

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

BRIGHT RESPONSE, LLC,	§	
Plaintiff,	§	
	§	
v.	§	Civil Action No. 2:07-cv-371-ce
	§	
GOOGLE, INC., et al.,	§	
	§	JURY TRIAL DEMANDED
Defendants.	§	
	§	

**BRIGHT RESPONSE, LLC'S
SUPPLEMENTAL BRIEF IN SUPPORT OF ITS RESPONSE TO
DEFENDANTS' JOINT MOTION IN LIMINE NO. 9**

Plaintiff Bright Response, LLC (“Bright Response”) files this supplemental brief in support of its response to Defendants’ Joint Motion in Limine No. 9. Defendants’ motion sought a ruling that the reexamination proceedings would be admissible at trial. Plaintiff responded that it agreed. Dkt. No. 518.¹ At the July 28, 2010 pre-trial hearing, there was no motion before the Court requesting the Court to exclude the reexamination proceedings for any reason.² Bright Response therefore supplements its response to further demonstrate why Defendants’ Motion was appropriate in the first place and why Bright Response did not oppose it: the reexamination proceedings are relevant and admissible.

¹ Bright Response stated: “Bright Response agrees that relevant portions of the reexamination proceedings are and should be admissible. Bright Response files this response, however, to state its position that all parties—not just the Defendants—should be permitted to refer to relevant portions of those proceedings.” Dkt. No. 518.

² See Transcript of Proceedings July 28, 2010 at 19 (attached at Wiley Decl. Ex. C) (“8 THE COURT: I'm not going to grant a motion in limine barring introduction of re-examination proceedings, okay? If either side goes too far, since y'all both want parts of it in, then y'all just need to object at the time of trial, okay? MR. FENSTER: Yes, Your Honor. *Just to clarify, nobody has moved, neither side, to exclude or bar any testimony.* THE COURT: I understand....”) (emphasis added).

A. The Reexamination is Final: There Will Be No Appeal.

There is one pending reexamination proceeding on the '947 patent that has a final office action and a second one that has been finally disposed of by the U.S. Patent & Trademark Office (USPTO).

The Google-initiated reexamination, in which the USPTO confirmed asserted claims 30, 31 and 33 over much of the prior art relied upon by Defendants, is complete. A Final Office Action has been issued. Bright Response responded to this Final Office Action with an Amendment After Final. The Examiner entered this Amendment as documented in her recent Advisory Action, in which she also confirmed the patentability of claims 30, 31 and 33, *inter alia*. See Wiley Decl. Ex. A (excerpt of Advisory Action). As such, the ball is now in Bright Response's court. Bright Response has the option to appeal the Examiner's findings to the Board of Patent Appeals and Interferences (BPAI), or to waive this right, in which case the reexamination is complete, and the USPTO will issue a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC), closing prosecution in this matter. If this reexamination proceeding, as well the second completed reexamination proceeding discussed below, are admitted in the current litigation, Bright Response ***will waive its right to the BPAI appeal*** in this proceeding and send a letter advising the Examiner of such and requesting that she expedite the issuance of the NIRC.

Yahoo filed a second request for reexamination based on the combination of the Allen patent and the CBR Express Manuals, as well as an obvious combination of Allen in combination with Watson, which was denied. See Wiley Decl. Ex. B at "Decision." The USPTO found that "[n]o substantial new question of patentability was raised," in a request

addressed specifically to claims 31 and 33. *Id.* Accordingly, there is no question that the status of these proceedings as to the asserted claims is relevant.

