

**UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA**

Case No. 1:16-cv-21761-KMM

PRISUA ENGINEERING CORP.,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD. et al.,

Defendants.

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MARKMAN ORDER

THIS CAUSE came before the Court upon the Markman Hearing held before the Court on July 7, 2017, relative to United States Patent No. 8,650,591 (the “591 Patent”). Plaintiff Prisua Engineering Corp. (“Prisua”) filed a claim construction brief (ECF No. 42). Defendants Samsung Electronics Co., Ltd. (“Samsung Korea”), Samsung Electronics America, Inc. (“Samsung America”), and Samsung Electronics Latinoamerica Miami (“Samsung Miami”) (collectively, “Samsung”) responded (ECF No. 50). Prisua replied (ECF No. 53), and Samsung filed a surreply (ECF No. 72). UPON CONSIDERATION of the ‘591 Patent, the prosecution history, the Parties’ briefs, the evidence presented at the Markman Hearing, the arguments of counsel, the pertinent portions of the record, and being otherwise fully advised in the premises, this Court enters the following Order.

I. BACKGROUND

On May 17, 2016, Prisua, a corporation organized in Florida with a principal place of business in Coral Gables, Florida, filed a Complaint (ECF No. 1) for patent infringement against Samsung pursuant to Title 35 of the United States Code, Section 271. *See* Pl.’s Compl. ¶¶ 1–5.

Prisua owns the ‘591 Patent, entitled “Video Enabled Digital Devices for Embedding User Data in Interactive Applications.” *Id.* ¶ 9. The ‘591 Patent was filed by the inventor, Dr. Yolanda Prieto, an officer and director of Prisua, on March 8, 2011, and issued by the U.S. Patent Office on February 11, 2014. *Id.* ¶¶ 10–11. Claim 1 of the ‘591 Patent states in relevant part:

An interactive media apparatus for generating a displayable edited video data stream from an *original video data stream*, wherein at least one pixel in a frame of said original video data stream is digitally extracted to form a first image, said first image then replaced by a second image resulting from a digital extraction of at least one pixel in a frame of a user input video data stream, said apparatus comprising:

an image capture device capturing the *user input video data stream*;

an image display device displaying the original video stream;

a data entry device, operably coupled with the image capture device and the image display device, operated by a user to select the at least one pixel in the frame of the user input video data stream to use as the second image, and further operated by the user to select the at least one pixel to use as the first image;

wherein said data entry device is selected from a group of devices consisting of: a keyboard, a display, a wireless communication capability device, and an external memory device;

a digital processing unit operably coupled with the data entry device, said digital processing unit performing:

identifying the selected at least one pixel in the frame of the user input video data stream;

extracting the identified at least one pixel as the second image;

storing the second image in a memory device operably coupled with the interactive media apparatus;

receiving a selection of the first image from the original video data stream;

extracting the first image;

spatially matching an area of the second image to an area of the first image in the original video data stream, wherein spatially matching the areas results in equal spatial lengths and widths between said two spatially matched areas;

and

performing a substitution of the spatially matched first image with the spatially matched second image to generate the displayable edited video data stream from the original video data stream.

Id. ¶ 13 (emphasis added). Claims 3 and 4 of the ‘591 patent, which are also the subject of this Markman Order, are dependent upon Claim 1.

Prisua alleges that Samsung manufactures and sells mobile phones, tablets, and cameras that have a camera functionality that violates the ‘591 Patent. *Id.* ¶ 14. Prisua alleges that these infringing products include, but are not limited to: Galaxy S4, S4 mini, S5, SIII, and Samsung Mega products, the Samsung Galaxy Note 10.1, Galaxy Note Pro, and Galaxy Tab Pro tablets, and NX300M, NX2000, WB800F, WB350 and WB250 cameras. *Id.*

Prisua alleges that these products include “an image capture device in the form of a front and back digital camera, a display device in the form of an LCD screen, and a data entry device in the form of a touchscreen keyboard.” *Id.* ¶ 15. The products also include a digital processing unit. Samsung’s products have a “Best Face” application that uses the product’s image capture device to capture images. Users of the product are then able to select a portion of the captured images along with a portion of the original video data stream. The product’s digital processing unit then uses its memory and processing components to “spatially match[] the second image (from the user input video data stream) to the first image (from the original video stream).” *Id.* This process substitutes the first image with the second image—i.e., the “user-selected ‘Best Face.’” *Id.* Prisua alleges that the above violates Prisua’s ‘591 Patent.

