2013-1282, -1283, -1284, -1285

United States Court of Appeals for the Federal Circuit

INTERVAL LICENSING LLC,
Plaintiff-Appellant,

v.

AOL, INC.,
Defendant-Appellee,

and

APPLE, INC.,
Defendant-Appellee,

and

GOOGLE, INC.,
Defendant-Appellee,

and

YAHOO! INC.,
Defendant-Appellee.

Appeal from the United States District Court for the Western District of Washington in consolidated case nos. 13-CV-0263, 13-CV-0264, 13-CV-0265, and13-CV-0266, Judge Marsha J. Pechman.

REPLY BRIEF FOR PLAINTIFF-APPELLANT INTERVAL LICENSING LLC

MICHAEL HEIM
NATHAN J. DAVIS
DOUGLAS R. WILSON
HEIM, PAYNE & CHORUSH LLP
600 Travis Street, Suite 6710
Houston, TX 77002
(713) 221-2000

JUSTIN A. NELSON
SUSMAN GODFREY L.L.P.
1201 Third Avenue, Suite 3800
Seattle, WA 98101
(206) 516-3880

THOMAS C. GOLDSTEIN
GOLDSTEIN & RUSSELL, PC
5225 Wisconsin Avenue, NW
Suite 404
Washington, DC 20015
(202) 887-4000

MAX L. TRIBBLE, JR.
SUSMAN GODFREY L.L.P.
1000 Louisiana Street, Suite 5100
Houston, TX 77002
(713) 653-7820

Counsel for Plaintiff-Appellant

October 11, 2013

CERTIFICATE OF INTEREST

Counsel for Interval Licensing LLC certifies the following:

I. The full name of every party or *amicus* represented by us is:

Interval Licensing LLC

II. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by us is:

None

III. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by us are:

None

IV. The names of all law firms and the partners or associates who appeared for the party now represented by us in the trial court or are expected to appear in this Court are:

Susman Godfrey LLP: Justin Nelson, Max Tribble, Edgar Sargent, Matthew Berry, Oleg Elkhunovich, Matthew Behncke, Andres Healy

Heim, Payne & Chorush LLP: Michael Heim, Douglas Wilson, Eric Enger, Nathan Davis, Niraj Patel, Robert Bullwinkel

Goldstein & Russell, PC: Thomas Goldstein

Dated: October 11, 2013

/s/ Justin A. Nelson
Justin A. Nelson
Counsel for Appellant

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INTRODUCTION

Long before constant web connectivity became a fact of life, the inventors of these patents anticipated and solved a critical problem. They determined how to funnel information to device users while also allowing their primary use of the device to continue unabated. The patents disclosing this invention resolve a multitude of technical issues—most of which are not at issue here—including acquiring information from diverse sources, resolving scheduling conflicts, and displaying notifications to users' peripheral attention without interrupting their primary interaction.

Defendants err in their attempts to invalidate or radically diminish the scope of the patents by refusing to acknowledge the concrete guidance they provide to skilled artisans. Defendants argue that the patents are indefinite when in fact, under this Court's settled standards, their common specification provides objective instructions for making an "unobtrusive" display. And they argue for claim constructions based on inapposite dictionaries or distant inferences that are inconsistent with the patents' plain terms. This Court should reverse the finding of indefiniteness, correct the District Court's claim construction errors, and remand.

ARGUMENT

I. Because The Specification Provides An Objective Definition Of "In An Unobtrusive Manner That Does Not Distract The User Of The Apparatus From A Primary Interaction With The Apparatus," The Term is Not Indefinite.

In asserting that the patents are indefinite, Defendants must satisfy "an exacting standard": to show, by "clear and convincing evidence," that the disputed terms claiming the display of images "in an unobtrusive manner" are "insolubly ambiguous," notwithstanding the specification's guidance. *Haemonetics Corp. v. Baxter Healthcare Corp.*, 607 F.3d 776, 783 (Fed. Cir. 2010). The District Court wrongly accepted Defendants' view that this standard is met whenever claim terms are "subjective." A11. That decision misreads this Court's precedents and, if affirmed, would invite indefiniteness challenges to every commonplace term incorporating human experience or a matter of degree.

This Court has repeatedly instructed that "[c]laim definiteness is analyzed 'not in a vacuum, but always in light of the teachings'" of the specification, *Energizer Holdings v. ITC*, 435 F.3d 1366, 1370 (Fed. Cir. 2006), which need only supply "*some standard* for measuring the scope of the [claims]," even when they are "subjective." *Datamize LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1351 (Fed. Cir. 2005) (emphasis added). Even then, a claim is "insolubly ambiguous" only if clear and convincing evidence shows that "reasonable efforts at claim construction prove *futile*," and "*no* narrowing construction can properly be

adopted," *Exxon Res. & Eng'g, Co. v. U.S.*, 265 F.3d 1371, 1375 (Fed. Cir. 2001) (emphasis added)—a standard this Court consistently enforces so as to "accord respect to the statutory presumption of patent validity, and … protect the inventive contribution of patentees, even when the drafting of their patents has been less than ideal." *Id.* The specification in this case supports Interval's construction and compares favorably to others the Court has deemed sufficiently definite.

A. Defendants Admit That "Subjective" Terms Must Be Read In Light Of The Specification

Echoing the District Court, *see* A12, Defendants occasionally suggest (at 30-34, 40-41) that because the concepts of "obtrusiveness" or "distraction" might vary from person to person if considered in the abstract, those terms are *per se* indefinite. (For ease of reading, we use "unobtrusive" as shorthand for the complete language claiming a "display in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus."). But even they ultimately acknowledge that regardless of the term's "subjectivity" in the abstract, they can prevail only if "the specification provides *no guidance* to one of ordinary skill on how … to determine whether an image is displayed in an 'unobtrusive manner.'" Defendants' Br. at 31 (emphasis added).

