

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

ALOFT MEDIA, LLC,

Plaintiff,

v.

ORACLE CORPORATION, ET AL.,

Defendants.

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Civil Action No. 6:09-CV-304
JURY TRIAL DEMANDED

**DEFENDANTS' MOTION FOR SUMMARY JUDGMENT OF INVALIDITY OF THE
ASSERTED CLAIMS OF UNITED STATES PATENT NOS. 7,499,898 AND 7,593,910
FOR INDEFINITENESS**

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I. INTRODUCTION

All of the claims asserted by Plaintiff are invalid under 35 U.S.C. § 112 because each contains terms, either expressly or by incorporation, that are indefinite. Specifically, the following terms are indefinite: “potential feasible hybrid theme,” “computer code for processing,” and “decision logic” and “logic related to decision making” (“the decision terms”). Each of these terms, read in the context of the asserted patents, fails to provide the public with notice of the patentee’s right to exclude.

The term “potential feasible hybrid theme” is indefinite because it is composed of insolubly ambiguous components and is subjective as a whole, and because the patents fail to disclose any objective standard for determining the scope of the invention. Potential infringers could not look to the patent to determine what would constitute a “potential feasible hybrid theme.”

The term “computer code for processing” is indefinite because it claims purely functional limitations, yet fails to disclose a specific algorithm for performing the “processing” function, as required by the Federal Circuit. By failing to bound the scope of the claimed method for “processing” with sufficient explanatory limitations, the patentee essentially attempts to preempt every method for “processing” information using computer code.

The two “decision terms” are indefinite because they are based on the purely subjective opinions of the users and authors of the software, and because no objective standard is provided to otherwise delineate the scope of the invention. One of skill in the art is left to speculate whether a “user” would find something valuable, would choose to confirm or modify certain information or outputs, or would envision a certain range of possibilities, thus rendering the

terms indefinite. For the foregoing reasons, Defendants respectfully request that this Court grant the instant motion and hold the asserted claims invalid as indefinite under § 112.

II. ISSUES PRESENTED

This Motion presents three issues of claim indefiniteness for the Court's determination.

1) Under 35 U.S.C. § 112, whether the claim term “potential feasible hybrid theme” is indefinite where the term is composed of insolubly ambiguous components, is subjective as a whole, and the patent fails to disclose any objective standard that would allow one of skill in the art to determine the scope of the claims.

2) Under 35 U.S.C. § 112, ¶ 6, whether the claim term “computer code for processing” is indefinite where the patent fails to disclose a specific algorithm as structure for performing the claimed “processing” function. Alternatively, under 35 U.S.C. § 112, ¶ 2, whether the claim term “computer code for processing” is indefinite where the patent fails to disclose a specific algorithm to bound the scope of the claimed “processing” element.

3) Under 35 U.S.C. § 112, whether the claim terms “decision logic” and “logic for decision making” are indefinite where the terms are subjective, and the patent fails to disclose any objective standard that would allow one of skill in the art to determine the scope of the claims.

III. BRIEF SUMMARY OF THE PATENTED TECHNOLOGY

The patents-at-issue are directed to a computer software program for decision-making. More specifically, the title of both patents is “Decision-Making System, Method and Computer Program Product,” and the field of the invention is “a computer-based platform which supports a decision making process.” (‘898 Patent [hereinafter “Ex. A”], 1:17-19.) The purported inventive element of the claimed inventions, however, is not a decision-making process itself. As stated in the specification's Background of the Invention, decision-making processes were

known as far back as the 18th century when Benjamin Franklin coined a process using decision alternatives, and many more solutions surfaced thereafter, including the Dialogue Decision Process (“DDP”). (Ex. A, ‘898 Patent, 1:22-56.) The DDP is a decision making process that was known in the prior art and includes the steps of framing, alternatives, analysis, and connection. The stated motivation for the patents was to provide a computer implementation of DDP. (Ex. A, ‘898 Patent, 2:1-3.)

In trying to narrow the scope of the claims, the patentee limited the claims to certain field of use applications, which is not enough under the current law to overcome a Section 101 rejection, and Defendants’ co-pending motion for summary judgment for non-patentable subject matter addresses this issue under the current *In re Bilski* regime. For example, Claim 14 of the ‘898 Patent recites that the claimed executed application is at least one of “a real estate-related application, a medical-related application, a corporate-related application, a product supply-related application, a service supply-related application, or a financial-related application.” (Ex. A, ‘898 Patent, 14:60-65.) The specification, however, does not provide any computer code or algorithms for these field of use applications, or any other applications. Neither does the specification provide any description of the actual software programs that process the information related to the claimed applications.

IV. STATEMENT OF FACTS

- 1) Plaintiff Aloft Media, LLC (“Aloft” or “Plaintiff”) is the assignee of both patents at issue in the instant action.
- 2) United States Patent 7,499,898 B1 (“the ‘898 Patent”) was filed July 25, 2007, and issued March 3, 2009. (Ex. A.)
- 3) United States Patent 7,593,910 B1 (“the ‘910 Patent”) was filed June 26, 2007, and issued September 22, 2009. (‘910 Patent [hereinafter “Ex. B”].)
- 4) Plaintiff alleges that Halliburton infringes Claims 110, 111, 113, 114, 115, 117, 118, 119, 120, 121, 122, 128, 129, 135, 139, 140, 141, 157, 159, 161, 163, 166, 172, 176, 177, 209,

326, 335, 346, 363, 365, 366, and 368 of the ‘910 Patent, and Claims 14, 15, 17, 18, 19, 20, 22, 35, 41, 42, 43, 44, 45, 57, and 63 of the ‘898 Patent (collectively, “the asserted claims”).

