

**IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS  
MIDLAND/ODESSA DIVISION**

PALISADE TECHNOLOGIES, LLP,

*Plaintiff*

v.

MICRON TECHNOLOGY, INC. and  
MICRON SEMICONDUCTOR  
PRODUCTS, INC.,

*Defendants.*

Case No. 7:24-cv-00262-DC-DTG

**Jury Trial Demanded**

**DEFENDANTS' PRELIMINARY INVALIDITY CONTENTIONS FOR  
U.S. PATENT NOS. 8,148,962; 8,327,051; AND 9,281,314**

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**I. Introduction**

Defendants Micron Technology, Inc. and Micron Semiconductor Products, Inc. (collectively, “Defendants” or “Micron”) submit its Preliminary Invalidity Contentions for U.S. Patent Nos. 8,148,962; 8,327,051; and 9,281,314 (“Invalidity Contentions”) to Plaintiff Palisade Technologies, LLP (“Plaintiff” or “Palisade”) pursuant to the Court’s Order Governing Proceedings in Patent Cases.<sup>1</sup>

In Plaintiff’s Preliminary Infringement Contentions (“Infringement Contentions”), served April 16, 2025, Plaintiff asserted the following claims of each patent against Micron.

<b>U.S. Patent No.</b>	<b>Asserted Claim(s)</b>
8,148,962	1, 7-11, 14
8,327,051	1-2, 4-6, 8, 16-17, 21, 23-25, 27
9,281,314	1, 3, 5-6, 13, 17-18

Micron’s Invalidity Contentions address only those claims asserted in Plaintiff’s Infringement Contentions. Micron provides these Invalidity Contentions without waiving any argument about the sufficiency or substance of Plaintiff’s Infringement Contentions.

Based on its investigation to date, Micron hereby: (a) identifies each item of prior art that anticipates each asserted claim or renders it obvious; (b) specifies whether each such item of prior art anticipates each asserted claim or renders it obvious and, if a combination of items of

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<sup>1</sup> On May 14, 2025, the Court granted Defendants’ unopposed motion to extend the service deadline for invalidity contentions for U.S. Patent Nos. 8,996,838 and 9,524,974 to July 3, 2025. ECF No. 48.

prior art makes a claim obvious, identifies each such combination and the motivation to combine such items; (c) provides a chart identifying where specifically in each item of prior art each element of each asserted claim is found, including for each element that is governed by pre-AIA 35 U.S.C. § 112 ¶ 6 and/or 35 U.S.C. § 112(f), the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function; (d) identifies any grounds of invalidity of the asserted claims based on indefiniteness under pre-AIA 35 U.S.C. § 112 ¶ 2 and/or 35 U.S.C. § 112(b), or enablement or written description under pre-AIA 35 U.S.C. § 112 ¶ 1 and/or 35 U.S.C. § 112(a); and (e) identifies any grounds of invalidity of the asserted claims directed to ineligible subject matter under 35 U.S.C. § 101.

In addition, based on its investigation to date, Micron has produced or is producing documents concurrently with these Invalidity Contentions.

## **II. Reservations**

Defendants reserve the right to amend these Invalidity Contentions. The information and documents that Defendants produce are based on information available to date and are subject to further revision.

The information and documents that Defendants produce are based on Defendants' present understanding of Plaintiff's infringement theories as advanced by Plaintiff in its Infringement Contentions. Plaintiff's Infringement Contentions are deficient in numerous respects. For example, although Plaintiff lists hundreds of product models as accused products in its Infringement Contentions, the accompanying claim charts include analysis for only four models. Thus, Plaintiff has failed to identify specifically where each element of each asserted claim is found within each accused instrumentality. If Plaintiff attempts or is permitted to cure such deficiencies, amends its contentions, or provides additional information regarding its

**IV. U.S. Patent No. 8,327,051 (“’051 Patent”)**

**A. Invalidity Contentions Under Pre-AIA 35 U.S.C. §§ 102 And 103**

**1. Identification of Prior Art**

In addition to the prior art cited on the face of the ’051 Patent and related patents, the admitted prior art in the specifications of the ’051 Patent and related patents, the prior art cited in any file histories, reexaminations, *inter partes* review proceedings, reissue proceedings, or other examination or post-grant proceedings of the ’051 Patent and related patents, and the prior art cited in any invalidity contentions or expert reports submitted in any action or proceedings involving the ’051 Patent or related patents, Defendants identify the following prior art that anticipates each asserted claim or renders it obvious.

**a) Prior Art Patents**

The following patents and patent publications are prior art to the asserted claims under at least pre-AIA 35 U.S.C. §§ 102(a), (b), (e), and/or (g) and/or pre-AIA 35 U.S.C. § 103. The identification of any patent or patent publication shall be deemed to include any counterpart patent or application filed, published, or issued anywhere in the world.

