UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
TYLER DIVISION

EOLAS TECHNOLOGIES, INC. and THE REGENTS OF THE UNIVERSITY OF CALIFORNIA	§	
Plaintiffs,	§	
v.	§	CIVIL ACTION NO. 6:09-CV-446 (LED)
ADOBE SYSTEMS, INC. ET AL.,	§	
Defendants.	§	

DEFENDANTS' MOTION TO LIMIT THE NUMBER OF ASSERTED CLAIMS FOR TRIAL

With merely five weeks to trial, Plaintiffs Eolas Technologies, Inc. ("Eolas") and the Regents of the University of California (collectively "Plaintiffs") continue to assert more than 20 claims against 10 separate defendants. Despite requests by the defendants, a written order, and oral encouragement from this Court, Plaintiffs continue to stall in selecting a reasonable number of claims for trial. Patent infringement trials are not a "gotcha" game – and plaintiffs should not be allowed to make it so. Now is the time – when the parties are making critical decisions about pretrial disclosures as to exhibits, witnesses and deposition designations – to narrow the number of asserted claims to focus on trial preparation. For the reasons set forth below, Defendants respectfully request that the Court now limit the number of claims that Plaintiffs can assert at trial to three or fewer claims per patent in order to streamline this case for trial.

I. Background

When Eolas filed this case in October 2009, it asserted 61 claims from two patents against a vast array of diverse defendants. On December 21, 2010, this Court ordered the parties

to meet and confer to "narrow the number of disputed claims to a reasonable number." Dkt. No. 536. Thereafter, Eolas only dropped 16 claims leaving 45 claims remaining in dispute. Due to the large number of claims still remaining, at the June 29, 2011 hearing, Defendants again requested this Court to require Eolas to narrow their claims to a reasonable number for trial, and this Court again encouraged them to narrow the case. Dkt. No. 762.

Since that time, however, Plaintiffs have done little to "narrow" this case but, instead, have chosen the opposite course. Specifically, in September 2011, Eolas added the Regents of the University of California as a plaintiff in this case – leading to the production of more than 430,000+ files (which are still being produced, contrary to Eolas' representation to this Court in September that they would be produced in short form) and at least five additional depositions (only one of which has occurred to date). Moreover, Plaintiffs requested this Court to reconsider its claim construction order to broaden the term "executable application" beyond the construction originally given by this Court and given by the Patent & Trademark Office in the patent file history. The result of which broadened the number of allegedly infringing products and web pages. Now, the parties have produced their expert reports, a number of supplemental reports and rebuttal reports. After all the dust has settled, Plaintiffs still assert some 22 claims from two patents against each of the 10 remaining defendants on a diverse array of products and technologies.

Plaintiffs have had more than two years since the filing of this lawsuit to identify their strongest claims. Furthermore, Plaintiffs have now had over five months to evaluate Defendants' invalidity expert reports and two months to evaluate Defendants' non-infringement reports. Plaintiffs have no justification for their refusal to meaningfully reduce the number of claims they continue to assert.

II. Argument

It is customary in complex patent cases involving a large number of claims to be tried and decided on a much smaller number of "representative claims." *See, e.g., Baxter Int'l, Inc. v. Cobe Labs., Inc.*, 88 F.3d 1054, 1056-57 (Fed. Cir. 1996) (plaintiff asserted twelve patent claims but a stipulation was reached to decide the infringement and validity on three claims).

> In presenting a patent case to the jury, counsel must address which claims of the asserted patent or patents are being allegedly infringed upon. Thus, the potential for jury confusion in a patent case increases exponentially with the number of claims asserted. Additionally, when the number of claims being asserted is so voluminous, litigation becomes extremely burdensome on both the parties and the Court.

Ronald A. Katz Tech. Licensing, L.P. v. Citibank, No. 5:05-cv-142-DF (E.D. Tex. January 27, 2006) (Dkt. No. 73, Order From Scheduling Conference And Docket Control Order) (This Court finding it within its discretion to limit the number of claims to help effectuate case management); *see In Re Katz*, 639 F.3d 1303 (2011) (Federal Circuit affirmed various district courts' procedures for limiting claims to a manageable number).

