

**UNITED STATES DISTRICT COURT
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-CE

**DEFENDANTS' MOTION FOR JUDGMENT AS A MATTER OF LAW ON
INVALIDITY FOR FAILURE TO SATISFY THE WRITTEN DESCRIPTION
REQUIREMENT OF 35 U.S.C § 112¶1**

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STATUTES

35 U.S.C. §112¶1	<i>passim</i>
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I. INTRODUCTION

Pursuant to Federal Rule of Civil Procedure 50, Yahoo! Inc. and Google Inc. (“Defendants”) hereby move the Court for entry of judgment as a matter of law that the asserted claims of the ’947 patent are invalid under 35 U.S.C. § 112¶1.

In this patent infringement case, plaintiff Bright Response, LLC asserts that the claims of U.S. Patent No. 6,411,947 (the ’947 patent), which describe a system for automatically processing electronic messages, such as emails, are infringed by Defendants’ internet advertising services that process internet users’ search queries and “clicks.” The asserted claims of the ’947 patent are directed to automatically processing “non-interactive electronic messages” but the patent specification discloses only one type of message in any sort of detail: email. The only other disclosure in the ’947 patent specification is a single sentence that references “digital formats, voice data, dual tone multi-frequency (DTMF) tones, or the like.” Despite directing an entire specification to emails, and then listing a handful of alternative formats of electronic messages, Plaintiff now alleges that an internet user’s search queries and clicks are non-interactive electronic messages. The ’947 patent specification, however, lacks any discussion of internet users’ search queries or clicks, much less any suggestion that search queries or clicks could be “non-interactive electronic messages” as contemplated by Plaintiff. Therefore, if the ’947 patent claims are indeed so broad as to encompass internet users’ search queries or mere clicks, then the claims have been stretched beyond the invention that is adequately described in the patent’s specification. Simply put, the ’947 patent’s inventors did not invent a way to automatically process internet users’ search queries and clicks, and certainly did not describe such an invention in the ’947 patent.

The first paragraph of Section 112 of the patent statute requires that a patent specification describe the invention in sufficient detail to show that the applicants were in possession, at the time of filing, of what they later claim. Claims are invalid for failing to meet this written description requirement when a patentee claims an entire genus, but only adequately discloses

certain species within that genus. In this case, according to Plaintiff, the asserted '947 patent claims broadly cover an entire class of information that goes beyond the genus of “non-interactive electronic messages.” While an email message may be one form of non-interactive electronic message, and the '947 patent specification lists several additional items that could be considered, under some circumstances, non-interactive electronic messages, “digital formats, voice data, and DTMF tones,” the '947 patent describes no other types of electronic messages and does not disclose or even suggest that a search query or a click could be a non-interactive electronic message. Indeed, there is no basis to suggest that at the time of filing the '947 application the patent applicants possessed the invention of applying the claimed methods of automatic processing of an electronic message to internet users' search queries or clicks. The lack of any disclosure of search queries and clicks in the specification makes it clear that the applicants did not even contemplate that subject matter. In fact, the original provisional patent application was merely an article describing EZ Reader, a system for automatically responding to email. Accordingly, there are no legally sufficient evidentiary basis for a reasonable jury to find that the asserted claims of the '947 patent are valid and Defendants' are entitled to judgment as a matter of law.

II. LEGAL STANDARD FOR WRITTEN DESCRIPTION

A patent applicant is obligated to provide the public with a specification that “shall contain a written description of the invention.” 35 U.S.C. §112¶1. The “purpose of the written description requirement is to ‘ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.’” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 560 F.3d 1366, 1371 (Fed. Cir. March 2010) (*en banc*) (quoting *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345 (Fed. Cir. 2000)). As such, the written description requirement of 35 U.S.C. §112¶1 requires patent applicants to describe their invention in sufficient detail in the specification to show that they were in possession, at the time of filing, of what is later claimed. *Gentry Gallery, Inc. v.*

Berklinc Corp., 134 F.3d 1473, 1479 (Fed. Cir. 1998) (“To fulfill the written description requirement, the patent specification ‘must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.’”) (quoting *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989)); *Ariad*, 560 F.3d at 1371 (“[T]he specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed”). This obligation is an essential part of the fundamental *quid pro quo* of the patent statute that requires an applicant to disclose the invention to the public in exchange for a valid patent. *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005).