<b>Patent or Publication Number</b>	<b>Country of Origin</b>	<b>Filing Date</b>	<b>Date of Issue or Publication</b>
U.S. Patent App. Pub. No. 2004/0136224 (“Hamer”)	U.S.	9/5/2003	7/15/2004
U.S. Patent App. Pub. No. 2006/0053241 (“Lin ’241”)	U.S.	7/27/2005	3/9/2006
U.S. Patent App. Pub. No. 2005/0070157 (“Neo”)	U.S.	9/30/2003	3/31/2005
U.S. Patent App. Pub. No. 2009/0031073 (“Diggs”)	U.S.	7/26/2007	1/29/2009
U.S. Patent App. Pub. No. 2007/0083683 (“Lin ’683”)	U.S.	10/6/2005	4/12/2007
U.S. Patent App. Pub. No. 2007/0263473 (“Raines”)	U.S.	5/14/2007	11/15/2007

Patent or Publication Number	Country of Origin	Filing Date	Date of Issue or Publication
U.S. Patent No. 8,073,985 (“Ni”)	U.S.	9/28/2007	12/6/2011
German Patent App. No. DE 102 20 629 (“Boeker”)	Germany	8/5/2002	11/27/2003
U.S. Patent App. Pub. No. 2004/0182938 (“Chen ’938”)	U.S.	8/13/2003	9/23/2004
U.S. Patent App. Pub. No. 2004/0250010 (“Chen ’010”)	U.S.	10/16/2003	12/9/2004

**b) Prior Art Systems**

The following systems are prior art under at least pre-AIA 35 U.S.C. §§ 102(a), (b) and/or

(g):

1. Products, components, systems, and methods invented, designed, developed, reduced to practice, and/or in public use or on sale related to the Palm Tungsten T5 handheld storage (“Palm Tungsten T5”), as exemplified in the claim chart in Exhibit B6. As part of these Invalidity Contentions, Defendants have produced documents relating to the Palm Tungsten T5. Based on information available to Defendants, Defendants believes that Palm Tungsten T5 was conceived and/or reduced to practice by palmOne, including that identified in the claim chart and its cited publications, at least before October 2004, without being abandoned, suppressed, or concealed, and it was in public use or on sale by the dates identified in the claim chart, which are no later than October 2004.
2. Products, components, systems, and methods invented, designed, developed, reduced to practice, and/or in public use or on sale related to the Sony Network Walkman NW-MS77DR model (“Sony Walkman”), as exemplified in the claim chart in Exhibit B-A. As part of these Invalidity Contentions, Defendants have produced documents relating to the Sony Walkman. Based on information available to Defendants, Defendants believes that the Sony Walkman was conceived and/or reduced to practice by Sony, including that identified in the claim chart and its cited publications, at least before December 2004, without being abandoned, suppressed, or concealed, and it was in public use or on sale by the dates identified in the claim chart, which are no later than December 2004.

Defendants’ investigation into publicly-available prior art systems that teach and/or render obvious each element of any asserted claims is ongoing. Fact discovery is at an early stage, and Defendants may require discovery from third parties regarding publicly-available prior

art systems. Defendants reserve the right to amend its identification of prior art systems as Defendants become aware of the existence, functionality, and/or characteristics of prior art systems as a result of their investigation and forthcoming discovery.

## 2. Primary References

Defendants contend that the primary prior art references identified below and described in the charts attached as Exhibits B1 to B6, by themselves, anticipate the asserted claims of the '051 Patent. To the extent that a primary reference is deemed not to anticipate a claim for failing to teach one or more limitations of that claim, Defendants contend that the claim would nonetheless have been obvious to a person of ordinary skill in the art at the time of the invention in view of the prior art reference itself and the knowledge of a person of ordinary skill in the art, as described in the attached charts. Defendants' prior art charts (attached as Exhibits B1 to B6) set forth the particular claims that are anticipated under 35 U.S.C. § 102 and/or rendered obvious under 35 U.S.C. § 103 by each item of prior art and identify where specifically in each item of prior art each element of each asserted claim is found.

Exhibit	Primary References
B1	U.S. Patent App. Pub. No. 2006/0053241 (“Lin ’241”)
B2	U.S. Patent App. Pub. No. 2009/0031073 (“Diggs”)
B3	U.S. Patent App. Pub. No. 2005/0070157 (“Neo”)
B4	U.S. Patent App. Pub. No. 2004/0182938 (“Chen ’938”)
B5	U.S. Patent App. Pub. No. 2004/0136224 (“Hamer”)
B6	Palm Tungsten T5

## 3. Secondary References

Exhibit B-A lists secondary prior art references and identifies, on a limitation-by-

limitation basis, where specifically each secondary reference teaches the limitations of the asserted claims. To the extent that a primary reference is deemed, by itself, not to anticipate or render obvious a claim for failing to teach one or more limitations, the claim would nonetheless have been obvious to a person of ordinary skill in the art at the time of the invention by the combination of the primary reference with one or more of the other primary references listed above and/or the references listed as disclosing those alleged missing limitations in Exhibit B-A.

