

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

SOFTWARE RIGHTS ARCHIVE, LLC §

§

VS.

§

Civil Case No. 2:07-cv-511 (CE)

§

GOOGLE, INC., YAHOO! INC., IAC §

SEARCH & MEDIA, INC., AOL, LLC, §

And LYCOS, INC. §

**DEFENDANTS' SUR-REPLY TO SRA'S MOTION TO STRIKE INVALIDITY
CONTENTIONS (DKT. NO. 218)**

INTRODUCTION

This dispute arose because Defendants sought leave to serve amended and supplemental invalidity contentions on December 18, 2009. Defendants did so in order to (i) clarify and narrow their obviousness combinations and (ii) add ten prior art references to their invalidity contentions. SRA opposed these amendments, even though SRA repeatedly requested that Defendants provide amended obviousness combinations (*see* Dkt. No. 228 at 1), and even though Defendants spent several months and incurred great expense in attempting to meet SRA's requests.

Besides opposing Defendants' amendments, SRA also belatedly moved to strike Defendants' original invalidity contentions – nearly a year after Defendants served them. Alternatively, SRA has asked the Court to order Defendants to serve amended contentions (i) asserting no more than five obviousness combinations and no more than five anticipatory references per claim and (ii) attaching “detailed claim charts identifying the specific language on which [Defendants] intend to rely.” (Dkt. No. 213 at 13.)

SRA's motion to strike is a transparent attempt to secure a tactical advantage, and it cites no authority justifying the arbitrary and highly prejudicial relief that it seeks. Defendants' amendments cannot prejudice SRA, as SRA requested that Defendants provide amended obviousness combinations and Defendants sought leave to amend them when this case was in its early stages. Specifically, SRA cannot dispute that Defendants sought leave to amend at a time when:

- (i) jury selection was not scheduled to occur until more than sixteen months from the filing of Defendants' motion (Dkt. No. 198);
- (ii) no invalidity discovery (other than seeking prior art) had occurred;
- (iii) none of the parties had served expert reports;

- (iv) the first claim construction-related deadline was four months away;
- (v) the first claim construction briefs were not due for eight months; and
- (vi) the claim construction hearing itself was approximately eleven months away.

For at least these reasons, SRA's motion to strike should be denied in its entirety.¹

ARGUMENT

I. DEFENDANTS' INVALIDITY CONTENTIONS SHOULD NOT BE STRICKEN DUE TO LENGTH

Elevating form over substance, SRA contends that Defendants' invalidity contentions should be stricken based on their length alone. (Dkt. No. 235 at 2-4.) This argument is flawed for several reasons.

First, contrary to SRA's assertion (Dkt. No. 235 at 2-3), there is no dispute about the length of Defendants' invalidity contentions (81 pages) or that the remainder of the contentions comprises detailed claim charts. (*See* Second Baker Decl. Ex. K.) But as Defendants explained in their Opening Brief (Dkt. No. 228 at 15), these charts are necessarily long because SRA has alleged that 5 different defendants infringe 64 claims of 3 different patents. Explaining how even a single anticipatory reference, or a combination of references for obviousness, discloses all of the limitations of even a single asserted claim requires multiple pages.²

¹ In accordance with the Court's January 29, 2010 order, (Dkt. No. 220), Defendants' sur-reply contains pages beyond the usual limit.

² SRA attempts to justify the volume of asserted claims by arguing that "many plaintiffs assert 64 claims or more." (Dkt. No. 235 at 3.) But 64 is a large and unwieldy number of claims by any standard, as evidenced by prior rulings of courts in the Eastern District of Texas. *See, e.g., Advanced Tech. Incubator, Inc. v. Sharp Corp.*, No. 07-468 (E.D. Tex. May 16, 2008) (limiting plaintiff to 10 claims); *Sky Tech., LLC v. SAP AG*, No. 06-440 (E.D. Tex. Feb. 6, 2007) (limiting plaintiff to 10 claims); *Coopervision, Inc. v. CIBA Vision Corp.*, No. 06-149 (E.D. Tex. Feb. 9, 2007) (limiting plaintiff to 20 claims).

