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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’ Invalidation Contentions with
Respect to U.S. Patents Nos. 6,034,652
and 6,788,314**

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 AOL, Inc., Apple Inc, Google Inc., and Yahoo! Inc. (collectively, “Defendants”) hereby serve these Invalidation Contentions (“Invalidation Contentions”) regarding U.S. Patent Nos. 6,034,652 (the “652 Patent”) and 6,788,314 (the “314 Patent”) (collectively, “Asserted Patents”). This document provides Part IV and Part V of the February 28, 2011 Invalidation Contentions served by all above-named defendants.

**Defendants Invalidation Contentions with
Respect to U.S. Patents Nos. 6,034,652 and
6,788,314 (10-cv-01385-MJP)**

EXHIBIT B

1 **IV. THE '652 PATENT**

2 **A. Anticipation**

3 Pursuant to P.R. 121, Defendants identify the following prior art now known to
4 Defendants to anticipate at least one of the asserted claims of the '652 Patent under at least 35
5 U.S.C. §§ 102(a), (b), (e), and/or (g), either expressly or inherently as understood by a person
6 having ordinary skill in the art. In some instances, Defendants have treated certain prior art as
7 anticipatory where certain elements are inherently present, and in particular where elements are
8 inherently present based on Plaintiff's apparent claim construction in its Infringement
9 Contentions. Invalidity claim charts for these references with respect to the '652 Patent are
10 attached to these Invalidity Contentions.

- 11 1. U.S. Patent No. 5,748,190 to Kjorsvik (issued May 5, 1998)
- 12 2. U.S. Patent No. 5,913,040 to Rakavy et al. (issued June 15, 1999)
- 13 3. U.S. Patent No. 5,796,945 to Tarabella (issued August 18, 1998)
- 14 4. U.S. Patent No. 5,959,623 to Van Hoff et al. (issued September 28, 1999)
- 15 5. U.S. Patent No. 5,740,549 to Reilly et al., (issued April 14, 1998)
- 16 6. PCT Publication No. WO 94/30000 to Beaumont et al. (published December 22,
17 1994)
- 18 7. The Official America Online for Windows Tour Guide (2d ed. 1994)
- 19 8. Novell GroupWise Version 4.1 Reference for Macintosh (1994)
- 20 9. Systems and methods invented, designed, developed and/or in public use or on
21 sale related to BackWeb, as exemplified by the Rakavy '040 patent and subject to further
22 discovery. Based upon information currently available to Defendants, Defendants believe that
23 such a system was designed and developed by BackWeb before August 22, 1995, and may have
24 been in public use or on sale by BackWeb before March 22, 1995.
- 25 10. Systems and methods invented, designed, developed and/or in public use or on
26 sale by AT&T Corp., as exemplified by the U.S. Patent No. U.S. Patent No. 5,819,284 and
27 subject to further discovery. Based upon information currently available to Defendants,
28 Defendants believe that such a system was designed and developed by AT&T Corp. before March

1 24, 1995, and may have been in public use or on sale by AT&T Corp. before March 22, 1995.

2 11. Systems and methods invented, designed, developed and/or in public use or on
3 sale related to PointCast, as exemplified by the Reilly '549 patent and subject to further
4 discovery. Based upon information currently available to Defendants, Defendants believe that
5 such a system was designed, and developed by PointCast, Inc., before June 12, 1995, and may
6 have been in public use or on sale by PointCast, Inc., before March 22, 1995.

7 12. Systems and methods invented, designed, developed and/or in public use or on
8 sale related to AOL's email or instant messaging systems, as exemplified by "The Official
9 America Online for Windows Tour Guide" (2d ed. 1994) and subject to further discovery. Based
10 upon information currently available to Defendants, Defendants believe that such a system was
11 designed and developed by AOL during or prior to 1994, and may have been in public use or on
12 sale by AOL during or prior to 1994.

13 13. Systems and methods invented, designed, developed and/or in public use or on
14 sale related to the Zephyr Notification Service, as exemplified by "The Zephyr Notification
15 Service," C. Anthony DellaFera, MIT 1988, and subject to further discovery. Based upon
16 information currently available to Defendants, Defendants believe that such a system was
17 designed and developed by Ciarán Anthony DellaFera, Michael R. Gretzinger, Mark W. Eichin,
18 Robert S. French, David C. Jedlinsky, John T. Kohl, and/or William E. Sommerfeld during or
19 prior to 1986, and may have been in public use or on sale by Ciarán Anthony DellaFera, Michael
20 R. Gretzinger, Mark W. Eichin, Robert S. French, David C. Jedlinsky, John T. Kohl, and/or
21 William E. Sommerfeld before March 22, 1995.

22 **B. Obviousness**

23 Pursuant to P.R. 121, Defendants identify the following additional prior art references and
24 systems now known to Defendants that either alone or in combination with other prior art
25 (including any of the above-identified anticipatory prior art and the additional prior art disclosed
26 in this section) render one or more of the asserted claims of the '652 Patent invalid as obvious
27 under 35 U.S.C. § 103. Invalidity claim charts for these references with respect to the '652 Patent
28 are also attached to these Invalidity Contentions. Defendants further identify combinations of

1 prior art (including any of the above-identified anticipatory prior art and the additional prior art
2 disclosed in this section) that render one or more of the asserted claims of the '652 Patent invalid
3 as obvious under 35 U.S.C. § 103. In certain instances, the suggested obviousness combinations
4 are provided in the alternative to Defendants' anticipation contentions and are not to be construed
5 to suggest that any reference included in the combinations is not by itself anticipatory.

- 6 1. U.S. Patent No. 5,572,643 to Judson (issued November 5, 1996)
- 7 2. U.S. Patent No. 5,819,284 to Farber et al. (issued October 6, 1998)
- 8 3. U.S. Patent No. 5,796,967 to Filepp et al. (issued August 18, 1998)
- 9 4. U.S. Patent No. 5,436,637 to Gayraud et al. (issued July 25, 1995)
- 10 5. U.S. Patent No. 5,309,234 to Kranawetter et al. (issued May 3, 1994)
- 11 6. U.S. Patent No. 5,781,894 to Petrecca et al. (issued July 14, 1998)
- 12 7. U.S. Patent No. 5,617,526 to Oran et al. (issued April 1, 1997)
- 13 8. The Zephyr Notification Service, C. Anthony DellaFera, (MIT 1988)
- 14 9. Systems and methods invented, designed, developed and/or in public use or on

15 sale related to DeskPicture by Peirce Software and subject to further discovery. Based upon
16 information currently available to Defendants, Defendants believe that such a system was
17 designed and developed by Peirce Software during or prior to 1993, and may have been in public
18 use or on sale by Peirce Software during or prior to 1993.

