

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

H2 INTELLECT LLC,

Plaintiff,

vs.

THE HOME DEPOT, INC.,
HOME DEPOT U.S.A., INC., AND
HOME DEPOT PRODUCT AUTHORITY, LLC,

Defendants.

Civil Action No. 2:25-cv-00123-JRG-
RSP

JURY TRIAL DEMANDED

**DEFENDANTS' OPPOSED MOTION TO CONSOLIDATE THIS CASE WITH CASE NO. 2:24-
CV-00694 (E.D. TEX.)**

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This is the second patent infringement case filed by plaintiff H2 Intellect LLC (“H2”) against Defendants The Home Depot, Inc., Home Depot U.S.A., Inc., and Home Depot Product Authority, LLC (collectively, “Home Depot”) in this Court within a six-month period. The asserted patents in both cases come from the *same* family, share the *same* specification, inventors and alleged inventive concepts, claim priority to the *same* application, and have similar claim scope. Both cases include the *same* accused products and involve substantially similar infringement and invalidity cases. As set forth below, all the relevant factors militate strongly in favor of consolidating this action through trial with pending Case No. 2:24-cv-00694 (“694 Action”) (collectively, the “Home Depot Actions”):

- Both patent infringement cases are pending in this Court, and both cases involve the exact same parties;
- Common questions of law and fact predominate between the Home Depot Actions, as (i) H2’s May 19, 2025 infringement contentions in both cases identify the same accused products and rely on the same Home Depot discovery to map to very similar claim elements, (ii) the alleged inventive concepts across all asserted patents are nearly identical, and (iii) there will be a substantial overlap in prior art and claim construction issues;
- The slight delay in resolving the 694 Action under the consolidated schedule proposed by Home Depot will in no way prejudice H2, considering (i) that H2 voluntarily split nearly identical claims and could have included all asserted patents in one earlier Complaint, and (ii) this action will be accelerated by several months; and
- Judicial economy will be preserved by one case track with consolidated discovery, one *Markman* claim construction hearing, one set of dispositive motions to adjudicate, and one trial.

Home Depot accordingly proposes consolidating this action and the 694 Action for all purposes on one track in the middle of the two current case schedules, with a proposed *Markman* claim

construction hearing date on or about January 20, 2026, and a proposed trial date on or about July 15, 2026.¹

I. STATEMENT OF ISSUES

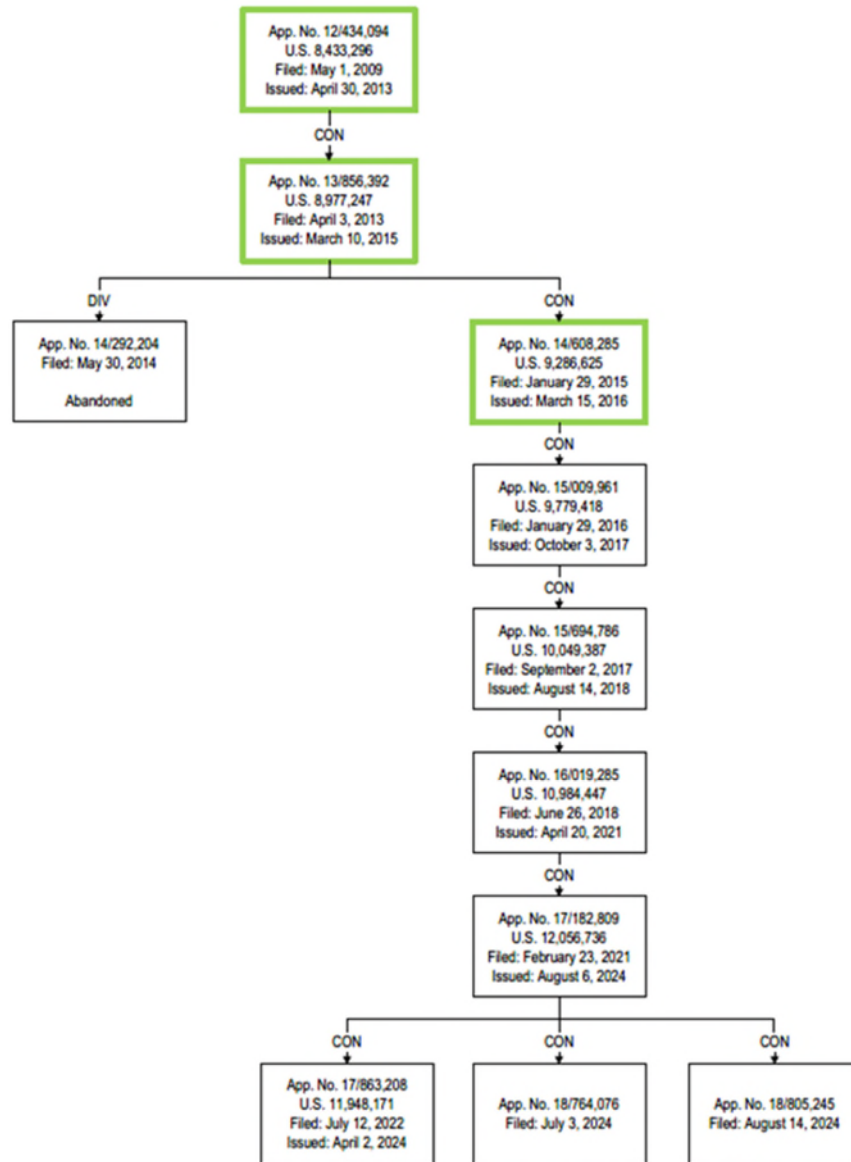
Per Local Rule CV-7(a)(1), Home Depot identifies the following issues to be decided by the Court:

- (1) Whether the Court should exercise its discretion to consolidate this Action with the 694 Action for all purposes under Fed. R. Civ. P. 42(a).

II. BACKGROUND

This Action accuses Home Depot of infringing U.S. Patent Nos. 8,977,247 (the “’247 Patent”) and 9,286,625 (the “’625 Patent”), which are continuations of the patent currently asserted in the 694 Action, U.S. Patent No. 8,433,296 (the “’296 Patent”). All of these patents are part of one family and share the same specification and claim back to the same priority date. Set forth below is an excerpted portion of the family tree for these applications and patents:

¹ A Proposed Docket Control Order is attached to the Declaration of Nicholas G. Papastavros, dated June 18, 2025 (“NGP Dec.”) as Ex. F. This action is currently consolidated for pre-trial purposes with *H2 Intellect LLC v. Amazon.com, Inc.* et al., C.A. No. 2:25-cv-00127-JRG and to further judicial economy Amazon has agreed to participate in claim construction proceedings on this track, while maintaining their post-*Markman*-hearing pretrial deadlines currently in place.



H2 filed the 694 Action on August 22, 2024, accusing Home Depot's hdPhones and the Store Mode and Curbside Pickup functionality from Home Depot's consumer mobile app of infringing the '296 Patent and U.S. Patent No. 11,948,171 (the "'171 Patent"). (694 Action, Dkt. No. 1.) Following discussions between the parties, the parties resolved their differences regarding the '171 Patent claims, and H2 thereafter filed a First Amended Complaint dropping that patent from the case on January 9, 2025. (694 Action, Dkt. No. 26.)

H2 proceeded to file the instant Action on February 3, 2025, also accusing Home Depot's hdPhones and the Store Mode and Curbside Pickup functionality of infringing the '247 Patent and the '625 Patent. (Dkt. No. 1.) There is no dispute that H2 could have included infringement claims for both of these patents in its earlier-filed Complaint, as the '247 Patent issued on March 10, 2015, and the '625 Patent issued on March 15, 2016. Many paragraphs in the complaints across the Home Depot Actions are substantively identical. (*Compare* Dkt. No. 1 ¶¶ 1–25, 28–46, *with* 694 Action, Dkt. No. 26 ¶¶ 1–25, 27–57.) *See also* NGP Dec. Ex. D. As a result, H2 identified the 694 Action as “related” to this action, per E.D. Tex. L. Civ. R. 42(a). (Dkt. No. 1-3 § VIII.)

Indeed, the two Complaints describe the purported inventive concepts which allegedly provide benefits over existing technology and constitute patentable subject matter under 35 U.S.C. § 101 in virtually identical terms. The asserted patents across both cases allegedly:

- Include the feature that the area for content delivery is customizable, which enables delivery of content in near real-time;
- Include the feature that the delivery of content is based on the mobile device entering an area for a predetermined/specified period of time, to avoid the problem of “alert spam”;
- Include the feature that a centralized management system can receive requests from multiple apps;
- Include the feature that the geographic areas can be exclusively reserved, including providing solutions for time-sharing and resolving competing priority claims in real-time; and
- Include the feature of resolving potentially competing claims to a reserved area.

(*Compare* Dkt. No. 1 ¶¶ 23–31, *with* 694 Action, Dkt. No. 26 ¶¶ 22–29.) Home Depot contends that each of these concepts are abstract and that the asserted elements lack an inventive contribution which transform them into patent-eligible claims, and the evidence presented on these points will be nearly identical across the two cases.

Following Home Depot's L.P.R. 3-4(a) disclosure of source code and technical documentation sufficient to show the operation of all accused instrumentalities in the 694 Action, on May 19, 2025, H2 served supplemental infringement contentions in the 694 Action and infringement contentions in this action. See NGP Dec. Exs. A and B. The Accused Products identified in these two sets of infringement contentions are identical: "the Home Depot consumer mobile application, HDPhone, HDPhone applications, and Store Systems applications, and any other Home Depot product that practices the Asserted Claims." Compare NGP Dec. Ex. A at 10, with Ex. B at 10, 149. The exemplary publicly available sources that allegedly support H2's contentions in both cases are identical. Compare NGP Dec. Ex. A at 11, with Ex. B at 11, 150. H2's mapping of the Accused Products to numerous claim elements is in many circumstances substantively identical across all three patents.² Compare, e.g., NGP Dec. Ex. A at 12–45 ('296:1[a]–1[b]), 56–66 ('296:1[c]), 67–72 ('296:1[d]), 89–101 ('296:1[h]–1[j]), 106–08 ('296:1[k]), 141–53 ('296:6[a]–6[c]), with Ex. B at 12–45 ('247:1[a]–1[b]), 53–58 ('247:1[d]), 69–79 ('247:1[e]), 80–94 ('247:1[f]–1[g]), 96–98 ('247:3[a]), 122–34 ('247:8[a]–8[b]), and *id.* at 151–70 ('625:1[a]), 189–91 ('625:1[e]), 204–14 ('625:2), 234–36 ('625:7), 268–80 ('625:19[a]–19[c]).

After filing this Action, in February 2025, H2 initially asked Home Depot to consolidate it into the earlier 694 Action, which Home Depot declined as prejudicial given the nearly six-month gap in filing dates and disparity in schedules. NGP Dec., ¶ 2. In further discussions at that time, H2 indicated that it had reevaluated consolidation and "after further reflection, H2 sees benefit in

²Home Depot contends with respect to both sets of contentions that H2 has failed to satisfy its burden of identifying "where each element of each asserted claim is found within each Accused Instrumentality" as required by P.L.R. 3-1(c), and Home Depot accordingly reserves all rights to seek to strike the contentions and/or compel contentions that comply with this patent local rule.

having two trials.” *Id.* ¶ 3 and Ex. C at 4. After receiving and reviewing H2’s May 19, 2025 infringement contentions in the 694 Action and this Action and confirming the substantial overlap in the charted claims and accused technology, *see* NGP Dec. Exs. A and B, Home Depot quickly reapproached H2 to propose consolidating these two cases in their entirety on a track that is roughly in the middle of the 694 Action schedule and this case’s schedule, “given the substantial overlap and efficiencies to be gained.” NGP Dec., ¶ 4 and Ex. C at 3. H2 again refused, stating that it no longer supported consolidation because “H2 believes that follow-up discovery in the second case, after discovery in the first case is closed, will likely be useful and necessary” and “H2 is also investigating potentially different damages models between the cases.” *Id.* ¶ 5 and Ex. C at 2. H2 later added that it was open to consolidation but only if the parties consolidated this action into the 694 Action (such that the trial date would be the current trial date of the 694 Action). *Id.* ¶ 6 and Ex. C at 1. Consolidating on the 694 Action track, however, is impractical if not impossible, as the parties have already started claim construction in the 694 Action (with terms for construction disclosed on June 5, 2025, and proposed constructions due on June 26, 2025), while the current deadline for Home Depot’s invalidity and subject matter eligibility contentions in this case remains nearly a month away (July 9, 2025).

On April 8, 2025, this Court consolidated this Action for pre-trial purposes only with *H2 Intellect LLC v. Amazon.com, Inc. et al.*, Case No. 2:25-cv-00127-JRG (the “Amazon Action”). Two of the three patents in this Action and the Amazon Action overlap, but the accused products, infringement claims and related discovery will differ substantially between the two cases. Home Depot counsel has conferred with Amazon counsel in light of the relief requested by this motion, and Amazon agrees to preserve judicial economy by participating in claim construction on the consolidated track proposed by Home Depot for the Home Depot Actions, including in the

Markman claim construction hearing proposed on or about January 20, 2026. *See* NGP Dec., ¶ 7. Amazon opposes any schedule modification that accelerates their post-*Markman*-hearing pretrial deadlines and their currently set trial date.

III. LEGAL STANDARD

The Court may consolidate two actions that “involve a common question of law or fact.” Fed. R. Civ. P. 42(a). Although consolidation is discretionary, “[c]ourts ‘are urged to make good use of Rule 42(a)’ to ‘expedite the trial and eliminate unnecessary repetition and confusion.’” *Hillman Grp., Inc. v. Keyme, LLC*, No. 2:19-cv-00209-JRG, 2020 WL 6938441, at *2 (E.D. Tex. Oct. 23, 2020) (*quoting* *Dupont v. S. Pac. Co.*, 366 F.2d 193, 195 (5th Cir. 1966)). Moreover, consolidation is “the proper solution to the problems created by the existence of two or more cases involving the same parties and issues, simultaneously pending in the same court.” *Lester v. Exxon Mobil Corp.*, 879 F.3d 582, 592 (5th Cir. 2018).

Courts consider the following five factors in determining whether consolidation is appropriate: “(1) whether the actions are pending in the same court; (2) whether there are common parties; (3) whether there are common questions of law or fact; (4) whether there is risk of prejudice or confusion versus a risk of inconsistent adjudications if the cases are tried separately; and (5) whether consolidation will promote judicial economy.” *Entropic Commc’ns, LLC v. Charter Commc’ns, Inc.*, No. 2:23-CV-00050-JRG, 2023 WL 5612452, at *1 (E.D. Tex. Aug. 29, 2023). All of these factors support consolidation of the Home Depot Actions in their entirety.

IV. THE COURT SHOULD CONSOLIDATE THIS ACTION WITH THE 694 ACTION.

The Home Depot Actions share the *same* parties, the *same* accused products, and a common specification across all three (3) asserted patents. They will also share common questions of law and fact, such as claim construction, the structure and operation of the accused products,

invalidity, and damages. The advantages of consolidation will therefore be two-fold: (1) consolidation will avoid the unnecessary waste required to relitigate these shared issues, and (2) it will also prevent H2 from splitting its claims and taking a second bite at discovery, damages, and trial, as it has suggested it would like to take if it is not satisfied with the outcome of the 694 Action.

A. Factor 1: The Actions Are Pending in the Same Court

Both Home Depot Actions are pending before this Court. (*Compare* Dkt. No. 1, with 694 Action, Dkt. No. 1.) Factor 1 therefore favors consolidation of the two cases.

B. Factor 2: The Actions Involve the Same Parties

Both Home Depot Actions involve the same parties. *Id.* Factor 2 therefore also favors consolidation.

While this case is currently consolidated with the Amazon Action for pretrial purposes, it will be most efficient for the two Home Depot Actions to be consolidated for all purposes including trial, with Amazon participating in the claim construction track and the *Markman* claim construction hearing in the Home Depot Actions. The Amazon Action involves different accused products, different infringement claims and will necessitate different discovery, and those products and claims can be separately adjudicated in the follow-on trial.

C. Factor 3: The Home Depot Actions Contain Numerous Overlapping Questions of Fact and Law

Courts regularly consolidate actions that involve related patents and the same accused products and infringement claims. *See Hillman*, 2020 WL 6938441, at *3 (consolidating two patent cases that involved different patents from the same family accusing the same products); *Entropic*, 2023 WL 5612452, at *2–3 (consolidating two patent cases involving different patents but the same accused products and services that would likely involve the same discovery and

witnesses); *SZ DJI Tech. Co. v. Autel Robotics USA LLC*, No. CV 16-706-LPS, 2018 WL 1316203, at *1 (D. Del. Mar. 14, 2018) (Stark, J.) (consolidating two patent cases where “the patents share common applicants, inventors, and priority periods and relate to various aspects of the same [invention] at issue, and the accused products are identical”); *BTL Indus. Inc. v. Rejuva Fresh LLC*, No. 1:23-CV-00032-SDN, 2024 WL 4905517, at *2–3 (D. Me. Nov. 27, 2024) (consolidating two patent cases with the same parties and different patents with overlapping claim terms)

1. *Non-infringement and invalidity issues overlap substantially between the two Home Depot Actions.*

Both Home Depot Actions accuse the same Store Mode and Curbside Pickup functionality of the Home Depot consumer mobile app, and hdPhone products used by Home Depot associates, of infringement. (*Compare* Dkt. No. 1 ¶¶ 33, 37, 47, *with* 694 Action, Dkt. No. 26 ¶¶ 31, 35.) The two Complaints rely on the same evidence of alleged infringement, including the same screenshots allegedly depicting the functionality of these products, and the same third-party sources such as interviews and articles allegedly providing circumstantial support for H2’s infringement allegations. (*Compare* Dkt. No. 1 ¶¶ 1–25, 28–46, *with* 694 Action, Dkt. No. 26 ¶¶ 1–25, 27–57.) *See also* NGP Dec. Ex. D. H2’s May 19, 2025 infringement contentions served in both Home Depot Actions are likewise near replicas; the accused products are identical, the exemplary publicly available sources that allegedly support H2’s contentions are identical, and H2’s mapping of the accused products to numerous claim elements is in many circumstances substantively identical across all three patents. *Compare, e.g.*, NGP Dec. Ex. A at 12–45 (’296:1[a]–1[b], 56–66 (’296:1[c]), 67–72 (’296:1[d]), 89–101 (’296:1[h]–1[j]), 106–08 (’296:1[k]), 141–53 (’296:6[a]–6[c]), *with* Ex. B at 12–45 (’247:1[a]–1[b], 53–58 (’247:1[d]), 69–79 (’247:1[e]), 80–94 (’247:1[f]–1[g]), 96–98 (’247:3[a]), 122–34 (’247:8[a]–8[b]), *and id.* at 151–70 (’625:1[a]), 189–91 (’625:1[e]), 204–14 (’625:2), 234–36 (’625:7), 268–80 (625:19[a]–19[c]). In fact, Home Depot

cannot identify any evidence cited in the charts served in this action that was not already cited in the charts served in the 694 Action. The substantial overlap in infringement claims between the Home Depot Actions strongly supports consolidation.

While Home Depot is still in the process of identifying potential prior art in this Action for the '247 and '625 Patents (invalidity contentions are due next month), it fully expects significant overlap with the invalidity contentions aimed at the '296 Patent, served in the 694 Action. As a threshold matter, the cited prior art references across the face of three asserted patents overlap almost entirely; the '247 and '625 Patents contain only a *single* unique patent reference ("Khivesara") apart from the 44 references cited in the '296 Patent. Moreover, at least five prior art references which Home Depot contends fully anticipate one or more of the claims in the 694 Action pursuant to 35 U.S.C. § 102 (and in combination also render claims obvious pursuant to 35 U.S.C. § 103) will also be cited as prior art against the asserted patents in this case: US 2002/0161633 (Jacob '633), US 2008/0032666 (Hughes '666), US 4,882,724 (Vela '724), US 2009/0163227 (Collins '227), and US 2009/0061890 (Andreasson '890). *See* NGP Dec. Ex. E at 17–20, 26–27.

Finally, as noted above H2 described the inventive concepts which allegedly constitute patentable subject matter under 35 U.S.C. § 101 in virtually identical terms across the two Home Depot Actions, and Home Depot anticipates asserting nearly identical § 101 validity challenges in the two cases. *See id.* at 31–44. Indeed, in an earlier-filed case the inventors Ryan Hardin and Andrew Hill previously described the '296 Patent (from the 694 Action) and '247 Patent (from this case) as comprising a single invention:

Plaintiffs invented a technological *solution* that solves these technical problems by implementing a centralized service for tracking and monitoring the location of the mobile device on behalf of apps on the mobile device. . . . The claimed *inventions* provide a *mechanism* whereby an app can register with the centralized service and

request to be notified about events relating to a particular geographic area of interest, . . . the claimed *inventions improve* the overall functioning of the mobile device itself by increasing processing efficiency and reducing battery drain, as well as the functioning of the individual apps.

See Hardin v. Samsung Elecs. Co., No. 2:22-cv-344 (E.D. Tex. 2022), Dkt. No. 1 ¶¶ 18–19, 24–25.

It will indisputably be more efficient to adjudicate the common legal issues of infringement and validity across the three asserted patents in one forum with consolidated discovery, dispositive motions, and trial.

2. *The Home Depot Actions will share common witnesses and damages issues.*

Because the accused products are identical across the Home Depot Actions, most of the discovery will be sought from the same fact witnesses in both cases, including the engineers, marketing, and finance employees knowledgeable about these features and products. Moreover, all three patents have the same inventors, Ryan Hardin and Andrew Hill, who will also doubtlessly be witnesses in the case. *See Hillman*, 2020 WL 6938441, at *2 (consolidating cases because they have “overlapping witnesses”).³

The evidence relevant to H2’s request for relief will also substantially overlap between the two Home Depot Actions. While H2 is a non-practicing entity which will be hard-pressed to prove any sort of harm that cannot be remedied by money damages, it has sought injunctive relief in both actions. (*Compare* Dkt. No. 1, Prayer for Relief (seeking damages and permanent injunction) *with* 694 Action, Dkt. No. 26, Prayer for Relief (same)). The evidence required for H2 to demonstrate irreparable harm such as lost sales, price erosion, and H2’s own licensing practices for the covered

³ Indeed, the parties have been negotiating the use of deposition testimony in both Home Depot Actions in the event the cases are not fully consolidated.

technology (*see, e.g., Nichia Corp. v. Everlight Ams., Inc.*, 855 F.3d 1328, 1341–42 (Fed. Cir. 2017)), will be the same for both cases.

3. *Claim construction issues will overlap between the two Actions.*

Claim terms in related patents should be construed to have the same meaning. *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1334 (Fed. Cir. 2003). Because all three asserted patents across both cases share an identical specification and similar prosecution history, the intrinsic evidence for claim construction will be substantially the same across all three asserted patents, thereby supporting consolidation. *See, e.g., Hillman*, 2020 WL 6938441, at *2 (consolidating cases because they have “overlapping ... claim-construction issues”); *BTL Indus.*, 2024 WL 4905517, at *2–3 (consolidating two patent cases “[b]ecause both actions require the court to construe” two overlapping claim terms).

Though claim construction has only just begun in the 694 Action, Home Depot has proposed the following terms for construction which appear across all asserted patents:

Term	'296 Patent Claims	'247 Patent Claims	'625 Patent Claims
“reserving” / “reservation”	1, 6, 10, 11, 15	1, 3, 8, 10, 15, 17	1, 19, 20
“a request to obtain an interest”	1, 6, 11	15	1, 19, 20
“registering” / “register”	1, 6, 11	1, 8, 15	1, 19, 20
“provide/providing ... a response to the request”	1, 6, 11	5, 7, 12, 14, 19	n/a

In such circumstances, it makes sense to preserve judicial economy and conduct one set of claim construction proceedings in a consolidated action, and the efficiencies here are enhanced because Amazon has agreed to participate in those proceedings as well.

D. Factor 4: The Benefits of Consolidation Outweigh Any Prejudice

The fourth factor weighs in favor of consolidation because the risk of inconsistent adjudication in cases with overlapping claims, issues, and defenses greatly outweighs any perceived prejudice experienced by H2, such as inconvenience or delay.

Hillman Group, Inc. v. KeyMe, LLC is squarely on point with the case at bar. In *Hillman*, the two infringement cases (involving the same products and patents with the same inventors, the same specification, and similar claim scope) were set for trial in December 2020 and June 2021, respectively, and Defendant proposed a single consolidated case with an April 2021 trial date. 6938441, at *2. Plaintiff argued in response that the presence of other patents “separates the paths” of the two cases and that it would be prejudiced by a further delay of the earlier-filed case. *Id.* This Court disagreed, stating that “consolidating the -70 case with the -209 case will conserve party and judicial resources by simplifying the issues before the Court and avoiding repetitious litigation. Although consolidation will delay resolution of the claims in the -209 case, this is offset by expediting resolution of the claims in the -70 case.” *Id.* at *3; accord *Entropic*, 2023 WL 5612452, at *3 (“Consolidation may delay resolution of claims in one case, but this is offset by expediting resolution of claims in the other case.”) Home Depot’s proposed consolidated schedule parallels those adopted by this Court in *Hillman* and *Entropic*.

Any claims of prejudice on the part of H2 to this single consolidated schedule ring hollow given that the ’247 and ’625 patents issued years ago — and H2 could easily have included them in the 694 Action — but instead H2 split its infringement claims into two cases on a track six months apart, apparently to get a second chance at discovery and double-dip on damages. NGP Dec., ¶ 5 and Ex. C at 2.⁴ This Court should not countenance these tactics. To that end, H2’s

⁴ See *Arendi S.A.R.L. v. LG Elecs. Inc.*, 47 F.4th 1380, 1384–86 & n.1 (Fed. Cir. 2022) (holding that “[t]he duplicative-litigation doctrine prevents plaintiffs from ‘maintain[ing] two separate

strategy mimics that of Plaintiff in *Entropic*, who anticipated that separate cases “will let it get double of everything at each pretrial stage (and potentially at trial).” *Entropic*, 2023 WL 5612452, at *3; accord *Oliney v. Gardner*, 771 F.2d 856, 859 (5th Cir. 1985) (“[T]he plaintiff [may] not use the incorrect procedure of filing duplicative complaints to expand the procedural rights he would otherwise enjoy.”) Considering that H2 is content with two separate cases running on two different tracks and risking inconsistent adjudications, it will certainly not be prejudiced by one consolidated case that resolves all issues on a track faster than that of the case at bar.

