January 12, 2021 *Via Email (dberten@giplg.com)*

David Berten
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Re: MyPort IP, Inc. Patent Portfolio

Dear David,

I am writing in further response to your letter dated October 13, 2020 to Jeffrey Lasker regarding the MyPort patent portfolio, and to follow up on our phone conversation on December 1, 2020.

Apple respects the valid intellectual property rights of third parties. MyPort asserts that Apple infringes three patents (U.S. Pat. Nos. 9,832,017; 10,237,067, and 10,721,066—all of which are in the same family and share a common specification). We have reviewed the patents and claim charts that you provided. Specifically, the claim charts contend that Apple infringes claims 13-17 of the '017 patent, claims 6-9 and 13-17 of the '067 patent, and claims 13-17 of the '066 patent. To the extent MyPort contends that Apple infringes any other claim or patent, please provide a detailed explanation of such alleged infringement. Otherwise, Apple understands that MyPort only contends that Apple infringes the claims and patents identified above.

As your letter mentions, MyPort approached Apple in 2011 regarding U.S. Patent No. 7,778,440, which MyPort asserted in litigation against HTC and other defendants. *See generally MyPort IP, Inc. v. HTC Corp., et al.*, No. 6:11-cv-246 (E.D. Tex.). In Apple's 2011 discussions with MyPort, Apple provided exemplary reasons why the '440 patent was invalid and not infringed. MyPort did not provide a substantive rebuttal and chose not to pursue its assertion against Apple any further. In the meantime, HTC filed an *ex parte* reexamination, and succeeded in invalidating each claim of the '440 patent. *See MyPort v. HTC*, Dkt. 189 (E.D. Tex. Oct. 26, 2017) (Joint Motion to Dismiss setting forth the reexamination history and invalidity of the '440 patent). Further, your October 13, 2020

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letter states that "MyPort IP has settled litigation in the Eastern District of Texas concerning the patent family and entered into licenses with several manufacturers of devices including Huawei Technologies Co., Ltd., Research in Motion Ltd., and Motorola Mobility, Inc." Yet, from our review of the case docket, it is Apple's understanding that these parties settled prior to the filing of the *ex parte* reexamination by HTC.

Now, nine years after MyPort first approached Apple regarding the invalid '440 patent, MyPort asserts three additional patents. For the exemplary reasons explained below, the newly-asserted MyPort patents do not cover Apple's products and services. Thus, Apple does not require a license.

U.S. Patent No. 9,832,017

MyPort contends that the Notes and Photos apps on the iPad infringe claims 13-17 of the '017 patent. The only asserted independent claim is claim 13, which is reproduced below:

A system for capturing image and audio information for storage, comprising:

> *internal storage;*
>
> *a microphone interfacable with an external audio information source that generates external audio information and a first data converter for capturing the first external audio information from the microphone;*
>
> *a camera interfacing with an image source to capture an image therefrom;*
>
> *the first data converter processing the captured external audio information and storing it in a first digital audio format as stored digital audio within the capture device, the camera for processing the captured image and storing it as a stored digital image;*
>
> *a second data converter for converting the received digital audio to a text based searchable file as a text context tag and creating an image recognition searchable*

context tag with image recognition of at least a portion of the digital image and associating the text and image recognition context tags with the digital image; and

the internal storage storing the digital image in association with the text and image recognition context tags.

As shown above, claim 13 recites a "first data converter" and a "second data converter." The claim charts contend that the first data converter is "iPad mini's microphone coupled with the iPad's processor and software to process the audio information into digital information."

But the claim charts do not identify the alleged second data converter. As shown above, claim 13 requires the second data converter to perform both (1) "converting the received digital audio to a text based searchable file as a text context tag," and (2) "creating an image recognition searchable context tag with image recognition of at least a portion of the digital image and associating the text and image recognition context tags with the digital image." There is nothing in the charts to indicate that the same alleged "data converter" performs both of these tasks.

Instead of identifying the alleged "second data converter," the claim charts assert that the Photo and Notes apps each "use[] machine learning to automatically apply image recognition tags to photos stored on the iPad." This is not consistent with the '017 patent's use of the term "data converter." *See, e.g.*, '017 patent at col. 3:59-60 ("In general, the data converter is any type of device that will capture the information and place it in some type of digitized format."). Applying tags to photos is not indicative of the presence of a "data converter," because, for example, no data is captured or converted. Accordingly, for at least this independent reason, Apple does not infringe claim 13 of the '017 patent. Because claims 14-17 depend from and further limit claim 13, Apple also does not infringe those claims for at least the same reason.

