IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

LEADER TECHNOLOGIES, INC., a Delaware corporation, Plaintiff and Counterdefendant, v. FACEBOOK, INC., a Delaware corporation, Defendant and Counterclaimant.	Civil Action No. 1:08-cv-00862-JJF **PUBLIC VERSION**

FACEBOOK INC.'S OPPOSITION TO PLAINTIFF'S MOTION IN LIMINE NO. 4 TO EXCLUDE EVIDENCE OF REEXAMINATION OF THE '761 PATENT

BLANK ROME LLP
Steven L. Caponi (DE Bar #3484)
1201 N. Market Street, Suite 800
Wilmington, DE 19801
302-425-6400
Fax: 302-425-6464

Attorneys for Defendant and Counterclaimant Facebook, Inc.

OF COUNSEL:

Heidi L. Keefe (*pro hac vice*)
Mark R. Weinstein (*pro hac vice*)
Jeffrey T. Norberg (*pro hac vice*)
Melissa H. Keyes *(pro hac vice)*
Elizabeth L. Stmeshkin (*pro hac vice*)
COOLEY GODWARD KRONISH LLP
5 Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155

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FOR THE DISTRICT OF DELAWARE

LEADER TECHNOLOGIES, INC., a Delaware corporation,	)	**CIVIL ACTION**
Plaintiff and Counterdefendant,	)	**No. 1:08-cv-00862-JJF**
v.	)	**CONFIDENTIAL FILED UNDER SEAL**
FACEBOOK, INC., a Delaware corporation,	)	
Defendant and Counterclaimant.	)	

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BLANK ROME LLP
1201 N. Market Street, Suite 800
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Melissa H. Keyes (*pro hac vice*)
Elizabeth L. Stameshkin (*pro hac vice*)
COOLEY LLP
3000 El Camino Real
5 Palo Alto Square, 4th Floor
Palo Alto, CA 94306

Dated: May 27, 2010

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Facebook generally agrees with the principle that neither party should introduce evidence or mention the ongoing *ex parte* or *inter partes* reexaminations of the '761 patent. Facebook has no plans to mention the reexaminations at trial, unless LTI makes either of the following arguments as discussed below.

I. ARGUMENTS REGARDING PRIOR ART CONSIDERED BY THE EXAMINER

The prior art references on which Facebook's invalidity defense is based were never considered by the Examiner during the prosecution of the '761 patent. LTI has nonetheless suggested that it intends to speculate to the contrary at trial. For example, in its pending Motion *in Limine* No. 1, LTI seeks to preclude Dr. Greenberg from stating that the prior art references cited by Facebook were not considered by the Examiner. The deposition questions LTI posed to Dr. Greenberg reproduced in that motion strongly indicate that LTI intends to speculate that Facebook's art references were considered during prosecution.

Redacted

LTI can point to no evidence that the Examiner was aware of, let alone considered, any of Facebook's prior art references, and should not be allowed to speculate to the contrary. Redacted

The U.S. Patent and Trademark Office has confirmed, in fact, that these references were not considered. In its orders granting both *ex parte* and *inter partes* reexamination, the Patent Office noted that each of the prior art references that Facebook relies upon in this litigation "was ***not*** before the Examiner during the prosecution of the ['761] patent." *See* Declaration of Kathryn Robinson in Support of Facebook's Oppositions to Leader Technology, Inc.'s Pretrial Motions ("Robinson Decl."), Ex. 5 ¶¶ 9-11; *id.*, Ex. 6 ¶¶ 14-18 (emphasis added). Should LTI improperly suggest that any of Facebook's prior art references *were* considered by the Examiner

during the prosecution of the '761 patent, therefore, Facebook should be allowed to introduce the reexamination orders by the USPTO to counter and refute that unfounded contention.

II. ARGUMENTS REGARDING MATERIALITY OF iMANAGE

Facebook has alleged that the iManage collaborative document management system invalidates the asserted claims of the '761 patent and support's Facebook's defense of inequitable conduct. To the extent LTI contends that iManage is not material to the '761 patent, Facebook should be allowed to rebut this argument with the fact that the Patent Office granted reexamination and made the following finding:

> iManage was not before the Examiner during the prosecution of the McKibben patent and there is a substantial likelihood that **a reasonable examiner would consider this teaching of iManage important in deciding whether the claims of the McKibben patent are patentable**. Accordingly, iManage raises a [substantial new question of patentability] as to claims 1-2, 4-16, 21, 23-26, 29, 31-34, which question has not been decided in a previous examination of the . . . McKibben patent.

Robinson Decl., Ex. 6 ¶ 17 (emphasis added).

Information is material when "a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent." *Larson Mfg. Co. v. Aluminart Prods. Ltd.*, 559 F.3d 1317, 1326-27 (Fed. Cir. 2009) (internal quotations and citation omitted). The USPTO has, therefore, essentially determined that iManage was both material and not disclosed to the Examiner during the prosecution of the '761 patent. This determination of materiality by the Patent Office will not change regardless of the ultimate outcome of the reexamination, and is highly probative of Facebook's inequitable conduct claim. Thus, *if* LTI attempts to argue that iManage is not material, the Patent Office's *Inter Partes* reexamination order of February 9, 2010 should be admitted for the limited purpose of rebutting this contention.

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Facebook opposes LTI's motion only for the limited purposes set forth above, and requests that the Court conditionally grant LTI's motion and either preclude LTI from making the arguments set forth above, or allow Facebook to introduce evidence of the reexamination orders should LTI make such arguments at trial.

Dated: May 27, 2010

By: */s/ Steven L. Caponi*
Steven L. Caponi (DE Bar No. 3484)
BLANK ROME LLP
1201 Market Street
Wilmington, DE 19801
Phone: (302) 425-6400
Fax: (302) 425-6464

Attorneys for Defendant and Counterclaimant Facebook, Inc.

Of Counsel:
Heidi L. Keefe
Mark R. Weinstein
Jeffrey T. Norberg
Melissa H. Keyes
Elizabeth L. Stameshkin
COOLEY LLP
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306
Phone: (650) 843-5000
Fax: (650) 857-9663