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NINTENDO OF AMERICA INC.

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PATRIOT SCIENTIFIC CORPORATION

**UNITED STATES DISTRICT COURT**  
**NORTHERN DISTRICT OF CALIFORNIA**

TECHNOLOGY PROPERTIES LIMITED )  
LLC, PHOENIX DIGITAL SOLUTIONS )  
LLC, and PATRIOT SCIENTIFIC )  
CORPORATION, )  
 )  
Plaintiffs, )  
 )  
v. )  
 )  
NINTENDO CO., LTD. and NINTENDO )  
OF AMERICA INC., )  
 )  
Defendants. )

Case No. 12-cv-03881-JSW  
**JOINT CASE MANAGEMENT  
STATEMENT**

1 The parties to the above-entitled action jointly submit this JOINT CASE  
2 MANAGEMENT STATEMENT pursuant to the Court's August 19, 2014 Order Lifting Stay  
3 and Setting Case Management Conference, the Court's Standing Order for Patent Cases, the  
4 Court's Civil Standing Orders, the November 27, 2012 Standing Order for All Judges of the  
5 Northern District of California, Patent Local Rule 2-1(a), Civil Local Rule 16-9, and Federal  
6 Rule of Civil Procedures 26(f).

7 1. Jurisdiction & Service

8 The Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a)  
9 because the action arises under federal statutes relating to patents.

10 No issue exists regarding personal jurisdiction or venue. No more parties remain to be  
11 served.

12 2. Facts

13 Plaintiffs (collectively "PDS") filed their Complaint against Defendants Nintendo Co.,  
14 Ltd. and Nintendo of America Inc. (collectively "Nintendo") for damages and injunctive relief  
15 based on alleged infringement of three of PDS' patents: United States Patent No. 5,440,749 (the  
16 "'749 Patent"), United States Patent No. 5,530,890 (the "'890 Patent") and United States Patent  
17 No. 5,809,336 (the "'336 Patent") (collectively, the "Asserted Patents").

18 PDS previously litigated the '336 Patent against Nintendo before the International Trade  
19 Commission ("the ITC case"). The administrative law judge issued a final Initial Determination  
20 on September 6, 2013, finding no violation of Section 337 as to Nintendo. PDS did not seek  
21 review of the finding of no violation for Nintendo and the Commission found no violation of  
22 Section 337, but found that TPL had satisfied the economic prong of the domestic industry  
23 requirement. For that reason, the Commission also terminated the investigation, which PDS did  
24 not appeal.

25 In October 2013, in Case No. 08-cv-00882-PSG (another suit in this District), a jury  
26 found infringement of the '336 Patent by a company named HTC. HTC has appealed the jury's

1 verdict to the Court of Appeals for the Federal Circuit, and that appeal is pending.

2 PDS is also currently litigating the Asserted Patents in seven other actions in this district:

3 Defendant(s)	Case Number
4 Barnes & Noble, Inc.	4:12-cv-03863-VC (N.D. Cal.)
5 6 Garmin Ltd., Garmin International, Inc., & 7 Garmin USA, Inc.	5:12-cv-03870-EJD (N.D. Cal.)
8 Huawei Technologies Co., Ltd. & Huawei 9 North America	4:12-cv-03865-PJH (N.D. Cal.)
10 11 LG Electronics, Inc. & LG Electronics USA, 12 Inc.	5:12-cv-03880-SI (N.D. Cal.)
13 Novatel Wireless, Inc.	3:12-cv-03879-PJH (N.D. Cal.)
14 15 Samsung Electronics Co., Ltd. & Samsung 16 Electronics America, Inc.	3:12-cv-03877-LHK (N.D. Cal.)
17 18 ZTE Corporation & ZTE (USA) Inc.	5:12-cv-03876-BLF (N.D. Cal.)
19 20	

21 A. Plaintiffs' Statement

22 As set forth in the Complaint, PDS contends that Nintendo has infringed and continues to  
23 infringe claims of the Asserted Patents. PDS asserts that Nintendo's infringing activities include  
24 the importing, making, using, offering to sell, and/or selling products and devices that embody  
25 and/or practice the patented inventions. In addition, PDS contends that Nintendo induces and  
26 instructs users of its accused products to connect to second devices and communicate with and

1 receive data from them in a manner that infringes the '336 Patent. Further, PDS informed  
2 Nintendo of its allegedly infringing acts prior to filing the Complaint and therefore believe that  
3 Nintendo's infringement has been, and continues to be, willful.

4 B. Defendants' Statement

5 Nintendo has not answered PDS' complaint. Nintendo's response to the complaint is due  
6 on or before November 17, 2014. (Dkt. 17, 19, 27.)<sup>1</sup> To the extent Nintendo answers the  
7 complaint, rather than file a motion under Fed. R. Civ. P. 12, Nintendo currently intends to deny  
8 infringement of any valid claim of the Asserted Patents and assert that the claims of the Asserted  
9 Patents are invalid. Nintendo also currently intends to deny any allegations of willful  
10 infringement and believes that, at a minimum, any allegations of willful infringement with  
11 respect to the '336 patent should be dropped immediately in light of the finding of no violation in  
12 the ITC case.

