

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.

Case No. 02:10-cv-91-DF

Consolidated with Case No. 02:10-cv-185-DF

**DEFENDANTS' JOINT OPPOSITION TO PLAINTIFF'S EMERGENCY MOTION TO  
COMPEL DEFENDANTS TO NARROW THEIR INVALIDITY CONTENTIONS**

Defendants jointly submit this Opposition to Plaintiff's Emergency Motion to Compel Defendants to Narrow Their Invalidity Contentions ("Motion"). *See* Docket Entry No. ("DE") 375. For all the reasons outlined below, Plaintiff's Motion should be denied.

**I. SUMMARY OF THE ARGUMENT**

The parties appear to fundamentally agree that the current size of this case will not allow for efficient conduct of the case within the time remaining to trial, much less in time for the *Markman* hearing. The parties also appear to agree that a Court-ordered reduction of case scope is necessary, although differ as to what should be cut first and in what magnitude. Defendants respectfully submit that the root of the problem is neither the length of Defendants' invalidity contentions nor the number of prior art references asserted – it is the sheer number of repetitive claims that Plaintiff has chosen to assert in one action against 19 Defendants and over 40 disparate products. In view of Plaintiff's assertion of 90 patent claims in 15 patents, Defendants offer to reduce the number of prior art references from 342 to 290 references (about 3 references per claim) is entirely reasonable and is alone reason enough to deny Plaintiff's motion.

Further, less than 48 hours before this Opposition was filed, Plaintiff informed Defendants for the first time that it intends to serve new infringement contentions that would substantially expand the case to include microprocessor cores never previously identified as infringing. Requiring Defendants to reduce the prior art on which they rely immediately before Plaintiff seeks to expand its infringement allegations would be highly prejudicial.

Plaintiff's proposal that Defendants should be limited to a particular number of references per claim is also unduly prejudicial. A substantial number of the prior art references cited by the Defendants describe products that Defendants will establish were prior art because they were on sale to the public more than a year before the relevant priority date. Documents describing such a prior art product are important evidence of its structure and operation, and are properly considered together with the product itself as a single piece of prior art, not as multiple, independent references as Plaintiff characterizes them.

It is also unfair to limit Defendants to a fixed number of references per claim when Plaintiff is asserting extraordinarily lengthy and unwieldy claims. Plaintiff has asserted some claims that are nearly a thousand words in length (e.g. claim 21 of Patent No. 7,660,973), that depend from as many as 8 parent claims, and incorporate dozens of limitations. Plaintiff's reduction from 391 to 90 asserted claims did little to narrow the case because the remaining 90 claims include most, if not all, of the limitations in the original 391 claims.

Plaintiff attempts to distract from these issues by asserting arguments that are both procedurally improper and factually incorrect. First, Plaintiff argues that Defendants' invalidity contentions are insufficient under the Patent Rules, even though it concedes in its brief that this is a separate issue, to be resolved at a later date, after the parties have had an opportunity to meet and confer. Tellingly, Plaintiff has been in possession of Defendants' Invalidity Contentions for

over three months, and never once raised a concern about the sufficiency of the contentions until last week, immediately prior to filing its motion to reduce the number of asserted references.

Second, Plaintiff misrepresents Defendants' proposal. Contrary to what is stated in Plaintiff's Motion, Defendants voluntarily offered to reduce the total number of asserted prior art references from approximately 342 references to 290, and then, in the spirit of compromise, to reduce again to roughly 260 references or possibly even a lower number – in total, a (significant) elimination of roughly 80 prior art references. Not once during the meet and confer process was Plaintiff able to articulate why this proposal was unreasonable. Instead, Plaintiff refused Defendants' offer without explanation, and filed the present Motion seeking to limit Defendants to an arbitrary number of 15 prior art references per claim, regardless of the number of limitations present in any of the asserted claims (some of which go on for over a full column). *See* Appendix A. In contrast, Defendants fully explained the basis for their proposal and suggested additional procedural mechanisms, including early summary adjudication of a priority date issue, that would make further narrowing possible. All of Defendants' proposals were rejected without comment.

Indeed, under the guise of "fairness," Plaintiff has unreasonably argued throughout the pendency of this case that the reduction in claims versus reduction in prior art needs to be a tit-for-tat process, devoid of any context or meaning, as if the exercise of identifying relevant prior art is simply a numbers game. This oversimplification of the case has led to the current predicament, with both sides now at loggerheads as to how best to proceed.

