

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' CLAIM CONSTRUCTION BRIEF**

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## EXHIBITS

- Ex. A: The current claim language of the patents-in-suit
- Ex. B: U.S. Patent No. 5,838,906 (issued Nov. 17, 1998)
- Ex. C: First reexamination certificate for the '906 patent (issued June 6, 2006)
- Ex. D: Second reexamination certificate for the '906 patent (issued Feb. 3, 2009)
- Ex. E: U.S. Patent No. 7,989,985 (issued Oct. 6, 2009)
- Ex. F: Joint Claim Construction and Prehearing Statement (Oct. 29, 2010) [Docket No. 479]
- Ex. G: Defendants' proposed corresponding structure(s)/act(s) for those terms that Defendants contend are subject to § 112, ¶ 6 (Oct. 29, 2010)
- Ex. H: Eolas's proposed corresponding structure(s)/act(s) for those terms that Defendants contend are subject to § 112, ¶ 6 (Oct. 29, 2010) [Docket No. 479-1]
- 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)
- Ex. J: Compilation of intrinsic and extrinsic evidence in support of Defendants' proposed constructions (with citations to the underlying evidence)
- Ex. K: Excerpts from Douglas Young, *The X Window System, Programming and Applications with Xt* (1990)
- Ex. L: *Rich-Text Format (RTF) Specification* (June 1992)
- Ex. M: Doyle et al., "Processing Cross-sectional Image Data for Reconstruction of Human Developmental Anatomy from Museum Specimens," *Newsletter of the Association for Computing Machinery Special Interest Group on Biomedical Computing*, vol. 13, No. 1, ACM Press, pp. 9-15 (Feb. 1993)
- Ex. N: Excerpts from *Object Linking and Embedding OLE 2.01 Design Specification* (Sept. 27, 1993)
- Ex. O: Ang et al., "Integrated Control of Distributed Volume Visualization Through the World-Wide-Web." *Proceedings of Visualization 1994*, IEEE Press, Washington, D.C. (Oct. 1994)
- Ex. P: Excerpts from *Eolas, et al. v. Microsoft, Corp.*, No. 99-C-626, Jury Instructions (N.D. Ill. Aug. 7, 2003)
- Ex. Q: Excerpts from *Barron's Dictionary of Computer Terms* (2d ed. 1989)
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- Ex. T: Excerpts from *Academic Press Dictionary of Science and Technology* (1992)
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- Ex. X: Excerpts from *21st Century Dictionary of Computer Terms* (1994)
- Ex. Y: Excerpts from *Microsoft Press Computer Dictionary* (2d ed. 1994)
- Ex. Z: Excerpts from Silicon Graphics, Inc., *Annual Report*, Securities and Exchange Commission, Fiscal Year ended June 30, 1994
- Ex. AA: WWW-VRML, "FYI... press release", at 1 (Aug. 30, 1994) [PA-0000333362]
- Ex. BB: WWW-VRML, "FYI... press release", at 1 (Aug. 31, 1994) [PA-0000333364]
- Ex. CC: WWW-VRML, "FYI... press release", at 1 (Aug. 31, 1994) [PA-0000333365]
- Ex. DD: Excerpts from David Martin Dep., *Eolas Techs Inc. v. Microsoft Corp.*, No. C-99-0212 (N.D. Ill. January 20-21, 2000)
- Ex. EE: Excerpts from Cheong Ang Dep., *Eolas Techs Inc. v. Microsoft Corp.*, No. C-99-0212 (N.D. Ill. January 21-22, 2000)
- Ex. FF: Excerpts from Michael Doyle Dep., *Eolas Techs Inc. v. Microsoft Corp.*, No. 99-C-626 (N.D. Ill. February 28-March 1, 2000)
- Ex. GG: Excerpts from Trial Tr., *Eolas Techs Inc. v. Microsoft Corp.*, No. 99-C-626 (N.D. Ill. July-Aug. 2003)
- Ex. HH: Excerpts from Eolas's Memorandum In Support of Claim Construction, *Eolas Techs Inc. v. Microsoft Corp.*, No. 99-C-626 (N.D. Ill. Oct. 14, 2000)

**The following packets of documents are being filed separately:**

- "906 PH": Excerpts from prosecution history of U.S. Patent No. 5,838,906
- "359 PH": Excerpts from abandoned application No. 09/075,359
- "831 PH": Excerpts from first reexamination of the '906 patent (No. 90/006,831)
- "563 PH": Excerpts from interference involving the '906 patent (No. 105,563)
- "858 PH": Excerpts from second reexamination of the '906 patent (No. 90/007,858)
- "985 PH": Excerpts from prosecution history of U.S. Patent No. 7,989,985

## **I. INTRODUCTION**

Eolas's proposed constructions stretch the claims beyond their proper scope. The alleged invention was a minor modification to the Mosaic browser, a popular browser at the time. The claims purportedly provide only two distinctions over Mosaic: (i) eliminating the need for a user to "click" before interacting with an object (such as a movie), and (ii) displaying the object inline in the webpage rather than in a separate "pop-up" window. To secure allowance of an invention so close to the prior art, Eolas was repeatedly required to narrow the claims during prosecution. The prosecution histories span 15+ years and are immense.<sup>1</sup> Although Eolas trumpets the fact its claims ultimately survived — after countless arguments and amendments — it is imperative that the claims be construed against the entirety of that lengthy prosecution, which Eolas's brief all but ignores.

## **II. LEGAL ISSUES**

### **A. The entire intrinsic record must be considered when construing the disputed claims**

The earlier '906 patent was reexamined twice between 2003 and 2008. The first reexamination ended with a 73-page "Examiner's Statement of Reasons for Patentability," *see* 831 PH Ex. 19, and the second reexamination ended with amendments to the claims and a four-page "Examiner's Statement of Reasons for Patentability," *see* 858 PH Ex. 11.

The record from those reexaminations is intrinsic evidence that must be considered when construing the claims. In particular, an examiner's reasons for allowance is powerful, unbiased, intrinsic evidence of "how one skilled in the art understood the term at the time the application was filed." *Geomas (Int'l) Ltd. v. Idearac Media Servs.-West, Inc.*, No. 2:06-cv-475-CE, 2008 WL 4966933, at \*13 (E.D. Tex. Nov. 20, 2008) (quoting *Salazar v. Procter & Gamble Co.*, 414 F.3d 1342, 1347 (Fed. Cir. 2005)). "Because an examiner in reexamination can be considered

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<sup>1</sup> The complete prosecution histories from the Patent Office span hundreds of thousands of pages. To make this amount of information more manageable for the Court, Defendants have excerpted and highlighted the most relevant evidence and compiled it on a term-by-term basis (along with other relevant intrinsic and extrinsic evidence) as Exhibit J to this brief.

one of ordinary skill in the art, his construction of the asserted claims carries *significant weight*<sup>2</sup> and provides the “*expert view* of the PTO.” *St. Clair Intellectual Prop. Consultants, Inc. v. Canon Inc.*, No. 2009-1052, 2011 WL 66166, at \*5–\*6 (Fed. Cir. Jan. 10, 2011) (unpublished).

Remarkably, Eolas argues that the examiner’s reasons for allowance “place *no* constraints on claim scope.” Eolas Br. at 9, 22 (citing *Salazar*, 414 F.3d at 1347). But in *Salazar*, the examiner’s statements were made at a time when the PTO regulations provided that silence in the face of an examiner’s statement “shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.” *Salazar*, 414 F.3d at 1345. In 2000, however, that specific provision in the regulations was *deleted* with the intention that “the failure of an applicant to comment on damaging reasons for allowance would give rise to a *presumption* of acquiescence to those reasons, and the negative inferences that flow therefrom.” *Changes To Implement the Patent Business Goals*, 65 Fed. Reg. 54,604, 54,633 (Sept. 8, 2000) (amending 37 C.F.R. § 1.104(e)). Here, the examiner’s reasons for allowance in the first and second reexamination were made after 2000 — after lengthy back-and-forth argument — and Eolas never responded to the examiners’ statements. Accordingly, it should be presumed that Eolas acquiesced to the examiner’s reasoning.

Finally, the reasons for allowance in the two reexaminations of the earlier ’906 patent affect the scope of the claims in *both* asserted patents. *See, e.g., Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1349 (Fed. Cir. 2004) (“the prosecution history of one patent is relevant to an understanding of the scope of a common term in a second patent stemming from the same parent application”). Indeed, when Eolas added the claims that issued in the later ’985 patent, Eolas argued that the claims were patentable for the same reasons provided by the examiner in the earlier reexamination of the ’906 patent, *see* Ex. J at 145, and the ’985 patent was specifically allowed for the same reasons as provided in both reexaminations of the ’906 patent, *see* Ex. J at 149.

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<sup>2</sup> Unless stated otherwise, all emphasis in quotes throughout this brief has been added.



**B. The prosecution history and specification trump Eolas’s recently manufactured “claim differentiation” arguments**

In a transparent attempt to avoid the consequences of the lengthy prosecution histories, Eolas repeatedly invokes the doctrine of claim differentiation. *See* Eolas Br. at 12, 15, 16–17, 19, 20. But the doctrine of claim differentiation is “not a hard and fast rule and will be overcome by a contrary construction dictated by the written description or prosecution history.” *Regents of University of Cal. v. Dakocytomation Cal., Inc.*, 517 F.3d 1364, 1375 (Fed. Cir. 2008) (quoting *Seachange Int’l, Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1369 (Fed. Cir. 2005)). In short, the doctrine of claim differentiation cannot be utilized to “broaden claims beyond their correct scope.” *Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, 438 F.3d 1374, 1381 (Fed. Cir. 2006) (rejecting a construction based on claim differentiation where it was “not consistent with the overall context of this invention and this field of art as described in the specification”).

Most of Eolas’s claim differentiation arguments rest entirely on dependent claims submitted by amendment in the later ’985 prosecution some fourteen years after the original application was filed and ten years after the original ’906 patent issued. *See* Eolas Br. at 12, 15, 16–17, 19, 20. In essence, Eolas is arguing that by adding *dependent* claims to a *later* issued patent, it *retroactively* broadened *all* the claims — even claims in the *earlier* issued patent — notwithstanding the 15+ years of prosecution premised on a narrower construction. Not one of the cases cited by Eolas supports that untenable position. And the closest case on point rejected that argument out of hand. *See ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1376 (Fed. Cir. 2009) (rejecting claim differentiation argument where dependent claims were added “years after the filing date of the original patents, the issuance of the [asserted] patents, and the introduction of the allegedly infringing . . . products”).

