

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

|  |   |                                 |
|--|---|---------------------------------|
| LEADER TECHNOLOGIES, INC., a Delaware corporation, | ) |                                 |
|  | ) |                                 |
|  | ) | Civil Action No. 08-862-JJF/LPS |
| Plaintiff-Counterdefendant,                        | ) |                                 |
|  | ) |                                 |
| v.   | ) |                                 |
|  | ) | <b>PUBLIC VERSION</b>           |
| FACEBOOK, INC., a Delaware corporation,            | ) |                                 |
|  | ) |                                 |
| Defendant-Counterclaimant                          | ) |                                 |

**DECLARATION OF JAMES HANNAH IN SUPPORT OF PLAINTIFF  
LEADER TECHNOLOGIES, INC.'S ANSWERING BRIEF IN  
OPPOSITION TO DEFENDANT FACEBOOK INC.'S MOTION TO  
STAY PENDING REEXAMINATION OF U.S. PATENT NO. 7,139,761**

OF COUNSEL:

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*Attorneys for Plaintiff  
Leader Technologies, Inc.*

Dated: November 9, 2009  
Public Version: November 17, 2009

I, James Hannah, hereby declare:

1. I am an attorney with the law firm King & Spalding LLP, counsel of record for Plaintiff Leader Technologies, Inc. ("Leader"). I have personal knowledge of the facts set forth in this declaration and can testify competently to those facts.

2. [REDACTED]

3. [REDACTED]

4. The parties have completed substantial discovery in the case. Leader has served five sets of interrogatories, four sets of requests for production and three sets of requests for admission. Facebook has served six sets of interrogatories, four sets of requests for production and two sets of requests for admissions. There has been a total of 68 interrogatories, 267 requests for production, and 87 requests for admission propounded in the case just between Leader and Facebook.

5. The parties have also done substantial third party discovery, serving a total of 22 subpoenas, issued in 10 different states, involving a total of 279 requests for production. Specifically, Facebook has served 18 subpoenas for documents. These subpoenas were issued in California, Ohio, Maryland, Georgia, Washington, New York, Illinois, Pennsylvania, and Mississippi. Facebook served a total of 226 requests for production in these subpoenas. Leader

has served 4 subpoenas for documents. These subpoenas were issued in California, Ohio and Connecticut. Leader served a total of 53 requests for production in these subpoenas. Leader intends to serve subpoenas for depositions of a number of third parties once the schedule permits Leader to take depositions.

6. [REDACTED]

[REDACTED]

7. Leader has also been working with its other anticipated experts in the case. Leader has had several conference calls with its damages expert, Russell Parr, regarding damages issues involved in this case. Leader has also met with its expert who will be handling validity issues in the case.

8. [REDACTED]

[REDACTED]

9. Attached hereto as Exhibit A is a true and correct copy of Leader's Executive Summary, dated August 12, 2002, bearing bates numbers LTI083639-42.

10. Attached hereto as Exhibit B is a true and correct copy of Leader's White Paper for the Leader2Leader® product, bearing bates numbers LTI015709-15.

11. Attached hereto as Exhibit C is a true and correct copy of Facebook's Fact Sheet, available at <http://www.facebook.com/press/info.php?factsheet>.

12. Attached hereto as Exhibit D is a true and correct copy of a press release entitled "Web 2.0 Summit: a conversation with Mark Zuckerberg", dated November 6, 2008.

13. Attached hereto as Exhibit E is a true and correct copy of a report from the U.S. Patent and Trademark Office regarding *Ex Parte* Reexamination Filing Data dated June 30,

2009.

14. Attached hereto as Exhibit F is a true and correct copy of a document entitled *Overview of USPTO Proceedings For the Reexamination of a U.S. Patent*.

15. Attached hereto as Exhibit G is a true and correct copy of a report from the U.S. Patent and Trademark Office regarding *Inter Partes* Reexamination. Filing date dated June 30, 2009.

16. Attached hereto as Exhibit H is a true and correct copy of a report from the Institute for Progress regarding *Inter Partes* Reexamination.

17. Attached hereto as Exhibit I is a true and correct copy of a document entitled *Reexamination Practice with Concurrent District Court Patent Litigation*.

18. Attached hereto as Exhibit J is a true and correct copy of an excerpt from Practising Law Institute entitled *Stays Pending Reexamination*, dated August 2007.

19. Attached hereto as Exhibit K is a true and correct copy of Facebook's First Supplemental Responses to Leader's Interrogatories Nos. 3, 4, 6, and 10, dated May 15, 2009.

20. Attached hereto as Exhibit L is a true and correct copy of the transcript of the scheduling conference held before Judge Faman on March 31, 2009.

21. Attached hereto as Exhibit M is a true and correct copy of the transcript of the telephone conference held before Magistrate Judge Stark on October 23, 2009.

22. Attached hereto as Exhibit N is a true and correct copy of Facebook's Responses to Leader's Fourth Set of Interrogatories, served on November 3, 2009.

23. A recent survey reported that the District of Delaware has one of the lowest percentages (35%) of granting stay pending reexamination. Attached hereto as Exhibit O is a true and correct copy of the survey, available at <http://www.patentlyo.com/patent/2009/11/the-following-guest-post-is-by-matthew-smith-the-grant-rate-of-motions-to-stay-is-highly-judge-dependent-and-somewhat-less-ob.html?cid=6a00d8341c588553ef0120a64dade2970b>.

24. Attached hereto as Exhibit P is a true and correct copy of Leader's Responses to Facebook's First Set of Interrogatories (Nos. 1-9), dated March 20, 2009.

25. Attached hereto as Exhibit Q is a true and correct copy of Leader's Objections and Responses to Facebook's Request for Admissions (1-20), Set one, dated September 4, 2009.

I declare under penalty of perjury under the laws of the State of California and the United States that the foregoing is true and correct. Executed this 9th day of November 2009, at Redwood Shores, California.

  
\_\_\_\_\_  
James Hannah

**EXHIBIT A**

**THIS EXHIBIT HAS BEEN  
REDACTED IN ITS ENTIRETY**

**EXHIBIT B**



**THIS EXHIBIT HAS BEEN  
REDACTED IN ITS ENTIRETY**

**EXHIBIT C**

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**Facebook Factsheet**

**About Facebook**

Founded in February 2004, Facebook is a social utility that helps people communicate more efficiently with their friends, family and coworkers. The company develops technologies that facilitate the sharing of information through the social graph, the digital mapping of people's real-world social connections. Anyone can sign up for Facebook and interact with the people they know in a trusted environment.

**Product**

Facebook's simplified navigation gives users easy access to core site functions and applications. Profile, Friends, Networks and Inbox – pages core to the user experience on Facebook – have a prominent place at the top of the user's profile page. Facebook applications – Photos, Notes, Groups, Events and Posted items – are displayed on the left side bar, along with any third-party applications a user has added to their account.

**Technology**

Facebook is the second most-trafficked PHP site in the world, and one of the largest MySQL installations anywhere, running thousands of databases. Facebook has built a lightweight but powerful multi-language RPC framework that allows the company to seamlessly and easily tie together subsystems written in any language, running on any platform. The company is the largest user in the world of memcached, an open-source caching system, and has created a custom-built search engine serving millions of queries a day, completely distributed and entirely in-memory, with real-time updates.

**Platform**

Facebook Platform is a development platform that enables companies and engineers to deeply integrate with the Facebook website and gain access to millions of users through the social graph. Facebook is a part of millions of people's lives all around the world providing unparalleled distribution potential for applications and the opportunity to build a business that is highly relevant to people's lives. More information can be found at <<http://developers.facebook.com>>.

**Privacy**

Facebook has led the industry in giving people tools to control the information they share and with whom they choose to share it. User privacy has always been a top priority for the company, which has worked with such organizations as the National Center for Missing and Exploited Children and WiredSafety. Facebook is TrustE certified. Users also have the ability to share and restrict information based on specific friends or friend lists.

**Funding**

Round one: \$500,000 from Peter Thiel, Summer 2004; Round two: \$12.7 million from Accel Partners, April 2005; Round three: \$27.5 million from Greylock Partners leading the round, Meritech Capital Partners participating, and Accel Partners and Peter Thiel increasing their investment in the company.

**Board**

Members: Mark Zuckerberg, Marc Andreessen, Jim Breyer, Don Graham and Peter Thiel; Observer: David Sze; Observer: Paul Madera

**Employees**

900+

**Users**

Over 300 million active (users who have returned to the site in the last 30 days)

**Offices**

Headquartered in Palo Alto, Calif. U.S. offices: Atlanta; Chicago; Dallas; Detroit; New York; Venice Beach, Calif. International offices: Dublin, Ireland; London; Paris; Sydney; Toronto.

|  |
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**EXHIBIT D**

# VentureBeat

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## Web 2.0 Summit: a conversation with Mark Zuckerberg

November 6, 2008 | Dean Takahashi | Comments |



John Battelle of Federated Media is interviewing Mark Zuckerberg, chief executive of Facebook, at the Web 2.0 Summit now. Zuckerberg spoke last year at the summit, wearing sandals. This year, Battelle noticed, Zuckerberg is wearing tennis shoes.

The conversation started with a dance around questions that Zuckerberg couldn't answer. Asking the same opening question as he did last year, Battelle said, "How's the financing going?" Last year, Facebook was negotiating a \$240 million investment by Microsoft. Rumors are again floating that Facebook is seeking a new round of money. Zuckerberg said it's not clear that he really needs money right now.

"Trips to Dubai?" Battelle said.

"I've never been to Dubai," Zuckerberg said. Battelle also asked if Facebook's chief financial officer had been there recently. Zuckerberg didn't answer. Battelle then asked, "Do you need money?"

Zuckerberg answered, "No."

The talk moved on. Zuckerberg said there are now more than 100 million users (120 million, to be exact). International growth has been the primary goal this

year, Zuckerberg said. Facebook is now being translated into 20 native languages. Facebook is opening a bunch of overseas offices. He noted that 7 percent of the French population is on Facebook now. The company is still pursuing growth. It is not optimizing revenue, but Zuckerberg said that ads and brand direct sales are working well.

"How does it break down?" Battelle asked. Zuckerberg wouldn't answer that. He said that revenues are in the hundreds of millions. Early on, Zuckerberg said that Microsoft was a big source of revenues. It's still millions of dollars, but a smaller percentage of revenue than the other pieces, he said.

"Do you think Steve Ballmer is happy with the price he paid?" Battelle asked, noting that the \$240 million Microsoft investment valued Facebook at an astounding \$15 billion.

It was more about a partnership, Zuckerberg said, than money. "We've got a really good partnership," he added.

Battelle asked again. "Do you think Steve is happy with the price he paid?" Zuckerberg said it was a good valuation but the company does not feel pressure to live up to the valuation from last year.

"On a day-to-day basis, we do not have a discussion where we need to do something to value the company at \$15 billion," Zuckerberg said.

Zuckerberg said that his company is still hiring "really good technical people — the people who are building things." He also said they are expanding international sales. He noted that the Facebook redesign really helped some useful applications such as Causes.

Battelle asked about Facebook Connect, the next iteration of the Facebook platform which lets developers create apps that allow Facebook users connect to friends on other networks. Facebook Connect was in closed beta test and has now opened up to anyone. Battelle said a criticism of Facebook is that it's a "walled garden," particularly because it doesn't want to be part of a broader, distributed web and won't join OpenSocial.

Zuckerberg says systems often wind up being open, but they have to "start somewhere." He noted how Facebook opened itself up to third-party applications. Over time, he said, opening up further is worth a conversation.

"These systems move toward openness over time," he said. "Look at the PC industry. Microsoft wound up being a strong company because they made itself more open over time." But, he noted, Microsoft didn't start that way.

"The challenge we have is to bring people along that whole path," he said. "Facebook Connect is the next evolution. There is a rate at which this will happen."

How does Facebook Connect make money? The whole model is indirect and ad-driven, Zuckerberg said.

Is Twitter just a feature of Facebook? "I think they're doing something pretty good," Zuckerberg said. He noted they are one of the partners in Facebook Connect. He said that socially aware ads perform much better than others. There was one ad that ran which showed a Facebook user's friends supporting certain causes such as Obama's campaign. That one got a lot of results, Zuckerberg said.

What about Facebook being banned, particularly in enterprises and in the Army? Zuckerberg said there are industries that have to monitor employee communications. There are policies that are allowing Facebook usage but ban just parts of it that might be sensitive, such as direct chat, Zuckerberg said. Over time, Facebook is adding tools that make the social network more useful to enterprise businesses, particularly where people can share ideas and get feedback for company-related matters.

"Facebook right now isn't an enterprise company, but seeing how that stuff is working gives me confidence that someone will build something really good in this space," he said.

"Is there a chess game going on among rivals regarding openness?" Battelle asked. That was an overly dramatic way of putting it, Zuckerberg said. "We are on stage," Battelle said. "That's my job." Zuckerberg replied, "Fair enough."

Zuckerberg said it is really early in the platform definition for social networks. He said that it isn't clear whether OpenSocial and Facebook will always be going in different directions.

"We'll have to see how it plays out," he said.

Zuckerberg is encouraged that people are sharing more and more things about their lives on Facebook. The more that grows, the more Facebook is doing its job, he said.

Asked how people can alter a cause that they organized, such as the Facebook group that emerged to oppose Proposition 8 in California (which banned gay marriage), Zuckerberg said the tools are there for people to take something that they started and morph it into something else.

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|--|--|---|
| <p><b>Facebook</b><br/>http://www.facebook.com/</p>  | <p>Watch Company<br/>Get Widget</p>  |  |
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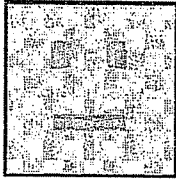
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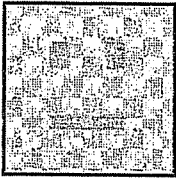


Neft 11 months ago

See the video of the interview with Mark: <http://web2summit.blip.tv/#1453588>

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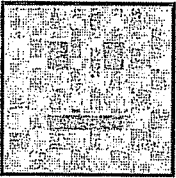
Emma Brand 7 months ago

"Zuckerberg is encouraged that people are sharing more and more things about their lives on Facebook."

I think after recent events, people are less likely to want to share everything, thanks to the somewhat devious dealings of Facebook.

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abercrombie622 2 weeks ago

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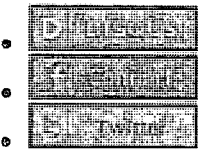
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**EXHIBIT E**



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
 United States Patent and Trademark Office  
 P.O. Box 1450  
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Ex Parte Reexamination Filing Data -- June 30, 2009

|  |                    |
|--|--------------------|
| 1. Total requests filed since start of <i>ex parte</i> reexam on 07/01/81..... | 10066 <sup>1</sup> |
| a. By patent owner   | 3615      36%      |
| b. By other member of public   | 6286      62%      |
| c. By order of Commissioner  | 165      2%        |
| 2. Number of filings by discipline   |                    |
| a. Chemical Operation  | 2914      29%      |
| b. Electrical Operation  | 3487      34%      |
| c. Mechanical Operation  | 3503      35%      |
| d. Design Patents  | 162      2%        |
| 3. Annual <i>Ex Parte</i> Reexam Filings                                       |                    |
| Fiscal Yr. No.      Fiscal Yr. No.      Fiscal Yr. No.      Fiscal Yr. No.     |                    |
| 1981    78 (3 mos.)    1989    243      1997    376      2005    524           |                    |
| 1982    187      1990    297      1998    350      2006    511                 |                    |
| 1983    186      1991    307      1999    385      2007    643                 |                    |
| 1984    189      1992    392      2000    318      2008    680                 |                    |
| 1985    230      1993    359      2001    296      2009    481YTD              |                    |
| 1986    232      1994    379      2002    272                                  |                    |
| 1987    240      1995    392      2003    392                                  |                    |
| 1988    268      1996    418      2004    441                                  |                    |
| 4. Number known to be in litigation.....                                       | 3079.....31%       |
| 5. Decisions on requests.....  | 9675               |
| a. No. granted.....  | 8895.....92%       |
| (1) By examiner  | 8782               |
| (2) By Director (on petition)  | 113                |
| b. No. denied.....   | 780.....8%         |
| (1) By examiner  | 745                |
| (2) Reexam vacated   | 35                 |

<sup>1</sup>Of the requests received in FY 2009, 20 requests have not yet been accorded a filing date, and preprocessing of 24 requests was terminated for failure to comply with the requirements of 37 CFR 1.510. See Clarification of Filing Date Requirements for *Ex Parte* and *Inter Partes* Reexamination Proceedings, Final Rule, 71 Fed. Reg. 44219 (August 4, 2006).

|     |   |                    |                                    |                     |         |
|-----|---|--------------------|------------------------------------|---------------------|---------|
| 6.  | Total examiner denials (includes denials reversed by Director).....                                   |                    |                                    | 858                 |         |
| a.  | Patent owner requester  | 444                |                                    | 52%                 |         |
| b.  | Third party requester   | 414                |                                    | 48%                 |         |
| 7.  | Overall reexamination pendency (Filing date to certificate issue date)                                |                    |                                    |                     |         |
| a.  | Average pendency  |                    | 25.1 (mos.)                        |                     |         |
| b.  | Median pendency   |                    | 19.5 (mos.)                        |                     |         |
| 8.  | Reexam certificate claim analysis:  | Owner<br>Requester | 3 <sup>rd</sup> Party<br>Requester | Comm'r<br>Initiated | Overall |
| a.  | All claims confirmed  | 22%                | 27%                                | 12%                 | 25%     |
| b.  | All claims cancelled  | 8%                 | 13%                                | 21%                 | 11%     |
| c.  | Claims changes  | 70%                | 60%                                | 67%                 | 64%     |
| 9.  | Total <i>ex parte</i> reexamination certificates issued (1981 – present) .....                        |                    |                                    | 6908                |         |
| a.  | Certificates with all claims confirmed  |                    | 1705                               | 25%                 |         |
| b.  | Certificates with all claims canceled   |                    | 776                                | 11%                 |         |
| c.  | Certificates with claims changes  |                    | 4427                               | 64%                 |         |
| 10. | Reexam claim analysis – requester is patent owner or 3 <sup>rd</sup> party or Commissioner initiated: |                    |                                    |                     |         |
| a.  | Certificates – PATENT OWNER REQUESTER .....   |                    |                                    | 2792                |         |
| (1) | All claims confirmed  |                    | 621                                | 22%                 |         |
| (2) | All claims canceled   |                    | 228                                | 8%                  |         |
| (3) | Claim changes   |                    | 1943                               | 70%                 |         |
| b.  | Certificates – 3 <sup>rd</sup> PARTY REQUESTER .....  |                    |                                    | 3969                |         |
| (1) | All claims confirmed  |                    | 1066                               | 27%                 |         |
| (2) | All claims canceled   |                    | 517                                | 13%                 |         |
| (3) | Claim changes   |                    | 2386                               | 60%                 |         |
| c.  | Certificates – COMMISSIONER INITIATED REEXAM .....  |                    |                                    | 147                 |         |
| (1) | All claims confirmed  |                    | 18                                 | 12%                 |         |
| (2) | All claims canceled   |                    | 31                                 | 21%                 |         |
| (3) | Claim changes   |                    | 98                                 | 67%                 |         |

**EXHIBIT F**

## OVERVIEW OF USPTO PROCEEDINGS FOR THE REEXAMINATION OF A U.S. PATENT

Effect of a Pending Reexamination -- Each claim of a patent is presumed valid under 35 U.S.C. 282 and may be enforced notwithstanding the presence of a pending reexamination proceeding. See *Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988); See also *Viskase Corp. v. Am. Nat'l Can Co.*, 261 F.3d 1316, 1328, 59 USPQ2d 1823, 1831 (Fed. Cir. 2001); *In re Etter*, 756 F.2d 852, 857, 225 USPQ 1, 4 (Fed. Cir. 1985)(en banc). Although litigation may move forward in parallel with a reexamination proceeding, at the district court's discretion, the results of the reexamination proceeding may have an effect on the litigation. See e.g., *In re Translogic*, 504 F.3d 1249 (Fed. Cir. 2007). Under 35 U.S.C. 307, a patent is not revised by any amendment or cancellation of a claim made during a reexamination proceeding until a reexamination certificate is issued.

Ex Parte Reexamination – A proceeding in which any person may request reexamination of a U.S. Patent based on one or more prior patents or printed publications. A requester who is not the patent owner (i.e., a “third party requester”) has only limited participation rights in the proceeding. [MPEP 2209]

Inter Partes Reexamination – A proceeding in which any person who is not the patent owner and is not otherwise estopped may request reexamination of a U.S. Patent issued from an original application filed on or after November 29, 1999 based on one or more prior patents or printed publications. Both patent owner and third party requester have participation rights throughout the proceeding, including appeal rights. [MPEP 2609]

Reexamination Granted – An Order Granting Reexamination is not a determination of claim patentability. An Order that one or more claims of a U.S. Patent will be reexamined because the request has established the existence of at least one SNQ based upon prior patents and/or printed publications. [MPEP 2247.01]

In *ex parte* reexamination, the Order, whether granting or denying reexamination, must be mailed within three months of the filing date of the request for reexamination. [MPEP 2241]

In *inter partes* reexamination, the Order must be mailed not later than three months after the request is filed. [MPEP 2641]

Reexamination Denied – An Order Denying Reexamination is also not a determination of claim patentability. An order denying reexamination of any of the claims of a U.S. Patent because the Office has determined that no SNQ has been established in the request for reexamination. [MPEP 2247.01]

Substantial New Question of Patentability (SNQ) – A request for reexamination must establish the existence of at least one new technological teaching affecting any claim of the patent for which reexamination has been requested that was not considered by the Office in a prior Office proceeding involving the patent. The SNQ is established based on prior patents and/or printed publications. [MPEP 2242]

Notice of Filing of Request for Reexamination – Notice that a request for reexamination has been filed and accorded a filing date is published in the *Official Gazette*. [MPEP 2215]

Rejection (Non-Final) – The initial Office action on patentability.