#### **4. Obvious Combinations**

To the extent that a primary reference is deemed, by itself, not to anticipate or render obvious a claim for failing to teach one or more limitations, the claim would nonetheless have been obvious to a person of ordinary skill in the art at the time of the invention by the combination of the primary reference with one or more other primary references and/or the knowledge of someone skilled in the art. For example, a person of ordinary skill in the art would have been motivated to combine any reference in Exhibits B1 to B6 with any other reference(s) in Exhibits B1 to B6 and B-A. Such combinations would be achieved, for example, by merely combining the disclosures described in the respective claim charts for each reference.

Defendants also contend that any of the primary references (or combination of primary references) could be combined with any of the secondary references (or combination of secondary references) in Exhibit B-A to render obvious the asserted claims. Such combinations would be achieved by merely combining the disclosures described in the respective claim charts for each reference.

The obviousness combinations are provided in the alternative to Defendants' anticipation contentions and are not to be construed to suggest that any reference included in the combinations is not itself anticipatory.

**a) Exemplary Combinations**

Below are examples of prior art references that would have been combined by one of ordinary skill in the art at the time of the alleged invention. These combinations are merely examples. The asserted claims of the '051 Patent are rendered obvious by:

- Lin '241 alone or in combination with one or more of Diggs, Neo, Chen '938, Hamer, the Palm Tungsten T5, Boeker, Raines, Ni, Lin '683, and the Sony Walkman. For example:
  - Independent claims 1 and 16 are obvious over Lin '241; Lin '241 in view of Diggs; Lin '241 in view of Neo; Lin '241 in view of Chen '938; Lin '241 in view of Hamer; Lin '241 in view of the Palm Tungsten T5; Lin '241 in view of Raines; Lin '241 in view of Ni; Lin '241 in view of Line '683; and Lin '241 in view of the Sony Walkman.
  - Dependent claims 2 and 17 are obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Boeker.
  - Dependent claim 4 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Diggs; Boeker; Chen '938; Ni; and/or Neo.
  - Dependent claim 5 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Diggs; Boeker; Chen '938; Ni; Neo; Hamer; and/or Lin '683.

- Dependent claim 6 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Diggs; Boeker; Chen '938; Ni; Hamer; and/or Lin '683.
- Dependent claims 8 and 21 are obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Boeker; Diggs; Ni; and/or Lin '683.
- Dependent claim 23 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Diggs; Boeker; Neo; Hamer; and/or Lin '683.
- Dependent claim 24 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Diggs; Boeker; Raines; Chen '938; Ni; Neo; the **Palm Tungsten T5**; Hamer; Lin '683; and/or the **Sony Walkman**.
- Dependent claim 25 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Diggs; Neo; Chen '938; Hamer; the **Palm Tungsten T5**; Raines; Ni; Lin '683; and/or the **Sony Walkman**.
- Dependent claim 27 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Diggs; Chen '938; Ni; and/or Neo.
- **Diggs** alone or in combination with one or more of Lin '241, Diggs, Neo, Chen '938, Hamer, the **Palm Tungsten T5**, **Boeker**, Raines, Ni, Lin '683, and the **Sony Walkman**. For example:

- Independent claims 1 and 16 are obvious over Diggs; Diggs in view of Lin '241; Diggs in view of Neo; Diggs in view of Chen '938; Diggs in view of Hamer; Diggs in view of the **Palm Tungsten T5**; Diggs in view of Raines; Diggs in view of Ni; Diggs in view of Lin '683; and Diggs in view of the **Sony Walkman**.
- Dependent claims 2 and 17 are obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Boeker.
- Dependent claim 4 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Boeker; Chen '938; Ni; and/or Neo.
- Dependent claim 5 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Boeker; Chen '938; Ni; Neo; Hamer; and/or Lin '683.
- Dependent claim 6 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Boeker; Chen '938; Ni; Hamer; and/or Lin '683.
- Dependent claims 8 and 21 are obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Boeker; Ni; and/or Diggs in view of Lin '683.
- Dependent claim 23 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Boeker; Neo; Hamer; and/or Lin '683.

- Dependent claim 24 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Boeker; Raines; Chen '938; Ni; Neo; the Palm Tungsten T5; Hamer; Lin '683; and/or the Sony Walkman.
- Dependent claim 25 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Neo; Chen '938; Hamer; he Palm Tungsten T5; Raines; Ni; Lin '683; and/or the Sony Walkman.
- Dependent claim 27 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Chen '938; Ni; and/or Neo.
- Neo alone or in combination with one or more of Lin '241, Diggs, Neo, Chen '938, Hamer, the Palm Tungsten T5, Boeker, Raines, Ni, Lin '683, and the Sony Walkman. For example:
  - Independent claims 1 and 16 are obvious over Neo; Neo in view of Lin '241; Neo in view of Diggs; Neo in view of Chen '938; Neo in view of Hamer; Neo in view of the Palm Tungsten T5; Neo in view of Raines; Neo in view of Ni; Neo in view of Lin '683; and Neo in view of the Sony Walkman.
  - Dependent claims 2 and 17 are obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Boeker.

