

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

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

**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**

**DEFENDANTS' MOTION FOR LEAVE TO ADDRESS FILE HISTORY  
DISCLAIMER ISSUES, ARISING FROM THE RECENT REEXAMINATION, IN  
THE UPCOMING CLAIM CONSTRUCTION PROCEEDINGS**

In an abundance of caution, Defendants hereby move for leave to address, in the upcoming claim construction briefing, whether Uniloc is bound by express disclaimers arising from the recent reexamination of the '216 patent. Defendants presently intend to fully address such issues in connection with the claim construction proceedings.

The moving defendants *do not seek to change* any prior construction – rather, they seek to subject all relevant prior constructions to Uniloc's express (and very recent)

disclaimers. While leave does not appear to be required under these circumstances, Uniloc seems to be taking the position that the Court has foreclosed any inquiry into Uniloc's express disclaimers absent such leave. Hence this motion.

As this Court may be aware, in recent reexamination proceedings *that did not conclude until earlier this month*, the Patent and Trademark Office (“PTO”) twice rejected all of the claims of the ’216 patent as invalid in light of two prior art references – one to Hellman and one to Grundy. In order to overcome those rejections and distinguish those references, Uniloc made a series of statements to the PTO as to what its patent categorically *does not cover*. Some of those statements are collected in the attachments to Exhibit B of the Joint Claim Construction Statement, setting out the intrinsic evidence supporting Defendants’ claim construction positions. (*See, e.g.*, Case No. 6:10-CV-472, Dkt. No. 247-2.) They include, as just a small example, the following statements, all made in or around late 2010 by Uniloc and/or its declarants to the PTO:

- (1) “A checksum is not usable as a generator of unique IDs.”
- (2) “Grundy himself suggests the use of checksums as error-checking means . . .”
- (3) “. . . many different sets of user data could produce the same checksum.”
- (4) “For the above reasons, a checksum cannot possibly preserve whatever uniqueness the input data may possess.”
- (5) “Grundy does not teach or suggest that the checksum, or the registration code that includes the checksum as one of the fields, represents a unique identifier associated with the intended registered user.”
- (6) A checksum is “a calculated value that is used to test data integrity.”

(*Id.*) This is just a sampling of the express and unambiguous statements made by Uniloc to overcome the prior art. And Uniloc was successful. As the PTO noted in its August 5, 2011, Notice of Intent to Issue Reexamination Certificate: “The Patent Owner has persuasively argued that the summation [algorithm] disclosed by Grundy is used in the context of merely verifying the correctness of information related to the user and is not being used to generate an ID per se. Since the information is not being used for the same purpose, one skilled in the art therefore would not use the algorithm of Grundy as part of the generation of the claimed licensee unique ID.” As a result, Defendants seek the following disclaimer applicable to all asserted claims: “the licensee unique ID/security key cannot be generated by a checksum, summation algorithm, or equivalent thereof, used to test data integrity.” (*See, e.g.*, Case No. 6:10-CV-472, Dkt. No. 247-2 at pp. 16, 17-21.)<sup>1</sup>

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<sup>1</sup> Defendants Aspyr Media, Inc., Borland Software Cop, Digital River, Inc., GEAR Software, Inc. and GEAR Software Holdings, Inc. also seek an additional disclaimer applicable to all relevant claims based on Uniloc’s express and unambiguous disavowals of claim scope in the same Reexamination filings addressed above. Uniloc’s disclaimers relevant to the Hellman reference include for example the following: (1) “None of the input signals to Hellman’s cryptographic function generator 38 (or 23)—namely, K (or SK), N, R, and H—are unique to a licensee and therefore cannot disclose the ‘local licensee unique ID’ of claim 1;” and (2) “Inputs to cryptographic function generator 38 are limited to K (the cipher key), N (the number of desired software uses), R (a random number), and H (signal representing the software to be licensed). . . . There is no input into Hellman’s cryptographic function that is uniquely associated with an intended licensee. (Rosenblatt, ¶¶ 38-39).” *See* Case No. 6:10-CV-472, Dkt. No. 247-2 at pp. 16, 22-38. Similarly, this is just a sampling of the express and unambiguous statements made by Uniloc to overcome the Hellman prior art reference. Defendants therefore seek the following disclaimer as set forth by the PTO: “The licensee unique ID generated by the means recited in each of the claims must be derived from at least one piece of information that is specific to the user, such as name, billing information, or product information unique to the installation entered by the user. The information cannot be specific to the computer or independently generated by the computer.” *Id.*; Notice of Intent to Issue Reexamination Certificate, mailed on Aug. 5, 2011 at 5.

Uniloc knows that the issue of whether, and the extent to which, its recent statements to the PTO, made to overcome the prior art, constitute binding disclaimers has not been addressed by any Court. Indeed, when Defendants asked Uniloc not to oppose this motion, and instead to allow Defendants to file a simple unopposed motion so that this Court could address the issues in the first instance, Uniloc provided a “conditional” agreement. Uniloc, according to its letter, would agree not to oppose such a motion, but only if Defendants agreed to prevent any defendant from even asking this Court for leave to seek to re-construe a few other terms of interest to those defendants:

“As for the alleged ‘prosecution history disclaimer applicable to all claims,’ however, Uniloc will not oppose a motion seeking leave to have the Court consider this single issue during the *Markman* process, provided that no defendant seeks to re-construe any terms that have already been construed. . .”

