

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

**EOLAS TECHNOLOGIES §  
INCORPORATED and THE REGENTS §  
OF THE UNIVERSITY OF CALIFORNIA §**

**Plaintiffs, §**

**vs. §**

**ADOBE SYSTEMS INC., AMAZON.COM §  
INC., CDW CORPORATION, CITIGROUP §  
INC., THE GO DADDY GROUP, INC., §  
GOOGLE INC., J.C. PENNEY §  
CORPORATION, INC., STAPLES, INC., §  
YAHOO! INC., and YOUTUBE, LLC., §**

**Defendants. §**

**CASE NO. 6:09-CV-00446-LED**

**JURY TRIAL**

**PLAINTIFFS MOTION FOR JUDGMENT AS A MATTER OF LAW  
ON DEFENDANTS' ASSERTIONS OF INVALIDITY**

## **I. INTRODUCTION**

Plaintiffs The Regents of the University of California and Eolas Technologies Incorporated (“Plaintiffs”) hereby move for judgment as a matter of law under Federal Rules of Civil Procedure 50 on each and every Defendant’s assertions of invalidity, as there is insufficient evidence for a reasonable jury to find that any of the asserted claims of the ’906 patent and the ’985 patent are invalid.

### **LEGAL STANDARDS**

#### **A. Standard for Judgment as a Matter of Law**

The Court should grant a motion for judgment as a matter of law (“JMOL”) with regard to a particular issue when “there is no legally sufficient evidentiary basis for a reasonable jury to find for [the non-moving] party on that issue.” FED. R. CIV. P. 50(a); *see Reeves v. Sanderson Plumbing Prods., Inc.*, 530 U.S. 133, 149-50 (2000); *Guile v. United States*, 422 F.3d 221, 225 (5th Cir. 2005). The Court must review all of the evidence of record in deciding a motion for JMOL, “must draw all reasonable inferences in favor of the non-moving party, and . . . not make credibility determinations or weigh the evidence.” *Reeves*, 530 U.S. at 150; *see also Johns Hopkins Univ. v. Datascope Corp.*, 88 USPQ2d 1365, 1367 (Fed. Cir. 2008). In the Fifth Circuit, entry of judgment as a matter of law under Rule 50(b) is appropriate if evidence supporting the movant is “uncontradicted and unimpeached [or] if the facts and inferences point so strongly and overwhelmingly in favor of one party that the Court believes that [a] reasonable [jury] could not arrive at a contrary verdict.” *Med. Care Am., Inc. v. Nat’l Union Fire Ins. Co.*, 341 F.3d 415, 420 (5th Cir. 2003).

## II. ARGUMENTS

### A. Defendants Provided No Legally Sufficient, Evidentiary Basis for a Reasonable Jury to Find Claims 1 and 6 and Claims 1, 3, 10, 16, 18, 20, 22, 36, 38, 40, and 42 of the '985 Patent Invalid.

#### 1. Lack of Requisite Corroboration to Invalidate the '906 Patent and '985 Patent

“[T]he presumption of validity, 35 U.S.C. § 282, requires those challenging validity to introduce clear and convincing evidence on all issues relating to the status of the reference as prior art.” *Colucci v. Callaway Golf Co.*, 750 F. Supp. 2d 767, 773 (E.D. Tex. 2010) (citation omitted). As the U.S. Supreme Court held in the seminal case of *The Barbed Wire Patent*, 143 U.S. 275, 284 (1892), “[w]itnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves are not usually to be depended upon for accurate information.” Accordingly, a patent may not be invalidated solely on uncorroborated testimony. *See Finnigan Corp. v. Int’l Trade Comm’n*, 180 F.3d 1354, 1366-70 (Fed. Cir. 1999) (“The law has long looked with disfavor upon invalidating patents on the basis of mere testimonial evidence absent other evidence that corroborates that testimony.”); *Colucci v. Callaway Golf Co.*, 750 F. Supp. 2d 767, 773 (E.D. Tex. 2010) (“Testimonial evidence of invalidity must be corroborated, regardless of his or her level of interest.”).

