

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

INTELLECTUAL VENTURES I, LLC and)
INTELLECTUAL VENTURES II, LLC,)
)
Plaintiffs/Counter Defendants,)
)
v.) Civ. No. 11-908-SLR
)
MOTOROLA MOBILITY LLC,)
)
Defendants/Counter Claimants.)

Brian E. Farnan, Esquire of Farnan, LLP, Wilmington, Delaware. Counsel for Plaintiff. Of Counsel: Margaret Elizabeth Day, Esquire, David L. Alberti, Esquire, Clayton Thompson, Esquire, Marc C. Belloli, Esquire, Yakov Zolotorev, Esquire, and Nickolas Bohl, Esquire of Feinberg Day Alberti & Thompson LLP.

Jack B. Blumenfeld, Esquire and Stephen J. Krafshchik, Esquire of Morris Nichols, Arsht & Tunnell LLP, Wilmington, Delaware. Counsel for Defendant. Of Counsel: Candice Decaire, Esquire, D. Clay Holloway, Esquire, and Steven Moore, Esquire of Kilpatrick Townsend & Stockton LLP, and David A. Nelson, Esquire, David A. Perlson, Esquire, Patrick D. Curran, Esquire and Joshua L. Sohn, Esquire of Quinn Emanuel Urquhart & Sullivan LLP.

MEMORANDUM OPINION

Dated: March 31, 2016
Wilmington, Delaware


ROBINSON, District Judge

I. INTRODUCTION

On October 6, 2011, plaintiff Intellectual Ventures I, LLC and Intellectual Ventures II, LLC (collectively “IV”) filed suit in this district against defendant Motorola Mobility, Inc. (“Motorola”) alleging infringement of six patents: U.S. Patent Nos. 7,810,144 (“the ‘144 patent”), 6,412,953 (“the ‘953 patent”), 7,409,450 (“the ‘450 patent”), 7,120,462 (“the ‘462 patent”), 6,557,054 (“the ‘054 patent”), and 6,658,464 (“the ‘464 patent”). (D.I. 1) Motorola answered and asserted affirmative defenses of, inter alia, failure to state a claim, non-infringement, invalidity, prosecution history estoppel, the equitable doctrines of waiver, acquiescence, laches and unclean hands, and statutory time limitation on damages. (D.I. 10) Motorola also asserted counterclaims for non-infringement and invalidity. (*Id.*) IV answered Motorola’s counterclaims on January 6, 2012. (D.I. 13)

On August 20, 2013, Motorola filed a motion for summary judgment of invalidity (D.I. 230), and on September 9, 2013, Motorola filed a motion for summary judgment of non-infringement (D.I. 252). In a memorandum opinion and order dated January 2, 2014, the court issued its claim construction and resolved several issues, finding no infringement of claim 26 of the ‘144 patent and invalidity of claim 1 of the ‘953 patent based on the asserted prior art.¹ (D.I. 284) The court additionally denied Motorola’s motion for summary judgment of noninfringement of the ‘144, ‘953, ‘054, ‘464, ‘450, and

¹ While the court found a genuine issue of material fact existed regarding whether the ‘911 patent discloses the conversion of the unusable light reflected by the optical rotation selection layer from one linear polarization to another, the court found that combining the Ouderkirk and Mukasa references renders the ‘953 patent obvious. (D.I. 284 at 36-40)

'462 patents, and denied Motorola's motion for summary judgment of invalidity of the '144 '054, '464, '450, and '462 patents. (*Id.*) On January 8, 2014, the court limited trial to those issues related to the '462, '054 and '464 patents. (D.I. 288)

A nine-day jury trial was held on January 24 - February 4, 2014. The trial resulted in a hung jury and a mistrial was declared. On March 5, 2014, Motorola filed a renewed motion for judgment as a matter of law (D.I. 319), which the court granted with respect to invalidity of claims 1 and 8 of the '464 patent (D.I. 349). On January 12, 2015, Motorola filed a supplemental brief on patent eligibility and indefiniteness regarding the '054, '450 and '144 patents. (D.I. 360) The court invalidated the asserted claims of the '054 patent as being directed to unpatentable subject matter under 35 U.S.C. § 101. (D.I. 378)

