

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
MIDLAND/ODESSA DIVISION**

CardWare Inc.,	§	
	§	
Plaintiff,	§	
	§	
v.	§	Civil Action No. 7:24-cv-00278-DC-DTG
	§	
	§	JURY TRIAL DEMANDED
	§	
Google LLC,	§	
	§	
Defendant.	§	

PLAINTIFF CARDWARE INC.’S RESPONSIVE CLAIM CONSTRUCTION BRIEF

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I. INTRODUCTION

Defendant Google, Inc. (“Google”) has proposed that six claims of two asserted patents—related patents U.S. Patent Nos. 10,339,520 (“the ’520 patent”) and 11,176,538 (“the ’538 patent”)—are indefinite based only on purported “antecedent” basis issues. Google’s indefiniteness challenges against one claim—claim 10 of the ’520 patent—rehash arguments on this same claim that were rejected by the U.S. District Court for the Eastern District of Texas in a prior case. As with Samsung, the litigant in that prior case, Google fails to consider the context of the claims, which makes clear that the terms are not indefinite. Moreover, Google’s expert, Dr. Black, does not do any of the limited things that the Supreme Court and Federal Circuit precedent permit experts to do during claim construction, such as apply some expertise in the field, describe the nature of the technology, or provide context about the invention or state of the art. Rather, Dr. Black’s declaration is nearly indistinguishable from a legal brief and an English-language analysis. His declaration should be disregarded under controlling Supreme Court and Federal Circuit law.

When read in the context of the claims and the specification, all the disputed claim terms are understandable and the scope of the inventions that they define are clear. Therefore, all of Google’s indefiniteness arguments should be rejected.¹

II. JUDGE PAYNE ALREADY REJECTED SOME OF THE SAME INDEFINITENESS ARGUMENTS THAT GOOGLE NOW MAKES

CardWare previously asserted the ’520 and ’538 patents in the United States District Court for the Eastern District of Texas against Samsung. *See* D.I. 58-1. In that case, Samsung argued that “payment information” and related terms in claim 10 of the ’520 patent were indefinite, based

¹ CardWare withdraws claim 6 of the ’538 patent as an asserted claim, rendering that portion of Google’s brief moot.

on nearly identical indefiniteness arguments (made by the same law firm, Paul Hastings LLP). *See* D.I. 58-1 at 20–23. Judge Payne rejected Samsung’s arguments and held that claim 10 of the ’520 patent is not indefinite and construed the terms to have their plain meaning. *Id.* at 23. Judge Payne also addressed seven different arguments by Samsung regarding purported indefiniteness of terms in the ’538 patent. *Id.* at 37–57. He found that one claim (not asserted here) was indefinite, but that the rest were not indefinite.² *Id.* Judge Payne’s decision on these terms was well-reasoned, and was decided after four rounds of briefing, submission of a technology tutorial, and approximately three hours of oral argument.

III. ARGUMENT

A. Google’s Expert Declaration Should be Disregarded

Expert testimony has a limited role in claim construction, such as “to provide background on the technology at issue, to explain how an invention works, to ensure that the court’s understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, or to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (*en banc*). Likewise, the Supreme Court has explained this limited role: “experts may be examined to explain terms of art, and the state of the art, at any given time, but they **cannot** be used to prove the proper or legal construction of any instrument of writing.” *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 332 (2015) (cleaned up; emphasis added).

² Judge Payne found that claim 1 of the ’538 patent was indefinite prior to the date when CardWare was issued a Certificate of Correction (“CoC”), but did not hold that it was indefinite after that date. D.I. 58-1 at 37-40. CardWare is not seeking pre-CoC damages.

Dr. Black offers **no** technical analysis whatsoever. *See, e.g.*, Ex. A³ (“Black Tr.”) at 70:10–19 (“I don’t have any kind of general discussion of the shape or overall objective or I don’t summarize the claim.”); *id.*, at 71:6–12 (“I don’t discuss the patent overall, what its setting out to do”); *id.* at 134:5–11. Instead, he offers “conclusory, unsupported assertions as to a term’s definition [which] are not helpful to a court.” *See Phillips*, 415 F.3d at 1318; *MCOM IP, LLC v. Woodforest Nat’l Bank & Inetco Sys., Ltd.*, No. 6-21-CV-989-ADA, 2022 WL 1394551, at *3 (W.D. Tex. May 3, 2022).

Dr. Black’s conclusions should be disregarded and afforded no weight.

B. U.S. Patent No. 10,339,520

1. “payment information”; “issued payment information”; “an issuer provided payment information”; “the issuer provided payment information”; “a static device account number payment information”; “the payment information”; “a issuer provided payment information”; “issuer provided payment information” (claim 10)

Plaintiff’s Proposed Construction	Defendant’s Proposed Construction
Not indefinite. Plain and ordinary meaning.	Indefinite

a) “Payment Information” In Claim 10 Is Definite.

