

1 **I. JOINT INTRODUCTORY STATEMENT**

2 Pursuant to the Court’s March 12, 2008 Order Following Case Management Conference,
3 which adopted the schedule proposed by Acacia, the Internet Defendants, and the Cable Defendants
4 in the February 29, 2008 Joint Case Management Statement, the parties hereby submit this Joint
5 Stipulation.

6 Through the exchange of the lists of defendants’ proposed Section 112 motions, the lists of
7 proposed motions to which Acacia opposes and does not oppose, and the lists of motions which
8 defendants intend to make, it has become clear that the parties disagree as to the status of this matter
9 and the procedures that should be followed in the future.

10 Accordingly, this Joint Stipulation is divided into two parts. The first part is submitted by
11 Acacia only and sets forth Acacia’s position. The second part is submitted by the defendants only
12 and sets forth the position of all defendants.

13 **II. ACACIA’S POSITION**

14 Acacia has now stipulated to the invalidity of all of the patent claims at issue in this action as
15 a result of and based only upon this Court’s claim construction Orders. Judgment should be entered
16 without delay in defendants’ favor. Nonetheless, defendants now propose to file additional
17 summary judgment motions on alternative invalidity theories. Not only is there no case or
18 controversy relating to these alternative theories, but defendants’ proposal would condemn the
19 parties and Court to needlessly expend substantial time and expense to determine them. Even then,
20 as a result of material factual disputes, the entry of summary judgment is at best unlikely and will
21 only serve to delay the appeal of this matter.

22 Accordingly, the Court should enter summary judgment (on a motion to be brought by
23 Acacia or on its own motion) that all of the asserted claims are invalid (for the reasons stated in
24 Acacia’s stipulation) and that the Court should dismiss defendants’ counterclaims without prejudice.
25 This judgment would be a final judgment, which Acacia could then appeal to the Federal Circuit
26 without delay. No certification of any issue by this Court will be necessary.

1 **A. Factual Events Leading to this Joint Stipulation**

2 In its March 12, 2008 Order, the Court adopted the schedule proposed by Acacia, the Internet
3 Defendants, and the Cable Defendants whereby: (1) defendants would provide Acacia with a list of
4 Section 112 motions that they would propose to make in this phase of the case; (2) Acacia would
5 identify which of those proposed motions it would not oppose (and therefore agree to stipulate to
6 invalidity); and (3) depending upon which motions Acacia would not oppose and the claims to
7 which Acacia would stipulate as being invalid, defendants would identify which of its previously-
8 identified Section 112 motions it would proceed to make (presumably withdrawing motions if the
9 stipulations rendered moot any alternative grounds of invalidity).

10 At the Case Management Conference, Acacia made clear that, through this process of
11 identifying motions and non-opposition by Acacia, this case could be in a position for entry of a
12 final judgment and subsequent appeal, *without any further motions for the Court to consider*:

13 Mr. Dorman: Speaking for myself only, I'm personally hopeful that we are
14 going to be able to stipulate to enough that there may be no summary
15 judgment motions before you. That we're clearly going to get to, I
16 believe, a circumstance where, where there's a complete final judgment.

17 We may require certification, which under this circumstance, I
18 think, would be absolutely appropriate in light of your MDL duties, but
19 my own suspicion is that this entire case is going to be resolved subject
20 to appeal just by this process that we're doing. That's my view.

21 (See, March 7, 2008 Transcript, 58:10-21; Exhibit 1, hereto).

22 On March 28, 2008, defendants provided Acacia with two separate lists of proposed
23 motions. The EchoStar defendants acting by themselves identified seven proposed motions (some
24 with multiple subparts). (Exhibit 2, hereto). The remaining defendants identified thirty-five
25 proposed motions, some of which also had multiple subparts (Exhibit 3 hereto).¹

26 Acacia considered defendants' proposed lists of motions and, on April 4, 2008, responded by

27 ¹ For example, proposed motion no. 14 has eight subparts seeking judgment that each asserted claim
28 is invalid, because there is no written description or enablement for each element of the transmission
system (i.e., there is no disclosure of an element capable of performing the functions described in
the specification for that element). (Exhibit 3, at 3-4). Similarly, proposed motion no. 15 has seven
subparts for the same issues with respect to the receiving system. (Exhibit 3, at 4-5).

1 identifying nine motions which it would not oppose—two proposed motions from the EchoStar list
2 and seven proposed motions from the other defendants’ list (subject to Acacia’s objections and its
3 rights on appeal). (Exhibit 4, hereto). As a result of Acacia’s non-opposition to these motions, all
4 of the presently asserted patent claims against all defendants are rendered invalid for the reasons
5 identified in defendants’ proposed motions (which are based upon the Court’s claims construction
6 rulings), and, consistent with Acacia’s statement of non-opposition, Acacia prepared and served a
7 stipulation to this effect.² (Exhibit 5, hereto). This stipulation sets forth the claims and invalidity
8 grounds to which Acacia has stipulated and states that, as a result, every asserted claim is invalid
9 (subject to Acacia’s objections and rights on appeal). *Id.* As to the remainder of the EchoStar
10 defendants’ five proposed motions and the other defendants’ twenty-eight proposed motions, Acacia
11 stated that it would oppose those motions if filed. (Exhibit 4, at 3).

12 Acacia advised defendants that, consistent with its representations to the Court at the Case
13 Management Conference,³ Acacia is prepared to enter into a stipulated summary judgment that each
14 asserted claim is invalid, which can be entered by the Court as a final, appealable judgment.
15 (Exhibit 4, at 2). Acacia also explained that, if defendants would not so stipulate, Acacia would
16 bring its own motion for summary judgment requesting that the patent claims be held invalid for the
17 reasons set forth in its stipulation.

18 The defendants refused Acacia’s offer. The EchoStar defendants (now joined by DIRECTV)
19 responded to Acacia by stating that they intend to file all six of their proposed motions opposed by
20 Acacia. (Exhibit 6, hereto). The other defendants responded by stating that they intend to bring four
21

22 ² Defendants complain that Acacia has not provided the Internet Defendants with a covenant not to
23 sue as to Claims 1-18 of the ‘992 patent (See, Jt. Stip., at 21, fn. 27). Acacia has withdrawn those
24 claims, as it informed the Court in its Opposition to the Internet Defendants’ Motion for Summary
25 Judgment re ‘702 Patent filed on October 19, 2004, and provided a covenant not to sue: “Since this
26 past summer, Acacia has withdrawn claims 1-18 of the ‘992 patent from this case ***and will not
assert them against any defendant for any past, present, or future act.*** (Fact 27, Defendants’
Statement of Uncontroverted Facts; Dorman Decl. ¶ 7).” (Opposition, at 17:15-18; emphasis
added).

27 ³ See, e.g., March 7, 2008 Transcript, at 59:4-11; Exhibit 1.

1 “broadly-stated” motions and intend to bring additional motions (which Acacia opposes) on all
2 claim terms which the Court identified as “arguably indefinite.” (Exhibit 7, at 1-2 and n. 1). On
3 April 14, 2008, Acacia informed defendants that there is no agreement as to how to proceed in this
4 phase of the case, and therefore Acacia intends to provide the Court with Acacia’s portion of the
5 Joint Stipulation separately from that of the defendants. (Exhibit 8, hereto).

6 Although these defendants have attempted to re-package their motions to make it appear that
7 they are not filing on all of the issues initially identified by them,⁴ they clearly state that each of the
8 issues raised in the twenty-eight proposed motions identified in their original letter will be included.⁵

9 *Id.*

10 **B. Acacia’s Proposal Will Result in a Final, Appealable Judgment Requiring No**
11 **Certification by the Court**

12 **1. The Court Should Immediately Enter Summary Judgment of Invalidity**
13 **and Should Dismiss Without Prejudice All of Defendants’ Declaratory**
14 **Judgment Counterclaims**

15 As a consequence of this Court’s claim construction, Acacia agreed that it would not oppose
16 nine (9) of defendants’ proposed motions for summary judgment of invalidity and served a
17 stipulation to that effect. As a result, there is no dispute that all of the patent claims are invalid for
18 purposes of this litigation and, as a matter of law, cannot be infringed. Notwithstanding Acacia’s
19 admission of invalidity, defendants refuse to agree to the entry of judgment, insisting instead that
20 they be allowed to protract this matter by filing motions for summary judgment on numerous
21 alternative and disputed grounds also relating to invalidity. As there is no longer a case or
22 controversy regarding invalidity, and to avoid the needless expenditure of time and expense, Acacia

23 ⁴ Defendants’ re-packaging is contrary to the parties’ schedule which the Court adopted. According
24 to that schedule, defendants were to identify “which of its previously-identified § 112 motions it will
25 proceed to make.” (D.I. 267, at 3:1-4).

26 ⁵ In their portion of this Joint Stipulation, defendants contend that they have narrowed their lists of
27 proposed motions. (See, Jt. Stip., at 28:6-7). The only narrowing by defendants was to remove
28 from their lists the motions to which Acacia agreed to stipulate. The non-Satellite Defendants’ letter
specifically stated that their motions “will address all of the particular grounds itemized in [Mr.
Benyacar’s] March 28 letter that were not included in Acacia’s stipulation.” (Exhibit 7, at 1, n. 1).
This is hardly narrowing.

