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UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

OAKLAND DIVISION

EMBLAZE LTD.,

Plaintiff,

v.

APPLE INC., a California Corporation,

Defendant.

CASE NO. 4:11-CV-01079 SBA

EMBLAZE LTD.'S REPLY CLAIM CONSTRUCTION BRIEF

Date: October 31, 2012
Time: 9:00 a.m.
Courtroom: 1

Before The Honorable Saundra Brown Armstrong

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Pursuant to Patent L. R. 4-5 and Order Concerning September 15, 2011 Case Management Conference (DE 68), Plaintiff Emblaze Ltd. ("Emblaze") submits this reply brief in support of its proposed construction of the disputed claim terms of U.S. Patent No. 6,389,473 ("'473 Patent").

I. OVERVIEW OF THE '473 PATENT

Apple's overviews of the '473 Patent (Apple Br.[1], pp. 2-4) and the disputed claim terms (Apple Br., 4-5) seek to confine Emblaze's invention to preferred embodiments, an approach that has been repeatedly and consistently rejected by the Court of Appeals for the Federal Circuit. The description in the '473 Patent (Ex. 1)[2] – not Apple's narrowing characterizations – is the best source for understanding the patented invention.

Before the '473 Patent, "high-cost, dedicated computer systems" were "required in order to ensure that the data stream [was] distributed and received by clients 30 in real time" (1:34-40[3]). The inventors of the '473 Patent recognized that "real-time broadcasting [was] normally possible only for hosts having a suitable, dedicated encoder and broadcast server and [could not] be offered by Internet service providers (ISPs) to their general clientele." (1:43-47). The inventors of the '473 Patent thus developed the ability to "remotely broadcast a multimedia program through an Internet service provider (ISP) using common, universally-supported Internet communication protocols" (1:64-67), such as HTTP (2:12-14). By dividing and encoding a data stream into a sequence of files, the '473 Patent places the data in an advantageous format for transmission over limited bandwidth connections, regardless of whether the data is compressed, and also accommodates the use of common, universally supported Internet communication protocols.

The solution of the '473 Patent is applicable not only to broadcasting multimedia data in real-time over the limited bandwidth networks of the late 1990s, but also overcomes today's challenges of broadcasting multimedia data in real-time over the limited bandwidth of present day cellular and wifi networks and the challenges associated with broadcasting large format multimedia data, e.g., high definition (HD) streams. The invention of the '473 Patent -- providing "high-bandwidth data streaming

[1] Defendant Apple Inc.'s Response and Evidence in Support of its Proposed Claim Constructions (DE 118) is referred to herein as the "Apple Br.".
[2] All exhibits referenced herein were attached to the Declaration of Lisa Ferrari (DE 112) submitted in support of Emblaze's Opening Claim Construction Brief (DE 111) ("Emblaze Opening Br.").
[3] All references to the '473 Patent are in the form "column:line", and unless otherwise stated, all references in this form are to the '473 Patent.

over a network using common, existing server and network infrastructure" (1:51:53) that may be used to broadcast a multimedia program, "for example, an interview program or an entertainment or sports event" (6:58-59) – is as relevant today as it was when the original application for patent was filed in the 1990s.

II. THE PRIORITY DATE OF THE '473 PATENT IS IRRELEVANT TO CLAIM CONSTRUCTION

In its overview of the parties' claims construction positions (Apple Br., p. 5), and throughout its brief, Apple asserts that for purposes of claim construction, Emblaze cannot rely upon "new matter" added to the U.S. application for the '473 Patent that is not found in the Israeli priority document. That is wrong; the priority date of the '473 Patent is irrelevant to the claim construction analysis. *See PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1302, 1310-11 (Fed. Cir. 2008) (affirming construction of the claim term "customer interface" based on new matter added to a later-filed application).

