

No.

**United States Court of Appeals
for the Federal Circuit**

IN RE MIDWEST ATHLETICS AND SPORTS ALLIANCE LLC,
Petitioner.

*On Petition for a Writ of Mandamus to the
United States District Court for the Western District of New York
Civil Action No. 6:19-CV-06036, Judge Elizabeth A. Wolford*

PETITION FOR WRIT OF MANDAMUS

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CERTIFICATE OF INTEREST

1. The full name of every party represented by me is:
Midwest Athletics and Sports Alliance LLC
2. The name of the real party in interest represented by me is:
Midwest Athletics and Sports Alliance LLC
3. All parent corporations and any publicly held companies that own 10 percent of the stock of the party or amicus curia represented by me are listed below:
None.
4. The names of all law firms, partners and associates that have not entered an appearance in the appeal, and (a) appeared for the entity in the lower tribunal; or (b) are expected to appear for the entity in this court:
James Hannah, Eileen M. Patt, Cristina L. Martinez, and Greg Proctor of Kramer Levin Naftalis & Frankel LLP.
David Rothenberg of Rothenberg Law.
5. Other than the originating case numbers(s), the title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal:
None.
6. All information required by Fed. R. App. P. 26.1(b) and (c) in criminal cases and in bankruptcy cases.
None.

Dated: August 3, 2021

/s/ Paul J. Andre
Paul J. Andre

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I. INTRODUCTION

Petitioner Midwest Athletics and Sports Alliance LLC (“MASA”) asks that this Court intervene to prevent the district court from compelling MASA to dismiss patents from the underlying litigation using the guise of case management. Such dismissal deprives MASA of due process in asserting its patents. Indeed, the district court acknowledges that it knows of no other court that has similarly found that it has the authority to limit the number of patents that a plaintiff may assert (as opposed to the number of claims) in the context of case management. A writ is necessary to prevent the imminent injury to MASA’s patent rights when it will be compelled to dismiss all of its causes of action for patent infringement except for four of them shortly after dispositive motion practice. This is precisely the type of issue for which mandamus is appropriate, as it would serve to supervise district court litigation in an area where direction is needed, and to correct a decision that may have far-reaching implications for the hundreds of patent litigations involving multiple patents currently pending throughout the United States.

II. RELIEF SOUGHT

MASA respectfully requests a writ of mandamus directing the U.S. District Court for the Western District of New York (the “District Court”) to vacate its Order adopting the Special Master’s Patent Narrowing Recommendation, which

improperly required MASA to reduce the number of patents it asserted from twenty to eight at the dispositive motion stage and from eight to four at the trial stage.

III. ISSUES PRESENTED

Whether the District Court abused its discretion by forcing MASA, a patent-owner plaintiff, to dismiss its patents, which are independent legally cognizable causes of action, for the sole purported purpose of streamlining the action, which is already sufficiently manageable based in part on reductions in the number of asserted claims?

IV. FACTUAL BACKGROUND AND PROCEDURAL HISTORY

MASA is a public benefit organization that provides resources to organizations to foster positive values and the importance of sports and physical activity in child development. MASA filed the underlying lawsuit against Xerox, Corp. (“Xerox”) on December 13, 2017, asserting twenty of its patents covering innovations related to printers and copiers, including their operation, performance, maintenance and workflow management.¹ Appx158-213. Specifically, the Asserted

¹ Specifically, the patents MASA asserted in its original pleading are: U.S. Patent Nos. 7,502,582 (“582 Patent”), 7,720,425 (“425 Patent”), 8,005,415 (“415 Patent”), 6,203,005 (“3005 Patent”), 6,305,684 (“684 Patent”), 8,019,255 (“255 Patent”), 8,634,113 (“113 Patent”), 6,718,285 (“285 Patent”), 6,909,856 (“856 Patent”), 6,799,005 (“9005 Patent”), 6,462,756 (“756 Patent”), 6,509,974 (“974 Patent”), 6,411,314 (“314 Patent”), 6,724,998 (“998 Patent”), 6,993,278 (“278 Patent”), 7,658,375 (“375 Patent”), 8,220,795 (“795 Patent”), 8,554,089 (“089 Patent”), 8,591,022 (“022 Patent”) 8,805,239 (“239 Patent”).

Patents can be grouped into four general categories: (1) Roller/Feeder Patents (‘3005, ‘255, and ‘113 Patents); Pentachrome Patents (‘415, ‘425, ‘582 Patents); (3) Printer Performance and Maintenance Patents (‘285 and ‘856 Patents); and Work Flow Patents (‘9005, ‘314, ‘974 and ‘756 Patents). MASA accuses different models of Xerox’s office equipment of infringement, including printers, scanners, and multifunction systems. *Id.*

From the outset of this action, MASA and Xerox agreed that a phased narrowing of issues would make the case more manageable to the parties and the Court, particularly given the number of asserted patents, claims, invalidity theories and prior art references. MASA proposed a balanced approach consistent with case narrowing precedent, in which MASA would narrow its infringement case by reducing the number of asserted claims at certain points in the case, and Xerox would narrow its invalidity case by reducing the number of its invalidity theories. Appx475-476.

Xerox, on the other hand, proposed an inequitable approach requiring MASA to eliminate *patents* from the case instead of merely limiting claims, without a proportional reduction in Xerox’s invalidity case. *Id.* Specifically, Xerox proposed that MASA narrow its asserted patents to no more than four patents by 21 days after issuance of the claim construction order—an 80% reduction of its case. *Id.* MASA adamantly objected to this approach on a number of grounds, including that it was a

violation of its legal rights under due process, that it was unprecedented and that it was unnecessary to make the case manageable.

