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18 Attorneys for Plaintiff and Counterclaim-
19 Defendant IPDEV Co.

20 **UNITED STATES DISTRICT COURT**
21 **SOUTHERN DISTRICT OF CALIFORNIA**

22 IPDEV CO.,
23 Plaintiff, and
24 Counterclaim-
25 Defendant

26 v.

27 AMERANTH, INC.,
28 Defendant, and
 Counterclaimant.

LEAD CASE NO. 3:11-cv-01810-DMS-WVG

CASE NO. 3:14-cv-01303-DMS-WVG

**IPDEV’S CIV LR 7.1 (f)(3)(b)
STATEMENT OF REASONS IN
OPPOSITION TO POSITIONS
TAKEN BY AMERANTH IN ITS
MOTION FOR SUMMARY
ADJUDICATION OF
UNENFORCEABILITY OF ‘449
PATENT FOR INEQUITABLE
CONDUCT IN ITS
PROSECUTION**

1 Pursuant to Civil Local Rule 7.1(f)(3)(b), Plaintiff and Counter-Defendant
2 IPDEV Co. (“IPDEV”) hereby submits the following Statement of All Reasons in
3 Opposition to the Positions Taken by Defendant and Counter-Plaintiff Ameranth,
4 Inc. (“Ameranth”) in its Motion for Summary Adjudication of Unenforceability of
5 [the] ’449 Patent For Inequitable in its Prosecution (“Motion”). For the following
6 reasons and those articulated in the accompanying Memorandum of Points and
7 Authorities, IPDEV respectfully requests the Court to deny Ameranth’s Motion.

8 1. The denial of the Petition for Covered Business Method Review
9 (“CBM”) of U.S. Patent No. 8,146,077 (“the ’077 patent”) filed by various
10 Defendants in this action was not material to the patentability of U.S. Patent No.
11 8,738,449 (“the ’449 patent”). Neither IPDEV nor any company affiliated
12 therewith was involved in any manner with this CBM and there is no evidence that
13 IPDEV was in possession of any information relating to this CBM during the
14 pendency of the ’449 patent application. Ameranth has also failed to prove that
15 IPDEV, or anyone acting on its behalf, appreciated the alleged materiality of the
16 CBM and intentionally withheld it from the United States Patent & Trademark
17 Office (“PTO”). At a minimum, genuine disputes of material fact exist precluding
18 entry of summary judgment in favor of Ameranth.

19 2. Boilerplate statements in a counterclaim alleging invalidity of the ’077
20 patent were not “but-for” material to the patentability of the ’449 patent. Similarly,
21 an allegation by QuikOrder that Ameranth committed inequitable conduct during
22 the prosecution of the ’077 patent was not “but-for” material to the patentability of
23 the ’449 patent. Moreover, Ameranth’s “willful blindness” argument fails to
24 demonstrate the requisite intent to deceive the PTO and relies on an incorrect legal
25 standard. At a minimum, genuine disputes of material fact exist precluding entry of
26 summary judgment in favor of Ameranth.

27 3. Claim constructions from the Eastern District of Texas for terms
28 recited in U.S. Patent Nos. 6,384,850 (“the ’850 patent”) and 6,871,325 (“the ’325

1 patent”) was not “but-for” material to the patentability of the ’449 patent and was
2 not intentionally withheld from the PTO. Not only are the claim constructions
3 immaterial to the patentability of the ’449 patent, Ameranth also offers no evidence
4 that IPDEV or any attorneys representing it during the prosecution of the ’449
5 patent were even aware of any rulings handed down in the Eastern District of
6 Texas, thus failing to prove the requisite intent by clear and convincing evidence.
7 At a minimum, genuine disputes of material fact exist precluding entry of summary
8 judgment in favor of Ameranth.

9 4. Ameranth asserts that IPDEV’s alleged failure to disclose that the
10 claims of the ’077 patent were allowed over the ’739 patent was intentional and
11 material. The ’077 patent was disclosed to the PTO in IPDEV’s Preliminary
12 Statement, wherein it stated “that filed claims 1-18 are copied from claims 1-18 of
13 issued U.S. Patent No. 8,146,077, issued March 27, 2012 from U.S. Application
14 No. 11/112,990 filed April 22, 2005 (“the ’077 Patent).” Additionally, the ’739
15 patent is cited on the face of the ’077 patent. In addition to lacking the requisite
16 materiality, Ameranth has also failed to establish the requisite intent by clear and
17 convincing evidence. At a minimum, genuine disputes of material fact exist
18 precluding entry of summary judgment in favor of Ameranth.

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20 Dated: October 20, 2017

/s/ Andrew C. Warnecke

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