Another district court facing a similar situation found that a reexamination that was pending on appeal was admissible evidence on the issue of validity. *See In re Bingo Card Minder Corp.*, 1998 U.S. App. LEXIS 5600 (Fed. Cir. Feb. 25, 1998) (stating that the “district court also determined that the results of the reexamination proceeding were admissible evidence on the issue of invalidity.”). In *Bingo Card Minder*, the defendants’ request for reexamination was granted, and, during the process, some claims were rejected and some claims were confirmed. The plaintiff appealed to the Board of Patent Appeals and Interference, and that appeal was pending when defendant submitted a petition for a writ of mandamus after the Court denied its motion to dismiss. The Federal Circuit denied the writ, but noted in the background section without further comment that the “district court also determined that the results of the reexamination proceeding were admissible evidence on the issue of invalidity.” *Id.* at *3. The facts regarding the reexamination are the same here, except that Bright Response has not appealed the final action of the reexamination and instead will also remove all doubt and waive its appeal (and drop claims 28 and 38) if the Court admits the reexamination materials. Because the reexaminations will be complete, the Court should allow evidence of the reexaminations into evidence in this case.

B. Defendants Agreed that Portions of the Reexamination Are Relevant: They Moved To Have Them Admitted in the First Place.

Defendants’ recognition of the relevance of the reexamination proceedings is demonstrated by the fact that it was Defendants who moved the Court to rule that the reexamination proceedings were admissible. The record shows that the Court granted that motion because it was agreed.

THE COURT: ...**9 is granted as agreed**. That deals with re examinations. Is there any -- as I read the papers, the defendant wants to offer certain portions of the re-exam or the defendants do, as well as the plaintiff; is that correct?

MR. FENSTER: That's my understanding, Your Honor.

MR. VERHOEVEN: Yes, Your Honor.

See Wiley Decl. Ex. C (hearing) at 18:25-19:24 (emphasis added).

C. Defendants' Invalidity Case Is Based On Art Considered—And Rejected--in the Reexamination(s).

The relevance of the reexamination proceedings, which Defendants admitted by their Motion in Limine No. 9, remains in full force because of Defendants' validity case and their arguments concerning the presumption of validity. Defendants will argue, and have demonstrated their intent to argue, that the presumption of validity does not apply because prior art was not considered by the U.S. Patent & Trademark Office. Defendants' Proposed Jury Instructions prove this: **Defendants have requested that the Court instruct the jury that Defendants must prove invalidity only by a preponderance of the evidence.** Dkt. No. 433 at Post-Trial Instructions, p. 3.³

Bright Response is therefore entitled to argue that these particular items of prior art were before the PTO in reexamination, and claims 30, 31, and 33 were confirmed – again – and again. The only fair and reasonable way to make the reexamination proceedings *not* relevant is for the Court to order that Defendants withdraw all arguments based on any art that was before the PTO and now stands rejected – again – and again. Both reexaminations will be completed. The

³ Dkt. No. 433 at Post-Trial Instructions, page 3: “Even though the United States Patent and Trademark Office has allowed the claims of the ‘947 patent, you, the jury, have responsibility for deciding whether the claims of the patent are valid. **Google, AOL and Yahoo! bear the burden of proving invalidity by a preponderance of evidence.** This does not require proof beyond a reasonable doubt. This means that Google, AOL and Yahoo! must show that it is more likely than not that the asserted claims of the ‘947 patent are invalid.” (emphasis added).

typical rationale for not admitting a reexamination – that is an initial or incomplete proceeding— is not the case here. The reexaminations are appropriate admissible evidence.

D. Bright Response’s Withdrawal of Claims 28 and 38 Was Conditioned on Admissibility of the Reexamination Proceedings.

Toward the conclusion of the hearing, after the Court heard the balance of the motions in limine and granted, denied, and carried with the case various other motions, counsel for Bright Response stated that it would no longer be pursuing claims 28 and 38. Wiley Decl. Ex. C at 65 (“MR. FENSTER: Your Honor, *in light of the motions in limine, plaintiffs will not be pursuing Claims 28 and 38....*”) (emphasis added). After further discussion on the record concerning Joint Motion in Limine No. 9, Bright Response made its position very clear on the record: its statement that it was not pursuing claims 28 and 33 was contingent on the Court’s earlier ruling, namely, that it was granting Defendants’ Joint Motion in Limine No. 9 as agreed:

THE COURT: Yeah. And if -- well, Mr. – is your decision, abandon those claims, contingent on allowing evidence of re-exam?