III. APPLE'S "RESERVATION" OF 35 U.S.C. § 112 INVALIDITY ARGUMENTS

Apple misstates Emblaze's position when it "agrees with Emblaze that invalidity arguments under 35 U.S.C. § 112 should not be addressed during the *Markman* proceeding" (Apple Br., p. 5). Emblaze argued only that "[a]lleged invalidity of patent claims for failure to satisfy the *written description* and *enablement* requirements of 35 U.S.C. § 112, ¶1" are not relevant to claim construction. (Emblaze Br., p.7 (emphasis added)). Emblaze never asserted that invalidity for *indefiniteness* in violation of 35 U.S.C. § 112 ¶2 need not be considered during claim construction; to the contrary, Emblaze correctly asserted that it should be. (Emblaze Br., pp. 6-7,13-14, 17-18 and 21-22). *See Personalized Media Communs., L.L.C. v. ITC*, 161 F.3d 696, 705 (Fed. Cir. 1998) ("A determination of claim indefiniteness is a legal conclusion that is drawn from the court's performance of its duty as the construer of patent claims."); *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1378 (Fed. Cir. 1999) (same); *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347-48 (Fed. Cir. 2005) (same). Apple's brief does not explain why any of the disputed terms is indefinite, and as a consequence Apple has waived any argument of invalidity based on an alleged failure to satisfy the definiteness requirement of 35 U.S.C. § 112 ¶2. *See Smithkline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1319-1320 (Fed. Cir. 2006) (holding that arguments not raised in briefs are waived, and explaining that mere allusion to arguments is insufficient and that arguments raised in footnotes are not preserved).

A claim cannot be held indefinite if it is amenable to claim construction. *See Energizer Holdings, Inc. v. ITC*, 435 F.3d 1366, 1371 (Fed. Cir. 2006) ("A claim that is amenable to construction is not invalid on the ground of indefiniteness."). Because all of the claim terms in dispute are amenable to construction – as Apple itself recognizes by the constructions it proffers – there would have been no basis for Apple to assert indefiniteness even if Apple had not waived that argument.

IV. THE DISPUTED CLAIM TERMS

Apple's proffered constructions of the disputed claim terms are addressed below in the order in which the terms appear in the Joint Claim Construction and Prehearing Statement ("JCCPS", DE 97).

1. Term #1: "real-time broadcasting" [Claims 1, 25]

Apple argues that real-time broadcasting requires receipt of a broadcast "**simultaneously with minimal delay**," while Emblaze contends that it means that the broadcast is received "**without substantial delay**", with no requirement of "simultaneous" receipt. As explained in Emblaze's opening brief, the passage at 1:16-18 that Apple cites as support for importing its "simultaneously" limitation into the claims refers to simultaneous transmission from a transmitting computer, not simultaneous reception by the client computers. *See also*, Emblaze's Opening Br., p. 8. Regardless, Apple does not argue that the specification uses "words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope", nor does Apple argue that the disputed term is expressly defined in the patent to require simultaneous receipt, and in the absence of those circumstances it is improper to import Apple's "simultaneously" limitation into claims 1 and 25. *See Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002).[4]

Apple's "with minimal delay" limitation is also wrong because it would improperly restrict the claims to a preferred embodiment. *See Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1342 (Fed. Cir. 2010), *rehearing denied by, rehearing en banc denied by*, 605 F.3d 1347 (Fed. Cir. 2010), *cert.*

[4] Apple relies upon *Aventis Pharmaceuticals Inc. v. Impax Labs, Inc.*, Civ. A. 02-1322 GEB, 2011 WL 94188, at *6-*7 (D.N.J. Jan. 11, 2011), but in that case the Court held that "the patent cannot be limited to the problems and particular solutions disclosed in the Background of the Invention," and because there was no dispute that the claim term at issue, "suitable antiadherents", included antiadherents that resulted in improvements over the prior art, the Court accepted that as an interim definition, which may be "further developed as the case progresses and evidence is presented that further defines or identifies other 'suitable antiadherents'".

