

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 FOR JUDGMENT AS A MATTER OF LAW
ON WRITTEN DESCRIPTION AND INVENTORSHIP**

Plaintiff Bright Response, LLC (“Bright Response”) files this Motion for Judgment as a matter of law under Rule 50(a) on written description and inventorship. The Court expressly permitted the parties to file written submissions to supplement what was argued in Court before the case was submitted to the jury.¹ Bright Response therefore files this written motion, which reiterates and supplements its grounds for judgment as a matter of law made on the record in open court on Saturday, August 7, 2010. *See* Transcript (“Trans.”) (8/7/10 a.m.) at 4:2-5:1; Trans. (8/6/10) at 175:11-16, 21-25; 176:1 (noting parties could supplement oral motions with later written submissions; no new grounds or arguments permitted).

I. INTRODUCTION AND SUMMARY

Defendants’ written description and inventorship arguments at trial were afterthoughts at best. Bright Response therefore requested, before the jury received the Court’s charge, that the Court find the evidence insufficient under Rule 50(a), precluding submission of those issues to

¹ Accordingly, Bright Response objects to each of the Defendants’ “supplemental” pre-verdict Motions for JMOL insofar as their scope exceeds the issues presented in their in-Court rule 50(a) JMOL motions. The Court expressly prohibited any new arguments or grounds when it allowed the parties to file written submissions.

the jury. In fact, proving again that Defendants did not have this issue on their radar screen for their trial presentations, Defendants almost neglected the issue entirely when the Court heard brief oral motions for JMOL. *See* Trans. (8/7/10 p.m.) at 22-23 (“MR. ROOKLIDGE: And second, Mr. Perlson reminds me that the Defendants need to make a judgment as -- a motion for judgment as a matter of law to make a pre-verdict Motion for JMOL, on the written description defense.”). The Court nevertheless denied Bright Response’s Motion for JMOL on written description and inventorship, and Bright Response now reiterates those arguments demonstrating that no jury question was presented.²

II. ARGUMENT

A. No Evidence To Justify Allowing The Jury To Decide Written Description.

Written description is an invalidity defense that requires a patent applicant to “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the [claimed] invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). As with all invalidity defenses, it must be proved by clear and convincing evidence. *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364 (Fed. Cir. 2003). In addition to the lack of evidence to justify sending this issue to the jury—as Bright Response urged just before the Court charged the jury—the notion that Defendants are entitled to judgment as a matter of law on this is wrong as a matter of law as well. *See* Dkt. No. 615 (Defendants’ JMOL as to written description).

² Bright Response raised these same written description argument in its (i) Response’s response to Yahoo’s Motion for Summary Judgment on Written Description; and (ii) Bright Response’s Cross-Motion on Written Description. Dkt. No. 420.

As a testament to the insufficient evidence, Yahoo counsel admitted in closing arguments that there was *not* “a lot of discussion” in the record. Yahoo attempted to cure its evidentiary lacunae by attorney argument in closing, while admitting the record was threadbare:

The next issue is written description. And let's take a look at the Court's -- the Court's instruction that will be provided to you of the written description requirement, *because there hasn't been a lot of discussion about the written description requirement* until yesterday's testimony. So *this is something that you really haven't rolled up your sleeves and gotten into*.

Transcript (8/ 7/10 a.m.) at 97:12-19 (emphasis added). Counsel cannot cure the evidentiary omissions after the fact. Attorney argument in closing is not evidence on which a JMOL can be decided. *See Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1380 (Fed. Cir. 2009) (emphasizing that “unsworn attorney argument is not evidence”).

