

Defendant MLB Advanced Media, L.P. (“Advanced Media”), pursuant to Local Rule 56.1, respectfully submits this Statement of Undisputed Material Facts in support of its Motion for Summary Judgment of Non-Infringement. Specifically, Advanced Media identifies the following material facts as to which there is no genuine dispute, citing as necessary the Declaration of Cynthia J. Franecki in Support of Advanced Media’s Motion for Summary Judgment and the exhibits thereto (cited herein as “Franecki Decl.” ¶ __, Ex. __); the Declaration of Dinn Mann in Support of Advanced Media’s Motion for Summary Judgment and the exhibits thereto (cited herein as “Mann Decl.” ¶ __, Ex. __); and documents already of record in the current case.

The Game of Baseball

1. In the game of baseball, a pitcher throws (“pitches”) a baseball to an opposing team’s batter and the batter attempts to hit the ball in play with a bat. (*See* Franecki Decl., Ex. A at ’716 Patent col. 1:25-52.)

2. The pitcher continues throwing pitches to the same batter until the batter reaches base successfully (e.g., by getting a hit) or the defense gets the batter out. (*Id.*)

3. A batter can successfully reach base numerous ways without the defensive team recording an out, for example, a hit (single, double, triple, or home run), a walk, hit-by-pitch, strikeout with wild pitch, fielding error, catcher interference, or, in certain situations, a fielder’s choice. (*Id.*)

4. An out can occur in many ways, including, for example, strikeouts, fly outs, and ground outs. (*Id.*)

5. A batter either reaches base safely or causes an out as a direct result of the final pitch that the pitcher throws him. (*Id.*)

6. Outs may otherwise occur on the base path, for example, when a base runner gets caught trying to steal a base. (*Id.*)

U.S. Patent No. 7,628,716 (the “’716 Patent”)

7. The ’716 Patent is titled “Method of Recording and Playing Baseball Game Showing Each Batter’s Last Pitch.” (*Id.*)

8. It lists George M. Mockry and Greg. M. Mockry as the inventors of the claimed method. (*Id.*)

9. The patent application that matured into the ’716 Patent published as United States Patent Publication No. 2003/0060311 on March 27, 2003. (*Id.*, Exs. A, B.)

10. The ’716 Patent, however, did not issue until December 8, 2009, after it was initially rejected by the USPTO, and later confirmed in a split decision by the BPAI. (*Id.*, Exs. A, H.)

11. The ’716 Patent describes the editing process as one involving the retention of the final pitch thrown to each batter at each appearance-at-bat:

In accordance with an aspect of this invention, a film or video record is made of each player’s turn at bat. The video record, which can be film, digital, or tape, is ***edited down to retain the last pitch thrown to each player***, plus any resulting action for that pitch. ***This would record each safe base hit, each walk, strike out, sacrifice fly, ground out, etc.***

(*Id.*, Ex. A at ’716 Patent col. 1:56-61 (emphasis supplied).)

12. The ’716 Patent’s process also includes selling, on a subscription basis, the recording resulting from this editing process:

The completed (edited) version can be sold on a per-game basis, i.e., through a cable subscription arrangement, or delivered digitally over the Internet to subscribers, perhaps using a password and PIN assigned to the subscriber.

(*Id.* at ’716 Patent col. 2:40-43.)

13. Claim 1’s claimed method includes:

(2) editing the game recording of each appearance-at-bat to produce an edited recording by deleting substantially all game action other than (i) game action from a final pitch thrown to each

player ... and (3) obtaining subscribers for viewing the edited recording and (4) playing or broadcasting the edited recording as a condensed recorded game for viewing by the subscribers.

(Id. at '716 Patent Claim 1.)

