

1 TIMOTHY T. SCOTT (SBN 126971)
 2 tscott@kslaw.com
 3 GEOFFREY M. EZGAR (SBN 184243)
 4 gezgar@kslaw.com
 LEO SPOONER III (SBN 241541)
 5 lspooner@kslaw.com
 KING & SPALDING LLP
 6 333 Twin Dolphin Drive, Suite 400
 Redwood Shores, CA 94065
 Telephone: (650) 590-0700
 7 Facsimile: (650) 590-1900

8 SCOTT T. WEINGAERTNER
 9 sweingaertner@kslaw.com
 ROBERT F. PERRY
 10 rperry@kslaw.com
 CHRISTOPHER C. CARNAVAL
 11 ccarnaval@kslaw.com
 MARK H. FRANCIS
 12 mfrancis@kslaw.com
 KING & SPALDING LLP
 13 1185 Avenue of the Americas
 New York, NY 10036-4003
 Telephone: (212) 556-2100
 15 Facsimile: (212) 556-2222

16 Attorneys for Defendant
 17 GOOGLE INC.

18 **UNITED STATES DISTRICT COURT**
 19 **NORTHERN DISTRICT OF CALIFORNIA**
 20 **SAN JOSE DIVISION**

21 TEXTSCAPE LLC,
 22 Plaintiff,
 23 v.
 24 GOOGLE INC.
 25 Defendant.

Case No. 5:09-cv-04552-JF
**GOOGLE INC.'S MOTION FOR
 SUMMARY JUDGMENT OF
 INVALIDITY OF CLAIM 1 OF U.S.
 PATENT NO. 5,713,740**
HEARING ON MOTION
 DATE: July 30, 2010
 TIME: 9:00 A.M.
 PLACE: COURTROOM 3

TABLE OF CONTENTS

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Page

I. INTRODUCTION	1
II. STATEMENT OF THE ISSUE TO BE DECIDED	2
III. STATEMENT OF MATERIAL FACTS.....	2
IV. LEGAL STANDARD	4
A. Summary Judgment	4
B. Invalidity under 35 U.S.C. § 102 (a), (e) and (g).....	5
C. Invalidity under 35 U.S.C. § 112, ¶ 1	5
V. ARGUMENT.....	6
A. Textscape’s Allegations	6
B. Claim 1 is Invalid Under § 102 In View of the Prior Art ‘391 Patent.....	7
C. Claim 1 is Invalid Under § 102 In View of the Prior Art ‘808 Patent.....	9
D. Claim 1 is Invalid Under 35 U.S.C. § 112, ¶ 1 For Lack of Written Description.....	11
E. This Motion is Ripe for Adjudication.....	12
VI. CONCLUSION.....	12

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

TABLE OF AUTHORITIES

Page(s)

Cases

Amgen Inc. v. Hoechst Marion Roussel, Inc., 457 F.3d 1293 (Fed. Cir. 2006)..... 5

Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986)..... 12

Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co., 598 F.3d 1336 (Fed. Cir. 2010)..... 4, 5, 6, 11

Dynacore Holdings Corp. v. U.S. Philips Corp., 363 F.3d 1263 (Fed. Cir. 2004)..... 4

In re Schreiber, 128 F.3d 1473, (Fed. Cir. 1997) 5

Int’l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1239 (Fed. Cir. 2009) 6

Invitrogen Corp. v. Clontech Labs., Inc., 429 F.3d 1052, 1072-73 (Fed. Cir. 2005) 6

Lockwood v. American Airlines, Inc., 107 F.3d 1565 (Fed. Cir. 1997) 4

Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574 (1986)..... 4

Oney v. Ratliff, 182 F.3d 893, 895 (Fed. Cir. 1999) 5

Order Granting Defendant’s Motion for Summary Judgment, Textscape LLC v. Adobe Systems Inc., 3:09-cv-4550-BZ, Dkt 57 (N.D. Cal. June 7, 2010) 2, 4, 11