19 Each prior art reference and systems (collectively for this subsection, "references")
20 disclosed in the preceding Anticipation section and in this Obviousness section, either alone or in
21 combination with other prior art, also renders the asserted claims of the '652 Patent invalid as
22 obvious.

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

27 Defendants hereby incorporate the description in the February 28, 2011 Invalidity
28 Contentions served by all above-named defendants summarizing the law regarding obviousness.

1 Because the '652 Patent simply arranges old elements with each performing the same
2 function it had been known to perform and yields no more than what one would expect from such
3 an arrangement, the combination is obvious. Further, in the prior art, there were well-recognized
4 design needs and market pressures to present information to a user in the vicinity of a display
5 device. Such design needs and market pressures provided ample reason to combine the prior art
6 elements. *KSR*, 127 S. Ct. at 1742. Moreover, since there were a finite number of predictable
7 solutions, a person of ordinary skill in the art had good reason to pursue the known options. *Id.*
8 The above identified prior art references use those familiar elements for their primary or well-
9 known purposes in a manner well within the ordinary level of skill in the art. Accordingly,
10 common sense and knowledge of the prior art render the claims invalid under either § 102 or
11 § 103.

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

21 Below are several examples of prior art combinations with respect to particular
22 limitations. These prior art combinations are not exhaustive; rather, they are illustrative examples
23 of the prior art combinations disclosed generally above. These exemplary combinations are
24 alternatives to Defendants' anticipation and single reference obviousness contentions, and, thus,
25 they should not be interpreted as indicating that any of the individual references included in the
26 exemplary combinations are not alone in invalidating prior art under 35 U.S.C. §§ 102 and/or
27 103.

28 To the extent that Plaintiff contends that any of the above-identified prior art fails to

1 disclose one or more limitations of the asserted claims of the '652 Patent, Defendants reserve the
2 right to identify other prior art references that would render the claims obvious despite the
3 allegedly missing limitation. Defendants reserve all rights to supplement or modify these Joint
4 Invalidation Contentions and to rely on other references that prove invalidity of these claims in a
5 manner consistent with the Federal Rules of Civil Procedure and the Rules of this Court.

6 1. U.S. Patent No. 5,748,190 to Kjorsvik, in view of one or more of the following:

- 7 o U.S. Patent No. 5,913,040 to Rakavy et al.
- 8 o U.S. Patent No. 5,796,945 to Tarabella
- 9 o U.S. Patent No. 5,959,623 to Van Hoff et al.
- 10 o U.S Patent No. 5,740,549 to Reilly et al.
- 11 o PCT Publication No. WO 94/30000 to Beaumont et al.
- 12 o The Official America Online for Windows Tour Guide
- 13 o Novell GroupWise Version 4.1 Reference for Macintosh
- 14 o U.S. Patent No. 5,572,643 to Judson
- 15 o U.S. Patent No. 5,819,284 to Farber et al.
- 16 o U.S. Patent No. 5,796,967 to Filepp et al.
- 17 o U.S. Patent No. 5,436,637 to Gayraud et al.
- 18 o U.S. Patent No. 5,309,234 to Kranawetter et al.
- 19 o U.S. Patent No. 5,781,894 to Petrecca et al.
- 20 o U.S. Patent No. 5,617,526 to Oran et al.
- 21 o The Zephyr Notification Service, C. Anthony DellaFera

22 2. U.S. Patent No. 5,913,040 to Rakavy et al., in view of one or more of the
23 following:

- 24 o U.S. Patent No. 5,748,190 to Kjorsvik
- 25 o U.S. Patent No. 5,796,945 to Tarabella
- 26 o U.S. Patent No. 5,959,623 to Van Hoff et al.
- 27 o U.S Patent No. 5,740,549 to Reilly et al.
- 28 o PCT Publication No. WO 94/30000 to Beaumont et al.

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- 2 o Novell GroupWise Version 4.1 Reference for Macintosh
- 3 o U.S. Patent No. 5,572,643 to Judson
- 4 o U.S. Patent No. 5,819,284 to Farber et al.
- 5 o U.S. Patent No. 5,796,967 to Filepp et al.
- 6 o U.S. Patent No. 5,436,637 to Gayraud et al.
- 7 o U.S. Patent No. 5,309,234 to Kranawetter et al.
- 8 o U.S. Patent No. 5,781,894 to Petrecca et al.
- 9 o U.S. Patent No. 5,617,526 to Oran et al.
- 10 o The Zephyr Notification Service, C. Anthony DellaFera
- 11 3. U.S. Patent No. 5,796,945 to Tarabella, in view of one or more of the following:
- 12 o U.S. Patent No. 5,748,190 to Kjorsvik
- 13 o U.S. Patent No. 5,913,040 to Rakavy et al.
- 14 o U.S. Patent No. 5,959,623 to Van Hoff et al.
- 15 o U.S. Patent No. 5,740,549 to Reilly et al.
- 16 o PCT Publication No. WO 94/30000 to Beaumont et al.
- 17 o The Official America Online for Windows Tour Guide
- 18 o Novell GroupWise Version 4.1 Reference for Macintosh
- 19 o U.S. Patent No. 5,572,643 to Judson
- 20 o U.S. Patent No. 5,819,284 to Farber et al.
- 21 o U.S. Patent No. 5,796,967 to Filepp et al.
- 22 o U.S. Patent No. 5,436,637 to Gayraud et al.
- 23 o U.S. Patent No. 5,309,234 to Kranawetter et al.
- 24 o U.S. Patent No. 5,781,894 to Petrecca et al.
- 25 o U.S. Patent No. 5,617,526 to Oran et al.
- 26 o The Zephyr Notification Service, C. Anthony DellaFera
- 27 4. U.S. Patent No. 5,959,623 to Van Hoff et al., in view of one or more of the
- 28 following:

