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16 UNITED STATES DISTRICT COURT  
 17 NORTHERN DISTRICT OF CALIFORNIA  
 18 OAKLAND DIVISION

20 GOOGLE INC.,

21 Plaintiff,

22 v.

23 NETLIST, INC.

24 Defendant.

CASE NO. C08 04144 SBA

[Related to civil Action No. C09-05718 SBA]

**DEFENDANT NETLIST, INC.'S  
 OPPOSITION TO GOOGLE INC.'S  
 MOTION FOR SUMMARY JUDGMENT  
 OF INVALIDITY**

Date: July 27, 2010  
 Time: 1:00 p.m.  
 Place: Courtroom 3  
 Judge: Hon. Sandra Brown Armstrong

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1 Netlist, Inc. (“Netlist”) hereby opposes Google Inc.’s (“Google”) motion for summary  
2 judgment of invalidity (“Motion”).

### 3 4 I. INTRODUCTION

5 Google seeks to invalidate Netlist’s patent-in-suit, U.S. Patent No. 7,289,386 (the “’386  
6 Patent”), for allegedly failing to satisfy the “written description” requirement of 35 U.S.C.  
7 §112(1). According to Google, it is entitled to summary judgment because the ‘386 Patent  
8 drawings do not depict the limitation of claim 1 that “the logic element further responds to a first  
9 command signal from the computer system by generating a second command signal transmitted  
10 to the plurality of memory devices” (the “second command signal limitation”).

11 Google ignores two key facts that quickly dispose of its Motion: 1) the second command  
12 signal limitation was *identically recited* in the original claims submitted with the application for  
13 the ‘386 Patent, and 2) the text of the specification describes the second command signal  
14 limitation. Google attempts to mislead the Court by suggesting that compliance with a Patent  
15 Office Rule, 37 C.F.R. 1.83(a), is required in order to satisfy the written description requirement.  
16 However, such a requirement has never been imposed by Congress or the courts and cannot be  
17 reconciled with the separate drawing statute set forth in 35 U.S.C. § 113. Thus, the Court should  
18 deny Google’s motion.

### 19 20 II. STATEMENT OF FACTS

21 The application for the ‘386 Patent was filed on July 5, 2005. Original Application,  
22 Transmittal Sheet (Declaration of Steven R. Hansen, dated July 6, 2010 (“Hansen Dec.”) ¶ 3;  
23 Exhibit (“Exh.”) “A”). At the time it was filed, the second command signal limitation was  
24 recited in dependent claim 12 (as shown in bold), which read as follows:

25 12. The memory module of Claim 8, wherein **the logic element further**  
26 **responds to a first command signal from the computer system by generating**  
27 **a second command signal transmitted to the plurality of memory devices,** the  
28 first command signal corresponding to the second number of ranks and the second  
command signal corresponding to the first number of ranks.

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Original Application at 43 (Hansen Dec. ¶3, Exh. “A”). In the first office action, the Examiner found claim 12 to be allowable if rewritten to include the limitations of its base claim (1) and intervening claim (8):

**Claims 12-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.**

Non-final Office Action, dated January 26, 2007 at 11 (original emphasis) (Hansen Dec. ¶4, Exh. “B”). Netlist therefore amended claim 12 to include all of the limitations of claims 1 and 8. Amendment and Response to January 26, 2007 Office Action at 2 (Hansen Dec. ¶5, Exh. “C”). As a result, the application was allowed on July 30, 2007. Notice of Allowance and Issue Fee Due, dated July 30, 2007 (Hansen Dec. ¶6, Exh. “D”).

In addition, the Detailed Description of Exemplary Embodiments in the ‘386 Patent specification describes the second command signal limitation as follows:

In response to the set of input control signals, **the logic element 40 generates a set of output control signals which includes address and command signals.**

In certain embodiments, the set of output control signals corresponds to a first number of ranks in which the plurality of memory devices 30 of the memory module 10 are arranged . . . .

The ‘386 Patent at 7:2-10 (Hansen Dec. ¶7, Exh. “E”) (emphasis added). The foregoing excerpt makes clear that the logic element 40 generates command signals that correspond to the first number of ranks in which *the plurality of memory devices are arranged*. Google’s Motion does not address either the originally-filed claims or the foregoing specification reference. With respect to the latter, Google quotes deposition testimony from Netlist’s expert Rick Turley wherein he was unable to quickly identify the portion of the specification that addressed the command signal limitation. Google’s Motion at 7:9-13. Google carefully avoids arguing that the specification does not describe the limitation because it knows it is not true. Instead, it

1 allows the Court to draw that erroneous inference by quoting Mr. Turley instead of addressing  
2 the actual specification statements.