Peters v. Active Mfg. Co., 129 U.S. 530, 537 (1889)..... 6

Pharmacia & Upjohn Co. v. Mylan Pharmaceuticals, Inc., 170 F.3d 1373 (Fed. Cir. 1999)..... 11

PowerOasis, Inc. v. T-Mobile USA, Inc., 522 F.3d 1299, 1307 (Fed. Cir. 2008)..... 6

Telemac Cellular Corp. v. Topp Telecom, Inc., 247 F.3d 1316 (Fed. Cir. 2001)..... 5

Univ. of Rochester v. G.D. Searle & Co., Inc., 358 F.3d 916, 927 (Fed. Cir. 2004) 6

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

TABLE OF AUTHORITIES (CONT.)

Page(s)

Statutes

35 U.S.C. § 102 *passim*
35 U.S.C. § 103 *passim*
35 U.S.C. § 112 *passim*

Rules

FED. R. CIV. P. 56..... 1, 4, 12

Other Authorities

U.S. Patent No. 5,339,391..... *passim*
U.S. Patent No. 5,510,808..... *passim*
U.S. Patent No. 5,713,740..... *passim*

1 PLEASE TAKE NOTICE that on Friday, July 30, 2010 at 9:00 a.m., or as soon thereafter
2 as counsel may be heard, in Courtroom 3 of this Court, located at 280 South 1st Street, San Jose,
3 CA 95113 (5th Floor), Defendant Google Inc. (“Google”) will, and hereby does, move for
4 Summary Judgment of Invalidity.

5 Pursuant to Rule 56 of the Federal Rules of Civil Procedure, Google respectfully moves
6 the Court for an Order granting Summary Judgment in Google’s favor and a finding that claim 1
7 of U.S. Patent No. 5,713,740 (“the ‘740 patent,” Ex. A)¹ is invalid. In the event that the Court
8 elects not to entertain this motion, Google has concurrently moved this Court for a stay of all
9 proceedings in view of the recent grant by the U.S. Patent and Trademark Office of Defendant’s
10 Request for Reexamination of the ‘740 patent based on a substantial new question of
11 patentability raised by Defendant. (*See* Ex. B.)

12 **I. INTRODUCTION**

13 In the present action, Plaintiff Textscape LLC (“Textscape”) has alleged that the
14 “scrollbar indication” feature in Google’s Chrome Web Browser embodies every element in
15 claim 1 of the ‘740 patent. (*See* Ex. C, *Plaintiff’s Disclosure of Asserted Claims and*
16 *Infringement Contentions*.) However, the same feature is clearly illustrated in the prior art to the
17 ‘740 patent, which anticipates claim 1 under 35 U.S.C. § 102(a), (e) and (g). Indisputable
18 evidence establishes that Plaintiff’s earliest alleged conception date for claim 1 of the ‘740 patent
19 post-dates the U.S. filing dates of the anticipatory prior art. Claim 1 of the ‘740 patent is
20 therefore invalid under 35 U.S.C. § 102(a), (e) and (g), as discussed below.

21 As a second basis for invalidity, claim 1, as asserted against Google, is invalid under 35
22 U.S.C. § 112, ¶ 1 for lack of written description. Textscape alleges that claim 1 should be read in
23 such a manner as to be infringed by the Chrome Web Browser, but as this Court has recently
24 recognized in *Textscape LLC v. Adobe Systems Inc.*, the ‘740 patent specification establishes that
25 the alleged inventor was not in possession of a graphical user interface (“GUI”) such as the
26

27 _____
28 ¹ All references to “Ex. __.” are Exhibits attached to the Declaration of Scott T. Weingaertner (“Decl.”), submitted with this motion.

1 Chrome Web Browser. *See Order*, 3:09-cv-4550-BZ, Dkt 57 (N.D. Cal. June 7, 2010).

2 The present Motion is ripe for adjudication. Given (i) the absence of any claim
3 construction issues, (ii) the fact that the prior art is being applied in precisely the same manner
4 that Plaintiff applies claim 1 to the accused product, (iii) the clarity with which the prior art
5 discloses the elements of claim 1 as applied by Textscape, and (iv) the recent holding of another
6 Division of this Court as to the inadequacy of the written description of the ‘740 patent under 35
7 U.S.C. §112, ¶ 1 to support the claims of that patent, there is no reason to prolong this dispute.

