UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF TEXAS

TYLER DIVISION

Eolas Technologies Incorporated,) *Plaintiff*,) vs.) 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*.))	No. 6:09-cv-00446-LED (filed Oct. 6, 2009)

<u>DEFENDANTS' MOTION FOR PARTIAL SUMMARY JUDGMENT OF INDEFINITENESS</u>

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Ex. I: Letter from plaintiff stating that "it will no longer assert the following claims against any Defendant in the above-captioned matter: U.S. Patent No. 5,838,906: Claims 4, 5, 9, and 10; U.S. Patent No. 7,599,985: Claims 12, 13, 14, 15, 32, 33, 34, 35, 44, 45, 46, and 47" (Jan. 25, 2011)

I. INTRODUCTION

Pursuant to the Court's Docket Control Order, *see* Docket No. 249, all Defendants hereby

move for partial summary judgment of indefiniteness with respect to claims 6–8 and 12–14 of

U.S. Patent No. 5,838,906, and claims 16–31 and 40–43 of U.S. Patent No. 7,599,985.

II. STATEMENT OF ISSUES TO BE DECIDED

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

- Are the following claims indefinite because they are insolubly ambiguous about whether the "additional instructions" must reside on the "network server" or the "client workstation": '906 claims 12 and 14?[1] (Yes.)

- Are the following claims indefinite because they are drafted to cover both an apparatus and a method of using that apparatus: '906 claims 6–8 and 13–14, and '985 claims 28–31?[2] (Yes.)

- If § 112, ¶ 6 does not apply, are the following claims indefinite because they use purely functional language: '906 claims 6–8 and 13–14, and '985 claims 16–31 and 40–43?[3] (Yes.)

- If § 112, ¶ 6 applies, are the following claims indefinite because they lack corresponding structure for an "executable application" that enables an end-user to "directly interact" with an object at the "first location": '906 claims 6–8 and 13–14, and '985 claims 16–31 and 40–43?[4] (Yes.)

III. 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.

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[1] The exact same issue applies to claims 5 and 10 of the '906 patent, and claim 15 of the '985 patent, but Eolas recently stated that it is dropping those claims, *see* Ex. I, so in reliance on Eolas's representation, Defendants are not addressing those claims in this motion.

[2] 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. I, so in reliance on Eolas's representation, Defendants are not addressing those claims in this motion.

[3] The exact same issue applies to claims 9–10 of the '906 patent, and claims 32–35 of the '985 patent, but Eolas recently stated that it is dropping those claims, *see* Ex. I, so in reliance on Eolas's representation, Defendants are not addressing those claims in this motion.

[4] The exact same issue applies to claims 32–35 of the '985 patent, and claims 9–10 of the '906 patent (to the extent that Eolas is correct that those claims should be construed to mean "directly interact" like all of the other claims, *see* Ex. F at 4), but Eolas recently stated that it is dropping those claims, *see* Ex. I, so in reliance on Eolas's representation, Defendants are not addressing those claims in this motion.

R. Civ. P. 56(a). As shown by the cases cited in the sections below, indefiniteness is a question

of law that is routinely decided by summary judgment.

A.   **The following claims are indefinite because they are insolubly ambiguous about whether the "additional instructions" must reside on the "network server" or the "client workstation": '906 claims 12 and 14**

Claims 12 and 14 of the '906 patent are insolubly ambiguous about whether the

"additional instructions" must reside on the "network server" or the "client workstation":

1.   **Statement of undisputed material facts**

1.   Claim 12 of the '906 patent (which depends from claims 1, 2, 3, and 11) includes

the following limitations:

> A method for running an application program in a computer network environment, comprising:
>
> providing at least *one client workstation* and *one network server* coupled to said network environment, wherein said network environment is a distributed hypermedia environment; . . .
>
> utilizing said browser to display, on said client workstation, at least a portion of a first hypermedia document *received over said network from said server*, . . .
>
> wherein *additional instructions* for controlling said controllable application *reside on said network server* . . .
>
> wherein *said additional instructions* for controlling said controllable application *reside on said client workstation*.

