

Subject: XR Communications v. Apple - infringement contentions
Date: Thursday, January 13, 2022 at 7:04:38 AM Central Standard Time
From: Lesley Hamming
To: rmirzaie@raklaw.com, pkroeger@raklaw.com, pwang@raklaw.com, jpickens@raklaw.com, mchan@raklaw.com, Christian W. Conkle, Jason Wietholter
CC: Laura Mulligan, Doug Winnard, Michael Pieja, Jennie Hartjes
Attachments: image001.png, 20220113_Apple_Ltr re infringement contentions.pdf

Counsel -

Please view the attached letter.

Thank you,
Lesley

Lesley M. Hamming

Associate

[200 South Wacker Dr, 22nd Floor, Chicago, IL 60606](#)

D 312-881-5995 **C** 847-309-3783 **F** 312-881-5191

GOLDMAN ISMAIL TOMASELLI BRENNAN & BAUM LLP

The information contained in this communication is confidential and should be considered to be attorney work product and/or attorney-client privileged. This communication is the property of Goldman Ismail Tomaselli Brennan & Baum LLP and is intended only for the use of the addressee. If you are not the intended recipient, please notify the sender, delete the message, and note that any distribution or copying of this message is prohibited. Any discussion of tax matters contained herein is not intended or written to be used, and cannot be used, for the purpose of avoiding any penalties that may be imposed under federal tax laws.

SENT VIA

January 13, 2022

SENT VIA E-MAIL

Reza Mirzaie
RUSS AUGUST & KABAT
12424 Wilshire Blvd. 12th Floor
Los Angeles, CA, 90025
rmirzaie@raklaw.com

Re: *XR Communications, LLC, dba Vivato Technologies v. Apple Inc.*, Case No. 6:21-cv-620-ADA, XR's Infringement Contentions

Dear Reza:

I write regarding several deficiencies in Plaintiff XR Communications' ("XR's") preliminary disclosure of asserted claims and infringement contentions ("PICs"), served on December 20, 2021. Under the Court's Order Governing Proceedings, XR was required to provide "a chart setting forth where in the accused product(s) each element of the asserted claim(s) are found." OGP Version 3.5.1 at 1. XR has failed to do so for at least the following reasons:

Claim 1

First, XR's PICs for claim 1 do not show "where in the accused product(s)" each claim element is found because they do not even map the claims to a single product. Claim 1 requires a device that includes a "**transceiver**" that both "receives a first [and second] signal transmission from a remote station" (element 1[d]) and uses a "set of weighting values . . . to construct one or more beam-formed transmissions" (element 1[g]). XR's claim chart for elements [1b] and [1d] points to the iPhone 12 as the device that allegedly includes this "transceiver." PICS, App'x A at 9 (Dec. 20, 2021). Element [1g] then refers to "**the transceiver**," confirming that it is referring to the same "transceiver" as elements [1b] and [1d]. For element [1g], however, XR alleges that "the transceiver" which performs the claimed "beam-form[ing]" is found in "**the remote station (e.g., a Wi-Fi access point)**." *Id.* at 36. XR's chart improperly combines features of two different products (only one of which is an Apple product) to satisfy the same limitation at different points in claim 1. It thus does not show "where in the accused" iPhone 12—or any other Apple product—"each element" of claim 1 is found, as the OGP requires.

Chicago 200 South Wacker, 22nd Floor, Chicago, IL 60606

Dallas 7557 Rambler Road, Suite 1450, Dallas, TX 75231

Santa Monica 100 Wilshire Boulevard, Suite 1760, Santa Monica, CA 90401

goldmanismail.com

Further, elements [1e] and [1f] require, respectively, “first signal information” and “second signal information [that] is different from the first signal information.” In other words, claim 1 requires that XR identify two “different” pieces of signal information. In its chart, however, XR points to only a single piece of alleged “signal information” for both elements: “parameters in the beamforming feedback matrix.” *Id.* at 18 & 27. Because the claim requires two “different” pieces of signal information, XR’s chart does not show “where in the accused products each” of these elements is found.

Claim 2

For claim 2, XR’s PICs merely point back to element [1d], stating, in their entirety, “*see supra* claim element [1d].” *Id.* at 47. But dependent claim 2 contains additional elements that are not present in claim [1d]. In particular, claim 2 claims “wherein the first signal transmission and the second signal transmission comprise electromagnetic signals comprising one more transmission peaks and one or more transmission nulls”—a requirement that is not present in claim [1d]. XR’s unexplained reference to a claim that lacks these limitations cannot satisfy the OGP’s requirement that XR show “where in the accused product” they are found.

Claims 4 and 12

For claims 4 and 12, XR’s PICs refer to the “Echo Show 10.” *Id.* at 47. This is not an Apple product at all—it appears to be a type of display sold by Amazon. Mapping claim 4 to an Amazon product is not a proper disclosure of infringement contentions against Apple.

