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-00741-JRG
v.	§	LEAD CASE
	§	
ADP, LLC,	§	
BIG FISH GAMES, INC.,	§	Case No. 2:16-cv-00858-JRG

JOINT STATUS REPORT

Pursuant to the Court's Order of August 5, 2019, Dkt. No. 322, Plaintiffs, Uniloc USA, Inc., and Uniloc Luxembourg, S.A. (collectively, "Uniloc"), and Big Fish Games, Inc. ("Big Fish"),[1] hereby provide the following joint status report listing the issues remaining on remand and propose a schedule for resuming proceedings.

I. BACKGROUND

Pursuant to the Fourth Amended Docket Control Order of March 29, 2017, Dkt. No. 143, discovery closed on September 18, 2017, and the parties served disclosures for expert witnesses by the parties with the burden of proof on September 22, 2017. Shortly thereafter, on September 28, 2017, this Court's Memorandum Opinion and Order (Dkt. No. 267) ("§ 101 Order") dismissed the case, concluding that:

> Defendants have shown that claims 3–5, 8, 9, 13, 15–20, 22–24, 28–33, 35–37, 41 and 42 of the '466 Patent, claims 5, 7, 9, 11, 13, 15 and 17 of the '766 Patent, claims 1–8, 10–39 and 41–46 of the '578, and claims 1, 12 and 17 of the '293 Patent are drawn to ineligible subject matter and, therefore, invalid. Accordingly, the Motion to Dismiss (Docket No. 17) is GRANTED as to those claims. The Motion is DENIED as to any unasserted patent claims. The Motion is DENIED AS MOOT as to Defendants' motion to dismiss the claims for infringement of the '293 Patent for failure to plead sufficient factual allegations.

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[1]   All other defendants have been dismissed from the cases that had been related. However, the co-pending case against Kaspersky Lab, Inc., 2:16-cv-00871-RWS (E.D. Tex.), has also been remanded.

Dkt. No. 267 at 25.

On May 24, 2019, the Federal Circuit reversed this Court's dismissal as to the '293 and '578 patents, and affirmed the dismissal as to the '466 and '766 patents. *See* Dkt. No. 317. Big Fish (along with Kaspersky Lab, Inc., a defendant in a parallel case) petitioned for panel rehearing. That petition was denied, *see* Dkt. No. 320, and the mandate issued on July 18, 2019, *see* Dkt. No. 321.

II.   REMAINING ASSERTED CLAIMS

Shortly before the Court's § 101 Order, Uniloc made its final election of asserted claims. Following the Federal Circuit's opinion, on remand the following asserted claims remain: claims 1, 8, 17, 27, and 30 of the '578 patent, and claims 1, 12, and 17 of the '293 patent.

III.   REMAINING ISSUES

A.   Reopening Discovery

As noted above, discovery closed just prior to the Court's order dismissing the case.

1.   Uniloc's Position

Although discovery did close in this case, that was nearly two years ago. An unknown amount of additional infringement has occurred since. Further, Big Fish may have changed its systems in the interim. And, as will be discussed below, there were live discovery disputes. As such, Uniloc proposes to briefly reopen discovery. The parties would be required to promptly produce any new materials that would otherwise be required pursuant to the Court's Patent Local Rules, and to provide one or more witnesses for deposition as appropriate.

2.   Big Fish's Position

Prior to the Court's § 101 Order, the parties had completed fact discovery on September 18, 2017, and served opening expert reports on September 22, 2017. Both parties had an

opportunity to fully develop the factual record prior to the close of fact discovery. Accordingly, Uniloc's request to reopen discovery without limitation should be denied.

Fully reopening the discovery period is unwarranted and unnecessary at this late procedural juncture in the case. While Big Fish preserved certain fact discovery issues by filing motions to compel specific categories of documents and proper answers to specific interrogatories prior to the fact discovery deadline, Uniloc had not filed any discovery motions. Instead, only after the fact discovery deadline, Uniloc served alleged "final infringement contentions" and sought production of damages-related documents. Uniloc's proposal to reopen fact discovery is therefore an attempt to rectify its discovery errors and backfill the gaps in its factual infringement and damages theories.