1 will bring a motion for summary judgment on Acacia’s claims and defendants’ counterclaims asking
2 the Court to adjudicate that all of the asserted claims are invalid as being indefinite, based on
3 Acacia’s stipulation, and, on that basis, asking the Court to dismiss without prejudice all of
4 defendants’ declaratory judgment counterclaims.⁶ (See, Exhibit 4, at 2).

5 Such a stipulation will be a final judgment, as it will adjudicate all claims in the case. No
6 certification by the Court under Rule 54(b) will be required. This is the most efficient manner for
7 the Court to bring this case to a conclusion and to permit the Federal Circuit to consider Acacia’s
8 appeal.

9 Acacia’s proposal to enter judgment of invalidity of all asserted and dismissal of all
10 counterclaims without prejudice is legally correct and Federal Circuit-approved. According to the
11 Federal Circuit, this Court has the power to dismiss, without prejudice, defendants’ declaratory
12 judgment counterclaims, including their non-infringement and unenforceability counterclaims
13 (regardless of whether the claim is moot):⁷

14 Second, the district court could have dismissed the counterclaim without
15 prejudice (either with or without a finding that the counterclaim was moot)
16 following the grant of summary judgment of non-infringement. “We have
17 previously held that a district court has discretion to dismiss a counterclaim
18 alleging that a patent is invalid as moot where it finds no infringement.”
19 *Phonometrics, Inc. v. N. Telecom Inc.*, 133 F.3d 1459, 1468 (Fed. Cir. 1998).
20 (citing *Nestier Corp. v. Menasha Corp.-Lewisystems Div.*, 739 F.2d 1576,
1580-81 (Fed. Cir. 1984)). We note that the Supreme Court’s decision in
Cardinal Chemical Co. v. Morton International, Inc., 508 U.S. 83, 124 L. Ed.
2d 1, 113 S. Ct. 1967 (1993), which prohibits us, as an intermediate court,

21 ⁶ The Court itself stated at the Case Management Conference that a motion that permits the Court to
22 find that it has adjudicated the case on its merits would have “a great deal of value.” (March 7, 2008
Transcript, at 56:11-18; Exhibit 1).

23 ⁷ The Court should be aware that there is only one counterclaim (called the Eighth Counterclaim),
24 brought by some of the Internet defendants, which is not a declaratory judgment counterclaim
25 related to patent invalidity, non-infringement, or unenforceability. The Eighth Counterclaim is for
26 unfair trade practices (the Court may recall that it denied Acacia’s motion to dismiss this claim,
27 although the Court did dismiss the Ninth Counterclaim for abuse of process.) Acacia has asked the
Internet defendants to stipulate to dismissal without prejudice of this claim to permit these MDL
proceedings to be appealed. If the Internet defendants do not agree to such a stipulation, then
Acacia shall also ask the Court in its motion for summary judgment to dismiss this counterclaim
without prejudice.

1 from vacating a judgment of invalidity when we conclude that a patent is not
2 infringed, does not preclude the discretionary action of a district court, in an
3 appropriate case, in dismissing an invalidity counterclaim without prejudice
4 when it concludes a patent is not infringed.

5 *See, Nystrom v. Trex Co., Inc.*, 339 F.3d 1347, 1351 (Fed. Cir. 2003).⁸

6 Dismissing defendants' counterclaims without prejudice is the most efficient procedure for
7 obtaining a final, appealable judgment without certification, especially in this MDL proceeding
8 involving numerous defendants. In *Nystrom*, a judgment of non-infringement of all claims and
9 invalidity of three of the asserted twenty claims was held to be non-appealable, because the district
10 court had stayed the defendants' counterclaims for invalidity of the remaining claims and for
11 unenforceability. *Nystrom*, 339 F.3d at 1349. The presence of these counterclaims meant that the
12 judgment was not final. *Id.*

13 The Federal Circuit set forth the four options that were available to the district court in order
14 to produce a final judgment where there are unresolved counterclaims:

- 15 1. The court could have proceeded to trial on the invalidity and unenforceability
16 counterclaims or otherwise disposed of the issue on the merits.⁹ *Id.*, at 1350;

17 ⁸ *See also, Z Trim Holdings, Inc. v. Fibergel Technologies, Inc.*, 2008 U.S. Dist. LEXIS 6086, *19
18 (D. Wis. 2008) ("For the same reason, defendant's counterclaims of invalidity and unenforceability
19 must be dismissed. This court loses jurisdiction over these counterclaims once there is no longer an
20 ongoing 'case or controversy.' [citations omitted]. The only "case or controversy" asserted by
21 defendant is plaintiff's claim of patent infringement, which has been resolved."); *Digital Privacy,
22 Inc. v. RSA Sec., Inc.*, 199 F. Supp. 2d 457, 458-459 (E.D. Va. 2002) ("The court exercises its
23 discretion to grant Digital Privacy's motion for dismissal of the invalidity counterclaims as moot.
24 'Where, as here, noninfringement is clear and invalidity is not plainly evident, it is appropriate to
25 treat only the infringement issue.' *Leesona Corp. v. United States*, 208 Ct. Cl. 871, 530 F.2d 896,
26 906 n.9 (Ct. Cl. 1976) (quoted by *Phonometrics, Inc. v. Northern Telecom, Inc.*, 133 F.3d 1459,
27 1468 (Fed. Cir. 1998)"); *Pandrol USA, LP v. Airboss Railway Products, Inc.*, 320 F.3d 1354, 1362
28 (Fed. Cir. 2003).

⁹ Defendants contend that *Nystrom* supports their contention that the Court could proceed with
23 defendants' counterclaims for invalidity, infringement and unenforceability even though all of the
24 asserted claims are invalid. (Jt. Stip., at 23:5-9). The facts of *Nystrom*, however, are different than
25 those of this case. In *Nystrom*, the court held that all of the asserted claims were not infringed and
26 some, but not all, of the claims were invalid. As discussed *supra* (Jt. Stip., at 13:4-7), a finding of
27 infringement may not deprive the court of jurisdiction of invalidity because of public policy
28 considerations applicable only to invalidity. Those policy considerations do not apply when the
claims are invalid and the issue is infringement, i.e., infringement is mooted by invalidity, as
defendants themselves told the Court, (Response to Satellite Statement, at 4:17-5:6, D.I., 269,
quoted at 12:5-12). Additionally, and most applicable to the present issue, the Federal Circuit did
not hold that the parties could proceed further on any *alternative ground of non-infringement* (there

- 1 2. As discussed above, the court could have dismissed the counterclaims without
- 2 prejudice and entered judgment on the adjudicated claims; *Id.*, at 1351;
- 3 3. The court could have certified an appeal on fewer than all of the claims under Rule
- 4 54(b). *Id.*; or
- 5 4. The court have entered an immediately appealable interlocutory judgment under 28
- 6 U.S.C. § 1292(b).

7 *Nystrom*, 339 F.3d at 1350-51. Acacia proposes that the Court follow the second option set forth in
8 *Nystrom* (quoted above). Here, defendants have pending counterclaims for non-infringement and
9 unenforceability, which the Court can and should dismiss without prejudice so that the invalidity
10 issue adjudicated by the Court can be appealed.

11 Defendants contend that Acacia’s “approach is inefficient because it increases the potential
12 for further proceedings in this Court and the need for serial appeals.” (Jt. Stip., at 24:9-11). In
13 *Nystrom*, the Federal Circuit stated that “piecemeal litigation is strictly precluded by the rule of
14 finality for patent cases as it is for any other case,” but the court nevertheless approved of the
15 procedures proposed by Acacia here. *Nystrom*, 339 F.3d at 1350-51. Such procedures therefore do
16 not result in piecemeal litigation, as defendants contend.^{10 11}

17
18 already being a finding of non-infringement of all claims).

19 ¹⁰ In *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1384 (Fed. Cir. 2005), the court
20 dismissed as moot alternative grounds of invalidity and the parties appealed on only one ground of
21 invalidity. The court reversed on that invalidity ground and thus remanded to the district court for
22 further proceedings on the other invalidity grounds. *Invitrogen*, 424 F.3d at 1384 (“Finally,
23 Stratagene asks this court to consider its affirmative defenses of enablement, anticipation, and
24 obviousness, as alternate grounds for invalidity. Final judgment by the district court included an
order that invalidated the ‘797 patent based on public use under § 102(b), and on no other ground.
The district court declared moot the other invalidity claims and made no final judgment on them.
Therefore, under 28 U.S.C. § 1295(a)(1) (final judgment rule), this court declines to assert
jurisdiction to consider an appeal on these issues. This court reverses the trial court’s judgment of
invalidity due to public use . . . and remands for the case for further proceedings.”)

