

EXHIBIT A

HON. MARSHA J. PECHMAN

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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' Invalidation Contentions

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

I. INTRODUCTION

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

1 “652 Patent”), and 6,788,314 (the “314 Patent”) (collectively, “Asserted Patents”). *See*
2 Plaintiff’s Disclosure of Asserted Claims and Infringement Contentions, served on Defendants on
3 December 28, 2010 (“Infringement Contentions”). Each Defendant joins these Invalidity
4 Contentions only as to those claims of those patents asserted against that Defendant.

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

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

17 The accompanying invalidity claim charts list specific examples of prior art references
18 and systems which disclose, either expressly or inherently, each limitation of certain claims
19 and/or examples of prior art references and systems in view of which a person of ordinary skill in
20 the art would have considered each limitation and the claimed combination of such limitations
21 obvious. Defendants have endeavored to identify the relevant portions of the references and
22 features of the systems. The references and systems, however, may contain additional support for
23 other claim limitations. Defendants may rely on uncited portions of the references and/or uncited
24 features of the systems, other documents and expert testimony to provide context or to aid in
25 understanding the cited portions of the references and/or cited features of the systems. Where
26 Defendants cite to a particular figure in a reference, the citation should be understood to
27 encompass the caption and description of the figure and any text relating to the figure.
28

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

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

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

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

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

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

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

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

1 **II. THE '507 PATENT**

2 **A. Anticipation**

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

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

- 1 9. Pentland et al., Photobook: Content-Based Manipulation of Image Databases, in M.I.T.
- 2 Media Laboratory Perceptual Computing Technical Report No. 255, 1993 (Pentland
- 3 1993).
- 4 10. Kindermann et al., The MIHMA Demonstrator Application: bmt line, April 1996.
- 5 11. Japanese Laid-Open Patent Application No. H08-106543 to Taniguchi et al. (filed October
- 6 5, 1994, published April 23, 1996).
- 7 12. Japanese Laid-Open Patent Application No. H07-114572 to Yuasa et al. (filed October 18,
- 8 1993, published May 2, 1995).
- 9 13. U.S. Patent No. 5,870,770 to Wolfe (filed Jan. 28, 1998, continuation of Ser. No. 487,925,
- 10 Jun. 7, 1995, issued Feb. 9, 1999).
- 11 14. U.S. Patent No. 5,870,754 to Dimitrova et al. (filed Apr. 25, 1996, issued Feb. 9, 1999).
- 12 15. U.S. Patent No. 5,485,611 to Astle (filed Dec. 30, 1994, issued Jan. 16, 1996).
- 13 16. U.S. Patent No. 5,754,938 to Herz et al. (filed Oct. 31, 1995, issued May 19, 1998).
- 14 17. U.S. Patent No. 5,740,549 to Reilly et al. (filed Jun. 12, 1995, issued Apr. 14, 1998).
- 15 18. U.S. Patent No. 5,774,664 to Hidary et al. (filed Mar. 25, 1996, issued Jun. 30, 1998).
- 16 19. U.S. Patent No. 5,835,667 to Wactlar et al. (filed Oct. 14, 1994, issued Nov. 10, 1998).
- 17 20. U.S. Patent No. 6,025,837 to Matthews, III et al. (filed Mar. 29, 1996, issued Feb. 15,
- 18 2000).
- 19 21. U.S. Patent No. 5,553,221 to Reimer et al. (filed Jun. 1, 1995, issued Sep. 3, 1996).
- 20 22. Systems¹ and methods invented, designed, developed and/or in public use or on sale
- 21 related to Network Plus, as exemplified by the Bender article and subject to further
- 22 discovery. Based upon information currently available to Defendants, Defendants believe
- 23 that such a system was designed and developed at least before December 4, 1995, and
- 24 may have been in public use or on sale on or before December 4, 1995.
- 25 23. Systems and methods invented, designed, developed and/or in public use or on sale related
- 26 to Fishwrap, as exemplified by the Chesnais article and subject to further discovery.

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

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

4 24. Systems and methods invented, designed, developed and/or in public use or on sale related
5 to Pointcast, as exemplified by the Reilly '549 patent and subject to further discovery.

