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

BRIGHT RESPONSE, LLC Plaintiff, v. GOOGLE INC., et al., Defendants.	Civil Action No. 2:07-cv-371-TJW

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EXPERT REPORT OF HARRY F. MANBECK, JR.

Harry F. Manbeck, Jr.

July 20, 2010
Date

C The Alleged Addition of Improper Joint Inventors to the '947 Patent.

59. Mr. Mossinghoff asserts that the "improper naming of persons who are not inventors on a U.S. patent—as Ms. Rice testified in the first part of her deposition –is a breach of the duty of candor and good faith to the PTO which, if done with intent to deceive the PTO, would support a finding of inequitable conduct." Mossinghoff Report, p. 28.

60. The first point I would raise is that insofar as I can determine from the evidence available to me, there is absolutely no intent by anyone to mislead the PTO as to the proper inventorship entity. The '947 patent is, of course, a continuation of the '059 patent, and the named co-inventors are the same in both. Insofar as I can determine from the prosecution history of the '059 patent, the inventorship entity was determined by the attorneys who filed the application. Three of the five inventors, Ms. Piccolo and Messrs. Angotti and Cohen were employees of Chase, while Ms. Rice and Ms. Hsu were employees of Brightware, a predecessor-in-interest to Bright Response's ownership of the '947 patent. When the '233 application was filed, only Ms. Rice and Ms. Hsu were named as co-inventors, but the inventorship entity was corrected to include all five inventors. This was done by a Certificate of Correction issued by the PTO after the '947 patent had issued.

61. Mr. Mossinghoff points to testimony from Ms. Rice in his argument to support his theory that the inventive entity may be incorrect. But he does not consider the deposition testimony of Ms. Piccolo, Mr. Angotti and Mr. Cohen as to why they were included in the inventorship entity. That testimony includes the following:

A. <u>Rosanna Piccolo</u>

Q: Okay. Do you know why you were added as an inventor?

A: I believe because I was the project manager for Chase.

Q: On the EZ Reader project?

A: Correct.

Deposition of Rosanna Piccolo, July 9, 2009, p. 21:12-17.

B. Anthony Angotti

> Q: Did you provide any input on what was actually claimed in the patent?
>
> MR. BUSTAMANTE: Objection, form.
>
> A: Yes. In terms of what the patent is for?
>
> Q: Yes.
>
> A: Yes.

Deposition of Anthony Angotti, November 13, 2009, p. 141:18-23. Mr. Angotti also stated in his declaration:

> Prior to the merger, Rosanna Piccolo and I worked with Amy Rice and Julie Hsu in coming up with certain aspects of the system configuration and implementation details of the EZ Reader System. Having now had an opportunity to more fully review the claims of the '059 and the '947 patents, it is my recollection that Rosanna Piccolo and I contributed to the prioritization and sub-categorization of incoming emails and the system-level architecture disclosed in the '059 and the '947 patents. In particular, I recall being involving in the collaborative efforts surrounding the inventions claimed in claims 4-6 and 45-51 of the '947 patent.

Declaration of Anthony Angotti, June 15, 2004, ¶ 6.

C. Fred Cohen

> Q: So, let's talk a little bit about that. So they brought you a draft of the application, and then what

happened?

A: I read through the application to see if it satisfied Chase's policies and practices, and, given my knowledge of Chase's operations, to determine whether or not it made appropriate claims, given the little I knew from the face of the document about the invention. And I gave no legal advice in that context because I'm not a patent lawyer. I looked at it. It looked fine to me, but I said wouldn't it be appropriate to add this aspect of the invention, and the attorney said, yeah, that seems appropriate. Now we have to make you an inventor.

Q: When you say "this aspect," what aspect?

A: When the application came to me, it contemplated input to the process only of electronic inquiries, e-mails, and other electronic inquiries—actually, I'm—my memory is not specific as to the other inquiries—something akin to e-mail inquiries, and I said it shouldn't be limited to e-mail inquiries, given what I know of technology now. For example, dictation software it ought to be able to handle a voice or a voice recording just as well as it does an e-mail or a electronic transmission of words. And they agreed and broadened the claims. By the way, to my knowledge, I was a listed inventor on the initial Chase application.

Deposition of Fred R. Cohen, May 20, 2009, pp. 27:9-28:15.

62. Thus, it is clear that all three of the Chase employees believed they were co-inventors and had no intent to deceive the PTO by executing their inventors' declarations. The file history of the '947 patent does not indicate any objection by Ms. Rice or Ms. Hsu to the three Chase employees being included as co-inventors and, as pointed out by Mr. Mossinghoff, Ms. Rice did acknowledge during her testimony that the Chase employees were co-inventors. Thus, I see no evidence of intent by anyone to mislead the PTO as to the correct inventorship entity.

63. If during the current litigation it should be established the one or more of the named co-inventors was not in fact a co-inventor, the inventive entity can be corrected by the court under the 35 USC 256. That section of the patent statute reads as follows:

> Correction of Named Inventor.
>
> Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error. The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

64. All in all, it is my opinion that Mr. Mossinghoff is crying foul when there was none and if there was an inadvertent naming of an incorrect co-inventor, it can be readily corrected. Thus, there is certainly no sustainable reason to claim that the '947 patent should be declared unenforceable because of an incorrect naming of one or more co-inventors.

65. From the evidence I have reviewed, I have not seen any evidence of intent to deceive the PTO. Mr. Mossinghoff has not offered any express opinions based on his expertise on the intent to deceive the PTO. I expressly reserve the right to supplement my rebuttal opinions should Mr. Mossinghoff be permitted to offer opinions on these or other related issues.