

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

UNILOC USA, INC., et al.,	§	
Plaintiffs,	§	
v.	§	Case No. 2:16-cv-00393-RWS
	§	LEAD CASE
	§	
AVG TECHNOLOGIES USA, INC.,	§	
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BITDEFENDER LLC,	§	Case No. 2:16-cv-00394-RWS
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UBISOFT, INC.,	§	Case No. 2:16-cv-00397-RWS
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KASPERSKY LAB, INC.,	§	Case No. 2:16-cv-00871-RWS
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SQUARE ENIX, INC.,	§	Case No. 2:16-cv-00872-RWS
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Defendants.		

UNILOC USA, INC., et al.,	§	
Plaintiffs,	§	
v.	§	Case No. 2:16-cv-00741-RWS
	§	LEAD CASE
	§	
ADP, LLC,	§	
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BIG FISH GAMES, INC.,	§	Case No. 2:16-cv-00858-RWS
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Defendants.		

**MOTION TO RECONSIDER A PORTION OF THIS COURT’S MEMORANDUM
OPINION AND ORDER CONSTRUING CERTAIN TERMS (DKT. 210)**

On September 22, Plaintiffs (“Uniloc”) filed its Opening Claim Construction Brief in *Uniloc USA, Inc. v. NetSuite, Inc.* (“*NetSuite*”), Case No. 2:16-cv-00863-RWS, Docket No. 117, in preparation for a claim construction hearing before this Court in that consolidated action on November 1, 2017. In that Brief (attached as Ex. A), Uniloc asks this Court to modify a portion of its construction from the Opinion and Order (“Opinion”), entered August 16, 2017, in the above-captioned *AVG*, Docket No. 210, and *ADP*, Docket No. 233, cases.

The reasons for the requested modification are set forth in that Brief, and are repeated, pretty much verbatim, in this Motion to Reconsider. Uniloc is filing this Motion, in the above-

captioned cases, to give the Defendants in these cases the opportunity to weigh in on the issue, and to assure that whatever decision the Court reaches applies to all cases.

Uniloc requests the Court to schedule this motion for oral hearing at the same date and time as the November 1 claim construction hearing in *NetSuite*.

In this Motion, Uniloc requests the Court to modify, in part, and only as to certain patents, the Court's claim construction of "application launcher program" and "application program."

In support of the request, Uniloc submits the accompanying declaration of Dr. Michael Shamos.¹

I. The Court should modify its construction of "application launcher program," but only as to the '578 patent.²

This Court construed "application launcher program" across all three patents in which it appeared – including the '578 patent – as "a program distributed to a client to initially populate a user desktop and *to request an instance of the application for execution at the client*" (emphasis added). Opinion at 27-31. Uniloc now asks the Court, with respect to claim 1 (and other claims) of the '578 patent,³ to modify the second half of that construction to read "to request execution of the application program."

To support that request, Uniloc highlights several factual statements and legal conclusions in the Opinion that need to be reconsidered, and sets forth the reasons for reconsideration.

¹ The accompanying declaration is identical to the Shamos declaration submitted in *NetSuite*. *NetSuite*, Docket No. 117-7.

² U.S. Patent 6,324,578.

³ Uniloc is not asking the Court to modify the construction with respect to the claims of the '466 patent or the '766 patent in which "application launcher" appears.

A. The Opinion erred in using the prosecution history of the '466 patent to construe claims of the '578 patent.

1. Under *Abbott Laboratories*, the prosecution history of the '466 patent cannot be used to interpret the claims of the '578 patent.

The Opinion (at 29-30) erroneously relies on statements in the prosecution history of the '466 patent to construe how this term is used in claim 1⁴ of the '578 patent. The Opinion overlooks that the separate applications for the '578 patent and the '466 patent were not continuations, divisionals, or continuations-in-part of each other. They were filed as independent, patentably distinct applications, on the same date. Further, the inventive entities differed: the '578 application included an inventor (Kaminsky) not an inventor on the '466 application; the '466 application, in turn, included inventors (McGarvey and Salahshour) not on the '578 application. Even though the applications were co-pending, shared some common inventors, and were commonly assigned, the prosecution history of one cannot limit the claims of the other.

