

1 DURIE TANGRI LLP
2 DARALYN J DURIE (SBN 169825)
3 ddurie@durietangri.com
4 RYAN M. KENT (SBN 220441)
5 rkent@durietangri.com
6 EUGENE NOVIKOV (SBN 257849)
7 enovikov@durietangri.com
8 217 Leidesdorff Street
9 San Francisco, CA 94111
10 Telephone: 415-362-6666
11 Facsimile: 415-236-6300

12 Attorneys for Defendant and Counterclaim Plaintiff
13 YELP! INC.

14
15 IN THE UNITED STATES DISTRICT COURT
16 FOR THE NORTHERN DISTRICT OF CALIFORNIA
17 SAN FRANCISCO DIVISION

18 EIT HOLDINGS, LLC, a Delaware company

19 Plaintiff and Counterclaim Defendant,

20 v.

21 YELP! INC., a Delaware corporation

22 Defendant and Counterclaim Plaintiff.

Case No. 3:10-cv-05623-WHA

**YELP! INC.'S MOTION FOR SUMMARY
JUDGMENT OF INVALIDITY**

Date: January 19, 2012
Time: 8:00 a.m.
Ctrm: 8, 19th Floor
Judge: Honorable William Alsup

TABLE OF CONTENTS

PAGE NO.

1

2

3 NOTICE OF MOTION 1

4 STATEMENT OF RELIEF REQUESTED 1

5 MEMORANDUM OF POINTS AND AUTHORITIES..... 1

6 I. BACKGROUND..... 2

7 A. The '837 Patent and Asserted Claims. 2

8 B. The Prior Art. 4

9 1. The '938 Patent. 4

10 2. Fishwrap. 5

11 II. ARGUMENT 6

12 A. Claim 40 is Indefinite. 7

13 B. Claims 40 and 41 are Anticipated or Rendered Obvious by Prior Art..... 9

14 1. The '938 Patent Anticipates Claims 40 and 41. 9

15 a. Claim 41. 10

16 i. receiving through the master node a user id corresponding

17 to a current user of the user node 10

18 ii. accessing from the master database user profile information

19 corresponding to the user id and respective network address..... 11

20 iii. transmitting to the user node, through the master node, a

21 reference to target information corresponding to the

22 accessed user profile 13

23 iv. storing a user report from the user node 14

24 b. Claim 40. 15

25 i. Preamble. 15

26 ii. means for registering a first-time user of the computer

27 network 15

28 iii. means for receiving, through the master node, a user id and

respective network address corresponding to a current user

of the user node 16

iv. means for accessing from the master database user profile

information corresponding to the user id 16

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

TABLE OF CONTENTS (CONT'D)

PAGE NO.

- v. means for transmitting to the user node, through the master node, a reference to target information corresponding to the accessed user profile 17
- vi. means for storing a user report from the user node 17
- 2. The Freshman Fishwrap Anticipates Claims 40 and 41..... 17
 - a. Fishwrap was in public use more than one year prior to the '837 patent's priority date. 17
 - b. Claim 41. 18
 - i. receiving through the master node a user id corresponding to a current user of the user node 18
 - ii. accessing from the master database user profile information corresponding to the user id and respective network address..... 19
 - iii. transmitting to the user node, through the master node, a reference to target information corresponding to the accessed user profile 20
 - iv. storing a user report from the user node 22
 - c. Claim 40. 22
 - i. Preamble. 22
 - ii. means for registering a first-time user of the computer network 23
 - iii. means for receiving, through the master node, a user id and respective network address corresponding to a current user of the user node 23
 - iv. means for accessing from the master database user profile information corresponding to the user id 24
 - v. means for transmitting to the user node, through the master node, a reference to target information corresponding to the accessed user profile 25
 - vi. means for storing a user report from the user node 25
- CONCLUSION 25

TABLE OF AUTHORITIES

PAGE NO.

