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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SANTA ANA DIVISION

UNILOC 2017 LLC,

Plaintiff,

v.

NETSUITE INC.,

Defendant.

Case No. 8:19-cv-01151-DOC(KESx)

**DEFENDANT’S AMENDED 26(f)
REPORT**

Hearing: December 4, 2019, 3 p.m.
Judge: David O. Carter

1 Pursuant to Federal Rules of Civil Procedure 26 and 34, Defendant NetSuite
2 Inc. (“NetSuite”) files this Amended Rule 26(f) Report. The parties previously filed
3 a Joint Rule 26(f) report on October 18, 2019. D.I. 29. The Court subsequently
4 transferred this case pursuant General Order 19-03, vacated the prior scheduling
5 conference before Judge Staton, and set a new scheduling conference for December
6 4, 2019. D.I. 35, 37. The parties in several related cases pending before the Court
7 have been ordered to attend this same conference. *See* 8:19-cv-1150-DOC(KESx),
8 *Uniloc 2017 LLC v. Infor, Inc.*, D.I. 39 (Nov. 6, 2019); 8:19-cv-1061-DOC(KESx),
9 *Square Enix, Inc. et al. v. Uniloc 2017 LLC*, D.I. 36 (Oct. 28, 2019); 8:19-cv-1062-
10 DOC(KESx), *Ubisoft, Inc. v. Uniloc 2017 LLC*, D.I. 45 (Nov. 6, 2019).
11 Accordingly, NetSuite believes it would be helpful for the Court to have NetSuite’s
12 updated positions on the Rule 26(f) issues, including proposed dates, many of which
13 (including the date for serving infringement contentions) are affected by the revised
14 scheduling conference date. For example, Uniloc previously proposed serving
15 infringement contentions on November 15 (D.I. 29-1), but let that date come and go,
16 presumably because of the transfer and new scheduling conference date.

17 NetSuite coordinated a uniform schedule (attached as Exhibit A) with the
18 other related Defendants and Declaratory Judgment Plaintiffs and understands that
19 they are proposing the same schedule as NetSuite. However, Uniloc declined to
20 participate in this amended 26(f) report, indicating that it did not believe it was
21 necessary to submit a revised proposal by November 20, or to coordinate a schedule
22 between the different cases that are set for conference on December 4.

23 **(1) NetSuite’s Statement of the case:**

24 As detailed in NetSuite’s pending motion to dismiss Uniloc’s first Amended
25 Complaint, the litigation history on the asserted patents is highly-relevant to this
26 matter. *See* D.I. 27.

27

28

1 Judge Schroeder in the Eastern District of Texas issued a *Markman* order in
2 *Uniloc USA, Inc. et al. v. ADP, LLC*, 16-cv-00741-RWS (E.D. Tex.) (“ADP cases”)¹
3 construing numerous claim terms of the ’293 and ’578 patents (the “*Markman*
4 Order”). That *Markman* Order continues to govern in those ongoing cases.

5 NetSuite believes that it does not infringe either of the Patents-in-Suit, under
6 Judge Schroeder’s *Markman* Order—in particular the construction of the term
7 “application program(s)”—or otherwise, and that, in view of Judge Schroeder’s prior
8 work, this Court’s adoption of Judge Schroeder’s construction of “application
9 program(s)” in the context of NetSuite’s motion to dismiss will be case-dispositive
10 for NetSuite.

11 NetSuite believes that, given Judge Schroeder’s ruling, which turns entirely on
12 a question of law, the Court need not conduct full claim construction proceedings.
13 However, to the extent that the Court believes further claim construction briefing is
14 necessary with respect to the term “application program(s),” NetSuite proposes that
15 the Court address the issue early in the case, prior to addressing other claim
16 construction issues and before the parties or Court take time with potentially
17 unnecessary discovery issues. Given the prior litigation history, NetSuite contends
18 that the Court should stay discovery until the construction of “application
19 program(s)” is resolved. D.I. 30.