In *ex parte* reexamination, the initial action is not mailed with the Order Granting Reexamination; the patent owner may file optional comments, to which the third party requester may respond, prior to the initial Office action. Therefore the Office must await the expiration of the periods for such comments and responses thereto before mailing the initial action. [MPEP 2262]

In *inter partes* reexamination, the initial action may optionally be mailed together with the Order Granting Reexamination, but even if not, no party comments are permitted prior the mailing of the initial action. Patent owner files a response to a non-final action that includes argument and/or an evidentiary showing

and/or amendments, and the response will be entered as a matter of right. Third party requester may thereafter respond with written comments directed to the Office action and to the patent owner's response. [MPEP 2260]

Rejection (Final) – A second or subsequent action on patentability in an *ex parte* reexamination may be made “final.” While responsive arguments may be considered, entry of an amendment or consideration of additional evidence is not a matter of right in a final rejection. Patent owner may appeal to the USPTO Board of Patent Appeals and Interferences (BPAI). [MPEP 2271]

Action Closing Prosecution (ACP) – The second or subsequent action on patentability in an *inter partes* reexamination proceeding. Patent owner may respond with argument and/or an evidentiary showing and/or amendments. Alternatively, patent owner may choose not to respond. If patent owner does file a response, then third party requester may thereafter file written comments directed only to the patent owner's submission. Entry of the patent owner response is not a matter of right. Neither party may appeal at this point in the proceeding. [MPEP 2671.02]

Right of Appeal Notice (RAN) – After (1) considering any patent owner response to an ACP, and any third party requester written comments thereto, or (2) the expiration of the time for patent owner to file a response and no response has been filed, the examiner will either re-open prosecution if necessary, or issue a RAN. The RAN sets time periods in which the parties may appeal to the BPAI. The RAN also closes prosecution. Any amendment filed after a RAN will not be entered. [2673.02]

It is possible for the Office to issue a RAN after a patent owner response to the initial Office action on patentability if both parties stipulate that the issues are appropriate for a final rejection and or a final patentability determination.

Appeal to the BPAI – Ex Parte Reexamination – A notice of appeal is a proper response to a final rejection in an *ex parte* reexamination. Only patent owner may appeal. The appeal process is similar to that in a non-provisional patent application. [MPEP 2273]

Appeal to the BPAI – Inter Partes Reexamination – Either party may file a notice of appeal as a proper response to a RAN in an *inter partes* reexamination. If some claims are rejected and some claims are allowed or confirmed as patentable, both parties may appeal those determinations, file appeal briefs, respondent's briefs directed to the other party's appeal brief, and, after the examiner files the examiner's answer to those briefs, file a rebuttal brief directed to the examiner's answer. [MPEP 2674]

Subsequent (Court) Appeals – Ex Parte Reexamination – If the request for reexamination was filed prior to November 29, 1999, patent owner may appeal the decision of the BPAI to either the U.S. District Court for the District of Columbia, or to the Court of Appeals for the Federal Circuit. If the request for reexamination was filed on or after November 29, 1999, patent owner may appeal only to the Federal Circuit. [MPEP 2279]

Subsequent (Court) Appeals – Inter Partes Reexamination – Either party who was a party to an appeal to the BPAI and is dissatisfied with the result may appeal only to the Court of Appeals for the Federal Circuit. [MPEP 2683]

Concurrent Reexamination and Litigation – If there is concurrent litigation and reexamination on a patent, and the request for reexamination was filed as a result of court order, or the litigation has been stayed for the purpose of reexamination, the Office will expedite the proceedings by taking the case up for action at the earliest possible time, setting shorter response times, and permitting extensions of time only upon a strong showing of sufficient cause. [MPEP 2286]

Effect of Concluded Litigation on Reexamination



A court decision holding that a patent claim is valid will not preclude the Office from continuing to reexamine such claim in an *ex parte* reexamination proceeding, even if the court decision is final and non-appealable. The Office applies the “broadest reasonable interpretation” for claim language in a reexamination proceeding, because claims may be amended during the proceeding. Courts apply a less liberal standard of claim interpretation, and therefore, the Office may conclude that a claim held valid in a court proceeding is unpatentable or invalid in an *ex parte* reexamination proceeding. [MPEP 2286]

A final, non-appealable court decision holding that a patent claim is invalid will preclude the Office from ordering any reexamination proceeding for such claim, or, will result in termination of any reexamination proceeding previously ordered as to such claim. [MPEP 2286]

It should be noted that with respect to *inter partes* reexamination, a final, nonappealable holding in litigation that a patent claim is valid may operate to estop a party from even requesting *inter partes* reexamination of that claim, or from maintaining a previously ordered *inter partes* reexamination of that claim. Estoppel may also operate to preclude a party who has obtained an Order Granting *Inter Partes* Reexamination of a patent claim from asserting invalidity of that claim in litigation under Section 1338 of Title 28 on grounds that such party raised, or could have raised, during that *inter partes* reexamination, if that claim has been finally determined to be patentable in the *inter partes* reexamination proceeding. [MPEP 2686.04(V)]

Notice of Intent to Issue Reexamination Certificate (NIRC) – Reexamination proceedings do not become “abandoned.” Rather, an NIRC is mailed to inform the parties that a reexamination proceeding has been terminated, whether by the failure of a party to timely file a required response, or by the natural resolution of all outstanding issues of claim patentability. The NIRC lists the status of all claims that were subject to reexamination, including any patent claims that have been canceled and any claims added during the proceeding that were not part of the patent that were reexamined and determined to be patentable. The NIRC also indicates which patent claims, if any, were not reexamined. An NIRC may include an examiner’s amendment, and must include reasons for confirmation of any patent claims that were determined to be patentable without amendment, and reasons for allowance of any amended patent claims or any newly added claims. [MPEP 2287]

Reexamination Certificate – A reexamination proceeding is concluded by publication of a reexamination certificate. The certificate amends the text of the patent that was reexamined, in a manner analogous to a certificate of correction. The Reexamination Certificate will contain the text of all changes to the text of the patent that was the subject of the reexamination proceeding. [MPEP 2288 and 2290]

Notice to the Public of Reexamination Certificate – Publication of a reexamination certificate is announced in the Official Gazette. [MPEP 2691]

# EXHIBIT G



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Inter Partes Reexamination Filing Data - June 30, 2009

Table with 7 main categories: 1. Total requests filed since start of inter partes reexam on 11/29/99 (671); 2. Number of filings by discipline (Chemical, Electrical, Mechanical, Design); 3. Annual Reexam Filings (table with columns for Fiscal Yr. and No. from 2000-2009); 4. Number known to be in litigation (446, 66%); 5. Decisions on requests (583 total, 95% granted, 5% not granted); 6. Overall reexamination pendency (Average: 36.1 mos., Median: 33.0 mos.); 7. Total inter partes reexamination certificates issued (77 total, 35% with claim changes).

1Of the requests received in FY 2009, 14 requests have not yet been accorded a filing date, and 8 requests have had preprocessing terminated, for failure to comply with the requirements of 37 CFR 1.915. See Clarification of Filing Date Requirements for Ex Parte and Inter Partes Reexamination Proceedings, Final Rule, 71 Fed. Reg. 44219 (August 4, 2006).

**EXHIBIT H**

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## Reexamining *Inter partes* Reexam

Beginning in 1981, U.S. patent law set up patent reexamination as an administrative alternative to litigation for addressing patent validity concerns. The idea was to create a less expensive and speedier alternative to decide questions of patent validity. Although the level of scrutiny of the U.S. patent system has risen dramatically in light of the ongoing debate over patent reform, reexamination has received relatively little attention. Recently however, we have observed a number of trends that suggest that it might be time to carefully reexamine patent reexamination, particularly *inter partes* reexamination.

In doing so, we have discovered the following:

- *Inter partes* reexamination requests are rising rapidly – a 6X increase between 2003 and 2007
- Reexamination, particularly *inter partes* reexamination is not simply used as an alternative to litigation, but an integral part of litigation strategy – more than half (52%) of patents in *inter partes* reexams are known to be in litigation during their reexamination
- Virtually all requests for *inter partes* reexamination are granted – 95% of *inter partes* reexam requests are granted, and this statistic may actually understate the effective grant rate
- To date, there has never been a single *inter partes* reexamination that has gone through the entire reexamination process (including appeal) and made it to completion – only three have ever received a decision by the Board of Patent Appeals and Interferences
- Despite a mandate for “special dispatch”, the time required to complete an *inter partes* reexamination is much longer than commonly believed
  - o Without appeal, the average pendency period for *inter partes* reexam is 43.5 months, much longer than the 28.5 months reported by the USPTO – a 95% confidence interval would put the pendency between 34 and 53 months
  - o Although no *inter partes* reexam has ever been completed after being appealed, the average pendency for appealed *inter partes* reexams is 78.4 months (assuming no rework by the patent office or secondary appeal) - a 95% confidence interval would put the pendency between 5 and 8 years

## Why reexamine *inter partes* reexams?

Over the last several years, the number of reexamination requests at the USPTO has been rising rapidly. This is particularly true for *inter partes* reexams. The number of requests for *inter partes* reexam had increased 6X from 24 in calendar 2003 to 142 in calendar 2007. (Note: Our analysis is based on calendar years rather than the USPTO’s fiscal year.) This increase appears to be a result of the increasing use of reexamination as an integral part of litigation strategy by defendants or potential defendants in patent

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litigation. According to USPTO statistics, more than half (52%) of all patents subject to *inter partes* reexamination are known to be in litigation during the reexamination process.

The story of Microsoft and Avistar is a particularly telling example. After six months of licensing negotiation, Microsoft has requested reexamination of 24 of Avistar's 29 U.S. patents. Although Avistar's key patents have previously survived two significant litigations, Microsoft's actions have delayed its licensing program and placed the company into financial distress resulting in a 25% reduction in its U.S. and European workforce.

Although the reexamination statute in the U.S. may have been intended to provide an alternative to litigation, the actual use of reexamination appears to be an augmentation of litigation strategy rather than an alternative. In many cases, patent litigation in U.S. courts and 337 actions at the International Trade Commission (investigations of unfair trade practices related to IP infringement) run simultaneously with reexamination at the Patent Office. Simultaneous litigation and reexamination raise serious questions for U.S. courts about whether to wait for the results of a pending reexamination or continue with their court proceedings.

The conclusions so far have been mixed. In some cases, patent litigation has been stayed pending the results of reexam, while in others, the cases have continued. Many people will remember for example that Judge Spencer who presided over the contentious patent battle between NTP and RIM over the "Blackberry patents" famously refused to stay the litigation proceedings despite the fact that the PTO had issued an initial rejection of the claims at issue.

These difficult and often critical decisions by circuit court judges and administrative law judges depend heavily on their understanding and expectations of what will happen in the reexamination process at the PTO. How reliable are initial office actions as a predictor of final results in a reexamination? How long will the process take? How often are the patent examiner's findings upheld on appeal? For judges, these questions are critical in determining whether a request for a stay should be granted. For litigants, these questions can strongly influence litigation strategy.

*Ex parte* reexamination was established by statute in 1981, and more than 9,000 reexamination requests have been filed with more than 6,000 reexamination certificates issued (signaling the completion of the process). The *ex parte* reexamination process is well established. Much less is known about *inter partes* reexams. Established by statute in November of 1999, the first *inter partes* reexamination was not requested until 2001. Through mid-April of 2008, there have been 396 requests for *inter partes* reexamination at the USPTO, and only 16 of those have received reexamination certificates.

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Given the rising importance of reexaminations in general, and the relative scarcity of information about *inter partes* reexam specifically, we decided to take a closer look to discover what can be learned about this relatively little understood process.

## What did we do?

To examine the *inter partes* reexamination process, we copied transaction level data for every *inter partes* reexamination from the USPTO's PAIR database. These transactions reveal both the sequence and the timing of each step through the process. The database we created all cases and transactions through April 16, 2008.

We noted and corrected a number of anomalies in the PTO data including:

- Several reexaminations appeared to proceed without the initial "Request for *Inter partes* Reexamination" transaction in the PTO data – we investigated and manually filled in this missing data
- Several reexaminations included references to "*ex parte*" reexamination despite the fact that they were "*inter partes*" reexams – we manually reviewed and resolved each discrepancy
- Duplicate transactions (same reexam number, same transaction, same date) were eliminated – these were generally not errors, but represent instances where the documents were uploaded into the PAIR system in multiple parts

We then extracted the key milestone transactions in the reexamination process and mapped the process and timeline for every *inter partes* reexamination to discover what path each case had taken through the process, and how long each step in the process takes. The results of our analysis are briefly described below, and more fully captured in the attached presentation slides.

## What did we find?

### Requests for *inter partes* reexamination are rising rapidly

As described above, the number of *inter partes* reexamination requests is rising rapidly. In 2007, there were 142 requests for *inter partes* reexams, three times as many as in 2005, and nearly six times as many as in 2003. *Inter partes* reexam requests have risen nearly 90% per year (CAGR) over the last five years.

### Nearly all *inter partes* reexamination request are granted

Granting a request for reexamination is not automatic. The standard for granting a reexamination request requires that a "significant new question" of patentability must be presented by the requestor. Since their inception in 2001, there have been 396 requests for *inter partes* reexamination requested at the USPTO. Of these, 354 have reached a decision about whether the reexamination request will be granted. Over this period, ninety-five percent of all *inter partes* reexam requests have been granted. With so few requests being denied (19), we reviewed each case where a reexamination was denied, and found that the effective denial rate may actually be overstated. A number of the

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nineteen requests for reexamination that were denied are from a small number of inventions where multiple patent reexams were requested. Still others were not for utility patents, but were request for reexamination of design patents. It is fair to say that virtually all requests for *inter partes* reexamination are granted. Whatever threshold has been established by the Patent Office for determining a "significant new question" of patentability, few requestors have been unable to clear it.

## The *inter partes* reexamination process is not linear

By tracing every single *inter partes* reexamination through the process, we were able to discover the path through reexamination that is actually followed by real patents in process. While the majority of patents follow the main sequence (Request → Grant → Non-final Office Action → ACP → Reexam Certificate), some cases skip steps, and others repeat steps multiple times. For example, some reexams skip over multiple steps and proceed quickly to a Reexam Certificate. This happens most often when the patent holder fails to respond to the Patent Office within the statutory timeframe, and the PTO proceeds to issue a certificate. Still other times, patents repeat steps multiple times. About one-quarter of the time *inter partes* reexams include multiple "Non-final Office Actions", and about one-tenth of the time they receive multiple "Actions Closing Prosecution".

## One-quarter of all *inter partes* reexam decisions are appealed, but none has ever proceeded through appeal to the end of the process

One of the major challenges in examining the *inter partes* reexam process is that very few cases have proceeded all the way through the process. Through mid-April 2008, only nineteen cases have ever proceeded past the Notice of Right to Appeal. Of these, approximately one-quarter (5 cases - 26%) have been appealed to the Board of Patent Appeals and Interferences (BPAI), one case (~5%) went back for another Action Closing Prosecution, and the remaining 13 cases (68%) moved on to "Intent to Issue a Reexam Certificate".

Of the cases that have gone on to appeal, only three have received a decision by the BPAI. None of the three decisions represents a final decision by the BPAI that can be appealed to the Federal Circuit as in each case, the Board added new grounds for rejection and remanded the cases to the Patent Office for further action. None of the three cases has reached a final Reexamination Certificate, and it has taken 4, 4, and 5 years for the cases to get to the initial BPAI decision.

## The average pendency of 28.5 months reported by the USPTO is highly skewed

The USPTO regularly publishes statistics about *inter partes* reexaminations. According to their latest publication (December 31, 2007), the average pendency (Filing date to certificate issue date) is 28.5 months. This calculation is based on only 12 *inter partes* reexaminations that had reached a final certificate by that date. In our analysis which is up to date as of April 16, 2008, we found 16 reexaminations that had reached a final



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certificate. Our calculation of average pendency for those cases was only slightly longer at 30.1 months.

However, in carefully examining the 16 cases that have received final certificates, we note that 10 of the completed reexams skipped directly from the "First Non-final Action" to the "Intent to Issue a Reexam Certificate". Upon closer inspection, each of these cases skipped multiple steps because the patent owner failed to respond to the office action. The average pendency of these cases was 24 months, while the average for the remaining six cases that followed the basic process (Non-final Action → ACP → Right of Appeal → Notice of Intent to Issue a Reexam Certificate → Reexam Certificate) was ~39 months. It should be noted that NONE of the cases that have received a final Reexam Certificate have gone to appeal.

While mathematically accurate, the pendency statistic provided by the USPTO is highly misleading. An appropriate reading of the statistic is that the Patent Office takes two years to dispose of a patent through *inter partes* reexam if the patent holder doesn't care to defend its rights. It takes significantly longer to get to a resolution if the patent holder participates in the process.

#### Average pendency for an un-appealed *inter partes* reexam is more than 3.5 years

Given the small number of cases that have proceeded through the *inter partes* reexam process, a more appropriate way to estimate average pendency is to calculate the time required for cases to proceed through each step in the process and sum them up. We calculated an average time and a 95% confidence interval for each step in the main sequence. Based on our calculations, it takes more than 3 ½ years (43.5 months) for the average case to proceed through the basic reexam process to a final conclusion – this assumes that the case is not appealed to the BPAI or beyond. A 95% confidence interval suggests a range of between 34 and 53 months for average pendency for an un-appealed *inter partes* reexam.

#### Expected pendency for appealed *inter partes* reexams is at least 6.5 years

*Inter partes* cases that go through the appeal process can be expected to take much longer than the 3 ½ years described above. Calculating average pendency for appealed cases is difficult because as we have noted, there has never been an appealed *inter partes* case that has completed the process. However, if we make a conservative assumption that all cases that go through the appeal process will receive a decision by the BPAI and immediately move to "Intent to Issue a Reexam Certificate", then we can calculate an average expected pendency. The result of this calculation is that average pendency (assuming no "rework" by the patent office and no secondary appeals to the BPAI, the Federal Circuit, or the Supreme Court) is 78.4 months – slightly longer than 6.5 years. A 95% confidence interval suggests an average pendency for appealed cases (again, assuming no rework) is between 5 and 8 years (60-97 months)! Given that the only three *inter partes* reexam cases that have received a BPAI decision all require further "rework" and are subject to further appeal, these estimates may be highly conservative.

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According to statute, reexam cases are to be handled with "special dispatch". This means that reexam cases are to receive priority over all other cases. The Patent Office has reportedly set a target of 24 months to complete the reexam process, but so far, the actual time to conclude an *inter partes* reexam is far beyond this target. This can not help but raise significant concern to anyone who is interested in the efficient administration of justice in the U.S. patent system.

## **Conclusion**

The *inter partes* reexam process requires special attention by the U.S. Patent Office. At present, the time to complete these cases far exceeds the expectation of "special dispatch" embodied in the patent statute. Federal judges, administrative law judges, and litigants should take special note of these facts as they can significantly impact the progress of patent litigation.

# EXHIBIT I

REEXAMINATION  
PRACTICE WITH  
CONCURRENT  
DISTRICT  
COURT PATENT  
LITIGATION

*Robert Greene Sterne,  
Kenneth Bass III, Jon Wright  
& Matt Dowd  
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Washington, DC*



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Matt Dowd.

# Reexamination Practice with Concurrent District Court Patent Litigation

By Robert Greene Sterne, Kenneth C. Bass, Jon E. Wright and Matt Dowd<sup>1</sup>

## I. Introduction<sup>2</sup>

This paper addresses the interface between patent litigation in the federal courts and reexamination proceedings involving the patent-in-suit at the United States Patent and Trademark Office. Celebrated cases such as the one involving the Blackberry wireless product, as well as the eBay case at the United States Supreme Court, have highlighted the critical interplay between these two worlds -- one of the Article III courts and the other of a U.S. Government administrative agency. These so-called "parallel universes" work with separate rules, time lines and results involving the same patent. As independent arbiters of patent validity, they each also pose a distinct set of challenges and risks.

For reasons discussed more fully below, patent reexamination continues to influence patent litigation and this influence is growing, especially if the option of *inter partes* reexamination is present. Through the efforts of its Central Reexamination Unit ("CRU"), the PTO has gone through great effort to make the current reexamination procedures a viable avenue for post-grant patent challenges, even while Congress mulls alternative post-grant proceedings. At the same time, the recent Supreme Court decision in *KSR v. Teleflex*,<sup>3</sup> appears to have cast serious doubt on the validity of many hundreds of thousands of issued patents. For these reasons, the Sedona Patent Litigation Conference 2007 has decided to continue its in-depth dialogue on how reexamination practice and other post-grant PTO proceedings fit with patent litigation. This paper repeats and reinforces many of the topics covered in the 2006 Sedona Conference on Patent Litigation as those topics continue to be highly relevant today. The authors have also updated the reexamination statistics coming from the CRU and have further tried to determine how the *KSR* decision could impact reexamination practice.