denied on other grounds, 131 S.Ct. 3020 (2011). In Apple's citations to the specification, the specification uses the modifier "preferably" to describe the "delay", *i.e.*, "*preferably* with only a minimal necessary transmission and decoding delay" (10:48-54) and "*preferably* with only a minimal lag" (8:1-7) (Apple Br., p. 8, emphasis added). "Preferably" clearly connotes a preferred embodiment, not a mandatory requirement of the invention. *See Enzo Biochem*, 599 F.3d at 142. ("[I]t is improper to read limitations from a preferred embodiment described in the specification — even if it is the only embodiment —into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited.") (internal quotation omitted). Neither can Apple use a dictionary definition to improperly import limitations into the claim (Apple's Br., p. 8). *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005) (*en banc*), *cert. denied*, 546 U.S. 1170 (2006) ("The main problem with elevating the dictionary to such prominence is that it focuses the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent."). Regardless, there is nothing in Apple's cited dictionary definition that references "minimal delay".

Apple contends that the specification does not use the words "without substantial delay". However, Apple does not dispute that the specification describes receipt of a real-time broadcast as occurring "substantially in real time" (7:5, 8:5), and "without substantial delay" correctly captures the meaning of that expression.[5]

Apple's proffered construction also includes the word "communicating", and Apple asserts that Emblaze's proposed construction reads out the active verb "broadcasting," and only requires "random reception". Emblaze is not certain what Apple means by "random reception", but in any event it is already clear from other portions of claims 1 and 25 that the broadcast data is intended for receipt by client computers (claim 1: "uploading the sequence to a server . . . such that one or more client computers can download the sequence over the network from the server . . . (14:28-31); claim 25: "which uploads the sequence to a server . . . such that one or more client computers can download the sequence over the

[5] Unlike the terms in the cases cited by Apple (Apple's Br., p. 8 at n.5), "substantially intermittent contact" in *3M Innovative Properties Co. v. Tredegar Corp.*, Civ. 09-3335 DWF/AJB, 2011 WL 6004023, at *24 (D. Minn. Nov. 30, 2011) and "substantially maximize the strength of the output signal" in *KLA-Tencor Corp. v. Xitronix Corp.*, A-08-CA-723-SS, 2011 WL 318123, at *3-*5 (W.D. Tex. Jan. 31, 2011), Emblaze's construction of "real time broadcasting" as being "without substantial delay" is supported by the specification of the '473 Patent.

network from the server . . . (16:4-7)). There is no need for a separate and undefined "communicating" addition to the meaning of "real-time broadcasting".

2. Terms #2 and 3: "providing at the transmitting computer a data stream having a given data rate" [Claim 1]

Apple's construction of "providing" as "inputting" is wrong because it ignores the portions of the patent specification that expressly recognize that the data stream may be generated by the transmitting computer rather than being "input" to the transmitting computer ("the data stream comprises multimedia data captured or generated by the transmitting computer" (2:29-31, emphasis added); "although data inputs of other types may be generated at or by computer 34 . . ." (6:33-34, emphasis added). The term "providing" requires no construction; its ordinary meaning suffices. The term "providing" is not limited to "transmitting" or "receiving"; rather it simply connotes that whether by input to or generation at the transmitting computer, a data stream is "provided" at the transmitting computer. No further clarification is necessary.

Apple's construction is also wrong because it reads the term "given" out of the claim.[6] Apple argues that the specification does not teach that the data rate is assigned (Apple Br., p. 10), but the patent teaches "providing at the transmitting computer a data stream having a *given* data rate" (3:29-30, emphasis added), whether it is the data rate at which the stream is generated or a data rate assigned by compression of the stream.

Apple also contends that "data rate" must be construed to include the "actual units of measure" (*i.e.*, in bits per second), because without units of measurement, the construction is "general" and will "expand the meaning of 'data rate' beyond the bounds of what is actually contemplated by the '473 patent." Apple Br., p. 10. But Apple does not explain why this is so. Apple's insistence that data rate include the "actual units of measure" would lead to a too narrow claim construction that would, for example, exclude a data rate measured in other units, such as gigabytes per minute, when nothing in the claim requires a specific unit of measurement. Emblaze's construction, defining a data rate as "an amount

[6] The claim clause, "providing at the transmitting computer a data stream having a given data rate," (*see, e.g.*, claim 1), allows the "given data rate" to be compressed, but does not *require* compression.

of data per unit of time" generically, defines a data rate without confinement to any particular units of measurement.