**III. LEVEL OF ORDINARY SKILL**

Eolas asserts, without any support, that “one of ordinary skill in the art in the 1994 time frame would have had a Bachelor of Science degree, or its equivalent, in computer science.” *See* Eolas’s Br. at 3. However, it does not appear that any of the claim construction disputes here rest upon whether the skilled artisan is fresh out of school or has 30 years of experience. Rather,

the disputes focus on the meaning of computer-science terms. As such, the Court need not resolve the applicable level of skill, but need only rely on the parties' agreement that the applicable field is computer science.

#### IV. ARGUMENT

##### A. “executable application”

<u>Claim Term(s)</u>	<u>Defendants' Proposed Construction</u> <sup>3</sup>	<u>Eolas's Proposed Construction</u>
executable application	a native binary program that remains separate from the browser and is not part of an operating system or a utility	any computer program code, that is not the operating system or a utility, that is launched to enable an end-user to directly interact with data

Eolas urges, without analysis, that the Court blindly adopt the construction of “executable application” used in the prior Microsoft litigation. *See* Eolas Br. at 8. Eolas’s suggestion should be rejected for two reasons. First, the reexaminations have altered the intrinsic record materially since the prior ruling. Thus, a proper construction now requires an independent review of the entire intrinsic record, including that added during the reexaminations. *See St. Clair*, 2011 WL 66166, at \*5–\*7 (adopting new constructions in light of reexamination proceedings, despite prior inconsistent claim construction in different litigation involving same patent). Second, the previous construction was issued before the decision in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), which repudiated the methodology behind the previous construction. The fundamental premise of the previous construction for “executable application” was that “*absent a disclaimer*, the claims of the ’906 patent are not limited to the embodiments listed in the specification.” *See Eolas Techs. Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1336 (Fed. Cir. 2005). That approach to claim construction — which results in overly broad constructions by de-emphasizing the importance of the specification — was rejected en banc by *Phillips*. *See, e.g., Nystrom v. TREX Co.*, 374 F.3d 1105, 1110–13 (Fed. Cir. 2004) (construing claim broadly,

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<sup>3</sup> To focus the disputes as framed by Eolas’s opening brief, and to simplify the issues for the Court to decide, Defendants have streamlined their proposed constructions for several claim terms.

before *Phillips*), *superseded and withdrawn* by 424 F.3d 1136, 1142–46 (Fed. Cir. 2005) (construing the same claim narrowly, after *Phillips*).

As discussed above, the two reexaminations of the '906 patent are important intrinsic evidence that affect the scope of the claims in both asserted patents. *See supra* § II.A, pp. 1–2. First, the reexaminations show that Eolas's proposed construction for "executable application" is too narrow in one respect because it appends "enabl[ing] an *end-user* to *directly* interact with data."<sup>4</sup> During the second reexamination — which was after the Federal's Circuit's decision in *Eolas* — the Patent Office considered the broadest *reasonable* interpretation of "executable application" and concluded that this limitation was disclosed in the Cohen prior art even though Cohen did *not* enable an end-user to directly interact with data. *See* Ex. J at 20–23. To overcome the Cohen prior art, Eolas narrowed its claims by adding the limitations "enabl[ing] an end-user to directly interact with data," *see* Ex. J at 24, thus conceding that these limitations are not inherent in the definition of "executable application." To accept Eolas's proposed construction for "executable application" would make all of the limitations that Eolas added elsewhere in the claims superfluous.

Second, the reexaminations confirm that Eolas's proposed construction is too broad in other respects, because it could encompass non-native and non-binary code such as scripts. During the first reexamination, the examiner reviewed the specification and concluded that a script running within a webpage could *not* be an "executable application" because (i) a script must be interpreted at runtime before being executed (which is slow), whereas the patent teaches that the "executable application" must have "instruction[s] in *binary* form that is a member of

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<sup>4</sup> It is unclear why this phrase was included in the claim construction in the Microsoft litigation. It does not appear that either party included this phrase in their proposed constructions, *see* Ex. HH, nor does it appear that either party ever disputed the inclusion of this phrase in the final claim construction, *see Eolas*, 399 F.3d at 1336–38. In short, it does not appear that this phrase was material to any issue in the Microsoft litigation, which is all the more reason this phrase should not be blindly adopted in this litigation. Instead, the term "executable application" should be independently construed by this Court after examining all the relevant intrinsic and extrinsic evidence — especially the new intrinsic evidence from the subsequent reexaminations.

the *native* instruction set of the microprocessor (i.e., a *binary machine language* instruction)” which is much faster, *see* Ex. J at 18–19, and (ii) the script *merges* with the browser, whereas the patent teaches that the “executable application” remains *discrete and separate* from the browser, *see* Ex. J at 17, 20.

The examiner’s construction for “executable application” during the first reexamination is consistent with the specification. The specification does not use the phrase “executable application”; it refers to “application client 210,” *see, e.g.*, ’906 Fig. 5, and (more generally) an “application program,” *see, e.g.*, ’906 at 13:11–:15. The specification shows that “application client 210” is *discrete and separate* from “browser client 208”: the two are separate boxes running in separate processes. *See, e.g.*, ’906 at 8:66–:67 & Fig. 5, 10:17–:19.

The examiner’s construction during the first reexamination is also consistent with the original prosecution, where the applicants argued that a script within a webpage could not be an “executable application.” *See* Ex. J at 10–11. Finally, the examiner’s construction during the first reexamination is also consistent with the definitions found in technical dictionaries, which confirm that “executable” means *native binary* (i.e., “machine”) code that can be executed directly (not a script, which must be interpreted), and “application” means a complete program (*not* a routine or library that merges with other code):

<u>“executable” dictionary definition</u>	<u>“application” dictionary definition</u>
“ <i>executable</i> file”: “A file that contains program code that cannot be understood by humans but can be <i>directly executed</i> by the computer.” Ex. B at 27.	“ <i>application</i> ”: “A <i>computer program</i> designed to help people perform a certain type of work” Ex. B at 28.
“ <i>executable</i> program”: “[U]sually refers to a <i>compiled</i> program that has been translated into <i>machine code</i> in a format that can be loaded into memory and run.” Ex. B at 29.	“computer program”: “The term usually implies a <i>self-contained entity</i> , as opposed to a routine or <i>library</i> .” Ex. B at 28.

**B. “automatically invoke”**

<u>Claim Term(s)</u>	<u>Defendants’ Proposed Construction</u>	<u>Eolas’s Proposed Construction</u>
automatically [invoking / invoke] [the / said] executable application	the executable application is launched to permit a user to interact with the object without any intervening activation of the object by the user	automatically calling or activating the executable application
executable application is automatically invoked by the browser		executable application is automatically called or activated by the browser

The primary dispute over “automatically invoke” is whether the claims cover an executable application that cannot be used until the user *clicks* to activate the object. Eolas suggests that its proposed construction could cover users who must *click* before interacting with the object — precisely how the prior art worked.<sup>5</sup> Eolas had to narrow its claims to overcome that prior art, so Eolas should not be allowed to recapture what it surrendered to secure allowance of its claims.

The term “automatically invoke” was added to the claims during prosecution to overcome the prior-art Mosaic browser. *See* Ex. J at 36. The applicants distinguished Mosaic on the basis that it required the user to *click* on a hyperlink before being able to interact with the object. *See* Ex. J at 37 (“the external application is not automatically invoked . . . but rather it is invoked by an interactive command given by the user, namely *interactively selecting* the URL anchor”).

Next the applicants had to overcome a rejection based on the Koppolu (i.e., OLE) prior art. OLE was prior-art technology from Microsoft that allowed, for example, an Excel spreadsheet to be embedded into a Word document. Importantly, the applicants admitted that with the OLE prior art, an executable application “can be automatically invoked . . . at document

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<sup>5</sup> Eolas also invites legal error by suggesting no construction is necessary. *See* Eolas Br. at 9–10. To the contrary, “[w]hen the parties present a fundamental dispute regarding the scope of a claim term, it is the court’s duty to resolve it.” *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008) (vacating and remanding because district court failed to resolve dispute about construction for “only if”).

rendering time,” but the applicants argued that this was *not* the claimed “automatically invoking” because “editing [i.e., interactive] capabilities are invoked *only after the containee object has been interactively activated by the user.*” See Ex. J at 39 (emphasis in original). See generally 906 PH Ex. 16 at 12–13. The OLE design specification confirms that an “.EXE” application for an object may be invoked and “executing” in the background while the user-interface (UI) for the object is still “Inactive” — meaning the user must *click* to activate the object before being permitted to interact with the object. See Ex. J at 50, 52, 54. Thus, according to the applicants, even if an executable application is invoked without involvement of the user, that does not qualify as “automatically invoking” within the meaning of the claimed invention if the user must click on something before being able to interact with the object.

The applicants repeatedly argued that their invention avoided the need for a “click.” See Ex. J at 37–41. And, ultimately, the examiner allowed the claims in response to these arguments. See Ex. J at 41. The first reexamination saw a replay of this result as the applicants again overcame the prior art by emphasizing that the prior art required the user to manually “click,” whereas the claimed invention automatically invokes the executable application as soon as an embed text format is parsed. See Ex. J at 42–44.<sup>6</sup> And again the examiner agreed: “The web browser [in the claimed invention] invokes the claimed ‘executable application’ *immediately* after an ‘EMBED’ tag is parsed.” Ex. J at 45. “Toye [in the prior art] teaches that ‘automatically invoking’ . . . is performed by selection, and not by parsing.” Ex. J at 46; see also *id.* at 47.

