

UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA

MOTOROLA MOBILITY, INC.,

CASE NO. 1:10-cv-24063-MORENO

Plaintiff / Counterclaim Defendant,

v.

MICROSOFT CORPORATION,

Defendant / Counterclaim Plaintiff.

**PLAINTIFF/COUNTERCLAIM DEFENDANT MOTOROLA
MOBILITY, INC.'S MOTION FOR USE OF REPRESENTATIVE CLAIMS
AND ACCOMPANYING MEMORANDUM OF LAW IN SUPPORT**

Plaintiff/Counterclaim Defendant Motorola Mobility, Inc. (“Motorola”), pursuant to Federal Rules of Civil Procedure 1 and 16 and all other applicable rules and this Court’s inherent power, moves for an Order directing the parties to try this action using a reasonable number of representative claims of the multiple patents at issue, instead of the hundreds of claims that Defendant/Counterclaim Plaintiff Microsoft Corporation (“Microsoft”) proposes to be tried. This motion should be granted for the reasons set forth in the memorandum of law below.

MEMORANDUM OF LAW**I. INTRODUCTION**

The use of representative claims to streamline complex patent cases with large numbers of claims is routinely used in complex patent litigation. Yet, Microsoft – at this date when discovery is largely complete and the parties have submitted all motion papers – refuses to limit the number of claims and insists that hundreds of claims in the more than a dozen patents be tried. This would lead to an unnecessarily complex and unwieldy case and a waste of the resources of the jury, the Court, and the parties.

Between Motorola’s main claims and Microsoft’s counterclaims, this patent action involves fourteen (14) patents and over 150 asserted claims – 60 asserted by Motorola and 92 asserted by

Microsoft.¹ In turn, the patents are associated with various allegedly infringing products with respect to each party. In total, nearly 30 different products are accused in this case.

To ease the logistical burden of this case, Motorola seeks to make the case more manageable by limiting the number of claims that ultimately will be presented to the jury through the use of representative claims. Microsoft has refused and failed to present a valid reason for not doing so other than it insisting on presenting each and every claim it seeks to enforce to the jury to be tried. Whatever the arrangement, the parties should be on the same footing and thus Microsoft's insistence on trying all of its claims to the jury will require Motorola to do the same.

Yet, if the case proceeds according to Microsoft's model, over **150 claims** relating to the multiple patents and allegedly infringing products will be presented to the jury. Such a plan is a complete waste of resources as many of the claims at issue are duplicative of each other or generally redundant.

Worse, proceeding to trial on such an unwieldy amount of claims likely would confuse the jury, make it hard for a manageable trial to be conducted in the standard 2-week period, and lead to the unnecessary expenditure of the parties' and the Court's resources. As explained below, to avoid similar issues, numerous courts from around the country, including the Federal Circuit, have deemed it proper to limit the number of claims in complex patent cases, such as this case.

Motorola requests that the Court direct the parties to proceed on a reasonably limited number of claims – Motorola proposes forty (40) claims total with each party asserting twenty (20) claims. Motorola further proposes that if the Court were inclined to grant Motorola's request, that it direct the parties to meet and confer with regard to the choosing and defining of the claims, as well as the preclusive effect that any determinations with respect to the representative claims would have on the dependent claims and then submit a final order on same.

FACTUAL BACKGROUND AND PROCEDURAL HISTORY

Motorola filed this case on November 10, 2010, claiming that various of Microsoft's products infringe the Motorola Patents. (D.E. 1). The Microsoft products accused of infringing these patents include Windows 7, Windows Vista, Windows Phone 7, Windows Mobile 6.5,

¹ The patents asserted by Motorola are U.S. Patents Nos. 5,502,839; 5,764,899; 5,784,001; 6,272,333; 6,408,176; 6,757,544; and 6,983,370 (collectively, the "Motorola Patents"). The patents asserted by Microsoft are U.S. Patents Nos. 6,791,536; 6,897,853; 7,024,214; 7,493,130; 7,383,460; 6,897,904; and 6,785,901 (collectively, the "Microsoft Patents").

