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July 14, 2017

BY CM/ECF & HAND DELIVERY

The Honorable Richard G. Andrews
U.S. District Court for the District of Delaware
U.S. Courthouse
844 North King Street
Wilmington, DE 19801

Re: *Acceleration Bay LLC v. Activision Blizzard, Inc. et al.*
D. Del., C.A. No. 16-453-RGA, 16-454-RGA, 16-454-RGA

Dear Judge Andrews:

Plaintiff Acceleration Bay LLC (“Acceleration Bay”) writes in response to the Court’s question during the July 10, 2017 *Markman* hearing to confirm its position that statements made during the prosecution of the six asserted patents are not binding upon the scope of the other asserted patents. Each of the asserted patents issued from a separate application, and none of the patents are a parent, continuation, continuation-in-part or divisional of another.

To determine whether statements made during prosecution of a patent apply to construing the claims of a different patent, the Federal Circuit considers a number of factors, including (1) whether the patents have a parent/child or sibling relationship (*i.e.*, were filed as continuations, continuations-in-part, or divisional applications of one another or a common parent), (2) whether the patents claim the same invention, (3) the patents’ respective disclosures, (4) when the patents were filed, (5) common ownership, and (6) overlap in inventorship. *See Abbott Labs. v. Dey, L.P.*, 287 F.3d 1097, 1105 (Fed. Cir. 2002) (declining to limit claim scope based on prosecution history of a separate application that did not have a parent/child or sibling relationship with the patent-in-suit); *cf. Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004) (holding that statements made in prosecution of one patent are relevant to the scope of all sibling patents).

Acceleration Bay is not aware of any Federal Circuit case finding statements made during prosecution of a different patent to be binding on the construction of another patent without a parent/child or sibling relationship between the patents, which is not present here. For example, in *Abbott Laboratories*, the patent-in-suit claimed improvements on inventions disclosed in a commonly owned earlier filed application sharing one of the same inventors. 287 F.3d at 1105.

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The Federal Circuit nevertheless declined to limit the claim scope of the patent-in-suit based on statements made during prosecution of the earlier filed application, explaining that the patent-in-suit “was not filed as a continuation, continuation-in-part, or divisional application of the [earlier filed] application” and that “[t]hese applications have no formal relationship and were presented to the patent office as patentably distinct inventions.” *Id.* at 1105.

Similarly, in *Trustees of Columbia Univ. in City of N.Y. v. Symantec Corp.*, the Federal Circuit held that “there is no reason why” claims from two separate but commonly owned patent families sharing one of the same inventors should be construed consistently, explaining that the “patents comprise two separate families, and these two families of patents claim two different inventions, list only one inventor in common, were filed years apart, and do not result from the same patent application.” 811 F.3d 1359, 1369 (Fed. Cir. 2016). The Federal Circuit further cautioned that, even if patents are in the same family, that does not mean that their claims must be construed consistently—rather, the context of the claim language itself may dictate that the claims cover different scope. *Id.* at 1370; *see also ResQNet.com, Inc. v. Lansa, Inc.*, 346 F.3d 1374, 1383 (Fed. Cir. 2003) (“Although a parent patent’s prosecution history may inform the claim construction of its descendant, the [parent] patent’s prosecution history is irrelevant to the meaning of this limitation because the two patents do not share the same claim language.”)(citation omitted).

Here, the asserted patents were filed as six separate applications and do not have a parent/child or sibling relationship.¹ Further, they have separate file histories, they claim different inventions,² and, although there are similarities in their specifications, they are not identical. Under these circumstances, there is no basis to limit the scope of any of these patents based on statements made in prosecution of one of the other patents.

Respectfully,

/s/ Philip A. Rovner

Philip A. Rovner (#3215)

cc: All Counsel of Record (Via ECF Filing, Electronic Mail)

¹ Although the face each of the asserted patents states that it “is related to” each of the other patents, this statement does not create a formal familial relationship, *i.e.*, a parent/child or sibling relationship. This is confirmed by the fact that the USPTO’s Patent Application Information Retrieval system (“PAIR”) does not identify the asserted patents as related. *See* attached Exhibits A-F (PAIR “Continuity Data” for each of the asserted patents).

² The USPTO recognized that the asserted patents claim separate and patentably distinct inventions, only requiring terminal disclaimers between the ‘344 and ‘966 patents.