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

UNILOC USA, INC. et al.,	)	
	)	
Plaintiffs,	)	
	)	No. 2:16-cv-00741-JRG
v.	)	LEAD CASE
	)	
ADP, LLC, et al.,	)	
	)	
Defendants.	)	
	)	

BLACKBOARD'S REPLY IN SUPPORT OF ITS MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM AND IMPROPER VENUE

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Uniloc's attempt to save the asserted patents from invalidity under 35 U.S.C. § 101 fails because the patents' claims are directed to nothing more than the abstract ideas of routine business practices of businesses delivering their products and services ("application program[s]") to their customers through on-demand servers. Although each asserted patent adds its own gloss to such routine business practices – providing customers with a list of available products or services from which the customer can select which product or service it wants ('466 patent); tailoring a product or service to each customer's preferences ('578 patent); and centralized distribution of a product or service ('293 patent) – none of the asserted patents offers any specific improvement in computers beyond widely available generic computing technologies. Nowhere to be found in the asserted patents is any new kind of computer hardware or unique computer algorithm.

In its opposition, Uniloc repeatedly claims that the asserted patents "solve a problem particular to computers, namely providing application programs to roaming users who login from different clients with varying hardware and operating systems." *E.g.*, *Opp'n* at 11. Even assuming such problem existed in the prior art (which it did not), the asserted claims do not recite any computer hardware or software that is new to solve that problem. Nowhere does Uniloc identify any asserted claim elements that purportedly expressly address the problem. This is exactly the sort of failure that renders the claims patent ineligible. *See Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1359 (Fed. Cir. 2016) ("[T]he asserted claims do not contain any limitations that address the protection gap or volume problem, e.g., by requiring automatic updates to the antivirus or antispam software or the ability to deal with a large volume of such software … [W]hen a claim directed to an abstract idea 'contains no restriction on how the result is accomplished . . . [and] [t]he mechanism . . . is not described,

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although this is stated to be the essential innovation[,]' then the claim is not patent-eligible.").[1] The problem identified by Uniloc and the asserted patents are thus ships passing in the night – they do not meet up in the asserted claims. The asserted patents thus fail the test for patent eligibility under Section 101.

I. THE ASSERTED PATENTS CLAIM ABSTRACT IDEAS.

A. Uniloc's Own Descriptions Reveal the Abstract Ideas of the Asserted Patents.

Uniloc describes the '466 patent as follows: "application programs may be installed at the server and an instance of a selected application program may be provided to a client when needed for execution." *Opp'n* at 4. This precisely aligns with Blackboard's description of the '466 patent as the abstract idea of "providing customers with a list of available products or services from which the customer can select which product or service it wants."

Uniloc describes the '578 patent as follows: "delivering configured applications when demanded by a user" using "configurable preferences." *Opp'n* at 5. This too precisely aligns with Blackboard's description of the '578 patent as the abstract idea of "tailoring a product or service to each customer's preferences."

Finally, Uniloc describes the '293 patent as follows: "The file packet is distributed to the target on-demand server to make the application program available for use by a user at a client." *Opp'n* at 5. This also precisely aligns with Blackboard's description of the '293 patent as the abstract idea of "centralized distribution of a product or service."

[1] Although discussed in Blackboard's motion, Uniloc's opposition does not address the *Intellectual Ventures I LLC v. Symantec Corp.* case at all.

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B. The Asserted Claims Do Not Recite Any Specialized Computer Hardware or Software Beyond the Abstract Ideas.

1. The Asserted '466 Patent Claims Recite Generic Computers Performing Abstract Ideas.

Uniloc argues that the '466 patent is not abstract because "it inherently require[s] a computer." *Opp'n* at 11. That is not the test for patent eligibility. If that were the test, all patent claims reciting computer technologies would be patent eligible, and clearly that is not the case. Only those patents that purport to provide a specific computer improvement may be eligible. *See In Re TLI Commc'n LLC Patent Litig.*, 823 F.3d 607, 612 (Fed. Cir. 2016). Uniloc identifies nothing in the asserted independent claims of the '466 patent that purportedly recites – without a further claim construction – any specific computer improvement. Rather, Uniloc resorts to offering a construction for a single term in a futile attempt to save those claims. For the term "an instance of the selected one of the plurality of application programs," Uniloc offers the proposed construction "a modified version of an application program that is adapted to the type of hardware and/or operating system from which a user requests execution." *Opp'n* at 12-13. Uniloc argues that this claim construction is important to expressing the solution to the "problem of providing seamless integration of application access across heterogeneous networks." *Id.* at 12. However, Uniloc's proposed construction – even if accepted – is unhelpful to its cause. Nothing about Uniloc's proposed construction expresses that the adaptation of the application program occurs for each of multiple "heterogeneous networks." And even if it did, such tailoring of a product or service is nothing more than abstract. *See Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369 (Fed. Cir. 2015) ("[A] newspaper might advertise based on the customer's location. Providing this minimal tailoring—e.g., providing different newspaper inserts based upon the location of the individual—is an abstract idea."). Uniloc's reliance on *Core Wireless* is misplaced because the claim language itself taught a specific type of

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computer improvement in the nature of a specialized algorithm. *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 2016 U.S. Dist. LEXIS 123232, at *31-32 (E.D. Tex. Aug. 8, 2016) ("The claim teaches further delaying or metering the transmission by an integer multiple of the transmission time interval. This is an archetypal example of an invention directed to 'improv[ing] the functioning of the computer itself' or 'improv[ing] an existing technological process' that Courts have repeatedly held to be patent-eligible.").

Uniloc devotes much of its argument about the '466 patent to two dependent claims – claims 2 and 7. Of course, this does not help any of the independent claims of the '466 patent. In any event, Uniloc's arguments about the dependent claims also fail. Uniloc argues that the "display regions" are responsive to information "maintained at the server" (for claim 2), and that the "user desktop interface is configured responsive to an identifier of the user" (for claim 7). Again, such tailoring a product or service to a customer's tastes is nothing more than an abstract idea. *See Intellectual Ventures I LLC*, 792 F.3d at 1369; *Clear with Computers, LLC v. Altec Indus., Inc.*, Nos. 6:14-cv-79 & -89, 2015 WL 993392, at *4 (E.D. Tex. Mar. 3, 2015) ("[T]he asserted claims are directed to the abstract idea of creating a customized sales proposal for a customer."); *OpenTV, Inc. v. Netflix Inc.*, 76 F. Supp. 3d 886, 892 (N.D. Cal. 2014) ("The concept of gathering information about one's intended market and attempting to customize the information then provided is as old as the saying, 'know your audience.'").

2. The Asserted '578 Patent Claims Recite Generic Computers Performing Abstract Ideas.

Stripping away Uniloc's flawed argument that claims reciting computers cannot be invalid under Section 101, Uniloc's attempt to save the independent claims of the '578 patent boils down to this: an application program is executed using sets of "configurable preferences," and such a term requires claim construction before a Section 101 analysis. *Opp'n* at 14-15. But

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