

**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

**REPLY IN SUPPORT OF DEFENDANTS' MOTION FOR SUMMARY JUDGMENT OF
INVALIDITY OF UNITED STATES PATENT NOS. 7,499,898 AND 7,593,910**

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I. The Term “Potential Feasible Hybrid Theme” is Indefinite

A. Any possible construction is contrary to the intrinsic evidence

Aloft’s argument is based on improper claim interpretations and is contrary to the intrinsic evidence. To find that potential feasible hybrid theme is definite would require equating a “hybrid theme” to a “hybrid strategy.” (Aloft Br. at 17-18.) Such a construction, however, is improper and contrary to the weight of the intrinsic evidence. The most valuable evidence informing claim interpretation - that is, the claim language itself - indicates that “hybrid theme” and “hybrid strategy” are *not* synonymous. (Ex. A to Motion, ‘898 Patent at Claim 54 (“a hybrid theme includes a hybrid strategy.”); Ex. B to Motion, ‘910 Patent at Claim 84 (“the feasible hybrid theme is associated with at least one strategy.”).) The patentee chose to use the two different phrases to limit the scope of one invention. Thus, construing the phrases to be synonymous is improper because it would render the patentee’s word choice in the claims superfluous. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315, 1317 (Fed. Cir. 2005); *Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, 438 F.3d 1374, 1380 (Fed. Cir. 2006). Construing the phrases to be synonymous is also contrary to the specification. The patentee, acting as its own lexicographer, chose to expressly define “strategy” as equating to “strategic decisions” or “decisions.” (Ex. A, ‘898 Patent at 11:8-10.) What the patentee did *not* do, however, was define “theme” or to equate it with “strategy.” Aloft cannot point to any intrinsic evidence to otherwise indicate that the terms are synonymous and, indeed, none exists.¹ Without equating “hybrid theme” and “hybrid strategy,” Aloft’s argument cannot be supported and the term remains insolubly ambiguous.

¹ Aloft’s reference to the drawings in the provisional application further supports Halliburton’s position that the two terms are not synonymous, because even there the patentee used the two terms differently. (Aloft Br. at 17.)

Moreover, Aloft’s argument fails to consider the term “potential feasible hybrid theme” as a whole. Aloft focuses only on “hybrid theme” and completely fails to address the additional limitations present in the term. Even if one of skill in the art could derive the meaning of “hybrid theme” from the patents’ disclosure, this is insufficient to delineate the scope of “potential feasible hybrid theme” with sufficient specificity. Aloft improperly ignores the presence of the “potential” and “feasible” elements, rendering them superfluous to the meaning of the term as a whole. Such a construction cannot stand. *See Curtiss-Wright*, 438 F.3d at 1380. Aloft does not point to any further intrinsic evidence to delineate the scope and meaning of the term. Thus, the Court should find that the term is indefinite as insolubly ambiguous.

B. Aloft fails to address that the term is wholly subjective

Aloft’s brief avoids addressing the intrinsic evidence that illustrates that a “potential feasible hybrid theme” is wholly subjective because it is based on the unrestrained opinions of the users of the claimed invention. (Motion at 8.) Just because the term comprises some sort of display or representation does not negate the fact that it was generated using subjective input. As discussed fully in Aloft’s motion and co-pending Markman brief, the specification expressly contemplates that each step of the computer-implemented decision making process is subject to the opinions of the users of the software. (Motion at 8.) Aloft fails to dispute this evidence.

Even Aloft’s construction fails to preserve the validity of the claims, and Aloft’s avoidance of the issue cannot dispel the subjectivity of the term. For example, even if the court were to find that “hybrid strategy” is synonymous with “hybrid theme,” it is still generated based on subjective input. A hybrid strategy is an “optimal” compilation of decisions taken from alternative strategies (Aloft Br. at 18), and the specification makes clear that a determination of what is “optimal,” is subject to the opinions and input of the software users. (Motion at 8.) Further, if the potential feasible hybrid theme is generated during the connection step of the

DDP, as Aloft asserts (Aloft Br. at 17), the specification makes clear that the unrestrained opinions of the users are critical to this step. (Ex. A, '898 Patent at 12:66-13:2 (“The 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.”)). Even under Aloft’s proposed construction it cannot escape the purely subjective nature of a potential feasible hybrid theme, rendering the claim invalid as indefinite.