Defendants respectfully submit that the most prudent solution is to deny Plaintiff's Motion and to grant Defendants' Motion, and order Plaintiff to reduce its asserted claims to a more appropriate number of representative claims – a number that takes into account the number

of disparate Defendants and products Plaintiff chose to accuse in a single action. Defendants are amenable to serving amended invalidity contentions within a reasonable time after Plaintiff reduces its claims, which will include an elimination of the approximately 80 references Defendants have already informed Plaintiff they are willing to drop, in addition to any further eliminations that can be made based on the eliminated claims.

## **II. FACTUAL BACKGROUND**

On March 23, 2011, the parties submitted an agreed Docket Control Order (“DCO”) which required Plaintiff to bring the number of asserted claims down to a total of 90 claims by January 6, 2012. *See* DE 224. At all times during the negotiations preceding the submission of the DCO, Defendants maintained that 90 claims was an unreasonable number and reserved the right to seek relief from the Court for a further reduction of claims at a later time. Brewer Decl. ¶3. In response, Plaintiff argued that Defendants should be required to reduce the number of prior art references to 90 references. *Id.* The parties were unable to reach agreement on the reduction of prior art, but agreed to meet and confer after Plaintiff reduced its Infringement Contentions to 90 claims, as reflected in the DCO. *See* DE 237.

On the same day that the DCO was submitted, Plaintiff served Defendants with Infringement Contentions asserting 391 claims from sixteen patents. *See* Motion, DE 375, at 2. Plaintiff’s Infringement Contentions included hundreds of pages of charts for over 40 different microprocessor chips and handsets. Brewer Decl. ¶4.

Defendants served their Invalidity Contentions on October 17, 2011. *Id.* at ¶6. Because no narrowing of claims had occurred at that time, Defendants were required to serve invalidity charts for all 391 claims asserted by Plaintiff. Defendants charted a comparatively low 342 invalidating prior art references against Plaintiff’s 391 asserted claims.

On January 6, 2012, as required under the DCO, Plaintiff narrowed the number of asserted claims to 90 claims. *See* DE 374. The parties thereafter began the meet and confer process to determine whether they could reach agreement on the number of references to be reduced from Defendants' invalidity contentions. At the start of this process, Defendants notified Plaintiff that they were willing to eliminate all prior art relied upon in Defendants' invalidity contentions solely as anticipating or rendering obvious (including in combination with other references) the claims that MicroUnity had dropped from its Infringement Contentions. Brewer Decl. ¶8, Ex. B. Defendants' opening offer amounted to a reduction from roughly 342 asserted prior art references to approximately 290 references – a reduction of over 50 asserted prior art references. Defendants also stated that a further narrowing would be possible if Plaintiff would reduce its asserted claims in a more meaningful way and requested to meet and confer on this issue. *Id.* Specifically, Defendants pointed out that Plaintiff's purported "reduction" from 391 to 90 claims had not meaningfully reduced the scope of the case because the remaining claims included most, if not all, of the limitations in the original 391 claims.<sup>1</sup> *Id.*

On January 29, 2012, Plaintiff rejected Defendants' proposal, and raised for the first time concerns about the sufficiency of Defendants' Invalidity Contentions. *Id.* The parties thereafter participated in two teleconferences on January 31, 2012, and February 3, 2012, to discuss whether they could reach agreement on a set number of prior art references to be eliminated from the case and whether a further reduction of the scope of the case was possible. Brewer Decl. at ¶¶9–10. At the January 31, 2012 conference, Defendants proposed that Plaintiff either reduce its asserted claims to a smaller, representative number of claims or agree to an early summary judgment proceeding on the priority date claimed by Defendants' patents. *Id.* at ¶9.

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<sup>1</sup> For example, as seen in the attached appendix, the claims of the U.S. Patent No. 7,260,708 (the "708 patent") (which was dropped) are virtually identical to the claims of U.S. Patent No. 7,353,367 (the "367 patent") (which was not dropped). *See* Appendix B.