3. Term #4: slice [Claims 1, 11, 23, 25, 37]

Apple contends that a slice is "a discrete, individually distinct segment," Apple Br., p. 11, whereas Emblaze contends it means "a segment of the data stream". Apple now explains that by "discrete, individually distinct" it means that the slices must be "separate and distinct from one another" (Apple Br., pp. 11-12), but that "clarification" is not helpful. Independent claims 1 and 25 expressly recite that the "stream is divided into a sequence of slices", and there is no reason to repeat that concept in the definition of "slice".

4. Term #5: each slice having a predetermined data size associated therewith [Claims 1, 25]

Emblaze does not contend that a "time duration" is the same as a "predetermined data size;" rather, Emblaze contends that the '473 Patent specifically teaches that the data size may be established by setting a time duration (*see* Emblaze's Opening Br., pp. 11-12). Apple seeks to exclude a predetermined time duration as a measure of data size, but the teaching of the '473 Patent is to the contrary, and dependent claims 23 and 37 also make clear that the predetermined data size of the slices may comprise a "predetermined duration."

Apple relies upon the disclosure in the '473 Patent at 11:56-59, but that disclosure supports Emblaze's construction, not Apple's. The beginning of that paragraph – which Apple does not cite – refers to a "set duration step" (11:53). The passage that Apple cites, "file 42 may be assigned a file size of 10 Kbytes, with T_1=5 sec" (11:58-59), does not relate to data size alone. Rather, the data size of the slices is being set by assigning a time duration to the slices. As the entirety of the paragraph makes clear, if each file is assigned a time duration of 5 seconds, and is uploaded at 2 Kbytes/sec, then the maximum data size per file is 10 Kbytes, though of course the amount of data in any individual file will depend on the content being streamed at the particular time that file is formed. Put another way, if the data rate is known – and both claims 1 and 25 specify that the data stream has a "given data rate" -- then setting the time duration also sets the data size.

Relying on the word "predetermined", Apple's construction would improperly require that the data size of the slices be assigned in advance of the data stream being divided, but Apple's supporting citation says nothing about when the data size of the slice is "predetermined". Apple's construction is also wrong because it excludes predetermining the data size as the slices are being prepared, as specifically contemplated by the '473 Patent. At 9:66 – 10:1, the '473 Patent explains that "[t]the data are compressed at step 80, and are then 'sliced' at step 82 into files . . . ", and reference to step 82 in Figure 7 shows that single step as including both setting the slice duration and preparing the slice, i.e., the data size is "predetermined" as the slice is being prepared. *See also,* 11:65 – 12:12. Nor is there any disavowal of claim scope in the specification or prosecution history of the '473 Patent that mandates a construction that requires assigning the data size of the slices before the data stream is divided.

5. Term #6: encoding the slices in a corresponding sequence of files [Claim 1] encodes the slices in a corresponding sequence of files [Claim 25]

Apple's construction improperly imports a "compression" limitation into claims 1 and 25, when there is nothing in these claim terms that requires compression.[7] Apple simply ignores the explicit statement in the specification that compression is not required. *See* 6:54-56 ("Preferably, the data in the sequence are compressed, although compression is not essential to implementation of the present invention." (emphasis added); *see also,* 2:1-28).[8] As explained in Emblaze's opening brief at 13-15, "encoding" as used in claims 1 and 25 means "forming each slice as a file, wherein a file includes data from a corresponding slice and a file descriptor".

Apple contends that "the step of 'encoding the slices' must occur after the 'dividing' step" because slices cannot be encoded until they are created. But that argument supports Emblaze's construction of "encoding", not Apple's, as compression – which Apple equates with encoding – takes place *before* the data stream is sliced. S*ee* 9:62 – 10:5 and Figure 7. Indeed, the specification of the '473 Patent at 11:23 –

[7] Apple relies upon evidence, 3:45-48, 11:26-28, and 11:23-24 (Apple's Br., p. 14) that was not cited for term #6 in the Joint Claim Construction and Prehearing Statement (DE 97, pp. 30-40), and those references should be ignored.

