patent Application Pub. No. 2004/0125779 to Kelton ("Kelton")
U.S. Patent Application Pub. No. 2005/0136949 to Barnes Jr. ("Barnes")
U.S. Patent Application Pub. No. 2007/0091855 to Karaoguz ("Karaoguz")
U.S. Patent Application Pub. No. 2007/0238483 to Boireau et al. ("Boireau")
U.S. Patent Application Pub. No. 2008/253345 to Sanguinetti ("Sanguinetti")
U.S. Patent No. 6,516,192 to Spaur et al. ("Spaur")
U.S. Patent No. 7,590,075 and U.S. Patent Pub. No. 2006/0233191 to Pirzada et al. ("Pirzada")

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Exemplary Prior Art References
U.S. Patent Pub. No. 2006/0135076 to Honkanen et al. (“Honkanen”)
U.S. Patent Pub. No. 2006/0203758 to Tee et al. (“Tee”)
U.S. Patent Pub. No. 2006/0258289 to Dua (“Dua”)
Zhang et al., A Triple-Standard Transceiver Architecture For GSM, WCDMA and Wi-Fi Applications, 2005 12th IEEE International Conference on Electronics, Circuits and Systems (“Zhang”)
IEEE Std 802.11g-2003, Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) specifications Band (“IEEE 802.11g”)
Specification of the Bluetooth System (“Bluetooth-Specification”)
U.S. Patent Application Pub. No. 2004/0264600 to Kao et al. (“Kao”).

Defendants identify the following exemplary combinations as combinations of prior art showing obviousness for claims 18, 19, and 20 of the ’284 patent:

- Nokia 6131 in view of Kelton
- Nokia 6131 in view of Barnes
- Nokia 6131 in view of Boireau
- Nokia 6131 in view of Dua
- Nokia 6131 in view of Honkanen
- Nokia 6131 in view of Karaoguz
- Nokia 6131 in view of Pirzada
- Nokia 6131 in view of Sunguentti
- Nokia 6131 in view of Spaur
- Nokia 6131 in view of Tee
- Nokia 6131 in view of TR 22.937
- Nokia 6131 in view of Malyan
- Nokia 6131 in view of IEEE Std 802.11a
- Nokia 6131 in view of IEEE Std 802. 15.3
- Nokia 6131 in view of TR 45.912
- Nokia 6131 in view of Zhang
- Nokia 6131 in view of IEEE 802.11g
- Nokia 6131 in view of Bluetooth-Specification
- Nokia 6131 in view of Kao
- Nokia 6131 in view of Bluetooth-Specification and IEEE 802.11g
- Nokia 6131 in view of Bluetooth-Specification and IEEE 802.11a
- Nokia 6131 in view of Barnes and Dua
- Nokia 6131 in view of Barnes, Dua, and Kao
- Nokia 6131 in view of Barnes, Dua, Kao, and Bluetooth-Specification
- Nokia N93 in view of Kelton
- Nokia N93 in view of Barnes
- Nokia N93 in view of Boireau
- Nokia N93 in view of Dua
- Nokia N93 in view of Honkanen

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- Nokia N93 in view of Karaoguz
- Nokia N93 in view of Pirzada
- Nokia N93 in view of Sunguentti
- Nokia N93 in view of Spaur
- Nokia N93 in view of Tee
- Nokia N93 in view of TR 22.937
- Nokia N93 in view of Malyan
- Nokia N93 in view of IEEE Std 802.11a
- Nokia N93 in view of IEEE Std 802. 15.3
- Nokia N93 in view of TR 45.912
- Nokia N93 in view of Zhang
- Nokia N93 in view of IEEE 802.11g
- Nokia N93 in view of Bluetooth-Specification
- Nokia N93 in view of Kao
- Nokia N93 in view of Bluetooth-Specification and IEEE 802.11g
- Nokia N93 in view of Bluetooth-Specification and IEEE 802.11a
- Nokia N93 in view of Barnes and Dua
- Nokia N93 in view of Barnes, Dua, and Kao
- Nokia N93 in view of Barnes, Dua, Kao, and Bluetooth-Specification
- Nokia N95 System in view of Kelton
- Nokia N95 System in view of Barnes
- Nokia N95 System in view of Boireau
- Nokia N95 System in view of Dua
- Nokia N95 System in view of Honkanen
- Nokia N95 System in view of Karaoguz
- Nokia N95 System in view of Pirzada
- Nokia N95 System in view of Sunguentti
- Nokia N95 System in view of Spaur
- Nokia N95 System in view of Tee
- Nokia N95 System in view of TR 22.937
- Nokia N95 System in view of Malyan
- Nokia N95 System in view of IEEE Std 802.11a
- Nokia N95 System in view of IEEE Std 802. 15.3
- Nokia N95 System in view of TR 45.912
- Nokia N95 System in view of Zhang
- Nokia N95 System in view of IEEE 802.11g
- Nokia N95 System in view of Bluetooth-Specification
- Nokia N95 System in view of Kao
- Nokia N95 in view of Bluetooth-Specification and IEEE 802.11g
- Nokia N95 in view of Bluetooth-Specification and IEEE 802.11a
- Nokia N95 in view of Barnes and Dua
- Nokia N95 in view of Barnes, Dua, and Kao
- Nokia N95 in view of Barnes, Dua, Kao, and Bluetooth-Specification

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- Kelton in view of Nokia N95
- Kelton in view of Barnes
- Kelton in view of Boireau
- Kelton in view of Dua
- Kelton in view of Honkanen
- Kelton in view of Karaoguz
- Kelton in view of Pirzada
- Kelton in view of Sunguentti
- Kelton in view of Spaur
- Kelton in view of Tee
- Kelton in view of TR 22.937
- Kelton in view of Malyan
- Kelton in view of IEEE Std 802.11a
- Kelton in view of IEEE Std 802. 15.3
- Kelton in view of TR 45.912
- Kelton in view of Zhang
- Kelton in view of IEEE 802.11g
- Kelton in view of Bluetooth-Specification
- Kelton in view of Kao
- Kelton in view of Honkanen and Nokia N95
- Kelton in view of Honkanen and Nokia N93
- Kelton in view of Honkanen and Nokia 6131
- Kelton in view of Bluetooth-Specification and IEEE 802.11g
- Kelton in view of Bluetooth-Specification and IEEE 802.11a
- Kelton in view of Nokia N95, Bluetooth-Specification, and IEEE 802.11a
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- Tee in view of Honkanen, Nokia N95, Bluetooth-Specification, and IEEE 802.11g
- Tee in view of Honkanen, Nokia N93, Bluetooth-Specification, and IEEE 802.11a
- Tee in view of Honkanen, Nokia N93, Bluetooth-Specification, and IEEE 802.11g
- Tee in view of Barnes and Dua
- Tee in view of Barnes and Nokia N95
- Tee in view of Barnes and Nokia N93
- Tee in view of Barnes and Nokia 6131
- Tee in view of Dua and Nokia N95
- Tee in view of Dua and Nokia N93
- Tee in view of Dua and Nokia 6131
- Tee in view of Barnes, Dua, and Nokia N95
- Tee in view of Barnes, Dua, and Nokia N93
- Tee in view of Barnes, Dua, and Nokia 6131
- Tee in view of Barnes, Dua, and Nokia N95
- Tee in view of Barnes, Dua, and Nokia N93
- Tee in view of Barnes, Dua, and Nokia 6131
- Tee in view of Barnes, Dua, and Kao
- Tee in view of Barnes, Dua, Kao, and Bluetooth-Specification
- Tee in view of Barnes, Dua, Nokia N95, Kao, and Bluetooth-Specification
- Tee in view of Barnes, Dua, Nokia N93, Kao, and Bluetooth-Specification
- Tee in view of Barnes, Dua, Nokia 6131, Kao, and Bluetooth-Specification
- TR 22.937 in view of Nokia N95
- TR 22.937 in view of Kelton
- TR 22.937 in view of Barnes
- TR 22.937 in view of Boireau
- TR 22.937 in view of Dua
- TR 22.937 in view of Honkanen

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- TR 22.937 in view of Karaoguz
- TR 22.937 in view of Pirzada
- TR 22.937 in view of Sanguinetti
- TR 22.937 in view of Spaur
- TR 22.937 in view of Tee
- TR 22.937 in view of Malyan
- TR 22.937 in view of IEEE Std 802.11a
- TR 22.937 in view of IEEE Std 802. 15.3
- TR 22.937 in view of TR 45.912
- TR 22.937 in view of Zhang
- TR 22.937 in view of IEEE 802.11g
- TR 22.937 in view of Bluetooth-Specification
- TR 22.937 in view of Kao
- TR 22.937 in view of Honkanen and Nokia N95
- TR 22.937 in view of Honkanen and Nokia N93
- TR 22.937 in view of Honkanen and Nokia 6131
- TR 22.937 in view of Bluetooth-Specification and IEEE 802.11g
- TR 22.937 in view of Bluetooth-Specification and IEEE 802.11a
- TR 22.937 in view of Nokia N95, Bluetooth-Specification, and IEEE 802.11a
- TR 22.937 in view of Nokia N95, Bluetooth-Specification, and IEEE 802.11g
- TR 22.937 in view of Nokia N93, Bluetooth-Specification, and IEEE 802.11a
- TR 22.937 in view of Nokia N93, Bluetooth-Specification, and IEEE 802.11g
- TR 22.937 in view of Nokia 6131, Bluetooth-Specification, and IEEE 802.11a
- TR 22.937 in view of Nokia 6131, Bluetooth-Specification, and IEEE 802.11g
- TR 22.937 in view of Honkanen, Nokia 6131, Bluetooth-Specification, and IEEE 802.11a
- TR 22.937 in view of Honkanen, Nokia 6131 Bluetooth-Specification, and IEEE 802.11g
- TR 22.937 in view of Honkanen, Nokia N95, Bluetooth-Specification, and IEEE 802.11a
- TR 22.937 in view of Honkanen, Nokia N95, Bluetooth-Specification, and IEEE 802.11g
- TR 22.937 in view of Honkanen, Nokia N93, Bluetooth-Specification, and IEEE 802.11a
- TR 22.937 in view of Honkanen, Nokia N93, Bluetooth-Specification, and IEEE 802.11g
- TR 22.937 in view of Barnes and Dua
- TR 22.937 in view of Barnes and Nokia N95
- TR 22.937 in view of Barnes and Nokia N93
- TR 22.937 in view of Barnes and Nokia 6131
- TR 22.937 in view of Dua and Nokia N95
- TR 22.937 in view of Dua and Nokia N93
- TR 22.937 in view of Dua and Nokia 6131

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- TR 22.937 in view of Barnes, Dua, and Nokia N95
- TR 22.937 in view of Barnes, Dua, and Nokia N93
- TR 22.937 in view of Barnes, Dua, and Nokia 6131
- TR 22.937 in view of Barnes, Dua, and Nokia N95
- TR 22.937 in view of Barnes, Dua, and Nokia N93
- TR 22.937 in view of Barnes, Dua, and Nokia 6131
- TR 22.937 in view of Barnes, Dua, and Kao
- TR 22.937 in view of Barnes, Dua, Kao, and Bluetooth-Specification
- TR 22.937 in view of Barnes, Dua, Nokia N95, Kao, and Bluetooth-Specification
- TR 22.937 in view of Barnes, Dua, Nokia N93, Kao, and Bluetooth-Specification
- TR 22.937 in view of Barnes, Dua, Nokia 6131, Kao, and Bluetooth-Specification

To the extent that Plaintiff contends that any of the references identified in Exhibits I-01–I-14 do not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background, experience with imaging systems, and/or prior art, including but not limited to one or more of the prior art references identified in the chart above.

A person of ordinary skill in the art would have been motivated to combine or modify any of the references in Exhibits I-01–I-14 and the list above to include these limitations because, for example, videotelephony systems were well known and documented in the prior art before the alleged priority date of the Asserted Patents. In fact, the claimed basic features of communication systems have been known for decades. *See, e.g.*, Section II.C, *supra*; I-01–I-14. Market forces and design incentives, for example, related to videotelephony systems make the combination of such a system with any of the references identified in Exhibits I-01–I-14 predictable to one of ordinary skill in the art.

For example, a POSITA would have found it predictable to combine the teachings of Barnes and Honkanen because both Barnes and Honkanen pertain to broadcasting digital information over different kinds of radio connections. A POSITA would have, in particular, found it obvious to use Honkanen's common control manager in Barnes's device.