- 1 ○ U.S. Patent No. 5,748,190 to Kjorsvik
- 2 ○ U.S. Patent No. 5,913,040 to Rakavy et al.
- 3 ○ U.S. Patent No. 5,796,945 to Tarabella
- 4 ○ U.S. Patent No. 5,740,549 to Reilly et al.
- 5 ○ PCT Publication No. WO 94/30000 to Beaumont et al.
- 6 ○ The Official America Online for Windows Tour Guide
- 7 ○ Novell GroupWise Version 4.1 Reference for Macintosh
- 8 ○ U.S. Patent No. 5,572,643 to Judson
- 9 ○ U.S. Patent No. 5,819,284 to Farber et al.
- 10 ○ U.S. Patent No. 5,796,967 to Filepp et al.
- 11 ○ U.S. Patent No. 5,436,637 to Gayraud et al.
- 12 ○ U.S. Patent No. 5,309,234 to Kranawetter et al.
- 13 ○ U.S. Patent No. 5,781,894 to Petrecca et al.
- 14 ○ U.S. Patent No. 5,617,526 to Oran et al.
- 15 ○ The Zephyr Notification Service, C. Anthony DellaFera
- 16 5. U.S. Patent No. 5,572,643 to Judson, in view of one or more of the following:
- 17 ○ U.S. Patent No. 5,748,190 to Kjorsvik
- 18 ○ U.S. Patent No. 5,913,040 to Rakavy et al.
- 19 ○ U.S. Patent No. 5,796,945 to Tarabella
- 20 ○ U.S. Patent No. 5,959,623 to Van Hoff et al.
- 21 ○ U.S. Patent No. 5,740,549 to Reilly et al.
- 22 ○ PCT Publication No. WO 94/30000 to Beaumont et al.
- 23 ○ The Official America Online for Windows Tour Guide
- 24 ○ Novell GroupWise Version 4.1 Reference for Macintosh
- 25 ○ U.S. Patent No. 5,819,284 to Farber et al.
- 26 ○ U.S. Patent No. 5,796,967 to Filepp et al.
- 27 ○ U.S. Patent No. 5,436,637 to Gayraud et al.
- 28 ○ U.S. Patent No. 5,309,234 to Kranawetter et al.

- 1 o U.S. Patent No. 5,781,894 to Petrecca et al.
- 2 o U.S. Patent No. 5,617,526 to Oran et al.
- 3 o The Zephyr Notification Service, C. Anthony DellaFera
- 4 6. U.S Patent No. 5,740,549 to Reilly et al., in view of one or more of the following:
- 5 o U.S. Patent No. 5,748,190 to Kjorsvik
- 6 o U.S. Patent No. 5,913,040 to Rakavy et al.
- 7 o U.S. Patent No. 5,796,945 to Tarabella
- 8 o U.S. Patent No. 5,959,623 to Van Hoff et al.
- 9 o PCT Publication No. WO 94/30000 to Beaumont et al.
- 10 o The Official America Online for Windows Tour Guide
- 11 o Novell GroupWise Version 4.1 Reference for Macintosh
- 12 o U.S. Patent No. 5,572,643 to Judson
- 13 o U.S. Patent No. 5,819,284 to Farber et al.
- 14 o U.S. Patent No. 5,796,967 to Filepp et al.
- 15 o U.S. Patent No. 5,436,637 to Gayraud et al.
- 16 o U.S. Patent No. 5,309,234 to Kranawetter et al.
- 17 o U.S. Patent No. 5,781,894 to Petrecca et al.
- 18 o U.S. Patent No. 5,617,526 to Oran et al.
- 19 o The Zephyr Notification Service, C. Anthony DellaFera
- 20 7. PCT Publication No. WO 94/30000 to Beaumont et al., in view of one or more of
- 21 the following:
- 22 o U.S. Patent No. 5,748,190 to Kjorsvik
- 23 o U.S. Patent No. 5,913,040 to Rakavy et al.
- 24 o U.S. Patent No. 5,796,945 to Tarabella
- 25 o U.S. Patent No. 5,959,623 to Van Hoff et al.
- 26 o U.S Patent No. 5,740,549 to Reilly et al.
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- 1 ○ U.S. Patent No. 5,572,643 to Judson
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- 3 ○ U.S. Patent No. 5,796,967 to Filepp et al.
- 4 ○ U.S. Patent No. 5,436,637 to Gayraud et al.
- 5 ○ U.S. Patent No. 5,309,234 to Kranawetter et al.
- 6 ○ U.S. Patent No. 5,781,894 to Petrecca et al.
- 7 ○ U.S. Patent No. 5,617,526 to Oran et al.
- 8 ○ The Zephyr Notification Service, C. Anthony DellaFera
- 9 8. The Official America Online for Windows Tour Guide, in view of one or more of
- 10 the following:
- 11 ○ U.S. Patent No. 5,748,190 to Kjorsvik
- 12 ○ U.S. Patent No. 5,913,040 to Rakavy et al.
- 13 ○ U.S. Patent No. 5,796,945 to Tarabella
- 14 ○ U.S. Patent No. 5,959,623 to Van Hoff et al.
- 15 ○ U.S. Patent No. 5,740,549 to Reilly et al.
- 16 ○ PCT Publication No. WO 94/30000 to Beaumont et al.
- 17 ○ Novell GroupWise Version 4.1 Reference for Macintosh
- 18 ○ U.S. Patent No. 5,572,643 to Judson
- 19 ○ U.S. Patent No. 5,819,284 to Farber et al.
- 20 ○ U.S. Patent No. 5,796,967 to Filepp et al.
- 21 ○ U.S. Patent No. 5,436,637 to Gayraud et al.
- 22 ○ U.S. Patent No. 5,309,234 to Kranawetter et al.
- 23 ○ U.S. Patent No. 5,781,894 to Petrecca et al.
- 24 ○ U.S. Patent No. 5,617,526 to Oran et al.
- 25 ○ The Zephyr Notification Service, C. Anthony DellaFera
- 26 9. Novell GroupWise Version 4.1 Reference for Macintosh, in view of one or more
- 27 of the following:
- 28 ○ U.S. Patent No. 5,748,190 to Kjorsvik