Abbott Laboratories v. Dey, L.P., 287 F.3d 1097 (Fed. Cir. 2002) is squarely on point:

It is true that the '839 and '301 patents are commonly owned by Abbott, and the inventor of the '839 patent is one of the three inventors of the '301 patent. However, the '839 application was not filed as a continuation, continuation-in-part, or divisional application of the '301 application. These applications have no formal relationship and were presented to the patent office as patentably distinct inventions. ... Under these circumstances, we do not see a basis for concluding that statements made about the characteristics of the surfactant claimed by the '301 patent should be attributed to the improved surfactant claimed by the '839 patent, simply because the applications had a common assignee, one common inventor, and similar subject matter. We therefore conclude that the above-quoted statements from the prosecution history of the '301 patent do not create an estoppel with respect to the '839 patent.

⁴ In discussing the use of terms in the '578 patent, this brief will focus on claim 1, as representative, but Uniloc's arguments would be identical for the use of those terms in other claims of the '578 patent.

Id. at 1104-05 (emphasis added); *see also In re Berg*, 140 F.3d 1428, 1435 n. 7 (Fed. Cir. 1998) (noting, in the context of considering a double patenting rejection, that two applications filed by the same inventor were “not related as by continuation, continuation-in-part, or divisional” and that filing such two separate applications implied “that each application is independent and patentably distinct”).

The Opinion (at 11-14) justified reliance on the ’466 prosecution history by citing *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1306-07 (Fed. Cir. 2007) and *Microsoft Corp. v. Multi-tech Sys., Inc.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004). The Opinion, however, overlooked that the applications in those cases were formally related, as continuations, continuations-in-part, or divisionals, unlike the relationship between the ’578 application and the ’466 application. That is the critical distinction *Abbott Laboratories* highlights.

Additionally, in *Verizon* and *Microsoft*, the inventive entities were the same. Here, the inventive entities differ. The inventive entity of the ’466 application did not include Kaminsky and thus that entity would not have authority to surrender, on Kaminsky’s behalf, the scope of claims that Kaminsky, *et al.*, had obtained.

- B. The Opinion erred in using the prosecution history of the ’766 patent to construe the claims of the ’578 patent.**
 - 1. Under *Microsoft* and *Georgia-Pacific*, statements in the prosecution history of the ’766 patent do not affect construction of claims in the ’578 patent.**

The Opinion (at 29) erroneously relied on statements in the prosecution history of the ’766 patent to construe how this term is used in the ’578 patent. The error, however, is different from the one recited above. Because the application for the ’766 patent was a divisional of the application for the ’578 patent, *Abbott Laboratories* would not apply. Under the authority of

both *Microsoft* and *Verizon*, the prosecution history of the '766 patent *could* have relevance to construction of the '578 patent.

But there are two significant limitations, which prevent using those prosecution histories here to construe the '578 patent. In *Microsoft*, 357 F.3d at 1349 n. 7, the majority opinion distinguished statements in a prosecution history that “refer more specifically to the references cited against the claims of the [patent being prosecuted] only.” The majority limited the relevance of *those* statements to construction of the claims of the patent then being prosecuted, holding statements of that type could not be used to construe claims of *other* patents in the family. Thus, under *Microsoft*, statements in the prosecution history of the '766 patent that refer to references cited only against claims of the '766 patent cannot be cited to construe *other* patents, however related. The statements from the '766 prosecution history that the Opinion (at 29) refers to clearly fall in that category, as they are statements distinguishing prior art references (Duvvoori, Franklin, Christiano) cited against only the claims of the '766 patent.

The other significant limitation arises from *Georgia-Pacific Corp. v. United States Gypsum Co.*, 195 F.3d 1322, 1333 (Fed. Cir. 1999). As the majority opinion in *Microsoft*, 357 F.3d at 1350, itself acknowledges, the *Georgia-Pacific* case:

rejected the argument that the patentee was “bound by” statements made by the applicant in connection with a later application after the patent in suit had already issued. ... We rejected the argument that the patentee was bound, or estopped, by a statement made in connection with a later application on which the examiner of the first application could not have relied.

Here, the '578 patent issued on November 27, 2001. The examiner of the '578 patent thus could not have relied on any statements made after that date in the prosecution of the '766 patent, and there were no statements before that date. Although the application for the '766 patent was filed on April 10, 2001, as it turns out, there were no statements at all in that

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