[8] Apple argues that real-time transmission of uncompressed multimedia data was impossible to achieve in the 1990s when the application for the '473 Patent was filed. Apple Br., p. 4. But Apple does not offer any expert testimony to support its contention of "impossibility", and without expert testimony that contention is worthless and should be ignored.

12:2 expressly teaches that *after* the data stream is compressed (11:39-44), the slices are "encoded" into files, clearly indicating that encoding in this context is *not* referring to compression (12:1-2 ("at the same time as file 44 (slice 2) is being *encoded* and prepared.")(emphasis added)). Likewise, claims 1 and 25 recite encoding the slices in a corresponding sequence of files, which, as Apple correctly points out, can only take place *after* the slices are formed, thus confirming that the reference to encoding in claims 1 and 25 is *not* a reference to compression.

All of Apple's citations to the specification describe "encoding the stream," not "encoding the slices", and as explained in Emblaze's opening brief, encoding has different meanings in these different contexts. See Emblaze's opening brief at pages 14-15.

6. Term #7: sequence of files, each file having a respective index [Claims 1, 25]

Apple cites two cases, *Wang Labs., Inc. v. Am. Online, Inc.,* 197 F.3d 1377 (Fed. Cir. 1999) and *General Am. Transp. Corp. v. Cryo-Trans., Inc.,* 93 F.3d 766, 770 (Fed. Cir. 1996), for the proposition that it is appropriate to limit claims to a specific embodiment where only one embodiment is disclosed (Apple Br., p. 17). But in a subsequent decision, *Liebel-Flarsheim Co. v. Medrad, Inc.,* 358 F.3d 898, 906 (Fed. Cir. 2004), the Federal Circuit "expressly reject[ed] the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment." Indeed, in *Liebel,* the Federal Circuit expressly distinguished both *Wang Labs* and *General Am. Transp.*:

> *Wang* therefore does not stand for the proposition that if a patent specification describes only a particular embodiment, the claims must be limited to that subject matter. We have never read *Wang Labs* to stand for so broad a proposition.
>
> . . .
>
> In [*General Am. Transp.* and other cases], this court interpreted the pertinent claim language narrowly, not merely because the specification did not describe a broader embodiment, but because the specification, claim, or prosecution history made clear that the invention was limited to a particular structure.

358 F.3d at 907-908.

Apple does not argue – nor could it – that there is an express disavowal in the specification or prosecution history that warrants its proposed narrow construction. There is nothing in the specification or prosecution history of the '473 Patent that supports limiting the "index" to an "alphanumeric indicator",

or to an index representing the slice's "location" in the sequence, or to an index "contained" in the file. The specification only requires that the "index" differentiate one file from another, but does not require the index to be an alphanumeric indicator or to be "contain[ed]" in the file. The index may be part of the file name and need not be "contained" within the file. *See* 7:59-64; 7:66-8:1.

7. Term #8: uploading the sequence to a server at an upload rate generally equal to the data rate of the stream [Claim 1]

which uploads the sequence to a server at an upload rate generally equal to the data rate [Claim 25]

Apple's proposed construction incorporates the same erroneous interpretation of the term "rate" as Apple proposes for claim terms #2 and #3 above. Apple's argument that Emblaze has not offered a claim construction of "data rate" is wrong, and the Court is referred to Emblaze's discussion of claim terms #2 and #3 above and in its opening brief for the reasons that "rate", whether an "upload rate," "download rate" or "data rate," should be construed as an amount of data per unit of time, and not as "speed, as measured in bits per second" as Apple proposes.

Apple states that "the claim language mandates equality between 'the upload rate' and 'the data rate,'" (Apple Br., p. 17), but in fact the claim language only requires that these rates be "generally equal" (*see, e.g.*, 14:29). Apple would construe "generally equal" as "closely matches," but Apple never explains how that construction would aid the trier of fact when "closely matches" is no more precise than "generally equal". The ordinary meaning of "generally equal" is clear and sufficient --- it means approximately, but not necessarily exactly, equal. *See Anchor Wall Systems, Inc. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1311 (Fed. Cir. 2003) ("'generally parallel' envisions some amount of deviation from exactly parallel").

