

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

DIAMOND GRADING
TECHNOLOGIES LLC

Plaintiff,

v.

GEMOLOGICAL INSTITUTE OF
AMERICA INC.

Defendant.

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Case No. 02:14-cv-1162-RWS-RSP
JURY TRIAL DEMANDED

**PLAINTIFF’S LOCAL PATENT RULE 3-1 AND 3-2
DISCLOSURES TO DEFENDANT
GEMOLOGICAL INSTITUTE OF AMERICA INC.**

Pursuant to Rules 3-1 and 3-2 of the Local Patent Rules (“P.R.”) of the Eastern District of Texas, Plaintiff Diamond Grading Technologies LLC (“Plaintiff” or “DGT”) submits these Infringement Contention Disclosures concerning U.S. Patent No. RE44,963 (the “RE963 Patent”) to Defendant Gemological Institute of America, Inc. (“Defendant” or “GIA”).

DGT makes these disclosures based on the information presently available to it. DGT has not been given access to internal and proprietary information related to the GIA Diamond Cut Grading System, including but not limited to source code related to that system or components of that system, such as GIA’s Facetware Cut Estimator software. DGT reserves its right to amend or supplement these Disclosures as permitted by the Federal Rules of Civil Procedure, by the Local Rules of the Eastern District of Texas (including the EDTX Local Patent Rules), and by order of the Court as discovery is ongoing in this case.

DISCLOSURES UNDER P.R. 3-1

(a) **Each claim of each patent in suit that is allegedly infringed by each opposing party.**

Defendant infringes claims 1, 17, 34, 35, 53, 55, 76, 79, 80, 82, 83, 85, 88, 94, 98, 114, and 120 of the 'RE963 Patent. DGT reserves the right to supplement and/or amend this disclosure after it is allowed to review and conduct appropriate discovery related to the GIA Diamond Cut Grading System, including but not limited to source code related to that system or components of that system, such as GIA's Facetware Cut Estimator software.

- (b) **Separately for each asserted claim, each accused apparatus, product, device, process, method act, or other instrumentality ("Accused Instrumentality") of each opposing party of which the party is aware. This identification shall be as specific as possible. Each product, device, and apparatus must be identified by name or model number, if known. Each method or process must be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process.**

The GIA Diamond Cut Grading System and GIA Diamond Cut Grading Referencing System, including the GIA Facetware Cut Estimator software ("Accused Instrumentalities") infringe each of the above claims. DGT reserves the right to supplement and/or amend these contentions as proprietary information is learned during discovery and as allowed by the Local Rules of the Eastern District of Texas, the Federal Rules of Civil Procedure, or by Order of the Court.

- (c) **A chart identifying specifically where each element of each asserted claim is found within each Accused Instrumentality, including for each element that such party contends is governed by 35 U.S.C. §112(6), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function.**

The Accused Instrumentalities are proprietary systems that include computerized systems developed and used by GIA to evaluate the cut of gemstones, including diamonds. DGT provides claim charts based on publicly available information. However, such information is very limited in nature and a full analysis of the Accused Instrumentalities requires discovery of GIA's internal and proprietary information, including documents and computer source code related at least to the GIA Facetware Cut Estimator software. DGT reserves the right to supplement and/or amend these

contentions, including claim charts, once GIA has provided full and complete discovery of its internal information related to the Accused Instrumentalities.

(d) Whether each element of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the Accused Instrumentality.

The Accused Instrumentalities are proprietary systems that include computerized systems developed and used by GIA to evaluate the cut of gemstones, including diamonds. DGT makes these disclosures based on publicly available information. However, such information is very limited in nature and a full analysis of the Accused Instrumentalities requires discovery of GIA's internal and proprietary information, including documents and computer source code related at least to the GIA Facetware Cut Estimator software. DGT reserves the right to supplement and/or amend these disclosures once GIA has provided full and complete discovery of its internal information related to the Accused Instrumentalities. Based on its review of the limited publicly available information about the Accused Instrumentalities, DGT believes, at this time, that each element of each asserted claim of the 'RE963 Patent is literally present within the Accused Instrumentalities. In the alternative, DGT identifies the following elements as present under the doctrine of equivalents.

Element	Claim(s)
Light Beam	1, 14, 32
Light and/or Beam of Light	16, 34
Light and/or Light Source	55, 76, 79, 80, 82, 83, 85, 88, 94, 98, 114, 120

(e) For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled.

DGT contends that each of the claims of the 'RE963 Patent is entitled to a priority date at least as early as January 10, 1997.

- (f) **If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party must identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim.**

DGT has no products that incorporate or reflect the claimed invention of the 'RE963 Patent.

DISCLOSURES UNDER P.R. 3-2

- (a) **Documents (e.g. contracts, purchase orders, invoices, advertisements, marketing materials, offer letters, beta site testing, and third party or joint development agreements) sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell, the claimed invention prior to the date of application for the patent in suit. A party's production of a document as required herein shall not constitute an admission that such document evidences or is prior art under 35 U.S.C. §102.**

Responsive to P.R. 3-2(a), DGT produces DGT003073- DGT011433. Until such time as the Court has entered a protective order, these documents are designated generally as Confidential and/or Confidential - Outside Attorneys Eyes Only under the provisions of P.R. 2-2.

- (b) **All documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified pursuant to P.R. 2-1(e), whichever is earlier.**

Responsive to P.R. 3-2(b), DGT produces DGT003073- DGT011433. Until such time as the Court has entered a protective order, these documents are designated generally as Confidential and/or Confidential - Outside Attorneys Eyes Only under the provisions of P.R. 2-2.

- (c) **A copy of the file history for each patent in suit.**

Responsive to P.R. 3-2(c), DGT produces DGT000001- DGT003072.

Dated: November 19, 2015

Respectfully submitted,
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**ATTORNEYS FOR PLAINTIFF
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CERTIFICATE OF SERVICE

The undersigned certifies that on November 19, 2015, Defendant's counsel are being served a true and correct copy of this document via electronic service.

/s/ William Z. Duffy
William Z. Duffy

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