The jury had no chance to “roll up their sleeves,” as counsel argued, because Defendants neglected this theory throughout its *entire* case-in-chief, failing to meet their burden of clear and convincing evidence. Indeed, their own invalidity expert, Dr. Branting, failed to provide testimony regarding written description at all. Nor could he have, as his expert testimony was limited to his expert report. As Bright Response raised in its challenge to Dr. Branting on this point in its *Daubert*/Rule 702 Motion (Dkt. No. 527), his report does not provide the requisite opinion to support a finding of lack of written description—the totality of his opinions compromise a single conclusory statement.³

³ As Bright Response argued in its Motion to Strike:

“Of the 286 paragraphs that comprise Dr. Branting's report, only two of the paragraphs address his opinion regarding the sufficiency of the written description of the '947 patent. These paragraphs have been reproduced in full below:

276. I have been informed by counsel that to meet the written description requirement, an application must describe an invention, and do so in sufficient detail, that one skilled in the art can clearly conclude that the inventor invented the full scope of the claimed invention as of the filing date sought. I understand the question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification.

The evidence not only did not improve at trial – it was less. Not one mention of the written description requirement appears in the entire examination of Dr. Branting. *See* Trans. (8/6/10 am) at 78:3-116:10. To the contrary, in Plaintiff’s case-in-chief, the unrebutted evidence from Dr. Rhyne is that in his opinion, *one of ordinary skill in the art would understand the scope of the patent to not be limited to e-mail*. *See* Trans. (8/6/10 p.m.) at 163:17-21. Dr. Rhyne’s testimony confirms what is already in evidence and apparent on the face of the patent itself and the provisional application: the ‘947 patent is not limited to email.

1. The Provisional Applications and Rice Patent Disclosures Establish a Compliant Written Description.

The disclosures of the Rice patent provisional and patent applications convey to those of ordinary skill in the art that, as of the filing date, the inventor had possession of the claimed subject matter, which includes application of the invention to responding to non-interactive electronic messages of various digital formats, including but not limited to email. For example, the Rice patent:

277. I am of the opinion that at the time the ‘947 patent was filed, one of ordinary skill in the art would not understand that the specification described in sufficient detail an invention to receive, interpret, and retrieve one or more responses to an Internet search query, an Internet user’s click or a web page, which I understand is what Plaintiff contends meets the noninteractive electronic message limitation in the accused products.

.... Paragraph 276 describes Dr. Branting’s understanding of the relevant law. Therefore, the full extent of Dr. Branting factual analysis regarding written description can be found in paragraph 277 above.

As these paragraphs conclusively establish, Dr. Branting offers no factual underpinnings for his opinion. Aside from his conclusion regarding how one of ordinary skill in the art would view the written description of the "non-interactive electronic message" element of the asserted claims, Dr. Branting provides no citation to the specification of the ‘947 patent or the provisional applications to which the ‘947 patent claims priority. Dr. Branting provides no analysis describing what portions of the written description of the ‘947 patent would lead one of ordinary skill in the art to understand that the invention in the ‘947 patent would not apply broadly to all non-interactive electronic messages. Indeed, Dr. Branting’s statement is barely more than a mere statement “there is no written description” as Section 112 requires or “the claims asserted are invalid for lack of written description/under Section 112.” As in *Neutrino* [*Neutrino Dev. Corp. v. Sonosite, Inc.*, 410 F. Supp. 2d 529, 548 (S.D. Tex. 2006)], the Court should find Dr. Branting’s bare conclusion inadmissible and strike Dr. Branting’s invalidity opinion addressing 35 U.S.C. § 112, ¶ 1.

- Describes electronic messages including email and a variety of digital formats: “The electronic message 11 is preferably an E--mail message in ASCII text data format, it being understood that the invention is not so limited. 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.” PX1 (Rice patent) at 11:28-34.
- Expressly discloses a system to manage and respond to electronic messages, not limited to email. *See id.* at 4:10-13 (“It is preferred that the electronic messages 11 are E-mail messages and are so referred to herein, it being understood, however, that other types of electronic messages 11 are contemplated as being within the scope of the invention.”).
- Describes issues relating to potential fraud and customer inquiries relating to “promotional content” and “product sales.” *Id.* at 10:1-5, 10:10-13.
- Discloses the problem of businesses face expanding access to their products and services by using “the Internet and other on-line information channels”: “Many businesses have recently sought to expand access to their products and services by using the Internet and other on-line information channels to reach current and potential customers. Indeed, marketing campaigns which solicit customers over on-line information channels using electronic messages are becoming increasingly popular. These marketing campaigns have become very successful and often customers also contact a business concern using electronic messages (for example, E-mail) to request, among other things, product information, account status, and access to products and services.” *Id.* at 1:26-36.
- Addresses the problems experienced by businesses “in adapting their business practices to respond to large volumes of incoming electronic messages transmitted over a variety of communications channels (*e.g.*, the Internet, telecommunications channels, and the like).” *Id.* at 1:37-41.