A six-day jury trial was held on March 16 - 24, 2015 on the infringement and validity of claim 41 of the '144 patent and claims 1, 5, 8 and 9 of the '450 patent ("Trial 1"). On March 25, 2015, the jury returned a verdict that claim 41 of the '144 patent was valid and infringed and invalidated the '450 patent based on obviousness. (D.I. 411) A five-day jury trial was held on March 26 - 30, 2015 on the infringement and validity of claims 1, 10, 11, and 13 of the '462 patent ("Trial 2"). On March 30, 2015, the jury returned a verdict that claims 1, 10, 11, and 13 of the '462 patent were valid and infringed. (D.I. 424) Presently before the court are the following motions: (1) Motorola's motion for new trial on the '144 patent (D.I. 433); (2) Motorola's renewed motion for judgment as a matter of law ("JMOL") on the '144 patent (D.I. 436); (3) IV's renewed motion for JMOL regarding the '450 patent (D.I. 438); (4) Motorola's motion for new trial on the '462 patent (D.I. 442); (5) Motorola's renewed motion for JMOL on the

'462 patent (D.I. 444); and (5) IV's motion to strike improper lodging of demonstrative exhibits (D.I. 449). The court has jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a).

II. BACKGROUND

A. The Parties

IV I and II are limited liability companies organized and existing under the laws of the State of Delaware, with their principal place of business in Bellevue, Washington. (D.I. 1 at ¶¶ 1-2) IV I owns the '144, '450, '054, and '464 patents. (*Id.* at ¶¶ 10, 14, 18, 20) IV II is the exclusive licensee of the '953 patent and owns the '462 patent. (*Id.* at ¶¶ 12, 16)

Motorola is a corporation organized and existing under the laws of the State of Delaware, with its principal place of business in Libertyville, Illinois. (*Id.* at ¶ 3) It makes, manufactures, and/or sells the accused products. (*Id.* at ¶ 28)

B. The Patents

1. The '144 Patent

The '144 patent, titled "File Transfer System for Direct Transfer Between Computers," was filed on April 7, 2009 and issued on October 5, 2010.² The '144 patent "relates to transferring computer files electronically from one location to another, and more particularly to electronic transfer of computer files directly between two or more computers or computing devices." ('144 patent at 2:4-7)

² The '144 patent is a continuation of application no. 10/657,221 filed on September 9, 2003, which is a continuation of application no. 10/167,697 filed on June 13, 2002, which is a continuation of application no. 09/694,472 filed on October 24, 2000, which is a continuation of application no. 09/190,219 filed on November 13, 1998, which claims priority to provisional application no. 60/065,533 filed on November 13, 1997.

2. The '450 Patent

The '450 patent, titled "Transmission Control Protocol/Internet Protocol (TCP/IP) Packet-Centric Wireless Point to Multi-Point (PTMP) Transmission System Architecture," was filed February 28, 2005 and issued August 5, 2008.³ The '450 patent claims a system and method for "coupling one or more subscriber customer premise equipment (CPE) stations with a base station over a shared wireless bandwidth using a packet-centric protocol; and allocating the wireless bandwidth and system resources based on contents of packets." ('450 patent, Abstract) The invention specifically relates to "a system and method for implementing a QoS [quality of service] aware wireless point-to-multi-point transmission system." (*Id.* at 3:27-30)

3. The '462 Patent

The '462 patent, titled "Portable Computing, Communication and Entertainment Device with Central Processor Carried in a Detachable Handset," was filed December 19, 2005 and issued October 10, 2006.⁴ It claims a system that involves: (1) a portable device referred to in the claims as a "detachable handset" that has a central processor; and (2) a "docking display unit" that lacks a central processor. ('462 patent at 1:19-30, 6:2-20) The detachable handset can be docked with the docking display unit and, when docked, the central processor in the detachable handset controls the entire system. (*Id.*)

III. STANDARDS

³ The '450 patent is a continuation of application no. 09/349,477 filed on July 9, 1999, which claims priority from provisional application no. 60/092,452 filed on July 10, 1998.

⁴ The '462 patent is a continuation of application no. 09/719,290 filed on April 7, 2000, which claims priority from provisional application no. 60/128,138 filed on April 7, 1999.

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