

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION**

IMAGINEAR, INC. and IMAGINE AR,
INC.,

Plaintiffs,

v.

NIANTIC, INC.

Defendant.

Civil Action No.

**DEFENDANT NIANTIC, INC.'S MOTION TO QUASH
PLAINTIFFS' SUBPOENA TO COOLEY LLP**

Movant Niantic, Inc. ("Niantic") pursuant to Federal Rule of Procedure 45, respectfully moves this Court for an Order quashing the subpoena issued by Plaintiffs ImagineAR, Inc. and Imagine AR, Inc. ("Plaintiffs") to non-party Cooley LLP in connection with the currently pending lawsuit in the U.S. District Court for Delaware: *ImagineAR, Inc. and Imagine AR, Inc. v. Niantic, Inc.*, No. 24-cv-01252-JDW (D. Del.). This motion is brought in the Eastern District of Virginia because the subpoena requires compliance in this District, although Cooley LLP is headquartered in the Northern District of California.

Niantic brings this motion under Federal Rule of Civil Procedure 45(d)(3)(A)(iii), which requires the court for the district where compliance is required (the Eastern District of Virginia) to quash a subpoena that requires disclosure of a protected matter. As set forth in detail in the accompanying Memorandum, this Court should grant Niantic's Motion and quash Plaintiffs' subpoena because Plaintiffs' subpoena (i) unduly burdens non-party Cooley LLP, including because it seeks production of materials already requested from a party to the litigation, (ii) seeks materials that fall squarely under the work product and attorney-client privilege protections, and

(iii) seeks irrelevant materials, including relating to a patent that has already been dismissed in the litigation pending in the District of Delaware.

For the reasons set forth above and in the accompanying Memorandum, the Declaration of Sarah E. Piepmeier and accompanying exhibits, and any other matter the Court may properly consider, Niantic respectfully requests that this Court enter an Order quashing Plaintiffs' subpoena to Cooley LLP.

Dated: September 11, 2025

Respectfully submitted,

By: /s/ Veronica S. Ascarrunz

Sarah E. Piepmeier (*pro hac vice* pending)
Nathan B. Sabri (*pro hac vice* pending)
Perkins Coie LLP
505 Howard Street, Suite 1000
San Francisco, California 94105-3204
(415) 344-7000
SPiepmeier@perkinscoie.com
NSabri@perkinscoie.com

Veronica S. Ascarrunz, VA Bar No. 67913
Perkins Coie LLP
700 Thirteenth Street N.W., Suite 800
Washington, DC 20005-3960
Phone: 202.654.6200
VAscarrunz@perkinscoie.com

Attorneys for Defendant Niantic, Inc.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on September 11, 2025, a true and correct copy of the foregoing document was served by email on Plaintiffs' counsel of record in the underlying litigation.

Dated: September 11, 2025

Respectfully submitted,

By: /s/ Veronica S. Ascarrunz

Sarah E. Piepmeier (*pro hac vice* pending)
Nathan B. Sabri (*pro hac vice* pending)
Perkins Coie LLP
505 Howard Street, Suite 1000
San Francisco, California 94105-3204
(415) 344-7000
SPiepmeier@perkinscoie.com
NSabri@perkinscoie.com

Veronica S. Ascarrunz, VA Bar No. 67913
Perkins Coie LLP
700 Thirteenth Street N.W., Suite 800
Washington, DC 20005-3960
Phone: 202.654.6200
VAscarrunz@perkinscoie.com

Attorneys for Defendant Niantic, Inc.

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION**

IMAGINEAR, INC. and IMAGINE AR,
INC.,

Plaintiffs,

v.

NIANTIC, INC.

Defendant.

Civil Action No.

NOTICE OF HEARING

PLEASE TAKE NOTICE THAT on Friday, October 10, 2025, at 10:00 a.m., or as soon thereafter as counsel may be heard, Defendant Niantic, Inc., will present oral argument in support of their Motion to Quash Plaintiffs' Subpoena to Cooley LLP.

Dated: September 11, 2025

By: /s/ Veronica S. Ascarrunz

Sarah E. Piepmeier (*pro hac vice* pending)
Nathan B. Sabri (*pro hac vice* pending)
Perkins Coie LLP
505 Howard Street, Suite 1000
San Francisco, California 94105-3204
(415) 344-7000
SPiepmeier@perkinscoie.com
NSabri@perkinscoie.com

Veronica S. Ascarrunz, VA Bar No. 67913
Perkins Coie LLP
700 Thirteenth Street N.W., Suite 800
Washington, DC 20005-3960
Phone: 202.654.6200
VAscarrunz@perkinscoie.com

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 11th day of September, 2025, a true and correct copy of the foregoing document was served by email on Plaintiffs' counsel of record in the underlying litigation.

Dated: September 11, 2025

By: /s/ Veronica S. Ascarrunz

Sarah E. Piepmeier (*pro hac vice* pending)
Nathan B. Sabri (*pro hac vice* pending)
Perkins Coie LLP
505 Howard Street, Suite 1000
San Francisco, California 94105-3204
(415) 344-7000
SPiepmeier@perkinscoie.com
NSabri@perkinscoie.com

Veronica S. Ascarrunz, VA Bar No. 67913
Perkins Coie LLP
700 Thirteenth Street N.W., Suite 800
Washington, DC 20005-3960
Phone: 202.654.6200
VAscarrunz@perkinscoie.com

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION**

IMAGINEAR, INC. and IMAGINE AR,
INC.,

Plaintiffs,

v.

NIANTIC, INC.

Defendant.

Civil Action No.

**DEFENDANT NIANTIC, INC.'S MEMORANDUM OF POINTS AND AUTHORITIES
IN SUPPORT OF MOTION TO QUASH PLAINTIFFS' SUBPOENA TO COOLEY LLP**

TABLE OF CONTENTS

I.	INTRODUCTION & SUMMARY.....	1
II.	FACTUAL BACKGROUND.....	2
III.	ARGUMENT.....	3
A.	Legal Standards.....	3
B.	Niantic Has Standing to Move to Quash Because the Information Plaintiffs Seek Is Niantic’s Privileged Information	5
C.	Plaintiffs’ Requests Seek Privileged Information from a Law Firm	5
D.	Plaintiffs’ Requests Are Irrelevant to the Litigation and/or Completely Speculative	8
IV.	CONCLUSION.....	9

TABLE OF AUTHORITIES

CASES	PAGE
<i>Found. to Support Animal Prot. v. Vital Farms, Inc.</i> , No. 2:22mc23, 2023 WL 3446200 (E.D. Va. Apr. 3, 2023).....	3, 7, 9
<i>Golden Trade, S.r.L. v. Jordache</i> , 143 F.R.D. 508 (S.D.N.Y. Aug. 10, 1992)	5, 7
<i>High Tech Med. Instrumentation, Inc. v. New Image Indus., Inc.</i> , 161 F.R.D. 86 (N.D. Cal. 1995).....	3
<i>In re Grand Jury Subpoena (Mark Torf/Torf Environmental Mgmt.)</i> , 357 F.3d 900 (9th Cir. 2004)	5
<i>In re Subpoena Duces Tecum to AOL, LLC</i> , 550 F. Supp. 2d 606 (E.D. Va. 2008)	3
<i>In re Subpoena to Power Integrations, Inc.</i> , No. 5:24-mc-80157-VKD, 2025 WL 55280 (N.D. Cal., Jan. 8, 2025)	6
<i>In re Subpoenas for Documents Issued to ThompsonMcMullan, P.C.</i> , No. 3:16-mc-1, 2016 WL 1071016 (E.D. Va. Mar. 17, 2016)	5
<i>Intex Recreation Corp. v. Bestway USA, Inc.</i> , 2024 WL 4404982, at *10 (C.D. Cal. Sep. 6, 2024).....	7
<i>Kovalnko v. Kirkland & Ellis LLP</i> , No. 22-cv-05990-HSG (TSH), 2024 WL 664691 (N.D. Cal. Feb. 16, 2024)	5
<i>NantWorks, LLC v Niantic, Inc.</i> , N.D. Cal, Case. No. 3-20-cv-06262.....	2
<i>Niantic, Inc. v. Nant Holdings IP, LLC</i> , IPR2021-01119 (PTAB June 15, 2021) (challenging U.S. Pat. No. 10,664,518)	2
<i>Niantic, Inc. v. Nant Holdings IP, LLC</i> , IPR2021-01133 (PTAB June 14, 2021) (challenging U.S. Pat. No. 10,403,051)	2
<i>Sawgrass Sys. Inc. v. BASF Aktiengesellschaft</i> , No. 99–CV–70242–DT, 1999 WL 358681 (E.D. Mich. Feb. 26, 1999)	7
<i>Sioux Steel Co. v. Prairie Land Millwright Services, Inc.</i> , No. 16 C 2212, 2020 WL 2900834 (N.D. Ill. Jun. 3, 2020)	7

<i>Soluble Tech. Grp., LLC v. Dreampak, LLC</i> , No. 3:21cv328 (MHL), 2022 WL 20563014 (E.D. Va. Mar. 22, 2022).....	4
<i>Stardock Sys., Inc. v. Reiche</i> , No. 4:17-cv-07025-SBA (KAW), 2018 WL6259536 (N.D. Cal. Nov. 30, 2018)	4
<i>Trans Union, LLC v. Scroggins</i> , No. 3:24-mc-2-MHL-SLS, 2024 WL 4124681 (E.D. Va. Sep. 9, 2024).....	9
<i>VLSI Tech. LLC v. Kirkland & Ellis LLP</i> , No. MC 18-63-RGK, 2018 WL 6930769 (C.D. Cal. Jun. 19, 2018).....	9

STATUTES

35 U.S.C. § 101	3
-----------------------	---

OTHER AUTHORITIES

Fed. R. Civ. P. 26(b)(3)(A)	4
Fed. R. Civ. P. 45(c)(1)	3, 9
Fed. R. Civ. P. 45(c)(3)(A)(iv)	3
Fed. R. Civ. P. Rule 26(c)(1)	9
Fed. R. Civ. P. 45	3, 8

**MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF NIAN TIC’S
MOTION TO QUASH**

I. INTRODUCTION & SUMMARY

Plaintiffs ImagineAR, Inc. (“ImagineAR”) and Imagine AR, Inc. (“IAR,” collectively, “Plaintiffs”) and Defendant Niantic, Inc. (“Niantic”) are litigating a multi-patent case in the United States District Court for the District of Delaware (“the Delaware matter”). Although the pleadings have not yet closed, Plaintiffs have broadly and aggressively subpoenaed multiple third parties, including two law firms—one who represented Niantic in unrelated litigation, and another who represented Nintendo (another third party) as patent prosecution counsel. Niantic respectfully moves to quash Plaintiffs’ subpoena to the Cooley LLP law firm because it seeks information related to prior art searches and other analyses conducted by attorneys, during active litigation, that is squarely covered by the attorney client privilege and work product doctrines.

Not only is the information Plaintiffs seek protected by privilege and work product, it is irrelevant to the underlying litigation. Based on arguments Plaintiffs have made in opposition to Niantic’s Motion to Dismiss in the underlying litigation, it appears that Plaintiffs seek this information because, on their theory, *if* Cooley LLP uncovered patents owned by Plaintiffs during the course of searching for prior art in connection with petitions for *inter partes* review (IPR) it previously filed in unrelated litigation on behalf of Niantic, *and* communicated that to Niantic, that constitutes “knowledge” of the asserted patents for purposes of willful infringement. But Judge Wolson has recently granted Niantic’s Motion to Dismiss pre-suit willfulness and inducement, so this tenuous theory is not relevant to any claims at issue in the Delaware litigation.

Niantic thus respectfully requests that the Court grant its Motion to Quash and protect the privileged and work product information prepared and communicated by the Cooley LLP law firm.

II. FACTUAL BACKGROUND

Cooley LLP was outside counsel to Niantic in a litigation entitled *NantWorks, LLC v Niantic, Inc.*, N.D. Cal, Case. No. 3-20-cv-06262. As part of that representation, Cooley LLP filed at least two IPR petitions challenging the patents asserted in that case. *Niantic, Inc. v. Nant Holdings IP, LLC*, IPR2021-01133 (PTAB June 14, 2021) (challenging U.S. Pat. No. 10,403,051); *Niantic, Inc. v. Nant Holdings IP, LLC*, IPR2021-01119 (PTAB June 15, 2021) (challenging U.S. Pat. No. 10,664,518). That district court and PTAB litigation is unrelated to the underlying litigation here – i.e., there are different asserted patents and a different patent owner, with no relationship between the plaintiffs or any other connection between the two cases. Cooley LLP is not outside counsel to Niantic in the Delaware matter between Plaintiffs and Niantic.

On June 10, 2025, in connection with the underlying litigation here, Plaintiffs served a subpoena on Cooley LLP, who timely served objections asserting privilege and met and conferred with Plaintiffs. In particular, Plaintiffs’ subpoena seeks the following three broad categories of documents from Cooley LLP:

1. All documents relating to Niantic’s Petitions for Inter Partes Review of U.S. Patent Nos. 10,664,518 (IPR2021-1119) and 10,403,051 (IPR2021-1133) (“the IPRs”), including all Prior Art that was considered for the petitions in the IPRs, all Prior Art that Cooley or Niantic was aware of before and during the IPRs, any Prior Art search reports provided to Cooley or Niantic in connection with the IPRs, and the results of any Prior Art searches conducted by, or for, Cooley or Niantic.
2. All documents relating to United States published patent application no. US201202766997, which led to U.S. Patent No. 8,579,710 and is cited on the face of the patent at issue in IPR2021-1119 (i.e., U.S. Patent No. 10,664,518).

