

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

**BEDROCK COMPUTER
TECHNOLOGIES LLC,**

Plaintiff,

v.

**SOFTLAYER TECHNOLOGIES, INC.,
et al.**

Defendants.

§
§
§
§
§
§
§
§
§
§
§
§
§
§
§

CASE NO. 6:09-cv-269-LED

Jury Trial Demanded

**PLAINTIFF’S SUPPLEMENTAL BRIEFING IN SUPPORT OF ITS
MOTION IN LIMINE REGARDING REEXAMINATION OF THE ’120 PATENT**

Plaintiff Bedrock Computer Technologies LLC (“Bedrock”) submits this supplemental briefing in support of Bedrock’s motion in limine that seeks to exclude references to the January 10, 2011 reexamination proceeding of the ’120 Patent, which is the second reexamination of the ’120 Patent. For the reasons below, the second reexamination is not a reconsideration of the first reexamination, which confirmed the patentability of the claims at issue in this case. As a result, the Court should exclude the second reexamination.

A. The MPEP Provides, And The PTO Found, That The Second Reexamination Must Show A Substantial New Question Of Patentability “Different From” The Question Raised In The First Reexamination

The Manual of Patent Examining Procedure makes clear that a second reexamination request filed when a first reexamination is pending “should be determined on its own merits without reference to the pending reexamination.” (Aurentz Declaration at Ex. A, MPEP 2240). Furthermore, “in order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of

patentability (“SNQ”) which is *different from* that raised in the pending reexamination for *the claims in effect at the time of the determination.*” *Id.* (emphasis in original) If a different substantial new question of patentability is not provided by the second request for reexamination, the request *must be denied.* *Id.* (emphasis added). A different substantial new question of patentability can be based solely on art that was previously considered by the PTO in the first reexamination or the original examination of the patent (i.e. “old art”), where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in earlier concluded examination(s), in view of *a material new argument or interpretation presented in the requests.* (Aurentz Dec. at Ex. B MPEP 2258.01) (emphasis added).

The procedural posture of the now finalized first reexamination and the second granted request for reexamination proves by itself that the PTO is not reconsidering the same arguments or issues as presented in the first reexamination. When discussing the reasons for granting the second reexamination the examiner stated that the “cited teachings are new and non-cumulative...” with respect to the first reexamination. (Aurentz Dec. at Ex. C, PTO Action Granting Second Reexamination at 10-11). The PTO has found that the two reexaminations present different arguments and issues.

B. The Patent Office Declining To Merge The Two Proceedings Shows That They Present Different Questions

“Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, 37 CFR 1.565(c) provides that the proceedings will usually be merged.” (Aurentz Dec. at Ex. D MPEP 2283). “No petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings.” *Id.* The PTO has the sole discretion to merge or not merge co-pending reexamination

proceedings. *Id.* The PTO “always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster ‘special dispatch.’ The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis.” (Ex. D, MPEP 2283).

The requestor of the second reexamination filed a Notice of Concurrent and Related Office Proceedings and Concurrent Litigation on January 11, 2011 informing the PTO of the first reexamination. The PTO issued the Notice of Intent To Issue Reexamination Certificate in the first reexamination on January 14, 2011, terminating the prosecution of that case. Applying a case by case analysis and the authority to merge the reexaminations, the PTO had the ability to keep the first reexamination open by merging the second reexamination into it, but chose not to. The decision not to merge and to assign the reexamination its own unique identifier shows that the second reexamination is different from the first reexamination.

C. The Second Requestor Was Not Seeking A Reconsideration Of The First Reexamination

The anonymous requestor of the second reexamination sought reexamination on art not before the PTO or on art that was presented to the PTO in a new light. Specifically, the second requestor had to certify the following:

The SNQs raised herein are based on prior art that was either considered and discussed during the prosecution of the '120 patent, but which is considered herein in a new light, as permitted under the rules, reexamination examining procedures, and case law, or was not cited altogether. The references, alone or in combination, are not cumulative to the prior art discussed during the original prosecution. Thus, they are appropriate for use in supporting the SNQs of patentability raised herein.