- 1 o U.S. Patent No. 5,913,040 to Rakavy et al.
- 2 o U.S. Patent No. 5,796,945 to Tarabella
- 3 o U.S. Patent No. 5,959,623 to Van Hoff et al.
- 4 o U.S Patent No. 5,740,549 to Reilly et al.
- 5 o PCT Publication No. WO 94/30000 to Beaumont et al.
- 6 o The Official America Online for Windows Tour Guide
- 7 o U.S. Patent No. 5,572,643 to Judson
- 8 o U.S. Patent No. 5,819,284 to Farber et al.
- 9 o U.S. Patent No. 5,796,967 to Filepp et al.
- 10 o U.S. Patent No. 5,436,637 to Gayraud et al.
- 11 o U.S. Patent No. 5,309,234 to Kranawetter et al.
- 12 o U.S. Patent No. 5,781,894 to Petrecca et al.
- 13 o U.S. Patent No. 5,617,526 to Oran et al.
- 14 o The Zephyr Notification Service, C. Anthony DellaFera

15 **C. Enablement, Written Description,**
16 **Indefiniteness Invalidity Under 35 U.S.C. § 112**

17 The Court’s Standing Order for Patent Cases requires, for each asserted claim, the
18 identification of “any grounds for invalidity based on indefiniteness, enablement, or written
19 description under 35 U.S.C. § 112.” Defendants provide below their preliminary invalidity
20 contentions on those three issues, for the asserted claims, preserving all other invalidity
21 contentions under other provisions of Section 112 (or any other Sections, such as Section 101),
22 and preserving all invalidity contentions for the non-asserted claims.

23 Defendants hereby incorporate the description in the February 28, 2011 Invalidity
24 Contentions served by all above-named defendants summarizing the law regarding § 112.

25 As Defendants best understand Plaintiff’s Infringement Contentions at this time, certain
26 asserted claims of the ’652 Patent fail to meet the requirements of 35 U.S.C. § 112(2) and/or 35
27 U.S.C. § 112(1) for at least the following reasons.

1 **1. Indefiniteness Under 35 U.S.C. § 112(2)**

2 a. **Additional Legal Principles**

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

14 While a patent claim that does not include the term “means” is not presumptively subject
15 to § 112(6) and the algorithm disclosure requirements for computer-enabled functions, such a
16 limitation will still be subject to 112(6) if “the claim term fails to recite sufficiently definite
17 structure or else recites function without reciting sufficient structure for performing that
18 function.” *Massachusetts Inst. of Tech. and Elecs. for Imaging, Inc. v. Abacus Software*, 462 F.3d
19 1344, 1353 (Fed. Cir. 2006) (internal quotations and citations omitted); *see also, e.g., Welker*
20 *Bearing Co. v. PHD, Inc.*, 550 F.3d 1090, 1096 (Fed. Cir. 2008) (ruling claim limitation reciting
21 “a mechanism for moving ...” was a means-plus-function limitation despite not including the
22 word “means” because “no adjective endows the claimed ‘mechanism’ with a physical or
23 structural component”); *Inventio AG v. ThyssenKrupp Elevator Americas Corp.*, 718 F. Supp. 2d
24 529, 558-59 (D. Del. 2010) (holding claim term “computing unit” was a means-plus-function
25 limitation because nothing in the claim language provided sufficient structure for any of the
26 functions performed by the “computing unit”).

27 b. **Indefinite Claims**

28 ***Independent Claim 4***

1 Claim 4 and all claims dependent thereon fail to satisfy the requirements of § 112(2)
2 because each of the claim terms or phrases quoted below does not have a meaning that can be
3 clearly and definitely determined, and thus fails to put the public on notice of what is and is not
4 covered by the claims.

- 5 • “peripheral attention”
- 6 • “set of content data”
- 7 • “selectively displaying”
- 8 • “in an unobtrusive manner that does not distract a user of the apparatus from a
9 primary interaction with the apparatus”
- 10 • “control option(s)”

11 Claim 4 and all claims dependent thereon also fail to satisfy the requirements of § 112(2)
12 because the specification lacks a supporting disclosure of appropriate structure for performing the
13 claimed functions recited in the following means-plus-function limitations:

- 14 • “means for acquiring a set of content data from a content providing system”
- 15 • “means for selectively displaying on the display device, in an unobtrusive manner
16 that does not distract a user of the apparatus from a primary interaction with the
17 apparatus, an image or images generated from the set of content data”
- 18 • “means for displaying one or more control options with the display device while
19 the means for selectively displaying is operating”
- 20 • “means for controlling aspects of the operation of the system in accordance with a
21 selected control option”

22 Interval’s own contentions confirm these are not supported by an appropriate disclosure
23 because Interval has asserted that the limitations cover processors “configured to execute
24 instructions” that perform the recited function.

25 ***Dependent Claims 5, 6, 7, 8, and 11***

26 Claim 5 fails to satisfy the requirements of § 112(2) because each of the claim terms or
27 phrases quoted below does not have a meaning that can be clearly and definitely determined, and
28 thus fails to put the public on notice of what is and is not covered by the claims.

- “scheduling the display”

Claim 11 fails to satisfy the requirements of § 112(2) because each of the claim terms or phrases quoted below does not have a meaning that can be clearly and definitely determined, and thus fails to put the public on notice of what is and is not covered by the claims.

- “establish(es) a link”

Claims 6, 7, and 8 fail to satisfy the requirements of § 112(2) because they include unsupported means-plus-function limitations:

- “means for scheduling the display of an image or images generated from a set of content data”

Independent Claim 15

Claim 15 and all claims dependent thereon fail to satisfy the requirements of § 112(2) because each of the claim terms or phrases quoted below does not have a meaning that can be clearly and definitely determined, and thus fails to put the public on notice of what is and is not covered by the claims.

- “set of content data”
- “attention manager”
- “user interface installation instructions”
- “content data scheduling instructions for providing temporal constraints”
- “sequencing instructions”
- “display instructions”
- “temporal constraints on the display”
- “during operation of an attention manager”

Claim 15 and all claims dependent thereon also fail to satisfy the requirements of § 112(2) because they include indefinite means-plus-function limitations, or whether interpreted as means-plus-function claims or not, they do not have a supporting disclosure of how the functions of the claimed instructions are implemented. Although the term “means” is not present in the claim, the claim limitations with the “instructions for/that” language fail to recite sufficient structure for performing the functions as demonstrated below.

