

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

UNILOC USA, INC., et al.,
Plaintiffs,

v.

AVG TECHNOLOGIES USA, INC.,
KASPERSKY LAB, INC.,
SQUARE ENIX, INC.,
Defendants.

Case No. 2:16-cv-00393-RWS
LEAD CASE

Case No. 2:16-cv-00871-RWS
Case No. 2:16-cv-00872-RWS

UNILOC USA, INC., et al.,
Plaintiffs,

v.

ADP, LLC,
BIG FISH GAMES, INC.,
Defendants.

Case No. 2:16-cv-00741-RWS
LEAD CASE

Case No. 2:16-cv-00858-RWS

**PLAINTIFFS' MOTION TO RECONSIDER A PORTION OF THIS COURT'S
MEMORANDUM OPINION AND ORDER CONSTRUING CERTAIN TERMS**

This Court issued a claim construction order (“Opinion”), Dkt. No. 233¹, on August 16, 2017. Shortly thereafter, Plaintiffs (“Uniloc”) filed a Motion to Reconsider a Portion of that Opinion, Dkt. No. 266, but this Court’s decision on eligibility, Dkt. No. 267, mooted that motion before Defendants could file an opposition.

Uniloc now renews the portions of that previously filed motion that relate to the ’578 and ’293 patents. In this Motion, Uniloc requests the Court to modify, in part, the Court’s claim construction of “application launcher program” and “application program,” as it applies to those patents.

¹ All citations in this Motion are to the docket in 2:16-cv-00741-RWS.

In support of this request, Uniloc submits the accompanying declaration of Dr. Michael Shamos.²

Other actions

After the Federal Circuit remanded this action with respect to '578 and '293 patents, Uniloc 2017³, the current owner, filed actions on those patents against other entities. Because of venue restrictions imposed by *TC Heartland LLC v. Kraft Foods Grp. Brands LLC*, 137 S. Ct. 1514 (2017), those actions had to be filed in districts other than this one. Currently, actions on these patents are thus pending before eight other District Court judges.

The procedure in each of those districts is to proceed to claim construction during the earlier phases of the action. However, Uniloc expects that most, perhaps all, of those courts will delay their own decision on claim construction, to await this Court's decision on this motion.

I. The Court should modify its construction of “application launcher program,” as to the '578 patent.

This Court construed “application launcher program” across all three patents in which it then appeared – including the '578 patent – as “a program distributed to a client to initially populate a user desktop and *to request an instance of the application for execution at the client*” (emphasis added). Opinion at 27-31. Uniloc now asks the Court, with respect to claims of the '578 patent, to modify the second half of that construction to read “to request execution of the application program.”

² If this Court holds a hearing on the motion, Dr. Shamos will testify.

³ As the Federal Circuit added Uniloc 2017 to this action as a plaintiff, Legacy Plaintiffs will move to add that entity's name to the case caption.

To support that request, Uniloc highlights several factual statements and legal conclusions in the Opinion that need to be reconsidered, and sets forth the reasons for reconsideration.⁴

- A. The Opinion erred in using the prosecution history of the '466 patent to construe claims of the '578 patent.**
- 1. Under Abbott Laboratories, the prosecution history of the '466 patent cannot be used to interpret the claims of the '578 patent.**
- a. The patents are not formally related.**

The Opinion (at 29-30) erroneously relies on statements in the prosecution history of the '466 patent to construe how this term is used in claims of the '578 patent. The Opinion overlooks that the separate applications for the '578 patent and the '466 patent were not continuations, divisionals, or continuations-in-part of each other. They were filed as independent, patentably distinct applications, on the same date. Further, the inventive entities differed: the '578 application included an inventor (Kaminsky) not an inventor on the '466 application; the '466 application, in turn, included inventors (McGarvey and Salahshour) not on the '578 application. Even though the applications were co-pending, shared some common inventors, and were commonly assigned, the prosecution history of one cannot limit the claims of the other.