Google asserts that one of the “payment information” terms in claim 10 is indefinite because it lacks clear antecedent basis. D.I. 58 (“Br.”) at 3–10. Google’s position is incorrect—the claim language, when read *in context*, is definite—just as Judge Payne already found after considering the same arguments in the *Samsung* litigation.

Claim 10 recites a method of generating limited-use replacement payment credentials that can be used *instead of* issued payment information (*e.g.*, the traditional credit card information

³ As used herein, “Exhibit” refers to the exhibits to the Declaration of Yue (Joy) Wang in Support of CardWare’s Responsive Claim Construction Brief (“Wang Decl.”) filed concurrently herewith.

issued by a bank). For that reason, it claims multiple categories of “payment information,” including (i) issued payment information which comprises an issuer provided payment information, (ii) a dynamically generated one-time limited-use number, (iii) static device account number payment information, and (iv) a complete replacement payment information that is a combination of the dynamically-generated and static device account numbers.

Below is a color-coded version of claim 10 showing how each of the “payment information” terms match-up with each other.

10. A method of storing and generating **payment information** in an electronic device, the method comprising:

[a] accepting a user input of **issued payment information** input at a touch screen display of the electronic device, wherein **the information** comprises an **issuer provided payment information** [steps 1 and 2, below];

[b] wherein the electronic device comprises device-specific and user-specific information; and,

[c] wherein the **issuer provided payment information** is communicated wirelessly [step 3, below]; and,

[d] receiving wirelessly a **static device account number payment information** for storage on the electronic device [step 4, below]; and wherein

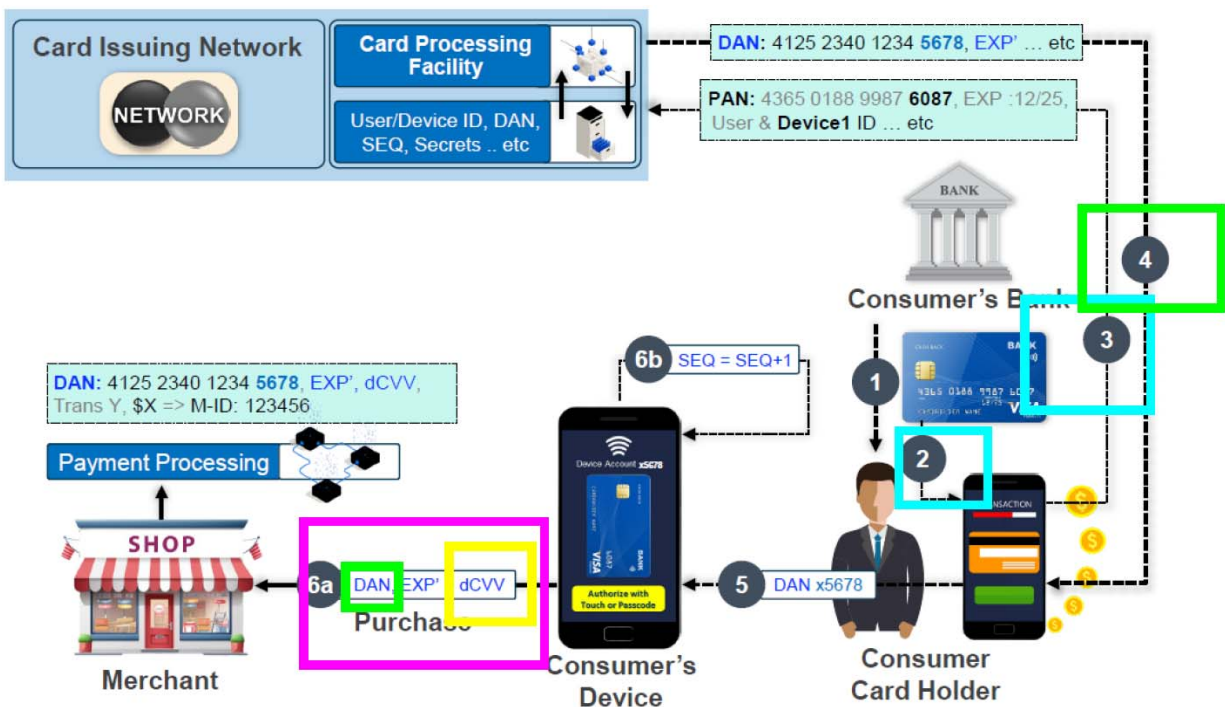
[e] **at least a portion of the payment information is a limited-use number for limited use by the device**, in place of **a issuer provided payment information** [step 6a, below]; and,

[f] **dynamically generating a one-time limited-use number** based on at least one of a set of information including: user-identifying information; user secrets; device information; device secrets; time; merchant; facility location; sequence count; **payment information**; account information; amount; and transaction information [reflected in steps 6a and 6b, below]; and

[g] using said **static device account number** and said **dynamically generated one-time limited-use number** together in the place of **issuer provided payment information** for **making a payment transaction** [step 6a, below].

