

**IN THE 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.,
SAMSUNG ELECTRONICS AMERICA, INC.,
SAMSUNG ELECTRONICS LATINOAMERICA
MIAMI, INC.,

Defendants.

ORDER DENYING SUMMARY JUDGMENT

This cause came before the Court upon Defendants Samsung Electronics America, Inc., Samsung Electronics Co., Ltd., and Samsung Electronics Latinoamerica Miami, Inc.'s (collectively, "Samsung") Motion for Summary Judgment (ECF No. 153). Plaintiff Prisia Engineering Corp. ("Prisia") filed a response (ECF No. 182) and Samsung replied (ECF No. 205). The motion is now ripe for review.

For the reasons that follow, Samsung's Motion for Summary Judgment is DENIED.

I. BACKGROUND¹

Dr. Yolanda Prieto, Ph.D., is the founder, president, and sole shareholder of Prisia. Dr. Prieto is also the inventor of the patent at issue. On March 9, 2010, Dr. Prieto filed U.S. Patent Application No. 8,650,591 (“the ’591 Patent”), claiming priority to provisional application No. 61/311,892. On February 11, 2014, the United States Patent and Trademark Office (“U.S.P.T.O.”) granted the ’591 Patent, entitled “Video Enabled Digital Devices for Embedding User Data in Interactive Applications.”

Shortly thereafter, on August 29, 2014, Prisia sent Samsung a letter asserting that Samsung infringed the ’591 Patent. Prisia asserts that certain of Samsung’s products (“Accused Devices”) infringe Claims 1, 3, 4, and 8 of the ’591 Patent (the “Asserted Claims”).

A. Prisia’s Intellectual Property

In 2010 Dr. Prieto filed the original patent application² that eventually matured into the ’591 Patent. *Id.*, ¶ B-10. The ’591 Patent generally relates to a method for generating an edited video data stream from an original video data stream. Generation of the edited video stream

¹ The Court has set forth the background and pertinent facts of the matter in several prior orders. *See, e.g.* (ECF Nos. 56, 103, 268). In the interest of brevity, the Court recites only facts that are relevant to the motion at hand. These facts are undisputed and supported by the record. *See* Samsung’s Statement of Material Facts in Support of Summary Judgment (“Samsung’s 56.1”) (ECF No. 154), Prisia’s Statement of Material Facts in Opposition to Samsung’s Motion for Summary Judgment (“Prisia’s 56.1”) (ECF No. 181), and Samsung’s Response to Prisia’s 56.1 (ECF No. 205-1 at 1, n. 1). The Court notes that Samsung’s Response to Prisia’s 56.1 objects to a subset of Prisia’s additional as untimely. ECF No. 205-1 at 1, n 1. In light of the Court’s denial of Samsung’s Motion to Strike (ECF No. 189), Samsung’s objection to this subset of facts fails. Omnibus Order dated February 13, 2018 (ECF No. 268) at 27.

² Claim 1 of the original application stated as follows:

A method for generating an edited video data stream from an original video stream wherein generation of said edited video stream comprises a step of: substituting at least one object in a plurality of object in said original video stream by at least a different object.

Id.

comprises a step substituting at least one object in a plurality of objects—like an image of a face—in the original video data stream with at least one different object. Figure 3, reproduced below, is a simplified illustration of a video image substitution.

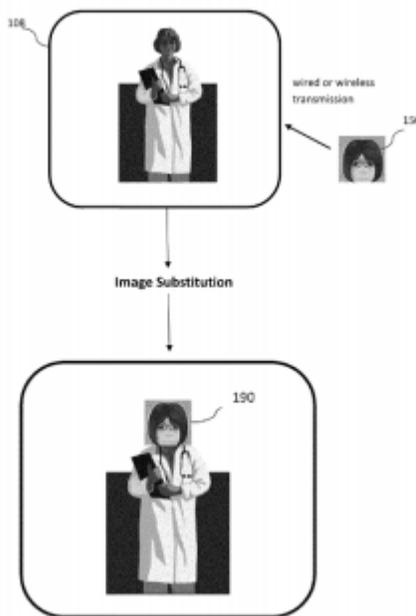


FIG. 3

Id. The original claims were rejected by the U.S.P.T.O. Dr. Prieto subsequently rewrote them, adding the requirement of “spatially matching the areas results in equal spatial lengths and widths between said two spatially matched areas.” *Id.*, ¶¶ B-15–16. The term “spatially matching” appears only in the claims of the ’591 Patent as they issued and is not defined. *Id.*, ¶¶ B-16–17. Following the claim construction hearing, this Court recognized that there is no single technique for spatially matching but that a person of ordinary skill in the art would be able to choose among the different types of spatial matching techniques. *Id.*, ¶ B-18; *Markman* Order (ECF No. 103) at 9.