- Dependent claim 4 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Neo Chen '938; and/or Ni.
- Dependent claim 5 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Chen '938; Ni; Hamer; and/or Lin '683.
- Dependent claim 6 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Chen '938; Ni; Hamer; and/or Lin '683.
- Dependent claims 8 and 21 are obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Boeker; Diggs; Ni; and/or Lin '683.
- Dependent claim 23 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Hamer; and/or Lin '683.
- Dependent claim 24 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Raines; Chen '938; Ni; the Palm Tungsten T5; Hamer; Lin '683; and/or the Sony Walkman.
- Dependent claim 25 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Chen '938; Hamer; the Palm Tungsten T5; Raines; Ni; Lin '683; and/or the Sony Walkman.

- Dependent claim 27 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Chen '938; and/or Ni.
- Chen '938 alone or in combination with one or more of Lin '241, Diggs, Neo, Chen '938, Hamer, the **Palm Tungsten T5**, Boeker, Raines, Ni, Lin '683, and the **Sony Walkman**. For example:
  - Independent claims 1 and 16 are obvious over Chen '938; Chen '938 in view of Lin '241; Chen '938 in view of Diggs; Chen '938 in view of Neo; Chen '938 in view of Hamer; Chen '938 in view of the **Palm Tungsten T5**; Chen '938 in view of Raines; Chen '938 in view of Ni; Chen '938 in view of Lin '683; and Chen '938 in view of the **Sony Walkman**.
  - Dependent claims 2 and 17 are obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Boeker.
  - Dependent claim 4 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Ni; and/or Neo.
  - Dependent claim 5 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Ni; Neo; Hamer; and/or Lin '683.
  - Dependent claim 6 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Ni; Hamer; and/or Lin '683.

- Dependent claims 8 and 21 are obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Boeker; Diggs; Ni; and/or Lin '683.
- Dependent claim 23 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Neo; Hamer; and/or Lin '683.
- Dependent claim 24 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Raines; Ni; Neo; the **Palm Tungsten T5**; Hamer; Lin '683; and/or the **Sony Walkman**.
- Dependent claim 25 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Neo; Hamer; the **Palm Tungsten T5**; Raines; Ni; Lin '683; and/or the **Sony Walkman**.
- Dependent claim 27 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Ni; and/or Neo.
- Hamer alone or in combination with one or more of Lin '241, Diggs, Neo, Chen '938, Hamer, the **Palm Tungsten T5**, Boeker, Raines, Ni, Lin '683, and the **Sony Walkman**. For example:
  - Independent claims 1 and 16 are obvious over Hamer; Hamer in view of Lin '241; Hamer in view of Diggs; Hamer in view of Neo; Hamer in view of Chen '938; Hamer in view of the **Palm Tungsten T5**; Hamer in view of

Raines; Hamer in view of Ni; Hamer in view of Lin '683; and Hamer in view of the Sony Walkman.

- Dependent claims 2 and 17 are obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Boeker.
- Dependent claim 4 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Chen '938; Ni; and/or Neo.
- Dependent claim 5 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Chen '938; Ni; Neo; and Lin '683.
- Dependent claim 6 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Chen '938; Ni; and/or Lin '683.
- Dependent claims 8 and 21 are obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Boeker; Diggs; Ni; and/or Lin '683.
- Dependent claim 23 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Neo; and/or Lin '683.
- Dependent claim 24 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241;

- Diggs; Boeker; Raines; Chen '938; Ni; Neo; the Palm Tungsten T5; Lin '683; and/or the Sony Walkman.
- Dependent claim 25 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Neo; Chen '938; the Palm Tungsten T5; Raines; Ni; Lin '683; and/or the Sony Walkman.
  - Dependent claim 27 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Chen '938; Ni; and/or Neo.
  - The Palm Tungsten T5 alone or in combination with one or more of Lin '241, Diggs, Neo, Chen '938, Hamer, Boeker, Raines, Ni, Lin '683, and the Sony Walkman. For example:
    - Independent claims 1 and 16 are obvious over the Palm Tungsten T5; the Palm Tungsten T5 in view of Lin '241; the Palm Tungsten T5 in view of Diggs; the Palm Tungsten T5 in view of Neo; the Palm Tungsten T5 in view of Chen '938; the Palm Tungsten T5 in view of Hamer; the Palm Tungsten T5 in view of Raines; the Palm Tungsten T5 in view of Ni; the Palm Tungsten T5 in view of Lin '683; and the Palm Tungsten T5 in view of the Sony Walkman.
    - Dependent claims 2 and 17 are obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Boeker.

- Dependent claim 4 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Chen '938; Ni; and/or Neo.
- Dependent claim 5 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Chen '938; Ni; Neo; Hamer; and/or Lin '683.
- Dependent claim 6 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Chen '938; Ni; Hamer; and/or Lin '683.
- Dependent claims 8 and 21 are obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Boeker; Diggs; Ni; and/or Lin '683.
- Dependent claim 23 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Neo; Hamer; and/or Lin '683.
- Dependent claim 24 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Boeker; Raines; Chen '938; Ni; Neo; Hamer; Lin '683; and/or the Sony Walkman.
- Dependent claim 25 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Neo; Chen '938; Hamer; Raines; Ni; Lin '683; and/or the Sony Walkman.

