IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
MIDLAND/ODESSA DIVISION

CARDWARE INC.,	§	
	§	
Plaintiff	§	
	§	
v.	§	Civil Action No. 7:24-CV-00278-DC-DTG
	§	
GOOGLE LLC,	§	JURY TRIAL DEMANDED
	§	
Defendant.	§	
	§	
	§	

DEFENDANT GOOGLE LLC'S INVALIDITY CONTENTIONS

Pursuant to the Scheduling Order (Dkt. 48), and the Court's Standing Order Governing Patent Proceedings ("Standing Order"), Defendant Google LLC ("Google" or "Defendant"), hereby discloses these Supplemental Invalidity Contentions in the above-captioned case to CardWare Inc. ("CardWare" or "Plaintiff"). The Scheduling Order and Standing Order require:

> Defendant serves preliminary invalidity contentions in the form of (1) a chart setting forth where in the prior art references each element of the asserted claim(s) are found, (2) an identification of any limitations the Defendant contends are indefinite or lack written description under section 112, and (3) an identification of any claims the Defendant contends are directed to ineligible subject matter under section 101. Defendant shall also produce (1) all prior art referenced in the invalidity contentions, and (2) technical documents, including software where applicable, sufficient to show the operation of the accused product(s).

On February 13, 2025, CardWare served Google with Infringement Contentions alleging infringement of claims 1, 2, 4-23 of U.S. Patent No. 10,339,520 (the "'520 Patent"); claims 1-23 of U.S. Patent No. 10,810,579 (the "'579 Patent"); claims 1-30 of U.S. Patent No. 11,176,538 (the "'538 Patent"); and claims 1-3, 15-53, 55-70, and 72 of U.S. Patent No. 11,620,634 (the "'534 Patent") (collectively, the "Asserted Claims" of the "Asserted Patents"). *See* Plaintiff

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examples of this anticipation and obviousness, along with the motivation to combine the selected prior art, are set forth in the attached Claim Charts (Exhibits A-01 through D-42) and Combinations Exhibit (Ex. I). The identification of obviousness combinations is not intended to be exhaustive, as there are many possible combinations of the references that one of ordinary skill in the art would have been motivated to make, and it is not practical to provide details of all such possible combinations, particularly at this early stage of the case.

The Scheduling Order (Dkt. 48) and the Standing Order contemplate that these Invalidity Contentions would be prepared and served in response to Plaintiff's Infringement Contentions. Defendant reserves the right to amend these Invalidity Contentions should Plaintiff amend its Infringement Contentions or its implicit claim constructions. Defendant also reserves the right to modify, amend, and/or supplement its Invalidity Contentions in light of positions that Plaintiff or its expert witnesses may assert concerning claim construction, infringement, and/or invalidity issues.[2] Defendant also reserves the right to modify, amend, and/or supplement its Invalidity Contentions in view of additional evidence, including third party evidence, produced in this matter in accordance with the Scheduling Order and Standing Order and/or as that information is produced in the ordinary course of discovery.

I. BACKGROUND AND STATE OF THE ART / SYSTEM PRIOR ART

A. Contactless Payments and Key Fobs

Contactless payment has been known since at least 1997. Exxon/Mobile, McDonalds and Bank of America launched contactless payment systems in the late 1990s and early 2000s. http://usatoday30.usatoday.com/tech/news/2001-05-29-mcdonalds-e-payments.htm,

[2] Defendant identifies and may rely upon references and arguments made in the following *inter partes* review petitions and related proceeding papers: IPR2023-00196, IPR2023-00210, IPR2023-00211, IPR2023-00219. Further, defendant may rely upon any *inter partes* or other ex parte proceeding brought against any Asserted Patent in the future.

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art products, devices, apparatuses, and systems, and their associated references anticipate and/or render obvious each of the Asserted Claims.

Defendant further intends to rely on inventor admissions concerning the scope of the prior art relevant to the Asserted Patent found in, *inter alia*, the prosecution history of the Asserted Patent and any related patents, patent applications, and/or post-grant proceedings including reexaminations and *inter partes* reviews; any deposition testimony of a named inventor on the Asserted Patent; and the papers filed and any evidence submitted by Plaintiff in conjunction with this litigation.

Discovery is in its earliest stages, and Defendant's prior art investigation, including via discovery and third-party discovery, is therefore not yet complete. Defendant reserves the right to rely upon additional evidence of invalidity obtained in the future, to the extent that further investigation and discovery yield information forming the basis for such claims.

A. Applicant-Admitted Prior Art[21]

The Asserted Patents admit that the following techniques and technology was known in the art:

- There are several different types of credit cards available in the marketplace at present. A first type of credit card is a conventional, standard piece of plastic with a magnetic strip, which is readily available and in wide commercial use. The advantage of this first type of credit card is that a large portion of the infrastructure for credit card transactions is

[21] This section is for illustrative purposes only, as it is not required by the Scheduling Order or Standing Order. As such, Defendant reserves all rights to contend that additional or different prior art was admitted by the applicant.

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operational features of these systems. This would have further motivated one of skill in the art to combine the prior art. In view of the simplicity of the claimed subject matter and its use of well-known components performing conventional operations, the common sense a person skilled in the art also would have served as a motivation to combine any of the identified references and demonstrates that the Asserted Claims of the Asserted Patents would have been obvious.

Defendant's attached exhibits contain claim charts identifying examples of prior art that anticipates and/or renders obvious each Asserted Claims of the Asserted Patents. Specifically, to the extent the attached claim charts cite to a reference for each element or limitation of an asserted claim, Defendant contends that such reference anticipates that claim. Defendant incorporates by reference each prior art reference of record in the prosecution of the Asserted Patent and related applications, including the statements made therein by the applicant, as well as the prior art discussed in the specification. Defendant further incorporates by reference all *inter partes* review proceedings and post-grant review proceedings filed in the future that challenge the patentability of any claim of the Asserted Patents, including all prior art, argument, and evidence. In addition, to the extent that the attached claim charts cite to additional references, Defendant contends, in the alternative, that the Asserted Claims are rendered obvious for the reasons set forth in the attached charts and exhibits. To the extent the attached claim charts do not identify any explicit disclosures of the prior art for a claim or claim limitation, Defendant contends those claims or claim limitations would have been obvious in view of the reference as a whole and/or the knowledge, skill, and experience of a person having ordinary skill in the art. To the extent any obviousness combinations are included in the attached charts and exhibits, they are provided in the alternative to Defendant's anticipation contentions and are not to be construed to suggest that any reference included in the combinations is not by itself anticipatory.

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DATED: April 3, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on the 3rd day of April, 2025, a true and correct copy of the foregoing document was served electronically on all counsel of record.

/s/ Matthias A. Kamber
Matthias A. Kamber

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