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## **I. INTRODUCTION AND BACKGROUND**

Plaintiff Eolas Technologies Inc. (“Eolas”) files this response to Defendants’ Motion for Summary Judgment of Invalidity for Lack of Written Description. Dkt. 877 (“Motion”). In their Motion, Defendants attempt to re-litigate issues of claim construction under the guise of a section 112(1) validity challenge—namely, whether the “embed text format” is limited to the “EMBED tag” embodiment of the patents-in-suit.<sup>1</sup> Motion at 1. Nowhere do the defendants seriously apply the law of written description to the claims of the patents-in-suit. The Court’s claim construction order (“Order”) has already rejected Defendants’ claim construction-related arguments, (Dkt. 914 at 15) and Defendants’ Motion should be denied.

## **II. RESPONSE TO STATEMENT OF ISSUE TO BE DECIDED**

Defendants’ frame the issue in their Motion as whether the asserted claims of the patents-in-suit are “invalid for lack of written description pursuant to Section 112(1)” for their use of the term “embed text format,” “insofar as that is something other than the EMBED tag that is disclosed in the patents.” Motion at 1. The Court, in its Order, has already rejected the substance of Defendants’ argument, holding that the “embed text format”

term is supported in the specification by the disclosure of the EMBED tag (‘906 patent, 14:32–33); however, the term is not limited to only a tag. Consistent with the Court’s construction of “text format,” and in view of the specification, the Court construes “embed text format” as “coded information that specifies to a browser application that an object is to be embedded in a displayed hypermedia document.”

Order at 15. Defendants cannot meet their burden to prove invalidity by clear and convincing evidence, particularly when all of the factual inferences are drawn in Eolas’ favor. *See Microsoft Corp. v. i4i Ltd. P’ship*, 131 S. Ct. 2238, 2242 (2011); *i2 Techs., Inc. v. Oracle Corp.*, No. 6:09-CV-194-LED, 2011 U.S. Dist. LEXIS 6053, at \*9 (E.D. Tex. Jan. 21, 2011).

## **III. RESPONSE TO STATEMENT OF UNDISPUTED MATERIAL FACTS**

1. Disputed. As the Court notes in its Order, “the [‘embed text format’] term is

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<sup>1</sup> The patents-in-suit are Patent Nos. 5,838,906 (“’906 Patent”) and 7,599,985 (“’985 Patent”).

supported in the specification by the disclosure of the EMBED tag ('906 patent, 14:32–33).” Order at 15. Additionally, Defendants’ assertion that interpreted scripting languages are not disclosed in the specification is incorrect. The specification teaches that applications written in interpreted scripting languages—like PostScript—may be used with the invention. Ex. A<sup>2</sup> ('906 patent) at col.12 l.54–col.13 l.18 (“As shown in Table II, the EMBED tag includes TYPE . . . [o]ther types are possible such as . . . ‘application/postscript.’”).<sup>3</sup>

2. Disputed. As the specification explains, the patentees attached Appendices A and B to their patent, which contained source code providing “details of a specific embodiment of the invention in conjunction with the discussion of the routines in this specification.” Ex. A ('906 Patent) at col.8 ll.5–15, col.13 ll.44–50. In these appendices—which Defendants neglect to attach to their Motion—the applicants disclosed the use of an “IMAGE3D tag” as an “embed text format.” Ex. C (Appendix A of '906 Patent) at 9 (MT\_IMAGE3D), 174 (M\_IMAGE3D) (showing examples of the IMAGE3D “embed text format”).<sup>4</sup>

**IV. EOLAS’ STATEMENT OF UNDISPUTED MATERIAL FACTS**

3. In their Motion, Defendants recycle their claim construction arguments almost verbatim, as illustrated in the following table:

| <u>Defendants’ Claim Construction Brief</u>   | <u>Defendants’ Motion</u>  |
|---|--|
| 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. Dkt. 569 at 11. | The term “embed text format” is not found in the specification to the patents-in-suit. Rather, it was coined by the inventors and added to the claims by amendment during prosecution long after the first filing. Motion at 1; <i>See also id.</i> at |

<sup>2</sup> Hereinafter Ex. A includes the '906 patent (Ex. A1) and its reexamination certificate (Ex. A2).

<sup>3</sup> PostScript—like JavaScript—is an interpreted script language. Ex. B (“PostScript Reference” *available at* <http://www.adobe.com/products/postscript/pdfs/PLRM.pdf>) at 24–25 (“The PostScript interpreter executes the PostScript language according to the rules in this chapter.”).

