

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY**

GARFUM.COM CORPORATION
Plaintiff,

v.

REFLECTIONS BY RUTH D/B/A
BYTEPHOTO.COM,

Defendant.

Case No. 1:14-cv-05919-JBS/KMW

**DEFENDANT'S BRIEF IN
OPPOSITION TO PLAINTIFF'S
MOTION TO RECONSIDER**

MOTION DAY: May 16, 2016

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TABLE OF CONTENTS

I. INTRODUCTION 1

II. FACTUAL BACKGROUND..... 2

 A. The Court Has Already Considered the Relevant Arguments For and Against Awarding Fees, Including Plaintiff’s Appeal to the ’615 Application. 2

 B. The Owner of the ’615 Application Disclaimed the Relevance of the Section 101 Briefing in this Case and the USPTO Never Discussed It. ... 6

 C. Plaintiff’s Belated Appeal to Its Own Counsel’s Ignorance Does Not Match the Timeline of Events. 7

III. ARGUMENT 8

 A. The Court Correctly Found That the USPTO’s Implicit Decision in a Separate Application Does Not Excuse Plaintiff’s Litigation Conduct. ... 9

 B. Plaintiff’s Remaining Arguments Are Untimely and Provide No Basis For Disturbing the Court’s Award of Fees..... 11

 1. The February 2014 Letter Could Have Been Raised Previously, Is Irrelevant, and Was Likely Never Sent. 12

 2. Plaintiff Cannot Excuse Its Inaccurate Expert Declaration By Claiming That It Had Alternative Legal Arguments. 14

 3. Plaintiff’s Counsel’s Ignorance of the Law Does Not Excuse Its Conduct but Instead Provides an Additional Basis For Awarding Fees..... 14

 C. The Court Should Award Defendant Its Fees For Opposing This Motion for Reconsideration. 17

IV. CONCLUSION..... 18

TABLE OF AUTHORITIES

Cases

Ameranth, Inc. v. Genesis Gaming Solutions, Inc.,
 No. SACV 11-00189 AG, 2014 WL 7012391 (C.D. Cal. Nov. 12, 2014) 4, 10

Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer. Inc.,
 326 F.3d 1226 (Fed. Cir. 2003)..... 9

Connolly v. Mitsui O.S.K. Lines (Am.) Inc.,
 No. CIVA 04-5127 (JLL), 2010 WL 715775 (D.N.J. Mar. 1, 2010)..... 8

CyberSource Corp. v. Retail Decisions, Inc.,
 654 F. 3d 1366 (Fed. Cir. 2011)..... 4, 11

D&D Assocs., Inc. v. Bd. of Educ. of N. Plainfield,
 No. CV 03-1026 (MLC), 2015 WL 8582984 (D.N.J. Dec. 10, 2015) 17

Ethicon, Inc. v. Quigg,
 849 F.2d 1422 (Fed. Cir. 1988)..... 4, 10

G-69 v. Degnan,
 748 F. Supp. 274 (D.N.J. 1990) 9

In re Chevron Corp.,
 650 F.3d 276 (3d Cir. May 25, 2011)..... 15

Lugus IP, LLC v. Volvo Car Corp.,
 No. CIV.A. 12-2906 JEI/JS, 2015 WL 1399175 (D.N.J. Mar. 26, 2015)..... 17

Merck & Co., Inc. v. Kessler,
 80 F.3d 1543 (Fed. Cir. 1996)..... 5

Octane Fitness, LLC v. ICON Health & Fitness, Inc.,
 134 S. Ct. 1749 (2014) 5

Sciele Pharma Inc. v. Lupin Ltd.,
 684 F.3d 1253 (Fed. Cir. 2012)..... 10, 11

Super Sack Mfg. Corp. v. Chase Packaging Corp.,
 57 F.3d 1054 (Fed. Cir. 1995)..... 16

Sussman v. Capital One, N.A.,
 No. CIV.A. 13-6483 FLW, 2015 WL 164095 (D.N.J. Jan. 13, 2015)..... 9, 12