Microsoft Exchange Server, Lync 2010, Live Messenger, and Bing Maps.

On December 23, 2010, Microsoft answered Motorola's Complaint and filed a counterclaim, alleging infringement by Motorola of the Microsoft Patents. Among the allegedly infringing products are over 20 Motorola Android devices and digital video recorders. (D.E. 21 at 13, 16).

Pursuant to the Court's Scheduling Order dated January 4, 2011 (D.E. 23), and as amended by the Order Continuing Trial and Certain Pretrial Dates dated January 20, 2011 (D.E. 36), the case is set for trial on the 2-week period commencing October 24, 2011.

To date, the parties have exchanged proposed constructions for claims and definition of terms. As well, the parties are finalizing discovery exchange, including expert submissions and depositions. As noted, the result of this process is that the parties are, collectively, trying over 150 claims among the various patents. Motorola approached Microsoft weeks ago to discuss possible representative claims in part to limit the number of terms that this Court would need to construe.² As noted, however, despite attempts by Motorola to have Microsoft agree to limit the number of claims, Microsoft has not agreed to do so, and the parties were forced to brief over 50 claim terms in its *Markman* submissions. As it stands presently, under Microsoft's approach there would be over **150 claims** being asserted in the 14 patents.

ARGUMENT

Microsoft's refusal to agree to a more manageable amount of claims is unreasonable, particularly when considering the significant extent of duplication and overlap among the parties' proposed claims.

This duplication and overlap may be illustrated by examining two of Microsoft's claims relating to two of the Microsoft syncing patents, Patents Nos. 7,024,214 and 7,493,130, just as an example. There are 7 independent claims with regard to these patents, but these claims essentially fall into two groups: consulting a set of flexible rules to select a sync mechanism and consulting a set of flexible rules to determine whether to sync a data item (and thereby also selecting a sync mechanism). Within those two groups, the claims are basically identical, except for being of different types: method, apparatus, and *Beauregard* claims (computer readable media claims).

A comparison of claim 2 relating to the '130 patent and claim 1 of the '214 patent reveals

² The parties are filing simultaneously with this brief, claim construction papers of nearly 100 pages in length each. Motorola believes that limiting the number of claims may reduce the number of claim terms that require construction.

that, with the exception of the preamble, these claims are identical:

Claim 2 of the '130 patent	Claim 1 of the '214 patent
<p>A first computer system in a network that includes the first computer system having a first data store and second computer system having a second data store, the first computer system comprising one or more computer-readable media having computer-executable instructions for implementing a method for synchronizing the first and second data stores in a flexible manner considering the circumstances that exist at the time of synchronization, wherein the method comprises:</p>	<p>In a network that includes a first computer system having a first data store and second computer system having a second data store, a method for synchronizing the first and second data stores in a flexible manner considering the circumstances that exist at the time of synchronization, the method comprising the following:</p>
<p>i. an act of the first computer system determining that a data item is to be synchronized;</p>	<p>i. an act of the first computer system determining that a data item is to be synchronized;</p>
<p>ii. an act of the first computer system identifying which of a plurality of synchronization mechanisms, including one or more hardwired or wireless communication connections, are available to use for synchronization;</p>	<p>ii. an act of the first computer system identifying which of a plurality of synchronization mechanisms, including one or more hardwired or wireless communication connections, are available to use for synchronization;</p>
<p>iii. an act of the first computer system consulting a set of one or more flexible selection rules to select a synchronization mechanism, the set of one or more flexible rules taking into consideration value, from having access to synchronized data, relative to at least one of (i) an economic cost for synchronization using each available synchronization mechanism, (ii) network security for each available synchronization mechanism, (iii) security of the second computer system, or (iv) value of data being synchronized and thereby selecting an available synchronization mechanism appropriate for the data item given the one or more flexible selection rules; and</p>	<p>iii. an act of the first computer system consulting a set of one or more flexible selection rules to select a synchronization mechanism, the set of one or more flexible roles taking into consideration value, from having access to synchronized data, relative to at least one of (i) an economic cost for synchronization using each available synchronization mechanism, (ii) network security for each available synchronization mechanism, or (iii) security of the second computer system, or (iv) value of data being synchronized and thereby selecting an available synchronization mechanism appropriate for the data item given the one or more flexible selection rules; and</p>
<p>iv. an act of the first computer</p>	<p>iv. an act of the first computer</p>