- 1 • “acquisition instructions for enabling acquisition of a set of content data from a
- 2 specified information source”
- 3 • “user interface installation instructions for enabling provision of a user interface
- 4 that allows a person to request the set of content data from the specified
- 5 information source”
- 6 • “content data scheduling instructions for providing temporal constraints on the
- 7 display of the image or images generated from the set of content data”
- 8 • “sequencing instructions that specify an order in which the images generated from
- 9 a set of content data are displayed”
- 10 • “display instructions for enabling display of the image or images generated from
- 11 the set of content data”

12 Interval’s own infringement contentions demonstrate that it intends to assert that these
13 limitations cover any instructions that perform the recited function.

14 ***Independent Claim 17***

15 To the extent claim 17 contains the same or similar limitations as identified above for
16 claim 15, claim 17 likewise fails to satisfy the requirements of § 112(2).

17 Claim 17 also fails to satisfy the requirements of § 112(2) because each of the claim
18 terms or phrases quoted below does not have a meaning that can be clearly and definitely
19 determined, and thus fails to put the public on notice of what is and is not covered by the claims.

- 20 • “saturation instructions that constrain the number of times that the image or
- 21 images generated from a set of content data can be displayed”

22 Claim 17 also fails to satisfy the requirements of § 112(2) because it includes the
23 additional indefinite means-plus-function limitations, or whether interpreted as means-plus-
24 function claims or not, they do not have a supporting disclosure of how the functions of the
25 claimed instructions are implemented.

- 26 • “saturation instructions that constrain the number of times that the image or
- 27 images generated from a set of content data can be displayed”

28 ***Independent Claim 18***

1 To the extent claim 18 contains the same or similar limitations as identified above for
2 claim 15, claim 18 likewise fails to satisfy the requirements of § 112(2).

3 Claim 18 also fails to satisfy the requirements of § 112(2) because each of the claim terms
4 or phrases quoted below does not have a meaning that can be clearly and definitely determined,
5 and thus fails to put the public on notice of what is and is not covered by the claims.

- 6 • “content data update instructions”
- 7 • “corresponds to a previously acquired set of content data”
- 8 • “audit instructions for monitoring usage of the content display system to
9 selectively display an image or images generated from a set of content data”

10 Claim 18 also fails to satisfy the requirements of § 112(2) because it includes the
11 additional indefinite means-plus-function limitations, or whether interpreted as means-plus-
12 function claims or not, they do not have a supporting disclosure of how the functions of the
13 claimed instructions are implemented.

- 14 • “content data update instructions for enabling acquisition of an updated set of
15 content data from an information source that corresponds to a previously acquired
16 set of content data”
- 17 • “operating instructions for beginning, managing and terminating the display on the
18 display device of an image generated from a set of content data”
- 19 • “content display system scheduling instructions for scheduling the display of the
20 image or images on the display device”
- 21 • “installation instructions for installing the operating instructions and content
22 display system scheduling instructions on the content display system”
- 23 • “audit instructions for monitoring usage of the content display system to
24 selectively display an image or images generated from a set of content data”

25 Interval’s own infringement contentions demonstrate that it intends to assert that these
26 limitations cover any instructions that perform the recited function.

27 **2. Lack of Written Description Under 35 U.S.C. § 112(1)**

28 Even if the terms identified in the preceding section are not determined to be means-plus-

1 function limitations, such terms are lacking a supporting disclosure of an algorithm to perform the
2 recited function and are thus invalid as lacking a written description.

3 ***Dependent Claim 11***

4 Claim 11 is invalid as lacking a supporting written description if interpreted as broadly as
5 Interval's contentions because the limitation "establish a link with an information location" is not
6 supported in the disclosure. To the extent Interval is asserting that this claim covers a link to an
7 information location that it asserts is a source or otherwise provides the alleged notices or images,
8 rather than another or additional location, this claim limitation is unsupported because the
9 specification describes at most a link to an additional information source, not the source for the
10 original content data.

11 ***Claims 15-18***

12 To the extent Interval asserts these claims cover systems, methods or media that do not
13 require the operation of some means to detect an idle period or other period of inactivity by the
14 user, they are not supported by a written description, at least because the terms "temporal
15 constraints on the display" and "during operation of an attention manager" require the same.

16 **3. Lack of Enablement Under 35 U.S.C. § 112(1)**

17 The terms identified above as lacking a supporting disclosure of an algorithm to perform
18 the recited function are invalid as not enabled given their indeterminate scope.

19 ***Independent Claims 15, 17, and 18***

20 In the alternative, the "instructions for [that]" limitations described above in section
21 IV(C)(1)(b) for claims 15, 17, and 18 as invalid means-plus-function limitations are also invalid
22 for lack of enablement under § 112(1). The functions the "instructions" must perform are not
23 adequately disclosed such that a programmer of ordinary skill in the art could create the necessary
24 "instructions" or software code without undue experimentation.

25 ***Dependent Claim 16***

26 Claim 16 is invalid for lack of enablement under § 112(1) because it depends upon invalid
27 claim 15.

1 **V. THE '314 PATENT**

2 **A. Anticipation**

3 Pursuant to P.R. 121, Defendants identify the following prior art now known to
4 Defendants to anticipate one or more of the asserted claims of the '314 Patent under at least 35
5 U.S.C. §§ 102(a), (b), (e), and/or (g), either expressly or inherently as understood by a person
6 having ordinary skill in the art. In some instances, Defendants have treated certain prior art as
7 anticipatory where certain elements are inherently present, and in particular where elements are
8 inherently present based on Plaintiff's apparent claim construction in its Infringement
9 Contentions. Invalidity claim charts for these references with respect to the '314 Patent are
10 attached to these Invalidity Contentions.

- 11 1. U.S. Patent No. 5,748,190 to Kjorsvik (issued May 5, 1998)
- 12 2. U.S. Patent No. 5,913,040 to Rakavy et al. (issued June 15, 1999)
- 13 3. U.S. Patent No. 5,796,945 to Tarabella (issued August 18, 1998)
- 14 4. U.S. Patent No. 5,959,623 to Van Hoff et al. (issued September 28, 1999)
- 15 5. U.S. Patent No. 5,740,549 to Reilly et al., (issued April 14, 1998)
- 16 6. PCT Publication No. WO 94/30000 to Beaumont et al. (published December 22,
17 1994)
- 18 7. The Official America Online for Windows Tour Guide (2d ed. 1994)
- 19 8. Novell GroupWise Version 4.1 Reference for Macintosh (1994)
- 20 9. Systems and methods invented, designed, developed and/or in public use or on
21 sale related to BackWeb, as exemplified by the Rakavy '040 patent and subject to further
22 discovery. Based upon information currently available to Defendants, Defendants believe that
23 such a system was designed and developed by BackWeb before August 22, 1995, and may have
24 been in public use or on sale by BackWeb before March 22, 1995.
- 25 10. Systems and methods invented, designed, developed and/or in public use or on
26 sale by AT&T Corp., as exemplified by the U.S. Patent No. Farber '284 patent and subject to
27 further discovery. Based upon information currently available to Defendants, Defendants believe
28 that such a system was designed and developed by AT&T Corp. before March 24, 1995, and may

1 have been in public use or on sale by AT&T Corp. before March 22, 1995.