<sup>4</sup> *See also* Ex. D (Appendix B of '906 Patent) (containing other applicant-submitted source code); Ex. E (7-22-11 Ang Deposition) at 625:12-626:15 (“[P]rior to using the tag e-m-b-e-d, IMAGE3D was used as another instance of an embed text format for HTML.”)

|  |  |
|--|--|
|  | 3–4 (making the same argument).  |
| The only embodiment of an “embed text format” disclosed is the EMBED tag of Table II. Dkt. 569 at 12.  | [T]he only example of a so-called “embed text format” found in the patents is the HTML EMBED tag referenced in Table II. Motion at 1; <i>See also id.</i> at 4 (making the same argument).       |
| Structurally, the specification and prosecution history demonstrate that the claimed embed text format is not just any text format, but a special tag . . . 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. Dkt. 569 at 11.   | When distinguishing the prior art Mosaic browser, the applicant relied heavily upon its “special” embed <i>tag</i> to distinguish the prior art . . . Motion at 5.                               |
| 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). . . . Thus, the claims require the embed text format and the display area to both be located at the same location. Dkt. 569 at 12. | During prosecution, the applicant repeatedly noted that a key characteristic of the claimed invention is that the object is displayed at the location of the “embed text format.” Motion at 6–7. |

4. The Court rejected the Defendants’ claim construction arguments. Order at 15.

5. The Court construed “embed text format” as “coded information that specifies to a browser application that an object is to be embedded in a displayed hypermedia document” and noted that “embed text format” as supported by the specification is not limited to only a tag. *Id.*

6. The specification of the patents-in-suit—including the source code appendices—discloses examples of “embed text format” that are not the EMBED tag of Table II. For example, the source code appendices disclose the use of the IMAGE3D tag as an “embed text format.” *See supra* Part III (discussing IMAGE3D’s use in Appendix A of the ’906 Patent).

7. The specification of the patents-in-suit discloses the use of interpreted scripting languages like PostScript. *See supra* Part III. *See also* Ex. I (Declaration of David Martin)

8. One of ordinary skill in the art would recognize that there are many ways to implement the inventions claimed by the patents-in-suit and that the claimed “embed text format” is not limited to a specific tag or type of tag. Ex. F (Martin Report) at ¶¶ 108–15.

## V. WRITTEN DESCRIPTION LAW

“Compliance with the written description requirement is a question of fact . . . .” that “will necessarily vary depending on the context[,]” “the nature and scope of the claims[,] and on the complexity and predictability of the relevant technology.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc); *Crown Packaging Tech., Inc. v. Ball Metal Beverage Container Corp.*, 635 F.3d 1373, 1380 (Fed. Cir. 2011). “The disclosure must reasonably convey to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Crown*, 635 F.3d at 1380 (quotations and citations omitted). On a motion for summary judgment of invalidity in light of an alleged failure to provide an adequate written description, Defendants have the burden to prove invalidity by clear and convincing evidence. *Microsoft v. i4i*, 131 S. Ct. at 2242.

The written description need not recite the claimed invention in *haec verba*. *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 923 (Fed. Cir. 2004). Additionally, the Federal Circuit has “repeatedly warned against confining the claims to” “very specific embodiments of the invention” found in the specification and has

expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment . . . because persons of ordinary skill in the art rarely would confine their definitions of terms to the exact representations depicted in the embodiments.

*Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc); *see also Crown*, 635 F.3d at 1381–83 (noting that the “written description support[ed] the asserted claims” and reversing the district court’s written description invalidity finding).

In support of their Motion, Defendants cite three cases and assert that “summary judgment is appropriate where ‘expansive claim language’ is supported by only one specific embodiment and the record establishes that the generic claimed invention was not in the possession of the inventor.” *ICU Med., Inc. v. Alaris Med. Sys.*, 558 F.3d 1368 (Fed. Cir. 2009);

*LizardTech, Inc. v. Earth Res. Mapping*, 424 F.3d 1336 (Fed. Cir. 2005); *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998). Motion at 2–3. However, as the Federal Circuit explained in rejecting the same arguments Defendants make here, “[i]n each of those cases[, *ICU*, *Lizard*, and *Tronzo*], the specification *unambiguously* limited the scope of the invention.” *Crown Packaging*, 635 F.3d at 1382 (emphasis added). Here, as the Court’s Order recognized, the specification of the patents-in-suit does not limit the scope of the invention and the term “embed text format.”

## VI. ARGUMENT

### A. “Embed Text Format” Is Supported By the Specification—And the Court Has Already Rejected Defendants’ Attempt to Limit It to the EMBED Tag.

Defendants assert that the “only support for the embed text format is an HTML embed tag.” Motion at 5. They are mistaken. First, Defendants made this very argument in claim construction and the Court expressly rejected it. *Compare* Dkt. 569 (Defendants’ Claim Construction Brief) at 12 (“The only embodiment of an ‘embed text format’ disclosed is the EMBED tag of Table II.”), *with* Order at 15 (“The term is supported in the specification by the disclosure of the EMBED tag (‘906 patent, 14:32–33); however, the term is not limited to only a tag.”). Second, the source code appendices that the patentees attached to the patents-in-suit—which Defendants neglect to attach to their Motion—disclose the use of an “embed text format” which is not an EMBED tag—namely, the IMAGE3D tag. *See supra* Part III (discussing IMAGE3D’s use in Appendix A of the ’906 Patent and inventor Ang’s deposition testimony relating to IMAGE3D as an “embed text format” example). In light of these two facts, neither of which Defendants address, Defendants’ Motion should be denied.<sup>5</sup>