8 **II. STATEMENT OF THE ISSUES TO BE DECIDED**

9 (1) Whether asserted claim 1 of the ‘740 patent is invalid under 35 U.S.C. § 102(a),
10 (e) and (g) as anticipated by U.S. Patent Nos. 5,339,391 and 5,510,808.

11 (2) Whether asserted claim 1 of the ‘740 patent is invalid under 35 U.S.C. § 112, ¶ 1
12 for inadequate written description.

13 **III. STATEMENT OF MATERIAL FACTS**

14 There are no genuine issues of material fact that could preclude summary judgment, as
15 only the following facts are relevant to this motion:

16 (1) Claim 1 of the ‘740 patent provides:

17 A method of producing a representation of text to enable a person
18 to obtain some comprehension of said text without reading all of
19 said text, comprising the steps of:

20 identifying at least one feature contained within at least a
21 portion of said text;

22 creating at least one representation of said portion of said text,
23 wherein said representation of said portion of said text does
24 not include any readable words but does include a graphical
25 indication that indicates the presence of said at least one
26 feature at least one location within said at least one
27 representation.

28 (Ex. A, ‘740 patent at claim 1.)

(2) Textscape’s infringement contentions provide a single claim chart alleging that
Google’s Chrome Web Browser infringes claim 1 of the ‘740 patent. (*See Ex. C* at 2-3.)

(3) With respect to the accused functionality, Textscape’s claim chart states that
“[t]he Google Chrome Web Browser includes a Find in Page feature that allows a user to enter

1 search terms to locate within a web page being viewed in the browser . . . [f]or each hit of the
2 search term, the Chrome Web Browser displays a horizontal yellow bar in the scrollbar at the
3 location of the hit within the web page.” (*Id.* at 3.)

4 (4) Textscape’s infringement contentions assert that the ‘740 patent is entitled to a
5 priority date of January 18, 1994. (*Id.* at 3.)

6 (5) The inventor of the ‘740 patent has recently testified under oath that he conceived
7 of the invention claimed in the ‘740 patent no earlier than November 1990. (*See* Ex. D, Excerpts
8 of the April 7, 2010 *Deposition of R. David Middlebrook in Textscape LLC v. Adobe Systems*
9 *Inc.*, 3:09-cv-4550-BZ (N.D. Cal.))

10 (6) U.S. Patent No. 5,339,391 (“the ‘391 patent,” Ex. E) issued on August 16, 1994
11 and is entitled “Computer display unit with attributed enhanced scroll bar.”

12 (7) The ‘391 patent was filed on August 4, 1993 as a continuation of Application No.
13 07/523,117, which was filed on May 14, 1990. (*See* Ex. F, excerpts from the Prosecution
14 History of the ‘391 patent.) The initial application filed on May 14, 1990 contains all of the
15 subject matter from the ‘391 patent that is identified as anticipatory in this motion. (*See id.*)

16 (8) U.S. Patent No. 5,510,808 (“the ‘808 patent,” Ex. G) issued on April 23, 1996 and
17 is entitled “Scrollbar having system of user supplied information.”

18 (9) The ‘808 patent was filed on January 31, 1995 as a continuation of Application
19 No. 531,213, which was filed on May 31, 1990. (*See* Ex. H, excerpts from the Prosecution
20 History of the ‘808 patent.) The initial application filed on May 31, 1990 contains all of the
21 subject matter from the ‘808 patent identified as anticipatory in this motion. (*See id.*)

22 (10) For purposes of this Motion only, without acceding to the propriety of
23 Textscape’s reading of the claims and reserving all rights to challenge that reading, Google relies
24 on: (i) Textscape’s attempt to read claim 1 of the ‘740 patent on the Chrome Web Browser; (ii)
25 Textscape’s assertion of a January 18, 1994 priority date for the ‘740 patent; and (iii) the
26 inventor’s previous testimony that he is entitled to a conception date in November 1990.