(Aurentz Dec. at Ex. E, Second Request For Reexamination at 9). One example reference that had never been previously considered by the PTO, that the requestor asked the PTO to consider

in the second reexamination, was the Van Wyk reference. The second requestor also asked the PTO to consider references that had been previously considered in the first reexamination by arguing that they should be viewed in a “new light” by submitting declarations from an expert for every previously considered reference. (Ex. E at 17). Specifically the requestor stated,

In the presently filed request for reexamination of claims 1-8 of the '120 patent, Requester has attached Declarations A, B and C, each executed by Dr. Michael Kogan. Requester has also submitted prior art documents that were relied upon by the Requester in the earlier 901010,856 reexamination request. These prior art documents are submitted “in a new light,” in view of the declarations of Dr. Kogan.

(Ex. E at 17). Thus, by the requestor’s own admission the information being reviewed by the PTO in the second reexamination is new and different from the first analysis done by the PTO. The examiner agreed with the requestor when granting the second reexamination request based on old art by stating, “The Request cites *new and non-cumulative* teachings of [old art] that a reasonable examiner would consider important in determining patentability of the claims that raise a substantial new question.” (Ex. C at 9-10).

D. Allowing the Second Reexamination Into Evidence Will Confuse The Jury

The procedural posture of the '120 Patent with respect to reexaminations is no different than if the first reexamination had been filed and concluded prior to the filing of this lawsuit and then having a second reexamination filed during the litigation. The timing of the different, unique reexamination proceedings should have no bearing on the Court’s evidentiary decision. It is this and other Courts’ practice to exclude the confusing non-final reexamination proceeding from introduction into evidence. *i4i L.P. v. Microsoft Corp.*, 670 F. Supp. 2d 568, 588 (E.D. Tex. 2009) (Davis, J.); *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 647 F. Supp. 2d 323, 356 (D. Del. 2009). The Federal Circuit has also affirmed similar district court rulings. *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1343 (Fed. Cir. 2009).

III. CONCLUSION

For the foregoing reasons the Court should exclude any evidence or argument about the second reexamination proceeding.

Dated: March 29, 2011.

Respectfully submitted,

McKOOL SMITH, P.C.

/s/ Jason D. Cassady

Douglas A. Cawley, Lead Attorney

Texas Bar No. 04035500

dcawley@mckoolsmith.com

Theodore Stevenson, III

Texas Bar No. 19196650

tstevenson@mckoolsmith.com

Rosemary T. Snider

Texas Bar No. 18796500

rsnider@mckoolsmith.com

Scott W. Hejny

Texas State Bar No. 24038952

shejny@mckoolsmith.com

Jason D. Cassady

Texas Bar No. 24045625

jcassady@mckoolsmith.com

J. Austin Curry

Texas Bar No. 24059636

acurry@mckoolsmith.com

Phillip M. Aurentz

Texas State Bar No. 24059404

paurentz@mckoolsmith.com

Daniel R. Pearson

Texas State Bar No. 24070398

dpearson@mckoolsmith.com

McKOOL SMITH, P.C.

300 Crescent Court, Suite 1500

Dallas, Texas 75201

Telephone: 214-978-4000

Facsimile: 214-978-4044

Sam F. Baxter

Texas Bar No. 01938000

McKOOL SMITH, P.C.

sbaxter@mckoolsmith.com

104 E. Houston Street, Suite 300

P.O. Box 0

Marshall, Texas 75670

Telephone: (903) 923-9000
Facsimile: (903) 923-9099

Robert M. Parker
Texas Bar No. 15498000
Robert Christopher Bunt
Texas Bar No. 00787165
PARKER, BUNT & AINSWORTH, P.C.
100 E. Ferguson, Suite 1114
Tyler, Texas 75702
Telephone: 903-531-3535
Facsimile: 903-533-9687
E-mail: rmparker@pbatyler.com
E-mail: rcbunt@pbatyler.com

**ATTORNEYS FOR PLAINTIFF
BEDROCK COMPUTER TECHNOLOGIES
LLC**

CERTIFICATE OF SERVICE

The undersigned certifies that, on March 29, 2010, the foregoing document was filed electronically in compliance with Local Rule CV-5(a). As such, this notice was served on all counsel who have consented to electronic service. Local Rule CV-5(a)(3)(A).

*/s/ Jason D. Cassidy*_____