Moreover, when the specification of the patents-in-suit discusses “embed text format,” it

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<sup>5</sup> Defendants also cite to Dr. Doyle’s trial testimony from the Microsoft trial in apparent support of their assertion that “embed text format” must be limited to an EMBED tag. *See* Motion at 4. However, the “embed text format” at issue in the Microsoft case was the OBJECT tag. *See e.g.*, Ex. G (MS Trial Tr.) at 1006:5–1007:7 (Eolas’ expert discussing the OBJECT tag).



does so in a non-limiting manner—as recognized by the Court’s Order. The specification of the patents-in-suit states that “[t]able II, below, shows *an example* of an HTML tag format used by the present invention to embed a link.” Ex. A (’906 patent) at col.12 ll.54–56 (emphasis added). Further, deposition testimony of the inventors clarified any misconceptions Defendants might have had about the language in the specification. *See* Ex. E (7-22-11 Ang Deposition) at 581:5–7 (“So this description actually provides an example and it describes an embodiment of the invention.”); *See also* Ex. H (6-30-11 Doyle Deposition) at 483:25–484:3 (“This is one example of an embed text format. It could be implemented in any manner that is consistent with the language in the claim, in any particular claim, in either of the patents.”). Thus, the specification not only describes multiple types of “embed text formats,” but also it describes those formats in a non-limiting manner—as recognized by both the Court and the inventors.<sup>6</sup> *See Crown Packaging*, 635 F.3d at 1382 (finding no written description issue where—as here—the specification does not “*unambiguously* limit[] the scope of the invention.”) (emphasis added).

**B. Defendants’ Claim That “Embed Text Format” Must Be Limited to a “Special” Tag Is Incorrect And Has Already Been Rejected by the Court.**

Defendants’ assertion that an “embed text format” must take the form of a “special” tag—namely, the EMBED tag—has already been considered and rejected by the Court. *Compare* dkt. 569 (Defendants’ Claim Construction Brief) at 11 (“[D]uring 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.”), *with* Order at 15 (“[T]he term is not limited to only a tag. Consistent with the Court’s construction of ‘text format,’ and in view of the specification, the Court construes ‘embed text format’ as ‘coded information that specifies to a

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<sup>6</sup> As *Phillips* makes clear and as the Court explicitly recognized in its Order, merely providing an exemplary embodiment of the invention—as the inventors of the patents-in-suit did—does not limit the scope of the claims. *See Phillips*, 415 F.3d at 1323; Order at 15.

browser application that an object is to be embedded in a displayed hypermedia document.”). Thus, to qualify as an “embed text format,” candidate information must satisfy the Court’s construction, which the Court found to be rooted in the patents’ specification. It would be strange indeed if “embed text format” were to run afoul of the written description requirement, given that Court’s definition of the term was based upon the specification of the patents-in-suit. *Id.*<sup>7</sup> Defendants’ Motion provides no answers to this fundamental quandary.

**C. Defendants’ Claim That the Object Must be Displayed at the Location of the “Embed Text Format” Has Also Been Rejected by the Court.**

Like the first two issues raised by Defendants, Defendants’ arguments directed to the location of the displayed object have been considered and rejected by the Court. *Compare* Dkt. 569 (Defendants’ Claim Construction Brief) at 12 (trying to limit the term so that the “embed text format” “must appear in the same place (in the page’s source code) as the display of the object occurs (in the displayed document)”), *with* Order at 17 (“The ‘location’ terms are clear and understandable. Defendants’ proposed construction improperly includes a requirement that the term designate where the embedded object will appear within the displayed document.”).<sup>8</sup>

**VII. CONCLUSION**

The relief Defendants seek is precluded by a genuine issue of material fact: whether a person of ordinary skill at the time the ’906 patent application was filed would have believed the inventors possessed what was claimed. Defendants’ Motion largely sidesteps this ultimate issue, but the nature of the patents’ disclosure, the Court’s Order, and expert opinion<sup>9</sup> indicate that it should be resolved in Eolas’ favor, particularly at the summary judgment stage.

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<sup>7</sup> Defendants’ arguments about “JavaScript” and “other scripting languages” are misplaced and out-of-context—the Court’s construction does not limit “embed text format” to a “special tag.” Motion at 5. In any event, as explained *supra*, the specification of the patents-in-suit discloses and discusses the use of interpreted scripting languages like PostScript. *See supra* Part III.

<sup>8</sup> *See also* Ex. F (Expert Report of David Martin) at ¶¶ 108–15.

<sup>9</sup> *See* Ex. I (Declaration of David Martin) (explaining that a person of ordinary skill would have believed the inventors possessed what is claimed at the time of filing).

Dated: September 28, 2011.

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the above and foregoing document has been served on all counsel of record via the Court's ECF system on September 28, 2011.

/s/ Josh Budwin  
Josh Budwin