

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.; 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.

Adobe Systems Inc.; Amazon.com, Inc.; Apple
Inc.; CDW LLC; 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.; Oracle America, Inc. f/k/a Sun
Microsystems, Inc.; Texas Instruments Inc.;
Yahoo! Inc.; and YouTube, LLC,

Counterclaimants,

vs.

Eolas Technologies Incorporated,

Counterdefendant.

**DEFENDANTS' MOTION FOR PARTIAL SUMMARY JUDGMENT OF
INTERVENING RIGHTS**

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- Ex. D: Non-final rejection during the second reexamination of the '906 patent in light of the Cohen patent (July 30, 2007) [858 PH Ex. 3]
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- Ex. F: Final rejection during the second reexamination of the '906 patent in light of the Cohen patent (Apr. 18, 2008) [858 PH Ex. 8]
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I. INTRODUCTION

Defendants hereby move for partial summary judgment that the reexamined claims of U.S. Patent No. 5,838,906 are not “legally identical” to any original claim of the ’906 patent, thus giving rise to defenses under 35 U.S.C. § 252 including intervening rights. Like indefiniteness, whether claims are “legally identical” is a question of law related to claim construction, *see Laitram Corp. v. NEC Corp.*, 163 F.3d 1342, 1347 (Fed. Cir. 1998), and thus Defendants are filing this motion on the same day that their claim construction brief and motion for summary judgment of indefiniteness are due, *see* Docket Control Order (Apr. 9, 2010) [Docket No. 249].

This motion responds to the recent order stating, “The Court is very concerned that the large number of claims and claim terms in this case is unmanageable.” *See* Ex. L at 1. This motion, if granted, would significantly narrow the case by eliminating many accused products and all liability before February 3, 2009, the date when the second reexamination certificate for the ’906 patent issued. (The other patent-in-suit did not issue until later in 2009.) Otherwise it appears that Eolas will try to show infringement and damages for the ’906 patent stretching back to 2003 (i.e., six years before the complaint was filed, *see* 35 U.S.C. § 286), which implicates a tremendous number of accused products and websites from the 21 unrelated Defendants.

The basis for this motion is simple: Eolas made two sets of amendments during reexamination that changed the scope of all asserted claims, as summarized in the chart below:

	<u>Asserted '906 patent claims</u>									
	<u>1</u>	2	3	11	12	<u>6</u>	7	8	13	14
Intervening rights from Cohen amendment (Feb. 3, 2009)	x	x	x	x	x	x	x	x	x	x
Intervening rights from § 112, ¶ 2 amendment (Feb. 3, 2009)									x	x

II. STATEMENT OF ISSUES TO BE DECIDED

This motion presents the following issue for the Court to decide:

- After the amendments made to overcome the Cohen prior art, are claims 1–3, 6–8, and 11–14 of the '906 C2 reexamination certificate legally identical in scope to any claim in the '906 patent as originally issued? (No.)
- After the amendments made to comply with the requirements of § 112, ¶ 2, are claims 13–14¹ of the '906 C2 reexamination certificate legally identical in scope to any claim in the '906 patent as originally issued? (No.)

III. STATEMENT OF UNDISPUTED MATERIAL FACTS

A. Eolas made amendments during the second reexamination of the '906 patent to overcome a rejection based on the “Cohen” prior art

1. Claims 1–3 and 6–8 of the '906 patent as originally issued included the following limitations:

wherein said embed text format is parsed by said browser to automatically invoke said executable application to execute on said client workstation in order to display said object and enable ***interactive processing*** of said object within a display area created at said first location within the portion of said first distributed hypermedia document being displayed in said first browser-controlled window

See Ex. A.

2. On July 30, 2007, during the second reexamination of the '906 patent, the Examiner mailed a non-final rejection of claims 1–3 and 6–8 of the '906 patent in light of U.S. Patent No. 5,367,621 (“Cohen”). *See Ex. D at 24 [PH_001_0000786969]; see also Ex. C (Cohen patent).*

3. On September 27, 2007, the patent owner responded to the Examiner’s rejection with various arguments attempting to distinguish the Cohen reference, but the patent owner did not propose any amendments to the rejected claims. *See Ex. E.*

4. On April 18, 2008, the Examiner mailed a final rejection of claims 1–3 and 6–8 in light of Cohen. The Examiner’s final rejection included the following statements:

¹ The exact same issue applies to claims 9–10 of the '906 patent, but Eolas recently stated that it is dropping those claims, *see Ex. M*, so in reliance on Eolas’s representation, Defendants are not addressing claims 9–10 in this motion.

Patent Owner's arguments . . . , with respect to the Cohen reference, have been fully considered, but they are not persuasive.

. . . .

