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11
12 **UNITED STATES DISTRICT COURT**
13 **CENTRAL DISTRICT OF CALIFORNIA**
14 **SOUTHERN DIVISION**

15 ACACIA MEDIA TECHNOLOGIES
16 CORPORATION,

17 Plaintiff,

18 vs.

19 NEW DESTINY INTERNET GROUP,
20 et. al.,

21 Defendants.

Case No. SACV 02-1040 JW (MLGx)

Consolidated Cases:

SA CV 02-1048-JW (MLGx)
SA CV 02-1063-JW (MLGx)
SA CV 02-1165-JW (MLGx)
SA CV 03-0217-JW (MLGx)
SA CV 03-0218-JW (MLGx)
SA CV 03-0219-JW (MLGx)
SA CV 03-0259-JW (MLGx)
SA CV 03-0271-JW (MLGx)
SA CV 03-0308-JW (MLGx)

Related Cases:

SA CV 03-1801-JW (MLGX)
SA CV 03-1803-JW (MLGX)
SA CV 03-1804-JW (MLGX)
SA CV 03-1805-JW (MLGX)
SA CV 03-1807-JW (MLGX)

**ACACIA'S OBJECTION TO
DEFENDANTS' REPEATED USE
OF THE SO-CALLED "SARNOFF
REPORT" IN CONNECTION
WITH THE MARKMAN
HEARING PROCEEDINGS**

CTRM: Hon. James Ware

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27 **AND ALL RELATED CASE ACTIONS.**

28 Case No. SACV 02-1040 JW (MLGx)

1 In its December 12, 2003 Order Consolidating Related Cases; Setting Claims
2 Construction Hearing; Setting Interim Case Management Conference, this Court
3 ordered in pertinent part that “the Court will consider only *intrinsic* evidence to
4 interpret disputed claims, i.e., the claims themselves, the written description portion of
5 the specification and the file history.” Order, para. 2 (emphasis added). The repeated
6 reference to *extrinsic* evidence by the Fish & Richardson Defendants (“Fish
7 Defendants”), and Acacia’s concern that it will thereby be prejudiced if it does not
8 respond to the Fish Defendants’ statements, occasions the filing of this brief
9 objection.

10 Notwithstanding this Court’s order, the Fish Defendants repeatedly relied on
11 certain extrinsic evidence in their claim construction briefing and arguments. The
12 original claim construction brief of the Fish Defendants identified a David Sarnoff
13 Research Center Report, which is extrinsic evidence. The Fish Defendants then
14 characterized the content of that report in its opening claim construction brief, p. 5:1-
15 9, and n.5. Exhibit I to the Declaration of Todd Miller, which accompanied the Fish
16 Defendants’ opening claim construction brief, included a copy of the extrinsic report.
17 Counsel for the Fish Defendants during the first day and the last day of the Markman
18 hearings orally referred to that extrinsic evidence report. Following the conclusion of
19 the hearing, counsel for Acacia received notice from Fish Defendant attorney Todd
20 Miller that the Court’s expert, Mr. Schulte, had requested from Mr. Miller a copy of
21 the “Sarnoff Report,” which is wholly extrinsic to the legally relevant documents to
22 be considered in connection with the claim construction determinations to be made by
23 this Court.

24 Acacia did not previously respond to defendants’ references and arguments
25 based on the Sarnoff Report because the matters were and remain impertinent and
26 outside the scope of the Court’s order. To assure that no prejudice results to Acacia,
27 the following facts relevant to the Sarnoff Report and to the Fish Defendants
28 comments concerning that report are provided by Acacia.

1 1. The report is legally irrelevant to issues of novelty and patentability—the
2 initial paragraph of the report in describing its scope states that the review “is not
3 intended as an expert evaluation of patentability.”

4 2. The author of the report is demonstrably wrong in his factual predicate
5 for the Report’s statement repeatedly relied on by the defendants that the Sarnoff
6 Center does not consider “the overall system architecture to be novel.” That
7 statement in the Report was expressly based on the author’s view that similar systems
8 have “been demonstrated in practice, such as the MPEG-based video-on-
9 demand/interactive multimedia prototype currently being shown at Bell
10 Communications Research, Morristown by Dr. A. Gelman” The date of the Sarnoff
11 Report, when Dr. Gelman’s system was “currently being shown,” was April 17, 1992,
12 over a year after the Yurt patent application was filed. Dr. Gelman’s earlier article
13 about his system, which is listed among the references at the end of the Sarnoff
14 Report, was not published until June 1991, well after the Yurt patent application was
15 filed. The Gelman article and system, therefore, were not even prior art to the Yurt
16 patents.

17 3. The author of the report demonstrably did not understand what Yurt
18 understood was necessary to an effective communication system. The precise
19 combination of elements described and claimed in the ‘992 and ‘702 patent system,
20 such as the use of a time encoder, is not mentioned in the Sarnoff Report at all.

21 4. The fact that the applicant did not disclose the Sarnoff Report or the
22 references cited in it during patent prosecution is not probative of any violation of the
23 applicant’s duty of candor as defendants irrelevantly argue. Like the Gelman article,
24 the Sarnoff Report itself and other references in it are not prior art. Any prior art
25 references that were identified in the Sarnoff Report were duplicative of other art the
26 Examiner did consider in issuing the ‘992 and ‘702 patents and therefore were not
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1 material. These are issues extrinsic and irrelevant to claim construction which may be
2 addressed, if at all, at a later time in this case.

3
4 DATED: June 3, 2004

HENNIGAN BENNETT & DORMAN LLP

5
6 By _____ /s/ _____
7 Roderick G. Dorman

8 Attorneys for Plaintiff,
9 ACACIA MEDIA TECHNOLOGIES
10 CORPORATION

1 **PROOF OF SERVICE**

2 I, Lisa Spears, declare:

3 I am a citizen of the United States and employed in Los Angeles County,
4 California. I am over the age of eighteen years and not a party to the within-entitled
5 action. My business address is 601 South Figueroa Street, Suite 3300, Los Angeles,
6 California 90017.

7 On **June 3, 2004**, I served a copy of the within document described as
8 **ACACIA’S OBJECTION TO DEFENDANTS’ REPEATED USE OF THE SO-**
9 **CALLED “SARNOFF REPORT” IN CONNECTION WITH THE MARKMAN**
10 **HEARING PROCEEDINGS** by transmitting via United States District Court for the
11 Central District of California Electronic Case Filing Program the document(s) listed
12 above by uploading the electronic files for each of the above listed document(s) on
13 this date, addressed as set forth:

14 **SEE ATTACHED SERVICE LIST**

15 The above-described document was also transmitted to the parties indicated
16 below, by United States Mail only.

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22 ICS, Inc. and AP Net Marketing	Global Media Resources SA

23 The above-described document was also transmitted to the parties indicated
24 below, by Federal Express only.

25 Chambers of the Honorable James Ware
26 Attn: Regarding Acacia Litigation
27 280 South First Street
28 San Jose, CA 95113
3 copies

I am readily familiar with Hennigan, Bennett & Dorman LLP's practice in its
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locations during designated hours are deposited with the United States Postal Service
with first class postage thereon fully prepaid that same day in the ordinary course of
business; and,

1 I am readily familiar with Hennigan, Bennett & Dorman LLP's practice in its
2 Los Angeles office for the collection and processing of federal express with Federal
Express.

3 I declare that I am employed in the office of a member of the bar of this Court
4 at whose direction the service was made.

5 Executed on **June 3, 2004**, at Los Angeles, California.

6
7
8 /s/
9 Lisa Spears
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