

**UNITED STATES DISTRICT COURT
DISTRICT OF NEW MEXICO**

STC.UNM,

Plaintiff,

v.

INTEL CORPORATION,

Defendant.

Civil No. 10-CV-01077-RB-WDS

**STCUNM'S SURREPLY TO INTEL'S MOTION
FOR SUMMARY JUDGMENT OF UNENFORCEABILITY**

Intel submits a new declaration and a new exhibit in its Reply Brief on its Motion for Summary Judgment. The new “evidence” is aimed at establishing that Sandia National Laboratories is a legal entity. However, the evidence already of record, from a Sandia Corporation Rule 30 (b)(6) witness (Sandia’s Chief Patent Counsel), establishes that:

“... Sandia National Laboratories is essentially the facilities that are owned by the Department of Energy. And we are contractor operated by Sandia Corporation, which is the legal entity, actually, which runs Sandia National Labs.

~~~

[Sandia Corporation] manages Sandia National Laboratories which is effectively the facilities out there, but it also, you know, it is a trademark owned by the Department of Energy, Sandia National Laboratories, but, we *do business as Sandia National Laboratories* so I think most of the public knows us as Sandia National Laboratories.”

Bieg [Ex U], at 8:18-9:9 (emphasis added). Thus, viewing Intel’s new evidence in its best light only moves this factual matter from the category of clearly established against Intel to the category of “genuine issue of material fact.” Either way, Intel loses.

Further, unlike Intel, STC.UNM obtained the underlying public records available for a sample of 20 patents of the 323 identified by Intel. Dec. of K. Vogt at ¶¶2-3. The documents obtained reveal that all of the underlying assignments identify Sandia Corporation as the entity assigned

the ownership interest. Dec. of K. Vogt; Exs 7 & 8. These documents establish that Sandia Corporation had a practice of identifying Sandia National Laboratories on the cover sheet as the party receiving the assignment and identifying Sandia Corporation in the assignment as the real party receiving the assignment. This interchangeable use of the two designations to refer to the same entity confirms that Sandia National Laboratories is indeed a DBA of Sandia Corporation as Mr. Bieg testified.

Finally, Intel's Reply Brief devotes a substantial portion of its reply (at 3-6), that it glossed over in its principal brief (fleeting references and no legal authority, at 8, 10, 18), viz., whether there was co-ownership prior to December 1, 2011 as a result of Draper's contribution to the invention. Whether the Court finds that co-ownership has always existed (Resp. at 10-11), or came into existence once the Patent Office issued the Certificate of Correction (Resp. at 8-10), the "claims" of the '998 patent need not have been invented by Draper for Sandia Corp. and STC.UNM to enjoy common in the '321 and '998 patents. *See* Resp. at 12. Intel cites to no authority to establish the incorrect legal theory it posits, *i.e.*, common owners of an invention do not enjoy common ownership in continuing patents. This is because the opposite is true. *See* Resp. Br. at 9-11 (*citing SiRF Tech., Inc. v. ITC*, 601 F.3d 1319, 1326 (Fed. Cir. 2010); *Abraxis Bioscience, Inc. v. Navinta LLC*, 625 F.3d 1359, 1364 (Fed. Cir. 2010); *Hendrie v. Sayles*, 98 U.S. 546, 554-555 (U.S. 1879); *E.I. Du Pont de Nemours & Co. v. Okuley*, 2000 U.S. Dist. LEXIS 21385, at \*80 (S.D. Ohio Dec. 21, 2000).

Dated: March 6, 2012

Deron B. Knoner  
KELEHER & MCLEOD, P.A  
201 Third Street NW, 12th Floor  
PO Box AA  
Albuquerque, New Mexico 87103  
(505) 346-4646

Respectfully submitted,

/s/ Steven R. Pedersen  
Rolf O. Stadheim  
Joseph A. Gear  
George C. Summerfield  
Keith A. Vogt  
Steven R. Pedersen  
STADHEIM & GREAR, LTD.  
400 N. Michigan Avenue, Suite 2200  
Chicago, Illinois 60611  
(312) 755-4400

*Attorneys for Plaintiff STC.UNM*

UNITED STATES DISTRICT COURT  
DISTRICT OF NEW MEXICO

STC.UNM,

Plaintiff,

v.

INTEL CORPORATION

Defendant.

Civil No. 1:10-cv-01077-RB-WDS

CERTIFICATE OF SERVICE

**Certificate of Service:** I HEREBY CERTIFY that on the 11th day of April, 2012, I filed the foregoing electronically through the CM/ECF system, which caused the following counsel for Defendant, Intel, Corp. to be served by electronic means, as more fully reflected on the Notice of Electronic Filing:

Clifford K. Atkinson ([catkinson@atb-law.com](mailto:catkinson@atb-law.com));  
Douglas A. Baker ([dbaker@atb-law.com](mailto:dbaker@atb-law.com));  
Robert A Van Nest ([rvannest@kvn.com](mailto:rvannest@kvn.com));  
Brian L Ferrall ([bferrall@kvn.com](mailto:bferrall@kvn.com));  
Paven Malhotra ([pmalhotra@kvn.com](mailto:pmalhotra@kvn.com));  
Benedict Y Hur ([bhur@kvn.com](mailto:bhur@kvn.com));  
Jonathan M. James ([JJames@perkinscoie.com](mailto:JJames@perkinscoie.com));  
Chad S Campbell ([CSCampbell@perkinscoie.com](mailto:CSCampbell@perkinscoie.com));  
Timothy J Franks ([TFranks@perkinscoie.com](mailto:TFranks@perkinscoie.com));  
Mark E Strickland ([MStrickland@perkinscoie.com](mailto:MStrickland@perkinscoie.com));  
Jonathan L McFarland ([JMcFarland@perkinscoie.com](mailto:JMcFarland@perkinscoie.com)); and  
Justin D. Rodriguez ([Jrodriguez@atb-law.com](mailto:Jrodriguez@atb-law.com)).

*/s/ Steven R. Pedersen*  
Attorney for Plaintiff