[I]n response to the Patent Owner's arguments on page 10, which argue that Cohen fails to expressly teach of the feature that "enable[s] interactive processing of said object", whereby, as noted above, the Patent Owner defines "interactive processing" as being a processing of the user utilizing the mouse or keyboard or similar device, that changes the structure or presentation of the object, thus being an interactive process. However, the current claim language does not specify this. Further, there is no requirement that the "interactive processing" be a process performed by the "user."

See Ex. F at 4 [PH_001_0000787214], 6 [PH_001_0000787216].

5. On June 17, 2008, the patent owner mailed amendments to the claims. The patent owner made the following amendments to claims 1–3 and 6–8 (where additions are shown with underlining, and deletions are shown with brackets):

wherein said embed text format is parsed by said browser to automatically invoke said executable application to execute on said client workstation in order to display said object and enable an end-user to directly interact with [interactive processing of] said object within a display area created at said first location within the portion of said first distributed hypermedia document being displayed in said first browser-controlled window

See Ex. G at 2 [PH_001_0000787262], 5 [PH_001_0000787265].

6. The patent owner included the following remarks with the amendments:

Claims 1 and 6 have now been amended to include the language that said executable application enables "an end-user to directly interact with said object" in order to obviate the grounds of rebuttal relating to interactive processing asserted by the examiner under his view of the broadest reasonable interpretation of claims 1 and 6.

See Ex. G at 11 [PH_001_0000787271].

7. The patent owner also added new claims 11 and 12, which have the same text found in original claims 4 and 5 except that they depend from claim 1 as amended above. The patent owner included the following remarks:

Claims 11 and 12 are the original claims 4 and 5 which depend on amended claim 1, and are thus allowable for the same reasons as claim 1.

See Ex. G at 9 [PH_001_0000787269], 10 [PH_001_0000787270].

8. The patent owner also added new claims 13 and 14, which have the same text found in original claims 9 and 10 except that they depend from claim 6 as amended above. The patent owner included the following remarks:

Claims 13 and 14 are the original claims 9 and 10 which depend on amended claims 6 and are thus allowable for the same reasons as claim 6.

See Ex. G at 9 [PH_001_0000787269], 10 [PH_001_0000787270].

9. On September 10, 2008, the Examiner mailed a Notice of Intent to Issue Ex Parte Reexamination Certificate (“NIRC”) indicating that the amendments shown above overcame the rejection based on the Cohen reference. See Ex. H.

10. The C2 reexamination certificate for the '906 patent issued on February 3, 2009, and included the amendments described above to claims 1–3, 6–8, and 11–14. See Ex. I.

11. The parties have agreed upon the following constructions:

<u>Claim Term(s)</u>	<u>Agreed-Upon Construction</u>
enable interactive processing of said object	allow the object to be processed based on the user's interaction
[enable / enabling] an end-user to directly interact with [said / the / an] object	allowing a user to directly interact with the object

See Ex. J at 3.

B. Eolas also made amendments during the second reexamination of the '906 patent to correct errors that made some claims invalid under § 112, ¶ 2

12. On June 17, 2008, during the second reexamination of the '906 patent, the patent owner added new claims 13 and 14, which were the same as original claims 9 and 10, respectively, except that they now depended from claim 6 *as amended* (and 7 and 8 as originally issued). In addition, the patent owner made the following changes to claims 9–10 and 13–14 (as compared to the language in original claims 9 and 10 when written in independent form), where additions are shown with underlining, and deletions are shown with brackets:

A computer program product . . . comprising . . . wherein additional instructions for controlling said controllable application reside on said network server, wherein said **[step of interactively controlling said controllable application] computer readable program code for causing said client workstation to interactively control said controllable application on said client workstation** includes

Compare Ex. A, with Ex. G at 6–9 [PH_001_0000787266–69].

13. The patent owner included the following remarks with the amendments:

Further, claim 9 has been amended to replace “said step of interactively controlling said controllable application” with — computer readable program code for causing said client workstation to interactively control said controllable application on said client workstation — to correct a typographical error that occurred when the method claim 4 was being converted to the computer program product claim 9.

. . . . Claims 13 and 14 are the original claims 9 and 10 which depend on amended claims 6 and are thus allowable for the same reasons as claim 6. Claim 13 has been changed to correct the typographical errors noted above regarding claim 9.

See Ex. G at 10 [PH_001_0000787270].

14. Eolas is not asserting the following claims against any Defendant in this action: claims 4–5 and 9–10 of the ’906 patent. See Ex. M.

IV. **ARGUMENT**

“The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). As shown by the cases cited below, this motion presents a question of law that is routinely decided by summary judgment.

