

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

**MICROUNITY SYSTEMS
ENGINEERING, INC.,
Plaintiff,**

v.

**APPLE, INC. et al,
Defendants.**

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Civ. Act. No. 2:10-cv-91

O R D E R

Before the Court is Plaintiff's Emergency Motion to Compel Defendants to Narrow Their Invalidity Contentions. Dkt. No. 375. Also before the Court are Defendants' Response and Plaintiff's Reply. Dkt. Nos. 379 and 386.

The Docket Control Order ("DCO") in the above-captioned case requires Defendants to narrow the number of asserted prior art references by February 24, 2012. Dkt. No. 237. The DCO also required the parties to complete the meet and confer process over narrowing of Defendants' asserted prior art references by February 3, 2012. *Id.* If the parties not able to come to an agreement, Plaintiff is then able to move for emergency relief after the conclusion of the meet and confer process. *Id.* The parties were not able to agree on a set limit on the number of prior art references and Plaintiff filed the instant motion.

Plaintiff moves to compel Defendants to narrow the number of prior art references they are asserting in their Invalidity Contentions. Dkt. No. 375 at 1. Plaintiff argues that it would be unfair to require it to reduce the number of asserted claims without requiring Defendants to reduce the number of asserted invalidity references by a commensurate amount.

Defendants respond that Plaintiff's proposal that Defendants should be limited to a particular number of references per claim is unduly prejudicial. Dkt. No. 379 at 2. Defendants also argue that it is unfair to limit them to a fixed number of references per claim when "Plaintiff is asserting extraordinarily length and unwieldy claims" and Plaintiff's reduction of the number of claims asserted did not reduce the scope of the case *Id.* Defendants submit that it has offered to reduce the approximately 342 invalidity references to 290, and then offered to reduce to roughly 260 references. *Id.* at 3. Defendants also submit that early summary adjudication of a priority date issue could make further narrowing possible. *Id.*

Plaintiff responds that Defendants' complaint that Plaintiff's narrowing of the case to 90 claims did not reduce the scope of the case is incorrect. Dkt. No. 386. Plaintiff submits that the reduction of number of asserted claims simplified its infringement case. *Id.* at 2. Plaintiff argues that Defendants have offered a trivial reduction in their asserted prior art references and that reduction "will have a meaningless impact on the case." *Id.* at 3. Plaintiff also argues that there is nothing unfair about requiring Defendants to limit their prior art references when Plaintiff has already limited the number of claims asserted. *Id.* at 3-4.

As set forth in the DCO, the parties had previously agreed that Defendants would narrow the number of asserted prior art references. Having considered the parties' briefing and arguments, the Court hereby **GRANTS** Plaintiff's Emergency Motion to Compel Defendants to Narrow Their Invalidity Contentions (Dkt. No. 375).

The Court **ORDERS** that by February 24, 2012, Defendants shall serve Invalidity Contentions that narrow the number of asserted prior art references in their Invalidity Contentions to no more than fifteen (15) individual references (*i.e.*, not groups of references)

asserted per claim or no more than eighteen (18) individual references per dependent claim where Plaintiff is also asserting a corresponding claim from which the dependent claim depends. Defendants may not multiple the number of claims by fifteen or eighteen and arrive at a gross number of possible references.

IT IS SO ORDERED

SIGNED this 14th day of February, 2012.

A handwritten signature in black ink, appearing to read "David Folsom", written over a horizontal line.

DAVID FOLSOM
UNITED STATES DISTRICT JUDGE