3. All documents exchanged or discussed with Niantic relating to the Patents-in-Suit, the Related Patents, ImagineAR, XMG Studio, Inc., 2343127 Ontario, Imagination Park Technologies, or the Named Inventors.

Declaration of Sarah E. Piepmeier (“Piepmeier Decl.”), submitted herewith, Exh. 1 (Subpoena to Cooley). Plaintiffs also sought similar documents from Niantic through party discovery. Niantic objected, and the parties met and conferred and recently had a telephonic hearing on Plaintiffs’ motion to compel.

Plaintiffs asserted U.S. Pat. No. 8,579,710 (“the ’710 patent”), at issue in Request No. 2, in the Delaware matter, but Judge Wolson recently dismissed all claims related to the ’710 patent under 35 U.S.C. § 101. Piepmeier Decl., Exh. 2 (D. Del. Case No. 1:24-cv-01252-JDW, Doc. 63 (Sept. 8, 2025 Order)). The ’710 patent is thus no longer at issue in the Delaware matter.

III. ARGUMENT

A. Legal Standards

Fed. R. Civ. P. 45(c)(3)(A)(iv) requires the Court to quash a subpoena that subjects a person to undue burden. “A party or attorney responsible for issuing and serving a subpoena must take reasonable steps to avoid imposing undue burden or expense on a [nonparty] subject to the subpoena.” Fed. R. Civ. P. 45(c)(1). Hence, Rule 45 provides additional protection to nonparties in discovery. *Id.*; *see also In re Subpoena Duces Tecum to AOL, LLC*, 550 F. Supp. 2d 606 (E.D. Va. 2008) (quashing subpoena that was unduly burdensome due at least to its overbreadth); *Found. to Support Animal Prot. v. Vital Farms, Inc.*, No. 2:22mc23, 2023 WL 3446200, at *5 (E.D. Va. Apr. 3, 2023) (“In assessing a motion to quash, a court should be mindful that ‘nonparties faced with civil discovery requests deserve special solicitude.’”) (citations omitted, cleaned up); *High*

Tech Med. Instrumentation, Inc. v. New Image Indus., Inc., 161 F.R.D. 86, 88 (N.D. Cal. 1995) (“nonparties subject to discovery requests deserve extra protection from the courts”).

The attorney-client privilege is designed to “encourage full and frank communication between attorneys and their clients” and protects from discovery “communication[s] made between privileged persons in confidence for the purpose of seeking, obtaining, or providing legal assistance to a client.” *Soluble Tech. Grp., LLC v. Dreampak, LLC*, No. 3:21cv328 (MHL), 2022 WL 20563014, at *2 (E.D. Va. Mar. 22, 2022) (internal citations omitted). In the Fourth Circuit, the attorney-client privilege protects communications from discovery if: “(1) the asserted holder of the privilege is or sought to become a client; (2) the person to whom the communication was made (a) is a member of the bar of a court, or his subordinate and (b) in connection with this communication is acting as a lawyer; (3) the communication relates to a fact of which the attorney was informed (a) by his client (b) without the presence of strangers (c) for the purpose of securing primarily either (i) an opinion on law or (ii) legal services or (iii) assistance in some legal proceeding, and not (d) for the purpose of committing a crime or tort; and (4) the privilege has been (a) claimed and (b) not waived by the client.” *Id.* (citations omitted). Furthermore, the privilege may extend to “otherwise privileged communications that involve persons assisting the lawyer in the rendition of legal services.” *Stardock Sys., Inc. v. Reiche*, No. 4:17-cv-07025-SBA (KAW), 2018 WL6259536, at *3 (N.D. Cal. Nov. 30, 2018) (quashing a subpoena seeking communications between a PR firm and defendants’ counsel) (internal citations omitted).

Rule 26(b)(3) protects work product from discovery, including documents prepared by the party, its attorney, or an agent of the party or attorney. Fed. R. Civ. P. 26(b)(3)(A) (“Ordinarily, a party may not discover documents and tangible things that are prepared in anticipation of litigation or for trial by or for another party or its representative (including the other party’s attorney,

consultant, surety, indemnitor, insurer, or agent).”) (emphasis added). “At its core, the work-product doctrine shelters the mental processes of the attorney, providing a privileged area within which he can analyze and prepare his client’s case.” *In re Grand Jury Subpoena (Mark Torf/Torf Environmental Mgmt.)*, 357 F.3d 900, 907 (9th Cir. 2004) (quoting *United States v. Nobles*, 422 U.S. 225, 238 (1975)). Documents may be protected by the work-product doctrine even if they do not reflect analysis of an attorney in any meaningful way. *See, e.g., Golden Trade, S.r.L. v. Jordache*, 143 F.R.D. 508, 511 (S.D.N.Y. Aug. 10, 1992).

B. Niantic Has Standing to Move to Quash Because the Information Plaintiffs Seek Is Niantic’s Privileged Information

All of the information Plaintiffs seek is attorney-client privileged or work product (to the extent it exists). Niantic owns the attorney-client privilege because Cooley LLP represented Niantic in the unrelated litigation, and any of Cooley’s work product was created on Niantic’s behalf. *See Kovalnko v. Kirkland & Ellis LLP*, No. 22-cv-05990-HSG (TSH), 2024 WL 664691, at *3 (N.D. Cal. Feb. 16, 2024) (quoting *Knoll, Inc. v. Moderno, Inc.*, No. 12-mc-80193-SI, 2012 WL 4466543, at *2 (N.D. Cal. Sept. 26, 2012)) (“[A] party moving to quash a non-party subpoena has standing when the party has a personal right or privilege in the information sought to be disclosed.”); *In re Subpoenas for Documents Issued to ThompsonMcMullan, P.C.*, No. 3:16-mc-1, 2016 WL 1071016, at *4 (E.D. Va. Mar. 17, 2016) (a party has standing to challenge a subpoena where it imposes an undue burden on a third party and/or implicates any confidential or privileged material).

C. Plaintiffs’ Requests Seek Privileged Information from a Law Firm

Each of Plaintiffs’ requests seeks undeniably privileged information from a law firm (Cooley LLP) who represented defendant Niantic in prior, unrelated litigation against a different party. In particular, Plaintiffs seek two categories of information: (1) documents related to IPR

petitions that Cooley LLP filed on behalf of Niantic in completely unrelated litigation, including prior art considered or uncovered relating to those IPRs; and (2) communications with Niantic regarding Plaintiffs, its predecessor, and the patents asserted against Niantic in the underlying Delaware litigation.

Prior Art Searches. Plaintiffs’ apparent argument that work done by a law firm while representing a party in litigation is not protected by attorney client privilege and/or work product would fundamentally upend the protections lawyers and clients rely upon to efficiently manage litigation. If all Plaintiffs wanted was a list of the prior art on which Niantic relied in the (unrelated) IPRs, it could simply review those IPRs. But to compel the art that Niantic’s counsel uncovered and decided *not* to rely on in its IPRs would seek to invade that core protected thought process and protected communication between lawyer and client. Such an order would undoubtedly have a chilling effect on lawyers’ ability to conduct prior art searches and communicate with their clients regarding strategy.

For these reasons, Courts routinely deny requests seeking privileged information related to prior art searches. For example, in *In re Subpoena to Power Integrations*, the court denied a motion to compel Power Integration to comply with a subpoena request related to prior art searches because “CogniPower offer[ed] no persuasive justification for requiring Power Integrations to produce, or generate a privilege log for, prior art searches that were conducted in 2020 and are protected from disclosure by the attorney-client privilege and/or the attorney work product doctrine.” *In re Subpoena to Power Integrations, Inc.*, No. 5:24-mc-80157-VKD, 2025 WL 55280, at *1 (N.D. Cal., Jan. 8, 2025). Similarly, the court in *Intex Recreation Corporation* denied a motion to compel prior art searches, noting specifically that a “prior art search need not include information about an attorney’s ‘mental impressions’ or views to be protected as work-product.”

Intex Recreation Corp. v. Bestway USA, Inc., No. LA CV19-08596 JAK (Ex), 2024 WL 4404982, at *10 (C.D. Cal. Sep. 6, 2024). Finally, the court in *Golden Trade* evaluated precisely this issue and denied a motion to compel a list of patents identified in prior art search because the search “was made to aid in current [] litigation, and hence its fruits come squarely within the ambit of the work-product doctrine.” *Golden Trade, S.r.L.*, 143 F.R.D. at 511. The court explicitly rejected an argument that such a list sought “only ‘factual material,’” and not “any analysis by the searchers or [] attorney[,]” because it would allow the moving party “in effect to appropriate the research labors and, to a degree, the analysis of the attorney’s agent.” *Id.* The court reasoned that “the request for disclosure trenches not merely upon the literal definition of work product found in Rule 26(b)(3), but also upon one of the policies embodied by the rule, which is to preclude one attorney from performing his function either without wits or on wits borrowed from the adversary.” *Id.* (cleaned up; internal quotations and citations omitted); *see also Sioux Steel Co. v. Prairie Land Millwright Services, Inc.*, No. 16 C 2212, 2020 WL 2900834, at *3 (N.D. Ill. Jun. 3, 2020) (“prior art searches conducted in anticipation of litigation constitute work product and are protected from disclosure”); *Sawgrass Sys. Inc. v. BASF Aktiengesellschaft*, No. 99–CV–70242–DT, 1999 WL 358681, at *4 (E.D. Mich. Feb. 26, 1999) (denying motion to compel prior art search results because a “prior art search is analogous to an attorney’s selection and compilation of documents in anticipation of litigation, which is protected by the work-product doctrine”).

Communications Between Cooley LLP and Its Client Niantic. This is the essence of attorney client privilege, and there is no justification for ordering its disclosure. *See, e.g., Loop AI*, 2016 WL 730211, at *3; *Found. to Support Animal Prot.*, 2023 WL 3446200, at *8 (quashing subpoena request that “encompasses opposing counsel’s litigation file” because “free-ranging attempts at obtaining discovery from opposing counsel is a particularly ugly type of discovery”

and “pursuant to rule 45, a court not only should but *must* quash a subpoena that “requires disclosure of privileged or other protected matter.”) (citations omitted, cleaned up, emphasis original). There can be no argument that Niantic has waived privilege over its communications with its outside counsel. This is simply a broad fishing expedition that squarely seeks privileged information.

D. Plaintiffs’ Requests Are Irrelevant to the Litigation and/or Completely Speculative

First, Request 2 is wholly irrelevant because the Delaware Court has recently invalidated Plaintiffs’ U.S. Patent No. 8,579,710, so any alleged knowledge of that patent is not relevant to the remaining claims or defenses in the Delaware litigation. Piepmeier Decl., Exh. 2 at 1; *see also* FN 4 (“Because I have determined that the ’710, ’746, and ’592 Patents are invalid, I am dismissing IAR’s claims on that basis and need not consider whether the FAC’s factual allegations state claims for indirect or willful infringement as to those patents.”)

Second, Request 1 (and 2) target information related to IPR petitions Cooley LLP filed in a prior, unrelated lawsuit against a different party and involving different patents, making it irrelevant to the Delaware suit. The patents Niantic challenged in those IPRs (U.S. Patent Nos. 10,664,518 and 10,403,051) are not asserted here. To the extent Plaintiffs contend the information sought would somehow relate to pre-suit willfulness, the Court has recently dismissed such claims in the Delaware matter, so there is no basis to seek this discovery. Piepmeier Decl., Exh. 2 at 1 (granting Niantic’s Motion to Dismiss pre-suit willfulness and inducement because there are no plausible allegations that Niantic was aware of alleged infringement). Moreover, even if Plaintiffs’ fishing expedition could turn up a list of patents that Cooley LLP was aware of, this would not amount to *Niantic’s* knowledge of the asserted patents, let alone their alleged infringement. Thus, even if Plaintiffs were able to overcome the work product and privilege issues discussed above, the burden their irrelevant requests would unduly place on non-party Cooley LLP cannot be

justified. *See, e.g., VLSI Tech. LLC v. Kirkland & Ellis LLP*, No. MC 18-63-RGK (PLAx), 2018 WL 6930769, at *3 (C.D. Cal. Jun. 19, 2018) (denying a motion to compel production pursuant to a subpoena in part because the “subpoena demands excess documents... that are not relevant to the underlying claims or proportional to the needs of the underlying case”); *Trans Union, LLC v. Scroggins*, No. 3:24-mc-2-MHL-SLS, 2024 WL 4124681, at *4 (E.D. Va. Sep. 9, 2024) (quoting *In re Subpoenas for Documents Issued to ThompsonMcMullan*, 2016 WL 1071016, at *5) (“A party may seek to quash or modify a subpoena on grounds of irrelevance or overbreadth, even though irrelevance and overbreadth are not explicitly listed as grounds to quash in Rule 26(c)(1) or Rule 45(c)(1), because either irrelevance or overbreadth necessarily establishes undue burden.”).

Finally, as to Request 3, there is no reason to believe that any communications relevant to Plaintiffs or the patents asserted in the Delaware matter exist in the first place—Cooley LLP represented Niantic in a completely unrelated lawsuit that nothing to do with Plaintiffs, their patents, or their predecessor. And even if they did, as noted above, they would be privileged.

IV. CONCLUSION

For the reasons stated, Niantic respectfully requests that the Court quash Plaintiffs’ subpoena to third party law firm Cooley LLP.