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<sup>1</sup> Sterne, Kessler, Goldstein and Fox, PLLC [www.skgf.com](http://www.skgf.com). Copyright 2007 SKGF, all rights reserved. This paper is a continuation of the paper presented during the Seventh Annual Sedona Conference on Patent Litigation, October 11-12, 2006 entitled "Integrating PTO Proceedings in Litigation Strategy" by Patrick E. Garrett, Robert Greene Sterne & Michael V. Messinger.

<sup>2</sup> The views expressed herein do not necessarily reflect those of the authors of this paper, their firm, or their clients. They also do not necessarily reflect those of the participants on the panel discussion at the Sedona Conference on this topic. They are presented in accordance with the Sedona Rules of full dialogue on these important issues in a completely off the record context so as to encourage education and the advancement of patent law.

<sup>3</sup> *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007).

## ***II. Issues for Consideration***

The following compilation of issues was raised by the authors, the Sedona Conference panelists, patent litigators, and prosecution specialists during Sedona Patent Litigation 2006. These "hot buttons" issues remain highly relevant in 2007 and are provided to aid critical decisions that need to be addressed to navigate the parallel worlds of PTO and district court proceedings involving the same patent rights.

### ***A. General PTO Prosecution Issues***

#### ***1. Protective Orders***

To what extent may the patent owner's trial team participate in prosecution of their pending patent applications, reexaminations, reissues, or interferences using information derived from the litigation?

To what extent may the accused infringer's trial team participate in prosecution of their own patent applications, reexaminations of the patent owner's patents, or interferences involving the patent owner?

#### ***2. Privilege***

What is the risk of waiver of privilege when a PTO submission, prosecution event or meeting uses litigation work product or reveals trial strategy?

#### ***3. Staffing***

What are the pros and cons of using patent attorneys from the trial team, or prosecution attorneys from the litigating law firm versus using outside patent attorneys or patent attorneys inside the patent owner's company. Consider the critical issues of efficiencies, maintenance of privilege, and compliance with protective orders? Best practices may warrant use of outside patent attorneys separate from the litigating firm and the patent owner's company.

### ***B. Reexamination Issues***

#### ***1. Timing of Reexamination Requests – When to File?***

When should a reexamination request be filed? Immediately after filing the answer to improve chances for a stay? Prior to enlisting of experts to identify the issues? Prior to finalization of expert reports to ensure consistency? Prior to submission of disputed claim terms or claim construction briefs to ensure consistency? After close of discovery to insure inclusion of potential additional prior art or deposition testimony? During the appeal to the Federal Circuit? After remand by the Federal Circuit to the district court?

## 2. *Multiple (ex parte) Reexamination Requests*

In what situations should multiple (ex parte) reexamination requests be considered? What impact might multiple or "rolling" reexamination requests have on the district court judge? Could multiple reexamination requests impact an already granted litigation stay?

## 3. *Withholding of Prior Art*

Should an accused infringer withhold prior art from a reexamination request, either for a potential subsequent reexamination request or for use at trial? As discussed below, some district court judges have crafted stays to preclude the third party requester from using art that could or should have been brought during the reexamination proceeding. Also note that there are express limitations regarding subsequent submissions of prior art in *inter parties* reexaminations.

## 4. *Experts' Independence*

Should technical or legal experts have access to reexamination requests prior to preparing reports? Also, do experts have a role in preparing a reexamination request?

## 5. *Stays and Binding Reexamination*

Is there a growing trend in which judges stay trial proceedings upon consent of the parties to be bound by the outcome of reexamination proceedings? Or does this remain an Eastern District of Texas phenomenon?

## 6. *SNQ Prior Art Rejection and Inequitable Conduct*

Does a PTO finding of a substantial new question (SNQ) of patentability have evidentiary value relating to "materiality" in an inequitable conduct determination? Does a PTO rejection of a claim (whether or not in suit) of the patent in suit have evidentiary value relating to "materiality" in an inequitable conduct determination? Does a PTO final rejection of a claim (whether or not in suit) of the patent in suit, or the subsequent affirmation of such rejection by the BPAI or the Federal Circuit, have evidentiary value relating to "materiality" in an inequitable conduct determination?

## 7. *SNQ and KSR*

What impact will the recent Supreme Court decision in *KSR v. Teleflex* have on the requestors ability to meet the "substantial new question" of patentability standard? Does an SNQ of patentability automatically exist for any patentee who overcame a prior art rejection under 35 U.S.C. § 103(a)? How will the CRU deal with *KSR* in terms of the SNQ and the subsequent reexamination of the claims?

**8. *Fast Courts versus Slow Courts***

How might the perceived speed of a court affect a decision to file a request for reexamination? Since the average pendency of a reexam through the CRU, the BPAI and the Federal Circuit is 48 to 60 months, is the vehicle of reexam more suitable for a slow court?

**9. *Cases with Multiple Defendants***

In cases with multiple defendants, how should a plaintiff deal with reexamination threats by a single defendant, or a plurality of defendants? For the defendants, should reexamination be explicitly dealt with in the joint defense agreement?

**10. *Standard of Obviousness***

How has the outcome of the pending United States Supreme Court case, *KSR vs. Teleflex*, and more recent Federal Circuit decisions involving obviousness, effected reexamination practice?

**11. *Interplay Between Co-Pending Reissue Applications and Re-examination Proceedings***

The PTO may merge a reexamination proceeding with a reissue application. What are the advantages or disadvantages for the parties? What factors go into the PTO's calculus in determining when or whether to merge co-pending proceedings.

**12. *Staffing in Reexaminations – The Judge's Perception***

Might a judge view a reexamination request as usurping the judge's authority? Does it help if the reexamination request is submitted by counsel not associated with trial counsel?

**13. *Interplay Between the Court's Claim Construction and PTO Construction***

The claim construction by the court often will be different and usually narrower than that used by the USPTO. USPTO practice dictates that claims be given their broadest reasonable interpretation consistent with the specification and the PTO is not limited by the considerations adopted by the trial court.

**14. *Burden of Proof***

In the world of litigation patent claims enjoy a clear and convincing evidence presumption of validity. In contrast, there is no such evidentiary presumption for claims under reexamination before the PTO.



### 15. *Limiting Patent Damages*

Statistics indicate that approximately two-thirds of patents put through re-examination result in some change to their claims. Ten percent are canceled outright. Consider the impact on patent damages.

### 16. *Prosecution Headaches*

Restarting prosecution in re-examination (*ex parte* or *inter partes*) creates the real world specter of prosecution estoppels and inconsistencies that result in adverse impact on subsequent patent litigation.

### 17. *Admissibility of Events in the Reexamination to the Jury*

Can the existence of or developments in the reexam, such as a final rejection of the claim(s) in suit, be brought to the attention of the jury, or is this inadmissible because it is too prejudicial? What about a decision by the BPAI? What if the claim(s) survive reexamination at the CRU? Does this make reexaminations more attractive in bench trials?

### 18. *Some Have Nicknamed the CRU as the "Central Rejection Unit". Is There Any Practical Truth To This Moniker?*

With the much greater resources devoted to the reexam process by the CRU, coupled with the impact of *KSR* in terms of how printed publications and patents will be treated by the CRU, and in *inter partes* reexaminations the presence of the third party requester through out the process, speculation abounds that the chance of a claim surviving the reexamination process is becoming less and less as time goes on. Is this speculation correct in practice?

## III. *Advanced Reexamination Practice in View of District Court Litigation*

Not all of the issues raised above are covered in detail below. However, the following sections should provide a patent litigator with at least the basic information needed to advise clients who are considering incorporating reexamination into their overall patent litigation strategy. The impact of *KSR* is also discussed in some detail.

### A. *General Tenets*

#### 1. *The Standard of Proof for Validity is Different for Reexamination than in District Court.*

The PTO reexamines patents using the same standards that it uses for original examinations. There is thus no presumption of validity for claims during reexamination.<sup>4</sup>

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<sup>4</sup> *In re Etter*, 756 F.2d 852 (Fed. Cir. 1985).

Further, non-patentability of claims only requires a showing by a preponderance of evidence.<sup>5</sup> In U.S. district courts, on the other hand, patents enjoy a presumption of validity under 35 U.S.C. § 282. Under that standard, invalidity of claims requires a showing by clear and convincing evidence. In sum, therefore, it should be easier to invalidate claims in view of prior art in a reexamination proceeding than at trial.

**2. *Claim Construction is Different for Reexamination than in District Court.***

During reexamination proceedings, claims are construed with their broadest reasonable interpretation, consistent with the specification.<sup>6</sup> For this reason, a Markman order in district court litigation has absolutely no preclusive effect on the PTO and is not binding thereon.<sup>7</sup> A broad claim construction draws in more potential prior art.

In U.S. district courts, on the other hand, claims are often construed so that they remain valid in view of prior art. The court looks to get the “correct” claim construction after reviewing the parties’ respective positions. Such a construction will typically be narrower than used by the PTO and may thus limit the world of available prior art.

**3. *KSR Has Likely Made it Easier for a Requestor to Show a Substantial New Question of Patentability.***

In *KSR v. Teleflex*, the Supreme Court overturned settled obviousness jurisprudence and refocused the obviousness calculus on the factors set forth more than 40 years ago in *Graham v. John Deere*. More specifically, the Supreme Court overturned the teaching-suggestion-motivation to combine (“TSM”) test that had become the hallmark of patentability in view of multiple prior art references. By replacing the objective TSM test with a more subjective approach to determining obviousness, the Supreme Court arguably made it far easier to reject patent applications and invalidate patents over combinations of prior art references. The *KSR* decision also calls into question the validity of literally hundreds of thousands of existing patents granted under the now discredited TSM standard.

In view of the new obviousness standard, the CRU will have to determine what threshold a requestor must meet to satisfy the substantial new question of patentability when the requestor relies on a combination of prior art references. Arguably, an SNQ of patentability exists over any patent that overcame an obviousness rejection by relying on TSM. Further, where new prior art comes to light that was not considered by the PTO, it appears as if a challenge to patent validity could become measurably easier.

As discussed in more detail below, the CRU is charged with conducting all reexaminations before the PTO. For the CRU to grant a reexamination request, the

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<sup>5</sup> *Xerox Corp. v. 3Com, Corp.*, 69 F.Supp.2d 404, 406-07 (W.D.N.Y. 1999).

<sup>6</sup> *In re Yamamoto*, 740 F.2d 1596, 1571 (Fed. Cir. 1984).

<sup>7</sup> *In re Trans Texas Holdings Corp.*, Docket No. 2006-1599, -1600, Slip. Op at 10-11 (Fed. Cir. August 22, 2007).

applicant must convince the CRU that there is substantial new question (“SNQ”) of patentability.<sup>8</sup> It is clear that the PTO views *KSR* as affecting a sea change to the obviousness calculus. Because the obviousness standard is retroactive, the practical reality is that an SNQ of patentability likely exists for nearly every issued patent that faced and overcame an obviousness rejection based on a combination of prior art references. This is especially true where the patent applicant relied on the old teaching-suggestion-motivation to combine test in overcoming the obviousness rejection.

Facing a potential flood of challenges to issued patents in view of *KSR*, the CRU will need to adopt standards to determine whether an SNQ exists vis-à-vis an applicant relying solely on *KSR* and previously reviewed prior art combinations. Based on our off-the-record conversations with PTO officials, the CRU has not yet developed those standards. Realistically and practically speaking, however, a reexamination applicant will likely have to do more than simply point to *KSR* and a previously considered prior art combinations. The minimum threshold for raising an SNQ based solely on previously considered prior art seems to be that this prior art must be viewed in “a new light.” A full development of the obviousness arguments will likely be required and reexamination applicant’s should expect the CRU to exercise its discretion in finding a SNQ of patentability in these circumstances.

In sum, the Supreme Court’s decision in *KSR* could have a potentially profound effect on reexamination practice—both on the number of reexaminations filed, and on the ease with which challengers may invalidate patents. If either number increases significantly, the effect on reexamination pendency and on district court patent litigation could be profound.

#### 4. *KSR Has Also Impacted What the PTO Will Consider as Analogous Art.*

In *KSR*, the Supreme Court stated that “any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.”<sup>9</sup> Indeed, the Court stated that “familiar items may have obviousness uses beyond their primary purposes.”<sup>10</sup> These statements from *KSR* may also impact the world of available prior art available to an accused infringer contemplating reexamination because *KSR* appears to weaken arguments that the applied art is “non-analogous.”<sup>11</sup>

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<sup>8</sup> See 37 C.F.R. § 1.515.

<sup>9</sup> *KSR Int’l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1742 (2007).

<sup>10</sup> *Id.*

<sup>11</sup> See *In re Icon Health & Fitness, Inc.*, Docket No. 2006-1573 (Fed. Cir. August 1, 2007).

5. ***The PTO is Not Bound by a Prior Determination of Validity by a U.S. Court.***

The PTO can invalidate patent claims that were previously declared not invalid by a U.S. Court. Thus, while the Office may accord deference to factual findings made by the court, the determination of whether a substantial new question of patentability exists will be made independently of the court's decision on validity, since the decision is not controlling on the Office.<sup>12</sup> A non-final holding of claim invalidity or unenforceability will also not be controlling on the question of whether a substantial new question of patentability is present. Only a final holding of claim invalidity or unenforceability (after all appeals) is controlling on the Office. In such cases, a substantial new question of patentability would not be present as to the claims held invalid or unenforceable.<sup>13</sup> In other words, the PTO will not reexamine patent claims that were previously invalidated by a U.S. court.

6. ***The Duty of Disclosure for the Patentee is Not Relaxed During Reexamination.***

A patent owner has a duty of disclosure during reexamination; the third party requestor does not. As a result, a patentee must take great care to fully disclose to the PTO all prior art that it has been made aware of as a result of the litigation, especially that art that was not used by the reexamination requestor. Failure to disclose to the PTO such prior art could result in a claim of inequitable conduct and could render the entire patent unenforceable, irrespective of whether the patent survives the reexamination proceedings.

***B. Potential Benefits/Risks of Reexamination for Accused Infringers***

1. ***Reexaminations May Affect Infringement Contentions.***

Arguments and amendments can potentially help a defendant's non-infringement defense, especially where a patent owner is forced to make narrowing arguments or amendments to key claim terms or phrases. Finally, many judges will stay litigation proceedings pending outcome of reexamination. Because of the potential impact on infringement contentions, reexamination requests should be filed on all patents-in-suit, if possible, and on all the asserted claims.

2. ***Reexamination May Affect Damages.***

Substantive amendments made during reexamination may defeat damages for past infringement by creating intervening rights.<sup>14</sup> A patent owner cannot seek damages for claims that are not substantially identical to the original claims.<sup>15</sup> There is no *per se* rule

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<sup>12</sup> *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988).

<sup>13</sup> See Manual of Patenting Examining and Procedure, § 2686.04.

<sup>14</sup> 35 U.S.C. § 307(b) and § 252.

<sup>15</sup> *Bloom Eng'g. Co. v. North American Mfg.*, 129 F.3d 1247, 1250 (Fed. Cir. 1997).

for determining whether a claim is not “substantially identical.”<sup>16</sup> The analysis includes examining “the claims of the original and the reexamined patents in light of the particular facts, including prior art, the prosecution history, other claims, and any other pertinent information.”<sup>17</sup> The determination is a legal one, and a claim is changed if its scope is changed.<sup>18</sup>

If a claim is determined to be not substantially identical, then a patentee may not seek damages for product sales prior to issuance of the reexamination certificate. If damages have already been awarded, a defendant may seek to have damages vacated since the patent was void *ab initio*. Again, because of the potential impact on damages, reexamination requests should be filed on all patents-in-suit, if possible, and on all the asserted claims.

Accused infringers should consider the following CRU statistics as of June 2007..

- 74% *Ex parte* all claims canceled or amended
- 88% *Inter partes* all claims canceled or amended

A full set of current CRU statistics are included at the end of this paper.

### 3. *The Litigation May be Stayed.*

A grant of reexamination may serve as a basis for a stay of trial proceedings. A stay is unlikely to be granted based simply on a reexamination request. The probability of a stay may go up after a reexamination is ordered (typically about two months after the request according to CRU goals), or after the first Office Action on the merits, which may accompany the order in an *inter partes* reexamination. This encourages early filing of reexaminations in a court proceeding, especially in a fast track court or the US ITC. A stay can delay the expense of trial for several years even when the reexamination does not result in any claim change. Over time, the patent owner may lose interest, key personnel, and/or financial resources, or other events in favor of the accused infringer could occur. Accordingly, a stay may improve the accused infringer’s settlement negotiating position.

Factors the court will consider in determining whether to grant a stay include whether the non-moving party will be unduly burdened or prejudiced by the stay, whether a stay will simplify the issues for trial, and whether discovery has been completed and a trial date set. Thus, a stay has a better chance of being granted if the order granting reexamination is received early in the litigation, before discovery is completed. A motion for a stay should also be filed before the Markman hearing; the parties and the judge will likely not want to endure the time and expense of a Markman hearing if there is any likelihood that the asserted claims will be amended during reexamination proceedings.

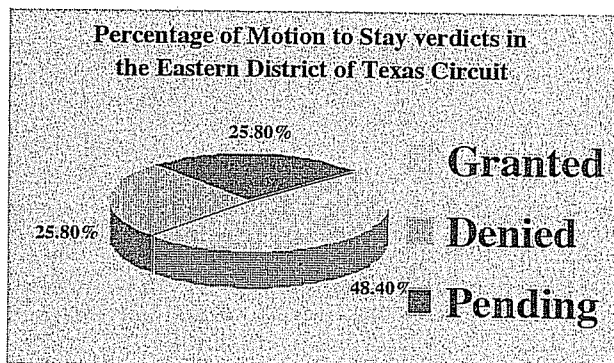
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<sup>16</sup> *Laitram Corp. v. Nec Corp.*, 952 F2d 1357 (Fed. Cir. 1991).

<sup>17</sup> *Id.* at 1362-63.

<sup>18</sup> *Tennant Co. v. Hako Minutman, Inc.*, 878 F2d 1413, 1417 (Fed. Cir. 1989).

The following chart reflects the status of motions to stay litigation filed from June 1, 2005 to June 1, 2007 in the Eastern District of Texas.<sup>19</sup>



An order to stay the litigation may come in several flavors and district court judges have a free reign in crafting litigation stays. For example, in addition to the estoppels that already explicitly to *inter partes* reexamination, a district court judge could make the same estoppels apply in the context of an *ex parte* reexamination request. For example, the stay may preclude future use of any art cited in the reexamination request to later challenge the validity of the asserted patent. At the other end of the spectrum, a stay could implement a form of issue preclusion and prevent the requestor from challenging the validity of the patent over any art or arguments that were or could have been brought during the reexamination proceeding. A party seeking a stay in view of reexamination proceedings would do well to investigate the types of stays granted by the judge, and in the relevant jurisdiction.

#### 4. *Reexamination May Affect Settlement.*

Because of these risks to the patent owner, a grant of reexamination, or an Office Action that is adverse to the patent claims, especially a final rejection, may improve the defendant's settlement negotiating position. Some practitioners suggest presenting a reexamination request to the patent owner prior to submitting the request to the PTO (*i.e.*, a "pocket reexamination request," to encourage early settlement on more favorable terms.

#### C. *Potential Risks of Reexamination for Accused Infringer.*

The clearest risk for an accused infringer is that at least one asserted patent claim survives the reexamination process unamended and without any adverse prosecution history estoppels. The reexamination may allow the patent owner to have the CRU deal with all of the art in the litigation and to present arguments and declarations that support patentability of the claims over this art, including possible secondary (objective)

<sup>19</sup> Graphic taken from PowerPoint presentation accompanying Federal Circuit Bar Association webinar on "Current State of Re-Exams at the USPTO," presented on September 13, 2007. Data obtained from PACER. Ms. Lissi Marquis and Mr. Greg Novak, two of the panelists for this Sedona Reexamination Panel, were presenters for the FCBA program.

considerations of non-obviousness that were not present when the claims were originally prosecuted. An *ex parte* reexamination may give the patent owner significant advantage in dealing with the art because the third party requester is excluded from the process after it is begun and the patent owner can interview the examiner. While the court can find a patent invalid even if it survives reexamination, most judges will defer to the presumed administrative expertise of the PTO, CRU and the BPAI.

#### ***IV. New Central Reexamination Unit (CRU) Improves Quality and Reduces Pendency***

##### ***A. Dedicated Examiners***

In 2005 the PTO created a dedicated Central Reexamination Unit (CRU) to ensure quality and consistency of reexamination proceedings, and to reduce pendency. The CRU handles all reexaminations regardless of technology and all legacy reexaminations have been transferred to the CRU from their respective Technology Centers. The CRU is currently headed by CRU Director, Ms. Lissi Marquis.

