

EXHIBIT A
PARTS 1 OF 3

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

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

Plaintiff,

v.

GOOGLE INC. et al.

Defendants.

Case No. 2:07-cv-371-TJW-CE

JURY TRIAL DEMANDED

DEFENDANTS' INVALIDITY CONTENTIONS

Defendants Google Inc., AOL LLC, America Online, Inc., and Yahoo! Inc. (collectively "Defendants") hereby serve their Invalidity Contentions pursuant to P.R. 3-3 and the Court's June 11, 2008, Docket Control Order.

The Invalidity Contentions set forth below are based on information currently available to Defendants and Defendants' present understanding of Plaintiff's interpretation of the asserted claims in the asserted U.S. Patent No. 6,411,947 (the "'947 patent") set forth in Plaintiff Bright Response, LLC's ("Bright Response") Disclosure of Asserted Claims and Infringement Contentions. Nothing in Defendants' disclosures should be regarded as necessarily reflecting how items of prior art would apply to the features of the '947 patent under a proper interpretation of the claims. Additionally, nothing in Defendants' disclosures should be regarded as necessarily reflecting the proper interpretation of the claims or an interpretation of the claims Defendants agree with or propose. Defendants dispute Bright Response's apparent claim interpretations and will propose alternative constructions to those apparently adopted by Bright Response in its infringement contentions at the appropriate time.

Defendants reserve the right to supplement or modify these Invalidity Contentions in a manner consistent with the Federal Rules of Civil Procedure, the applicable local rules or otherwise as the Court may allow. Further, Defendants reserve the right to rely on additional prior art; further analysis of prior art; application of prior art to new or different claims; depositions and discovery from prior art sources and authors; analysis of prior art products; combinations of references; expert opinion and/or testimony; evidence supporting invalidity of any asserted claim; and any additional relevant information that may result from their further investigation and discovery.

Defendant's Prior Art Reference Chart, attached hereto as Exhibit A, identifies where specifically in each identified item of prior art each element of each asserted claim is found, citing particular teachings/disclosure of the referenced art as applied to the features of the '947 patent. Persons of skill in the art, however, generally would appreciate an item of prior art in the context of other publications, literature, products, and understanding. The citations are exemplary and not exclusive. Defendants reserve the right to rely on uncited portions of the prior art references and on other publications and expert testimony as aids in understanding and interpreting the cited portions, as providing context to them, and as additional evidence that the prior art discloses a claimed feature. Defendants reserve the right to establish what was known to a person having ordinary skill in the art through other publications, products, and/or testimony. Defendants also reserve the right to rely on uncited portions of the prior art references, other publications, and testimony to establish that a person of skill in the art would have been motivated to combine certain of the cited references so as to render the claims obvious.

I. THE IDENTITY OF EACH ITEM OF PRIOR ART THAT ANTICIPATES AND/OR RENDERS OBVIOUS EACH ASSERTED CLAIM UNDER 35 U.S.C. §§ 102 AND/OR 103.

Initially, asserted Claims 26-27 & 38-40 of the '947 patent are not entitled to the filing date of Provisional Application No. 60/042,656, filed on April 4, 1997 and are not entitled to the filing date of Provisional Application No. 60/042,494, filed on April 3, 1997. Both applications

fail to support each element of Claims 26-27 & 38-40, particularly if the claims were to be interpreted as implied in Bright Response's Disclosure of Asserted Claims and Infringement Contentions. Accordingly, the earliest possible effective filing date for Claims 26-27 & 38-40 is April 2, 1998, the filing date of Application No. 09/054,233.

In addition to the prior art items submitted to or considered by the U.S.P.T.O in connection with the examination of the '947 patent, Defendants identify the following prior art items that anticipate and/or render obvious, alone or in combination, the asserted claims.

Ref. No.	Reference Description	Short Cite
1	U.S. Patent No. 5,224,206, issued June 29, 1993	'206
2	U.S. Patent No. 5,243,689, issued September 7, 1993	'689
3	U.S. Patent No. 5,317,677, issued May 31, 1994	'677
4	U.S. Patent No. 5,402,524, issued March 28, 1995	'524
5	U.S. Patent No. 5,444,823, issued August 22, 1995	'823
6	U.S. Patent No. 5,581,664, issued December 3, 1996	'664
7	U.S. Patent No. 5,586,218, issued December 17, 1996	'218
8	U.S. Patent No. 5,666,481, issued September 9, 1997	'481
9	U.S. Patent No. 5,836,771, issued November 17, 1998	'771
10	U.S. Patent No. 5,884,302, issued March 16, 1999	'302
11	U.S. Patent No. 5,899,985, issued May 4, 1999	'985
12	U.S. Patent No. 5,909,679, issued June 1, 1999	'679
13	U.S. Patent No. 6,058,435, issued May 2, 2000	'435
14	U.S. Patent No. 6,078,914, issued June 20, 2000	'914
15	U.S. Patent No. 6,085,201, issued July 4, 2000	'201
16	WO 92/15951, published September 17, 1992	WO 92/15951
17	WO 93/21587, published October 28, 1993.	WO 93/21587