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

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

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

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

25 **B. Obviousness**

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

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

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

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

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

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

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

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

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

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

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

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

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

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

- 1 4. Masand in view of one or more of the following: Iwayama, Yuasa, Cavnar, Salton book,
2 Salton article, Buckley and Herz.
- 3 5. Yuasa in view of one or more of the following: Iwayama, Masand, Cavnar, Salton book,
4 Salton article, Buckley and Herz.
- 5 6. Hjelsvold in view of one or more of the following: Bender, Joachims, Taniguchi,
6 Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen
7 patent, Kaplan, Iwayama, Masand, Yuasa, Salton article, Salton book, Herz, and Buckley.
- 8 7. Joachims in view of one or more of the following: Bender, Chesnais, Taniguchi,
9 Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen
10 patent, Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.
- 11 8. Drummond in view of one or more of the following: Bender, Wolfe, Taniguchi, Iwayama,
12 Masand, Cavnar, Salton book, Salton article, Buckley, Herz, Matthews, and Yuasa.
- 13 9. Pentland in view of one or more of the following: Chesnais, Bender, Joachims,
14 Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen
15 patent, Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.
- 16 10. Pentland 1993 in view of one or more of the following: Chesnais, Bender, Joachims,
17 Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen
18 patent, Kaplan, Iwayama, Masand, Yuasa, Salton , Herz, and Buckley.
- 19 11. Taniguchi in view of one more of the following: Chesnais, Bender, Joachims, Taniguchi,
20 Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen
21 patent, Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.
- 22 12. Wolfe in view of one or more of the following: Bender, Chesnais, Wactlar, Reimer,
23 Nielsen book, Nielsen patent, Dimitrova, Yuasa, Iwayama, Masand, Cavnar, Salton
24 article, Salton book, Buckley and Herz.
- 25 13. Dimitrova in view of one or more of the following: Bender, Chesnais, Wactlar, Reimer,
26 Nielsen book, Nielsen patent, Wolfe, Yuasa, Iwayama, Masand, Cavnar, Salton article,
27 Salton book, Buckley and Herz.
- 28

- 1 14. Astle in view of one or more of the following: Bender, Chesnais, Wactlar, Reimer,
2 Nielsen book, Nielsen patent, Wolfe, Yuasa, Iwayama, Masand, Cavnar, Salton book,
3 Salton article, Buckley and Herz.
- 4 15. Reilly in view of one or more of the following: Bender, Chesnais, Taniguchi, Drummond,
5 Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen patent,
6 Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.
- 7 16. Hidary in view of one or more of the following: Bender, Chesnais, Taniguchi,
8 Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen
9 patent, Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.
- 10 17. Wactlar in view of one or more of the following: Wolfe, Bender, Chesnais, Yuasa,
11 Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
- 12 18. Matthews in view of one or more of the following: Wolfe, Bender, Chesnais, Yuasa,
13 Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
- 14 19. Reimer in view of one or more of the following: Wolfe, Bender, Chesnais, Yuasa,
15 Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
- 16 20. Florin in view of one or more of the following: Wolfe, Bender, Chesnais, Yuasa,
17 Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
- 18 21. Nielsen in view of one or more of the following: Wolfe, Bender, Chesnais, Yuasa,
19 Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
- 20 22. Brown in view of one or more of the following: Wolfe, Bender, Chesnais, Yuasa,
21 Iwayama, Masand, Cavnar, Salton book, Salton article, Buckley and Herz.
- 22 23. Kindermann in view of one or more of the following: Bender, Chesnais, Taniguchi,
23 Drummond, Astle, Wactlar, Matthews, Reimer, Wolfe, Dimitrova, Nielsen book, Nielsen
24 patent, Kaplan, Iwayama, Masand, Yuasa, Salton book, Salton article, Herz, and Buckley.

25 **C. Invalidity Under 35 U.S.C. § 112**

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

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

4 All asserted claims of the '507 Patent violate the requirements of Section 112, ¶ 2, and all
5 asserted claims fail to satisfy the enablement and written description requirements of Section 112,
6 ¶ 1.

7 **1. Legal Background Regarding**
8 **Indefiniteness, Enablement, and Written Disclosure**

9 Section 112 includes a definiteness requirement. *See* 35 U.S.C. § 112(2) (“[T]he
10 specification shall conclude with one or more claims particularly pointing out and distinctly
11 claiming the subject matter which the applicant regards as his invention.”). When claims are “not
12 amenable to construction” or “insolubly ambiguous,” they are indefinite. *Young v. Lumenis, Inc.*,
13 497 F.3d 1336, 1346 (Fed. Cir. 2007).

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

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

1 *Inc. v. M-I LLC*, 514 F.3d 1244 (Fed. Cir. 2008). Claim limitations that lack a definite scope and
2 include aspects that are inherently subjective are also indefinite under 35 U.S.C. § 112(2).

3 *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350-52 (Fed. Cir. 2005) (affirming
4 holding that the claim term “aesthetically pleasing” was indefinite because “the scope of claim
5 language cannot depend solely on the unrestrained, subjective opinion of a particular individual
6 purportedly practicing the invention”).

