GOOGLE INC.'S MOTION TO STAY
PENDING REEXAMINATION OF U.S. PATENT NO. 5,713,740

Exhibit 2

I hereby certify that this correspondence is being filed using EFS-Web addressed to: Mail Stop Ex Parte Reexam, Central Reexamination Unit, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: April 2, 2010 Signature: /Holmes J. Hawkins III/
Holmes J. Hawkins III, 38,913

Docket No. 13557.105030
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reexamination of:

R. David Middlebrook

Control No.: Not yet Assigned

Patent No.: 5,713,740

Examiner: Not Yet Assigned

Issue Date: Feb. 3, 1998

Art Unit: Not Yet Assigned

For: SYSTEM AND METHOD FOR CONVERTING WRITTEN TEXT INTO A GRAPHICAL IMAGE FOR IMPROVED COMPREHENSION BY THE LEARNING DISABLED

REQUEST FOR *EX PARTE* REEXAMINATION UNDER 37 C.F.R. § 1.510

Mail Stop Ex Parte Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

King & Spalding, LLP (hereinafter, "Requester") submits, under the provisions of 37 C.F.R. § 1.510 *et seq.*, a Request for Reexamination (hereinafter, "Request") of claims 1-6 and 11-17 of U.S. Patent No. 5,713,740 (hereinafter "the '740 patent") entitled "System and Method for Converting Written Text into a Graphical Image for Improved Comprehension by the Learning Disabled," issued to R. David Middlebrook on February 3, 1998. The '740 patent is provided as Exhibit 1 to the Request.

In support of its request, Requester provides the following:

- The $2520.00 fee for requesting *ex parte* reexamination set forth in 37 C.F.R. § 1.20(c)(1) (37 C.F.R. § 1.510(a));

- A statement pointing out each substantial new question of patentability based on prior patents and printed publications (37 C.F.R. § 1.510(b)(1));

- An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested (37 C.F.R. § 1.510(b)(2));

- A copy of every patent or printed publication relied upon or referred to in paragraphs (b)(1) and (b)(2) of 37 C.F.R. § 1.510, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication (37 C.F.R. § 1.510(b)(3));

- A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper ((37 C.F.R. § 1.510(b)(4)) (Exhibit 1); and

- A certification that a copy of the request has been served in its entirety on the patent owner at the address as provided for in 37 C.F.R. § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office ((37 C.F.R. § 1.510(b)(5)).

Pursuant to 35 U.S.C. § 303, the prior art references discussed in this Request raise "substantial new questions of patentability" with respect to claims 1-6 and 11-17 of the '740 patent. As required by 37 C.F.R. § 1.510(b)(1), a statement pointing out each substantial new question of patentability is provided below for each identified claim for which reexamination is requested. As required by 37 C.F.R. § 1.510(b)(2) a detailed explanation of the pertinency and manner of applying the cited patents and publications to each identified claim is provided below for each identified claim for which reexamination is requested. As required by 37 C.F.R.

§ 1.510(b)(3) and (4), copies of the pertinent patents and publications relied upon, and a copy of the entire '740 patent including the front face, drawings, and specification/claims (in double column format) were previously provided. The fee for requesting reexamination under 37 C.F.R. § 1.20(c)(1) was previously provided.

TABLE OF CONTENTS

I. INTRODUCTION

King & Spalding, LLP ("Requester") requests reexamination of claims 1-6 and 11-17 of U.S. Patent 5,713,740 ("the '740 patent") under 35 U.S.C. §§ 302-307 and 37 C.F.R. § 1.510 *et seq*. The application for the '740 patent was filed on June 3, 1996, and does not appear to have an assignment recorded.[1]

The claims of the '740 patent relate to a "method which enables individuals to rapidly and accurately obtain information about the contents of a written text without having to read the words of the text." '740 patent, Abstract; '740 patent, Claims (reciting only method claims).

The Requester is aware of at least 9 prior art patents and printed publications that, alone or in combination, either anticipate or render obvious claims 1-6 and 11-17 of the '740 patent. The prior art patents and printed publications (1) were not cited to or considered by the Examiner during prosecution of the '740 patent and are not cumulative to information cited to or considered by the Examiner during prosecution of the '740 patent and (2) were not applied by the Examiner during prosecution of the '740 patent, particularly in combination with the prior art patents and printed publications that were not cited to or considered by the Examiner during prosecution of the '740 patent.

As will be discussed in greater detail in this Request, a number of the prior art patents and printed publications render unpatentable claim 1 of the '740 for the same reasons that the Patent Owner alleges that GOOGLE'S CHROME web browser infringes claim 1 of the '740 patent in

[1] Neither the face of the '740 patent nor the assignment records of the U.S. Patent and Trademark Office identify that the '740 patent has been assigned. The address and attorney agent information presented on PAIR for the '740 patent identifies the attorney of record as Eric A. LaMorte, 985 Reading Ave., Yardley, PA 19067-1626. The Roster of Attorneys and Agents lists Mr. LaMorte's address as LaMorte and Assocs. PC, P O Box 434, Yardley, PA 19067.

current litigation involving the ‘740 patent in the U.S. District Court for the District of Northern California.

Accordingly, at least in view of these listed prior art references and the substantial new questions of patentability that they raise, the Requester respectfully requests the issuance of an order for reexamination, and further requests that claims 1-6 and 11-17 be canceled. The Requester respectfully requests that this Request be afforded special dispatch in accordance with 35 U.S.C. § 305 and 37 C.F.R. § 1.550.

The Requester further respectfully requests that the Director provide an order of action dates to accompany the decision ordering reexamination of the ‘740 patent.

II. STATEMENT UNDER 37 C.F.R. § 1.510 (B)(1) POINTING OUT SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

Substantial new questions of patentability of claims 1-6 and 11-17 of the ‘740 patent are raised in view of the new prior art references not previously considered by the Examiner. Section II.A provides an overview of the ‘740 patent. Section II.B summarizes certain aspects of the law regarding reexamination. Section II.C summarizes the evidentiary standards applicable to reexamination. Section II.D provides a list of all prior art patents and printed publications relied upon in this Request. Section II.E provides a list of other supporting documents discussed in this Request. Section II.F provides a summary of pending litigation involving the ‘740 patent. Section II.G provides admissions by the Patent Owner of the ‘740 patent. Section II.H provides an identification of the substantial new questions of patentability raised in this Request. Section II.I provides an overview of the substantial new questions of patentability raised in this Request.

A. Overview of the '740 Patent

The claims of the '740 patent relate to a "method which enables individuals to rapidly and accurately obtain information about the contents of a written text without having to read the words of the text." '740 patent, Abstract; '740 patent, Claims (reciting only method claims). Claims 1 and 13 are independent claims. Claim 1 expressly claims:

> 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:
> [1a][2] identifying at least one feature contained within at least a portion of said text;
> [1b] creating at least one representation of said portion of said text,
> [1c] 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.

Claim 13 expressly recites:

> A method of producing a representation of text contained within a document to enable a person to obtain some comprehension of said text without reading said text, comprising the steps of:
> [13a] creating an image of said text wherein individual words of said text are not discernable within said image;
> [13b] identifying at least one textual feature contained within said text;
> [13c] illustrating on said image the areas of said text that contain said at least one textual feature.

The '740 patent indicates that it is an objective of the alleged invention "to provide a system and method to enable learning disabled individuals to use their visual/spatial abilities and/or parafoveal/peripheral vision instead of, or in addition to, their auditory abilities and/or

[2] Bracketed notations have been added to claims 1 and 13 to indicate claim limitations. These notations are added for convenience of presenting this Request and are not necessarily meant to indicate any interpretation of the claims by the Requester.

foveal vision for comprehending written text." '740 patent, 1:45-50.[3] The alleged invention "enables a person to understand a large amount of information about the body of written text without reading the words comprising the body of written text." '740 patent, Abstract.

The '740 patent issued from U.S. Patent Application Serial No. 08/655,699. This application was a continuation-in-part of U.S. Patent Application Serial No. 08/184,493, which matured into U.S. Patent No. 5,556,282. The '740 patent issued on a first action Notice of Allowance.

B. Aspects of the law governing reexamination

1. Citation of prior art

Any person at any time may file a request for reexamination by the Office of any claim of any patent on the basis of any prior art cited under the provisions of section 301." 35 U.S.C. § 302. Section 301 limits prior art to "patents or printed publications." 35 U.S.C. § 301.

MPEP 2128 classifies a reference as a printed publication if it is accessible to the public:

> A reference is proven to be a 'printed publication' 'upon a satisfactory showing that such *document* has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.'

In re Wyer, 655 F.2d 221, 210 USPQ 790 (CCPA 1981) (quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743, 148 USPQ 537, 540 (SDNY 1966)).

[3] When referring to patents with text arranged in columns, this Request uses the convention of column number:line number (or line number range) to indicate a specific section of text in the patent.

2. "Old" prior art can raise a significant new question of patentability

The fact that a prior art reference was cited or even previously considered by an examiner does not preclude use of that reference to find a substantial new question of patentability. *See* 35 U.S.C. § 303(a); MPEP Section 2258.01; *see also In re Swanson*, 540 F.3d 1368, 1380-81 (Fed. Cir., Sept. 4, 2008) (holding that consideration of a prior art reference in previous litigation and in an original examination does not preclude a finding of a SNQ based on the same prior art reference in reexamination).

A combination of such "old art" and art newly cited during the reexamination proceeding may raise a SNQ. *See* MPEP Section 2258.01. The Patent Office may even find a SNQ based exclusively on previously cited references.

> For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request.

See id.

3. Obviousness standard under *KSR*

The Supreme Court recently relaxed the Federal Circuit's requirement of a "teaching/suggestion/motivation test," and instead held that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc. et al.*, 550 U.S. 398, 416 (2007). The Court noted that "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation" of an existing system, then "§103(a) likely bars its patentability." *Id.* at 417. *KSR* also held that "if a technique has been used to

improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious" if within his or her skill. *See id.*

On October 10, 2007, the U.S. Patent and Trademark Office (USPTO) released Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103(a) in View of the Supreme Court Decision in *KSR Int'l Co. v. Teleflex Inc.*, 72 Fed. Reg. 195 at 57526 (the "PTO Guidelines"). The PTO Guidelines adopt the rationales from the *KSR* decision for determining obviousness. One of the rationales is "'Obvious to Try' – Choosing from a Finite Number of Identified, Predictable Solutions, With a Reasonable Expectation of Success." To reject a claim on this basis, the PTO Guidelines note that pertinent factors to consider are whether "there had been a finite number of identified, predictable potential solutions to the recognized need or problem," and "one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success." *Id.* at 57532. The PTO Guidelines have been incorporated into the MPEP's examination guidelines for determining obviousness under 35 U.S.C. § 103. *See* MPEP 2141.

Additionally, the Federal Circuit has applied the *KSR* obviousness standard to combine multiple embodiments disclosed in a single prior art reference. *Boston Sci. Scimed, Inc. v. Cordis Corp.*, No. 2008-1073, 2009 U.S. App. LEXIS 588, at *24 (Fed. Cir. Jan. 15, 2009) (holding that a person of ordinary skill would have been motivated to combine one embodiment found in a patent reference with a second, separate embodiment found in the same patent reference.)

4. Prior art references need not be enabling in an obviousness inquiry

Moreover, prior art references need not be enabling in the context of an obviousness inquiry. As stated in the MPEP:

> **35 U.S.C. 103(a) REJECTIONS AND USE OF INOPERATIVE PRIOR ART**
>
> "Even if a reference discloses an inoperative device, it is prior art for all that it teaches." *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Therefore, "a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103." *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991).

MPEP 2121.01; *see also* MPEP 2145; *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1357 (Fed. Cir. 2003) (holding that under 35 U.S.C. § 103, "a reference need not be enabled; it qualifies as prior art, regardless, for whatever is disclosed therein.") (citations to other cases omitted).

5. Claims of the patent are to be broadly construed

In a reexamination proceeding, claims are to be given their broadest construction consistent with the specification. *See In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) ("During reexamination, as with original examination, the PTO must give claims their broadest reasonable construction consistent with the specification.").

C. Evidentiary standards

If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present. *See* MPEP 2242. A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is

patentable. *Id.* In addition to patents and printed publications, admissions by a patentee may also be used as evidence to establish a substantial new question of patentability in combination with a patent or a printed publication. *See* MPEP 2217. An admission by a patentee may reside in a record created during litigation. *See id.* Such patentee admissions may be relied upon for any matter affecting patentability. 37 C.F.R. § 1.104(c)(3).

D. Prior art patents and printed publications relied upon in this Request

In accordance with 37 C.F.R. § 1.510, reexamination of claims 1-6 and 11-17 of the '740 patent is requested in view of the prior art patents and printed publications listed below, which raise substantial new questions of patentability. This Request will demonstrate how claims 1-6 and 11-17 of the '740 patent are anticipated or rendered obvious in view of the following prior art references:

1. Church, Kenneth W. and Jonathan Isaac Helfman. *Dotplot: A Program for Exploring Self-Similarity in Millions of Lines of Text and Code*, J. OF COMPUTATIONAL AND GRAPHICAL STATISTICS, Vol. 2, No. 2 (Jun. 1993), pp. 153-174 (hereinafter, the "Church 1993 reference"), provided as Exhibit 2.

2. U.S. Patent No. 5,510,808 to Cina Jr. et al., issued Apr. 23, 1996 from an application filed Jan. 31, 1995, which claims priority to an application filed May 31, 1990 (hereinafter, the "Cina '808 patent"), provided as Exhibit 3.

3. U.S. Patent No. 5,945,998 to Eick, issued Aug. 31, 1999 from an application filed Aug. 21, 1997, which claims priority to an application filed Sep. 6, 1991 (hereinafter, the "Eick '998 patent"), provided as Exhibit 4.

4. Eick, Stephen G., Joseph L. Steffen, and Eric E. Summer Jr. *Seesoft - A Tool for Visualizing Line Oriented Software Statistics*, IEEE TRANSACTIONS ON SOFTWARE ENG'G, VOL. 18, NO. 11 (Nov. 1992), pp. 957-968 (hereinafter, the "Eick 1992 reference"), provided as Exhibit 5.

5. U.S. Patent No. 5,623,588 to Gould, issued Apr. 22, 1997 from an application filed Dec. 14, 1992 (hereinafter, the "Gould '588 patent"), provided as Exhibit 6.

6. Kozima, Hideki. *Text Segmentation Based on Similarity Between Words*, Proceedings of the 31st Annual Meeting of the Association for Computational

Linguistics, Columbus, OH (Jun. 1993), pp. 286-288 (hereinafter, the "Kozima 1993 reference"), provided as Exhibit 7.

7. Brill, Eric. *A Simple Rule-Based Part of Speech Tagger*, Speech and Natural Language: Proceedings of a workshop held at Harriman, New York, Feb. 23-26, 1992, pp. 112-116 (hereinafter, the "Brill 1992 reference"), provided as Exhibit 8.

8. Church, Kenneth Ward. *A Stochastic Parts Program and Noun Phrase Parser for Unrestricted Text*, Proceedings of the Second Conference on Applied Natural Language Processing, Austin, TX, Feb. 9-12, 1988, pp. 136-143 (hereinafter, the "Church 1988 reference"), provided as Exhibit 9.

9. Church, Kenneth Ward. *Word Association Norms, Mutual Information, and Lexicography*, COMPUTATIONAL LINGUISTICS, VOL. 16, NO. 1 (Mar. 1990), pp. 22-29 (hereinafter, the "Church 1990 reference"), provided as Exhibit 10.

E. Supporting documents discussed in this Request

The following documents are provided to assist the Examiner in understanding the Request, including claim charts and references providing background information:

1. Claim Chart based on Church 1993 reference, provided as Exhibit 11.

2. Claim Chart based on Cina '808 patent, provided as Exhibit 12.

3. Claim Chart based on Eick '998 patent, provided as Exhibit 13.

4. Claim Chart based on Eick 1992 reference, provided as Exhibit 14.

5. Claim Chart based on Gould '588 patent, provided as Exhibit 15.

6. Claim Chart based on Kozima 1993 reference, provided as Exhibit 16.

F. Current Litigation

The Requester is aware of at least one current litigation matter involving the '740 patent. On September 25, 2009, Textscape LLC filed a complaint in the U.S. District Court for the Northern District of California alleging that Google, Inc. infringed the '740 patent. The case is styled *Textscape LLC v. Google, Inc.*, Civil Action No.: 5:09-cv-04552 JF. An Amended Joint

Case Management Statement for the case provides for a claim construction hearing in the case to take place in October 2010. Fact discovery will end 50 days after a Claim Construction Ruling is issued in the case. Dispositive motions are due 180 days after a Claim Construction Ruling is issued in the case.

G. Patent Owner Admissions

In establishing a substantial new question of patentability, "an admission by the patent owner of record in the file or in a court record may be utilized in combination with a patent or printed publication." MPEP 2217. "Admissions by the patent owner as to any matter affecting patentability may be utilized to determine the scope and content of the prior art in conjunction with patents and printed publications in a prior art rejection, whether such admissions result from patents or printed publications or from some other source." *Id* (emphasis omitted).

The Patent Owner,[4] provided preliminary infringement contentions in a pending litigation involving the '740 patent. A copy of these preliminary infringement contentions are provided in Exhibit 18. In these infringement contentions, the Patent Owner asserts claim 1 against a browser product, Google's Chrome Web Browser. Specifically, the Patent Owner contends that:

[4] In a complaint filed on September 25, 2009 in the United States District Court for the Northern District of California, Textscape LLC contended that it owns the '740 patent. *See* Complaint at 2 (provided as Exhibit 17, excerpted).

Claim 1 Claim Element	Google Chrome Web Browser Feature
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 scrollbar as a representation of the webpage and to show the location of hits for the search terms.
[1a] 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.
[1b] 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.
[1c] 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.

See Plaintiff's Disclosure of Asserted Claims and Infringement Contentions, *Textscape LLC v. Google, Inc.*, Civil Action No.: 5:09-cv-04552 JF, U.S. District Court for the Northern District of California, Exhibit 18.

In other words, the Patent Owner contends that a reasonable construction of the terms of claim element [1a] allows the element to cover a search feature in a browser that identifies the occurrences, or "hits," of a search term in a given text. Further, the Patent Owner alleges that a reasonable construction of the terms of claim element [1b] allows the element to cover a vertical scroll bar of a browser, where the scroll bar is the recited "representation" of a webpage. Finally, Patent Owner alleges that a reasonable construction of the terms of claim element [1c] allows the

element to cover the situation where the scroll bar itself does not have any readable words but instead displays an indication in the scroll bar of the location of the "hits" on the page.[5]

Since, "[d]uring reexamination, as with original examination, the PTO must give claims their broadest reasonable construction consistent with the specification," *In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007), the Patent Office should now construe the claim terms in claim 1 (and other claims as appropriate) at least as broadly as to be disclosed in prior art patents or printed publications that disclose a computer application with a scroll bar, where the scroll bar displays an indication of a feature of text in a presentation window of the application adjacent to the scroll bar and where the scroll bar itself does not have any readable words.

H. Identification of Substantial New Questions of Patentability

In this Request, substantial new questions of patentability for claims 1-6 and 11-17 of the '740 patent are identified in accordance with 37 CFR § 1.510(b)(1) as follows:

1. Anticipation under 35 U.S.C. § 102.

    a. Claims 1, 11, 13, 14, 16, and 17 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Church 1993 reference.

    b. Claims 1, 13, 14, 16, and 17 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Cina '808 patent.

    c. Claims 1, 13, 14, 16, and 17 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Eick '998 patent.

    d. Claims 1, 13, 14, 16, and 17 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Eick 1992 reference.

[5] By including these Patent Owner admissions in this Request, the Requester is in no way admitting to the correctness of the Patent Owner's position in litigation involving the '740 patent.

e. Claims 1, 13, and 14 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Gould ‘588 patent.

f. Claims 1, 12, 13, 14, and 15 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Kozima 1993 reference.

2. Obviousness under 35 U.S.C. § 103(a) based on Church 1993 reference.

a. Claims 2, 3, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Brill 1992 reference.

b. Claims 2, 3, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Church 1988 reference.

c. Claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Kozima 1993 reference.

d. Claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Church 1990 reference.

3. Obviousness under 35 U.S.C. § 103(a) based on Cina ‘808 patent.

a. Claims 2, 3, 4, 5, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina ‘808 patent in view of the Brill 1992 reference.

b. Claims 2, 3, 4, 5, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina ‘808 patent in view of the Church 1988 reference.

c. Claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina ‘808 patent in view of the Kozima 1993 reference.

d. Claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina ‘808 patent in view of the Church 1990 reference.

4. Obviousness under 35 U.S.C. § 103(a) based on Eick ‘998 patent.

a. Claims 2, 3, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick ‘998 patent in view of the Brill 1992 reference.

b. Claims 2, 3, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick ‘998 patent in view of the Church 1988 reference.

c. Claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick '998 patent in view of the Kozima 1993 reference.

d. Claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick '998 patent in view of the Church 1990 reference.

5. Obviousness under 35 U.S.C. § 103(a) based on Eick 1992 reference.

a. Claims 2, 3, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Brill 1992 reference.

b. Claims 2, 3, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Church 1988 reference.

c. Claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Kozima 1993 reference.

d. Claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Church 1990 reference.

6. Obviousness under 35 U.S.C. § 103(a) based on Gould '588 patent.

a. Claims 2, 3, 4, 5, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Brill 1992 reference.

b. Claims 2, 3, 4, 5, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Church 1988 reference.

c. Claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Kozima 1993 reference.

d. Claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Church 1990 reference.

The table below summarizes the grounds for substantial new questions of patentability for claims 1-6 and 11-17 of the '740 patent, on a claim-by-claim basis.

Claim No.	Grounds for Unpatentability, Anticipation	Grounds for Unpatentability, Obviousness
1	Church 1993 reference; Cina ‘808 patent; Eick ‘998 patent; Eick 1992 reference; Gould ‘588 patent; and Kozima 1993 reference.	
2		Church 1993 reference in view of the Brill 1992 reference; Church 1993 reference in view of the Church 1988 reference; Cina ‘808 patent in view of the Brill 1992 reference; Cina ‘808 patent in view of the Church 1988 reference; Eick ‘998 patent in view of the Brill 1992 reference; Eick ‘998 patent in view of the Church 1988 reference; Eick 1992 reference in view of the Brill 1992 reference; Eick 1992 reference in view of the Church 1988 reference; Gould ‘588 patent in view of the Brill 1992 reference; and Gould ‘588 patent in view of the Church 1988 reference.

Claim No.	Grounds for Unpatentability, Anticipation	Grounds for Unpatentability, Obviousness
3		Church 1993 reference in view of the Brill 1992 reference; Church 1993 reference in view of the Church 1988 reference; Cina '808 patent in view of the Brill 1992 reference; Cina '808 patent in view of the Church 1988 reference; Eick '998 patent in view of the Brill 1992 reference; Eick '998 patent in view of the Church 1988 reference; Eick 1992 reference in view of the Brill 1992 reference; Eick 1992 reference in view of the Church 1988 reference; Gould '588 patent in view of the Brill 1992 reference; and Gould '588 patent in view of the Church 1988 reference.
4		Cina '808 patent in view of the Brill 1992 reference; Cina '808 patent in view of the Church 1988 reference; Gould '588 patent in view of the Brill 1992 reference; and Gould '588 patent in view of the Church 1988 reference.
5		Cina '808 patent in view of the Brill 1992 reference; Cina '808 patent in view of the Church 1988 reference; Gould '588 patent in view of the Brill 1992 reference; Gould '588 patent in view of the Church 1988 reference

Claim No.	Grounds for Unpatentability, Anticipation	Grounds for Unpatentability, Obviousness
6		Church 1993 reference in view of the Brill 1992 reference; Church 1993 reference in view of the Church 1988 reference; Cina '808 patent in view of the Brill 1992 reference; Cina '808 patent in view of the Church 1988 reference; Eick '998 patent in view of the Brill 1992 reference; Eick '998 patent in view of the Church 1988 reference; Eick 1992 reference in view of the Brill 1992 reference; Eick 1992 reference in view of the Church 1988 reference; Gould '588 patent in view of the Brill 1992 reference; and Gould '588 patent in view of the Church 1988 reference.
11	Church 1993 reference.	
12	Kozima 1993 reference.	Church 1993 reference in view of the Kozima 1993 reference; Cina '808 patent in view of the Kozima 1993 reference; Eick '998 patent in view of the Kozima 1993 reference; Eick 1992 reference in view of the Kozima 1993 reference; and Gould '588 patent in view of the Kozima 1993 reference.

Claim No.	Grounds for Unpatentability, Anticipation	Grounds for Unpatentability, Obviousness
13	Church 1993 reference; Cina '808 patent; Eick '998 patent; Eick 1992 reference; Gould '588 patent; and Kozima 1993 reference.	
14	Church 1993 reference; Cina '808 patent; Eick '998 patent; Eick 1992 reference; Gould '588 patent; and Kozima 1993 reference.	
15	Kozima 1993 reference.	Church 1993 reference in view of the Church 1990 reference; Cina '808 patent in view of the Church 1990 reference; Eick '998 patent in view of the Church 1990 reference; Eick 1992 reference in view of the Church 1990 reference; and Gould '588 patent in view of the Church 1990 reference.
16	Church 1993 reference; Cina '808 patent; Eick '998 patent; and Eick 1992 reference.	
17	Church 1993 reference; Cina '808 patent; Eick '998 patent; and Eick 1992 reference.	

I. Overview of Substantial New Questions of Patentability

The application that matured into the '740 patent was filed on June 3, 1996. This application was a continuation-in-part of an application filed January 18, 1994. Claim 1 of the '740 patent recites a method of producing a representation of text, where the method identifies a feature contained within a portion of the text and then creates a representation of the portion of text, where the representation does not include any readable words but does indicate the presence of the identified feature. *See* '740 patent, claim 1.

Church 1993 reference. Church, Kenneth W. and Jonathan Isaac Helfman. *Dotplot: A Program for Exploring Self-Similarity in Millions of Lines of Text and Code*, J. OF COMPUTATIONAL AND GRAPHICAL STATISTICS, Vol. 2, No. 2 (Jun. 1993), pp. 153-174 (the "Church 1993 reference"), provided as Exhibit 2, discloses a software program that provides "a graphical tool for browsing millions of lines of text and source code." Church 1993 reference at 153. Since the Church 1993 reference was published in June 1993 it is prior art to the '740 patent under 35 U.S.C. § 102(b), given a priority date for the '740 patent of Jun. 3, 1996. To the extent that any of the claims of the '740 patent is entitled to the earlier priority date of the parent patent application for the application that matured into the '740 patent, then the Church 1993 reference is prior art under 35 U.S.C. § 102(a) for such claims. The Church 1993 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

As can be seen from Figure 1 of the Church 1993 reference, reproduced below, the software creates a representation of the text without any readable words. For example, the browser screen in the upper right of Figure 1 of the Church 1993 reference, which is indicated

by a "(a)," depicts a global overview of the text file. *See* Church 1993 reference at 154. This overview depicts diagonals, squares, and textures. As the Church 1993 reference explains, these diagonals, squares, and textures provide the viewer with specific information about the text, such as the reoccurrence of certain character sequences. *See* Church 1993 reference at 154-55. That is, these diagonals, squares, and textures indicate the presence of certain features in the text.