D.I. 1-1 (“520 patent”) at 17:8–33 (annotated, disputed term in **bold underline**).

The original “issued” payment information (blue) is replaced with the combination (i.e., “us[ed] together,” per the last limitation 10[g]) of a dynamically generated limited-use number (yellow) and the static device account number (green). The final replacement information (purple) is the combination of these two replacement pieces. That is how the claim reads, which can be illustrated through a corresponding color-coded mark-up of a diagram CardWare has previously presented (D.I. 44, and forthcoming technology tutorial) showing a real-world implementation.



As shown in the above diagram, the issued payment information (e.g., from the issuing bank) is accepted at the electronic device (blue, step 2, limitation 10[a]) and then gets wirelessly transmitted (blue, step 3, limitation 10[c]). That is clear because at each of steps 2 and 3, the claim describes the payment information as “issuer provided.” What comes back is a static device account number payment information (green, step 4, limitation 10[d]). Again, the context is clear because “payment information” at step 4 is described as a “static device account number.” The complete payment information (purple) is then used for purposes of a payment transaction, and

includes both the static device account number (**green**) and a dynamically generated one-time limited use number (**yellow**), all of which is shown in step 6a in the diagram, corresponding to limitation 10[g]. The yellow highlighted payment information is consistently described as limited-use (and in two recitations, dynamically generated).

There is nothing indefinite about the way that the claim describes the different steps in a secure payment transaction. There are multiple categories of “payment information” recited in claim 10 because that is the nature of this secure payment technology—one type of payment information gets replaced with another, and that replacement payment information includes different sub-portions. In each recitation, the context of the claim provides clarity as to which “payment information” is being recited, whether that is the “issued” payment information, the “static device account number,” the “dynamically generate[d] [] one-time limited use number” or the complete “payment information” that is used for the “payment transaction.”

Google nonetheless asserts that “the payment information,” bolded and underlined above, is indefinite because (per Google) it could refer to any of (i) “payment information” in the preamble; (ii) “issued payment information,” (iii) “an issuer provided payment information,” or (iv) “a static device account number payment information.” Br. at 4–8; D.I. 58-2 (“Black Decl.”), ¶¶ 34–39. This is wrong, as is evident from the context of the claim itself.

First, neither “issued payment information” nor “an issuer provided payment information” make sense as antecedent basis for the disputed term (bolded and underlined, above). Claim 10 recites, “accepting a user input of issued payment information . . . , wherein the information comprises an issuer provided payment information,” meaning that they are the same type of information, namely, payment information originating from an issuer. The “payment information” phrase that Google asserts is indefinite is supposed to be used “in place” of issuer-provided

payment information, per the surrounding claim language. Given that, why would the disputed “payment information” phrase refer to the same information (or even the same type of information) it is supposed to replace? Additionally, “issued” payment information refers to payment information that is “issued” to a user, *i.e.*, by a bank or other card issuer.⁴ Dr. Black acknowledged this.⁵ The “payment information” that Google highlights also cannot refer to “issued” payment information because that would not be information that is a limited use number for limited use by the electronic device, as the claim requires of the disputed phrase. Issued/issuer provided payment information comes from a bank and, by itself, would be device-agnostic.

Second, the disputed “payment information” phrase does not refer to “static device account number payment information.” Every time the claim refers to “static device account number payment information” it says so, both in the initial introduction of that phrase, and also in the last limitation where the claim uses the term “said static device account number.” Additionally, at least a “*portion*” of the disputed “payment information” phrase is a limited-use number for limited use by the device. This further indicates that the disputed phrase is not the “static device account

⁴ Two patent documents cited on the face of the ’520 patent explain that banks issue payment cards. See U.S. Patent No. 6,631,849 at 4:47-63 (“The front face of the card 10 may further include one or more conventional design elements such as a hologram 20, and **printed letters 22 denoting the financial institution issuing the card.**”) (emphasis added); U.S. Patent App. Pub. No. 2006/0032908A1 at [0105] (“For example, in one implementation the deactivated indicator 60 can only be reactivated with assistance from **the card issuer (e.g., the bank).**”) (emphasis added).

