

**UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS**

UNILOC 2017 LLC,

Plaintiff,

v.

PAYCHEX, INC.,

Defendant.

Civil Action No. 1:19-cv-11272-RGS

UNILOC 2017 LLC,

Plaintiff,

v.

ATHENAHEALTH, INC.,

Defendant.

Civil Action No. 1:19-cv-11278-RGS

RESPONDING BRIEF OF UNILOC ON CLAIM CONSTRUCTION AND INDEFINITENESS

Uniloc 2017 responds below to the arguments in Defendant's Joint Opening Brief On Claim Construction and Indefiniteness ("Def. Br.").

A. "Application launcher program"

Uniloc 2017's Construction	Defendants' Construction
computer program that launches, i.e., starts another program	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

Ordinary meaning

Defendants do not appear to dispute the ordinary meaning of this term is a "computer program that launches, *i.e.*, starts, another program."

However, they ask the Court to impose two restrictions that would exclude from the claims certain application launcher programs that fall within the ordinary meaning. But courts

may only depart from the ordinary meaning of a claim term in two instances: lexicography and disavowal. *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014). Neither occurred here.

Populate a user desktop

First, Defendants would require the application launcher program to “populate a user desktop,” apparently because the ’578 patent describes one application launcher program that happens to do that. ’578 patent at 12:26-35. But the ’578 patent also describes several other application launcher programs that do not populate a user desktop. For example, in one embodiment, *id.* at 11:32-37, the user desktop is populated before the application launcher is even distributed. And in *id.* at 11:60-12:1, the specification discloses another embodiment in which the application launcher program does not populate the user desktop.

As Dr. Shamos pointed out, Dkt. 34-2,¹ ¶¶ 46-47 (“Shamos Decl.”), Defendants’ construction introduces spurious concepts into the claim and contradicts the specification. “[I]t is axiomatic that a claim construction that excludes a preferred embodiment ... is rarely, if ever correct and would require highly persuasive evidentiary support.” *Anchor Wall Sys., Inc. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1308 (Fed. Cir. 2003) (internal citations omitted).²

¹ All references to docket entries are from the -11272 action.

² In 2017, in the Texas action, the then owners of the ’578 patent (Uniloc USA Inc. and Uniloc Luxembourg S.A.) had agreed to include “populate a user desktop” in the construction. But, as noted above, that construction is clearly incorrect, as it would exclude various described embodiments. In this action, Uniloc 2017 is therefore insisting on the correct construction.

Defendants cite statements from briefs to the Federal Circuit on the appeal in that action as to patent eligibility and also cite statements from that court. 772 Fed. Appx. 890 (2019); Def. Br. at 7, 11, 18. But that appeal did not involve any issues of claim construction. Thus, statements in the briefs on that appeal and in the Federal Circuit’s opinion that describe one or more

Execution at the server

Second, defendants argue the intrinsic evidence would exclude application launcher programs that launch programs at the server.

The Shamos declaration, however, methodically reviewed the entire '578 patent, including the specification and the claims, and found no support for that position. Shamos Decl., ¶¶ 51-61. (As the '578 patent issued on a first office action, there was no relevant prosecution history.) He pointed to the lack of *any* language in the patent that would exclude launching programs on the server. Finally, he found, as dispositive of the issue, a passage, 11:9-19, referring to a “client/server application program,” which is a clear reference to an application being run at a server.³ The patentees clearly intended to include all application launcher programs, including those that launch programs at the server.

As to this issue, Defendants principally raise an estoppel argument, based upon the later prosecution history of a different patent. They argue that during the prosecution of an application that led to issuance of U.S. Patent No. 6,728,766 (“the '766 patent”), a divisional of the '578 patent application, the applicants submitted an amendment on January 27, 2003, distinguishing a reference (*Duvvoori*) that had been cited against certain claims in that '766 application. Def. Br. at 9-10. They argue that the way in which patentees distinguished that reference would create an estoppel as to the scope of claims in the '766 patent, and that estoppel would carry back to the

embodiments were not intended by the parties or that court to delineate the “metes and bounds” of the claims.

³ As to the '578 specification itself, defendants argue only that the '578 patent’s mention of “delivering” applications supports their construction. Def. Br. at 9, citing '578 patent at 6:2-5, 6:51-53. But a person of skill in the art (POSITA) would read “deliver” as simply making an instance of the application available for execution, when demanded by a user. The cited passages do not support an argument that the patentees had disavowed or disclaimed application launcher programs that launch execution at the server.

already issued '578 patent, because the '766 patent application was a divisional of the '578 patent application.

That presents two questions. First, did those later arguments create an estoppel even as to claims of the '766 patent; and, if so, does the estoppel carry back to the claims of the already issued '578 patent.

As to the first, whether the arguments created an estoppel as to claims of the '766 patent is doubtful. At the time of the amendment, the patentees were pursuing various claims, including dependent claims that expressly required a server that “provides an instance of the selected one of the application program to the client for execution,” but did not require an application launcher. Dkt.25-6 at Paychex_PTO_0000587 (claim 27). The patentees distinguished Duvvoori on multiple grounds, not simply on the ground that Duvvoori did not teach requesting “a configurable instance of an application from a server for execution at the client as with the recited application launcher programs of the present invention.” *Id.* at Paychex_PTO_0000643. Applicants argued that Duvvoori only taught an agent process or a wrapper, and not an application launcher program at all. In context, the statements were thus not a clear disavowal of claim scope.

So whether the argument would create an estoppel as to the '766 patent is doubtful. But the more serious problem Defendants face is that the estoppel, if one existed, would not carry back to the '578 patent.

Because the '766 patent application was a divisional of the application that led to the '578 patent, the prosecution history of that application could have relevance to construction of the '578 patent. But the relevance is limited by *Georgia-Pacific Corp. v. United States Gypsum Co.*, 195 F.3d 1322, 1333 (Fed. Cir. 1999), which states:

[F]or [the patent owner] to be bound by the statement made to the PTO in connection with a later prosecution of a different patent, the statement would have to be one that the examiner relied upon in allowing the claims in the patent at issue.

The statements Defendants would rely upon were made January 7, 2003, long after the '578 patent had issued, on November 27, 2001. So *Georgia-Pacific* would appear to fit the facts of this case like a glove.

But that is not to say that post-issuance statements are always irrelevant. Defendants cited *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1306-07 (Fed. Cir. 2007), and *Teva Pharms USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1343 (Fed. Cir. 2015) as giving consideration to later statements. In addition, the majority opinion in *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004), considered as relevant *some* statements made after an earlier patent has issued. But *Microsoft* acknowledged *Georgia-Pacific* held there could be no estoppel:

In *Georgia-Pacific*, [w]e 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 intrinsic record of the '578 patent, namely, its specification and prosecution history, does not itself limit the construction of application launcher. And nothing in the portions of the prosecution history of the '766 patent Defendants cite contradicts Dr. Shamos's evidence the art's use of “application launcher” to describe “a computer program that launches, *i.e.*, starts, another computer program,” included its launching the program on either a client or server.

Rather, Defendants' argument does not appear to be directed at the meaning of the term to a POSITA. Instead, Defendants are arguing the later statements present a straightforward case of estoppel – in order to avoid a prior art reference, the patent owner made arguments that had



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