On June 13, 2019, Magistrate Judge Feldman appointed a Special Master pursuant to Rule 53 given what he deemed to be “the complicated issues that are present in this action.” Appx31. The Magistrate Judge granted the Special Master authority to perform various functions subject to review by the District Court, including to “[s]uperintend all proceedings for discovery.” Appx32. Over the next few months, the parties submitted multiple rounds of briefing and participated in multiple conferences with the Special Master to arrive at a case narrowing plan. Appx502-566; Appx567-588; Appx589-632. In October 2019, the Special Master recommended five phases of case narrowing, which Magistrate Judge Feldman adopted on November 4, 2019, in a Supplemental Scheduling Order:

1. MASA to elect no more than 60 claims not later than November 22, 2019. Xerox to elect no more than 90 invalidity positions by no later than 14 days thereafter.
2. MASA to elect no more than 14 terms to be construed by the Court during claim construction by December 9, 2019 or when the terms need to be finalized. Xerox to elect no more than 60 terms to be construed by the Court during claim construction by December 9, 2019 or when the terms need to be finalized.

3. MASA to elect no more than 24 claims 14 days after the Court issues its claim construction order. Xerox to elect no more than 24 invalidity positions not later than 21 days after the Court issued its claim construction order.
4. MASA to elect **no more than “* patents” and** no more than 16 claims not later than 14 days after the close of all discovery. Xerox to elect no more than 16 invalidity positions and 40 references not later than 21 days after the close of all discovery.
5. MASA to elect **no more than “* patents” and** no more than eight claims not later than 7 days after the Court’s decision(s) on all dispositive motions. Xerox to elect no more than 8 invalidity positions and 20 references not later than 14 days after the Court’s decision(s) on all dispositive motions.

Appx36-41. While MASA objected to the bolded portion of these five phases identified above, it agreed with the remainder of this proposal because it was proportional, consistent with case narrowing authority, and would accomplish the goal of making the case manageable going forward. Based on the Special Master’s recommendation, Magistrate Judge Feldman also ordered the parties “to agree to the terms of a stipulated voluntary dismissal without prejudice as a template for use if and when the protocol requires a narrowing of the number of Patents being asserted.”

Appx40. On December 13, 2019, the parties submitted the terms of the template to the Special Master. Appx640-641; Appx681-686.

On February 3, 2020, the Special Master entered her recommendation that for the bolded portions of Phases 4 and 5, MASA should be required to reduce the number of asserted patents from 20 to 8 in Phase 4, and from 8 to 4 in Phase 5. Appx12-30. MASA filed objections to this recommendation, explaining that there is no precedent authorizing a court to force a party to dismiss patents in the name of case narrowing, and that doing so is particularly unjustified here because the case is already manageable and will be properly streamlined through claim narrowing. Appx479-501.

The District Court remained silent on this issue for nearly a year and a half until June 25, 2021, when District Court Judge Wolford entered an order adopting the Special Master's patent-narrowing recommendation (the "Order"). Appx1-11. The Order found that MASA's objections to the Special Master's patent narrowing recommendation raised "both a question of law regarding the Court's authority to order patent narrowing and a challenge to the Special Master's determinations regarding case manageability," and reviewed both issues *de novo*. Appx5. The Order **acknowledged** the lack of authority for narrowing the number patents, noting that "there do not appear to be . . . any cases expressly discussing a court's authority to impose such a patent narrowing requirement where the plaintiff has objected."

Appx7-8. Nevertheless, the Order held that the District Court had the authority to narrow patents, finding no reason to distinguish between narrowing patent claims as opposed to patents themselves. *Id.* In doing so, the Order failed to consider the due process injury in forcing dismissal of patents as separate inventions representing distinct causes of action (and thus different from claims).

The Order also did not explain why claim narrowing was insufficient here to manage the case and did not address the authority that MASA cited showing that district courts effectively manage their cases by narrowing claims to a similar or greater number of claims than MASA had proposed here, not by patent narrowing. Instead, the Order concluded arbitrarily that four patents was the most a jury could handle at trial, failing to address the substantial overlap in subject matter across MASA's asserted patents and the extensive, unnecessary additional costs that MASA would incur in re-trying the patents that it is forced to dismiss. Appx10-11.

By the time of the Order, MASA had already fulfilled the requirements of Phases 1 through 3 of the case narrowing protocol, which it did not dispute, electing 60 claims on November 22, 2019 (i.e., Phase 1), and 24 claims on January 11, 2021, 14 days after the Court entered its claim construction order (i.e., Phase 3). Appx637-639; Appx642-644. Because MASA did not elect any claims from 3 of the asserted patents in Phase 3, it had effectively reduced the number of patents it asserted from 20 to 17 at that point.

The parties exchanged opening expert reports on June 2, 2021, and expert discovery closes on September 1, 2021. Appx120; Appx124. In late July 2021, in its continuing effort to narrow the issues in the case, MASA voluntarily withdrew five patents (the ‘022, ‘239, ‘998, ‘089 and ‘684 Patents). Appx645. Thus, MASA currently asserts 17 claims from 12 patents (‘582, ‘425, ‘415, ‘3005, ‘255, ‘113, ‘285, ‘856, ‘9005, ‘756, ‘974, ‘314 Patents).