On August 29, 2014, Prisua sent Samsung America a letter including a detailed claim chart alleging Samsung’s patent infringement. *Id.* ¶ 16. This letter prompted discussions between Prisua and Samsung Korea; Prisua proposed a license agreement, which Samsung rejected. *Id.* ¶ 18.

In its Complaint, Prisua alleges direct infringement of the ‘591 Patent against the three Defendants. *Id.* Counts 1–3. For relief, Prisua requests that the Court: (1) find Samsung liable for infringement of the ‘591 Patent; (2) enjoin and restrain Samsung from importing, selling, and/or offering to sell any products that infringe the ‘591 Patent; (3) award Prisua damages and treble such amount pursuant to 35 U.S.C. § 284; (4) find this case exceptional under 35 U.S.C. § 285 and therefore award Prisua reasonable attorneys’ fees and expenses, taxable costs and disbursements, and prejudgment and post-judgment interest; and (5) award Prisua such other and further relief as the Court deems just and proper.

On March 9, 2017, the Court denied Samsung’s Motion to Dismiss (ECF No. 56). The Parties have since completed claim construction briefing. On June 16, 2017, following a hearing, the Court denied without prejudice Samsung’s Motion to Stay the case pending *inter partes* review (ECF No. 62).

The Court held its Markman Hearing on July 7, 2017. The terms at issue span three of the ‘591 Patent’s asserted claims: independent Claim 1 and dependent Claims 3 and 4. In support of their constructions, the Parties provide both intrinsic and extrinsic evidence, including deposition testimony from Dr. Prieto, the inventor, as well as two experts.

II. STANDARD OF REVIEW

A patent must “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter” of the invention. 35 U.S.C. § 112(b). A patent’s claims are invalid as indefinite under § 112 if the “claims, viewed in light of the specification and prosecution history,” fail to “inform those skilled in the art about the scope of the invention with reasonable certainty.” *Nautilus, Inc. v. Boisig Instr., Inc.*, 134 S. Ct. 2130, 2129–30 (2014). This is so that the patent “afford[s] clear notice of what is claimed.” *Id.* Whether a claim is invalid for

indefiniteness is a question of law for the Court. *See Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1341 (Fed. Cir. 2015).¹

It is the Court's role to construe the claims of the disputed patent. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388–90 (1996). The Court principally looks to the claims made in the patent, specification, and prosecution history. *Alza Corp. v. Mylan Laboratories, Inc.*, 391 F.3d 1365, 1370 (Fed. Cir. 2004); *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). These sources are considered intrinsic evidence. *Vitronics Corp.*, 90 F.3d at 1582.

In approaching claim construction, the words of the claim are to be given their ordinary and customary meaning as understood by one with ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005); *see also Eleka Instrument S.A. v. O.U.R. Scientific Intern., Inc.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000) (“[a]bsent an express intent to impart a novel meaning, claim terms take on their ordinary meaning.”). “[C]laims are interpreted with an eye toward giving effect to all terms in the claim.” *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006). Otherwise, characteristics described in a claim would be considered superfluous, rendering the scope of the patent ambiguous and leaving examiners to guess about which claim language is deemed necessary and which is non-limiting elaboration. *Id.* Additionally, courts must pay particular attention to the patentees' own definition of the claim terms, which control. *Oakley, Inc. v. Sunglass Hut Intern.*, 316 F.3d 1331, 1341 (Fed. Cir. 2003) (“a patentee may be his or her own lexicographer by defining the claim terms.”).

¹ As discussed further below, Samsung raises indefiniteness challenges to multiple terms at issue in this case.

With respect to the relationship between the specification and the claims, the Federal Circuit has explained that claims must be read in view of the specification and that the specification may act as a sort of dictionary, which explains the invention and may define terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995), *aff'd* 517 U.S. 370 (1996). The Federal Circuit has cautioned, however, that “there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification.” *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998).

In addition to intrinsic evidence, courts may rely on extrinsic evidence, which includes expert and inventor testimony as well as dictionaries and technical treatises. *Markman*, 52 F.3d at 980. Extrinsic evidence, however, is viewed as less reliable than the patent and its prosecution history in determining how to read claim terms. *Phillips*, 415 F.3d at 1318.

III. ANALYSIS

As addressed at the Markman Hearing and in their filings, the Parties have stipulated to the following: (1) the term “extracting” shall be defined as “select and separate out”; and (2) “performing a substitution” shall be assigned its plain meaning. *See* ECF No. 40; *see also* Markman Hearing Transcript at 25:18–26:1.

