

Exhibit C

**UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF OHIO
EASTERN DIVISION**

AARON CLARK and JOHN PEIRANO,

Plaintiffs,

v.

**THE WALT DISNEY COMPANY; JAKKS
PACIFIC, INC.; PLAY ALONG TOYS;
KB TOYS; TOYS 'R US;
BABYUNIVERSE, INC.; ETOYS DIRECT,
INC.; and DISNEY SHOPPING, INC.,**

Defendants.

Case No. 2:08-CV-00982-JDH-MRA

Judge John D. Holschuh

Magistrate Judge Mark R. Abel

**DEFENDANT JAKKS PACIFIC, INC.'S RESPONSE TO PLAINTIFF CLARK'S
FIRST SET OF INTERROGATORIES**

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure, S.D. Ohio R. Civ. R. 26.1, and Magistrate Judge Abel's July 7, 2009 Order (Dkt. # 50), Defendant JAKKS Pacific, Inc. ("JAKKS") hereby responds to Plaintiff Aaron Clark's ("Plaintiff") First Set of Interrogatories ("ROG").

GENERAL OBJECTIONS

1. JAKKS objects to each and every interrogatory to the extent that it seeks information that contravenes the attorney-client privilege, the attorney work product doctrine, or any other applicable privilege or doctrine. To the extent that an individual interrogatory may be construed as seeking privileged information, JAKKS claims that privilege and invokes such protection. The fact that JAKKS does not specifically object to an individual interrogatory on the grounds that it seeks privileged information shall not be deemed a waiver of the applicable privilege or privileges.

2. JAKKS objects to Plaintiff's definition of the terms "Defendant JAKKS", "You" and "your" as overbroad to the extent that Plaintiff seeks to compel persons not under the control of JAKKS to respond to these ROGs.

3. JAKKS objects to Plaintiff's use of the term "Infringing Product" to the extent that it suggests that the identified products infringe the patent-in-suit. JAKKS maintains that none of the accused products infringe the Patent-in-Suit.

4. JAKKS objects to Plaintiff's definition of the term "Documents" as overbroad to the extent that it exceeds the definition of "documents" set forth in Rule 34 of the Federal Rules of Civil Procedure.

5. JAKKS objects to Plaintiff's definition of the term "All documents" as overbroad to the extent that it seeks to compel persons not under the control of JAKKS to respond to these ROGs.

6. JAKKS objects to Plaintiff's definition of the term "All communications" as overbroad to the extent that it seeks to compel persons not under the control of JAKKS to respond to these ROGs.

7. JAKKS objects to Plaintiff's definition of the term "Financial statements" as overbroad to the extent that it seeks to compel persons not under the control of JAKKS to respond to these ROGs.

8. JAKKS objects to Plaintiff's Instruction No. 1 as seeking irrelevant information to the extent that it seeks the last known address and phone number (business and home) of a person employed by JAKKS. JAKKS' employees can be contacted through JAKKS' counsel of record.

9. JAKKS objects to Plaintiff's Instruction No. 2 as seeking irrelevant information to the extent that it seeks the addresses of persons employed by JAKKS who prepared a document, to whom the document was addressed or distributed, or having custody of the original and any copies of a document. JAKKS' employees can be contacted through JAKKS' counsel of record. JAKKS further objects to Plaintiff's Instruction No. 2 as unduly burdensome to the extent that it seeks information readily apparent from a document (*i.e.* the document speaks for itself).

10. JAKKS objects to Plaintiff's Instruction No. 3 as seeking irrelevant information to the extent that it seeks the addresses of persons employed by JAKKS who were involved in any way with a communication, discussion or agreement. JAKKS' employees can be contacted through JAKKS' counsel of record. JAKKS further objects to Plaintiff's Instruction No. 3 as unduly burdensome to the extent that it seeks information readily apparent from a communication, discussion or agreement (*i.e.* the document speaks for itself).