3  
4 **III. ARGUMENT**

5 **THE COURT SHOULD DENY GOOGLE’S MOTION FOR SUMMARY**  
6 **JUDGMENT**

7 “Because a patent is presumed to be valid, see U.S.C. § 282 (1994), the party asserting  
8 invalidity has the burden of showing invalidity by clear and convincing evidence.” *WMS*  
9 *Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 1355 (Fed. Cir. 1999).

10 Therefore, as a party asserting an invalidity affirmative defense, Google must show by clear and  
11 convincing evidence that there is no genuine issue of a material fact as to whether claims 1 and  
12 11 meet the written description requirement. *See id.* Not only does Google fall far short of  
13 meeting its burden of proof, but the undisputed facts show that Claims 1 and 11 of the ‘386  
14 Patent do comply with the written description requirement. Regardless of whether the second  
15 command signal limitation is shown in the patent drawings, the limitation was identically recited  
16 in originally-filed claim 12 and is also set forth in the text of the specification. Thus, Google’s  
17 Motion should be denied.

18 The written description requirement is set forth in paragraph 1 of 35 U.S.C. § 112:

19 The specification shall contain a written description of the invention, and of the  
20 manner and process of making and using it, in such full clear, and concise, and  
21 exact terms as to enable any person skilled in the art to which it pertains or with  
22 which it is most nearly connected, to make and use the same, and shall set forth  
the best mode contemplated by the inventor of carrying out the invention.

23 35 U.S.C. § 112, ¶ 1.<sup>1</sup>

24 The written description requirement serves “to ensure that the inventor had possession, as  
25 of the filing date of the application relied on, of the specific subject matter later claimed by him;

26 \_\_\_\_\_  
27 <sup>1</sup> In addition to the written description requirement, the foregoing paragraph also sets forth the  
enablement and best mode requirements, which are not at issue in Google’s Motion.

1 how the specification accomplishes this is not material.” *In re Alton*, 76 F.3d 1168, 1172 (Fed.  
2 Cir. 1996) (citing *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976)). In order to meet the written  
3 description requirement of 35 U.S.C. §112(1), “the applicant **does not have to utilize any**  
4 **particular form of disclosure to describe the subject matter claimed**, but ‘the description  
5 must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what  
6 is claimed.’” *In re Alton*, 76 F.3d at 1172 (emphasis added) (citing *In re Gosteli*, 872 F.2d 1008,  
7 1012 (Fed. Cir. 989).) “[T]he applicant must ... convey with reasonable clarity to those skilled in  
8 the art that, as of the filing date sought, he or she was in possession of the invention.” *Vas-*  
9 *Cath*, 935 F.2d at 1563-64. In determining whether a claim satisfies the written description  
10 requirement, courts look to whether the specification as a whole would have failed to convey the  
11 invention to one skilled in the art. *See Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1539 (Fed.  
12 Cir. 1997). Google’s Motion is predicated on the assumption that the drawings alone define the  
13 metes and bounds of a patent’s written description. Google is wrong. As set forth below, it is  
14 black letter law that originally-filed claims and the specification text comprise part of the written  
15 description.

16  
17 **A. NETLIST’S ORIGINALLY FILED CLAIM 12 ESTABLISHES THAT CLAIM 1**  
18 **SATISFIES THE WRITTEN DESCRIPTION REQUIREMENT**

19 As the text of 35 U.S.C. § 112 clearly indicates, the written description requirement  
20 concerns the disclosure contained in the patent specification. Moreover, “[t]he original claims as  
21 filed are part of the patent specification.” *Northern Telecom, Inc. v. Datapoint Corporation*, 908  
22 F.2d 931, 938 (Fed. Cir. 1990). *See also, Union Oil Co. v. Atlantic Richfield Co., et al.*, 208  
23 F.3d 989, 998 (Fed. Cir. 2000)(“One of this court’s predecessor courts clarified that disclosure in  
24 an originally filed claim satisfies the written description requirement”). This black letter  
25 principle follows from the fact that paragraph 2 of 35 U.S.C. § 112 defines the specification as  
26 including the claims: “The specification shall conclude with one or more claims . . . .”

