



## **I. INTRODUCTION**

Defendants' motion to dismiss has been significantly strengthened due to a recent event in the reexamination proceedings. On January 14, 2011, after Bedrock filed its opposition to Defendants' motion, the PTO issued a notice of intent to issue a reexamination certificate. In the notice, the PTO indicated that it will be reissuing the '120 patent with four of its original claims, four amended claims, and four new claims. Although the exact date of reissuance is not clear, Defendants believe that the new '120 patent will reissue before the April 11 trial date in this action. The imminent issuance of the reexamination certificate for the '120 patent has significant consequences on this action because it confirms that half of the asserted claims – original claims 3, 4, 7 and 8 – no longer exist. As such, those four claims should be dismissed.

Bedrock should also be ordered to decide immediately whether it intends to add the four amended claims and four new claims to this action. If Bedrock decides to add any of these claims, Defendants respectfully request expedited briefing to address the impact these claims will have on this action. If Bedrock decides to not add these claims, it should be precluded from asserting them against Defendants in any future litigations.

Finally, because it appears that the reexamination proceedings will conclude shortly, Defendants hereby withdraw their motion to stay without prejudice.

## **II. DEFENDANTS' MOTION TO DISMISS CLAIMS 3, 4, 7 AND 8 SHOULD BE GRANTED BECAUSE THOSE CLAIMS NO LONGER EXIST**

Claims 3, 4, 7 and 8 as they currently exist in the '120 patent, as construed by the Court, as framed in Bedrock's infringement contentions, and as framed in Defendants' invalidity contentions no longer exist. Bedrock has abandoned these claims by introducing amended language into the claims in an attempt to avoid the PTO's conclusion that the claims as originally

stated are invalid.<sup>1</sup> The PTO's notice of intent to issue a reexamination certificate states that the certificate will be issued with amended independent claims 3 and 7.<sup>2</sup> Claims 4 and 8 have similarly changed because they depend from claims 3 and 7, respectively.<sup>3</sup> Defendants are aware of no authority that permits trial over abandoned claims and Bedrock has cited none. There is no basis for a trial on claims that no longer exist. Claims 3, 4, 7 and 8 should be dismissed.

### **III. BEDROCK SHOULD BE ORDERED TO IMMEDIATELY STATE WHETHER IT INTENDS TO ASSERT THE AMENDED AND NEW CLAIMS**

Bedrock should be ordered to decide immediately whether it intends to assert any of the amended or new claims in this action. If Bedrock decides to assert amended claims 3, 4, 7 or 8, or to assert new claims 9-12 against Defendants, the Court should set a schedule for expedited briefing to address the impact of introducing the newly amended and new claims at this late stage of the case. Defendants note that if Bedrock decides not to add the amended or new claims, Bedrock will be precluded from doing so in a future lawsuit under the doctrine of *res judicata*. *See, e.g., Allen v. McCurry*, 449 U.S. 90, 94 (1980). This “relieve[s] parties of the cost and vexation of multiple lawsuits, conserve[s] judicial resources, and, by preventing inconsistent decisions, encourage[s] reliance on adjudication.” *Id.*

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<sup>1</sup> Although Bedrock claims that its amendments merely “clarify” the claim language, Defendants strongly disagree and believe that the amendments significantly narrow the scope of these claims. The parties should have an opportunity to brief and be heard on the impact of the new language in these claims should Bedrock attempt to assert them in this action.

<sup>2</sup> *See* Exhibit A.

<sup>3</sup> The amendments introduce new claim terms, such as “target record” and “while searching for a target record” that were not present in the original claims. The amendments significantly change the scope of the claims.

#### IV. CONCLUSION

For the foregoing reasons, Defendants respectfully request that the Court: (1) dismiss claims 3, 4, 7, and 8 of the '120 patent, (2) order Bedrock to state by February 4, 2011 whether it intends to assert any of the new or amended claims in this action, (3) if Bedrock decides to add any of the amended or new claims, set an expedited briefing schedule addressing the impact of those claims on this action, and (4) if Bedrock decides not to add any of the amended or new claims, order that Bedrock cannot assert those claims against Defendants in any future litigations. Finally, Defendants hereby withdraw their motion to stay without prejudice.

Dated: January 24, 2011

Respectfully submitted,

*/s/ Todd Briggs, with permission by*

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that all counsel of record who have consented to electronic service are being served with a notice of filing of this document pursuant to L.R. CV-5(a)(7).

Date: January 24, 2011

*/s/ Michael E. Jones*

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