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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

HTC CORPORATION and HTC AMERICA, INC., Plaintiffs, v. TECHNOLOGY PROPERTIES LIMITED, PATRIOT SCIENTIFIC CORPORATION and ALLIACENSE LIMITED, Defendants.	Case No. 5:08-cv-00882 PSG **DEFENDANTS' OPPOSITION TO EMERGENCY MOTION FOR ADDENDUM TO JURY INSTRUCTIONS** Judge: Hon. Paul S. Grewal Date: September 20, 2013 Time: 9:30 a.m. Place: Courtroom 5, 4th Floor

Introduction

Although HTC titles its motion as a request for an addendum to the jury instructions, it is actually a motion for reconsideration of both the Court's summary judgment and claim construction orders. The motion seeks entry of yet ***another*** claim construction for "entire" that substantively differs from any construction HTC has previously requested in this case or the co-pending ITC action. Although this Court denied HTC's Motion for Summary Judgment of Non-Infringement of the '336 Patent in its entirety, HTC now re-writes the order as "granting-in-part" HTC's motion, and relies on it as the sole basis for the present request.

HTC's new "addendum" should be rejected because it imposes two new negative limitations on the "entire" elements that are not supported by the intrinsic evidence. Moreover, HTC's proposed addendum is hopelessly ambiguous and improperly conflates the two distinct concepts of: (1) generating a clock signal; and (2) regulating or adjusting the frequency of an already generated clock signal. While Defendants believe the Court has retained its original construction of "entire," the parties and the jury may also benefit from a clarification of the effect of the Court's September 17, 2013 Order – just not in the confusing manner proposed by HTC.

I. HTC'S MOTION FOR ADDENDUM TO JURY INSTRUCTIONS SHOULD BE DENIED BECAUSE IT SEEKS TO IMPOSE AMBIGUOUS AND UNSUPPORTED LIMITATIONS ON THE "ENTIRE" ELEMENTS.

In its September 17, 2013 Order (Dkt. No. 585), the Court denied HTC's Motion for Summary Judgment of Non-Infringement of the '336 Patent – the Court did ***not*** "grant-in-part" HTC's motion. In addition, the Court did not modify its claim construction for the "entire" elements.[1] Thus, for example, the construction of "entire oscillator" (claims 6 and 13) appears to remain as follows: "an oscillator that is entirely on the same semiconductor substrate as the central processing unit." If this remains the Court's construction, the parties should simply proceed to trial with that definition of "entire" – without HTC's confusing modifications.

[1] Although the Court noted in footnote 24 that "[t]he patentee's arguments traversing the prior art narrowed the claims," the Court did not provide specific guidance on the current scope and definition of the "entire" elements.

HTC now proposes to add two new negative limitations to the "entire" elements – one of which itself has two parts – as set forth below:

> **[1]** The terms "entire ring oscillator variable speed system clock" (in claims 1 and 11), "entire oscillator" (in claims 6 and 13), and "entire variable speed system clock" (in claims 10 and 16) are not satisfied by an accused system that uses any external clock to generate a signal.
>
> **[2]** An accused product can only infringe the '336 patent if that product contains an on-chip ring oscillator that is: **(a)** self-generating; and **(b)** does not rely on an input control to determine its frequency.

New limitation **[1]** is ambiguous. Presumably, HTC proposes this limitation in response to the Court's statement that it "agrees with HTC that the disputed limitations are properly understood to exclude any external clock used to generate a signal." Sept. 17, 2013 Order [Dkt. # 585] at 11. However, taken out of context, this statement is ambiguous because "uses any external clock to generate a signal" does not define what signal is being discussed and how the external clock may or may not be used to satisfy the claim. It also mischaracterizes the patent: Figure 17 shows the use of a conventional external crystal to clock the I/O interface. *See also* '336 17:12-34.

New limitation **[2]** is also ambiguous. The phrase "self-generating" is undefined. If "self-generating" means that the clock "does not rely on an input control to determine its frequency," then it is redundant. "Input control" are also undefined. It does not specify either the type of input or the type of control that is not permitted. Thus, HTC's proposed modifications to the Court's claim construction – whether by "addendum" to jury instructions or otherwise – should be rejected.

II. HTC'S NEW CLAIM LIMITATIONS SHOULD BE REJECTED BECAUSE THEY IMPROPERLY CONFLATE THE DISTINCT CONCEPTS OF "GENERATING A CLOCK SIGNAL" AND "REGULATING THE FREQUENCY OF A CLOCK SIGNAL," AND MISCONSTRUE THE MAGAR AND SHEETS REFERENCES.

