

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

UNILOC USA, INC., et al,	§	
Plaintiffs,	§	
v.	§	Case No. 2:16-cv-00741-RWS
	§	LEAD CASE
	§	
ADP, LLC,	§	
BIG FISH GAMES, INC.,	§	Case No. 2:16-cv-00858-RWS
Defendants.		

**DEFENDANT BIG FISH GAMES, INC.’S MOTION TO STRIKE
CERTAIN MEANS-PLUS-FUNCTION CLAIMS FROM
PLAINTIFFS’ INFRINGEMENT CONTENTIONS**

Defendant Big Fish Games, Inc. (“Big Fish”) hereby moves to strike certain means-plus-function claims from Plaintiffs Uniloc USA, Inc.’s, and Uniloc Luxembourg, S.A.’s (together, “Uniloc”) Infringement Contentions.

INTRODUCTION

Uniloc’s Infringement Contentions, as supplemented on August 21, 2017 (“Supplemental Infringement Contentions”), should be stricken for failure to comply with the Patent Local Rules with respect to the asserted claims drafted in means-plus-function format pursuant to pre-AIA 35 U.S.C. § 112, ¶ 6 (“Asserted MPF Claims”).¹ Patent Local Rule 3-1(c) requires Uniloc to specifically identify in its infringement contentions the structure, act, or material in the Big Fish accused instrumentality that Uniloc contends satisfies each limitation drafted in means-plus-function format. Yet, even after Uniloc elected to supplement its contentions after it reviewed Big Fish’s source code pursuant to paragraph 3(a)(i) of the Discovery Order—a deadline which

¹ The Asserted MPF Claims are: claims 17, 27, and 38 of U.S. Patent No. 6,324,578 (“the ’578 patent”); claims 12 and 17 of U.S. Patent No. 7,069,293 (“the ’293 patent”); and claims 15, 16, 17, 22 and 30 of U.S. Patent No. 6,510,466 (“the ’466 patent”). The ’578 patent, the ’293 patent, and the ’466 patent are collectively referred to as the “Asserted Patents.”

Uniloc belatedly tried to delay until after the fact discovery period—Uniloc’s Supplemental Infringement Contentions still fail to identify any specific structures embodied in the Big Fish accused instrumentality and do not provide any explanation as to what corresponding structures Uniloc contends are disclosed in the specifications of the Asserted Patents for each means-plus-function limitation.

Indeed, while Uniloc appears to contend that the Asserted Patents disclose certain algorithmic structures for the means-plus-function limitations (which are required to provide structure for software-based inventions, like those allegedly claimed in the Asserted Patents), Uniloc’s Supplemental Infringement Contentions do not articulate where the Asserted Patents disclose those algorithms, what those algorithms might be, or provide any explanation as to how Big Fish’s accused instrumentality reads onto the unidentified algorithms. Uniloc’s repeated refusal to provide sufficient infringement contentions (and repeated failure to properly supplement its interrogatory responses, which is the focus of a separate motion to compel) has resulted in Uniloc obfuscating its infringement theory for the means-plus-function limitations throughout the discovery period, which is now set to close. Uniloc’s tactics have severely prejudiced Big Fish’s ability to defend itself in this case, including Big Fish’s ability to prepare expert reports on invalidity and non-infringement—reports that are necessarily contingent upon Uniloc’s contentions with respect to structure.

Accordingly, because Uniloc has failed to meet its burden under the Patent Local Rules to allege a sufficient claim of infringement with respect to the Asserted MPF Claims, Uniloc’s Infringement Contentions for those claims should be stricken.

BACKGROUND

When this case began, Uniloc accused Big Fish of infringing sixty (60) claims across the three Asserted Patents.² Although nearly two-thirds of those originally asserted claims were drafted in means-plus-function format pursuant to § 112, ¶ 6, Uniloc did not identify any corresponding structure (algorithms or otherwise) disclosed in the specification of the Asserted Patents or any structure allegedly present in the Big Fish accused instrumentality. Instead, Uniloc merely cross-referenced to the steps in the method claims, without any further explanation of the alleged structures.

Despite repeated requests from Big Fish and other Defendants for Uniloc to comply with the deadlines in General Local Order 13-20, which required Uniloc to reduce the number of asserted claims, Uniloc refused to do so. Until just twelve days ago, Uniloc continued to assert all sixty claims against Big Fish. Uniloc only reduced its asserted claims on September 6, 2017, when it elected to assert claims 1, 8, 17, 27, and 38 of the '578 patent; claims 1, 12, and 17 of the '293 patent; and claims 15, 16, 17, 22, and 30 of the '466 patent. Of the thirteen remaining claims, ten are drafted in means-plus-function format—claims 17, 27, and 38 of the '578 patent; claims 12 and 17 of the '293 patent; and claims 15, 16, 17, 22, and 30 of the '466 patent (collectively, the “Asserted MPF Claims”).

