



## I. INTRODUCTION

In order to manufacture nonexistent disclaimers from out-of-context prosecution history snippets, Defendants blatantly ignore the applicable legal standard: “argument-based disavowals will be found . . . only if they constitute clear and unmistakable surrenders of subject matter.” *Cordis Corp. v. Medtronic AVE, Inc. (Cordis II)*, 511 F.3d 1157, 1177 (Fed. Cir. 2008); *accord N. Telecom Ltd. v. Samsung Elec. Co.*, 215 F.3d 1281, 1293-95 (Fed. Cir. 2000). This is necessary because a patent’s prosecution history “often lacks the clarity of the specification and thus is less useful for claim construction purposes.” *Digital-Vending Servs. Int’l, LLC v. Univ. of Phoenix, Inc.*, 672 F.3d 1270, 1276 (Fed. Cir. 2012) (citations omitted). Prosecution disclaimer cannot apply to statements that are amenable to multiple reasonable interpretations. *See SanDisk Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278, 1287 (Fed. Cir. 2008); *Cordis Corp. v. Medtronic AVE, Inc. (Cordis I)*, 339 F.3d 1352, 1359 (Fed. Cir. 2003). Further, “statements by the applicants must be read in the context of its overall argument . . . .” *Lucent Techs., Inc. v. Gateway, Inc.*, 525 F.3d 1200, 1211 (Fed. Cir. 2008). These legal standards demonstrate that Defendants’ purported “disclaimers” do not exist.

## II. CONSTRUCTION OF TERMS

### A. *Motion Control “Operation” and “Device” Terms*

#### 1. “motion control” (term no. 1)

Purporting to rely on a prosecution disclaimer, Defendants ignore the RGB Patents’ teaching that “the principles of the present invention are generally applicable to *any* mechanical system that generates *movement based on a control signal*.” Ex. 2 at 1:34-36 (emphasis added).<sup>1</sup> But Defendants’ purported justification is fundamentally flawed: RGB never argued that prior

<sup>1</sup> In the main, RGB cites to the previously referenced exhibits in RGB’s opening brief and Defendants’ responsive brief. Other exhibits are denominated as “New Exhibits.”

art was distinguishable because it taught “controlled movement” and not moving an “object” along a “desired path.” Defendants cite the Levy Declaration, which explains that “no type of printing language or implementation of printer drivers I am familiar with can be described as ‘a method of moving an object.’” Dfs’ Ex. N, ¶ 32. But that paragraph does not even mention “motion control,” much less disclaim a broad meaning of that term. And even the cases on which Defendants purport to rely recognize that, “[p]rosecution disclaimer does not apply . . . if the applicant simply describes features of the prior art and does not distinguish *the claimed invention* based on those features.” *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1375 (Fed. Cir. 2008) (emphasis added); *see also Grober v. Mako Prods., Inc.*, 686 F.3d 1335, 1342 (Fed. Cir. 2012); *Eolas Techs, Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1337 (Fed. Cir. 2005). The sentence that Defendants cite in the Levy Declaration merely compares the prior art to the embodiment in the patent at column 3, *not to the claim term “motion control.”*

Defendants also cite four bullet points to justify limiting “motion control” to an “object” and a “desired path.” Dfs’ Brf. at 5. But the cited passages do not refer to an “object” or a “desired path.” Further, they actually *undercut* Defendants’ position. For example, Defendants cite Mr. Malina’s statement that “Motion Control *encompasses* the coordinated real-time control of multiple actuators . . . to achieve control of linear *or rotary directions of motion*, velocities of movement, positions, and output torques.” Dfs’ Brf. at 5 (emphases added). The statement reflects that motion control “*encompasses*” certain things, not that it is *limited* to those things.

## 2. “motion control operation” (term no. 2)

“A claim construction that excludes the preferred embodiment is rarely, if ever, correct . . .” *Adams Respiratory Therapeutics, Inc. v. Perrigo Co.*, 616 F.3d 1283, 1290 (Fed. Cir. 2010) (citations omitted). Here, Defendants concede that Appendices A and B reflect RGB’s preferred

embodiment. And, despite Defendants' protestations to the contrary, their proposed construction would indeed exclude some of the operations in Appendix A.

Defendants argue that their proposed construction "does not require each individual operation to control motion." Dfs' Brf. at 7. This is incorrect. Defendants' proposed construction for "motion control operations" (taking account of Defendants' proposed construction for "motion control") is "hardware independent operations [*used to perform control of movement of an object along a desired path*] (such as GET POSITION, MOVE RELATIVE, or CONTOUR MOVE)." Ex. 9. Thus, to qualify as a "motion control operation" under Defendants' proposed constructions, the operation must indeed be "used to perform control of movement of an object along a desired path." Defendants' proposed construction therefore improperly excludes motion control operations that are not used to perform control of movement, including Get Position, Reset, Initialize, Shut Down, and Get Error Status. Yet these are exemplary motion control operations in RGB's preferred embodiment. RGB's Opening Brief ("Op. Brf.") at 4-6. Indeed, Get Position is called out specifically. Ex. 2 at 7:32-39.

Defendants also incorrectly argue that RGB's reliance "on 'motion control operations' to distinguish prior art during Reexam" is a disavowal of motion control operations that do not directly cause movement. Dfs' Brf. at 6-7, citing an RGB PTO Response (Dfs' Ex. B at 37-39) and the McConnell Declaration (Dfs' Ex. O, ¶14). But these documents distinguish "motion control operations" from "graphics operations" on a computer screen. Mr. McConnell explained that the GDI operations are "drawing operations which are performed via a Graphical Device Interface." Dfs' Ex. O, ¶14. These graphics operations give only the "illusion of motion created by changing the colors of individual pixels on a computer display." *Id.* An example is a screen saver that appears to move on the screen. Consistent with the prosecution history, RGB is *not*

attempting to cover these “graphics operations.” RGB’s construction for “motion control operations” is “operations performed on or by a motion control device,” where a “motion control device” comprises a “controller and a mechanical system.” In short, RGB never disclaimed any of the *motion control operations* taught in the RGB Patents or appendices.

Defendant ABB’s recent statement to the PTO confirms RGB’s proposed construction:

The process of controlling an MCD begins by defining several *physical actions capable of being performed by MCDs* in the abstract (“motion control operations”). . .

New Exhibit 27 at 4-5 (emphasis added). ABB agrees that “motion control operations” are merely “operations performed on or by a motion control device” (which ABB calls “MCDs).

### 3. “non-primitive operations” (term no. 3)

Although Defendants now attempt to ignore the RGB Patents’ lexicography, their summary judgment motion on indefiniteness admits that “[t]he patents describe a non-primitive operation as any operation that ‘do[es] not meet the definition of a primitive operation[.]’” Dkt No. 164 at 3. Significantly, Defendants acknowledge that a non-primitive operation merely “includes” (and is not “limited to,” as they argue here) “any operation that can be simulated using a combination of other (*i.e.*, primitive) operations.” *Id.*

Contrary to Defendants’ accusation, RGB’s application of “necessary for motion control” has not varied. For example, RGB’s position regarding “Move Relative” is completely consistent with its position regarding “Open Shutter” and “Close Shutter.” Because the “Move Relative” operation *is required for some classes of motion control devices*, it meets the “necessary for motion control” requirement. In contrast, the WOSA/XFS standard creates two classes of cash dispensing machines: ATMs and ATSS. But in contrast to “Move Relative,” the “Open Shutter” and “Close Shutter” operations are not required in *either* class of devices. In ATSS, those operations are “not supported;” in ATMs, those operations are “optional.” Because

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