⁵ Black Tr. at 28:12–29:1 (Q: “And so issuer provided payment information would normally be provided by a financial institution; is that right?” A: “In every case I can think of, yes.” Q: “Okay. And some of those financial institutions might be banks; right?” A: “I don’t know if banks use a separate entity to issue that information or if it’s considered—it might be some legal structure that matters here in the question, but I think banks are issuers as well as credit card suppliers.”).

number.” Rather, the disputed phrase has “portion[s].” The only category of “payment information” recited in the claim that is described as having “portion[s]” is the complete payment information used in the payment transaction, which, per limitation 1[g], has both the (i) static device account number, and (ii) dynamically generated one-time limited-use number.⁶

This is exactly what Judge Payne already ruled. D.I. 58-1 at 23.

Google argues that Judge Payne’s decision was incorrect because it referred to “all” of the buckets of payment information. Br. at 7. This is not what Judge Payne held; he held that the disputed phrase refers to the “‘information’ involved in **ultimately ‘making a payment transaction.’**” D.I. 58-1 at 23 (emphasis added). In other words, “payment information” does not refer to *all* information; that would include issued/issuer provided payment information that the complete “payment information” replaces. Rather, as Judge Payne held, it refers to the “‘information’ involved in ultimately ‘making a payment transaction.’” *Id.* This is the complete (replacement) payment information, as shown in the **purple** box in the diagram above. This is the same as the preamble of claim 10 of the ’520 patent, which refers to payment information generated in an electronic device. In contrast, by the plain language of claim 10 “issued payment information” is input by a user into the electronic device, and not generated in the electronic device.

b) The Scope of “Payment Information” In Limitation 10[f] Is Clear.

Google argues that the term “payment information,” in what CardWare has labeled as

⁶ Google also argues that claim 23 supports its position, even though claim 23 does not depend from claim 10 and involves a method for performing ATM-transactions. Regardless, just as with claim 10, “payment information” in claim 23 refers to the complete replacement payment information (*i.e.*, the replacement for the issued payment information) that is used in a secure transaction. Claim 23 specifically recites that the complete payment information includes different pieces—a plurality of static portions and a plurality of dynamically generated limited-use portions.

limitation 10[f] and highlighted in red, is also unclear. Br. at 8–9; Black Decl., ¶ 40. To be clear, Google does not actually say that this recitation of “payment information” is indefinite; instead, Google cites it as further purported evidence that Judge Payne got it wrong in rejecting these same arguments and holding that claim 10 is not indefinite. *Id.*

Limitation 10[f] provides for dynamically generating a one-time limited-use number (boxed in yellow in the above diagram). That dynamic generation is based on at least one piece of information from a set of categories, one of which is “payment information.” This payment information can be any payment information. Why? Because the claim does not say otherwise. It does not use “the” or “said” to refer back to some prior element. The claim just says that the dynamic generation can be based on (among other things) *some* payment information. That could be “issued payment information,” static device specific “payment information,” or any other category of payment information. This does not have any bearing on the term “the payment information” in limitation 10[e], highlighted in purple, that Google alleges is indefinite.

c) The Scope of “A Issuer Provided Payment Information” Is Clear.

Google also asserts that “a issuer provided payment information” in limitation 10[e], highlighted in blue, is unclear. Br. at 9–10; Black Decl., ¶ 41. Again, Google does not appear to argue that this term itself is indefinite, but rather that use of the article “a” further enforces its primary argument that “payment information” (purple, limitation 10[e]) is indefinite. Br. at 9–10.

The “payment information” (purple) in limitation 10[e] refers to the complete replacement payment information—for example, the information that is transmitted in step 6a in CardWare’s diagram above. This is used in place of “a issuer provided payment information.” The article “a” does not change this fact or make anything more or less indefinite. The complete “payment information” is used in place of “a issuer provided payment information,” which could be the

“issuer provided payment information” that is communicated wirelessly (per limitation 10[d]) or some other issuer-provided payment information that may already be stored in the device. CardWare was allowed to draft its claims in this way, and to introduce elements using the article “a.” It does not make anything indefinite in the claim.

For the reasons discussed above, Google has not demonstrated by clear and convincing evidence that the identified “payment information” terms in claim 1 are indefinite.

C. U.S. Patent No. 11,176,538

1. “said device account information” (claim 4)

Plaintiff’s Proposed Construction	Defendant’s Proposed Construction
Not indefinite. Plain and ordinary meaning.	Indefinite

Google asserts that “said device account information,” which appears in dependent claim 4, is indefinite because there is no recital of the *exact* term earlier in claim 4 or in claims 1 or 3 from which claim 4 depends. Br. at 10–12; Black Decl., ¶ 42. However, read in context, “said device account information” refers to the “complete device payment information” that is transmitted for processing and validated by “a payment issuer authority.”

