

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

L-3 COMMUNICATIONS SECURITY
AND DETECTION SYSTEMS
CORPORATION DELAWARE,

Plaintiff,

v.

AMERICAN SCIENCE &
ENGINEERING, INC.,

Defendant.

CIVIL ACTION NO. 04-10339-RWZ

**ASSENTED TO MOTION FOR LEAVE TO FILE
SURREPLY IN SUPPORT OF L-3'S OPPOSITION TO
AS&E'S MOTION FOR PARTIAL SUMMARY JUDGMENT
TO ADDRESS NEW ISSUES RAISED FOR THE FIRST TIME IN
AS&E'S REPLY MEMORANDUM**

L-3 requests leave to file the accompanying Surreply in opposition to AS&E's Motion for Partial Summary Judgment on inequitable conduct.

AS&E moved for partial summary judgment on the sole argument that it had made a full disclosure of all material information to the PTO. Indeed, AS&E expressly conceded for the purposes of its motion that the information identified by L-3 was material to the prosecution of the patents-in-suit. (AS&E's Mem. at 2, 8 n. 1).

Thus, L-3's initial Opposition concentrated on the disclosure issue. The Opposition pointed out that the patent application had stated that the patented system had been developed pursuant to a government contract, but that it had concealed that the contract (which reflected a sale of the patented invention) had been entered into

more than a year before AS&E had filed its initial patent application. Since this sale was prior to the critical date of AS&E's patents, it was prior art.

AS&E's Reply did not dispute that the disclosure was inadequate. Instead, AS&E changed its position, ignoring its earlier concession that the withheld information was "material." Its Reply now argued that there had been no need to disclose the information to the PTO in the first place. Specifically, AS&E alleged that the sale was not material because the invention was not then "ready for patenting." AS&E also asserted, for the first time, that the Court should grant summary judgment on the ground that AS&E had had no "intent to deceive the PTO."

L-3 thus requests leave to file this Surreply to address these newly-raised issues.

Respectfully submitted,

L-3 COMMUNICATIONS SECURITY AND
DETECTION SYSTEMS CORPORATION
DELAWARE

Dated: March 1, 2005

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LOCAL RULE 7.1 CERTIFICATE

As indicated in the certification under Local Rule 7.1 accompanying AS&E's motion for leave to file its reply, counsel for the parties have conferred and AS&E has assented to L-3's filing of this motion.

/s/ Robert M. Abrahamsen