In one example, the Church 1993 reference examines a dotplot of four AP stories concerning the death of Ryan White. *See* Church 1993 reference at 157. The dotplot depicts broken diagonal lines. *See* Church 1993 reference, Fig. 4, at 157. As the reference discloses, these broken diagonal lines indicate that the stories were updated. In this way, the dotplot indicates a feature of an article -- that the article was updated. *See also*, Church 1993 reference, Fig. 5 and accompanying text (depicting a dotplot comparing the French and English versions of Canadian parliament debates and showing, in the upper right and lower left quadrants, where French and English texts have common words); Fig. 8 and accompanying text (depicting a colorized dotplot comparing a Microsoft® manual in seven languages and depicting the feature of when words in the manual of the same language match (dark red), words in the manual of different languages match (yellow), and words in the manual of the similar languages match (color between yellow and dark red).

A reasonable examiner would have considered the teachings of the Church 1993 reference to be important in determining whether or not the claims of the '740 patent were patentable. As detailed below and in the claim chart in Exhibit 11, the Church 1993 reference either anticipates or, in combination with other patents and printed publications, renders obvious claims 1-3, 6, and 11-17 of the '740 patent. For this reason, the Church 1993 reference raises a

substantial new question of patentability with respect to claims 1-3, 6, and 11-17 of the '740 patent.

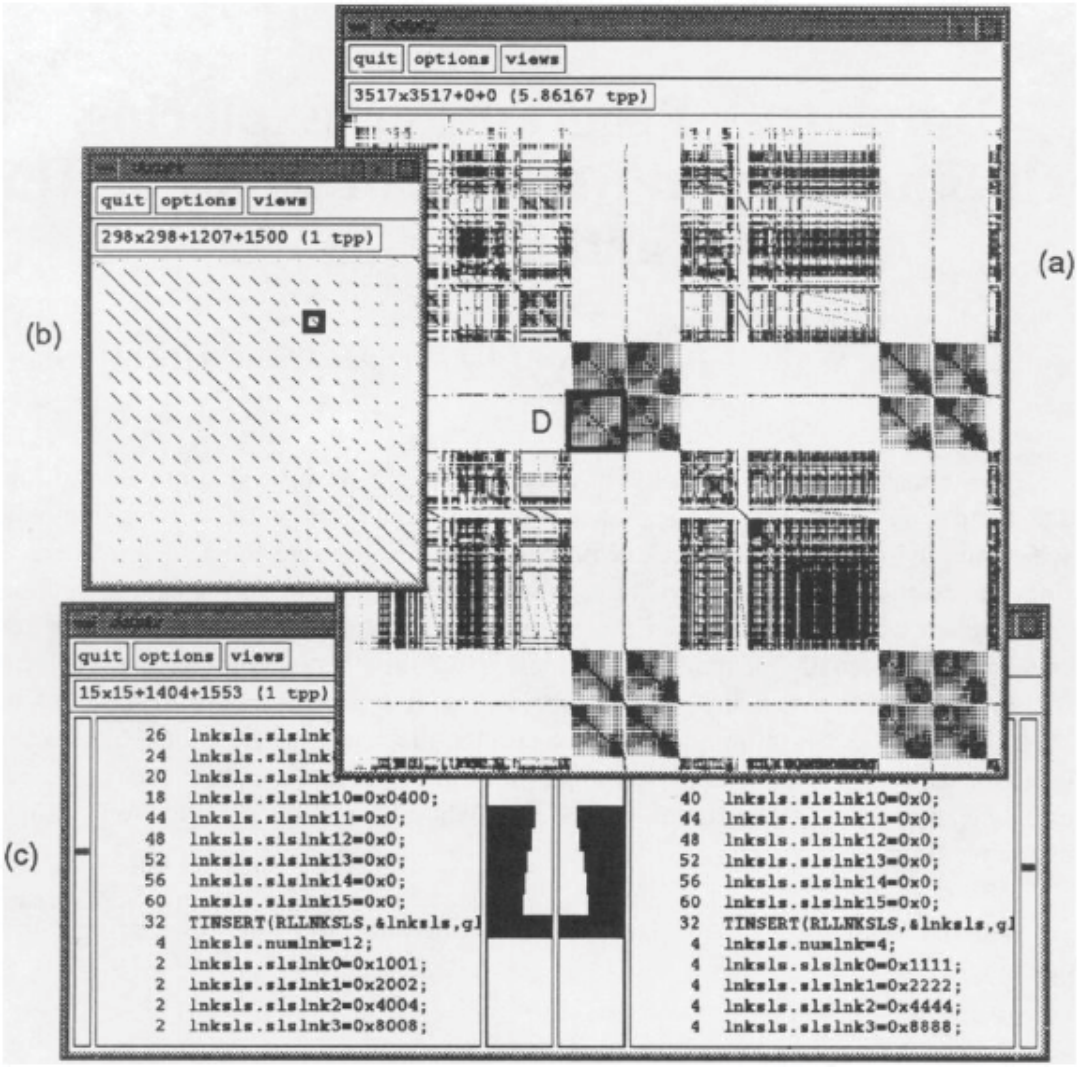


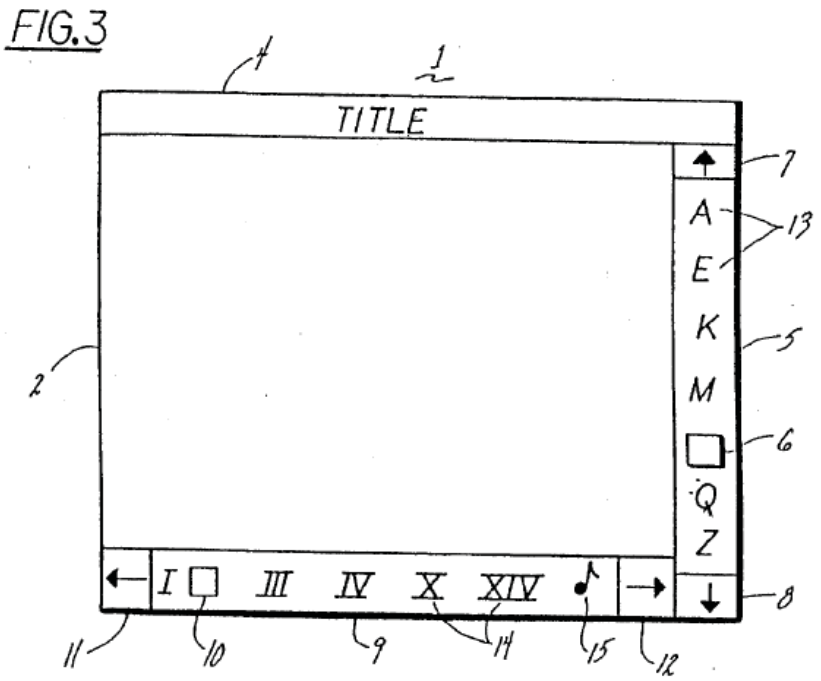
Figure 1. Dotplot Browser.

Cina '808 patent. U.S. Patent No. 5,510,808 to Cina Jr. et al., which issued Apr. 23, 1996 from an application filed Jan. 31, 1995 and which claims priority to an application filed May 31, 1990 (the "Cina '808 patent"), provided as Exhibit 3, discloses a scrollbar depicting specific information about information in the presentation window adjacent to the scroll bar. *See*

Cina ‘808 patent, Abstract. Since the Cina ‘808 patent issued Apr. 23, 1996 from an application with a filing date for the purposes of 35 U.S.C. § 102(e) of May 31, 1990, it is prior art to the ‘740 patent under 35 U.S.C. § 102(a) or 102(e), given a priority date for the ‘740 patent of Jun. 3, 1996. To the extent that any of the claims of the ‘740 patent is entitled to the earlier priority date of the parent patent application for the application that matured into the ’740 patent, then the Cina ‘808 patent is prior art under 35 U.S.C. § 102(e) for such claims. The Cina ‘808 patent was not in front of the Patent Office during the prosecution of the application that matured into the ‘740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the ‘740 patent.

Figure 3 of the Cina ‘808 patent depicts a representative presentation window from a computer application. The image includes horizontal and vertical scroll bars. “In accordance with the invention the user of the system is enabled, via the location information within the scrollbars 5 and 9, to rapidly position the horizontal slider 10 and/or the vertical slider 6 to move the window 2 to within a desired region of the larger presentation space 1.” Cina ‘808 patent, 4:38:42. In the disclosed embodiment of Figure 3, the symbols provide an indication of information in the presentation space, such as text. For example, “***[s]earch 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. As a result, the user is enabled to selectively choose which occurrences to view within the window.” Cina ‘808 patent, 5:48-55 (emphasis added). As seen in Figure 3, the representation of the text on the scroll bar does not use any readable words.

As discussed above in Section II.G, the Patent Owner asserts that the ***exact*** same configuration as disclosed in the Cina '808 patent (a scroll bar that indicates the occurrences of search hits in adjacent text but where the scroll bar itself has no readable words) infringes claim 1 of the '740 patent. Given this construction that the Patent Owner has applied to its own claim language, the Cina '808 patent alone raises a substantial new question of patentability as to claim 1. Further, the Cina '808 patent, in combination with other prior art references raise a substantial new question of patentability as to claims 1-6 and 12-17. A reasonable examiner would have considered the teachings of the Cina '808 patent to be important in determining whether or not the claims of the '740 patent were patentable. A detailed comparison of the Cina '808 patent, alone or in combination with other prior art patents and printed publications, with the claims of the '740 patent is provided below and in the claim chart in Exhibit 12.



Eick ‘998 patent. U.S. Patent No. 5,945,998 to Eick, which issued Aug. 31, 1999 from an application filed Aug. 21, 1997 and which claims priority to an application filed Sep. 6, 1991 (hereinafter, the “Eick ‘998 patent”), provided as Exhibit 4, discloses techniques for displaying a representation of software code. The display uses shapes and colors to indicate features of the code. *See* Eick ‘998 patent, Abstract. Since the Eick ‘998 patent has a filing date, for the purposes of 35 U.S.C. § 102(e), of Sep. 6, 1991, it is prior art to the ‘740 patent under 35 U.S.C. § 102(e), regardless of whether the ‘740 patent is entitled to a priority date of the parent application to the application that matured into the ‘740 patent. The Eick ‘998 patent was not in front of the Patent Office during the prosecution of the application that matured into the ‘740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the ‘740 patent.

Figure 2 of the Eick ‘998 patent, reproduced below, provides an exemplary display from an implementation of the disclosed technique. The display depicts columns, with each column representing a file containing computer code. The relative lengths of each column corresponds to a feature of each file -- the number of lines contained in the file. In this way, the disclosed process in the Eick ‘998 patent identifies a feature of the file (number of lines) and provides a representation of the code indicating the presence of that feature. *See* Eick ‘998 patent 4:66-7:15 (describing Fig. 2). As the Eick ‘998 patent discloses, other features of the code can be depicted on the representation. *See id.*

Fig. 15 of the Eick ‘998 patent discloses displaying information about a body of text on a scroll bar adjacent to the text. One such application is the results of a word search. *See* Eick ‘998 patent 22:15-20. As discussed above in Section II.G, the Patent Owner asserts that the

exact same configuration as disclosed in the Eick '998 patent infringes claim 1 of the '740 patent.

FIG. 2

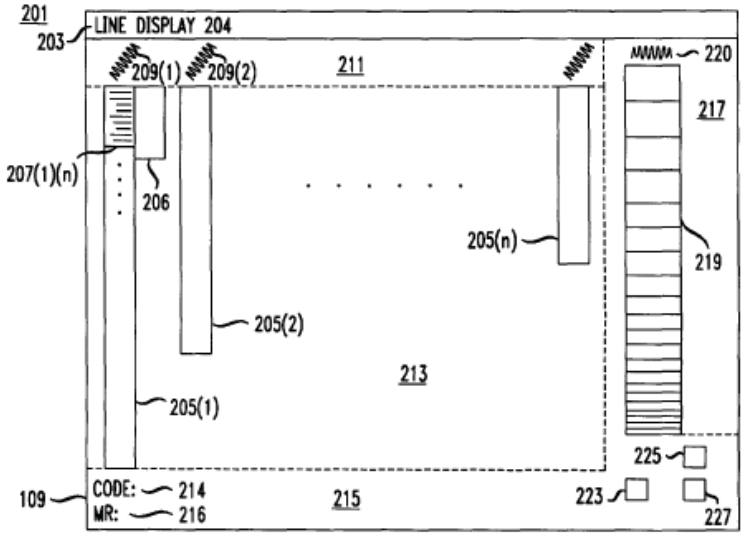
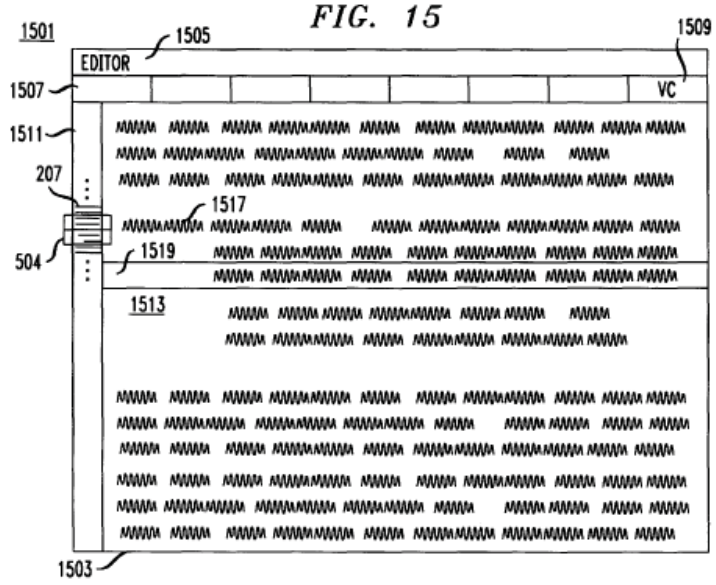


FIG. 15



A reasonable examiner would have considered the teachings of the Eick '998 patent to be important in determining whether or not the claims of the '740 patent were patentable. As detailed below and in the claim chart in Exhibit 13, the Eick '998 patent either anticipates or, in combination with other patents and printed publications, renders obvious claims 1-3, 6, and 12-

17 of the ‘740 patent. For this reason, the Eick ‘998 patent raises a substantial new question of patentability with respect to claims 1-3, 6, and 12-17 of the ‘740 patent.

Eick 1992 reference. Eick, Stephen G., Joseph L. Steffen, and Eric E. Summer Jr. *Seesoft - A Tool for Visualizing Line Oriented Software Statistics*, IEEE TRANSACTIONS ON SOFTWARE ENG’G, VOL. 18, NO. 11 (Nov. 1992), pp. 957-968 (hereinafter, the “Eick 1992 reference”), provided as Exhibit 5, discloses the Seesoft® software package. The Seesoft® software package provides a representation of computer code files. *See* Eick 1992 reference, Abstract. The Eick 1992 reference published in November 1992, making it prior art under 35 U.S.C. § 102(b), regardless of whether the ‘740 patent is entitled to a priority date of the parent application to the application that matured into the ‘740 patent. The Eick 1992 reference was not in front of the Patent Office during the prosecution of the application that matured into the ‘740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the ‘740 patent.

Figure 3 from the Eick 1992 reference is reproduced below. As can be seen from this representation, a vertical bar represents a computer code file and represents features of that file. In this embodiment, the colors are used to indicate the relative age of each line of code making up the file. That is, the representation indicates the identified feature of age of code line. *See* Eick 1992 reference at 960. The Eick 1992 reference further discloses that the Seesoft® tool could be used to analyze a corpus of text. *See* Eick 1992 reference at 963 (“For example, one possible application would be to display a text corpus such as the Bible. Each book could be represented as a column and each verse as a row. A subject index or the age of each verse could be used to color the rows.”).

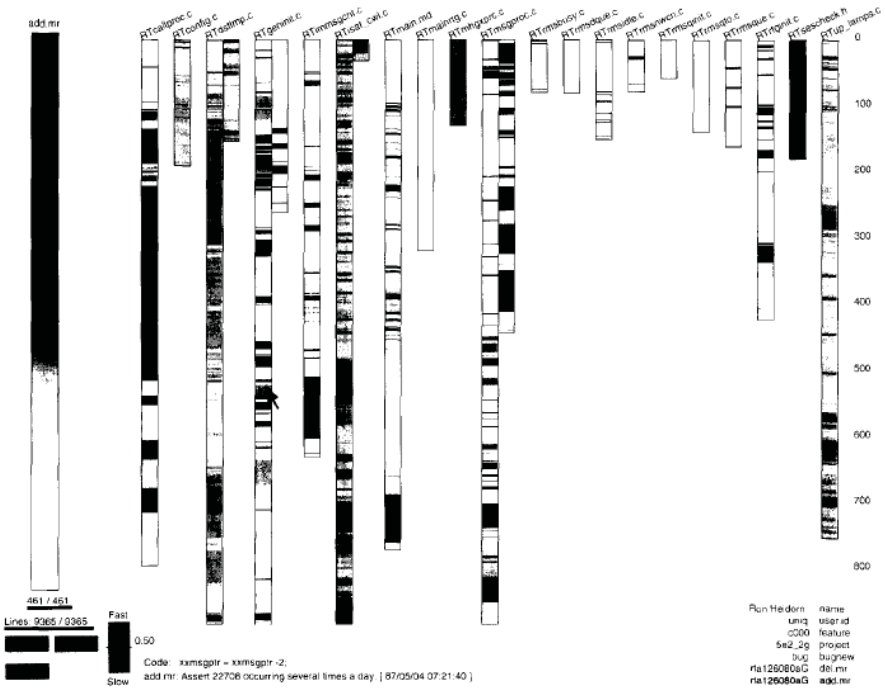


Fig. 3, Eick 1992 reference

A reasonable examiner would have considered the teachings of the Eick 1992 reference to be important in determining whether or not the claims of the ‘740 patent were patentable. As detailed below and in the claim chart in Exhibit 14, the Eick 1992 reference either anticipates or, in combination with other patents and printed publications, renders obvious claims 1-3, 6, and 12-17 of the ‘740 patent. For this reason, the Eick 1992 reference raises a substantial new question of patentability with respect to claims 1-3, 6, and 12-17 of the ‘740 patent.

Gould ‘588 patent. U.S. Patent No. 5,623,588 to Gould, which issued Apr. 22, 1997 from an application filed Dec. 14, 1992 (hereinafter, the “Gould ‘588 patent”), provided as Exhibit 6, discloses a process that varies the density or other appearance of a scroll bar for a computer application as the document salience varies. *See* Gould ‘588 patent, Abstract. Since the Gould ‘588 patent has a filing date, for the purposes of 35 U.S.C. § 102(e), of Dec. 14, 1992,

it is prior art to the ‘740 patent under 35 U.S.C. § 102(e), regardless of whether the ‘740 patent is entitled to a priority date of the parent application to the application that matured into the ‘740 patent. The Gould ‘588 patent was not in front of the Patent Office during the prosecution of the application that matured into the ‘740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the ‘740 patent.

Figure 11 of the Gould ‘588 patent, reproduced below, depicts an exemplary embodiment. The scroll bar provides an indication of a certain feature of the text, in this case highlighted text. As can be seen in the three separate screens, the indication on the scroll bar (the ovals) increase in size when the amount of highlighted text in the display area increases. The scroll bar itself does not have any text. *See* Gould ‘588 patent, Fig. 11 and accompanying text (5:65-6:28).

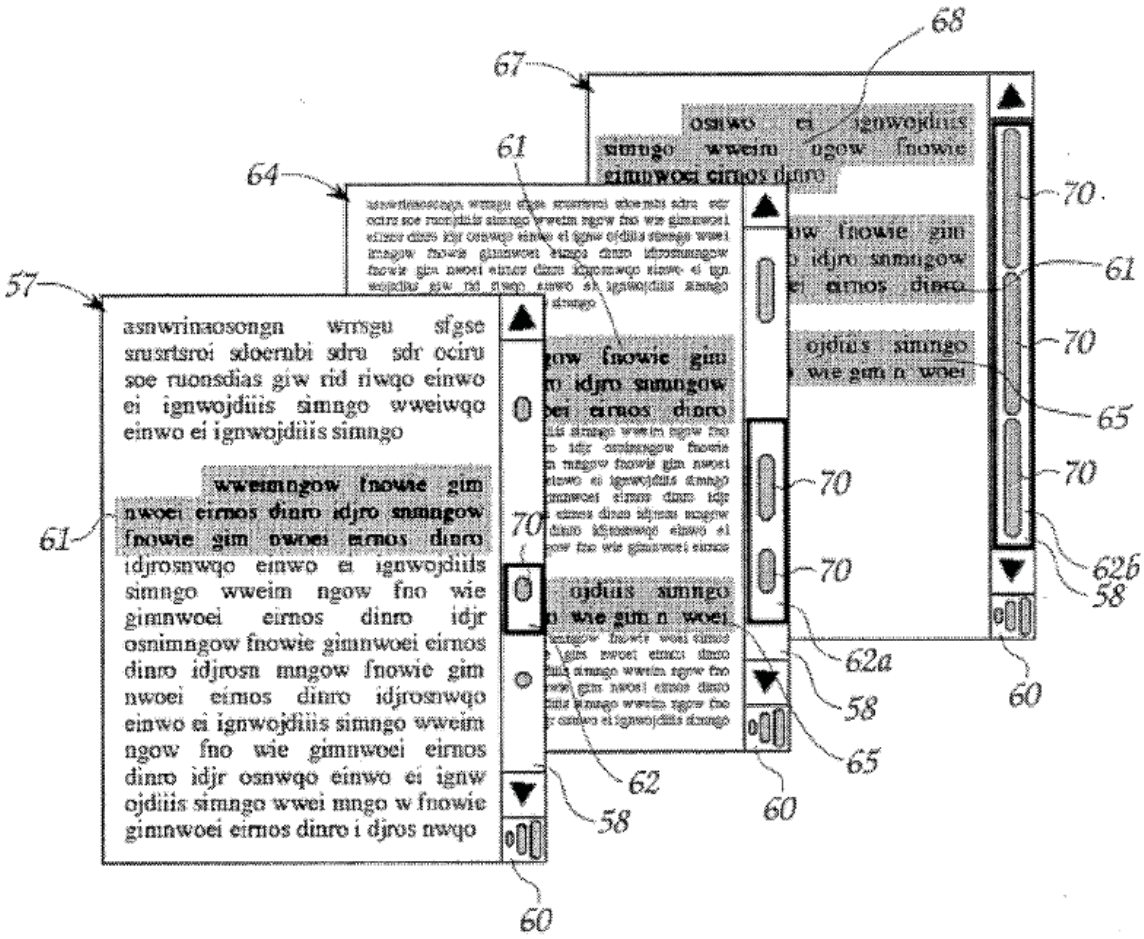


Fig. 11, Gould ‘588 patent

As discussed above in Section II.G, the Patent Owner asserts that a scroll bar that indicates the occurrences of search hits in adjacent text but where the scroll bar itself has no readable words infringes claim 1 of the ‘740 patent. Given this construction that the Patent Owner is applied to its own claim language, the Gould ‘588 patent alone raises a substantial new question of patentability as to claim 1. Further, the Gould ‘588 patent, in combination with other prior art references raise a substantial new question of patentability as to claims 1-6, and 12-15. A reasonable examiner would have considered the teachings of the Gould ‘588 patent to be important in determining whether or not the claims of the ‘740 patent were patentable. A

detailed comparison of the Gould '588 patent, alone or in combination with other prior art patents and printed publications, with the claims of the '740 patent is provided below and in the claim chart in Exhibit 15.

Kozima 1993 reference. Kozima, Hideki. *Text Segmentation Based on Similarity Between Words*, Proceedings of the 31st Annual Meeting of the Association for Computational Linguistics, Columbus, OH (Jun. 1993), pp. 286-288 (hereinafter, the "Kozima 1993 reference"), provided as Exhibit 7, discloses a process that produces an indicator of text structure, specifically segment boundaries in the text. *See* Kozima 1993 reference, Abstract. Since the Kozima 1993 reference was published in June 1993 it is prior art to the '740 patent under 35 U.S.C. § 102(b), given a priority date for the '740 patent of Jun. 3, 1996. To the extent that any of the claims of the '740 patent is entitled to the earlier priority date of the parent patent application for the application that matured into the '740 patent, then the Kozima 1993 reference is prior art under 35 U.S.C. § 102(a) for such claims. The Kozima 1993 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

As the Kozima 1993 reference discloses, text often includes a coherent structure (such as sentences, paragraphs, etc.). *See* Kozima 1993 reference at 286. The Kozima 1993 reference discloses a representation of a text including an indication of the text feature of segment boundaries. Figure 3 of the Kozima 1993 reference, reproduced below, provides the results of the computer-based method that produces a representation of text, where the "valleys" in the representation represent the feature of a segment boundary. Similarly, Figure 1 of the Kozima

1993 reference, reproduced below, provides a three-dimensional representation of the similarity of words in a text.

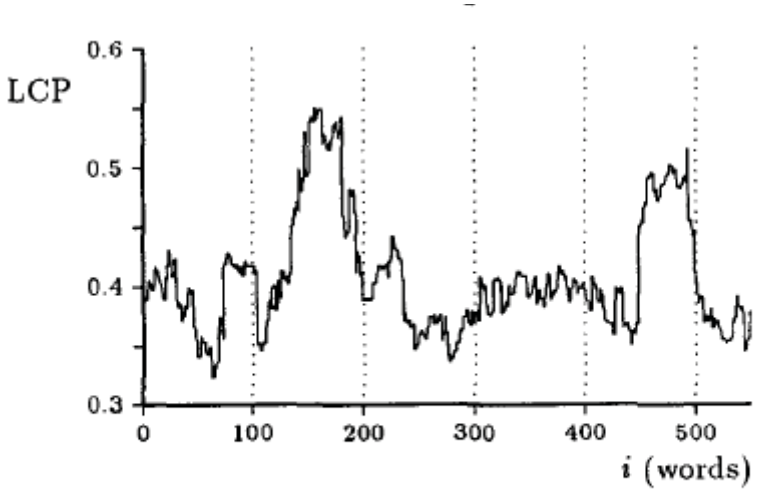


Figure 3. An example of LCP
(using rectangular window of Δ=25)

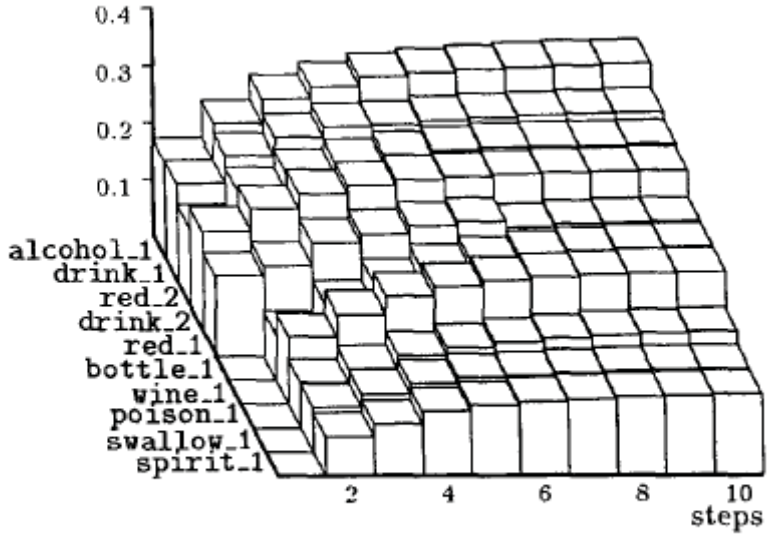


Figure 1. An activated pattern of a word list
(produced from {**red**, **alcoholic**, **drink**}).

