EXHIBIT 13

HENNIGAN, BENNETT & DORMAN LLP
RODERICK G. DORMAN (SBN 96908)
ALAN P. BLOCK (SBN 143783)
KEVIN SHENKMAN (SBN 223315)
601 South Figueroa Street, Suite 3300
Los Angeles, California 90017
Phone: (213) 694-1200
Fax: (213) 694-1234

Attorneys for Plaintiff
ACACIA MEDIA TECHNOLOGIES CORPORATION

UNITED STATES DISTRICT COURT

DISTRICT OF CALIFORNIA

SOUTHERN DIVISION

ACACIA MEDIA TECHNOLOGIES CORPORATION,

Plaintiff,

vs.

NEW DESTINY INTERNET GROUP, INC., et al.,

Defendants.

AND ALL RELATED CASE ACTIONS.

Case No. SA CV 02-1040 JW (MLGx)

Consolidated Cases:
SA CV 02-1048 JW (MLGx)
SA CV 02-1063 JW (MLGx)
SA CV 02-1165 JW (MLGx)
SA CV 03-0218 JW (MLGx)
SA CV 03-0219 JW (MLGx)
SA CV 03-0259 JW (MLGx)
SA CV 03-0271 JW (MLGx)
SA CV 03-0308 JW (MLGx)

Related Cases:
SA CV 03-1801 JW (MLGx)
SA CV 03-1803 JW (MLGx)
SA CV 03-1804 JW (MLGx)
SA CV 03-1807 JW (MLGx)

ACACIA'S OPPOSITION TO DEFENDANTS' MOTION TO STRIKE WEISS AND ALEXANDER EXPERT DECLARATIONS

DATE: December 2, 2004
TIME: 9:00 a.m.
CTRM: 9C, 9th Floor
Hon. James Ware

TABLE OF CONTENTS

Page

I. INTRODUCTION 1

II. ARGUMENT 3

A. Acacia is Legally Entitled to Proffer Expert Testimony Relevant to Material Issues in Opposition to Defendants' Invalidity Motion 3

1. During the *Markman* Hearing Process, the Court Prohibited the Parties from Introducing Expert Testimony on the Meaning of Claim Terms 3

2. Following Issuance of Its *Markman Order*, the Court Invited the Parties to Submit Expert Testimony in Connection With Invalidity Issues, Which Acacia Has Now Submitted 3

3. Acacia Did Not Waive Its Right to Proffer Expert Declarations in Opposing Defendants' Summary Judgment Motion, and Fed. R. Civ. P. 56(c) & (e) Expressly Authorize Acacia's Expert Declarations 4

B. Acacia's Expert Declarations are Relevant to, and Required for, Claim Construction, and their Consideration for Completing the Claim Construction Task did not Require Acacia to Bring a Motion for Reconsideration Under Local Rule 7-18 6

C. Controlling Federal Circuit Precedent Requires That the Court Consider Acacia's Expert Declaration Testimony as to the Meaning of the Disputed Claim Terms Discernible to One Skilled in the Art, Because the Court Cannot Determine Their Meaning from the Intrinsic Patent Documents 7

D. The Weiss and Alexander Declarations are Admissible Under Fed. R. Evid. 702 9

III. CONCLUSION 13

TABLE OF AUTHORITIES

Page(s)

Cases

AFG Indus., Inc. v. Cardinal IG Co.,
239 F.3d 1239 (Fed. Cir. 2001) 8

Aspex Eyewear, Inc. v. E'Lite Optik, Inc.,
2002 U.S. LEXIS 14834 (N.D. Tex. 2002) 12

Bancorp Services, L.L.C. v. Hartford Life Insurance Co.,
359 F.3d 1367 (Fed. Cir. 2004) 9

BJ Services Company v. Halliburton Energy Services, Inc.,
338 F.3d 1368 (Fed. Cir. 2003) 9

