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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

WILLIAM GRECIA,

Plaintiff,

v.

APPLE INC., *et al.*,

Defendants

Lead Case No. C-14-0775 EMC

**CONSOLIDATED CASES**

No. C-14-0969 EMC, *Grecia v. Sony Network*

No. C-14-1220 EMC, *Grecia v. VUDU, Inc.*

**ORDER DENYING DEFENDANT  
SONY’S MOTION TO STRIKE OR TO  
COMPEL FURTHER INFRINGEMENT  
CONTENTIONS**

**(Docket No. 149)**

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Pending before the Court is Defendant Sony Network Entertainment International LLC’s (“Sony’s”) Motion to Strike Or Compel Further Infringement Contentions (“Motion”). Docket No. 149.

**I. BACKGROUND**

William Grecia (“Grecia”) has alleged that Sony infringes his patent. The patent-in-suit is U.S. Patent No. 8,533,860 (“’860 patent”), entitled “Personalized Digital Media Access System-PDMAS Part II.” The ‘860 patent teaches a method of digital rights management.<sup>1</sup> Sony previously

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<sup>1</sup> For the unfamiliar reader, the relevant factual and procedural background and legal standard are laid out in more detail in the Court’s prior order on Sony’s motion to compel infringement contentions. Docket No. 140.

1 moved to compel Grecia to amend his infringement contentions. Docket No. 121. The Court  
2 granted in part and denied in part Sony's motion to compel. Docket No. 140. In particular, the  
3 Court directed Grecia to amend his infringement contentions to show "*what* he claims is the  
4 metadata of the digital content and *how* any read or write request is made." *Id.* at 4 (emphasis in  
5 original).<sup>2</sup>

6 In the pending motion, Sony complains that Grecia's infringement contentions, as amended,  
7 are again deficient. Sony argues that Grecia's infringement contentions do not identify sufficiently  
8 *where* the metadata of the digital content is. Sony contends that the Court should either strike  
9 Grecia's amended infringement contentions as to the "metadata of the digital content" or,  
10 alternatively, compel Grecia to amend his infringement contentions to include the following  
11 statements:

12 Grecia does not contend that any metadata of the digital content is contained in  
13 the same file as the digital content itself. Grecia does not contend that SEN reads  
14 any metadata contained within digital content files. Grecia does not contend that  
15 SEN writes to any metadata within digital content files. . . . Grecia does not  
16 contend that the verification token or the identification reference is written into  
17 any metadata contained within digital content files.

18 Docket No. 149-4 at 2-3.

19 For the reasons discussed herein, the Court **DENIES** Sony's Motion. Grecia has responded  
20 to the Court's concerns in his amended infringement contentions. The amended infringement  
21 contentions identify Grecia's theory as to where and how the accused web service makes access  
22 requests, *i.e.*, read or write requests of the metadata of the digital content.<sup>3</sup> Grecia has complied with  
23 the Court's prior order. As amended, Grecia's infringement contentions meet the baseline  
24 specificity required under Rule 3-1.

25 <sup>2</sup> The following is representative claim language from Claim 1 of the '860 patent:  
26 "receiving a digital content access request from at least one communications console of the plurality  
27 of data processing devices, the access request being a read or write request of metadata of the digital  
28 content, wherein the read or write request of metadata is performed in connection with a  
combination of at least one device and the cloud system . . . ."

<sup>3</sup> In its prior order, the Court ordered Grecia to amend his contentions to show that the  
limitations are met as to all accused services / devices or to show that a particular service / device is  
representative. Sony does not raise any objection in its motion to the absence of screenshots from  
Bravia HDTV or PS3 as to certain claim limitations. The Court therefore will not address that issue  
in this order.

1 **II. DISCUSSION**

2 A. Legal Standard

3 As discussed in the Court’s prior order on Sony’s motion to compel, Patent Local Rule 3-1  
4 requires the party claiming infringement to serve a “Disclosure of Asserted Claims and Infringement  
5 Contentions.” Rule 3-1 requires, among other things, “[a] chart identifying specifically where each  
6 limitation of each asserted claim is found within each Accused Instrumentality, including for each  
7 limitation . . . the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality  
8 that performs the claimed function.” Patent L.R. 3-1(c). Rule 3-1 is a “discovery device” that  
9 streamlines discovery in patent litigation by supplanting contention interrogatories. *Bender v.*  
10 *Freescale Semiconductor, Inc.*, No. C 09-1156 PJH MEJ, 2010 WL 1689465 at \*2 (N.D. Cal. Apr.  
11 26, 2010). Under Rule 3-1, the infringement contentions must be sufficiently specific to “provide  
12 reasonable notice to the defendant why the plaintiff believes it has a reasonable chance of proving  
13 infringement.” *Shared Memory Graphics LLC v. Apple, Inc.*, 812 F. Supp. 2d 1022, 1025 (N.D. Cal.  
14 2010).<sup>4</sup>

