

UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TENNESSEE
WESTERN DIVISION

_____)	
B.E. TECHNOLOGY, LLC,)	
)	
Plaintiff,)	
)	
vs.)	No.: 2:12-cv-02767-JPM-tmp
)	
AMAZON DIGITAL SERVICES, INC.,)	JURY DEMAND
)	
Defendant.)	
_____)	

**MEMORANDUM OF DEFENDANT
AMAZON DIGITAL SERVICES, INC. IN SUPPORT OF ITS MOTION TO DISMISS**

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Regents of the Univ. of Cal. v. Eli Lilly & Co.,
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Statutes and Rules:

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Miscellaneous:

Rai, A. *et al.*, United States Department of Commerce, PATENT REFORM:
 UNLEASHING INNOVATION, PROMOTING ECONOMIC GROWTH & PRODUCING HIGH-
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