

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

UNILOC 2017 LLC,

Plaintiff,

v.

GOOGLE LLC,

Defendant.

Civil Action No. 2:18-cv-00553-JRG

JURY TRIAL DEMANDED

DEFENDANT GOOGLE LLC'S P.R. 3-3 AND 3-4 INVALIDITY CONTENTIONS

Pursuant to Patent Local Rules 3-3 and 3-4, and pursuant to the Docket Control Order entered by the Court (Dkt. 42), Defendant Google LLC ("Google") respectfully submits these invalidity contentions and an accompanying production with respect to the claims identified by Plaintiff Uniloc 2017 LLC ("Uniloc") in its Disclosures Pursuant to Local P.R. 3-1 and 3-2. The asserted claims include claims 6-12 ("the Asserted Claims") of U.S. Pat. No. 6,366,908 ("the '908 Patent" or "the Asserted Patent").

PATENT LOCAL RULE 3-3 DISCLOSURES

This disclosure is directed to preliminary invalidity and unenforceability issues only and does not address claim construction or non-infringement. Google reserves all rights with respect to such issues, including but not limited to its position that the Asserted Claims of the '908 Patent are to be construed in a particular manner and are not infringed.

These invalidity contentions are preliminary and are based on Google's current knowledge, understanding, and belief as to the facts and information available as of the date of these

contentions. Google have not yet completed its investigation, discovery, or analysis of information related to this action, and additional discovery may require Google to supplement or amend its invalidity contentions. Google reserves the right to amend or supplement their contentions once it gains access to relevant materials Uniloc has not yet produced. While Google has made a good-faith effort to provide a comprehensive list of prior art relevant to this case, Google reserves the right to modify or supplement its prior art list and invalidity contentions at a later time with or based upon pertinent information that may be subsequently discovered from Uniloc or third parties. Moreover, discovery is ongoing and Google reserves the right to pursue all other defenses that may be available to them, including but not limited to defenses that the '908 Patent is unenforceable based on laches, estoppel, waiver, acquiescence, inequitable conduct, patent misuse, patent exhaustion, unfair competition, unclean hands, express or implied license, or any other grounds.

Any invalidity analysis depends, ultimately, upon claim construction, which is a question of law reserved for the Court. The Asserted Claims have not yet been construed by the Court in this case and, thus, Google has not yet had the opportunity to compare the Asserted Claims of the '908 Patent (as construed by the Court) with the prior art. Google reserves the right to amend, supplement, or materially modify its invalidity contentions after the claims have been construed by the Court. Google also reserves the right to amend, supplement, or materially modify its invalidity contentions in response to any claim construction positions that Uniloc may take in this case. Google also reserves the right to assert that a claim is indefinite, not enabled, or fails to meet the written description requirement based on any claim construction positions Uniloc may take in this case or based on any claim construction the Court may adopt in this case.

Google's invalidity contentions are directed to the claims asserted by Uniloc that are identified in Uniloc's Disclosures Pursuant to Local P.R. 3-1 and 3-2. Google reserves the right to modify, amend, supplement or otherwise alter its invalidity contentions in the event that Uniloc supplements or amends its infringement contentions or takes a claim construction position that is different than or in addition to those set forth in its infringement contentions, or for any other reason constituting good cause to modify, amend, supplement or otherwise alter these invalidity contentions.

Google further contends that Uniloc appears to be pursuing overly broad constructions of the Asserted Claims of the '908 Patent in an effort to piece together an infringement claim where none exists and to accuse products that do not practice the claims as properly construed. At the same time, Uniloc's infringement contentions are in most places too general and vague to discern exactly how Uniloc contends Google Search ("the Accused Product") practices each element of the Asserted Claims. Accordingly, these invalidity contentions are not intended to be, and are not, an admission that the Asserted Claims are infringed by any of Google's products or technology, that any particular feature or aspect of the Accused Product practices any elements of the Asserted Claims, or that any of Uniloc's proposed constructions are supportable or proper. To the extent that any of the prior art references disclose the same functionality or feature of any of the Accused Product, Google reserves the right to argue that said feature or functionality does not practice any element of any of the Asserted Claims, and to argue, in the alternative, that if said feature or functionality is found to practice any element of any of the Asserted Claims of the '908 Patent, then the prior art reference demonstrates that that element is not novel, is obvious, or is not patentable.

Attached hereto as Exhibits A-1 to A-23 are representative claim charts that demonstrate how the Asserted Claims of the '908 Patent are invalid in view of certain prior art. The references cited in the attached claim charts may disclose the limitations of the Asserted Claims of the '908 Patent expressly and/or inherently. Moreover, the suggested obviousness combinations are in the alternative to Google's contentions regarding anticipation. These obviousness combinations should not be construed to suggest that any reference included in any combination is not anticipatory in its own right.

In this action, Uniloc asserts that Google infringes certain claims of the '908 Patent. Although Uniloc asserts that these claims are either literally infringed or infringed under the doctrine of equivalents, Uniloc has failed to provide any analysis or explanation regarding alleged infringement of the Asserted Claims of the '908 Patent under the doctrine of equivalents. Google reserves the right to modify, amend, supplement or otherwise alter its preliminary invalidity contentions in the event Uniloc is permitted to modify, amend, supplement, or clarify its infringement contentions with respect to direct infringement (literal and under the doctrine of equivalents).

Prior art not included in this disclosure, whether known or not known to Google, may become relevant. In particular, Google is currently unaware of the extent to which Uniloc will contend that limitations of the Asserted Claims are not disclosed in the prior art identified herein. To the extent that such an issue arises, Google reserves the right to identify additional teachings in the same references or in other references that anticipate or would have made the addition of the allegedly missing limitation obvious. Moreover, Google may subpoena third parties believed to have information relevant to this disclosure and expressly reserves the right to amend, supplement,

or modify this disclosure as additional information is obtained from third parties, or from Uniloc itself.

Google further reserves the right to rely on uncited portions of the prior art references and in other publications and testimony as aids in understanding and interpreting the cited portions, as providing context thereto, and as additional evidence that a claim limitation is known or disclosed. Google further reserves the right to rely on uncited portions of the prior art references, other publications, and testimony to establish bases for combinations of certain cited references that render the asserted claims obvious.

The references discussed in the claim charts identified above or elsewhere may disclose the elements of the Asserted Claims explicitly and/or inherently, and/or they may be relied upon to show the state of the art in the relevant time frame. Google further reserves the right to rely on additional publications, materials, and testimony that are not yet currently identified for purposes other than as prior art, including but not limited to background, state of the art in the relevant time frame, level of ordinary skill in the art, and motivation to combine. The suggested obviousness combinations below 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.

Google is providing invalidity contentions only for the claims asserted by Uniloc, but hereby reserves the right to seek invalidation of all claims in the '908 Patent.

Google reserves the right to modify, amend, or supplement these disclosures as additional information becomes available, and as its discovery and investigation proceed.

I. THE '908 PATENT

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