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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

SPEX TECHNOLOGIES, INC.,
Plaintiff,

v.

KINGSTON TECHNOLOGY CORPORATION, KINGSTON DIGITAL, INC., KINGSTON TECHNOLOGY COMPANY, INC., IMATION CORPORATION, DATALOCKER INC., DATA LOCKER INTERNATIONAL, LLC,
Defendants.

CASE NO. 8:16-cv-01790-JVS-AGR

DEFENDANTS' JOINT INVALIDITY CONTENTIONS

Judge: Hon. James V. Selna

SPEX TECHNOLOGIES, INC.,
Plaintiff,

v.

WESTERN DIGITAL CORPORATION, WESTERN DIGITAL TECHNOLOGIES, INC., HGST, INC.,
Defendants.

Case No. 8:16-CV-01799-JVS-AGR

DEFENDANTS' JOINT INVALIDITY CONTENTIONS

Judge: Hon. James V. Selna

SPEX TECHNOLOGIES, INC.,
Plaintiff,

v.

TOSHIBA AMERICA ELECTRONICS COMPONENTS, INC., TOSHIBA AMERICA INFORMATION SYSTEMS, INC., TOSHIBA AMERICA, INC., AND TOSHIBA CORPORATION,
Defendants.

Case No. 8:16-CV-01800-JVS-AGR

DEFENDANTS' JOINT INVALIDITY CONTENTIONS

Judge: Hon. James V. Selna

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SPEX TECHNOLOGIES, INC.,
Plaintiff,
v.
APRICORN,
Defendant.

Case No. 8:16-CV-07349-JVS-AGR
**DEFENDANT'S JOINT INVALIDITY
CONTENTIONS**
Judge: Hon. James V. Selna

1 Pursuant to N.D. Cal. Patent Rules 3-3 and 3-4, and the Rules and Orders of this
2 Court, Defendants Toshiba America Electronic Components Inc., Toshiba America
3 Information Systems, Inc., Toshiba Corporation, Western Digital Corporation, Western
4 Digital Technologies, Inc., HGST, Inc., Imation Corporation, Kingston Technology
5 Corporation, Kingston Digital Inc., Kingston Technology Company, Inc., Apricorn,
6 Datalocker, Inc. and Data Locker International, LLC (collectively, “Defendants”)
7 hereby serve their Joint Invalidity Contentions (“Invalidity Contentions”) on Plaintiff
8 SPEX Technologies, Inc. (“SPEX”) in support of their allegation of invalidity of
9 United States Patent Nos. 6,003,135 (“135 Patent”) and 6,088,802 (“802 Patent”)
10 (collectively, “Asserted Patents”). While all of the claims collectively asserted against
11 the Defendants are addressed below, each Defendant hereby addresses only the claims
12 asserted against it.¹

13 **I. INTRODUCTION AND RESERVATION OF RIGHTS**

14 These Invalidity Contentions are based on information currently available to
15 Defendants. Defendants’ investigation and analysis of prior art is ongoing, and they
16 reserve the right to supplement or modify these Invalidity Contentions in a manner
17 consistent with the Federal Rules of Civil Procedure and the Court’s rules.

18 Defendants’ Invalidity Contentions do not constitute an admission that any
19 current, past, or future version of the accused products infringe the Asserted Patents
20 either literally or under the doctrine of equivalents. Unless otherwise stated, and in the
21 absence of a claim construction order in this action, Defendants have relied on the
22 broad claim constructions of the asserted claims that SPEX has implicitly adopted in
23 its Disclosure of Asserted Claims and Infringement Contentions (“Infringement
24 Contentions”), to the extent any construction can be inferred from SPEX’s
25 Infringement Contentions. Such reliance should not be taken to mean that Defendants

26 _____
27 ¹ SPEX’s Infringement Contentions do not assert the same claims against each
28 Defendant. Each Defendant adopts these invalidity contentions only as to those claims
and patents asserted against that Defendant.

1 understand, or are adopting or agreeing with, SPEX's apparent constructions.
2 Defendants expressly do not do so, and reserve their right to contest them.

3 Defendants' Preliminary Invalidity Contentions are made in the alternative, and
4 should not be interpreted to reply upon, or in any way affect, the non-infringement
5 arguments Defendants intend to assert in this case.

6 Although citations are made to exemplary passages in the prior art, Defendants
7 reserve the right to rely upon additional passages that also may be applicable, or that
8 may become applicable in light of any judicially ordered claim construction, changes
9 in Plaintiff's infringement contentions, and/or information obtained during remaining
10 discovery. In a similar vein, the obviousness combinations of prior art provided below
11 under 35 U.S.C. § 103 are merely exemplary and are not intended to be exhaustive.
12 Numerous additional obviousness combinations of the prior art identified below are
13 possible, and Defendants reserve the right to use any such combination in this
14 litigation. Where Defendants cite and rely on a U.S. patent, Defendants necessarily
15 cite, rely upon and incorporate by reference as additional prior art each and every
16 foreign priority patent (and the applications for those foreign priority patents) cited in
17 the identified U.S. patent.

18 Because Defendants' investigation regarding the invalidity of the asserted
19 patents is not yet complete, certain defenses, including, for example, knowledge or use
20 by others under § 102(a), public use or on-sale bar under § 102(b), derivation or prior
21 inventorship under §§ 102(f)/(g), inequitable conduct, laches, and estoppel, may only
22 become apparent as additional information becomes available. For example,
23 Defendants continue to investigate technological systems such as the Fortezza Crypto
24 Card and Telequip Crypta-Plus Card, among others. More generally, some of the prior
25 art items identified in these Invalidity Contentions relate to systems. Defendants are
26 investigating these prior art systems, and their associated product literature and web
27 pages, and reserve the right to modify, amend and/or supplement these contentions as
28 information becomes available during discovery.

1 In particular, and without limitation, Defendants reserve the right to identify
2 other art or to supplement their disclosures or contentions for at least the following
3 reasons:

4 (i) Defendants' position on the invalidity of particular claims will depend on
5 how the Court construes those claims, any findings as to the priority date of the
6 asserted claims, any findings as to the level of skill attributable to a person of ordinary
7 skill in the art, and/or positions that SPEX or expert witness(es) may take concerning
8 claim construction, infringement, and/or invalidity. Since claim construction has not
9 yet occurred in this action, Defendants cannot take a final position on the bases for
10 invalidity of the claims. Furthermore, SPEX has asserted contradictory positions as to
11 the meanings of key claim terms and claim coverage. While SPEX appears to rely on a
12 broad interpretation of the claim to support its infringement allegations, it argued for a
13 narrower interpretation in motion practice before this Court. For example, it argued
14 that its claims are directed to "specific machines," that "many non-accused products"
15 have security "implemented in software rather than hardware" and hence "would not
16 meet the security means limitation," and that devices "without mediating means, such
17 as those in the prior art, would not practice a number of the claims." SPEX's vague
18 and contradictory assertions as to the meaning of the claims and claim terms hinders
19 Defendants' ability to finalize invalidity contentions.

20 (ii) Defendants' search for prior art is ongoing, and they may discover and/or
21 analyze additional art, and additional materials relating to the art cited herein.

22 (iii) Defendants have not yet completed discovery from Plaintiff. Depositions
23 of the persons involved in the drafting and prosecution of the asserted patents, and of
24 the named inventors, for instance, will likely reveal information that affects the
25 disclosures and contentions herein.

26 (iv) Defendants have not yet completed discovery from third parties who have
27 information concerning the prior art cited herein, and possibly additional art. Such
28 discovery may also reveal information that affects the disclosures and contentions

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