

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

LEADER TECHNOLOGIES, INC.,	)	
a Delaware corporation,	)	<b>CIVIL ACTION</b>
	)	
Plaintiff and Counterdefendant,	)	<b>No. 1:08-cv-00862-LPS</b>
	)	
v.	)	
	)	
FACEBOOK, INC.,	)	
a Delaware corporation,	)	
	)	
Defendant and Counterclaimant.	)	
	)	

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**MEMORANDUM IN SUPPORT OF DEFENDANT FACEBOOK, INC.’S  
RENEWED MOTION FOR  
JUDGMENT AS A MATTER OF LAW (JMOL) OF INVALIDITY**

**[MOTION NO. 4 OF 4]**

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## **I. INTRODUCTION**

Pursuant to Federal Rule of Civil Procedure 50(b) and the Court's August 5, 2010 Order regarding post-trial motions, Facebook respectfully renews its motions for judgment as a matter of law as to invalidity of the asserted claims of U.S. Patent No. 7,139,761 on the grounds set forth below. At trial Facebook presented clear and convincing evidence that each of the asserted claims is anticipated by the Swartz, iManage and/or Hubert references. Facebook further presented clear and convincing evidence that these references, alone or in combination with each other and the Ausems reference, render all of the asserted claims obvious. In response, Leader provided only conclusory and inapposite expert testimony that is directly contradicted by the text of the prior art references themselves. Judgment as a matter of law is therefore appropriate on these issues.

Facebook also seeks judgment as a matter of law as to the invalidity of the asserted apparatus claims for the additional reasons set forth in Facebook's Motion for Summary Judgment No. 1 (D.I. 384). *See IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377 (Fed. Cir. 2005).

In the alternative, Facebook moves for a new trial on these limited issues of invalidity pursuant to Rule 59 based on the misconduct of Leader's counsel during the testimony of Dr. Saul Greenberg. Leader's statements to the jury, in direct defiance of this Court's orders, severely prejudiced Facebook by repeatedly making the false claim to the jury that the Swartz reference was considered by the United States Patent and Trademark Office ("PTO") during the prosecution of the '761 patent. Subsequent developments at the PTO – developments that Facebook was not allowed to present to the jury – confirm that the Swartz reference was not considered by the PTO. The Court's curative instruction on this issue, buried deep within numerous other jury instructions, cannot undo this prejudice. A new trial on this limited issue is therefore appropriate.

## **II. SWARTZ ANTICIPATES CLAIMS 1, 4, 7, 9, 11, 21, 23, 31 AND 32.**

Facebook's defense of anticipation is based 35 U.S.C. § 102, which requires that

Facebook show that each element of each asserted claim is disclosed, either explicitly or inherently, by the prior art references upon which Facebook relies. U.S. Patent No. 6,236,944 (“Swartz”), entitled “Method and Apparatus for the Integration of Information and Knowledge,” discloses a concept called knowledge integration, as explained by Dr. Greenberg at trial:

So [Swartz’s] concept was to trying to integrate the systems by this thing called knowledge integration, which would monitor what people could do within a particular context or system, track as they move between them, essentially, to use Swartz's term, to create a knowledge path of all the things they did across the systems.

Declaration of Elizabeth Stameshkin in Support of Facebook, Inc.’s Renewed Motions for Judgment as a Matter of Law (“Stameshkin Decl.”) Ex. 1 at 1453:2-9. Facebook provided clear and convincing evidence at trial that Swartz anticipates all of the asserted claims of the ’761 patent except for claim 16, which as discussed below is rendered obvious by various disclosures. Leader failed to rebut this evidence, providing only conclusory expert testimony that did not address the specific limitations of the asserted claims. As such, there is no legally sufficient basis on which a jury could find that the asserted claims of the ’761 patent are valid over Swartz, and judgment as a matter of law is appropriate.

**A. Facebook Provided Clear and Convincing Evidence that Independent Claim 1 of the ’761 Patent is Anticipated by Swartz.**

The testimony of Dr. Greenberg, along with exhibit DTX 919, established that each and every element of claim 1 of the ’761 patent is present and thereby anticipated by Swartz, as shown in the chart set forth in Appendix A at page 1.

In response, Leader’s expert, Dr. Herbsleb, alleged without support that Swartz somehow lacked the “context component” and the “tracking component.” Stameshkin Decl. Ex. 1 at 1821:13-1838:20. Dr. Herbsleb also attempted to draw a distinction between Swartz and the asserted claims by pointing to an alleged difference in the way in which one of the preferred embodiments of Swartz stored files. *Id.* at 1823:3-24. No reasonable jury could find that these unsupported and/or irrelevant opinions render Swartz non-anticipatory.

