**IN THE UNITED STATES DISTRICT COURT**

**FOR THE DISTRICT OF DELAWARE**

| | | |
|---|---|---|
| LEADER TECHNOLOGIES, INC., a Delaware corporation, | ) | |
| Plaintiff-Counterdefendant, | ) | Civil Action No. 08-862-JJF/LPS |
| v. | ) | |
| FACEBOOK, INC., a Delaware corporation, | ) | |
| Defendant-Counterclaimant. | ) | |

**DECLARATION OF JAMES HANNAH IN SUPPORT OF PLAINTIFF LEADER TECHNOLOGIES, INC.'S REPLY TO DEFENDANT FACEBOOK, INC.'S CLAIM CONSTRUCTION BRIEF**


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Dated: December 30, 2009

I, James Hannah, hereby declare:

1. I am an attorney with the law firm King & Spalding LLP, counsel of record for Plaintiff Leader Technologies, Inc. ("Leader"). I have personal knowledge of the facts set forth in this declaration and can testify competently to those facts.

2. Attached hereto as Exhibit 1 is a true and correct copy of a re-writing of all the asserted independent claims of the United States Patent No. 7,139,761 (the "'761 Patent") using the proposed constructions from Defendant Facebook's ("Facebook") Answering Claim Construction Brief.

3. Attached hereto as Exhibit 2 is a true and correct copy of a document illustrating the layers of the proposed constructions from Facebook's Answering Claim Construction Brief.

4. Attached hereto as Exhibit 3 is a true and correct copy of the e-mails between the parties from November 19, 2009 to November 20, 2009 setting the claim construction briefing schedule.

5. Attached hereto as Exhibit 4 is a true and correct copy of the Order from *Desa IP, LLC v. EML Techs., LLC*, No. 06-1168 (Fed. Cir. Jan 4, 2007).

I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct. Executed this 30th day of December, 2009, at Redwood Shores, California.

James Hannah

# EXHIBIT 1

**EXHIBIT 1**

Key:

**BOLD** - original claim language
UNDERLINE - Facebook's latest proposed terms
(BRACKET) - Facebook's latest proposed constructions

| Original Claim | Claim with Facebook's Proposed Constructions |
|---|---|
| **1. A computer-implemented network-based system that facilitates management of data, comprising:** | **1. A computer-implemented network-based system that facilitates management of data, comprising:** |
| **a computer-implemented context component of the network-based system for capturing context information associated with user-defined data created by user interaction of a user in a first context of the network-based system, the context component dynamically storing the context information in metadata associated with the user-defined data, the user-defined data and metadata stored on a storage component of the network-based system; and** | **a computer-implemented context component** (non-existent structure) **of the network-based system for capturing** (obtaining) **context information** (data that identifies a specific context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) **associated** (linked) **with user-defined data created by user interaction of a user in a first context** (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **of the network-based system, the context component** (non-existent structure) **dynamically** (automatically and in response to the preceding event) **storing the context information** (data that identifies a specific context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) **in metadata** (a stored item of information associated (linked) with a user's |

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| | data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/ workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))), user workspace (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) in which the user and the data currently reside) **associated** (linked) **with the user-defined data, the user-defined data and metadata** (a stored item of information associated (linked) with a user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))), user workspace (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside) **stored on a storage component** (non-existent structure) **of the network-based system; and** |
| **a computer-implemented tracking component of the network-based system for tracking a change of the user from the first context to a second context of the network-based system and dynamically updating the stored metadata based on the change, wherein the user accesses the data from the** | **a computer-implemented tracking component** (non-existent structure) **of the network-based system for tracking a change of the user from the first context** (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to |

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| **second context.** | accomplish a specific task) functionality related to a user-defined topic))) **to a second context** (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **of the network-based system and dynamically** (automatically and in response to the preceding event) **updating** (modifying the existing data to make it current) **the stored metadata** (a stored item of information associated (linked) with a user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))), user workspace (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) in which the user and the data currently reside) **based on the change** (in response to the user's movement from the first context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) to the second context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))), **wherein the user accesses** (retrieves information in the second context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality |

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| | related to a user-defined topic))) as distinct from uploading, adding or creating it) **the data from the second context** (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))). |

| Original Claim | Claim with Facebook's Proposed Constructions |
|---|---|
| **9. A computer-implemented method of managing data, comprising computer-executable acts of:** | **9. A computer-implemented method of managing data, comprising computer-executable acts of:** |
| **creating data within a user environment of a web-based computing platform via user interaction with the user environment by a user using an application, the data in the form of at least files and documents;** | **creating data within a user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) **of a web-based computing platform via user interaction with the user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) **by a user using an application** (a program designed to accomplish a specific task), **the data in the form of at least files and documents**; |
| **dynamically associating metadata with the data, the data and metadata stored on a storage component of the web-based computing platform, the metadata includes information related to the user, the data, the application, and the user environment;** | **dynamically** (automatically and in response to the preceding event) **associating** (linking) **metadata** (a stored item of information associated (linked) with the user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside) **with the** |

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| | **data, the data and metadata** (a stored item of information associated (linked) with the user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside) **stored on a storage component** (non-existent structure) **of the web-based computing platform, the metadata** (a stored item of information associated (linked) with the user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside) **includes information related to the user, the data, the application** (a program designed to accomplish a specific task), **and the user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)));
| **tracking movement of the user from the user environment of the web-based computing platform to a** | **tracking movement of the user from the user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection |

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| **second user environment of the web-based computing platform; and** | of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **of the web-based computing platform to a second user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **of the web-based computing platform; and** |
| **dynamically updating the stored metadata with an association of the data, the application, and the second user environment wherein the user employs at least one of the application and the data from the second environment.** | **dynamically** (automatically and in response to the preceding event) **updating** (modifying existing data to make current) **the stored metadata** (a stored item of information associated (linked) with the user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside) **with an association** (linking) **of the data, the application** (a program designed to accomplish a specific task), **and the second user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **wherein the user employs** (uses at least one of the application (a program designed to accomplish a specific task) and the data that is already in the second user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection |

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| | of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))), as distinct from uploading, adding or creating them) **at least one of the application** (a program designed to accomplish a specific task) **and the data from the second environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))). |

| Original Claim | Claim with Facebook's Proposed Constructions |
|---|---|
| **17. A computer-implemented method of managing data, comprising computer-executable acts of:** | **17. A computer-implemented method of managing data, comprising computer-executable acts of:** |
| **generating a plurality of user environments in a web-based system;** | **generating** (creating) **a plurality of user environments** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **in a web-based system;** |
| **ordering two or more of the plurality of user environments according to different arrangements of the user environments;** | **ordering** placing into a fixed sequence **two or more of the plurality of user environments** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **according to different arrangements** (a specifically-ordered set of items) **of the user environments** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)));) |
| **providing a plurality of applications for generating and processing data in the user environments, data of a user environment is dynamically associated with the user environment in metadata that corresponds to the data;** | **providing a plurality of applications** (a program designed to accomplish a specific task) **for generating** (creating) **and processing data in the user environments** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))), **data of a** |

| | |
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| | **user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **is dynamically** (automatically and in response to the preceding event) **associated** (linked) **with the user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **in metadata** (a stored item of information associated (linked) with the user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside) **that corresponds to the data;** |
| **creating an association of the data with a second user environment when the data is accessed from the second user environment;** | **creating an association** (linking) **of the data with a second user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **when the data is accessed** (the information is retrieved in the second user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a |