- 5) The asserted patents are both directed at computer software for performing logic related to decision making. The asserted patents both have the same title: “Decision-Making System, Method, and Computer Program Product.” (Exs. A, B.)
- 6) Only two of the asserted claims are independent: Claim 14 of the ‘898 Patent and Claim 110 of the ‘910 Patent. The asserted independent claims read as follows:

Claim 110 of the ‘910 Patent	Claim 14 of the ‘898 Patent
A computer program product embodied on a tangible computer readable medium, comprising: computer code capable of performing logic related to decision-making;	A computer program product embodied on a tangible computer readable medium, comprising, comprising: computer code for causing execution of an application capable of performing decision logic,
the computer code belonging to an application which is a real estate-related application, a medical-related application, a corporate-related application, a product supply-related application, a service supply-related application, or a financial-related application;	the application including at least one application that is a real estate-related application, a medical-related application, a corporate-related application, a product supply-related application, a service supply-related application, or a financial-related application;
computer code for retrieving first information from a storage;	computer code for retrieving first information from a database, per the application;
computer code for receiving second information from a user utilizing a user interface;	computer code for receiving second information from a user utilizing a user interface, per the application;
computer code for processing the first information and the second information;	computer code for processing the first information and the second information utilizing the decision logic;
computer code for generating a display, the display including at least one display that is a tornado diagram, a decision sensitivity display, a decision hierarchy display, an influence diagram, or a potential feasible hybrid theme.	computer code for generating at least two of: a tornado diagram, a decision sensitivity display, a decision hierarchy display, an influence diagram, and a potential feasible hybrid theme.

- 7) Each of the independent asserted claims is directed to computer software.
- 8) The disputed terms subject to this motion are “decision logic,” “logic related to decision making,” “computer code for processing,” and “potential feasible hybrid theme.”
- 9) All of the remaining asserted claims are dependent on the asserted independent claim of its respective patent. Each asserted dependent claim incorporates all of the limitations of the independent claim from which it depends and any intervening claims.

- 10) The asserted patents stem from the same family of patents and thus share a common specification.
- 11) The asserted claims do not recite computer source code.
- 12) The asserted patents' specification does not contain computer source code.

V. STATEMENT OF THE LAW

To be valid, 35 U.S.C. § 112, ¶ 2 requires that patent claims be definite, such that they particularly point out and distinctly claim the subject matter that the applicant regards as his invention. *Halliburton Energy Servs., Inc., v. M-I LLC*, 514 F.3d 1244, 1249 (Fed. Cir. 2008). The requirements of particularity and distinctness are met only when the claims “clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise.” *Id.* The purpose of the definiteness requirement is to ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee’s right to exclude. *Honeywell Int’l, Inc. v. Int’l Trade Comm’n*, 341 F.3d 1332, 1338 (Fed. Cir. 2003).

Claims are indefinite when a person of ordinary skill in the art cannot determine the bounds of the claims, *i.e.* when the claims are insolubly ambiguous. *Halliburton*, 415 F.3d at 1249. When the meaning of the claim is in doubt, especially when there is close prior art, the claim is properly declared invalid. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1218 (Fed. Cir. 1991). A claim is also properly held invalid for indefiniteness when it uses a subjective term and the specification fails to supply the standard for measuring the scope of the term. *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350, 1352-53 (Fed. Cir. 2005).

A party seeking to invalidate a claim under 35 U.S.C. § 112, ¶ 2, as indefinite must show by clear and convincing evidence that one of skill in the art would not understand the scope of

the claim when read in light of the specification. *Intellectual Prop. Dev., Inc. v. UA-Colombia Cablevision of Westchester, Inc.*, 336 F.3d 1308, 1319 (Fed. Cir. 2003).

A claim term deemed a means-plus-function limitation is indefinite if the specification does not disclose sufficient structure such that one skilled in the art would understand the structure as adequate to perform the claimed function. *Id.* Where the specification merely restates that software performs the recited function, the means-plus-function claim may be indefinite. *Finisar Corp. v. DirecTV Grp., Inc.*, 416 F.Supp. 2d 512, 518-19 (E.D. Tex. 2006), *aff'd*, 523 F.3d 1323, 1340-41 (Fed. Cir. 2008). “In a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999). Disclosure of a general purpose computer without a corresponding algorithm renders the means-plus-function claim indefinite. *Aristocrat Techs. Austl. Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1337-38 (Fed. Cir. 2008).

Summary judgment should be rendered when there is no issue of material fact and the movant is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). In rendering that judgment, the Court may rely on intrinsic and extrinsic evidence, such as expert testimony. *Datamize*, 417 F.3d at 1348. Indefiniteness is appropriately decided on summary judgment during the claim construction phase because “indefiniteness is a legal conclusion that is drawn from the court’s performance of its duty as the construer of patent claims.” *Datamize*, 417 F.3d at 1347; *Atmel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1379 (Fed. Cir. 1999) (stating that the indefiniteness analysis “is inextricably intertwined with claim construction”); *Halliburton Energy Servs., Inc. v. M-I LLC*, 456 F. Supp. 2d 811 (E.D. Tex. 2006), *aff’d*, 514

F.3d at 1244 (granting summary judgment of invalidity for indefiniteness under § 112, ¶ 2). Because indefiniteness, like claim construction in general, is a pure question of law, it does not turn on an underlying factual dispute and does not require the Court to credit certain evidence over other evidence or make factual evidentiary findings. *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1376 (Fed. Cir. 2001). Rather, the Court looks to the evidence to assist in its construction of the written document. *Id.*

VI. ARGUMENTS

A. The claim term “potential feasible hybrid theme” is indefinite.

The phrase “potential feasible hybrid theme” is insolubly ambiguous and impossible to construe in the context of the asserted patents. Indeed, the phrase “hybrid theme” itself is hopelessly ambiguous, and that ambiguity is heightened by the addition of “feasible” and “potential.” Even if one were able to somehow discern the meaning of a “hybrid theme,” one would still be left with the puzzling “potential” and “feasible” limitations.