By September 15, 2021, MASA must make its election under Phase 4, in which it will be forced to proceed with no more than 8 patents under the Order. Dispositive motions are due by early November 2021 (45 days after Xerox’s Phase 4 election). Appx124-125. Seven days after the District Court’s decisions on these motions, MASA will be compelled to limit the number of patents it asserts again under the District Court’s Order, this time to 4 patents—*i.e.*, only 20% of the patents it originally asserted. *Id.* MASA seeks this Court’s assistance to prevent this imminent and unjust deprivation of MASA’s patent rights.

V. JURISDICTIONAL STATEMENT AND STANDARD OF REVIEW

The Federal Circuit has jurisdiction over this petition because the underlying action is a patent case. *See* 28 U.S.C. § 1295. The Federal Circuit also has authority pursuant to the All Writs Act, which vests authority in “[t]he Supreme Court and all courts established by Act of Congress [to] issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of

law.” 28 U.S.C. § 1651(a); *Miss. Chem. Corp. v. Swift Agric. Chems. Corp.*, 717 F.2d 1374, 1379 (Fed. Cir. 1983) (citing 28 U.S.C. § 1651(a)); *In re Princo Corp.*, 478 F.3d 1345, 1351 (Fed. Cir. 2007) (“This court plainly has jurisdiction to issue a writ of mandamus.”).

Mandamus is available “to correct a clear abuse of discretion or usurpation of judicial power.” *In re United States*, 542 F. App'x 944, 947 (Fed. Cir. 2013) (quoting *In re Calmar, Inc.*, 854 F.2d 461, 464 (Fed. Cir. 1988)); *In re TS Tech. USA Corp.*, 551 F.3d 1315, 1318 (Fed. Cir. 2008). A court clearly abuses its discretion if it “(1) relies on clearly erroneous factual findings; (2) relies on erroneous conclusions of law; or (3) misapplies the law to the facts,” and if “such error[] produce[s] a patently erroneous result.” *In re Tracfone Wireless, Inc.*, No. 2021-136, 2021 U.S. App. LEXIS 11388, at *6 (Fed. Cir. Apr. 20, 2021). A writ of mandamus is proper where the petitioner can show a “clear and indisputable” right to relief; the absence of any “other adequate means to attain” such relief; and that issuance of the writ is “appropriate under the circumstances.” *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380-81 (2004).

VI. REASONS WHY THE WRIT SHOULD ISSUE

The District Court’s errors adopting an unprecedented case narrowing protocol that requires limiting the number of patents as opposed to patent claims warrant immediate intervention. MASA’s right to a writ of mandamus is clear and

indisputable because forcing MASA to dismiss patents—and thereby discrete causes of actions—violates its patent rights and amounts to a due process violation. This patent-narrowing protocol has no precedent from this Court or other district court cases, which instead require narrowing by the number of patent claims. Narrowing the number of claims to 8 by the time of trial, as MASA has proposed here, would make this case readily manageable. In contrast, the patent narrowing required by the District Court would lead to judicial inefficiency, particularly given the substantial overlap in discovery and evidence required among the asserted patents, which MASA will be forced to unnecessarily re-litigate and re-try multiple times in successive litigations.

MASA has no adequate alternative to this writ, because by the time the case is ripe for appeal, it will have already been irreparably harmed through the loss of its patent rights, and other means of relief (such as a motion for reconsideration or interlocutory appeal) are not viable for reasons explained below. A writ is particularly appropriate here as a means for this Court to immediately intervene to correct the bad precedent set by the District Court. Doing so is especially critical since this decision may have far-reaching implications if other district courts follow suit with this novel and unjust approach of depriving patentees of their rights in the name of case management.

A. MASA’s Right to Relief is Clear and Indisputable in View of the District Court’s Abuse of Discretion

1. Compelling MASA to Dismiss Entire Causes of Actions Violates Its Legal Rights

The District Court abused its discretion by entering the Order forcing MASA to dismiss its patents from the action. In doing so, the District Court failed to account for the significance of MASA’s patent rights, in contrast to the claims within those patents. Each of MASA’s patents is a *separate invention*—creating a distinct right that serves as an independent cause of action for infringement. *See Abbey v. Mercedes Benz of N. Am., Inc.*, 138 F. App’x 304, 308 (Fed. Cir. 2005) (vacating the district court’s grant of summary judgment on the basis of res judicata because “each patent asserted raises an independent and distinct cause of action”); 35 U.S.C. § 281. The District Court Order compelled MASA to drop these independent causes of action—specifically, 80% of its asserted patents—without any substantive or procedural basis, but rather for purported efficiency purposes.

Mandating dismissal of patents in this manner is critically distinct from narrowing claims, which is a common case management tool in patent litigation and within a district court’s inherent power as this Court has recognized. *See In re Katz Interactive Call Processing Pat. Litig.*, 639 F.3d 1303, 1312 (Fed. Cir. 2011). This is because a patent’s claims are part of the *same cause of action* brought by the patent and generally cover the same overall invention. *Innova/Pure Water, Inc. v.*

Safari Water Filtration Sys., Inc., 381 F.3d 1111, 1115 (Fed. Cir. 2004) (“the claims of a patent define the invention” of that patent). Thus, requiring a patentee to narrow claims is different from requiring that it drop entire inventions and forfeit its patent rights.

