EXHIBIT A

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The Honorable Rodney Gilstrap
U.S. District Court for the Eastern District of Texas
211 W. Ferguson
Tyler, Texas 75702

Re: C.A. No. 6:12-cv-799-JRG; *Invensys Systems, Inc. v. Emerson Electric Co., et al.*

Dear Judge Gilstrap:

Defendants' arguments are without merit. First, there appears to be no dispute regarding the prototypes. Second, dependent claim 13 of the '062 Patent is valid for (at least) the reasons independent claim 1 is valid as set forth in Invensys's letter briefs on claim 23. Third, contrary to Defendants' position, Dr. Bose's opinion that claim 24 of the '136 Patent is invalid is premised on Defendants' prototypes. Finally, Defendants' enablement and lack of written description defenses are based largely on Defendants' claim that the patents do not set forth the scientific principle on which they operate, which is simply not required by § 112.

I. There Is No Reason to Delay Granting Summary Judgment on Defendants' §§ 102 and 103 Defenses That Are Based on the Prototypes.

Defendants have stated that they "will not rely on the Digital Prototypes as evidence of invalidity." Defs.' Ltr. Br. (Bose) at 1, ECF No. 288-1. Defendants also seem to tacitly admit that without the prototypes they cannot prove invalidity of claim 36 of the '136 Patent, claims 1 and 20 of the '854 Patent, and claims 1, 4, and 8 of the '594 Patent. Thus, summary judgment on Defendants' §§ 102 and 103 defenses to those claims will be straightforward.

II. Claim 13 of the '062 Patent Is Not Anticipated or Obvious.

Claims 13 and 23 of the '062 Patent both depend from independent claim 1. In its opening and reply briefs requesting permission to file a summary judgment motion of infringement and validity of claim 23 (and as now confirmed by the PTAB), Invensys explained that none of the prior art references Defendants cite disclose the last element of claim 1. For the same reasons, Defendants cannot prove that claim 13 is invalid. *See* Pl.'s Ltr. Br. (Claim 23) at 5, ECF No. 266-1.

III. Claim 24 of the '136 Patent Is Not Anticipated or Obvious.

In his report on claim 24 of the '136 Patent, Dr. Bose relies exclusively on Defendants' prototypes for every element except the final limitation of the claim (*i.e.*, a control and

measurement system that accounts for aeration), which he asserts is also disclosed in Carpenter. Even then, Dr. Bose does not contend that Carpenter anticipates claim 24, but merely that it would have been obvious to combine Carpenter with the C32 prototype. *See* Bose Report ¶ 433. Thus, contrary to Defendants' assertion, Dr. Bose does not provide an invalidity opinion on claim 24 that is independent of the prototypes. As discussed above, Defendants have conceded that Dr. Bose cannot use the prototypes as prior art references, which precludes Defendants' §§ 102 and 103 defenses to claim 24 of the '136 Patent. *See supra* Part I.

IV. Defendants Cannot Support Their Enablement and Written Description Defenses.

A. A Patentee Need Not Explain the Science Underlying the Invention.

Defendants do not argue that a skilled artisan would be unable to *make* the patented flowmeter, but that skilled artisans would not understand *how* the invention works. *See* Defs.' Ltr. Br. (Invalidity) at 3-4, ECF No. 288-1. This has no relevance to the validity of Invensys's patents, however:

> It is certainly not necessary that [the inventor] understand or be able to state the scientific principles underlying his invention . . . . He must, indeed, make such disclosure and description of his invention that it may be put into practice. . . . This satisfies the law, which only requires as a condition of its protection that the world be given something new and that the world be taught how to use it. It is no concern of the world whether the principle upon which the new construction acts be obvious or obscure . . . .

Diamond Rubber Co. v. Consol. Rubber Tire Co., 220 U.S. 428, 435-36 (1911) (citations omitted); *see also Alcon Research Ltd. v. Barr Labs., Inc.*, 745 F.3d 1180, 1190 (Fed. Cir. 2014) ("Nor is it a requirement of patentability that an inventor correctly set forth, or even know, how or why the invention works." (quotations omitted)); *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1570 (Fed. Cir. 1983) ("[I]t is axiomatic that an inventor need not comprehend the scientific principles on which the practical effectiveness of his inventions rests."). Because Defendants' enablement and written description defenses are premised on a misconception of necessary contents of the specification under § 112, Defendants cannot prevail on those defenses as a matter of law.

B. Dr. Bose's Opinions on Enablement Are Conclusory.

Dr. Bose never claims that a skilled artisan following the teachings in the specifications would be unable to make a functional flowmeter meeting the limitations of the asserted claims without undue experimentation. In fact, Dr. Bose does not mention the amount of

experimentation required to practice the '646 Patent at all. As to the '761 Patent, he only offers a conclusory statement that undue experimentation would be necessary without discussing the amount of experimentation required. Such conclusory statements that ignore the enablement standard are insufficient to raise a fact issue. *See Alcon Research*, 745 F.3d at 1188-89; *Streck, Inc. v. Research & Diagnostic Sys., Inc.*, 665 F.3d 1269, 1290 (Fed. Cir. 2012).

C. Defendants' Written Description Argument Lacks Merit.

Contrary to Defendants' assertion, the specifications expressly show that the patented digital drive flowmeter provided improved accuracy under two-phase flow conditions. *See, e.g.*, '646 Pat. 51:38-11. Defendants cannot create a fact issue by misrepresenting the contents of the patents' specifications. In addition, to the extent Dr. Bose opines that the patents' claims are broader than the disclosures, he relies almost entirely on the alleged differences between the provisional application and the issued patents. But Defendants fail to cite any authority holding that a provisional application impacts the sufficiency of the specification in an issued patent.

V. Defendants Have No Excuse for Their Discovery Misconduct.

Defendants do not dispute that Richard Maginnis, Defendants' 30(b)(6) representative on the factual bases of Defendants' affirmative defenses, was unprepared to testify on this subject. Instead, Defendants' claim that Maginnis's lack of preparation should be excused because they objected to this topic. But "[t]he only pre-deposition protest allowed by the Federal Rules of Civil Procedure is a motion for a protective order." *Ferko v. NASCAR*, 218 F.R.D. 125, 144 (E.D. Tex. 2003); *see also RTC v. S. Union Co.*, 985 F.2d 196, 197 (5th Cir. 1993) (if a 30(b)(6) representative is not prepared to testify "then the appearance is, for all practical purposes, no appearance at all").

Nor can Defendants rely on their interrogatory responses. "[R]esponding to written discovery is not a substitute for providing a thoroughly educated Rule 30(b)(6) deponent." *Great Am. Ins. Co. of N.Y. v. Vegas Constr. Co.*, 251 F.R.D. 534, 541 (D. Nev. 2008).

Finally, Defendants' allegation that Invensys engaged in the same type of discovery misconduct is belied by their own briefing. Defendants argue that "Invensys did the very same thing in its deposition with respect to 30(b)(6) topics directed to the *legal contentions* of the parties." Defs.' Ltr. Br. (Invalidity) at 5, ECF No. 288-1 (emphasis added). Refusing to answer deposition questions related to *legal issues* is not the same as refusing to answer questions relating to the *factual bases* of a parties' defenses.

For the foregoing reasons, and the reasons set forth in its opening letter brief, Invensys requests permission to file a summary judgment motion on Defendants' affirmative defenses.

Respectfully submitted,

/s/ Claudia Wilson Frost

Claudia Wilson Frost

cc: All Counsel of Record (via ECF)