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10 ON2 TECHNOLOGIES, INC.

11 **UNITED STATES DISTRICT COURT**
12 **NORTHERN DISTRICT OF CALIFORNIA**
13 **SAN JOSE DIVISION**

14 MAX SOUND CORPORATION and
VEDANTI SYSTEMS LIMITED,

15 Plaintiffs,

16 v.

17 GOOGLE INC., YOUTUBE, LLC, and ON2
18 TECHNOLOGIES, INC.,

19 Defendants.

Case No. 5:14-cv-04412-EJD

**DEFENDANTS GOOGLE INC.,
YOUTUBE, LLC, AND ON2
TECHNOLOGIES, INC.'S MOTION TO
DISMISS FOR FAILURE TO STATE A
CLAIM**

Date: April 30, 2015

Time: 9:00 am

Place: Courtroom 4, 5th Floor

Judge: Honorable Edward J. Davila

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3	Plaintiff Max Sound Corporation	Max Sound or Plaintiff
4	Patent Owner Vedanti Systems Limited	VSL
5	Defendant Google Inc.	Google
6	Defendant YouTube, LLC	YouTube
7	Defendant On2 Technologies, Inc.	On2
8	Defendants Google, YouTube, and On2, collectively	Defendants
9	U.S. Patent No. 7,974,339	'339 patent or asserted patent
10	United States Patent and Trademark Office	PTO
11	Declaration of Jennifer J. Schmidt in Support of Defendants' Motion to Dismiss	Schmidt Decl.
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13	First Amended Complaint, (Dkt. No. 23)	Amended Complaint
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NOTICE OF MOTION AND MOTION

TO ALL PARTIES AND THEIR COUNSEL OF RECORD:

PLEASE TAKE NOTICE that on April 30, 2015, at 9:00 a.m., or as soon thereafter as the matter may be heard in courtroom of the Honorable Edward J. Davila, located at Courtroom 4, Fifth Floor, of the United States District Court for the Northern District of California, San Jose Division, Defendants will and hereby do move the Court for entry of an order dismissing this action pursuant to Federal Rule of Civil Procedure 12(b)(6).

This motion is based on this notice of motion and motion, the supporting memorandum of points and authorities, the accompanying Schmidt Decl., including exhibits,¹ and such additional evidence and arguments as may hereinafter be presented.

MEMORANDUM OF POINTS AND AUTHORITIES**I. INTRODUCTION**

Amendments impacting all claims of the '339 patent were made during prosecution, but are not reflected in the issued claims that form the basis for this litigation. The claims of the '339 patent are, therefore, invalid as indefinite under 35 U.S.C. § 112(2) for failure to claim what the inventors regard as their invention, and the Amended Complaint should be dismissed.

35 U.S.C. § 112(2) requires that each claim of a patent must set forth what the patent applicants regarded as their invention. The Federal Circuit has held that, when a transcription error renders an issued claim different than an allowed claim, the claim is invalid as indefinite for failure to specifically claim what the inventor regards as his invention. *Grp. One Ltd. v. Hallmark Cards, Inc.*, 407 F.3d 1297, 1303 (Fed. Cir. 2005). Patentees have a duty to correct errors with a certificate of correction under 35 U.S.C. § 254, but a certificate of correction has no effect in litigation initiated before the certificate is issued. *Id.*

Here, the issued claims of the '339 patent are meaningfully different from the claims requested by the applicants and allowed during prosecution. When the PTO prepared the '339 patent for issuance, it made a transcription error that failed to address amendments entered by the examiner during prosecution and, therefore, omitted key language from the independent claims.

¹ All Exhibits referenced herein refer to Exhibits to the Schmidt Decl. filed concurrently herewith.

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