There are four claims at issue: claims 1, 3, 4, and 8. Claim 1 is independent and the other claims derive their meaning therefrom. The claims read as follows:

Claim 1

An interactive media apparatus for generating a displayable edited video 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 selecting 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.

Claim 3

The interactive media apparatus of claim 1 wherein the digital processing unit is further capable of extracting the at least one pixel from the user entering data in the data entry display device.

Claim 4

The interactive media apparatus of claim 3 wherein the digital processing unit is further capable of extracting the at least one pixel from the user pointing to a spatial location in a displayed video frame.

Claim 8

The interactive media apparatus of claim 1, wherein the substitution performed by the digital processing device replaces at least a face of a first person from the original video data stream by at least a face of a second person from the user input video data stream.

'591 Patent (ECF No. 154, Ex. D) at Col. 7:14–54; 7:63–8:4).

B. Samsung's Allegedly Infringing Conduct

In 2012 Samsung entered into a licensing agreement with ArcSoft for the use of its application “Best Face” (“Best Face” or “the Best Face application”). Expert Report of Richard Lettiere (ECF No. 155-4) at 32–34. In late 2012 Samsung first released Best Face as a mode in the pre-installed camera application of one of the Accused Devices. *Id.* at 14. The Accused Devices came with Best Face as a mode in the pre-installed camera application until April 2014. *Id.* In April 2014 the Best Face mode was combined with four other camera modes, called the “Shot & More” mode, which was also a pre-installed camera application. *Id.* In April 2015 Shot & More was removed as a pre-installed application and users could instead download the application from the Samsung Galaxy App Store. *Id.*

Best Face loads a number of images. *Id.* ¶ A-8. Best Face displays one of the images as the background of its user interface.³ *Id.*, ¶ A-9. It detects the faces in the images and determines the bounding rectangles that delineate the area of the faces detected in the images. *Id.*, ¶ A-10. The bounding rectangles for each detected face are stored in the pRect field of the

³ See figure *infra* at 16.

application. *Id.* Best Face user interface displays yellow rectangles on the user interface for the detected faces. *Id.*

The user chooses one of the yellow rectangles and Best Face in turn presents candidate faces that the user may select from. *Id.*, ¶ A-11. Best Face then generates a single image. *Id.*, ¶ A-12.

C. **Procedural History**

On May 17, 2016, Prisia filed the instant action alleging patent infringement against Samsung pursuant to Title 35 of the United States Code, Section 271. Complaint (ECF No. 1). Samsung moved to dismiss the Complaint for failure to state an action, arguing that the '591 Patent is a non-patentable claim because it lacks the requisite inventive step to elevate an alleged abstract idea to patentable technology. The Court disagreed and denied Samsung's motion to dismiss, finding that there is an inventive concept embedded within the '591 Patent.

The Parties briefed the issue of claim construction over the course of several months. On July 7, 2017, the Court held a *Markman* Hearing⁴ and on September 6, 2017, issued its Order following *Markman* Hearing (“*Markman* Order”). In the *Markman* Order, the Court construed the following terms: “extracting,” “performing a substitution, user input video data stream,” “original video data stream,” “spatially matching,” “extracting the at least one pixel from the user entering data in the data entry display device,” and “extracting the at least one pixel from the user pointing to a special location in a displayed video frame.” The Court also held that Samsung had not met its burden of demonstrating by clear and convincing evidence that Claims 3 and 4 are indefinite.

⁴ It is the Court's duty to construe the claims of the disputed patent. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388–90 (1996).

On March 29, 2017, Samsung filed a petition with the Patent Trial and Appeals Board (“PTAB”) seeking *inter partes* review of the Asserted Claims,⁵ as well as Claim 11 of the ’591 Patent. On October 11, 2017, the PTAB declined to institute *inter partes* review of the Asserted Claims. PTAB Decision (ECF No. 132-1).

