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

UNILOC USA, INC., et al,	§	
Plaintiffs,	§	
	§	Case No. 2:16-cv-00741-JRG
v.	§	LEAD CASE
	§	
ADP, LLC,	§	
BIG FISH GAMES, INC.,	§	Case No. 2:16-cv-00858-JRG
BLACKBOARD, INC.,	§	Case No. 2:16-cv-00859-JRG
BOX, INC.,	§	Case No. 2:16-cv-00860-JRG
ZENDESK, INC.,	§	Case No. 2:16-cv-00863-JRG
Defendants.		

UNILOC USA, INC., et al,	§	
Plaintiffs,	§	
	§	Case No. 2:16-cv-00393-RWS
v.	§	LEAD CASE
	§	
AVG TECHNOLOGIES USA, INC.,	§	
BITDEFENDER LLC,	§	Case No. 2:16-cv-00394-RWS
PIRIFORM, INC.,	§	Case No. 2:16-cv-00396-RWS
UBISOFT, INC.,	§	Case No. 2:16-cv-00397-RWS
KASPERSKY LAB, INC.,	§	Case No. 2:16-cv-00871-RWS
SQUARE ENIX, INC.,	§	Case No. 2:16-cv-00872-RWS
Defendants.		

PLAINTIFFS' OPENING CLAIM CONSTRUCTION BRIEF

Overview of the Patents

Plaintiffs ("Uniloc") have asserted claims from four IBM patents, all with effective filing dates of December 14, 1998.

The '578 patent[1] describes (what were in 1998) innovative methods of managing configurable application programs on a computer network for a large enterprise. The IBM inventors filed the '766 patent[2] as a divisional of the '578, and thus it has the identical written description ("the '578 disclosure").

The '466 patent[3] also describes methods of managing application programs, but the written description of that patent differs from the '578 disclosure. The IBM inventors filed the '293 patent[4] as a divisional of the '466, and thus it has a written description identical to that of the '466. (Pinpoint references in this brief to the '466/'293 written description ("the '466 disclosure") will be to the '466 patent. (Ex. C)).

Both the '578 and '466 disclosures describe a computer network, which connects each individual user's computer terminal ("client terminal," or simply "client") to a remote server ("server") responsible for supporting that client, as well as for supporting a number of other clients. The network, in turn, connects the remote servers to a central network management server. FIG. 1 of the '466 patent graphically illustrates this server/client arrangement:
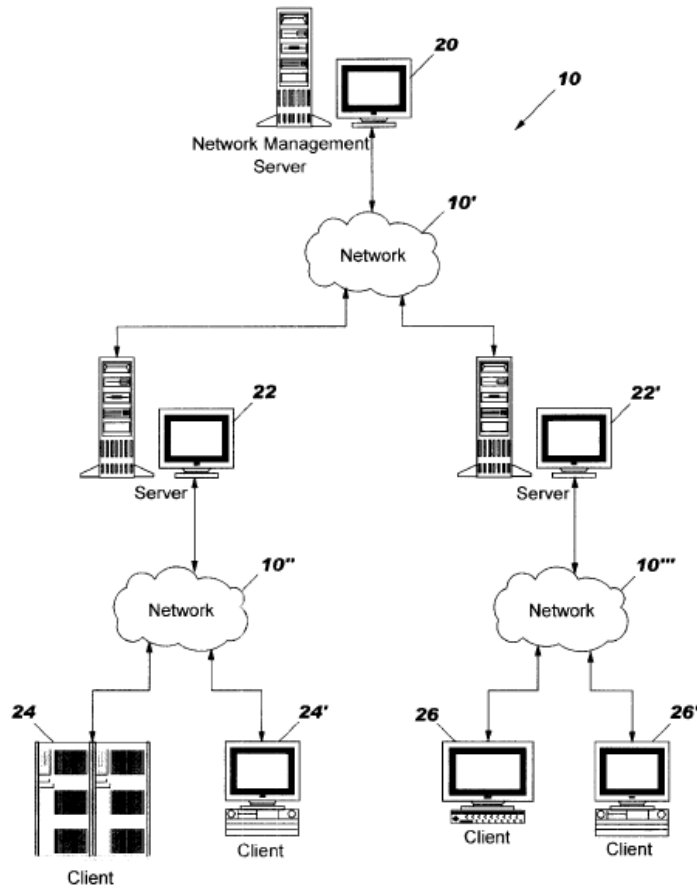
---

[1] U.S. Patent No. 6,324,578 (Ex. A).
[2] U.S. Patent No. 6,728,766 (Ex. B).
[3] U.S. Patent No. 6,510,466 (Ex. C).
[4] U.S. Patent No. 7,069,293 (Ex. D).