27 (11) The ‘391 and ‘808 patents both have initial filing dates in May 1990 (Exs. F; H),
28 well before the asserted ‘740 patent’s priority date of January 18, 1994, and before the earliest

1 possible conception date of the '740 patent, as provided in the inventor's testimony. The
2 disclosures in the '391 and '808 patents are therefore available as prior art under 35 U.S.C. §
3 102(a), (e), and (g).

4 (12) In the District Court's *Order Granting Defendant's Motion for Summary*
5 *Judgment in Textscape LLC v. Adobe Systems Inc.*, 3:09-cv-4550-BZ, Dkt. 57 (N.D. Cal. June 7,
6 2010) ("Adobe Order," Ex. I), the Court held that:

7 [Textscape's other patents] describe the use of Graphical User
8 Interfaces ("GUI") as part of one such [claim] step. The '740
9 patent does not contain any such reference. Plaintiff claims that its
10 disclosure in the '740 patent of the use of "existing computer
11 graphics software and existing software programs to implement the
12 invention" is sufficient. [] However, plaintiff concedes that it
13 made an explicit disclosure of the use and implementation of GUIs
14 in both the [other Textscape] patents, but did not do so in the '740
15 patent. Plaintiff's contention that the use of GUIs is "obvious" to
16 one skilled in the arts runs contrary to the Federal Circuit's holding
17 in *Ariad*. I find that the reference to existing software does not
18 disclose to one skilled in the art that the inventor had possession of
19 the means to accomplish the claims of the '740 patent using a GUI.

20 *Id.* at 5 (citing *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, 598 F.3d 1336 (Fed. Cir. 2010)
21 (*en banc*)) (emphasis added).

22 **IV. LEGAL STANDARD**

23 **A. Summary Judgment**

24 Summary judgment is appropriate where there is no genuine issue as to any material fact.
25 *See* FED. R. CIV. P. 56(c); *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1569 (Fed. Cir.
26 1997). To defeat a summary judgment motion, the opposing party must do "more than simply
27 show that there is some metaphysical doubt as to the material facts." *Matsushita Elec. Indus. Co.*
28 *v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986). In this regard, unsupported conclusions on the
ultimate issue of invalidity are "insufficient to raise a genuine issue of material fact." *Dynacore*
Holdings Corp. v. U.S. Philips Corp., 363 F.3d 1263, 1278 (Fed. Cir. 2004). Instead, the
opposing party must set forth "specific facts showing that there is a genuine issue for trial." FED.
R. CIV. P. 56(e); *Matsushita Elec.*, 475 U.S. at 587.

1 B. Invalidity under 35 U.S.C. § 102 (a), (e) and (g)

2 Patent law provides that a person is not entitled to a patent if:

3 (a) the invention was known or used by others in this country, or
4 patented or described in a printed publication in this or a foreign
5 country, before the invention thereof by the applicant for patent, or

6 . . .

7 (e) the invention was described in . . . (2) a patent granted on an
8 application for patent by another filed in the United States before
9 the invention by the applicant for patent. . . , or

10 . . .

11 (g) . . . (2) before such person’s invention thereof, the invention
12 was made in this country by another inventor who had not
13 abandoned, suppressed, or concealed it. . . .

14 35 U.S.C. § 102(a), (e) and (g). “A prior art reference anticipates a patent if it discloses all the
15 limitations of the claimed invention.” *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 457 F.3d
16 1293, 1304 (Fed. Cir. 2006) (citing *Oney v. Ratliff*, 182 F.3d 893, 895 (Fed. Cir. 1999)). The
17 prior art may disclose the claimed limitations either explicitly or inherently to anticipate them.
18 *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316 (Fed. Cir. 2001) (citing *In re*
19 *Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997)).

20 “Although anticipation is a question of fact, it still may be decided on summary judgment
21 if the record reveals no genuine dispute of material fact.” *Telemac*, 247 F.3d at 1327.