The ’985 patent was allowed for the same reasons set forth by the examiner in the first reexamination of the ’906 patent. See Ex. J at 49. Thus for all asserted claims, the proper construction of “automatically invoke” requires that the executable application is launched to

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<sup>6</sup> The applicants repeated these arguments again during the second reexamination. The applicants submitted the declaration of an expert who opined, “[A]utomatically invoke . . . requires that the executable application be invoked automatically, that is, without requiring any action such as a mouse click from the user. . . . Automatic invocation was an important improvement in the claimed ’906 technology over the prior art Mosaic browser. Automatic invocation allowed the object to appear *immediately* when the user visited the enclosing web page.” Ex. J at 48.

permit a user to interact with the object *without* any intervening activation of the object by the user. Indeed, the inventors themselves testified that “automatically invoke” excludes any mouse click before the user can interact with the object: “Q. So if a mouse click were required first, it would be outside the scope of this patent[?] A. Correct.” Ex. J at 55.

Eolas’s primary response to all of this evidence is a claim-differentiation argument based on the later ’985 patent. *See* Eolas Br. at 11–13. But as explained above, claim differentiation is merely a tool of construction that cannot overcome the constructions adopted during prosecution to overcome the prior art. *See supra* § II.B, p. 3. Indeed, it would be a disservice to the hard work of the patent examiners and to the public’s right to rely on the public record if a dependent claim added over a decade later could simply negate the entire prosecution history.

A secondary dispute between the parties concerns the term “invoke.” Eolas’s proposed construction does not address *any* of the intrinsic evidence and simply adopts a dictionary definition. *See* Eolas Br. at 10–11. That method of claim construction was expressly rejected by the Federal Circuit sitting en banc. *See Phillips*, 415 F.3d at 1320–22 (rejecting methodology of *Texas Digital*). In stark contrast, Defendants’ construction for “invoke” is “launch” because the specification uses the two terms interchangeably. *See* Ex. J at 34–36. For example, “When a browser program *invokes* a viewer program, the viewer is *launched* as a separate process.” ’906 at 3:15–:16. Later, the specification says “[w]hen browser client 208 encounters embedded program link 214, it *invokes* application client 210,” *id.* at 9:41–:42, and then in Figure 8A at step 290, the specification shows: “*launch* external application,” *see id.* at 15:9–:12. “The interchangeable use of the two terms is akin to a definition equating the two.” *Edwards Lifesciences LLC v. Cook Inc.*, 582 F.3d 1322, 1329 (Fed. Cir. 2009).

C. “text formats”

<u>Claim Term(s)</u>	<u>Defendants’ Proposed Construction</u>	<u>Eolas’s Proposed Construction</u>
text formats <sup>7</sup>	tags or symbols that specify document formatting	text that initiates processing

A “text format” is a tag or symbol, not simply any “text” as Eolas proposes (thus reading “formats” out of the claim). *See* ’906 at 14:10–:23. Eolas itself acknowledges that “a text format can be a ‘word, tag or symbol.’” Eolas Br. at 15. Eolas complains that Defendants have omitted the term “word” from their definition, but the “words” described in the patent (’906 at 14:26) are the *content* of the document to be displayed, not the means of formatting it (*i.e.* the text format). *See, e.g.*, ’906 at 14:18–:26 & Fig. 7A; Ex. J at 63 (“A browser parses a received document to identify HTML tags which specify various aspects of the document’s appearance and links to other documents.”).

As shown by the specification, text formats were something that existed in the prior art. *See, e.g.*, ’906 at 1:53–2:6 (discussing prior art hypertext systems, including HTML and Hypercard). The prior-art text formats, such as HTML, defined tags or symbols with special meaning to the browser’s parser for linking documents together as well as for marking up text for other formatting. *Id.* at 1:53–2:6, 2:44–:47, 12:54–13:18, 14:12–:23. For example, “HTML employ[ed] particular instructions, known as ‘tags’ to determine the appearance of a Web page. A tag is designated by placing the instruction within the symbols < >.” *Dow Jones & Co. v. Abblaise Ltd.*, 606 F.3d 1338, 1340–41 (Fed. Cir. 2010) (describing how HTML and tags worked in the early 1990s). The specification consistently refers to such tags and symbols as the basis for formatting a document and establishing links between documents and other objects. *See, e.g.*, ’906 at 1:53–:60, 2:44–:47, 5:24–:38, 9:24–:39, 9:55–:58, 11:56–12:8, 12:54–15:57.

Eolas’s proposal to define *text formats* as any text that initiates processing reads out the claim term “formats”; finds no support in the specification; and would render superfluous other

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<sup>7</sup> The Joint Claim Construction Statement erroneously referred to “text format” (singular) whereas the claims say “text formats” (plural).



claim language explicitly calling for such processing.

**D. “embed text format” / “first location”**

<u>Claim Term(s)</u>	<u>Defendants’ Proposed Construction</u>	<u>Eolas’s Proposed Construction</u>
embed text format, <sup>8</sup> located at a first location in said first distributed hypermedia document	tag located at the place in the received document where the embedded object will appear within the displayed document	embed text format located at a first location in the first distributed hypermedia document
embed text format [which] correspond[s/ing] to [a / said] first location in the document	tag located at the place in the received file where the embedded object will appear within the displayed document	embed text format which relates to a first location in the document

**Embed text format:** The term “embed text format” is not a term of art, nor is it found in the written description or original claims. It was coined by the inventors and added by amendment on August 20, 1996. *See* Ex. J at 61. The parties disagree on two points: first, the structure of the embed text format; and second, its location relative to the object it embeds.

Structurally, the specification and prosecution history demonstrate that the claimed embed text format is not just any text format, but a special tag. (Eolas merely incorporates its overbroad definition of “text format,” discussed above.) First, the only alleged support in the specification for the “embed text format” limitation is the EMBED *tag*. *See, e.g.,* Ex. J at 77 (identifying the EMBED tag as the “embed text format”); *see also id.* at 72 (similar understanding expressed by examiner’s reasons for allowance); ’906 at 12:54–13:36. Second, during prosecution, the inventors attempted to distinguish over the prior art by arguing that the claimed embed text format is a “special tag” not found in the prior art. Ex. J at 74. The inventors also distinguished their embed text format from other structures, such as an executable

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<sup>8</sup> Defendants originally proposed “embed text format” (on its own) as a separate phrase for construction, but Defendants now believe that the disputes between the parties with respect to both “embed text format” and “first location” can more efficiently be decided by addressing all disputes in the context of the longer phrase shown above.

script embedded in a document, confirming that the term cannot be construed as broadly as Eolas proposes. *See* Ex. J at 62.

**At a first location ('906 patent):** Turning to the location of the embed text format, the claims, specification and prosecution history show that it must appear in the same place (in the page's source code) as the display of the object occurs (in the displayed document). First, the claim language supports this view. All the claims containing the language being construed (i.e. all claims in the '906 patent) require, first, that the "embed text format [is] located ***at a first location*** in [the] first distributed hypermedia document," and second, that the object is eventually "display[ed] . . . within a display area created ***at said first location*** within the portion of said first distributed hypermedia document being displayed . . ." Thus, the claims require the embed text format and the display area to both be located at the same location — the "***first location***" — in the hypermedia document.

Second, the specification supports this interpretation. The only embodiment of an "embed text format" disclosed is the EMBED tag of Table II. *See* '906 at 12:56–65. This tag, however — while it includes elements by which to specify the type and source of the object and the dimensions of the display area — does ***not*** include elements that specify where the display area will appear in the displayed document. *See also* '906 at 12:65–13:31 (describing the EMBED tag). Thus, the display area's position must be specified by the position of the EMBED tag itself.

During prosecution and the two reexaminations, Eolas repeatedly advanced precisely this view of the invention. *See, e.g.*, Ex. J at 79–80 ("[In t]he present invention . . . [t]he external application ***displays . . . the object*** in a display window created within the portion of the document being displayed . . . ***at the location within the document of the embed text format.***"); *see also* Ex. J at 80 (Declaration of Michael D. Doyle; Applicants' Response at 2 (Dec. 23, 1997); Ex. J at 82 (Response to Office Action at 7 (Nov. 29, 2001)). *See generally* Ex. J at 79–85.

In fact, Eolas attempted to distinguish no fewer than three prior art references on the

ground that they did not display the object at the location of the embed text format. *See, e.g.*, Ex. J at 80 (“[In Mosaic,] a display window is not created in the first hypermedia document ***at the location in the document of the embed text format as required by the claim.***”); Ex. J at 83 (“[Cohen’s] LDESC tags cannot be the embed text format, because they do not satisfy the required claim element ‘wherein said first distributed hypermedia document includes an embed text format, located at a first location . . .’ ***This claim element requires that the embedded object be displayed at a location in the distributed hypermedia document (e.g., the Web page) that corresponds to the location of the embed text format within the document. . . . The LDESC tag does not appear in the document at the required location.*** Instead, the LDESC (link description) tag appears in the document file’s prologue.”); Ex. J at 84 (distinguishing NoteMail on the same grounds).

**Corresponding to a first location ('985 patent):** The '985 patent’s claims contain subtly different language than the '906’s. The '985 claims still require the object to be displayed at the first location in the document, but they require the embed text format to “correspond to,” rather than “be located at,” that location. Eolas argues that this change frees the embed text format of all locational restraints. In Eolas’s view, the embed text format now need only “relate to” the first location in some unspecified way. *See* Eolas Br. at 18–19. Read in context, the language does not support this broad interpretation.

Three pieces of context matter here. The first is the specification, which, as discussed above, describes only embodiments where the display and embed text format are co-located. The second is their common prosecution and reexamination history, also discussed above, in which Eolas repeatedly emphasized that the disclosed invention required this co-location. The third is the context in which the “corresponds to” language was introduced by amendment on April 11, 2008, *see* 985 PH Ex. 11, which shows that the changed language was meant to preserve, rather than eliminate, the co-location requirement. Before these amendments, the claims conflated the source document (which contains, for example, the text formats) and the displayed version of that document (which contains the display area where the object is

displayed), calling both the “distributed hypermedia document.” The amendments, however, distinguished between them, calling the former a “file,” and the latter a “document.” *See id.* Since the embed text format and the display area were now conceptualized as being contained in different entities (a “file” versus a “document”), it no longer made sense to say they were “located at” the same location. Thus, to *preserve* the co-location requirement, it was necessary to amend the claims to say that they were in *corresponding* locations in the two entities. This is exactly what the amendments did.

