

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

NORTHSTAR SYSTEMS LLC,	)	
	)	Case No. 2:22-cv-00496-JRG
	)	(MEMBER CASE)
Plaintiff,	)	
	)	<u>JURY TRIAL DEMANDED</u>
v.	)	
	)	
BAYERISCHE MOTOREN WERKE AG,	)	
	)	
Defendant.	)	
	)	

**PLAINTIFF’S DISCLOSURE OF ASSERTED CLAIMS
AND INFRINGEMENT CONTENTIONS**

Plaintiff NorthStar Systems LLC (“NorthStar” or “Plaintiff”) hereby makes the following infringement disclosures under the Patent Local Rules with respect to United States Patent No. 6,898,432 (“the ’432 Patent”), U.S. Patent No. 8,014,943 (“the ’943 Patent”), U.S. Patent No. 8,032,297 (“the ’297 Patent”), U.S. Patent No. 8,478,527 (“the ’527 Patent”), U.S. Patent No. 8,805,416 (“the ’416 Patent”) (collectively, the “Asserted Patents”). NorthStar’s investigation is ongoing, and discovery is in its preliminary stages. Accordingly, these disclosures are based on information available to NorthStar at this time. NorthStar reserves the right to supplement this disclosure after further discovery from defendant and non-parties, particularly documents and other discovery regarding defendant’s accused devices. NorthStar also reserves the right to assert additional claims of the Asserted Patents, accuse different products, or find alternative literal and/or equivalent infringing elements in Defendant’s products.

**I. DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT CONTENTIONS
PURSUANT TO PATENT LOCAL RULE 3-1**

A. ASSERTED CLAIMS

1. Accused Products

Defendant Bayerische Motoren Werke AG (“BMW” or “Defendant”) has infringed and/or continues to infringe one or more of the following claims of the Asserted Patents in connection with the Accused Products set forth below:

- Claims 1-2, 4-5, and 7-8 of the ’432 Patent;
- Claims 1-18, 20-21, and 23-26 of the ’943 Patent;
- Claims 1-18, 20-21, 23-26, and 28-30 of the ’297 Patent;
- Claims 1, 3-14, 18-20, and 26-30 of the ’527 Patent; and
- Claims 1, 3-6, 9-13, and 17-19 of the ’416 Patent.

B. ACCUSED INSTRUMENTALITIES

1. Accused Products

NorthStar is currently aware that certain of Defendant’s products infringe one or more of the Asserted Patents. Upon information and belief, these Accused Products include BMW vehicles that include GPS and mapping technology infringes the Patents-in-Suit. For example, and without limitation, exemplar infringing BMW products, include at least the following: BMW models including, but not limited to, the BMW X1, BMW X 2, BMW X3, BMW X3 M, BMW X4, BMW X4 M, BMW X5, BMW X5 M, BMW X6, BMW X6 M, BMW X7, BMW iX, BMW XM, BMW 1 Series, BMW 2 Series, BMW 3 Series, BMW 4 Series, BMW 5 Series, BMW 6 series, BMW 7 Series, BMW 8 Series, BMW M2, BMW M3, BMW M4, BMW M5, BMW M8, BMW i4, BMW i7, BMW Z4, BMW iX1, BMW iX3, BMW iX, BMW 2 Series Active Tourer; Mini models,

including, but not limited to, the Mini Electric Hardtop, Mini Hardtop 2 Door, Mini Hardtop 4 Door, Mini Countryman, Mini Countryman, Mini Countryman PHEV, Mini Clubman, Mini Convertible, Mini John Cooper Works models; Rolls-Royce models, including, but not limited to, the Rolls-Royce Phantom VII, Rolls-Royce Ghost, Rolls-Royce Wraith, Rolls-Royce Dawn, Rolls-Royce Phantom VIII, Rolls-Royce Cullinan, Rolls-Royce Boat Tail, Rolls-Royce Spectre;; and other infringing technology BMW sold, imported, or used in the United States, and vehicles sold, imported or used in the United States by BMW customers.¹

2. Claim Charts

A Claim Chart identifying a location of every element of every asserted claim of the '432 Patent within the Accused Products is attached hereto as Appendix A. NorthStar believes that the Accused Products cited in the claim charts are representative of the Accused Products, including all generations and versions.

