EXHIBIT A

December 2, 2016

Hon. Rodney Gilstrap
United States District Court for the Eastern District of Texas
Sam B. Hall, Jr. Federal Building and United States Courthouse
100 East Houston Street
Marshall, TX 75670

Re: Uniloc USA, Inc., et al. v. Box, Inc., No. 2:16-cv-860

Dear Judge Gilstrap:

I. Plaintiff's Position: Claim Construction Is Necessary To Inform The Court's § 101 Analysis

Box filed a motion to dismiss Uniloc's complaint, arguing that the asserted claims are invalid under 35 U.S.C. § 101. *See* Dkt. No. 89 ("Motion" or "Mot."). Claim construction is necessary to determine whether the Asserted Patents[1] contain patent-eligible subject matter. *See Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Canada*, 687 F.3d 1266, 1273-74 (Fed. Cir. 2012) ("[claim construction] will ordinarily be desirable – and often necessary – to resolve claim construction disputes prior to a §101 analysis."). The inquiry under *Alice* is whether "the claims at issue" are directed to an abstract idea, and, if so, whether "the elements of each claim both individually and 'as an ordered combination'" transform the nature of the claim into a patent-eligible application. *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014). Conducting that claim-by-claim, element-by-element inquiry would benefit from a fuller record in this case as the claims are specific to problems in application management within networks.[2]

The Asserted Patents relate to network management and application management when users roam on a computer network from computer to computer. Box argues that: (1) the asserted claims of the Asserted Patents are directed to abstract ideas (Mot. at 11-21), and (2) all claims fail to recite inventive concepts (*id.* at 21-26). Box's arguments are based on an overly-broad claim construction disregarding the explicit problem of application management for roaming users in computer networks to which the claims are directed. For example, as to the '293 Patents, Box argues that the asserted claims cover "the abstract idea of software distribution," Mot. at 11. However, the asserted claims of the '293 Patent recite elements such as: "network management server," "on-demand server," "a segment configured to initiate registration operations," "application program" and "file packet," that are terms material to the claims and, thus, require construction.

Box's argument that the above terms merely represent abstract ideas is inapposite, as it reads out inventive concepts to particular problems in network and application management; construction is thus required. The foregoing terms must be construed to give the claims proper context and meaning. Interpreting the interaction of these features as an abstract idea is simply unreasonable. *See, Genband USA LLC v.*

[1] U.S. Patent Nos. 6,324,578 ("the '578 Patent"), 6,510,466 ("the '466 Patent), and 7,069,293 ("the '293 Patent").

[2] Courts in this district have routinely denied Rule 12 motions made on §101 grounds as premature. *See, e.g., Phoenix Licensing, LLC, et al. v. Advance America, Cash Advance Centers, Inc.*, 2:15-cv-01375, Dkt. No. 25 (E.D. Tex. Sept. 30, 2016); *Wetro Lan LLC v. Phoenix Contact USA Inc.*, 2016 U.S. Dist. LEXIS 41012 *9-11 (E.D. Tex. Mar. 29, 2016).

Metaswitch Networks Ltd., No. 2:14-cv-33-JRG, Dkt. No. 582 (E.D. Tex. Sep. 29, 2016). In *Genband*, one of the claims was directed to first and second protocol agents working in IP telephony devices to communicate using a third protocol. *Id. at 73-74.* The Court rejected defendants' arguments that the claim covered an abstract idea. *Id.* As in *Genband*, the claims of the '293 Patent reciting the above elements "are not abstract but rather specific components that have a concrete nature and perform specific functions within a network." *Id.* at 76.

The '293 Patent, as well as the other Asserted Patents, solve particular problems in the computer field, thus rendering them patent eligible. *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259 (Fed. Cir. 2014) (upholding a claim as a patent-eligible inventive concept where the claimed solution was "necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks" because "it amount[ed] to an inventive concept for resolving this particular Internet-centric problem"). For example, the '293 Patent solves a longstanding problem in the industry for roaming users on networks so as to provide hardware portability by distributing application programs registered at on-demand servers according to client machine characteristics across heterogeneous networks. The solutions of the '293 Patent, as well as the other Asserted Patents, significantly improve mobility and hardware portability of the application programs, specifically in networks with roaming users on different machines.