Specifically, Defendants explained that the priority date issue could drastically reduce the scope of the case in a meaningful way, because it would either conclusively establish invalidity of certain patents if Defendants prevailed or reduce a large body of prior art from the case, in the event that Plaintiff prevailed. *Id.* Plaintiff rejected both proposals without explanation. *Id.*

On the February 3, 2012, teleconference, in the spirit of compromise, Defendants offered to further reduce the number of asserted prior art references by 10% (on top of the approximately 50 references that Defendants were already willing to drop). *Id.* at ¶10. Plaintiff once again rejected Defendants' proposal without explaining why it was unreasonable. Defendants also expressed a willingness to reduce any prior art references dealing with commonplace computer architecture concepts if Plaintiff agreed to stipulate that novelty could not be premised on those concepts. *Id.* Plaintiff summarily rejected this proposal as well. *Id.* at ¶11.

Under the DCO, Defendants are required to disclose their narrowed number of prior art references on February 24, 2012. *See* DE 237. The DCO does not require Defendants to reduce by a specific number of asserted prior art references (either in total or by asserted claim). *Id.* Defendants intend to comply with this deadline by dropping approximately 80 references from the case, as they committed to do during the meet and confer process. Defendants are willing to further reduce the number of prior art references, so long as MicroUnity is also required to reduce to 10 claims, or some number of representative claims that the Court deems appropriate.

### **III. ARGUMENT**

#### **A. Plaintiff Has Not Been Prejudiced By Defendants' Invalidity Contentions**

The great majority of Plaintiff's Motion is directed not towards the issue controlled by the DCO – the narrowing of asserted prior art references – but towards the distinct and separate issue of whether Defendants' Invalidity Contentions comply with the Patent Rules. In fact,

Plaintiff's initial argument section, entitled "The Defendants' Current Invalidity Charts Are Excessive and Unhelpful" (Motion, DE 375, at 5), is nothing more than an unfounded attack on the volume of Defendants' Invalidity Contentions.

As a preliminary matter, Plaintiff tacitly concedes that the sufficiency of Defendants' Invalidity Contentions is not ripe for judicial resolution, due to Plaintiff's late notice of its purported concerns and failure to satisfy the meet and confer requirements. Motion, DE 375, at 4-5. Moreover, contrary to Plaintiff's contention, Defendants have not "refused" to discuss Plaintiff's concerns, but have instead requested a proper opportunity to consider and respond to Plaintiff's belated objections. Significantly, Plaintiff has been in possession of Defendants' Invalidity Contentions since mid-October 2011, and did not once identify a concern regarding their sufficiency until January 29, 2012, one week before filing this motion, and over three weeks after it disclosed its list of 90 asserted claims. Given how late in the process Plaintiff has waited to raise its purported concerns, Plaintiff's cry of prejudice is not credible, and the Court may properly refuse to entertain its untimely objections. *See, e.g., Fresenius Med. Care Holdings, Inc. v. Baxter Int'l, Inc.*, No. C03-01431 SBA, 2006 WL 1329997, at \*7 (N.D. Cal. May 15, 2006) (denying motion to strike anticipation defense in light of the patentee's delayed filing); *Funai Elec. Co., Ltd. v. Daewoo Electronics Corp.*, No. C 04-01830 CRB, 2006 WL 3456607 (N.D. Cal. Nov. 29, 2006) (denying motion to strike invalidity contentions and noting that plaintiff waited several months to move after being served with the contentions).

Plaintiff's criticisms of Defendants' contentions are also without merit. Plaintiff first contends that Defendants' disclosures are insufficient because of their length. *See* Mot. at 5. In fact, the thousands of pages that MicroUnity complains of are specific passages from the asserted prior art references charted against the limitations of the asserted patents. *See, e.g., Wilson Dec.*

at Ex. 3 ('840 Invalidity Chart) at 11-182. Thus, the overall length of Defendants' contentions is Plaintiff's own doing; as it was necessitated by the staggering number of limitations Plaintiff has put at issue in this case, as well as the very level of specificity that Plaintiff demands. Importantly, Plaintiff could have elected to narrow the case prior to the deadline for the service of Defendants' invalidity contentions, but chose not to do so.

Plaintiff also complains of the exemplary nature of the citations provided by Defendants. Mot at 5. MicroUnity cites no support for the proposition that the use of exemplary citations is improper, and if Defendants were to exhaustively cite all of the evidence that may potentially be used from each reference, Defendants' contentions and charts would be much longer than they are presently. Plaintiff's argument that Defendants "offer no meaningful disclosure of obviousness combinations or motivation to combine any such combination" is also incorrect. *See* Mot. at 5. In fact, both the invalidity charts and the contentions identify groups of combinations and motivations to combine references. *See, e.g.,* Wilson Dec. at Ex. 3 ('840 Invalidity Chart) at 69, 183-88; *see also* Brewer Decl., Ex. A (Cover pleading of Defendants' Joint Invalidity Contentions).

