IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

FINTIV, INC.,	§	
	§	
Plaintiff,	§	C.A. No. 1:19-CV-1238-ADA
v.	§	
	§	JURY TRIAL DEMANDED
APPLE, INC.,	§	
	§	
Defendant.	§	

APPLE'S FINAL INVALIDITY CONTENTIONS

Pursuant to the Agreed Scheduling Order entered on June 10, 2019 (Dkt. No. 38), and as agreed by the parties on January 3, 2020, Defendant Apple, Inc. ("Apple") hereby serves its Final Invalidity Contentions for U.S. Patent No. 8,843,125 (the "'125 patent").

I. INTRODUCTORY STATEMENT

Fintiv's Preliminary Infringement Contentions served on May 20, 2019 and its proposed Amended Infringement Conventions, dated December 6, 2019 (collectively, the "Infringement Contentions"), are vague and incomplete, and do not provide the specificity necessary to allow Apple to adequately respond. For example, the Court's Order Governing Proceedings for Patent Cases states that "Plaintiff shall produce [] all documents evidencing conception and reduction to practice for each claimed invention" but Fintiv did not produce any responsive documents. In subsequent correspondence, Fintiv advised that it had searched for conception and reduction to practice documents but did not locate any and confirmed via email dated December 3, 2019 that it was not withholding any conception or reduction to practice documents. Fintiv's failure to timely produce conception and reduction to practice documents prejudices Apple's ability to prepare its invalidity contentions, especially given Fintiv's assertion that "[t]he subject matter described by the Asserted Claims…may have been conceived and reduced to practice prior to

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[the alleged priority date of December 30, 2010].” Infringement Contentions at 4. In preparing its invalidity contentions, Apple is relying on Fintiv’s alleged December 30, 2010 priority date.[1]

The Court’s Order Governing Proceeding for Patent Cases also required Fintiv to “serve[] preliminary infringement contentions in the form of a chart setting forth where in the accused product(s) each element of the asserted claim(s) are found.” Fintiv has failed to do so. For every claim element, Fintiv contends only “on information and belief” that the claim element is satisfied. Fintiv’s Infringement Contentions provide virtually no explanation for its infringement allegations and fail to fairly apprise Apple of Fintiv’s infringement theories or what is alleged to infringe. For example, Fintiv’s Infringement Contentions for at least the following elements are deficient:

- Claim 11: “displaying a contactless card applet based on attributes of the mobile device;”
- Claim 11: “receiving a selection of a contactless card applet;”
- Claim 11: “provisioning the selected contactless card applet, the widget, and the WMA.”
- Claim 14: “receiving filtered contactless card applet for provisioning, wherein the contactless card applet is filtered based on the mobile device information.”
- Claim 18: “a wallet client management component configured to store and to manage a mobile wallet application;”
- Claim 18: “a rule engine configured to filter a widget based on the mobile device information,”
- Claim 18: “wherein said wallet management system is configured to register the mobile device and the mobile wallet application in a Trusted Service Manager (TSM) system.”
- Claim 23: “a wallet management applet (WMA) corresponding to the contactless card applet, wherein the WMA is stored in the SE;”
- Claim 23: “wherein said OTA proxy is configured to capture mobile device information comprising SE information.”

[1] Fintiv’s proposed Amended Infringement Contentions claim a priority date of “no later than June 4, 2010.” Amended Infringement Contentions, pg. 5. This is nonsensical since a patent cannot claim priority to a date before the priority application was filed which, in this case, is December 30, 2010.

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Taking the "displaying …" limitation from claim 11 as an example, the materials cited by Fintiv do not disclose "displaying" any of the required information. *See* Infringement Contentions Ex. A at 13-16. Similarly, Fintiv's Infringement Contentions identify nothing that could reasonably constitute "receiving a selection of a contactless card applet" from a user. *Id*. at 16-18. In at least each of the instances identified above, Fintiv fails to "set[] forth where in the accused product(s) each element of the asserted claim(s) are found." Fintiv's failure to identify what it contends to be infringing in its Infringement Contentions has prejudiced Apple's ability to prepare these invalidity contentions. Moreover, Fintiv has not yet served its Final Infringement Contentions and Apple prepared these Final Invalidity Contentions without the benefit of knowing the positions Fintiv may take regarding the scope of the asserted claims, how Fintiv may interpret the Court's claim constructions, or how Fintiv may attempt to read the claims onto the accused products. Apple specifically reserves the right to amend these Final Invalidity Contentions after receiving Fintiv's Final Infringement Contentions.