Dated: September 11, 2025

Respectfully submitted,

By: /s/ Veronica S. Ascarrunz

Sarah E. Piepmeier (*pro hac vice* pending)
Nathan B. Sabri (*pro hac vice* pending)
Perkins Coie LLP
505 Howard Street, Suite 1000
San Francisco, California 94105-3204
(415) 344-7000
SPiepmeier@perkinscoie.com
NSabri@perkinscoie.com

Veronica S. Ascarrunz, VA Bar No. 67913
Perkins Coie LLP
700 Thirteenth Street N.W., Suite 800
Washington, DC 20005-3960
Phone: 202.654.6200
VAscarrunz@perkinscoie.com

Attorneys for Defendant Niantic, Inc.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on September 11, 2025, a true and correct copy of the foregoing document was served by email on Plaintiffs' counsel of record in the underlying litigation.

Dated: September 11, 2025

By: /s/ Veronica S. Ascarrunz

Sarah E. Piepmeier (*pro hac vice* pending)
Nathan B. Sabri (*pro hac vice* pending)
Perkins Coie LLP
505 Howard Street, Suite 1000
San Francisco, California 94105-3204
(415) 344-7000
SPiepmeier@perkinscoie.com
NSabri@perkinscoie.com

Veronica S. Ascarrunz, VA Bar No. 67913
Perkins Coie LLP
700 Thirteenth Street N.W., Suite 800
Washington, DC 20005-3960
Phone: 202.654.6200
VAscarrunz@perkinscoie.com

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION**

IMAGINEAR, INC. and IMAGINE AR,
INC.,

Plaintiffs,

v.

NIANTIC, INC.

Defendant.

Civil Action No.

DECLARATION OF SARAH E. PIEPMEIER IN SUPPORT OF MOTION TO QUASH

I, Sarah E. Piepmeier, hereby declare:

1. I am an attorney with the law firm Perkins Coie LLP, based in San Francisco, California, and I am lead counsel representing Defendant Niantic, Inc. (“Niantic”). I have personal knowledge of the facts set forth in this declaration and am competent to testify.

2. Attached hereto as Exhibit 1 is a true and correct copy of the Subpoena to Produce Documents, Information, or Objects or to Permit Inspection of Premises in a Civil Action that Plaintiffs ImagineAR, Inc. and Imagine AR, Inc. served on Cooley LLP (“Subpoena to Cooley”).

3. Attached hereto as Exhibit 2 is a true and correct copy of the Court’s Memorandum accompanying the September 8, 2025 Order issued in *ImagineAR, Inc. v. Niantic, Inc.*, No. 1:24-cv-01252-JDW (D. Del. Sept. 8, 2025), ECF No. 63.

I declare under penalty of perjury pursuant to 28 U.S.C. § 1746 that the foregoing is true and correct to the best of my knowledge.

Executed on September 11, 2025 in San Francisco, California.

/s/ Sarah E. Piepmeier
Sarah E. Piepmeier

EXHIBIT 1

UNITED STATES DISTRICT COURT

for the
District of Delaware

IMAGINEAR, INC. and IMAGINE AR, INC.,

Plaintiff

v.

NIANTIC, INC.

Defendant

Civil Action No. 24-cv-01252-JDW

**SUBPOENA TO PRODUCE DOCUMENTS, INFORMATION, OR OBJECTS
OR TO PERMIT INSPECTION OF PREMISES IN A CIVIL ACTION**To: COOLEY LLP
c/o Corporation Service Company, 100 Shockoe Slip Fl 2, RICHMOND, VA, 23219 - 4100, USA*(Name of person to whom this subpoena is directed)*

☒ **Production:** **YOU ARE COMMANDED** to produce at the time, date, and place set forth below the following documents, electronically stored information, or objects, and to permit inspection, copying, testing, or sampling of the material: See attached, Schedule A.

Plaintiffs request that you produce the requested documents by sending copies to the law firm of Greenberg Traurig LLP, 360 North Green Street, Suite 1300, Chicago, IL 60607, Attn: James J. Lukas, Jr.

Place: Greenberg Traurig, 1750 Tysons Boulevard, Suite
1000, McLean, VA 2210

Date and Time:

07/11/2025 5:00 pm

☐ **Inspection of Premises:** **YOU ARE COMMANDED** to permit entry onto the designated premises, land, or other property possessed or controlled by you at the time, date, and location set forth below, so that the requesting party may inspect, measure, survey, photograph, test, or sample the property or any designated object or operation on it.

Place:

Date and Time:

The following provisions of Fed. R. Civ. P. 45 are attached – Rule 45(c), relating to the place of compliance; Rule 45(d), relating to your protection as a person subject to a subpoena; and Rule 45(e) and (g), relating to your duty to respond to this subpoena and the potential consequences of not doing so.

Date: June 10, 2025

CLERK OF COURT

OR

/s/ James J. Lukas, Jr.Signature of Clerk or Deputy ClerkAttorney's signature

The name, address, e-mail address, and telephone number of the attorney representing *(name of party)* ImagineAR, Inc.
and Imagine AR, Inc. _____, who issues or requests this subpoena, are:

James J. Lukas, Jr.; lukasj@gtlaw.com; 360 North Green Street, Suite 1300, Chicago, IL 60607; (312) 456-1038

Notice to the person who issues or requests this subpoena

If this subpoena commands the production of documents, electronically stored information, or tangible things or the inspection of premises before trial, a notice and a copy of the subpoena must be served on each party in this case before it is served on the person to whom it is directed. Fed. R. Civ. P. 45(a)(4).

Civil Action No. 24-cv-01252-JDW

PROOF OF SERVICE*(This section should not be filed with the court unless required by Fed. R. Civ. P. 45.)*

I received this subpoena for *(name of individual and title, if any)* _____
 on *(date)* _____.

☐ I served the subpoena by delivering a copy to the named person as follows: _____
 _____ on *(date)* _____; or

☐ I returned the subpoena unexecuted because: _____
 _____.

Unless the subpoena was issued on behalf of the United States, or one of its officers or agents, I have also
 tendered to the witness the fees for one day's attendance, and the mileage allowed by law, in the amount of
 \$ _____.

My fees are \$ _____ for travel and \$ _____ for services, for a total of \$ 0.00.

I declare under penalty of perjury that this information is true.

Date: _____

Server's signature

Printed name and title

Server's address

Additional information regarding attempted service, etc.:

Federal Rule of Civil Procedure 45 (c), (d), (e), and (g) (Effective 12/1/13)**(c) Place of Compliance.**

(1) For a Trial, Hearing, or Deposition. A subpoena may command a person to attend a trial, hearing, or deposition only as follows:

- (A) within 100 miles of where the person resides, is employed, or regularly transacts business in person; or
- (B) within the state where the person resides, is employed, or regularly transacts business in person, if the person
 - (i) is a party or a party's officer; or
 - (ii) is commanded to attend a trial and would not incur substantial expense.

(2) For Other Discovery. A subpoena may command:

- (A) production of documents, electronically stored information, or tangible things at a place within 100 miles of where the person resides, is employed, or regularly transacts business in person; and
- (B) inspection of premises at the premises to be inspected.

(d) Protecting a Person Subject to a Subpoena; Enforcement.

(1) Avoiding Undue Burden or Expense; Sanctions. A party or attorney responsible for issuing and serving a subpoena must take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena. The court for the district where compliance is required must enforce this duty and impose an appropriate sanction—which may include lost earnings and reasonable attorney's fees—on a party or attorney who fails to comply.

(2) Command to Produce Materials or Permit Inspection.

(A) *Appearance Not Required.* A person commanded to produce documents, electronically stored information, or tangible things, or to permit the inspection of premises, need not appear in person at the place of production or inspection unless also commanded to appear for a deposition, hearing, or trial.

(B) *Objections.* A person commanded to produce documents or tangible things or to permit inspection may serve on the party or attorney designated in the subpoena a written objection to inspecting, copying, testing, or sampling any or all of the materials or to inspecting the premises—or to producing electronically stored information in the form or forms requested. The objection must be served before the earlier of the time specified for compliance or 14 days after the subpoena is served. If an objection is made, the following rules apply:

- (i) At any time, on notice to the commanded person, the serving party may move the court for the district where compliance is required for an order compelling production or inspection.
- (ii) These acts may be required only as directed in the order, and the order must protect a person who is neither a party nor a party's officer from significant expense resulting from compliance.

(3) Quashing or Modifying a Subpoena.

(A) *When Required.* On timely motion, the court for the district where compliance is required must quash or modify a subpoena that:

- (i) fails to allow a reasonable time to comply;
- (ii) requires a person to comply beyond the geographical limits specified in Rule 45(c);
- (iii) requires disclosure of privileged or other protected matter, if no exception or waiver applies; or
- (iv) subjects a person to undue burden.

(B) *When Permitted.* To protect a person subject to or affected by a subpoena, the court for the district where compliance is required may, on motion, quash or modify the subpoena if it requires:

- (i) disclosing a trade secret or other confidential research, development, or commercial information; or

(ii) disclosing an unretained expert's opinion or information that does not describe specific occurrences in dispute and results from the expert's study that was not requested by a party.

(C) *Specifying Conditions as an Alternative.* In the circumstances described in Rule 45(d)(3)(B), the court may, instead of quashing or modifying a subpoena, order appearance or production under specified conditions if the serving party:

- (i) shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship; and
- (ii) ensures that the subpoenaed person will be reasonably compensated.

(e) Duties in Responding to a Subpoena.

(1) Producing Documents or Electronically Stored Information. These procedures apply to producing documents or electronically stored information:

(A) *Documents.* A person responding to a subpoena to produce documents must produce them as they are kept in the ordinary course of business or must organize and label them to correspond to the categories in the demand.

(B) *Form for Producing Electronically Stored Information Not Specified.* If a subpoena does not specify a form for producing electronically stored information, the person responding must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms.

(C) *Electronically Stored Information Produced in Only One Form.* The person responding need not produce the same electronically stored information in more than one form.

(D) *Inaccessible Electronically Stored Information.* The person responding need not provide discovery of electronically stored information from sources that the person identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the person responding must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the court may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of Rule 26(b)(2)(C). The court may specify conditions for the discovery.

(2) Claiming Privilege or Protection.

(A) *Information Withheld.* A person withholding subpoenaed information under a claim that it is privileged or subject to protection as trial-preparation material must:

- (i) expressly make the claim; and
- (ii) describe the nature of the withheld documents, communications, or tangible things in a manner that, without revealing information itself privileged or protected, will enable the parties to assess the claim.

(B) *Information Produced.* If information produced in response to a subpoena is subject to a claim of privilege or of protection as trial-preparation material, the person making the claim may notify any party that received the information of the claim and the basis for it. After being notified, a party must promptly return, sequester, or destroy the specified information and any copies it has; must not use or disclose the information until the claim is resolved; must take reasonable steps to retrieve the information if the party disclosed it before being notified; and may promptly present the information under seal to the court for the district where compliance is required for a determination of the claim. The person who produced the information must preserve the information until the claim is resolved.

(g) Contempt.

The court for the district where compliance is required—and also, after a motion is transferred, the issuing court—may hold in contempt a person who, having been served, fails without adequate excuse to obey the subpoena or an order related to it.

SCHEDULE A

DEFINITIONS

1. “You,” “Your,” and/or “Cooley” refers to Cooley LLP, including without limitation all of its corporate locations, and all predecessors, successors, subsidiaries, parents, assignees, assignors, and affiliates, and all past or present directors, officers, shareholders, agents, representatives, employees, consultants, attorneys, accountants, entities acting in joint venture or partnership with or having investment relationships with Cooley LLP and others acting in cooperation with or on behalf of Cooley LLP.

2. “ImagineAR” means Plaintiffs ImagineAR, Inc. and Imagine AR, Inc.

3. “Niantic” means Defendant Niantic, Inc., including without limitation all of its corporate locations, and all predecessors, successors, subsidiaries, parents, assignees, assignors, and affiliates, and all past or present directors, officers, shareholders, agents, representatives, employees, consultants, attorneys, accountants, entities acting in joint venture or partnership with or having investment relationships with Niantic, Inc. and others acting in cooperation with or on behalf of Niantic, Inc.

4. The terms “document” and “documents” are used herein in the broadest sense permissible under Rule 34 of the Federal Rules of Civil Procedure, and include, but are not limited to, any things, any written, recorded or tangible graphic matter, or any other means of preserving data, expression, facts, opinions, thought, images, or other information of any kind, including without limitation all non-identical copies, drafts, out takes, subsequent versions, worksheets and proofs, however created or recorded, including without limitation audio tapes, annotations, calendars, correspondence, data or information of any kind recorded on compact disks, digital video diskettes, or any other type or form of diskettes for use with computers or other electronic

devices, or any hard drive, diary entries, electronic recordings of any kind, e-mail, memoranda, notes, photographs, reports, telephone slips and logs, video cartridges and videotapes, and sites, databases, or other means of information storage or retrieval on the Internet or the World Wide Web. These terms are to be interpreted broadly to include documents stored in *any* medium and specifically includes electronically stored information (“ESI”) such as e-mail and documents maintained in electronic form on Cooley’s websites, servers, and stand alone computers and hard drives.¹

5. “Person” or “persons” means any individual or firm, association, organization, joint venture, trust, partnership, corporation, or other collective organization or entity.

6. “Entity” means any person.

7. “Patents-in-Suit” means United States Patent Nos. U.S. 8,777,746 (“the ’746 patent”); U.S. 8,668,592 (“the ’592 patent”); U.S. 8,579,710 (“the ’710 patent”); U.S. 10,946,284 (“the ’284 patent”); U.S. 11,484,797 (“the ’797 patent”); U.S. 11,666,827 (“the ’827 patent”); and U.S. 12,070,691 (“the ’691 patent”).

8. “The Asserted Claims” means the patent claims identified in ImagineAR’s First Amended Complaint and ImagineAR’s infringement contentions, including any amendments thereto.