14. The '716 Patent contains a total of five claims. *(Id. at '716 Patent Claims 1-5.)*

15. Claim 1 is the only independent claim. *(Id.)*

16. All five claims of the '716 Patent are method claims. *(Id.)*

MLB.com's Condensed Games

17. MLB.com, the official public website for Major League Baseball, includes a webpage titled "MLB.com Media Center," available at <http://mlb.mlb.com/mediacenter>. *(See Mann Decl. ¶ 8.)*

18. On this page, anyone can click on a "Condensed Game," which is a video compilation of baseball highlights that corresponds to a previously played baseball game. *(Id. ¶¶ 3, 8-9.)*

19. Condensed Games include specific plays, camera angles, replays, and fan reactions to tell the story of the game. *(Id. ¶ 3.)*

20. To produce a Condensed Game, Advanced Media employs a subjective editing process, with editors utilizing the feed of the full-length baseball game received from whatever entity telecast the game, as the game is being played. *(Id. ¶¶ 5-6.)*

21. During this subjective editing process, outs that the editor deems to be "routine" outs (i.e., routine ground ball or fly ball outs) are removed from the edited recording. *(Id.)* Accordingly, many plate appearances are omitted entirely from every edited recording that is edited by Advanced Media. *(Id.)*

22. Since at least the end of the 2009 MLB season (November 4, 2009), none of the MLB Condensed Games edited by Advanced Media includes the final pitch thrown to each player at

each appearance-at-bat because many of that game's appearances-at-bat are missing entirely. (*Id.*)

23. Since the issuance of the '716 Patent, which occurred after the conclusion of the 2009 MLB season, none of the Condensed Games produced by Advanced Media's subjective editing process include the final pitch thrown to each player at each appearance-at-bat. (*Id.*)

24. Advanced Media does not obtain subscribers or require a subscription of any kind for access to Condensed Games. (*Id.* ¶¶ 7-11.)

25. Anyone with an Internet connection may access the above-described Condensed Games on the "MLB.com Media Player" page. (*Id.*)

26. No payment, password, PIN or other log in to MLB.com is required. (*Id.*)

27. To access the "MLB.com Media Player" page, a user must simply click "Watch/Listen" under the "Video" tab on MLB.com's home page. (*Id.*)

28. The availability of MLB Condensed Games without any subscription has been in place since prior to the issuance of the '716 Patent, and at least April 19, 2009. (*Id.*)

29. For all Major League Baseball games that took place prior to December 8, 2009, the recording and editing of these games into MLB Condensed Games occurred prior to December 8, 2009. (Mann Decl. ¶ 12.)

Specification and Prosecution History of the '716 Patent

30. Claim 1 of the '716 Patent includes method steps directed to "(3) obtaining *subscribers* for viewing the edited recording and (4) playing or broadcasting the edited recording as a condensed recorded game for viewing by the *subscribers*." (Franecki Decl., Ex. A at '716 Patent Claim 1 (emphasis added).)

31. The '716 Patent's specification contains the following statements:

The completed (edited) version can be sold on a per-game basis, *i.e.*, through a cable subscription arrangement, or delivered digitally over the Internet to subscribers, perhaps using a password and PIN assigned to the subscriber.

(Franecki Decl., Ex. A at '716 Patent col. 2:40-43.)

32. The “editing” step of Claim 1 reads as follows:

(2) ***editing the game recording of each appearance-at-bat to produce an edited recording by deleting substantially all game action other than***

(i) ***game action from a final pitch thrown to each player,***

(ii) successful attempts of runners on base to advance to another base not associated with the game action resulting from the final pitch, ***and***

(iii) unsuccessful attempts of the runners on base to advance to another base resulting in and out not associated with the game action resulting from the final pitch.

(Franecki Decl., Ex. A at Claim 1 (emphasis added).)

33. The '716 Patent specification includes the following statements:

In particular, this invention relates to a method of condensing the action portions of a baseball game by recording the game on film or video tape, and editing it to retain the action portions, *i.e.*, ***the last pitch thrown to the batters for each turn at the plate.***

(*Id.* at col. 1:20-24 (emphasis added).)

