

TABLE OF CONTENTS

I. INTRODUCTION1

II. ARGUMENT IN SUR-REPLY2

 A. No Asserted Claim Is Indefinite Under *IPXL*.2

 B. No Asserted Claim Improperly Uses Purely Functional Language.....5

 C. No Asserted Claim Is Subject to 35 U.S.C. § 112, ¶ 6.5

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Aloft Media, LLC v. Adobe Sys.</i> , 570 F. Supp. 2d 887 (E.D. Tex. 2008).....	4
<i>Ariba, Inc. v. Emptoris, Inc.</i> , No. 9:07-CV-90-RC, 2008 U.S. Dist. LEXIS 59862 (E.D. Tex. Aug. 7, 2008)	3
<i>Deep Nines, Inc. v. McAfee, Inc.</i> , No. 9:09-CV-89-RC, 2010 U.S. Dist. LEXIS 79420 (E.D. Tex. Aug. 4, 2010)	3
<i>Eolas Techs., Inc. v. Microsoft Corp.</i> , 399 F.3d 1325 (Fed. Cir. 2005).....	1, 3
<i>Finjan, Inc. v. Secure Computing Corp.</i> , 626 F.3d 1197 (Fed. Cir. 2010).....	4
<i>Haemonetics Corp. v. Baxter Healthcare Corp.</i> , 607 F.3d 776 (Fed. Cir. 2010).....	1
<i>Honeywell Int’l, Inc. v. United States</i> , 609 F.3d 1292 (Fed. Cir. 2010).....	1
<i>In re Katz Interactive Call Processing Patent Litig.</i> , No. 2009-1450, 2011 U.S. App. LEXIS 3212 (Fed. Cir. Feb. 18, 2011)	2
<i>Intellect Wireless, Inc. v. Kyocera Comm., Inc.</i> , No. 08 C 1350, 2099 U.S. Dist. LEXIS 94696 (N.D. Ill. Oct. 8, 2009)	2
<i>Intermec Techs. Corp. v. Palm Inc.</i> , No. 07-CV-272, 2010 U.S. Dist. LEXIS 96247 (D. Del. Sept. 14, 2010).....	4
<i>Microprocessor Enhancement Corp. v. Tex. Instruments Inc.</i> , 520 F.3d 1367 (Fed. Cir. 2008).....	2
<i>Ricoh Co., Ltd. v. Katun Corp.</i> , 486 F. Supp. 2d 395 (D.N.J. 2007)	2
<i>SynQor, Inc. v. Artesyn Techs., Inc.</i> , No. 2:07-CV-497-TJW-CE, 2010 U.S. Dist. LEXIS 74808 (E.D. Tex. July 26, 2010).....	2
<i>Toshiba Corp. v. Juniper Networks, Inc.</i> , No. 03-1035-SLR, 2006 U.S. Dist. LEXIS 44348 (D. Del. Jun. 28, 2006).....	2
<i>Yodlee, Inc. v. CashEdge, Inc.</i> , No. 05-CV-01550, 2006 U.S. Dist. LEXIS 86699 (N.D. Cal. Nov. 29, 2006)	4

STATUTES

35 U.S.C. § 112.....1, 5

I. INTRODUCTION

Proof of indefiniteness must meet “an exacting standard.” *Haemonetics Corp. v. Baxter Healthcare Corp.*, 607 F.3d 776, 783 (Fed. Cir. 2010). Only claims that cannot be construed—those claims that are “insolubly ambiguous”—are indefinite. *Id.* With respect to this motion, therefore, Defendants bear the burden to clearly demonstrate that “one of ordinary skill in the relevant art could not discern the boundaries of the claim based on the claim language, the specification, the prosecution history, and the knowledge in the relevant art.” *Id.*; *see also Honeywell Int’l, Inc. v. United States*, 609 F.3d 1292, 1301 (Fed. Cir. 2010) (“If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds.”). Defendants have not met this burden, and nothing suggests that the boundaries of the asserted claims are indiscernible.

To the contrary, highly relevant evidence indicates that the boundaries of these claims are readily discernible. Defendants focus their reply on language found in the ’906 patent’s claim 6, and in similar language found in the ’985 patent’s claim 28. Dkt. No. 586 (“Reply”) at 1-3. But the ’906 patent’s claim 6 has already been through three separate examinations by the Patent Office, litigated through a jury verdict of infringement, a judgment reflecting that verdict, and an affirmance of the related claim-construction and infringement issues on appeal. *See Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005). And significantly, in his opinion for the Federal Circuit panel in *Eolas*, then-Judge Rader had no difficulties discerning the bounds of that claim. *Id.* at 1328-29. Given the fact that the Federal Circuit was able to understand precisely what “[t]he ’906 claims require,” *id.* at 1328, those claims cannot be indefinite under 35 U.S.C. § 112, ¶ 2, *see Honeywell*, 609 F.3d at 1301; *Haemonetics*, 607 F.3d at 783. Further, given the fact that the requirements of claim 6 are readily discernible, the requirements of the similar language found in claim 28 defining the conditions in which the claimed “executable application” must be capable of operating under, is also readily discernible. In the absence of any proof showing otherwise, Defendants’ motion must be denied.