A reasonable examiner would have considered the teachings of the Kozima 1993 reference to be important in determining whether or not the claims of the '740 patent were

patentable. As detailed below and in the claim chart in Exhibit 16, the Kozima 1993 reference either anticipates or, in combination with other patents and printed publications, renders obvious claims 1 and 12-15 of the '740 patent. For this reason, the Kozima 1993 reference raises a substantial new question of patentability with respect to claims 1 and 12-15 of the '740 patent.

Brill 1992 reference. Brill, Eric. *A Simple Rule-Based Part of Speech Tagger*, Speech and Natural Language: Proceedings of a Workshop held at Harriman, New York, Feb. 23-26, 1992, pp. 112-116 (hereinafter, the "Brill 1992 reference"), provided as Exhibit 8, discloses a computer-based process for tagging parts of speech (nouns, verbs, …) in a body of text. *See* Brill 1992 reference at 112. The Brill 1992 reference published in February 1992, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Brill 1992 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The Brill 1992 reference discloses a computer-based algorithm that can search through a body of text and identify the parts of speech of each word. *See* Brill 1992 reference at 112. A reasonable examiner would have considered the teachings of the Brill 1992 reference to be important in determining whether or not the claims of the '740 patent were patentable. As detailed below and in the claim charts in Exhibits 11-16, the Brill 1992 reference, in combination with other patents and printed publications, renders obvious claims 2, 3, and 6 of the '740 patent. These claims recite limitations about identifying the most common nouns in a passage. For this reason, the Brill 1992 reference, in combination with other prior art references, raises a substantial new question of patentability with respect to claims 2, 3, and 6 of the '740 patent.

Church 1988 reference. Church, Kenneth Ward. *A Stochastic Parts Program and Noun Phrase Parser for Unrestricted Text*, Proceedings of the Second Conference on Applied Natural Language Processing, Austin, TX, Feb. 9-12, 1988, pp. 136-143 (hereinafter, the "Church 1988 reference"), provided as Exhibit 10, discloses a computer-based process for tagging parts of speech (nouns, verbs, …) in a body of text. *See* Church 1988 reference at 136. The Church 1988 reference published in February 1988, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Church 1988 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The Church 1988 reference discloses a computer-based algorithm that can search through a body of text and identify the parts of speech of each word. *See* Church 1988 reference at 136. A reasonable examiner would have considered the teachings of the Church 1988 reference to be important in determining whether or not the claims of the '740 patent were patentable. As detailed below and in the claim charts in Exhibits 11-16, the Church 1988 reference, in combination with other patents and printed publications, renders obvious claims 2, 3, and 6 of the '740 patent. These claims recite limitations about identifying the most common nouns in a passage. For this reason, the Church 1988 reference, in combination with other prior art references, raises a substantial new question of patentability with respect to claims 2, 3, and 6 of the '740 patent.

Church 1990 reference. Church, Kenneth Ward. *Word Association Norms, Mutual Information, and Lexicography*, Computational Linguistics, Vol. 16, No. 1 (Mar. 1990), pp. 22-

29 (hereinafter, the "Church 1990 reference"), provided as Exhibit 10, discloses a computer-based process for identifying related words in a body of text. *See* Church 1990 reference at 22. The Church 1990 reference published in March 1990, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Church 1990 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The Church 1990 reference discloses a computer-based algorithm that can search through a body of text and identify the location of associated words (e.g., doctor and nurse, bread and butter, …). *See* Church 1990 reference at 23. A reasonable examiner would have considered the teachings of the Church 1990 reference to be important in determining whether or not the claims of the '740 patent were patentable. As detailed below and in the claim charts in Exhibits 11-16, the Church 1990 reference, in combination with other patents and printed publications, renders obvious claim 15 of the '740 patent. This claim recites a limitation about identifying words having the same general meaning. For this reason, the Church 1990 reference, in combination with other prior art references, raises a substantial new question of patentability with respect to claim 15 of the '740 patent.

III. DETAILED EXPLANATION UNDER 37 C.F.R. § 1.510(B)(2) OF THE PERTINENCY AND MANNER OF APPLYING THE CITED PRIOR ART TO EVERY CLAIM FOR WHICH REEXAMINATION IS REQUESTED

The detailed explanation herein under 37 C.F.R. § 1.510(b)(2) comprises a summary of the reasons for unpatentability of the claims (set forth below) supported by detailed Claim Charts

(Exhibits 11-16). This detailed explanation describes the pertinence and manner of applying the prior art references to the claims of the '740 patent.

A. Rejections of Claims

1. Claims 1, 11, 13, 14, 16, and 17 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Church 1993 reference.

The Church 1993 reference was published in June 1993. The printed publication is prior art to the '740 patent under 35 U.S.C. § 102(b), given a priority date for the '740 patent of Jun. 3, 1996. To the extent that any of the claims of the '740 patent is entitled to the earlier priority date of the parent patent application for the application that matured into the '740 patent (Jan. 18, 1994), then the Church 1993 reference is prior art under 35 U.S.C. § 102(a) for such claims. The Church 1993 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

Claim 1

The preamble of claim 1[6] recites **"[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**." The Church 1993 reference discloses 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. *See, e.g.,* Church 1993 reference at 1 ("An interactive program, *dotplot*, has been developed for browsing millions of lines of text and source code, using an approach borrowed from biology for studying

[6] This Request provides an analysis of the preamble of the two independent claims of the '740 patent, claims 1 and 13. By including this analysis, the Requester is not necessarily contending that the preamble is limiting.

homology (self-similarity) in DNA sequences." … "Figure 1 shows the browser in action. Three views of a source code file are presented: (a) a global overview of the file in the upper right, (b) a magnified view of a small portion of the file in the upper left, and (c) a text view along the bottom. The views are linked together so that clicking and scrolling in one view updates the others appropriately." Figure 1 of the Church 1993 reference:

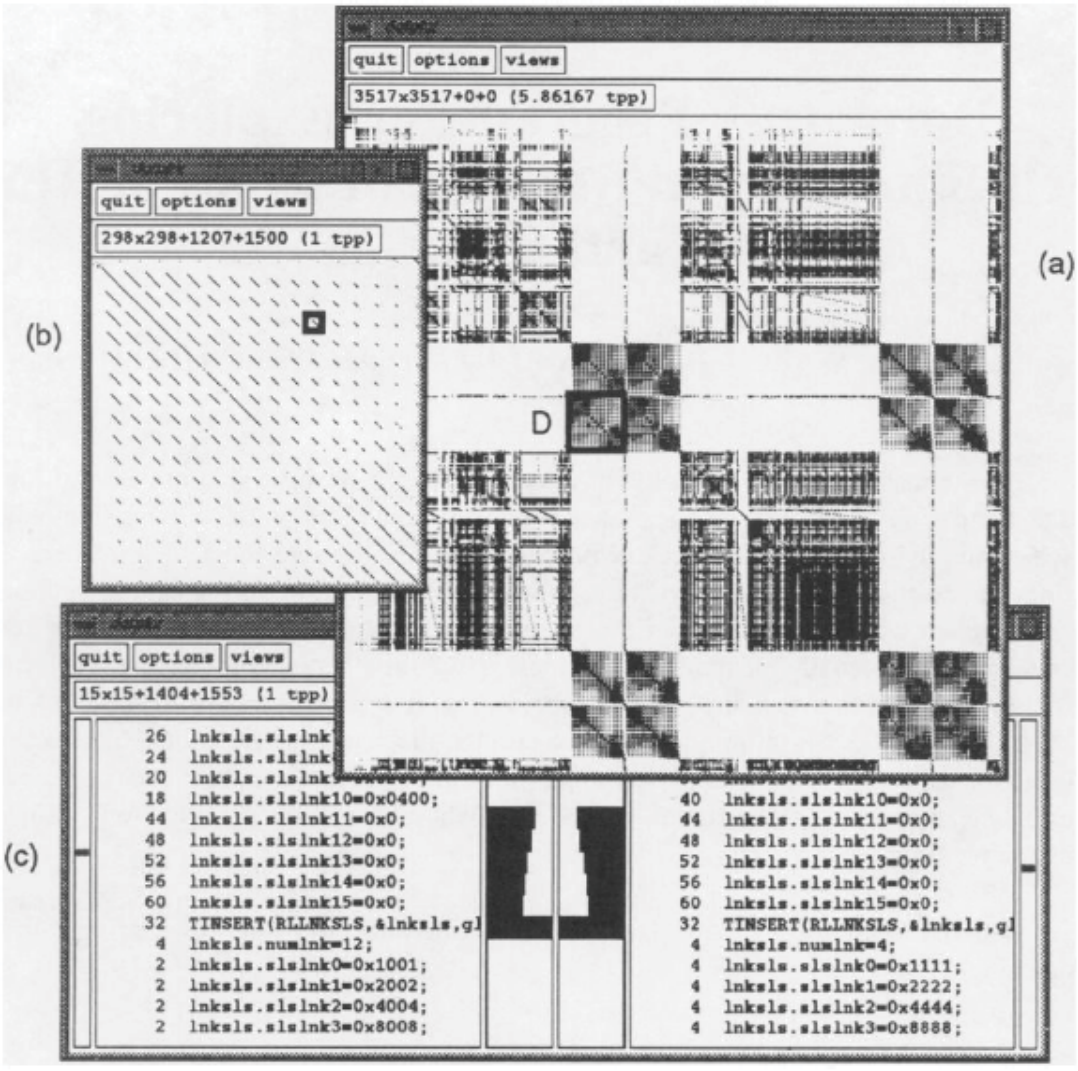


Figure 1. Dotplot Browser.

Claim element [1a] recites "**identifying at least one feature contained within at least a portion of said text**." The method disclosed in the Church 1993 reference identifies at least one feature contained within at least a portion of a source text, such as a body of text or linens of computer code. *See, e.g.*, Church 1993 reference at 3 ("Figure 5 is a dotplot of 37 million words of Canadian Hansards, parliamentary debates, which are available in both English and French. The input is constructed by concatenating three years of debates in English (37/2 million words) followed by the French equivalent (the remaining 37/2 million words). Consequently, there is a lag of approximately 37/2 million words between an English sentence and its French translation. Thirty-seven million is such a large amount of data that the dots in Figure 5 represent the relative number of matches per pixel, rather than the existence or non-existence of a particular match."). Figure 5 of the Church 1993 reference identifies matches between an English text and its French translation. Figure 5 of the Church 1993 reference shows:

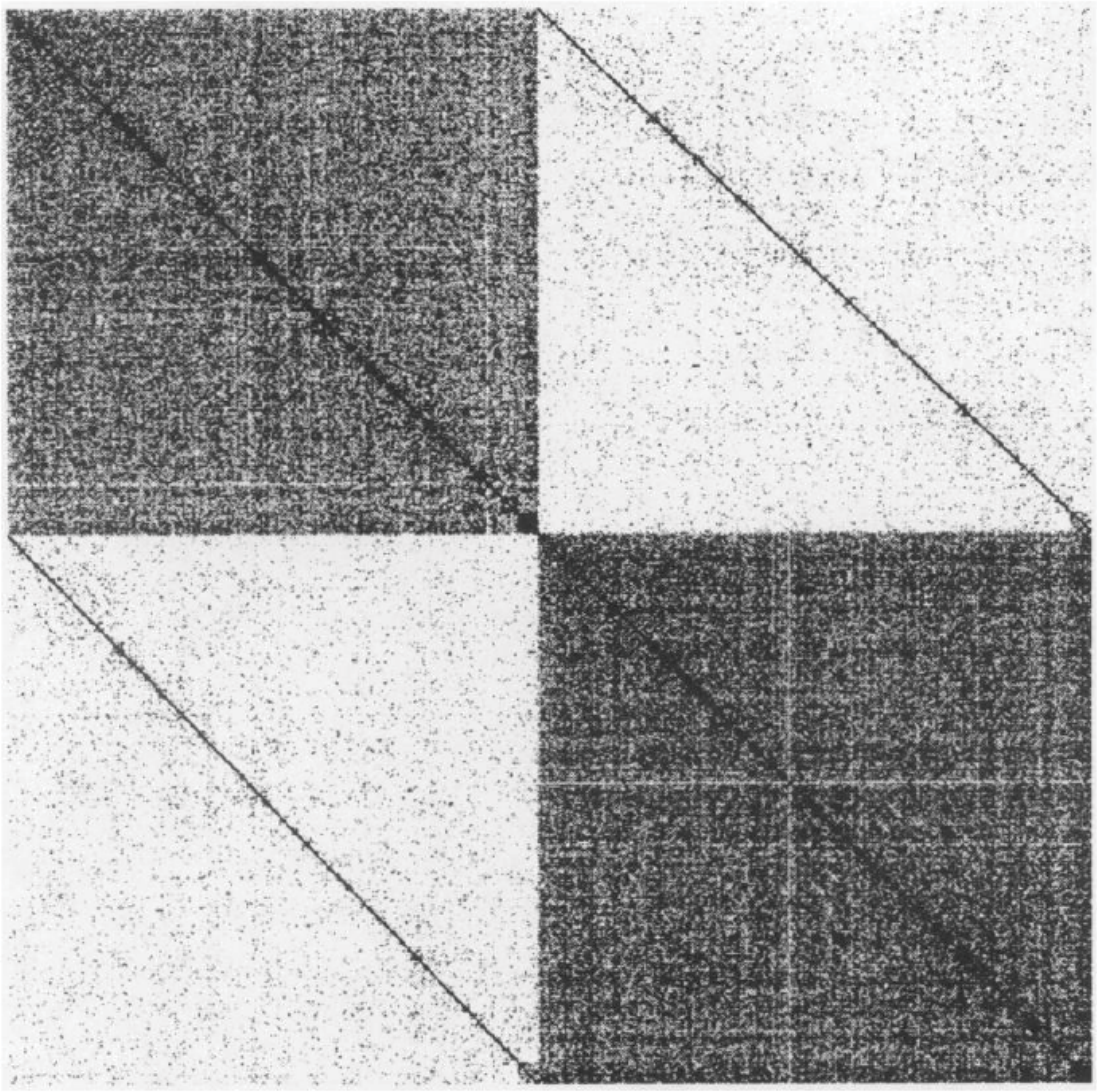


Figure 5. Three Years of Hansards (37 million words).

Claim element [1b] recites "**creating at least one representation of said portion of said text**." The method disclosed in the Church 1993 reference creates a representation of a body of text. *See, e.g.*, Church 1993 reference at 3 (discussing a dotplot representation of 37 million words of Canadian parliament argument, in English and French, as depicted in Fig. 5 of the Church 1993 reference); *see also*, Church 1993 reference at Fig. 5 (shown above).

Claim element [1c] recites" **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 method disclosed in the Church 1993 reference generates a representation of a body of text without any readable words. The representation does indicate the presence of a feature of the text body. *See, e.g.*, Church 1993 reference at 3 ("Figure 5 is a dotplot of 37 million words of Canadian Hansards, parliamentary debates, which are available in both English and French. The input is constructed by concatenating three years of debates in English (37/2 million words) followed by the French equivalent (the remaining 37/2 million words). Consequently, there is a lag of approximately 37/2 million words between an English sentence and its French translation. Thirty-seven million is such a large amount of data that the dots in Figure 5 represent the relative number of matches per pixel, rather than the existence or non-existence of a particular match."). Figure 5 of the Church 1993 reference identifies matches between an English text and its French translation. Figure 5 of the Church 1993 reference is presented above. The depicted feature is matching words in the text body, including incidents when the English and French words correspond (dots in the upper right and lower left quadrants of the dotplot).

Accordingly, claim 1 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Church 1993 reference. Please see the Claim Chart at Exhibit 11 for additional details.

Claim 11

Claim 11 recites "**[t]he method according to claim 1, wherein said step of creating at least one representation of said portion of said text includes the substeps of: reducing said**

portion of said text to an illegible size;" and "**displaying the reduced text in an uninterrupted format on a common backing**." The Church 1993 reference discloses creating an image displaying all of the text as a single image. For example, Figure 5 of the Church 1993 reference depicts a dotplot comparing the texts of 37 million words in French and English in a reduced (illegible) size. Figure 5 of the Church 1993 reference is depicted above, in connections with the analysis of claim 1. The Church 1993 reference discloses reducing the portion of text to illegible size. For example, Figure 5 of the Church 1993 reference depicts a dotplot a comparison the texts of 37 million words in French and English in an uninterrupted format on a common backing.

Accordingly, claim 11 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Church 1993 reference. Please see the Claim Chart at Exhibit 11 for additional details.

Claim 13

The preamble of claim 13 recites **"[a] method of producing a representation of text contained within a document to enable a person to obtain some comprehension of said text without reading said text**. The Church 1993 reference discloses 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. *See, e.g.,* Church 1993 reference at 1 ("An interactive program, *dotplot*, has been developed for browsing millions of lines of text and source code, using an approach borrowed from biology for studying homology (self-similarity) in DNA sequences." … "Figure 1 shows the browser in action. Three views of a source code file are presented: (a) a global overview of the file in the upper right, (b) a magnified view of a small portion of the file in the upper left, and (c) a text view along the bottom. The views are linked together so that clicking

and scrolling in one view updates the others appropriately." Figure 1 of the Church 1993 reference:

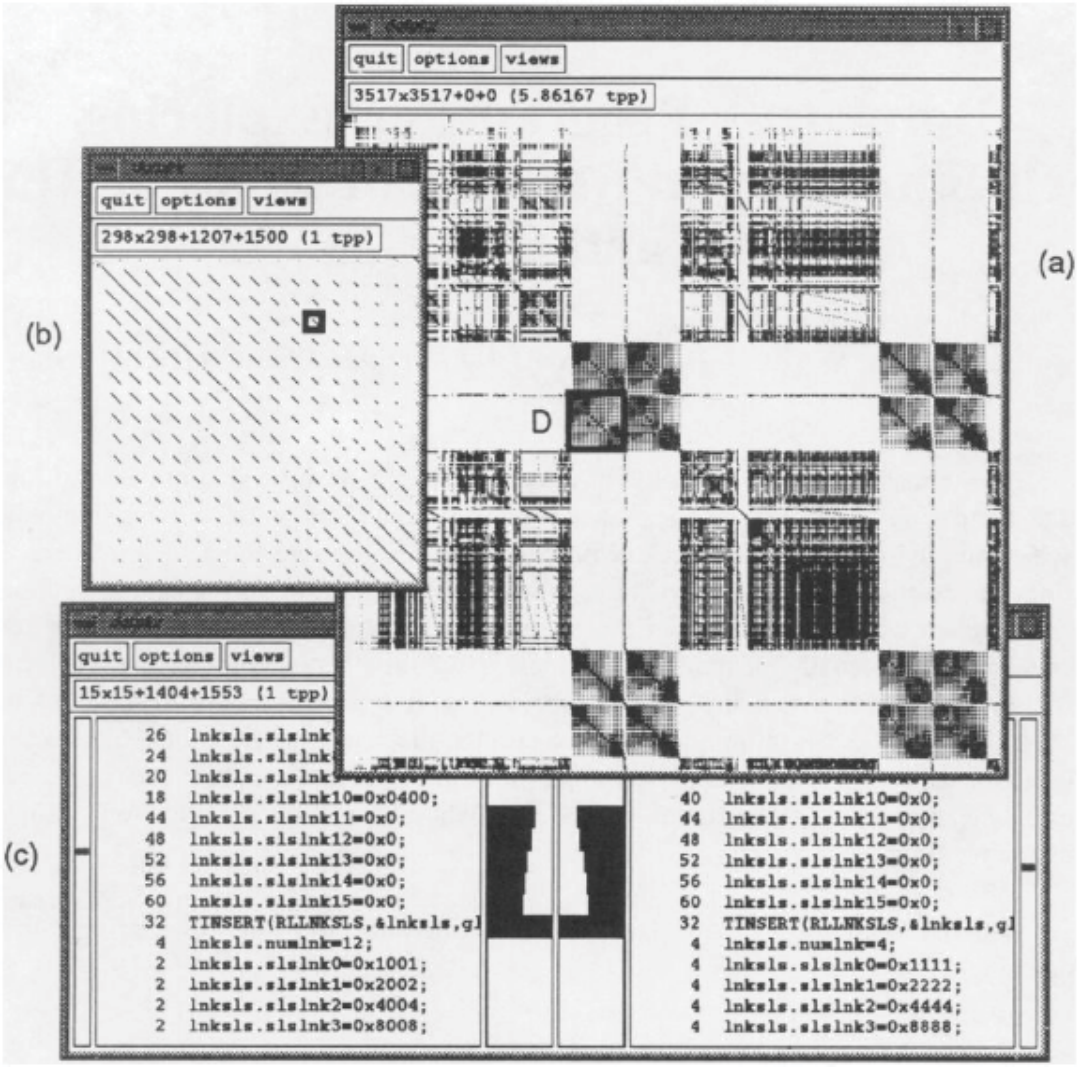


Figure 1. Dotplot Browser.

Claim element [13a] recites "**creating an image of said text wherein individual words of said text are not discernable within said image**." The method disclosed in the Church 1993 reference creates a representation of a body of text where words are not discernable. *See, e.g.*, Church 1993 reference at 3 (discussing a dotplot representation of 37 million words of Canadian

parliament argument, in English and French, as depicted in Fig. 5 of the Church 1993 reference); *see also*, Church 1993 reference at Fig. 5 (shown below):

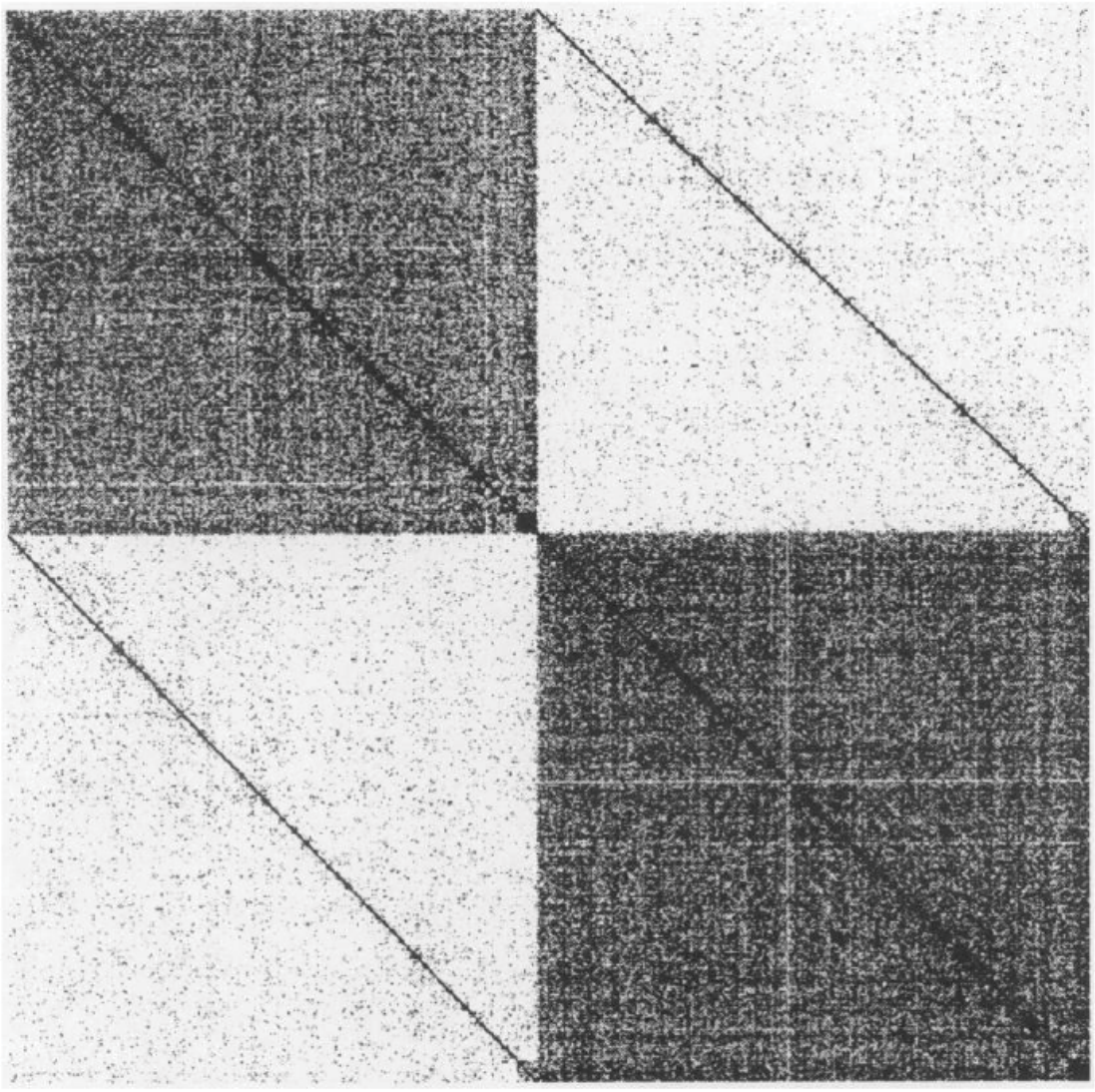


Figure 5. Three Years of Hansards (37 million words).

As can be seen in Figure 5 of the Church 1993 reference, no discernable words can be seen in the dotplot.

Claim element [13b] recites "**identifying at least one textual feature contained within said text**." The method disclosed in the Church 1993 reference identifies at least one feature contained within a source text, such as a body of text or linens of computer code. *See, e.g.*, Church 1993 reference at 3 ("Figure 5 is a dotplot of 37 million words of Canadian Hansards, parliamentary debates, which are available in both English and French. The input is constructed by concatenating three years of debates in English (37/2 million words) followed by the French equivalent (the remaining 37/2 million words). Consequently, there is a lag of approximately 37/2 million words between an English sentence and its French translation. Thirty-seven million is such a large amount of data that the dots in Figure 5 represent the relative number of matches per pixel, rather than the existence or non-existence of a particular match."). Figure 5 of the Church 1993 reference identifies matches between an English text and its French translation. Figure 5 of the Church 1993 is provided above.

Claim element [13c] recites "**illustrating on said image the areas of said text that contain said at least one textual feature**. The method disclosed in the Church 1993 reference generates a representation of a body of text illustrating the textual feature. *See, e.g.*, Church 1993 reference at 3 ("Figure 5 is a dotplot of 37 million words of Canadian Hansards, parliamentary debates, which are available in both English and French. The input is constructed by concatenating three years of debates in English (37/2 million words) followed by the French equivalent (the remaining 37/2 million words). Consequently, there is a lag of approximately 37/2 million words between an English sentence and its French translation. Thirty-seven million is such a large amount of data that the dots in Figure 5 represent the relative number of matches per pixel, rather than the existence or non-existence of a particular match."). Figure 5 of the Church 1993 reference identifies matches between an English text and its French translation.

Figure 5 of the Church 1993 reference is presented above. The depicted feature is matching words in the text body, including incidents when the English and French words correspond (dots in the upper right and lower left quadrants of the dotplot).

Accordingly, claim 13 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Church 1993 reference. Please see the Claim Chart at Exhibit 11 for additional details.

Claim 14

Claim 14 recites "**[t]he method according to claim 13, wherein said step of creating an image includes displaying all of said text as a single image**." The Church 1993 reference discloses creating an image displaying all of the text as a single image. For example, Figure 5 of the Church 1994 reference depicts a dotplot comparing the texts of 37 million words in French and English in a single image. Figure 5 of the Church 1993 reference is provide above, in connection with the analysis for claim 13.

Accordingly, claim 14 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Church 1993 reference. Please see the Claim Chart at Exhibit 11 for additional details.