This is shown in the relevant portions of claims 1, 3, and 4, reproduced below:

1. A method of performing a payment transaction, the method comprising: ...
 - [f] dynamically generating, by a processor of the device, device-specific limited-use payment information, for said selected payment method; and, ...
 - [h] combining of said dynamically-generated limited-use payment information with said static limited-use payment information, to generate a complete device payment information; and,
 - [i] transmitting said complete device payment information from said electronic device to a recipient reader via said NFC interface to the recipient NFC reader for a processing of the payment transaction; and
 - [j] receiving information at said electronic device corresponding to a transaction status of the payment transaction, wherein such transaction status is at least partly dependent on validation of the transmitted complete device payment information by a payment processor authority and a payment issuer authority; and, ...
3. The method of claim 1, further comprising receiving said confirmation result of

said complete device payment information authentication status from a payment processing authority via at least one interface of a set of interfaces comprising: said device NFC interface, a wireless interface of said device.

4. The method of claim 3, wherein the generating the limited-use payment information utilizes a unique device generated information limited-in-use to said selected issuer-payment method, in payment transactions performed by said device, in place of said selected issuer-payment information; and,

wherein said device account information will be rejected as invalid when not including a valid device generated limited-use information.

D.I. 1-3 (“’538 patent”), 19:35–20:29, 20:34–48 (annotated, disputed term in **underlined bold**).

As set out above, claim 1 and its dependent claims, including claim 4, are directed to a “method of performing a payment transaction” by a device that combines “dynamically-generated limited-use payment information with [] static limited-use payment information, to generate a complete device payment information.” (limitation 1[h]). The device then “transmit[s] said complete device payment information” from the electronic device via NFC “for a processing of the payment transaction” (limitation 1[i]) and receives “a transaction status” that is “dependent on validation of the transmitted complete device payment information” (limitation 1[j]). Claim 3 clarifies that the device receives a “confirmation status of said complete device payment information authentication status from a payment processing authority.” In other words, the “complete device payment information” is transmitted from the device to a payment processing authority for validation, and in response, the device receives a confirmation status.

Claim 4 clarifies that “device account information” may be “rejected as invalid.” There is no way to read “device account information” other than as referring back to the “complete device payment information.” This claim set repeatedly and consistently recites information that is transmitted for validation, and recites receipt by the device in accordance with an authentication status (valid or invalid). That transmitted and validated information is, per limitations 1[i] and 1[j], the “complete device payment information.” The fact that claim 4 uses a slightly modified

phrase “device account information” does not create indefiniteness or suggest it is talking about anything other than the same transmitted “complete device payment information” that is validated (or not validated) by a payment processing authority (*i.e.*, the only information that is sent for validation and therefore the only information that can be rejected as invalid). Accordingly, “said device account information” refers to “complete device payment information,” which is the information transmitted in connection with “a processing of the payment transaction” and which is tied to the “confirmation status” from said “payment processing authority.”

This is only further confirmed by the rest of claim 4, which recites: “said device account information will be rejected as invalid when not *including* a valid device-generated limited-use information.” In other words, “said device account information” is designed to *include* other information, namely, the device generated limited-use information (**yellow** in the above claim). The word “include” suggests that “said device account information” includes sub-pieces of information, at least one of which is the “device-generated limited-use information.” This is consistent because the “complete device payment information” recited in limitation 1**[h]** also includes sub-pieces of information: the static limited use payment information and “the dynamically-generated limited-use payment information” (*i.e.*, the same device-generated limited use information that is part of claim 4). Accordingly, everything in the claim points in the same direction—“said device account information” in claim 4 refers to the “complete device payment information” elsewhere in the claim language.

Google and its expert, Dr. Black, offer purported “alternative possibilities,” and conclude that they can’t figure out what claim 4 is referencing. Br. at 10–12; Black Decl., ¶ 42. But, neither Google nor Dr. Black consider the above contextual clues, or try to analyze what information, in the context of claim 4, is considered valid or invalid (or why). Black Tr. at 128:22-130:1, 130:3-

7 (“I d[idn’t] discuss the validation check in my declaration.”). And Dr. Black does not apply any expertise from the field. *Id.*, at 133:7-12 (“In my declaration, no, I didn’t discuss [the] underlying technology.”) He was not an English major—nor would an English major be a POSITA—and nothing about the above claim interpretation hinges upon any underlying technical questions.

For the reasons discussed above, Google has not demonstrated by clear and convincing evidence that “said device account information” in claim 4 is indefinite.