34. The '716 Patent specification includes the following statements:

The invention does not constitute merely a compilation of the highlights of a particular baseball game. Rather, ***the invention*** is directed to making a record of ***each and every outcome-determinative action*** that takes place during the complete game, while eliminating all of the action that ultimately does not impact the outcome.

(*Id.* at col. 2:60-65 (emphasis added).)

35. The '716 Patent specification includes the following statements:

The video record, which can be film, digital, or tape, is *edited down to retain the last pitch thrown to each player*, plus any resulting action for that pitch. *This would record each safe base hit, each walk, strike out, sacrifice fly, ground out, etc.* Of course, fielding would be recorded, i.e., each put-out, error, double-play, and throw-out.

(*Id.* at col. 1:57-62 (emphasis added).)

36. The '716 Patent specification includes the following statements:

The video record, which can be an analog record, such as film or videotape, or could be a digital record, is *edited to retain the last pitch thrown to each player*, plus any resulting action for that pitch as part of a consolidated record. . . . *Such a reduced record would include each safe base hit, each walk, strike out, sacrifice fly, ground out, etc of every batter.*

(*Id.* at col. 2:10-22 (emphasis added).)

37. During the prosecution of the '716 Patent, in their August 27, 2003 Amendment, in response to a rejection by the Patent Office the Mockrys distinguished their invention from a sports highlights narrative. (Franecki Decl., Ex. C at 9-10.)

38. Specifically, the Mockrys included the following statements:

The invention is NOT directed to simply making a “highlight” tape of a baseball game, as for example one might see on ESPN’s SportsCenter. Rather, the invention is directed to a method of editing a pre-recorded baseball game, whether the complete game or selected portions, such as by half-innings or full innings, to *show every outcome-determinative pitch to each batter*; while substantially eliminating all non-outcome-determinative action from the edited recording. *In this way the edited video shows only the outcome of each at bat in the game*, such as the strike-out pitch, the base hit, the home run, the hit batter, the ground out, the fly out, the double play ball, etc.

(*Id.* (emphasis added).)

39. During the prosecution of the '716 Patent, in their January 25, 2006 Amendment and Office Action Response the Mockrys argued the purported novelty of their invention. (Franecki Decl., Ex. E at 8-9.)

40. Specifically, the Mockrys argued:

The invention is NOT the production of a highlight show!! In stark contrast, the claimed method is an objective procedure for producing a specific edited version of a baseball game *in which every batter's appearance at the plate is shown, where that appearance is edited such that the resulting video consists essentially of the last pitch to each batter* and that edited video is broadcast.

(*Id.* (emphasis added).)

41. The Mockrys' April 2, 2008 Appeal Brief to the Board of Patent Appeals and Interferences ("BPAI") contains the following argument regarding their application:

Rather, the invention is directed to a particular pre-selected and thus objective method of editing a pre-recorded baseball game to show all of and essentially only all of the outcome-determinative action from the edited recording. In this way the edited video shows substantially only *the outcome of each at bat in the game (all of the "pay-off pitches"), such as the strike-out pitch, the base hit, the home run, the hit batter, the ground out, the fly out, the double play ball, etc. of each and every batter.*

(Franecki Decl., Ex. F at 14 (emphasis added).)

42. In their April 2, 2008 Appeal Brief to the BPAI, the Mockrys' argued that a recording produced by the "the present invention...would require at a minimum 54 pitches" because, according to the Mockrys, there is a minimum of 54 appearances-at-bat in a nine inning baseball game. (*Id.* at 14-15.)

43. On June 9, 2009, at the appeal hearing in front of the BPAI, counsel for the Mockrys, in a discussion with the BPAI about prior art highlights packages, differentiated the claims from the prior art, stating that unlike the Mockrys' method, "the highlight isn't going to be the last pitch to *every batter that bats.*" (*Id.*, Ex. G at 7 (emphasis added).)