A Claim Chart identifying a location of every element of every asserted claim of the '943 Patents within the Accused Products is attached hereto as Appendix B. NorthStar believes that the Accused Products cited in the claim charts are representative of the Accused Products, including all generations and versions.

A Claim Chart identifying a location of every element of every asserted claim of the '297 Patents within the Accused Products is attached hereto as Appendix C. NorthStar believes that the Accused Products cited in the claim charts are representative of the Accused Products, including all generations and versions.

¹ NorthStar has provided additional information regarding certain aspects of the Accused Products in the attached Claim Charts Appendices A-E.

A Claim Chart identifying a location of every element of every asserted claim of the '527 Patents within the Accused Products is attached hereto as Appendix D. NorthStar believes that the Accused Products cited in the claim charts are representative of the Accused Products, including all generations and versions.

A Claim Chart identifying a location of every element of every asserted claim of the '416 Patents within the Accused Products is attached hereto as Appendix E. NorthStar believes that the Accused Products cited in the claim charts are representative of the Accused Products, including all generations and versions.

NorthStar reserves the right to amend these claim charts, as well as other information contained in this document and the Appendices attached hereto, to incorporate new information learned during the course of discovery including, but not limited to, information that is not publicly available or readily discernible without discovery. NorthStar further reserves the right to amend these claim charts, as well as other information contained in this document and the exhibits attached hereto, pursuant to Patent Local Rules 3-1 and 3-6, and the Court's Standing Proposed Discovery Order Section 3(a)(i).

C. LITERAL INFRINGEMENT AND DOCTRINE OF EQUIVALENTS

NorthStar asserts that, under the proper construction of the asserted claims and their claim terms, the limitations of the asserted claims of the NorthStar patents are literally present in the Accused Products, as set forth in the claim charts attached hereto as Appendices A-E. NorthStar contends that any and all elements found not to be literally infringed are infringed under the doctrine of equivalents because the differences between the claimed inventions and the accused instrumentalities, if any, are insubstantial.

NorthStar also contends that Defendant has directly infringed and/or continues to directly infringe the asserted claims by making, using, offering for sale, selling, and importing into the United States the accused instrumentalities. Moreover, Defendant has directly infringed and/or continues to directly infringe the asserted method claims by using (*i.e.*, Defendant's employees testing and/or serving the accused instrumentalities, including the BMW Navigation System) in the United States. Furthermore, Defendant has indirectly infringed and/or has continued to indirectly infringe by contributing to and/or inducing others (*e.g.*, Defendant's suppliers, Defendant's 'customers or its customers' customers) to directly infringe those claims by making, using, offering for sale, or selling the Accused Products. Such indirect infringement is further evidenced by Defendant's technical materials and marketing materials including, but not limited to, marketing materials, product briefs, product specifications, troubleshooting guides, technical support websites, reference manuals, and other business documents and communications conveyed to Defendant's customers.

NorthStar also contends that Defendant has contributorily infringed and/or continues to contributorily infringe with the knowledge that the Accused Products, or the use thereof, infringe the Asserted Patents. Defendants knowingly and intentionally contributed to the direct infringement of the Asserted Patents by others, by supplying the Accused Products and/or associated software, that embody a material part of the claimed invention of the Asserted Patents, that are known by the Defendant to be specially made or adapted for use in an infringing manner, and are not staple articles with substantial non-infringing uses.

Pursuant to Patent Local Rule 3-6(a)(1), NorthStar reserves the right to amend its Infringement Contentions as to literal infringement or infringement under the doctrine of equivalents in light of the Court's claim construction.

D. PRIORITY DATES

Each of the asserted claims of the '432 Patent claim no priority, and the U.S. Patent Application No. 09/718,007, which was issued as the '432 Patent, was filed on November 21, 2000.