8. Term #9: such that one or more client computers can download the sequence over the network from the server at a download rate generally equal to the data rate [Claims 1, 25]

Apple contends that Emblaze's construction fails to construe "at a download rate generally equal to the data rate". But as explained in Emblaze's opening brief, that claim phrase is readily understood and does not require construction. As regards Apple's contention that "generally equal" should be construed as "closely matches", see Emblaze's discussion of claim term #8 immediately above.

Relying on *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329 (Fed. Cir. 2005), Apple contends that Emblaze's construction changes the "actual 'download' of the multimedia by the client computers to an optional 'capability' that contradicts the claims' 'real-time broadcasting' limitation." Apple misconstrues *Hoffer*. There was no dispute in *Hoffer* concerning whether the "whereas" clause required only the capability as contrasted with the actual performance of interactive data messaging – all agreed that capability was sufficient. Here, all that the "such that" clause in claims 1 and 25 requires is that the client computers have the recited capability, not that the client computers actually perform that capability. The disputed claim language uses the term "can", indicating only that the "one or more client computers can download the sequence …", not that they must do so (emphasis added). Simply put, there is no requirement in the claim language that any particular client computer actually performs the step of downloading the sequence of files. *See In the Matter of Venezia*, 530 F.2d 956, 958 (CCPA 1976)[9] (holding claim to "connector kit having component parts *capable* of being assembled" does not require the interrelated parts to actually be assembled) (emphasis added); *CSB-System International Inc. v. SAP America, Inc*., Civ. No. 10-2156, 2012 U.S. Dist. LEXIS 45847, *32 (E.D. Pa. April 2, 2012) ("Notably, nothing [in the claims] requires that the functions actually be used.").

Apple's proposed construction would require at least two independent actors (one operating the transmitting computer, and one operating the client computer) for infringement, whereas Emblaze's construction requires only one actor operating the transmitting computer to establish infringement. The Federal Circuit has recognized that a "patentee can usually structure a claim to capture infringement by a single party." *See BMC Resources, Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1381 (Fed. Cir. 2007) ("In this case, for example, BMC could have drafted its claims to focus on one entity"; *see also, Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1309 (Fed. Cir. 2011) ("[a] patentee can usually structure a claim to capture infringement by a single party, by focusing on one entity.") (internal quotation omitted).

Apple also makes the conclusory assertion that "the receipt of multimedia data by the client computers is material to patentability and is a requirement of the fundamental invention" (Apple Br., p. 19). But it is the capability of the client computers to receive the broadcast, not the actual performance of

[9] In *South Corp. v. U.S.*, 690 F.2d 1368, 1370 (Fed. Cir. 1982), the Federal Circuit adopted as precedent decisions of its predecessor court, the Court of Customs and Patent Appeals.

that capability, which is required by the invention, as the claim language itself makes clear. "Real-time broadcasting" occurs regardless of whether any client computer actually receives the data stream. For example, a radio station may broadcast in real time all day long, regardless of whether anyone has tuned into the radio station to listen. Emblaze's proposed claim construction does not "read out" the "such that" clause, but rather correctly construes that clause consistent with its plain meaning.

Apple also argues (Apple's Br., p. 19, n. 12) that Emblaze's claim construction is illogical in view of the claim language. But to the contrary the claim language supports Emblaze's construction, not Apple's. Claim 1 calls for "uploading the sequence to a server", but when it comes to the download side, the claim does not say "downloading the sequence over the network from the server" – which would require actual performance of the act of downloading – but rather says "such that the one or more client computers can download the sequence over the network", thereby only requiring the *capability* of downloading but not the actual act of downloading. Furthermore, claims 2 and 26, which depend from claims 1 and 25, respectively, do add a limitation requiring actual downloading of the sequence, further evidencing that there is no such requirement in the independent claims ("2. A method according to claim 1, and comprising downloading the sequence . . ." (14:33-34); "26. Apparatus according to claim 25, wherein the one or more client computes decode the sequence and play back the data stream . . ." (16:10-11)).

