MICHAEL A. SHERMAN (SBN 94783)
masherman@stubbsalderton.com
JEFFREY F. GERSH (SBN 87124)
jgersh@stubbsalderton.com
SANDEEP SETH (SBN 195914)
sseth@ stubbsalderton.com
WESLEY W. MONROE (SBN 149211)
wmonroe@stubbsalderton.com
STANLEY H. THOMPSON, JR. (SBN 198825)
sthompson@stubbsalderton.com
VIVIANA B. HEDRICK (SBN 239359)
vhedrick@stubbsalderton.com
STUBBS ALDERTON MARKILES, LLP
15260 Ventura Boulevard, 20TH Floor
Sherman Oaks, CA 91403
Telephone: (818) 444-4500
Facsimile: (818) 444-4520

Attorneys for PERSONALWEB TECHNOLOGIES, LLC

J. DAVID HADDEN (CSB No. 176148)
dhadden@fenwick.com
SAINA S. SHAMILOV (CSB No. 215636)
sshamilov@fenwick.com
PHILLIP J. HAACK (CSB No. 262060)
phaack@fenwick.com
RAVI R. RANGANATH (CSB No. 272981)
rranganath@fenwick.com
CHIEH TUNG (CSB No. 318963)
ctung@fenwick.com
FENWICK & WEST LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Telephone: 650.988.8500
Facsimile: 650.938.5200

Counsel for AMAZON.COM, INC. and AMAZON WEB SERVICES, INC.

DAVID D. WIER
david.wier@level3.com
Assistant General Counsel
1025 Eldorado Boulevard
Broomfield, CO 80021
Telephone: (720) 888-3539

Attorney for LEVEL 3 COMMUNICATIONS, LLC

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

IN RE PERSONAL WEB TECHNOLOGIES, LLC, ET AL., PATENT LITIGATION	Case No.: 5:18-md-02834-BLF-SVK
AMAZON.COM, INC., et al., Plaintiffs, v. PERSONALWEB TECHNOLOGIES, LLC, et al., Defendants.	Case No. 5:18-cv-00767-BLF-SVK **JOINT STATEMENT ON MOTION BY AMAZON.COM, INC. AND AMAZON WEB SERVICES, INC. TO COMPEL PERSONALWEB TO PROVIDE FURTHER INTERROGATORY RESPONSES** **Discovery Cut-Off: August, 16, 2019**
PERSONALWEB TECHNOLOGIES, LLC and LEVEL 3 COMMUNICATIONS, LLC, Counterclaimants, v. AMAZON.COM, INC. and AMAZON WEB SERVICES, INC., Counterdefendants.	

I. AMAZON'S STATEMENT

Amazon requests the Court's assistance with the discovery disputes described below. Fact discovery closes on August 16, 2019, and there are 213 days remaining until trial begins on March 16, 2020. The discovery requests at issue are attached as **Exs. 1 & 2**.[1] Amazon first raised these issues by letter on March 19, 2019. The parties conducted a two-hour conference on April 5, 2019, and Amazon served this motion on April 14.

After several additional conferences the parties have resolved all issues in the original motion except for one: (1) PersonalWeb agreed to conduct a reasonable search and produce the non-privileged documents in its possession custody and/or control for RFP Nos. 1, 21, 23-24, 35-37, 41, 46-48, 50-53, 57-58, 62-66, 74, 81-85 and 87. It will serve supplemental responses to that effect. (2) PersonalWeb agreed to serve a further response to Interrogatory No. 3 that states that the products and services that it contends practice the alleged inventions of each patent-in-suit are the accused products in each litigation that it has filed claiming infringement of such patent(s). Amazon agrees that such a narrative response will resolve the issue that it raised with respect to PersonalWeb's compliance with Rule 33(d). (3) PersonalWeb agreed to serve these supplemental responses by July 30, 2019.

Amazon requests the Court order PersonalWeb to supplement its response to Interrogatory No. 4, the remaining disputed request, within 7 days.

Interrogatory 4 requires PersonalWeb to state in detail secondary considerations or objective evidence of non-obviousness. Amazon needs this information urgently for preparation of its opening expert report on invalidity. PersonalWeb's response refers to the success of the accused Amazon technology and others but does not disclose any facts that connect that commercial success to the purported non-obviousness *of the patents-in-suit*. Nor is PersonalWeb willing to confirm its response is complete. A responding party must answer an interrogatory to the full extent of its knowledge. *See Haggarty v. Wells Fargo Bank, N.A.*, No. 10–2416 CRB (JSC), 2012 WL 4113341, at *1 (N.D. Cal. Sept. 18, 2012) ("The responding party must answer interrogatories using not only personal knowledge but also 'information immediately available to him or under his control.'") (citation omitted). *At a*

[1] The same discovery disputes at issue for Amazon are also at issue for Twitch. *See* **Exs. 3 & 4**; Twitch's First Set of Interrogatories Nos. 3-4; Twitch's First Set of Requests for Production Nos. 1, 18, 20-21, 33-35, 40-42, 44-47, 51-52, 56-60, 68, 75-79, 81

minimum, the Court should compel PersonalWeb to provide the facts in its possession.

