

Exhibit 5

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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' Amended 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 Amended Invalidity Contentions ("Amended Invalidity Contentions") and accompanying document production on Plaintiff and Counterclaim Defendant Interval Licensing LLC ("Plaintiff" or "Interval"). These Amended Invalidity Contentions add references and contentions from Defendants' Requests for Reexamination that were filed with the United States Patent and Trademark Office on March 16 and March 17, 2011. Three of the Requests for Reexamination were granted while the fourth remains pending.

1 **I. INTRODUCTION**

2 Plaintiff has asserted against Defendants one or more claims of one or more of United
3 States Patent Nos. 6,263,507 (the “507 Patent”), 6,757,682 (the “682 Patent”), 6,034,652 (the
4 “652 Patent”), and 6,788,314 (the “314 Patent”) (collectively, “Asserted Patents”). *See*
5 Plaintiff’s Disclosure of Asserted Claims and Infringement Contentions, served on Defendants on
6 December 28, 2010 (“Infringement Contentions”). Each Defendant joins these Amended
7 Invalidation Contentions only as to those claims of those patents asserted against that Defendant.

8 Defendants’ Amended Invalidation Contentions are based on their present understanding of
9 the asserted claims and Plaintiff’s apparent construction of the claims in its Infringement
10 Contentions. Accordingly, Defendants’ Amended Invalidation Contentions, including the
11 concurrently provided invalidity claim charts, may reflect alternative positions regarding claim
12 construction and scope. Further, by including prior art that anticipates or renders obvious claims
13 based on Plaintiff’s apparent claim construction or any other particular claim construction,
14 Defendants are not adopting Plaintiff’s claim construction, nor are they admitting to the accuracy
15 of any particular claim construction.

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

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

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

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

25 Defendants further may rely on any express or implied patent-applicant admissions or
26 admissions in the Asserted Patents or the prosecution thereof concerning the scope or content of
27 prior art; the patent prosecution histories for the Asserted Patents; any deposition testimony of the
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1 applicants for the Asserted Patents; and the papers filed and any evidence submitted by Plaintiff
2 in connection with this litigation. In particular, Defendants reserve the right to assert that the
3 asserted claims are invalid under 35 U.S.C. § 102(f) and/or (g) in the event Defendants obtain
4 evidence that the named inventors did not invent (either alone or in conjunction with others) the
5 subject matter claimed in the Asserted Patents or that others invented the subject matter claimed
6 before the named inventors. Should Defendants obtain such evidence, they will provide the name
7 of the person(s) from whom and the circumstances under which the claimed subject matter or any
8 part of it was derived or any prior inventors.

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

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

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

5 **II. THE '507 PATENT**

6 **A. Anticipation**

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

15 1. Bender et al., Network Plus, in SPIE Vol. 900 Imaging Applications in the Work
16 World, January 12-13, 1988 (published by SPIE – The International Society for Optical
17 Engineering).

18 2. Chesnais et al., The Fishwrap Personalized News System, in Proceedings of the
19 Second International Workshop on Community Networking, 1995, "Integrated Multimedia
20 Services to the Home," June 20-22, 1995 (published by IEEE).

21 3. Iwayama et al., Cluster-Based Text Categorization: A Comparison of Category
22 Search Strategies, SIGIR 1995 (published by ACM).

23 4. Masand et al., Classifying News Stories Using Memory Based Reasoning, SIGIR
24 1992 (published by ACM).

25 5. Hjelsvold et al., Integrated Video Archive Tools, in Multimedia '95, 1995
26 (published by ACM).

- 1 6. Drummond et al., Intelligent Browsing for Multimedia Applications, in
2 Proceedings of MULTIMEDIA '96, 1996 (published by IEEE).
- 3 7. Joachims et al., WebWatcher: Machine Learning and Hypertext, May 29, 1995.
- 4 8. Pentland et al., Photobook: Content-Based Manipulation of Image Databases, in
5 International Journal of Computer Vision, 1996 (published by Kluwer Academic Publishers).
- 6 9. Pentland et al., Photobook: Content-Based Manipulation of Image Databases, in
7 M.I.T. Media Laboratory Perceptual Computing Technical Report No. 255, 1993 (Pentland
8 1993).
- 9 10. Kindermann et al., The MIHMA Demonstrator Application: bmt line, April 1996.
- 10 11. Japanese Laid-Open Patent Application No. H08-106543 to Taniguchi et al. (filed
11 October 5, 1994, published April 23, 1996).
- 12 12. Japanese Laid-Open Patent Application No. H07-114572 to Yuasa et al. (filed
13 October 18, 1993, published May 2, 1995).
- 14 13. U.S. Patent No. 5,870,770 to Wolfe (filed Jan. 28, 1998, continuation of Ser. No.
15 487,925, Jun. 7, 1995, issued Feb. 9, 1999).
- 16 14. U.S. Patent No. 5,870,754 to Dimitrova et al. (filed Apr. 25, 1996, issued Feb. 9,
17 1999).
- 18 15. U.S. Patent No. 5,485,611 to Astle (filed Dec. 30, 1994, issued Jan. 16, 1996).
- 19 16. U.S. Patent No. 5,754,938 to Herz et al. (filed Oct. 31, 1995, issued May 19,
20 1998).
- 21 17. U.S. Patent No. 5,740,549 to Reilly et al. (filed Jun. 12, 1995, issued Apr. 14,
22 1998).
- 23 18. U.S. Patent No. 5,774,664 to Hidary et al. (filed Mar. 25, 1996, issued Jun. 30,
24 1998).
- 25 19. U.S. Patent No. 5,835,667 to Wactlar et al. (filed Oct. 14, 1994, issued Nov. 10,
26 1998).