9. “Prior Art” includes any documents, event, thing, or subject matter of the type set forth in or relevant under 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

¹ ESI includes, but is not be limited to, all text files (including word processing documents), spread sheets, e-mail files and information concerning e-mail (including all metadata fields, logs of e-mail history and usage, header information and “deleted” files including all potentially relevant data contained in free or slack space), Internet history files and preferences, graphical image format (“GIF”), tagged image file format (“TIFF”), portable document format (“PDF”) files, databases, contacts, tasks, calendar and scheduling information, computer system activity logs, all file fragments, and backup files containing Electronic Data.

10. “Related Patents” means all U.S. and foreign patents and applications relating in whole or in part to the Patents-in-Suit, including but not limited to any patents and applications to which the Patents-in-Suit claim priority (including provisional applications) and any continuations, continuations-in-part, divisional, reissues, reexaminations, and/or any other patent asserted in any amended complaint.

11. “Named Inventors” means any of the named inventors of the Patents-in-Suit and/or the Related Patents, including but not limited to: Oliver (Lake) Watkins, Jr., Yousef Chowdhary, Jeffrey Brunet, and Ravinder (Ray) Sharma.

12. “Predecessor-in-Interest” means any person or entity, other than ImagineAR, with any ownership interest in the Patents-in-Suit and/or the Related Patents at any time, including without limitation all of their corporate locations, and all predecessors, successors, subsidiaries, parents, assignees, assignors, and affiliates, and all past or present directors, officers, shareholders, agents, representatives, employees, consultants, attorneys, accountants, entities acting in joint venture or partnership with or having investment relationships with the Predecessor-in-Interest, and others acting in cooperation with or on behalf of the Predecessor-in-Interest.

13. “Accused Products” means the products ImagineAR identified in its Complaint.

14. “Related Litigations” means any litigation, administrative proceeding, arbitration, mediation, lawsuit, post-grant proceedings, International Trade Commission action, settlement, or other legal action involving any of the Patents-in-Suit or the Accused Products and any appeal.

15. “Including” means including but not limited to.

16. “All” shall be construed to include “any” and “each,” “any” shall be construed to include “all” and “each,” and “each” shall be construed to include “all” and “any,” in each case as

is necessary to bring within the scope of these Requests documents and things that might otherwise be construed as outside their scope.

17. The term “relating” includes but is not limited to the following meanings: pertaining, concerning, referring, discussing, mentioning, containing, reflecting, evidencing, constituting, describing, showing, identifying, proving, disproving, consisting of, supporting, contradicting, in any way legally, logically, or factually connected with the matters referenced.

18. The singular form of a word should be interpreted in the plural as well. Any pronoun shall be construed to refer to the masculine, feminine, or neuter gender, whichever in each case is broadest. The words “and” and “or” shall be construed conjunctively or disjunctively, whichever makes the Request more inclusive.

19. “The Litigation” means the above-referenced civil action filed by ImagineAR against Niantic, C.A. No. 24-01252- JDW, D. Del.

INSTRUCTIONS

1. These requests shall apply to all items (*e.g.*, documents or things) in your possession, custody, or control at the present time, as well as all items that come into your possession, custody, or control. If you know of the existence, past or present, of any items requested below, but are unable to produce such items because they are not presently in your possession, custody or control, you shall so state and shall provide a written statement setting forth:

- (a) the identity of the item;
- (b) the nature of the item (*e.g.*, letter, memorandum, or chart);
- (c) the identity of the person(s) who created (*e.g.*, authored) the item;
- (d) the identity of any person who received a copy of the item;
- (e) the date of the item;

- (f) a brief description of the subject matter of the item; and
- (g) the identity of any person who has possession, custody, or control of the item.

2. If no documents are responsive to a particular request, state that no responsive documents exist.

3. For any responsive items (*e.g.*, documents or things) that have been lost, destroyed, withheld from production, or redacted, for any reason, you shall provide a written statement setting forth:

- (a) the identity of the item;
- (b) the nature of the item (*e.g.*, letter, memorandum, or chart);
- (c) the identity of the persons(s) who created (*e.g.*, authored) the item;
- (d) the identity of any person who received a copy of the item;
- (e) the date of the item;
- (f) a brief description of the subject matter of the item; and
- (g) the circumstances of the loss or destruction of the item or any fact, statute, rule, or decision upon which you rely in withholding or redacting the item.

4. If you decline to produce any document or part thereof based on a claim of privilege or any other claim, describe the nature and basis of your claim and the information withheld in a manner sufficient:

- (a) to disclose the facts upon which you rely in asserting your claim;
- (b) to permit the grounds and reasons for withholding the information to be unambiguously identified; and
- (c) to permit the information withheld to be unambiguously identified.

5. All documents requested are to be produced in the same file or other organizational environment in which they are maintained. For example, a document that is part of a file, docket, or other grouping should be physically produced together with all other documents from said file, docket or grouping, in the same order or manner of arrangement as in the original.

6. You shall keep and produce a record of the source of each document produced. This shall include the name and location of the file where each document was located and the name of the person, group, or department having possession, custody, or control of each document.

7. You may elect to produce the requested documents by sending copies of the documents to the law firm of Greenberg Traurig, Attn: James J. Lukas, Jr., 360 N. Green Street, Suite 1300, Chicago, IL 60607 via hand delivery, Federal Express or any other form of delivery.

DOCUMENT REQUESTS

REQUEST NO. 1: All documents relating to Niantic’s Petitions for *Inter Partes* Review of U.S. Patent Nos. 10,664,518 (IPR2021-1119) and 10,403,051 (IPR2021-1133) (“the IPRs”), including all Prior Art that was considered for the petitions in the IPRs, all Prior Art that Cooley or Niantic was aware of before and during the IPRs, any Prior Art search reports provided to Cooley or Niantic in connection with the IPRs, and the results of any Prior Art searches conducted by, or for, Cooley or Niantic.

REQUEST NO. 2: All documents relating to United States published patent application no. US201202766997, which led to U.S. Patent No. 8,579,710 and is cited on the face of the patent at issue in IPR2021-1119 (*i.e.*, U.S. Patent No. 10,664,518).

REQUEST NO. 3: All documents exchanged or discussed with Niantic relating to the Patents-in-Suit, the Related Patents, ImagineAR, XMG Studio, Inc., 2343127 Ontario, Imagination Park Technologies, or the Named Inventors.

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

IMAGINEAR, INC. and IMAGINE AR,	)	
INC.,	)	
	)	
Plaintiffs,	)	C.A. No. 24-1252-JDW
	)	
v.	)	
	)	
NIANTIC, INC.,	)	
	)	
Defendant.	)	

PROTECTIVE ORDER

Plaintiffs ImagineAR, Inc. and Imagine AR (collectively, “Plaintiffs”) and Defendant Niantic, Inc. (“Defendant”) stipulate, pursuant to Rule 26(c) of the Federal Rules of Civil Procedure, that the following Protective Order may be entered by the Court:

I. PROCEEDINGS AND INFORMATION GOVERNED

1. This Order (“Protective Order”) is made under Fed. R. Civ. P. 26(c). It governs any document, information, or other thing furnished by any party to any other party, and it includes any non-party who receives a subpoena in connection with this action, subject to the consent of that non-party to its application thereto. For purposes of this Protective Order only, any non-party that produces information subject hereto shall be considered a “party” as that term is used herein. The information protected includes, but is not limited to: answers to interrogatories; answers to requests for admission; responses to requests for production of documents; deposition transcripts and videotapes; deposition exhibits; results or documentation of inspection or testing under Federal Rule of Civil Procedure 34; and other writings or things produced, given or filed in this action that are designated by a party as “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” or “Confidential” in accordance with the terms of this Protective

Order, as well as to any copies, excerpts, abstracts, analyses, summaries, descriptions, or other forms of recorded information containing, reflecting, or disclosing such information.

II. DESIGNATION AND MAINTENANCE OF INFORMATION

2. For purposes of this Protective Order, the “Highly Confidential - Outside Counsel’s Eyes Only” designation means that the document or thing contains extremely sensitive confidential information or items, disclosure of which to another Party or Non-Party would create a substantial risk of serious harm that could not be avoided by less restrictive means. As nonlimiting examples, this includes nonpublic information related to (1) patent applications that are not yet published; (2) highly sensitive information regarding manufacturing specifications or procedures or technical information, including research and development, product testing, prototypes, and designs for unreleased products; (3) commercial or licensing agreements and communications; (4) information capable of being utilized for the preparation or prosecution of a patent application, that is not publicly known and is of technical or commercial advantage to its possessor the disclosure of which is likely to cause harm to the competitive position of the producing party; or (5) highly sensitive financial and economic information, including financial planning, financial performance, financial business plans, competitive strategies, and business relationships. “Highly Confidential - Outside Counsel’s Eyes Only” does not include, and this Protective Order does not apply to, information that has been disclosed to the public or third persons in a manner making such information no longer confidential.

3. For purposes of this Protective Order, the “Highly Confidential - Source Code” designation means that the document or thing contains extremely sensitive confidential information or items representing computer code and associated comments and revision histories, formulas, engineering specifications, or schematics that define or otherwise describe in detail the

algorithms or structure of software or hardware designs, disclosure of which to another party or non-party would create a substantial risk of serious harm that could not be avoided by less restrictive means.

4. For purposes of this Protective Order, the “Confidential” designation means that the document or thing is comprised of commercial information that is not publicly known and is of technical or commercial advantage to its possessor, in accordance with Fed. R. Civ. P. 26(c)(1)(G), or other information required by law or agreement to be kept confidential and includes information that the producing party deems sensitive, which may include, but is not limited to, confidential research and development, financial, technical, marketing, product testing, or any other sensitive information for commercially sold products. “Confidential” does not include, and this Protective Order does not apply to, information that has been disclosed to the public or third persons in a manner making such information no longer confidential.

5. Documents and things produced during the course of this litigation within the scope of paragraphs 2-4 above may be designated by the producing party as containing “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” or “Confidential” information by placing on each page and each thing the applicable legend below:

HIGHLY CONFIDENTIAL - OUTSIDE COUNSEL’S EYES ONLY

or

HIGHLY CONFIDENTIAL - SOURCE CODE

or

CONFIDENTIAL

A party may designate information disclosed at a deposition as “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” or “Confidential” by requesting the

reporter to so designate the transcript or any portion of the transcript at the time of the deposition. If no such designation is made at the time of the deposition, any party will have fourteen (14) calendar days after receiving a finalized transcript or recording of the deposition to designate, to the other parties and to the court reporter, whether the transcript is to be designated as “Highly Confidential - Outside Counsel’s Eyes Only” or “Confidential.” If no such designation is made at the deposition or within this fourteen (14) calendar day period (during which period, the transcript must be treated as “Highly Confidential - Outside Counsel’s Eyes Only,” unless the disclosing party consents to less confidential treatment of the information), the entire deposition will be considered devoid of “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” or “Confidential” information. It is the responsibility of counsel for each party to maintain materials containing “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” or “Confidential” information in a secure manner and appropriately identified so as to allow access to such information only to such persons and under such terms as is permitted under this Protective Order.

III. INADVERTENT FAILURE TO DESIGNATE

6. Except as set forth in paragraphs 2-4, the inadvertent failure to designate or withhold any information as confidential will not be deemed to waive a later claim as to its confidential nature, or to stop the producing party from later designating such information as confidential at a later time. Any notice concerning the designation or re-designation of a document or thing shall be made within a reasonable time after discovery of inadvertent disclosure and shall be made in writing and state with particularity that such information contains “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” or “Confidential” information. The information must be treated by the receiving party as “Highly Confidential -

Outside Counsel's Eyes Only," "Highly Confidential - Source Code," or "Confidential" (as indicated by the producing party) from the time the receiving party is notified in writing of the change in the designation. Also, upon receipt of such notice, and upon receipt of a properly labeled document or thing within the scope of paragraph 5 above, the receiving party or parties shall promptly return to the producing party's counsel or destroy each unmarked or improperly marked document or thing (and any copies that may have been made). The receiving party or parties shall, to the extent reasonably possible, cooperate in restoring the appropriate level of confidentiality of such inadvertently produced document or thing.

7. If a party through inadvertence produces or provides discovery that it believes is subject to a claim of privilege, work product immunity, or is otherwise protected from disclosure, the producing party may give prompt written notice to the receiving party or parties that the discovery is subject to a claim of privilege, work product immunity, or other protection from disclosure and request that the discovery be returned to the producing party. The receiving party or parties shall destroy or return to the producing party such inadvertently produced discovery, and all copies and derivations within five (5) business days of receiving a written request for the return of the information. Return of the discovery by the receiving party shall not constitute an admission or concession, or permit any inference, that the returned document or thing is, in fact, properly subject to a claim of privilege, work product immunity, or other protection from disclosure, nor shall it foreclose any party from moving the Court for an order that such document or thing has been improperly designated or should be discoverable and usable in this action for reasons other than a waiver caused by the inadvertent production or providing of discovery. If such a motion is made, the burden of proof to show that a document or thing is entitled to a claim of privilege, work product immunity, or is otherwise protected from disclosure shall be on the producing party.

IV. PROCEDURE FOR OBJECTION TO DESIGNATION

8. At any time prior to the final pretrial conference in this action, any party may object in good faith to the designation or re-designation of any “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” or “Confidential” information by providing counsel for the producing party with written notice of the reasons for its objection. The producing party shall within ten (10) business days after receiving such written notice, advise the objecting party, in writing, of the basis for its designation. Within five (5) business days thereafter, the parties shall confer in a good faith effort to resolve the matter. Failing such resolution, the receiving party shall then have ten (10) business days from that conference (the “Motion Period”) to apply to the Court for relief or the objection is waived. The producing party retains the burden of establishing that the information was properly designated.