system using the selected synchronization mechanism to synchronize the data item with the second computer.	system using the selected synchronization mechanism to synchronize the data item with the second computer.
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There is simply no reason to assert two claims that include the same exact claim limitations. These claims are but one example of the type of inefficient and duplicative claims trial Microsoft proposes --unwarranted in any patent case -- but particularly inappropriate for an action such as this that already involves numerous patents and accused products. Indeed, just with regard to the '214 and '130 patents alone, Microsoft asserts some 50 claims. The number and complexity of such claims could be reduced if this Court were to require the parties to try only representative claims, as explained below.

This Court has the authority to do so pursuant to the Federal Rules of Civil Procedure, as well as the Court's inherent power to manage its cases. Rule 1 provides that district courts should "secure the just, speedy, and inexpensive determination of every action and proceeding." And, Rule 16 permits this Court to "consider and take appropriate action on the following matters: (A) formulating and simplifying the issues...; (D) avoiding unnecessary proof and cumulative evidence...; (L) adopting special procedures for managing potentially difficult or protracted actions that may involve complex issues...; (M) ordering a separate trial ... of a claim, counterclaim,... or particular issue; and (P) facilitating in other ways the just, speedy, and inexpensive disposition of the action." *Id.* (c)(2); *see also* Fed. R. Civ. P. 42(b) (allowing separate trials of specific claims or issues for convenience, economy, or to avoid prejudice).

The use of representative claims is not uncommon in complex patent cases with a large number of claims and issues, such as this case. Indeed, cognizant of the need to avoid undue expense, burdensomeness, and jury confusion, parties often stipulate to the use of representative claims. *E.g., Baxter Int'l, Inc. v. COBE Laboratories, Inc.*, 88 F.3d 1054, 1056 (Fed. Cir. 1996) (stipulation to use representative claims); *Thomson, S.A. v. Quixote Corp.*, 166 F.3d 1172, 1173 (Fed. Cir. 1999) (same).

Here, Microsoft thus far has refused to work with Motorola in devising and using representative claims. Accordingly, this Court should exercise its authority and direct the parties to use representative claims, as numerous other courts have done. Indeed, as recently as last month, the Federal Circuit found that a district court did not abuse its discretion in granting a motion to limit the number of claims that could be asserted in a patent case to 15 (fifteen), subject to an

increase for good cause shown. *Stamps.com Inc. v. Endicia, Inc.*, 2011 WL 2417044, *1 (Fed. Cir. June 15, 2011). That case involved even more infringement claims than this one (the plaintiff asserted in *Stamps* asserted some 400 infringement claims involving over 11 patents).³

Courts have employed similar limits in other cases. See, e.g., *In re Katz Interactive Call Processing Litigation*, 639 F.3d 1303 (Fed. Cir. 2011) (district court did not err in limiting plaintiff patentee to 64 claims from a large number of asserted claims when it left open the door for the assertion of additional claims on a showing of need); *ReRoof Am., Inc. v. United Structures of Am., Inc.*, 1999 WL 674517, *4 (Fed. Cir. Aug. 30, 1999) (district court did not abuse discretion in requiring plaintiff to use representative claims in lieu of large number of claims at issue) (unpublished); *Hearing Components, Inc. v. Shure, Inc.*, 2008 WL 2485426, at *1 (E.D. Tex. June 13, 2008) (*sua sponte* ordering parties to limit to ten the number of claim terms to be construed, and to select three representative claims from each patent); *Fenster Family Patent Holdings, Inc. v. Siemens Med. Solutions USA, Inc.*, 2005 WL 2304190, at *3 (D. Del. Sept. 20, 2005) (plaintiff's assertion of 90 claims and 49 allegedly infringing products “unreasonable” and limiting plaintiff to 10 claims and 5 products); cf. *Ormco Corp. v. Align Tech., Inc.*, 498 F.3d 1307, 1321 n.2 (Fed. Cir. 2001) (O'Malley, J., concurring in part and dissenting in part) (“There are legitimate ways in which district courts can streamline the claims construction analysis when faced with myriad claims from multiple patents. District courts ... may direct parties to identify the most representative claims for construction. In that way, the district court can provide guidance as to its construction of the most critical or oft-repeated claim terms and, thus, provide a roadmap with respect to the direction any additional claim construction might take.”).⁴