1 20. U.S. Patent No. 6,025,837 to Matthews, III et al. (filed Mar. 29, 1996, issued Feb.
2 15, 2000).

3 21. U.S. Patent No. 5,553,221 to Reimer et al. (filed Jun. 1, 1995, issued Sep. 3,
4 1996).

5 22. Systems¹ and methods invented, designed, developed and/or in public use or on
6 sale related to Network Plus, as exemplified by the Bender article and subject to further
7 discovery. Based upon information currently available to Defendants, Defendants believe that
8 such a system was designed and developed at least before December 4, 1995, and may have been
9 in public use or on sale on or before December 4, 1995.

10 23. Systems and methods invented, designed, developed and/or in public use or on
11 sale related to Fishwrap, as exemplified by the Chesnais article and subject to further discovery.
12 Based upon information currently available to Defendants, Defendants believe that such a system
13 was designed and developed at least before December 4, 1995, and may have been in public use
14 or on sale on or before December 4, 1995.

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

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

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

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

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

12 **B. Obviousness**

13 Pursuant to P.R. 121, Defendants identify the following additional prior art references and
14 systems now known to Defendants that either alone or in combination with other prior art
15 (including any of the above-identified anticipatory prior art and the additional prior art disclosed
16 in this section) render the asserted claims of the '507 Patent invalid as obvious under 35 U.S.C.
17 § 103. Invalidity claim charts for these references with respect to the '507 Patent are also
18 provided to Plaintiff with these Amended Invalidity Contentions.

19 1. U.S. Patent No. 5,583,560 to Florin et al. (filed Jun. 22, 1993, issued Dec. 10,
20 1996).

21 2. U.S. Patent No. 6,199,080 to Nielsen (filed Aug. 30, 1996, issued Mar. 6, 2001).

22 3. U.S. Patent No. 5,963,916 to Kaplan (filed Oct. 31, 1996, issued Oct. 5, 1999).

23 4. Brown et al., Automatic Content-Based Retrieval of Broadcast News, in ACM
24 Multimedia 1995, Nov. 5-9, 1995 (published by ACM).

25 5. Cavnar et al., N-Gram Based Text Categorization, in Proceedings of SDAIR-94,
26 3rd Annual Symposium on Document Analysis and Information Retrieval, 1994 (published by
27 ACM).

- 1 6. Buckley et al., The Effect of Adding Relevance Information in a Relevance
- 2 Feedback Environment, in DIGIR 94, 1994.
- 3 7. Salton, Introduction to Modern Information Retrieval, 1983 (published by
- 4 McGraw-Hill).
- 5 8. Salton et al., Improving Retrieval Performance by Relevance Feedback, in Journal
- 6 for American Society for Information Science, June 1990.
- 7 9. Nielsen, Hypertext and Hypermedia, 1990 (published by Academic Press, Inc.).
- 8 10. “The Associated Press Stylebook and Libel Manual”, The Associated Press, 1994
- 9 (“AP Stylebook”)
- 10 11. “Wire Service Transmission Guidelines”, Number 84-2”, Special Report /
- 11 American Newspaper Publishers Association, ANPA June 14, 1984 (“WTS Guidelines”)

12 Each prior art reference and system (collectively for this subsection, “references”)

13 disclosed in the preceding Anticipation section and in this Obviousness section, either alone or in

14 combination with other prior art, also renders the asserted claims of the ’507 Patent invalid as

15 obvious.

16 In addition, there are admissions in the ‘507 patent² acknowledging that certain claimed

17 subject matter is disclosed in the prior art (“Plaintiff Admissions”). For instance, the ‘507 Patent

18 states that “[t]he degree of similarity can be determined using any appropriate method, such as,

19 for example, relevance feedback.” (28:36-38)- Further, in col. 28, line 55 - col. 29, line 3, the

20 patent states that

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22 [T]he use of relevance feedback to determine the similarity

23 between two text segments is well-known, and is described in

24 more detail in, for example, the textbook entitled *Introduction to*

25 *Modern Information Retrieval*, by Gerard Salton, McGraw-Hill,

26 New York, 1983, the pertinent disclosure of which is incorporated

by reference herein. Relevance feedback is also described in detail

in “Improving Retrieval Performance by Relevance Feedback,”

Salton, G., *Journal of the American Society for Information*

Science, vol. 41, no. 4, pp. 288-297, June 1990 as well as “The

27 ² Patent Owner admissions can be combined with prior art patents and printed publications.

