IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

ASSA ABLOY GLOBAL SOLUTIONS, INC. Plaintiff, v. **LIBERTY ACCESS TECHNOLOGIES LICENSING LLC,** Defendant.	Case No. 1:23-cv-00756 **Hon. Charles P. Kocoras** **Designated Magistrate Judge: Sunil R. Harjani** **JURY TRIAL DEMANDED**

PLAINTIFF'S ANSWER TO DEFENDANT'S COUNTERCLAIMS AND PLAINTIFF'S COUNTERCLAIMS

Plaintiff ASSA ABLOY Global Solutions, Inc. ("AAGS" or "Plaintiff"), by their attorneys, hereby answers the counterclaims of Defendant Liberty Access Technologies Licensing LLC ("Liberty Access" or "Defendant") as follows:

GENERAL DENIAL

Pursuant to Fed. R. Civ. P. 8(b)(3), any allegations in Liberty Access's Answer, Affirmative Defenses and Counterclaims (D.I. 15) that are not specifically admitted below are hereby denied.

NATURE OF THE ACTION

1001. This is a patent infringement action to stop AAGS's infringement of the United States Patents issued by the United States Patent and Trademark Office ("USPTO"), a copy of which are attached as Exhibit A, Exhibit B, and Exhibit C (the "Asserted Patents"):

Ex. No.	U.S. Patent No.	Title
A	9,373,205	Access Control System And Method For Use By An Access Device

B	10,657,747	Access Control System And Method For Use By An Access Device
C	11,373,474	Access Control System And Method For Use By An Access Device

Answer: AAGS denies the allegations of patent infringement in Paragraph 1001 of Liberty's Answer. AAGS admits that Exhibits A, B, and C appear to be copies of the Asserted Patents, which, on their face, are entitled "Access Control System And Method For Use By An Access Device." AAGS is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 1001.

1002. Liberty Access seeks injunctive relief and monetary damages.

Answer: AAGS acknowledges the relief that Liberty seeks, but denies that Liberty is entitled to this, or any, relief.

THE PARTIES

1003. Liberty Access is a limited liability company organized under the laws of the State of Texas, with a place of business at 815 Brazos Street, Suite 500, Austin, Texas 78701 (Travis County).

Answer: AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1003, and thus denies the same.

1004. Liberty Access is the exclusive licensee of the Asserted Patents with all rights to recover for all past, present, and future infringement, including past damages.

Answer: AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1004, and thus denies the same.

1005. Upon information and belief based upon public information and its own statements in its FAC, AAGS is corporation organized and existing under the laws of Texas, and maintains its principal place of business at 631 International Parkway, Suite 100, Richardson, Texas 75081.

Answer: AAGS admits that it is a Texas corporation with a place of business at 631 International Parkway, Suite 100, Richardson, Texas 75081.

1006. Upon information and belief based upon public information, AAGS may be served through its registered agent, C T Corporation System, located at 1999 Bryan St., Suite. 900, Dallas, Texas 75201.

Answer: AAGS admits that it may be served through its registered agent, C T Corporation System, located at 1999 Bryan St., Suite. 900, Dallas, Texas 75201.

1007. Upon information and belief based upon public information, AAGS is related to ASSA ABLOY AB, ASSA ABLOY Mobile Services AB, and ASSA ABLOY Global Solutions AB, and AAGS is a vendor to Marriott International, Inc.

Answer: AAGS admits that it is related to ASSA ABLOY AB and ASSA ABLOY Global Solutions AB, and that it is a vendor to Marriott International, Inc. AAGS denies that it is currently related to ASSA ABLOY Mobile Services AB.

JURISDICTION AND VENUE

1008. Liberty Access repeats and re-alleges the allegations in the Paragraphs of its Counterclaims above as though fully set forth in their entirety.

Answer: AAGS incorporates by reference as if fully set forth herein its Answers to the Paragraphs of Liberty's Counterclaims above.

1009. This is an action for infringement of the Asserted Patents arising under 35 U.S.C. §§ 271, 281, and 284–85, among others. This Court has subject matter jurisdiction of the action under 28 U.S.C. §§ 1331 and 1338(a).

Answer: The allegations in Paragraph 1009 are legal conclusions, which require no response. To the extent a response is required, AAGS admits that Liberty's counterclaims raise a cause of action under the patent laws of the United States, Title 35 of the United States Code, in which case this Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. § 1338.

1010. AAGS are subject to this Court's specific and general personal jurisdiction under due process and/or the Illinois Long Arm Statute due at least to its substantial business in this judicial district, including: (i) At least a portion of the infringement alleged herein; (ii) regularly doing or soliciting business, engaging in other persistent courses of conduct, or deriving substantial revenue from goods and

services provided to individuals in Texas and in this District; and (iii) its filing its Declaratory Judgment suit against Liberty Access in this Court.

Answer: The allegations in Paragraph 1010 are legal conclusions, which require no response. Moreover, AAGS explicitly denies that it is subject to this Court's general personal jurisdiction. AAGS does not challenge personal jurisdiction for the purposes of this action only. AAGS denies any remaining allegations in Paragraph 1010.

1011. Specifically, AAGS intends to do and do business in, has committed acts of infringement in, and continues to commit acts of infringement in this District directly, through intermediaries, by contributing to and through its inducement of third parties, and offers its products or services, including those accused of infringement here, to customers and potential customers located in Illinois, including in this District.

Answer: AAGS admits that it does business with customers in this District, but denies that it has committed acts of patent infringement or contributed to or induced acts of patent infringement by others in this judicial district, or anywhere else. The remaining allegations of Paragraph 1011 consist of legal conclusions requiring no response. To the extent a response is required, AAGS denies the remaining allegations of Paragraph 1011.

1012. AAGS commits acts of infringement in this District, including, but not limited to, use of the Accused Products and inducement of third parties to use the Accused Products in an infringing manner, as described below.

Answer: The allegations in Paragraph 1012 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1012. AAGS specifically denies any act of infringement.

1013. Upon information and belief and based upon public information, AAGS has committed and continues to commit acts of infringement within this District.

Answer: The allegations in Paragraph 1013 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1013. AAGS specifically denies any act of infringement.

1014. Venue is proper in this district pursuant to 28 U.S.C. § 1400(b).

Answer: The allegations in Paragraph 1014 are legal conclusions, which require no response. To the extent a response is required, AAGS does not contest venue for the limited purposes of this civil action only.

THE ACCUSED PRODUCTS

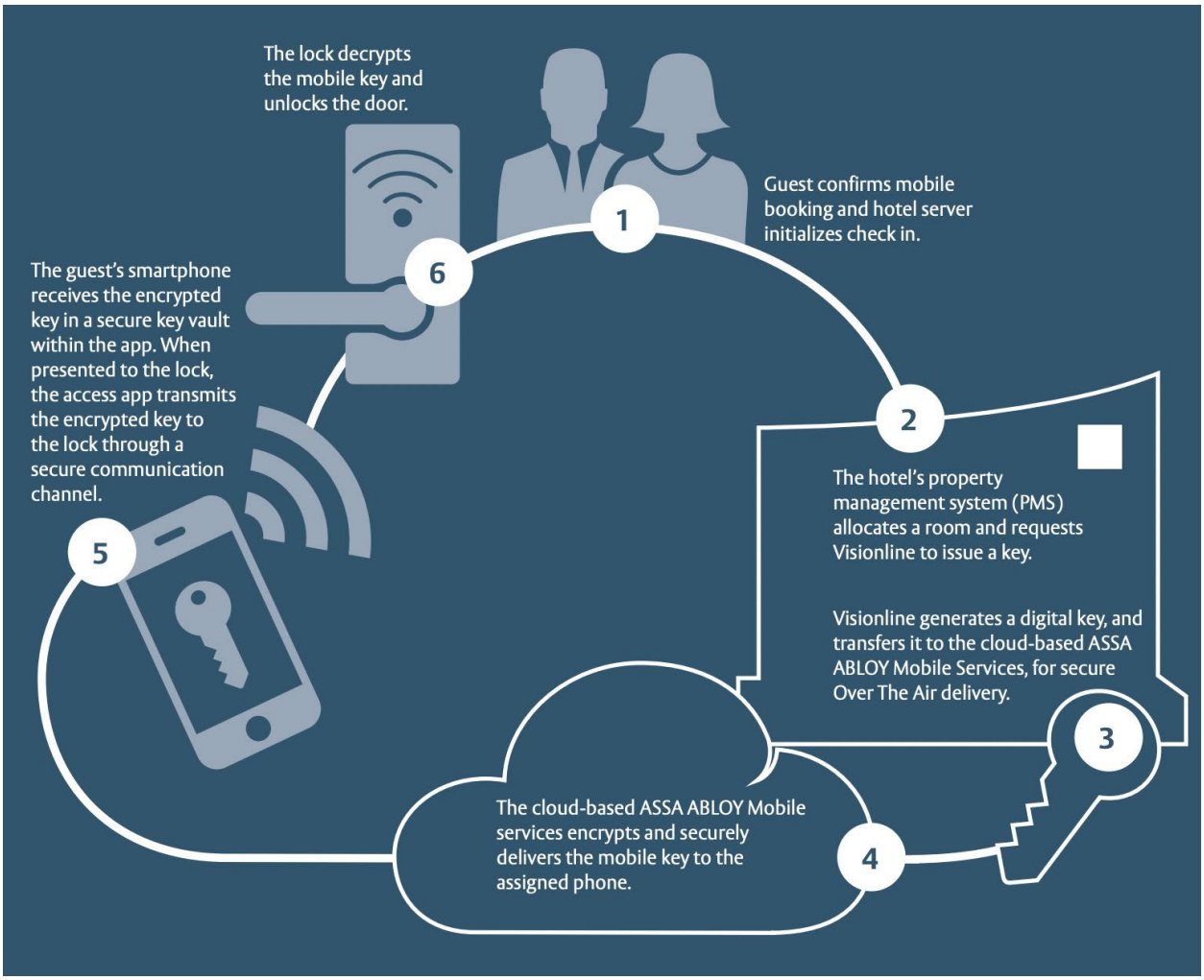
1015. Liberty Access repeats and re-alleges the allegations in the Paragraphs of its Counterclaims above as though fully set forth in their entirety.