In view of the significance of MASA’s patent rights (as opposed to claims within patents), the District Court’s finding that it has the authority to force dismissal of these patents is contrary to due process and legally erroneous. Indeed, this Court has never permitted limiting the number of asserted patents in the context of case narrowing, and the District Court cited no such authority. Although the District Court has broad discretion to administer its cases, it must act in accordance with due process. *Katz*, 639 F.3d at 1312-13; *see also* 1 HORWITZ ON PATENT LITIGATION § 5.07 (2019); *Certusview Techs., LLC v. S&N Locating Servs., LLC*, 2:13cv346, 2014 U.S. Dist. LEXIS 141013, at *9 (E.D. Va. Sept. 30, 2014). According to the Supreme Court, the Due Process Clause guarantees an “opportunity for hearing appropriate to the nature of the case.” *Jones v. Flowers*, 547 U.S. 220, 223 (2006). That means a party must be able to “present his case and have merits fairly judged.” *Logan v. Zimmerman Brush Co.*, 455 U.S. 422, 433 (1982); *Turner v. Rogers*, 564 U.S. 431, 443-45 (2011) (“[T]o make a civil proceeding fundamentally fair,” court must consider, among other factors, “risk of an erroneous deprivation” of party’s property). Here, the District Court deprived MASA of this opportunity to raise its

patents together in the underlying action and present its case as it sees fit, and it erroneously deprived MASA of its property rights by forcing it to dismiss its patents. Thus, the District Court's Order violates MASA's due process rights under Supreme Court precedent.

The standard set forth by this Court for making a due process claim further confirms that the Court's Order deprives MASA of due process. Specifically, in *Katz*, the Federal Circuit set forth the standard for determining whether a party's due process rights are violated in the particular situation of when a court orders a party to limit the number of patent claims it asserts in a litigation. 639 F.3d at 1303. The Court found that "[t]o make out a due process claim," a party "must demonstrate that the district court's claim selection procedure risked erroneously depriving it of its rights and that the risk outweighed the added costs associated with a substitute procedure." *Id.* at 1311 (citation omitted). Here, the District Court's Order forced MASA to dismiss entire patents (and therefore entire causes of action) rather than just patent claims, and therefore erroneously deprived MASA of its due process rights. A substitute procedure is to limit the number of claims, which MASA agreed to here, and which would streamline this case without inflating litigation costs. Thus, the *Katz* standard confirms the due process violation to MASA here.

Moreover, in finding no due process violation in *Katz*, this Court relied heavily on the patentee's failure to show how the unselected claims were not

duplicative of the selected claims with respect to infringement and invalidity issues, after the defendants had shown that many of the claims are duplicative. Consistent with *Katz*, in determining whether and to what extent to narrow claims, district courts look to whether the asserted claims are duplicative, whether the patents at issue have common genealogy and whether the patents contain terminal disclaimers. *Tech. Licensing Corp. v. Blackmagic Design PTY Ltd.*, 13-cv-05184-SBA (MEJ), 2015 U.S. Dist. LEXIS 7419, at *5 (N.D. Cal. Jan. 22, 2015); *Thought, Inc. v. Oracle Corp.*, 12-cv-05601-WHO, 2013 U.S. Dist. LEXIS 147561, at *4-5 (N.D. Cal. Oct. 10, 2013) (citing *Katz*, 639 F.3d at 1311).

By applying this reasoning to patents as opposed to claims, the patents that the District Court is forcing MASA to dismiss are not duplicative of one another. MASA's patents also come from different genealogies and present unique legal issues of validity and infringement. In fact, Xerox argued during conferences with the Court and Special Master that the asserted patents contain seventeen different specifications, and the Special Master notes in her recommendations that "17 patents do not overlap" because they are not subject to terminal disclaimers. Appx619 (referring to "17 different patent specifications"); Appx12, n.1.² Accordingly, the patents asserted by MASA are not duplicative.

² This is the opposite of *Katz*, where the defendants "provid[ed] examples of duplicative claims and point[ed] out the common genealogy of *Katz*'s patents and

Thus, based on the standards set forth by the Supreme Court and this Court, as applied by district courts across the country, the District Court's Order improperly deprives MASA of due process in asserting its patents.

2. No Authority Supports Eliminating Patents in the Name of Case Management

As the District Court acknowledges, there is *no authority* that supports a requirement forcing a patentee to drop its patents for case management purposes. Appx7 (“[T]here do not appear to be . . . any cases expressly discussing a court’s authority to impose such a patent narrowing requirement where the plaintiff has objected.”).³ None of the authority cited by Xerox, the Special Master or the District Court involves the circumstances here where a patentee is required to involuntarily dismiss its patents as part of the case management process. This lack of authority is not surprising and simply shows that other courts have not been willing to run afoul of due process by compelling patentees to give up patents in a case. Instead, to achieve case management goals, courts regularly require patentees to narrow claims

the terminal disclaimers in almost all of them.” *Katz*, 639 F.3d at 1311. Indeed, this Court noted that the district court did not err in “finding that many of Katz’s claims are duplicative” where there are “only eight unique specifications with a common genealogy.” *Id.*, n.7.

³ While the Order also refers to the Special Master’s identification of cases “in which reduction of patents has been required,” it does not provide any discussion or analysis of these cases. Appx6-8. The Order further does not address MASA’s arguments that *all* of these cases involve circumstances where, unlike here, the patentee *agreed to* a reduction in asserted patents. Appx491-492.

(and alleged infringers to narrow invalidity theories and prior art references), which MASA has agreed to and even itself proposed here.

Consistent with such a claim narrowing case management approach, at least one other district court has explicitly rejected patent narrowing with a similar number of patents at issue. Appx647-648. Specifically, in the co-pending *Ricoh* case, District Judge Savage from the Eastern District of Pennsylvania rejected Ricoh's request for the same unwarranted and unprecedented case narrowing approach of limiting the number of patents that the District Court adopted here. Indeed, in the context of rejecting the limitation on patent approach, the Court imposed a significantly faster schedule than the one presented in the instant action to ensure an efficient and timely resolution of *all* of MASA's causes of action.

