

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

UNILOC USA, INC., ET AL.	§	
Plaintiffs,	§	
	§	
vs.	§	CASE NO. 6:10-CV-373
	§	PATENT CASE
	§	
SONY CORPORATION OF AMERICA,	§	
ET AL.	§	
Defendants.	§	
	§	
UNILOC USA, INC., ET AL.	§	
Plaintiffs,	§	
	§	
vs.	§	CASE NO. 6:10-CV-471
	§	PATENT CASE
	§	
DISK DOCTORS LABS, INC., ET AL.	§	
Defendants.	§	
	§	
UNILOC USA, INC., ET AL.	§	
Plaintiffs,	§	
	§	
vs.	§	CASE NO. 6:10-CV-472
	§	PATENT CASE
	§	
NATIONAL INSTRUMENTS CORP., ET	§	
AL.	§	
Defendants.	§	
	§	
UNILOC USA, INC., ET AL.	§	
Plaintiffs,	§	
	§	
vs.	§	CASE NO. 6:10-CV-591
	§	PATENT CASE
	§	
ENGRASP, INC., ET AL.	§	
Defendants.	§	

UNILOC USA, INC., ET AL.
Plaintiffs,

vs.

BMC SOFTWARE, INC., ET AL.
Defendants.

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CASE NO. 6:10-CV-636
PATENT CASE

UNILOC USA, INC., ET AL.
Plaintiffs,

vs.

FOXIT CORPORATION, ET AL.
Defendants.

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CASE NO. 6:10-CV-691
PATENT CASE

SYMANTEC CORPORATION, ET AL.
Plaintiffs,

vs.

UNILOC USA, INC., ET AL.
Defendants.

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§

CASE NO. 6:11-CV-33
PATENT CASE

PATENT RULE 4-3 JOINT CLAIM CONSTRUCTION
AND PRE-HEARING STATEMENT

Plaintiffs, Uniloc USA Inc. and Uniloc Singapore Limited (“Uniloc”) have asserted that Defendants Activision Blizzard, Inc., Adobe Systems, Inc., Aladdin Knowledge Systems, Inc., Aladdin Knowledge Systems, Ltd., ApexSQL, LLC, Aspyr Media, Inc., Autodesk, Inc., BMC Software, Inc., Borland Software Corp., ComponentOne, LLC, Digital River, Inc., eEye, Inc., Electronic Arts, Inc., FileMaker, Inc., Foxit Corp., Freedom Scientific, Inc., Freedom Scientific BLV Group, LLC, GEAR Software, Inc., GEAR Software Holdings, Inc., Intego, Inc., Intuit, Inc., Manifold Net

Ltd., Markzware, McAfee, Inc., Microlead Corp., National Instruments Corp., Onyx Graphics, Inc., Pervasive Software, Inc., Pinnacle Systems, Inc., Quinstar Corp., SafeNet, Inc., Sage Software, Inc., SolarWinds, Inc., SolarWinds Worldwide, LLC, Sony Corp. of America, Sony DADC US Inc., Stat-Ease, Inc., Symantec Corp., Tableau Software, Inc., Transmagic, Inc., Unity Technologies SF, Wildpackets, Inc., and Xtreamlock, Pty in the above-numbered cases (collectively “Defendants”) infringe claims 1, 7-13, 15-16, and 19-20¹ (“Asserted Claims”) of U.S. Patent No. 5,490,216 (“the ‘216 Patent”).

Pursuant to Patent Rule 4-3 and the Court’s Docket Control Order, the parties submit this joint claim construction statement and pre-hearing statement with respect to the ‘216 Patent.

As shown in the attached charts, the Defendants intend to present arguments regarding alleged disclaimer(s) resulting from the recently concluded reexamination. There is a dispute as to whether such a disclaimer is or is not a new construction of previously defined terms. The Defendants also seek to construe the term “local,” and there is a dispute as to whether the term “local” has been previously construed by the District Court for the District of Rhode Island. Uniloc’s and Defendants’ positions on these issues are as follows:

Uniloc’s Position: In this Statement, Defendants put forward new constructions for two claim terms already construed by previous Courts (“local licensee unique ID generating means” and “licensee unique ID”) and raise an issue that Defendants claim would alter the construction of all previously construed claim terms (the Defendants’

¹ Claim 20 has only been asserted against certain defendants.

