

**UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF TEXAS  
TYLER DIVISION**

**UNILOC USA, INC. and**

**UNILOC SINGAPORE PRIVATE LIMITED,**

Plaintiffs,

v.

**NATIONAL INSTRUMENTS CORP., ET AL.**

Defendants.

Civ. Action No.: 6:10-cv-00472-LED

**JURY TRIAL DEMANDED**

**PLAINTIFFS' NOTICE THAT CASE IS READY  
FOR STATUS CONFERENCE**

Plaintiffs Uniloc USA, Inc. and Uniloc (Singapore) Private Limited (collectively “Uniloc”) hereby give notice that Uniloc’s seven pending cases before this Court are now ready for status conference. Uniloc respectfully requests that the Court set these cases (including the declaratory judgment action filed by Symantec in California but transferred to this Court) for a single status conference separate from the Court’s regularly scheduled group status conferences. The seven cases are styled as follows:

*Uniloc USA, Inc. et al. v. Sony Corp. of America, et al.*, No. 6:10-cv-00373 (LED)

*Uniloc USA, Inc. et al. v. Disk Doctors Labs, Inc.*, No. 6:10-cv-00471 (LED)

*Uniloc USA, Inc. et al. v. National Instruments Corp. et al.*, No. 6:10-cv-00472 (LED)

*Uniloc USA, Inc. et al. v. Engrasp, Inc. et al.*, No. 6:10cv-00591 (LED)

*Uniloc USA, Inc. et al. v BMC Software, Inc., et al.*; No. 6:10-cv-00636 (LED)

*Uniloc USA, Inc. et al. v. Foxit Corp., et al.*, No. 6:10-cv-00691 (LED)

*Symantec Corp. et al. v. Uniloc USA Inc. et al.*, No. 6:11-cv-00033 (LED)

## **1. UNILOC'S PATENT AND LITIGATION HISTORY**

The asserted patent, U.S. Patent No. 5,490,216, describes a system and method for software activation to help prevent piracy. The '216 patent has a long litigation history, including a jury trial and multiple trips to the Federal Circuit. In September 2003, Uniloc sued Microsoft Corporation for infringement in the District Court for the District of Rhode Island. *Uniloc USA, Inc. v. Microsoft Corp.*, 640 F. Supp. 2d 150, 159 (D.R.I. 2009). Two and half years later, in May 2006, that Court conducted a *Markman* hearing and in August 2006 issued an order construing 23 terms. *Uniloc USA, Inc. v. Microsoft Corp.*, No. 1:03-cv-00440-WY-DLM (D.R.I.) Dkt#s 142 & 145.

In October 2007, the Rhode Island Court granted Microsoft's motion for summary judgment of non-infringement. Uniloc appealed in August 2008 and the Federal Circuit reversed the district court on the summary judgment finding. In reversing the Federal Circuit considered and rejected "several alternative grounds for affirming the summary judgment beyond those which were reached by the district court" and concluded that they were without merit and further construed the term "licensee unique ID" explaining that vendor-supplied information, such as Microsoft's Product Key, could provide the basis for a licensee unique ID. *Uniloc USA, Inc. v. Microsoft Corp.*, 2008 U.S. App. LEXIS 16938, \*16-18.

In April 2009, after a 10-day trial, a jury found the '216 Patent valid, infringed and awarded Uniloc \$388 million for Microsoft's infringement. *Uniloc USA, Inc. v. Microsoft Corp.*, 640 F. Supp. 2d 150, 160 (D.R.I. 2009). Notwithstanding the jury's verdict, in September 2009, the District Court granted Microsoft's post-trial motions for judgment as a matter of law of non-infringement and for a new trial on damages. *Id.* at 165-76, 183-85. Uniloc, and Microsoft, appealed to the Federal Circuit.

On January 4, 2011, the Federal Circuit reversed the Rhode Island Court a second time on the issue of infringement, reinstating the jury's finding of infringement, but upheld the District Court's grant of a new trial on damages. *Uniloc USA, Inc. v. Microsoft Corp.*, 2011 U.S. App. LEXIS 11, \*82 (Fed. Cir. Jan. 4, 2011). The Federal Circuit also explicitly rejected Microsoft's arguments that the '216 Patent was anticipated by U.S. Patent 4,658,093 to Martin E. Hellman ("Hellman"), noting that in accordance with its 2008 claim construction, Hellman failed to teach a "licensee unique ID" as claimed in the '216 Patent.

On March 7, 2011, both Microsoft and Uniloc filed petitions in the Federal Circuit. Microsoft filed a Petition for a Panel Rehearing and Uniloc filed a combined Petition for a Panel Rehearing and *En Banc* hearing. On March 22, 2011, Microsoft's Petition for Rehearing was denied. On March 24, Federal Circuit requested Microsoft file a response to Uniloc's petition for panel and en banc rehearing. As such, no decision has been made on Uniloc's petitions. Nonetheless, if and when that case is eventually remanded and the mandate spreads, it will not return to Judge Smith in Rhode Island who presided over the Microsoft trial. On January 27, 2011, Judge Smith transferred the case to the District of Massachusetts and as of February 3, 2011, the case has been reassigned to Judge William Young, District of MA and Judge Smith is no longer assigned to the case. *Uniloc USA, Inc. v. Microsoft Corp.*, Case No. 03-440 (D.R.I. Jan. 27, 2011) (Dkt#444 and #445).