Samsung now moves for summary judgment on four grounds. Samsung’s Motion for Summary Judgment (ECF No. 153). First, Samsung argues that Samsung cannot infringe the Asserted Claims because Prisia has failed to provide evidence that the Accused Devices satisfy all of the limitations of the Asserted Claims, specifically the limitations in the preamble of the Asserted Claims. Second, Samsung argues it has not infringed the Asserted Claims as a matter of law because the Accused Devices do not display the claimed “original video data stream” or generate the claimed “displayable edited video data stream.” Third, Samsung states that the Asserted Claims are invalid for indefiniteness under 35 U.S.C. § 112 because the Asserted Claims impermissibly contain both apparatus limitations and method steps. Fourth, Samsung argues that the Asserted Claims are invalid for failure to satisfy the written description requirement of 35 U.S.C. § 112 because there is no single commonly understood definition of “spatially matching.”

II. LEGAL STANDARD

Summary judgment is appropriate where there is “no genuine issue as to any material fact [such] that the moving party is entitled to judgment as a matter of law.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986); *see also* Fed. R. Civ. P. 56. An issue of fact is “material” if it is a legal element of the claim under the applicable substantive law which might affect the outcome of the case. *Allen v. Tyson Foods, Inc.*, 121 F.3d 642, 646 (11th Cir. 1997). An issue of fact is

⁵ Prisia moved to exclude the PTAB’s Decision and the Court granted that request for reasons set forth in the Court’s Omnibus Order (ECF No. 268) at 5.

“genuine” if the record, taken as a whole, could lead a rational trier of fact to find for the non-moving party. *Id.* Additionally, speculation or conjecture cannot create a genuine issue of material fact. *Cordoba v. Dillard’s, Inc.*, 419 F.3d 1169, 1181 (11th Cir. 2005).

The moving party has the initial burden of showing the absence of a genuine issue as to any material fact. *Id.* (citation omitted). In assessing whether the moving party has met this burden, the court must view the movant’s evidence and all factual inferences arising from it in the light most favorable to the non-moving party. *Denney v. City of Albany*, 247 F.3d 1172, 1181 (11th Cir. 2001). Once the moving party satisfies its initial burden, the burden shifts to the non-moving party to come forward with evidence showing a genuine issue of material fact that precludes summary judgment. *Bailey v. Allgas, Inc.*, 284 F.3d 1237, 1243 (11th Cir. 2002); *see also* Fed. R. Civ. P. 56(e). “The mere existence of a scintilla of evidence in support of the [non-moving party’s] position will be insufficient; there must be evidence on which the jury could reasonably find for the [non-movant].” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 252 (1986). “If reasonable minds could differ on the inferences arising from undisputed facts, then a court should deny summary judgment.” *Miranda v. B & B Cash Grocery Store, Inc.*, 975 F.2d 1518, 1534 (11th Cir. 1992). But if the record, taken as a whole, cannot lead a rational trier of fact to find for the non-moving party, there is no genuine issue for trial, and summary judgment is proper. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986).

III. PATENT INFRINGEMENT LEGAL FRAMEWORK

A patent is infringed when a person “without authority makes, uses, offers to sell, or sells any patented invention, within the United States . . . during the term of the patent.” 35 U.S.C. § 271(a). Determining whether an accused device infringes a patent requires a two-step inquiry. *See Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1360 (Fed. Cir. 2004). First, a court must determine the scope and meaning of “any disputed terms and limiting

expressions in the [patent] claims” as a matter of law. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (noting it is a “‘bedrock principle’ of patent law that the claims of a patent define the invention to which the patentee is entitled the right to exclude”) (citation omitted). “[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.” *Vivid*, 200 F.3d at 803 (citing *U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997) (claim construction is for “resolution of disputed meanings”). Under this analysis, “[w]ords of a claim are generally given their ordinary and customary meaning, which is the meaning a term would have to a person of ordinary skill in the art after reviewing the intrinsic record at the time of the invention.” *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) (noting the “‘heavy presumption’ that a claim term carries its ordinary and customary meaning”).

Second, the fact finder compares “the properly construed claims to the allegedly infringing device.” *Dynacore Holdings Corp. v. U.S. Philips Corp.*, 363 F.3d 1263, 1273 (Fed. Cir. 2004). Under this step, an accused device can infringe the asserted claims of a patent either literally or under the doctrine of equivalents.⁶ *Cephalon, Inc. v. Watson Pharm., Inc.*, 707 F.3d