With regard to the context and tracking components, Dr. Herbsleb’s conclusory testimony is contradicted by the Swartz reference itself. The Swartz patent itself establishes the existence of a tracking component: “More specifically, knowledge integration middleware is preferably employed to identify (including tracking, monitoring, analyzing) the context in which information is employed so as to enable the use of such context in the management of knowledge.” Stameshkin Decl. Ex. 22 at col. 6:22-26 (emphasis added). *See also id.* at col. 8:56-60 (“Such a system also preferably captures metadata associated with the information shared, stored and accessed by the users of the data so as to characterize the ‘context’ in which the information is being used.”) (emphasis added).

Despite this clear teaching, Dr. Herbsleb tried to contend:

It [Swartz] doesn’t have a context component. There’s nothing like an environment. There’s nothing like a user workspace. And so it can’t do any of the things, you know, described in here because it doesn’t have user workspace.

...

The tracking component element of Claim 1 is essentially in the same story, it does not track users as they move from any context to any other context. It’s not centered around users. It doesn’t track users at all.

Stameshkin Decl. Ex. 1 at 1833:18-1834:1. Nothing further was stated or pointed to that would contradict the plain teaching of Swartz. As such, no reasonable jury could conclude that Swartz does not disclose tracking in light of the above.

Dr. Herbsleb’s argument that Swartz does not disclose workspaces, environments or contexts is similarly contradicted by the text of Swartz itself. *See* Stameshkin Decl. Ex. 22 at col. 4:55-58 (“Alternative or improved embodiments of the invention will enable users to define and execute multiple tasks to be performed by one or more applications from anywhere within a document.”); *see also id.* at col. 9:31-33 (one preferred embodiment, “using stored context information, provides access to historical information about how a report was created, who did the work, and when it was completed....”); *id.* at col. 8:56-60 (quoted above). Once again,

notwithstanding Dr. Herbsleb's conclusory testimony to the contrary, no reasonable jury could find that contexts<sup>1</sup> are not disclosed in the Swartz reference.

Dr. Herbsleb's statement that Swartz is "not centered around users" is not relevant to the issue of whether Swartz includes the tracking component disclosed in the asserted claims. To show anticipation, Facebook need only show that the invention disclosed in Swartz includes a tracking component (along with all of the other elements of the asserted claims), not that tracking user movement is somehow "central" to the Swartz invention.

Similarly, Dr. Herbsleb's testimony regarding the alleged differences in file structures between Swartz and the '761 patent is not relevant to the issue of whether any of the asserted claims is anticipated by Swartz because Dr. Herbsleb does not tie this alleged difference to any required element of any of the asserted claims. At trial, Dr. Herbsleb described one of the problems the '761 patent was attempting to solve as the hierarchical storage of data within folders, which Dr. Herbsleb then attempted to use to differentiate the '761 patent from Swartz, pointing to one of the figures in Swartz that includes an allegedly hierarchical file structure. Stameshkin Decl. Ex. 1 at 1789:13-1790:5, 1824:1-16. This ignores the fact that *none* of the asserted claims discloses or requires an alternative to traditional hierarchical file storage structures. It further ignores the fact that the tool described as a preferred embodiment of the invention of the '761 patent *also* relies on the same traditional hierarchical file structure. *See* Stameshkin Decl. Ex. 4 at Fig. 16. Finally, the problem to be solved by the inventors is irrelevant to the question of anticipation. *In re Self*, 671 F.2d 1344, 1350-1351 (C.C.P.A. 1982).

Dr. Herbsleb's testimony thus alleges an irrelevant (and inapt) distinction that has nothing to do with what is actually claimed, and should be disregarded. None of Dr. Herbsleb's

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<sup>1</sup> This Court's claim construction order defines "context" as "environment," and during trial Leader's infringement expert defined "workspace" as "sort of like a subset of the context or environment where the user is operating." D.I. 281; Stameshkin Decl. Ex. 1 at 723:6-10. Despite this alleged difference, Leader's infringement expert used the terms interchangeably when describing the Facebook system. *Compare, e.g.*, Stameshkin Decl. Ex. 1 at 723:18-23 and 665:24-666:8.



conclusory testimony provides any basis for distinguishing the identity of the disclosures of Swartz from claim 1 of the '761 patent, and thus no reasonable jury could fail to find that claim 1 of the '761 patent is anticipated by Swartz.

**B. Facebook Provided Clear and Convincing Evidence that Independent Claims 9, 21, and 23 of the '761 Patent are Also Anticipated by Swartz.<sup>2</sup>**

With respect to claim 9, Dr. Greenberg and Dr. Herbsleb agreed that there are two limitations that are different from and in addition to the limitations of claim 1: 1) claim 9 requires a web-based computing platform rather than a network-based system, and 2) claim 9 requires user environments rather than contexts. As to the first, Dr. Greenberg testified about several disclosures of a web-based computing platform within Swartz:

Then it says of a web-based computing platform. And this is also another difference from claim one, and I identified parts in the patent that shows Swartz discloses the web-based computing platform.