A. **This motion only raises a question of law related to the issue of claim construction**

It is important to clarify precisely what Defendants are seeking by this motion. In short, Defendants are seeking a legal determination that none of the asserted claims in the ’906 C2 reexamination certificate is legally “identical” in scope to any claim in the original ’906 patent, meaning (i) there cannot be infringement of those claims before the ’906 C2 reexamination certificate issued on February 3, 2009, (ii) Defendants are entitled to “absolute intervening”

rights with respect to those claims, and (iii) this Court is permitted to grant Defendants “equitable intervening rights” with respect to those claims. However, to simplify this motion and avoid any possible factual questions, Defendants are not seeking at this time a determination of which specific products would be affected by “absolute intervening rights,” nor are Defendants seeking at this time a determination of what “equitable intervening rights,” if any, should be granted. This is discussed in more detail in the following paragraphs:

“The effect of a reexamined patent during the period before issuance of the reexamination certificate is governed by 35 U.S.C. § 307(b), which provides that the rules established in § 252 for reissued patents shall apply to reexamined patents.” *Bloom Eng’g Co. v. N. Am. Mfg. Co.*, 129 F.3d 1247, 1249 (Fed. Cir. 1997).

Under 35 U.S.C. §§ 252 & 307(b), if a claim is **narrowed** during reexamination, there are **three** consequences. First, there is no infringement for acts before the issuance of the reexamination certificate:

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are **identical**, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are **identical** with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

35 U.S.C. § 252, ¶ 1 (Supp. I 1996) (emphasis added).² “Once a determination is made that the

² The current version of § 252 uses the phrase “substantially identical” instead of the word “identical,” but that version does not apply to this case. The word “substantially” was added by the American Inventors Protection Act of 1999, Pub. L. No. 106-113, § 4507(8), 113 Stat. 1501A-552, -566. The effective date for this amendment is as follows: “Sections 4502 through 4507, and the amendments made by such sections, shall take effect on the date that is 1 year after the date of the enactment of this Act [*i.e.*, November 29, 2000] and shall apply to all applications filed under section 111 of title 35, United States Code, on or after that date, and all applications complying with section 371 of title 35, United States Code, that resulted from international applications filed on or after that date.” *Id.* § 4508, 113 Stat. at 1501A-566 to -567. The application for the ’906 patent was filed in 1994, *see* Ex. A, and thus the new law does not apply. In any event, Defendants contend that the new law would not change the outcome of this motion.

claims are not ‘identical’ within the meaning of the first paragraph of section 252, the defense of intervening rights under the second paragraph of section 252 can be raised.” *Westvaco Corp. v. Int’l Paper Co.*, 991 F.2d 735, 742 (Fed. Cir. 1993). Thus, a second consequence of a narrowing amendment during reexamination is “absolute intervening rights,” meaning an accused infringer has the absolute right to sell or continue using anything that was made, used, or purchased before the issuance of the reexamination certificate. *See* 35 U.S.C. § 252, ¶ 2, first sentence; *BIC Leisure Prods., Inc. v. Windsurfing Int’l, Inc.*, 1 F.3d 1214, 1220–21 (Fed. Cir. 1993). Third, if a claim is narrowed during reexamination, this Court is permitted to grant “equitable intervening rights” for the protection of investments made or business commenced before the issuance of the reexamination certificate. *See* 35 U.S.C. § 252, ¶ 2, second sentence; *BIC Leisure*, 1 F.3d at 1221; *Seattle Box Co. v. Indus. Crating & Packing, Inc.*, 731 F.2d 818, 830 (Fed. Cir. 1984) (suggesting possible equitable remedies).

The question of whether the claims of the ’906 C2 reexamination certificate are “identical” in scope to any claim in the original ’906 patent is the only substantive question raised by this motion. This is a question of law related to the issue of claim construction: “A determination of whether the scope of a . . . claim is *identical* with the scope of the original claim is a question of law.” *Westvaco*, 991 F.2d at 742 (emphasis added) (reversing and finding claim not “identical” as a matter of law); *accord Aspex Eyewear, Inc. v. E’Lite Optik, Inc.*, 552 F. Supp. 2d 620, 624 (N.D. Tex. 2008) (granting summary judgment), *appeal dismissed*, No. 2009-1051, 2010 WL 2383807 (Fed. Cir. June 11, 2010). “This rule flows from the general principle that ‘the interpretation and construction of patent claims, which define the scope of the patentee’s rights under the patent, is a matter of law, exclusively for the court.’” *Laitram Corp. v. NEC Corp.*, 163 F.3d 1342, 1347 (Fed. Cir. 1998) (reversing and finding claim not “identical” as a matter of law).