Cybor Corp. v. FAS Technologies, Inc.,
138 F.3d 1448 (Fed. Cir. 1998) 9

Daubert v. Merrell Dow Pharm., Inc.,
508 U.S. 579 (1993) 11

DeMarini Sports, Inc. v. Worth, Inc.,
239 F.3d 1314 (Fed. Cir. 2001) 12

Digital Biometrics, Inc. v. Identix, Inc.,
149 F.3d 1335 (Fed. Cir. 1998) 9

Exxon Research and Engineering Co. v. U.S.,
265 F.3d 1371 (Fed. Cir. 2001) 9

Intellectual Property Dev., Inc. v. UA-Columbia Cablevision of Westchester, Inc.,
2002 U.S. Dist. Lexis 17 (S.D.N.Y. 2002) 6

Jack Gutman, Inc. v. Kopykake Enterprises, Inc.,
302 F.3d 1352 (Fed. Cir. 2002) 9

Key Pharms. v. Hercon Labs Corp.,
161 F.3d 709 (Fed. Cir. 1998) 9

Liquid Dynamics Corp. v. Vaughn Co., Inc.,
2004 WL 2260626 (N.D. Ill. 2004) 12

Papst Licensing GmbH and Co. KG v. Sunonwealth Elec. Machine Ind. Co., Ltd.,
332 F. Supp. 2d 1142 (N.D. Ill. 2004) 12

TABLE OF AUTHORITIES (continued)

Page(s)

Personalized Media Communications L.L.C. v. ITC,
161 F.3d 696 (Fed. Cir. 1998) 13

TI Group Auto. Sys. v. VDO N. Am., L.L.C.,
375 F.3d 1126 (Fed. Cir. 2004) 13

Utah Medical Products, Inc. v. Graphic Controls Corp.,
350 F.3d 1376 (Fed. Cir. 2003) 6

Verve, LLC v. Crane Cams & Equipment Co., Inc.,
311 F.3d 1116 (Fed. Cir. 2002) 7, 8, 11

Vitronics Corp. v. Conceptronic, Inc.,
90 F.3d 1576 (Fed. Cir. 1996) 7, 8

Rules

Fed. R. Civ. P. 56(c) 4, 5

Fed. R. Civ. P. 56(e) 4, 10

Fed. R. Evid. 702 ..... 10, 11

I. INTRODUCTION

There is no reason in fact or in law to strike the declarations of Mr. S. Merrill Weiss and Dr. Peter Alexander, which Acacia presented in support of its opposition to defendants' motion for summary judgment of indefiniteness and non-enablement. There is every reason to consider it—the Court is legally required to consider the pertinent extrinsic evidence provided in those declarations to conclusively address issues of indefiniteness and enablement and the Court invited the parties to provide this legally relevant information. Acacia never waived its right to present expert testimony in opposition to a summary judgment motion. It merely declined the Court's invitation to conduct an evidentiary hearing where the Court would weigh expert testimony on fundamental factual issues for which Acacia contends it has a right to a jury trial. (See Dorman Declaration dated October 19, 2004 at ¶¶ 5-6).

A basic misperception underlies both defendants' motion for summary judgment and their motion to strike Acacia's expert declarations. Those documents disclose that defendants mistakenly believe they are entitled to summary judgment of invalidity based on nothing more than the Court's *Markman Order* which, they say, is final and conclusive. Defendants mistakenly believe they have no obligation to overcome the presumption of validity through proof by clear and convincing evidence of the underlying, foundational facts that are essential to establish indefiniteness and non-enablement. Defendants compound their error when they assert that Acacia may not present contrary evidence, even in opposition to a summary judgment motion.

How did we reach the point where the parties so fundamentally disagree on the procedural status of these issues in this case? Quotes cited by defendants from the *Markman Order* suggest why defendants believe these issues require no more evidence. Citing the *Markman Order* at 35:13-14, defendants note the Court's statement "... one of skill in the art would not understand the meaning of the term 'identification encoder.'" (Defs. Motion to Strike Memo., at 11:11-17). Similarly, they note that "the Court concluded one of ordinary skill in the art would not

understand the scope or bounds of the claim, where read in light of the specification rendering an 'identification encoder' insolubly ambiguous. (*Markman Order* at 35:20-22)" (Defs. Motion to Strike Memo., at 11:19-24). Taking these statements from the *Markman Order*, defendants erroneously argue that, since the Court has now made these "findings," no expert testimony on these subjects is now required or even permitted in opposition to their summary judgment motion.

