

**GOOGLE INC.'S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY
OF CLAIM 1 OF U.S. PATENT NO. 5,713,740**

Exhibit I

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

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

TEXTSCAPE LLC, a New Jersey)
Corporation,)
)
Plaintiff(s),)
)
v.)
)
ADOBE SYSTEMS INC., a)
Delaware Corporation,)
)
Defendant(s).)
)
_____)

No. C09-4550 BZ

**ORDER GRANTING DEFENDANT'S
MOTION FOR SUMMARY JUDGMENT**

Defendant and Counterclaimant Adobe Systems Inc.
("Adobe") has moved for summary judgment contending that the
claims of U.S. Patent No. 5,930,809 (the "'809 patent") are
invalid as anticipated under 35 U.S.C. §§ 102(a) and (b).¹
Adobe also moves for summary judgment that the '809 patent is
not entitled to the benefit of any related patent applications
filed prior to September 22, 1997, the '809 patent's
application date.

¹ All parties have consented to my jurisdiction, for
all proceedings including entry of final judgment, pursuant to
28 U.S.C. 636(c).

1 Plaintiff and Counterdefendant Textscape LLC
2 ("Textscape") has one employee, Mr. David Middlebrook, who
3 invented a "System and Method for Processing Text" and was
4 awarded the '809 patent. Textscape claims that Adobe Reader
5 versions 6.0, 7.0, 8.0, and 9.0 infringe the '809 patent.²
6 Adobe claims that the '809 patent (1) was anticipated by Adobe
7 Reader 1.0, (2) was anticipated by Mr. Middlebrook at the
8 Technology, Reading, and Learning Difficulties Conference in
9 January of 1996 ("the TRLD demo"), more than one year before
10 applying for the '809 patent, and (3) is not entitled to the
11 priority date of either Patent No. 5,713,740 (the "'740
12 patent") or Patent No. 5,556,282 (the "'282 patent").
13 Textscape applied for the '740 patent application on June 3,
14 1996 and for the '282 patent on January 18, 1994.

15 The dispositive issue in this motion is to which priority
16 date the '809 patent is entitled. If the '809 patent is not
17 entitled to the priority date of the '282 patent, then the
18 claims of the '809 patent are barred as anticipated because of
19 Mr. Middlebrook's public demonstration of the software at the
20 TRLD Conference. At oral argument, plaintiff conceded if the
21 '809 patent application date controls, its claims are invalid
22 as anticipated. Plaintiff solely argues that the priority
23 date of the '282 patent controls.

24 If the '809 patent is entitled to the filing date of the
25 '282 patent, then the Court must determine whether the Adobe
26 Reader 1.0 anticipated the '809 patent. Plaintiff argues that

27 ² Claim 1 of the '809 patent is the only independent
28 claim. Claims 2-16 are all dependent on Claim 1.

1 Reader 1.0 did not anticipate the '809 patent because it does
2 not include "a plurality of different mapping formats."

3 **SUMMARY JUDGMENT STANDARD**

4 Rule 56 of the Federal Rules of Civil Procedure provides
5 for summary judgment when there is no genuine issue as to any
6 material fact and the court can determine that the party is
7 entitled to a judgment as a matter of law.³ "A patent shall
8 be presumed valid, and each claim shall be presumed valid
9 independently of the validity of other claims. 35 U.S.C. §
10 282. The burden is on the party asserting invalidity to prove
11 it with facts supported by clear and convincing evidence."

12 Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d
13 443, 446 (Fed.Cir. 1986).

14 **PRIORITY DATE**

15 "In order to gain the benefit of the filing date of an
16 earlier application under 35 U.S.C. § 120, each application in
17 the chain leading back to the earlier application must comply
18 with the written description requirement of 35 U.S.C. § 112."

19 Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1571 (Fed.
20 Cir. 1997). To "maintain the continuity of disclosure . . . a
21 prior application itself must describe an invention, and do so
22 in sufficient detail that one skilled in the art can clearly
23 conclude that the inventor invented the claimed invention as
24 of the filing date sought." Id. at 1572-72. "Entitlement to
25 a filing date does not extend to subject matter which is not
26

27 ³ The parties did not submit a joint statement of
28 undisputed facts as required by my pretrial order. However,
the facts in this case do not appear to be in dispute.

1 disclosed, but would be obvious over what is expressly
2 disclosed. It extends only to that which is disclosed." Id.

