

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

_____)	
WORLDS, INC.,)	
)	
Plaintiff)	
)	
v.)	
)	Civil Action No. 12-10576-DJC
ACTIVISION BLIZZARD, INC.,)	
BLIZZARD ENTERTAINMENT, INC. and)	
ACTIVISION PUBLISHING, INC.,)	
)	
Defendants.)	
_____)	

MEMORANDUM AND ORDER

CASPER, J.

March 13, 2014

I. Introduction

In this patent dispute, Plaintiff Worlds, Inc., (“Worlds”) alleges that Activision Blizzard, Inc., Blizzard Entertainment, Inc. and Activision Publishing, Inc. (collectively, “Defendants”) infringe United States Patents Nos. 7,181,690 (“‘690”), 7,493,558 (“‘558”), 7,945,856 (“‘856”), 8,082,501 (“‘501”) and 8,145,998 (“‘998”) (collectively, the “Patents-In-Suit”). The Defendants have filed a motion for summary judgment seeking a ruling that all of the asserted claims in the Patents-In-Suit are invalid. D. 83. For the following reasons, the Court **ALLOWS** the Defendants’ motion.

II. Factual Background

A. Patents-in-Suit

This lawsuit involves patents that teach an invention enabling large numbers of computer users to interact over a client-server network in a “virtual world” displayed on a computer screen. D. 62-2, 62-3, 62-4, 62-5, 62-6. Plaintiff Worlds alleges that the Defendants infringe the

following patent claims: ‘690 claims 1-20; ‘558 claims 4-9; ‘856 claim 1; ‘501 claims 1-8, 10, 12, 14-16; ‘998 claims 1-3, 7, 8, 11-20.¹ ¶ 1. Worlds asserts that the Patents-In-Suit are entitled to an effective filing date of November 13, 1995, which is the filing date of U.S. Provisional Application No. 60/020,296 (“the Provisional Application”). ¶ 2. All of the Patents-in-Suit reference U.S. Patent No. 6,219,045 (“the ‘045 patent”). ¶¶ 7, 13, 16, 19, 22. The ‘045 patent was filed on November 12, 1996 and issued on April 17, 2001. ¶ 8. The ‘045 patent does not claim priority to any earlier filed application and does not contain any reference to the Provisional Application. ¶¶ 9-11. The ‘045 patent is not asserted in this action. ¶ 7.

The ‘690 patent was filed on August 3, 2000 and issued on February 20, 2007. ¶ 3. The ‘690 patent does not contain any reference to the Provisional Application. ¶ 6. The ‘690 patent states that it is a “[c]ontinuation of application No. 08/747,420, filed on Nov. 12, 1996, now Pat. No. 6,219,045,” i.e., the ‘045 patent not asserted in this action. ¶ 7.

The ‘558 patent was filed on November 2, 2006 and issued on February 17, 2009. ¶ 12. The ‘558 patent states that it is a “[c]ontinuation of application No. 09/632,154, filed on Aug. 3, 2000, now Pat. No. 7,181,690, which is a continuation of application No. 08/747,420, filed on Nov. 12, 1996, now Pat. No. 6,219,045.” ¶ 13. Unlike the ‘045 or ‘690 patents, the first sentence of the specification of the ‘558 patent states: “This application . . . claims priority from provisional application No. 60/020,296, filed Nov. 13, 1995.” ¶ 14.

