IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ARENDI S.A.R.L., Plaintiff, v. GOOGLE LLC, Defendant.	)	C.A. No. 13-919-LPS
ARENDI S.A.R.L., Plaintiff, v. OATH HOLDINGS INC. and OATH INC., Defendants.	)	C.A. No. 13-920-LPS

DEFENDANTS GOOGLE LLC'S, OATH HOLDINGS INC.'S AND OATH INC.'S RESPONSIVE CLAIM CONSTRUCTION BRIEF REGARDING CLAIM TERMS PARTICULAR TO US PATENT NO. 7,496,854

David E. Moore (#3983)
Bindu A. Palapura (#5370)
Stephanie E. O'Byrne (#4446)
POTTER ANDERSON & CARROON LLP
Hercules Plaza, 6th Floor
1313 N. Market Street
Wilmington, DE 19801s
(302) 984-6000
dmoore@potteranderson.com
bpalapura@potteranderson.com

Attorneys for Defendant Google LLC

Jack B. Blumenfeld (#1014)
Anthony Raucci (#5948)
MORRIS, NICHOLS,
ARSHT & TUNNEL LLP
1201 North Market Street
Wilmington, DE 19801
(302) 658-9200
jblumenfeld@mnat.com
araucci@mnat.com

Attorneys for Defendants
Oath Holdings Inc. and Oath Inc.

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6312701

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Defendants Google LLC ("Google"), Oath Holdings Inc., and Oath Inc. (together "Oath") file this brief in response to Arendi's Opening Claim Construction Brief Addressing U.S. Patent Nos. 7,496,854 ("'854 Patent") and 7,921,356 ("'356 Patent").[1]

I. INTRODUCTION

A. The Law of Indefiniteness

The Federal Circuit has made clear that for a computer-related means-plus-function limitation, the knowledge or skill-set of a person of ordinary skill in the art does not, and cannot, compensate for a patent specification's failure *explicitly* to include and describe an algorithm for programming a computer to accomplish the specified function. *See Blackboard, Inc. v. Desire2Learn*, 574 F.3d 1371, 1385 (Fed. Cir. 2009) ("A patentee cannot avoid providing specificity as to structure simply because someone of ordinary skill in the art would be able to devise a means to perform the claimed function."); *Atmel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1380 (Fed. Cir. 1999) ("[C]onsideration of the understanding of one skilled in the art in no way relieves the patentee of adequately disclosing sufficient structure in the specification.") As a matter of law, merely reciting the claimed function (or desired result) in a claim and in the specification (e.g., analyze document text to identify contact information without user intervention) does not suffice as the disclosure of an algorithm, which, by definition, must contain a sequence of explicitly defined steps. *See Blackboard,* 574 F.3d at 1384 (finding patent disclosure insufficient as it described only outcome of the function to be performed, but not means for achieving that outcome); *Noah Sys. Inc. v. Intuit Inc.*, 675 F.3d 1302, 1317 (Fed. Cir. 2012)

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[1] Because the lone, disputed '356 claim term – "providing an input device configured by the document editing program" ('356 Patent, claims 1, 12) – is virtually identical to the '843 claim term – "providing an input device configured by the first computer program" ('843 Patent, claims 1, 23) – Google and Oath address these terms together in Defendants' responsive brief regarding the '843 and '993 Patents.

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(rejecting argument that undisclosed algorithm was "in the common ken" of a skilled artisan).

In direct contravention of the Federal Circuit's clear mandate, Arendi does not point to any explicitly disclosed algorithms in the specification of U.S. Patent No. 7,496,854 ("the '854 Patent"), but, instead, argues repeatedly that a person of ordinary skill in the art ("POSITA") would understand the scope of the challenged means-plus-function terms of the '854 Patent, or be capable of *devising* a necessary algorithm using their technical knowledge. (*See, e.g.,* "[a] person of ordinary skill would just as readily understand the scope of this claim term as she would 'means for searching.'" D.I. 119 at 5; "'[i]nserting information into an electronic document, based on user selection or otherwise, is a basic form of data transfer that a person of ordinary skill in the art would readily recognize and understand;" D.I. 119 at 10; "a person of ordinary skill in the art would understand how to employ rudimentary programming techniques to initialize the second application based on these inputs;" D.I. 119 at 13; "a person of ordinary skill in the art would appreciate the scope of 'associated' as provided by the claims." D.I. 119 at 15.) Arendi's analysis thus improperly "conflates the definiteness requirement of section 112, paragraphs 2 and 6, and the enablement requirement of section 112, paragraph 1." *EON Corp. IP Holdings LLC v. AT&T Mobility LLC,* 785 F.3d 616, 624 (Fed. Cir. 2015), *quoting Blackboard*, 574 F.3d at 1385.

Unlike the enablement requirement (which focuses on whether a POSITA can make and use a claimed invention), a section 112 ¶ 6 disclosure serves the very different purpose of limiting a claim's scope to the particular structure and/or algorithm explicitly disclosed in the patent specification, together with its equivalents. *EON*, 521 F.3d at 1336 ("[t]he question before us is whether the specification contains a sufficiently precise description of the 'corresponding structure' to satisfy section 112, paragraph 6, not whether a person of skill in the art could devise some means to carry out the recited function.") By repeatedly resorting to a POSITA's knowledge

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