While limiting the number of patents in the context of case narrowing is an issue of first impression before the Federal Circuit, certain authority at the federal level is instructive. *First*, this Court's decision in *Katz* is informative for what the Court did *not* consider. Specifically, this Court in *Katz* found that limiting the number of asserted claims for purposes of case management did not run afoul of due process under the circumstance of that case—yet the argument was not made to this

Court, and thus it was never even a consideration, to narrow the number of *patents*, as here.⁴ *Katz*, 639 F.3d at 1309.

Second, the Federal Advisory Committee prepared a case-narrowing model order for patent cases that limits claims and prior art, not the number of patents. *See* Appx560 (“FAC Model Order”); *see also* 1 HORWITZ ON PATENT LITIGATION § 5.07 (2019). The FAC Model Order considers, among other factors, the categories of issues in a patent case that should be limited including the “number of *claims*, number of prior art references, number of invalidity theories, number of terms for claim construction, number of accused products, or some combination[.]” Appx560 (emphasis added). MASA respectfully submits it is not a coincidence that this broad list of issues to consider when narrowing a case does not include reducing the number of patents asserted.

At the district court level, it has become commonplace for courts to streamline their patent infringement cases by requiring a patentee to reduce the number asserted claims, not patents, after considering a number of factors. These courts find that reasonable limits on the number of claims asserted in infringement actions achieve the goal of case manageability and judicial economy. *See* 1 HORWITZ ON PATENT

⁴ The issue in *Katz* was whether the unselected claims should be severed and stayed to avoid preclusive effects in later actions—a procedure that MASA is not seeking here for unselected claims or patents.

LITIGATION § 5.07 (2019); *see also Certusview*, 2014 U.S. Dist. LEXIS 141013, at *9-10 (district courts may limit the number of patent claims a plaintiff may assert to control the dispositions of the causes on its docket with economy of time and effort for itself, for counsel, and for litigants); *Masimo Corp. v. Philips Elecs. N. Am. Corp.*, 918 F. Supp. 2d 277, 282 (D. Del. 2013) (“[a] district court has inherent authority to reasonably limit both the number of claim terms to be construed and the number of patent claims the parties may assert”). This lack of authority for narrowing patents reinforces the error of the District Court’s Order in forcing MASA to dismiss its patents.

3. The Limitation on Claims Achieves Case Manageability and is Consistent with Authority

Narrowing asserted claims is more than adequate to attain case manageability such that there is no need to even consider forcing dismissal of patents. Here, vacating the District Court’s Order would provide the narrow relief of eliminating only the specific portion of the case narrowing protocol that forces MASA to dismiss its patents, leaving intact the remainder of the protocol that requires claim reduction. As a result, MASA would still need to reduce its case to 16 claims by the close of all discovery and 8 claims by trial—a final reduction to 2% of MASA’s claims originally asserted in this action.

This is more than sufficient to narrow the case for trial and consistent with the claim narrowing approach taken by various courts, many of which allow even more

claims than here. For example, the FAC Model Order allows for “five asserted claims per patent from among the ten previously identified claims and no more than a total of 16 claims” in the final election after claim construction. Appx565. In the Northern District of Illinois, a patentee is permitted 10 claims per patent and 20 claims overall in its final infringement contentions, and in the Eastern District of Texas, a patentee must narrow its case to 16 claims prior to expert discovery. Appx674; Appx653. A court in the Central District of California directed the patentee “to limit its asserted claims to no more than 25 within 21 days of this Order.” *Universal Elecs. Inc. v. Roku Inc.*, 18-1580 JVS (ADx), 2019 U.S. Dist. LEXIS 74660, at *16 (C.D. Cal. Mar. 14, 2019). Various other district courts impose similar or higher limitations on the number of asserted claims. *See, e.g., Biedermann Techs. GmbH & Co. v. K2M, Inc.*, 18-cv-585, 2019 U.S. Dist. LEXIS 229888, at *9 (E.D. Va. June 10, 2019) (instructing plaintiff “to provide Defendant with a list identifying no more than forty asserted claims.”); *ParkerVision, Inc. v. Qualcomm Inc.*, No. 6:14-cv-687-Orl-40LRH, 2019 U.S. Dist. LEXIS 122051, at *13 (M.D. Fla. July 23, 2019) (permitting plaintiff to proceed with 40 claims).

In determining the amount of claim narrowing necessary to achieve a manageable case, district courts look to the number of claims at issue and the feasibility of trying the claims to a jury. *Tech. Licensing Corp.*, 2015 U.S. Dist. LEXIS 7419, at *5; *Thought, Inc.*, 2013 U.S. Dist. LEXIS 147561, at *4-5 (citing

Katz, 639 F.3d at 1311). Applying these considerations here, the number of asserted claims MASA proposed is quite reasonable at 8 and would be straightforward to try before a jury. Indeed, the District Court's Order ignored this consideration as it is difficult to imagine how trying 8 claims to a jury would be an issue.

Given the substantial reduction in claims that MASA has agreed to by the time of trial, there is no merit to the District Court's characterization of this case as "unusually large" because it involves "20 patents" and "321 claims." Appx2. Indeed, this characterization ignores the fact that nearly one and a half years had passed since the Special Master recommended the patent narrowing protocol, including 3 of the 5 phases of narrowing, such that as of the date of the Order, MASA only asserted 24 claims and 17 patents, which it has since further reduced to 17 claims and 12 patents. Thus, extensive narrowing of the case has already occurred and will continue to occur by the time of trial, making elimination of patents wholly unnecessary to achieve efficiency.