C. Aloft contradicts its argument regarding the decision terms

Aloft’s argument for the definiteness of “potential feasible hybrid theme” contradicts Aloft’s argument regarding the decision terms. Aloft denies that the decision terms are limited to the DDP, yet can *only* point to intrinsic evidence regarding the DDP to support its proposed construction of “potential feasible hybrid theme.” In order to formulate *any* construction of “potential feasible hybrid theme,” Aloft is constricted to a discussion of the displays generated during DDP. Aloft’s position is disingenuous: in the same breath that it denies that the independent claims are limited to the DDP, it must adopt the limitations of the DDP to formulate a construction of “potential feasible hybrid theme” and preserve the validity of the claims. Moreover, Aloft has consistently opposed adopting limitations from the preferred embodiment (Aloft Markman Reply Br. at 1-4; Aloft Br. at 12), yet does exactly that in arguing that “potential feasible hybrid theme” is definite. Either way, the asserted independent claims that house these disputed terms are invalid as indefinite.

II. The Decision Terms are Indefinite²

A. Aloft fails to address that the decision terms are wholly subjective

Aloft's argument wholly avoids the issues presented by Halliburton's motion and mischaracterizes the law of the Federal Circuit regarding software patents. The fact that the "decision terms" are directed to software does not render them *per se* definite, as Aloft proposes.³ (Aloft Br. at 8-12.) Rather than address Halliburton's arguments that the decision terms are wholly subjective and the patents fail to disclose an objective anchor delineating the scope of the claims, Aloft attempts to hide behind the form in which the claims were drafted. Yet again, Aloft attempts to avoid the substance of the claims by focusing on their form, contending that Halliburton has improperly characterized the claimed inventions as methods rather than articles of manufacture.⁴ (Aloft Br. at 8, 10.) This conflation lacks any basis in fact

² Halliburton continues to assert that all the decision terms ("decision logic," "logic related to decision making," "decision making," "capable of performing logic related to decision making," and "capable of performing decision logic") are indefinite but focuses its discussion on the terms "decision logic" and "logic related to decision making" because it applies equally to all of the aforementioned terms. Halliburton also continues to assert that the terms addressed solely in its Markman briefing are indefinite ("value"; "sources of value"; "collaborative decision platform").

³ Tellingly, Aloft does not cite to *any* case law to support its contention that, because the claims are directed to software, they are definite. Halliburton has previously described Aloft's misunderstanding of the law in its responsive claim construction brief, and hereby incorporates by reference the arguments stated therein. (Markman Resp. Br., Dkt. No. 166 at 14-15.) To foreclose any further discussion of the issue, Halliburton briefly points out that the *Aloft Media, LLC v. Adobe Sys., Inc.* case on which Aloft bases its contention did *not* stand for the proposition that computer code alone connotes sufficient structure to one skilled in the art to render a claim definite. Rather, the court looked beyond the disclosure of computer code to find that the claims otherwise disclosed a sufficient explanatory limitation of the computer's operations - that is, the specific algorithm utilized to carry out the claimed functions - in finding the claims to meet the disclosure requirements of § 112. 570 F. Supp. 2d 887, 897-98 (E.D. Tex. 2008).

⁴ Aloft incorrectly asserted that Halliburton characterized the claimed inventions as methods, rather than articles of manufacture, in an attempt to avoid the law governing patentable subject matter in the context of software claims. (Aloft § 101 Resp. Br., Dkt. No. 167 at 1-2.) Although Halliburton is of the belief that it sufficiently clarified this issue for Aloft (§ 101 Reply Br., Dkt. No. 172 at 3), it becomes necessary to reiterate the position raised therein.

or law, and is misplaced. Rather, Halliburton has challenged Aloft to meet the definiteness requirements for software process claims, i.e. the patentee must sufficiently describe the process carried out by the software 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). Aloft's response brief wholly fails to respond to the issues raised and does not point to any intrinsic evidence that could serve the notice function contemplated by § 112.

Aloft wholly fails to address or otherwise respond to the evidence that shows that the decision terms are indefinite because they are wholly subjective in nature. Aloft's refusal to address the evidence is premised on its argument that the terms are not limited to the DDP (Aloft Br. at 12), and that the terms cannot be subjective due to their form (Aloft Br. at 13). Despite making such arguments, Aloft does not point to any intrinsic evidence to refute the subjectivity of the decision terms. Aloft cannot dispute that the only disclosures that exist within the four corners of the asserted patents depend on the subjective opinions of the users of the software. (Ex. A, '898 Patent at 10:46-61 ("the values that are important to the decision makers"); 12:66-13:2 ("The 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.")) Accordingly, this Court should find that the decision terms are invalid as indefinite. *Datamize*, 417 F.3d at 1350.