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| | specific task) functionality related to a user-defined topic))), as distinct from uploading, adding or creating it) **from the second user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))); |
| **dynamically storing the association of the data and the second user environment in the metadata;** | **dynamically** (automatically and in response to the preceding event) **storing the association** (linking) **of the data and the second user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **in the metadata** (a stored item of information associated (linked) with the user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside); |
| **storing in a storage component ordering information related to the ordering of the two or more of the plurality of user environments; and** | **storing in a storage component** (non-existent structure) **ordering information** (data that specifies a particular order in which user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) must be traversed (navigation by |

| | |
|---|---|
| | the user according to a specific path or route) **related to the ordering** (placing into a fixed sequence) **of the two or more of the plurality of user environments** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))); **and** |
| **traversing the different arrangements of the user environments with one or more of the applications based on the ordering information to locate the data associated with the user environments.** | **traversing** (navigation by the user according to a specific path or route) **the different arrangements** (a specifically-ordered set of items) **of the user environments** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **with one or more of the applications** (a program designed to accomplish a specific task) **based on the ordering information** (data that specifies a particular order in which user environments (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and appli |

# EXHIBIT 2

# Environment -- 5 Layers

environment = collection of interrelated contexts

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

# Context -- 4 Layers

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

# Web -- 3 Layers

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

# Workspace -- 2 Layers

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

# Metadata -- 7 Layers

metadata = a stored item of information associated with the user's data that identifies at least the context, user workspace or user environment in which the user and the data currently reside

↓

associated = linked

environment = collection of interrelated contexts

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

# Context Information -- 5 Layers

context information = data that identifies at least a specific context

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

# Change Information-- 3 Layers

change information = data that records the movement of a user from one workspace to another

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

# Change in Access of the User -- 6 Layers

change in access of the user = movement of a user from the first workspace to the second workspace to facilitate access in the second workspace

↓

accesses = retreives information in the second context or user workspace as distinct from uploading, adding or creating it

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

# Based on the Change -- 5 Layers

based on the change = in response to the user's movement from the first context to the second context

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

# Accesses -- 5 Layers

accesses = retrieves information in the second context or user workspace as distinct from uploading, adding or creating it

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

# Accessed -- 6 Layers

accessed = the information is retrieved in the second user environment, as distinct from uploading, adding or creating it

↓

environment = collection of interrelated contexts

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

# Employs -- 6 Layers

employs = uses at least one of the application and the data that is already in the second user environment, as distinct from uploading, adding or creating them

↓

environment = collection of interrelated contexts

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

# Employs -- 3 Layers

employs = uses at the application and data that is already in the second user workspace, as distinct from uploading, adding or creating them

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

# Ordering Information -- 7 Layers

ordering information = data that specifies a particular order in which user environments must be traversed

↓

environment = collection of interrelated contexts

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

traversing = navigation by the user according to a specific path or route

# EXHIBIT 3

**From:** Hannah, James
**Sent:** Friday, November 20, 2009 3:24 PM
**To:** 'Norberg, Jeffrey'
**Cc:** 'Steven Caponi'; 'Stackel, Mary Ellen'; Weinstein, Mark; 'Patti Clark'; 'Thomas Preston'; Andre, Paul; Keefe, Heidi; 'Rovner, Philip A.'; Kobialka, Lisa; Kastens, Kristopher; Keyes, Melissa
**Subject:** RE: Leader v. Facebook - Claim Construction Schedule

Jeff,

As we discussed on the phone, the parties will follow the following claim construction briefing schedule:

November 23rd - Parties exchange claim terms
November 25th - Parties meet and confer regarding claim terms
November 30th - Parties exchange claim constructions
December 2nd - Parties meet and confer regarding claim constructions
December 10th - Leader files opening claim construction brief
December 23rd - Facebook files response claim construction brief
December 30th - Leader files reply claim construction brief

We also agreed that all people on this email chain shall be served the claim construction briefs by email on the above provided due dates.

Let me know if you have any questions.