Q. This one of those?

A. Yes, it is. Here's an excerpt from Swartz.

He says, "Knowledge management level also includes data docket web-based knowledge reporter." So clearly this is a web-based system or it has capabilities of a web-based system, so this is a web-based platform.

At the bottom we see the data docket being accessed by the web browser. Clearly this is a web-based platform.

Stameshkin Decl. Ex. 1 at 1477:6-22. With regard to user environments, Dr. Greenberg noted that "[t]he Court has actually construed context to be the same as environment," and thus this element would be anticipated for the same reasons as Claim 1. *Id.* at 1476:22-23. He goes on to note that "[m]ore generally, Swartz is describing all the stuff people are doing in a system, so that's their environment for doing their work, so that's all satisfied by Swartz." *Id.* at 1477:2-5. Dr. Herbsleb's rebuttal to these statements consisted solely of the conclusory opinion that "for all the same reasons that I have discussed, [Swartz] does not anticipate any of the elements of Claim

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<sup>2</sup> Both Dr. Greenberg and Dr. Herbsleb testified that the independent claims of the '761 patent contain many common limitations, *see, e.g.*, Stameshkin Decl. Ex. 1 at 1476:4-11; 1768:4-17, and thus, in analyzing claims 9, 21, and 23 both experts focused on the differences between these claims and claim 1.

9.” *Id.* at 1835:14-16. As Leader provided no evidence to contradict Dr. Greenberg’s testimony, no reasonable jury could fail to find that Swartz anticipates claim 9.

With respect to claim 21, Dr. Greenberg and Dr. Herbsleb agreed that there is one substantive limitation different from and in addition to claims 1, 4, 9 and 11: claim 21 requires user workspaces rather than contexts or user environments. *Id.* at 1528:3-4 (“The only difference is that it’s a user workspace.”); *id.* at 1804:16-1805:22. Dr. Greenberg testified that user workspaces are equated with contexts and user environments in the ’761 patent and in addition, Swartz “is describing a system where people are working within that system, so that’s their using [sic] workspace.” *Id.* at 1483:3-13. In response, Dr. Herbsleb merely claims that “there is, you know, no user workspace in the technology of Swartz disclosure.” *Id.* at 1836:17-20. As discussed above, this conclusory statement is contradicted by the text of Swartz. Therefore, no reasonable jury could fail to find that Swartz anticipates claim 21.

With respect to claim 23, Dr. Greenberg and Dr. Herbsleb agreed that all substantive limitations of the claim are disclosed in the other independent claims of the ’761 patent. *Id.* at 1530:13-1532:7, 1806:8-16. Therefore, for all the reasons that no reasonable jury could fail to find that Swartz anticipates claims 1, 9 and 21, no reasonable jury could fail to find that Swartz anticipates claim 23.

**C. Facebook Provided Clear and Convincing Evidence that Dependent Claims 4, 7, 11, 25, 31 and 32 of the ’761 Patent are Anticipated by Swartz**

The testimony of Dr. Greenberg, along with exhibit DTX 919, established that additional limitations disclosed by claims 4, 7, 11, 25, 31 and 32 of the ’761 patent are literally present in and thereby also anticipated by Swartz, as shown in the chart set forth in Appendix A.

In response to Dr. Greenberg’s testimony regarding claims 4 and 7, Dr. Herbsleb’s only opinion was that somehow Swartz does not disclose “context information” or “context.” Stameshkin Decl. Ex. 1 at 1834:14-1835:6. However, as discussed above, Swartz does disclose context information, as set forth specifically in the text of Swartz. *See id.* Ex. 22 at col. 8:56-60 (“Such a system also preferably captures metadata associated with the information shared, stored

and accessed by the users of the data so as to characterize the ‘context’ in which the information is being used.”) (emphasis added). With regard to claim 11, Dr. Herbsleb attempted to argue that because Swartz does not disclose a “user environment,” it does not anticipate claim 11. Stameshkin Decl. Ex. 1 at 1835:22-23. As discussed *supra* with regard to claim 9, however, Swartz does in fact disclose a user environment. Finally, Dr. Herbsleb conclusorily testified that claims 25, 31 and 32 were not met because they are dependent on claim 23. *Id.* at 1837:10-19. However, as the evidence clearly contradicts his only arguments regarding claim 23, which is clearly anticipated, Dr. Herbsleb’s arguments for claims 25, 31 and 32 must similarly fail.

