

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF FLORIDA**

Case No. 1:10-24063-CIV-MORENO

MOTOROLA MOBILITY, INC.,

Plaintiff / Counterclaim Defendant,

v.

MICROSOFT CORPORATION,

Defendant / Counterclaim Plaintiff.

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**MOTOROLA MOBILITY, INC.'S MOTIONS *IN LIMINE* NOS. 1-9  
AND BRIEF IN SUPPORT THEREOF**

Pursuant to the Court's January 20, 2011 Order Continuing Trial and Certain Pretrial Dates (D.E. 36), Plaintiff and Counterclaim Defendant, Motorola Mobility, Inc. ("Motorola") hereby moves *in limine*, prior to *voir dire* examination of the jury panel, to exclude matters that are inadmissible or prejudicial from jury selection and trial in this matter.<sup>1</sup>

Motorola respectfully requests that the Court instruct Defendant and Counterclaim Plaintiff, Microsoft Corporation ("Microsoft") and its counsel, representatives, and all witnesses tendered by Microsoft (whether live or by deposition) not to mention, offer evidence about, refer to, ask questions alluding to or reasonably likely to result in a reference to, or attempt to convey to the jury in any manner, directly or indirectly, any of the matters set forth below. In the alternative, Motorola requests that the Court instruct Microsoft and its counsel, representatives, and all witnesses tendered by Microsoft (whether live or by deposition) not to do so without first obtaining a ruling from the Court outside the presence and hearing of any prospective jurors and the jury ultimately selected in this case. Motorola further requests that the Court instruct Microsoft to warn and counsel each witness to follow these instructions.

The subjects as to which Motorola seeks preclusion are as follows:

1. The parties should be precluded from introducing any expert testimony regarding positions not timely and adequately disclosed in their expert reports, expert depositions, or expert declarations.
2. The parties should be precluded from introducing expert testimony regarding claim construction.
3. Microsoft should be precluded from introducing testimony regarding Motorola products not specifically accused of infringement.
4. For any patent claim as to which Microsoft did not have its experts analyze noninfringement under Motorola's proposed claim constructions, Microsoft should be precluded from introducing expert testimony regarding noninfringement if the Court adopts Motorola's constructions.
5. Microsoft should be precluded from presenting expert testimony regarding infringement of Microsoft's asserted patents under the doctrine of equivalents.

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<sup>1</sup> Motorola reserves the right to file additional motions *in limine* that may become necessary due to upcoming events, including actions or orders by the Court.

6. Microsoft should be precluded from presenting expert testimony regarding indirect infringement (induced or contributory infringement) of Microsoft's asserted patents.
7. Microsoft should be precluded from presenting expert testimony on source code relating to features Microsoft has accused of infringing U.S. Patent Nos. 7,024,214 and 7,493,130.
8. Microsoft should not be permitted to suggest that Motorola is responsible for any purported gaps in Microsoft's understanding of how Motorola's accused products work.
9. Microsoft should be precluded from relying on representative products to prove infringement.

**I. Motion *In Limine* No. 1: The Parties Should Be Precluded From Introducing Any Expert Testimony Regarding Positions Not Timely And Adequately Disclosed In Their Expert Reports, Expert Depositions, Or Expert Declarations**

Under the Federal Rules of Civil Procedure, the parties were required to disclose reports from their experts “contain[ing] a complete statement of all opinions the witness will express and the basis and reasons for them [and] the facts or data considered by the witness in forming them,” as well as to provide timely supplements to those reports. *See* Fed. R. Civ. P. 26(a)(2)(B), 26(e). Under Rule 37(c)(1), “[i]f a party fails to provide information or identify a witness as required by Rule 26(a) or 26(e), the party is not allowed to use that information or witness to supply evidence on a motion, at a hearing, or at a trial, unless the failure was substantially justified or is harmless.” Fed. R. Civ. P. 37(c)(1). As a result, federal courts routinely preclude expert witnesses from presenting opinions that were not contained within their reports or any timely supplemental expert disclosure. *See, e.g.*, 8A Charles Alan Wright et al., *Federal Practice and Procedure* § 2031.1 (3d ed.); *Macaulay v. Anas*, 321 F.3d 45, 51-52 (1st Cir. 2003) (upholding exclusion of expert report introducing new theory of liability more than a month after the deadline for expert disclosures and days before the anticipated trial date); *Cummins v. Lyle Industries*, 93 F.3d 362, 371 (7th Cir. 1996) (upholding exclusion of expert evidence that had not been disclosed in report or supplement).

