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10 **IN THE UNITED STATES DISTRICT COURT**
11 **FOR THE CENTRAL DISTRICT OF CALIFORNIA**

12 **DIGITAL VERIFICATION**
13 **SYSTEMS, LLC**

14
15 Plaintiff,

16 v.

17 **ENCYRO, INC.**

18 Defendant.
19

Case No. 5:22-cv-00686-JWH-SP

DEFENDANT’S RESPONSIVE
CLAIM CONSTRUCTION BRIEF

January 19, 2023, at 10:00 a.m.
Courtroom 9D

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22 **DEFENDANT’S RESPONSIVE CLAIM CONSTRUCTION BRIEF**

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25 Herein Defendant responds to Plaintiff’s Opening Claim Construction Brief,
26 Dkt. No. 31.

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**I. MR. ROTHSCHILD’S DECLARATION SHOULD BE STRICKEN,
AND DVS SANCTIONED UNDER RULE 30(D)(2)**

Pursuant to this Court’s Scheduling Order and the adopted Northern District of California’s Patent Local Rules (“PLR”), Rule 4-2, extrinsic evidence was to be disclosed on November 11, 2022. Order, Dkt. No. 21; DVS Rule 4-2 Disclosure, Lamkin Decl., Exh A. On November 11, 2022, DVS did not disclose that it would be filing a declaration from the named inventor and owner of DVS, Leigh Rothschild. *Id.* Conversely, in accordance with this Court’s Scheduling Order and adopted PLR 4-2, Encyro provided to DVS a copy of Professor Hughes’ Declaration. *See* Dkt. Nos. 28, 30-4. Encyro also offered Professor Hughes’ deposition, which Encyro declined to take.

Pursuant to the Court’s Scheduling Order and PLR 4-2(c) and 4-3, the Parties then engaged in a meet and confer to narrow the disputed claim construction issues and exchanged drafts of the Joint Claim Construction Statement (“JCCS”). Again, DVS did not disclose Leigh Rothschild or his testimony. *See* Dkt. No. 28.

Pursuant to the Court’s Scheduling Order and PLR 4-3, on December 2, 2022, the Parties filed their JCCS. The JCCS requires, “an identification of any extrinsic evidence [including . . .] testimony of percipient and expert witnesses”. Dkt. No. 28, at 2. DVS still did not disclose Mr. Rothschild. *Id.* As of the filing of the JCCS, DVS had failed to disclose Mr. Rothschild’s testimony to Defendant and to the Court, in

1 contravention of this Court’s Scheduling Order, Dkt. No. 21.

2 On December 9, 2022, the Parties filed their opening claim construction briefs,
3 wherein DVS surprised Encyro with Mr. Rothschild’s 18-page declaration, replete
4 with dense citations. Dkt. No. 31-4. Encyro immediately wrote to DVS and asked that
5 it either withdraw Mr. Rothschild’s declaration or allow Encyro to depose Mr.
6 Rothschild to minimize the prejudice to Encyro. Lamkin Decl., Exh. B; *see also*
7 *Dexcom, Inc. v. AgaMatrix, Inc.*, No. CV 16-05947 SJO (ASx), 2017 U.S. Dist. LEXIS
8 178846, at *15-24 (C.D. Cal. Aug. 1, 2017) (excluding expert declaration for failure to
9 disclose).

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13 DVS largely ignored Encyro’s communications until Tuesday December 20,
14 2022, *i.e.*, 11 days after the opening briefs and 3 days before the responsive briefs were
15 due. Lamkin Decl., Exh C. In its December 20 email, DVS stated that Mr. Rothschild
16 could be available for deposition on Thursday afternoon December 22, 2022, *i.e.*, the
17 afternoon before Encyro’s rebuttal claim construction brief was due. Encyro ignored
18 DVS’ gamesmanship and prepared for Mr. Rothschild’s deposition. Said preparation
19 involved Encyro’s counsel and expert clearing their full calendars to adequately
20 prepare for Mr. Rothschild’s deposition in two day’s time. Lamkin Decl., ¶8.

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24 Even as Encyro bent over backward to accommodate DVS’ improper conduct,
25 DVS’ gamesmanship escalated. Under the Federal Rules, Encyro was entitled to a 7-
26 hour deposition of Mr. Rothschild. Fed.R.Civ.P 30(d)(1). But, at the beginning of his
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1 deposition, Mr. Rothschild again surprised Encyro by announcing that he would only
2 sit for one hour. Rothschild Rough Depo Tr., 2:6-22. Lamkin Decl., Exh C.¹

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4 Encyro’s counsel attempted to explain to Mr. Rothschild that Encyro would be
5 forced to move to strike given the prejudice Encyro would suffer at not being able to
6 adequately depose Mr. Rothschild if he did not agree to extend his deposition. *Id.*, at
7 3:2-5:9, 41:5-42:16. Encyro even offered to continue the deposition to the next
8 morning, *i.e.*, today, the deadline for Encyro’s responsive brief, but Mr. Rothschild
9 refused every attempt at compromise. *Id.*, 41:5-42:16.