Statutes

35 U.S.C. § 285..... 2

Federal Regulations

37 C.F.R. § 1.56..... 9

Other Authorities

Bruce M. Wexler, Jason T Christiansen, Simon F. Kung, Paul Hastings Client
Alert, *Supreme Court’s Dismissal of Invalidity Counterclaim Based on Covenant
Not to Sue Raises New Potential Avenues for Argument in Hatch-Waxman Act
Cases* (2013)..... 16

Fenwick & West LLP, Patent Law Year In Review (2008) 16

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McDermott, Will & Emery, IP Update, Volume 8, No. 7 (July 2005) 16

Defendant Reflections by Ruth submits this brief in opposition to Plaintiff Garfum.com Corporation's motion for reconsideration.

I. INTRODUCTION

Plaintiff's motion for reconsideration provides no grounds for disturbing the Court's award of attorneys' fees. To the contrary, the motion provides this Court with additional grounds for finding the case exceptional and awarding fees. Plaintiff's motion should be rejected for at least three reasons.

First, the Court has already considered, and rejected, Plaintiff's argument that events at the United States Patent and Trademark Office (USPTO) excuse its conduct in this litigation. Plaintiff already argued that, since the USPTO had found similar claims patentable, its arguments for validity were reasonable. The Court correctly held that implicit decisions from the USPTO in an *ex parte* proceeding do not excuse Plaintiff from its duty to present tenable arguments and declarations. Plaintiff provides no reason to alter this holding. Furthermore, the Court's fee award was based on multiple factors, such as the timing of Plaintiff's dismissal of its claims, which are entirely independent of events at the USPTO.

Second, all of Plaintiff's remaining arguments are points that should have been raised in its original opposition brief. For example, Plaintiff points to emails that, if they are accepted as genuine, existed well before that opposition was filed. Plaintiff provides no grounds explaining its delay in raising this evidence. These arguments are untimely and must be rejected.

Third, Plaintiff's motion provides new grounds for finding the case exceptional. Plaintiff belatedly offers the extraordinary admission that its conduct in this case was founded on its counsel's ignorance of the law. Far from *excusing* Plaintiff's litigation strategy, this admission provides the Court with an alternative basis for awarding fees. Fee awards exist precisely to deter parties from litigating in a wasteful and incompetent manner.

The Court should deny the motion to reconsider and further order that Defendant is entitled to its fees for preparing this opposition brief.

II. FACTUAL BACKGROUND

A. The Court Has Already Considered the Relevant Arguments For and Against Awarding Fees, Including Plaintiff's Appeal to the '615 Application.

Exactly one day after this Court noticed a hearing on Defendant's fully briefed motion to dismiss, Plaintiff moved to dismiss its complaint with prejudice. *See* Text Order Setting Hearing, May 19, 2015 (Doc. 42); Motion to Dismiss Complaint and Counterclaims, May 20, 2015 (Doc. 43). Defendant informed the Court that, as Plaintiff's covenant not to sue had deprived the Court of jurisdiction over the counterclaims, it would not oppose Plaintiff's motion for dismissal of Defendant's counterclaims. *See* Order, May 21, 2015 (Doc. 45). The Court then granted Plaintiff's motion and dismissed the complaint with prejudice. *Id.*

As the prevailing party, Defendant filed a motion for an award of attorneys' fees under 35 U.S.C. § 285. In support of its motion, Defendant raised several independent arguments. *See generally* Brief in Support of Defendant's Motion for

Attorneys Fees, June 22, 2015 (Doc. 46-6) (hereafter “Def.’s Fee Brief”). Defendant argued that Plaintiff’s case was, from the outset, intended to use the cost of defense as leverage to secure an undeserved settlement. *See id.* at 16-18. Defendant argued that Plaintiff’s monetary demands bore no relation to Defendant’s tiny revenue as a hobby website. *See id.* Defendant argued that Plaintiff had presented implausible arguments in support of the validity of its patent. *See id.* at 11-13. Defendant argued that Plaintiff had submitted an expert declaration with statements expressly contradicted by the text of its own patent. *See id.* at 13-16. Specifically, Plaintiff’s counsel and its expert contended that the invention could not be implemented with a “conventional” database even though the patent contradicts this twice. *Id.* Defendant also argued that Plaintiff had dismissed its claims to avoid a ruling on the merits. *See id.* at 18.