A POSITA would have been motivated to use Honkanen's common control manager to implement Barnes's device that "preferably includes means" for determining best available radio connections based on bandwidth, data rate, changes in availability, and user preference. Barnes

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[0064]-[0068]. Specifically, a POSITA would have been motivated to implement Honkanen's continuous connection control manager and parameter control manager, internal components of Honkanen's common control manager, into Barnes's device so as to fulfill the Barnes's preferred network switching functionality, that governs in "one or more of 1) changes in network conditions such as failure of a first network or the first network slowing down (due to high use such as multiple users and/or high levels of data being communicated), such as below a predetermined level (e.g., threshold speed), or increases in noise, 2) the user making a request, or attempting to make the request, to communicate data that is more suitable for communication through a second network (e.g., the user requesting a video file or movie), 3) the anticipated request of the user (e.g., based on the user starting a particular application such as a video player), 4) changes in network availability (e.g., a new network becoming available), 5) changes in conditions of the second network (e.g., more bandwidth or less noise), 6) the available capacity or relative available capacity (e.g., how full to capacity a network is), 7) the communication capabilities of the device, and 8) the historical (or anticipated) availability of bandwidth of network(s) (which may include, for example, use, volume, capacity, and/or speed data for days of the week or times of the day)." Barnes at [0068]; Honkanen at [0056]-[0058]. This modification would have been predictable and would have had a reasonable expectation of success because both Barnes's device and Honkanen's connection managers concern switching network connections to send data based on a variety of conditions and thus operate under the same principles and for the same purpose. Barnes at [0002]-[0004]; Honkanen at [0022]-[0027].

Further, a POSITA would have been motivated to combine the teachings from references teach and only focus on a single aspect of communication devices such as communicating via different, multiple radio connections (such as Honkanen, Dua, Barnes, Kelton) with the disclosures found in system art (such as Nokia N93, Nokia N95, Nokia 6131) as well as specifications for and further art expanding on standards (such as Bluetooth-Specification, IEEE 802.11a, IEEE 802.11g, 802.15.3, Kao, Zhang, Malyan). A POSITA looking for details on implementing multiple radio connections controlled by a single device/user would have been motivated to investigate standards and systems available at the time that already possessed capability for multiple radio connections.

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For example, the Nokia N93, Nokia N95, and Nokia 6131 systems all disclose applications which a user can use to issue indications to connect to an external device or the Internet, and a POSITA would have recognized that using applications to provide user input to establish radio communication circuits like those described in references such as Honkanen, Dua, Barnes, and Kelton. Further, a POSITA looking for details regarding different frequency bands and modulation/demodulation methods would have been motivated to consult different standards and publications writing on frequency bands and modulation/demodulation methods such as IEEE 802.11a, IEEE 802.11g, IEEE 802.15.3, Kao, Malyan, and Zhang.

Modifications of the other primary references would have been obvious in a similar vein. That is, the primary references disclose apparatuses and methods for simultaneous control of multiple radio communication circuits that would have been obvious to replace with other disclosed apparatus and methods performing the same functionality in the same way. Similarly, for any of the references that do not disclose particular hardware for controlling radio connections, it would have been obvious to provide communication control measures (*e.g.*, as disclosed in Honkanen, as explained above) to provide network switching functionality in response to numerous parameters, including user preference. Further, the mixing/culling in any of the primary references would have been obvious to modify based on mixing/culling in any of the other disclosed references because such a combination involves combining elements known in the prior art according to known methods to yield a predictable result and also require a simple substitution of one or more known elements for another to obtain a predictable result. These modification, all limited to controlling multiple radio connections, involve conventional techniques implemented in known manners, and thus, would have a reasonable expectation of success. Further, adding functionality to allow the user to select a particular network (*e.g.*, as disclosed in Kelton at [0181]) to the charted references disclosing network management and user interfaces would have been obvious to try to improve a similar device in the same way. The references themselves provide teachings suggesting the benefits and feasibility of implementing priority schemes for multiple connections and user input for the same, such that a person of ordinary skill in the art would have been motivated to try to implement this known solution in a known device ready for improvement.

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Accordingly, to the extent Plaintiff contends that any reference identified in Exhibits I-01–I-14 does not disclose these limitations, a person of ordinary skill in the art would have arrived at the purported invention based on their own background knowledge of one of ordinary skill in the art and/or by combining any reference identified in Exhibits I-01–I-14 in view of any of the references identified in the chart above.

E. Lack of Secondary Indicia of Nonobviousness

The Asserted Claims are further rendered obvious in light of the lack of any evidence of secondary considerations of nonobviousness. Plaintiff bears the burden with respect to any such secondary considerations, and it has not satisfied that burden to date. Moreover, for any secondary consideration to be relevant, Plaintiff must establish a nexus between the secondary consideration and the claimed inventions. *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1312 (Fed. Cir. 2006). Plaintiff has not provided any evidence of any secondary considerations, much less any nexus between such secondary considerations and the claimed inventions of the Asserted Patents. Should Plaintiff identify such alleged secondary considerations, Defendants may respond.

In the meantime, Defendants provide the following:

- The alleged invention's commercial success: No products are known to practice the Asserted Claims. Even if products were determined to practice the Asserted Claims, their success could not be attributed to the Asserted Claims. Indeed, there is no evidence that the allegedly novel elements claimed in the Asserted Patents could possibly lead to commercial success of products, especially multi-component consumer electronic products (e.g., Laptops and Smartphone) like the products Plaintiff has accused in this case. Defendants' owe any commercial success to a wide variety of technologies and factors, which do not include any specific reference to the accused features.
- Long felt but unresolved needs / recognition of an unaddressed problem: No such long felt and unresolved need or unaddressed problem existed. To the contrary, the prior art cited above demonstrates that numerous others had already recognized and solved the needs purportedly addressed by the Asserted Patents.

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- Unexpected results: No evidence of any such unexpected results or skepticism by experts is known. To the contrary, the alleged inventions claimed in the Asserted Patents are entirely preempted by the work of others and/or represent, at best, the foreseeable results of routine experimentation or optimization given the state of the art as shown by the prior art cited above.
- The failure of others: No evidence of any such failure is known. To the contrary, the prior art cited above demonstrates that numerous others had already succeeded at the same endeavor purportedly addressed by the Asserted Patents.
- Praise by others: No evidence of any such praise is known.
- Teaching away by others: No evidence of any such teaching is known. To the contrary, the prior art cited above demonstrates that numerous others had already taught *toward* the purported inventions recited in the Asserted Claims.
- Copying of the alleged invention by competitors: No evidence of any such copying is known. *See Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1366 (Fed. Cir. 2001) (allegedly copied feature must be an embodiment of the patented claims).

III. Contentions Under 35 U.S.C. § 112

Various claims of the Asserted patents are also invalid for indefiniteness, lack of enablement, and/or lack of written description under 35 U.S.C. § 112.

Defendants' contentions that the following claims are invalid under 35 U.S.C. § 112 are made in the alternative and do not constitute, and should not be interpreted as, admissions regarding the construction or scope of the claims of the Patents-In-Suit, or that any of the claims of the Patents-In-Suit are not anticipated or rendered obvious by prior art. The following contentions, made pursuant to Pat L.R. 3-3(d), are subject to revision and amendment pursuant to Federal Rule of Civil Procedure 26(e) and the Orders in this matter to the extent appropriate, including in light of further investigation and discovery regarding any defenses, the Court's construction of the claims at issue, and/or review and analysis of expert witnesses.

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A. The Asserted Claims Are Invalid for Lack of Enablement and Written Description

Under 35 U.S.C. § 112, a patent must provide sufficient description of the claimed invention to permit or enable a person of ordinary skill in the art to make and use the claimed invention. As discussed below, the Asserted Claims are invalid for failure to comply with the written description and enablement requirements because the Patents-in-Suit do not contain sufficient written description of the claimed invention and do not provide a sufficiently enabling disclosure.

A patent must sufficiently disclose the invention to reasonably convey to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3 1336, 1351 (Fed. Cir. 2010) (en banc). Under 35 U.S.C. § 112, ¶1, "[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention." To satisfy the written description requirement, the specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention at the time of filing. *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345 (Fed. Cir. 2000) ("The purpose of [the written description requirement] is to ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor's contribution to the field of art as described in the patent specification"); *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) ("[A]ll limitations must appear in the specification."); *see also Ariad*, 598 F.3d at 1351-52 ("[T]he test requires an objective inquiry into the *four corners of the specification*" as "*it is the specification itself that must demonstrate possession*."); *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306-07 (Fed. Cir. 2008) ("[T]o satisfy the written description requirement, 'the missing descriptive matter *must necessarily be present in the . . . specification*[.]'"), 1310 ("Obviousness simply is not enough; subject matter must be disclosed to establish possession."); *Carnegie Mellon*

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Univ. v. Hoffmann–La Roche Inc., 541 F.3d 1115, 1122 (Fed. Cir. 2008) ("[T]he applicant must 'convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention,' and *demonstrate that by disclosure in the specification of the patent*."); *Rivera v. Int'l Trade Comm'n*, 857 F.3d 1315, 1319 (Fed. Cir. 2017) ("*The specification* of a patent as filed must 'contain a written description of the invention.'" (internal citations omitted)); *Novozymes A/S v. Dupont Nutrition Biosciences APS*, 723 F.3d 1336, 1344 (Fed. Cir. 2013) ("[T]he specification must describe an invention understandable to [a] skilled artisan and show that the inventor actually invented the invention claimed. A mere wish or plan for obtaining the claimed invention does not satisfy the written description requirement.") (internal citation, quotation marks omitted).

The enablement requirement is satisfied only if one skilled in the art can practice the invention based on the teachings of the patent without undue experimentation. *See AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1244 (Fed. Cir. 2003). Hence, a claim is invalid for lack of enablement if a POSITA would not be able to read the specification and practice the claimed invention without undue experimentation. *Amgen Inc. v. Sanofi, Aventisub LLC*, 987 F.3d 1080, 1084 (Fed. Cir. 2021). "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." *Amgen Inc.*, 987 F.3d at 1084 (internal citation, quotation marks omitted). The factual considerations, which are known as "*Wands* factors," are "(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims." *Id*. (quoting *In re Wands*, 858 F.2d 731, 736–37 (Fed. Cir. 1988)). A claimed invention may be invalid for non-enablement even if it was disclosed in the prior art: "It is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement." *Genentech v. Novo Nordisk*, 108 F.3d 1361, 1366 (Fed. Cir. 1997). The patentee is "required to provide an adequate enabling disclosure in the specification; it cannot simply rely on the knowledge of a person of ordinary skill to serve as a

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substitute for the missing information in the specification." *Alza Corp. v. Andrx Pharms., LLC*, 603 F.3d 935, 940-41 (Fed. Cir. 2010). "A patentee who chooses broad claim language must make sure the broad claims are fully enabled." *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999-1000 (Fed. Cir. 2008). As the Federal Circuit has explained:

> Enablement serves the dual function in the patent system of ensuring adequate disclosure of the claimed invention and of preventing claims broader than the disclosed invention. This important doctrine prevents both inadequate disclosure of an invention and overbroad claiming that might otherwise attempt to cover more than was actually invented. Thus, a patentee chooses broad claim language at the peril of losing any claim that cannot be enabled across its full scope of coverage.

Magsil Corp. and MIT v. Hitachi, 687 F.3d 1377, 1380-81 (Fed. Cir. 2012). "The specification must contain sufficient disclosure to enable an ordinarily skilled artisan to make and use the entire scope of the claimed invention at the time of filing." *Id*. at 1381-82.

Based on the information currently available, Defendants contend that the specification of each Patent-in-Suit does not provide sufficient written description and/or enablement for each of the claim limitations identified below, thus identifying grounds of invalidity for lack of enablement and/or written description with respect to the Asserted Claims and the limitations of the Asserted Claims, pursuant to Pat. L.R. 3-3(d). Where Defendants have identified a phrase as lacking written description and/or enablement, Defendants also contend that the subparts of the phrase lack written description and/or enablement within the context recited in the claim. Although the following discussion includes the identification and discussion of claim terms and limitations lacking § 112 written description and enablement support, a more detailed basis for Defendants' written description and enablement defenses may be set forth in any expert report(s) on invalidity to be served by Defendant in accordance with the Court's Scheduling Order.