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12 Further, in deposition, Mr. Rothschild was combative and evasive, refusing to
13 answer nearly every question posed. The entire transcript is replete with obfuscation,
14 as detailed below and as highlighted in Mr. Rothschild’s rough transcript. *See, e.g.*,
15 Rothschild Rough Depo Tr., 7:1-10, 17:9-18:9, 20:3-25, Lamkin Decl., Exh. C.

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18 Mr. Rothschild even refused to follow Encyro’s request that he use a computer
19 able to download exhibits because, in his first deposition unrelated to claim
20 construction, Mr. Rothschild forced Encyro to depose him while he used an iPad with
21 no ability to view or download exhibits. As such, Encyro requested, prior to his
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25 ¹ The rough transcript was provided last night, December 22, 2022. Encyro will file
26 the final once received. Encyro notes, while California state courts do not permit
27 submission of draft transcripts, Encyro is aware of no such bar in federal court. *See*
28 *Fontenot v. Safety Council of Sw. La.*, No. 2:16-CV-84, 2017 U.S. Dist. LEXIS 97618,
at *16 (W.D. La. June 23, 2017); *Jadwin v. Abraham*, No. 1:07-cv-00026-OWW-TAG,
2008 U.S. Dist. LEXIS 116780, at *17 (E.D. Cal. Aug. 22, 2008).

1 deposition, that Mr. Rothschild employ the proper equipment at deposition. Lamkin
2 Decl., Exh D, at 1. But yet again, Mr. Rothschild refused to employ the proper
3 deposition equipment, severely constraining and confusing an already rushed and
4 unnecessarily contentious deposition. Rothschild Rough Depo Tr., 6:9-14, 37:7-10,
5 *passim*.
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8 Ultimately, as shown below, DVS and Mr. Rothschild frustrated every attempt
9 at a fair deposition. As such, DVS should pay Encyro’s fees and costs associated with
10 Mr. Rothschild’s deposition. Fed.R.Civ.P 30(d)(2); *RG Abrams Ins. v. Law Offices of*
11 *C.R. Abrams*, No. 2:21-cv-00194-FLA-MAAx, 2021 U.S. Dist. LEXIS 253216, at *71
12 (C.D. Cal. Dec. 22, 2021) (“Sanctions [under Rule 30(d)(2)] can include the payment
13 of fees, expert witness fees, court reporter fees, and attorney travel.”). Lamkin Decl.,
14 ¶8 (setting forth \$22,517.15 in fees and costs).
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17 Even setting aside Mr. Rothschild’s conduct, Mr. Rothschild’s declaration
18 should be stricken because DVS has failed to establish that he is a person of skill in the
19 art (“POSITA”). *United States v. Real Prop.*, 763 F. Supp. 2d 1175, 1186 n.77 (C.D.
20 Cal. 2011) (“The party offering the expert bears the burden of establishing that Rule
21 702 is satisfied.”) (collecting cases); *Lust by & Through Lust v. Merrell Dow Pharm.*,
22 89 F.3d 594, 598 (9th Cir. 1996) (accord).
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26 It is true that inventors are “typically” presumed to be POSITA, but here that
27 presumption has been rebutted. *See, e.g., Phillips v. AWH Corp.*, 415 F.3d 1303, 1313
28

1 (Fed. Cir. 2005) (*en banc*) (inventors are typically persons skilled in the field of the
2 invention). Mr. Rothschild appears to have no experience in the pertinent art, does not
3 have a computer science degree, and cannot cite to any experience that qualifies him as
4 an expert in the pertinent art. Rothschild Rough Depo Tr., 8:5-10:16. Moreover, as
5 discussed herein, the '860 Patent fails to contain any actual technical disclosures,
6 further evidencing the named inventor's lack of knowledge in the art. *See Sport*
7 *Dimension, Inc. v. Coleman Co.*, No. CV 14-00438 BRO (MRWx), 2015 U.S. Dist.
8 LEXIS 192011, at *7 (C.D. Cal. Jan. 29, 2015) ("Mr. Bressler cannot testify as an
9 expert witness unless he 'is qualified as an expert *in the pertinent art*'") (emphasis in
10 the original); *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356 (Fed. Cir.
11 2008).)²

12 Finally, Mr. Rothschild admitted that DVS' counsel wrote his entire declaration.
13 Rothschild Rough Depo Tr., 40:21-41:2. It's quite clear from Mr. Rothschild's brief
14 deposition, that he had no familiarity with the contents of his declaration. *See, e.g., id.*,
15 at 11:1-12:17, 21:9-14, 22:12-19, 39:2-40:4.

23 ² DVS states, "a POSITA of the subject matter claimed by the Patent-in-Suit is a
24 person having a bachelor's degree in computer science or electrical engineering, or by
25 equivalent education or training, and approximately 0-3 years of experience." DVS
26 OCCB, 10:10-12. Defendant contends DVS' position is inconsistent with the law, as
27 POSITA must have skill *in the pertinent art*. *Sport Dimension*, 2015 U.S. Dist.
28 LEXIS 192011, at *7. As such, POSITA should have a bachelor's degree in computer
science with an emphasis on encryption or data verification, or the equivalent in
experience or training.