Before filing this motion, Defendants conferred with Eolas about the timing of this motion. *See* Ex. K. At first Eolas agreed that intervening rights should be decided at the same time as claim construction, but later Eolas stated that “[b]ecause intervening rights includes

factual determinations, we think it is improper to file such a motion prior to the close of fact discovery.” *Id.* In response to Eolas’s concerns, and to avoid any possible factual questions, Defendants are not seeking at this time a determination of which specific products would be affected by “absolute intervening rights,” nor are Defendants seeking at this time a determination of what “equitable intervening rights,” if any, should be granted. Defendants are only seeking a legal determination that none of the asserted claims in the ’906 C2 reexamination certificate is legally “identical” in scope to any claim in the original ’906 patent, which is a question of law related to the issue of claim construction.

B. No asserted claims in the ’906 C2 reexamination certificate are “legally identical” in scope to any original claim of the ’906 patent

1. Claims 1–3, 6–8, and 11–14 of the ’906 patent were narrowed during the second reexamination to overcome the Cohen prior art

Claims 1–3, 6–8, and 11–14 of the ’906 C2 reexamination certificate were all narrowed to overcome the Cohen prior art, and thus none is “identical” to any claim in the original ’906 patent. In particular, all of these claims were amended to replace the phrase “enable *interactive processing* of said object” with the phrase “enable *an end-user to directly interact with* said object.” *See* Fact Nos. 1–9. The new phrase is narrower than the old phrase because (i) it requires *direct* interaction and (ii) the interaction must be with a *user*. Indeed, that is why the amended claims were allowed over the Cohen prior art, while the original claims were rejected in light of the Cohen prior art. *See id.* Furthermore, the parties have stipulated that the two phrases have different meanings, *see* Fact No. 11, which confirms that they are not “identical” as a matter of law.

The Federal Circuit has repeatedly held that amending a claim during reexamination to overcome the prior art — as happened in this case — results in a finding that the amended claim is not “identical” to the original claim. *See Laitram*, 163 F.3d at 1348; *Bloom*, 129 F.3d at 1250–51. Furthermore, in a related context the Supreme Court has held that there is a *presumption* that every amendment made during prosecution was made for a substantial reason related to

patentability (i.e., the amendment substantively changed the scope of the claim). *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33 (1997).

A rejection indicates that the patent examiner does not believe the original claim could be patented. While the patentee has the right to appeal, his decision to forgo an appeal and submit an amended claim is taken as a concession that the invention as patented does not reach as far as the original claim. Were it otherwise, the inventor might avoid the PTO's gatekeeping role and seek to recapture in an infringement action the very subject matter surrendered as a condition of receiving the patent.

Festo, 535 U.S. at 734 (citations omitted).

The facts of this case are similar: faced with a rejection in light of the Cohen prior art, Eolas chose to amend the claims instead of appealing the rejection, thereby conceding that the amended claims are narrower than the original claims. Accordingly, Defendants are entitled to summary judgment that claims 1–3, 6–8, and 11–14 of the '906 C2 reexamination certificate are not “identical” to any claim in the original '906 patent, meaning there can be no infringement of those claims before the issuance of the '906 C2 reexamination certificate on February 3, 2009, and Defendants are entitled to “absolute intervening rights” with respect to those claims.

2. **Claims 13–14 of the '906 patent were changed during the second reexamination to correct errors that made the claims invalid under § 112, ¶ 2**

Claims 13–14 of the '906 C2 reexamination certificate were also substantively changed by another amendment during the second reexamination, providing a second reason why neither claim is “identical” to any claim in the original '906 patent. In particular, both of these claims were amended to replace the phrase “wherein said *step of interactively controlling* . . . includes” with the phrase “wherein said *computer readable program code* . . . includes.” *See* Fact Nos. 12–13.

The effect of these amendments was to correct an error that made the original claims indefinite under § 112, ¶ 2. Original claims 9–10 claimed an *apparatus* (“A computer program product”), and thus there was no antecedent basis for “said *step* of interactively controlling,”

which is a *method* limitation. *See* Fact No. 12. Furthermore, the Federal Circuit has held that a claim to both an apparatus and the method steps of using the apparatus is indefinite. *See IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (affirming summary judgment of indefiniteness). The amendments made during the second reexamination removed the method limitations and replaced them with apparatus limitations, thus curing the indefiniteness problems — and substantively changing the scope of the claims.

Accordingly, Defendants are entitled to summary judgment that claims 13–14 of the '906 C2 reexamination certificate are not “identical” to any claim in the original '906 patent, meaning there can be no infringement of those claims before the issuance of the '906 C2 reexamination certificate on February 3, 2009, and Defendants are entitled to “absolute intervening rights” with respect to those claims.

V. CONCLUSION

For all of these reasons, Defendants’ motion for partial summary judgment of intervening rights should be GRANTED as set forth in the proposed order accompanying this motion.

DATED: February 4, 2011

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CERTIFICATE OF SERVICE

I hereby certify that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3) on February 4, 2011.

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