

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

BRIGHT RESPONSE, LLC,	§	
Plaintiff,	§	
	§	
v.	§	Civil Action No. 2:07-cv-371-ce
	§	
GOOGLE, INC., et al.,	§	
	§	JURY TRIAL DEMANDED
Defendants.	§	
	§	

**BRIGHT RESPONSE, LLC'S MOTION IN LIMINE NUMBER 1  
 (UNCHARTED PRIOR ART REFERENCES):  
 MOTION TO PRECLUDE DEFENDANTS' RELIANCE ON OR REFERENCE TO  
 UNCHARTED PRIOR ART REFERENCES (EZ READER MANUAL  
AND CBR EXPRESS MANUALS) AND HEARSAY**

Plaintiff Bright Response, LLC files this pre-trial Motion in Limine pursuant to the Court's docket control order (D.I. 385), and before the commencement of the voir dire examination of the jury panel, concerning certain prior art references and arguments that Defendants may not rely on at trial for the reasons set forth below. Bright Response also files, concurrently with this Motion in Limine No. 1 additional motions in limine ("Plaintiff's Omnibus Motion") necessary for the Court's ruling to ensure no unfair prejudice impairs Bright Response's right to a fair trial.

**I. SUMMARY OF RELIEF REQUESTED.**

The Defendants' expert witness as to the validity of the '947 Patent—Dr. Branting—has prepared an expert report that presents many new theories of invalidity never before asserted by the Defendants (whether in Defendants' P.R. 3-3 Invalidity Contentions, the multiple supplementations thereto, or otherwise). Bright Response requests an order from this Court precluding Defendants from relying on uncharted prior art references that are the basis for these new theories of invalidity. Specifically, Bright Response requests an order from this Court

precluding Defendants and their expert, Dr. Branting, from relying on, mentioning, or arguing in any way any other alleged prior art reference concerning the “EZ Reader” except for the only reference Defendants charted: the EZ Reader article published on August 5, 1996 by the American Association for Artificial Intelligence (AAAI) (the “AAAI Article”). Wiley Decl. **Ex. A** (AAAI Article); Wiley Decl. **Ex. B** (conference date). The order requested would preclude Defendants from, for example, relying on, arguing, or referring to the EZ Reader *manual*—“*The EZ Reader User's Guide and Reference Manual*”—or (ii) an amalgam of testimony from other witnesses and documents, such as one of the named inventors Amy Rice, and mere hearsay with a third-party witness Mr. Chuck Williams.

Defendants’ expert Dr. Branting may not so belatedly and expansively go beyond the confines of Defendants’ contentions and opine on an anticipatory references—the EZ Reader *manual*—that is nowhere charted in any of the *three* iterations of the Defendants’ P.R. 3-3 Invalidity Contentions. Defendants and Dr. Branting should be precluding from mentioning the EZ Reader manual for any purpose.

Just as deficient, but deficient only as of May 2010 when defendants supplemented for the second time, is Defendants’ supplement with Chart A-69. Wiley Decl. **Ex. C**. Defendants chart only the Allen patent “*with* the CBR Express Reference Manual as prior art to Asserted Claims of” the ‘947 patent” (*id.*) (emphasis added)—there is no separate chart to demonstrate that the CBR Express Reference Manuals themselves anticipate. It is clear then from Defendants’ operative Invalidity Contentions that Defendants have never had any intention of using the CBR Express Manuals as anticipation. Wiley Decl. **Ex. C** (Chart A-69). Dr. Branting’s report, however, tells a different story. Wiley Decl. **Ex. D**. Defendants apparently intend to rely on a theory that the CBR Express Manuals themselves anticipate as Dr. Branting

opines on this very theory in his expert report. He may not do so. The Court should preclude Dr. Branting from also opining on the CBR Express Manuals (which comprise (i) the CBR Express User’s Guide and (ii) the CBR Express Reference Manual) as separate anticipatory references.

## **II. DEFENDANTS’ CONTENTIONS—SINCE 2008—CHART ONLY THE EZ READER ARTICLE.**

The Defendants served their original P.R. 3-3 Invalidity Contentions on August 7, 2008. Wiley Decl. **Ex. E**. Defendants attached just one chart, including numerous references for each asserted claim of the ‘947 patent. The only references concerning the EZ Reader, are to the *AAAI article*.<sup>1</sup>

In March 2010, Defendants Google and AOL sought leave to supplement their P.R. 3-3 Invalidity Contentions, and Plaintiff consented. The charts for this supplementation included an “EZ Reader” exhibit. This exhibit, identified as Chart A-4, was 5 pages in length and was limited to citations to the AAI Article for each of the asserted claims (claims 26, 27, 30, 31, 33, 38, 39, 40). *See* Wiley Decl. **Ex. F** (March proposed supplement). It includes no other citations for the “EZ Reader.” Moreover, Plaintiff consented to Defendants Google and AOL serving supplemental P.R. 3-3 Invalidity Contentions upon receiving a redline showing the additional contentions and charts that Google and AOL would seek leave to supplement. *See* Wiley Decl.