Notably, when a patentee has voluntarily reduced the number of claims it will assert, and the case is manageable as reduced, courts are hesitant to require a further reduction in the patentee's case. For example, in *Automated Merch Sys. v. Crane Co.*, 3:03-cv-88(L), 2012 U.S. Dist. LEXIS 194668 (N.D.W.Va. Feb. 15, 2012), the district court declined to require a patentee to further reduce the number of asserted claims to ten after the patentee had already made a significant reduction from 116

asserted claims to 26. *Id.* at *8, 11. Here, MASA has already reduced the number of asserted claims to a manageable 17 claims and has no objection to further limiting the number of claims to 8 by the time of trial.

Thus, requiring MASA to reduce the number of patents, which each serve as independent causes of action, is not only unprecedented, but also contrary to the ample authority that shows that the proper approach for case narrowing is through limiting other aspects of the case, including asserted claims. Here, streamlining of this case has already been achieved by the protocol for narrowing the number of claims. Therefore, there is no actual case management purpose served by the District Court's creation of new law that a court has authority to mandate dismissal of patents.

4. Narrowing Patents Instead of Claims Does Not Advance Judicial Economy but Rather Impedes It

Compounding the District Court's error, forcing dismissal of MASA's patents actually impedes manageability by *adding* to overall expense to the Court and parties, rather than saving expense, given the prospect of successive litigation to address the dismissed patents. This is because there is significant overlap in the discovery and evidence that supports MASA's infringement claims across all of the asserted patents, which the District Court failed to consider, such that it is far more efficient to try them in a single action.

Specifically, even though each asserted patent covers a unique invention, the overall subject matter that the patents cover is similar and thus implicates overlapping discovery and evidence. In many instances, the same accused Xerox product is accused of infringing multiple asserted patents across the four categories of Roller/Feeder, Pentachrome, Printer Performance and Maintenance and Work Flow. For example, the Xerox Phaser 6500/6505 products are accused of infringing MASA's '3005, '255, and '239, '089 Patents. *See* Appx230, Appx402, Appx425, Appx461. These patents belong to at least two of the four different categories, namely the Roller/Feeder Patents and Printer Performance and Maintenance Patents. They simply focus on different components of the same product based on the particular invention disclosed in each patent.⁵ There is also overlap in inventors across the Asserted Patents. For example, Yee S. Ng and Robert C. Logel are each named inventors of the Pentachrome Patents ('582, '415 and '425 Patents); Robert Holzwarth is a named inventor of the '314 and '756 Patents; and David Hansen is a named inventor of the '314, '756 and '974 Patents. Appx216-225.

Accordingly, obtaining discovery in a single action is far more efficient than forcing MASA to dismiss certain patents only to have to double-back at some

⁵ Other overlapping accused products include the Xerox Phaser 7800 that infringes the '856, '278, and '022 Patents, and the Xerox WorkCentre 6505 that infringe the '255 and '3005 Patents.

unspecified later time for discovery on similar or the same subject matter. For example, Xerox produced user guides and manuals for accused products that infringe multiple asserted patents. Likewise, Xerox produced financial information on a product-by-product basis, relevant to the infringement allegations for multiple patents. It would be unnecessarily costly to replicate this discovery and re-litigate and re-try this evidence across multiple actions. In addition, requiring inventors to testify in successive actions depending on which patents are asserted is unduly burdensome and a waste of resources. Moreover, the parties have already exchanged infringement and invalidity contentions, discovery requests, document productions, and expert reports relating to all asserted patents.

Given the overlapping subject matter among the asserted patents, allowing MASA to proceed with 8 claims without a specific limit on the number of patents would not complicate the case for a jury. If a jury can make sense of four different patents from each of the four groups of patents mentioned above, a jury would be able to understand the additional patents that have subject matter overlapping with those four patents. Indeed, motion practice and trial will be significantly less efficient under the District Court's Order, as it is much more efficient to present an accused product to the court and jury once and then focus on discrete components that infringe individual patents. Under Xerox's proposal, the parties and the court, including multiple juries, will have to deal with such issues multiple times. Thus,

instead of any efficiency benefit from narrowing the patents, inefficiency and waste of resources would result when the dismissed patents are tried in successive litigation.

Indeed, this inefficiency is directly at odds with the due process standard set forth in *Katz*. The District Court’s deprivation of MASA’s rights to assert its patents not only far “outweigh[.]” any potential “added costs” of not narrowing patents (and only narrowing claims), but the deprivation of rights actually *adds* costs. *Katz*, 639 F.3d at 1311 (“[t]o make out a due process claim, [patentee] must demonstrate that the district court’s claim selection procedure risked erroneously depriving it of its rights and that the risk outweighed the added costs associated with a substitute procedure.”)(citation omitted). Given the unprecedented deprivation of patent rights and waste of resources that result from the Order, the District Court abused its discretion and its Order should be vacated.

5. The District Court’s Rationalization for Narrowing Patents Rather Than Claims Should be Rejected

There is no merit to the District Court’s rationalization that forcing MASA to dismiss all but four of its patents is proper because it could achieve the same result by limiting MASA to four claims by the time of trial. As an initial matter, it is fundamentally contrary to due process to order MASA, with no substantive or procedural basis, to dismiss its patents that cover separate inventions and define

MASA's legally actionable rights, as opposed to individual patent claims. This alone renders the Order erroneous.