11. Since discovery is not concluded, JAKKS' responses to Plaintiff's ROGs should not be deemed exhaustive. The following responses reflect JAKKS' present knowledge,

information and belief and may be subject to change or modification based on JAKKS' further discovery, or on facts or circumstances that may come to JAKKS' knowledge or attention in the future. JAKKS reserves the right to supplement its responses as additional information, if any, comes into its possession, custody or control.

12. Nothing in these responses shall be construed to waive the rights or objections which otherwise might be available to JAKKS, nor shall JAKKS' answering of any of the ROGs be deemed an admission of relevancy, materiality or admissibility in evidence of the ROG or of the responses thereto.

13. All responses stated below are provided subject to and without waiving any of the General Objections stated above.

JAKKS' RESPONSES TO PLAINTIFF'S INTERROGATORIES

INTERROGATORY NO. 2

Please state and identify the entire factual basis for your contention that you have not infringed Claim 1 and Claim 5 in the Patent-in-Suit.

ANSWER: JAKKS objects to this Interrogatory to the extent that it seeks information protected by the attorney-client privilege or attorney work product doctrine. Subject to the foregoing and General Objections, JAKKS responds as follows:

JAKKS does not infringe Claims 1 and 5 of the Patent-in-Suit because the accused Hannah Montana and Cheetah Girls posters do not have a housing unit that meets the limitation that requires a surface of the housing unit to be prepared with a matching art "*which is substantially the same as that area of said poster art which appears on said portion of said poster that said housing covers when said housing is attached to said poster*", such that said housing artistically blends in with the surrounding poster art that is not covered by said housing" (collectively referred to as the "housing unit limitation"). See '272 patent at 3:6-12, 4:12-17

(emphasis added). The housing units of the accused Hannah Montana and Cheetah Girls posters are not prepared with the art over which they are placed. Rather, the housing units of the accused Hannah Montana and Cheetah Girls posters are prepared with monochrome colors (*i.e.* blue, pink or purple). Thus, because the accused posters do not meet the “housing unit limitation,” JAKKS does not infringe Claims 1 and 5 of the Patent-in-Suit. *See also* Defendants’ Motion to Dismiss (Dkt. # 11, 22).

In addition, Plaintiff is estopped from arguing that the accused products meet the “housing unit limitation” under the doctrine of equivalents. The Supreme Court has described prosecution history estoppel as a limit on the doctrine of equivalents:

In some cases the Patent and Trademark Office (PTO) may have rejected an earlier version of the patent application on the ground that a claim does not meet a statutory requirement for patentability. ... When the patentee responds to the rejection by narrowing his claims, this prosecution history estops him from later arguing that the subject matter covered by the original, broader claim was nothing more than an equivalent.”

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 727 (2002).

In the instant case, when the applicant initially filed his patent application, claim 1 contained the limitation “wherein said blister pack matches the artwork of the poster to which it is attached.” *See* Patent App. No. 402,195 at claim 1. The Examiner, however, rejected all the claims under 35 U.S.C. § 103 as being unpatentable over Hoshi (U.S. Patent No. 4,934,079). *See* Oct. 10, 1995 Office Action at 3-5. Specifically, the Examiner stated: “The claimed blister pack matching the art work of the poster lacks criticality because the housing in Hoshi would still serve the same function as a housing for the electrical components.” *Id.* at 3-4.

In response, the applicant argued that his invention was not obvious in light of the cited prior art because unlike the cited prior art, the housing unit of his invention “allows artwork to be placed on the blister pack ... so that the electronic circuitry and sound emanating means under the housing is ‘camouflaged’ in the poster presentation.” *See* Jan. 10, 1996 Amendment and

Remarks at 4. The applicant also distinguished his invention by claiming that the housing “can be printed with artwork so as to visually blend in with the actual artwork of the poster, and effectively hide the sound module so as not to disturb or interrupt the visual flow of the poster.”