1. '760 patent

Asserted claims 4, 6, 7, and 9 of the '760 patent fail to satisfy the requirements of 35 U.S.C. § 112 at least because the '760 patent fails to provide an adequate written description and/or enablement of the following limitations, at least as those limitations are applied by Plaintiff in its Infringement Contentions:

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- "reproducing at least a first still picture, a second still picture and a picture from a recording medium" / "reproducing at least a first still picture, a second still picture and a picture recorded on a recording medium" (e.g., '760 patent, cls. 4, 7)
- "reproducing at least a first still picture, a second still picture and a picture" / "reproducing at least a first still picture, a second still picture and a picture recorded" (e.g., '760 patent, cls. 4, 7)
- "said picture corresponds to said first and second still pictures and has a smaller number of pixels than said first and second still pictures" (e.g., '760 patent, cls. 4, 7)
- "said picture . . . has a smaller number of pixels than said first and second still pictures" (e.g., '760 patent, cls. 4, 7)
- "smaller number of pixels" (e.g., '760 patent, cls. 4, 7)
- "wherein said first still picture, said second still picture and said picture are related pictures derived from common signal data" (e.g., '760 patent, cls. 4, 7)
- "said picture are related pictures derived from common signal data" (e.g., '760 patent, cls. 4, 7)
- "related pictures derived from common signal data" (e.g., '760 patent, cls. 4, 7)
- "said picture" (e.g., '760 patent, cls. 4, 7)
- "related pictures" (e.g., '760 patent, cls. 4, 7)
- "common signal data" (e.g., '760 patent, cls. 4, 7)
- "first still picture corresponding to a selected picture" (e.g., '760 patent, cls. 4, 7)
- "first still picture corresponding to" (e.g., '760 patent, cls. 4, 7)
- "corresponding to a selected picture" (e.g., '760 patent, cls. 4, 7)
- "corresponding to" (e.g., '760 patent, cls. 4, 7)

The foregoing terms, phrases, and/or limitations are not described in such a way that a person having ordinary skill in the art at the time of the alleged invention would have understood that the individuals named as the inventors on the face of the '760 patent were in possession of the claimed subject matter, at least to the extent the claims are interpreted consistently with the positions taken

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in Plaintiff's Infringement Contentions. Furthermore, to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions, the '760 patent fails to teach a person of ordinary skill in the art how to make and use the full scope of the claimed invention without undue experimentation with respect to foregoing phrases. To the extent the claims are construed or interpreted to be as broad as the positions taken in Plaintiff's Infringement Contentions, the '760 patent does not provide adequate written description or enable the full scope of the claim limitations listed above.

2. '334 patent

Asserted claims 4 and 6 of the '334 patent fail to satisfy the requirements of 35 U.S.C. § 112 at least because the '334 patent fails to provide an adequate written description and/or enablement of the following limitations, at least as those limitations are applied by Plaintiff in its Infringement Contentions:

- "variable amplitude amplifier" (e.g., '334 patent, cl. 4);
- "receiving a first communication signal and a transmitting power control signal from a cell-site station" (e.g., '334 patent, cl. 4);
- "generating a power control signal derived from said transmitting power control signal" (e.g., '334 patent, cl. 4);
- "voice signal code" and "voice code signal" (e.g., '334 patent, cl. 4);
- "converting said voice signal code into an audio signal" (e.g., '334 patent, cl. 4);
- "controlling said transmitter in such a manner that an open-loop power control is performed at first and then a closed-loop power control is performed according to said power control signal" (e.g., '334 patent, cl. 4);
- "control transmitted power to converge into a range required by said cell-site station" (e.g., '334 patent, cl. 4);
- "controlling said transmitter in such a manner that an open-loop power control is performed at first and then a closed-loop power control is performed according to said power control signal so as to control transmitted power to converge into a range required by said cell-site station" (e.g., '334 patent, cl. 4);

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- "a function defining a relation between bias data and gain data stored in said memory" (e.g., '334 patent, cl. 4);
- "stored in said memory" (e.g., '334 patent, cl. 4)
- "controlling a gain of said variable amplitude amplifier and a bias condition of said power amplifier using a function defining a relation between bias data and gain data stored in said memory" (e.g., '334 patent, cl. 4);
- "the maximum bias voltage value" (e.g., '334 patent, cl. 4);
- "a ratio to the maximum bias voltage value" (e.g., '334 patent, cl. 4);
- "said function uses bias conditions defined in a ratio to the maximum bias voltage value" (e.g., '334 patent, cl. 4);
- "the maximum value" (e.g., '334 patent, cls. 4, 6);
- "said bias condition increases gradually to the maximum value" (e.g., '334 patent, cls. 4, 6);
- "the value taken when said cellular telephone is very far from the cell-site station" (e.g., '334 patent, cl. 4);
- "when said cellular telephone is very far from the cell-site station" (e.g., '334 patent, cl. 4);
- "output intensity increases to the value taken when said cellular telephone is very far from the cell-site station" (e.g., '334 patent, cl. 4)
- "said bias condition increases gradually to the maximum value when output intensity increases to the value taken when said cellular telephone is very far from the cell-site station" (e.g., '334 patent, cl. 4);
- "said function uses bias conditions defined in a ratio to the maximum bias voltage value and that said bias condition increases gradually to the maximum value when output intensity increases to the value taken when said cellular telephone is very far from the cell-site station" (e.g., '334 patent, cl. 4);
- "controlling a gain of said variable amplitude amplifier and a bias condition of said power amplifier using a function defining a relation between bias data and gain data

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stored in said memory, in such a manner that said function uses bias conditions defined in a ratio to the maximum bias voltage value and that said bias condition increases gradually to the maximum value when output intensity increases to the value taken when said cellular telephone is very far from the cell-site station" (e.g., '334 patent, cl. 4);

- "said bias condition increases gradually to the maximum value when said output intensity increases within the range of −50 dB to 0 dB" (e.g., '334 patent, cl. 6);
- "when said output intensity increases within the range of −50 dB to 0 dB" (e.g., '334 patent, cl. 6).

The foregoing terms, phrases, and/or limitations are not described in such a way that a person having ordinary skill in the art at the time of the alleged invention would have understood that the individuals named as the inventors on the face of the '334 patent were in possession of the claimed subject matter, at least to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions. Furthermore, to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions, the '334 patent fails to teach a person of ordinary skill in the art how to make and use the full scope of the claimed invention without undue experimentation with respect to foregoing phrases. To the extent the claims are construed or interpreted to be as broad as the positions taken in Plaintiff's Infringement Contentions, the '334 patent does not provide adequate written description or enable the full scope of the claim limitations listed above.

Furthermore, to the extent that Plaintiff is attempting to improperly broaden the scope of this claim to read on products that are not cellular telephones used in a CDMA system (for example, by reading out the preamble as non-limiting), the patent specification does not provide a written description of the claimed elements for telephones that are not used in a CDMA system or for portable devices that are not telephones that suggest that the alleged inventors were in possession of the claimed invention, and would enable a person of ordinary skill in the art to create such invention for non-CDMA telephones or for non-telephone products.

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3. ’821 patent

Asserted claim 6 of the ’821 patent fail to satisfy the requirements of 35 U.S.C. § 112 at least because the ’821 patent fails to provide an adequate written description and/or enablement of the following limitations, at least as those limitations are applied by Plaintiff in its Infringement Contentions:

- “white balance control means for detecting an achromatic portion of an image of an object on the basis of chrominance signals formed from an output signal that is obtained from an image pickup device via an optical system and indicative of said object image, controlling gains of said chrominance signals in accordance with a deviation amount of white balance detected from said achromatic portion, and controlling the white balance” (e.g., ’821 patent, cl. 6)
- “white balance control means” (e.g., ’821 patent, cl. 6)
- “white balance control means for detecting an achromatic portion of an image of an object on the basis of chrominance signals” (e.g., ’821 patent, cl. 6)
- “detecting an achromatic portion of an image of an object on the basis of chrominance signals” (e.g., ’821 patent, cl. 6)
- “chrominance signals formed from an output signal that is obtained from an image pickup device via an optical system and indicative of said object image” (e.g., ’821 patent, cl. 6)
- “an output signal that is obtained from an image pickup device via an optical system” (e.g., ’821 patent, cl. 6)
- “an optical system” (e.g., ’821 patent, cl. 6)
- “white balance control means for . . . controlling gains of said chrominance signals in accordance with a deviation amount of white balance detected from said achromatic portion” (e.g., ’821 patent, cl. 6)
- “controlling gains of said chrominance signals in accordance with a deviation amount of white balance detected from said achromatic portion” (e.g., ’821 patent, cl. 6)

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- "controlling gains of said chrominance signals" (e.g., '821 patent, cl. 6)
- "a deviation amount of white balance detected from said achromatic portion" (e.g., '821 patent, cl. 6)
- "a deviation amount of white balance" (e.g., '821 patent, cl. 6)
- "detected from said achromatic portion" (e.g., '821 patent, cl. 6)
- "white balance control means for . . . controlling the white balance" (e.g., '821 patent, cl. 6)
- "controlling the white balance" (e.g., '821 patent, cl. 6)
- "object distance detecting means for detecting a distance to the object and outputting object distance detection information" (e.g., '821 patent, cl. 6)
- "object distance detecting means" (e.g., '821 patent, cl. 6)
- "detecting a distance to the object and outputting object distance detection information" (e.g., '821 patent, cl. 6)
- "detecting a distance to the object" (e.g., '821 patent, cl. 6)
- "outputting object distance detection information" (e.g., '821 patent, cl. 6)
- "zoom value detecting means for detecting a zoom value of said optical system and outputting zoom value information" (e.g., '821 patent, cl. 6)
- "zoom value detecting means" (e.g., '821 patent, cl. 6)
- "detecting a zoom value of said optical system and outputting zoom value information" (e.g., '821 patent, cl. 6)
- "detecting a zoom value of said optical system" (e.g., '821 patent, cl. 6)
- "outputting zoom value information" (e.g., '821 patent, cl. 6)
- "executes a correcting operation of the white balance deviation" (e.g., '821 patent, cl. 6)
- "forming a white balance control amount adjustment value to adjust a white balance control amount for the gains of said white balance control means on the basis of said object brightness information, said object distance detection information which is output from said object distance detecting means, and said zoom value

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information which is output from said zoom value detecting means" (e.g., '821 patent, cl. 6)

- "forming a white balance control amount adjustment value to adjust a white balance control amount for the gains of said white balance control means" (e.g., '821 patent, cl. 6)
- "forming a white balance control amount adjustment value" (e.g., '821 patent, cl. 6)
- "adjust a white balance control amount for the gains of said white balance control means on the basis of said object brightness information" (e.g., '821 patent, cl. 6)
- "adjust a white balance control amount for the gains of said white balance control means" (e.g., '821 patent, cl. 6)
- "adjust a white balance control amount" (e.g., '821 patent, cl. 6)
- "gains of said white balance control means" (e.g., '821 patent, cl. 6)
- "the gains of said white balance control means on the basis of said object brightness information" (e.g., '821 patent, cl. 6)
- "on the basis of said object brightness information, said object distance detection information which is output from said object distance detecting means, and said zoom value information which is output from said zoom value detecting means" (e.g., '821 patent, cl. 6)
- "said object distance detection information which is output from said object distance detecting means" (e.g., '821 patent, cl. 6)
- "said zoom value information which is output from said zoom value detecting means" (e.g., '821 patent, cl. 6)
- "wherein the white balance control amount is adjusted on the basis of said white balance control amount adjustment value" (e.g., '821 patent, cl. 6)
- "on the basis of said white balance control amount adjustment value" (e.g., '821 patent, cl. 6)

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- "wherein as said white balance control amount adjustment value, an object distance threshold value for discriminating a magnitude of the distance to the object is formed on the basis of said object brightness information and said zoom value information, said object distance detection information is compared with said object distance threshold value information, thereby obtaining said white balance control amount adjustment value according to a result of the comparison" (e.g., '821 patent, cl. 6)
- "wherein as said white balance control amount adjustment value, an object distance threshold value for discriminating a magnitude of the distance to the object is formed on the basis of said object brightness information and said zoom value information" (e.g., '821 patent, cl. 6)
- "wherein as said white balance control amount adjustment value, an object distance threshold value" (e.g., '821 patent, cl. 6)
- "wherein as said white balance control amount adjustment value" (e.g., '821 patent, cl. 6)
- "an object distance threshold value for discriminating a magnitude of the distance to the object is formed on the basis of said object brightness information and said zoom value information" (e.g., '821 patent, cl. 6)
- "an object distance threshold value for discriminating a magnitude of the distance to the object" (e.g., '821 patent, cl. 6)
- "discriminating a magnitude of the distance to the object" (e.g., '821 patent, cl. 6)
- "wan object distance threshold value for discriminating a magnitude of the distance to the object is formed" (e.g., '821 patent, cl. 6)
- "is formed on the basis of said object brightness information and said zoom value information" (e.g., '821 patent, cl. 6)
- "on the basis of said object brightness information and said zoom value information" (e.g., '821 patent, cl. 6)

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- "said object distance detection information is compared with said object distance threshold value information, thereby obtaining said white balance control amount adjustment value according to a result of the comparison" (e.g., '821 patent, cl. 6)
- "said object distance detection information is compared with said object distance threshold value information" (e.g., '821 patent, cl. 6)
- "thereby obtaining said white balance control amount adjustment value according to a result of the comparison" (e.g., '821 patent, cl. 6)
- "obtaining said white balance control amount adjustment value according to a result of the comparison" (e.g., '821 patent, cl. 6)

The foregoing terms, phrases, and/or limitations are not described in such a way that a person having ordinary skill in the art at the time of the alleged invention would have understood that the individuals named as the inventors on the face of the '821 patent were in possession of the claimed subject matter, at least to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions. Furthermore, to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions, the '821 patent fails to teach a person of ordinary skill in the art how to make and use the full scope of the claimed invention without undue experimentation with respect to foregoing phrases. To the extent the claims are construed or interpreted to be as broad as the positions taken in Plaintiff's Infringement Contentions, the '821 patent does not provide adequate written description or enable the full scope of the claim limitations listed above.