Answer: AAGS incorporates by reference as if fully set forth herein its Answers to the Paragraphs of Liberty's Counterclaims.

1016. Based upon public information, AAGS owns, operates, advertises, controls, sells, imports, and/or offers for sale, and instructs its subsidiaries, affiliates, and end users to use the hardware, software, and functionality that allows users to use their Mobile Access features as a key to a hotel room, through marketed products and services, including, but not limited to, the ASSA ABLOY Global Solutions Mobile Access Software Development Kit (SDK), the ASSA ABLOY Global Solutions Mobile Access App, ASSA ABLOY Mobile Services, SESON technology, VingCard Classic Electronic Locks, VingCard Essence Electronic Locks, Visionline, and Vostio Access Management (collectively "Accused Products"). See Exhibit D, Exhibit E, and Exhibit F.

Answer: The allegations of Paragraph 1016 are vague and unclear, and therefore AAGS denies them on at least that basis. To the extent the allegations can be understood, AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1016 and thus denies the same. AAGS also denies the allegations of Paragraph 1016 to the extent they use terms of the Asserted Patents, and thus constitute legal conclusions.

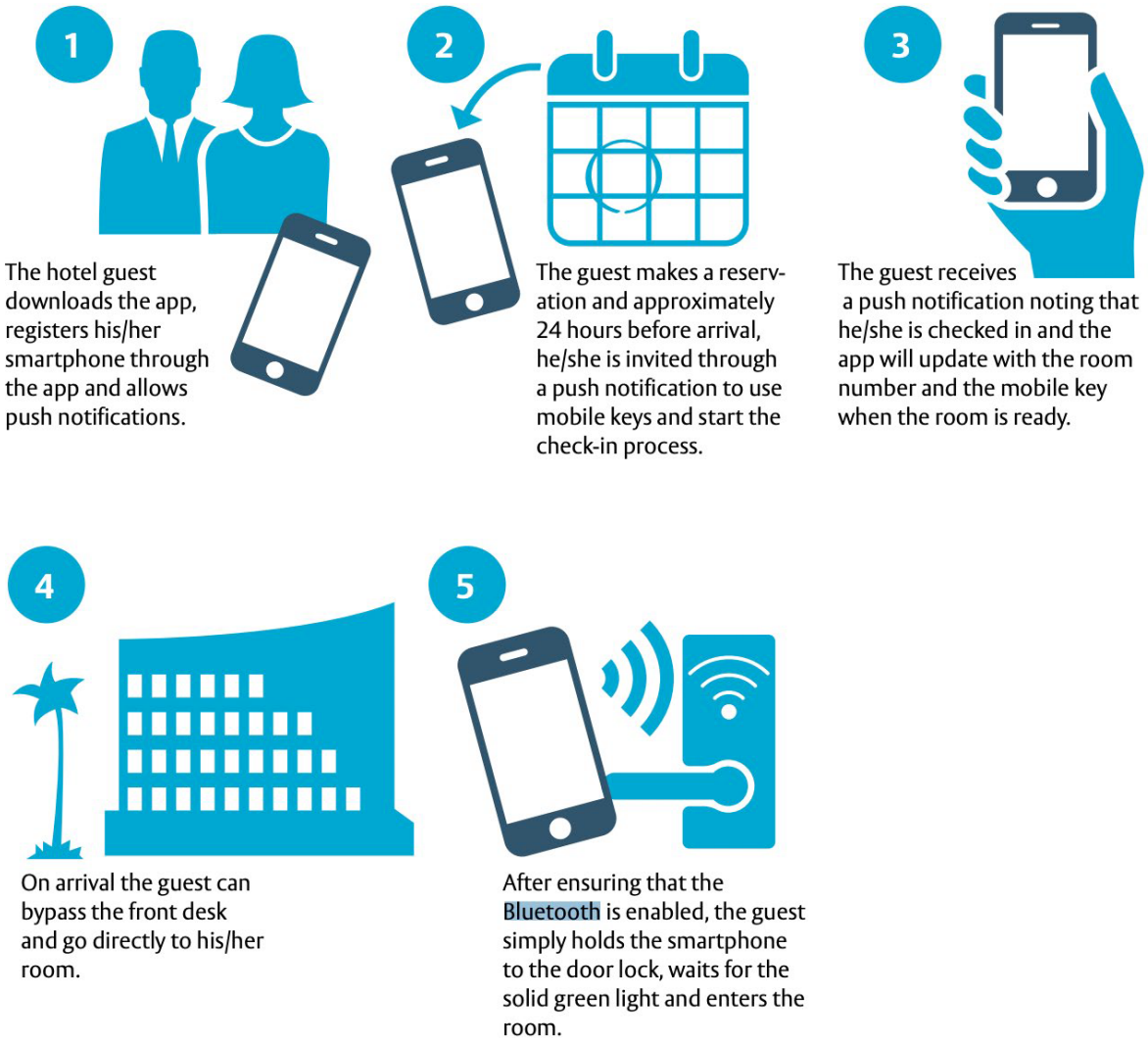
1017. The Accused Products provide features, functionality, hardware, and software that, e.g., permit a hotel to enter a hotel room reservation for a user into a reservation system.



Source: Ex. D, at D-9

<u>Answer</u>: AAGS admits that Exhibit D is labeled with the name "ASSA ABLOY Global Solutions," but responds that the Exhibit speaks for itself. The remaining allegations of Paragraph 1017 are vague and unclear, and therefore AAGS denies them on at least that basis. To the extent that the remaining allegations can be understood, AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1017 and thus denies the same. AAGS also denies the allegations of Paragraph 1017 to the extent they use terms of the Asserted Patents, and thus constitute legal conclusions.

1018. The Accused Products also generate reservation information based on the user's reservation and transmit that reservation information to an application on a portable device of the user.



Source: Ex. D, at D-6

Answer: AAGS admits that Exhibit D is labeled with the name "ASSA ABLOY Global Solutions," but responds that the Exhibit speaks for itself. The remaining allegations of Paragraph 1018 are vague and unclear, and therefore AAGS denies them on at least that basis. To the extent the remaining allegations can be understood, AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1018 and

thus denies the same. AAGS also denies the allegations of Paragraph 1018 to the extent they use terms of the Asserted Patents, and thus constitute legal conclusions.

1019. The application on the portable device transmits a message to an access device of a door lock and the access device activates the door lock.

Answer: AAGS admits that Exhibit D is labeled with the name "ASSA ABLOY Global Solutions," but responds that the Exhibit speaks for itself. The remaining allegations of Paragraph 1019 are vague and unclear, and therefore AAGS denies them on at least that basis. To the extent the remaining allegations can be understood, AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1019 and thus denies the same. AAGS also denies the allegations of Paragraph 1019 to the extent they use terms of the Asserted Patents, and thus constitute legal conclusions.

Source: Ex. D, at D-6

1020. In marketing the Accused Products, AAGS represents that "You can choose between three variants of the solution depending on your needs."

Our Mobile Access options for hotels

You can choose between three variants of the solution depending on your needs.

Customer Integration

This solution is created for hotels with their own app initiatives that want to integrate mobile access into their own apps and back end systems. ASSA ABLOY Global Solutions provides a Mobile Access Software Development kit (SDK) together with dedicated onboarding services to facilitate seamless integration.

Third Party Certified Partner App

This solution suits hotels that want mobile app functionality beyond just access control, but don't yet have their own in-house app initiatives. They can here pick a solution from one of our selected app specialist partners, who through our Certified Partner Program already have integrated our mobile access functionality into their products.

ASSA ABLOY Global Solutions Mobile Access App

This is our own ready-to-use, off-the-shelf solution. The app suits hotels that want to provide basic mobile access solutions to their guests in a simple to use format. There are no integrations or third-party dependencies required.

We publish a general app that is available in the App Store and on Google Play. Through an administration portal, hotels can customize their digital key graphics to reflect company branding or design. This will then show in a "Passbook" inspired style for the hotel to use.

Unlock Your Door in a Second with Your iPhone or Apple Watch

With room key in Apple Wallet, guests can access their rooms, elevators, and common spaces like the gym and the pool using just their iPhone or Apple Watch. It's easy, convenient and private. Room key in Apple Wallet integrates into existing access control systems, is simple to distribute and manage, and takes advantage of the built-in security features of iPhone and Apple Watch.