The Court should also reject Plaintiff's unsupported assertion that Defendants' grouping of references directed to similar products is somehow improper. *See* Mot. at 5-6. These references all discuss the same technology, and should be considered together. By way of example, the Hewlett-Packard references (identified in Plaintiff's motion as an example of improper grouping) all relate to the same product line (the PA-RISC processor family) and discuss different facets of the HP PA-RISC processors. *See* Mot. at 6-7. The complaint that the grouping approach used by Defendants "raise[s] an undefined number of potential obviousness combinations, numbering at least in the thousands" is also unfounded, as courts have found this



to be a valid approach to invalidity contentions where there is a large body of references that disclose the same limitations. *See, e.g., Keithley v. The Homestore.com, Inc.*, 553 F. Supp. 2d 1148, 1150 (N.D. Cal. 2008); *Avago Techs. Gen. IP PTE Ltd. v. Elan Microelectronics Corp.*, No. C04-05385 JW (HRL), 2007 WL 951818, at \*4 (N.D. Cal. Mar. 28, 2007).

### **B. Plaintiff Misrepresents the Scope of Defendants' Proposed Reduction**

Not only has Plaintiff misrepresented the sufficiency of Defendants' invalidity contentions, it has also misstated Defendants' proposed reduction of references. Defendants have not merely offered to reduce the prior art by ten percent, as Plaintiff contends. Instead, at the outset of the meet and confer process, Defendants offered to reduce the prior art relied upon in Defendants' invalidity contentions to solely the prior art "anticipating or rendering obvious (including in combination with other references) the claims on MicroUnity's narrowed [90-claim] list." Motion, DE 375, Wilson Decl., Ex. 1, at 3. Defendants' opening offer would amount to a reduction of asserted prior art references from roughly 342 to 290 – a reduction of over 50 asserted prior art references. On top of this, Defendants *also* offered to reduce the remaining prior art references by ten percent.

In its Motion, Plaintiff attempts to downplay (if not negate) Defendants' proposal by arguing that Defendants' were required to drop certain references automatically once Plaintiff disclosed its list of narrowed claims. Plaintiff's argument is legally and procedurally incorrect. Because Defendants have asserted counterclaims of invalidity, Defendants *have a legal and procedural right* to continue to allege that the originally-asserted claims of the patents-in-suit are invalid.<sup>2</sup> This is especially true in a case such as this, where Plaintiff's infringement allegations are based on the structure and function of a discrete component of Defendants' accused products

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<sup>2</sup> Actually, Defendants have the right to assert that any of the claims from the patents-in-suit are invalid, as long as Defendants provided the basis for invalidity as required by the Court's Local Patent Rule 3-3.

– a component that is supplied to some of the Defendants by a third party. Those Defendants therefore have a keen interest in invalidating all of the originally-asserted claims of Plaintiff so that Plaintiff cannot later assert those same claims against their third-party component suppliers, thereby further interrupting and threatening Defendants’ businesses. In light of this, Defendants opening offer to remove all the prior art references that were asserted against Plaintiff’s withdrawn claims was a legitimate narrowing of Defendants’ asserted prior art references and was appropriately commensurate with the scope of Plaintiff’s own reduction.

**C. The Reduction in the Number of Asserted Claims Did Not Reduce the Scope of the Case**

Moreover, although Plaintiff makes much of the fact that it cut the number of asserted claims by “70%,” it fails to inform the Court that it has by no means narrowed the scope of this case by any such degree.

First, the reduction in the number of asserted claims did nothing to reduce the scope of the accused products because the 90 claims that remain in the case include most, if not all, of the limitations found in the 391 claims originally asserted. Because the same limitations appear in the current set of asserted claims, the number of accused products has not been reduced. In fact, after filing its “emergency” motion and the day before this Opposition was due, Plaintiff informed Defendants that it intended to seek leave to serve *new* infringement contentions, adding new microprocessor cores never previously accused of infringement to the case and therefore not the subject of any Patent Rule 3-4 production. Although Defendants are still assessing these new, lengthy allegations, it appears that entirely new infringement and validity issues have been raised. If Plaintiff is permitted to amend its infringement contentions to include these new allegations, Defendants will be required to seek leave to amend their invalidity contentions. Plaintiffs should not be permitted to seek a Court-ordered reduction of the case that prejudices

Defendants while simultaneously seeking to enlarge the case for its own benefit. This latest development in the case further underscores why judicial resolution of this issue is necessary.

