

**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

DECLARATION OF JAMES J. FOSTER RE CLAIM CONSTRUCTION

1. I am trial counsel for Plaintiff, Uniloc 2017, and I submit this declaration to provide various facts relevant to claim construction in these actions.

The Texas actions

2. The two patents asserted in this action, the '578 and '293 patents, had been previously asserted in a number of actions filed in 2016-17 in the Eastern District of Texas. Those actions also included two other patents not asserted here.

3. Eight of those cases were consolidated for purposes of claim construction. The eight defendants formed a joint defense group, which appointed lawyers for two defendants to

also represent the other defendants in discussions with me, as counsel for plaintiffs¹ regarding claim construction issues.

4. The '578 and '293 patents have a total of 62 means-plus-function (MPF) terms (or “claim elements”), and the other two patents had 41 additional MPF terms. For each, the local patent rules of that district required the parties to identify the “structure(s), act(s) or material(s) corresponding to that element.”

5. That turned out to be a tedious process. But the parties filed with the court lists, attached to this declaration as Exhibits A and B, identifying the MPF terms in the '578 and '293 patents, respectively, and their proposals as to corresponding structure for each. In those lists, the defendants proposed structures for every MPF term, usually in considerable detail.

This Action

6. At the beginning of the *Markman* process in this action, Defendants suggested they were considering arguing that selected MPF terms were indefinite as lacking corresponding structure. But they did not specify which of the 62 MPF terms they had in mind. Uniloc responded by suggesting they simply file a Rule 7 motion setting forth whatever claims or other indefiniteness arguments they settle on, and we would respond to that motion, as appropriate. But they disagreed, and the Court allowed them to raise indefiniteness arguments as part of the *Markman* process.

7. The parties agreed that, subject to the Court's approval, Defendants would get an extra ten pages in their Opening Brief (to enable them to brief indefiniteness) and Uniloc would get an extra ten pages in its Responding Brief (for the same purpose).

¹ In those actions, plaintiffs were Uniloc USA, Inc. and Uniloc Luxembourg S.A., the previous owners of the patents.

8. Because Local Rule 16.6(e)(1)(c) allows the parties to present no more than ten claim terms for construction, and the parties had already identified six, on January 20 I wrote to Defendants asking them “to identify four indefiniteness ‘terms’ on which you want the Court to focus.”

9. They wrote back the same day (see attached Exhibit C), disagreeing there was any limitation on the number of indefiniteness issues they could present. In the same email, they identified, for the first time, five “exemplary” MPF terms they intended to argue lacked disclosure of corresponding structure.

10. The email also mistakenly stated Uniloc would not identify corresponding structures for those MPF terms. As that was not true, I wrote back immediately (see attached exhibit D) to call their attention to the attached Exhibits A and B, which had been filed in Texas. I told them they could use Uniloc’s proposals as to corresponding structure from those documents in their opening brief.

February 20, 2020

/s/ James J. Foster

James J. Foster