Ref. No.	Reference Description	Short Cite
18	WO 95/02221, published January 19, 1995.	WO 95/02221
19	Nitta, Katsumi, et al., Helic II – A Legal Reasoning System on the Parallel Inference Machine, Proceedings of the International Conference on Fifth Generation Computer Systems (1992).	Nitta '92
20	Hill, Will, et al., Recommending and Evaluating Choices in a Virtual Community of Use, Conference on Human Factors in Computing Systems (1995).	Hill '95
21	Rissland, Edwina, et al., A Hybrid CBR-IR Approach to Legal Information Retrieval, Proceedings of the Fifth International Conference on Artificial Intelligence and Law (1995).	Rissland '95
22	Rissland, Edwina, et al., Combining Case-Based and Rule-Based Reasoning: A Heuristic Approach, Proceedings of the Eleventh International Joint Conference on Artificial Intelligence, (1989).	Rissland '89
23	Aamodt, Agnar, et al., Case-Based Reasoning: Foundational Issues, Methodological Variations, and System Approaches, AI Communications, Vol. 7 Nr. 1, 39-59, (1994).	Aamodt '94
24	Allen, Bradley P., Case-Based Reasoning: Business Applications, Communications of the ACM, Vol. 37, Issue 3, 40-42 (1994).	Allen '94
25	Fathi-Torbaghan, M., et al., ICARUS: Integrating Rule-Based and Case-Based Reasoning on the Base of Unsharp Symptoms, IEEE International Conference on Systems, Man and Cybernetics, Vol. 3, 2424-2427, (1995).	Fathi-Torbaghan '95
26	Fox, Susan, Introspective Learning for Case-Based Planning, Ph.D. Thesis, Computer Science, Indiana University, (1995).	Fox '95
27	Golding, Andrew R., et al., Improving Rule-Based Systems Through Case-Based Reasoning, Proceedings of the 9th National Conference on Artificial Intelligence, Anaheim, CA, 22-27, (1991).	Golding '91
28	Golding, Andrew R., et al., Improving Accuracy by Combining Rule-Based and Case-Based Reasoning, Artificial Intelligence Vol. 87, 215-254 (1996). See also, Golding, Andrew R., et al., Improving Accuracy by Combining Rule-Based and Case-Based Reasoning, Mitsubishi Electric Research Laboratories (1995). ¹	Golding '96

¹ The two references entitled Golding, Andrew R., et al., Improving Accuracy by Combining Rule-Based and Case-Based Reasoning disclose the same material and are jointly referenced as Golding '96 in Defendants' Invalidity Contentions and Exhibit A to Defendants' Invalidity Contentions.

Ref. No.	Reference Description	Short Cite
29	Jurisica, Igor, Inductive Learning and Case-Based Reasoning, Canadian AI Conference, Workshop on What Is Inductive Learning?, Toronto, (1996).	Jurisica '96
30	Leake, David B., Chapter 1: CBR in Context: The Present and Future, Case-Based Reasoning: Experiences, Lessons, and Future Directions, Menlo Park: AAAI Press / MIT Press, (1996).	Leake '96
31	Manago, Michel, et al., Induction and Reasoning from Cases, First European Workshop on CBR, Seki-Report SR-93-12 University of Kaiserslautern, 313-318, (1993).	Manago '93
32	Slator, Brian, et al., Taxops: A Case-Based Advisor, International Journal of Expert Systems, 4-2, 1-28, (1991).	Slator '91
33	Surma, Jerzy, et al., Integrating Rules and Cases for the Classification Task, Case-Based Reasoning, Research and Development, First International Case-Based Reasoning Conference, - ICCBR '95, Springer Verlag, 325-334, (1995).	Surma '95
34	Watson, Ian, et al., Case-Based Reasoning: A Review, The Knowledge Engineering Review 9(4), (1994).	Watson '94
35	Watson, Ian, Case-Based Reasoning Tools: An Overview, Proc. Second U.K. Workshop Case-Based Reasoning (1996).	Watson '96
36	Skalak, David B., et al., Argument Moves in a Rule-Guided Domain, Proceedings of the 3rd International Conference on Artificial Intelligence and Law, 1-11, (1991).	Skalak '91
37	Chi, Robert T., et al., An Integrated Approach of Rule-Based and Case-Based Reasoning for Decision Support, Proceedings of the 19th Annual Conference on Computer Science, San Antonio, Texas. 255-267 (1991).	Chi '91
38	Acorn, T., et al., SMART: Support Management Automated Reasoning Technology for COMPAQ Customer Service, Proc. Fourth Annual Conf. on Innovative Applications of Artificial Intelligence, Menlo Park, CA: AAAI Press, (1992).	Acorn '92
39	Auriol, E., et al., INRECA: A Seamlessly Integrated System Based on Inductive Reasoning and Case-Based Reasoning, Lecture Notes in Artificial Intelligence: Subseries of Lecture Notes in Computer Science: Springer-Verlag Berlin Heidelberg, (1995).	Auriol '95
40	Portinale, L, et al., ADAPTER: An Integrated Diagnostic System Combining Case-Based and Abductive Reasoning, Lecture Notes in Artificial Intelligence: Subseries of Lecture Notes in Computer Science: Springer-Verlag	Portinale '95

Ref. No.	Reference Description	Short Cite
	Berlin Heidelberg, (1995).	
41	Rissland, Edwina, et al., CABARET: Rule Interpretation in a Hybrid Architecture, International Journal of Man Machine Studies 34, 839-887, (1991).	Rissland '91
42	Lopez, Beatriz, et al., Case-based Planning for Medical Diagnosis, Methodologies for Intelligent Systems, 7th International Symposium (1993).	Lopez '93
43	Rissland, Edwina, et al., Case-based Diagnostic Analysis in a Blackboard Architecture, Proceedings of the Eleventh International Joint Conference on Artificial Intelligence, (1993).	Rissland '93
44	Vossos, George, et al., An Example of Integrating Legal Case Based Reasoning with Object Oriented Rule-Based Systems: IKBALS II, Proceedings of the Third International Conference on Artificial intelligence and Law, 31-41 (1991).	Vossos '91
45	Dutta, Somitra, et al., Integrating Case Based and Rule Based Reasoning: The Possibilistic Connection, Uncertainty in Artificial Intelligence 6, Elsevier Science Publishers B.V. (1991).	Dutta '91
46	Skalak, David, et al., Arguments and Cases: An Inevitable Intertwining, Artificial Intelligence and Law 1, 3-44 (1992).	Skalak '92
47	Popple, James, A Pragmatic Legal Expert System, Dartmouth Publishing Company (1996).	Popple '96
48	Kriegsman, Mark, et al., Building a Case-Based Help Desk Application, IEEE Expert, Vol. 8, No. 6, 18-26 (1993).	Kriegsman '93
49	Simoudis, Evangelos, Using Case-Based Retrieval for Customer Technical Support, IEEE Expert, Vol. 7, No. 5, 7-12 (1992).	Simoudis '92
50	Hall, Robert, INFOMOD: A Knowledge-Based Moderator for Electronic Mail Help Lists, Proceedings of the Fifth International Conference of Information and Knowledge Management, 107-114 (1996).	Hall '96
51	Rissland, Edwina, et al., A Case-Based System for Trade Secrets Law, Proceedings of the First International Conference on Artificial intelligence and Law, 60-67 (1987).	Rissland '87
52	Kowalski, Andrezj, Case-Based Reasoning and the Deep Structure Approach to Knowledge Representation, Proceedings of the Third International Conference on Artificial Intelligence and Law, 21-30 (1991).	Kowalski '91
53	Whitehead, Steven, Auto-FAQ: An Experiment in Cyberspace Leveraging, Computer Networks and ISDN	Whitehead '95