Furthermore, Aloft's reason for disregarding the evidence showing subjectivity is flawed. The decision terms *must* be limited to the DDP. The provisional application Aloft references in its response illustrates that the specification's disclosures provide clear and convincing evidence that the decision terms are subjective. (Aloft Br. at 3.) The provisional application, which is incorporated by reference into the specification of the asserted patents, *only* discloses a decision process comporting to the steps of the DDP and describes the invention as a computer platform

to implement the process. (Aloft Br. at Ex. 8, Provisional Application at 2:21-3-27.) The specifications and drawings of the asserted patents disclose no other process for decision making. (Ex. A, '898 Patent, Fig. 5.) Accordingly, because the terms are limited to the DDP the specification's disclosures regarding the DDP provide clear and convincing evidence that the decision terms are invalid as wholly subjective.

B. Aloft fails to address that the decision terms are overly broad to the point of invalidity

Aloft blatantly ignores the law that requires a patent to “clearly distinguish what is claimed from what is foreclosed from future enterprise.” *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942). A claim term is indefinite where it is broad enough to cover both the inventive element that was superior to the prior art, as well as all future improvements thereof. *Halliburton Energy Servs., Inc. v. M-I, LLC*, 514 F.3d 1244, 1253 (Fed. Cir. 2008) (holding claim invalid under § 112, ¶ 2). This is exactly what the decision terms, as drafted, accomplish: the claims cover the use of software to implement decision making processes within the prior art, as well as all other computer-implemented decision making processes yet to be invented. As such, the claims are overly broad to the point of invalidity. *Id.* at 1253. Aloft does not refute this point and, in fact, raises arguments that support a finding that the decision terms are indefinite.

Aloft's arguments focus solely on the *meaning* of the decision terms and fail to address that the scope of the terms is indefinite.⁵ “Even if a claim term's definition can be reduced to

⁵ Aloft's reference to the position of the parties with respect to “decision logic” is irrelevant because the patents at issue in that case were different from the patents at issue presently. Furthermore, the Court never issued a ruling as to whether the meaning and scope of the term was sufficiently definite to meet the requirements of § 112. Finally, Aloft's attempt to equate an opposing party in litigation with one of skill in the art is improper. *See Sundance, Inc. v. DeMonte Fabricating, Ltd.*, 5530 F.3d 1356, 1363 (Fed. Cir. 2008) (held that “where an issue calls for a consideration of evidence from the perspective of one of ordinary skill in the art, it is

words, the claim is still indefinite if a person of ordinary skill in the art cannot translate the definition into meaningfully precise claim scope.” *Halliburton*, 514 F.3d at 1251. A patent must disclose an objective standard or formula so that one of skill in the art, upon reading the patent, would be able to determine the scope of the patentee’s right to exclude. *Datamize*, 417 F.3d at 1352; *Harrah’s Entm’t, Inc. v. Station Casinos, Inc.*, 321 F. Supp. 2d 1173, 1179-80 (D. Nev. 2004). Even if one of skill in the art would understand the decision terms to have a specific meaning, the *scope* nevertheless remains indefinite because the patent does not disclose an objective standard or formula executed during each “unique” decision process. (Ex. A, ‘898 Patent at 1:62) Aloft admits as much, explaining that “an optimal hybrid strategy may vary depending upon the unifying or dominant idea (i.e., ‘theme’) in which the decision is being approached.” (Aloft Br. at 18.)⁶ The patentee expressly indicated that any standard or formula would, in fact, be subjective and based on the opinions of the users of the software and the context of the decision. (Ex. A, ‘898 Patent at 10:37-42, 46-51.)

Aloft argues that the claims themselves do not require that a decision be reached (Aloft Br. at 10), but when it is helpful to its position argues that a “potential feasible hybrid theme” is a “compilation of *decisions*” (Aloft Br. at 18). Aloft cannot have it both ways. The decision terms and the term “potential feasible hybrid theme” both appear in the same independent claim to

contradictory to rule 702 to allow a witness to testify on the issue who is not qualified as a technical expert in that art.”); *Advanced Incubator, Inc. v. Sharp Corp.*, 2010 WL 1170148, *3-4 (E.D. Tex. Mar. 22, 2010) (striking portions of expert opinion as to legal issue of definiteness).