FIG. 1

An application program ("application") is software written to perform a particular function for a user (as opposed to system software, which is designed to operate the network.) Common examples of applications are word processing applications (e.g., Microsoft Word) and spreadsheets (e.g., Excel).

In 1998, designers of computer networks for large enterprises were confronted with the problem of peripatetic users, i.e., users who login at different times from different clients. The IBM inventors, in these patents, describe innovative ways, circa 1998, they had reduced to practice to allow a peripatetic user to access the user's authorized applications from any client on the network, while maintaining the user's own selected preferences.

Computer network designers in 1998 were also confronted by the problems of efficiently distributing applications throughout the enterprise, and of then frequently (and efficiently) updating those applications, while maintaining consistency among users, as to both application updates and administrator preferences. The IBM inventors devised, and reduced to practice, innovative ways to accomplish that.

Finally, the IBM inventors devised methods to manage the allocation of licenses to applications in the enterprise environment, where the number of users accessing, or seeking to access, an application would exceed the number of existing licenses.

<div align="center"><u>**Claim Construction Issues**</u></div>

Exhibit A to the Joint Claim Construction Statement and Prehearing Memorandum ("JCCS") listed 14 claim terms/phrases on which the parties had not reached agreement. Since filing that document, the parties have eliminated certain disputes, and narrowed others. Uniloc below lists, in what it sees as the order of priority, the remaining claim construction disputes.

1. **Whether the '578 and '293 patent claims require applications be executed at the client.**

In networks of the type the patents describe, a user can execute (i.e., run) an application in one of two ways: 1) the application could be downloaded to, and then executed on, the client terminal, or 2) the application could remain on the server and be executed by the user remotely.

The parties agree the asserted claims of the '466 patent (and claims 3, 9, and 15 of the '766 patent) are drawn to the first method. But the parties disagree as to the '578 and '293 patents. Uniloc's position is the claims of the '578 and '293 patents cover both methods; by contrast, defendants would limit the claims of those patents, as with the claims of the '466 patent, to the first method.

Uniloc's position is easy to explain: <u>All</u> claims of the '466 patent (and claims 3, 9, and 15 of the '766 patent) have language unambiguously requiring execution on the client. The independent claims of the '466 patent, claims 1, 15, and 16, recite providing an application "*to the client for execution.*" (The relevant claims of the '766 patent have identical language.) Thus, during the prosecution history of the '466 patent, the inventors acknowledged that, in the claims they were pursuing in the '466 patent, the applications "are executed at a client device rather than having the application program execute at the server." (Ex. E at UNILOC_IBM_0630)

But no similar language appears in the claims or prosecution of the '578 and '293 patents. For example, while claim 1 of the '578 patent reads "executing the application program," it says nothing as to where the application, when executed, resides. The inventors appear to have drafted the claims of the '578 patent to cover *either* method.

The claims of the '293 patent are directed to an exchange of applications from a central management server to the remote servers, not from the remote server to the client. Thus, those claims do not even mention executing the application program. During the prosecution history of the '293 patent, the inventors distinguished certain prior art by pointing out the claim (that would become claim 1 of the '293 patent) recited "an exchange, *not involving a client*, to enable availability of a program" at a target on-demand server. (Ex. F at UNILOC_IBM_0668)

In the JCCS, defendants sought a construction of the '578 and '293 patent claims that would require execution at the client. Their mechanism for obtaining that construction was to ask that "application programs/applications" in all four of the patents, including the '578 and '293 patents, be defined as program code that "executes locally at the client." (To the same end, they also proposed adding "for download" to the availability the '293 patent claims would require.)

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.

fastcase®
Smarter legal research.