Ref. No.	Reference Description	Short Cite
	Systems 28, 137-146 (1995).	
54	Chang, Kai, et al., A Self-Improving Helpdesk Service System Using Case-Based Reasoning Techniques, Computers in Industry 30, 113-125 (1996).	Chang '96
55	Nguyen, Trung, et al., Compaq Quickscore: Providing the Consumer with the Power of AI, AI Magazine, Vol. 14, No. 3, 50-60 (1993).	Nguyen '93
56	Rice, Amy, et al. EZ Reader: Embedded AI for Automatic Electronic Mail Interpretation and Routing, Proceedings of the Thirteenth National Conference on Artificial Intelligence and the Eighth Innovative Applications of Artificial Intelligence Conference, Vol. 2, 1507-1517, (1996).	Rice '96
57	Lenz, Mario, Cabata – A Hybrid CBR System, Proceedings of First European Workshop on Case-Base Reasoning (EWCBR), 204-209 (1993).	Lenz '93
58	Venkataraman, S., et al., A Rule – Rule – Case Based System for Image Analysis, Proceedings of First European Workshop on Case-Base Reasoning (EWCBR), 410-415 (1993).	Venkataraman '93
59	U.S. Patent No. 5,720,001, issued February 17, 1998	Nguyen '001
60	Cohen, William W. Fast Effective Rule Induction, Proceedings of the Twelfth International Conference on Machine Learning, (1995)	Cohen '95
61	Cohen, William W. Learning Rules that Classify E-Mail, Proceedings of the 1996 AAAI Spring Symposium on Machine Learning in Information Access (1996)	Cohen '96
62	Jeffries, Robin, et al. Comparing a Form-based and a Language-based User Interface for Instructing a Mail Program. ACM Sigchi Bulletin, Volume 17, Issue SI, p. 261-266 (1987)	Jefferies '87

The following list provides the identity of items or services sold, offered for sale, known or that embodied the inventions of the '947 patent made by another before the alleged invention by the patent applicants as described in the prior art references included in Exhibit A hereto. As discovery is still ongoing and Defendants have not completed their prior art investigation, Defendants expressly reserve the right to further rely on depositions and discovery from prior art

sources, authors and other entities relating to the sales, offers for sale, disclosures, use, deployment, design, functionality, operation and development of the identified items or services.

Item Known, Used, Sold or Offered for Sale	Date Known, Used, Sold or Offered for Sale	Identity of Person or Entity Which Made the Information Known or to Whom It Was Made Known, or Which Made the Use or Sale or Which Made or Received the Sale or Offer; Identity of Person From Whom the Invention or Any Part of It Was Derived and Surrounding Circumstances; Identity of Person or Entities Involved in the Making of the Invention Before the Patent Applicants and Surrounding Circumstances
EZ Reader	1996	Rice, Amy, et al. and as described in the above-identified prior art authored by the individual
Helic II	1992	Nitta, Katsumi, et al. and as described in the above-identified prior art authored by the individual
ICARUS	1995	Fathi-Torbaghan, M., et al. and as described in the above-identified prior art authored by the individual
Taxops	1991	Slator, Brian, et al. and as described in the above-identified prior art authored by the individual
SMART	1992	Acorn, T., et al. and as described in the above-identified prior art authored by the individual

INRECA	1995	Auriol, E., et al. and as described in the above-identified prior art authored by the individual
ADAPtER	1995	Portinale, L, et al. and as described in the above-identified prior art authored by the individual
CABARET	1991	Rissland, Edwina, et al. and as described in the above-identified prior art authored by the individual
IKBALS II	1991	Vossos, George, et al. and as described in the above-identified prior art authored by the individual
INFOMOD	1996	Hall, Robert and as described in the above-identified prior art authored by the individual
Auto-FAQ	1995	Whitehead, Steven and as described in the above-identified prior art authored by the individual
Compaq Quicksource	1993	Nguyen, Trung, et al. and as described in the above-identified prior art authored by the individual
Cabata	1993	Lenz, Mario and as described in the above-identified prior art authored by the individual
ROBBIE	1995	Fox, Susan and as described in the above-identified prior art authored by the individual
ANAPRON	1996	Golding, Andrew R. et al. and as described in the above-identified prior art authored by the individual

TA3	1996	Jurisica, Igor and as described in the above-identified prior art authored by the individual
CHI	1991	Chi, Robert T., et al. and as described in the above-identified prior art authored by the individual
BOLERO	1993	Lopez, Beatriz, et al. and as described in the above-identified prior art authored by the individual
FRANK	1993	Rissland, Edwina, et al. and as described in the above-identified prior art authored by the individual
MARS	1991	Dutta, Somitra, et al. and as described in the above-identified prior art authored by the individual
SHYSTER	1996	Popple, James and as described in the above-identified prior art authored by the individual
CASCADE	1992	Simoudis, Evangelos and as described in the above-identified prior art authored by the individual
HYP0	1987	Rissland, Edwina, et al. and as described in the above-identified prior art authored by the individual
MPC	1991	Kowalski, Andrezj and as described in the above-identified prior art authored by the individual
SmartUSA	1996	Chang, Kai, et al. and as described in the above-identified prior art authored by

		the individual
R-R-C	1993	Venkataraman, S. et al. and as described in the above-identified prior art authored by the individual

II. P.R. 3-3(B). ANTICIPATION, OBVIOUSNESS, AND MOTIVATION TO COMBINE.

Defendants contend that each and every asserted claim of the '947 patent is anticipated and/or rendered obvious under 35 U.S.C. 102 and/or 103 in light of the identified prior art. The contentions described herein are exemplary, representing Defendants' present view based on limited discovery. Below and in the attached Exhibit A, Defendants identify whether each item of prior art anticipates each asserted claim or renders it obvious. In addition, below, Defendants identify combinations of items of prior art that render each of the asserted claims obvious and the motivation to combine such items.