Plaintiff had a full opportunity to respond to these arguments. *See* Plaintiff’s Opposition to Defendant’s Motion for Fees, July 27, 2015 (Doc. 52) (hereafter “Plaintiff’s Fee Opp.”). As to the soundness of its arguments for validity, Plaintiff relied on its original opposition brief regarding Defendant’s motion to dismiss. *See id.* at 8 (incorporating the prior filing by reference). Plaintiff did not address the fact that its expert declaration contradicted the text of its own patent. Indeed, its opposition brief did not even mention its expert declaration, let alone provide a defense of it. With respect to the timing of its dismissal, Plaintiff argued simply that it had “run out of options.” *Id.* at 5. Plaintiff also argued, albeit contrary to directly controlling Federal Circuit law, that Defendant was not the prevailing party. *See id.* at 11-12.

Most relevant for this motion to reconsider, Plaintiff relied heavily on a continuation application—U.S. Patent Application No. 13/531,615 (the “’615 Application”)—that was then pending from U.S. Patent No. 8,209,618 (the “’618 Patent”). *See id.* at 1, 9-10. Plaintiff argued that the USPTO had found the claims of the ’615 Application patentable even though the claims were “nearly identical to those of the ’618 Patent” and even though the examiner was “mandated to apply the same *Alice* standard as the District Court.” *Id.* at 1. Plaintiff provided a detailed claim chart illustrating the similarity of the claims. *See id.* at 10. Plaintiff concluded that if the USPTO “could find that nearly identical claims are patent eligible under the very same patent eligibility test that this Court would apply, it is reasonable to conclude the ’618 Patent is valid.” *Id.* at 11.

Defendant’s reply brief directly addressed Plaintiff’s argument regarding the ’615 Application. Defendant wrote:

The details of a pending, ex parte proceeding in a different forum with different procedures and standards are of little significance. *See Ameranth, Inc. v. Genesis Gaming Solutions, Inc.*, No. SACV 11-00189 AG, 2014 WL 7012391, at *8 (C.D. Cal. Nov. 12, 2014) (“the back-and-forth at the USPTO on a related but unissued patent is of very limited relevance”); *see also Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1428 (Fed. Cir. 1988) (“The two forums take different approaches in determining invalidity and on the same evidence could quite correctly come to different conclusions.”). This is especially true where the USPTO did not even discuss the issues before the Court in this case. Even if the Office had issued a reasoned decision regarding the eligibility of the claims in this case, that would be a question of law entitled to no deference. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1369 (Fed Cir. 2011) (patent eligibility is a question of law); *Merck & Co., Inc. v. Kessler*, 80 F.3d

1543, 1549-50 (Fed. Cir. 1996) (courts give no deference to the USPTO on questions of law).

Reply Brief in Support of Defendant's Motion for Attorneys' Fees at 12-13, August 3, 2015 (Doc. 53).

Having considered all of this briefing, the Court found that Defendant was entitled to a partial award of fees. *See* Opinion, March 30, 2016 (Doc. 56) (hereafter "Fee Op."). The Court accepted some, but not all, of Defendant's arguments. The Court held that while Plaintiff's case might not have been unreasonable from the outset, it was unreasonable at least from the time Plaintiff filed its opposition to the motion to dismiss. *See id.* at 28.

The Court noted that, under *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749 (2014), it could consider both the merits of Plaintiff's case and its litigation conduct. *See* Fee Op. at 12. Weighting the totality of circumstances, the Court found that a number of factors supported its partial award of fees. These included:

- "Plaintiff made untenable arguments *directly contrary to the plain text of the specification.*" *Id.* at 25 (emphasis added).
- "Plaintiff's expert declaration was entirely conclusory and unsupported." *Id.* at 26.
- Plaintiff's "claim that it had no other option but to provide a covenant not to sue to avoid the attendant consequences of bringing a lawsuit is at odds with the fact that Plaintiff is the one who filed suit." *Id.* at 24.
- "Plaintiff's suit was dismissed to avoid a decision on the merits." *Id.* at 27.