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

18 A patent claim reciting a function without using the term “means” is still subject to
19 Section 112(6) if “the claim term fails to recite sufficiently definite structure or else recites
20 function without reciting sufficient structure for performing that function.” *Massachusetts Inst. of*
21 *Tech. and Elecs. for Imaging, Inc. v. Abacus Software*, 462 F.3d 1344, 1353 (Fed. Cir. 2006)
22 (internal quotations and citations omitted); *see also, e.g., Welker Bearing Co. v. PHD, Inc.*, 550
23 F.3d 1090, 1096 (Fed. Cir. 2008) (ruling claim limitation reciting “a mechanism for moving ...”
24 was a means-plus-function limitation despite not including the word “means” because “no
25 adjective endows the claimed ‘mechanism’ with a physical or structural component”); *Inventio*
26 *AG v. ThyssenKrupp Elevator Americas Corp.*, 718 F. Supp. 2d 529, 558-59 (D. Del. 2010)
27 (holding claim term “computing unit” was a means-plus-function limitation because nothing in
28

1 the claim language provided sufficient structure for any of the functions performed by the
2 “computing unit”).

3 35 U.S.C. § 112 further includes an enablement requirement. *See* 35 U.S.C. § 112(1)
4 (“The specification shall contain a written description . . . of the manner and process of making
5 and using [the invention] in such full, clear, concise and exact terms as to enable any person
6 skilled in the art to which it pertains, or with which it is most nearly connected, to make and use
7 the same.”).

8 To satisfy the enablement requirement, the disclosure “must teach those skilled in the art
9 how to make and use the full scope of the claimed invention without ‘undue experimentation.’”
10 *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999 (Fed. Cir. 2008). Moreover, “[i]t is the
11 specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an
12 invention in order to constitute adequate enablement.” *Genentech, Inc. v. Novo Nordisk A/S*, 108
13 F.3d 1361, 1366 (Fed. Cir. 1997). “If, by following the steps set forth in the specification, one of
14 ordinary skill in the art is not able to replicate the claimed invention without undue
15 experimentation, the claim has not been enabled as required by 112, paragraph 1.” *National*
16 *Recovery Tech., Inc. v. Magnetic Separation Syst., Inc.*, 166 F.3d 1190 (Fed. Cir. 1990).
17 Similarly, if a specification teaches away from a substantial portion of the claim, or otherwise
18 does not enable the full scope of the claim, there is no enablement. *AK Steel Corp. v. Sollac*, 344
19 F.3d 1234 (Fed. Cir. 2003); *see also Alza Corp. v. Andrx Pharms.*, 603 F.3d 935, 940–43 (Fed.
20 Cir. 2010) (claims covering both non-osmotic and osmotic embodiments were invalid for the
21 patent’s failure to enable non-osmotic embodiments); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
22 999–1002 (Fed. Cir. 2008) (claims covering invention’s use with both movies and video games
23 were invalid for patent’s failure to enable the claimed “invention” in the context of movies);
24 *Automotive Techs. Int’l, Inc. v. BMW of N. Am., Inc.*, 501 F.3d 1274, 1281–85 (Fed. Cir. 2007)
25 (claims covering both mechanical and electronic sensors were invalid for patent’s failure to
26 enable electrical sensors); *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1377–80 (Fed.
27 Cir. 2007) (claims covering injectors with or without a pressure jacket were invalid for patent’s
28 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.

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

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

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

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

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

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

23 The claim term "body of information" is indefinite. For example, the patent does not
24 sufficiently explain criteria for distinguishing between a "body of information" versus "data
25 representing a body of information," or for distinguishing between one "body of information" and
26 another "body of information," or for distinguishing between a "body of information" and a
27 portion of a "body of information," or for distinguishing a "body of information" from
28

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

- 27 • “body of information”;
- 28 • “segment representing a defined set of information”;

- 1 • “determining the degree of similarity between the subject matter content of the
- 2 unclassified segment and the subject matter content of each of the previously
- 3 categorized segments”; and
- 4 • “identifying one or more of the previously categorized segments as relevant to the
- 5 unclassified segment based upon the determined degrees of similarity.”

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

- 8 • “determining the degree of similarity between the subject matter content of the
- 9 unclassified segment and the subject matter content of each of the previously
- 10 categorized segments”; and
- 11 • “identifying one or more of the previously categorized segments as relevant to the
- 12 unclassified segment based upon the determined degrees of similarity.”