The parties’ experts in this case likewise should be barred from offering any testimony regarding positions not timely disclosed in this litigation, either in opening reports or appropriate supplemental reports, as required by the Rules. Allowing a party to present expert testimony at trial regarding issues not previously disclosed would be trial by ambush and highly prejudicial. *See La Gorce Palace Condo. Ass’n v. QBE Ins. Corp.*, No. 10–20275–CIV, 2011 WL 1522564, at \*2 (S.D. Fla. Apr. 12, 2011) (“The purpose of full disclosures is to provide the parties with the information needed to assess the merits of their cases early enough in the litigation to make an informed decision about settlement and prepare their cases for trial.”).

**II. Motion *In Limine* No. 2: The Parties Should Be Precluded From Introducing Expert Testimony Regarding Claim Construction**

Motorola and Microsoft agreed in writing that the parties would not use experts for claim construction in this case. This agreement was confirmed by a May 6, 2011 e-mail from Tung Nguyen, counsel for Microsoft, stating, “Microsoft agrees with Motorola that neither party will use experts for claim construction.” (Declaration of R. Andrew Schwentker in Support of Motorola

Mobility, Inc.'s Motions *in Limine* ("Schwentker") Exh. A at 7 (May 6, 2011 e-mail from Tung Nguyen to Leslie Spencer, counsel for Motorola.)

Relying on the parties' agreement, Motorola did not have its technical experts opine on issues of claim construction in their reports. Several of Microsoft's experts, on the other hand, opined on issues of claim construction, including which party's constructions (invariably Microsoft's) they agreed with. (*See id.* at 4-5 (July 1, 2011 e-mail from Steven Pepe, counsel for Motorola, to Paul Tripodi, counsel for Microsoft, outlining portions of Microsoft's expert reports where experts opined on claim construction).)

Based on the parties' agreement, Motorola asked Microsoft to withdraw the portions of its experts' reports where they opined on claim construction. But Microsoft responded that it disagreed with Motorola's understanding of the agreement, suggesting instead that the parties had only agreed "not to use expert testimony in connection with claim construction briefing." (Schwentker Exh. A at 1-2 (July 6, 2011 e-mail from Paul Tripodi to Steven Pepe).)<sup>2</sup>

Microsoft's position is insupportable. The language in Mr. Nguyen's May 6<sup>th</sup> e-mail is clear and unambiguous: "neither party will use experts for claim construction." It is not limited to "expert testimony in connection with claim construction briefing," as Microsoft contends. Nor does Microsoft provide any corroboration for its interpretation other than a description of a May 4<sup>th</sup> telephone call in which counsel for Motorola proposed – consistent with the overall agreement memorialized on May 6 – that neither party submit expert declarations with their claim construction briefing. (*See id.*) If Microsoft thought that the final agreement was to be limited to use of experts for claim construction briefing, it could and should have said so in Mr. Nguyen's e-mail. In view of the clear language in Mr. Nguyen's e-mail, and Motorola's reliance on that language, neither party should be permitted to rely on its experts for claim construction.<sup>3</sup>

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<sup>2</sup> Microsoft further explained that some of its experts opined on claim construction "as part of the *foundation* for their opinions." (*Id.* (emphasis in original).) It is unclear why Microsoft believes this was necessary. Microsoft's experts could have simply analyzed infringement and validity of each disputed claim element under both parties' proposed constructions, without opining on which party's constructions they believed were correct. Indeed, that is exactly what Motorola's experts did, and, in fact, what some of Microsoft's experts did.

<sup>3</sup> Motorola's understanding of the parties' agreement is also consistent with the Federal Circuit's admonition that expert reports and testimony regarding claim construction are forms of extrinsic evidence that should be accorded less weight than a patent's intrinsic evidence (e.g., the patent itself, the prosecution history). *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1317-19 (Fed. Cir. 2005) (en banc) ("[E]xtrinsic evidence consisting of expert reports and testimony is generated at the

Because the parties are exchanging claim construction briefs on the same day that Motorola is filing this motion, Motorola does not know yet whether Microsoft will rely on its experts' opinions in its claim construction briefs. If Microsoft does so, however, it will be in direct violation of the parties' agreement. In that event, any such expert opinions should be stricken and all portions of Microsoft's claim construction brief that refer to or rely on such expert opinions also should be stricken.