II. ARGUMENT IN SUR-REPLY

A. No Asserted Claim Is Indefinite Under *IPXL*.

As explained in Eolas' response, *IPXL* is a narrow case. Dkt. No. 583 ("Resp.") at 3; *see SynQor, Inc. v. Artesyn Techs., Inc.*, No. 2:07-CV-497-TJW-CE, 2010 U.S. Dist. LEXIS 74808, at *96 (E.D. Tex. July 26, 2010). Application of its rule has been explicitly approved only twice by the Federal Circuit,¹ and never—by any court—in the context of “computer readable program code” claims such as those at issue here. Resp. at 2-6. Defendants request an unsupported and literally unprecedented extension of the narrow rule in *IPXL* to the claims in this case—a number of which have already been considered by the Federal Circuit. That request should be denied.

Defendants suggest that the recent “holding in *Katz* directly supports [their] indefiniteness argument.” Reply at 1. But that is not true. *Katz* did not involve computer readable code “for causing” or “operable to”; it involved an “interface control system for use with . . . a communication facility . . . wherein . . . individual callers digitally enter data.” *Katz*, 2011 U.S. App. LEXIS 3212, at *34-35. The court found that, just as in *IPXL*, these system claims contained “language . . . directed to user actions, not system capabilities,” and as such impermissibly “claim both an apparatus and a method of use.” *Id.* In short, there was “no meaningful distinction” between the claims at issue in *IPXL* and the claims at issue in *Katz*. *See id.* at *34. Meaningful distinctions abound in the claims at issue here. Resp. at 3-6.

Defendants focus heavily on particular “ed” verbs in the claims, but numerous courts have explained “that use of active as opposed to equivalent passive language” does not render a claim insolubly ambiguous under *IPXL*. *See Intellect Wireless, Inc. v. Kyocera Comm., Inc.*, No. 08 C 1350, 2009 U.S. Dist. LEXIS 94696, at *18 (N.D. Ill. Oct. 8, 2009); *Toshiba Corp. v. Juniper Networks, Inc.*, No. 03-1035-SLR, 2006 U.S. Dist. LEXIS 44348, at *14 (D. Del. Jun. 28, 2006); *Ricoh Co., Ltd. v. Katun Corp.*, 486 F. Supp. 2d 395, 402 (D.N.J. 2007). Defendants

¹ Once in *IPXL* itself, and once more six years later in the case of *In re Katz Interactive Call Processing Patent Litig.*, No. 2009-1450, 2011 U.S. App. LEXIS 3212 (Fed. Cir. Feb. 18, 2011). Significantly, application of the rule was explicitly rejected in the closer case of *Microprocessor Enhancement Corp. v. Tex. Instruments Inc.*, 520 F.3d 1367, 1374 (Fed. Cir. 2008).

also repeatedly highlight Judge Clark’s *Ariba* case as critical to their position. Reply at 1-3; *Ariba, Inc. v. Emptoris, Inc.*, No. 9:07-CV-90-RC, 2008 U.S. Dist. LEXIS 59862 (E.D. Tex. Aug. 7, 2008). But that case is also distinguishable. Most critically, as explained in Eolas’ response, *Ariba* did not involve computer readable code claims. Resp. at 5. Defendants do not dispute this point, Reply at 1-3, and given the numerous cases finding such claims definite, Resp. at 2-5, this point is dispositive. In addition, *Ariba* did not involve the “operable to” or “for causing” language at issue here—language that Defendants now concede takes claims outside of *IPXL*’s ambit. Reply at 1. Indeed, in another decision two years after *Ariba*, Judge Clark indicated that the addition of similar “capable of” language would turn what otherwise appeared to be an improper method step into a proper functional limitation. *Deep Nines, Inc. v. McAfee, Inc.*, No. 9:09-CV-89-RC, 2010 U.S. Dist. LEXIS 79420, at *11 (E.D. Tex. Aug. 4, 2010).

