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19 *Attorneys for Defendants LG ELECTRONICS INC.,*
20 *LG ELECTRONICS U.S.A., INC., and*
21 *LG ELECTRONICS MOBILE RESEARCH U.S.A., LLC*

22 **THE UNITED STATES DISTRICT COURT**
23 **SOUTHERN DISTRICT OF CALIFORNIA**

24 BELL NORTHERN RESEARCH,
25 LLC,

26 Plaintiff,

27 v.

28 LG ELECTRONICS INC., LG
ELECTRONICS U.S.A., INC., and LG
ELECTRONICS MOBILE
RESEARCH U.S.A., LLC,

Defendants.

Case No. 3:18-cv-02864-CAB-BLM

**DEFENDANTS LG
ELECTRONICS INC., LG
ELECTRONICS U.S.A., INC., AND
LG ELECTRONICS MOBILE
RESEARCH U.S.A., LLC'S
AMENDED INVALIDITY
CONTENTIONS AND
PRODUCTION OF DOCUMENTS
PURSUANT TO PATENT LOCAL
RULES 3.3 AND 3.6(b)**

1 Pursuant to S.D. Cal. Patent Local Rules 3.3 and 3.6(b), and the Rules and
2 Orders of this Court, Defendants LG Electronics Inc. (“LGE”), LG Electronics U.S.A.,
3 Inc. (“LGEUS”), and LG Electronics Mobile Research U.S.A., LLC (“LGMR”)
4 (collectively, “Defendants” or “LG”) hereby serve their Amended Invalidity
5 Contentions (“Invalidity Contentions”) on Plaintiff Bell Northern Research, LLC
6 (“Plaintiff” or “BNR”) in support of LG’s allegations of invalidity of United States
7 Patent Nos. 7,945,285 (“the ’285 Patent”); 6,549,792 (“the ’792 Patent”); 8,416,862
8 (“the ’862 Patent”); 7,957,450 (“the ’450 Patent”); 8,792,432 (“the ’432 Patent”); and
9 7,039,435 (“the ’435 Patent”) (collectively, the “Asserted Patents”).

10 Pursuant to the parties’ stipulation and the Court’s order, BNR’s allegations of
11 infringement with respect to United States Patent Nos. 7,990,842 (“the ’842 Patent”)
12 and 6,941,156 (“the ’156 Patent”) have been dismissed with prejudice, and LG’s
13 allegations that the ’842 and ’156 Patents are invalid have been dismissed without
14 prejudice. (*See* Dkt. No. 73.) Solely for that reason, LG has removed its invalidity
15 contentions with respect to the ’842 and ’156 Patents.

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

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

21 Defendants’ Invalidity Contentions do not constitute an admission that any
22 current, past, or future version of the accused products infringe the Asserted Patents
23 either literally or under the doctrine of equivalents. In many instances, Defendants
24 have relied on the broad claim constructions of the Asserted Claims that Plaintiff has
25 (1) implicitly adopted in its Disclosure of Asserted Claims and Infringement
26 Contentions (“Infringement Contentions”) and amendments or supplements thereto, to
27 the extent any construction can be inferred from Plaintiff’s Infringement Contentions,
28

1 and/or (2) explicitly adopted in its claim constructions disclosed pursuant to Patent
2 Local Rules 4.1 and 4.2. Such reliance should not be taken to mean that Defendants
3 understand, or are adopting or agreeing with, Plaintiff's apparent constructions.
4 Defendants expressly do not do so and reserve their right to contest them.

5 Defendants' Invalidity Contentions are made in addition to and/or in the
6 alternative to Defendants' non-infringement positions, and should not be interpreted to
7 rely upon, or in any way affect, the non-infringement arguments Defendants intend to
8 assert in this case.

9 Although citations are made to exemplary passages in the prior art, Defendants
10 reserve the right to rely upon additional passages that also may be applicable, or that
11 may become applicable in light of any judicially ordered claim construction, changes
12 in Plaintiff's infringement contentions, Plaintiff's validity contentions, and/or
13 information obtained during remaining discovery. Where Defendants cite and rely on
14 a U.S. patent, Defendants necessarily cite, rely upon, and incorporate by reference as
15 additional prior art each and every foreign priority patent (and the applications for
16 those foreign priority patents) cited in the identified U.S. patent.