28 MPEP § 2217(III).

1 Effect of Adding Relevance Information in a Relevance Feedback
2 Environment," Buckley, C. et. al., Proceedings of 17th
3 International Conference on Research and Development in
4 Information Retrieval, DIGIR 94, Springer-verlag (Germany),
5 1994, pp. 292-300, the disclosures of which are incorporated by
6 reference herein.

7 In other words, the '507 Patent itself makes clear that there is nothing particularly
8 significant or important – in terms of imparting patentability (either novelty or nonobviousness)
9 to a claim – about using relevance feedback to determine similarity, and it is just one of multiple
10 techniques that could be used.

11 The '507 Patent also includes admissions that data acquired from news sources must be
12 digital to process it: "As will be apparent from the description below, the processing of the data
13 representing the primary and secondary information generally requires that the data be in digital
14 form. Text data acquired from online text sources, for example, is acquired in digital form and so
15 can be used directly in such processing." *See, e.g.*, the '507 Patent at col. 12, lines 3-8.

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

20 The United States Supreme Court has clarified the standard for what types of inventions
21 are patentable. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). In particular, the Supreme
22 Court emphasized that inventions arising from ordinary innovation, ordinary skill, or common
23 sense should not be patentable. *Id.* at 1732, 1738, 1742-43, 1746. In that regard, a patent claim
24 may be obvious if the combination of elements was obvious to try or there existed at the time of
25 the invention a known problem for which there was an obvious solution encompassed by the
26 patent's claims. In addition, when a work is available in one field of endeavor, design incentives
27 and other market forces can prompt variations of it, either in the same field or a different one. If a
28 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

1 an arrangement, the '507 Patent's combination of known elements was obvious to a person of
2 ordinary skill in the art at the time of the alleged invention. Further, in the prior art, there were
3 well-recognized design needs and market pressures to develop a browser for use in navigating a
4 "body of information." Such design needs and market pressures provided ample reason to
5 combine the prior art elements. *KSR*, 127 S. Ct. at 1742. Moreover, since there were a finite
6 number of predictable solutions, a person of ordinary skill in the art had good reason to pursue the
7 known options. *Id.* The above '507 Patent merely uses those familiar elements for their primary
8 or well-known purposes in a manner well within the ordinary level of skill in the art.
9 Accordingly, common sense and knowledge of the prior art render the asserted claims of the '507
10 Patent invalid under either § 102 and/or § 103.

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

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

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

10 1. Bender in view of one or more of the following: Joachims, Taniguchi,
11 Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent,
12 Kaplan, Iwayama, Masand, Yuasa, Salton article, Salton book, Herz, Chesnais, Plaintiff
13 Admissions, and Buckley.

14 2. Chesnais in view of one or more of the following: Bender, Joachims, Taniguchi,
15 Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent,
16 Kaplan, Iwayama, Masand, Yuasa, Salton article, Salton book, Herz, AP Stylebook, WST
17 Guidelines, Plaintiff Admissions, and Buckley.

18 3. Iwayama in view of one or more of the following: Masand, Yuasa, Cavnar, Salton
19 book, Salton article, Buckley, Plaintiff Admissions, and Herz.

20 4. Masand in view of one or more of the following: Iwayama, Yuasa, Cavnar, Salton
21 book, Salton article, Buckley and Herz.

22 5. Yuasa in view of one or more of the following: Iwayama, Masand, Cavnar, Salton
23 book, Salton article, Buckley, Plaintiff Admissions, and Herz.

24 6. Hjelsvold in view of one or more of the following: Bender, Joachims, Taniguchi,
25 Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent,
26 Kaplan, Iwayama, Masand, Yuasa, Salton article, Salton book, Herz, and Buckley.

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

5 8. Drummond in view of one or more of the following: Bender, Wolfe, Taniguchi,
6 Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley, Herz, Matthews, and Yuasa.

7 9. Pentland in view of one or more of the following: Chesnais, Bender, Joachims,
8 Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent,
9 Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.

10 10. Pentland 1993 in view of one or more of the following: Chesnais, Bender,
11 Joachims, Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book,
12 Nielsen patent, Kaplan, Iwayama, Masand, Yuasa, Salton , Herz, and Buckley.

13 11. Taniguchi in view of one more of the following: Chesnais, Bender, Joachims,
14 Taniguchi, Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book,
15 Nielsen patent, Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.

16 12. Wolfe in view of one or more of the following: Bender, Chesnais, Wactlar,
17 Reimer, Nielsen book, Nielsen patent, Dimitrova, Yuasa, Iwayama, Masand, Cavnar, Salton
18 article, Salton book, Buckley and Herz.

19 13. Dimitrova in view of one or more of the following: Bender, Chesnais, Wactlar,
20 Reimer, Nielsen book, Nielsen patent, Wolfe, Yuasa, Iwayama, Masand, Cavnar, Salton article,
21 Salton book, Buckley and Herz.