E. Factor 5: Consolidation Will Avoid Unnecessary Costs and Conserve Judicial Resources

Maintaining separate pre-trial and trial schedules for the two Home Depot Actions will only result in repetitious litigation. Consolidation will eliminate duplicative briefing on claim construction and the potential for multiple *Markman* claim construction hearings; duplicative depositions of witnesses testifying on behalf of both parties; duplicative discovery on the same accused products and on the same or similar prior art references and systems; duplicative expert reports and expert discovery; duplicative dispositive motions; and multiple trials, with separate jury empanelments. The resources of the Court and parties will clearly be preserved by consolidating the Home Depot Actions for all purposes. *Hillman*, 2020 WL 6938441, at *2–3 (consolidation will conserve party and judicial resources by simplifying the issues before the Court and avoiding repetitious litigation).

actions involving the same subject matter at the same time in the same court . . . against the same defendant” and noting that the doctrine “does not require a final judgment to bar a later complaint, but it does involve a similar inquiry [to claim preclusion] in that it also looks to whether the later complaint is, essentially, repetitious”); *Netlist, Inc. v. Samsung Elecs. Co.*, No. 2:22-CV-00293-JRG, 2023 WL 5532133, at *2 (E.D. Tex. Aug. 28, 2023) (“Claim splitting can extend a preclusive effect to cases ‘dealing with simultaneous actions on related theories,’ and in such cases, no final judgment is required.” (emphasis omitted)).

V. CONCLUSION

For the foregoing reasons, Home Depot respectfully requests that the Court consolidate this Action with the 694 Action on the proposed case schedule submitted herewith.

Dated: June 18, 2025

Respectfully submitted,

By: /s/ Nicholas G. Papastavros
Nicholas G. Papastavros
DLA PIPER LLP (US)
33 Arch Street, 26th Floor
Boston, MA 02110-1447
Telephone: 617.406.6000
Facsimile: 617.406.6119
nick.papastavros@dlapiper.com

Eric H. Findlay
Texas Bar No. 00789886
FINDLAY CRAFT, P.C.
7270 Crosswater Avenue, Suite B
Telephone: 903.534.1100
efindlay@findlaycraft.com

*Attorneys for Defendants The Home
Depot, Inc., Home Depot U.S.A., Inc.,
and Home Depot Product Authority, LLC*

CERTIFICATE OF SERVICE

I hereby certify that on June 18, 2025, I electronically filed the foregoing with the Clerk of Court using the CM/ECF system. All counsel of record has been served by electronic mail.

/s/ Nicholas G. Papastavros
Nicholas G. Papastavros

CERTIFICATE OF CONFERENCE

The undersigned certifies that counsel for Home Depot has complied with the meet and confer requirement in Local Rule CV-7(h), including through a personal teleconference between counsel for Plaintiff, Rex Mann, and counsel for Defendants, Nick Papastavros, on June 6, 2025, and numerous written communications (including on May 21 and 30, and June 3, 6, 9, 10, and 12 2025). Counsel for Plaintiff stated at different times that it (a) opposed consolidation or (b) would be willing to consolidate, but only on the 694 Action schedule; and that it opposes the relief sought by Defendants' Motion to Consolidate This Case with Case No. 2:24-cv-00694. The Amazon Defendants do not oppose consolidation on the current schedule in the consolidated -123/-127 case, and do not oppose a consolidated *Markman* hearing date on January 20, 2026 or later. The Amazon Defendants oppose any schedule modification that accelerates their post-*Markman*-hearing pretrial deadlines and their currently set trial date.

/s/ Nicholas G. Papastavros
Nicholas G. Papastavros

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

H2 INTELLECT LLC,

Plaintiff,

vs.

THE HOME DEPOT, INC.,
HOME DEPOT U.S.A., INC., AND
HOME DEPOT PRODUCT AUTHORITY, LLC,

Defendants.

Civil Action No. 2:25-cv-00123

JURY TRIAL DEMANDED

**DECLARATION OF NICHOLAS G. PAPASTAVROS IN SUPPORT OF DEFENDANTS’
MOTION TO CONSOLIDATE THIS CASE WITH CASE NO. 2:24-cv-00694**

I, Nicholas G. Papastavros, declare as follows:

1. I am a partner at DLA Piper (US) LLP. I am a member of the bars of the Commonwealth of Massachusetts, the State of New York and the District of Columbia, and a member of this Court. I have personal knowledge of the facts set forth in this declaration, and if called as a witness, I would testify competently to those facts.
2. In February, 2025, I conferred with counsel for H2 Intellect LLC (“H2”). H2 proposed consolidating Case No. 2:25-cv-00123 (“this Action”) with the ongoing Case No. 2:24-cv-00694 (the “694 Action”) on the schedule established for the 694 Action. I expressed my objection to consolidating under that condition.
3. On February 12, 2025, counsel for H2 indicated in a follow-up email on this issue that H2 “would be willing to discuss consolidation” but saw “benefit in having two trials, so it is not as inclined to concede so much in order to consolidate.”

4. On May 21, 2025, I emailed counsel for H2 to propose consolidating this Action with the 694 Action on a track roughly in the middle of the two actions, “given the substantial overlap and efficiencies to be gained.”

5. Counsel for H2 responded later that day refusing to consolidate on any schedule because “H2 believes that follow-up discovery in the second case, after discovery in the first case is closed, will likely be useful and necessary” and “H2 is also investigating potentially different damages models between the cases.”

6. On May 30, 2025, I followed up with counsel for H2 via email on the issue of consolidation. On June 3, 2025, counsel for H2 responded that H2 would consider consolidating this Action into the 694 Action “such that the trial date would be the current trial date of the [694 Action].” I then met and conferred with counsel for H2, Rex Mann, on this issue by teleconference on June 6, 2025.

7. On June 9, 2025, counsel for Home Depot conferred with counsel for Amazon.com, Inc. (“Amazon”). Counsel for Amazon indicated that Amazon agreed to participate in claim construction on the consolidated track proposed by Home Depot, including in the *Markman* claim construction hearing proposed on or about January 20, 2026. However, Amazon objects to accelerating its post-*Markman*-hearing pretrial deadlines and its currently set trial date.

8. Attached hereto as **Sealed-Exhibit A** is a true and correct copy of H2’s First Supplemental Infringement Contentions to Defendants The Home Depot, Inc., Home Depot U.S.A, Inc., and Home Depot Product Authority, LLC Pursuant to Local Patent Rules 3-1 and 3-2 served on May 19, 2025 in the 694 Action. The contentions purport to map the Accused

Products against the elements of U.S. Patent No. 8,433,296 (the “’296 Patent”). The citations in the Motion adhere to the bates numbering found on the bottom right corner of the document.

9. Attached hereto as **Sealed-Exhibit B** is a true and correct copy of H2’s Infringement Contentions to Defendants The Home Depot, Inc., Home Depot U.S.A, Inc., and Home Depot Product Authority, LLC Pursuant to Local Patent Rules 3-1 and 3-2 served on May 19, 2025 in this Action. The contentions purport to map the Accused Products against the elements of U.S. Patent Nos. 8,977,247 (the “’247 Patent”) and 9,286,625 (the “’625 Patent”). The citations in the Motion adhere to the bates numbering found on the bottom right corner of the document.

10. Attached hereto as **Exhibit C** is a true and correct copy of a series of emails between counsel for Home Depot and counsel for H2 on February 12, May 21, May 30, and June 3, 2025.

11. Attached hereto as **Exhibit D** is a true and correct copy of a comparison between the operative complaints in this Action (Dkt. No. 1) and the 694 Action (Dkt. No. 26). Michael Gniwisch, an associate at DLA Piper (US), LLP ran the comparison using the Kofax Power PDF program.

12. Attached hereto as **Exhibit E** is a true and correct copy of Home Depot’s Invalidity Contentions, Subject Matter Eligibility Contentions, and Accompanying Document Production served on January 10, 2025 in the 694 Action.

13. Attached hereto as **Exhibit F** is an Exemplar Proposed Docket Scheduling Order.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on this day, June 18, 2025.

By: /s/ Nicholas G. Papastavros
Nicholas G. Papastavros

EXHIBIT A

FILED UNDER SEAL

EXHIBIT B

FILED UNDER SEAL

EXHIBIT C

From: Mann, Rex <RMann@winston.com>
Sent: Tuesday, June 3, 2025 2:05 PM
To: Papastavros, Nick; Boyce, Tyler
Cc: Winston-H2; DLA-HD-H2; efindlay@findlaycraft.com
Subject: RE: H2 Intellect v. Home Depot (-123 case) Infringement Contentions

Follow Up Flag: Follow up
Flag Status: Flagged

 EXTERNAL MESSAGE

Hi Nick,

H2 is open to consolidation if we consolidate the second case into the first case (such that the trial date would be the current trial date of the first case). Is that something Home Depot would agree to? As to your comment about depositions, H2 agrees as a general rule that 30(b)(1) witnesses should not be produced more than once, although there can be exceptions, for example, the deposition of Steven Sorensen where Home Depot did not produce his emails prior to the deposition.

If we aren't in agreement, I believe we have to meet and confer before Home Depot files its motion, so let me know when you propose doing that.

Regards,

Rex

Rex Mann

Partner

Winston & Strawn LLP

D: +1 214-453-6412

M: +1 979-571-7416

winston.com

**WINSTON
& STRAWN**
LLP

From: Papastavros, Nick <Nick.Papastavros@us.dlapiper.com>
Sent: Friday, May 30, 2025 8:23 PM
To: Mann, Rex <RMann@winston.com>; Boyce, Tyler <tboyce@winston.com>
Cc: Winston-H2 <Winston-H2@winston.com>; DLA-HD-H2 <DLA-HD-H2@us.dlapiper.com>; efindlay@findlaycraft.com
Subject: RE: H2 Intellect v. Home Depot (-123 case) Infringement Contentions

Rex,

To close the loop on this and as mentioned in my May 21 email, Home Depot will be moving to consolidate the 2 cases on a track that is roughly in the middle of the schedule in case 1 and the anticipated schedule in case 2. I trust given the below exchange that H2 opposes, but if there is anything further to discuss with respect to this

H2 Intellect - Exhibit 2006

proposal please let me know by midday next Tuesday. As I have mentioned on a couple occasions now including in my February 27 and May 12 emails, as a general proposition we do not intend on producing witnesses more than once, so your team should be asking the questions it has which might apply to both cases in the depositions being taken.

Nick

From: Mann, Rex <RMann@winston.com>

Sent: Wednesday, May 21, 2025 8:56 PM

To: Papastavros, Nick <Nick.Papastavros@us.dlapiper.com>; Boyce, Tyler <tboyce@winston.com>

Cc: Winston-H2 <Winston-H2@winston.com>; DLA-HD-H2 <DLA-HD-H2@us.dlapiper.com>; efindlay@findlaycraft.com

Subject: RE: H2 Intellect v. Home Depot (-123 case) Infringement Contentions

 EXTERNAL MESSAGE

Nick,

H2 is not inclined to agree to your proposed schedule consolidation. H2 does not believe Home Depot is taking this case very seriously, and in light of Home Depot's recent positions and litigation tactics, the first case should proceed on schedule so this matter may be resolved as soon as possible. Moreover, although H2 previously proposed a consolidation several months ago and might have considered something at that time, given the passage of time and positions Home Depot has taken, H2 does not any longer believe it makes sense to consolidate. In addition, given the delays in discovery by Home Depot and the apparent misrepresentations Home Depot has made so far—which we will be raising with you separately soon—H2 believes that follow-up discovery in the second case, after discovery in the first case is closed, will likely be useful and necessary. There are also differences in the patents between the two cases, and H2 is also investigating potentially different damages models between the cases—so H2 believes that consolidation would lead to some significant inefficiencies.

H2 also questions whether Home Depot's request is truly motivated by efficiency, rather than strategic considerations in light of the parallel proceedings Home Depot has initiated. If efficiency was of primary importance to Home Depot, we think it would have worked against this goal to file the recent PGR on a patent H2 has said it does not intend to assert and that it does not believe Home Depot is infringing due to the time elements in the independent claims. Moreover, given the PTAB's recent interest in efficient use of its resources, H2 does not believe the PTAB is going to look favorably on Home Depot's tactics. To be clear, H2 plans to point out to the PTAB (with declaration support) that Home Depot is filing the PGR on a patent that H2 has told Home Depot it does not believe Home Depot is infringing. We also plan to state in the declaration that Home Depot has told H2 that it intends to file a PGR on every patent H2 gets in the future, which suggests Home Depot is not making these decisions based on the merits and is instead doing it for an ulterior motive that H2 believes the PTAB will not appreciate. H2 also believes that the PTAB will likely give this evidence considerable weight in its assessment of Home Depot's credibility in general at the PTAB.

Rex

Rex Mann

Partner

Winston & Strawn LLP

D: +1 214-453-6412

M: +1 979-571-7416

winston.com



From: Papastavros, Nick <Nick.Papastavros@us.dlapiper.com>
Sent: Wednesday, May 21, 2025 8:47 AM
To: Mann, Rex <RMann@winston.com>; Boyce, Tyler <tboyce@winston.com>
Cc: Winston-H2 <Winston-H2@winston.com>; DLA-HD-H2 <DLA-HD-H2@us.dlapiper.com>; efindlay@findlaycraft.com
Subject: RE: H2 Intellect v. Home Depot (-123 case) Infringement Contentions

Rex,

Given the substantial overlap and efficiencies to be gained, we are interested in consolidating the two currently pending cases against Home Depot in their entirety on a track that is roughly in the middle of what the case 1 track is and what the anticipated case 2 track will be. Please let me know if H2 is open to this conceptually, and if so we can circulate a draft of a proposal.

Thanks
Nick

From: Mann, Rex <RMann@winston.com>
Sent: Wednesday, February 12, 2025 2:42 PM
To: Nall, Jennifer; Boyce, Tyler; Ladd, Jacob; Walker, Chad; Melsheimer, Tom; mbjohnson@winston.com
Cc: efindlay@findlaycraft.com; DLA-HD-H2
Subject: RE: H2 v. Home Depot - extension of time

 EXTERNAL MESSAGE

Hi Jennifer,

I have checked with H2. H2 is pushing back on this. As H2 did with the first case, it is always willing to allow reasonable extensions. But unlike the first case, in this case, Home Depot hasn't had to search for counsel, learn about the accused products, or investigate the technology at issue. As such, it doesn't seem to need the extension here. Moreover, given Home Depot doesn't seem to be interested in discussing alternative dispute resolution, H2 would prefer to just get to trial as soon as possible on this case. That said, if you can get me a little more detail as to why Home Depot needs the extension under the circumstances here, or request a shorter extension, I'll see if I can get H2 to not oppose.

On a related note, I had reached out to counsel for Home Depot about consolidating the patents in this second case to the first case—and I mentioned how H2 would be willing to push back some of the near-term deadlines and make some other concessions to do so. If we did that, then no extension would be needed here of course. H2 would still be happy to discuss scheduling issues, and if there is some efficiency to be gained in consolidating—without creating unnecessary delay—H2 would be willing to discuss. That said, after further reflection, H2 sees benefit in having two trials, so it is not as inclined to concede so much in order to consolidate. Unless Home Depot wants to discuss any further, therefore, H2 will intend to proceed as is with two schedules and two trials and not file a motion to consolidate at this time.

Regards,

Rex

Rex Mann

Partner

Winston & Strawn LLP

D: +1 214-453-6412

M: +1 979-571-7416

winston.com



From: Mann, Rex
Sent: Wednesday, February 12, 2025 11:03 AM
To: Nall, Jennifer <Jennifer.Nall@us.dlapiper.com>; Boyce, Tyler <tboyce@winston.com>; Ladd, Jacob <JLadd@winston.com>; Walker, Chad <CBWalker@winston.com>; Melsheimer, Tom <TMelsheimer@winston.com>; Johnson, Brett <MBJohnson@winston.com>

Cc: efindlay@findlaycraft.com; DLA-HD-H2 <DLA-HD-H2@us.dlapiper.com>

Subject: RE: H2 v. Home Depot - extension of time

Hi Jennifer,

Let me check with H2.

Rex

Rex Mann

Partner

Winston & Strawn LLP

D: +1 214-453-6412

M: +1 979-571-7416

winston.com



From: Nall, Jennifer <Jennifer.Nall@us.dlapiper.com>

Sent: Wednesday, February 12, 2025 8:45 AM

To: Mann, Rex <RMann@winston.com>; Boyce, Tyler <tboyce@winston.com>; Ladd, Jacob <JLadd@winston.com>; Walker, Chad <CBWalker@winston.com>; Melsheimer, Tom <TMelsheimer@winston.com>; Johnson, Brett <MBJohnson@winston.com>

Cc: efindlay@findlaycraft.com; DLA-HD-H2 <DLA-HD-H2@us.dlapiper.com>

Subject: H2 v. Home Depot - extension of time

Rex,

Will H2 oppose a 30-day extension of time for Home Depot to respond to the complaint in 2:25-cv-123?

Thanks,

Jen

Jennifer Librach Nall

Partner

T +1 512 457 7249
F +1 512 721 2249
jennifer.nall@us.dlapiper.com

DLA Piper LLP (US)
303 Colorado Street
Suite 3000
Austin, TX 78701-4653



dlapiper.com

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EXHIBIT D

Text Comparison

Initial Document:
26 Am Compl.pdf

Changed Document:
1 Compl.pdf

Summary

Differences exist between the documents.

2138 word(s) added
676 word(s) deleted
3992 word(s) matched

6 page(s) added
4 page(s) deleted
20 page(s) replaced

<u>Insert</u>	Word(s) inserted
~~Delete~~	Word(s) deleted
Move	Word(s) moved
Different	Word(s) different only in style

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

H2 INTELLECT LLC,

Plaintiff,

vs.

**THE HOME DEPOT, INC.,
HOME DEPOT U.S.A., INC., AND
HOME DEPOT PRODUCT AUTHORITY, LLC,**

Defendants.

Civil Action No. 2:24-cv-00694-JRG-
~~RSP~~

JURY TRIAL DEMANDED

~~FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT~~

Plaintiff H2 Intellect LLC files this Complaint for Patent Infringement against Defendants The Home Depot, Inc. (“Home Depot”), Home Depot U.S.A., Inc. (“HDUSA”), and Home Depot Product Authority, LLC (“HDP A”), and allege as follows:

NATURE OF THE ACTION

1. This is a civil action for patent infringement arising under the Patent Laws of the United States, 35 U.S.C. §§ 1, et seq., including §§ 271, 281, 284, and 285.

THE PARTIES

2. Plaintiff H2 Intellect LLC is a Texas limited liability corporation having an address located at 3630 Durness Way, Houston, TX 77025.

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

H2 INTELLECT LLC,

Plaintiff,

vs.

**THE HOME DEPOT, INC.,
HOME DEPOT U.S.A., INC., AND
HOME DEPOT PRODUCT AUTHORITY, LLC,**

Defendants.

Civil Action No. 2:25-cv-00123

JURY TRIAL DEMANDED

COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff H2 Intellect LLC files this Complaint for Patent Infringement against Defendants The Home Depot, Inc. (“Home Depot”), Home Depot U.S.A., Inc. (“HDUSA”), and Home Depot Product Authority, LLC (“HDP A”), and allege as follows:

NATURE OF THE ACTION

1. This is a civil action for patent infringement arising under the Patent Laws of the United States, 35 U.S.C. §§ 1, et seq., including §§ 271, 281, 284, and 285.

THE PARTIES

2. Plaintiff H2 Intellect LLC is a Texas limited liability corporation having an address located at 3630 Durness Way, Houston, TX 77025.

3. Upon information and belief, The Home Depot, Inc. (“Home Depot”) is a corporation organized under the laws of the State of Delaware with a place of business in Atlanta, GA 30339.

3. Upon information and belief, The Home Depot, Inc. (“Home Depot”) is a corporation organized under the laws of the State of Delaware with a place of business in Atlanta, GA 30339.

4. Upon information and belief, Home Depot U.S.A., Inc. (“HDUSA”) is a subsidiary of Home Depot and is a corporation organized under the laws of the State of Delaware with a place of business in Atlanta, GA 30339.

5. Upon information and belief, Home Depot Product Authority (“HDPHA”) is a subsidiary of Home Depot and is a corporation organized under the laws of the State of Georgia with a place of business in Atlanta, GA 30339.

6. Upon information and belief, Home Depot’s, HDUSA’s, and HDPHA’s registered agent for service of process in Texas is Corporation Service Co. d/b/a CSC-Lawyers Inc., 211 E. 7th Street Suite 620, Austin, TX 78701. Upon information and belief, Defendants Home Depot, HDUSA, and HDPHA sell, offer to sell, and/or use products and services throughout the United States, including in this judicial district, and introduce infringing products and services into the stream of commerce knowing that they would be sold and/or used in this judicial district and elsewhere in the United States.

JURISDICTION AND VENUE

7. This is an action arising under the patent laws of the United States, 35 U.S.C. § 271.

8. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).

9. Venue is proper in this judicial district under 28 U.S.C. §§ 1391 and 1400(b) because Defendant has committed acts of infringement and has a regular and established place of business in this District. Upon information and belief, Defendants have a regular and established

4. Upon information and belief, Home Depot U.S.A., Inc. ("HDUSA") is a subsidiary of Home Depot and is a corporation organized under the laws of the State of Delaware with a place of business in Atlanta, GA 30339.

5. Upon information and belief, Home Depot Product Authority ("HDP") is a subsidiary of Home Depot and is a corporation organized under the laws of the State of Georgia with a place of business in Atlanta, GA 30339.

6. Upon information and belief, Home Depot's, HDUSA's, and HDP's registered agent for service of process in Texas is Corporation Service Co. d/b/a CSC-Lawyers Inc., 211 E. 7th Street Suite 620, Austin, TX 78701. Upon information and belief, Defendants Home Depot, HDUSA, and HDP sell, offer to sell, and/or use products and services throughout the United States, including in this judicial district, and introduce infringing products and services into the stream of commerce knowing that they would be sold and/or used in this judicial district and elsewhere in the United States.

JURISDICTION AND VENUE

7. This is an action arising under the patent laws of the United States, 35 U.S.C. § 271.

8. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).

9. Venue is proper in this judicial district under 28 U.S.C. §§ 1391 and 1400(b) because Defendant has committed acts of infringement and has a regular and established place of business in this District. Upon information and belief, Defendants have a regular and established place of business in Texas and in this District, including at 411 TX-281 E Loop, Longview, TX 75605, 601 Northcreek Dr., Sherman, TX 75092, 3901 Old Jacksonville Hwy, Tyler, TX 75701, 4211 S Medford Dr, Lufkin, TX 75901, and other locations. Home Depot has thousands of

place of business in Texas and in this District, including at 411 TX-281 E Loop, Longview, TX 75605, 601 Northcreek Dr., Sherman, TX 75092, 3901 Old Jacksonville Hwy, Tyler, TX 75701, 4211 S Medford Dr, Lufkin, TX 75901, and other locations. Home Depot has thousands of employees working throughout the state of Texas, including within the Eastern District of Texas. Given the location of the plaintiff and its primary stakeholders in Texas, the location of the inventors' activities and contacts at various chambers of commerce in Texas, and the location of relevant witnesses at Home Depot, including in East Texas, the Eastern District of Texas is a highly convenient, if not the most convenient, forum for this lawsuit.

10. This Court has personal jurisdiction over Defendants. Defendants Home Depot, HDUSA, and HDPa have continuous and systematic business contacts with the State of Texas. Defendants, directly and/or through subsidiaries or intermediaries (including distributors, retailers, and others), conducts their business extensively throughout Texas, by shipping, distributing, offering for sale, selling, and advertising (including the provision of interactive web pages and mobile applications) their products and/or services in the State of Texas and the Eastern District of Texas. Defendants regularly do business or solicit business, engage in other persistent courses of conduct, and/or derive substantial revenue from products and/or services provided to individuals in the State of Texas.

11. Defendants Home Depot, HDUSA, and HDPa directly and/or through subsidiaries or intermediaries (including distributors, retailers, and others), have purposefully and voluntarily placed one or more products and/or services in the stream of commerce that practice the Asserted ~~Patent~~ with the intention and expectation that the one or more products and/or services will be purchased and used by consumers and/or Defendants' employees in the Eastern District of Texas.

employees working throughout the state of Texas, including within the Eastern District of Texas. Given the location of the plaintiff and its primary stakeholders in Texas, the location of the inventors' activities and contacts at various chambers of commerce in Texas, and the location of relevant witnesses at Home Depot, including in East Texas, the Eastern District of Texas is a highly convenient, if not the most convenient, forum for this lawsuit.

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11. Defendants Home Depot, HDUSA, and HDPa directly and/or through subsidiaries or intermediaries (including distributors, retailers, and others), have purposefully and voluntarily placed one or more products and/or services in the stream of commerce that practice the Asserted Patents with the intention and expectation that the one or more products and/or services will be purchased and used by consumers and/or Defendants' employees in the Eastern District of Texas. These products and/or services have been and continue to be purchased and used by operators/carriers in the Eastern District of Texas.

These products and/or services have been and continue to be purchased and used by operators/carriers in the Eastern District of Texas.

BACKGROUND OF THE INVENTORS

12. Inventors Ryan Hardin and Andrew Hill both grew up in Henderson, Texas. After college, Hardin and Hill started an IT services company called Pronet Solutions Corp. in 2002 in East Texas. Upon establishing the business after a few years, Hardin and Hill began to investigate and discuss emerging and future business opportunities that would leverage their technological backgrounds and expertise.