The Court expressly considered and rejected Plaintiff's argument regarding the '615 Application. The Court wrote:

The notice from the PTO also cannot provide cover to Plaintiff's positions taken in litigation. The notice of allowance was transmitted on June 19, 2015. (See Office Action at cover.) This was well after the commencement of litigation and the briefing of the original motion to dismiss. While it may be evidence that reasonable minds could differ, without any mention of 35 U.S.C. § 101 in the notice of allowance, this Court cannot draw such a conclusion.

Id. at 26.

Having determined that Plaintiff litigated the case unreasonably at least from the time of its opposition to Defendant's motion to dismiss, the Court awarded Defendant fees for time expended on or after April 6, 2015. *Id.* at 37. Since the fee motion was not entirely successful, the Court awarded Defendant half of its fees for time expended working on the fee motion itself. *Id.* at 38.

B. The Owner of the '615 Application Disclaimed the Relevance of the Section 101 Briefing in this Case and the USPTO Never Discussed It.

On January 18, 2016, while Defendant's motion for fees was fully briefed and pending a decision, Plaintiff Garfum.com Corporation assigned the '618 Patent and the '615 Application to a different corporation, Mindtrig.com Limited Liability Company ("Mindtrig"). See Certification of Daniel Nazer in Support of Defendant's Opposition to Plaintiff's Motion to Reconsider at ¶¶ 4-5, Exs. B-C (hereafter "Nazer Dec."). Both Plaintiff and Mindtrig are controlled by Michael Garofalo. See Nazer Dec. at ¶¶ 6-7, Exs. D-E. Plaintiff did not inform Defendant or this Court that it had assigned the patent-in-suit to a different corporation. Moreover, Plaintiff's counsel's sworn declaration incorrectly attributes numerous actions from after January 18, 2016 to "Garfum" or "Plaintiff" when these actions

were actually taken by Mindtrig as the new owner of the '615 Application. *See, e.g.,* Amended Declaration of Austin Hansley in Support of Plaintiff's Motion for Reconsideration at ¶¶ 7, 9 (Doc. 62) (hereafter "Am. Hansley Dec.").

On February 10, 2016, Mindtrig filed an information disclosure statement with the USPTO and submitted some of the briefing from this case. *See* Am. Hansley Dec., Ex. F.¹ Notably, Mindtrig submitted the litigation briefing with the following statement: "Submission of the present Information Disclosure Statement *should not be taken as an admission* that the cited reference(s) is/are legally available prior art or that the same *is/are pertinent or material.*" Am. Hansley Dec., Ex. F (Doc. 62, p. 64) (emphasis added). At no point anywhere in the history of the '615 Application did the examiner discuss this briefing, Section 101, or the *Alice* standard. *See generally* Am. Hansley Dec., Exs. B-G.

C. Plaintiff's Belated Appeal to Its Own Counsel's Ignorance Does Not Match the Timeline of Events.

In its original opposition to Defendant's motion for fees, Plaintiff attempted to explain the timing of its dismissal with prejudice by arguing that it had "run out of options." Plaintiff's Fee Opp. at 5. Its counsel has now submitted a declaration stating that: "On April 10, 2015, for the first time, I became aware of case law

¹ Plaintiff claims that it submitted "all of the § 101 briefs filed in this case." *See* Motion to Reconsider Br. at 1. That is not accurate, however. Mindtrig did not submit Plaintiff's own opposition to Defendant's motion to dismiss nor its expert declaration. *See* Am. Hansley Dec., Ex. F (Doc. 62, p. 61) (listing documents submitted).

supporting dismissing a case through a unilateral covenant not to sue and subsequent filing of a motion to dismiss the counterclaims of a defendant in order to bring an end to the subject litigation.” Am. Hansley Dec. at ¶ 13. Counsel attached an exhibit with an excerpt of an internal firm email in support of this claim. *Id.* Ex. H. Plaintiff’s counsel also affirms that: “On April 10, 2015, Plaintiff unilaterally signed and returned to our Firm a covenant not to sue Defendant thereby causing Defendant’s counterclaims to lack standing making them moot.” *Id.* at ¶ 14.