Indeed, Federal Rules of Civil Procedure 1 and 16 necessitate a "just, speedy, and inexpensive determination of every action" that is formulated and simplified through the guidance of the Court. Likewise, the Court has the authority to require Plaintiffs to limit the number of asserted claims for trial to a reasonable and manageable number. In fact, some courts, including courts in this district, have required plaintiffs to streamline the case to as few as three claims per patent. *See, e.g., Hearing Components, Inc. v. Shure, Inc.*, No. 9:07-CV-104-RC, 2008 WL 2485426, at *1 (E.D. Tex. June 13, 2008) (ordering the plaintiff to select no more than 3 representative claims from each patent for claim construction and trial when 3 patents were asserted); *Verizon Cal. Inc. v. Ronald A. Katz Tech. Licensing, L.P.*, 326 F. Supp. 2d 1060, 1066 (C.D. Cal. 2003) (ordering plaintiff to select no more than three representative claims per patent

for its infringement case). Moreover, a number of other courts have ordered the plaintiff to proceed to trial with even greater limitations on the number of asserted claims. *See, e.g., Online News Link LLC v. Apple, Inc.*, No. 2:09-CV-312-DF (E.D. Tex. Mar. 12, 2010) (docket control order) (limiting plaintiff to 10 claims for claim construction); *Cummins-Allison Corp. v. SBM Co., Ltd.*, 669 F. Supp. 2d 774, 780 (E.D. Tex. 2009) (eight representative claims for trial when four patents were asserted).

Likewise, the Federal Circuit has affirmed the practice of limiting a plaintiff's claims to a manageable number of representative claims. *See ReRoof Amer., Inc. v. United Structures of Amer., Inc.*, 215 F.3d 1351 (Fed. Cir. Aug. 30, 1999) (Federal Circuit affirmed district court's decision to limit plaintiff to five representative claims for trial despite plaintiff's claim of prejudice); *Kearns v. General Motors Corp.*, No. 95-1535, 1994 U.S. App. LEXIS 19568 (Fed. Cir. July 26, 1994) (Federal Circuit affirmed district court's decision to dismiss plaintiff's case after plaintiff failed to comply with court order to limit case to one representative claim per patent).

Here, as is common practice throughout patent cases, Plaintiffs should be required to limit the number of claims for trial. Defendants' request is not overly burdensome. Indeed, as the cases above demonstrate, Defendants' request is far less restrictive than the limits imposed by numerous other courts. Now, before pretrial disclosures, is the time to streamline this case for trial, and reducing the case to three or fewer asserted claims per patent would significantly aid this cause. Plaintiffs should not be allowed to hold their cards until the eleventh hour and then on the eve of trial drop several claims as a trial strategy designed only to obfuscate the true issues for trial. Plaintiffs either have a viable infringement case or they do not – their continued attempts to hide the ball are telling. Plaintiffs should not be allowed to waste this Court's or the

defendants' time and efforts in last minute trial preparation with these continued tactics.

III. Conclusion

As Plaintiffs are certainly aware, the parties will be given limited time at trial to present their evidence. Likewise, Defendants will only have a limited amount of time to defend against Plaintiffs' infringement theories and present their invalidity case. It is without question that neither side will have sufficient time to present evidence regarding 22 asserted claims. In order to conserve the Court's and the parties' resources, Defendants respectfully request that the Court now limit the number of representative claims for Plaintiffs to three or fewer claims per patent for trial.

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 30th day of December, 2011.

/s/ Jennifer H. Doan
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CERTIFICATE OF CONFERENCE

Counsel for Amazon and Yahoo! had a meet and confer with Plaintiffs counsel on December 8, and follow-up emails on December 19 and December 30, 2011, to which no response has been received regarding this motion.

/s/ Jennifer H. Doan
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