

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

JAWBONE INNOVATIONS, LLC,

Plaintiff,

v.

APPLE INC.,

Defendant.

Civil Action No. 6:21-cv-00984-ADA

JURY TRIAL DEMANDED

DEFENDANT’S PRELIMINARY INVALIDITY CONTENTIONS

Pursuant to the Local Patent Rules and the Court’s Scheduling Order Defendant Apple Inc.. (“Defendant”) respectfully submits these preliminary invalidity contentions with respect to the asserted claims of U.S. Patent Nos.8,019,091 (the “’091 Patent”); 8,280,072 (the “’072 Patent”); 7,246,058 (the “’058 Patent”); 10,779,080 (the “’080 Patent”); 11,122,357 (the “’357 Patent”); 8,467,543 (the “’543 Patent”); 8,503,691 (the “’691 Patent”); 8,321,213 (“the ’213 Patent); and 8,326,611 (the “’611 Patent”) (collectively, the “Asserted Patents”) identified by Plaintiff Jawbone Innovations, LLC, (“Jawbone” or “Plaintiff”) in its Infringement Contentions.

The currently Asserted Claims, as reflected in Plaintiff’s Infringement Contentions, are:

- Claims 1-18 of the ’091 Patent;
- Claims 1-4 of the ’058 Patent;
- Claims 1-9 of the ’072 Patent;
- Claims 1-20 of the ’080 Patent;
- Claims 1-20 of the ’357 Patent;
- Claims 1, 3, 6-13, 19-23, and 26 of the ’543 Patent;

- Claims 1-46 of the '691 Patent;
- Claims 1-42 of the '213 Patent; and
- Claims 1-44 of the '611 Patent.

As detailed further below, the Asserted Patents are anticipated by, or obvious in view of, one more of the prior art references being produced concurrently pursuant to 35 U.S.C. § 102 and/or § 103, as well as invalid under 35 U.S.C. §§ 101 and 112.

I. PRELIMINARY STATEMENT

These invalidity contentions and eligibility contentions are based on Defendant's current knowledge, understanding, and belief of the Asserted Patents and prior art, of Plaintiff's infringement theories (inasmuch as they can be inferred from its Infringement Contentions), and of the facts and other information available as of the date of these invalidity contentions. Defendant's investigation, discovery, and analysis of information related to this action is ongoing. Additional discovery, elucidation of Plaintiff's impermissibly vague infringement contentions, and/or orders of the Court may require Defendant to amend or supplement these invalidity contentions and eligibility contentions, and Defendant expressly reserves the right to do so as the case proceeds. These contentions represent Defendant's good-faith effort to provide a comprehensive identification of prior art relevant to this case, but Defendant reserves the right to modify or supplement its prior art list and invalidity contentions and eligibility contentions at a later time with, or based upon, pertinent information that may be subsequently discovered.

A. No Waiver

Nothing in these contentions is intended, nor should be construed, as a waiver of any noninfringement position or argument under 35 U.S.C. §§ 101 or 112. Defendant's statements herein (including the accompanying claim charts) reflect Defendant's present understanding of the

purported scope of the claims as alleged by Plaintiff in its Infringement Contentions (as best those contentions can be understood in light of their present deficiencies).

The patent claims have yet to be construed. As a result, Defendant has based these contentions upon its knowledge and understanding of the potential scope of the Asserted Claims at this time, and, in part, upon the apparent interpretations of the Asserted Claims advanced by Plaintiff in its Infringement Contentions. Defendant may disagree with Plaintiff's interpretation of the meaning of many terms and phrases in the Asserted Claims. Defendant has provided these contentions based in part on its present understanding of Plaintiff's apparent constructions and interpretations of the Asserted Claims. These contentions do not represent Defendant's agreement or view as to the proper interpretation of any claim term contained therein. Any similarity between any apparent claim interpretation in any of Defendant's charts of prior art references and Plaintiff's contentions is not an admission or agreement with Plaintiff about the meaning of any claim term, but rather a reflection of the fact that the subject matter Plaintiff believes is claimed is present in the prior art, or that the claims are otherwise invalid. These contentions are made in the alternative, and should not be interpreted to rely upon, or in any way affect, the non-infringement arguments Defendant may assert in this case. Defendant reserves the right to amend, supplement, or materially modify these contentions as the case proceeds. Defendant also reserves the right to amend, supplement, or materially modify its contentions based on any infringement and/or additional claim construction positions that Plaintiff may take in this case.