James

---

**From:** Norberg, Jeffrey [mailto:jnorberg@cooley.com]
**Sent:** Friday, November 20, 2009 2:22 PM
**To:** Hannah, James
**Cc:** 'Steven Caponi'; 'Stackel, Mary Ellen'; Weinstein, Mark; 'Patti Clark'; 'Thomas Preston'; Andre, Paul; Keefe, Heidi; 'Rovner, Philip A.'; Kobialka, Lisa; Kastens, Kristopher
**Subject:** RE: Leader v. Facebook - Claim Construction Schedule

James,

To facilitate a more meaningful meet and confer process, we propose the following schedule:

November 23rd - Parties exchange claim terms
November 25th - Parties meet and confer regarding claim terms
November 30th - Parties exchange claim constructions
December 2nd - Parties meet and confer regarding claim constructions

December 9th - Leader files opening claim construction brief
December 23rd - Facebook files response claim construction brief
December 30th - Leader files reply claim construction brief

Sincerely,

Jeff

---

**From:** Hannah, James [mailto:jhannah@KSLAW.com]
**Sent:** Friday, November 20, 2009 12:00 PM
**To:** Norberg, Jeffrey
**Cc:** 'Steven Caponi'; 'Stackel, Mary Ellen'; Weinstein, Mark; 'Patti Clark'; 'Thomas Preston'; Andre, Paul; Keefe, Heidi; 'Rovner, Philip A.'; Kobialka, Lisa; Kastens, Kristopher
**Subject:** RE: Leader v. Facebook - Claim Construction Schedule

Jeff,

Please confirm that Facebook agrees to the briefing schedule provided below and that Facebook agrees to serve all briefs by email. Thanks.

James

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**From:** Hannah, James
**Sent:** Thursday, November 19, 2009 12:08 PM
**To:** Norberg, Jeffrey
**Cc:** 'Steven Caponi'; 'Stackel, Mary Ellen'; Weinstein, Mark; 'Patti Clark'; 'Thomas Preston'; Andre, Paul; Keefe, Heidi; Rovner, Philip A.; Kobialka, Lisa; Kastens, Kristopher
**Subject:** Leader v. Facebook - Claim Construction Schedule

Jeff,

As a follow up to our conference this morning, we propose the following claim construction schedule:

November 23rd - Parties exchange claim terms
November 24th - Parties meet and confer regarding claim terms
November 25th - Parties exchange claim constructions
November 30th - Parties meet and confer regarding claim constructions
December 9th - Leader files opening claim construction brief
December 23rd - Facebook files opposition claim construction brief
December 30th - Leader files reply claim construction brief

Please let us know if Facebook agrees to the above claim construction briefing schedule. Also, due to the holiday season, we propose that all briefs be served by email to all parties addressed on this email. Please confirm that Facebook is agreeable to serve all briefs by email. Thanks.

James

**James Hannah**
*Attorney At Law*
King & Spalding LLP

Silicon Valley -
333 Twin Dolphin Drive, Suite 400
Redwood Shores, CA 94065

San Francisco -
Four Embarcadero Center, Suite 3500
San Francisco, CA 94111

Phone (SV & SF): (650) 590-0726
Fax (SV & SF): (650) 590-1900
Email: jhannah@kslaw.com

# EXHIBIT 4

NOTE: This disposition is nonprecedential.

# United States Court of Appeals for the Federal Circuit
(CORRECTED)

06-1168

DESA IP, LLC,

Plaintiff-Appellant,

v.

EML TECHNOLOGIES, LLC
and COSTCO WHOLESALE CORPORATION,

Defendants-Appellees.

James R. Higgins, Jr., Middleton Reutlinger, of Louisville, Kentucky, argued for plaintiff-appellant. With him on the brief were Augustus S. Herbert and Robert J. Theuerkauf.

Roger L. Cook, Townsend and Townsend and Crew LLP, of San Francisco, California, argued for defendants-appellees. With him on the brief was Iris Sockel Mitrakos.