Id. Before the applicant’s response was considered by the Examiner, in an interview, the Examiner and applicant reached an agreement “to add limitation to the claim such that to emphasize the blister pack is printed so that it blends in with the artwork at the area where the blister pack is attached to.” *See* Jan. 23, 1996 Examiner Interview Summary Record. Thus, the applicant amended claim 1 as follows (added text underlined, deleted text in brackets):

wherein a surface of said housing [said blister pack material] is prepared with a matching art which is substantially the same as that area of said poster art which appears on said portion of said poster that said housing covers when said housing is attached to said poster, such that said housing artistically blends in with the surrounding poster art that is not covered by said housing [adapted to match the artwork of said poster].

See March 13, 1996 Amendment at 2. After this amendment, the Examiner allowed the claims to issue. *See* April 2, 1996 Notice of Allowability.

In sum, the Examiner initially rejected the claims as obvious in light of the prior art, and in response the applicant narrowed the claims from a housing unit “adapted to match the artwork of said poster” to a housing unit “prepared with a matching art which is substantially the same as that area of said poster art which appears on said portion of said poster that said housing covers when said housing is attached to said poster, such that said housing artistically blends in with the surrounding poster art that is not covered by said housing.”

Plaintiff claimed that the accused products meet the “housing unit limitation” under the doctrine of equivalents because:

The electronic module which houses the electronics and is attached to the Defendants infringing poster ***is colored in a manner so as to blend attractively with the image*** as a marketable finished product so as not to be an eyesore. Defendants infringing designs of the housing unit have included monochrome

colors of an exact pantone color found elsewhere on the poster, or colors in contrast with colors on the poster so as to attractively blend.

See Plaintiff's Response to JAKKS' ROG No. 5 (emphasis added). In view of the prosecution history, however, Plaintiff is estopped from arguing that a housing unit that is merely "adapted to match the artwork of the poster" infringes the Patent-in-Suit under the doctrine of equivalents. Thus, JAKKS cannot infringe Claims 1 and 5 of the Patent-in-Suit under the doctrine of equivalents.

INTERROGATORY NO. 6

Please state and identify separately for Claim 1 and Claim 5 of the Patent-in-Suit your proposed construction on an element-by-element basis, identifying all intrinsic and extrinsic evidence supporting your proposed construction.

ANSWER: JAKKS objects to this Interrogatory to the extent that it seeks information protected by the attorney-client privilege or attorney work product doctrine. Subject to the foregoing and General Objections, JAKKS responds as follows:

JAKKS does not believe that any of the claim terms in Claims 1 and 5 of the Patent-in-Suit require construction beyond the plain ordinary meaning of the terms.

With respect to the "housing unit limitation," the plain ordinary meaning of these terms makes clear that the housing surface must be prepared so that it matches the art that is covered by the housing. The claim language compels this result when it requires the housing surface be prepared with "matching art" that is "substantially the same" as the area of the poster art that the "housing covers" when it is attached to the poster.

This construction is also supported by: (1) dictionary definitions, *see Am. Heritage Dictionary of the English Language*, ed. 1981, at p. 805 ("match") and p. 140 ("blend"); (2) the specification of the Patent-in-Suit, *see* '272 patent at 1:18-20, 1:20-23, 1:58-60, 2:24-29; (3) the

Figures of the Patent-in-Suit, *see* '272 patent at 1:66-2:16, Figs 1 & 4; and (4) the prosecution history of the Patent-in-Suit, *see supra* (JAKKS' Response to ROG No. 2). *See also* Defendants' Motion to Dismiss (Dkt. Nos. 11, 22).

In contrast, Plaintiff's proposed claim construction of the "housing unit" limitation states that "[t]his sentence of the claim is not concerned with what the housing covers but that the housing, regardless of where and how it is placed, is 'prepared with matching art which is substantially the same' and 'artistically blends with the surrounding poster.'" *See* Plaintiff's Response to JAKKS' ROG Nos. 8-9. Thus, Plaintiff completely ignores the words "that area of said poster art which appears on said portion of said poster that said housing covers when said housing is attached to said poster" and "that is not covered by said housing." The Supreme Court, however, has held: "Each element contained in a patent claim is deemed material to defining the scope of the patented invention." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (1997). Thus, **all** of the words in the claim "have meaning and must be given effect." *Environmental Instruments, Inc. v. Sutron Corp.*, 877 F.2d 1561, 1564 (Fed. Cir. 1989) (abrogated on other grounds). Accordingly, Plaintiff's proposed claim construction is improper as a matter of law.