Plaintiff suggests that its counsel’s discovery about the law explains why it filed its motion to dismiss when it did. But it did not dismiss its claims at that time. Instead, it waited until **forty days later**. *See* Motion to Dismiss, May 20, 2015 (Doc. 43). In the meantime, Defendant was required to file its reply brief in support of its motion to dismiss. Plaintiff’s motion to dismiss was supported by a short, three-page memorandum of law (Doc. 43-1) and attached a covenant not to sue (Doc. 43-2). Although Plaintiff’s counsel affirms that his client signed a covenant not to sue on April 10, 2015, the covenant actually provided to Defendant and filed with this Court is dated May 19, 2016 (*see* Doc. 43-2) which is the day that this Court noticed the hearing on Defendant’s motion to dismiss.

III. ARGUMENT

Reconsideration is an extraordinary remedy and should be granted “very sparingly.” *See Connolly v. Mitsui O.S.K. Lines (Am.) Inc.*, No. CIVA 04-5127 (JLL), 2010 WL 715775, at *1 (D.N.J. Mar. 1, 2010). A motion to reconsider

should be granted only if “the matters or decisions overlooked, if considered by the court, might reasonably have altered the result reached.” *See G-69 v. Degnan*, 748 F. Supp. 274, 275 (D.N.J. 1990) (internal quotation marks and citation omitted). Motions for reconsideration may not be used simply to relitigate old matters or argue new matters that could have been raised before the original decision was reached. *See Sussman v. Capital One, N.A.*, No. CIV.A. 13-6483 FLW, 2015 WL 164095, at *2 (D.N.J. Jan. 13, 2015).

A. The Court Correctly Found That the USPTO’s Implicit Decision in a Separate Application Does Not Excuse Plaintiff’s Litigation Conduct.

At best, Plaintiff’s latest argument concerning the ’615 Application is an addendum to the argument already rejected by this Court. All that has changed is that Mindtrig submitted some of the Section 101 briefing from this case to the USPTO.² Despite Plaintiff’s current claim that this material is highly relevant to the validity of the claims in the ’615 Application, Mindtrig expressly disclaimed its importance when it was submitted to the USPTO. Unsurprisingly, then, the

² Notably, Mindtrig and its patent counsel did *not* submit this Court’s ruling of March 30, 2016 to the USPTO in the ’615 Application even though the patent was not scheduled to issue until April 26, 2016. The duty of candor to the USPTO requires that “each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith” including a “duty to disclose . . . all information known to that individual to be material to patentability.” 37 C.F.R. § 1.56(a). This duty extends to “any information that a reasonable examiner would substantially likely consider important.” *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, 326 F.3d 1226, 1234 (Fed. Cir. 2003).

examiner did not discuss or comment on it at all. Thus, once again, Plaintiff appeals to the *implicit* ruling of the examiner. As before, it points to the similarity of the claims and to general USPTO guidance. *Compare* Plaintiff's Fee Opp. at 9-11 *with* Memorandum in Support of Plaintiff's Motion for Reconsideration at 9-14 (Doc. 60-1) (hereafter "Mot. for Reconsideration Br."). The Court's prior holding applies directly to both arguments. *See* Fee Op. at 26 (noting that the while the USPTO's actions "may be evidence that reasonable minds could differ, without any mention of 35 U.S.C. § 101 in the notice of allowance, this Court cannot draw such a conclusion.").

The law fully supports the Court's ruling. As Defendant explained in its original reply brief, the details of an *ex parte* proceeding in a different forum with different procedures and standards is of very little relevance. *See Ethicon*, 849 F.2d at 1428-1429; *Ameranth*, 2014 WL 7012391, at *8. This is especially true when the USPTO did not even discuss the issues before this Court.