Microsoft should also be precluded from introducing expert testimony at trial regarding claim construction. As the Court knows, it must construe disputed claim terms before the case is submitted to the jury. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 391 (1996). And only the Court's constructions will be relevant to the jury's determination of infringement and validity of the asserted patent claims. Any discussion of claim construction at trial, other than reference to and use of the Court's constructions, therefore would be irrelevant and contrary to the parties' agreement, and will likely confuse the jury. *See* Fed. R. Evid. 401-403.

### **III. Motion *In Limine* No. 3: Microsoft Should Be Precluded From Introducing Testimony Regarding Motorola Products Not Specifically Accused Of Infringement**

Microsoft accuses the BMC9012, BMC9022D set-top boxes of infringing U.S. Patent No. 6,785,901 and the DCT6416, DCH6416, and DCX3400 set-top boxes of infringing U.S. Patent No. 6,897,904. However, Microsoft continues to assert that these patents are also infringed by "other set-top boxes incorporating hardware and/or software that is substantially similar [to the BMC9012 and BMC9022D]" and "other set-top boxes [in addition to the DCT6416, DCH6416, and DCX3400] running software version 78.xx or substantially similar software." (Hoang Exh. M at ¶¶ 37, 174.)

Despite having been in possession of discovery relating to Motorola's set-top box products – including set-top boxes other than those listed above – for many months, and despite having deposed numerous Motorola employees (Schwentker ¶ 4), Microsoft has not alleged that any other product infringes either of these patents. Equally important, Microsoft has not introduced evidence of infringement regarding any other product. At this late date, when discovery relating to these patents and products is closed, and when both parties' expert reports and claim construction briefing has been exchanged, Microsoft should not be permitted to introduce evidence or testimony

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time of and for the purpose of litigation and thus can suffer from bias that is not present in intrinsic evidence."'). Here, the parties agreed in writing to more – no reliance on experts for purposes of claim construction. Microsoft should be held to its agreement.

alleging infringement of the '901 or '904 patents by any additional Motorola product. Any evidence regarding Motorola products not specifically accused of infringement at this date is untimely, irrelevant and likely to confuse the jury, and therefore should be excluded. *See* Fed. R. Evid. 401-403.

**IV. Motion *In Limine* No. 4: For Any Patent Claim As To Which Microsoft Did Not Have Its Experts Analyze Noninfringement Under Motorola's Proposed Claim Constructions, Microsoft Should Be Precluded From Introducing Expert Testimony Regarding Noninfringement If The Court Adopts Motorola's Constructions**

Motorola's technical experts analyzed Microsoft's infringement of Motorola's asserted patents under both parties' proposed claim constructions across all of Microsoft's asserted claims. Some of Microsoft's experts, however, did not. (*See, e.g.*, Hoang Exh. S at ¶ 65 (Dr. Craig Knoblock stated, "I have not been asked to analyze the claims for non-infringement under Motorola's proposed claim constructions.")) Where Microsoft's experts failed to render opinions of non-infringement under Motorola's proposed constructions, that expert should be precluded for offering any such opinion or testimony for the first time at trial.

The parties exchanged final claim constructions on June 3, 2011. (*See* Schwentker Exhs. B & C.) The parties exchanged opening expert reports on June 24, 2011 and rebuttal reports on July 7, 2011. Thus, by the time Microsoft's experts were required to serve rebuttal reports on noninfringement, they had had ample time (the same amount of time Motorola's experts had) to analyze noninfringement under both parties' constructions. Neither Microsoft nor its experts have offered any reason as to why certain of Motorola's proposed constructions were ignored on rebuttal. Nevertheless, in purposefully omitting such opinions from their experts' reports, neither Microsoft nor its experts should not be allowed to introduce any such opinions for the first time at trial. *See* Fed. R. Civ. P. 26(a)(2)(B), 26(e), 37(c)(1).

**V. Motion *In Limine* No. 5: Microsoft Should Be Precluded From Presenting Expert Testimony Regarding Infringement Of Microsoft's Asserted Patents Under The Doctrine Of Equivalents**

Under the doctrine of equivalents, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997). To support a finding of infringement under the doctrine of equivalents, Microsoft must present, on a limitation-by-limitation basis, "particularized testimony and linking argument as to the 'insubstantiality of the

differences' between the [claimed invention] and the [accused device or process], or with respect to the function, way, result test.” *Amgen Inc. v. F. Hoffman-La Roche Ltd.*, 580 F.3d 1340, 1382 (Fed. Cir. 2009) (quoting *Tex. Instruments v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1567 (Fed. Cir. 1996)). Microsoft has failed to do so for any of the Motorola products that Microsoft has accused of infringing its patents.

