

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.)
_____)

**MICROSOFT CORPORATION’S S.D. FLA. L.R. 7.5(c) STATEMENT OF MATERIAL
FACTS WITH NO GENUINE ISSUE FOR TRIAL IN OPPOSITION
TO MOTOROLA MOBILITY’S MOTION FOR SUMMARY JUDGMENT
OF INFRINGEMENT AND INVALIDITY**

Pursuant to Local Rule 7.5(c), Defendant and Counterclaim Plaintiff Microsoft Corp. ("Microsoft") submits the following Statement of Material Facts in support of its Opposition to Motorola Mobility, Inc.'s ("Motorola") Motion for Summary Judgment of Infringement and Invalidity. (D.E. 126):

1. Disputed in Part. For reasons unrelated to the filing of this motion, Microsoft has withdrawn claims 16 and 17 of the '536 patent.

2. Not disputed for the purposes of this motion only.

THE '536 PATENT

3. Not disputed for the purpose of this motion only.

4. Not disputed for the purpose of this motion only.

5. Not disputed for the purpose of this motion only.

6. Not disputed for the purpose of this motion only

7. Disputed in part. The '536 Patent describes a method and apparatus for simulating at least one gesture of a pointing device such as a mouse. This at least one gesture may be simulated by use of a pointing device such as a stylus. (Ex. 1, U.S. Patent No. 6,791,536 2:57-60.)

8. Not disputed for the purpose of this motion only.

9. Not disputed for the purpose of this motion only.

10. Not disputed for the purpose of this motion only.

11. Not disputed for the purpose of this motion only.

12. Not disputed for the purpose of this motion only.

13. Not disputed for the purpose of this motion only.

14. Not disputed for the purpose of this motion only.

15. Not disputed for the purpose of this motion only.

16. Not disputed for the purpose of this motion only.

17. Not disputed for the purpose of this motion only.

18. Disputed. Nowhere in Dr. Stevenson's Rebuttal Report does he reference Harada as disclosing a "touch-sensitive display." (Ex. 6, U.S. Patent No. 6,657,615 3:59-60.)

19. Disputed in part. Dr. Stevenson proffers no opinion whether Harada discloses a stylus. Instead, Dr. Stevenson repeatedly states that Harada does not disclose certain uses of a stylus (holding in place or dragging the stylus) that comport with the use of a stylus as described in the '536 patent (*See generally* Ex. 5, Rebuttal Expert Report of Dr. Robert L. Stevenson Regarding Validity of U.S. Patent No. 6,791,536 paras. 40-56.)

20. Disputed in part. Dr. Stevenson proffers no opinion as to whether Harada discloses a two-button mouse. (*See generally* Ex. 5, Rebuttal Expert Report of Dr. Robert L. Stevenson Regarding Validity of U.S. Patent No. 6,791,536.)

21. Not disputed for the purpose of this motion only.

THE '853 PATENT

22. Not disputed for the purpose of this motion only.

23. Not disputed for the purpose of this motion only.

24. Disputed in part. Of the asserted claims (claims 7 through 11), only claim 7 is independent.

25. Not disputed for the purpose of this motion only.

26. Not disputed for the purpose of this motion only.

27. Not disputed for the purpose of this motion only.

28. Not disputed for the purpose of this motion only.

29. Disputed. Microsoft's infringement contentions detail Motorola's infringement of at least claim 7 of the '853 patent. (Ex. 16, 4/28/2011 Microsoft's Supplemental Responses to Motorola's First Set of Interrogatories (Nos. 4-6, 9-10 and 15), pp. 93-100.)

30. Disputed. Microsoft's infringement contentions detail Motorola's infringement of at least claim 7 of the '853 patent including the process by which a representative Motorola device infringes. Microsoft's infringement contentions are directed towards Motorola's infringement through its various Android-based products. (Ex. 16, 4/28/2011 Microsoft's Supplemental Responses to Motorola's First Set of Interrogatories (Nos. 4-6, 9-10 and 15), pp. 93-100.)

31. Disputed. The entirety of Dr. Stevenson's Expert Report Regarding Infringement analyzes Motorola's infringement of the '853 patent. Dr. Stevenson has considered the distinction between direct and indirect infringement, and Dr. Stevenson has concluded that Motorola's products infringe the '853 patent. As such, Dr. Stevenson's report is directed toward Motorola's infringement, direct and indirect, through its various Android-based products. (Ex. 8, Exhibit C to Stevenson '853 Infringement Report.)