3 In Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co., the
4 Federal Circuit clarified the written description requirement
5 under § 112. 598 F.3d 1336 (Fed.Cir. 2010). The court stated
6 that "an adequate written description . . . requires more than
7 a generic statement of an invention's boundaries." Id. at
8 1349. "[T]he test for sufficiency [of the description] is
9 whether the disclosure of the application relied upon
10 reasonably conveys to those skilled in the art that the
11 inventor had possession of the claimed subject matter as of
12 the filing date." Id. at 1351. Finally, "while the
13 description requirement does not demand any particular form of
14 disclosure . . . a description that merely renders the
15 invention obvious does not satisfy the requirement." Id. at
16 1352.

17 Here, plaintiff must prove that the written description
18 of the '809 patent is contained in the written description of
19 the '740 patent as well as the '282 patent.⁴ After comparing
20 the '809, '740, and '282 patents, I find that the '740 patent
21 did not provide an adequate written description sufficient to
22 entitle the '809 patent to the priority date of the '282
23 patent. In other words, the '809 patent did not cross the
24 bridge to the '282 patent. Therefore, each "application in

25
26 ⁴ The court in PowerOasis, Inc. v. T-Mobile USA, Inc.
27 held that in circumstances such as this case, the burden is on
28 the plaintiff to come forward with evidence that it is entitled
to the earlier priority date. 522 F.3d 1299, 1305-06 (Fed.Cir.
2008). Plaintiff conceded that it had the burden of proving
entitlement to an earlier priority date at the hearing.

1 the chain leading back to the earlier application" did not
2 satisfy the written description requirement. Lockwood, 107
3 F.3d at 1571.

4 First, the patent at issue describes the steps that a
5 computer must perform to manage a body of text. Both the
6 '809 and the '282 patent describe the use of Graphical User
7 Interfaces ("GUI") as part of one such step. The '740 patent
8 does not contain any such reference. Plaintiff claims that
9 its disclosure in the '740 patent of the use of "existing
10 computer graphics software and existing software programs to
11 implement the invention" is sufficient. Opposition at 6:27.
12 However, plaintiff concedes that it made an explicit
13 disclosure of the use and implementation of GUIs in both the
14 '809 and '282 patents, but did not do so in the '740 patent.
15 Plaintiff's contention that the use of GUIs is "obvious" to
16 one skilled in the arts runs contrary to the Federal Circuit's
17 holding in Ariad. I find that the reference to existing
18 software does not disclose to one skilled in the art that the
19 inventor had possession of the means to accomplish the claims
20 of the '740 patent using a GUI.

21 Second, the '809 patent discloses the use of a "text
22 display menu" and a "map box" which are not discussed in the
23 '740 patent.⁵ The difference in scope between the '809 and
24 the '740 patents is demonstrated by comparing Figure 1 of the
25 '740 patent with Figure 2 of the '809 patent. See Reply

26
27 ⁵ In response to plaintiff's application for the '809
28 patent, the USPTO noted that "no mention of a map box was found
in either of the parent applications" Oliver Decl. Ex.
11 p. 3.


1 p. 3-4. Figure 2 contains several graphical representations
2 as to how the text in a particular document would be
3 displayed, manipulable, and mapped. Further, Figure 2
4 contains an explicit "map box" which allows a user to select
5 from a plurality of different mapping formats. In contrast,
6 Figure 1 contains a depiction of how text may be scanned into
7 a computer, have certain data extracted, and then have that
8 extracted data displayed. Figure 1 contains none of the
9 graphical representations that depict how a user would be able
10 to view the relevant output. Nor does Figure 1 depict the use
11 of a "map box" for selecting display options. At oral
12 argument, plaintiff contended that though the '740 patent does
13 not explicitly mention a "map box," it does disclose the use
14 of a "display." However, it is uncontested that the '740
15 patent does not disclose any of the controls, options, or
16 menus that make the '809 "map box" a useful invention. The
17 lack of specificity in the description of the '740 patent is
18 ultimately fatal to plaintiff's claim for an earlier priority
19 date.

20 I find that plaintiff did not satisfy the written
21 description requirement under Ariad and Lockwood in its '740
22 patent to warrant a priority date earlier than the filing date
23 of the '809 patent. As such, plaintiff's claims in the '809
24 patent are invalid as anticipated under 35 U.S.C. § 102(b) by
25 plaintiff's public demonstration at the TRLD demo. Adobe's
26 motion for summary judgment is **GRANTED**. All claims of the
27 '809 patent are invalid as anticipated. Because I have found
28 the '809 patent to be invalid, I do not address whether Reader

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

1.0 anticipated the '282 patent.

Dated: June 7, 2010



Bernard Zimmerman
United States Magistrate Judge

G:\BZALL\BZCASES\TEXTSCAPE V. ADOBE SYSTEMS\MSJ ORD v 2.wpd