

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

UNILOC 2017 LLC and UNILOC USA, INC., §

Plaintiffs, §

v. §

Civil Action No. 2:18-CV-00552-JRG-RSP

GOOGLE LLC, §

Defendant. §

DEFENDANT'S INITIAL INVALIDITY CONTENTIONS
AND P.R. 3-3 AND 3-4 DISCLOSURES

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I. PRELIMINARY MATTERS

Pursuant to P.R. 3-3 and 3-4 and the Docket Control Order (ECF No. 37), Defendant Google LLC (“Google” or “Defendant”) hereby discloses its P.R. 3-3 and 3-4 disclosures (“Invalidity Contentions”) in view of Plaintiff Uniloc 2017 LLC’s (“Uniloc”) P.R. 3-1 Disclosure of Asserted Claims and Infringement Contentions (“Infringement Contentions”). Google contends that each of Uniloc’s Asserted Claims (as defined below) is invalid under at least 35 U.S.C. §§ 102, 103, and/or 112.

A. Asserted Claims

U.S. Patent No. 9,564,952 (the “952 Patent” or the “Asserted Patent”) “relates generally to technology for near field authentication of users and their computing devices.” (’952 at 1:12-13). Uniloc’s Infringement Contentions allege infringement of claims 9-12 of the Asserted Patent by Google (collectively, the “Asserted Claims”).

B. Uniloc’s Infringement Contentions

Google bases these Invalidity Contentions on its current understanding of the Asserted Claims in view of Uniloc’s Infringement Contentions, which are deficient in many respects. Specifically, Uniloc failed to meet its burden under at least P.R. 3-1 subparagraphs (c) and (d).

First, Uniloc’s single claim chart fails to identify “where each element of each asserted claim is found within each Accused Instrumentality,” as required by P.R. 3.1(c) (emphasis added). Significantly, Uniloc’s infringement contentions purport to include previously unidentified products, including OnHub routers, in the definition of “Accused Instrumentalities” merely by naming them in the header of that single claim chart. (Uniloc Inf. Cont. at 1.) Uniloc, however, fails to provide analysis for any of these newly named products in that chart, or even discuss those products anywhere else in its infringement contentions. The only products arguably discussed in that chart are Google Nearby Messages API and Google Chromecast Guest Mode. This Court has

found that, where a plaintiff seeks to chart merely an exemplary product, it must also explain in its contentions why the charted products are representative of the uncharted products. *See, e.g., Alacritech Inc. v. Centurylink, Inc.*, 2:16-cv-00693-JRG-RSP, 2017 WL 3007464 (E.D. Tex. July 14, 2017). Google objects to Uniloc’s attempt to accuse other products without explaining how they are equivalent to Google Nearby Messages API or Google Chromecast Guest Mode—the only products arguably charted. Absent such explanation, those products are not properly accused in this case.

Moreover, Uniloc fails to map even Google Nearby Messages API or Google Chromecast Guest Mode to particular limitations in claim 9. For example, claim element 9a requires “scanning a plurality of predetermined frequencies for a free frequency,” but Uniloc was unable to cite any support that Google Nearby meet that limitation. Instead, Uniloc relies on nothing more than speculation to allege that Google Nearby “should scan the allotted (or predetermined) ultrasonic frequencies” and “should follow the same procedure” allegedly disclosed in a Google patent. (Uniloc Inf. Cont. Chart at 7-9.) The same is true for element 9b, which requires “selecting the free frequency from the plurality of predetermined frequencies.” (Id. at 9-11.)

Similarly, Uniloc fails to identify any “user-configurable data” included in the message transmitted by Google Nearby Messages API, and Google cannot identify how Uniloc contends element 9g is met. Uniloc identifies the PIN as non-user-configurable data for Chromecast Guest Mode, but relies on only unsupported speculation that the “K value might be different for different implementations” and thus “may be called user-configurable data.” (Uniloc Inf. Cont. Chart at 21.)

Uniloc also failed to provide separate charts identifying where it contends the additional element(s) of dependent claim 12 are found in the Accused Instrumentalities. Instead, it simply

states without explanation: “Refer to Claim 9d and 11.” (See Uniloc Inf. Cont. Chart at 37.) For at least these reasons, Uniloc’s infringement contentions fail to comply with the local rules.

Additionally, in its claim chart, Uniloc relies upon “live testing” of a “Google Chromecast Device” in two scenarios, during which audio sound waves were purportedly recorded and later analyzed using “an application,” but Uniloc fails to provide any further details regarding the parameters of these tests and does not attach any documentation of such testing. (See Uniloc Inf. Cont. Chart at 31-33.) Figures 31-32 of the chart, which purport to be screenshots from this testing, cite to an unidentified “Exhibit,” but none of the exhibits attached appear to include those figures.

Second, Uniloc does not identify whether it claims each element is present literally or under the doctrine of equivalents in each Accused Instrumentality, as required by P.R. 3-1(d). Instead, Uniloc makes the blanket assertion that “[a]ny claim element not literally present in the Accused Instrumentalities as set forth in the claims charts is found in those Instrumentalities under the doctrine of equivalents because any differences between such claim element and the Accused Instrumentalities are insubstantial and/or the Accused Instrumentalities perform substantially the same function, in substantially the same way to achieve substantially the same result as the corresponding claim element(s).” (Uniloc Inf. Cont. at 3.) This boilerplate language does not meet the notice requirement of P.R. 3-1(d). See *Eolas Techs. Inc. v. Amazon.com, Inc.*, 2016 WL 7666160, at *3 (E.D. Tex. December 5, 2016) (striking DOE contentions as insufficient under P.R. 3-1(d) based on similar blanket statements).

The foregoing deficiencies in Uniloc’s Infringement Contentions have unduly burdened Google and frustrated its ability to understand how Uniloc is applying the claims, and thus its ability to identify all potential bases for invalidity in these contentions. In light of these deficiencies, Google reserves all rights to challenge the reasonableness and sufficiency of Uniloc’s

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