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

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

27 Claim 82 and its asserted dependent claims are invalid for the same reasons as claim 39.
28

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

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

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

10 **III. THE '682 PATENT**

11 **A. Anticipation**

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

- 19 1. U.S. Patent No. 5,749,081 to Whiteis (filed April 6, 1995; issued May 5, 1998)
- 20 2. U.S. Patent No. 5,428,778 to Brookes (filed September 13, 1994; issued June 27,
21 1995)
- 22 3. U.S. Patent No. 5,724,567 to Rose et al. (filed April 25, 1994; issued March 3,
23 1998)
- 24 4. U.S. Patent No. 6,049,777 to Sheena et al. (filed March 14, 1997; issued April 11,
25 2000)
- 26 5. U.S. Patent No. 6,195,657 to Rucker et al. (filed September 25, 1997; issued
27 February 27, 2001)

1 6. U.S. Patent No. 6,385,619 to Eichstaedt et al. (filed January 8, 1999; issued May 7,
2 2002)

3 7. U.S. Patent No. 7,082,407 to Bezos et al. (filed August 19, 1999²; issued July 25,
4 2006)

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

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

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

11 11. “Making Recommender Systems Work for Organizations,” published April 1999
12 by “Proceedings of PAAM ’99,” authored by Nathalie Glance, Damian Arregui, and Manfred
13 Dardenne.

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

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

26
27 _____
28 ² Bezos claims priority to an earlier-filed provisional application, U.S. Provisional Application
No. 60/128,557, filed on April 9, 1999.

1 14. Systems and methods invented, designed, developed and/or in public use or on
2 sale related to SiteSeer, as exemplified by “SiteSeer: Personalized Navigation for the Web” and
3 U.S. Patent No. 6,195,657 to Rucker et al., 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 March 31, 1997, and may have been in public use or on
6 sale on or before March 31, 1997 by Imana, Inc.

7 15. Systems and methods invented, designed, developed and/or in public use or on
8 sale related to Knowledge Pump, as exemplified by “Making Recommender Systems Work for
9 Organizations” and “Knowledge Pump: Community-centered Collaborative Filtering,” and
10 subject to further discovery. Based upon information currently available to Defendants,
11 Defendants believe that such a system was designed and developed at least before October 2,
12 1997, and may have been in public use or on sale on or before October 2, 1997 by Xerox Corp.

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

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

25 **B. Obviousness**

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

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

- 4 1. "Knowledge Pump: Community-centered Collaborative Filtering," published
5 October 27, 1997, authored by Natalie Glance, Damian Arregui, and Manfred
6 Dardenne.
- 7 2. Microstrategy, Inc., "MicroStrategy Launches Strategy.com, the World's First
8 Personal Intelligence Network," press release dated June 28, 1999
- 9 3. U.S. Patent No. 7,181,417 to Langseth et al. (filed January 21, 2000, issued
10 February 20, 2007
- 11 4. "webCobra: An Automated Collaborative Filtering Agent System for the World
12 Wide Web," published December 5, 1997, authored by Steve Nesbitt.
- 13 5. U.S. Patent No. 6,078,740 to DeTreville et al. (filed November 4, 1996; issued
14 June 20, 2000)
- 15 6. Systems and methods invented, designed, developed and/or in public use or on
16 sale related to MicroStrategy Broadcaster, as exemplified by U.S. Patent No.
17 7,181,417 to Langseth et al. and/or to "Strategy.com," and subject to further
18 discovery. Based upon information currently available to Defendants, Defendants
19 believe that such a system was designed and developed at least before June 28,
20 1999, and may have been in public use or on sale on or before June 28, 1999 by
21 Microstrategy, Inc.
- 22 7. U.S. Patent No. 6,807,558 to Hassett et al. (filed June 2, 1998; issued October 19,
23 2004)
- 24 8. U.S. Patent No. 7,209,942 to Hori et al, (filed December 23, 1999; issued April 24,
25 2007)

26 Each prior art reference and system (collectively for this subsection, "references")
27 disclosed in the preceding Anticipation section and in this Obviousness section, either alone or in
28

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

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

7 Because the '682 Patent simply arranges old elements with each performing the same
8 function it had been known to perform and yields no more than what one would expect from such
9 an arrangement, the combination is obvious. Further, in the prior art, there were well-recognized
10 design needs and market pressures to alert users to items of current interest. Such design needs
11 and market pressures provided ample reason to combine the prior art elements. *KSR*, 127 S. Ct. at
12 1742. Moreover, since there were a finite number of predictable solutions, a person of ordinary
13 skill in the art had good reason to pursue the known options. *Id.* The '682 Patent merely uses
14 those familiar elements for their primary or well-known purposes in a manner well within the
15 ordinary level of skill in the art. Accordingly, common sense and knowledge of the prior art
16 render the asserted claims of the '682 Patent invalid under either § 102 and/or § 103.