Because Dr. Greenberg’s testimony, along with exhibit DTX 919, established by clear and convincing evidence that Swartz anticipates claims 4, 7, 11, 25, 31 and 32 of the ’761 patent, and because Leader failed to present any evidence to the contrary, no reasonable jury could fail to find that Swartz anticipates claims 4, 7, 11, 25, 31 and 32 of the ’761 patent.

### **III. iMANAGE ANTICIPATES ALL ASSERTED CLAIMS**

The iManage DeskSite 6.0 system and the iManage DeskSite 6.0 User Reference Manual (2001) (collectively, “iManage”) disclose a large-scale, network-based document management system that tracks users’ interactions with documents for the purpose of facilitating the collaboration across an enterprise. Stameshkin Decl. Ex. 1 at 1495:16-1497:4. Facebook provided clear and convincing evidence at trial that iManage anticipates all of the asserted claims of the ’761 patent. Leader failed to rebut this evidence, providing only conclusory expert testimony that did not address the specific limitations of the asserted claims. As such, there is no legally sufficient basis on which a jury could find that the ’761 patent is valid over iManage, and judgment as a matter of law is appropriate.

#### **A. iManage Anticipates Claim 1 of the ’761 Patent**

The testimony of Dr. Greenberg, along with exhibit DTX 925E, established that every limitation of each and every element of claim 1 of the ’761 patent is present in and thereby anticipated by iManage, as shown in the chart set forth in Appendix A.

In response, Leader’s expert Dr. Herbsleb testified in terms of generalities and addressed aspects of the ’761 patent that do not constitute limitations of any asserted claim. First, Dr. Herbsleb testified that iManage operates within a traditional hierarchical system. Stameshkin Decl. Ex. 1 at 1794:19-1795:17. As discussed above, operating outside a hierarchical file system is not a limitation of any asserted claim. Second, Dr. Herbsleb testified that the iManage system is document-centric rather than user centric. *Id.* at 1796:11-1797:2. Again, as discussed above, user-centricity is not a limitation of any claim of the ’761 Patent.

Finally, Dr. Herbsleb argued that somehow iManage does not disclose contexts, a context component or tracking users between contexts because it does not *generate* contexts. *Id.* at 1798:14-1799:9. Again, however, generating contexts is not a requirement of any asserted claim of the ’761 Patent. As shown in Appendix A, iManage captures and stores context information reflecting the applications and locations – *i.e.*, contexts – in which users create data, which is sufficient to anticipate claim 1. Also, as in seen in Figure 3.26, reproduced in Appendix A, iManage specifically discloses tracking the movement of a user from a first context (“WINWORD”) to a second context (“MANAGE32”). Therefore, Dr. Herbsleb’s testimony regarding contexts is both irrelevant to the limitations of claim 1 and supported by no evidence.

Because Dr. Greenberg’s testimony, along with exhibit DTX 925E, established by clear and convincing evidence that iManage anticipates claim 1 of the ’761 patent, and because Dr. Herbsleb failed to identify any limitation of claim 1 that is not met by iManage, no reasonable jury could fail to find that iManage anticipates claim 1.

**B. iManage Anticipates Independent Claims 9, 21 and 23 of the ’761 Patent<sup>3</sup>**

With respect to claim 9, Dr. Greenberg testified about several disclosures of a web-based computing platform within iManage:

“Chapter three, page three.

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<sup>3</sup> Again, both experts focused on the differences between claims 9, 21, and 23 and claim 1 in their analyses of the additional independent claims.

It says ‘In order to send a document URL link, your system must include an iManage worksite web component server.’ So this illustrates that iManage has web capabilities. It’s a web platform.

If we can go on, and there’s another one where it says here, on page seventy-four, it says you can send a copy of a document, a link of a document, or URL link of a document through e-mail from iManage desk site. The fact that you can send a URL to a document also says that iManage must be web-based.

Q. Anything else?

A. I believe there’s one more, and here it says – in chapter six, page fifty-seven, it says in the worksite box, you can enter the URL for accessing the iManage worksite in the base path field, and there’s further things that talk about sending document to URL link or sending folder to URL link.

Q. Was there a figure that showed that in the reference manual?

A. Yes. Well, it doesn’t show this. It shows another capability where we see that iManage itself, in fact, has an address bar, and this is where it says web URL. That’s directly from their image, so you can access things from the web, so yet again shows capabilities of a web-based platform.”

