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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

FIRSTFACE CO., LTD.,
Plaintiff,
v.
APPLE, INC.,
Defendant.

Case No. [3:18-cv-02245-JD](#)

CLAIM CONSTRUCTION ORDER

Re: Dkt. No. 61

The parties in this patent infringement action seek construction of eight phrases from the asserted claims in U.S. Patent No. 9,633,373 (the '373 patent) and U.S. Patent No. 9,779,419 (the '419 patent).¹ The Court received full briefing from the parties and held a technology tutorial. During the technology tutorial, defendant Apple made a comment to the effect that plaintiff Firstface had asserted inconsistent construction positions before the Patent Trial and Appeal Board. The Court invited each side to file a ten-page supplemental brief on the issue. Dkt. No. 118. Apple chose to file almost 900 pages of materials that ranged far beyond PTAB proceedings. Dkt. No. 123. The Court ordered this improper and massively oversized filing to be stricken from the docket, and allowed the parties to file the ten-page submissions as originally contemplated. See Dkt. Nos. 192 (strike order), 130 (Apple), 131 (Firstface).

¹ The parties' briefing on claim construction also included terms from U.S. Patent No. 8,831,557 (the '557 patent). See, e.g., Dkt. No. 61. All asserted claims of the '557 patent, and some of the asserted claims of the '373 and '419 patents were found unpatentable in *inter partes* review (IPR) proceedings before the Patent Trial and Appeal Board (PTAB). Dkt. No. 106. The final written decisions of PTAB were all affirmed by the Federal Circuit. *Id.* Only claims 11-14 and 18 of the

United States District Court
Northern District of California

BACKGROUND

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2 Firstface asserts claims 11-14 and 18 of the '373 patent and claims 10-13 and 15-17 of the
3 '419 patent against Apple. Dkt. No. 1 at ¶¶24, 37; Dkt. No. 106 at 2. The '373 patent and '419
4 patent are both continuations of the same application and share a common specification. *See* Dkt.
5 No. 61-3; Dkt. No. 61-4. The patents describe a mobile communication terminal and method for
6 operating the mobile communication terminal that allows for simultaneous activation of the
7 display screen and user authentication. Dkt. No. 61-3 at 1:17-23. The prior art required a
8 separation of these functions, requiring that the device be activated first and then requiring a
9 second input to authenticate the user. *Id.* at 25-49. The activation button may also be used to
10 perform multiple functions if the button is pressed multiple times or for a longer period of time.
11 *Id.* at 4:51-5:2. The '373 patent and '419 patent primarily differ in the specificity of their claims;
12 the '373 patent's claims are more general with regard to their claiming of the functions of the
13 activation button while the '419 patent claims the use of fingerprint recognition and authentication
14 specifically as a function of the activation button. *Compare* Dkt. No. 61-3 at 14:14-57 with Dkt.
15 No. 61-4 at 14:15-65.

DISCUSSION

I. LEGAL STANDARD

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18 Claim construction analysis “must begin and remain centered on the claim language itself,
19 for that is the language the patentee has chosen to particularly point[] out and distinctly claim[] the
20 subject matter which the patentee regards as his invention.” *Source Vagabond Sys. Ltd. v.*
21 *Hydrapak, Inc.*, 753 F.3d 1291, 1299 (Fed. Cir. 2014) (quoting *Innova/Pure Water, Inc. v. Safari*
22 *Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004)). Claim terms are given their
23 “ordinary and customary meaning,” which is “the meaning that the term would have to a person of
24 ordinary skill in the art in question at the time of the invention.” *Phillips v. AWH Corp.*, 415 F.3d
25 1303, 1312-13 (Fed. Cir. 2005) (en banc) (internal quotation omitted). “The subjective intent of
26 the inventor when he used a particular term is of little or no probative weight in determining the
27 scope of a claim (except as documented in the prosecution history).” *Markman v. Westview*

1 “Rather the focus is on the objective test of what one of ordinary skill in the art at the time of the
2 invention would have understood the term to mean.” *Markman*, 52 F.3d at 986. The parties do
3 not dispute the definition of a person of ordinary skill in the art.

4 As the Federal Circuit has underscored, the “only meaning that matters in claim
5 construction is the meaning in the context of the patent.” *Trustees of Columbia Univ. v. Symantec*
6 *Corp.*, 811 F.3d 1359, 1363 (Fed. Cir. 2016). The presumption that plain and ordinary meaning
7 can be overcome only by a patentee’s express definition of a term or express disavowal of the
8 scope of the claim has been clarified. *Id.* at 1364. A term may be redefined “by implication”
9 when given a meaning that is ascertainable from a reading of the specification or the patent
10 documents. *Id.* Redefinition and disavowal need not be expressly stated or called out *in haec*
11 *verba*. *Id.* at 1363. “The ordinary meaning of a claim term is not the meaning of the term in the
12 abstract,” but the term’s “meaning to the ordinary artisan after reading the entire patent.” *Astra*
13 *Zeneca AB v. Mylan Pharm. Inc.*, 19 F.4th 1325, 1330 (Fed. Cir. 2021) (quotations omitted)
14 (quoting *Eon Corp. IP Holdings v. Silver Spring Networks*, 815 F.3d 1314, 1320 (Fed. Cir. 2016)).

