

UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF TEXAS  
TYLER DIVISION

Eolas Technologies Incorporated,

*Plaintiff,*

vs.

No. 6:09-cv-00446-LED (filed Oct. 6, 2009)

Adobe Systems Inc.; Amazon.com, Inc.; Apple  
Inc.; Argosy Publishing, Inc.; Blockbuster Inc.;  
CDW Corp.; Citigroup Inc.; eBay Inc.; Frito-  
Lay, Inc.; The Go Daddy Group, Inc.; Google  
Inc.; J.C. Penney Corporation, Inc.; JPMorgan  
Chase & Co.; New Frontier Media, Inc.; Office  
Depot, Inc.; Perot Systems Corp.; Playboy  
Enterprises International, Inc.; Rent-A-Center,  
Inc.; Staples, Inc.; Sun Microsystems, Inc.;  
Texas Instruments Inc.; Yahoo! Inc.; and  
YouTube, LLC,

*Defendants.*

**DEFENDANTS' REPLY IN SUPPORT OF MOTION FOR SUMMARY  
JUDGMENT OF INVALIDITY FOR LACK OF WRITTEN DESCRIPTION**

**TABLE OF CONTENTS**

A. Eolas Misconceives The Legal Issue Presented..... 1

B. There Is No Support in the Written Description Suggesting The Inventors Possessed A Non-Tag “Embed Text Format” — And Eolas Cites None..... 2

C. Eolas Concedes There Is No Support For An “Embed Text Format” At A Location Other Than Where The Object Is Displayed ..... 3

## **TABLE OF AUTHORITIES**

### **Cases**

<i>Ariad Pharm., Inc., v. Eli Lilly &amp; Co.</i> 598 F.3d 1336 (Fed. Cir. 2010).....	1, 2
<i>Atl. Research Mktg. Sys., Inc. v. Troy</i> Nos. 2011-1002, -1003 (Fed. Cir. Oct. 6, 2011).....	1
<i>Crown Packaging Tech., Inc. v. Ball Metal Beverage Container Corp.</i> 635 F.3d 1373 (Fed. Cir. 2011).....	2
<i>Phillips v. AWH Corp.</i> 415 F.3d 1303 (Fed. Cir. 2005).....	1
<i>PowerOasis, Inc. v. T-Mobile USA, Inc.</i> 522 F.3d 1299 (Fed. Cir. 2008).....	3

Eolas’s response brief fails to offer any evidence—not a single citation to the specification of the patents-in-suit—to establish to one of ordinary skill that the inventors possessed the full scope of the “embed text format” that Eolas now claims. Instead, Eolas’s opposition is built upon the misguided notion that this Court’s claim construction order has resolved written description *ipso facto*. But claim construction is merely a predicate that frames the written description question, it does not answer it.

**A. Eolas Misconceives The Legal Issue Presented**

Contrary to Eolas’s assertions, Defendants’ motion does not “attempt to limit” the Court’s construction of “embed text format.” *See* D.I. 996 (“Resp.”) at 6-7. Rather, Defendants’ motion presents an entirely separate inquiry. Now that the claims have been construed broadly at Eolas’s urging, is there sufficient disclosure in the specification to convey to one skilled that the inventors had possession of the full scope of the claims? *See* Mot. at 1-2 (citing cases); *Atl. Research Mktg. Sys., Inc. v. Troy*, Nos. 2011-1002, -1003, slip op. at 12-16 (Fed. Cir. Oct. 6, 2011) (construing claim first before incorporating that construction into the written description analysis). A claim may be construed to define a genus, “yet the question may still remain whether the specification, including original claim language, demonstrates that the applicant has invented species sufficient to support a claim to a genus.” *Ariad Pharm., Inc., v. Eli Lilly & Co.*, 598 F.3d 1336, 1349 (Fed. Cir. 2010). “[M]erely drawing a fence around the outer limits of a purported genus is not an adequate substitute for describing a variety of materials constituting the genus and showing that one has invented a genus and not just a species.” *Id.* at 1350.<sup>1</sup>

---

<sup>1</sup> Eolas’s quotation of *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005), merely reiterates the non-controversial statement that claims may be construed more broadly than the embodiment disclosed. But it does not address whether that narrower disclosure is in turn sufficient to show possession of the broader claim for purposes of Section 112.