⁶ “Literal infringement of a claim exists when every limitation recited in the claim is found in the accused device.” *Kahn v. Gen. Motors Corp.*, 135 F.3d 1472, 1477 (Fed. Cir. 1998). “If any claim limitation is absent from the accused device, there is no literal infringement as a matter of law.” *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1247 (Fed. Cir. 2000). Under the doctrine of equivalents, infringement is established “if an element of the accused device performs substantially the same function in substantially the same way to obtain the same result as the claim limitation.” *EMD Millipore Corp. v. AllPure Techs., Inc.*, 768 F.3d 1196, 1202 (Fed. Cir. 2014). Thus, the doctrine of equivalents “prevents an accused infringer from avoiding infringement by changing only minor or insubstantial details of a claimed invention while retaining their essential functionality.” *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1424 (Fed. Cir. 1997). Because the Court has granted Samsung’s motion to exclude evidence or

1330, 1340 (Fed. Cir. 2013). Although there is no “per se rule that expert testimony is required to prove infringement when the art is complex,” *Centricut, LLC v. Esab Grp., Inc.*, 390 F.3d 1361, 1370 (Fed. Cir. 2004), courts regularly approve of the use of expert testimony to establish infringement. *See Ultradent Products, Inc. v. Life-Like Cosmetics, Inc.*, 127 F.3d 1065, 1070 (Fed. Cir. 1997); *see also Aquatex Indus., Inc. v. Techniche Sols.*, 479 F.3d 1320, 1329 (Fed. Cir. 2007) (“Even where literal infringement is involved, expert infringement testimony is generally required in cases involving complex technology.”).

It is the patentee’s burden to prove infringement by a preponderance of the evidence. *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1535 (Fed. Cir. 1991). “If the patentee fails to meet that burden, the patentee loses regardless of whether the accused comes forward with any evidence to the contrary.” *Creative Compounds, LLC v. Starmark Labs.*, 651 F.3d 1303, 1314 (Fed. Cir. 2011). The Federal Circuit teaches that “[s]ummary judgment on the issue of infringement is proper when no reasonable jury could find that every limitation recited in a properly construed claim either is or is not found in the accused device either literally or under the doctrine of equivalents.” *PC Connector Sols. LLC v. SmartDisk Corp.*, 406 F.3d 1359, 1364 (Fed. Cir. 2005) (citing *Bai v. L & L Wings, Inc.*, 160 F.3d 1350, 1353–54 (Fed. Cir. 1998)).

IV. DISCUSSION

Samsung moves for summary judgment on Prisia’s claims that Samsung infringes the ’591 Patent. Samsung argues: (1) there is no infringement because Prisia has failed to offer any proof that the Accused Devices meet the limitations in the preamble of the Asserted Claims; (2) the Accused Devices do not infringe the ’591 Patent because there is no “original video data stream” or “displayable edited video data stream;” (3) the Asserted Claims are invalid as

testimony on the doctrine of equivalents the Court need not consider infringement under that theory in its present analysis. Omnibus Order (ECF No. 268) at 9.

indefinite for impermissibly containing both apparatus limitations and method steps; and (4) the Asserted Claims are invalid for failing to meet the written description requirement of 35 U.S.C. § 112.

A. The Preamble of the Asserted Claims Is Not Limiting.

To prove literal infringement, Prisua must prove by a preponderance of evidence that the Accused Devices have each and every limitation in the Asserted Claims. Samsung argues that Prisua has not and cannot prove that the Accused Devices meet the limitations of the preamble. In response, Prisua argues that the preamble argument is improperly raised as a new issue of claim construction but even if the Court were to consider the argument, the preamble is not limiting and, even if it is limiting, the Accused Devices satisfy the preamble's limitations.

1. Samsung Waived the Argument.

On November 21, 2016, the parties filed a joint claim construction statement identifying three terms for construction. (ECF No. 40). Therein the parties stated that they “agree that the construction of the foregoing terms will be dispositive.” *Id.* at 2. Briefing and discovery related to claim construction ensued, culminating in the *Markman* Hearing before the Court on July 7, 2017. Samsung's argues that Prisua was aware of Samsung's limitations of the preamble as early as June 23, 2017, but chose to ignore those limitations. Samsung also suggests that it is irrelevant that certain limitations of the preamble were not offered for construction by the Court because the majority of the claim limitations were not submitted for express construction.

“[W]hether a term in a claim's preamble should be considered a claim limitation is a question of claim construction.” *Donaldson Co., Inc. v. Baldwin Filters, Inc.*, No. 09-CV-1049 (PJS/AJB), 2011 WL 2183179, *8 (D. Minn. Jun. 6, 2011). Failure to timely raise a dispositive issue of claim construction constitutes waiver. *See Cent. Admixture Pharm. Servs., Inc. v.*

Advanced Cardiac Sols., P.C., 482 F.3d 1347, 1356 (Fed. Cir. 2007) (affirming district court’s ruling that party waived argument with respect to term by failing to raise it during claim construction.)

