IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

ANCORA TECHNOLOGIES, INC., Ancora, v. LG ELECTRONICS INC. and LG ELECTRONICS U.S.A., INC., Defendants.	CIVIL ACTION NO. 1:20-cv-0034 JURY TRIAL DEMANDED
ANCORA TECHNOLOGIES, INC., Ancora, v. SAMSUNG ELECTRONICS CO., LTD. and SAMSUNG ELECTRONICS AMERICA, INC., Defendants.	CIVIL ACTION NO. 1:20-cv-0034 JURY TRIAL DEMANDED

DEFENDANTS' REPLY IN SUPPORT OF MOTION FOR RECONSIDERATION

I.   INTRODUCTION

Under the Court's construction, the relevant limitation ("using an agent") now reads:

> using *a software program or routine* to set up a verification structure in the erasable, non-volatile memory of the BIOS, the verification structure accommodating data that includes at least one license record.

In view of *Egenera*, this construction of the nonce term "agent" cannot avoid § 112, ¶ 6. Instead,

a "software program or routine," like the construction in *Egenera*, is "so broad and formless as to

be a generic black box for performing the recited computer-implemented functions." *Egenera*

Inc. v. Cisco Systems, Inc, --- F.3d ----, 2020 WL 5084288 at *4 (Fed. Cir. Aug. 28, 2020)

(quoting *Egenera Inc. v. Cisco Systems*, 2018 WL 717342, at *6 (D. Mass. Feb. 5, 2018)).

Plaintiff focuses its efforts on distinguishing the Court's construction for the "agent" term from the construction proposed in *Egenera*. This is a distinction without a difference: "a software program or routine" provides no more structure to claim 1 of the '941 patent than "software, firmware, or circuitry" provided in *Egenera*, as both set forth "the same black box recitation of structure . . . as if the term 'means' had been used." *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1350 (Fed. Cir. 2015). Nothing in Plaintiff's rebuttal refutes this basic fact.

Plaintiff ignores, and therefore apparently concedes, that *Egenera* has precluded any supporting structure that the "agent" term might have claimed through its activity "in the erasable, non-volatile memory of the BIOS." Nor can intrinsic evidence provide that structure, as the '941 patent does not mention the "agent" term in any section of the specification. Thus, the "using an agent" limitation is a means-plus-function limitation under § 112, ¶ 6.

II.   LEGAL STANDARD

Plaintiff relies on invalidated pre-*Austin* case law to suggest that the Court follow the heightened standard of Rule 59(e). ECF No. 104 at 1-2. But *Austin* is clear — reliance on the Rule 59(e) standard for interlocutory review is legal error and grounds for review. *Austin v. Kroger Tex., L.P.*, 864 F.3d 326, 337 (5th Cir. 2017) (vacating part of the district court's opinion since it "evinces a clear reliance on the heightened standard of Rule 59(e) to deny [appellant's] motion for reconsideration."). Instead, Defendants' motion must be considered under Rule 54(b).

III.   ARGUMENT

Construing the "agent" term as "a software program or routine" fails to provide sufficient structure, and the intrinsic evidence of the '941 patent cannot compensate for this failure.

A.   *Egenera* Shows That Plaintiff's Intrinsic Evidence Is Insufficient

Plaintiff never claims that "software," by itself, connotes sufficient structure, but instead relies on the specification and prosecution history to provide this structure. ECF No. 104 at 5-8.

Plaintiff claims that Defendant's suggestion of corresponding structure under § 112, ¶ 6 "is fatal to their argument that 'agent' invokes § 112, ¶ 6." ECF No. 104 at 7. ***Plaintiff's arguments turn the standard on its head.*** "Indeed, this view would seem to leave § 112, ¶ 6 without any application: any means-plus-function limitation that met the statutory requirements, i.e., which includes having corresponding structure in the specification, would end up not being a means-plus-function limitation at all." *MTD Products Inc. v. Iancu*, 933 F.3d 1336, 1344 (Fed. Cir. 2019). In other words, under Plaintiff's interpretation, only claims that lack corresponding structure in the specification (i.e., indefinite claims) will be governed by § 112, ¶ 6. The claims are interpreted in light of the specification whether or not claim construction involves interpreting a "means" limitation. *Id.* at 1342–43. Unless the patentee demonstrates a clearly expressed intent to act as its own lexicographer and defines the nonce term as the term used in the preferred embodiment, "a preferred embodiment disclosed in the specification cannot impart structure to a term that otherwise has none." *Id*. Here, the specification cannot lend structure to the claims because the '941 patent never identifies any structure as corresponding to the "agent" term. *See id.* at 1344. "Indeed, the specification does not even refer to [the claim term]." *Id.* Thus, Plaintiff's reliance on the specification is misplaced.[1]

Plaintiff also relies on the prosecution history of the '941 patent. ECF No. 104 at 7-8. But, as discussed above, this prosecution history cannot provide structure to avoid § 112, ¶ 6 that is lacking in the "agent" term and the surrounding claim language. The examiner's summary of the "agent" term is, in any case, "not inconsistent with claiming in means-plus-function format," as it discloses only that the "agent" acts as a means to achieve particular functions. *MTD Products*, 933 F.3d at 1345. In addition, as Defendants have argued, the prosecution history

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[1] *See* ECF No. 104 at 7 (relying on 1:60-2:1, 3:51-61, and 6:18-28).

cannot provide structure to the "agent" term when that term was specifically added as a novel component to overcome the prior art. *See* ECF No. 49 at 3-5.