The best-chosen claim terms often must refer to "subjective" human experiences that are matters of degree. Many commonplace words have that feature, including several claim terms this Court has recently approved over

indefiniteness challenges. *See, e.g.*, *Deere & Co. v. Bush Hog, LLC*, 703 F.3d 1349, 1360 (Fed. Cir. 2012) ("easily" washed off); *Hearing Components v. Shure*, 600 F.3d 1357, 1367 (Fed. Cir. 2010) ("readily" replaced). Were such words off-limits, it would often be hard to write a patent anyone could read.

The definiteness or subjectivity of such claim terms without reference to the patent is irrelevant: "We have not insisted that claims be plain on their face in order to avoid condemnation for indefiniteness; rather, what we have asked is the claims be amenable to construction, however difficult that task may be." *Exxon*, 265 F.3d at 1375. The determinative question is "whether a person experienced in the field … would understand the scope of the claim when read in light of the specification," *Energizer*, 435 F.3d at 1369—specifically, whether the guidance and examples in the specification allow the terms to "be given *any* reasonable meaning," *Shure*, 600 F.3d at 1366-67 (emphasis added).

Defendants' most-cited case establishes this very point. In *Datamize*, this Court recognized that even "purely subjective" terms can be given a definite construction based on a specification that supplies "*some standard* for measuring the scope of the phrase." 417 F.3d at 1351 (emphasis added). Similarly, in attempting to distinguish *Deere* and *Shure* (at 35), Defendants themselves agree that subjective terms are definite if "the intrinsic record describe[s] structural features providing an objective boundary for the limitation."

Defendants make the same error in asserting (at 41-42) that Interval's construction would "read out" claim terms because an image could be displayed in unused space but sometimes still be "obtrusive" or "distracting" (in the abstract, colloquial sense) because of its content, typeface, or size. That argument ignores that the claim language is defined by the patents, and particularly the specification.[1]

Defendants miss the point of the invention in arguing (at 41-42) that images displayed in a spatially unobtrusive way might still be "obtrusive" or "distracting" in a colloquial sense, given how the user ultimately reacts to the display (including its content). An attention manager only works if it sometimes will distract a user in the abstract sense of that word—*i.e.*, by drawing the user's attention. An email from the nurse at a child's school or a long-lost relative might well be obtrusive (colloquially speaking), but the whole idea is to collect, schedule, and display such notifications in an area of the screen where the user can perceive them peripherally and attend to them *if necessary or desired* based on content. Accordingly, the spatial construction Interval proposes is not only the best supported by the specification, but also the most consistent with the invention's function of

[1] Accordingly, Defendants' hypothetical (at 42) with a picture of a large weather notification next to a word processor window is susceptible of an easy answer: Because the claims, as defined, look to whether the information overlaps with a user's primary interaction, whether information is subjectively distracting to some users is irrelevant.

presenting information on the periphery of the device. *See Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 899 (Fed. Cir. 2013).

Defendants also err in arguing (at 21-22, 32, 34) that notwithstanding the specification, their interpretation of unobtrusive is supported by deposition testimony they elicited from Interval's expert. They argue that he conceded that "obtrusiveness" might depend upon "infinite contexts"—making it indefinitely subjective. But the witness explained—over, A585, and over, A586, and over, A587, and over, A588, and several more times over again, A589—that he had not "formed an opinion with regards to the proper construction of the word 'unobtrusive'" *in the context of this patent* because he had not reviewed the intrinsic record to that end. *E.g.*, A585, at 111:16-22, 113:2-7. All he offered was what Defendants demanded: his speculation, "outside the context of this case," A587, at 123:4 (defense counsel's words), that many factors might contribute to the "obtrusiveness" of an image in the colloquial sense.

B. The Specification Ties The Claim Terms To The Wallpaper Embodiment, Which Renders Them Definite

As Interval's opening brief explained (at 10-12, 24-30), the patents teach that images are displayed "unobtrusively" when they appear "in an area of the display screen not substantially used by displayed information associated with the [user's] primary interaction." This proposed construction quotes almost word-for-word an example the specification provides of the patents' "wallpaper

embodiment"—which the specification also calls the "active" or "spatial" embodiment. Interval's Br. at 12. Defendants' attempts to avoid this clear teaching fail.

i. The Specification Provides And The Prosecution History Confirms That The Disputed Terms Refer To The Wallpaper Embodiment, Not The Screensaver Embodiment

Defendants argue that Interval's proposed construction is indefinite because the patents teach the "screensaver embodiment" as making "unobtrusive" displays. As two patent examiners have correctly found (including, most recently, in *inter partes* examination), this argument misreads the patents.

Three times, the specification describes an unobtrusive display as an inherent characteristic of only the wallpaper embodiment, not the screensaver embodiment. Defendants thus misconstrue the specification when they claim (at 31-32) that it "simply repeats the claim language." In fact, it expressly distinguishes the two embodiments; describes "unobtrusive" displays as necessary only for the wallpaper embodiment; and—using the very language of Interval's proposed construction—provides an explicit example of how that embodiment makes unobtrusive displays.

At the outset, the specification expressly distinguishes an embodiment in which the images are displayed "during inactive periods" (the screensaver embodiment) from one in which "the information can be presented … during

active periods … *but in an unobtrusive manner that does not distract the user* from the primary interaction with the apparatus (*e.g., the information is presented in areas of a display screen that are not used by displayed information associated with the primary interaction*.)" '652 Patent, at 2:3-19 (A41) (emphasis added).

Later, the specification uses the same language and then further clarifies that these two embodiments employ two different types of "unused capacity"—"temporal" (screensaver) and "spatial" (wallpaper)—again tying the disputed claim language only to the latter concept of unused spatial capacity. *Id.* at 6:34-51 (A43).