Source: Ex. E, at E-12

Answer: AAGS admits that "You can choose between three variants of the solution depending on your needs" is an accurate quote of the cited Exhibit, but responds that the Exhibit speaks for itself. To the extent there are any additional allegations in Paragraph 1020, AAGS denies them.

1021. AAGS's "Mobile Key" provides a "works by generating an encrypted digital key that is transmitted to users' smart devices and safely stored in a key vault on a mobile app. When presented to the appropriate door lock, the app then transmits digital key information over a secure communication channel, ensuring that only authorized users are able to gain access." See Ex. F, at F-2,

Answer: The allegations of Paragraph 1021 are vague and unclear, and therefore AAGS denies them on at least that basis. To the extent the allegations can be understood, AAGS admits that Paragraph 1021 contains two accurate quotes of the cited Exhibit, but AAGS lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 1021 and thus denies the same.

1022. Based upon public information, AAGS, directly and/or through its agents, intermediaries, customers, and/or employees use, advertise, provide, and/or educate third parties about the Accused Products. See Ex. D, Ex. E, and Ex. F.

Answer: The allegations of Paragraph 1022 are vague and unclear, and therefore AAGS denies them on at least that basis. To the extent the allegations can be understood, AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1022 and thus denies the same. AAGS also denies the allegations of Paragraph 1022 to the extent they constitute legal conclusions.

COUNT I: Infringement of U.S. Patent No. 9,373,205

1023. Liberty Access repeats and re-alleges the allegations in the Paragraphs of its Counterclaims above as though fully set forth in their entirety.

Answer: AAGS incorporates by reference as if fully set forth herein its Answers to the Paragraphs of Liberty's Counterclaims above.

1024. The USPTO duly issued U.S. Patent No. 9,373,205 (the "'205 patent") on June 21, 2015, after full and fair examination of Application No 14/603,434, which was filed on January 23, 2015. See Ex. A, at A-1. A Reexamination Certificate was issued on February 25, 2022, after supplemental examination of application No. 96/000,367. *See id.*, at A-18–21.

Answer: AAGS admits that a copy of the '205 patent obtained from the USPTO's website indicates that the '205 patent has an issue date of June 21, 2016 (but denies the '205 patent issued on June 21, 2015, as Liberty's Answer alleges) and is based on Application No. 14/603,434, which the copy of the patent indicates was filed on January 23, 2015. AAGS further

admits that records from the USPTO's website indicate that a Reexamination Certificate with a patent number of 9,373,205 and a supplemental examination request number of 96/000,367 includes a certificate issuance date of February 25, 2022. AAGS further admits that a purported copy of the '205 patent is attached to Liberty's Answer as Exhibit A. AAGS is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 1024, and therefore denies the same.

1025. Liberty Access is the exclusive licensee of the '205 patent with all substantial rights, and interest in and to the '205 patent, including the sole and exclusive right to prosecute this action and enforce the '205 patent against infringers, and to collect damages for all relevant times.

Answer: AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1025 and thus denies the same.

1026. Liberty Access or its predecessors-in-interest have satisfied all statutory obligations required to collect pre-filing damages for the full period allowed by law for infringement of the '205 patent.

Answer: AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1026 and thus denies the same.

1027. The claims of the '205 patent are not directed to an abstract idea and are not limited to well-understood, routine, or conventional activity. Rather, the claimed inventions include inventive components that allow for secure access to control of a door lock based on information contained in a current reservation certificate.

Answer: The allegations in Paragraph 1027 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1027.

1028. The written description of the '205 patent describes in technical detail each limitation of the claims, allowing a skilled artisan to understand the scope of the claims and how the non-conventional and non-generic combination of claim limitations is patently distinct from and improved upon what may have been considered conventional or generic in the art priority date. The '205 patent also identifies and circumscribes all information necessary for a skilled artisan to perform each limitation in the claims in light of that which was known in the art at the priority date.

Answer: The allegations in Paragraph 1028 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1028.

1029. AAGS has infringed one or more claims of the '205 patent by using, providing, supplying, or distributing the Accused Products.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the '205 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. AAGS denies any remaining allegations in Paragraph 1029.

1030. AAGS has directly infringed, either literally or under the doctrine of equivalents, at least claim 5 of the '205 patent.

Answer: AAGS specifically denies that it has directly or indirectly infringed claim 5 (or any other claim) of the '205 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. AAGS denies any remaining allegations in Paragraph 1030.

1031. For example, the Accused Products provide an access device for use in an access control system, the access device comprising: a processor having control of a door lock; and a communication module connected to the processor, the processor is configured to receive a reservation certificate presented by a portable terminal through the communication module; wherein, when a current reservation certificate that comprises an interval of a reservation is presented by the portable terminal, the processor is configured to compare the interval of the reservation of the current reservation certificate to a current time accessible to the processor, determine the current time is within the interval of the reservation, and activate the door lock to allow the portable terminal to unlock the door lock during the interval of the reservation, as recited in claim 5.

Answer: AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1031 and thus denies the same. AAGS also specifically denies any act of infringement. AAGS also denies the allegations of Paragraph 1031 to the extent they use terms of the Asserted Patents, and thus constitute legal conclusions.

1032. The processor of the Accused Products also has access to the current time, the reservation certificate comprises data representative of an interval of the

reservation, and the processor activates the door lock during the interval, as recited in claim 5.

Answer: AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1032 and thus denies the same. AAGS also specifically denies any act of infringement. AAGS also denies the allegations of Paragraph 1032 to the extent they use terms of the Asserted Patents, and thus constitute legal conclusions.

1033. Since at least August 18, 2022, AAGS has also indirectly infringed and continues to indirectly infringe one or more claims of the '205 patent by inducing others to directly infringe one or more claims of the '205 patent. AAGS has induced and continues to induce its subsidiaries, parents, partners, affiliates, employees, and end-users, including its customers and potential customers, to directly infringe, either literally or under the doctrine of equivalents, one or more claims of the '205 patent by using the Accused Products. AAGS took active steps, directly or through contractual relationships with others, with the specific intent to cause them to use the Accused Products in a manner that infringes one or more claims of the '205 patent, including, for example, claim 5 of the '205 patent. Such steps by AAGS included, among other things, advising or directing personnel, subsidiaries, affiliates, contractors, or end-users to make or use the Accused Products in an infringing manner; advertising and promoting the use of the Accused Products in an infringing manner; or distributing instructions that guide users to use the Accused Products in an infringing manner. AAGS is performing these steps, which constitute induced infringement with the knowledge of the '205 patent and with the knowledge that the induced acts constitute infringement. AAGS is aware that the normal and customary use of the Accused Products by others would infringe one or more claims of the '205 patent. AAGS's inducement is ongoing.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the '205 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. The allegations in Paragraph 1033 contain legal conclusions, which require no response. AAGS denies any remaining allegations in Paragraph 1033.

1034. AAGS has also indirectly infringed and continues to indirectly infringe by contributing to the infringement of one or more claims of the '205 patent. AAGS has contributed and continues to contribute to the direct infringement of one or more claims of the '205 patent by personnel, contractors, subsidiaries, affiliates, customers, and other end users by encouraging them to use the Accused Products to perform the steps of the patented process as described in one or more claims of the '205 patent including, but not limited to, provided access to coding, software, or functionalities that allow customers and end users to incorporate functionality from

AAGS's applications into those customers' and end users' proprietary brand applications or websites. The Accused Products have special features that are specially designed to be used in an infringing way and that have no substantial uses other than ones that infringe one or more claims of the '205 patent, including, for example, claim 5 of the '205 patent. The special features include, for example, the method recited in claim 5, including all the intermediary steps. The special features constitute a material part of the invention of one or more of the claims of the '205 patent and are not staple articles of commerce suitable for substantial non-infringing use. AAGS's contributory infringement is ongoing.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the '205 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. The allegations in Paragraph 1034 contain legal conclusions, which require no response. AAGS denies any remaining allegations in Paragraph 1034.

1035. To the extent that AAGS is not the only direct infringer of one or more claims of the '205 patent, it instructs its subsidiaries, customers, and end users on how to infringe the through its support and sales to them. See Ex. D, Ex. E, and Ex. F.

Answer: The allegations of Paragraph 1035 are vague and unclear, especially based on the language of "how to infringe the [sic] through its support and sales" and therefore AAGS denies them on at least that basis. To the extent the allegations can be understood, AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1035 and thus denies the same. AAGS specifically denies that it has directly or indirectly infringed any claim of the '205 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. The allegations in Paragraph 1035 also contain legal conclusions, which require no response. AAGS denies any remaining allegations in Paragraph 1035.

1036. Since at least August 18, 2022, AAGS's direct and indirect infringement of one or more claims of the '205 patent was, has been, and continues to be willful, intentional, deliberate, or in conscious disregard of Liberty Access' rights under the patent.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the '205 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. The allegations in Paragraph 1036 contain legal conclusions, which require no response. AAGS denies any remaining allegations in Paragraph 1036.