Claim 16

Claim 16 recites "**[t]he method according to claim 13, wherein said step of identifying at least one textual feature includes identifying multiple textual features**." The Church 1993 reference discloses identifying multiple textual features. For example, Figure 8 of the Church 1993 reference depicts a dotplot comparing the translations of a Microsoft® manual in seven different languages in a single image. The image depicts multiple textual features including: words from two texts are the same, words from two texts are different, and words

from two texts are not the same, but are similar. *See* Church 1993 reference at 160-61. Figure 8 of the Church 1993 reference is depicted below:

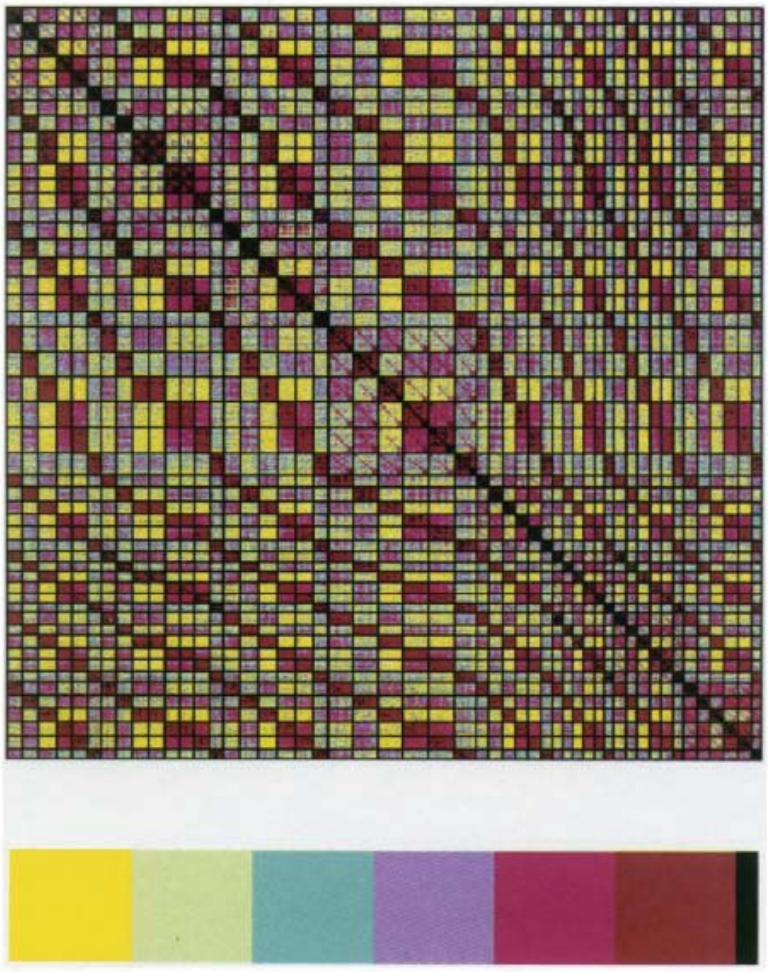


Figure 8. Six Chapters of Microsoft Manuals in Seven Languages (3.3 Million Words) With Color Map.

Accordingly, claim 16 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Church 1993 reference. Please see the Claim Chart at Exhibit 11 for additional details.

Claim 17

Claim 17 recites "**[t]he method according to claim 16, wherein said step of illustrating on said image the areas of said text that contain said at least one textual feature includes illustrating the areas of said text that contain at least two of said textual features**." The Church 1993 reference discloses illustrating the areas of text that contain at least two textual features. For example, Figure 8 of the Church 1993 reference depicts a dotplot comparing the translations of a Microsoft® manual in seven different languages in a single image. The image depicts multiple textual features including: words from two texts are the same, words from two texts are different, and words from two texts are not the same, but are similar. *See* Church 1993 reference at 160-61. The images are arranged such that the relative location of the image is associated with the location of words in the text. Figure 8 of the Church 1993 reference is provided above, in connection with the analysis of claim 16.

Accordingly, claim 17 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Church 1993 reference. Please see the Claim Chart at Exhibit 11 for additional details.

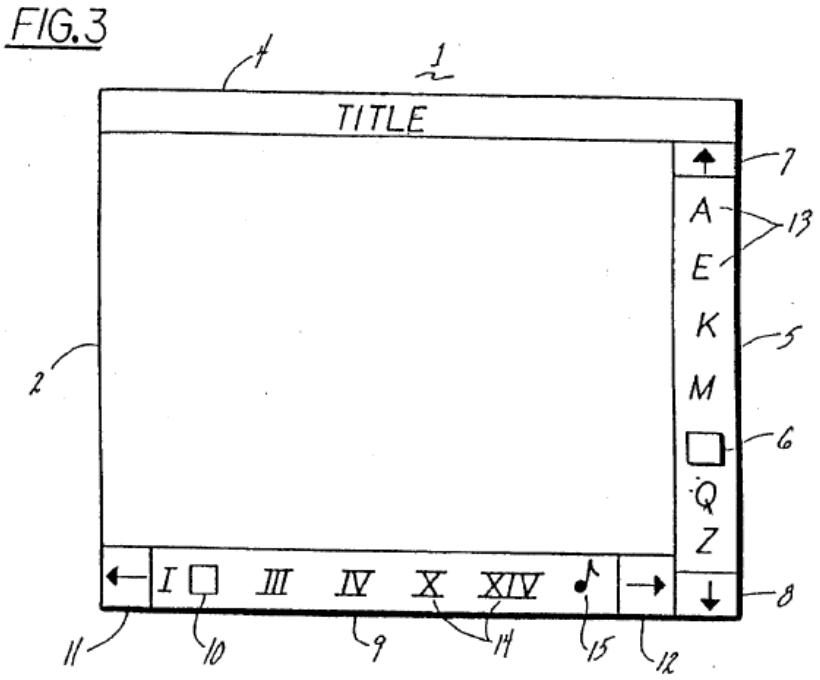
2. Claims 1, 13, 14, 16, and 17 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Cina '808 patent.

The Cina '808 patent issued Apr. 23, 1996 from an application with a filing date for the purposes of 35 U.S.C. § 102(e) of May 31, 1990. The Cina '808 patent is prior art to the '740 patent under 35 U.S.C. § 102(a) or 102(e), given a priority date for the '740 patent of Jun. 3, 1996. To the extent that any of the claims of the '740 patent is entitled to the earlier priority date of the parent patent application for the application that matured into the '740 patent (Jan. 18, 1994), then the Cina '808 patent is prior art under 35 U.S.C. § 102(e) for such claims. The Cina '808 patent was not in front of the Patent Office during the prosecution of the application that

matured into the ‘740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the ‘740 patent.

Claim 1

The preamble of claim 1 recites **“[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**.” The Cina ‘808 patent discloses 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. *See, e.g.,* Cina ‘808 patent at 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.”); *see also*, Cina ‘808 patent, Fig. 3 (depicting a presentation screen where the symbols on the scroll bar represent locations of information in a text document, such as the results of a search). Fig. 3 of the Cina ‘808 patent:



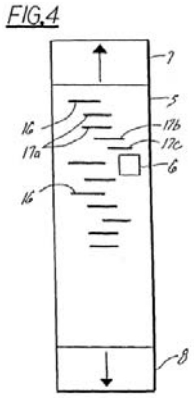
Claim element [1a] recites "**identifying at least one feature contained within at least a portion of said text**." Cina '808 patent discloses the identification of features within at least a portion of said text, such as the characteristics of a structured text file, sections of a document, or search results. *See, e.g.,* Cina '808 patent, 4:44-56 (disclosing an embodiment with linear graphic symbols indicating the location of features in adjacent text). *See also,* Cina '808 patent, 5:47-55 ("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. As a result, the user is enabled to selectively choose which occurrences to view within the window."); Fig. 3 (presented above). The symbols on the scroll bar identify features within the text.

Claim element [1b] recites "**creating at least one representation of said portion of said text**." Cina '808 patent discloses the creation of representations of portions of text, such as

selected lines of text in a presentation space, by using various colors and shapes. Cina '808 patent also discloses the creation of indicators within application scroll bars. *See, e.g.,* Cina '808 patent, 3:23-25 ("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."); *see also* Cina '808 patent, 5:47-58 ("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. As a result, the user is enabled to selectively choose which occurrences to view within the window. If the application provides for annotation of the document, location information can indicate the position of such annotation."); Fig. 3 (provided above).

Claim element [1c] recites "**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**." Cina '808 patent discloses the creation of representations of portions of text that are graphical indicators, such as various colors, shapes, symbols or images, and not readable words. Cina '808 patent also discloses the use of graphical indicators within application scroll bars. *See, e.g.*, Cina '808 patent, 3:25-28 ("The indicia may take the form of alphanumeric characters, symbols, colors, graphical images, audio information and combinations thereof."); Cina '808 patent, 5:16-18 ("It should be noted that the location information may take the form of a number representing the chapter number, a special symbol, or simply a line. Furthermore, the specific form of the location information may be user selectable or application selectable."); Cina

‘808 patent, Fig. 3 (provided above); Cina ‘808 patent; Fig. 4 (provided below, depicting horizontal marks to indicate the location of a feature in a body of text):



Further, the Cina ‘808 patent discloses exactly the same configuration as the Patent Owner contends infringes claim 1 of the ‘740 patent. The following table compares the Patent Owner’s infringement contentions to the disclosure of the Cina ‘808 patent. As can be seen from the comparison, by the Patent Owner’s own admission, the Cina ‘808 patent anticipates claim 1 of the ‘740 patent. *See* MPEP 2217 (“Admissions by the patent owner as to any matter affecting patentability may be utilized to determine the scope and content of the prior art in conjunction with patents and printed publications in a prior art rejection, whether such admissions result from patents or printed publications or from some other source.”) (emphasis omitted).

Claim 1 Claim Element	Google Chrome Web Browser Feature	Cina '808 patent Disclosure
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 scrollbar as a representation of the webpage and to show the location of hits for the search terms.	*See* Cina '808 patent at 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.").
[1a] 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.	*See* Cina '808 patent, 5:47-53 ("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.").

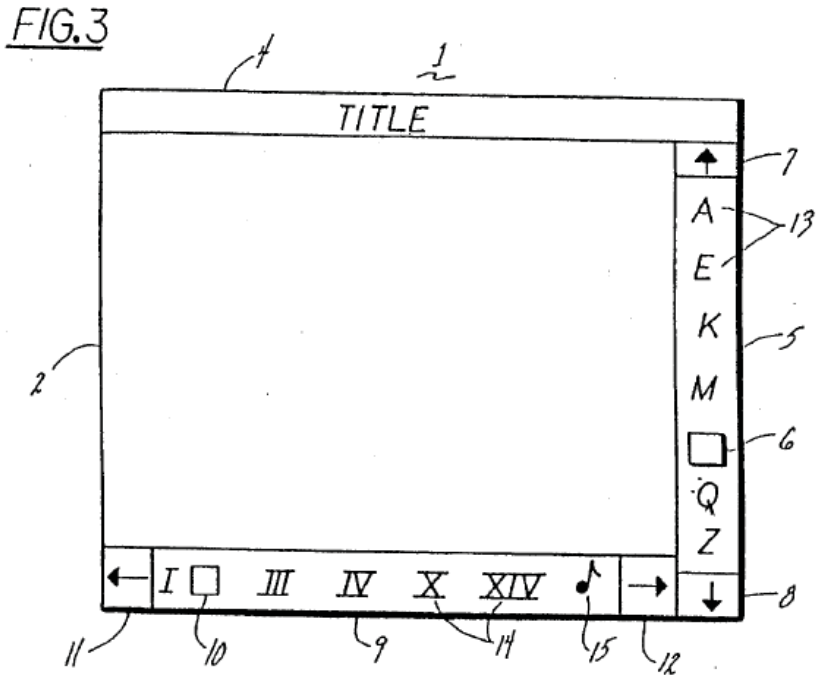
Claim 1 Claim Element	Google Chrome Web Browser Feature	Cina '808 patent Disclosure
[1b] creating at least one representation of said portion of said text,	The Chrome Web Browser uses the vertical scrollbar as a representation of the web page and to show the location of hits for the search terms.	*See* Cina '808 patent, 5:47-53 ("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.").
[1c] 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.	*See* Cina '808 patent, 3: 25-28 ("The indicia may take the form of alphanumeric characters, symbols, colors, graphical images, audio information and combinations thereof."); Fig. 4 (provided above).

Accordingly, claim 1 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Cina '808 patent. Please see the Claim Chart at Exhibit 12 for additional details.

Claim 13

The preamble of claim 13 recites **"[a] method of producing a representation of text contained within a document to enable a person to obtain some comprehension of said text without reading said text**." The Cina '808 patent discloses a method for producing a representation of text contained within a document to enable a person to obtain some

comprehension of said text without reading said text. *See, e.g.,* Cina '808 patent at 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."); s*ee also*, Cina '808 patent, Fig. 3 (depicting a presentation screen where the symbols on the scroll bar represent locations of information in a text document, such as the results of a search). Fig. 3 of the Cina '808 patent:



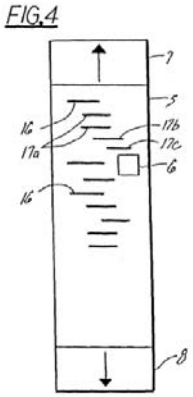
Claim element [13a] recites "**creating an image of said text wherein individual words of said text are not discernable within said image**." Cina '808 patent discloses creating representations of text, such as selected lines of text in a presentation space, by using various colors and shapes (that is, without using any discernable words of the text). Cina '808 patent also discloses the creation of indicators within application scroll bars. *See, e.g.,* Cina '808

patent, 3:23-25 ("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."); *see also* Cina '808 patent, 5:47-58 ("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. As a result, the user is enabled to selectively choose which occurrences to view within the window. If the application provides for annotation of the document, location information can indicate the position of such annotation."); Fig. 3 (provided above).

Claim element [13b] recites "**identifying at least one textual feature contained within said text**." Cina '808 patent discloses identifying textual features in a body of text, such as the characteristics of a structured text file, sections of a document, or search results. *See, e.g.,* Cina '808 patent, 4:44-56 (disclosing an embodiment with linear graphic symbols indicating the location of features in adjacent text). *See also,* Cina '808 patent, 5:47-55 ("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. As a result, the user is enabled to selectively choose which occurrences to view within the window."); Fig. 3 (presented above).

Claim element [13c] recites "**illustrating on said image the areas of said text that contain said at least one textual feature**. Cina '808 patent discloses illustrating the areas of text that include a textual feature, such as by using colors, shapes, symbols or images (and not readable words) on a scroll bar to indicate the location in the text of the feature. *See, e.g.*, Cina

'808 patent, 3:25-28 ("The indicia may take the form of alphanumeric characters, symbols, colors, graphical images, audio information and combinations thereof."); Cina '808 patent, 5:16-18 ("It should be noted that the location information may take the form of a number representing the chapter number, a special symbol, or simply a line. Furthermore, the specific form of the location information may be user selectable or application selectable."); Cina '808 patent, Fig. 3 (provided above); Cina '808 patent; Fig. 4 (provided below, depicting horizontal marks to indicate the location of a feature in a body of text):



Accordingly, claim 13 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Cina '808 patent. Please see the Claim Chart at Exhibit 12 for additional details.

Claim 14

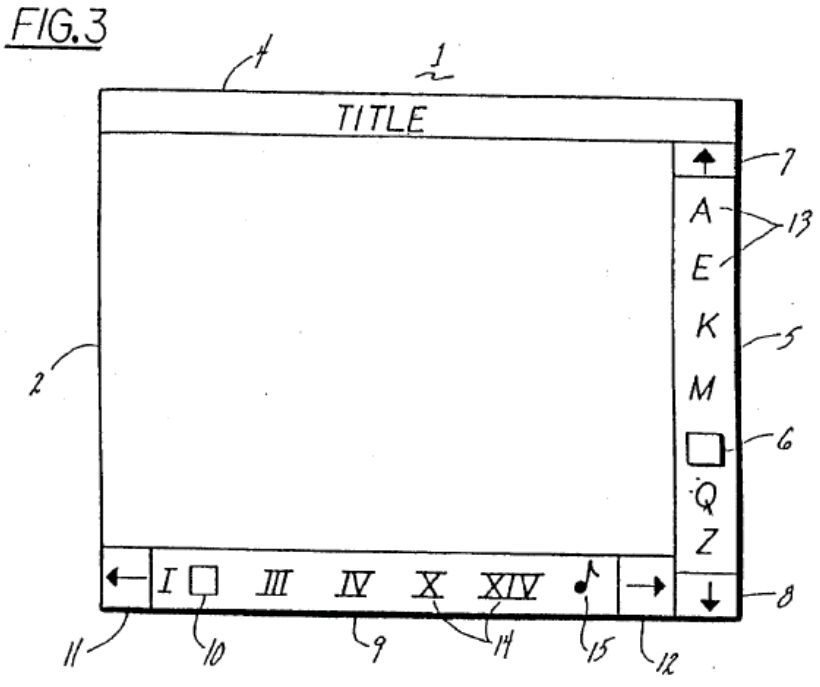
Claim 14 recites "**[t]he method according to claim 13, wherein said step of creating an image includes displaying all of said text as a single image**." The method disclosed in the Cina '808 patent creates a single image depicting a body of text, as the scroll bar spans the entire body of text. One of ordinary skill in the art would understand that an application that employs a scroll bar would have the scroll bar (the recited "image") represent the entire text. The scroll bar is used to move about the text. *See generally*, Cina '808 patent (disclosing producing a scroll bar

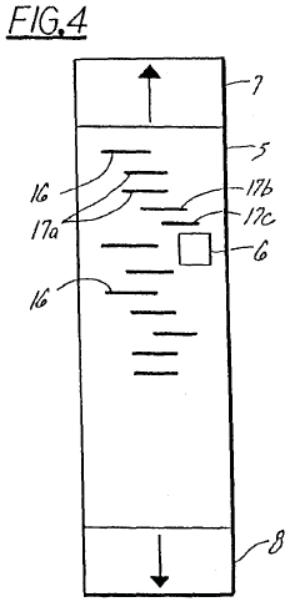
associated with an application displaying text); *see, e.g.*, Figs. 3 and 4 (provided above in connection with the analysis of claim 13 and depicting a scroll bar representing associated text).

Accordingly, claim 14 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Cina '808 patent. Please see the Claim Chart at Exhibit 12 for additional details.

Claim 16

Claim 16 recites "**[t]he method according to claim 13, wherein said step of identifying at least one textual feature includes identifying multiple textual features**." The Cina '808 patent discloses identifying multiple textual features on a scroll bar. The Cina '808 patent discloses creating an image displaying multiple textual features. For example, one symbol may indicate the beginning of Section A of a text (for example, an "A") and another symbol may indicate a search term (such as a "—"). *See* Cina '808 patent, Figs. 3and 4, below:





Accordingly, claim 16 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Cina '808 patent. Please see the Claim Chart at Exhibit 12 for additional details.

Claim 17

Claim 17 recites "**[t]he method according to claim 16, wherein said step of illustrating on said image the areas of said text that contain said at least one textual feature includes illustrating the areas of said text that contain at least two of said textual features**." The Cina '808 patent discloses creating an image displaying multiple textual features. For example, one symbol may indicate the occurrence of a link to a media file (for example, a "♪") and another symbol may indicate a section header location (such as an "A"). *See* Cina '808 patent, Fig. 3 (presented above).

Accordingly, claim 17 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Cina '808 patent. Please see the Claim Chart at Exhibit 12 for additional details.

3. **Claims 1, 13, 14, 16, and 17 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Eick '998 patent.**

The Eick '998 patent has a filing date, for the purposes of 35 U.S.C. § 102(e), of Sep. 6, 1991. The Eick '998 patent is prior art to the '740 patent under 35 U.S.C. § 102(e), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Eick '998 patent was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

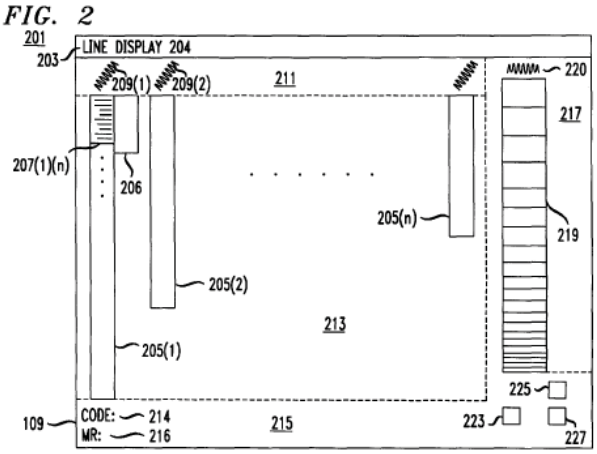
Claim 1

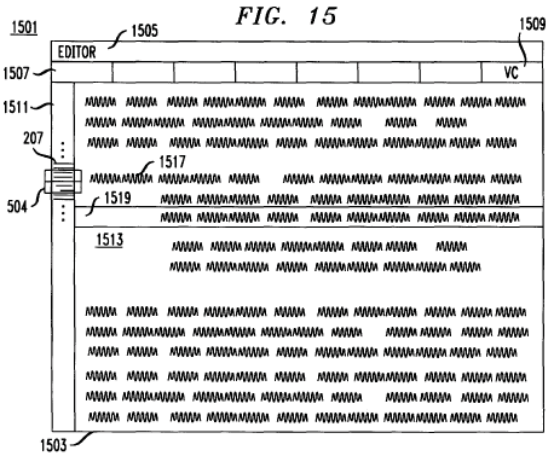
The preamble of claim 1 recites **"[a] method of producing a representation of text to enable a person to obtain some comprehension of said text without reading all of said text**." The Eick '998 patent discloses representations of text,[7] such as software code, which enable a person to obtain some comprehension of said text without reading all of said text. *See, e.g.,* Eick '998 patent, Abstract ("The techniques are employed in a system for discovering information about a large body of software. The system displays representations of up to 40,000 lines of code in a single window."); Eick '998 patent, 2:34-38 ("Another aspect of the invention is apparatus for visually representing characteristics of the contents of a set of files in a display. The apparatus comprises: means for associating a visual characteristic with a given characteristic of the content ….").

Claim element [1a] recites "**identifying at least one feature contained within at least a portion of said text**." The Eick '998 patent discloses the identification of features within at least a portion of a text, such as the characteristics of selected lines of software code or text document. *See, e.g.,* Eick '998 patent, 6:12-23 ("Right hand space 217 contains line characterization column 219 and line characterization column label 220. Line characterization column 219 indicates how different values from modification request records 121 are to be displayed in line representations 207. For example, each code file line record 119 includes a pointer to the modification request record 121 for the modification request which added or deleted the line, and the relevant modification request record 121 in turn includes a pointer to date record 139; consequently, the time at which every line of code was added to or deleted from the code body can be determined

[7] The term "text" recited in this and other claims would include computer code. *See In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) ("During reexamination, as with original examination, the PTO must give claims their broadest reasonable construction consistent with the specification.").

from code body data base 113."); Eick '998 patent, 22:10-31 ("…if the text editor marks text lines which are parts of special structures such as section headings or lists, those lines may be displayed in different colors, so that the logical structure of the document becomes visible from the line representations in scroll bar 1511. Additionally, if a word search is done on the file being edited, the line representations 207 for the lines containing the searched-for words may be given a different appearance… If there is other information about the file which is linked to the lines of the file, the line representations in the scroll bar can be used to display that information, too. For example, if the text being edited was a program in the body of code with which the preferred embodiment was concerned, the line representations could show all of the information available in the modification request data base. The developer would thus be able to determine as he edited which modification request had added the line he was editing, when it was last modified, and who modified it, to name a few facts…"); Eick '998 patent, Figs. 2 and 15:





Claim element [1b] recites "**creating at least one representation of said portion of said text**." Eick '998 patent discloses the creation of representations of portions of text, such as selected lines of software code, by using various colors and shapes. Eick '998 patent also discloses the creation of indicators within application scroll bars. *See, e.g.,* Eick '998 patent, 6:23-46 ("The time at which a line of code was changed is made visible in display 201 as

follows: a shade of color is assigned to each modification request. The shade depends on when the modification request was completed. In the preferred embodiment, the shades range from red through yellow to blue, with blue representing the oldest and red the most recent modification request. Further, each modification request is associated with a modification request representation consisting of a rectangle of pixels in line characterization column 219, with the rectangle for the oldest modification request at the bottom and the rectangle for the youngest at the top. The modification request representation for a given modification request is further displayed in that modification request's color, so that the color of line characterization column 219 ranges from blue at the bottom to red at the top. Finally, the line representations 207 which were added or deleted in a given modification request are displayed in the color corresponding to that time. Thus, line representations 207 which were added or deleted in the most recent modification request are red, while those which were added or deleted in the oldest modification request are blue, and the other line representations 207 have the colors corresponding to the modification requests in which they were added or deleted."); Eick '998 patent, Fig. 2 (above); Eick '998 patent, 22:5-20 ("There are many ways in which line representations 207 may provide detailed information about the lines in the file. For example, line representations 207 may show indentations as previously described and may also show blank lines, either by a different color or by the color of scroll bar 1511, as shown in FIG. 15. Further, if the text editor marks text lines which are parts of special structures such as section headings or lists, those lines may be displayed in different colors, so that the logical structure of the document becomes visible from the line representations in scroll bar 1511. **Additionally, if a word search is done on the file being edited, the line representations 207 for the lines containing the searched-for words may be given a different appearance. In some embodiments, they may be given a different**

color, in others, the line representations may blink, and in still others, they may become dashed.") (emphasis added); Eick '998 patent at Fig. 15 (above).

Claim element [1c] recites" **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 Eick '998 patent discloses the creation of representations of portions of text that are graphical indicators, such as various colors and shapes, and not readable words. Eick '998 patent also discloses the use of graphical indicators within application scroll bars. *See, e.g.,* Eick '998 patent, 6:23-46; Eick '998 patent, Fig. 2 (above); Eick '998 patent, 22:5-20; Eick '998 patent at Fig. 15 (above).

Further, the Eick '998 patent discloses exactly the same configuration at the Patent Owner contends infringes claim 1 of the '740 patent. The following table compares the Patent Owner's infringement contentions to the disclosure of the Eick '998 patent. As can be seen from the comparison, by the Patent Owner's own admission, the Eick '998 patent anticipates claim 1 of the '740 patent. *See* MPEP 2217 ("Admissions by the patent owner as to any matter affecting patentability may be utilized to determine the scope and content of the prior art in conjunction with patents and printed publications in a prior art rejection, whether such admissions result from patents or printed publications or from some other source.") (emphasis omitted).

Claim 1 Claim Element	Google Chrome Web Browser Feature	Eick '998 patent Disclosure
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 scrollbar as a representation of the webpage and to show the location of hits for the search terms.	*See, e.g.,* Eick '998 patent, Abstract ("The techniques are employed in a system for discovering information about a large body of software. The system displays representations of up to 40,000 lines of code in a single window.").
[1a] 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.	*See* Eick '998 patent, 22:15-20 ("Additionally, if a word search is done on the file being edited, the line representations 207 for the lines containing the searched-for words may be given a different appearance. In some embodiments, they may be given a different color, in others, the line representations may blink, and in still others, they may become dashed.").
[1b] 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.	*See* Eick '998 patent, 22:15-20 ("Additionally, if a word search is done on the file being edited, the line representations 207 for the lines containing the searched-for words may be given a different appearance. In some embodiments, they may be given a different color, in others, the line representations may blink, and in still others, they may become dashed.").

