

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
TYLER DIVISION

EOLAS TECHNOLOGIES, INC. AND THE
REGENTS OF THE UNIVERSITY OF
CALIFORNIA,

Plaintiffs,

v.

ADOBE SYSTEMS, INC., ET AL.,

Defendants.

Civil Action No. 6:09-CV-446 LED

JURY TRIAL DEMANDED

**ADOBE SYSTEMS INCORPORATED'S MOTION *IN LIMINE* TO EXCLUDE
EVIDENCE OF EFFORTS TO INITIATE A RE-EXAMINATION OF THE '906
PATENT**

Subject to its Motion for Leave to file a separate *Motion in Limine*, filed on this same date, Adobe Systems Incorporated (“Adobe”) submits this Motion and Memorandum of Law in to exclude evidence relating to efforts by any party or third party to persuade the Director of the United States Patent And Trademark Office (“USPTO”) to initiate a re-examination of U.S. Patent No. 5,838,906 (the ’906 patent).

I. INTRODUCTION

Plaintiffs accuse Adobe of infringing the ’906 patent based on Adobe’s operation of various websites, such as Adobe.com and Photoshop.com. Plaintiffs assert that this infringement began in 2006, and their damages expert Weinstein places the hypothetical negotiation date at that time. Plaintiffs have also stipulated that they are not entitled to collect damages for any alleged infringement prior to the date the suit was filed, namely October 6, 2009.

Despite the fact that they claim no damages for any conduct by Adobe before October 2009, Plaintiffs seek to introduce evidence that Adobe and a company it acquired in 2006 (Macromedia) acted in 2003 to persuade the USPTO to re-examine the ’906 patent. Adobe does not seek to exclude evidence of the re-examination itself. However, the fact that Adobe desired in 2003 that the ’906 patent be re-examined is not relevant to any issue in this case. Moreover, Plaintiffs apparently seek to introduce this evidence to create the false impression that Adobe was concerned in 2003 that its websites infringed the ’906 patent. The record is clear, though, that Adobe, Macromedia, and the various non-parties that made up the W3C¹ were only concerned about the impact that the ’906 patent might have on *Microsoft’s* Internet Explorer web browser. If Eolas is allowed to make an issue of the fact that Adobe and others wanted the ’906

¹ The W3C is the World Wide Web Consortium, which is a non-profit organization started by Tim Berners-Lee, who invented the WWW. It has a diverse membership that includes parties and non-parties to the suit who are interested in promulgating standards for the WWW. *See, e.g.*, <http://www.w3c.org/Consortium>.

patent re-examined in 2003, then Adobe will need to respond by laying out the entire history of Plaintiffs' prior lawsuit with Microsoft, the particular infringement allegations there against Internet Explorer and the Microsoft Windows operating system, including the fact that Eolas included Macromedia and Adobe technology in its trial against Microsoft but never accused either of infringement, and the vastly different scope of infringement allegations in the present case vis-à-vis the Microsoft litigation. This irrelevant side-show would waste valuable trial time of the Court and jury, the parties, and will lead to substantial confusion over the real case-dispositive issues. Moreover, it would cause conflicts with other Defendants who oppose the admission of evidence of the Microsoft trial.

II. ARGUMENT

A. Adobe's And The W3C's Communications That Preceded the Director Ordered Re-Examination Of The '906 Patent Are Not Relevant To Damages Or Liability

Plaintiffs' damages expert Weinstein includes in his expert report a discussion of efforts in 2003 by Adobe, Macromedia, and the Patent Advisory Group of the W3C to convince the Director of the USPTO to re-examine the '906 patent. *See* Exh. A attached hereto at ¶¶ 70-73. Weinstein does not opine that these facts would have any impact on the hypothetical negotiation or damages in this case. Nor could he: by his own analysis, the hypothetical negotiation between Adobe and Eolas would have taken place in August of 2006, over three years after the Director-initiated reexamination was ordered and shortly after the re-examination concluded. *See* Exh. B attached hereto at ¶¶ 21, 54. The damages period admittedly does not start to run until October of 2009, when Eolas filed suit. Efforts years earlier to institute a re-examination have no relevance to the issue of a reasonable royalty in 2006, and Weinstein provides none.

In the same vein, Plaintiffs' technical expert Martin includes a "timeline" in his report that includes the following entries:

"October 14, 2003 Letter from AOL, Macromedia and Microsoft urging re-examination of the '906 patent is submitted to the PTO"

"October 15, 2003 Letter from Adobe urging director-ordered reexamination of the '906 patent is submitted to the PTO"

See Exh. C attached hereto at p. 19. But Martin offers no opinion that these events from 2003 have anything to do with his infringement analysis. Nor could he since his infringement analysis relates entirely to actions by Adobe after August of 2006.