Plaintiff offers no authority challenging this principle. Instead, it cites *Sciele Pharma Inc. v. Lupin Ltd.*, 684 F.3d 1253, 1258 (Fed. Cir. 2012),³ for the proposition that, "because the prior art references were previously before the PTO," there is an "added burden of overcoming the deference" due to the agency. *See* Mot. for Reconsideration Br. at 15 (quoting 684 F.3d at 1258). But Plaintiff quotes text where the Federal Circuit was discussing the holding of the district

³ Plaintiff incorrectly cites this case as "*Lupin Ltd. v. Mylan Inc.*" Mylan Inc. was Lupin's co-defendant in that case, not its opponent.

court. The appeals court *expressly rejected* this principle later in the same opinion. *See* 684 F.3d at 1259-60. The Federal Circuit held that the district court was “wrong” on the question of burden and that “there is no heightened or added burden that applies to invalidity defenses that are based upon references that were before the Patent Office.” *Id.* at 1260.

Plaintiff’s citation to *Lupin* is misguided for an additional reason: eligibility under Section 101 is a question of law where the USPTO is entitled to no deference. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F. 3d 1366, 1369 (Fed. Cir. 2011). *Lupin* did not even discuss Section 101 or subject matter eligibility. So, in addition to badly mischaracterizing its holding, Plaintiff relies on a case considering different issues.

Further, Plaintiff’s renewed argument regarding the ’615 Application does not rebut most of the Court’s reasons for finding this case exceptional and awarding fees. It does not excuse Plaintiff’s conclusory and inaccurate expert declaration. It does not give the Court any reason to alter its finding that Plaintiff dismissed its claims to avoid a ruling on the merits. Thus, even if it were accepted, this new argument would not be sufficient for reconsidering the award of fees.

B. Plaintiff’s Remaining Arguments Are Untimely and Provide No Basis For Disturbing the Court’s Award of Fees.

In its motion for reconsideration, Plaintiff belatedly presents the following additional arguments:

- It contends that it first contacted Defendant about its patent months before filing suit. *See* Mot. for Reconsideration Br. at 2.

- It argues that “the mere fact that a conventional database may be used in implementing the invention is far from dispositive.” *See id.* 16-17.
- It contends that the timing of its dismissal is explained by the fact that its counsel did not learn about the significance of a covenant not to sue until April 10, 2015. *See id.* at 18-19.

Each of these arguments should be rejected outright for a simple reason: these points *could have been raised* in Plaintiff’s original opposition brief. *See Sussman*, 2015 WL 164095, at *2 (motion to reconsider is not an opportunity to present evidence that was previously available). Even if they were timely, these arguments have no merit. Should the court wish to consider them in detail, Defendant addresses each in turn below.

1. The February 2014 Letter Could Have Been Raised Previously, Is Irrelevant, and Was Likely Never Sent.

In its opinion, the Court stated that this lawsuit was filed without prior contact by Plaintiff to Defendant. Fee Op. at 3 (citing a declaration by Ruth Taylor). The Court made that finding based on evidence submitted with Defendant’s opening fee brief which had not been contested by Plaintiff in its opposition. The Court did not place any significant weight on this finding. Indeed, it rejected Defendant’s argument that it should be entitled to attorneys’ fees from the outset of this case. *See id.* at 28-29.

Plaintiff now contends that it sent an email and a letter by US mail to Defendant on February 18, 2014.⁴ Since this communication has purportedly been in Plaintiff's possession since that time, Plaintiff could have included this evidence with its original opposition. In any event, Defendant never received these messages. *See* Certification of Ruth Taylor in Support of Opp. at ¶¶ 3-7; Certification of Steve Taylor in Support of Opp. at ¶¶ 2-8. Indeed, Ruth and Steve Taylor still retain their Bytphoto.com email from February 2014 and can confirm that the purported email was never received. *See* Ruth Taylor Dec. at ¶¶ 4-5; Steve Taylor Dec. at ¶ 5, Ex. A. The Taylors also have no recollection of receiving a physical letter which, had it arrived, would have been highly memorable to them. *See* Ruth Taylor Dec. at ¶¶ 5-6; Steve Taylor Dec. at ¶¶ 6-7. The purported letter appears to be incomplete as it includes the Taylors' names but not their address. *See* Am. Hansley Dec., Ex. A. Considering all the evidence, it seems likely that these alleged communications were never sent. In any event, since it has no bearing on its decision, the Court should ignore Plaintiff's belated and highly questionable evidence.