25 ¹¹ Defendants’ reliance on *Surgical Laser Techs., Inc. v. Surgical Laser Products, Inc.*, 27 U.S.P.Q.
26 2d 1614, 1993 U.S. Dist. LEXIS 1062, at *11 (E.D. Pa. 1993) and *Chapperal Communications, Inc.*
27 *v. Boman Indus., Inc.*, 798 F.2d 456, 459 (Fed. Cir. 1986), as demonstrating a disfavor for
“piecemeal” litigation, is misplaced. (See, Jt. Stip., at 25:8-12 and 25:27-26:3). Both cases
28 addressed requests under Rule 54(b) for certification of an appeal of less than all of the claims in the
case. These cases are inapplicable here, because Acacia is not seeking certification under Rule

1 In any event, any decision by this Court on less than every conceivable issue that could have
2 been tried has the risk of future appeals. While defendants' proposals include some additional
3 issues, they would not resolve all issues in this case and will not eliminate the risk of future appeals
4 on the many issues which still will not be resolved. Under Acacia's proposed procedure, there can
5 be no further appeals if defendants are successful on appeal anyway. Here, any risk of future
6 appeals associated with Acacia's position is substantially outweighed by the burdens placed upon
7 the Court and parties should defendants be allowed to proceed on the numerous issues they raise.

8 In their portion of this Stipulation, defendants contend that the Court retains jurisdiction to
9 decide defendants' claims for attorneys' fees under 35 U.S.C. § 285, including deciding whether the
10 patents are unenforceable for inequitable conduct. Defendants cite *Monsanto Co. v. Bayer*
11 *Bioscience N.V.*, 514 F.3d 1229, 1242-43 (Fed. Cir. 2008). In *Monsanto*, the court stated that,
12 although the plaintiff's covenant not to sue divested the court of Article III jurisdiction over the
13 patent-related counterclaims, the court nevertheless retained jurisdiction to decide a request for
14 attorneys' fees pursuant to Section 285 (which can be proven with a finding of inequitable
15 conduct).¹² ¹³ *Monsanto*, 514 F.3d at 1242. A request for attorneys' fees (which must be brought
16 within 14 days after entry of judgment)¹⁴, however, does not ripen until after a judgment on the
17 underlying claims has been entered (and thus a prevailing party is determined). Acacia only asks

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19 54(b); rather, it is asking for entry of a final judgment on all claims and dismissal without prejudice
20 of defendants' counterclaims. Defendants also make reference in their portion of this stipulation to
21 that fact that Acacia previously sought a judgment on the claims of the '702 patent. (See, Jt. Stip., at
22 19, fn. 24). Acacia's request, which the Court denied, was made under Rule 54(b) and sought
23 certification of an appeal on less than all of the claims. That request is also irrelevant to the present
24 issues.

25 ¹² Unlike *Monsanto*, there is no finding in this case of inequitable conduct. Not every defendant in
26 these MDL proceedings has plead an affirmative defense or counterclaim for inequitable conduct.

27 ¹³ Another Federal Circuit case held that an appeal of a claim for inequitable conduct was mooted by
28 a ruling of patent invalidity. *Mycogen Plant Science, Inc. v. Monsanto Co.*, 243 F.3d 1316, 1320
(Fed. Cir. 2001) ("Our ruling affirming patent invalidity moots the cross-appeals of inequitable
conduct and liability for inducement of infringement by Pioneer.") Here, there is a stipulation that
all asserted claims are invalid.

¹⁴ See, Fed.R.Civ.P. 54(d)(2)(B)(i); Civil L.R. 54-6.

1 that defendants' unenforceability counterclaims be dismissed without prejudice. If the appeals court
2 reverses, then defendants can re-assert their counterclaims in the remanded proceedings.

3 Defendants' proposed motions for summary judgment do not include any motions for
4 attorneys' fees or inequitable conduct anyway. Thus, even under defendants' proposed procedure,
5 the issues of attorneys fees and inequitable conduct will not be decided by the Court prior to appeal
6 and, if any pending counterclaim were to remain after defendants' motions are decided, it will have
7 to be dismissed without prejudice so that a final judgment can be entered. Whether or not the Court
8 has jurisdiction over the issues of attorneys' fees or inequitable conduct has nothing to do with the
9 issue of jurisdiction of patent invalidity issues.

10 **2. The Court Should Not Permit Defendants To File Any Section 112**
11 **Summary Judgment Motions On Alternative Invalidity Grounds, As**
12 **Such Motions Are Mooted By Acacia's Stipulation that All Asserted**
13 **Claims are Invalid And the Court Has No Further Jurisdiction**

14 The Court should not waste its resources adjudicating the numerous Section 112 summary
15 judgment motions that defendants' seek to file. Acacia has already stipulated to the invalidity of
16 each asserted claim, and thus the issues raised by these motions are moot.

17 Pursuant to Article III, § 2 of the U.S. Constitution, a district court has no authority to issue
18 "advisory opinions" upon moot questions. *See, Teva Pharm. USA, Inc. v. Novartis Pharm. Corp.*,
19 482 F.3d 1330, 1337-1338 (Fed. Cir. 2007) ("Similar to the ripeness doctrine and based on the same
20 constitutional 'controversy' requirement is the Court's prohibition against advisory opinions. Under
21 this doctrine, federal courts are to decide only 'actual controversies by judgment which can be
22 carried into effect, and not to give opinions upon moot questions or abstract propositions, or to
23 declare principles or rules of law which cannot affect the matter in the case before it.'"), *quoting*,
24 *Local No. 8-6, Oil, Chem. & Atomic Workers Int'l Union v. Missouri*, 361 U.S. 363, 367, 80 S. Ct.
25 391, 4 L. Ed. 2d 373 (1960); *See also, Spectronics Corp. v. H.B. Fuller Co.*, 940 F.2d 631, 635 (Fed.
26 Cir. 1991) ("The exercise of judicial power under Article III depends at all times on the existence of
27 a case or controversy."); *Aspex Eyewear, Inc. v. Miracle Optics, Inc.*, 2003 U.S. Dist. LEXIS 26356,
28 at * 6 (C.D. Cal. 2003) ("Article III, § 2 confines the federal judicial power to 'cases or

1 controversies.’ A federal court has no authority to give opinions upon moot questions.”), *citing*,
2 Tashima, Wagstaffe, *Federal Civil Procedure Before Trial*, § 2:1267.

3 A case is moot “when the issues presented are no longer ‘live’ or the parties lack a legally
4 cognizable interest in the outcome.” *Caraco Pharm. Laboratories, Ltd. v. Forest Laboratories, Inc.*,
5 2008 U.S. App. LEXIS 6838, *44-45 (Fed. Cir. 2008), *quoting*, *Powell v. McCormack*, 395 U.S.
6 486, 496-97 (1969). “The mootness doctrine requires that the requisite personal stake that is
7 required for a party to have standing at the outset of an action must continue to exist throughout all
8 stages of the action.” *Caraco*, 2008 U.S. App. LEXIS 6838, *44, *citing*, *United States Parol*
9 *Comm’n v. Geraghty*, 445 U.S. 388, 397 (1980).

10 In their portion of this Stipulation, defendants admit that the Court has discretion to dismiss
11 defendants’ claims based on “prudential mootness.” (Jt. Stip., at 23:10-24:1). While Acacia
12 believes that the Court is deprived of Article III jurisdiction of defendants’ claims based on
13 “jurisdictional mootness,”¹⁵ even if the Court were to disagree with Acacia, the Court can still
14 dismiss defendants’ claims based on “prudential mootness,” which, in those circumstances, it should
15 do to avoid the inefficiencies, waste, and significant delay of defendants’ numerous motions and to
16 promote judicial economy of an immediate appeal. Defendants cannot be heard to complain to the
17 appellate court if this Court were to dismiss based on “prudential mootness,” as they concede the
18 Court has such discretion.

19
20 ¹⁵ Defendants contend that there is a difference between “jurisdictional” and “prudential” mootness
21 and therefore Acacia is only asking that the Court exercise its discretion in the interests of judicial
22 economy, not that the Court is deprived of jurisdiction under Article III. As a result of all asserted
23 claims being invalid (as stipulated by Acacia based on the Court’s claim construction rulings): (1)
24 the Court has no Article III jurisdiction to adjudicate any other ground of invalidity (this claim
25 having been adjudicated in defendants’ favor, thereby rendering moot any other ground of invalidity
26 (not yet adjudicated) (See, cases cited in Acacia’s portion at 11:3-12 and fn. 17)), (2) the Court has
27 no Article III jurisdiction over defendants’ infringement claims, as defendants previously admitted
28 (See, Response to Satellite Statement, at 4:17-5:6, D.I., 269, quoted at 12:5-12; and cases cited in
Acacia’s portion at 13, fn. 20), and, (3) whether the Court has Article III jurisdiction over
defendants’ unenforceability counterclaim is irrelevant, because no defendant contends that the
Court should adjudicate that claim in this phase of the case, so defendants would presumably agree
that this claim should be dismissed without prejudice (it would have to be for there to be a final
judgment for an appeal even if the Court followed the defendants’ proposal and ruled on their
motions for summary judgment).