Each of the asserted claims of the '943 Patent is entitled to the priority date of its earliest application, U.S. Patent Application No. 12/151,827 with a filing date of May 8, 2008.

Each of the asserted claims of the '297 Patent claim no priority, and the U.S. Patent Application No. 12/151,827, which was issued as the '297 Patent, was filed on May 8, 2008.

Each of the asserted claims of the '527 Patent is entitled to the priority date of its earliest application, U.S. Patent Application No. 12/151,827 with a filing date of May 8, 2008.

Each of the asserted claims of the '416 Patent is entitled to the priority date of its earliest application, U.S. Patent Application No. 09/690,001 with a filing date of October 16, 2000.

NorthStar reserves the right to establish an earlier date of invention based upon actions related to conception and reduction to practice of the claimed inventions.

E. NORHTSTAR'S OWN PRODUCTS

NorthStar is continuing to investigate what products and/or historical products may practice the claimed inventions, including those products of third parties (*e.g.*, previous assignees) of the Asserted Patents. At the present time NorthStar is not currently aware of any past products that practice its patents. NorthStar's investigation is ongoing, and NorthStar will supplement these contentions following its investigation (and claim construction as necessary).

II. PRODUCTION OF DOCUMENTS PURSUANT TO PATENT LOCAL RULE 3-2

NorthStar is producing or making available for inspection documents that are in NorthStar's possession, custody, or control as set forth in Patent Local Rule 3-2. A NorthStar 3-2 Production Index identifying these documents is attached hereto.

This preliminary identification of documents is for convenience and is not an admission that each document falls within any exemplary categories in the Patent Local Rules, or that any document qualifies as prior art. Thus, NorthStar reserves its right to add to, delete from, or otherwise modify its disclosures in this section as its investigation proceeds.

Production of these documents is governed by Patent Local Rule 2-2 and, with the exception of documents produced pursuant to P.R. 3.2(c) and public documents listed in the infringement charts, are considered "Confidential – Outside Attorneys Eyes Only" and disclosure of the confidential document or information, shall be limited to each party's outside attorney(s) of record and the employees of such outside attorney(s).

Dated: July 20, 2023

Respectfully submitted,

/s/ Vincent J. Rubino, III

Alfred R. Fabricant

NY Bar No. 2219392

Email: ffabricant@fabricantllp.com

Peter Lambrianakos

NY Bar No. 2894392

Email: plambrianakos@fabricantllp.com

Vincent J. Rubino, III

NY Bar No. 4557435

Email: vrubino@fabricantllp.com

FABRICANT LLP

411 Theodore Fremd Avenue, Suite 206 South

Rye, New York 10580

Telephone: (212) 257-5797

Facsimile: (212) 257-5796

John Andrew Rubino

NY Bar No. 5020797

Email: jarubino@rubinoip.com

Michael Mondelli III

NY Bar No. 5805114
Email: mmondelli@rubinoip.com
RUBINO IP
51 J.F.K. Parkway
Short Hills, New Jersey 07078
Telephone: (201) 341-9445
Facsimile (973) 535-0921

Justin Kurt Truelove
Texas Bar No. 24013653
Email: kurt@truelovelawfirm.com
TRUELOVE LAW FIRM, PLLC
100 West Houston Street
Marshall, Texas 75670
Telephone: (903) 938-8321
Facsimile: (903) 215-8510

***ATTORNEYS FOR PLAINTIFF
NORTHSTAR SYSTEMS LLC***

CERTIFICATE OF SERVICE

I hereby certify that on November 3, 2022, a true and correct copy of the above and foregoing document has been served by email on:

Lionel M. Lavenue
**FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP**
1875 explorer Street, Suite 800
Reston, VA 20190

Lionel.lavenue@finnegan.com
Attorneys for Bayerische Motoren Werke AG

/s/ Vincent J. Rubino, III

Vincent J. Rubino, III

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Bates Start	Bates End
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