**B. There Is No Support in the Written Description Suggesting The Inventors Possessed A Non-Tag “Embed Text Format” — And Eolas Cites None**

It is uncontested that the phrase “embed text format” does not appear in the specification but is a made-up term added during prosecution. *See* Mot. at 1. Here, Eolas has urged the Court to construe “embed text format” very broadly to include any kind of “coded information.” *See* D.I. 914 (“Order”) at 15. Its claim to all “coded information” capable of embedding content amounts to a functional claim for which the written description concern is “especially acute.” *Ariad*, 598 F.3d at 1349. Yet, Eolas essentially acknowledges that the specification fails to disclose an “embed text format” that is not a tag, much less all of the unlimited types of coded information claimed to be covered. Indeed, Eolas does not dispute that during prosecution (and subsequent legal proceedings) the patentees repeatedly relied on the “embed text format” being a “special tag” to distinguish prior art that did not use tags. *See* Mot. at 1-2, 5 (attaching and quoting file history).<sup>2</sup> Thus, after reading the specification, one skilled in the art would not understand Eolas to have invented species sufficient to support a claim to the broad genus including unlimited kinds of “coded information.” *See Ariad*, 598 F.3d at 1349.

Unable to point to any disclosure in the specification, Eolas submits the declaration of David Martin to attempt to create a factual dispute. First, Dr. Martin cites the so-called “IMAGE3D tags” buried in source code appendices. Martin Decl. at ¶ 7. Yet he admits this is merely another example of a tag. *Id.* (“[T]he specification teaches the use of an IMAGE3D tag.”). Thus, it provides no support for use of any other type of coded information.

Second, Dr. Martin cites an example of an external application type,

---

<sup>2</sup> Eolas’s reliance on *Crown Packaging Tech., Inc. v. Ball Metal Beverage Container Corp.* is therefore misplaced, as that case acknowledges that *ICU*, *Lizard*, and *Tronzo* properly invalidated claims where, as in this case, “the specification discloses only one specific method” and the patentee used that to distinguish prior art that used a different method. 635 F.3d 1373, 1382 (Fed. Cir. 2011).

“application/postscript,” that “may be used with the invention.” *Id.* ¶ 8. As the quotation from the specification makes perfectly clear, this is simply an example of an “application” type “to be used to handle the object.” ’906 Patent at 13:2–7. That is, it is given as an example of the “executable application,” which is an entirely separate and distinct limitation from the “embed text format.” The phrase “application/postscript” is given as an example “value” of the type “element” within the EMBED tag example, so one of ordinary skill would not understand it to disclose the use of “postscript,” or any other scripting language for that matter, as the “embed text format” itself. The rest of the declaration consisting of lawyer argument and conclusory assertion also cannot raise a genuine issue of material fact. *See PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1310 (Fed. Cir. 2008).

**C. Eolas Concedes There Is No Support For An “Embed Text Format” At A Location Other Than Where The Object Is Displayed**

This Court has declared that the claim limitations “logically demonstrate[] that the embed text format location in the document is where the displayed object will appear.” Order at 17 (emphasis added). Eolas does not dispute that there is no support in the written description for an “embed text format” at a location other than where the “object” is displayed.<sup>3</sup> The Court’s construction has resolved Defendants’ motion in this respect. However, if Eolas were to contend that the embed text format need not be so located, such a construction would lack written description support. *See, e.g., PowerOasis*, 522 F.3d at 1309 (finding embodiments disclosing co-located elements insufficient to support claim covering elements at different locations).

For the foregoing reasons, Defendants’ respectfully request that Defendants’ Motion for Summary Judgment of Invalidity for Lack of Written Description be GRANTED.

---

<sup>3</sup> Eolas merely asserts the Court “rejected” the requirement that the “embed text format” be at the same location. This is plainly wrong, as the Court’s *Markman* order makes clear.

DATED: October 11, 2011

By: /s/ Jason W. Wolff (w/ permission)

David J. Healey  
<[Healey@fr.com](mailto:Healey@fr.com)>  
FISH & RICHARDSON P.C.  
1 Houston Center  
1221 McKinney Street, Suite 2800  
Houston, TX 77010  
Telephone: (713) 654-5300  
Facsimile: (713) 652-0109

OF COUNSEL:

Frank E. Scherkenbach  
<[Scherkenbach@fr.com](mailto:Scherkenbach@fr.com)>  
FISH & RICHARDSON P.C.  
One Marina Park Drive  
Boston, MA 02110-1878  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906

Jason W. Wolff  
<[Wolff@fr.com](mailto:Wolff@fr.com)>  
FISH & RICHARDSON P.C.  
12390 El Camino Real  
San Diego, CA 92130  
Telephone: (858) 678-5070  
Facsimile: (858) 678-5099