Appealed from: United States District Court for the Middle District of Tennessee

Judge Aleta A. Trauger

NOTE: This disposition is nonprecedential.

# United States Court of Appeals for the Federal Circuit

06-1168

DESA IP, LLC,

Plaintiff-Appellant,

v.

EML TECHNOLOGIES, LLC
and COSTCO WHOLESALE CORPORATION,

Defendant-Appellees.

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DECIDED: January 4, 2007

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Before MICHEL, Chief Judge, PLAGER, Senior Circuit Judge, and RADER, Circuit Judge.

MICHEL, Chief Judge.

In this patent case, DESA IP, LLC ("DESA") appeals from a stipulated judgment of non-infringement, entered by the United States District Court for the Middle District of Tennessee following a claim construction hearing. Desa IP, LLC v. EML Techs., LLC, No. 3-04-0160 (Nov. 21, 2005). Because the district court erred in construing "sensor means" and other disputed terms, we vacate and remand.

## I. BACKGROUND

DESA is the owner of United States Patent No. 5,598,066 ("the '066 patent"), directed to motion-activated security lights. The '066 patent discloses a light that

illuminates at two levels: (1) a dim "accent" level when dusk is detected by a photocell within the apparatus and (2) a brighter "security" level which is rapidly activated when motion is detected by a passive infrared motion sensor. The lamp remains illuminated at the "security" level as long as the motion sensor continues to detect motion (which resets an internal timer), but eventually returns to "accent" mode. When the photocell senses daylight, however, the lamp is turned off.

The '066 patent further discloses that, in the preferred embodiment, there is a "manual override" feature, which keeps the light continuously on at the brighter "security level" until daylight. The preferred embodiment also has a "pulse counting" feature, which avoids false triggering by activating the "security" mode only when motion is twice detected by the sensor within a specified time period. These additional features, (neither of which are present in the accused device), are explicitly recited in some, but not all, of the claims.

On February 27, 2004, DESA filed suit against EML Technologies LLC ("EML") and Costco Wholesale Corporation ("Costco"),[1] alleging infringement of claims 6, 9, 10 and 11 of the '066 patent. Claim 6 recites:

> An apparatus comprising:
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> first sensor means for detecting a first predetermined condition external to said apparatus, said first predetermined condition being motion relative to said first sensor means of a person or object separate from said apparatus;
>
> second sensor means for detecting a second predetermined condition, said second predetermined condition being a predetermined level of light external to said apparatus;

[1] Costco imports and sells the allegedly infringing motion-activated security lights manufactured by EML.

a lamp which can emit a first level of illumination and which can emit a second level of illumination substantially greater than said first level of illumination, said lamp being capable of switching rapidly from said first level of illumination to said second level of illumination; and

control circuit means coupled to said lamp and responsive to said first and second sensor means for causing said lamp to emit light at said first level of illumination in the absence of said first predetermined condition in response to said second predetermined condition, and for causing said lamp to emit light at said second level of illumination in response to detection of said first predetermined condition;

wherein said control circuit means includes means responsive to detection of said first predetermined condition for initiating measurement of a predetermined time interval, and responsive to expiration of said time interval for causing said lamp to thereafter emit light at said first level of illumination in response to said second predetermined condition in the absence of a recurrence of said first predetermined condition.

Claim 9 recites:

sensor means for detecting a predetermined condition external to said apparatus;

a lamp which can emit a first level of illumination and which can emit a second level of illumination substantially greater than said first level of illumination, said lamp being capable of switching rapidly from said first level of illumination to said second level of illumination; and

control circuit means coupled to said lamp and responsive to said sensor means for causing said lamp to emit light at said first level of illumination in the absence of said predetermined condition, and for causing said lamp to emit light at said second level of illumination in response to detection of said predetermined condition, wherein said control circuit means is powered by an AC voltage, and wherein said control circuit means include switching means for selectively permitting and preventing the application of said AC voltage to said lamp and means for causing said switching means to be actuated for a selected portion of each half wave cycle of said AC voltage, said portion of said half waves being greater for said second level of illumination than for said first level of illumination.