Notwithstanding the absence of authority supporting their position, Defendants argue—as articulated for the first time in their reply—that apparatus claims 6 and 28 contain method steps that must be performed by a browser before there will be infringement of either claim. Reply at 2-3. That is not the case. Claim 6 simply claims computer readable code that is capable of performing the claimed limitations in the relevant “distributed hypermedia environment.” Indeed, the Federal Circuit has recognized as much. *Eolas*, 399 F.3d at 1328-29. Claim 28 simply claims “computer readable media encoded with software comprising an executable application,” including code capable of performing various functions in an environment that includes a browser capable of performing other functions. Defendants complain that claim 28 claims the executable application, but the claim includes limitations on the capabilities of the browser. Defendants’ complaint does not implicate *IPXL* or render claim 28 insolubly ambiguous. Claim 28 patents an “executable application” that is capable of performing various functions—for example, “caus[ing] the client workstation to display an object and enable an end-user to directly interact with said object while the object is being displayed within a display area created at a first location with a portion of a hypermedia document being displayed in a browser-controlled window”—“if and when” the conditions recited in the several “wherein” clauses are

present. *See Yodlee, Inc. v. CashEdge, Inc.*, No. 05-CV-01550, 2006 U.S. Dist. LEXIS 86699, at *13 (N.D. Cal. Nov. 29, 2006). Taking claim 28 as an example, and borrowing liberally from the oft-cited *Yodlee* case:

[t]he claim describes what happens [when, among other things, “the executable application is automatically invoked by the browser.”] It does not seek to patent [automatic invocation]; it seeks only to patent a device which performs certain functions if and when [it is automatically invoked]. Infringement occurs when a device that has the capability of performing the steps described [in the claim] is manufactured and sold. Whether a user actually [uses a browser to automatically invoke the executable application] is of absolutely no import. Similarly, the process initiated by [automatic invocation] need never take place. If the device presents such [computer readable code], and [automatic invocation] would initiate the process described [in the claim], the device infringes.

2006 U.S. Dist. LEXIS 86699, at *13; *see also Intermec Techs. Corp. v. Palm Inc.*, No. 07-CV-272, 2010 U.S. Dist. LEXIS 96247, at *57 (D. Del. Sept. 14, 2010) (same).

This reading of claims 6 and 28 is confirmed by their usage of the “for causing” and “operable to” language. Resp. at 4-5. As noted, Defendants concede that this is classic apparatus-limitation language.² Reply at 1. Defendants assert, however, that their argument is not based on this language, but on the “wherein” clauses following it. Reply at 1-3. Those “wherein” clauses, however, are clearly linked with the preceding “for causing” and “operable to” language—they further describe the capabilities of the claimed code in its relevant environment. Resp. at 4. Again, the case law supports this interpretation of these computer readable code claims. *See Finjan, Inc. v. Secure Computing Corp.*, 626 F.3d 1197, 1205 (Fed. Cir. 2010); *Aloft Media, LLC v. Adobe Sys.*, 570 F. Supp. 2d 887, 898 (E.D. Tex. 2008); Resp. at 2-5.³

² Defendants argue that dependent claims 29-31 that recite “[t]he method of claim 28” somehow transform claim 28 from an apparatus claim to a method claim. But Eolas dropped claims 29-31, and in any event, the reference to the “method” of claim 28 is clearly a typographical error, for which a certificate of correction has been filed. *See Ex. A.* These dependent claims have no impact on the determination of whether claim 28 impermissibly claims an apparatus and a method of use of this apparatus.

³ Defendants also generate some confusion in reply by selectively citing portions of Eolas’ infringement contentions. Reply at 2. Issues of infringement should not be relevant to Defendants’ assertion of indefiniteness. But in any event, and in an attempt to minimize confusion, Eolas recognizes and agrees that claim 6 of the ’906 patent is generally directed to browsers, and that claim 28 of the ’985 patent is generally directed to executable applications.

B. No Asserted Claim Improperly Uses Purely Functional Language.

In reply, Defendants focus their “purely functional” argument on four claims—20, 24, 28, and 40 of the ’985 patent. Reply at 4. Three of these are method claims (20, 24, and 40), and Defendants offer no authority suggesting that functional language might invalidate such claims. Resp. at 6-9. The fourth is addressed above (28), and its claimed structure is clear: “computer readable media encoded with software comprising an executable application” D.Br. at 4.

C. No Asserted Claim Is Subject to 35 U.S.C. § 112, ¶ 6.

The single paragraph that Defendants devote to this argument in reply is noteworthy for one reason: having now addressed the issue in at least three briefs, Defendants still have made no real attempt to overcome the strong presumption that, because the asserted claims do not use the word “means,” they are not subject to § 112, ¶ 6. Resp. at 9-10. In any event, FIGS. 5, 8A and 9, along with the description of these figures at columns 9-10 and 14-16 teach in detail how the system creates a window within or adjacent to the browser window to allow the user to directly interact with the object using the executable application’s graphical user interface.

Dated: March 7, 2010.

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CERTIFICATE OF SERVICE

The undersigned certifies that true and correct copies of the foregoing document were served to all counsel of record via the Court's ECF system.

/s/ Josh Budwin
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