

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

HY-KO PRODUCTS COMPANY LLC,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 2:21-cv-00197-JRG
)	
THE HILLMAN GROUP, INC.,)	
)	
Defendant.)	

**DEFENDANT’S 4-2 PRELIMINARY CLAIM
CONSTRUCTIONS AND EXTRINSIC EVIDENCE**

Pursuant to Patent Rule 4-2 and the Court’s Docket Control Order (Dkt. No. 44), The Hillman Group, Inc. (“Hillman”) respectfully submit their Preliminary Proposed Claim Constructions and Extrinsic Evidence for the claim terms, phrases, or clauses contained in the asserted patents that the parties identified on November 17, 2021, for claim construction purposes pursuant to Patent Rule 4-1.

Hillman bases these constructions upon their current knowledge, understanding, and belief as to the facts and information available as of this date. Hillman reserves the right to further amend these preliminary proposed claim constructions as the parties proceed with discovery and work toward the preparation of a final Joint Claim Construction Statement. In particular, Hillman reserves the right to modify or supplement these P.R. 4-2 disclosures to facilitate agreement with Hy-Ko, to avoid duplication of terms or phrases, to reflect newly-received information, or in response to any changes in Hy-Ko’s P.R. 3-1 and P.R. 3-2 disclosures. To the extent necessary to clarify the issues for the Court or otherwise avoid ambiguity or confusion, Hillman reserves the right to address a word or phrase separately from

the terms listed below, including but not limited to if addressing that word or phrase separately will assist in the resolution of the parties' disputes.

Hillman also reserve their right to revise their proposals regarding claim terms in view of Hy-Ko's proposals and as discovery proceeds. Hillman specifically reserves the right to modify or supplement their preliminary proposed constructions once they have had an opportunity to review Hy-Ko's preliminary proposed constructions. Hillman further reserves the right to rely on extrinsic evidence identified by Hy-Ko and to add additional extrinsic evidence, particularly for constructions on which the parties disagree. Furthermore, Hillman reserves the right to update their citations to additional relevant extrinsic evidence, such as inventor testimony and testimony from attorneys responsible for prosecuting the asserted patents, as well as to identify additional dictionary definitions and prior art.

Hillman also reserves the right to amend these disclosures to the extent Hy-Ko supplements or amends its infringement contentions or claim construction disclosures. Hy-Ko has not served infringement contentions that comply with P.R. 3-1 and/or Paragraph 3 of the Court's Discovery Order (Dkt. No. 45) and has otherwise not provided sufficient notice as to its infringement theories in this case. Hillman is prejudiced in identifying the terms and constructions below in the absence of knowledge as to how Hy-Ko intends to assert its claim scope in this litigation. Hillman specifically reserve the right to modify the terms and proposed constructions identified herein within a reasonable time of Hy-Ko being permitted to serve any supplemental contentions.

Hillman contends that various claim limitations are indefinite. To the extent that Hillman provided proposed alternative claim constructions for these claim limitations and in the event that the claims are not found to be indefinite, such proposal is not an admission that these claims

are amenable to proper construction and/or satisfy the definiteness requirement of 35 U.S.C. § 112, which Hillman specifically denies. Moreover, nothing in these proposed terms should suggest that a particular limitation or claim is valid or construable, accurately described, enabled or definite within the meaning of 35 U.S.C. § 112.

To confirm the proper construction, in addition to the extrinsic evidence cited below, Hillman may rely on the patents and other references cited during the prosecution of the asserted patents. Hillman also may rely on one or more of the prior art systems and/or publications identified in their Invalidity Contentions to explain the state of the art and/or to show the ordinary meaning of certain claim terms. Furthermore, Hillman may rely on any public statement of Hy-Ko and/or its representatives (including statements made in prosecution of foreign counterparts to the asserted patents), or any current or former employee of Hy-Ko; any of the named inventors and/or prosecuting attorneys; and/or any information from other sources, including discovery produced in this case. Hillman may also rely on documents produced by Hy-Ko pursuant to Patent Local Rule 3-2 to the extent those documents evidence the ordinary meaning of claim terms and/or any different meaning assigned to claim terms by the inventors. Hillman may also rely on testimony from one or more of the inventors and/or the prosecuting attorney elicited in ongoing discovery in this case. Testimony from one or more of the inventors or the prosecuting attorney may be relevant to the meaning or indefiniteness of one or more of the contested claim terms.