4. '188 patent

Asserted claims 4, 5 and 6 of the '188 patent fail to satisfy the requirements of 35 U.S.C. § 112 at least because the '188 patent fails to provide an adequate written description and/or enablement of the following limitations, at least as those limitations are applied by Plaintiff in its Infringement Contentions:

- "a deciding process for deciding whether a thumbnail image can be changed or not based on change permission information indicating whether a change can be made on the thumbnail image showing contents of recorded information which includes

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at least image information and is recorded on a recording medium" (e.g., '188 patent, cl. 4)

- "a deciding process for deciding whether a thumbnail image can be changed or not" (e.g., '188 patent, cl. 4)
- "a deciding process for deciding" (e.g., '188 patent, cl. 4)
- "a deciding process" (e.g., '188 patent, cl. 4)
- "process" (e.g., '188 patent, cl. 4)
- "changed" (e.g., '188 patent, cl. 4)
- "based on change permission information indicating whether a change can be made on the thumbnail image showing contents of recorded information which includes at least image information and is recorded on a recording medium" (e.g., '188 patent, cl. 4)
- "change permission information indicating whether a change can be made on the thumbnail image showing contents of recorded information which includes at least image information and is recorded on a recording medium" (e.g., '188 patent, cl. 4)
- "whether a change can be made on the thumbnail image showing contents of recorded information which includes at least image information and is recorded on a recording medium" (e.g., '188 patent, cl. 4)
- "whether a change can be made on the thumbnail image" (e.g., '188 patent, cl. 4)
- "a change can be made on the thumbnail" (e.g., '188 patent, cl. 4)
- "on the thumbnail" (e.g., '188 patent, cl. 4)
- "change permission information indicating whether a change can be made on the thumbnail image" (e.g., '188 patent, cl. 4)
- "change permission information" (e.g., '188 patent, cl. 4)
- "the thumbnail image showing contents of recorded information which includes at least image information and is recorded on a recording medium" (e.g., '188 patent, cl. 4)

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- "contents of recorded information which includes at least image information and is recorded on a recording medium" (e.g., '188 patent, cl. 4)
- "contents of recorded information" (e.g., '188 patent, cl. 4)
- "recorded information" (e.g., '188 patent, cl. 4)
- "recorded information which includes at least image information and is recorded on a recording medium" (e.g., '188 patent, cl. 4)
- "a change prohibiting process for prohibiting a change of the thumbnail image when the deciding device decides that a change is not permitted" (e.g., '188 patent, cl. 4)
- "a change prohibiting process for prohibiting a change of the thumbnail image" (e.g., '188 patent, cl. 4)
- "a change prohibiting device for prohibiting" (e.g., '188 patent, cl. 4)
- "a change prohibiting device" (e.g., '188 patent, cl. 4)
- "a change of the thumbnail image when the deciding device decides that a change is not permitted" (e.g., '188 patent, cl. 4)
- "when the deciding device decides that a change is not permitted" (e.g., '188 patent, cl. 4)
- "deciding device decides" (e.g., '188 patent, cl. 4)
- "wherein editing is performed on a reproduced form of the recorded information recorded on the recording medium" (e.g., '188 patent, cl. 4)
- "editing is performed on a reproduced form of the recorded information recorded on the recording medium" (e.g., '188 patent, cl. 4)
- "editing is performed on a reproduced form of the recorded information" (e.g., '188 patent, cl. 4)
- "reproduced form of the recorded information recorded on the recording medium" (e.g., '188 patent, cl. 4)
- "recording medium" (e.g., '188 patent, cl. 4)

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- "a generating process which generates a display signal for displaying a warning indicating that the thumbnail image cannot be changed when the deciding device decides that a change is not permitted" (e.g., '188 patent, cl. 5)
- "a generating process" (e.g., '188 patent, cl. 5)
- "when the deciding device decides that a change is not permitted" (e.g., '188 patent, cl. 5)
- "when the deciding device decides" (e.g., '188 patent, cl. 5)
- "a generating process which generates a display signal for displaying a warning indicating that the thumbnail image cannot be changed w" (e.g., '188 patent, cl. 5)
- "a changing process for changing the thumbnail image when the deciding device decides, instead of the change prohibiting device, that a change is permitted" (e.g., '188 patent cl. 6)
- "a changing process for changing the thumbnail image" (e.g., '188 patent cl. 6)
- "changing the thumbnail image when the deciding device decides, instead of the change prohibiting device, that a change is permitted" (e.g., '188 patent cl. 6)
- "the change prohibiting device" (e.g., '188 patent cl. 6)
- "deciding device decides, instead of the change prohibiting device," (e.g., '188 patent, cl. 6)

The foregoing terms, phrases, and/or limitations are not described in such a way that a person having ordinary skill in the art at the time of the alleged invention would have understood that the individuals named as the inventors on the face of the '188 patent were in possession of the claimed subject matter, at least to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions. Furthermore, to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions, the '188 patent fails to teach a person of ordinary skill in the art how to make and use the full scope of the claimed invention without undue experimentation with respect to foregoing phrases. To the extent the claims are construed or interpreted to be as broad as the positions taken in Plaintiff's Infringement

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Contentions, the ’188 patent does not provide adequate written description or enable the full scope of the claim limitations listed above.

5. ’493 patent

Asserted claims 10, 12, 13, and 14 of the ’493 patent fail to satisfy the requirements of 35 U.S.C. § 112 at least because the ’493 patent fails to provide an adequate written description and/or enablement of the following limitations, at least as those limitations are applied by Plaintiff in its Infringement Contentions:

- “A method for operating an electric camera, … the method comprising: selecting between a static image mode and a moving video mode, and when in the static image mode, selecting an operation from a list…, upon selecting the operation of recording the image in the static image mode, … upon selecting the operation of monitoring the image in the static image mode …, upon selecting the operation of recording the image in the moving video mode…” (e.g., ’493 patent, cl. 10)
- “signal processing unit that generates image signals by processing the output signals of the image sensing device” (e.g., ’493 patent, cl. 10)
- “signal processing unit” (e.g., ’493 patent, cl. 10)
- “the electric camera includes … a display unit with a display screen that displays an image corresponding to the image signals” (e.g., ’493 patent, cl. 10)
- “a display unit” (e.g., ’493 patent, cl. 10)
- “a display unit with a display screen” (e.g., ’493 patent, cl. 10)
- “a display unit with a display screen that displays an image corresponding to the image signals” (e.g., ’493 patent, cl. 10)
- “selecting between a static image mode and a moving video mode” (’493 patent, cl. 10)
- “when in the static image mode, selecting an operation from a list including (1) recording the image in the static image mode, and (2) monitoring the image in the static image mode” (e.g., ’493 patent, cl. 10)

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- "when in the static image mode, selecting an operation from a list" (e.g., '493 patent, cl. 10)
- "selecting an operation from a list including (1) recording the image in the static image mode, and (2) monitoring the image in the static image mode" (e.g., '493 patent, cl. 10)
- "a list including (1) recording the image in the static image mode, and (2) monitoring the image in the static image mode" (e.g., '493 patent, cl. 10)
- "upon selecting the operation of recording the image in the static image mode, using the signal processing unit to generate the image signals by using all signal charges accumulated in all N number of vertically arranged pixel lines of the image sensing device, to provide N pixel lines" (e.g., '493 patent, cl. 10)
- "upon selecting the operation of recording the image in the static image mode" (e.g., '493 patent, cl. 10)
- "using the signal processing unit to generate the image signals by using all signal charges accumulated in all N number of vertically arranged pixel lines of the image sensing device, to provide N pixel lines" (e.g., '493 patent, cl. 10)
- "by using all signal charges accumulated in all N number of vertically arranged pixel lines of the image sensing device" (e.g., '493 patent, cl. 10)
- "all signal charges accumulated in all N number of vertically arranged pixel lines" (e.g., '493 patent, cl. 10)
- "upon selecting the operation of monitoring the image in the static image mode, using the signal processing unit to generate the image signals by using pixel lines which have been mixed or culled from the N number of vertically arranged pixel lines of the image sensing device to provide only pixel lines separated from one another by intervals of a given distance" (e.g., '493 patent, cl. 10)
- "upon selecting the operation of monitoring the image in the static image mode" (e.g., '493 patent, cl. 10)

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- "using the signal processing unit to generate the image signals by using pixel lines which have been mixed or culled from the N number of vertically arranged pixel lines of the image sensing device to provide only pixel lines separated from one another by intervals of a given distance" (e.g., '493 patent, cl. 10)
- "using pixel lines which have been mixed or culled from the N number of vertically arranged pixel lines of the image sensing device" (e.g., '493 patent, cl. 10)
- "provide only pixel lines separated from one another by intervals of a given distance" (e.g., '493 patent, cl. 10)
- "upon selecting the operation of recording the image in the moving video mode, using the signal processing unit to generate the image signals by using a portion of, or the entirety of, the N number of vertically arranged pixel lines which have been mixed or culled to provide only pixel lines separated from one another by intervals of a second distance, wherein a value of the second distance is different from a value of the first distance" (e.g., '493 patent, cl. 10)
- "upon selecting the operation of recording the image in the moving video mode" (e.g., '493 patent, cl. 10)
- "using the signal processing unit to generate the image signals by using a portion of, or the entirety of, the N number of vertically arranged pixel lines which have been mixed or culled to provide only pixel lines separated from one another by intervals of a second distance" (e.g., '493 patent, cl. 10)
- "using a portion of, or the entirety of, the N number of vertically arranged pixel lines" (e.g., '493 patent, cl. 10)
- "the N number of vertically arranged pixel lines which have been mixed or culled" (e.g., '493 patent, cl. 10)
- "provide only pixel lines separated from one another by intervals of a second distance" (e.g., '493 patent, cl. 10)
- "wherein a value of the second distance is different from a value of the first distance" (e.g., '493 patent, cl. 10)

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- "wherein the value of the first distance is larger than the value of the second distance" (e.g., '493 patent, cl. 12)
- "wherein N is equal to or greater than a product of a fixed parameter multiplied by a number of effective scanning lines M of the display screen" (e.g., '493 patent, cl. 13)
- "fixed parameter" (e.g., '493 patent, cl. 13)

The foregoing terms, phrases, and/or limitations are not described in such a way that a person having ordinary skill in the art at the time of the alleged invention would have understood that the individuals named as the inventors on the face of the '493 patent were in possession of the claimed subject matter, at least to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions. Furthermore, to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions, the '493 patent fails to teach a person of ordinary skill in the art how to make and use the full scope of the claimed invention without undue experimentation with respect to foregoing phrases. To the extent the claims are construed or interpreted to be as broad as the positions taken in Plaintiff's Infringement Contentions, the '493 patent does not provide adequate written description or enable the full scope of the claim limitations listed above.