In 2006, the CRU included 31 Patent Examiners, 3 Supervisory Patent Examiners, and 10 support staff. The Examiners are selected from the ranks of the PTO Examiner Corps and have an average of approximately 17 years of examining experience. Many of the Examiners also have advanced technical degrees and/or law degrees. The Examiners are evaluated on work quality and workflow, not on production quotas as is the case with the regular examiner corps. Assignment to the CRU is recognized throughout the PTO as professional advancement, and morale throughout the CRU is high and turnover is low.

Cases are handled with special dispatch. Preparation of each Office Action involves two Patent Examiners and one Supervisory Patent Examiner. One of the Patent Examiners prepares the Office Action. The second Patent Examiner and the Supervisory Patent Examiner review the Office Action before the Office Action is mailed. The three Examiners will conference to resolve any disagreements. The assigned Examiners will not include an Examiner who examined the original patent application.

##### ***B. Expedited Handling***

The CRU has a three month deadline to issue a decision on an SNQ. Further, the Central Reexamination Unit (CRU) has established a goal to issue a Final Office Action within two years of the filing of a request for reexamination. All reexaminations are handled with "Special Dispatch." Higher priority is afforded to reexaminations of patents involved in litigation. Even higher priority is afforded when trial proceedings have been stayed pending the outcome of reexamination. The CRU has dedicated paralegals that search litigation databases for case status before each Office Action is mailed. Reexaminations that have been pending for nearly two years are assigned the highest priority.

**C. Practice Suggestions from the CRU Director, Ms. Marquis**

Under new practice, the CRU will only reexamine claims for which a substantial new question of patentability (SNQ) is alleged and found. In the past, a SNQ for even a single claim would typically trigger reexamination of all claims.

Under the new rules, every submitted reference must be applied to at least one claim. Many requests are being denied a filing date for failure to apply every cited reference. The filing date is important because the PTO strives to issue a final office within two years of the filing date.

Litigation docket numbers are not to be cited in PTO disclosure forms (i.e., PTO Form 1449, PTO/SB/08A, or PTO/SB/08B). Affidavits and/or testimony transcripts can be cited in PTO disclosure forms.

Extensions of time in reexamination proceedings must be obtained in advance, and will not be granted without a substantial reason. A request for an extension of time must include a description of relevant activities to date, reasons necessitating an extension of time, and relevant actions that will be taken during the requested extension period. Potential valid reasons include death or unavailability of the inventor, or a need for trial testimony or exhibits. Extensions of time will not be granted for holidays or vacations.

If you have a concern about a reexamination, contact the Office of the CRU Director before petitioning the Patent Commissioner. A petition to the Commissioner triggers the transfer of the reexamination file from the CRU to the Commissioner. This may delay the reexamination proceeding.

**V. Instituting and Prosecuting Reexaminations**

**A. Generally**

Reexamination can be *ex parte* or *inter partes*. In *ex parte* reexamination, a third party requestor will receive copies of Office Actions and patent owner replies, but cannot otherwise participate in the reexamination proceeding and cannot appeal PTO decisions. *Ex parte* reexamination is discussed below. In *inter partes* reexamination, when the patent owner submits a reply to an Office Action, the third party requestor is entitled to file comments in response thereto. The third party's comments must, however, be limited to issues raised by the Office action or in the patent owner's response. The third party requestor is entitled to certain appeals, but is also subject to certain estoppels. *Inter partes* reexamination is discussed below.

**B. The Request**

A request for reexamination must include a statement pointing out each substantial new question (SNQ) of patentability. The SNQ must be based on prior patents and/or printed publications. (37 CFR 1.510(b)(1), 37 CFR 1.915(b)(3)). Other patentability issues will not be considered for instituting a reexamination.



The request must also include an identification of every claim for which reexamination is requested, and a detailed explanation of the pertinence and manner of applying each of the cited prior art to every claim for which reexamination is requested. (37 CFR 1.510(b)(2), 37 CFR 1.915(b)(3)). Failure to address each submitted reference in the detailed description will result in a denial of a filing date. The filing date starts a two-year period in which the PTO strives to issue a Final Office Action.

The PTO will only reexamine those claims for which a SNQ is alleged and found. The PTO will consider an undated document if it is accompanied by reliable evidence, such as an affidavit or deposition transcripts, supporting an asserted publication date. Where a reference originated with the patent owner, the CRU might consider issuing a request to the patent owner for additional information under 37 CFR 1.105. For reexaminations ordered on or after November 2, 2002, a finding of a substantial new question of patentability, and claim rejections, can be based solely on previously cited/considered "old" prior art, or in combination with other prior art. MPEP 2242(II)(A) and MPEP 2258.01(A).

#### **C. Ex Parte Reexamination**

*Ex parte* reexamination can be requested by a patent owner or any third party requestor at any time during the enforceability of a patent. 35 USC 302, 37 CFR 1.510 ("Rule 510"). Subsequent requests for *ex parte* reexamination by a third party requestor are permitted. Co-pending reexamination proceedings may be merged. (Rule 565.) The patent owner is not permitted to broaden the scope of claims during *ex parte* reexamination. (Rule 552(b)). A third party requestor can appeal a determination refusing *ex parte* reexamination to the PTO Director. The Director's decision is non-appealable. (Rule 515(c)).

In response to a grant of *ex parte* reexamination, the patent owner is entitled to file a statement on the new question of patentability, including any proposed amendments the patent owner wishes to make. (37 C.F.R. 1.530). Where the *ex parte* reexamination was requested by third party, the third party is entitled to respond to such a patent owner statement. (37 C.F.R. 1.535). This may be a reason why it is not common for a patent owner to make a statement prior to receipt of an Office Action.

The patent owner is entitled to appeal to the Board of Patent Appeals and Interferences and to the Federal Circuit with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent. 35 U.S.C. 306. A third party requestor is not entitled to such appeals.

#### **D. Director-Initiated Ex Parte Reexamination**

The Director of PTO can institute *ex parte* reexaminations *sua sponte*. 35 USC 303, 37 CFR 1.520. Under current PTO practice, the Director will institute a reexamination only upon a finding that a patent brings disrepute on the PTO or that there was a significant procedural error during examination. For example, where a Patent Examiner failed to consider references submitted in an IDS during the examination

process, despite numerous requests from the applicant, the PTO may determine whether the references raise a SNQ.

#### ***E. Inter Partes Reexamination***

*Inter partes* reexamination can be requested by any party other than the patent owner and its privies, at any time during the period of enforceability of a patent. (Rule 913.). *Inter partes* reexamination is only available for patents that issued from an original application filed in the United States on or after November 29, 1999. (Rule 913.) As with ex parte reexaminations, a third party requestor can appeal a determination refusing *inter partes* reexamination to the Director. The Director's decision is non-appealable. (Rule 927.)

A patent owner is entitled to appeal to the Board of Patent Appeals and Interferences and to the Federal Circuit with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent. 35 U.S.C. 315(a). A third party requestor is entitled to appeal to the Board of Patent Appeals and Interferences and to the Federal Circuit with respect to any *final* decision favorable to the patentability of any original or proposed amended or new claim of the patent. 35 U.S.C. 315(b).

#### ***F. Estoppels in Inter Partes Reexamination***

A third party cannot argue invalidity in a civil patent action on any ground that was or could have been raised in a prior *inter partes* reexamination requested by the third party. The third party is not, however, precluded from asserting invalidity based on newly discovered art that was unavailable to the third party requestor and the PTO at the time of the *inter partes* reexamination. (35 U.S.C. 315(c)). Similarly, a third party cannot request *inter partes* reexamination on the basis of issues that the third party raised or could have raised in a prior civil patent action. (Rule 907(b)).

Once a request for *inter partes* reexamination has been granted, the third party requestor cannot file a subsequent request for *inter partes* reexamination while the prior *inter partes* reexamination is pending. 37 CFR 1.907(a) Once a final decision is granted favorable to patentability of any original, proposed amended, or new claim, the third party requestor cannot thereafter request *inter partes* reexamination of such claim on the basis of issues that the third party raised or could have raised in the prior *inter partes* reexamination. 37 CFR 1.907(c).

After an *inter partes* reexamination has been instituted, the third party requestor is precluded from citing any additional prior art unless it rebuts a finding of the Examiner or a response by the patent owner, or if it became known or available after filing of the request. (1.948)

In summary, failure to cite all known or available prior art in a *request for inter partes* reexamination could preclude the requestor from submitting the prior art during the *inter partes* reexamination and in any future *inter partes* reexamination.

## **VI. Merger and Stays in Concurrent PTO Proceedings**

It is possible and not too uncommon to have reexaminations that are co-pending with other reexaminations, or even with other post-grant proceedings such as reissue applications. Co-pending proceedings may be merged. Alternatively, one may be stayed relative to another. The determination is decided on a case-by-case basis and the parties may plead their case by petition. Factors include the relative status of one to the other in terms of completeness, the status of any co-pending litigation, and the nature of the proceeding itself. The various rules are listed below, however any ultimate action is at the discretion of the director.

- Merger of *ex parte* reexamination with co-pending *ex parte* reexamination, reissue and interference proceedings. 37 C.F.R. 1.565
- Merger of *ex parte* reexamination with reissue and interference proceedings. 37 C.F.R. 1.989(a)
- Merger of *ex parte* reexamination and *inter partes* reexamination proceedings. 37 C.F.R. 1.989(b)

## **VII. Reexamination Statistics**

Attached are reexamination statistics for 2006-2007.

Inter Partes Reexamination Filing Data - Fiscal Year 2006

|   |                  |
|---|------------------|
| 1. Total requests filed 10/01/05 - 9/30/06 .....  | 70 <sup>20</sup> |
| 2. Number of filings by discipline  |                  |
| a. Chemical Operation   | 17 24%           |
| b. Electrical Operation   | 27 39%           |
| c. Mechanical Operation   | 26 37%           |
| 3. Annual Reexam Filings  |                  |
| <u>Fiscal Yr.</u> <u>No.</u> <u>Fiscal Yr.</u> <u>No.</u> <u>Fiscal Yr.</u> <u>No.</u> <u>Fiscal Yr.</u> <u>No.</u> |                  |
| 2000        0            2002        4            2004        27            2006        70                          |                  |
| 2001        1            2003        21           2005        59  |                  |
| 4. Number known to be in litigation .....   | 45.....64%       |
| 5. Decisions on requests .....  | 47               |
| a. No. granted .....  | 43.....91%       |
| (1) By examiner   | 43               |
| (2) By Director (on petition)   | 0                |
| b. No. not granted .....  | 4.....9%         |
| (1) By examiner   | 4                |
| (2) Reexam vacated  | 0                |
| 6. Overall reexamination pendency (Filing date to certificate issue date, reexams concluded in FY06)                |                  |
| a. Average pendency   | 34.1 (mos.)      |
| b. Median pendency  | 40.0 (mos.)      |
| 7. Total inter partes reexamination certificates issued (in FY 2006) .....  | 4                |
| a. Certificates with all claims confirmed   | 1        25%     |
| b. Certificates with all claims canceled  | 3        75%     |
| c. Certificates with claims changes   | 0        0%      |

<sup>20</sup> Of the requests received in FY 2006, 9 requests have not yet been accorded a filing date, for failure to comply with the requirements of 37 CFR 1.915. See Clarification of Filing Date Requirements for *Ex Parte* and *Inter Partes* Reexamination Proceedings, Final Rule, 71 Fed. Reg. 44219 (August 4, 2006).

Inter Partes Reexamination Filing Data - June 30, 2007

|   |                   |                   |            |                   |            |                   |            |
|---|-------------------|-------------------|------------|-------------------|------------|-------------------|------------|
| 1. Total requests filed since start of <i>inter partes</i> reexam on 11/29/99 .....   | 272 <sup>21</sup> |                   |            |                   |            |                   |            |
| 2. Number of filings by discipline  |                   |                   |            |                   |            |                   |            |
| a. Chemical Operation   | 69                | 25%               |            |                   |            |                   |            |
| b. Electrical Operation   | 98                | 36%               |            |                   |            |                   |            |
| c. Mechanical Operation   | 105               | 39%               |            |                   |            |                   |            |
| 3. Annual Reexam Filings  |                   |                   |            |                   |            |                   |            |
| <u>Fiscal Yr.</u>   | <u>No.</u>        | <u>Fiscal Yr.</u> | <u>No.</u> | <u>Fiscal Yr.</u> | <u>No.</u> | <u>Fiscal Yr.</u> | <u>No.</u> |
| 2000  | 0                 | 2002              | 4          | 2004              | 27         | 2006              | 70         |
| 2001  | 1                 | 2003              | 21         | 2005              | 59         | 2007              | 90         |
| 4. Number known to be in litigation .....   | 137               | 50%               |            |                   |            |                   |            |
| 5. Decisions on requests .....  | 232               |                   |            |                   |            |                   |            |
| a. No. granted .....  | 223               | 96%               |            |                   |            |                   |            |
| (1) By examiner   | 2238              |                   |            |                   |            |                   |            |
| (2) By Director (on petition)   | 0                 |                   |            |                   |            |                   |            |
| b. No. not granted .....  | 9                 | 4%                |            |                   |            |                   |            |
| (1) By examiner   | 7                 |                   |            |                   |            |                   |            |
| (2) Reexam vacated  | 2                 |                   |            |                   |            |                   |            |
| 6. Overall reexamination pendency (Filing date to certificate issue date)             |                   |                   |            |                   |            |                   |            |
| a. Average pendency   | 29.1 (mos.)       |                   |            |                   |            |                   |            |
| b. Median pendency  | 30.4 (mos.)       |                   |            |                   |            |                   |            |
| 7. Total <i>inter partes</i> reexamination certificates issued (1999 - present) ..... | 8                 |                   |            |                   |            |                   |            |
| a. Certificates with all claims confirmed   | 1                 | 12%               |            |                   |            |                   |            |
| b. Certificates with all claims canceled  | 7                 | 88%               |            |                   |            |                   |            |
| c. Certificates with claims changes   | 0                 | 0%                |            |                   |            |                   |            |

---

<sup>21</sup> Of the requests received through June 30, 2007, 1 proceeding was vacated per 37 CFR 1.913; and 7 requests have not yet been accorded a filing date and preprocessing of I request was terminated, for failure to comply with the requirements of 37 CFR 1.915. See Clarification of Filing Date Requirements for *Ex Parte* and *Inter Partes* Reexamination Proceedings, Final Rule, 71 Fed. Reg. 44219 (August 4, 2006).

Ex Parte Reexamination Filing Data - Fiscal Year 2006

|  |                   |     |
|--|-------------------|-----|
| 1. Total requests filed 10/01/05 - 9/30/06 ..... | 511 <sup>22</sup> |     |
| a. By patent owner                               | 128               | 25% |
| b. By other member of public                     | 383               | 75% |
| c. By order of Commissioner                      | 0                 | 0%  |

|                                    |     |     |
|------------------------------------|-----|-----|
| 2. Number of filings by discipline |     |     |
| a. Chemical Operation              | 118 | 23% |
| b. Electrical Operation            | 228 | 45% |
| c. Mechanical Operation            | 165 | 32% |

3. Annual Ex Parte Reexam Filings

| <u>Fiscal Yr.</u> | <u>No.</u>  | <u>Fiscal Yr.</u> | <u>No.</u> | <u>Fiscal Yr.</u> | <u>No.</u> | <u>Fiscal Yr.</u> | <u>No.</u> |
|-------------------|-------------|-------------------|------------|-------------------|------------|-------------------|------------|
| 1981              | 78 (3 mos.) | 1989              | 243        | 1997              | 376        | 2005              | 524        |
| 1982              | 187         | 1990              | 297        | 1998              | 350        | 2006              | 511        |
| 1983              | 186         | 1991              | 307        | 1999              | 385        |                   |            |
| 1984              | 189         | 1992              | 392        | 2000              | 318        |                   |            |
| 1985              | 230         | 1993              | 359        | 2001              | 296        |                   |            |
| 1986              | 232         | 1994              | 379        | 2002              | 272        |                   |            |
| 1987              | 240         | 1995              | 392        | 2003              | 392        |                   |            |
| 1988              | 268         | 1996              | 418        | 2004              | 441        |                   |            |

|   |     |     |
|---|-----|-----|
| 4. Number known to be in litigation ..... | 229 | 45% |
|---|-----|-----|

|                                     |     |  |
|-------------------------------------|-----|--|
| 5. Determinations on requests ..... | 453 |  |
|-------------------------------------|-----|--|

|                      |     |     |
|----------------------|-----|-----|
| a. No. granted ..... | 422 | 93% |
|----------------------|-----|-----|

|                 |     |
|-----------------|-----|
| (1) By examiner | 417 |
|-----------------|-----|

|                               |   |
|-------------------------------|---|
| (2) By Director (on petition) | 5 |
|-------------------------------|---|

|                     |    |    |
|---------------------|----|----|
| b. No. denied ..... | 31 | 7% |
|---------------------|----|----|

|                 |    |
|-----------------|----|
| (1) By examiner | 31 |
|-----------------|----|

|                   |   |
|-------------------|---|
| (2) Order vacated | 0 |
|-------------------|---|

---

<sup>22</sup> Of the requests received in FY 2006, 35 requests have not yet been accorded a filing date, and preprocessing of one request was terminated, for failure to comply with the requirements of 37 CFR 1.510. See Clarification of Filing Date Requirements for *Ex Parte* and *Inter Partes* Reexamination Proceedings, Final Rule, 71 Fed. Reg. 44219 (August 4, 2006).

|  |                  |                  |                  |                |
|--|------------------|------------------|------------------|----------------|
| 6. Total examiner denials (includes denials reversed by Director) .....                  |                  |                  |                  | 36             |
| a. Patent owner requester  |                  | 14               |                  | 39%            |
| b. Third party requester   |                  | 22               |                  | 61%            |
| 7. Overall reexamination pendency (Filing date to certificate issue date)                |                  |                  |                  |                |
| a. Average pendency  |                  |                  |                  | 26.7 (mos.)    |
| b. Median pendency   |                  |                  |                  | 27.8 (mos.)    |
| 8. Reexam certificate claim analysis:  | Owner            | 3rd Party        | Comm'r           |                |
|  | <u>Requester</u> | <u>Requester</u> | <u>Initiated</u> | <u>Overall</u> |
| a. All claims confirmed  | 25%              | 27%              | 13%              | 26%            |
| b. All claims cancelled  | 9%               | 15%              | 37%              | 12%            |
| c. Claims changes  | 66%              | 58%              | 50%              | 62%            |
| 9. Total ex parte reexamination certificates issued (in FY 2006) .....                   |                  |                  |                  | 327            |
| a. Certificates with all claims confirmed  |                  |                  | 85               | 26%            |
| b. Certificates with all claims canceled   |                  |                  | 39               | 12%            |
| c. Certificates with claims changes  |                  |                  | 203              | 62%            |
| 10. Reexam claim analysis - requester is patent owner or 3rd party; or Comm'r initiated. |                  |                  |                  |                |
| a. Certificates - PATENT OWNER REQUESTER .....   |                  |                  |                  | 131            |
| (1) All claims confirmed   |                  |                  | 33               | 25%            |
| (2) All claims canceled  |                  |                  | 12               | 9%             |
| (3) Claim changes  |                  |                  | 86               | 66%            |
| b. Certificates - 3rd PARTY REQUESTER .....  |                  |                  |                  | 188            |
| (1) All claims confirmed   |                  |                  | 50               | 27%            |
| (2) All claims canceled  |                  |                  | 28               | 15%            |
| (3) Claim changes  |                  |                  | 110              | 58%            |
| c. Certificates - COMM'R INITIATED REEXAM .....  |                  |                  |                  | 8              |
| (1) All claims confirmed   |                  |                  | 1                | 12.5%          |
| (2) All claims canceled  |                  |                  | 3                | 37.5%          |
| (3) Claim changes  |                  |                  | 4                | 50%            |

Ex Parte Reexamination Filing Data - June 30, 2007

|   |                    |     |
|---|--------------------|-----|
| 1. Total requests filed since start of ex parte reexam on 07/01/81 .....  | 8732 <sup>23</sup> |     |
| a. By patent owner  | 3446               | 39% |
| b. By other member of public  | 5121               | 59% |
| c. By order of Commissioner   | 165                | 2%  |
| 2. Number of filings by discipline  |                    |     |
| a. Chemical Operation   | 2634               | 30% |
| b. Electrical Operation   | 2890               | 33% |
| c. Mechanical Operation   | 3208               | 37% |
| 3. Annual Ex Parte Reexam Filings   |                    |     |
| <u>Fiscal Yr.</u> <u>No.</u> <u>Fiscal Yr.</u> <u>No.</u> <u>Fiscal Yr.</u> <u>No.</u> <u>Fiscal Yr.</u> <u>No.</u> |                    |     |
| 1981    78 (3 mos.)    1989    243    1997    376    2005    524  |                    |     |
| 1982    187            1990    297    1998    350    2006    511  |                    |     |
| 1983    186            1991    307    1999    385    2007    477  |                    |     |
| 1984    189            1992    392    2000    318   |                    |     |
| 1985    230            1993    359    2001    296   |                    |     |
| 1986    232            1994    379    2002    272   |                    |     |
| 1987    240            1995    392    2003    392   |                    |     |
| 1988    268            1996    418    2004    441   |                    |     |
| 4. Number known to be in litigation .....   | 2145               | 25% |
| 5. Determinations on requests .....   | 8373               |     |
| a. No. granted .....  | 7662               | 92% |
| (1) By examiner   | 7551               |     |
| (2) By Director (on petition)   | 111                |     |
| b. No. denied .....   | 711                | 8%  |
| (1) By examiner   | 676                |     |
| (2) Order vacated   | 35                 |     |