V. DISCLOSURE AND USE OF CONFIDENTIAL INFORMATION

9. Information designated as “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” or “Confidential” may only be used for purposes of preparation, trial, and appeal of this action. No “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” or “Confidential” information may be used under any circumstances for any other proceeding, for prosecuting any patent application, for patent licensing, or for any other business, competitive, or other purpose.

10. Subject to paragraph 12 below, “Highly Confidential - Outside Counsel’s Eyes Only” and “Highly Confidential - Source Code” information may be disclosed by the receiving party only to the following individuals, provided that such individuals are informed of and have agreed in writing to the terms of this Protective Order prior to the disclosure to them of the “Highly Confidential - Outside Counsel’s Eyes Only” or “Highly Confidential - Source Code” information:

(a) outside counsel for the receiving party in this action; (b) supporting personnel employed by outside counsel (a), such as paralegals, legal secretaries, data entry clerks, legal clerks, private photocopying services; (c) experts or consultants and their necessary support staff; (d) any persons requested by counsel to furnish services such as document coding, image scanning, mock trial, jury profiling, translation services, court reporting services, demonstrative exhibit preparation, or the creation of any computer-database from documents; and (e) those individuals designated in paragraph 14.

11. Subject to paragraph 12 below, “Confidential” information may be disclosed by the receiving party only to the individuals identified in paragraph 10 and 15 and one corporate designee of each party. A corporate designee identified pursuant to this paragraph shall: 1) be informed of the terms of the Protective Order, as modified herein, prior to the disclosure of the “Confidential” information; and 2) sign the confidentiality agreement at Exhibit A of the Protective Order. Prior to the disclosure of “Confidential” information to any corporate designee, counsel for the receiving party shall serve the executed confidentiality agreement of the corporate designee on counsel for the producing party.

12. Further, prior to disclosing “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” or “Confidential” information to a receiving party’s proposed expert or consultant, the receiving party shall disclose such person in writing to the producing party and provide to the producing party a signed Confidentiality Agreement in the form attached as Exhibit A. In the case of a proposed expert or consultant, the receiving party shall also provide to the producing party the resume or curriculum vitae of the proposed expert or consultant, the expert or consultant’s business affiliation, and any current and past consulting relationships in the industry. The producing party will thereafter have five (5) business days from receipt of the

Confidentiality Agreement to object to any proposed expert or consultant. The objection must be made for good cause and in writing, stating with particularity the reasons for the objection. Failure to object within five (5) business days constitutes approval. If the parties are unable to resolve any objection, the receiving party may apply to the presiding judge to resolve the matter. There will be no disclosure to any proposed expert or consultant during the five (5) business day objection period, unless that period is waived by the producing party, or if any objection is made, until the parties have resolved the objection, or the presiding judge has ruled upon any resultant motion.

13. Counsel is responsible for the adherence by third-party vendors to the terms and conditions of this Protective Order.

14. “Highly Confidential - Outside Counsel’s Eyes Only” or “Highly Confidential - Source Code” information may be disclosed to a person who is not already allowed access to such information under this Protective Order if:

- (a) the information was previously received or authored by the person or was authored or received by a director, officer, employee or agent of the company for which the person is testifying as a designee under Fed. R. Civ. P. 30(b)(6);
- (b) the designating party is the person or is a party for whom the person is a director, officer, employee, consultant or agent; or
- (c) counsel for the party designating the material agrees that the material may be disclosed to the person.

In the event of disclosure under this paragraph, only the person and persons to whom disclosure of “Highly Confidential - Outside Counsel’s Eyes Only” or “Highly Confidential - Source Code” information may be made under this Protective Order and who are bound by this Protective Order, may be present during the disclosure or discussion of “Highly Confidential - Outside Counsel’s

Eyes Only” or “Highly Confidential - Source Code” information. Disclosure of material pursuant to this paragraph does not constitute a waiver of the confidential status of the material so disclosed.

15. “Confidential” information may be disclosed to a person who is not already allowed access to such information under this Protective Order if:

- (a) the information was previously received or authored by the person or was authored or received by a director, officer, employee or agent of the company for which the person is testifying as a designee under Fed. R. Civ. P. 30(b)(6);
- (b) the designating party is the person or is a party for whom the person is a director, officer, employee, consultant or agent; or
- (c) counsel for the party designating the material agrees that the material may be disclosed to the person.

In the event of disclosure under this paragraph, only the person and persons to whom disclosure of “Confidential” information may be made under this Protective Order and who are bound by this Protective Order, may be present during the disclosure or discussion of “Confidential” information. Disclosure of material pursuant to this paragraph does not constitute a waiver of the confidential status of the material so disclosed.

16. If a receiving party learns that, by inadvertence or otherwise, it has disclosed information designated by a producing party as “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” or “Confidential” to any person or in any circumstance not authorized under this Order to receive such information, the receiving party must, as soon as is practicable: (a) notify in writing the producing party of the unauthorized disclosure; (b) use its best efforts to retrieve all copies of the protected materials; and (c) inform the person or persons to whom unauthorized disclosures were made, to the extent the person or persons are

identifiable, of all the terms of this Order. To the extent any person not authorized under this Order to receive “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” or “Confidential” information receives, by inadvertence or otherwise, information designated by a producing party as “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” or “Confidential,” counsel is responsible for ensuring such person’s adherence to the terms and conditions of this Protective Order.

VI. SOURCE CODE

17. Any source code produced in discovery shall be made available for inspection, in a format allowing it to be reasonably reviewed and searched, between 8:00 am and 6:00 pm local time on business days or at other mutually agreeable times, at an office of the producing party’s counsel or another mutually agreed upon location. A party requesting access to inspect another party’s source code materials must provide notice to the producing party at least seven (7) days prior to the requested inspection. The parties agree to cooperate in good faith to make source code available for inspection outside of normal business hours or upon less than seven (7) days notice as necessary.

18. The source code shall be made available for inspection on a secured computer in a secured room without Internet access or network access to other computers. The producing party shall provide the receiving party with information explaining how to start, log on to, and operate the computer(s) in order to access the produced source code and shall produce the source code in computer searchable format. The producing party shall install reasonably available commercial tools that are sufficient for viewing and searching the code produced, on the platform produced, if such tools exist, are presently used in the ordinary course of the producing party’s business, and do not require payment of additional license fees. The receiving party may request that additional

software tools be installed on the computer to assist the receiving party's review of the source code. The receiving party shall be responsible for providing the tools or licenses to the tools that it wishes to use to the producing party at least seven (7) days prior to the first date on which access to the source code computer is sought so that the producing party may install such tools on the computer.

19. The receiving party shall not copy, remove, or otherwise transfer any portion of the source code onto any recordable media or recordable device. The receiving party shall be entitled to take notes (electronic or non-electronic) relating to the source code but may not copy the source code into such notes. To the extent the receiving party desires to take notes electronically, the producing party shall provide a note-taking computer (e.g., a computer, which is distinct from the standalone computer, that is not linked to any network, including a local area network, an intranet or the Internet, and has image making functionality of any type disabled, including but not limited to camera or video functionality) ("note-taking computer") with a current, widely used word processing program for the receiving party's use in taking such notes. The "note-taking computer" shall be used for the sole purpose of note-taking and shall be retained by the producing party. Such notes shall be transferred to a removable disk or drive provided by the producing party for the receiving party to retain, and the computer cleared of such notes. The note-taking computer shall have no features which would hinder the complete clearing of the receiving party's notes after such notes have been transferred. Any such notes shall not include copies or reproductions of portions of the source code; however, the notes may contain filenames, directory names, module names, class names, parameter names, variable names, function names, method names, or procedure names.

20. Using the software available on the source code computer, the receiving party shall create PDFs of the printed copies the receiving party is requesting and save them to a folder on the desktop of the source code computer named "Print Requests" with a subfolder identifying the date of the request. The PDFs file names must include identifying information including the file path and file name. Alternatively, the receiving party may identify the source code file paths and file names of the printed copies the receiving party is requesting. The producing party may monitor the activities of the receiving party's representatives during any source code review, but only to ensure that there is no unauthorized recording, copying, or transmission of the source code.

21. The receiving party may request paper copies of limited portions of source code (containing no more than 10 consecutive pages and no more than 300 pages of source code) that are reasonably necessary for the preparation of court filings, pleadings, expert reports, or other papers, or for deposition or trial, but shall not request paper copies for the purposes of reviewing the source code other than electronically as set forth in paragraph 17 in the first instance. To the extent a receiving party believes it needs additional pages beyond these limits, and upon a showing of good cause by the receiving party, the parties will negotiate in good faith as to whether to allow printing of additional pages. Any request for printed source code material shall be served via an email request identifying the subfolders of the "Print Requests" folder that the receiving party is requesting or the source code file paths and file names of the printed copies the receiving party is requesting. Within three (3) business days of such request, the producing party shall provide one copy of all such source code material in paper form including bates numbers and the label "HIGHLY CONFIDENTIAL - SOURCE CODE." If the request is served after 6:00 p.m. Pacific Time, it shall be deemed served the following business day. The producing party shall not print or

add markings, including watermarks, to the requested source code material in a manner that obscures or otherwise makes the printed source code material difficult to read.

22. The receiving party shall maintain a record of any individual who has inspected any portion of the source code in electronic or paper form, including the name of each individual, the bates range(s) of source code materials provided to that individual, and the date on which the materials were provided to that individual. The receiving party shall maintain all paper copies of any printed portions of the source code in a secured, locked area. The receiving party shall not create any electronic or other images of the paper copies and shall not convert any of the information contained in the paper copies into any electronic format. The receiving party shall only make additional paper copies if such additional copies are (1) necessary to prepare court filings, pleadings, or other papers (including a testifying expert's expert report), (2) necessary for deposition, or (3) otherwise necessary for the preparation of its case. Any paper copies used during a deposition shall be retrieved by the producing party at the end of each day and must not be given to or left with a court reporter or any other unauthorized individual.

VII. NON-PARTY INFORMATION

23. The existence of this Protective Order must be disclosed to any person producing documents, tangible things, or testimony in this action who may reasonably be expected to desire confidential treatment for such documents, tangible things or testimony. Any such person may designate documents, tangible things, or testimony confidential pursuant to this Protective Order.

VIII. FILING DOCUMENTS WITH THE COURT

24. If any party wishes to submit "Highly Confidential Outside - Counsel Eyes Only," "Highly Confidential - Source Code," or "Confidential" information to the Court, the submission must be filed under seal in conformance with the Court's rules and procedures. Materials filed

under seal must include a cover page bearing the title of this matter, an indication of the nature of the contents of such sealed filing, the words “HIGHLY CONFIDENTIAL - OUTSIDE COUNSEL’S EYES ONLY SUBJECT TO PROTECTIVE ORDER,” “HIGHLY CONFIDENTIAL - SOURCE CODE SUBJECT TO PROTECTIVE ORDER,” or “CONFIDENTIAL - SUBJECT TO PROTECTIVE ORDER,” as applicable.

Pursuant to the Court’s Policies and Procedures, except in emergency situations, a party may not file a document under seal (or redact necessary and/or substantive information) without first obtaining leave of the Court, which can be sought by filing a motion for leave to file under seal (as described below), and attaching (under seal) the materials the party wishes to file under seal. No party may file a document under seal without a contemporaneous motion to seal that meets the standards of *In re Avandia Marketing, Sales Practices & Products Liability Litigation*, 924 F.3d 662 (3d Cir. 2019). A party who seeks leave to file material under seal (the “Filing Party”) must do the following:

(a) Procedure for a filing with only the Filing Party’s own confidential material under seal. A Filing Party who seeks to file material under seal that only contains the Filing Party’s own confidential information must **(1)** contemporaneously file a motion for leave to file the material under seal supported by a declaration providing support for the motion and attaching as an exhibit, or as exhibits, the material the Filing Party wishes to file under seal, **(2)** file a public version of the filing, redacting any material the Filing Party is seeking leave to file under seal, **(3)** serve the other parties with any sealed attachments to the motion for leave to file under seal, and **(4)** within four days of receiving a ruling on the Filing Party’s motion for leave to file under seal, make the appropriate under seal or public filings based on the Court’s ruling on the motion for leave to file under seal.

(b) Procedure for a filing containing material designated by parties other than the Filing Party as Protected Material under this Order. A Filing Party who seeks to make a filing that contains material designated by another party (including third parties) as protected material under this Order must follow the procedures in this paragraph. If the filing is subject to a deadline, **(1)** file a joint stipulation (for which the Filing Party need not obtain prior approval from the Court) extending the deadline for the filing by 7 days (which extension will not affect any other deadlines, including the deadline to respond to the filing which will be calculated as though the filing were made on the date the joint stipulation is filed); and **(2)** on the original filing deadline, serve the other party with a full set of the filings (the content of which will not change between this point in time and their ultimate filing absent agreement of the parties), except that in the case of material designated as protected material by third parties, providing the third party only the material the Filing Party seeks to file under seal so designated by the third party.

If the filing is not subject to a deadline, the Filing Party shall comply with (2) above, and the date of service will be used to calculate subsequent deadlines such as the response deadline.