Finally, following its detailed description of "an embodiment … in which the attention manager presents information … when a user is not engaged in an intensive interaction," (*i.e.*, screensaver), the patent says this: "As indicated above, in *other* embodiments of the invention, the attention manager presents information to the person during active periods, *but in an unobtrusive manner*." *Id.* at 13:11-14 (A47) (emphasis added). This formulation links the "unobtrusive" language to the wallpaper embodiment. *Id.* at 6:34-51 (A43).

Defendants ignore these specification passages and (at 37) rest their argument on a convoluted paragraph diagram based on column 3 of the patents. They would attach the phrase "unobtrusive manner" to the screensaver embodiment by assuming that every reference to "the selective display" in the

specification refers back to and is defined by an earlier description of an aspect of the invention that involves "selectively displaying on the display device, in an unobtrusive manner." Although Defendants provide little explanation, presumably they intend to rely on the word "the" in the phrase "the selective display."

This one definite article cannot bear the entire weight of Defendants' proposed construction. All embodiments of the invention are engaged in "the selective display" on "a display device" of "an image or images generated from the set of content data." "The selective display" is thus a natural way to begin descriptions of the invention's *various* embodiments. The patent nowhere defines "selective display" nor suggests that each instance of those words requires displaying unobtrusively. Indeed, the first time the specification references "selective display" is the column before, in a passage that does not reference displaying in an "unobtrusive manner." '652 Patent, at 2:35-38 (A41). At a minimum, Defendants cannot use the supposed ambiguity of this one passage as clear and convincing evidence refuting the specification's thrice-repeated separation of the "unobtrusive display" from the screensaver embodiment.

To the extent it is necessary to refer to the prosecution history, *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005), it confirms that "unobtrusive" displays are not inherent in the screensaver embodiment. During the original prosecution, the examiner expressly distinguished "two main modes of operation:

(1) display content during inactive periods (screen saver embodiment) …; and (2) display content data in unobtrusive manner (wallpaper embodiment and display area embodiment)." A1073. Then on reexamination, the examiner found that "the broadest reasonable interpretation of independent claim 4, in light of the specification, *excludes the screensaver embodiment* because the claim language … is consistently and repeatedly linked to the 'wallpaper embodiment' and excludes the 'screensaver embodiment.'" A1090-91 (emphasis added).

Defendants' answer (at 40-41) is that these examiners were just wrong. But given the "broadest reasonable interpretation" standard, *see* A1090-91, the supposed error would have to be egregious. Even reading the isolated excerpts that Defendants cite from the prosecution history (at 39-41) strongly in their favor, the most they can establish is that the applicant initially took a broad position, which the examiner rejected in a narrower reading. Interval expressly embraced that interpretation in reexamination. *E.g.*, A1308. That is a classic disclaimer. *TorPharm Inc. v. Ranbaxy Pharms., Inc.*, 336 F.3d 1322, 1330 (Fed. Cir. 2003) ("[T]he public is entitled to equate an inventor's acquiescence to the examiner's narrow view of patentable subject matter with abandonment of the rest."); *Krippelz v. Ford Motor Co.*, 667 F.3d 1261, 1266 (Fed. Cir. 2012) ("A patentee's statements during reexamination can be considered during claim construction, in keeping with the doctrine of prosecution disclaimer."). The prosecution history establishes that

"the PTO and the inventor understood the patent," *Phillips*, 415 F.3d at 1317, to provide that an unobtrusive display was a feature of only the wallpaper embodiment.

Defendants' characterization of the prosecution history is also overstated and incorrect. For example, the inventor did not rely on the screensaver embodiment to establish priority for the "unobtrusive manner" limitation, as Defendants suggest (at 39). Rather, his declaration and exhibits demonstrated prior reduction to practice of *both* embodiments, as was required. *See* A1035-44. The prosecuting attorney then cited to all these exhibits as evidence of priority date. *See* A1010-13. And after that declaration, the examiner correctly understood that the "screen saver embodiment" was not the "mode of operation" that required "display[ing] content data in an unobtrusive manner." A1073.

Defendants likewise misunderstand the reissue language and original claims on which they rely (at 36, 39). The claims they identify contain the "unobtrusive display" limitation and an *additional* limitation that the display occur during an idle period. That language indicates that some displays can occur both in unused space and during an idle time. It does not teach that displaying in an "unobtrusive manner" is an inherent characteristic of the screensaver embodiment or that displaying during an idle period is sufficient to display in an "unobtrusive manner." Once again, even if ambiguous, the specification itself and the other

parts of the prosecution history demonstrate that "unobtrusive" is associated with the wallpaper embodiment.

ii. The Specification's Example Of How The Wallpaper Embodiment Displays In An Unobtrusive Manner Is Sufficient To Support Interval's Construction And Provide Objective Guidance

Because the specification requires "unobtrusive" displays only in the wallpaper embodiment, it fully supports Interval's construction. Interval's construction is nearly identical to the specification's repeated example of how the wallpaper embodiment can display images unobtrusively (*i.e.*, using "areas of a display screen that are not used by … the primary interaction"). '652 Patent, at 2:13-19 (A41), 6:34-45 (A43); *supra* pp. 7-8.

Although they acknowledge (at 38) that the specification provides an example of how the wallpaper embodiment makes unobtrusive displays, Defendants seek to ignore that teaching by overstating what this Court's precedents require. Echoing the District Court (*see* A8-12), Defendants argue (at 29, 31, 34, 38, 47-48) that the specification cannot render the claim terms definite because it does not affirmatively "limit[] the claim to [its] examples," provide that such examples are "the only way" to satisfy the claim, or expressly define the disputed terms. The Court has recently emphasized, however, that claim terms that are subjective or matters of degree may be definite in light of the specification even if

the specification "does not specifically define [those terms] with actual parameters." *Biosig*, 715 F.3d at 899.

