

1 FINNEGAN, HENDERSON, FARABOW,  
2 GARRETT & DUNNER, LLP  
3 3300 Hillview Avenue  
4 Palo Alto, California 94304  
5 Telephone: (650) 849-6600  
6 Facsimile: (650) 849-6666  
7 Erik R. Puknys (Bar No. 190926)  
8 erik.puknys@finnegan.com  
9 Lily Lim (Bar No. 214536)  
10 lily.lim@finnegan.com

11 FINNEGAN, HENDERSON, FARABOW,  
12 GARRETT & DUNNER, LLP  
13 901 New York Avenue, NW  
14 Washington, DC 20001  
15 Telephone: (202) 408-4000  
16 Facsimile: (202) 408-4400  
17 Gerald F. Ivey, *pro hac vice*  
18 gerald.ivey@finnegan.com  
19 E. Robert Yoches, *pro hac vice*  
20 bob.yoches@finnegan.com  
21 Douglas A. Rettew, *pro hac vice*  
22 doug.rettew@finnegan.com  
23 Joseph E. Palys, *pro hac vice*  
24 joe.palys@finnegan.com  
25 Anna Balishina Naydonov, *pro hac vice*  
26 anna.balishina@finnegan.com

27 Attorneys for Defendants  
28 ABBYY USA Software House, Inc., ABBYY  
Software, Ltd., ABBYY Production LLC, and  
Lexmark International, Inc.

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

NUANCE COMMUNICATIONS INC.,

Plaintiff,

v.

ABBYY USA SOFTWARE HOUSE, INC., a  
California corporation, ABBYY SOFTWARE,  
LTD., a Cyprus corporation, ABBYY  
PRODUCTION LLC, a Russia corporation, and  
LEXMARK INTERNATIONAL, INC., a  
Delaware corporation,

Defendants.

CASE NO. CV 08-02912-JSW (MEJ)

**DEFENDANTS' NOTICE OF  
CONDITIONAL CROSS-APPEAL**

Judge: Hon. Jeffrey S. White

1 On August 26, 2013, following the trial of this case, this Court entered a Final Judgment in  
2 favor of Defendants, ABBYY USA Software House, Inc., ABBYY Software, Ltd., ABBYY  
3 Production LLC, and Lexmark International, Inc., based on the jury's verdict that Defendants did not  
4 infringe any of the claims Nuance asserted against them (i.e., claims 4, 6, 13, 14, and 18 of U.S.  
5 Patent No. 6,038,342; claim 7 of U.S. Patent No. 5,381,489; and claim 62 of U.S. Patent No.  
6 6,742,161). Prior to trial, Defendants chose not to try their invalidity defenses to the asserted claims.  
7 Defendants' decision was based on the Court's claim constructions and the manner in which Nuance  
8 asserted that the claims applied to the accused products identified in Nuance's Infringement  
9 Contentions and the September 28, 2012 expert report of Nuance's liability expert, Dr. Daniel  
10 Lopresti. As things now stand, Defendants are the prevailing party in this Court.

11 Nonetheless, this situation may change if, in Nuance's appeal from this Court's Final  
12 Judgment, the Federal Circuit reverses or vacates this Court's judgment of noninfringement. For  
13 example, if, in the course of reversing or vacating the judgment of noninfringement, the Federal  
14 Circuit modifies this Court's claim construction or permits Nuance to assert a new infringement  
15 theory, the modified claim construction or new infringement theory may raise new invalidity  
16 defenses. *See, e.g., Lazare Kaplan Int'l v. Photoscribe Techs., Inc.*, 714 F.3d 1289, 1297 (Fed. Cir.  
17 2013) (stating that a conditional cross-appeal is appropriate in this situation because "a new claim  
18 construction [on appeal] potentially raises new validity issues" on remand). And in that event,  
19 Defendants should be able to ask the Federal Circuit to vacate the Final Judgment of this Court to the  
20 extent it applies to Defendants' invalidity defenses and either declare the asserted claims invalid or  
21 remand that issue to this Court so that Defendants can develop the record and, if appropriate, pursue  
22 their invalidity defenses to the asserted claims. *Id.*

23 Accordingly, notice is hereby given that Defendants conditionally cross-appeal to the United  
24 States Court of Appeals for the Federal Circuit from the Final Judgment entered by this Court on  
25 August 26, 2013 (the time for appeal from which having been automatically stayed by Plaintiff  
26 Nuance's motion for judgment as a matter of law and/or new trial, which was denied by the Court on  
27 December 10, 2013), including any judgment regarding Defendants' invalidity defenses  
28

1 encompassed within this Court's judgment of August 26, 2013, and from any and all other orders,  
2 rulings, findings, and/or conclusions of the Court adverse to Defendants on the issue of invalidity.

3 A check for \$505, representing the \$500 fee for docketing a case on appeal specified in 28  
4 U.S.C. § 1913 and the \$5 fee for filing a notice of appeal specified in 28 U.S.C. § 1917, is provided  
5 with this Notice of Conditional Cross-Appeal.

6  
7 Dated: January 22, 2014

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP

8  
9  
10 By: /s/ Erik R. Puknys  
Erik R. Puknys  
Attorneys for Defendants  
11 ABBYY USA Software House, Inc., ABBYY  
12 Software, Ltd., ABBYY Production LLC, and  
Lexmark International, Inc.  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28