Interval Licensing LLC v. eBay, Inc. et al Doc. 188 Att. 1

HON. MARSHA J. PECHMAN

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

INTERVAL LICENSING LLC, Plaintiff, v. AOL, INC.; APPLE, INC.; eBAY, INC.; FACEBOOK, INC.; GOOGLE INC.; NETFLIX, INC.; OFFICE DEPOT, INC.; OFFICEMAX INC.; STAPLES, INC.; YAHOO! INC.; AND YOUTUBE, LLC, Defendants.	Case No. 2:10-cv-01385-MJP **Defendants' Invalidity Contentions**

Pursuant to the Court's February 16, 2011 Scheduling Order, the Court's Standing Order for Patent Cases, and Local Patent Rules ("P.R.") 121 and 122, Defendants in the above-captioned Action (collectively, "Defendants") hereby serve these Invalidity Contentions ("Invalidity Contentions") and accompanying document production on Plaintiff and Counterclaim Defendant Interval Licensing LLC ("Plaintiff" or "Interval"). Each Defendant will separately serve Non-Infringement Contentions.

I. INTRODUCTION

Plaintiff has asserted against Defendants one or more claims of one or more of United States Patent Nos. 6,263,507 (the "'507 Patent"), 6,757,682 (the "'682 Patent"), 6,034,652 (the

EXHIBIT A

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"'652 Patent"), and 6,788,314 (the "'314 Patent") (collectively, "Asserted Patents"). *See* Plaintiff's Disclosure of Asserted Claims and Infringement Contentions, served on Defendants on December 28, 2010 ("Infringement Contentions"). Each Defendant joins these Invalidity Contentions only as to those claims of those patents asserted against that Defendant.

Defendants' Invalidity Contentions are based on their present understanding of the asserted claims and Plaintiff's apparent construction of the claims in its Infringement Contentions. Accordingly, Defendants' Invalidity Contentions, including the attached invalidity claim charts, may reflect alternative positions regarding claim construction and scope. Further, by including prior art that anticipates or renders obvious claims based on Plaintiff's apparent claim construction or any other particular claim construction, Defendants are not adopting Plaintiff's claim construction, nor are they admitting to the accuracy of any particular claim construction.

By mapping particular claim language to prior art references in the accompanying claim charts, Defendants are not implying or admitting that such claim language is entitled to patentable weight when the claim as a whole is compared to the prior art to determine invalidity under Sec. 102 or 103 of the Patent Act.

The accompanying invalidity claim charts list specific examples of prior art references and systems which disclose, either expressly or inherently, each limitation of certain claims and/or examples of prior art references and systems in view of which a person of ordinary skill in the art would have considered each limitation and the claimed combination of such limitations obvious. Defendants have endeavored to identify the relevant portions of the references and features of the systems. The references and systems, however, may contain additional support for other claim limitations. Defendants may rely on uncited portions of the references and/or uncited features of the systems, other documents and expert testimony to provide context or to aid in understanding the cited portions of the references and/or cited features of the systems. Where Defendants cite to a particular figure in a reference, the citation should be understood to encompass the caption and description of the figure and any text relating to the figure.

Conversely, where Defendants cite to particular text referring to a figure, the citation should be understood to include the figure as well.

Consistent with P.R. 124, Defendants reserve the right to amend these disclosures and associated document production should Plaintiff provide any information that it failed to provide in its Infringement Contentions or should Plaintiff amend its Infringement Contentions in any way. Moreover, Defendants reserve the right to revise their ultimate contentions concerning the invalidity of the asserted claims in light of the Court's construction of the asserted claims, any findings as to the priority date or effective filing date of the asserted claims, any additional prior art discovered or further developed during the course of the litigation, and/or positions that Plaintiff or expert witness(es) may take concerning claim construction, infringement, and/or invalidity issues. Defendants hereby provide disclosures and related documents pertaining only to the asserted claims identified by Plaintiff in its Infringement Contentions. Defendants reserve the right to modify, amend, or supplement these Invalidity Contentions to show the invalidity of any additional claims that the Court may allow Plaintiff to later assert. Defendants further reserve the right to supplement their P.R. 122 document production should they later find additional prior art, including without limitation patents, publications, documents, software, and/or source code.

Defendants also reserve the right to rely on any admitted prior art identified in the Asserted Patents, including admissions as to the state of the art at the time the applications were filed and admissions that any elements of the patent claims disclosed in this admitted prior art are not novel.

Defendants further may rely on any express or implied patent-applicant admissions or admissions in the Asserted Patents or the prosecution thereof concerning the scope or content of prior art; the patent prosecution histories for the Asserted Patents; any deposition testimony of the applicants for the Asserted Patents; and the papers filed and any evidence submitted by Plaintiff in connection with this litigation. In particular, Defendants reserve the right to assert that the asserted claims are invalid under 35 U.S.C. § 102(f) and/or (g) in the event Defendants obtain evidence that the named inventors did not invent (either alone or in conjunction with others) the subject matter claimed in the Asserted Patents or that others invented the subject matter claimed

before the named inventors. Should Defendants obtain such evidence, they will provide the name of the person(s) from whom and the circumstances under which the claimed subject matter or any part of it was derived or any prior inventors.

Prior art not included in this disclosure, whether known or not known to Defendants, may become relevant. In particular, Defendants are currently unaware of the extent, if any, to which Plaintiff will contend that limitations of the Asserted Patents are not disclosed in the prior art identified by Defendants. To the extent that such an issue arises, Defendants reserve the right to identify other references that disclose the allegedly missing limitation(s) of the disclosed device or method and thus render obvious the claims of the Asserted Patents. Further, because discovery has only recently begun and because Defendants have not yet completed their search for and analysis of relevant prior art, Defendants reserve the right to revise, amend, and/or supplement the information provided herein, including identifying, charting, and relying on additional references, should Defendants' continuing search and analysis yield additional information or references, consistent with the Patent Rules and the Federal Rules of Civil Procedure.

Additionally, because third-party discovery has not yet begun, Defendants reserve the right to present additional items of prior art under 35 U.S.C. §§ 102(a), (b), (e), (f), and/or (g), and/or § 103, located during the course of such discovery or further investigation, and to assert invalidity under 35 U.S.C. §§ 102(a), (b), (c), (d), (e), (f) or (g), to the extent that such discovery or investigation yields information forming the basis for such invalidity. For example, one or more Defendants expect to issue subpoenas to, and receive information from, third parties believed to have knowledge, documentation, and/or corroborating evidence concerning some of the prior art listed below and/or additional prior art. These third parties include, without limitation, the authors, inventors, or assignees of the references listed in these disclosures.

For prior art patents that qualify as Section 102(b) prior art, Defendants may also rely upon the patent's Patent Office file history as a Section 102(b) prior publication.

II. THE ’507 PATENT

A. Anticipation

Pursuant to P.R. 121, Defendants identify the following prior art now known to Defendants to anticipate the asserted claims of the ’507 Patent under at least 35 U.S.C. §§ 102(a), (b), (e), and/or (g), either expressly or inherently as understood by a person having ordinary skill in the art. In some instances, Defendants have treated certain prior art as anticipatory where certain elements are inherently present, and in particular where elements are inherently present based on Plaintiff’s apparent claim construction in its Infringement Contentions. Invalidity claim charts for these references with respect to the ’507 Patent are attached to these Invalidity Contentions.

1. Bender et al., Network Plus, in SPIE Vol. 900 Imaging Applications in the Work World, January 12-13, 1988 (published by SPIE – The International Society for Optical Engineering).
2. Chesnais et al., The Fishwrap Personalized News System, in Proceedings of the Second International Workshop on Community Networking, 1995, “Integrated Multimedia Services to the Home,” June 20-22, 1995 (published by IEEE).
3. Iwayama et al., Cluster-Based Text Categorization: A Comparison of Category Search Strategies, SIGIR 1995 (published by ACM).
4. Masand et al., Classifying News Stories Using Memory Based Reasoning, SIGIR 1992 (published by ACM).
5. Hjelsvold et al., Integrated Video Archive Tools, in Multimedia ’95, 1995 (published by ACM).
6. Drummond et al., Intelligent Browsing for Multimedia Applications, in Proceedings of MULTIMEDIA ’96, 1996 (published by IEEE).
7. Joachims et al., WebWatcher: Machine Learning and Hypertext, May 29, 1995.
8. Pentland et al., Photobook: Content-Based Manipulation of Image Databases, in International Journal of Computer Vision, 1996 (published by Kluwer Academic Publishers).