2. “[device-transmitted] limited-use payment information” (claim 7)

Plaintiff’s Proposed Construction	Defendant’s Proposed Construction
Not indefinite. Plain and ordinary meaning.	Indefinite

Claim 7 depends from claim 3, which in turn depends from claim 1. Claim 1 and 7 recite, in relevant part:

1. A method of performing a payment transaction, the method comprising: . . .
dynamically generating, by a processor of the device, device-specific limited-use payment information, for said selected payment method; and,
using said limited-use payment information in place of at least a portion of said selected original issuer-supplied payment information for the transaction; and,
combining of said dynamically-generated limited-use payment information with said static limited-use payment information, to generate a complete device payment information; and,
transmitting said complete device payment information from said electronic device to a recipient reader via said NFC interface to the recipient NFC reader for a processing of the payment transaction . . .
visually conveying the transaction payment authorization status via a user-interface displayed on said display.
3. The method of claim 1 . . .
7. The method of claim 3, wherein the visual conveying of the transaction status is further comprising at least one, of a set of visual information including:
a confirmation result of payment authority authenticating said device-transmitted limited-use payment information,
a confirmation result of payment authority authenticating said device-transmitted complete device payment information . . .

’538 patent at 19:35–20:29, 20:34–39, 21:31–50 (annotated, disputed term in **underlined bold**).

Google asserts that because none of claims 1, 3, or 7 recites “device-transmitted limited-use payment information,” a POSITA would not understand what the term “limited-use payment information” refers to. Br. at 18–19; Black Decl., ¶ 47. Not so. The disputed “device transmitted limited-use payment information” phrase refers to the “dynamically-generated limited use payment information” (yellow) that, in claim 1, is combined with the “static limited-use payment information” to generate a “complete device payment information” (green).

This makes sense when claim 7 is considered in connection with the parallel structure and similar concept recited in claim 4. Claim 4, like claim 7, also discusses validation (i.e. “authenticating”) of both the “complete device payment information” and a sub-portion that is limited-use information. Specifically, claim 1 (from which claim 4 depends, via claim 3) requires “receiving information . . . corresponding to a transaction status [which is] at least partly dependent on validation of the transmitted complete device payment information by a payment processor authority and a payment issuer authority.” Claim 4 further recites, “wherein **said device account information** will be rejected as invalid when not including a **valid device generated limited-use information.**” ’538 patent at 20:40-48 (annotated). Accordingly, the validation by a payment processor authority recited in claim 4 requires a validation check of the “device generated limited-use information.” Same, too, with claim 7. Claim 7 recites a confirmation result of “said device-transmitted complete device payment information.” That is in yellow, above. And, like claim 4, it recites confirmation of the dynamically generated limited-use payment information. That is the part in green, above.

Google is correct that the disputed phrase in claim 7 refers to “device-transmitted limited-use payment information,” and not “dynamically generated limited-use payment information.” But it is referring to the same thing—claims 4 and 7 refer to validation by a payment authority of

the complete payment information and the portion thereof that is dynamically-generated limited-use information. *See Energizer Holdings, Inc. v. Int’l Trade Comm’n*, 435 F.3d 1366, 1369–70 (Fed. Cir. 2006) (finding that “said zinc anode” refers to “anode gel comprised of zinc as the active anode component” recited earlier in the same claim). CardWare’s construction is also consistent with the specification, which explains that the dynamically *generated* number can be verified by the “payment authority.” *See, e.g., id.* at 10:30-33 (“a unique number may be *generated* by the multi-function electronic device and verified by the payment authority.”) (emphasis added).

Google also argues that CardWare’s filing of a CoC related to claim 1 affects the analysis of claim 7. Br. at 18. It does not. The CoC corrected minor linguistic issues, *inter alia*, deleting “the” found between “wherein” and “authorizing” in claim 1, replacing “using said limited-use payment information” with “using said limited-use payment informations” in claim 1. Ex. B. The changes to claim 1 have no bearing on the understandability of the terms of claim 7 (which must be analyzed in their own context).

For the reasons discussed above, Google has not demonstrated by clear and convincing evidence that “[device-transmitted] limited-use payment information” in claim 7 is indefinite.

3. “said information” (claim 9)

Plaintiff’s Proposed Construction	Defendant’s Proposed Construction
Not indefinite. Plain and ordinary meaning.	Indefinite

Claim 9 depends from Claim 8, which in turn depends from Claim 1. Claims 1, 8, and 9 recite, in relevant part:

1. A method of performing a payment transaction, the method comprising . . .
dynamically generating, by a processor of the device, device-specific limited-use payment information, for said selected payment method; . . .
8. The method of claim 1, wherein the generating the limited-use payment information is comprising:
a device-specific account number; and

a device-internal transaction sequence counter count; and

an information unique to the user and device which does not pass in the transaction; and,

at least one payment authority-supplied information which does not pass in the transaction, wherein the complete device payment information is only valid for use in place of an issuer payment method in authorizable payments when comprising all valid device generated limited-use information elements, and

wherein said generating is limiting in-scope-of-use said generated payment information . . . by combining said information elements including: said transaction-specific sequence count information, said device-specific information, said user-specific information, and said authority-specific information.

