

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

MICROUNITY SYSTEMS ENGINEERING,
INC.,

Plaintiff,

V.

APPLE, INC.; AT&T INC.; AT&T MOBILITY §
 LLC; CELLCO PARTNERSHIP; EXEDEA, INC.; §
 GOOGLE INC.; HTC CORPORATION; HTC §
 AMERICA, INC.; LG ELECTRONICS, INC.; §
 LG ELECTRONICS MOBILECOMM U.S.A., §
 INC.; MOTOROLA MOBILITY, INC.; NOKIA §
 CORPORATION; NOKIA INC.; PALM, INC.; §
 QUALCOMM INC.; SAMSUNG ELECTRONICS §
 CO., LTD.; SAMSUNG SEMICONDUCTOR §
 INC.; SAMSUNG TELECOMMUNICATIONS §
 AMERICA, LLC; SPRINT SPECTRUM LP; §
 and TEXAS INSTRUMENTS INC., §

Defendants.

[illegible]

Case No. 02:10-cv-91-DF
Consolidated with Case No. 02:10-
cv-185-DF

JURY TRIAL DEMANDED

**PLAINTIFF'S REPLY IN SUPPORT OF ITS EMERGENCY MOTION TO COMPEL
DEFENDANTS TO NARROW THEIR INVALIDITY CONTENTIONS**

For the sake of brevity, MicroUnity will focus on five points in reply, but otherwise rests on its opening briefing.

First, Defendants complain bitterly about the process undertaken here by MicroUnity, but their complaints lack credibility — given that the Defendants themselves agreed to that process. With full knowledge of MicroUnity's 391 asserted claims, Defendants agreed (and Judge Ward ordered) that MicroUnity limit itself to 90 claims in January 2012.¹ Accordingly, Defendants' complaints that the 90 claims picked by MicroUnity did not narrow the case because they overlap with the dropped 300 claims amount to crocodile tears. If there was substantial overlap between all of MicroUnity's 391 originally-asserted claims (a proposition with which MicroUnity does not agree, see below), then Defendants knew about it when they agreed to the reduction to 90 claims. Certainly Defendants have not now identified any alternate set of 90 claims they were hoping MicroUnity could have selected but did not, and which would have, in their view, more substantially narrowed the case.

Second, in any event, Defendants' premise is false that MicroUnity's narrowing of the case from 391 to 90 claims did not reduce the scope of the case. Defendants' main attempt to prove this assertion consists simply of repeating it often enough to make it sound true. But the only actual analysis of the claims that Defendants perform is to cite just two pairs of dropped/retained claims out of the 300 dropped claims. Opp., at 11. Had Defendants actually

¹ Defendants in their Opposition imply that they only learned of MicroUnity's 391 claims the same day they submitted the agreed DCO to the Court. "On the same day that the DCO was submitted, Plaintiff served Defendants with Infringement Contentions asserting 391 claims from sixteen patents." Opp., at 4. Defendants do not mention, however, that in an effort to be transparent, MicroUnity voluntarily disclosed via email to the Defendants its 391 asserted claims more than a month before the agreed DCO was submitted and before its infringement contentions were due. Ex. A (2/14/11 email).

analyzed MicroUnity's claim selections, they would have been forced to concede that MicroUnity's claim reduction had eliminated a whole host of concepts from the case.

For example, MicroUnity dropped all claims from U.S. Patent No. 5,737,547, which relates to non-blocking load buffers. No claims covering even similar subject matter continue to be asserted in this case. Additionally, MicroUnity completely dropped the RE39,500 Patent, which originally contained 62 asserted claims relating to detailed aspects of combination cache/buffers. Although MicroUnity retains two dependent claims from other patents that recite a combined cache/buffer, those two dependent claims do not reflect most of the subject matter of the 62 dropped claims, such as the use of indices and the use of addresses in accessing the combined cache/buffer.

MicroUnity's narrowing also tremendously simplified its infringement case. For example, MicroUnity originally asserted 83 method claims, which require a showing that the method is actually carried out by an accused direct infringer. Such a showing requires extensive software (and potentially hardware) discovery and analysis to understand the architecture of the software to prove that certain instructions are executed. MicroUnity dropped 71 of its asserted method claims in its narrowing. Even if the same subject matter that was asserted in a method claim were to appear in a computer-readable storage medium or apparatus claim, the discovery required as well as the proof at trial would be far less burdensome on all parties than with the asserted method claim.

Moreover, even if certain limitations of a dropped claim are included elsewhere in MicroUnity's retained claims, each dropped claim still represents a distinct invention — the elimination of which indisputably simplifies the case. After all, for both infringement and validity, each claim must be treated as a whole, not simply based on individual limitations that

are a part of the combination claim. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 344-45 (1961) (“For if anything is settled in the patent law, it is that the combination patent covers only the totality of the elements in the claim and that no element, separately viewed, is within the grant.”).