Where Defendants have listed a reference as rendering a particular claim invalid without an express combination of other prior art (or with the knowledge of one skilled in the art), Defendants contend that the cited reference anticipates the claim. In addition, Defendants contend that such cited reference also renders the claim obvious. Defendants expressly reserve the right to assert that each of the claims is obvious in view of the prior art identified herein, in the event that the Court finds that one of more of the references that Defendants contend anticipate the claims do not anticipate such claims. In addition to the combinations specifically listed below for obviousness, each item of prior art identified above, as well as each of the prior art items submitted to or considered by the U.S.P.T.O. in connection with the examination and allowance of the '947 patent, is combinable — for purposes of rendering the claim obvious — with one or more of any other prior art items referenced herein.

Defendants note that many of the prior art references disclosed herein were not cited by the applicants or the examiner and, therefore, were not considered by the U.S.P.T.O. during prosecution.

A. Anticipation

Defendant contends that the following prior art included in the attached Exhibit A anticipates the asserted claims²:

Prior Art	Anticipated Claims
U.S. Patent No. 5,224,206	26-27 & 38-40
U.S. Patent No. 5,243,689	26-27 & 38-40
U.S. Patent No. 5,317,677	26-27 & 38-40
U.S. Patent No. 5,402,524	26-27 & 39-40
U.S. Patent No. 5,444,823	26-27 & 38-40
U.S. Patent No. 5,581,664	26-27 & 38-40
U.S. Patent No. 5,586,218	26-27 & 38-40
U.S. Patent No. 5,666,481	26-27 & 38-40
U.S. Patent No. 5,836,771	26-27 & 38-40
U.S. Patent No. 5,884,302	26-27 & 38-40
U.S. Patent No. 5,899,985	26-27 & 38-40
U.S. Patent No. 5,909,679	26-27 & 38-40
U.S. Patent No. 6,058,435	26-27 & 38-40
U.S. Patent No. 6,078,914	26-27 & 38-40
U.S. Patent No. 6,085,201	26-27 & 39-40
Patent Publication No. WO 92/15951	26-27 & 39-40
Patent Publication No. WO 93/21587	26-27 & 40
Patent Publication No. WO 95/02221	26-27 & 38-40
Helic-II- A Legal Reasoning System on the Parallel Inference Machine	26-27 & 38-40

² To the extent any identification is inadvertently omitted here which implicitly is present in the invalidity chart attached as Exhibit A, Defendants incorporate by this reference any such items of prior art.

Recommending and Evaluating Choices in a Virtual Community of Use	26-27 & 38-40
A Hybrid CBR-IR Approach to Legal Information Retrieval	26-27 & 38-40
Combining Case-Based and Rule-Based Reasoning: A Heuristic Approach	26-27 & 38-40
Case-Based Reasoning: Foundational Issues, Methodological Variations, and System Approaches	26-27 & 38-39.
Case-Based Reasoning: Business Applications	26-27 & 38-40
ICARUS: Integrating Rule-Based and Case-Based Reasoning on the Base of Unsharp Symptoms	26-27 & 38, 40
Introspective Learning for Case-Based Planning	26-27 & 38-40
Improving Rule-Based Systems Through Case-Based Reasoning	26-27 & 38-40
Improving Accuracy by Combining Rule-Based and Case-Based Reasoning Vol. 87, 215-254 (1996). See also Improving Accuracy by Combining Rule-Based and Case-Based Reasoning, Mitsubishi Electric Research Laboratories (1995).	26-27 & 38-40
Inductive Learning and Case-Based Reasoning	26-27 & 38-40
Chapter 1: CBR in Context: The Present and Future	26-27 & 38-40
Induction and Reasoning from Cases	26-27 & 38-40
Taxops: A Case-Based Advisor	26-27 & 38-40
Integrating Rules and Cases for the Classification Task	26-27 & 38-40
Case-Based Reasoning: A Review	26-27 & 38-40
Case-Based Reasoning Tools: An Overview	26-27 & 38-40
Argument Moves in a Rule-Guided Domain	26-27 & 38
An Integrated Approach of Rule-Based and Case-Based Reasoning for Decision Support	26-27 & 38-40
SMART: Support Management Automated Reasoning Technology for COMPAQ Customer Service	26-27 & 38-40
INRECA: A Seamlessly Integrated System Based on Inductive Reasoning and Case-Based Reasoning	26-27 & 40
ADAPtER: An Integrated Diagnostic System Combining Case-Based and Abductive Reasoning	26-27 & 38, 40
CABARET: Rule Interpretation in a Hybrid Architecture	26-27 & 38, 40
Case-based Planning for Medical Diagnosis	26-27 & 38, 40
Case-based Diagnostic Analysis in a Blackboard Architecture	26-27 & 39-40

