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

UNILOC USA, INC., et al.,	§	
Plaintiffs,	§	
	§	Case No. 2:16-cv-00393-RWS
v.	§	LEAD CASE
	§	
AVG TECHNOLOGIES USA, INC.,	§	
BITDEFENDER LLC,	§	Case No. 2:16-cv-00394-RWS
PIRIFORM, INC.,	§	Case No. 2:16-cv-00396-RWS
UBISOFT, INC.,	§	Case No. 2:16-cv-00397-RWS
Defendants.		

UNILOC USA, INC., et al.,	§	
Plaintiffs,	§	
	§	Case No. 2:16-cv-00741-RWS
v.	§	LEAD CASE
	§	
ADP, LLC,	§	
BIG FISH GAMES, INC.,	§	Case No. 2:16-cv-00858-RWS
BLACKBOARD, INC.,	§	Case No. 2:16-cv-00859-RWS
BOX, INC.,	§	Case No. 2:16-cv-00860-RWS
ZENDESK, INC.,	§	Case No. 2:16-cv-00863-RWS
KASPERSKY LAB, INC.,	§	Case No. 2:16-cv-00871-RWS
SQUARE ENIX, INC.,	§	Case No. 2:16-cv-00872-RWS
Defendants.		

REPLY SUPPLEMENTAL CLAIM CONSTRUCTION BRIEF

Defendants have split into three groups. Kaspersky Lab now agrees with Uniloc, as it "proposes that the Court adopt Uniloc's constructions of the two terms." (Dkt.185, p.1, n.1).[1] Three defendants, Ubisoft, Square Enix, and Big Fish (the "Minority"), now propose an *entirely new* construction for "make the program available for use." (Dkt. 185, pp. 9-10). Their new construction contradicts the position of the other six (the "Majority"), because it does not require an application program (hereinafter, "application") be available "for download."

The Central Issue Is Whether the Inventors Disavowed the Full Scope of Their Claims

The central issue as to the two new terms, as well as several previously briefed, is whether a limitation, clearly expressed in specific language in the claims of the '466 patent ("providing an instance of the …application…to the client for execution"), should be read into claims of other patents that omit that language.[2] Previous briefing, (Dkt. 155, pp. 2-10), treats that issue, in depth.

To review, the parties agree that the claims of the '578 and '293 patents, given their ordinary and customary meaning, would cover portions of networks that execute applications on a server (as well as networks that execute applications on the client). (Dkt. 155, pp. 2-3). The language of a claim will usually be given its ordinary and customary meaning, with the only exception argued here being disavowal. (Dkt. 155, p. 3). Evidence of disavowal must be clear and unmistakable. (Dkt. 155, pp. 3-4).

I.   "Application launcher program"

All asserted claims of the '578 patent require an "application launcher program" (hereinafter, "launcher"). Language from the Summary of the Invention, and other language from the specification, describes the launcher as a program that "request[s] execution of the application program." (Dkt.174, pp.1-4).[3] Defendants seek to limit the launcher to programs that download

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[1] All docket cites are to 2:16-cv-00393-RWS.

[2] The applications on which the four patents are based were filed the same day, by IBM, using the same lawyers. Had the inventors intended to limit the scope of the '578 or '293 patents, they would have included in the claims of those patents language similar to the language in the '466 patent claims.

[3] In response to Uniloc's reliance upon the key statement in the Summary of the Invention that the launcher provides the "request to initiate execution of the application" ('578 patent 4:6-9), defendants argue Uniloc took the phrase "out-of-context" because "the *full passage* further specifies" the server responds by downloading the application to the client for execution. (Dkt. 185, p.4).Uniloc did not take that phrase out-of-context. The reference to downloading

the application. Defendants, however, have not presented clear and unmistakable evidence that the inventors disavowed the full scope of the claimed invention.

Defendants point out the only mention, in the '578 patent, of where execution might occur refers to downloading an application for execution at the client -- albeit in a description of an "alternative preferred embodiment," deep into the patent. ('578 patent 11:27-12:36). Because the specification does not otherwise mention location of execution, defendants argue the inventors disavowed a reading of the claims that would embrace more than that one embodiment.

But the Federal Circuit has "repeatedly held it is 'not enough that the only embodiments, or all of the embodiments, contain a particular limitation' to limit claims beyond their plain meaning." *Unwired Planet, LLC v. Apple Inc.*, 829 F.3d 1353, 1359 (Fed. Cir. 2016).[4]

That would especially apply here. All claims of the '578 patent pertain to methods of, and systems for, executing applications *through the use of administrator and user sets of configurable preferences*. Whether applications are executed at the server or at the client would be irrelevant to the claimed invention. Thus, the inventors did not mention location of execution in the claims; or in the SUMMARY OF THE INVENTION portion of the specification; or in the first five columns of the DETAILED DESCRIPTION OF PREFERRED EMBODIMENTS; nor do defendants offer any reason why they should have.

Defendants next attempt to rely upon references, in the specification of the '466 patent, (Dkt. 185, pp. 3-4), which "repeatedly" mention distributing applications to clients. But all claims of the '466 patent recite "providing an instance of the … application … to the client for execution," because that patent is directed to a different invention, which, unlike the invention of the '578 patent, incorporates that feature. Thus, references to that feature in the '466 patent would in no way disavow the full scope of claims of the '578 patent, none of which include that language.

