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

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| Bedrock Computer Technologies LLC,<br><br>Plaintiff,<br><br>v.<br><br>SoftLayer Technologies, Inc., et al.,<br><br>Defendants. | Case No. 6:09-CV-269-LED<br><br>JURY TRIAL DEMANDED |

**DEFENDANT AOL'S NOTICE OF SUPPLEMENTAL AUTHORITY IN SUPPORT OF ITS MOTION FOR CLARIFICATION AND/OR RECONSIDERATION OF JUDGE LOVE'S ORDER DENYING SUMMARY JUDGMENT REGARDING THE LEGAL ISSUE OF WHETHER MERE CAPABILITY IS SUFFICIENT FOR INFRINGEMENT OF CLAIMS 1-2 OF THE '120 PATENT (DKT. NO. 665)**

Defendant AOL respectfully submits the following Notice of Supplemental Authority in support of its Motion for Clarification and Reconsideration of Judge Love's Order Denying Summary Judgment Regarding the Legal Issue of Whether Mere Capability is Sufficient for Infringement of Claims 1-2 of the '120 Patent (Dkt. No. 665). On April 7, 2011, the U.S. District Court for the Eastern District of Wisconsin addressed this exact legal question and granted summary judgment of noninfringement.

In *Mikkelsen Graphic Engineering (MGE) v. Zund America*, the court held that MGE's apparatus claims were not drafted to suggest capability, and therefore, actual performance of the functions was necessary to infringe the claims. Because Zund disabled (but did not remove) the accused code, Zund did not perform the claimed functions. Therefore, Zund did not infringe as a matter of law. No. 2:07-cv-00391-LA, Dkt. No. 266, at 18-22 (E.D. Wisc., Apr. 7, 2011) (attached hereto as Exhibit A). In reaching its decision, the Court stated:

> MGE's argument that disabling the search function does not cure the infringement is based on its contention that an accused product "need only be capable of operating" in an infringing way in order for a sale of that product to constitute direct infringement. However, this is not a complete statement of the law. Although the sale of an accused product that is capable of operating in non-infringing modes may infringe a patent, that can occur only where the claims of the patent are "drawn to capability." *Finjan, Inc. v. Secure Computing Corp.*, 626 F.3d 19979, 1204 (Fed. Cir. 2010); *Ball Aerosol & Speciality Container, Inc. v. Limited Brands, Inc.*, 555 F.3d 984, 994-95 (Fed. Cir. 2009). For a claim to be drawn to capability, the claim language must specify a product that is capable of performing a particular function or operation, not merely a device that actually performs that function or operation.

*Mikkelsen*, No. 2:07-cv-00391-LA, at 19 (citation and footnote omitted). The Court went on to explain:

> Nothing in MGE's apparatus claims suggests that a device that contains disabled source code for searching is within the scope of the claims. The claims are not drafted in terms of software components but in terms of the *actual function* of the apparatus. In

> other words, the apparatus claims specify a device that performs MGE's methods, not a device that contains software code for performing MGE's methods. When the code for searching is disabled, the device does not perform MGE's methods, and thus sales of the device with the code for searching disabled is not direct infringement.

*Id.* at 21-22 (emphasis added, footnote omitted).

Claim 1 of Bedrock's 120 patent requires, for example: "a linked list to store and provide access to records stored in memory of the system, at least some of the records automatically expiring" and "a record search means utilizing a search key to access the linked list." Claim 1 uses active tense; claim 1 does not specify mere capability. Therefore, claim 1, like the claims in *MGE,* requires that the functions be actually performed. If the accused device does not have a linked list with records that automatically expire, and does not use a search key to access the linked list, there can be no infringement. Bedrock has produced no evidence, nor can it, that AOL ever performs the claimed functions. Therefore, as in *MGE,* summary judgment of noninfringement is appropriate for AOL.

Respectfully submitted, this the 12th day of April 2011.

/s/ *Deron Dacus*_____

Deron R. Dacus
Texas Bar No. 00790553
derond@rameyflock.com
Ramey & Flock, P.C.
100 E. Ferguson, Suite 500
Tyler, Texas 75702
Telephone: (903) 597-3301
Facsimile: (903) 597-2413

Frank G. Smith
frank.smith@alston.com
ALSTON & BIRD LLP
One Atlantic Center
1201 West Peachtree Street

Atlanta, GA 30309
Telephone: (404) 881-7240
Facsimile: (404) 256-8184

Alan L. Whitehurst
alan.whitehurst@alston.com
Marissa R. Ducca
marissa.ducca@alston.com
ALSTON & BIRD LLP
The Atlantic Building
950 F Street, N.W.
Washington, DC 20004
Telephone: (202) 756-3300
Facsimile: (202) 756-3333

Louis A. Karasik (*pro hac vice*)
lou.karasik@alston.com
Rachel Capoccia
rachel.capoccia@alston.com
ALSTON & BIRD LLP
333 South Hope Street
16th Floor
Los Angeles, CA 90071
Telephone: (213) 576-1148
Facsimile: (213) 576-1100

*Attorneys for Defendant AOL Inc.*

**CERTIFICATE OF SERVICE**

This is to certify that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this notice via the Court's CM/ECF system per Local Rule CV-5(a)(3) on this 12th day of April, 2011. Any other counsel of record will be served by first class mail.

*/s/ Deron Dacus* _____