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8 **UNITED STATES DISTRICT COURT**
 9 **SOUTHERN DISTRICT OF CALIFORNIA**

11 IN RE: AMERANTH PATENT
 12 LITIGATION

Lead Case No. 11cv1810 DMS (WVG)

13 **DECLARATION OF JOHN W.**
 14 **OSBORNE IN SUPPORT OF**
 15 **AMERANTH’S MOTION FOR**
 16 **SUMMARY ADJUDICATION OF**
 17 **UNENFORCEABILITY OF ‘449**
 18 **PATENT BASED ON INEQUITABLE**
 19 **CONDUCT IN ITS PROSECUTION;**
 20 **REQUEST FOR JUDICIAL NOTICE**

21 Date: November 3, 2017
 22 Time: 1:30 p.m.
 23 Location: Courtroom 13A
 24 Judge: Hon. Dana M. Sabraw

25 Complaint Filed: August 15, 2011

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DECLARATION OF JOHN W. OSBORNE

I, John W. Osborne, declare as follows:

1. I am an attorney licensed to practice and in good standing with the State Bar of New York, and am admitted in this matter *pro hac vice* in the United States District Court for the Southern District of California. I am also admitted to practice before the United States Patent & Trademark Office (the “PTO”). I am one of the counsel of record for Plaintiff Ameranth, Inc. (“Ameranth”), in these consolidated cases. I was also counsel of record for Ameranth in the infringement against Menusoft and Par tried in the United States District Court for the Eastern District of Texas. I am familiar with the matters filed and served by the parties in these cases. On these bases, I have first-hand personal knowledge of the facts set forth in this declaration. If called upon to testify, I would and could do so competently as set forth herein. I provided this declaration in support of Ameranth’s Motion for Summary Adjudication of ‘449 Patent for Inequitable Conduct in its Prosecution.

2. The current matter—IPDEV v. Ameranth—is a “priority of invention” dispute between IPDEV’s U.S. Patent No. 8,738,449 (the “‘449 Patent”) and Ameranth’s U.S. Patent No. 8,146,077 (the “‘077 Patent”). IPDEV has admitted that, in its application to the PTO for the ‘449 Patent, it intentionally copied the claims of Ameranth’s ‘077 Patent.

3. The ‘449 Patent claims to be a continuation of Patent Application No. 09/282,645 (the “‘645 Application”), which in turn is a continuation of U.S. Patent No. 5,991,739 (the “‘739 Patent”). The ‘449 Patent thus relies upon the same specification as the ‘739 Patent and ‘645 Application. Based on this “lineage,” IPDEV claims an effective filing date for the ‘449 Patent of November 24, 1997, the filing date of the application for the ‘739 Patent. Ameranth contests that the claims of IPDEV’s ‘449 Patent (which copy the claims of Ameranth’s

1 '077 Patent) are actually taught, disclosed by, described or enabled by the
2 specification of the '739 Patent (sometimes referred to as "Cupps").

3 4. Through the present motion, Ameranth requests that the Court
4 summarily adjudicate that IPDEV's '449 Patent is unenforceable as a result of
5 inequitable conduct and fraud on the PTO perpetrated during the prosecution of
6 the '449 Patent.

7 5. Lodged with the Court as **Exhibit 1** to the Notice of Lodgment
8 ("NOL") filed herewith is a true and correct copy of QuikOrder, Inc.'s Initial
9 Disclosure pursuant to Fed. R. Civ. P. 16(a)(1), dated March 1, 2013, served in the
10 consolidated patent infringement litigation before this Court.

11 6. Lodged with the Court as **Exhibit 2** to the NOL is a true and correct
12 copy of U.S. Patent No. 8,146,077, issued on March 27, 2012. Ameranth requests
13 that the Court take judicial notice of this document as an official record of a public
14 agency.

15 7. Lodged with the Court as **Exhibit 3** to the NOL is a true and correct
16 copy of the transcript of transcript of the deposition of David Kargman, taken on
17 July 17, 2017 in Chicago, Illinois.

18 8. Lodged with the Court as **Exhibit 4** to the NOL is a true and correct
19 copy of the Amended Petition for Covered Business Method Patent Review of
20 U.S. Patent No. 8,146,077 filed by petitioners in the U.S. Patent and Trademark
21 Office on November 8, 2013. Ameranth requests that the Court take judicial
22 notice of this document as an official record of a public agency.