As noted below, Hillman may also rely on testimony from one or more expert witnesses, including any identified by Hy-Ko. Such expert evidence may address the relevant field of art, the level of ordinary skill in the art, whether certain terms connote sufficient structure to perform the claimed functions, whether the patents' specifications disclose and clearly link sufficient

structure to perform the claimed functions, the definiteness of certain terms, and the meaning that certain claim terms would have to a person of ordinary skill in the art based on the asserted patents' disclosure and associated prosecution history, including any extrinsic evidence offered by Hy-Ko or Hillman. Hillman further notes that it does not cite references cited on the cover of the patents-in-suit in this P.R. 4-2 Statement, as such references are properly considered intrinsic evidence and are not required to be identified at this stage. *See V-Formation, Inc. v. Benetton Grp. SpA*, 401 F.3d 1307, 1311 (Fed. Cir. 2005).

Dated: November 24, 2021

Respectfully submitted,

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**ATTORNEYS FOR DEFENDANT THE
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was electronically served on counsel for the Plaintiff on November 24, 2021.

By: /s/ Kevin Schubert
Kevin Schubert

I. U.S. Patent No. 9,687,920

Term #	Claim Term	Claim(s)	Preliminary Construction	Preliminary Identification of Extrinsic Evidence
1	“key positioner configured to engage said master key”	1, 10, 19	Function: engage and position said master key Structure: finger engaging the side of the master key	<p>One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the '920 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the '920 Patent would have understood this claim term, including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.</p> <p>Phillips, Bill, Locksmithing, Second Edition, 2010, McGraw Hill, pages 365-397. (HILLMAN-000017754)</p> <p>Phillips, Bill, Master Locksmithing, 2008, McGraw Hill, pages 359-400. (HILLMAN-000017708)</p> <p>Hy-Ko's 11/22/2021 Interrogatory Responses, Ex. B, pages 2-3.</p>
2	“tip view”	10	view of the key into the tip towards the head	<p>One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the '920 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the '920 Patent would have understood this claim term, including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.</p> <p>Phillips, Bill, Locksmithing, Second Edition, 2010, McGraw Hill, page 394. (HILLMAN-000017754)</p> <p>Phillips, Bill, Master Locksmithing, 2008, McGraw Hill, page 397. (HILLMAN-000017708)</p>

Term #	Claim Term	Claim(s)	Preliminary Construction	Preliminary Identification of Extrinsic Evidence
				<p>Rathjen, Joseph E., Locksmithing From Apprentice to Master, TAB Books, 1995, pages 173-175. (HILLMAN-000017791)</p> <p>U.S. Patent No. 9,514,385 (HILLMAN-000017683)</p> <p>File History of U.S. Patent No. 9,514,385, including the 7/27/2016 NOA, 6/17/2016 Applicant Remarks and Claims, 12/17/2015 Final Rejection, 10/22/2015 Remarks and Claims. (HILLMAN-000016520)</p> <p>HY-KO00004915</p>
3	“substantially tip view”	10	Indefinite	<p>One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the ’920 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the ’920 Patent would have understood this claim term (including whether or not the term is or is not definite), including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.</p> <p>Any extrinsic evidence cited for “tip view.”</p>
4	“measure a thickness”	18	Indefinite	<p>One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the ’920 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the ’920 Patent would have understood this claim term (including whether or not the term is or is not definite), including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.</p> <p>Phillips, Bill, Locksmithing, Second Edition, 2010, McGraw Hill, pages</p>

Term #	Claim Term	Claim(s)	Preliminary Construction	Preliminary Identification of Extrinsic Evidence
				365-397. (HILLMAN-000017754) Phillips, Bill, Master Locksmithing, 2008, McGraw Hill, pages 359-400. (HILLMAN-000017708)
5	"the housing"	18	Indefinite	One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the '920 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the '920 Patent would have understood this claim term (including whether or not the term is or is not definite), including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.

