

1 Aaron S. Jacobs (Cal. Bar No. 214953)  
ajacobs@princelobel.com  
2 James J. Foster  
jfoster@princelobel.com  
3 PRINCE LOBEL TYE LLP  
One International Place, Suite 3700  
4 Boston, MA 02110  
Tel: (617) 456-8000

5  
6 Matthew D. Vella (Cal. State Bar No.  
314548)  
mvella@princelobel.com  
7 PRINCE LOBEL TYE LLP  
357 S. Coast Highway, Suite 200  
8 Laguna Beach, CA 92651  
Tel: (949) 232-6375  
9

ETHERIDGE LAW GROUP, PLLC  
James L. Etheridge (SBN 158629)  
Jim@Etheridgelaw.com  
2600 East Southlake Blvd Suite 120-324  
Southlake, TX 76092  
(817) 470-7249 - Telephone  
(817) 887-5950 – Facsimile

Attorneys for Uniloc 2017 LLC

For Defendants’ counsel, please see  
signature block

10  
11 UNITED STATES DISTRICT COURT  
12 CENTRAL DISTRICT OF CALIFORNIA  
13 SANTA ANA DIVISION

14 UNILOC 2017 LLC,  
15 Plaintiff,  
16 v.  
17 INFOR, INC.,  
NETSUITE, INC.,  
18 SQUARE ENIX, INC., and  
SQUARE ENIX LLC,  
19 SQUARE ENIX CO., LTD. and  
20 SQUARE ENIX HOLDINGS CO.,  
LTD.  
21 UBISOFT, INC.,  
22 Defendants.

Case No. 8:19-cv-01150-DOC-KES

**JOINT 26(f) REPORT**

Hearing: December 7, 2020  
Judge: David O. Carter

23 Pursuant to Federal Rules of Civil Procedure 26 and 34, the parties file this  
24 Joint Rule 26(f) Report, per the Court’s Order, Dkt. No. 53.

25 **I. STATEMENT OF THE CASE**

26 These actions have been consolidated and this Report is being submitted in all  
27 the actions. The Infor action has been stayed pending completion of settlement  
28

1 papers, and thus the below does not pertain to that action. Otherwise, the discussion  
2 below will apply to all cases, except where noted.

### 3 **Uniloc 2017's Position**

4 These are patent infringement actions. Uniloc 2017 accuses each defendant of  
5 infringing United States Patent Nos. 6,344,578 and 7,069,293. Each defendant  
6 denies infringement and alleges the patents are invalid.

7 Uniloc 2017 first brought suit on the patents-in-suit against Ubisoft, NetSuite,  
8 and Square Enix in July/August 2016. In the normal course, those actions would  
9 have gone to judgment well before now. But they were waylaid: first, by venue  
10 issues raised by *TC Heartland LLC v. Kraft Foods Grp. Brands LLC*, 137 S.Ct. 1514  
11 (2017), and secondly, by a district court decision, since reversed, that certain patent  
12 claims were ineligible for patenting. *Uniloc USA, Inc. v. ADP LLC*, 279 F.Supp. 736  
13 (E.D. Tex. 2007).

14 Each of those Accused Infringers has thus now been aware of the patents for  
15 at least four years, as well as aware of the extent and theory of the infringement  
16 allegations against them. And each would have long since formulated its defenses.  
17 So Uniloc 2017 believes it appropriate to move those actions forward expeditiously.

18 Uniloc 2017 thus suggests dispensing with some of the preliminary steps that  
19 might be appropriate to first-filed patent actions, such as formal infringement and  
20 invalidity contentions.

21 Netsuite and Ubisoft have each filed a summary judgment motion (which each  
22 labeled as a motion to dismiss to evade this Court's rule limiting each party to one  
23 summary judgment motion) raising an issue unique to the respective defendant.  
24 Uniloc 2017 has already filed its Opposition, Dkt. No. 62, to the Netsuite motion  
25 (which motion had asked the Court to adopt a contested claim construction and enter  
26 judgment thereon) and will file its opposition to the just received Ubisoft motion,  
27  
28

1 Dkt. No. 67-1, (which motion appears to argue claim preclusion) after Uniloc 2017  
2 has had time to digest it.

3 Netsuite also states it intends to file an additional motion that will claim it is a  
4 “strategic business partner” of the former patent owner, IBM, but Uniloc 2017  
5 cannot comment on that motion until it is filed.