In *Shure*, for example, this Court reversed a holding that the phrase "readily installed and replaced by a user" was indefinite because different users would have different impressions and abilities regarding the replacement of the relevant hearing-aid part. 600 F.3d at 1368. The written description said little—only that the part was "simple to install, easy to remove, and convenient to replace," and was "inexpensive and require[d] no tools for installation or removal." *Id.* at 1367. It also disparaged some prior art where "removal and replacement ha[d] been difficult," especially for older people. *Id.* The Court noted that these were "the *only* examples or discussion provided by the specification" regarding the disputed terms. *Id.* (emphasis added). But this discussion was sufficient to find "some standard for measuring the scope of the phrase'" (*i.e.*, whether tools were needed). *Id.* at 1368.

Likewise, in *Deere*, this Court rejected the contention that a claim limiting the invention to rotary decks that were "easily washed off" was indefinitely subjective. 703 F.3d at 1360. The Court found all the guidance it needed in the following six lines from the specification:

> An object of the invention is to provide a deck which is easy to clean but yet has an underside free of obstructions to the smooth flow of cut material.

> A more specific object of the invention is to provide a rotary cutter deck which has an upper, generally convex smooth surface from which debris tends to slide off and water will run off.

U.S. Pat. No. 6,052,980, at 1:40-46. From this statement, the Court found sufficient "physical characteristics [to] guide the determination of whether a deck" was easy to clean (*i.e.*, whether it had a smooth, convex surface). *Deere*, 703 F.3d at 1360.

The specifications in those cases would not have met Defendants' proposed standard that the specification must make these examples the *only* way to satisfy the claim language. Under this Court's actual standard, an example alone can provide "some standard" for an allegedly subjective claim term. *Shure*, 600 F.3d at 1368. This specification supplies such an example. It demonstrates that the wallpaper embodiment displays images "in an unobtrusive manner" by making use of the screen's "unused spatial capacity," which supplies the standard for judging the "obtrusiveness" of various displays under Interval's proposed construction.

iii. The Use Of The Word "Substantially" Does Not Detract From The Guidance Provided By The Specification

Defendants also oppose including the phrase "not *substantially* used" in the construction. But the word "substantially" merely recognizes that a proper claim construction includes cases of immaterial overlap between the primary interaction and the images displayed by the invention. It is also the best reading of the specification's guidance, for three reasons.

First, the specification states that displaying in the unused portion of the screen is only one "example" of how the wallpaper embodiment meets the "unobtrusive display" limitation, '652 Patent at 2:3-19 (A41); 6:34-51 (A43); 13:11-17 (A47), which indicates that other ways exist to employ the screen's unused "spatial" capacity that are broader than having no overlap whatsoever or displaying exclusively in the background.

Second, the specification expressly states that displayed images can supersede displayed "extraneous information," *id.* at 7:45-48 (A44), which would be impossible if "unobtrusive" displays excluded even insubstantial cases of overlap with the primary interaction.

Third, Interval's construction is more consistent with the functionality of the invention—which is a proper basis for limiting allegedly indefinite claim terms, *see Biosig*, 715 F.3d at 900—and which would be unaffected by insubstantial overlap with the primary display. Indeed, the patents speak of engaging the user's peripheral attention, which is consistent with images slightly overlapping with the primary interaction. *E.g.*, '652 Patent, at 2:1-5 (A41).

Defendants' remaining argument (at 42-44) that Interval's inclusion of cases of "insubstantial" overlap itself renders the claims indefinite is also incorrect. The "substantial" modifier is familiar—appearing in countless patents and throughout the law—and its definiteness has been affirmed by this Court on numerous

occasions. *See* Interval's Br. at 35-36 (collecting cases). The most pertinent example is *Exxon*, where this Court found that the term "substantial absence of slug flow" was definite precisely because "[o]ne of skill in the art would understand … that the *reason* slug flow should be avoided is that it may interfere with reactor efficiency." 265 F.3d at 1381 (emphasis added). So too here: One skilled in the art would of course know that the "reason [overlap] should be avoided is that it may interfere with [the user's primary interaction]." Both technical experts and commonsensical fact-finders thus have an adequate standard at the ready by which to judge whether any overlap between the displayed images and the primary interaction is substantial within the meaning of the claims and the teachings of the specification. Indeed, although Defendants routinely confuse infringement and indefiniteness questions (*e.g.*, at 34, 41-48), this is exactly the kind of problem for expert witnesses and jury trials. *See, e.g.*, *Acumed LLC v. Stryker Corp.*, 483 F.3d 800, 806 (Fed. Cir. 2007) (such "line-drawing problems" in the application of a claim construction are "properly left to the trier of fact").

C. Interval's Narrower Alternative Is Supported And Preserved

Although a construction including cases of "insubstantial" overlap is most consistent with the specification, Interval has offered an even-more-limited alternative: If the Court concludes that the "substantial" modifier is inappropriate, it may be struck. *See, e.g.*, *Kinetic Concepts, Inc. v. Blue Sky Med. Group, Inc.*,

554 F.3d 1010, 1022 (Fed. Cir. 2009) (claim term can be limited to particular parameter disclosed in the specification to avoid indefiniteness). The resulting construction is a word-for-word restatement of the specification's example of an "unobtrusive" display. '652 Patent, at 2:13-19 (A41), 6:34-45 (A43). Defendants' objection to this alternative (at 47-48) is a glaring example of the error discussed above. *Supra* pp. 12-14. In the space of two lines, Defendants acknowledge that *Kinetic Concepts*, 554 F.3d at 1022, narrowed an allegedly indefinite term because "the specification disclose[d] one particular method" of understanding it, but then inappropriately transform this into a requirement that the specification expressly make its method "the only way" to meet the term.