An Example of Integrating Legal Case Based Reasoning with Object Oriented Rule-Based Systems: IKBALS II	26-27 & 39-40
Integrating Case Based and Rule Based Reasoning: The Possibilistic Connection	26-27 & 38, 40
Arguments and Cases: An Inevitable Intertwining	26-27 & 38, 40
A Pragmatic Legal Expert System	26-27 & 38-40
Building a Case-Based Help Desk Application	26-27 & 39-40
Using Case-Based Retrieval for Customer Technical Support	26-27 & 38-40
INFOMOD: A Knowledge-based Moderator for Electronic Mail Help Lists	26-27 & 38-40
A Case-Based System for Trade Secrets Law	26-27 & 38-40
Case-Based Reasoning and the Deep Structure Approach to Knowledge Representation	26-27 & 38-40
Auto-FAQ: An Experiment in Cyberspace Leveraging	26-27 & 39-40
A Self-Improving Helpdesk Service System Using Case-Based Reasoning Techniques	26-27 & 39-40
Compaq Quickscore: Providing the Consumer with the Power of AI	26-27 & 39-40
EZ Reader: Embedded AI for Automatic Electronic Mail Interpretation and Routing	26-27 & 38-40
Cabata – A hybrid CBR System	26-27 & 38-40
A Rule – Rule – Case Based System for Image Analysis	26-27 & 38-40
U.S. Patent No. 5,720,001	26-27 & 38-40
Fast Effective Rule Induction	26-27 & 38-40
Learning Rules that Classify E-Mail	26-27 & 38-40
Comparing a Form-based and a Language-based User Interface for Instructing a Mail Program	26-27 & 38-40
EZ Reader	26-27 & 38-40
Helic II	26-27 & 38-40
ICARUS	26-27 & 38, 40
Taxops	26-27 & 38-40
SMART	26-27 & 38-40
INRECA	26-27 & 40

ADAPtER	26-27 & 38, 40
CABARET	26-27 & 38, 40
IKBALS II	26-27 & 38, 40
INFOMOD	26-27 & 38-40
Auto-FAQ	26-27 & 39-40
Compaq Quicksource	26-27 & 39-40
Cabata	26-27 & 38-40
ROBBIE	26-27 & 38-40
ANAPRON	26-27 & 38-40
TA3	26-27 & 38-40
CHI	26-27 & 38-40
BOLERO	26-27 & 38, 40
FRANK	26-27 & 39-40
MARS	26-27 & 38, 40
SHYSTER	26-27 & 38-40
CASCADE	26-27 & 38-40
HYPO	26-27 & 38-40
MPC	26-27 & 38-40
SmartUSA	26-27 & 39-40
R-R-C	26-27 & 38-40

Defendants' investigation of the prior art is ongoing and as additional information is found with respect to the prior art systems and methods identified herein, Defendants may find that in addition to those already identified above, the asserted claims are anticipated by one or more of other prior art systems or methods.

B. Obviousness

Defendants contend that each reference identified above, alone or when combined with the knowledge of persons of ordinary skill in the art at the time the claimed invention was purportedly invented or when combined as provided below, renders all the asserted claims of the '947 patent invalid as obvious under 35 U.S.C. § 103. To the extent motivation to combine is relevant to the obviousness inquiry, motivation to combine the teachings of the references identified below is found in the listed references themselves as well as (1) the nature of the problem, (2) the knowledge of those of ordinary skill in the art, (3) the teachings of the prior art, particularly the clear teachings in the field relating to the use of knowledge based reasoning systems, including rule bases and/or case bases, to process and respond to electronic messages as disclosed in the references and (4) the fact that the relevant prior art is directed towards knowledge systems and/or rule based reasoning and/or rule databases and/or case based reasoning and/or case databases.

For example, the existence of knowledge based reasoning systems, and the use of rule based reasoning and/or case based reasoning in such reasoning systems, was well-understood by people of skill in the art at the time the '947 patent application was filed, as evidenced by the art cited herein. The use of knowledge based reasoning systems to respond to messages provided electronically was also well-known, as evidenced by the art cited herein. It would have been obvious to one of skill in the art at the time to modify or combine these related teachings to arrive at the claimed invention.

Additionally, the references, alone or in combination with other references listed above, contain an explicit and/or implicit teaching, suggestion, motivation or inference to combine one or more of the references in that the motivation exists within the references themselves, as well as within the knowledge of those of ordinary skill in the art. These references identify and address the same technical issues and suggest very similar solutions to those issues. Many of these references cross-reference and discuss one another, providing an explicit motivation to

combine such references, and thereby further illustrate the close technical relationship among this group of references.

Finally, the rule of “motivation to combine” has been expanded by the Supreme Court’s recent clarification that the teaching, suggestion and motivation (“TSM”) test for obviousness is a “flexible” one and not rigidly applied. *KSR Intern. Co. v. Teleflex, Inc.*, 550 U.S. ____ (2007); 127 S. Ct. 1727 (2007). The *KSR* case clarified that the motivation to combine need not be rigidly found in the references themselves, but can be found in the “interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person of ordinary skill in the art...”. *Id.* at 1741. Importantly, the Supreme Court stated that “any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide reason for combining elements...” *Id.* at 1733. Defendants accordingly apply the Supreme Court’s “flexible” TSM test for these disclosures.

If and to the extent that Bright Response challenges the correspondence of any of these references with respect to particular elements of the asserted claims of the ’947 patent, Defendants reserve the right to supplement these contentions to identify additional motivations to combine particular references with one another.

The combinations of references provided below under 35 U.S.C. § 103 are merely exemplary and are not intended to be exhaustive. Additional obviousness combinations of the references identified below are possible, and the Defendants reserve the right to use any such combination(s) in this litigation. In particular, the Defendants are currently unaware of Bright Response’s allegations with respect to the level of skill in the art, the typical person of ordinary skill in the art, and of the extent, if any, to which Bright Response may contend that limitations of the claims at issue are not disclosed in the prior art identified by the Defendants as anticipatory, and the extent to which Bright Response will contend that elements not disclosed in the asserted patent specification would have been known to persons of skill in the art. To the extent that an issue arises with any such limitations, the Defendants reserve the right to identify

other references that would have made such limitations obvious in view of the relevant disclosures.