<sup>23</sup> Of the requests received through June 30, 2007, 28 requests have not yet been accorded a filing date, and preprocessing of 25 requests was terminated, for failure to comply with the requirements of 37 CFR 1.510. See Clarification of Filing Date Requirements for *Ex Parte* and *Inter Partes* Reexamination Proceedings, Final Rule, 71 Fed. Reg. 44219 (August 4, 2006).



|  |                  |                  |                  |             |
|--|------------------|------------------|------------------|-------------|
| 6. Total examiner denials (includes denials reversed by Director) .....                  |                  |                  |                  | 787         |
| a. Patent owner requester  |                  | 442              | 56%              |             |
| b. Third party requester   |                  | 345              | 44%              |             |
| 7. Overall reexamination pendency (Filing date to certificate issue date)                |                  |                  |                  |             |
| a. Average pendency  |                  |                  |                  | 23.4 (mos.) |
| b. Median pendency   |                  |                  |                  | 18.2 (mos.) |
| 8. Reexam certificate claim analysis:  | Owner            | 3rd Party        | Comm'r           |             |
|  | <u>Requester</u> | <u>Requester</u> | <u>Initiated</u> |             |
|  |                  | <u>Overall</u>   |                  |             |
| a. All claims confirmed  | 23%              | 29%              | 13%              | 26%         |
| b. All claims cancelled  | 7%               | 12%              | 21%              | 10%         |
| c. Claims changes  | 70%              | 59%              | 66%              | 64%         |
| 9. Total ex parte reexamination certificates issued (1981 - present) .....               |                  |                  |                  | 5795        |
| a. Certificates with all claims confirmed  |                  |                  | 1513             | 26%         |
| b. Certificates with all claims canceled   |                  |                  | 596              | 10%         |
| c. Certificates with claims changes  |                  |                  | 3686             | 64%         |
| 10. Reexam claim analysis - requester is patent owner or 3rd party; or Comm'r initiated. |                  |                  |                  |             |
| a. Certificates - PATENT OWNER REQUESTER .....   |                  |                  |                  | 2503        |
| (1) All claims confirmed   |                  |                  | 578              | 23%         |
| (2) All claims canceled  |                  |                  | 181              | 7%          |
| (3) Claim changes  |                  |                  | 1744             | 70%         |
| b. Certificates - 3rd PARTY REQUESTER .....  |                  |                  |                  | 3149        |
| (1) All claims confirmed   |                  |                  | 917              | 29%         |
| (2) All claims canceled  |                  |                  | 385              | 12%         |
| (3) Claim changes  |                  |                  | 1847             | 59%         |
| c. Certificates - COMM'R INITIATED REEXAM .....  |                  |                  |                  | 143         |
| (1) All claims confirmed   |                  |                  | 18               | 13%         |
| (2) All claims canceled  |                  |                  | 30               | 21%         |
| (3) Claim changes  |                  |                  | 95               | 66%         |

## **EXHIBIT J**



908 PLI/Pat 91  
908 PLI/Pat 91

Practising Law Institute  
Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series  
PLI Order No. 13599  
August, 2007

Parallel Patent Litigation and Reexamination Proceedings 2007: Keeping Your Case on Track

**\*91 STAYS PENDING REEXAMINATION**

Jack B. Blumenfeld  
Leslie A. Polizoti  
Morris, Nichols, Arsht & Tunnell LLP

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#### \*95 I. *EX PARTE* REEXAMINATIONS

Most reexaminations are *ex parte*. In *ex parte* reexaminations, the PTO has confirmed all claims about 26% of the time, and allowed amended claims 64% of the time. There is only a 10% chance that all of the claims will be cancelled.

Nonetheless, historically, reexamination and stay have been initiated by the alleged infringer. Recently, however, it has also become a patentee's game.

##### A. Strategic Considerations -- From The Alleged Infringer's Perspective

Your client has been sued for patent infringement. A reexamination is pending, or you can start one with what you think is a "killer" piece of prior art not considered during prosecution. Should you seek a stay?

###### 1. *The Upside*

Generally, the benefit of a stay to a defendant is delay. The importance of delay depends on the circumstances -- for example, if the patent will expire soon; if the defendant needs time to do a design-around or to try to postpone an injunction; or if the defendant cannot afford litigation.

###### 2. *The Downside*

Reexamination is not a likely route for the defendant to win the case. In *ex parte* reexaminations, the patentee has total control. Once this reexamination is started, the defendant cannot stop it. The most likely outcome is that the claims will survive reexamination -- by being confirmed or amended (in a way that still covers the accused products). Then, the defendant goes to trial with its best prior art having been blessed by the PTO, and with the patent having been examined twice.

###### 3. *Post-trial Reexamination*

If litigation results in the patent being upheld, and the PTO later cancels the claims after reexamination, the patent is invalid. [FN1] At this point, there is no downside to the adjudicated infringer. The defendant may also be able to use a pending reexamination to stay \*96 an injunction or a damages proceeding. See *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 996 F.2d 1236 (Fed. Cir. 1993) (unpublished).

##### B. Strategic Considerations -- From The Patentee's Perspective

- Your client has sued for infringement, and the defendant has cited better art than what was considered during the original prosecution. Should you put the patent into reexamination and seek a stay? This is a strategy that is becoming more common.

###### 1. *The Upside*

Generally, the benefit to the patentee of a reexamination is to have the PTO confirm patentability over the defendant's best art, and then to use that confirmation in the litigation. The patentee has much more control

in an ex parte reexamination, including the ability to amend the claims strategically.

## 2. The Downside

Delaying the day of reckoning.

## II. TRENDS IN DISTRICT COURTS

### A. Who Typically Requests A Reexamination And A Stay?

#### 1. The Trends

In the vast majority of cases, it is the defendant that requests reexamination and then moves for a stay. In reported stay decisions since 2004, the defendant requested the reexamination more than 75% of the time, and moved to stay more than 80% of the time. A stay was granted in slightly more than half of the decisions. In the four reported decisions where a plaintiff moved to stay, only one was granted.

#### 2. The Defendant's Motion

The driving force for defendants to request a stay is to delay trial. In most of the cases the motion was made late in the litigation -- after discovery, a Markman hearing, or summary judgment briefing. These motions were usually denied, in part because the court found that the defendant sought delay or the stay would result in undue delay. *E.g., NTP, Inc. v. Research in Motion, Ltd.*, 397 F. Supp. 2d 785, 788 (E.D. Va. 2005) ("Valid patents would be \*97 rendered meaningless if an infringing party were allowed to circumvent the patents' enforcement by incessantly delaying and prolonging court proceedings which have already resulted in a finding of infringement.").

Where the motion was made earlier in the case, before discovery, it was usually granted.

#### 3. The Plaintiff's Motion

Courts will deny a stay if they think that the plaintiff is trying to game the system by filing suit, taking discovery and then moving to stay the case. *See, e.g., Jain v. Trimas Corp.*, 2005 WL 2397041 (E.D. Cal. 2005) ("plaintiff chose the forum, forced defendant to expend time and money, and now, after the litigation has progressed for over a year, seeks reexamination of his patent [and a stay] based on prior art references known [for more than a year].").

One court granted a plaintiff's motion to stay after the defendant requested the reexamination. *3M Innovative Properties Co. v. DuPont Dow Elastomers LLC*, 2005 WL 2216317 (D. Minn. 2005). Although the defendant argued that a stay would be prejudicial, the court dismissed that argument because the defendant, who opposed the stay, "is the very party that requested reexamination by the PTO at a late stage in the litigation . . . . Any prejudice to DuPont is partly of its own making." *Id.* at \*2. Additionally, the court believed that the result of the reexamination could be relevant to the defendant's inequitable conduct defense, by assisting with the determination whether the undisclosed art was material. *Id.*

### B. Three-Factor Test For A Stay

Courts use a three-factor test on a motion for a stay: (1) how far the litigation has progressed; (2) whether a stay would unduly prejudice or present a clear tactical disadvantage to the non-moving party; and (3) whether a stay will simplify the issues in the case. *Gunthy-Renker Fitness, LLC v. Icon Health and Fitness, Inc.*, 48

U.S.P.Q.2d 1058 (C.D. Cal. 1998).

### 1. *The Progress Of The Litigation*

Litigation is more likely to be stayed if it is in its early stages (*e.g.*, before the close of discovery). *E.g.*, *KLA-Tencor Corp. v. Nanometrics, Inc.*, 2006 WL 708661 (N.D. Cal. 2006). If, however, discovery has passed, or there has been a Markman hearing or summary judgment briefing, the stay is usually denied. *But see Motson v. Franklin Covey Co.*, 2005 WL 3465664 (D.N.J. 2005) \*98 (granting after summary judgment, but before a trial date was set, because plaintiff did not argue prejudice and because the reexamination would simplify issues).

Courts usually link this factor to the other two. For example, courts may find no prejudice if the case is stayed early in the litigation; but if the litigation is close to trial, it is likely that the court will perceive that the motion was made for a tactical advantage.

### 2. *Prejudice And Tactical Advantages*

**Knowledge Of The Prior Art.** A party's knowledge of the prior art, without a reason for delaying the request for reexamination, usually cuts against a stay. *E.g.*, *Lectrolarm Custom Servs., Inc. v. Vicon Indus., Inc.*, 2005 WL 2175436, \*5 (W.D. Tenn. 2005) ("The Defendants were aware of the allegedly invalidating prior art that is central to their request for reexamination long before they actually submitted the request to the PTO.").

**Prejudice.** Courts have found prejudice, for example, when a pending summary judgment motion would resolve the whole case. *Jain*, 2005 WL 2397041 at \*2. Courts have also found prejudice when the movant objected to other delay earlier in the litigation, *e.g.*, *Soverain Software LLC v. Amazon.com, Inc.*, 356 F. Supp. 2d 660, 662 (E.D. Tex. 2005), or when the moving party otherwise has already tried to delay the case, *e.g.*, *Centillion Data Sys., LLC v. Convergys Corp.*, 2005 WL 2045786, \*1 (S.D. Ind. 2005) (denying defendants' motion to stay in part because defendants delayed case for 18 months by challenging jurisdiction).

Generally, if a case is in its early stages, courts will not find prejudice (*e.g.*, *KLA-Tencor*, 2006 WL 708661 at \*2-3). Even if the non-movant claims prejudice, many courts will dismiss such an argument by noting that any prejudice can be remedied by money damages. *E.g.*, *Zilog, Inc. v. Quicklogic Corp.*, 2004 WL 2452850, \*2 (N.D. Cal. 2004) (granting stay in part because "damages, the only remedy at issue here, are dictated by the complaint filing date, the recoverable amount is independent of the length of litigation").

### 3. *Simplifying The Issues*

**Knowledge Of What Happens In The PTO.** Some courts will grant a stay based upon an optimistic view of what will happen during reexamination. Other courts have a more realistic understanding of what happens during reexamination and deny the stay, noting that the PTO may consider only patents and printed publications, and will not consider other defenses such as on sale bar, public \*99 use, enablement, written description, best mode, and inequitable conduct. *See* 35 U.S.C. § 301, 311; *e.g.*, *In re Columbia Univ. Patent Litigation*, 330 F. Supp. 2d 12, 15-16 (D. Mass. 2004); *Lectrolarm*, 2005 WL 2175436 at \*3 ("Further, reexamination only deals with invalidity from printed prior art. Unless all claims were invalidated . . . this court would still need to deal with issues concerning other types of prior art, liability, and damages.").

Moreover, some courts do not consider reexamination proceedings duplicative of litigation, noting, for example, that the PTO and a court may correctly reach different outcomes on the same issues. *E.g.*, *In re Columbia Univ. Patent Litigation*, 330 F. Supp. 2d at 15 ("The courts and the PTO take different approaches

to examining the validity of a patent. [citations omitted.] Consequently, the courts and the PTO may properly reach different conclusions on the same evidence.”).

**PTO's Statistics.** Statistically, the PTO cancels all claims 10% of the time. The claims are confirmed 26% of the time, and amended 64%. *Ex Parte Reexamination Filing Data -- June 30, 2006*. Courts sometimes find that these statistics weigh in favor of denying a stay, interpreting them as “suggest[ing] that in a typical case there is a substantial probability a reexamination will have a major impact on the issues to be resolved.” *KLA-Tencor*, 2006 WL 708661 at \*4.

Another way to interpret the statistics, however, is that there is a 90% chance that the claims will survive the reexamination -- so the court will have to learn the technology and construe the claims anyway. Even if the claims are narrowed, the patentee will try to ensure that they are narrowed in such a way that there is still an argument for infringement. As one court noted in support of denying a motion to stay, the court may still need to determine the scope of the original claims, even if they are amended during reexamination. See *In re Columbia Univ. Patent Litigation*, 330 F. Supp. 2d at 18 (noting that the court may still need to construe the original claims even after reexamination because a party cannot be liable for infringement before the issuance of a reexamination certificate unless the reexamined claims are identical to the original ones).

### C. The Trends In Delaware

Chief Judge Robinson and Judge Farnan typically deny motions to stay pending reexamination. Their view seems to be that the Court and the PTO each have jobs to do, and they can be done in parallel. For example, Judge Robinson has cited the Federal Circuit's decision in \*100 *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988), to explain that litigation and reexamination are “distinct proceedings, with distinct parties, purposes, procedures, and outcomes.” *ArthroCare Corp. v. Smith & Nephew, Inc.*, C.A. No. 01-504 slip op. at 1-2 (D. Del. Nov. 11, 2002). In her view, the court's “primary purpose is to manage litigation in an expeditious manner in order to create an appropriate record (through motion practice or trial) for review by the Federal Circuit.” She will not, therefore, stay cases pending reexamination “absent extraordinary circumstances.” *Id.* at 2.

Judge Farnan has also denied motions stay based on his view that the court's role is to prepare the case for appeal. For example, in *St. Clair v. Sony*, he denied Sony's motion to stay pending reexamination because:

[t]his case, like many, is about “the injunction.” If successful at trial, St. Clair will aggressively seek an injunction against Sony. Sony will aggressively oppose St. Clair's efforts. In my view, the pending reexamination proceeding will not do much to contribute to this end game strategy.

C.A. No. 01-557 slip op. at 3 (D. Del. Jan. 30, 2003). He also noted that he was “convinced that a trial and appeal is what will finally resolve the parties' dispute.” *Id.* at 3-4.

In contrast, Judge Sleet has typically granted stays during reexamination. See, e.g., *Gioello Enterprises Ltd. v. Mattel, Inc.*, 2001 WL 125340 (D. Del. 2001); see also, *Textron Innovations, Inc. v. The Toro Co.*, C.A. No. 05-486 (D. Del. April 25, 2007) (granting stay pending reexamination even though discovery was completed and trial was two months away); *Abbott Diabetes Care, Inc. v. Dexcom, Inc.*, C.A. No. 05-590 (GMS), 2006 U.S. Dist. LEXIS 57469 (D. Del. Aug. 16, 2006). Some of his cases, however, have involved unique factual circumstances. For example, in two cases where he granted a stay, there was a Federal Circuit appeal pending, in addition to a reexamination. See *Alloc, Inc. v. Unilin Décor N.V.*, C.A. No. 03-253 (D. Del. July 11, 2003) (staying case where a closely related patent-in-suit was being reexamined, and where the Federal Circuit was reviewing three other closely related patents from an ITC appeal); *In re Pharmastem Therapeutics, Inc. Patent Litigation*, C.A. No. 05-md-1660, October 6, 2005 (staying case where three of the four patents-in-suit were being reexamined and the Federal Circuit was reviewing, among other issues, the validity of two of the pat-

ents-in-suit). Another case he stayed was unusually complex: the plaintiffs filed more than 300 related patent applications with an estimated 10,000 claims. See *Pegasus Development Corp. v. DirecTV*, C.A. No. 00-1020, Memorandum and Order (D. Del. May 14, 2003) (“Given the involved prosecution history of the \*101 various patents-in-suit and hundreds of related patents, the number of claim terms at issue, the inordinate amount of prior art references, and the PTO’s conclusion that all of the challenged claims warrant reexamination, the court finds particular merit in permitting an additional layer of review by the PTO before expending further judicial resources.”).

### III. INTER PARTES REEXAMINATIONS

When *inter partes* reexamination went into effect in November 1999, the PTO had projected approximately 400 *inter partes* reexamination requests in 2000, and then increasing 10% per year. In the first five years, only 53 *inter partes* reexamination requests were filed, as opposed to the projected 2,500. As of April 2007, seven *inter partes* reexaminations had gone through to issuance of reexamination certificates. In six of the seven, all challenged claims were cancelled. Thus far, in cases where the PTO has issued an office action, it has rejected claims in 71% of the cases. As numbers increase, it will likely be a much more fertile area for stays pending reexamination.

35 U.S.C. § 318 provides that once an *inter partes* reexamination order has been issued, the patent owner may obtain a stay of “any pending litigation which involves an issue of patentability of any claims in the patent which are the subject of the *inter partes* reexamination order,” unless the Court determines that a stay would not serve the interest of justice. Why a patent owner would not want to do that to itself is another question.

Although the decisions are very recent, district courts have frequently granted stays of litigation pending *inter partes* reexamination. *Habasit Belting, Inc. v. Rexnord Indus. Inc.*, C.A. No. 03-185-JJF (D. Del. Sept. 22, 2005); *Echostar Tech. Corp. v. Tivo, Inc.*, 2006 U.S. Dist. LEXIS 48431 (E.D. Tex. 2000); *Graham-White Mfg. Co. v. Ell-Con Nat'l, Inc.*, 2006 U.S. Dist. LEXIS 68754 (D.S.C. 2006); *Tesco Corp. v. Varco I/P, Inc.*, 2006 U.S. Dist. LEXIS 82047 (S.D. Tex. 2006); *Intermotive, Inc. v. Inpower, LLC*, 2007 U.S. Dist. LEXIS 1301 (E.D. Cal. 2007); *eSoft, Inc. v. Blue Coat Systems, Inc.*, 2007 U.S. Dist. LEXIS 11261 (D. Colo. 2007); *Anascape, Ltc. v. Microsoft Corp. and Nintendo of America, Inc.*, 47 F. Supp. 2d 612 (E.D. Tex. 2007) (staying claims on patents for which *inter partes* reexamination had been requested, but denying stay on patent which *ex parte* reexamination had been requested); but see *Mars, Inc. v. JCM American Corp*, 2006 U.S. Dist. LEXIS 84565 (D.N.J. 2006) (affirming Magistrate Judge’s denial of stay).

#### \*102 IV. A CASE STUDY

The *ArthroCare v. Smith & Nephew* case from the District of Delaware illustrates how a plaintiff can benefit from reexamination during litigation. ArthroCare sued Smith & Nephew for infringement of three patents relating to arthroscopic surgical devices. C.A. No. 01-504-SLR. At the time the lawsuit was filed, the PTO had granted a third party request for reexamination of one of the patents.

##### A. The Defendant’s Motion To Stay Is Denied

In November 2002, the PTO rejected the claims of the patent-in-suit in light of prior art relied on in the litigation. Smith & Nephew immediately moved to stay pending reexamination. Chief Judge Robinson denied the stay. Her order quoted the Federal Circuit’s *Ethicon* decision, explaining that litigation and reexamination are not duplicative, because they are “distinct proceedings, with distinct parties, purposes, procedures, and outcomes.” Nov. 11, 2002 slip op. at 1-2. She also noted that “in this case, where only one of the three pat-



ents is undergoing reexamination, where the patents at issue relate to an evolving and highly competitive market, and where the reexamination proceedings to date have not been conducted with what the court would consider 'special dispatch,' the court declines to find this an exceptional case warranting a stay." *Id.* at 2.

#### **B. The Plaintiff Uses The Reexamination To Its Benefit**

During the reexamination, the patentee put all of defendant's prior art and invalidity contentions before the Patent Office. In March 2003, just before trial, the PTO issued a Notice of Intent to Issue Reexamination Certificate for all claims. Smith & Nephew moved *in limine* to exclude evidence of the reexamination at trial. ArthroCare argued that (1) the reexamination is relevant because it is part of the prosecution history of one of the patents-in-suit; (2) the defendant's burden of proving invalidity is "especially difficult to meet" when the art relied on was considered by the PTO; and (3) the notice of intent was a final notice -- not a preliminary office action. Chief Judge Robinson denied that motion.

#### **C. The Defendant Could Not Tell The Jury About The Second Reexamination**

Smith & Nephew then requested reexaminations of all three patents. Shortly before trial, the PTO granted those requests. The defendant was \*103 not allowed to put those before the jury, however, because they were not final actions. *See also Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1584 (Fed. Cir. 1996) ("... the grant by the examiner of a request for reexamination is not probative of unpatentability . . . although surely evidence that the criterion for reexamination has been met (i.e., that a 'substantial new question of patentability' has been raised . . .), [the grant] does not establish a likelihood of patent invalidity.").