Regardless of whether the filing is subject to a deadline, **(3)** within 3 days of step (2) above, meet and confer in good faith with the party or parties who designated the material in question as protected material under this Order to identify any information that should be filed under seal; **(4)** within seven (7) days of step (2), file a joint motion for leave to file under seal the material the parties determine should be filed under seal, supported by a declaration providing support for the motion from each party seeking to file material under seal and attaching as an exhibit, or as exhibits, the material the parties are seeking to file under seal; **(5)** within seven (7) days of step (2), file a public version of the filing, redacting any material the parties are seeking leave to file under seal; and **(6)** within four days of receiving a ruling on the joint motion for leave to file under

seal, make the appropriate under seal or public filings based on the Court's ruling on the joint motion for leave to file under seal.

(c) Procedure for expedited filings. If the Filing Party's submission requires expedited treatment (for example for an urgent discovery motion), the parties will meet and confer in good faith and take all reasonable efforts to follow the procedures above in subsection (ii) except that the joint motion for leave to file under seal will be filed within three (3) days (or less if the circumstances require) of the Filing Party filing the joint stipulation.

In all instances in which a Filing Party is granted leave to file material under seal, redacted versions of sealed documents must be filed publicly unless the redactions would be so extensive as to render the document unreadable. The Filing Party shall be responsible for informing the Clerk of the Court that the filing should be sealed and for placing the legend "FILED UNDER SEAL PURSUANT TO COURT ORDER" on the caption and conspicuously on each page of the filing. Exhibits to a filing shall conform to the labeling requirements set forth in this Order.

IX. NO PREJUDICE

25. Producing or receiving "Highly Confidential - Outside Counsel's Eyes Only," "Highly Confidential - Source Code," or "Confidential" information or otherwise complying with the terms of this Protective Order, will not (a) operate as an admission by any party that any particular "Highly Confidential - Outside Counsel's Eyes Only," "Highly Confidential - Source Code," or "Confidential" information contains or reflects trade secrets or any other type of confidential or proprietary information; (b) prejudice the rights of a party to object to the production of information or material that the party does not consider to be within the scope of discovery; (c) prejudice the rights of a party to seek a determination by the presiding judge that particular materials be produced; (d) prejudice the rights of a party to apply to the presiding judge

for further protective orders; or (e) prevent the parties from agreeing in writing to alter or waive the provisions or protections provided for in this Protective Order with respect to any particular information or material.

X. CONCLUSION OF LITIGATION

26. Within sixty (60) calendar days after final judgment in this action, including the exhaustion of all appeals, or within sixty (60) calendar days after dismissal pursuant to a settlement agreement, each party or other person subject to the terms of this Protective Order shall destroy or return to the producing party all materials and documents containing “Highly Confidential - Outside Counsel’s Eyes Only,” “Highly Confidential - Source Code,” and “Confidential” information, and certify to the producing party that this destruction or return has been done. However, outside counsel for any party is entitled to retain all court papers, trial transcripts, exhibits, and attorney work product, including containing information provided pursuant to this Protective Order, provided that any such materials are maintained and protected in accordance with the terms of this Protective Order.

XI. OTHER PROCEEDINGS

27. By entering this Protective Order and limiting the disclosure of information in this case, the Court does not intend to preclude another court from finding that information may be relevant and subject to disclosure in another case. Any person or party subject to this order who becomes subject to a motion to disclose another party’s information designated “Confidential,” “Highly Confidential - Source Code,” or “Highly Confidential - Outside Counsel’s Eyes Only” pursuant to this order shall promptly notify that party of the motion so that the party may have an opportunity to appear and be heard on whether that information should be disclosed.

XII. REMEDIES

28. Any party may petition the presiding judge for good cause shown if the party desires relief from a term or condition of this Protective Order.

XIII. NO WAIVER

29. Nothing in this Protective Order shall prejudice the right of either party to object to the production of any document or part thereof upon any appropriate ground, including any applicable privilege, and nothing herein shall be construed as a waiver of such rights. Moreover, nothing in this Protective Order shall prejudice the right of either party to object to the admissibility at trial of any information or other evidentiary material on any appropriate ground, and nothing herein shall be construed as a waiver of such right.

30. Entering into, agreeing to, and/or complying with the terms of this Protective Order shall not: (i) operate as an admission by any party that any particular information contains or reflects currently valuable trade secrets or protected proprietary or commercial information; or (ii) operate as an admission by any party that any particular information is, or is not, relevant to this action.

XIV. PARTIES' OWN INFORMATION

31. Nothing in this Protective Order shall limit a producing party's use of its own documents, things, or information unless otherwise ordered by the Court. Nor shall anything in this Protective Order prevent a producing party from disclosing its "Highly Confidential - Outside Counsel's Eyes Only," "Highly Confidential - Source Code," or "Confidential" information to any person. Such disclosures shall not affect any designation of such documents as "Highly Confidential - Outside Counsel's Eyes Only," "Highly Confidential - Source Code," or

“Confidential” information pursuant to the terms of this Protective Order so long as the disclosure is made in a manner reasonably calculated to maintain the confidentiality of the information.

XV. PROSECUTION BAR

32. To the extent material designated as “Highly Confidential - Outside Counsel’s Eyes Only” or “Highly Confidential - Source Code” includes information relating to the design or functionality of a party’s current or future augmented or virtual reality products, mobile videogame products, mobile application software, mobile gaming products, video gaming products, computer vision products, and/or location-centric products, the following additional restrictions apply unless the producing and receiving parties agree otherwise in writing:

Any attorney and any other person who receives, obtains, or becomes informed about, in whole or in part, the substance of another party’s material designated “Highly Confidential - Outside Counsel’s Eyes Only” or “Highly Confidential - Source Code” pursuant to this order shall not prepare, prosecute, supervise, or assist in the preparation or prosecution of any patents or patent applications relating to augmented or virtual reality products, mobile videogame products, or mobile application software, including without limitation the patents asserted in this action and any application claiming priority to or otherwise related to the patents asserted in this action, before any foreign or domestic agency, including the United States Patent and Trademark Office. For purposes of this provision, “prosecution” means involvement in or advising regarding drafting or amending patent claims. For the avoidance of doubt, this provision does not preclude an attorney or patent agent from representing a party either challenging or defending a patent before a domestic or foreign agency, including but not limited to reissue, reexamination, *inter partes* review, or other post grant administrative proceedings, but this provision would preclude such attorney or

patent agent from drafting or advising directly or indirectly on any amendment to a claim of the patent being challenged in such proceedings.

33. This Prosecution Bar shall begin when access to another party's material is first received by the affected individual and shall end two years after final termination of this action, including any appeals. Notwithstanding the immediately preceding sentence, in the event outside counsel who reviewed designated material withdraws from representation, this Prosecution Bar shall end for that outside counsel two years after final termination of this action, including any appeals, or two years after the date of withdrawal, whichever comes first. To ensure compliance with the purpose of this provision, each party shall create an "Ethical Wall" between those persons with access to designated materials and any individuals who prepare, prosecute, supervise or assist in the preparation or prosecution of any patent application relating to augmented or virtual reality products.

Dated: June 3, 2025

OF COUNSEL:

James J. Lukas, Jr.
Matthew S. Levinstein
Sean Patchin, Jr.
Patrick J. Owens
Greenberg Traurig, LLP
360 N. Green St., Suite 1300
Chicago, IL 60607
(312) 456-8400
lukasj@gtlaw.com
levinsteinm@gtlaw.com
sean.patchin@gtlaw.com
patrick.owens@gtlaw.com

Benjamin P. Gilford
Greenberg Traurig, LLP
90 South 7th St., Ste. 3500

/s/ Renée Mosley Delcollo

Renée Mosley Delcollo (#6442)
Greenberg Traurig, LLP
222 Delaware Avenue, Ste. 1600
Wilmington, DE 19801
(302) 661-7000
renee.delcollo@gtlaw.com

Attorneys for Plaintiffs

Minneapolis, MN 55402
(612) 259-9700
gilfordb@gtlaw.com

Erik M. Bokar
Greenberg Traurig, PA
450 S. Orange Avenue, Ste. 650
Orlando, FL 32801
(407) 317-8560
bokare@gtlaw.com

OF COUNSEL:

Sarah E. Piepmeier
Nathan Sabri
Perkins Coie LLP
505 Howard Street, Suite 1000
San Francisco, CA 94105-3204
(415) 344-7000
spiepmeier@perkinscoie.com
nsabri@perkinscoie.com

/s/ Sara M. Meltzer

Kelly E. Farnan (#4395)
Sara M. Meltzer (#6509)
Richards, Layton & Finger, P.A.
One Rodney Square
920 North King Street
Wilmington, DE 19801
(302) 651-7700
farnan@rlf.com
metzler@rlf.com

Attorneys for Defendant Niantic, Inc.

IT IS SO ORDERED.

Signed this 4th day of June, 2025.

/s/ Joshua D. Wolson

UNITED STATES DISTRICT JUDGE

EXHIBIT A

CORPORATE DESIGNEE, EXPERT WITNESS, AND CONSULTANT
ADHERENCE TO PROTECTIVE ORDER

I, _____, acknowledge and declare that I have received a copy of the Protective Order (“Order”) entered in the following case: *ImagineAR, Inc. and Imagine AR, Inc. v. Niantic, Inc.*, C.A. No. 24-1252-JLH (D. Del.). Having read and understood the terms of the Order, I agree to be bound by the terms of the Order and consent to the jurisdiction of said Court for the purpose of any proceeding to enforce the terms of the Order.

Name of individual: _____

Present occupation/job description:

Name of Company or Firm: _____

Address: _____

Dated: _____

[Signature]

EXHIBIT 2

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

IMAGINEAR, INC., et al.,

Plaintiffs,

v.

NIANTIC, INC. d/b/a NIANTIC LABS,

Defendant.

Case No. 1:24-cv-01252-JDW

MEMORANDUM

It's *Avada Kedavra* for three of ImagineAR, Inc. and Imagine AR, Inc.'s ("IAR") patents because all of them are abstract and lack an inventive concept. And it's also game over for IAR's claims of pre-suit indirect and willful infringement for the remaining patents at issue in this case because IAR has not alleged facts that make it plausible that Niantic, Inc. had the requisite knowledge of alleged infringement. Thus, I will grant Niantic's partial motion to dismiss.

I. BACKGROUND

Plaintiffs ImagineAR, Inc. and Imagine AR, Inc. (together "IAR") are the respective owner and licensee of various patents including U.S. Patent Nos.: (1) 8,777,746, entitled "Gestures To Encapsulate Intent" (the "'746 Patent"); (2) 8,668,592, entitled "Systems And Methods Of Changing Storyline Based On Player Location" (the "'592 Patent"); (3) 8,579,710, entitled "Systems And Methods Of Virtual Goods Trading Using Ratings To

Ascribe Value To Virtual Goods" (the "'710 patent"); (4) 10,946,284, entitled "Systems And Methods For Capture And Use Of Local Elements In Gameplay" (the "'284 patent"); (5) 11,484,797, entitled "Systems And Methods For Capture And Use Of Local Elements In Gameplay" (the "'797 patent"); (6) 11,666,827, entitled "Systems And Methods For Capture And Use Of Local Elements In Gameplay" (the "'827 patent"); and (7) 12,070,691, entitled "Systems And Methods For Capture And Use Of Local Elements In Gameplay" (the "'691 patent") (together the "Patents-In-Suit"). On November 13, 2024, IAR filed suit against Defendant Niantic, Inc., claiming that Niantic infringes one or more claims of the Patents-In-Suit by making, using, selling, offering for sale in the United States, and/or importing into the United States, video games including Pokémon GO, Pikmin Bloom, Peridot, Skatrix, Monster Hunter Now, and Harry Potter: Wizards Unite. IAR asserts claims against Niantic for direct infringement, indirect infringement (including both induced and contributory infringement), and willful infringement.

Niantic moved to dismiss. However, I granted IAR's Unopposed Cross-Motion To Amend And Supplement Complaint so that it could supplement its allegations regarding its claims for indirect and willful Infringement. IAR's operative pleading, its First Amended Complaint (the "FAC"), asserts the same infringement theories as to the same Patents-In-Suit. Niantic has filed a partial motion to dismiss the FAC, seeking dismissal of: (1) IAR's infringement claims for the '710, '746, and '592, as invalid under 35 U.S.C. § 101,

and (2) IAR's pre-suit indirect and pre-suit willful infringement claims.¹ IAR opposes the motion, and it is ripe for review.

II. LEGAL STANDARD²

Federal Rule of Civil Procedure 12(b)(6) allows a party to move to dismiss a complaint for failure to state a claim upon which relief can be granted. Fed. R. Civ. P. 12(b)(6). Rather than require detailed pleadings, the "[r]ules demand only a short and plain statement of the claim showing that the pleader is entitled to relief[.]" *Connelly v. Lane Const. Corp.*, 809 F.3d 780, 786 (3d Cir. 2016) (quotation omitted). "To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Id.* In determining whether a claim is plausible, the court must "draw on its judicial experience and common sense." *Id.* at 786–87 (same). First, the court must identify the elements needed to set forth a particular claim. *See id.* at 787. Second, the court should identify conclusory allegations, such as legal conclusions, that are not entitled to the presumption of truth. *See id.* Third, with respect to well-pleaded factual allegations, the court should accept those allegations as true and "determine whether they plausibly give rise to an entitlement to relief." *Id.* (quotation omitted). The court must "construe those truths in the light most

¹ Niantic's motion to dismiss the claims for indirect and willful infringement claims is confined to pre-suit conduct—*i.e.* conduct that occurred before IAR filed suit on November 13, 2024.

² Applicable regional circuit law governs the standard for motions to dismiss. *See Mobile Acuity Ltd. v. Blippar Ltd.*, 110 F.4th 1280, 1288 (Fed. Cir. 2024).

favorable to the plaintiff, and then draw all reasonable inferences from them." *Id.* at 790 (citation omitted).