Claim 1 Claim Element	Google Chrome Web Browser Feature	Eick '998 patent Disclosure
[1c] 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.	*See* Eick '998 patent, 22:5-20 ("There are many ways in which line representations 207 may provide detailed information about the lines in the file. For example, line representations 207 may show indentations as previously described and may also show blank lines, either by a different color or by the color of scroll bar 1511, as shown in FIG. 15. Further, if the text editor marks text lines which are parts of special structures such as section headings or lists, those lines may be displayed in different colors, so that the logical structure of the document becomes visible from the line representations in scroll bar 1511. Additionally, if a word search is done on the file being edited, the line representations 207 for the lines containing the searched-for words may be given a different appearance. In some embodiments, they may be given a different color, in others, the line representations may blink, and in still others, they may become dashed.").

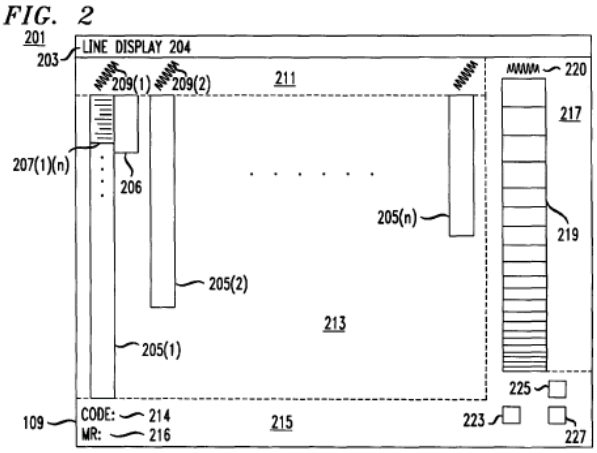
Accordingly, claim 1 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Eick '998 patent. Please see the Claim Chart at Exhibit 13 for additional details.

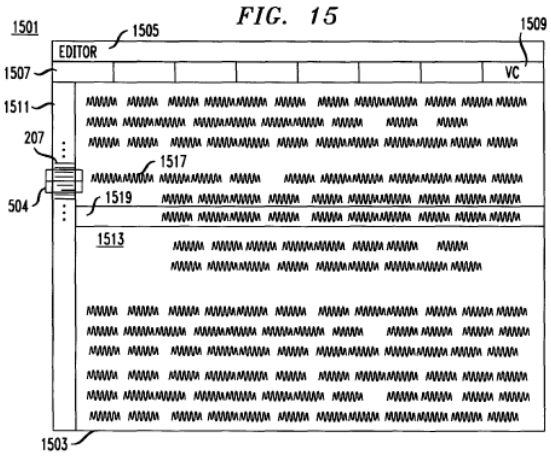
Claim 13

The preamble of claim 13 recites **"[a] method of producing a representation of text contained within a document to enable a person to obtain some comprehension of said text without reading said text**." The Eick '998 patent discloses representations of text, such as software code, which enable a person to obtain some comprehension of said text without reading all of said text. *See, e.g.,* Eick '998 patent, Abstract ("The techniques are employed in a system for discovering information about a large body of software. The system displays representations of up to 40,000 lines of code in a single window."); Eick '998 patent, 2:34-38 ("Another aspect of the invention is apparatus for visually representing characteristics of the contents of a set of files in a display. The apparatus comprises: means for associating a visual characteristic with a given characteristic of the content ….").

Claim element [13a] recites "**creating an image of said text wherein individual words of said text are not discernable within said image**." Eick '998 patent discloses creating a representation of a body of text, such as selected lines of software code, by using various colors and shapes. Eick '998 patent also discloses the creation of indicators within application scroll bars. *See, e.g.,* Eick '998 patent, 6:23-46 ("The time at which a line of code was changed is made visible in display 201 as follows: a shade of color is assigned to each modification request. The shade depends on when the modification request was completed. In the preferred embodiment, the shades range from red through yellow to blue, with blue representing the oldest and red the most recent modification request. Further, each modification request is associated

with a modification request representation consisting of a rectangle of pixels in line characterization column 219, with the rectangle for the oldest modification request at the bottom and the rectangle for the youngest at the top. The modification request representation for a given modification request is further displayed in that modification request's color, so that the color of line characterization column 219 ranges from blue at the bottom to red at the top. Finally, the line representations 207 which were added or deleted in a given modification request are displayed in the color corresponding to that time. Thus, line representations 207 which were added or deleted in the most recent modification request are red, while those which were added or deleted in the oldest modification request are blue, and the other line representations 207 have the colors corresponding to the modification requests in which they were added or deleted."); Eick '998 patent, Fig. 2; Eick '998 patent, 22:5-20 ("There are many ways in which line representations 207 may provide detailed information about the lines in the file. For example, line representations 207 may show indentations as previously described and may also show blank lines, either by a different color or by the color of scroll bar 1511, as shown in FIG. 15. Further, if the text editor marks text lines which are parts of special structures such as section headings or lists, those lines may be displayed in different colors, so that the logical structure of the document becomes visible from the line representations in scroll bar 1511. **Additionally, if a word search is done on the file being edited, the line representations 207 for the lines containing the searched-for words may be given a different appearance. In some embodiments, they may be given a different color, in others, the line representations may blink, and in still others, they may become dashed."**) (emphasis added); Eick '998 patent at Fig. 15. Eick '998 patent, Figs. 2 and 15:





Claim element [13b] recites "**identifying at least one textual feature contained within said text**." The Eick '998 patent discloses identifying features within a body of text, such as the characteristics of selected lines of software code or text document. *See, e.g.,* Eick '998 patent, 6:12-23 ("Right hand space 217 contains line characterization column 219 and line characterization column label 220. Line characterization column 219 indicates how different values from modification request records 121 are to be displayed in line representations 207. For example, each code file line record 119 includes a pointer to the modification request record 121 for the modification request which added or deleted the line, and the relevant modification request record 121 in turn includes a pointer to date record 139; consequently, the time at which every line of code was added to or deleted from the code body can be determined from code body data base 113."); Eick '998 patent, 22:10-31 ("…if the text editor marks text lines which are parts of special structures such as section headings or lists, those lines may be displayed in different colors, so that the logical structure of the document becomes visible from the line representations in scroll bar 1511. Additionally, if a word search is done on the file being edited, the line representations 207 for the lines containing the searched-for words may be given a different appearance… If there is other information about the file which is linked to the lines of the file, the line representations in the scroll bar can be used to display that information, too. For

example, if the text being edited was a program in the body of code with which the preferred embodiment was concerned, the line representations could show all of the information available in the modification request data base. The developer would thus be able to determine as he edited which modification request had added the line he was editing, when it was last modified, and who modified it, to name a few facts…"); Eick '998 patent, Figs. 2 and 15 (provided above).

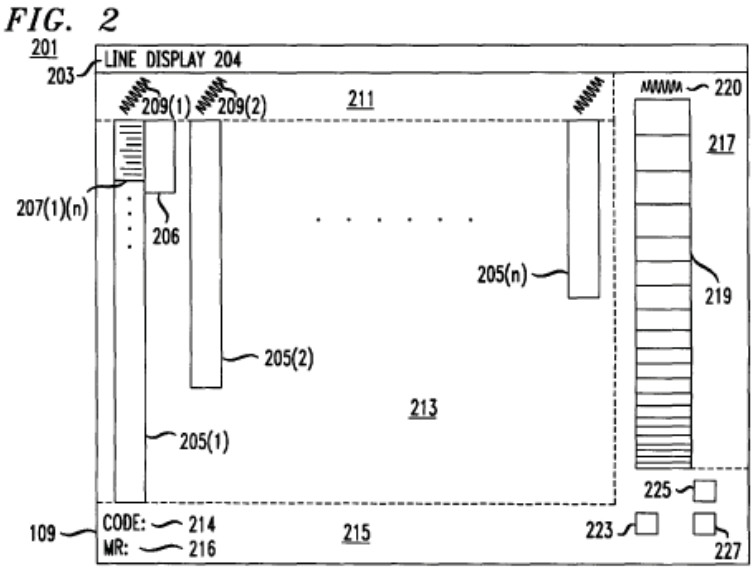
Claim element [13c] recites "**illustrating on said image the areas of said text that contain said at least one textual feature**. The Eick '998 patent discloses illustrating textual features on a scroll bar and on a column representing computer code using graphical indicators. *See, e.g.,* Eick '998 patent, 6:23-46; Eick '998 patent, Fig. 2 (above); Eick '998 patent, 22:5-20; Eick '998 patent at Fig. 15 (above).

Accordingly, claim 13 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Eick '998 patent. Please see the Claim Chart at Exhibit 13 for additional details.

Claim 14

Claim 14 recites "**[t]he method according to claim 13, wherein said step of creating an image includes displaying all of said text as a single image**." The Eick '998 patent displays the text of a single computer file in a single image. Fig. 2 of the Eick '998 patent provides an exemplary display from an implementation of the disclosed technique. The display depicts columns, with each column representing a file containing computer code. The relative lengths of each column corresponds to a feature of each file -- the number of lines contained in the file. In this way, the disclosed process in the Eick '998 patent identifies a feature of the file (number of lines) and provides a representation of the code indicating the presence of that feature. *See* Eick '998 patent, 4:66-7:15 (describing Fig. 2). As the Eick '998 patent discloses,

other features of the code can be depicted on the representation. *See id.* *See also*, Eick '998 patent, Fig. 2:



Accordingly, claim 14 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Eick '998 patent. Please see the Claim Chart at Exhibit 13 for additional details.

Claim 16

Claim 16 recites "**[t]he method according to claim 13, wherein said step of identifying at least one textual feature includes identifying multiple textual features**." The Eick '998 patent discloses that the scroll bar can display multiple features of a given text. For example, it can display the "hits" from a search. Additionally, it can display lines of text that were modified, such as through deleting or moving the line. *See* Eick '998 patent, 22:15-23 ("Additionally, if a word search is done on the file being edited, the line representations 207 for the lines containing the searched-for words may be given a different appearance… If there is other information about the file which is linked to the lines of the file, the line representations in the scroll bar can be used to display that information, too.").*See also* Eick '998 patent, Fig. 15

(presented above in connection with the analysis of claim 13); Eick '998 patent, 21:45-22:63 (describing an embodiment of the Eick '998 patent used to analyze text).

Accordingly, claim 16 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Eick '998 patent. Please see the Claim Chart at Exhibit 13 for additional details.

Claim 17

Claim 17 recites "**[t]he method according to claim 16, wherein said step of illustrating on said image the areas of said text that contain said at least one textual feature includes illustrating the areas of said text that contain at least two of said textual features**." The Eick '998 patent discloses that the scroll bar can display multiple features of a given text. For example, it can display the "hits" from a search. Additionally, it can display lines of text that were modified, such as through deleting or moving the line. *See* Eick '998 patent, 22:15-23 ("Additionally, if a word search is done on the file being edited, the line representations 207 for the lines containing the searched-for words may be given a different appearance… If there is other information about the file which is linked to the lines of the file, the line representations in the scroll bar can be used to display that information, too."). *See also* Eick '998 patent, Fig. 15 (presented above in connection with the analysis of claim 13); Eick '998 patent, 21:45-22:63 (describing an embodiment of the Eick '998 patent used to analyze text).

Accordingly, claim 17 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Eick '998 patent. Please see the Claim Chart at Exhibit 13 for additional details.

4. **Claims 1, 13, 14, 16, and 17 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Eick 1992 reference.**

The Eick 1992 reference published in November 1992, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent

application to the application that matured into the '740 patent. The Eick 1992 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

Claim 1

The preamble of claim 1 recites **"[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**." The Eick 1992 reference discloses producing a representation of text,[8] such as, for example, source code, to enable a person to obtain some comprehension of the text without reading all of the text. *See, e.g.,* Eick 1992 reference at 957 ("The Seesoft® software visualization system allows one to analyze up to 50 000 lines of code simultaneously by mapping each line of code into a thin row."). The Eick 1992 reference also discloses an application of the concept to a complete textual work. *See* Eick 1992 reference at 963 ("For example, one possible application would be to display a text corpus such as the Bible. Each book could be represented as a column and each verse as a row. A subject index or the age of each verse could be used to color the rows. Another application we are working on is to represent directories as columns and files as rows. This would allow us to visualize even more code on a single display.").

Claim element [1a] recites "**identifying at least one feature contained within at least a portion of said text**." Eick 1992 reference discloses identifying at least one feature contained within at least a portion of the text, such as, for example, the date source code was created or

[8] The term "text" recited in this and other claims would include computer code. *See In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) ("During reexamination, as with original examination, the PTO must give claims their broadest reasonable construction consistent with the specification.").

modified. *See, e.g.,* Eick 1992 reference at 957 ("The color of each row indicates a statistic of interest, e.g., red rows are those most recently changed, and blue are those least recently changed."); *id.* ("A difficult problem in software engineering is understanding statistics collected at the source code line level of detail. This class of statistics includes information such as who wrote each line, when it was last changed, whether it fixes a bug or adds new functionality, how it is reached, how often it is executed, and so on."); *id.* ("For each change to the software they typically capture information such as the affected lines, reason for the change, date, and responsible programmer. Static analyzers such as CIA [6] and cscope [7] capture the definitions of functions, types, macros, external variables, etc., and where they occur in the code. Profilers such as lcomp [8] perform basic block counting, indicating how often individual lines are executed."); *id.* ("The color of each row is determined by a statistic associated with the line of code that it represents. In several of our examples the statistic will be the date that the line was created."). As disclosed in the Eick 1992 reference, the depiction of a complete body of code is provided in a single screen with bars with indications for each row. *See, e.g.*, Eick 1992 reference at Fig. 1:

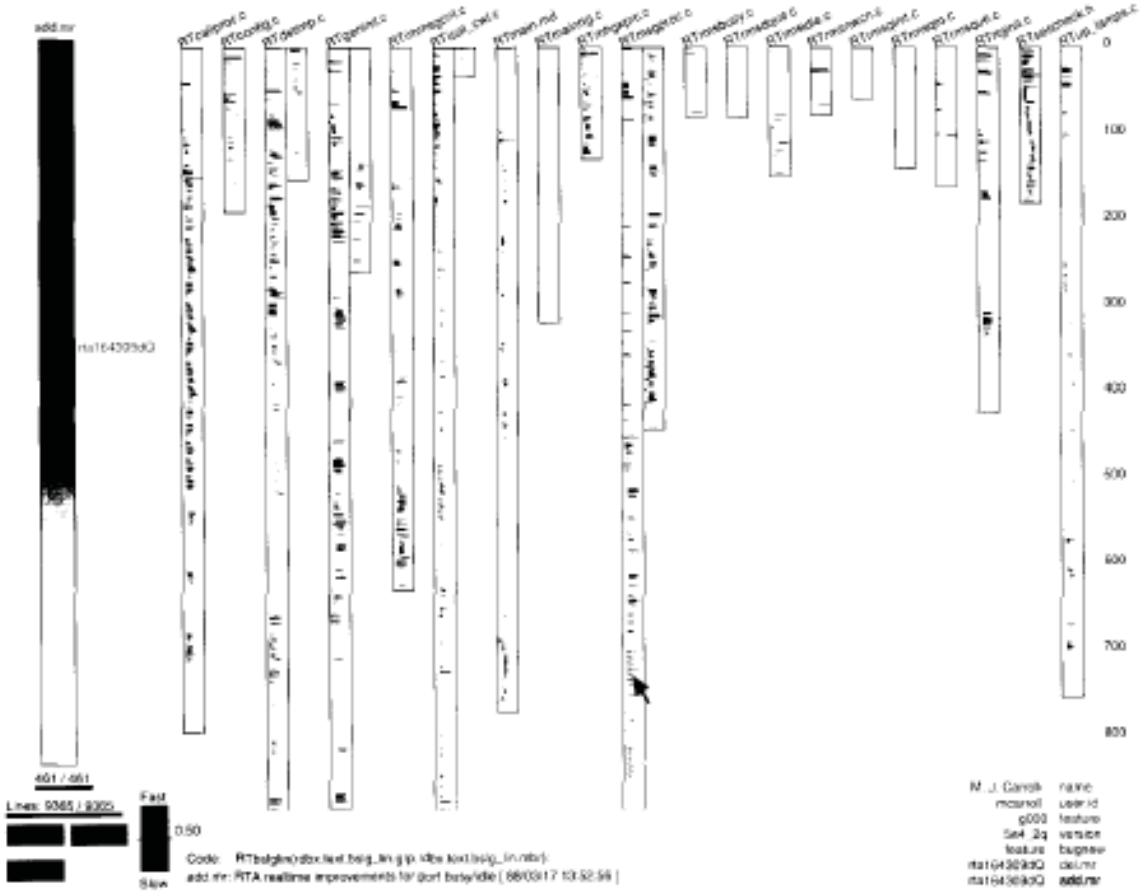


Fig. 1. Sample Seesoft display. A Seesoft display of a directory with 20 files and 9 365 lines of code. Each file is represented as a column and each line of code as a colored row. The files are either C code (.c), header (.h), or configuration management (.md) files. The color of each line is determined by the modification request (MR) that created the line. All MR's touching any of these files are shown on the left using a color scale with the oldest in blue and the newest in red.

Claim element [1b] recites "**creating at least one representation of said portion of said text**." Eick 1992 reference discloses creating at least one representation of the portion of the text by, for example, using columns with colored rows to represent source code files and lines. *See, e.g.,* Eick 1992 reference at 957 ("The Seesoft® software visualization system allows one to analyze up to 50 000 lines of code simultaneously by mapping each line of code into a thin row. The color of each row indicates a statistic of interest, e.g., red rows are those most recently changed, and blue are those least recently changed."). *See also*, Eick 1992 reference at 957 ("By means of direct manipulation and high interaction graphics, the user can manipulate this reduced

representation of the code in order to find interesting patterns."); *id.* ("There are four key ideas: reduced representation, coloring by statistic, direct manipulation, and capability to read actual code. The reduced representation is achieved by displaying files as columns and lines of code as thin rows. The color of each row is determined by a statistic associated with the line of code that it represents. In several of our examples the statistic will be the date that the line was created. The visual impression is that of a miniaturized copy of the code with color depicting the age of the code."); Fig. 1 (depicted above). "Fig. 1 shows a display of a directory containing 20 source code files containing 9 365 lines of code. The height of each column tells the user how large each file is. Files longer than one column are continued over to the next column." Eick 1992 reference at 957.

Claim element [1c] recites "**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**." Eick 1992 reference discloses that the representation of the portion of the text does not include any readable words but does include a graphical indication that indicates the presence of the at least one feature at at least one location within the at least one representation by, for example, using various colored rows located within a column to indicate statistics for lines of source code at corresponding locations within a file. *See, e.g.,* Eick 1992 reference at 958 ("With our display, programmers immediately recognize the files and lines of code because the display looks like a text listing viewed from a distance. The statistics are obvious from the row colors as is the spatial distribution of the statistic in the code."); Eick 1992 reference at 959 ("The row representation shows clearly the indentation and length of each line of code. The color of each line is tied to a line oriented statistic. This statistic is highlighted on the list of statistic

names in the lower righthand comer. The rows are just large enough so that block comments, functions, and control structures such as *case* and *if* statements are visible just by their indentation.").

Accordingly, claim 1 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Eick 1992 reference. Please see the Claim Chart at Exhibit 14 for additional details.

Claim 13

The preamble of claim 13 recites **"[a] method of producing a representation of text contained within a document to enable a person to obtain some comprehension of said text without reading said text**. The Eick 1992 reference discloses producing a representation of text, such as, for example, source code, to enable a person to obtain some comprehension of the text without reading all of the text. *See, e.g.,* Eick 1992 reference at 957 ("The Seesoft® software visualization system allows one to analyze up to 50 000 lines of code simultaneously by mapping each line of code into a thin row."). The Eick 1992 reference also discloses an application of the concept to a complete textual work. *See* Eick 1992 reference at 963 ("For example, one possible application would be to display a text corpus such as the Bible. Each book could be represented as a column and each verse as a row. A subject index or the age of each verse could be used to color the rows. Another application we are working on is to represent directories as columns and files as rows. This would allow us to visualize even more code on a single display.").

Claim element [13a] recites "**creating an image of said text wherein individual words of said text are not discernable within said image**." Eick 1992 reference discloses creating at least one representation of the portion of the text by, for example, using columns with colored

rows to represent source code files and lines. *See, e.g.,* Eick 1992 reference at 957 ("The Seesoft® software visualization system allows one to analyze up to 50 000 lines of code simultaneously by mapping each line of code into a thin row. The color of each row indicates a statistic of interest, e.g., red rows are those most recently changed, and blue are those least recently changed."). *See also*, Eick 1992 reference at 957 ("By means of direct manipulation and high interaction graphics, the user can manipulate this reduced representation of the code in order to find interesting patterns."); *id.* ("There are four key ideas: reduced representation, coloring by statistic, direct manipulation, and capability to read actual code. The reduced representation is achieved by displaying files as columns and lines of code as thin rows. The color of each row is determined by a statistic associated with the line of code that it represents. In several of our examples the statistic will be the date that the line was created. The visual impression is that of a miniaturized copy of the code with color depicting the age of the code."); Fig. 1 (depicted below). "Fig. 1 shows a display of a directory containing 20 source code files containing 9 365 lines of code. The height of each column tells the user how large each file is. Files longer than one column are continued over to the next column." Eick 1992 reference at 957.

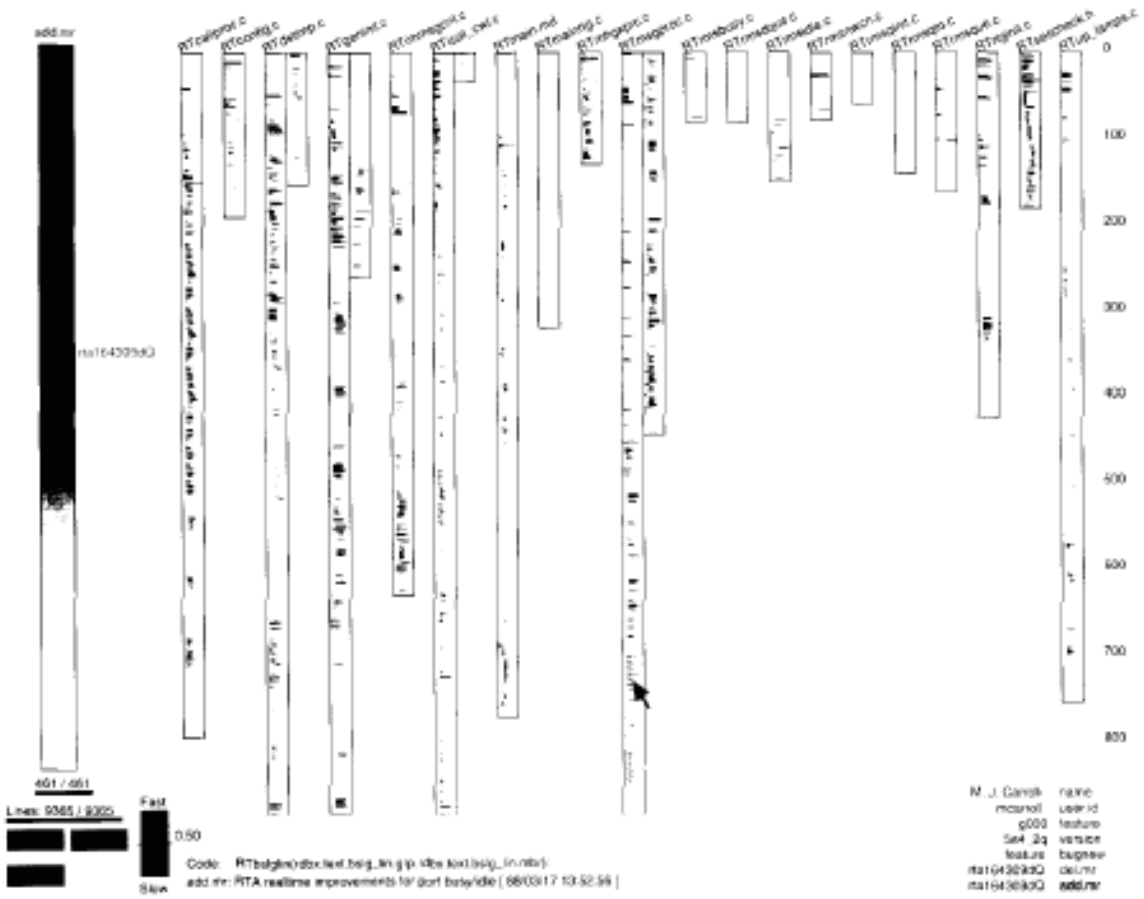


Fig. 1. Sample Seesoft display. A Seesoft display of a directory with 20 files and 9 365 lines of code. Each file is represented as a column and each line of code as a colored row. The files are either C code (.c), header (.h), or configuration management (.md) files. The color of each line is determined by the modification request (MR) that created the line. All MR's touching any of these files are shown on the left using a color scale with the oldest in blue and the newest in red.

Claim element [13b] recites "**identifying at least one textual feature contained within said text**." Eick 1992 reference discloses identifying at least one feature contained within at least a portion of the text, such as, for example, the date source code was created or modified. *See, e.g.,* Eick 1992 reference at 957 ("The color of each row indicates a statistic of interest, e.g., red rows are those most recently changed, and blue are those least recently changed."); *id.* ("A difficult problem in software engineering is understanding statistics collected at the source code line level of detail. This class of statistics includes information such as who wrote each line, when it was last changed, whether it fixes a bug or adds new functionality, how it is reached, how often it is executed, and so on."); *id.* ("For each change to the software they typically

capture information such as the affected lines, reason for the change, date, and responsible programmer. Static analyzers such as CIA [6] and cscope [7] capture the definitions of functions, types, macros, external variables, etc., and where they occur in the code. Profilers such as lcomp [8] perform basic block counting, indicating how often individual lines are executed."); *id.* ("The color of each row is determined by a statistic associated with the line of code that it represents. In several of our examples the statistic will be the date that the line was created."). As disclosed in the Eick 1992 reference, the depiction of a complete body of code is provided in a single screen with bars with indications for each row. *See, e.g.*, Eick 1992 reference at Fig. 1 (above)

Claim element [13c] recites "**illustrating on said image the areas of said text that contain said at least one textual feature**". Eick 1992 reference discloses that the representation illustrates the features of the source code, for example, using various colored rows located within a column to indicate statistics for lines of source code at corresponding locations within a file. *See, e.g.,* Eick 1992 reference at 958 ("With our display, programmers immediately recognize the files and lines of code because the display looks like a text listing viewed from a distance. The statistics are obvious from the row colors as is the spatial distribution of the statistic in the code."); Eick 1992 reference at 959: "The row representation shows clearly the indentation and length of each line of code. The color of each line is tied to a line oriented statistic. This statistic is highlighted on the list of statistic names in the lower righthand comer. The rows are just large enough so that block comments, functions, and control structures such as *case* and *if* statements are visible just by their indentation.").

Accordingly, claim 13 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Eick 1992 reference. Please see the Claim Chart at Exhibit 14 for additional details.

Claim 14

Claim 14 recites "**[t]he method according to claim 13, wherein said step of creating an image includes displaying all of said text as a single image**." The Eick 1992 reference displays the text of a single computer file in a single image, considering the presentation of the entire code in a single image a "key idea" presented in the reference. *See, e.g.,* Eick 1992 reference at 957 ("There are four key ideas: ***reduced representation***, coloring by statistic, direct manipulation, and capability to read actual code. ***The reduced representation is achieved by displaying files as columns and lines of code as thin rows***. The color of each row is determined by a statistic associated with the line of code that it represents. In several of our examples the statistic will be the date that the line was created. ***The visual impression is that of a miniaturized copy of the code with color depicting the age of the code***.") (emphasis added). The Eick 1992 reference also discloses an application of the concept to a complete textual work. *See* Eick 1992 reference at 963 ("For example, one possible application would be to display a text corpus such as the Bible. Each book could be represented as a column and each verse as a row. A subject index or the age of each verse could be used to color the rows. Another application we are working on is to represent directories as columns and files as rows. This would allow us to visualize even more code on a single display.").