1 In this case, the second command signal limitation was *identically recited* in Netlist’s  
2 originally-filed claims. Google ignores this point completely. The *Union Oil* case involved a  
3 similar situation. In that case, the accused infringers sought to invalidate a claim directed to  
4 unleaded gasoline under the written description requirement. The subject patent claim recited  
5 the limitation “a 90% D-86 distillation point no greater than 300 degrees F.” *Union Oil*, 208  
6 F.3d at 992. The Federal Circuit held that the limitation met the written description requirement  
7 because it was “claimed exactly in original [application] claim 29.” *Id.* at 998 (second claim  
8 limitation in the table shown). *See also*, Manual of Patent Examining Procedure at § 608.01(1)  
9 (Hansen Dec. ¶9, Exh. “H”) (“In establishing a disclosure, applicant may rely not only on the  
10 description and drawing as filed but also on the original claims if their content justifies it”).  
11 Because the second command signal limitation was included in Netlist’s original claims,  
12 Google’s Motion must be denied.

13

14 **B. THE WRITTEN DESCRIPTION REQUIREMENT DOES NOT MANDATE THE**  
15 **INCLUSION OF CLAIM FEATURES IN DRAWINGS**

16 As indicated above, contrary to Google’s argument, the written description requirement is  
17 directed to the content of “the specification” not merely the technical drawings. Google has not  
18 asserted or attempted to show that the “written description,” comprising the text of the patent and  
19 the originally-filed claims, fails to support the command signal limitation. They have not offered  
20 any evidence, such as expert witness testimony, that one of ordinary skill in the art would not  
21 have considered the inventors to have been in possession of the command signal limitation at the  
22 time the application for the ‘386 patent was filed. Therefore, Google has not met its *prima facie*  
23 burden of establishing the absence of a genuine issue of material fact.

24 In this case, the originally-filed claims and the Detailed Description of Exemplary  
25 Embodiments in the ‘386 Patent describe the second command signal limitation and clearly  
26 convey that Netlist’s inventors were in possession of that limitation at the time the application  
27 for the ‘386 Patent was filed.

28

1 Unlike the written description requirement and other specification requirements of 35  
2 U.S.C. § 112, drawing requirements are separately spelled out in 35 U.S.C. § 113, which requires  
3 drawings only “where necessary for the understanding of the subject matter sought to be  
4 patented.” The same section also provides that “the Director [of the Patent & Trademark Office]  
5 may require” the submission of a drawing “[w]hen the nature of the subject matter admits of  
6 illustration by a drawing and the applicant has not furnished a drawing . . . .” However, section  
7 113 does not provide a basis for invalidating a patent claim. *See* 35 U.S.C. § 282(3) (stating that  
8 sections 112 and 251 may provide an invalidity defense but omitting section 113). Moreover,  
9 Google has not and cannot establish that the patented subject matter cannot be understood unless  
10 the second command signal limitation is shown in a drawing.

11 Google incorrectly states that for the written description requirement of 35 U.S.C. §  
12 112(1) to be satisfied, the figures of the patent must show ‘**every feature of the invention**  
13 **specified in the claims,**’ as required under 37 C.F.R. 1.83(a).” (Motion p. 8:18-21 (emphasis in  
14 original).) However, Google cites no statute or case for this proposition because it is not the  
15 law. Contrary to Google’s assertion, the Federal Circuit has “explained that the written  
16 description requirement can be satisfied by words” as well as by “figures, diagrams, formulas,  
17 etc.” *Koito Mfg. Co., Ltd., et al. v. Turn-Key-Tech LLC, et al.*, 381 F.3d 1142, 1154 (Fed. Cir.  
18 2004).

19 Google misleadingly suggests that a Patent Office Rule provided in 37 C.F.R. 1.83(a)  
20 defines a standard for compliance with the written description requirement. Google cites this  
21 district’s opinion in *Acacia Media Technologies Corp. v. New Destiny Internet Group*, 2006 U.S.  
22 Dist LEXIS 93710, 2006 WL 3707987 (N.D. Cal. 2006) in alleged support of this proposition.  
23 However, the opinion is inapposite. *Acacia* is a claim construction opinion. The issue of written  
24 description invalidity was neither before the court nor addressed by it. With respect to one claim  
25 limitation at issue, the court noted that it was not depicted in the drawings, and as a result, the  
26 court deferred construing the disputed limitation until it held further proceedings to determine if  
27 the subject claim complied with the written description requirement:

1 Claim 2 of the '275 provides no drawings of a reception system communicating  
2 with the receiving system. Therefore, the Court declines to give a construction to  
3 the phrase "playing back the stored copy of the information from the reception  
4 system to the receiving system" pending further proceedings to determine whether  
5 Claim 2 of the '275 Patent complies with the written description requirement of 35  
6 U.S.C. § 112.