- Dependent claim 27 is obvious over any of the obviousness grounds listed for independent claims 1 and 16 alone and/or further in view of Lin '241; Diggs; Chen '938; Ni; and/or Neo.

**b) Motivations to Combine and Expectation of Success**

To the extent a finder of fact finds that a primary prior art reference does not disclose one or more limitations of an asserted claim, the asserted claim is nevertheless obvious because the alleged missing limitations contain nothing beyond ordinary improvements. In other words, the asserted claim combines known elements to achieve predictable results or chooses between clear alternatives known to those of skill in the art, particularly in view of the state of the art as reflected in the relevant prior art.

Moreover, as explained above, it would have been obvious to a person of skill in the art at the time of the alleged invention of the asserted claims to combine any primary reference with any combination of other primary references so as to practice the asserted claims. To the extent that Plaintiff argues that any concept claimed in the asserted claims is not disclosed in a primary reference, it would, at a minimum, have been obvious to adapt the primary reference to include the concept or combine it with other primary references that disclose the concept. Each concept described and claimed in the Asserted Patents was known to those of skill in the art as available design choices for semiconductor memory design and fabrication.

The Supreme Court has held that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). “When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one.” *Id.* at 417. As the Supreme Court made clear, “[f]or the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the

art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *Id.*

To determine whether there is an apparent reason to combine the known elements in the fashion claimed by the patent at issue, a court can “look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art.” *Id.* at 418. For example, obviousness can be demonstrated by showing “there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 420. “[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* Common sense also teaches that “familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.*

However, the Supreme Court in *KSR* held that a claimed invention can be obvious even if there is no explicit teaching, suggestion, or motivation for combining the prior art to produce that invention. In summary, *KSR* holds that patents that are based on new combinations of elements or components already known in a technical field may be found to be obvious. *See, generally, KSR*, 550 U.S. 398. Specifically, the Court in *KSR* rejected a rigid application of the “teaching, suggestion, or motivation [to combine]” test. *Id.* at 418. “In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim.” *Id.* at 419. “Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the

manner claimed.” *Id.* at 420. A key inquiry is whether the “improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

The rationale to combine or modify prior art references is significantly stronger when, as here, the references seek to solve the same problem, come from the same field, and correspond well to each other. *In re Inland Steel Co.*, 265 F.3d 1354, 1362 (Fed. Cir. 2001). The Federal Circuit has held that two references may be combined as invalidating art under similar circumstances, namely “[the prior art] focus[es] on the same problem that the . . . patent addresses: enhancing the magnetic properties of . . . steel. Moreover, both [prior art references] come from the same field . . . . Finally, the solutions to the identified problems found in the two references correspond well.” *Id.* at 1364 (concerning patents and prior art relating to improving the magnetic and electrical properties of steel).

In view of the Supreme Court’s *KSR* decision, the PTO issued a set of Examination Guidelines. Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in view of the Supreme Court Decision in *KSR International Co. v. Teleflex, Inc.*, 72 Fed. Reg. 57526 (October 10, 2007). Those Guidelines summarized the *KSR* decision and identified various rationales for finding a claim obvious, including those based on other precedents. Those rationales include:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

*Id.* at 57529. The above rationales likewise apply in rendering obvious the asserted claims of the Asserted Patents.

The references disclosed herein, alone or in combination, contain an explicit and/or implicit teaching or motivation to combine them due to the following: (1) the knowledge generally available to a person of ordinary skill in the art; (2) the prior art references as understood by a person of ordinary skill in the art; (3) the nature of the problem to be solved; (4) the fact that each prior art reference addresses similar problems; and (5) the knowledge of those skilled in the art that the disclosed elements had been or could be used together.

As an example of those reasons and motivations to combine the references, Lin '241, Hamer, Neo, Diggs, Lin '683, Raines, Ni, the Palm Tungsten T5, Boeker, Chen '938, and the Sony Walkman, all generally relate to or use memory cards for storing and transferring data between various interfaces. *See, e.g.*, Lin '241, ¶ 7; Diggs, ¶ 8; Neo, ¶ 2; Chen '938, ¶¶ 5-8; Hamer, ¶ 14. The references disclose using similar components and techniques, such as the use of a USB port, along with a corresponding set of pins and controller circuitry; an I/O port, along with a corresponding set of pins and controller circuitry; memory in communication with the ports; a housing that stores the memory and exposes the ports; positioning the ports on the same end to allow a same card-insertion direction irrespective of whether a host device comprises a mating USB port or a mating I/O port; and positioning the ports such that when the I/O port is electrically connected with a host device, at least one of the pins of the USB port is not electrically

connected, and when the USB port is connected to the host device, at least one of the pins of the I/O port is not electrically connected. *See generally* Ex. B1-B6. Thus, combining one or more such references merely involves combining prior art elements according to known methods to yield predictable results, the substitution of one known element for another to obtain predictable results, the use of a known technique to improve similar devices in the same way, or applying a known technique to a known device ready for improvement to yield predictable results.

