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VIA ECF

Hon. Katherine B. Forrest
United States District Judge
United States Courthouse
500 Pearl Street
New York, New York 10007

Re: *JobDiva, Inc. v. Monster Worldwide Inc.*, No. 13 Civ. 8229 (S.D.N.Y.)

Dear Judge Forrest:

Plaintiff JobDiva, Inc. ("JobDiva"), pursuant to Rule 2.F of Your Honor's Individual Practices in Civil Cases, seeks resolution of a discovery dispute with Defendant Monster Worldwide, Inc. ("Monster"). **Specifically, JobDiva respectfully requests that the Court order Monster, within 7 days of JobDiva identifying its 16 asserted claims pursuant to the Court's July 22 Order (D.I. 111), to select no more than 3 references or reference combinations to assert as prior art per asserted claim, for expert discovery, summary judgment and trial. Monster also should be ordered to immediately supplement its Rule 26(a)(1) Disclosures to comply with the Federal Rules.**[1]

1. Introduction and Nature of Dispute

At Monster's request, the Court ordered JobDiva to reduce its asserted claims to 16 after a *Markman* decision, with possibly further reduction for trial. (D.I. 111.) With expert discovery imminent, Monster should now be required to limit the number of prior art references/ combinations it may assert per claim for expert discovery, summary judgment and trial.

Monster's invalidity contentions purport to assert anticipation by and/or obviousness in light of ***over 100*** references/combinations across the four patents-in-suit. (Ex. 1 at 11-141.) Monster served ***49 claim charts*** comprising ***over 3,000 pages***, relying on several anticipation

1 JobDiva believes the relief sought herein is appropriately sought in a letter motion under Rule 2.F, since it relates to Monster's contentions and disclosures, which are the subject of discovery. If the Court disagrees, JobDiva can address these issues in a formal motion.

references and ***27 to 38 reference combinations*** per claim. (*Id.*) That is in addition to various under-developed prior invention theories under 35 U.S.C. § 102(g), and invalidity theories under 35 U.S.C. §§ 101 and 112. (*Id.* at 5-11.) There is no way that Monster can present that many invalidity theories at trial. JobDiva should not be required to expend resources analyzing, taking discovery on, and responding to, invalidity theories that will not be advanced at trial.

The problem with Monster's overbroad contentions is compounded by its refusal to provide meaningful Rule 26(a)(1) Disclosures. On July 1, 2014, Monster amended its Disclosures to identify 21 entities and individuals who purportedly have "information regarding the invalidity of the JobDiva patents-in-suit." (Ex. 2.) And, although Monster has recently indicated that it will not be calling many of them at trial (Ex. 3), it has refused to identify the specific invalidity-related knowledge allegedly held by those that remain, or how it intends to rely on them. (Exs. 3-8.) Further adding to JobDiva's prejudice, Monster has not provided the information required by the Court's rules with respect to certain prior invention challenges under 35 U.S.C. § 102(g), to which at least some of the individuals and entities listed on Monster's Rule 26(a)(1) Disclosures are apparently relevant. Specifically, Monster has alleged prior invention by at least three entities, but has failed to describe the complete alleged "circumstances surrounding the making of the invention before the patent applicant(s)" by those entities, such as alleged conception and reduction to practice dates, identities of those involved in the alleged prior invention, and the alleged diligence in reduction to practice. (Ex. 1 at 19-20, 22-24.)

JobDiva has conferred with Monster, but has been unable to reach agreement regarding these issues. While Monster has indicated it is amenable to some limitation, it insists that it should be permitted 8 references/combinations per claim, and that it should not be required to make its selection until after receiving JobDiva's final infringement contentions.[2] (Ex. 9.) And, Monster has refused to provide ***any*** additional detail regarding the invalidity-related entities and individuals in its Rule 26(a)(1) Disclosures. (Ex. 3.)

2. <u>The Court Should Grant JobDiva the Requested Relief</u>

(a) Limitation of Prior Art References

As Monster itself pointed out in support of its motion to limit JobDiva's asserted claims, it is within the Court's discretion to limit the parties' claims and defenses where appropriate. *See, e.g., In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1312 (Fed. Cir. 2011). To that end, courts frequently require defendants to narrow the number of prior art

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[2] By way of compromise, JobDiva offered that Monster may limit its references/combinations to 5 per claim if Monster accepted JobDiva's proposal on timing, and agreed to discuss further limitation if and when the Court decides that JobDiva's asserted claims should be further limited from 16. (Ex. 9.) Monster refused. (*Id.*)

references relied upon as the parties approach trial. *See ActiveVideo Networks, Inc. v. Verizon Comm'cns*, No. 2:10-cv-248, 2011 WL 7036048, at *2 (E.D. Va. July 5, 2011).