1 Mr. Rothschild's declaration should be stricken as proffered in contravention of
2 this Court's Scheduling Order and because DVS has failed to meet its burden to
3 establish that Mr. Rothschild is an expert under Rule 702. Finally, because DVS and
4 Mr. Rothschild's conduct prevented a fair deposition, DVS should pay Encyro's fees
5 and costs associated with said deposition, \$22,517.15. Lamkin Decl., ¶8.
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8 **II. EACH OF THE FOUR, POSSIBLY FIVE, CLAIM CONSTRUCTION**
9 **ISSUES SHOULD BE RESOLVED IN DEFENDANT'S FAVOR**

10 **A. The Module Generating Assembly is Comprised of Hardware**

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12 The Parties have agreed that the claimed system is at least partially composed of
13 hardware. Lamkin Decl., Exh B (third point), Exh D, at 4. The debate before the
14 Court is whether the hardware portion includes the module generating assembly. DVS
15 OCCB, at 11:18-22. DVS' refusal to acknowledge a fact it was desperate to establish
16 in the prosecution history is a tad on the nose. During prosecution, Mr. Rothschild told
17 the USPTO that the module generating assembly "must contain hardware". '860
18 Patent, PxHx, Dkt. No. 31-3, at DVSENC_00000268. In litigation, Mr. Rothschild,
19 the owner of DVS, attempts to duck his own representations to the USPTO:
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23 Q. Okay. In general, do you make an effort to make truthful statements to the
24 USPTO during the prosecution of your patents?

25 A. Absolutely and unequivocally.
26 . . .

27 Q. So you understand that this [Exhibit] is an amendment admitted by applicant
28 [Rothschild] in the prosecution history of the '860 patent; correct?

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A. I do.

...

Q. I'm reading the last line on the first page. It says "Therefore, properly construed, the claimed module generating assembly must include hardware." Do you see that line, sir?

A. I do.

Q. Is that the truth?

A. I don't understand the question.

Q. This was a statement submitted on your behalf to the United States Patent and Trademark Office. Is it a true statement?

A. It is a statement that was submitted in the application, Ms. Lamkin.

Q. Sir, my question is this: Is it a true statement?

A. It is a statement as was submitted in the application.

Q. Sir, it's a yes-or-no question. Is it true?

A. I've given you – I've given you my answer, Ms. Lamkin.

Rothschild Rough Depo Tr., 14:9-12, 16:15-18, 17:9-18:2.

Mr. Rothschild's deposition gymnastics aside, he told the USPTO that the module generating assembly "must" contain hardware, and the public is entitled to hold him to his word. *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1344 (Fed. Cir. 2015); *Springs Window Fashions LP v. Novo Indus., L.P.*, 323 F.3d 989, 995 (Fed. Cir. 2003); *Infinity Comput. Prods. v. Oki Data Ams., Inc.*, 987 F.3d 1053, 1059 (Fed. Cir. 2021).

1 **B. “Module Generating Assembly” is an Indefinite Term**

2 The term “module generating assembly,” present in every asserted claim, is
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4 indefinite because it is a means-plus-function term, and the specification fails to clearly
5 link the term to a sufficient disclosure in the specification.

6 The claim term, “a module generating assembly” nested within the functional
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8 claim language “structured to receive at least one verification data element
9
10 corresponding to the at least one entity and create said at least one digital identification
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12 module,” is a black box that performs claimed functions; it is purely functional
13
14 claiming. Claim 1, lim[b]. The claim language fails to provide any structure for
15 performing the claimed function. As such, the module generating assembly term is a
16 means-plus-function term.³ *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1351
17 (Fed. Cir. 2015) (*en banc*); *Rain Computing, Inc. v. Samsung Elecs. Am., Inc.*, 989
18 F.3d 1002 (Fed. Cir. 2021).

19 As explained in *Williamson* and applicable here, “‘module’ is simply a generic
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21 description for software or hardware that performs a specified function. Generic terms
22
23 such as ‘mechanism,’ ‘element,’ ‘device,’ and other nonce words that reflect nothing

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25 _____
26 ³ There is a presumption, though not a “strong presumption,” that a term that does not
27 use “means” is not a means-plus-function term. But that presumption is overcome,
28 where, as here, the claim term fails to recite sufficiently definite structure or else
recites function without reciting sufficient structure for performing that function.
Williamson v. Citrix Online, LLC, 792 F.3d 1339, 1349 (Fed. Cir. 2015) (*en banc*).

1 more than verbal constructs may be used in a claim in a manner that is tantamount to
2 using the word ‘means’ because they ‘typically do not connote sufficiently definite
3 structure’ and therefore may invoke § 112, para. 6.” *Williamson*, at 1350-51; *Rain*, at
4 1006.

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6 As here, “assembly” is also considered a nonce word. *MTD Prods. Inc. v.*
7 *Iancu*, 933 F.3d 1336, 1344 (Fed. Cir. 2019). “Indeed, ‘assembly’ is akin to other
8 terms, like ‘mechanism,’ ‘element,’ and ‘device,’ . . . because they ‘typically do not
9 connote sufficient definite structure.’” *Pelican Int'l Inc. v. Hobie Cat Co.*, No. 20-cv-
10 2390-BAS-MSB, 2022 U.S. Dist. LEXIS 18400, at *19 (S.D. Cal. Feb. 1, 2022)
11 (quoting *Williamson*, at 1350).