In addition, below are additional motivations to combine prior art for particular claim limitations. The following discussion of specific claim limitations merely provides examples, which are not limiting.

For example, to the extent that any primary reference is deemed not to anticipate a claim for failing to teach limitations 1[g]/16[g] (“the USB port and the I/O port are positioned to allow a same card-insertion direction irrespective of whether a host device comprises a mating USB port or a mating I/O port”), it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the primary reference with any of the prior art that discloses limitations 1[g]/16[g] in Exhibits B1 to B6 and B-A. For example, the charted prior art references explicitly describe or implicitly suggest a memory card having a USB port and I/O port positioned to allow a same card-insertion direction irrespective of whether a host device comprises a mating USB port or a mating I/O port. *See, e.g.*, Lin ’241, Figs. 5, 6A, ¶¶ 106-107; Diggs, Fig. 7, ¶¶ 23, 55; Neo, Fig. 1, ¶¶ 24, 29; Hamer, Fig. 2; *see also* Chen ’938, ¶ 16, Boeker, Fig. 1, ¶ 12; Raines, Figs. 3A, 4B, ¶¶ 10-12, 21, 94-95; Ni, 8:43-52. It would have been obvious to combine any primary reference with any of Lin ’241, Hamer, Neo, Diggs, Lin ’683, Raines, Ni, the Palm Tungsten T5, Boeker, Chen ’938, and the Sony Walkman to satisfy limitations 1[g]/16[g]. A person skilled in the art would have recognized that having “USB port and the I/O

port are positioned to allow a same card-insertion direction irrespective of whether a host device comprises a mating USB port or a mating I/O port” was a common, predictable design for a portable handheld memory card. Further, a person of ordinary skill in the art would have recognized that positioning the USB and I/O ports in this manner has several benefits. For example, with such a port positioning, a user need not worry about the orientation of the card when inserting it into different devices, which can prevent damage. It also reduces the risk of inserting the card incorrectly, in turn further minimizes the risk of damage to the device’s ports. Thus, a person of ordinary skill in the art would have been motivated to modify any of the primary references to include the claimed features, to the extent it is not disclosed. A person of ordinary skill in the art would also have had a reasonable expectation of success given that, by the alleged priority date of the ’051 Patent, storage devices that accommodate different kinds of host devices were widely sold and used. A person of ordinary skill in the art would have understood that these references disclose interrelated teachings based on routine technologies and would have been amenable to various well-understood and predictable combinations.

In addition, to the extent that any primary reference is deemed not to anticipate a claim for failing to teach limitations 1[h]/16[h] (“the USB port and the I/O port are positioned such that when the I/O port is electrically connected with the host device, at least one of the first set of pins of the USB port is not electrically connected to the host device, and when the USB port is electrically connected to the host device, at least one of the second set of pins of the I/O port is not electrically connected to the host device”), it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the primary reference with any of the prior art that discloses limitations 1[h]/16[h] in Exhibits B1 to B6 and B-A. For example, the charted prior art references explicitly describe or implicitly suggest a memory card whose USB and I/O

ports are positioned such that when the I/O port is electrically connected with the host device, at least one of the first set of pins of the USB port is not electrically connected to the host device, and when the USB port is electrically connected to the host device, at least one of the second set of pins of the I/O port is not electrically connected to the host device. *See, e.g.*, Lin '241, ¶¶ 31, 33-35, 36-38; Diggs, Figs. 2, 7, ¶¶ 23, 40, 55; Neo, ¶¶ 4, 26; Chen '938, ¶¶ 21, 31; Boeker ¶¶ 1-2; Raines, Figs. 3A, 4A, ¶¶ 12, 34-35, 62, 94-95, 110; Ni at 8:25-52. It would have been obvious to combine any primary reference with any of Lin '241, Neo, Diggs, Raines, Ni, the Palm Tungsten T5, Boeker, Chen '938, and the Sony Walkman to satisfy limitations 1[h]/16[h].

A person skilled in the art would have recognized that having “the USB port and the I/O port ... positioned such that when the I/O port is electrically connected with the host device, at least one of the first set of pins of the USB port is not electrically connected to the host device, and when the USB port is electrically connected to the host device, at least one of the second set of pins of the I/O port is not electrically connected to the host device” was a common, predictable design for a memory card. Further, a person of ordinary skill in the art would have recognized that positioning the USB and I/O ports in this manner has several benefits, such as promoting efficient and convenient memory storage operations. Specifically, a person of ordinary skill in the art would have appreciated that positioning the USB and I/O ports in such a manner would help minimize interference between the two ports when both are connected to a host device. In addition, a person of ordinary skill in the art would have appreciated that such a port positioning promotes design flexibility and compatibility, by allowing the memory card to be easily used with different devices. A person of ordinary skill in the art would have further appreciated that such a port positioning could help minimize wear on the USB and I/O ports, thereby increasing the memory card’s durability and longevity. Thus, a person of ordinary skill in the art would have

been motivated to modify any of the primary references to include the claimed features, to the extent it is not disclosed. A person of ordinary skill in the art would also have had a reasonable expectation of success given that, by the alleged priority date of the '051 Patent, storage devices that accommodate different kinds of host devices were widely sold and used. A person of ordinary skill in the art would have understood that these references disclose interrelated teachings based on routine technologies and would have been amenable to various well-understood and predictable combinations.