22 14. Astle in view of one or more of the following: Bender, Chesnais, Wactlar,
23 Reimer, Nielsen book, Nielsen patent, Wolfe, Yuasa, Iwayama, Masand, Cavnar, Salton book,
24 Salton article, Buckley and Herz.

25 15. Reilly in view of one or more of the following: Bender, Chesnais, Taniguchi,
26 Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent,
27 Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.
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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 Amended 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.

1 All asserted claims of the ‘507 Patent violate the requirements of Section 112, ¶ 2, and all
2 asserted claims fail to satisfy the enablement and written description requirements of Section 112,
3 ¶ 1.

4 **1. Legal Background Regarding**
5 **Indefiniteness, Enablement, and Written Disclosure**

6 Section 112 includes a definiteness requirement. *See* 35 U.S.C. § 112(2) (“[T]he
7 specification shall conclude with one or more claims particularly pointing out and distinctly
8 claiming the subject matter which the applicant regards as his invention.”). When claims are “not
9 amenable to construction” or “insolubly ambiguous,” they are indefinite. *Young v. Lumenis, Inc.*,
10 497 F.3d 1336, 1346 (Fed. Cir. 2007).

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

16 If a patent applicant coins a term used in a patent claim, she has a duty to define that
17 coined term with precision or else the claim may be invalid for indefiniteness. *J.T. Eaton & Co.*
18 *v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1570 (Fed. Cir. 1997). Inconsistencies between a
19 claim and a disclosure of a patent may render the claim indefinite. A patent claim is indefinite if
20 it claims both a system and a method of using the system. *IPXL Holdings LLC v. Amazon.com,*
21 *Inc.*, 430 F.3d 1377, 1383-84 (Fed. Cir. 2005). Where a patent fails to specify which of available
22 alternative tests to use for measuring compliance with a claim limitation, and different tests can
23 have different results, the claims are indefinite. *Honeywell Int’l, Inc. v. ITC*, 341 F.3d 1332 (Fed.
24 Cir. 2003). “Whether the patent expressly or at least clearly differentiates itself from specific
25 prior art ... is an important consideration in the definiteness inquiry.” *Halliburton Energy Servs.,*
26 *Inc. v. M-I LLC*, 514 F.3d 1244 (Fed. Cir. 2008). Claim limitations that lack a definite scope and
27 include aspects that are inherently subjective are also indefinite under 35 U.S.C. § 112(2).
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1 *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350-52 (Fed. Cir. 2005) (affirming
2 holding that the claim term “aesthetically pleasing” was indefinite because “the scope of claim
3 language cannot depend solely on the unrestrained, subjective opinion of a particular individual
4 purportedly practicing the invention”).

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

16 A patent claim reciting a function without using the term “means” is still subject to
17 Section 112(6) if “the claim term fails to recite sufficiently definite structure or else recites
18 function without reciting sufficient structure for performing that function.” *Massachusetts Inst. of*
19 *Tech. and Elecs. for Imaging, Inc. v. Abacus Software*, 462 F.3d 1344, 1353 (Fed. Cir. 2006)
20 (internal quotations and citations omitted); *see also, e.g., Welker Bearing Co. v. PHD, Inc.*, 550
21 F.3d 1090, 1096 (Fed. Cir. 2008) (ruling claim limitation reciting “a mechanism for moving ...”
22 was a means-plus-function limitation despite not including the word “means” because “no
23 adjective endows the claimed ‘mechanism’ with a physical or structural component”); *Inventio*
24 *AG v. ThyssenKrupp Elevator Americas Corp.*, 718 F. Supp. 2d 529, 558-59 (D. Del. 2010)
25 (holding claim term “computing unit” was a means-plus-function limitation because nothing in
26 the claim language provided sufficient structure for any of the functions performed by the
27 “computing unit”).
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1 35 U.S.C. § 112 further includes an enablement requirement. *See* 35 U.S.C. § 112(1)
2 (“The specification shall contain a written description . . . of the manner and process of making
3 and using [the invention] in such full, clear, concise and exact terms as to enable any person
4 skilled in the art to which it pertains, or with which it is most nearly connected, to make and use
5 the same.”).