Recently, PersonalWeb has also argued it *cannot respond* because Amazon did not identify specific obviousness combinations in its invalidity contentions. This objection is bogus for two reasons. First, the requested facts concern PersonalWeb's purported invention and do not depend in any way on *Amazon's* contentions in a lawsuit.[2] Second, PersonalWeb never objected or sought any relief in the months it has had Amazon's invalidity contentions. *See, e.g.*, *Fujifilm Corp. v. Motorola Mobility LLC,* No. 12–cv–03587–WHO, 2015 WL 757575, at *29 (N.D. Cal. Feb. 20, 2015) (explaining proper recourse is a motion to compel). Regardless, Amazon *did* identify specific combinations in the charts included with the contentions. It mapped each limitation in the claims to a primary prior art reference and included pin citations to the other references that disclose the same limitation.[3] Local Patent Rule 3-3(b) does not require anything more. *See 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) (contentions sufficient where defendant identified prior art groups and asserted they would invalidate however combined, even though that encompassed many combinations); *see also Keithley v. Homestore.com, Inc.*, 553 F. Supp. 2d 1148, 1150 (N.D. Cal. 2008) (same).

II. PERSONALWEB'S STATEMENT

Interrogatory 4 ask for PersonalWeb's contentions regarding secondary considerations of non-obviousness and, in a separate sentence (a discrete subpart), the nexus between claimed inventions and secondary considerations of non-obviousness. The nexus between secondary considerations of non-obviousness and a claim, however, depends on which features of the claims are disclosed in a single prior art reference. *See Novartis v. Torrent Pharma. Ltd.*, 853 F.3d 1316, 1330 (Fed, Cir. 2017).

Amazon's Invalidity Contentions list 54 prior art references as anticipating claims of the

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[2] The secondary considerations are: (1) the invention's commercial success, (2) long felt but unresolved needs, (3) the failure of others, (4) skepticism by experts, (5) praise by others, (6) teaching away by others, (7) recognition of a problem, (8) copying of the invention by competitors, and (9) other relevant factors. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 381 F.3d 1371, 1377 (Fed. Cir. 2004); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *In re Beattie*, 974 F.2d 1309, 1313 (Fed. Cir. 1992).

[3] Amazon can provide copies of the contentions if the Court so requests.

patents-in-suit and state, "Any of the references listed above may be combined to render obvious, and therefore invalidate, each of the asserted claims of the Patent-in-Suit as demonstrated above and/or in the accompanying claim charts." Amazon's Invalidity Contentions do not identify *any* combinations of two or more specific pieces of prior art as rendering any claims of the patents-in-suit obvious. Even if limited to combinations of just two or three references, Amazon's Invalidity Contentions allege obviousness based on 26,235 different combinations of two or three of the 54 listed prior art references. Asking PersonalWeb to form contentions as to secondary considerations of non-obviousness and the nexus between such indicia and each of the thousands of possible combinations of prior art Amazon relies on in its Invalidity Contentions is completely unreasonable, overbroad, and unduly burdensome. PersonalWeb should not be forced to answer it.

Amazon ignores *Novartis* and that the nexus between secondary considerations of non-obviousness and a claim, depends on which features of the claims are missing in a single prior art reference when it states, incorrectly, that "the requested facts concern PersonalWeb's purported invention and do not depend in any way on *Amazon's* contentions in a lawsuit."

Further, Amazon's generic statement, "Any of the references listed above may be combined to render obvious, and therefore invalidate, each of the asserted claims of the Patent-in-Suit as demonstrated above and/or in the accompanying claim charts," is not sufficient as an "identification of any combinations of prior art showing obviousness" as required by Patent L.R. 3-3(b). *See Slot Speaker Technologies, Inc. v. Apple, Inc.*, 2017 WL 235049 at *7 (N.D. Cal. 2017). As to invalidity contentions of obviousness based on a single prior art reference, Amazon's Patent L.R. 3-3 disclosures show each of the 24 charted references as disclosing every element of each of the charted patent claims and thus does not disclose what element of any of the claims is not met by the charted references, but would have been obvious in view of the charted reference. Accordingly, Amazon has not sufficiently disclosed any obviousness invalidity contention based on a single reference, either.

Thus, for the additional reason that Amazon has not sufficiently disclosed any specific obviousness invalidity contentions in its Patent L.R. 3-3 disclosure, obviousness is no longer an issue in this case and Interrogatory No. 4 does not relate to any relevant issue in the case and is not reasonably calculated to lead to the discovery of any admissible evidence and thus need not be

answered by PersonalWeb.

Amazon recently raised the argument that PersonalWeb should have objected to Amazon's invalidity contentions earlier. This argument ignores, however, PersonalWeb's argument here is not that Amazon's invalidity contentions are necessarily deficient in general, just they do not provide enough information to allow PersonalWeb to answer Interrogatory No, 4.

Respectfully submitted,

Dated: July 24, 2019

STUBBS, ALDERTON & MARKILES, LLP

By: */s/ Wesley W. Monroe*
Michael A. Sherman
Jeffrey F. Gersh
Sandeep Seth
Wesley W. Monroe
Stanley H. Thompson, Jr.
Viviana Boero Hedrick
Attorneys for Defendants

Attorneys for PERSONALWEB TECHNOLOGIES, LLC

Dated: July 24, 2019

FENWICK & WEST LLP

By: */s/ J. David Hadden*
J. DAVID HADDEN (CSB No. 176148)
dhadden@fenwick.com
SAINA S. SHAMILOV (CSB No. 215636)
sshamilov@fenwick.com
TODD R. GREGORIAN (CSB No. 236096)
tgregorian@fenwick.com
PHILLIP J. HAACK (CSB No. 262060)
phaack@fenwick.com
RAVI R. RANGANATH (CSB No. 272981)
rranganath@fenwick.com
CHIEH TUNG (CSB No. 318963)
ctung@fenwick.com
FENWICK & WEST LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Telephone: 650.988.8500
Facsimile: 650.938.5200

Counsel for AMAZON.COM, INC. and AMAZON WEB SERVICES, INC.