

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

BRIGHT RESPONSE, LLC
F/K/A POLARIS IP, LLC

v.

GOOGLE INC., et al.

NO. 2:07-CV-371-TJW-CE

**DEFENDANTS' JOINT MOTION *IN LIMINE* NO. 6: MOTION TO EXCLUDE
EVIDENCE AND ARGUMENT THAT ALLEN DOES NOT DISCLOSE A
"NON-INTERACTIVE ELECTRONIC MESSAGE"**

Introduction

Bright Response has admitted that U.S. Patent No. 5,581,644 to Allen discloses “an electronic message in which the sender does not provide any additional information after the message has been received”—the Court’s construction of “non-interactive electronic message.” Nevertheless, Bright Response asserts that Allen does not disclose the “non-interactive” limitation because the system Allen describes does not *always* process a non-interactive message.

Bright Response’s argument is foreclosed by well-settled Federal Circuit law. “[A] prior art product that sometimes, but not always, embodies a claimed method nonetheless teaches that aspect of the invention.” *Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314, 1326 (Fed. Cir. 2003). Accordingly, Bright Response should not be permitted to present this argument to the jury.

Argument

I. EVIDENCE AND ARGUMENT THAT ALLEN DOES NOT DISCLOSE THE “NON-INTERACTIVE ELECTRONIC MESSAGE” LIMITATION SHOULD BE PRECLUDED BECAUSE BRIGHT RESPONSE AND DR. RHYNE HAVE ADMITTED THAT ALLEN DISCLOSES THAT LIMITATION.

The Court construed “non-interactive electronic message” to mean “an electronic message in which the sender does not provide any additional information after the message has been received.” (Dkt. 369 at 9.) Bright Response’s expert, Dr. V. Thomas Rhyne, admits in his expert report that “Allen states the possibility of automatically answering problems in which the sender does not provide any additional information after the message has been received” (Kammerud Dec., Ex. A (Rhyne Rebuttal Report) at ¶ 52.) He further states that “Allen does disclose that some received messages may not require further user intervention” (*Id.*) Similarly, in his declaration in support of Bright Response’s summary judgment opposition brief,

Dr. Rhyne states: “I agree that Allen does disclose the possibility that in some instances, a sender does not provide any additional information after the message has been received”

(Kammerud Dec., Ex. B (Rhyne Decl.) at ¶ 22.) He further states: “Allen does disclose that *some* received messages may not require further user intervention” (*Id.* (emphasis in original).) And he admits “[f]or ‘high’ messages the Allen system does not seek additional information from the user. . . .” (*Id.* at ¶ 25.)

Despite these clear admissions, Dr. Rhyne cryptically concludes that Allen does not meet the “non-interactive electronic message” limitation because “the Allen system always provides the *capability* of having the sender of the message provide additional information after his or her message has been received by that system.” (Kammerud Dec., Ex. A (Rhyne Rebuttal Report) at ¶ 52.) Despite this “capability,” however, Dr. Rhyne does not dispute that the system described by the Allen Patent processes messages in which the sender does not provide any additional information after the message has been received. Nor could he, given his admissions set forth above.

In its summary judgment brief, Bright Response relies completely on Dr. Rhyne’s analysis. (*See* Dkt. No. 419 at 14-15.) Bright Response then criticizes Defendants for asking the Court to “focus[] on the case where the description itself creates a high match score and the questions may be skipped as a result.” (*Id.* at 14.) Consistent with Dr. Rhyne’s opinion, however, Bright Response does not dispute that, in that case, the system is processing a non-interactive electronic message. Instead, Bright Response asks the Court to simply ignore Allen’s disclosure of instances in which a “non-interactive electronic message” is processed.

Under well-established Federal Circuit law, those instances cannot be ignored. “[A] prior art product that sometimes, but not always, embodies a claimed method nonetheless teaches that

aspect of the invention.” *Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314, 1326 (Fed. Cir. 2003) (finding that prior art product disclosed a limitation despite the fact that the product did not always practice the limitation). Accordingly, Bright Response’s only attempt to overcome Allen’s disclosure of the “non-interactive electronic message” limitation is squarely foreclosed by Federal Circuit law, and Bright Response should not be permitted make that argument to the jury.

II. EVIDENCE AND ARGUMENT THAT ALLEN DOES NOT DISCLOSE THE “NON-INTERACTIVE ELECTRONIC MESSAGE” LIMITATION SHOULD BE PRECLUDED BECAUSE IT WOULD CONFUSE THE JURY.

Evidence is properly excluded “if its probative value is substantially outweighed by the danger of unfair prejudice, confusion of the issues, or misleading the jury” Fed. R. Evid. 403. In light of Bright Response’s and Dr. Rhyne’s own admissions, evidence and argument concerning Bright Response’s theory about why Allen does not disclose a “non-interactive electronic message” has no probative value. Bright Response should not be permitted to confuse the jury with its legally erroneous theory of validity. *See Graef v. Chem. Leaman Corp.*, No. 95-40945, 1997 U.S. App. LEXIS 12782, at *18 (5th Cir. Feb. 24, 1997) (setting forth the Fifth Circuit’s “‘harmful’ plus ‘non-probative’” test for exclusion).

Conclusion

For the foregoing reasons, Defendants respectfully request that Bright Response be prohibited from introducing evidence or argument that the Allen patent does not disclose the “non-interactive electronic message” limitation of the ‘947 patent.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that counsel of record who are deemed to have consented to electronic service are being served today with a copy of this document via the Court's ECF system per Local Rule CV-5(a)(3), as well as by electronic mail. Any other counsel of record will be served via electronic mail, facsimile transmission and/or first class mail on today's date.

By /s/ Margaret P. Kammerud
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