In addition, to the extent that any primary reference is deemed not to anticipate a claim for failing to teach claims 2 and 17 (“decryption circuitry in communication with the memory and configured to decrypt encrypted data stored in the memory”), it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the primary reference with any of the prior art that discloses claims 2 and 17 in Exhibits B1 to B6 and B-A. For example, the charted prior art references explicitly describe or implicitly suggest a memory card having decryption circuitry in communication with the memory and configured to decrypt encrypted data stored in the memory. *See, e.g.*, Boeker at ¶¶ 1-9, 12, 15; Sony Walkman Operating Instructions at 8. It would have been obvious to combine any primary reference with any of Boeker and the Sony Walkman to satisfy claims 2 and 17. A person skilled in the art would have recognized that having “decryption circuitry in communication with the memory and configured to decrypt encrypted data stored in the memory” was a common, predictable design for a memory card. Further, a person of ordinary skill in the art would have recognized that incorporating such circuitry into the memory card has several benefits. For example, a person of ordinary skill in the art would have appreciated that including encryption and decryption on board the memory card enhances security by ensuring that stored information remains confidential

(accessible only to authorized users). Such a position of ordinary skill in the art would have known that circuitry may also help verify the integrity of the data (i.e., ensuring it hasn't been tampered with). Further, hardware-based encryption and decryption (e.g., through circuitry) was known to be generally faster than software-based solutions, thereby reducing latency for accessing data without compromising security. Thus, a person of ordinary skill in the art would have been motivated to modify any of the primary references to include the claimed features, to the extent it is not disclosed. A person of ordinary skill in the art would also have had a reasonable expectation of success given that, by the alleged priority date of the '051 Patent, storage devices that accommodate different kinds of host devices were widely sold and used. A person of ordinary skill in the art would have understood that these references disclose interrelated teachings based on routine technologies and would have been amenable to various well-understood and predictable combinations.

In addition, to the extent that any primary reference is deemed not to anticipate a claim for failing to teach claim 4 (“a power management unit in communication with the USB controller circuitry”), it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the primary reference with any of the prior art that discloses this limitation in Exhibits B1 to B6 and B-A. For example, the charted prior art references explicitly describe or implicitly suggest a power management unit in communication with the USB controller circuitry. *See, e.g.*, Diggs, ¶¶ 4, 29; Chen '938, ¶ 39, Fig. 8; Hamer, ¶¶ 6, 23. It would have been obvious to combine any primary reference with any of Diggs, Chen '938, Neo, and the Sony Walkman to satisfy claim 4. A person skilled in the art would have recognized that having “a power management unit in communication with the USB controller circuitry” was a common, predictable design for a memory card. Further, a person of ordinary skill in the art

would have recognized that managing power of a circuit, including circuitry that controls a USB port, has several benefits. For example, a person of ordinary skill in the art would have appreciated the ability to adjust power to comply with applicable USB standards. Thus, a person of ordinary skill in the art would have been motivated to modify any of the primary references to include the claimed features, to the extent it is not disclosed. A person of ordinary skill in the art would also have had a reasonable expectation of success given that, by the alleged priority date of the '051 Patent, storage devices that accommodate different kinds of host devices were widely sold and used. A person of ordinary skill in the art would have understood that these references disclose interrelated teachings based on routine technologies and would have been amenable to various well-understood and predictable combinations.

In addition, to the extent that any primary reference is deemed not to anticipate a claim for failing to teach claims 8 and 21 (“the memory comprises Flash memory”), it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the primary reference with any of the prior art that discloses this limitation in Exhibits B1 to B6 and B-A. For example, the charted prior art references explicitly describe or implicitly suggest a memory comprises Flash memory. *See, e.g.*, Lin '241, ¶ 3; Diggs, ¶ 30; Neo, ¶¶ 2, 11. It would have been obvious to combine any primary reference with any of Lin '683, Diggs, Boeker, Lin '241, Ni, Neo, and the Sony Walkman to satisfy claims 8 and 21.

A person skilled in the art would have recognized that having “the memory compris[ing] Flash memory” was a common, predictable design for a memory card. Further, a person of ordinary skill in the art would have recognized that the benefits of implementing Flash memory. A person of ordinary skill in the art would have known that Flash memory was an obvious design choice for a type of memory. Thus, a person of ordinary skill in the art would have been motivated

to modify any of the primary references to include the claimed features, to the extent it is not disclosed. A person of ordinary skill in the art would also have had a reasonable expectation of success given that, by the alleged priority date of the '051 Patent, storage devices that accommodate different kinds of host devices were widely sold and used. A person of ordinary skill in the art would have understood that these references disclose interrelated teachings based on routine technologies and would have been amenable to various well-understood and predictable combinations.

