

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

**LARGAN PRECISION CO., LTD.,**

**Plaintiff,**

**v.**

**ABILITY OPTO-ELECTRONICS  
TECHNOLOGY CO., LTD.; NEWMAX  
TECHNOLOGY CO., LTD.; AND HP  
INC.**

**Defendants.**

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**Civil Action No. 4:19-CV-696-ALM  
Jury Trial Demanded**

**DEFENDANTS' INVALIDITY CONTENTIONS FOR U.S. PATENT NO. 8,988,796**

Pursuant to Local Patent Rule 3-3 and the Court's Amended Scheduling Order (D.I. 80), Defendants Ability Opto-Electronics Technology Co., Ltd. ("Ability"), Newmax Technology Co., Ltd. ("Newmax"), and HP Inc. ("HP") (collectively "Defendants") disclose these Invalidation Contentions for U.S. Patent No. 8,988,796 ("the '796 Patent").

**Introduction**

Defendants disclose these Invalidation Contentions for claims 1–9, 11, and 15–25<sup>1</sup> of the '796 Patent ("the Asserted Claims") asserted by Plaintiff Largan Precision Co., Ltd. ("Largan") in its April 2, 2020 Disclosure of Asserted Claims and Infringement Contentions ("Infringement Contentions")<sup>2</sup>. Defendants contend that each of the claims asserted by Largan is invalid under at least one or more of 35 U.S.C. §§ 101, 102, 103, and 112.

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<sup>1</sup> The cover pleading of Largan's Infringement Contentions does not identify claim 23 as an asserted claim of the '796 Patent. However, some of Largan's Local P.R. 3-1 claim charts include claim 23. Defendants therefore have included claim 23 in these Invalidation Contentions.

<sup>2</sup> It is unclear from Largan's infringement contentions which Newmax products are accused of infringing which claims. As such, Newmax joins each claim of these invalidity contentions only to the extent that that Largan is accusing Newmax of infringement of a particular claim. In other words, Newmax only joins the contentions for claims that Largan has asserted or later asserts against Newmax in this case.

Defendants have based these Invalidity Contentions, in part, upon Largan's Infringement Contentions, including Largan's apparent claim constructions and the allegedly-infringing features of the Accused Instrumentalities. However, Largan's Infringement Contentions fail to comply with Local P.R. 3-1 because they do not provide reasonable notice of Largan's infringement theories.<sup>3</sup> In the event that Largan seeks to amend its Infringement Contentions or otherwise provide further detail about its infringement theories and/or the Court permits Largan to assert additional claims or infringement theories against Defendants in the future, Defendants reserve the right to supplement and amend these Invalidity Contentions or to otherwise disclose new or supplemental invalidity contentions regarding such claims. Further, nothing herein is an admission that Largan's Infringement Contentions are correct.

The Court has not yet entered a claim construction order and claim construction discovery has not yet begun. Defendants expressly reserve the right to propose alternatives to and to rebut Largan's claim constructions. Defendants also reserve the right to supplement and amend these Invalidity Contentions consistent with Local P.R. 3-6, including the addition of prior art and grounds for invalidity, whether currently known or unknown to Defendants once the Court has issued a claim construction order and in the event that Largan amends its Infringement Contentions following any such order.

The Court has not determined whether any or all parts of the preamble of the Asserted Claims are limitations. To the extent that Defendants have charted or otherwise discuss the claim preambles in these Invalidity Contentions, their doing so is not an admission that the preambles are limiting. Defendants expressly reserve the right to assert that the claim preambles are not limiting, in whole or in part, during claim construction discovery and briefing.

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<sup>3</sup> See, e.g., April 16, 2020 Letter from K. Davis to B. Sigler, May 1, 2020 Letter from D. Hoffman to B. Sigler, and May 15, 2020 Letter from B. Stroy to B. Sigler.

For purposes of these Invalidity Contentions, Defendants have presumed the priority date for the '796 Patent to be October 29, 2013. Nonetheless, Largan retains the burden of proof on the issue of priority, and Defendants reserve the right to dispute that the '796 Patent has a valid priority claim to this date. If the Court finds that the '796 Patent is not entitled to this priority date, or Largan attempts to amend its priority date, Defendants reserve the right to supplement or amend these Invalidity Contentions, including to identify additional prior art based on any revised priority date.