44. Also during the June 9, 2009, BPAI hearing, when asked what the novelty of the Mockrys' invention was, counsel for the Mockrys' argued "[w]hat defines, I think, our invention

from the art is the Inventors require objectively that *each last pitch* is part of this record.” (*Id.* at 4 (emphasis added).)

45. Additionally during the June 9, 2009, BPAI hearing, counsel for the Mockrys’ stated, as opposed to the Mockrys’ invention, prior art highlights processes were “not going to show *every routine ground out, every routine fly out, every*, however it takes place.” (*Id.* at 8 (emphasis added).)

46. The BPAI, in a split decision, allowed Claim 1 because the prior art of record purportedly did not teach including “boring outs” in an edited recording and Claim 1 “requires the inclusion of uninteresting game elements such as a quick three out inning with three ground outs to second base.” (Franecki Decl., Ex. H at 11.)

47. During prosecution, the claims of the patent application that resulted in the ’716 Patent were rejected by the Examiner based on 35 U.S.C. §§ 101, 102, 103, and 112. (*See, e.g., Id.* at Exs. C, D, E, and F.)

48. In response, the Mockrys’ amended their patent specification and claims, and added new claims that were amendments of the claims that were rejected. (*See, e.g., Ex. C* at 1-12; *Ex. D* at 1-7.)

49. The Mockrys’ amendments, addition of claims, and accompanying arguments were made to overcome the Examiner’s rejections. (*Id.*)

50. The Mockrys’ amendments, addition of claims, and accompanying arguments pertained to the ’716 Patent Claim 1’s “editing,” “obtaining subscribers,” and “playing or broadcasting...for viewing by the subscribers” steps.

51. The Mockrys amended their patent specification and claims after the patent application was published on March 27, 2003. (*See, e.g., Ex. C* at 1-12; *Ex. D* at 1-7.)

52. The following is a redline comparison of Claim 1 of the '716 Patent as compared against Claim 4 of the '716 Patent's published patent application:

A method of ~~recording and editing a~~providing a subscription for viewing a recorded baseball game in which players from each ~~side~~team appear at bat, ~~in turn,~~ and attempt to place a pitched baseball into play and reach base safely; with players failing to reach base safely being out and players on base attempting unsuccessfully to advance to another base being out; the method comprising:

(1) recording the appearances at bat for every player and game action resulting from an appearance-at-bat to produce a game recording;

(2) editing the recorded appearances at bat to leave only the last the game recording of each appearance-at-bat to produce an edited recording by deleting substantially all game action other than (i) game action from a final pitch thrown to each player, ~~plus any action ensuing after that pitch and any~~ (ii) successful attempts of runners on base to advance to another base; ~~and not~~ associated with the game action resulting from the final pitch and (iii) unsuccessful attempts of the runners on base to advance to another base resulting in and out not associated with the game action resulting from the final pitch;

(3) obtaining subscribers for viewing the edited recording and

(4) ~~presenting the edited recorded game~~ playing or broadcasting the edited recording as a condensed recorded game ~~showing important action portions of the game for viewing by the subscribers.~~

(Compare, e.g., Claim 4 of Ex. B with '716 Claim 1 of Ex. A.)

53. Issued Claim 1 of the '716 Patent is directed to a "method for providing a subscription for viewing" whereas the published application Claim 4 is directed to a "method of recording and editing." (*Id.*)

54. Issued Claim 1 of the '716 Patent includes steps directed to "recording," "editing," "obtaining," and "playing or broadcasting...for viewing by subscribers" whereas the published application Claim 4 only includes steps directed to "recording," "editing," and "presenting...the game." (*Id.*)

George and Greg Mockrys' Public Statements

55. On November 25, 2010, a Mr. Greg Mockry of New York, presumably the same Greg Mockry that is an inventor of the '716 Patent and one of the founders of Plaintiff in this case, commented in the comments section of an Internet article at "<http://phammond.com/blog/mlb-tv-quality-baseball-direct-to-your-computer>" that commented favorably on MLB.com's Condensed Game features. (*See* Franecki Decl., Ex. I.)