⁴ Plaintiff's counsel, Austin Hansley, originally affirmed that the letter had been sent to "Defendant's Counsel" on February 18, 2014. *See* Declaration of Austin Hansley in Support of Plaintiff's Motion for Reconsideration at ¶ 3 (Doc. 60-2). Defendant's counsel wrote to Mr. Hansley explaining that, as of that date, Defendant did not have counsel. *See* Nazer Dec. at ¶ 3, Ex. A. Mr. Hansley did not respond to this communication. Rather, without providing any explanation for the Court, he submitted an amended declaration. *See* Am. Hansley Dec. at ¶ 3.

2. Plaintiff Cannot Excuse Its Inaccurate Expert Declaration By Claiming That It Had Alternative Legal Arguments.

A motion to reconsider is not the appropriate forum for merely disagreeing with the Court's original ruling. Nevertheless, Plaintiff now quibbles with the Court's discussion of validity. It argues that "the Court misunderstands Plaintiff's arguments related to the validity of the patent-in-suit" because "the mere fact that a conventional database may be used in implementing the invention is far from dispositive with respect to the § 101 analysis." Mot. to Reconsider Br. at 16. But this argument does nothing to alleviate the Court's most serious concern: that Plaintiff presented an expert declaration contradicted by the text of its own patent. *See Fee Op.* at 20-21. Plaintiff has now had multiple opportunities to defend its expert declaration. It has offered no defense whatsoever. Instead, it merely suggests it had other arguments. Even if accepted, the fact that Plaintiff had other arguments does not excuse its decision to submit a "conclusory and unsupported" expert declaration. *See Fee Op.* at 26.

3. Plaintiff's Counsel's Ignorance of the Law Does Not Excuse Its Conduct but Instead Provides an Additional Basis For Awarding Fees.

Plaintiff has made a selective waiver of privilege to assert that its counsel did not learn about the significance of a covenant not to sue until April 10, 2015.⁵

⁵ Should the Court be inclined to reconsider its ruling on fees based on Plaintiff's waiver of privilege, Defendant respectfully requests that the Court allow discovery into all of Plaintiff's communications regarding its decision to dismiss its complaint. This should include all related emails and a deposition of Mr. Hansley.

For the reasons given in Part II.C. *supra*, even if this is accepted as true, it does not explain the timing of Plaintiff's dismissal, which occurred 40 days later. The timeline fully supports the Court's conclusion that Plaintiff dismissed its claims to avoid a ruling on the merits.

Plaintiff's counsel's purported discovery also occurred *before* Defendant filed its reply brief in support of its motion to dismiss (counsel's internal email is dated April 10, 2015 and Defendant's reply brief was due and filed on April 13, 2015). *Compare* Am. Hansley Dec., Ex. H *with* Reply Brief in Support of Defendant's Motion to Dismiss, April 13, 2015 (Doc. 41). Rather than inform Defendant that it intended to dismiss its claims with prejudice, Plaintiff simply waited for Defendant to file its reply brief. Indeed, Plaintiff's counsel claims that his client had signed a covenant not to sue on April 10, 2015 (although this does not match the date on the covenant actually submitted to the Court). *Compare* Am. Hansley Dec. at ¶ 14 *with* Patterson Dec., Ex. A (Doc. 43-2). Plaintiff provides no excuse as to why it did not immediately inform Defendant and this Court about its decision.

It is well-settled that a party cannot make a selective waiver of privilege of only those privileged documents that it believes will help its case. *See In re Chevron Corp.*, 650 F.3d 276, 287 (3d Cir. May 25, 2011) (allowing a party to waive privilege for "favorable documents and information . . . then shield related documents behind the screen of privilege would be to permit the use of privilege and the work product doctrine as both sword and shield, an abuse that courts have discouraged").

