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 MOTION TO CLARIFY OR RECONSIDER THE COURT'S RULING DENYING PLAINTIFF'S MOTION IN LIMINE NO. 14 (CLAIMS NO LONGER BEING PURSUED) IN LIGHT OF THE COURT'S GRANTING MOTION IN LIMINE NO. 15 (PRODUCTS NO LONGER ACCUSED)

Plaintiff Bright Response, LLC ("Bright Response") files this Motion to Clarify or alternatively to seek reconsideration of the Court's ruling denying Plaintiff's Motion in Limine No. 14. The first part of Motion in Limine No. 14 referred to uncharted prior art. But the second part of that same Motion in Limine referred to the prejudicial effect of allowing the jury to hear any reference to the fact that Plaintiff was no longer asserting certain claims in the case. It is identical to Plaintiff's Motion in Limine No. 15—which the Court granted—and which requested the same relief except as to products no longer being accused by Plaintiff.

Motion in Limine No. 14 requested the Court to preclude the following:

> 14.… any reference to or comment regarding the fact that Bright Response is no longer asserting certain claims of the '947 patent against any of the Defendants, or the fact that Bright Response had a broader number of claims at one time and is now bringing a smaller number of claims. Bright Response should not be adversely affected by the jury's speculating as to the reason for that narrowing: parties should be incentivized to narrow their issues for trial and to focus the issues at trial, not penalized by allowing the jury to speculate.

Dkt. No. 453 at 8.

That portion of Motion in Limine 14 cited the same authority Bright Response relied on for Motion in Limine 15, which the Court granted, to preclude Defendants' reference to products that were no longer accused: *PalTalk Holding, Inc. v. Microsoft Corp.*, No. 2:06-CV-367-DF, Order, Dkt. No. 226 at 4 (E.D. Tex. Feb. 25, 2009). *PalTalk* speaks directly to the prejudice of allowing the jury to hear mention of claims no longer being pursued:

> Reference to any prior patent claims, causes of action, or forms of relief that have been dismissed or abandoned during this lawsuit would have little relevance and be highly prejudicial…the jury is ill-equipped to determine whether PalTalk's abandonment of previous claims occurred for purely strategic reasons or occurred because Microsoft possessed legitimate defenses. ***Therefore, even if such evidence was relevant to Microsoft's willfulness defense, it is highly prejudicial***.

PalTalk Holding, No. 2:06-CV-367-DF, Order, Dkt. No. 226 at 4 (cited at Dkt. No. 453 at 8-9 n.4).

Accordingly, Bright Response would request that the Court reconsider and order as to Motion in Limine 14 (concerning claims) as it did for Motion in Limine No. 15 (concerning products). The jury is "ill-equipped" to place in a proper perspective the many reasons for which claims may have been abandoned. Parties would have little incentive to narrow their case for trial if they had to make the Hobson's choice of (i) narrowing the case, for whatever reason or (ii) risking the speculation the jury might engage in upon the opposing party's arguments and references to the fact that its opponent was no longer pursuing certain claims.

Moreover, the Court's ruling on Motion in Limine No. 15 as to products suggests that the Court did intend for this type of ruling to encompass claims as well. The Court held:

> ***15 is granted*** insofar as the defendants are precluded from stating that a particular product or service was at one time accused of infringement and now is not accused of infringement. This order does not prevent the defendants from saying -- or introducing evidence in front of the jury that particular products or services are not accused of infringement standing alone. So I'm allowing you to do that, but you can't -- ***I'm not going to get into withdrawn claims of infringement in front of the jury***, okay? Any questions?

Wiley Decl. Ex. A at 17 (emphasis added).

Should the Court allow Defendants to mention to the jury – or otherwise introduce evidence of – the fact that some claims were asserted and then dropped, Plaintiff should have the opportunity to argue – and present evidence of – some of the reasons for dropping claims and not dropping others. As many of the strategic reasons relate to the repeated blessing of certain claims of the '947 Patent, Bright Response should have the opportunity to explain to the Court that prior claims were not blessed—and not blessed three times—while the patent claims before the jury had been considered three times and in all situations held to be valid.

Regardless, for clarity and consistency, and to avoid prejudice for the same reasons the Court granted Plaintiff's Motion in Limine No. 15, Bright Response requests a ruling on Plaintiff's Motion in Limine No. 14 that is parallel to the Court's ruling above regarding Motion in Limine 15, namely: "Defendants are precluded from stating that a particular claim was at one time asserted and is now not asserted, but this Order does not prevent the Defendants from saying in front of the jury that particular claims of the '947 patent are not have not been asserted." A proposed order to this effect is attached.

Dated: July 31, 2010

Respectfully submitted,

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

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CERTIFICATE OF CONFERENCE

I certify that on the 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 this motion to clarify the Court's rulings as to Plaintiff's Motion in Limine No. 14 as set forth in above motion to be consistent with the Court's ruling on Motion in Limine No. 15. The response I received required that in order to secure Yahoo's consent, Bright Response had to agree with Yahoo on a different matter, which Bright Response could not do. Accordingly, the parties are at an impasse presenting an issue for this Court.

\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 31st 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