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15 Tellingly, DVS fails to point to any structure in the claim. DVS OCCB, 11:12-
16 13:7. Of concern, instead DVS repeats the same argument made in its opposition to
17 Encyro’s bond motion, *i.e.*, “if Defendant’s interpretation of the PTAB’s ruling was
18 correct, why would the PTAB have determined the term (as Defendant suggests)
19 invalid for failure to provide a structure, yet neither institute a petition to declare the
20 claim invalid nor declare the claim invalid for this reason.” DVS OCCB, 12:27-13:2;
21 Opp. Bond Mot., Dkt. No. 26, 15:10-13. This argument is legally frivolous. DVS is
22 represented by 4 patent litigators, 2 of said litigators are admitted to practice before the
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1 USPTO.⁴ Each is responsible for knowing patent law, *i.e.*, that the PTAB is not
2 permitted to invalidate a claim as indefinite nor is it permitted to institute an IPR if it—
3 as here—finds the term at-issue indefinite. *Samsung Elecs. Am., Inc. v. Prisia Eng'g*
4 *Corp.*, 948 F.3d 1342, 1350 (Fed. Cir. 2020) (*citing Cuozzo Speed Techs., LLC v. Lee*,
5 136 S. Ct. 2131, 2141-42, 195 L. Ed. 2d 423 (2016).) The PTAB did the only thing it
6 was permitted to do, told the world that the asserted claims of the '860 Patent were
7 means-plus-function with no corresponding structure, *i.e.*, invalid. IPR Decision, Dkt.
8 No. 22-7.

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12 If determined to be means-plus-function, the specification must “clearly link”
13 the functional claim language to a disclosed corresponding structure in the
14 specification. *Williamson*, 792 F.3d, 1352. Both parties agree that the functional
15 language is: “[i] receive at least one verification data element corresponding to the at
16 least one entity and [ii] create said at least one digital identification module”. DVS
17 RCCB, at 13:11-13. But there is nothing that “clearly links” these functions to a
18 structure in the specification, the only “structure” that performs that function is a
19 generic black box called a “module generating assembly”. *See, e.g.*, '860, 3:46-49. A
20 generic black box is not sufficient structure; a generic computer or server can do lots of
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⁴ In responding to this same argument in its Reply, Encyro noted that DVS had 3 patent litigators. Reply, Dkt. No. 27, 7:25. But this number omits DVS' General Counsel, who is also a patent litigator admitted before the USPTO.

1 things, they do not limit the claims to a “corresponding structure”. As explained by the
2 Federal Circuit in *Aristocrat Techs. Austl. PTY Ltd. v. Int'l Game Tech.*, 521 F.3d 1328
3 (Fed. Cir. 2008), “In cases involving a computer-implemented invention in which the
4 inventor has invoked means-plus-function claiming, this court has consistently
5 required that the structure disclosed in the specification be more than simply a general
6 purpose computer or microprocessor.” *Id.*, at 1333. “If the specification is not clear as
7 to the structure that the patentee intends to correspond to the claimed function, then the
8 patentee has not paid the price but is attempting to claim in functional terms
9 unbounded by any reference to structure in the specification.” *Id.* (quoting *Diagnostics*
10 *Corp. v. Elekta AB*, 344 F.3d 1205, 1211 (Fed. Cir. 2003).); *Net MoneyIN, Inc. v.*
11 *VeriSign, Inc.*, 545 F.3d 1359, 1367 (Fed. Cir. 2008).

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16 It's helpful to consider when a “general purpose computer” might provide
17 sufficient structure. One example is the “rare” *Katz* exception. See *Ergo Licensing,*
18 *LLC v. CareFusion 303, Inc.*, 673 F.3d 1361, 1365 (Fed. Cir. 2012) (discussing “the
19 rare circumstances where any general-purpose computer without any special
20 programming can perform the function that an algorithm need not be disclosed,” and
21 citing *Katz Interactive Call Processing Patent Litig. v. Am. Airlines, Inc. (In re Katz*
22 *Interactive Call Processing Patent Litig.)*, 639 F.3d 1303 (Fed. Cir. 2011).) In *Katz*,
23 the claimed functions performed were themselves generic, *i.e.*, “processing, receiving,
24 and storing” data. *Ergo*, at 1365. As such, “the disclosure of a general-purpose
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1 computer was sufficient”. *Id.*; *Katz*, 639 F.3d, 1316. Again, it is rare that a claimed
2 function is so generic that a general purpose computer can provide the structure. *Ergo*,
3 at 1364-65.
4