#### **D. The Trial**

During trial, the jury was told about the reexamination, including that the plaintiff had put all of the defendant's invalidity contentions before the PTO, and the claims had been confirmed. In addition to the then-standard jury instruction that patents are presumed valid, the jury was given an additional instruction about the reexamination:

One of the patents-in-suit . . . has been the subject of a reexamination . . . . Reexamination is a procedure that allows the Patent Office to address substantial new questions of patentability after the issuance of a patent . . . . If the patentability of the claims is confirmed, the Patent Office will issue a Notice of Intent to Issue an Ex Parte Reexamination Certificate . . . .

The jury upheld the validity of the patents.

#### **E. The Permanent Injunction Was Not Stayed Pending Appeal**

Smith & Nephew moved to stay the permanent injunction, arguing that there was substantial doubt as to the validity of the patents, because the PTO had granted Smith & Nephew's requests for reexamination. Chief Judge Robinson also denied this motion, holding that Smith & Nephew's appeal did not have a strong likelihood of success on the merits. She noted that the fact that reexamination was granted did not cast the validity of the patents in doubt, especially after the jury upheld their validity, and after the Court had found on JMOL that the jury's verdict was based on substantial evidence. 315 F. Supp. 2d 615, 619-20 (D. Del. 2004).

#### **F. Post-script**

In September 2005 and April 2006, the PTO issued Notices of Intent to Issue Reexamination Certificates for

all three of the patents-in-suit. Although some of the claims were cancelled, most were either confirmed or amended with similar scope as the original claims.

[FN1]. If the patent is invalidated in litigation, that decision is controlling on the PTO, and the PTO should discontinue the reexamination. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1429 (Fed. Cir. 1988).

908 PLI/Pat 91

908 PLI/Pat 91

END OF DOCUMENT

**EXHIBIT K**

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

LEADER TECHNOLOGIES, INC., a  
Delaware corporation

Plaintiff,

v.

FACEBOOK, INC., a Delaware  
corporation

Defendant.

**CIVIL ACTION**

**NO. 1:08-cv-00862-JJF**

**FACEBOOK, INC.'S FIRST  
SUPPLEMENTAL RESPONSES TO  
PLAINTIFF LEADER TECHNOLOGIES,  
INC.'S INTERROGATORIES NOS. 3, 4, 6,  
AND 10**

PROPOUNDING PARTY: LEADER TECHNOLOGIES, INC.

RESPONDING PARTY: FACEBOOK, INC.

SET NUMBER: ONE (1)

Pursuant to Rule 33 of the Federal Rules of Civil Procedure, defendant and counterclaimant FACEBOOK, INC. ("Facebook") hereby serves its First Supplemental Responses to LEADER TECHNOLOGIES, INC.'s ("LTP") Interrogatories Nos. 3, 4, 6, and 10. The responses contained herein are based on information reasonably available to Facebook as of the date of this response. Facebook's investigation is continuing and ongoing and Facebook expressly reserves the right to revise and/or supplement these responses.

**GENERAL OBJECTIONS**

The following General Objections shall be deemed incorporated in full into each of the individual responses set forth below.

1. Facebook objects to each interrogatory to the extent it purports to require Facebook to do anything beyond that required by the Federal Rules of Civil Procedure, the Local

Rules of this Court, or other applicable law.

2. Facebook objects to Plaintiff's "Instructions" to the extent they seek to impose obligations beyond those permitted by the Federal Rules of Civil Procedure, the Local Rules of this Court, or other applicable law.

3. Facebook objects to each interrogatory to the extent it seeks information protected from disclosure by the attorney-client privilege, the attorney work-product doctrine, and/or any other applicable privilege or immunity.

4. Facebook objects to each interrogatory to the extent it is phrased in a manner that renders it overly broad, vague, ambiguous, or requires subjective judgment or speculation on the part of Facebook. Facebook responds to these interrogatories by construing them in light of the scope of the issues in this action.

5. Facebook objects to each interrogatory to the extent it seeks to elicit information that is subject to a right of privacy under the relevant provisions of federal and state law.

6. Facebook objects to each interrogatory to the extent it seeks to elicit information that comprises third-party confidential information.

7. Facebook objects to each interrogatory to the extent it purports to place an obligation on Facebook to obtain information that is as readily available to LTI as it is to Facebook.

8. Facebook objects to each interrogatory to the extent it calls for information not in the possession, custody and control of Facebook.

9. Facebook objects to each interrogatory to the extent it seeks privileged information originating on or subsequent to the commencement of this lawsuit. Given the burden and expense to Facebook involved in creating a privilege log in accordance with Instruction C, Facebook objects to logging information originating on or subsequent to the commencement of this lawsuit.

10. Facebook objects to each interrogatory to the extent it is not properly limited in time and/or improperly attempts to capture information, if any, created prior to issuance of the

'761 patent.

### **OBJECTIONS TO DEFINITIONS**

A. Facebook objects to Plaintiff's definition of "you," "your," "Facebook," and "Defendant" as overly broad. Facebook shall construe the terms to mean Facebook, Inc., TheFacebook, LLC, and their employees, agents and attorneys.

B. Facebook objects to Plaintiff's definition of "Facebook Website" on the grounds that it purports to include every iteration, function, application and/or technology ever in existence at facebook.com (including legacy or related website(s)), and countless systems and applications unrelated to Facebook or its services. This definition renders Plaintiff's interrogatories grossly overbroad and unduly burdensome, and purports to seek information that is neither relevant to the subject matter of this action nor reasonably calculated to lead to the discovery of admissible evidence. Facebook further objects to the definition as vague and ambiguous on the grounds that it includes additional undefined terms (*e.g.*, "Site Content" and "User Content").

C. Facebook objects to Plaintiff's definition of "'761 Patent" and "Patent-in-Suit" as overly broad. Facebook shall construe these terms as limited to United States Patent No. 7,139,761 and as not extending to related or pending patents or patent applications.

D. Facebook objects to Plaintiff's definition of "document" to the extent it seeks to define that term more broadly than the Federal Rules of Civil Procedure and/or the Federal Rules of Evidence. Facebook shall construe the term in a manner consistent with said Rules.

E. Facebook objects to Plaintiff's instructions as to the definition of "identify" when applied to a document, product, individual or event as an overly broad and improper instruction. Facebook shall give the term its ordinary meaning.

### **SPECIFIC OBJECTIONS AND RESPONSES**

#### **INTERROGATORY NO. 3:**

Describe in detail the complete factual basis for the First Affirmative Defense pled in the Facebook Amended Answer that "Facebook is not infringing and has not infringed any claim of

the '761 Patent, either literally or under the doctrine of equivalents" and identify the persons most knowledgeable about, and all documents and things relating to, such defense.

**FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 3:**

Facebook incorporates by reference its original General and specific Objections and Responses to Interrogatory No. 3, as well as its General Objections set forth above.

Subject to and without waiving its objections, Facebook responds as follows: Plaintiff has asserted claims 1, 2, 4, 5, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 21, 23, 24, 25, 26, 29, 31, 32, 33 and 34 of the '761 patent; but has refused to provide any contentions regarding how Facebook allegedly infringes these claims. Facebook is aware of no basis for any contention that it practices or has practiced each and every limitation of the asserted independent claims 1, 9, 21 or 23 of the '761 patent, as required to establish infringement. Because the patent laws make clear that a dependent claim "shall be construed to incorporate by reference all of the limitations of the claim to which it refers," 35 U.S.C. § 112 ¶ 4, Facebook is likewise aware of no basis for any contention of infringement of the asserted dependent claims 2, 4, 5, 7, 8, 10, 11, 12, 13, 14, 15, 16, 24, 25, 26, 29, 31, 32, 33 and 34 of the '761 patent. Moreover, the patent laws make clear that an invalid patent cannot be infringed and claims 1, 2, 4, 5, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 21, 23, 24, 25, 26, 29, 31, 32, 33 and 34 of the '761 patent are invalid under 35 U.S.C. § 101 for failing to recite statutory subject matter as required by *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (*en banc*). Therefore, none of claims 1, 2, 4, 5, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 21, 23, 24, 25, 26, 29, 31, 32, 33 or 34 of the '761 patent are infringed.

Facebook specifically reserves its right to further supplement its response to this interrogatory after Plaintiff identifies the basis, if any, for its allegations of infringement, its construction of the asserted claims, and the products Plaintiff is accusing of infringement.

**INTERROGATORY NO. 4:**

Describe in detail the complete factual basis for the Second Affirmative Defense pled in the Facebook Amended Answer that "each claim of the '761 patent is invalid for failure to meet one or more of the contentions of patentability specified in 35 U.S.C. §§ 101-103 and/or 112"

and identify the persons most knowledgeable about, and all documents and things relating to, such defense.

**FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 4:**

Facebook incorporates by reference its original General and specific Objections and Responses to Interrogatory No. 4, as well as its General Objections set forth above. Facebook further objects to this interrogatory on the grounds that it remains premature because LTI has not disclosed its infringement or claim construction contentions, nor has it provided information including, without limitation, the testimony of the inventors and all information and documents relating to the alleged conception and reduction to practice of the alleged invention claimed in the '761 patent, all which bear on the invalidity and unenforceability of the '761 patent.

Subject to and without waiving its objections, Facebook responds as follows: LTI has asserted Claims 1, 2, 4, 5, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 21, 23, 24, 25, 26, 29, 31, 32, 33 and 34 of the '761 patent. Claims 1, 2, 4, 5, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 21, 23, 24, 25, 26, 29, 31, 32, 33 and 34 of the '761 patent are invalid for failing to satisfy the conditions of patentability set forth in 35 U.S.C. §§ 101, 102, 103 and 112. Among other things, claims 1, 2, 4, 5, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 21, 23, 24, 25, 26, 29, 31, 32, 33 and 34 of the '761 patent are invalid under 35 U.S.C. § 101 for failing to recite statutory subject matter as required by *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (*en banc*). Claims 1, 2, 4, 5, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 21, 23, 24, 25, 26, 29, 31, 32, 33 and 34 of the '761 patent are also invalid because they lack novelty and/or are obviousness under 35 U.S.C. §§ 102, 103. The alleged invention of these claims is anticipated and/or rendered obvious in view of at least the following prior art:

- International Patent Application No. PCT/US2000/010066, published as WO/2000/06220, to Bruce E. Brown, et al. ("Brown 06220");
- U.S. Patent No. 5,930,801 to Brian C. Falkenhainer, et al.;
- U.S. Patent No. 6,584,466 to M. Michael Serbinis, et al.;
- U.S. Patent No. 7,062,532 to Mark Edward Sweat, et al.;
- U.S. Patent No. 6,289,460 to Mir Hamiragha;



- U.S. Patent No. 6,732,148 to Julio Estrada, et al.;
- U.S. Patent No. 6,161,146 to Victor B. Kley, et al.;
- U.S. Patent No. 7,366,990 to Satyan G. Pitroda;
- U.S. Patent No. 6,341,291 to Keith A. Bentley, et al.;
- U.S. Patent No. 5,826,265 to Gary Alan Van Huben, et al.;
- Paul Dourish, et al., *Presto: An Experimental Architecture for Fluid Interactive Document Spaces*, ACM Transactions on Computer-Human Interaction, Vol. 6, Issue 2, 133-61, Jun. 30, 1999.
- Paul Dourish, et al., *Extending Document Management Systems with User-Specific Active Properties*, ACM Transactions on Information Systems, Vol. 18, Issue 2, 140-70, Apr. 30, 2000.
- Marlon Pierce, et al., *Interoperable Web Services for Computational Portals*, Proceedings of the 2002 ACM/IEEE Conference on Supercomputing, Nov. 22, 2002.
- U.S. Patent No. 7,089,278 to Elizabeth F. Churchill, et al.; and
- U.S. Patent No. 7,437,312 to Rajesh Bhatia, et al.

Facebook's search for prior art is ongoing and Facebook reserves its right to further supplement its response to this interrogatory. Finally, claims 1, 2, 4, 5, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 21, 23, 24, 25, 26, 29, 31, 32, 33 and 34 of the '761 patent are also invalid under 35 U.S.C. § 112 ¶ 1 because the written description does not reflect that the inventors were in possession of the alleged invention, nor does it enable persons of ordinary skill in the art to make and use it without undue experimentation.

Facebook specifically reserves its right to further supplement its response to this interrogatory after Plaintiff identifies the basis, if any, for its allegations of infringement, its construction of the asserted claims, and the products Plaintiff is accusing of infringement.

**INTERROGATORY NO. 6:**

Describe in detail the complete factual basis for the Sixth Affirmative Defense pled in the Facebook Amended Answer that "prosecution history estoppel and/or prosecution disclaimer

precludes any finding of infringement” and identify the persons most knowledgeable about, and all documents and things relating to, such defense.

**FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 6:**

Facebook incorporates by reference its original General and specific Objections and Responses to Interrogatory No. 6, as well as its General Objections set forth above.

Subject to and without waiving its objections, Facebook responds as follows: The applicants for the '761 patent amended claims during prosecution in an attempt to overcome rejections by the Patent Office. See LTI 000427-695.

For example, on or about June 3, 2005, the United States Patent and Trademark Office (“USPTO”) rejected all claims of the '761 patent, as, among other things, anticipated by the prior art. The applicants cancelled, amended and made arguments attempting to distinguish the cited prior art from the proposed claims on or about November 3, 2005 to overcome those rejections. The USPTO issued a final rejection of all pending claims as obvious in light of the prior art on or about January 5, 2006. The applicants again cancelled, amended and made arguments attempting to distinguish the cited prior art from the proposed claims on or about May 5, 2006. On or about June 21, 2006 the applicants made a Request for Continued Examination in which they submitted additional amendments to overcome the prior art cited in the January 5, 2006 Final Rejection. The applicants also made arguments and discussed amendment of the proposed claims to overcome the prior art on or about August 15, 2006 via a interviews with the Examiner.

At least, the above arguments and amendments the applicants made to overcome the prior art will preclude Plaintiff from arguing certain claim constructions and equivalents under, *inter alia*, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U. S. 722 (2002). In light of the multiple amendments and arguments made by the applicants during prosecution of the '761 patent, and because Plaintiff has refused to provide the purported basis for its allegations of infringement and has refused to provide its claim construction contentions, a more precise identification of the precluded arguments cannot be provided at this time.

The persons most knowledgeable about Facebook’s Sixth Affirmative Defense include

LTI, Leader Technologies, LLC, all applicants and prosecuting attorneys involved with the prosecution of the '761 patent, Eric D. Jorgenson, Mike McKibben, Jeff Lamb, Eric Rosenberg, Brad Whiteman, Steve Hanna, Tim Fathbrucker, Andrea Gieg and Mark Astin and all others involved in the prosecution of the '761 patent. Documents supporting Facebook's Sixth Affirmative Defense include LTI 000427-695.

Facebook specifically reserves its right to further supplement its response to this interrogatory after Plaintiff identifies the basis, if any, for its allegations of infringement, its construction of the asserted claims 1, 2, 4, 5, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 21, 23, 24, 25, 26, 29, 31, 32, 33 and 34, the products Plaintiff is accusing of infringement or as otherwise needed.

**INTERROGATORY NO. 10:**

Describe in detail each type of product, activity, event or occurrence that generates revenue for Facebook, including but not limited to information relating to the first instances where such product, activity, event or occurrence generated revenue for Facebook.

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**FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 10:**

Facebook incorporates by reference its original General and specific Objections and Responses to Interrogatory No. 10, as well as its General Objections set forth above.

Subject to and without waiving the foregoing objections, Facebook responds that it generates revenue through the sales of advertising on facebook.com and use of its "Gifts" feature. Facebook first offered advertising on facebook.com in or about April 2004. Facebook first offered its "Gifts" feature in or about February 2007. Facebook specifically reserves its right to further supplement its response to this interrogatory after Plaintiff identifies the basis, if any, for its allegations of infringement, its construction of the asserted claims, and the products Plaintiff is accusing of infringement.

Dated: May 15, 2009

By: 

**OF COUNSEL:**

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*Attorneys for Defendant and  
Counterclaimant Facebook, Inc.*

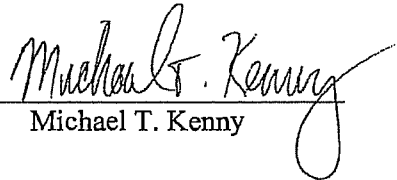
[Verification to Follow]

**CERTIFICATE OF SERVICE**

I hereby certify that on May 15, 2009 I caused to be served FACEBOOK, INC.'S FIRST SUPPLEMENTAL RESPONSES TO PLAINTIFF LEADER TECHNOLOGIES, INC.'S INTERROGATORIES NOS. 3, 4, 6, AND 10 by electronic mail and first class mail as follows:

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Michael T. Kenny

## **EXHIBIT L**

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UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

LEADER TECHNOLOGIES, INC : CIVIL ACTION NO.  
 : March 31, 2009  
Plaintiff, :  
 : 2:41 p.m.  
v. :  
 :  
FACEBOOK, INC :  
 :  
Defendant. :  
..... :

TRANSCRIPT OF SCHEDULING CONFERENCE  
BEFORE THE HONORABLE JOSEPH J. FARNAN, JR.  
UNITED STATES DISTRICT JUDGE

APPEARANCES:

For the Plaintiff: POTTER, ANDERSON & CORROON  
BY: PHILLIP A. ROVNER, ESQ.



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For the Defendant:

BLANK ROME, LLP.

STEVEN L. CAPONI, ESQ.

-and-

WHITE & CASE, LLP.

BY: HEIDI L. KEEFE, ESQ

Court Reporter:

LEONARD A. DIBBS

Official Court Reporter

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P R O C E E D I N G S

THE COURT: Good afternoon.

Do you want to announce your appearances and case?

MR. ROVNER: Phil Rovner from Potter, Anderson &  
Corroon.

Good afternoon, your Honor, representing the plaintiff,  
Leader Technologies.

This is Leader Technologies versus Facebook.

MR. CAPONI: Good afternoon, Steve Caponi from Blank  
Rome, and with me is Heidi Keefe of White & Case for Facebook,  
the defendant.

THE COURT: Good afternoon.

I wanted to get you over because I got correspondence  
from both sides about why you couldn't get a Scheduling Order  
together.

And I understand that there are discovery -- alleged  
deficiencies. And I understand that there are start-up issues  
between the two sides.

But not to be able to get an Scheduling Order submitted  
shouldn't have as a reason that those things were occurring  
between you. It's unacceptable.

So what I thought I would do is get you here, have you  
put together a bare-bones Scheduling Order in front of me. That  
way I can resolve any of those disputes. Then if you continue

1 to have issues going back and forth, you can notice something  
2 for the Motion Day and we'll take it up.

3 It sounds like even that in the initial stages if you  
4 are having these kind of very elementary disagreements that we  
5 might have to do something more than -- I have a case now. I've  
6 never seen anything like it in the 25 years. There are over a  
7 120 motions in the case. It's just crazy.

8 Good news. I'm using it for a lecture. I'm keeping  
9 all the papers and silliness of e-mails. I'm going to make  
10 something positive out of it. You two shouldn't be having these  
11 problems.

12 When do you want to go to trial?

13 MR. ROVNER: Both parties agreed that the June 2010  
14 trial date that you set is what we want, since you ordered it.  
15 It's good that we want it. The problem seems to be on some  
16 discovery deadlines.

17 THE COURT: I'm not going to get into that.

18 MR. ROVNER: Okay.

19 THE COURT: We're going to trial in June 2010.

20 When are we going to have cutoff of factual discovery?

21 I've seen what you proposed. I'm going through the  
22 exercise here. When are we cutting off factual discovery?

23 MR. ROVNER: We believe July, August time frame as we  
24 have in the order.

25 MR. CAPONI: Later in the year. We're looking at

1       October, November. The issue from our standpoint -- not to get  
2       into the discovery dispute. It really comes down to -- we don't  
3       -- we do know the size. As it stands right now.

4               THE COURT: I remember the whole issue.

5               MR. CAPONI: We're looking at the entire --

6               THE COURT: They said it's your entire platform.

7               MR. CAPONI: Like November. Unless it narrows, we're  
8       getting a lot of third party discovery.

9               THE COURT: We'll make it November.

10              To address that issue, discovery will cutoff -- pick a  
11       date in November 2009.

12              And when we will have the need after that fact  
13       discovery for an a Markman hearing? Probably in December or  
14       January.

15              MR. CAPONI: Yes, your Honor.

16              MR. ROVNER: We believe it should be in October. We  
17       think the Markman Hearing can be done before the fact discovery.

18              THE COURT: You're going to be arguing so much before  
19       then, you won't have time to do the briefing and all. I can  
20       tell there are going to be a lot of arguments here. Unless this  
21       case gets narrowed down tremendously, we'll have the Markman  
22       Hearing in January of 2010.

23              Now, assuming this is going to be an easy Markman  
24       Hearing having a taken a look at the patent. This is like, two  
25       guys in a dorm room.

1           MR. CAPONI: I don't think this is going to be  
2 astrophysics here.

3           THE COURT: It's not going to tax my chemical  
4 background or biological background, two guys in a Harvard dorm.  
5 How hard can it be?

6           So, we're going to have a quick Markman decision, which  
7 means your expert reports -- so that we're ready for the June  
8 trial -- are going to be due, and your depositions completed by  
9 mid-April of 2010. That will give us time to have a hearing,  
10 get you a Memorandum Order on the constructions and give you a  
11 chance to designate and then exchange with the Court, take your  
12 depositions.

