

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
TEXARKANA DIVISION**

HITACHI MAXELL, LTD.,

*Plaintiff,*

v.

HUAWEI DEVICE USA INC. and HUAWEI  
DEVICE CO., LTD.,

*Defendants.*

Case No. 5:16-cv-00178-RWS

LEAD CASE

**JURY TRIAL DEMANDED**

HITACHI MAXELL, LTD.,

*Plaintiff,*

v.

ZTE CORPORATION and ZTE USA INC.,

*Defendants.*

Case No. 5:16-cv-00179-RWS

**JURY TRIAL DEMANDED**

**P.R. 4-3 JOINT CLAIM CONSTRUCTION AND PREHEARING STATEMENT**

Pursuant to P.R. 4-3 and the parties' agreed modification to proposed Docket Control Order (*see, e.g.*, Dkt. 41-1), Plaintiff Hitachi Maxell, Ltd. ("Plaintiff" or "Maxell") and Defendants Huawei Device USA Inc., Huawei Device Co., Ltd. (collectively "Huawei") and ZTE USA Inc. ("ZTE USA") (collectively, "Defendants") hereby serve this joint claim construction and prehearing statement.

The proposed claim terms listed below occur in U.S. Patent No. 5,396,443 ("the '443 Patent"), which is asserted against both Huawei and ZTE USA, and U.S. Patent Nos. 7,509,139

Case 5:16-cv-00178-RWS Document 74 Filed 09/01/17 Page 1 of 61 PageID #: 1524

(“the ’517 Patent”); 7,671,901 (“the ’901 Patent”); 6,856,760 (“the ’760 Patent”); and 7,116,438 (“the ’438 Patent”), which are asserted against Huawei; and U.S. Patent Nos. 6,748,317 (“the ’317 Patent”); 8,339,493 (“the ’493 Patent”); 8,736,729 (“the ’729 Patent”); 6,408,193 (“the ’193 Patent”); 6,329,794 (“the ’794 Patent”); 6,816,491 (“the ’491 Patent”); and 8,098,695 (“the ’695 Patent”), which are asserted against ZTE USA.

**I. STATEMENT BY NONMOVING PARTY REGARDING CLAIMS SUBJECT TO AN INDEFINITENESS CHALLENGE**

Pursuant to the DCO (Dkt. No. 70), Maxell provides the following statement with respect to the indefiniteness challenges:

- With respect to the claim term “a storage unit in which group information generated by classifying the plurality of base stations into groups” in claim 11 of the ’139 Patent, Maxell may present testimony and opinion from one or more experts, including without limitation Dr. Michael Caloyannides, Dr. Branimir Vojcic, and/or Dr. Sayfe Kiaei addressing arguments presented by Huawei that the term is indefinite. Maxell’s expert(s) will testify that, in view of the disclosures in the specification, one of ordinary skill in the art would have been able to ascertain the scope this claim term with reasonable certainty.
- With respect to the claim term “waits a longer time” in claim 1 of the ’517 Patent, (claim 11) Maxell may present testimony and opinion from one or more experts, including without limitation Dr. Michael Caloyannides, Dr. Branimir Vojcic, and/or Dr. Sayfe Kiaei addressing arguments presented by Huawei that the term is indefinite. Maxell’s expert(s) will testify that one of ordinary skill in the art would have been able to ascertain the scope of this claim term with reasonable certainty.
- With respect to the claim term “a controller which executes control so that the correction portion corrects the video signals in accordance with distribution of luminance or hue or saturation of the video signals and with the illumination detected by the illumination sensor when any change occurs in the video signal inputted to the input portion, wherein the controller corrects luminance of the video signal without correcting hue and saturation of the video signal when the change of the video signal does not occur and when the illumination detected by the illumination sensor is above a predetermined value” in claim 1 of the ’901 Patent, Maxell may present testimony and opinion from one or more experts, including without limitation Dr. Shukri Soury and/or Dr. Vijay Madiseti addressing arguments presented by Huawei that the term is indefinite. Maxell’s expert(s) will testify that, in view of the disclosures in the specification, one of ordinary skill in the art would have been able to ascertain the scope this claim term with reasonable certainty. Further, if this term is found to be a means-plus-function term—which Maxell does not

concede, Maxell's expert(s) will testify that the specification provides adequate structure for this term.