The term “hybrid theme,” which appears in every asserted independent claim, is left undefined by the patent. (Declaration of Dr. James S. Dyer [hereinafter “Ex. D”], ¶ 11.) The closest one might come to a definition is that given for a “hybrid strategy,” which is said to somehow combine “the most valuable decisions” from alternative strategies. (Ex. A, ‘898 Patent, 12:51-60.) But whatever a “theme” is, it is certain that a “theme” is not a “strategy” for the simple reason that the claims repeatedly use both terms, which creates a presumption that the two terms have different meanings.¹ See *Tandon Corp. v. Int’l Trade Comm’n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987) (“There is presumed to be a difference in meaning and scope when

¹ For example, definitions of “theme” include “a topic of discourse or discussion; the subject of an artistic work; an implicit or recurrent idea; a motif.” (The American Heritage Dictionary (3d. ed. 1994) [hereinafter “Ex. C”], 837.) None of these definitions implicates a “strategy.”

different words or phrases are used in separate claims.”) That presumption becomes a certainty in light of Claim 54 in the ‘898 Patent, in which “the feasible hybrid theme includes a hybrid strategy,” and Claim 84 of the ‘910 Patent, in which “the feasible hybrid theme is associated with at least one strategy.” Thus, whatever a “theme” is, it cannot possibly be just another name for a “strategy.”

In addition to the vagueness of the word “theme” as recited in the claims, the specification provides no guidance to the public in determining any bounds for “hybrid,” other than that a “hybrid strategy” somehow combines “the most valuable” decisions as determined by the user. (Ex. A, ‘898 Patent, 12:51-60.) The term “hybrid” in these patents is wholly subjective. (Ex. D, Dyer Dec., ¶ 12.) The patent provides no objective criteria by which the limits of what is considered “most valuable” can be determined. For example, the claims of the patent (and the specification) omit any description of what variables, ranges, comparisons, calculations, formulas, mathematical principles, or computer steps can accomplish the determination of a “most valuable” “hybrid strategy.” A person of ordinary skill in the art would have had no objective basis by which to implement a process for creating a “hybrid.” (Ex. D, Dyer Dec., ¶ 12.)

Apart from telling the public that a “theme” is not a “strategy,” the patent provides no guidance in determining the meaning of “theme” in the context of these claims. (Ex. D, Dyer Dec., ¶ 11.) The ordinary meaning of “theme” – subject or topic – similarly provides no help.² Apart from being used frequently in the claims, the word “theme” occurs in only one other place in the patent, Figure 4a, where one finds the following phrase: “User confirmation or modification of Strategy Names or Themes and corresponding alternatives for all of the

² *Supra* note 1.

decisions that comprise the strategy.” (Ex. A, ‘898 Patent, Fig. 4a.) At first glance, one might be tempted to conclude from that cryptic note that a “theme” is a “strategy name.” But such is not possible because a “strategy name” in the patent is simply a straightforward English phrase, such as “No Participation,” that is determined and assigned by a user (Ex. A, ‘898 Patent, Fig. 8c), whereas a “hybrid theme,” whatever it is, is something that is generated by computer code. (Ex. A, ‘898 Patent, Claim 14.) A “theme,” therefore, simply cannot be a “strategy name.”

For whatever reason, the patentee used the word “theme” throughout the claims, yet the specification recites the word only once and provides no definition or guidance that would assist the public in determining its meaning, as is required by § 112, ¶ 2. *Honeywell*, 341 F.3d at 1338-39. The patentee could have used other words, like “strategy,” “policy,” or “tactic” – each of which the patent specification describes with more detail – but the patentee did not. (Ex. A, ‘898 Patent, 11:1-15; Ex. D, Dyer Dec., ¶ 11.) Instead, the patentee chose the hopelessly ambiguous word “theme,” leaving the public to guess its meaning in these claims, with the only clues being that it is something other than a strategy (Ex. A, ‘898 Patent, Claim 54) generated by computer code (Ex. A, ‘898 Patent, Claim 14) and able to be displayed (Ex. B, ‘910 Patent, Claim 110). The patentee is now seeking to benefit from that intentional ambiguity. *Halliburton*, 514 F.3d at 1254.

Assuming that one of skill in the art were to somehow unravel the “hybrid theme” mystery, he or she would then be presented with two additional conundrums – the scope of the terms “feasible” and “potential.” The asserted claims do not simply require any “hybrid theme” – they require a “*potential feasible* hybrid theme.” First, the word “feasible” is like the “most valuable” phrase, a subjective term for which the patent provides no objective standard.

Datamize, 417 F.3d at 1352. Indeed, the term “feasible” appears only in the claims. Assigning the ordinary meaning for the term, one is left with a “hybrid strategy” that “is capable of being accomplished or possible” – which adds yet another layer of subjectivity and ambiguity to “hybrid theme.”³

The term “potential” further compounds the problem. That word is used twice in the patent specification – neither time with regard to feasible hybrid themes. (Ex. A, ‘898 Patent, 1:45-46 (“potential outcomes”); 6:14 (“potential domain”).) All that the ordinary meaning of the term “potential” conveys in the context of “potential feasible hybrid theme” is that the claims do not actually require a “feasible hybrid theme” but rather require something that has the “capacity to become or develop into” a “feasible hybrid theme”⁴ – that is, a hybrid theme that might work or might not work. (Ex. D, Dyer Dec., ¶ 13.) Again, the patent wholly omits any description of what variables, ranges, comparisons, calculations, formulas, mathematical principles, or computer-based steps to determine when any “hybrid theme” is both “feasible” and “potential.” (Ex. D, Dyer Dec., ¶ 13.) Because the asserted patents provide no guidance in understanding the meaning of “feasible hybrid theme,” it is impossible for the public to know what might be or develop into a “feasible hybrid theme.” (Ex. D, Dyer Dec., ¶ 13.)

In short, the term “potential feasible hybrid theme” cannot be defined with sufficient particularity to meaningfully apprise a person of ordinary skill in the art of the precise claim scope. Therefore, the Court should rule that the term is indefinite, rendering all of the asserted claims invalid.

