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.,
        Defendants.
	Case No. 2:16-cv-00393-RWS
	LEAD CASE
	
	Case No. 2:16-cv-00871-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' REPLY IN SUPPORT OF MOTION TO RECONSIDER
A PORTION OF THIS COURT'S MEMORANDUM OPINION AND ORDER –
<u>00741 (Dkt. No. 233, - 00393 Dkt. No. 210) -- CONSTRUING CERTAIN TERMS</u>**

<u>**ORAL ARGUMENT REQUESTED**</u>

The parties appear to agree as to how the terms in question are used in the art. Dr. Michael Shamos provided ample evidence "application launcher program" was a term of art that meant "a computer program that launches, i.e., starts another computer program," which usage would include programs that launched applications to be executed at a server. Dkt. No. 344-1 ("Shamos Decl.") at ¶ ¶ 26-32.[1] Big Fish's Opposition, Dkt. No. 352 ("Opp."), did not argue otherwise

Similarly, "application program" (or "application") is a term the art commonly uses to refer to software written to perform a particular function for a user – as opposed to system software, which is designed to operate the network – whether executed at a client or on a server, or whether executed within the browser window.

1. **The specification of the '578 patent does not narrow the patent's claims beyond their ordinary meaning**.

The issue as to claim construction is whether anything in the intrinsic record of the '578 patent would exclude from the asserted claims embodiments in which an application executes on the server, rather than on the client, or executes within the browser window. Dr. Shamos found no support for that exclusion. He even cited examples in the '578 patent's specification where an application would be executed on the server or within the browser window. Shamos Decl. at ¶ ¶ 47-49, 51-52.

Big Fish does not dispute those examples or otherwise respond to Dr. Shamos's evidence.

2. **Non-incorporated portions of the '466 Prosecution History cannot be used to interpret claims of the '578 patent**.

Big Fish does not dispute the '466 and '578 patents lack a familial relationship, which can only be formed if the patents are related by continuations, continuations-in-part, or divisionals.

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[1] As with the Motion, all citations in this Reply are to the docket in 2:16-cv-00741-RWS. The identical Motion, however, was also filed in 2:16-cv-00393-RWS, in which Kaspersky Lab, Inc. is a defendant. -393 Dkt. No. 293. Kaspersky does not oppose the Motion.

Applications that do not have such a relationship are "presented to the patent office as patently distinct inventions," and *for that reason* the intrinsic record of one is not automatically part of the intrinsic record of the other. *Abbott Laboratories v. Dey, L.P.*, 287 F.3d 1097, 1104-05 (Fed. Cir. 2002). Patents are not formally related simply because their applications are commonly owned, or have an overlap of inventors, or have similar subject matter. *Id.*

Although Big Fish argues there was only a partial overlap of inventors in *Abbott*, Opp. at 13-14, the same was true here. Big Fish also argues here the applications were filed the same day, but simultaneous filing does not create the familial relationship *Abbott* required. In fact, *Abbott* itself cited as support for its holding *In re Berg*, 140 F.3d 1428, 1435 n. 7 (Fed. Cir. 1998), in which two applications had been filed the same day by the same inventor, without effecting a familial relationship. *Abbott*, 287 F.3d at 1105.

Finally, Big Fish argues the Court should make an exception to *Abbott* because the '578 application incorporated the '466 Application[2] by reference. But *Goldenberg v. Cytogen, Inc.,* 373 F.3d 1158, 1167 (Fed. Cir. 2004) would reject that argument. *Goldenberg* also involved two patent applications (the '261 and '262 applications) filed the same day, and the '262 application had been cited in the prosecution of the '261 application. Because there was no familial relationship the court excluded from the intrinsic record of the '261 application events in the prosecution history of the '262 application other than at the '261 application itself. *Id.* at 1167 ("this court's precedent takes a narrow view on when a related patent or its prosecution history is available to construe the claims of a patent at issue and draws a distinct line between patents that have a familial relationship and those that do not").

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[2] To avoid confusion, this Reply will use the capitalized terms "'466 Application" to refer to the application for the '466 patent and "'466 Prosecution History" to refer to the non-incorporated portion of the prosecution history that followed the filing of the '466 Application.

Big Fish attempts to distinguish *Goldenberg* as involving new material subsequently added through a continuation in part. Opp at 14. But the court excluded that material because, unlike the '262 application, it had not been incorporated. The same is true here.

Big Fish cites *Microsoft Corp. v. Multi-Tech Systems, Inc.*, 357 F.3d 1340 (Fed. Cir. 2004), and five other cases that found statements made in the prosecution of other patents to have been relevant to claim construction of a patent in suit. Opp. at 10-11. But in all six[3] of those cases – unlike here – the patents *had a familial relationship*, and thus were not subject to the absolute bar *Abbott* imposed.

In any event, even if the '466 and '578 patents had had a familial relationship, the applicants' arguments in the '466 Prosecution History cited in the Opinion, Dkt. No. 233 ("Opin.") at 29-30, would not support narrowing of the '578 patent's claims beyond their ordinary meaning. The Opinion cited as its sole support for its construction of "application program," the statement in the Prosecution History of the '466 patent:

> an instance of the application program is requested through the desktop but executes locally at the client as a separate application from the browser interface. For example, Lotus Notes would not execute within the browser window.

Opin. at 20. But, as the Motion (at 8-10) explains, that statement was not directed to the meaning of "application program." The applicants were simply explaining the claimed invention *of the '466 patent* executed locally at the client. All the claims of the '466 patent contained the language "*provid[e]an instance* of [the selected] application program[] *to the client* for execution responsive

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[3] *Microsoft*, 357 F.3d at 1342 (same parent application); *Alexsam, Inc. v. Best Buy Co., Inc.*, No. 2: 10CV93, 2012 WL 1188406 (E.D. Tex. April 9, 2012) (continuation); *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314 (Fed. Cir. 2003) (continuation-in-part); *Teva Pharms USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335 (Fed. Cir. 2015) (continuations); *Capital Mach. Co., Inc. v. Miller Veneers, Inc.*, 524 Fed. Appx 644, 649 (Fed. Cir. 2013) (parent or child); *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1306-07 (Fed. Cir. 2007)(divisional).

to the selection" (emphasis added), which language does not appear in the asserted claims of the '578 patent, or the '293 patent. The asserted claims of the '578 and '293 patents, normally construed, would thus include all applications, including those executed within the browser window.

3. The prosecution history of the '766 patent cannot be used to create an estoppel.

Nothing in the prosecution history of the '766 patent contradicts Dr. Shamos's evidence the art's use of "application launcher" to describe "a computer program that launches, i.e., starts, another computer program," would have been broad enough to include its launching the program on *either* a client or a server.

At some point during the prosecution history of the '766 patent, well after the '578 patent had issued, the examiner cited three prior art references, which the applicants then distinguished by describing features of those references in a way Big Fish argues would have created an *estoppel* as to the '766 patent.[4] Opp. at 10-12.

The Motion, citing *Microsoft*, raised two separate arguments why such an estoppel would not have extended to the '578 patent. First, the court should "limit [the] relevance" of statements in the prosecution history of another patent to "interpretation of the [other patent] only" where those statements "refer more specifically to the references cited against the claims of [that other] patent only." *Microsoft*, 357 F.3d at 1349 n. 5. Big Fish does not dispute the statements listed in the Order (at 29) clearly fall in that category. On that basis alone, the Court should reject an estoppel here.

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[4] Whether those statements would actually create an estoppel, even as to claims of the '766 patent, is doubtful. *See* Dkt. No. 165 at 8-10.

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