9. Pentland et al., Photobook: Content-Based Manipulation of Image Databases, in M.I.T. Media Laboratory Perceptual Computing Technical Report No. 255, 1993 (Pentland 1993).
10. Kindermann et al., The MIHMA Demonstrator Application: bmt line, April 1996.
11. Japanese Laid-Open Patent Application No. H08-106543 to Taniguchi et al. (filed October 5, 1994, published April 23, 1996).
12. Japanese Laid-Open Patent Application No. H07-114572 to Yuasa et al. (filed October 18, 1993, published May 2, 1995).
13. U.S. Patent No. 5,870,770 to Wolfe (filed Jan. 28, 1998, continuation of Ser. No. 487,925, Jun. 7, 1995, issued Feb. 9, 1999).
14. U.S. Patent No. 5,870,754 to Dimitrova et al. (filed Apr. 25, 1996, issued Feb. 9, 1999).
15. U.S. Patent No. 5,485,611 to Astle (filed Dec. 30, 1994, issued Jan. 16, 1996).
16. U.S. Patent No. 5,754,938 to Herz et al. (filed Oct. 31, 1995, issued May 19, 1998).
17. U.S. Patent No. 5,740,549 to Reilly et al. (filed Jun. 12, 1995, issued Apr. 14, 1998).
18. U.S. Patent No. 5,774,664 to Hidary et al. (filed Mar. 25, 1996, issued Jun. 30, 1998).
19. U.S. Patent No. 5,835,667 to Wactlar et al. (filed Oct. 14, 1994, issued Nov. 10, 1998).
20. U.S. Patent No. 6,025,837 to Matthews, III et al. (filed Mar. 29, 1996, issued Feb. 15, 2000).
21. U.S. Patent No. 5,553,221 to Reimer et al. (filed Jun. 1, 1995, issued Sep. 3, 1996).
22. Systems[1] and methods invented, designed, developed and/or in public use or on sale related to Network Plus, as exemplified by the Bender article and subject to further discovery. Based upon information currently available to Defendants, Defendants believe that such a system was designed and developed at least before December 4, 1995, and may have been in public use or on sale on or before December 4, 1995.
23. Systems and methods invented, designed, developed and/or in public use or on sale related to Fishwrap, as exemplified by the Chesnais article and subject to further discovery.

[1] For further information on the system art, please refer to the chart for the publication or patent that exemplifies the art.

Based upon information currently available to Defendants, Defendants believe that such a system was designed and developed at least before December 4, 1995, and may have been in public use or on sale on or before December 4, 1995.

24. Systems and methods invented, designed, developed and/or in public use or on sale related to Pointcast, as exemplified by the Reilly '549 patent and subject to further discovery. Based upon information currently available to Defendants, Defendants believe that such a system was designed and developed at least before December 4, 1995, and may have been in public use or on sale on or before December 4, 1995.

25. Systems and methods invented, designed, developed and/or in public use or on sale related to Photobook, as exemplified by both of the Pentland articles. Based upon information currently available to Defendants, Defendants believe that such a system was designed and developed at least before November 1993, and may have been in public use or on sale on or before November 1993.

26. Systems and methods invented, designed, developed and/or in public use or on sale related to SEEKER and Dow Jones, as exemplified by the Masand article. Based upon information currently available to Defendants, Defendants believe that such a system was designed and developed at least before December 4, 1995, and may have been in public use or on sale on or before December 4, 1995.

27. Office Depot's "Better Together" feature accused of infringement by Interval. On information and belief, the feature of showing "Better Together" items was first invented, designed, developed, and publicly implemented by Office Depot prior to 1996. Defendants are still investigating this prior art system. To the extent that Interval contends that Office Depot's "Better Together" feature infringes any claims, that allegation would simultaneously render such claims invalid.

B. Obviousness

Pursuant to P.R. 121, Defendants identify the following additional prior art references and systems now known to Defendants that either alone or in combination with other prior art (including any of the above-identified anticipatory prior art and the additional prior art disclosed

in this section) render the asserted claims of the ’507 Patent invalid as obvious under 35 U.S.C. § 103. Invalidity claim charts for these references with respect to the ’507 Patent are also attached to these Invalidity Contentions.

1. U.S. Patent No. 5,583,560 to Florin et al. (filed Jun. 22, 1993, issued Dec. 10, 1996).
2. U.S. Patent No. 6,199,080 to Nielsen (filed Aug. 30, 1996, issued Mar. 6, 2001).
3. U.S. Patent No. 5,963,916 to Kaplan (filed Oct. 31, 1996, issued Oct. 5, 1999).
4. Brown et al., Automatic Content-Based Retrieval of Broadcast News, in ACM Multimedia 1995, Nov. 5-9, 1995 (published by ACM).
5. Cavnar et al., N-Gram Based Text Categorization, in Proceedings of SDAIR-94, 3rd Annual Symposium on Document Analysis and Information Retrieval, 1994 (published by ACM).
6. Buckley et al., The Effect of Adding Relevance Information in a Relevance Feedback Environment, in DIGIR 94, 1994.
7. Salton, Introduction to Modern Information Retrieval, 1983 (published by McGraw-Hill).
8. Salton et al., Improving Retrieval Performance by Relevance Feedback, in Journal for American Society for Information Science, June 1990.
9. Nielsen, Hypertext and Hypermedia, 1990 (published by Academic Press, Inc.).

Each prior art reference and system (collectively for this subsection, “references”) disclosed in the preceding Anticipation section and in this Obviousness section, either alone or in combination with other prior art, also renders the asserted claims of the ’507 Patent invalid as obvious.

In addition, the patent specification acknowledges that “relevance feedback” was disclosed in the prior art. For example, the patent states that “[t]he use of relevance feedback to determine the similarity between two text segments is well-known, and is described in more detail in, for example, the textbook entitled *Introduction to Modern Information Retrieval*, by Gerard Salton, McGraw-Hill, New York, 1983, ...” (28:55-60).

In addition, each anticipatory prior art reference and/or each additional prior art reference may be combined with (1) information known to persons skilled in the art at the time of the

alleged invention, (2) any of the anticipatory prior art references, and/or (3) any of the additional prior art references identified above in this section to render these claims invalid as obvious.

The United States Supreme Court has clarified the standard for what types of inventions are patentable. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). In particular, the Supreme Court emphasized that inventions arising from ordinary innovation, ordinary skill, or common sense should not be patentable. *Id*. at 1732, 1738, 1742-43, 1746. In that regard, a patent claim may be obvious if the combination of elements was obvious to try or there existed at the time of the invention a known problem for which there was an obvious solution encompassed by the patent's claims. In addition, when a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.

Because the '507 Patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than what one would expect from such an arrangement, the '507 Patent's combination of known elements was obvious to a person of ordinary skill in the art at the time of the alleged invention. Further, in the prior art, there were well-recognized design needs and market pressures to develop a browser for use in navigating a "body of information." Such design needs and market pressures provided ample reason to combine the prior art elements. *KSR*, 127 S. Ct. at 1742. Moreover, since there were a finite number of predictable solutions, a person of ordinary skill in the art had good reason to pursue the known options. *Id*. The above '507 Patent merely uses those familiar elements for their primary or well-known purposes in a manner well within the ordinary level of skill in the art. Accordingly, common sense and knowledge of the prior art render the asserted claims of the '507 Patent invalid under either § 102 and/or § 103.

Moreover, a person of ordinary skill would have been motivated to combine the above prior art based on the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. The identified prior art addresses the same or similar technical issues and suggests the same or similar solutions to those issues. To the extent that Plaintiff challenges a combination of prior art with respect to a particular element,

Defendants reserve the right to supplement these contentions to further specify the motivation to combine the prior art. Defendants may rely on cited or uncited portions of the prior art, other documents, and expert testimony to establish that a person of ordinary skill in the art would have been motivated to modify or combine the prior art so as to render the claims invalid as obvious.