1 Acacia’s stipulation that all of the asserted claims are invalid, by itself, moots any alternative
2 ground of invalidity.¹⁶ Many courts have held that, once a patent claim is invalid on any ground,
3 any motion pertaining to any alternative ground of invalidity should be declared moot. *See*,
4 *Invitrogen*, 424 F.3d at 1384 (“Finally, Stratagene asks this court to consider its affirmative defenses
5 of enablement, anticipation, and obviousness, as alternate grounds for invalidity. Final judgment by
6 the district court included an order that invalidated the ‘797 patent based on public use under §
7 102(b), and on no other ground. The district court declared moot the other invalidity claims and
8 made no final judgment on them. Therefore, under 28 U.S.C. § 1295(a)(1) (final judgment rule),
9 this court declines to assert jurisdiction to consider an appeal on these issues.”); *Maytag Corp. v.*
10 *Electrolux Home Products, Inc.*, 448 F. Supp. 2d 1034, 1084 (N.D. Ia. 2006) (“[A] determination
11 that patents-in-suit are invalid on at least one ground does moot other invalidity and infringement
12 issues.”).¹⁷ ¹⁸ ¹⁹

13
14 ¹⁶ The fact that the invalidity of Acacia’s asserted claims is, at the present time, evidenced in a
15 stipulation by Acacia, rather than in a judgment by the Court, should be irrelevant. By stipulating to
16 the invalidity of all claims, Acacia is precluded from asserting these claims against any defendant
(or any other third party for that matter), unless and until the Court of Appeals reverses this Court’s
claim construction rulings.

17 ¹⁷ *See also, Crown Packaging Technology, Inc. v. Rexam Beverage Can Co.*, 531 F. Supp. 2d 629
18 (D. Del. 2008) (“In light of the court’s determination, below, that Rexam is entitled to summary
19 judgment of the remaining claim at issue, claim 14 of the ‘826 patent, the court need not address the
20 parties arguments concerning Rexam’s alternative invalidity theories. Those theories are, therefore,
21 denied as moot.”); *International Automated Systems, Inc. v. Digital Persona, Inc.*, 2008 U.S. Dist.
22 LEXIS 445, *79 (D. Utah 2008) (“The Court has now construed all the disputed claims in the ‘474
23 Patent and has ruled on all pending motions. The Court finds that Defendants’ Motion for Summary
Judgment of Invalidity Under the Definiteness Requirement of 35 U.S.C. § 112 is moot, and
24 Defendants’ Motion for Summary Judgment of Invalidity Under the Written Description,
25 Enablement, and ‘Regards as Invention’ Requirements of 35 U.S.C. § 112 is granted.”); *Liebel-
26 Flarsheim Co. v. Mallinckrodt, Inc.*, 481 F.3d 1371, 1383 (Fed. Cir. 2007) (“Because we affirm the
27 district court’s conclusion that the asserted claims of the patents at issue are invalid, we need not
28 reach Medrad’s cross-appealed issues concerning infringement and inventorship, the latter actually
being an alternative ground for a holding of invalidity, not a proper basis for a cross-appeal.”)

24 ¹⁸ Defendants also cite *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 996-99 (Fed. Cir. 2008) and
25 *Liebel-Flarshiem Co. v. Medrad, Inc.*, 481 F.3d 1371, 1377 (Fed. Cir. 2007) for the proposition that
26 courts have ruled on multiple alternate counterclaims of invalidity. In both *Sitrick*, and *Liebel-
27 Flarshiem*, unlike the present case, the court was not considering a motion on alternative grounds of
28 invalidity after the claims had already been adjudicated to be invalid. Many other courts, as cited
herein in this Section, have held that a subsequent motion on alternative grounds of infringement is
mooted by a prior finding of invalidity.

1 For the same reasons, all issues of infringement are rendered moot when a patent claim is
2 determined to be invalid, as the Internet and Cable defendants recently successfully argued to the
3 Court. These defendants should not be heard to complain that their proposed motions for summary
4 judgment on alternative invalidity grounds are similarly moot:

5 It is axiomatic that a claim that has been found (or held to be) invalid can not be
6 infringed. *Richdel, Inc., v. Sunspool Corp.*, 714 F.2d 1573, 1580 (Fed. Cir.
7 1983) (“The claim being invalid, there is nothing to be infringed.”)
8 ***Consequently, any determination that a claim is invalid precludes a finding of***
9 ***infringement, thereby rendering moot any issues of infringement.*** *See, e.g.,*
10 *Princeton Biochems., Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1339-40
11 (Fed. Cir. 2005) (“Because [the asserted] claim [] is invalid for obviousness,
12 this court need not reach the issues of prior invention and infringement.”);
13 *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1322 (Fed. Cir. 2005)
14 (“Because we have sustained the judgment that [the] asserted claims are invalid,
15 th[e] [infringement] issue is moot.”); *Lough v. Brunswick Corp.*, 86 F.3d 1113,
16 1123 (Fed. Cir. 1996) (“No further public interest is served by our resolving an
17 infringement question after a determination that the patent is invalid.”).

18 (Response to Satellite Statement in Joint Case Management Statement, at 4:17-5:6, D.I. 269;

19 ¹⁹ In their portion of this stipulation, defendants mischaracterize the holding in *Maytag*. Defendants
20 contend that in *Maytag*, the “court ruled that all the asserted claims were invalid for lack of written
21 description and then still ruled that *some of the those claims were also not enabled.*” (Jt. Stip., at
22 22:7-8). This was not the case at all. In *Maytag*, at the summary judgment hearing, the court asked
23 the parties to focus only on their written description and enablement contentions, and then found (at
24 the same time) that the patents were invalid on both grounds. *Maytag*, 448 F. Supp. 2d at 1083-84.
25 Having found invalidity on these two grounds, the court went on to hold that any other ground of
26 invalidity (which had been raised in already-pending motions for summary judgment, which the
27 court said were likely precluded by genuine issues of material fact) is mooted by this finding. *Id.*, at
28 1084.

29 Defendants make the same assertion with respect to *International Automated Systems*, 2008 U.S.
30 Dist LEXIS 445 (cited in footnote 29 on page 22, *supra*). In that case, the court had before it two
31 invalidity summary judgment motions, one for indefiniteness and one for “written description,
32 enablement, and ‘Regard as Invention.’” The court granted the second motion for invalidity, but
33 denied the first motion, as being mooted by the ruling on the second motion.

34 Interestingly, in both cases, no further work was necessary by any of the parties to permit the Court
35 to adjudicate the alternative invalidity issues, as those motions had already been fully briefed, yet
36 the court in both cases refused to even rule on the motions, on the ground that they were moot.
37 Arguments of efficiency could have been made for the court to rule on those motions, so that the
38 court’s rulings on those motions could also be appealed together with its other ruling, but they were
39 not.

1 emphasis added).²⁰

2 Defendants' contention that a district court does not automatically lose jurisdiction over one
3 counterclaim simply because it rules on another, citing *Fort James Corp. v. Solo Cup Co.*, 412 F.3d
4 1340, 1348-49 (Fed. Cir. 2005), is wrong. The *Fort James* case is readily distinguishable. In *Fort*
5 *James* the Court held that the disposition of infringement does not deprive the court of jurisdiction
6 over validity because of public policy considerations applicable to patent validity. 412 F.3d at 1348,
7 citing, *Cardinal Chem. Co. v. Morton Int'l, Inc.*, 508 U.S. 83, 95 (1993). The *Fort James* case did
8 not hold and does not support the conclusion that a determination of invalidity does not deprive the
9 trial court of jurisdiction over other potential invalidity arguments. Here, unlike *Fort James*, the
10 asserted patent claims would be invalid per Acacia's stipulation.

11 Defendants reliance *Computer Docking Station Corp. v. Dell, Inc.*, 2006 U.S. Dist. LEXIS
12 74421 (W.D. Wis. 2006) is similarly misplaced. In *Computer Docking*, unlike the present case, the
13 court's construction caused an issue as to infringement (not invalidity), specifically, which of
14 defendants' accused computers do not infringe under the court's construction. It was clear that some
15 of the accused computers did not infringe under the court's construction, but unclear whether all of
16 defendants' accused computers did not infringe. As the parties had not yet conducted discovery on
17 the defendants' accused computers, the parties could not agree on the scope of the final judgment
18 (i.e, which accused computers to include). Because the parties agreed that at least some of the
19 computers did not infringe (thereby meaning that there was an appealable issue on this particular
20

21
22 ²⁰ See also, *Z Trim Holdings*, 2008 U.S. Dist. LEXIS 6086, *19 (“Next, aside from its motion for
23 summary judgment for noninfringement, defendant has filed a separate motion for summary
24 judgment on the issue of invalidity. Because defendant’s motion for summary judgment will be
25 granted on the basis of noninfringement, defendant’s motion for summary judgment of invalidity
26 will be denied as moot.”); *Chamberlain Group, Inc. v. Interlogix, Inc.*, 2002 U.S. Dist. LEXIS
27 14113, *12-13 (N.D. Ill. 2002) (“Interlogix also moves for summary judgment on the invalidity of
the ‘364 patent. This motion is rendered moot based on the court’s determination of non-
infringement.”); *Aspex Eyewear*, 2003 U.S. Dist. LEXIS 26356, at * 6 (“Defendant’s motion for
summary judgment of invalidity (filed October 20, 2003) follows on the heels of the court’s finding
of noninfringement of the ‘545 patent (issued August 3, 2003). The court’s grant of summary
judgment of noninfringement made moot the current motion for summary judgment of invalidity.
Nystrom, 339 F.3d at 1351.”)