Further, although Plaintiff cites portions of the specification and dictionary definitions in his Response to JAKKS' ROG Nos. 8-9, none of the citations actually support his proposed claim construction. For example, Plaintiff's citations to the summary of the invention ('272 patent at 1:7-15) and the preferred embodiment ('272 patent at 2:18-19, 52-55), do not modify the plain ordinary meaning of the claim terms. Moreover, Plaintiff's dictionary definitions actually support JAKKS', not Plaintiff's, proposed construction. For example, the dictionary cited by Plaintiff defines "match" as "to be exactly like; correspond exactly," and defines "blend" as "to combine or associate so that the separate constituents or the line of demarcation

cannot be distinguished.” Notably, Plaintiff has not cited any portion of the prosecution history in support of his proposed claim constructions. Accordingly, the intrinsic evidence (*i.e.* claims, specification, prosecution history) and extrinsic evidence (*i.e.* dictionary definitions) support JAKKS’, not Plaintiff’s, proposed claim construction.

Even further, if, after applying all the available tools of claim construction, the claim is still ambiguous, the Federal Circuit has acknowledged application of the maxim that “claims should be construed to preserve their validity.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1327 (Fed. Cir. 2005) (en banc). Plaintiff’s proposed claim construction would render the claims invalid as indefinite and/or obvious.

Every patent’s specification must “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2. “[T]he purpose of the definiteness requirement is to ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee’s right to exclude.” *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005) (citing *Honeywell, Int’l, Inc. v. ITC*, 341 F.3d 1332, 1338 (Fed. Cir. 2003)). According to the Supreme Court, “[t]he statutory requirement of particularity and distinctness in claims is met only when [the claims] clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise.” *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942).

For example, in *Datamize*, the Federal Circuit upheld the district court’s grant of summary judgment that the patent was invalid as indefinite based on the term “aesthetically pleasing.” *Datamize*, 417 F.3d at 1348-56. Specifically, the Federal Circuit held that “[t]he scope of claim language cannot depend solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention.” *Id.* at 1350 (citing *Application of*

Musgrave, 431 F.2d 882, 893 (C.C.P.A. 1970)). “A purely subjective construction of ‘aesthetically pleasing’ would not notify the public of the patentee’s right to exclude since the meaning of the claim language would depend on the unpredictable vagaries of any one person’s opinion of the aesthetics of [the product].” *Id.* “Reference to undefined standards, regardless of whose views might influence the formation of those standards, fails to provide any direction to one skilled in the art attempting to determine the scope of the invention. In short, the definition of [a claim term] cannot depend on the undefined views of unnamed persons, even if they are experts, specialists, or academics.” *Id.* at 1352-53.

Plaintiff’s proposed constructions of the claim terms “art,” “matching art,” and “artistically blends,” would render the claim invalid as indefinite. For example, Plaintiff proposes the Court define “art” as “the conscious production or arrangement of sounds, colors, forms, movements, or other elements in a manner that affects the sense of *beauty*, specifically the production of the *beautiful* in a graphic or plastic medium.” *See* Plaintiff’s Response to JAKKS’ ROG Nos. 8-9 (emphasis added). Plaintiff’s proposed construction of “art,” however, necessarily requires a “sense of beauty.” “While beauty is in the eye of the beholder, a claim term, to be definite, requires an objective anchor.” *Datamize*, 417 F.3d at 1350. Thus, under Plaintiff’s proposed construction of the term “art,” claims 1 and 5 of the ’272 patent are invalid as indefinite.