Defendants err in suggesting that *Honeywell Int'l, Inc. v. ITC*, 341 F.3d 1332, 1338-39 (Fed. Cir. 2003), and *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1250 (Fed. Cir. 2008), forbid Interval's narrowing construction by supposedly holding that claim terms may not be interpreted in light of the specification. Those decisions hold no such thing; as discussed above, even Defendants concede that the specification is a proper guide to render claim terms definite. By contrast, in *Honeywell*, the specification discussed *none* of the possible standards for measuring a disputed term, which says nothing about a case like this one where the specification provides an on-point example. 341 F.3d at 1338-39. And while *Halliburton* stands for the uncontroversial proposition that

claims cannot always be limited to preferred embodiments, it does not depart from this Court's precedents and foreclose a skilled artisan from making inferences from the kind of detailed and repeated descriptions provided by this specification (and prosecution history). 514 F.3d at 1250; *see supra* pp. 13-14, 16-17 (discussing this Court's decisions in *Shure*, *Deere*, and *Kinetic Concepts*).

Defendants also incorrectly suggest (at 47) that this narrowing alternative is waived. In fact, Interval offered this alternative to the District Court: "[I]f that were true and they were correct, the correct solution is to cross out the word 'substantially' from the definition. It's not to make it indefinite, because that definition comes directly from the specification." A794-95, at 59:23-60:4.

II. The Specification Discloses Sufficient Structure Corresponding To The Means-Plus-Function Claims

As Interval's opening brief explains (at 44-49), the patents disclose sufficient structure to support their claims on "means for selectively displaying … in an unobtrusive manner … an image or images generated from the set of content data." *E.g.*, '652 Patent, at 30:29-33 (A55) (claim 4). They do so by disclosing the algorithm by which a specially programmed computer schedules and displays content in the relevant way.

"Precedent and practice permit a patentee to express that procedural algorithm in any understandable terms including … in prose, or as a flow chart[.]" *Typhoon Touch Techs. v. Dell, Inc.*, 659 F.3d 1376, 1385 (Fed. Cir. 2011)

(quotation marks omitted). The specification here does both—laying out the process in flow charts and elaborating in prose. It explains how unobtrusive displays are made in the "unused spatial dimension" of the device, '652 Patent, at 6:38-51 (A43); how data is scheduled for "selective display," *id.* at 10:10-11:26 (A45); what is meant by the "primary interaction," *id.* at 8:14-34 (A44); and the content of "display instructions" for specific hardware, *id.* at 15:48-56 (A48). Only actual code—which the law does not require, *see Aristocrat Techs. v. Int'l Game Tech.*, 521 F.3d 1328, 1337 (Fed. Cir. 2008)—could make the algorithm much more detailed.

Defendants' response (at 51-53) overstates the requirements of this Court's precedent. Misreading *Aristocrat*, they apparently believe that repeating any of the functional language in the algorithm is fatal. But *every* algorithm describes a function at some level—and the more specific the function recited in the claims, the more likely the algorithm will incorporate its terms. *See Typhoon Touch*, 659 F.3d at 1384-85 ("The preferred definition of 'algorithm' in the computer art is: A fixed step-by-step procedure for accomplishing a given result[.]") (quotation marks omitted).

Defendants rest their argument principally on *Aristocrat*. But that was a case where the *parties agreed* that the only structure described was a "general purpose computer" with "appropriate programming." 521 F.3d at 1334. This

Court did not forbid describing a way to practice the claimed function using similar words; it forbade the patentee from just "describ[ing] the *result* of practicing [it]." *Id.* (emphasis added). The specification here does more: providing explanatory and procedural details for the relevant display. Most important, it instructs software engineers to display unobtrusively by locating the display in a part of the screen not substantially used by the primary interaction.

The proper standard is demonstrated by *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339 (Fed. Cir. 1999). The function there was "assigning a plurality of numbers representing said angular positions of said reel, said plurality of numbers exceeding said predetermined number of radial positions such that some rotational positions are represented by a plurality of numbers." *Id.* at 1347. (In plainer words, assigning numbers to positions on a slot-machine reel so that some positions got more than one number). Looking to the single illustration below, the Court found an algorithm for achieving that result. *Id.* at 1349.

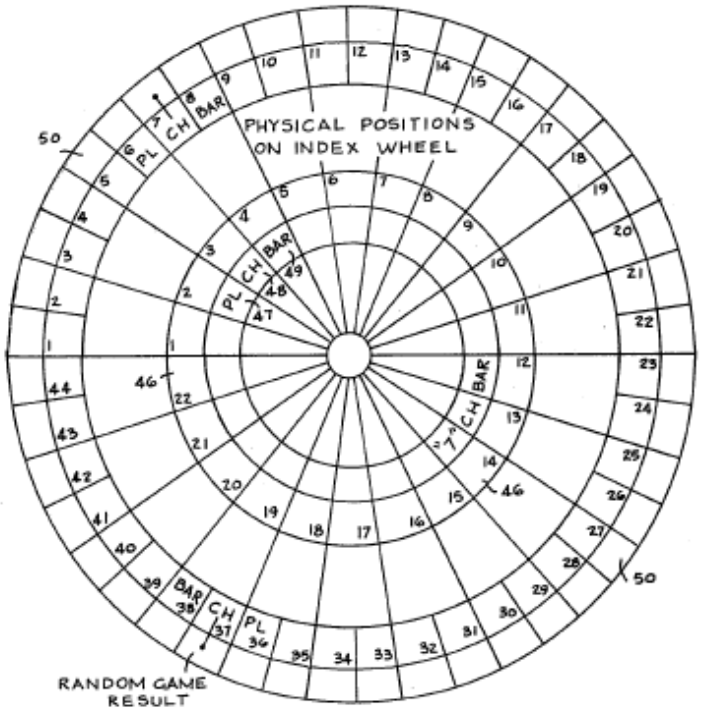


FIG 6

This is just a picture of how the invention in the *WMS Gaming* patent worked. And it allowed the Court to find *and approve* an algorithm whose terms quite closely mirrored the claimed function. *See id.* at 1347. Accordingly, and contrary to Defendants' assertions, a description of how the invention works that uses similar words to the claimed function is adequate to define a means-plus-function claim. The patents here contain such a description, explaining to skilled artisans how to schedule images for a selective display and how to locate those images in