An applicant shows possession of the invention “by describing the invention, with all its claimed limitations.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). Thus, an applicant must use words, figures, diagrams, or formulas that fully set forth the claimed invention. *Id.* at 1572. While the exact claim terms need not be used, the specification must set forth an equivalent description of the claimed invention. *Id.*

Judgment as a matter of law is proper when “the facts and inferences point so strongly and overwhelmingly in favor of one party that the Court believe that reasonable men could not arrive at a contrary verdict.” *Wallace v. Methodist Hosp. Sys.*, 271 F.3d 212, 219 (5th Cir. 2001); *see also* Fed. R. Civ. P. 50(a) (judgment as a matter of law is appropriate if there is no legally sufficient basis to find for the party on that issue.)

III. ARGUMENT

A. Independent Claim 26 Is Invalid For Lack of Written Description of the “Non-Interactive Electronic Message” Limitation

The '947 patent generally describes interpreting non-interactive electronic messages, but describes in sufficient detail only one specific type of such message: an email. Any claim related to a non-interactive electronic message that is not also limited to email is invalid for a lack of written description.

Independent claim 26 is one such claim. Claim 26 requires, *inter alia*, that a “non-electronic message” is automatically processed and interpreted by a rule base and a case base knowledge engine. (White Decl. Ex. A 14:40-50) (Claim 26 “A method for automatically processing a *non-interactive electronic message* using a computer, comprising the steps of. . .”). 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. No. 369 at 9]. Based on this definition, Bright Response alleges that each of Yahoo!’s search systems meet this limitation by analyzing internet users’ search queries and clicks. (White Decl. Ex. B p. 2) (“The claims asserted against Yahoo . . . are directed to various claimed methods comprising automatically processing a non-interactive electronic message, for example user queries, searches, clicks, advertising requests”). Plaintiff also makes similar allegations as to Google. Bright Response’s allegations of infringement, however, are broader than the written description of the ’947 patent because the specification fails to describe internet users’ search queries and clicks as electronic messages.

1. The ’947 Patent Specification Describes Only One Kind of “Non-Interactive Electronic Message”: Email

While the ’947 patent specification generally discusses processing non-interactive electronic messages, the specification sufficiently describes only one kind of such message: an email. Figures 1, 2A, and 2B illustrate this point. In Figure 1 “messages,” which are depicted as physical pieces of mail, communicate between a domain server and a local sever. (White Decl. Ex. A Fig 1.) One of ordinary skill in the art would interpret these pictures as Electronic Mail (also known as “E-mail” or “email”). In Figure 2A the electronic message is specifically referred to as an “E-mail” drafted by a customer (step 100), and then processed by the recipient’s system (steps 102 and 104). (*Id.* Fig. 2A.) Figure 2B does not provide any specific label regarding the electronic message. (*Id.* Fig. 2B.) This figure, however, is a continuation of Figure 2A (*Id.* Ex. A 7:31-33), thus a person of ordinary skill in the art would recognize that Figure 2B’s reference to a “message” would be the same as Figure 2A’s reference to an “E-

mail.” These figures provide only one definition for the term electronic message, and that is an email.

Furthermore, the text of the specification confirms that the patentees’ provided only one specific description of the generic term “non-interactive electronic message.” (*See, e.g., Id.* 1:29-36 (disclosing an email as one type of message); 4:19-22 (disclosing email); 4:51-56 (same)). Not only does the specification describe electronic messages as email, the specification refers to electronic messages as emails at least 100 times.

2. The cursory discussion in the ’947 Patent Specification of Other Types of Electronic Messages is Insufficient to Support a Claim to the Entire Genus of “Non-Interactive Electronic Messages”

The ’947 patent specification makes only passing reference to other kinds of electronic messages; however, merely listing these other kinds of messages is insufficient to satisfy the written description requirement for claims directed broadly to the genus that includes all kinds of electronic messages. Plaintiff may point to the passage in the ’947 patent stating that an electronic message can be provided in different formats. (*Id.* 11:31-34) (“Indeed, the electronic message 11 may take on a variety of data formats including digital formats, voice data, dual tone multi-frequency (DTMF) tones, or the like.”). The ’947 patent’s only teaching of how to apply its claimed methods to these formats is a brief description of receiving and translating voice data into human readable text. *Id.* at 11:34-38, 50-57. This single sentence is the only reference to any type of electronic message other than an email. The inclusion of the voice data format was added to the specification only because a non-prosecuting attorney reviewed a draft of the patent and suggested that dictation software could covert voice inputs into text inputs and then be processed exactly like an email. (White Decl. Ex. C) (Cohen Deposition 30:8-1, May 20, 2009) (“I suggested one way to do it was to use dictation software to render the spoken word into written word and then it could be processed just as the proposed invention would process it.”). Mr. Cohen did not suggest any other types of electronic messages. (*Id.* at 39:14-24; 40:10-15.)

