

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
WACO DIVISION

BILLJCO, LLC,

Plaintiff,

v.

APPLE INC.

Defendant.

Case No. 6:21-cv-528-ADA

JURY TRIAL DEMANDED

DEFENDANT APPLE, INC.'S
PRELIMINARY INVALIDITY CONTENTIONS

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Defendant Apple, Inc. (“Apple”) hereby provides its Preliminary Invalidity Contentions pursuant to the Joint Scheduling Order entered by the Court on September 11, 2021. *See* ECF No. 27. Based on its investigation to date, Apple hereby produces the prior art references on which these Contentions are based and other documents as mandated by the Joint Scheduling Order.

I. INTRODUCTION

These Preliminary Invalidity Contentions address the asserted claims identified by Plaintiff BillJCo, LLC (“BillJCo”) in its Preliminary Infringement Contentions. Should the Court allow BillJCo to later assert infringement of additional claims not asserted in BillJCo’s Preliminary Infringement Contentions, or to supplement its infringement contentions with additional infringement theories with respect to the asserted claims, Apple reserves the right to supplement its Preliminary Invalidity Contentions to assert invalidity of those additional claims and/or to assert invalidity based on the additional infringement theories. Apple also reserves the right to supplement its Preliminary Invalidity Contentions in response to information learned in fact or expert discovery, including identification of additional prior art.

Apple’s Preliminary Invalidity Contentions are based in whole or in part on its present understanding of the asserted claims and BillJCo’s Infringement Contentions, including the priority date of the asserted patents identified by BillJCo in its Infringement Contentions, including 8,566,839 (the “839 Patent”), 8,639,267 (the “267 Patent”), 8,761,804 (the “804 Patent”), 9,088,868 (the “868 Patent”), 10,292,011 (the “011 Patent”), and 10,477,994 (the “994 Patent”) (collectively, the “Asserted Patents”). Apple’s Invalidity Contentions are responsive at least to the same level of specificity of BillJCo’s Infringement Contentions.

Apple’s Invalidity Contentions may consider BillJCo’s apparent claim constructions, to the extent BillJCo’s constructions can be understood from BillJCo’s Infringement Contentions. Such

apparent constructions may be inconsistent with the constructions that Apple ultimately will proffer in this case. By including prior art that would anticipate or render obvious the asserted claims of the Asserted Patents based on BillJCo's disclosed and apparent claim constructions, or based on any other particular claim construction, Apple is not adopting BillJCo's claim constructions, nor is Apple admitting to the correctness of any particular claim construction. The Court has established separate deadlines for the parties' proposed claim constructions, and Apple will disclose its proposed constructions according to those deadlines. Solely for purpose of these Preliminary Invalidity Contentions, Apple may, if necessary, apply alternative, and even inconsistent, claim construction positions. Apple reserves all rights to amend these Preliminary Invalidity Contentions after the Court issues its claim construction ruling, or if the Court permits BillJCo to amend its Infringement Contentions.

Apple does not concede that BillJCo's Infringement Contentions provide the requisite level of specificity, and Apple provides these Invalidity Contentions without waiving any right to receive from BillJCo complete and specific infringement contentions. Moreover, nothing herein admits in any way that any of the accused products, or any of Apple's other products, infringe any of the asserted claims.

II. RELATED INVALIDITY CONTENTIONS AND DISCLOSURES

Apple expressly incorporates by reference as if fully set forth herein, and intends to rely on, each of the contentions, charts, prior art references, and other statements made or disclosed in any petitions for *inter partes* review filed by any party or third-party as to any asserted patent. Apple also incorporates by reference as if fully set forth herein all contentions, charts, prior art references, and other statements relating to any ground of invalidity identified by any potential or actual licensee to any asserted patent and by any party in any other past, present, or future litigation

involving many asserted patent or patents related to any asserted patent, including without limitation the following matters: *BillJCo, LLC v. Cisco Systems, Inc.*, Case No. 2-21-cv-00181 (EDTX); and *BillJCo, LLC v. Hewlett Packard Enterprise Company et al.*, Case No. 2-21-cv-00183 (EDTX). Apple also incorporates by reference all grounds of invalidity identified in any present or future reexamination, *inter partes* review, covered business method (CBM) patent review, or other post-issuance review by the Patent and Trademark Office of any asserted patent. Apple also incorporates by reference the production of documents associated with any grounds for invalidity for any asserted patent identified in this paragraph. Apple also incorporates any grounds of invalidity known to BillJCo or any affiliated party, whether or not disclosed. Apple requests that all such contentions from every case involving any asserted patent be produced to Apple as soon as possible after they are served on, or become known to, BillJCo.

Apple's discovery and investigation in connection with this lawsuit is continuing, and these Preliminary Invalidity Contentions are based on information obtained to date. Among other things, discovery is still underway, witnesses remain to be deposed, and the Court has not yet construed any terms of the Asserted Patents. Accordingly, Apple's Preliminary Invalidity Contentions are subject to modification, amendment, or supplementation in accordance with the Joint Scheduling Order, the Local Rules of the Western District of Texas, and/or the Federal Rules of Civil Procedure as this action progresses and additional information is obtained.

III. IDENTIFICATION OF PRIOR ART

Apple identifies the following prior art to the Asserted Patents. Apple contends that the prior art disclosed below generally all relate to the subject matter of one or more Asserted Patents

and collectively, they are all relevant at least as background of the art to each of the Asserted Patents, irrespective of the sub-section in which they are expressly cited.

Apple expressly reserves the right to at least use and rely on any of the prior art cited herein to establish or otherwise support Apple's contentions as to what was known in the state of the art during the pertinent time frame for the Asserted Patents. Apple further incorporates by reference all references listed on the face of the Asserted Patents. The inclusion or omission of a reference that is listed on the face of one or more of the Asserted Patents should not be deemed a waiver to rely on such references.

A. Anticipation

Appendices 839-, 267-, 804-, 868-, 994-, and 011- are claim charts that specifically identify prior art that anticipates and/or renders obvious each of the asserted claims of the Asserted Patents. In addition to the references specifically identified in the appendices, Apple also reserves the right to rely on any of the patents or publications deriving from applications in the respective claimed priority chains of the Asserted Patents, the references cited on the face of the Asserted Patents and related patents, any admitted prior art references in the specifications of the Asserted Patents and related patents, the prosecution histories of the Asserted Patents and related patents, the references cited in any USPTO, including PTAB proceedings, related to any asserted patent or related patents, or any references known to BillJCo or any affiliated party and the references cited in any invalidity contentions that have been or will be submitted in any action or proceedings involving any asserted patent or related patents.

Apple may also rely on expert testimony and any additional prior art identified during the course of discovery. Furthermore, Apple may rely on any of the prior art references in these Preliminary Invalidity Contentions to demonstrate a motivation to combine. Apple may also rely

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