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15 Attorneys for Defendants
ABBYY USA Software House, Inc., ABBYY
16 *Software, Ltd., ABBYY Production LLC, and*
Lexmark International, Inc.

17 UNITED STATES DISTRICT COURT
18 NORTHERN DISTRICT OF CALIFORNIA
19 SAN FRANCISCO DIVISION

20 NUANCE COMMUNICATIONS INC.,

21 Plaintiff,

22 v.

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

26 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, therefore, 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. Photocopy 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 encompassed within this Court's judgment of August 26, 2013, and from any and all other orders,

1 rulings, findings, and/or conclusions of the Court adverse to Defendants on the issue of invalidity,
2 including the Court's Orders dated June 4, 2014 and June 23, 2014.

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.

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7 Dated: July 9, 2014

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP

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By: /s/ Erik R. Puknys
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