Moreover, while MASA recognizes that narrowing claims to a number less than the total number of patents would have the collateral effect of narrowing the number of patents, it does not object to narrowing claims in this manner here if reasonable. For instance, MASA did not object to the portion of the Special Master's recommendation limiting MASA to 8 claims by the time of trial, which would mean that it would voluntarily drop 12 of the patents it originally asserted. Under this approach, MASA would still be free to determine the number of remaining patents that it could assert at trial to arrive at the 8 claims. In contrast, under the approach of the District Court's Order, MASA will be unreasonably forced to dismiss all but 4 of its asserted patents, or 80% of its original case, or worse yet, in the hypothetical proposal by the District Court, to dismiss all but 4 claims, which is 1% of the 321 claims originally asserted in this case. Thus, a reasonable claim narrowing protocol, which has the practical effect of causing MASA to voluntarily elect particular patents to pursue, is different from the Order's draconian elimination of the vast majority of MASA's case through patent narrowing.⁶

⁶ While the District Court also relies on this Court's assumption in *Katz* that the patentee had a separate property right in each claim, this Court made this assumption "without deciding" whether this separate property right exists. 639

The error in the District Court’s analysis is highlighted by its reliance on the further rationalization that MASA would not lose any “substantive right” by the forced dismissal of its patent rights, because it could raise them again later with certain stipulated protections in place (e.g., tolling the statute of limitations). Appx8. This misses the mark for a number of reasons. As an initial matter, this entirely ignores MASA’s rights to a fair *process*, which the District Court has the duty to safeguard but neglected to do so. By forcing MASA to dismiss patents, even if it is allowed to raise them later, MASA cannot prosecute its case as it sees fit and therefore is still being deprived of its due process rights.

Furthermore, requiring MASA to raise its improperly dismissed patents again in a later litigation would be highly inefficient and an unnecessary waste of the Court’s and parties’ time and resources, as described above. These expenses may indeed be prohibitive to MASA, a small charitable company with limited resources, effectively eviscerating its *substantive* rights to the patents it was forced to drop. At the same time, such an approach would create advantages for an accused infringer, like Xerox, which is a large multi-billion-dollar corporation, by permitting it to dodge these causes of action simply because MASA may not be able to afford to raise them yet again. To the extent MASA could come up with the resources to re-

F.3d at 1311, n.6. Thus, this assumption in the footnote of the *Katz* opinion does not support equating claims to patents when considering due process.

assert these patents, it would be further prejudiced not only by the outsized costs of re-litigating them against Xerox, but also the unnecessary delay in being able to assert its rights and even potential loss of evidence, such as documents and witnesses.

Therefore, the District Court provided no justification for its Order erroneously depriving MASA of its patent rights.

B. MASA Lacks Alternative Means to Address the Court's Abuse of Discretion

MASA “lack[s] adequate alternative means” to obtain relief outside of this writ of mandamus. *Mallard v. U.S. Dist. Ct. S. Dist. Of Iowa*, 490 U.S. 296, 309 (1989) (granting writ of mandamus because “Mallard had no alternative remedy available to him”). The District Court failed to rule on the Special Master’s recommended protocol for nearly one and a half years, such that expert discovery is now well underway, dispositive motions are due in just over three months, and trial is imminent. A writ of mandamus is necessary because, by the time this case is tried and appealed, the harm will have been done. If MASA is required to dismiss its patents in this litigation and proceed through trial without them, the due process injury to MASA will have occurred and it will have missed the opportunity to try those patents together in this case as it sees fit. MASA’s only option would be to try these dismissed patents in future litigation, which may be cost prohibitive and effectively deprive MASA of its ability to pursue the patents altogether. To the

extent MASA can muster the resources to file successive suits, these actions would waste the court and parties' time and resources when those same patents could have been litigated far more efficiently in this action. Thus, MASA seeks corrective action now to prevent irreparable deprivation of its rights and needless waste of resources.

To the extent there are other means by which MASA could obtain this relief now as opposed to after final judgment, they are inadequate. For instance, a motion for reconsideration is not a viable option. There is no provision for a motion for reconsideration under the Western District of New York's local rules, and Judge Wolford has noted that "The Federal Rules of Civil Procedure do not recognize a motion for 'reconsideration.'" *Mikulec v. Town of Cheektowaga*, 302 F.R.D. 25, 28 (W.D.N.Y. 2014). Judge Wolford has further explained that in the Second Circuit, "[t]he standard for granting a [motion for reconsideration] is strict, and reconsideration will generally be denied unless the moving party can point to controlling decisions or data that the court overlooked—matters, in other words, that might reasonably be expected to alter the conclusion reached by the court." *Shrader v. CSX Transp., Inc.*, 70 F.3d 255, 257 (2d Cir. 1995).⁷ Indeed, of the only five

⁷ Judge Wolford has also noted that in the Second Circuit: "The major grounds justifying reconsideration are an intervening change of controlling law, the availability of new evidence, or the need to correct a clear error or prevent a manifest injustice." *Virgin Atl. Airways v. Nat'l Mediation Bd.*, 956 F.2d 1245,

motions for reconsideration that Judge Wolford has granted over the course of seven years on the bench, three involved an explicit intervening change of law (*Buehlman, Pirk, Garcia*), one involved a misunderstanding regarding a party's position (*Mikulec*), and the fifth involved binding precedent relevant to the District Court that it had overlooked (*Errington*). *Buehlman v. Ide Pontiac, Inc.*, 345 F. Supp. 3d 305, 310 (W.D.N.Y. 2018); *United States v. Pirk*, 1:15-CR-00142 EAW, 2019 U.S. Dist. LEXIS 126670, at *6-7 (W.D.N.Y. July 29, 2019); *Mikulec*, 302 F.R.D. at 28-29; *Garcia v. Rosen*, 6:19-cv-06327 EAW, 2021 U.S. Dist. LEXIS 6602, at *16-17 (W.D.N.Y. Jan. 13, 2021); *Errington v. Warden Bedford Hills C.F.*, 1:17-cv-00258 EAW, 2019 U.S. Dist. LEXIS 130910, at *17 (W.D.N.Y. Aug. 5, 2019). Here, MASA is not presenting any new evidence or argument, but instead challenging the District Court's Order as an abuse of discretion. Thus, a motion for reconsideration is not an adequate option.