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

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

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

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

13 1. U.S. Patent No. 5,749,081 to Whiteis in view of one or more of the following:

- 14 • U.S. Patent No. 6,049,777 to Sheena et al.
- 15 • U.S. Patent No. 6,195,657 to Rucker et al.
- 16 • U.S. Patent No. 7,082,407 to Bezos et al.
- 17 • U.S. Patent No. 7,181,417 to Langseth et al.
- 18 • "MicroStrategy Launches Strategy.com, the World's First Personal
19 Intelligence Network"
- 20 • U.S. Patent No. 6,807,558 to Hassett et al.
- 21 • U.S. Patent No. 7,209,942 to Hori et al,

22 2. U.S. Patent No. 5,428,778 to Brookes, in view of one or more of the following:

- 23 • U.S. Patent No. 6,049,777 to Sheena et al.
- 24 • U.S. Patent No. 5,724,567 to Rose et al.
- 25 • U.S. Patent No. 7,181,417 to Langseth et al.
- 26 • "MicroStrategy Launches Strategy.com, the World's First Personal
27 Intelligence Network"

28 3. U.S. Patent No. 5,724,567 to Rose et al., in view of one or more of the following:

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

8 4. U.S. Patent No. 6,078,740 to DeTreville et al. in view of one or more of the
9 following:

- 10 • U.S. Patent No. 6,049,777 to Sheena et al.
- 11 • U.S. Patent No. 7,082,407 to Bezos et al.
- 12 • U.S. Patent No. 7,181,417 to Langseth et al.
- 13 • “MicroStrategy Launches Strategy.com, the World's First Personal
- 14 Intelligence Network”

15 5. U.S. Patent No. 6,049,777 to Sheena et al. in view of one or more of the following:

- 16 • U.S. Patent No. 5,724,567 to Rose et al.
- 17 • U.S. Patent No. 7,082,407 to Bezos et al.
- 18 • U.S. Patent No. 7,181,417 to Langseth et al.
- 19 • “MicroStrategy Launches Strategy.com, the World's First Personal
- 20 Intelligence Network”
- 21 • U.S. Patent No. 6,807,558 to Hassett et al.
- 22 • U.S. Patent No. 7,209,942 to Hori et al,

23 6. U.S. Patent No. 6,195,657 to Rucker et al. in view of one or more of the
24 following:

- 25 • U.S. Patent No. 5,724,567 to Rose et al.
- 26 • “Sitereer: Personalized Navigation for the Web”
- 27 • U.S. Patent No. 7,181,417 to Langseth et al.
- 28 • “MicroStrategy Launches Strategy.com, the World's First Personal

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

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

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

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

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

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

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Intelligence Network”

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

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

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

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

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

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

C. Invalidity Under 35 U.S.C. § 112

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

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

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

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

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

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

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

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

5 To the extent that this claim term is read to cover indications that something as a whole is
6 of interest, rather than a portion presently being viewed is of interest, this renders the asserted
7 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 include
9 content that is not dynamically changing in “real-time,” such as recorded content any portion of
10 which can be accessed at any time, this renders the asserted claims invalid under all Sec. 112
11 requirements discussed above.

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

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

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

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

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

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

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

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

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

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

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

22 The claim language "an indication that an item ... is of current interest" renders the
23 asserted claims invalid under all Sec. 112 requirements discussed above. To the extent that the
24 claims are read to include indications of interest in an item as a whole, a topic generally, or as
25 otherwise distinct from an indication of interest in a particular currently playing content feature
26 (e.g., scene) of the item (e.g., rhinos appearing at the watering hole), this renders the asserted
27 claims invalid under all Sec. 112 requirements discussed above.
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1 To the extent that the claims or this claim language are read to include a user indicating
2 her rating or level of interest in something, this renders the asserted claims invalid under all
3 Sec. 112 requirements discussed above.

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

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

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

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

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

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

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

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

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

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

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

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

25 There is no support in the patent for an “intensity rank indicating the level of current
26 interest of the item relative to other items.” For example, an “intensity rank” may be calculated
27 even when there is only one item for which alerts have been received. The recited “intensity
28

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

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

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

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

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

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

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

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

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

9 **IV. THE ’652 PATENT**

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

12 **V. THE ’314 PATENT**

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

15 **VI. ACCOMPANYING DOCUMENT PRODUCTION**

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

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

25 DATED this 28th day of February 2011.

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I certify that, on this 28th day of February, 2011, I caused to be served via e-mail Defendants' Invalidation Contentions on all counsel who have appeared in this action:

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