

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
MIAMI DIVISION

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

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

**MICROSOFT CORPORATION’S OPPOSITION TO MOTOROLA MOBILITY, INC’S
MOTION FOR USE OF REPRESENTATIVE CLAIMS**

Defendant/Counterclaim Plaintiff Microsoft Corporation (“Microsoft”) opposes Plaintiff/Counterclaim Defendant Motorola Mobility, Inc.’s (“Motorola”) Motion for Use of Representative Claims. (“Motorola Mot.”) (D.E. 121).

On November 10, 2010, Motorola filed a complaint accusing Microsoft of infringing seven different and unrelated patents.¹ Compl. at ¶¶ 7-13 (D.E. 1). Motorola contends that almost a dozen of Microsoft’s products, including Windows Phone 7 with Silverlight, Windows Live Messenger 2011, Exchange Server 2010 with Unified Messaging, and Bing Maps and Bing Local for cellular smartphones infringe Motorola’s patents. On December 23, 2010, Microsoft answered Motorola’s complaint and filed a counterclaim alleging that Motorola infringed seven of Microsoft’s patents.² Microsoft’s counterclaim contended that certain Motorola Android devices and digital video recorders (“DVRs”) infringe Microsoft’s patents. Counterclaim, at ¶¶ 15-49 (D.E. 21). In total, this litigation involves 14 separate patents, more than 30 accused products, and collectively more than 130 asserted claims across the patents-in-suit.

After choosing to bundle seven wholly unrelated patents into a single complaint and asserting more than 50 patent claims, Motorola contends that this case has become “unnecessarily complex and unwieldy.”³ Motorola Mot., p. 1 (D.E. 121). Instead of taking steps to streamline its case, which could potentially eliminate a need for any motion practice, Motorola now requests

¹ Specifically, Motorola contended that Microsoft violated U.S. Patent Nos. 5,502,839 (“the ‘839 patent”), 5,764,899 (“the ‘899 patent”), 5,784,001 (“the ‘001 patent”), 6,272,333 (“the ‘333 patent”), 6,408,176 (“the ‘176 patent”), 6,757,544 (“the ‘544 patent”) and 6,983,370 (“the ‘370 patent”) (collectively, “the Motorola Patents”). *See also discussion* pp. 6-7 n. 9. *infra* (describing the Motorola Patents).

² Microsoft alleged that Motorola violated U.S. Patent Nos. 6,791,536 (“the ‘536 Patent”), 6,897,853 (“the ‘853 Patent”), 7,024,214 (“the ‘214 Patent”), 7,493,130 (“the ‘130 Patent”), 7,383,460 (“the ‘460 Patent”), 6,897,904 (“the ‘904 Patent”), and 6,785,901 (“the ‘901 Patent”). Counterclaim at ¶¶ 8-14 (collectively, “the Microsoft Patents”).

³ On July 27, after Motorola filed its motion, Motorola withdrew eleven claims. Accordingly, Motorola is currently asserting 57 claims.

that this Court impose an utterly arbitrary 20 claim limit on Microsoft, which would disproportionately reduce the number of claims that Microsoft could present in prosecution of its counterclaim. In support of its argument to reduce the number of Microsoft's claims from 76 to 20, Motorola does nothing more than make a bare contention that Microsoft's claims are "duplicative." As the parties' voluminous claim construction briefs clearly illustrate, however, this overgeneralization is grossly inaccurate.⁴ In fact, Motorola's lone example of an alleged "duplicative" claim is contradicted by Motorola's own claim construction brief, in which it states that, while Microsoft's "130 patent is a continuation of the '214 patent...[,] *their claims are different.*" Motorola Op. Claim Construction Br., p. 78 n.23 (D.E. 123) (emphasis supplied).

Furthermore, Motorola's proposed 20 claim limit is wholly arbitrary, and Motorola has offered no factual or legal justification for this proposed limitation. Motorola's motion is also premature. As courts have routinely recognized, it should be left to the parties to narrow their claims and defenses as litigation progresses.⁵ See *Accolade Systems LLC v. Citrix Systems, Inc.*, Case No. 07-CV-48, at *2 (E.D. Tex. May 11, 2009) (D.E. 195) ("While the Court always encourages parties to focus their cases to the most relevant claims and references, the Court does not usually impose a limit on the number of claims and references because parties naturally withdraw claims and references that are not viable for use at trial.") (Group Exh. A). As the case progresses and after the Court issues its *Markman* ruling, the parties will in due course eliminate claims that no longer need to be tried.