U.S. Patent No. 10,237,067

MyPort contends that the Photos app on the iPad infringes claims 6-9 and 13-17 of the '067 patent. The only asserted independent claims are claims 6 and 13, which are reproduced below:

6. *A system for capturing image and audio information for storage, comprising:*

a capture device having:

internal storage;

a microphone interfaceable with and external audio information source that generates external audio information and a first data converter for capturing the first external audio information from the microphone,

a camera interfacing with and external image source to capture an image therefrom;

the first data converter processing the captured external audio information and storing it in a first digital audio format as stored digital audio in internal storage within the capture device, the camera for processing the captured image and storing it as a stored digital image in internal storage;

a data capture device for capturing, as captured data, location information, and time information associated with at least the capture of the image and storing the captured data as stored captured data;

a media data converter for converting the received digital audio to a text based searchable file as a text context tag and creating an image recognition searchable context tag with image recognition of at least a portion of the digital image and associating the text and image recognition context tags with the digital image and the captured data, and

the internal storage storing the digital image in association with the text and image recognition context tags in addition to the stored captured data.

13. *A system for capturing image and audio information for storage, comprising:*

internal storage;

a microphone interfaceable with an external audio information source that generates external audio information and a first data converter for capturing the external audio information from the microphone;

a camera interfacing with an image source to capture an image therefrom;

a data capture device for capturing, as captured data, location information and time information associated with at least the capture of the image and storing the captured data as stored captured data;

the first data converter processing the captured external audio information and storing it in a first digital audio format as stored digital audio within the capture device, the camera for processing the captured image and storing it as a stored digital image;

a second data converter for converting the received digital audio to a text based searchable file as a text context tag and creating an image recognition searchable context tag with image recognition of at least a portion of the digital image and associating the text and image recognition context tags with the digital image and with the stored captured data; and

the internal storage storing the digital image in association with the text and image recognition context tags in addition to the stored captured data.

As shown above, claim 6 recites a "**media data converter** for converting the received digital audio to a text based searchable file as a text context tag and creating an image recognition searchable context tag with image recognition of at least a portion of the digital image and associating the text and image recognition context tags with the digital image and the captured data," and claim 13 recites a "**second data converter** for converting the received digital audio to a text based searchable file as a text context tag and creating an image recognition searchable context tag with image recognition of at least a portion of the digital image and associating the text and image recognition context tags with the digital image and with the stored captured data."

As discussed above in the context of the ’017 patent, the claim charts fail to show a data converter that both (1) “convert[s] the received digital audio to a text based searchable file as a text context tag,” and (2)”creat[es]an image recognition searchable context tag with image recognition of at least a portion of the digital image and associating the text and image recognition context tags with the digital image and the captured data.” Instead, as with the ’017 patent, the claim chart merely points to the iPad applying image recognition tags to photos. Thus, for at least the reasons that Apple does not infringe the asserted claims of the ’017 patent, Apple does not infringe the asserted claims of the ’067 patent.

U.S. Patent No. 10,721,066

MyPort contends that the Photos app on the iPad and iPhone infringes claims 13-17 of the ’066 patent. The only asserted independent claim is claim 13, which is reproduced below:

A method for capturing image and audio information for storage, comprising the steps of:

> *providing internal storage;*
>
> *interfacing a microphone with an external audio information source that generates external audio information and converting with a first data converter the external audio information from the microphone;*
>
> *interfacing a camera with an image source to capture an image therefrom;*
>
> *capturing with a capture device, as captured data, location information and time information associated with at least the capture of the image and storing the captured data as stored captured data;*
>
> *the first data converter processing the captured external audio information and storing it in a first digital audio format as stored digital audio within the capture device, the camera for processing the captured image and storing it as a stored digital image;*
>
> *converting with a second data converter the received digital audio to a text based searchable file as a text context tag and creating an image recognition searchable context tag with image recognition of at least a portion of the digital image and*

associating the text and image recognition context tags with the digital image and with the stored captured data; and

storing in the internal storage the digital image in association with the text and image recognition context tags in addition to the stored captured data.

As shown above, claim 13 recites "converting with a **second data converter** the received digital audio to a text based searchable file as a text context tag and creating an image recognition searchable context tag with image recognition of at least a portion of the digital image and associating the text and image recognition context tags with the digital image and with the stored captured data."

As discussed above in the context of the '017 and '067 patents, the claim charts fail to show a second data converter that both (1) "convert[s] . . . the received digital audio to a text based searchable file as a text context tag," and (2)"creat[es] an image recognition searchable context tag with image recognition of at least a portion of the digital image and associating the text and image recognition context tags with the digital image and with the stored captured data." Instead, as with the '017 and '067 patents, the claim chart merely points to the iPad applying image recognition tags to photos. Thus, for at least the reasons that Apple does not infringe the asserted claims of the '017 and '067 patents, Apple does not infringe the asserted claims of the '066 patent.