Accordingly, claim 14 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Eick 1992 reference. Please see the Claim Chart at Exhibit 14 for additional details.

Claim 16

Claim 16 recites "**[t]he method according to claim 13, wherein said step of identifying at least one textual feature includes identifying multiple textual features**." The

Eick 1992 reference discloses identifying multiple features on a representation, including the author of a line of code and when it was last changed. *See, e.g.,* Eick 1992 reference at 957 ("A difficult problem in software engineering is understanding statistics collected at the source code line level of detail. This class of statistics includes information such as who wrote each line, when it was last changed, whether it fixes a bug or adds new functionality, how it is reached, how often it is executed, and so on.").

Accordingly, claim 16 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Eick 1992 reference. Please see the Claim Chart at Exhibit 14 for additional details.

Claim 17

Claim 17 recites "**[t]he method according to claim 16, wherein said step of illustrating on said image the areas of said text that contain said at least one textual feature includes illustrating the areas of said text that contain at least two of said textual features**." The Eick 1992 reference discloses identifying multiple features on a representation, including the author of a line of code and when it was last changed. *See, e.g.,* Eick 1992 reference at 957 ("A difficult problem in software engineering is understanding statistics collected at the source code line level of detail. This class of statistics includes information such as who wrote each line, when it was last changed, whether it fixes a bug or adds new functionality, how it is reached, how often it is executed, and so on.").

Accordingly, claim 17 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Eick 1992 reference. Please see the Claim Chart at Exhibit 14 for additional details.

5. **Claims 1, 13, and 14 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Gould '588 patent.**

The Gould '588 patent has a filing date, for the purposes of 35 U.S.C. § 102(e), of Dec. 14, 1992. The Gould '588 patent is prior art to the '740 patent under 35 U.S.C. § 102(e), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Gould '588 patent was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

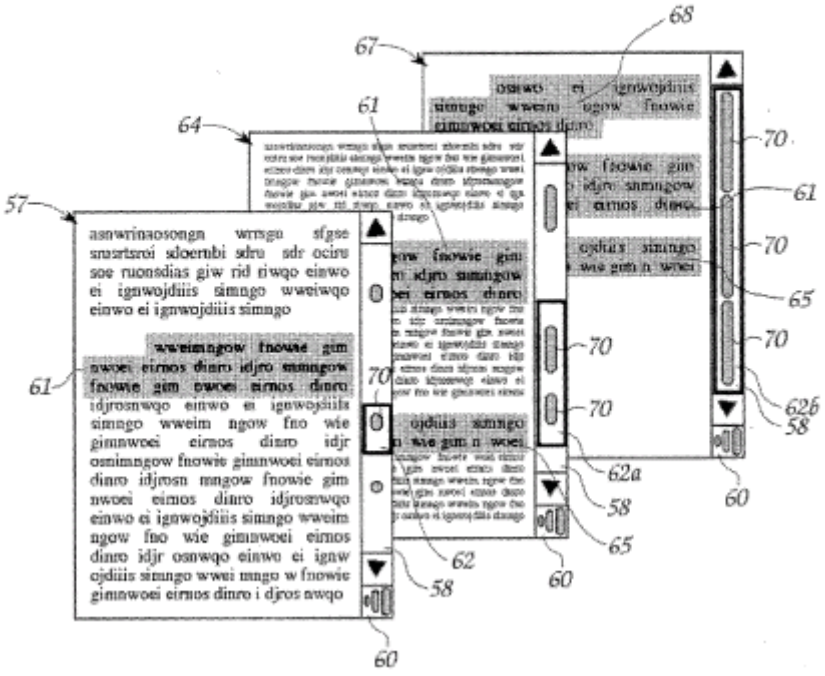
Claim 1

The preamble of claim 1 recites **"[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**." Gould '588 patent discloses representations of text which enable a person to obtain some comprehension of said text without reading all of the text. *See, e.g.,* Gould '588 patent, Abstract ("A relativity controller is a scroll bar/window combination that provides a way to see data in relation to both the context of its wholeness and the salience of its contents. To accomplish this, the linear density or other appearance of the scroll bar (acting as a ruler or scale) varies with the density of the document salience (as indicated by different kinds of annotations or marks). It also provides a way to zoom between perspectives. This is usable on many different data types: including sound, video, graphics, calendars and word processors.").

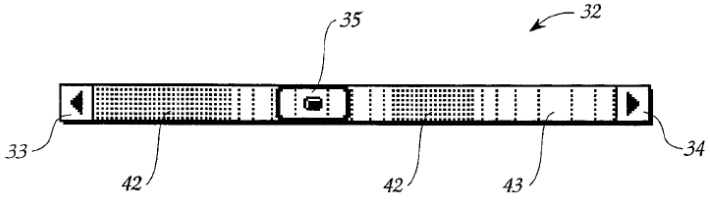
Claim element [1a] recites "**identifying at least one feature contained within at least a portion of said text**." Gould '588 patent discloses the identification of features within at least a portion of said text, such as the salience of selected text. In one disclosed example, the method of the Gould '588 patent identifies locations in a text that are highlighted. The text can be

manipulated such that the highlighted areas become the focus of the text presentation screen. *See, e.g.,* Gould '588 patent, 5:65-6:28 ("FIG. 11 shows another example of application of the invention to text documents. FIG. 11 depicts one page 57 of linear spatially depicted text, which would normally be displayed as a single screen with its accompanying vertical scroll bar 58 with, in this case, a relativity controller box 60. Three text lines have been highlighted 61 as salient. The thumb 62, it will be noted, has a certain size (height), showing as before one marked salient segment on the page. When the relativity controller box 60 is clicked on and dragged rightward (toward the right side of the mouse pad), reference numeral 64 now shows the resultant screen display. Note now that the non-salient (non-highlighted) parts of the original screen 57 have been shrunk or condensed, so that now not only the original marked segment 61 is visible but also a second marked segment 65. Note further that the thumb 62a has enlarged to indicate the increased number of visible salient points. Screen 64 also shows how the unmarked "insignificant" text above and below the salient segments shrink up, and disappear in the third screen 67 shown at the right when scaling perspective, as other salient segments 68 come into view. Thus, when the second screen 64 has segments 61,65 marked, and when the controller box 60 is clicked on and again dragged to the right, more of the succeeding text can be displayed as illustrated in the third screen 67. Again note the increased size of the thumb 62b. In all three cases, the scroll bar 58 illustrates at 70 the scope of the salient segments and thus the modified text representation. The text abstract generated 67 in this process could be presented in library search systems, so that the user could then more readily scan and expand the view to give more details as desired."). Figure 11 depicts:

Figure 11



The Gould '588 patent further discloses "how high density 42 and low density 43 appearances can indicate non-marked and marked segments, respectively." Gould '588 patent, 5:15-17. Figure 7 depicts:



Similarly, the density of marks on a vertical scroll bar can represent the density of information in a text document. *See, e.g.*, Gould '588 patent, Figs. 9 and 10 (depicted below):

Figure 9

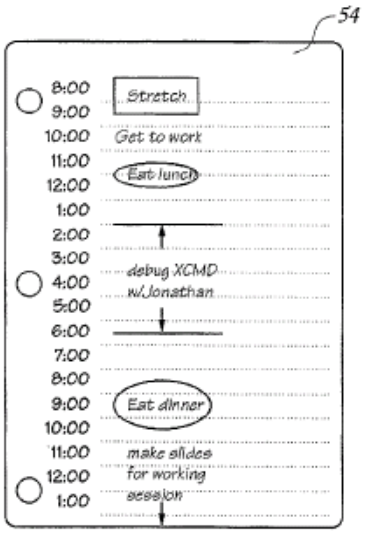
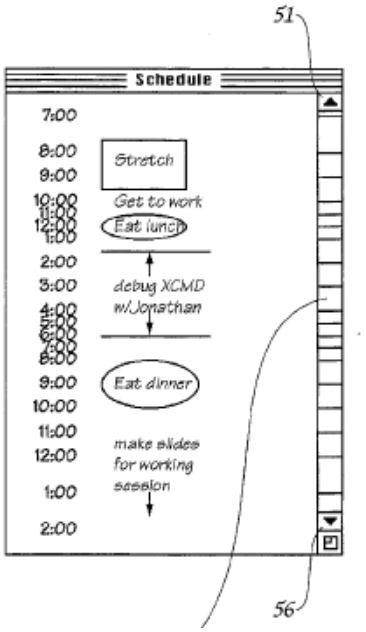


Figure 10



Claim element [1b] recites "**creating at least one representation of said portion of said text**." Gould '588 patent discloses the creation of representations of portions of text, such as selected text, by using various graphical indicators. Gould '588 patent also discloses the creation of indicators within application scroll bars. *See, e.g.*, Gould '588 patent, Figs. 7, 9, 10, and 11 (presented above) and accompanying text.

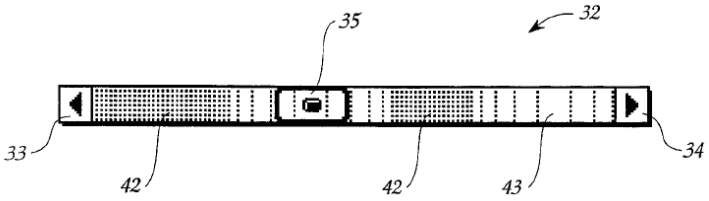
Claim element [1c] recites "**wherein said representation of said portion of said text does not include any readable words but does include a graphical indication that indicates the presence of said at least one feature at at least one location within said at least one representation**." Gould '588 patent discloses the creation of representations of portions of text that are graphical indicators, by using various graphic indicators, and not readable words. Gould '588 patent also discloses the use of graphical indicators within application scroll bars. *See, e.g.*, Gould '588 patent, Figs. 7, 9, 10, and 11 (presented above) and accompanying text.

Accordingly, claim 1 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Gould '588 patent. Please see the Claim Chart at Exhibit 15 for additional details.

Claim 13

The preamble of claim 13 recites "**[a] method of producing a representation of text contained within a document to enable a person to obtain some comprehension of said text without reading said text**." Gould '588 patent discloses representations of text which enable a person to obtain some comprehension of said text without reading all of the text. *See, e.g.,* Gould '588 patent, Abstract ("A relativity controller is a scroll bar/window combination that provides a way to see data in relation to both the context of its wholeness and the salience of its contents. To accomplish this, the linear density or other appearance of the scroll bar (acting as a ruler or scale) varies with the density of the document salience (as indicated by different kinds of annotations or marks). It also provides a way to zoom between perspectives. This is usable on many different data types: including sound, video, graphics, calendars and word processors.").

Claim element [13a] recites "**creating an image of said text wherein individual words of said text are not discernable within said image**." Gould '588 patent discloses the creation of representations of portions of text, such as selected text, by using various graphical indicators. Gould '588 patent also discloses the creation of indicators within application scroll bars. *See, e.g.*, Gould '588 patent, Figs. 7, 9, 10, and 11 and accompanying text. These figures depict:



Gould ‘588 patent, Fig. 7

Figure 9

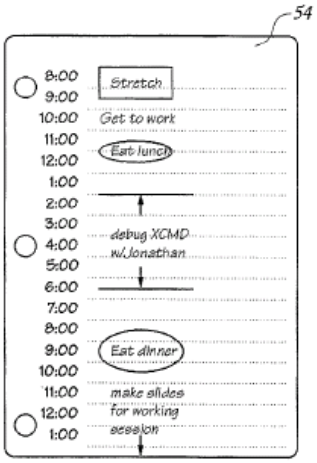


Figure 10

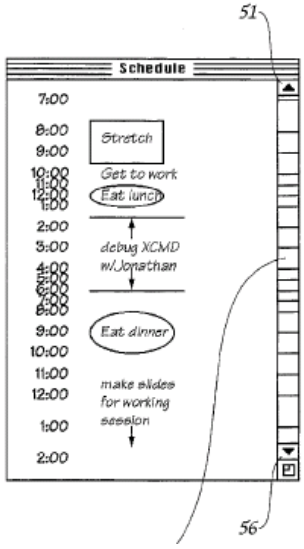
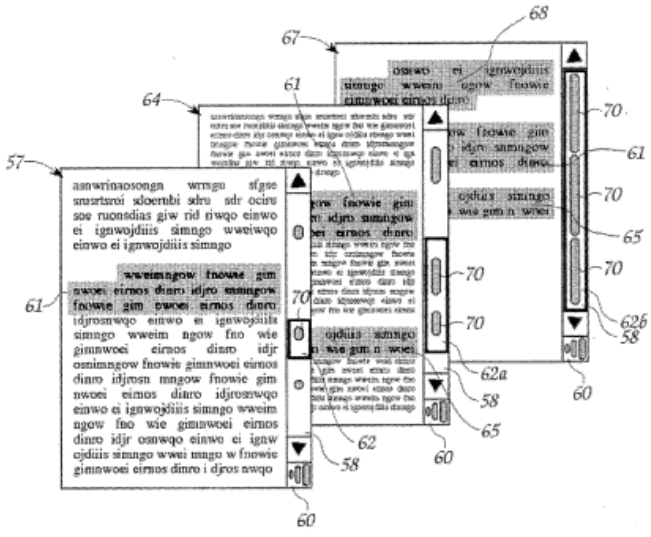


Figure 11



Claim element [13b] recites "**identifying at least one textual feature contained within said text**." Gould '588 patent discloses the identification of features within at least a portion of said text, such as the salience of selected text. In one disclosed example, the method of the Gould '588 patent identifies locations in a text that are highlighted. The text can be manipulated such that the highlighted areas become the focus of the text presentation screen. *See, e.g.,* Gould '588 patent, 5:65-6:28 ("FIG. 11 shows another example of application of the invention to text documents. FIG. 11 depicts one page 57 of linear spatially depicted text, which would normally be displayed as a single screen with its accompanying vertical scroll bar 58 with, in this case, a relativity controller box 60. Three text lines have been highlighted 61 as salient. The thumb 62, it will be noted, has a certain size (height), showing as before one marked salient segment on the page. When the relativity controller box 60 is clicked on and dragged rightward (toward the right side of the mouse pad), reference numeral 64 now shows the resultant screen display. Note now that the non-salient (non-highlighted) parts of the original screen 57 have been shrunk or condensed, so that now not only the original marked segment 61 is visible but also a second marked segment 65. Note further that the thumb 62a has enlarged to indicate the increased number of visible salient points. Screen 64 also shows how the unmarked "insignificant" text above and below the salient segments shrink up, and disappear in the third screen 67 shown at the right when scaling perspective, as other salient segments 68 come into view. Thus, when the second screen 64 has segments 61,65 marked, and when the controller box 60 is clicked on and again dragged to the right, more of the succeeding text can be displayed as illustrated in the third screen 67. Again note the increased size of the thumb 62b. In all three cases, the scroll bar 58 illustrates at 70 the scope of the salient segments and thus the modified text representation. The text abstract generated 67 in this process could be presented in library search systems, so that the

user could then more readily scan and expand the view to give more details as desired."). *See also*, Gould '588 patent, Figs. 7, 9, 10, and 11 (presented above) and accompanying text.

Claim element [13c] recites "**illustrating on said image the areas of said text that contain said at least one textual feature**. Gould '588 patent discloses the creation of representations of portions of text that are graphical indicators, by using various graphic indicators, and not readable words. Gould '588 patent also discloses the use of graphical indicators within application scroll bars. *See, e.g.*, Gould '588 patent, Figs. 7, 9, 10, and 11 (presented above) and accompanying text.

Accordingly, claim 13 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Gould '588 patent. Please see the Claim Chart at Exhibit 15 for additional details.

Claim 14

Claim 14 recites "**[t]he method according to claim 13, wherein said step of creating an image includes displaying all of said text as a single image**." The Gould '588 patent displays all of the text of an analyzed text. *See, e.g.,* Gould '588 patent, Figs. 9 and 10 (presented above, in connection with the analysis of claim 13). Figures 9 and 10 display, on the scroll bar, a representation of a complete text, in this case a schedule page.

Accordingly, claim 14 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Gould '588 patent. Please see the Claim Chart at Exhibit 15 for additional details.

6. **Claims 1, 12, 13, 14, and 15 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Kozima 1993 reference.**

The Kozima 1993 reference was published in June 1993. The Kozima 1993 is prior art to the '740 patent under 35 U.S.C. § 102(b), given a priority date for the '740 patent of Jun. 3,

1996. To the extent that any of the claims of the '740 patent is entitled to the earlier priority date of the parent patent application for the application that matured into the '740 patent, then the Kozima 1993 reference is prior art under 35 U.S.C. § 102(a) for such claims. The Kozima 1993 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

Claim 1

The preamble of claim 1 recites **"[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**." The Kozima 1993 reference discloses a method for providing a representation of a corpus of text. For example, the disclosed method identifies segment breaks in the text. *See, e.g*., Kozima 1993 reference, Abstract ("This paper proposes a new indicator of text structure, called the lexical cohesion profile (LCP), which locates segment boundaries in a text."). *See also* Kozima 1993 reference, Fig. 3 (showing a representation of a body of text and identifying the breaks in text segments).

Claim element [1a] recites "**identifying at least one feature contained within at least a portion of said text**." The Kozima 1993 reference discloses a method for providing a representation of a corpus of text. The Kozima 1993 reference discloses the text feature of segment breaks in the text. *See, e.g*., Kozima 1993 reference, Abstract ("This paper proposes a new indicator of text structure, called the lexical cohesion profile (LCP), which locates segment boundaries in a text."). *See also* Kozima 1993 reference, Fig. 3 (showing a representation of a body of text and identifying the breaks in text segments):

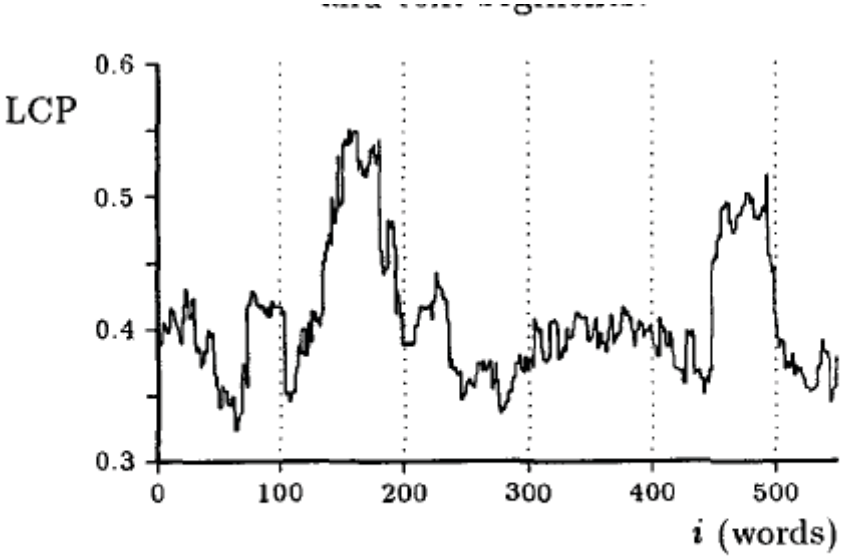


Figure 3. An example of LCP
(using rectangular window of Δ=25)

Claim element [1b] recites "**creating at least one representation of said portion of said text**." The Kozima 1993 reference discloses a method for providing a representation of a corpus of text. For example, the disclosed method identifies segment breaks in the text. *See, e.g.*, Kozima 1993 reference, Abstract ("This paper proposes a new indicator of text structure, called the lexical cohesion profile (LCP), which locates segment boundaries in a text."). *See also* Kozima 1993 reference, Fig. 3 (showing a representation of a body of text and identifying the breaks in text segments) (presented above).

Claim element [1c] recites "**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 Kozima 1993 reference discloses a method for providing a representation of a corpus of text. For example, the disclosed method identifies segment breaks in the text. *See, e.g.*, Kozima 1993 reference, Abstract ("This paper proposes a new indicator of text structure, called the lexical cohesion profile (LCP), which locates segment boundaries in a

text."). *See also* Kozima 1993 reference, Fig. 3 (showing a representation of a body of text and identifying the breaks in text segments) (presented above). The representation (the graph) has no readable words.

Accordingly, claim 1 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Kozima 1993 reference. Please see the Claim Chart at Exhibit 16 for additional details.

Claim 12

Claim 12 recites "**[t]he method according to claim 1, further including the step of displaying said at least one representation in a three dimensional format**." The Kozima 1993 reference discloses a method for depicting a feature of a given text, specifically word similarity, in a three dimensional manner. *See* Kozima 1993 reference, Fig. 1 and accompanying text. Figure 1 depicts:

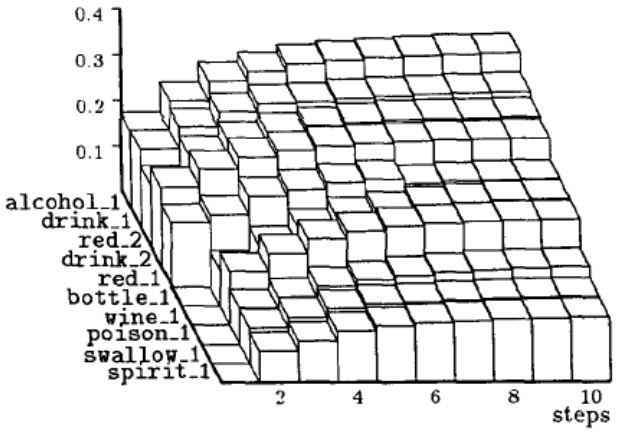


Figure 1. An activated pattern of a word list (produced from {red, alcoholic, drink}).

Accordingly, claim 12 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Kozima 1993 reference. Please see the Claim Chart at Exhibit 16 for additional details.

Claim 13

The preamble of claim 13 recites **"[a] method of producing a representation of text contained within a document to enable a person to obtain some comprehension of said text without reading said text**." The Kozima 1993 reference discloses a method for providing a representation of a corpus of text. For example, the disclosed method identifies segment breaks in the text. *See, e.g.*, Kozima 1993 reference, Abstract ("This paper proposes a new indicator of text structure, called the lexical cohesion profile (LCP), which locates segment boundaries in a text."). *See also* Kozima 1993 reference, Fig. 3 (showing a representation of a body of text and identifying the breaks in text segments).

Claim element [13a] recites "**creating an image of said text wherein individual words of said text are not discernable within said image**." The Kozima 1993 reference discloses a method for providing a representation of a corpus of text. For example, the disclosed method identifies segment breaks in the text. *See, e.g.*, Kozima 1993 reference, Abstract ("This paper proposes a new indicator of text structure, called the lexical cohesion profile (LCP), which locates segment boundaries in a text."). *See also* Kozima 1993 reference, Fig. 3 (showing a representation of a body of text and identifying the breaks in text segments). The representation of the text (the graph) has no readable words. Figure 3 depicts:

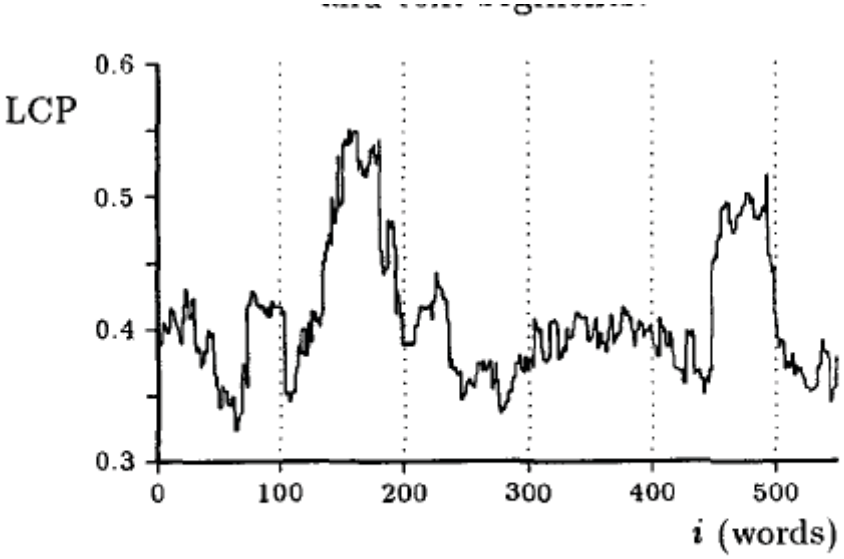


Figure 3. An example of LCP
(using rectangular window of Δ=25)

Claim element [13b] recites "**identifying at least one textual feature contained within said text**." The Kozima 1993 reference discloses a method for providing a representation of a corpus of text. The Kozima 1993 reference discloses the text feature of segment breaks in the text. *See, e.g.*, Kozima 1993 reference, Abstract ("This paper proposes a new indicator of text structure, called the lexical cohesion profile (LCP), which locates segment boundaries in a text."). *See also* Kozima 1993 reference, Fig. 3 (showing a representation of a body of text and identifying the breaks in text segments) (depicted above).

Claim element [13c] recites "**illustrating on said image the areas of said text that contain said at least one textual feature**. The Kozima 1993 reference discloses a method for providing a representation of a corpus of text. For example, the disclosed method identifies segment breaks in the text. *See, e.g.*, Kozima 1993 reference, Abstract ("This paper proposes a new indicator of text structure, called the lexical cohesion profile (LCP), which locates segment boundaries in a text."). *See also* Kozima 1993 reference, Fig. 3 (showing a representation of a body of text and identifying the breaks in text segments) (presented above).

Accordingly, claim 13 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Kozima 1993 reference. Please see the Claim Chart at Exhibit 16 for additional details.

Claim 14

Claim 14 recites "**[t]he method according to claim 13, wherein said step of creating an image includes displaying all of said text as a single image**." The Kozima 1993 reference discloses a method that displays all of the text as a single image. The graph of Fig. 3 covers all of the words of the body of text. *See* Kozima 1993 reference, Fig. 3 (depicted above, in connection with the analysis of claim 13).

Accordingly, claim 14 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Kozima 1993 reference. Please see the Claim Chart at Exhibit 16 for additional details.

Claim 15

Claim 15 recites "**[t]he method according to claim 13, wherein said step of identifying at least one textual feature includes identifying words in said text having generally the same definition**." The Kozima 1993 reference discloses a method that analyzes the relationship of related words, termed "lexical cohesion." *See, e.g.*, Kozima 1993 reference at 286 ("The similarity σ(w,w') ε [0,1] between words w,w′ is computed in the following way: (1) produce an activated pattern by activating the node w; (2) observe activity of the node w′ in the activated pattern."); Fig. 1. Figure 1 of the Kozima 1993 reference depicts:

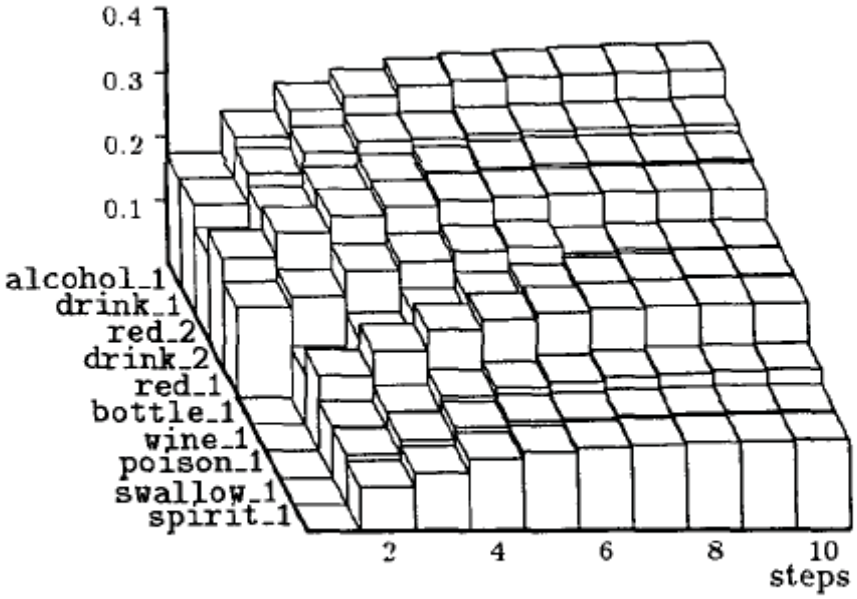


Figure 1. An activated pattern of a word list (produced from {**red**, **alcoholic**, **drink**}).