Several courts even have adopted local rules that set presumptive limits on the numbers of claims to be construed or presented. E.g., Local Patent Rules, N. Dist. of Ill., Rule 4.1(b) (effective Oct. 1, 2009) (requiring parties to have a meet and confer to select no more than 10 terms or phrases to submit to the court for construction, and providing that if the parties can't agree on the ten terms to submit, each party shall be allocated five terms, further requiring that for each term presented to the court for construction, the “parties must certify whether it is outcome-

³ *Stamps.Com, Inc. v. Endicia, Inc., PSI Systems Inc.*, 2009 WL 2576371 (C.D. Cal. May 21, 2009).

⁴ See, also *Auto Wax Co. v. Mark V Products*, No. 3:99-CV-0982-M, 2001 WL 292597, at *1 (N.D. Tex. March 14, 2001) (requiring plaintiff to limit number of claims to be tried from 86 to 19); *Verizon Calif., Inc. v. Ronald A. Katz Tech. Licensing, L.P.*, 326 F. Supp. 2d 1060, 1066 (C.D. Cal. 2003)

determinative.”); Local Patent Rules, W.D. Wash., Rule 132(c) (effective Jan. 1, 2009) (requiring parties to identify “[t]he ten most important disputed terms,” and stating that the “Court will construe a maximum of ten claim terms at the initial Markman hearing, unless the Court determines otherwise.”); Local Rule 16.6, D. Mass., App. ¶ B(4)(d) (requiring parties to limit number of terms identified for the court to construe and to “prioritize the disputed terms in order of importance”) (effective as of November 4, 2008).

If representative claims are not utilized in this case, the parties, the Court, and ultimately the jury will be required to analyze the hundreds of claims vis-à-vis the numerous accused products. As well, defenses such as prior art and invalidity will have to be considered against an inordinate number of claims.

Motorola believes that limiting the parties to 40 (forty) representative claims, to be split equally among the parties (20 each), would serve to significantly streamline the case while safeguarding the parties’ rights.

II. CONCLUSION

For the foregoing reasons, Motorola respectfully requests that the Court order the parties to limit each of their cases to 20 (twenty) representative claims, with other claims to be litigated as required if they are not resolved through the representative claims. Microsoft also requests that the Court direct the parties to meet and confer in order to discuss and define the representative claims, as well as the effect such claims would have on the remaining issues in the case.

CERTIFICATE OF GOOD FAITH CONFERENCE

I hereby certify that in accordance with Local Rule 7.1(a)(3), counsel for Motorola has conferred with counsel for Microsoft in a good faith effort to resolve the issues raised in this motion, but that the parties were unable to reach an agreement on these issues.

/s/ Edward M. Mullins
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(requiring plaintiff to select a maximum of three representative claims for each patent it contended was infringed).

Dated: July 21, 2011

Respectfully submitted,

/s/ Edward M. Mullins

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on July 21, 2011, I electronically filed the foregoing document with the Clerk of the Court using the CM/ECF filing system. I also certify that the foregoing document is being served this date on all counsel of record or pro se parties on the Service List below in the manner specified, either via transmission of Notices of Electronic Filing generated by the CM/ECF system or; in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

/s/ Edward M. Mullins

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Motorola Mobility, Inc. v. Microsoft Corporation

Case No.: 1:10-CV-24063-MORENO/TORRES

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