Rockstar Consortium US LP et al v. Google Inc Doc. 264

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

ROCKSTAR CONSORTIUM US LP AND NETSTAR TECHNOLOGIES LLC, Plaintiffs, v. GOOGLE INC. Defendant.	)	Civil Action No. 13-cv-00893-JRG-RSP **JURY TRIAL DEMANDED**

NOTICE CONCERNING PRELIMINARY ELECTION OF ASSERTED CLAIMS AND UPDATE ON NARROWING OF ISSUES FOR CLAIM CONSTRUCTION

The Court's October 15, 2014 Agreed Order Focusing Patent Claims and Prior Art (Dkt. 201) required Rockstar to reduce the number of asserted claims to 50 by November 6, 2014. On that date, Rockstar served its Preliminary Election of Asserted Claims, attached hereto as Exhibit A.[1] Rockstar has now identified the following as the remaining asserted claims in this case:

Patent Number	Asserted Claims
U.S. Pat. No. 7,236,969	1, 2, 6, 8, 9, 10, 11, 14, 17, 18, 19, and 21
U.S. Pat. No. 7,469,245	1, 3, 6, 7, 8, 16, and 17
U.S. Pat. No. 7,672,970	2, 3, 4, 5, 8, 11, 13, 15, 18, 20, 21, 24, 31, 35, and 38
U.S. Pat. No. 7,895,178	1, 5, 8, 9, and 10
U.S. Pat. No. 7,895,183	6, 8, and 18
U.S. Pat. No. 7,933,883	2, 3, 4, 5, 7, 9, 10, and 24

[1] Rockstar later substituted two of the claims on November 10 and 11, 2014. (Ex. B.)

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The following terms for which the parties presented claim construction disputes during claim construction are no longer in any of Rockstar's currently asserted claims:

Term	**Claims (Now Unasserted)**
"determining whether the advertisement was successful"	'969 – 22
"user preference edit input"	'245 – 5
"the communications interface" [antecedent basis]	'183 – 12
"the desired information" [antecedent basis]	'969 – 22
Order of steps of claim 12 of the '178 patent	'178 – 12

Accordingly, these claim construction disputes do not require a resolution from the Court. In fact, given that the terms above are not in any Rockstar asserted claim, this Court no longer has jurisdiction to rule on their construction. *Cf. Jang v. Boston Scientific Corp.*, 532 F.3d 1330, 1336 (Fed. Cir. 2008) (noting the "risk of rendering an advisory opinion as to claim construction issues that do not actually affect the infringement controversy between the parties").

Rockstar agrees that "user preference edit input", "the communications interface" as used in claim 12 of the '183 patent, and the order of the steps of claim 12 of the '178 patent need not be construed by the Court. However, Rockstar contends that the Court must still issue a construction of "determining whether the advertisement was successful" and "the desired information," as used in claim 22 of the '969 patent, even though Rockstar has dropped claim 22 and dependent claim 23 of the '969 patent from its case against Google, and no longer asserts these claims. (Ex. A at 2.) Specifically, Rockstar states that that "although not included" in its list of 50 asserted claims:

> Rockstar specifically reserves the right to assert Claims 22 and 23 of Patent Number 7,236,969. The Court tentatively held those claims indefinite due to the term "successful." Should the Court keep that ruling, Rockstar intends to appeal on that point. And in the event that the Court or the District Court find that term not indefinite, Rockstar specifically reserves the right to substitute one or both of those claims for one or more of the claims disclosed below.

(Ex. A at 1.)

If Rockstar wanted the Court to issue constructions that impact claims 22 and 23 of the '969 patent, however, then it needed to include those claims the set of 50 claims it identified pursuant to the Court's Order. Because Rockstar did not do so, as noted above, the Court no longer has jurisdiction to address the claim construction disputes concerning these unasserted claims. Further, having now dropped claims 22 and 23 of the '969 patent, Rockstar cannot hedge on the Court diverging from its tentative ruling by leaving open its ability to later assert these claims. Indeed, this would be a clearly improper end-run to the Court's Order to reduce to 50 total asserted claims. And while Rockstar indicates it intends to appeal whether the "successful" term is indefinite, having now dropped claim 22 and 23, there is no longer anything for Rockstar to appeal as to these claims. *SanDisk Corp. v. Kingston Tech. Co*., 695 F.3d 1348, 1354 (Fed. Cir. 2012) (holding that dropped claims "do not present a current infringement controversy" and that appellate court lacked Article III "jurisdiction to review the district court's claim constructions related to [dropped claims] because [patentee] voluntarily withdrew those claims from the litigation") (citing *Jang*, 532 F.3d at 1336).

In addition, the following terms, for which the parties agreed to claim constructions, no longer appear in any of the asserted claims:

Term	Claims	Agreed Construction
"link to a website"	'178 – 7, 16 '183 – 2, 10, 15	"a hyperlink to a website"
"compil[e|ing] user profile data"	'183 – 7, 20	"collect user profile data"

DATED: November 11, 2014

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3) on November 11, 2014.

/s/ Antonio Sistos

CERTIFICATE OF CONFERENCE

On November 10, 2014, counsel for Defendants conferred with Justin Nelson of Susman Godfrey, Counsel for Rockstar, via email. In that conference, the parties discussed their clients' positions. The parties agreed that most of the terms above should be withdrawn from the Court's consideration, but substantively disagreed with respect to "determining whether the advertisement was successful" and "the desired information." With respect to those terms, the parties' discussions ended in an impasse.

/s/ Antonio Sistos