Therefore, listing voice data, accompanied by a passing description of how to convert that data into human readable text, is insufficient to support a claim to entire genus of every kind of non-interactive electronic message, much less search queries and clicks, which are not messages. A broad claim, such as claim 26, is invalid under the written description requirement when the “entirety of the specification clearly indicates that the invention is of a much narrower scope.” *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1323 (Fed. Cir. 2002); *see also Gentry Gallery*, 134 F.3d at 1480 (“[C]laims may be no broader than the supporting disclosure, and . . . a narrow disclosure will limit claim breadth”).

Not only is the brief description of digital formats, voice data, and DTMF tones insufficient to adequately disclose the entire genus of electronic messages, these data formats are also entirely distinct from the data contained in an internet users’ search queries and clicks. *Ariad*, 560 F.3d at 1372 (“the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the science or technology, [and] the predictability of the aspect at issue” are factors to determine the adequacy of disclosure of generic claims) (quoting *Capon v. Eshhar*, 418 F.3d 1349, 1359 (Fed. Cir. 2005)). Voice recognition/transcription and processing DTMF tones are distinct fields from searching on the internet. In the fields of voice recognition/transcription and processing DTMF tones, the system does not perform any processing until it receives the data from the source. A person having ordinary skill in the art would recognize that processing search queries and clicks operate in an entirely different manner. Search companies, such as Defendants’, first must scan the internet, select information from these web pages to store, rank the stored information, and then organize the stored information. Only after all of this processing can internet users’ search queries and clicks be processed by the system. Mr. Cohen, who suggested the addition of digital formats, voice data, and dual tone multi-frequency (DTMF) tones, did not associate these types of electronic messages to internet users’ search queries and clicks. (White Decl. Ex. C) (Cohen 69:1-9.)

In short, the brief description in the '947 patent specification of other types of electronic messages fails to adequately define the entire scope of the genus electronic message and cannot support a definition of internet users' search queries and clicks.

3. The '947 Patent Specification Does Not Describe an Internet Users' Search Queries or Clicks as "Non-Interactive Electronic Messages"

Despite the specification's voluminous disclosures that an email is an electronic message and detailed teachings of how to apply the claimed invention to email, there is no genuine dispute of fact that the '947 patent specification fails to disclose to a person of ordinary skill in the art that an electronic message could be internet user's search queries or clicks. *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2009), *aff'd en banc*, 560 F.3d 1366 (Fed. Cir. 2010) ("[T]he specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed"). Indeed, there is no mention of search queries or clicks anywhere in the '947 patent.

The focus in the '947 patent specification on email extends to the details by which the disclosed automatic interpretation is conducted. The specification explains that the preferred embodiment works by "first detecting combinations of prominent words (or text) and patterns of text within an electronic message." (White Decl. Ex. A 4:35-38) (parentheses in original.) That technique is understood by those of ordinary skill in the art to apply to emails, which contain words, text, and patterns of text. The specification, however, provides no explanation of how to apply that technique to "clicks," which contain no text at all, or to "queries," which may not contain any words, enough words to qualify as text, or enough text to establish text patterns.

Even if internet users' search queries or clicks could be construed to be electronic messages, there is no teaching in the '947 patent of how to apply the claimed invention to internet users' search queries or clicks. The written description requirement is not fulfilled by mere disclosure of a limitation. This disclosure must be accompanied by sufficient detail in the

specification to show that the applicants were in possession, at the time of filing, of what is later claimed. *Gentry Gallery*, 134 F.3d at 1479.