6. '729 patent

Asserted claims 3 and 4 of the '729 patent fail to satisfy the requirements of 35 U.S.C. § 112 at least because the '729 patent fails to provide an adequate written description and/or enablement of the following limitations, at least as those limitations are applied by Plaintiff in its Infringement Contentions:

- "A method for operating a camera … comprising the steps of: selecting between a static image mode and a moving video mode; and selecting an operation from a list of operations, as follows: when in the static image mode, selecting an operation from a list of operations including: a monitoring of an image in the static image mode, and a recording of an image in the static image mode, and when in the

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moving video mode, selecting an operation from a list of operations including: a recording of an image in the moving video mode" (e.g., '729 patent, cl. 3)

- "the camera including … signal processing unit configured to form image signals at a predetermined view angle by using effective pixels of the image sensing device" (e.g., '729 patent, cl. 3)
- "signal processing unit configured to form image signals at a predetermined view angle by using effective pixels of the image sensing device" (e.g., '729 patent, cl. 3)
- "signal processing unit" (e.g., '729 patent, cl. 3)
- "a predetermined view angle" (e.g., '729 patent, cl. 3)
- "using effective pixels of the image sensing device" (e.g., '729 patent, cl. 3)
- "the camera including…a display unit configured to display an image corresponding to the image signals formed by the signal processing unit" (e.g., '729 patent, cl. 3)
- "display unit configured to display an image corresponding to the image signals formed by the signal processing unit" (e.g., '729 patent, cl. 3)
- "display unit" (e.g., '729 patent, cl. 3)
- "the camera including … an image-instability detector configured to detect an amount of image-instability of the camera" (e.g., '729 patent, cl. 3)
- "an image-instability detector configured to detect an amount of image-instability of the camera" (e.g., '729 patent, cl. 3)
- "image-instability detector" (e.g., '729 patent, cl. 3)
- "an amount of image-instability of the camera" (e.g., '729 patent, cl. 3)
- "selecting between a static image mode and a moving video mode" (e.g., '729 patent, cl. 3)
- "selecting an operation from a list of operations, as follows: when in the static image mode, selecting an operation from a list of operations including: a monitoring of an image in the static image mode, and a recording of an image in the static

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image mode, and when in the moving video mode, selecting an operation from a list of operations including: a recording of an image in the moving video mode" (e.g., '729 patent, cl. 3)

- "selecting an operation from a list of operations, as follows:" (e.g., '729 patent, cl. 3)
- "when in the static image mode, selecting an operation from a list of operations including: a monitoring of an image in the static image mode, and a recording of an image in the static image mode" (e.g., '729 patent, cl. 3)
- "when in the static image mode, selecting an operation from a list of operations" (e.g., '729 patent, cl. 3)
- "when in the moving video mode, selecting an operation from a list of operations including: a recording of an image in the moving video mode" (e.g., '729 patent, cl. 3)
- "when in the moving video mode, selecting an operation from a list of operations" (e.g., '729 patent, cl. 3)
- "wherein when the selected operation is the monitoring of an image in the static image mode, the signal processing unit forms image signals with a first view angle, by using a first effective set of pixels of the image sensing device" (e.g., '729 patent, cl. 3)
- "when the selected operation is the monitoring of an image in the static image mode" (e.g., '729 patent, cl. 3)
- "the signal processing unit forms image signals with a first view angle, by using a first effective set of pixels of the image sensing device" (e.g., '729 patent, cl. 3)
- "the signal processing unit forms image signals with a first view angle" (e.g., '729 patent, cl. 3)
- "form image signals with a first view angle, by using a first effective set of pixels of the image sensing device" (e.g., '729 patent, cl. 3)

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- "using a first effective set of pixels of the image sensing device" (e.g., '729 patent, cl. 3)
- "wherein when the selected operation is the recording of an image in the static image mode, the signal processing unit forms image signals by using all effective pixels of the image sensing device" (e.g., '729 patent, cl. 3)
- "when the selected operation is the recording of an image in the static image mode" (e.g., '729 patent, cl. 3)
- "the signal processing unit forms image signals by using all effective pixels of the image sensing device" (e.g., '729 patent, cl. 3)
- "all effective pixels of the image sensing device" (e.g., '729 patent, cl. 3)
- "wherein when the selected operation is the recording of an image in the moving video mode, the signal processing unit forms image signals with a second view angle, different from the first view angle, by using a second effective set of pixels which is a portion of the array of pixels of the image sensing device, a position of the second effective set of pixels being changed according to the amount of image-instability detected by the image-instability detector, in order to correct the image-instability" (e.g., '729 patent, cl. 3)
- "when the selected operation is the recording of an image in the moving video mode" (e.g., '729 patent, cl. 3)
- "the signal processing unit forms image signals with a second view angle, different from the first view angle, by using a second effective set of pixels which is a portion of the array of pixels of the image sensing device" (e.g., '729 patent, cl. 3)
- "a second effective set of pixels which is a portion of the array of pixels of the image sensing device" (e.g., '729 patent, cl. 3)
- "a position of the second effective set of pixels being changed according to the amount of image-instability detected by the image-instability detector, in order to correct the image-instability" (e.g., '729 patent, cl. 3)

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- "a position of the second effective set of pixels being changed according to the amount of image-instability detected by the image-instability detector" (e.g., '729 patent, cl. 3)
- "a position of the second effective set of pixels being changed" (e.g., '729 patent, cl. 3)
- "changed according to the amount of image-instability detected by the image-instability detector" (e.g., '729 patent, cl. 3)
- "wherein the first view angle is larger than the second view angle" (e.g., '729 patent, cl. 4)

The foregoing terms, phrases, and/or limitations are not described in such a way that a person having ordinary skill in the art at the time of the alleged invention would have understood that the individuals named as the inventors on the face of the '729 patent were in possession of the claimed subject matter, at least to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions. Furthermore, to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions, the '729 patent fails to teach a person of ordinary skill in the art how to make and use the full scope of the claimed invention without undue experimentation with respect to foregoing phrases. To the extent the claims are construed or interpreted to be as broad as the positions taken in Plaintiff's Infringement Contentions, the '729 patent does not provide adequate written description or enable the full scope of the claim limitations listed above.

7. '449 patent

Asserted claims 9, 10, 11, and 12 of the '449 patent fail to satisfy the requirements of 35 U.S.C. § 112 at least because the '449 patent fails to provide an adequate written description and/or enablement of the following limitations, at least as those limitations are applied by Plaintiff in its Infringement Contentions:

- "outputting, by an output unit, a menu display for a user to select one group of video information among a plurality of groups of video information by specifying a

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position of a character corresponding to the one group of video information" (e.g., '449 patent, cls. 9)

- "outputting, by an output unit, a menu display for a user to select one group of video information among a plurality of groups of video information" (e.g., '449 patent, cls. 9)
- "select one group of video information among a plurality of groups of video information" (e.g., '449 patent, cls. 9)
- "select one group of video information among a plurality of groups of video information by specifying a position of a character corresponding to the one group of video information" (e.g., '449 patent, cls. 9)
- "controlling, by a controller, the output unit to display a first group of thumbnails corresponding to the first group of video information, when a first group of video information is selected in the menu display by specifying a position of a character corresponding to the first group of video information" (e.g., '449 patent, cls. 9)
- "controlling, by a controller, the output unit to display a first group of thumbnails corresponding to the first group of video information" (e.g., '449 patent, cls. 9)
- "controlling, by a controller, the output unit to display a first group of thumbnails … by specifying a position of a character corresponding to the first group of video information" (e.g., '449 patent, cls. 9)
- "controlling, by a controller, the output unit to display a second group of thumbnails corresponding to the second group of video information, when a second group of video information is selected in the menu display by specifying a position of a character corresponding to the second group of video information" (e.g., '449 patent, cls. 9)
- "controlling, by a controller, the output unit to display a second group of thumbnails corresponding to the second group of video information" (e.g., '449 patent, cls. 9)

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- "controlling, by a controller, the output unit to display a second group of thumbnails … by specifying a position of a character corresponding to the second group of video information" (e.g., '449 patent, cls. 9)
- "video information" (e.g., '449 patent, cls. 9, 10, and 12)
- "specifying a position of a character corresponding to the [one/first/second] group of video information" (e.g., '449 patent, cls. 9)
- "specifying a position of a character" (e.g., '449 patent, cls. 9)
- "when one video information recorded on the recording medium that is included in both the first group of video information and the second group of video information is deleted from the first group of video information, the controller continues to include the one video information in the second group of video information, and a thumbnail corresponding to the one video information is displayed as one of the thumbnails of the second group of thumbnails when the controller controls the output unit to display the second group of thumbnails" (e.g., '449 patent, cls. 9)
- "when one video information recorded on the recording medium that is included in both the first group of video information and the second group of video information is deleted from the first group of video information" (e.g., '449 patent, cls. 9)
- "the controller continues to include the one video information in the second group of video information" (e.g., '449 patent, cls. 9)
- "a thumbnail corresponding to the one video information is displayed as one of the thumbnails of the second group of thumbnails when the controller controls the output unit to display the second group of thumbnails" (e.g., '449 patent, cls. 9)
- "removes the one video information from the first group of video information" (e.g., '449 patent, cls. 12)

The foregoing terms, phrases, and/or limitations are not described in such a way that a person having ordinary skill in the art at the time of the alleged invention would have understood that the individuals named as the inventors on the face of the '449 patent were in possession of the claimed subject matter, at least to the extent the claims are interpreted consistently with the positions taken

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in Plaintiff's Infringement Contentions. Furthermore, to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions, the '449 patent fails to teach a person of ordinary skill in the art how to make and use the full scope of the claimed invention without undue experimentation with respect to foregoing phrases. To the extent the claims are construed or interpreted to be as broad as the positions taken in Plaintiff's Infringement Contentions, the '449 patent does not provide adequate written description or enable the full scope of the claim limitations listed above.

8. '072 patent

Asserted claims 11, 12, 13, 14, and 15 of the '072 patent fail to satisfy the requirements of 35 U.S.C. § 112 at least because the '072 patent fails to provide an adequate written description and/or enablement of the following limitations, at least as those limitations are applied by Plaintiff in its Infringement Contentions:

- "outputting a menu display for a user to select one group of video data among a plurality of groups of video data by specifying a position of a character corresponding to the one group of video data" (e.g., '072 patent, cls. 11)
- "outputting a menu display for a user to select one group of video data among a plurality of groups of video data" (e.g., '072 patent, cls. 11)
- "outputting a menu display for a user to select one group of video data" (e.g., '072 patent, cls. 11)
- "to select one group of video data among a plurality of groups of video data by specifying a position of a character corresponding to the one group of video data" (e.g., '072 patent, cls. 11)
- "to select one group of video data among a plurality of groups of video data" (e.g., '072 patent, cls. 11)
- "controlling display, when a first group of video data is selected in the menu display by specifying a position of a character corresponding to the first group of video data, a first group of thumbnails corresponding to the first group of video data in a

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state that the order of the first group of thumbnails is editable" (e.g., '072 patent, cls. 11)

- "controlling display, when a first group of video data is selected in the menu display by specifying a position of a character corresponding to the first group of video data" (e.g., '072 patent, cls. 11)
- "a first group of thumbnails corresponding to the first group of video data in a state that the order of the first group of thumbnails is editable" (e.g., '072 patent, cls. 11)
- "controlling to display, when a second group of video data is selected in the menu display by specifying a position of a character corresponding to the second group of video data, a second group of thumbnails corresponding to the second group of video data in a state that the order of the second group of thumbnails is editable" (e.g., '072 patent, cls. 11)
- "controlling to display, when a second group of video data is selected in the menu display by specifying a position of a character corresponding to the second group of video data" (e.g., '072 patent, cls. 11)
- "a second group of thumbnails corresponding to the second group of video data in a state that the order of the second group of thumbnails is editable" (e.g., '072 patent, cls. 11)
- "specifying a position of a character corresponding to the [one/first/second] group of video data" (e.g., '072 patent, cls. 11)
- "when one video data recorded on the recording medium that is included in both the first group of video data and the second group of video data is deleted from the first group of video data, the controller continues to include the one video data in the second group of video data, and a thumbnail corresponding to the one video data is displayed as one of the thumbnails of the second group of thumbnails when the controller controls to display the second group of thumbnails" (e.g., '072 patent, cls. 11)

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- "when one video data recorded on the recording medium that is included in both the first group of video data and the second group of video data is deleted from the first group of video data" (e.g., '072 patent, cls. 11)
- "the controller continues to include the one video data in the second group of video data" (e.g., '072 patent, cls. 11)
- "a thumbnail corresponding to the one video data is displayed as one of the thumbnails of the second group of thumbnails when the controller controls to display the second group of thumbnails" (e.g., '072 patent, cls. 11)
- "video data" (e.g., '072 patent, cls. 11-13, 15)
- "encoding inputted video data with an encoder" (e.g., '072 patent, cls. 12)
- "encoding" / "encoder" / "encoded" (e.g., '072 patent, cls. 12)
- "removes the one video data from the first group of video data" (e.g., '072 patent, cls. 15)

The foregoing terms, phrases, and/or limitations are not described in such a way that a person having ordinary skill in the art at the time of the alleged invention would have understood that the individuals named as the inventors on the face of the '072 patent were in possession of the claimed subject matter, at least to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions. Furthermore, to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions, the '072 patent fails to teach a person of ordinary skill in the art how to make and use the full scope of the claimed invention without undue experimentation with respect to foregoing phrases. To the extent the claims are construed or interpreted to be as broad as the positions taken in Plaintiff's Infringement Contentions, the '072 patent does not provide adequate written description or enable the full scope of the claim limitations listed above.