Stameshkin Decl. Ex. 1 at 1519:19-1520:23. Dr. Herbsleb’s sole rebuttal to this was that the references to web-based computing in iManage were “oblique,” *id.* at 1803:2-3, an assertion that does nothing to refute Dr. Greenburg’s showing that iManage explicitly discloses this element of claim 9. Dr. Greenberg also testified that the Court’s claim construction order, which equates contexts with environments, means that iManage discloses user environments in the same manner it discloses contexts. *Id.* at 1521:7-13. Dr. Herbsleb offered only conclusory testimony that iManage does not have environments, without addressing Dr. Greenberg’s clear testimony that demonstrated that iManage includes contexts (defined by the Court as environments), and updates metadata with context information. *Id.* at 1803:7-11. Therefore, no reasonable jury could fail to find that iManage anticipates claim 9.

With respect to claim 21, Dr. Greenberg testified that user workspaces are equated with contexts and user environments in the ’761 patent, Stameshkin Decl. Ex. 1 at 1483:3-8, and that the plain meaning of the term “user workspace” necessitates a finding of anticipation by iManage. *Id.* at 1528:4-6 (“iManage gives a place for people to do their work, so by definition it

gives them a user workspace, so that's covered.") In response, Dr. Herbsleb repeated his conclusory statements that in his opinion iManage does not use workspaces, and does not update metadata. *Id.* at 1800:3, 1805:9. Again, Dr. Herbsleb's testimony is directly contradicted by the disclosures of the iManage desk reference manual. *See id.* Ex. 23, Fig. 3.26. Therefore, no reasonable jury could fail to find that iManage anticipates claim 21.

With respect to claim 23, Dr. Greenberg and Dr. Herbsleb agreed that all substantive limitations of the claim are disclosed in the other independent claims of the '761 patent. Stameshkin Decl. Ex. 1 at 1530:13-1532:7, 1806:8-16. Therefore, for all the reasons that no reasonable jury could fail to find that iManage anticipates claims 1, 9 and 21, no reasonable jury could fail to find that iManage anticipates claim 23.

**C. iManage Anticipates Dependent Claims 4, 7, 11, 16, 25, 31 and 32 of the '761 Patent**

The testimony of Dr. Saul Greenberg, along with exhibit DTX 925E, established that the additional limitations disclosed by claims 4, 7, 11, 16, 25, 31 and 32 of the '761 patent are literally present in and thereby also anticipated by iManage, as set forth in the chart in Appendix A.

In response, Dr. Herbsleb testified that iManage could not anticipate claims 4, 7 and 11 because it does not disclose contexts or user environments. *See, e.g.,* Stameshkin Decl. Ex. 1 at 1800:22-24, 1803:23-1804:1. However, as shown in Appendix A, iManage does disclose both contexts and user environments. With regard to claim 16, Dr. Herbsleb merely testified that "there's really nothing at all in there about portable wireless devices" (*id.* at 1804:5-6), which is directly contradicted by both Dr. Greenberg's testimony and the plain text of the iManage reference. *See* Stameshkin Decl. Ex. 23 at 173. Finally, Dr. Herbsleb merely testified that claims 25, 31 and 32 were not met because they are dependent on claim 23. *Id.* Ex. 1 at 1806:17-24. However, as the evidence clearly contradicts his only arguments regarding claim 23, Dr. Herbsleb's arguments for claims 25, 31 and 32 must similarly fail.

Because Dr. Greenberg's testimony, along with exhibit DTX 925E, established by clear and convincing evidence that iManage anticipates claims 4, 7, 11, 16, 25, 31 and 32 of the '761 patent, and because Leader failed to present any evidence to the contrary, no reasonable jury could fail to find that iManage anticipates claims 4, 7, 11, 16, 25, 31 and 32.

#### **IV. HUBERT ANTICIPATES CLAIMS 1, 4, 7, 9, 11, 21, 23, 31 AND 32**

Published European Patent Application No. EP 1 087 306 A2 to Laurence Hubert *et al.* and U.S. Patent No. 7,647,349 to Laurence Hubert *et al.* (which contains the disclosures of EP 1 087 306 A2) (collectively, "Hubert") disclose an Internet-based system for managing documents in which metadata about a document is attached to and travels with the document throughout the system.

"[T]he idea in Hubert is that you have those documents, a thing called the metadocument. . . . And the idea is that the metadocument would contain data, but it would also contain metadata as well as the processing information, which is yet another form of metadata that captures all the things that people are doing to that document over time, and that information would be stored. . . . He had this idea that the document would see all the things that would happen to it, would capture all the things happening to it in a certain source [or] environment, and move it across the network from one environment to another or from one context to another, that that information would spread to other places."

Stameshkin Decl. Ex. 1 at 1541:8-1542:10.

At trial Facebook provided clear and convincing evidence that Hubert anticipates claims 1, 4, 7, 9, 11, 21, 23, 25, 31 and 32 of the '761 patent. By contrast, Leader failed to rebut this evidence, providing only vague and conclusory expert testimony that did not address the specific limitations of the asserted claims. As such, there is no legally sufficient basis on which a jury could find that the '761 patent is valid over Hubert.