1 counterclaim), the court decided to resolve the parties’ dispute over the scope of the judgment by
2 deciding which, if any, of defendants’ accused computers did not infringe before entering the final
3 judgment.²¹ In the present case, there is no infringement issue; the issues of invalidity to be
4 appealed are clear and are stipulated to by Acacia on all asserted claims and any other invalidity
5 ground is disputed.

6 It should be noted that, in *Computer Docking*, the Court did not hold that it would also have
7 to decide all of the invalidity and unenforceability issues raised by defendants’ counterclaims so that
8 the litigation would not result in another appeal on those issues. *Id.* (e.g., “In the first instance
9 [reversal of both claim constructions], the chances are high that the court of appeals will see the case
10 again, but this is true whenever it reverses the trial court.”). *Computer Docking* also did not address
11 the issue presented here; namely, whether the Court retained jurisdiction or would otherwise decide
12 alternative invalidity challenges where the patent was already determined to be invalid.

13 **C. There Is No Doubt That There Will Be Issues of Material Fact Precluding**
14 **Summary Judgment On Defendants’ Proposed Enablement and Written**
15 **Description Motions**

16 Defendants contend that their motions for summary judgment “will not involve any factual
17 disputes” (Jt. Stip., at 26:18-19) thereby implying that these motions will be simple for the Court to
18 grant in defendants’ favor and implying that Acacia is acting improperly by even opposing these
19 motions. Acacia has every right to oppose defendants’ motions, not only because it will need to
20 develop a record for appeal on all of the disputed issues, but also because Acacia believes that, when
21 the Court sees the evidence, it will determine there are material fact disputes and will not grant
22 summary judgment.²² Indeed, the Court specifically instructed the parties at the outset of the Case

23 ²¹ Interestingly, almost one and a half years later, the very same judge (Judge Barbara Crabb) ruled
24 that a motion for summary judgment of invalidity would be denied as moot and counterclaims of
25 invalidity and unenforceability would be dismissed as moot where the court had granted motion for
summary judgment of non-infringement. *See, Z Trim Holdings*, 2008 U.S. Dist. LEXIS 6086, *19-
20.

26 ²² In their portion of this Stipulation, defendants address only two of their many proposed motions.
27 The first is their proposed motion “limited to showing that claim 4 of the ‘720 patent, which uses the
28 phrase ‘responsive to’ rather than ‘in response to,’ is also invalid for the same reasons as Claims 8
and 14” (written description and enablement). (Jt. Stip., at 26:18-27:3). Acacia has already

1 Management Conference that it did not want the parties to stipulate to any motions unless the
2 following standards were met:

3 But I don't want you to do it [stipulate] unless you believe that there is a
4 strong possibility that, that there would be a basis for the Court holding
5 undisputed facts that a claim is either valid or invalid. . . . The standards are
6 high and therefore, it has to meet that high standard. And more often than not
7 I think of that issue as one that requires evidence, expert opinion evidence.
8 And it is very difficult, unless the parties agree on what that expert opinion
9 evidence is, to see a circumstance where the Court would, would take that
10 away from the jury and make a finding.”

11 (March 7, 2008 Transcript, at 7:1-17; Exhibit 1)

12 The issues of enablement and written description raised by defendants are fact-intensive and,
13 if defendants' bring summary judgment motion on these issues, the Court will be required to
14 consider numerous factual matters. For instance, enablement requires a determination by the Court
15 as to whether “one of ordinary skill in the art could make and use the claimed invention without
16 undue experimentation.” *Warner-Lambert Co. v. Teva Pharmaceuticals USA, Inc.*, 418 F.3d 1326,

17 stipulated that claim 4 of the '720 patent is invalid on the grounds that that the Court stated that the
18 phrase “means, responsive to the compressed, digitized data, for transmitting” lacks sufficient
19 structure in the specification (Exhibit 5). Acacia believed that this stipulation had resolved the
20 written description and enablement issues and therefore no stipulation on these additional grounds of
21 invalidity was necessary. However, in order to eliminate one issue from this stipulation, Acacia
22 shall not oppose defendants' motion that claim 4 of the '720 patent is also invalid on written
23 description and enablement grounds. Acacia notes that defendants admit that Acacia agreed that
24 claim 8 of the '720 patent is invalid for lack of written description and enablement, however, the
25 Satellite Defendants' April 11 letter states that they still intend to bring a motion on this issue. (See,
26 Exhibit 6, at 2, motion no. 3). The Satellite Defendants need to remove that motion from their list of
27 proposed motions.

28 The second motion relates to the phrase “to at a plurality of subscriber receiving stations” of claim
17 of the '863 patent. (Jt. Stip., at 27:4-10). The parties addressed this issue during the claim
construction phase of this case (with defendants contending then, as they do now, that this phrase is
indefinite; Acacia opposed defendants' contentions of indefiniteness), but the Court did not construe
this phrase (or hold it to be indefinite) in any of its claim construction orders. In its Fourth Claim
Construction Order (dated March 2, 2007), the Court stated that there were words and phrases
submitted for construction which were not addressed in any Order and the Court invited any party to
submit a request for construction for such term. (4th CCO, at 28:13-16; D.I. 220). No defendant
made any such request, and defendants have stated that “[o]n this record, all parties agree: that the
Court's claim construction duties are complete.” (D.I. 269, Response to Satellite Statement in Joint
Case Management Statement.) Defendants had the opportunity to raise this issue earlier, but they
did not, and therefore they themselves have demonstrated that there is no urgency for the Court to
decide this issue.

1 1337 (Fed. Cir. 2005). Whether undue experimentation is needed is determined by examining a
2 number of factors (known as the “Wands” factors):

3 Whether undue experimentation is needed is not a single, simple factual
4 determination, but rather is a conclusion reached by weighing many factual
5 considerations.’ *Wands*, 858 F.2d at 737. Some of these considerations,
6 commonly referred to as “the Wands factors,” include “(1) the quantity of
7 experimentation necessary, (2) the amount of direction or guidance presented,
8 (3) the presence or absence of working examples, (4) the nature of the
9 invention, (5) the state of the prior art, (6) the relative skill of those in the art,
10 (7) the predictability or unpredictability of the art, and (8) the breadth of the
11 claims.” *Id.*; see also *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1213
12 (Fed. Cir. 1991) (stating that the Wands factors “are illustrative, not
13 mandatory” and that what is relevant to an enablement determination depends
14 upon the facts of the particular case).

15 *Warner-Lambert*, 418 F.3d at 1337.

16 In view these many factors, it was not surprising that the court in *Warner-Lambert* reversed
17 the district court’s grant of summary judgment of non-enablement. *Id.*

18 Similarly, the issue of compliance with the written description requirement, which requires
19 the court to answer the question of “whether the disclosure of the application relied upon
20 ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed
21 subject matter,’” is also fact-based and will be expert intensive. *Vas-Cath, Inc. v. Mahurkar*, 935
22 F.2d 1555, 1563 (Fed. Cir. 1991) (“Our cases also provide that compliance with the ‘written
23 description’ requirement of § 112 is a question of fact, to be reviewed under the clearly erroneous
24 standard.”) Again, summary judgment is inappropriate where resolution of what a patent conveyed
25 to those skilled in the art requires examination of experts, demonstrations and exhibits. *Vas-Cath*,
26 935 F.2d at 1566-67 (reversing district court’s grant of summary judgment on written description
27 where expert testimony on behalf of the patentee established genuine issue of material fact as to
28 what patent disclosed to persons of ordinary skill in the art), citing, *Hesston Corp. v. Sloop*, 1988
U.S. Dist. LEXIS 1573, *13 (D. KS. 1988) (“summary judgment on § 112 ‘written description’
issue inappropriate where resolution of what parent disclosure conveyed to those skilled in the art
may require examination of experts, demonstrations and exhibits”).

1 **D. Acacia’s Conclusion**

2 The Court should adopt Acacia’s proposal that the Court enter judgment of invalidity of all
3 claims asserted by Acacia for the reasons stated in Acacia’s stipulation and dismiss without
4 prejudice defendants’ counterclaims. This procedure for obtaining a final appealable judgment has
5 been expressly approved by the Federal Circuit and therefore it will not result in the impermissible
6 “piecemeal” litigation that defendants fear. It also will not cause the Court to exceed its subject
7 matter jurisdiction by considering the thirty-four additional Section 112 motions on alternative
8 invalidity grounds proposed by defendants, which motions are mooted by Acacia’s stipulation of
9 invalidity of all of its asserted claims.