5 All of this makes sense. In the rare instance when a claim contains simple
6 computer operations like sending and receiving data and nothing more, the structure
7 that accomplishes those functions can be a general purpose computer. Put another
8 way, “a microprocessor can serve as structure for a computer-implemented function
9 only where the claimed function is coextensive with a microprocessor itself.” *EON*
10 *Corp. IP Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616, 621-22 (Fed. Cir. 2015).
11 Here, there can be no sound argument that the admitted functions are “coextensive”
12 with a processor. *See Eon*, at 621-22; *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d
13 1359, 1366-68 (Fed. Cir. 2008); *Ironworks Patents LLC v. Samsung Elecs. Co.*, 798 F.
14 App'x 621, 628 (Fed. Cir. 2020). Here, the claimed function—as agreed by both
15 Parties—is “receive at least one verification data element corresponding to the at least
16 one entity and create said at least one digital identification module”. As such, they do
17 not fall under the “rare” *Katz* exception.
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23 DVS’ claims must be bounded by a specific structure, else they are boundaryless
24 and thus indefinite. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901, 134
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1 S. Ct. 2120, 2124 (2014).⁵

2 In his declaration, Mr. Rothschild states that the module generating assembly
3 could be a computer application, a web server, a file server, or “or other computing
4 device”. Dkt. No. 31-4, ¶¶21-22. Of course, none of these generic applications or
5 devices constitute a specific “corresponding structure” because a “general purpose
6 computer” cannot be a corresponding structure where, as here, the claimed function is
7 not basic general purpose computer functions. *Williamson*, at 1352; *Aristocrat*, 1333;
8 *Rain*, 989 F.3d, at 1007; *Ergo*, 1364-65.

9 Further, Mr. Rothschild’s position conflicts with the intrinsic record. “In at least
10 one embodiment, however, the module generating assembly is at least partially
11 integrated within the computer application”. ’860 Patent, 2:19-22, 7:60-66, 8:31-35.
12 This is, the very embodiment cited by DVS in its claim construction disclosure⁶ and
13 the very embodiment called for by the claim language: “in at least another
14 embodiment, the module generating assembly is at least partially integrated within the
15 computer application, such as the word processing program, for example, as a feature,
16 option, or plug-in. In such an embodiment, the digital identification module need not
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25 ⁵ “Indefiniteness is a question of law this court reviews de novo.” *In re Walter*, 698 F.
26 App’x 1022, 1025 (Fed. Cir. 2017) (*citing Biosig Instruments, Inc. v. Nautilus, Inc.*,
27 783 F.3d 1374, 1377 (Fed. Cir. 2015) (*citing Interval Licensing LLC v. AOL, Inc.*, 766
28 F.3d 1364, 1370 (Fed. Cir. 2014)).)

⁶ JCCS, Dkt. No. 28, 4:15-16, *citing* ’860, 7:48-8:62.

1 be imported, but is rather created, at least in part, by the module generating assembly.”
2 Dkt. No. 28, 4:15-16; ’860, 8:31-38. The embodiment called for in the claim (the one
3 that creates the digital identification module, lim[b]) is the embodiment that “is at least
4 partially integrated within the computer application, such as the word processing
5 program”. Dkt. No. 28, 4:15-16; ’860, 8:31-38, Claim 1, lim[b].
6
7

8 Based on the intrinsic record and DVS’ own evidence, the module generating
9 assembly that creates the digital identification module (Claim 1, lim[b]) must be able
10 to be “at least partially integrated within the computer application”. ’860, 8:31-38.
11 But it makes no sense to opine that “a computer application, a web server, a file server,
12 or other computing device” can be “at least partially integrated within the computer
13 application”. How can an application (like Microsoft Word) be integrated into itself,
14 Microsoft Word, the example given in the patent (5:1-5)? Or a server integrated into
15 Microsoft Word? Its semantically (Word into Word) and technologically (server into
16 Word) impossible.
17
18
19

20 Again, Mr. Rothschild’s refusal to respond to questions on this issue is telling.
21 Indeed, he is so unfamiliar with his own declaration that he refuses to answer questions
22 because verifying the statements in his own declaration would be, according to him,
23 speculation:
24
25

26 Q. To be clear, then, in paragraphs 21 and 22, Mr. Rothschild, is it true that you
27 are saying the module generating assembly may be a computer application or
28 web server, a file server or other computing device?

1
2 A. I know you want, Ms. Lamkin, me to answer to your questions which would
3 call for speculation. My answer is it is what it says in the declaration. I will not
4 speculate.

5 Q. Sir, I'm not asking you to speculate. I'm asking you to read your own sworn
6 declaration. I'm asking you, in paragraphs 21 and 22, is it your opinion that the
7 module generating assembly might be a computer application or a web server
8 running on a device or a file server or other computing device?

9 A. My opinion, Ms. Lamkin, is as stated in those paragraphs, which is part of the
10 declaration of Leigh Rothschild in support of the Plaintiff's Opening Claim
11 Construction Brief, as you defined it, Exhibit 1.

12 ...

13 Q. I'll give you one more opportunity to answer the question, Mr. Rothschild. In
14 paragraphs 21 and 22 of your sworn declaration, document number 31-4, is it
15 your opinion that the module generating assembly may be a computer
16 application or a web server running on a device or a file server or other
17 computing device?

18 A. If the court reporter would like to read back my testimony, as I previously
19 answered this question twice, that would be my answer.

20 ...