32. Disputed. The entirety of Dr. Stevenson's Exhibit C to his Expert Report Regarding Infringement analyzes Motorola's infringement of the '853 patent. Dr. Stevenson has considered the distinction between direct and indirect infringement, and Dr. Stevenson's concluded that Motorola's products infringe the '853 patent. As such, Dr. Stevenson's Exhibit C to Dr. Stevenson's report is directed toward Motorola's infringement, direct and indirect, through its various Android based products. (Ex. 8, Exhibit C to Stevenson '853 Infringement Report.)

THE '904 PATENT

33. Not disputed for the purpose of this motion only.

34. Disputed in part. U.S. Patent No. 6,897,904 (“the '904 Patent”) is generally directed to systems and methods for selecting among multiple tuners to tune to a particular channel, for allowing a user to record a program with a tuner while watching a different program with another tuner without requiring any user input concerning selection of tuners, and when the user switches back to a channel that is being recorded, for providing an indication that the user is now watching a recorded program. (Motorola’s Kao Ex. 8, the '904 Patent.)

35. Disputed in part. Microsoft asserted that Motorola infringes claims 12 and 18-20 of the '904 Patent. Microsoft identified the accused products for the '904 Patent as set-top boxes with digital video recording (DVR) functionality and two or more tuners, as well as associated software, including the DCT6416, DCH6416 and DCX3400 and other set-top boxes running software version 78.xx or substantially similar software. (Ex. 10, 04/05/11 Microsoft’s Infringement Contentions; *see also* Motorola’s Hoang Exs. M and N, Terveen Report.)

36. Not disputed for the purpose of this motion only.

37. Not disputed for the purpose of this motion only.

38. Not disputed for the purpose of this motion only.

39. Not disputed for the purpose of this motion only.

40. Not disputed for the purpose of this motion only.

41. Disputed. Microsoft’s infringement contentions accuse Motorola of directly infringing the asserted claims of the '904 Patent. (Ex. 10, 04/05/11 Microsoft’s Infringement Contentions.) Microsoft’s infringement contentions state: “Motorola has infringed, induced infringement of and/or contributorily infringed and continues to infringe, induce infringement of

and/or contributorily infringe the Asserted Claims literally and/or under the doctrine of equivalents.” (*Id.* at 2.)

42. Disputed. Microsoft’s infringement contentions contend that Motorola indirectly infringes the asserted claims of the ’904 Patent. (Ex. 10, 04/05/11 Microsoft’s Infringement Contentions.) Microsoft’s infringement contentions state: “Motorola has infringed, induced infringement of and/or contributorily infringed and continues to infringe, induce infringement of and/or contributorily infringe the Asserted Claims literally and/or under the doctrine of equivalents.” (*Id.* at p. 2.)

43. Undisputed.

44. Disputed. The Terveen Report refers to the deposition of Jeffrey Newdeck.

(Motorola’s Hoang Exs. M and N.)

(Ex. 15, 06/28/11 Newdeck Dep. at 20:14-22:4.) The Terveen Report also

refers to a number of user guides of the accused products. (Motorola’s Hoang Exs. M and N.) In addition, Dr. Terveen tested and used one of the accused products to confirm his conclusions.

(*Id.*)

45. Disputed. For each of the asserted claims, the Terveen Report refers to Motorola

as discussed in the Report. (Motorola’s Hoang Exs. M and N.)

46. Disputed. For each of the asserted claims, the Terveen Report refers to Motorola

and refers to Motorola’s documents, including user manuals. (Motorola’s Hoang Exs. M and N.)

47. Disputed. The Terveen Report refers to the deposition of Jeffrey Newdeck.

(Motorola's Hoang Exs. M and N.)

(Ex. 15, 06/28/11 Newdeck Dep. at 20:14-22:4.)

48. Disputed. *See, e.g.*, Responses to Paragraphs 41, 42, 44, 45 and 46 above.

49. Not disputed for the purpose of this motion only.

50. Not disputed for the purpose of this motion only.

THE '901 PATENT.

51. Not disputed for the purpose of this motion only.

52. Disputed in part. Microsoft asserted that Motorola infringes claims 1-3, 5-6, 8-9, 11, 22-23, 25, 27-29, 31, 33 and 35 of U.S. Patent No. 6,785,901. Microsoft identified the accused products of the '904 Patent as set-top boxes with digital video recording (DVR) functionality and parental control functionality, as well as associated software, including but not limited to BMC9012 and BMC9022D. (Ex. 10, 04/05/11 Microsoft's Infringement Contentions.)