1255 (2d Cir. 1992) (internal quotations and citations omitted). “With respect to the third of these criteria, to justify review of a decision, the Court must ‘have a clear conviction of error on a point [of law] that is certain to recur.’” *Turner v. Vill. of Lakewood*, No. 11-cv-211-A, 2013 WL 5437370, at *3-4 (W.D.N.Y. Sept. 27, 2013) (quoting *United States v. Adegbite*, 877 F.2d 174, 178 (2d Cir. 1989)). “These criteria are strictly construed against the moving party so as to avoid repetitive arguments on issues that have been considered fully by the court.” *Boyde v. Osborne*, No. 10-cv-6651, 2013 WL 6662862, at *1 (W.D.N.Y. Dec. 17, 2013) (quoting *Griffin Indus., Inc. v. Petrojam, Ltd.*, 72 F. Supp. 2d 365, 368 (S.D.N.Y. 1999)).

An interlocutory appeal is also not a viable option. As an initial matter, Federal Circuit law does not require that, prior to filing a writ of mandamus, a party request that a judge certify their own order for appeal, and then have that request be denied. *See, e.g., In re Genentech, Inc.*, 566 F.3d 1338 (Fed. Cir. 2009) (writ of mandamus considered and granted without petitioner having previously requested certification under Section 1292 (b)). Moreover, given the lag of 16 months in obtaining the Order, time is of the essence and any request by MASA that the District Court certify this issue for appeal may not be decided for months, after which MASA would need to appeal, and by then the damage will have been done.

Moreover, the requirements of Section 1292(b) present obstacles to the use of interlocutory appeal to review the District Court's Order. Certification under 28 U.S.C. § 1292 requires that the District Court "be of the opinion that such order involves a controlling question of law as to which there is substantial ground for difference of opinion and that an immediate appeal from the order may materially advance the ultimate determination of the litigation." 28 U.S.C. § 1292(b). It is unlikely that the District Court would be willing to certify the issue for appellate review when the court evidently believes in good faith that it has authority to limit the number of patents a plaintiff may assert, and despite MASA's explanation in briefing of the costs of *additional* litigation, the District Court may not believe that an interlocutory appeal would advance the determination of the *instant* litigation.

Appx7. Moreover, the instant petition involves the question of whether the District Court overreached its discretion in managing its patent cases, which it may not consider appropriate for certification.

For these reasons, MASA's only adequate recourse is to seek this writ.

C. Issuing a Writ of Mandamus is Particularly Appropriate Here

A writ is precisely the remedy appropriate here. It allows for a process to quickly fix the flawed precedent now set by the District Court on a fundamental, undecided question of law and to supervise patent litigation in district courts. If left uncorrected, the District Court will have provided authority for accused infringers to use to eliminate patents in any multi-patent case in the name of case management. This will have far-reaching consequences, as about half of patent cases involve multiple patents, and over 300 cases filed this year alone involve over 4 patents. Appx649. Immediately correcting the District Court's error is necessary to reverse course before other district courts adopt a similar approach that degrades the rights of patent owners. In fact, as noted above, another defendant, Ricoh, has already copied Xerox's approach of seeking to narrow patents, albeit unsuccessfully. Appx647-648. Future accused infringers may have better luck with the District Court's Order in place.

Moreover, a writ is an appropriate and even necessary remedy for the Federal Circuit to protect the very patent rights at stake in actions over which the Court has

exclusive appellate jurisdiction. 28 U.S.C. § 1295. This issue falls squarely within the purview of the Federal Circuit's expertise of patent law, allowing this Court to provide critical direction regarding how a district court should manage patent cases without violating due process rights. Thus, a writ of mandamus is both appropriate and essential here.

VII. CONCLUSION

WHEREFORE, petitioner respectfully requests this Court to grant the following relief:

- A. Vacate the District Court's Case Narrowing Order. *See* Appx1-11.

Respectfully submitted,

Dated: August 3, 2021

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CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Fed. R. App. P. 21(d)(1) because this brief contains 7,729 words, exclusive of the certificate of interest, table of contents, table of a, statement of related cases, addendum and this certificate of compliance as exempted by Fed. R. App. P. 21(a)(2)(C) and Fed. Cir. R. 32(b)(2).

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally-spaced typeface using Microsoft Word 2010 in Times New Roman 14-point font.

/s/ Paul J. Andre
Paul J. Andre

CERTIFICATE OF SERVICE

I, Paul J. Andre, hereby certify that on August 3, 2021, a copy of MIDWEST ATHLETICS AND SPORTS ALLIANCE LLC'S PETITION FOR A WRIT OF MANDAMUS was filed electronically with the Clerk of the Court using the Appellate CM/ECF System. In addition, pursuant to Fed. R. App. P. 21 (a)(1), a copy of the foregoing document was served via electronic mail on counsel of record and was mailed via overnight delivery to the trial court judge as set forth below.

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