The problem, of course, is that there was no evidence whatsoever presented by either party prior to the *Markman Order* concerning these issues. There was no evidence presented by either party concerning: (1) a description of the hypothetical person of ordinary skill in the art to whom the patents are directed; (2) what that hypothetical person would understand the claims to mean in light of the specification; and (3) whether that hypothetical person could build the claimed invention without undue experimentation. The Court could not have adjudicated or made findings on these issues, since the invalidity issues were not earlier presented for decision and evidence on them was not earlier proffered. By Order of the Court, expert testimony was not earlier permitted and evidence could not be presented on these issues in the earlier hearings.

Now, to address these issues in connection with defendants' invalidity motion, the Court has properly requested expert testimony. Defendants have failed to provide any expert testimony in support of their summary judgment motion, but which Acacia did provide in opposing that motion. Defendants' motion to strike is a groundless effort to keep this Court from becoming properly informed concerning legally relevant facts extrinsic to the patent documents that materially effect claim construction and validity issues of definiteness and enablement. It should be denied.

II. ARGUMENT

A. Acacia is Legally Entitled to Proffer Expert Testimony Relevant to Material Issues in Opposition to Defendants' Invalidity Motion

1. During the *Markman* Hearing Process, the Court Prohibited the Parties from Introducing Expert Testimony on the Meaning of Claim Terms

During the earlier *Markman* proceedings, the Court limited its analysis of the construction of the claim terms to only the intrinsic patent evidence: "At the hearing, the Court will consider only intrinsic evidence to interpret disputed claims, i.e., the claims themselves, the written description portion of the specification and the prosecution history." (December 18, 2003 Order, at 2:11-13). The Court specifically prohibited the parties during the earlier *Markman* proceedings from presenting any expert testimony on the meaning of the claim terms and on the issue of whether one of skill in the art would understand the meaning of the claim terms when the claims are read in light of the specification: "Pursuant to the Court's order at the November 21, 2003 case management conference, no party shall file expert declarations in support of its claim construction contentions." (December 18, 2003 Order, at 2:16-18). Acacia did not proffer any expert testimony in the earlier Markman proceeding because the Court did not allow it.

2. Following Issuance of Its *Markman Order*, the Court Invited the Parties to Submit Expert Testimony in Connection With Invalidity Issues, Which Acacia Has Now Submitted

In this case, after the Markman hearing process, the Court issued its *Markman* Order and concluded, based solely on its consideration of the intrinsic patent documents, that (1) it could not construe the term "sequence encoder," and (2) it could construe the term "identification encoder," but that the term is arguably indefinite. The Court did not invalidate the claims embodying these terms; instead, it sought expert testimony from the parties. (*Markman Order*, at p. 21, n 16). Pursuant to that

directive, Acacia provided the expert declaration testimony of Alexander and Weiss in opposition to Defendants' summary judgment motion of invalidity.

3. Acacia Did Not Waive Its Right to Proffer Expert Declarations in Opposing Defendants' Summary Judgment Motion, and Fed. R. Civ. P. 56(c) & (e) Expressly Authorize Acacia's Expert Declarations

The plain terms of summary judgment provisions in Fed. R. Civ. P. 56(c) & (e) provide additional authority for submission of Acacia's expert declarations. Rule 56(c) states: "The adverse party prior to the day of the hearing may serve opposing affidavits." Rule 56(e) in turn states:

> When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of the adverse party's pleadings, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If the adverse party does not so respond, summary judgment, if appropriate, shall be entered against the adverse party.

While defendants' failure of proof concerning invalidity is sufficient grounds to deny their motion for summary judgment even without any opposing expert declarations by Acacia, Acacia is nevertheless entitled, under Rule 56, to proffer its expert declarations in opposition to that motion.

Defendants contend that Acacia has waived its right to present extrinsic expert testimony in opposition to their motion for summary judgment, because (1) Acacia did not present expert testimony during the earlier Markman proceedings, (2) it did not move for an evidentiary hearing, and (3) defendants have been prejudiced by

Acacia's submissions of expert declarations in opposition to their summary judgment motion. (Motion at pp. 5-7). For a host of reasons, these contentions are baseless.

