

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF ILLINOIS

OCEAN TOMO, LLC,

Plaintiff-Counter Defendant,

v.

JONATHAN BARNEY and  
PATENTRATINGS, LLC,

Defendants-Counter Plaintiffs.

No. 12 C 8450

Judge: Joan B. Gottschall

Magistrate: Judge Mary M. Rowland

**PLAINTIFF-COUNTER DEFENDANT'S MEMORANDUM IN SUPPORT OF ITS  
MOTION FOR SUMMARY JUDGMENT OF INVALIDITY UNDER 35 U.S.C. § 101**

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Plaintiff-Counter Defendant Ocean Tomo, LLC (“OT”), in support of its Motion for Summary Judgment of Invalidity under 35 U.S.C. § 101, hereby presents its memorandum in support thereof. Defendant-Counter Plaintiff PatentRatings’ (“PR”) U.S. Patent Nos. 6,556,992 (the “992 Patent”), 7,962,511 (the “511 Patent”), 7,716,226 (the “226 Patent”), 8,504,560 (the “560 Patent”), 7,949,581 (the “581 Patent”), 7,657,476 (the “476 Patent”), 8,131,701 (the “701 Patent”) and 8,818,996 (the “996 Patent”) (collectively, the “patents-in-suit”) are each invalid under 35 U.S.C. § 101 as they do not claim patentable subject matter. In particular, and under the Supreme Court’s recent holding in *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014), the claims of the patents-in-suit are directed to abstract *ideas* that are not entitled to protection under the patent statutes.

## INTRODUCTION

This action arises out of a soured business relationship between OT, on the one hand, and PR and Barney, on the other hand. OT, the leading Intellectual Capital Merchant Banc firm, provides, among other things, financial products and services related to expert testimony, valuation, investments, risk management and transactions throughout the United States and overseas. Barney created PR, a company that owns and develops computer-generated metrics that can be used to help determine the quality and relevance of issued United States patents. As detailed below, the algorithm underlying these metrics has been issued a number of patents by the United States Patent and Trademark Office and is used to assess the quality and relative value of patent portfolios.

In approximately 2004, OT and PR entered into a License Agreement pursuant to which, among other things, PR licensed to OT the right to use PR’s patented technology in order to determine the quality and relevance of patents for certain of OT’s clients. As part of the business relationship, Barney became a Member of OT, and OT became a Member of PR. Over the years,

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