Each prior art item identified above renders each and every asserted claim obvious. In addition, the following combinations of prior art references included in Exhibit A provided under P.R. 3-3(c) render obvious the asserted claims of the '947 patent (for short cite correspondence to reference full identification see tables 1 and 2 in section above regarding P.R. 3-3(a)):

Claim 26 is obvious in view of the ordinary skill in the art at the time of the invention. Moreover, claim 26 is obvious over the combination of any one or more of '206, '677, '823, '664, '218, '481, '771, '302, '985, '679, '435, '914, WO 95/02221, Nitta '92, Hill '95, Rissland '95, Rissland '89, Allen '94, Fox '95, Golding '91, Golding '96, Slator '91, Watson '94, Watson '96, Chi '91, Acorn '92, Popple '96, Simoudis '92, Hall '96, Rissland '87, Kowalski '91, EZ Reader, Helic II, Taxops, SMART, INFOMOD, Rice '96, Aamodt '94, Fathi-Torbaghan '95, Jurisica '96, Leake '93, Surma '95, Skalak '91, Manago '93, Portinale '95, Rissland '91, Lopez '93, Vossos '91, Dutta '91, Skalak '92, ICARUS, ADAPTER, CABARET, IKBALS II, '524, '201, WO 92/15951, WO 93/21587, Auriol '95, Rissland '93, Kriegsman '93, INRECA, Whitehead '95, Chang '96, Nguyen '93, Auto-FAQ, Compaq Quicksource, '689, Lenz '93, Cabata, ROBBIE, ANAPRON, CHI, SHYSTER, CASCADE, HYPO, MPC, R-R-C, BOLERO, FRANK, MARS, SmartUSA, TA3, Cohen '95, Cohen '96, '001, Jefferies '87 or Venkataraman '93, and/or further in view of the level of skill in the art.

Claim 27 is obvious in view of the ordinary skill in the art at the time of the invention. Moreover, claim 27 is obvious over the combination of any one or more of '206, '677, '823, '664, '218, '481, '771, '302, '985, '679, '435, '914, WO 95/02221, Nitta '92, Hill '95, Rissland '95, Rissland '89, Allen '94, Fox '95, Golding '91, Golding '96, Slator '91, Watson '94, Watson '96, Chi '91, Acorn '92, Popple '96, Simoudis '92, Hall '96, Rissland '87, Kowalski '91, EZ Reader, Helic II, Taxops, SMART, INFOMOD, Rice '96, Aamodt '94, Fathi-Torbaghan '95, Jurisica '96, Leake '93, Surma '95, Skalak '91, Manago '93, Portinale '95, Rissland '91, Lopez '93, Vossos '91, Dutta '91, Skalak '92, ICARUS, ADAPTER, CABARET, IKBALS II, '524,

'201, WO 92/15951, WO 93/21587, Auriol '95, Rissland '93, Kriegsman '93, INRECA, Whitehead '95, Chang '96, Nguyen '93, Auto-FAQ, Compaq Quicksource, '689, Lenz '93, Cabata ROBBIE, ANAPRON, CHI, SHYSTER, CASCADE, HYPO, MPC, R-R-C, BOLERO, FRANK, MARS, SmartUSA, TA3, Cohen '95, Cohen '96, '001, Jefferies '87 or Venkataraman '93, and/or further in view of the level of skill in the art.

Claim 38 is obvious in view of the ordinary skill in the art at the time of the invention. Moreover, claim 38 is obvious over the combination of any one or more of '206, '677, '823, '664, '218, '481, '771, '302, '985, '679, '435, '914, WO 95/02221, Nitta '92, Hill '95, Rissland '95, Rissland '89, Allen '94, Fox '95, Golding '91, Golding '96, Slator '91, Watson '94, Watson '96, Chi '91, Acorn '92, Popple '96, Simoudis '92, Hall '96, Rissland '87, Kowalski '91, EZ Reader, Helic II, Taxops, SMART, INFOMOD, Aamodt '94, Fathi-Torbaghan '95, Jurisica '96, Leake '93, Surma '95, Skalak '91, Manago '93, Portinale '95, Rissland '91, Lopez '93, Vossos '91, Dutta '91, Skalak '92, Cohen '95, Cohen '96, '001, Jefferies '87, ICARUS, ADAPTER, CABARET, IKBALS II, Rice '96, '689, Lenz '93, Cabata, ROBBIE, ANAPRON, CHI, SHYSTER, CASCADE, HYPO, MPC, R-R-C, TA3, BOLERO, MARS or Venkataraman '93, and/or any one or more of '524, '201, WO 92/15951, WO 93/21587, Aurilo '95, Rissland '93, Kriegsman '93, Whitehead '95, Chang '96, Nguyen '93, Auto-FAQ, Compaq Quicksource, SmartUSA, FRANK or INRECA and/or further in view of the level of skill in the art.

Claim 39 is obvious in view of the ordinary skill in the art at the time of the invention. Moreover, claim 39 is obvious over the combination of any one or more of '206, '677, '823, '664, '218, '481, '771, '302, '985, '679, '435, '914, WO 95/02221, Nitta '92, Hill '95, Rissland '95, Rissland '89, Allen '94, Fox '95, Golding '91, Golding '96, Slator '91, Watson '94, Watson '96, Chi '91, Acorn '92, Popple '96, Simoudis '92, Hall '96, Rissland '87, Manago '93, Surma '95, Leake '96, '689, Kowalski '91, Cohen '95, Cohen '96, '001, Jefferies '87, EZ Reader, Helic II, Taxops, SMART, INFOMOD, '524, '201, WO 92/15951, Aamodt '94, Jurisica '96, Rissland '93, Kriegsman '93, Whitehead '95, Chang '96, Nguyen '93, Rice '96, Auto-FAQ, Compaq Quicksource, Lenz '93, Cabata, ROBBIE, ANAPRON, CHI, SHYSTER, CASCADE, HYPO,

MPC, R-R-C, TA3, FRANK, SmartUSA or Venkataraman '93, and/or any one or more of WO 93/21587, Fathi-Torbaghan '95, Skalak '91, Auriol '95, Portinale '95, Rissland '91, Lopez '93, Vossos '91 Dutta '91, Skalak '92, ICARUS, INRECA, ADAPTER, CABARET, MARS, BOLERO or IKBALS II and/or further in view of the level of skill in the art.