Cases

Aristocrat Technologies Australia Pty Ltd. v. International Game Technology,
521 F.3d 1328 (Fed. Cir. 2008).....1, 7, 8

Asyst Technologies, Inc. v. Empak, Inc.,
No. C 98-20451 JF, 2006 WL 3302476 (N.D. Cal., Dec. 20, 2006)10

Blackboard, Inc. v. Desire2Learn, Inc.,
574 F.3d 1371 (Fed. Cir. 2009).....8

Celeritas Techs., Ltd. v. Rockwell Int’l Corp.,
150 F.3d 1354 (Fed. Cir. 1998).....9

Kemco Sales, Inc. v. Control Papers Co.,
208 F.3d 1352 (Fed. Cir. 2000).....7

KSR Int’l Co v. Teleflex, Inc.,
550 U.S. 398 (2007).....25

Matsushita Elec. Indus. Co, Ltd. v. Zenith Radio Corp.,
475 U.S. 574 (1986).....9

Net 2 Press, Inc. v. 58 Dix Avenue Corp.,
266 F. Supp. 2d 146 (D. Me. 2003)10

Net MoneyIN, Inc. v. Verisign, Inc.,
545 F.3d 1359 (Fed. Cir. 2008).....7, 8

Odetics, Inc. v. Storage Tech. Corp.,
185 F.3d 1259 (Fed. Cir. 1999).....24

PowerOasis, Inc. v. T-Mobile USA, Inc.,
522 F.3d 1299 (Fed. Cir. 2008).....9

Typhoon Touch Technologies, Inc. v. Dell, Inc.,
___ F.3d ___, No. 2009-1589, 2011 WL 5289603 (Fed. Cir. 2011)8

Volterra Semiconductor Corp. v. Primarion, Inc.,
No. C-08-05129 JCS, 2011 WL 2559612 (N.D. Cal., May 4, 2011)10

Statutes

35 U.S.C. § 102.....1, 2, 9

35 U.S.C. § 103.....25

35 U.S.C. § 112.....1, 7, 8, 9, 24

Rules

Fed. R. Civ. P. 56.....9

NOTICE OF MOTION

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that on January 19, 2012, at 8:00 a.m., or as soon thereafter as the matter may be heard, in the courtroom of the Honorable William Alsup, United States District Court, 450 Golden Gate Avenue, San Francisco, CA 94102, Defendant Yelp! Inc. will move the Court for summary judgment that claims 40 and 41 of the U.S. Patent No. 5,828,837 (“’837 patent”) are invalid pursuant to 35 U.S.C. § 102. These claims are directed to delivering references to target information contained in a master database to users over a network. Claim 40 is written in means-plus-function form and is invalid as indefinite for lack of corresponding structure under 35 U.S.C. § 112. Additionally, the Fishwrap System in public use at the Massachusetts Institute of Technology more than one year prior to the patent filing date, and U.S. Patent No. 5,754,938, filed before the ’837 patent, anticipate and render obvious both asserted claims of the ’837 patent.

STATEMENT OF RELIEF REQUESTED

Plaintiff EIT Holdings, LLC (“EIT”) asserts infringement by defendant Yelp! Inc. (“Yelp”) of two claims of U.S. Patent No. 5,828,837, entitled “Computer Network System and Method for Efficient Information Transfer” – claim 40, a system claim drafted in means-plus-function form, and claim 41, a method claim. There is no genuine issue of material fact that both claims are invalid as construed by the Court, and Yelp respectfully requests an order granting summary judgment of invalidity.

MEMORANDUM OF POINTS AND AUTHORITIES

Claim 40 is invalid under 35 U.S.C. § 112 ¶ 6 for lack of adequate corresponding structure. In its Claim Construction Order, the Court determined that a “master program” is the only corresponding structure disclosed in the specification for three of claim 40’s means-plus-function terms, over EIT’s objection that the claims should be construed to preserve their validity. A “master program” is insufficient corresponding structure as a matter of law, akin to the “general purpose computer” held inadequate by the Federal Circuit in *Aristocrat Technologies Australia Pty Ltd. v. International Game Technology*, 521 F.3d 1328, 1333 (Fed. Cir. 2008). The fact that the “master program” is described as having subcomponents cannot save the claim from indefiniteness, because this Court has already rejected EIT’s argument that certain of those subcomponents constitute the corresponding structure for the terms

1 in question.

2 Both asserted claims are also independently invalid in light of the prior art. The claims disclose a
3 system and method for retrieving references to target information from a master database and
4 transmitting them to a user over a network. There is no legitimate dispute that this was not new when the
5 '837 patent was filed in 1996. U.S. Patent No. 5,754,938, filed October 31, 1995 ("938 patent"), offers
6 a detailed description of a "News Clipping Service" that anticipates the two asserted claims. Likewise, by
7 April 1995, students and faculty at the Massachusetts Institute of Technology had developed and put into
8 public use an online personalized newspaper service known as "Fishwrap" that practiced every limitation
9 of the asserted claims. Both the '938 patent and the Fishwrap system are anticipating prior art under 35
10 U.S.C. § 102.