13. In the 2006-2007 timeframe, Hardin and Hill were interested in the digital billboard business. At that time, digital billboards were relatively new, and Hardin and Hill saw an opportunity to grow a business for displaying content (e.g., advertisements) on digital billboards, which they could efficiently manage and control remotely. However, Hardin and Hill ultimately saw significant barriers to entry for getting into the digital billboard business, including costs, regulatory considerations, and governmental issues.

14. Then, in late 2007, Hardin was at a meeting in Henderson, and when getting in his car to go to his next appointment, he looked at his phone and thought—why should he and Hill risk the expense to erect digital billboards if much of the public might soon be carrying digital billboards in their pockets? Of course, at that time, smartphones were in a period of rapid development, and while a few mobile devices had GPS, access to the internet, and apps, they were certainly not as commonplace as today. Hardin and Hill were betting on the future. This thought inspired Hardin and Hill to develop several specific technological improvements to the manner in which mobile devices operated over the then-conventional technologies. Going forward, Hardin

BACKGROUND OF THE INVENTORS

12. Inventors Ryan Hardin and Andrew Hill both grew up in Henderson, Texas. After college, Hardin and Hill started an IT services company called Pronet Solutions Corp. in 2002 in East Texas. Upon establishing the business after a few years, Hardin and Hill began to investigate and discuss emerging and future business opportunities that would leverage their technological backgrounds and expertise.

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and Hill continued to fine-tune the implementation of their inventions and applied for their first patent on May 1, 2009.

15. Separate from the patented inventions, not only did Hardin and Hill realize a technical solution was needed—but they realized they needed a way to market the technology to consumers. In this same timeframe, Hardin and Hill coincidentally received a phone call from the Henderson Area Chamber of Commerce, which requested a website be designed—but as cheaply as possible. Hardin and Hill ultimately saw this as an opportunity to market their inventions. As a result, Hardin and Hill decided they would develop and host the website for free for the Henderson Area Chamber of Commerce, but then ultimately, build free websites for all Chambers of Commerce. Then, through the access the chambers had with businesses, the websites could get advertising revenue—which is how Hardin and Hill could ultimately be compensated. Moreover, once setting up this network of chambers of commerce was complete, eventually the patented technology could also be marketed and used to create location-aware content delivery on mobile devices as they envisioned an increased demand from businesses for location-aware apps and from the public for mobile devices. Hardin and Hill called the product “ChamberPlanet.”

16. Hardin and Hill spent years developing ChamberPlanet and started to get numerous chambers of commerce on board. At one point, Hardin and Hill were working with the Henderson Area Chamber, Jacksonville Chamber, Bullard Area Chamber, Pittsburgh Camp County Chamber, and the Greater Marshall Chamber of Commerce. In fact, Hardin and Hill negotiated the purchase of the MarshallTexas.com domain from a third party and provided it to the Greater Marshall Chamber of Commerce. As more chambers got on board, more challenges arose, including that

15. Separate from the patented inventions, not only did Hardin and Hill realize a technical solution was needed—but they realized they needed a way to market the technology to consumers. In this same timeframe, Hardin and Hill coincidentally received a phone call from the Henderson Area Chamber of Commerce, which requested a website be designed—but as cheaply as possible. Hardin and Hill ultimately saw this as an opportunity to market their inventions. As a result, Hardin and Hill decided they would develop and host the website for free for the Henderson Area Chamber of Commerce, but then ultimately, build free websites for all Chambers of Commerce. Then, through the access the chambers had with businesses, the websites could get advertising revenue—which is how Hardin and Hill could ultimately be compensated. Moreover, once setting up this network of chambers of commerce was complete, eventually the patented technology could also be marketed and used to create location-aware content delivery on mobile devices as they envisioned an increased demand from businesses for location-aware apps and from the public for mobile devices. Hardin and Hill called the product “ChamberPlanet.”

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17. On or around 2012, however, while Hardin and Hill were still developing and growing the ChamberPlanet product, their separate business Pronet also began to experience some challenges, largely due to the business disruptions created by the financial crisis. Hardin and Hill had to focus more on Pronet, which was the business that provided revenue to them—and this slowed the growth of ChamberPlanet. In addition, numerous members of Hardin’s family began to have serious health issues. Hardin’s wife had medical issues in pregnancies which required multiple surgeries and then she later developed cancer. Around the same time, Hardin’s mother fell and broke her back, and Hardin’s father required a lung transplant. Hardin needed to prioritize his family over the continued development of ChamberPlanet for a period of time.

18. During this period of time, however, Hardin and Hill noticed that mobile devices were starting to utilize the technological advances that Hardin and Hill invented and ultimately patented. Moreover, these companies developing the mobile devices and related software and services had significantly more financial resources that enabled them to commercialize the inventions much more quickly than Hardin or Hill could. As a result, Hardin and Hill then decided to focus more on protecting the intellectual property they had developed, while continuing to look for opportunities to bounce back and continue to make progress on their technology.

19. Hardin and Hill have a significant amount of intellectual property they have developed, including the following patents: U.S. Patent No. 8,433,296, U.S. Patent No. 8,977,247,

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19. Hardin and Hill have a significant amount of intellectual property they have developed, including the following patents: U.S. Patent No. 8,433,296, U.S. Patent No. 8,977,247, U.S. Patent No. 9,286,625, U.S. Patent No. 9,245,284, U.S. Patent No. 9,710,794, U.S. Patent No. 9,779,418, U.S. Patent No. 10,049,387, U.S. Patent No. 10,719,819, U.S. Patent No. 10,984,447, U.S. Patent No. 11,423,374, U.S. Patent No. 11,948,171, U.S. Patent No. 11,972,403, and U.S. Patent No. 12,056,736.

U.S. Patent No. 9,286,625, U.S. Patent No. 9,779,418, U.S. Patent No. 10,049,387, U.S. Patent No. 10,984,447, U.S. Patent No. 11,948,171, and U.S. Patent No. ~~12,056,736.¹~~

THE ASSERTED ~~PATENT~~

20. Plaintiff is the owner in right, title, and interest in and to multiple United States patents and patent applications, including U.S. Patent No. ~~8,433,296~~ (the “~~’296 Patent~~” or the “~~Asserted Patent~~”). The ~~Asserted Patent~~ is valid and enforceable, and the inventions claimed in the ~~Asserted Patent~~ were novel, non-obvious, unconventional, and non-routine as of the May 1, 2009 filing date of the patent application leading to issuance of the ~~Asserted Patent~~.

21. The ~~’296 Patent~~, entitled “Exclusive Delivery of Content within Geographic Areas,” was duly and legally issued to inventors Ryan Hardin and Andrew Hill on ~~April 30, 2013~~. Plaintiff owns the entire right, title, and interest in the ~~’296 Patent~~ and is entitled to sue for past and future infringement. A true and correct copy of the ~~’296 Patent~~ is attached as Exhibit A.

OVERVIEW OF THE INVENTIONS

~~22.~~ The ~~Asserted Patent~~ is generally directed to methods and systems for delivering content to application programs on mobile devices based on the geographic location of the devices. The Background of the ~~Asserted Patent~~ describes conventional delivery of content to mobile devices in response to requests based on user interactions and preferences. The ~~Asserted Patent~~ ~~describes~~ and ~~claims~~ particular technical solutions that overcome the disadvantages of the conventional methods while being specifically applicable to the unique nature of mobile devices.

¹ ~~Hardin and Hill also developed three patents in a patent family relating to the application of dynamic tokens, which family is not asserted in this complaint. U.S. Patent No. 9,245,284, U.S. Patent No. 9,710,794, and U.S. Patent No. 10,719,819.~~

THE ASSERTED PATENTS

20. Plaintiff is the owner in right, title, and interest in and to multiple United States patents and patent applications, including U.S. Patent Nos. 8,977,247 (the “’247 Patent”) and 9,286,625 (the “’625 Patent”) (together, the “Asserted Patents”). The Asserted Patents are valid and enforceable, and the inventions claimed in the Asserted Patents were novel, non-obvious, unconventional, and non-routine as of the May 1, 2009 filing date of the patent application leading to issuance of the Asserted Patents.

21. The ’247 Patent, entitled “Exclusive Delivery of Content within Geographic Areas,” was duly and legally issued to inventors Ryan Hardin and Andrew Hill on March 10, 2015. Plaintiff owns the entire right, title, and interest in the ’247 Patent and is entitled to sue for past and future infringement. A true and correct copy of the ’247 Patent is attached as Exhibit A.

22. The ’625 Patent, entitled “Exclusive Delivery of Content within Geographic Areas,” was duly and legally issued to inventors Ryan Hardin and Andrew Hill on March 15, 2016. Plaintiff owns the entire right, title, and interest in the ’625 Patent and is entitled to sue for past and future infringement. A true and correct copy of the ’625 Patent is attached as Exhibit B.

OVERVIEW OF THE INVENTIONS

23. The Asserted Patents are generally directed to methods and systems for delivering content to application programs on mobile devices based on the geographic location of the devices. The Background of the Asserted Patents describes conventional delivery of content to mobile devices in response to requests based on user interactions and preferences. The Asserted Patents describe and claim particular technical solutions that overcome the disadvantages of the conventional methods while being specifically applicable to the unique nature of mobile devices.

~~23.~~ The innovations described and claimed in the Asserted ~~Patent~~ provide several benefits over conventional technologies, including existing geofencing solutions, as described below.

~~24.~~ *First*, the Asserted ~~Patent~~ ~~includes~~ the feature that the area for content delivery is customizable, which enables delivery of content in near-real time to areas as specific as particular business or home locations. *See, e.g., '296 Patent*, at 8:~~40-41~~. The area can be defined by various “geometric constructs,” or by “map features, such as streets, rivers, landmarks, or any of the other various map features.” *See, e.g., '296 Patent* at 8:~~46-48~~. This is claimed by, for example, allowing sponsors to provide “perimeter definitions” (*see, e.g., '296 Patent* at 8:~~46-65~~; *'296 Patent*, claim 1 (“establishing a plurality of perimeters defining a plurality of geographic areas”)). This solves unique problems associated with providing content to applications on mobile devices. For example, it allows a business that rents canoes to provide content to mobile devices (or related mobile applications) located on the unique geographic confines of a particular river or lake. *See, e.g., '296 Patent* at ~~4:56-60~~ (“reserved geographic area can be partially bounded by a ... river, ... or other desired boundary.”). Or it could allow a parent to receive a notification via a mobile application on her mobile device when her child arrives safely at home from school. *See, e.g., '296 Patent* at 9:~~21-27~~ (“the content received from the sponsor can be stored for later delivery to registered applications running on mobile devices having target locations... such target locations may include... when the mobile device or target location physically enters... the sponsor’s reserved area”).

~~25.~~ *Second*, the Asserted Patent includes the feature that an entity operating as a centralized management system can receive requests from multiple apps for the delivery of content

24. The innovations described and claimed in the Asserted Patents provide several benefits over conventional technologies, including existing geofencing solutions, as described below.

25. *First*, the Asserted Patents include the feature that the area for content delivery is customizable, which enables delivery of content in near-real time to areas as specific as particular business or home locations. *See, e.g.*, '625 Patent, at 8:60-61. The area can be defined by various “geometric constructs,” or by “map features, such as streets, rivers, landmarks, or any of the other various map features.” *See, e.g.*, '625 Patent at 8:65-67. This is claimed by, for example, allowing sponsors to provide “perimeter definitions” (*see, e.g.*, '625 Patent at 8:65-9:17; '247 Patent, claim 1 (“establishing a plurality of perimeters defining a plurality of geographic areas”)). This solves unique problems associated with providing content to applications on mobile devices. For example, it allows a business that rents canoes to provide content to mobile devices (or related mobile applications) located on the unique geographic confines of a particular river or lake. *See, e.g.*, '625 Patent at 5:8-12 (“reserved geographic area can be partially bounded by a ... river, ... or other desired boundary.”). Or it could allow a parent to receive a notification via a mobile application on her mobile device when her child arrives safely at home from school. *See, e.g.*, '625 Patent at 9:39-45 (“the content received from the sponsor can be stored for later delivery to registered applications running on mobile devices having target locations... such target locations may include... when the mobile device or target location physically enters... the sponsor’s reserved area”).

26. *Second*, one or more of the Asserted Patents describes and claims the feature that the delivery of content is based on the mobile device entering an area for a predetermined/specified

period of time, for example where this period of time can be specified by the requestor. See, e.g., '625 Patent at 3:35-37, claim 13 ("wherein receiving the request to obtain the interest in the designated geographic area includes receiving a value representing a specified length of time for having content associated with the one or more sponsors delivered to the one or more application program instances after it is determined that the object of interest has entered the designated geographic area and has remained within the designated geographic area for the specified length of time."). Conventional methods prior to May 1, 2009, did not enable content delivery specifically targeted to mobile applications within a given area for a certain amount of time. This technological advance enables the delivery of content for those mobile devices that enter and remain within the claimed requested customizable region. In contrast, conventional broadcast delivery (e.g., TV or radio) is generally neither aware of the location of the intended device (apart from knowing that they must be within range of the transmitter, e.g., in a city), nor is aware of how long the intended device has remained within range, nor is it aware of any movement of the intended device. This capability allows, for example, avoiding the delivery of content when a mobile device has not met the time restriction, e.g., the mobile device is merely passing through the region or nearby the region's boundary.

27. This capability was particularly important to avoid the problem in the industry of "alert spam," wherein mobile devices would receive unwanted alerts (such as notifications or offers) that were not relevant to the mobile device application or user. As explained in the preceding paragraph, the Asserted Patents describe and claim a technical solution to this problem of alert spam that was unique to mobile devices. The capability is actually counterintuitive, for example, for a parent receiving a notification via a mobile application on her mobile device when

when the device enters a specific geographic area, determine a mobile device's physical geographic location, and deliver content to requesting apps when it has been determined that the mobile device has entered any of the specified ~~areas and remained therein for a predetermined/specified period of time~~. See, e.g., '296 Patent at 3:18-20, 9:21-27, claim 1. The centralized management system can thereby deliver specific content to each of a number of registered apps within specific regions under centralized management.

26. ~~: Third, the Asserted Patent includes the feature that a request identifier can be provided for each request for content from an application program; this identifier further being used to provide information related to user interaction with the provided content and then providing additional content to the application program, or other application programs, in response. See, e.g., '296 Patent at 2:52-55, 12:14-17, claim 3 ("receiving information related to user interaction with the provided content, the information including the request identifier, and providing additional content to the registered application in response to the received information.").~~ This is a unique technological solution for the tracking of user interaction with content delivered based on geographic areas of interest and allowing further tailored content to be delivered to that user.

27. ~~Fourth, the Asserted Patent includes the feature that the geographic areas can be exclusively reserved, including providing technical solutions for time-sharing and resolving competing priority claims in real-time. See, e.g., '296 Patent at 3:11-22, claim 5 ("reserving a specific one of the plurality of geographic areas for exclusive delivery of content associated with a particular one of the plurality of sponsors to registered application programs").~~ This feature solves problems that are unique to the environment of mobile devices with multiple applications,

her child arrives safely at home from school, one would think that ideally the notification would be sent immediately, but by including a slight time delay there are actually technical benefits that may outweigh the benefit of an immediate notification.

28. Third, the Asserted Patents include the feature that an entity operating as a centralized management system can receive requests from multiple apps for the delivery of content when the device enters a specific geographic area, determine a mobile device's physical geographic location, and deliver content to requesting apps when it has been determined that the mobile device has entered any of the specified areas. See, e.g., '625 Patent at 3:28-39, 9:39-45; '247 Patent, claim 1. The centralized management system can thereby deliver specific content to each of a number of registered apps within specific regions under centralized management.

29. Fourth, one or more of the Asserted Patents include the feature that the geographic areas can be exclusively reserved, including providing technical solutions for time-sharing and resolving competing priority claims in real-time. See, e.g., '625 Patent at 3:28-39, 7:20-44, claim 2 ("wherein restricting content delivery to the one or more application program instances includes restricting content delivery after receiving the request to obtain the interest in the designated geographic area"); '247 Patent at 7:8-32, claim 3 ("restricting content delivery to being to the first one of the registered application programs during a first period of time and to being to from the second one of the registered application programs during a second period of time"). This feature solves problems that are unique to the environment of mobile devices with multiple applications, such as how to resolve competing claims for exclusivity in a particular geographic area when multiple applications are simultaneously in use on a mobile device.

such as how to resolve competing claims for exclusivity in a particular geographic area when multiple applications are simultaneously in use on a mobile device.

~~28. Sixth~~, the Asserted ~~Patent~~ also ~~provides~~ solutions to resolving potentially competing claims to a reserved area. *See, e.g., '296 Patent at 7:19-25.* One example embodiment is to increase the predetermined radial distance of a target location if needed to determine which content should be provided in response to a negative determination. *See, e.g., '296 at claim 4* (“~~determining whether at least one of the plurality of sponsors is associated with a geographical representation lying at least partially within a predetermined radial distance of a target location; in response to a negative determination, increasing the predetermined radial distance.~~”).

~~29.~~ These claimed features provide technological solutions to problems that are unique to the technological environment of multiple application programs on mobile devices and thereby improve the functionality of mobile devices. For example, the centralized management solution allows for battery savings through the reduction of instances in which a device’s location must be polled. It also provides solutions for resolving competing claims of exclusivity to a particular geographic area by content providers, allowing geographic exclusivity to be further divided among other dimensions including based on mobile application and time.

COUNT I: CLAIM FOR PATENT INFRINGEMENT OF THE '296 PATENT

~~30.~~ Plaintiff repeats and realleges the allegations in paragraphs 1-~~29~~ as if fully set forth herein. Defendants have infringed, contributorily infringed, and/or induced infringement of one or more claims of the '296 Patent by making, using, selling, offering for sale, or importing into the United States, or by intending that others make, use, import into, offer for sale, or sell in the United States, products and/or methods covered by one or more claims of the '296 Patent including, but

30. Fifth, one or more of the Asserted Patents also provide solutions to resolving potentially competing claims to a reserved area. *See, e.g.,* '625 Patent at 7:29-44, claim 11 ("wherein restricting content delivery to the one or more application program instances includes restricting content delivery to being content to be delivered during the one or more designated times."); '247 Patent at 7:8-32, claim 3 ("restricting content delivery to being to the first one of the registered application programs during a first period of time and to being to from the second one of the registered application programs during a second period of time"). One example embodiment is to increase the predetermined radial distance of a target location if needed to determine which content should be provided in response to a negative determination. *See, e.g.,* '625 Patent at 2:3-8.

31. These claimed features provide technological solutions to problems that are unique to the technological environment of multiple application programs on mobile devices and thereby improve the functionality of mobile devices. For example, the centralized management solution allows for battery savings through the reduction of instances in which a device's location must be polled. It also provides solutions for resolving competing claims of exclusivity to a particular geographic area by content providers, allowing geographic exclusivity to be further divided among other dimensions including based on mobile application and time.

COUNT I: CLAIM FOR PATENT INFRINGEMENT OF THE '247 PATENT

32. Plaintiff repeats and realleges the allegations in paragraphs 1-31 as if fully set forth herein. Defendants have infringed, contributorily infringed, and/or induced infringement of one or more claims of the '247 Patent by making, using, selling, offering for sale, or importing into the United States, or by intending that others make, use, import into, offer for sale, or sell in the United

not limited to the Home Depot mobile application and mobile devices used by Defendants' employees (collectively, the "Accused Products").

~~31.~~ Upon information and belief, Defendants' products and services that infringe one or more claims of the '~~296~~ Patent include at least the Home Depot mobile application and infrastructure (including Store Mode and Curbside Pickup features) and mobile devices used by Defendants' employees (including the hdPhone operating system and device). The products listed are exemplary, and Plaintiff will be able to provide a more comprehensive list after discovery. Upon information and belief, Defendants also infringe one or more claims of the '~~296~~ Patent through their use of geofencing or location information in their advertising or content delivery efforts or their own applications they develop.

~~32.~~ For example, upon information and belief, one or more of the Accused Products infringe at least claim ~~11~~ of the '~~296~~ Patent. Defendants make, use, sell, offer for sale, import, export, supply, or distribute within the United States one or more of the Accused Products and thus directly infringe the '~~296~~ patent.

~~33.~~ Defendants indirectly infringe one or more claims of the '~~296~~ Patent as provided by 35 U.S.C. § 271(b) by inducing infringement by others, such as manufacturers, resellers, and end-user customers in this District and throughout the United States. For example, direct infringement is the result of activities performed by manufacturers, resellers, or operators/carriers of mobile devices which use the Accused Products, who, upon information and belief, perform each step of the claimed invention as directed by Defendants. Upon information and belief, Defendants' customers, including in this District, also use the claimed invention when they use

States, products and/or methods covered by one or more claims of the '247 Patent including, but not limited to the Home Depot mobile application and mobile devices used by Defendants' employees (collectively, the "Accused Products").

33. Upon information and belief, Defendants' products and services that infringe one or more claims of the '247 Patent include at least the Home Depot mobile application and infrastructure (including Store Mode and Curbside Pickup features) and mobile devices used by Defendants' employees (including the hdPhone operating system and device). The products listed are exemplary, and Plaintiff will be able to provide a more comprehensive list after discovery. Upon information and belief, Defendants also infringe one or more claims of the '247 Patent through their use of geofencing or location information in their advertising or content delivery efforts or their own applications they develop.

34. For example, upon information and belief, one or more of the Accused Products infringe at least claim 15 of the '247 Patent. Defendants make, use, sell, offer for sale, import, export, supply, or distribute within the United States one or more of the Accused Products and thus directly infringe the '247 patent.

35. Defendants indirectly infringe one or more claims of the '247 Patent as provided by 35 U.S.C. § 271(b) by inducing infringement by others, such as manufacturers, resellers, and end-user customers in this District and throughout the United States. For example, direct infringement is the result of activities performed by manufacturers, resellers, or operators/carriers of mobile devices which use the Accused Products, who, upon information and belief, perform each step of the claimed invention as directed by Defendants. Upon information and belief, Defendants' customers, including in this District, also use the claimed invention when they use

Defendants accused products. Defendants received actual notice of the '296 Patent at least as early as the ~~filing of this Complaint.~~

~~34.~~ Defendants contributorily infringe one or more claims of the '296 Patent as provided by 35 U.S.C. § 271(c) by contributing to the infringement by others, such as manufacturers, resellers, and end-user customers in this District and throughout the United States.

~~35.~~ Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction to ~~register~~ a plurality of application programs for use with a content delivery platform, ~~wherein the plurality of registered application programs are each associated with at least one application program type,~~ including as demonstrated in the images below.

STORE MODE

Take your project from doing to done when you visit any store. View in-stock items, Product Lists, reviews & more.



Home Depot, *Home Depot App: Store Mode* (May 27, 2024), https://www.homedepot.com/c/SF_Mobile_Shopping [hereinafter *Example Image 1.1*].

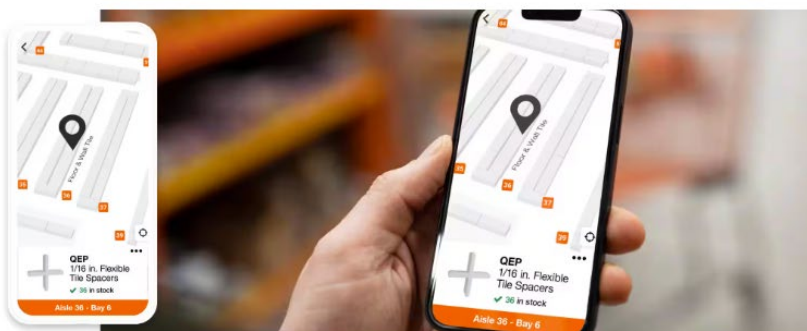
Defendants accused products. Defendants received actual notice of the '247 Patent at least as early as August 22, 2024 when Plaintiff filed the original complaint in Case No. 2:24-cv-00694. Home Depot then became aware of the '247 Patent and did not meaningful alter its conduct, and upon information and belief, Home Depot did not take steps to ensure its conduct was not infringing. Instead, Home Depot continued infringement, and at that point, it was deliberate and intentional. Upon information and belief, including belief created by actions taken by Home Depot in the co-pending case against Home Depot by Plaintiff, Home Depot has stuck its head and the sand and not even investigated whether its use of geofencing infringes the patent at issue. Home Depot has therefore willfully infringed the '247 patent. Enhanced damages are warranted based on Home Depot's willful, deliberate, and consciously wrongful infringement.

36. Defendants contributorily infringe one or more claims of the '247 Patent as provided by 35 U.S.C. § 271(c) by contributing to the infringement by others, such as manufacturers, resellers, and end-user customers in this District and throughout the United States.

