

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

ICASHE, INC.,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD.,
et al.

Defendants.

Civil Action No. 2:24-CV-0429-JRG

JURY TRIAL DEMANDED

DEFENDANTS' INELIGIBILITY CONTENTIONS

Pursuant to this Court's Standing Order Regarding Subject Matter Eligibility Contentions Applicable to All Patent Infringement Cases Assigned to Chief District Judge Rodney Gilstrap ("Standing Order") and the Court's Docket Control Order (Dkt. No. 30), Defendants Samsung Electronics Co., Ltd, and Samsung Electronics America, Inc. (collectively, "Defendants" or "Samsung") serve these Ineligibility Contentions ("Ineligibility Contentions") addressing how the claims of U.S. Patent Nos. 8,403,219 ("the '219 patent"), 9,122,965 ("the '965 patent"), 9,202,156 ("the '156 patent"), 9,208,423 ("the '423 patent"), 9,483,722 ("the '722 patent"), 11,270,174 ("the '174 patent"), 11,694,053 ("the '053 patent") (collectively the "Asserted Patents") are ineligible for patent protection.

I. RESERVATIONS AND OBJECTIONS

A. General Reservations

Pursuant to paragraph (c) of the Standing Order, Samsung reserves the right to amend or supplement these Ineligibility Contentions: (1) if Plaintiff amends its infringement contentions; or (2) if the Court's claim construction ruling so requires.

The information provided should not be deemed an admission regarding the scope of any claims or the proper construction of those claims or any terms contained therein. Samsung's claim construction disclosures will be provided under P.R. 4 as required by the Court's Docket Control Order. Nothing contained in these Ineligibility Contentions should be understood or deemed to be an express or implied admission or contention with respect to the absence of factual disputes relating to patent ineligibility, the absence of a need for construction of any terms in an asserted claim, any proper construction of any terms in an asserted claim, or alleged infringement of that claim. There is no claim construction issue or factual issue that precludes the Court finding that the claims of the Asserted Patents are patent ineligible.

Nothing in these disclosures should be treated as an admission that Samsung is obligated to produce documentation not under its possession, custody, or control, or that can be obtained from some other source that is more convenient, less burdensome, and/or less expensive, or for which the burden or expense outweighs its likely benefit. Samsung expressly reserves the right to revise, amend, and/or supplement its disclosures and document production should additional documentation become available.

B. Challenged Claims

Samsung contends that the following claims asserted by Plaintiff in its P.R. 3-1 Disclosure of Asserted Claims and Infringement Contentions (collectively the "Challenged Claims") are invalid under 35 U.S.C. § 101:

Challenged Patent	Asserted Claims
9,122,965	1-20
9,483,722	1-14
11,694,053	1-8, 17-20
8,403,219	1-6
9,202,156	1-5, 8-12
9,208,423	1-5, 8-18
11,270,174	1-9

These Ineligibility Contentions address only the Challenged Claims. Samsung reserves the right to supplement these contentions if Plaintiff asserts infringement of any claim other than those identified in Plaintiff's Infringement Contentions, Plaintiff amends or otherwise changes its infringement contentions, and/or Plaintiff asserts a claim construction that would render or further confirm that a Challenged Claim is unpatentable.

C. Ongoing Discovery

Samsung's discovery and investigation in this lawsuit are ongoing, and therefore, Samsung reserves the right to revise, amend, and/or supplement these Ineligibility Contentions as discovery progresses and as it discovers additional information. Discovery is ongoing, and Samsung's prior art investigation and third-party discovery are in the initial stages. As such, Samsung reserves the right to revise, amend, and/or supplement the information provided herein, including identifying, and relying on additional references, should Samsung's further search and analysis yield additional information or references, consistent with the Local Rules, Judge Gilstrap's Standing Order, and the Federal Rules of Civil Procedure.

Samsung reserves the right to rely on all documents produced by Samsung, as well as Plaintiff, any predecessors in interest, the named inventors, and any other third parties, as discovery is ongoing.

II. SUBJECT MATTER INELIGIBILITY CONTENTIONS CHARTS

Pursuant to the Court's Standing Order, attached to these Eligibility Contentions are Appendices that demonstrate legal and factual bases for the ineligibility of the Challenged Claims.

- Appendix A contains Samsung's ineligibility charts for the '965 patent.
- Appendix B contains Samsung's ineligibility charts for the '722 patent.
- Appendix C contains Samsung's ineligibility charts for the '053 patent.
- Appendix D contains Samsung's ineligibility charts for the '219 patent.
- Appendix E contains Samsung's ineligibility charts for the '156 patent.
- Appendix F contains Samsung's ineligibility charts for the '423 patent.
- Appendix G contains Samsung's ineligibility charts for the '174 patent.

III. DOCUMENT PRODUCTION

Pursuant to section (b) of the Standing Order, Samsung identifies and incorporates by reference Samsung's P.R. 3-3 identification of prior art and P.R. 3-4(b) production, served concurrently with these Ineligibility Contentions, that include the evidence currently known or available to Defendants that evidences the patent ineligibility of the Asserted Patents, including evidence that the Challenged Claims merely recite well-known, routine, and conventional elements. Samsung also incorporates by reference the Asserted Patents and their file histories, which provide additional evidence of ineligibility, as well as Plaintiff's other related patents and their file histories. *See, e.g.*, SAM429-00000001 - SAM429-00036559. Samsung also incorporates by reference the materials identified in the Appendices to these Ineligibility Contentions.

DATED: November 20, 2024

By: /s/ Alexander Middleton

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document has been served via email to all counsel or record on this 20st day of November, 2024.

/s/ Alexander Middleton