9. Term #10: decode the sequence [Claims 8, 26]

Apple improperly construes "decode" in this claim term to mean "decompress", but as explained with respect to claim term #6, the meaning of "decode" depends on the context in which it is used, and like claim term #6, there is nothing in the claim language at issue here that limits "decode" to "decompress". Rather, as used in claims 8 and 26, decode only requires extracting playable data from the sequence, regardless of whether the data were compressed. And as noted above and in Emblaze's opening brief, the '473 Patent expressly states that compression is <u>not</u> required. *See, e.g.*, 6:54-56 ("Preferably, the data in the sequence are compressed, although compression is not essential to implementation of the present invention.").

Apple cites *Johnson Worldwide Assocs, Inc. v. Zebco Corp.,* 50 F. Supp.2d 863, 867-68 (W.D. Wisc. 1998), *Janssen Pharmaceutica N.V. v. Eon Labs Mfg., Inc.,* 2003 WL 25819555, at *8 (E.D. N.Y. Nov. 26, 2003) and *Haliburton Servs. v. Smith Int'l Inc.*, 2004 WL 305722, at *5 (E.D. Tex. Feb. 13, 2004) as supporting its construction (Apple's Br., pp. 19-20), but the courts in those cases did not rely solely on a parenthetical to construe a claim term, but rather in each case the court considered the entirety of the specifications and the language of the claims. *See, e.g., Johnson,* 50 F. Supp.2d at 867 (the parenthetical reference supported the Court's claim construction analysis that relied on other portions of the specification that limited the "trolling motor" to a "thrust motor"); *Haliburton,* 2004 WL 305722 at *6 ("The Court does not find that Column 8's distinction is clear enough to contradict the construction suggested by the abstract, claim language, and patent teachings."). Apple only cites the Magistrate Judge's claim construction order in *Janssen,* 2003 WL 25819555, at *10, failing to mention the reversal of that claim construction order by the District Court, and the modification of the District Court's construction by the Federal Circuit. Furthermore, none of the three opinions in *Janssen* defined the disputed claim term solely by a parenthetical expression.

Emblaze is aware of no Federal Circuit case holding as a principle of claim construction that a parenthetical expression following a claim term defines that term, and the Federal Circuit, construing parenthetical expressions outside of *Markman* proceedings, has recognized that a parenthetical may be illustrative and not definitional. *Novacor Chemicals, Inc. v. United States*, 171 F.3d 1376, 1381 (Fed. Cir. 1999) ("Therefore, in this case, Customs's argument that the parenthetical is merely an illustrative example makes sense. We, therefore, conclude that no definition is provided by the parenthetical for the term 'supplemental duties.'").

10. Term #11: play back the data stream responsive to the indices of the files [Claim 8]

play back the data stream responsive to the indices thereof [Claim 26]

Apple's construction is wrong because it suggests that the client must play back the entire data stream ("play back the data stream in the order of the indices"). But this ignores the express teaching in the specification that "a user can decide and indicate at which slice of data stream 40 to begin downloading. Responsive to a user input, client 30 selects an appropriate starting slice and begins to

download and decode (decompress) files 42, 44, 46, etc." 10:43-48 (emphasis added). The highlighted language makes clear that the client computer need not play back the entire data stream, but rather may play back only part of the data stream. Apple asserts that its construction is consistent with the Summary of the Invention at 2:15-21, but nothing in that passage requires that all of the files be played back, and as noted, the specification makes clear that they need not be.

Apple also contends, without support, that Emblaze's construction of "responsive to the indices" as "based on the indices" does not require a "responsive connection" between the file indices and the playback and is too vague and general. But "based on" has the same meaning as "responsive to" in the disputed claim language. Contrary to Apple's conclusory argument, Emblaze's construction – "based on" – does not render the term "responsive to the indices" superfluous, vague or too general.

Apple also argues that Emblaze's claim construction fails to capture the "real-time" requirement of the claims, but the "real-time" requirement of claims 8 and 26 is already captured by the term "real-time broadcasting" in independent claims 1 and 25 from which these claims respectively depend.