III. ANALYSIS

A. Patent Eligibility

An invention is patent eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. "The Supreme Court has interpreted this language to exclude '[l]aws of nature, natural phenomena, and abstract ideas' from patent eligibility." *Recentive Analytics, Inc. v. Fox Corp.*, 134 F.4th 1205, 1211 (Fed. Cir. 2025) (quotation omitted). Following the Supreme Court's decision in *Alice Corp. Pty. v. CLS Bank Int'l*, 573 U.S. 208 (2014), "courts perform a two-step analysis to determine patent eligibility under § 101." *Recentive*, 134 F.4th at 1211. First, the court "determine[s] whether the claims at issue are directed to one of those patent-ineligible concepts." *Id.* (quotation omitted). If so, the second step requires the court to "assess the 'elements of each claim both individually and as an ordered combination' to determine whether they possess an 'inventive concept' that is 'sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.'" *Id.* (same).

Patent validity under Section 101 is a question of law that can be resolved on a motion to dismiss. *See Trinity Info Media, LLC v. Covalent, Inc.*, 72 F.4th 1355, 1360 (Fed. Cir. 2023). Patents are presumptively valid, and "[t]he burden to prove the ineligibility of

any patent claim stays with the patent challenger at all times." *Mobile Acuity Ltd. v. Blippar Ltd.*, 110 F.4th 1280, 1291 (Fed. Cir. 2024).

1. '710 Patent

Claim 15 of the '710 Patent claims:

A computer-implemented system for trading virtual goods on at least one computing device in communication with a storage medium, comprising:

a game engine programmed for:

providing a game environment accessible by a plurality of players, including a facility enabling a first player to acquire or develop a virtual good, the virtual good having a starting value;

receiving, via the game environment at least one rating of the virtual good from a second player;

automatically increasing or decreasing the starting value as a function of the at least one rating of the virtual good;

making the virtual good available for purchase at a new value representing the automatically increased or decreased starting value; and

receiving a request from a requesting player to purchase the virtual good, and checking whether the requesting player previously rated the virtual good prior to allowing a sale of the virtual good to the requesting player;

the storage medium in communication with the game engine for:

storing the starting value, the at least one rating and the new value.

(D.I. 21-3 at 13:8 – 14:4.)

a. *Alice* step one: abstract idea

At step one under *Alice*, I must consider “what the patent asserts to be the focus of the claimed advance over the prior art” by “focus[ing] on the language of the [a]sserted [c]laims themselves, considered in light of the specification.” *Yu v. Apple Inc.*, 1 F.4th 1040, 1043 (Fed. Cir. 2021) (quotation omitted). In the context of software and other computer-related patents, the question is “whether the claims focus on ‘the specific asserted improvement in computer capabilities ... or, instead, on a process that qualifies as an abstract idea for which computers are invoked merely as a tool.’” *Recentive*, 134 F.4th at 1212 (quotation omitted). The alleged improvement must be directed to functionality; “[a]n improved result, without more, is not enough to support patent eligibility at *Alice* step one.” *Contour IP Holding LLC v. GoPro, Inc.*, 113 F.4th 1373, 1379 (Fed. Cir. 2024) (citation omitted).

Courts must “tread carefully” when it comes to determining whether a patent claims an abstract idea. *Alice*, 573 U.S. at 217. To that end, courts are wary of “describing the claims at such a high level of abstraction and untethered from the language of the claims” such that the exceptions to Section 101 would swallow the rule. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016). The specification’s claimed advance over the prior art is “the ability to take other factors into account”—other than the seller’s own valuation—“for ascribing value to virtual goods” in the context of “virtual goods trading.” (D.I. 21-3 at 1:39-43.) And the language of Claim 15 also focuses on setting a

value for virtual goods to be sold in a game environment. Thus, Claim 15's focus is valuing virtual goods for trading. Niantic has oversimplified Claim 15 by describing its focus as "receiving and processing data to manage trades" of virtual goods. (D.I. 34 at 7.) However, because Niantic's oversimplification of the claim's focus does not impact the overall analysis, I will address the merits of its arguments rather than deny the motion on that basis alone.

Like "risk hedging," "intermediated settlement," and "placing an order based on displayed market information,[]" valuing goods for trading "is 'a fundamental economic practice long prevalent in our system of commerce.'" *Alice*, 573 U.S. at 219 (quoting *Bilski v. Kappos*, 561 U.S. 593, 611 (2010)); *Trading Techs. Int'l, Inc. v. IBG LLC*, 921 F.3d 1084, 1092 (Fed. Cir. 2019). And "verifying a transaction to avoid fraud ... is [another] long-standing commercial practice." *Bozeman Fin. LLC v. Fed. Rsrv. Bank of Atlanta*, 955 F.3d 971, 979 (Fed. Cir. 2020). The same is true with rating products, and at least one other judge has concluded that claims directed to the processing of sales data "by calculating a performance rating" and utilizing that rating "to adjust price" were abstract. *Surgetech, LLC v. Uber Techs. Inc.*, 700 F. Supp.3d 179, 184 (D. Del. 2023), *aff'd*, No. 2024-1280, 2025 WL 1621648 (Fed. Cir. June 9, 2025). The Federal Circuit has "repeatedly found claims directed to similar concepts, and containing similar steps, to be abstract." *In re Zimmerman*, No. 2023-cv-1542, 2024 WL 503743, at *2 (Fed. Cir. Feb. 9, 2024). Thus, I have

little trouble concluding that Claim 15 is abstract because it is directed to a fundamental economic practice.

IAR's arguments don't persuade me otherwise. *First*, the fact that "Claim 15 defines concrete system components for virtual gaming" does not make it any less abstract. (D.I. 35 at 6.) Indeed, "asserted claims can be directed to an abstract idea even if the claims require generic computer components" *Trinity*, 72 F.4th at 1364. That is true here. The components to which IAR points—"at least one computing device," "a storage medium," and "a game engine"—are "generic computing terms ... that provide a generic technical environment for performing the abstract idea" of valuing virtual goods in the game environment based on players' ratings of those goods. *Trinity*, 72 F.4th at 1364.

Second, while IAR contends that Claim 15 improves the relevant technology, the claim is not directed to improvements to a computer's functionality. Instead, Claim 15's focus "is not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools." *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016). Claim 15 is directed to problems with valuing and trading virtual goods, not computers. That is one of the reasons that Claim 15 is different from the patent eligible claim in *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016). In that case, the specific rules in the claim's limitations were directed to a technological improvement because they "allow[ed] *computers to produce* 'accurate and realistic lip synchronization and facial expressions in animated characters' that

previously could only be produced by human animators.” *McRO*, 837 F.3d at 1313 (emphasis added).

In this case, on the other hand, Claim 15 does not include any similarly specific rules that lead to an improvement in computer functionality. Instead, the alleged “rule” (“automatically increasing or decreasing the starting value as a function of the at least one rating of the virtual good”) is directed at an improvement in the abstract idea itself (how to value virtual goods) and uses generic computer components to adjust a virtual good’s value based on ratings. (D.I. 21-3 at 13:18-20.) And Claim 15’s remaining limitations are just “functional steps” directed to the same abstract idea. *Wireless Discovery LLC v. eHarmony, Inc.*, 654 F. Supp. 3d 360, 374 (D. Del. 2023), *aff’d*, No. 2023-1582, 2024 WL 3336763 (Fed. Cir. July 9, 2024). Thus, Claim 15 is a far cry from the specific rules and algorithms that were patent-eligible in *McRO*.

b. *Alice* step two: inventive concept

Having determined that Claim 15 is directed to an abstract idea, I turn to the second step of the *Alice* inquiry, which requires me to “consider the elements of the claims to determine whether they transform the nature of the claim into a patent-eligible application of the abstract idea.” *Secured Mail Sols. LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 911 (Fed. Cir. 2017) (citation omitted). “This is the search for an inventive concept, which is something sufficient to ensure that the claim amounts to significantly more than

the abstract idea itself." *Id.* (same). For the claim to survive, "an inventive concept must be evident" *Id.* (quotation omitted). In this case, it's not.

In computer-implemented inventions like the '710 Patent, "the computer must perform more than 'well-understood, routine, conventional activities previously known to the industry.'" *CosmoKey Sols. GmbH & Co. KG v. Duo Sec. LLC*, 15 F.4th 1091, 1097 (Fed. Cir. 2021) (same). But Claim 15's "checking" limitation prior to allowing a sale is routine. For example, both brick-and-mortar and online merchants check purchasers' identification before selling certain products, like nicotine and alcohol. Firearms dealers also check multiple sources of information before permitting a sale, and online betting platforms check users' ages and locations before permitting certain wagers. Even more on point, some brokerages will check a customer's account to confirm that a particular trade does not put that customer at risk of a margin call. And many stores will check a customer's purchase and return history to confirm that the customer's history does not indicate that the customer will likely return the product. Thus, Claim 15's "computer-mediated implementation of routine or conventional activity is not enough to provide an inventive concept." *United Servs. Auto. Ass'n v. PNC Bank N.A.*, 139 F.4th 1332, 1339 (Fed. Cir. 2025).

Even if Claim 15 prevents fraud and collusion in trading virtual goods in video games (which is not clear to me), Claim 15 is different than the inventive claim in *DDR*, where "the claimed solution [was] necessarily rooted in computer technology in order to

overcome a problem specifically arising in the realm of computer networks." *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014). Here, on the other hand, fraudulent transactions and price manipulation are not unique to computer networks or video games. And the fact that the "checking" occurs in the context of a game environment is not enough to render it inventive. *See United Servs.*, 139 F.4th at 1338. And finally, the "mere automation" of the "checking" step and the changes in price "does not constitute a patentable improvement in computer technology." *Trading Techs.*, 921 F.3d at 1384 (quotation omitted). In short, Claim 15 is not inventive because it does not amount to significantly more than the abstract idea itself.

c. Representativeness

Having determined that Claim 15 is invalid under Section 101, the next question is whether it is representative of the remaining claims of the '710 Patent. A district court may "limit[] the analysis of a § 101 challenge to representative claims ... when the claims at issue are 'substantially similar and linked to the same' ineligible concept." *Mobile Acuity*, 110 F.4th at 1290 (quotation omitted). Niantic bears the initial burden to make that *prima facie* showing. *See id.* If Niantic makes the requisite showing, then the burden shifts to IAR "to present non-frivolous arguments as to why the eligibility of the identified representative claim cannot fairly be treated as decisive of the eligibility of all claims in the group." *Id.*

Niantic has made a *prima facie* showing that Claim 15 of the '710 Patent is representative of the remaining claims in the patent.³ Indeed, all of the claims in the '710 Patent are linked to the overall concept of valuing virtual goods for trading. The method claims (Claims 1 – 14) fail to provide any distinctive significance from the systems claims (Claims 15 – 24), and the language of the two independent claims—Claims 1 and 15—is substantially similar. And while “[a] claim is not representative simply because it is an independent claim[.]” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365 (Fed. Cir. 2018), the limitations in claims 16 – 24 do not alter the concept of Claim 15.

ImagineAR’s arguments in response are either frivolous or not persuasive. As an initial matter, it is not sufficient for IAR to state in a conclusory fashion that “claim construction and discovery remain.” (D.I. 35 at 9.) Instead, to avoid dismissal on this basis, IAR “must propose a specific claim construction or identify specific facts that need development and explain why those circumstances must be resolved before the scope of the claims can be understood for § 101 purposes.” *Trinity*, 72 F.4th at 1360-61. It hasn’t done that.

³ I am not convinced that IAR’s use of certain claims as exemplars in the FAC for infringement purposes is compelling evidence of representativeness in this instance because “[a] statement that a claim is representative for purposes of infringement—without more—is insufficient to show that a claim is representative for purposes of invalidity under 35 U.S.C. § 101.” *GREE, Inc. v. Supercell Oy*, No. 19-cv-161, 2020 WL 475443, at *3 (E.D. Tex. Jan. 29, 2020).

In addition, the fact that the “PTO has already found Claims 1-14 to be directed to eligible subject matter” has nothing to do with whether Claim 15 is representative of those claims. (D.I. 35 at 9.) And I am “not required to defer to Patent Office determinations as to eligibility” in any event. *Sanderling Mgmt. Ltd. v. Snap Inc.*, 65 F.4th 698, 705 (Fed. Cir. 2023). As for the claims that include “physical system components” (D.I. 35 at 9), those limitations are just generic computer components and their conventional operations, which do not change the overall concept articulated in Claim 15. And, for similar reasons set forth above, the alleged “rules” in Claims 20 – 24 are not specific enough to constitute an improvement to computer functionality. Thus, I will treat Claim 15 as representative of the remaining claims in the ‘710 Patent.

2. ‘746 Patent

Claim 1 of the ‘746 Patent claims:

A method of enabling gameplay with a character in a game environment on a mobile device, comprising:

providing a game environment in which a player can play a game via a character;

when there is an expectation of action from the character in the game, receiving a touch gesture input on the mobile device;

calculating fidelity of the touch gesture input to an optimal gesture in a reference gesture table; and

if the fidelity is within a predefined range associated with the optimal gesture, matching the touch gesture input to the optimal gesture and calling an associated game script wherein the character would be shown as having successfully completed the expectation.

(D.I. 21-1 at 12:57 – 13:3.)

a. Alice step one: abstract idea

The focus of Claim 1 of the '746 Patent is using a touch screen in a game environment. The language of the claim focuses on evaluating a player's gestures on a touch screen in the context of a game environment. While the specification identifies the advance over prior art as the fact that "many (similar or different) actions may result from a set of inputs for any given context[.]" (D.I. 21-1 at 8:58-60), Claim 1 does not claim that. Rather, that alleged innovation may be the focus of some of the dependent claims.

