IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF OKLAHOMA

MILLER MENDEL, INC., a Washington Corporation; TYLER MILLER, an Oregon State resident,	))))	
Plaintiffs,	))	
vs.	))	Case No. <u>CIV-18-990-C</u>
THE CITY OF OKLAHOMA CITY, a municipal corporation,	)))	
Defendant.	))	

DEFENDANT THE CITY OF OKLAHOMA CITY'S
<u>NON-INFRINGEMENT AND INVALIDITY CONTENTIONS</u>

Defendant The City of Oklahoma City, pursuant to the Court's Revised Scheduling Order [Dkt. No. 36], provides these Non-Infringement and Invalidity Contentions to Plaintiffs Miller Mendel, Inc. and Tyler Miller. OKC's investigation is ongoing. Accordingly, OKC expressly reserves the right to modify, supplement, and otherwise amend these Non-Infringement and Invalidity Contentions as necessary as discovery progresses and following claim construction.

I.   INTRODUCTION

Based on Plaintiffs' Disclosure of Asserted Claims and Infringement Contentions ("Infringement Contentions"), served by Plaintiffs May 30, 2019, Plaintiffs assert the following patent and claims against OKC: U.S. Patent No. 10,043,188 ("the '188 Patent" or "the Asserted Patent"), Claims 1, 5, 9, and 15 (collectively "the Asserted Claims"). These Non-Infringement and Invalidity Contentions use the term "PHOSITA" to refer to a person having ordinary skill in the art to which the Asserted Patent pertains.

II. THE '188 PATENT

The '188 Patent (application no. 14/721,707 ("the '707 Application)) was filed May 26, 2015, as a continuation of Application No. 13/441,648 ("the '648 Application"), filed April 6, 2012, which issued as U.S. Patent No. 9,070,098 ("the '098 Patent").

In their Infringement Contentions, Plaintiffs allege they are entitled to claim priority to U.S. Provisional Application 61/472,556 ("the '556 Provisional Application"), which was filed April 6, 2011. However, the '188 Patent does not actually claim priority to the '556 Provisional Application (*see,* OKC-0000001). The Application Data Sheet (OKC-0000508-0000512) submitted with the '707 Application claims the benefit of only the '648 Application, not the '556 Provisional Application. (OKC-0000509). The USPTO's acknowledgement of receipt of the '707 Application, mailed June 3, 2015, also states that the '707 Application claimed priority only to the '648 Application. (OKC-0000408). During prosecution of the '707 Application, Miller did not file a Supplemental Application Data Sheet (or anything else) to establish his priority claim to the '556 Provisional Application as required by USPTO Regulations. Thus, the priority date for the '188 Patent is no earlier than April 6, 2012, not April 6, 2011, as alleged in Plaintiffs' Infringement Contentions.

III. OKC'S NON-INFRINGEMENT CONTENTIONS AND CHARTS

Pursuant to the Court's Revised Scheduling Order [Dkt. No. 36], OKC provides its Non-Infringement Contention charts for each of the Asserted Claims. *See* Exhibit 1. OKC's Non-Infringement Contentions, positions, and charts are based on Plaintiffs' proposed constructions, as provided with their Infringement Contentions. OKC bases its non-

infringement contentions and positions on those constructions without conceding in any way that those constructions are correct, and instead expressly reserves the right to oppose those constructions at the time specified in the Court's Revised Scheduling Order [Dkt. No. 36]. *See*, **VI. Other Reservations and Explanations**, *infra*.

As shown in its non-infringement charts, OKC asserts it does not infringe any of the Asserted Claims, which are all independent claims and, therefore, cannot infringe any dependent claim depending therefrom. *See, e.g. Monsanto Co. v. Syngenta Seeds, Inc.*, 503 F.3d 1352, 1359 (Fed. Cir. 2007). OKC expressly reserves the right to amend its non-infringement contentions and charts.

IV. OKC'S INVALIDITY CONTENTIONS AND CHARTS

Pursuant to the Court's Revised Scheduling Order [Dkt. No. 36], OKC identifies the following prior art now known to OKC to anticipate and/or render obvious at least one of the Asserted Claims under at least 35 U.S.C. §§ 102 and 103, either expressly or inherently as would have been understood by a PHOSITA at the time of the invention. The following patents, publications, and systems are prior art under at least 35 U.S.C. §§ 102 and 103. Invalidity claims charts for these references with respect to the '188 Patent are attached as Exhibits 2 through 7.

A. Prior Art Patents and Publications

1. U.S. Patent No. 6,714,944, "System and Method for Authenticating and Registering Personal Background Data," filed December 23, 1999, issued March 30, 2004 ("Shapiro");

2. U.S. Patent No. 6,904,407, "Repository for Jobseekers' References on the Internet," filed September 24, 2001, issued June 7, 2005 ("Ritzel");

3. U.S. Patent No. 7,080,057, "Electronic Employee Selection Systems and Methods," filed August 2, 2001, issued July 18, 2006 ("Scarborough");

4. U.S. Patent No. 7,136,865, "Method and Apparatus to Build and Manage a Logical Structure Using Templates," filed April 8, 2002, issued November 14, 2006 ("Ra");

5. U.S. Patent No. 7,155,400, "Universal Task Management System, Method and Product for Automatically Managing Remote Workers, Including Automatically Recruiting Workers," filed November 14, 2001, issued December 26, 2006 ("Jilk");

6. U.S. Patent No. 7,246,067, "Secure Online Dating Support System and Method," filed March 20, 2003, issued July 27, 2007 ("Austin");

7. U.S. Patent No. 7,346,541, "System, Method and Computer Readable Medium for Acquiring and Analyzing Personal History Information," filed August 14, 2000, issued March 18, 2008 ("Cuttler");

8. U.S. Patent No. 8,799,243, "System and Method Providing for Regulatory Compliance," filed October 25, 2006, issued August 5, 2014 ("Havlik");

9. U.S. Patent No. 8,842,156, "Unified Interactive Video Kiosk for Information Management and Method for the Same," filed June 28, 2013, issued September 23, 2014 ("Alekhin");

10. U.S. Patent No. 9,037,517, "Automation and Streamlining of Recruiting and Background Screening Via Bi-Directional Communication and Process Integration," filed January 30, 2007, issued May 19, 2015 ("Malnati");

11. U.S. Patent Pub. No. 2003/0097342, "Method for Verifying Employment Data," filed January 24, 2000, published May 22, 2003 ("Whittingtom");

12. U.S. Patent Pub. No. 2003/0171927, "Method and System for Verifying or Certifying Traits of Candidates Seeking Employment," filed March 5, 2002, published September 11, 2003 ("Bernard");

13. U.S. Patent Pub. No. 2003/0208752, "Employee Candidate Computer and Web-Based Interactive Assessment Software and Method of Employee Candidate Assessment," filed May 3, 2002, published November 6, 2003 ("Farris");

14. U.S. Patent Pub. No. 2004/0053203, "System and Method for Evaluating Applicants," filed September 16, 2002, published March 18, 2004 ("Walters");

15. U.S. Patent Pub. No. 2004/0088173, "Interactive, Certified Background Check Business Method," filed October 31, 2002, published May 6, 2004 ("Mather");

16. U.S. Patent Pub. No. 2004/0230478, "Method and System for Streamlining Recruitment Process Through Independent Certification of Resumes," filed May 4, 2004, published November 18, 2004, and tracing priority to U.S. Provisional App. No. 60/471,374, filed May 15, 2003 ("Saxena");

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