9. '284 patent

Asserted claims 18, 19, and 20 of the '284 patent fail to satisfy the requirements of 35 U.S.C. § 112 at least because the '284 patent fails to provide an adequate written description and/or

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enablement of the following limitations, at least as those limitations are applied by Plaintiff in its Infringement Contentions:

- "connecting, via a second radio communication circuit, to an internet or a home network" (*e.g.*, '284 pat. at cl. 18);
- "connecting" (*e.g.*, '284 pat. at cl. 18);
- "receiving digital information" (*e.g.*, '284 pat. at cl. 18);
- "controlling each of the first and second radio communication circuits such that the first radio communication circuit transmits digital video information to the external apparatus and the second radio communication circuit connects to the internet or the home network simultaneously" (*e.g.*, '284 pat. at cl. 18);
- "controlling each of the first and second radio communication circuits" (*e.g.*, '284 pat. at cl. 18);
- "controlling" (*e.g.*, '284 pat. at cl. 18);
- "the second radio communication circuit connects to the internet or the home network simultaneously" (*e.g.*, '284 pat. at cl. 18);
- "connects to the internet or the home network" (*e.g.*, '284 pat. at cl. 18);
- "connects to the internet or the home network simultaneously" (*e.g.*, '284 pat. at cl. 18);
- "controlling assignment between the first radio communication circuit and the external apparatus, and assignment between the second radio communication circuit and the internet or the home network" (*e.g.*, '284 pat. at cl. 18);
- "controlling assignment" (*e.g.*, '284 pat. at cl. 18);
- "assignment between the first radio communication circuit and the external apparatus" (*e.g.*, '284 pat. at cl. 18);
- "assignment between the second radio communication circuit and the internet or the home network" (*e.g.*, '284 pat. at cl. 18);
- "assignment" (*e.g.*, '284 pat. at cl. 18);

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- "controlling the assignment such that the assignment between the first radio communication circuit and the external apparatus is prioritized more than the assignment between the second radio communication circuit and the internet or the home network when a user issues an indication to transmit digital video information by the first radio communication circuit while acquiring information from the internet or the home network by the second radio communication circuit" (*e.g.*, '284 pat. at cl. 18);
- "controlling the assignment" (*e.g.*, '284 pat. at cl. 18);
- "is prioritized more than" (*e.g.*, '284 pat. at cl. 18);
- "is prioritized" (*e.g.*, '284 pat. at cl. 18);
- "prioritized more than" (*e.g.*, '284 pat. at cl. 18);
- "prioritized" (*e.g.*, '284 pat. at cl. 18); and
- "when a user issues an indication to transmit digital video information by the first radio communication circuit while acquiring information from the internet or the home network by the second radio communication circuit" (e.g., '284 pat. at cl. 18).

The foregoing terms, phrases, and/or limitations are not described in such a way that a person having ordinary skill in the art at the time of the alleged invention would have understood that the individuals named as the inventors on the face of the '284 patent were in possession of the claimed subject matter, at least to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions. Furthermore, to the extent the claims are interpreted consistently with the positions taken in Plaintiff's Infringement Contentions, the '284 patent fails to teach a person of ordinary skill in the art how to make and use the full scope of the claimed invention without undue experimentation with respect to foregoing phrases. To the extent the claims are construed or interpreted to be as broad as the positions taken in Plaintiff's Infringement Contentions, the '284 patent does not provide adequate written description or enable the full scope of the claim limitations listed above.

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B. The Asserted Claims Are Invalid because the Asserted Claims do not Particularly Point Out and Distinctly Claim the Subject Matter which the Inventor Regards as the Invention

One or more terms of the Asserted Claims may suffer from defects that render them indefinite, as those claims are applied by Plaintiff in its Infringement Contentions. Under § 112, ¶ 2, "a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). A separate and additional requirement of § 112, ¶ 2 requires the claims of the patent cover "the subject matter which the inventor or joint inventor regards as his invention." *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1377 (Fed. Cir. 2000).

Based on the information currently available, the Asserted Claims fail to inform those skilled in the art about the scope of the invention with reasonable certainty under § 112, ¶ 2, due to, at least, the following phrases. A more detailed basis for Defendants' indefiniteness defenses may be set forth in any expert report(s) on invalidity to be served in accordance with the Court's Scheduling Order and/or at an appropriate later stage of this lawsuit, such as claim construction. To the extent that Defendants has identified any instance of a term or limitation in a particular claim as rendering the claim invalid as indefinite, Defendants contend that every instance of the challenged term or limitation in each Asserted Claim renders the claim invalid for the same reason.

1. '760 patent

One or more Asserted Claims, and/or terms of the Asserted Claims, of the '760 patent may suffer from defects that render them indefinite, at least under interpretations and/or applications of the claim language that Plaintiff appears to be asserting, including, for example:

- "first still picture corresponding to a selected picture" (e.g., '760 patent, cls. 4, 7) because the limitation's outer boundaries are unclear; and
- "selected picture" (e.g., '760 patent, cls. 4, 7) because the limitation's outer boundaries are unclear.

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2. '334 patent

One or more Asserted Claims, and/or terms of the Asserted Claims, of the '334 patent may suffer from defects that render them indefinite, at least under interpretations and/or applications of the claim language that Plaintiff appears to be asserting, including, for example:

- "a power control signal derived from said transmitting power control signal" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "said first communication signal received from a cell-site station" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "voice signal code" and "voice code signal" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of these terms;
- "said cellular telephone" (e.g., '334 patent, cl. 4) if the preamble is not limiting because, in that case, this term would lack antecedent basis;
- "said transmitter" (e.g., '334 patent, cl. 4) if the preamble is not limiting because, in that case, this term would lack antecedent basis;
- "an open-loop power control is performed" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "a closed-loop power control is performed" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "controlling said transmitter in such a manner that an open-loop power control is performed at first and then a closed-loop power control is performed according to said power control signal" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "converge into a range" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;

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- "so as to control transmitted power to converge into a range required by said cell-site station" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "controlling said transmitter in such a manner that an open-loop power control is performed at first and then a closed-loop power control is performed according to said power control signal so as to control transmitted power to converge into a range required by said cell-site station" because a POSITA would not have understood the scope and meaning of this term;
- "said variable amplitude amplifier" (e.g., '334 patent, cl. 4) if the preamble is not limiting because, in that case, this term would lack antecedent basis;
- "said power amplifier" (e.g., '334 patent, cl. 4) if the preamble is not limiting because, in that case, this term would lack antecedent basis;
- "a function defining a relation between bias data and gain data" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "said memory" (e.g., '334 patent, cl. 4) because this term lacks antecedent basis;
- "a function defining a relation between bias data and gain data stored in said memory" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "controlling a gain of said variable amplitude amplifier and a bias condition of said power amplifier using a function defining a relation between bias data and gain data stored in said memory" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "bias conditions defined in a ratio" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "the maximum bias voltage value" (e.g., '334 patent, cl. 4) because this term lacks antecedent basis and a POSITA would not have understood the scope and meaning of this term;

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- "a ratio to the maximum bias voltage value" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "bias conditions defined in a ratio to the maximum bias voltage value" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "said function uses bias conditions defined in a ratio to the maximum bias voltage value" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "said bias condition" (e.g., '334 patent, cls. 4, 6) because a POSITA would not have understood which of the prior claimed "bias condition[s]" this term refers to;
- "gradually" (e.g., '334 patent, cls. 4, 6) because a POSITA would not have understood the scope and meaning of this term;
- "said bias condition increases gradually" (e.g., '334 patent, cls. 4, 6) because a POSITA would not have understood the scope and meaning of this term;
- "the maximum value" (e.g., '334 patent, cls. 4, 6) because this term lacks antecedent basis and a POSITA would not have understood the scope and meaning of this term;
- "increases gradually to the maximum value" (e.g., '334 patent, cls. 4, 6) because a POSITA would not have understood the scope and meaning of this term;
- "said bias condition increases gradually to the maximum value" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "the value" (e.g., '334 patent, cl. 4) because this term lacks antecedent basis and a POSITA would not have understood the scope and meaning of this term;
- "very far" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;

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- "said cellular telephone is very far from the cell-site station" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "the cell-site station" (e.g., '334 patent, cl. 4) because a POSITA would not have understood which of the prior claimed "cell-site station[s]" this term refers to;
- "the value taken when said cellular telephone is very far from the cell-site station" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "output intensity increases to the value taken when said cellular telephone is very far from the cell-site station" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "said bias condition increases gradually to the maximum value when output intensity increases to the value taken when said cellular telephone is very from the cell-site station" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "in such a manner that said function uses bias conditions defined in a ratio to the maximum bias voltage value and that said bias condition increases gradually to the maximum value when output intensity increases to the value taken when said cellular telephone is very far from the cell-site station" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;
- "controlling a gain of said variable amplitude amplifier and a bias condition of said power amplifier using a function defining a relation between bias data and gain data stored in said memory, in such a manner that said function uses bias conditions defined in a ratio to the maximum bias voltage value and that said bias condition increases gradually to the maximum value when output intensity increases to the value taken when said cellular telephone is very far from the cell-site station" (e.g., '334 patent, cl. 4) because a POSITA would not have understood the scope and meaning of this term;

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- "when said output intensity increases within the range of -50 dB to 0 dB" (e.g., '334 patent, cl. 6) because a POSITA would not have understood the scope and meaning of this term;
- "said bias condition increases gradually to the maximum value when said output intensity increases within the range of -50 dB to 0 dB" (e.g., '334 patent, cl. 6) because a POSITA would not have understood the scope and meaning of this term.

Claims 4 and 6 also fail the additional requirement of § 112, ¶ 2 requiring the claims cover "the subject matter which the inventor or joint inventor regards as his invention." These claims recite various conventional limitations which are described in the Background of the Invention of the '334 Patent. *Compare* '334 Patent, cls. 4, 6, *with id.*, cols. 1:6-2:18. Further, the specification does not tie such conventional technologies to the alleged invention claimed in these claims, especially the limitation reciting "controlling a gain of said variable amplitude amplifier and a bias condition of said power amplifier using a function defining a relation between bias data and gain data stored in said memory, in such a manner that said function uses bias conditions defined in a ratio to the maximum bias voltage value and that said bias condition increases gradually to the maximum value when output intensity increases to the value taken when said cellular telephone is very far from the cell-site station." *Compare id.*, cls. 4, 6, *with id.*, cols. 2:20-10:67.

3. '821 patent

One or more Asserted Claims, and/or terms of the Asserted Claims, of the '821 patent may suffer from defects that render them indefinite, at least under interpretations and/or applications of the claim language that Plaintiff appears to be asserting, including, for example:

- "white balance control means for detecting an achromatic portion of an image of an object on the basis of chrominance signals formed from an output signal that is obtained from an image pickup device via an optical system and indicative of said object image, controlling gains of said chrominance signals in accordance with a deviation amount of white balance detected from said achromatic portion, and controlling the white balance" (e.g., '821 patent, cl. 6) because the specification fails to disclose adequate structure for this means-plus-function term;

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- "controlling gains of said chrominance signals in accordance with a deviation amount of white balance detected from said achromatic portion, and controlling the white balance" (e.g., '821 patent, cl. 6) because a POSITA would not have been able to understand the scope and meaning of this term;
- "controlling the white balance" (e.g., '821 patent, cl. 6) because a POSITA would not have been able to understand the scope and meaning of this term;
- "object distance detecting means for detecting a distance to the object and outputting object distance detection information" (e.g., '821 patent, cl. 6) because the specification fails to disclose adequate structure for this means-plus-function term and because a POSITA would not have been able to understand the scope and meaning of this term;
- "zoom value detecting means for detecting a zoom value of said optical system and outputting zoom value information" (e.g., '821 patent, cl. 6) because the specification fails to disclose adequate structure for this means-plus-function term;
- "executes a correcting operation of the white balance deviation, comprising the steps of" (e.g., '821 patent, cl. 6) because a POSITA would not have been able to understand the scope and meaning of this term;
- "forming a white balance control amount adjustment value to adjust a white balance control amount for the gains of said white balance control means" (e.g., '821 patent, cl. 6) because a POSITA would not have been able to understand the scope and meaning of this term;
- "wherein as said white balance control amount adjustment value, an object distance threshold value for discriminating a magnitude of the distance to the object is formed on the basis of said object brightness information and said zoom value information, said object distance detection information is compared with said object distance threshold value information, thereby obtaining said white balance control amount adjustment value according to a result of the comparison" (e.g.,

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’821 patent, cl. 6) because a POSITA would not have been able to understand the scope and meaning of this term;

- “wherein as said white balance control amount adjustment value, an object distance threshold value for discriminating a magnitude of the distance to the object is formed on the basis of said object brightness information and said zoom value information” (e.g., ’821 patent, cl. 6) because a POSITA would not have been able to understand the scope and meaning of this term;
- “said object distance detection information is compared with said object distance threshold value information, thereby obtaining said white balance control amount adjustment value according to a result of the comparison” (e.g., ’821 patent, cl. 6) because a POSITA would not have been able to understand the scope and meaning of this term.

