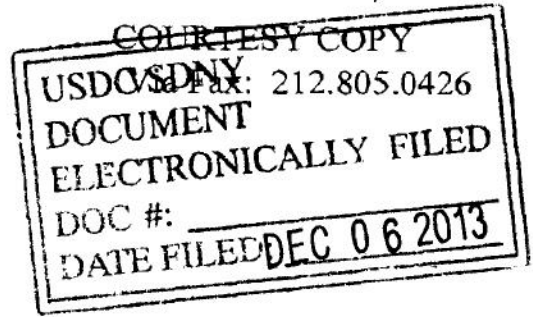


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December 4, 2013



Via Filing and Service Per ECF Procedure

Honorable Laura T. Swain
U.S. District Judge
Daniel Patrick Moynihan
United States Courthouse
500 Pearl Street
New York, New York 10007-1312

MEMO ENDORSED

Re: *Worldwide Home Products Inc. v. Time, Inc. et al.*, 1:11-cv-3633-LTS-MHD

Dear Judge Swain:

I am counsel for Defendants in the above-referenced case. We are writing to seek leave to file a sur-reply to Plaintiff's reply brief in further support of its Motion To Alter, Amend, Vacate, or Set Aside the September 30, 2013 Memorandum Opinion and Order. In the alternative, Defendants request that this Court have the present letter entered on the record and considered by the Court in ruling on the instant motion. Given the Court's grant of Plaintiff's request for additional pages and time for the filing of its reply brief, we kindly ask the Court for similar consideration in the granting of the present request.

In particular, Defendants seek leave to file this sur-reply to address key issues from which Plaintiff has tried to distract the Court. Plaintiff continues to narrowly frame the issue before the Court as though this case merely involved a failure of a patent attorney to advise the US Patent Office ("USPTO") of the existence of certain prior art when the patent attorney was not sure whether the prior art product was in fact prior art. This is a complete misrepresentation of Attorney Sonnabend's conduct in this case.

First, Attorney Sonnabend affirmatively told the patent examiner that the prior art Merrick hangers did not have abutting hooks. He obviously was not able to make that determination from the thumbnail photographs on the Merrick webpage, as correctly noted by the Court. He made this false representation knowing he had Merrick hangers in his possession that (i) he believed to be the Merrick hangers illustrated in the thumbnail photos and that (ii) established the opposite. Either that, or he had no idea what was taught in the prior art, and his representation as to his knowledge of the prior art before the USPTO was a deliberate falsehood.

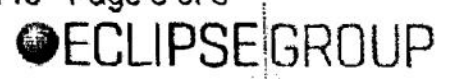
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In either event, it was his deliberate factual misrepresentations to the examiner during the prosecution of the application that constituted fraud on the patent office -- also known as inequitable conduct.

Second, his refusal to bring to the examiner's attention the photographs of the Merrick hangers provided to him by Defendants' counsel, particularly in light of his deliberate fraudulent misrepresentations to the examiner, make it abundantly clear that he was not only making willful misrepresentations, but withholding clearly material information. Plaintiff attempts to distract the Court by implying that Attorney Sonnabend had no duty to disclose the information if he did not know whether or not it was prior art. This argument is not based in law. The information only need be **material** ... the law does not require that the information be prior art. See *American Calcar*, 2012 WL 1328640 at *11 (S.D. Cal. Apr. 17, 2012) (finding intent to deceive the PTO under *Therasense* for failing to disclose operational information, including photograph of the prior art of record). Plaintiff purposely avoids addressing the materiality of the information in Plaintiff's possession and the fact that all the information in Plaintiff's possession establishes, by clear and convincing evidence, that Plaintiff's counsel (i) made false and intentional misrepresentations to the USPTO about highly relevant features of the prior art -- all while, (ii) concealing highly relevant and material information in his possession that would clarify (in a contradicting manner) the features of the prior art images in the prosecution history.

Third, it remains undisputed that the prior art Merrick Hangers depicted in the thumbnail photos have abutting hook members. Nothing in the record or in Plaintiff's arguments offers any new evidence to negate the fact that Attorney Sonnabend knew he made material misrepresentations to the USPTO about the features of the Merrick Hangers depicted in the thumbnail photos, which were clearly prior art. Attorney Sonnabend withheld the material photographs and hangers in his possession, and failed to correct the examiner's misunderstanding of the abutting features of the prior art Merrick Hangers, for the simple reason that the examiner would never have allowed the claims to issue had he been aware of the true structure of the Merrick hangers illustrated in the thumbnail photos. All the evidence clearly supports and "demonstrates unequivocally that [Sonnabend] understood that the precise features of the physical Merrick Hangers were material to the Application and that he withheld evidence from the PTO examiner as to the physical configurations of the Merrick Hanger that was depicted in the Merrick Reference." (September 30 Order at 15). This fact remains undisputed.

Hon. Laura T. Swain
12/4/2013
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Finally, and most importantly, Plaintiff's assertions were never presented by Plaintiff in opposition to Defendants' Motion for Summary Judgment. It is black-letter law that these new arguments may not be raised now, for the first time, in a motion for reconsideration. Plaintiff's request for reconsideration on these issues should be denied for this reason alone.


Respectfully submitted,

/s/ Edward F. O'Connor
THE ECLIPSE GROUP LLP

cc: V. David Rivkin
Carlton Fields, P.A.
Attorney for Plaintiff
Jeffrey Sonnabend (Via E-Mail)

The request for consideration of a surreply is denied. The motion is fully briefed.

SO ORDERED:

 12/5/13
HON. LAURA TAYLOR SWAIN
UNITED STATES DISTRICT JUDGE