Second, SRA's complaints about length ignore that Defendants provided the actual text of the invalidity references, rather than just the citations themselves. Defendants did so to *assist* SRA's understanding of their positions. Removing this text for the sole purpose of adhering to an artificial page limit could only hinder SRA's understanding.³

Third, SRA's attempt to read in a strict page limit on invalidity contentions, as a matter of law, finds no support in this Court's Local Patent Rules or case law. While SRA alleges that *Saffran v. Johnson & Johnson*, No. 2:07-cv-451 (E.D. Tex. Feb. 24, 2009) imposed a length requirement by striking contentions "that were overly lengthy" (Dkt. No. 235 at 2), SRA misreads that case entirely. In *Saffran*, the court referred to the length of the defendants' invalidity contentions *just once*, and it never suggested that their length alone was a reason to strike them. Rather, the crux of *Saffran's* holding was that "defendants' almost 800 pages of 'Invalidity Contentions' [*did*] not put plaintiffs on real or useful notice." *Saffran* at 1-2 (emphasis added).⁴ This deficiency is inapposite to Defendants' detailed original or amended contentions.

The other case SRA cites, *Cummins-Allison Corp. v. SBM Co., Ltd.*, No. 07-196, 2009 WL 763926 (E.D. Tex. Mar. 19, 2009), is even less supportive of SRA's position. The court in *Cummins-Allison* never discussed the length of the defendants' invalidity contentions, but simply

³ In its Reply Brief (Dkt. No. 235), SRA again highlights one specific claim chart to challenge Defendants' invalidity contentions. SRA's argument is moot, as Defendants' amended contentions expressly withdrew this chart. (*See* Second Baker Decl. Ex. M at 3 ("Defendants withdraw the combination of references previously presented in Exhibit C-1 of their Invalidity Contentions and add Table App-5.")). Incredibly, SRA seeks to rely on this chart to justify its motion to strike, but refuses to consent to an amendment to Defendants' invalidity contentions that would withdraw this same chart.

⁴ Nor is it "disingenuous" of Defendants to challenge the sufficiency of SRA's infringement contentions in view of their length. (Dkt. No. 235 at 3.) As set forth in Defendants' Opening Brief (Dkt. No. 228 at 4), when SRA served its infringement contentions, it failed to provide claim charts for the vast majority of the purportedly accused products, and the charts SRA did provide frequently lacked the degree of specificity required under the Local Patent Rules.

held that plaintiff's assertion of a large number of claims did not excuse their obligation to file complete contentions. *See id.* at *3 (“While Plaintiff has undoubtedly engaged in tactical games in an attempt to gain an advantage by asserting more than 200 claims, having only pared them down to 116 claims at the time Defendants served their Invalidity Contentions, Defendants cannot be excused for neglecting to file complete Invalidity Contentions.”). Here, Defendants are not seeking to excuse their obligation to file complete invalidity contentions addressing all 64 of SRA's asserted claims. To the contrary, Defendants' detailed contentions address all of them.

II. DEFENDANTS' INVALIDITY CONTENTIONS SHOULD NOT BE STRICKEN BASED ON THEIR DISCLOSURE OF OBVIOUSNESS COMBINATIONS

SRA next argues that Defendants' original invalidity contentions should be stricken because they “failed to identify the specific combinations that the defendants intend to use at trial” and instead “identify trillions of potential combinations.” (Dkt. No. 235 at 4.) SRA is wrong. It is undisputed that Defendants provided in their invalidity contentions several specific obviousness combinations for each of the asserted patents. (Dkt. No. 228 at 16.) It is equally undisputed that Defendants, in the text of the invalidity contentions themselves, identified groups of references and specific combinations rendering obvious the asserted claims. (*Id.*)

SRA does not address – much less distinguish – the cases from Defendants' Opposition Brief, demonstrating that Defendants' invalidity contentions are adequate. *See Avago Techs. Gen. IP PTE Ltd. v. Elan Microelectronics Corp.*, No. 04-5385, 2007 WL 951818, at *4 (N.D. Cal. Mar. 28, 2007) (holding that defendant complied with Local Rule 3-3(b) even though it grouped references together “in an approach that results in literally billions of different combinations”); *Keithley v. The Homestore.com, Inc.*, 553 F. Supp. 2d 1148, 1150 (N.D. Cal. 2008) (finding that defendants' grouping method for obviousness combinations was consistent with *Avago* and Rule

3-3(b) even though it could lead to millions of possible combinations).⁵ Notably, *Keithley* noted that the defendants’ use of a “grouping method” was the most efficient and clear way to disclose potential obvious combinations for large numbers of prior art documents. *See Keithley*, 553 F. Supp. 2d at 1150.