4. ’188 patent

One or more Asserted Claims, and/or terms of the Asserted Claims, of the ’188 patent may suffer from defects that render them indefinite, at least under interpretations and/or applications of the claim language that Plaintiff appears to be asserting, including, for example:

- “the change prohibiting device” / “the deciding device” (e.g., ’188 patent, cls. 4-6) because this term lacks antecedent basis.

5. ’493 patent

One or more Asserted Claims, and/or terms of the Asserted Claims, of the ’493 patent may suffer from defects that render them indefinite, at least under interpretations and/or applications of the claim language that Plaintiff appears to be asserting, including, for example:

- “wherein the electric camera includes the features of an image sensing device … , a signal processing unit … , and a display unit” (e.g., ’493 patent, cl. 10) because the limitation’s outer boundaries are unclear

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6. '449 patent

One or more Asserted Claims, and/or terms of the Asserted Claims, of the '449 patent may suffer from defects that render them indefinite, at least under interpretations and/or applications of the claim language that Plaintiff appears to be asserting, including, for example:

- "the [first/second] group of video information" (e.g., '449 patent, cl. 9) because this term lacks antecedent basis.
- Claims 9-12 fail the additional requirement of § 112, ¶ 2 requiring the claims cover "the subject matter which the inventor or joint inventor regards as his invention." As explained above, '449 Patent (and '072 Patent) describe a "management" scheme with hierarchical levels, and provides a summary of a "management state of AV data on a recording medium" in Figure 1. In its response to LG's motion for judgment on the pleadings, Maxell contends that this management scheme reflects the alleged invention. D.I. 105 at 7. But as LG explained in its reply, the management scheme is not reflected in the claims. D.I. 113 at 2. LG incorporates by reference its motion for judgment on the pleadings and reply in support (D.I. 94, 113) herein.

7. '072 patent

One or more Asserted Claims, and/or terms of the Asserted Claims, of the '072 patent may suffer from defects that render them indefinite, at least under interpretations and/or applications of the claim language that Plaintiff appears to be asserting, including, for example:

- Claims 11-15 fail the additional requirement of § 112, ¶ 2 requiring the claims cover "the subject matter which the inventor or joint inventor regards as his invention." As explained above, '072 Patent (and '449 Patent) describe a "management" scheme with hierarchical levels, and provides a summary of a "management state of AV data on a recording medium" in Figure 1. In its response to LG's motion for judgment on the pleadings, Maxell contends that this management scheme reflects the alleged invention. D.I. 105 at 7. But as LG explained in its reply, the management scheme is not reflected in the claims. D.I. 113 at 2. LG incorporates

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by reference its motion for judgment on the pleadings and reply in support (D.I. 94, 113) herein.

8. '284 patent

One or more Asserted Claims, and/or terms of the Asserted Claims, of the '284 patent may suffer from defects that render them indefinite, at least under interpretations and/or applications of the claim language that Plaintiff appears to be asserting, including, for example:

- "connecting, via a second radio communication circuit, to an internet or a home network" (*e.g.*, '284 pat. at cl. 18) because the limitation's outer boundaries are unclear;
- "internet or a home network" (*e.g.*, '284 pat. at cl. 18) because the limitation's outer boundaries are unclear;
- "receiving digital information" (*e.g.*, '284 pat. at cl. 18) because the limitation's outer boundaries are unclear;
- "controlling the assignment such that the assignment between the first radio communication circuit and the external apparatus is prioritized more than the assignment between the second radio communication circuit and the internet or the home network when a user issues an indication to transmit digital video information by the first radio communication circuit while acquiring information from the internet or the home network by the second radio communication circuit." (*e.g.*, '284 pat. at cl. 18) because the limitation's outer boundaries are unclear;
- "while acquiring information from the internet or the home network" (*e.g.*, '284 pat. at cl. 18) because the limitation's outer boundaries are unclear;
- "internet or the home network" (*e.g.*, '284 pat. at cl. 18) because the limitation's outer boundaries are unclear; and
- "when a user issues an indication to transmit digital video information by the first radio communication circuit while acquiring information from the internet or the home network by the second radio communication circuit" (*e.g.*, '284 pat. at cl. 18) because the limitation's outer boundaries are unclear.

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IV. Contentions Under 35 U.S.C. § 101

To be patentable subject matter under § 101, a claim must be directed to one of four eligible subject matter categories: "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. "Claims that fall within one of the four subject matter categories may nevertheless be ineligible if they encompass laws of nature, physical phenomena, or abstract ideas." *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1350 (Fed. Cir. 2014) (citing *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980)). The Supreme Court established a two-step test for deciding the subject matter eligibility of claims under § 101. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014). First, the claims must be analyzed to determine whether they are drawn to one of the statutory exceptions, *i.e.*, a patent ineligible concept: an abstract idea, a law of nature, or a natural phenomenon. *See id.* Second, the elements of the claims must be viewed both individually and as an ordered combination to see if there is an "inventive concept." *Id.*; *see also Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335-36 (Fed. Cir. 2016). The claims are examined to determine if they merely invoke well-understood, routine, conventional components and activity to apply an abstract idea. *See, e.g.*, *Elec. Comm'n Techs. v. ShoppersChoice.com*, 958 F.3d 1179, 1180-82 (Fed. Cir. 2020).

Based on the information currently available, the asserted claims of the '188, '072, '449, and '760 Patents fail to claim patent-eligible subject matter under § 101 as explained in Defendants' Motion for Judgment on the Pleading (D.I. 94, 113), which are incorporated herein by reference. In addition the following patent also fail to recite patent-eligible subject matter for at least, the following reasons:

1. '334 patent

At least the asserted claims of the '334 Patent are invalid under 35 U.S.C. § 101 for failure to recite patent eligible subject matter. Specifically, the asserted claims of the '334 Patent are fatally abstract under the U.S. Supreme Court's decision in *Alice*.

Asserted claim 4 is representative of the asserted claims of the '334 Patent because dependent claim 6 does not modify the underlying abstract idea in claim 4. Dependent claim 6 merely provides a specific range for the "output intensity" claimed in claim 4. '334 Patent, cl. 6.

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This difference between the claims offers no "distinctive significance of any claim limitations other than those included" in claim 4 and lacks any inventive contribution. *See Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253 at 1256 n.1 (Fed. Cir. 2016) (quotation omitted); *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324 n.6 (Fed. Cir. 2016).

***Alice*, Step 1:** Claims 4 and 6 of the '334 Patent are generally directed to the abstract idea of a "function" defining a relation between bias data and gain data, which is used to calculate and control gain and bias conditions of amplifiers in a transmitter of a cellular telephone used in a CDMA system. '334 Patent, cls. 4, 6. Claims directed to such mathematical formulas or relationships have long been held to involve abstract ideas, including mental processes. *See, e.g.*, *In re Killian*, 45 F.4th 1373, 1379 (Fed. Cir. 2022); *RecogniCorp, LLC v. Nintendo Co., Ltd.*, 855 F.3d 1322, 1326-28 (Fed. Cir. 2017); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353-54 (Fed. Cir. 2016); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371-73 (Fed. Cir. 2011); *Parker v. Flook*, 437 U.S. 584, 585-86 (1978).

***Alice*, Step 2:** Because claim 4 of the '334 Patent is directed to the abstract idea of using a function to calculate and control gain and bias conditions, the claims must add an "inventive concept" that ensures the patent amounts to significantly more than a patent on the ineligible idea itself. *Alice*, 573 U.S. at 222. The '334 Patent claims fail here because they add nothing more than conventional activities performed using conventional power control technology, as explained by the specification and prior art discussed in the patent itself, as well as the prior art identified in these contentions. The claims merely recite conventional "receiving," "generating," "converting," and "controlling" steps using conventional, generic cellular telephone technology, such as a "cellular telephone," a "transmitter" with "amplifier[s]," a "cell-site station" in a CDMA system, an "acoustic transducer," and various "signals." *E.g.*, '334 Patent, cl. 4. Similarly, claim 6 merely recites a conventional range of output intensity. The written description or figures of the '334 patent merely recite generic components and concepts, and nothing in the specification raises the concepts disclosed within to anything inventive, let alone non-abstract. *Broadband iTV, Inc. v. Amazon.com, Inc.*, 113 F.4th 1359, 1370 (Fed. Cir. 2024) ("When the patent's specification

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describes the components and features listed in the claims generically, it supports the conclusion that these components and features are conventional.") (internal quotations omitted).

Nor can Maxell save the claims by arguing that the ordered combination of these conventional elements elevates the claims to patent-eligible status. *See Alice*, 573 U.S. at 217. Indeed, the elements of the claims recite abstract ideas to be performed on generic cellular components and thus "do not contain an inventive concept." *Two-Way Media*, 874 F.3d at 1339.

2. '821 patent

At least asserted claim 6 of the '821 Patent is invalid under 35 U.S.C. § 101 for failure to recite patent eligible subject matter. Specifically, the asserted claim of the '821 Patent is fatally abstract under the U.S. Supreme Court's decision in *Alice*.

***Alice*, Step 1:** Claim 6 of the '821 Patent is generally directed to the abstract idea of collecting information and forming a white balance adjustment amount based on the collected information. Rather than claiming any improvements in the art, claim 6 merely describes a method for using a conventional image forming device that can record an image (via an "image pickup device") and detect three aspects of the recorded image: object brightness, object distance, and zoom. *See* '821 patent at claim 6. Similar to *Elec. Power Grp., LLC v. Alstom S.A.*, the focus on claim 6 is simply on "collecting information, analyzing it, and displaying certain results of the collection and analysis." 830 F.3d 1350, 1353 (Fed. Cir. 2016). The subsequent claim recitations of claim 6 merely recite adjustments to the white balancing using these same three parameters—object brightness, object distance, and zoom—in different ways to perform white balancing on the image. *See* '821 patent at claim 6 ("wherein as said white balance control amount adjustment value, an object distance threshold value for discriminating a magnitude of the distance to the object is formed on the basis of said object brightness information and said zoom value information; and said object distance detection information is compared with said object distance threshold value information, thereby obtaining said white balance control amount adjustment value according to a result of the comparison"). Claim 6 of the '821 Patent does involves nothing more than collecting data (object brightness, object distance, and zoom) and determining a white balance based on the collected data. The white balancing itself (i.e., manipulation to the image data to

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perform white balancing) is not even required to be performed by claim 6 – merely the determination of a white balancing adjustment amount is required.

Claim 6 is further directed to an abstract idea because it does not define any hardware structural components that perform any of the adjustments or comparisons to determine white balance. *See id.* Instead, claim 6 merely recites numerous comparisons and adjustments without any recitations regarding ***how*** white balancing is performed, how the three parameters relate to one another, or the use of the white balancing result in any tangible manner. This high-level claim is directed to the abstract idea itself. *See, e.g., Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258-59 (Fed. Cir. 2016) ("There is nothing in claim 1 that is directed to ***how*** to implement out-of-region broadcasting on a cellular telephone. Rather, the claim is drawn to the idea itself.") (emphasis added). The use of results-based functional language confirms that claim 6 of the '821 Patent is drawn to an abstract idea. *See Two-Way Media Ltd. v. Comcast Cable Comms., LLC*, 874 F.3d 1329,1337 (holding claims "using result-based functional language" were drawn to ineligible subject matter for failing to "sufficiently describe how to achieve these results in a non-abstract way."); *see also Affinity Labs of Texas, LLC v. Amaxon.com Inc.*, 838 F.3d 1266, 1269; *Dropbox, Inc. v, Synchronoss Techs. Inc*, 815 F. App'x 529, 537 (Fed. Cir. 2020) ("'[T]ransmitting' data, and 'retrieving' data are generalized steps to be performed on a computer using conventional computer activity.").

