

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

CERTICOM CORP. and CERTICOM
PATENT HOLDING CORP.,

Plaintiffs,

v.

Civil Action No. 2-07CV-216

SONY CORPORATION, SONY
CORPORATION OF AMERICA, SONY
COMPUTER ENTERTAINMENT INC.,
SONY COMPUTER ENTERTAINMENT
AMERICA INC., SONY PICTURES
ENTERTAINMENT INC., SONY
ELECTRONICS INC. and SONY DADC
US INC.

Defendants.

**SONY'S SECOND AMENDED INVALIDITY CONTENTIONS AND DOCUMENT
PRODUCTION UNDER PATENT RULES 3-3 AND 3-4**

Pursuant to Patent Rule 3-3, Defendants Sony Corporation, Sony Corporation of America, Sony Computer Entertainment Inc., Sony Computer Entertainment America Inc., Sony Pictures Entertainment Inc., Sony Electronics Inc. and Sony DADC US Inc. (collectively "Sony") provide the following Second Amended Invalidity Contentions with respect to U.S. Patent Nos. 6,563,928 (the "'928 Patent") and 6,704,870 (the "'870 Patent") (collectively, "the patents-in-suit") asserted by Certicom Corp. and Certicom Patent Holding Corp. (collectively "Certicom").

In accordance with the Patent Rules, Sony provides Exhibits A and B that identify prior art that anticipates and/or renders obvious the asserted claims (and the claims from which they

depend) of the patents-in-suit, including charts that: (1) specifically identify exemplary locations in the prior art where each element for each asserted claim (and claims from which they depend) is found, and (2) establish how each asserted claim (and each claim from which it depends) is invalid as anticipated and/or obvious in view of the prior art. The Exhibits also identify the invalidity of certain of the asserted claims of the patents-in-suit under 35 U.S.C. 101 and 35 U.S.C. § 112, ¶¶ 1 and/or 2.

The citations to the prior art and explanations in the attached exhibits are exemplary, and Sony reserves the right to rely on other portions or aspects of the cited prior art, as well as systems or products embodying that art or testimony from others regarding that art, in proving the invalidity of the asserted claims of the patents-in-suit. Any reference identified as anticipating any claim under 35 U.S.C. § 102 also renders that claim invalid as obvious under 35 U.S.C. § 103, either by itself or when combined with another cited prior art reference or the knowledge of one of ordinary skill in the art at the time of the alleged inventions of the patents-in-suit. All of the identified prior art within an individual claim chart relates to the relevant technology of the patent to which the art is directed, and Sony relies upon these references to demonstrate that one of ordinary skill in the art would have known or been motivated to combine the references as disclosed to practice the asserted claims (and the claims from which they depend) of the patents-in-suit. Where a particular item of prior art incorporates by reference other documents or materials, Sony's identification of the particular prior art reference includes all such incorporated documents or materials.

Certicom has, thus far, failed to meet its requirements under Patent Rule 3-1. In particular, Certicom has asserted that each claim element is, at least partially, a software limitation, and has relied on P.R. 3-1(h) to defer its obligations to meet the requirements under

Patent Rule 3-1. Thus, Certicom has not provided sufficient specificity concerning its infringement allegations and the interpretation of its asserted claims to enable Sony to provide its complete contentions concerning invalidity. Sony has made a good faith effort to fulfill its obligations under the patent rules in their entirety, but reserves its right to supplement its contentions at such time as Certicom complies with its disclosure obligations under P.R. 3-1. Additionally, Sony's discovery and investigation in connection with this lawsuit are continuing, and thus, these disclosures are based on information obtained to date. Accordingly, Sony's Second Amended Invalidity Contentions set forth in the attached exhibits are subject to modification, amendment, or supplementation in accordance with the Court's order, rules and/or the Federal Rules of Civil Procedure.

Sony's Second Amended Invalidity Contentions do not imply that Sony concedes any claim construction implied or suggested by Certicom's Complaint or Certicom's disclosures under Patent Rule 3-1. Sony reserves the right to raise claim interpretation issues as provided by the Docket Control Order and Patent Rules, or by further order, and to further amend its Invalidity Contentions in view of such contentions as provided for in the Court's Patent Rules.

In the absence of claim construction rulings, these Second Amended Invalidity Contentions are made in the alternative and may presuppose claim constructions that are broader than Sony will argue that the Court should adopt. These Second Amended Invalidity Contentions should not be interpreted to rely upon, or in any way effect, the claim construction and non-infringement arguments that Sony intends to put forth in this case. References cited in the attached exhibits may disclose the elements of the asserted claims (and claim from which they depend) either explicitly and/or inherently, and/or may be relied upon to show the state of the art in the relevant time frames. The suggested obviousness combinations are in the

alternative to Sony's anticipation contentions and are not to be construed to suggest that any obviousness reference is not also anticipatory. Sony reserves the right to withdraw prior art from, and add additional prior art to, this disclosure in light of the Court's claim construction rulings, or as information is obtained during the course of discovery.

Any and all cites to particular figures in the attached invalidity charts shall be deemed to wholly incorporate the figure by reference, and include the figure as if it had been inserted into the chart itself, as well as any text discussing the figure. Figures which have not been explicitly cited in the chart or text of these Second Amended Invalidity Contentions, but which appear on the cited pages of the reference, are wholly incorporated by reference into these Second Amended Invalidity Contentions.

Sony's investigation regarding the validity of the patents-in-suit based on prior art and other grounds, including those based on public use or sale under 35 U.S.C. § 102(b), improper inventorship, derivation under § 102(f), and failure to comply with 35 U.S.C. § 112, is ongoing. Accordingly, Sony specifically reserves the right to modify, amend, or supplement these disclosures as additional information, documents and things become available, and as its discovery and investigation proceeds.

**DOCUMENT PRODUCTION ACCOMPANYING AMENDED INVALIDITY
CONTENTIONS PURSUANT TO PATENT RULE 3-4**

A copy of each item of prior art identified pursuant to Patent Rule 3-3(a) is being provided, and bear Bates Nos. SNYCE00000783-SNYCE00000912, SNYCE00219713-SNYCE00219756, SNYCE14953311-SNYCE14953516 and CERT00001688 - CERT00001736.

Dated: January __, 2009

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