In addition, to the extent that any primary reference is deemed not to anticipate a claim for failing to teach claim 27 (“wherein the USB port comprises multiple data lines; wherein the first set of pins comprise multiple data pins connected to the multiple data lines; and wherein all of the multiple data pins are not electrically connected to the I/O controller circuitry”), it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the primary reference with any of the prior art that discloses claim 27 in Exhibits B1 to B6 and B-A for the same reasons as for claim limitation 1[h]. Similarly, a person skilled in the art would have been motivated to modify any of the primary references to include the claimed features, to the extent it is not disclosed and would also have had a reasonable expectation of success for the same reasons explained for claim limitation 1[h].

## **B. Invalidity Contentions Under 35 U.S.C. § 112**

Defendants include below the grounds on which Defendants contend the asserted claims are invalid for failure to meet the requirements of the first two paragraphs of 35 U.S.C. § 112.

Plaintiff has not yet provided a claim construction for many of the terms and phrases that Defendants anticipate will be in dispute. Defendants, therefore, cannot provide a complete list of its § 112 defenses because Defendants do not know whether Plaintiff will proffer a

construction for certain terms and phrases that is broader than, or inconsistent with, the construction that would be supportable by the disclosure set forth in the specification.

To the extent the following contentions reflect constructions of claim limitations consistent with or implicit in Plaintiff's Infringement Contentions, no inference is intended nor should any be drawn that Defendants agree with Plaintiff's claim constructions, and Defendants expressly reserve the right to contest such claim constructions. Defendants offer these contentions in response to Plaintiff's Infringement Contentions and without prejudice to any position it may ultimately take as to any claim construction issues.

Accordingly, Defendants reserve the right to amend or supplement these § 112 Invalidity Contentions as discovery progresses.

**1. Indefiniteness Under 35 U.S.C. § 112, ¶ 2**

35 U.S.C. § 112, ¶ 2 requires that a patent claim “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2. Claim terms that fail to inform those skilled in the art “with reasonable certainty . . . about the scope of the invention” fail the definiteness requirement of 35 U.S.C. § 112, ¶ 2. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014).

Each of the asserted claims are invalid as indefinite under 35 U.S.C. § 112 because they fail to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. In particular, the following limitations, read in light of the intrinsic evidence, fail to inform those skilled in the art with reasonable certainty about the scope of the claimed inventions:

- Claim 1: “the USB port and the I/O port are positioned on a same end to allow a same card-insertion direction irrespective of whether a host device comprises a mating USB port or a mating I/O port;
- Claim 1: “the USB port and the I/O port are positioned such that when the I/O port is electrically connected with the host device, at least one of the first set of pins of the USB port is not electrically connected to the host device, and when the USB port is electrically connected to the host device, at least one of the second set of pins of the I/O port is not electrically connected to the host device.”
- Claim 5: “a host interface module”
- Claim 23: “at least two pins of the USB port are parallel to at least two pins of the I/O port.”
- Claim 24: “layout for the USB port is different from layout of the I/O port.”
- Claim 25: “the I/O port is configured for mating with an external port.”
- Claim 27: “all of the multiple data pins are not electrically connected to the I/O controller circuitry.”

**2. Lack of Enablement/Lack of Written Description Under 35 U.S.C. § 112, ¶ 1**

The asserted claims of the '051 Patent are further invalid under 35 U.S.C. § 112, ¶ 1 because the specifications do not contain an adequate written description of the subject matter of these claims and would not enable one of skill in the relevant art to make and use the alleged invention.

For a claim to be valid, the specification must contain a written description of the invention. 35 U.S.C. § 112, ¶ 1. To fulfill the written description requirement, it “must clearly allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed.”

*Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (citation and internal quotation marks omitted). “[T]he applicant must ‘convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention,’ and demonstrate that by disclosure in the specification of the patent.” *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991)).

The specification must also describe “the manner and process of making and using [the invention], in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the” invention. *Ariad*, 598 F.3d at 1343; *see also* 35 U.S.C. § 112 ¶ 1. “The enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation.” *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1244 (Fed. Cir. 2003) (citation omitted). “[T]he scope of the claims must be less than or equal to the scope of the enablement.” *Nat’l Recovery Tech., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1196 (Fed. Cir. 1999).

Each of the asserted claims below are invalid because the specifications fail to provide written description and/or an enabling disclosure of at least the following limitations:

- Claim 1: “wherein the USB port and the I/O port are positioned on a same end to allow a same card-insertion direction irrespective of whether a host device comprises a mating USB port or a mating I/O port;
- Claim 1: “when the I/O port is electrically connected with the host device, at least one of the first set of pins of the USB port is not electrically connected to the host device, and when the USB port is electrically connected to the host device, at least one of the second set of pins of the I/O port is not electrically connected to the host device.”

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Respectfully submitted,

/s/ John Kappos

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**CERTIFICATE OF SERVICE**

Pursuant to the Federal Rules of Civil Procedure, I hereby certify that, on June 11, 2025, all counsel of record who have appeared in this case are being served with a copy of the foregoing via the electronic mail.

/s/ John Kappos  
John Kappos  
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