Defendants further identify combinations of prior art (including any of the above-identified anticipatory prior art and the additional prior art disclosed in this section) that render the asserted claims of the ’507 Patent invalid as obvious under 35 U.S.C. § 103. Below are several examples of prior art combinations with respect to particular limitations. These prior art combinations are not exhaustive; rather, they are illustrative examples of the prior art combinations disclosed generally above. These exemplary combinations are alternatives to Defendants’ anticipation and single-reference obviousness contentions, and, thus, they should not be interpreted as indicating that any of the individual references included in the exemplary combinations are by themselves invalidating prior art under 35 U.S.C. §§ 102 and/or 103.

To the extent that Plaintiff contends that any of the above-identified prior art fails to disclose one or more limitations of the asserted claims of the ’507 Patent, Defendants reserve the right to identify other prior art references that would render the claims obvious despite the allegedly missing limitation. Defendants reserve all rights to supplement or modify these Invalidity Contentions and to rely on other references that prove invalidity of these claims in a manner consistent with the Federal Rules of Civil Procedure and the Rules of this Court.

1. Bender in view of one or more of the following: Joachims, Taniguchi, Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent, Kaplan, Iwayama, Masand, Yuasa, Salton article, Salton book, Herz, and Buckley.
2. Chesnais in view of one or more of the following: Bender, Joachims, Taniguchi, Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent, Kaplan, Iwayama, Masand, Yuasa, Salton article, Salton book, Herz, and Buckley.
3. Iwayama in view of one or more of the following: Masand, Yuasa, Cavnar, Salton book, Salton article, Buckley, and Herz.

4. Masand in view of one or more of the following: Iwayama, Yuasa, Cavnar, Salton book, Salton article, Buckley and Herz.
5. Yuasa in view of one or more of the following: Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
6. Hjelsvold in view of one or more of the following: Bender, Joachims, Taniguchi, Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent, Kaplan, Iwayama, Masand, Yuasa, Salton article, Salton book, Herz, and Buckley.
7. Joachims in view of one or more of the following: Bender, Chesnais, Taniguchi, Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent, Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.
8. Drummond in view of one or more of the following: Bender, Wolfe, Taniguchi, Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley, Herz, Matthews, and Yuasa.
9. Pentland in view of one or more of the following: Chesnais, Bender, Joachims, Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent, Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.
10. Pentland 1993 in view of one or more of the following: Chesnais, Bender, Joachims, Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent, Kaplan, Iwayama, Masand, Yuasa, Salton , Herz, and Buckley.
11. Taniguchi in view of one more of the following: Chesnais, Bender, Joachims, Taniguchi, Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent, Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.
12. Wolfe in view of one or more of the following: Bender, Chesnais, Wactlar, Reimer, Nielsen book, Nielsen patent, Dimitrova, Yuasa, Iwayama, Masand, Cavnar, Salton article, Salton book, Buckley and Herz.
13. Dimitrova in view of one or more of the following: Bender, Chesnais, Wactlar, Reimer, Nielsen book, Nielsen patent, Wolfe, Yuasa, Iwayama, Masand, Cavnar, Salton article, Salton book, Buckley and Herz.

14. Astle in view of one or more of the following: Bender, Chesnais, Wactlar, Reimer, Nielsen book, Nielsen patent, Wolfe, Yuasa, Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
15. Reilly in view of one or more of the following: Bender, Chesnais, Taniguchi, Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent, Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.
16. Hidary in view of one or more of the following: Bender, Chesnais, Taniguchi, Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent, Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.
17. Wactlar in view of one or more of the following: Wolfe, Bender, Chesnais, Yuasa, Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
18. Matthews in view of one or more of the following: Wolfe, Bender, Chesnais, Yuasa, Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
19. Reimer in view of one or more of the following: Wolfe, Bender, Chesnais, Yuasa, Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
20. Florin in view of one or more of the following: Wolfe, Bender, Chesnais, Yuasa, Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
21. Nielsen in view of one or more of the following: Wolfe, Bender, Chesnais, Yuasa, Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
22. Brown in view of one or more of the following: Wolfe, Bender, Chesnais, Yuasa, Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
23. Kindermann in view of one or more of the following: Bender, Chesnais, Taniguchi, Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent, Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.

C. Invalidity Under 35 U.S.C. § 112

The Court's Standing Order for Patent Cases requires, for each asserted claim, the identification of "any grounds for invalidity based on indefiniteness, enablement, or written description under 35 U.S.C. § 112." Defendants provide below their preliminary invalidity

contentions on those three issues, for the asserted claims, preserving all other invalidity contentions under other provisions of Section 112 (or any other Sections, such as Section 101), and preserving all invalidity contentions for the non-asserted claims.

All asserted claims of the '507 Patent violate the requirements of Section 112, ¶ 2, and all asserted claims fail to satisfy the enablement and written description requirements of Section 112, ¶ 1.

1. Legal Background Regarding Indefiniteness, Enablement, and Written Disclosure

Section 112 includes a definiteness requirement. *See* 35 U.S.C. § 112(2) ("[T]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."). When claims are "not amenable to construction" or "insolubly ambiguous," they are indefinite. *Young v. Lumenis, Inc.*, 497 F.3d 1336, 1346 (Fed. Cir. 2007).

The definiteness requirement requires that the claim must set forth what the applicant regards as the invention, and do so with sufficient particularity and definiteness. *Allen Eng'g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir. 2002). Where it would be apparent to one of skill in the art, based on the patent specification, that the "invention" set forth in a claim is not what the patent applicant regarded as the invention, the claim is invalid. *Id.*

If a patent applicant coins a term used in a patent claim, she has a duty to define that coined term with precision or else the claim may be invalid for indefiniteness. *J.T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1570 (Fed. Cir. 1997). Inconsistencies between a claim and a disclosure of a patent may render the claim indefinite. A patent claim is indefinite if it claims both a system and a method of using the system. *IPXL Holdings LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1383-84 (Fed. Cir. 2005). Where a patent fails to specify which of available alternative tests to use for measuring compliance with a claim limitation, and different tests can have different results, the claims are indefinite. *Honeywell Int'l, Inc. v. ITC*, 341 F.3d 1332 (Fed. Cir. 2003). "Whether the patent expressly or at least clearly differentiates itself from specific prior art … is an important consideration in the definiteness inquiry." *Halliburton Energy Servs.*,

Inc. v. M-I LLC, 514 F.3d 1244 (Fed. Cir. 2008). Claim limitations that lack a definite scope and include aspects that are inherently subjective are also indefinite under 35 U.S.C. § 112(2). *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350-52 (Fed. Cir. 2005) (affirming holding that the claim term "aesthetically pleasing" was indefinite because "the scope of claim language cannot depend solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention").

To determine the proper scope of a means-plus-function claim in accordance with 35 U.S.C. § 112(6), a court must review the patent specification to identify what corresponding structure is disclosed as performing the claimed function. *Micro Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250, 1257 (Fed. Cir. 1999). When a patent specification does not disclose an algorithm corresponding to a computer-enabled means-plus-function limitation, the claim necessarily fails to particularly point out and distinctly claim the invention as required by 35 U.S.C. § 112(2). *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1340-41 (Fed. Cir. 2008), *cert. denied*, 129 S. Ct. 754 (2008); *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333-35 (Fed. Cir. 2008), *cert. denied*, 129 S. Ct. 754 (2008); *see also Blackboard, Inc. v. Desire2Learn Inc.*, 574 F.3d 1371, 1384 (Fed. Cir. 2009); *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1367 (Fed. Cir. 2008).

A patent claim reciting a function without using the term "means" is still subject to Section 112(6) if "the claim term fails to recite sufficiently definite structure or else recites function without reciting sufficient structure for performing that function." *Massachusetts Inst. of Tech. and Elecs. for Imaging, Inc. v. Abacus Software*, 462 F.3d 1344, 1353 (Fed. Cir. 2006) (internal quotations and citations omitted); *see also, e.g., Welker Bearing Co. v. PHD, Inc.*, 550 F.3d 1090, 1096 (Fed. Cir. 2008) (ruling claim limitation reciting "a mechanism for moving …" was a means-plus-function limitation despite not including the word "means" because "no adjective endows the claimed 'mechanism' with a physical or structural component"); *Inventio AG v. ThyssenKrupp Elevator Americas Corp.*, 718 F. Supp. 2d 529, 558-59 (D. Del. 2010) (holding claim term "computing unit" was a means-plus-function limitation because nothing in

the claim language provided sufficient structure for any of the functions performed by the "computing unit").