Each of the terms of the '293 Patent, as well as the other Asserted Patents, are intended to place meaningful limits on claims that distinguish the claimed inventions from the prior art and are relevant – at a minimum – to the Court's second-step determination of whether the elements transform the nature of the claim into a patent-eligible application. For example, the claim element "a segment configured to initiate registration operations" of the '293 patent includes "an import data file and a call to an import program executing on a target station." This is a solution to the longstanding problem of roaming users in networks as described above. As the '293 patent describes, "a profile manage import call is included in the distributed file packet along with an import text containing the data required to properly install and register the application program on the on-demand server and make it available to authorized users." The presence of the above language in the '293 specification "is the single best guide to the meaning of the claim terms (*Phillips*, 415 F.3d at 1318). As there are clearly factual disputes regarding the proper context and meaning of this and other disputed elements, construction of the asserted claims is required.[3]

For example, as to the '466 Patent, Box argues that the claims cover "the abstract idea of software distribution." Mot. at 11. The asserted claims of the '466 Patent recite material elements such as: "installing a plurality of application programs at the server," "login request," "user desktop," "plurality of display regions" and "application management information," that require construction. As to the '578 Patent, Box argues that the claims cover "the abstract idea of customization based on preferences." Mot. at 18. The asserted claims of the '578 Patent again recite material elements such as: "application program," "configurable preferences," "application launcher program," "user set," "executing the application launcher program," "administrator set," "configuration manager program" and "instance," that require construction.

[3] There are also numerous means plus function terms found in the Asserted Patents that need to be construed.

The asserted claims are directed to particular methods and apparatuses that represent specific solutions to problems identified in the Asserted Patents. Thus, Uniloc requests that the Court defer deciding the Motion until the completion of claim construction.

II. Defendant's Position: No Claim Construction Can Render Plaintiff's Claims Patentable

Uniloc's portion of the joint letter fails to (a) identify evidence from the specifications or file histories that shows *why* certain terms need construction, or (b) explain *how* construction of those terms would materially affect the Section 101 analysis. Rather, Uniloc simply lists claim terms for each patent-in-suit and then states without support that the terms "require construction." Even if Uniloc is correct, patents whose claims "require construction" are still appropriately invalidated at the pleading stage if the claims would still be directed to ineligible subject matter even if construed as a patentee suggests. *See, e.g.*, *Preservation Wellness v. Allscripts Healthcare*, 2:15-cv-1559-WCB, 2016 WL 2742379, at *6 (E.D. Tex. May 10, 2016); *Rothschild Location Techs. LLC v. Geotab USA, Inc.*, 6:15-cv-682-RWS-JDL, 2016 WL 3584195, at *4 (E.D. Tex. January 4, 2016).

Uniloc already received—and declined—a number of opportunities to identify evidence that its patent terms required construction. In July and August of this year, Uniloc filed opposition and sur-reply briefs in *Uniloc v. BitDefender*, 16-cv-394-RWS (E.D. Tex.) against a motion to dismiss two of the three patents asserted in this action. Uniloc chose not to identify any evidence that its claims required construction, nor even a single construction that would, if adopted, limit the claims to patentable subject matter. Instead, Uniloc relied on the plain language of the claims and on attorney argument to assert patentability. *See* 16-cv-394 (RWS) D.I. 26 at 9–12, D.I. 32 at 8–9. Uniloc's Opposition Brief in that action discussed many of the same terms identified in this letter as requiring construction (*e.g.* "user desktop interface," "plurality of display regions," and "on-demand server"), yet Uniloc never argued that those terms required a specialized construction.[4] *See* 16-cv-394 (RWS), D.I. 26 at 11, 15. Similarly, Uniloc presented no argument to Judge Schroeder that construction of its claims drafted in means-plus-function form was material to the validity of its patents.[5] Uniloc also failed to identify any claim construction evidence or explain how construction would materially affect the Section 101 analysis in any of the four letter briefs it has recently submitted to the Court on this topic. Dkt. Nos. 34-1, 36-1, 75-1, 83-1. Uniloc's repeated failure to provide this information is fatal to its position.

The intrinsic evidence supports Box's position that the claims in this suit require no specialized constructions to determine the § 101 issue. For example, Uniloc argues in this letter that the '293 Patent's "segment configured to initiate registration operations" includes "an import data file and a call to an import program executing on a target station." But this is not a proffered construction—instead,

[4] Uniloc's absence of explanation is in sharp contrast with the cases it cites for the proposition that courts "routinely" await claim construction to decide § 101 motions. First, in *Wetro Lan*, the patentee had "proposed a construction . . . through its expert witness" and the defendant had "not responded with specificity"; here, Uniloc has not explained why construction could be necessary, let alone proposed a construction via an expert. 2016 WL 1228746, at *4. Second, *Phoenix* depended on a prior ruling in which contentious claim construction briefing had already been submitted. *See* No. 14-cv-965, D.I. 184 at 3-4. Here, no such claim construction disputes exist.

[5] As this court has noted, "the mere presence of means plus function terms does not require a deferred ruling on validity under § 101." *See Landmark Tech., LLC v. Assurant, Inc.*, No. 6:15- CV-76-RWS-JDL, 2015 WL 4288211, at *2 (E.D. Tex. July 14, 2015).

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