## **II. HIGH PRIORITY TERMS WHOSE CONSTRUCTION WILL BE MOST SIGNIFICANT TO THE RESOLUTION OF THE CASE**

**Maxell's Position:** Maxell believes the following terms will be the most significant to resolution of certain claims in the case to the extent they relate to Huawei's Motion to Dismiss (Dkt. No. 26): "calculating characterizing quantities" in claims 1 and 11 of the '139 Patent and the terms "GPS receiver means," "GPS reliability calculation means," "cellular reliability calculation means," "cellular receiver means," and "GPS/cellular positioning results combining means" in claim 1 of the '292 Patent include the most significant disputes and therefore are the most significant to the resolution of the case.

Maxell also believes the following terms will be significant to resolution of certain claims in the case: "a relation of said direction and a direction from said present place to said destination" and "walking navigation" in claims 1, 10, 15, 16, 17, and 20 of the '317 Patent, "an image-instability detector" in claim 1 of the '729 Patent, and "controller means" in claim 1 of the '491 Patent.

In addition, the Parties have agreed that the following terms should be interpreted as means-plus-function terms according to pre-AIA 35 U.S.C. § 112, ¶ 6, however, no party has identified these as high priority (that is, among the 32 disputed terms) but have not been able to agree upon the corresponding structures:

- "a control means for effecting control wherein, if said user-associated medium at least approaches said detecting means, a controlled object is set in a non-power saving state, and wherein, if said user associated medium is distant from said detecting means for at least a predetermined constant period of time, at least a part

- of said controlled object is set in a power saving state” (’443 Patent, Claim 1);
- “reproducing means for reproducing, from a recording medium, at least moving pictures encoded by a first encoding method and first pictures having a smaller number of pixels than the moving pictures” (’440 Patent, Claims 5, 7);
  - “first outputting means for outputting a plurality of reproduced ones of the first pictures” (’440 Patent, Claim 5);
  - “second outputting means for outputting a moving picture corresponding to any selected first picture” (’440 Patent, Claim 5);
  - “reproducing means for reproducing at least a first still picture, a second still picture and a picture from a recording medium, wherein said first still picture is encoded by a first encoding method, said second still picture is encoded by a second encoding method different from the first encoding method, and said picture corresponds to said first and second still pictures and has a smaller number of pixels than said first and second still pictures, and wherein said first still picture, said second still picture and said picture are related pictures derived from common signal data” (’760 Patent, Claims 10 and 13);
  - “first outputting means for outputting a plurality of reproduced pictures from the reproducing operation” (’760 Patent, Claim 10); and
  - “second outputting means for outputting said first still picture corresponding to a selected picture” (’760 Patent, Claim 1).

**Huawei’s Position:** Huawei believes that the following limitations are claim dispositive.

1. **'292 Patent:** “combining” / “combined” and “GPS/cellular positioning results combining means for combining the GPS-based position result and the cellular-based position result with the GPS positioning reliability and the cellular positioning reliability” (claims 1 and 2)
2. **'139 Patent:** “characterizing quantities of the communication quality” (claims 1 and 11)
3. **'139 Patent:** “a storage unit in which group information generated by classifying the plurality of base stations into groups” (claim 11)
4. **'443 Patent:** “detecting means. . .” (claim 1)
5. **'517 Patent:** “waits a longer time” (claim 1)
6. **'517 Patent:** “selection switching determination unit for selecting” (claim 1)
7. **'438 Patent:** “an input entered by a user” (claim 1)
8. **'440 Patent:** “still pictures encoded by a second encoding method, and second pictures corresponding to the still pictures and having a smaller number of pixels than the still pictures are recorded” (claims 1, 3, 5, 7)
9. **'760 Patent:** “first encoding method” (claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15)
10. **'901 Patent:** “when any change occurs in the video signal inputted to the input portion” and “when the change of the video signal does not occur and when the illumination detected by the illumination sensor is above a predetermined value” (claim 1)

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.