***Alice*, Step 2:** Because the claim 6 of the '821 Patent is directed to the abstract idea of collecting information and forming a white balance adjustment amount based on the collected information, the claims must add an "inventive concept" that ensures the patent amounts to significantly more than a patent on the ineligible idea itself. *Alice*, 573 U.S. at 222. The '821 Patent claim likewise fails here because it adds nothing more than conventional activities performed using conventional camera technology, as explained by the specification and prior art incorporated into the patent itself. The claims merely recite "white balance control means," "an image pickup device," "object distance detecting means," and "zoom value detecting means." *E.g.*, '821 Patent at claim 6. The written description or figures of the '821 patent merely recite generic computer components, and nothing in the specification raises the concepts disclosed within

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to anything inventive, let alone non-abstract. *Broadband iTV, Inc. v. Amazon.com, Inc.*, 113 F.4th 1359, 1370 (Fed. Cir. 2024) ("When the patent's specification describes the components and features listed in the claims generically, it supports the conclusion that these components and features are conventional.") (internal quotations omitted).

Importantly, beyond results-based language, nothing in the '821 Patent's claim 6 or specification defines ***how*** white balance is adjusted based on the collected information or ***how*** the white balance adjustment is actually implemented on image data. This Court has found such limits of patent claims and specification ineligible at Step Two. *Cisco Sys.*, 386 F. Supp. 3d at 1200 ("But this is nothing more than a restatement of the idea of ranking and selecting devices based on antenna performance characteristics that the Court found to be abstract at step one . . . . The problem here is that nothing in the claim or the specification explains the technique in anything more than broad, generalized, functional terms."). Because these claims recite nothing more than generic computer implementation of the abstract ideas identified in Step One, they must fail. *Twilio, Inc.*, 249 F. Supp. 3d at 1150 ("claim 1 specifies steps at a high level of generality to carry out the abstract idea of selecting the best message routing option based on separately-transmitted feedback. Nothing in the claims or the specification suggests that any of its elements are arranged in a non-conventional or non-generic way. *See Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999, 1013 (Fed. Cir. 2018) ("These claims do not recite anything more than simply stating the abstract idea while adding the words 'apply it.'") (internal quotations omitted).

Defendants further incorporate the discussion of the prior art above as additional evidence that these features were well known, routine, and conventional.

3. '284 patent

At least the asserted claims of the '284 Patent are invalid under 35 U.S.C. § 101 for failure to recite patent eligible subject matter. Specifically, the asserted claims of the '284 Patent are fatally abstract under the U.S. Supreme Court's decision in *Alice*.

Asserted claim 18 is representative because like claim 18, all independent claims recite nearly identical requirements of (1) connecting to an external apparatus to transmit video via a first radio communication circuit; (2) connecting to "an internet or a home network" via a second radio

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communication circuit; and (3) controlling the assignment among those two connections, including controlling that assignment according to certain criteria. '284 patent at claims 1, 7, 13, 18. The dependent claims do not add anything further beyond additional criteria to control assignment as explained by (3). *Id.* at claims 2-6, 8-12, 14-15, 19-20.

***Alice*, Step 1:** The claims of the '284 Patent are generally directed to the abstract ideas of (i) controlling messaging routing in the telephony messaging field and (ii) ranking radio connections according to a criterion and selecting the radio connection with the highest rank to send video. Rather than claiming any improvements in the art, the '284 Patent's claim language merely describes a device (or method implemented thereby) that has two simultaneous connections, controls the assignment (e.g., transmission rate) over those two connections, and controlling the assignment of the first connection to be more than that of the second connection when the user "issues an indication" to send video via the first connection. *See* '284 patent at claim 18. Similar to the abstract "controlling messaging routing" claims in *Twilio, Inc. v. Telesign Corp.*, the claims here, which merely select a radio connection to send video along, are analogous to a person who chooses to send a package via FedEx, UPS, or USPS. 249 F. Supp. 3d 1123 (N.D. Cal. 2017). Similarly, insofar as the claims prioritize one connection over another, they are also abstract like the claims this Court found abstract in *Cisco Sys., Inc. v. Uniloc USA Inc.* because the claims are "directed to abstract ideas related to the ranking of information (whether message routing data, customer service representative profiles, or antenna performance) and taking subsequent action (whether routing of a delivery receipt, the selection of a customer service representative, or the selection of a master station) based on those rankings." 386 F. Supp. 3d 1186, 1195 (N.D. Cal. 2019) (citing *Twilio*, 249 F. Supp. at 1144). The claims of the '284 Patent only stand to control assignment (transmission rate) of two radio connections that respectively perform basic, well-known features of (1) transmitting video; and (2) downloading data from the Internet or a home network. Similarly, here, "the ['284] patent purports to rank [radio connections] based on [user indication], just as a prospective diner could rank restaurant choices." *See id.* Indeed, "Nothing in the patent's process for ranking the [radio connections] . . . describes anything that cannot be done manually or with a mental process." *See id.* at 1195-96.

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Nothing about these claims recite specific functionality—just that they are done on a computer, making the claims further abstract for reciting generic computer implementation, as well. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353-54 (Fed. Cir. 2016) ("the focus of the claims is not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools"); *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258-59 (Fed. Cir. 2016) ("There is nothing in claim 1 that is directed to ***how*** to implement out-of-region broadcasting on a cellular telephone. Rather, the claim is drawn to the idea itself.") (emphasis added). Indeed, the use of results-based functional language further confirms that the '284 patent's claims are drawn to an abstract idea. *See Two-Way Media Ltd. v. Comcast Cable Comms., LLC*, 874 F.3d 1329,1337 (holding claims "using result-based functional language" were drawn to ineligible subject matter for failing to "sufficiently describe how to achieve these results in a non-abstract way."); *see also Affinity Labs of Texas, LLC v. Amaxon.com Inc.*, 838 F.3d 1266, 1269; *Dropbox, Inc. v, Synchronoss Techs. Inc*, 815 F. App'x 529, 537 (Fed. Cir. 2020) ("'[T]ransmitting' data, and 'retrieving' data are generalized steps to be performed on a computer using conventional computer activity.") (cleaned up).

***Alice*, Step 2:** Because the '284 Patent's claims are directed to the abstract ideas of controlling messaging routing and ranking radio connections, the claims must add an "inventive concept" that ensures the patent amounts to significantly more than a patent on the ineligible idea itself. *Alice*, 573 U.S. at 222. The '284 Patent claims likewise fail here because nothing more than conventional activities performed on conventional network equipment, as explained by the specification and prior art incorporated into the patent itself. The claims merely recite "video display" and "video processing" apparatuses and methods corresponding thereto with generic computer equipment including first and second "radio communication circuit[s]" and merely "a controller" to control those radio communication circuits. *E.g.*, '284 Patent at claim 18. The written description or figures of the '284 patent merely recite generic computer components, and nothing in the specification raises the concepts disclosed within to anything inventive, let alone non-abstract. *Broadband iTV, Inc. v. Amazon.com, Inc.*, 113 F.4th 1359, 1370 (Fed. Cir. Sept. 3, 2024) ("When the patent's specification describes the components and features listed in the claims

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generically, it supports the conclusion that these components and features are conventional.") (cleaned up).

Importantly, beyond results-based language, nothing in the '284 Patent's claims or specification recite ***how*** assignment is controlled in the systems or ***how*** the claimed apparatuses and methods receive user indications to send video along a certain communication path.[3] This Court has found such limits of patent claims and specification ineligible at Step Two. *Cisco Sys.*, 386 F. Supp. 3d at 1200 ("But this is nothing more than a restatement of the idea of ranking and selecting devices based on antenna performance characteristics that the Court found to be abstract at step one . . . . The problem here is that nothing in the claim or the specification explains the technique in anything more than broad, generalized, functional terms."). Because these claims recite nothing more than generic computer implementation of the abstract ideas identified in Step One, they must fail. *Twilio, Inc.*, 249 F. Supp. 3d at 1150 ("claim 1 specifies steps at a high level of generality to carry out the abstract idea of selecting the best message routing option based on separately-transmitted feedback. Nothing in the claims or the specification suggests that any of its elements are arranged in a non-conventional or non-generic way."); *see also Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999, 1013 (Fed. Cir. 2018) ("These claims do not recite anything more than simply stating the abstract idea while adding the words 'apply it.'") (cleaned up).

To be sure, the '284 patent's results-based, functional language does not advance any inventive concept either. Rather, the claims merely describe the desired function or outcome "without providing any limiting detail that confines the claim to a particular solution." *Affinity Labs*, 838 F.3d at 1269.

Defendants further incorporate the discussion of the prior art above as additional evidence that these features were well known, routine, and conventional.

4. '449 and '072 Patents

In addition to the invalidity under Section 101 for the '449 and '072 patents as shown in Defendants' motion for judgment on the pleadings, the '072 patent is invalid under Section 101

[3] It is not even clear from the patent ***what*** "controlling assignment" describes—let alone ***how*** it is performed. Indeed, the patent does not sufficiently disclose whether the scope of "assignment" is limited to transmission rate, or something more.

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due to statutory double patenting in view of the '449 patent. Under 35 U.S.C. § 101, "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor[.]" This section "prevents two patents from issuing on the same invention." *Application of Vogel*, 422 F.2d 438, 441 (C.C.P.A. 1970). Although two claims may use different words, the claim may nevertheless cover the "same invention." *Id.* ("claims may be differently worded and still define the same invention."). When the same invention is claimed twice, Section 101 prevents the second claim. *Id.* Plaintiff's interpretation of the claims of the '449 and '072 patents in its Patent L.R. 3-1 shows Plaintiff's interpretation of the '449 and '072 patents shows that these patents claim the same invention, and thus, the second patent—the '072 patent—is invalid.

V. Patent L.R. 3-4 – Document Production Accompanying Invalidity Contentions

A. Patent L.R. 3-4(a): Source code, specifications, schematics, flow charts, artwork, formulas, or other documentation sufficient to show the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its Patent L.R. 3-1(c) chart;

Based on their investigations to date, Defendants have produced or are producing materials pursuant to Patent L.R. 3-4(a) at Bates Nos. LGEMAX00000001-00067536, LGEMAX00067539-00081568, LGEMAX00082907-00082969, LGEMAX00083141-00083172, and LGEMAX00083209-00092164. In addition, Defendants hereby make source code for the accused products available for inspection in the Washington D.C. offices of Fish & Richardson P.C., to the extent such source code is in the possession, custody, and/or control of Defendants.

B. Patent L.R. 3-4(b): A copy or sample of the prior art identified pursuant to Patent L.R. 3-3(a) which does not appear in the file history of the patent(s) at issue. To the extent any such item is not in English, an English translation of the portion(s) relied upon shall be produced;

Based on their investigations to date, Defendants have produced or are producing materials pursuant to Patent L.R. 3-4(b) at Bates Nos. PA0000001-0026267.

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C. Patent L.R. 3-4(c): All agreements that may be related to the accused instrumentality or may be comparable to a license that would result from a hypothetical reasonable royalty negotiation;

Based on their investigations to date, Defendants have produced or are producing materials pursuant to Patent L.R. 3-4(c) at Bates Nos. LGEMAX00082624-00082869.

D. Patent L.R. 3-4(d): Documents sufficient to show the sales, revenue, cost, and profits for accused instrumentalities identified pursuant to Patent L.R. 3-1(b) for any period of alleged infringement; and

Based on their investigations to date, Defendants have produced or are producing materials pursuant to Patent L.R. 3-4(d) at Bates Nos. LGEMAX00067537, LGEMAX00082870.

E. Patent L.R. 3-4(e): All agreements that may be used to support the party denying infringement's damages case. The producing party shall separately identify by production number which documents correspond to each category.

Based on their investigations to date, Defendants have produced or are producing materials pursuant to Patent L.R. 3-4(e), including at least all materials identified pursuant to Patent L.R. 3-4(c). To the extent discovery reveals other information responsive to this subsection, Defendants will produce such material.

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Dated: February 3, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on February 3, 2025, a true and correct copy of the above and foregoing document was served on the following counsel of record via electronic mail to the addresses set forth below:

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