

**CONFIDENTIAL BUSINESS INFORMATION
SUBJECT TO PROTECTIVE ORDER**

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
MIAMI DIVISION

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

_____)
MOTOROLA MOBILITY, INC.,)
)
Plaintiff,)
)
vs.)
)
MICROSOFT CORPORATION,)
)
Defendant.)
_____)
MICROSOFT CORPORATION,)
)
Counterclaim Plaintiff,)
)
vs.)
)
MOTOROLA MOBILITY, INC.,)
)
Counterclaim Defendant.)
_____)

**DEFENDANT/COUNTERCLAIM PLAINTIFF MICROSOFT CORPORATION'S
OPPOSITION TO PLAINTIFF/COUNTERCLAIM DEFENDANT MOTOROLA
MOBILITY, INC.'S MOTIONS *IN LIMINE* NOS. 1-9**

Defendant/Counterclaim Plaintiff Microsoft Corporation ("Microsoft"), hereby submits its Opposition to Plaintiff/Counterclaim Defendant Motorola Mobility, Inc.'s Motions *in Limine* No. 1-9. (D.E. 129).

1. Expert Testimony Regarding Positions Not Timely and Adequately Disclosed.

The parties have resolved this motion, and will present the Court with a Stipulation setting forth their agreement.

2. Expert Testimony Regarding Claim Construction. The parties have resolved this

motion, and will present the Court with a Stipulation setting forth their agreement.

3. Products Not Specifically Accused of Infringement. Microsoft does not oppose

this motion *in limine* to the extent that Microsoft is not precluded from presenting evidence regarding Motorola's infringement related to set-top box products BMC9012, BMC9022D, DCT6416, DCH6416, and DCX3400.

4. Limitation on Expert Testimony Regarding Noninfringement. Motorola's motion

in limine should be denied because it is premature to limit expert testimony to any particular claim construction until the Court has construed the claims. Claim construction is a question of law that "is exclusively within the province of the court." *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996). While the parties have exchanged proposed claim constructions, the Court is not limited to these proposals and may construe the claims without adopting either parties' proposed constructions. As such, the opinions of Microsoft's expert witnesses may need to be revised and/or supplemented once the Court has construed the claims. Thus, since the claim construction process remains ongoing and the Court has not yet ruled, Motorola's motion is premature and should be denied. *See, e.g., Hochstein v. Microsoft Corp.*, Case No. 04-73071, 2009 U.S. Dist. LEXIS 57698, at *15 (E.D. Mich. July 7, 2009) (finding motions *in limine* pertaining to a claim term to be premature until the court had completed claim construction).

5. Expert Testimony Regarding Infringement of Microsoft's Patents Under the

Doctrine of Equivalents. Microsoft opposes this motion *in limine* because it is premature in light

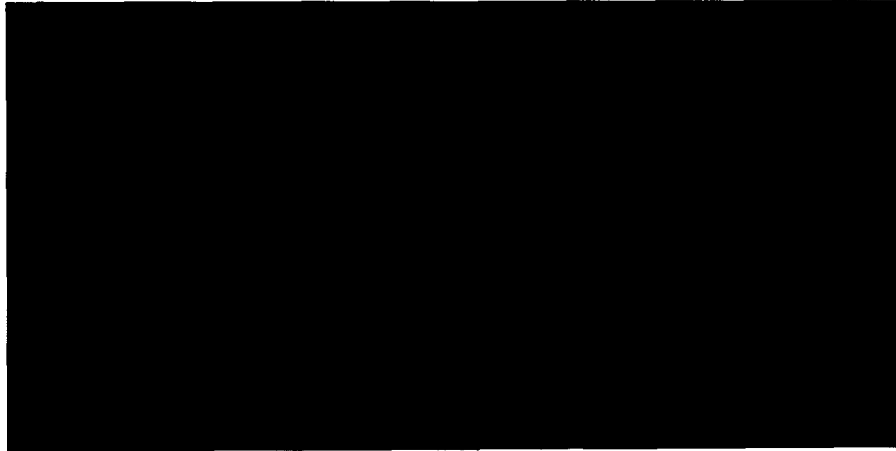
of the Court's pending ruling on claim construction. Infringement is a two part analysis: "First, the court determines the scope and meaning of the patent claims asserted ... [and secondly,] the properly construed claims are compared to the allegedly infringing device." *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998) (en banc) (citations omitted). This analysis is the same for both literal infringement and infringement under the Doctrine of Equivalents.