2 11. Systems and methods invented, designed, developed and/or in public use or on
3 sale related to PointCast, as exemplified by the Reilly '549 patent and subject to further
4 discovery. Based upon information currently available to Defendants, Defendants believe that
5 such a system was designed, and developed by PointCast, Inc., before June 12, 1995, and may
6 have been in public use or on sale by PointCast, Inc., before March 22, 1995.

7 12. Systems and methods invented, designed, developed and/or in public use or on
8 sale related to AOL's email or instant messaging systems, as exemplified by "The Official
9 America Online for Windows Tour Guide" (2d ed. 1994) and subject to further discovery. Based
10 upon information currently available to Defendants, Defendants believe that such a system was
11 designed and developed by AOL during or prior to 1994, and may have been in public use or on
12 sale by AOL during or prior to 1994.

13 13. Systems and methods invented, designed, developed and/or in public use or on
14 sale related to the Zephyr Notification Service, as exemplified by "The Zephyr Notification
15 Service," C. Anthony DellaFera, MIT 1988, and subject to further discovery. Based upon
16 information currently available to Defendants, Defendants believe that such a system was
17 designed and developed by Ciarán Anthony DellaFera, Michael R. Gretzinger, Mark W. Eichin,
18 Robert S. French, David C. Jedlinsky, John T. Kohl, and/or William E. Sommerfeld during or
19 prior to 1986, and may have been in public use or on sale by Ciarán Anthony DellaFera, Michael
20 R. Gretzinger, Mark W. Eichin, Robert S. French, David C. Jedlinsky, John T. Kohl, and/or
21 William E. Sommerfeld before March 22, 1995.

22 **B. Obviousness**

23 Pursuant to P.R. 121, Defendants identify the following additional prior art references and
24 systems now known to Defendants that either alone or in combination with other prior art
25 (including any of the above-identified anticipatory prior art and the additional prior art disclosed
26 in this section) render one or more of the asserted claims of the '314 Patent invalid as obvious
27 under 35 U.S.C. § 103. Invalidity claim charts for these references with respect to the '314 Patent
28 are also attached to these Invalidity Contentions. Defendants further identify combinations of

1 prior art (including any of the above-identified anticipatory prior art and the additional prior art
2 disclosed in this section) that render one or more of the asserted claims of the '314 Patent invalid
3 as obvious under 35 U.S.C. § 103. In certain instances, the suggested obviousness combinations
4 are provided in the alternative to Defendants' anticipation contentions and are not to be construed
5 to suggest that any reference included in the combinations is not by itself anticipatory.

- 6 1. U.S. Patent No. 5,572,643 to Judson (issued November 5, 1996)
- 7 2. U.S. Patent No. 5,819,284 to Farber et al. (issued October 6, 1998)
- 8 3. U.S. Patent No. 5,796,967 to Filepp et al. (issued August 18, 1998)
- 9 4. U.S. Patent No. 5,436,637 to Gayraud et al. (issued July 25, 1995)
- 10 5. U.S. Patent No. 5,309,234 to Kranawetter et al. (issued May 3, 1994)
- 11 6. U.S. Patent No. 5,781,894 to Petrecca et al. (issued July 14, 1998)
- 12 7. U.S. Patent No. 5,617,526 to Oran et al. (issued April 1, 1997)
- 13 8. The Zephyr Notification Service, C. Anthony DellaFera, (MIT 1988)
- 14 9. Systems and methods invented, designed, developed and/or in public use or on

15 sale related to DeskPicture by Peirce Software and subject to further discovery. Based upon
16 information currently available to Defendants, Defendants believe that such a system was
17 designed and developed by Peirce Software during or prior to 1993, and may have been in public
18 use or on sale by Peirce Software during or prior to 1993.

19 Each prior art reference and systems (collectively for this subsection, "references")
20 disclosed in the preceding Anticipation section and in this Obviousness section, either alone or in
21 combination with other prior art, also renders the asserted claims of the '314 Patent invalid as
22 obvious.

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

27 Defendants hereby incorporate the description in the February 28, 2011 Invalidity
28 Contentions served by all above-named defendants summarizing the law regarding obviousness.

1 Because the '314 Patent simply arranges old elements with each performing the same
2 function it had been known to perform and yields no more than what one would expect from such
3 an arrangement, the combination is obvious. Further, in the prior art, there were well-recognized
4 design needs and market pressures to present information to a user in the vicinity of a display
5 device. Such design needs and market pressures provided ample reason to combine the prior art
6 elements. *KSR*, 127 S. Ct. at 1742. Moreover, since there were a finite number of predictable
7 solutions, a person of ordinary skill in the art had good reason to pursue the known options. *Id.*
8 The above identified prior art references use those familiar elements for their primary or well-
9 known purposes in a manner well within the ordinary level of skill in the art. Accordingly,
10 common sense and knowledge of the prior art render the claims invalid under either § 102 or
11 § 103.

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

21 Below are several examples of prior art combinations with respect to particular
22 limitations. These prior art combinations are not exhaustive; rather, they are illustrative examples
23 of the prior art combinations disclosed generally above. These exemplary combinations are
24 alternatives to Defendants' anticipation and single reference obviousness contentions, and, thus,
25 they should not be interpreted as indicating that any of the individual references included in the
26 exemplary combinations are not alone invalidating prior art under 35 U.S.C. §§ 102 and/or 103.

27 To the extent that Plaintiff contends that any of the above-identified prior art fails to
28 disclose one or more limitations of the asserted claims of the '314 Patent, Defendants reserve the

1 right to identify other prior art references that would render the claims obvious despite the
2 allegedly missing limitation. Defendants reserve all rights to supplement or modify these Joint
3 Invalidation Contentions and to rely on other references that prove invalidity of these claims in a
4 manner consistent with the Federal Rules of Civil Procedure and the Rules of this Court.