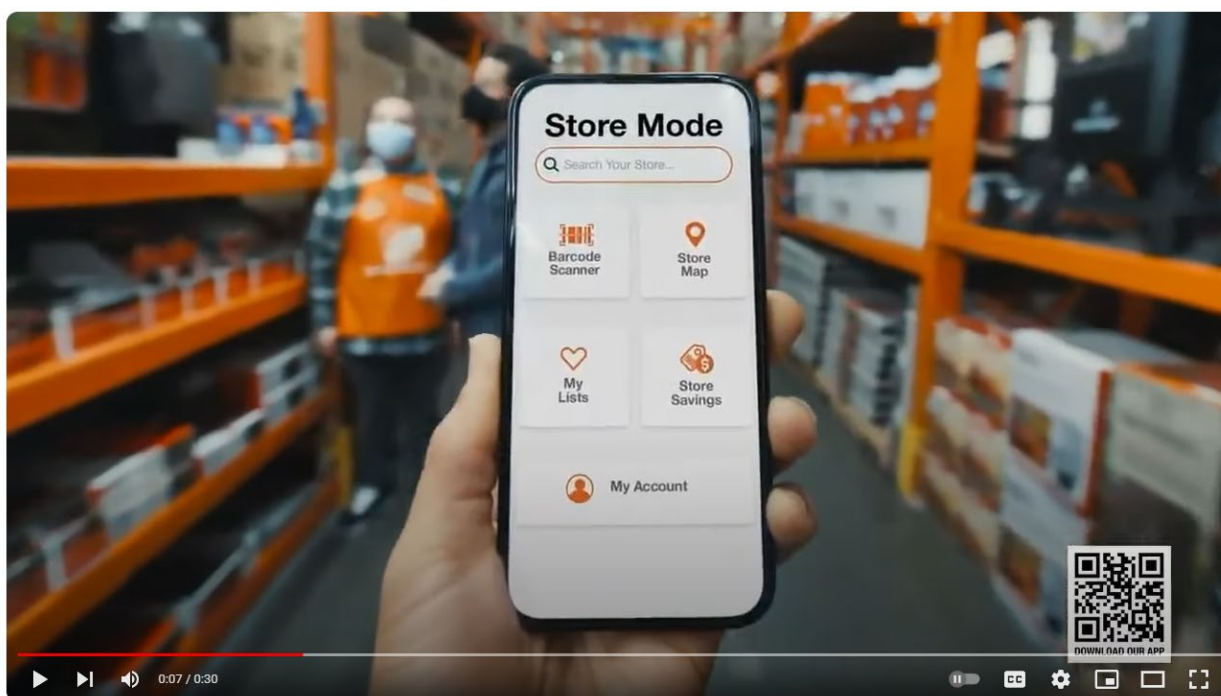
37. Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction for registering a plurality of application programs for use with a content delivery platform, including as demonstrated in the images below.

PRODUCT LOCATOR

No need to wander. The app helps you navigate to the aisle and bay to find the item you need.



Home Depot, *Home Depot App: Product Locator* (May 27, 2024), https://www.homedepot.com/c/SF_Mobile_Shopping [hereinafter *Example Image 1.2*].



SN®, *The Home Depot Commercial 2022* (May 27, 2024), <https://www.youtube.com/watch?v=bLbiUqIu8WE> [hereinafter *Example Image 1.3*].

STORE MODE

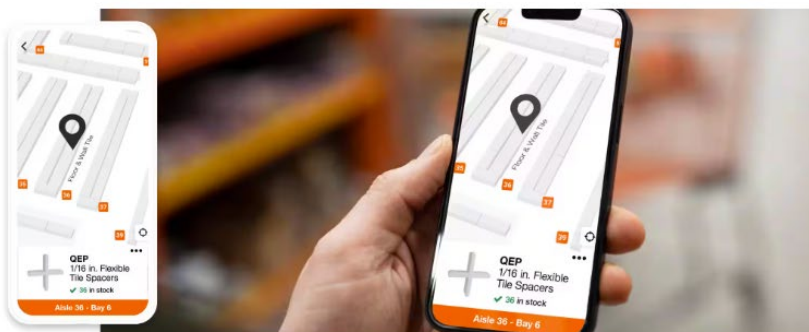
Take your project from doing to done when you visit any store. View in-stock items, Product Lists, reviews & more.



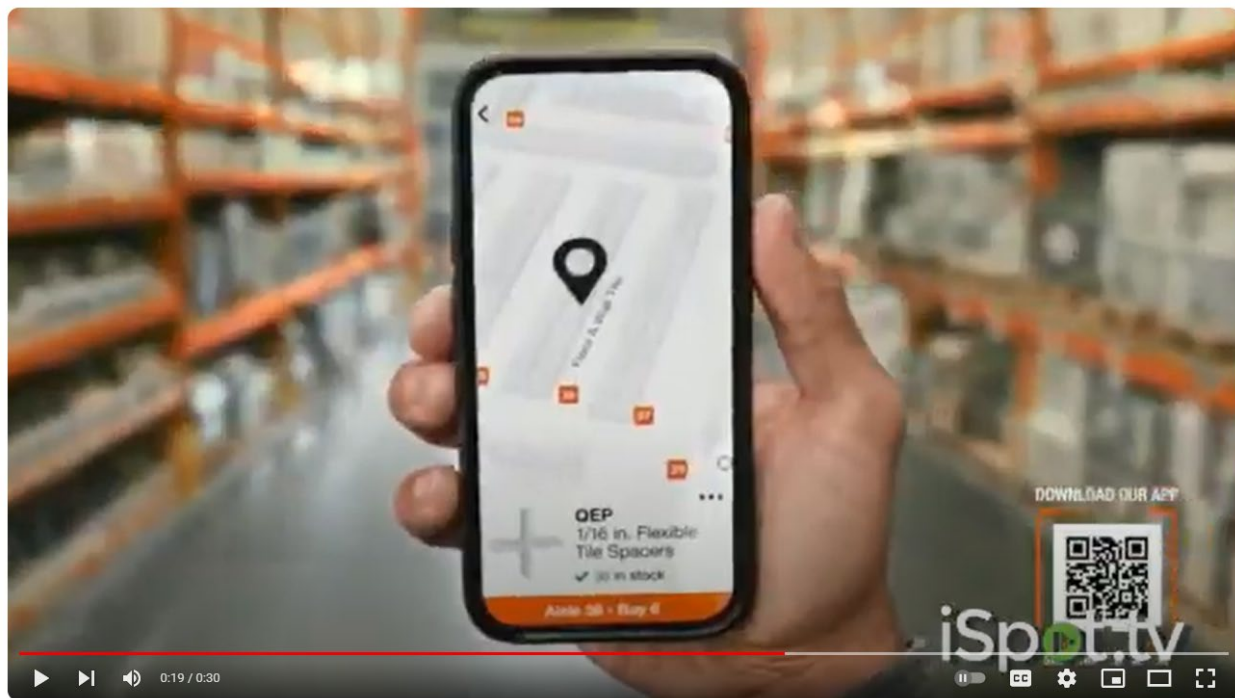
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https://www.homedepot.com/c/SF_Mobile_Shopping [hereinafter *Example Image 1.1*].

PRODUCT LOCATOR

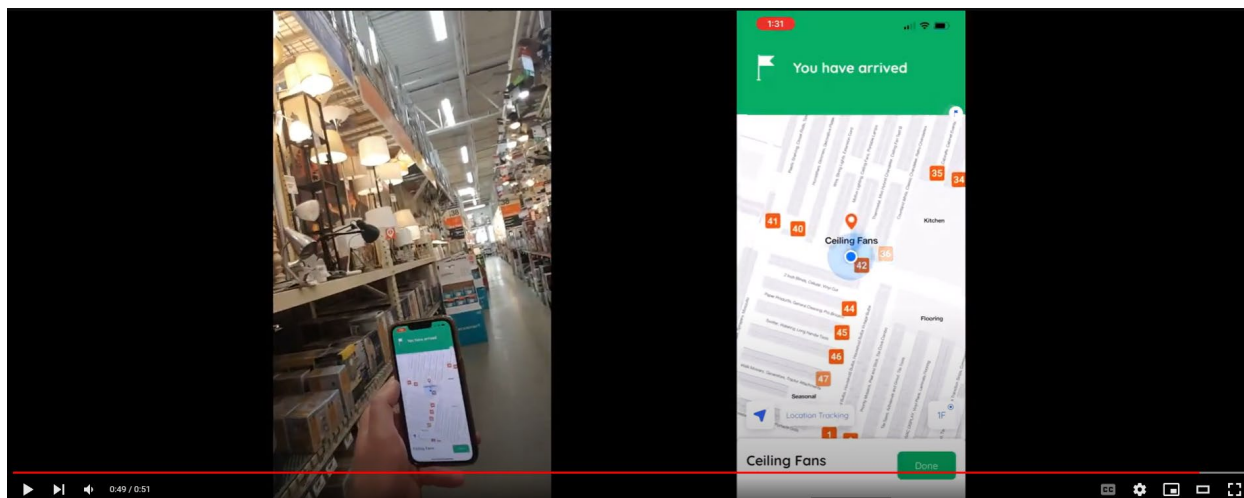
No need to wander. The app helps you navigate to the aisle and bay to find the item you need.



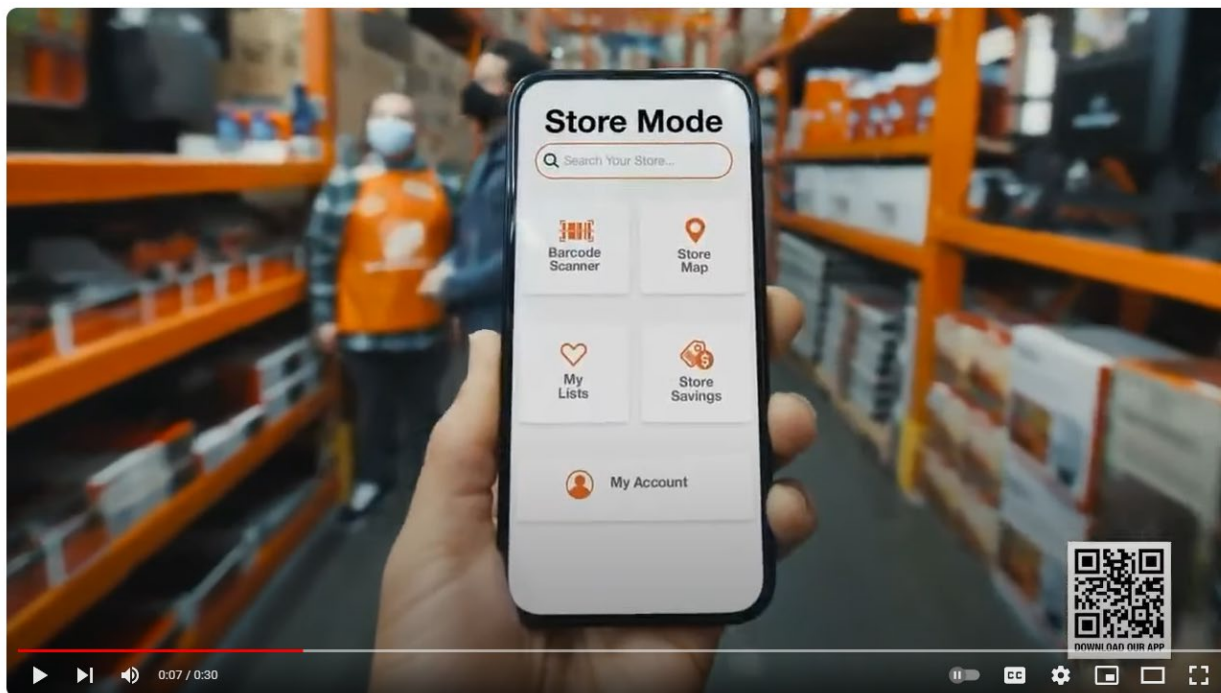
Home Depot, *Home Depot App: Product Locator* (May 27, 2024),
https://www.homedepot.com/c/SF_Mobile_Shopping [hereinafter *Example Image 1.2*].



~~Pointr = The Deep Location Company, Home Depot Commercial 2024 | Map My List (May 27, 2024), <https://www.youtube.com/watch?v=7XbygJeebqo> [hereinafter Example Image 1.4].~~



~~Pointr = The Deep Location Company, Home Depot walk through (June 27, 2023), <https://www.youtube.com/watch?v=-5sGrZkkzjE> [hereinafter Example Image 1.5].~~



SN®, *The Home Depot Commercial 2022* (May 27, 2024),

<https://www.youtube.com/watch?v=bLbiUqIu8WE> [hereinafter *Example Image 1.3*].

Home Depot's revamped mobile app highlights engaging features like barcode search, voice search and visual search. When a user walks into a Home Depot store, the app will automatically switch to in-store mode. Then, the shopper can use the app to navigate to the aisle in which a product is located. Home Depot also works with Adobe on mobile analytics, geofencing and mobile content optimization to drive offline sales and in-store pickups.

"Our core mobile strategy is focused on our customers' needs," Vemana said. "It's all about how to make their shopping experience easier and consistent across desktop, mobile and in the store."

Augmented reality is an area that Home Depot is looking to improve. Its competitor Lowe's recently introduced Lowe's Vision, an in-store navigation app that uses Google's Tango AR tech to let shoppers in Sunnyvale, California, and Lynnwood, Washington, search for products, add them to a shopping list and locate them within stores using AR. Home Depot has already let shoppers place virtual products in the real world through its shopping app, but it doesn't plan to develop a navigation app like Lowe's Vision anytime soon.

"There's good engagement in AR, and we are working on the tech in various ways," Vemana said.

Home Depot's revamped mobile app highlights engaging features like barcode search, voice search and visual search. When a user walks into a Home Depot store, the app will automatically switch to in-store mode. Then, the shopper can use the app to navigate to the aisle in which a product is located. Home Depot also works with Adobe on mobile analytics, geofencing and mobile content optimization to drive offline sales and in-store pickups.

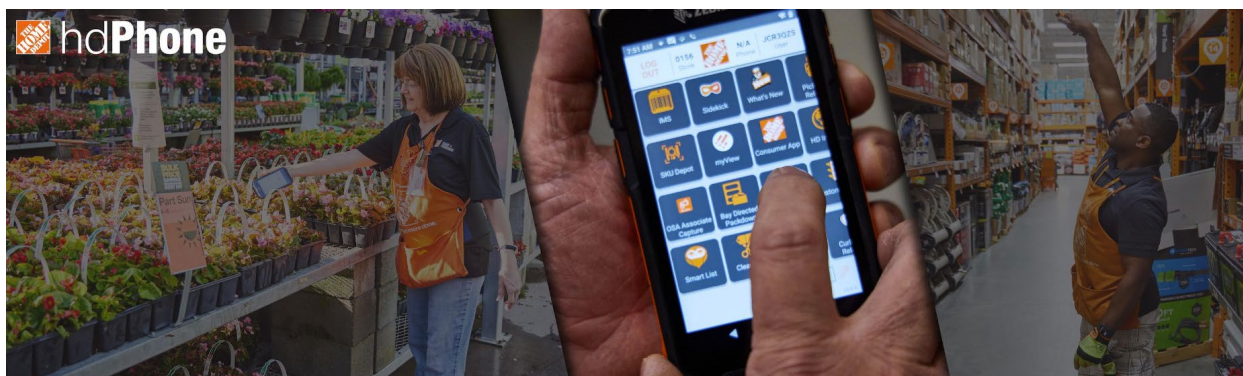
"Our core mobile strategy is focused on our customers' needs," Vemana said. "It's all about how to make their shopping experience easier and consistent across desktop, mobile and in the store."

Augmented reality is an area that Home Depot is looking to improve. Its competitor Lowe's recently introduced Lowe's Vision, an in-store navigation app that uses Google's Tango AR tech to let shoppers in Sunnyvale, California, and Lynnwood, Washington, search for products, add them to a shopping list and locate them within stores using AR. Home Depot has already let shoppers place virtual products in the real world through its shopping app, but it doesn't plan to develop a navigation app like Lowe's Vision anytime soon.

"There's good engagement in AR, and we are working on the tech in various ways," Vemana said.

Yuyu Chen, *On Black Friday, Home Depot saw more mobile traffic than desktop*, DIGIDAY (November 28, 2017), <https://digiday.com/marketing/how-home-depot-uses-mobile-to-drive-sales/> [hereinafter *Example Image 1.6*].

Yuyu Chen, *On Black Friday, Home Depot saw more mobile traffic than desktop*, DIGIDAY (November 28, 2017), <https://digiday.com/marketing/how-home-depot-uses-mobile-to-drive-sales/> [hereinafter *Example Image 1.4*].



The new mobile devices allow for increased capabilities:

- Communicate anywhere throughout the entire store and into the parking lots.
- Advanced-range barcode scanning enables associates to locate products, check pricing and inventory availability in hand or from more than 40 feet away, which is helpful when serving customers and locating products in overhead storage.
- Docking with Zebra's Workstation Connect enables associates to view and demo products and specifications on larger screens, helping customers find products to complete their projects.
- Additional capabilities include multi-device integration, more efficient app speeds, in-store texting, direct walkie talkie communication, and more.

Home Depot, *The Home Depot Upgrades In-Store Network and Mobile Devices to Enhance the Interconnected Experience* (June 15, 2022), <https://corporate.homedepot.com/news/company/home-depot-upgrades-store-network-and-mobile-devices-enhance-interconnected-experience> [hereinafter *Example Image 1.5*].

1. Digitizing maps

An accurate [in-store map](#) is the first step to Store Mode. It unlocks a host of other features, including wayfinding, product location, aisle location, and proximity-based push notifications. [Indoor mapping](#) in retail poses two significant challenges. Firstly, manually creating digital maps for hundreds (or even thousands) of diverse stores is incredibly time-consuming which can delay your app launch considerably. Secondly, keeping maps updated in a retail environment that changes their layout frequently according to the retail calendar and changing seasons, promotions, and displays is a never-ending task. Fortunately, tools like [MapScale®](#) can retrieve existing maps of all stores in any format and convert them in a fraction of the time it would take using a manual conversion. Maps can be upgraded and changed in seconds with simple cloud-based mapping tools. Once this step has been completed, the groundwork is laid for rich and engaging location-aware features.

Watch how Home Depot has enabled digital maps & Store Mode in their app:

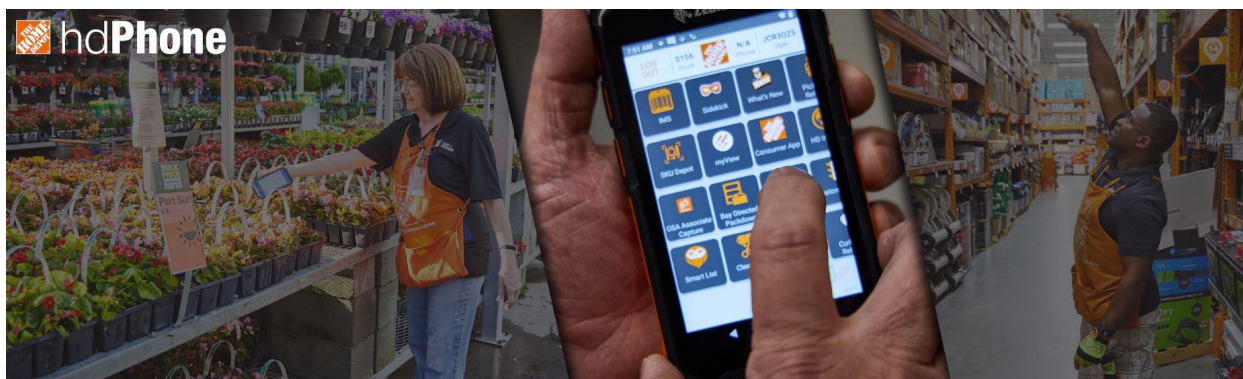


~~Pointnr, The Building Blocks To Implement Retail App Store Mode: Digitizing Maps (October 18, 2022); <https://www.pointnr.tech/blog/building-blocks-to-implement-store-mode> [hereinafter Example Image 1.7].~~

3. Blue Dot Positioning

With stores like Macy's or Home Depot that take up thousands of square feet of floor space and multiple storeys, simply indicating which aisle a product is located in isn't enough guidance to help a customer find what they are looking for. [Indoor blue dot positioning](#) will enable retailers to guide shoppers to the products on their shopping list turn-by-turn (much like GPS positioning does outdoors). [Bluetooth Low Energy \(BLE\) hardware](#) is the cheapest, most accurate and most secure enabler of indoor location technology. The hardware can be implemented as standalone beacons, or reside inside WiFi access points or inside smart lighting, sensors and cameras. Together with a SDK (Software Development Kit) that resides inside the mobile, you can calculate the user's real time location in the app with great accuracy. The SDK helps retailers steer customers to general points of interest, like bathroom facilities, customer service, or elevators.

~~Pointnr, The Building Blocks To Implement Retail App Store Mode: Blue Dot Positioning (October 18, 2022); <https://www.pointnr.tech/blog/building-blocks-to-implement-store-mode> [hereinafter Example Image 1.8].~~

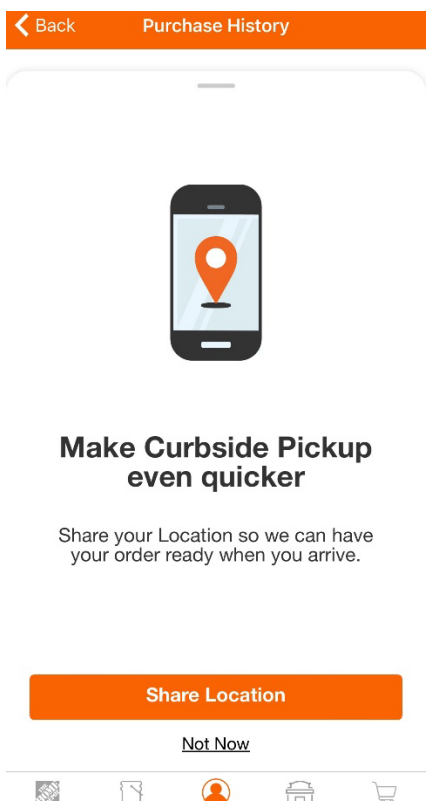


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Home Depot, *The Home Depot Upgrades In-Store Network and Mobile Devices to Enhance the Interconnected Experience* (June 15, 2022),

<https://corporate.homedepot.com/news/company/home-depot-upgrades-store-network-and-mobile-devices-enhance-interconnected-experience> [hereinafter *Example Image 1.9*].



Home Depot Mobile Application [hereinafter *Example Image 1.10*].

Battleground: Online and offline user experience (UX)

Home Depot took a guerrilla approach to the on-premise "user experience." While there was no curbside pickup at Home Depot before the pandemic at all, they were able to have a first solution ready [in a matter of hours](#).

[According to CIO Carrey](#), they started with a "manual process where a customer would arrive at the store after ordering online, inform an associate of their order number, and then the associate would get the order and bring it out." They even had handmade signs to direct people to the pickup location.

In Home Depot's next iteration, customers had to text or call when they arrived at the store. Eventually, they transitioned to a process [fully embedded in their app using geofencing](#) so that most of the communication and data exchange happened automatically. Home Depot was able to do this quickly by leveraging solutions like DataStax built on Apache Cassandra.

Radar Team, *Retail showdown: Safe curbside pickup at Home Depot versus Lowe's*, RADAR.COM (Jan. 21, 2021), <https://radar.com/blog/retail-showdown-curbside-pickup> [hereinafter Example Image 1.11].

Home Depot also used DataStax and Apache Cassandra to stand up curbside apps quickly. Siddiqui said Home Depot is a big open source shop.

Siddiqui explained:

Some of the tenants of that One Home Depot journey has been creating a set of common services, a common API, a common compute environment. There will be shared decisions between all our different channels. As we've developed these common services, we have been able to really reconcile what a customer sees online, what an associate gets to see in store and how to connect it all together.

[← Back](#)
[Purchase History](#)



Make Curbside Pickup even quicker

Share your Location so we can have your order ready when you arrive.

Share Location

[Not Now](#)



Home Depot Mobile Application [hereinafter *Example Image 1.6*].

Battleground: Online and offline user experience (UX)

Home Depot took a guerrilla approach to the on-premise "user experience." While there was no curbside pickup at Home Depot before the pandemic at all, they were able to have a first solution ready [in a matter of hours](#).

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As those services were available, our mobile application, and our first phones, which are in our associates use in the stores. We did not offer by curbside pickup before all of this happened, but we were able to in a very agile manner, build a solution. The first solution was really in a matter of few hours.

And then with the rapid testing in two weeks, majority of our US stores implemented curbside pickup. And the first one, customers are manually checked in by a Greeter, and there was manual release of the order by the Runners. In the next iteration, customers could text us or call when they were in the parking lot. And associates had an app guiding through the order release using the first one mobile devices. Then we embedded the application of that into our app and brought geo-fencing in, automatically we can communicate to a customer in the parking lot, what car they are in, and our associate knows and can deliver the order.

Larru Dignan, *How Home Depot navigated a demand boom during COVID-19*, ZDNET.COM (Nov. 3, 2020), <https://www.zdnet.com/article/how-home-depot-navigated-a-demand-boom-during-covid-19/> [hereinafter Example Image 1.12].

~~36.~~ Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction ~~to establish~~ a plurality of perimeters defining ~~respective~~ geographic areas, including as demonstrated in *Example Images 1.1-1.12*, *supra* at paragraph ~~35~~.

37. Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction ~~to maintain~~ at least one ~~record indicating content delivery reservations associating each of a plurality of sponsors with specific~~ registered application

Home Depot also used DataStax and Apache Cassandra to stand up curbside apps quickly. Siddiqui said Home Depot is a big open source shop.

Siddiqui explained:

Some of the tenants of that One Home Depot journey has been creating a set of common services, a common API, a common compute environment. There will be shared decisions between all our different channels. As we've developed these common services, we have been able to really reconcile what a customer sees online, what an associate gets to see in store and how to connect it all together.

As those services were available, our mobile application, and our first phones, which are in our associates use in the stores. We did not offer by curbside pickup before all of this happened, but we were able to in a very agile manner, build a solution. The first solution was really in a matter of few hours.

And then with the rapid testing in two weeks, majority of our US stores implemented curbside pickup. And the first one, customers are manually checked in by a Greeter, and there was manual release of the order by the Runners. In the next iteration, customers could text us or call when they were in the parking lot. And associates had an app guiding through the order release using the first one mobile devices. Then we embedded the application of that into our app and brought geo-fencing in, automatically we can communicate to a customer in the parking lot, what car they are in, and our associate knows and can deliver the order.

Larru Dignan, *How Home Depot navigated a demand boom during COVID-19*, ZDNET.COM (Nov. 3, 2020), <https://www.zdnet.com/article/how-home-depot-navigated-a-demand-boom-during-covid-19/> [hereinafter *Example Image 1.8*].

38. Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of

instructions comprising at least one instruction for establishing a plurality of perimeters defining a plurality of geographic areas, including as demonstrated in Example Images 1.1-1.8, supra at paragraph 37.

39. Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction for receiving, from at least a particular one of the registered application programs, a request to obtain an interest in a designated geographic area, including as demonstrated in Example Images 1.1-1.8, supra at paragraph 37.

40. Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction for determining if the interest in the designated geographic area is to be provided to at least the particular one of the registered application programs, including as demonstrated in Example Images 1.1-1.8, supra at paragraph 37.

41. Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction for reserving content delivery to at least the particular one of the registered application programs to being from one or more sponsors after it is determined that an object of interest has entered the designated geographic area in response to determining that the interest in the designated geographic area is to be provided to at least the particular one of the registered application programs, including as demonstrated in Example Images 1.1-1.8, supra at paragraph 37.

program types and at least one of the plurality of geographic areas, including as demonstrated in *Example Images 1.1-1.12, supra* at paragraph 35.

~~38.~~ Defendants provide products comprising a non-transitory computer readable medium tangibly embodying ~~programs~~ of computer executable instructions, the program of instructions comprising at least one instruction to ~~receive, from a sponsor, a request to obtain~~ an interest in ~~a selected one of the plurality of geographic areas,~~ including as demonstrated in *Example Images 1.1-1.12, supra* at paragraph 35.

~~39.~~ Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction to ~~provide the sponsor a response to the request,~~ including as demonstrated in *Example Images 1.1-1.12, supra* at paragraph 35.

~~40.~~ Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction to ~~store a record of the interest in the selected one of the plurality of geographic areas,~~ including as demonstrated in *Example Images 1.1-1.12, supra* at paragraph 35.

~~41.~~ Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction to ~~receive, from the sponsor, content to be delivered to application programs having target locations contained within the selected one of the plurality of geographic areas,~~ including as demonstrated in *Example Images 1.1-1.12, supra* at paragraph 35.

42. Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction for receiving, from the one or more sponsors, content to be delivered to at least one of the registered application programs in response to said reserving, including as demonstrated in Example Images 1.1-1.8, supra at paragraph 37.

43. Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction for providing at least a portion of the content received from the one or more sponsors to at least the particular one of the registered application programs after it is determined that the object of interest has entered the designated geographic area, including as demonstrated in Example Images 1.1-1.8, supra at paragraph 37.

44. By engaging in the conduct described herein, Defendants have injured Plaintiff and are thus liable for infringement of one or more claims of the '247 Patent, pursuant to 35 U.S.C. § 271. Defendants have committed these acts of infringement without license or authorization. To the extent any element is not found literally, upon information and belief, it is satisfied by the doctrine of equivalents.

45. As a result of Defendants' infringement of one or more claims of the '247 Patent, Plaintiff has suffered monetary damages and is entitled to a monetary judgment in an amount adequate to compensate for Defendants' past infringement, together with interests and costs. In addition, Defendants' infringement is causing irreparable harm and monetary damage to Plaintiff and will continue to do so unless and until Defendants are enjoined by the Court.

COUNT II: CLAIM FOR PATENT INFRINGEMENT OF THE '625 PATENT

46. Plaintiff repeats and realleges the allegations in paragraphs 1-45 as if fully set forth herein. Defendants have infringed, contributorily infringed, and/or induced infringement of one or more claims of the '625 Patent by making, using, selling, offering for sale, or importing into the United States, or by intending that others make, use, import into, offer for sale, or sell in the United States, products and/or methods covered by one or more claims of the '625 Patent including, but not limited to the Home Depot mobile application and mobile devices used by Defendants' employees (collectively, the "Accused Products").

47. Upon information and belief, Defendants' products and services that infringe one or more claims of the '625 Patent include at least the Home Depot mobile application and infrastructure (including Store Mode and Curbside Pickup features) and mobile devices used by Defendants' employees (including the hdPhone operating system and device). The products listed are exemplary, and Plaintiff will be able to provide a more comprehensive list after discovery. Upon information and belief, Defendants also infringe one or more claims of the '625 Patent through their use of geofencing or location information in their advertising or content delivery efforts or their own applications they develop.

48. For example, upon information and belief, one or more of the Accused Products infringe at least claim 20 of the '625 Patent. Defendants make, use, sell, offer for sale, import, export, supply, or distribute within the United States one or more of the Accused Products and thus directly infringe the '625 patent.

49. Defendants indirectly infringe one or more claims of the '625 Patent as provided by 35 U.S.C. § 271(b) by inducing infringement by others, such as manufacturers, resellers, and end-user customers in this District and throughout the United States. For example, direct

infringement is the result of activities performed by manufacturers, resellers, or operators/carriers of mobile devices which use the Accused Products, who, upon information and belief, perform each step of the claimed invention as directed by Defendants. Upon information and belief, Defendants' customers, including in this District, also use the claimed invention when they use Defendants accused products. Defendants received actual notice of the '625 Patent at least as early as August 22, 2024 when Plaintiff filed the original complaint in Case No. 2:24-cv-00694. Home Depot then became aware of the '625 Patent and did not meaningfully alter its conduct, and upon information and belief, Home Depot did not take steps to ensure its conduct was not infringing. Instead, Home Depot continued infringement, and at that point, it was deliberate and intentional. Upon information and belief, including belief created by actions taken by Home Depot in the pending case against Home Depot by Plaintiff, Home Depot has stuck its head under the sand and not even investigated whether its use of geofencing infringes the patent at issue. Home Depot has therefore willfully infringed the '625 patent. Enhanced damages are warranted based on Home Depot's willful, deliberate, and consciously wrongful infringement.

50. Defendants contributorily infringe one or more claims of the '625 Patent as provided by 35 U.S.C. § 271(c) by contributing to the infringement by others, such as manufacturers, resellers, and end-user customers in this District and throughout the United States.

51. Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction for registering an application program for having content associated with one or more sponsors delivered to one or more application program instances after it is determined that an object of interest has one of entered and exited a designated

geographic area thereby designating the application program as a registered application program, including as demonstrated in *Example Images 1.1-1.8, supra* at paragraph 37.

52. Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction for receiving, from the registered application program, a request to obtain an interest in the designated geographic area for having content associated with the one or more sponsors delivered to the one or more application program instances after it is determined that the object of interest has entered the designated geographic area, including as demonstrated in *Example Images 1.1-1.8, supra* at paragraph 37.

53. Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction for storing a reservation associating the designated geographic area with the registered application program after it is determined that the interest in the designated geographic area is to be granted to the registered application program, including as demonstrated in *Example Images 1.1-1.8, supra* at paragraph 37.

54. Defendants provide products comprising a non-transitory computer readable medium tangibly embodying programs of computer executable instructions, the program of instructions comprising at least one instruction for restricting content delivery to the one or more application program instances to being content associated with at least one of the one or more sponsors after it is determined that the object of interest has entered the designated geographic area, including as demonstrated in *Example Images 1.1-1.8, supra* at paragraph 37.

~~42.~~ Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction ~~to receive a request from a~~ registered application program ~~for content to be used within~~ the registered application program, including as demonstrated in *Example Images 1.1-1.12, supra* at paragraph ~~35~~.

~~43.~~ Defendants provide products comprising a non-transitory computer readable medium tangibly embodying ~~a program~~ of computer executable instructions, the program of instructions comprising at least one instruction to ~~select~~ content associated with at least one of the ~~plurality of sponsors to be delivered to the registered application program of a specific type, in~~ accordance with ~~a content delivery reservation associating the at least one sponsor with a~~ geographic ~~area and a registered application program type,~~ including as demonstrated in *Example Images 1.1-1.12, supra* at paragraph ~~35~~.

~~44.~~ Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction ~~to provide the selected~~ content to the ~~registered~~ application ~~program,~~ including as demonstrated in *Example Images 1.1-1.12, supra* at paragraph ~~39~~.

~~45.~~ By engaging in the conduct described herein, Defendants have injured Plaintiff and are thus liable for infringement of one or more claims of the '~~296~~ Patent, pursuant to 35 U.S.C. § 271. Defendants have committed these acts of infringement without license or authorization. To the extent any element is not found literally, upon information and belief, it is satisfied by the doctrine of equivalents.

55. Defendants provide products comprising a non-transitory computer readable medium tangibly embodying a program of computer executable instructions, the program of instructions comprising at least one instruction for causing registered application program content associated with at least one of the one or more sponsors to be provided for use by the one or more application program instances after it is determined that the object of interest has entered the designated geographic area, including as demonstrated in *Example Images 1.1-1.8, supra* at paragraph 37.

56. By engaging in the conduct described herein, Defendants have injured Plaintiff and are thus liable for infringement of one or more claims of the '625 Patent, pursuant to 35 U.S.C. § 271. Defendants have committed these acts of infringement without license or authorization. To the extent any element is not found literally, upon information and belief, it is satisfied by the doctrine of equivalents.

57. As a result of Defendants' infringement of one or more claims of the '625 Patent, Plaintiff has suffered monetary damages and is entitled to a monetary judgment in an amount adequate to compensate for Defendants' past infringement, together with interests and costs. In addition, Defendants' infringement is causing irreparable harm and monetary damage to Plaintiff and will continue to do so unless and until Defendants are enjoined by the Court.

DEMAND FOR JURY TRIAL

58. Plaintiff hereby demands a trial by jury on all claims so triable.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests that this Court enter judgment in its favor and grant the following relief:

~~46.~~ As a result of Defendants' infringement of one or more claims of the '~~296~~ Patent, Plaintiff has suffered monetary damages and is entitled to a monetary judgment in an amount adequate to compensate for Defendants' past infringement, together with interests and costs. In addition, Defendants' infringement is causing irreparable harm and monetary damage to Plaintiff and will continue to do so unless and until Defendants are enjoined by the Court.

DEMAND FOR JURY TRIAL

~~47.~~ Plaintiff hereby demands a trial by jury on all claims so triable.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests that this Court enter judgment in its favor and grant the following relief:

- A. Adjudge that Defendants infringe one or more claims of the Asserted ~~Patent~~;
- B. Adjudge that the claims of the Asserted ~~Patent~~ are valid and enforceable;
- ~~C.~~ Award Plaintiff damages in an amount adequate to compensate Plaintiff for Defendants' infringement of one or more claims of the Asserted ~~Patent~~, but in no event less than a reasonable royalty under 35 U.S.C. § 284;
- ~~D.~~ Award enhanced damages pursuant to 35 U.S.C. § 284;
- ~~E.~~ Award Plaintiff pre-judgment and post-judgment interest to the full extent allowed under the law, as well as Plaintiff's costs;
- ~~F.~~ Enter an order finding that this is an exceptional case and awarding Plaintiff its reasonable attorneys' fees pursuant to 35 U.S.C. § 285;
- ~~G.~~ Enter a permanent injunction against all Defendants' products found to infringe the Asserted ~~Patent~~;

- ⦿ Award, in lieu of an injunction, a compulsory forward royalty;
- ⦿ Order an accounting of damages; and
- ⦿ Award such other relief, including equitable relief, as the Court may deem appropriate and just under the circumstances.

- A. Adjudge that Defendants infringe one or more claims of the Asserted Patents;
- B. Adjudge that Defendants willfully infringed one or more claims of the Asserted Patents;
- C. Adjudge that the claims of the Asserted Patents are valid and enforceable;
- D. Award Plaintiff damages in an amount adequate to compensate Plaintiff for Defendants' infringement of one or more claims of the Asserted Patents, but in no event less than a reasonable royalty under 35 U.S.C. § 284;
- E. Award enhanced damages pursuant to 35 U.S.C. § 284;
- F. Award Plaintiff pre-judgment and post-judgment interest to the full extent allowed under the law, as well as Plaintiff's costs;
- G. Enter an order finding that this is an exceptional case and awarding Plaintiff its reasonable attorneys' fees pursuant to 35 U.S.C. § 285;
- H. Enter a permanent injunction against all Defendants' products found to infringe the Asserted Patents;
- I. Award, in lieu of an injunction, a compulsory forward royalty;
- J. Order an accounting of damages; and
- K. Award such other relief, including equitable relief, as the Court may deem appropriate and just under the circumstances.

DATED: ~~August 22, 2024~~

Respectfully submitted,

/s/ Rex A. Mann

Thomas M. Melsheimer

Texas Bar No. 13922550

tmelsheimer@winston.com

M. Brett Johnson

Texas Bar No. 00790975

mbjohnson@winston.com

Rex A. Mann

Texas Bar No. 24075509

rmann@winston.com

Chad B. Walker

Texas Bar No. 24056484

cbwalker@winston.com

WINSTON & STRAWN LLP

2121 North Pearl Street, Suite 900

Dallas, TX 75201

Telephone: (214) 453-6500

J. Tyler Boyce

Texas Bar No. 24127214

tboyce@winston.com

WINSTON & STRAWN LLP

800 Capitol Street, Suite 2400

Houston, TX 77002

Telephone: (713) 651-2600

ATTORNEYS FOR PLAINTIFF

DATED: February 3, 2025

Respectfully submitted,

/s/ Rex A. Mann

Thomas M. Melsheimer

Texas Bar No. 13922550

tmelsheimer@winston.com

M. Brett Johnson

Texas Bar No. 00790975

mbjohnson@winston.com

Rex A. Mann

Texas Bar No. 24075509

rmann@winston.com

Chad B. Walker

Texas Bar No. 24056484

cbwalker@winston.com

WINSTON & STRAWN LLP

2121 North Pearl Street, Suite 900

Dallas, TX 75201

Telephone: (214) 453-6500

J. Tyler Boyce

Texas Bar No. 24127214

tboyce@winston.com

WINSTON & STRAWN LLP

800 Capitol Street, Suite 2400

Houston, TX 77002

Telephone: (713) 651-2600

ATTORNEYS FOR PLAINTIFF

EXHIBIT E

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

H2 INTELLECT LLC,

Plaintiff,

vs.

THE HOME DEPOT, INC.,
HOME DEPOT U.S.A., INC., AND
HOME DEPOT PRODUCT AUTHORITY, LLC,

Defendants.

Civil Action No. 2:24-cv-00694-JRG-RSP

JURY TRIAL DEMANDED

**HOME DEPOT’S INVALIDITY CONTENTIONS, SUBJECT MATTER ELIGIBILITY
CONTENTIONS, AND ACCOMPANYING DOCUMENT PRODUCTION**

Pursuant to the Court’s December 10, 2024 Amended Docket Control Order [Doc. 23], Defendants The Home Depot, Inc.¹, Home Depot U.S.A., Inc., and Home Depot Product Authority, LLC and (collectively, “Home Depot” or “Defendants”) hereby provide their Initial Invalidity Contentions, Subject Matter Eligibility Contentions, and accompanying document production concerning the claims that Plaintiff, H2 Intellect LLC (“H2” or “Plaintiff”), identified in its disclosure of Asserted Claims and Infringement Contentions dated November 1, 2024 (Plaintiff’s Disclosure of Asserted Claims and Infringement Contentions and Accompanying Documents Production), as follows: U.S. Patent No. 8,433,296 (the “’296 patent”) asserted claims 1–15 (the “Asserted Claims”).²

¹ The Home Depot, Inc. is an improperly named holding company, which does not manufacture, use, offer for sale, or sell any product or service accused of infringement in this case or operate Home Depot’s online presence or retail stores, and should accordingly be dismissed from this case.

² H2 is no longer asserting U.S. Patent No. 11,948,171 [Doc. 26].

In their Invalidity Contentions, Defendants: (i) identify each currently known item of prior art that anticipates, renders obvious or otherwise invalidates each Asserted Claim under AIA 35 U.S.C. § 102 and/or § 103; (ii) specify whether each such item of prior art anticipates and/or renders obvious the applicable Asserted Claim; (iii) submit charts for illustrative prior art references identifying where each limitation of each Asserted Claim is disclosed or rendered obvious by the prior art; (iv) identify combinations and illustrative reasons to combine prior art references where a combination of prior art references makes an Asserted Claim obvious, (v) identify grounds for invalidating Asserted Claims based on indefiniteness, enablement, and/or written description under 35 U.S.C. § 112; and (vi) identify the grounds for invalidating the Asserted Claims under 35 U.S.C. § 101 for failure to claim patent eligible subject matter.

I. RESERVATION OF RIGHTS

Defendants reserve their right to amend, modify, and/or supplement this disclosure and their Invalidity Contentions. Specifically, Defendants reserve the right to amend based upon the Court's claim construction. Defendants additionally reserve the right to amend their Contentions if H2 later provides any information that it failed to provide in its Infringement Contentions and/or its accompanying document production, or if H2 amends or alters its Infringement Contentions in any way. Further, these Invalidity Contentions are based on information obtained by Defendants to date. Discovery in this case is on-going. In particular, fact discovery is not complete, the Asserted Claims have not been construed, and expert discovery has not begun. Defendants intend to seek discovery from H2 and third parties regarding public use and/or the on-sale bar under AIA 35 U.S.C. § 102, additional prior art under AIA 35 U.S.C. §§ 102 and 103, applicant's failure to comply with 35 U.S.C. §§ 112 and 101, and/or other grounds of invalidity and/or unenforceability. Based on discovery, Defendants may identify additional prior art and invalidity arguments, and the Court's construction of one or more terms from any

Asserted Claim may require that Defendants supplement or amend these Contentions.

Accordingly, Defendants reserve the right to revise and/or supplement these Contentions as this case proceeds. Moreover, Defendants reserve the right to supplement and/or amend these Contentions based on any findings as to the priority date of the Asserted Claims, and/or positions that H2 or its expert witnesses may take concerning claim interpretation, infringement, and/or invalidity issues. In addition, none of these Contentions constitutes an admission concerning the proper construction of the claims.

Prior art not included in this disclosure, whether known or unknown to Defendants, may become relevant. In particular, Defendants are currently unaware of the extent, if any, to which H2 will contend that limitations of the Asserted Claims are not disclosed in the prior art that Defendants identified or will contend that any of the identified references do not qualify as prior art under AIA 35 U.S.C. § 102. The identification of any patents and/or patent publications as prior art shall be deemed to refer to the application that was submitted for the same and to include identification of any foreign counterpart patents and applications as well as international applications. To the extent that such an issue arises, Defendants reserve the right to identify additional teachings in the same references or in other references that anticipate or would have rendered the addition of the allegedly missing limitation to the device or method obvious.

Defendants' claim charts submitted as part of these Initial Invalidity Contentions cite to particular teachings and disclosures of the prior art as applied to features of the Asserted Claims. Persons having ordinary skill in the art, however, may view an item of prior art generally in the context of other publications, literature, products, and understanding. Accordingly, the cited portions are only examples, and Defendants reserve the right to rely on uncited portions of the prior art references and on other publications and expert testimony as aids in understanding and

interpreting the cited portions, as providing context thereto, and as additional evidence that a claim limitation is known or disclosed. Where Defendants cite to a particular figure in a reference, the citation should be understood to encompass the caption and description of the figure and any text in the reference relating to the figure. Similarly, where Defendants cite to particular text referring to a figure, the citation should be understood to include the figure and caption as well. Where Defendants cite to portions of a reference with respect to an element of a dependent claim, these citations should be understood to include the relevant citations provided in the claim(s) from which that dependent claim depends, and vice versa. Defendants further reserve the right to rely on uncited portions of the prior art references, other publications, and testimony to establish bases for combinations of certain cited references that render the Asserted Claims obvious. Further, for any combination, Defendants reserve the right to rely additionally on information generally known to those skilled in the art and/or common sense.

The references discussed in the claim charts may disclose elements of the Asserted Claims explicitly and/or inherently, and/or they may be relied upon to show the state of the art in the relevant time frame. The suggested obviousness combinations are sometimes provided in the alternative to Defendants' anticipation contentions and are not meant to suggest that any reference included in the combinations is not by itself anticipatory. Furthermore, nothing stated herein shall be treated as an admission or suggestion that Defendants' Accused Instrumentalities meet any limitation of any Asserted Claim. Defendants deny that they infringe any and Asserted Claims.

II. THE IDENTITY OF EACH ITEM OF PRIOR ART THAT ALLEGEDLY ANTICIPATES EACH ASSERTED CLAIM OR RENDERS IT OBVIOUS

Pursuant to Local Patent Rule 3-3(a), Defendants identify each item of prior art that allegedly anticipates each Asserted Claim or renders it obvious. The identification of any patents

and/or patent publications as prior art also refers to the application submitted for the same and includes identification of any prior-issued patents or prior publications in the family, foreign counterpart patents and applications, and any international applications. Concurrently with the service of these Invalidity Contentions, Defendants are producing the prior art documents identified herein that have not previously been produced. Defendants also incorporate by reference all prior art known to Plaintiff and all prior art and invalidity contentions served by any defendant on the '296 patent or its children.

A. Table 1: Patent References for the '296 patent

No.	Number and Name	Country of Origin	Issue Date/Date of Publication	Filing Date	Earlier Priority Date
1.	2003/0008661 (Joyce)	US	01/09/2003	07/03/2001	07/03/2001
2.	2005/0159883 (Humphries)	US	07/21/2005	01/16/2004	01/16/2004
3.	2007/0083539 (Glorikian)	US	04/12/2007	09/01/2006	09/01/2006
4.	2009/0024476 (Baar)	US	01/22/2009	07/18/2008	07/18/2007
5.	7,259,694 (Myllymaki)	US	08/21/2007	02/26/2001	02/26/2001
6.	8,014,762 (Chmaytelli '762)	US	09/06/2011	03/31/2005	03/31/2005
7.	10,684,350 (Dupray)	US	06/16/2020	03/15/2013	03/15/2013
8.	11,463,860 (Maier)	US	10/04/2022	11/30/2020	11/30/2020
9.	2002/0161633 (Jacob '633)	US	10/31/2002	04/27/2001	04/27/2001
10.	2008/0186165 (Bertagna)	US	08/07/2008	01/31/2008	02/01/2007
11.	2009/0124241 (Krishnaswamy)	US	05/14/2009	11/11/2008	11/14/2007
12.	2009/0163227 (Collins '227)	US	06/25/2009	12/21/2007	12/21/2007
13.	2010/0138294 (Bussmann)	US	06/03/2010	12/03/2008	12/03/2008
14.	2017/0011424 (Abou-Rizk '424)	US	01/12/2017	09/19/2016	06/27/2007

No.	Number and Name	Country of Origin	Issue Date/Date of Publication	Filing Date	Earlier Priority Date
15.	7,814,106 (Guido '106)	US	10/12/2010	06/21/2006	06/22/2001
16.	8,019,532 (Sheha)	US	09/13/2011	03/07/2006	03/07/2005
17.	9,204,251 (Mendelson '251)	US	12/01/2015	05/22/2014	05/22/2014
18.	9,338,601 (Issa)	US	05/10/2016	11/12/2013	02/02/2009
19.	9,418,366 (Mayers)	US	08/16/2016	03/30/2007	03/30/2007
20.	8,315,456 (Hicks)	US	11/20/2012	04/10/2008	04/10/2008
21.	KR20010102668A (Cha Sang Gyun)	KR	11/16/2001	05/04/2000	05/04/2000
22.	KR20060119476A (Jung Kee Joong)	KR	11/24/2006	05/20/2005	05/20/2005
23.	KR20040021267A (Ha Jung Seok)	KR	03/10/2004	09/03/2002	09/03/2002
24.	KR20080019867A (Jeon Young Seo)	KR	03/05/2008	08/29/2006	08/29/2006
25.	2003/0208401 (Karsten)	US	11/06/2003	06/12/2001	06/12/2001
26.	2004/0176105 (Ashmore)	US	09/09/2004	03/11/2004	03/11/2004
27.	2004/0205048 (Pizzo)	US	10/14/2004	03/28/2003	03/28/2003
28.	2006/0116817 (Salmre)	US	06/01/2006	11/26/2004	11/26/2004
29.	2006/0223494 (Chmaytelli '494)	US	10/05/2006	03/31/2005	03/31/2005
30.	2006/0270421 (Phillips)	US	11/30/2006	05/27/2005	05/27/2005
31.	2007/0129888 (Rosenberg)	US	06/07/2007	06/28/2006	12/05/2005
32.	2008/0032666 (Hughes '666)	US	02/07/2008	08/07/2006	08/07/2006
33.	2008/0268876 (Gelfand)	US	10/30/2008	04/23/2008	04/24/2007
34.	2009/0089288 (Petersen)	US	04/02/2009	09/27/2007	09/27/2007
35.	2009/0157632 (Ryu)	US	06/18/2009	11/26/2008	11/26/2008
36.	2009/0210700 (Nomura)	US	08/20/2009	04/10/2008	04/10/2008
37.	6,782,369 (Carrott)	US	08/24/2004	12/30/1999	12/30/1999
38.	7,054,649 (Yamazaki)	US	05/30/2006	07/31/2003	07/31/2003
39.	7,089,264 (Guido '264)	US	08/08/2006	06/22/2001	06/22/2001

No.	Number and Name	Country of Origin	Issue Date/Date of Publication	Filing Date	Earlier Priority Date
40.	7,457,628 (Blumberg '628)	US	11/25/2008	08/20/2003	08/20/2003
41.	7,536,695 (Alam)	US	05/19/2009	03/28/2003	03/28/2003
42.	7,712,660 (Keohane)	US	05/11/2010	01/08/2009	08/04/2005
43.	8,219,115 (Nelissen)	US	07/10/2012	05/12/2009	05/12/2008
44.	2009/0197582 (Lewis)	US	08/06/2009	01/28/2009	02/01/2008
45.	2009/0275348 (Weinreich '348)	US	11/05/2009	05/01/2009	05/02/2008
46.	8,229,458 (Busch '458)	US	07/24/2012	03/16/2008	04/08/2007
47.	8,447,332 (Weinreich '332)	US	05/21/2013	05/01/2009	05/02/2008
48.	8,798,613 (MacNaughtan)	US	08/05/2014	09/17/2008	09/17/2007
49.	8,863,178 (Abou-Rizk '178)	US	10/14/2014	07/31/2013	06/27/2007
50.	8,510,773 (Abou-Rizk '773)	US	08/13/2013	06/27/2008	06/27/2007
51.	12,008,307 (Kirkpatrick '307)	US	06/11/2024	07/15/2020	11/12/2007
52.	2008/0235040 (Ratliff)	US	09/25/2008	03/23/2007	03/23/2007
53.	2010/0070606 (Shenfield)	US	03/18/2010	09/12/2008	09/12/2008
54.	8,826,145 (Kirkpatrick '145)	US	09/02/2014	11/11/2008	11/12/2007
55.	2008/133860 (Britt)	WO	11/06/2008	04/22/2008	04/23/2007
56.	2004/0252049 (Vantalon)	US	12/16/2004	07/18/2002	07/18/2001
57.	2009/0300017 (Tokusho)	US	12/03/2009	04/24/2009	04/24/2009
58.	2011/0173054 (Kutaragi)	US	07/14/2011	01/14/2011	04/07/2006
59.	2017/0013066 (Toprani)	US	01/12/2017	09/19/2016	06/30/2014
60.	2008/0098420 (Khivesara)	US	04/24/2008	12/20/2006	10/19/2006
61.	2006/0004631 (Roberts)	US	01/05/2006	09/10/2004	09/11/2003
62.	2010/0113065 (Narayan)	US	05/06/2010	11/04/2008	11/04/2008
63.	8,135,777 (Colligan)	US	03/13/2012	04/13/2009	12/23/2008
64.	8,983,488 (Sweeney)	US	03/17/2015	12/11/2008	12/11/2008