Further, claims 4 and 12 require that a signal’s “content comprises data configured to be used by the remote station to modify the placement of one or more transmission peaks and one or more transmission nulls.” XR’s PICs for claim 4 merely point back to element [1d], stating, in its entirety, “*see supra* claim element [1d].” *Id.* at 47. XR’s PICs for claim 12, in turn, point back to claim 4.¹ But element [1d] has nothing to do with the use of “content” or “data” to “modify the placement of one or more transmission peaks and . . . nulls.” Indeed, element [1d] does not even mention content, data, peak, or nulls. Instead, it refers to the receipt of two generic “transmissions” simultaneously. XR’s unexplained cross-reference to a claim that lacks any of the elements of claims 4 and 12 cannot satisfy the OGP’s requirement that XR show “where in the accused product each element” of that claim is found.

Claim 8

For element [8d] of claim 8, XR again relies entirely on an unexplained reference to element [1g]. *Id.* at 50. But these two elements are different. Element [8d] requires a set of weighting values “configured to be used **by the remote station**” to engage in beam-forming. Element [1g], in contrast, claims a set of weighting values “configured to be used **by the transceiver**.” XR’s cross-reference thus cannot and does not show where XR believes the claimed weights “to be used by the transceiver” itself are found in any Apple product for claim 8.

Claims 9 and 16

For claims 9 and 16, it is not clear whether XR’s contentions contain a typographical error or whether the cross-references cited in those claims reflect XR’s actual positions. Claim 9, for example, claims “transmitting the third signal to the remote station via the antenna,” yet XR cites back to element [1a] that contains no mention of a third signal. Claim 16 likewise claims “wherein the first signal transmission and the second signal transmission comprise electromagnetic signals comprising one or more transmission peaks and one or more transmission nulls,” yet XR cites back to element [1d] that contains no mention of “electromagnetic signals” or “peaks” and “nulls.” Please clarify whether XR intended to cite to different elements of these claims, or whether this accurately reflects XR’s substantive position. If XR stands by

¹ XR’s PICs for claim 12 also refer to claim 11, which also is unrelated to the modification of peaks, nulls, or any other part of a signal.

January 13, 2022

Page 3

the cross-references provided, please explain why it believes they are appropriate given that claims 9 and 16 contain limitations not present in the referenced parts of claim 1.

Claim 15

The language of element [15g] tracks that of element [1g], and XR's contentions for both are the same. XR's contentions for element [15g] suffer from the same issues set forth above with respect to claim 1, and fail to comply with the OGP for the same reasons.

Indirect Infringement

XR stated that it asserts "indirect infringement under 35 U.S.C. §271(b)." PICS at 2 (Dec. 20, 2021). These allegations are improper because the Court has dismissed XR's indirect infringement claims (induced and contributory infringement).² (Dkt. No. 18). Please confirm that XR is withdrawing its indirect infringement claims at this time.

Doctrine of Equivalents

XR provided no substantive disclosures in support of its allegations of infringement under the doctrine of equivalents ("DOE"). XR instead stated *in toto*: "[t]o the extent [Apple] contends that other limitations are not literally infringed, [XR] asserts that the limitation is infringed under the doctrine of equivalents." PICS at 4 (Dec. 20, 2021). This is improper because it does not show "where in the accused product(s) each element of the asserted claim(s) are found"—or even where **any** element is found—under the doctrine of equivalents as required by the OGP. To the extent XR intends to assert a theory of infringement under the doctrine of equivalents, please confirm that it will supplement its infringement contentions to include a disclosure of that theory on an element-by-element basis.

If Plaintiffs are unwilling to provide, by January 21, supplemental contentions that address each of the deficiencies set forth above, please provide your availability for a meet-and-confer on January 19.

Apple's evaluation of XR's infringement contentions is preliminary and ongoing. Apple's discussion of particular claim elements or parts of elements in this letter is not an admission that these or other elements or parts of elements are present in any Apple product or that XR's contentions for any elements are sufficient. Apple reserves the right to raise other issues and identify additional deficiencies based on its further assessment, the parties' and the Court's positions on claim construction, fact or expert discovery, or any other information put forward in this or the CRSR Related Cases.

Sincerely yours,



Lesley M. Hamming

CC:
Paul A. Kroeger
pkroeger@raklaw.com

² The dismissal was made without prejudice to XR seeking discovery relevant to these allegations, to which Apple reserves its right to raise appropriate objections, and without prejudice to XR amending the Complaint to allege induced infringement and contributory infringement.

January 13, 2022
Page 4

Philip X. Wang
pwang@raklaw.com
James N. Pickens
jpickens@raklaw.com
Minna Chan
mchan@raklaw.com
Christian Conkle
cconkle@raklaw.com
Jason Wietholter
jwietholter@raklaw.com