UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
WACO DIVISION

CPC PATENT TECHNOLOGIES PTY LTD, Plaintiff, v. HMD GLOBAL OY, Defendant.	Case No.6:21-cv-00166-ADA

HMD'S INVALIDITY CONTENTIONS

Defendant HMD Global Oy ("Defendant" or "HMD") hereby provides the following disclosure of its Invalidity Contentions regarding U.S. Patent No. 9,665,705 (the "'705 Patent" or the "Asserted Patent"). These contentions are made only as to the Asserted Claims in the Infringement Contentions of Plaintiff CPC Patent Technologies Pty Ltd. ("Plaintiff" or "CPC"), which are claims 1, 10, 11, 15-17 of the '705 Patent (collectively, the "Asserted Claims").[1]

Fact discovery, including third-party discovery, is still open in this case. Accordingly, these Invalidity Contentions are made without the benefit of full discovery from CPC or from third parties, including manufacturers and providers of prior art systems and technology. HMD expressly reserves the right, and states its intent, to pursue such discovery and to amend its invalidity contentions as warranted.

Nothing in these contentions (or exhibits) should be construed as an admission regarding

[1] CPC has indicated that it has dropped previously asserted claims and is now asserting only claims 1, 10, 11, and 15-17 of the '705 patent. *See* Response to Defendant's Interrogatory No. 21, served February 24, 2022; *see also* email from George Summerfield, sent March 16, 2022, indicating that CPC is no longer asserting any claims of U.S. Patent No. 9,269,208.

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

infringement, either literally or under the doctrine of equivalents, or as an admission regarding HMD's understanding of the proper scope of the Asserted Claims. Given the ambiguities in CPC's infringement contentions and its implicit interpretation of the claims, the exemplary citations herein necessarily account for a variety of possible infringement arguments, including CPC's apparent (and at times erroneous) interpretations of its claims. In the context of anticipation, "[t]he principle of law is concisely embodied in the truism that: 'That which infringes if later anticipates if earlier.'" *Brown v. 3M*, 265 F.3d 1349, 1352 (Fed. Cir. 2001). Similarly, for obviousness, "obvious variants of prior art references are themselves part of the public domain." *In re Translogic Tech.*, 504 F.3d 1249, 1259 (Fed. Cir. 2007).

Further, although HMD expressly contends below that numerous terms in the Asserted Claims are indefinite, lack written description, and/or are not enabled, the claim charts provided herein assume the alternative and, without prejudice to those positions, identify invalidating disclosure from the identified art notwithstanding these defects in the claims.

I. Priority / Benefit Date

All Asserted Claims are entitled to a priority date no earlier than August 10, 2012, the actual filing date of U.S. Patent No. 9,269,208 (the "'208 Patent"). The '705 Patent is not entitled to the benefit of the filing date of U.S. Patent No. 8,266,442 (the "'442 Patent"), nor to any earlier filing date of which the '442 Patent claims benefit, because the '208 Patent fails to provide a "specific reference" to the '442 Patent as required by 35 U.S.C. § 120 and 37 C.F.R. 1.78. *See Medtronic CoreValve, LLC v. Edwards Lifesciences Corp.*, 741 F.3d 1359, 1363 (Fed. Cir. 2014).

Even if *arguendo* the '208 Patent provided a "specific reference" to the '442 Patent, the '705 Patent would at most be entitled to the August 13, 2004 filing date of International Patent Application No. PCT/AU2004/001083, of which the '442 Patent purports to be a National Stage

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

Entry. This is because Australian provisional patent application 2003904317 fails to provide a written description of the asserted claims and to enable the asserted claims.

For example, each Asserted Claim includes one of the following limitations, for which the Australian provisional patent application 2003904317 fails to provide any support under 35 U.S.C. § 119, 35 U.S.C. § 120, or 35 U.S.C. § 371: "receive a series of entries of the biometric signal, said series being characterized according to at least one of the number of said entries and a duration of each said entry" ('705 Patent Asserted Claims 1, 10); "receiving a series of entries of the biometric signal; determining at least one of the number of said entries and a duration of each said entry; mapping said series into an instruction; and populating the database according to the instruction" ('705 Patent Asserted Claim 11); "receiving a series of entries of the biometric signal, said series being characterised according to at least one of the number of said entries and a duration of each said entry; mapping said series into an instruction; [and] populating the database according to the instruction" ('705 Patent Asserted Claims 15, 16); and "receiving a series of entries of the biometric signal; determining at least one of the number of said entries and a duration of each said entry; mapping said series into an instruction; and populating the database according to the instruction" ('705 Patent Asserted Claim 17).