5 1. U.S. Patent No. 5,748,190 to Kjorsvik, in view of one or more of the following:

- 6 ○ U.S. Patent No. 5,913,040 to Rakavy et al.
- 7 ○ U.S. Patent No. 5,796,945 to Tarabella
- 8 ○ U.S. Patent No. 5,959,623 to Van Hoff et al.
- 9 ○ U.S. Patent No. 5,740,549 to Reilly et al.
- 10 ○ PCT Publication No. WO 94/30000 to Beaumont et al.
- 11 ○ The Official America Online for Windows Tour Guide
- 12 ○ Novell GroupWise Version 4.1 Reference for Macintosh
- 13 ○ U.S. Patent No. 5,572,643 to Judson
- 14 ○ U.S. Patent No. 5,819,284 to Farber et al.
- 15 ○ U.S. Patent No. 5,796,967 to Filepp et al.
- 16 ○ U.S. Patent No. 5,436,637 to Gayraud et al.
- 17 ○ U.S. Patent No. 5,309,234 to Kranawetter et al.
- 18 ○ U.S. Patent No. 5,781,894 to Petrecca et al.
- 19 ○ U.S. Patent No. 5,617,526 to Oran et al.
- 20 ○ The Zephyr Notification Service, C. Anthony DellaFera

21 2. U.S. Patent No. 5,913,040 to Rakavy et al., in view of one or more of the
22 following:

- 23 ○ U.S. Patent No. 5,748,190 to Kjorsvik
- 24 ○ U.S. Patent No. 5,796,945 to Tarabella
- 25 ○ U.S. Patent No. 5,959,623 to Van Hoff et al.
- 26 ○ U.S. Patent No. 5,740,549 to Reilly et al.
- 27 ○ PCT Publication No. WO 94/30000 to Beaumont et al.
- 28 ○ The Official America Online for Windows Tour Guide

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- 4 o U.S. Patent No. 5,796,967 to Filepp et al.
- 5 o U.S. Patent No. 5,436,637 to Gayraud et al.
- 6 o U.S. Patent No. 5,309,234 to Kranawetter et al.
- 7 o U.S. Patent No. 5,781,894 to Petrecca et al.
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- 10 3. U.S. Patent No. 5,796,945 to Tarabella, in view of one or more of the following:
- 11 o U.S. Patent No. 5,748,190 to Kjorsvik
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- 22 o U.S. Patent No. 5,309,234 to Kranawetter et al.
- 23 o U.S. Patent No. 5,781,894 to Petrecca et al.
- 24 o U.S. Patent No. 5,617,526 to Oran et al.
- 25 o The Zephyr Notification Service, C. Anthony DellaFera
- 26 4. U.S. Patent No. 5,959,623 to Van Hoff et al., in view of one or more of the
- 27 following:
- 28 o U.S. Patent No. 5,748,190 to Kjorsvik

- 1 ○ U.S. Patent No. 5,913,040 to Rakavy et al.
- 2 ○ U.S. Patent No. 5,796,945 to Tarabella
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- 3 6. U.S Patent No. 5,740,549 to Reilly et al., in view of one or more of the following:
- 4 o U.S. Patent No. 5,748,190 to Kjorsvik
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- 6 o U.S. Patent No. 5,796,945 to Tarabella
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- 18 o The Zephyr Notification Service, C. Anthony DellaFera
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- 28 o U.S. Patent No. 5,572,643 to Judson

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- 7 ○ The Zephyr Notification Service, C. Anthony DellaFera
- 8 8. The Official America Online for Windows Tour Guide, in view of one or more of
- 9 the following:
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- 11 ○ U.S. Patent No. 5,913,040 to Rakavy et al.
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- 13 ○ U.S. Patent No. 5,959,623 to Van Hoff et al.
- 14 ○ U.S. Patent No. 5,740,549 to Reilly et al.
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- 22 ○ U.S. Patent No. 5,781,894 to Petrecca et al.
- 23 ○ U.S. Patent No. 5,617,526 to Oran et al.
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- 3 o U.S. Patent No. 5,740,549 to Reilly et al.
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- 10 o U.S. Patent No. 5,309,234 to Kranawetter et al.
- 11 o U.S. Patent No. 5,781,894 to Petrecca et al.
- 12 o U.S. Patent No. 5,617,526 to Oran et al.
- 13 o The Zephyr Notification Service, C. Anthony DellaFera

14 **C. Enablement, Written Description,**
15 **Indefiniteness Invalidation Under 35 U.S.C. § 112**

16 The Court’s Standing Order for Patent Cases requires, for each asserted claim, the
17 identification of “any grounds for invalidity based on indefiniteness, enablement, or written
18 description under 35 U.S.C. § 112.” Defendants provide below their preliminary invalidity
19 contentions on those three issues, for the asserted claims, preserving all other invalidity
20 contentions under other provisions of Section 112 (or any other Sections, such as Section 101),
21 and preserving all invalidity contentions for the non-asserted claims.

22 Defendants hereby incorporate the description in the February 28, 2011 Invalidity
23 Contentions served by all above-named defendants summarizing the law regarding § 112.

24 As Defendants best understand Plaintiff’s Infringement Contentions at this time, certain
25 asserted claims of the ’652 Patent fail to meet the requirements of 35 U.S.C. § 112(2) and/or 35
26 U.S.C. § 112(1) for at least the following reasons.

1 **1. Indefiniteness Under 35 U.S.C. § 112(2)**

2 a. **Additional Legal Principles**

3 Defendants hereby incorporate section IV(C)(1)(a).

4 b. **Indefinite Claims**

5 *All Asserted Claims*

6 All the asserted claims are indefinite because each of the claim terms or phrases quoted
7 below does not have a meaning that can be clearly and definitely determined, and thus fails to put
8 the public on notice of what is and is not covered by the claims.