III. DEFENDANTS’ INVALIDITY CONTENTIONS SHOULD NOT BE STRICKEN DUE TO OTHER ALLEGED “DEFICIENCIES”

Again elevating form over substance, SRA argues that Defendants’ original invalidity contentions should be stricken due to other alleged “deficiencies.” Specifically, SRA argues that the contentions should be stricken because they are merely “illustrative” (Dkt. No. 235 at 5), refer to “information known to persons skilled in the art” (*id.* at 5-6), reserve the right to rely on additional combinations of disclosed art (*id.* at 6), and include “boilerplate” language incorporating certain previously-disclosed combinations by reference (*id.* at 6-7). In support, SRA cites *Cummins-Allison* and *Realtime Data, LLC v. Packeteer, Inc.*, No. 08-144, 2009 WL 4782062 (E.D. Tex. Dec. 8, 2009) (*id.* at 5-6).

But neither of these cases demonstrates that Defendants’ contentions are deficient or justify SRA’s extraordinary requested relief. The court in *Cummins-Allison*, for example, simply barred a defendant from relying at trial on references and combinations that were absent from its invalidity contentions. *See* 2009 WL 763926, at *4-7. Similarly, *Realtime Data* prohibited the

⁵ As Defendants explained in their Opposition Brief, cases from the Northern District of California (such as *Avago* and *Keithley*) are particularly instructive to resolve disputes relating to this Court’s Local Patent Rules, as this Court modeled its Rules on the Northern District’s. *See Mass. Inst. Tech. v. Abacus Software*, 2004 WL 5586072, at *5 (E.D. Tex. Sept. 10, 2004) (“For patent infringement cases, Judge Ward adopted the Northern District of California’s Patent Local Rules. This Court will therefore consider cases in the Northern District of California that have interpreted its Patent Local Rules with regard to the issues presented by Microsoft’s motion [to amend its invalidity contentions.]”).

defendant from seeking summary judgment on references and combinations absent from its invalidity contentions. *See* 2009 WL 4782062, at *3-4.

In neither case did the Court *strike* the defendants' existing contentions. Instead, it simply prohibited them from going *outside* those contentions and raising new invalidity theories at summary judgment or trial. Accordingly, it is improper for SRA to suggest that these cases warrant striking Defendants' original invalidity contentions for alleged deficiencies where, as here, Defendants sought leave to amend long before filing any summary judgment motions or trial.

IV. SRA CONCEDES THERE IS NO SUPPORT FOR ARBITRARY LIMITS ON THE NUMBER OF PRIOR ART REFERENCES AND OBVIOUSNESS COMBINATIONS THAT DEFENDANTS MAY RELY UPON

SRA still cites no support for its alternative requested relief – that Defendants' original invalidity contentions, if allowed “at all,” be limited to five anticipatory references and five obviousness combinations per claim (Dkt. No. 235 at 7). SRA's utter failure to cite *any* supportive authority for such draconian relief justifies denying it.

Critically, SRA also still identifies no prejudice warranting striking Defendants' contentions. SRA concedes it waited nearly one year after receiving Defendants' invalidity contentions before filing the instant motion. (Dkt. No. 228 at 18.) During that intervening year-long period, SRA sent Defendants just two letters objecting to their disclosures – the more recent of which was sent over six months ago. (Baker Decl. Exs. C-D.) It was only *after* Defendants sought leave to amend that SRA filed this belated and retaliatory motion to strike. In view of its timing, SRA's motion to strike is a transparent attempt to practice litigation by ambush. *See Cummins-Allison Corp.*, 2009 WL 763926, at *1.

Denying SRA's motion to strike, and allowing Defendants' original contentions to stand and their amended contentions to be entered, cannot prejudice SRA in any way. Jury selection is not set to occur until May 2, 2011 – more than sixteen months from the filing date of Defendants'

Motion for Leave to Amend Invalidity Contentions (Dkt. No. 198) – and no depositions related to invalidity or prior art have been conducted to date. No claim construction-related deadlines have passed. Accordingly, ample time remains for SRA to analyze Defendants’ comprehensive invalidity contentions.

CONCLUSION

For all of the reasons set forth above and in Defendants’ Opposition Brief (Dkt. No. 228), Defendants respectfully request that the Court deny SRA’s motion to strike Defendants’ invalidity contentions in its entirety.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that counsel of record who are deemed to have consented to electronic service are being served this 26 day of March, 2010, with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3).

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