For the remaining terms in dispute, the Court construes them as follows:

A. “User input video data stream” and “original video data stream”

During the Markman Hearing and in their briefs, the Parties addressed the terms “user input video data stream” and “original video data stream.” together due to the overlap in the arguments for each construction. The Court likewise addresses these terms together. Both terms are found in Claim 1 of the ‘591 Patent.

Prisua defines “user input video data stream” as “a sequence of images digitally recorded by a user separate from the original video data stream.” Samsung defines this term as “a digitally recorded sequence of frames contained in a format for displaying the frames as a motion picture (e.g., ASF, MPEG-2, AVI) that is provided by the user.” In similar fashion, Prisua defines “original video data stream” as “a digitally recorded sequence of images that is to be modified,” while Samsung defines it as “a digitally recorded sequence of frames contained in a format for displaying the frames as a motion picture (e.g., ASF, MPEG-2, AVI) that is to be modified.” During the Markman Hearing, Prisua indicated that it would consent to compromise by substituting the phrase “image frames” in place of “images” in each of Prisua’s constructions; however, Samsung did not indicate that it agreed to this alteration. *See* Reply at 4 (Prisua describing that it believes “video data stream” can be properly defined as either “a sequence of images” or a “sequence of image frames” because there is no material distinction between the two phrases).

Central to the construction of these two terms is the meaning of “video data stream.” According to Samsung, Prisua’s construction is an attempt “to broaden ‘video’” (and by extension the ‘591 Patent) to “include still images and a sequence of still images.” *See* Response at 7, n.1. Samsung cites to the English Oxford Dictionary for its definition of video as “[t]he recording, reproducing, or broadcasting of moving visual images” or “a recording of moving visual images made digitally or on videotape.” *Id.* (Ex. K). Samsung claims that one of ordinary skill in the art would understand a “video data stream” to be “a digitally recorded sequence of frames contained in a format for displaying the frames as a motion picture.” *See* Delp Declaration ¶ 28 (Ex. I). Samsung cites to the testimony of its expert, Dr. Edward J. Delp, for

the principle that a video portrays motion, while a still image² does not necessarily do so. *Id.* ¶ 29. Dr. Delp testified that “not all digitally recorded sequences of images are video” and that “a still image or a sequence of still images that cannot be played back to the viewer as a motion picture [is not a] video data stream.” *Id.*

Prisua, alternatively, argues that the term “image” is necessary to accurately define “video,” which is a series of images in succession that creates the illusion of movement. This interpretation of “video” is supported by the language of the ‘591 Patent and reflects how a person of ordinary skill in the art would understand the term. The word “image” is used seventeen times in Claim 1 of the ‘591 Patent—for example, to describe “receiving a selection of the . . . image from the . . . video data stream” and “extracting the . . . image” from the video data stream. *See* ‘591 Patent at 7:43–45. Prisua argues that its use of the term “images” in its construction of “video data stream” is intended “to provide clarity and dispel the notion that blank frames are ever present in any of the ‘591 patent’s video data streams.” *See* Reply at 4.

The Court agrees with Prisua that the inclusion of “images” in the definition of these terms is consistent with the plain meaning of the claim language and will aid the jury in understanding the terminology. As Prisua consents to the addition of the term “frames,” that word will be added to Prisua’s constructions to provide greater specificity. The terms “*user input video data stream*” and “*original video data stream*” are hereby construed as “a sequence of image frames digitally recorded by a user separate from the original video data stream” and “a digitally recorded sequence of image frames that is to be modified,” respectively.

B. “Spatially matching”

Prisua defines “spatially matching” as “aligning a set of pixels in the spatial domain.”

² As Prisua notes in its Reply Brief, those of skill in the art use the terms “still image” and “image” interchangeably. *See* Deposition of Edward J. Delp, Ph.D. at 118–119s (ECF No. 53-1).

Samsung argues that this term is indefinite under 36 U.S.C. § 112(b). In the alternative, Samsung defines the term as: “partitioning images into a set of course to fine scale sub-blocks and concatenating the histograms extracted from all blocks into a long vector representation.”