Claims 10 and 11, although likewise drafted as independent claims, merely add additional limitations to those recited by claim 9.

The district court appointed as technical advisor Dr. Charles Carnal, a professor of electrical engineering at Tennessee Technological University. It held a three-day Markman hearing, during which multiple experts for both sides testified as to (1) the applicability of 35 U.S.C. § 112, ¶ 6 and (2) the meaning of the disputed claim terms.[2] At the end of the hearing, the court orally rendered its claim construction ruling. Hr'g Tr. 656-78, Oct. 27, 2005.

Most relevant to this appeal, the district court construed the disputed terms "sensor means," "control circuit means," and "switching means." As a preliminary matter, the court concluded that 35 U.S.C. § 112, ¶ 6 applied to all three of these phrases because the asserted claims did not recite sufficient structure, materials, or acts to perform the recited functions. Id. at 659:8-11.

The court found the corresponding structure for "first sensor means for detecting a first predetermined condition external to said apparatus" in claim 6—where "first predetermined condition" was internally defined within claim 6 to be "motion relative to said first sensor means of a person or object separate from said apparatus"—described at col.3 l.24-col.4 l.5 of the specification. Id. at 664:6-14. This definition includes not only the passive infrared sensors Q1 and Q2, but also what Professor Massengill dubbed "selection circuitry," i.e., circuits 43, 46, 47, 48 and 51 of Figures 2A and 2B. See id. at 481:5-11. The same meaning was ascribed to "sensor means for detecting a predetermined condition external to said apparatus" in claims 9, 10 and 11. Id. at 665:16-25.

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[2] Mark Patterson, William Raper, Thomas J. Paulus, and Steven Carlson testified for DESA. J. Michael Thesz, Scott Evans, and Professor Lloyd Massengill testified on behalf of EML and Costco.

As for "control circuit means," the court found that this described, in plain language, "the means for causing the lamp to go on at accent level when there is no motion but it's dark or dusk, and then going up to the higher level of illumination, which I believe is 95%, in response to detection of the motion of a person or object." Id. at 667:15-22. It found the corresponding structure for this function described at col.5 l.63-col.6 l.14. Id. at 667:24-668:4.

Finally, "switching means for selectively permitting and preventing the application of said AC voltage to said lamp" was described by the court in plain language as "basically a switch that allows the lamp to either be on or off." Id. at 670:5-6. The court found the corresponding structure described at col.5 ll.13-25, which was, as EML and Costco had argued, "more than just the triac."[3] Id. at 670:22.

The court then stressed that all of the means-plus-function terms were being construed to include structural equivalents, too. Id. at 672:17. On October 31, 2005, the court issued a written order adopting these oral rulings without further explanation.

DESA subsequently conceded that none of the asserted claims were infringed, and a stipulated judgment was entered on November 21, 2005. This judgment is expressly conditioned upon the district court's interpretation of "sensor means" being upheld on appeal. A timely notice of appeal was filed on December 16, 2005. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

## II. DISCUSSION

Claim construction is a question of law reviewed de novo. Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1454-56 (Fed. Cir. 1998) (en banc). When construing

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[3] A triac is a type of electronic switch.

claim terms, the court determines the customary meaning of claim terms as understood by a person of ordinary skill in the art according to the methodology set forth in Vitronics Corp v. Conceptronics, Inc., 90 F.3d 1576, 1582-83 (Fed. Cir. 1996) and reaffirmed in Phillips v. AWH Corp., 415 F.3d 1303, 1312-19 (Fed. Cir. 2005) (en banc).

**A**

Where an element in a claim is expressed as a means or step for performing a specified function without reciting structure, it "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112, ¶ 6. This two-step inquiry involves determining (1) whether § 112, ¶ 6 applies and, if it does, (2) identifying the claimed function and corresponding structures in the written description. Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352, 1360 (Fed. Cir. 2000).