⁴ The parties jointly requested this Court for leave to file 95-page opening briefs and 50-page response briefs on claim construction. (D.E. 122).

⁵ In fact, that is precisely what Microsoft has done, and will continue to do. For example, on August 4, 2011 Microsoft withdrew a total of sixteen claims of four patents (Microsoft Patents '130, '214, '460, '536). Thus, Microsoft is presently asserting 76 claims.

If Motorola wishes to simplify the case, there is absolutely nothing to prevent Motorola from voluntarily reducing the number of asserted claims. While Motorola states in its motion that it is amenable to reducing the number of claims to be tried from over 50 to 20 claims (Motorola Mot., p. 2), Motorola fails to identify the specific claims that Motorola does not believe it needs to take to trial. Motorola should identify those claims as expeditiously as possible, as a courtesy to this Court and Microsoft, given that the Court has been asked to render constructions on more than 130 claims. Indeed, Motorola's complaint that "the parties were forced to brief over 50 claim terms in its *Markman* submissions," (Motorola Mot., p. 3), is a problem of Motorola's own making—most of those terms are from Motorola's own patents.⁶ Accordingly, Motorola's motion to artificially reduce the number of Microsoft's triable claims should be denied.

ARGUMENT

Motorola's request for this Court to limit the number of claims to be tried to 20 per side would be highly prejudicial to Microsoft. Motorola's brief provides no support for forcing Microsoft to limit the number of its claims at this stage, much less forcing a draconian reduction in the number of Microsoft's asserted claims from 76 to 20.

A. Motorola's Attempt to Impose an Artificial Limitation on the Number of Microsoft's Claims Before this Court Issues its Markman Ruling is Premature and Improper.

On July 21, 2011, the parties filed their opening claim construction briefs. (D.E. 123-125.) Response briefs were due on August 8, 2011. Motorola filed the instant motion on July 21, before claim construction briefing was even completed. Courts have regularly found that

⁶ The out-of-district local rules cited by Motorola (Motorola Mot., pp. 6-7) discuss limitations on the number of claim terms to be presented to the court for construction. Here, to streamline the issues for the Court, the parties have already agreed to limit the number of claim terms for construction to 25 per party (not including claim terms written in "means-plus function" language which must be construed by the Court). (D.E. 51). Of the 63 terms addressed in the parties' opening claim construction briefs, the substantial majority (51) are from Motorola's patents. Only eleven are from Microsoft's patents. (D.E. 123-125, 134-135).

ordering a party to reduce the number of claims prior to the court's claim construction ruling is inappropriate and prejudicial. *See e.g., Fractus S.A. v. Samsung Electronics, Co., Ltd.*, No. 6:09-CV-203 (E.D. Tex. Mar. 8, 2010) (D.E. 332) (rejecting limitation prior to end of claim construction where patentee asserted 148 claims because, in part, "[t]he risk of prejudice to Plaintiff is not adequately offset by increases in efficiency and manageability") (Group Exh. A); *SPH America, LLC v. High Tech Computer Corp.*, No. 08-CV-2146, *3 (S.D. Cal. Mar. 4, 2009) (D.E. 121) (declining to reduce the number of claims from 253 because "the risk of prejudice exists") (Group Exh. A). The parties are in agreement that this Court will construe the meanings of the disputed claim terms, and until this Court has rendered its constructions, Motorola is not in a position to speculate as to which, if any, of Microsoft's claims purportedly "overlap."

Motorola's attempt to unilaterally force Microsoft to take some claims to trial and abandon others before the Court issues its *Markman* Order is nothing more than a back-door attempt to impose its subjective constructions on Microsoft's claims. If Motorola believed that Microsoft's claims were entirely duplicative, Motorola should have addressed the matter in its claim construction briefing, not in a motion to arbitrarily limit the number of Microsoft's triable claims. For good reason, Motorola failed to make any argument of redundancy in its opening claim construction brief. In addition, despite Motorola's assertion that "many of the claims at issue are duplicative of each other or generally redundant," (Motorola Mot., p. 2; D.E. 121), Motorola cites only one example of so-called duplication that implicates only two out of 76 Microsoft claims. Specifically, Motorola argues that Claim 1 of the '214 patent and Claim 2 of the '130 patent are identical beyond their respective "preambles." Motorola's argument, however, is contradicted by its own claim construction brief, in which Motorola stated that, while the "'130 patent is a continuation of the '214 patent...[,] *their claims are different.*" Motorola

Op. Claim Construction Br., p. 78 n.23 (D.E. 123) (emphasis supplied). Additionally, by inexplicably ignoring the preambles, Motorola fails to acknowledge that these two claims address different subject matters. Claim 1 of the ‘214 patent is directed towards a method of operation for a product, whereas Claim 2 of the ‘130 patent is directed towards a computer system product. *See* Motorola Mot., p. 4 (setting forth the preambles of each claim).⁷ Furthermore, while Motorola complains that “with regard to the ‘214 and ‘130 patents alone, Microsoft asserts some 50 claims,” (Motorola Mot., p. 5), Microsoft has voluntarily withdrawn its assertion of 12 claims under those patents. Moreover, many of those claims do not add significant complexity to the case at all. For example, Claim 10 of the ‘214 patent adds only the limitation that the accused device comprise a mobile telephone.