Two other pieces of evidence support this view. First, Eolas described the original claim elements of the ’906 patent in a similar way during reexamination, confirming that the ’985 patent broke no new ground. *See Ex. J* at 83 (“[The] *located at* a first location [element] . . . requires that the embedded object be displayed at a location in the distributed hypermedia document (e.g., the Web page) that *corresponds to* the location of the embed text format within the document. . . .”). Second, the Examiner at one point instructed Eolas to identify support for the newly amended claims. In response, Eolas did not highlight the “corresponds to” language as a new element requiring support, and listed as support only the specification’s EMBED tag — which is co-located with the display area. *See Ex. J* at 85. Eolas thus represented that the new language was not materially different from the former “located at” limitation.

As explained above, Eolas’s claim differentiation theory based on claims 8 and 9 of the later ’985 patent cannot broaden the claims beyond their correct scope. *See supra* § II.B, p. 3. In any event, Eolas’s claim differentiation argument is baffling, since neither claim 8 nor claim 9 recites limitations that are applicable to this issue.<sup>9</sup>

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<sup>9</sup> Claim 8 makes no mention of the “embed text format” or where the object must be embedded in the document. Similarly, Claim 9 concerns how the “specifying” action is accomplished, not where the object is embedded in the document.

**E. “specifies the location of at least a portion of [an / said] object”**

<u>Claim Term(s)</u>	<u>Defendants’ Proposed Construction</u>	<u>Eolas’s Proposed Construction</u>
specifies the location of at least a portion of [an / said] object	specifies the location of at least a portion of [an / said] object <sup>10</sup>	specifies the location of at least part of an object

Defendants believe that the jury should accord this limitation its common meaning. The common meaning of “specifies” is “to name or state explicitly or in detail.” *See* Ex. S at 1132. This is consistent with the intrinsic evidence, which discloses that the embed text format specifies the location by *nam<sup>ing</sup> explicitly* the address where the object or portion thereof is to be found. *See, e.g.*, ’906 at 2:44–:47 (“the mechanism for *specifying* and locating a linked object . . . is an HTML ‘element’ that **includes an object address in the format of a Uniform Resource Locator (URL)**”); ’906 at 14:66–:67 (“[t]he data object *specified* **by the URL** in the EMBED tag”).

Initially, Eolas conceded this limitation should have its common and ordinary meaning, but now Eolas announces it can no longer abide that meaning. Eolas must overcome a heavy presumption. *See Epistar Corp. v. ITC*, 566 F.3d 1321, 1334 (Fed. Cir. 2009) (“heavy presumption” that terms carry their ordinary and customary meaning).

The embed text format must do more than merely somehow “*indirectly*” provide *un*specified “information about where to get the object’s data,” *see* Eolas’s Br. at 17 & n.12. Eolas distinguished the “Khoyi” prior art reference during prosecution for the very reason that the embed text format there did not “*explicitly define*” a link to the object, such as by providing the “*precise location of a data file on a disk drive.*” *See* Ex. J at 92.<sup>11</sup>

<sup>10</sup> Where “specifies” has its common meaning: “to name or state explicitly or in detail.” *See Merriam-Webster’s Collegiate Dictionary* 1132 (9th ed. 1991), *available at* Ex. S.

<sup>11</sup> Eolas likewise asserted the location of the object could not be indirectly “specified,” arguing Khoyi did not anticipate where the actual “definition” of the link referenced by Khoyi’s “link marker” was not stated explicitly in the document, but was set forth in a separate data structure (a “link table”) used to resolve the object’s actual address. *See* Ex. J at 92. Eolas also asserted that the use of scripts and variables was insufficient to *specify* an object’s location. *See* Ex. J at 91–92 (overcoming Mercury Project rejection).

Eolas supports its construction with self-serving statements made by its paid consultant (Felten), *see* Eolas Br. at 17, but such expressions are entitled to little weight. *See, e.g., Honeywell v. ITT Indus., Inc.*, 452 F.3d 1312, 1319 (Fed. Cir. 2006). This is particularly so where submitted in a re-examination occurring years after claims containing the disputed term were originally issued. Nor can Eolas circumvent this evidence by invoking “claim differentiation,” especially where based solely upon a single dependent claim, in a later-filed patent, submitted fourteen years after the original application was filed. *See supra* § II.B, p. 3.

**F. “identify an embed text format”**

<b><u>Claim Term(s)</u></b>	<b><u>Defendants’ Proposed Construction</u></b>	<b><u>Eolas’s Proposed Construction</u></b>
identify[ing] an embed text format	detecting an embed text format during parsing of a hypermedia document	detecting an embed text format
an embed text format . . . is identified		an embed text format is detected

The phrase “identifying an embed text format” appears only in the later ’985 patent. Each independent claim of the ’906 patent, by contrast, recites “said embed text format is *parsed*.” In the ’985 patent, Eolas moved the term “parsed” into dependent claims and added the term “identifying” to the independent claims. Eolas is now attempting to use the doctrine of claim differentiation to expand the scope of “identifying an embed text format” beyond the specification’s disclosure. This is improper. *See supra* § II.B, p. 3.

The specification describes identifying an embed text format as a *substep* of parsing (i.e., it is *narrower* than parsing): “At step 258, a check is made as to whether the current tag is the EMBED tag.” ’906 at 14:26–:28. This description appears in a paragraph describing *parsing*, specifically the “HTMLparse.c” file and its “HTMLparse” routine. ’906 at 14:12–:39. The paragraph refers to Figure 7A, which shows the identifying step 258 referred to above is part of the HTMLparse routine. ’906 at Fig. 7A & 14:16–:17 (“This first routine HTML parse, is entered at step 252....”). During prosecution of the ’985 patent, the examiner required the applicants to cite support in the specification for each claim limitation. Not surprisingly, for the

“identifying an embed text format” limitation, the applicants cited only one passage: “a check is made to whether the current tag is the EMBED tag,” described above. *See* Ex. J at 100.

Accordingly, “identifying an embed text format” must occur *during parsing of a hypermedia document*. There is no other support in the specification for a broader construction.

**G. “object”**

<b><u>Claim Term(s)</u></b>	<b><u>Defendants’ Proposed Construction</u></b>	<b><u>Eolas’s Proposed Construction</u></b>
object	information presentable to a user of a computer system, which is not a program and which does not include source code or byte code	text, images, sound files, video data, documents or other types of information that is presentable to a user of a computer system

The parties agree that an “object” encompasses “information presentable to a user of a computer system.” However, Eolas’s proposed construction is both incomplete and incorrect, and Defendants’ proposed construction is required, because the intrinsic evidence precludes an “object” from being (or including) a software program, source code, or byte code.

Each of the fifteen independent claims of the asserted patents recites both an “object” and separate “executable application” software that renders the object interactive. That uniform description is repeated in the specification, which teaches that the “application client 210” (the “executable application” of the claims) is software that is used to display the object. *See, e.g.*, ’906 at 9:31–10:16. Consistent with the requirements of the claims, the specification teaches that the “objects” that are displayed and rendered interactive are “data objects” that are presentable to a user, such as “text, images, sounds files, video, additional documents, etc.” ’906 at 3:33–:37; *see also id.* at 2:14–:17 (“text, images, sound files, video data, documents or other types of information that is presentable to a user of a computer system”) & 1:64–:65, 2:17, 2:29–:30, 2:56–:61, 3:27, 4:60–:65, 6:26–:47, 9:16–:17, 9:27–:28, 9:38, 9:50, 9:59–:67 (each referring to the display or manipulation of “data objects”). The specification does not teach that the claimed “executable application” software (the “application client 210” in the specification) controls or otherwise acts upon another software program in an object; the specification only describes embodiments in which the executable application is used to display and manipulate data such as

images and videos. '906 at 2:56–3:37; 4:60–5:23; 8:63–11:51; Figs. 1, 8A, 9, 10. While Eolas's brief relies upon the "other types of information that is presentable to a user of a computer system" language from the specification (*see* Eolas Br. at 21), such information cannot include a software program, which is *not* information that is "presentable" to a user for viewing and manipulation.

Given that each independent claim expressly requires that the "executable application" itself "enable" the interactivity of the "object" (*see, e.g.*, '906 claims 1 and 4; '985 claims 1 and 16), they leave no room for other software programs, including any software programs in the "object," to enable that interactivity. Indeed, if the claimed object could include its own software program that enabled the required interactivity, then the claimed executable application, and the claimed role that it plays in enabling the interactivity of the object, would be rendered superfluous. Such a result should be avoided. *See Mathworks, Inc. v. Comsol AB*, No. 06-334, 2008 WL 393809, at \*4 (E.D. Tex. Feb. 12, 2008) ("[b]edrock principles of claim construction counsel against a construction that renders additional limitations superfluous") (quoting *Hyperion Solutions Corp. v. OutlookSoft Corp.*, 422 F. Supp. 2d 760, 772 (E.D. Tex. 2006)); *Merck & Co. v. Teva Pharmaceuticals USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005).

Eolas's argument that an object may include a software program also is contrary to the claim language providing that the client workstation "display" the object "within a display area" to an end-user. *See, e.g.*, '906 claims 1 and 6; '985 claims 1 and 16. While an "object" such as a document, picture, or video can be "displayed" in a "display area," nothing in the claims suggests that a *software program* ever is or can be so displayed. Rather, the claims specifically recite that the end-user "interacts" with an object that is "displayed" in the "display area." *See id.* Indeed, as Eolas points out in its own brief, the crux of the invention was "to embed interactive *content* directly into previously-static web pages." Eolas Br. at 5; *see also id.* at 7 (an "object" "is what the user interacts with and manipulates") & 6 ("one of the stated goals of the patents-in-suit was to disclose 'a system that allows the accessing, display and manipulation of large amounts of data, especially image data [*e.g.* a video or a 3D image], over the Internet . . .'")



(quoting '906 at 6:21–:25).

