

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

UNILOC 2017

Plaintiff

v.

GOOGLE LLC,

Defendant.

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NO. 2-18-cv-00551-JRG-RSP

**INVALIDITY CONTENTIONS OF
DEFENDANT GOOGLE LLC**

Defendant Google LLC (“Defendant” or “Google”), by its attorneys, makes these Invalidation Contentions concerning U.S. Patent No. 7,012,960 (“the Asserted Patent”), to Plaintiff Uniloc 2017 LLC and Uniloc USA, Inc. (“Plaintiff” or “Uniloc”) in connection with the above-referenced action, pursuant to the Docket Control Order entered by the Court (Dkt. No. 45) and Local Patent Rule (“P.R.”) 3-3.

Google’s Invalidation Contentions herein reflect Google’s knowledge as of this early date in the present action. Google reserves the right, to the extent permitted by the Court and the applicable statutes and rules, to modify and/or supplement its Invalidation Contentions in response to becoming aware of additional prior art or information regarding prior art, any modification or supplementation of Plaintiff’s Infringement Contentions, any claim construction by the Court, or as otherwise may be appropriate.

The Docket Control Order and the Patent Rules contemplate that these Invalidation Contentions would be prepared and served in response to Plaintiff’s Infringement Contentions. However, Plaintiff’s Infringement Contentions are insufficient because they lack proper and

complete disclosure as to how Plaintiff contends that Google infringes the Asserted Claims. By way of example, and without limitation, these deficiencies were detailed in letters to Plaintiff from Google on July 9, 2019. Due to Plaintiff's failure to provide proper and complete disclosure of its Infringement Contentions under P.R. 3-1, Google reserves the right to seek leave from the Court to amend these Invalidity Contentions should Plaintiff be allowed by the Court to amend its Infringement Contentions or its apparent claim constructions. Google also reserves the right to amend these Invalidity Contentions in light of positions that Plaintiff or their expert witnesses may assert concerning claim construction, infringement, and/or invalidity issues.

Google's Exhibits attached hereto cite to particular teachings and disclosures of the prior art as applied to features of the asserted claims. However, persons having ordinary skill in the art generally may view an item of prior art in the context of other publications, literature, products, and understanding. As such, the cited portions of prior art identified herein are exemplary only. Google may rely on the entirety of the prior art references listed herein, including un-cited portions of those prior art references, and on other publications and expert testimony shedding light on those prior art references, including as aids in understanding and interpreting the cited portions, as providing context thereto and as additional evidence that the prior art discloses a claim limitation.

Google will also rely on documents, products, testimony, and other evidence to establish bases for and motivations to make combinations of certain cited references that render the asserted claims obvious. Google may rely upon corroborating documents, products, testimony, and other evidence including materials obtained through further investigation and third-party discovery of the prior art identified herein, that describes the invalidating features identified in these contentions; evidence of the state of the art in the relevant time period (irrespective of whether such references themselves qualify as prior art to the Asserted Patent), including prior art listed on

the face of the Asserted Patent and/or disclosed in the specification (“Admitted Prior Art”); and/or expert testimony to provide context to or aid in understanding the cited portions of the identified prior art.

The references discussed in the Exhibits herein disclose the elements of the asserted claims explicitly or inherently, and/or they may be relied upon to show the state of the art in the relevant time frame. To the extent the attached claim charts cite to a reference for each element or limitation of an asserted claim, Google contends that such reference anticipates that claim. In addition, to the extent that the attached claim charts cite to additional references, Google contends, in the alternative, that the asserted claim is rendered obvious for the reasons set forth in the attached charts. To the extent suggested obviousness combinations are included in the attached claim charts, they are provided in the alternative to Google’s anticipation contentions and are not to be construed to suggest that any reference included in the combinations is not by itself anticipatory.