⁴ The Opinion (at 4) contains an error. It copies, and labels as claim 1, what is actually claim 15 of the '578 patent. The copied claim (15) is narrower than claim 1, because claim 15 requires the server “provide an instance of the application program” responsive to a request from a user, a limitation not in claim 1. Perhaps this mistake – copying the wrong claim as claim 1 – caused the BACKGROUND section of the Opinion (at 4) to state, erroneously:

The '578 patent relates to obtaining user and administrator preferences for the application programs installed at a server and providing these preferences along with an instance of the application program to a client for execution.

(emphasis added). Inspection of the *actual* claim 1 readily shows nothing in it supports the underlined portion of that statement.

Abbott Laboratories v. Dey, L.P., 287 F.3d 1097 (Fed. Cir. 2002) is on point:

It is true that the '839 and '301 patents are commonly owned by Abbott, and the inventor of the '839 patent is one of the three inventors of the '301 patent. However, the '839 application was not filed as a continuation, continuation-in-part, or divisional application of the '301 application. These applications have no formal relationship and were presented to the patent office as patentably distinct inventions. ... Under these circumstances, we do not see a basis for concluding that statements made about the characteristics of the surfactant claimed by the '301 patent should be attributed to the improved surfactant claimed by the '839 patent, simply because the applications had a common assignee, one common inventor, and similar subject matter. We therefore conclude that the above-quoted statements from the prosecution history of the '301 patent do not create an estoppel with respect to the '839 patent.

Id. at 1104-05 (emphasis added); *see also In re Berg*, 140 F.3d 1428, 1435 n. 7 (Fed. Cir. 1998) (noting, in the context of considering a double patenting rejection, that two applications filed by the same inventor were “not related as by continuation, continuation-in-part, or divisional” and that filing such two separate applications implied “that each application is independent and patentably distinct”).

The Opinion (at 11-14) justified reliance on the '466 prosecution history by citing *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1306-07 (Fed. Cir. 2007) and *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004). The Opinion, however, overlooked that the applications in those cases were formally related, as continuations, continuations-in-part, or divisionals, unlike the relationship between the '578 application and the '466 application. That is the critical distinction *Abbott Laboratories* highlights.

Additionally, in *Verizon* and *Microsoft*, the inventive entities were the same. Here, the inventive entities differ. The inventive entity of the '466 application did not include Kaminsky and thus that entity would not have authority to surrender, on Kaminsky's behalf, the scope of claims that Kaminsky, *et al.*, had obtained.

b. Incorporation by reference would be limited only to the '466 application.

The Opinion, at 11-12, observes the applications for the '578 and '466 patents were filed the same day and each application incorporated the other by reference. Although incorporation by reference would make the disclosure contained in the '466 *application* part of the disclosure of the '578 patent, it does not create a formal relationship of the sort discussed in *Abbott*. Equally important, incorporation by reference of the application does not make any other part of the prosecution history intrinsic evidence.

Goldenberg v. Cytogen, Inc., 373 F.3d 1158 (Fed. Cir. 2004), is on point. In that action, as with IBM here, Goldenberg filed two separate applications the same day, the '261 and '262 applications. In a first office action, the examiner issued a double patenting rejection of the claims of the '261 over the claims of the '262, and then Goldenberg filed a response distinguishing them. *Id.* at 1161. The Federal Circuit held the court could “reference [] the contents of the '262 *application* as it existed when Goldenberg distinguished” (emphasis added) it from the '261 application in the office action response. The court analogized it to citing prior art, which makes that prior art intrinsic evidence. Thus “the district court was entitled to treat the '262 application as part of the intrinsic evidence of the ['261 application] patent when construing the claim terms.” *Id.* at 1168.

However, the Federal Circuit held the district court erred in considering later portions of the file history as intrinsic evidence:

While the content of the '262 application at the time it was distinguished from the '261 application constitutes part of the prosecution history ..., subsequently added new matter is not similarly incorporated.

Id. The court went on to describe the significance of its ruling:

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