In addition, Plaintiff’s proposed claim construction stated that “[t]here is no requirement for housing to match exactly.” *See* Plaintiff’s Response to JAKKS’ ROG Nos. 8-9. Plaintiff also cites a dictionary that defines “match” to mean “to resemble or harmonize with: *The coat matches the dress.*” Under this proposed construction, however, the term “matching art” is indefinite and renders claims 1 and 5 invalid because there are no objective standards to

determine whether art is “matching art.” Instead, the term “matching art” is a wholly subjective standard that renders the claims indefinite.

In addition, Plaintiff’s proposed construction stated:

Broad words were used to convey the concept of ‘artistically blends.’ Certainly the sentence is carefully crafted to cover a potential future embodiment with a housing that potentially could match exactly, but does not require such, and at the same time is intentionally written in **vague enough form with use of broad words** so as not to limit the scope of, excuse, exclude or fail to protect in any way use of a housing which simply attractively blends, as is stated in the claim itself.

See Plaintiff’s Response to JAKKS’ Interrogatory Nos. 8-9 (emphasis supplied). In other words, Plaintiff admits that the term “artistically blends” is “vague” due to the use of “broad words.” The only delineation of the term “artistically blends” is that the housing “attractively blends.” Similarly, Plaintiff’s proposed construction also stated:

Under the Patent, there can be **many different embodiments** of how and where the housing is attached and **the degree to which it blends** with the poster art. ... This sentence in its entirety, read as one singular description, is intended to reflect that the creation of the product is done in a manner that is **attractive**. The last sentence of claim one on this Patent is intended to say that when the housing is placed on the poster, it will be done in a manner such that the end product is **attractive, professional and that the housing does not stick out like a sore thumb**.

Id. According to Plaintiff’s proposed construction, the claim term “artistically blends” means “blend” in many different degrees, such that the end product is “attractive, professional and that the housing does not stick out like a sore thumb.” Attractiveness and professionalism, however, are subjective terms, rendering the claims invalid as indefinite. Where the term in question expresses a measure of degree, “the district court must determine whether the patent’s specification provides some standard for measuring that degree.” *Seattle Box Co. v. Indus. Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984). As with the term “aesthetically pleasing” in *Datamize*, Plaintiff’s proposed construction of “artistically blends” is completely

dependent on a person's subjective opinion, and thus renders the claims invalid as indefinite. *See Datamize*, 417 F.3d at 1350.

Finally, Plaintiff's proposed construction of the "housing unit limitation" would render the Patent-in-Suit invalid as obvious in view of the prior art. As discussed *supra* (JAKKS' Response to ROG No. 2), the Examiner initially rejected the claims as obvious in view of the prior art, and only allowed the claims after the applicant amended the claims to include the "housing unit limitation." Plaintiff, however, proposes that "[t]he last sentence of claim one on this Patent is intended to say that when the housing is placed on the poster, it will be done in a manner such that the end product is attractive, professional and that the housing does not stick out like a sore thumb." *See* Plaintiff's Response to JAKKS' ROG Nos. 8-9 (emphasis supplied). Plaintiff, however, admits that making a product in an attractive and professional manner would have been obvious. *Id.* ("The intent was to protect against any copy cat of our Talking Poster concept brought into the marketplace, which would obviously be done in an attractive and professional manner and we have done so."). Thus, under Plaintiff's proposed construction, as the Examiner originally concluded, the Patent-in-Suit would be invalid as obvious in view of the prior art.

In sum, JAKKS proposes that claims 1 and 5 should be construed according to the plain ordinary meaning of the words of the claim, and such construction is supported by the claims themselves, the specification, the prosecution history, dictionary definitions, and the maxim that claims should be construed to preserve their validity. In contrast, Plaintiff's proposed claim constructions are improper as a matter of law, are not supported by any evidence, and would render the claims invalid as indefinite and/or obvious.

//

//

INTERROGATORY NO. 12

Please state and identify the different Hannah Montana and Cheetah Girls' Infringing Products manufactured and licensed by Defendant JAKKS that exist and were offered for sale or sold on your website, www.jakkspecific.com. For each Infringing Product identified, please include the quantity of each, if known, that exist.