First, no cognizable prejudice can arise from Acacia's timely opposition to a summary judgment motion with evidence expressly permitted under Rule 56(c) & (e). Moreover, defendants, as movants, had the burden of establishing material facts without substantial controversy and, yet, inexplicably failed to support their summary judgment motion with *any* supporting evidence essential to demonstrating invalidity by clear and convincing evidence. Any "prejudice" that befalls defendants is entirely self-inflicted.

Next, Acacia's factual submissions have not been and could not be unexpected. Acacia's expert witness submissions have at all times been consistent with the Court's directives and Acacia's stated intentions. Acacia has responded to the Court's invitation to provide expert testimony. Further, following the *Markman Order*, Acacia has consistently communicated to defendants and the Court its intent to present expert testimony in its opposition to defendants' motion for summary judgment (rather than in a motion for an evidentiary hearing).[1] Acacia has made this clear repeatedly: (1) at the meetings of counsel conducted on August 2 and 3, 2004; (2) in the Joint Statement re Markman Order; and (3) at the telephonic Case Management Conference on August 17, 2004. (See Dorman Decl. dated October 19, 2004 at ¶¶ 4-6). Accordingly, Acacia has not waived its right to present the Weiss and Alexander expert declarations in its opposition to defendants' motion for summary judgment.

---

[1] In its *Markman Order*, the Court invited Acacia to bring a motion for an evidentiary hearing with respect only to the terms "identification encoding means" and "sequence encoder;" but did not invite Acacia to bring a motion for an evidentiary hearing with respect to "identification encoder" (regarding either indefiniteness or enablement). (*Markman Order*, at 21:5-7, 34:4-6, and 36:2-3). Defendants contend that "presumably" the Court also intended to invite Acacia to bring a motion for an evidentiary hearing with respect to "identification encoder." (Motion to Strike at 4:8-10). There are no grounds for defendants to make this presumption; had the Court intended to invite a motion for an evidentiary hearing from Acacia on "identification encoder," it would have so stated.

B. Acacia's Expert Declarations are Relevant to, and Required for, Claim Construction, and their Consideration for Completing the Claim Construction Task did not Require Acacia to Bring a Motion for Reconsideration Under Local Rule 7-18

Defendants contend that the Weiss and Alexander declarations should be stricken because Acacia did not move for reconsideration of the Court's *Markman Order* pursuant to Local Rule 7-18, and that the time for Acacia to bring a motion for reconsideration has passed. Defendants are wrong.

First, there is no limitation in Local Rule 7-18 as to when Acacia must bring a motion for reconsideration, even if a motion for reconsideration were required.

Second, a motion for reconsideration was not required because *Markman* orders are interlocutory and are always subject to revision in the Court's discretion as its understanding of the technology evolves. Intellectual Property Dev., Inc. v. UA-Columbia Cablevision of Westchester, Inc., 2002 U.S. Dist. Lexis 17, **14-15 (S.D.N.Y. 2002) ("*Markman* decisions are interlocutory ... subject to revision any time before a judgment is rendered. This Court has the inherent discretion to reconsider the claim construction."); Utah Medical Products, Inc. v. Graphic Controls Corp., 350 F.3d 1376, 1382 (Fed. Cir. 2003) (trial court properly revised its claim construction because "it realized ... that [the] construction did not correctly define the invention.")

Lastly, this Court invited expert testimony concerning issues of indefiniteness which necessarily includes evidence and determination of what one of ordinary skill at the art would have understood the terms "sequence encoder" and "identification encoder" to mean in light of the specification at the time of the invention. The Federal Circuit teaches us that where, as here, a district court is unable unambiguously to construe a claim term from the intrinsic patent documents alone, the court must consider expert testimony of the type Acacia has provided. See, e.g., Verve, LLC v. Crane Cams & Equipment Co., Inc., 311 F.3d 1116, 1119-1120 (Fed.