³ Definition of “feasible” includes “capable of being accomplished or brought about; possible.” (Ex. C, Dictionary, 308.)

⁴ Definition of “potential” includes “capable of being but not yet in existence; latent; capacity for growth, development, or coming into being.” (Ex. C, Dictionary, 648.)

B. The claim terms “decision logic” and “logic related to decision making” are indefinite.

The '898 and '910 Patents asserted in this case both contain disputed claim terms that contain the word “decision” (the “decision terms”). Specifically, the disputed decision terms are “decision logic,” found in independent Claim 14 of the '898 Patent, and “logic related to decision making,” found in independent Claim 110 of the '910 Patent. The disputed “decision” terms are indefinite and will rise and fall together because they are all directed to making a decision, yet fail to inform one of ordinary skill in the art how to make a decision.

In an attempt to understand the decision terms, a person of ordinary skill in the art could view the terms broadly or narrowly. (Ex. D, Dyer Dec., ¶ 15.) If viewed broadly, the terms are unbounded and could include virtually any type of decision making process. (Ex. D, Dyer Dec., ¶ 15.) Yet, Aloft is not entitled to claim every method for making a decision. To be entitled to exclude others from using a certain methodology of making a decision, the patentee must sufficiently describe the method so that one of skill in the art could determine the scope of the claims. *Harrah's Entm't, Inc. v. Station Casinos, Inc.*, 321 F.Supp.2d 1173, 1179-80 (D. Nev. 2004). Under this broad view, a person of ordinary skill in the art would have no basis for determining any bounds for the decision terms. (Ex. D, Dyer Dec., ¶ 15.)

One of skill in the art could also view the decision terms narrowly. (Ex. D, Dyer Dec., ¶ 16.) Under a narrow view, the decision terms would refer to the Dialogue Decision Process (“DDP”) that is discussed throughout the patent specification and the figures. (Ex. D, Dyer Dec., ¶ 16.) This view is supported by the motivation for the invention given in the patent: “a need for a computer-implemented method which may be utilized for implementing DDP in different environments in a universal manner.” (Ex. A, '898 Patent, 2:1-3; Ex. D, ¶ 16.)

1. The Only Methodology Described in the Specification Relies on Subjective Criteria

DDP is the only specific methodology described in the specification, and it relies on subjective criteria, with one if its four steps being wholly subjective. (Ex. D, ¶ 17.) A decision is the passing of judgment on an issue. (Ex. C, Dictionary, 223.) Decision making is a function of the human mind based on subjective criteria. The plain meaning of the decision terms inherently encompasses purely subjective criteria; the patents' specification does not attempt to deviate from this plain meaning, nor do Plaintiff's proposed constructions. (Plaintiff's Opening Brief Regarding Claim Construction (No. 162) (filed Nov. 23, 2010) [hereinafter "Plt's Markman Br."].)

The scope of claim language cannot "depend solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention." *Datamize*, 417 F.3d at 1350. This would allow a patentee to benefit from ambiguity, rather than requiring a patentee to give proper notice of the scope of the claims. *Halliburton*, 514 F.3d at 1254. The patents' specification itself describes the subjectivity on which the claimed inventions depend. For example, the patent describes the intuitive and idiosyncratic nature of "decisions" by categorizing those, at least in part, as "decisions of immediate interest" ("strategy or strategic decisions or just decisions") and "decisions that can be deferred until later" ("tactics"). (Ex. A, '898 Patent, 8:7-12.) No objective anchor is otherwise sufficiently disclosed to render the terms definite, and none can exist given the self-described "universal" applicability of the claims to a broad spectrum of non-ministerial contexts.

a) DDP is the only methodology that could be applicable to the claims

Aloft is not entitled to claim every method for making a decision; in order to be entitled to exclude others from using a certain methodology of making a decision, the patentee must

sufficiently describe the method so that one of skill in the art could determine the scope of the claims. *Harrah's*, 321 F.Supp. 2d at 1179-80. The patents' specification lists numerous methodologies for making decisions, some that date as far back as the 18th century, such as Benjamin Franklin's method of listing advantages of two alternative choices and canceling out the advantages common to both. (Ex. A, '898 Patent, 1:23-2:4.) Other exemplary methodologies listed in the specification include the Kepner-Tregoe method, the Value Management method, Analytic Hierarchy Process, Decision Trees, probability methods, and the DDP. (Ex. A, '898 Patent, 1:23-2:4.)

Of the various methodologies referenced in the specification, the DDP is the only methodology that the specification attempts to explain with any particularity by identifying four abstract steps (framing, alternatives, analysis, connection). (Ex. A, '898 Patent, 1:52-56.) The patents expressly state, "[t]here is therefore a need for a computer implemented method which may be utilized for implementing DDP in different environments in a universal manner." (Ex. A, '898 Patent, 2:1-3.) Under this narrow view, one of skill in the art would understand the claimed inventions, and thus the decision terms, to be solely directed to the DDP. (Ex. D, Dyer Dec., ¶ 16.)

