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

FUNCTION MEDIA, L.L.C.	§	
	§	
Plaintiff,	§	**Civil Action No. 2007-CV-279**
	§	
vs.	§	
	§	
GOOGLE INC. AND YAHOO!, INC.	§	
	§	
Defendants.	§	**JURY TRIAL DEMANDED**

FUNCTION MEDIA, L.L.C.'S RESPONSE TO
GOOGLE'S MOTION TO LIMIT THE NUMBER OF ASSERTED CLAIMS

This Court should deny Google's Motion to Limit Claims. The parties can easily litigate the eighteen claims (not thirty-two, as argued by Google)[1] that FM has asserted for trial. Alternatively, if this Court elects to limit FM's claims to five, then it should likewise limit Google's asserted prior art references to four and/or permit FM multiple trials.

Google's motion is premised, in part, on a misstatement. FM has asserted eighteen claims against Google. *See* Ex. A (Grinstein 8/10/09 email). Google contends, however, that FM's eighteen claims are actually thirty-two, because certain of FM's dependent claims will require FM to prove up the elements of other claims upon which they depend. But this is simply semantics. A claim is a claim. There is no difference between asserting, on the one hand, a dependent claim with one limitation that depends on an independent claim with five limitations, and, on the other, asserting an independent claim with six limitations. Yet Google would count the former as asserting two claims, and the latter as asserting one. For that matter, Google by its

[1] This Court's *Markman* ruling eliminated the two '045 patent claims from FM's asserted twenty claims, and presumably two claims as well from Google's recalculated number of thirty-four.

logic would have no problem with FM's asserting five independent claims, with one hundred limitations each, yet the assertion of eighteen claims with many fewer limitations vexes Google. Indeed, Google identifies nothing troublesome from a trial perspective in the specific claims FM has selected for trial – *e.g.*, a huge number of limitations, vastly different claimed subject matters, etc. So it resorts to creative math to generate the appearance of a problem, where none exists.

In any event, the number of claims that FM has asserted for trial fits comfortably within the standards this Court has set. In *Negotiated Data Solutions, LLC v. Dell, Inc.*, No. 2:06-CV-528, this Court limited a plaintiff to forty claims prior to *Markman*. *See* Exhibit B (7/30/08 order). This Court did the same in *Minerva Industries, Inc. v. Motorola, Inc.*, No. 2:07-CV-229-CE. *See* Exhibit C (7/30/09 order). Granted, the parties are now close to trial. But the realities of trial ought to compel both sides to limit their claims and asserted references to a number reasonable for trial presentation. Thus, the better approach – as expressed recently by Judge Davis in *Accolade Systems LLC v. Citrix Systems, Inc.* – is to leave it up the parties to agree to narrow their contentions if they so choose, provided they are at a reasonable level to begin with. *See* Exhibit D (5/11/09 Order, allowing fourteen claims and twenty-six references to proceed to trial within one month, and noting that parties "naturally withdraw claims and references that are not viable for use at trial").

Here, FM has asserted eighteen claims and Google has asserted sixteen references (consisting of twenty-five documents). *See* Exhibit E (DeFranco 9/22/09 letter limiting prior art references).[2] If FM's eighteen claims pose a trial problem for Google, then Google's sixteen

[2] To be clear, FM has also moved for summary judgment that each reference asserted by Google does not anticipate or render obvious FM's asserted claims. FM has also moved *in limine* to preclude certain of the *(continued...)*

references/twenty-five documents ought to do the same for FM. This Court should thus leave it up to the parties to negotiate reductions, if need be.

Alternatively, if this Court opts to order FM to reduce its number of asserted claims to five, then it should likewise order Google to reduce its asserted references to four. All of Google's arguments against FM's number of claims apply with equal force to Google's number of prior art references. And Google's assertion of sixteen references to FM's earlier assertion of twenty claims established a ratio of four to five. As such, a limitation of four Google references to FM's five asserted claims would be fair.

Moreover, if this Court does limit FM to just five claims for trial, due process prevents FM from being summarily denied its legal rights as to its remaining claims. Accordingly, FM requests that, following the first trial on its initial five claims, FM be granted up to three additional trials to try its remaining thirteen asserted claims.[3]

Respectfully submitted,

/s/ Joseph S. Grinstein

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references/documents asserted by Google on the grounds they were not properly disclosed or charted. Thus, FM does not believe that Google will ultimately be able to assert some or all of its currently identified art.

[3] FM reserves all rights as to additional trials for the other claims in its patents which it has not asserted, or which it originally asserted but has since withdrawn for trial purposes.

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CERTIFICATE OF SERVICE

I hereby certify that on October 19, 2009, I electronically filed the foregoing document with the clerk of the court for the U.S. District Court, Eastern District of Texas, using the electronic filing system of the court. The electronic case filing system sent a "Notice of Electronic Filing" to the following attorneys of record who have consented in writing to accept this Notice as service of this document by electronic means:

/s/ Joseph S. Grinstein
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