Cir. 2002) (reversing summary judgment of indefiniteness: "[T]he Court erred in law in requiring that the intrinsic evidence of the specification and prosecution history is the sole source of meaning of words that are used in a technological context." This Court, consistent with the law, should consider any expert testimony provided by the parties on these issues and determine the legally correct construction of the claim terms "identification encoder" and "sequence encoder."[2]

C. Controlling Federal Circuit Precedent Requires That the Court Consider Acacia's Expert Declaration Testimony as to the Meaning of the Disputed Claim Terms Discernible to One Skilled in the Art, Because the Court Cannot Determine Their Meaning from the Intrinsic Patent Documents

It is absolutely proper, indeed required, for this Court to consider extrinsic expert testimony as to whether one of ordinary skill in the art would have understood the meaning of the terms "sequence encoder" and "identification encoder," when read in light of the specification, and, if so, the meaning of the terms understood by one of skill in the art.

The Federal Circuit has held that it would be legal error for a district court to rely exclusively on the intrinsic patent evidence, and thereby ignore expert testimony, when considering a motion for summary judgment of indefiniteness. Thus, district courts are required to consider expert testimony, if presented, on the meaning of claim terms when considering motions for summary judgment of indefiniteness. In Verve, 311 F.3d at 1119-1120, the district court, based solely on the intrinsic record, granted summary judgment that the disputed term "was indefinite" because it was not

---

[2] Acacia's expert declarants state that one skilled in the art would understand the "sequence encoder" limitation of the claims to be the "time encoder" disclosed in the specification as a preferred embodiment. The Court's failure to consider this testimony would result in violation of the familiar cannon of claim construction that "a claim construction that excludes the preferred embodiment is rarely, if ever correct and would require highly persuasive evidentiary support." Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583 (Fed. Cir. 1996).

"supported in the specification and prosecution history by a sufficiently clear definition." Id. at 1119. The Federal Circuit vacated the summary judgment and remanded for "further proceedings, including any appropriate recourse to extrinsic evidence concerning the usage and understanding of the [disputed] term 'substantially' in relevant context." Id. at 1120. The Federal Circuit reasoned that:

> [T]he court erred in law, in requiring that the intrinsic evidence of the specification and prosecution history is the sole source of meaning of words that are used in a technologic context. While reference to intrinsic evidence is primary in interpreting claims, the criterion is the meaning of words as they would be understood by persons in the field of the invention. Patent documents are written for persons familiar with the relevant field.... The question is not whether the [disputed term] has a fixed meaning ..., but how the phrase would be understood by persons experienced in [the] field ..., upon reading the patent documents.

Id. at 1119-1120; see also AFG Indus., Inc. v. Cardinal IG Co., 239 F.3d 1239, 1248-49 (Fed. Cir. 2001) (vacating summary judgment that was based on district court's erroneous claim construction: "This case presents a good example of how extrinsic evidence can and should be used to inform a court's claim construction, and how failure to take into account the testimony of persons of ordinary skill in the art may constitute reversible error....)[3]

---

[3] Expert testimony is always properly considered by a court when the intrinsic evidence alone is insufficient to construe the claim. Vitronics, 90 F.3d at 1584 ("No doubt there will be instances in which intrinsic evidence is insufficient to enable the court to determine the meaning of the asserted claims, and in those instances, extrinsic evidence, such as that relied on by the district court, may also properly be relied on to understand the technology and to construe the claims."); Digital Biometrics, Inc. v. Identix, Inc., 149 F.3d 1335, 1344 (Fed. Cir. 1998) ("However, if after consideration of the intrinsic evidence there remains doubt as to the exact meaning of the claim terms, consideration of extrinsic evidence may be necessary to determine the proper construction."); Key Pharms. v. Hercon Labs Corp., 161 F.3d 709, 716-18 (Fed. Cir.

