

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
NORFOLK DIVISION

I/P ENGINE, INC.

Plaintiff,

v.

AOL, INC., *et al.*,

Defendants.

Civil Action No. 2:11-cv-512

**MEMORANDUM IN SUPPORT OF MOTION IN LIMINE #1 TO PRECLUDE
PLAINTIFF FROM INTRODUCING EVIDENCE ON WILLFUL INFRINGEMENT,
PRE-SUIT KNOWLEDGE, OR COPYING**

Defendants respectfully file this Memorandum in support of their Motion to preclude Plaintiff from offering evidence of willful infringement, Defendants' pre-suit knowledge of the Asserted Patents, or Defendants' copying of the Asserted Patents.

I. PLAINTIFF SHOULD BE PRECLUDED FROM OFFERING EVIDENCE OF WILLFUL INFRINGEMENT

Plaintiff's latest Initial Disclosures, dated August 8, 2012, state that "I/P Engine may also seek increased damages based on defendants' willful infringement of the patents-in-suit." (Sohn Dec., Ex. A.) Yet it would be wholly improper for Plaintiff to introduce evidence of willful infringement at trial, for the simple reason that Plaintiff has never pled willful infringement. Plaintiff's Complaint makes no willful infringement claim (*see generally* D.N. 1), and Plaintiff's counsel recently admitted that "I/P Engine has not plead willfulness." (Sohn Dec., Ex. B.)

Because Plaintiff never pled willful infringement, Plaintiff may not argue willful infringement or seek enhanced willful infringement damages at trial. *See Revolution Eyewear, Inc. v. Aspex Eyewear, Inc.*, 563 F.3d 1358, 1373 (Fed. Cir. 2009) ("The most important fact here is that Contour failed to plead a claim for willful infringement. As a result, it was barred from seeking enhanced damages based on willful infringement"). It follows that Plaintiff may not introduce any evidence of willful infringement, as no willful infringement claim is properly in this case.

In an effort to avoid motion practice over this issue, Defendants repeatedly asked Plaintiff to confirm that it would not pursue a willfulness claim at trial. (Sohn Dec., Exs. C, D.) Plaintiff refused to confirm this fact, instead simply stating that "as counsel has pointed out, I/P Engine has not plead willfulness." (*Id.*, Ex. B.) Given Plaintiff's refusal to confirm that it will not pursue willfulness at trial (or to withdraw the statement from its Initial Disclosures that it "may" seek increased willfulness damages), Defendants had no choice but to bring the present Motion.

II. PLAINTIFF SHOULD BE PRECLUDED FROM OFFERING EVIDENCE THAT DEFENDANTS HAD PRE-SUIT KNOWLEDGE OF THE ASSERTED PATENTS

For the same reason, Plaintiff should be barred from introducing any evidence that Defendants had pre-suit knowledge of the Asserted Patents. Pre-suit knowledge of the Asserted Patents would have no relevance to any issue other than willful infringement. Yet, as discussed above, no willful infringement claim is properly in this case. Because Defendants' pre-suit knowledge would have no relevance to the claims and defenses that are in this case, Plaintiff should be barred from introducing any evidence of Defendants' pre-suit knowledge.

Furthermore, Plaintiff's supposed evidence of Defendants' pre-suit knowledge is far too weak and attenuated for the jury to conclude that Defendants actually had pre-suit knowledge of the Asserted Patents. For example, the only "evidence" of Google's pre-suit knowledge that

Plaintiff has put forth is an allegation that Google licensed a separate patent (the '361 Patent) from third-party Overture Services, Inc., that Overture was simultaneously prosecuting another patent application "related to the '361 patent," and that this patent application was rejected over one of the Asserted Patents. (See D.N. 1 at ¶¶ 48-53.) In other words, Plaintiff asks the jury to infer that Google had pre-suit knowledge of the Asserted Patents because a third-party patent application, "related to" a patent that Google licensed, was rejected over one of the Asserted Patents. No reasonable fact-finder could infer that Google had pre-suit knowledge of the Asserted Patents based on these facts. Accordingly, even if Google's pre-suit knowledge was relevant to any issues in this case (and it is not), none of Plaintiff's proffered evidence is actually probative of Google's pre-suit knowledge. Or at minimum, any slight probative value of this evidence would be substantially outweighed by the risk of jury confusion and sheer waste of time, thereby rendering this evidence inadmissible under Fed. R. Evid. 403.

III. PLAINTIFF SHOULD BE PRECLUDED FROM OFFERING EVIDENCE OR ARGUMENT THAT DEFENDANTS COPIED THE ASSERTED PATENTS

Just as Plaintiff has provided no competent evidence that Defendants had pre-suit knowledge of the Asserted Patents, Plaintiff has provided no evidence that Defendants copied the Asserted Patents. Indeed, while a defendant's copying of an asserted patent is a "secondary consideration" that may show the non-obviousness of the patent,¹ Plaintiff has never listed copying as a secondary consideration in this case. (See Sohn Dec., Ex. E) (listing various secondary considerations, but not copying). Thus, Plaintiff has never alleged copying in the one legal area (obviousness) for which it could theoretically be relevant.

¹ See, e.g., *DePuy Spine, Inc. v. Medtronic Somafor Danek, Inc.*, 567 F.3d 1314, 1328 (Fed. Cir. 2009).

Accordingly, any evidence or argument about copying that Plaintiff might offer at the present juncture would be irrelevant and highly prejudicial under Rule 403. For example, Plaintiff cannot support its infringement case by alleging that Defendants copied the Asserted Patents. *See DePuy*, 567 F.3d at 1336 ("evidence of copying is 'of no import on the question of whether the claims of an issued patent are infringed,' either literally or by equivalents.") To the contrary, a copying allegation could only serve to prejudice the jury by suggesting that the accused systems lack innovation and are mere replicas of the Asserted Patents.

Because any evidence or argument about copying would be irrelevant and prejudicial, Plaintiff should be precluded from offering such evidence at trial or arguing to the jury that Defendants copied the Asserted Patents.

DATED: September 21, 2012

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CERTIFICATE OF SERVICE

I hereby certify that on September 21, 2012, I will electronically file the foregoing with the Clerk of Court using the CM/ECF system, which will send a notification of such filing (NEF) to the following:

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