35 U.S.C. § 112 further includes an enablement requirement. *See* 35 U.S.C. § 112(1) ("The specification shall contain a written description . . . of the manner and process of making and using [the invention] in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.").

To satisfy the enablement requirement, the disclosure "must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999 (Fed. Cir. 2008). Moreover, "[i]t is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement." *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997). "If, by following the steps set forth in the specification, one of ordinary skill in the art is not able to replicate the claimed invention without undue experimentation, the claim has not been enabled as required by 112, paragraph 1." *National Recovery Tech., Inc. v. Magnetic Separation Syst., Inc.*, 166 F.3d 1190 (Fed. Cir. 1990). Similarly, if a specification teaches away from a substantial portion of the claim, or otherwise does not enable the full scope of the claim, there is no enablement. *AK Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003); *see also Alza Corp. v. Andrx Pharms.*, 603 F.3d 935, 940–43 (Fed. Cir. 2010) (claims covering both non-osmotic and osmotic embodiments were invalid for the patent's failure to enable non-osmotic embodiments); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999–1002 (Fed. Cir. 2008) (claims covering invention's use with both movies and video games were invalid for patent's failure to enable the claimed "invention" in the context of movies); *Automotive Techs. Int'l, Inc. v. BMW of N. Am., Inc.*, 501 F.3d 1274, 1281–85 (Fed. Cir. 2007) (claims covering both mechanical and electronic sensors were invalid for patent's failure to enable electrical sensors); *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1377–80 (Fed. Cir. 2007) (claims covering injectors with or without a pressure jacket were invalid for patent's failure to enable injector without a pressure jacket).

35 U.S.C. § 112 further includes a written description requirement. *See* 35 U.S.C. § 112(1) ("The specification shall contain a written description of the invention . . . ."). "The test [for written description support] requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed." *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336 (Fed. Cir. 2010) (en banc). The disclosure of the claimed subject matter must be:

- express or necessarily present, *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998);
- complete, *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1995) ("One shows that one is 'in possession' of the invention by describing the invention, with all its claimed limitations….");
- unambiguous, *Hyatt v. Boone*, 146 F.3d 1348, 1352 (Fed. Cir. 1998),
- specific, *Purdue Pharma L.P. v. F.H. Faulding and Co.*, 230 F.3d 1320, 1322 (Fed. Cir. 2000); and
- as broad as the claim, *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1478-80 (Fed. Cir. 1998).

The specification must describe the claimed invention in sufficient detail so that a person having ordinary skill in the art can recognize what is claimed. "The appearance of mere indistinct words in a specification or a claim, even an original claim, does not necessarily satisfy that requirement." *University of Rochester v. G.D. Searle & Co.*, 358 F.3d 916 (Fed. Cir. 2004).

2. Invalidity of the Asserted Claims

The identified violations noted below both individually and collectively render the asserted claims invalid under each of the statutory requirements described above. Identifying certain claim language below does not imply that such language is entitled to any patentable weight when comparing the claim as a whole to the prior art.

The '507 Patent's asserted claims overreach by covering solutions and capabilities that the patent admits its disclosure does not describe or enable. For example, the asserted claims cover performing the claim's recited methods and functions on pure unaugmented video information, but the patent does not enable or demonstrate possession of such capabilities. In addition, the patent admits that its disclosed techniques cannot identify subject-matter "segment" breaks in pure video input; cannot effectively compare two such segments even if they were identified; cannot effectively compare a pure video segment to any other form of segment (e.g., audio or text); and cannot compare any video sequence (even if not a subject-matter segment) to a non-video segment. This renders the asserted claims invalid under all Sec. 112 requirements discussed above.

The '507 Patent discloses that the claimed system has a supposed ability to process a body of unstructured information by partitioning it into subject matter segments, and then comparing those segments to find related segments, and displaying related segments together, in "real-time." But the patent further discloses that the disclosed techniques could not achieve these results with pure video data, namely video data unaugmented by accompanying text, audio, or markers designating the breaks between different subject-matter segments of the video information (e.g., a raw, silent feed from a web cam). Further, applications purportedly incorporated by reference into the patent further disclose the inability of existing machine vision analysis technologies to partition video content by subject matter. This further renders the asserted claims invalid under all Sec. 112 requirements discussed above.

The patent discloses that "[a]n important aspect of the invention is the capability to determine relatedness of segments of information represented by different types of data." But nothing in the patent enables comparison of unaugmented video to other data forms that lack visual characteristics such as hue, chrominance, etc., such as pure audio. This further renders the asserted claims invalid under all Sec. 112 requirements discussed above.

Additionally, the asserted claims are invalid under all Sec. 112 requirements discussed above, particularly in some cases given the breadth that Interval apparently intends to assert for such claims:

- To the extent that the asserted claims are read to include techniques or instructions capable of acquiring a body of information having at least two adjoining segments that differ from each other in subject matter or theme but which have no augmentation explicitly identifying the breaks between those different segments, and capable of reliably identifying and displaying two different segments having related subject matters or themes without displaying an unrelated segment, and capable of doing so without structuring, partitioning, categorizing, or augmenting the body of information, this renders the asserted claims invalid under all requirements of Section 112 discussed above.
- To the extent that the claims are read as not requiring a step or function of "structuring" (as this term is used in the patent) the data representing the body of information, this further renders the asserted claims invalid under all requirements of Section 112 discussed above.
- To the extent that the claims are read as not requiring a step or function of "synchronizing" audio and video portions of the body of information, this further renders the asserted claims invalid under all requirements of Section 112 discussed above.
- To the extent that the claims are read as not requiring a step or function of obtaining "a textual representation of audiovisual data" representing the body of information, this further renders the asserted claims invalid under all requirements of Section 112 discussed above.

Individually and collectively, the above disconnects between the claims and the patent's disclosure render the asserted claims invalid under all Sec. 112 requirements described above. More generally, the patent's disclosure did not enable or show possession of the full scope of the asserted claims. For example, the claims are invalid because their full scope covers something the patent admits it could not achieve, as in *AK Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003).

The ’507 Patent disclosure taught away from storing acquired information remotely from the user’s display. For example, the patent disclosure taught that its control device, primary display device, system controller, and data storage device should be interconnected to a conventional computer bus, not requiring wire communication over network communication lines to communicate with each other. To the extent that the asserted claims are read to permit the acquisition, storage, or processing of a “body of information” remotely from its display (e.g., separated by the Internet or other computer network), this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

The ’507 Patent disclosed certain Internet information sites such as Clarinet, AOL, CompuServe or Prodigy. These services gathered information and categorized their information, such as news stories, into topics, such that these data items were provided to users associated with pre-established subject-matter relationships. But the patent teaches that such information sources were outside of the alleged invention. To the extent that the claims are read to cover gathering or creating data items and associating data items with existing information categories in order to associate plural data items with each other by associating them with the same subject matter or other category, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

Claims 20 and 63 (and their asserted dependent claims) do not associate or relate any of their “generating,” or “comparing,” steps or functions with any of the others (other than each concerning the same “body of information”). For example, these claim steps and functions do not refer to “the segment” referenced in some other step or function, but rather refer to “a” segment. This renders the asserted claims invalid under all Sec. 112 requirements discussed above.

The claim term “body of information” is indefinite. For example, the patent does not sufficiently explain criteria for distinguishing between a “body of information” versus “data representing a body of information,” or for distinguishing between one “body of information” and another “body of information,” or for distinguishing between a “body of information” and a portion of a “body of information,” or for distinguishing a “body of information” from

"information." Nor does the patent distinguish, sufficiently, between "body of information," "segment," "different segment," "portion or representation of a segment," and "data."

To the extent the term "body of information" is read to include information not represented by audiovisual data that can be used to generate an audiovisual display, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

The claim term "reviewing" "a body of information" is indefinite because, among other reasons, the '507 Patent does not disclose what it means to "review" a "body of information."