Although mentioned during the course of the *Markman* Hearing, the preamble’s alleged limitation was not raised as a term to be construed. Accordingly, Samsung has waived this argument.⁷

2. The Preamble Is Not Limiting.

Even if Samsung had not waived this argument, the Court would not conclude that the preamble is limiting.

“[A]s a general rule preamble language is not treated as limiting.” *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1347 (Fed. Cir. 2012). However, a preamble is limiting if it “recites essential structures or steps, or if it is necessary to give life, meaning, and vitality to the claim.” *Proveris Sci. Corp. v. Innovasystems, Inc.*, 739 F.3d 1367, 1372 (Fed. Cir. 2014). The preamble may be limiting and a necessary component of the claimed invention “[w]hen limitations in the body of the claim rely upon and derive antecedent basis from the preamble.” *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003). And it is for the Court to decide “[w]hether a preamble limits a claimed invention [because it] is a question of law.” *Rotatable Techs. LLC v. Motorola Mobility LLC*, 567 F. App’x 941, 943 (Fed. Cir. 2014).

“If the body of the claim ‘sets out the complete invention,’ the preamble is not ordinarily treated as limiting the scope of the claim.” *Bicon, Inc. v. Staumann Co.*, 441 F.3d 945 (Fed. Cir.

⁷ The Court also denied Samsung’s Motion to Amend Invalidity Contentions (ECF No. 231) seeking to belatedly raise this preamble argument. The Court also granted Prisua’s *Daubert* Motion (ECF No. 168) with respect to the exclusion of testimony from Samsung’s expert Dr. Delp’s opinions relating to the preamble as limiting. See Omnibus Order dated February 13, 2018 (ECF No. 268) at 16–17.

2006). A claim term that is also found in the preamble to the claim would be redundant if the preamble is not “necessary to give life, meaning, and vitality” to the claim. *Neev v. Abbott Med. Optics, Inc.*, No. 09-146 (RBK), 2012 WL 1066797, *11 (D. Del. Mar. 26, 2012) (quoting *Poly-America, L.P. v. GSE Lining Tech., Inc.*, 383 F.3d 1303, 1309 (Fed. Cir. 2004)).

The preamble of Claim 1 states:

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:

Samsung’s 56.1 (ECF No. 154) ¶ A-3.

Samsung first argues that the preamble is limiting because numerous claim limitations refer back to and obtain their basis from the preamble, specifically pointing to the following terms in the body of Claim 1: “user input video data stream,” “the at least one pixel,” “the frame of said original video data stream” “the second image resulting from a digital extraction,” “the interactive media apparatus,” and “the displayable edited video data stream from the original video data stream.”

While true that the aforementioned terms are all terms in the body of the claim, this alone is insufficient for finding the preamble as limiting. *See Neev v. Abbott Med. Optics, Inc.*, 2012 WL 1066797, *11. Samsung fails to provide analysis or evidentiary support for this proposition and simply relies upon the conclusory statement that the above-mentioned terms “are all terms in the body of the claim that refer back to the preamble.” Samsung’s Motion (ECF No. 153) at 4.

Samsung also argues that the preamble is critical to understanding the claim limitation “operated by the user to select the at least one pixel to use as the first image.” Samsung’s Motion (ECF No. 153) at 4. The preamble explains that the first image is formed from a

selection of the at least one pixel from the “original video data stream.” Without this preamble language, Samsung argues that there would be no guidance in the claim to inform a person of skill in the art as to the source of the first image.

In response, Prisia argues that the opening clause of the preamble of Claim 1 adds nothing to the claim and merely recites a purpose or intended use and thus is not a limitation. *See Innova/Pure*, 381 F.3d 1111, 1118 (Fed. Cir. 2004) (stating “we need not decide whether the preamble adds a limitation to the claim because we hold that it recites a purpose or intended use [of the at-issue claim]. Specifically, Prisia contends that the “at least one pixel . . . to form a first image” in the preamble is the same as “at least one pixel to use as the first image” in the body of the claim. Prisia’s Response (ECF No. 182) at 6. Prisia also discredits Samsung’s argument by pointing to Samsung’s failure to define what it considers the definition of the word “form.” In reply, Samsung argues that “form” and “use” do not have the same meaning⁸ and urges the Court to ignore the declarations cited in support of Prisia’s opposition to the Motion. Although it is Prisia’s ultimate burden to prove infringement, Samsung bears the burden of proving no issues of material fact exist for purposes of summary judgment and it has not done so on this point.