13 3. Legal Issues

14 The principal disputed legal issues are:

- 15 a. Ownership and standing with respect to the Asserted Patents;  
16 b. The proper claim construction for the Asserted Patents;  
17 c. Whether Nintendo infringed and continues to infringe – literally, contributorily, or  
18 by inducement – one or more of the Asserted Patents;  
19 d. Whether the claims of the Asserted Patents are valid;  
20 e. Whether PDS is entitled to compensation for any proven patent infringement,  
21 pursuant to 35 U.S.C. § 284, and if so, the amount;  
22 f. Whether the case is “exceptional” within the meaning of 35 U.S.C. § 285,  
23 entitling the prevailing party to reasonable attorneys' fees.

24  
25 <sup>1</sup> PDS has agreed that by participating in this Joint Case Management Conference statement prior to responding to  
26 the complaint, Nintendo is not waiving any defenses it may have or motions that it may bring in response to the  
complaint.

1 4. Motions

2 There is no pending motion.

3 5. Amendment of Pleadings

4 No amendment of pleadings is expected.

5 6. Evidence Preservation

6 Each party has reviewed the Guidelines Relating to the Discovery of Electronically  
7 Stored Information. Each party represents that it has instituted reasonable document retention  
8 procedures to maintain any relevant documents, electronic or otherwise, until this dispute is  
9 resolved. The parties have met and conferred pursuant to Fed. R. Civ. P. 26(f).

10 7. Disclosures

11 The parties will exchange initial disclosures on October 3, 2014.

12 8. Discovery

13 No discovery has been served thus far. The parties conducted their Rule 26(f)  
14 Conference of Parties on September 5, 2014. Pursuant to Fed. R. Civ. P. 26(f), the parties submit  
15 the following discovery plan:

16 (A) *Changes to disclosures.* The parties do not expect that any changes will be made  
17 in the form, or requirement for disclosures under Rule 26(a). The parties will exchange initial  
18 disclosures on October 3, 2014.

19 (B) *Subjects on which discovery may be needed.* The parties expect to conduct  
20 discovery concerning the claims and defenses raised by PDS in its Complaint and Answer to  
21 Counterclaims and by Nintendo in its Answer and Counterclaims. The parties' proposed  
22 schedule is set forth below in section 16. In light of the discovery already conducted in the ITC  
23 case, some discovery may not need to be duplicated.

24 (C) *Issues relating to disclosure or discovery of electronically stored information.*  
25 The parties anticipate that certain discovery may be produced in electronic form and have agreed  
26 to meet and confer, as necessary, to resolve any issues concerning electronic discovery as they

1 arise.

2 (D) *Issues relating to claims of privilege or of protection as trial-preparation*  
3 *material*. Privileged communications about this action and the ITC case, made after the action  
4 was initiated or ITC case was filed (whichever is earlier), need not be recorded in the parties'  
5 respective privilege logs. The parties will meet and confer as necessary to discuss other issues  
6 when they arise.

7 (E) *Changes in limitations on discovery*. The parties do not currently request any  
8 changes to the limitations on discovery as provided by the Federal Rules of Civil Procedure.

9 (F) *Orders that should be entered by the court*. The parties are in the process of  
10 agreeing upon a protective order, the terms of which—when finalized, and with the approval of  
11 this Court—shall govern and be entered in this case.

12 9. Class Actions

13 This is not a class action.

14 10. Relief

15 As prayed for in PDS' Complaint, PDS seeks an award of damages in an amount  
16 adequate to compensate PDS for Nintendo's infringement of the Asserted Patents; a declaration  
17 that Nintendo's infringement of the Asserted Patents was willful and that this case is exceptional  
18 pursuant to 35 U.S.C. § 285; an award of PDS' costs, expenses and attorney fees incurred in  
19 bringing and prosecuting this action; and an award of enhanced damages resulting from  
20 Nintendo's willful infringement, and all other categories of damages allowed by 35 U.S.C. §  
21 284. PDS' compensatory damages claim will be calculated pursuant to a reasonable royalty  
22 analysis based on information produced during the course of the case. PDS also intends to seek  
23 pre- and post-judgment interest at standard rates in an amount to be proven at trial. PDS intends  
24 to seek actual costs, expenses, and attorney fees incurred in bringing and prosecuting this action,  
25 in an amount to be determined at the time such fees are calculated. Finally, PDS intends to seek  
26 trebling of the jury's compensatory damages award due to Nintendo's willful infringement.