II. U.S. Patent No. 9,656,332

Term #	Claim Term	Claim(s)	Preliminary Construction	Preliminary Identification of Extrinsic Evidence
6	“positioning said master key to a desired location to align the master key with an optical imaging device”	11	This step must occur after the “receiving step.”	One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the ’332 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the ’332 Patent would have understood this claim term, including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.
7	“selectively capturing a second image”	11	This step must occur after the “determining” step.	One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the ’332 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the ’332 Patent would have understood this claim term, including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.

III. U.S. Patent No. 10,421,133

Term #	Claim Term	Claim(s)	Preliminary Construction	Preliminary Identification of Extrinsic Evidence
8	“retention mechanism panel”	1, 24	slidable panel with a retention mechanism located on it	<p>One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the '133 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the '133 Patent would have understood this claim term, including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.</p> <p>Phillips, Bill, Locksmithing, Second Edition, 2010, McGraw Hill, pages 365-397. (HILLMAN-000017754)</p> <p>Phillips, Bill, Master Locksmithing, 2008, McGraw Hill, pages 359-400. (HILLMAN-000017708)</p>
9	“An integrated key duplication machine”	1	The preamble is limiting	<p>One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the '133 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the '133 Patent would have understood this claim term, including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.</p> <p>Any extrinsic evidence cited for the term “key blank identification system configured to operate individually from the key cutting system” below.</p>
10	“A plurality of key duplication	11	The preamble is limiting	<p>One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the '133 Patent, including the relevant state of the art, how a person of ordinary skill in</p>

Term #	Claim Term	Claim(s)	Preliminary Construction	Preliminary Identification of Extrinsic Evidence
	systems”			<p>the art as of the priority date of the ’133 Patent would have understood this claim term, including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.</p> <p>Any extrinsic evidence cited for the term “key blank identification system configured to operate individually from the key cutting system” below.</p>
11	“key blank identification system configured to operate individually from the key cutting system”	1, 11, 24	Indefinite	<p>One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the ’133 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the ’133 Patent would have understood this claim term (including whether or not the term is or is not definite), including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.</p> <p>TechTerms.com (definition of “integrated”), Nov. 21, 2014, available at https://techterms.com/definition/integrated. (HILLMAN-000017706)</p>

IV. U.S. Patent No. 9,682,432

Term #	Claim Term	Claim(s)	Preliminary Construction	Preliminary Identification of Extrinsic Evidence
12	“for communicating with a transponder on the key”	1, 13	for communicating with a transponder on the key in the key load position	One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the '432 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the '432 Patent would have understood this claim term, including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.
13	“for communicating with a transponder on the master key”	8, 20	for communicating with a transponder on the master key in the key load position [retention mechanism]	One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the '432 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the '432 Patent would have understood this claim term, including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.
14	“A method for identifying [and duplicating] a key”	1, 8, 13	The preamble is limiting	One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the '432 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the '432 Patent would have understood this claim term, including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.
15	“An identification system for duplicating	20	The preamble is limiting	One or more experts including Robert Almblad, George Heredia, and/or John Titus may testify regarding the technology of the '432 Patent, including the relevant state of the art, how a person of ordinary skill in the art as of the priority date of the '432 Patent would have understood

Term #	Claim Term	Claim(s)	Preliminary Construction	Preliminary Identification of Extrinsic Evidence
	keys”			this claim term, including in light of the specification and file history, and/or in rebuttal to arguments made by or on behalf of Hy-Ko regarding claim construction.