The ‘494 provisional application also makes the necessary disclosures, disclosing:

- A system that addresses businesses seeking to “expand access to their products and services through the Internet and other online channels” and “to provide electronic banking services using phone and personal computer technology” and the “related problems of responding quickly and cost-effectively to a high volume of customer queries (PX45 (provisional ‘494) at BR000083).
- Consideration of enhancement to “add business knowledge for other business areas who choose to take advantage of World Wide Web communication with customers” (*id.* at BR000092)).

- Four separate references involving generally “routing of electronic forms” and “online delivery and the information superhighway.” (*id.* at BR000093).
- Description of the invention as including “receiving a fixed data file”; “interpreting the meaning of the data file using case based and rule based reasoning”; “categorizing the data file as being able to be responded to automatically or requiring a human response”; and “receiving E-mail and formulating an E-mail response be drafted.” (*id.* at BR000094).
- Description of the invention as including: “receiving a fixed data file”; “interpreting the meaning of the data file using case based and rule based reasoning”; and “formulating an automatic response to the data file consistent with its meaning” (*id.* at BR000094).

The other provisional application of the '947 patent (No. 60-042,656) discloses a system which included source code classes that could be applied to a range of electronic messages. *See, e.g.,* PX 44 ('656 provisional) at BR000036, 39-40. The '656 application also described categories and responses including sales and promotional materials. *See id.* at BR000041-42. Yet on the most critical factual issue of all—whether these discloses in total are adequate to show that the person of ordinary skill in the art would understand the inventors invented what was claimed at the time—the sole evidence is from Dr. Rhyne and in Bright Response’s favor.

2. Defendants’ Last-Minute Attempt at Eliciting Evidence Misses The Point And Does Not Refute Dr. Rhyne’s Opinion.

The only evidence that Defendants have to support their ill-chosen defense was, at best, a harried last-minute effort during Bright Response’s *rebuttal* case and only after Defendants closed their case in chief. They attempted to do so through a line of questioning as to whether hypertext transfer protocol (“http”) is explicitly disclosed in the '947 patent. *E.g.,* Trans (8/6/10) at 158:1-19. This is insufficient as a matter of law to answer the legal question that the written description requirement comprises: whether the disclosures of the Rice patent provisional and patent applications convey to those of ordinary skill in the art that as of the filing date the inventor had possession of the claimed subject matter.

The *only* testimony related to this question is from Plaintiff's expert Dr. Rhyne, and it refutes what negligible inapposite evidence Defendants attempted to elicit in the final minutes of their case. Dr. Rhyne answered to show that one of ordinary skill in the art at the time of the application would have recognized that the inventors of the Rice patent invented what is claimed—a system that, among other things, receives, interprets, and responds to non-interactive electronic messages *not limited to email*. See Trans (8/6/10 p.m.) at 163:17-21. Dr. Rhyne based his opinion on at least two portions of the patent specification that explicitly say that the invention described in the patent is not limited to email. Trans. (8/6/10 pm) at 163:22-164:3; see *also id.* at 163:5-13.