The fact that the claimed “object” is not a software program (nor source code or byte code) is driven home in the prosecution history of the '906 patent and a related application that ultimately was abandoned (No. 09/075,359 “the '359 application”). In reexamination of the '906 patent, the Patent Office distinguished the prior art by squarely addressing the issue of whether the claimed “object” may be a software program or include source or byte code. Specifically, the Examiner’s reasons for allowance state: “[T]he scope of the claimed '906 external ‘object’ clearly does *not* read upon a high-level *source code PROGRAM*, such as a Viola script, nor does it read upon an object in *byte-code form*.” Ex. J at 117 (capitalization in original). Eolas never disputed this statement, and in any event such examiner statements carry significant weight in claim construction. *See supra* § II.A, pp. 1–2. And in the '359 application prosecution history, the Patent Office rejected claims for lack of written description in the specification, stating explicitly that “[t]here is no disclosure in the specification that the ‘executable application is a computer program which runs other programs.’” Ex. J at 116. Rather than disagree, Eolas abandoned this application.

Eolas attempts to salvage its construction by pointing to the specification’s reference to “program objects.” Eolas Br. at 21–22. However, the *claims* do not recite “program objects” and, as established above, the specification makes clear that the *claimed* “objects” that are “displayed” within the “display area” and rendered “interactive” by the “executable application” are data objects, not programs. Moreover, the specification never describes “program objects” as being acted upon by an executable application, as each independent claim requires for the claimed “object.” See '906 at abstract; 1:22; 3:52–:53; 3:58; 6:51; 6:67; 7:4. As such, the claims, specification, and prosecution history all convincingly support a construction of “object” that excludes programs, source code, and byte code.

H. “hypermedia document” / “distributed hypermedia document” / “file containing information”

<u>Claim Term(s)</u>	<u>Defendants’ Proposed Construction</u>	<u>Eolas’s Proposed Construction</u>
[first] hypermedia document	a document received by the browser that includes hyperlinks to graphics, sound, video or other media	a document that allows a user to click on images, sound icons, video icons, etc., that link to other objects of various media types, such as additional graphics, sound video, text, or hypermedia or hypertext documents
[first] distributed hypermedia document		[first] hypermedia document that allows a user to access a remote data object over a network
file containing information to enable a browser application to display [, on] [said/the] [client workstation,] at least [a / said] portion of [a / said] distributed hypermedia document	a file containing information received by the browser that includes hyperlinks to graphics, sound, video or other media	the file contains information to allow the browser application to display at least part of a distributed hypermedia document

Throughout the intrinsic evidence, the patentees use the term “hypermedia document” to refer to a document that is received and presented by a browser in a computer system, and that includes links to “graphics, sound, video or other media” according to the hypertext format. ’906 at 2:14–:20; *see also* Ex. J at 124–49. While Eolas contends that Defendants’ proposed construction improperly reads in limitations, the patents-in-suit do not disclose any hypermedia documents that are *not* received by the browser or that do *not* contain hyperlinks.

First, every independent claim of the ’906 patent explicitly recites the use of a “*browser* to display . . . at least a portion of a first hypermedia document *received* over said network from said server.” ’906 claims 1, 4, 5, 6, 9, 10.<sup>12</sup> The specification of the ’906 patent also describes the hypermedia document as being “retrieved and displayed on the user’s display screen.” *Id.* at 2:41–:42.

<sup>12</sup> Similarly, every independent claim of the ’985 patent explicitly recites “*receive[ing]* . . . at least one file containing information to enable [a / said] *browser* application to display.” ’985 claims 1, 16, 20, 24, 28, 32, 36, 40, 44.

Second, the intrinsic evidence describes a hypermedia document as “similar” to a hypertext document, which it defines as a document that “is primarily text and *includes links* to other data objects *according to the hypertext format*” (*i.e.*, hyperlinks). *Id.* at 2:14–:27. Both types of documents include links to other data objects according to the hypertext format, but when the object being linked to is “graphics, sound, video or other media,” the document is said to be a hypermedia document. *Id.* Throughout the intrinsic record, the applicants’ discussions of hypermedia documents are consistent with documents that include hyperlinks to objects. *See, e.g., id.* at 1:53–2:27 (referring to “hyper” documents with hyperlinks to other objects). For example, hypermedia document 10 in Figure 1 of the ’906 patent includes image icon 22 with a link to image 16. *Id.* at 2:62–:63 & Fig. 1. The specification of the ’906 patent also provides an example of “an *HTML tag format* used by the present invention to embed *a link* to an application program *within a hypermedia document.*” *Id.* at 12:54–:56. The very title of the patents-in-suit use the term “hypermedia” twice.

Defendants also propose that the related term “distributed hypermedia document” should be construed the same as “hypermedia document.” In contrast, Eolas asserts that “distributed hypermedia document” is a “hypermedia document that allows a user to access a remote data object over a network.” Eolas neglects to cite to any support for such construction, instead relying solely on the argument that its definition “reflects the ordinary-language meaning of the term at issue.” Eolas Br. at 23. At the same time, however, Eolas contends that the patentees acted as their own lexicographers, which is inconsistent. *See id.* Additionally, Eolas’s proposed construction ignores the fact that the applicants used these two claim terms interchangeably in all but one independent claim of the ’985 patent. For instance, claim 24 of the ’985 patent recites “a first location within a portion of *a hypermedia document* ... at least said portion of *said distributed hypermedia document* ....” *See also* ’985 claims 1, 16, 20, 28, 36, 40 and 44. The only possible antecedent basis for “said distributed hypermedia document” is “a hypermedia document.” Accordingly, because it is clear that the applicants intended for these claim terms to

refer to the same thing, such terms should be construed identically as proposed by Defendants.<sup>13</sup>

Finally, Defendants’ proposed construction of “file containing information to enable a browser application to display [, on] [said / the] [client workstation,] at least [a / said] portion of [a / said] distributed hypermedia document” — a term appearing only in the claims of the ’985 patent — is identical to Defendants’ proposed construction of the preceding two terms except that the construction of the preceding two terms refers to “document” instead of “file containing information.” The written description of the ’985 patent provides no support for any “file containing information . . .” other than a file or document that is received and presented by a browser in a computer system, and that includes links to “graphics, sound, video or other media” according to the hypertext format. ’985 at 2:12–:20; *see also* Ex. J at 124–49.

Eolas cannot support a construction of this term that differs in scope from the construction of “hypermedia document” and “distributed hypermedia document” as those terms are used in the related ’906 patent. Indeed, the “file containing information . . .” language first appeared in newly submitted claims of the ’985 patent that were included in a supplemental amendment filed on April 11, 2008, *over thirteen years after the written description of the priority ’906 patent was filed*. *See* 985 PH Ex. 11. In response to a request by the examiner to cite to support in the specification for the elements and limitations of the pending claims, the applicants cited to the portions of the specification that define and discuss “hypermedia document.” *See* Ex. J at 147–48. Therefore, for the reasons explained above, the construction for “file containing information . . .” should mirror the construction for the preceding two terms.

**I. “distributed application”**

<b><u>Claim Term(s)</u></b>	<b><u>Defendants’ Proposed Construction</u></b>	<b><u>Eolas’s Proposed Construction</u></b>
distributed application	an application in which tasks are broken up and performed in parallel on two or more computers	an application that may be broken up and performed among two or more computers

<sup>13</sup> Defendants’ proposed construction does not render the word “distributed” superfluous because the proposed construction acknowledges that the hypermedia document is “received by the browser.”

Defendants' construction of "distributed application" is the construction that "most naturally aligns with the patent's description of the invention" by incorporating the key characteristics of a distributed application described in the specification. *See Phillips*, 415 F.3d at 1316. In contrast, Eolas's construction ignores the purpose behind distributing application tasks over multiple computers: to allow parallel processing of computer applications. Indeed, Eolas's equivocal construction even ignores the plain meaning of the term "distributed" by seeking a construction stating that the distributed application "*may*" be performed among two or more computers.

Though the parties apparently agree that a distributed application can be "broken up and performed among two or more computers," Defendants' construction recognizes that the application will have some tasks that must be performed by multiple computers *in parallel*. The specification explains that the '985 patent is directed to "shortcomings" in prior art systems used to display large data objects in "*real time*" because of, *inter alia*, the limited processing power of the computers typically available to users. *See* '985 at 5:31–6:15. As Eolas acknowledges, the specification's description of a system that purports to solve this problem includes using a "distributed application" where application "tasks such as volume rendering may be broken up and easily performed among two or more computers." Eolas's Br. at 24; *see also* '985 at Fig. 6; 6:63–7:16, 10:63–11:16. But, in its selective quotation of the specification, Eolas ignores that the specification also makes clear that the advantage derived from splitting up tasks is "providing *parallel* distributed processing for tasks such as volume rendering." *Id.* at 6:63–:67; *see also* Ex. J at 174 (Declaration of Michael D. Doyle). Certain aspects of a distributed application, such as coordination of the distributed processing, may be centralized on a single computer, but if only a single computer performs part of an application task at any one time, the application would *not* be "distributed" and the purported advantage of substituting multiple smaller (and typically cheaper) computers for a single large computer would not be achieved. *See* '985 at 5:31–6:15, 10:63–11:16. Thus, a person of skill in the art would have understood a distributed application in the context of the specification to require parallel processing across multiple computers. *See*

also '985 at 11:2–:14 (discussing how multiple computers in the distributed system “all work together to perform the task”).

Eolas’s proposal is also nonsensical because it states that the application “*may* be broken up and performed among two or more computers,” which is tantamount to stating that a distributed application *may or may not* be “distributed.” The claims are clear in requiring the application to be, in fact, distributed, and it is the use of multiple computers that makes an application “distributed.” This understanding is confirmed by contemporaneous technical dictionaries. *See* Ex. J at 178 (“data are stored and processed on more than one computer”); *id.* at 179 (“Implementation of a single application system on multiple computer configurations in different locations”). Only Defendants’ construction properly reflects this crucial fact.

**J. “workstation”**

<b><u>Claim Term(s)</u></b>	<b><u>Defendants’ Proposed Construction</u></b>	<b><u>Eolas’s Proposed Construction</u></b>
workstation <sup>14</sup>	a desktop or desktside computer with an operating system and hardware that provides higher performance than a personal computer	a computer system connected to a network that serves the role of an information requester

The term “workstation” is a term of art. A “workstation” is a computer that is more powerful (and expensive) than a “personal computer.” The name “workstation” comes from the fact it is designed to sit in a person’s work area, either on their desk or off to the side. Eolas’s proposed construction is incorrect because it could encompass personal computers or portable computers. Those are not “workstations.”