Accordingly, claim 15 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by the Kozima 1993 reference. Please see the Claim Chart at Exhibit 16 for additional details.

7. **Obviousness under 35 U.S.C. § 103(a) based on Church 1993 reference.**

a. Claims 2, 3, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Brill 1992 reference.

Claim 2

Claim 2 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring noun within said portion of said text**." To the extent that the Church 1993 reference fails to expressly or inherently disclose the subject matter of claim 2, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Brill 1992 reference discloses

a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. The Brill 1992 reference published in February 1992, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Brill 1992 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Church 1993 reference to arrive at the invention of claim 2. Using the teachings of the Brill 1992 reference, the Church 1993 reference would be modified to show, through the dotplot, the location of the most frequently occurring nouns.

Reasons to combine the Church 1993 reference and the Brill 1992 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Church 1993 reference and the Brill 1992 reference. The Church 1993 reference teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Brill 1992 reference, the method of the Church 1993 reference could be modified to provide a representation of the text that indicates through the dotplot of the occurrence of the most frequently occurring nouns. The Brill 1992 reference discloses that the method can accurately tag parts of speech. The combination of the Church 1993 reference and the Brill 1992 reference represents merely the combination of known processes that yield

predictable results, a method for providing a dotplot that indicates the occurrences of the most frequently occurring nouns.

Accordingly, claim 2 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 11 for additional details.

Claim 3

Claim 3 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring nouns within said portion of said text**." To the extent that the Church 1993 reference fails to expressly or inherently disclose the subject matter of claim 3, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. As discussed above in connection with the analysis for claim 2, the Brill 1992 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Church 1993 reference to arrive at the invention of claim 3. Using the teachings of the Brill 1992 reference, the Church 1992 reference would be modified to show, through the dotplot, the location of the most frequently occurring nouns. Reasons to combine the Church 1993 reference and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 3 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 11 for additional details.

Claim 6

Claim 6 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating a representation that indicates locations within said portion of said text that contain more than one frequently occurring nouns**." To the extent that the Church 1993 reference fails to expressly or inherently disclose the subject matter of claim 6, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. As discussed above in connection with the analysis for claim 2, the Brill 1992 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Church 1993 reference to arrive at the invention of claim 6. Using the teachings of the Brill 1992 reference, the Church 1993 reference would be modified to show, through the dotplot, the location of the most frequently occurring nouns. Reasons to combine the Church 1993 reference and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 6 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 11 for additional details.

b. Claims 2, 3, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Church 1988 reference.

Claim 2

Claim 2 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring noun within said portion of said text**." To the extent that the Church 1993 reference fails to expressly or inherently disclose the subject matter of claim 2, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Church 1988 reference discloses a method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generall*y, Church 1988 reference. The Church 1988 reference published in February 1988, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Church 1988 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1988 reference. It would be obvious to combine the teachings of the Church 1988 reference with the Church 1993 reference to arrive at the invention of claim 2. Using the teachings of the

Church 1988 reference, the Church 1993 reference would be modified to show, through the dotplot, the location of the most frequently occurring nouns.

Reasons to combine the Church 1993 reference and the Church 1988 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Church 1993 reference and the Church 1988 reference. The Church 1993 reference teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Church 1988 reference, the method of the Church 1993 reference could be modified to provide a representation of the text that indicates through the dotplot of the occurrence of the most frequently occurring nouns. The Church 1988 reference discloses that the method can accurately tag parts of speech. The combination of the Church 1993 reference and the Church 1988 reference represents merely the combination of known processes that yield predictable results, a method for providing a dotplot that indicates the occurrences of the most frequently occurring nouns. Further, given the common author of the two references, one of ordinary skill in the art would have had an initial reason to consider the combined teachings of the two references.

Accordingly, claim 2 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 11 for additional details.

Claim 3

Claim 3 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring nouns within said portion of said text**." To the extent that the Church 1993 reference fails to expressly or

inherently disclose the subject matter of claim 3, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Church 1988 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Church 1988 reference. As discussed above in connection with the analysis for claim 2, the Church 1988 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1988 reference. It would be obvious to combine the teachings of Church 1988 reference with the Church 1993 reference to arrive at the invention of claim 3. Using the teachings of the Church 1988 reference, the Church 1993 reference would be modified to show, through the dotplot, the location of the most frequently occurring nouns. Reasons to combine the Church 1993 reference and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 3 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 11 for additional details.

Claim 6

Claim 6 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating a representation that indicates locations within said portion of said text that contain more than one frequently occurring nouns**." To the extent that the Church 1993 reference fails to expressly or inherently disclose the subject matter of claim 6, a method that identifies the most frequently occurring noun within a body of text is

known. For example, the Church 1988 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Church 1988 reference. As discussed above in connection with the analysis for claim 2, the Church 1988 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1988 reference. It would be obvious to combine the teachings of Church 1988 reference with the Church 1993 reference to arrive at the invention of claim 6. Using the teachings of the Church 1988 reference, the Church 1993 reference would be modified to show, through the dotplot, the location of the most frequently occurring nouns. Reasons to combine the Church 1993 reference and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 6 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 11 for additional details.

c. Claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Kozima 1993 reference.

Claim 12 recites "**[t]he method according to claim 1, further including the step of displaying said at least one representation in a three dimensional format**." To the extent that the Church 1993 reference does not expressly or inherently disclose this claim element, the Kozima 1993 reference discloses a method for depicting a feature of a given text, specifically word similarity, in a three dimensional manner *See* Kozima 1993 reference, Fig. 1 and accompanying text. The Kozima 1993 reference was published in June 1993. The Kozima 1993

is prior art to the '740 patent under 35 U.S.C. § 102(b), given a priority date for the '740 patent of Jun. 3, 1996. To the extent that any of the claims of the '740 patent is entitled to the earlier priority date of the parent patent application for the application that matured into the '740 patent, then the Kozima 1993 reference is prior art under 35 U.S.C. § 102(a) for such claims. The Kozima 1993 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The use of three-dimensional imaging was well known before the priority date of the '740 patent, as illustrated by the Kozima 1993 reference. It would be obvious to combine the teachings of the Kozima 1993 reference with the Church 1993 reference to arrive at the invention of claim 12, namely displaying results in a three dimensional manner. For example, instead of using a spectrum of color for the dotplot of Figure 8 of the Church 1993 reference, boxes with different heights could be depicted to illustrate the relative similarity between the translations of the manual. Figure 8 of the Church 1993 reference is provided above, in connection with the analysis of how the Church 1993 reference anticipates claim 16.

Reasons to combine the Church 1993 reference and the Kozima 1993 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Church 1993 reference and the Kozima 1993 reference. The Church 1993 reference teaches using a computer-based program to analyze texts and identify features of that text. It teaches a variety of ways to display the features of the text in a dotplot format, such as employing color. The Kozima 1993 reference also teaches about representing a feature of a source text. In one representation, the Kozima 1993 reference teaches that a three-dimensional image could be used. By incorporating the three-dimensional imaging technique taught in the Kozima 1993 reference,

the method of the Church 1993 reference could be modified to provide a representation of a text that indicates through a three-dimensional dotplot an indication of a feature of the text. The combination of the Church 1993 reference and the Kozima 1993 reference represents merely the combination of known processes that yield predictable results, a method for providing a dotplot that indicates the occurrences of a feature of a processed source text using a three-dimensional image.

Accordingly, claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Kozima 1993 reference. Please see the Claim Chart at Exhibit 11 for additional details.

d. Claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Church 1990 reference.

Claim 15 recites "**[t]he method according to claim 13, wherein said step of identifying at least one textual feature includes identifying words in said text having generally the same definition**." To the extent that the Church 1993 reference does not expressly or inherently disclose this claim element, the Church 1990 reference discloses a method for identifying associated words, including words with generally the same definition (e.g., doctor and dentist). *See* Church 1990 reference at 24. The Church 1990 reference published in March 1990, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Church 1990 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify related words in a source text using a computer program was well known before the priority date of the ‘740 patent. as illustrated by the Church 1990 reference. It would be obvious to combine the teachings of the Church 1990 reference with the Church 1993 reference to arrive at the invention of claim 15, so as to modify the method of the Church 1993 reference to produce a dotplot that indicates the occurrences of words with the same definition in text.

Reasons to combine the Church 1993 reference and the Church 1990 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Church 1993 reference and the Church 1990 reference. The Church 1993 reference teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Church 1990 reference, the method of the Church 1993 reference could be modified to provide a representation of the text that indicates through the dotplot of the occurrence of related words, including words with generally the same definition. The combination of the Church 1993 reference and the Church 1990 reference represents merely the combination of known processes that yield predictable results, a method for providing a dotplot that indicates the occurrences of the related nouns. Further, given the common author of the two references, one of ordinary skill in the art would have had an initial reason to consider the combined teachings of the two references.

Accordingly, claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Church 1993 reference in view of the Church 1990 reference. Please see the Claim Chart at Exhibit 11 for additional details.

8. **Obviousness under 35 U.S.C. § 103(a) based on Cina '808 patent.**

a. Claims 2, 3, 4, 5, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Brill 1992 reference.

Claim 2

Claim 2 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring noun within said portion of said text**." To the extent that the Cina '808 patent fails to expressly or inherently disclose the subject matter of claim 2, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. The Brill 1992 reference published in February 1992, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Brill 1992 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Cina '808 patent to arrive at the invention of claim 2. Using the teachings of the Brill 1992 reference, the Cina '808 patent would be modified to show, on the scroll bar, the location of the most frequently occurring nouns, in a manner similar to the way the Cina '808 patent teaches displaying "hits" from a search of the text.

Reasons to combine the Cina '808 patent and the Brill 1992 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Cina '808 patent and the Brill 1992 reference. The Cina '808 patent reference teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Brill 1992 reference, the method of the Cina '808 patent could be modified to provide a representation of the text that indicates on the scroll bar the occurrence of the most frequently occurring nouns. The Brill 1992 reference discloses that the method can accurately tag parts of speech. The combination of the Cina '808 patent and the Brill 1992 reference represents merely the combination of known processes that yield predictable results, a method for providing a representation of text on a scroll bar that indicates the occurrences of the most frequently occurring nouns.

Accordingly, claim 2 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 12 for additional details.

Claim 3

Claim 3 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring nouns within said portion of said text**." To the extent that the Cina '808 patent fails to expressly or inherently disclose the subject matter of claim 3, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. As discussed above

in connection with the analysis for claim 2, the Brill 1992 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Cina '808 patent to arrive at the invention of claim 3. Using the teachings of the Brill 1992 reference, the Cina '808 patent would be modified to show, on a scroll bar, the location of the most frequently occurring nouns, similar to how the Cina '808 patent teaches showing the "hits" from a search of a body of text. Reasons to combine the Cina '808 patent and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 3 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 12 for additional details.

Claim 4

Claim 4 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating multiple representations of said portion of said text wherein each of said representations includes a graphical indication that indicates the presence of one of said frequently occurring nouns at at least one location therein**." The Cina '808 patent discloses creating multiple representations of a portion of text. As the Patent Owner admits in infringement contentions in a pending litigation, a "representation" would include a scroll bar. The Cina '808 patent discloses both a horizontal scroll bar and a vertical scroll bar, with indications of a text property on each of these scroll bars. *See, e.g.*, Cina '808

patent, Fig. 3 (depicted above in connection with the analysis of the Cina '808 patent and claim 1) and accompanying text. For example, using the image of Figure 3, a symbol could appear on both the horizontal and vertical scroll bars, such as a "—," to indicate the location of the most frequently occurring noun.

Accordingly, claim 4 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 12 for additional details. Reasons to combine the Cina '808 patent and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Claim 5

Claim 5 recites "**[t]he method according to claim 4, further including the step of creating a composite representation from each of said representations, wherein said composite representation illustrates areas within said portion of said text common to at least two of said representations**." The Cina '808 patent discloses creating multiple representations of a portion of text. As the Patent Owner admits in infringement contentions in a pending litigation, a "representation" would include a scroll bar. The Cina '808 patent discloses both a horizontal scroll bar and a vertical scroll bar, with indications of a text property on each of these scroll bars. *See, e.g.*, Cina '808 patent, Fig. 3 (depicted above in connection with the analysis of the Cina '808 patent and claim 1) and accompanying text. For example, using the image of Figure 3, a symbol could appear on both the horizontal and vertical scroll bars, such as a "—," to indicate the location of the most frequently occurring noun. The horizontal and vertical scroll bars together are the recited composite representation, as depicted in Fig. 3.

Accordingly, claim 5 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 12 for additional details. Reasons to combine the Cina '808 patent and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Claim 6

Claim 6 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating a representation that indicates locations within said portion of said text that contain more than one frequently occurring nouns**." To the extent that the Cina '808 patent fails to expressly or inherently disclose the subject matter of claim 6, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. As discussed above in connection with the analysis for claim 2, the Brill 1992 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Cina '808 patent to arrive at the invention of claim 6. Using the teachings of the Brill 1992 reference, the Cina '808 patent would be modified to show, on a scroll bar, the location of the most frequently occurring nouns, similar to how the Cina '808 patent teaches showing the "hits" from a search of a body of text. Reasons to combine the Cina '808 patent and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 6 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 12 for additional details.

b. Claims 2, 3, 4, 5, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Church 1988 reference.

Claim 2

Claim 2 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring noun within said portion of said text**." To the extent that the Cina '808 patent fails to expressly or inherently disclose the subject matter of claim 2, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Church 1988 reference discloses a computer-based method for tagging words in a text based on the parts of the Church 1988 reference published in February 1988, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Church 1988 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1988 reference. It would be obvious to combine the teachings of the Church 1988 reference with the Cina '808 patent to arrive at the invention of claim 2. Using the teachings of the Church 1988 reference, the Cina '808 patent would be modified to show, on the scroll bar, the location

of the most frequently occurring nouns, in a manner similar to the way the Cina '808 patent teaches displaying "hits" from a search of the text.

Reasons to combine the Cina '808 patent and the Church 1988 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Cina '808 patent and the Church 1988 reference. The Cina '808 patent reference teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Church 1988 reference, the method of the Cina '808 patent could be modified to provide a representation of the text that indicates on the scroll bar the occurrence of the most frequently occurring nouns. The Church 1988 reference discloses that the method can accurately tag parts of speech. The combination of the Cina '808 patent and the Church 1988 reference represents merely the combination of known processes that yield predictable results, a method for providing a representation of text on a scroll bar that indicates the occurrences of the most frequently occurring nouns.

Accordingly, claim 2 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 12 for additional details.

Claim 3

Claim 3 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring nouns within said portion of said text**." To the extent that the Cina '808 patent fails to expressly or inherently disclose the subject matter of claim 3, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Church 1988 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word,

such as noun, verb, noun phrase, *etc*. *See generally*, Church 1988 reference. As discussed above in connection with the analysis for claim 2, the Church 1988 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1988 reference. It would be obvious to combine the teachings of the Church 1988 reference with the Cina '808 patent to arrive at the invention of claim 3. Using the teachings of the Church 1988 reference, the Cina '808 patent would be modified to show, on a scroll bar, the location of the most frequently occurring nouns, similar to how the Cina '808 patent teaches showing the "hits" from a search of a body of text. Reasons to combine the Cina '808 patent and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 3 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 12 for additional details.

Claim 4

Claim 4 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating multiple representations of said portion of said text wherein each of said representations includes a graphical indication that indicates the presence of one of said frequently occurring nouns at at least one location therein**." The Cina '808 patent discloses creating multiple representations of a portion of text. As the patent Owner admits in infringement contentions in a pending litigation, a "representation" would include a scroll bar. The Cina '808 patent discloses both a horizontal scroll bar and a vertical

scroll bar, with indications of a text property on each of these scroll bars. *See, e.g.*, Cina '808 patent, Fig. 3 (depicted above in connection with the analysis of the Cina '808 patent and claim 1) and accompanying text. For example, using the image of Figure 3, below, a symbol could appear on both the horizontal and vertical scroll bars, such as a "—," to indicate the location of the most frequently occurring noun.

Accordingly, claim 4 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 12 for additional details. Reasons to combine the Cina '808 patent and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Claim 5

Claim 5 recites "**[t]he method according to claim 4, further including the step of creating a composite representation from each of said representations, wherein said composite representation illustrates areas within said portion of said text common to at least two of said representations**." The Cina '808 patent discloses creating multiple representations of a portion of text. As the Patent Owner admits in infringement contentions in a pending litigation, a "representation" would include a scroll bar. The Cina '808 patent discloses both a horizontal scroll bar and a vertical scroll bar, with indications of a text property on each of these scroll bars. *See, e.g.*, Cina '808 patent, Fig. 3 (depicted above in connection with the analysis of the Cina '808 patent and claim 1) and accompanying text. For example, using the image of Figure 3, a symbol could appear on both the horizontal and vertical scroll bars, such as a "—," to indicate the location of the most frequently occurring noun. The horizontal and vertical scroll bars together are the recited composite representation, as depicted in Fig. 3.

Accordingly, claim 5 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 12 for additional details. Reasons to combine the Cina '808 patent and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Claim 6

Claim 6 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating a representation that indicates locations within said portion of said text that contain more than one frequently occurring nouns**." To the extent that the Cina '808 patent fails to expressly or inherently disclose the subject matter of claim 6, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Church 1988 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, etc. *See generally*, Church 1988 reference. As discussed above in connection with the analysis for claim 2, the Church 1988 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by Church 1988 reference. It would be obvious to combine the teachings of the Church 1988 reference with the Cina '808 patent to arrive at the invention of claim 6. Using the teachings of Church 1988 reference, the Cina '808 patent would be modified to show, on a scroll bar, the location of the most frequently occurring nouns, similar to how the Cina '808 patent teaches showing the "hits" from a search of a body of text. Reasons to combine the Cina '808 patent and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 6 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 12 for additional details.

c. Claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Kozima 1993 reference.

Claim 12 recites "**[t]he method according to claim 1, further including the step of displaying said at least one representation in a three dimensional format**." To the extent that the Cina '808 patent does not expressly or inherently disclose this claim element, the Kozima 1993 reference discloses a method for depicting a feature of a given text, specifically word similarity, in a three dimensional manner *See* Kozima 1993 reference, Fig. 1 and accompanying text. The Kozima 1993 reference was published in June 1993. The Kozima 1993 is prior art to the '740 patent under 35 U.S.C. § 102(b), given a priority date for the '740 patent of Jun. 3, 1996. To the extent that any of the claims of the '740 patent is entitled to the earlier priority date of the parent patent application for the application that matured into the '740 patent, then the Kozima 1993 reference is prior art under 35 U.S.C. § 102(a) for such claims. The Kozima 1993 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The use of three-dimensional imaging was well known before the priority date of the '740 patent, as illustrated by the Kozima 1993 reference. It would be obvious to combine the teachings of the Kozima 1993 reference with the Cina '808 patent to arrive at the invention of claim 12, namely displaying results in a three dimensional manner. For example, symbols on the scroll bar generated by the method of the Cina '808 patent could be three-dimensional.

Reasons to combine the Cina '808 patent and the Kozima 1993 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Cina '808 patent and the Kozima 1993 reference. The Cina '808 patent teaches using a computer-based program to analyze texts and identify features of that text. It teaches a variety of ways to display the features of the text on a scroll bar, such as employing symbols or color. The Kozima 1993 reference also teaches about representing a feature of a source text. In one representation, the Kozima 1993 reference teaches that a three-dimensional image could be used. By incorporating the three-dimensional imaging technique taught in the Kozima 1993 reference, the method of the Cina '808 patent could be modified to provide a representation of a text that indicates through a three-dimensional symbol an indication of a feature of the text. The combination of the Cina '808 patent and the Kozima 1993 reference represents merely the combination of known processes that yield predictable results, a method for a representation of text on a scroll bar that indicates the occurrences of a feature of a processed source text using a three-dimensional image.

Accordingly, claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Kozima 1993 reference. Please see the Claim Chart at Exhibit 12 for additional details.

d. Claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Church 1990 reference.

Claim 15 recites "**[t]he method according to claim 13, wherein said step of identifying at least one textual feature includes identifying words in said text having generally the same definition**." To the extent that the Cina '808 patent does not expressly or inherently disclose this claim element, the Church 1990 reference discloses a method for identifying associated words,

including words with generally the same definition (e.g., doctor and dentist). *See* Church 1990 reference at 24. The Church 1990 reference published in March 1990, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Church 1990 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify related words in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1990 reference. It would be obvious to combine the teachings of the Church 1990 reference with the Cina '808 patent to arrive at the invention of claim 15. The method of the Cina '808 patent would be modified to provide an indication on a scroll bar of words with the same definition.

Reasons to combine the Cina '808 patent and the Church 1990 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Cina '808 patent and the Church 1990 reference. The Cina '808 patent teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Church 1990 reference, the method of the Cina '808 patent could be modified to provide a representation of the text that indicates on a scroll bar the occurrence of related words, including words with generally the same definition. The combination of the Cina '808 patent and the Church 1990 reference represents merely the combination of known processes that yield predictable results, a method for providing a scroll bar that indicates the occurrences of the related nouns, in a manner similar to the method disclosed in Cina '808 patent for displaying "hits" from a search.

Accordingly, claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Cina '808 patent in view of the Church 1990 reference. Please see the Claim Chart at Exhibit 12 for additional details.

9. **Obviousness under 35 U.S.C. § 103(a) based on Eick '998 patent.**

a. Claims 2, 3, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick '998 patent in view of the Brill 1992 reference.

Claim 2

Claim 2 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring noun within said portion of said text**." To the extent that the Eick '998 patent fails to expressly or inherently disclose the subject matter of claim 2, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. The Brill 1992 reference published in February 1992, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Brill 1992 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Eick '998 patent to arrive at the invention of claim 2. Using the teachings of the Brill 1992

reference, the Eick ‘998 patent would be modified to show, on the scroll bar or display column, the location of the most frequently occurring nouns, in a manner similar to the way the Eick ‘998 patent teaches displaying other textual features.

Reasons to combine the Eick ‘998 patent and the Brill 1992 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Eick ‘998 patent and the Brill 1992 reference. The Eick ‘998 patent teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Brill 1992 reference, the method of the Eick ‘998 patent could be modified to provide a representation of the text that indicates on the scroll bar the occurrence of the most frequently occurring nouns. The Brill 1992 reference discloses that the method can accurately tag parts of speech. The combination of the Eick ‘998 patent and the Brill 1992 reference represents merely the combination of known processes that yield predictable results, a method for providing a representation of text on a scroll bar or display column that indicates the occurrences of the most frequently occurring nouns.

Accordingly, claim 2 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick ‘998 patent in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 13 for additional details.

Claim 3

Claim 3 recites “**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring nouns within said portion of said text**.” To the extent that the Eick ‘998 patent fails to expressly or inherently disclose the subject matter of claim 3, a method that identifies the most frequently occurring

noun within a body of text is known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. As discussed above in connection with the analysis for claim 2, the Brill 1992 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Eick '998 patent to arrive at the invention of claim 3. Using the teachings of the Brill 1992 reference, the Eick '998 patent would be modified to show, on a scroll bar, the location of the most frequently occurring nouns, similar to how the Eick '998 patent teaches displaying other textual features. Reasons to combine the Eick '998 patent and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 3 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick '998 patent in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 13 for additional details.

Claim 6

Claim 6 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating a representation that indicates locations within said portion of said text that contain more than one frequently occurring nouns**." To the extent that the Eick '998 patent fails to expressly or inherently disclose the subject matter of claim 6, a method that identifies the most frequently occurring noun within a body of text is

known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. As discussed above in connection with the analysis for claim 2, the Brill 1992 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Eick '998 patent to arrive at the invention of claim 6. Using the teachings of the Brill 1992 reference, the Eick '998 patent would be modified to show, on a scroll bar or display column, the location of the most frequently occurring nouns, similar to how the Eick '998 patent teaches showing other textual features. Reasons to combine the Eick '998 patent and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 6 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick '998 patent in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 13 for additional details.

b. Claims 2, 3, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick '998 patent in view of the Church 1988 reference.

Claim 2

Claim 2 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring noun within said portion of said text**." To the extent that the Eick '998 patent fails to expressly or inherently disclose the subject matter of claim 2, a method that identifies the most frequently occurring

noun within a body of text is known. For example, the Church 1988 reference discloses a computer-based method for tagging words in a text based on the parts of the Church 1988 reference published in February 1988, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Church 1988 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1988 reference. It would be obvious to combine the teachings of the Church 1988 reference with the Eick '998 patent to arrive at the invention of claim 2. Using the teachings of the Church 1988 reference, the Eick '998 patent would be modified to show, on the scroll bar or display column, the location of the most frequently occurring nouns, in a manner similar to the way the Eick '998 patent teaches displaying other textual features.

Reasons to combine the Eick '998 patent and the Church 1988 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Eick '998 patent and the Church 1988 reference. The Eick '998 patent reference teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Church 1988 reference, the method of the Eick '998 patent could be modified to provide a representation of the text that indicates on the scroll bar or display column the occurrence of the most frequently occurring nouns. The Church 1988 reference discloses that the method can accurately tag parts of speech. The combination of the Eick '998 patent and

the Church 1988 reference represents merely the combination of known processes that yield predictable results, a method for providing a representation of text on a scroll bar or display column that indicates the occurrences of the most frequently occurring nouns.

Accordingly, claim 2 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick '998 patent in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 13 for additional details.

Claim 3

Claim 3 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring nouns within said portion of said text**." To the extent that the Eick '998 patent fails to expressly or inherently disclose the subject matter of claim 3, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Church 1988 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Church 1988 reference. As discussed above in connection with the analysis for claim 2, the Church 1988 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1988 reference. It would be obvious to combine the teachings of the Church 1988 reference with the Eick '998 patent to arrive at the invention of claim 3. Using the teachings of the Church 1988 reference, the Eick '998 patent would be modified to show, on a scroll bar or display column, the location of the most frequently occurring nouns, similar to how the Eick '998 patent

teaches showing other textual features. Reasons to combine the Eick '998 patent and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 3 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick '998 patent in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 13 for additional details.

Claim 6

Claim 6 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating a representation that indicates locations within said portion of said text that contain more than one frequently occurring nouns**." To the extent that the Eick '998 patent fails to expressly or inherently disclose the subject matter of claim 6, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Church 1988 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Church 1988 reference. As discussed above in connection with the analysis for claim 2, the Church 1988 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1988 reference. It would be obvious to combine the teachings of the Church 1988 reference with the Eick '998 patent to arrive at the invention of claim 6. Using the teachings of Church 1988 reference, the Eick '998 patent would be modified to show, on a scroll bar or display column, the location of the most frequently occurring nouns, similar to how the Eick '998 patent teaches

showing other textual features. Reasons to combine the Eick '998 patent and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 6 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick '998 patent in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 13 for additional details.

c. Claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick '998 patent in view of the Kozima 1993 reference.