Claim 40 is obvious in view of the ordinary skill in the art at the time of the invention. Moreover, claim 40 is obvious over the combination of any one or more of '206, '677, '823, '664, '218, '481, '771, '302, '985, '679, '435, '914, WO 95/02221, Nitta '92, Hill '95, Rissland '95, Rissland '89, Allen '94, Fox '95, Golding '91, Golding '96, Slator '91, Watson '94, Watson '96, Chi '91, Acorn '92, Popple '96, Simoudis '92, Hall '96, Rissland '87, Fathi-Torbaghan '95, Jurisica '96, Manago '93, Surma '95, Leake '96, '689, ICARUS, TA3, Kowalski '91, EZ Reader, Helic II, Taxops, SMART, INFOMOD, '524, '201, WO 92/15951, WO 93/21587, Auriol '95, Portinale '95, Rissland '91, Lopez '93, Rissland '93, Vossos '91, Dutta '91, Skalak '92, Cohen '95, Cohen '96, '001, Jefferies '87, Kriegsman '93, INRECA, ADAPTER, CABARET, IKBALS II, Whitehead '95, Chang '96, Nguyen '93, Rice '96, Auto-FAQ, Compaq Quicksource, Lenz '93, Cabata, ROBBIE, ANAPRON, CHI, SHYSTER, CASCADE, HYPO, MPC, R-R-C, BOLERO, FRANK, MARS, SmartUSA or Venkataraman '93, and/or any one or more of Aamodt '94, or Skalak '91, and/or further in view of the level of skill in the art.

III. P.R. 3-3(C). CLAIM CHARTS.

Pursuant to P.R. 3-3(c) and the Court's June 11, 2008 Docket Control Order, and based, in whole or in part, on Bright Response's asserted theories of infringement as identified in its Disclosure of Asserted Claims and Infringement Contentions, Defendants provide the chart of the above prior art references in Exhibit A. As indicated above, Defendants' reliance on Bright Response's implied claim constructions does not mean that Defendants agree that such constructions are proper. All portions of each reference are relied upon to support the disclosure of each claim element, as all portions provide general support. In an effort to focus the issues, exemplary descriptions and citations are provided, but do not represent every place where a particular claim element may be found in the prior art reference. Persons of ordinary skill in the

art generally read a prior art reference as a whole and in the context of other publications and literature. Therefore, Defendants reserve the right to rely on additional, or different, portions of the prior art references and on other publications and expert testimony to provide context and as aids to understanding and interpreting the portions cited.

Defendants may also rely on uncited portions of the prior art references, other publications, and the testimony of experts to establish that a person of ordinary skill in the art would have been motivated to modify or combine certain of the cited references so as to render the claims obvious. Where Defendants cite to a particular figure in a prior art reference, the citation should be understood to encompass the caption and description of the figure and any text relating to the figure in addition to the figure itself. Conversely, where a cited portion of text refers to a figure, the citation should be understood to include the figure as well.

IV. P.R. 3-3(D). INVALIDITY BASED ON ENABLEMENT OR WRITTEN DESCRIPTION UNDER 35 U.S.C. § 112(1) OR INDEFINITENESS UNDER 35 U.S.C. § 112(2).

A. Written Description under 35 U.S.C. § 112(1)

Asserted claims 26-27 and 38-40 are invalid as lacking written description under 35 U.S.C. § 112, ¶ 1. Claims 26-27 & 38-40 lack written description because one of ordinary skill in the art would not recognize that the inventors had possession of at least the following elements:

To the extent Bright Response asserts that any of Yahoo's accused instrumentalities include a "non-interactive electronic message," as recited in Claims 26-27 & 38-40, the specification provides no written description for that claim element.

To the extent that Bright Response asserts that any of Yahoo's accused instrumentalities include a "rule base knowledge engine" or "case base knowledge engine" as recited in claims 26-27 & 38-40, the specification provides no written description for those claim elements.

To the extent that Bright Response asserts that any of Yahoo's accused instrumentalities include "one or more predetermined responses corresponding to the interpretation of the

electronic message,” as recited in Claims 26-27 & 38-40, the specification provides no written description for that claim element.

To the extent that Bright Response asserts that any of Yahoo’s accused instrumentalities include a “predetermined response” that is “altered in accordance with the interpretation of the electronic message before delivery to the source,” as recited in Claim 38, the specification provides no written description for that claim element.

To the extent that Bright Response asserts that any of Yahoo’s accused instrumentalities include an “electronic message” that “includes fixed data” as recited in Claim 39, the specification provides no written description for that claim element.

To the extent that Bright Response asserts that any of Yahoo’s accused instrumentalities include an “electronic message” that “includes variable data” as recited in Claim 40, the specification provides no written description for that claim element.

To the extent Bright Response asserts that any of Google’s accused instrumentalities include a “non-interactive electronic message,” as recited in Claims 26-27 & 38-40, the specification provides no written description for that claim element.

To the extent that Bright Response asserts that any of Google’s accused instrumentalities include a “rule base knowledge engine” or “case base knowledge engine” as recited in claims 26-27 & 38-40, the specification provides no written description for those claim elements.

To the extent that Bright Response asserts that any of Google’s accused instrumentalities include “one or more predetermined responses corresponding to the interpretation of the electronic message,” as recited in Claims 26-27 & 38-40, the specification provides no written description for that claim element.

To the extent that Bright Response asserts that any of Google’s accused instrumentalities include a “predetermined response” that is “altered in accordance with the interpretation of the electronic message before delivery to the source,” as recited in Claim 38, the specification provides no written description for that claim element.

To the extent that Bright Response asserts that any of Google's accused instrumentalities include an "electronic message" that "includes fixed data" as recited in Claim 39, the specification provides no written description for that claim element.

To the extent that Bright Response asserts that any of Google's accused instrumentalities include an "electronic message" that "includes variable data" as recited in Claim 40, the specification provides no written description for that claim element.

To the extent Bright Response asserts that any of AOL's accused instrumentalities include a "non-interactive electronic message," as recited in Claims 26-27 & 38-40, the specification provides no written description for that claim element.

To the extent that Bright Response asserts that any of AOL's accused instrumentalities include a "rule base knowledge engine" or "case base knowledge engine" as recited in claims 26-27 & 38-40, the specification provides no written description for those claim elements.