##### **A. Hubert Anticipates Independent Claim 1 of the '761 Patent**

The testimony of Dr. Saul Greenberg, along with exhibits DTX 0922 and DTX 0604, established that every limitation of each and every element of claim 1 of the '761 patent is literally present in and thereby anticipated by Hubert, as shown in the chart set forth in Appendix A.

Leader's expert witness, Dr. Herbsleb, testified only in terms of generalities, failing to address the many required limitations of claim 1 and thereby failed to rebut the clear and convincing evidence of anticipation proffered through Dr. Greenberg's testimony. Dr. Herbsleb's opinion regarding Hubert was limited to two aspects of the reference. First, Dr. Herbsleb claimed that Hubert is document-centric whereas the '761 patent is user-centric. Stameshkin Decl. Ex. 1 at 1809:1-19. However, even were this true, this difference would not prevent Hubert from anticipating the '761 patent because being "based around users and users' workspaces", *id.* at 1809:10-11, is not a limitation of any asserted claim of the '761 patent. In fact, Hubert *does* meet all the actual limitations of claim 1 of the '761 patent, as testified to by Dr. Greenberg and as shown in Appendix A. Thus, Dr. Herbsleb's "general sense" of the reference should therefore be disregarded. Second, Dr. Herbsleb claimed that Hubert could not anticipate any claim that required the existence of a context, environment or workspace because, "[t]here just is no context. In the sense of an environment or user environment, there's nothing like that in the system." *Id.* at 1815:4-8. However, the Court construed context to mean environment (D.I. 281), and Hubert specifically discloses "source[s] or environment[s]" in which users can access documents. *See, e.g.*, Stameshkin Decl. Ex. 24, Abstract, ¶ 0009, 0012-14. Dr. Herbsleb's testimony is once again directly contradicted by the prior art reference itself, and should therefore be disregarded.

Because Dr. Greenberg's testimony, along with exhibits DTX 0922 and DTX 0604, established by clear and convincing evidence that Hubert anticipates claim 1 of the '761 patent, and because Dr. Herbsleb failed to identify any limitation of claim 1 that is not met by Hubert, no reasonable jury could fail to find that Hubert anticipates claim 1.

**B. Hubert Anticipates Independent Claims 9, 21 and 23 of the '761 Patent<sup>4</sup>**

With respect to claim 9, Dr. Greenberg testified that Hubert discloses both a method that operates over the Internet, (Stameshkin Decl. Ex. 1 at 1546:5-9; 1552:10-22), and a method that

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<sup>4</sup> Again, both experts focused on the differences between claims 9, 21, and 23 and claim 1 in their analyses of the additional independent claims.



includes user environments, (*id.* at 1552:6-9). Dr. Herbsleb addressed only the latter of these two differences—as noted above in claim 1—and testified without support and contrary to the plain language of the Hubert reference. *Id.* at 1817:11-20. *Cf.* Stameshkin Decl. Ex. 24, ¶ 0023. *See also supra* at IV.A. Therefore, no reasonable jury could fail to find that Hubert anticipates claim 9.

With respect to claim 21, Dr. Greenberg testified that user workspaces are equated with contexts and user environments in the '761 patent, (Stameshkin Decl. Ex. 1 at 1483:3-8), and that the plain meaning of the term “user workspace” necessitates a finding of anticipation by Hubert. *Id.* at 1555:21-23 (“This is a place where people are supposed to do their work. So, by definition, this is a user workspace.”) In rebuttal, Dr. Herbsleb testified only with circular statements, entirely without evidentiary support. *Id.* at 1818:21-1819:2. Therefore, no reasonable jury could fail to find that Hubert anticipates claim 21.

With respect to claim 23, Dr. Greenberg and Dr. Herbsleb agreed that all substantive limitations of the claim are disclosed in the other independent claims of the '761 patent. Stameshkin Decl. Ex. 1 at 1558:1-1559:14, 1819:6-21. Therefore, for all the reasons that no reasonable jury could fail to find that Hubert anticipates claims 1, 9 and 21, no reasonable jury could fail to find that Hubert anticipates claim 23.

### **C. Hubert Anticipates Dependent Claims 4, 7, 11, 25, 31 and 32 of the '761 Patent**

The testimony of Dr. Saul Greenberg, along with exhibits DTX 0922 and DTX 0604, established that the additional limitations disclosed by claims 4, 7, 11, 25, 31 and 32 of the '761 patent are literally present in and thereby also anticipated by Hubert, as shown in the chart set forth in Appendix A.