Claim 12 recites "**[t]he method according to claim 1, further including the step of displaying said at least one representation in a three dimensional format**." To the extent that the Eick '998 patent does not expressly or inherently disclose this claim element, the Kozima 1993 reference discloses a method for depicting a feature of a given text, specifically word similarity, in a three dimensional manner *See* Kozima 1993 reference, Fig. 1 and accompanying text. The Kozima 1993 reference was published in June 1993. The Kozima 1993 is prior art to the '740 patent under 35 U.S.C. § 102(b), given a priority date for the '740 patent of Jun. 3, 1996. To the extent that any of the claims of the '740 patent is entitled to the earlier priority date of the parent patent application for the application that matured into the '740 patent, then the Kozima 1993 reference is prior art under 35 U.S.C. § 102(a) for such claims. The Kozima 1993 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The use of three-dimensional imaging was well known before the priority date of the '740 patent, as illustrated by the Kozima 1993 reference. It would be obvious to combine the teachings of the Kozima 1993 reference with the Eick '998 patent to arrive at the invention of

claim 12, namely displaying results in a three dimensional manner. For example, symbols on the scroll bar or display column generated by the method of the Eick '998 patent could be three-dimensional.

Reasons to combine the Eick '998 patent and the Kozima 1993 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Eick '998 patent and the Kozima 1993 reference. The Eick '998 patent teaches using a computer-based program to analyze texts and identify features of that text. It teaches a variety of ways to display the features of the text in a column or scroll bar format, such as employing color. The Kozima 1993 reference also teaches about representing a feature of a source text. In one representation, the Kozima 1993 reference teaches that a three-dimensional image could be used. By incorporating the three-dimensional imaging technique taught in the Kozima 1993 reference, the method of the Eick '998 patent could be modified to provide a representation of a text that indicates through a three-dimensional symbol an indication of a feature of the text. The combination of the Eick '998 patent and the Kozima 1993 reference represents merely the combination of known processes that yield predictable results, a method for a representation of text on a scroll bar that indicates the occurrences of a feature of a processed source text using a three-dimensional image.

Accordingly, claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick '998 patent in view of the Kozima 1993 reference. Please see the Claim Chart at Exhibit 13 for additional details.

d. Claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick '998 patent in view of the Church 1990 reference.

Claim 15 recites "**[t]he method according to claim 13, wherein said step of identifying at least one textual feature includes identifying words in said text having generally the same definition**." To the extent that the Eick '998 patent does not expressly or inherently disclose this claim element, the Church 1990 reference discloses a method for identifying associated words, including words with generally the same definition (e.g., doctor and dentist). *See* Church 1990 reference at 24. The Church 1990 reference published in March 1990, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Church 1990 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify related words in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1990 reference. It would be obvious to combine the teachings of the Church 1990 reference with the Eick '998 patent to arrive at the invention of claim 15. The method of the Eick '998 patent would be modified to provide an indication on a scroll bar or display column of words with the same definition.

Reasons to combine the Eick '998 patent and the Church 1990 reference.

One of ordinary skill in the art would have reasons to combine the teachings of Eick '998 patent and the Church 1990 reference. The Eick '998 patent teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught

in the Church 1990 reference, the method of the Eick '998 patent could be modified to provide a representation of the text that indicates on a scroll bar the occurrence of related words, including words with generally the same definition. The combination of the Eick '998 patent and the Church 1990 reference represents merely the combination of known processes that yield predictable results, a method for providing a scroll bar or display column that indicates the occurrences of the related nouns, in a manner similar to the method disclosed in Eick '998 patent for displaying other textual features.

Accordingly, claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick '998 patent in view of the Church 1990 reference. Please see the Claim Chart at Exhibit 13 for additional details.

10. **Obviousness under 35 U.S.C. § 103(a) based on Eick 1992 reference.**

a. Claims 2, 3, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Brill 1992 reference.

Claim 2

Claim 2 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring noun within said portion of said text**." To the extent that the Eick 1992 reference fails to expressly or inherently disclose the subject matter of claim 2, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. The Brill 1992 reference published in February 1992, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application

that matured into the ‘740 patent. The Brill 1992 reference was not in front of the Patent Office during the prosecution of the application that matured into the ‘740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the ‘740 patent.

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the ‘740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Eick 1992 reference to arrive at the invention of claim 2. Using the teachings of the Brill 1992 reference, the Eick 1992 reference would be modified to show, on the scroll bar or display column, the location of the most frequently occurring nouns, in a manner similar to the way the Eick 1992 reference teaches displaying other textual features.

Reasons to combine the Eick 1992 reference and the Brill 1992 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Eick 1992 reference and the Brill 1992 reference. The Eick 1992 reference teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Brill 1992 reference, the method of the Eick 1992 reference could be modified to provide a representation of the text that indicates on the scroll bar the occurrence of the most frequently occurring nouns. The Brill 1992 reference discloses that the method can accurately tag parts of speech. The combination of the Eick 1992 reference and the Brill 1992 reference represents merely the combination of known processes that yield predictable results, a method for providing a representation of text on a scroll bar or display column that indicates the occurrences of the most frequently occurring nouns.

Accordingly, claim 2 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 14 for additional details.

Claim 3

Claim 3 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring nouns within said portion of said text**." To the extent that the Eick 1992 reference fails to expressly or inherently disclose the subject matter of claim 3, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. As discussed above in connection with the analysis for claim 2, the Brill 1992 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Eick 1992 reference to arrive at the invention of claim 3. Using the teachings of the Brill 1992 reference, the Eick 1992 reference would be modified to show, on a scroll bar or display column, the location of the most frequently occurring nouns, similar to how the Eick 1992 reference teaches displaying other textual features. Reasons to combine the Eick 1992 reference and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 3 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 14 for additional details.

Claim 6

Claim 6 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating a representation that indicates locations within said portion of said text that contain more than one frequently occurring nouns**." To the extent that the Eick 1992 reference fails to expressly or inherently disclose the subject matter of claim 6, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. As discussed above in connection with the analysis for claim 2, the Brill 1992 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Eick 1992 reference to arrive at the invention of claim 6. Using the teachings of the Brill 1992 reference, the Eick 1992 reference would be modified to show, on a scroll bar or display column, the location of the most frequently occurring nouns, similar to how the Eick 1992 reference teaches showing other textual features. Reasons to combine the Eick 1992 reference and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 6 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 14 for additional details.

b. Claims 2, 3, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Church 1988 reference.

Claim 2

Claim 2 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring noun within said portion of said text**." To the extent that the Eick 1992 reference fails to expressly or inherently disclose the subject matter of claim 2, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Church 1988 reference discloses a computer-based method for tagging words in a text based on the parts of the Church 1988 reference published in February 1988, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Church 1988 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1988 reference. It would be obvious to combine the teachings of the Church 1988 reference with the Eick 1992 reference to arrive at the invention of claim 2. Using the teachings of the Church

1988 reference, the Eick 1992 reference would be modified to show, on the scroll bar or display column, the location of the most frequently occurring nouns, in a manner similar to the way the Eick 1992 reference teaches displaying other textual features.

Reasons to combine the Eick 1992 reference and the Church 1988 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Eick 1992 reference and the Church 1988 reference. The Eick 1992 reference teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Church 1988 reference, the method of the Eick 1992 reference could be modified to provide a representation of the text that indicates on the scroll bar or display column the occurrence of the most frequently occurring nouns. The Church 1988 reference discloses that the method can accurately tag parts of speech. The combination of the Eick 1992 reference and the Church 1988 reference represents merely the combination of known processes that yield predictable results, a method for providing a representation of text on a scroll bar or display column that indicates the occurrences of the most frequently occurring nouns.

Accordingly, claim 2 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 14 for additional details.

Claim 3

Claim 3 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring nouns within said portion of said text**." To the extent that the Eick 1992 reference fails to expressly or inherently disclose the subject matter of claim 3, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Church 1988 reference discloses a

computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Church 1988 reference. As discussed above in connection with the analysis for claim 2, the Church 1988 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1988 reference. It would be obvious to combine the teachings of the Church 1988 reference with the Eick 1992 reference to arrive at the invention of claim 3. Using the teachings of the Church 1988 reference, the Eick 1992 reference would be modified to show, on a scroll bar or display column, the location of the most frequently occurring nouns, similar to how the Eick 1992 reference teaches showing other textual features. Reasons to combine the Eick 1992 reference and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 3 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 14 for additional details.

Claim 6

Claim 6 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating a representation that indicates locations within said portion of said text that contain more than one frequently occurring nouns**." To the extent that the Eick 1992 reference fails to expressly or inherently disclose the subject matter of claim 6, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Church 1988 reference discloses a computer-based method for tagging

words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Church 1988 reference. As discussed above in connection with the analysis for claim 2, the Church 1988 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by Church 1988 reference. It would be obvious to combine the teachings of the Church 1988 reference with the Eick 1992 reference to arrive at the invention of claim 6. Using the teachings of Church 1988 reference, the Eick 1992 reference would be modified to show, on a scroll bar or display column, the location of the most frequently occurring nouns, similar to how the Eick 1992 reference teaches showing other textual features. Reasons to combine the Eick 1992 reference and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 6 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 14 for additional details.

c. Claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Kozima 1993 reference.

Claim 12 recites "**[t]he method according to claim 1, further including the step of displaying said at least one representation in a three dimensional format**." To the extent that the Eick 1992 reference does not expressly or inherently disclose this claim element, the Kozima 1993 reference discloses a method for depicting a feature of a given text, specifically word similarity, in a three dimensional manner *See* Kozima 1993 reference, Fig. 1 and accompanying text. The Kozima 1993 reference was published in June 1993. The Kozima 1993 is prior art to

the ‘740 patent under 35 U.S.C. § 102(b), given a priority date for the ‘740 patent of Jun. 3, 1996. To the extent that any of the claims of the ‘740 patent is entitled to the earlier priority date of the parent patent application for the application that matured into the ‘740 patent, then the Kozima 1993 reference is prior art under 35 U.S.C. § 102(a) for such claims. The Kozima 1993 reference was not in front of the Patent Office during the prosecution of the application that matured into the ‘740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the ‘740 patent.

The use of three-dimensional imaging was well known before the priority date of the ‘740 patent, as illustrated by the Kozima 1993 reference. It would be obvious to combine the teachings of the Kozima 1993 reference with the Eick 1992 reference to arrive at the invention of claim 12, namely displaying results in a three dimensional manner. For example, symbols on the scroll bar or display column generated by the method of the Eick 1992 reference could be three-dimensional.

Reasons to combine the Eick 1992 reference and the Kozima 1993 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Eick 1992 reference and the Kozima 1993 reference. The Eick 1992 reference teaches using a computer-based program to analyze texts and identify features of that text. It teaches a variety of ways to display the features of the text in a column or scroll bar format, such as employing color. The Kozima 1993 reference also teaches about representing a feature of a source text. In one representation, the Kozima 1993 reference teaches that a three-dimensional image could be used. By incorporating the three-dimensional imaging technique taught in the Kozima 1993 reference, the method of the Eick 1992 reference could be modified to provide a representation of a text that indicates through a three-dimensional symbol an indication of a feature of the text. The

combination of the Eick 1992 reference and the Kozima 1993 reference represents merely the combination of known processes that yield predictable results, a method for a representation of text on a scroll bar or display column that indicates the occurrences of a feature of a processed source text using a three-dimensional image.

Accordingly, claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Kozima 1993 reference. Please see the Claim Chart at Exhibit 14 for additional details.

d. Claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Church 1990 reference.

Claim 15 recites "**[t]he method according to claim 13, wherein said step of identifying at least one textual feature includes identifying words in said text having generally the same definition**." To the extent that the Eick 1992 reference does not expressly or inherently disclose this claim element, the Church 1990 reference discloses a method for identifying associated words, including words with generally the same definition (e.g., doctor and dentist). *See* Church 1990 reference at 24. The Church 1990 reference published in March 1990, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Church 1990 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify related words in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1990 reference. It

would be obvious to combine the teachings of the Church 1990 reference with the Eick 1992 reference to arrive at the invention of claim 15. The method of the Eick 1992 reference would be modified to provide an indication on a scroll bar or display column of words with the same definition.

Reasons to combine the Eick 1992 reference and the Church 1990 reference.

One of ordinary skill in the art would have reasons to combine the teachings of Eick '998 patent and the Church 1990 reference. The Eick 1992 reference teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Church 1990 reference, the method of the Eick 1992 reference could be modified to provide a representation of the text that indicates on a scroll bar the occurrence of related words, including words with generally the same definition. The combination of Eick 1992 reference and the Church 1990 reference represents merely the combination of known processes that yield predictable results, a method for providing a scroll bar or display column that indicates the occurrences of the related nouns, in a manner similar to the method disclosed in Eick 1992 reference for displaying other textual features.

Accordingly, claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Eick 1992 reference in view of the Church 1990 reference. Please see the Claim Chart at Exhibit 14 for additional details.

11. **Obviousness under 35 U.S.C. § 103(a) based on Gould '588 patent.**

a. Claims 2, 3, 4, 5, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Brill 1992 reference.

Claim 2

Claim 2 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring noun within said portion of said text**." To the extent that the Gould '588 patent fails to expressly or inherently disclose the subject matter of claim 2, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. The Brill 1992 reference published in February 1992, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Brill 1992 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Gould '588 patent to arrive at the invention of claim 2. Using the teachings of the Brill 1992 reference, the Gould '588 patent would be modified to show, on the scroll bar, the location of the most frequently occurring nouns, in a manner similar to the way the Gould '588 patent teaches displaying other textual features.

Reasons to combine the Gould '588 patent and the Brill 1992 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Gould '588 patent and the Brill 1992 reference. The Gould '588 patent teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Brill 1992 reference, the method of the Gould '588 patent could be modified to provide a representation of the text that indicates on the scroll bar the occurrence of the most frequently occurring nouns. The Brill 1992 reference discloses that the method can accurately tag parts of speech. The combination of the Gould '588 patent and the Brill 1992 reference represents merely the combination of known processes that yield predictable results, a method for providing a representation of text on a scroll bar that indicates the occurrences of the most frequently occurring nouns.

Accordingly, claim 2 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 15 for additional details.

Claim 3

Claim 3 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring nouns within said portion of said text**." To the extent that the Gould '588 patent fails to expressly or inherently disclose the subject matter of claim 3, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. As discussed above

in connection with the analysis for claim 2, the Brill 1992 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Gould '588 patent to arrive at the invention of claim 3. Using the teachings of the Brill 1992 reference, the Gould '588 patent would be modified to show, on a scroll bar, the location of the most frequently occurring nouns, similar to how the Gould '588 patent teaches displaying other textual features. Reasons to combine the Gould '588 patent and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 3 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 15 for additional details.

Claim 4

Claim 4 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating multiple representations of said portion of said text wherein each of said representations includes a graphical indication that indicates the presence of one of said frequently occurring nouns at at least one location therein**." The Gould '588 patent discloses creating multiple representations of a portion of text. As the Patent Owner admits in infringement contentions in a pending litigation, a "representation" would include a scroll bar. The Gould '588 patent discloses creating multiple representations of a portion of text. For example, the Gould '588 patent discloses, in Fig. 11 and accompanying text,

that different representations of the same portion of text can be provided, with the different representations focusing on different areas of the portions of text. *See* Fig. 11, reproduced above in connection with the analysis of how the Gould '588 patent anticipates claim 1 of the '740 patent.

Accordingly, claim 4 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 15 for additional details. Reasons to combine the Gould '588 patent and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Claim 5

Claim 5 recites "**[t]he method according to claim 4, further including the step of creating a composite representation from each of said representations, wherein said composite representation illustrates areas within said portion of said text common to at least two of said representations**." The Gould '588 patent discloses creating multiple representations of a portion of text. As the Patent Owner admits in infringement contentions in a pending litigation, a "representation" would include a scroll bar. The Gould '588 patent discloses creating multiple representations of a portion of text. For example, the Gould '588 patent discloses, in Fig. 11 and accompanying text, that different representations of the same portion of text can be provided, with the different representations focusing on different areas of the portions of text, forming a composite image, such as that shown in Figure 11 of the Gould '588 patent. *See* Fig. 11, reproduced above in connection with the analysis of how the Gould '588 patent anticipates claim 1 of the '740 patent.

Accordingly, claim 5 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 15 for additional details. Reasons to combine the Gould '588 patent and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Claim 6

Claim 6 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating a representation that indicates locations within said portion of said text that contain more than one frequently occurring nouns**." To the extent that the Gould '588 patent fails to expressly or inherently disclose the subject matter of claim 6, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Brill 1992 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Brill 1992 reference. As discussed above in connection with the analysis for claim 2, the Brill 1992 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Brill 1992 reference. It would be obvious to combine the teachings of the Brill 1992 reference with the Gould '588 patent to arrive at the invention of claim 6. Using the teachings of the Brill 1992 reference, the Gould '588 patent would be modified to show, on a scroll bar, the location of the most frequently occurring nouns, similar to how the Gould '588 patent teaches showing other textual features. Reasons to combine the Gould '588 patent and the Brill 1992 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 6 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Brill 1992 reference. Please see the Claim Chart at Exhibit 15 for additional details.

b. Claims 2, 3, 4, 5, and 6 are unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Church 1988 reference.

Claim 2

Claim 2 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring noun within said portion of said text**." To the extent that the Gould '588 patent fails to expressly or inherently disclose the subject matter of claim 2, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Church 1988 reference discloses a computer-based method for tagging words in a text based on the parts of the Church 1988 reference published in February 1988, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Church 1988 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1988 reference. It would be obvious to combine the teachings of the Church 1988 reference with the Gould '588 patent to arrive at the invention of claim 2. Using the teachings of the Church 1988 reference, the Gould '588 patent would be modified to show, on the scroll bar, the location

of the most frequently occurring nouns, in a manner similar to the way the Gould '588 patent teaches displaying other textual features.

Reasons to combine the Gould '588 patent and the Church 1988 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Gould '588 patent and the Church 1988 reference. The Gould '588 patent teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Church 1988 reference, the method of the Gould '588 patent could be modified to provide a representation of the text that indicates on the scroll bar the occurrence of the most frequently occurring nouns. The Church 1988 reference discloses that the method can accurately tag parts of speech. The combination of the Gould '588 patent and the Church 1988 reference represents merely the combination of known processes that yield predictable results, a method for providing a representation of text on a scroll bar or display column that indicates the occurrences of the most frequently occurring nouns.

Accordingly, claim 2 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 15 for additional details.

Claim 3

Claim 3 recites "**[t]he method according to claim 1, wherein said step of identifying at least one feature includes identifying the most frequently occurring nouns within said portion of said text**." To the extent that the Gould '588 patent fails to expressly or inherently disclose the subject matter of claim 3, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Church 1988 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word,

such as noun, verb, noun phrase, *etc*. *See generally*, Church 1988 reference. As discussed above in connection with the analysis for claim 2, the Church 1988 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1988 reference. It would be obvious to combine the teachings of the Church 1988 reference with the Gould '588 patent to arrive at the invention of claim 3. Using the teachings of the Church 1988 reference, the Gould '588 patent would be modified to show, on a scroll bar, the location of the most frequently occurring nouns, similar to how the Gould '588 patent teaches showing other textual features. Reasons to combine the Gould '588 patent and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 3 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 15 for additional details.

Claim 4

Claim 4 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating multiple representations of said portion of said text wherein each of said representations includes a graphical indication that indicates the presence of one of said frequently occurring nouns at at least one location therein**." The Gould '588 patent discloses creating multiple representations of a portion of text. As the Patent Owner admits in infringement contentions in a pending litigation, a "representation" would include a scroll bar. The Gould '588 patent discloses creating multiple representations of a

portion of text. For example, the Gould '588 patent discloses, in Fig. 11 and accompanying text, that different representations of the same portion of text can be provided, with the different representations focusing on different areas of the portions of text. *See* Fig. 11, reproduced above in connection with the analysis of how the Gould '588 patent anticipates claim 1 of the '740 patent.

Accordingly, claim 4 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 15 for additional details. Reasons to combine the Gould '588 patent and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Claim 5

Claim 5 recites "**[t]he method according to claim 4, further including the step of creating a composite representation from each of said representations, wherein said composite representation illustrates areas within said portion of said text common to at least two of said representations**." The Gould '588 patent discloses creating multiple representations of a portion of text. As the Patent Owner admits in infringement contentions in a pending litigation, a "representation" would include a scroll bar. The Gould '588 patent discloses creating multiple representations of a portion of text. For example, the Gould '588 patent discloses, in Fig. 11 and accompanying text, that different representations of the same portion of text can be provided, with the different representations focusing on different areas of the portions of text, forming a composite image, such as that shown in Figure 11 of the Gould '588 patent. *See* Fig. 11, reproduced above in connection with the analysis of how the Gould '588 patent anticipates claim 1 of the '740 patent.

Accordingly, claim 5 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 15 for additional details. Reasons to combine the Gould '588 patent and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Claim 6

Claim 6 recites "**[t]he method according to claim 3, wherein said step of creating at least one representation includes creating a representation that indicates locations within said portion of said text that contain more than one frequently occurring nouns**." To the extent that the Gould '588 patent fails to expressly or inherently disclose the subject matter of claim 6, a method that identifies the most frequently occurring noun within a body of text is known. For example, the Church 1988 reference discloses a computer-based method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, *etc*. *See generally*, Church 1988 reference. As discussed above in connection with the analysis for claim 2, the Church 1988 reference is prior art to the '740 patent under 35 U.S.C. § 102(b).

The ability to identify a part of speech, such as a noun, in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by Church 1988 reference. It would be obvious to combine the teachings of the Church 1988 reference with the Gould '588 patent to arrive at the invention of claim 6. Using the teachings of Church 1988 reference, the Eick 1992 reference would be modified to show, on a scroll bar, the location of the most frequently occurring nouns, similar to how the Gould '588 patent teaches showing other textual features. Reasons to combine the Gould '588 patent and the Church 1988 reference are provided above in connection with the analysis of claim 2.

Accordingly, claim 6 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Church 1988 reference. Please see the Claim Chart at Exhibit 15 for additional details.

c. Claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Kozima 1993 reference.

Claim 12 recites "**[t]he method according to claim 1, further including the step of displaying said at least one representation in a three dimensional format**." To the extent that the Gould '588 patent does not expressly or inherently disclose this claim element, the Kozima 1993 reference discloses a method for depicting a feature of a given text, specifically word similarity, in a three dimensional manner *See* Kozima 1993 reference, Fig. 1 and accompanying text. The Kozima 1993 reference was published in June 1993. The Kozima 1993 is prior art to the '740 patent under 35 U.S.C. § 102(b), given a priority date for the '740 patent of Jun. 3, 1996. To the extent that any of the claims of the '740 patent is entitled to the earlier priority date of the parent patent application for the application that matured into the '740 patent, then the Kozima 1993 reference is prior art under 35 U.S.C. § 102(a) for such claims. The Kozima 1993 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The use of three-dimensional imaging was well known before the priority date of the '740 patent, as illustrated by the Kozima 1993 reference. It would be obvious to combine the teachings of the Kozima 1993 reference with the Gould '588 patent to arrive at the invention of claim 12, namely displaying results in a three dimensional manner. For example, symbols on the scroll bar generated by the method of the Gould '588 patent could be three-dimensional.

Reasons to combine the Gould '588 patent and the Kozima 1993 reference.

One of ordinary skill in the art would have reasons to combine the teachings of the Gould '588 patent and the Kozima 1993 reference. The Gould '588 patent teaches using a computer-based program to analyze texts and identify features of that text. It teaches a variety of ways to display the features of the text in a column or scroll bar format, such as employing color. The Kozima 1993 reference also teaches about representing a feature of a source text. In one representation, the Kozima 1993 reference teaches that a three-dimensional image could be used. By incorporating the three-dimensional imaging technique taught in the Kozima 1993 reference, the method of the Gould '588 patent could be modified to provide a representation of a text that indicates through a three-dimensional symbol an indication of a feature of the text. The combination of the Gould '588 patent and the Kozima 1993 reference represents merely the combination of known processes that yield predictable results, a method for a representation of text on a scroll bar that indicates the occurrences of a feature of a processed source text using a three-dimensional image.

Accordingly, claim 12 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Kozima 1993 reference. Please see the Claim Chart at Exhibit 15 for additional details.

d. Claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould '588 patent in view of the Church 1990 reference.

Claim 15 recites "**[t]he method according to claim 13, wherein said step of identifying at least one textual feature includes identifying words in said text having generally the same definition**." To the extent that the Gould '588 patent does not expressly or inherently disclose this claim element, the Church 1990 reference discloses a method for identifying associated

words, including words with generally the same definition (e.g., doctor and dentist). *See* Church 1990 reference at 24. The Church 1990 reference published in March 1990, making it prior art under 35 U.S.C. § 102(b), regardless of whether the '740 patent is entitled to a priority date of the parent application to the application that matured into the '740 patent. The Church 1990 reference was not in front of the Patent Office during the prosecution of the application that matured into the '740 patent nor is it cumulative to the prior art considered by the Patent Office during the prosecution of the '740 patent.

The ability to identify related words in a source text using a computer program was well known before the priority date of the '740 patent, as illustrated by the Church 1990 reference. It would be obvious to combine the teachings of the Church 1990 reference with the Gould '588 patent to arrive at the invention of claim 15. The method of the Gould '588 patent would be modified to provide an indication on a scroll bar of words with the same definition.

Reasons to combine the Gould '588 patent and the Church 1990 reference.

One of ordinary skill in the art would have reasons to combine the teachings of Gould '588 patent and the Church 1990 reference. The Gould '588 patent teaches using a computer-based program to analyze texts and identify features of that text. By incorporating the program taught in the Church 1990 reference, the method of the Gould '588 patent could be modified to provide a representation of the text that indicates on a scroll bar the occurrence of related words, including words with generally the same definition. The combination of Gould '588 patent and the Church 1990 reference represents merely the combination of known processes that yield predictable results, a method for providing a scroll bar that indicates the occurrences of the related nouns, in a manner similar to the method disclosed in Gould '588 patent for displaying other textual features.

Accordingly, claim 15 is unpatentable under 35 U.S.C. § 103(a) as being obvious over the Gould ‘588 patent in view of the Church 1990 reference. Please see the Claim Chart at Exhibit 15 for additional details.

IV. CONCLUSION

For the reasons provided herein, Requester respectfully submits that the prior art submitted herewith raises substantial new questions of patentability as to claims 1-6 and 11-17 of the '740 patent because, as discussed above, claims 1-6 and 11-17 of the '740 patent are either anticipated or rendered obvious in view of the prior art patents and printed publications discussed herein. Accordingly, reexamination of claims 1-6 and 11-17 of the '740 patent is respectfully requested, finally rejecting these claims.

The undersigned further notes the standards set forth at 37 C.F.R. 1.550(f) wherein the reexamination Requester will be sent copies of Office actions issued during the reexamination proceedings as well as served (by the patent owner) with any document filed in the reexamination proceeding in accordance with 37 C.F.R. 1.248. (*See* MPEP §§ 2264 and 2266.)

If the Patent Office determines that a fee and/or other relief is required, Requester petition for any required relief including authorizing the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 11-0980** referencing Docket No. 13557.105030.

As identified in the attached Certificate of Service and in accordance with 37 C.F.R. §§ 1.33(c) and 1.510(b)(5), a copy of the present request is being served to the address of the attorney or agent of record.

April 2, 2010

Respectfully submitted,

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