Prisua acknowledges that neither the ‘591 Patent’s specification nor its prosecution history provides an express definition of “spatially matching.” *See* Claim Construction Brief at 13. As stated above, under the *Nautilus* standard a patent claim is indefinite if, when “read in light of the specification delineating the patent, and the prosecution history,” the claim “fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus*, 134 S. Ct. at 2124. Samsung argues that the absence of intrinsic evidence available to help define “spatially matching” means that the ‘591 Patent does not adequately inform the public of this term’s scope, and therefore does not meet *Nautilus* standard. *See* Response at 12–13.

However, the Federal Circuit has clarified that extrinsic evidence may “play a significant role in the indefiniteness analysis.” *Dow Chem. Co. v. Nova Chems. Corp. (Canada)*, 809 F.3d 1223, 1225 (Fed. Cir. 2015) (per curiam). The Federal Circuit has also stated that “if a skilled person would choose an established method of measurement, that may be sufficient to defeat a claim of indefiniteness, even if that method is not set forth . . . in the patent itself.” *Id.* at 1225 (Prost, J., concurring). The accused infringer—in this case, Samsung—bears the burden of proving indefiniteness by clear and convincing evidence. *Id.*

Here, Prisua’s expert has testified that a person of ordinary skill in the art would be able to choose among the different types of spatially matching techniques. *See* Negahdaripour Dec. ¶¶ 9–25 (ECF No. 53-10). Prisua’s expert cites to numerous publications in the field as extrinsic evidence in support of defining spatially matching as “aligning a set of pixels in the spatial

domain.” *Id.* Furthermore, Samsung’s own expert testified that he would be able to choose among spatially matching techniques if required to do so. Counsel for Prisia asked Dr. Delp, “[Y]ou could choose among the [spatially matching techniques] you know and love, right?” Dr. Delp responded that “[he] could probably choose those, yes.” Delp Depo. at 218:18–20.

Samsung has therefore failed to meet its burden of demonstrating by clear and convincing evidence that one of ordinary skill in the art would be unable to choose among different definitions of “spatially matching.” The Court rejects Samsung’s argument that “spatially matching” is indefinite and adopts Prisia’s construction of the term as “aligning a set of pixels in the spatial domain.”

C. Antecedent Claim Terms

Samsung argues that Claims 3 and 4—which are dependent claims—are indefinite because they contain terms with no antecedent basis in Claim 1. For the reasons below, the Court rejects this argument.

1. “Extracting the at least one pixel from the user entering data in the data entry display device” (“Claim 3 term”)

Prisia defines the Claim 3 term as “selecting and separating out the at least one pixel chosen by a user on a display, when said display is acting as a data entry device and receives a selection of at least one pixel by said user.”

Samsung argues that the Claim 3 term is indefinite because there is no antecedent basis for the terms “the user entering data” or “the data entry display device” in Claim 3. However, as Prisia notes, an antecedent basis can be present by implication. *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1117 (Fed. Cir. 1987); *see also Cross Med. Prods. V. Medtronic Sofamor Danek*, 424 F.3d 1293, 1319 (Fed. Cir. 2005). While Claim 1 may not explicitly use the terms “the user entering data” or “the data entry display device,” Claim 1 uses several terms that

would illuminate the meaning of Claim 3 for one of ordinary skill in the art. For example, Claim one describes “a data entry device” that is “operated by a user” in order “to select the at least one pixel.” *See* ‘591 Patent, 7:25–30. In addition, the specification addresses “user input data” that “can be captured directly” by a “stand alone device” that includes “data entry devices such as a . . . displaying device.” *Id.* 4:57–63.

Samsung has not provided sufficient evidence to meet its burden of demonstrating by clear and convincing evidence that Claim 3 is indefinite. Therefore, the Court adopts Prisia’s construction of the Claim 3 term.

2. “Extracting the at least one pixel from the user pointing to a special location in a displayed video frame” (“Claim 4 term”)

Prisia defines the Claim 4 term as “performing spatial analysis on a video frame based on a user input, then selecting and separating out the at least one pixel chosen by said user.” Samsung argues this term is indefinite because it depends upon Claim 3. As the Court has not found the Claim 3 term to be indefinite, the Court rejects this argument. The Claim 4 term is therefore defined using Prisia’s construction.

IV. CONCLUSION

For the foregoing reasons, it is hereby ORDERED AND ADJUDGED that United States Patent Number 8,650,591 shall be construed in a manner consistent with this Order.

DONE AND ORDERED in Chambers at Miami, Florida, this 6th day of September, 2017.

K. MICHAEL MOORE
UNITED STATES DISTRICT JUDGE

cc: All counsel of record