13           It doesn't look like the case lends itself to Summary  
14 Judgment since I've been certified as the least granting Summary  
15 Judgment judge in the country on patent cases. I'm going to say  
16 you can file Summary Judgment motions by May 1.

17           Don't be surprised if you get an order back and the  
18 client says that's all he did because this transcript will be  
19 out there in the world recognizing that it will be almost  
20 impossible in this case not to have a general issue of material  
21 fact or some other bar to the grant of Summary Judgment. At  
22 least being a deferral of it until some additional evidence is  
23 heard, which means we ought to have a pretrial conference in the  
24 first week in June contemplating a late June trial date.

25           So that first week of June, let's just the Wednesday or

1 the Thursday. That will be the pretrial. Your outside counsel  
2 are coming from where?

3 MS. KEEFE: California.

4 THE COURT: Mr. Rovner?

5 MR. ROVNER: Paul Andre is coming from California.

6 THE COURT: It's better to get you hear the night  
7 before to have the 10 o'clock in the morning and have you get  
8 out of Philadelphia.

9 MS. KEEFE: That is better for us, your Honor.

10 MR. ROVNER: One thing, you had set a trial date for  
11 June 7th.

12 THE COURT: We're going to move that a tiny bit. I did  
13 that thinking that I was going to go with the August, September  
14 kind of date. Since I pushed it out, I have to push out some  
15 other date. We'll do it at the end of June.

16 June the 3rd will be the pretrial or the second. It  
17 doesn't matter, I guess.

18 MS. KEEFE: Either one, your Honor.

19 THE COURT: We'll do it at 10 o'clock in the morning so  
20 we can contemplate those flights.

21 We'll start the trial on June the 28th of 2010, 9:30  
22 a.m.

23 MS. KEEFE: Thank you, your Honor.

24 MR. ROVNER: Sorry to keep passing questions.

25 You said the Markman would be June 2010.

1 Do you want to set a date now?

2 THE COURT: We can do that.

3 MR. ROVNER: I'm on a roll.

4 THE COURT: We can do that Markman Hearing. It could be  
5 either January 19 or 20th. That's a Tuesday or Wednesday. That  
6 way you don't have to fly out on a Sunday.

7 MR. CAPONI: We'll go the Wednesday, your Honor.

8 MR. ROVNER: I don't have any preference.

9 THE COURT: Okay. 10 o'clock on January 20th. That's  
10 a Wednesday, at 2010.

11 MS. KEEFFE: Thank you, your Honor.

12 MR. ROVNER: Thank you.

13 THE COURT: Okay. I'll expect to get that order pretty  
14 quickly and we'll get the filed. Then you can continue your  
15 arguments.

16 I'll probably see you in May. Work them out. I'm not  
17 going to use this as one of my abuse showing cases.

18 If you are really not getting along to the point of  
19 reasonableness, what's going to happen? Your favorite thing,  
20 Mr. Rovner, your special thing. You might be going to a Special  
21 Master.

22 MR. ROVNER: I didn't want to suggest it.

23 THE COURT: You're going to go to a Special Master.  
24 I'm trying to get prepared for two pretty large trials.

25 I haven't heard an announcement yet as of March 31st of

1 who the new judge is going to be. This thing is probably put  
2 off until late summer or early fall. We're going to be carrying  
3 90, 95 patent cases. You can't be meaningful and do your bench  
4 trials decisions and patents and keep them going and try to stay  
5 within a window of two years for trial.

6 Your conduct will dictate whether or not you go to a  
7 Special Master after I see your first round of arguments.

8 MR. CAPONI: Your honor, for both sides, we actually  
9 get along. The happens to be the first issue that we disagree  
10 with the most. Once we get past that hurdle, hopefully the  
11 waters won't be too choppy.

12 THE COURT: I'm looking forward to it, Mr. Caponi.

13 Mr. Rovner, is there anything you want to add.

14 MR. ROVNER: We'll be fine. We'll have a Protective  
15 Order agreed upon and get it to you. I'm curious about the case  
16 that you are going to use as an example. I hope I'm not in that  
17 one. I might be.

18 (A discussion was held off the record.)

19 THE COURT: All right it. Thank you very much.

20 (At this time court proceedings concluded.)

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23

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# EXHIBIT M



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11:37:12 1 open. Tied in from his opposition letter was that these are  
 11:37:18 2 all the facts they have. And therefore I would assume that  
 11:37:20 3 in his supplementation he would remove the "on information  
 11:37:26 4 and belief," because these are the only facts that he has  
 11:37:32 5 right now and this is all there is. So it is not an  
 11:37:38 6 open-ended thing. This is what he has as of right now.  
 11:37:44 7 We know if something else comes up somewhere  
 11:37:50 8 down the line, he can always move to amend those responses.  
 11:37:56 9 But as of right now, the responses need to be clear and  
 11:38:02 10 complete and not simply information and belief, because that  
 11:38:08 11 is not appropriate. That's why if we could incorporate it  
 11:38:14 12 in the opposition, since they said this is all I have, that  
 11:38:20 13 was the fight.  
 11:38:26 14 THE COURT: Mr. Andre, I understood that is what  
 11:38:32 15 you would be offering to do. That is, that you have  
 11:38:38 16 provided the full basis of what you know today, prior to  
 11:38:44 17 getting discovery on willful infringement, you have provided  
 11:38:50 18 everything that you know about the basis for your willful  
 11:38:56 19 infringement claim, and you reserve the right to supplement  
 11:39:02 20 to the extent you find something else in discovery.  
 11:39:08 21 Did I get your position correct, Mr. Andre?  
 11:39:14 22 MR. ANDRE: You did, Your Honor.  
 11:39:20 23 THE COURT: Ms. Keefe, that's what you are  
 11:39:26 24 looking for?  
 11:39:32 25 MS. KEEFE: I think it is. I think the only

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11:39:38 1 thing I would also note, Your Honor, is that I would like to  
 11:39:44 2 simply reserve the right to move for a commensurate stay if  
 11:39:50 3 I move for summary judgment of non-willfulness based on the  
 11:39:56 4 facts in the record. That can happen at a later time.  
 11:40:02 5 THE COURT: That is not a matter that is  
 11:40:08 6 actually in dispute today.  
 11:40:14 7 MS. KEEFE: Correct.  
 11:40:20 8 THE COURT: Any problem with the mechanism that  
 11:40:26 9 I give Mr. Andre till next Wednesday to formally supplement  
 11:40:32 10 his response with the contents of the letter?  
 11:40:38 11 MS. KEEFE: No, Your Honor.  
 11:40:44 12 THE COURT: Any problem with that from your end,  
 11:40:50 13 Mr. Andre?  
 11:40:56 14 MR. ANDRE: No, Your Honor. Thank you.  
 11:41:02 15 THE COURT: I believe that takes care in full of  
 11:41:08 16 Facebook's issue. Is that right, Ms. Keefe?  
 11:41:14 17 MS. KEEFE: I believe, Your Honor.  
 11:41:20 18 THE COURT: Fine. I appreciate you flagging  
 11:41:26 19 that way of dealing with it for me.  
 11:41:32 20 Let's move on, then, to Leader's various  
 11:41:38 21 complaints about Facebook's compliance with the Court's  
 11:41:44 22 September 4th order. Let me hear first from Leader on  
 11:41:50 23 this one.  
 11:41:56 24 MR. ANDRE: Your Honor, James Hannah will be  
 11:42:02 25 talking about the technical documents in this matter.

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11:39:42 1 MR. HANNAH: Your Honor, James Hannah  
 11:39:48 2 representing Leader. Good morning.  
 11:39:54 3 Simply, we are just asking for Facebook to  
 11:39:59 4 provide a complete response and all the technical documents  
 11:40:05 5 that it has that we have identified the source code modules  
 11:40:11 6 for. As Your Honor remembers, we were asked to identify  
 11:40:17 7 source code modules for which we sought technical documents,  
 11:40:23 8 for which we found infringing technology. We identified  
 11:40:29 9 those documents — we identified those source code modules  
 11:40:35 10 to Facebook, and Facebook, in turn, produced approximately  
 11:40:41 11 4,000 pages, most of those, 3900 of them were public  
 11:40:47 12 documents. Of that we have got about 400 pages which were a  
 11:40:53 13 screen shot of a wicking. We do not have any e-mails, which  
 11:40:59 14 Facebook has refused to produce. We do not have any design  
 11:41:05 15 documents. We don't have any development documents. All of  
 11:41:11 16 these documents are highly relevant to our case.  
 11:41:17 17 For instance, the e-mails and the design  
 11:41:23 18 developments documents, the development documents will  
 11:41:29 19 provide information as to when there were product changes,  
 11:41:35 20 and we can see when different functionality was implemented  
 11:41:41 21 by Facebook. It will provide info as to how employees  
 11:41:47 22 characterized the operation and functionality of the site.  
 11:41:53 23 It will provide information on how the system operates, so  
 11:41:59 24 we have an idea about how each application interacts with  
 11:42:05 25 the source code modules. We can look at the source code

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11:42:11 1 itself.  
 11:42:17 2 But seeing the e-mails, the design documents,  
 11:42:23 3 the development documents, and how the source code modules  
 11:42:29 4 operate gives us a full picture of the Facebook website and  
 11:42:35 5 what's been accused of infringement.  
 11:42:41 6 The list goes on and on, Your Honor. It gives  
 11:42:47 7 you insight as to how the employees use the site and how  
 11:42:53 8 Facebook instructs the employees to use the site. It gives  
 11:42:59 9 us insight to see how Facebook instructs its users to use  
 11:43:05 10 the site, because we do not see any technical manuals in  
 11:43:11 11 there, we do not see any instructions, any troubleshooting  
 11:43:17 12 guides.  
 11:43:23 13 The e-mails will allow us to also narrow and  
 11:43:29 14 focus our discovery in depositions. If we don't have any  
 11:43:35 15 e-mail communications and if we don't have any design  
 11:43:41 16 documents, development documents, we are shooting in the  
 11:43:47 17 dark. We don't know exactly the engineers that we need to  
 11:43:53 18 depose to ask about the infringing technology, the  
 11:43:59 19 infringing source code modules. So it's putting Leader in a  
 11:44:05 20 very difficult situation, not having these technical  
 11:44:11 21 documents.  
 11:44:17 22 THE COURT: All right. Well, I appreciate that  
 11:44:23 23 you have come up with a list of the potential relevance of  
 11:44:29 24 the e-mails. But I got to tell you, none of that sounds  
 11:44:35 25 like it's particularly relevant where the issue is a

11:42:16 1 straightforward question of infringement and you now have  
 11:42:50 2 full access to the entire source code. I do agree with  
 11:43:58 3 Facebook that there has to be some balancing here in light  
 12 4 of the circuit that got us to where we are and to where we  
 .06 5 are in the case schedule. So you are welcome to take  
 11:43:32 6 another shot. But particularly address the representation  
 11:43:16 7 that there would be a significant burden of many months and  
 11:43:20 8 330 employees that would have to have their e-mails  
 11:43:24 9 reviewed. How could that balance possibly weigh in your  
 11:43:28 10 favor when you have been given free access to the full  
 11:43:32 11 source code, which is, after all, the alleged infringing  
 11:43:34 12 product?

11:43:36 13 MR. HANNAH: Your Honor, I mean, we believe that  
 11:43:38 14 Facebook should have already searched their e-mails for the  
 11:43:44 15 relevant e-mails. We believe that saying that they have to  
 11:43:50 16 search now for the e-mails is disingenuous of them. To  
 11:43:54 17 address the particular aspects about the infringing  
 11:43:58 18 technology, we need the e-mails to examine the development  
 11:44:02 19 and design documents to know exactly when the infringement  
 11:44:06 20 began.

11:44:08 21 The source code that we were able to look at was  
 11:44:10 22 a snapshot from about July 2009. So we have no idea how the  
 11:44:18 23 Facebook site operated when the patent issued, for instance,  
 11:44:22 24 in 2006. We have no idea what changes were made from 2006  
 11:44:28 25 to 2007 to the present day. And the only way we are going

11:44:32 1 to be able to have that information is if we have the  
 11:44:36 2 development documents, the design documents, the e-mails  
 11:44:42 3 from Facebook.

11:44:42 4 THE COURT: If I require Facebook to identify  
 11:44:46 5 the most relevant engineers for depositions, to the extent  
 11:44:50 6 they haven't done that already, why can't you just simply  
 11:44:54 7 ask those questions in deposition?

11:44:58 8 MR. HANNAH: Well, during deposition we would  
 11:45:00 9 like to have the e-mails and the technical documents so that  
 11:45:04 10 we can see what their role is. I mean, I have a feeling  
 11:45:08 11 that if you order that, Your Honor, and we do not have the  
 11:45:12 12 e-mails, we are still going to be shooting in the dark as to  
 11:45:16 13 what their role is.

11:45:18 14 Furthermore, we have a limited amount of  
 11:45:20 15 depositions in this case. So if they give us a list of 30  
 11:45:24 16 engineers working on a particular aspect or application,  
 11:45:28 17 then we are not going to be able to focus in on the people  
 11:45:34 18 that are going to be relevant and questions that we need to  
 11:45:38 19 ask,

11:45:38 20 THE COURT: That is a problem I can take care  
 21 of. If that's what they do and it turns out you need 40  
 11:45:44 22 engineering depositions and you can make that showing, I am  
 11:45:48 23 open to that possibility.

11:45:48 24 The definition of "technical document" that you  
 11:45:58 25 included did not specify, as I read it, e-mails, nor do I

11:46:04 1 recall any reference to e-mails when we were discussing  
 11:46:08 2 thoroughly the issue of what technical documents you are  
 11:46:12 3 looking for. In that context, why should I not accept the  
 11:46:16 4 representation of Facebook that the first time they had any  
 11:46:20 5 thought that you were looking for e-mails relating to  
 11:46:24 6 technical issues was quite recently?

11:46:28 7 MR. HANNAH: Your Honor, this comes back to our  
 11:46:30 8 requests for production, which were served on Facebook on  
 11:46:32 9 February 20th of this year, of 2009. Those RFPs all ask for  
 11:46:40 10 all documents and communications relating to the  
 11:46:42 11 functionality of the Facebook website. In particular, there  
 11:46:46 12 is an RFP 26 that asks for all schematics. It asks for all  
 11:46:54 13 flowcharts. It asks for all diagrams.

11:46:56 14 Furthermore, the definition of documentation  
 11:47:00 15 that we have in the RFPs says, and I am quoting, "The term  
 11:47:06 16 'document' shall mean all writings and recordings as those  
 11:47:10 17 terms are defined..." and it goes on to say including  
 11:47:12 18 e-mail.

11:47:12 19 So they have had notice from eight months ago  
 11:47:16 20 that we wanted e-mails, we wanted all technical documents.  
 11:47:20 21 And we just really haven't anything in eight months. Now we  
 11:47:24 22 have 30 days left in discovery, and they still haven't  
 11:47:28 23 fulfilled their obligations under the Federal Rules of Civil  
 11:47:32 24 Procedure.

11:47:32 25 THE COURT: What about their argument that you

11:47:32 1 go on to define technical documents as a subset of documents  
 11:47:38 2 and there you list a number of things, starting with source  
 11:47:40 3 code, and you don't mention e-mails?

11:47:46 4 MR. HANNAH: Your Honor, if you look at our  
 11:47:52 5 RFPs, it states that we asked for all documents and  
 11:47:54 6 communications. We have documents defined as including  
 11:47:58 7 e-mails. Communications is also defined as including  
 11:48:00 8 e-mail.

11:48:02 9 For instance, RFP 26, if you look at that one,  
 11:48:08 10 it never says that we want all technical documents relating  
 11:48:10 11 to the research, design, implementation, development,  
 11:48:14 12 engineering, programming, structure, performance or  
 11:48:18 13 operation of the Facebook website. Those are all documents,  
 11:48:22 14 communications, which is defined to include e-mails.

11:48:24 15 They have had notice of this for a long time  
 11:48:26 16 now. For them to say that they haven't searched any of  
 11:48:30 17 their e-mails -- I mean, they haven't even searched the  
 11:48:34 18 e-mails for the patent number, apparently, which is highly  
 11:48:38 19 relevant to this case and should have been produced months  
 11:48:40 20 ago. Even the words Leader Technologies wasn't searched for  
 11:48:44 21 in the e-mails, which is another highly relevant term that  
 11:48:48 22 should have been produced months ago.

11:48:50 23 MS. KEEFE: Your Honor, I am absolutely sorry to  
 11:48:52 24 interject.

11:48:52 25 That is absolutely untrue. We absolutely have

11:48:54 1 searched the e-mails for the term Leader. Leader  
 11:48:58 2 Technologies, McKibben, Lamb, white paper, anything that was  
 11:49:02 3 an early thing that had to do with the patent and the patent  
 11:49:06 4 numbers. We have absolutely done that, and in anticipation  
 11:49:08 5 of this call actually had the search repeated again  
 11:49:10 6 yesterday. I am sorry to interject there. But that was an  
 11:49:16 7 absolute untruth that I wanted to clear up.  
 11:49:16 8 THE COURT: Mr. Hannah, what is your basis for  
 11:49:20 9 advising me that those circumstances have not happened?  
 11:49:22 10 MR. HANNAH: During the meet-and-confer, you can  
 11:49:26 11 look at the correspondence that was between the two, they  
 11:49:28 12 stated that they have not searched in their e-mail and that  
 11:49:32 13 they will not search through their e-mails. I am basing  
 11:49:34 14 this off the representation of Facebook.  
 11:49:36 15 THE COURT: Ms. Keefe, I will turn to you  
 11:49:38 16 momentarily.  
 11:49:40 17 One further thing, Mr. Hannah: Do you have a  
 11:48:44 18 basis to dispute the contention of Facebook at this point,  
 11:49:52 19 putting aside whether they should have looked more, whether  
 11:49:54 20 they have looked; that it would take them months to do what  
 11:49:58 21 you are asking them to do going forward, and if I have to  
 11:50:02 22 weigh that burden today versus what seems to me the  
 11:50:08 23 relatively low relevance, how could I find that that  
 11:50:12 24 weighing comes out in your favor?  
 11:50:14 25 MR. HANNAH: Well, Your Honor, the source code

11:50:16 1 modules that we have identified pursuant to your order was  
 11:50:22 2 only about ten percent of the source code modules. So I do  
 11:50:24 3 not believe that there is a huge burden, that they are going  
 11:50:28 4 to have to produce a lot of e-mail, because we have  
 11:50:32 5 identified a limited amount of the source code modules.  
 11:50:36 6 Furthermore, they have told us that the technical documents  
 11:50:38 7 was limited in nature.  
 11:50:40 8 So based on those representations from Facebook,  
 11:50:44 9 I do not see how it can take many months, as they have  
 11:50:46 10 stated. I believe we would be able to get a reasonable  
 11:50:50 11 production of the technical documents in a fairly short  
 11:50:54 12 amount of time.  
 11:50:54 13 THE COURT: All right. Let me turn it to Ms.  
 11:50:58 14 Keefe to talk about technical documents just on that issue.  
 11:51:00 15 MS. KEEFE: On the specific issue that Mr.  
 11:51:02 16 Hannah just discussed, the burden would be tremendous. The  
 11:51:06 17 200 files that they listed in their narrowed search, as they  
 11:51:10 18 claim it's narrowed, literally touches the entire site. I  
 11:51:16 19 would ask Mr. Hannah to let me know which portions of the  
 11:51:20 20 site are actually excluded from that identification. As we  
 11:51:28 21 have told Mr. Hannah, those 200 files, because of the ones  
 11:51:28 22 they chose, touch almost every single aspect of the entire  
 11:51:30 23 site. We have told him that that would involve at least 300  
 11:51:34 24 people. The 300 people that we identified in trying to  
 11:51:38 25 figure out how we would have to do this search we limited

11:51:42 1 down to people who actually affected those PHC files, not  
 11:51:46 2 people who may have talked about them or may have done  
 11:51:48 3 something else. This is essentially, Facebook is a one  
 11:51:52 4 large web single product.  
 11:51:52 5 So if we are talking about e-mails about  
 11:51:56 6 Facebook, that's all these people do all day every day. And  
 11:52:00 7 that search would be incredibly complicated and burdensome,  
 11:52:04 8 as Your Honor has noted.  
 11:52:04 9 The only other thing I would like to add is that  
 11:52:08 10 we absolutely have searched e-mails for narrowly tailored  
 11:52:12 11 things that we were able to identify, for example, the  
 11:52:16 12 patent number, the Leader Technologies, the names of the  
 11:52:20 13 inventors, the names of their products, anything of that  
 11:52:22 14 nature. What we said during the meet-and-confer was we had  
 11:52:24 15 not conducted technical searches or searches based on things  
 11:52:30 16 that we couldn't understand or figure out, because they  
 11:52:32 17 refused to narrow what they were asking us to search  
 11:52:34 18 throughout the e-mail database.  
 11:52:38 19 I think Your Honor understands the rest of it  
 11:52:40 20 well.  
 11:52:40 21 THE COURT: Let me just ask you, the concern  
 11:52:44 22 that Leader is not going to be able to efficiently identify  
 11:52:50 23 which engineering witnesses it should depose and is not  
 11:52:52 24 going to be able to efficiently depose them without some  
 11:52:58 25 further production of technical documents, including

11:53:02 1 e-mails, respond to that concern, please.  
 11:53:04 2 MS. KEEFE: I think there are three separate  
 11:53:06 3 answers to that, Your Honor. The first is that we  
 11:53:08 4 understand our obligation under Rule 26 to identify  
 11:53:10 5 witnesses that we are going to use to support our case.  
 11:53:14 6 That will be one way of helping them.  
 11:53:16 7 Secondly, they actually have already  
 11:53:18 8 identified a number of engineers that they specifically want  
 11:53:22 9 to have documents from. They were able to identify those  
 11:53:26 10 from the documents that were produced already. Those came  
 11:53:28 11 up in their requests for production on October 20th. There  
 11:53:32 12 were requests for production limited to those individuals.  
 11:53:34 13 And then finally, Your Honor, this is exactly  
 11:53:36 14 what a 30(b)(6) is used for. They can give us a 30(b)(6)  
 11:53:42 15 topic that asks us to identify those persons. We will put  
 11:53:46 16 up a witness who identifies those persons, and they can  
 11:53:48 17 notify us which of those persons they would like to depose.  
 11:53:52 18 If Your Honor needs to extended beyond the ten  
 11:53:54 19 number, that is obviously something that we will deal with.  
 11:53:58 20 THE COURT: Okay. Mr. Hannah, any response?  
 11:54:00 21 MR. ANDRE: Your Honor, I would like to jump in  
 11:54:04 22 real quick.  
 11:54:06 23 My concern is -- and I have been listening to  
 11:54:08 24 this -- is that Facebook has effectively denied any type of  
 11:54:14 25 discovery to us. They produced 398 pages of technical

11:54:18 1 documents. I have been doing this a long time. I have seen  
 11:54:22 2 a lot of different patent cases involving this technology.  
 11:54:24 3 I have never seen such a small production of technical  
 11:54:30 4 documents.