New limitations **[1]** and **[2]** taken together are ambiguous and confusing. The source of the ambiguity is HTC's unjustified overextension of the arguments the patent applicants made during prosecution about the Sheets and Magar references. In addition, HTC repeatedly conflates the use of an external crystal oscillator and/or a control signal "to ***generate*** a clock signal" versus the use of an external crystal oscillator and/or a control signal "to determine or regulate the ***frequency*** of an already generated clock signal."

A. Contrary to HTC's Repeated and Unsupported Arguments, "Generating a Clock Signal" and "Regulating or Adjusting the Frequency of a Clock Signal" Are Not the Same; HTC's Effort to Conflate These Concepts is Designed to Confuse the Jury.

As an initial matter, "generating a clock signal" is ***not the same*** as "adjusting the frequency clock signal." Frequency is a ***characteristic*** of an already generated clock signal, as explained in Defendants' opposition to HTC's motion for summary judgment. In both its motion for summary judgment and its current emergency motion, HTC incorrectly argues that there should be no infringement if its products use a control signal or an external crystal/clock generator **to set or adjust the *frequency*** of the clock signal. This is quite different than arguing (as HTC did on summary judgment) that an external crystal and/or control signal may not be used to "***generate*** a clock signal." Equating "setting or adjusting the ***frequency*** of a clock signal" with "generating a clock signal" is fundamentally incorrect.

The difference between a **clock signal** and its **frequency** is apparent from the specification and claims of the '336 patent. For example:

> The ring oscillator 430 is useful as a **system clock** . . . because **its performance** tracks the parameters which similarly affect all other transistors on the same silicon die.

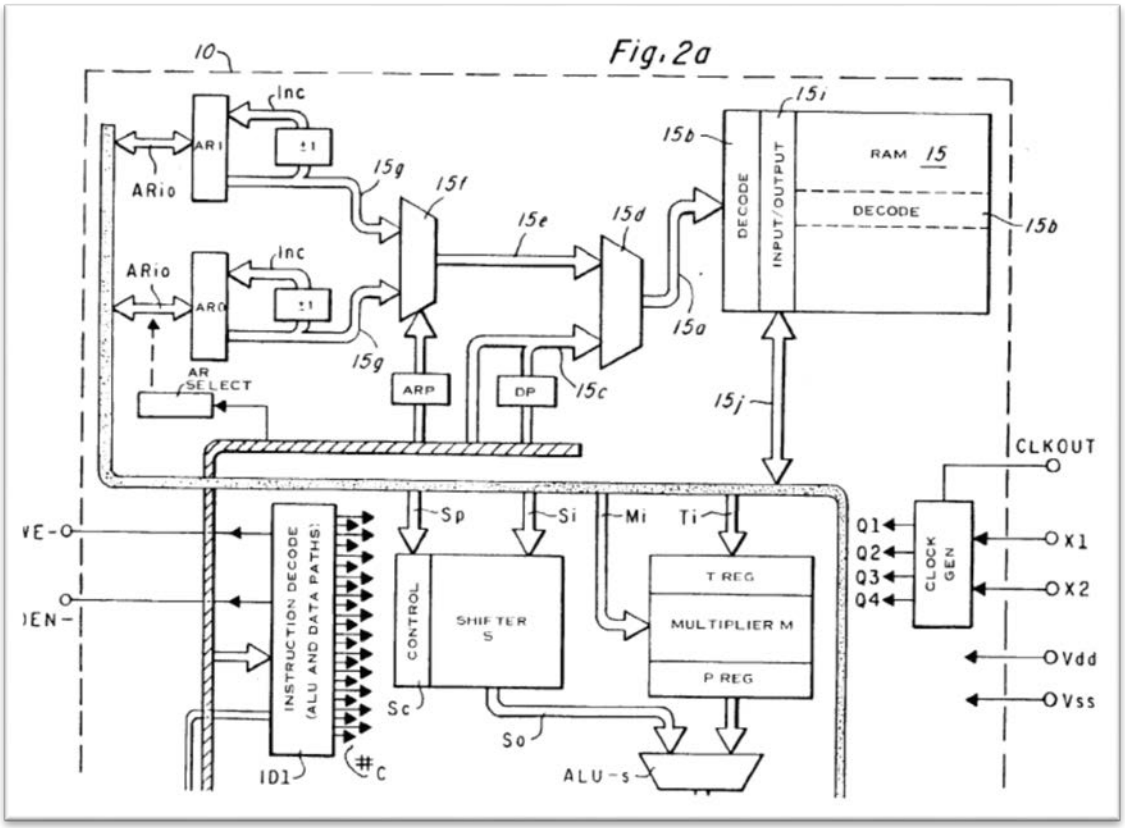
'336 at 16:63-67. In other words, the "performance" of the clock – *i.e.*, its speed or frequency – is ***not*** the same as the clock itself: its performance (frequency) changes, because it "tracks the parameters which similarly affect all other transistors on the same silicon die."