However, to the extent that Uniloc is concerned about fact issues that may have come about in the intervening period *after* the Court's § 101 Order and the Federal Circuit remand, Big Fish agrees a limited discovery scope and period is appropriate. Big Fish therefore proposes a two-month period during which the parties serve amended Rule 26(a) and (e) disclosures and serve amended interrogatory responses and/or amended requests for admission responses, as necessary, and depose any newly disclosed witnesses, provided that this discovery is limited solely to matters that need to be supplemented due to changes in law or fact that occurred *after* the Court's § 101 Order. In no event should the parties be permitted to serve any other disclosures or submit discovery requests unrelated to changes in law or fact that occurred *after* the Court's § 101 Order.

B.   Adding Uniloc 2017 LLC as a Plaintiff

The Uniloc entities entered into a series of transactions in mid-2018, which transactions ultimately resulted in the patents being reassigned to a new, related entity, Uniloc 2017 LLC.

1.   Uniloc's Position

The Federal Circuit has added Uniloc 2017 to this action, over Big Fish's objection. *See* Dkt. No. 317 at 3-6. Uniloc will request the Court to amend the district court caption to reflect the Federal Circuit's ruling.

2.   Big Fish's Position

Big Fish does not oppose Uniloc's request to add Uniloc 2017 as a party, provided that Uniloc, within 14 days of a Court order granting Uniloc's requested relief, produce all documents and agreements between or among the existing plaintiffs and Uniloc 2017, all documents related to standing, and all documents evidencing the "series of transactions" that Uniloc referenced above. Further, Big Fish requests that Uniloc amend its discovery responses, if necessary, to account for the inclusion of Uniloc 2017 within the same 14-day period. As the record before the Federal Circuit makes clear, Uniloc 2017 received an interest in the patents as of May 2018, but took no action to inform the Court, the Federal Circuit, or Big Fish. Accordingly, Uniloc should not be permitted to delay production of these documents, which are necessary to understand the relationship between the plaintiffs and assess the need for deposition discovery of Uniloc 2017, by forcing Big Fish to make written requests to which Uniloc may interpose objections.

C.   Uniloc's Motion to Reconsider a Portion of this Court's Memorandum Opinion and Order Construing Certain Terms

On September 27, 2017, Uniloc filed a motion for reconsideration of the Court's Opinion and Order regarding claim construction. Dkt. No. 266. The motion was denied as moot the next day. Dkt. No. 267.

1.   Uniloc's Position

Uniloc will resubmit the previously filed motion, with two modifications: 1) deletion of any requests as to the '466 or '766 patents, as those patents are no longer in the case; and 2) update as to developments in the law since its filing.

Big Fish asks the motion be bifurcated, with the motion to "address" procedural issues and then to "address" the merits. The Court may, of course, address the issues in any order it chooses, but the motion itself will brief the merits, to assure a complete record. Big Fish can raise any procedural objections in its opposition, and then Uniloc will respond to those in its reply.

After the Federal Circuit's decision, Uniloc 2017 refiled a number of actions on the '578 and '293 patents. There are now actions against 16 other defendants pending on those patents, with 13 of them in other districts before 9 different judges.[2] Uniloc 2017 expects those courts will benefit from this Court's decision on the merits of the motion for reconsideration.

2.   Big Fish's Position

As Uniloc notes, Uniloc filed its motion for reconsideration the day before the Court's § 101 Order, and, therefore, Big Fish has not filed its response in opposition. Nevertheless, Uniloc's motion for reconsideration was, at the time it was originally filed, untimely. Nothing about the intervening delay in this case due to Uniloc's appeal changes the untimeliness of its motion. Instead, Uniloc seeks to undo one of the Court's constructions in order to obtain a more advantageous position regarding its infringement contentions in the later-filed cases, which Uniloc expressly mentions above. In fact, Uniloc has asserted the same claim construction position it now seeks from this Court in one of the later-filed cases. *See* Dkt. No. 233 (discussing Uniloc's claim construction briefing in *Uniloc USA, Inc. v. NetSuite, Inc.*, Case No. 2:16-cv-00862-RWS). Thus, Uniloc's motion is not intended to aid the courts in the later-filed cases, but is meant to avoid having those courts reject Uniloc's new position as inconsistent with the positions it took before this Court in this case.

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[2]   There are also five actions, Nos. 2-19-cv-00219, -220, -221, -223 and -224, in this District, currently assigned to Judge Gilstrap.

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