

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
NORFOLK DIVISION**

)
)
NADER ASGHARI-KAMRANI and
KAMRAN ASGHARI-KAMRANI,
)

Plaintiffs,
)

v.
)

UNITED SERVICES AUTOMOBILE
ASSOCIATION,
)

Defendant.
)
)
)
)

Civil Action No. 2:15-cv-00478-RGD-LRL

Hon. Robert G. Doumar

PARTIES’ JOINT STATEMENT ON CLAIM CONSTRUCTION

Pursuant to the Court’s Rule 16(b) Scheduling Order dated May 3, 2016 [Dkt. No. 54], Plaintiffs Nader Asghari-Kamrani and Kamran Asghari-Kamrani (“Plaintiffs”) and Defendant United Services Automobile Association (“USAA”) submit this joint statement in anticipation of a *Markman* hearing. The patent at issue is U.S. Patent No. 8,266,432.

I. CLAIM CONSTRUCTIONS TO WHICH THE PARTIES AGREE

At this point, the parties agree on these constructions of claim terms.

Term/Phrase	Claims	Construction
“to authenticate a user” / “for authenticating a user” / “authenticate a user’s identity” / “authenticate the user” / “authenticating a user” / “authenticating the user” / “authenticating [by the central- entity] the user”	All	“To determine that a user is who he says he is.” (Where a “user” is not necessarily a human individual.)
“alphanumeric”	All	“Including at least one letter and at least

Term/Phrase	Claims	Construction
		one number.”

II. EACH SIDE’S CONSTRUCTION OF DISPUTED CLAIM TERMS

The parties’ proposed constructions of disputed terms are identified in Appendix A hereto.

Plaintiffs contend that the Rule 16(b) Scheduling Order did not request “USAA’s Evidence” and “Plaintiffs’ Evidence” for their claim construction positions at this time, apart from a summary/outline of any witness testimony. Accordingly, Plaintiffs will set forth the intrinsic and extrinsic evidence supporting their claim constructions in their *Markman* briefs.

III. EACH SIDE’S REBUTTAL TO THE OPPOSING PARTY’S PROPOSED CONSTRUCTION

A. Plaintiffs’ Rebuttal

USAA’s claim constructions are based on a number fundamental errors in the law of claim construction. First, USAA improperly reads limitations from the specification into the claims. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1319-20 (Fed. Cir. 2005) (*en banc*) (quoting *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1340 (Fed. Cir. 2001) (describing reading limitations from the specification into the claims as a “cardinal sin” of patent law). USAA’s claim constructions tend to read claim terms as incorporating every single limitation that USAA can find disclosed in the specification, which is erroneous.

USAA also misreads the prosecution history for disavowals of claim scope where there is plainly none. Disavowal, or disclaimer of claim scope, is only considered when it is *clear and unmistakable*. See *SciMed Life Sys.*, , 242 F.3d at 1341; see also *In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d 1359, 1365-67 (Fed. Cir. 2004) (refusing the limit claim term “user computer” to only “single-user computers” even though “some of the language of the specification, when

viewed in isolation, might lead a reader to conclude that the term . . . is meant to refer to a computer that serves only a single user, the specification as a whole suggests a construction that is not so narrow”).

USAA’s citations to expert witness testimony are extrinsic evidence and should therefore only be considered after intrinsic evidence. *Phillips*, 415 F.3d at 1317-18. Furthermore, expert witness testimony in regard to claim construction is even less than reliable than *objective* extrinsic evidence such as technical dictionaries, since expert witness testimony may be biased and self-serving.

For most of the apparently disputed claim language, the terms should be given their plain and ordinary meaning. *Phillips*, 415 F.3d at 1312-13 (citing *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)).

Since Plaintiffs only received USAA’s claim construction arguments minutes before the filing deadline, they will rebut USAA’s claim constructions in detail in the *Markman* briefing.