Furthermore, courts have held that "[a]bsent extraordinary circumstances, a manageable number per claim is ***no more than 2-3 references***." *Gemalto S.A. v. HTC Corp.*, No. 6:10-cv-561, slip op. at 2 (E.D. Tex. Oct. 23, 2012) (Ex. 10); *see also Keranos, LLC v. Silicon Storage Tech., Inc.*, No. 2:13-cv-17, 2013 WL 5763738, at *4 (E.D. Tex. Aug. 5, 2013) ("The Court routinely limits Defendants to ***two or three prior art references . . . The Court will count a combination as a single prior art reference***."). Narrowing invalidity bases in this way serves "to reduce the overall costs of the litigation by eliminating needless discovery regarding issues that will likely be dropped prior to trial, and allow the Court to dedicate its resources to truly dispositive and meritorious issues." *Unified Messaging Solutions LLC v. Facebook, Inc.*, No. 6:11-cv-00120, 2012 WL 11606516, at *1 (E.D. Tex. July 12, 2012).

Viewed in this light, JobDiva's proposed limitation of 3 references/combinations per asserted claim is appropriately geared towards ensuring orderly and manageable expert discovery, summary judgment and trial proceedings. Monster's proposal of 8 per claim, in contrast, is excessive; it would require the parties' experts to grapple with up to ***128*** distinct references/combinations, most of which will not be relied upon by Monster at trial.

JobDiva's proposed timing for Monster's prior art election is also reasonable and appropriate. Indeed, it provides Monster with no more and no less than the amount of time that the Court provided JobDiva following the *Markman* decision to make its election of asserted claims for infringement purposes. No doubt, at this late stage, Monster has already determined which of its invalidity grounds are strongest and will be argued on summary judgment and at trial. Monster first served its initial Invalidity Contentions almost five months ago, and has had ample time to hone them to identify its best two or three arguments for each asserted claim. Monster's complaint that JobDiva's proposal would "deprive Monster of the benefit of the Court's schedule, particularly as to the deadline for Monster's final invalidity contentions" (Ex. 9) is misplaced. Depending on when the Court issues its *Markman* ruling, JobDiva may be required to narrow its claims without the benefit of Monster's final contentions.

Thus, the relief requested by JobDiva should be granted because it is reasonable and routinely granted in similar cases for case management and to avoid wasting resources, and Monster can identify no prejudice or "extraordinary circumstances" that militate against it.

(b) Updated Rule 26(a)(1) Disclosures

Monster should also be required to update its Rule 26(a)(1) Disclosures. The mere disclosure that individuals and third parties "may possess information regarding invalidity of the JobDiva patents-in-suit" (Ex. 2) fails to provide the information required by the Federal Rules,

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and prejudices JobDiva in its ability to take meaningful discovery, and prepare for trial. *See Sender v. Mann*, 225 F.R.D. 645, 650-651 (D. Colo. 2004) ("Initial disclosures should provide the parties 'with information essential to the proper litigation of all relevant facts, to eliminat[e] surprise, and to promot[e] settlement,' and a "party cannot defeat the purposes of Rule 26(a)(1) simply by providing a laundry list of undifferentiated witnesses"); *see also LT Game Intern. Ltd. v. Shuffle Master, Inc.*, No. 2:12–cv–01216–GMN, 2013 WL 321659, at *4 (D. Nev. Jan. 28, 2013) ("[The Rule 26(a)(1)] inquiry includes discovering the substance of the information the witness possesses and disclosing that information to the other party if the disclosing party intends to use it"); *Lipari v. U.S. Bancorp, N.A.*, No. 07–2146–CM–DJW, 2008 WL 2874373, at *2 (D. Kan. July 22, 2008) ("the Rule 26(a)(1)(A) disclosure should provide enough information that would allow the opposing party to help focus the discovery that is needed and to determine whether a deposition of a particular person identified as a potential witness might be necessary."); *Hertz v. Luzenac Am., Inc.*, No. 04–cv–1961–LTB–CBS, 2006 WL 994431, at *7 (D. Colo. Apr. 13, 2006) ("[D]isclosures should provide the opposing party with enough useful information to make informed decisions regarding discovery and trial preparation"). Monster should therefore be required to provide meaningful Rule 26(a)(1) Disclosures that identify the individuals and entities that Monster ***will actually rely upon*** for invalidity purposes, and describe the way in which Monster intends to rely on them, immediately.

Sincerely,

/s/ Benjamin A. Lasky

Benjamin A. Lasky

Enclosures
cc: Counsel of record

Ordered
motion denied with leave to renew. The parties shall meet and confer within 48 hours. A renewed motion may be brought on 9/8/14 if the meet and confer is unsuccessful. Monster may then have to 9/15 to oppose.

/s/ K. B. Forrest
USDJ

9/3/14