See Exs. B, D; *see also* Ex. A (reprinting claim language).

2.   Claim 14 of the '906 patent (which depends from claims 6, 7, 8, and 13) includes

all the same limitations shown above in bold. *See* Exs. B, D; *see also* Ex. A (reprinting claim

language).

2.   **Argument**

A claim is indefinite if it is "insolubly ambiguous." *See, e.g.*, *Halliburton Energy Servs.,*

Inc. v. M-I LLC, 514 F.3d 1244, 1249 (Fed. Cir. 2008) (affirming this Court's summary

judgment of indefiniteness).

Claims 12 and 14 of the '906 patent are indefinite because they are insolubly ambiguous about whether the "additional instructions" must reside on the "network server" or the "client workstation." First these claims state "additional instructions . . . reside on said ***network server***," but later these same claims state "***said*** additional instructions . . . reside on said ***client workstation***." *See* Fact Nos. 1–2. Thus it is insolubly ambiguous where the claimed "additional instructions" must reside.

Even if it were possible to imagine ways to rewrite the claims so that they make sense, that would not avoid a finding of indefiniteness. The Federal Circuit "repeatedly and consistently has recognized that courts may not redraft claims, whether to make them operable or to sustain their validity." *Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004) (refusing to correct non-sensical claim limitation that literally called for heating cookie dough until it was burned to a crisp); *accord Haemonetics Corp. v. Baxter Healthcare Corp.*, 607 F.3d 776, 781 (Fed. Cir. 2010) (similar).

B. **The following claims are indefinite because they are drafted to cover both an apparatus and a method of using that apparatus: '906 claims 6–8 and 13–14, and '985 claims 28–31**

Claims 6–8 and 13–14 of the '906 patent, and claims 28–31 of the '985 patent, are drafted to cover both an apparatus and a method of using that apparatus:

1. **Statement of undisputed material facts**

3. Independent claim 6 of the '906 patent (and dependent claims 7–8 and 13–14) include the following limitations:

> ***A computer program product*** for use in a system having at least one client workstation and one network server coupled to said network environment, wherein said network environment is a distributed hypermedia environment, the computer program product comprising:
>
> a computer usable medium having computer readable program code physically embodied therein, said computer program product further comprising:
>
> computer readable program code for causing said client workstation to execute a browser application to parse a first distributed hypermedia document to identify text formats

included in said distributed hypermedia document and to respond to predetermined text formats to initiate processes specified by said text formats;

computer readable program code for causing said client workstation to utilize said browser to display, on said client workstation, at least a portion of a first hypermedia document received over said network from said server,

wherein the portion of said first hypermedia document *is displayed* within a first browser-controlled window on said client workstation,

wherein said first distributed hypermedia document includes an embed text format, located at a first location in said first distributed hypermedia document, that specifies the location of at least a portion of an object external to the first distributed hypermedia document,

wherein said object has type information associated with it *utilized* by said browser *to identify and locate* an executable application external to the first distributed hypermedia document, and

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 . . . .

See Exs. B, D; *see also* Ex. A (reprinting claim language).

4. Independent claim 28 of the '985 patent includes the following limitations:

One or more computer readable media encoded with software comprising <u>an executable application</u> for use in a system having at least one client workstation and one network server coupled to a network environment, operable to:

cause the client workstation to display an object and enable an end-user to directly interact with said object while the object is being displayed within a display area created at a first location within a portion of a hypermedia document being displayed in a browser-controlled window,

wherein said network environment is a distributed hypermedia environment,

wherein said client workstation *receives*, over said network environment from said server, at least one file containing information to enable said browser application to display, on said client workstation, at least said portion of said distributed hypermedia document within said browser-controlled window,

wherein said executable application is external to said file,

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> wherein said client workstation *executes* said browser application, with the browser application responding to text formats to initiate processing specified by the text formats,
>
> wherein at least said portion of the document *is displayed* within the browser-controlled window,
>
> wherein an embed text format which corresponds to said first location in the document *is identified* by the browser,
>
> wherein the embed text format specifies the location of at least a portion of said object external to the file,
>
> wherein the object has type information associated with it,
>
> wherein the type information *is utilized* by the browser *to identify and locate* said executable application, and
>
> wherein the executable application *is automatically invoked* by the browser, in response to the identifying of the embed text format.