20 NetSuite also contends that the claims are invalid under 35 U.S.C. §§ 101,
21 102, 103, and/or 112, particularly when read as broadly as Uniloc implies in its first
22 Amended Complaint and when ignoring the Federal Circuit’s guidance about claim
23 scope (as Uniloc has done in the first Amended Complaint). NetSuite also contends
24 that the asserted claims of the asserted patents are unenforceable, that Uniloc lacks
25 standing, and that it has failed to mark or give pre-suit notice, limiting relief under

26 _____
27 ¹ This case was consolidated for discovery purposes with 16-cv-00744-
28 JRG; 16-cv-00858; 16-cv-00859; 16-00860; and 16-cv-00863, all in the

1 35 U.S.C. § 287(a). NetSuite further contends that this case is exceptional and that
2 NetSuite is entitled to reasonable attorneys’ fees, expenses, and costs incurred in this
3 actions pursuant 35 U.S.C. § 285.

4 **(2) Principal issues:**

5 Subject to and without waiving its positions and arguments, NetSuite asserts
6 that some of the disputed issues include, but are not limited to, the following:

- 7 • Construction of the asserted claims;
- 8 • Whether NetSuite has infringed and/or is directly infringing the
9 Patents-in-Suit;
- 10 • Whether the Patents-in-Suit are invalid under 35 U.S.C. §§
11 101, 102, 103, and/or 112;
- 12 • Whether the Patents-In-Suit are unenforceable;
- 13 • Whether Uniloc has standing to assert the Patents-in-Suit;
- 14 • Whether Uniloc is collaterally estopped, either now or at a later
15 time, in view of other litigation history on the Patents-in-Suit
- 16 • Whether Uniloc has complied with 35 U.S.C. § 287 and
17 whether Uniloc’s alleged damages are limited under the same;
- 18 • The amount of damages, if any, under 35 U.S.C. § 284;
- 19 • Whether this case is exceptional and, if so, the amount of
20 damages to which Plaintiff or Defendant is entitled.

21 NetSuite reserves the right to revise or supplement this list as the case progresses.

22 **(3) Motions to Amend, Joining Parties:** NetSuite does not contemplate

23 motions to add parties or claims, to file amended pleadings, to dismiss for lack of
24 jurisdiction, or to transfer venue.

25 **(4) Dispositive motions:**

26 NetSuite has filed a motion to dismiss Uniloc’s First Amended Complaint and
27 a motion to stay discovery pending resolution of the term “application program(s).”

28 See D.I. 27; D.I. 29. NetSuite anticipates filing a motion for summary judgment

1 after claim construction proceedings, if necessary. NetSuite does not anticipate any
2 other motions at this stage.

3 **(5) Settlement efforts:**

4 NetSuite believes that ADR Procedure No. 2 is best suited for the case, but
5 requests that the mediation be held after construction of the term “application
6 program(s).” NetSuite believes that early determination of the construction of the
7 term “application program(s)” will be useful for settlement purposes.

8 **(6) Discovery plan:**

9 NetSuite has put forth an agreed proposed schedule that should govern
10 discovery, attached as Exhibit A.²

11 NetSuite proposes that Fed. R. Civ. P. Rule 30(a)(2)’s limit on depositions
12 taken without further leave of Court for good cause should be set at 5 depositions per
13 party, given the scope of the case and the fact that neither an injunction nor lost
14 profits (two issues that often require additional discovery) are in play.

15 NetSuite believes that discovery should be stayed pending resolution of the
16 term “application program(s)” for the reasons explained in its co-pending motion to
17 stay. *See* D.I. 30. NetSuite believes that the proposed schedule set forth in Exhibit
18 A provides sufficient time for its motions to be decided and for the parties to later
19 conduct discovery should the motions be denied.

20 **(7) Preliminary trial estimate:** NetSuite believes that a four (4)-day jury
21 trial is appropriate.

22 **(8) Other issues and specific proposed dates:**

23 Because this is a patent case, NetSuite proposes adoption of the Northern
24 District of California patent rules, with the following modification to the deadlines
25 specified therein to streamline the issues and discovery in this case:

26 _____

27 ² NetSuite believes that construction of “application program” should
28 precede other dates on the agreed-upon schedule, as set forth in its

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