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

UNILOC 2017 LLC and UNILOC USA, INC.,	§	
	§	
Plaintiffs,	§	
	§	
v.	§	Civil Action No. 2:18-CV-00499-JRG-RSP
	§	
GOOGLE LLC,	§	
	§	
Defendant.	§	
	§	

DEFENDANT'S INITIAL INVALIDITY CONTENTIONS
AND P.R. 3-3 AND 3-4 DISCLOSURES

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I.   PRELIMINARY MATTERS

Pursuant to P.R. 3-3 and 3-4 and the Docket Control Order (ECF No. 40), Defendant Google LLC ("Google" or "Defendant") hereby discloses its P.R. 3-3 and 3-4 disclosures ("Invalidity Contentions") in view of Plaintiff Uniloc 2017 LLC's ("Uniloc") P.R. 3-1 Disclosure of Asserted Claims and Infringement Contentions ("Infringement Contentions"). Google contends that each of Uniloc's Asserted Claims (as defined below) is invalid under at least 35 U.S.C. §§ 101, 102, 103, and/or 112.

A.   Asserted Claims

U.S. Patent No. 8,194,632 (the "'632 Patent" or the "Asserted Patent") generally relates to a "method for establishing network connections between stationary terminals and remote devices through mobile devices." ('632 Patent at 1:1-4.)   Uniloc's Infringement Contentions allege infringement of claims 1, 8, and 15 of the Asserted Patent by Google (collectively, the "Asserted Claims").

B.   Uniloc's Infringement Contentions

Google bases these Invalidity Contentions on its current understanding of the Asserted Claims in view of Uniloc's Infringement Contentions, which are deficient in many respects. Specifically, Uniloc failed to meet its burden under at least P.R. 3-1 subparagraphs (c), (d), and (e).

First, Uniloc's single claim chart fails to identify where each element is found within each Accused Instrumentality, as required by P.R. 3.1(c). Uniloc fails to map any of the identified products to particular limitations in claim 1, because the documents on which Uniloc relies describe a method of communication between devices that does not follow the steps of the claimed method. For example, claim element 1b requires the stationary terminal (which Uniloc alleges is the Chromecast device) to transmit "an invitation message comprising a network address relating

to the stationary terminal and a remote device identifier to the proximate mobile device," but the Chromecast procedures Uniloc cites (Uniloc Exs. I and J) state that it is the mobile device—not the alleged stationary terminal—that sends the initial message. (*See* Uniloc Inf. Cont. Chart at 17-18.) And, Google cannot identify what Uniloc actually contends the "invitation message" is.

Similarly, claim element 1c requires that the mobile device provide the network address of the stationary terminal to the remote device, but Uniloc was unable to cite any support that Chromecast meets that limitation. Instead, Uniloc relies on nothing more than unsupportive and speculative "information and belief," to allege "the sender (or mobile device) should also provide information related to the Chromecast, e.g. IP address (or network address related to stationary terminal) to the remote server (or, remote device)." (Uniloc Inf. Cont. Chart at 27.)

Uniloc also failed to provide a separate chart identifying where it contends the additional element(s) of dependent claim 8 are found in the Accused Instrumentalities. Instead, it simply states without explanation "Refer to Claim 1Pre through 1c." (*See* Uniloc Inf. Cont. Chart at 32.) This means, for instance, that Uniloc has failed to identify what it contends the "remote mobile device" is.

Additionally, Uniloc relies upon "an exemplary test" allegedly conducted on Chromecast "to showcase the implementation and process flow of the cast functionality in the accused products," but fails to provide any details regarding the parameters of this test and does not attach a copy of the "testing document" referenced and excerpted from in its chart. (*See* Uniloc Inf. Cont. Chart at 8-10, 15-16, 19-26, Uniloc Exs. H, M.)

Second, Uniloc does not identify whether it claims each element is present literally or under the doctrine of equivalents in each Accused Instrumentality as required by P.R. 3-1(d). Instead, Uniloc makes the blanket assertion that "[a]ny claim element not literally present in the Accused

Instrumentalities as set forth in the claims charts is found in those Instrumentalities under the doctrine of equivalents because any differences between such claim element and the Accused Instrumentalities are insubstantial and/or the Accused Instrumentalities perform substantially the same function, in substantially the same way to achieve substantially the same result as the corresponding claim element(s)." (Uniloc Inf. Cont. at 3.) This boilerplate language does not meet the notice requirement of the local rules. *See Eolas Techs. Inc. v. Amazon.com, Inc.*, 2016 WL 7666160, at *3 (E.D. Tex. December 5, 2016) (striking DOE contentions as insufficient under P.R. 3-1(d) based on similar blanket statements).

Third, Uniloc asserts, under P.R. 3-1(e), that each of the Asserted Claims is entitled to a priority date "not later than at least one of the [following] referenced priority dates" (Uniloc Inf. Cont. at 3-4):

- November 28, 2005, based on the filing date of U.S. Application Serial No. 11/288,505;

- July 15, 2005, based on the filing date of U.S. Application Serial No. 11/182,927;

- March 28, 2005, based on the filing date of U.S. Application Serial No. 11/091,242;

- January 24, 2005, based on the filing date of U.S. Application Serial No. 11/042,620;

- September 7, 2004, based on the filing date of U.S. Application Serial No. 10/935,342; and

- April 5, 2004, based on the filing date of U.S. Application Serial No. 10/817,994.

Google does not concede that any of the Asserted Claims of the Asserted Patent are entitled to Uniloc's purported priority dates. It is, and remains, Uniloc's burden to establish the right to priority to any earlier applications. The Asserted Patent was filed on October 1, 2010 and purports to claim priority as a continuation of application No. 11/288,505, which claims priority as a continuation-in-part to five earlier-filed applications, including the earliest filed

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