“disclaimer” issue). Uniloc believes the submission of these claim terms and the “disclaimer” issue to be impermissible. The Court’s Docket Control Order states:

The Court prefers to minimize the time spent on previously construed terms.
The parties must seek leave and show good cause to submit previously construed terms for construction.

Prior to the submission of this Statement, Defendants have not sought leave nor have they shown good cause pursuant to the Court’s Order regarding the two terms and “disclaimer” issue in question. Uniloc reads the Court’s Docket Control Order as applying to the re-submission of any previously construed claim term, regardless of the reason of why it is being resubmitted. Given Uniloc’s understanding, it has noted its objections and positions in Exhibit A to this document where appropriate.

Finally, Uniloc notes that the positions attributed to it in Defendants’ statement, below, are not accurate and should not be relied upon by the Court.

Defendants’ Position: The Defendants submit that leave is not necessary to address the disclaimer issue because a disclaimer is not a modification of a prior claim construction. On the contrary, the claim constructions provided by the District Court for the District of Rhode Island reflect that Court’s opinion as to how the claims should be interpreted at the time the invention was made. The disclaimer argument, on the other hand, reflects further limitations on any claim construction by virtue of arguments made after issuance of the patent by Uniloc in order to save the patent from invalidity.

Moreover, the prior constructions could not have considered this disclaimer issue for the simple reason that the arguments resulting in the disclaimer **had not been made at the time of the previous claim construction order.**

Therefore, to the extent that this Court holds that leave is necessary for the disclaimer argument, the Defendants hereby do seek leave to address the disclaimer point.

The Defendants further note that Uniloc does not dispute that the disclaimer dispute – which arises from express representations made by Uniloc to the Patent Office, in connection with the very recent reexamination (ie, subsequent to the prior claim constructions), made to overcome preliminary findings by the PTO that all of the patent claims were invalid -- raises new issues that could not have been raised in the prior claim construction proceedings. Uniloc has already stated in writing that “Uniloc will not oppose a motion seeking leave to have the Court consider this [disclaimer] issue during the Markman process, provided” The proviso dealt with issues wholly unrelated to the disclaimer dispute. The Defendants maintain that it is entirely inappropriate to hold the disclaimer issue hostage to unrelated issues and contend that Uniloc’s own statement that it would not oppose motion for leave is sufficient grounds to have this Court hear the disclaimer issue.

With respect to the term “local” in the phrase “local licensee unique ID generating means,” Defendants disagree with Uniloc’s position that this term has already been construed by previous Courts. Rather, the phrases “local licensee unique ID generating means” and “remote licensee unique ID generating means” were given the exact same construction without construing the limitations “local” or “remote.” Therefore, Defendants submit that leave is not necessary to construe the term “local” in the context of “local licensee unique ID generating means.” However, to the extent this Court holds

that leave is necessary to construe “local,” the Defendants hereby do seek leave to construe “local.”

(a) **Agreed Constructions***

The parties stipulate that the previous constructions for the following terms/phrases should be adopted subject to the following three qualifications by the Defendants:

1. The Defendants dispute that the terms “licensee unique ID”, “security key”, “registration key”, and “enabling key” were properly construed by the District Court for the District of Rhode Island and contend that the term should have been construed to mean “A unique identifier associated with a licensee that is generated, at least in part, from personal information and not merely computer-related or software-related information.” This construction is the construction that the dissent believed was correct in *Uniloc I.* 290 Fed. Appx. 337 (Fed. Cir. 2008). However, this Court stated that it would be adopting the prior constructions subject to the parties’ preservation of rights of appeal, as stated in this Court’s Memorandum and Order, dated 5-20-2011. We therefore present this argument (based on the reasoning of the dissent) to preserve our rights to appeal this issue to the Federal Circuit. Should the Court wish to hear argument on this construction, the Defendants are willing to argue for this construction.

2. The Defendants submit that all constructions below are subject to any disclaimer made by Uniloc during prosecution of the reexamination of the patent-in-suit.