Nor do the number of asserted claims of these patents present an undue burden on the Court in terms of claim construction – there are only three disputed claim terms for the ‘214 and ‘130 patents combined. As these claim terms appear in every independent claim under the patents, they would need construction even if Microsoft withdrew all but one of the asserted claims for these two patents. Furthermore, the seven patents asserted by Microsoft altogether account for only eleven of the 50+ claim terms proposed by the parties for construction. In sharp contrast, Motorola’s ‘839 patent *alone* requires the Court to construe sixteen distinct claim terms.

⁷ As a result, the direct infringer of the two claims could be different. The direct infringer of Claim 1 of the ‘214 patent could be end users of the accused Motorola products, upon their operation of the products to perform in a way that meets the limitations set forth in Claim 1. This is in contrast with Claim 2 of the ‘130 patent, where the direct infringer could be Motorola itself, upon Motorola’s use, sale, or offer for sale of the accused Motorola products, each of which is a computer system that meets the limitations of Claim 2.

Significantly, reducing the number of asserted claims of the Microsoft patents will have little impact on the number of terms to be construed by the Court.⁸

B. If Motorola Wishes to Streamline the Case, It Should Withdraw Unnecessary Claims.

Motorola's motion arises out of its view that this case is too large and complex for a jury. *See, e.g.*, Motorola Mot., p. 2 ("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 a threshold matter, Motorola's complaint about the scope and complexity of this case is a problem of its own making. Motorola was the master of its complaint and made the conscious choice to file a lawsuit implicating seven unrelated patents and dozens of accused products.⁹

⁸ Motorola's citation to *In re Katz Interactive Call Processing Litig.*, 639 F.3d 1303 (Fed. Cir. 2011), is misplaced and does not require this Court to impose a limitation on Microsoft. (Motorola Mot., p. 6). The plaintiff in *Katz* "did not question the need to limit the number of claims in order to make the case manageable." *Id.* at 1309. When *Katz* later contended that certain claims that he had originally failed to designate as representative claims were unique, he never attempted to make such a showing, as was permitted by the district court's order. Instead, he asked the court to sever and stay the non-selected claims. *Id.* at 1310. The Federal Circuit held that if *Katz* had made a showing of uniqueness and if the "district court had refused to permit *Katz* to add those specified claims, that decision would be subject to review and reversal." *Id.* at 1312-13. Here, not only has Motorola failed to make a "convincing showing that many of the claims are duplicative," (*id.* at 1311), the law would require that Microsoft be given an opportunity at a later point in the case, including after this Court rules on claim constructions, to request this Court to expand the number of representative claims to be tried. *Cf. Stamps.com, Inc. v. Endicia, Inc.*, 2011 WL 2417044, *3 (Fed. Cir. June 15, 2011) (cited in Motorola Mot., p. 6) (noting that limitations on claim constructions were not immutable). To avoid unnecessary rounds of motion practice, the parties should have an opportunity to conduct a self-evaluation of their claims after this Court issues claim construction rulings and as the litigation progresses.

⁹ Motorola describes its seven patents as: (1) teaching a new approach for managing the delivery of data to a portable, wireless device in a limited-bandwidth environment (the '333 patent) (Motorola Op. Claim Construction Br., p. 7) (D.E. 123), (2) enabling a smart phone to initiate a phone call by using information stored in a voice mail message (the '176 patent) (*id.* at 13); (3) enabling a user to continue an IM session started on one device on another device (the '370 patent) (*id.* at 21); (4) displaying alphanumeric messages that correspond to a key word appearing in the message (the '001 patent) (*id.* at 36); (5) disclosing a new approach to determining a location relevant to a point of interest, such as a nearby airport (the '544 patent) (*id.* at 48); (6)