Notwithstanding the patents' identification of four distinct steps within DDP to make a decision, the decision terms are indefinite because one of skill in the art would not be able to determine *how* to reach a decision. In *Harrah's Entertainment, Inc. v. Station Casinos, Inc.*, the term "theoretical win profile" was held indefinite under § 112, ¶ 2. 321 F.Supp. 2d at 1179. The purpose of the "theoretical win profile" was to provide a casino with "a more accurate estimate of [a] customer's value to the casino." *Id.* at 1178-79. The patent disclosed that a theoretical win profile could be determined by three specific variables - (1) customer winnings, (2) at call

casino properties, (3) over a period of time - that were computed utilizing any type of commutative operation such as addition, multiplication, averaging, “or otherwise.” *Id.* at 1178-79. Although mathematical precision is not required, the Court held that the patent’s failure to state *how* one might compute a theoretical win profile rendered the claim indefinite. *Id.* at 1179. To be definite, the intrinsic evidence must disclose a formula or standard with sufficient “explanatory limitation” to tell one of skill in the art *how* to determine if the desired result – that is, the claimed result – has been reached. *Input/Output, Inc. v. Sercel, Inc.*, No. 5:06-CV-236, 2008 WL 5427982, at *26 (E.D. Tex. Apr. 28, 2008); *Synqor, Inc. v. Artesyn Techs., Inc.*, No. 2:07-CV-497, 2010 WL 2991037, at *29 (E.D. Tex. July 26, 2010). Each step of the DDP methodology is subjective, depending on the opinions of the users or authors practicing the claimed invention, and this subjectivity renders the precise scope of the claimed invention indefinite.

b) The Framing step of the DDP method relies on subjective opinions

Framing is the first step of the DDP methodology and is required by each of the remaining steps. (Ex. A, ‘898 Patent, Fig. 1a.) The Framing process described in the specification relies on the subjective opinions of the authors and users of DDP, thus rendering the DDP methodology intrinsically subjective. Particularly, the specification states:

The purpose of Framing is to clearly communicate to the users the capabilities of the chosen decision application 124 and to allow ***the users to modify the problem definition to the extent that the capability for modification has been incorporated by the authors*** of the application.

(Ex. A, ‘898 Patent, 10:37-42 (emphasis added).) The patent does not explain any further how the users can modify the problem definition, nor does it explain to what extent modification has been incorporated by the authors of the application.

Additionally, inputs utilized during Framing are purely subjective in nature. The specification states:

Such input may include *the policies that form boundary conditions for the decision*, the strategic decisions that can be made, *the values that are important to the decision makers*, the uncertainties that may impact the values desired, and the relationship of the above elements.

(Ex. A, '898 Patent, 10:46-51 (emphasis added).) However, the specification's description stops there and does not inform one of ordinary skill about the extent of the "boundary conditions" or how to determine what is "important" to a decision maker. The subjectivity of the Framing process is further illustrated by the user's final right of rejection; during Framing the application generates certain displays that are "to be confirmed or modified by the users." (Ex. A, '898 Patent, 10:55.) Again the patents fail to explain what modifications can be made, as well as any criteria for confirming or rejecting the displays. The specification confirms the subjectivity of the inputs provided by the users by stating:

In the event that the users are unable to successfully represent the decision problem *as they see it* with the initial decision application, they will select another application 124 and repeat the Framing process 300.

For example, *the users may not want to address a particular decision at this time*, in which case it would become a tactic.

(Ex. A, '898 Patent, 10:63-67; 11:13-15 (emphasis added).) One of ordinary skill in the art would not be able to deduce why a user would "not want to address a particular decision." The subjective "guess and check" method required by the Framing step can only leave one of ordinary skill in the art to guess how to perform the DDP method in its entirety, let alone the Framing step.

c) The Alternatives step of the DDP method relies on subjective opinions

Just as the Framing step of the DDP method relies on subjective inputs and criteria, so too does the Alternatives step. Specifically, “[t]he purpose of the Alternatives process is to develop a set of strategic alternatives that capture the range of possibilities *envisioned by the users.*” (Ex. A, ‘898 Patent, 11:29-32 (emphasis added).) The specification again fails to give any further guidance on what a user might envision or how one of ordinary skill in the art could determine what could possibly be envisioned by a user of the DDP method. Furthermore, the users are able to “confirm or modify” the alternatives, and the modifications or confirmations are used as inputs in the Alternatives step. (Ex. A, ‘898 Patent, 11:36; 11:51-53.) Again, the patent does not describe the criteria or basis for such confirmations or modifications. Essentially the Alternatives step of the DDP method could encompass almost anything “envisioned by the users” and the specification provides one of ordinary skill no guidance on how to bound this step in any meaningful way. *See Input/Output*, 2008 WL 5427982, at *26 (rejecting the plaintiff’s construction that could potentially capture the entire range of a variable because there was no further explanatory limitation).

d) The Analysis and Connection steps of the DDP method rely on subjective opinions

Both the Analysis and Connection steps of the DDP method rely on subjective user opinions just like the Framing and Alternatives steps, and render any claims premised on them indefinite. For example, “[t]he purposes of the Analysis process is *to enable users to have a shared understanding of the significant sources of risk and value* in each of the initially defined alternative strategies.” (Ex. A, ‘898 Patent, 11:67-12:3 (emphasis added).) The patent provides no guidance on how one of ordinary skill would determine what is “significant.” *See Input/Output*, 2008 WL 5427982, at *25-26 (holding “small positive difference” indefinite because the patent did not disclose a standard for measuring or describing “small”).

The Connection step shares similar vagueness and subjective inputs and is, in fact, wholly subjective. (Ex. D, Dyer Dec., ¶ 17.) Specifically, “[t]he first connection module 606 also *receives as input user insight 129 regarding how to combine sources of value into a new more valuable hybrid strategy.*” (Ex. A, ‘898 Patent, 12:66-13:2 (emphasis added).) The specification again fails to further describe what “user insights” are used as inputs, nor does the specification provide any test or methodology for assessing these “user insights.” The decision terms relying on the Analysis and Connection steps of the DDP method cannot be definite because the specification fails to provide any test or methodology to determine the inputs used in the steps. *Harrah’s*, 321 F. Supp. 2d at 1179-1180. Moreover, the specification’s continued reliance on users’ subjective opinions cannot be the basis of any definite claim in the patents. *Datamize*, 417 F.3d at 1348.

C. The claim term “computer code for processing” is indefinite.

1. “Computer code for processing” is governed by § 112, ¶ 6

In the context of the asserted claims, the term “computer code for processing” is a limitation that is purely functional in nature, and fails to disclose sufficient structure for performing the claimed “processing” function. As such, “computer code for processing” is a means-plus-function limitation that is properly subject to § 112, ¶ 6.