To the extent that Bright Response asserts that any of AOL's accused instrumentalities include "one or more predetermined responses corresponding to the interpretation of the electronic message," as recited in Claims 26-27 & 38-40, the specification provides no written description for that claim element.

To the extent that Bright Response asserts that any of AOL's accused instrumentalities include a "predetermined response" that is "altered in accordance with the interpretation of the electronic message before delivery to the source," as recited in Claim 38, the specification provides no written description for that claim element.

To the extent that Bright Response asserts that any of AOL's accused instrumentalities include an "electronic message" that "includes fixed data" as recited in Claim 39, the specification provides no written description for that claim element.

To the extent that Bright Response asserts that any of AOL's accused instrumentalities include an "electronic message" that "includes variable data" as recited in Claim 40, the specification provides no written description for that claim element.

B. Enablement under 35 U.S.C. § 112(1)

Asserted claims 26-27 and 38-40 are invalid as lacking enablement under 35 U.S.C. § 112, ¶ 1. Claims 26-27 & 38-40 fails to enable the invention because one of ordinary skill in the art would not recognize how to use at least the following elements:

To the extent Bright Response asserts that any of Yahoo's accused instrumentalities include a "non-interactive electronic message," as recited in Claims 26-27 & 38-40, the specification does not enable one skilled in the art to use the claim element.

To the extent that Bright Response asserts that any of Yahoo's accused instrumentalities include a "rule base knowledge engine" or "case base knowledge engine" as recited in claims 26-27 & 38-40, the specification does not enable one skilled in the art to use those claim elements.

To the extent that Bright Response asserts that any of Yahoo's accused instrumentalities include "one or more predetermined responses corresponding to the interpretation of the electronic message," as recited in Claims 26-27 & 38-40, the specification does not enable one skilled in the art to use the claim element.

To the extent that Bright Response asserts that any of Yahoo's accused instrumentalities include a "predetermined response" that is "altered in accordance with the interpretation of the electronic message before delivery to the source," as recited in Claim 38, the specification does not enable one skilled in the art to use the claim element.

To the extent that Bright Response asserts that any of Yahoo's accused instrumentalities include constitutes an "electronic message" that "includes fixed data" as recited in Claim 39, the specification does not enable one skilled in the art to use the claim element. .

To the extent that Bright Response asserts that any of Yahoo's accused instrumentalities include an "electronic message" that "includes variable data" as recited in Claim 40, the specification does not enable one skill in the art to use the claim element.

To the extent Bright Response asserts that any of Google's accused instrumentalities include a "non-interactive electronic message," as recited in Claims 26-27 & 38-40, the specification does not enable one skilled in the art to use the claim element.

To the extent that Bright Response asserts that any of Google's accused instrumentalities include a "rule base knowledge engine" or "case base knowledge engine" as recited in claims 26-27 & 38-40, the specification does not enable one skilled in the art to use those claim elements.

To the extent that Bright Response asserts that any of Google's accused instrumentalities include "one or more predetermined responses corresponding to the interpretation of the electronic message," as recited in Claims 26-27 & 38-40, the specification does not enable one skilled in the art to use the claim element.

To the extent that Bright Response asserts that any of Google's accused instrumentalities include a "predetermined response" that is "altered in accordance with the interpretation of the electronic message before delivery to the source," as recited in Claim 38, the specification does not enable one skilled in the art to use the claim element.

To the extent that Bright Response asserts that any of Google's accused instrumentalities include constitutes an "electronic message" that "includes fixed data" as recited in Claim 39, the specification does not enable one skilled in the art to use the claim element.

To the extent that Bright Response asserts that any of Google's accused instrumentalities include an "electronic message" that "includes variable data" as recited in Claim 40, the specification does not enable one skill in the art to use the claim element.

To the extent Bright Response asserts that any of AOL's accused instrumentalities include a "non-interactive electronic message," as recited in Claims 26-27 & 38-40, the specification does not enable one skilled in the art to use the claim element.

To the extent that Bright Response asserts that any of AOL's accused instrumentalities include a "rule base knowledge engine" or "case base knowledge engine" as recited in claims 26-27 & 38-40, the specification does not enable one skilled in the art to use those claim elements.

To the extent that Bright Response asserts that any of AOL's accused instrumentalities include "one or more predetermined responses corresponding to the interpretation of the electronic message," as recited in Claims 26-27 & 38-40, the specification does not enable one skilled in the art to use the claim element.

To the extent that Bright Response asserts that any of AOL's accused instrumentalities include a "predetermined response" that is "altered in accordance with the interpretation of the electronic message before delivery to the source," as recited in Claim 38, the specification does not enable one skilled in the art to use the claim element.

To the extent that Bright Response asserts that any of AOL's accused instrumentalities include constitutes an "electronic message" that "includes fixed data" as recited in Claim 39, the specification does not enable one skilled in the art to use the claim element.

To the extent that Bright Response asserts that any of AOL's accused instrumentalities include an "electronic message" that "includes variable data" as recited in Claim 40, the specification does not enable one skill in the art to use the claim element.

C. Indefinite under 35 U.S.C. § 112(2)

Asserted claim 38 is invalid as indefinite under 35 U.S.C. § 112, ¶ 2. Claim 38 is indefinite because one of ordinary skill in the art would not be able to translate the phrase "wherein the predetermined response is altered in accordance the interpretation of the electronic message before delivery to the source" into a meaningfully precise claim scope.

Asserted claim 39 is invalid as indefinite under 35 U.S.C. § 112, ¶ 2. Claim 39 is indefinite because one of ordinary skill in the art would not be able to translate the phrase "wherein the electronic message includes fixed data" into a meaningfully precise claim scope.

Asserted claim 40 is invalid as indefinite under 35 U.S.C. § 112, ¶ 2. Claim 40 is indefinite because one of ordinary skill in the art would not be able to translate the phrase "wherein the electronic message included variable data" into a meaningfully precise claim scope.

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Respectively submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was served at least via e-mail on this date to counsel of record for Plaintiff Bright Response, LLC.

August 7, 2008

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