Similarly, claim 6 discusses "**an entire oscillator**" that "clock[s] said central processing unit ***at a clock rate.***" Plainly, the clock itself (the entire oscillator) is not the same as its "clock rate" (frequency), which is a ***characteristic*** of the already generated clock signal. Further, the "clock rate" in claim 6 has the ability to "vary" based on changes in "one or more fabrication or operational parameters." Obviously, the identity and source of the clock signal itself – the "entire oscillator" – does not change. By contrast, the "clock rate" (frequency) – which is a ***characteristic*** of the clock signal generated by the entire oscillator – can vary based on conditions.

Thus, equating "clock signal" and "frequency of the clock signal" is just plain wrong. And HTC improperly uses this flawed logic to argue for a confusing and ambiguous construction of "entire." The Court should reject HTC's invitation to adopt a legally incorrect construction.

B. The File History's Treatment of Magar and Sheets Do Not Support the Overreaching Limitations Sought by HTC.

HTC needs to stop misrepresenting to the Court about what Magar and Sheets disclosed, and how the patent applicants distinguished them. The applicants' never distinguished Magar by "unambiguously disclaim[ing] clocks and oscillators that ***rely on*** an external crystal for ***frequency control***," as HTC falsely argued in on summary judgment (HTC 457 Mot. at 12). First, the '336 patent ***shows the use of an external crystal*** (to clock the I/O interface). '336, Fig. 17; 17:12-34. HTC also blatantly mischaracterizes Magar, which included a CPU clock that was exactly like the prior art disclosed in the '336 patent (and the external crystal used to clock the I/O interface in Figure 17 of the '336 patent). The external crystal oscillator in Magar (connected at X1 and X2) generated the actual clock signal for the CPU; it was not a reference signal, and there was nothing in the "CLOCK GEN" circuitry box in Figure 2 of Magar to generate an oscillating clock signal:



Tyan Decl. [Dkt. # 471-1], Exh. A (Magar). Thus, distinguishing Magar had nothing to do with a disclaimer about the use of any external crystal for "frequency control." HTC should stop arguing, once and for all, that the Magar external crystal is the same thing as a reference crystal that is used

by a PLL. The two are completely different, and HTC's unsupportable mischaracterizations of Magar should be rejected. Neither Magar nor the applicants' statements in the file history had anything to do with the use of a crystal oscillator as a ***reference signal*** for a PLL. Rather, the off-chip crystal oscillator in Magar provided the actual clock signal for the CPU in the Magar microprocessor. **That is what applicants disclaimed: *the use of an external crystal to generate the actual clock signal for the CPU.***

HTC has also repeatedly misconstrued the file history's distinction of Sheets. As Defendants explained in their opposition to HTC's summary judgment motion, the applicants merely observed that ***Sheets lacked any on-chip oscillator***. Rather, Sheets provided "control information" – in the form of a "**digital word**" – to an **external clock**:

> The present invention does not similarly rely upon provision of frequency control information to an **external clock**, but instead contemplates providing a ring oscillator clock and the microprocessor within the same integrated circuit. . . Sheets' system for providing clock control signals to an **external clock** is thus seen to be unrelated to the integral microprocessor/clock system of the present invention.

Tyan Decl. [Doc. 471-1], Exh. F (4/1996 Amend.) at 8; Tyan Decl. [Doc. 471-1], Exh. B (Sheets) at 2:54-68 ("Microprocessor 101 . . . writes a **digital word** . . . via data bus 104 to VCO 102").

In a subsequent amendment, the applicants noted that the **external** Sheets clock "***required***" a "**digital word**" or "**command input**." By contrast, in the '336 invention, "both the variable speed clock and the microprocessor ***are fabricated together in the same integrated circuit***." Tyan Decl. [Dkt. # 471-1], Exh. G (1/1997 Amendment) at 4. Thus, the applicants distinguished Sheets on two bases: (1) unlike the '336 invention, Sheets lacked an on-chip clock/oscillator; and (2) the ***off-chip*** clock in Sheets ***required*** a "digital word"/"command input." These distinctions do not come close to constituting a disclaimer of any "control signal" for any purpose. Indeed, the analog voltage and/or current supplied to a ring oscillator are nothing like the "digital command word" in Sheets. For example, while any ring oscillator needs power to oscillate (*i.e.*, analog voltage/current), it does not have the ability to accept and process a "digital command word" – nor could it be "***required***" to do so.

Accordingly, Defendants respectfully ask the Court to deny HTC's Emergency Motion for Addendum to Jury Instructions. Rather, Defendants respectfully ask the Court to reaffirm its

original construction of "entire." If the Court deems it necessary, it might consider a clarification of the effect of its September 17, 2013 Order regarding the "entire" limitations.

Dated: September 18, 2013

Respectfully Submitted,

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