23 9. Lodged with the Court as **Exhibit 5** to the NOL is a true and correct
24 copy of the Non-Institution Decision of Covered Business Method Patent Review
25 of U.S. Patent No. 8,146,077, issued by the PTAB on March 26, 2014. Ameranth
26 requests that the Court take judicial notice of this document as an official record
27 of a public agency.

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1 10. Lodged with the Court as **Exhibit 6** to the NOL is a true and correct
2 copy of the U.S. Patent No. 8,738,449, issued on May 27, 2014. Ameranth
3 requests that the Court take judicial notice of this document as an official record
4 of a public agency.

5 11. Lodged with the Court as **Exhibit 7** to the NOL is a true and correct
6 copy of an Office Action Summary from Patent Application No. 11/190,633,
7 dated January 7, 2010. Ameranth requests that the Court take judicial notice of
8 this document as an official record of a public agency.

9 12. Lodged with the Court as **Exhibit 8** to the NOL is a true and correct
10 copy of IPDEV Co.’s Preliminary Statement to the Patent and Trademark Office,
11 filed on August 22, 2012, in the application for the ‘449 Patent. Ameranth
12 requests that the Court take judicial notice of this document as an official record
13 of a public agency.

14 13. Lodged with the Court as **Exhibit 9** to the NOL is a true and correct
15 copy of the transcript of the deposition of James Kargman taken on July 17, 2017
16 in Chicago, Illinois.

17 14. Lodged with the Court as **Exhibit 10** to the NOL is a true and correct
18 copy of the transcript of the deposition of Michael O. Warnecke taken on August
19 11, 2017 in Chicago, Illinois.

20 15. Lodged with the Court as **Exhibit 11** to the NOL is a true and correct
21 copy of the Reporter’s Transcript of Proceedings of the September 12, 2013 status
22 conference before the Honorable Dana Sabraw in the consolidated patent
23 infringement litigation before this Court. Ameranth requests that the Court take
24 judicial notice of this document as an official record of the Court.

25 16. Lodged with the Court as **Exhibit 12** to the NOL is a true and correct
26 copy of the transcript of the Rule 30(b)(6) deposition of IPDEV (David Kargman)
27 taken on August 3, 2017 in Chicago, Illinois.
28

1 17. Lodged with the Court as **Exhibit 13** to the NOL is a true and correct
2 copy of the transcript of the deposition of Joseph Hamilton taken on July 27, 2017
3 in Woodland Hills, California.

4 18. Lodged with the Court as **Exhibit 14** to the NOL is a true and correct
5 copy of the transcript of the deposition of Yingli Wang taken on July 7, 2017 in
6 Woodland Hills, California.

7 19. Lodged with the Court as **Exhibit 15** to the NOL is a true and correct
8 copy of the Memorandum and Claim Construction Order issued by the Hon.
9 Charles Everingham on April 21, 2010 in Case No. 2-07-cv-271, Ameranth, Inc.
10 v. Menusoft Systems Corp., et al., in the United States District Court for the
11 Eastern District of Texas. Ameranth requests that the Court take judicial notice of
12 this document as an official court record.

13 20. Lodged with the Court as **Exhibit 16** to the NOL is a true and correct
14 copy of the Claim Construction Memorandum and Order issued by the Hon. Roy
15 Payne on August 10, 2012 in Case No. 2:10-CV-294, Ameranth, Inc. v. Par
16 Technology, Corp., et al., in the United States District Court for the Eastern
17 District of Texas. Ameranth requests that the Court take judicial notice of this
18 document as an official court record.

19 21. Lodged with the Court as **Exhibit 17** to the NOL is a true and correct
20 copy of an excerpt from the Fourth Edition of Microsoft Computer Dictionary.
21 The excerpt explains that, within the categories “portable computers,” “Laptop”
22 means a computer that “can be held on the lap,” whereas in contrast “Handheld”
23 means “can be held in one hand.”

24 22. Lodged with the Court as **Exhibit 18** to the NOL is a true and correct
25 copy of an Office Communication from the PTO in IPDEV’s ‘645 application
26 patent file dated August 28, 2012 regarding an August 20, 2012 interview between
27 the examiner and prosecuting counsel. Ameranth requests that the Court take
28 judicial notice of this document as an official court record.