See Ex. E; *see also* Ex. A (reprinting claim language).

5. Claim 29 of the '985 patent states: "The *method* of claim 28 where: the information to enable comprises text formats." *Id.*

6. Claim 30 of the '985 patent states: "The *method* of claim 29 where: the text formats are HTML tags." *Id.*

7. Claim 31 of the '985 patent states: "The *method* of claim 28 where: the information contained in the file received comprises at least one embed text format." *Id.*

2. Argument

The Federal Circuit has adopted the rule that "[a] single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph." *IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (affirming summary judgment of indefiniteness).

Claims 6–8 and 13–14 of the '906 patent, and claims 28–31 of the '985 patent, violate the rule of *IPXL* because they are drafted to cover both an apparatus and a method of using that apparatus. For example, independent claim 28 of the '985 patent is directed to both an apparatus ("an executable application") and to various method steps performed by a separate "browser

application" (e.g., "is identified," "is utilized . . . to identify and locate," "is automatically

invoked"). *See* Fact No. 4. Dependent claims 29–31 of the '985 patent confirm that claim 28

has method steps: they refer to "[t]he ***method*** of claim 28." *See* Fact Nos. 5–7.

Similarly, independent claim 6 of the '906 patent (and dependent claims 7–8 and 13–14)

are directed to both an apparatus ("A computer program product") and to various method steps

(e.g., "is displayed," "utilized . . . to identify and locate," "is parsed . . . to automatically

invoke"). *See* Fact No. 3.

The claims in this case are similar to the claim that was found indefinite in *IPXL*:

> The ***system of claim 2*** [including an input means] wherein the
> predicted transaction information comprises both a transaction type
> and transaction parameters associated with that transaction type,
> ***and the user uses the input means*** to either change the predicted
> transaction information or accept the displayed transaction type
> and transaction parameters.

430 F.3d at 1384 (emphasis in original). The claim in *IPXL* was directed to an apparatus ("The

system of claim 2") yet the claim included a method step ("the user uses the input means") and

thus it was found indefinite as a matter of law.

The claims in this case are also similar to the claims this Court found indefinite in *Ariba,*

Inc. v. Emptoris, Inc., No. 07-90, 2008 WL 3482521 (E.D. Tex. Aug. 7, 2008) (Clark, J.):

> 31. ***A bidding device*** operated by a potential seller during an on-
> line electronic auction, said bidding device comprising software
> that displays information about the auction to the potential seller
> and enables the potential seller to submit bids electronically to the
> auction; . . .
>
> wherein a bid submitted by the potential seller operating the
> bidding device ***is compared*** to the corresponding bid ceiling of the
> potential seller operating the bidding device, and the bidding
> device communicates a bid message to the potential seller
> operating the bidding device in accordance with the results of the
> comparison . . . .

Id. at *6–*7. "Because claim 31 recites both an apparatus and a method, it is indefinite and

therefore invalid under 35 U.S.C. § 112(2). Its dependent claims, claims 32–36 and 38, are

likewise invalid." *Id.* at *8 (granting summary judgment).

The same is true here, and thus claims 6–8 and 13–14 of the '906 patent, and claims 28–31 of the '985 patent, should be found indefinite as a matter of law.