In January 2010, approximately 8 months after the jury verdict against it and while the case was pending before the Federal Circuit a second time, Microsoft filed an *ex parte* request for reexamination of the '216 Patent. Microsoft's request was based primarily on the Hellman reference discussed above, and the Grundy reference, a patent that was already considered by the Patent Office during the original examination of the '216 Patent.

## **2. MOTIONS PENDING IN THE CURRENT CASES**

Uniloc USA, Inc. v. Sony Corp. of Am., No. 6:10-cv-00373 (LED)

Dkt#53 – Activision Blizzard, Inc.’s Motion to Dismiss, or Alternatively, Motion for a More Definite Statement. This motion is now moot due to Uniloc’s amending the complaint against Activation Blizzard.

Dkt#73 – Joint Motion to Change Venue Under 28 U.S.C. § 1404(a) filed by the defendants requesting transfer to Rhode Island. Briefing on this motion was completed on February 17, 2011.

Uniloc USA, Inc. v. Disk Doctors Labs, Inc., No. 6:10-cv-00471 (LED)

Dkt# 122/#126 – Motion to Stay filed or joined by six of the eleven defendants. Briefing is not completed. There are no pending motions to dismiss or transfer in this case.

Uniloc USA, Inc. v. National Instruments Corp., Inc., No. 6:10-cv-00472 (LED)

Dkt#60 – Motion to Dismiss for Improper Venue Pursuant to Rule 12(B)(3) by Symantec Corp. Briefing completed on January 19, 2011. Symantec’s Motion to Dismiss is moot as detailed below, because the California Court transferred the dispute between Symantec and Uniloc that formed the basis of the motion to this Court.

Dkt#113/114 – Joint Motion to Change Venue Under 28 U.S.C. § 1404(a) filed by or joined by eleven of the twelve defendants requesting transfer to Rhode

Island. The Motion was filed on March 25, 2011 and briefing is not yet completed.

Uniloc USA, Inc. v. Engrasp, Inc., No. 6:10-cv-00591 (LED)

Dkt#117/121/124-128/133 – Motion to Stay filed or joined by ten of the sixteen defendants. Briefing is not completed.

There are no pending motions to dismiss or transfer in this case.

Uniloc USA, Inc. v. BMC Software, Inc., No. 6:10-cv-00636 (LED)

Dkt#51 – Joint Motion to Change Venue Under 28 U.S.C. § 1404(a) filed by the defendants requesting transfer to Rhode Island. The Motion was filed on March 25, 2011 and briefing is not yet completed.

Uniloc USA, Inc. v. Foxit Corporation, Inc., No. 6:10-cv-00691 (LED)

Dkt#40 – Motion to Dismiss for Improper Venue and Lack of Personal Jurisdiction by Microlead Corporation. Briefing for this motion was completed on February 14, 2011.

Dkt#56 – Motion for Entry of Default against Defendant Manifold Net Ltd. filed by Uniloc USA, Inc. was filed on February 25, 2011.

Symantec Corp. v. Uniloc USA Inc., No. 6:11-cv-00033 (LED)

Symantec filed this declaratory judgment action in the District Court for the Central District of California. The District Court for the Central District of

California transferred this case to the Eastern District of Texas on January 18, 2011. Symantec is a Defendant in *Uniloc USA, Inc. v. National Instruments Corp., Inc.*, No. 6:10-cv-00472 and the transferred DJ claims should be consolidated into that matter.

### **3. PRIOR EDTX CASES**

*Uniloc USA, Inc. et al. v. Abbyy Software, Inc. et al.*, No. 6:09-cv-00538 (LED-JDL).

This matter was filed November 30, 2009 against thirteen defendants. Robert Faulkner (Ret.) served as mediator. All issues were resolved and the final defendant dismissed eight months after the status conference. The matter was closed on January 4, 2011.

*Uniloc USA, Inc. et al. v. BCL Technologies et al.*, No. 6:10-cv-00018 (LED-JDL).

This matter was filed January 27, 2010 against thirteen defendants. Robert Faulkner (Ret.) served as mediator. All issues were resolved and the final defendant dismissed six months after the status conference. The matter was closed on January 4, 2011,

*Uniloc USA, Inc. et al. v. Cyberlink.com Corp. et al.*, No. 6:10-cv-00069 (LED-JDL).

This matter was filed March 1, 2010 against fifteen defendants. Robert Faulkner (Ret.) served as mediator. All issues were resolved and the final defendant dismissed five months after the status conference. The matter was closed on November 17, 2010.

**4. DATES OF MARKMAN HEARING/TRIAL IN RELATED CASES**

No dates have been set for any *Markman* hearing or trial in any of the seven related cases.

Date: March 29, 2011

By: /s/ Dean Bostock

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**ATTORNEYS FOR PLAINTIFFS**

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document through the Court's CM/ECF system per Local Rule CV-5(a)(3) on the 29<sup>th</sup> day of March, 2011.

By: /s/ Dean Bostock