A patentee may not allege equivalence generally. Rather, the analysis must be performed on an element-by-element basis:

Each element contained in a patent claim is deemed material to defining to scope of the patented invention, and thus the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole.

*Warner-Jenkinson*, 520 U.S. at 29. Conclusory testimony by an expert as to the overall similarity of the patented and accused products is insufficient. See *Texas Instruments, Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1567 (Fed. Cir. 1996) (“Such evidence must be presented on a limitation-by-limitation basis. Generalized testimony as to the overall similarity between the claims and the accused infringer’s product or process will not suffice.”). Furthermore, “the doctrine of equivalents cannot merely be subsumed in [a plaintiff’s] case of literal infringement.” *Lear Siegler, Inc. v. Sealy Mattress Co. of Mich., Inc.*, 873 F.2d 1422, 1425 (Fed. Cir. 1989). If a plaintiff does not disclose a separate, factual basis, infringement under the doctrine of equivalents is properly precluded. *Nike, Inc. v. Wolverine World Wide, Inc.*, 43 F.3d 644, 648-49 (Fed. Cir. 1994).

Here, the statements provided by Microsoft and its experts are precisely the type of conclusory, non-specific analysis the Federal Circuit has deemed insufficient. Microsoft should therefore be precluded from doing so for the first time at trial. For example, Motorola’s interrogatories asked Microsoft to state whether Motorola’s “alleged infringement is literal, ***under the doctrine of equivalents***, or both” and to “describe in detail where each element, limitation, or step of each claim is found.” (Schwentker Exh. D.) But Microsoft’s responses did not provide ***any*** basis for alleged infringement based on the doctrine of equivalents. (See Schwentker Exhs. E-M.)

Nor did Microsoft’s technical experts provide sufficient information and analysis in their reports concerning infringement under the doctrine of equivalents. Instead, some of Microsoft’s experts’ reports and claim charts make only conclusory statements about the doctrine of equivalents. (See, e.g., Hoang Exhs. A at ¶ 22; B at ¶¶ 26, 100, 211; H at 6, 12; I at 6, 12; L at 48-49; M at ¶ 51; N at Exhibit C at 2.) Others did not discuss infringement based on the doctrine of equivalents at all. (See, e.g., Hoang Exhs. E, F, G, J, K.)



As an example of Microsoft's conclusory analysis under the doctrine of equivalents, its technical expert for U.S. Patent Nos. 6,785,901 and 6,897,904, Dr. Loren G. Terveen, stated:

To the extent that it is found that the '901 Accused Devices do not literally meet any of the elements of claim 1 of the '901 Patent, it is my opinion that the '901 Accused Devices would meet such claim element under the doctrine of equivalents. For each element of claim 1, the '901 Accused Devices perform substantially the same function, in substantially the same way, to achieve substantially the same result as the recited element. To the extent any difference exists at all, any difference between the claimed limitations of the '901 Patent and the '901 Accused Devices is insubstantial.

(Hoang Exh. M at ¶ 51.) Identical boilerplate language can be found throughout Dr. Terveen's report. (*See id.* at ¶¶ 60, 65, 70, 75, 80, 85, 92, 105, 110, 115, 127, 140, 145, 150, 159, 172, 201, 206, 213, 218.) This type of conclusory statement mirrors language that courts have found grossly inadequate to support expert testimony on infringement under the doctrine of equivalents, such as the following:

Even if the Retrobutton were found not to practice this claim element literally, it would still practice this element under the doctrine of equivalents because it performs substantially the same function in substantially the same way to achieve substantially the same result. This is so for the same reasons discussed above in conjunction with literal infringement.

*Smith and Nephew, Inc. v. Arthrex, Inc.*, No. 2:07-cv-335, 2010 WL 457142, at \*9 (E.D. Tex. Feb. 5, 2010).