No.	Number and Name	Country of Origin	Issue Date/Date of Publication	Filing Date	Earlier Priority Date
65.	2008/0004952 (Koli)	US	01/03/2008	06/30/2006	06/30/2006
66.	2008/0004954 (Horvitz)	US	01/03/2008	06/30/2006	06/30/2006
67.	8,762,205 (Narayanaswami '205)	US	06/24/2014	01/17/2008	01/17/2008
68.	9,225,823 (Andreasson '823)	US	12/29/2015	08/31/2007	08/31/2007
69.	2003/0028621 (Furlong)	US	02/06/2003	05/13/2002	05/23/2001
70.	2007/0026871 (Wager '871)	US	02/01/2007	07/28/2006	07/28/2005
71.	2009/0061890 (Andreasson '890)	US	03/05/2009	08/31/2007	08/31/2007
72.	7,203,967 (Chmaytelli '967)	US	04/10/2007	09/10/2003	09/10/2003
73.	8,588,816 (Collins '816)	US	11/19/2013	12/21/2007	12/21/2007
74.	2006/0058037 (Kenyon)	US	03/16/2006	09/13/2004	09/13/2004
75.	2010/0120450 (Herz)	US	05/13/2010	11/13/2008	11/13/2008
76.	6,182,113 (Narayanaswami '113)	US	01/30/2001	09/16/1997	09/16/1997
77.	2006/0253453 (Chmaytelli '453)	US	11/09/2006	03/31/2005	03/31/2005
78.	2007/0001904 (Mendelson '904)	US	01/04/2007	05/08/2006	05/09/2005
79.	2004/0224702 (Chaskar)	US	11/11/2004	05/09/2003	05/09/2003
80.	2006/0149630 (Elliott)	US	07/06/2006	11/16/2005	11/16/2004
81.	6,628,938 (Rachabathuni)	US	09/30/2003	08/14/2000	08/14/2000
82.	2005/0114694 (Wager '694)	US	05/26/2005	08/12/2004	11/05/2003
83.	2005/0118999 (Zhu)	US	06/02/2005	12/02/2003	12/02/2003
84.	2006/0009198 (Kasai)	US	01/12/2006	06/09/2005	09/28/2004
85.	2004/0248551 (Rowitch)	US	12/09/2004	01/30/2004	01/31/2003
86.	60/946677 (Abou-Rizk '677)	US	06/27/2007	06/27/2007	06/27/2007

No.	Number and Name	Country of Origin	Issue Date/Date of Publication	Filing Date	Earlier Priority Date
87.	2004/0110515 (Blumberg '515)	US	6/10/2004	08/20/2003	08/20/2003
88.	61/050180 (Weinreich '180)	US	N/A	05/02/2008	05/02/2008
89.	2004/0253965A1 (Sato '965)	US	12/16/2004	10/16/2002	10/16/2001
90.	4,882,724 (Vela '724)	US	11/21/1989	10/14/1987	10/14/1987
91.	2005/0131837 (Sanctis)	US	06/16/2005	12/03/2004	12/15/2003
92.	2005/0215238 (Macaluso '238)	US	09/29/2005	03/24/2004	03/24/2004
93.	2006/0271281 (Ahn '281)	US	11/30/2006	05/20/2006	05/20/2005
94.	2007/0088852 (Levkovitz)	US	04/19/2007	01/24/2006	01/17/2006
95.	2007/0273558 (Smith '558)	US	11/29/2007	01/08/2007	04/21/2005
96.	2008/0140479 (Mello)	US	06/12/2008	10/23/2007	06/29/2006
97.	2008/0248815 (Busch '815)	US	10/09/2008	03/16/2008	04/08/2007
98.	2010/0063866 (Kinoshita '866)	US	03/11/2010	12/09/2008	09/09/2008
99.	5,420,606 (Begum '606)	US	05/30/1995	09/20/1993	09/20/1993
100.	6,177,880 (Begum '880)	US	01/23/2001	07/12/1993	06/16/1992
101.	8,504,073 (Svendsen)	US	08/06/2013	08/12/2008	08/12/2008

B. Table 2: Publication References for the '296 patent

No.	Title	Date of Publication	Author(s) and Publisher
1.	2008 Marks Continued Growth for In-Vehicle Navigation With NAVTEQ® Map Data	03/05/2009	WebWire
2.	Alcatel-Lucent Launches Location-Based Service	09/10/2008	Marin Perez

No.	Title	Date of Publication	Author(s) and Publisher
3.	Alcatel-Lucent Launches Next-Gen Location-Drive Services Platform	09/12/2008	GPS Daily
4.	Alcatel-Lucent's 5130 GMSP taps into location-based services revenue	09/11/2008	Michael Morisy
5.	Foursquare (Company)	No later than 05/15/2024	Wikipedia
6.	SXSW: Foursquare Scores Despite Its Flaw	03/18/2009	Jason Kincaid, TechCrunch.com
7.	Foursquare City Guide	No later than 09/22/2022	Wikipedia
8.	Location-Based Advertising The Key to Unlocking the Most Value in the Mobile Advertising and Location-Based Services Markets	No later than 12/31/2009	Lisa Peterson et al.
9.	GSM Celebrates Its 20th Anniversary	No later than 09/30/2007	Javier Gozálvez
10.	Compass Assisted GPS for LBS Applications	No later than 12/31/2006	Mark Amundson, Honeywell
11.	Context-Aware Historical Route – The Old Tampere	No later than 12/31/2003	Veikko Ikonen et al.
12.	Context-Aware Services for Mobile Users: Technology and User Experiences	No later than 12/31/2004	Juha Kolari et al.
13.	Experiences in using role-playing, computer game and physical action to enhance user involvement in design of future applications	No later than 10/31/2004	Veikko Ikonen
14.	Kontti – Context-aware Mobile Portal	No later than 07/31/2003	Juha Kolari
15.	Sharing Content and Experiences in Smart Environments	No later than 01/31/2010	Johan Plomp et al.
16.	In the Zone: Views through a context-aware mobile portal	09/08/2003	Juha Kolari et al.

No.	Title	Date of Publication	Author(s) and Publisher
17.	Making maps with NAVTEQ	01/22/2010	Microsoft
18.	MoCA: A Middleware for Developing Collaborative Applications for Mobile Users	No later than 10/31/2004	Vagner Sacramento, Markus Endler, Hana K. Rubinsztein, Luciana S. Lima, Kleider Gonçalves, Fernando N. Nascimento, Giulliano A. Bueno, IEEE DISTRIBUTED SYSTEMS ONLINE
19.	Canalys Navigation Forum 2007 Barcelona	09/15/2007	Mike Barrett
20.	Exercise 2: Exploring the Data Portal – NAVTEQ	No later than 12/31/2009	
21.	Nokia buys mapping service for \$8.1 billion	10/01/2007	James Niccolai
22.	NAVTEQ Overview	No later than 12/31/2008	Judson Green
23.	NAVTEQ Acquires Acuity Mobile	12/04/2010	MundoGEO
24.	NAVTEQ and XM Radio Introduce XM NavTraffic	04/07/2004	Mavromatic
25.	NAVTEQ Corporation	No later than 02/01/2019	Company-Histories.com
26.	NAVTEQ Corporation to offer NAVTEQ map data for use in Microsoft SQL Server 2008.	02/29/2008	Telecomworldwire
27.	NAVTEQ Part 1/3 - A Visit to NAVTEQ	11/03/2004	Dave Burrows
28.	NAVTEQ Part 2/3 - Mapping Ireland	11/03/2004	Dave Burrows
29.	NAVTEQ Part 3/3 - Road Data and Country Coverage	11/03/2004	Dave Burrows
30.	NAVTEQ Reports More Drivers are Updating Navigation System Maps	11/11/2008	WebWire

No.	Title	Date of Publication	Author(s) and Publisher
31.	NAVTEQ to Demonstrate Wireless Map Update Technology at ITS World Congress	11/07/2005	GISuser
32.	NAVTEQ to Showcase Leading Map-Enhanced Traffic Solutions at ITS World Congress	10/23/2008	GISuser
33.	Nokia to acquire digital-map provider Navteq	10/01/2007	Aude Lagorce, MarketWatch
34.	Where.com - What is WHERE?	12/09/08	WHERE
35.	Media And Games Invest ("MGI") Acquires US-Based Verve Wireless To Advance Its Market Position In Programmatic Mobile Location Display And Video Advertising	01/23/2020	Verve Wireless, Inc.
36.	Vervewireless.com - PRODUCTS & SERVICES: VERVE'S ADCEL	01/16/2008	Verve Wireless, Inc.
37.	The Mobile Marketing Solution That Drives Engagement and Results: Verve	No later than 12/31/2017	The Silicon Review
38.	Verve Integrates with Yext for Multilocation Marketing	10/17/2018	Destination CRM
39.	Vervewireless.com - Products & Services	05/19/2007	Verve Wireless, Inc.
40.	Vervewireless.com - Verve Publishing Platform	04/30/2006	Verve Wireless, Inc.
41.	Vervewireless.com – Homepage	04/27/2007	Verve Wireless, Inc.
42.	Vervewireless.com - PRODUCTS & SERVICES: OVERVIEW	01/16/2008	Verve Wireless, Inc.
43.	WaveMarket.com – Homepage	04/18/2009	WaveMarket, Inc.
44.	Xtify.com - API Overview	10/09/2008	Xtify
45.	Xtify.com - Documentation Home	09/27/2008	Xtify
46.	Xtify.com - FAQ	10/09/2008	Xtify
47.	IBM Buys Mobile Messenger Xtify To Connect Commerce And Ads	10/04/2013	David Kaplan

No.	Title	Date of Publication	Author(s) and Publisher
48.	Xtify.com - Xtify Overview	09/14/2008	Xtify
49.	Xtify.com – QuickStart	12/21/2008	Xtify
50.	Xtify.com - Supported Platforms	10/09/2008	Xtify
51.	Xtify.com - Xtify User Guide	10/09/2008	Xtify
52.	Xtify.com - Why Xtify?	11/09/2008	Xtify
53.	Geofencing for Fleet & Freight Management	No later than 12/31/2009	Fabrice Reclus et al.
54.	Integrating GPS Technology	05/22/2008	Kevin Haghighat
55.	Semantic Agents for Location-Aware Service Provisioning in Mobile Network	12/20/2005	Alisa Devlic
56.	Android 0.9	No later than 03/06/2024	BetaWiki
57.	Android 1.0 r1	No later than 08/16/2021	BetaWiki
58.	Android is now Open Source	10/21/2008	Android Developers Blog
59.	Android m3-rc20a	No later than 01/15/2022	BetaWiki
60.	Android m3-rc22a	No later than 01/15/2022	BetaWiki
61.	Android m3-rc37a	No later than 01/15/2022	BetaWiki
62.	Android m5-rc14	No later than 08/16/2021	BetaWiki
63.	Android m5-rc15	No later than 08/16/2021	BetaWiki
64.	Android SDK update: m5-rc15 released	03/03/2008	Jason Chen
65.	Android: the first week	11/16/2007	David McLaughlin
66.	Announcing a beta release of the Android SDK	08/18/2008	Dan Morrill
67.	Realizing Location-Based Push-Services on Mobile Devices	07/18/2002	Florian Fuchs

No.	Title	Date of Publication	Author(s) and Publisher
68.	HTC Dream	No later than 07/24/2017	Wikipedia
69.	Information Management and Exchange in the Nexus Platform	No later than 04/30/2004	Martin Bauer et al.
70.	It's official: Google announces open-source mobile phone OS, Android	11/05/2007	Jacqui Cheng
71.	JCP Home	09/24/2006	Java Community Process
72.	JSR-179 Location API for J2ME v1.0.1	02/23/2006	Nokia Corporation
73.	Location API 2.0 for J2ME – A new standard in location for Java-enabled mobile phones	01/31/2008	Sean J. Barbeau et al.
74.	Location Systems: An Introduction to the Technology Behind Location Awareness	06/02/2008	Anthony LaMarca et al.
75.	Location-Aware Information Delivery with ComMotion	09/25/2000	Natalia Marmasse et al.
76.	MiddleWhere: A Middleware for Location Awareness in Ubiquitous Computing Applications	No later than 12/31/2004	Anand Ranganathan et al.
77.	MWCo8: Hands-on with a working Google Android device	02/12/2008	ZDNet
78.	Nexus-A Platform for Context-Aware Applications	No later than 06/30/2004	Frank Durr et al.
79.	NexusScout: An advanced location-based application on a distributed, open mediation platform	No later than 12/31/2003	Daniela Nicklas et al.
80.	On a Location Model for Fine-Grained Geocast	No later than 12/31/2003	Frank Durr et al.
81.	Place-Its: Location-Based Reminders on Mobile Phones	03/23/2005	Timothy Sohn et al.
82.	Exploring the Location API for J2ME	No later than 01/31/2006	David Parsons

No.	Title	Date of Publication	Author(s) and Publisher
83.	Documentation for the X Window System Version 11 Release 6.9 and 7.0 (X11R6.9/X11R7.0)	12/21/2005	The X.Org Foundation
84.	X Window System Protocol, X Consortium Standard, X Version 11, Release 6.9/7.0	No later than 12/31/2004	Robert W. Scheier
85.	Oracle Manufacturing - API and Open Interfaces Manual Release 11i	No later than 02/28/2001	Oracle
86.	Oracle Cost Management - User's Guide Release 11i	No later than 01/31/2000	Oracle
87.	Multiple Organizations in Oracle Applications Release 11i	No later than 3/31/2002	Oracle
88.	Release Content Document - Release 12 Oracle Human Resources Management System	No later than 12/31/2006	Oracle
89.	Menayan 2008	08/21/2008	YieldBuild Blog
90.	AppLoop.com: Home	08/24/2008	apploop.com
91.	AppLoop.com: Advertisers	07/05/2008	apploop.com
92.	AppLoop.com: About	08/24/2008	apploop.com
93.	AppLoop.com: Blog	08/24/2008	apploop.com
94.	AppLoop.com: Developers	07/03/2008	apploop.com

Defendants further contend that there may be offers for sale and/or public uses of products that qualify as prior art under 35 U.S.C. §§ 102(a) and/or (b), including but not limited to the technology described in the prior art patents and publications identified herein. Details regarding such offers for sale and public uses may be found within the identified prior art and/or the possession of Plaintiff and/or third parties, their successors-in-interest, and their respective customers, from whom Defendants has not yet received discovery. Defendants reserve the right to present additional prior art or evidence of prior art located and to amend or supplement its

Invalidity Contentions to the extent that such discovery or investigation yields information forming the basis for such contentions.

Moreover, the '296 patent inventors made public disclosures and executed agreements that may qualify as prior disclosure or offers for sale under 35 U.S.C. § 102, such as, for example, the following: (1) a May 14, 2008 MapKick presentation to the Henderson Area Chamber of Commerce (H2-HD_000000001-H2-HD_000000004); and (2) and April 18, 2009 ChamberPlanet and Henderson Area Chamber of Commerce License and Service Agreement (H2-HD_000000048).

Further, to the extent the inventions identified in the patents, publications, systems, and other prior art to the '296 patent identified in these Invalidity Contentions were conceived by another and diligently reduced to practice before the alleged conception and reduction to practice of the Asserted Claims of the '296 patent by the named inventors of those patents, Defendants alleges that such prior art inventions invalidate the Plaintiff's '296 patent under 35 U.S.C. § 102(g).

In addition, Defendants do not have any specific disclosures under 35 U.S.C. § 102(f) at this time. Discovery is ongoing, however, and Defendants reserves the right to assert any of the preceding items of prior art under 35 U.S.C. § 102(f)

III. WHETHER EACH ITEM OF PRIOR ART ANTICIPATES EACH ASSERTED CLAIM OR RENDERS IT OBVIOUS

Pursuant to Local Patent Rule 3-3(b), Defendants disclose the prior art known to Defendants that anticipates or renders obvious the Asserted Claims under 35 U.S.C. § 102 and/or 103. Although Defendants have identified at least one disclosure of a limitation for each prior art reference, each and every disclosure of the same limitation in the same reference is not necessarily identified. To focus the issues, Defendants cite only representative portions of an

identified reference in Exhibits 296.A through 296.M, even where a reference may contain additional support for a particular claim limitation.

Further, some or all of the systems identified below or identified in the prior art publications and patents will be the subject of continuing investigation and discovery, including ongoing and currently uncompleted third-party discovery. Defendants reserve the right to supplement their contentions consistent with the Federal Rules and the Local Patent Rules in the event that additional information is discovered relating to these systems.

A. Anticipating References

Defendants identify the following reference(s) as anticipating one or more of the Asserted Claims of each of the '296 patent under 35 U.S.C. § 102. The below table of anticipating references is exemplary, and it does not constitute an admission that any reference anticipates only the listed claims.

Anticipating Prior Art	Invalid Claim(s)
US 2002/0161633 ("Jacob '633")	1-15
US 2008/0032666 ("Hughes '666")	1-15
US20060253453 ("Chmaytelli '453")	1-15
US 2009/0163227 ("Collins '227")	1-15
US 2009/0061890 ("Andreasson '890")	1-15
US 4,882,724 ("Vela '724")	1-15

To the extent any item of prior art cited above is deemed not to disclose, explicitly or inherently, any limitation of the Asserted Claim(s), Defendants reserve the right to argue that any difference between that prior art and the corresponding patent claim would have been either inherent to the art, or obvious to one of ordinary skill in the art, even if they have not specifically

denoted that the art is to be combined with the knowledge of a person of ordinary skill in the art. Each prior art reference above describing or relating to a prior art system should be understood to discuss the system's capabilities generally and specific examples of specific installations of the particular system. To the extent the prior art references describe various implementations of the same underlying system, that underlying system is a single reference under 35 U.S.C. §§ 102(a) and/or 102(b). The prior art references are evidence of the capabilities of the prior art system, and each chart provided for a prior art system should be understood to incorporate by reference all printed publications describing or relating to that prior art system and all charts provided for those printed publications.

B. Obviousness Combinations and Rationale(s) to Combine

In addition to the anticipatory references described in these Invalidity Contentions, each prior art reference identified above and described in the charts attached as Exhibits 296.A through 296.M, either alone or in combination with other prior art, also renders the Asserted Claims invalid as obvious under 35 U.S.C. § 103 as described in those Exhibits. Each identified prior art reference may be combined with (i) information known to persons skilled in the art at the time of the alleged inventions of the '296 patent or (ii) any of the other anticipatory or other prior art references identified in these contentions or the accompanying charts. In addition, Defendants incorporate by reference each and every prior art reference of record in the prosecution histories of the '296 patent, counterpart patents, and related patent applications, as well as all statements made by the applicant in the prosecution histories of the '296 patent, counterpart patents, and related patent applications, including any discussion of prior art or conventional features in any of the specifications of the '296 patent, counterpart patents, and related patent applications.

Defendants incorporate by reference the statements and reasoning by the U.S. Patent and Trademark Office during prosecution of the '296 patent and any counterpart patents or applications, and any parent or child patents or applications, as to why it would have been obvious to modify or combine prior art references to achieve the limitations of the Asserted Claims or similar claims in any counterparts.

1. Exemplary Combinations

The following listing provides several exemplary combinations with respect to the Asserted Claims:

- Jacob '633 combined with the knowledge of a person of ordinary skill in the art.³
- Jacob '633 combined with the teachings of one or more of Hughes '666, Vela '724, Collins '227, Chmaytelli '453, Andreasson '890, Macaluso '238, Kinoshita '866, Smith '558, Sato '965, Ahn '281, Begum '880, Begum '606, Levkovitz '852, Sanctis '837, Bussmann '294, Mello '479, Busch '815, Svendsen '073, Xtify, Menayan 2008, and/or AppLoop.
- Hughes '666 combined with the knowledge of a person of ordinary skill in the art.
- Hughes '666 combined with the teachings of one or more of Jacob '633, Vela '724, Collins '227, Chmaytelli '453, Andreasson '890, Macaluso '238, Kinoshita '866, Smith '558, Sato '965, Ahn '281, Begum '880, Begum '606, Levkovitz '852, Sanctis '837, Bussmann '294, Mello '479, Busch '815, Svendsen '073, Xtify, Menayan 2008, and/or AppLoop.
- Chmaytelli '453 combined with the knowledge of a person of ordinary skill in the art.
- Chmaytelli '453 combined with the teachings of one or more of Jacob '633, Hughes '666, Vela '724, Collins '227, Andreasson '890, Macaluso '238, Kinoshita '866, Smith '558, Sato '965, Ahn '281, Begum '880, Begum '606, Levkovitz '852, Sanctis '837, Bussmann '294, Mello '479, Busch '815, Svendsen '073, Xtify, Menayan 2008, and/or AppLoop.
- Collins '227 combined with the knowledge of a person of ordinary skill in the art.

³ The knowledge of ordinary skill in the art may be corroborated with any background references listed in this cover pleading even if they are not specifically cited in any claim chart.

- Collins '227 combined with the teachings of one or more of Jacob '633, Hughes '666, Vela '724, Chmaytelli '453, Andreasson '890, Macaluso '238, Kinoshita '866, Smith '558, Sato '965, Ahn '281, Begum '880, Begum '606, Levkovitz '852, Sanctis '837, Bussmann '294, Mello '479, Busch '815, Svendsen '073, Xtify, Menayan 2008, and/or AppLoop.
- Andreasson '890 combined with the knowledge of a person of ordinary skill in the art.
- Andreasson '890 combined with the teachings of one or more of Jacob '633, Hughes '666, Vela '724, Collins '227, Chmaytelli '453, Macaluso '238, Kinoshita '866, Smith '558, Sato '965, Ahn '281, Begum '880, Begum '606, Levkovitz '852, Sanctis '837, Bussmann '294, Mello '479, Busch '815, Svendsen '073, Xtify, Menayan 2008, and/or AppLoop.
- Vela '724 combined with the knowledge of a person of ordinary skill in the art.
- Vela '724 combined with the teachings of one or more of Jacob '633, Hughes '666, Collins '227, Chmaytelli '453, Andreasson '890, Macaluso '238, Kinoshita '866, Smith '558, Sato '965, Ahn '281, Begum '880, Begum '606, Levkovitz '852, Sanctis '837, Bussmann '294, Mello '479, Busch '815, Svendsen '073, Xtify, Menayan 2008, and/or AppLoop.

2. Motivations to Combine

The suggested obviousness combinations discussed herein are not to be construed to suggest that any reference included in the combinations is not anticipatory. Further, to the extent that Plaintiff contends that any of the anticipatory prior art fails to disclose one or more limitations of the '296 patent, Defendants reserve the right to identify other prior art references that, when combined with the anticipatory prior art, would render the claims obvious despite an allegedly missing limitation. Defendants will further specify the motivations to combine the prior art, including through reliance on expert testimony, at the appropriate later stage of this lawsuit.

The decision in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), held that patents that are based on new combinations of elements or components already known in a technical field may be found to have been obvious. The Supreme Court rejected a rigid application of the “teaching, suggestion, or motivation [to combine]” test. *Id.* at 415, 419. “In determining whether

the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim.” *Id.* at 419. “Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 420. The Supreme Court emphasized the principle that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. A key inquiry is whether the “improvement is more than the predictable use of prior art elements according to their established function.” *Id.* at 417.

The Court further held that “in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 420. It is sufficient that a combination of elements was “obvious to try” — “When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.” *Id.* at 421. “In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.” *Id.* Finally, the Supreme Court recognized that “[g]ranting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility.” *Id.* at 419.

The rationale to combine or modify prior art references is significantly stronger when the references seek to solve the same problem, come from the same field, and correspond well together. *See In re Inland Steel Co.*, 265 F.3d 1354, 1362 (Fed. Cir. 2001) (allowing two

references to be combined as invalidating art under similar circumstances where the art “focus[ed] on the same problem . . . c[a]me from the same field of art [and] . . . the identified problem found in the two references correspond[ed] well”).

All of the following rationales recognized in *KSR* support a finding of obviousness with respect to each of the obviousness combinations disclosed herein: (1) combining prior art elements according to known methods to yield predictable results; (2) simple substitution of one known element for another to obtain predictable results; (3) use of a known technique to improve similar devices, methods, or products in the same way; (4) applying a known technique to a known device, method, or product ready for improvement to yield predictable results; (5) “obvious to try,” that is, choosing from a finite number of identified, predictable solutions with a reasonable expectation of success; (6) known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and (7) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. Certain of these rationales are discussed more specifically below. The fact that other rationales are not discussed more specifically should not be interpreted as an admission or concession that the other rationales do not apply.

Defendants further contend that the prior art identified in these Preliminary Invalidity Contentions is evidence of simultaneous or near-simultaneous independent invention by others of the alleged invention as recited in one or more of the ’296 patent. Defendants reserve their rights to rely on the simultaneous or near-simultaneous independent invention by others as further evidence of the obviousness of the ’296 patent.