- 9 • “peripheral attention”
- 10 • “set of content data”
- 11 • “selectively display [selectively displaying on the display device. . . /apparatus that
12 effects selective display on the display device]
- 13 • “in an unobtrusive manner that does not distract a user of the apparatus from a
14 primary interaction with the apparatus”
- 15 • “engaging [enabling engagement of] the peripheral attention of a user”
- 16 • “wherein the one or more sets of content data are selected from a plurality of sets
17 of content data”
- 18 • “without the content data being aggregated”
- 19 • “the respective content provider may provide”
- 20 • all the “instructions” limitations
- 21 • control option(s) [claims 7, 9, 10, 12, 13, and 15]

22 *Independent Claim 3*

23 For the reasons discussed above in section IV(C)(1)(b) for claims 15, 17, and 18 of the
24 ’652 patent relating to the “instructions for/that” language, the following limitations fail to satisfy
25 the requirements of § 112(2), rendering claim 3 and all claims dependent thereon indefinite.

- 26 • “instructions for providing one or more sets of content data to a content display
27 system associated with the display device and located entirely in the same physical
28 location as the display device”

- 1 • “instructions for providing to the content display system a set of instructions for
- 2 enabling the content display system to selectively display, in an unobtrusive
- 3 manner that does not distract a user of the display device or an apparatus
- 4 associated with the display device from a primary interaction with the display
- 5 device or apparatus, an image or images generated from a set of content data”
- 6 • “instructions for auditing the display of sets of content data by the content display
- 7 system”

8 ***Independent Claim 7***

9 For the reasons discussed above in section IV (C)(1)(b) for claims 15, 17, and 18 of the
10 ’652 patent relating to the “instructions for/that” language, the following limitations fail to satisfy
11 the requirements of § 112(2), rendering claim 7 and all claims dependent thereon indefinite.
12 Although the term “means” is not present in the claim, the claim limitations with the
13 “apparatus/device that” language fail to recite sufficient structure for performing the functions as
14 demonstrated below.

- 15 • “data acquisition apparatus that enables acquisition of a set of content data”
- 16 • “display apparatus that effects selective display on the display device, in an
- 17 unobtrusive manner that does not distract a user of the display device or an
- 18 apparatus associated with the display device from a primary interaction with the
- 19 display device or apparatus, of an image or images generated from the set of
- 20 content data”
- 21 • “user input apparatus that enables selection by a user of one or more control
- 22 options during the selective display of the image or images generated from the set
- 23 of content data”
- 24 • “a system control device that controls aspects of the operation of the system in
- 25 accordance with a selected control option”

26 ***Independent Claim 13***

27 For the reasons discussed above in section IV(C)(1)(b) for claims 15, 17, and 18 of the
28 ’652 patent relating to the “instructions for/that” language, the following limitations fail to satisfy

1 the requirements of § 112(2), rendering claim 13 and all claims dependent thereon indefinite.

- 2 • “instructions for acquiring a set of content data from a content providing system”
- 3 • “instructions for selectively displaying on the display device, in an unobtrusive
- 4 manner that does not distract a user of the display device or an apparatus
- 5 associated with the display device from a primary interaction with the display
- 6 device or apparatus, an image or images generated from the set of content data”
- 7 • “instructions for enabling selection by a user of one or more control options during
- 8 the selective display of the image or images generated from the set of content
- 9 data”
- 10 • “instructions for controlling aspects of the operation of the system in accordance
- 11 with a selected control option”

12 2. Lack of Written Description Under 35 U.S.C. § 112(1)

13 a. Additional Legal Principles

14 A negative limitation added to a claim to “carve out” subject matter to overcome a prior
15 art rejection violates the written description requirement if it introduces new concepts. *See In re*
16 *Xi*, 2008 WL 5232784, at *1-*3 (BPAI 2008) (determining a negative limitation to remove
17 impurities from a chemical compound that was added to overcome a prior art rejection violated
18 the written description requirement because the specification did not disclose that these impurities
19 could not be present”) (citing *Ex parte Grasselli*, 231 U.S.P.Q. 393, 394 (BPAI 1983) (finding the
20 negatively claimed language “said catalyst being free of uranium and the combination of
21 vanadium and phosphorous” in a product claim introduced new concepts because “the express
22 exclusion of certain elements implies the permissible inclusion of all other elements not so
23 expressly excluded”), *aff’d*, 738 F.2d 453 (Fed. Cir. 1983) (unpublished)).

24 b. Invalid Claims

25 *All Asserted Claims*

26 During prosecution, the following negative limitation was added to overcome prior art that
27 allegedly aggregated content data at a single service node. Amendment D (10/28/2003) at 9-10.
28 There is nothing in the specification to indicate that the patentee possessed an invention that

1 prohibited remote aggregation of content data as claimed. In fact, the term “aggregation” fails to
2 appear anywhere in the ’314 specification, and there is nothing in the specification to suggest that
3 content data can never be stored in a common remote location prior to being provided to a content
4 display system. Therefore, the following negative limitation added to “carve out” subject matter
5 from a prior art reference has no support in the specification and violates the written description
6 requirement.

- 7 • “without the content data being aggregated at a common physical location remote
8 from the content display system prior to being provided to the content display
9 system”

10 All asserted claims are also invalid for failing to satisfy the written description because
11 nowhere in the ’314 specification is (i) the physical location of content providers, or (ii)
12 independent transmission/receipt of content data, discussed.

- 13 • “wherein each associated content provider is located in a different physical
14 location than at least one other content provider and each content provider
15 provides its content data to the content display system independently of each other
16 content provider”

17 **3. Lack of Enablement Under 35 U.S.C. § 112(1)**

18 The terms identified above as lacking a supporting disclosure of an algorithm to perform
19 the recited function are invalid as not enabled given their indeterminate scope.

20 ***Independent Claims 3, 7, and 13***

21 The “instructions for” and “apparatus/device that” limitations described above in section
22 V(C)(1)(b) for claims 3, 7, and 13 as invalid means-plus-function limitations are also invalid for
23 lack of enablement under § 112(1). The functions the “instructions” and “apparatus/device” must
24 perform are not adequately disclosed such that a programmer of ordinary skill in the art could
25 create the necessary software and/or hardware without undue experimentation.

26
27 DATED this 28 day of February, 2011.

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1 **CERTIFICATE OF SERVICE**

2 I certify that, on this 28th day of February, 2011, I caused to be served via e-mail Defendants'
3 Invalidity Contentions with Respect to U.S. Patents Nos. 6,034,652 and 6,788,314 on all counsel
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48 **Defendants Invalidity Contentions with
Respect to U.S. Patents Nos. 6,034,652 and
6,788,314 (10-cv-01385-MJP)**

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