21 Q. If you could please turn to Column 2, lines 8 to 22 [of the patent], which I
22 will read into the record. "In at least one embodiment, however, the module
23 generating assembly is at least partially integrated within the computer
24 application, e.g., an interactive word processing program." Do you see that, sir?

25 A. I do.

26 Q. Do you have an understanding of what that passage means in your patent?

27 A. Yes, I do.

28 Q. Can you please explain it?

A. It means that in at least one embodiment, however, the mobile generating
assembly is at least partially integrated within the computer application, e.g., an
interactive word processing program. In other words, it means what it says. It's

1 the plain and ordinary meaning as placed in the patent application.

2 ...

3 Q. Okay. So in your opinion, the module generating assembly may be a
4 computer application or a web server returning on a device; correct?

5 A. That is what it states, Ms. Lamkin.

6 ...

7 Q. Okay. Now, with that in mind, could we please turn back to Exhibit 2, the
8 '860 patent. In the highlighted language, you write "In at least one embodiment,
9 however, the module generating assembly is at least partially integrated within
10 the computer application." Do you see that, sir?

11 A. I do.

12 ...

13 Q. How is it possible to have a computer application integrated within a
14 computer application?

15 A. First of all, it means what it says, as provided in the specificity of patent
16 number 9,054,860.⁷

17 ...

18 Q. Mr. Rothschild but I'll give you another opportunity. Could you please
19 explain how it's possible to have a computer application partially integrated
20 within a computer application?

21 A. I testified that in paragraphs 21 through 25 in my declaration, that is
22 explained. If you would like me to read paragraphs 21 through 25 into the record
23 so that you have it before you, I'd be more than happy to do that now. Just tell
24 me when to start, Ms. Lamkin.

25 Q. Mr. Rothschild, I'll give you one more opportunity to answer the question
26 that I'm asking, that is: How is it possible to have a computer application
27 partially integrated within a computer application?

28 A. If the court reporter would choose to read back my testimony, that would be
my -- on this matter, as per your question, that would be my answer, for the third

⁷ Mr. Rothschild then provides a long combative answer that doesn't answer the question and is too long to place herein given the page limitations. See Exh C, at 26:1-27:4.

1 time.

2 Rothschild Rough Depo Tr., 21:5-22:6, 23:9-27:23; *see also id.*, at 28:16-32:14 (asking
3 how a server can be “partially integrated” into an application, to the same effect).
4

5 In addition to the portions of the patent specification DVS itself identified as
6 providing corresponding structure, DVS also identified Figure 7 as providing
7 corresponding structure for the module generating assembly. JCCS, Dkt. No. 28, 4:14.
8 DVS’ position is inconsistent with the intrinsic record. Figure 7 depicts “generally”
9 the process of “digital identification verification”. ’860, 7:48-50. The module
10 generating assembly (50) isn’t even depicted in Figure 7.
11
12

13 In deposition, Mr. Rothschild again refused to answer direct questions on the
14 issue:
15

16 Q. Where is the module generating assembly 50 in Figure 7 of the ’860 patent,
17 Mr. Rothschild?

18 A. Could you repeat the question?
19

20 Q. Where is module generating assembly 50 in Figure 7 of the ’860 patent?

21 A. Well, referring to the drawing, it is, as is stated, Ms. Lamkin. It’s self evident.
22

23 Q. Your testimony, sir, is that it’s self evident that module generating assembly
24 50 is in Figure 7?

25 A. My testimony is the exhibit, as – the exhibit is as it was published in my
26 declaration as Figure 7. Nothing more, nothing less.

27 Q. I’ll ask the question one more time, Mr. Rothschild. Can you please explain
28 where module generating assembly 50 is depicted in Figure 7 of the ’860 patent?

1
2 A My answer is that Figure 7, as was reproduced in my declaration, is as it
3 stands, is as it was published, and is self explanatory.

4 Rothschild Rough Depo Tr., 34:5-23.

5 In addition to his refusal to answer questions about his own declaration and
6 central to claim construction, Encyro had prepared dozens of other questions material
7 to this issue, but Mr. Rothschild refused to sit beyond a single hour. Mr. Rothschild's
8 declaration should be stricken, and his company DVS sanctioned under Rule 30(d)(2).
9

10
11 Regardless, DVS' position, that the module generating assembly could be "a
12 computer application, a web server, a file server, or other computing device," is *contra*
13 well-established law; a corresponding structure cannot be a general computer. And the
14 position makes no sense in the context of the intrinsic record. DVS citation to Figure 7
15 fares no better, it does not even mention the module generating assembly (50).
16

17 Further, Rothschild's declaration should be disregarded because it contradicts the
18 intrinsic record. *See BASF Agro B.V. v. Makhteshim Agan of N. Am., Inc.*, 519 F.
19 App'x 1008, 1018 (Fed. Cir. 2013) ("Extrinsic evidence cannot vary the terms of the
20 claims or otherwise contradict the intrinsic record. Even testimony from a qualified
21 expert has little probative value if it is inconsistent with the intrinsic record.")
22 (citations omitted).
23
24

25
26 The asserted claims are invalid as indefinite. The module generating assembly
27 is a means-plus-function term with no corresponding structure disclosed in the
28

1 specification.