C. If § 112, ¶ 6 does not apply, then the following claims are indefinite because they use purely functional language: claims 6–8 and 13–14 of the '906 patent, and claims 16–31 and 40–43 of the '985 patent

Claims 6–8 and 13–14 of the '906 patent, and claims 16–31 and 40–43 of the '985 patent, use purely functional language:

1. Statement of undisputed material facts

8. Claims 6–8 and 13–14 of the '906 patent include the following limitations:

> A *computer program product* for use in a system having at least one client workstation and one network server coupled to said network environment, wherein said network environment is a distributed hypermedia environment, *the computer program product comprising*:
>
> a computer usable medium having computer readable program code physically embodied therein, said computer program product further comprising:
>
> *computer readable program code for <u>causing</u>* said client workstation to execute a browser application to parse a first distributed hypermedia document to identify text formats included in said distributed hypermedia document and to respond to predetermined text formats to initiate processes specified by said text formats;
>
> *computer readable program code for <u>causing</u>* said client workstation to utilize said browser to display, on said client workstation, at least a portion of a first hypermedia document received over said network from said server, wherein . . . .

See Exs. B, D; *see also* Ex. A (reprinting claim language).

9. Claims 16–19 of the '985 patent include the following limitations:

> One or more *computer readable media* encoded with software comprising computer executable instructions, for use in a distributed hypermedia network environment, wherein the network environment comprises at least one client workstation and one network server coupled to the network environment, *and when the software is executed <u>operable to</u>*:
>
> receive, at the client workstation from the network server over the network environment, at least one file . . .
>
> <u>*cause*</u> the client workstation to utilize the browser to . . . .

See Ex. E; *see also* Ex. A (reprinting claim language).

10.   Claims 20–23 of the '985 patent include the following limitations:

> A ***method*** of serving digital information in a computer network environment having a network server coupled the network environment, and where the network environment is a distributed hypermedia environment, ***the method comprising***:
>
> ***communicating*** via the network server with at least one client workstation over said network ***in order to <u>cause</u> said client workstation to***:
>
> receive, over said network environment from said server, at least one file . . .
>
> execute, at said client workstation, a browser application . . . .

See Ex. E; *see also* Ex. A (reprinting claim language).

11.   Claims 24–27 of the '985 patent include the following limitations:

> A ***method*** for running an executable application in a computer network environment, wherein said network environment has at least one client workstation and one network server coupled to a network environment, ***the method comprising***:
>
> ***<u>enabling</u>*** an end-user to directly interact with an object by utilizing said executable application to interactively process said object while the object is being displayed within a display area created at a first location within a portion of a hypermedia document being displayed in a browser-controlled window, wherein . . . .

See Ex. E; *see also* Ex. A (reprinting claim language).

12.   Claims 28–31 of the '985 patent include the following limitations:

> One or more ***computer readable media*** encoded with software comprising an executable application for use in a system having at least one client workstation and one network server coupled to a network environment, ***<u>operable to</u>***:
>
> ***<u>cause</u>*** the client workstation to display an object and enable an end-user to directly interact with said object . . . wherein . . . .

See Ex. E; *see also* Ex. A (reprinting claim language).

13.   Claims 32–35 of the '985 patent include the following limitations:

> A ***method*** for serving digital information in a computer network environment, ***said method comprising***:

> *communicating* via a network server with at least one client workstation over said computer network environment *in order to cause said client workstation to*:
>
> receive at said client workstation, over said computer network environment from said server, at least one file . . .
>
> utilize an executable application . . . .

See Ex. E; *see also* Ex. A (reprinting claim language).

14. Claims 40–43 of the '985 patent include the following limitations:

> A *method* of serving digital information in a computer network environment having a network server coupled to said computer network environment, and where the network environment is a distributed hypermedia network environment, *the method comprising*:
>
> *communicating* via the network server with at least one remote client workstation over said computer network environment *in order to cause said client workstation to*:
>
> receive, over said computer network environment from the network server, at least one file . . .
>
> execute, at said client workstation, a browser application . . . .

See Ex. E; *see also* Ex. A (reprinting claim language).

2.   Argument

As part of the bargain for receiving a patent, an applicant must provide "claims *particularly pointing out and distinctly claiming* the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2 (emphasis added). Given this requirement, the Supreme Court has long held that "a patentee may not broaden his product claims by describing the product in terms of *function*." *Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 371 (1938) (finding functional claims indefinite as a matter of law); *see also Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 11–14 (1946) (reversing and finding functional claims indefinite as a matter of law); *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 234–37 (1942) (same). "The limits of a patent *must be known* for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public." *Gen. Elec. Co.*, 304 U.S. at 364 (emphasis added).