6 To satisfy the enablement requirement, the disclosure “must teach those skilled in the art
7 how to make and use the full scope of the claimed invention without ‘undue experimentation.’”
8 *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999 (Fed. Cir. 2008). Moreover, “[i]t is the
9 specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an
10 invention in order to constitute adequate enablement.” *Genentech, Inc. v. Novo Nordisk A/S*, 108
11 F.3d 1361, 1366 (Fed. Cir. 1997). “If, by following the steps set forth in the specification, one of
12 ordinary skill in the art is not able to replicate the claimed invention without undue
13 experimentation, the claim has not been enabled as required by 112, paragraph 1.” *National*
14 *Recovery Tech., Inc. v. Magnetic Separation Syst., Inc.*, 166 F.3d 1190 (Fed. Cir. 1990).
15 Similarly, if a specification teaches away from a substantial portion of the claim, or otherwise
16 does not enable the full scope of the claim, there is no enablement. *AK Steel Corp. v. Sollac*, 344
17 F.3d 1234 (Fed. Cir. 2003); *see also Alza Corp. v. Andrx Pharms.*, 603 F.3d 935, 940–43 (Fed.
18 Cir. 2010) (claims covering both non-osmotic and osmotic embodiments were invalid for the
19 patent’s failure to enable non-osmotic embodiments); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
20 999–1002 (Fed. Cir. 2008) (claims covering invention’s use with both movies and video games
21 were invalid for patent’s failure to enable the claimed “invention” in the context of movies);
22 *Automotive Techs. Int’l, Inc. v. BMW of N. Am., Inc.*, 501 F.3d 1274, 1281–85 (Fed. Cir. 2007)
23 (claims covering both mechanical and electronic sensors were invalid for patent’s failure to
24 enable electrical sensors); *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1377–80 (Fed.
25 Cir. 2007) (claims covering injectors with or without a pressure jacket were invalid for patent’s
26 failure to enable injector without a pressure jacket).

1 35 U.S.C. § 112 further includes a written description requirement. *See* 35 U.S.C.
2 § 112(1) (“The specification shall contain a written description of the invention . . .”). “The test
3 [for written description support] requires an objective inquiry into the four corners of the
4 specification from the perspective of a person of ordinary skill in the art. Based on that inquiry,
5 the specification must describe an invention understandable to that skilled artisan and show that
6 the inventor actually invented the invention claimed.” *Ariad Pharmaceuticals, Inc. v. Eli Lilly &*
7 *Co.*, 598 F.3d 1336 (Fed. Cir. 2010) (en banc). The disclosure of the claimed subject matter must
8 be:

- 9 • express or necessarily present, *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir.
10 1998);
- 11 • complete, *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1995)
12 (“One shows that one is ‘in possession’ of the invention by describing the invention,
13 with all its claimed limitations. . . .”);
- 14 • unambiguous, *Hyatt v. Boone*, 146 F.3d 1348, 1352 (Fed. Cir. 1998),
- 15 • specific, *Purdue Pharma L.P. v. F.H. Faulding and Co.*, 230 F.3d 1320, 1322 (Fed.
16 Cir. 2000); and
- 17 • as broad as the claim, *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1478-80
18 (Fed. Cir. 1998).

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

23 **2. Invalidity of the Asserted Claims**

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

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

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

21 The patent discloses that “[a]n important aspect of the invention is the capability to
22 determine relatedness of segments of information represented by different types of data.” But
23 nothing in the patent enables comparison of unaugmented video to other data forms that lack
24 visual characteristics such as hue, chrominance, etc., such as pure audio. This further renders the
25 asserted claims invalid under all Sec. 112 requirements discussed above.
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1 Additionally, the asserted claims are invalid under all Sec. 112 requirements discussed
2 above, particularly in some cases given the breadth that Interval apparently intends to assert for
3 such claims:

- 4 • To the extent that the asserted claims are read to include techniques or instructions
5 capable of acquiring a body of information having at least two adjoining segments that
6 differ from each other in subject matter or theme but which have no augmentation
7 explicitly identifying the breaks between those different segments, and capable of
8 reliably identifying and displaying two different segments having related subject
9 matters or themes without displaying an unrelated segment, and capable of doing so
10 without structuring, partitioning, categorizing, or augmenting the body of information,
11 this renders the asserted claims invalid under all requirements of Section 112
12 discussed above.
- 13 • To the extent that the claims are read as not requiring a step or function of
14 “structuring” (as this term is used in the patent) the data representing the body of
15 information, this further renders the asserted claims invalid under all requirements of
16 Section 112 discussed above.
- 17 • To the extent that the claims are read as not requiring a step or function of
18 “synchronizing” audio and video portions of the body of information, this further
19 renders the asserted claims invalid under all requirements of Section 112 discussed
20 above.
- 21 • To the extent that the claims are read as not requiring a step or function of obtaining “a
22 textual representation of audiovisual data” representing the body of information, this
23 further renders the asserted claims invalid under all requirements of Section 112
24 discussed above.

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

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

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

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

26 The claim term "body of information" is indefinite. For example, the patent does not
27 sufficiently explain criteria for distinguishing between a "body of information" versus "data
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1 representing a body of information,” or for distinguishing between one “body of information” and
2 another “body of information,” or for distinguishing between a “body of information” and a
3 portion of a “body of information,” or for distinguishing a “body of information” from
4 “information.” Nor does the patent distinguish, sufficiently, between “body of information,”
5 “segment,” “different segment,” “portion or representation of a segment,” and “data.”

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

9 The claim term “reviewing” “a body of information” is indefinite because, among other
10 reasons, the ’507 Patent does not disclose what it means to “review” a “body of information.”

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

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

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

23 The claim term “a defined set of information in the body of information” is indefinite
24 because, among other reasons, it is unclear what criteria are used to identify a “defined” set of
25 information in the “body of information.”
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1 The claim term “acquiring data representing the body of information” is indefinite
2 because, among other reasons, the patent does not adequately disclose criteria for determining
3 whether or not certain data is or is not adequate to “represent” a “body of information.”