For purposes of these Invalidity Contentions, Google identifies prior art references and provides element-by-element claim charts based, in part, on the apparent claim constructions advanced by Plaintiff in its Infringement Contentions. The citation of prior art herein and the accompanying Exhibits are not intended to reflect Google’s claim construction contentions, which will be disclosed in due course in accordance with the Docket Control Order, and may instead reflect Plaintiff’s apparent (and potentially erroneous) claim constructions based on its Infringement Contentions. Nothing stated herein shall be treated as an admission or suggestion that Google agrees with Plaintiff regarding either the scope of any of the asserted claims or the claim constructions advanced in the Infringement Contentions. Moreover, nothing in these Invalidity Contentions shall be treated as an admission that any of Google’s accused technology meets any limitations of the claims.

Pursuant to P.R. 3-3 and 3-4, Google has provided disclosures and related documents pertaining to only the asserted claims as identified by Plaintiff in its Infringement Contentions. See Bates Nos. Goog-UNI551-PA-00000001–GOOG-UNI551-PA-00003918. Google will further supplement its P.R. 3-4 document production should it later find additional, responsive documents, such as documents produced by third parties in response to discovery requests. Much of the art identified below reflects common knowledge and the state of the art prior to the filing date of the Asserted Patent.

Each of the asserted claims¹ of the Asserted Patent is anticipated by and/or obvious in view of one or more items of prior art identified herein, alone or in combination. Specific examples of this anticipation and obviousness, along with the motivation to combine the selected prior art, are set forth in Section IV. Google further reserves the right to assert additional theories of invalidity not addressed or required to be disclosed in its P.R. 3-3 invalidity contentions.

In addition to the prior art identified below and the accompanying invalidity claim charts, Defendant also incorporates by reference any prior art disclosed at any time by parties in the present litigation or by any party to any other past, present, or future litigation or U.S. Patent and Trademark Office proceeding involving the asserted patent or related patents.

I. ALLEGED PRIORITY

In its Infringement Contentions, Uniloc contends that each of the asserted claims of the Asserted Patent “is entitled to a priority date not later than Mar. 6, 2001 and Oct. 24, 2000, respectively.” Google objects to Uniloc including the “not later than” language and two different dates in its priority claim, such that Uniloc has asserted an open-ended priority date in violation of this Court’s Patent Local Rules. Indeed, P.R. 3-1(e) requires that plaintiff identify “*the priority*

¹ For reasons analogous to those identified herein, Google contends all *non-asserted* claims of the Asserted Patent are invalid as anticipated and/or obvious in view of the prior art or indefinite.

date to which each asserted claim allegedly is entitled” – not a start date, end date, set of potential dates, or date range.

Putting aside Uniloc’s failure to comply with P.R. 3-1(e), EP patent applications Serial Number 00402939 cannot support Uniloc’s claimed priority date of October 24, 2000 for the Asserted Patent. For example, EP 402939 does not include Figure 5 of the Asserted Patent, which purports to describe “a fourth embodiment of a transcoding device according to the invention, said device also comprising a spatial filter circuit and, possibly, a temporal filter circuit.” Asserted Patent, 2:59-62. Therefore, the only arguable priority date that Uniloc can claim is March 6, 2001, the date of the filing of the EP application Serial Number 01400588, which appears to have identical disclosure to that of the Asserted Patent.²

Uniloc also incorporates by reference any identifications and analyses that any expert witness(es) may take concerning priority issues. To the extent that Uniloc is permitted to modify, and in fact modifies in any manner, the alleged date to which the Asserted Patent is entitled to priority, Google reserves the right to respond and challenge that date to the extent required by law to satisfy their burden.

II. STATE OF THE ART

The references discussed in the Exhibits attached hereto may be relied upon to show the state of the art in the relevant time frame. This prior art identification is only exemplary and is not in any way intended to limit the scope of what one of ordinary skill in the art would have understood at the relevant time period of the alleged invention or the breadth of the state of the art to which the alleged invention of the Asserted Patent relates. Google reserves the right to rely upon additional prior art, information, testimony, and/or knowledge to demonstrate what one of

² To the extent the Court may determine that certain asserted claims might be entitled to different respective priority dates, Google reserves the right to revise these contentions accordingly.

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