9. The method of claim 8, wherein the generating the limited-use payment information further utilizes a secure combining of said information, by at least one processor of the device, into a singular cryptogram number, capable of passing in at least a portion of the device transaction payment information.

'538 Patent at 19:35–20:29, 21:51–22:10 (annotated, disputed term in **underlined bold**).

Google asserts that “said information” recited in claim 9 is indefinite because the antecedent for “said information” may be any, or some combination, of the different types of “information” recited in Claims 1 and 8. Br. at 15–16; Black Decl., ¶ 45. Google is incorrect. “[S]aid information” in claim 9 refers to the four pieces of “information” introduced in claim 8, from which claim 9 depends.

There is only one introduction in this claim set (claim 1 and its dependent claims, including claims 8 and 9) of “generating” a “limited-use payment information” (yellow). That comes from claim 1, which requires “dynamically generating . . . device-specific limited-use payment information.” Claim 1 does not specify the inputs into that dynamic generation of limited-use payment information. But claim 8 does, specifying four pieces of information that are inputs to that dynamic generation. Indeed, claim 8 states as much—its introductory phrase is “wherein the generating the limited-use payment information” comprises four pieces of information (green), referring back to the only prior instance of generating limited-use payment information (from claim 1). Claim 8 further indicates (in the last limitation) that these same four pieces of information

(green) are combined. Claim 9 depends from claim 8 and goes one step further, indicating that the generating step utilizes a “secure combining” of “said information.” That is, “said information” of claim 9 refers to the four pieces of information introduced in claim 8.

This is the only logical reading from the context of the claim. It is also consistent with the specification of the ’538 patent, which discloses that these same four elements may be combined “to generate a limited-use payment number.” *See, e.g.*, ’538 patent at cols. 18–19, Table 1 (“[S]aid device . . . generates a sequential parameter . . . which along with certain user information, transaction identifiers, user secrets, payment authority secrets is combined to generate a limited-use payment number[.]”).

Google claims that “said information” of claim 9 is indefinite because (per Google) it could be any of the other types of information introduced in claim 1 or 8. Br. at 16; Black Decl., ¶ 45. That overly-simplistic analysis plays off the various types of recited “information” to imply some inherent confusion, but ignores the context of the claim language. Claim 9 states that “**the generating the limited-use payment information** further utilizes a secure combining of said information . . .” From this introductory language, we know that the focus of claim 9 is directed to the generating the limited-use payment information. Therefore, “said information” cannot be, for example, the “device-specific static limited-use payment information” as Google suggests, because that information is not “generated.” Rather, that device-specific static information is “retrieved from a memory,” as recited in claim 1.

Nor can “said information” be a single piece of information from claim 8, such as the “information unique to the user and device,” as Google alternatively suggests. Claim 9 (and also claim 8) indicate that it is “combining said information.” The word “combining” indicates that “said information” must be multiple pieces of information; it would be a non-sequitur to combine

a single piece of information. Google ignores all of these important contextual considerations, and effectively tries to shift the burden to CardWare to prove definiteness. Google’s expert fares no better, and again just regurgitates the same English language semantics exercise that Google proffers in its brief, without applying any expertise, identifying any underlying technical facts on which this claim construction dispute turns, or considering the context of the claim language. Black Decl., ¶ 42. Black Tr. at 153: 1-7; 154:15-155:3 (Q: “And did you describe . . . that greater context in your declaration?” A: “I don’t refer to that specific part of claim 8 or 9 where it talks about combining information in my declaration.”)

4. “said information” (claim 27)

Plaintiff’s Proposed Construction	Defendant’s Proposed Construction
Not indefinite. Plain and ordinary meaning.	Indefinite

Google is wrong that “said information” (as bolded and underlined below) is indefinite; it parallels the structure in the immediately preceding limitation and refers to “a payment account information, [and] a user information,” as shown and discussed below.

27. The non-transitory, computer-readable medium of claim 25, wherein the one or more processors include a cryptographic processor, and wherein the executable instructions further cause the one or more processors to: . . .

wherein further said cryptogram number is created by said device processor cryptographic combination of device transaction sequence counter count, a payment account information, a user information, and information stored in the device and specific to the device and which is not communicated in the transaction; and,

wherein said transaction sequence counter, said information and said secrets are known to both said device, and to said payment processing authority; and . . .

’538 Patent at 24:49–25:15, 25:41–26:5 (annotated, disputed term in **said information**).