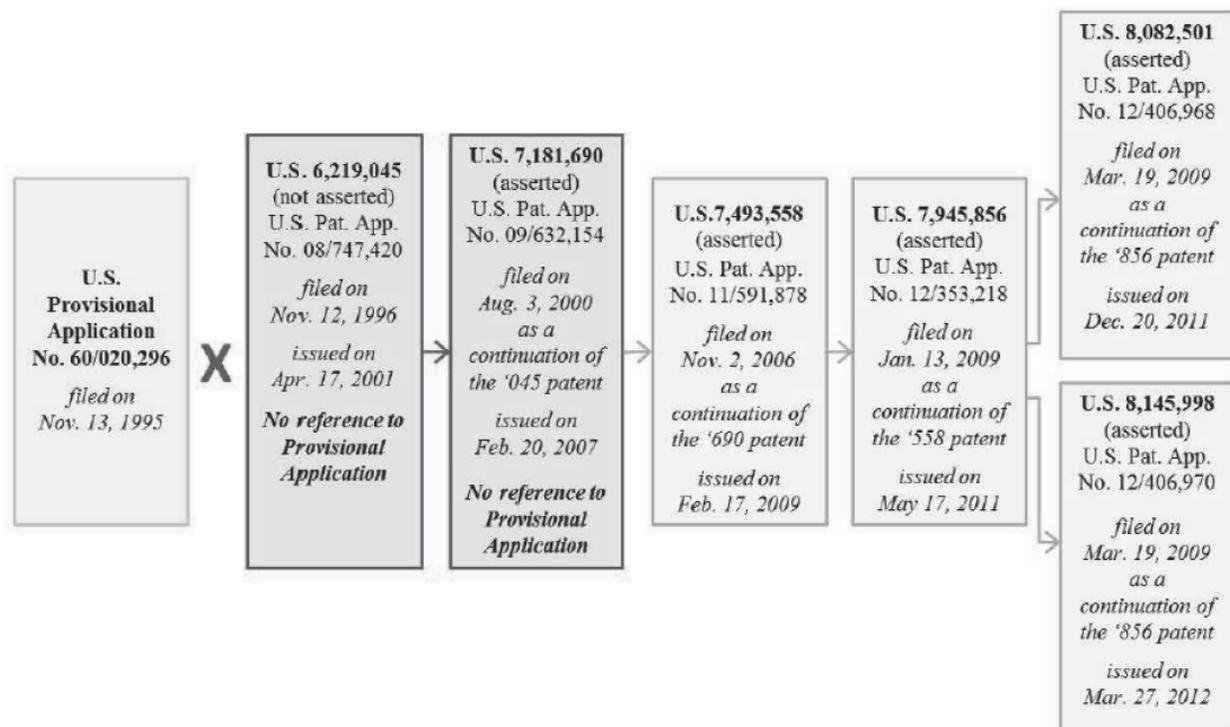
¹ Unless otherwise noted, all references are to the Defendants’ statement of facts, D. 85. “Worlds does not dispute the facts set forth in Defendants’ Statement of Undisputed Material Facts.” Pl. Opp., D. 89 at 8 n.2. Worlds asserts additional facts in its opposition to summary judgment. D. 89 at 8-13. Many of these facts recite public documents found in the prosecution histories of the ‘045 and ‘690 patents and the authenticity of these documents are not contested. To the extent that Worlds introduces new facts beyond these public documents, the Court finds no genuine dispute of material fact that prevents an award of summary judgment as a matter of law.

The '856 patent was filed on January 13, 2009 and issued on May 17, 2011. ¶ 15. The '856 patent states that it is a "[c]ontinuation of application No. 11/591,878, filed on Nov. 2, 2006, now Pat. No. 7,493,558, which is a continuation of application No. 09/632,154, filed on Aug. 3, 2000, now Pat. No. 7,181,690, which is a continuation of application No. 08/747,420, filed on Nov. 12, 1996, now Pat. No. 6,219,045." ¶ 16. The first sentence of the specification of the '856 patent states: "This application . . . claims priority from U.S. provisional patent application No. 60/020,296, filed Nov. 13, 1995." ¶ 17.