The claim term "segment" is indefinite. For example, to the extent that a "segment" is defined by its subject matter or theme, it is unclear what criteria are used to identify a sufficient change in subject matter or theme to constitute a segment break. As another example, the patent does not provide adequate criteria for distinguishing between a "segment" and a mere "portion" or "representation" of a segment, or between a "segment" and a "body of information."

To the extent that "segment" is read as including sequences that are not characterized by a common subject matter or theme, then this further distances the claims from the patent's disclosure, rendering the asserted claims invalid under all Sec. 112 requirements discussed above.

The body of claim 20 and the body of claim 63 each includes references to five "segments." To the extent these claims do not require any of the five to be the same as any of the others, this further renders the asserted claims invalid under all Sec. 112 requirements discussed above.

The claim term "a defined set of information in the body of information" is indefinite because, among other reasons, it is unclear what criteria are used to identify a "defined" set of information in the "body of information."

The claim term "acquiring data representing the body of information" is indefinite because, among other reasons, the patent does not adequately disclose criteria for determining whether or not certain data is or is not adequate to "represent" a "body of information."

To the extent that this claim language is read to include retrieving data already in the possession and control of the entity performing this step or function, or to include creating information, or to include passively receiving information sent by another specifically to the

recipient, this further renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the claim language "generating a display of a first segment of the body of information" is read to include generating a display of only a portion of a first segment, or a display of only data representing a first segment, or display of other information combined with a first segment, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

The claim term "comparing data representing a segment of the body of information to data representing a different segment of the body of information" is indefinite because, among other reasons, the patent does not adequately disclose criteria for determining whether or not certain data is or is not adequate to "represent" a "segment" of a "body of information."

To the extent that this comparing step and function includes comparing data respectively representing different "segments" of the "body of information," neither "segment" being a "segment" referenced in any other step or function of the claim, this further renders the asserted claims invalid under all Sec. 112 requirements discussed above.

The claim term "related" is indefinite because, among other reasons, the patent defines "related" as covering "the same or similar subject matter," but it fails to disclose adequate criteria for the measure or degree of similarity (or technique used to ascertain such measure or degree) required to characterize two different segments as related or not, or to distinguish between subject matters or themes that are similar and thus related versus subject matters or themes that are not similar and thus not related.

The claim term "predetermined criteria" is indefinite because, among other reasons, the patent provides insufficient disclosure of any example of such "predetermined criteria."

The claim phrase "to determine whether, according to one or more predetermined criteria, the compared segments are related" renders the asserted claims invalid under all Sec. 112 requirements discussed above to the extent that the asserted claims are not limited to the "predetermined criteria" described in the patent, if any, or to techniques described in the patent for making the recited determination.

To the extent that "generating a display of a portion of, or a representation of, a second segment of the body of information … [in response to the display of] a first segment to which the second segment is related" does not require that the second "segment" be the segment identified by any other step or function of the claim or by any technique described in the patent, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the phrase "is generated in response to the display" is read to cover a method or system that generates "a display of a portion of, or representation of, a second segment" based upon an action of a user, rather than "automatically" and in response to the display of a first segment, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

Further regarding claim 63 and its dependent asserted claims, the patent does not describe or enable even one computer readable medium encoded with the recited instructions, rendering the claim invalid under all Sec. 112 requirements described above. Further, the patent discloses no example of any encoded instructions for any of the functions recited in these claims. To the extent these claims' "instructions for . . ." elements are governed by Section 112, ¶ 6, they lack sufficient corresponding "structure" in the patent, further rendering these claims invalid for indefiniteness. Alternatively, even if not interpreted as Section 112, ¶ 6 limitations, these claims are indefinite because they do not recite a description of any algorithm or similar disclosure that is sufficient to distinguish the computer-readable media from the prior art or any other instructions that perform a similar function.

The claim phrase "instructions for generating a display of a portion of, or a representation of, a second segment of the body of information from data that is part of the stored data, wherein the display of the portion or representation of the second segment is generated in response to the display of a first segment to which the second segment is related" is indefinite because, among other reasons, it is indefinite as to whether the recited instructions must be responsible for carrying out the "wherein" restriction.

The claim term "substantially coextensive in time with the display of the related first segment" is indefinite because, among other reasons, the patent provides no adequate criteria for determining whether this claim language is met or not.

The claim term "a relevance feedback method" is indefinite and lacks adequate support in the patent. Essential matter cannot be incorporated by reference.

As to "the display of a first segment" recited in claims 34 and 77, to the extent that this "first segment" is not any of the "segments" referenced in the independent claim, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

The phrases "further comprises" and "further comprise" in claims 22-23 and 65-66 lack any antecedent basis and are therefore indefinite. The reference to "first segment" in "wherein the first and second segments" does not indicate which of the two "first segments" referenced in claim 20 or 63 it is referencing, rendering these claims indefinite.

Each reference to "further comprises" or "further comprise" in claims 24, 31, 67, and 74 lacks any antecedent basis and renders the claims indefinite. In addition, as noted, the patent disclosure taught away from using a computer network as recited in these claims.

To the extent that claims 27-28 and 70-71 are not limited to "predetermined criteria" described in the patent, if any, or to techniques described in the patent, if any, for making the recited determination, this further renders these asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent the "a first segment" in claims 34 and 77 is not the "at least some of the body of information," this renders this claim invalid under all Sec. 112 requirements described above.

The reference to "further comprising" in claims 37 and 80 lacks any antecedent basis and renders the claims indefinite.

Claim 39 and its asserted dependent claims are invalid for indefiniteness further because the following terms or phrases lack a definite scope:

- "body of information";
- "segment representing a defined set of information";

- "determining the degree of similarity between the subject matter content of the uncategorized segment and the subject matter content of each of the previously categorized segments"; and
- "identifying one or more of the previously categorized segments as relevant to the uncategorized segment based upon the determined degrees of similarity."

Claim 39 and its asserted dependent claims are invalid further because the following claim limitations lack written description:

- "determining the degree of similarity between the subject matter content of the uncategorized segment and the subject matter content of each of the previously categorized segments"; and
- "identifying one or more of the previously categorized segments as relevant to the uncategorized segment based upon the determined degrees of similarity."

To the extent that Interval alleges that "determining the degree of similarity between the subject matter content of the uncategorized segment and the subject matter content of each of the previously categorized segments" may be performed in a manner other than by "relevance feedback," claim 39 and its asserted dependent claims are not described or fully enabled because the patent specification provides no other discussion of how to determine a degree of similarity. To the extent that Interval alleges that this claim limitation may be performed by "relevance feedback," the claim is not enabled because the specification does not teach how "relevance feedback" would be applied to "determine[e] the degree of similarity between the subject matter content of the uncategorized segment and the subject matter content of each of the previously categorized segments."

Claim 39 and its asserted dependent claims are not enabled because the patent does not enable "any desired method," *see* 30:54-57, of "selecting one or more subject matter categories with which to identify the uncategorized segment based upon the subject matter categories used to identify the relevant previously categorized segments."

Claim 82 and its asserted dependent claims are invalid for the same reasons as claim 39.

Claims 43 and 86 are also invalid because "performing a relevance feedback method" is indefinite.

Claims 43 and 86 are also invalid because "performing a relevance feedback method" is not enabled because the patent specification does not teach how relevance feedback can be used to "determine the degree of similarity."

Claim 86 is invalid for lack of written description because the specification does not show possession of "wherein the uncategorized segment has been acquired from a first data source and the previously categorized segment or segments have been acquired from a second data source that is different than the first data source."

III. THE '682 PATENT

A. Anticipation

Pursuant to P.R. 121, Defendants identify the following prior art now known to Defendants to anticipate the asserted claims of the '682 Patent under at least 35 U.S.C. §§ 102(a), (b), (e), and/or (g), either expressly or inherently as understood by a person having ordinary skill in the art. In some instances, Defendants have treated certain prior art as anticipatory where certain elements are inherently present, and in particular where elements are inherent based on Plaintiff's apparent claim construction in its Infringement Contentions. Invalidity claim charts for these references with respect to the '682 Patent are attached to these Invalidity Contentions.