ANSWER: JAKKS objects to this Interrogatory as vague and ambiguous as to the term "licensed by Defendant JAKKS." JAKKS also objects to this Interrogatory as vague and ambiguous as to the terms "offered for sale or sold on your website." JAKKS also objects to this Interrogatory as vague and ambiguous and seeking irrelevant information to the extent that it seeks "the quantity of each, if known, that exist." Subject to the foregoing and General Objections, JAKKS responds as follows:

1. Hannah Montana "If We Were A Movie" poster;
2. Hannah Montana "Pumpin' Up The Party" poster;
3. Hannah Montana "Who Said" poster;
4. Hannah Montana "Make Some Noise" poster;
5. Hannah Montana "Life's What You Make It" poster;
6. Hannah Montana "Bigger Than Us" poster;
7. Cheetah Girls "Do Your Own Thing" poster;
8. Cheetah Girls "The Party's Just Begun" poster; and
9. Cheetah Girls "Amigas Cheetahs" poster.

INTERROGATORY NO. 17

For each Infringing Product identified in the response to Interrogatory No. 12, please describe how the poster art does not consist of a housing that is prepared with matching art

which is substantially the same as the area of the poster art which appears on said portion of said poster that said housing covers when said housing is attached to said poster, such that said housing artistically blends in with the surrounding poster art that is not covered by said housing.

ANSWER: JAKKS objects to this Interrogatory to the extent that it seeks information protected by the attorney-client privilege or attorney work product doctrine. Subject to the foregoing and General Objections, JAKKS responds as follows:

The housing units contained in each of the posters identified in response to Interrogatory No. 12 are all prepared with monochrome colors (*i.e.* blue, pink or purple), not with the art that appears on the portion of the poster that the housing covers. *See also supra* (JAKKS' Response to ROG No. 2); *see also* Defendants' Motion to Dismiss (Dkt. Nos. 11, 22).

Dated: July 20, 2009

Respectfully submitted,

By: /s/ Michael C. Lueder

Michael C. Lueder
Foley & Lardner LLP
777 E. Wisconsin Ave.
Milwaukee, WI 53202
Tel: (414) 297-4900
Trial Attorney

/s/ Grant E. Kinsel

Grant Kinsel (*Pro Hac Vice*)
Michael J. Song (*Pro Hac Vice*)
Foley & Lardner LLP
555 South Flower St., Suite 3500
Los Angeles, CA 90071
Tel: (213) 972-4500

Attorneys for JAKKS Pacific, Inc.

CERTIFICATE OF SERVICE

I hereby certify that the counsel of record who are deemed to have consented to electronic service are being served today with a copy of this document by electronic mail.

Dated: July 20, 2009

/s/ Michael J. Song

<p>Brian Edward Dickerson The Dickerson Law Group 5003 Horizons Drive Suite 200 Upper Arlington , OH 43220 614-339-5370 Fax: 614-442-5942 bdickerson@dickerson-law.com</p> <p>Kevin R Connors 5003 Horizons Drive Suite 101 Columbus , OH 43220 614-562-5877 kevinconnors@kevinconnors.com</p> <p>Sharlene I Chance The Dickerson Law Group 5003 Horizons Drive Suite 200 Columbus , OH 43220 614-339-5370 Fax: 614-442-5942 schance@dickerson-law.com</p>	<p>Attorneys for Plaintiff Aaron Clark</p>
--	--

VERIFICATION

I, Tom Delaney, have read the foregoing DEFENDANT JAKKS PACIFIC, INC.'S RESPONSE TO PLAINTIFF CLARK'S FIRST SET OF INTERROGATORIES and have knowledge of its contents.

I am Senior Vice President, Marketing of Defendant JAKKS Pacific, Inc., which is a party to this action. The matters stated in the foregoing document are true of my own knowledge except as to those matters which are stated on information and belief, and as to those matters, I believe them to be true.

I declare under the penalty of perjury that the foregoing is true and correct.

Executed on July 20, 2009



Tom Delaney
SVP, Marketing
JAKKS Pacific, Inc. 7-20-09