*Attorneys for Defendant and  
Counterclaimant Adobe Systems Inc.*

By: */s/ Edward R. Reines*

---

Edward R. Reines  
edward.reines@weil.com  
Jared Bobrow  
jared.bobrow@weil.com  
Sonal N. Mehta  
sonal.mehta@weil.com  
Aaron Y. Huang  
aaron.huang@weil.com  
Andrew L. Perito  
andrew.perito@weil.com  
WEIL, GOTSHAL & MANGES LLP  
201 Redwood Shores Parkway  
Redwood Shores, CA 94065  
Telephone: (650) 802-3000  
Facsimile: (650) 802-3100

Doug W. McClellan  
doug.mcclellan@weil.com  
WEIL, GOTSHAL & MANGES LLP  
700 Louisiana, Suite 1600  
Houston, TX 77002  
Telephone: (713) 546-5000  
Facsimile: (713) 224-9511

Jennifer H. Doan  
jdoan@haltomdoan.com  
Joshua R. Thane  
jthane@haltomdoan.com  
HALTOM & DOAN  
6500 Summerhill Road, Suite 100  
Texarkana, TX 75503  
Telephone: (903) 255-1000  
Facsimile: (903) 255-0800

Otis W. Carroll, Jr. (Bar No. 03895700)  
fedserv@icklkw.com  
Deborah J. Race (Bar No. 16448700)  
drace@icklkw.com  
IRELAND CARROLL & KELLEY  
6101 S. Broadway, Suite 500  
Tyler, TX 75703  
Telephone: (903) 561-1600  
Facsimile: (903) 581-1071

*Attorneys for Defendants  
Amazon.com, Inc., and Yahoo! Inc.*



By: /s/ Thomas L. Duston (w/ permission)

Thomas L. Duston  
<[tduston@marshallip.com](mailto:tduston@marshallip.com)>  
Anthony S. Gabrielson  
<[agabrielson@marshallip.com](mailto:agabrielson@marshallip.com)>  
Scott A. Sanderson (*pro hac vice*)  
<[ssanderson@marshallip.com](mailto:ssanderson@marshallip.com)>  
MARSHALL, GERSTEIN & BORUN LLP  
6300 Willis Tower  
233 South Wacker Drive  
Chicago, IL 60606-6357  
Telephone: (312) 474-6300  
Facsimile: (312) 474-0448

Eric H. Findlay (Bar No. 00789886)  
<[efindlay@findlaycraft.com](mailto:efindlay@findlaycraft.com)>  
Brian Craft (Bar No. 04972020)  
<[bcraft@findlaycraft.com](mailto:bcraft@findlaycraft.com)>  
FINDLAY CRAFT, LLP  
6760 Old Jacksonville Highway  
Suite 101  
Tyler, TX 75703  
Telephone: (903) 534-1100  
Facsimile: (903) 534-1137

*Attorneys for Defendant CDW LLC*

By: /s/ Edwin R. DeYoung (w/ permission)

Edwin R. DeYoung (Bar No. 05673000)

<[edeyoung@lockelord.com](mailto:edeyoung@lockelord.com)>

Roy W. Hardin (Bar No. 08968300)

<[rhardin@lockelord.com](mailto:rhardin@lockelord.com)>

Roger Brian Cowie (Bar No. 00783886)

<[rcowie@lockelord.com](mailto:rcowie@lockelord.com)>

M. Scott Fuller (Bar No. 24036607)

<[sfuller@lockelord.com](mailto:sfuller@lockelord.com)>

Galyn Gafford (Bar No. 24040938)

<[ggafford@lockelord.com](mailto:ggafford@lockelord.com)>

Jason E. Mueller

<[jmueller@lockelord.com](mailto:jmueller@lockelord.com)>

LOCKE LORD BISSELL & LIDDELL LLP

2200 Ross Avenue, Suite 2200

Dallas, TX 75201-6776

Telephone: (214) 740-8000

Facsimile: (214) 740-8800

Eric L. Sophir (*pro hac vice*)

<[esophir@kslaw.com](mailto:esophir@kslaw.com)>

KING & SPALDING LLP

1301 K. Street. NW, Suite 600

Washington, D.C. 20005-3364

Telephone: (202) 626-8980

Facsimile: (202) 626-3737

*Attorneys for Defendant Citigroup Inc.*

By: /s/ Sasha G. Rao (w/ permission)

---

James R. Batchelder (pro hac vice)

[james.batchelder@ropesgray.com](mailto:james.batchelder@ropesgray.com)

Sasha G. Rao (pro hac vice)

[sasha.rao@ropesgray.com](mailto:sasha.rao@ropesgray.com)