Innovation Toys, LLC v. MGA Entertainment, Inc., 637 F.3d 1314, 1318-1319 (Fed. Cir. 2011).

Microsoft's experts have each recognized that claim construction is pending and that they may need to revise their analysis once the Court has issued its construction. To preclude Microsoft's experts' testimony now before a proper infringement analysis can be completed would be severely prejudicial to Microsoft. Fed. R. Evid. 403. Irrespective of the Court's final claim construction, Microsoft's experts' testimony as to Motorola's alleged infringement under the Doctrine of Equivalents is highly relevant and should be admitted. Fed. R. Evid. 402.

6. Expert Testimony Regarding Indirect Infringement of Microsoft's Asserted Patents. Microsoft opposes this motion *in limine* to the extent that it proposes that Microsoft's experts who have previously opined on the topic of indirect infringement be precluded from providing related testimony on indirect infringement. Moreover, Microsoft opposes this motion *in limine* to the extent that it proposes that Microsoft be precluded entirely from presenting evidence on indirect infringement. Motorola criticizes Microsoft's experts for failing to perform a substantive analysis of indirect infringement—prior to the Court's construction of claims. *See Cybor Corp.*, 138 F.3d at 1454 (establishing that claim construction precedes the infringement analysis). However, this generalized criticism simply cannot be applied to all of Microsoft's experts. For example Dr. Howard Jay Siegel analyzed Motorola's infringement of U.S. Patent Nos. 7,024,214 ("the '214 patent") and 7,493,130 ("the '130 patent"). In addition to his well-

supported conclusions as to Motorola's direct infringement, Dr. Siegel also opined that Motorola indirectly infringed the '214 and '130 Patents:



(Ex. 1, Expert Report of Dr. Howard Jay Siegel Regarding Infringement of U.S. Patents Nos. 7,024,214 and 7,493,130, para. 213.) As shown, Dr. Siegel's preliminary analysis (prior to claim construction) is far from conclusory.

Moreover, Motorola has built a glass house—several of its technical experts have performed no indirect infringement analysis whatsoever. *See, e.g.*, Ex. 2, First Expert Report of Mr. Joel R. Williams Regarding Whether Certain Claims of U.S. Patent No. 6,983,370 Are Practiced by Defendant Microsoft Corporation; Ex. 3, First Expert Report of Scott Andrews Regarding Whether Certain Claims of U.S. Patent No. 6,757,544 Are Practiced by Defendant Microsoft Corporation. To the extent that Motorola proposes that Microsoft's experts be barred from presenting evidence of Motorola's indirect infringement, Microsoft cross-moves that Motorola's experts similarly be precluded from presenting evidence of Microsoft's alleged indirect infringement.

7. Expert Testimony on Source Code Relating to Features Microsoft Has Accused of Infringing '214 and '130 Patents. Motorola's motion *in limine* is based on its characterization of what was disclosed in Dr. Siegel's expert report on infringement. As mentioned above, Microsoft

does not dispute that expert witnesses should be precluded from presenting opinions that were not timely disclosed. To the extent that this Motion is in any way broader than Motion *in Limine* No. 1 (for which the parties have entered into a Stipulation), it should be denied as Motorola has not presented, nor could it present, a basis to grant this Motion. In further response to Motorola's Motion *in Limine* No. 7, Microsoft hereby incorporates by reference its Opposition to Motorola's Motion to Exclude the Testimony of Howard Jay Siegel Regarding Infringement, filed August 8, 2011.