⁸ The case cited by Samsung on this point is misleading. Samsung’s Reply (ECF No. 205) at 3. Samsung cites *Bancorp Servs., LLC v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1373 (Fed. Cir. 2004) and states parenthetically “holding that when the patentee uses different terms to identify similar claim limitations, those terms should have different meanings.” Samsung’s Reply (ECF No. 206) at 3. In *Bancorp*, the Federal Circuit noted “that the use of both terms in close proximity in the same claim gives rise to an inference that a different meaning should be assigned to each.” *Bancorp*, 359 F.3d at 1373 (internal citation omitted). But the Federal Circuit went on to say “[t]hat inference, however, is not conclusive; it is not unknown for different words to be used to express similar concepts, even though it may be poor drafting practice.” *Id.* On that particular issue of claim construction, the Court stated that it did “not agree with the district court that the use of the two different terms in the asserted claims tends to support the conclusion that the two terms cannot be synonyms for one another.” Careful parsing is critical to the Court’s analysis, as is careful reading.

Samsung also argues that Prisia affirmatively relied on the limitations in the preamble to contest Samsung's prior art-based invalidity arguments both in this case and in Samsung's *inter partes* review of '591 Patent. "[C]lear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention." *Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002). But Samsung fails to explain just how Prisia clearly relied on the preamble. The mere mention or explanation of the preamble during those proceeding is not, without more, evidence of "clear reliance."

Samsung's arguments are unavailing. The Court has already found that Samsung waived the preamble argument by failing to raise it during claim construction. But even if not waived, on summary judgment Samsung fails to meet its burden as to the substantive argument that the preamble is limiting.

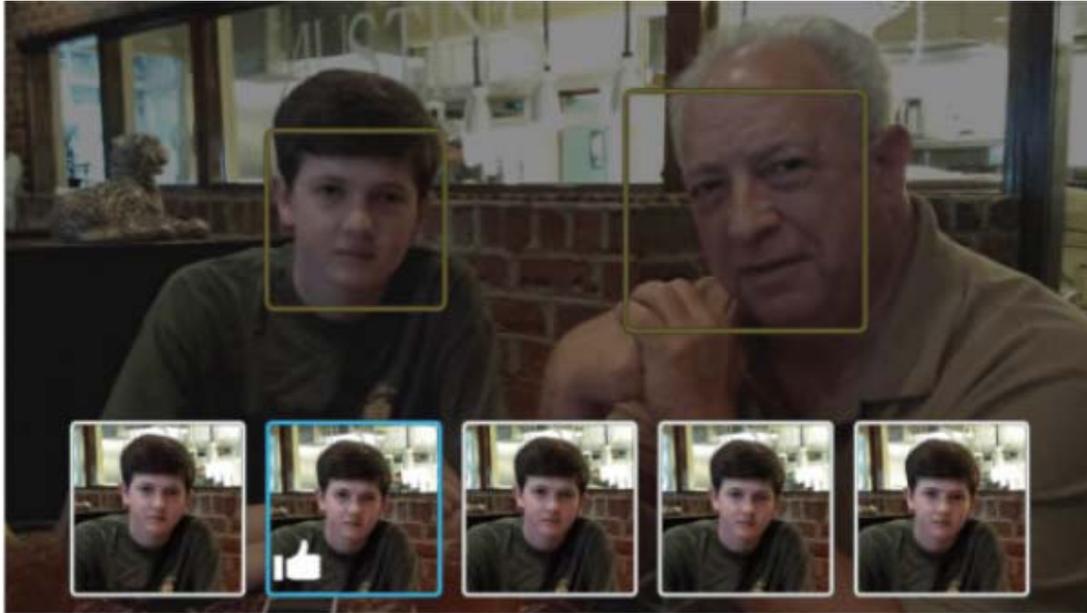
B. Issues of Fact Remain as to the "Original Video Data Stream" and "Displayable Edited Video Data Stream."

Samsung argues summary judgment is appropriate because the undisputed facts show that the Accused Devices do not display the claimed "original data stream" or generate a "displayable edited video data stream." Samsung's 56.1, ¶ A-7. Claim 1 requires displaying "an original video data stream" and generating a "displayable edited video data stream." But there is no such video data stream that is displayed or generated in the Best Face application, says Samsung. Prisia asserts that the Accused Devices meet both limitations.