1037. On information and belief, AAGS has a policy or practice of not reviewing the patents of others (including instructing its employees to not review the patents of others), and thus has been willfully blind of Liberty Access' patent rights).

Answer: The allegations in Paragraph 1037 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1037.

1038. AAGS's actions were at least objectively reckless as to the risk of infringing a valid patent and this objective risk was either known or should have been known by AAGS.

Answer: The allegations in Paragraph 1038 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1038.

1039. Liberty Access has been damaged as a result of the infringing conduct by AAGS alleged above. Thus, AAGS is liable to Liberty Access in an amount that compensates it for such infringement, which by law cannot be less than a reasonable royalty, together with interest and costs as fixed by this Court under 35 U.S.C. § 284.

Answer: AAGS denies the allegations in Paragraph 1039. AAGS also specifically denies any alleged infringement.

1040. Liberty Access has suffered and continues to suffer irreparable harm, through its loss of market share and goodwill, for which there is no adequate remedy at law. Liberty Access has and will continue to suffer this harm by virtue of AAGS's infringement of one or more claims of one or more claims of the '205 patent. AAGS's actions have interfered with and will continue to interfere with Liberty Access' ability to license technology. The balance of hardships favors Liberty Access' ability to commercialize its own ideas and technology. The public interest in allowing Liberty Access to enforce its right to exclude outweighs other public interests, which supports injunctive relief in this case.

Answer: The allegations in Paragraph 1040 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1040.

COUNT II: Infringement of U.S. Patent No. 10,657,747

1041. Liberty Access repeats and re-alleges the allegations in the Paragraphs of its Counterclaims above as though fully set forth in their entirety.

Answer: AAGS incorporates by reference as if fully set forth herein its Answers to the Paragraphs of Liberty's Counterclaims above.

1042. The USPTO duly issued U.S. Patent No. 10,657,747 (the "'747 patent") on May 19, 2020, after full and fair examination of Application No. 16/034,278, which was filed on July 12, 2018. See Ex. B, at B-1.

Answer: AAGS admits that a copy of the '747 patent obtained from the USPTO's website indicates that the '747 patent has an issue date of May 19, 2020, and is based on Application No. 16/034,278, which the copy of the patent indicates was filed on July 12, 2018. AAGS further admits that a purported copy of the '747 patent is attached to Liberty's Answer as Exhibit B. AAGS is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 1042, and therefore denies the same.

1043. Liberty Access is the exclusive licensee of the '747 patent with all substantial rights, and interest in and to the '747 patent, including the sole and exclusive right to prosecute this action and enforce the '747 patent against infringers, and to collect damages for all relevant times.

Answer: AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1043 and thus denies the same.

1044. Liberty Access or its predecessors-in-interest have satisfied all statutory obligations required to collect pre-filing damages for the full period allowed by law for infringement of the '747 patent.

Answer: AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1044 and thus denies the same.

1045. The claims of the '747 patent are not directed to an abstract idea and are not limited to well-understood, routine, or conventional activity. Rather, the claimed inventions include inventive components that improve upon the function and operation of preexisting systems and methods for secure access to control of a door lock based on information contained in a reservation certificate.

Answer: The allegations in Paragraph 1045 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1045.

1046. The written description of the '747 patent describes in technical detail each limitation of the claims, allowing a skilled artisan to understand the scope of the claims and how the non-conventional and non-generic combination of claim limitations is patently distinct from and improved upon what may have been considered conventional or generic in the art at the priority date. The '747 patent also identifies and circumscribes all information necessary for a skilled artisan to perform each limitation in the claims in light of that which was known in the art at the priority date.

Answer: The allegations in Paragraph 1046 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1046.

1047. AAGS has infringed and continue to infringe one or more claims of the '747 patent by making, using, providing, supplying, selling, offering for sale, or distributing the Accused Products.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the '747 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. AAGS denies any remaining allegations in Paragraph 1047.

1048. AAGS has directly infringed and continues to directly infringe, either literally or under the doctrine of equivalents, at least claim 1 of the '747 patent.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the '747 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. AAGS denies any remaining allegations in Paragraph 1048.

1049. For example, the Accused Products provide an access control system comprising an access device comprising a communication module connected to a processor having control of a door lock; a secure reservation interface to receive a reservation request from a first device for a reservation at a given destination, the reservation interface comprising one or more screens for receiving a selection of a location at the destination and an interval of the reservation; a reservation server, in communication with the reservation interface and a network, to receive the reservation request for the destination that includes a selected location at the destination and an interval of the reservation; issue a reservation certificate describing the interval of the reservation based on the reservation request and the selected location; and 3) transmit, via the network, from the reservation server to a

second device distinct from the first device, the reservation certificate and a communication setting corresponding to the access device, d) an application installed on the second device to receive the reservation certificate and the communication setting corresponding to the access device, wherein the application wirelessly transmits the reservation certificate to the access device using the communication setting upon receipt of a command to activate the door lock; and e) wherein the access device receives the reservation certificate from the application based on use by the application of the communication setting, and the processor activates the door lock based on at least the receipt of the reservation certificate.

Answer: AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1049 and thus denies the same. AAGS also specifically denies any act of infringement. AAGS also denies the allegations of Paragraph 1049 to the extent they use terms of the Asserted Patents, and thus constitute legal conclusions.

1050. Since at least August 18, 2022, AAGS has also indirectly infringed and continues to indirectly infringe one or more claims of the '747 patent by inducing others to directly infringe one or more claims of the '747 patent. AAGS has induced and continues to induce its subsidiaries, parents, partners, affiliates, employees, and end-users, including its customers and potential customers, to directly infringe, either literally or under the doctrine of equivalents, one or more claims of the '747 patent by using the Accused Products. AAGS took active steps, directly or through contractual relationships with others, with the specific intent to cause them to use the Accused Products in a manner that infringes one or more claims of the '747 patent, including, for example, claim 1 of the '747 patent. Such steps by AAGS included, among other things, advising or directing personnel, contractors, or end-users to make or use the Accused Products in an infringing manner; advertising and promoting the use of the Accused Products in an infringing manner; or distributing instructions that guide users to use the Accused Products in an infringing manner. AAGS is performing these steps, which constitutes induced infringement with the knowledge of the '747 patent and with the knowledge that the induced acts constitute infringement. AAGS is aware that the normal and customary use of the Accused Products by others would infringe one or more claims of the '747 patent. AAGS's inducement is ongoing. See Ex. D, Ex. E, and Ex. F.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the '747 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. The allegations of Paragraph 1050 also contain legal conclusions, which require no response. AAGS denies any remaining allegations in Paragraph 1050.

1051. AAGS has also indirectly infringed and continues to indirectly infringe by contributing to the infringement of one or more claims of the '747 patent. AAGS has contributed and continue to contribute to the direct infringement of one or more claims of the '747 patent by personnel, contractors, subsidiaries, affiliates, customers, and other end users by encouraging them to use the Accused Products to perform the steps of the patented process as described in one or more claims of the '747 patent including, but not limited to, provided access to coding, software, or functionalities that allow customers and end users to incorporate functionality from AAGS's applications into those customers' and end users' proprietary brand applications or websites. The Accused Products have special features that are specially designed to be used in an infringing way and that have no substantial uses other than ones that infringe one or more claims of the '747 patent, including, for example, claim 1 of the '747 patent. The special features include, for example, the method recited in claim 1, including all the intermediary steps. The special features constitute a material part of the invention of one or more of the claims of the '747 patent and are not staple articles of commerce suitable for substantial non-infringing use. AAGS's contributory infringement is ongoing. See Ex. D, Ex. E, and Ex. F.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the '747 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. The allegations of Paragraph 1051 also contain legal conclusions, which require no response. AAGS denies any remaining allegations in Paragraph 1051.

1052. To the extent that AAGS is not the only direct infringer of one or more claims of the '747 patent, it instructs its subsidiaries, customers, and end users on how to infringe the through its support and sales to them. See Ex. D, Ex. E, and Ex. F.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the '747 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. The allegations of Paragraph 1052 also contain legal conclusions, which require no response. AAGS denies any remaining allegations in Paragraph 1052.

1053. Since at least August 18, 2022, AAGS's direct and indirect infringement of one or more claims of the '747 patent was, has been, and continues to be willful, intentional, deliberate, or in conscious disregard of Liberty Access' rights under the patent.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the '747 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. AAGS denies any remaining allegations in Paragraph 1053.

1054. Furthermore, on information and belief, AAGS has a policy or practice of not reviewing the patents of others (including instructing its employees to not review the patents of others), and thus has been willfully blind of Liberty Access' patent rights.

Answer: The allegations in Paragraph 1054 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1054.

1055. AAGS's actions are at least objectively reckless as to the risk of infringing a valid patent and this objective risk was either known or should have been known by AAGS.

Answer: The allegations in Paragraph 1055 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1055.

1056. Liberty Access has been damaged and continues to be damaged as a result of the infringing conduct by AAGS alleged above. Thus, AAGS is liable to Liberty Access in an amount that compensates it for such infringement, which by law cannot be less than a reasonable royalty, together with interest and costs as fixed by this Court under 35 U.S.C. § 284.

Answer: The allegations in Paragraph 1056 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1056. AAGS also specifically denies any alleged infringement.