The specification expressly draws this distinction between a “workstation” and a “personal computer.” First the specification states that “[c]omputer systems connected to a network . . . may be of varying types, e.g., mainframes, *workstations*, personal computers, etc.” and that each has “proprietary hardware and operating systems.”<sup>15</sup> *See* '906 at 1:31–:35. Next

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<sup>14</sup> The term for construction is and always has been “workstation,” *see* Ex. F at 4, not “*client workstation*” as misrepresented by Eolas, *see* Eolas Br. at 25–26.

<sup>15</sup> The claims confirm that a “workstation” must include an operating system — otherwise it would be unable to perform any of the functions recited in the claims. For example, claim 6 of

(Footnote continued)

the specification distinguishes between “large” computers (e.g., “server A at 106” in Fig. 2) and “small computers” (e.g., “small computer 104” in Fig. 2). *See id.* at 4:2–:3. The specification states that a “small computer” can be a “personal computer *or* a work station.” *Id.* at 3:64–:65. The specification repeatedly distinguishes between “workstations” and “personal computers.” *See, e.g., id.* at 1:33, 3:64–:65, 4:24, 5:52–:53, 6:18. Finally, the specification states that “workstations” are more powerful than “personal computers”: “[T]he processing power needed to perform the calculations to animate such images in real time does not exist on most *workstations*, not to mention *personal computers*.” *Id.* at 5:52–:53.

Technical dictionaries also distinguish between a “workstation” and a “personal computer.” While those dictionaries recognize that a broad definition of “workstation” could encompass a “personal computer,” the use of the term “workstation” in the specification is only consistent with the narrower dictionary definition that excludes “personal computers”:

<p>“[C]an refer to a personal computer; however, generally assumed to refer to <i>high-power</i>, full-featured <i>desktop</i> computers used for <i>scientific</i> and <i>engineering</i> applications. These are often based on the UNIX operating system with high-resolution screens, <i>fast processing power</i>, and large storage capacities.” Ex. J at 187.</p>	<p>“In general, a combination of input, output, and computing hardware that can be used for work by an individual. More often, however, the term refers to a <i>powerful</i> stand-alone computer of the sort used in computer-aided design and other applications requiring a <i>high-end</i>, usually expensive, machine (\$10,000 to \$100,000) with <i>considerable calculating or graphics capability</i>.” Ex. J at 188.</p>
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Indeed, the alleged invention was the result of work on *three-dimensional* images for *scientific* applications, and the alleged reduction to practice took place on an SGI *workstation* — not a personal computer. *See* Ex. J at 184, 186–87. SGI’s annual report from 1994 distinguishes between workstations and personal computers and states, “The *workstation* products are available in *desktop* and *deskside* configurations, and are used primarily by *technical, scientific and creative professionals to simulate, analyze, develop and display complex 3D objects and*

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the ’906 patent requires “computer readable program code for causing said client *workstation* to *execute* a browser application” and “computer readable program code for causing said client *workstation* to utilize said browser to *display*.”

*phenomena.*” Ex. J at 188–89.

Eolas’s proposed construction misses the mark because it is based on a passage in the specification discussing the term “*client*”: “*Clients* are generally *information requestors* . . . .” ’906 at 4:58. But this passage does not define or even discuss “*workstation*,” which is the term in dispute. Indeed, Eolas’s proposed construction for “workstation” would render the claim term “client” superfluous.

Eolas also argues that “the specification describes ‘personal computers’ and ‘workstations’ as playing the same role in the inventions of the patents-in-suit.” Eolas Br. at 26 (citing “client computer 108 of FIG.2”). But Figure 2 (cited by Eolas) is labeled “*Prior Art*” and thus does not show the claimed invention. The claims all require a “workstation,” not just a generic “computer.” Indeed, the applicants originally drafted some claims to a “workstation” and other claims more broadly to a “computer,” but the applicants canceled all the broader claims to a “computer” in response to a rejection, leaving just the narrower claims to a “workstation.” Ex. J at 182–83. Thus the applicants knew how to claim a generic “computer,” but did not.

**K. “network server”**

<b><u>Claim Term(s)</u></b>	<b><u>Defendants’ Proposed Construction</u></b>	<b><u>Eolas’s Proposed Construction</u></b>
network server	a computer running software that is capable of executing applications responsive to requests from a client workstation, and that processes commands from a client workstation to locate and retrieve documents or files from storage	a computer system that serves the role of an information provider

Under Eolas’s construction, any computer or “computer system” would qualify as a “network server” because any computer necessarily provides information. Eolas’s construction ignores the bulk of the intrinsic record and instead relies on a single passage in the Background. *See* ’906 at 4:55–:59. Eolas’s construction even ignores the relied upon passage’s instruction that client and server computers are characterized according to their “predominant role.” *Id.* As



such, Eolas advances a construction in which any computer would qualify as a “network server.” Defendants’ construction, in contrast, defines the term “network server” in a way that matches the usage of that term in the patent and avoids the indefiniteness inherent in Eolas’s proposal.

During prosecution, Eolas consistently identified the “server *computer* 204” (not system) as the claimed “network server.” *See, e.g.*, Ex. J at 199–204. Likewise, in the Interference involving the ’906 Patent, the inventors told the Patent Office that “server computer 204” was the “network server” of each claim. *See* Ex. J at 197–98. Because Eolas has repeatedly identified “server computer 204” as the claimed “network server,” the construction of “network server” should reflect the function of “server computer 204.”

As shown throughout the intrinsic record, server computer 204 is the *originator* of responsive information requested by the client workstation (*i.e.* the “document” or “files” referred to in the claims). ’906 at 9:45–:63 & Fig. 5 (“[S]erver process 218 ultimately receives the request. Server process 218 then retrieves data object 216 and transfers it over network 206 back to application client 210.”); *see also* ’906 at 4:66–5:21; Ex. J at 196 (Felten Decl. ¶ 22); Ex. J at 195(’906 Amendment B). Thus, the patent depicts and describes that the network server receives requests and provides documents or files in response. Moreover, the structure of the claims notes that the network server is *coupled to* the distributed hypermedia environment, distinguishing it from other computers that form that environment. The specification likewise distinguishes “other computers” that act as intermediaries in transferring data from the originating network server. *See* ’906 at 4:21–:22. Defendants’ proposed construction recognizes this distinction, while Eolas’s “information provider” definition allows any of the “other computers” to qualify as a “network server” and is therefore improper.

The acknowledged *network server* — “server computer 204” — includes an “Application (Server) 220.” *See* ’906 at Fig. 5. The patent describes that “Application (Server) 220” “works in communication with” the client workstation “to assist in processing that may need to be performed by an external program.” ’906 at 10:35–:39. Thus, in operation, “server computer 204” includes an application server that executes applications in response to requests from a

client computer. Defendants’ construction recognizes that the “network server” is “capable of executing applications responsive to requests from a client workstation.” In sum, Defendants’ proposed construction matches the usage of the term in the patent where Eolas’s construction would expand the scope of “network server” to include any computer, and, as such, Defendants’ construction should be adopted.

**L. Corresponding structure(s)/act(s) for § 112, ¶ 6**

There are four groups of claims that use language that invokes § 112, ¶ 6:

1. ’985 claims 24–27: “the method comprising: *enabling* . . .”
2. ’985 claims 20–23 and 40–43: “communicating . . . *in order to cause*”
3. ’985 claims 16–19 and 28–31: “software . . . *operable to . . . cause*”
4. ’906 claims 6–8 and 13–14: “computer readable program code *for causing* . . . .”

*See* Ex. G. The four groups above claim a *functional result*, rather than sufficient structures or acts for achieving that result, and thus § 112, ¶ 6 should apply, even though the claims do not use the word “means.” That is because “‘purely functional claim language’ is now permissible . . . only under the conditions of 35 U.S.C. § 112, sixth paragraph.” *Ex Parte Miyazaki*, 89 U.S.P.Q.2d 1207, 1216–17 (BPAI 2008) (finding “sheet feeding area *operable to feed*” to be purely functional); *see also Ex Parte Rodriguez*, 92 U.S.P.Q.2d 1395, 1404–05 (BPAI 2009) (finding “system configuration generator *configured to generate*” to be purely functional).

The first group of claims above is most egregious: it purports to cover *any* method for “enabling” various results. The second group is nearly as egregious: it purports to cover *any* method of “communicating” that “causes” various results. Eolas’s brief does not dispute that § 112, ¶ 6 should apply to these two groups of claims. *See* Eolas Br. at 26–28.

With respect to the third and fourth groups above, Eolas relies on non-binding district court cases to argue that “software” and “code” is structural, so § 112, ¶ 6 does not apply.<sup>16</sup> But

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<sup>16</sup> Eolas also argues that in the last litigation, § 112, ¶ 6 was not applied to claim 6 of the ’906 patent, *see* Eolas Br. at 27–28, but that does not prove anything because it appears that neither party raised § 112, ¶ 6 in the last litigation so the question was never decided. Eolas also argues that Defendants proposed structural definitions for “computer readable *media*” and “computer

(Footnote continued)

the cases cited by Eolas do not discuss two important binding precedents from the Federal Circuit that *rejected* the argument that software/code is sufficient structure:

“Although ‘commands’ represent structure (in the form of <i>software</i> ), it is <i>not sufficient structure</i> to perform the entirety of the function.” <i>Altiris, Inc. v. Symantec Corp.</i> , 318 F.3d 1363, 1376 (Fed. Cir. 2003).	“For a patentee to claim a means for performing a particular function and then to disclose only a <i>general purpose computer</i> as the structure designed to perform that function amounts to pure <i>functional</i> claiming.” <i>Aristocrat Techs. Australia PTY Ltd. v. Int’l Game Tech.</i> , 521 F.3d 1328, 1333 (Fed. Cir. 2008).
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Notably, district courts (including this Court) that *have* considered the Federal Circuit’s decision in *Aristocrat* have concluded that a claim to a “computer” or “processor” is *not* sufficient structure to avoid § 112, ¶ 6 — which directly supports the conclusion that “software” and “code” is not sufficient structure, either. *See Personal Audio, LLC v. Apple, Inc.*, No. 09-111, slip op. at 40–41 (E.D. Tex. Jan. 31, 2011) (Clark, J.) (applying § 112, ¶ 6 to “processor”); *Soque Holdings (Bermuda) Ltd. v. Keyscan, Inc.*, No. 09-2651, 2010 WL 2292316, at \*12 (N.D. Cal. June 7, 2010) (applying § 112, ¶ 6 to “computer”).