Microsoft and its experts provide neither factual nor analytical bases for any conclusion of infringement by equivalence and, in particular, do not undertake the necessary limitation-by-limitation analysis, as required under the law. Because Microsoft has not provided any equivalence analysis on a limitation-by-limitation basis for any asserted claim, Microsoft should not be permitted to offer, for the first time at trial, purported evidence of infringement under the doctrine of equivalents. *See* Fed. R. Civ. P. 26(a)(2)(B)(i), 26(e), 37(c)(1). To do so would be "trial by surprise," and Motorola will be highly prejudiced by Microsoft's untimeliness and lack of candor.

**VI. Motion *In Limine* No. 6: Microsoft Should Be Precluded From Presenting Expert Testimony Regarding Indirect Infringement (Induced Or Contributory Infringement) Of Microsoft's Asserted Patents**

As with infringement under the doctrine of equivalents, Motorola's interrogatories specifically asked Microsoft to state "whether Microsoft contends that the alleged infringement is

direct infringement, induced infringement, and/or contributory infringement” and to “describe in detail where each element, limitation, or step of each claim is found.” (Schwentker Exh. D.) But again, Microsoft did not provide *any* basis for alleging indirect infringement (*i.e.*, infringement based on either induced infringement or contributory infringement). (Schwentker Exhs. E-M.) Nor did Microsoft’s experts provide sufficient information in their expert reports regarding induced infringement or contributory infringement of Microsoft’s patents. Rather, many of Microsoft’s experts made only conclusory statements about indirect infringement. (*See, e.g.*, Hoang Exhs. B at ¶¶ 28, 99, 213; M at ¶¶ 52, 61, 66, 71, 76, 81, 86, 93, 106, 111, 116, 128, 141, 146, 151, 160, 173, 202, 207, 214, 219.)

Accordingly, Microsoft should be precluded from presenting, for the first time at trial, purported evidence of induced infringement or contributory infringement of any of Microsoft’s patents. *See* Fed. R. Civ. P. 26(a)(2)(B), 26(e), 37(c)(1).

**VII. Motion *In Limine* No. 7: Microsoft Should Be Precluded From Presenting Expert Testimony On Source Code Relating To Features Microsoft Has Accused Of Infringing U.S. Patent Nos. 7,024,214 and 7,493,130**

Microsoft has accused Motorola Android products of infringing certain claims of U.S. Patent Nos. 7,024,214 (“the ‘214 patent”) and 7,493,130 (“the ‘130 patent”), both of which relate to synchronization of devices in a computer network. The asserted claims of these patents are directed to, for example, “a computer program product” or “computer-executable instructions.” Despite this express claim language, Microsoft’s technical expert for these two patents, Dr. Howard Jay Siegel, did not review or consider *any* source code in forming his opinions regarding infringement. (*See* Hoang Exhs. B & D.)

Motorola made the source code for all but one of the accused products available for inspection by Microsoft’s experts beginning on May 18, 2011.<sup>4</sup> (*See* Schwentker ¶ 17.) The source code was continuously available for inspection after that date, but Dr. Siegel never reviewed that source code, nor did Microsoft seek to have Dr. Siegel review the source code.

Because Microsoft’s expert did not review the relevant source code when forming his opinions on alleged infringement of the ‘214 and ‘130 patents, Microsoft should be precluded from presenting, for the first time at trial, expert testimony relating to this source code as part of any

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<sup>4</sup> Source code for the remaining product (Motorola’s Xoom tablet) was made available for inspection on June 20, 2011, following final release of the code.

effort to prove infringement of either of these patents. *See* Fed. R. Civ. P. 26(a)(2)(B)(i), 26(e), 37(c)(1).

**VIII. Motion *In Limine* No. 8: Microsoft Should Not Be Permitted To Suggest That Motorola Is Responsible For Any Purported Gaps In Microsoft's Understanding Of How Motorola's Accused Products Work**

As Microsoft has known for many months, Motorola's accused products use third party components. Motorola oftentimes does not have access to detailed technical documents and source code about these third party components. During discovery, Motorola informed Microsoft of this, and produced the relevant documents to which it did have access. For example, technical information for the Droid 2 accused product (and its components) can be found in the product's Bills of Materials and Theory of Operation Manual, among other documents. (*See, e.g.*, Hoang Exhs. T-X.) With respect to the accused set-top box products, system integration and function specifications made clear that software was provided by third parties, such as Rovi and Digeo. (*See, e.g.*, Hoang Exhs. Y-CC.) Microsoft thus had ample opportunity to seek discovery from relevant third parties to obtain further detailed technical information. However, Microsoft did not subpoena or otherwise request technical information from a single third party.<sup>5</sup>

Therefore, any gap in Microsoft's understanding of the products it has accused of infringement is of Microsoft's own making. Any attempt by Microsoft to suggest the contrary to the jury would not only be incorrect, but would also materially and unfairly prejudice Motorola and mislead the jury. *See* Fed. R. Evid. 403. Accordingly, Microsoft should not be permitted to make any such suggestion.

