

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
TYLER DIVISION

BEDROCK COMPUTER
TECHNOLOGIES LLC,

Plaintiff,

v.

SOFTLAYER TECHNOLOGIES, INC. et
al.,

Defendants.

CASE NO. 6:09-CV-00269

Hon. Leonard E. Davis

JURY TRIAL DEMANDED

**DEFENDANTS' UNOPPOSED RENEWED MOTION FOR LEAVE
TO SERVE AN EXPERT REPORT REGARDING REEXAMINATION PROCEDURES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

I. INTRODUCTION

The United States Patent & Trademark Office (“USPTO”) has granted two reexamination requests of the patent-in-suit, U.S. Patent No. 5,893,120 (the ‘120 Patent). The requests for these reexaminations specifically involved a number of prior art references that the Defendants¹ do not intend to use at trial. During both reexaminations, several prior art references that Defendants intend to use at trial were listed in an IDS submitted to the USPTO, but there is no evidence that several of these prior art references were considered by the examiner who conducted the first reexamination. To ensure the jury has a clear understanding of USPTO procedure associated

¹ This motion is filed on behalf of Defendants Amazon.com Inc., SoftLayer Technologies, Inc., MySpace, Inc., AOL Inc, and Yahoo! Inc.

with submission and consideration of prior art, as well as the USPTO's procedures that led to the grant of a second reexamination, Defendants filed a motion for leave to serve an expert report regarding reexamination procedures in the USPTO.² The motion requested that, if the Court admitted the evidence of the reexaminations of the '120 patent, the Court also grant the Defendants leave to disclose an expert with respect to the USPTO's reexamination process. Subsequently, Magistrate Judge Love granted Defendants' Motion in Limine #4, which precluded Plaintiff from offering testimony, evidence or argument regarding the reexaminations of the '120 patent.³ Thus, Defendants' motion for leave to serve an expert report regarding reexamination procedures in the USPTO was rendered moot. Accordingly, the Court denied Defendants' motion.⁴ During trial of a co-Defendant in this matter, the Court allowed the Plaintiff to present evidence of one of the reexaminations of the '120 patent.⁵ The Court also permitted the co-Defendant to present testimony from a USPTO expert.⁶ In consideration of the Court's decision, Defendants renew their motion to serve an expert report regarding reexamination procedures in the USPTO.⁷

² Defendants' Motion for leave to Serve an Expert Report Regarding Reexamination Procedures in the United States Patent and Trademark Office, *Bedrock Computer Technologies v. SoftLayer Technologies, Inc. et al.*, 6:09-cv-269 (E.D. Tex. March 28, 2011), DKT 668.

³ Order, *Bedrock Computer Technologies v. SoftLayer Technologies, Inc. et al.*, 6:09-cv-269 (E.D. Tex. March 30, 2011), DKT 680.

⁴ Order, *Bedrock Computer Technologies v. SoftLayer Technologies, Inc. et al.*, 6:09-cv-269 (E.D. Tex. March 31, 2011), DKT 691.

⁵ *Bedrock Computer Technologies v. Google*, 6:09-cv-269, Trial Transcript, April 11, 2011, Morning Session, 11:14-18.

⁶ *Bedrock Computer Technologies v. Google*, 6:09-cv-269, Trial Transcript, April 13, 2011, Afternoon Session, 77:5-167:3.

⁷ Defendants intend to offer the opinion of Mr. Nick Godici, a former U.S. Patent Examiner and the former Commissioner for Patents. Mr. Godici's Expert Report was served on April 20, 2011 and is attached hereto as Exhibit A.

Defendants hereby restate all facts and arguments presented in the March 28, 2011, motion for leave to serve an expert report regarding reexamination procedures⁸ and renew their request that, if the Court decides to permit reference to either or both of the reexaminations,⁹ the Court also grant the Defendants leave to disclose an expert with respect to the USPTO's reexamination process. In particular, due to the complexity of the dual reexaminations of the '120 Patent, and the fact that the examiner considered some, but not all, prior art submitted, there is a significant danger that the jury will become confused regarding what the examiner's decision means in the context of the second reexamination, and whether all the prior art was indeed considered. To counter this danger, Defendants renew their request that they be allowed to rely on the testimony of an expert in the USPTO's reexamination procedures who can guide the jury through the USPTO's procedures for considering submitted prior art, and also explain why the USPTO granted a second reexamination of the '120 patent, before issuing a certificate in the first reexamination.

⁸ Defendants' Motion for leave to Serve an Expert Report Regarding Reexamination Procedures in the United States Patent and Trademark Office, *Bedrock Computer Technologies v. SoftLayer Technologies, Inc. et al.*, 6:09-cv-269 (E.D. Tex. March 28, 2011), DKT 668.

⁹ Defendants plan to file a Bench Brief in support of excluding all references to both reexaminations as addressed in Defendants' Motion in Limine #4 [DKT 604] and in opposition to Plaintiff's Motion in Limine A [DKT 587].

Dated: April 21, 2011

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that all counsel of record who are deemed to have consented to electronic service are being served with a copy of the forgoing document via the Court's CM/ECF system pursuant to the Court's Local Rules this 21st day of April, 2011.

/s/ E. Danielle T. Williams