2 **C. The “Partially Associate” Term is Indefinite**

3
4 The asserted claims disclose, “at least one digital identification module
5 comprising at least one primary component structured to at least **partially associate**
6 said digital identification module with said at least one entity”. ’860, 9:16-19
7
8 (emphasis added). But the patent offers no “objective boundaries” for the term
9 “partially associate”. As such, the term is indefinite. *Interval Licensing LLC v. AOL,*
10 *Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014). As the United States Supreme Court has
11 explained, “a patent does not satisfy the definiteness requirement of § 112 merely
12 because a court can ascribe some meaning to a patent’s claims.” *Id.* (quoting *Nautilus,*
13 *134 S. Ct. at 2130*). “The claims, when read in light of the specification and the
14 prosecution history, must provide objective boundaries for those of skill in the art.” *Id.*
15 Here, the specification provides zero explanation, zero meaning, zero “objective
16 boundaries” for the term. *See, e.g., Rillito River Ltd. Liab. Co. v. Bamboo Indus. Ltd.*
17 *Liab. Co.*, No. 2:17-cv-00181-TLN-CKD, 2018 U.S. Dist. LEXIS 154933, at *26
18 (E.D. Cal. Sep. 10, 2018) (finding the term “partially surround” indefinite where the
19 patent’s specification failed to provide objective boundaries for the term).
20
21
22
23
24

25 As Professor Hughes explains, in the world of data or identity verification, one
26 cannot “partially associate” an electronic signature with the signatory. Hughes Decl.,
27 ¶¶27-32. Association happens mathematically, and you cannot partially associate a
28

1 signatory with a document mathematically. *Id.* You can't do only part of the math and
2 have an actual verification. *See id.*

3
4 DVS devotes a single paragraph to this issue in its opening brief. DSV OCCB,
5 15:26-16:7. DVS' argument is as follows, "To the contrary, the '860 Patent makes
6 abundantly clear, and a POSITA would agree, that the primary component is structured
7 in a manner, such as being in the form of an image or graphical representation of a
8 signature, which is both part of the digital identification module and indicates that the
9 signatory entity provided such image or graphic." *Id.* (citing Rothschild Decl., ¶28).
10 This language is impenetrable. And ¶28 in Mr. Rothschild's declaration is simply the
11 same language cut-and-pasted (as is much of Mr. Rothschild's declaration. It appears
12 that DVS' counsel simply pasted some of the brief into a declaration and asked
13 Rothschild to sign it⁸).
14
15
16
17

18 Encyro had no opportunity to depose Mr. Rothschild regarding this term.

19 The "partially associate" term is indefinite as the intrinsic record provides no
20 "objective boundaries" for the term.
21

22 **D. The Asserted Claims Are Invalid as the Patentee Was Not "In**
23 **Possession" of Limitation [e] When the '860 Patent Was Filed**

24 Lack of written description is an issue that generally arises when a patentee
25

26
27 ⁸ *E.g.*, Compare Rothschild Decl., 10:26-11:12 with DVS OCCB, 11:20-12:4;
28 Rothschild Decl., 11:13-18 with DVS OCCB, 12:7-12.

1 amends or attempts to amend his claims during prosecution. If the new claim language
2 (a new invention) is not disclosed in the specification as originally filed, the inventor
3 was not “in possession” of the newly added invention when he filed his patent. *Ariad*
4 *Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*). The
5 basic idea is that you can’t grab new stuff during prosecution because the date of filing
6 determines the date of invention for priority disputes. *See Ariad*, at 1357 (“a written
7 description analysis occurs as of the filing date sought”).
8
9

10
11 To overcome an Examiner’s rejection, the patentee added limitation [e] during
12 prosecution. Encyro OCCB, 6:10; ’860 PxBx, Dkt. No. 31-1, at DVSENC_00000039,
13 97-98, 167. If the ideas in limitation [e] were not in the patent when filed, the claims
14 are invalid for failing to meet the “written description” requirement of 35 U.S.C.
15 ¶112(1).
16

17
18 Materially, neither party believes limitation [e] needs to be construed. DVS
19 OCCB, at 16:21-22, 17:14-15; Encyro OCCB, 2417-19. Thus, the Court need merely
20 look at limitation [e] and compare said limitation to the specification and ask, is the
21 invention in limitation [e] also in the specification? If not, the term is invalid because
22 applicant Rothschild tried to claim an idea not in his patent as-filed. *D Three Enters.,*
23 *LLC v. SunModo Corp.*, 890 F.3d 1042, 1047 (Fed. Cir. 2018).
24
25

26 The limitation at-issue reads, “said at least one digital identification module is
27 cooperatively structured to be embedded within only a single electronic file”. ’860,
28

1 9:20-22. But the language applicant Rothschild added is not in the specification; *i.e.*,
2 there is nothing in the specification as filed that discloses the new invention, limitation
3 [e]. DVS has not, cannot, point to any teachings in the specification that covers
4 technology that limits the embedding of a digital identification module to a single
5 electronic file, and the term “cooperatively structured” doesn’t even appear in the
6 specification outside the (new) claims.
7
8