22 C. Invalidity under 35 U.S.C. § 112, ¶ 1

23 The Patent Statute provides as follows:

24 The specification shall contain a written description of the
25 invention, and of the manner and process of making and using it, in
26 such full, clear, concise, and exact terms as to enable any person
27 skilled in the art to which it pertains, or with which it is most
28 nearly connected, to make and use the same. . .

29 35 U.S.C. § 112, ¶ 1. Sitting *en banc* this year, the Federal Circuit “read the statute to give effect
30 to its language that . . . § 112, first paragraph, contains two separate description requirements: a
31 ‘written description [i] of the invention, and [ii] of the manner and process of making and using
32 [the invention].’” *Ariad*, 598 F.3d at 1344. The Court described the test for written description
33 as “whether the disclosure of the application relied upon reasonably conveys to those skilled in
34 the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* at

1 1531. In other words, “the specification itself that must demonstrate possession . . . a description
2 that merely renders the invention obvious does not satisfy the requirement.” *Id.* at 1532.

3 “Compliance with the written description requirement is a question of fact but is
4 amenable to summary judgment in cases where no reasonable fact finder could return a verdict
5 for the nonmoving party.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1307 (Fed.
6 Cir. 2008) (citing *Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1072-73 (Fed. Cir.
7 2005)). “[A] patent can be held invalid for failure to meet the written description requirement,
8 based solely on the language of the patent specification.” *Univ. of Rochester v. G.D. Searle &*
9 *Co., Inc.*, 358 F.3d 916, 927 (Fed. Cir. 2004) (citation omitted).

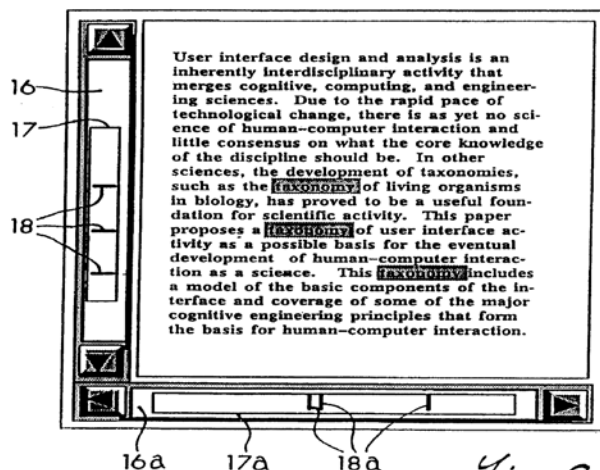
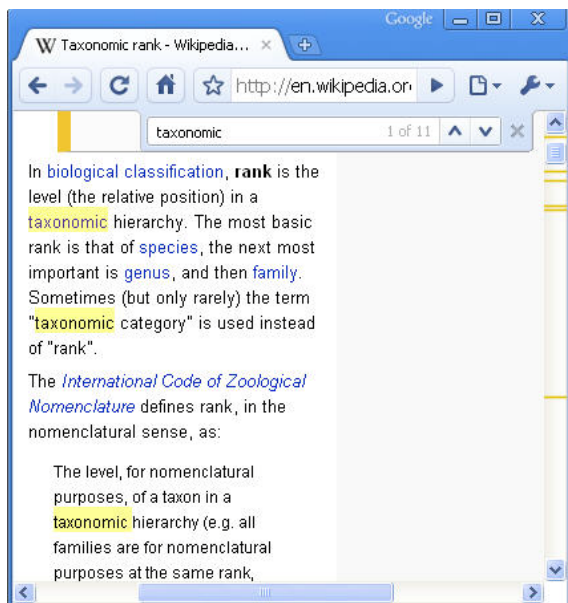
10 **V. ARGUMENT**