The reasons discussed above are merely examples of why Apple does not need a license, and are not exhaustive. We reserve any omitted non-infringement, invalidity, or other defenses. If you continue to disagree with our assessment, please provide a detailed explanation of your position.

Sincerely,

Michael West

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March 19, 2021

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Dear Michael:

Thank you for your January 12 letter responding to MyPort's assertion that certain Apple products infringe certain MyPort patents. We appreciate Apple's responses to MyPort's concerns and hope that we can continue to cooperate to resolve the matter.

We disagree with Apple's non-infringement arguments. With regard to the three asserted patents, Apple asserts that its products do not have a "second data converter" or "media data converter." Apple does not dispute, however, that the accused products (1) convert audio files to text files; and (2) convert images without tags to images with searchable tags using image recognition. The structure doing these conversions is different than the structure that converts analog sound waves to digital audio files. There are thus at least two different "data converters" in the accused products: one that converts analog sound waves to digital audio files, and one that converts information that has already been digitized into a converted format that includes text files and image tags.

As to the argument that a "data converter" must "capture information," we disagree that such a construction is correct or, even if it is adopted, means there is no infringement. Whichever way "data converter" is construed, it must be able to accomplish the claimed function of, for example, converting a *digital* audio file to a text file. A court will either decline to read a "capture" limitation into the phrase "data converter" (the most likely result), or will conclude that the converter "captures" the digital audio file or image when it is loaded into the converter for conversion.

As often happens in matters of claim interpretation, we may be at a point where we "agree to disagree." That does not mean we cannot continue our discussions to resolve the matter. Apple has identified a possible interpretation that may reduce (but not eliminate) a finding of infringement on the asserted claims, and MyPort will take that risk into account as we determine whether we can reach an agreement. Similarly, given that the family has open continuations, Apple will need to consider whether new claims will overcome the issues Apple has raised (assuming those issues are not resolved in MyPort's favor).

I suggest we schedule another call for following up. Thank you,

April 19, 2021 *Via Email (dberten@giplg.com)*

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Re: MyPort IP, Inc. Patent Portfolio

Dear David,

I write in response to your letter dated March 19, 2021. We have reviewed your letter and for at least the reasons discussed below, it does not cure the deficiencies in MyPort's claim charts that we identified in my letter dated January 12, 2021. Accordingly, Apple does not infringe the asserted patents and does not require a license.

The accused devices do not include a "second data converter" or "media data converter."

As explained in my January 12 letter, each asserted independent claim recites either a "second data converter" or "media data converter" that performs at least the following two functions: (1) converting the received digital audio to a text based searchable file as a text context tag, and (2) creating an image recognition searchable context tag with image recognition of at least a portion of the digital image and associating the text and image recognition context tags with the digital image. *See* January 12, 2021 Letter at 2-7.

Because the accused Apple devices do not include a single "data converter" that performs these two functions, Apple does not infringe any of the asserted claims. Your March 19, 2021 letter appears to concede this, stating that "[t]here are thus at least two different 'data converters' in the accused products: one that converts analog sound waves to digital audio files, and one that converts information that has already been digitized into a converted format that includes text files and image tags." March 19, 2021 Letter at 1. While Apple does not concede that its products include any "data converters" as described in your letter and claim charts, even if your characterization were correct, this simply confirms that Apple does not infringe. The claims are clear that a single "data converter" must

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perform both functions. Your letter's concession that these functions are allegedly performed by two separate "data converters" establishes that Apple does not infringe any claim of the asserted MyPort patents.

The alleged "second data converter" and "media data converter" do not capture information.

As explained in my January 12 letter, the shared specification of the three asserted patents states that "[i]n general, the data converter is any type of device that will capture the information and place it in some type of digitized format." January 12, 2021 Letter at 3 (quoting U.S. Patent No. 9,832,017 at col. 3:59-60). In spite of this plain statement, your March 19 letter states that you disagree that a data converter must capture information. And there is no dispute that the accused functionality of applying tags to digital images is fundamentally different from capturing information. Accordingly, for this additional independent reason, Apple does not infringe any of the asserted claims.

The reasons discussed above are merely examples of why Apple does not need a license, and are not exhaustive. We reserve any omitted non-infringement, invalidity, or other defenses. If you continue to disagree with our assessment, please provide a detailed explanation of your position.

Sincerely,

Michael West

Michael West
Legal Counsel, IP Transactions