Second, because of the substantial redundancy that existed in the original set of 391 asserted claims, reducing to 90 claims did virtually nothing to substantively alter the scope of the relevant prior art. For example, Plaintiff no longer asserts claims from the '708 patent, but continues to assert 12 claims from the '367 patent that cover subject matter similar to the '708 patent claims. *See* List of Asserted Patent Claims, DE 374, at 2. Indeed, as shown in the attached chart, the claims of these two patents are nearly identical. *See* Appendix A (comparing claims). Similarly, while Plaintiff dropped claims from the '500 patent (dynamically allocated cache/buffer), it continues to assert claim 43 from the '061 patent, which covers the same subject matter. *See id.* Plaintiff election to drop and retain claims from the '287 patent that are virtually identical similarly failed to reduce the scope of the case in any way. Defendant provided all of these examples to Plaintiff in the meet and confer process, and Plaintiff provided no meaningful response.

**D. Plaintiff's Arbitrary "Per Claim" Reduction is Inequitable and Unsupported**

Plaintiff's request that the Court compel Defendants to narrow the number of prior art references to no more than 15 references total per claim (for both anticipation and obviousness) is also entirely prejudicial and unsupported by any relevant authority. None of the cases cited by Plaintiff require a narrowing of this type. In fact, in each case Plaintiff cites, the court required the defendants to reduce to a certain number of *charts* or obviousness *combinations*, not a particular number of prior art references per claim.

While Plaintiff attempts to frame this rigid proposal as an impartial and fair reduction of prior art, in reality, the opposite is true. The limitation Plaintiff suggests would be particularly

damaging to Defendants, as Plaintiff has asserted claims with a massive number of limitations. Claim 21 of U.S. Patent No. 7,660,973 – a string of 1 independent and 8 dependent claims spanning 137 lines of the patent – is just one example of this type of claim. *See* Appendix B. Plaintiff's suggested reduction would implicate those claims that contain more limitations than others or require more invalidating references for the purposes of showing obviousness. For those claims that are not anticipated or rendered obvious by as many references (*e.g.* claim 14 of the '061 patent, which is anticipated by only 13 references) there would be no reduction in the scope of Defendants' invalidity contentions or this case. As such, Plaintiff's inflexible proposal is unfair to Defendants and does not uniformly narrow the scope of this case.

Notably, the only constraint on Plaintiff is a limitation on the total number of asserted claims. Plaintiff was not required to limit its contentions to a certain number of asserted claims per patent, or a certain number of claim dependencies, or limitations per claim. It is inequitable that Plaintiff should be able to freely pick and choose, without restriction, a large number of extremely lengthy deep dependent claims, yet Defendants should be limited to asserting an arbitrary number of prior art references per claim. Defendants should be allowed to narrow this case in the same manner that Plaintiff did – by the *total number* of asserted prior art references – which is exactly what the DCO contemplates.

Plaintiff's requested reduction is further flawed in that a substantial number of the references identified in Defendants' invalidity contentions describe specific computer systems that Defendants intend to demonstrate were publicly used, known, and on sale in this country prior to the dates of the alleged invention of the asserted patents. Thus, in addition to constituting potentially invalidating publications in their own right, these references provide evidence of such public sale and use pursuant to 35 U.S.C. § 102(a) and (b). Defendants are

entitled to establish prior use, knowledge, and sale of these systems and to use many of these documents as evidence in addition to (or in lieu of) merely asserting them as invalidating publications. To that end, Defendants have the right to conduct discovery of third parties concerning these documents and the systems they describe. It would be patently unfair for Defendants to be deprived of the opportunity to use these documents prior to taking such depositions or conducting such discovery.

Further, Defendants have no control over the number of documents that describe the structure and operation of the prior art that is represented by a product sold in the marketplace. For example, multiple documents are necessary to establish structure and operation of the Hewlett-Packard HP7100 processor that Defendants have identified as relevant prior art. Defendants believe that the HP7100 should be treated as a single prior art reference – a product that was offered for sale under 35 U.S.C. § 102(b) – whereas Plaintiff’s proposal would unfairly count each document used to describe it. And while Plaintiff’s unreasonable proposal on this point is sufficient grounds to deny the motion outright, Defendants wish to emphasize that, even if the Court is inclined to impose a per-claim limitation on the number of prior art references as Plaintiff seeks, it should still reject Plaintiff’s request that each individual document describing a given prior art system be treated as an individual reference that would count against the total. In that instance, the Court should instead rule that any particular prior art system (e.g., the Hewlett-Packard HP7100) constitutes a single “reference” for purposes of the limit, even if multiple individual manuals or other documents may be required to show its features or operation.