The obviousness combinations disclosed in these Invalidity Contentions under 35 U.S.C. § 103 are exemplary and are not intended to be exhaustive. Alternative and additional obviousness combinations of the prior-art references identified in these Invalidity Contentions are possible, and Defendants reserve the right to use any such combinations in this litigation.

Defendants are currently unaware of the extent, if any, that Largan contends that the prior art does not disclose the claim limitations. To the extent that Largan disputes that a claim limitation is met by a prior-art reference, Defendants reserve the right to identify other prior-art references having the allegedly-missing limitation and that it would have been obvious to combine with the prior-art reference in order to supply the allegedly-missing limitation.

Defendants' investigation into prior art remains ongoing. This includes Defendants' investigation into the prior art referred to in these Invalidity Contentions, into prior art not yet known to Defendants, into third-party prior art, and into related evidence, documents, and knowledgeable witnesses. For example, third party Apple has indicated that it plans to produce documents responsive to the subpoena HP served on February 17, 2020, but Apple's response has been significantly slowed down by the ongoing coronavirus pandemic. By way of further example, despite numerous attempts to serve third party Genius at its offices in California, HP's process

servers have been unable to get someone in the office to open the door. Defendants intend to pursue this and other third-party discovery as to prior art products and systems. Moreover, prior art may become relevant depending on the claim constructions Largan asserts, the claim constructions the Court adopts, and as Largan provides further detail about its Infringement Contentions. Additional evidence and information about prior art, including documentation and witness testimony, may later be discovered and presented. The inventor has not been deposed to date – defendants expect the inventor testimony to open up additional avenues of prior art discovery including prior art computer programs used to develop and optimize optical lens systems. Accordingly, Defendants reserve the right to present this additional evidence and information in support of these Invalidity Contentions, and to supplement and amend these Invalidity Contentions in a manner consistent with the Federal Rules of Civil Procedure and the Court’s rules, including the Patent Rules.

### **Invalidity Contentions**

#### **I. Patent Rule 3-3(a)**

Defendants identify below the prior art now known to Defendants that anticipates or renders obvious the Asserted Claims. Defendants have identified at least one representative or exemplary disclosure of a limitation for each prior-art reference, for purposes of providing notice of their contentions regarding anticipation and obviousness. Accordingly, each and every disclosure of the same limitation in the same reference is not necessarily identified, even where a reference may contain additional support for or discussion of a particular claim limitation. Defendants and their experts may rely upon, discuss, analyze, and cite other portions of each prior-art reference that are similar to the representative or exemplary disclosures provided for the prior-art reference. To the extent that they are prior art, Defendants and their experts also reserve the

right to rely upon foreign counterparts of the U.S. patents and patent applications identified in the Invalidation Contentions and/or U.S. counterparts of foreign patents and foreign patent applications identified in the Invalidation Contentions. Defendants may also rely on statements found in the Asserted Patents and/or their prosecution histories, related patents and/or patent applications, any deposition or expert testimony, and/or documents or evidence submitted by Largan during this litigation.

Persons of ordinary skill in the art generally read an item of prior art as a whole and in the context of other publications and literature. Thus, to understand and interpret any specific statement or disclosure within a prior-art reference, such persons would rely on other information within the reference, along with other publications and their general scientific knowledge. Defendants therefore also may rely upon uncited portions of the prior-art references and on other publications and expert testimony to provide context and explanation, and as aids to understanding and interpreting the portions that are identified for the prior art.

**A. Prior Art Patents and Published Patent Applications Under 35 U.S.C. § 102(a).**

Country Of Origin	Patent/Pub. No.	Inventor	Filing Date	Issue/Pub. Date
United States	US 6,744,570 B1	Isono	Apr. 30, 2003	Jun. 1, 2004
United States	US 6,747,816 B2	Sato	Feb. 19, 2002	Jun. 8, 2004
United States	US 6,775,074 B2	Kasahara	Nov. 27, 2002	Aug. 10, 2004
United States	US 7,009,783 B2	Do	Jun. 27, 2003	Mar. 7, 2006
United States	US 7,009,784 B2	Amanai	May 28, 2004	Mar. 7, 2006
United States	US 7,095,570 B2	Amanai	May 11, 2004	Aug. 22, 2006
United States	US 7,274,518 B2	Tang	Oct. 6, 2006	Sep. 25, 2007

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