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<sup>1</sup> The Exhibit A chart to Defendants’ August 7, 2008 Invalidity Contentions is included within the single PDF file as the Defendants’ Invalidity Contentions; the Exhibit A has separate pagination, however, and it follows the conclusion of the Invalidity Contentions at page 28. Although the local rules require attaching excerpts, Bright Response must demonstrate that the entire chart shows *no charting* for any reference but the Rice AAI article, the balance of the Exhibit must be provided in addition to the reference highlighted concerning only the Rice AAI article. *See* Wiley Decl. Ex. C (at “Exhibit A to Defendants’ Invalidity Contentions”) at 7 (citing Rice *AAAI article* 1509); *id.* at 14 (citing Rice *AAAI article*, 1509); *id.* at 22 (citing Rice *AAAI article* 1509-1510, 1513); *id.* at 31-32 (citing *AAAI Article* 1509); *id.* at 39 (citing *AAAI article* 1509); *id.* at 46 (citing *AAAI article* 1509); *id.* at 52 (citing citing *AAAI article* 1513); *id.* at 57 (citing citing *AAAI article* 1513).

**Ex. G** (March redline for chart). That redline shows Google and AOL were only correcting the unwieldy format of the original Exhibit A to Defendants’ August 2008 Invalidity Contentions (Wiley Decl. **Ex. E**), but they still relied exclusively on the AAI article. *Id.* The Court granted Google and AOL’s (unopposed) motion for leave on March 31, 2010. D.I. 298 (Motion); D.I. 300 (Order).

Yahoo had not moved to supplement its contentions when Google and AOL did, but approached Plaintiff on April 30, 2010 with a proposed joint supplementation—again—by all Defendants. **Wiley Decl. Ex. H**. For this third iteration of charting the EZ Reader, Defendants relied on the same EZ Reader Exhibit. **Wiley Decl. & Ex. F**. In other words, Defendants relied on an EZ Reader exhibit, 5 pages in length—excerpted below—citing nothing but the same AAI article to chart how Defendants contended that the EZ Reader anticipated the asserted claims of the ‘947 patent:

**Chart A-4**  
**Claim Chart of “EZ Reader: Embedded AI for Automatic Electronic Mail Interpretation and Routing” (“EZ READER”)**

‘947 Patent	EZ READER
A method for automatically processing a non-interactive electronic message using a computer, comprising the steps of:	<i>EZ READER</i> 1507, 1510
(a) Receiving the electronic message from a source;	<i>EZ READER</i> 1507, 1509
(b) Interpreting the electronic message using a rule base and case base knowledge engine; and	<i>EZ READER</i> 1507, 1509-13
(c) Retrieving one or more predetermined responses corresponding to the interpretation of the electronic	<i>EZ READER</i> 1509-11.

message from a repository for automatic delivery to the source.	
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Wiley Decl. **Ex. F** (emphasis added).

In none of the three iterations of their invalidity contentions did Defendants once chart any other aspect of the EZ Reader other than the AAAI Article. Defendants now, on the eve of trial, are attempting to greatly broaden the scope of their invalidity contentions beyond just the AAAI article to the prejudice of Bright Response. They attempt to reach other product manuals and testimony about a number of versions of the EZ Reader product—all of which were available to the Defendants months and which, even over a year ago (to the extent Defendants were going to rely upon them), should have been the subject of P.R. 3-3 charts.<sup>2</sup>

Defendants' expert, Dr. Branting, in his report relies extensively on prior art that he refers to as "EZ Reader"—but not the AAAI Article that Defendants charted and relied on since August 2008. Instead, Defendants, through Dr. Branting's report, are attempting to expand the universe of references, invalidity arguments, and theories by including the EZ Reader *manual*. Wiley Decl. **Ex. I** at 36-39 (excerpts from Dr. Branting's report). Dr. Branting's charting for EZ Reader is nothing like the one that Defendants have used, simply in a different format in its various iterations since August 2008:

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<sup>2</sup> Bright Response put Defendants on notice—in January 2009—that sufficient contentions and charts were required to fulfill the notice requirements of P.R. 3-3 Invalidity Contentions. Wiley Decl. **Ex. J** (Edmonds letter: Jan. 19, 2009). Bright Response reiterated "Defendants' duty to include in those charts at the outset preparing their P.R. 3-3 invalidity contentions – in particular with respect to alleged prior art that is owned or controlled by any of the defendants and alleged prior art that is in the public domain." Even then, over a year ago, Bright Response was clear that preparing the case would be hindered if Defendants attempted even then to include additional prior art references: "To be clear, any attempt at this point to add any such alleged prior art to this case would be unfairly prejudicial to Bright Response." *Id.* Defendants cannot now profess surprise then at being limited to the deficient universe of contentions and charts.