3. Defendant Pervasive does not join the stipulation as to the first term in the table below and will be moving for leave to append an additional phrase to the previous construction.

	Term/Phrase	Previous/Agreed* Construction
		*Agreed subject to the three qualifications above
1	“Licensee Unique ID” “Security key” “Registration key” “Enabling key”	A unique identifier associated with a licensee
2	“Information uniquely descriptive of an intending licensee” “Information...which uniquely identifies an intended registered user”	Information that is uniquely associated with a person who intends to become a licensee so as to access full functionality of the digital data
3	“Local licensee unique ID generating means” “Remote licensee unique ID generating means” “Registration key generating means”	<u>Function</u> : to generate a local or remote licensee unique ID/registration key. <u>Structure</u> : a summation algorithm or a summer and equivalents thereof
4	“Algorithm”	Any set of instruction that can be followed to carry out a particular task
5	“Includes the algorithm utilized by said local licensee unique ID generating means to produce said licensee unique ID”	Includes the identical algorithm used by the local licensee unique ID generating means to produce the licensee
6	“generated by a third party means of operation of a duplicate copy of said registration key generating	Generated by a third party's use of a duplicate copy of the registration key generating means

	means”	
7	“Use mode”	A mode that allows full use of the digital data or software in accordance with the license
8	“Fully enabled mode” “full version run”	A mode/version that allows full use of the digital data or software in accordance with the license
9	“Partly enabled” or “demonstration mode”	A mode that allows partial use of the digital data or software
10	“Mode switching means”	<u>Function</u> : to permit the digital data or software to run in a use mode/fully enabled mode of the locally generated licensee unique ID/registration key matches with the remotely generated licensee unique ID/enabling key. <u>Structure</u> : program code which performs a comparison of two numbers or a comparator and equivalents thereof.
11	“Has matched”	A comparison between locally generated licensee unique ID/registration key and the remotely generated licensee unique ID/enabling key shows that the two are the same
12	“Mode switching means will permit said data to run in said use mode in subsequent execution only if said platform unique ID has not changed”	The mode switching means will permit the data to run in the use mode only if the platform unique ID is identical to what it was the previous time the digital data were run
13	“Registration system”	A system that allows digital data or software to run in a use mode on a platform if and only if an appropriate licensing procedure has been followed
14	“Provided to said mode-switching means by said intending user “	Provided to the mode-switching means by the person who intends to become a licensee
15	“Communicated to said intending user”	Communicated to the person who intends to become a licensee
16	“Checking by the registration	Verification by the registration authority

	authority that the information unique to the user is correctly entered”	that information unique to the user and entered by the user is accurate
17	“Wherein said registration system is replicated at a registration authority”	Wherein the registration system attachable to software to be protected is reproduced exactly at the registration authority
18	“Serial number”	A number that is one of a series
19	“Platform unique ID generating means”	<u>Function</u> : to generate a platform unique ID. <u>Structure</u> : a summation algorithm or a summer and equivalents thereof.

(b) **Disputed Claim Terms**

Uniloc’s proposed construction for each disputed claim term from the ‘216 Patent, as well as its identification of supporting evidence, is set forth in Exhibit A. The Defendants’ proposed construction or position for each disputed claim term from the ‘216 Patent, as well as their identification of supporting evidence, is set forth in Exhibit B.

(c) **Time for Claim Construction Hearing**

The parties believe that 3 hours (1.5 hours for Uniloc and 1.5 hours for Defendants) will be sufficient for the claim construction hearing.

(d) **Witnesses**

No party intends to call any witnesses to testify on issues regarding claim construction.

(f) **Other Issues**

The parties are not aware of any other issues that should be taken up at a pre-hearing conference before the claim construction hearing.

Dated: August 29, 2011

By:

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CERTIFICATE OF SERVICE

I hereby certify that on the 29th day of August 2011, I electronically filed the foregoing document with the clerk of the court for the U.S. District Court, Eastern District of Texas, Tyler Division, using the electronic case filing system of the court. The electronic case filing system sent a “Notice of Electronic Filing” to the attorneys of record who have consented in writing to accept this Notice as service of this document by electronic means.

/s/ Edward R. Nelson, III