Apple's construction of these terms would also improperly import a term, "in the order of", into the disputed terms. But there is nothing in the claim that requires Apple's "in the order of" limitation, nor is there an express disavowal of claim scope in the specification or prosecution history of the '473 Patent that would justify importing such a limitation into the claims.

11. Term #12: at a replay rate generally equal to the data rate [Claim 8]

at a data replay rate generally equal to the data rate [Claim 26]

Apple's construction is wrong for the same reasons discussed above with respect to claim term #2, #3, #8 and #9.

12. Term #13: uploading and updating an index file containing the index of the file in the sequence that was most recently uploaded [Claim 9]

Apple does not provide any support for importing into the claims a "single . . . variable" limitation with respect to the index file. And for the same reasons explained for claim term #7, and because there is no express disavowal in the specification or the prosecution history of the '473 Patent, it would be wrong to adopt Apple's construction and limit the "index file" to a preferred embodiment described in the '473 Patent.

13. Term #14: encoding slices at a plurality of different quality levels [Claim 11] slices are encoded at a plurality of different quality levels [Claim 40]

There is nothing in the language of these claim terms that requires that "encoding" or "encoded" to be limited to "compressing," and the Court is referred to Emblaze's discussion with respect to claim term #6 concerning the meaning of "encoding".

Compression is one way to achieve a quality level, but is not required to achieve a quality level. A multimedia stream of data, even without compression, inherently has a quality level. A plurality of different quality levels may be achieved without compression, such as by providing plural data streams, each one with a different data rate. As with "encoding", Apple improperly seeks to limit "quality levels" as referring only to compression levels, but there is no express disavowal in the specification or prosecution history of the '473 Patent mandating that construction.

Apple complains that Emblaze has not defined the term quality level, but that term is well understood as referring to the degree of resolution, as the '473 Patent makes clear (3:5-6; "In other preferred embodiments the slices are provided by the server at multiple resolution or quality levels".).

14. Term #15: determining a data bandwidth of the network between the server and the client computer [Claim 12]

Apple contends that Emblaze's construction of "bandwidth" is too general, as it incorporates Emblaze's construction of the term "data rate." But for reasons similar to those explained above with respect to claim terms #2 and #3, nothing in this claim term restricts the determination of a bandwidth to a measurement in bits per second.

Apple's proposed construction would also require that the client "measure[] the data transfer capacity" of the network connection, but there is nothing in the claim language that requires a "measurement", or that the "data transfer capacity" be measured. For example, "determining a data bandwidth" (*see, e.g.*, Fig 6B ("determine link rate"); 9:6-9; 10:64-11:22) may be achieved by simply querying the server. Nor is there an express disavowal in the specification or prosecution history of the '473 Patent that would justify importing a "measurement" limitation into the claim, much less a measurement in any particular units of measurement.

15. Term #16: wherein dividing the stream into the sequence of slices comprises dividing the stream into a sequence of time slices, each having a predetermined duration associated therewith [Claim 23]

wherein the predetermined data size of each of the slices corresponds to a time duration of the slice [Claim 37]

As explained in connection with claim term #5, Apple's proposed construction is wrong because there is no requirement in the claim language that there be separate assignments of data size and time duration for each slice, or that the time duration be assigned "in advance of the stream being divided", nor is there any basis for reading those limitations into the claims. Apple's argument that Emblaze does not cite any "support from the '473 Patent establishing that the 'predetermined data size' of a slice . . . can be determined based solely on a preset time duration in advance of the dividing step" (Apple Br., p. 25) mischaracterizes Emblaze's claim construction for the reason stated above with respect to claim term #5 and ignores the citations on page 12 of Emblaze's opening brief which explain that setting the time duration of a slice may serve to establish the data size of the slice.

V. CONCLUSION

For the reasons set forth above and in Emblaze's opening brief, Emblaze respectfully requests that the Court adopt its proposed claim constructions.

Respectfully Submitted,

DATED: July 31, 2012

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