Even if it did provide a plausible explanation for the timeline of this case, Plaintiff's counsel's ignorance of the law is simply no excuse. The law firm of Austin Hansley PLLC filed more than 400 patent lawsuits in 2015.⁶ The principle of law that Mr. Hansley "discovered" in April 2015 has been well-established and well-known to patent litigators since at least 1995 when the Federal Circuit decided *Super Sack Mfg. Corp. v. Chase Packaging Corp.*, 57 F.3d 1054 (Fed. Cir. 1995).⁷ Even under the much stricter standard for imposing Rule 11 sanctions, ignorance of the law does not provide an attorney with an excuse. *See, e.g., D&D Assocs., Inc. v. Bd. of Educ. of N. Plainfield*, No. CV 03-1026 (MLC), 2015 WL

⁶ This information is available at <https://search.rpxcorp.com> by searching for Austin Hansley PLLC and setting date range of suits filed from January 1, 2015 to December 31, 2015.

⁷ *See, e.g.,* Bruce M. Wexler, Jason T Christiansen, Simon F. Kung, Paul Hastings Client Alert, *Supreme Court's Dismissal of Invalidity Counterclaim Based on Covenant Not to Sue Raises New Potential Avenues for Argument in Hatch-Waxman Act Cases* (2013) (noting the "longstanding general approach that a covenant not to sue or a promise not to assert a patent against an alleged infringer renders a patent invalidity counterclaim moot" and citing *Super Sack*), at <http://www.paulhastings.com/publications-items/details?id=fb17de69-2334-6428-811c-ff00004cbded>; Fenwick & West LLP, *Patent Law Year In Review* (2008) ("Federal Circuit again addresses jurisdiction over declaratory judgment claims and confirms that patentee may still escape declaratory claims by dismissing its claims and granting a covenant not to sue," citing *Super Sack*), at https://www.fenwick.com/FenwickDocuments/Patent_Law_2008.pdf; Frommer Lawrence & Haug LLP, *Explore Our Insights, Covenant Not to Sue* ("Patentees frequently issue covenants not to sue when, after the patentee sues for infringement, a defendant moves to invalidate the allegedly infringed patent. In these situations, where the risk of patent invalidity is high, the covenants are offered to avoid the risk of the patent being invalidated.") <http://www.flhlaw.com/Covenant-Not-to-Sue/>; McDermott, Will & Emery, *IP Update*, Volume 8, No. 7 (July 2005).

8582984, at *26 (D.N.J. Dec. 10, 2015) . Sanctions and fee awards exist precisely to deter attorneys from litigating in a wasteful and incompetent manner. Plaintiff’s belated attempt to rely on counsel’s ignorance must be rejected.

C. The Court Should Award Defendant Its Fees For Opposing This Motion for Reconsideration.

Generally, a party entitled to attorneys’ fees is entitled to fees for time expended litigating the fee motion itself. *See* Fee Op. at 29; *Lugus IP, LLC v. Volvo Car Corp.*, No. CIV.A. 12-2906 JEI/JS, 2015 WL 1399175, at *6, n.5 (D.N.J. Mar. 26, 2015) (noting that a “party seeking attorneys’ fees pursuant to 35 U.S.C. § 285 may seek fees for the fee petition itself.”). For the same reasons, the Court should award fees for this opposition brief. While the Court awarded Defendant half of its fees for its work on its original fee petition (reflecting its partial success), the Court should award full fees for this opposition. For all the reasons provided above, Plaintiff’s motion to reconsider raises numerous untimely arguments and unsupported legal contentions. Plaintiff has wasted yet more of this Court’s time and Defendant’s resources. A further fee award is appropriate.

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IV. CONCLUSION

For the foregoing reasons, Defendant respectfully requests the Court deny Plaintiff's motion for reconsideration and award Defendant its attorneys' fees for preparing this opposition brief.

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By: /s/ Frank L. Corrado

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