10 **III. DEFENDANTS’ POSITION**

11 Defendants propose that, consistent with the parties’ agreement and the Court’s order to
12 effectively and efficiently handle the next phase of this case, the Court consider motions and
13 briefing regarding § 112 invalidity of the asserted claims. Acacia, on the other hand, now seeks to
14 vitiate the parties’ agreement and wants to move for summary judgment against itself, arguing that
15 the Court lacks jurisdiction to hear the Defendants’ motions, that such motions are inefficient, and
16 that the motions might raise disputed issues of material fact. Acacia is wrong on all counts. This
17 Court has subject matter jurisdiction to hear the Defendants’ invalidity motions. Further, Acacia’s
18 proposal to appeal immediately to the Federal Circuit on a small, limited number of issues is
19 inefficient, unnecessarily delays resolution of this case, and wastes judicial resources. The
20 Defendants’ motions will not create factual issues and will promote judicial efficiency by packaging
21 a *substantial collection* of the Court’s disputed claim constructions, along with the § 112 invalidity
22 grounds on which the asserted claims are invalid, for appeal to the Federal Circuit. These arguments
23 have the further benefit of collectively affecting each of the asserted claims. Accordingly, the
24 Defendants request that the Court direct the parties to proceed with the § 112 invalidity briefing
25 schedule already in effect pursuant to the Court’s March 12 Scheduling Order.

1 **IV. BACKGROUND**

2 On February 13, 2008, the Court issued its sixth claim construction order. (D.I. 266.) In that
3 order, the Court directed the parties to file a joint statement on February 29 addressing how the case
4 should next proceed. All parties agreed in that joint statement that the next stage of the case should
5 include § 112 motions to address invalidity positions created by the Court’s claim construction
6 orders. (D.I. 267.) The parties also agreed on a process and schedule that contemplated that there
7 would be motions to which Acacia would stipulate but that there would also be motions that would
8 be decided by the Court. Specifically, Acacia stated that “in the interest of judicial economy” the
9 parties should address the Defendants’ motions “so that the invalidity of the asserted claims on these
10 grounds *can be stipulated to or adjudicated.*” (D.I. 267 at 2:12-17 (emphasis added).)²³

11 Notably, in a supplemental paper filed on March 5, 2008, Acacia reiterated that position,
12 stating that in addition to the invalidity grounds on which the parties agreed, “[i]f the Court rules in
13 favor of defendants on any of their other 112 motions for written description or enablement that they
14 contemplate bringing under our proposed procedure, then the Court can include those rulings in its
15 Final Judgment.” (D.I. 270 at 3:5-8.) In other words, Acacia argued that a final judgment entered in
16 this case would include the Court’s rulings on the Defendants’ written description and enablement
17 motions — in addition to any stipulated grounds of invalidity. As Acacia made clear at the March 7,
18 2008, hearing, simply stipulating to invalidity was “the approach that Plaintiffs preferred” but that
19 “the Defendants then said . . . let’s get as many issues up that we can get up . . . that bear on not only
20 indefiniteness but enablement issues, [and] written description issues *Now, we’re amenable to*
21 *that and that’s included in this proposal.*” (Ex. 1 at 12-13 (emphasis added).)

22 The Court agreed that the proposed § 112 motions would more efficiently allow the parties
23 to address remaining issues in the case:

24
25
26 ²³ In addition, the Satellite Defendants argued that non-infringement should be included with the
27 dispositive motions. Acacia and the other Defendants disagreed, and the Court determined that non-
infringement should not be heard in this next phase. All of the Defendants reserve their rights to
bring other summary judgment motions on grounds not addressed in this round, if necessary.

1 I'm persuaded that the joint proposal of what I would call the
2 plaintiffs and the cable defendants and others, the nonsatellite
defendants has a great deal of merit both in terms of judicial economy
and in terms of how the issues in the case would be framed.

3 (Ex. 1 at 55:25-56:6.) Accordingly, the Court adopted the schedule proposed by Acacia and the
4 other Defendants. (D.I. 272.)

5 Pursuant to this schedule, the Defendants provided Acacia with their proposed § 112 motions
6 on March 28. (Exs. 2 & 3, March 28, 2008, Letters to Acacia from D. Benyacar and M. Kreeger.)
7 Acacia responded to these letters on April 4 by claiming *for the first time* that given Acacia's
8 stipulation to the invalidity of the asserted claims on certain narrow, limited grounds, *no* § 112
9 motions were appropriate. (Ex. 4, April 4, 2008, Letter to Defendants from A. Block.) In response,
10 the Defendants provided their lists of proposed motions and requested that Acacia follow the March
11 12 Court-ordered briefing schedule for their § 112 invalidity motions. (Exs. 6 & 7, April 11, 2008,
12 Letters to Acacia from D. Benyacar and M. Kreeger.) Acacia rebuffed Defendants' efforts to reach
13 a compromise, responding on April 14 that it would file a separate statement from the Defendants,
14 disputing the Court's ability to consider any contested § 112 motions and requesting an immediate
15 appeal to the Federal Circuit. (Ex. 8, April 14, 2008, E-mail to Defendants from A. Block.) This
16 Joint Statement followed.²⁴

17 Acacia's entire section of this Joint Statement attempts to repudiate its agreement and
18 intentionally confuses "the approach that Plaintiff preferred" with what Acacia actually agreed to,
19 namely that Defendants' motions to which Acacia refused to stipulate would be addressed by the
20 Court. A different quote from Acacia at the March 7 hearing than the one selectively put forth by
21 Acacia (in Section II.A) makes clear this distinction:

22
23
24 ²⁴ This is not the first time that Acacia has tried to obtain an entry of judgment against itself. Acacia
25 previously tried to obtain an entry of judgment in connection with the '702 patent (D.I. 120). These
26 efforts were opposed by the Defendants (D.I. 125) and rejected by the Court at a hearing on
27 February 24, 2006. Subsequent efforts were made by Acacia in discussions with Defendants. Yet
despite these previous efforts, as noted above, Acacia abandoned such positions and explicitly
agreed to a process whereby the Court would have an opportunity to rule on motions to which
Acacia refused to stipulate.

1 [T]he legal effect of what you've done in those six claim construction
2 matters is to render indefinite as a matter of law, and, therefore,
invalid every claim we're currently asserting against every defendant
in this case. I believe that's correct, okay.

3 If I were tomorrow to file a motion that says a motion to dismiss, to
4 enter judgment of invalidity on these bases and dismiss everything
else without prejudice because, because there is no longer a case or
5 controversy, I believe that would be a legally correct motion to bring
because we can all agree that you cannot infringe a claim that is
6 invalid.

7 If I'm correct that the legal effect of your rulings to date have been
that all of these are invalid because they're indefinite, then this case
8 would be over and, and we wouldn't have a basis, you wouldn't have
a constitutional basis to consider further motions for summary
9 judgment.

10 *What we have done is, I haven't brought that motion because I'm*
11 *content rather than to fight that motion practice, if there is some*
12 *additional invalidity section 112 arguments that are -- that can be*
further developed based upon your rulings, because this is an MDL
proceeding and it made sense to do that.

13 (Ex. 1 at 51-52 (emphasis added).)

14 For all the following reasons, the Court should hold Acacia to its agreement and proceed
15 with the § 112 briefing schedule.

16 **V. THIS COURT RETAINS JURISDICTION TO RULE ON THE DEFENDANTS' § 112**
17 **INVALIDITY MOTIONS.**

18 Acacia argues that as a result of its stipulations, all asserted claims are invalid and that,
19 therefore, the Court no longer has jurisdiction to decide other issues in this case, including any
20 invalidity grounds beyond the minimum number strategically selected by Acacia. Acacia asserts
21 that any rulings by the Court on these issues would amount to an impermissible "advisory opinion."
22 Acacia is wrong.

23 Numerous Defendants have pleaded counterclaims for declaratory judgment that the Acacia
24 patents are invalid, not infringed, and unenforceable.²⁵ These claims remain pending. Moreover,

25 _____
26 ²⁵ Acacia states that not all of the Defendants have asserted unenforceability counterclaims. Acacia
27 takes nothing by this statement. Many Defendants have asserted unenforceability due to inequitable
conduct and the time has not yet passed by which the remainder can add such a defense.

1 some of the Internet Defendants have pending claims against Acacia for unfair competition. Thus,
2 regardless of the outcome of the § 112 motions, the Court retains independent jurisdiction to decide
3 the Defendants’ counterclaims, including their claims for attorney fees as the prevailing parties in an
4 “exceptional case” under 35 U.S.C. § 285, including deciding whether the patents are unenforceable
5 for inequitable conduct. *See Monsanto Co. v. Bayer Bioscience N.V.*, 514 F.3d 1229, 1242-43 (Fed.
6 Cir. 2008).²⁶ This is true even if the patent holder has covenanted not to sue the alleged infringers.²⁷
7 *Highway Equip. Co. v. FECO, Ltd.*, 469 F.3d 1027, 1033 n.1 (Fed. Cir. 2006).