Similarly, in Bancorp Services, L.L.C. v. Hartford Life Insurance Co., 359 F.3d 1367 (Fed. Cir. 2004), the district court granted summary judgment of indefiniteness, but only considered only the testimony of defendant Hartford's expert, while rejecting the testimony of the plaintiff Bancorp's expert on the meaning of the disputed term to one of skill in the art.[4] Id. at 1370. The Federal Circuit reversed the finding of indefiniteness, because, among other things, the district court committed error by failing to consider Bancorp's expert's testimony. Id. at 1374-75 ("It was therefore error for the court to decline to consider Mr. Mylnechuck's evidence regarding the meaning of a term used in connection with stable value protected investments.")[5]

D. The Weiss and Alexander Declarations are Admissible Under Fed. R. Evid. 702

Defendants contend that the Weiss and Alexander declarations should be stricken under Fed. R. Civ. P. 56(e), because they fail to meet the admissibility requirements of Fed. R. Evid. 702. In particular, defendants contend that, because

---

1998) ("[A] trial court is quite correct in hearing and relying on expert testimony on an ultimate claim construction question in cases in which the intrinsic evidence . . . does not answer the question...."); Jack Gutman, Inc. v. Kopykake Enterprises, Inc., 302 F.3d 1352, 1361 (Fed. Cir. 2002) ("District courts may engage in a rolling claim construction, in which the court revisits and alters its interpretation of the claim terms as it understanding of the technology evolves. This is particularly true where issues involved are complex, either due to the nature of technology, or *because the meaning of the claims is unclear from the intrinsic evidence.*"; emphasis added); See also, Cybor Corp. v. FAS Technologies, Inc., 138 F.3d 1448, 1454 (Fed. Cir. 1998) (*en banc*) (holding that the Federal Circuit reviews claim construction *de novo* and discussing the role of intrinsic evidence: "the court is looking to the extrinsic evidence to assist in its construction of the written document, a task it is required to perform.")

[4] The district court rejected Bancorp's expert's testimony, because it believed that the expert's expertise was only in a field outside of the relevant field of art for the patent. The Federal Circuit, however, held that the relevant field of art of the patent was broader than that considered by the district court and thus Bancorp's expert did have expertise in the relevant field of art. Bancorp, 359 F.3d at 1375.

[5] Expert testimony relating to indefiniteness was also presented by the parties and considered by the court in connection with a summary judgment motion of indefiniteness in Exxon Research and Engineering Co. v. U.S., 265 F.3d 1371, 1383 (Fed. Cir. 2001) and in connection with a jury trial on the issue of indefiniteness in BJ Services Company v. Halliburton Energy Services, Inc., 338 F.3d 1368, 1372-73 (Fed. Cir. 2003).

Weiss and Alexander declarations deviate from the Court's *Markman Order*, the testimony offered in the Weiss and Alexander declarations does not comport with reliable scientific principles and methods. According to defendants, the Court's *Markman Order* is final and Weiss and Alexander are bound by, and cannot deviate from, all statements and findings made by the Court. (Motion to Strike, at 8:16-22, 10:1-17, and 13:15-28).

Defendants contend that because the experts Weiss and Alexander arrive at a different conclusion than the Court's regarding whether one skilled in the art could discern a meaning from the specification for the disputed terms, their expert testimony is per se unreliable under Fed. R. Evid. 702 and Daubert. Defendants misapprehend both the role of expert testimony in ascertaining the meaning of the claims from the vantage point of one skilled in the art and the test of reliability.

Defendants' argument is completely wrong; they have it backwards. Expert testimony concerning what one of ordinary skill in the art at the time of the invention would have understood a claim term to mean in light of the specification is information to be used by a Court in subsequently construing a claim term, not the opposite. What this Court said in 2004 *cannot be considered* by an expert whose task it is to simply tell us, as of 1991, what one of ordinary skill in the art would have understood the terms "sequence encoder" and "identification encoder" to mean in light of the specification. Defendants' argument to the contrary is simply another iteration of their contention, discussed at length in the Introduction to this opposition brief, that the Court has concluded its claim construction activities and that the Court's determinations on claim construction, indefiniteness, and enablement are final and binding so that no further legal or factual inquiry is required. If that were the case, the Court would not have invited expert testimony by both sides. Moreover, it cannot be the case because the Federal Circuit, in these circumstances, requires this Court to consider these facts proffered by experts in determining the correct

construction of claim terms. See Vitronics, 90 F.3d at 1584, 1585; Verve, 311 F.3d at 1119-20; Bancorp, 359 F.3d at 1374-75.