Claim 27 recites “said cryptogram number is created by said device . . . combination of device transaction sequence counter count, a payment account information, a user information, and information stored in the device and specific to the device and which is not communicated in

the transaction.” A “wherein” clause immediately follows that recites, “wherein said transaction sequence counter, said information and said secrets are known to both said device, and to said payment processing authority.” Therefore, it logically follows, without any need to look beyond the claim language itself, that “said information” corresponds to the “a payment account information, [and] a user information,” as recited in the parallel structure of Claim 27. In other words, in the wherein clause, “said transaction sequence counter” (in blue) must refer to the “device transaction sequence count” in the preceding limitation; both of those phrases refer to sequence counts. Google does not dispute that. Similarly, “said secrets,” (in yellow) refers to the “information stored in the device and specific to the device and which is not communicated in the transaction” in the preceding limitation. The fact that this is “not communicated” is the clue that this is *secret* information. What is left from the immediately preceding limitation? It is the “payment account information” and the “user information,” as shown in green. This is therefore what is being referenced with “said information.” The claim phrases are even described in the same order—blue, green, then yellow—in both limitations. This explanation is also consistent with the specification. See ’538 patent at cols. 18–19, Table 1 (“[S]aid device . . . generates a sequential parameter . . . which along with certain user information, transaction identifiers, user secrets, payment authority secrets is combined to generate a limited-use payment number[.]”).

Google’s assertions that “said information” could refer to other “information” elements from claim 25 lack merit. For example, “online purchase information” and “merchant information” would not be “known to both said device, and to said payment processing authority,” as required by the disputed claim phrase.

5. “said secrets” (claim 27)

Plaintiff’s Proposed Construction	Defendant’s Proposed Construction
Not indefinite. Plain and ordinary meaning.	Indefinite

Google asserts that a POSITA would not be reasonably certain about the scope of “said secrets” because the word “secrets” is not recited in elsewhere in claim 27 or its parent claim 25. Br. at 19–20; Black Decl., ¶¶ 48-49. Google is incorrect.

As explained above, *supra* Section III.C.4, claim 27 recites “cryptographically comput[ing] a one-time-use cryptogram number,” by a “combination of **device transaction sequence counter count**, **a payment account information, a user information**, and **information stored in the device and specific to the device and *which is not communicated in the transaction***.” ’538 patent at 25:51–56 (annotated and emphasis added). The immediately following limitation recites “wherein **said transaction sequence counter**, **said information** and **said secrets** are known to both said device, and to said payment processing authority.” *Id.* at 25:57–59 (annotated, disputed term in **underlined bold**). Because “the information stored in the device and specific to the device” is *not communicated in the transaction* but is still known to the device and the payment processing authority, then such information must constitute “secrets” (because only the device and the payment processing authority know them, and they cannot be intercepted because they are not communicated in a transaction). Therefore, it logically follows, that the term “said secrets” corresponds to the “information stored in the device and specific to the device and *which is not communicated in the transaction*.” Even Google’s expert agrees. *See* Black Tr. 162:17-163:10.

For the reasons discussed above, Google has not demonstrated by clear and convincing evidence that “said secrets” in claim 27 is indefinite.

IV. CONCLUSION

For the foregoing reasons, CardWare respectfully requests that the Court enter an order finding that all of the aforementioned claim terms are not indefinite and rejecting the positions Google advances in its constructions.

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Respectfully submitted,

/s/ Eric H. Findlay

Eric H. Findlay

State Bar No. 00789886

Brian Craft

State Bar No. 04972020

FINDLAY CRAFT, P.C.

7270 Crosswater Avenue, Suite B

Tyler, Texas 75703

Tel: (903)534-1100

Fax: (903)534-1137

efindlay@findlaycraft.com

bcraft@findlaycraft.com

Matthew G. Berkowitz (*pro hac vice*)

Yue (Joy) Wang (*pro hac vice*)

Navid C. Bayar (*pro hac vice*)

Leaf Williams (*pro hac vice*)

Timothy Trost (*pro hac vice*)

Reichman Jorgensen Lehman & Feldberg LLP

100 Marine Parkway, Suite 300

Redwood Shores, CA 94065

Tel: (650) 623-1401

mberkowitz@reichmanjorgensen.com

ywang@reichmanjorgensen.com

nbayar@reichmanjorgensen.com

lwilliams@reichmanjorgensen.com

ttrost@reichmanjorgensen.com

Caroline Walters (*pro hac vice*)

Khue Hoang (*pro hac vice*)

Patrick Colsher

Reichman Jorgensen Lehman & Feldberg LLP

400 Madison Avenue, Suite 14D

New York, NY 10017

Tel: (212) 381-1965

cwalters@reichmanjorgensen.com

khoang@reichmanjorgensen.com

pcolsher@reichmanjorgensen.com

Attorneys for Plaintiff

CERTIFICATE OF SERVICE

I hereby certify that on the 12th day of June, 2025, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system, which will send notification of such filing to all counsel of record.

/s/ Eric H. Findlay
Eric H. Findlay