1057. Liberty Access has suffered and continues to suffer irreparable harm, through its loss of market share and goodwill, for which there is no adequate remedy at law. Liberty Access has and will continue to suffer this harm by virtue of AAGS's infringement of one or more claims of one or more claims of the '747 patent. AAGS's actions have interfered with and will continue to interfere with Liberty Access' ability to license technology. The balance of hardships favors Liberty Access' ability to commercialize its own ideas and technology. The public interest in allowing Liberty Access to enforce its right to exclude outweighs other public interests, which supports injunctive relief in this case.

Answer: The allegations in Paragraph 1057 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1057.

COUNT III: Infringement of U.S. Patent No. 11,373,474

1058. Liberty Access repeats and re-alleges the allegations in the Paragraphs of its Counterclaims above as though fully set forth in their entirety.

Answer: AAGS incorporates by reference as if fully set forth herein its Answers to the Paragraphs of Liberty's Counterclaims above.

1059. The USPTO duly issued U.S. Patent No. 11,373,474 (the "'474 patent") on June 28, 2022, after full and fair examination of Application No. 17/646,837, which was filed on January 3, 2022. See Ex. C, at C-1.

Answer: AAGS admits that a copy of the '474 patent obtained from the USPTO's website indicates that the '474 patent has an issue date of June 28, 2022, and is based on Application No. 17/646,837, which the copy of the patent indicates was filed on January 3, 2022. AAGS further admits that a purported copy of the '474 patent is attached to Liberty's Answer as Exhibit C. AAGS is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 1059, and therefore denies the same.

1060. Liberty Access is the exclusive licensee of the '474 patent with all substantial rights, and interest in and to the '474 patent, including the sole and exclusive right to prosecute this action and enforce the '474 patent against infringers, and to collect damages for all relevant times.

Answer: AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1060 and thus denies the same.

1061. Liberty Access or its predecessors-in-interest have satisfied all statutory obligations required to collect pre-filing damages for the full period allowed by law for infringement of the '474 patent.

Answer: AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1061 and thus denies the same.

1062. The claims of the ’474 patent are not directed to an abstract idea and are not limited to well-understood, routine, or conventional activity. Rather, the claimed inventions include inventive components that improve upon the function and operation of preexisting systems and methods secure access to control of a door lock based on information contained in a reservation certificate.

Answer: The allegations in Paragraph 1062 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1062.

1063. The written description of the ’474 patent describes in technical detail each limitation of the claims, allowing a skilled artisan to understand the scope of the claims and how the non-conventional and non-generic combination of claim limitations is patently distinct from and improved upon what may have been considered conventional or generic in the art at the priority date. The ’474 patent also identifies and circumscribes all information necessary for a skilled artisan to perform each limitation in the claims in light of that which was known in the art at the priority date.

Answer: The allegations in Paragraph 1063 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1063.

1064. AAGS has infringed and continue to infringe one or more claims of the ’474 patent by making, using, providing, supplying, selling, offering for sale, or distributing the Accused Products.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the ’474 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. AAGS denies any remaining allegations in Paragraph 1064.

1065. AAGS has directly infringed and continue to directly infringe, either literally or under the doctrine of equivalents at least claim 1 of the ’474 patent.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the ’474 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. AAGS denies any remaining allegations in Paragraph 1065.

1066. For example, the Accused Products provide an access control system comprising an access device comprising a communication module connected to a processor having control of a door lock, an application on a portable terminal and a server to provide a communication setting to the application, the communication setting corresponding to the access device, and to further provide to the application

a reservation certificate comprising an interval of a reservation, wherein the application compares the interval of the reservation to a current time accessible to the application to determine if the reservation certificate is current and activates the door lock by communicating with the access device via the communication setting when the application determines that the reservation certificate is current.

Answer: AAGS lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1066 and thus denies the same. AAGS also denies the allegations of Paragraph 1066 to the extent they use terms of the Asserted Patents, and thus constitute legal conclusions. AAGS also specifically denies any act of infringement.

1067. Since at least August 18, 2022, AAGS has also indirectly infringed and continues to indirectly infringe one or more claims of the '474 patent by inducing others to directly infringe one or more claims of the '474 patent. AAGS has induced and continues to induce its subsidiaries, parents, partners, employees, affiliates, and end-users, including its and potential customers, to directly infringe, either literally or under the doctrine of equivalents, one or more claims of the '474 patent by using the Accused Products. AAGS took active steps, directly or through contractual relationships with others, with the specific intent to cause them to use the Accused Products in a manner that infringes one or more claims of the '474 patent, including, for example, claim 1 of the '474 patent. Such steps by AAGS included, among other things, advising or directing personnel, contractors, or end-users to make or use the Accused Products in an infringing manner; advertising and promoting the use of the Accused Products in an infringing manner; or distributing instructions that guide users to use the Accused Products in an infringing manner. AAGS is performing these steps, which constitutes induced infringement with the knowledge of the '474 patent and with the knowledge that the induced acts constitute infringement. AAGS is aware that the normal and customary use of the Accused Products by others would infringe one or more claims of the '474 patent. AAGS's inducement is ongoing. See Ex. D, Ex. E, and Ex. F.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the '474 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. The allegations of Paragraph 1067 also contain legal conclusions, which require no response. AAGS denies any remaining allegations in Paragraph 1067.

1068. AAGS has also indirectly infringed and continues to indirectly infringe by contributing to the infringement of one or more claims of the '474 patent. AAGS has contributed and continues to contribute to the direct infringement of one or more claims of the '474 patent by personnel, contractors, subsidiaries, affiliates, customers, and other end users by encouraging them to use the Accused Products to

perform the steps of the patented process as described in one or more claims of the '474 patent including, but not limited to, provided access to coding, software, or functionalities that allow customers and end users to incorporate functionality from AAGS's applications into those customers' and end users' proprietary brand applications or websites. The Accused Products have special features that are specially designed to be used in an infringing way and that have no substantial uses other than ones that infringe one or more claims of the '474 patent, including, for example, claim 1 of the '474 patent. The special features include, for example, the method recited in claim 1, including all the intermediary steps. The special features constitute a material part of the invention of one or more of the claims of the '474 patent and are not staple articles of commerce suitable for substantial non-infringing use. AAGS's contributory infringement is ongoing. See Ex. D, Ex. E, and Ex. F.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the '474 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. The allegations of Paragraph 1068 also contain legal conclusions, which require no response. AAGS denies any remaining allegations in Paragraph 1068.

1069. To the extent that AAGS is not the only direct infringer of one or more claims of the '474 patent, it instructs its subsidiaries, customers, and end users on how to infringe the through its support and sales to them. See Ex. D, Ex. E, and Ex. F.

Answer: AAGS specifically denies that it has directly or indirectly infringed any claim of the '474 patent, literally or under the doctrine of equivalents, in this judicial district or elsewhere in the United States. AAGS denies any remaining allegations in Paragraph 1069.

1070. Since at least August 18, 2022, AAGS's direct and indirect infringement of one or more claims of the '474 patent was, has been, and continues to be willful, intentional, deliberate, or in conscious disregard of Liberty Access' rights under the patent.

Answer: The allegations in Paragraph 1070 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1070.

1071. Furthermore, on information and belief, AAGS has a policy or practice of not reviewing the patents of others (including instructing its employees to not review the patents of others), and thus has been willfully blind of Liberty Access' patent rights.

Answer: The allegations in Paragraph 1071 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1071.

1072. AAGS's actions are at least objectively reckless as to the risk of infringing a valid patent and this objective risk was either known or should have been known by AAGS.

Answer: The allegations in Paragraph 1072 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1072.

1073. Liberty Access has been damaged and continues to be damaged as a result of the infringing conduct by AAGS alleged above. Thus, AAGS is liable to Liberty Access in an amount that compensates it for such infringement, which by law cannot be less than a reasonable royalty, together with interest and costs as fixed by this Court under 35 U.S.C. § 284.

Answer: AAGS denies the allegations in Paragraph 1073. AAGS also specifically denies any alleged infringement.

1074. Liberty Access has suffered and continues to suffer irreparable harm, through its loss of market share and goodwill, for which there is no adequate remedy at law. Liberty Access has and will continue to suffer this harm by virtue of AAGS's infringement of one or more claims of one or more claims of the '474 patent. AAGS's actions have interfered with and will continue to interfere with Liberty Access' ability to license technology. The balance of hardships favors Liberty Access' ability to commercialize its own ideas and technology. The public interest in allowing Liberty Access to enforce its right to exclude outweighs other public interests, which supports injunctive relief in this case.

Answer: The allegations in Paragraph 1074 are legal conclusions, which require no response. To the extent a response is required, AAGS denies the allegations in Paragraph 1074.

RESPONSE TO LIBERTY ACCESS' PRAYER FOR RELIEF

Defendant denies any act of infringement regarding the '205 patent, the '747 patent, and the '474 patent (the "Asserted Patents"). Defendant specifically denies the allegations by Liberty of direct, induced, or contributory infringement of one or more claims of the Asserted Patents, either literally or under the doctrine of equivalents. Defendant denies that Liberty is entitled to any form of relief at all and denies that Liberty is entitled to the relief sought in the prayer for

relief. Accordingly, the prayer by Liberty should be denied in its entirety with prejudice, and Liberty should take nothing.