If Motorola now wishes to scale back the scope of its complaint, the solution is not to arbitrarily limit the number of claims that Microsoft may present at trial – a proposition that exclusively favors Motorola. Nor should Motorola’s willingness to identify its representative claims be contingent on a prior agreement from Microsoft to limit its own claims in a vacuum. Indeed, recognizing that further dialogue between the parties would be required, Motorola requests this Court to order a meet and confer to discuss Motorola’s proposed limitations. Motorola Mot., p. 7 (“Motorola . . . also requests that the Court direct the parties to meet and confer in order to discuss and refine the representative claims, as well as the effect such claims would have on the remaining issues in the case”). As courts have recognized, it should be left to the parties to narrow their claims and defenses as litigation progresses. *See Accolade Systems LLC v. Citrix Systems, Inc.*, Case No. 07-CV-48, at *2-3 (E.D. Tex. May 11, 2009) (D.E. 195) (“While the Court always encourages parties to focus their cases to the most relevant claims and references, the Court does not usually impose a limit on the number of claims and references because parties naturally withdraw claims and references that are not viable for use at trial.”) (Group Exh. A); *cf. Thomson, S.A. v. Quixote Corp.*, 166 F.3d 1172, 1173 (Fed. Cir. 1999) (cited in Motorola Mot., p. 5) (use of representative claims was by agreement); *Baxter Int’l, Inc. v. COBE Laboratories, Inc.*, 88 F.3d 1054, 1056 (Fed. Cir. 1996) (cited in Motorola Mot., p. 5) (stipulation to use representative claims).

Indeed, both sides, without any need for this Court’s intervention or micromanagement, have voluntarily dismissed claims as fact and expert discovery have progressed. To date,

minimizing the amount of data transmitted in a reply e-mail (the ‘899 patent) (*id.* at 53); and (7) “disclos[ing] software that interacts with ‘virtual’ representations of input and output (‘I/O’) data, rather than ‘real’ or physical I/O devices (such as a mouse, keyboard, screen or printer)” (the ‘839 patent) (*id.* at 59). As Motorola’s descriptions illustrate, these patents are not all related to one another, dependent on one another, or cover the same subject matters.

Motorola has withdrawn sixteen claims and Microsoft has also withdrawn sixteen claims. If Motorola wishes to withdraw any additional claims, it is free to do so. Microsoft will, in turn, continue to evaluate its claims as this litigation progresses and after this Court rules on the parties' proposed claim constructions. *See* Section A, above. Simply put, there is no need for the Court at this juncture to impose an arbitrary limit on the number of Microsoft's claims.¹⁰

C. Motorola's Proposed 20 Claim Limit is Wholly Arbitrary and Lacks Any Basis.

Finally, Motorola's selection of a 20 claim limit per side is pulled out of thin air. Motorola has offered absolutely no factual or legal justification for this proposed limitation, which would prejudice Microsoft and require a disproportionate reduction in the number of Microsoft's triable claims. Motorola does not tie this proposed limitation to any discussion of the individual patents, accused products, claims, or the evidence that may be presented to the jury in this case. After having determined that it only needs to try a fraction of its asserted claims, Motorola has asked this Court to impose significant limitations on Microsoft's prosecution of its counterclaims. As Motorola acknowledges, Microsoft is currently asserting 76 claims, 18 more claims than Motorola. There is no basis for requesting this Court to impose such a draconian reduction in the number of Microsoft's claims just because Motorola wishes to simplify the presentation of its own case.

CONCLUSION

¹⁰ Motorola cites *ReRoof Am., Inc. v. United Structures of Am., Inc.*, 1999 WL 674517, *4 (Fed. Cir. Aug. 30, 1999), for the proposition that the "district court did not abuse [its] discretion in requiring plaintiff to use representative claims in lieu of large number of claims at issue." (Motorola Mot., p. 6). However, the *ReRoof* court never made such a finding. Rather, the court stated that "[i]t is unnecessary for us to decide whether the trial court[.]...was error in the circumstances of this case, because ReRoof has not shown that it was prejudiced by the court-ordered reduction in the number of claims it was allowed to present to the jury." *Id.* at *4. Here, there is no doubt that a court-ordered reduction in the number of claims, based purely on Motorola's unsupported subjective characterizations of those claims as "duplicative," would prejudice the prosecution of Microsoft's counterclaims.

For the reasons stated above, Motorola's motion is unnecessarily premature and, if granted, would unduly prejudice Microsoft at trial. Accordingly, Motorola's motion should be denied.

Dated: August 8, 2011

Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on the 8th day of August, 2011, I electronically filed the foregoing document with the Clerk of the Court, using the CM/ECF system, which will automatically send email notification of such filing to all counsel who have entered an appearance in this action.

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