Each and every Defendant failed to produce legally sufficient, clear and convincing evidence to corroborate its witnesses’ testimony that any version of Viola was, prior to the September 7, 1993 conception date, a public sale, printed publication, or otherwise qualifies as prior art under 35 U.S.C. § 102(a); a public sale, printed publication, or otherwise qualifies as prior art under 35 U.S.C. § 102(b); and/or that any version of Viola, Mediaview, Mosaic, and/or the embed tag met each and every limitation of any of the asserted claims of the '906 patent and '985 patent, either alone or in combination with one another.

## 2. Anticipation of the '906 Patent and '985 Patent

To establish anticipation under 35 U.S.C. § 102(a), a defendant must establish by legally sufficient, clear and convincing evidence that “the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.” Anticipation under section 102(a) requires the presence of each and every limitation of the claimed invention in the prior art reference. *Amgen Inc. v. F. Hoffmann-La Roche, Ltd.*, 580 F.3d 1340, 1366 (Fed. Cir. 2009). The requirement that the invention was “known or used by others in this country” “means knowledge or use which is accessible to the public.” *Carella v. Starlight Archery*, 804 F.2d 135, 139 (Fed. Cir. 1986) “A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1394-95 (Fed. Cir. 2008) (quoting *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006)).

To invalidate a patent under section 102(b), a defendant must establish by legally sufficient, clear and convincing evidence that the invention was “patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” 35 U.S.C. § 102(b). To be anticipatory, a reference must describe, either expressly or inherently, each and every claim limitation and enable one of skill in the art to practice an embodiment of the claimed invention without undue experimentation. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009).

Anticipation under section 102(g)(2) requires the defendant to establish by legally sufficient, clear and convincing evidence that “before such persons invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or

concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.” 35 U.S.C. § 102(g)(2).

Each and every Defendant failed to meet its burden to produce legally sufficient, clear and convincing evidence that any of the asserted claims of the '906 patent and the '985 patent are anticipated by any version of Viola. Specifically, each and every Defendant failed to prove that the following claim elements are met by any version of Viola by legally sufficient, clear and convincing evidence:

1) that any version of Viola satisfies the “wherein said first distributed hypermedia document includes an embed text format” limitation, as construed by the Court and as required by every asserted claim of the '906 patent and the '985 patent;

2) that any version of Viola satisfies the “wherein said object has type information ... to identify and locate an executable application external to the first distributed hypermedia document” limitation, as construed by the Court and as required by asserted claims 1 and 6 of the '906 patent and asserted claims 1, 3, 10,16, 18, 20, and 22 of the '985 patent;

3) that any version of Viola satisfies the “wherein the executable application is part of a distributed application” limitation, as construed by the Court and as required by asserted claims 36, 38, 40, and 42 of the '985 patent;

4) that any version of Viola satisfies the “receiving ... a portion of a distributed hypermedia document within a browser-controlled window” limitation, as construed by the Court and as required by every asserted claim of the '906 patent and the '985 patent;

5) that any version of Viola satisfies the “where the text formats are HTML tags” limitation, as construed by the Court and as required by claims 3, 18, and 22 of the ’985 patent.

In addition to the claim elements and failures of proof set forth above, each and every Defendant also failed to prove that:

1) any version of Viola was, prior to the September 7, 1993 conception date, a public sale, printed publication, or otherwise qualifies as prior art under 35 U.S.C. § 102(a);

2) any version of Viola was, more than one year prior to the November 17, 1994 filing date, a public sale, printed publication, or otherwise qualifies as prior art under 35 U.S.C. § 102(b); and

3) any person conceived of the claimed invention prior to the September 7, 1993 conception date, exercised reasonable diligence from their conception through actual reduction to practice, and actually reduced to practice their invention on or before the November 17, 1994 filing date under 35 U.S.C. § 102(g)(2).