8. Suggestion That Motorola is Responsible for Any Purported Gaps in Microsoft's Understanding of How Motorola's Accused Products Work. Motorola's motion *in limine* is premature and unnecessary. Motorola's attempt to obtain an omnibus ruling that Motorola is not responsible for any gaps in Microsoft's knowledge – regardless of whether Motorola had a discovery obligation to produce such information – is highly improper. Although Motorola purports to argue that some relevant information is in the possession of third parties, Motorola was clearly obligated to produce to Microsoft in discovery all responsive documents and information within its possession, custody or control. Fed. R. Civ. P. 34 (a). To the extent Motorola presents evidence during the course of the trial regarding the Accused Products that it has not shared with Microsoft, Microsoft reserves its right to object and to take any action necessary to ensure that it is not prejudiced.

9. Microsoft Should Be Precluded from Relying Upon Representative Products to Prove Infringement. Microsoft opposes this motion *in limine* because the differences between the Accused Products are immaterial to the functionalities accused. With regards to U.S. Patent Nos. 7,024,214, 7,493,130, 6,897,853, 6,79 [REDACTED]

[REDACTED] Each of Microsoft's experts who have submitted

technical reports relating to the aforementioned patents – Dr. Howard Siegel, Dr. Robert

Stevenson, and Michael Fagan – [REDACTED]

[REDACTED]
[REDACTED]
[REDACTED] Microsoft has made no secret that its target in this and related litigations with Motorola is the Android Operating System.

[REDACTED]
[REDACTED]¹ It is entirely appropriate that Microsoft's experts determine a subset of the accused devices are infringing,² establish that all the accused devices are the same within the context of the asserted claims [REDACTED]

[REDACTED]³ and conclude that the remaining accused devices function in a similar manner. The probative value of this approach far outweighs any prejudice to Motorola, prevents cumulative evidence, and avoids the unnecessary burden that Motorola's approach would place on the court. See Fed. R. Evid. 403.

¹ Indeed, it is likely that each of Microsoft's technical experts would arrive at similar conclusions with regards to mobile devices running the Android Operating System produced by OEMs other than Motorola (e.g., the HTC Incredible, or the Samsung Nexus S).

² Which each has done. *See, e.g.*, Ex. 4, Expert Report of Dr. Robert L. Stevenson Regarding Infringement of Claims 7-11 of U.S. Patent No. 6,897,853 para. 79 ("Stevenson Report #1") (using the Droid 2 as an exemplar); Ex. 5, Expert Report of Dr. Robert L. Stevenson Regarding Infringement of Claims 1, 16, 17, and 37-40 of U.S. Patent No. 6,791,536 para. 76 ("Steven Report #2") (using the Droid 2 as an exemplar); Ex. 1, Expert Report of Dr. Howard Jay Siegel Regarding Infringement of U.S. Patent Nos. 7,024,214 and 7,493,130 para. 112 ("Siegel Report") (using the Droid X, Droid 2 and Backflip devices as exemplars); Ex. 6, Expert Report of Michael Fagan Regarding Infringement of Claims 7-13 of U.S. Patent No. 7,383,460 paras. 66, 200, 113 ("Fagan Report") (using several Motorola Android devices as exemplars).

³ Again, which each has done. *See, e.g.*, Ex. 4, Stevenson Report #1, para. 79; Ex. 5, Stevenson Report #2, para. 77; Ex. 1, Siegel Report, para. 82; Ex. 6, Fagan Report paras. 66, 200, 257.