When the provisional applications and the patent itself state on their face they are not aimed solely at email, it is incorrect as a matter of law to allow the written description defense to proceed for the jury's consideration. See *Honeywell Int'l, Inc. v. U.S.*, 609 F.3d 1292, 1301 (Fed. Cir. 2010) (“While original figure 3 may have disclosed a CRT, *there is no reason, in light of the other statements in the specification, to limit the disclosure to only CRTs*. For these reasons, the Court of Federal Claims clearly erred in finding that the original application's disclosure was limited to CRT displays and that claim 2 of the '14 patent is invalid under the written description requirement.”) (emphasis added). Therefore, the Court should have granted Bright Response's JMOL request to find that evidence insufficient to submit this defense to the jury.

B. No Evidence to Justify Allowing The Jury to Decide Incorrect Inventorship.

“An assertion of incorrect inventorship must be based on facts proved by clear and convincing, corroborated evidence.” *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed.

Cir. 1998) (citing *Hess*, 106 F.3d at 980).⁴ As the Federal Circuit noted in *C.R. Bard*, determining the question of legal inventorship is a difficult task—“one of the most difficult issues in American patent law.” *Id.* at 1352 (citing *Jamesbury Corp. v. United States*, 518 F.2d 1384, 1396 (Ct. Cl. 1975)). Because of this difficulty, 35 U.S.C. § 256 “permits correction of the designated inventorship of a patent when an error was made without deceptive intent.” *Id.* at 1352-53.

There is no evidence to justify sending this issue to the jury—as Bright Response urged just before the Court charged the jury with that issue. *See* Trans. at 4-5 (8/7/10 a.m.). Here too, as with written description, Defendants made little to no effort to present a case of incorrect inventorship. As requested pursuant to Bright Response’s August 7, 2010 motion for JMOL, the Court should have granted that motion and not sent the issue to the jury. The only evidence that Defendants’ presented to the jury was the testimony of Ms. Rice that she did not know what Mr. Angotti contributed to the patent. There has never been a dispute as to whether Ms. Hsu is an inventor. The other inventors that testified by deposition said that they were inventors. Trans. (8/6/10 pm) at 6:14-17 (Piccolo); Trans. (8/6/10 pm) at 107:22-108:18 (deposition testimony from Fred Cohen concerning his input on the invention). And Mr. Angotti testified at a portion of deposition, that was not played but read into the record, that he did in fact have input into the invention claimed in the '947 patent. *See* Trans. (8/6/10 p.m.) at 18-19:2. Lastly, there is no dispute, nor was there any factual dispute at trial, as to whether Ms. Julie Hsu is an inventor. As a result, Defendants failed to meet their burden of showing by clear and convincing evidence that

⁴ Even if there were an affirmative finding of incorrect inventorship, a patentee may invoke corrective measures. *See Checkpoint Systems, Inc. v. All-Tag Sec. S.A.*, 412 F.3d 1331, 1340 (Fed. Cir. 2005) (“Then, “[u]pon such a finding of incorrect inventorship, a patentee may invoke section 256 to save the patent from invalidity.” Thus, after it is determined that a patent’s inventorship is incorrect, “the patentee must then be given an opportunity to correct inventorship pursuant to that section.””).

there was incorrect inventorship here. Judgment as a matter of law pursuant to Federal Rules of Civil Procedure, Rule 50(a), was appropriate on this issue, and the Court should not allow the jury to decide the issue with gaps in the evidence that preclude that defense as a matter of law.

III. CONCLUSION

The jury is entitled to decide only those questions on which there is adequate factual content to present a question of fact. No such adequate factual foundation exists on this record. The jury did not have before it the quantum of evidence to present a conflicting question of fact. Accordingly, the Court should grant this motion pursuant to Rule 50(a), and enter judgment as a matter of law that the Rice patent is not invalid for lack of written description or incorrect inventorship.

Dated: August 9, 2010

Respectfully submitted,

By: /s/ Elizabeth A. Wiley
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CERTIFICATE OF SERVICE

I certify that counsel of record who are deemed to have consented to electronic service are being served this 9th day of August, 2010, with a copy of this document via the Court's CM/ECF systems per Local Rule CV-5(a)(3). Any other counsel will be served electronic mail, facsimile, overnight delivery and/or First Class Mail on this date.

\s\ Elizabeth A. Wiley
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