Using a touch screen in a game environment is an abstract idea. The functional language of Claim 1 makes clear that the claim is directed to "a result or effect"—matching a touch gesture input an optimal gesture and calling an associated game script—rather than "a specific means or method that improves the relevant technology." *Contour*, 113 F.4th at 1379 (quotation omitted). The claim describes calculating the fidelity of a player's touch gesture on a mobile device and then matching it to an optimal gesture in a reference gesture table if it falls within a predefined range associated with the optimal gesture. But there is no explanation "how to accomplish these steps, at a technical level[.] *Thunder Power New Energy Vehicle Dev. Co. Ltd. v. Byton N. Am. Corp.*, 340 F. Supp.3d 922, 929 (N.D. Cal. 2018), *aff'd*, 777 F. App'x 517 (Fed. Cir. 2019) (original emphasis). "At that level of generality, the claim[] do[es] no more than describe a desired function or outcome" *Id.* (quotation omitted). In short, Claim 1 lacks "the specificity required to

transform a claim from one claiming only a result to one claiming a way of achieving it.” *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1343 (Fed. Cir. 2018) (same). Therefore, it is abstract, and IAR’s contrary arguments are unavailing.

Again, the process set forth in Claim 1 reflects “a much more generic set of steps than *McRO*’s specific claim language.” *Sanderling Mgmt. Ltd. v. Snap Inc.*, 65 F.4th 698, 703 (Fed. Cir. 2023). For example, Claim 1 does not describe—at all—how to evaluate the fidelity of a touch gesture. And even if it’s true that “Claim 1 recites a new method of evaluating touch screen inputs differently than the prior art” (D.I. 35 at 12)—which is not clear—that fact does not make it any less abstract. “[A] claim for a new abstract idea is still an abstract idea.” *Mobile Acuity*, 110 F.4th at 1294 (quotation omitted). Thus, this claim fails at step one.

b. *Alice* step two: inventive concept

An “[t]he abstract idea itself cannot supply the inventive concept, ‘no matter how groundbreaking the advance.’” *Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1378, 1385 (Fed. Cir. 2019). The Federal Circuit has also made clear that “‘improving a user’s experience while using a computer application is not, without more, sufficient to render the claims’ patent-eligible at step one.” *Int’l Bus. Machines Corp. v. Zillow Grp., Inc.*, 50 F.4th 1371, 1377 (Fed. Cir. 2022) (quotation omitted). These principles demonstrate that IAR cannot prevail at the second step of the *Alice* inquiry. It contends that Claim 1 “provides a richer and more unique gaming experience than known methods of touch

gesture evaluation.” (D.I. 35 at 13.) But that’s just a repackaged version of the same argument that fails at step one. Like the plaintiff in *Mobile Acuity*, IAR’s “suggesti[on] that its alleged ‘inventive concept’ is not found in the prior art” is irrelevant to the *Alice* inquiry. *Mobile Acuity*, 110 F.4th at 1294. Indeed, “[t]he search for a § 101 inventive concept is ... distinct from demonstrating § 102 novelty.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016). Thus, “even if [C]laim 1 recites novel subject matter, that fact is insufficient by itself to confer eligibility.” *Yu*, 1 F.4th at 1045. Absent something significantly more than the abstract idea itself, Claim 1 is not inventive.

c. Representativeness

Niantic has made a *prima facie* showing that Claim 1 is representative of the remaining claims in the ‘746 Patent. The ‘746 Patent’s dependent claims recite slight variations on the same abstract idea that do not change the primary focus of the claims—using a touchscreen in a game environment.

Again, IAR’s arguments miss the mark. IAR has not explained why claim construction or discovery are necessary to understand the scope of the remaining for purposes of a Section 101 analysis. *See Trinity*, 72 F.4th at 1360-61. And the technical limitations that IAR identifies do not render other claims non-abstract or inventive. Instead, they are all variations on the same theme. Like Claim 1, the language of the dependent claims’ limitations is results-oriented and does not identify specific steps for improving the mobile device’s functionality, and the mobile device is just a tool. And

again, whether the limitations “refine the claimed method’s novel approach to evaluating touch gesture inputs on a touch screen” is irrelevant to determining whether the claims include an inventive concept. (D.I. 35 at 14.) Thus, IAR falls short of its burden to demonstrate that I should not treat Claim 1’s patent eligibility as decisive of the eligibility of the remaining claims of the ‘746 Patent.

3. ‘592 Patent

Claim 1 of the ‘592 Patent claims:

A method of enabling virtual gameplay on a computing device in communication with a storage medium, the method comprising the steps of:

providing a video game environment on the computing device, enabling a first player to play a game via a character, the first player being one of a plurality of players which have access to the video game environment, each player having a geographic location;

detecting, via an input device in communication with the computing device, the first player's geographic location, and storing the player's geographic location on the storage medium; and

in response to the detected geographic location, retrieving, via the computing device, a storyline for the first player's character to interact with, the retrieved storyline being related to the geographic location of the first player; and permitting the other players' characters to interact with the retrieved storyline as long as the first player remains connected to the game;

wherein other storylines are opened and closed to the first player's character as other players enter and leave the game.

(D.I. 21-2 at 13:60 – 14:14.)

a. Alice step one: abstract idea

Claim 1 of the '510 Patent focuses on tailoring content based on a player's location. The language of the claim focuses on providing storylines in a game environment based on, and related to, a player's geographic location. And the specification explains that unlike the static or predictable virtual worlds in prior art, the '510 Patent offers "a richer and more unique gameplay experience for each player" by taking a player's geographic location into account. (D.I. 21-2 at 1:42-43.) Thus, Niantic's characterization is apt.

"Whether particular claim limitations are abstract ... must be decided on a case-by-case basis in light of the particular claim limitations, patent specification, and invention at issue." *CosmoKey Sols. GmbH & Co. KG v. Duo Sec. LLC*, 15 F.4th 1091, 1099 (Fed. Cir. 2021). However, "prior cases can be helpful in analyzing eligibility," and the Federal Circuit's decision in *Intell. Ventures I LLC v. Cap. One Bank*, 792 F.3d 1363 (Fed. Cir. 2015) is instructive. In that case, the Court recognized that tailoring content based on a user's location or address ... "is 'a fundamental ... practice long prevalent in our system'" and concluded that providing tailored content "based upon the location of the individual—is an abstract idea." *Id.* at 1369. Because that is what Claim 1 describes, I have little trouble concluding that it is also directed to an abstract idea.

Tellingly, in its response, IAR does not grapple with *Intell. Ventures* or any of the "several precedents in which [the Federal Circuit has] concluded that broadly analogous claims, such as those involving methods of providing particularized information to

individuals based on their locations, to be abstract.” *Beteiro, LLC v. DraftKings Inc.*, 104 F.4th 1350, 1356 (Fed. Cir. 2024). Instead, IAR argues that Claim 1 is not abstract because it “recites a new method for ... enabling a virtual game world that is accessible by multiple players at the same time” based on players’ locations. (D.I. 35 at 16.) But whether Claim 1 describes a “new” method does not tell me anything about whether it is abstract. Again, “[e]ligibility and novelty are separate inquiries.” *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017) (citation omitted). And, in any event, Claim 1 doesn’t describe specific steps for *how* to perform the method. Instead, it sets forth generic actions—by generic “computing devices”—of detecting players’ locations, storing that information, and retrieving a related storyline. In other words, it does not set forth an improvement to how a computer functions. And an alleged “improved result, without more, is not enough to support patent eligibility at Alice step one.” *Contour*, 113 F.4th at 1379 (citation omitted). Thus, Claim 1 is abstract.

b. Alice step two: inventive concept

There is no inventive concept that transforms Claim 1 from an abstract idea. Again, IAR conflates eligibility and novelty, arguing that “Claim 1 contains an inventive concept because it expressly identifies how the claimed methods achieve a technological improvement over existing virtual games known in the art.” (D.I. 35 at 16.) “[T]hat contention is unavailing at step two, as “a claim for a new abstract idea is still an abstract idea.” *Mobile Acuity*, 110 F.4th at 1294 (quotation omitted). Instead, Claim 1 recites

generic computing devices that perform routine and conventional functions: detecting a player's location, storing that information, retrieving related content, and updating content for players based on that information. Thus, Claim 1 is not inventive.

c. Representativeness

Niantic has made a *prima facie* showing as to representativeness. Dependent claims 3-16 describe additional tailoring based on a player's location, and claims 17-25 describe how generic components will perform the claimed method. Thus, the claims are substantially similar, and they all link to the same abstract idea of tailoring video game content based on a player's location.

IAR has not satisfied its burden to demonstrate why the eligibility of Claim 1 should not be treated as representative of the remaining claims. Instead, it just argues again that the parties have yet to engage in claim construction and discovery. That is insufficient, and IAR's substantive argument fares no better. "[A]n inventive concept must be evident in the claims." *Secured Mail*, 873 F.3d at 911 (quotation omitted). It is not evident to me that the dependent claims contain an inventive concept, and IAR hasn't bothered to explain what the alleged inventive concepts are. Instead, it makes a conclusory assertion that "the dependent claims recite additional inventive concepts tied to certain attributes of the virtual world, the players, and the players' geographic locations." (D.I. 35 at 17.) That doesn't tell me anything. In short, IAR has "not presented any meaningful argument for

the distinctive significance of any claim limitations not found" in Claim 1. *Berkheimer*, 881 F.3d at 1365. Thus, I will treat Claim 1 as representative for Section 101 purposes.

B. Pleading Sufficiency⁴

"Claims for induced, contributory and willful infringement all require that the defendant had knowledge of the asserted patents and knowledge that the acts at issue constituted patent infringement." *NEC Corp. v. Peloton Interactive, Inc.*, No. 22-cv-987, 2023 WL 8529287, at *2 (D. Del. Dec. 8, 2023). To state a plausible claim of induced infringement, a plaintiff must allege facts "that the accused infringer specifically intended [another party] to infringe [the patent] and knew that the [other party's] acts constituted infringement." *AlexSam, Inc. v. Aetna, Inc.*, 119 F.4th 27, 46 (Fed. Cir. 2024) (quotation omitted). "To state a claim for contributory infringement, a complaint must adequately allege: '(1) the defendant had 'knowledge of the patent in suit,' (2) the defendant had 'knowledge of patent infringement,' and (3) the accused product is not a staple article or commodity of commerce suitable for a substantial non-infringing use." *Id.* at 47 (same). And finally, "[t]o sufficiently plead willful infringement, a patentee must allege facts plausibly showing that, as of the time of the claim's filing, the accused infringer: (1) knew of the patents-in-suit, (2) infringed the patents after acquiring that knowledge, and (3) knew, or should have known, that its conduct in doing so amounted to infringement of

⁴ Because I have determined that the '710, '746, and '592 Patents are invalid, I am dismissing IAR's claims on that basis and need not consider whether the FAC's factual allegations state claims for indirect or willful infringement as to those patents.

the patents." *Hills Point Indus. LLC v. Just Fur Love LLC*, No. 22-cv-1256, 2023 WL 8804046, at *2 (D. Del. Dec. 20, 2023).

IAR has not alleged facts that make it plausible that Niantic had knowledge of alleged infringement of the '284, '797, '827, and '691 Patents. At most, the FAC includes factual allegations that make it plausible that Niantic had pre-suit knowledge of the '284 Patent. In 2021, Niantic entered into a joint venture with Nintendo "to develop mobile augmented reality and virtual space software products and services, including but not limited to the infringing Pokémon GO and Pikmin Bloom products and services." (D.I. 21 at ¶ 58.) Then, in December of 2021, Nintendo cited the '284 Patent during prosecution of its own patent, and the FAC alleges that pursuant to the joint venture, Niantic and Nintendo "shared their knowledge of mobile augmented reality and virtual space ... patent applications, patents, and cited prior art." (D.I. 21 at ¶ 58.) Accepting these factual allegations as true, it is plausible that Nintendo shared its knowledge of the '284 Patent with Niantic.

However, no well-pled facts would permit an inference that Niantic had knowledge of the alleged infringement. Instead, the FAC recites boilerplate allegations that Niantic "has had knowledge of ... its infringement of the '284 patent, others' infringement of the '284 patent, and exemplary infringing software products and services (and components thereof)." (*Id.*) These conclusory allegations are insufficient to state a claim for indirect or willful infringement of the '284 Patent.

As for the '797, '827, and '691 Patents, there are no similar allegations that Nintendo was aware of them, and it is far too speculative to suggest that Nintendo must have known about them just because they are continuations of the '284 Patent. *See, e.g., Jackson v. Seaspine Holdings Corp.*, No. 20-cv-1784, 2022 WL 610703, at *5 (D. Del. Feb. 14, 2022) (citing *MONEC Holding AG v. Motorola Mobility, Inc.*, 897 F. Supp. 2d 225, 233 (D. Del. 2012)). Thus, it is not plausible that Niantic learned about the '797, '827, or '691 Patents during its joint venture with Nintendo. As such, "[t]hese allegations are insufficient to support an inference of actual knowledge of the patents, let alone knowledge of infringement." *Id.* This dooms IAR's pre-suit claims for indirect and willful infringement of these patents.

IV. CONCLUSION

The '710, '746, and '592 Patents are each invalid because they are abstract and non-inventive. I will also dismiss IAR's pre-suit claims for indirect and willful infringement, as the FAC does not include sufficient factual allegations of Niantic's pre-suit knowledge of the remaining patents and their alleged infringement. An appropriate Order follows.

BY THE COURT:

/s/ Joshua D. Wolson

JOSHUA D. WOLSON, J.

September 8, 2025