MR. FENSTER: Yes, sir. Yes, Your Honor. *If you're going to keep -- if Your Honor is inclined to exclude the re-exam, then we'll keep 28 and 38 in.*

Wiley Decl. Ex. C at 70:21 – 71:1 (emphasis added).

Bright Response therefore submits (i) the reexamination proceedings remain relevant for the reasons set forth Defendants’ Motion in Limine No. 9, Plaintiff’s response to that Motion, and based on the supplemental reasons Plaintiff sets forth herein; and (ii) that the Court should reconsider its advisory ruling denying the Defendants’ Joint Motion in Limine No. 9.

Dated: July 30, 2010

Andrew W. Spangler
LEAD COUNSEL
SPANGLER LAW P.C.
208 N. Green Street, Suite 300
Longview, Texas 75601
(903) 753-9300
(903) 553-0403 (fax)
spangler@spanglerlawpc.com

David M. Pridham
LAW OFFICE OF DAVID PRIDHAM
25 Linden Road
Barrington, Rhode Island 02806
(401) 633-7247
(401) 633-7247 (fax)
david@pridhamiplaw.com

John C. Hueston
CA SBN 164921
IRELL & MANELLA, LLP
840 Newport Center Dr., Suite 400
Newport Beach, CA 92660
Tel: (949) 760-0991
Fax: (949) 760-5200
Email: jhueston@irell.com

Adam S. Goldberg
CA SBN 250172
IRELL & MANELLA, LLP
1800 Avenue of the Stars, Suite 900
Los Angeles, CA 90067
Tel: (310) 203-7535
Fax: (310) 203-7199
Email: agoldberg@irell.com

Respectfully submitted,

By: /s/ Elizabeth A. Wiley
Elizabeth A. Wiley

Elizabeth A. Wiley
Texas State Bar No. 00788666
THE WILEY FIRM PC
P.O. Box 303280
Austin, Texas 78703-3280
Telephone: (512) 560.3480
Facsimile: (512) 551.0028
Email: lizwiley@wileyfirmpc.com

Marc A. Fenster
CA Bar No. 181067
mfenster@raklaw.com
Alexander C.D. Giza
CA Bar No. 212327
agiza@raklaw.com
Andrew Weiss
CA Bar No. 232974
aweiss@raklaw.com
Adam Hoffman
CA Bar No. 218740
ahoffman@raklaw.com
RUSS, AUGUST & KABAT
12424 Wilshire Blvd., 12th Floor
Los Angeles, CA 90025
(310) 826-7474
(310) 826-6991 (fax)

Patrick R. Anderson
PATRICK R. ANDERSON PLLC
4225 Miller Rd, Bldg. B-9, Suite 358
Flint, MI 48507
(810) 275-0751
(248) 928-9239 (fax)
patrick@praplhc.com

CERTIFICATE OF CONFERENCE

I certify that on this 30th day of July 2010 I have complied with this Court's local rules to meet and confer as follows: I informed counsel for Yahoo and Google that we would be proceeding with briefing in relation to Bright Response's prior filing in response to Defendants' Joint Motion in Limine No. 9 and in light of the Court's Order today denying that motion in limine. I was informed that Defendants' position is that there is nothing to reconsider or brief, even in light of the Court's denial of the Motion in Limine, as Defendants consider the issue open until Defendants let the Court know their position on Claims 28 and 38.

\s\ Andrew W. Spangler
Andrew W. Spangler

CERTIFICATE OF SERVICE

I certify that counsel of record who are deemed to have consented to electronic service are being served this 30th day of July, 2010, with a copy of this document via the Court's CM/ECF systems per Local Rule CV-5(a)(3). Any other counsel will be served electronic mail, facsimile, overnight delivery and/or First Class Mail on this date.

\s\ Elizabeth A. Wiley
Elizabeth A. Wiley