**Anticipation under 35 U.S.C. § 102 and Obviousness under 35 U.S.C. 203 by  
EZ Reader**

Claim Language from US 6,411,947	Disclosure in EZ Reader
26. A method for automatically processing a non-interactive electronic message using a computer, comprising the steps of:	<p>The <i>EZ Reader system</i>, as described in the Rice paper <i>and the EZ Reader Manual</i>, automatically processed non-interactive electronic messages, e.g. email.</p> <p>“Lotus Notes is Chase Manhattan Bank's corporate email standard; Chase's corporate email router mutes emails to and from the Internet domain and Lotus Notes databases. Accordingly, EZ. Reader was built to operate continuously and automatically in conjunction with Lotus Notes mail functions.” (BR 001255, p .1510.)</p> <p>“EZ Reader is an intelligent electronic mail (email) tender that employs a unique combination of rule based parsing and case-based reasoning to automatically and with a high level of accuracy classify and respond to large volumes of incoming email. EZ Reader reduces the time and human resources required to handle incoming email by selecting responses and adding attachments and advice to each incoming message based on how previous similar messages were handled.” (BR 001252, p .1507, Abstract.)</p>
(a) Receiving the electronic message from a source:	<p>The <i>EZ Reader system</i>, as described in the Rice paper <i>and the EZ Reader Manual</i>, received email from a source:</p> <p>“EZ Reader is an intelligent electronic mail (email) tender that employs a unique combination of rule based parsing and case-based reasoning to automatically and with a high level of accuracy classify and...</p>

**Wiley Decl. Ex. K at 60** (excerpts from Exhibit 3 to the Branting Report) (emphasis added).

Dr. Branting, further expands on the confines of Defendants’ contentions by reaching out to a third party and determining, based only on a telephone conversation, that he can properly opine that EZ Reader anticipates. *See Wiley Decl. Ex. I* at 101 (“239. As detailed in section VI.D, EZ Reader anticipates every asserted claim. Of note, EZ Reader uses ART\*Enterprise as its case-based knowledge engine, the same engine used in CBR-Express. (Watson 336-337; **July 2, 2010 Conversation with Chuck Williams.**) (emphasis added); *see also id.* at 52 n.14 (citing as reference for opinion: “**Telephone conversation on July 2, 2010**”) (emphasis added).

Lastly, again moving far afield from any semblance of notice in the operative contentions—as recently supplemented in May 2010—Dr. Branting opines on two “CBR Express” reference manuals as anticipatory references. Wiley Decl. **Ex. D** at 60 (excerpts Branting Report re CBR) (“The CBR Express Users Guide (“User’s Guide”) and CBR Express Reference Manual (“Reference Manual”) *anticipate and render obvious* claims 26, 28, 30, 31, and 33.”). In fact, the very evidence on which Defendants rely in their response to Bright Response Motion for Summary Judgment on their affirmatives defenses and counterclaims also relies on Chart A-69 of their Invalidity Contentions—added in the last supplementation in May 2010—but there is no charting whatsoever of either of these references as distinct references that anticipate. The title of the chart alone reveals the chart was not even intended for that purpose. It is intended solely for the showing how those manuals, combined with Allen, render the asserted claims invalid.

**Chart A-69**  
**U.S. Pat. No. 5,581,664 to Allen with the CBR Express Reference Manual**  
**as prior art to**  
**Asserted Claims of U.S. Patent No. 6,411,947 (“947 Patent”)**

Wiley Decl. **Ex. C**.

### **III. ARGUMENT**

#### **A. Defendants’ Failure to Chart the EZ Reader Manual—Ever—Means Defendants Violated P.R. 3-3. and Cannot Remedy that Error At This Late Date.**

“The purpose of the Patent Local Rule 3-3 is to place the Plaintiff on notice of potentially invalidating art that Defendants will assert in their case and at trial.” *Cummins-Allison Corp. v. SBM Co., Ltd.*, No. 9:07-CV-196, 2009 WL 763926, at \*4 (E.D. Tex. Mar. 19, 2009). The local rules for providing adequate notice would be completely eviscerated if a defendant could refer to a single publication—*for two years*—as a prior art reference, and then, on the eve of trial in an expert report, allow its expert to refer to other publications and systems. An invalidating

reference cannot be cobbled together from bits and pieces of different prior art, and certainly not from prior art that has never been charted as part of a defendant's P.R. 3-3 contentions.

