

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

SMART RF INC.,

Plaintiff,

v.

AT&T MOBILITY LLC,

Defendant.

Civil Action No. 2:24-cv-00195

Jury Trial Demanded

**PLAINTIFF SMART RF INC.'S DISCLOSURE OF ASSERTED CLAIMS AND
INFRINGEMENT CONTENTIONS**

Pursuant to Local Patent Rules 3-1 and 3-2, Plaintiff Smart RF Inc. (hereinafter, "Plaintiff" or "Smart RF") makes the following disclosure of asserted claims and infringement contentions to AT&T Mobility LLC (hereinafter, "Defendant" or "AT&T").

The following asserted claims and contentions are based upon Smart RF's good faith evaluation of information known to Smart RF at this time. Discovery in this case has not begun, and Smart RF reserves its right to supplement and/or amend these disclosures in view of information and/or documents that may be obtained during discovery, further investigation, the Court's claim construction ruling, applicable case law and authorities, and/or any other reasons permitted by the Federal Rules of Civil Procedure, by the Local Rules of the Eastern District of Texas, or by order of the Court. *See Eolas Techs. Inc. v. Amazon.com, Inc.*, No. 6:15-CV-01038, 2016 WL 7666160, at *2 (E.D. Tex. Dec. 5, 2016) ("[G]iven Plaintiff's assertion that Defendants have not produced all documents and code reflecting their server architectures, it is unreasonable to expect Plaintiff to draft ICs in great detail . . . [C]ontentions should become more detailed with the conclusion of fact discovery and claim construction.").

I. P.R. 3-1 Disclosure of Asserted Claims and Infringement Contentions

(a) Each claim of each patent in suit that is allegedly infringed by each opposing party.

Based on information presently available, Smart RF contends that the Defendant directly and/or indirectly infringes the claims identified in Exhibits A-E, including the following claims of the patents-in-suit:

1. Claims 1-11 of U.S. Patent No. 7,035,345 (the “345 patent”);¹
 2. Claims 1-22 of U.S. Patent No. 8,078,561 (the “561 patent”);²
 3. Claims 1-15 of U.S. Patent No. 8,767,857 (the “857 patent”);³
 4. Claims 1-15 of U.S. Patent No. 9,641,204 (the “204 patent”);⁴ and
 5. Claims 1-10 of U.S. Patent No. 10,958,296 (the “296 patent”).⁵
- (b) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality (“Accused Instrumentality” or “Accused Product”) of each opposing party of which the party is aware. This identification shall be as specific as possible. Each product, device, and apparatus must be identified by name or model number, if known. Each method or process must be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process.**

The Accused Instrumentalities/Products of which Smart RF is aware are identified below. Smart RF reserves the right, in response to discovery or as otherwise permitted, to supplement its identification of Accused Instrumentalities/Products.

1. The Accused Instrumentalities/Products for U.S. Patent No. 7,035,345 include those identified in Exhibit A, including but not limited to Defendant’s cellular

¹ See also Exhibit A, incorporated herein by reference.

² See also Exhibit B, incorporated herein by reference.

³ See also Exhibit C, incorporated herein by reference.

⁴ See also Exhibit D, incorporated herein by reference.

⁵ See also Exhibit E, incorporated herein by reference.

network, and any other similar products that include the elements of the asserted claims identified in the accompanying charts.

2. The Accused Instrumentalities/Products for U.S. Patent No. 8,078,561 include those identified in Exhibit B, including but not limited to Defendant's cellular network, and any other similar products that include the elements of the asserted claims identified in the accompanying charts.
3. The Accused Instrumentalities/Products for U.S. Patent No. 8,767,857 include those identified in Exhibit C, including but not limited to Defendant's cellular network, and any other similar products that include the elements of the asserted claims identified in the accompanying charts.
4. The Accused Instrumentalities/Products for U.S. Patent No. 9,641,204 include those identified in Exhibit D, including but not limited to Defendant's cellular network, and any other similar products that include the elements of the asserted claims identified in the accompanying charts.
5. The Accused Instrumentalities/Products for U.S. Patent No. 10,958,296 include those identified in Exhibit E, including but not limited to Defendant's cellular network, and any other similar products that include the elements of the asserted claims identified in the accompanying charts.

Smart RF expressly reserves the right to seek leave of Court to augment and supplement these disclosures after discovery from Defendant, or as permitted under the Patent Rules. Smart RF expects that this disclosure may be subject to amendment or supplementation to identify and accuse additional products developed or made available after the date on which these contentions are served, or of which Smart RF was not aware at the time that these contentions were prepared.

- (c) **A chart identifying specifically where each element of each asserted claim is found within each Accused Instrumentality, including for each element that such party contends is governed by 35 U.S.C. § 112 (¶ 6), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function.**

Charts identifying where each element of the asserted claims is found within each Accused Instrumentality/Product are included as Exhibits A-E accompanying this document. Based on publicly available information and Plaintiff's research, Smart RF asserts that the Accused Instrumentalities/Products for each of the asserted patents infringe the asserted claims of the asserted patent, as identified in the accompanying charts, in the same or substantially similar manner. On information and belief, Smart RF contends that each of the Accused Instrumentalities/Products include the same or substantially same structures and functions as those identified for each asserted claim element in the accompanying charts. Thus, the attached claim charts are representative of the manner and theory of infringement pertaining to the Accused Instrumentalities/Products for each of the asserted patents.