11 A. Textscape’s Allegations

12 Textscape alleges that Google’s Chrome Web Browser infringes claim 1 of the ‘740
13 patent because when a user searches for a particular word or phrase in a webpage, the browser
14 generates a horizontal line in the scrollbar adjacent to each line of the webpage in which that
15 term or phrase appears. (*See* Ex. C at 3 (“For each hit of the search term, the Chrome Web
16 Browser displays a horizontal yellow bar in the scrollbar at the location of the hit within the web
17 page”).) However, as demonstrated below, the ‘391 and ‘808 patents both disclose and illustrate
18 precisely the same functionality that Plaintiff accuses of infringement – identifying the line of
19 text within a document where a search term appears by placing horizontal lines in the scrollbar
20 adjacent to those terms. Each element of Textscape’s infringement allegations against the
21 Chrome Web Browser’s “scrollbar indication feature” is therefore shown in its entirety by the
22 ‘391 and ‘808 patents. Each of these prior art patents therefore renders claim 1 invalid under 35
23 U.S.C. §102 as anticipated, because “it has been well established for over a century that the same
24 test must be used for both infringement and anticipation. This general rule derives from the
25 Supreme Court’s proclamation 120 years ago in the context of utility patents: “[t]hat which
26 infringes, if later, would anticipate, if earlier.”” *Int’l Seaway Trading Corp. v. Walgreens Corp.*,
27 589 F.3d 1233, 1239 (Fed. Cir. 2009) (quoting *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537
28 (1889)).

1 **B. Claim 1 is Invalid Under § 102 In View of the Prior Art '391 Patent**

2 The figure below on the left is a screenshot of the accused scrollbar indication feature in
3 Google's Chrome Web Browser. (See Decl. at ¶ 11.) The figure on the right illustrates the same
4 "scrollbar indication feature" in the prior art '391 patent. (See Ex. E at Fig. 2; Ex. F at Fig. 2.)



15 **Accused Web Chrome Browser**

15 **Fig. 2 in the prior art '391 patent**

16 As asserted by Textscape against Google's Chrome Web Browser, there is simply no
17 difference between the elements in claim 1 of the asserted '740 patent and the corresponding
18 disclosure in the prior art '391 patent, which fully describes the use of search result indicators in
19 a scrollbar. As further demonstrated in Table 1 below, the '391 patent disclosure clearly
20 anticipates claim 1, as asserted against Google, on an element-by-element basis in view of the
21 claim as applied by Textscape's Patent L.R. 3-1(c) allegations. These prior art disclosures also
22 appear in the original application for the '391 patent that was filed on May 14, 1990. (See Ex. F
23 at 3, 7, 11.)