9 Tacitly admitting that the patent contains no disclosure in support of the new
10 invention added to overcome prior art, DVS provides a 3-sentence analysis of the
11 written description issue. DVS OCCB, 22:2-4. Indeed, *citing Nautilus*, DVS again
12 appears to confuse the written description requirement with the definiteness
13 requirement. *Id.*, at 22:8-11; *see also Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d
14 916, 920 (Fed. Cir. 2004) (written description and definiteness are different
15 requirements under Section 112).
16
17
18

19 Instead of demonstrating written description of the actual claim language, DVS
20 attempts to water down the claim, proposing the following construction for limitation
21 [e]: “having a clearly defined structure or organization to permit incorporation or
22 placement within only a single electronic file at a time”. JCCS, Dkt. No. 28, 7:4-7.
23 Almost every single word in limitation [e] is both changed and diluted. For example,
24 changing “embedded within only a single electronic file” to “within only a single
25 electronic file *at a time*”. And “digital identification module is cooperatively
26
27
28

1 structured” to “a clearly defined structure or organization”. JCCS, Dkt. No. 28, 7:4-7.

2 Materially, DVS’ leading evidence in support of its construction is undated
3 dictionary definitions. But, any evidence in support of claim construction must be from
4 the date of invention, *i.e.*, 2008. *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334
5 F.3d 1294, 1299 (Fed. Cir. 2003). DVS’ undated dictionary definitions plucked from
6 current online sources are inadmissible. *Id.*, at 1299.

9 DVS’ alleged intrinsic evidence in support of its own construction is contained
10 in two paragraphs in its opening brief. DVS OCCB, 19:3-18, 21:25-22:11. As to the
11 first paragraph, DVS’ cited language is salmagundi, containing a smattering of
12 unrelated concepts and not even remotely touching upon limitation [e]. *See id.*, 19:3-
13 14 18. DVS’ second paragraph is, again, out of touch with the actual record. DVS alleges
15 that the Examiner determined the written description requirement to have been met for
16 Claims 16 and 18, and since—DVS alleges—Claims 16 and 18 are the same as
17 limitation [e], the issue is *res judicata*. *Id.*, at 21:25-22:11. But the pages cited by DVS
18 in the prosecution history pertain to indefiniteness, not written description. DVS OCCB,
19 at 21:26 (*citing* PxHx, Dkt. No. 31-3, at 351-58); *see* PxHx, Dkt. No. 31-3, at 352. The
20 Examiner did not consider the written description issue.

24 Limitation [e] does not need to be construed. Nothing in the specification
25 discloses a technology that “cooperatively structures” a “digital identification module”
26 and a “single electronic file”. Nothing in the specification discloses a technology that
27
28

1 limits the embedding of a digital identification module to a single electronic file.

2 If the Court believes it would be helpful to construe limitation [e], Encyro
3 believes Rothschild's statements to the USPTO must control said construction. *See*
4 Encyro OCCB, at 25:12-26:23.
5

6 Rothschild devotes 5 pages (11 paragraphs) of his declaration to limitation [e].
7 Dkt. No. 31-4, ¶¶26-37. Encyro was prevented from asking Mr. Rothschild any
8 questions regarding these opinions. Encyro was prejudiced by DVS/Mr. Rothschild's
9 conduct.
10
11

12 III. CONCLUSION

13 For the reasons stated above and in Encyro's opening brief, Encyro respectfully
14 asks that the terms at-issue be construed in accordance with the cited law and intrinsic
15 record, *i.e.*, according to Encyro's proposed constructions.
16

17 Encyro also asks that DVS be ordered to pay Encyro's fees and costs associated
18 with Mr. Rothschild's deposition.
19

20 Finally, Encyro asks that Mr. Rothschild's declaration be excluded as submitted
21 in violation of this Court's Standing Order and the adopted Patent Local Rules. To be
22 clear, Encyro is not concerned with "substance" of Mr. Rothschild's declaration. Aside
23 from failing to qualify as POSITA, Mr. Rothschild's declaration is devoid of actual
24 expert analysis and is merely copied from DVS' opening brief. His deposition
25 responses and conduct suggest that Mr. Rothschild has not even read his declaration.
26
27
28

1 Further, the Rothschild declaration frequently conflicts with the intrinsic record. On
2 that basis alone, it cannot be considered. *See BASF Agro*, 519 F. App'x, at 1018. Plainly
3 stated, Mr. Rothschild's declaration is characteristic of the hundreds of meritless
4 lawsuits he has filed. And until Mr. Rothschild is appropriately sanctioned and then
5 held accountable to said sanctions, his conduct will continue.
6
7
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9

10 *Rachael D. Lamkin*

11

Rachael D. Lamkin

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CERTIFICATE OF SERVICE

I hereby certify that on this 22nd day of December, 2022, a true and accurate copy of the above and foregoing:

**DEFENDANT’S RESPONSIVE CLAIM CONSTRUCTION BRIEF
LAMKIN DECL ISO
SUPPORTING EXHIBITS**

Was served upon counsel via the Court’s ECF system.

Rachael D. Lamkin

Rachael D. Lamkin