Finally, the terms “software” and “code” are simply *generic* terms like “mechanism”<sup>17</sup> and “element”<sup>18</sup> that do not imply sufficient structure to avoid § 112, ¶ 6. Indeed, the *Microsoft Press Computer Dictionary* defines “code” as “a *generic term* for program instructions.” *See* Ex. Y at 78.

Assuming § 112, ¶ 6 applies, Eolas has failed to identify the proper corresponding structure(s)/act(s). Instead Eolas has simply provided column and line numbers for virtually the *entire* specification. *See* Ex. H. That is meaningless. The Federal Circuit has held that for computer-implemented means-plus-function claims, the corresponding structure is “*not* the

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program *product*,” *see id.* at 28, but those are different terms that *do* imply structure (unlike the four groups of terms above); indeed, Defendants’ proposed construction for both was “a *physical item* . . . .” *See* Ex. F at 6.

<sup>17</sup> *Welker Bearing Co. v. PHD, Inc.*, 550 F.3d 1090, 1095–96 (Fed. Cir. 2008) (“mechanism for moving” not sufficiently structural); *MIT v. Abacus Software*, 462 F.3d 1344, 1353–54 (Fed. Cir. 2006) (“colorant selection mechanism” not sufficiently structural).

<sup>18</sup> *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1213–15 (Fed. Cir. 1998) (“lever moving element” and “movable link member” not sufficiently structural).

general purpose computer, but rather the special purpose computer programmed to perform the *disclosed algorithm*.” *Aristocrat*, 521 F.3d at 1333. In this case, that means at least the following structure is required:

- NCSA Mosaic browser version 2.4 for X-Windows with the modifications to the source code shown in Appendix A and Appendix B to the patent
- hypermedia document (212) with the following HTML tag at a “first location” in the document: <EMBED TYPE = “application/x-vis” HREF = [URL address for data object (216)] WIDTH = [width of window to display the object] HEIGHT = [height of window to display the object]>
- data object (216)

See Ex. G. However, there is no algorithm disclosed for the following limitation found (with slight variation to the language) in all of the § 112, ¶ 6 claims, and thus all of the § 112, ¶ 6 claims are indefinite, see *Aristocrat*, 521 F.3d at 1332–38, as explained in more detail in Defendants’ motion for summary judgment being filed today:

- “executable application . . . to display said object and enable 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”

## V. CONCLUSION

For all of these reasons, Defendants’ proposed claim constructions should be adopted.

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By: /s/ Jason W. Wolff

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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)>  
Joseph P. Reid (*pro hac vice*)  
<[Reid@fr.com](mailto:Reid@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 Reines

---

Edward Reines (*pro hac vice*)  
<[edward.reines@weil.com](mailto:edward.reines@weil.com)>

Joseph H. Lee (*pro hac vice*)  
<[joseph.lee@weil.com](mailto:joseph.lee@weil.com)>

WEIL, GOTSHAL & MANGES LLP  
201 Redwood Shores Parkway  
Redwood Shores, CA 94065  
Telephone: (650) 802-3000  
Facsimile: (650) 802-3100

Otis W. Carroll, Jr. (Bar No. 03895700)  
<[fedserv@ickl.com](mailto:fedserv@ickl.com)>

Deborah J. Race (Bar No. 16448700)  
<[drace@ickl.com](mailto:drace@ickl.com)>

IRELAND CARROLL & KELLEY  
6101 S. Broadway, Suite 500  
Tyler, TX 75703  
Telephone: (903) 561-1600  
Facsimile: (903) 581-1071

*Attorneys for Defendant and  
Counterclaimant Amazon.com, Inc.*

By: /s/ Richard A. Cederoth

---

David T. Pritikin (*pro hac vice*)  
<[dpitkin@sidley.com](mailto:dpitkin@sidley.com)>  
Richard A. Cederoth (*pro hac vice*)  
<[rcederoth@sidley.com](mailto:rcederoth@sidley.com)>  
Shubham Mukherjee (*pro hac vice*)  
<[smukherjee@sidley.com](mailto:smukherjee@sidley.com)>  
SIDLEY AUSTIN LLP  
One South Dearborn Street  
Chicago, IL 60603  
Telephone: (312) 853-7000  
Facsimile: (312) 853-7036

Teague I. Donahey (*pro hac vice*)  
<[tdonahey@sidley.com](mailto:tdonahey@sidley.com)>  
SIDLEY AUSTIN LLP  
555 California Street, Suite 2000  
San Francisco, CA 94104  
Telephone: (415) 772-1200  
Facsimile: (415) 772-7400

Theodore W. Chandler (*pro hac vice*)  
<[tchandler@sidley.com](mailto:tchandler@sidley.com)>  
SIDLEY AUSTIN LLP  
555 West Fifth Street, Suite 4000  
Los Angeles, CA 90013  
Telephone: (213) 896-6000  
Facsimile: (213) 896-6600

Aaron R. Bleharski (*pro hac vice*)  
<[ableharski@sidley.com](mailto:ableharski@sidley.com)>  
Duy D. Nguyen (*pro hac vice*)  
<[ddnguyen@sidley.com](mailto:ddnguyen@sidley.com)>  
SIDLEY AUSTIN LLP  
1001 Page Mill Road, Building 1  
Palo Alto, CA 94304  
Telephone: (650) 565-7000  
Facsimile: (650) 565-7100

Eric M. Albritton (Bar No. 00790215)  
<[ema@emafirm.com](mailto:ema@emafirm.com)>  
ALBRITTON LAW FIRM  
P.O. Box 2649  
Longview, TX 75606  
Telephone: (903) 757-8449  
Facsimile: (903) 758-7397

*Attorneys for Defendant and  
Counterclaimant Apple Inc.*

By: /s/ Thomas L. Duston

---

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 and  
Counterclaimant CDW LLC*



By: /s/ M. Scott Fuller

---

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)>

LOCKE LORD BISSELL & LIDDELL LLP  
2200 Ross Avenue, Suite 2200  
Dallas, TX 75201-6776  
Telephone: (214) 740-8000  
Facsimile: (214) 740-8800

Alexas D. Skucas (*pro hac vice*)  
<[askucas@kslaw.com](mailto:askucas@kslaw.com)>

KING & SPALDING LLP  
1185 Avenue of the Americas  
New York, NY 10036-4003  
Telephone: (212) 556-2100  
Facsimile: (212) 556-2222

Eric L. Sophir (*pro hac vice*)  
<[esophir@kslaw.com](mailto:esophir@kslaw.com)>

KING & SPALDING LLP  
1700 Pennsylvania Ave. NW, Suite 200  
Washington, D.C. 20006-4707  
Telephone: (202) 626-8980  
Facsimile: (202) 626-3737

*Attorneys for Defendant Citigroup Inc.*

By: /s/ Edward Reines

---

Edward Reines (*pro hac vice*)  
<[edward.reines@weil.com](mailto:edward.reines@weil.com)>  
Joseph H. Lee (*pro hac vice*)  
<[joseph.lee@weil.com](mailto:joseph.lee@weil.com)>

WEIL, GOTSHAL & MANGES LLP  
201 Redwood Shores Parkway  
Redwood Shores, CA 94065  
Telephone: (650) 802-3000  
Facsimile: (650) 802-3100

Otis W. Carroll, Jr. (Bar No. 03895700)  
<[fedserv@icklawn.com](mailto:fedserv@icklawn.com)>  
Deborah J. Race (Bar No. 16448700)  
<[drace@icklawn.com](mailto:drace@icklawn.com)>

IRELAND CARROLL & KELLEY  
6101 S. Broadway, Suite 500  
Tyler, TX 75703  
Telephone: (903) 561-1600  
Facsimile: (903) 581-1071

*Attorneys for Defendant and  
Counterclaimant eBay Inc.*

By: /s/ Jeffrey F. Yee

---

Jeffrey K. Joyner (*pro hac vice*)

<[joynerj@gtlaw.com](mailto:joynerj@gtlaw.com)>

Jeffrey F. Yee (*pro hac vice*)

<[yeej@gtlaw.com](mailto:yeej@gtlaw.com)>

GREENBERG TRAUERIG LLP

2450 Colorado Avenue, Suite 400E

Santa Monica, CA 90404

Telephone: (310) 586-7700

Facsimile: (310) 586-7800

Christopher M. Joe (Bar No. 00787770)

<[chrisjoe@bjciplaw.com](mailto:chrisjoe@bjciplaw.com)>

Brian Carpenter (Bar No. 03840600)

<[brian.carpenterb@bjciplaw.com](mailto:brian.carpenterb@bjciplaw.com)>

Eric W. Buether (Bar No. 03316880)

<[eric.buethere@bjciplaw.com](mailto:eric.buethere@bjciplaw.com)>

BUETHER JOE & CARPENTER, LLC

1700 Pacific, Suite 2390

Dallas, TX 75201

Telephone: (214) 466-1270

Facsimile: (214) 635-1842

*Attorneys for Defendant and  
Counterclaimant Frito-Lay, Inc.*

By: /s/ Neil J. McNabnay

---

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 and  
Counterclaimant The Go Daddy Group,  
Inc.*

By: /s/ Scott T. Weingaertner

---

Scott T. Weingaertner (*pro hac vice*)

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

Robert F. Perry (*pro hac vice*)

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

Allison H. Altersohn (*pro hac vice*)

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

Christopher C. Carnaval (*pro hac vice*)

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

Mark H. Francis (*pro hac vice*)

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

KING & SPALDING LLP

1185 Avenue of the Americas

New York, NY 10036-4003

Telephone: (212) 556-2100

Facsimile: (212) 556-2222

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 Defendant and  
Counterclaimant Google Inc.*

By: /s/ Jeffrey F. Yee

---

Jeffrey K. Joyner (*pro hac vice*)

<[joynerj@gtlaw.com](mailto:joynerj@gtlaw.com)>

Jeffrey F. Yee (*pro hac vice*)

<[yeej@gtlaw.com](mailto:yeej@gtlaw.com)>

GREENBERG TRAUIG LLP

2450 Colorado Avenue, Suite 400E

Santa Monica, CA 90404

Telephone: (310) 586-7700

Facsimile: (310) 586-7800

Christopher M. Joe (Bar No. 00787770)

<[chrisjoe@bjciplaw.com](mailto:chrisjoe@bjciplaw.com)>

Brian Carpenter (Bar No. 03840600)

<[brian.carpenterb@bjciplaw.com](mailto:brian.carpenterb@bjciplaw.com)>

Eric W. Buether (Bar No. 03316880)

<[eric.buethere@bjciplaw.com](mailto:eric.buethere@bjciplaw.com)>

BUETHER JOE & CARPENTER, LLC

1700 Pacific, Suite 2390

Dallas, TX 75201

Telephone: (214) 466-1270

Facsimile: (214) 635-1842

*Attorneys for Defendant and  
Counterclaimant J.C. Penney Corporation,  
Inc.*

By: /s/ Stephen K. Shahida

---

Stephen K. Shahida (*pro hac vice*)

<[sshahida@mwe.com](mailto:sshahida@mwe.com)>

David O. Crump (*pro hac vice*)

<[dcrump@mwe.com](mailto:dcrump@mwe.com)>

MCDERMOTT WILL & EMERY LLP

600 13th Street, N.W.