7 *Id.* at \*78-79. The Court did not hold the subject claim invalid because the drawings lacked the  
8 disputed claim limitation. Nor did the Court hold that 37 C.F.R. 1.83 provides a standard for  
9 assessing compliance with the written description requirement. To the contrary, the Court held  
10 that despite the fact that the drawings did not show the disputed claim limitation, *further*  
11 *proceedings were required* to determine if the written description requirement had been met. If,  
12 as Google suggests, the *Acacia* court had held that drawings were required to satisfy the written  
13 description requirement, no further proceedings would have been necessary.

14 Unlike *Acacia*, *Novo Nordisk A/S, et al. v. Becton Dickinson & Co.*, 96 F.Supp.2d 309  
15 (S.D.N.Y. 2000), *aff'd*, 304 F.3d 1216 (Fed. Cir. 2002) deals with the written description  
16 requirement. In *Novo Nordisk*, the Patent Examiner required the patentee to add drawings to the  
17 application *after* it was filed because the invention "admit[ted] of illustration." *Novo Nordisk*, 96  
18 F.Supp.2d at 314. The accused infringer argued that for purposes of the written description  
19 requirement, the added drawings necessarily added disclosure that was not present at the time of  
20 filing. *Id.* The court disagreed, holding that the "absence of drawings from the application as  
21 originally filed does not, *ispo facto*, require a finding that the subject matter depicted in the  
22 drawings was not disclosed in the original application." *Id.* The *Novo Nordisk* decision makes  
23 clear that claim features need not be shown in patent drawings in order to satisfy the written  
24 description requirement. Google's contrary assertion should be rejected.

### 25 **C. GOOGLE FAILED TO RAISE THE PRESENT GROUNDS FOR PATENT** 26 **INVALIDITY IN ITS INVALIDITY CONTENTIONS**

27 In its Invalidity Contentions, Google did not assert that the '386 Patent claims were  
28 allegedly invalid because of a failure to disclose the second command signal limitation in the

1 '386 Patent's written description. Under this district's Patent Local Rules, Google should be  
2 precluded from now asserting this defense.

3 Patent Local Rule 3-3 states:

4 Not later than 45 days after service upon it of the "Disclosure of Asserted Claims and  
5 Infringement Contentions," each party opposing a claim of patent infringement, shall  
6 serve on all parties its "Invalidity Contentions" which shall contain the following  
information:

7 ...

8 (d) Any grounds of invalidity based on 35 U.S.C. § 101, indefiniteness under 35 U.S.C. §  
9 112(2) or enablement or written description under 35 U.S.C. § 112(1) of any of the  
asserted claims.

10 On April 13, 2009 Google served its Invalidity Contentions. Hansen Dec. ¶ 8. While  
11 Exhibit 12 to the Invalidity Contentions mentioned the written description requirement, Google  
12 did not assert that the second command signal limitation failed to meet that requirement.  
13 Instead, Google asserted that "claim 1 is invalid for lack of written description and/or  
14 enablement under 35 U.S.C. § 112, ¶ 1" based on the claim limitation "second command signal  
15 corresponding to the first number ranks." Exhibit 12 to Google's Supplemental Invalidity  
16 Contentions (Hansen Dec. ¶ 8, Exhs. "F" and "G") (emphasis added). In contrast to the claim  
17 limitation identified in Google's Invalidity Contentions, the second command signal limitation at  
18 issue in Google's Motion is "the logic element further responds to a first command signal from  
19 the computer system by generating a second command signal transmitted to the plurality of  
20 memory devices." Under the Patent Local Rules, if Google wished to assert this new basis of  
21 written description invalidity, it was obligated to obtain "an order of the Court upon a timely  
22 showing of good cause." Patent Local Rule 3-6. Google never sought or obtained the required  
23 Court order. Moreover, on March 30, 2010, Google served Amended Invalidity Contentions and  
made no changes to its written description invalidity contentions.

24 Having failed to disclose the present alleged written description defense in its Invalidity  
25 Contentions or to obtain leave of court to amend its Contentions, Google should be precluded  
26 from seeking summary judgment on the basis that the second command signal limitation  
27 allegedly does not meet the written description requirement.

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**IV. CONCLUSION**

For the foregoing reasons, Google’s Motion should be denied.

DATED: July 6, 2010

LEE TRAN & LIANG APLC

By: /s/ Steven R. Hansen  
Steven R. Hansen  
Attorneys for Defendant NETLIST, INC.