

1 JAMES C. OTTESON, State Bar No. 157781
jim@agilityiplaw.com
2 MICHELLE BREIT, State Bar No. 133143
mbreit@agilityiplaw.com
3 AGILITY IP LAW, LLP
149 Commonwealth Drive
4 Menlo Park, CA 94025
Telephone: (650) 227-4800
5 Facsimile: (650) 318-3483

6 Attorneys for Defendants
TECHNOLOGY PROPERTIES LIMITED and
7 ALLIACENSE LIMITED

8 CHARLES T. HOGE, State Bar No. 110696
choge@knlh.com
9 KIRBY NOONAN LANCE & HOGE
35 Tenth Avenue
10 San Diego, CA 92101
Telephone: (619) 231-8666
11 Facsimile: (619) 231-9593

12 Attorneys for Defendant
PATRIOT SCIENTIFIC CORPORATION

13 UNITED STATES DISTRICT COURT
14 NORTHERN DISTRICT OF CALIFORNIA
15 SAN JOSE DIVISION
16

17 ACER, INC., ACER AMERICA)
CORPORATION and GATEWAY, INC.,)
18 Plaintiffs,)
19 v.)
20 TECHNOLOGY PROPERTIES LIMITED,)
21 PATRIOT SCIENTIFIC CORPORATION,)
and ALLIACENSE LIMITED,)
22 Defendants.)
23

Case No. 3:08-cv-00877 PSG

**DEFENDANTS' MOTION PURSUANT
TO CIVIL LOCAL RULE 7-9 FOR
LEAVE TO FILE MOTION FOR
RECONSIDERATION OF CERTAIN
ASPECTS OF CLAIM
CONSTRUCTION**

24
25
26
27
28

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

HTC CORPORATION and HTC
AMERICA, INC.,

Plaintiffs,

v.

TECHNOLOGY PROPERTIES LIMITED,
PATRIOT SCIENTIFIC CORPORATION
and ALLIACENSE LIMITED,

Defendants.

Case No. 3:08-cv-00882 PSG

BARCO, N.V.,

Plaintiffs,

v.

TECHNOLOGY PROPERTIES LIMITED,
PATRIOT SCIENTIFIC CORPORATION
and ALLIACENSE LIMITED,

Defendants.

Case No. 3:08-cv-05398 PSG

Introduction

Civil Local Rule 7-9(b)(1) states that a party may file a motion for leave to file a motion for reconsideration if: “at the time of the motion for leave, a material difference in fact or law exists from that which was presented to the Court before entry of the interlocutory order for which reconsideration is sought.” Civ. L.R. 7-9(b)(1). As discussed below, Defendants uncovered a material difference in fact after Judge Ware’s First Claim Construction Order (Docket No. 336, June 12, 2012) as a result of Defendants’ continuing review of the voluminous file histories for the MMP Patent Portfolio, including U.S. Patent No. 5,530,890 (“the ’890 patent”). In particular, Defendants uncovered evidence in the file history for the original parent application for the ’890 patent (from 20 years ago) that strongly supports reconsideration of Judge Ware’s First Claim Construction Order regarding the “separate DMA CPU” limitation in claim 11 of the ’890 patent.

Argument

I. CONTINUED REVIEW OF THE FILE HISTORIES OF THE MMP PORTFOLIO PROVIDED ADDITIONAL FACTS THAT REQUIRE MODIFICATION OF JUDGE WARE’S CONSTRUCTION OF “SEPARATE DMA CPU.”

Defendants’ Moore Microprocessor Patent (“MMP”) Portfolio includes file histories covering thirty-seven (37) applications resulting in seven (7) issued U.S. patents. In addition, the Plaintiffs in the present cases and other parties have filed sixteen (16) reexamination requests in the U.S. Patent and Trademark Office, and a nullity action in the European Patent Office, that has greatly multiplied the volume of the file histories for the MMP Portfolio. In total, the MMP Portfolio file histories (including reexamination proceedings) comprise approximately 291 U.S. patent references, 33 foreign patent references, 382 non-patent references, 134 litigation-related pleadings or transcripts, and 205 office actions and responses, leading to over than 30,000 pages of correspondence between the applicants and PTO and over 1,000 references.

In preparing its claim construction briefing for the ’890 patent before Judge Ware, TPL and its counsel focused on the file history for the application that led to the ’890 patent, as well as the extensive reexaminations of the MMP patents. TPL did so in the belief that such file histories, in conjunction with disclosures in the patent specification, provided the most relevant information

1 regarding the proper construction of the claim terms being construed, for example, the term
2 “separate DMA CPU.”

3 However, after the Court issued its First Claim Construction Order, which includes a
4 construction of the term “separate DMA CPU” (in claim 11 of the ‘890 patent), TPL embarked on
5 a second review of the voluminous file history. In particular, TPL looked back at the file history
6 for the parent application that led to the entire MMP Portfolio. As explained in the attached
7 Motion for Reconsideration, the early file history of the parent application included a restriction
8 requirement that led to subsequent prosecution of ten divisional applications, one of which led to
9 the ‘890 patent.¹ The restriction requirement provides significant insight into the meaning of the
10 term “separate DMA CPU”; in particular, how the Examiner distinguished the term from the
11 meaning of the term adopted by Judge Ware.

12 As the Federal Circuit has recognized, “district courts may engage in a rolling claim
13 construction, in which the court revisits and alters its interpretation of the claim terms as its
14 understanding of the technology evolves.” *Pfizer, Inc. v. Teva Pharm., USA, Inc.*, 429 F.3d 1364,
15 1377 (Fed.Cir.2005); *see also Utah Med. Prods., Inc. v. Graphic Controls Corp.*, 350 F.3d 1376,
16 1381-82 (Fed.Cir.2003) (district court did not err in amending claim construction during oral
17 arguments for pretrial motions nearly two years after original construction). Moreover, “[w]hen
18 the parties raise an actual dispute regarding the proper scope of these claims, the court, not the
19 jury, must resolve that dispute.” *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d
20 1351, 1360 (Fed.Cir.2008).

21
22
23
24
25
26
27
28 ¹ The Motion for Reconsideration is attached hereto as Exhibit 1.

Conclusion

1
2 Due to the material difference in fact discovered by Defendants in the file history for the
3 parent application for the MMP Portfolio, Defendants respectfully ask the Court for leave to file
4 the attached Motion for Reconsideration to correct the construction of “separate DMA CPU” in
5 claim 11 of the ‘890 patent. If convenient for the Court, Defendants propose that this issue be
6 briefed on the same schedule as the supplemental briefing to be received by the Court in advance
7 of the November 2012 claim construction hearing.

8
9 Dated: September 10, 2012

Respectfully submitted,

10 AGILITY IP LAW, LLP

11
12 By: /s/ James C. Otteson
James C. Otteson

13 Attorneys for Defendants
14 TECHNOLOGY PROPERTIES LIMITED
15 and ALLIACENSE LIMITED

16 KIRBY NOONAN LANCE & HOGE

17
18 By: /s/ Charles T. Hoge
Charles T. Hoge

19 Attorneys for Defendant
20 PATRIOT SCIENTIFIC CORPORATION