

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

RAYTHEON COMPANY,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD., ET
AL.,

Defendants.

CA No. 2:15-cv-341-JRG-RSP
LEAD CASE

RAYTHEON COMPANY,

Plaintiff,

v.

SONY KABUSHIKI KAISHA, ET AL.,

Defendants.

**DEFENDANTS' INVALIDITY CONTENTIONS AND
DISCLOSURES PURSUANT TO PATENT RULES 3-3 AND 3-4**

Pursuant to the Court's August 14, 2015 Docket Control Order (Dkt. No. 60), and Local Patent Rule 3-3, and in further view of plaintiff Raytheon Company's ("Raytheon") own disclosures and discovery responses to date, defendants Sony Corporation, Sony Corporation of America, Sony Electronics Inc., Sony Mobile Communications (USA) Inc., Sony Semiconductor Corporation, Sony EMCS Corporation, Sony Mobile Communications Inc., Sony Mobile Communications AB, OmniVision Technologies, Inc., Apple Inc., Samsung Electronics Co., LTD., Samsung Electronics America, Inc., and Samsung Semiconductor Inc.

(collectively, “Defendants”) by and through their attorneys hereby provide the following preliminary Invalidity Contentions with respect to the claims of U.S. Patent No. 5,591,678 (“the ’678 patent”) asserted by Raytheon.

I. PRELIMINARY MATTERS

Defendants’ Invalidity Contentions are in response to Raytheon’s Infringement Contentions served on July 16, 2015. These Invalidity Contentions address the asserted claims in Raytheon’s infringement contentions against Defendants, which are claims 1, 5-10, 13, and 18 of ’678 patent.¹ Defendants reserve the right to supplement their Invalidity Contentions in response to any additional claims asserted by Raytheon.

Defendants contend that Raytheon has failed to meet its burden under P. R. 3-1 subparagraphs

To the extent Raytheon alleges that the asserted claims are entitled to a date of invention prior to the filing date of the application identified in Raytheon’s P.R. 3-1(e) disclosure—application Ser. No. 6,120, filed January 19, 1993—Defendants contend that Raytheon has not provided evidence sufficient to establish prior conception and reduction to practice for each asserted claim on a claim-by-claim basis.

These Invalidity Contentions are accompanied by Exhibits A-Z. These exhibits identify various anticipation and obviousness contentions by disclosing exemplary locations in the prior

¹ Raytheon has not provided any infringement contentions to Samsung for claims 5-7, 13, and 18 of the ’678 patent. Samsung understands that these claims are not asserted against Samsung. To the extent Raytheon belatedly asserts them and is permitted to do so, Samsung reserves the right to supplement, amend, or otherwise modify these invalidity contentions.

art, either expressly or inherently, where each limitation of each asserted claim can be found and/or would have been considered obvious by a person of ordinary skill in the art. Defendants are relying on the anticipation and obviousness contentions of Exhibits A-Y regardless of whether any such contentions are repeated in the text of this document. Moreover, the citations to prior art and explanations provided in the attached exhibits are exemplary, and Defendants reserve the right to rely on any other portions or aspects of the cited prior art, systems or products embodying that art or testimony from others regarding that art, as well as expert testimony in proving the invalidity of the asserted claims of the '678 patent. Where Defendants cite to a particular figure in a reference, the citation should be understood to encompass the caption and description of the figure and any text relating to the figure. Conversely, where Defendants cite to particular text referring to a figure, the citation should be understood to include the figure as well.

The suggested obviousness combinations are in addition to Defendants' anticipation contentions and are not to be construed to suggest that any reference included in the combinations is not anticipatory on its own.

The United States Supreme Court recently clarified the standard for what types of inventions are patentable. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). In particular, the Supreme Court emphasized that inventions arising from ordinary innovation, ordinary skill, or common sense should not be patentable. *Id.* at 1732, 1738, 1742-1743, 1746. In that regard, a patent claim may be obvious if the combination of elements was obvious to try or there existed at the time of the invention a known problem for which there was an obvious solution encompassed by the patent's claims. In addition, when a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a

different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars its patentability.

“[T]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1731. Because the ’678 patent simply arrange old elements with each performing the same function it had been known to perform and yields no more than what one would expect from such an arrangement, the combination is obvious. *Id.* at 1742. The asserted claims are therefore invalid under 35 U.S.C. § 103 because they do nothing more than combine known techniques and apparatuses according to their known and ordinary uses to yield predictable results.

Moreover, since there was a finite number of predictable solutions, a person of ordinary skill in the art had good reason to pursue the known options. *Id.* Indeed, a person skilled in the art would have been familiar with all the claim elements that the patentee used to distinguish the prior art during prosecution. The identified prior art references merely use those familiar elements for their primary or well-known purposes in a manner well within the ordinary level of skill in the art. Accordingly, common sense and the knowledge of the prior art render the asserted claims invalid under either Section 102 or Section 103.

A person of ordinary skill would have been motivated to combine the above prior art based on his knowledge, the nature of the problem to be solved, and the teachings of the prior art. The identified prior art addresses the same or similar technical issues and suggests the same or similar solutions to those issues. Moreover, some of the prior art refer to or discuss other prior art, illustrating the close technical relationship among the prior art. To the extent that Raytheon challenges a combination of prior art with respect to a particular element, Defendants reserve the right to supplement these contentions to further specify the motivation to combine the prior art.

Defendants may rely on cited or uncited portions of the prior art, other documents, and expert testimony to establish that a person of ordinary skill in the art at the time of the alleged invention would have been motivated to modify or combine the prior art so as to render the claims invalid as obvious.

As discussed in more detail below, any reference identified as anticipating any asserted claim under 35 U.S.C. §102 also renders the asserted claim invalid as obvious under 35 U.S.C. §103, either by itself or when combined with any of the other cited prior art references or the knowledge of one of ordinary skill in the art. All of the identified prior art within an individual claim chart relates and is directed to the relevant technology of the '678 patent, and Defendants rely upon the disclosures of these references themselves, as well as the nature of the problem purportedly solved by the asserted claims, to demonstrate that one of ordinary skill in the art would have known and been motivated to combine the references as disclosed to practice the asserted claims of the '678 patent. Where a particular item of prior art incorporates by reference other documents or materials, Defendants' identification of the particular prior art reference includes all such incorporated documents or materials.

These Invalidity Contentions should not be interpreted to rely upon, or in any way affect, the claim construction or non-infringement arguments that Defendants have put forth or intend to put forth in this case. Nor are Defendants adopting any of Raytheon's claim construction positions. Rather, these contentions are being provided in response to Raytheon's July 16, 2015 Infringement Contentions (to the extent understood) and the Defendants' present understanding of the asserted claims. Therefore, the attached charts contain (among other things) examples of where the features of the accused products are found in the prior art, such that any interpretation

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