unused portions of the screen so as to achieve the claimed function of displaying "unobtrusively." The District Court's contrary conclusion should be reversed.

III. "Attention Manager" Was Incorrectly Limited To Two Overly Specific Embodiments

The District Court construed "attention manager" as limited to a system that displays images in only one of two ways, either: (1) "when the program detects that the user is not engaged in a primary interaction"; or (2) "as a background of the computer screen." A18. These are overly narrow descriptions of the screensaver and wallpaper embodiments (that is, the one that displays in "unused temporal capacity" and the one that displays in "unused spatial capacity"). Because this construction excludes other embodiments affirmatively referenced by the specification, it cannot be correct. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) (such a construction is "rarely, if ever, correct."). This Court should adopt Interval's alternative, which comes directly from the specification's description of an "attention manager." But if this Court shares Defendants' premise that "attention manager" should be explicitly defined in terms of a structure that displays images in the unused "temporal" and "spatial" capacity of a display device, Interval has proposed an alternative that does not share the District Court's error.

A. The District Court's Construction Is Incorrect Because It Excludes Specified Embodiments

First, the District Court erred in construing the screensaver embodiment ("unused temporal capacity") as limited to a display "when the program detects that the user is not engaged in a primary interaction." A18. The specification teaches that this embodiment can also be triggered by a direct user command. *See* '652 Patent, at 9:23-37 (A45). Defendants would save the District Court's construction (at 54) by characterizing this as "*detect[ing]* that the user is not engaged in a primary interaction," but that argument only emphasizes that the District Court's actual language excludes a specified embodiment. One would not ordinarily describe a manual fire alarm switch as "detecting" the presence of a fire.

The District Court's constricted view of the wallpaper embodiment ("unused spatial capacity") is similarly flawed. After describing the screensaver embodiment in detail, the specification provides that "in other embodiments … the attention manager presents information to the person during active periods, but in an unobtrusive manner." And immediately following this general description of the wallpaper embodiment, it provides that "[i]n such embodiments, video content data could be presented, *for example*, as wallpaper on the display screen." '652 Patent, at 13:11-17 (A47) (emphasis added). The implication is unmistakable: What is described in shorthand as "the wallpaper embodiment" includes *more* than

just the one "example" of displaying images on the wallpaper. The District Court's misconstruction says exactly the opposite.

Defendants' response (at 54-55) wildly over-reads the choice of "wallpaper embodiment" as shorthand for the version of the invention that employs unused spatial capacity. To be sure, the "Background of the Invention" mentions the display's "background" in discussing how people typically use their computer's "wallpaper." '652 Patent, at 1:50-55 (A41). But when the specification creates the "wallpaper embodiment" shorthand, it defines it more generally as an instance where the invention displays images "in addition to" those of the primary interaction. *Id.* at 3:25-31 (A42). Defendants point to nothing in that passage (or anywhere else) that suggests inferring from the chosen shorthand that the "wallpaper embodiment" can only ever display on what was earlier described in passing as the "wallpaper." In fact, as detailed above, the patents suggest exactly the opposite, calling that just one "example" of the broader embodiment. Nor is it strange to name that broader embodiment the "wallpaper embodiment," even though it can display in ways other than wallpaper as well. The point of the name is that displays in this embodiment function *like* displays on the wallpaper: using the parts of the screen that are not substantially used by the primary interaction.

Defendants fare no better in seeking support from the prosecution history (at 57). The applicant did distinguish prior art that displayed notifications in a loading

browser window ("Judson") as employing a different part of the device's unused capacity. But that is because, as the applicant represented, Judson displayed "during, and as part of [the user's] primary interaction with the computer" (*i.e.*, surfing the Internet on a browser). A985-86. In other words, Judson displayed in an area of the screen used by the primary interaction, and so the correct representation that this fell outside the wallpaper embodiment in no way supports the District Court's approach.[2]

B. Interval's Proposal Was Correct, And Its Appropriate Alternative Is Not Waived

While Defendants proposed the mistaken construction adopted below, Interval proposed a construction drawn directly from the specification. It says that "[a]n attention manager presents information to a person in the vicinity of a display device in a manner that engages at least the peripheral attention of the person." '652 Patent, at Abstract (A32). The parties agreed that "peripheral attention of the person" means "a part of the user's attention that is not occupied by the user's primary interaction." A886. Interval thus proposed that "attention manager" be construed as "a system for engaging at least part of the user's attention that is not

[2] Defendants' odd hypothetical (at 56) likewise falls outside the wallpaper embodiment—not because the notification image appears off the wallpaper, but because it completely obscures the part of the screen "used by the primary interaction."

occupied by the user's primary interaction with the apparatus." This construction captures the express lexicography of the patents. *See Phillips*, 415 F.3d at 1316.