During the claim construction process, Uniloc failed to sufficiently describe the structure and/or algorithms allegedly disclosed in the specification for the more than 100 distinct elements within the sixty initially asserted means-plus-function claims. *See* Dkt. 218 at 1-3 (describing the parties' means-plus-function exchanges). Between the service of the parties' initial P.R. 4-2 disclosures on March 23, 2017, and the end of June, the parties exchanged multiple rounds of

² Uniloc's Disclosure of Asserted Claims and Infringement Contentions, dated November 10, 2016, are attached hereto as Exhibits A-D.

proposals related to the myriad means-plus-function claims, but continued to disagree as to the identification of the alleged structures. None of Uniloc's various proposals during that period specifically described the corresponding structures/algorithms for performing various computing functions as required for the software-based limitations in the Asserted MPF Claims. Uniloc instead cited wholesale sections of the specifications of various patents (some of which are not even asserted in this case), and made no effort to explain how the lengthy cited paragraphs provided algorithmic structure that corresponded to the means-plus-function claim elements. *See, e.g., Uniloc USA, Inc., et al. v. AVG Tech. USA, Inc.*, 2:16-cv-00393-RWS ("AVG Action"), Dkt. 188-2. Thus, the parties were never able to reach agreement on the applicable structure for the means-plus-function claims.

As the claim construction hearing drew closer, it became apparent that Uniloc's proposals for many, if not all, of the means-plus-function terms did not contain algorithmic, step-by-step procedures or code for accomplishing the functional acts claimed, as required to avoid a finding of indefiniteness for software-based limitations. Accordingly, upon the filing of Defendants' Supplemental Responsive Claim Construction Brief, which was spurred by Uniloc's eleventh hour reversal of its prior positions concerning previously agreed-upon claim terms, Defendants Big Fish and ADP also moved for leave to file a supplemental claim construction brief to demonstrate that the means-plus-function claims are indefinite. *See* Dkts. 217, 218. That motion remains pending.

Uniloc reviewed Big Fish's source code on July 17 and 18, 2017. Despite the 30-day deadline to supplement its Initial Infringement Contentions following source code review under paragraph 3(a) of the Discovery Order in this case, Uniloc did not request an extension of that deadline until August 14, 2017, just days before its supplemented contentions would have been

due. *See* Dkt. 106, ¶ 3(a); Ex. E (Email from A. Jacobs, dated Aug. 14, 2017). Paragraph 3(a) provides that “if a party claiming patent infringement asserts that a claim element is a software limitation, the party need not comply with P.R. 3-1 for those claim elements until 30 days after source code for each Accused Instrumentality is produced by the opposing party.” Dkt. 106, ¶ 3(a). Uniloc’s requested extension would have delayed its supplementation until either 30 days after the Court issued its claim construction order or two weeks following an unnoticed and previously unrequested deposition of Big Fish’s source code representative. Big Fish, still facing over 60 asserted claims and without having received any information regarding Uniloc’s infringement theory, agreed to a four day extension. In addition, Big Fish specifically requested that Uniloc’s supplementation “properly identify: (1) the structures disclosed in the patents-in-suit that allegedly correspond to the claimed functions; and (2) the Big Fish structures that Uniloc alleges to satisfy each of the identified structures in the patents-in-suit.” Ex. E (Email from D. Ball, dated Aug. 15, 2017).

Uniloc served its Supplemental Infringement Contentions on August 21, 2017.³ Ex. E (Email from A. Jacobs, dated Aug. 21, 2017). The very next day, Big Fish notified Uniloc that its Supplemental Infringement Contentions still failed to identify means-plus-function structures as required by the Patent Local Rules and again requested compliant contentions. Ex. I (Email from T. Geiger, dated Aug. 22, 2017). Despite further requests and subsequent meet-and-confers between the parties’ counsel, Uniloc has repeatedly refused to provide any further supplementation or to identify structures.

³ Uniloc’s Supplemental Infringement Contentions are attached as Exhibit F, G, and H. (Plaintiffs’ Initial and Supplemental Infringement Contentions are throughout together referred to as the “Infringement Contentions.”)

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