Unlike Dr. Greenberg's specific citations, Dr. Herbsleb again provided only generalities, testifying that Hubert could not anticipate claims 4, 7 and 11 because it does not disclose contexts or user environments. Stameshkin Decl. Ex. 1 at 1816:2-14, 1817:24-1818:6. However, as discussed *supra*, Hubert does disclose both contexts and user environments; in fact,

it uses the specific term “environment.” With regard to claims 25, 31 and 32, Dr. Herbsleb merely stated, without analysis or evidentiary support, that “the Hubert reference does not anticipate any of these claims.” *Id.* at 1820:6-14.

Because Dr. Greenberg’s testimony, along with exhibits DTX 0922 and DTX 0604, established by clear and convincing evidence that Hubert anticipates claims 4, 7, 11, 25, 31 and 32 of the ’761 patent, and because Leader failed to present any evidence to the contrary, no reasonable jury could fail to find that Hubert anticipates claims 4, 7, 11, 25, 31 and 32.

**V. ALL ASSERTED CLAIMS ARE OBVIOUS IN LIGHT OF SWARTZ, iMANAGE, HUBERT AND AUSEMS**

Facebook’s defense of obviousness of the ’761 patent is governed by 35 U.S.C. § 103(a) and the Supreme Court’s decision in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). Obviousness is a question of law based on underlying facts. Under binding Supreme Court precedent, when a patent simply combines known elements, each performing the same function it was already known to perform, and yields what a person of ordinary skill would expect from such a combination, the combination is obvious as a matter of law. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007); *see also Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976). On the record here, obviousness was clearly and convincingly established as a matter of law by the prior art presented by Dr. Greenberg. *See id.* at 426-27. The factors for the court to consider in making this legal determination include the scope and content of the prior art, the differences between the prior art and the claims of the patent, and the level of ordinary skill in the art. *Id.* at 406. When considering obviousness in the software context, the Supreme Court has thus looked to whether the prior art software showed “analogous” features and similar “characteristics and capabilities.” *Dann v. Johnston*, 425 U.S. 219, 229 (1976). As this record shows, even if there is no anticipation, all the prior art relied on here was directed to computer systems that did the same thing in ways that were at least analogous the claimed invention.

With respect to claim 16, which adds only a method step of accessing an environment using a portable wireless device, it is rendered obvious as a matter of law in light of the

combination of Swartz '994 and U.S. Patent No. 6,434,403 to Ausems, the combination of either Hubert '306 or Hubert '349 with Ausems, or the combination of iManage with Ausems, as detailed during the testimony of Professor Greenberg. Stameshkin Decl. Ex. 4; *id.* Ex. 1 at 1566:11-1567:14, 1570:1-22. iManage and Ausems, both prior art, disclose the use of a portable wireless device in connection with the disclosed systems and methods. *See* Stameshkin Decl. Ex. 23 at 173; *id.* Ex. 25. Portable wireless devices were in wide use when the '761 patent was conceived, and Dr. Greenberg testified that accessing the inventions described in the prior art references via a portable wireless device would have been obvious to one of ordinary skill in the art at the time the patent was issued. Stameshkin Decl. Ex. 1 at 1568:3-1569:16. Leader did not seriously dispute this testimony, instead choosing to rely on its theory that other aspects of the asserted claims are not disclosed by Facebook's proffered prior art references. On this record, therefore, claim 16 is obvious as a matter of law.

With respect to all asserted claims, no reasonable jury could fail to find that these claims are obvious in view of the combination of Swartz '994, the Hubert references, or iManage and the other combinations explained by Professor Greenberg. Stameshkin Decl. Ex. 1 at 1564:5-23, 1566:11-1567:14, 1570:1-22, 1572:9-18. In response, Leader provided only conclusory testimony from Dr. Herbsleb that:

I haven't seen any reference that anyone has offered as to why someone would think to combine them anyway. There has really been no reason offered as to why we should do that. But even if we did, all suffer from the same problems as we've seen. I was saying the same thing over and over again, if you can combine them all, none of them has a context. None of them has a tracking component. None of them invalidates any single element of any of the claims. If you put them all together, they still don't invalidate any of the elements of any of the claims.

*Id.* at 1838:24-1839:16. However, as discussed *supra*, there is no support for Dr. Herbsleb's claims that these references do not disclose context or tracking components. Further, the law does not require a motivation to combine two references in order to find obviousness. *See KSR*, 550 U.S. at 402 ("The diversity of inventive pursuits and of modern technology counsels against

confining the obviousness analysis by a formalistic conception of the words teaching, suggestion, and motivation.”). To the contrary, the combination of known prior art elements performing known functions is obvious as a matter of law: “For over a half century, the Court has held that a ‘patent for a combination which only unites old elements with no change in their respective functions ... obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.’” *Id.* at 415-16 (quoting *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950)).