In 1952, Congress authorized functional claiming, but only in accordance with the provisions of § 112, ¶ 6 — so-called "means-plus-function" claims. *See Ex Parte Miyazaki*, 89 U.S.P.Q.2d 1207, 1216–17 (BPAI 2008) (discussing history of § 112, ¶ 6). "This statutory provision was meant to preclude the overbreadth inherent in open-ended functional claims . . . which effectively purport to cover any and all means so long as they perform the recited functions." *Halliburton Energy*, 514 F.3d at 1256 n.7 (affirming summary judgment of indefiniteness).

Eolas insists that § 112, ¶ 6 does not apply to any of its claims. *See* Ex. F at 3. If that is true, then claims 6–8 and 13–14 of the '906 patent, and claims 16–31 and 40–43 of the '985 patent, are indefinite as a matter of law because they employ purely functional language.[5] These claims fall into four categories:

1. '985 claims 24–27: "the method comprising: ***enabling*** . . ." *See* Fact No. 11.

2. '985 claims 20–23 and 40–43: "communicating . . . ***in order to cause***" *See* Fact Nos. 10, 13–14.

3. '985 claims 16–19 and 28–31: "software . . . ***operable to . . . cause***" *See* Fact Nos. 9, 12.

4. '906 claims 6–8 and 13–14: "computer readable program code ***for causing*** . . . ." *See* Fact No. 8.

The language above — "enabling," "in order to cause," "operable to cause," and "for causing" — is precisely the type of language that has been deemed functional in previous cases. *See, e.g.*, *Gen. Elec. Co.*, 304 U.S. at 368 ("A filament . . . of such size and contour ***as to prevent*** substantial sagging"); *Ex Parte Rodriguez*, 92 U.S.P.Q.2d 1395, 1404–05 (BPAI 2009) ("system configuration generator ***configured to*** generate"); *Ex Parte Miyazaki*, 89 U.S.P.Q.2d at 1217 ("sheet feeding area ***operable to*** feed").

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[5] Even if the terms at issue are construed as being in means-plus-function form, however, that does not mean that the claims are necessarily valid under § 112. For example, as discussed in the next section, even if § 112, ¶ 6 applies, Defendants contend that the claims are indefinite for failing to disclose a corresponding algorithm for certain limitations. *See infra* § III.D, p. 11. More generally, Defendants have additional invalidity arguments under § 112 that are not raised in this motion.

The first group of claims identified above purports to cover ***any*** method for "enabling" various results. *See* Fact No. 11. The second group above purports to cover ***any*** method of "communicating" that "causes" various results. *See* Fact Nos. 10, 13–14. While the third and fourth groups above refer to "software" and "code" for a computer, *see* Fact Nos. 8–9, 12, that does not make those claims any less functional: "For a patentee to claim a means for performing a particular function and then to disclose only a ***general purpose computer*** as the structure designed to perform that function amounts to pure ***functional*** claiming." *Aristocrat Techs. Australia PTY Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008) (emphasis added).

Accordingly, if § 112, ¶ 6 does not apply, then claims 6–8 and 13–14 of the '906 patent, and claims 16–31 and 40–43 of the '985 patent, should be found indefinite because of their purely functional language.

D. **If § 112, ¶ 6 applies, then the following claims are indefinite because they lack corresponding structure for an "executable application" that enables an "end-user" to "directly interact" with an object at the "first location": claims 6–8 and 13–14 of the '906 patent, and claims 16–31 and 40–43 of the '985 patent**

The specification fails to disclose an algorithm for how the claimed "executable application" performs the claimed function of enabling an "end-user" to "directly interact" with an object at the "first location":

1. **Statement of undisputed material facts**

15.   Claims 6–8 and 13–14 of the '906 patent include the following limitations:

> executable application to execute on said client workstation in order to display said object and ***enable an end-user to <u>directly interact</u> with said object within a display area created at said <u>first location</u>*** within the portion of said first distributed hypermedia document being displayed in said first browser-controlled window

See Exs. B, D; *see also* Ex. A (reprinting claim language).