⁶ Aloft’s statements were made in its discussion of the disputed term “potential feasible hybrid theme.” The statements in that discussion are relevant to the definiteness of the decision terms because both terms are found within independent claims 110 and 14 asserted by Aloft. Because the terms are used to describe the same claimed invention, the explanation of each term informs the construction of the other. See *Brookhill-Wilk1, LLC v. Intuitive Surgical, Inc.*, 326 F.3d 1216, 1220 (Fed. Cir. 2003) (stating that, “while certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered” in construing the meaning and scope of a term).

describe a single invention. This single invention either requires a decision, or it does not. If it does, the claims are wholly subjective and thus invalid due to indefiniteness. If it does not, the claims are indefinite because even Aloft cannot propose a construction of “potential feasible hybrid theme” that does not contradict other positions it has taken regarding the independent claims. Accordingly, the claims are invalid as indefinite.

Aloft’s argument that one of skill in the art would understand the meaning and scope of the decision terms is unsupported by the intrinsic evidence and the law, and therefore must fail. The relevant inquiry is whether one of skill in the art would understand the patent itself to bound the claim scope, not simply whether that person would be capable of implementing the claimed functionality. *Union Pacific Res. Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 692 (Fed. Cir. 2001). The intrinsic evidence does not contain sufficient explanatory limitation to allow one of skill in the art to utilize the “computational capabilities” Aloft suggests in its response. (Aloft Br. at 14.) Further, if the claims are not limited to the DDP, the intrinsic evidence does not contain sufficient explanatory limitation to inform one of skill in the art *which* decision process - out of a potentially infinite pool of possible algorithms used for decision making - to utilize for each decision. Aloft brief does not point to any disclosures in the intrinsic evidence. Instead, Aloft improperly tries to substitute the alleged *capability* of one of skill in the art for the knowledge of one of skill in the art in light of the intrinsic evidence. *Union Pacific*, 236 F.3d at 692.

III. The Term “Computer Code for Processing” is Indefinite

A. Aloft misstates the law governing software patents under § 112, ¶ 6

Aloft’s entire argument is premised on the assertion that the claim’s recitation of “computer code” - without more - sufficiently discloses structure to avoid governance by § 112,

¶ 6. (Aloft Br. at 22.) This assertion fundamentally misstates the law and is without merit. Aloft’s brief does not cite one case that stands for its stated proposition; rather, all of the cases cited by Aloft looked *beyond* the claim’s mere recitation of “computer code” or the like to find that the claims themselves otherwise disclosed sufficient explanatory limitations that essentially disclosed a specific algorithm for carrying out the claimed functionality. *Aloft Media v. Adobe*, 570 F. Supp. 2d 887, 897-98 (E.D. Tex. 2008); (Aloft Br. at 23). Thus, the recitation of “computer code” alone does not determine whether the claims are subject to § 112, ¶ 6.

The evidence within the four corners of the patent is sufficient to rebut the presumption that “computer code for processing” is not subject to § 112, ¶ 6. Even Aloft’s own admissions illustrate that the term is purely functional, rendering it subject to § 112, ¶ 6. *See Touchcom, Inc. v. Dresser, Inc.*, 427 F. Supp. 2d 730, 733 (E.D. Tex. 2005) (if functional claiming is identified, the term only falls outside of § 112, ¶ 6 if the term itself discloses sufficient structure). Aloft stated, “The computer program product includes computer code that is described in terms of its functionality.” (Aloft Markman Br. at 4-5.) Tellingly, Aloft expends nearly four pages arguing why “computer code” alone connotes sufficient structure without ever actually telling the Court what the “computer code for processing” does.

Aloft’s refusal to address any more than the term “computer code” is fatal to the validity of the claim, and places undue weight on the presumption resulting from the lack of the word “means.” Although the presumption is applicable, it is overcome where the claim is purely functional and fails to disclose sufficient structure to one of ordinary skill in the art.⁷ By Aloft’s own admission the terms are purely functional, thus rebutting the presumption and providing strong evidence that the terms are properly subject to § 112, ¶ 6. (Aloft Markman Br. at 4-5.) Accordingly, the evidence showing that the terms are subject to § 112, ¶ 6 remains wholly unrefuted.

⁷ *Personalized Media Comm’n, LLC v. Int’l Trade Commission*, 161 F.3d 696, 700-701 (Fed. Cir. 1998) (“digital detector” is subject to § 112, ¶ 6 because it is purely functional and does not connote sufficient structure to one of skill in the art); *Mass. Institute of Tech. et al. v. Abacus, Inc.*, 462 F.3d 1344, 1354 (Fed. Cir. 2006) (“colorant selection mechanism” was subject to § 112, ¶ 6 because it purely functional and “colorant mechanism” does not place sufficient explanatory limitations to disclose structure).

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CERTIFICATE OF SERVICE

The undersigned certifies that, on December 31, 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