56. Mr. Mockry stated (all [sic]):

My favorite item they offer is Condensed games[.] ... I do not understand why MLB keeps changing the pure form of Condensed games showing the last pitch to each batter. It only takes 15-20 minutes to see all the batters. MLB has changed there format back and forth thru the years, taking out certain batters to make it only 10-12 minutes long back to showing the last pitch to every batter, 15-20 minutes. Why mess with a pure form of showing each batter. ... MLB should get it straight that we, the paying public wants to see the final pitch to every batter with Condensed Games, nothing else.

(*Id.*)

57. Baseball Quick is aware that MLB.com's Condensed Games do not include the final pitch to each and every batter of the subject game. (*Id.*)

58. At least since November 25, 2010, Baseball Quick has been aware that MLB.com's Condensed Games do not include the final pitch to each and every batter of the subject game. (*Id.*)

59. The same Mr. Mockry also stated in the same comments that "MLB also has gone from charging (\$4.95 per season in 2002) to having [Condensed Games] in it's paid package \$19.95 per month up to \$22.95 this year, *to offering [Condensed Games] Free this year.*" (*Id.* (emphasis added).)

60. Baseball Quick is also aware that Advanced Media does not charge for the ability to access and view MLB.com's Condensed Games. (*Id.*)

61. At least since November 25, 2010, Baseball Quick has been aware that Advanced Media does not charge for the ability to access and view MLB.com's Condensed Games. (*Id.*)

62. Prior to issuance of the '716 Patent, George Mockry, an inventor of the '716 Patent and one of the founders of Baseball Quick, contacted, in a series of e-mails, Advanced Media and numerous other media organizations that cover baseball and expressly encouraged all parties to freely use his invention:

February 12, 2009 E-Mail From George Mockry

June, of this year, 2008, marked 8 years since we were issued a Provincial Patent for a new method of broadcasting a baseball game.

The patent idea is to condense a baseball broadcast down to the least common denominator. That is, broadcasting only the last pitch to each batter. We called it "Baseball Quick."

...

Until we are issued a patent, it can be used freely, and, in fact, we encourage just that. It has been our hope that the idea would be used creatively, during this period of time, hopefully to be considered by all the major medias. This includes radio, television, cell phones, mobile wireless devices, the internet, and any other electronic media.

(Mann Decl., Ex. A at 3 (emphasis added).)

March 6, 2009 E-Mail From George Mockry

Subject: BROADCAST ONLY [THE LAST PITCH TO EACH BATTER]

June, of this year, 2009, marked 9 years since we were issued a Provincial Patent for a new method of broadcasting a baseball game.

The patent idea is to condense a baseball broadcast down to the least common denominator. That is, broadcasting only the last pitch to each batter. We called it “Baseball Quick.”

...

Until we are issued a patent, it can be used freely, and, in fact, we encourage just that. It has been our hope that the idea would be used creatively, during this period of time, hopefully to be considered by all the major medias. This includes radio, television, cell phones, mobile wireless devices, the internet, and any other electronic media.

(Mann Decl., Ex. B at 3 (emphasis added).)

March 22, 2009 E-Mail From George Mockry

[EVERY] network should try a new broadcast idea (only the last pitch to each batter)

It's free, available to any network, a new idea not owned by anyone. Every play, the whole game, in 20 minutes.

It can be used in regular or satellite radio, television, the internet or mobile wireless.

(Mann Decl., Ex. C at 3 (emphasis added).)

63. The other media organizations included as recipients of the above e-mails include, among others: ESPN, Baseball America, Baseball Prospectus, Sporting News, Associated Press, USA Today, New York Times, Boston Globe, San Francisco Chronicle, Denver Post, and the Chicago Sun-Times. (*Id.*, Exs. A, B, and C.)

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Respectfully submitted,

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