16.   Claims 16–31 and 40–43 of the '985 patent include limitations similar to those block quoted above (i.e., an "executable application" that enables an "end-user" to "directly interact" with an object at the "first location"). *See* Ex. E; *see also* Ex. A.

17.   Defendants contend that the limitations block quoted above and appearing in claims 6–8 and 13–14 of the '906 patent, and claims 16–31 and 40–43 of the '985 patent, are subject to § 112, ¶ 6. *See* Ex. F at 3; Ex. G.

18.   When asked to identify the corresponding structure(s)/act(s) for the terms that Defendants contend are subject to § 112, ¶ 6, Eolas did not name any specific structures, acts, algorithms, or source code, and instead provided line and column numbers for lengthy passages in the specification. *See* Ex. H.

2.   Argument

The Federal Circuit has placed limits on § 112, ¶ 6 claims that rely on computer code as the disclosed structure: Where "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) (emphasis added).

When a specification fails to disclose an algorithm for performing the claimed function, the Federal Circuit has consistently held that the claim is indefinite as a matter of law. *See, e.g.*, *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1382–85 (Fed. Cir. 2009) (affirming summary judgment of indefiniteness); *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1365–67 (Fed. Cir. 2008) (same); *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1340–41 (Fed. Cir. 2008) (same); *Aristocrat Techs. Australia PTY Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1334–36 (Fed. Cir. 2008) (same); *see also Network-1 Sec. Solutions, Inc. v. Cisco Sys., Inc.*, 692 F. Supp. 2d 632, 645–48 (E.D. Tex. 2010) (Davis, J.) (following *Aristocrat* and granting summary judgment of indefiniteness).

In this case, Defendants have argued in their claim construction brief being filed today that § 112, ¶ 6 applies to certain limitations in claims 6–8 and 13–14 of the '906 patent, and claims 16–31 and 40–43 of the '985 patent. If Defendants are correct that § 112, ¶ 6 applies, however, then those claims are indefinite under *Aristocrat* and its progeny because they fail to

disclose an algorithm for how the claimed "executable application" performs the claimed function of "enabl[ing] an end-user to directly interact with 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."

The disclosure in the patent is insufficient to meet the definiteness requirement of *Aristocrat* and its progeny for two independent reasons. First, the patent provides no algorithms concerning the claimed "executable application." With respect to the claimed "browser," by way of contrast, the patent attaches source code, *see id.* at 8:5–:15, and the patent provides flowcharts showing how the browser handles certain routines, *see id.* figs.7–8. The detail provided about the "browser" stands in marked contrast to the lack of detail provided about the "executable application." Tellingly, Eolas itself has failed to identify any specific algorithm corresponding to the claimed "executable application." *See, e.g.*, Ex. H at 7, Nos. 4–5.

Second, the patent provides no algorithms concerning how the claimed "executable application" enables an end-user to "***directly interact*** with 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." Figure 9, and the text accompanying that figure, merely shows a panel (354) that is ***outside*** the browser window (350) that, at most, allows a user to ***indirectly*** interact with the object while the object is being displayed at the "first location" (352). *See* Ex. B at 16:18–:22 & fig.9. The patent states "[a]nother possibility is to have panel window 354 ***within*** Mosaic window 350," *id.* at 16:17–:18 (emphasis added), but the patent provides no explanation, let alone an algorithm, for accomplishing that "possibility."

Thus if § 112, ¶ 6 applies to the "executable application" limitations in claims 6–8 and 13–14 of the '906 patent, and claims 16–31 and 40–43 of the '985 patent, then those claims are indefinite as a matter of law under *Aristocrat*.

IV.   CONCLUSION

For all of these reasons, Defendants' motion for partial summary judgment of indefiniteness should be GRANTED as set forth in the proposed order.

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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