4 To the extent that this claim language is read to include retrieving data already in the
5 possession and control of the entity performing this step or function, or to include creating
6 information, or to include passively receiving information sent by another specifically to the
7 recipient, this further renders the asserted claims invalid under all Sec. 112 requirements
8 discussed above.

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

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

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

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

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

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

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

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

18 Further regarding claim 63 and its dependent asserted claims, the patent does not describe
19 or enable even one computer readable medium encoded with the recited instructions, rendering
20 the claim invalid under all Sec. 112 requirements described above. Further, the patent discloses
21 no example of any encoded instructions for any of the functions recited in these claims. To the
22 extent these claims’ “instructions for . . .” elements are governed by Section 112, ¶ 6, they lack
23 sufficient corresponding “structure” in the patent, further rendering these claims invalid for
24 indefiniteness. Alternatively, even if not interpreted as Section 112, ¶ 6 limitations, these claims
25 are indefinite because they do not recite a description of any algorithm or similar disclosure that
26 is sufficient to distinguish the computer-readable media from the prior art or any other
27 instructions that perform a similar function.
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1 The claim phrase “instructions for generating a display of a portion of, or a representation
2 of, a second segment of the body of information from data that is part of the stored data, wherein
3 the display of the portion or representation of the second segment is generated in response to the
4 display of a first segment to which the second segment is related” is indefinite because, among
5 other reasons, it is indefinite as to whether the recited instructions must be responsible for
6 carrying out the “wherein” restriction.

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

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

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

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

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

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

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

4 The reference to “further comprising” in claims 37 and 80 lacks any antecedent basis and
5 renders the claims indefinite.

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

- 8 • “body of information”;
- 9 • “segment representing a defined set of information”;
- 10 • “determining the degree of similarity between the subject matter content of the
11 uncategorized segment and the subject matter content of each of the previously
12 categorized segments”; and
- 13 • “identifying one or more of the previously categorized segments as relevant to the
14 uncategorized segment based upon the determined degrees of similarity.”

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

- 17 • “determining the degree of similarity between the subject matter content of the
18 uncategorized segment and the subject matter content of each of the previously
19 categorized segments”; and
- 20 • “identifying one or more of the previously categorized segments as relevant to the
21 uncategorized segment based upon the determined degrees of similarity.”

22 To the extent that Interval alleges that “determining the degree of similarity between the
23 subject matter content of the uncategorized segment and the subject matter content of each of the
24 previously categorized segments” may be performed in a manner other than by “relevance
25 feedback,” claim 39 and its asserted dependent claims are not described or fully enabled because
26 the patent specification provides no other discussion of how to determine a degree of similarity.

27 To the extent that Interval alleges that this claim limitation may be performed by “relevance
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1 feedback,” the claim is not enabled because the specification does not teach how “relevance
2 feedback” would be applied to “determine[e] the degree of similarity between the subject matter
3 content of the uncategorized segment and the subject matter content of each of the previously
4 categorized segments.”

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

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

10 Claims 43 and 86 are also invalid because “performing a relevance feedback method” is
11 indefinite.

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

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

19 **III. THE '682 PATENT**

20 **A. Anticipation**

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

- 3 1. U.S. Patent No. 5,749,081 to Whiteis (filed April 6, 1995; issued May 5, 1998)
- 4 2. U.S. Patent No. 5,428,778 to Brookes (filed September 13, 1994; issued June 27,
5 1995)
- 6 3. U.S. Patent No. 5,724,567 to Rose et al. (filed April 25, 1994; issued March 3,
7 1998)
- 8 4. U.S. Patent No. 6,049,777 to Sheena et al. (filed March 14, 1997; issued April 11,
9 2000)
- 10 5. U.S. Patent No. 6,195,657 to Rucker et al. (filed September 25, 1997; issued
11 February 27, 2001)
- 12 6. U.S. Patent No. 6,385,619 to Eichstaedt et al. (filed January 8, 1999; issued May 7,
13 2002)
- 14 7. U.S. Patent No. 7,082,407 to Bezos et al. (filed August 19, 1999³; issued July 25,
15 2006)
- 16 8. U.S. Patent No. 6,466,918 to Spiegel et al. (filed November 18, 1999; issued
17 October 15, 2002)
- 18 9. "SiteSeer: Personalized Navigation for the Web," published March 1997 in
19 Communications of the ACM (Vol. 40, No. 3), authored by James Rucker and Marcos J. Polanco.
- 20 10. "Building Consumer Trust with Accurate Product Recommendations: A White
21 Paper on LikeMinds WebSell 2.1," published 1997, authored by Dan R. Greening.
- 22 11. "Making Recommender Systems Work for Organizations," published April 1999
23 by "Proceedings of PAAM '99," authored by Nathalie Glance, Damian Arregui, and Manfred
24 Dardenne.