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an application does not appear in the Summary of the Invention, but rather it appears *six columns* later in the patent ('578 patent 10:9-12), in a different section, and as an "alternative preferred embodiment."

[4] Other Federal Circuit cases have reached the same holding. *Akamai Technologies Inc. v. Limelight Networks, Inc.*, 805 F.3d 1368, 1375 (Fed. Cir. 2015); *Info-Hold, Inc. v. Applied Media Technologies Corp.*, 783 F.3d 1262, 1266-68 (Fed. Cir. 2015); *GE Lighting Solutions, LLC v. AgiLight, Inc.*, 750 F.3d 1304, 1308-10 (Fed.Cir. 2014); *Howmedica Osteonics Corp. v. Wright Medical Technology, Inc.*, 540 F.3d 1337, 1345 (Fed.Cir. 2008).

Further, as the '578 patent issued on a first office action, nothing in the '578 patent's prosecution history could disavow anything. Defendants thus attempt to rely upon the prosecution history of sibling applications, such as those for the '466 and '766 patents. Those prosecution histories can be considered, but only as extrinsic evidence,[5] as they were not part of the negotiation with the PTO to obtain the claims of the '578 patent. *C&C Jewelry MFG, Inc. v. West*, 2010 WL 2681921, *1 (N.D.Cal. 2010). As previously discussed, (Dkt. 155, pp. 7-9), no statements of the inventors in those prosecutions would clearly and unmistakably disavow the scope of any claims of the '578 patent.[6]

Uniloc's argument, in the Opening Supplemental Brief, that the defendants' construction would not cover a described embodiment that executes applications at the client (Dkt. 174, p.3), mistakenly cited from the wrong patent. The correct cite is the '578 patent at 11:39-41, 48-54.

II.   "Make the application program available for use"

Uniloc would give this term, from the '293 patent, its unrestricted meaning, which would encompass making the program available for execution at the server, as well making it available for download to the client. (Dkt. 174, p. 4).

The Majority's Construction

Defendants have conceded the ordinary and customary meaning of "application program" would include programs executed at the client. Similarly, the ordinary and customary meaning of "available for use" would include being available for execution at the server. The legal issue – as earlier briefed, (Dkt. 165, pp. 2-7) – thus reduces to whether the inventors clearly and unmistakably disavowed that scope.

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5 The claims of the '766 patent are drawn to requesting from a license management server a "license availability," and receiving from that server an indication of license availability. The claims do not mention, or relate to, where applications are executed, or to the invention of the '578 patent, which relates to executing applications through the use of administrator and user configurable preferences. Thus, even if during the prosecution of the '766 patent the inventors chose to limit the claims of that patent to avoid prior art relating to determining license availability, that would not clearly and unmistakably limit claims of different inventions in sibling patents.

6 *Aylus Networks, Inc. v. Apple Inc*., 856 F. 3d 1353, 1361-63 (Fed. Cir. 2017) (" to invoke the doctrine of prosecution disclaimer, any such statements must be both clear and unmistakable … [W]hen a prosecution argument is subject to more than one reasonable interpretation, it cannot rise to the level of a clear and unmistakable disclaimer.")

In its portion of the Supplemental Brief, the Majority argue, as they had earlier, that, because the combined '466/'293 specification describes executing an application at the client, it "defines" an "application program" as a program that *only* executes at a client, and thus disavows other embodiments. (Dkt. 185, pp. 7-8).

The Majority, however, ignore Uniloc's previous response: nowhere do the inventors state or imply an application executing at the server is not an "application." (Dkt. 155, p. 8). The inventors' statements – that the "invention" of the '466 patent requires execution at the client – arise from the language in the '466 patent claims explicitly imposing that requirement ("providing an instance of the … application … to the client for execution"), language that does not appear in the '578 or '293 patent claims.

Uniloc pointed out the '293 patent resulted from the PTO's issuing a restriction requirement. (Dkt. 174, p.6). The Majority respond with a muddled argument, (Dkt. 185, pp. 8-9), revealing it does not understand restriction requirements, [7] or why they are imposed. If the PTO determines two inventions in a single application are patentably distinct – and thus subject to restriction – the claims of one patent do not have to (and generally do not) embrace limitations contained in claims of the other.

The Majority argue that because the claims distribute the file packets to "on-demand" servers, those claims should be limited to systems where applications are executed at the client. (Dkt. 185, p. 7). Those servers, however, are described as "on-demand" because they respond only when a request (demand) is received from a user selecting an application for execution, not because of where the application would be executed. Depending upon the design of the system, the server would deliver the application to the user either by allowing the user to execute it at the server or by downloading it to the client (for execution). "Deliver" in the agreed construction of "on-demand

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[7] The Majority mistakenly refers to the '466 patent as the "parent" of the '293, (Dkt. 185, p. 7), and the defendants mistakenly refer to the'766 patent as a "continuation" of the '578 patent. (Dkt. 185, p. 5). When the PTO imposes a restriction requirement, the new application is a divisional, not a continuation. The applications are informally referred to as "siblings," not parent/child. The prosecution history of one sibling forms no part of the prosecution history of the other.

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