One of skill in the art would find the combination of the charted references obvious to try, due at least to the similarity of the technical teachings of the art, as shown, for example, by the overlapping U.S. classes of the '296 patent and numerous of the cited prior art (*e.g.*, Jacob '633, Cover (705/14); Collins, Cover (455/456); Andreasson '890, Cover (455/456); Macaluso '238, Cover (455/414)). As another example, one of skill in the art would find that the teachings could be predictably interchanged by, for example, simple substitution, at least because of the predictability of the art and the known interchangeability of the various elements (*e.g.*, '296 Patent, 3:23-50 ("System 100 can include a network, for example Internet . . . other Suitable communication infrastructure . . . portable computer 179, which may include . . . any of various general or dedicated purpose computers that can be carried or transported . . . a mobile phone may also be a general purpose computing device, a radio, a television, and a navigation system"), 11:40-48 ("For example, the mobile device can forward information associated with a target location to the content delivery platform, or the content delivery server can obtain location information from a third party application or device, from a home location register (HLR), from a visiting location register (VLR), from raw, differential, processed or semi-processed GPS data, from power signals used in code division multiple access (CDMA) or other wireless communications systems, or otherwise."); Jacob '633, ¶37 ("In a preferred embodiment, the user communications unit derives its location information from an integral global positioning receiver that receives signals from GPS satellites and conventionally calculates the position coordinates . . . Other location techniques may alternatively be employed, for example, the use of cellular radiotelephone base site location information."); Huges, ¶43 ("Location of the mobile devices 206 can be determined in any manner that allows location information to be provided to the alert system 202."); Chmaytelli '453, ¶7 ("In current wireless server-client systems, information can

be transmitted to the wireless devices, such as a cellular telephone, by short messaging service ("SMS"), or other over-the-air methods known in the art."); Collins '227, ¶73 ("The location routine 96 may be consistent with the location information 88 and may be any known or future known satellite-based, terrestrial-based or hybrid location determination routine."); Andreasson '890, ¶39 ("Any portable electronic device capable of operating in accordance with some embodiments of the present invention may be used without departing from the scope of the present invention."); Vela '724, 40:51-56 ("In the preferred embodiment disclosed herein, the various signals are generated and transmitted as light signals. It will be evident to those skilled in the art, however, that radio frequency (rf) generation and transmission techniques may be used in lieu thereof in accord with certain aspects of the invention.")

As another example, one of skill in the art would be motivated to combine the references, and would have a reasonable expectation of success in combining the charted references, at least because the references use known variations of existing technologies, including known wireless communication and location techniques, telecommunication techniques and equipment, and global positioning systems and techniques, to solve routine and well understood problems (including communicating the remote location of a wireless devices and updating that location in reference to another point of interest) in predictable ways. For example, each of the references, Jacob '633, Hughes '666, Chmaytelli '453, Collins '227, Andreasson '890, and Vela '724 (and others) are directed to the use of mobile devices and locating those devices for advertising and commercial use (*e.g.*, Jacob '633, ¶16; Huges, ¶¶8-12, 83; Chmaytelli '453, ¶10; Collins '227, ¶10; Andreasson '890, ¶3-4, 44; Vela '724, 2:15-46).

In sum, each limitation of each claim of the '296 patent was well-known to those of ordinary skill in the art at the time. At best, the elements recited in the '296 patent are mere

combinations and modifications of these well-known elements. A person of ordinary skill in the art would be able, and motivated, to improve the existing technology in the same or similar manner by combining or modifying the individual elements that were already known in the art to yield predictable results.

IV. A CHART IDENTIFYING WHERE SPECIFICALLY IN EACH ALLEGED ITEM OF PRIOR ART EACH ELEMENT OF EACH ASSERTED CLAIM IS FOUND

Pursuant to Local Patent Rule 3-3(c), Defendants provide invalidity charts identified below and attached as Exhibits 296.A through 296.M identifying example identifications of each Asserted Claim being disclosed in each item of prior art charted.

A. Claim Chart List

Exhibit	'296 Claims	Bases for Invalidity
296.A	1-15	§ 102 and/or § 103 – Jacob '633
296.B	1-15	§ 103 Jacob '633 in view of one or more of Macaluso '238, Kinoshita '866, Smith '558, Sato '965, Ahn '281, Begum '880, Begum '606, Levkovitz '852, Sanctis '837, Bussmann '294, Mello '479, Busch '815, Svendsen '073, Xtify, Menayan 2008, and/or AppLoop.
296.C	1-15	§ 102 and/or § 103 – Hughes '666
296.D	1-15	§ 103 Hughes '666 in view of one or more of Macaluso '238, Kinoshita '866, Smith '558, Sato '965, Ahn '281, Begum '880, Begum '606, Levkovitz '852, Sanctis '837, Bussmann '294, Mello '479, Busch '815, Svendsen '073, Xtify, Menayan 2008, and/or AppLoop.
296.E	1-15	§ 102 and/or § 103 – Chmaytelli '453
296.F	1-15	§ 103 Chmaytelli '453 in view of one or more of Macaluso '238, Kinoshita '866, Smith '558, Sato '965, Ahn '281, Begum '880, Begum '606, Levkovitz '852, Sanctis '837, Bussmann '294, Mello '479, Busch '815, Svendsen '073, Xtify, Menayan 2008, and/or AppLoop.
296.G	1-15	§ 102 and/or § 103 – Collins '227

Exhibit	'296 Claims	Bases for Invalidity
296.H	1-15	§ 103 Collins '227 in view of one or more of Macaluso '238, Kinoshita '866, Smith '558, Sato '965, Ahn '281, Begum '880, Begum '606, Levkovitz '852, Sanctis '837, Bussmann '294, Mello '479, Busch '815, Svendsen '073, Xtify, Menayan 2008, and/or AppLoop.
296.I	1-15	§ 102 and/or § 103 – Andreasson '890
296.J	1-15	§ 103 Andreasson '890 in view of one or more of Macaluso '238, Kinoshita '866, Smith '558, Sato '965, Ahn '281, Begum '880, Begum '606, Levkovitz '852, Sanctis '837, Bussmann '294, Mello '479, Busch '815, Svendsen '073, Xtify, Menayan 2008, and/or AppLoop.
296.K	1-15	§ 102 and/or § 103 – Vela '724
296.L	1-15	§ 103 Vela '724 in view of one or more of Macaluso '238, Kinoshita '866, Smith '558, Sato '965, Ahn '281, Begum '880, Begum '606, Levkovitz '852, Sanctis '837, Bussmann '294, Mello '479, Busch '815, Svendsen '073, Xtify, Menayan 2008, and/or AppLoop.
296.M	1-15	§ 103 Jacob '633 in view of one or more of Hughes '666, Chmaytelli '453, Collins '227, Andreasson '890, and Vela '724.

Defendants have identified at least one instance of each claim element found in an item of prior art. Defendants have attempted to identify the most relevant portions of the references. The references may, however, contain additional support for claim limitations. Persons of ordinary skill in the art generally read a prior art reference as a whole and in the context of other publications and literature. Defendants may rely upon uncited portions of the references, other documents, and expert testimony to provide context or to aid in understanding the disclosures of the references. Where Defendants cite to a particular figure in a reference, the citation should be understood to encompass the caption and any corresponding description of the figure in the

specification. Conversely, where Defendants cite to particular text referring to a figure, the citation should be understood to include the corresponding figure as well.

Defendants base these claim charts in part upon Plaintiff's infringement positions. These claim charts do not indicate that Defendant agrees with or adopts Plaintiff's positions or claim constructions. Defendants reserve the right to propose and argue for different positions and constructions. To the extent that any prior art reference discloses the same feature or functionality of the accused instrumentalities, Defendant reserves the right to argue that such feature or functionality does not meet any limitation of any of the Asserted Claims of the '296 patent.

V. ANY GROUNDS OF INVALIDITY BASED ON INDEFINITENESS UNDER 35 U.S.C. § 112

Pursuant to Local Patent Rule 3-3(c), Defendants disclose grounds of invalidity based on indefiniteness under 35 U.S.C. § 112 ¶ 2 or enablement or written description under 35 U.S.C. § 112 ¶ 1 of any of the asserted claims based on Defendants' investigation to date and currently available information. For each claim identified as invalid, any dependent claims of those invalid claims are also invalid under 35 U.S.C. §§ 112, ¶ 1 and/or 112, ¶ 2. Defendants reserve the right to supplement and amend these contentions based on further discovery and investigation, including the deposition of any named parties, the Asserted Patents' inventors, or prior artists.

A. Enablement and Written Description

35 U.S.C. § 112, ¶ 1 requires that the specification contain a written description of the invention. "[T]he hallmark of written description is disclosure." *Bos. Sci. Corp. v. Johnson & Johnson*, 647 F.3d 1353, 1361-62 (Fed. Cir. 2011) (citation omitted). The test for whether a specification adequately describes an invention is "whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the

claimed subject matter as of the filing date [T]he test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art [It] is a question of fact.” *Ariad Pharms., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc); *Bos. Sci.*, 647 F.3d at 1362.

The enablement requirement of Section 112 demands that the patent specification enable “those skilled in the art to make and use the full scope of the claimed invention without `undue experimentation.’” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993)). “[T]he scope of the claims must be less than or equal to the scope of the enablement.” *Nat’l Recovery Tech., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1196 (Fed. Cir. 1999).

Defendants contend that the following Asserted Claims are invalid under 35 U.S.C. § 112, ¶ 1. Each Asserted Claim identified below is invalid under ¶ 1 because the specification of the Asserted Patents fails to provide a sufficient written description, enabling disclosure and/or fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention the meaning of the term(s) and/or phrase(s):

Asserted Claim(s)	Term(s) and/or Phrase(s) Lacking Written Description and Enablement
1, 6, 11	“registered application programs are each associated with at least one application program type” / “registered application programs are each associated with at least one application program type” / “registered application programs are each associated with at least one application program type”
1, 6, 11	“establishing a plurality of perimeters defining a plurality of geographic areas” / “establish a plurality of perimeters defining a plurality of geographic areas” / “establish a plurality of perimeters defining respective geographic areas”
1	“subject to the reserving”
2, 7, 12	“recording a request identifier associated with the request” / “record a request identifier associated with the request” / “record a request identifier associated with the request”
3, 8, 13	“receiving information related to user interaction with the provided content, the information including the request identifier” / “receive information related to user interaction with the provided content, the information including the request

Asserted Claim(s)	Term(s) and/or Phrase(s) Lacking Written Description and Enablement
	identifier” / “receive information related to user interaction with the provided content, the information including the request identifier”
4, 9, 14	“determining whether at least one of the plurality of sponsors is associated with a geographical representation lying at least partially within a predetermined radial distance of a target location; in response to a negative determination, increasing the predetermined radial distance” / “determine whether at least one of the plurality of sponsors is associated with a geographical representation lying at least partially within a predetermined radial distance of a target location; and at least one instruction to increase the predetermined radial distance in response to the at least one instruction to determine” / “determine whether at least one of the plurality of sponsors is associated with a geographical representation lying at least partially within a predetermined radial distance of a target location; and at least one instruction to increase the predetermined radial distance in response to a negative determination”

B. Indefiniteness

Claims are indefinite under 35 U.S.C. § 112, ¶ 2 when they “fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 989, 901 (2014).

In addition to Defendants’ reservation of rights stated above, Defendants note that the Court’s Docket Control Order contemplates that all indefiniteness issues be brought to the Court’s attention through the *Markman* briefing process. Defendants’ detailed arguments as to indefiniteness will be presented at that time, *i.e.*, through the *Markman* meet and confer and briefing process.

Defendants contend that the ’296 patent is invalid under 35 U.S.C. § 112, ¶ 2. The Asserted Claims identified below are invalid under ¶ 2 because they fail to inform, with reasonable certainty, those skilled in the art about the scope of the claimed invention

Asserted Claim(s)	Term(s) and/or Phrase(s) Lacking Written Description and Enablement
1, 6, 11	“registered application programs are each associated with at least one application program type” / “registered application programs are each associated with at least

Asserted Claim(s)	Term(s) and/or Phrase(s) Lacking Written Description and Enablement
	one application program type” / “registered application programs are each associated with at least one application program type”
1, 6, 11	“reserving delivery of content from a plurality of sponsors” / “at least one record indicating content delivery reservations associating each of a plurality of sponsors” / “at least one record indicating content delivery reservations associating each of a plurality of sponsors”
1, 6, 11	“receiving, from a registered application program, a request for content to be used within the registered application program” / “receive a request from a registered application program for content to be used within the registered application program” / “target locations contained within the selected one of the plurality of geographic areas”
1	“subject to the reserving”
2, 7, 12	“recording a request identifier associated with the request” / “record a request identifier associated with the request” / “record a request identifier associated with the request”
3, 8, 13	“receiving information related to user interaction with the provided content, the information including the request identifier” / “receive information related to user interaction with the provided content, the information including the request identifier” / “receive information related to user interaction with the provided content, the information including the request identifier”
4, 9, 14	“determining whether at least one of the plurality of sponsors is associated with a geographical representation lying at least partially within a predetermined radial distance of a target location” / “determine whether at least one of the plurality of sponsors is associated with a geographical representation lying at least partially within a predetermined radial distance of a target location” / “receive information related to user interaction with the provided content, the information including the request identifier”
5, 15	“reserving a specific one of the plurality of geographic areas for exclusive delivery of content associated with a particular one of the plurality of sponsors to registered application programs and having a target location contained within the specific one of the plurality of geographic areas” / “reserve a specific one of the plurality of geographic areas for exclusive delivery of content associated with a particular one of the plurality of sponsors to application programs and having a target location contained within the specific one of the plurality of geographic areas”
1, 6, 11	“receiving, from a sponsor, a request to obtain an interest in a selected one of the plurality of geographic areas; providing the sponsor a response to the request;... receiving, from a registered application program, a request for content to be used within the registered application program; in response to receiving the request:”/ “at least one instruction to receive, from a sponsor, a request to obtain an interest in a selected one of the plurality of geographic areas; at least one instruction to provide the sponsor a response to the request; at least one instruction to receive a request from a registered application program for content to be used within the registered application program;”/ “at

Asserted Claim(s)	Term(s) and/or Phrase(s) Lacking Written Description and Enablement
	least one instruction to receive, from a sponsor, a request to obtain an interest in a selected one of the plurality of geographic areas; at least one instruction to provide the sponsor a response to the request; at least one instruction to receive a request from a registered application program for content to be used within the registered application program;”
2, 7, 12	“recording a request identifier associated with the request; and providing the request identifier to the registered application program.”/ “at least one instruction to record a request identifier associated with the request; and at least one instruction to provide the request identifier to the registered application program.”/ “at least one instruction to record a request identifier associated with the request; and at least one instruction to provide the request identifier to the registered application program.”
3, 8, 13	“receiving information related to user interaction with the provided content, the information including the request identifier; and”/ “at least one instruction to receive information related to user interaction with the provided content, the information including the request identifier; and”/ “at least one instruction to receive information related to user interaction with the provided content, the information including the request identifier; and”/

VI. INVALIDITY BASED ON UNPATENTABLE SUBJECT MATTER UNDER 35 U.S.C. § 101

Pursuant to the Court’s Standing Order for Eligibility Contentions, Defendants provide Subject Matter Eligibility charts attached as Exhibits 296.1EC, 296.2EC, 296.3EC, and 296.4EC. In addition to the charts, the Defendants provide the following disclosure.

The ’296 patent claims are unpatentable under §101 because they recite the abstract activity of defining a geographic area for delivering content and delivering the content to a mobile device when it enters the geographic area based on known computer technology which the Plaintiff admittedly did not invent (geofencing). Indeed, this same Court has already determined that the claims of multiple child patents of the ’296 patent, which share an identical specification, constituted abstract ideas at the summary judgment stage. *See* Pretrial Conf. Tr. at 67, *Hardin v. Samsung Electronics Co., Ltd.*, No. 2:21-cv-290-JRG (E.D. Tex. Jan. 28, 2023), ECF No. 218. In this same vein, there is no “inventive concept” in the claims sufficient to ensure

that the patent amounts to anything more than the abstract concept itself. Where, as here, the claims use only generic, conventional computers and software components to perform a series of functions, there is simply nothing inventive to transform the abstract claims into something more.

A. Legal Standard

In step one of the two-step test for determining whether a patent is directed to ineligible subject matter under Section 101, the Court must decide whether the claims are “directed to” an abstract idea. *Alice*, 573 U.S. at 218. If the claim’s “‘character as a whole’ is directed to excluded subject matter” (an abstract idea), the Court proceeds to step two. *Affinity Labs of Tex. v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016). In step two, the Court should “look with more specificity at what the claim elements add, in order to determine ‘whether they identify an “inventive concept” in the application of the ineligible subject matter’ to which the claim is directed.” *Id.* at 1258. The Court must decide whether the elements of the claim, taken “both individually and ‘as an ordered combination.’” provide an “inventive concept” that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [abstract idea] itself.” *Alice*, 573 U.S. at 217-18. Any “additional features” in the claim related to the inventive concept “must be more than ‘well-understood, routine, conventional activity.’”

Intellectual Ventures I LLC v. Erie Indem. Co., 850 F.3d 1315, 1328 (Fed. Cir. 2017).

B. Alice Step One: Claim 1 Is Directed to an Abstract Idea

At step one, the Board is to “focus...on whether the *claims* of the asserted patents fall within the excluded category of abstract ideas.” *PersonalWeb Techs. v. Google LLC*, 8 F.4th 1310, 1313, 1316 (Fed. Cir. 2021). Representative Claim 1 is drafted in functional language and amounts to nothing more than the abstract idea of targeting the delivery of content based on the

location of a mobile device. The claim limitations merely including the processes of (i) registering application programs for delivering content, (ii) establishing perimeters defining geographic areas for the delivery of content to a mobile device, (iii) reserving delivery of content from the sponsors on the basis of both a specific geographic area and application program type, and (iv) delivering generic content from the sponsor once the mobile device has entered geographic area reserved for the sponsor or advertiser. *See, e.g.*, '296 Patent, Claim 1. The process of targeting content for delivery based on an individual's geographic location has been occurring for ages: selecting advertisements for billboards based on a billboard's location and the nearby businesses, inserting a local affiliate's television commercial in a commercial break for shows that are broadcasted nationally, selecting advertisements for local businesses on AM/FM radio based on audience and location, and many others. Indeed, as explained in the '296 patent, advertisements have been traditionally limited by location due to signal range: "[a]dvertisements can be delivered...within communications range of areas transmitters or other information providers." '296 Patent, 1:13-15.

The Federal Circuit has repeatedly rejected claims as abstract where they use "result-based functional language" and fail to "sufficiently describe how to achieve these results in a non-abstract way" (like the claims of the '185 patent). *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1337 (Fed. Cir. 2017) (noting that "[t]he claim requires the functional results of 'converting,' 'routing,' 'controlling,' 'monitoring,' and 'accumulating records,' but does not sufficiently describe how to achieve these results in a non-abstract way."); *accord Int'l Bus. Machines Corp. v. Zillow Grp.*, 50 F.4th 1371, 1378 (Fed. Cir. 2022) (patent is "result-oriented," describing required functions "presenting," "receiving," "selecting," "synchronizing" without explaining *how* to accomplish any of the tasks); *Affinity Labs of Texas*,

LLC v. DirecTV, LLC, 838 F.3d 1253, 1260-61 (Fed. Cir. 2016) (functional claim invalidated because there was nothing in the claim that described how to perform the claimed function).

As in *Two-Way*, *IBM*, and *Affinity Labs*, Claim 1 of the '296 patent describes in functional terms the delivery of content based on a mobile device's location ("registering" applications, "establishing" perimeters for geographic areas, "reserving" delivery of content for a sponsor on the basis of a geographic area and an application type, "receiving" a request for content, and "providing" the content to the application on the mobile device) without identifying how these steps would be performed in any manner that constitutes any sort of technical improvement. Claim 1 does not disclose *how* to register applications, *how* to establish perimeters for geographic areas, *how* to reserve the delivery of content, *how* to receive a request for content, or *how* to provide the content to the application on the mobile device. Instead, the claim elements recite functions in the abstract, couched as computer instructions. *Broadband iTV v. Amazon.com*, 113 F.4th 1359 (Fed. Cir. 2024). Nothing in this claim identifies a specific method of solving a problem unique to computers or the Internet—rather, these are "tasks for which a computer is used in its ordinary capacity." *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1305 (Fed. Cir. 2018).

Post-*Alice*, the Federal Circuit has repeatedly held that claims targeting content delivery based on location (and analogous concepts) are directed to abstract ideas. *See Beteiro, LLC v. DraftKings Inc.*, 104 F. 4th 1350, 1356 (Fed. Cir. 2024) (exchanging information and allowing or disallowing a bet based on where a user is located is an abstract idea); *Broadband iTV v. Amazon.com*, 113 F.4th 1359 (Fed. Cir. 2024) (targeted advertising constitutes abstract idea); *Sanderling Management Ltd. v. Snap, Inc.*, 65 F.4th 698, 703 (Fed. Cir. 2023) (claims "directed to the abstract idea of 'providing information—in this case, a processing function—based on

meeting a condition,’ e.g., matching a GPS location indication with a geographic location.”)

Intellectual Ventures I LLC v. Capital One Bank (USA), 792 F.3d 1363 (Fed. Cir. 2015)

(tailoring website content based on viewer’s location or the time of day when the user navigated to the website is abstract).⁴

The Federal Circuit’s reasoning in *Beteiro, LLC* is on all fours with the case at bar. The representative claim in that case contained the steps of:

- (1) detecting information about a gambling activity; (2) generating and transmitting a notification message regarding the activity to a user; (3) receiving a bet message that includes information regarding a bet to be placed and the location of the user; (4) determining whether the bet is allowed or disallowed using the location information; and (5) processing information for placing the bet or disallowing the bet.

Beteiro, LLC v. DraftKings Inc., 104 F. 4th at 1355. The Federal Circuit determined this was directed to the abstract idea of “exchanging information concerning a bet and allowing or disallowing the bet **based on where the user is located.**” *Id.* (emphasis added).

Claim 1 of the ’296 patent is similarly directed to the abstract idea of delivering content based on location. Indeed, the claims feature the same generic steps found to be abstract in

Beteiro:

- registering a plurality of application programs and receiving content to be delivered to the application programs (limitations 1[a], 1[g]) **[1]** (*Beteiro*’s detecting information);
- reserving geographic areas of interest (limitations 1[b]-[f]); **[2]-[3]** (*Beteiro*’s receipt and use of geographic information in connection with a bet);

⁴ *Accord PersonalWeb Techs. v. Google LLC*, 8 F.4th 1310, 1313, 1316 (Fed. Cir. 2021) (invalidating claims that use “identifiers to perform various data management functions” including “controlling access to data items” and “retrieving and delivering copies of data items”).

- receiving a request for content and delivering the content to the application program on the mobile device within the geographic area of interest (limitations 1[h]-[j]); [4]-[5] (*Beteiro*'s processing information for allowing/disallowing a bet based on location).

See *id.* The Federal Circuit noted that the claim at issue in *Beteiro*, like the claims here, are “drafted using largely (if not entirely) result-focused language, containing no specificity about how the purported invention achieves those results.” *Id.* at 1356 (emphasis added).

Many district courts have reached the same conclusion with location-based claims, relying on consistent, well-established Federal Circuit authority. See, e.g., *PerDiemCo LLC v. NexTraq LLC*, 2024 WL 1434452, at *13 (N.D. Ga. Mar. 13, 2024) (finding claims “directed to the abstract idea of collecting, analyzing, and distributing information from geo-tracking devices”). *GeoComply Sols. Inc. v. Xpoint Services LLC*, 2023 WL 1927393, at *6 (D. Del. Feb. 10, 2023) (finding claims directed to the abstract idea of “determining the location of a device based on geolocation information and programs present on the device”); *Front Row Techs., LLC v. Cisco Sys., Inc.*, 2023 WL 11800705, at *6 (W.D. Tex. Sept. 13, 2023) (finding claims directed to the abstract idea of “restrict[ing] content based on the user’s location-based data”); *CG Tech. Dev., LLC v. FanDuel, Inc.*, 442 F. Supp. 3d 840, 847 (D. Del. 2020), *aff’d*, 858 F. App’x 363 (Fed. Cir. 2021) (claims directed to the “basic concept of determining game configuration based on the location of a mobile device” are abstract).

In sum, Claim 1 “preempt[s] the entire industry’s ability to use” the abstract idea, no matter how it is implemented. See, e.g., *ChargePoint, Inc. v. SemaConnect, Inc.*, 920 F.3d 759, 769-70 (Fed. Cir. 2019) (explaining that a broad claim drafted in “a result-oriented way” that amounts to preempting the entire industry’s ability to use the abstract idea is patent ineligible); see also *GeoComply*, 2023 WL 1927393, at *8 (“[C]laim 1 by its terms would accord patent protection to any method of verifying a person’s location using geolocation data and the presence

of certain programs on the person's device. As such, it would result in the preemption of a wide range of activities relating to geolocation, even outside the context of online gaming.”).

C. Alice Step Two: No Inventive Concept Sufficient to Transform the Abstract Idea

Because Claim 1 is directed to an abstract idea, the next step is to determine whether it contains an “inventive concept...sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself.” *Alice*, 573 U.S. at 217-18 (citations and quotations omitted). It does not. Importantly, “a claimed invention’s use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention ‘significantly more’ than that ineligible concept.” *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018).