Washington, DC 20005-3096

Telephone: (202) 756-8327

Facsimile: (202) 756-8087

Trey Yarbrough (Bar No. 22133500)

<[trey@yw-lawfirm.com](mailto:trey@yw-lawfirm.com)>

Debra Elaine Gunter (Bar No. 24012752)

<[debby@yw-lawfirm.com](mailto:debby@yw-lawfirm.com)>

YARBROUGH WILCOX, PLLC

100 E. Ferguson Street

Suite 1015

Tyler, TX 75702

Telephone: (903) 595-3111

Facsimile: (903) 595-0191

*Attorneys for Defendant and  
Counterclaimant JPMorgan Chase & Co.*

By: /s/ Michael Simons

---

Michael Simons (Bar No. 24008042)

<[msimons@akingump.com](mailto:msimons@akingump.com)>

AKIN GUMP STRAUSS HAUER & FELD LLP

300 West 6th Street, Suite 2100

Austin, TX 78701

Telephone: (512) 499-6253

Facsimile: (512) 499-6290

*Attorney for Defendant and  
Counterclaimant New Frontier Media, Inc.*

By: /s/ Suzanne M. Wallman

---

Kenneth J. Jurek

<[kjurek@mwe.com](mailto:kjurek@mwe.com)>

Suzanne M. Wallman

<[swallman@mwe.com](mailto:swallman@mwe.com)>

Brett E. Bachtell

<[bbachtell@mwe.com](mailto:bbachtell@mwe.com)>

MCDERMOTT WILL & EMERY LLP

227 West Monroe Street

Chicago, IL 60606

Telephone: (312) 372-2000

Facsimile: (312) 984-7700

J. Thad Heartfield (Bar No. 09346800)

<[thad@jth-law.com](mailto:thad@jth-law.com)>

THE HEARTFIELD LAW FIRM

2195 Dowlen Road

Beaumont, TX 77706

Telephone: (409) 866-3318

Facsimile: (409) 866-5789

*Attorneys for Defendant and  
Counterclaimant Office Depot, Inc.*



By: /s/ Scott F. Partridge

---

Scott F. Partridge (Bar No. 00786940)  
<[scott.partridge@bakerbotts.com](mailto:scott.partridge@bakerbotts.com)>

Roger J. Fulghum (Bar No. 00790724)  
<[roger.fulghum@bakerbotts.com](mailto:roger.fulghum@bakerbotts.com)>

BAKER BOTTS L.L.P.

One Shell Plaza

910 Louisiana

Houston, TX 77002-4995

Telephone: (713) 229-1234

Facsimile: (713) 229-1522

Kevin J. Meek (Bar No. 13899600)

<[kevin.meek@bakerbotts.com](mailto:kevin.meek@bakerbotts.com)>

Paula D. Heyman (Bar No. 24027075)

<[paula.heyman@bakerbotts.com](mailto:paula.heyman@bakerbotts.com)>

BAKER BOTTS L.L.P.

1500 San Jacinto Center

Austin, TX 78701-4075

Telephone: (512) 322-2500

Facsimile: (512) 322-2501

Vernon E. Evans (Bar No. 24069688)

<[vernon.evans@bakerbotts.com](mailto:vernon.evans@bakerbotts.com)>

BAKER BOTTS L.L.P.

2001 Ross Avenue

Dallas, TX 75201-2980

Telephone: (214) 953-6500

Facsimile: (214) 953-6503

Shannon Dacus (Bar No. 00791004)

<[Shannond@rameyflock.com](mailto:Shannond@rameyflock.com)>

RAMEY & FLOCK, P.C.

100 East Ferguson, Suite 500

Tyler, TX 75702

Telephone: (903) 597-3301

Facsimile: (903) 597-2413

*Attorneys for Defendant and  
Counterclaimant Perot Systems Corp.*

By: /s/ Gentry C. McLean

---

David B. Weaver (Bar No. 00798576)  
<[dweaver@velaw.com](mailto:dweaver@velaw.com)>  
Avelyn M. Ross (Bar No. 24027871)  
<[aross@velaw.com](mailto:aross@velaw.com)>  
Gentry C. McLean (Bar No. 24046403)  
<[gmclean@velaw.com](mailto:gmclean@velaw.com)>  
John A. Fedock (Bar No. 24059737)  
<[jfedock@velaw.com](mailto:jfedock@velaw.com)>  
VINSON & ELKINS LLP  
2801 Via Fortuna, Suite 100  
Austin, TX 78746-7568  
Tel: (512) 542-8400  
Fax: (512) 236-3218

*Attorneys for Defendant and  
Counterclaimant Playboy Enterprises  
International, Inc.*

By: /s/ Jeffrey F. Yee

---

Jeffrey K. Joyner (*pro hac vice*)  
<[joynerj@gtlaw.com](mailto:joynerj@gtlaw.com)>  
Jeffrey F. Yee (*pro hac vice*)  
<[yeej@gtlaw.com](mailto:yeej@gtlaw.com)>  
GREENBERG TRAUIG LLP  
2450 Colorado Avenue, Suite 400E  
Santa Monica, CA 90404  
Telephone: (310) 586-7700  
Facsimile: (310) 586-7800

Christopher M. Joe (Bar No. 00787770)  
<[chrisjoe@bjciplaw.com](mailto:chrisjoe@bjciplaw.com)>  
Brian Carpenter (Bar No. 03840600)  
<[brian.carpenterb@bjciplaw.com](mailto:brian.carpenterb@bjciplaw.com)>  
Eric W. Buether (Bar No. 03316880)  
<[eric.buethere@bjciplaw.com](mailto:eric.buethere@bjciplaw.com)>  
BUETHER JOE & CARPENTER, LLC  
1700 Pacific, Suite 2390  
Dallas, TX 75201  
Telephone: (214) 466-1270  
Facsimile: (214) 635-1842

*Attorneys for Defendant and  
Counterclaimant Rent-A-Center, 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 and  
Counterclaimant Staples, Inc.*

By: /s/ Mark D. Fowler

---

Mark D. Fowler (*pro hac vice*)  
<[mark.fowler@dlapiper.com](mailto:mark.fowler@dlapiper.com)>  
DLA PIPER US LLP  
2000 University Avenue  
East Palo Alto, CA 94303-2215  
Telephone: (650) 833-2000  
Facsimile: (650) 833-2001

Kathryn B. Riley (*pro hac vice*)  
<[kathryn.riley@dlapiper.com](mailto:kathryn.riley@dlapiper.com)>  
DLA PIPER US LLP  
401 B Street, Suite 1700  
San Diego, CA 92101  
Telephone: (619) 699-2700  
Facsimile: (619) 764-6692

Eric H. Findlay (Bar No. 00789886)  
<[efindlay@findlaycraft.com](mailto:efindlay@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 and  
Counterclaimant Oracle America, Inc.  
(formerly known as Sun Microsystems,  
Inc.)*

By: /s/ Carl R. Roth

---

Carl R. Roth (Bar No. 17312000)  
<[cr@rothfirm.com](mailto:cr@rothfirm.com)>  
Brendan C. Roth (Bar No. 24040132)  
<[br@rothfirm.com](mailto:br@rothfirm.com)>  
Amanda A. Abraham (Bar No. 24055077)  
<[aa@rothfirm.com](mailto:aa@rothfirm.com)>  
THE ROTH LAW FIRM, P.C.  
115 N. Wellington, Suite 200  
Marshall, TX 75670  
Telephone: (903) 935-1665  
Facsimile: (903) 935-1797

*Attorneys for Defendant and  
Counterclaimant Texas Instruments  
Incorporated*

By: /s/ Edward Reines

---

Edward Reines (*pro hac vice*)  
<[edward.reines@weil.com](mailto:edward.reines@weil.com)>  
Joseph H. Lee (*pro hac vice*)  
<[joseph.lee@weil.com](mailto:joseph.lee@weil.com)>  
WEIL, GOTSHAL & MANGES LLP  
201 Redwood Shores Parkway  
Redwood Shores, CA 94065  
Telephone: (650) 802-3000  
Facsimile: (650) 802-3100

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

*Attorneys for Defendant and  
Counterclaimant Yahoo! Inc.*

By: /s/ Scott T. Weingaertner

---

Scott T. Weingaertner (*pro hac vice*)

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

Robert F. Perry (*pro hac vice*)

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

Allison H. Altersohn (*pro hac vice*)

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

Christopher C. Carnaval (*pro hac vice*)

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

Mark H. Francis (*pro hac vice*)

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

KING & SPALDING LLP

1185 Avenue of the Americas

New York, NY 10036-4003

Telephone: (212) 556-2100

Facsimile: (212) 556-2222

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 Defendant and  
Counterclaimant YouTube, LLC*

**SIGNATURE ATTESTATION**

I hereby certify that concurrence in the service of this document has been obtained from each of the other signatories shown above.

/s/ Shubham Mukherjee  
Attorney for one of the Defendants

**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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*/s/ Shubham Mukherjee*  
Attorney for one of the Defendants