Although claim language lacking the term “means” is presumptively outside of the realm of § 112, ¶ 6, the presumption is rebutted if “the term fails to recite sufficiently definite structure or else recites function without reciting sufficient structure for performing that function.” *Mass. Inst. of Tech. v. Abacus Software*, 462 F.3d 1344, 1353 (Fed. Cir. 2006). To determine if a term discloses sufficient structure, the proper inquiry is whether the term is understood as describing structure to one of skill in the art, or whether it instead constitutes a nonce word or verbal

construct that is simply a substitute for the term “means for.” *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1360 (Fed. Cir. 2004).

a) The claim term is purely functional

The plain meaning of “computer code for processing” is purely functional; the claimed function is “processing.” Plaintiff admits as much, stating that the “product includes computer code that is described in terms of its functionality.” (Plt’s Markman Br., No. 162, 5.) Processing is the act of carrying out a systematic series of operations or steps that are directed toward a specific end. (Ex. C, Dictionary, 659 at verb def. 1.) While the specific operations executed during “processing,” as well as the results and outputs of “processing” remain unclear in light of the asserted patents, “processing” nevertheless recites a function.

One of skill in the computer technology industry would understand the term “computer code for processing” as reciting purely functional limitations because “processing” is *the* essential function of a computer. It is axiomatic that computer processing is implemented and executed through specific computer source code. Even the patentee acknowledged that “processing” is purely functional by referring to a computer alternately as a “central processing unit” or “CPU” in the specification. (Ex. A, ‘898 Patent, Fig. 2 at 210 (drawing depicting “CPU”); 2:16-27 (describing Fig. 2 as depicting a “computer”); 4:19.) Essentially, “computer code” is simply a substitute for a general purpose computer – that is, the inherent “means for” processing.⁵ Accordingly, the term is purely functional.

b) Sufficient structure is not present in the claims

⁵ See *NetMoneyIN, Inc. v. VeriSing, Inc.*, 545 F.3d 1359, 1366 (Fed. Cir. 2008) (“bank computer” did not disclose sufficient structure to perform “generating” function); see also *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1376 (Fed. Cir. 2003) (“the claim only recites ‘commands ... for booting’ and states a location. This is really a restatement of ‘means of booting’; the commands are still described solely in functional terms.”).

Once functional claiming is identified, a claim term only falls outside the scope of § 112, ¶ 6 if the term itself discloses sufficient structure for performing the claimed function. *Touchcom, Inc. v. Dresser, Inc.*, 427 F.Supp. 2d 730, 733 (E.D. Tex. 2005). However, contrary to Plaintiff's assertions in its claim construction brief, the recitation of "computer code, in itself" cannot disclose sufficient structure to cause the term to escape § 112, ¶ 6 governance. (Plt's Markman Br., No. 162, 16.) *See NetMoneyIN*, 545 F.3d at 1366 ("the 'bank computer' is not sufficient to rebut the means-plus-function presumption"). The Federal Circuit has consistently required that computer software patents disclose a specific algorithm as structure. *WMS Gaming*, 184 F.3d at 1348. In *Aloft Media, LLC v. Adobe Sys., Inc.*, the sole case on which Plaintiff relies, the Court looked beyond the recitation of "computer code, in itself" (Plt's Markman Br., No. 162, 16), to find that the claims themselves otherwise disclosed a specific description of the "computer code's operation," which adequately conveyed the structure for performing the "specific function" to one of skill in the art. 570 F.Supp. 2d 887, 897-98 (E.D. Tex. 2008). On its face, the term "computer code for processing" fails to provide an algorithm for performing the "processing" function.

Unlike the claims in *Adobe*, the asserted claims do not include any other language that otherwise disclose sufficient structure for performing "processing." In *Adobe*, the claim placed descriptive limitations on the computer code's operations, in effect disclosing a sufficiently specific algorithm as a means for performing the claimed function. *Id.* at 898. Here, however, the claim language "first information and second information" following the term does not provide any guidance as to the specific operations carried out by the computer code during "processing." Instead, it merely describes the information subject to the "processing" function, which is insufficient to impart structure. *Input/OutPut*, 2008 WL 5427982, at *18. Similarly,

the “storage” and “user interface” limitations within the claim language describe the location of the information subject to processing – not the means for “processing.”

Additionally, purported descriptive limitations in the surrounding claim language do not add any meaningful limitation on the scope of “computer code for processing” because the limitations are all directed to *other* functional claim elements. For example, the limitations of “a tornado diagram, a decision sensitivity display, a decision hierarchy display, an influence diagram, or a potential feasible hybrid theme” all limit the scope of the function “generating a display,” which is an element claimed separate and apart from “computer code for processing.” Contrary to Plaintiff’s unsupported assertion that “the elements of claim 110 recite the term computer code coupled with a description of the computer code’s operation” (Plt’s Markman Br., No. 162., 5), the elements of the claims do not provide any clues that would enable one of skill in the art to discern an algorithm for “processing.”

Utilizing principles of claim differentiation to compare independent and dependent claims does not supply any additional guidance regarding an algorithm for “processing.” *See Halliburton*, 456 F.Supp. 2d at 824-25. The limitations within dependent claims are unhelpful because they expressly limit *other* functional elements of the independent claims, and not “computer code for processing.” For example, dependent Claim 124 of the ‘910 Patent adds the limitations: “wherein the universal modules include a framing module, an alternatives module, an analysis module, and a connection module” to independent Claim 110. (Ex. B, ‘910 Patent, 23:31-34.) The added limitations do not aid in determining the means for “processing,” however, because they expressly refer to the “universal modules” – *not* the “computer code for processing.”

For the foregoing reasons, the term “computer code for processing” is a restatement of “means for processing” because it is claimed purely as a “processing” function without disclosing sufficient structure for performing that function. Consequently, the term is a means-plus-function limitation that is properly governed by § 112, ¶ 6.