While intrinsic evidence can inform interpretation of the claim elements, "the focus remains on whether the claim as properly construed recites sufficiently definite structure to avoid the ambit of § 112, ¶ 6." *Personalized Media Commc'n., LLC v. Intl. Trade Comm'n.*, 161 F.3d 696, 704 (Fed. Cir. 1998). *Egenera* has established that the '941 patent claims cannot provide this structure because "[m]ere inclusion of a limitation within a structure does not automatically render the limitation itself sufficiently structural." 2020 WL 5084288 at *5. The claims state only that the agent "set[s] up a verification structure" — which is pure function — "in the erasable, non-volatile memory of the BIOS" — which is precisely the inclusion within a structure that *Egenera* has rejected. '941 Patent at 6:64-65. Plaintiff's argument that the claim "describes a piece of software within a specific piece of hardware for a specific purpose," ECF No. 104 at 6, proves that this claim cannot provide sufficient structure. Plaintiff does not contest this point.

The Federal Circuit has established a two-step process for means-plus-function analysis. First, the Court must "determine if the claim limitation is drafted in means-plus-function format." *MTD Products*, 933 F.3d at 1344. Second, the Court must "review the specification to identify the structure that performs the claimed function(s)." *Id.* In *MTD Products*, the Federal Circuit determined that the PTAB had erroneously "conflated these distinct inquiries, holding that the specification's disclosure of corresponding structure demonstrates that the alleged means-plus-function term is sufficiently definite so as to not invoke § 112, ¶ 6." *Id.* Ancora commits the same mistake by relying on the specification to provide structure that is absent in the claims.

B.   Software, By Itself, Does Not Connote Sufficient Structure

In their opening brief, Defendants noted that the Court's construction of 'agent' as "a software program or routine" did not, by itself, connote sufficient structure to avoid § 112, ¶ 6.

ECF No. 100 at 5-7. This is consistent with the Court's Claim Construction Order, which also refused to hold that "a software program or routine," by itself, connotes sufficient structure. ECF No. 93 at 34-35 (distinguishing *Digital Retail*, 2020 WL 376664 (W.D. Tex. Jan. 23, 2020), which established that "software alone did not connote structure," by relying on the claims and specification to provide structure). *Egenera* confirms that claim terms based on "software" do not, by themselves, convey sufficient structure.

Plaintiff claims that "dozens of post-Williamson cases " have held that software connotes sufficient structure. ECF No. 104 at 8-9. Five of the seven such cases cited by Plaintiff, however, held that "software" avoided § 112, ¶ 6 *when supported by sufficient structure in the claims*[2]— thus demonstrating that "software" is not, by itself, sufficient to avoid § 112, ¶ 6. The two inapposite cases—one pre-*Williamson* and the other from the District of Massachusetts—do not tip the balance of the case law, including this Court's holding in *Digital Retail*.

IV.   CONCLUSION

Defendants request that the Court reconsider its construction of the "agent" term.

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[2] *See Bascom Glob. Internet Servs., Inc. v. AT&T Corp.*, 2017 WL 5905698, at *16 (N.D. Tex. Sept. 20, 2017) (holding that a claim term construed as "software" could avoid § 112, ¶ 6 because "[t]he claims themselves disclose logical rules for achieving the functions described"); *Collaborative Agreements, LLC v. Adobe Sys. Inc.*, 15-CV-03853-EMC, 2015 WL 7753293, at *5 (N.D. Cal. Dec. 2, 2015) (holding that a claim term that described a form of software could avoid § 112, ¶ 6 because "the claim language here provides a description as to how the code segment operates"); *USA, Inc. v. Autodesk, Inc.*, 2016 WL 3647977, at *19 (E.D. Tex. July 7, 2016) (holding that "add-on computer software code," a much narrower term than "software," could avoid § 112, ¶ 6 because "[t]he claims connote that the [term] is structural by describing how the [term] operates within the claimed invention to achieve its objectives."); *Kit Check, Inc. v. Health Care Logistics, Inc.*, 2019 WL 4142719, at *12-13 (S.D. Ohio Aug. 30, 2019) (holding that "computer executable instructions" could avoid § 112, ¶ 6 because "[t]he claims specify how the processors receive information . . . and from where . . . . Taken together, these "computer executable instructions" claims describe the "objectives and operations of the instructions."); *Syncpoint Imaging, LLC v. Nintendo of America Inc.*, 2016 WL 55118, at *23 (E.D. Tex. Jan. 5, 2016) (addressing "instructions," and determining that those instructions avoided § 112, ¶ 6 at least in part because "[the claims] themselves recite the objectives and operations of the instructions in the [relevant] limitations").

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