

**UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

JAWBONE INNOVATIONS, LLC,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD.  
AND SAMSUNG ELECTRONICS  
AMERICA, INC.,

Defendants.

Civil Action No. 2:21-cv-00186-JRG

**DEFENDANTS' INVALIDITY CONTENTIONS AND ELIGIBILITY CONTENTIONS**

Pursuant to the Local Patent Rules and the Court's Scheduling Order Defendants Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. (collectively, "Defendants") respectfully submit these invalidity contentions and eligibility 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"); and 8,503,691 (the "'691 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; and
- Claims 1-46 of the '691 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 at SJAW\_INV\_000001 - SJAW\_INV\_007764 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 Defendants' 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. Defendants' 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 Defendants to amend or supplement these invalidity contentions and eligibility contentions, and Defendants expressly reserve the right to do so as the case proceeds. These contentions represent Defendants' good-faith effort to provide a comprehensive identification of prior art relevant to this case, but Defendants reserve the right to modify or supplement their 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 invalidity contentions and eligibility contentions is intended, nor should be construed, as a waiver of any noninfringement position or argument under 35 U.S.C. §§ 101 or 112. Defendants' statements herein (including the accompanying claim charts) reflect Defendants' 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, Defendants have based these invalidity contentions and eligibility 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. Defendants may disagree with Plaintiff's interpretation of the meaning of many terms and phrases in the Asserted Claims. Defendants have provided these invalidity contentions and eligibility contentions based in part on their present understanding of Plaintiff's apparent constructions and interpretations of the Asserted Claims. These invalidity contentions and eligibility contentions do not represent Defendants' agreement or view as to the proper interpretation of any claim term contained therein. Any similarity between any apparent claim interpretation in any of Defendants' charts of prior art reference 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 invalidity contentions and eligibility contentions are made in the alternative, and should not be interpreted to rely upon, or in any way affect, the non-infringement arguments Defendants may assert in this case. Defendants reserve the right to amend, supplement, or materially modify its invalidity contentions and eligibility contentions as the case proceeds. Defendants also reserve the right to amend, supplement, or materially modify its invalidity contentions and eligibility contentions based on any infringement and/or additional claim construction positions that Plaintiff may take in this case.

Defendants also reserve the right to amend, supplement, or materially modify their invalidity contentions and eligibility contentions in response to any claim construction or interpretation positions that Plaintiff may take. Defendants also reserve 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 Defendants’ other products or services, infringes any of the Asserted Claims.

Defendants further note 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. For example, as explained in Defendants’ February 16, 2022, letter, Plaintiff’s Infringement Contentions fail to clearly identify the aspects or features of the Accused Products that Plaintiff contends meet the elements of the Asserted Claims. As a result, Defendants have been prejudiced in their ability to prepare these invalidity contentions and eligibility contentions. In addition, Plaintiff’s Infringement Contentions, in many cases, continue to fail to put Defendants on notice of Plaintiff’s interpretation of the Asserted Claims, further prejudicing Defendants’ ability to identify relevant prior art. In addition, Plaintiff has identified theories of infringement under the doctrine of equivalents for only claims 6 and 8 of the ’091 Patent. Defendants have 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 Defendants. 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, Defendants expressly reserve the right to supplement or amend these invalidity contentions and eligibility contentions to account for such amendments.

Furthermore, these invalidity contentions and eligibility contentions have been prepared in reliance on Plaintiff's interrogatory responses in which it declined to identify any particular claim element that it alleges is not met by the prior art.

To the extent that any of the prior art references disclose the same functionality or feature of any of the Accused Products, Defendants reserve 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 Defendants' 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 do not constitute prior art under 35 U.S.C. § 102, Defendants reserve the right to rely upon other prior art

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