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27 ³ Bezos claims priority to an earlier-filed provisional application, U.S. Provisional Application
28 No. 60/128,557, filed on April 9, 1999.

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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.

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

1 further discovery. Based upon information currently available to Defendants, Defendants believe
2 that such a system was designed and developed at least before December 31, 1997, and may have
3 been in public use or on sale on or before December 31, 1997 by LikeMinds, Inc.

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

10 **B. Obviousness**

11 Pursuant to P.R. 121, Defendants identify the following additional prior art references and
12 systems now known to Defendants that either alone or in combination with other prior art
13 (including any of the above-identified anticipatory prior art and the additional prior art disclosed
14 in this section) render the asserted claims of the '682 Patent invalid as obvious under 35 U.S.C.
15 § 103. Invalidity claim charts for these references with respect to the '682 Patent are provided to
16 Plaintiff with these Invalidity Contentions.

17 1. "Knowledge Pump: Community-centered Collaborative Filtering," published
18 October 27, 1997, authored by Natalie Glance, Damian Arregui, and Manfred Dardenne.

19 2. Microstrategy, Inc., "MicroStrategy Launches Strategy.com, the World's First
20 Personal Intelligence Network," press release dated June 28, 1999

21 3. U.S. Patent No. 7,181,417 to Langseth et al. (filed January 21, 2000, issued
22 February 20, 2007)

23 4. "webCobra: An Automated Collaborative Filtering Agent System for the World
24 Wide Web," published December 5, 1997, authored by Steve Nesbitt.

25 5. U.S. Patent No. 6,078,740 to DeTreville et al. (filed November 4, 1996; issued
26 June 20, 2000)

1 6. Systems and methods invented, designed, developed and/or in public use or on
2 sale related to MicroStrategy Broadcaster, as exemplified by U.S. Patent No. 7,181,417 to
3 Langseth et al. and/or to “Strategy.com,” and subject to further discovery. Based upon
4 information currently available to Defendants, Defendants believe that such a system was
5 designed and developed at least before June 28, 1999, and may have been in public use or on sale
6 on or before June 28, 1999 by Microstrategy, Inc.

7 7. U.S. Patent No. 6,807,558 to Hassett et al. (filed June 2, 1998; issued October 19,
8 2004)

9 8. U.S. Patent No. 7,209,942 to Hori et al, (filed December 23, 1999; issued April 24,
10 2007)

11 Each prior art reference and system (collectively for this subsection, “references”)
12 disclosed in the preceding Anticipation section and in this Obviousness section, either alone or in
13 combination with other prior art, also renders the asserted claims of the ’682 Patent invalid as
14 obvious.

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

19 Because the ’682 Patent simply arranges old elements with each performing the same
20 function it had been known to perform and yields no more than what one would expect from such
21 an arrangement, the combination is obvious. Further, in the prior art, there were well-recognized
22 design needs and market pressures to alert users to items of current interest. Such design needs
23 and market pressures provided ample reason to combine the prior art elements. *KSR*, 127 S. Ct. at
24 1742. Moreover, since there were a finite number of predictable solutions, a person of ordinary
25 skill in the art had good reason to pursue the known options. *Id.* The ’682 Patent merely uses
26 those familiar elements for their primary or well-known purposes in a manner well within the
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1 ordinary level of skill in the art. Accordingly, common sense and knowledge of the prior art
2 render the asserted claims of the '682 Patent invalid under either § 102 and/or § 103.

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

12 Defendants further identify combinations of prior art (including any of the above-
13 identified anticipatory prior art and the additional prior art disclosed in this section) that render
14 the asserted claims of the '682 Patent invalid as obvious under 35 U.S.C. § 103. Below are
15 several examples of prior art combinations. These prior art combinations are not exhaustive;
16 rather, they are illustrative examples of the prior art combinations disclosed generally above.
17 These exemplary combinations are alternatives to Defendants' anticipation and single-reference
18 obviousness contentions, and, thus, they should not be interpreted as indicating that any of the
19 individual references included in the exemplary combinations are by themselves invalidating
20 prior art under 35 U.S.C. §§ 102 and/or 103.

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

- 27 1. U.S. Patent No. 5,749,081 to White is in view of one or more of the following:
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- 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.

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- “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.

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- 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

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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”

B. 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. Further, the clause using this claim term is grammatically flawed and ambiguous. For example, it is unclear whether “intensity weight value” is the second object of the verb “determine” or the second object of the preposition “with.” 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

1 other, rendering the asserted claims invalid under all Sec. 112 requirements discussed above.
2 Moreover, the patent does not describe or enable a process that performs this step of “determining
3 an intensity value to be associated with the indication” more than once for a given indication,
4 rendering claim 18 invalid under all Sec. 112 requirements discussed above.

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

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

16 Each claim recites “adjusting the intensity value” after determining it, irreconcilably
17 contradicting the patent, which describes a single “determine alert intensity” step (*e.g.*, at Fig. 6,
18 step 602) and never describes adjusting the value so determined. The patent describes a series of
19 calculations to reach that determination of an alert’s intensity value, but as shown in Fig. 6, it
20 regards those calculations as constituting a single determining step, not a step of determining
21 followed by a step of adjusting, as erroneously claimed. This renders the asserted claims invalid
22 under all Sec. 112 requirements discussed above.