1 Nintendo's requests for relief will be contained in their answer to the complaint.

2 11. Settlement and ADR

3 The parties have engaged in settlement discussions in connection with the ITC  
4 investigation but have not specifically discussed Alternative Dispute Resolution with respect to  
5 this action. The parties believe that some form of ADR would be appropriate.

6 12. Consent to Magistrate Judge For All Purposes

7 Nintendo has filed a Declination to Proceed Before a US Magistrate Judge. Docket No.

8 14.

9 13. Other References

10 This case is not suitable for reference to binding arbitration, a special master, or the  
11 Judicial Panel on Multidistrict Litigation.

12 14. Narrowing of Issues

13 At this time, PDS does not foresee bifurcating any issues, claims, or defenses. Nintendo  
14 believes that certain issues may be amenable to bifurcation in light of the finding of no  
15 infringement in the ITC case, as well as findings in other cases involving one of more of the  
16 Asserted Patents. Nintendo will be in a better position to request bifurcation, if warranted, after  
17 PDS serves its infringement contentions.

18 Subject to the progression of discovery, the parties may be able to narrow certain issues  
19 via stipulated facts.

20 15. Expedited Trial Procedure

21 The parties do not believe this case is appropriate for an expedited trial schedule.

22 16. Scheduling

23 Pursuant to the Patent Local Rules and the Court's Standing Order for Patent Cases,  
24 claim construction deadlines are set as follows<sup>2</sup>:

25

26 <sup>2</sup> The parties have modified some of the deadlines from those set forth in the local rules.

Event	Due Date
Disclosure of Asserted Claims and Infringement Contentions (and related documents). Patent L.R. 3-1, 3-2.	October 24, 2014
Invalidity Contentions (and related documents). Patent L.R. 3-3, 3-4.	December 18, 2014
Exchange of Proposed Terms for Construction. Patent L.R. 4-1(a).	January 8, 2015
Exchange of Preliminary Claim Constructions and Extrinsic Evidence. Patent L.R. 4-2.	January 29, 2015
Joint Claim Construction and Prehearing Statement. Patent L.R. 4-3.	February 10, 2015
Completion of Claim Construction Discovery. Patent L.R. 4-4.	March 12, 2015
Opening Claim Construction Brief. Patent L.R. 4-5(a).	March 27, 2015
Responsive Claim Construction Brief. Patent L.R. 4-5(b).	April 10, 2015
Reply Claim Construction Brief. Patent L.R. 4-5(c); Amended, final joint claim construction statement. Standing Order for Patent Cases.	April 17, 2015
Technology Tutorial. Standing Order for Patent Cases.	April 27, 2015
Claim Construction Hearing. Patent L.R. 4-6; Standing Order for Patent Cases.	Monday, May 4, 2015 at 1:30 p.m.

The parties propose that the Court hold a Status Conference after the Court's claim construction ruling to set dates regarding the close of fact discovery, expert disclosures, close of expert discovery, mediation and other necessary deadlines, up to and including trial.

17. Trial

The parties demand a jury trial on their respective claims. The parties expect it to last two weeks.

18. Disclosure of Non-Party Interested Entities or Persons

PDS has filed the "Certification of Interested Entities or Persons" required by Civil Local Rule 3-15. PDS certifies that as of this date, other than the named parties and their shareholders, there is no interest to report.



1 Nintendo will file the “Certification of Interested Entities or Persons” required by Civil  
2 Local Rule 3-15 at the appropriate time. Nintendo certifies that as of this date, other than the  
3 named parties and their shareholders, there is no interest to report.

4 19. Professional Conduct

5 All attorneys of record for the parties have reviewed the Guidelines for Professional  
6 Conduct for the Northern District of California.

7 20. Patent Local Rule 2-1 Matters

8 (1) *Proposed modification of the obligations or deadlines set forth in the Patent*  
9 *Local Rules.* The parties currently do not propose any other modification of the obligations or  
10 deadlines set forth in the Patent Local Rules other than those set forth in Section 16 above.

11 (2) *Scope and timing of any claim construction discovery.* The parties do not know  
12 now what, if any, claim construction discovery will be needed or if the parties will need expert  
13 testimony for claim construction.

14 (3) *Format of the claim construction hearing.* The parties agree that live testimony at  
15 the claim construction hearing is not likely to be necessary. The parties will discuss order of  
16 argument prior to the hearing.

17 (4) *Educating the Court on technology.* Pursuant to the Court’s Standing Order for  
18 Patent Cases, the parties will present a technology tutorial one week before the claim  
19 construction hearing.

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Dated: September 19, 2014

Respectfully submitted,

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**FILER’S ATTESTATION PURSUANT TO L.R. 5-1(i)(3)**

I, James C. Otteson, am the ECF User whose ID and password are being used to file the “JOINT CASE MANAGEMENT STATEMENT” I hereby attest that concurrence in the filing of this document has been obtained from each of the other signatories.

Dated: September 19, 2014

By:           /s/ James C. Otteson            
James C. Otteson