

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

INVENSYS SYSTEMS, INC.,

Plaintiff,

vs.

EMERSON ELECTRIC CO. and
MICRO MOTION INC., USA,

Defendants.

and

MICRO MOTION INC., USA,

Counterclaim-Plaintiff,

vs.

INVENSYS SYSTEMS, INC.,

Counterclaim-Defendant.

Case No. 6:12-cv-00799-LED

INVALIDITY CONTENTIONS OF EMERSON ELECTRIC CO. AND MICRO MOTION, INC.

Pursuant to the Second Amended Docket Control Order, (Dkt. No. 69), and in compliance with P. R. 3-3, Defendant Emerson Electric Co. (“Emerson”) and Defendant and Counterclaim-Plaintiff Micro Motion, Inc. (“Micro Motion”) hereby provide their Invalidity Contentions relating to the Invensys Patents-in-Suit (United States Patent Nos. 7,124,646, 7,136,761, 6,311,136, 7,505,854, 6,754,594, 7,571,062, and 8,000,906) to Plaintiff and Counterclaim-Defendant Invensys Systems, Inc. (“Invensys”).

In addition, in compliance with P. R. 3-4, Emerson and Micro Motion are producing documents branded with production numbers MM00002702-MM0646207, certain of

which are being provided in native format and all of which are subject to the Protective Order entered in this case, (Dkt. No. 66).¹

These Invalidity Contentions are being provided without prejudice to Emerson's and Micro Motion's rights and are based on reasonable beliefs and information available prior to completion of fact or expert discovery. As such, Emerson and Micro Motion reserve the right to amend, add, supplement, change, alter, expand, or otherwise modify these Invalidity Contentions as Emerson and Micro Motion learn new information, additional facts are ascertained as discovery progresses in this case, including written discovery, document production, and both fact and expert depositions, analyses are made, research is completed, and additional contentions and elections of asserted claims are made.²

In addition, because there has been neither an interpretation of any claim elements of the Invensys Patents-in-Suit nor a *Markman* hearing and ruling to determine the meaning and scope of any of the claims, Emerson and Micro Motion reserve the right to amend, add, supplement, change, alter, expand, or otherwise modify these Invalidity Contentions, including in response to any Court order and/or the Rules of Practice for Patent Cases before the Eastern District of Texas, including P. R. 3-6.

¹ Micro Motion intends to make the relevant source code available for inspection at its counsel's office either in Boulder, Colorado or Milwaukee, Wisconsin upon Invensys's request, subject to the Protective Order, (Dkt. No. 66), and the parties' agreed upon restrictions.

² For example, Invensys has only just begun producing documents and has not produced all relevant documents in the possession, custody, or control of the purported inventors of the Invensys Patents-in-Suit or of Oxford University. Until those documents have been produced and appropriate follow up discovery has been conducted, Emerson and Micro Motion reserve their rights to assert appropriate invalidity defenses, including defenses under 35 U.S.C. §§ 102(b), (f), and (g).

These Invalidity Contentions should not be taken as evidence of or construed as an admission that the claim terms of the Invensys Patents-in-Suit have any construction alleged, now or hereafter, by Invensys. However, to the extent that the claim terms of the Invensys Patents-in-Suit have a scope and meaning that is suggested by Invensys, the claims are still anticipated or rendered obvious by the prior art identified and discussed in these Invalidity Contentions or otherwise invalid under 35 U.S.C. § 112. Based on the information available at this time, the Invensys Patents-in-Suit are invalid under any likely claim construction. Correspondingly, nothing in these Invalidity Contentions should be interpreted to mean that Emerson or Micro Motion have adopted a construction of any claim language, or that any claim language requires construction.

In addition, Emerson and Micro Motion reserve the right to rely on additional references, including those listed in the attached Exhibits and discussed herein, to establish the invalidity of the asserted claims of the Invensys Patents-in-Suit. To the extent any reference identified herein is not prior art to the asserted claims of the Invensys Patents-in-Suit, that reference is evidence of simultaneous invention by another.

These Invalidity Contentions are made solely for the purpose of this action and are subject to all objections as to competence, relevance, materiality, propriety, and admissibility, and to any other objections, which are expressly reserved and may be interposed at the time of trial.

With these reservations of rights and subject to Invensys's preliminary and final election of asserted claims, Emerson and Micro Motion provide their Invalidity Contentions, which identify how the currently asserted claims of the Invensys Patents-in-Suit are anticipated or rendered obvious by prior art as well as how these claims are invalid under various paragraphs

of § 112. Specifically, consistent with P. R. 3-3(a), Exhibit A identifies each item of prior art that is cited to show anticipation or obviousness of any claim. Consistent with P. R. 3-3(b) and (c), Exhibit B identifies representative prior art that anticipates each asserted claim or, in combination with other prior art references, renders the asserted claims obvious, setting forth representative motivations for such combinations.

The charts in Exhibit B identify where, in each cited prior art reference, each element of each asserted claim may be found. Where a single prior art reference includes every element of an asserted claim, that claim is anticipated or rendered obvious under that prior art reference. Where a combination of prior art references includes the elements of an asserted claim, that claim is obvious. If a particular prior art reference is found not to anticipate a particular asserted claim, that reference renders that claim obvious, either alone or in combination with other prior art disclosing the elements allegedly missing from that reference. The inclusion of a prior art reference as part of an obvious combination of prior art references does not preclude application of that prior art reference as a piece of prior art that anticipates or renders obvious without combination, or renders obvious in a different combination.

These Invalidity Contentions incorporate by reference, in their entirety, all references cited in any of the prior art references. In addition, where Emerson and Micro Motion cite to a particular figure in a prior art reference, the citation should be understood to encompass the caption and description of the figure and any text relating to the figure in addition to the figure itself. Where a cited portion of the text refers to a figure, the citation should be understood to include the figure as well.

In addition, Emerson and Micro Motion cite to Micro Motion product manuals and other documents descriptive of Micro Motion products, which are anticipating and/or render

obvious claims of the Invensys Patents-in-Suit. These product manuals and descriptive documents represent the associated products and product families, such that the associated products and product families also anticipate or render obvious the respective claims. Emerson and Micro Motion reserve the right to use the associated products and product families and related manuals and descriptive documents to show invalidity of any of the asserted claims in subsequent proceedings.

In an effort to focus the issues, Emerson and Micro Motion have cited only representative portions of the identified references, even where a reference may contain additional support for a particular claim element. Persons of ordinary skill in the art generally read an item of prior art as a whole and in the context of other publications and literature. Thus, to understand and interpret any specific statement or disclosure within a prior art reference, such persons would rely on other information within the reference, along with other publications, texts, and treatises, and their general scientific knowledge. Emerson and Micro Motion may rely on uncited portions of the prior art references and on other publications and expert testimony to provide context and as aids to understanding and interpreting the portions that are cited. In other words, the Exhibits are provided for illustrative purposes and may not set forth every place in every reference where a claim element is disclosed. Where elements are disclosed at multiple locations within a single item of prior art, Emerson and Micro Motion have not necessarily identified every iteration of every disclosure. In the Exhibits, the absence of an identified location in a reference where a claim or claim element of the Invensys Patents-in-Suit is found should not be deemed an admission by Emerson or Micro Motion that the element is missing from the reference.

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