8 In addition, a district court does not automatically lose jurisdiction over one counterclaim
9 simply because it rules on another. *See Fort James Corp. v. Solo Cup Co.*, 412 F.3d 1340, 1348-49
10 (Fed. Cir. 2005). Indeed, there are innumerable patent cases where a district court exercises its
11 discretion to rule on multiple, alternative counterclaims of invalidity. *See, e.g., Sitrick v.*
12 *Dreamworks, LLC*, 516 F.3d 993, 996-99 (Fed. Cir. 2008) (reviewing a district court’s grant of
13 summary judgment of invalidity under § 112, paragraphs 1 and 2, each of which independently
14 disposed of all asserted claims); *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1377 (Fed.
15 Cir. 2007) (reviewing a lower court’s grant of summary judgment of invalidity for one family of
16 patents on alternative grounds of §§ 102 and 112). A patent holder *may* render counterclaims for
17 declaratory relief moot where the patent holder covenants not to sue the alleged infringer. *See Super*
18 *Sack Mfg. Corp. v. Chase Packaging Corp.*, 57 F.3d 1054, 1058-59 (Fed. Cir. 1995); *see also*
19 *Caraco Pharm. Labs., Ltd. v. Forest Labs., Ltd.*, No. 2007-1404, 2008 U.S. App. LEXIS 6838, at
20 *48-49 (Fed. Cir. April 1, 2008) (finding proffered covenant insufficient). Here, however, Acacia

21
22 ²⁶ In trying to distinguish *Monsanto*, Acacia appears to agree that the Court retains jurisdiction over
23 the Defendants’ claims of inequitable conduct and request for attorney fees under § 285. Acacia’s
24 only quibble is that judgment has not yet been entered and that a prevailing party has not been
25 determined. Plainly, if all of the Yurt claims are invalid, as Acacia freely admits, then the
26 Defendants would be the prevailing parties and entitled to seek attorney fees under § 285 and their
27 inequitable conduct allegations.

28 ²⁷ Notably, Acacia has not provided the Internet Defendants with a covenant not to sue as to Claims
1-18 of the ’992 patent — claims the Court and the parties expended considerable effort to construe
and on which the Internet Defendants moved for summary judgment prior to this case being
transferred by the multi-district litigation panel.

1 has neither covenanted not to sue the Defendants nor dismissed its claims with prejudice. The
2 opposite is true — Acacia explicitly seeks to reserve all its rights to pursue infringement claims
3 should it prevail on appeal.²⁸

4 Moreover, many of the cases on which Acacia relies actually support Defendants’ position,
5 as the courts did the opposite of what Acacia proposes. For example, Acacia cites *Maytag Corp. v.*
6 *Electrolux Home Products, Inc.*, 448 F. Supp. 2d 1034, 1084 (N.D. Iowa 2006), for the proposition
7 that courts have held that “once a patent claim is invalid *on any ground, any motion pertaining to*
8 *any alternative ground* of invalidity should be declared moot.” (Acacia Stmt. at 11:2-3 (emphasis
9 added).) But the *Maytag* court ruled that all the asserted claims were invalid for lack of written
10 description but still ruled that *some of those same claims were also not enabled.* *Id.* at 1084.
11 Similarly, in *International Automated Systems, Inc. v. Digital Persona, Inc.*, No. 2:06-CV-72, 2008
12 U.S. Dist. LEXIS 445 (D. Utah Jan. 2, 2008), which Acacia cites for the same proposition, the court
13 found that the asserted patent was invalid on *at least two independent grounds.*²⁹ *Id.* at *71-74.
14 Under Acacia’s reasoning, neither of these courts would have had the authority to make alternative
15 findings of invalidity.

16 Likewise, the Federal Circuit cases Acacia cites do not support its assertion that district
17 courts are prohibited from ruling on alternative invalidity grounds. *See Liebel-Flarsheim*, 481 F.3d
18 at 1383 (determining that it “need not reach” alternative ground of invalidity in light of affirmance
19 of a single ground); *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1384 (Fed. Cir. 2005)
20 (declining to rule on additional invalidity grounds where no final ruling on those grounds had been
21 made by district court); *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 243 F.3d 1316, 1320 (Fed. Cir.
22 2001) (finding it “unnecessary” to address additional invalidity argument in light of affirmance of
23 invalidity on the ground of prior invention). Further, what is clear from these cases is that since,

24
25 ²⁸ While Acacia has in the past dropped claims (*see, e.g.*, D.I. 265), there are still 65 claims pending
26 over the five Yurt patents. Acacia has refused to narrow the case further.

27 ²⁹ The court found that the claims were independently invalid on written description *and* enablement
28 grounds. *Int’l Automated Sys.*, 2008 U.S. Dist. LEXIS 445, at *72-73.

1 except in rare circumstances, the Federal Circuit serves as the ultimate arbiter on patent matters,
2 when it has already found no liability against the alleged infringer on one ground it can exercise its
3 discretion not to rule on additional grounds since its ruling is “statistically unlikely” to be subject to
4 review, much less overturned on any appeal to the Supreme Court. *See Lough v. Brunswick Corp.*,
5 86 F.3d 1113, 1123 (Fed. Cir. 1996). This is quite different from a district court decision, which is
6 always reviewed on appeal by the Federal Circuit.

7 *Nystrom*, which Acacia cites extensively, reiterated the Federal Circuit’s policy against
8 piecemeal appeals and specifically stated that it was within the trial court’s discretion to rule on the
9 remaining invalidity counterclaims, even after the lower court held that all asserted claims were not
10 infringed and additional claims were invalid. *Nystrom v. TREX Co.*, 339 F.3d 1347, 1350-51 (Fed.
11 Cir. 2003).³⁰

12 Acacia’s statements confuse and conflate mootness in the Article III sense (*i.e.*, jurisdictional
13 mootness) and prudential mootness. Jurisdictional mootness deprives a court of jurisdiction and
14 requires a court to dismiss the action. *Powell v. McCormack*, 395 U.S. 486, 496 n.7 (1969)
15 (explaining that court lacks jurisdiction to consider the merits of a moot case). Prudential mootness,
16 on the other hand, is where a court, having already decided one dispositive issue, *chooses* not to
17 address another equally dispositive issue. This latter type of mootness results from a court’s
18 “discretion in matters of remedy and judicial administration,” and *not* jurisdictional considerations.
19 *See Chamber of Commerce v. United States Dep’t of Energy*, 627 F.2d 289, 291 (D.C. Cir. 1980);
20 *see also Ali v. Cangemi*, 419 F.3d 722, 723-24 (8th Cir. 2005) (explaining the difference between
21 prudential mootness and jurisdictional mootness); *Fischer & Porter Co. v. U.S. Int’l Trade Comm’n*,
22 831 F.2d 1574,1581-82 (Fed. Cir. 1987) (patent issues mooted by affirmance of no injury in
23 proceeding under 19 U.S.C. § 1337). At best, Acacia is requesting the Court to exercise its
24

25 ³⁰ Like *Nystrom*, district court cases that Acacia cites also emphasize that trial courts have discretion
26 to rule on alternative counterclaims. *See, e.g., Aspex Eyewear Inc. v. Miracle Optics, Inc.*, No. CV
27 01-10396, 2003 U.S. Dist. LEXIS 26356, at *6 (C.D. Cal. Nov. 25, 2003); *Digital Privacy, Inc. v.*
RSA Sec., Inc., 199 F. Supp. 2d 457, 458 (E.D. Va. 2002).

1 discretion in the interest of judicial economy. As discussed herein, judicial economy is better served
2 by the Court’s consideration of alternative grounds of invalidity — a point to which Acacia readily
3 agreed in the Case Management Statement and at the March 7 hearing.

4 In short, this Court has jurisdiction to hear the Defendants’ motions for invalidity.

5 **VI. ACACIA’S PROPOSAL IS INEFFICIENT, PROMOTES DELAY, AND WASTES**
6 **JUDICIAL RESOURCES.**

7 Acacia proposes an immediate appeal to the Federal Circuit on invalidity flowing from only
8 a small, limited number of the Court’s claim constructions, despite the fact that Acacia clearly
9 disputes many of the remaining constructions, which also lead to findings of invalidity. Acacia’s
10 piecemeal approach is inefficient because it increases the potential for further proceedings in this
11 Court and the need for serial appeals.

12 *Computer Docking Station Corp. v. Dell Inc.*, No. 06-C-0032-C, 2006 U.S. Dist. LEXIS
13 74421 (W.D. Wis. Oct. 11, 2006), illustrates the inefficiencies of Acacia’s proposal. In that case,
14 the plaintiff conceded that according to one of the court’s claim constructions, *all* the asserted claims
15 in suit were not infringed. *Id.* at *1-2. Based on that claim construction, the parties stipulated to
16 non-infringement of the asserted claims. They could not, however, agree regarding whether the case
17 should proceed immediately to the Federal Circuit or to non-infringement motions based on a
18 second of the court’s claim constructions. Like Acacia, the plaintiff in that case argued that given
19 the parties’ stipulation, all remaining issues were moot because the plaintiff had no viable
20 infringement case and that the district court lacked jurisdiction to hear additional motions. *Id.* The
21 defendants opposed entry of judgment on the first claim construction because they wanted to present
22 non-infringement motions on the second claim construction. *Id.* at *2-3.