Patent Rule 3-3 is the mirror image, the corollary, to the plaintiff's burden to produce adequate information contentions under P.R. 3-1. It requires charts for each reference in order to provide adequate notice:

Patent Rule 3-3 **requires**, in relevant part, that a Defendant: (1) the identity of each item of prior art, (2) whether each item of prior art anticipates or renders obvious each asserted claim, (3) the identity of the combination of items of prior art that makes a claim obvious and the motivation to combine such terms, **and (4) a chart identifying where specifically in each alleged item of prior art each element of each asserted claim is found.** See P.R. 3-3(a)-(d).

*Realtime Data, LLC v. Packeteer, Inc.*, 2009 WL 4782062, at \*2 (E.D. Tex. Dec. 8, 2009) (emphasis added) (citing/quoting *Cummins-Allison Corp.*, 2009 WL 763926, at \*4); *see also Finisar Corp. v. DirecTV Group, Inc.*, 424 F. Supp. 2d 896, 897 (E.D. Tex. 2006) (noting rule for specific reference to anticipatory prior art); *see also Finisar*, 424 F. Supp. 2d at 899 (failing to comply with notice requirements “is **grounds for prohibiting introduction of evidence of the prior art.**”) (emphasis added) (citing *Ferguson Beauregard/Logic Controls v. Mega Sys., L.L.C.*, 350 F.3d 1327, 1347 (Fed. Cir. 2003)); *see also id.* at 901-02 (“Invalidity is an affirmative defense, and the party which does not properly investigate applicable prior art early enough to timely meet disclosure requirements **risks exclusion of that evidence.** *Mega Sys.*, 350 F.3d at 1347.”) (emphasis added).

Had Bright Response provided Defendants with nothing more than a few cites to a single manual for its charts in support of its infringement contentions, no doubt Defendants would deem that inadequate and limit Bright Response to that one and only charted reference to present its infringement case at trial.



**B. Defendants' Failure To Chart The EZ Reader Manual—Ever—Has Caused Bright Response Great Prejudice.**

Bright Response has been significantly prejudiced by Defendants' failure to comply with their obligations under P.R. 3-3. This case has been on the Court's docket for more than two years. Defendants have now *twice* updated their invalidity contentions, and Bright Response has twice allowed Defendants to do so. Each time for each supplement Defendants charted only the AAI Article. Bright Response justifiably and reasonably relied on Defendants' charts in constructing its defenses and determining what discovery to take to challenge where Defendants contended a prior art reference anticipated, claim step by claim step, each asserted claim. The first time Bright Response received *any* notice that Defendants were planning their invalidity case based on the EZ Reader *manual*—and the EZ Reader system—as prior art (and not the AAI Article) was in Dr. Branting's report. Dr. Branting's report, served on July 6, 2010—less than one month before trial—is not the type of “notice” the Patent Rules in this District require. The consequences of that omission, and the significant prejudice to Bright Response, requires limiting Defendants to the only EZ Reader reference they ever charted in the more than two years this case has been on file—the AAI Article.

**C. Relying On CBR Express Manuals As Separate Anticipating References Also Is Prejudicial.**

When Defendants have never charted anything but how the CBR Express manuals render some claims of the '947 patent *obvious*, there is no basis to revise two years worth of charting and suddenly argue anticipation in an expert report and allow an expert to so opine at trial. Anticipation and obviousness are separate defenses with separate elements. To allow charting for obviousness to substitute for that required for anticipation violates the very purpose of P.R.3-3 contentions and its explicit requirement for charting each specific reference on which a defendant intends to rely. *See Realtime Data*, 2009 WL 4782062, at \*2 (citing/quoting

*Cummins-Allison Corp.*, 2009 WL 763926, at \*4 and rule requirement for “*a chart identifying where specifically in each alleged item of prior art each element of each asserted claim is found.*”) (emphasis added). Particularly in view of Bright Response permitting not just one but two supplementations, Defendants’ failure to analyze every prior art reference in a timely fashion requires placing the consequence of that omission on Defendants, not Bright Response. Those consequences must be exclusion of those references from trial and precluding Dr. Branting from relying on them or basing an anticipation opinion on them. *Finisar*, 424 F. Supp. 2d at 899 (failing to comply with notice requirements “is grounds for prohibiting introduction of evidence of the prior art.”).

#### **IV. CONCLUSION.**

Bright Response therefore requests the Court to enter the attached order, precluding Defendants and their counsel from referring to, mentioning, arguing, or relying on for any arguments at trial, within hearing of the jury, (1) the EZ Reader Manual (or the EZ Reader system, or hearsay as the basis for any anticipation opinion) as invalidating anticipatory prior art references; and (2) the CBR References Manuals, never charted as separate anticipatory references that cannot now be used to support an anticipation opinion.

Dated: July 22, 2010

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I certify that a true and correct copy of this motion has been served on all opposing counsel of record on this 22<sup>nd</sup> day of July 2010 by using the Court's' CM/ECF system.

\s\ Andrew W. Spangler  
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