The use of the word "means" in the claim language invokes a rebuttable presumption that § 112, ¶ 6 applies; conversely, the failure to use "means" invokes a presumption that § 112, ¶ 6 does not apply. Apex Inc. v. Raritan Computer, Inc., 325 F.3d 1365, (Fed. Cir. 2003). Here, the key disputed phrases are "sensor means," "control circuit means," and "switching means." Nonetheless, the presumption that § 112, ¶ 6 applies may be rebutted if the claim recites no function or recites sufficient structure for performing that function. Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1427 28 (Fed. Cir. 1997).

The trial court recognized that the use of the word "means" invoked the presumption that § 112, ¶ 6 applied, but resorted to expert testimony to resolve whether that presumption was rebutted. DESA presented evidence from Mr. Patterson that the

use of "means" language was ambiguous because it was commonly used in electronics patents without necessarily intending to invoke § 112, ¶ 6. Mr. Carlson and Mr. Raper further testified that the modifiers "sensor," "control circuit," and "switch" were commonly understood by those skilled in the art to describe structure. Defendants' experts testified to the contrary. The district court ultimately rejected DESA's argument that the asserted claims contained sufficient structural language to escape the application of § 112, ¶ 6. Hr'g Tr. at 659:12-15.

Although the district court seemed to rely upon expert testimony,[4] we note that its conclusion could have been reached without the aid of extrinsic evidence. First, the claims use both means-plus-function language (i.e., "sensor means," "control circuit means," etc.) and structural language (i.e., lamp, zero crossing detect circuit, etc.), which suggests that the patentee intentionally used "means" language to invoke § 112, ¶ 6. Second, the claims recite a function for each of these "means" limitations without specifying what structure(s) would be required to perform that function. Third, we reject DESA's argument that the use of "sensor, "control circuit," and "switching" before the word "means" was sufficient to denote structure. Rather, those modifiers were simply used to distinguish between subsequent references to different "means" limitations within the same claim, i.e., "said first and second sensor means" as opposed to "said control circuit means." Finally, DESA argues that this court has previously stated that "it is clear that the term 'circuit' by itself connotes some structure." Apex, 325 F.3d at 1373. In Apex, however, the word "means" was not used, so the reverse

[4] While the court did not explain in detail the reasons behind its oral decision, we infer that the court found the expert testimony of Mr. Thesz and Professor Massengill to be more persuasive.

presumption—i.e., that § 112, ¶ 6 does not apply—was invoked. Here, we agree with the district court that DESA failed to overcome the presumption that § 112, ¶ 6 does apply to "sensor means," "control circuit means," and "switching means."

**B**

We now consider whether the district court correctly identified the claimed functions and corresponding structures of the disputed phrases. We conclude that it erred in relying upon Professor Massengill's expert testimony. In doing so, the district court construed each disputed claim term by simply referring to various passages in the specification that corresponded to portions of Figures 2A and 2B, which depict the preferred embodiment. Expert testimony in conflict with the intrinsic evidence, however, should have been accorded no weight. Phillips, 415 F.3d at 1318; see also Markman v. Westview Instruments, 517 U.S. 370, 390 (1996) (holding that expert testimony must be evaluated in a manner that "fully comports with specification and the claims" and "preserve[s] the patent's internal coherence").

**1**

With respect to "first sensor means" (of claim 6) or "sensor means" (of claims 9, 10, and 11) for detecting motion, the central dispute is whether this includes "selection circuitry" such as the pulse-counting function, as Professor Massengill testified. On appeal, DESA reiterates its argument that only Q1 and Q2—i.e., the passive infrared sensors depicted in Figure 2A—perform the motion-detecting function. We agree that "sensor means" is properly construed as "Q1 and Q2 or equivalents." All the other parts of Figures 2A and 2B, including the pulse-count function at 51, are part of the control circuit in the preferred embodiment.