2. The term “computer code for processing” is indefinite under § 112, ¶ 6

The term “computer code for processing” is indefinite under § 112, ¶ 6 because the specification fails to disclose a specific algorithm for performing the “processing” function. *WMS Gaming*, 184 F.3d at 1348; *NetMoneyIN*, 545 F.3d at 1366. (Ex. D, Dyer Dec., ¶ 19.) Because one of skill in the art would not be able to understand how “processing” is conducted, the scope of the claimed invention is indefinite. *Touchcom*, 427 F.Supp. 2d at 735-36. (Ex. D, Dyer Dec., ¶ 19.) As such, all the claims in the patents-in-suit containing the term “computer code for processing” are invalid.

a) No algorithm is disclosed in the specification

The patents’ specification ultimately fails to sufficiently disclose an algorithm for performing “processing” under the requirements of § 112, ¶ 6. The patents’ failure to provide an algorithm for determining the scope of the claimed means for “processing” constitutes an impermissible attempt to claim every method of utilizing information in the computer software industry. *See Harrah’s*, 321 F.Supp. 2d at 1179. Moreover, the disclosure of four abstract steps comprising the DDP methodology does not remedy this void. Plaintiff’s attempt to point to an algorithm linked to the “computer code” fails to render “computer code for processing” definite because, by Plaintiff’s own words, the computer code’s operation disclosed is specifically directed to “a decision making process,” not the specific “computer code for processing” that is a separate element of the asserted independent claims. (Plt’s Markman Br., No. 162, 5.) Because

one of ordinary skill in the art would not be able to determine the means for “processing,” all of the claims including the term are invalid.

An algorithm may include the steps, formulas, or procedures to be performed by the computer, expressed either textually or in a chart. *Finisar*, 416 F.Supp. 2d at 518. However, the asserted patents ultimately fail to “avoid purely functional claiming” because they do not provide an algorithm for “processing” in any way, much less in the acceptable manners discussed above. *Net MoneyIN*, 545 F.3d at 1367; *Touchcom*, 427 F.Supp. 2d at 735-36. No “computer code” or source code for “processing” is disclosed by the specification. Further, although a general purpose computer is disclosed, it is well-settled that this is insufficient to impart structure on a software patent claim and to escape invalidity. *Net MoneyIN*, 545 F.3d at 1367.

b) Specification does not disclose how “processing” is performed

The specification does not disclose any algorithm to tell one of skill in the art *how* “processing” is performed. Instead, it uses terms of general computer functionality to describe the means for “processing,” without ever describing how processing is actually performed. Plaintiff admits that the computer code “is described in terms of its functionality.” (Plt’s Markman Br., 5.) Absent a specific description of how the functions are performed, the mere “general functionality” disclosure renders the claims invalid as indefinite. *See Encyclopedia Britannica, Inc. v. Alpine Elecs. of Am., Inc.*, No. 05-CV-359-LY, 2008 WL 7328271, at *18 (W.D. Tex. Sept. 30, 2008) (general software functionality was not sufficient to tell one of skill in the art how “accessing” and “retrieving” means were performed).

Moreover, even if the specification’s disclosure of the abstract four-step DDP methodology applies to the “computer code for processing” element, this cannot impart sufficiently definite structure because each of the steps’ description lacks sufficient detail to account for the performance of the “processing” function. *See Touchcom*, 427 F.Supp.2d at 736.

In *Touchcom, Inc. v. Dresser, Inc.*, the District Court for the Eastern District of Texas illustrated this point, stating:

[T]he court agrees, that these three steps are insufficient to perform the entire function found in the claim language. It must be remembered that the claim language requires ‘transforming’ or ‘changing’ and ***this three step algorithm lacks sufficient detail to account for the transforming or changing function required by the claim.***

Id. (emphasis added). Thus, to the extent that the specification discloses four discrete steps for “processing,” this is nevertheless insufficient because the specification does not specifically describe *how* the framing, alternatives, analysis, and connection steps are performed by the software.

Each step of the DDP methodology is described in terms of general functionality; each step’s corresponding module “receives” or “takes” certain input information and then uses that information to “generate” an “output” or “display.” (Ex. A, ‘898 Patent, 11:18, 38 (framing module); 11:41, 43 (alternative module); 12:22 (analysis module); 12:64, 13:14 (connection module).) The patents do not disclose the criteria governing the selection of input information, nor do they describe the formula or equation applied to the input information during “processing.” The patents do not describe the criteria for determining whether input information has been processed so that it is properly the subject of an “output” or “display.” Furthermore, the claims do not even identify how the “first information” and “second information” is used after it is processed. One of skill in the art would not know how to perform the “processing” function, and would wonder what to do with the information after it is processed. This ambiguity wholly fails to serve the notice function, rendering the claims indefinite.

The charts and figures disclosed in the specification are equally unhelpful. The information in the charts constitutes “nothing more than a restatement of the function,” which does not limit the means for “processing” in any specific way. *See Finisar*, 416 F.Supp.2d at

519 (rejecting purported disclosure of structure that was merely “bare repetition of the function” and did not tell *how* the software “generated or embedded”).⁶ The flow charts depicted in the specification do not describe the equations or transformations that occur at each step of the DDP methodology. Instead, they merely depict the conceptual functions performed at each step, such as “framing,” without actually telling *how* the software performs each step of the claimed function. (Ex. A, ‘898 Patent, Figs. 3, 4.)

c) Specification mentions equations but lacks sufficient description of those equations

The patentee admits that certain “equations,” “algorithms” and “calculations” are “necessary” during DDP processing. (Ex. A, ‘898 Patent, 12:10-12 (“the platform makes necessary calculations to output tornado diagrams”); 13:65-67 (“the decision application that includes equations and data relating to the decisions and uncertainties to the value”); 14:41 (“There are well-defined algorithms for the hierarchal expansion of each of the attributes in the minimum set in the event additional detail is requested.”).) However, the specification does not describe such equations with particularity such that one of skill in the art would understand how to calculate inputs, which calculations or equations to apply to certain inputs, and when to apply calculations or equations. The patentee’s impermissible attempt to broadly claim every possible equation for “processing” would reward ambiguity rather than provide the public with notice of the scope of the claimed means. *See Halliburton*, 514 F.3d at 1254.