AFFIRMATIVE DEFENSES TO LIBERTY ACCESS' COUNTERCLAIMS

Without conceding that any of the following must necessarily be pleaded as an affirmative defense, or that any of the following is not already at issue by virtue of the forgoing denials, and without prejudice to AAGS's rights to plead additional defenses as discovery into the facts of the matter warrant, AAGS adopts and incorporates by reference, as if set forth herein, any affirmative defense asserted by any other defendant in this action to the extent that such affirmative defenses would be applicable to AAGS, and AAGS also asserts the following affirmative defenses:

FIRST AFFIRMATIVE DEFENSE
(Noninfringement)

Liberty is not entitled to any relief against AAGS because AAGS has not infringed, and is not infringing directly, indirectly, by induced or contributory infringement, or in any way (either literally or under the doctrine of equivalents), any valid and enforceable claim of the any of the Asserted Patents. AAGS incorporates by reference the noninfringement allegations raised in AAGS's First Amended Complaint, and any subsequent supplements thereto.

SECOND AFFIRMATIVE DEFENSE
(Invalidity)

The claims of the Asserted Patents are invalid at least due to anticipation by or obviousness over the prior art, and they are directed towards ineligible subject matter. To the extent the claimed products and/or systems are allegedly practiced by AAGS, those claims are invalid under 35 U.S.C. §§ 101, 102, 103, and/or 112.

THIRD AFFIRMATIVE DEFENSE
(Unenforceability of the Asserted Patents)

Liberty and its agents intentionally withheld from the USPTO material information related to the alleged patentability of the asserted patents, rendering them unenforceable. *Therasense, Inc. v. Becton, Dickinson and Co.*, 649 F. 3d 1276, 1287 (Fed. Cir. 2011) ("To prevail on the defense of inequitable conduct, the accused infringer must prove that the applicant misrepresented or omitted material information with the specific intent to deceive the PTO."); *see also Intercontinental Great Brands LLC v. Kellogg N. Am. Co*., 869 F.3d 1336, 1342 (Fed. Cir. 2017) (applying the *Therasense* standard when the subject patent was undergoing reexamination).

The prosecution histories of the asserted patents show that Liberty, its affiliate, Urban Intel, Inc. (the apparent owner of the asserted patents), the alleged inventors (Chris Outwater and William Gibbens Redmann), and the prosecuting attorneys at Kasha Law LLC, John and Kelly Kasha, must have known about material prior art and withheld that art from the Patent Office, at least during the reexamination of the '205 patent filed by Urban Intel (Reexamination No. 96/000,367).

John Kasha and Kelly Kasha, who prosecuted the '205 patent, as well as its alleged inventors, Chris Outwater and William Gibbens Redmann, intentionally and knowingly failed to disclose material information during the prosecution of the '205 patent in violation of the duty of candor owed to the USPTO. Had any one of these individuals disclosed this information as required, the '205 patent would not have survived reexamination.

On October 18, 2018, during prosecution of the application that would become the '747 patent, Urban Intel, through its attorney Kelly Kasha, filed an information disclosure statement (IDS) that listed 40 prior art references, including U.S. Patent. Pub. Nos. 2009/0184801,

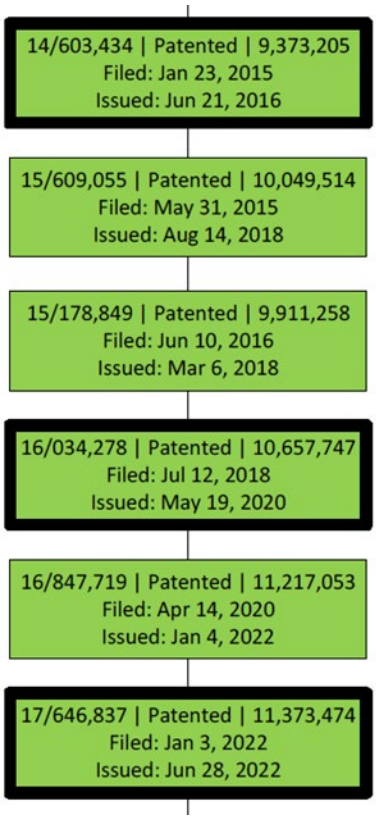
2010/0141381; and WO 2008/076074, which all name Olle Bliding as an inventor (collectively, the "Bliding References"). Ex. 1 at 82-88. The same IDS also disclosed a secondary reference, U.S. Patent Pub. No. 2010/0201536 to Robertson, et al. ("Robertson", referred to collectively with the "Bliding References" as the "Bliding and Robertson References"), which similarly disclosed claimed features in the '205 patent. *Id.* at 83. While Kelly Kasha signed the certification statement associated with the filing of these references, her knowledge of these references is also reasonably imputed to John Kasha, as they are the only attorneys listed on the website of their law firm (https://sites.google.com/a/kashalaw.com/www/home), both have participated extensively in the prosecution of the asserted patents, and both Kelly and John Kasha signed statements during the prosecution of the reissue application, from which the '747 patent was a continuation. See, e.g., Ex. 2 at 22-64 (Corrected Request for Supplemental Examination of U.S. Patent No. 9,373,205 signed by John Kasha), 98-100 (Request for Supplemental Examination Transmittal Form, signed by Kelly Kasha, with Part B Attachment).

The Bliding and Robertson References are material to all the claims of the asserted patents because they teach all of the elements of the '205 patent, from which the '747 and '474 patents are continuations, including both (1) the core limitations involving using a "reservation certificate" comprising ordinary information about the reservation to activate a door lock, and (2) the additional limitations directed towards comparing the interval of the reservation to the "reservation certificate" in determining whether to activate a door lock (the "temporal limitations"). *See Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d at 1288-92; *see, e.g.,* Bliding at p. 6, lines 1-6, 30-34 (explaining that "access defining data" may include "temporal data" and that matching data is a "requisite" for granting access); p. 12, lines 21-26 (explaining that "temporal data . . . defines one or more time frames during which access is permitted"); p.

18, lines 16-20 (explaining the interval during which a user may be allowed access through the lock device). Further emphasizing Bliding's materiality, combining the references, while permissible, is not even required because each reference, on its own, teaches the claimed elements of the '205 patent. *See Regeneron Pharms., Inc. v. Merus N.V.*, 864 F.3d 1343, 1350, 1355 (Fed. Cir. 2017) (explaining that to prove materiality, withheld references can be analyzed both individually and in combination).

Yet, on August 4, 2021, when Urban Intel, through its attorneys, sought reexamination of the '205 patent almost three years after Kasha Law LLC submitted an IDS during prosecution of the '747 patent, Kelly Kasha **omitted both the Bliding and Robertson References**. Ex. 2 at 98-100 (Request for Supplemental Examination Transmittal Form, signed by Kelly Kasha, with a Part B attachment not listing any of the Bliding and Robertson References). Moreover, on December 13, 2021, purported inventors Mssrs. Outwater and Redmann participated in an interview with the examiner for the reexamination of the '205 patent and withheld the Bliding References during the interview. *See* Ex. 2 at 231 (Examiner's Ex Parte Reexamination Interview Summary). Instead, Urban Intel, John Kasha, Kelly Kasha, and the inventors based the reexamination only on a narrower reference, U.S. Patent Pub. No. 2003/0208386 ("Brondrup"), which does not disclose the temporal limitations that Urban Intel would add, through its attorneys, during the reexamination. Ex. 2 at 316-22 (Claim Amendments submitted on January 31, 2022 by John Kasha). Having kept the material Bliding References from Patent Office scrutiny, Urban Intel secured its modified claims on February 25, 2022, *id.* at 340-41 (Ex Parte Reexamination Certificate), six months before Liberty asserted those claims against Marriott on August 18, 2022. Establishing a pattern of deception, Urban Intel also secured similar limitations in U.S. Patent No. 11,373,474 (the "'474 patent"), where on February 4, 2022 Kelly Kasha filed

an IDS that also omitted the Bliding and Robertson References. Ex. 3 at 91-93. For reference, an excerpt of Liberty's patent portfolio family tree, with the currently asserted patents bolded, is shown below.



John Kasha, Kelly Kasha, Chris Outwater, and William Gibbens Redmann must have known about the material Bliding and Robertson References because they were included in the October 18, 2018 IDS filed during examination of the application that became the '747 patent, which was filed ***before*** both the reexamination for the '205 patent and the filing of the application that became the '474 patent. *See Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F. 3d 1312 (Fed. Cir. 2009) (explaining that pleadings may meet the standard of Rule 9(b) if they "allege sufficient underlying facts from which a court may reasonably infer that a party acted with the requisite state of mind."); *see also* Ex. 1 at 82-88 (October 18, 2018 IDS), Ex. 2 at 22-64 (Corrected Request for Supplemental Examination of U.S. Patent No. 9,373,205, filed on August

4, 2021), Ex. 3 at 91-93 (IDS filed on February 4, 2022 for the application that became the '474 patent). Nevertheless, John Kasha, Kelly Kasha, Chris Outwater, and William Gibbens Redmann withheld these references from the Patent Office during the reexamination of the '205 patent, and instead offered the narrower Brondrup reference, with the intent to deceive the Patent Office into allowing Urban Intel to modify the '205 patent to cover limitations taught by the hidden Bliding and Robertson References. Moreover, during prosecution of the application that became the '474 patent, Kelly Kasha filed an IDS on February 4, 2022 that omitted the Bliding and Robertson References. Ex. 3 at 91-93. Thus, John Kasha, Kelly Kasha, Chris Outwater, and William Gibbens Redmann carefully selected which references to disclose to the Patent Office and which to not, demonstrating an intent to deceive the USPTO. *See American Calcar, Inc. v. American Honda Motor Co.*, 768 F.3d 1185, 1190 (Fed. Cir. 2014).