11 In July 2011, following service of Yelp's invalidity contentions pursuant to Patent Local Rule 3-
12 3, Yelp served an interrogatory requesting that EIT detail its bases for contending that the asserted claims
13 are not anticipated by Yelp's prior art. In its two page-long response, EIT admitted that a number of
14 limitations were disclosed by Fishwrap and the '938 patent, and offered conclusory denials as to the rest.
15 (Declaration of Eugene Novikov in Support of Yelp! Inc.'s Motion for Summary Judgment of Invalidity
16 ("Novikov Decl.") Ex. 1 at 8-10.) EIT having failed to put forth any evidence to rebut Yelp's assertions
17 of invalidity, and there being no issue of material fact with respect to any of the claim limitations,
18 summary judgment is warranted.

19 **I. BACKGROUND**

20 **A. The '837 Patent and Asserted Claims.**

21 The core of the invention described in the '837 patent is a network architecture that efficiently
22 controls the flow of network traffic to deliver target information to the user in a way that makes use of
23 idle bandwidth and minimizes network delay. As discussed in more detail in Yelp's claim construction
24 brief (ECF No. 125 at 2-4), much of the specification and the vast majority of the claims are devoted to
25 variations on this theme. The two claims EIT has chosen to assert against Yelp, however, are much
26 broader. Neither contains any limitations directed to controlling network traffic, using idle bandwidth, or
27 minimizing delay. Instead, they generally claim a system and a method of retrieving references to target
28 information from a master database and delivering them to the user. Here is claim 40, which is written in

1 means-plus-function form:

2 A master program module coupled to a master node and a master database
3 for connecting information providers and user nodes for a
4 computer network comprising:

5 means for registering a first-time user of the computer network;

6 means for receiving, through the master node, a user id and respective
7 network address corresponding to a current user of the user
8 node;

9 means for accessing from the master database user profile information
10 corresponding to the user id;

11 means for transmitting to the user node, through the master node, a
12 reference to target information corresponding to the accessed
13 user profile; and

14 means for storing a user report from the user node.

15 (Novikov Decl. Ex. 2, claim 40.) In its Claim Construction Order, the Court held that the corresponding
16 structure disclosed in the specification for the “means for receiving,” “means for transmitting,” and
17 “means for storing” terms was the “master program.” (ECF No. 134 at 14, 16, 18.) While the master
18 program is not described in detail, it is clearly intended to be some sort of computerized system – in one
19 embodiment, a “large server” (Novikov Decl. Ex. 2 at 3:50-53) – capable of executing the various tasks
20 described in the claims and in the specification, such as receiving a user ID, reading the user profile to
21 determine what references to target information should be transmitted to the user, transmitting those
22 references, and storing the “user report.” (Novikov Decl. Ex. 2 at Figs. 5A and 5B, 4:48-64, 7:4-14.)

23 Claim 41 is written as a method claim, but otherwise parallels claim 41, with minor differences:

24 A method for connecting information providers and user nodes coupled to
25 a master node and a master database comprising the steps of:

26 receiving through the master node a user id corresponding to a current
27 user of the user node;

28 accessing from the master database user profile information
corresponding to the user id and respective network address;

transmitting to the user node, through the master node, a reference to
target information corresponding to the accessed user profile;
and

storing a user report from the user node.

(*Id.* at claim 41.) At claim construction, the Court considered three terms common to both claims. “Master node” was construed as “point of connection into a network, through which items are transmitted and received, to facilitate communication between an information provider and a user node.” (ECF No. 134 at 11.) “Master database” was construed to mean “a collection of electronic information from which user profile information can be accessed.” (*Id.* at 13.) The Court declined to construe the term “reference,” instead affording the term its plain meaning and noting that “[t]he patent used the term generally to mean something that refers to something else.” (*Id.* at 7.)

B. The Prior Art.

Claims 40 and 41 are drawn to a system and method for the transmission of personalized information – providing users references to information, over a network, based on the contents of their user profiles, and then storing a report of the user’s network activity. Personalization of this kind was well known by April 1996, when the ’837 patent was filed. While the scope of prior art disclosing this sort of system is vast, this motion focuses on two references: U.S. Patent No. 5,754,938 and “Fishwrap,” an online personalized newspaper service in public use.

