

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

UNILOC USA, INC., <i>ET AL.</i>	Case No. 2:16-cv-00992-JRG
Plaintiffs,	LEAD CASE
V.	
MOTOROLA MOBILITY LLC	
TENCENT AMERICA LLC ET AL.	2:16-cv-00694-JRG
SNAPCHAT, INC.	2:16-cv-00696-JRG
HTC AMERICA, INC.	2:16-cv-00989-JRG
KYOCERA INTERNATIONAL, INC.	2:16-cv-00990-JRG
ZTE (USA), INC. ET AL.	2:16-cv-00993-JRG
HUAWEI DEVICE USA INC. ET AL.,	2:16-cv-00994-JRG
Defendants.	

DEFENDANTS’ JOINT PRELIMINARY INVALIDITY CONTENTIONS

Pursuant to Local Patent Rule 3-3 and the Court’s Docket Control Order (“DCO”), the undersigned Defendants in the above-captioned cases (collectively, “Defendants”) set forth their Joint Invalidation Contentions concerning U.S. Patent Nos. 7,535,890 (“the ’890 patent”), 8,199,747 (“the ’747 patent”), 8,724,622 (“the ’622 patent”), and 8,995,433 (“the ’433 patent”) (collectively, the “Asserted Patents”).¹ These contentions set forth Defendants’ preliminary Invalidation Contentions with respect to the claims currently asserted by Plaintiffs Uniloc USA, Inc. and Uniloc Luxembourg S.A. (collectively, “Plaintiff” or “Uniloc”).

Defendants also serve herewith the document production accompanying these disclosures pursuant to Local Patent Rule 3-4.

I. INTRODUCTORY STATEMENT

The Asserted Claims² of the Asserted Patents are neither novel nor non-obvious in view of

¹ These Preliminary Invalidation Contentions should not be construed as a waiver to any defense, objection, or motion related to personal jurisdiction or venue, and each Defendant maintains any and all objections, defenses, and motions relating to jurisdiction and venue that have been previously raised.

² As used herein, the term “Asserted Claims” encompasses all claims that Plaintiff asserts against each individual Defendant in these consolidated cases. Each individual Defendant joins these Invalidation Contentions with respect to only the claims and patents that are asserted against each such Defendant.

the state of the prior art and the understanding of those of ordinary skill in the art at the time of the alleged inventions. The Asserted Claims instead attempt to lay claim over the use of “instant voice messaging systems,” “generating an instant voice message,” systems and methods for “transmitting [] selected recipients and [] instant voice message[s] [] over [various] networks,” an “instant messaging application,” and other features and functionality, which were well-known in the field prior to the alleged inventions of the Asserted Patents.

The Asserted Claims are also invalid because they fail to claim patent-eligible subject matter under 35 U.S.C. § 101 and *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) and its progeny, as set forth herein. The Asserted Claims are also invalid for lack of written description and lack of enablement under 35 U.S.C. § 112, as explained herein.

II. INVALIDITY CONTENTIONS

The following contentions are based on Defendants’ current understanding of the Asserted Claims as applied in Plaintiff’s Infringement Contentions, without the benefit of claim construction and only limited discovery. Accordingly, these Invalidity Contentions may reflect various potential and alternative positions regarding claim construction and scope. To the extent these Contentions reflect or suggest a particular interpretation or reading of any claim element, Defendants do not adopt, advocate, or acquiesce to such an interpretation or reading. Nor do these Invalidity Contentions constitute any admission by Defendants that any accused products or services, including any current or past versions of those products or services, are covered by any Asserted Claim. Defendants do not take any position herein regarding the proper scope or construction of the Asserted Claims.

Any assertion herein that a particular limitation is disclosed by a prior art reference or references may be based in part on Plaintiff’s apparent interpretation, as identified in Plaintiff’s Infringement Contentions and/or Complaints in these actions, and is not intended to be, and is not, an admission by Defendants that any such construction is supportable or correct. To the extent the following contentions reflect constructions of claim limitations consistent with or implicit in Plaintiff’s Infringement Contentions, no inference is intended, nor should any be drawn, that

Defendants agree with or concedes those claim constructions. Defendants expressly do not do so, and reserves its right to contest them.

To the extent that prior art cited for a particular limitation discloses functionality that is the same or similar in some respects to the alleged functionality in the accused products and/or services as set forth in Plaintiff's Infringement Contentions, Defendants do not concede that those limitations are in fact met by those accused functionalities.

Defendants further reserve the right to seek to supplement and amend these disclosures and associated document production based on further investigation, analysis, and discovery, Defendants' consultation with experts and others, and contentions or court rulings on relevant issues such as claim construction and priority dates. For example, since discovery is in the early stages, deposing the alleged inventors may reveal information that affects the disclosures and contentions herein. Defendants further reserve the right to rely on IPRs filed or instituted against the Asserted Patents, including Uniloc's submissions and arguments in those IPRs. Also, Defendants have not completed discovery from third parties who have information concerning the prior art cited herein and possible additional art. Defendants also reserve the right to seek leave to amend these Invalidity Contentions and/or to modify their selection of prior art references in the event that Plaintiff serves supplemental or modified infringement contentions.

