

**quinn emanuel trial lawyers | new york**

51 Madison Avenue, 22nd Floor, New York, New York 10010-1601 | TEL: (212) 849-7000 FAX: (212) 849-7100

WRITER'S DIRECT DIAL NO.  
(212) 849-7145

WRITER'S INTERNET ADDRESS  
robertwilson@quinnemanuel.com

February 8, 2013

**VIA HAND DELIVERY**

Jan Horbaly  
Circuit Executive and Clerk of the Court  
United States Court of Appeals  
for the Federal Circuit  
717 Madison Place, N.W.  
Washington, DC 20005

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US COURT OF APPEALS  
FEDERAL CIRCUIT

Re: Soverain Software LLC v. Newegg Inc., No. 2011-1009

Dear Mr. Horbaly:

On February 5, 2013, Newegg wrote concerning several “clerical errors” in the opinion issued on January 22, 2013 (the “Opinion”). However, the errors that Newegg identifies with respect to claim 34 of U.S. Patent No. 5,715,314 (the “314 patent”) are substantive, not clerical. The Opinion did not make a repeated clerical error on this point, as Newegg represents, but instead analyzed the wrong claim in the ‘314 patent – *i.e.*, claim 34 instead of asserted claim 35. Moreover, in doing so, the Opinion followed Newegg’s identification of the wrong asserted claim in its briefs, a fact that Newegg omits in its letter.

As Newegg’s letter acknowledges, Soverain alleged that Newegg infringed claims 35 and 51 of the ‘314 patent. At trial, “the jury found Newegg liable for induced infringement of claims 35 and 51 of the ‘314 patent.” *Soverain Software LLC v. Newegg Inc.*, 836 F.Supp.2d 462, 468 (E.D. Tex. 2010) (emphasis added). In its briefs on appeal, however, Newegg incorrectly stated that Soverain asserted infringement under “claims 34 and 51 of the ‘314 patent,” and it quoted

**quinn emanuel urquhart & sullivan, llp**

LOS ANGELES | 865 South Figueroa Street, 10th Floor, Los Angeles, California 90017-2543 | TEL (213) 443-3000 FAX (213) 443-3100  
SAN FRANCISCO | 50 California Street, 22nd Floor, San Francisco, California 94111-4788 | TEL (415) 875-6600 FAX (415) 875-6700  
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WASHINGTON, DC | 1299 Pennsylvania Avenue NW, Suite 825, Washington, District of Columbia 20004-2400 | TEL (202) 538-8000 FAX (202) 538-8100  
LONDON | 16 Old Bailey, London EC4M 7EG, United Kingdom | TEL +44 20 7653 2000 FAX +44 20 7653 2100  
TOKYO | NBF Hibiya Building, 25F, 1-1-7, Uchisaiwai-cho, Chiyoda-ku, Tokyo 100-0011, Japan | TEL +81 3 5510 1711 FAX +81 3 5510 1712  
MANNHEIM | Mollstraße 42, 68165 Mannheim, Germany | TEL +49 621 43298 6000 FAX +49 621 43298 6100  
MOSCOW | Paveletskaya Plaza, Paveletskaya Square, 2/3, 115054 Moscow, Russia | TEL +7 499 277 1000 FAX +7 499 277 1001  
HAMBURG | An der Alster 3, 20099 Hamburg, Germany | TEL +49 40 89728 7000 FAX +49 40 89728 7100

Jan Horbaly  
February 8, 2013  
Page 2

claim 34 as representative of Sovereign's asserted "shopping cart" claims. Newegg Opening Br. 6-7, 20, 27, 31 (emphasis added); *but see id.* 41 (referencing claim 35). Sovereign correctly identified asserted claims 35 and 51 of the '314 patent in its opening appeal brief. *See* Sovereign Opp. Br. 7. The Opinion, however, quotes from claim 34, not claim 35, and analyzes whether each of the elements of claim 34 would have been obvious. *Id.*

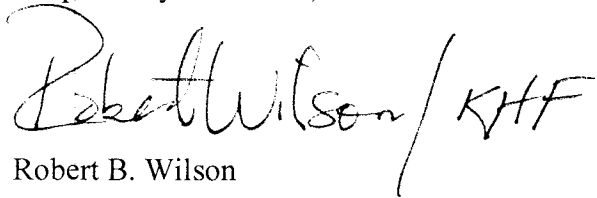
This error is material because claim 35 is narrower than claim 34. Claim 35 is dependent on claim 34 and, in addition to the elements in claim 34, requires a "payment message to be created before said buyer computer causes said payment message to be activated." A99. In a footnote in its letter, Newegg states that "Sovereign did not dispute that the single, additional limitation in claim 35 was found in the CompuServe Mall system." Sovereign by no means concedes that CompuServe satisfies this limitation. *See* Sovereign Opp. Br. 48 ("Newegg's witnesses attempted to cobble together disparate teachings from multiple references without offering any rationale why a person of ordinary skill in the art would have made its proffered combinations."); A2548:13-A2550:6.

Sovereign intends to file a petition concerning the panel's mistaken consideration of the wrong claim as well as other aspects of the Opinion. Sovereign also notes that, in sharp contrast to the Opinion, two other tribunals, based on fully developed records in proceedings that concluded after this case was argued, have found claim 35 and all the other claims at issue in this appeal non-obvious. First, the Patent and Trademark Office, in several separate reexamination proceedings completed after this case was argued, confirmed each of the claims in reexamination in the patents in suit over the prior art cited by Newegg in its appeal. *See Reexamination Control Number 90/011,937*, U.S. Patent No. 7,272,639, Certificate Issued, Feb. 1, 2013; *Reexamination Control Number 90/011,442*, U.S. Patent No. 5,909,492, Certificate Issued, Nov. 28, 2012; *Reexamination Control Number 90/011,443*, U.S. Patent No. 5,715,314, Certificate Issued, Sept. 11, 2012; and *Reexamination Control Number 90/011,444*, U.S. Patent No. 7,272,639, Certificate Issued, Oct. 4, 2011. Second, on November 18, 2011, in a case currently pending on appeal, a jury found that claims 34 and 51 of the '314 patent and claims 15, 17, and 39 of the '492 patent were not obvious. *See* Final Judgment, *Sovereign Software LLC v. Victoria's Secret Direct Brand Management*, No. 09-CV-0274, at 1 (E.D. Tex. Aug. 22, 2012) (Dkt. No. 559); Verdict Form, *Sovereign Software LLC v. Victoria's Secret Direct Brand Management*, No. 09-CV-0274, at 2 (E.D. Tex. Nov. 18, 2011) (Dkt. No. 505).

For the foregoing reasons, Sovereign respectfully requests that the Court deny Newegg's request to correct the Opinion and defer any decision until Sovereign has had an opportunity to fully brief the issues in its forthcoming petition.

Jan Horbaly  
February 8, 2013  
Page 3

Respectfully submitted,



Robert B. Wilson

cc: Kent Bauldauf, Jr., Esq. (via email)  
Claudia Wilson Frost, Esq. (via email)  
Edward R. Reines, Esq. (via email)