Third, contrary to Defendants’ suggestions, Defendants have offered a trivial reduction in their asserted prior art references. Defendants make much of the fact that they offered to drop the 50 references they had asserted solely against MicroUnity’s 300 dropped claims. But, of course, this is not a real reduction in art because the claims against which that art was asserted are out of the case anyway. Defendants attempt to suggest this maneuver was substantive because “Defendants have asserted counterclaims of invalidity, [so] Defendants have a legal and procedural right to continue to allege that the originally-asserted claims of the patents-in-suit are invalid.” *Opp.*, at 9. Defendants make this argument in their brief without the benefit of any case citations, and for good reason—just last month, the Federal Circuit rejected it. *Streck, Inc. v. Research & Diagnostic Sys., Inc.*, 665 F.3d 1269, 1284 (Fed. Cir. 2012) (holding that the district court correctly refused to try validity of previously asserted claims that were no longer asserted at the time of trial because “there is no evidence that R & D met its burden of showing a continuing case or controversy with respect to the unasserted claims”). Accordingly, all that Defendants have offered to do is reduce their actual art from about 290 references to 260. That tiny, 10% reduction will have a meaningless impact on the case.

Fourth, there is nothing unfair about requiring Defendants to further limit their art. Defendants, for example, offer no defense of their assertion of 62 separate references against each of the two claims of MicroUnity’s lead patent, the ’840, not including the hundreds of references incorporated by reference and literally thousands of obviousness combinations.

Defendants complain at length about how it is hard for them to prepare for trial even with 90 claims, how the number of the asserted claims makes *Markman* difficult for them, *etc.* But all of these same arguments apply in spades to their own assertions of art. How can MicroUnity reasonably prepare for trial facing potentially hundreds of references against just the two claims of its lead patent, the vast majority of which have not been explained in any meaningful way as required by PR 3-4?²

Fifth and finally, as will be more fully set forth in MicroUnity's forthcoming opposition to Defendants' motion to limit claims, it is now Defendants' "turn" to substantively narrow their case. The Defendants agreed to a reduction by MicroUnity to 90 claims in January 2012, and they further agreed to narrow their art in February 2012. Requiring MicroUnity first to gut its case further before Defendants make any real narrowing would be unfair and would relieve Defendants of their own agreement. Defendants wish to have it both ways—they wish to cabin MicroUnity into very narrow infringement contentions that they can quickly and easily analyze for *Markman* and discovery purposes, but they wish to obfuscate through sheer volume and incomplete disclosure their real prior art intentions for as long as possible. Witness, for example,

² Defendants spend considerable space arguing over whether their invalidity contentions comply with PR 3-4. But as MicroUnity said in its opening brief, the real issue in this motion is the DCO's requirement that Defendants narrow asserted references; MicroUnity pointed out the deficiencies in Defendants' contentions to demonstrate how big a job it will be to bring those contentions into compliance unless Defendants' art is substantially reduced. MicroUnity reserves the right to address Defendants' failure to comply with PR 3-4 in a separate motion.

Defendants also complain on page 10 of their Opposition: "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." Defendants thus resist narrowing their asserted art because these proposed infringement contentions allegedly add "entirely new validity" issues. Yet Defendants never identify such issues, nor do they explain how the identification of additional infringing elements of currently-accused products – but not additional asserted claims or additional accused products – could logically require the Defendants to assert additional art.

that even after asking this Court to reduce MicroUnity to just 10 claims at this early stage of the case, Defendants make no definitive promises about the amount of art they would cut in response. Opp., at 15. Based on past behavior, one can expect Defendants to cut another 10% of their references, leaving MicroUnity with still hundreds of references and ill-defined thousands of obviousness combinations to deal with for just 10 claims.

On this point, Defendants make much of a supposed admission by MicroUnity during the meet-and-confer process on this motion: “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.” Opp., at 14-15. But this is not some grand admission that MicroUnity made while litigating this motion — MicroUnity said the exact same thing in the DCO. DKT #237, at 5 n.6 (“It is Plaintiff’s position that ninety (90) asserted claims is an appropriate number as of January 2012. Plaintiff is willing to meet and confer after the Markman order for a further narrowing of claims.”). That MicroUnity will eventually narrow its claims further, however, does nothing to relieve Defendants of their duty to perform their own narrowing now. As is plain, Defendants simply wish for MicroUnity to make substantive concessions on the scope of its infringement case unilaterally, while retaining flexibility as to their invalidity case for as long as possible. This is unfair, and this Court should hold Defendants to their obligation to make a significant reduction in their art now.

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Respectfully Submitted,

/s/ Stephen D. Susman (by permission Joseph S. Grinstein)

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was filed on this 13th day of February, 2012 using the Court's CM/ECF system. Under LR CV-5(a)(3), such electronic filing constitutes service of the document on all counsel who are deemed to have consented to electronic service. Any other counsel will be served by electronic mail pursuant to LR CV-5(d).

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