6

### 7 **Defendants’ Position**

8 This is a patent infringement case. Uniloc 2017 LLC and/or its predecessor  
9 entities (“Uniloc”) have asserted these patents (U.S. Patent Nos. 6,324,578 and  
10 7,069,293, the “Asserted Patents”) approximately 50 prior times, resulting in  
11 multiple rulings from other courts that are relevant to this case. Specifically, two  
12 District Court Judges – Judge Schroeder in the Eastern District of Texas, and Judge  
13 Stearns in the District of Massachusetts, have already construed certain terms of the  
14 asserted patents. Certain claims of the ’578 Patent (20, 22, 23, 24, 35, 37, 39) have  
15 already been held to be invalid as indefinite through these claim construction  
16 proceedings. Other cases on the same two patents remain pending in other district  
17 courts. The ’578 Patent expired nearly two years ago, on December 14, 2018. The  
18 ’293 Patent expires in just two months, on February 3, 2021.

19 Uniloc acquired the asserted patents from IBM pursuant to an agreement  
20 whereby IBM reserved the right to license certain of its “Strategic Business  
21 Partners,” contractually defined by a monetary threshold amount of business  
22 between certain dates. Uniloc is obligated under the IBM agreement to defend and  
23 indemnify any such strategic business partners. Other defendants in other cases have  
24 already been dismissed as a result of this licensing agreement. Defendant NetSuite  
25 believes that it is also such a strategic business partner of IBM, that, as a result,  
26 Uniloc lacks statutory authority to bring this suit solely in its own name against  
27 NetSuite, and that it is obligated to defend and indemnify NetSuite for this case. In

28

1 addition, Uniloc's infringement allegations against Defendant Ubisoft, Inc. directly  
2 implicate technology provided by an adjudicated IBM Strategic Partner and non-  
3 infringer, Akamai.

4  
5 **II. LEGAL ISSUES**

6 *Uniloc 2017's position:*

7 The key legal issues will include infringement, validity, and damages.

8 *Defendants' position:*

9 Defendants believe the key legal issues include:

- 10 1. Whether Defendants have infringed the Asserted Patents in violation of 35  
11 U.S.C. § 271;
- 12 2. Whether Uniloc has a good faith basis to allege that Defendants possessed the  
13 knowledge and intent to infringe required for an allegation of indirect  
14 infringement of the Asserted Patents after they were found to be invalid and  
15 during the pendency of the appeal of that invalidation to the Federal Circuit;
- 16 3. Whether the Asserted Patents meet the conditions for patentability and satisfy  
17 all of the requirements set forth in the provisions of 35 U.S.C. §§ 101, 102,  
18 103, and/or 112;
- 19 4. Whether Uniloc has standing and/or statutory authority to assert the Asserted  
20 Patents solely in its own name;
- 21 5. Whether the Asserted Patents are enforceable;
- 22 6. Whether Uniloc is barred or estopped, either now or at a later time, in view of  
23 other litigation history on the Asserted Patents;
- 24 7. The amount of damages, if any, under 35 U.S.C. § 284;
- 25 8. Whether Uniloc's alleged damages are limited under 35 U.S.C. § 287;
- 26 9. Whether Uniloc is obligated to defend and/or indemnify NetSuite in  
27 connection with this litigation and if so, the amount thereof;
- 28

1 10. Whether attorneys' fees, costs, or expenses are recoverable under 35 U.S.C. §  
2 284 and/or § 285; and

3 11. In the event that the Asserted Patents are found not infringed, unenforceable,  
4 subject to a licensing obligation or right, and/or invalid, the relief, if any, to be  
5 awarded to Defendants.

6 Defendants reserve the right to revise or supplement this list as the case progresses.  
7

### 8 **III. DAMAGES**

9 *Uniloc 2017's position:*

10 Uniloc 2017 seeks damages in the nature of a reasonable royalty for infringing  
11 use. As there has been no discovery as yet as to the extent of use of the accused  
12 products, the parties cannot presently give a realistic range of provable damages.

13 *Defendants' position:* Defendants do not believe that Uniloc is entitled to  
14 damages. NetSuite contends that Uniloc is obligated to defend and indemnify  
15 NetSuite for its defense of litigation brought against it under patents acquired from  
16 IBM under the aforementioned agreement. Should Uniloc proceed with litigation  
17 against Ubisoft accusing the technology of Akamai, an adjudicated IBM Strategic  
18 Partner and non-infringer, Ubisoft would contend the same.  
19

### 20 **IV. INSURANCE**

21 None of the parties have insurance coverage.

### 22 **V. MOTIONS**

23 *Uniloc 2017's position:*

24 Uniloc 2017 does not contemplate motions to add parties or claims, or to file  
25 amended pleadings.

26 *Defendants' position:*  
27  
28

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.