Because Defendants are continuing their search for and analysis of relevant prior art, Defendants reserve the right to seek to revise, amend, and/or supplement the information provided herein, including identifying, charting, and/or relying upon additional prior art references, relevant disclosures, and bases for Invalidity Contentions. Additional prior art, disclosures, and invalidity defects, whether or not cited in this disclosure and whether known or not known to Defendants, may become relevant as investigation, analysis, and discovery continue. Defendants are currently unaware of the extent, if any, to which Plaintiff will contend that limitations of the Asserted Claims are not disclosed in the prior art identified by Defendants. To the extent that such an issue arises, Defendants reserve the right to identify and rely upon other references or portions of references regarding the allegedly missing limitation(s). Moreover, Plaintiffs have not yet produced invalidity

contentions on the same patents it received in other lawsuits, and Defendants specifically reserve the right to supplement their contentions based on such material in Plaintiffs' possession. Defendants notify Plaintiffs that they incorporate herein by reference, and intend to rely on, each reference, disclosure and/or argument set forth in invalidity contentions served in any prior matter involving the same patents but not yet produced to Defendants by Plaintiffs. Defendants also reserve the right to supplement their contentions based on materials that could not be obtained prior to service of these contentions due to confidentiality restrictions.

Additionally, because discovery has only recently commenced, Defendants reserve the right to present additional prior art references and/or disclosures under 35 U.S.C. §§ 102(a), (b), (e), (f), and/or (g), and/or § 103, located during the course of such discovery or further investigation, and to assert invalidity under 35 U.S.C. §§ 102(c), (d), or (f), to the extent that such discovery or investigation yields information forming the basis for such invalidity.

A. Identity of Each Item of Prior Art—P.R. 3-3 (a)

Pursuant to P.R. 3-3 (a), and subject to Defendants' reservation of rights, Defendants identify each item of prior art that anticipates or renders obvious one or more of the Asserted Claims in the attached Prior Art Index submitted herewith. *See Appendix A, infra.* To the extent that the references listed in **Appendix A** are not identified as items of prior art that anticipate or render obvious an Asserted Claim, Defendants intend to rely on these references as background and as evidence of the state of the art at the time of Plaintiff's alleged invention. For example, U.S. Patent No. 5,426,594, filed in April 1993 and issued on June 20, 1995 to Motorola, discloses and claims the ability of one user to select an electronic greeting card, insert personalized text and voice messages that are sent to a central server for subsequent sending to a defined recipient.

Additionally, the prior art references cited by Defendants include references that are related patent applications and issued patents that contain substantially the same subject matter (e.g., published U.S. patent applications, and issued U.S. patents, foreign applications or issued patents). Any citation to or quotation from any of these patent applications or patents, therefore, should be understood as encompassing any parallel citation to the same subject matter in other related or

corresponding applications or patents. For example, where a claim chart cites a published patent application that ultimately issued as a patent with substantially the same written description, Defendants may rely upon the published patent application and/or the issued patent as prior art.

Defendants also reserve the right to later rely upon all references or portions of references provided in **Appendix A** to supplement or amend their disclosures contained herein. Also, to the extent not expressly mentioned herein, Defendants incorporate by reference (1) any and all prior art contained or identified in documents produced thus far by Plaintiff in this or any other proceeding, (2) any and all additional materials regarding or bearing upon invalidity in Plaintiff's possession or control that have not been produced to date, to the extent that any exist, and any and all prior art cited by defendants in any prior case, including but not limited to *Uniloc USA, Inc. v. Samsung Electronics America, Inc., et al*, Case No. 2:16-cv-642-JRG (E.D. Tex.).

Each disclosed item of prior art describing a product, system, or other implementation made in the United States is evidence of a prior invention by another under 35 U.S.C. § 102(g), as evidenced by the named inventors, authors, organizations, and publishers involved with each such reference. Defendants further intend to rely on admissions of the named inventors concerning the prior art, including statements found in the Asserted Patents, their prosecution histories, related patents and/or patent applications, any deposition testimony, and the papers filed and any evidence submitted by Plaintiff in conjunction with this litigation.

Finally, Defendants note that disclosures in the Asserted Patents themselves either anticipate the claimed inventions or render the claimed inventions obvious, either alone or in combination with the prior art references disclosed in these Contentions. Defendants may rely upon the statements in the Asserted Patents as admitted prior art. For example, in the Background of the Invention section of the Asserted Patents, the specification describes “prior art IP telephony system **100**,” which is also represented in Figure 1 of the Asserted Patents. *See, e.g.*, U.S. Patent No. 7,535,890 (“the ’890 patent”)³ at 1:40-2:10, Fig. 1. System **100** has many similarities with the

³ The specification of each Asserted Patent is identical, as all of the Asserted Patents resulted from continuation applications in the same patent family. As such, only one patent is cited here for clarity and brevity.

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