Not only does the specification of the '066 patent repeatedly refer to the passive infrared sensors Q1 and Q2 as the "sensors," it even explicitly states that "[t]he sensors Q1 and Q2 are each coupled to a detector portion 43 of the circuit," (emphasis added) and then goes on to describe the additional functions of the circuit—i.e., selecting and amplifying the "signals most likely to correspond to infrared signals from a human body." Col.3 ll.34-35, 38-39. Because the intrinsic evidence clearly sets forth the corresponding structure for "sensor means," it was improper to rely upon contrary extrinsic evidence to construe this term.[5]

**2**

Although the stipulated judgment was only conditioned upon the claim construction of "sensor means," we now address the proper construction of "control circuit means." EML and Costco argue that the patentee distinguished certain prior art on the basis that the invention had a pulse-counting feature as "generally disclosed." Thus, they argue, the pulse-counting feature is a limitation of every claim, and if "sensor means" does not limit the invention to those devices with a pulse-counting function, then "control circuit means" does. We disagree.

The structure corresponding to "control circuit means" (i.e., everything except the lamp, the passive infrared sensors, and the photocell) necessarily varies from claim to claim, depending on the functions disclosed. For example, claim 6 contains a limitation wherein the lamp will revert to the first level of illumination after a predetermined time

[5] In any event, we reject with Professor Massengill's testimony that the "selection circuitry" is part of the "sensor means." Rather, the passive infrared sensors Q1 and Q2 detect motion, while the pulse-counting feature and other parts of the circuit are used to decide whether the lamp switches to the brighter level of illumination in response or whether the detected motion is ignored.

interval if additional motion is not detected, see col.8 ll.12-19, so a control circuit would have to include portion 52 of Figure 2B or its equivalent to be within the scope of claim 6. Claims 9-11, however, lack this particular limitation and would not require portion 52 to be part of an infringing control circuit. The same holds true for the pulse-counting function, which is expressly recited as a limitation only in claim 12.

Moreover, the Jensen/McCavit declaration in the prosecution history states that the prior art also lacked "other features as recited in the claims," not just the pulse-counting function. Specifically, the Nippon reference was distinguished on several grounds. Some claims recite the manual-override function, others recite the pulse-counting function, and "[i]n addition, [application] claims 2, 10, 11 and 12[6] are directed to features clearly not disclosed or suggested in the instruction manual." Although the validity of these claims remains to be decided, nothing in the prosecution history suggests that either the manual-override function or the pulse-counting function was intended to be a limitation of every claim. Unlike application claim 16 (which ultimately issued as claim 12), the claims asserted by DESA were not distinguished over prior art on the basis of the pulse-counting function.

**3**

Finally, as to "switching means" in claims 9, 10 and 11, we agree with DESA that this claim term is properly construed to mean "triac Q3 or equivalents." The other structures described in the portion of the specification referenced by the district court correspond to the "means for causing said switching means to be actuated for a

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[6] These claims were renumbered and issued as claims 6, 9, 10, and 11.

selected portion of each half wave cycle of said AC voltage." Again, the court erred in relying upon expert testimony that was inconsistent with the intrinsic evidence.

## III. CONCLUSION

For the aforementioned reasons, we vacate the stipulated judgment of non-infringement and remand for further proceedings consistent with this opinion. We expressly encourage the district court to revisit its claim construction for any other terms it deems necessary.

**IN THE UNITED STATES DISTRICT COURT**
**FOR THE DISTRICT OF DELAWARE**

**CERTIFICATE OF SERVICE**

I, Philip A. Rovner, hereby certify that on December 30, 2009, the within document was filed with the Clerk of the Court using CM/ECF which will send notification of such filing(s) to the following; that the document was served on the following counsel as indicated; and that the document is available for viewing and downloading from CM/ECF.

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