⁶ In holding the term invalid as indefinite the court stated: “Aside from the fact that this appears to be an attempt to encompass human activity (e.g., decision making by an individual), it provides no algorithm or description of a structure by which the indices are generated or imbedded.” *Finisar*, 416 F.Supp. 2d at 519. Incidentally, the court’s notation is also the subject of *Defendants’ Motion for Summary Judgment of Invalidity of United States Patent Nos. 7,499,898 and 7,593,910* under § 101 that is currently pending before the Court. *See* Def.’s Mot. For Summ. J. of Invalidity of U.S. Patent Nos. 7,499,898 and 7,593,910 (No. 149) (filed Oct. 29, 2010). This further supports the proposition that the specification cannot disclose adequate structure to render the claims valid.

The specification provides no further limiting explanation of the algorithms that would allow one of skill in the art to understand how computer software performs the processing function. Nor does the specification expressly refer to a named algorithm “known to one of ordinary skill in the art,” thereby identifying the algorithm and adequately incorporating it by reference. *Encyclopedia Britannica*, 2008 WL 7328271, at *18. This is especially true given the broad applicability of the claims to many different industries in which decision making implicates different variables, attributes, ranges, possibilities, and desired results. In fact, the patentee expressly recognized that the claimed software is *not* limited to specific computations or algorithms “since each decision is unique.” (Ex. A, ‘898 Patent, 1:62.) Indeed, the problem purportedly solved by the claimed software is that “***it can be applied to any decision regardless of type, complexity, or number of decision makers.***” (Ex. A, ‘898 Patent, 1:58-60 (emphasis added).) Thus, the specification does not distinctly point out the structure for performing the “processing” function, let alone the structure for performing the claimed function in all of the contexts to which the claimed invention purportedly applies. For the foregoing reasons, the term “computer code for processing” is invalid as indefinite.

3. Even if § 112, ¶ 6 does not apply, the term is indefinite

Should the court determine that “computer code for processing” is not subject to § 112, ¶ 6, the term is nevertheless indefinite under § 112, ¶ 2 because the patents do not specifically describe an algorithm or equation utilized during “processing.” To the extent that the DDP methodology is vaguely disclosed, it is based on purely subjective criteria that cannot be the subject of a definite patent claim. The term’s indefiniteness is further evidenced by the inconsistent use of “processing” and “process” throughout the asserted patents. As such, “computer code for processing” is invalid as indefinite under § 112, ¶ 2.

a) No algorithm is sufficiently disclosed

The fact that a software term falls outside of the scope of § 112, ¶ 6, does not alleviate a patentee's responsibility to disclose a specific algorithm that would permit a general purpose computer to practice the claimed invention. *See, e.g., Input/OutPut*, 2008 WL 5427982, at * 26 (software claim indefinite under § 112, ¶ 2). As discussed above, the patents' specification fails to disclose an algorithm for "computer code for processing" with sufficient explanatory limitation to provide one of skill in the art with notice of potential infringement. *See WMS Gaming*, 184 F.3d at 1348. Indeed, the patentee admits that (at least) 10% of software has to "be written and tested from scratch." (Ex. A, '898 Patent, 6:9-16.) The patentee, however, omitted any description (or mention) of the very programming objects a person of ordinary skill in the art would need in order to build the computer code at the heart of the invention.

b) Any algorithm disclosed is insufficient because it is based on purely subjective criteria

The patentee's incomplete disclosure of the four-step DDP methodology is insufficient to fulfill the disclosure requirements of § 112, ¶ 2, because all of the steps are premised on the subjective opinions of the users and authors practicing the patented invention. *Datamize*, 417 F.3d at 1350. The information input subject to the DDP methodology is premised on the user's "collective view of the decision problem." (Ex. A, '898 Patent, 10:59-60.) Each of the framing, alternatives, analysis, and connection steps present an opportunity for a user to "confirm or modify" the results or output based on their opinions. (Ex. A, '898 Patent, 11:36.) For example, the stated purpose of the Alternatives process is to "develop a set of strategic alternatives that capture the range of possibilities *envisioned by the users*." (Ex. A, '898 Patent, 11:31-32 (emphasis added).) As described by the patents' specification, the DDP methodology is indefinite because claim language cannot depend solely on the unrestrained, subjective opinion

of a particular individual purportedly practicing the patented invention. *Datamize*, 417 F.3d at 1350. Accordingly, the claims are indefinite, and therefore invalid.

VII. CONCLUSION

The Court should grant Defendants' Motion for Summary Judgment of Invalidity because the asserted claims recite terms that are indefinite in contravention of the requirements of 35 U.S.C. § 112. First, the phrase "potential feasible hybrid theme" cannot be defined in a way that meaningfully appraises a person of ordinary skill in the art of the particular scope of the asserted claims. The specification does not support any clear definition, and any meaning would be purely subjective. Second, the "decision terms" are likewise too subjective to give the claims a particular and definite scope. Third, the phrase "computer code for processing" is a purely functional means-plus-function limitation that is unsupported by any structure because there is no disclosure of code or algorithms linked to the "processing" function recited in the claims. As such, the "computer code for processing" term is indefinite under § 112, ¶ 6, rendering the claims invalid. For the foregoing reasons, Defendants respectfully request that the Court grant this Motion and award any other suitable remedy as justice so requires.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that, on December 7, 2010, the foregoing document was filed electronically in compliance with Local Rule CV-5(a). As such, this notice was served on all counsel who have consented to electronic service. Local Rule CV-5(a)(3)(A).

/s/ Phillip Aurentz
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