As further example, each Asserted Claim also includes the limitation of a "secure access signal" for which the Australian provisional patent application 2003904317 fails to provide any support under 35 U.S.C. § 119, 35 U.S.C. § 120, or 35 U.S.C. § 371.

As still further example, each Asserted Claim also includes the limitation of "an instruction" for which the Australian provisional patent application 2003904317 fails to provide any support under 35 U.S.C. § 119, 35 U.S.C. § 120, or 35 U.S.C. § 371

DOCKET ALARM

Find authenticated court documents without watermarks at docketalarm.com.

II. Invalidity By Prior Disclosure

Because each Asserted Claim is entitled to a priority date no earlier than August 10, 2012, each Asserted Claim is invalid under 35 U.S.C. § 102(b) in view of the February 24, 2005 publication of the specification of PCT/AU2004/001083, which is identical to the specifications of the Asserted Patent. An inventor's own work disclosing the claimed invention, published more than one year before the filing of a subsequent application, will be invalidating prior art to any patent issuing from that application absent a proper benefit claim to an effective filing date predating the published disclosure. *See Encyclopaedia Britannica, Inc. v. Alpine Electronics of Am., Inc.*, 609 F.3d 1345, 1347 (Fed. Cir. 2010); *Baxter Intern., Inc. v. McGaw, Inc.*, 149 F.3d 1321, 1334 (Fed. Cir. 1998); *Apple Inc. v. E-Watch, Inc.*, No. IPR2015-00414, 2016 WL 3476867, at *10 (P.T.A.B. June 22, 2016).

III. Invalidity By Prior Art

HMD identifies below prior art that invalidates each of the Asserted Claims. Each of the references below (and/or the underlying products described therein) qualifies as prior art under one or more sections of 35 U.S.C. §§ 102 and/or 103.

In addition to their invalidating disclosures, the patents and references provided herein may also be relied upon to show the status of the art at the relevant times, including the knowledge of persons of ordinary skill in the art and their motivations. These patents and references may also be used as secondary consideration evidence to demonstrate the obviousness of the claims, including to show contemporaneous development of the subject matter of the Asserted Claims. HMD may also rely on the background knowledge of the person of ordinary skill in the art.

The identification of prior art below is not exclusive. HMD may rely upon references cited throughout this document and the attached exhibits, as well as other art that may become known

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

and/or relevant during the course of this or related litigation. HMD further understands that third parties may have disclosed invalidity contentions and prior art to CPC which CPC has yet to produce in this litigation. HMD incorporates all such prior art and contentions into these disclosures.

HMD also incorporates as if fully set forth herein the complete file histories for the Asserted Patent and related patents and foreign counterparts, including any prior art or supporting documents cited therein. HMD may rely on the patent applicants' admissions concerning the scope of the prior art relevant to the Asserted Patent found in, *inter alia*: the patents specifications, the patents prosecution histories and that of their related patents and foreign counterparts; deposition testimony of the named inventor on the Asserted Patent; and the papers filed and any evidence submitted by CPC in connection with this or any other litigation. HMD not only relies upon the prior art disclosed herein, but also relies on any commercial embodiments and accompanying literature of the various assignees that correspond to the respective disclosures found within the prior art disclosed herein. The assignees' various and respective commercial embodiments and/or corresponding literature anticipate and/or render obvious the claims of the Asserted Patent for at least the reasons disclosed in these Invalidity Contentions and claim charts, as well as for other independent reasons found within the commercial embodiments and corresponding literature. HMD also reserves the right to rely on related patents, published applications, foreign patents or publications, and other patent documents as necessary to establish prior art status of the below references or clarify the disclosures cited.

A. Patents And Patent Publications

HMD contends that each prior art reference set forth in Exhibits B-1 – B-15, listed below, anticipates under 35 U.S.C. § 102 and renders obvious under 35 U.S.C. § 103 the Asserted Claims,

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

WHAT WILL YOU BUILD? | sales@docketalarm.com | 1-866-77-FASTCASE

fastcase® Smarter legal research.