53. Not disputed for the purpose of this motion only.

54. Disputed in part. Claims 27-29, 31, 33 and 35 are apparatus claims. (Motorola's Kao Ex. 10, the '901 Patent.)

55. Not disputed for the purpose of this motion only.

56. Disputed. Microsoft's infringement contentions accuse Motorola of directly infringing the asserted claims of the '901 Patent. (Ex. 10, 04/05/11 Microsoft's Infringement Contentions.) Microsoft's infringement contentions state: "Motorola has infringed, induced infringement of and/or contributorily infringed and continues to infringe, induce infringement of

and/or contributorily infringe the Asserted Claims literally and/or under the doctrine of equivalents.” (*Id.* at 2.)

57. Disputed. Microsoft’s infringement contentions contend that Motorola indirectly infringes the asserted claims of the ’901 Patent. (Motorola’s Kao Ex. 11.) Microsoft’s infringement contentions state: “Motorola has infringed, induced infringement of and/or contributorily infringed and continues to infringe, induce infringement of and/or contributorily infringe the Asserted Claims literally and/or under the doctrine of equivalents.” (*Id.* at p. 2.)

58. Disputed. The Terveen Report refers to the deposition of Robert Shuff. (Motorola’s Hoang Exs. M and N.) [REDACTED] [REDACTED] (Ex. 9, 06/16/11 Shuff Dep. at 48:2-4.) The Terveen Report also refers to a number of user guides of the accused products. (Motorola’s Hoang Exs. M and N.) In addition, Dr. Terveen tested and used one of the accused products. (*Id.*)

59. Disputed. For each of the asserted claims, the Terveen Report refers to Motorola [REDACTED] as discussed in the Report. (Motorola’s Hoang Exs. M and N.)

60. Disputed in part. [REDACTED] [REDACTED] [REDACTED] (Ex. 9, 06/16/11 Shuff Dep. at 48:2-4.)

61. Disputed in part. [REDACTED]

[REDACTED]

(Ex. 9, 06/16/11 Shuff Dep. at 48:2-4.)

62. Disputed. Microsoft's infringement contentions cite to evidence indicating that the accused products include Motorola's BMC boxes made, used, sold and/or offered to sell by Motorola. (Ex. 10, 04/05/11 Microsoft's Infringement Contentions.) [REDACTED]

[REDACTED]

(See, e.g., Ex. 9, 06/16/11 Shuff Dep. at 48:2-4.)

63. Disputed. The Terveen Report cites to evidence indicating that the accused products include Motorola's BMC boxes made, used, sold and/or offered to sell by Motorola. (Motorola's Hoang Exs. M and N.) [REDACTED]

[REDACTED]

[REDACTED] (See, e.g., Ex. 9, 06/16/11 Shuff Dep. at 48:2-4.)

64. Disputed. See, e.g., Responses to Paragraphs 62 and 63 above.

65. Disputed. The Terveen Report indicates that Motorola's accused set-top boxes with digital video recording (DVR) functionality and parental control functionality, as well as associated software, including but not limited to BMC9012 and BMC9022D, are infringing the '901 Patent. [REDACTED]

[REDACTED]

[REDACTED]

66. Not disputed for the purpose of this motion only.

67. Not disputed for the purpose of this motion only.

**ADDITIONAL MATERIAL FACTS IN SUPPORT OF MICROSOFT'S
OPPOSITION TO MOTOROLA'S MOTION FOR SUMMARY JUDGMENT**

68. Stephen Moore, Motorola's 30(b)(6) corporate designee, testified that as part of

[REDACTED]

[REDACTED] (Ex. 19, Deposition of Stephen Moore at 11:12-13:25; 50:21-59:21, 23:20-28:21.)

69. Mr. Moore also testified that, [REDACTED]

[REDACTED]

[REDACTED] (Ex. 19, Deposition of Stephen Moore at 12:23-16:24.)

70. Mr. Moore als [REDACTED]

[REDACTED]

(Ex. 19, Deposition of Stephen Moore at 60:7-65:2.)

71. [REDACTED]

[REDACTED]

[REDACTED] (Ex. 11, [REDACTED])

[REDACTED] MOTO-MS-002021096 to -1124, p. 5.)

72. [REDACTED]

[REDACTED]

[REDACTED] (Ex. 11, [REDACTED])

[REDACTED] MOTO-MS-002021096 to -1124 pg. 6-11.)

73. [REDACTED]

[REDACTED] (Ex. 12,

[REDACTED] MOTO-MS-002517344.)

74. [REDACTED]

[REDACTED] (Ex. 13,

[REDACTED] MOTO-MS-000054350.)

75. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] (Ex. 14, [REDACTED])

[REDACTED] MOTO-MS-005128693 to MOTO-MS-005128704, p. 5.)

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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