Significantly, it is important to note that the number of references Defendants have asserted in this case is no greater the number of prior art references Plaintiff *itself* identified as relevant during the prosecution of its patents. In fact, the asserted patents identify hundreds of

prior art references on their face. *See, e.g.*, ‘973 patent at pp. 1–13 (listing over 12 pages of references cited during prosecution). Plaintiff’s own demonstration of the expansive scope of the relevant prior art is a strong indication that it would be unduly prejudicial to (i) arbitrarily limit the Defendants to a specific number of references per claim, or (ii) limit the number of prior art references beyond the roughly 260 proposed by Defendants without a large reduction in the scope of the claims asserted.

**E. Defendants Have Already Significantly Reduced the Scope of This Case – Further Reduction Must Begin With Plaintiff**

As noted above, Defendants voluntarily agreed to reduce the number of asserted prior art references from 342 references to 290 – a reduction of over 50 asserted prior art references. When Plaintiff responded that was not enough, Defendants offered an additional 10% reduction (amounting to approximately 30 more prior art references), bringing the remaining total to roughly 260 prior art references applied against 90 asserted claims. As opposed to the 15 to 18 prior art per references per claim that Plaintiff has proposed (which, when taken to the extreme example could result in between 1350 and 1620 separate prior art references based on Plaintiff’s 90 asserted claims), Defendants have already effectively reduced this case to *less than three prior art references per asserted claim*. Accordingly, Defendants have already significantly reduced the scope of this case.

Defendants are not unwilling to further reduce the scope of this case. However, such a reduction must start with a further reduction by Plaintiff of the number of asserted claims to 10 claims, or some other manageable number that the Court deems appropriate. As set forth in Defendants’ Motion to Limit the Number of Asserted Claims, MicroUnity cannot possibly meet its burden at trial if it continues to assert 90 claims, as this would require it to show thousands of instances of infringement among the 19 Defendants and dozens of accused products. Indeed,

counsel for MicroUnity did not deny in the meet and confer on the present Motion that it would eventually have to limit its claims at some point prior to trial.

The standard practice adopted by this Court requires plaintiffs to reduce the number of asserted claims down to 10 claims during the claim construction process. *See, e.g., Stambler v. Amazon.com, Inc.*, No. 2:09-cv-00310-DF (E.D. Tex. Jan. 6, 2010) (docket control order); *see also Online News Link LLC. V. Apple, Inc.*, No. 2:09-cv-312-DF (E.D. Tex. Mar. 12, 2010) (same); *Advanced Geo-Location Tech, LLC v. Virgin Mobile USA, L.P.*, No. 2:09-cv-00091-DF (E.D. Tex. Oct. 21, 2009) (same); *Advanced Tech. Incubator, Inc. v. Sharp Corp.*, No. 2:07-cv-468-DF (E.D. Tex. May 19, 2008) (same). There is no compelling reason for the Court to deviate from its standard practice.

As the claim construction process has effectively begun, the Court should act now to narrow the scope of this case to a manageable level by limiting the number of asserted claims against Defendants to 10, as it regularly requires. Once that is done, and once the breadth of Plaintiff's case is clear, Defendants are amenable to limiting the number of asserted prior art references further. However, if Defendants are forced to further narrow their asserted prior art references now, without knowing what subset of the currently-asserted 90 claims Plaintiff intends to ultimately construe and take to trial, Defendants ability to present their best invalidity case will be prejudiced.

#### **IV. CONCLUSION**

For all the foregoing reasons, Defendants respectfully request that Plaintiff's Emergency Motion to Compel Defendants to Narrow Their Invalidity Contentions be denied.

Date: February 10, 2012

Respectfully submitted,

/s/ Tyler T. VanHoutan

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**CERTIFICATE OF SERVICE**

I hereby certify that all counsel of record who are deemed to have consented to electronic service are being served this 10<sup>th</sup> day of February, 2012 with a copy to the foregoing document via the Court's CM/ECF system in compliance with Local Rule CV-5(a)(3)

/s/ Tyler T. VanHoutan