**IX. Motion *In Limine* No. 9: Microsoft Should Be Precluded From Relying On Representative Products To Prove Infringement**

Microsoft accuses 23 different Motorola Android-based products of infringing U.S. Patent Nos. 7,024,214 and 7,493,130. However, Microsoft's technical expert for these two patents, Dr. Howard Jay Siegel, inspected only three Motorola Android phones – the Motorola Droid 2, Droid X, and Backflip. (Hoang Exh. B at ¶ 80.) And in his infringement claim charts, Dr. Siegel limited his citations of technical documents to those for the Droid 2 and Droid X. (*See* Hoang Exhs. E at 1, n.1; F at 1, n.1.) Despite his failure to inspect, or cite technical documents for, the remaining 20

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<sup>5</sup> On July 7, the last day of discovery, Microsoft served seven subpoenas on third parties, but each was limited to requests for authentication. None had anything to do with information related to accused features. (*See* D.E. 107-113.)

accused phones, Dr. Siegel stated, “I have observed that all of the Motorola Android Devices share the same features (e.g., structures, functions, operations) relevant to infringement of the ‘214 and ‘130 patents.” (Hoang Exh. B at ¶ 82.) Dr. Siegel even went so far as concluding that a product that has not even been released yet (the Bionic) has the same features as Motorola’s other Android devices. (*Id.* at ¶¶ 78, 82.) Based on this conclusion, Dr. Siegel unilaterally “selected representative products from the Motorola Android Devices” for purposes of his infringement analysis. (*Id.* at ¶ 82.)

Similarly, Microsoft accuses the same 23 Motorola Android products of infringing U.S. Patent Nos. 6,897,853 and 6,791,536. Dr. Robert Stevenson, Microsoft’s technical expert with respect to these patents, in analyzing Motorola’s accused products against Microsoft’s ‘853 patent, noted in his report:

I have used the Droid 2 as an exemplary device in this Infringement Chart. I have reviewed the NPIs, user manuals, technical documents, design guides, and source code for all other Accused Products, made available by Motorola. These accused Android devices operate in a manner that is similar to the Droid 2 and while there are some differences in the source code, the underlying functionality is equivalent in the context of the ‘853 claims.

(Hoang Exh. K at ¶ 79.) Despite acknowledging that “there are some differences in the source code” among the 23 accused Motorola devices – but not offering any detail as to what those differences are – Dr. Stevenson concluded that all 23 devices infringe the asserted claims of the ‘853 patent. This conclusion is apparently based on his unsubstantiated conclusion that “the underlying functionality [of all accused products is] equivalent in the context of the ‘853 claims.” (Hoang Exh. K at ¶ 79). Dr. Stevenson did not provide any specific citations to any documentary or testimonial evidence to support his finding of infringement for any accused device other than the Droid 2.

Dr. Stevenson’s report was similarly lacking with respect to his infringement analysis of the ‘536 patent. He states in his report that “All Accused Products *seem to have similar functionality* for the purpose of the ‘536 patent except where indicated.” (Hoang Exh. G at ¶ 77 (emphasis added).) Instead of analyzing each product, Dr. Stevenson rests his conclusions on “seeming” similarities. In two particularly telling examples of the broad strokes that Dr. Stevenson uses in conducting his analysis: (1) he concludes that the accused Droid Bionic product infringes the ‘536 patent *even though he admits that there was no source code available* for it<sup>6</sup> (*Id.* at ¶ 69 (emphasis added)); and

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<sup>6</sup> Motorola’s Droid Bionic product is still in development and has not yet been released.

(2) he concludes that the Xoom product infringes even though he acknowledges that there are “software changes” in the product that cause certain features to “behave differently than the rest of the Accused Products” (*Id.* at 19, n.1).

Similarly, Microsoft accuses two Motorola set-top boxes of infringing U.S. Patent No. 6,785,901 and three Motorola set-top boxes of infringing U.S. Patent No. 6,897,904. Yet Microsoft’s expert for those two patents, Dr. Loren G. Terveen, tested only one product for each patent. (*See* Hoang Exh. M at ¶¶ 42, 179 n.12.)

