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

PARUS HOLDINGS INC., Plaintiff, v. APPLE INC., Defendant.	§ § § § § § § § § § §	CIVIL ACTION 6:19-cv-00432-ADA JURY TRIAL DEMANDED **[LEAD CASE]**

PARUS HOLDINGS INC., Plaintiff, v. GOOGLE LLC, Defendant.	§ § § § § § § § § § §	CIVIL ACTION No. 6:19-cv-00433-ADA JURY TRIAL DEMANDED

PARUS HOLDINGS INC., Plaintiff, v. LG ELECTRONICS, INC., LG ELECTRONICS USA, INC., Defendants.	§ § § § § § § § § § §	CIVIL ACTION No. 6:19-cv-00437-ADA JURY TRIAL DEMANDED

Parus Exhibit 2011

PARUS HOLDINGS INC., Plaintiff, v. SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC., Defendants.	§ § § § § § § § § §	CIVIL ACTION No. 6:19-cv-00438-ADA JURY TRIAL DEMANDED

PARUS HOLDINGS INC., Plaintiff, v. AMAZON.COM, INC., Defendant.	§ § § § § § § § § §	CIVIL ACTION No. 6:19-cv-00454-ADA JURY TRIAL DEMANDED

DEFENDANTS' CORRECTED PRELIMINARY INVALIDITY CONTENTIONS

I. INTRODUCTION

Pursuant to the January 17, 2020 Scheduling Order (D.I. 85), Defendants Apple Inc. ("Apple"); Google LLC ("Google"); LG Electronics, Inc., LG Electronics USA, Inc. ("LG Defendants"); Samsung Electronics Co., Ltd., Samsung Electronics America, Inc. ("Samsung Defendants"); and Amazon.Com, Inc. ("Amazon") (collectively, "Defendants") provide these Preliminary Invalidity Contentions to Plaintiff Parus Holdings Inc. ("Parus") for the following patents (collectively, "Asserted Patents") and claims (collectively, "Asserted Claims") identified as asserted in Parus's Preliminary Infringement Contentions and Disclosure of Priority Dates and

Dates of Conception/Reduction to Practice served on December 11, 2019 ("Infringement Contentions"):

- U.S. Patent No. 7,076,431 ("'431 Patent") — Claims 1, 2, 4, 5, 6, 7, 9, 10, 13, 14 ("'431 Asserted Claims")
- U.S. Patent No. 9,451,084 ("'084 Patent") — Claims 1, 2, 4, 5, 6, 7, 10, 14 ("'084 Asserted Claims")[1]

Defendants address the invalidity of the Asserted Claims and conclude with a description of their document productions and identification of additional reservations and explanations. These Preliminary Invalidity Contentions use the acronym "POSITA" to refer to a person having ordinary skill in the art to which the claimed inventions pertain. Although the Court consolidated the related cases filed by Parus, each Defendant is entitled to its own trial and nothing in these contentions limits any particular Defendant's right to select defenses for trial.

II. PRIORITY DATE OF THE ASSERTED PATENTS AND CLAIMS

Parus asserts the following priority dates for all Asserted Claims in its December 11, 2019 Infringement Contentions:

- Priority Date: October 13, 1998
- Conception: October 13, 1998
- Actual Reduction to Practice: January 16, 2000
- Constructive Reduction to Practice: February 4, 2000

It is Parus's burden to show entitlement to its asserted priority dates, and Defendants assert that Parus has failed to meet that burden. The documents produced by Parus in support of its alleged conception and actual reduction to practice dates (PARUS_00000001-8645) do not show that the named inventors of the Asserted Patents conceived the Asserted Claims on or after

[1] The Asserted Patents are governed by the pre-AIA statutory framework as the applications were filed before March 16, 2013.

October 13, 1998, do not show that the named inventors of the Asserted Patents were diligent in reducing to practice their alleged inventions, and do not show that the alleged inventions were actually reduced to practice on or after January 16, 2000. In addition, provisional application No. 60/180,344, filed February 4, 2000, on which Parus appears to rely to support its alleged constructive reduction to practice, fails to disclose all elements of the Asserted Claims. Similarly, provisional application No. 60/233,068, filed September 15, 2000, fails to disclose all elements of the Asserted Claims. Finally, as described below, elements of the Asserted Claims lack written description and enablement support, and those Asserted Claims therefore cannot claim priority to earlier continuation applications on the face of the Asserted Patents. For purposes of these Preliminary Invalidity Contentions, Defendants identify art that qualifies as prior art under 35 U.S.C. § 102 (pre-AIA) on or before February 4, 2000, the filing date of the earliest allegedly related provisional application to the Asserted Patents.

III. INVALIDITY UNDER 35 U.S.C. § 101

To be patentable subject matter under § 101, a claim must be directed to one of four eligible subject matter categories: "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. "Claims that fall within one of the four subject matter categories may nevertheless be ineligible if they encompass laws of nature, physical phenomena, or abstract ideas." *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980). The Supreme Court established a two-step test for deciding the subject matter eligibility of claims under § 101. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014). First, the claims must be analyzed to determine whether they are drawn to one of the statutory exceptions. *Id.* Claims that invoke generic computer components instead of reciting specific improvements in computer capabilities are abstract under this first step. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335-36 (Fed. Cir. 2016). Second, the elements of the claims must be viewed both individually

and as an ordered combination to see if there is an "inventive concept." *Id.* The mere fact that a claim recites or implies that an abstract idea is implemented using a general-purpose computer does not supply an inventive concept necessary to satisfy § 101. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016); *Alice*, 134 S. Ct. at 2357-59.

All of the Asserted Claims are directed to ineligible subject matter under 35 U.S.C. § 101 and applicable case law authority.[2] Pursuant to the Court's guidance, Defendants will present any § 101 motions after claim construction.

IV. '431 PATENT

A. Prior Art References

Defendants identify the following prior art now known to Defendants to anticipate or render obvious the '431 Asserted Claims under at least 35 U.S.C. §§ 102(a), (b), (e), and/or (g), and/or § 103, either expressly or inherently as understood by a POSITA.

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[2] *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012); *Trading Techs. Int'l, Inc. v. IBG, LLC*, 921 F.3d 1084 (Fed. Cir. 2019); *ChargePoint, Inc. v. SemaConnect, Inc.*, 920 F.3d 759 (Fed. Cir. 2019); *SAP America, Inc. v. InvestPic, LLC*, 898 F.3d 1161 (Fed. Cir. 2018); *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335 (Fed. Cir. 2018); *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121 (Fed. Cir. 2018); *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329 (Fed. Cir. 2017), *cert. denied*, 139 S. Ct. 378 (2018); *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332 (Fed. Cir. 2017); *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229 (Fed. Cir. 2016); *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253 (Fed. Cir. 2016); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016); *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369 (Fed. Cir. 2016); *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363 (Fed. Cir. 2015); *Internet Patents Corp. v. Active Network, Inc*, 790 F.3d 1343 (Fed. Cir. 2015); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359 (Fed. Cir. 2015); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343 (Fed. Cir. 2014); *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344 (Fed. Cir. 2014); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (Fed. Cir. 2011).

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