In relevant part, Claim 1 states "[p]erforming 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." ECF No. 205, Ex. A.1 at 151. The Court construed "original video data stream" to mean "a digitally recorded sequence of image frames that is to be

modified.” *Markman* Order (ECF No. 103) at 8. The Court construed a “video” as a “series of images in succession that creates the illusion of movement.” *Id.*

The following figure represents a step performed by the Best Face application.



The crux of Samsung’s argument is that the claimed original video data stream is the yellow rectangles⁹ that define the areas of the faces detected in a single photo and that image data within these yellow rectangles is not a “sequence of image frames.” Samsung’s Motion (ECF No. 153) at 8. But Prisia argues that the five burst images, not the yellow rectangle data, form a sequence of images.¹⁰ Samsung says even if this were true, “the claims require ‘an image display device *displaying* the original video data stream.’ In the Accused Products, only one of the five burst photos is displayed.” Samsung’s Reply (ECF No. 205) at 4 (emphasis in original).

⁹ The yellow rectangles are the two rectangles found on the top portion of the displayed background image.

¹⁰ The testimony relied upon by Prisia is contained in declarations attached to its Response (ECF No. 8). As noted above, the Court denied Samsung’s motion to strike these declarations. Omnibus Order (268) at 27.

The Parties' conflicting arguments and expert testimony make it clear that issues of fact remain as to what constitutes the original video data stream in the Accused Devices. It is not within the Court's purview to make this determination.¹¹

C. **Samsung Has Not Met Its Burden of Proving That the Asserted Claims Are Not Invalid as Indefinite.**

Samsung argues that the Asserted Claims of the '591 Patent are invalid as indefinite under 35 U.S.C. § 112. Specifically, Samsung argues that Claim 1 impermissibly includes method steps in an apparatus claim. Samsung cites the PTAB's Decision as highly persuasive of the indefiniteness and invalidity of the Asserted Claims, while noting that the PTAB's Decision is not binding. In response, Prisia argues that Samsung waived this argument and that the Asserted Claims are not invalid as indefinite.

Under 35 U.S.C. § 112(b), a patent must "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter" of the claimed invention. A patent's claims are invalid as indefinite 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. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129–30 (2014). A patent that recites "both an apparatus and a method of using that apparatus renders a claim indefinite." *IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (2005). The purpose is to prevent a situation where "a manufacturer or seller of the claimed apparatus would not know from the claim whether it might also be liable for contributory infringement because a buyer or

¹¹ Samsung's argument regarding the "displayable edited video data stream" fares no differently. As issues of fact remain as to what constitutes an "original video data stream," so do issues regarding "displayable edited video data stream" because the latter derives meaning from the former.

user of the apparatus later performs the claimed method of using the apparatus.” *IPXL Holdings, LLC*, 430 F.3d at 1384.

First, the PTAB Decision does not illuminate the issue of invalidity such that a grant of summary judgment is warranted. In granting Prisia’s motion to exclude evidence of the PTAB’s Decision, the Court noted the differing standard of review and different evidence employed by the PTAB. Omnibus Order (ECF No. 268) at 5. This is an unpersuasive apples to oranges comparison.

Second, Prisia argues that Samsung waived this argument by failing to raise it prior to summary judgment. The Court’s Patent Pretrial Order (ECF No. 10) required Samsung to serve invalidity contentions on Prisia within forty-five days of Prisia’s service of infringement contentions. The Patent Pretrial Order required invalidity contentions on the basis of 35 U.S.C. § 112 be set forth with specificity. *Id.*, ¶ 2(c)–(d). And any amendment to contentions “may be made only by order of the Court upon a timely showing of good cause.” *Id.*, ¶ 4(a). The Court also stated that “[t]he duty to supplement discovery responses does not excuse the need to obtain leave of court to amend contentions.” *Id.*, ¶ 4(b).

Samsung contests the alleged waiver, arguing that it expressly alleged invalidity as an affirmative defense. Answer (ECF No. 59) at 6. Samsung’s second affirmative defense, entitled “Invalidity, Unenforceability,” states “[t]he Asserted Patent is invalid and/or void for failure to comply with the requirements of Part II of Title 35 of the United States Code, including, for example §§ 101, 102, 103, and 112.” *Id.* Samsung also points to its Invalidity Contentions and the corrected petition in the *inter partes* review proceeding as putting Prisia on notice of its indefiniteness argument. Invalidity Contentions (ECF No. 205, Ex. B) at 1–2; Corrected Petition

(ECF No. 205, Ex. C) at 38 n. 7. Neither the Invalidity Contentions¹² nor the Corrected Petition¹³ imply that Prisia should have been on notice of Samsung's mixed method/apparatus theory of invalidity.