B. USAA’s Rebuttal

a. transaction

Plaintiffs contend that this term should be understood according to its ordinary meaning, and that USAA’s proposed construction is not within that ordinary meaning. But Plaintiffs have already conceded in filings with the Patent Office in an *Inter Partes* Review of the patent-in-suit that USAA’s is the “broadest reasonable interpretation” of the term “transaction.” Having made that admission, Plaintiffs may not now be seen to broaden this term in an attempt to reclaim scope that they have previously surrendered. *E.g., TomTom, Inc. v. Adolph*, 790 F.3d 1315, 1325 (Fed. Cir. 2015) (“where the patentee has unequivocally disavowed a certain meaning to obtain his patent, the doctrine of prosecution disclaimer attaches and narrows the ordinary meaning of the claim congruent with the scope of the surrender”); *InTouch Techs., v. VGO*

Comms., Inc., 751 F.3d 1327, 1341-42 (Fed. Cir. 2014) (explaining that the reexamination history is part of the prosecution history); *Grober*, , 686 F.3d at 1341 (applying doctrine of prosecution disclaimer to reexamination proceedings); *Aylus Networks, Inc. v. Apple, Inc.*, 2016 WL 270387 at *5 (N.D. Cal. January 21, 2016) (holding that Patentee’s statements in a Preliminary Patent Owner Response, like relied on here, “are akin to a prosecution disclaimer” under which the “patentee is held to what he declares during the prosecution of his patent”).

b. dynamic code

Plaintiffs’ proposal of “a substantially nonpredictable and temporary digital code” fails for a number of reasons. First, use of the term “substantially” in this manner renders their proposed construction indefinite. Second, Plaintiffs admitted in the *Inter Partes* Review proceeding, “[t]he term ‘dynamic code’ has a substantially similar scope with ‘SecureCode’ as defined in the specification.” USAA’s proposed construction tracks the definition in the specification of the ’432 Patent at 2:35-40, with a few tweaks for clarity. Third, Plaintiffs have already admitted in the *Inter Partes* Review that the broadest reasonable interpretation of the term “dynamic code” is “any dynamic, non-predictable and time dependent alphanumeric code, secret code, PIN or other code, which may be broadcasted to the user over a communication network, and may be used as part of a digital identity to identify a user as an authorized user.” *E.g., TomTom, Inc. v. Adolph*, 790 F.3d 1315, 1325 (Fed. Cir. 2015) (“where the patentee has unequivocally disavowed a certain meaning to obtain his patent, the doctrine of prosecution disclaimer attaches and narrows the ordinary meaning of the claim congruent with the scope of the surrender”); *InTouch Techs., v. VGO Comms., Inc.*, 751 F.3d 1327, 1341-42 (Fed. Cir. 2014) (explaining that the reexamination history is part of the prosecution history); *Grober*, , 686 F.3d at 1341 (applying doctrine of prosecution disclaimer to reexamination proceedings); *Aylus Networks, Inc. v. Apple, Inc.*, 2016 WL 270387 at *5 (N.D. Cal. January 21, 2016) (holding that

Patentee's statements in a Preliminary Patent Owner Response, like relied on here, "are akin to a prosecution disclaimer" under which the "patentee is held to what he declares during the prosecution of his patent"). Finally, Plaintiffs have admitted that any given code is *only* used *once*. Mar. 8, 2016 Hrg. Tr. at 11:16-20 ("Every time you generate a code, it's a new code."); accord POPR at 23; '432 file history, Page 17 of 8/10/10 Office Action Response; '837 file history, Pages 7, 9 of 8/30/05 Office Action Response.

c. central-entity and external-entity

Plaintiffs' constructions of these terms are overbroad because they pay no mind to the intrinsic record. Plaintiffs' first mistake is that they ignore that their own patent defines these terms. *See* Plaintiffs' Patent Owner's Preliminary Response ("POPR") in IPR2015-01842 at 11 (admitting that the '432 patent defines these terms). At column 2, lines 13-26 and lines 52-63, the Court will find that the '432 patent provides explicit definitions for these terms, which are irreconcilable with Plaintiffs' constructions. It would be error for this Court to ignore the Patentees' own definitions of these terms and for that reason alone, Plaintiffs' constructions are improper. *E.g., Jack Guttman, Inc. v. Kopykake Enterprises, Inc.*, 302 F.3d 1352, 1360-61 (Fed. Cir. 2002).

Plaintiffs' constructions err not just in failing to account for the requirements of a "central-entity" and "external-entity" set out in the '432 patent, but also by adding a requirement that makes no sense. Plaintiffs suggest that the "central-entity" and "external-entity" are not "entities" or "parties" as described in the specification, but rather are *computers*. The '432 patent is very clear that an "external-entity" is, among other things, "any *party* offering goods or services" and that a "central-entity" is, among other things, "any *party* that has a user's personal and/or financial information." '432 patent, col. 2:13-26 (emphasis added). This requirement is also inconsistent with the claims, which recite both a "central-entity" and a "computer associated

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