1. Mere Use of a General-Purpose Computer is Insufficient.

Claim 1 is a method-style claim that is entirely devoid of hardware components. Indeed, the '296 patent provides that its methods “may be implemented in a processing system executing a set of instructions stored in memory, or on a removable computer readable medium.” '296 patent, 12:29-32. An example system that is capable of performing the method of claim 1 is shown in FIG. 7. '296 patent, 12:12:32-34 (“An example of a system according to some embodiments is illustrated in FIG. 7).The system illustrated in FIG. 7 of the '296 patent is nothing more than a general-purpose computer that includes generic computing components configured to execute generic, conventional software instructions. *See, e.g.*, '296 patent, 12:34-13:3. Claim 1 neither seeks to solve any technological problems arising in the realm of computers or computer networks nor offer any unconventional technological solutions. The specification of the '296 patent confirms that this is indeed the intention of claim 1. '296 Patent, 12:36-39 (“Processing System 700 includes one or more central processing units,...which may be

conventional microprocessors”) (emphasis added); 12:46-50 (“Processing system 700 includes random access memory (RAM) 720; read-only memory (ROM) 715, wherein the ROM 715 could also be erasable programmable read-only memory (EPROM) or electrically erasable programmable read-only memory (EEPROM).”).

The Federal Circuit has repeatedly held that merely invoking “computers and networks that are not even arguably inventive are ‘insufficient to pass the test of an inventive concept in the application’ of an abstract idea.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016) (citation omitted). Claims that recite “no improved computer resources” and use “already available computers, with their already available basic functions, to use as tools in executing” the abstract idea do not provide an inventive concept. *SAP Am. Inc. v. InvestPic LLC*, 898 F.3d 1161, 1169-70 (Fed. Cir. 2018). The recitation of generic computer instructions in claim 6 accordingly cannot provide the requisite inventive concept. *See GeoComply*, 2023 WL 1927393, at *12 (“What is claimed and disclosed, therefore, is no more than the general idea of using generic computer components to obtain geolocation information from a user’s device, to consider whether certain programs are present on that device, and to report the results of an unspecified analysis of that information.”).

2. The Purported Advantages Are Insufficient.

Plaintiff alleges multiple purported advantages in preemptively addressing eligibility. *See* First Amended Complaint (“FAC”), ¶¶ 24-29. These alleged advantages are either not tethered to the claims or merely relate to advantages of the abstract idea itself, not advantages of a claimed inventive concept. *See ChargePoint, Inc. v. SemaConnect, Inc.*, 920 F.3d 759, 766 (“[W]hile the specification may help illuminate the true focus of a claim, when analyzing patent eligibility, reliance on the specification must always yield to the claim language in identifying that focus.”).

Customizable Content. Plaintiff alleges that “content delivery is customizable, which enables delivery of content in near-real time to areas as specific as particular business or home locations.” This area could be defined by “map features, such as streets, rivers, [or] landmarks...” See FAC, ¶24. The claims, however, say nothing about “real-time” delivery, nor do they mention specific map features such as streets, rivers or landmarks, and “[u]nclaimed features cannot function to remove [a claim] from the realm of ineligible subject matter.” *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 967 F.3d 1285, 1295 (Fed. Cir. 2020); *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1322 (Fed. Cir. 2016) (finding that the district court erred in “relying on technological details set forth in the patent’s specification and not set forth in the claims to find an inventive concept”). Rather, the claims simply mention “establishing a plurality of perimeters defining a plurality of geographic areas.” See ’296 Patent, claims 1[b], 6[e], and 11[b]. This limitation is nothing more than an extension of the abstract idea itself: defining desired locations for content delivery. Furthermore, even if this were an improvement (it is not), it would still not be an inventive concept because it flows from the abstract idea itself. See *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1288- 89 (Fed. Cir. 2018) (explaining that benefit of allowing users quicker access to relevant data did not provide a sufficient improvement because that benefit “flow[ed] from performing an abstract idea”).

Centralized Management System. Plaintiff further alleges that using a centralized management system “can thereby deliver specific content to each of a number of registered apps within specific regions under centralized management.” See FAC, ¶ 25. But none of the asserted claims recite “centralized management” or a “central management system” or anything similar. At best, some recite a “content delivery platform,” which can be a generic computer or Internet server that communicates with the mobile devices as depicted in Figure 1 of the ’296 Patent. See

also '296 Patent, Fig. 7, 12:29-13:3 (describing conventional microprocessor-based computer systems). Moreover, simply centralizing control or allowing a multiplicity of the same idea is not inventive. *See, e.g., Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1319 (Fed. Cir. 2016) (“‘enhancement procedure’” of “combining data from multiple network devices” is not an inventive concept “because the abstract idea of ‘gathering and combining data’ is not patent-eligible”); *Realtime Data LLC v. Array Networks Inc.*, 2023 WL 4924814 at *11 (Fed. Cir. Aug. 2, 2023) (“[u]sing multiple compression techniques and compressing and storing data on a generic component faster than if it were uncompressed data, moreover, is an abstract idea and cannot provide an inventive concept”).

Plaintiff further alleges that centralized management system “delivers content to requesting apps when it has been determined that the mobile device has entered any of the specified areas and remained therein for a predetermined or specified period of time.” FAC, ¶ 25. This feature, however, does not provide an inventive concept—it is just another rule for delivering content, devoid of any technological improvement, and thus itself is an abstract idea. The Federal Circuit has confirmed that providing information based on a condition or rule occurring (namely, matching a GPS indication with a geographic location) is abstract. *See Sanderling*, 65 F.4th at 703 (terming this a “distribution rule”). As in *Sanderling*, conditioning delivery of content based on the mobile device remaining within the specified geographic area for a predetermined length of time (*see, e.g.* claim 60) is nothing more than a distribution rule, and the specification does not describe any technological improvement or inventive concept associated with this rule. '296 Patent, 3:18-20 (“[t]he request can also include time limitations, limitations based on the length of time a mobile device remains within a certain geographic area, or other desired limitations.”); 9:25-27 (“when the mobile device or target location physically

enters or remains within the sponsor’s reserved area for a desired length of time.”). Here, there is no description of *how* to determine what the predetermined time should be or *how* to apply these restrictions.

Identifier. Plaintiff further alleges that providing a request identifier can be provided for each request for content from an application program. This identifier allegedly receives information related to user interaction with the content and provides additional content to the registered application. FAC, ¶ 26. But contrary to plaintiff’s claims that this is a “unique technological solution,” (*see id.*) the Federal Circuit has determined that identifiers which perform data-management functions constitute abstract ideas without an inventive contribution. *PersonalWeb Techs. v. Google LLC*, 8 F.4th 1310, 1313, 1316 (Fed. Cir. 2021).

Exclusivity/Resolving Competing Claims. The Plaintiff also alleges the features that geographic areas can be exclusively reserved -- and that competing claims to geographic areas can be resolved – are technological improvements. FAC, ¶ 27. But these concepts are not embodied in any of the independent claims; instead, the ‘296 patent *only* mentions “reserving a specific one of the plurality of geographic areas for exclusive delivery of content” in dependent claims 5, 10, and 15. Nothing in the ‘296 patent’s claims talks about resolving *competing* claims. Moreover, PO’s purported improvements apply to traditional broadcast as well. Radio and TV stations can only broadcast one commercial in a timeslot. Thus, scheduling of advertisements, i.e., resolving competing claims already existed (e.g., TV stations auctioned off advertisement timeslots).

Accordingly, the ‘296 patent’s claims should be held invalid under §101.

D. Claim 1 Is Representative of the Asserted Claims

When analyzing a patent under §101, it is appropriate to consider the issue based on a representative claim. *Accenture Glob. Servs. v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344 (Fed. Cir. 2013) (“Because the system claim and method claim contain only minor differences in terminology but require performance of the same basic process, they should rise or fall together.”) (cleaned up). A claim is representative when “the claims of the...patents are substantially similar in that they recite little more than the same abstract idea.” *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014); *see also Phoenix Licensing, L.L.C. v. Consumer Cellular, Inc.*, 2017 WL 1065938, at *8-9 (E.D. Tex. Mar. 8, 2017) (“[H]ere, as the Federal Circuit stated in the case of *Content Extraction*, the representative claims are ‘substantially similar’ to the other claims and all of the claims are ‘linked to the same abstract idea.’”).

The ’296 patent claims are directed to the abstract idea of delivering content based on location using generic computer technology. As explained more below, the independent claims generally require the following:

- Registering application programs (e.g., claims 1[a], 6[d], 11[a])
- Reserving a geographic areas for delivery of content (e.g., claims 1[b]-[g], 6[e]-[j], 11[b]-[g]);
- Receiving a request for content from a registered application on a mobile device (e.g., claims 1[h], 6[k], 11[h]); and
- Delivering the content based on the type of registered application and location of the mobile device (e.g., claims 1[i]-[j], 6[l]-[m], 11[i]-[j]).

Claim 1 is representative of the asserted claims (claims 1-15) and includes the above limitations. Claim 1’s dependent claims 2-5 do not change representativeness because they merely add additional conventional and routine limitations as described below. *See Content*

Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n, 776 F.3d 1343, 1349 (Fed. Cir. 2014) (dependent claims adding “well-known, routine, and conventional functions” merely narrow representative claims).

- Claim 2 further requires the recording and subsequent delivery of a request identifier to the application program.
- Claim 3 further requires receiving user interaction information related to the user’s interaction with the provided content and the delivery of additional content to the application program.
- Claim 4 requires use of a radial distance to determine whether a sponsor is associated with a geographic area.
- Claim 5 requires exclusively reserving a geographic area for a given sponsor.

Claims 6-10 are the system claim counterparts to the method-style claims 1-5 and thus do not change the representativeness analysis. Claims 11-15 are the Beauregard-style claim counterparts to the method-style claims 1-5. For example, Beauregard-style claim 11 includes in the preamble explicitly that its “non-transitory computer readable medium tangibly embod[ies] a program of computer executable instructions,” where the program of computer executable instructions are substantially similar to the method steps of claim 1. The following table maps the system claims to the corresponding Beauregard claims and method claims, respectively.

Method Claim Number	System Claim Number	Corresponding Beauregard Claim Number
1	6	11
2	7	12
3	8	13
4	9	14
5	10	15

Any differences in the named generic computer components between claim sets do not affect representativeness. Different descriptions of generic computer components implementing an abstract idea do not affect the 101 analysis. *See Alice*, 573 U.S. at 210 (all claims fell together

because “[t]he method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea.”). Since the claims recite generic computer limitations like memory, a processor, and code or software, claim 1 is representative.

Finally, no dependent claim adds any inventive concept because they all recite insignificant pre- or post-solution activity. *See Apple, Inc.*, 842 F.3d at 1242. As explained above, the dependent claims add routine and conventional limitations, *e.g.*, recording and delivering of a request identifier, receiving user interaction information related to the user’s interaction with the provided content and the delivery of additional content to the application program, using a radial distance to determine whether a sponsor is associated with a geographic area, and exclusively reserving a geographic area for a given sponsor—none of which are new or inventive. Because the Beauregard and method claims are no different in all material respects with respect to the system claims, the same analysis applies. Claim 1 of the ’296 Patent is representative of claims 1-15 of the ’296 Patent.

VII. UNENFORCEABILITY CONTENTIONS

Defendants reserve their right to assert inequitable conduct and any other enforceability defense as fact discovery progresses.

VIII. DOCUMENT PRODUCTION ACCOMPANYING INVALIDITY CONTENTIONS

Pursuant to Local Patent Rule 3-4 and the Court’s Standing Order for Eligibility Contentions, Defendants are producing herewith copies of the prior art referenced in their Preliminary Invalidity Contentions and Eligibility Contentions at HD_H2_0000030 - HD_H2_0006232. Defendants have also gathered certain technical documents for production pursuant to P.R. 3-4(a) and will produce them following a conference with plaintiff’s counsel regarding the scope of Plaintiff’s infringement contentions. *See* 11/29/24 correspondence.

Defendants reserve the right to supplement this production as the case progresses, including but not limited to, producing or making additional documents available for inspection.

Dated: January 10, 2025

Respectfully submitted,

By: /s/ Nicholas G. Papastavros
Nicholas G. Papastavros
DLA PIPER LLP (US)
33 Arch Street, 26th Floor
Boston, MA 02110-1447
Telephone: 617.406.6000
Facsimile: 617.406.6119
nick.papastavros@dlapiper.com

Eric H. Findlay
Texas Bar No. 00789886
FINDLAY CRAFT, P.C.
7270 Crosswater Avenue, Suite B
Telephone: 903.534.1100
efindlay@findlaycraft.com

CERTIFICATE OF SERVICE

I hereby certify that on January 10, 2025, the foregoing document was served by email on all counsel of record.

/s/ Nicholas G. Papastavros
Nicholas G. Papastavros

EXHIBIT F

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

H2 INTELLECT LLC,

Plaintiff,

v.

**THE HOME DEPOT, INC., HOME
DEPOT U.S.A., INC., AND HOME
DEPOT PRODUCT AUTHORITY,
LLC,**

Defendants.

Civil Action No. 2:25-cv-00123-JRG-RSP

JURY TRIAL DEMANDED

[EXEMPLAR PROPOSED] DOCKET CONTROL ORDER

Before the Court is The Home Depot, Inc., Home Depot U.S.A., Inc., and Home Depot Product Authority LLC's (collectively, "Home Depot") Motion to Consolidate (Dkt. No. ____). Having considered the same it is hereby ORDERED that the following schedule of deadlines is in effect until further notice of this Court:

694 Action Date	123 Action Date	Consolidated Date	Deadline
April 20, 2026	September 14, 2026	July 15, 2026	*Jury Selection - 9:00 a.m. in Marshall, Texas
7 days before Jury Selection	7 days before Jury Selection	7 days before Jury Selection	*Defendant to disclose final invalidity theories, final prior art references/combinations, and final equitable defenses. ¹
10 days before Jury Selection	10 days before Jury Selection	10 days before Jury Selection	*Plaintiff to disclose final election of Asserted Claims. ²

¹ The proposed DCO shall include this specific deadline. The deadline shall read, "7 days before Jury Selection," and shall not include a specific date.

² Given the Court's past experiences with litigants dropping claims and defenses during or on the eve of trial, the Court is of the opinion that these additional deadlines are necessary. The proposed DCO shall include this specific deadline. The deadline shall read, "10 days before Jury Selection," and shall not include a specific date.

694 Action Date	123 Action Date	Consolidated Date	Deadline
March 23, 2026	August 17, 2026	June 17, 2026	*If a juror questionnaire is to be used, an editable (in Microsoft Word format) questionnaire shall be jointly submitted to the Deputy Clerk in Charge by this date. ³
March 16, 2026	August 10, 2026	June 10, 2026	*Pretrial Conference - 9:00 a.m. in Marshall, Texas before Magistrate Judge Roy Payne
March 9, 2026	August 3, 2026	June 3, 2026	*Notify Court of Agreements Reached During Meet and Confer
March 9, 2026	August 3, 2026	June 3, 2026	*File Joint Pretrial Order, Joint Proposed Jury Instructions, Joint Proposed Verdict Form, Responses to Motions in Limine, Updated Exhibit Lists, Updated Witness Lists, and Updated Deposition Designations
March 2, 2026	July 27, 2026	May 27, 2026	*File Notice of Request for Daily Transcript or Real Time Reporting. If a daily transcript or real time reporting of court proceedings is requested for trial, the party or parties making said request shall file a notice with the Court and e-mail the Court Reporter, Shawn McRoberts, at shawn_mcroberts@txed.uscourts.gov .
February 24, 2026	July 20, 2026	May 20, 2026	File Motions <i>in Limine</i> The parties shall limit their motions <i>in limine</i> to issues that if improperly introduced at trial would be so prejudicial that the Court could not alleviate the prejudice by giving appropriate instructions to the jury.
February 24, 2026	July 20, 2026	May 20, 2026	Serve Objections to Rebuttal Pretrial Disclosures

³ The Parties are referred to the Court's Standing Order Regarding Use of Juror Questionnaires in Advance of *Voir Dire*.

694 Action Date	123 Action Date	Consolidated Date	Deadline
February 18, 2026	July 13, 2026	May 13, 2026	Serve Objections to Pretrial Disclosures; and Serve Rebuttal Pretrial Disclosures
February 3, 2026	June 29, 2026	April 29, 2026	Serve Pretrial Disclosures (Witness List, Deposition Designations, and Exhibit List) by the Party with the Burden of Proof
January 26, 2026	June 22, 2026	April 22, 2026	*Response to Dispositive Motions (including Daubert Motions). Responses to dispositive motions that were filed <u>prior</u> to the dispositive motion deadline, including Daubert Motions, shall be due in accordance with Local Rule CV-7(e), not to exceed the deadline as set forth in this Docket Control Order. ⁴ Motions for Summary Judgment shall comply with Local Rule CV-56.
January 12, 2026	June 8, 2026	April 8, 2026	*File Motions to Strike Expert Testimony (including Daubert Motions) No motion to strike expert testimony (including a Daubert motion) may be filed after this date without leave of the Court.
January 12, 2026	June 8, 2026	April 8, 2026	*File Dispositive Motions No dispositive motion may be filed after this date without leave of the Court. Motions shall comply with Local Rule CV-56 and Local Rule CV-7. Motions to extend page limits will only be granted in exceptional circumstances. Exceptional

⁴ The parties are directed to Local Rule CV-7(d), which provides in part that “[a] party’s failure to oppose a motion in the manner prescribed herein creates a presumption that the party does not controvert the facts set out by movant and has no evidence to offer in opposition to the motion.” If the deadline under Local Rule CV 7(e) exceeds the deadline for Response to Dispositive Motions, the deadline for Response to Dispositive Motions controls.

694 Action Date	123 Action Date	Consolidated Date	Deadline
			circumstances require more than agreement among the parties.
January 10, 2026	June 1, 2026	April 1, 2026	Deadline to Complete Expert Discovery
December 23, 2025	May 18, 2026	March 18, 2026	Serve Disclosures for Rebuttal Expert Witnesses
December 4, 2025	April 27, 2026	February 25, 2026	Serve Disclosures for Expert Witnesses by the Party with the Burden of Proof
November 21, 2025	April 27, 2026	February 25, 2026	Deadline to Complete Fact Discovery and File Motions to Compel Discovery
November 6, 2025	April 9, 2026	February 5, 2026	Comply with P.R. 3-7 (Opinion of Counsel Defenses)
October 17, 2025	March 19, 2026	January 20, 2026	*Claim Construction Hearing - 9:00 a.m. in Marshall, Texas before Magistrate Judge Roy Payne
October 3, 2025	March 5, 2026	January 5, 2026	*Comply with P.R. 4-5(d) (Joint Claim Construction Chart)
September 26, 2025	February 26, 2026	December 29, 2025	*Comply with P.R. 4-5(c) (Reply Claim Construction Brief)
September 18, 2025	February 19, 2026	December 22, 2025	Comply with P.R. 4-5(b) (Responsive Claim Construction Brief)
September 4, 2025	February 5, 2026	December 8, 2025	Comply with P.R. 4-5(a) (Opening Claim Construction Brief) and Submit Technical Tutorials (if any) Good cause must be shown to submit technical tutorials after the deadline to comply with P.R. 4-5(a)
September 4, 2025	February 5, 2026	December 8, 2025	Deadline to Substantially Complete Document Production and Exchange Privilege Logs Counsel are expected to make good faith efforts to produce all required documents as soon as they are

694 Action Date	123 Action Date	Consolidated Date	Deadline
			available and not wait until the substantial completion deadline
August 21, 2025	January 22, 2026	November 24, 2025	Comply with P.R. 4-4 (Deadline to Complete Claim Construction Discovery)
August 14, 2025	January 15, 2026	November 17, 2025	File Response to Amended Pleadings
August 1, 2025	January 2, 2026	November 3, 2025	*File Amended Pleadings It is not necessary to seek leave of Court to amend pleadings prior to this deadline unless the amendment seeks to assert additional patents.
July 24, 2025	December 26, 2025	October 27, 2025	Comply with P.R. 4-3 (Joint Claim Construction Statement)
June 26, 2025	December 4, 2025	October 6, 2025	Comply with P.R. 4-2 (Exchange Preliminary Claim Constructions)
June 5, 2025	November 13, 2025	September 15, 2025	Comply with P.R. 4-1 (Exchange Proposed Claim Terms)
December 19, 2024	July 9, 2025	July 9, 2025	Comply with Standing Order Regarding Subject-Matter Eligibility Contentions ⁵
December 19, 2024	July 9, 2025	July 9, 2025	Comply with P.R. 3-3 & 3-4 (Invalidity Contentions)
November 29, 2024	June 18, 2025	June 18, 2025	*File Proposed Protective Order and Comply with Paragraphs 1 & 3 of the Discovery Order (Initial and Additional Disclosures) The Proposed Protective Order shall be filed as a separate motion with the caption indicating whether or not the proposed order is opposed in any part.

⁵ <http://www.txed.uscourts.gov/sites/default/files/judgeFiles/EDTX%20Standing%20Order%20Re%20Subject%20Matter%20Eligibility%20Contentions%20.pdf> [https://perma.cc/RQN2- YU5P]

694 Action Date	123 Action Date	Consolidated Date	Deadline
November 21, 2024	June 11, 2025	June 11, 2025	*File Proposed Discovery Order The Proposed Discovery Order shall be filed with the caption indicating whether or not the proposed order is opposed in any part.
	June 4, 2025	June 4, 2025	Join Additional Parties
	May 14, 2025	May 14, 2025	Comply with P.R. 3-1 & 3-2 (Infringement Contentions)

(*) indicates a deadline that cannot be changed without an acceptable showing of good cause. Good cause is not shown merely by indicating that the parties agree that the deadline should be changed.

ADDITIONAL REQUIREMENTS

Mediation: While certain cases may benefit from mediation, such may not be appropriate for every case. The Court finds that the Parties are best suited to evaluate whether mediation will benefit the case after the issuance of the Court’s claim construction order. Accordingly, the Court **ORDERS** the Parties to file a Joint Notice indicating whether the case should be referred for mediation **within fourteen days of the issuance of the Court’s claim construction order.** As a part of such Joint Notice, the Parties should indicate whether they have a mutually agreeable mediator for the Court to consider. If the Parties disagree about whether mediation is appropriate, the Parties should set forth a brief statement of their competing positions in the Joint Notice.

Summary Judgment Motions, Motions to Strike Expert Testimony, and Daubert Motions: For each motion, the moving party shall provide the Court with two (2) hard copies of the completed briefing (opening motion, response, reply, and if applicable, sur-reply), excluding exhibits, in D-three-ring binders, appropriately tabbed. All documents shall be single-sided and must include the CM/ECF header. These copies shall be delivered to the Court within three (3) business days after briefing has completed. For expert-related motions, complete digital copies of the relevant expert report(s) and accompanying exhibits shall be submitted on a single flash drive to the Court. Complete digital copies of the expert report(s) shall be delivered to the Court no later than the dispositive motion deadline.

Indefiniteness: In lieu of early motions for summary judgment, the parties are directed to include any arguments related to the issue of indefiniteness in their *Markman* briefing, subject to the local rules’ normal page limits.

Lead Counsel: The Parties are directed to Local Rule CV-11(a)(1), which provides that “[o]n the first appearance through counsel, each party shall designate a lead attorney on the pleadings or otherwise.” Additionally, once designated, a party’s lead attorney may only be changed by the filing of a Motion to Change Lead Counsel and thereafter obtaining from the Court an Order granting leave to designate different lead counsel. The true lead counsel should be

designated early and should not expect to parachute in as lead once the case has been largely developed. •

Motions for Continuance: The following will not warrant a continuance nor justify a failure to comply with the discovery deadline:

- a. The fact that there are motions for summary judgment or motions to dismiss pending;
- b. The fact that one or more of the attorneys is set for trial in another court on the same day, unless the other setting was made prior to the date of this order or was made as a special provision for the parties in the other case;
- c. The failure to complete discovery prior to trial, unless the parties can demonstrate that it was impossible to complete discovery despite their good faith effort to do so.

Amendments to the Docket Control Order (“DCO”): Any motion to alter any date on the DCO shall take the form of a motion to amend the DCO. The motion to amend the DCO shall include a proposed order that lists all of the remaining dates in one column (as above) and the proposed changes to each date in an additional adjacent column (if there is no change for a date the proposed date column should remain blank or indicate that it is unchanged). In other words, the DCO in the proposed order should be complete such that one can clearly see all the remaining deadlines and the changes, if any, to those deadlines, rather than needing to also refer to an earlier version of the DCO.

Proposed DCO: The Parties’ Proposed DCO should also follow the format described above under “Amendments to the Docket Control Order (‘DCO’).”

Joint Pretrial Order: In the contentions of the Parties included in the Joint Pretrial Order, the Plaintiff shall specify all allegedly infringed claims that will be asserted at trial. The Plaintiff shall also specify the nature of each theory of infringement, including under which subsections of 35 U.S.C. § 271 it alleges infringement, and whether the Plaintiff alleges divided infringement or infringement under the doctrine of equivalents. Each Defendant shall indicate the nature of each theory of invalidity, including invalidity for anticipation, obviousness, subject-matter eligibility, written description, enablement, or any other basis for invalidity. The Defendant shall also specify each prior art reference or combination of references upon which the Defendant shall rely at trial, with respect to each theory of invalidity. The contentions of the Parties may not be amended, supplemented, or dropped without leave of the Court based upon a showing of good cause.

Trial: All parties must appear in person at trial. All non-individual (including but not limited to corporate) parties must appear at trial through the presence in person of a designated representative. Once they have appeared, any representative of a non-individual party shall not be replaced or substituted without express leave of Court.

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

H2 INTELLECT LLC,

Plaintiff,

vs.

THE HOME DEPOT, INC.,
HOME DEPOT U.S.A., INC., AND
HOME DEPOT PRODUCT AUTHORITY, LLC,

Defendants.

Civil Action No. 2:25-cv-00123-JRG-
RSP

JURY TRIAL DEMANDED

ORDER ON MOTION TO CONSOLIDATE

Before the Court is Defendants The Home Depot, Inc., Home Depot U.S.A., Inc., and Home Depot Product Authority, LLC's Opposed Motion to Consolidate this Case with Case No. 2:24-cv-00694 (E.D. Tex.). Having considered the Motion and the exhibits thereto, and pursuant to Federal Rule of Civil Procedure 42, IT IS HEREBY ORDERED that this Motion to Consolidate is GRANTED.

The Clerk is directed to consolidate this Action with Civil Action No. 2:24-cv-00694.