1. U.S. Patent No. 5,749,081 to Whiteis (filed April 6, 1995; issued May 5, 1998)
2. U.S. Patent No. 5,428,778 to Brookes (filed September 13, 1994; issued June 27, 1995)
3. U.S. Patent No. 5,724,567 to Rose et al. (filed April 25, 1994; issued March 3, 1998)
4. U.S. Patent No. 6,049,777 to Sheena et al. (filed March 14, 1997; issued April 11, 2000)
5. U.S. Patent No. 6,195,657 to Rucker et al. (filed September 25, 1997; issued February 27, 2001)

6. U.S. Patent No. 6,385,619 to Eichstaedt et al. (filed January 8, 1999; issued May 7, 2002)

7. U.S. Patent No. 7,082,407 to Bezos et al. (filed August 19, 1999[2]; issued July 25, 2006)

8. U.S. Patent No. 6,466,918 to Spiegel et al. (filed November 18, 1999; issued October 15, 2002)

9. "Siteseer: Personalized Navigation for the Web," published March 1997 in Communications of the ACM (Vol. 40, No. 3), authored by James Rucker and Marcos J. Polanco.

10. "Building Consumer Trust with Accurate Product Recommendations: A White Paper on LikeMinds WebSell 2.1," published 1997, authored by Dan R. Greening.

11. "Making Recommender Systems Work for Organizations," published April 1999 by "Proceedings of PAAM '99," authored by Nathalie Glance, Damian Arregui, and Manfred Dardenne.

12. Systems and methods invented, designed, developed and/or in public use or on sale related to grapeVINE, as exemplified by U.S. Patent No. 5,428,778 to Brookes and subject to further discovery. Based upon information currently available to Defendants, Defendants believe that such a system was designed and developed at least before December 31, 1996, and may have been in public use or on sale on or before December 31, 1996 by grapeVINE Technologies Ltd.

13. Systems and methods invented, designed, developed and/or in public use or on sale related to Firefly, as exemplified by U.S. Patent No. 5,749,081 to Whiteis and subject to further discovery. On information and belief, the Firefly system is further exemplified and embodied by U.S. Patent No. 6,049,777 to Sheena et al. Based upon information currently available to Defendants, Defendants believe that such a system was designed and developed at least before December 31, 1996, and may have been in public use or on sale on or before December 31, 1996 by Firefly Network, Inc.

[2] Bezos claims priority to an earlier-filed provisional application, U.S. Provisional Application No. 60/128,557, filed on April 9, 1999.

14. Systems and methods invented, designed, developed and/or in public use or on sale related to SiteSeer, as exemplified by "Siteseer: Personalized Navigation for the Web" and U.S. Patent No. 6,195,657 to Rucker et al., and subject to further discovery. Based upon information currently available to Defendants, Defendants believe that such a system was designed and developed at least before March 31, 1997, and may have been in public use or on sale on or before March 31, 1997 by Imana, Inc.

15. Systems and methods invented, designed, developed and/or in public use or on sale related to Knowledge Pump, as exemplified by "Making Recommender Systems Work for Organizations" and "Knowledge Pump: Community-centered Collaborative Filtering," and subject to further discovery. Based upon information currently available to Defendants, Defendants believe that such a system was designed and developed at least before October 2, 1997, and may have been in public use or on sale on or before October 2, 1997 by Xerox Corp.

16. Systems and methods invented, designed, developed and/or in public use or on sale related to LikeMinds Websell 2.1, as exemplified by "Building Consumer Trust with Accurate Product Recommendations: A White Paper on LikeMinds WebSell 2.1" and subject to further discovery. Based upon information currently available to Defendants, Defendants believe that such a system was designed and developed at least before December 31, 1997, and may have been in public use or on sale on or before December 31, 1997 by LikeMinds, Inc.

17. Office Depot's "Better Together" feature accused of infringement by Interval. On information and belief, the feature of showing "Better Together" items was first invented, designed, developed, and publicly implemented by Office Depot prior to 1996. Defendants are still investigating this prior art system. To the extent that Interval contends that Office Depot's "Better Together" feature infringes any claims, that allegation would simultaneously render such claims invalid.

B. Obviousness

Pursuant to P.R. 121, Defendants identify the following additional prior art references and systems now known to Defendants that either alone or in combination with other prior art (including any of the above-identified anticipatory prior art and the additional prior art disclosed

in this section) render the asserted claims of the ’682 Patent invalid as obvious under 35 U.S.C. § 103. Invalidity claim charts for these references with respect to the ’682 Patent are also attached to these Invalidity Contentions.

1. “Knowledge Pump: Community-centered Collaborative Filtering,” published October 27, 1997, authored by Natalie Glance, Damian Arregui, and Manfred Dardenne.
2. Microstrategy, Inc., “MicroStrategy Launches Strategy.com, the World's First Personal Intelligence Network,” press release dated June 28, 1999
3. U.S. Patent No. 7,181,417 to Langseth et al. (filed January 21, 2000, issued February 20, 2007
4. “webCobra: An Automated Collaborative Filtering Agent System for the World Wide Web,” published December 5, 1997, authored by Steve Nesbitt.
5. U.S. Patent No. 6,078,740 to DeTreville et al. (filed November 4, 1996; issued June 20, 2000)
6. Systems and methods invented, designed, developed and/or in public use or on sale related to MicroStrategy Broadcaster, as exemplified by U.S. Patent No. 7,181,417 to Langseth et al. and/or to “Strategy.com,” and subject to further discovery. Based upon information currently available to Defendants, Defendants believe that such a system was designed and developed at least before June 28, 1999, and may have been in public use or on sale on or before June 28, 1999 by Microstrategy, Inc.
7. U.S. Patent No. 6,807,558 to Hassett et al. (filed June 2, 1998; issued October 19, 2004)
8. U.S. Patent No. 7,209,942 to Hori et al, (filed December 23, 1999; issued April 24, 2007)

Each prior art reference and system (collectively for this subsection, “references”) disclosed in the preceding Anticipation section and in this Obviousness section, either alone or in

combination with other prior art, also renders the asserted claims of the ’682 Patent invalid as obvious.

In addition, each anticipatory prior art reference and/or each additional prior art reference may be combined with (1) information known to persons skilled in the art at the time of the alleged invention, (2) any of the anticipatory prior art references, and/or (3) any of the additional prior art references identified above in this section to render these claims invalid as obvious.

Because the ’682 Patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than what one would expect from such an arrangement, the combination is obvious. Further, in the prior art, there were well-recognized design needs and market pressures to alert users to items of current interest. Such design needs and market pressures provided ample reason to combine the prior art elements. *KSR*, 127 S. Ct. at 1742. Moreover, since there were a finite number of predictable solutions, a person of ordinary skill in the art had good reason to pursue the known options. *Id*. The’682 Patent merely uses those familiar elements for their primary or well-known purposes in a manner well within the ordinary level of skill in the art. Accordingly, common sense and knowledge of the prior art render the asserted claims of the ’682 Patent invalid under either § 102 and/or § 103.

Moreover, a person of ordinary skill would have been motivated to combine the above prior art based on the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. The identified prior art addresses the same or similar technical issues and suggests the same or similar solutions to those issues. To the extent that Plaintiff challenges a combination of prior art with respect to a particular element, Defendants reserve the right to supplement these contentions to further specify the motivation to combine the prior art. Defendants may rely on cited or uncited portions of the prior art, other documents, and expert testimony to establish that a person of ordinary skill in the art would have been motivated to modify or combine the prior art so as to render the claims invalid as obvious.

Defendants further identify combinations of prior art (including any of the above-identified anticipatory prior art and the additional prior art disclosed in this section) that render the asserted claims of the ’682 Patent invalid as obvious under 35 U.S.C. § 103. Below are

several examples of prior art combinations. These prior art combinations are not exhaustive; rather, they are illustrative examples of the prior art combinations disclosed generally above. These exemplary combinations are alternatives to Defendants' anticipation and single-reference obviousness contentions, and, thus, they should not be interpreted as indicating that any of the individual references included in the exemplary combinations are by themselves invalidating prior art under 35 U.S.C. §§ 102 and/or 103.

To the extent that Plaintiff contends that any of the above-identified prior art fails to disclose one or more limitations of the asserted claims of the '682 Patent, Defendants reserve the right to identify other prior art references that would render the claims obvious despite the allegedly missing limitation. Defendants reserve all rights to supplement or modify these Joint Invalidity Contentions and to rely on other references that prove invalidity of these claims in a manner consistent with the Federal Rules of Civil Procedure and the Rules of this Court.