Apple understands that Plaintiff Fintiv, Inc. ("Fintiv") has asserted claims 11, 13-14, 16-18, and 20-25 of the '125 patent, which are collectively referred to herein as the "Asserted Claims".

To the extent that these Final Invalidity Contentions rely on or otherwise embody particular constructions of terms or phrases in the Asserted Claims, Defendant is not proposing any such constructions as proper constructions of those terms or phrases. Various positions put forth in this document are predicated on Plaintiff's incorrect and overly broad interpretation of its claims as evidenced by its Infringement Contentions. Those positions are not intended to and do not necessarily reflect Defendant's interpretation of the true and proper scope of Plaintiff's

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claims, and Defendant reserves the right to adopt claim construction positions that differ from or even conflict with various positions put forth in this document.

The Court issued a *Markman* ruling on November 27, 2019 (Dkt. 86) construing the following terms:

Term	Court's Construction
"wallet management applet"	"software that enables management of an electronic wallet including, but not limited to, the functionality of storing account specific information"
"widget"	Plain-and-ordinary meaning, where the plain-and-ordinary meaning is "software that is either an application or works with an application, and which may have a user interface."
"mobile wallet application"	Plain-and-ordinary meaning
"SE information"	"information that is about or related to the SE including, but not limited to, production life cycle, card serial number, card image number, and integrated circuit card identification"
"mobile device information"	Plain-and-ordinary meaning
"over-the-air (OTA) proxy" and "OTA proxy"	"software, in conjunction with relevant hardware, that provisions contactless card applets, captures mobile device information (including SE information), transmits data (mobile device and SE specific information) to the TSM system, and receives APDU commands from the TSM and appropriately forwards them."
"provision[ing]"	Plain-and-ordinary meaning, where the plain and ordinary meaning is "mak[e/ing] available for use."

Apple offers these Final Invalidity Contentions in response to the Court's claim constructions and Fintiv's Infringement Contentions, notwithstanding the deficiencies therein, without prejudice to any position Apply may ultimately take as to any claim construction issues. Apple's application of the Court's claim constructions in these Final Invalidity Contentions is not an admission that Apple agrees with any of the Court's constructions. Apple specifically disagrees with many of the Court's constructions and reserves the right to challenge them both in this or any other proceeding, including on appeal. Nor should Apple's Final Invalidity Contentions be interpreted as suggesting that Fintiv's reading of the Asserted Claims is correct, that any of the Asserted Claims are not indefinite, or as an admission that any of Apple's

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products or technology infringe any claim of the Asserted Patent. Apple specifically denies any such infringement.

These Final Invalidity Contentions, including the attached exhibits, are subject to modification, amendment, and/or supplementation in the event that Fintiv provides any information that it failed to provide in its Infringement Contentions or attempts to cure the deficiencies in its Infringement Contentions, in light of Fintiv's Final Infringement Contentions, and/or in view of any Court's ruling regarding the construction or scope of the Asserted Claims, any findings as to the priority, conception, or reduction to practice date of the Asserted Claims, and/or positions that Fintiv or its expert witness(es) may take concerning claim construction, infringement, and/or invalidity issues. Further, because discovery is not complete, Apple reserves the right to revise, amend, and/or supplement the information provided herein, including identifying and relying on additional references, should Apple's further search and analysis yield additional information or references, consistent with the applicable rules and the Federal Rules of Civil Procedure.

These Final Invalidity Contentions herein are based on Apple's present knowledge and Apple reserves the right to amend these contentions if it identifies new material despite Apple's reasonable efforts to prepare these contentions. Apple's investigation regarding invalidity of the '125 patent over prior art and regarding other grounds of invalidity, including those based on the public use and on-sale bars under 35 U.S.C. § 102(b), anticipation under 35 U.S.C. § 102, obviousness under 35 U.S.C. § 103, failure to comply with 35 U.S.C. § 112, derivation and improper inventorship under 35 U.S.C. § 102(f), and prior invention under 35 U.S.C. § 102(g), is ongoing. There may be products that were known or in public use prior to the filing dates of the

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