

246 F.R.D. 579, 589-90 (E.D. Mo. 2007), *Black & Decker Inc. v. Robert Bosch Tool Corp.*, 371 F. Supp. 2d 965, 968-69 (N.D. Ill. 2005), and *SanDisk Corp. v. Audio MPEG, Inc.*, C06-02655 RMW, 2007 WL 30598, *2-6 (N.D. Cal. Jan. 3, 2007)).

Wolfram attempts to distinguish *Applera*, *Furminator*, *Black & Decker*, and *Audio MPEG* by over-emphasizing the opening reference line of Lodsys' letter — which merely reads: "Infringement of U.S. Patent Nos. 5,999,908, 7,133,834, 7,222,078, and 7,620,565" — and alleging that Lodsys' notice letter therefore identified the '908, '834 and '565 patents as infringed. Plaintiff's Opposition to Defendant Lodsys, LLC's and Lodsys Group, LLC's Motion to Dismiss Under FRCP 12(b)(1) (Dkt. 27) (the "Opposition") at 4, 7-9. However, as described in the Memorandum, *Applera*, *Furminator*, *Black & Decker*, and *Audio MPEG* make clear that more is needed to create declaratory judgment jurisdiction — namely the patent owner must make specific, particularized assertions of infringement, which are not present here regarding the '908, '834, and '565 patents. Memorandum at 5; *see also Streck, Inc. v. Research & Diagnostic Sys., Inc.*, 665 F.3d 1269, 1284 (Fed. Cir. 2012) cert. denied, 11-1212, 2012 WL 1190441 (U.S. May 21, 2012) (regarding particular claims of patents-in-suit, court lacked declaratory judgment jurisdiction over claims that were not asserted or were withdrawn in the litigation); *PPS Data, LLC v. Availity, LLC*, 3:11-CV-747-J-37TEM, 2012 WL 252830, *2-3 (M.D. Fla. Jan. 26, 2012) (same); *3D Sys., Inc. v. Envisiontec, Inc.*, 575 F. Supp. 2d 799, 805 (E.D. Mich. 2008) (threat of infringement litigation is insufficient to confer declaratory judgment jurisdiction where the threat "was in general terms lacking any specificity"). Thus, Wolfram has failed to show that the reasoning in these cases is inapplicable to this litigation.

In contrast, the decisions cited by Wolfram as "controlling precedent" *are*, in fact, distinguishable. *See* Opposition at 5-7 (citing *SanDisk corp. v. STMicroelectronics, Inc.*, 480 F.3d 1372 (Fed. Cir. 2007), *Cardinal Chemical Co. v. Morton Intern., Inc.*, 508 U.S. 83, 113 S.

Ct. 1967, 124 L. Ed. 2d 1 (1993), *Hewlett-Packard Co. v. Acceleron LLC*, 587 F.3d 1358 (Fed. Cir. 2009), *Micron Technology, Inc. v. MOSAID Technologies, Inc.*, 518 F.3d 897 (Fed. Cir. 2008), and *Renaissance Learning, Inc. v. Doe No. 1*, No. 11-cv-166-SLC, 2011 WL 5983299 (W.D. Wis. Nov. 29, 2011)). In particular, the decisions cited by Wolfram concerned whether there was a case or controversy between the parties, without deciding the question, salient to this litigation, of whether a case or controversy regarding a particular patent in a portfolio can spill over to confer declaratory judgment jurisdiction over the other patents in the portfolio. Here, Lodsys and Lodsys Group do not challenge the Court's declaratory judgment jurisdiction over Wolfram's claims regarding the '078 patent, given Lodsys' notice letter and claim chart detailing Wolfram's infringement of the '078 patent. But Wolfram has not carried its burden of showing that jurisdiction also encompasses the '908, '834, and '565 patents.

Moreover, *STMicroelectronics* is also distinguishable because in that case, the patent owner presented the declaratory judgment plaintiff with "a detailed presentation which identified, on an element-by-element basis, the manner in which [the patent owner] believed *each* of [the plaintiff's] products infringed the specific claims of *each* of [the patent owner's] patents [and] also gave [the plaintiff] a packet of materials, over 300 pages in length, containing, for *each* of [the patent owner's] fourteen patents under discussion, a copy of the patent, reverse engineering reports for certain of [the plaintiff's] products, and diagrams showing a detailed infringement analysis of [the plaintiff's] products." 480 F.3d at 1382 (emphasis added). In contrast, Wolfram does not allege that Lodsys' letter detailed any specific infringement of the '908 patent, the '834 patent, or the '565 patent by Wolfram.

Likewise, *Cardinal Chemical* is distinguishable because the Court found there was declaratory judgment jurisdiction over the defendant's *counterclaims* for infringement of certain patents, given that the patent owner had sued the defendant for infringement of those particular

patents and thereby the defendant had "actually been charged with infringement" of the patents. *Cardinal Chemical*, 508 U.S. at 86, 96. It suffices to say that Lodsys has not sued Wolfram for infringement of any patent, let alone the '908, '834, and '565 patents.²

Hewlett Packard is distinguishable for the additional reason that, in determining there was a case or controversy between the patent owner and HP, the *Hewlett Packard* Court found persuasive that the patent owner's communications with HP requested that HP refrain from commencing a declaratory judgment action, but, at the same time, the patent owner refused HP's proposal of a 120-day standstill during which the patent owner would not sue HP. *Hewlett-Packard*, 587 F.3d at 1362-64. In contrast, no litigation standstill proposals were made or rejected by Lodsys, Lodsys Group, or Wolfram here.

Finally, in *Renaissance Learning*, unlike here, the patent owner's communications with the declaratory judgment plaintiff (1) indicated that the patent owner would "identify specific patents and provide information outlining the basis for the infringement claims against [the plaintiff's] products or services," (2) characterized licensing discussions as a way to avoid "resorting to litigation," and (3) included a "demand for a one-sided forbearance agreement that required that [the plaintiff] not file suit but imposed no reciprocal obligation on [the patent owner]" — all of which the *Renaissance* Court found persuasive in concluding that the plaintiff had met its burden of showing a case or controversy between the parties. *Renaissance Learning*, 2011 WL 5983299 at *2-4.

Accordingly, Lodsys and Lodsys Group respectfully request that this Court dismiss Wolfram's First, Second, Fourth, Fifth, Sixth, and Eighth Claims for Relief under FRCP 12(b)(1) for lack of subject matter jurisdiction.

² Incidentally, Wolfram's contention that Lodsys and Lodsys Group have filed numerous recent lawsuits against other parties involving the '834 patent is flatly wrong. Opposition at 6. In fact, neither Lodsys nor Lodsys Group has filed any lawsuits to enforce the '834 patent, as Wolfram's table at pages 2 and 3 of the Opposition confirms.

Dated this 30th day of May, 2012.

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