1. U.S. Patent No. 5,749,081 to Whiteis in view of one or more of the following:
    - U.S. Patent No. 6,049,777 to Sheena et al.
    - U.S. Patent No. 6,195,657 to Rucker et al.
    - U.S. Patent No. 7,082,407 to Bezos et al.
    - U.S. Patent No. 7,181,417 to Langseth et al.
    - "MicroStrategy Launches Strategy.com, the World's First Personal Intelligence Network"
    - U.S. Patent No. 6,807,558 to Hassett et al.
    - U.S. Patent No. 7,209,942 to Hori et al,
2. U.S. Patent No. 5,428,778 to Brookes, in view of one or more of the following:
    - U.S. Patent No. 6,049,777 to Sheena et al.
    - U.S. Patent No. 5,724,567 to Rose et al.
    - U.S. Patent No. 7,181,417 to Langseth et al.
    - "MicroStrategy Launches Strategy.com, the World's First Personal Intelligence Network"
3. U.S. Patent No. 5,724,567 to Rose et al., in view of one or more of the following:

- U.S. Patent No. 6,049,777 to Sheena et al.
- U.S. Patent No. 6,195,657 to Rucker et al.
- U.S. Patent No. 7,181,417 to Langseth et al.
- "MicroStrategy Launches Strategy.com, the World's First Personal Intelligence Network"
- U.S. Patent No. 6,807,558 to Hassett et al.
- U.S. Patent No. 7,209,942 to Hori et al,

4. U.S. Patent No. 6,078,740 to DeTreville et al. in view of one or more of the following:
    - U.S. Patent No. 6,049,777 to Sheena et al.
    - U.S. Patent No. 7,082,407 to Bezos et al.
    - U.S. Patent No. 7,181,417 to Langseth et al.
    - "MicroStrategy Launches Strategy.com, the World's First Personal Intelligence Network"
5. U.S. Patent No. 6,049,777 to Sheena et al. in view of one or more of the following:
    - U.S. Patent No. 5,724,567 to Rose et al.
    - U.S. Patent No. 7,082,407 to Bezos et al.
    - U.S. Patent No. 7,181,417 to Langseth et al.
    - "MicroStrategy Launches Strategy.com, the World's First Personal Intelligence Network"
    - U.S. Patent No. 6,807,558 to Hassett et al.
    - U.S. Patent No. 7,209,942 to Hori et al,
6. U.S. Patent No. 6,195,657 to Rucker et al. in view of one or more of the following:
    - U.S. Patent No. 5,724,567 to Rose et al.
    - "Siteseer: Personalized Navigation for the Web"
    - U.S. Patent No. 7,181,417 to Langseth et al.
    - "MicroStrategy Launches Strategy.com, the World's First Personal

Intelligence Network”

7. U.S. Patent No. 6,385,619 to Eichstaedt et al. in view of one or more of the following:

- U.S. Patent No. 5,724,567 to Rose et al.
- U.S. Patent No. 6,049,777 to Sheena et al.
- U.S. Patent No. 7,082,407 to Bezos et al.
- U.S. Patent No. 6,466,918 to Spiegel et al.
- U.S. Patent No. 7,181,417 to Langseth et al.
- “MicroStrategy Launches Strategy.com, the World's First Personal Intelligence Network”
- U.S. Patent No. 6,807,558 to Hassett et al.
- U.S. Patent No. 7,209,942 to Hori et al,

8. U.S. Patent No. 7,082,407 to Bezos et al. in view of one or more of the following:

- U.S. Patent No. 5,724,567 to Rose et al.
- U.S. Patent No. 6,049,777 to Sheena et al.
- U.S. Patent No. 6,466,918 to Spiegel et al.
- U.S. Patent No. 7,181,417 to Langseth et al.
- “MicroStrategy Launches Strategy.com, the World's First Personal Intelligence Network”
- U.S. Patent No. 6,807,558 to Hassett et al.
- U.S. Patent No. 7,209,942 to Hori et al,

9. U.S. Patent No. 6,466,918 to Spiegel et al. in view of one or more of the following:

- U.S. Patent No. 5,724,567 to Rose et al.
- U.S. Patent No. 6,049,777 to Sheena et al.
- U.S. Patent No. 7,082,407 to Bezos et al.
- U.S. Patent No. 7,181,417 to Langseth et al.
- “MicroStrategy Launches Strategy.com, the World's First Personal

Intelligence Network"

- U.S. Patent No. 7,209,942 to Hori et al,
- U.S. Patent No. 6,807,558 to Hassett et al.

10. "webCobra: An Automated Collaborative Filtering Agent System for the World Wide Web" in view of one or more of the following:

- U.S. Patent No. 5,724,567 to Rose et al.
- U.S. Patent No. 6,049,777 to Sheena et al.
- U.S. Patent No. 7,082,407 to Bezos et al.
- U.S. Patent No. 7,181,417 to Langseth et al.
- "MicroStrategy Launches Strategy.com, the World's First Personal Intelligence Network"

11. "Building Consumer Trust with Accurate Product Recommendations: A White Paper on LikeMinds WebSell 2.1" in view of one or more of the following:

- U.S. Patent No. 5,724,567 to Rose et al.
- U.S. Patent No. 6,049,777 to Sheena et al.
- U.S. Patent No. 7,082,407 to Bezos et al.
- U.S. Patent No. 7,181,417 to Langseth et al.
- "MicroStrategy Launches Strategy.com, the World's First Personal Intelligence Network"

12. "Making Recommender Systems Work for Organizations" in view of "Knowledge Pump: Community-centered Collaborative Filtering"

C. Invalidity Under 35 U.S.C. § 112

The identified violations noted below both individually and collectively render the asserted claims invalid under each of the Section 112 requirements described above. Identifying certain claim language below does not imply that such language is entitled to any patentable weight when comparing the claim as a whole to the prior art.

All '682 Patent claims require determining an "intensity weight value." This three-word phrase appears nowhere else in the patent. Further, the claims require determining an "intensity

weight value," without saying a value of what, or specifying any use of the value. Nor is this phrase a term of art. This claim language renders the asserted claims invalid under each Section 112 requirement discussed above.

Claim 18 contradicts claim 3. Dependent claim 18 recites "***further comprising*** determining the weight to be given the indication," the bolded language indicating that claim 3 does not recite that determining step. But, in fact, claim 3 does recite that step: "determining an intensity value to be associated with the indication." These claims irreconcilably contradict each other, rendering the asserted claims invalid under all Sec. 112 requirements discussed above. Moreover, the patent does not describe or enable a process that performs this step of "determining an intensity value to be associated with the indication" more than once for a given indication, rendering claim 18 invalid under all Sec. 112 requirements discussed above.

Claim 4 contradicts claim 3. Dependent claim 4 recites "wherein processing the indication comprises determining the intensity value for the indication." But claim 3 already recites that same "determining" step separately from the processing step. Thus, claim 4 requires (and claim 3 encompasses) performing the same step twice — a step described in the patent as being performed only once, rendering the asserted claims invalid under all Sec. 112 requirements discussed above.

Each claim is internally inconsistent. Each independent claim (claims 1-3) inconsistently requires determining the intensity value "to be associated with the indication" but then contradicts that "to be associated" by reciting "adjusting the intensity value." If the value is adjusted, then the pre-adjusted value was not "to be associated" with the indication. This renders the asserted claims invalid under all Sec. 112 requirements discussed above.

Each claim recites "adjusting the intensity value" after determining it, irreconcilably contradicting the patent, which describes a single "determine alert intensity" step (*e.g.*, at Fig. 6, step 602) and never describes adjusting the value so determined. The patent describes a series of calculations to reach that determination of an alert's intensity value, but as shown in Fig. 6, it regards those calculations as constituting a single determining step, not a step of determining

followed by a step of adjusting, as erroneously claimed. This renders the asserted claims invalid under all Sec. 112 requirements discussed above.