To support its motion, Motorola cites an unpublished case from a distant forum as controlling here. *See Fujitsu Ltd., v. Netgear Inc.*, No. 07-cv-710, 2009 WL 3047616 (W.D. Wis. Sept 18, 2009). In *Fujitsu*, the plaintiffs alleged that over 260 of the defendant's products infringed the asserted patents, based in part on the allegation that each product comported with the 802.11 wireless networking standard. *Id.* at *3-4. Because the plaintiffs were unable to present evidence that the relevant accused features were identical amongst all 260 products, plaintiffs created confusion instead of creating efficiencies. *Id.* The accused functionality in *Fujitsu* was disabled in the default setting: "fragmentation, that is, the patented method, is disabled by default on every accused product. Nothing in the manuals tells users that they have to enable fragmentation to use the products or even that they should." *Id.* at *86 (emphasis added). Because the "products can be used without enabling fragmentation" (*Id.*), the court required Philips to show evidence of direct infringement by users turning on the fragmentation function. *Fujitsu Ltd. v. Netgear, Inc.*, 620 F.3d 1321, 1326 (Fed. Cir. 2010). In contrast, Microsoft's experts have established [REDACTED]

[REDACTED] Thus these products, within the context of the Microsoft's alleged claims, have the *same* functionality.

The approach of Microsoft's experts is not based on speculation or conclusory statements. Taking Motorola's admonishment—that similar products cannot be grouped—to its logical conclusion would insist that Microsoft's experts test every single one of the millions of Android-based devices that Motorola has sold. In contrast, Microsoft and its experts have drawn a sensible line in light of the accused devices and the subject matter of the asserted claims. It is [REDACTED]

[REDACTED]

[REDACTED]

For instance, with respect to the '214 and '130 patents, Dr. Siegel reviewed technical documents, developer documents, and user guides for all of the accused Motorola Android Devices. For clarity, Dr. Siegel provided page-level citations primarily to documents related to sample devices. Dr. Siegel made clear, however, that he reviewed documents for all accused devices and that they contained similar information to the documents he cited explicitly. (*See* Ex. 1, Siegel Report, Exhibit I at 1, n. 1 and Exhibit J at 1, n. 1.). Dr. Siegel cited the Bates ranges of technical documents that he reviewed for each of the accused Motorola Android Devices. (*Id.*; *see also* Ex. 1, Siegel Report, Exhibit D (listing the technical documents reviewed and relied upon by Dr. Siegel).) [REDACTED]

[REDACTED]

[REDACTED] (*See* Ex. 7, Rebuttal Expert Report of Dr. Tal Lavian Regarding U.S. Patent Nos. 7,024,214 and 7,493,130, paras. 24, 47). That feature was used as an example in Dr. Siegel's infringement report, alongside many other examples directed at the same claim limitation. Furthermore, Motorola's expert, [REDACTED]

[REDACTED]

[REDACTED]

Lavian Dep. Tr. at 59. Thus, Motorola's contention that the Motorola Android devices cannot be analyzed using representative products is without merit, and the Motion should be denied.

Furthermore, with respect to the set top box patents, U.S. Patent Nos. 6,785,901 (“the ‘901 patent”) and 6,897,904 (“the ‘904 patent”), Microsoft’s expert Loren Terveen, has similarly

[REDACTED] (See Ex. 9, Expert Report of Loren G. Terveen Regarding Infringement of U.S. Patent Nos. 6,785,901 and 6,897,904 paras. 38, 174.) Consequently, these products (like the Android mobile devices), all share the same functionality with respect to the asserted claims. Microsoft’s reliance on representative products to prove infringement simply will not prejudice Motorola so as to outweigh the probative (and economical) value of this approach. Fed. R. Evid. 703.

CONCLUSION

For the foregoing reasons, Motorola’s Motions *in Limine* Nos. 1-9 (D.E. 129) should be denied in their entirety.

DATED this 8th day of August, 2011.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on August 8, 2011, I electronically filed the foregoing document with the Clerk of the Court using CM/ECF. I also certify that the foregoing document is being served this day on all counsel of record or pro se parties identified on the attached Service List in the manner specified, either via transmission of Notices of Electronic Filing generated by CM/ECF or in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

Respectfully submitted,

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