15 With this teaching, the rule that a claim and its constituent words and phrases are
16 interpreted in light of the intrinsic evidence flourishes anew. The touchstones are the claims
17 themselves, the specification and, if in evidence, the prosecution history. *Phillips*, 415 F.3d at
18 1312-17. This intrinsic evidence is the most significant source of the legally operative meaning of
19 disputed claim language. *Continental Circuits LLC v. Intel Corp.*, 915 F.3d 788, 799 (Fed. Cir.
20 2019). The claim language can “provide substantial guidance as to the meaning of particular
21 claim terms,” both through the context in which the claim terms are used and by considering other
22 claims in the same patent. *Phillips*, 415 F.3d at 1314. The specification is also a crucial source of
23 information: although it is improper to read limitations from the specification into the claims, the
24 specification is “the single best guide to the meaning of a disputed term.” *Id.* at 1315 (“[T]he
25 specification ‘is always highly relevant to the claim construction analysis. Usually, it is
26 dispositive . . .’”) (internal quotations omitted); *see also Merck & Co., Inc. v. Teva Pharms. USA,*
27 *Inc.*, 347 F.3d 1367, 1370 (Fed. Cir. 2003) (“[C]laims must be construed so as to be consistent

1 treatises) to resolve the scope and meaning of a claim when circumstances warrant that. *Phillips*,
2 415 F.3d at 1317.

3 II. CLAIM CONSTRUCTION

4 A. “inactive state”/ “while the touch screen display is turned off” (’373 patent 5 claims 11-12; ’419 patent claims 10, 12, 16-17)

6 Firstface’s Proposed Construction	Apple’s Proposed Construction	Court’s Construction
7 “a state in which the display is turned off yet the device itself 8 is turned on”	“state in which the display is not receiving power”	“a state in which the device is communicable but a display screen is turned off”

9 The term “inactive state” is expressly defined in the shared specification of the ’373 and
10 ’419 patents. “The term ‘inactive state’ used herein refers to a state in which the mobile
11 communication terminal is communicable but a display screen is turned off.” Dkt. No. 61-3² at
12 3:21-23. It is a core principle of claim construction that the patentee may act as his own
13 lexicographer if the specification defines a term “with reasonably clarity, deliberateness, and
14 precision.” *Abbott Labs. v. Syntron Bioresearch, Inc.*, 334 F.3d 1343, 1354 (Fed. Cir. 2003); *see*
15 *also Level Sleep LLC v. Sleep Number Corp.*, 2021 WL 2934816, at *4 (Fed. Cir. Jul. 13, 2021)
16 (unpublished) (“[W]here a patent applicant has elected to be a lexicographer by providing an
17 explicit definition in the specification for a claim term, the definition selected by the applicant
18 controls.”) (internal quotes omitted) (cleaned up). Despite this definition of the term in the
19 specification, both parties offer a different proposed construction.

20 Firstface acknowledges the definition of “inactive state” in the specification, but relies on
21 additional teachings from the specification to say that the inactive state requires that a state where
22 the device is completely turned off is excluded. Dkt. No. 61 at 12. Apple says that Firstface is
23 attempting to read-in a requirement that the device must be turned on while the display is in an
24 inactive state. Dkt. No. 69 at 10. The specification explains that “a state in which the mobile
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27 ² The ’373 patent and ’419 patent share a specification. Consequently, the Court cites to just the
28 specification of the ’373 patent for claim terms and disclosures found in both the ’373 and ’419

1 communication terminal is completely turned off is excluded.” Dkt. No. 61-3 at 3:29-31. This
2 teaching in the specification completely contradicts Apple’s position.

3 Even so, the Court declines to adopt Firstface’s construction, which also is different from
4 the definition provided by the specification. In *Abbott*, the Federal Circuit found that the
5 specification’s definition was not sufficiently clear because portions of the passage defining a
6 claim term provided two alternative definitions. *Abbott*, 334 F.3d at 1355. That is not the case
7 with “inactive state.” There is nothing inconsistent between the definition that explains that “the
8 mobile communication is communicable but a display screen is turned off,” and the further
9 clarification that excludes a state where “the mobile communication terminal is completely turned
10 off.” Dkt. No. 61-3 at 3:21-23, 3:29-31.

11 Apple suggests that its construction is proper based on a proposed construction of “an OFF
12 state of the display unit,” which it says should have the same construction as “inactive state.”
13 First, “OFF state” is not a claim term in the ’373 and ’419 patents, but a term that appeared in the
14 ’557 patent, which is no longer in this case. Apple points to statements in the prosecution history
15 of the ’557 patent, where Firstface distinguished a piece of prior art that described “switching from
16 the OFF state of the power of the device to the ON state of the power of the device.” Dkt. No. 69-
17 10 at 8. Firstface stated to the examiner that activation related to the OFF and ON states of the
18 display screen, not the power of the device. *Id.* This does not change the Court’s view that the
19 definition contained in the specification is the correct definition for “inactive state.” The
20 specification makes clear that while the inactive state is a reference to the state of the display
21 screen, the mobile communication terminal is still communicable, and that the mobile
22 communication terminal is turned on. Dkt. No. 61-3 at 3:23-31.

23 Consequently, the Court construes the term “inactive state” as it is defined in the
24 specification, to mean “a state in which the device is communicable but a display screen is turned
25 off.”

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