Moreover, the IDS was filed on October 18, 2018, while Liberty's case against Hilton in this District (Civil Action No. NDIL-1-18-cv-03627) was pending, and Liberty filed a stipulation to stay certain deadlines in the Hilton proceeding ***the very next day***, on October 19, 2018, and then moved to stay the Hilton proceedings entirely based on a "settlement" on October 23, 2018. Ex. 4 at 8. While discovery is needed to reveal whether these dates are a coincidence, there is at least a reasonable inference that Liberty, the alleged inventors, and Liberty's attorneys learned about the material Bliding and Robertson references during the Hilton litigation, and then actively chose not to disclose them during the reexamination to secure amended claims to reassert against AAGS's customer Marriott. *See Costar Realty Information, Inc. v. CIVIX-DDI, LLC*, 946 F. Supp. 2d 766, 777-79 (N.D. Ill. 2013) ("At the pleading stage, by contrast, the proponent of inequitable conduct need only plead sufficient facts that the court 'may reasonably infer' knowledge and intent. [Plaintiff's] allegations meet that standard, insofar as they identify a

plausible motive and opportunity for hiding the relevant references from the PTO.") (citing *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F. 3d at 1328-29 & n. 5) (citation omitted). Moreover, this inequitable conduct as to one patent poisons the entire portfolio. See *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d at 1288-89 ("[T]he taint of a finding of inequitable conduct can spread from a single patent to render unenforceable other related patents and applications in the same technology family.") (*citing Consol. Aluminum Corp. v. Foseco Int'l Ltd.*, 910 F.2d 804, 808-12 (Fed.Cir.1990)).

FOURTH AFFIRMATIVE DEFENSE
(Waiver, Acquiescence, Estoppel, and/or Statute of Limitations)

The remedies requested by Liberty under the asserted patent are barred by waiver, acquiescence, estoppel, and/or 35 U.S.C. § 286.

FIFTH AFFIRMATIVE DEFENSE
(Claim Construction Estoppel)

Liberty is estopped from asserting any interpretation of any of the claims of the asserted patent broadly enough to cover any of AAGS's products because of statements, representations, amendments, omissions, and/or concessions made to the USPTO during prosecution of the application for issuance of the Asserted Patents, during the reexamination of the '205 patent, or by reasons of prior acts.

SIXTH AFFIRMATIVE DEFENSE
(Prosecution History Estoppel)

Liberty is estopped from taking positions regarding the scope the asserted claims of the Asserted Patents to cover or include, either literally or by application of the doctrine of equivalents, methods used or products manufactured, used, imported, sold, or offered for sale by AAGS because of admissions, amendments, and statements to the USPTO during prosecution of

the applications leading to the issuance of the asserted patent or related family members, including statements made and acquiesced to during the reexaminations of the Asserted Patents.

SEVENTH AFFIRMATIVE DEFENSE
(No Willful Infringement)

Liberty is not entitled to a determination that AAGS willfully infringed any of the Asserted Patents at least because AAGS has not infringed and is not infringing directly, indirectly, by inducement of infringement or contributory infringement, or in any way (either literally or under the doctrine of equivalents), any valid and enforceable claims of the Asserted Patents. AAGS has not willfully or deliberately infringed any claim of the Asserted Patents.

EIGHTH AFFIRMATIVE DEFENSE
(Time Limitation on Obtaining a Reasonable Royalty)

Liberty's alleged damages are limited by 35 U.S.C. §154(d).

NINTH AFFIRMATIVE DEFENSE
(Failure to State a Claim)

Liberty's claims for relief fail to state a claim upon which relief can be granted.

TENTH AFFIRMATIVE DEFENSE
(Failure to Mark)

Liberty and/or its predecessors in interest failed to mark a patented product or provide actual notice of infringement in order to recover damages. See 35 U.S. Code § 287.

COUNTERCLAIMS

AAGS, as Counterclaimant, asserts the following counterclaims against Liberty.

NATURE OF THE ACTION

1. This is an action for declaratory judgment of invalidity arising under the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202.

THE PARTIES

2. Plaintiff ASSA ABLOY Global Solutions, Inc. ("AAGS" or "Plaintiff") is a corporation organized and existing under the laws of Texas and maintains its principal place of business at 631 International Parkway STE 100, Richardson, TX 75081.

3. On information and belief, Defendant Liberty Access Technologies Licensing LLC ("Defendant" or "Liberty") is a limited liability company organized and existing under the laws of Texas and having a principal place of business at 815 Brazos Street, Suite 500, Austin, Texas 78701.

JURISDICTION AND VENUE

4. The Court has subject matter jurisdiction over this action pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202; 28 U.S.C. §§ 1331 and 1338; and the Patent Laws of the United States, 35 U.S.C. §§ 1 et seq.

5. Venue in this Court is proper at least because the matters alleged arise from Liberty's counterclaims.

COUNT 1

(Declaratory Judgment of Invalidity of the '205 Patent)

6. The allegations of Paragraphs 1-5 of this Counterclaim are incorporated by reference as if fully set forth herein.

7. The asserted claims of the '205 patent are invalid because they fail to meet the patentability requirements of Title 35 of the United States Code, including but not limited to, 35 U.S.C. §§ 101, 102, 103, and/or 112.

8. As a non-limiting example, the asserted claims of the '205 patent are invalid as anticipated and/or obvious under 35 U.S.C. §§ 102 and 103 in view of at least: WO Publication

No. WO2008/076074 A1 ("*Knutsson*"), U.S. Patent Publication No. 2009/0219133 A1 ("*Woodard*"), U.S. Patent No. 8,730,004 B2 ("*Elfström*"), U.S. Patent No. 7,353,396 B2 ("*Micali*"), WO Publication No. WO2001/063425 A1 ("*Bröndrup*"), and Japanese Patent Publication No. 2002/083087 to Inoue et al. Accordingly, the claims are invalid.

9. As a non-limiting example, the asserted claims of the '205 patent are invalid as lacking written description and enablement for at least the elements of:

> "wherein . . . the processor is configured to compare the interval of the reservation . . . to a current time accessible to the processor," and
>
> "wherein . . . the processor is configured to . . . determine the current time is within the interval of the reservation."

Accordingly, the claims are invalid.

10. As another non-limiting example, the asserted claims of the '205 patent are invalid as they are directed to an abstract idea without significantly more. For example, the claimed embodiments merely apply existing generic components to make door access more convenient for a user. Nothing about the claimed combinations, however, provides any technological improvement.

COUNT 2

(Declaratory Judgment of Unenforceability of the '205 Patent)

11. Liberty and its agents intentionally withheld from the USPTO material information related to the alleged patentability of the asserted patents, rendering them unenforceable. *Therasense, Inc. v. Becton, Dickinson and Co.*, 649 F.3d 1276, 1287 (Fed. Cir. 2011).

12. On October 18, 2018, during prosecution of the application that would become the ’747 patent, Kelly Kasha filed an information disclosure statement (IDS) that listed 40 prior art references, including U.S. Patent. Pub. Nos. 2009/0184801, 2010/0141381; and WO 2008/076074, which all name Olle Bliding as an inventor (“the Bliding References”).

13. The same IDS also disclosed a secondary reference, U.S. Patent Pub. No. 2010/0201536 to Robertson, et al. (“Robertson”).

14. This IDS was filed before both the reexamination for the ’205 patent and the filing of the application that became the ’474 patent.

15. Robertson, like the Bliding References, similarly disclosed claimed features in the ’205 patent.

16. The Bliding and Robertson References are material to all the claims of the asserted patents because they teach all of the elements of the ’205 patent, from which the ’747 and ’474 patents are continuations, including both (1) the core limitations involving using a “reservation certificate” comprising ordinary information about the reservation to activate a door lock, and (2) the additional limitations directed towards comparing the interval of the reservation to the “reservation certificate” in determining whether to activate a door lock (the “temporal limitations”).

17. Had any of John Kasha, Kelly Kasha, Chris Outwater, or William Gibbens Redmann disclosed this information as required, the ’205 patent would not have survived reexamination.

18. John Kasha and Kelly Kasha prosecuted Reexamination Application No. 96/000,367, as both Kelly and John Kasha signed statements during the prosecution of this reissue application, from which the ’747 patent was a continuation.

19. John Kasha has participated in the prosecution of the asserted patents.

20. Kelly Kasha has participated in the prosecution of the asserted patents.

21. John Kasha and Kelly Kasha are the only attorneys listed at the website of their law firm.

22. Accordingly, while Kelly Kasha signed the certification statement associated with the filing of the Bliding References and Robertson during prosecution of the ’747 patent, her knowledge of these references is also reasonably imputed to John Kasha.