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

25 To the extent that this claim term is read to cover indications that something as a whole is
26 of interest, rather than activity occurring now in the electronic resource is of interest, this renders
27 the asserted claims invalid under all Sec. 112 requirements discussed above.
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1 To the extent that the claim term “item” or “item . . . of current interest” is read to include
2 content that is not dynamically changing in “real-time,” such as recorded content any portion of
3 which can be accessed at any time, this renders the asserted claims invalid under all Sec. 112
4 requirements discussed above.

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

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

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

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

19 To the extent that the claim term “indication” is read to have two different meanings in the
20 same claim, that renders the asserted claims indefinite in violation of Section 112, ¶ 2. To the
21 extent that the claim term “indication” is read as having the same meaning throughout each claim,
22 this renders the claims invalid under Section 112, ¶ 1. For example, the patent does not describe
23 or enable (following the disclosure’s steps) receiving an “indication” from a “source” and
24 disseminating that same “indication” to a “participant.”

25 To the extent that the claim term “indication” is read to encompass messages not derived
26 from the actions of a person while viewing the “item” in question, this renders the asserted claims
27 invalid under all Sec. 112 requirements discussed above.
28

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

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

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

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

16 The claim language “an indication that an item ... is of current interest” renders the
17 asserted claims invalid under all Sec. 112 requirements discussed above. To the extent that the
18 claims are read to include indications of interest in an item as a whole, a topic generally, or as
19 otherwise distinct from an indication of interest in a particular activity (e.g., scene) of the item
20 (e.g., rhinos appearing at the watering hole), this renders the asserted claims invalid under all
21 Sec. 112 requirements discussed above.

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

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

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

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

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

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

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

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

24 To the extent that the claim phrase “based on a characteristic for the item provided by the
25 source” is read to cover “characteristics” that are not a distinct trait of the item that the item
26 possessed independent of any action by, or subjective opinion of, the source, this renders the
27 asserted claims invalid under all Sec. 112 requirements discussed above.
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1 To the extent that the language “item is of current interest” in the phrase “informing the
2 participant that the item is of current interest” is read to have a different meaning than the same
3 claim language has earlier in the claim, this renders the asserted claims in violation of
4 Section 112, ¶ 2.

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

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

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

19 There is no support in the patent for an “intensity rank indicating the level of current
20 interest of the item relative to other items.” For example, an “intensity rank” may be calculated
21 even when there is only one item for which alerts have been received. The recited “intensity
22 rank” calculation does not concern more than one item. This renders claims 5 and 6 invalid under
23 all Sec. 112 requirements discussed above.

24 The claim language “based at least in part on the intensity value of the indication” does
25 not specify which of the two previously determined “indications” or “intensity” values it
26 references, rendering claims 5-6 invalid under Section 112, ¶ 2.
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28

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

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

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

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

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

22 Claims 1 and 2 are further indefinite for claiming functions without reciting structure in
23 support of the claim-recited functions. To the extent that the claim language “a computer
24 configured to . . . inform the participant that the item is of current interest” in claim 1 and/or
25 “computer instructions for . . . informing the participant that the item is of current interest” in
26 claim 2 is read to be a means-plus-function element subject to Section 112, ¶ 6, this further
27 renders these claims invalid for indefiniteness for failure of the patent specification to adequately
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1 disclose, and link to the claim-recited functions, specific corresponding algorithms or other
2 “structure.” Further, the body of claim 2 recites nothing other than this claim language “computer
3 instructions for . . . informing the participant that the item is of current interest,” and thus its
4 indefiniteness cannot be remedied by resort to Sec. 112, ¶ 6.

5 To the extent the patentee has failed to set forth in the specification the best mode
6 contemplated by the inventors of carrying out the alleged invention, such as features associated
7 with the commercial website Kundi.com, the ’682 patent is invalid under Sec. 112, ¶ 1. Because
8 much of the information relevant to the contention that the asserted claims are invalid for failure
9 to satisfy the best-mode requirement is uniquely within the possession of Interval, and discovery
10 is ongoing, Defendants expect to develop further information in support of this defense.

11 **II. THE ’652 PATENT**

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

14 **III. THE ’314 PATENT**

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

17 **IV. ACCOMPANYING DOCUMENT PRODUCTION**

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

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

27 DATED this 26th day of May 2011.

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CERTIFICATE OF SERVICE

I certify that, on this 26th day of May, 2011, I caused to be served via e-mail Defendants' Amended Invalidity Contentions on all counsel who have appeared in this action:

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14 I further certify that, on this 26th day of May, 2011, I caused to be served via shared
workspace and via FedEx Defendants' Supplemental Claim Charts accompanying their Amended
15 Invalidity Contentions on Plaintiff's counsel.

16 DATED: May 26, 2011

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