### **3. Obviousness of the ’906 Patent and the ’985 Patent**

To invalidate a patent under section 103 of the Patent Statute, a defendant must establish by legally sufficient, clear and convincing evidence that “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a). To avoid hindsight analysis regarding combinations of prior art, courts require the presentation of “evidence from before the time of the invention in the form of some teaching, suggestion, or even mere motivation (conceivably found within the knowledge of an ordinarily skilled artisan) to make the variation or combination.” *Rolls-Royce, PLC v. United Techs. Corp.*, 603 F.3d 1325, 1338 (Fed. Cir. 2010). And while obviousness is a question of law based on underlying findings of fact, “the question of

motivation to combine may nonetheless be addressed on summary judgment or JMOL in appropriate circumstances.” *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1239 (Fed. Cir. 2010)

Each and every Defendant failed to meet its burden to produce legally sufficient, clear and convincing evidence that any claims of the '906 patent and the '985 patent are obvious under any combination of the following prior art references under 35 U.S.C. § 103: any version of Viola, Mediaview, Mosaic, and/or the embed tag.

Each and every Defendant specifically failed to prove the following facts by legally sufficient, clear and convincing evidence:

1) that it would have been obvious to one of ordinary skill in the art to combine any version of Viola, Mediaview, Mosaic, and/or the embed tag to create the claimed inventions of the '906 patent;

2) that it would have been obvious to one of ordinary skill in the art to combine any version of Viola, Mediaview, Mosaic, and/or the embed tag to create the claimed inventions of the '985 patent;

3) that one of ordinary skill in the art would have been motivated to combine any version of Viola, Mediaview, Mosaic, and/or the embed tag to create the claimed inventions of the '906 patent; and

4) that one of ordinary skill in the art would have been motivated to combine any version of Viola, Mediaview, Mosaic, and/or the embed tag to create the claimed inventions of the '985 patent.

#### **4. Written Description of the '906 Patent and the '985 Patent**

The Federal Circuit recently found that “the test for sufficiency [of the written description] is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing

date.” *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). “[T]he test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” Defendants bore the burden of proving by clear and convincing evidence that the claims of the patents-in-suit are invalid for a lack of written description. *Id.* at 1354.

Each and every Defendant failed to meet its burden to produce legally sufficient, clear and convincing evidence that the ’906 patent and the ’985 patent do not meet the written description requirement of 35 U.S.C. Section 112 because no Defendant offered any evidence that shows that the inventors failed to describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Each and every Defendant also failed to meet its burden to prove invalidity under any subsection of 35 U.S.C. § 112.

#### **5. Patent-Eligible Subject Matter of the ’906 Patent**

Patentability of an invention “is governed by Section 101 of the Patent Act, which establishes categories of patentable subject matter: . . . any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof[.]” 35 U.S.C. § 101. Each and every Defendant failed to meet its burden to produce legally sufficient, clear and convincing evidence that the ’906 patent and the ’985 patent do not claim patent-eligible subject matter under 35 U.S.C. Section 101 because each and every Defendant failed to offer any evidence that shows that the ’906 patent and the ’985 patent were not directed to statutory subject matter.



### III. CONCLUSION

For the foregoing reasons, Plaintiffs respectfully request that the Court grant their Motion for Judgment as a Matter of Law on Defendants' Assertions of Invalidity.

Dated: February 8, 2012.

**McKool Smith, P.C.**

*/s/ Mike McKool*

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**CERTIFICATE OF SERVICE**

Pursuant to Local Rule CV-5(a)(7), the undersigned certifies that the foregoing document was filed electronically on February 8, 2012. As such, counsel for Plaintiffs has served this Motion in electronic form on all counsel who have consented to electronic service.

/s/ Gretchen Curran  
Gretchen Curran