

**IN THE UNITED STATES DISTRICT COURT FOR THE
NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION**

CIVIX-DDI, LLC,

Plaintiff,

v.

EXPEDIA, INC., AND TRAVELSCAPE, INC.,

Defendants.

Case No.: 03 C 3792

Judge Amy J. St. Eve

Magistrate Judge Arlander Keys

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MICHAEL W. DOBBINS
CLERK, U.S. DISTRICT COURT

**MEMORANDUM IN SUPPORT OF EXPEDIA'S MOTION *IN LIMINE* (No. 6) TO
PRECLUDE CIVIX FROM MENTIONING COPYING OR LONG-FELT NEED AS
SECONDARY CONSIDERATIONS OF NON-OBVIOUSNESS**

Expedia moves *in limine* to preclude CIVIX from suggesting, either in argument or during witness examination, that Expedia or anyone else engaged in any copying as a secondary consideration of nonobviousness. There is simply no evidence anywhere in the record of any copying of the patented invention by anyone, and allowing CIVIX to nevertheless argue or imply that there would be improper and prejudicial. For the same reason, Expedia moves to preclude CIVIX from suggesting, either in argument or during witness examination, that the technology disclosed in the patents in suit satisfied a long-felt but previously unmet need. Again, there is no evidence anywhere in the record of any such long-felt need, and CIVIX has never disclosed any such need. Even if there were such evidence, it would be irrelevant and prejudicial because CIVIX cannot establish the nexus between any such evidence and the claimed inventions that is required before any such evidence is relevant.

Accordingly, CIVIX should be precluded from referring to or suggesting either copying or long-felt need as secondary considerations of non-obviousness to rebut Expedia's proof of obviousness.

I. CIVIX SHOULD BE PRECLUDED FROM CONTENDING THAT COPYING OR LONG-FELT NEED EXIST IN THIS CASE OR THAT THEY SUGGEST NON-OBVIOUSNESS

Expedia contends that the asserted claims of the patents in suit are invalid as being obvious in light of the prior art. A determination of obviousness under 35 U.S.C. § 103, however, includes consideration of whether or not the patentee has demonstrated the existence of secondary evidence of non-obviousness. *See, e.g., Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1323 (Fed. Cir. 2004). Among the factors that the Federal Circuit has identified as relevant to this inquiry are whether the alleged infringer copied the invention and whether the invention satisfied a long-felt but previously unsatisfied need. *Id.* at 1324; *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995).

Mere infringement is not synonymous with copying. Rather, copying requires the replication of some specific product. *Iron Grip*, 392 F.3d at 1325. Indeed, "more than the mere fact of copying by an accused infringer is needed to make that action significant to a determination of the obviousness issue." *Cable Electric Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1028 (Fed. Cir. 1985). Similarly, without a specific showing of long-felt need or failure of others, the mere passage of time without the invention is *not* evidence of non-obviousness. *Iron Grip*, 392 F.3d at 1325.

Moreover, for objective evidence of non-obviousness to be afforded weight in the obviousness determination, "its proponent must establish a nexus between the evidence and the merits of the claimed invention." *GPAC*, 57 F.3d at 1580. That nexus must be established

before the evidence may become relevant to the issue of obviousness. *Iron Grip*, 392 F.3d at 1324.

Here, however, CIVIX has no evidence of copying, and CIVIX has no evidence of long-felt but unmet need. Indeed, as to copying, the Expedia website and technology were indisputably up and running *years* before *any* of the asserted patents even issued. In fact, this Court has already found that Expedia had no notice of any of the CIVIX patents before this lawsuit was filed (*see* Order of September 14, 2005 (docket #408), at 49-50; *see also id.* at 43-48). This finding was made despite CIVIX's arguing that there was evidence of copying based upon the irrelevant fact that Microsoft had been on notice of the parent patents — exactly the type of arguments that this motion seeks to preclude at trial.

Still further, despite passing mention by CIVIX in other contexts, there is not a shred of evidence that Microsoft, the company from which Expedia sprang, knew of any of CIVIX's earlier patents at the time that the Expedia website was designed. It should go without saying that, without knowledge of the patented invention, it is impossible to copy that invention.

A fortiori, without any foundational evidence that anything was copied or that anything had been needed for a long time, CIVIX has no evidence to link any copying or long-felt need to the elements of the claimed invention as it must to show the required nexus. Therefore, it cannot be heard to argue or suggest that Expedia engaged in any copying, or that there was a long-felt need that was met by the claimed invention.

To allow CIVIX, nevertheless, to imply or otherwise argue — or even mention as a general possibility — either of these secondary considerations would be improper and unnecessarily prejudicial.

II. CONCLUSION

Given the particular facts of this case, CIVIX should be precluded from suggesting or arguing at trial that either copying or long-felt need are available as possible indicia of non-obviousness to counter Expedia's obviousness proof.

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