The Weiss and Alexander declarations are proper expert testimony and are therefore admissible pursuant to Fed. R. Evid. 702. A prerequisite for admissibility under Rule 702 is whether the specialized knowledge of the expert "will assist the trier of fact to understand the evidence." It is indisputable that Weiss and Alexander both have specialized knowledge and experience in the technology disclosed in the '702 patent. In their declarations, Weiss and Alexander do not engage in claim construction which is the province of the Court – they answer fact questions which this Court can then use in its task of construing claims. They properly consider the intrinsic patent evidence and information available to one skilled in the art in early 1991 to: (1) show that one of ordinary skill in the art would have understood the meaning of the terms "sequence encoder" and "identification encoder," when read in light of the specification; (2) show how one of ordinary skill in the art would have defined these terms; and (3) show that one of skill in the art would have been enabled by the specification, in January 1991, to make and use an "identification encoder." As set forth by the Federal Circuit in Verve, 311 F.3d at 1119-1120, a court is required dto consider such expert testimony, in cases such as this one, where the court is unable to construe a claim term using only the intrinsic patent evidence, and therefore the Weiss and Alexander testimony "will assist the trier of fact to understand the evidence."

The Weiss and Alexander declarations are wholly competent and reliable under Fed. R. Evid. 702 and Daubert v. Merrell Dow Pharm., Inc., 508 U.S. 579 (1993). Expert testimony which applies specialized knowledge and experience to the language of a patent is a reliable method of determining how one of ordinary skill in the art would interpret claim language. Aspex Eyewear, Inc. v. E'Lite Optik, Inc., 2002 U.S. LEXIS 14834, *94-95 (N.D. Tex. 2002) ("The court considers this methodology – that of applying specialized knowledge and experience to the language and

prosecution history of a specific patent in order to determine the meaning of its terms – to be reliable for determining how one with ordinary skill in the art would interpret the claim language of the '207 patent.")

Finally, defendants cite three cases supporting their motion to strike, none of which is applicable to the facts of this case. In two of the cases cited by defendants, the court had already construed the claims and was performing the second step of the two-step process for determining infringement – comparing the properly construed claims to the allegedly infringing device.[6] See, DeMarini Sports, Inc. v. Worth, Inc., 239 F.3d 1314, 1330 (Fed. Cir. 2001) ("After claim construction, the next step in an infringement analysis is comparing the properly construed claims with the allegedly infringing devices.") Where the Court had construed the term, it was improper for an expert to use a different construction when providing an opinion as to whether the accused device was covered by the claim. In the third case, the court was performing the second step of the two-step process for determining patent invalidity for non-enablement – determining whether the claims as properly construed are enabled.[7] See, e.g., TI Group Auto. Sys. v. VDO N. Am., L.L.C., 375 F.3d 1126, 1139 (Fed. Cir. 2004) (patent validity is a two step process with the first step being the proper construction of the claims). In this case, unlike the cases cited by defendants, the Court is necessarily still working on the first step, claim construction,[8] since that is the

---

[6] In DeMarini, the expert's testimony that the accused device has the same structure as that in the claims could not be relied upon, because the expert's testimony "runs contrary to the construction of claim 15 set forth above." DeMarini, 239 F.3d at 1331.

In Papst Licensing GmbH and Co. KG v. Sunonwealth Elec. Machine Ind. Co., Ltd., 332 F. Supp. 2d 1142, 1148 (N.D. Ill. 2004), the court had given the claim term "polygon" a particular meaning. In arguing for infringement (not claim construction), however, Papst ignored the court's construction of "polygon."

[7] In Liquid Dynamics Corp. v. Vaughn Co., Inc., 2004 WL 2260626 (N.D. Ill. 2004), the expert testified that Figure 6 of the patent was not enabled. This was irrelevant, because the court had previously held that the claims did not require strict adherence to the structure of Figure 6. Liquid Dynamics, 2004 WL 2260626, at *4-5.

[8] The issue of indefiniteness arises out of the court's performance of its duty to

only legally relevant reason for this Court to have invited and thereafter consider expert testimony of the type requested.

III. CONCLUSION

For all foregoing reasons and authorities, Acacia respectfully requests that the motion to strike its expert declarations be denied.

