

Yahoo! hereby responds to Bedrock's Notice of Conclusion of Second Reexamination ("Notice"). In its Notice, Bedrock asserted that "the art relied upon by Yahoo! was undeniably in front of the USPTO in the second re-examination." Dkt. No. 878 at 1. Bedrock's assertion is irrelevant, because the second reexamination was not allowed to be presented to the jury at trial and is not in evidence.¹ Further, the issue is not whether the prior art relied upon by Yahoo! was in front of the PTO; rather, the issue is whether the examiner substantively considered the prior art. This Court should only defer to the PTO if and when the PTO actually examines the patent in view of the Yahoo! prior art. It is clear from the examination history that the PTO did no such thing. Contrary to Bedrock's assertion, there is no indication in the second reexamination record, on the Notice of Intent to Issue *Ex Parte* Reexamination Certificate ("NIRC"), or on the *Ex Parte* Reexamination Certificate that the examiner ever considered the prior art Yahoo! relied upon at trial and in briefing on Yahoo!'s Renewed Motion for Judgment as a Matter of Law Regarding Invalidity (Docket Nos. 845, 871) ("Motion").

FACTUAL BACKGROUND

Yahoo! presented evidence at trial that the following prior art either anticipates or makes obvious the '120 patent: 1) early versions of the Linux route.c file (Linux source code versions 1.3.52, 1.3.53, and 2.0.1 ("the '95 Linux Code")), and 2) the Naval Research Laboratories key management computer source code ("the NRL code"). *See* Motion at 6-14 and 14-20, respectively. There is no indication that the PTO ever substantively considered either of these two sets of prior art in the second reexamination.

The Request for *Ex Parte* Reexamination of U.S. Patent No. 5,893,120, No. 90/011,426 ("Request") was filed on January 10, 2011 and cited six pieces of prior art: an article by Christopher J. Van Wyk and Jeffrey Scott Vitter; the '495 and '499 patents issued to Richard

¹ Docket No. 680, regarding Bedrock's Motion *in limine* A.

Nemes; and three patents issued to Thatte, Dirks, and Morris. These six references were included on an Information Disclosure Statement (“IDS”) accompanying the January 2011 Request.

In February 2011, the PTO granted the Request for Reexamination. Along with the order, the examiner included a copy of the January 2011 IDS, upon which he had initialed the six pieces of prior art cited in the Request and considered as required by PTO regulations. MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) 609.05(b) (“Examiners must consider all citations submitted in conformance with the rules, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form PTO/SB/08A and 08B . . . provides a clear record of which citations have been considered by the Office.”).

On April 1, 2011, Bedrock submitted an IDS which cited two early versions of the ’95 Linux code—Linux source code versions 1.3.52 and 2.0.1. However, the examiner did not initial or make any other marking on this IDS indicating that the examiner considered these references.²

On April 28, 2011—after the first day of trial—Bedrock submitted to the PTO the declaration of Alexey Kuznetsov, including attachments of the ’95 Linux code. There is no IDS in the reexamination record for this submission, and no indication in the record that the examiner considered these documents. Bedrock also submitted an IDS that cited the NRL code. Again, there are no initials or any other marking on this IDS in the record, and no indication that the examiner considered these references.

As Yahoo! has already noted in the Motion, the NIRC does not indicate that the NRL code or the ’95 Linux code were ever considered by the PTO during the reexamination. In fact, the NIRC specifies that the Certificate will be issued in view of the “Request for Reexamination

² At trial, Nicholas Godici, former Commissioner for Patents at the PTO, testified that the absence of an examiner’s initials indicated that prior art was not reviewed. Trial Transcripts May 9, 2011 (Afternoon) at 170:23-171:6.

submitted 1/10/2011,” and does not contain any citation, mention, or discussion of any prior art considered other than the art included in the Request.

The Certificate itself only lists the article and patents included in the Request, and does not identify the art relied upon at trial. Dkt. No. 878-1.

CONCLUSION

Contrary to Bedrock’s characterization, the reexamination record establishes that the PTO did not consider the art that Yahoo! relied upon at trial and in its Renewed Motion for Judgment as a Matter of Law Regarding Invalidity. In fact, the Reexamination Certificate does not identify the art relied upon at trial.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a). All other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing by certified mail, return receipt requested, on this the 28th day of September, 2011.

/s/ Yar R. Chaikovsky _____
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