Finally, Plaintiffs may suggest that the prior art identified in the letters to the Director of the USPTO did not include certain prior art which Defendants might rely on at trial, such as MediaView and Director, and may argue that the reason for the omission is that Adobe concluded the omitted prior art was no good. *See*, e.g., Exh. D attached hereto at 48:9-50:10 (examining a former Adobe employee on why Apple or others did not include certain prior art in the letters to the USPTO regarding reexamination and why Apple was dismissed from the case; to minimize burden on the court this testimony is not submitted but can be if the characterization of it is in question). The argument is a non-sequitur, would be based wholly on speculation, and plainly would prejudice Defendants.

Thus, Adobe's (or anyone else's) communications about re-examination of the '906 patent have no relevance to the damages or liability issues for trial in this case. Plaintiffs have placed them into their expert reports as a back-door means of getting the evidence before the jury, even though it does not relate to the experts' opinions.

B. Communications Concerning Re-Examination Of The '906 Patent Are Not Relevant To Willfulness

Plaintiffs likely will also argue that Adobe's 2003 re-examination communications are relevant to willfulness.² Plaintiffs may argue that the evidence is necessary to establish that Adobe knew about the '906 patent in 2003. This is not in dispute; Adobe has admitted that it was aware of the '906 patent in 2003. What Plaintiffs really seek is an inference that, because Adobe desired that the '906 patent undergo re-examination, Adobe believed its websites infringed the patent. But the very documents that Plaintiffs' cite demonstrate that this is not true:

Additionally, Adobe asserted that significant concerns have been expressed within the broader community of owners and users of websites on the internet regarding *changes that would have to be implemented in web browsers* to avoid infringing the ['906] patent.

See Exh. A at ¶ 71, (quoting letter from Adobe's Meme Jacobs Rasmussen to USPTO Director Steven Kunin) (emphasis added); see also pp. 41-44.

As the letter plainly states, Adobe was concerned that the '906 patent might force browser companies like Microsoft to make changes to their *web browsers*. Because those browsers interacted with Adobe products, Adobe was concerned that such changes would be disruptive to its products and its customers. But these communications do not support an inference that Adobe was concerned that *its websites*—the accused instrumentality in this case—infringed the '906 patent. To the contrary, Plaintiffs' were well aware of Adobe's and Macromedia's products, since Eolas used them as evidence *against Microsoft* in the 2003 trial. Plaintiffs never suggested that any Adobe or Macromedia product or website infringed the '906 patent prior to commencing this action in October of 2009. It surely raised no such claim in

² Adobe has filed a summary judgment motion as to Plaintiffs' willfulness claim, based on Plaintiffs' stipulation that it has no claim for pre-suit damages, and the fact that it did not seek a preliminary injunction after filing suit.

2003, or at any time before filing suit six years later. The infringement verdict against Microsoft caused only business concerns for Adobe—not legal concerns as Plaintiffs would imply.

If Plaintiffs are allowed to try and obtain the false inference they seek with this evidence, Adobe will be forced to explain that *Microsoft* had suffered an adverse jury verdict, and that *Microsoft* was concerned about an injunction. Besides forcing Adobe to waste precious trial time debunking the false inference and recounting the complex history of the Microsoft litigation and appeal, there exists a very real possibility that the jury will tar Adobe with Microsoft's brush. The jury might wrongly believe that because Microsoft was an adjudicated infringer of the '906 patent, and because Adobe's products functioned with Microsoft's web browser, Adobe also infringed the '906 patent. This is presumably just what Plaintiffs want the jury to take away from the re-examination communications by Adobe, the W3C and others.

Adobe's actions in 2003 in lobbying the PTO simply are not relevant to infringement claims that begin—at the earliest—in August of 2006. Evidence about actions of the W3C—a group whose members (besides Adobe) are not even parties to this case—in 2003 is even further afield. To the extent that the evidence has any probative value, it is substantially outweighed by the unfair prejudice that comes with it. The Court should exclude the evidence pursuant to Fed. R. Evid. 402 and 403.

Dated: January 6, 2012

Respectfully submitted,

FISH & RICHARDSON P.C.

By: /s/ David J. Healey

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Counsel for Defendant

ADOBE SYSTEMS INCORPORATED

CERTIFICATE OF CONFERENCE

I certify that I spoke with attorneys for Plaintiff on January 5, 2012 and that the motion is opposed.

/s/ David J. Healey _____

David J. Healey

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on January 6, 2012 to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Local Rule CV-5(a)(3).

/s/ David J. Healey

David J. Healey