See Uniloc letter of August 26, 2011, attached hereto as Ex. A. In other words, Uniloc, despite essentially acknowledging in this sentence that the disclaimer issue is not a request to re-construe claim terms, took the position that if any Defendant sought to exercise its right to ask for leave to reconsider the prior construction of any claim term, Uniloc would oppose leave to allow this Court even to address a fundamental issue that only recently arose in connection with Uniloc’s repeated and unambiguous assertions to the PTO as to what its claims do *not* cover.

Defendants do not believe that Uniloc’s opposition to this motion is reasonable. Disagreement with the Defendants’ arguments as to the existence of, or the scope and effect of, disclaimers made by Uniloc in connection with the recent reexamination is one thing. That is what the *Markman* briefing and proceedings are for. But taking the position that the Court should not address the issue at all – or rather, that the Court should

not address the issue unless Defendants give up some other, unrelated rights – is contrary to all notions of justice and fair play and is, in addition, just inviting the Court into error.

Uniloc may contend that Defendants should have moved for leave earlier. Defendants disagree, for at least three reasons. First, even if one were to assume that leave is required here, it would not have been proper to raise the disclaimer issue any earlier with the Court. As noted above, *the claims in the '216 patent stood rejected until August 5, 2011* – when the PTO issued its Notice of Intent to Issue Reexamination Certificate (“NIRC”). Uniloc’s disclaimers during the reexamination proceedings are what convinced the PTO to issue the NIRC, and they were expressly the basis for the PTO’s decision. Uniloc did not file a notice of the NIRC with the Court until August 10, 2011. (*See, e.g.*, Case No. 6:10-CV-472, Dkt. No. 207.) Uniloc then dropped six claims on August 19, 2011. Defendants raised the disclaimer issue in the exchange of the parties’ P.R. 4-2 disclosures on August 24, 2011. Defendants then met and conferred with Uniloc on August 25, before formally requesting leave, since the Court generally requires that parties meet and confer before filing motions (L.R. CV-7), and Defendants did not expect that Uniloc would oppose addressing the disclaimer issues (and indeed Uniloc did not indicate any opposition until it sent its letter of August 26 which, as set forth above, for the first time attached unacceptable and punitive conditions to any non-opposition).<sup>2</sup> Thus, in reality, this motion (if it is even required) is timely.

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<sup>2</sup> It is also noteworthy that some of the most direct and unambiguous statements made by Uniloc to the PTO to overcome the prior art were included in a declaration of William Rosenblatt, dated late November 2010 and submitted by Uniloc to the PTO. Defendants were unable to obtain a copy of that declaration from the PTO, and Uniloc did not produce it to the Defendants in connection with its requisite prior production. Indeed, *Uniloc did not produce a copy of the Rosenblatt Declaration until yesterday* –

In any event, this is not a request to re-construe anything. Instead, it is a request to subject all prior constructions to disclaimers that apply across the board (but not to any one specific term) – and that are based on admissions Uniloc made recently to the PTO to overcome rejections, long after the claim constructions from the prior cases issued. Thus, it is unclear whether the Court’s Docket Control Order (DCO) even requires a motion for leave.

Finally, even if the DCO were construed to require a motion for leave, the DCO is silent as to the timing of such a motion, and Defendants raised the issue in a timely fashion (in their P.R. 4-2 disclosures) and are now timely seeking leave.<sup>3</sup> That Uniloc cannot seriously argue waiver here is reflected in Uniloc’s letter offering not to oppose; but the fact that Defendants would not agree to draconian conditions cannot lead to a waiver of rights arising out of Uniloc’s recent conduct in front of the PTO.

For all of the foregoing reasons, Defendants respectfully request that the Court grant them leave to have the disclaimer issues addressed during the upcoming claim construction proceedings, or alternatively to clarify that no such leave is required.

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*August 29, 2011*; and yet it seeks to prevent Defendants from even addressing before this Court the disclaimer issues arising therefrom.

<sup>3</sup> Defendants also note that a request for leave is included in the Patent Rule 4-3 Joint Claim Construction and Pre-Hearing Statement, filed by the parties on August 29, 2011.

Dated: August 30, 2011

Respectfully submitted,

*/s/ Mark A. Flagel, with permission by  
Allen F. Gardner*

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**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 via the Court's CM/ECF system per Local Rule CV-5(a)(3) on August 30, 2011.

/s/ Allen F. Gardner

**CERTIFICATE OF CONFERENCE**

I hereby certify that counsel for the undersigned Defendants met and conferred with counsel for the Uniloc plaintiffs on a telephone conference August 25, 2011 and counsel for Uniloc, in a letter dated August 26, 2011, stated they were conditionally opposed to the relief sought in this motion.

/s/ Mark A. Flagel, with permission  
by Allen F. Gardner