23. On August 4, 2021, almost three years after Kasha Law LLC submitted an IDS during prosecution of the ’747 patent, Urban Intel, through its attorney John Kasha, sought reexamination of the ’205 patent, and Urban Intel and Mr. Kasha omitted both the Bliding and Robertson References.

24. On December 13, 2021, Mssrs. Outwater and Redmann, the purported inventors of the ’205 patent, participated in an interview with the examiner for the reexamination of the ’205 patent and withheld the Bliding and Robertson References during the interview.

25. Instead, Urban Intel, John Kasha, Kelly Kasha, and the inventors based the reexamination only on a narrower reference, U.S. Patent Pub. No. 2003/0208386 (“Brondrup”), which, unlike the Bliding and Robertson References, does not disclose the temporal limitations that Urban Intel would add during the reexamination.

26. Urban Intel, through its attorneys, deceivingly offered the narrower Brondrup reference as relevant prior art when Urban Intel knew more relevant prior art references existed.

27. This focus on Brondrup without disclosing the Bliding and Robertson References was done with the intent to deceive the Patent Office into allowing Urban Intel to modify the ’205 patent to cover limitations taught by the hidden Bliding and Robertson References.

28. Having kept the material Bliding and Robertson References from Patent Office scrutiny, Urban Intel secured its modified claims on February 25, 2022, six months before Liberty asserted those claims against Marriott on August 18, 2022.

29. John Kasha, Kelly Kasha, Chris Outwater, and William Gibbens Redmann carefully selected which references to disclose to the Patent Office and which to not, exemplifying an intent to deceive the USPTO.

30. The IDS filed on October 18, 2018, during prosecution of the application that would become the ’747 patent, was filed while Liberty’s lawsuit against Hilton in this District (Civil Action No. NDIL-1-18-cv-03627) was pending.

31. The very next day, October 19, 2018, Liberty filed a stipulation to stay certain deadlines in the Hilton proceeding.

32. Four days after filing the stipulation, on October 23, 2018, Liberty moved to stay the Hilton proceedings entirely based on a “settlement.”

33. Liberty, the alleged inventors, and Liberty’s attorneys learned about the material Bliding and Robertson references during the Hilton litigation, and then actively chose not to disclose them during the reexamination of the ’205 patent, to secure amended claims to assert against AAGS’s customer Marriott.

34. There is at least plausible reasoning that John Kasha and Kelly Kasha, who prosecuted the ’205 patent, as well as its alleged inventors, Chris Outwater and William Gibbens Redmann, intentionally and knowingly failed to disclose material information during the prosecution of the ’205 patent in violation of the duty of candor owed to the USPTO.

35. Through this intentional withholding of the material Bliding and Robertson References by John Kasha, Kelly Kasha, Chris Outwater, and William Gibbens Redmann, the ’205 patent is unenforceable.

COUNT 3

(Declaratory Judgment of Invalidity of the ’747 Patent)

36. The allegations of Paragraphs 1-5 of this Counterclaim are incorporated by reference as if fully set forth herein.

37. The asserted claims of the ’747 patent are invalid because they fail to meet the patentability requirements of Title 35 of the United States Code, including but not limited to, 35 U.S.C. §§ 101, 102, 103, and/or 112.

38. As a non-limiting example, the asserted claims of the ’747 patent are invalid as anticipated and/or obvious under 35 U.S.C. §§ 102 and 103 in view of at least: WO Publication No. WO2008/076074 A1 (“*Knutsson*”), U.S. Patent Publication No. 2009/0219133 A1 (“*Woodard*”), U.S. Patent No. 8,730,004 B2 (“*Elfström*”), U.S. Patent No. 7,353,396 B2 (“*Micali*”), WO Publication No. WO2001/063425 A1 (“*Bröndrup*”), and Japanese Patent Publication No. 2002/083087 to Inoue et al. Accordingly, the claims are invalid.

39. As another non-limiting example, the asserted claims of the ’747 patent are invalid as lacking written description and enablement for at least the elements of:

> “transmit, via the network, from the reservation server to a second device distinct from the first device, the reservation certificate and a communication setting corresponding to the access device,” and
>
> “the access device receives the reservation certificate from the application based on use by the application of the communication setting.”

Accordingly, the claims are invalid.

40. As another non-limiting example, the asserted claims of the ’747 patent are invalid as they are directed to an abstract idea without significantly more. For example, the claimed embodiments merely apply existing generic components to make door access more convenient for a user. Nothing about the claimed combinations, however, provides any technological improvement.

COUNT 4

(Declaratory Judgment of Unenforceability of the ’747 Patent)

41. The allegations of Paragraphs 11-35 of this Counterclaim are incorporated by reference as if fully set forth herein.

42. Inequitable conduct as to one patent, such as the ’205 patent, poisons the entire portfolio. Accordingly, the ’747 patent, which is a continuation of the ’205 patent, is also unenforceable.

COUNT 5

(Declaratory Judgment of Invalidity of the ’474 Patent)

43. The allegations of Paragraphs 1-5 of this Counterclaim are incorporated by reference as if fully set forth herein.

44. The asserted claims of the ’474 patent are invalid because they fail to meet the patentability requirements of Title 35 of the United States Code, including but not limited to, 35 U.S.C. §§ 101, 102, 103, and/or 112.

45. As a non-limiting example, the asserted claims of the ’474 patent are invalid as anticipated and/or obvious under 35 U.S.C. §§ 102 and 103 in view of at least: WO Publication No. WO2008/076074 A1 (“*Knutsson*”), U.S. Patent Publication No. 2009/0219133 A1

("*Woodard*"), U.S. Patent No. 8,730,004 B2 ("*Elfström*"), U.S. Patent No. 7,353,396 B2 ("*Micali*"), WO Publication No. WO2001/063425 A1 ("*Bröndrup*"), and Japanese Patent Publication No. 2002/083087 to Inoue et al. Accordingly, the claims are invalid.

46. As a non-limiting example, the asserted claims of the '474 patent are invalid as lacking written description and enablement for at least the elements of:

> "the application [on a portable terminal] activat[ing] the door lock . . . when the application determines that the reservation certificate is current" and
>
> "wherein the application compares the interval of the reservation to a current time accessible to the application to determine if the reservation certificate is current."

Accordingly, the claims are invalid.

47. As another non-limiting example, the asserted claims of the '474 patent are invalid as they are directed to an abstract idea without significantly more. For example, the claimed embodiments merely apply existing generic components to make door access more convenient for a user. Nothing about the claimed combinations, however, provides any technological improvement.

COUNT 6

(Declaratory Judgment of Unenforceability of the '474 Patent)

48. The allegations of Paragraphs 11-35 of this Counterclaim are incorporated by reference as if fully set forth herein.

49. On February 4, 2022, during prosecution of the '474 patent, Kelly Kasha filed an IDS that omitted the Bliding and Robertson References.

50. Despite having knowledge of the material Bliding and Robertson References, none of Kelly Kasha, John Kasha, Chris Outwater, and William Gibbens Redmann brought these references to the attention of the USPTO during the prosecution of the ’474 patent.

51. On February 4, 2022, during prosecution of the ’474 patent, Kelly Kasha filed an IDS that omitted the Bliding and Robertson References.

52. There is at least plausible reasoning that John Kasha and Kelly Kasha, who prosecuted the ’474 patent, as well as its alleged inventors, Chris Outwater and William Gibbens Redmann, intentionally and knowingly failed to disclose material information during the prosecution of the ’474 patent in violation of the duty of candor owed to the USPTO.

53. Through this intentional withholding of the material Bliding and Robertson References by John Kasha, Kelly Kasha, Chris Outwater, and William Gibbens Redmann, the ’474 patent is unenforceable.

54. Moreover, inequitable conduct as to one patent, such as the ’205 patent, poisons the entire portfolio. Accordingly, the ’474 patent, which is a continuation of the ’205 patent, is also unenforceable.

DEMAND FOR JURY TRIAL

Defendant, under Rule 38 of the Federal Rules of Civil Procedure, requests a trial by jury of any issues so triable by right.

PRAYER FOR RELIEF

WHEREFORE, AAGS, having completely and fully provided its Answer to Liberty’s counterclaims, pray for a final judgment against Liberty, respectfully requesting the following relief:

A. A judgment that the claims of the asserted patent are invalid;

B. Preliminary and permanent injunctive relief restraining Defendant and its agents, servants, employees, successors and assigns, and all others in concert and privity with them from wrongfully asserting any of the asserted patents against Plaintiff's products and services;

C. A judgment under 35 U.S.C. § 285 awarding AAGS its costs and reasonable attorneys' fees expended in defending and maintaining this action; and

D. A judgment awarding AAGS such other and further relief as the Court may deem just and proper.

Dated: May 8, 2023

Respectfully submitted,

/s/Lionel M. Lavenue

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CERTIFICATE OF SERVICE

I hereby certify that on May 8, 2023, I caused a true and correct copy of the foregoing to be filed electronically with the Clerk of Court using the CM/ECF system, which will send notification of such filing via electronic mail to all counsel of record.

/s/Lionel M. Lavenue
Lionel M. Lavenue