DATED: November 18, 2004

HENNIGAN, BENNETT & DORMAN LLP

By: /s/
Roderick G. Dorman
Alan P. Block
Kevin I. Shenkman

Attorneys for Plaintiff
ACACIA MEDIA TECHNOLOGIES CORPORATION

---

construe the claims. Personalized Media Communications L.L.C. v. ITC, 161 F.3d 696, 705 (Fed. Cir. 1998). A decision on indefiniteness therefore concerns only the construction of the claim – either the claim is indefinite, or, if it is not, it must be construed.

PROOF OF SERVICE

I declare as follows:

I am a citizen of the United States and employed in Los Angeles County, California. I am over the age of eighteen years and not a party to the within-entitled action. My business address is 601 South Figueroa Street, Suite 3300, Los Angeles, California 90017.

On **November 18, 2004**, I served a copy of the within document described as **ACACIA'S OPPOSITION TO DEFENDANTS' MOTION TO STRIKE WEISS AND ALEXANDER EXPERT DECLARATIONS** by transmitting via United States District Court for the Central District of California Electronic Case Filing Program the document listed above by uploading the electronic files for each of the above listed document on this date, addressed as set forth on the attached Service List.

The above-described document was also transmitted to the parties indicated below, by Federal Express only.

Chambers of the Honorable James Ware
Attn: Regarding Acacia Litigation
280 South First Street
San Jose, CA 95113
3 copies

I am readily familiar with Hennigan, Bennett & Dorman LLP's practice in its Los Angeles office for the collection and processing of mail with the United States Postal Service; pursuant to that practice, envelopes placed for collection at designated locations during designated hours are deposited with the United States Postal Service with first class postage thereon fully prepaid that same day in the ordinary course of business; and,

I am readily familiar with Hennigan, Bennett & Dorman LLP's practice in its Los Angeles office for the collection and processing of federal express with Federal Express.

I declare that I am employed in the office of a member of the bar of this Court at whose direction the service was made.

Executed on **November 18, 2004**, at Los Angeles, California.

/s/
Lisa Spears

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

SERVICE LIST

Juanita Brooks, Esq. Todd G. Miller, Esq. Fish & Richardson P.C. 12390 El Camino Real San Diego, California 92130 ***Attorneys for Defendants Ademia Multimedia, LIC - Adult Entertainment Broadcast Network Audio Communications - Cyberheat, Inc. - Game Link, Inc. - Holio.Net L.L.C. - Lightspeedcash - Matrix Content, Inc. - New Destiny - VS Media, Inc.***	Jonathan E. Singer, Esq. William R. Woodford, Esq. Fish & Richardson P.C. 60 South Sixth Street 3300 Dain Rauscher Plaza Minneapolis, Minnesota 55402 ***Attorneys for Defendants Ademia Multimedia, LIC - Adult Entertainment Broadcast Network Audio Communications - Cyberheat, Inc. - Game Link, Inc. - Holio.Net L.L.C. - Lightspeedcash - Matrix Content, Inc. - New Destiny - VS Media, Inc.***
Gregory B. Wood, Esq. Fulbright & Jaworski L.L.P. 865 S. Figueroa Street, 29th Floor Los Angeles, CA 90017 ***Attorneys for Defendant ASKCS.com, Inc.***	Douglas W. Sprinkle, Esq. Mark Schneider, Esq. Gifford, Krass, Groh, Sprinkle, Sanderson & Citkowski 280 N. Old Woodward Ave., Suite 400 Birmingham, Michigan 48009 ***Attorneys for Defendant ASKCS.com, Inc.***
Victor de Gyarfas, Esq. Foley & Lardner 2029 Century Park East, 35th Floor Los Angeles, CA 90067-3021 ***Attorneys for Defendant Cybertrend, Inc.***	Gary A. Hecker, Esq. James M. Slominski, Esq. The Hecker Law Group 1925 Century Park East, Suite 2300 Los Angeles, Ca 90067 ***Attorneys for Defendant/Counterclaimant Offendale Commercial Limited BV***
David A. York, Esq. Adam Alper, Esq. Latham & Watkins 135 Commonwealth Drive Menlo Park, CA 94025 ***Attorneys for Defendants ICS, Inc. and AP Net Marketing***	