While Defendants attack that construction as unsupported or indefinite (at 58-60), these arguments are not only wrong (based on the foregoing), but also unhelpful. Claim construction is not baseball arbitration, where the parties submit competing proposals and the judge adopts one wholesale. *See Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1556 (Fed. Cir. 1995) ("[T]he judge's task is not to decide which of the adversaries is correct."). And so this Court must find a fix for the District Court's plainly erroneous construction—one that, unlike Defendants', at least encompasses all specified embodiments. *See id.* at 1560 ("When [the Federal Circuit] determine[s] on appeal, as a matter of law, that a trial judge has misinterpreted a patent claim, [it] independently construe[s] the claim."). To that end, Interval proposed an alternative this Court could use if it found the primary offer insufficiently helpful for the jury: Define "attention manager" with reference to the screensaver and wallpaper embodiments, but give them their full scope. (To wit: An attention manager "displays images to a user either when the user is not engaged in a primary interaction or in an area of the display screen that is not substantially used by the user's primary activity"). Interval's Br. at 53-54.

Contrary to Defendants' argument (at 60-61), Interval made the relevant argument below: that Defendants' construction was incorrect because it was limited to two specific embodiments and excluded others. *E.g.*, A832-33, at 97:16-98:3 ("background of the computer screen" is too narrow); A573 ("attention manager" covers the broader, "unused spatial capacity" embodiment). Interval also argued below that "attention manager" extended to the full scope of both the "unused temporal capacity" embodiment and the "unused spatial capacity" embodiment. A573. In any event, Interval's proposal cannot be "waived," because it is only a helpful suggestion as to how this Court can do something it must.

IV. The District Court's Construction Of "Instructions" Invites Improper Arguments And Should Be Clarified

This Court should exercise its discretion to correct the District Court's mistaken construction of the claim term "instructions," which while not dispositive will lead to improper arguments that should be precluded now in order to prevent unnecessary and costly errors on remand. *See Deere*, 703 F.3d at 1357. The District Court's construction, which implies that "instructions cannot be data alone," A27, is a manifest *Phillips* error: It places "heavy [in fact, complete] reliance on the dictionary," is "divorced from the intrinsic evidence," and thus "transform[s] the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification."

Phillips, 415 F.3d at 1321. Accordingly, it would conserve judicial resources to at least vacate that construction or, better yet, adopt one that the specification reflects.

On the question of whether "instructions" can sometimes be data alone, the specification is clear. It says:

> Each of these sets of instructions and/or data can be embodied in [1] an appropriate computer program or set of computer instructions (the latter capable of including computer instructions and data); or [2] an appropriate set of data configured for use by a set or sets of instructions (e.g. computer program) that must interact with the set of data in order to implement the attention manager.

'652 Patent, at 14:59-65 (A47) (bracketed enumeration added). This says in so many words that "instructions … can be embodied in … [a] set of data configured for use by a set of instructions."

Moreover, the specification uses the phrase "set of instructions and/or data" as a definition for "functional components." *Id.* at 14:53-54 (A47). And Figure 3A demonstrates that *all* of the functional components may be "instructions." *See* Interval's Br. at 56 (discussing figure). Accordingly, when the patent says that "each" functional component "can be embodied in … an appropriate set of data"—a point Defendants actually *concede* (at 64)—it directly contradicts the District Court's view by showing that some of these instructions can be data alone.

The problem with the District Court's construction—which requires that instructions be "statements in a programming language," A27-A28—is that it invites Defendants to advance arguments that are irreconcilable with this plain

teaching from the specification. The language above shows that when data tells a computer what to do—when it is "configured for use by a set or sets of instructions (e.g. computer program)"—that data is itself an instruction. But myopically focusing on the claim construction language, Defendants can argue that the data is not "a statement in a programming language," and so not an "instruction." This will confuse the proceedings—and the jury—with an argument that the specification unambiguously refutes.

The patent examiner adopted Interval's reading on this point *to the letter*, and Defendants' effort to contest that intrinsic evidence misstates the record. They claim (at 65-66) that "[t]he examiner said that the prior art specified *a function* ('display information now or soon') corresponding to the recited 'scheduling instructions.'" But what the examiner actually said was that content providers in the prior art provided *data* ("the new set of content data") that specified a function ("display new data now or soon"), thereby satisfying a limitation requiring that "the content provider may provide scheduling *instructions*"—a limitation appearing in all the '314 Patent's asserted claims. *See* A1215 ("[N]ew content data … indicates a timing, such as display new information now or soon."); A1207 ("[N]ew information is an instruction to display new information."). Interval never contested this interpretation—instead, it distinguished the prior art on other

grounds—and so it should certainly be entitled to that claim scope now. Instructions can be data, just as the examiner found regarding prior art references.

Against this intrinsic evidence, Defendants (at 65) marshal only a dictionary defining "instructions" as "a statement in a programming language." But they will not accept that *same dictionary's* definition of "data," as "a representation of facts, concepts, or *instructions* in a manner suitable for communication, interpretation, or processing by humans or by automatic means." *Id.* (quoting IEEE dictionary, emphasis added). Instead, they switch to a dictionary that distinguishes data and instructions, a move that proves *Phillips*'s point about the perils of relying on dictionaries for claim construction.

Defendants also attempt to explain away the IEEE definition of data (at 65) by saying that it only includes "instructions suitable for processing by automatic means," which (they say) is consistent with the District Court's holding that instructions cannot be data alone. But that misses the point entirely. The important problem with the District Court's construction is that it implies that a set of data alone can never be "instructions" *even if* it is "suitable for processing by automatic means" (for example, by the processor and operating system on a mobile phone). Because the examiner, the specification, and Defendants' own dictionary all refute this point—recognizing that data alone can be instructions when

"configured for use by a set of instructions," '652 Patent, at 14:63-65 (A47)—that implication should be rejected before it spirals out of control.