23 The court in that case rejected the same argument Acacia makes here. It agreed with the
24 defendants, finding that “it would be premature to enter final judgment before a determination” on
25 infringement under the second claim construction was made. *Id.* at *3. Evaluating the parties’
26 competing allegations of efficiency and delay, it found that “[t]he primary consideration is whether
27 the court of appeals would have to review the case twice.” *Id.* According to the court,

1 If the case were to be appealed now, the court of appeals would have
2 three options. It could reverse both of the critical claim constructions
3 or it could reverse only one of them. In the first instance, the chances
4 are high that the court of appeals will see the case again, but this is
5 true whenever it reverses the trial court. If the appellate court chose a
6 second option and reversed only the [second] construction, the case
7 would be over because of plaintiff's concession that none of
8 defendants' devices include the [first] limitation. The problem comes
9 if the appellate court reverses only the [first] construction, making
10 additional litigation necessary to determine which devices infringe this
11 limitation of the '645 patent and whether defendants are entitled to
12 judgment on any of their counterclaims. If the litigation resulted in
13 another appeal, the appellate judges would be required to familiarize
14 themselves all over again with the meaning of [the second
15 construction] before determining the application of the term to the
16 accused devices. *This is the kind of unnecessary work that the final
17 judgment rule is intended to avoid.*

18 *Id.* at * 3-4 (emphasis added); *see also Surgical Laser Techs. Inc., v. Surgical Laser Prods., Inc.*, 27
19 U.S.P.Q.2d (BNA) 1614, No. 90-7965, 1993 U.S. Dist. LEXIS 1062, at *11 (E.D. Pa 1993)
20 (“Granting Rule 54(b) certification creates the possibility that the Court of Appeals for the Federal
21 Circuit would have to acquaint itself with [plaintiff's] two-piece laser delivery system a second
22 time.”).

23 The same reasoning applies here. Were Acacia to prevail on any of the grounds it wants to
24 appeal now, the parties would be back before this Court litigating some or all of the same motions
25 that the Defendants are prepared to bring now. Those proceedings would inevitably lead to yet
26 another appeal, at which point the Federal Circuit would also be required to familiarize itself all over
27 again with the Yurt patents and the Court's claim construction orders.

28 Given the effort the Court and the parties have expended over the years, it makes little sense
to send the case to the Federal Circuit to review so few issues, especially when resolving the
Defendants' invalidity motions would not meaningfully delay what has been a lengthy, complex
litigation process. It is far more efficient to resolve the pending disputes according to the Court's
March 12 schedule. The parties can then send to the Federal Circuit a comprehensive package of
issues that more accurately reflects the issues in the case and the orders to date. More specifically,
the Federal Circuit can hear disputes regarding a *substantial number* of the Court's claim
construction decisions, along with the § 112 motions to which those constructions naturally lead

1 (and which collectively affect every asserted claim), rather than a select number of constructions
2 that Acacia wants to appeal now. *See Chaparral Commn'cs Inc. v. Buman Indus., Inc.*, 798 F.2d
3 456, 459 (Fed. Cir. 1986) (finding that “policy against piecemeal appeals” “clearly outweighed”
4 plaintiff’s 54(b) motion to hear ruling on unenforceability of design patent when infringement of
5 utility patent remained pending).

6 **VII. THE DEFENDANTS’ INVALIDITY MOTIONS WILL NOT LEAD TO FACTUAL**
7 **DISPUTES.**

8 Acacia also professes concern over “factual issues” that the Defendants’ motions will
9 allegedly create. This argument is meritless. Acacia itself cites cases that found claims invalid on
10 summary judgment for indefiniteness, lack of written description, and lack of enablement. *See, e.g.,*
11 *Int’l Automated Sys.*, 2008 U.S. Dist. LEXIS 445, at *72-73; *Maytag*, 448 F. Supp. 2d at 1084.³¹

12 Moreover, the Defendants do not propose to bring motions for summary judgment on all of
13 their invalidity contentions and have never implied that Acacia is “acting improperly” in opposing
14 them. Instead, they have chosen targeted invalidity motions that rely primarily on the intrinsic
15 evidence and the Court’s claim constructions to show that there is no support or enabling disclosure
16 for certain claim terms. In accordance with the Court’s scheduling order, the Defendants provided
17 Acacia with a final list of their proposed motions, which are attached as Exhibits 6 and 7.³² These
18 motions are not overly complicated, will require limited briefing, and will not involve any factual
19 disputes.

20 For example, Acacia has already agreed that under the Court’s construction of the term “in
21 response to,” as used in Claim 14 of the ’863 and Claim 8 of the ’720 patents, there is no written
22

23 ³¹ Acacia argues that lack of enablement is particularly inappropriate for summary judgment. Lack
24 of enablement is appropriate for summary judgment and has been granted, including in this district.
25 *See, e.g., Use Techno Corp. v. Kenko USA, Inc.*, 515 F. Supp. 2d 1086 (N.D. Cal. 2007).

26 ³² Exhibit 7 is a letter on behalf of the Cable and Internet Defendants setting forth their contemplated
27 motions. Exhibit 6 is a letter sent on behalf of the Satellite Defendants setting forth their
28 contemplated motions. Both letters were sent on April 11th consistent with the Court’s order. (D.I.
272.)

1 description or enablement of the term in the specification. Thus, one of the Defendants’ proposed
2 motions will be limited to showing that Claim 4 of the ’720 patent, which uses the phrase
3 “responsive to” rather than “in response to,” is also invalid for the same reasons as Claims 8 and 14.
4 The briefing on this issue will be short and will not involve factual disputes because the Court has
5 *already found* that the phrases mean the same thing.³³ (4th CCO at 18.)

6 Similarly, the Defendants plan to file a motion that an error in Claim 17 of the ’863 patent
7 renders that claim, along with its dependent claims, indefinite. The error in Claim 17, which
8 includes the phrase “to at a plurality of subscriber receiving stations,” makes it impossible to
9 determine the claim’s scope — a fact that Acacia’s counsel specifically admitted to this Court at the
10 September 2006 *Markman* hearing on this claim. This issue is one of law, and the Defendants’
11 motion will follow up on briefing already submitted by the Round 3 Defendants as part of the
12 *Markman* briefing schedule.³⁴

13 Of course, should Acacia believe that there is a *material* factual dispute with respect to any
14 particular motion, it can argue that position before the Court. However, it is improper to preclude
15 the Defendants from making a motion simply because Acacia raises the specter of a factual dispute.
16 Acacia’s argument should be rejected.

17 **VIII. IT WILL NOT BE A BURDEN ON THE COURT TO CONSIDER THE**
18 **DEFENDANTS’ MOTIONS.**

19 In an effort to make it look burdensome for the Court to proceed with consideration of
20 Defendants’ motions, Acacia complains that the Defendants initially identified 35 motions that they
21 contemplated bringing in their March 28 letters.³⁵ A simple review of these letters indicates that this
22

23 ³³ Acacia now states in its section of this statement that it will not oppose the invalidity of Claim 4
24 on written description and enablement grounds. Of course, Defendants will not bring a motion on
Claim 4 of the ’720 patent if Acacia agrees not to oppose it and includes it in the stipulation.

25 ³⁴ Acacia argues that the Defendants have waived this issue, which makes little sense. Defendants’
26 indefiniteness motion is exactly the type of motion the Court’s § 112 schedule anticipates.

27 ³⁵ While Acacia is correct that two different letters including two different lists were sent, the letter
sent by Mr. Benyacar included all of the motions identified by Mr. Kreeger.

1 is a red-herring. First, at least 6 of these motions relate to terms where the Court indicated that the
2 claims were “arguable indefinite,” and several others address terms the Court otherwise identified as
3 potentially invalid. As the Court made clear at the March 7 hearing, it wanted to have these issues
4 resolved: “And I found things that are arguably indefinite and so far of what I would also wish to
5 have in the process is an opportunity to have, to have -- to lay those matters to rest.” (Ex. 1 at 12-
6 13.) Second, in its April 4 letter, Acacia stipulated to another five of these motions and
7 acknowledged that for two additional motions “Acacia will not oppose” the motions. (Ex. 4 at 1, 3.)
8 Third, as set forth in Defendants’ April 11 letters, the remaining issues condense down to just a
9 handful of motions.

10 Acacia fails to mention that the initial April 4 lists of proposed motions were for Acacia’s
11 benefit. Defendants went through the time and effort to break down the various independent bases
12 for their motions to give Acacia the benefit of Defendants’ thinking, as well as to make it easier for
13 Acacia to stipulate to a particular ground of invalidity, which Acacia appeared to indicate at the
14 CMC hearing was also its expectation:

15 What we are then going to do is look at that proposal, that list proposal
16 and meet with them and say, you know, we agree with you that based
17 upon what the court has done, that's going to be the result so there's no
18 need to file a motion on this. That that's going to be, based upon this
19 court's ruling, this is invalid for this reason.

18 *And we think there's going to be a large number of issues that are*
19 *listed in that joint statement that are going to be the subject of*
stipulation in that regard.

20 (Ex. 1 at 57:16-58:1.) As demonstrated by Acacia’s actions, Defendants need not have bothered as
21 Acacia did not engage in this process in good faith.

22 **IX. CONCLUSION**

23 In light of the success of the phased approach in this case, Acacia’s agreement to a schedule,
24 this Court’s ability to continue to retain jurisdiction (despite Acacia’s protestations to the contrary),
25 the efficiency in comprehensively addressing claim construction, and the ability of this Court to
26 decide these motions without any additional factual inquiry, the Defendants respectfully request that

27 ///

1 the Court adhere to the adopted schedule and proceed with consideration of the Defendants' § 112
2 motions.

3 Respectfully submitted,

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