15 As to the amended infringement contentions at issue in the instant Motion, the Court finds  
16 that Grecia has complied with the Court’s prior order. First, Grecia has defined *what* he contends  
17 the metadata of the digital content is. Grecia’s amended infringement contentions set forth that  
18 metadata means “a collection of data (such as a database on SNEI’s servers or on the user’s device)  
19 that contains information about . . . which pieces of content the user is authorized to access.”  
20 Docket No. 146-1 at 3. Grecia further defines the form of the metadata, *i.e.*, that it exists in a  
21 metadata database. Specifically, Grecia contends that Sony “writes to the metadata” under claim 1  
22 of the ‘860 patent by “updating the metadata database to reflect what the user is authorized to  
23 access.” *Id.*

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26 <sup>4</sup> In its Motion, Sony repeatedly cites a later decision in *Shared Memory* in which the  
27 magistrate judge struck portions of the infringement contentions that did not comply with a prior  
28 order to amend. *See Shared Memory Graphics LLC v. Apple Inc.*, No. C-10-02475 MMC JSC, 2011  
WL 3878388, at \*1 (N.D. Cal. Sept. 2, 2011). The Court observes that the portion of the order to  
which Sony cites was objected to by Shared Memory, and Judge Chesney granted *de novo* review.  
*Shared Memory Graphics, LLC v. Apple Inc.*, No. C 10-2475 MMC, 2011 WL 5320749, at \*4 (N.D.  
Cal. Nov. 2, 2011). It appears the case resolved before Judge Chesney ruled on her *de novo* review.

1 Second, Grecia has mapped *where* in the accused system Sony allegedly practices the  
2 infringing steps of reading from and writing into the metadata. Grecia has presented exemplar  
3 screenshots of graphical user interfaces from the PS4 device showing the metadata allegedly being  
4 written to and read from the user's device and Sony's servers. Docket No. 146-1 at 3-6. Grecia's  
5 identification of specific locations in the accused system where he alleges the steps of the patented  
6 method are practiced gives Sony sufficient notice to which Sony can respond and defend. *See*  
7 *Shared Memory Graphics*, 812 F. Supp. 2d at 1025.

8 Third, Grecia has spelled out *how* the read and write requests are made. Grecia has provided  
9 screenshots with detailed labels showing how the system prompts read or write request and showing  
10 screenshots of system confirmations that those requests were made. Docket No. 146-1 at 3-6.

11 The Court finds these amended disclosures to be adequate. The Court does not find anything  
12 in the local rules or in the case law that suggests that a plaintiff patentee bears the burden of  
13 identifying what the accused instrumentality does *not* do, as Sony requests. Moreover, Sony's  
14 proposed amendment clearly anticipates claim construction and reflects its theory of defense. It  
15 seems that Sony intends to propose a construction of the claim language that would exclude  
16 metadata in a database, per Sony's belief in the "plain language" construction of the claim language.  
17 *See* Docket No. 149 at 6. Teeing up such arguments on the merits is "precisely what [infringement  
18 contentions] are designed to accomplish." *Shared Memory Graphics*, 812 F. Supp. 2d at 1025. The  
19 infringement contentions here meet the requisite specificity under Rule 3-1, because they achieve  
20 that objective. *See id.*

21 The parties' papers and the attached meet and confer correspondence indicate that this  
22 motion practice resulted from Sony's misreading of the Court's prior order in at least two respects.

23 The Court stated in its prior order that Grecia's clarifications in his opposition to Sony's  
24 prior motion to compel did not "cure the deficiency in his infringement contentions," because the  
25 infringement contentions themselves must provide the factual basis of the alleged infringement, and  
26 not, as Sony suggests in its correspondence, because the proposed clarifications were insufficient.  
27 *See* Docket No. 140 at 4 (citing *Droplets, Inc. v. Amazon.com, Inc.*, No. C12-03733 HRL, 2013 WL  
28 1563256, at \*3 (N.D. Cal. Apr. 12, 2013)); *see also* Kolassa Decl., Ex. A at 2. As a result, the Court

1 specifically directed Grecia to “clarify the language in the infringement contentions, with ‘the type  
2 of guidance provided in [Grecia’s] Opposition.’” *Id.* Upon review of Grecia’s amended  
3 contentions, it appears that Grecia has now provided that guidance in his amendment. Grecia has  
4 defined the metadata of the digital content and has mapped how the accused instrumentalities read  
5 on the metadata claim limitations.

6 Sony’s second misunderstanding relates to the scope of the amendments contemplated by the  
7 Court’s previous order. The Court specifically anticipated modest amendments in its prior order.  
8 The Court largely overruled Sony’s objections and observed that Sony’s “arguments on the merits  
9 tend to show that Sony has begun to crystallize its defenses to Grecia’s theory of infringement[;]  
10 [t]hus, the Court views the limited amendments discussed herein as enough to allow the case to  
11 proceed.” Docket No. 140 at 5. Grecia has now made the limited amendments necessary to provide  
12 notice of his claims. Accordingly, the case should proceed.

### 13 **III. CONCLUSION**

14 For the foregoing reasons, the Court **DENIES** Sony’s Motion. The amended infringement  
15 contentions provide adequate notice of Grecia’s theory of infringement and have mapped the what,  
16 where, and how of each claim limitation. The amended infringement contentions have undoubtedly  
17 focused the parties on the critical disputed claim terms and have adequately served their intended  
18 discovery function.

19 This order disposes of Docket No. 149.

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21 IT IS SO ORDERED.

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23 Dated: January 5, 2015

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26 EDWARD M. CHEN  
27 United States District Judge  
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