

**MORRIS, NICHOLS, ARSHT & TUNNELL LLP**

1201 NORTH MARKET STREET  
P.O. BOX 1347  
WILMINGTON, DELAWARE 19899-1347

(302) 658-9200  
(302) 658-3989 FAX

**JACK B. BLUMENFELD**  
(302) 351-9291  
(302) 425-3012 FAX  
jblumenfeld@mnat.com

July 14, 2017

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

VIA ELECTRONIC FILING

Re: Acceleration Bay LLC; C.A. Nos. 16-453 (RGA); 16-454 (RGA); and 16-455 (RGA)

Dear Judge Andrews:

Defendants submit this letter to address whether the prosecution histories of the '344 and '966 Patents, including arguments to overcome Alagar (*see* C.A. No. 16-453, D.I. 191, Ex. K-A), constitute intrinsic evidence and apply equally to the other Asserted Patents (the '634, '147, '069 and '497 Patents). Defendants submit that the '344 and '966 prosecution histories are intrinsic evidence for the other Asserted Patents.

**Background:** The six Asserted Patents were filed on the same day, by the same inventors, and include largely identical specifications. *See* Appendix A. Each of the Asserted Patents cites on its face the applications for the '344 and '966 Patents as prior art, as well as the Alagar reference.<sup>1</sup> Further, each of the Asserted Patents cross-references the applications of the other Asserted Patents as “related,” and states that their “disclosures ... are incorporated herein by reference.” *Id.*

The Patent Office rejected the pending claims of the applications for the '344 and '966 Patents in May and June 2003, respectively, in view of Alagar. *See* C.A. No. 16-453, D.I. 117, Ex. B-1 & B-2. On September 10, 2003, the applicants amended both the '344 and '966 applications, adding the “m” and “m-regular” limitations, in order to overcome Alagar. The applicants addressed the “m” limitations and explained that Alagar teaches “indiscriminate linking with neighbors” and is “precisely the opposite” of the claimed invention. Ex. B-1 (September 10, 2003 Amendment) at 9-11. The applicants also explained that “the Alagar reference is deceiving in that it coincidentally shows a 4-regular network” and that “the Alagar reference clearly indicates that there is in fact nonregularity in a computer network formed because the number of neighbors is not set at a predetermined number.” *Id.* In contrast, the Applicants stated that “Claim 1 as amended requires that the computer network be m regular at substantially all times where there are not new nodes entering or leaving the network.” *Id.* The '344 and '966 Patents then issued, with the remaining related applications still pending. The

<sup>1</sup> The '147 Patent cites the applications for the '344 and '966 Patents as prior art. The '344, '966, '634, '069, and '497 Patents each cite the other five Asserted Patent applications as prior art.

The Honorable Richard G. Andrews  
July 14, 2017  
Page 2

claims in the '634 and '147 applications were amended to add the same "m" and "m-regular" terms. B-3 ('147: 12/11/2003 Amend.) at 4; B-4 ('634: 7/13/2004 Examiner Amend.) at 2-4

**The file histories of the '344 and '966 patents are intrinsic evidence to all of the Asserted Patents.** The Asserted Patents state that they are related to one another and expressly incorporate by reference the applications for the other Asserted Patents. Thus those other applications (including their file histories) are part of the intrinsic records of all of the patents. *EPL Holdings, LLC v. Apple, Inc.*, 2014 WL 491270, at \*2 (N.D. Cal. Feb. 4, 2014) ("Intrinsic evidence includes the patent and its file history, including any reexaminations and reissues, related patents and their prosecution histories, and the prior art that is cited or incorporated by reference in the patent-in-suit and prosecution history."). The listing on the face of the patent, cross-reference to, and incorporation of the applications for the '344 and '966 Patents by the other four Asserted Patents satisfies the public notice requirement for intrinsic evidence.

Further, the Federal Circuit has held that prior art "listed as a reference on the face of the [asserted patent]" establishes that the reference is intrinsic evidence. *V-Formation, Inc. v. Benetton Grp. SpA*, 401 F.3d 1307, 1311 (Fed. Cir. 2005) ("The [] patent is prior art that was listed as a reference on the face of the [] patent and in an Information Disclosure Statement. ... This court has established that 'prior art cited in a patent or cited in the prosecution history of the patent constitutes intrinsic evidence.'" (citing cases); see also *Open Text S.A. v. Box, Inc.*, 2015 WL 400348, at \*2 (N.D. Cal. Jan. 28, 2015) ("The only definition ... that the parties point to in the intrinsic record is in U.S. Patent No. 5,202,982, which is listed on the face of the patent and thus constitutes intrinsic evidence."). Here, each of the Asserted Patents lists Alagar and the applications for the '344 and '966 Patents on its face, and thus they are intrinsic evidence.

Still further, none of the rationales for treating evidence as extrinsic apply here. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318-19 (Fed. Cir. 2005) (identifying five reasons why extrinsic evidence is less reliable than intrinsic evidence). The prosecution history at issue here was contemporaneous with all of the applications, all Asserted Patents share the same inventors, and the statements were made by the Applicants themselves regarding the meaning of terms common to and used in the same way by each of the Asserted Patents.

**The Applicant Statements Are Relevant and Persuasive Evidence Whether Intrinsic or Extrinsic.** Even if the Court concludes that the file histories of the '344 and '966 Patents are not intrinsic evidence, they should at least be considered persuasive extrinsic evidence. For example, the Court of Federal Claims found an argument in an earlier patent to be persuasive evidence for the construction of a later patent with the same inventor. *Ross-Hime Designs, Inc. v. United States*, 126 Fed. Cl. 299, 324-25 (2016) (citations omitted). The case involved two patents that shared the same inventor and used the same claim language but did not share a common parent application. And, unlike this case, the patents there had different specifications and did not cross reference and incorporate one another by reference. *Id.* The court found that a disclaimer made during the prosecution of the earlier '580 Patent bore on the Court's construction of the same claim term from the later '962 Patent. *Id.* ("Defendant's position is further supported by the fact that the '580 Patent is expressly listed as a prior art reference in the '962 Patent specification and the '580 Patent itself uses the term 'differentials in movement.' As such, the Court concludes that its understanding of 'differentials in movement' based on the disclaimer in the '580 Patent also bears on the Court's construction of 'differentials in movement' for the '962 Patent.").

The Honorable Richard G. Andrews  
July 14, 2017  
Page 3

Respectfully,

*/s/ Jack B. Blumenfeld*

Jack B. Blumenfeld (#1014)

JBB/dlw

Enclosure

cc: Clerk of Court (Via Hand Delivery; w/enclosure)  
All Counsel of Record (Via Electronic Mail; w/enclosure)

**Appendix A**

<b>JCCC Ex. No. (C.A. 16-453, D.I. 117)</b>	<b>Patent No.</b>	<b>App. No.</b>	<b>App. Date</b>	<b>Issue Date</b>
A-1	6,701,344	09/629,042	July 31, 2000	Mar. 2, 2004
A-2	6,714,966	09/629,043	July 31, 2000	Mar. 30, 2004
A-3	6,732,147	09/629,577	July 31, 2000	May 4, 2004
A-4	6,829,634	09/629,576	July 31, 2000	Dec. 7, 2004
A-5	6,910,069	09/629,570	July 31, 2000	June 21, 2005
A-6	6,920,497	09/629,572	July 31, 2000	Jul. 19, 2005