17 In these Invalidity Contentions (in either this cover pleading or in the Invalidity
18 Claim Charts attached as exhibits hereto), reference to "one of ordinary skill," "skilled
19 artisan," or any other similar term refers to a person of ordinary skill in the art at the
20 time of the alleged invention, as laid out in 35 U.S.C. § 103, for whichever particular
21 Asserted Patent is being discussed.

22 These Invalidity Contentions are based on information currently available to
23 Defendants. Defendants' investigation and analysis is ongoing, and Defendants
24 reserve the right to supplement or modify these Invalidity Contentions in a manner
25 consistent with Patent Local Rule 3.6, the Federal Rules of Civil Procedure, and the
26 Court's rules. Because Defendants' investigation regarding the invalidity of the
27 Asserted Patents is ongoing, certain defenses, including, for example, non-patentable
28

1 subject matter under 35 U.S.C. §101,¹ knowledge or use by others under 35 U.S.C.
2 § 102(a), public use and/or on-sale bar under 35 U.S.C. § 102(b), derivation or prior
3 inventorship under 35 U.S.C. §§ 102(f)/(g), inequitable conduct, unenforceability, and
4 estoppel, etc. may only become apparent as additional information becomes available.
5 Defendants have not yet had the opportunity to conduct sufficient fact discovery
6 regarding their unenforceability defenses. To the extent that during discovery any
7 evidence is produced that supports a contention that any Asserted Patent is
8 unenforceable due to inequitable conduct during prosecution or for any other reason,
9 Defendants reserve all rights to amend and/or supplement their Invalidity Contentions
10 to include such unenforceability contentions.²

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

14 (i) Defendants' position on the invalidity of particular claims will depend on
15 any claim construction from the Court, any findings as to the priority date of the
16 Asserted Claims, any findings as to the level of skill attributable to a person of
17 ordinary skill in the art, and/or positions that Plaintiff or expert witness(es) may take
18 concerning claim construction, infringement, and/or invalidity.

19 (ii) Defendants have not yet completed discovery from Plaintiff. Depositions
20 of the persons involved in the drafting and prosecution of the Asserted Patents, and of
21 the named inventors, for instance, will likely reveal information that affects the
22 disclosures and contentions herein.

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

27 ¹ Defendants note that Patent Local Rule 3.3 does not require the disclosure of
contentions under 35 U.S.C. § 101 in a party's Invalidity Contentions.

28 ² Defendants note that Patent Local Rule 3.3 does not require the disclosure of
unenforceability contentions in a party's Invalidity Contentions.

1 contentions herein.

2 (iv) If Plaintiff modifies any assertion or contention in its Infringement
3 Contentions, or presents any new assertion or contention relevant to these Invalidity
4 Contentions, Defendants reserve the right to supplement or otherwise amend these
5 Invalidity Contentions.

6 Defendants' claim charts cite to particular teachings and disclosures of the prior
7 art as applied to features of the Asserted Claims. However, persons having ordinary
8 skill in the art generally view an item of prior art in the context of other publications,
9 literature, products, and their own experience and understanding. As such, the cited
10 portions in Defendants' claim charts are exemplary only. Where Defendants cite to a
11 particular figure in a reference, the citation should be understood to encompass the
12 caption and description of the figure and any text relating to the figure. Similarly,
13 where Defendants cite to particular text referring to a figure, the citation should be
14 understood to include the figure and caption as well. Furthermore, Defendants reserve
15 the right to rely on uncited portions of the prior art references and on other publications
16 and expert testimony as aids in understanding and interpreting the cited portions, as
17 providing context thereto, as additional evidence that the prior art discloses a claim
18 limitation or the invention as a whole, as evidence of the state of the art at a particular
19 time, and/or as evidence of the obviousness factor of contemporaneous development
20 by others. Defendants further reserve the right to rely on uncited portions of the prior
21 art references, other publications, and testimony, including expert testimony, to
22 establish bases for combination of prior art references that render the Asserted Claims
23 obvious. Defendants also reserve the right to rely upon any documentary or
24 testimonial evidence of the existence of any systems that embodied or practiced the
25 disclosures found in the accompanying invalidity charts, for example as discussed in
26 the prior art references cited herein, as such systems may qualify as prior art under 35
27 U.S.C. § 102(g). To the extent that any claim term or judicially ordered claim
28 construction invokes the printed matter doctrine, Defendants also reserve the right to

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