11:54:34 5 My guess is, on the e-mail side, they have not  
 11:54:38 6 done anything to search for technical documents that would  
 11:54:44 7 normally happen in the course of this type of litigation.

11:54:40 8 When we start taking these depositions, my guess is that the  
 11:54:44 9 engineers are going to start identifying a lot of documents  
 11:54:46 10 that they have that they used that we do not have access to.

11:54:50 11 The only thing we have at this point other than  
 11:54:52 12 the 390 pages is the source code. We can't use the source  
 11:54:54 13 code in deposition. We are lawyers. We are not technical  
 11:54:58 14 experts.

11:55:00 15 So it is something that puts us at a huge  
 11:55:04 16 disadvantage by them just, you know, not fulfilling their  
 11:55:06 17 obligations under the Federal Rules.

11:55:08 18 E-mails, as Your Honor knows, are required to be  
 11:55:12 19 produced. They are relevant documents under the Federal  
 11:55:16 20 Rules of Civil Procedure. Just because they haven't done it  
 11:55:20 21 in the last eight months and it will be a burden on them to  
 11:55:22 22 do it now, it seems to be prejudicial to us. We produced  
 11:55:24 23 our e-mails. It was a burden. But that's what the rulings  
 11:55:28 24 call for.

11:55:28 25 I am more concerned with the technical documents

11:55:32 1 than the e-mails, given search terms for e-mails, to run a  
 11:55:36 2 search five or ten times. But the technical documents I  
 11:55:40 3 have a huge concern with, because we have to identify some  
 11:55:42 4 of the engineers based on 398 pages, but I don't know how  
 11:55:46 5 many more there are out there that we should be looking at.  
 11:55:50 6 That is my big issue.

11:55:50 7 THE COURT: But what is it that is in the record  
 11:55:54 8 other than your prior experience in other cases with other  
 11:55:56 9 types of companies that should cause me to doubt the  
 11:56:00 10 repeated representations from Facebook that they have  
 11:56:02 11 provided the responsive technical documents, send you off to  
 11:56:06 12 do your depositions? If you find there is more, that would  
 11:56:10 13 show that Facebook didn't comply with its discovery  
 11:56:14 14 obligations, they are going to have to produce them then,  
 11:56:18 15 and maybe you will be moving for sanctions. I don't know.

11:56:20 16 What do you have today that should cause me,  
 11:56:22 17 other than your past experience, to believe that they are  
 11:56:26 18 not being forthcoming when they insist that they are?

11:56:28 19 MR. ANDRE: The declarations provided by the  
 11:56:32 20 attorney, the search method they used, they really just  
 11:56:34 21 looked at the wicking. It is something --- these cases come  
 11:56:40 22 along, you generally talk to the engineers who work on this.  
 11:56:42 23 You then have e-mails to the company, saying do you have  
 11:56:46 24 relevant documents? What are your design documents?

11:56:48 25 They had in-house attorneys and outside counsel

11:56:52 1 do searches, that is about it. That declaration was not  
 11:56:54 2 what I would call going to the level needed to produce  
 11:56:58 3 documents in this type of case.

11:57:00 4 As far as e-mail goes, they didn't try to search  
 11:57:04 5 for technical documents. I mean, I wish e-mails were not  
 11:57:08 6 part of discovery, I really do, because they are the biggest  
 11:57:10 7 pain in discovery in these types of cases.

11:57:14 8 But that is not the rules at this point.  
 11:57:14 9 E-mails are part of the documents that you have to collect.  
 11:57:18 10 And there was no agreement between the parties that e-mails  
 11:57:20 11 would not be collected.

11:57:22 12 So at this point, we are being prejudiced  
 11:57:26 13 because we spent the hours, hundreds of attorney hours  
 11:57:30 14 reviewing e-mails, producing them, and they didn't try,  
 11:57:34 15 other than the fact they didn't even try to look at for  
 11:57:40 16 technical information in the e-mails, but then their  
 11:57:42 17 declaration was such that they have outside counsel do the  
 11:57:46 18 search.

11:57:46 19 Other than my own experience, that is what I  
 11:57:50 20 rely on.

11:57:50 21 THE COURT: I am prepared to rule on this. I am  
 11:57:58 22 denying Leader's request for production of further technical  
 11:58:04 23 documents. I believe, considering the fact that we have had  
 11:58:08 24 extensive discussions and analysis of what technical  
 11:58:14 25 documents and what access to source code Facebook was going

11:58:18 1 to have to provide, given how we got here, given that that  
 11:58:22 2 access to the entire source code has been provided and that  
 11:58:26 3 there can be no better discovery for plaintiff in trying to  
 11:58:30 4 prove infringement in a case like this than to have the  
 11:58:34 5 access to the source code, and mindful of the fact that  
 11:58:38 6 plaintiff's expert indicated in a declaration that he needed  
 11:58:42 7 full access to the source code, along with technical  
 11:58:46 8 documents in order to make a meaningful discovery of the  
 11:58:50 9 source code, and that I thereafter ordered that to happen,  
 11:59:02 10 and that that happened, I am satisfied at this point,  
 11:59:06 11 weighing what I find to be the likely very minimal relevance  
 11:59:10 12 of additional documents from Facebook, technical documents,  
 11:59:14 13 that is, and particularly the very minimal relevance of any  
 11:59:18 14 e-mails. Weighing that against the burden that I believe  
 11:59:22 15 would be imposed if Facebook were required to do anything  
 11:59:26 16 more than the searches that it has already indicated it has  
 11:59:30 17 done for e-mails, particularly by searching for keywords on  
 11:59:34 18 the most relevant keywords related to this case, that  
 11:59:38 19 balance favors, in my view quite strongly, Facebook at this  
 11:59:42 20 point in this case.

11:59:44 21 I am mindful that depositions will be starting I  
 11:59:48 22 think about three or four weeks from now that will include  
 12:00:02 23 30(b)(6) depositions. I agree with Facebook that Leader can  
 12:00:06 24 designate some of these topics on 30(b)(6). They can get  
 12:00:10 25 their answers and you can depose engineers and ask them if

12:00:16 1 there are other documents. If it turns out that Facebook  
 12:00:22 2 has not actually been sufficiently forthcoming with its  
 12:00:26 3 production of technical documents, then we will deal with  
 30 4 that when you are able to show that to me. But at this  
 4 5 point I accept the representations, and I find that Facebook  
 12:00:36 6 has done enough with respect to production of technical  
 12:00:40 7 documents. And I am not going to order them to do anything  
 12:00:42 8 more in that regard.  
 12:00:44 9 Let's move on to, I think Leader is next,  
 12:00:48 10 raising an issue about the sufficiency of the production of  
 12:00:50 11 marketing and financial documents.  
 12:00:54 12 MR. ANDRE: Your Honor, we just wanted to follow  
 12:01:00 13 up on this issue, the fact that Facebook has not given us  
 12:01:04 14 any type of date certain as to when they would produce  
 12:01:08 15 these marketing and financial documents. They keep saying  
 12:01:12 16 we are going to produce, we are going to produce, we will do  
 12:01:16 17 it before November 20th, but they don't give us any set  
 12:01:20 18 time. Holding out to the 11th hour is an issue for us.  
 12:01:24 19 They have not given us firm representations, or given us  
 12:01:28 20 business plans or any type of market information,  
 12:01:32 21 advertising, things of that nature.  
 12:01:34 22 What we are asking for, what we asked previously  
 12:01:36 23 is give us a date certain and we won't have to go to court,  
 12:01:40 24 because you have been stalling for months. And they won't  
 12:01:42 25 give us a date certain. That's why we are moving on the

12:02:50 1 being the date certain, since you are not deposing anyone  
 12:02:56 2 until at least November 21?  
 12:02:58 3 MR. ANDRE: We are concerned with a huge  
 12:03:02 4 document dump on the last day of written discovery, the last  
 12:03:04 5 day they can produce documents. We are mindful that we may  
 12:03:08 6 get hundreds of thousands of documents at the last hour.  
 12:03:12 7 THE COURT: Didn't I give you until March 1st to  
 12:03:14 8 complete depositions of fact witnesses?  
 12:03:16 9 MR. ANDRE: You did, Your Honor.  
 12:03:18 10 THE COURT: I don't understand how, even if they  
 12:03:20 11 are waiting to dump all that on you on November 20th, you  
 12:03:24 12 are going to be unduly prejudiced to complete your  
 12:03:26 13 depositions by March 1st.  
 12:03:30 14 MR. ANDRE: Your Honor, I don't know if it would  
 12:03:32 15 be unduly prejudicial. It is just prejudicial in the fact,  
 12:03:36 16 they haven't even produced 2008 yet at this point. There is  
 12:03:40 17 no reason why they are withholding these documents. I  
 12:03:44 18 understand we have discovery cutoffs for a reason. We have  
 12:03:48 19 asked for Facebook to actually produce documents in a timely  
 12:03:52 20 manner.  
 12:03:52 21 At this point, we are not getting any of the  
 12:03:56 22 financial documents, either. That is the reason we wanted  
 12:04:00 23 to see if Your Honor would give us a date certain as to when  
 12:04:02 24 they should start the production of at least the 2008  
 12:04:06 25 documents.

12:01:46 1 marketing and financial documents.  
 12:01:48 2 THE COURT: Facebook.  
 12:01:48 3 MS. KEEFE: The most interesting thing on the  
 12:01:50 4 financial documents is we have actually given them, the  
 12:01:54 5 document we produced on September 20th was a spread sheet,  
 12:01:56 6 which was sufficient to show all of the financials for the  
 12:02:00 7 company. I am not sure what more they want on that, unless  
 12:02:04 8 they want me to produce all of the canceled checks and  
 12:02:06 9 everything that goes into that.  
 12:02:10 10 They actually have documents sufficient to show  
 12:02:12 11 full financials. If they need something else, I would like  
 12:02:16 12 them to tell me exactly what it is.  
 12:02:16 13 On the marketing and other types of documents, I  
 12:02:20 14 am not sure that I completely understand which ones they  
 12:02:22 15 want and how they want them, but I have never refused to  
 12:02:26 16 produce them. I have been checking, and they will have them  
 12:02:28 17 by the end of discovery, which is no prejudice to anyone  
 12:02:32 18 because depositions don't even start until the end of  
 12:02:36 19 November/beginning of December. They will have all the  
 12:02:38 20 documents before then.  
 12:02:40 21 THE COURT: So the date certain is November 20  
 12:02:42 22 and you will do your best to provide documents sooner on a  
 12:02:44 23 rolling basis as you have been doing.  
 12:02:46 24 MS. KEEFE: Absolutely, Your Honor.  
 12:02:48 25 THE COURT: Mr. Andre, what is wrong with that

12:04:06 1 THE COURT: All right. The date certain is by  
 12:04:10 2 November 20th, 2009. I am satisfied that Facebook is doing  
 12:04:14 3 its best to produce the relevant and responsive marketing  
 12:04:18 4 and financial documents. I accept the representation that  
 12:04:20 5 they will continue to do that, that they will complete that  
 12:04:24 6 production by November 20th, and that that will provide  
 12:04:28 7 sufficient opportunity for the plaintiff to complete the  
 12:04:30 8 necessary fact depositions, consistent with the schedule  
 12:04:34 9 provided for completion of fact depositions.  
 12:04:38 10 Let's move on. I think the final issue is  
 12:04:40 11 whether Facebook should be compelled to produce any  
 12:04:46 12 documents from previous litigations.  
 12:04:48 13 Let me hear from Leader on that first, please.  
 12:04:52 14 MR. ANDRE: Your Honor, the supplementation of  
 12:04:54 15 the interrogatories regarding our willful infringement is  
 12:04:56 16 relying upon some of this information from the previous  
 12:05:00 17 litigation to show you what the relevance is.  
 12:05:02 18 There are two points that we put in our letter  
 12:05:06 19 brief that we will be supplementing our interrogatory with.  
 12:05:08 20 Those came from the fact that we had the deposition  
 12:05:10 21 testimony of the founder of Facebook, on the codes, the  
 12:05:16 22 basic website, on the two-week period and using the source  
 12:05:24 23 codes to develop Facebook. He also destroyed anything  
 12:05:28 24 having to do with the original source code.  
 12:05:30 25 That testimony from previous litigation is

12:05:32 1 obviously relevant to our case. We are not asking for  
 12:05:36 2 everything from the previous litigation. What we are asking  
 12:05:38 3 for are Facebook witnesses that he talked about, the  
 12:05:40 4 founding of Facebook, the development of the website, the  
 12:05:42 5 materials relied upon when they were writing the Facebook  
 12:05:50 6 code, all that isn't in that previous litigation. And as we  
 12:05:56 7 are now going to be supplementing an interrogatory with  
 12:05:58 8 information from that, I would like to have the actual  
 12:06:02 9 physical transcripts of those depositions instead of relying  
 12:06:06 10 upon those that are still on the Internet.

12:06:12 11 THE COURT: All right. Facebook.

12:06:14 12 MS. KEEFE: Your Honor, I am a little flummoxed,  
 12:06:18 13 because this is absolutely the first time I have heard any  
 12:06:20 14 of this. As we noted in our letter, this is an issue that  
 12:06:24 15 Your Honor specifically ordered in July, that if they wanted  
 12:06:26 16 to come back and readdress this issue after the motion had  
 12:06:30 17 been denied, that we need to meet and confer in good faith  
 12:06:34 18 regarding the topic.

12:06:34 19 We started to talk about the fact that they were  
 12:06:38 20 going to be asking again for litigation documents, and the  
 12:06:44 21 parties specifically agreed to meet and confer on this issue  
 12:06:46 22 on Tuesday. So the first time I have ever heard that there  
 12:06:48 23 is any -- next Tuesday, sorry. This is the first time I  
 12:06:52 24 have heard that there is any narrowing of any relevance of  
 12:06:54 25 any form. I still contend that the burden, again, of all of

12:08:18 1 and copying it and producing it. There is no search  
 12:08:22 2 required. These are litigation documents.  
 12:08:24 3 That is what we are asking for, Your Honor.  
 12:08:26 4 THE COURT: All right. With respect to this  
 12:08:28 5 one, I am today also going to deny Leader's request for  
 12:08:34 6 production of the litigation documents. But that is without  
 12:08:38 7 prejudice to it being raised again. If this is going to  
 12:08:44 8 remain in dispute, I would like to see it raised fairly  
 12:08:50 9 soon, within the next 30 days or so. But right now, I think  
 12:08:54 10 it is premature for me to rule today, given that what I have  
 12:09:00 11 heard from Mr. Andre is a significant narrowing of what the  
 12:09:04 12 purpose is and therefore what the breadth is of what  
 12:09:10 13 litigation documentation Leader thinks it needs.

12:09:14 14 The fact that Leader is now going to be  
 12:09:16 15 supplementing its interrogatories next Wednesday, consistent  
 12:09:20 16 with my order from earlier in the call, does not provide any  
 12:09:24 17 basis for requiring Leader to be provided with any prior  
 12:09:30 18 litigation documents, because my order is that the  
 12:09:36 19 supplementation next Wednesday will extend only so far as  
 12:09:44 20 Leader incorporating its letter response into its  
 12:09:50 21 supplemental interrogatory responses, which means what  
 12:09:54 22 Leader will be doing is saying, on the record, what  
 12:10:00 23 information it has based on publicly available information  
 12:10:04 24 to support its willful infringement claim. There will be  
 12:10:08 25 further supplementation of that if and when Leader learns

12:07:00 1 the prior litigation based on the fact that they are  
 12:07:06 2 absolutely irrelevant, not regarding the same technology,  
 12:07:08 3 not regarding the same patent, overweighs any de minimis  
 12:07:12 4 relevance. If Your Honor is inclined to do anything, I  
 12:07:16 5 think we should at least meet and confer first. Also, I  
 12:07:18 6 stand by the fact that the relevance doesn't outweigh  
 12:07:22 7 anything.

12:07:22 8 THE COURT: Okay. Mr. Andre, do you want to  
 12:07:24 9 respond?

12:07:24 10 MR. ANDRE: Your Honor, on October 16th, our  
 12:07:28 11 letter, Exhibit 10 to our brief, you see that we once again  
 12:07:32 12 requested documents from the previous litigation. Mr.  
 12:07:40 13 Hannah had a meet-and-confer with counsel for Facebook,  
 12:07:42 14 saying that we cannot wait any longer on this and we will  
 12:07:46 15 move in the court on it. They said we can keep talking  
 12:07:50 16 about it. We said, no, we need an answer now because we  
 12:07:52 17 need those documents because we do want to supplement our  
 12:07:56 18 willful infringement case. Obviously, stuff that we got  
 12:07:58 19 from the previous testimony is relevant to that and is  
 12:08:00 20 really key to it.

12:08:06 21 So we did tell them that this was an issue and  
 12:08:06 22 that we were going to move on it.

12:08:08 23 Secondly, like I said, this is no burden to them  
 12:08:12 24 at all. This is in their file. This is in sitting their  
 12:08:16 25 lawyers' files right now. This is a matter of taking it out

12:10:12 1 something in discovery to add to its willful infringement  
 12:10:16 2 contentions.

12:10:18 3 So the requirement to provide supplemental  
 12:10:20 4 responses to the interrogatories does not provide a basis  
 12:10:24 5 for requiring Facebook to produce any additional or any  
 12:10:28 6 previous litigation documents at this time.

12:10:30 7 I can tell you -- and this may be relevant to  
 12:10:34 8 your meeting and conferring -- I am inclined to the view  
 12:10:40 9 that prior deposition testimony related to what materials  
 12:10:48 10 were relied on in the development of the Facebook website  
 12:10:50 11 sounds to me like it may very well prove to be relevant and  
 12:10:54 12 the production of it could also streamline and thereby make  
 12:11:00 13 more efficient the deposition process in this case.

12:11:02 14 I am not prepared at this time to put that in a  
 12:11:06 15 ruling. At this point, I am denying, as I said, the request  
 12:11:10 16 for the production, but without prejudice to it being  
 12:11:12 17 renewed fairly soon, after a further meet-and-confer based  
 12:11:16 18 on everything else that we have talked about today.

12:11:20 19 I think that's all the issues that the parties  
 12:11:22 20 have raised. Am I correct about that, Mr. Andre?

12:11:24 21 MR. ANDRE: That's correct, Your Honor. Thank  
 12:11:28 22 you.

12:11:26 23 THE COURT: And, Ms. Keefe, am I correct about  
 12:11:30 24 that?

12:11:30 25 MS. KEEFE: Yes, you are, Your Honor. Thank you



12:11:32 1 very much,  
12:11:32 2 THE COURT: I have one question for all of you.  
12:11:34 3 The objections to one of my earlier discovery  
12:11:34 4 orders, are those still pending? I believe those would be  
12:11:34 5 Facebook's objections. Are those objections still pending?  
12:11:38 6 Or have they been mooted by subsequent developments?  
12:11:52 7 MS. KEEFE: I believe they have been mooted by  
12:11:52 8 subsequent developments, Your Honor, and we would withdraw  
12:11:56 9 them.  
12:11:56 10 THE COURT: If that is the case, put together a  
12:12:00 11 letter of some sort, or some sort of filing, so Judge Farnan  
12:12:02 12 will see that and know that he doesn't have to deal with  
12:12:06 13 those.  
12:12:06 14 MS. KEEFE: Absolutely, Your Honor.  
12:12:08 15 THE COURT: Thank you all for your time.  
12:12:10 16 (Counsel respond "Thank you.")  
12:12:12 17 (Conference concluded at 12:10 p.m.)  
18  
19 Reporter: Kevin Maurer  
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