More specifically, the District Court's construction may spawn two sets of improper arguments. First, relying on the words of the District Court's construction, Defendants may argue that sending data (like a new mail message) is not sending "instructions" because it is not "a statement in a programming language." Second, they may argue that "object code" is not a "programming language," introducing an issue based on the precise words of a dictionary definition that has literally nothing to do with anything in the patent. Defendants downplay these possibilities, suggesting (at 63) that perhaps the District Court's construction will include data under such circumstances, or (at 67) that object code may be a programming language. Because Defendants apparently agree that such clarifications are in order, the Court could, at a minimum, provide them here. But it should not accept Defendants' familiar gambit: minimizing the issue and encouraging the Court to do nothing today, and turning the infringement stage into a circus tomorrow.

Accordingly, Interval primarily seeks a construction of "instructions" that forecloses these contrary-to-the-specification arguments, such as the one it proposed below. *See* A27 (instructions means "data related to the accomplishment of a function and/or a statement or expression that can be interpreted by a

computer that specifies a function"). But it would suffice for present purposes to vacate the District Court's erroneous construction on the grounds of its plain *Phillips* error. Indeed, it would even suffice to accept Defendants' apparent invitation and decline to address this issue now by stating that the District Court's construction does not exclude data that can be interpreted by other instructions or statements in any particular kind of computer code. It would waste judicial resources, however, to simply send this case forth with a construction of the term "instructions" that invites the kind of arguments this Court could never affirm in a later appeal.

CONCLUSION

This Court should reverse the holdings of indefiniteness and correct the constructions of "in an unobtrusive manner that does not distract a user," "attention manager," and "instructions."

Respectfully submitted,

/s/ Justin A. Nelson
JUSTIN A. NELSON
SUSMAN GODFREY L.L.P.
1201 Third Avenue, Suite 3800
Seattle, WA 98101
(206) 516-3880

MICHAEL HEIM
NATHAN J. DAVIS
DOUGLAS R. WILSON
HEIM, PAYNE & CHORUSH LLP
600 Travis Street, Suite 6710
Houston, TX 77002
(713) 221-2000

THOMAS C. GOLDSTEIN
GOLDSTEIN & RUSSELL, PC
5225 Wisconsin Avenue, NW
Suite 404
Washington, DC 20015
(202) 887-4000

MAX L. TRIBBLE, JR.
SUSMAN GODFREY L.L.P.
1000 Louisiana Street, Suite 5100
Houston, TX 77002
(713) 653-7820

Counsel for Plaintiff-Appellant

October 11, 2013

United States Court of Appeals
for the Federal Circuit

Interval Licensing LLC v AOL, Inc., 2013-1282, -1283, -1284, 1285

CERTIFICATE OF SERVICE

I, Robyn Cocho, being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

Counsel Press was retained by HEIM, PAYNE & CHORUSH LLP, Attorneys for Appellant to print this document. I am an employee of Counsel Press.

On **October 11, 2013**, Counsel for Appellant has authorized me to electronically file the foregoing **REPLY BRIEF FOR APPELLANT** with the Clerk of Court using the CM/ECF System, which will serve via e-mail notice of such filing to any of the following counsel registered as CM/ECF users:

Elizabeth Day
David Alberti
Feinberg Day Alberti
& Thompson LLP
1600 El Camino Real, Ste. 280
Menlo Park, CA 94025
(650) 618-4360
eday@feinday.com
dalberti@feinday.com

Counsel for Appellee, Apple, Inc.

Deanne Maynard
(Principal Counsel)
Morrison & Foerster LLP
2000 Pennsylvania Ave., NW
Suite 6000
Washington, DC 20006
(202) 887-8740
dmaynard@mofo.com

Michael A. Jacobs
Matthew I. Kreeger
Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105
(415) 268-7178
mjacobs@mofo.com
mkreeger@mofo.com

Counsel for Appellee, Yahoo! Inc.

J. Michael Jakes
(Principal Counsel)
Gerald F. Ivey
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
901 New York Ave., N.W.
Washington, DC 20001
(202) 408-4000
mike.jakes@finnegan.com
gerald.ivey@finnegan.com

Cortney Scott Alexander
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
3500 SunTrust Plaza
303 Peachtree Street, NE
Atlanta, GA 30308
(404) 653-6400
cortney.alexander@finnegan.com

Robert L. Burns, II
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
Two Freedom Square
11955 Freedom Drive
Reston, VA 20190
(571) 203-2700
robert.burns@finnegan.com

Erik R. Puknys
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
3300 Hillview Avenue
Palo Alto, CA 94304
(650) 849-6600
erik.puknys@finnegan.com

Counsel for Appellee AOL Inc.

Kevin McGann
(Principal Counsel)
Dimitrios T. Drivas
White & Case LLP
1155 Avenue of the Americas
New York, NY 10036
212-819-8200
kmcgann@whitecase.com
ddrivas@whitecase.com

Warren S. Heit
Carmen Lo
Wendi R. Schepler
White & Case LLP
3000 El Camino Real
Five Palo Alto Square, 9th Fl.
Palo Alto, CA 94306
(650)213-0321
wheit@whitecase.com
clo@whitecase.com
wschepler@whitecase.com

Counsel for Appellee Google, Inc.

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October 11, 2013

/s/ Robyn Cocho
Counsel Press

CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rules of Appellate Procedure 28.1(e)(3) and 32(a)(7)(C), the undersigned hereby certifies that this brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 28.1(e)(2)(B)(i).

1. This brief complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B) and Federal Circuit Rule 32(b) because this brief contains 6,970 words, excluding the parts of the brief exempted by Federal Circuit Rule 32(b)(1)-(3).

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2007 in 14-point Times New Roman Font.

Dated: October 11, 2013

/s/ Justin A. Nelson
Justin A. Nelson
Counsel for Plaintiff-Appellant