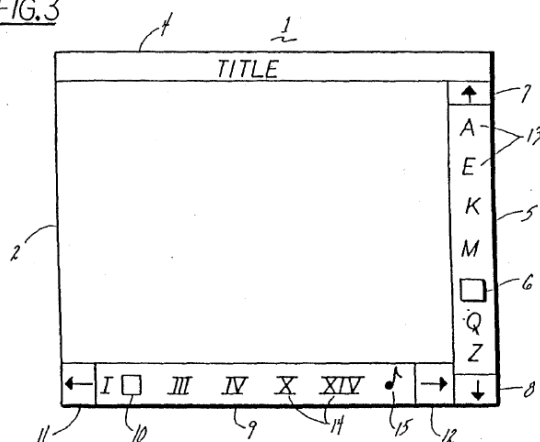
Table 1

Textscape’s Patent L.R. 3-1(c) Allegations (Ex. C)		Prior Art ‘391 Patent
Asserted Claim 1	Google Chrome Web Browser	
1. A method of producing a representation of text to enable a person to obtain some comprehension of said text without reading all of said text, comprising the steps of:	“The Google Chrome Web Browser includes a Find in Page feature that allows a user to enter search terms to locate within a web page being viewed in the browser. The Chrome Web Browser uses the vertical scroll as a representation of the webpage and to show the location of hits for the search terms.”	<i>See, e.g.</i> , Col. 1:55-61: “With the attribute enhanced scroll bar of the present invention, a user can determine the distribution of significant attributes in the space defined by the stored data file, and can determine the existence of significant data attributes outside of the visible portion of the data file presently being displayed in the data display field of the screen...”
identifying at least one feature contained within at least a portion of said text;	“The Find in Page feature of the Chrome Web Browser allows a user to enter a search term. The Chrome Web Browser searches the text of the currently displayed web page to identify hits for the search term.”	<i>See, e.g.</i> , Col. 1:62-63 “Examples of significant data attributes include words or phrases within a document...” <i>See, e.g.</i> , Col. 5:24-25: “...the implementation could be used for many things, such as finding the hits in the textual search of a buffer...”
creating at least one representation of said portion of said text,	“The Chrome Web Browser uses the vertical scrollbar as a representation of the web page and to show the location of hits for the search terms.”	<i>See, e.g.</i> , Col. 2:4-6: “As a result, significant task-specific attributes of the data file being displayed are visually indexed against a scroll bar...”
wherein said representation of said portion of said text does not include any readable words but does include a graphical indication that indicates the presence of said at least one feature at at least one location within said at least one representation.	“The vertical scrollbar in the Chrome Browser does not include any readable words or text from the web page. For each hit of the search term, the Chrome Web Browser displays a horizontal yellow bar in the scrollbar at the location of the hit within the web page.”	<i>See, e.g.</i> , Col. 2:4-6: “As a result, significant task-specific attributes of the data file being displayed are visually indexed against a scroll bar...” <i>See, e.g.</i> , Col. 4: 3-6: “FIG. 3 illustrates how a significant amount of information can be obtained about a data file by viewing the featural representation of the data file offered by the enhanced scroll bar alone.”

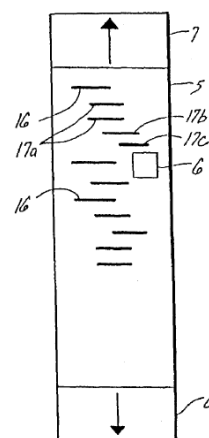
1 C. Claim 1 is Invalid Under § 102 In View of the Prior Art '808 Patent

2 Claim 1 of the '740 patent is also anticipated by the prior art '808 patent. According to
3 the '808 patent, “[i]t is a still further object of the invention to provide presentation space-related
4 location information within a scrollbar, the location information having the form of, by example,
5 characters, symbols, graphics, color and/or audio cues.” (Ex. G at Col. 2:58-62; Ex. H at 5.) The
6 '808 patent further provides that “[s]earch command results may also be indicated by scrollbar
7 location information. That is, a command to find all occurrences of a specific character string
8 results in location information being written to the vertical scrollbar, the location information
9 indicating each occurrence of the search string within the document.” (Ex. G at Col. 5:47-52;
10 Ex. H at 12-13.) The '808 patent also provides corresponding figures, which illustrate the
11 different types of indicators that can be used in a scrollbar. (See, e.g., Ex. G at Figs. 3 and 4; Ex.
12 H at Figs. 3 and 4.)

13 FIG.3



13 FIG.4



21 **Figures 3 and 4 in the prior art '808 patent**

22 The '808 patent explains that in “FIG. 4 there is shown another embodiment of a vertical
23 scrollbar 5 having location information in the form of linear graphical symbols 16 and 17.” (Ex.
24 G at Col. 4: 44-46; Ex. H at 10.) The '808 patent clearly describes every aspect of the feature in
25 the Google Chrome Web Browser which Textscape has alleged to infringe each element of claim
26 1. As further demonstrated in Table 2 below, the '808 patent disclosure anticipates claim 1 on an
27 element-by-element basis in view of Textscape’s infringement contentions. These disclosures
28 also appear in the original application filed on May 31, 1990. (See Ex. H at 10, 12-13, Abstract.)