4. The Federal Circuit Holds Computer-Based Claims Invalid for Failure to Meet the Written Description Requirement when a Genus is Claimed, but Only One Species is Disclosed

When a patentee seeks to claim a general category (a genus), but only discloses in the specification one specific item in that category (a species), then that claim is invalid based on a failure to meet the written description requirement of 35 U.S.C. § 112¶1. The Federal Circuit analyzes computer claims under the same standard. In *LizardTech*, defendant Earth Resource Mapping argued that LizardTech’s asserted claim was invalid due to a failure to meet the written description requirement. *LizardTech*, 424 F.3d at 1340. The claims involved technology for digital image compression using a discrete wavelet transform. *Id.* at 1337. The specification described a “seamless” set of discrete wavelet transforms, whereby the computer program broke an image into a number of tiles and the invention addressed an issue in the prior art where the seams of those tiles contained errors. *Id.* at 1339. In one claim at issue, however, LizardTech failed to include the “seamless” limitation (a particular species of wavelet transforms). *Id.* The Federal Circuit determined that the claim encompassed all methods (the genus) of creating seamless discrete wavelet transforms. *Id.* at 1344. As such, the court determined that LizardTech was claiming inventions beyond the scope of its disclosure, and invalidated that claim for failure to meet the written description requirement. *Id.* at 1345-46. The court explained that the fact the specification only described one embodiment was not enough to invalidate the claim; rather, the one embodiment taken with the specification *as a whole* would not lead a person skilled in the art to believe that the patentee had possession of the full scope invention as described in the claims. *Id.* at 1345.

The present case includes the same deficiency found in *LizardTech*. The ’947 patent specification generally refers electronic messages, but sufficiently describes automatically interpreting only one species of electronic message: email. According to Bright Response,

however, claim 26 covers a significantly broader scope. Under Bright Response's interpretation, this claim covers any genus of electronic message, as well as things that go beyond this genus, including internet users' search queries and clicks. The fundamental disconnect between Bright Response's allegations regarding claim 26's expansive coverage of all electronic messages and the specific disclosure in the '947 specification of only one type of electronic message – an email – renders this claim invalid under the written description requirement of 35 U.S.C. §112¶1. Thus, even if search queries or clicks could be considered electronic messages, which Defendants' dispute, they are not supported by the specification, and Bright Response's overly broad interpretation of electronic message renders claim 26 invalid under 35 U.S.C. §112¶1.

B. The Remaining Asserted Claims are All Dependent on Claim 26, and are Therefore Also Invalid Due To A Lack Of Written Description

Dependent claims 31 and 33 are also invalid for lack of written description support. *LizardTech*, 424 F.3d at 1340-47 (claims that depend on independent claim that lacked written description support are invalid).

IV. CONCLUSION

Pursuant to Federal Rule of Civil Procedure 50, Defendants' hereby move the Court for entry of judgment as a matter of law that the asserted claims of the '947 patent are invalid under 35 U.S.C. § 112¶1.

Dated: August 7, 2010

APPROVED AS TO FORM AND
SUBSTANCE:

/s/ Amy H. Candido

Charles K. Verhoeven, CA Bar No. 170151
LEAD ATTORNEY

David A. Perlson, CA Bar No. 209502
Amy H. Candido, CA Bar No. 237829
Kevin A. Smith, CA Bar No. 250814
QUINN EMANUEL URQUHART &
SULLIVAN, LLP

50 California Street, 22nd Floor
San Francisco, California 94111
Telephone: (415) 875-6600
Facsimile: (415) 875-6700

Jennifer Parker Ainsworth
TX Bar No. 00784720
Wilson, Robertson & Cornelius, P.C.
P.O. Box 7339
Tyler, Texas 75711
Telephone: (903) 509-5000
Facsimile: (903) 509-5092
jainsworth@wilsonlawfirm.com

Counsel for Google Inc.

APPROVED AS TO FORM AND
SUBSTANCE:

/s/ Jennifer H. Doan

William C. Rooklidge
Email: rooklidge@howrey.com
State Bar No. 134483
Howrey, LLP
4 Park Plaza, Suite 1700
Irvine CA 92614-2559
Telephone: (949) 721-6900

Jason C. White
Email: whitej@howrey.com
State Bar No. 6238352
Howrey, LLP
321 N. Clark Street, Suite 3400
Chicago IL 60654
Telephone: (312) 595-1239

Brian A.E. Smith
Email: smithbrian@howrey.com
State Bar No. 188147
Howrey LLP
525 Market Street, Suite 3600
San Francisco CA 94105-2708
Telephone: (415) 848-4900

Jennifer Doan
Email: jdoan@haltondoan.com
State Bar No. 08809050
Joshua Reed Thane
Email: jthane@haltondoan.com
State Bar No. 24060713
Haltom & Doan
Crown Executive Center, Suite 100
6500 Summerhill Road
Texarkana TX 75503
Telephone: (903) 255-10002
Counsel for Yahoo! Inc.

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a). All other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing by certified mail, return receipt requested, on August 7, 2010.

/s/ Jennifer H. Doan
Jennifer H. Doan