The '501 patent was filed on March 19, 2009 and issued on December 20, 2011. ¶ 18. The '501 patent states that it is a "[c]ontinuation of application No. 12/353,218, filed on Jan. 13, 2009, now Pat. No. 7,945,856, which is a continuation of application No. 11/591,878, filed on Nov. 2, 2006, now Pat. No. 7,493,558, which is a continuation of application No. 09/632,154, filed on Aug. 3, 2000, now Pat. No. 7,181,690, which is a continuation of application No. 08/747,420, filed on Nov. 12, 1996, now Pat. No. 6,219,045." ¶ 19. The first sentence of the specification of the '501 patent states: "This application . . . claims priority from U.S. Provisional patent application Ser. No. 60/020,296, filed Nov. 13, 1995." ¶ 20.

The '998 patent was filed on March 19, 2009 and issued on March 27, 2012. ¶ 21. The '998 patent states that it is a "[c]ontinuation of application No. 12/353,218, filed on Jan. 13, 2009, which is a continuation of application No. 11/591,878, filed on Nov. 2, 2006, now Pat. No. 7,493,558, which is a continuation of application No. 09/632,154, filed on Aug. 3, 2000, now Pat. No. 7,181,690, which is a continuation of application No. 08/747,420, filed on Nov. 12, 1996, now Pat. No. 6,219,045." ¶ 22. The first sentence of the specification of the '998 patent states: "This application . . . claims priority from U.S. Provisional Patent Application Ser. No. 60/020,296, filed Nov. 13, 1995." ¶ 23.

To illustrate the relation of these patents, the Court reproduces here a graphic found in the Defendants' memorandum supporting summary judgment, D. 84 at 5:



Although Worlds does not dispute these facts, D. 89 at 8 n.2, Worlds cites three examples where the Provisional Application is mentioned in documents that are part of the '045 patent's prosecution history: (1) an application transmittal letter, D. 89-10 at 4; (2) the inventors' declarations, D. 89-10 at 42-47; and (3) a request for corrected filing receipt, D. 89-10 at 48. The application transmittal letter and the inventors' declarations were filed in 1996 and cite the correct Provisional Application serial number but incorrectly list the Provisional Application's filing date as June 24, 1996. D. 89-10 at 4, 42-52. The request for a corrected filing receipt was filed on August 18, 2000 and identifies the correct serial number and filing date for the Provisional Application. *Id.*²

² Worlds also cites several documents in the prosecution history of the '690 patent that mention the Provisional Application. D. 89 at 11-12.

Worlds further submits a screen-shot of a public website operated by the United States Patent and Trademark Office (“USPTO”) indicating that according to the website the ‘045 patent claims priority to the Provisional Application. D. 89 at 11. Worlds also states that on July 5, 2013, it requested that the USPTO issue certificates of correction “to include references to the 1995 provisional application on the front pages of the ‘045 and ‘690 patents and at the beginning of their specifications.” D. 89 at 12-13. The USPTO granted these requests on September 24, 2013. D. 107 at 1.

B. Invention Reduced to Practice

In 1995, Worlds created two software products called Worlds Chat and AlphaWorld. Worlds Chat was first demonstrated and publically released in April 1995. ¶¶ 31-32. Worlds Chat embodied all of the asserted claims of the Patents-in-Suit at least as early as April 1995. ¶ 37. AlphaWorld was first demonstrated in June 1995 and was released on approximately June 29, 1995. ¶¶ 24-25. At least as of September 1995, AlphaWorld practiced all of the asserted claims of the Patents-In-Suit and subsequent versions of AlphaWorld also practiced the asserted claims. ¶ 27. Thus, AlphaWorld and Worlds Chat practiced all of the asserted claims of the Patents-In-Suit and were in public use more than one year before November 12, 1996, which is the filing date of the ‘045 patent. ¶¶ 33-34; see also D. 89 at 8.

III. Standard of Review

The Court will grant a moving party’s motion for summary judgment when there is no genuine dispute of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A dispute is genuine if “the evidence about the fact is such that a reasonable jury could resolve the point in favor of the nonmoving party,” Vélez-Rivera v. Agosto-Alicea, 437 F.3d 145, 150 (1st Cir. 2006) (quoting United States v. One Parcel of Real

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