The attached claim charts are based on publicly available information currently accessible to Smart RF as discovery has yet to begin. Specifically, Smart RF believes that evidence of infringement will be found in Defendant's source code, technical documents, specifications, schematics, or other proprietary information, which has not been produced yet. Accordingly, Smart RF reserves the right to amend its list of Accused Instrumentalities/Products or charts after obtaining relevant discovery from Defendant (including, but not limited to access to Defendant's source code disclosures, technical documents, and other proprietary information), or as permitted by the Court, the Patent Rules, or the Federal Rules of Civil Procedure.

Smart RF does not contend that any claim element is governed by 35 U.S.C. § 112 ¶6.

(d) Whether each element of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the Accused Instrumentality.

Except as identified in Exhibits A-E, and based on its current understanding of the claim language and publicly available information pertaining to the Accused Instrumentalities/Products, and without notice of any claim construction or non-infringement position from Defendant, Smart RF currently contends that each element of each asserted claim is literally present. Further, as the Court has not construed any claim term, it is not yet clear whether Smart RF will rely on the doctrine of equivalents for the remaining patent claims. Accordingly, Smart RF reserves the right to amend its infringement contentions as necessary. However, any claim element not literally present in the Accused Instrumentalities/Products, as set forth in the attached claim charts, is satisfied under the doctrine of equivalents because any difference between such claim element and the accused element is insubstantial. In other words, the accused element performs substantially the same function, in substantially the same way to achieve substantially the same result as the corresponding claim element(s).

Smart RF reserves the right to augment and supplement its disclosure concerning the doctrine of equivalents based upon additional information obtained through discovery or based upon the Court's claim construction.

(e) For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled.

Each asserted claim in each of the patents-in-suit is entitled to a priority date no later than the filing date of the earliest application to which it claims priority. Plaintiff believes the asserted claims have the following priority dates.

1. The asserted claims of the '345 patent are entitled to a priority date at least as early as October 1999.

2. The asserted claims of the '561 patent are entitled to a priority date at least as early as December 2005.
3. The asserted claims of the '857 patent are entitled to a priority date at least as early as September 2008.
4. The asserted claims of the '204 patent are entitled to a priority date at least as early as February 2010.
5. The asserted claims of the '296 patent are entitled to a priority date at least as early as February 2010.

Plaintiff believes that each asserted patent may be entitled to a priority date several months earlier than the date identified above based on the inventors' efforts to reduce the claimed inventions to practice. Plaintiff reserves the right to amend its list of priority dates as additional information becomes available.

- (f) If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party must identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim.**

Smart RF does not assert that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed inventions.

II. P.R. 3-2 Document Production Accompanying Disclosure

- (a) Documents (e.g., contracts, purchase orders, invoices, advertisements, marketing materials, offer letters, beta site testing agreements, and third party or joint development agreements) sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell, the claimed invention prior to the date of application for the patent in suit. A party's production of a document as required herein shall not constitute an admission that such document evidences or is prior art under 35 U.S.C. §102.**

Smart RF identifies the following documents:

- '345 patent: SMARTRF_0000037-SMARTRF_0000059
- '561 patent: SMARTRF_0000060-SMARTRF_0000085
- '857 patent: SMARTRF_0000086-SMARTRF_0000369
- '204 patent: SMARTRF_0000001-SMARTRF_0000036
- '206 patent: SMARTRF_0000001-SMARTRF_0000036

(b) All documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified pursuant to P. R. 3-1(e), whichever is earlier.

Smart RF identifies the following documents:

- '345 patent: SMARTRF_0000037-SMARTRF_0000059; SMARTRF_0000524-SMARTRF_0000543
- '561 patent: SMARTRF_0000060-SMARTRF_0000085; SMARTRF_0000544-SMARTRF_0000579
- '857 patent: SMARTRF_0000086-SMARTRF_0000369; SMARTRF_0000580-SMARTRF_0399294
- '204 patent: SMARTRF_0000001-SMARTRF_0000036; SMARTRF_0000370-SMARTRF_0000523
- '206 patent: SMARTRF_0000001-SMARTRF_0000036; SMARTRF_0000370-SMARTRF_0000523

Smart RF is not aware of any other non-privileged documents in its possession, custody, or control that evidence conception, reduction to practice, design, or development of the claimed inventions that were created on or before the above referenced dates for the patents-in-suit. Smart RF notes that documents responsive to P.R. 3-2(b) may be in the possession of third parties, such as prior assignees of the patents-in-suit. In the event that discovery from any such party leads to documents

that evidence conception, reduction to practice, design, and development of any claimed invention that were created on or before the date of application for the patents-in-suit, Smart RF reserves the right to claim such date.

(c) A copy of the file history for each patent in suit.

A copy of the file histories for the patents-in-suit are produced herewith and bear production numbers as follows: SMARTRF_0399578-SMARTRF_0399730; SMARTRF_0399752-SMARTRF_0399883; SMARTRF_0399898-SMARTRF_0400108; SMARTRF_0400123-SMARTRF_0400380; SMARTRF_0399295-SMARTRF_0399564.

Dated: May 15, 2024

Respectfully submitted,

/s/ Patrick J. Conroy

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**ATTORNEYS FOR PLAINTIFF
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing document was served on Defendant through its respective counsel via electronic mail on May 15, 2024.

/s/ Patrick J. Conroy