Regardless, Dr. Greenberg testified that Xerox would have been motivated to combine Swartz and Hubert because Xerox is the assignee of both patents, that iManage was a competitor in the field at the time and therefore the iManage reference would have been known to one of ordinary skill in the art, and that all of the prior art references relate to “the same thing.” Stameshkin Decl. Ex. 1 at 1564:24-1566:4, 1565:10-16. As Dr. Greenberg put it:

“[T]hey all deal with the same thing. As I’ve mentioned, they’re all about, you know, what is a person doing in a certain context? Can we capture that?

Can we store that? Can we track what they do when they move between context? Can we capture and store that as well?

Can we revise that at a later time? Can we access that? Can a person review what has happened to all these documents, all this information across these contexts?

So that’s another reason it would be obvious to combine in these three references.

*Id.* at 1565:15-1566:4. Again, no reasonable jury could conclude on this record that the asserted claims are not obvious in light of the testimony of Dr. Greenberg, and judgment as a matter of law is appropriate.

## **VI. CLAIMS 1, 4, 7, 21, 23, 25, 31 AND 32 ARE INVALID AS INDEFINITE UNDER IPXL**

Facebook also moves for judgment as a matter of law with respect to claims 1, 4, 7, 21, 23, 25, 31 and 32 on the ground that these claims are invalid as indefinite under *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377 (Fed. Cir. 2005), because these claims impermissibly attempt to claim an apparatus or computer-readable medium, as well as an explicit step that must be performed by a user. These grounds are set forth in the pending motion for summary

judgment of invalidity that has been deferred until after the completion of phase 1, which is herein incorporated by reference, but judgment as a matter of law is also sought and is also appropriate on this legal question pursuant to Fed. R. Civ. P. 50(a) and (b).

**VII. IN THE ALTERNATIVE, A NEW TRIAL ON INVALIDITY BASED ON SWARTZ WOULD BE REQUIRED IF THE COURT WERE INCLINED TO ENTER JUDGMENT FOR LEADER**

As the Court is aware, Facebook prevailed at trial on the on-sale bar and prior-use defenses. If the Court were nonetheless inclined to enter judgment in favor of Leader for any reason or grant any request by Leader for a new trial on the prior use and on-sale bar defenses, Facebook respectfully submits that it would be entitled to a new trial on the question of anticipation and obviousness with regard to the Swartz reference, based on the improper and prejudicial comments of Leader's counsel regarding the prosecution history of the '761 patent. During trial, counsel for Leader asked Facebook's expert Dr. Greenberg several improper questions, implying – and then stating – the untrue contention that the Swartz patent was considered by the PTO during the prosecution of the '761 patent. Stameshkin Decl. Ex. 1 at 1581:13-1583:14. Leader's counsel made these comments even after having been warned repeatedly by the Court during pretrial proceedings and again during Dr. Greenberg's cross-examination that such comments were prohibited. *See* D.I. 599. By disregarding this Court's explicit order, Leader created a substantial danger that the jury came to believe that the Swartz reference was considered by the PTO during the prosecution of the '761 patent when, in fact, it was not. This impropriety was severely prejudicial because it is likely to have caused the jury to lend less weight to the Swartz reference due to an erroneous belief that Swartz had previously been considered and found not to be anticipatory by the PTO.

The Court's limiting instruction on this issue did not effectively remedy the prejudice to Facebook because Facebook still had no opportunity to present to the jury the PTO's subsequent statements that, in fact, the Swartz reference was not considered during the prosecution of the '761 patent. On September 25, 2009, the PTO granted Facebook's request for reexamination of the asserted claims, noting that the Swartz reference was not considered during the prosecution

of the '761 patent and presented a substantial new question of patentability. D.I. 599 and D.I. 599-1. The PTO's own statements regarding whether the Swartz patent was considered during prosecution are dispositive of what the PTO actually considered and Facebook should have been allowed to present this evidence to the jury to remedy Leader's highly prejudicial false statements. Thus, were the Court to grant judgment for Leader or grant any request for a new trial by Leader, Facebook would be entitled to a new trial limited to the issue of whether Swartz is anticipatory prior art. *See Fineman v. Armstrong World Industries, Inc.*, 980 F.2d 171, 208 (3rd Cir. 1992) (new trial granted based on prejudicial misconduct by counsel where curative instruction did not remedy prejudice).

### VIII. CONCLUSION

For the foregoing reasons, Facebook's motion for judgment as a matter of law as to invalidity should be granted. In the alternative, if the Court were inclined to enter judgment in favor of Leader notwithstanding the jury's finding of invalidity, a new trial should be ordered.

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