Messrs. Seigel’s, Stevenson’s and Terveen’s grouping of representative products as a basis for infringement is improper. A plaintiff cannot select representative products based on conclusory statements that the products share the same features of functionality. *See Fujitsu Ltd. v. NETGEAR, Inc.*, No. 07-cv-710, 2009 WL 3047616, at \*3 (W.D. Wis. Sept. 18, 2009), *rev’d in part on other grounds*, 620 F.3d 1321 (Fed. Cir. 2010). Just as Microsoft has done here, the plaintiffs in *Fujitsu* tried to group the accused products when providing evidence of infringement by making generalized statements about the products sharing functionality and being part of the same family. In rejecting the plaintiff’s attempt, the court observed:

Grouping does not work when the only evidence supporting such grouping is merely that “*in general*, different versions of a product are part of the same family and have the same basic functionality.” Slight variations in product functionality may be the difference between infringement and non-infringement by that product, as shown by the test results of different versions of product WG11VCNA. Saying that products have the same “basic” functionality is not enough to justify grouping without evidence that the relevant features are identical. Accordingly, I will disregard plaintiffs’ attempts to group products or to group versions of products unless plaintiffs can cite actual evidence supporting the similar functionality of the products.

*Id.* at \*4 (internal citations omitted, emphasis in original).

Microsoft has the “burden to show specific instances of direct infringement for *each* accused product.” *Id.* at \*27 (emphasis in original). It has not even attempted to do so – either through product testing or citations to technical documentation. Instead, it has attempted to group products based on speculation and conclusory statements. Microsoft has failed to provide evidence that the few phones and set-top boxes it has selected are “representative products” and therefore should be precluded from relying on these products in trying to prove infringement of any other products.

Respectfully submitted,

July 21, 2011

By:           /s/Edward M. Mullins          

*Of Counsel:*

Jesse J. Jenner  
(admitted *pro hac vice*)  
Steven Pepe  
(admitted *pro hac vice*)  
Khue Hoang  
(admitted *pro hac vice*)  
Ropes & Gray LLP  
1211 Avenue of the Americas  
New York, NY 10036  
Telephone: (212) 596-9000  
Facsimile: (212) 596-9090

Norman H. Beamer  
(admitted *pro hac vice*)  
Mark D. Rowland  
(admitted *pro hac vice*)  
Gabrielle E. Higgins  
(admitted *pro hac vice*)  
Ropes & Gray LLP  
1900 University Avenue, 6<sup>th</sup> Floor  
East Palo Alto, CA 94303  
Telephone: (650) 617-4000  
Facsimile: (650) 617-4090

Lead Counsel for Plaintiff,  
MOTOROLA MOBILITY, INC.

Edward M. Mullins, Fla. Bar No. 863920  
emullins@astidavis.com  
Hal M. Lucas, Fla. Bar No. 0853011  
hlucas@astidavis.com  
Astigarraga Davis Mullins  
& Grossman, P.A.  
701 Brickell Avenue, 16th Floor  
Miami, FL 33131  
Tel.: (305) 372-8282; Fax. (305) 372-8202

Local Counsel for Plaintiff,  
MOTOROLA MOBILITY, INC.

**CERTIFICATE OF GOOD FAITH CONFERENCE**

Counsel for Motorola certifies that Motorola has made a good faith effort to consult with counsel for Microsoft regarding the issues raised in this motion. The parties, under the circumstances and without the benefit of the actual filings, were unable to agree on any issue in the motion. However, the parties have agreed to continue to discuss the matters forthwith and will notify the Court of any agreements on the issues, including, if necessary, the filing of agreed orders resolving same and/or the withdrawal of any agree-upon issue in this motion.