Table 2

Textscape’s Patent L.R. 3-1(c) Allegations (Ex. B)		Prior Art ‘808 Patent
Asserted Claim 1	Google Chrome Web Browser	
1. A method of producing a representation of text to enable a person to obtain some comprehension of said text without reading all of said text, comprising the steps of:	“The Google Chrome Web Browser includes a Find in Page feature that allows a user to enter search terms to locate within a web page being viewed in the browser. The Chrome Web Browser uses the vertical scroll as a representation of the webpage and to show the location of hits for the search terms.”	<i>See, e.g.</i> , Abstract: “A third step displays within the scrollbar at least one indicia for indicating a relative location of a feature of interest within the presentation space. The indicia may take the form of alphanumeric characters, symbols, colors, graphical images, audio information and combinations thereof.”
identifying at least one feature contained within at least a portion of said text;	“The Find in Page feature of the Chrome Web Browser allows a user to enter a search term. The Chrome Web Browser searches the text of the currently displayed web page to identify hits for the search term.”	<i>See, e.g.</i> , Col. 5:47-52: “Search command results may also be indicated by scrollbar location information. That is, a command to find all occurrences of a specific character string results in location information being written to the vertical scrollbar, the location information indicating each occurrence of the search string within the document.”
creating at least one representation of said portion of said text,	“The Chrome Web Browser uses the vertical scrollbar as a representation of the web page and to show the location of hits for the search terms.”	<i>(discloses both elements)</i>
wherein said representation of said portion of said text does not include any readable words but does include a graphical indication that indicates the presence of said at least one feature at at least one location within said at least one representation.	“The vertical scrollbar in the Chrome Browser does not include any readable words or text from the web page. For each hit of the search term, the Chrome Web Browser displays a horizontal yellow bar in the scrollbar at the location of the hit within the web page.”	<i>See, e.g.</i> , Col. 4:44-56: “Referring to FIG. 4 there is shown another embodiment of a vertical scrollbar 5 having location information in the form of linear graphical symbols 16 and 17.” <i>See, e.g.</i> , Col. 5:47-52, above.

1 D. Claim 1 is Invalid Under 35 U.S.C. § 112, ¶ 1 For Lack of Written Description

2 As explained by the District Court’s Order in *Textscape LLC v. Adobe Systems Inc.*, the
3 use of a Graphical User Interface (“GUI”) is not described in the ‘740 patent. (*See Adobe Order*,
4 Ex. H at 5:5-8.) The Court further noted that “plaintiff concedes that it made an explicit
5 disclosure of the use and implementation of GUIs in both the [other Textscape] patents, but did
6 not do so in the ‘740 patent.” (*Id.* at 5:12-14.) Instead, the ‘740 patent vaguely explains:

7 Textmapping may also be practiced on text displayed on a
8 computer screen. Existing computer graphics software, including
9 pen technology for computers, may be used in much the same way
10 as pencils, pens and colored markers are used to map a text
11 displayed on paper. In addition, elements of existing software
12 programs, such as the search functions employed in most word
13 processing software packages, can be used to quickly locate
14 selected features in a text.

12 (Ex. A, ‘740 patent at 10:55-62). This disclosure is exactly what the *Ariad* Court held was not
13 sufficient to meet the written disclosure requirement. 598 F.3d at 1532 (finding that it is “the
14 specification itself that must demonstrate possession . . . [but] a description that merely renders
15 the invention obvious does not satisfy the requirement”). The District Court in the *Adobe* case
16 recognized this patent’s failure in holding that “Plaintiff’s contention that the use of GUIs is
17 ‘obvious’ to one skilled in the arts runs contrary to the Federal Circuit’s holding in *Ariad*.”
18 (*Adobe Order*, Ex. I at 5:15-17.) The Court concluded that “the reference to existing software
19 does not disclose to one skilled in the art that the inventor had possession of the means to
20 accomplish the claims of the ‘740 patent using a GUI.” (*Id.* at 5:17-20.) *See generally*
21 *Pharmacia & Upjohn Co. v. Mylan Pharmaceuticals, Inc.*, 170 F.3d 1373, 1379-80 (Fed. Cir.
22 1999) (noting that a judgment of invalidity will have a collateral estoppel effect if the “patentee
23 has had a full and fair opportunity to litigate the relevant issue or issues in a prior case”).

24 In sum, while Textscape reads claim 1 against the GUI functionality in the Chrome Web
25 Browser, it is invalid under § 112, ¶ 1 because the ‘740 patent lacks any written description
26 demonstrating that the “inventor had possession of the claimed subject matter as of the filing
27 date.” *Ariad*, 598 F.3d at 1544; *Adobe Order*, Ex. I at 5.