Mark D. Rowland

[mark.rowland@ropesgray.com](mailto:mark.rowland@ropesgray.com)

Brandon Stroy (pro hac vice)

[brandon.stroy@ropesgray.com](mailto:brandon.stroy@ropesgray.com)

Rebecca R. Hermes (pro hac vice)

[rebecca.wight@ropesgray.com](mailto:rebecca.wight@ropesgray.com)

Han Xu (pro hac vice)

[han.xu@ropesgray.com](mailto:han.xu@ropesgray.com)

**ROPES & GRAY LLP**

1900 University Avenue, 6th Floor

East Palo Alto, California 94303-2284

Telephone: (650) 617-4000

Fascimile: (650) 617-4090

Michael E. Jones (Bar No. 10929400)

[mikejones@potterminton.com](mailto:mikejones@potterminton.com)

Allen F. Gardner (Bar No. 24043679)

[allengardner@potterminton.com](mailto:allengardner@potterminton.com)

POTTER MINTON

A Professional Corporation

110 N. College, Suite 500

Tyler, TX 75702

Telephone: (903) 597-8311

Facsimile: (903) 593-0846

*Attorneys for Defendants  
Google, Inc. and YouTube, LLC*

By: /s/ Brian Carpenter (w/ permission)

Christopher M. Joe

[Chris.Joe@BJCIPLaw.com](mailto:Chris.Joe@BJCIPLaw.com)

Brian Carpenter

[Brian.Carpenter@BJCIPLaw.com](mailto:Brian.Carpenter@BJCIPLaw.com)

Eric W. Buether

[Eric.Buether@BJCIPLaw.com](mailto:Eric.Buether@BJCIPLaw.com)

Buether Joe & Carpenter

1700 Pacific, Suite 2390

Dallas, TX 95201

Telephone: (214) 466-1270

*Attorneys for Defendant*

*J.C. Penny Corporation, Inc.*

By: /s/ Neil J. McNabnay (w/ permission)  
Thomas M. Melsheimer (Bar No.  
13922550)  
<[txm@fr.com](mailto:txm@fr.com)>  
Neil J. McNabnay (Bar No. 24002583)  
<[njm@fr.com](mailto:njm@fr.com)>  
Carl E. Bruce (Bar No. 24036278)  
<[ceb@fr.com](mailto:ceb@fr.com)>  
FISH & RICHARDSON P.C.  
1717 Main Street, Suite 5000  
Dallas, TX 75201  
Telephone: (214) 747-5070  
Facsimile: (214) 747-2091  
  
Proshanto Mukherji (*pro hac vice*)  
<[pvm@fr.com](mailto:pvm@fr.com)>  
FISH & RICHARDSON P.C.  
One Marina Park Drive  
Boston, MA 02110-1878  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906  
  
*Attorneys for Defendant  
The Go Daddy Group, Inc.*

By: /s/ Kate Hutchins

---

Mark G. Matuschak (*pro hac vice*)  
<[mark.matuschak@wilmerhale.com](mailto:mark.matuschak@wilmerhale.com)>

Donald R. Steinberg (*pro hac vice*)  
<[donald.steinberg@wilmerhale.com](mailto:donald.steinberg@wilmerhale.com)>

WILMER CUTLER PICKERING HALE AND  
DORR LLP  
60 State Street  
Boston, MA 02109  
Telephone: (617) 526-6000  
Facsimile: (617) 526-5000

Kate Hutchins (*pro hac vice*)  
<[kate.hutchins@wilmerhale.com](mailto:kate.hutchins@wilmerhale.com)>

WILMER CUTLER PICKERING HALE AND  
DORR LLP  
399 Park Avenue  
New York, NY 10011  
Telephone: (212) 230-8800  
Facsimile: (212) 230-8888

Daniel V. Williams, (*pro hac vice*)  
<[daniel.williams@wilmerhale.com](mailto:daniel.williams@wilmerhale.com)>

WILMER CUTLER PICKERING HALE AND  
DORR LLP  
1875 Pennsylvania Avenue NW  
Washington, DC 20006  
Telephone: (202) 663-6000  
Facsimile: (202) 663-6363

Michael E. Richardson (Bar No. 24002838)  
<[mrichardson@brsfirm.com](mailto:mrichardson@brsfirm.com)>

BECK REDDEN & SECREST  
1221 McKinney, Suite 4500  
Houston, TX 77010  
Telephone: (713) 951-6284  
Facsimile: (713) 951-3720

*Attorneys for Defendant Staples, Inc.*

