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13  
14 **UNITED STATES DISTRICT COURT**  
15 **CENTRAL DISTRICT OF CALIFORNIA**  
**SOUTHERN DIVISION**

16 UNILOC 2017 LLC,  
17 Plaintiff,  
18 v.  
19 INFOR, Inc.,  
20 Defendant.

21 \_\_\_\_\_  
22 UBISOFT, INC.  
23 Plaintiff,  
24 v.  
25 UNILOC 2017, LLC,  
26 Defendant.  
27 \_\_\_\_\_  
28

CASE NO. 8:19-cv-01150-DOC-KES  
(CONSOLIDATED)

**UBISOFT'S REPLY IN SUPPORT OF  
UBISOFT'S MOTION FOR  
JUDGMENT ON THE PLEADINGS  
AS TO UNILOC'S  
COUNTERCLAIMS OF  
INFRINGEMENT**

Judge: Hon. David O. Carter  
Date Filed: November 23, 2020  
Hearing Date: December 21, 2020  
Time: 8:30 AM  
Location: Ronald Reagan Federal  
Building, Courtroom 9D

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**TABLE OF AUTHORITIES**

**Cases**

*Adaptix, Inc. v. Amazon.com, Inc.*, No. 5:14-cv-01379-PSG, 2015 WL 4999944  
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*Brain Life, LLC v. Elekta Inc.*, 746 F.3d 1045 (Fed. Cir. 2014).....3

*D-Beam v. Roller Derby Skate Corp.*, 316 F. App’x 966 (Fed. Cir. 2008) .....2

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*In re PersonalWeb Techs., LLC*, No. 18-md-02834-BLF, 2019 WL 1455332  
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*MGA, Inc. v. Gen. Motors Corp.*, 827 F.2d 729 (Fed. Cir. 1987) .....2

*Shaw v. Hahn*, 56 F.3d 1128 (9th Cir. 1995).....3

*SpeedTrack, Inc. v. Office Depot, Inc.*, 791 F.3d 1317 (Fed. Cir. 2015).....4

1           The core facts are undisputed. Uniloc repeatedly sued Akamai for infringement  
2 of the same two patents that are at issue in this case and lost. The dismissal of Uniloc’s  
3 claim against Akamai was with prejudice, an “adjudication on the merits.” Uniloc did  
4 not appeal. And now, Uniloc is suing Akamai’s customer, Ubisoft, for infringement of  
5 the *same* patents based on its use of the *same* Akamai technology at issue in the Akamai  
6 case. This is barred by the doctrine of preclusion and the *Kessler* doctrine—the final  
7 adjudication on the merits against Akamai itself bars Uniloc from pursuing Akamai’s  
8 customers (such as Ubisoft) for alleged infringement based on their use of the same  
9 Akamai technology at issue in the Akamai litigation. The Federal Circuit’s decision in  
10 *PersonalWeb* on nearly identical facts confirms that the dismissal with prejudice  
11 conferred upon Akamai the right to continue producing, using, and selling its CDN  
12 services without further harassment from Uniloc, “either directly *or through suits*  
13 *against [Akamai’s] customers* for using that product.” *In re PersonalWeb Techs. LLC*,  
14 961 F.3d 1365, 1379 (Fed. Cir. 2020).

15           None of Uniloc’s attempts to end-run the Akamai ruling aid its cause. Although  
16 Uniloc dusts off the Restatement to suggest that the Akamai ruling might not completely  
17 bar its case here, the Federal Circuit’s *PersonalWeb* decision holds otherwise. Uniloc’s  
18 assertion that Ubisoft and Akamai may not be in privity, when it is undisputed that  
19 Ubisoft is Akamai’s customer with respect to the allegedly-infringing technology,  
20 strains credibility. And when all of that fails, Uniloc suggests—without any showing of  
21 good faith analysis—that *maybe* Ubisoft uses a CDN other than Akamai (it does not),  
22 and *maybe* that other CDN could be at issue in the case (it should not). By this point,  
23 Uniloc should know its infringement theory, and should have investigated whatever  
24 technology it is accusing. And the only CDN that Uniloc has accused of infringement in  
25 this case is the one provided by Akamai, which has already been adjudicated to be non-  
26 infringing. This case should be dismissed with prejudice.

27  
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1           **I.     ARGUMENT**

2           Uniloc’s infringement claim against Ubisoft accuses Ubisoft’s use of Akamai’s  
3 Content Delivery Network (“CDN”) of infringement. Uniloc accuses Ubisoft of  
4 infringing certain claims of the ’578 and ’293 Patents. Dkt. 29 (Uniloc’s Counterclaims,  
5 Consolidated Case No. 8:19-cv-1062). More particularly, Uniloc’s counterclaims allege  
6 infringement because “Ubisoft distributes software” (Dkt. 29, ¶ 8 regarding the ’578  
7 Patent) and Ubisoft “uses on-demand servers” (Dkt. 29, ¶ 21 regarding the ’293 Patent),  
8 and Uniloc contends that the server that performs the accused distribution of software is  
9 the Akamai Content Distribution Network (“CDN”):

10           

As shown in the below screenshot, Ubisoft uses at least Akamai’s CDN to distribute application programs from a centralized  
11 network management server to target on-demand servers.

12 Dkt. 67-3 (Uniloc’s Infringement Contentions, p. 1-2). In short, Ubisoft’s use of  
13 Akamai’s CDN is squarely alleged of infringement in this case with respect to both  
14 Asserted Patents.

15           Uniloc has already sued Akamai for infringement of the ’578 and ’293 Patents  
16 and is barred from pursuing yet another infringement lawsuit against Akamai’s  
17 customer, Ubisoft. The District of Massachusetts dismissed Uniloc’s prior case against  
18 Akamai with prejudice, over Uniloc’s objection, and made clear that it operated as an  
19 “adjudication on the merits.” Dkt. 67-9. As explained in the dismissal, Uniloc is “barred  
20 from asserting infringement claims against Akamai.” *Id.* A dismissal with prejudice is  
21 “considered a judgment on the merits,” and “a final judgment on the merits precludes  
22 the parties or their privies from relitigating claims that were or could have been raised  
23 in that action.” *D-Beam v. Roller Derby Skate Corp.*, 316 F. App’x 966, 968-969 (Fed.  
24 Cir. 2008). Further, the *Kessler* doctrine “bars a patent infringement action against a  
25 customer of a seller who has previously prevailed against the patentee. . .” *MGA, Inc. v.*  
26 *Gen. Motors Corp.*, 827 F.2d 729, 734 (Fed. Cir. 1987).

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