

**IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF TENNESSEE
NASHVILLE DIVISION**

GIBSON GUITAR CORPORATION,

Plaintiff,

v.

WAL-MART STORES INC.; TARGET CORPORATION; KMART CORPORATION; SEARS, ROEBUCK & CO.; AMAZON.COM, INC.; GAMESTOP CORPORATION; TOYS-R-US, INC.; HARMONIX MUSIC SYSTEMS, INC.; VIACOM INTERNATIONAL, INC.; and ELECTRONIC ARTS, INC.,

Defendants.

Civil Action No. 3:08-0279

United States District Judge
Thomas A. Wiseman, Jr.

Jury Demand

DEFENDANTS' MOTION TO LIFT STAY

Harmonix Music Systems, Inc., Viacom International Inc., and Electronic Arts Inc., (the “Viacom Parties”) and Wal-Mart Stores, Inc., Target Corp., Kmart Corp., Sears, Roebuck and Co., Amazon.com, Inc., GameStop Corp., and Toys-R-Us, Inc. (the “Retailer Defendants”) respectfully request that the Court lift the stay in the proceedings in this case following the United States Patent & Trademark Office’s (“PTO”) issuance of a notice of intent to confirm the claims of United States Patent No. 5,990,445 (the “patent-in-suit”) as amended by Gibson Guitar Corporation (“Gibson”). The Viacom Parties and Retailer Defendants make this request so that they may file a motion for summary judgment of non-infringement.

As noted in prior status reports, on May 29, 2008, the PTO issued an order granting reexamination of the patent-in-suit, finding that there existed a substantial new question of patentability based on prior art cited by the Viacom Parties. The Viacom Parties thereafter filed a motion for a stay of the litigation pending reexamination (D.E. 53), which the Court granted on August 8, 2008. *See* D.E. 97, August 8, 2008 Order. In granting the stay, the Court stated that “any party may, upon good cause, file a motion to lift the stay.” D.E. 97, August 8, 2008 Order, at 2.

Following this Court’s decision, on March 27, 2009, the PTO rejected numerous claims of the patent-in-suit, including claims 1-21, 23-25 and 28. *See* Notice of Intent to Issue Ex Parte Reexamination Certificate at 2, attached hereto as Exhibit 1. In response, Gibson amended the rejected claims of its patent on June 16, 2009, and submitted new claims. Of particular importance to the infringement claims Gibson alleges in this lawsuit, Gibson amended independent claims 1, 13, 25 and 28, to recite “a musical instrument adapted for (a) making musical sounds and (b) generating/producing an instrument audio signal representative of the musical sounds.” *Id.* at 2, 4-5. Based on these amendments, the patent examiner withdrew its rejections and issued the notice of intent to confirm the claims as amended on September 21, 2009. *Id.* at 2, 4-5, 8-11.

Gibson's amendments to the independent claims of the patent-in-suit significantly affect the scope of the claims. In light of the amendments to the claims, and given in particular that the *Rock Band* and *Guitar Hero* video games and products that this lawsuit attacks indisputably **do not** feature a "musical instrument" having the aforementioned features, Gibson's claims are untenable. The Viacom Parties and Retailer Defendants thus intend to file a motion for summary judgment of non-infringement and thereby dispose of this case in its entirety, as soon as the stay is lifted.

The motion will be based also on collateral estoppel principles arising from a finding of non-infringement of the patent-in-suit by the *Guitar Hero* video games and products in the case previously pending between Activision Publishing, Inc. ("Activision") and Gibson in the Central District of California, titled *Activision Publishing, Inc. v. Gibson Guitar Corp.* (Case No. CV08-01653). The district court in that case granted Activision's motion for summary judgment on February 26, 2009, based on the undisputed fact that the *Guitar Hero* video games and products do not make use of an actual musical instrument, as required by the claims in Gibson's patent-in-suit. *See* Order Denying Gibson's Motion for Reconsideration of the Claim Construction Order, Sustaining Activision's Objections to Evidence, and Granting Activision's Motion for Summary Judgment, dated February 26, 2009, at 10-19, attached hereto as Exhibit 2. Shortly thereafter, Gibson agreed to dismiss Activision and the *Guitar Hero* video games and products from this lawsuit. *See* D.E. 120, Order of Dismissal With Prejudice. Gibson's claims for infringement based on the *Rock Band* video games and products remain pending. For purposes of Gibson's patent-in-suit and its claims for relief, however, there is no relevant difference between the *Guitar Hero* video games and products and the *Rock Band* video games and products. Thus, the same finding of non-infringement made in the case filed in the Central District of California should be made here, and the Viacom Parties and Retailer Defendants intend to so argue and explain in their motion for summary judgment once the stay is lifted.

For the foregoing reasons, the Viacom Parties and Retailer Defendants respectfully request this Court lift the motion to stay the proceedings so that they may file a motion for summary judgment.

Dated: October 16, 2009

Respectfully submitted,

By: /s/ Aubrey B. Harwell, III
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CERTIFICATE OF SERVICE

I hereby certify that on this 16th day of October 2009, I caused a true and correct copy of the foregoing:

DEFENDANTS' MOTION TO LIFT STAY

to be served via the Court's electronic filing system upon the following counsel of record for Plaintiff:

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