

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

The four patents in these actions are directed towards four different inventions, with each invention relating to a particular portion of an enterprise computer network. The patents are largely independent. A company could infringe a patent covering one portion of its network, but not infringe a second patent covering a second portion, if that company chose not to use the invention of the second patent in that second portion.

The claims of the '466 patent are directed to methods, systems, and products for downloading applications to clients for execution at the clients. Thus, all of the claims of that patent incorporate specific language requiring execution at the client, namely: “providing an instance of the... application... to the client for execution.”

But the claims of the '578 and '293 patents are directed towards different inventions, which inventions can be practiced in networks where execution is instead at a server (as well as in networks where execution is at the client). The inventors therefore did not incorporate in the claims of those patents language requiring execution at the client.²

A. The claim construction issue reduces to whether the inventors disavowed the ordinary and usual meaning of the claims of the '578 and '293 patents.

In the Opening Claim Construction Brief, Uniloc stated that an *application* is software written to perform a particular function for a user -- as opposed to system software, which is designed to operate the network. Un.Br. 3. Uniloc also pointed out that nothing in the ordinary

² Exhibit A to the Joint Claim Construction Statement and Prehearing Memorandum (“JCCS”) listed 14 claim terms/phrases on which the parties have not reached agreement. For several of those, the disagreement centered on the same issue: whether the '578 and '293 patent claims require applications be executed at the client. Rather than repeat arguments, Uniloc, in its briefing, identified that as a separate, overriding claim construction issue and consolidated its arguments under the above heading.

and usual meaning of “application” would limit the term to software executed only at a client, as applications are frequently executed at remote servers. Un.Br. 6. Uniloc also argued that no other language in the asserted claims of the ’578 and ’293 patents, if given its ordinary usual meaning, would require applications be executed at the client. Un.Br.5. Defendants did not dispute any of those propositions.

Uniloc also recited the Federal Circuit’s position, settled en banc in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005), that claims should be given their ordinary and customary meaning, with but two exceptions: where the patentees act as their own lexicographer or where the patentees disavow the full scope of the claim term in the specification or during prosecution. Again, defendants do not dispute that is the law. Further, defendants do not argue the lexicographer exception applies to this issue in these patents.

Thus, this claim construction issue reduces to whether the patentees disavowed a scope of the ’578 and ’293 patent claims that would allow execution at the server. Uniloc found no disavowal. Un.Br. 7. Defendants argue otherwise. D.Br. 5-10.

B. What is required to find a disavowal.

The courts have repeatedly held that the evidence of disavowal must be clear and unmistakable:

“[D]isavowal requires that ‘the specification [or prosecution history] make clear that the invention does not include a particular feature.’” *Pacing Techs., LLC v. Garmin Int’l, Inc.*, 778 F.3d 1021, 1024 (Fed. Cir. 2015)(internal citations omitted).

“We have found disavowal or disclaimer based on clear and unmistakable statements by the patentee that limit the claims, such as ‘the present invention includes...’ or ‘the present invention is...’ or ‘all embodiments of the present invention are...’.” *Id.* (internal citations omitted); *see also David Netzer Consulting Eng’r LLC v. Shell Oil Co.*, 824 F.3d 989, 994 (Fed. Cir. 2016), *cert. denied*, 137 S. Ct. 695 (2017).

As discussed above, given their ordinary meaning, the claims of the '578 and '293 patents would cover portions of networks that execute applications on a server (as well as networks that execute applications on the client). To establish a disavowal, defendants must point to statements or arguments that clearly and unmistakably give up that broad coverage. For example, "prior art reference X does not anticipate the claims of the '578 patent because in reference X, applications are executed on a server, rather than the client."

C. Defendants' alleged disavowal.

This Reply will step through each of what defendants argue constituted a disavowal. None meet the above criteria.

1. The '578 Specification

Defendants first argue the inventors "distinguished" the "claimed invention" on the basis of executing at the server. D.Br. 6. They cite the following sentence from the specification of the '578 patent:

Each of these "mobility" systems typically do not address the full range of complications which may arise in a heterogeneous network utilizing differing devices and connections.

('578 patent at: 3:5-8), which followed a description of various mobility systems (2:35-3:4), including two (2:50-55) that executed applications at the server. But the above language, disparaging certain mobility systems, says nothing about executing at the server. Rather, the language criticizes certain mobility systems not for where they execute applications, but for not addressing "the full range of complications which may arise in a heterogeneous network utilizing different devices and connections." This limitation of prior art mobility systems (further explained at 3:12-27 of the '578 patent) would appear, from the intrinsic record, to be

independent of where applications are executed, as the systems disparaged included *all* described in 2:35-3:4 of the '578 specification, not just the systems (2:50-55) that execute at the server.

Patent specifications, in the portion typically entitled “background of the invention,” commonly discuss the pluses and minuses of existing products or systems. Here, if the specification had recited the comparative advantages and disadvantages of executing applications at a server, that comparison would not normally be viewed as “disavowing” a claim scope broad enough to cover either approach. But the '578 specification does not even go that far, as it nowhere criticizes, even impliedly, executing applications on the server.

Defendants also argue that the disclosed embodiments in the '578 patent specification reflect that applications are executed at the client. D.Br. 6-7. But the section of the specification entitled “DETAILED DESCRIPTION OF PREFERRED EMBODIMENTS” that begins at 6:29 and ends at 11:22, and which steps through FIGS. 2-4 of the '578 patent, makes no mention of where the applications are executed. Rather, it describes, as does the claims, downloading not the application, but only the “application launcher program,” which need not include the entire application. The only reference in the entire patent to an embodiment that describes execution at the client is in a section (11:27-12:36) describing the “[a]lternative preferred embodiments ... described in [the '466] patent application patent.” As discussed above, all the claims in the '466 patent require execution as the client. That an alternate embodiment (from the '466 patent) executes at the client does not disavow the '578 patent claims' coverage of systems or programs that execute on a server.

In any event, as a general rule, a court may not read into the claims limitations from an embodiment, particularly when, as here, the limitation does not appear in all embodiments. *See SuperGuide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004)(finding “a

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