The term "current interest" is not sufficiently defined in the patent, rendering the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that this claim term is read to cover indications that something as a whole is of interest, rather than a portion presently being viewed is of interest, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the claim term "item" or "item . . . of current interest" is read to include content that is not dynamically changing in "real-time," such as recorded content any portion of which can be accessed at any time, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the claim term "item" or "item . . . of current interest" is read to include something whose content and objective interest level is not dependent on the particular time it is viewed, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the claim term "item" or "item . . . of current interest" is read to cover a topic generally or groups of information rather than a specific and dynamically changing particular item, the asserted claims are not supported by an adequate written description.

These terms are not sufficiently defined in the patent, rendering the asserted claims invalid under all Sec. 112 requirements discussed above. For example, the patent does not sufficiently disclose or distinctly claim whether the "dynamic" content of an "item" needs to be unpredictable.

To the extent that the claims are read to include an "item" that a "participant" cannot view in "real time" over a network by accessing a web page or other on-line electronic resource**,** then this further distances the claims from the patent's disclosure, rendering the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the claim term "indication" is read to have two different meanings in the same claim, that renders the asserted claims indefinite in violation of Section 112, ¶ 2. To the extent that the claim term "indication" is read as having the same meaning throughout each claim,

this renders the claims invalid under Section 112, ¶ 1. For example, the patent does not describe or enable (following the disclosure's steps) receiving an "indication" from a "source" and disseminating that same "indication" to a "participant."

To the extent that the claim term "indication" is read to encompass messages not derived from the actions of a person while viewing the "item" in question, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the claims are read to not require affirmatively sending a "participant" an "indication" that an "item" is of "current interest," then this further distances the claims from the patent's disclosure, rendering the asserted claims invalid under all Sec. 112 requirements discussed above.

The term "receive/receiving in real-time" is not sufficiently defined in the patent, rendering the asserted claims invalid under all Sec. 112 requirements discussed above. The patent does not adequately distinguish between receiving an "indication" in "real-time" versus receiving an indication not in real-time.

To the extent that the claims are read to include a process that does not notify a "participant" of an "indication" of "current interest" until after the dynamic-content feature that provoked that indication has ended (e.g., the rhinos have left the watering hole), this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the phrase "a source other than the participant" is read to cover a "source" other than a person, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

The claim language "an indication that an item … is of current interest" renders the asserted claims invalid under all Sec. 112 requirements discussed above. To the extent that the claims are read to include indications of interest in an item as a whole, a topic generally, or as otherwise distinct from an indication of interest in a particular currently playing content feature (e.g., scene) of the item (e.g., rhinos appearing at the watering hole), this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the claims or this claim language are read to include a user indicating her rating or level of interest in something, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

In non-method claims 1 and 2, the significance of the claim term "current" is indefinite. For example, the supposed difference between a computer configured to receive (or instructions for receiving) an indication of "current interest" versus an indication not of current "interest" is not disclosed in the patent. The patent does not teach how a computer or computer instruction determines that a received indication of interest is or is not an indication of "current" interest.

To the extent that the term "process" or "processing" is read to include "processing" an indication in some manner other than performing each step identified in Fig. 6 of the patent, and only those steps, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the claims are read to cover determining an "intensity value" that applies only to one (or fewer than all) "participants," the claims lack full-scope written description and full-scope enablement support.

To the extent that the claims are read to cover determining "an intensity value" for an indication that does not apply throughout the rest of the method, or that is not calculated using only objective criteria (not any expression of weight suggested by the source of the alert), this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the claims are read to cover determining "an intensity value" for an indication that is calculated, at least in part, based on the extent to which the source of the indication is trusted, the claims further lack full-scope written description and enablement support. The patent discloses that an alert intensity may be based on a level of trust in the alerting user, but does not describe or enable a method for achieving that.

To the extent that the claims are read to cover changing the value calculated in the claim step "determine an intensity value to be associated with the indication," this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that this claim language in non-method claims 1 and 2 requires an action or step, it renders those claims indefinite hybrid claims.

To the extent that the claim phrase "based on a characteristic for the item provided by the source" is read to cover "characteristics" that are not a distinct trait of the item that the item possessed independent of any action by, or subjective opinion of, the source, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the language "item is of current interest" in the phrase "informing the participant that the item is of current interest" is read to have a different meaning than the same claim language has earlier in the claim, this renders the asserted claims in violation of Section 112, ¶ 2.

To the extent that the claim language "item is of current interest" is read as having the same meaning throughout each claim, this renders the claims invalid under Section 112, ¶ 1. For example, the patent does not describe or enable (following the disclosure's steps) receiving an indication of "current interest" from a source and disseminating that same indication to a participant, or informing a participant that an item is of "current interest" whenever receiving from a source an indication that the item is of "current interest."

Regarding the claim language, "database … configured to store data relating to the item/Storing data relating to the indication in a database," the patent does not provide full-scope written description or enablement support for storing in a database any and all information relating to an item, or to an indication.

To the extent that "intensity rank" is not limited to the exact data identified in the patent disclosure as an "intensity rank," then this further distances claims 5-6 from the patent's disclosure, rendering these asserted claims invalid under all Sec. 112 requirements discussed above.

There is no support in the patent for an "intensity rank indicating the level of current interest of the item relative to other items." For example, an "intensity rank" may be calculated even when there is only one item for which alerts have been received. The recited "intensity

rank" calculation does not concern more than one item. This renders claims 5 and 6 invalid under all Sec. 112 requirements discussed above.

The claim language "based at least in part on the intensity value of the indication" does not specify which of the two previously determined "indications" or "intensity" values it references, rendering claims 5-6 invalid under Section 112, ¶ 2.

To the extent that the claim language "identifying all items of current interest within the selected categories" requires or includes identifying all items of current interest to a user or participant accessible via any network, or all such items accessible via the World Wide Web, this renders claims 6 and 11-13 invalid under all Sec. 112 requirements discussed above. To the extent that the claim is read not to require or include this, then this claim language is indefinite.

To the extent that the claim language "associating the item with a category of interest to which the item relates" is read to include some technique other than accepting a category identified by a person who was the "source" of the "indication" of "current interest," this renders these asserted claims invalid under all Sec. 112 requirements discussed above.

The patent provides an inadequate disclosure of any software or technique for creating the "software objects" and arrays, including the alert software object, hot list software object, hot token object, etc., referenced in Fig. 1 and Fig. 12. The patent does not provide adequately disclosure of any software or technique for identifying an alerting user. This renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the claim language "disseminating to a participant an indication" is read to cover providing an "indication" to a participant about content available on a given website only after the user is already logged on to or browsing the website, this renders the asserted claims invalid under all Sec. 112 requirements discussed above.

To the extent that the term "participant" is construed to include persons who have not requested an indication that an item is of current interest, this renders the asserted claims invalid under the all Sec. 112 requirements discussed above.

Claims 1 and 2 are further indefinite for claiming functions without reciting structure in support of the claim-recited functions. To the extent that the claim language "a computer

configured to . . . inform the participant that the item is of current interest" in claim 1 and/or "computer instructions for . . . informing the participant that the item is of current interest" in claim 2 is read to be a means-plus-function element subject to Section 112, ¶ 6, this further renders these claims invalid for indefiniteness for failure of the patent specification to adequately disclose, and link to the claim-recited functions, specific corresponding algorithms or other "structure." Further, the body of claim 2 recites nothing other than this claim language "computer instructions for . . . informing the participant that the item is of current interest," and thus its indefiniteness cannot be remedied by resort to Section 112, ¶ 6.

IV. THE '652 PATENT

Defendants AOL, Apple, Google, and Yahoo! will separately serve invalidity contentions regarding the '652 Patent.

V. THE '314 PATENT

Defendants AOL, Apple, Google, and Yahoo! will separately serve invalidity contentions regarding the '314 Patent.

VI. ACCOMPANYING DOCUMENT PRODUCTION

Pursuant to P.R. 122, and based on their investigation to date, Defendants are producing and/or will make available for inspection documents currently in their possession, custody, or control required to accompany these Invalidity Contentions. Defendants will also make available for inspection certain prior art systems upon request.

Defendants' search for prior art references, additional documentation, and/or corroborating evidence concerning prior art systems is ongoing. Accordingly, Defendants reserve the right to continue to supplement their production as Defendants obtain additional prior art references, documentation, and/or corroborating evidence concerning invalidity during the course of discovery.

DATED this 28th day of February 2011.

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CERTIFICATE OF SERVICE

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