

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION**

**Intellectual Ventures I LLC and
Intellectual Ventures II LLC,**

Plaintiffs,

v.

VMware, Inc.,

Defendant.

Civil Action No. 1:19-cv-01075-ADA

DEFENDANT'S PRELIMINARY INVALIDITY CONTENTIONS

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Pursuant to the Order Governing Proceedings (Dkt. No. 44), Defendant VMware, Inc. (“VMware” or “Defendant”) hereby provides its Preliminary Invalidity Contentions with respect to the claims identified by Plaintiffs Intellectual Ventures I LLC and Intellectual Ventures II LLC (“IV” or “Plaintiffs”) in their November 5, 2019, Disclosure of Infringement Contentions served in the above captioned matter (“Infringement Contentions”).

I. PRELIMINARY STATEMENT AND RESERVATION OF RIGHTS

A. The Asserted Claims

According to the Infringement Contentions, Plaintiffs assert the following patents, claims, and priority dates.

Asserted Patent	Asserted Claims	Asserted Priority Date
U.S. Patent No. RE 44,686 (“the ’686 patent”)	5-7	May 11, 2000
U.S. Patent No. RE 42,726 (“the ’726 patent”)	1-12	May 11, 2000
U.S. Patent No. 7,949,752 (“the ’752 patent”)	1-4, 6, 9-11, 13-14, 22-26	October 23, 1998
U.S. Patent No. RE: 43,051 (“the ’051 patent”)	1, 3-6	March 15, 2000
U.S. Patent No. RE: 44,818 (“the ’818 patent”)	1, 17, 30, 32-33, 37-42	December 7, 2007

The ’686 patent, the ’726 patent, the ’752 patent, the ’051 patent, and the ’818 patent are collectively referred to as the “Asserted Patents” and the claims listed in the table above are collectively referred to as the “Asserted Claims.” Any reference to an “asserted priority date” in these Preliminary Invalidity Contentions refers to the “Asserted Priority Dates” identified in the table above.

Defendant contends that each of the Asserted Claims is invalid under at least one or more of 35 U.S.C. §§ 101, 102, 103, 112, and/or 251. Pursuant to the Order Governing Proceedings, Defendant does not provide any contentions regarding claims not asserted by Plaintiffs. To the

extent that the Court permits Plaintiffs to assert additional claims against Defendant in the future, Defendant reserves all rights to amend or supplement these Preliminary Invalidity Contentions or to otherwise disclose new or supplemental invalidity contentions regarding such claims.

Furthermore, because discovery is ongoing, Defendant reserves the right to revise, amend, and/or supplement the information provided herein, including identifying, charting, and relying on additional references, should discovery yield additional information or references. Defendant reserves the right to amend these contentions in response to any claim construction rulings, as permitted by the Order Governing Proceedings (Dkt. No. 44) or with permission of the Court.

The Infringement Contentions are deficient in multiple respects and do not provide Defendant with sufficient information to understand the specific accused features and components and the alleged factual and evidentiary bases for Plaintiffs' infringement allegations. Among other things, the Infringement Contentions lack the specificity required to understand the scope of the claims, fail to properly identify accused instrumentalities, and fail to explain adequately Plaintiffs' infringement theories for numerous limitations. Plaintiffs have prejudiced Defendant's ability to understand, for purposes of preparing these Preliminary Invalidity Contentions, what Plaintiffs allege to be the scope of the Asserted Claims. If Plaintiffs modify any assertion or contention in its Infringement Contentions, or present any new assertion or contention relevant to these Preliminary Invalidity Contentions to the extent allowed by the Order Governing Proceedings (Dkt. No. 44) or the Court, Defendant reserves the right to supplement or otherwise amend these initial Invalidity Contentions.

B. Claim Construction

Because the Court has not yet construed any terms of the Asserted Claims, Defendant's Preliminary Invalidity Contentions are based on (1) Defendant's present understanding of the Asserted Claims, and (2) the claim constructions Plaintiffs appear to be proposing based on the Infringement Contentions. Defendant reserves the right to supplement or otherwise amend these Preliminary Invalidity Contentions in response to any proposed claim constructions or alleged supporting evidence offered by Plaintiffs, any report from any expert witness for Plaintiffs

regarding claim construction issues, any claim construction briefing filed by Plaintiffs, and any position taken by Plaintiffs concerning claim construction, infringement, or invalidity.

Defendant takes no position on any matter of claim construction in these Preliminary Invalidity Contentions. If Defendant's apparent claim constructions herein are consistent with any explicit, apparent, or implied claim constructions in the Infringement Contentions, no inference is intended and no inference should be drawn that Defendant agrees with any of Plaintiffs' claim constructions. Any statement herein describing or tending to describe any claim element is provided solely for the purpose of understanding and/or applying the cited prior art. Defendant expressly reserves the right (1) to propose any claim construction Defendant considers appropriate, (2) to contest any claim construction proposed by Plaintiffs that Defendant considers inappropriate or inaccurate, and/or (3) to take positions with respect to claim construction issues that are inconsistent with, or even contradictory to, claim construction positions expressed or implied in these Preliminary Invalidity Contentions.

Prior art not included in these Preliminary Invalidity Contentions, whether now known to Defendant or not, might become relevant depending on the claim constructions proposed by Plaintiffs, Defendant and/or the Court's claim construction rulings. Defendant reserves all rights to supplement or modify the positions and information in these Preliminary Invalidity Contentions, including without limitation the prior art and grounds of invalidity set forth herein, after the Court has construed the asserted claims.

C. Ongoing Discovery and Supplementation

Defendant's investigation, including its investigation of prior art and grounds for invalidity, is ongoing. Furthermore, Defendant's invalidity positions will be the subject of expert testimony. Defendant bases these Preliminary Invalidity Contentions on its current knowledge and understanding of the Asserted Claims, Plaintiffs' Infringement Contentions, the prior art, systems, and other facts and information available as of the date of these contentions. Defendant reserves the right to supplement these Preliminary Invalidity Contentions, including, without limitation, by adding additional prior art and grounds of invalidity in accordance with the Federal

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