Samsung does not address its failings with respect to the requirements set forth in the Patent Pretrial Order. Further, Samsung recently moved to amend its invalidity contentions and still did not present this theory as a basis for amendment.¹⁴ Samsung indeed seeks to improperly introduce a new theory of invalidity. *See Realtime Data, LLC v. Packeteer, Inc.*, No. 6:08-cv-144, 2009 WL 4782062 (E.D. Tex. Dec. 8, 2009). The Court will not consider this theory on summary judgment.

D. Samsung Has Not Met Its Burden of Proving That The Asserted Claims Are Invalid Because They Lack Written Description.

Samsung also moves for summary judgment on the basis that the Asserted Claims are invalid because they lack written description. The basis for Samsung's argument is: (1) that the "spatially matching" limitation was added after the initial filing of the '591 Patent and (2) the limitation fails to provide a written description for "spatially matching."

35 U.S.C. § 112(a) requires that a patent "contain a written description of the invention, and of the manner and process of making and using it." The written description must "allow[] a person of skill in the art to recognize that the patentee invented what is claimed." *Synthes USA*

¹² Samsung identifies bases for finding the Patent invalid as indefinite but does not claim invalidity due to a mixed method and apparatus claim. *See Invalidity Contentions* (ECF No. 205-1, Ex. B) at 15–16 (Identifying bases for invalidity "discloses those grounds of invalidity based on 35 U.S.C. § 101, indefiniteness under § 112(b) or lack of enablement or written description under 35 U.S.C. § 112(a) of any of the asserted claims").

¹³ Corrected Petition (ECF No. 205-1, Ex. C) at 38 ("As shown herein, claims 3–4 contain numerous § 112 issues (*e.g.*, written description, indefiniteness).").

¹⁴ The Court denied Samsung's Motion to Amend Invalidity Contentions. Order on Motion for Leave to Amend Invalidity Contentions (ECF No. 231).

LLC v. Spinal Kinetics, Inc., 734 F.3d 1332, 1341 (Fed. Cir. 2013). The patentee must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Vas-Cath Inc. v. Majurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991). “[T]he written description inquiry looks to the four corners of the specification to discern the extent to which the inventor[s] had possession of the invention as broadly claimed.” *Rivera v. Int’l Trade Comm’n*, 857 F.3d 1315, 1319 (Fed. Cir. 2017). But the written description of a patent “need not contain precisely the same words as are found in the asserted claims.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008) (internal citation omitted). The written description must “actually or inherently disclose the claim element.” *Id.* at 1306.

The written description requirement is a question of fact. *Id.* at 1307. But Samsung contends that summary judgment is appropriate because no reasonable fact finder could return a verdict for the non-moving party. Samsung’s Motion (ECF No. 153) at 15 (citing *PowerOasis*, 522 F.3d at 1307. Samsung states that “Prisua has failed to point to any evidence to the contrary save the objective opinion of the inventor of the ’591 Patent and conclusory statements by its expert that ‘spatially matching’ was known.” Samsung’s Motion (ECF No. 153) at 16.

In response, Prisua argues that Samsung has failed to carry its burden of establishing invalidity on this issue by failing to cite any factual or expert evidence. Prisua’s Response (ECF No. 182) at 16. Further, one of Prisua’s experts stated that what is contained in the written description necessarily and inherently teaches spatial matching as part of the invention. Negahdaripour Decl. (ECF No. 182, Ex. 5, ¶¶ 5–6). Prisua contends that based on the written description, a person of ordinary skill in the art would understand that the process described of substitution and embedding the user input data into another data set as if it were originally its

own, would require a mapping that aligns the pixels in the spatial domain correctly “to produce a resulting stream where the user inputted data becomes part of the input device’s stream as if it were originally its own.” *Id.* ¶ 9. This would require a spatial match of the areas of the two images, the one being substituted and the one used in the substitution/embedding. *Id.* ¶¶ 7–9.

Although the written description does not contain the phrase “spatial matching,” it is possible that the trier of fact—here, the jury—will find that the application discloses that particular device. Samsung has thus failed to meet its heavy burden and summary judgment on this issue is precluded.

V. CONCLUSION

For the foregoing reasons, Samsung’s Motion for Summary Judgment (ECF No. 153) is hereby DENIED.

DONE AND ORDERED in Chambers at Miami, Florida, this 15th day of February, 2018.

K. MICHAEL MOORE
CHIEF UNITED STATES DISTRICT JUDGE

c: All counsel of record