/s/Edward M. Mullins

Edward M. Mullins

## 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

Edward M. Mullins (Fla. Bar No. 863920)

### SERVICE LIST

*Motorola Mobility, Inc. v Microsoft Corporation*

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

United States District Court, Southern District of Florida

Curtis B. Miner  
[curt@colson.com](mailto:curt@colson.com)  
Colson Hicks Eidson  
255 Alhambra Circle  
Penthouse  
Coral Gables, Florida 33134

Jim S. Zeng\*  
[jzeng@sidley.com](mailto:jzeng@sidley.com)  
Theodore W. Chandler\*  
[tchandler@sidley.com](mailto:tchandler@sidley.com)  
Sandra S. Fujiyama\*  
[sfujiyama@sidley.com](mailto:sfujiyama@sidley.com)  
Michael C. Lee  
[michael.lee@sidley.com](mailto:michael.lee@sidley.com)  
Paul D. Tripodi, II\*  
[ptripodi@sidley.com](mailto:ptripodi@sidley.com)  
Erik J. Carlson\*  
[ecarlson@sidley.com](mailto:ecarlson@sidley.com)  
Olivia M. Kim\*  
[okim@sidley.com](mailto:okim@sidley.com)  
Christopher G. Wilson\*  
[cgwilson@sidley.com](mailto:cgwilson@sidley.com)  
Yongdan Li\*  
[yongdan.li@sidley.com](mailto:yongdan.li@sidley.com)  
Sidley Austin LLP  
555 West Fifth Street  
Los Angeles, California 90013

John W. McBride\*  
[jwmcbride@sidley.com](mailto:jwmcbride@sidley.com)  
David T. Pritikin\*  
[dpritikin@sidley.com](mailto:dpritikin@sidley.com)  
Douglas I. Lewis\*  
[dilewis@sidley.com](mailto:dilewis@sidley.com)  
Richard A. Cederroth\*  
[rcederroth@sidley.com](mailto:rcederroth@sidley.com)  
Erin E. Kelly\*  
[ekelly@sidley.com](mailto:ekelly@sidley.com)  
Shubham Mukherjee\*  
[smukherjee@sidley.com](mailto:smukherjee@sidley.com)  
Sherry A. Knutson\*  
[sknutson@sidley.com](mailto:sknutson@sidley.com)  
Stephen C. Carlson\*  
[scarlson@sidley.com](mailto:scarlson@sidley.com)  
Elizabeth Curtin\*  
[ecurtin@sidley.com](mailto:ecurtin@sidley.com)  
Neil H. Wyland\*  
[nwyland@sidley.com](mailto:nwyland@sidley.com)  
William M. Chang\*  
[wchang@sidley.com](mailto:wchang@sidley.com)  
Michael L. Lisak\*  
[mlisak@sidley.com](mailto:mlisak@sidley.com)  
Gerald L. Angst\*  
[ganst@sidley.com](mailto:ganst@sidley.com)  
Frank J. Favia, Jr.\*  
[ffaviajr@sidley.com](mailto:ffaviajr@sidley.com)  
Anthony Balkissoon\*  
[abalkissoon@sidley.com](mailto:abalkissoon@sidley.com)



Aseem S. Gupta\*  
[agupta@sidley.com](mailto:agupta@sidley.com)  
Sidley Austin LLP  
555 California Street, Suite 2000  
San Francisco, California 94104

David J. Wolfsohn\*  
[wolfsohn@woodcock.com](mailto:wolfsohn@woodcock.com)  
Woodcock Washburn LLP  
Cira Centre  
2929 Arch Street  
Philadelphia, Pennsylvania 19104

Tamar B. Kelber\*  
[tbkelber@sidley.com](mailto:tbkelber@sidley.com)  
Kathleen L. Holthaus\*  
[kholthaus@sidley.com](mailto:kholthaus@sidley.com)  
Sidley Austin LLP  
One S. Dearborn  
Chicago, Illinois 60603

Brian R. Nester\*  
[bnester@sidley.com](mailto:bnester@sidley.com)  
Sidley Austin LLP  
1501 K Street, N.W.  
Washington, DC 20005

Tung T. Nguyen\*  
[tnguyen@sidley.com](mailto:tnguyen@sidley.com)  
Nabeel U. Khan\*  
[nkhan@sidley.com](mailto:nkhan@sidley.com)  
Dale B. Nixon\*  
[dnixon@sidley.com](mailto:dnixon@sidley.com)  
Nicole D. Sims  
[nsims@sidley.com](mailto:nsims@sidley.com)  
Benjamin B. Kelly\*  
[bbkelly@sidley.com](mailto:bbkelly@sidley.com)  
Daniel J. Galligan\*  
[dgalligan@sidley.com](mailto:dgalligan@sidley.com)  
Sidley Austin LLP  
717 North Harwood, Suite 3400  
Dallas, Texas 75201

*Attorneys for Defendant*  
Electronically served via CM/ECF

*\*Admitted pro hac vice*