Defendant also reserves the right to amend, supplement, or materially modify its contentions in response to any claim construction or interpretation positions that Plaintiff may take. Defendant also reserves the right to assert that a claim is indefinite, not enabled, or fails to meet the written description requirement of 35 U.S.C. § 112 based on any claim construction or

interpretation position Plaintiff may take in this case or based on any claim construction the Court may further adopt in this case.

B. No Admission

Nothing disclosed herein is an admission or acknowledgement that any product accused of infringement by Plaintiff in its Infringement Contentions (the “Accused Products”), or any of Defendant’s other products or services, infringes any of the Asserted Claims.

Defendant further notes that Plaintiff appears to rely upon overly broad interpretations of the Asserted Claims. At the same time, Plaintiff’s Infringement Contentions are in most places too general and vague to discern Plaintiff’s infringement theories and how exactly Plaintiff contends each Accused Product meets or practices each element of the Asserted Claims. As a result, Defendant has been prejudiced in its ability to prepare these invalidity contentions. In addition, Plaintiff’s Infringement Contentions, in many cases, continue to fail to put Defendant on notice of Plaintiff’s interpretation of the Asserted Claims, further prejudicing Defendant’s ability to identify relevant prior art. In addition, Plaintiff has identified theories of infringement under the doctrine of equivalents for only claim 6 of the ’091 Patent, claim 14 of the ’213 Patent, and claim 1 of the ’611 Patent. Defendant has relied on Plaintiff’s apparent representation that it has no doctrine of equivalents theories for any other claims in preparing these invalidity contentions and eligibility contentions, and any attempt by Plaintiff to present an untimely doctrine of equivalents argument would be severely prejudicial to Defendant. To the extent that Plaintiff is later permitted by the Court to amend its contentions to cure the deficiencies of its current contentions or to pursue any currently undisclosed doctrine of equivalents theories, Defendant expressly reserves the right to supplement or amend these invalidity contentions to account for such amendments.

To the extent that any of the prior art references discloses the same functionality or feature of any of the Accused Products, Defendant reserves the right to argue that said feature or functionality does not practice any element of any of the Asserted Claims, and to argue, in the alternative, that if said feature or functionality is found to practice any element of any of the Asserted Claims, then the prior art reference demonstrates that the element is not novel, is obvious, and/or is otherwise not patentable. To the extent that any of the prior art references discloses the same functionality or feature of any of the Accused Products, Defendant reserves the right to argue that said feature or functionality does not practice any element of any of the Asserted Claims, and to argue, in the alternative, that if said feature or functionality is found to practice any element of any of the Asserted Claims, then the prior art reference demonstrates that the element is not novel, is obvious, and/or is otherwise not patentable.

Attached hereto are representative claim charts that identify where the elements of the Asserted Claims of the Asserted Patents may be found in the prior art and further identifying why those references are not novel or non-obvious. The references cited in the attached claim charts may disclose the limitations of the Asserted Claims expressly and/or inherently. The suggested obviousness combinations may be presented in conjunction with or in the alternative to Defendant's contentions regarding anticipation. These obviousness combinations should not be construed to suggest that any reference included in any combination is not anticipatory in its own right. Further, to the extent that Plaintiff contends that any of the references identified does not constitute prior art under 35 U.S.C. § 102, Defendant reserves the right to rely upon other prior art references in the same patent family with substantially identical disclosures as evidence of invalidity based on the same theories as those disclosed below.

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