1. The ’938 Patent.

The ’938 patent was filed on October 31, 1995, and discloses a system for “customized electronic identification of desirable objects, such as news articles, in an electronic media environment.” (Declaration of Christopher Schmandt in Support of Yelp! Inc.’s Motion for Summary Judgment of Invalidity (“Schmandt Decl.”) Ex. 1 at Abstract.) In the patented system, information providers communicate with the user through a proxy server that knows the user by a pseudonym – i.e., a user id. (*Id.*) The user provides the system with a “one-time return address[.]” that can be used to send messages, such as news articles, to the user. (Schmandt Decl. Ex. 1 at 32:34-45.) The purpose of the proxy server is to permit the user to receive personalized content without compromising his privacy. (Schmandt Decl. Ex. 1 at 57:3-11.) Using the proxy server, the system maintains a “user profile” and “target profile interest summary” for each user, containing the user’s interests, preferences, and network activity, and permits information

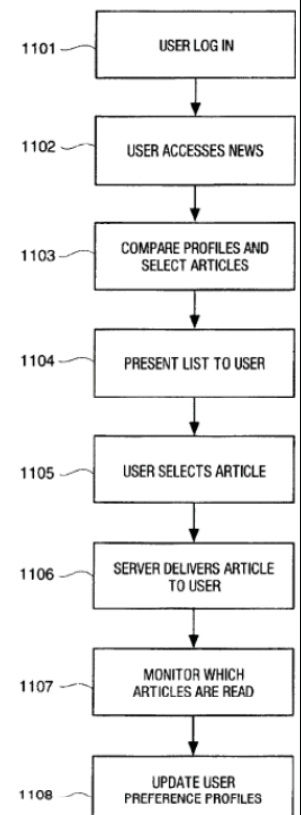


FIG. 10

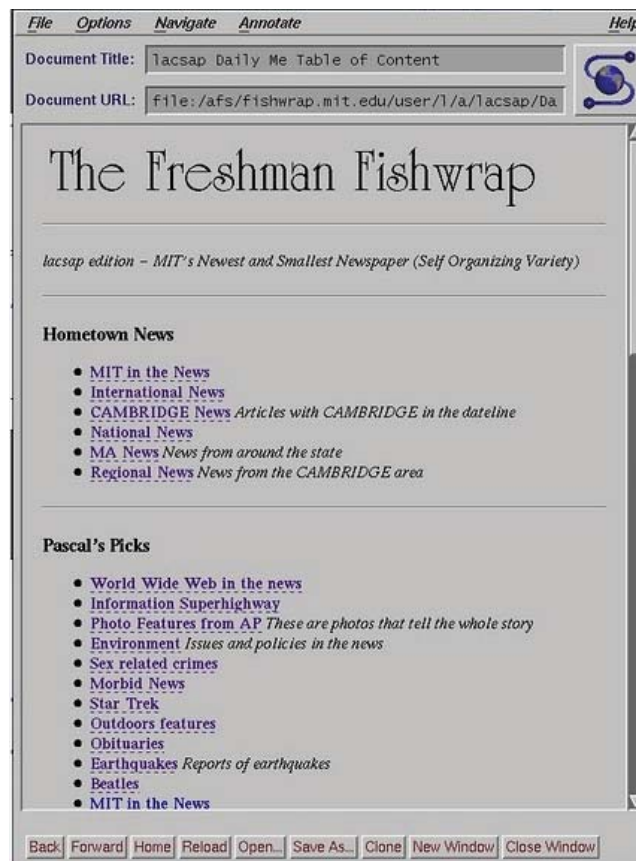
1 providers to customize content to the user without learning his identity. (Schmandt Decl. Ex. 1 at 32:34-
2 45.) At predetermined times, the system evaluates certain “target objects” against each user profile “to
3 generate a user-customized rank ordered listing of target objects most likely to be of interest to each user
4 so that the user can select from among these potentially relevant target objects, which were automatically
5 selected by this system from the plethora of target objects that are profiled on the electronic media.”
6 (Schmandt Decl. Ex. 1 at Abstract.) The user profile is then updated based on relevance feedback from
7 the user. (Schmandt Decl. Ex. 1 at 17:18-44.)

8 The '938 specification discusses a “News Clipping Service” embodiment of the invention,
9 wherein the “target objects” selected for the user, based on the user profile, are news articles. Above and
10 to the right is a flow diagram from the specification depicting how this embodiment is intended to
11 function. (Schmandt Decl. Ex. 1, Fig. 10.)

12 **2. Fishwrap.**

13 The Freshman Fishwrap Project began as part of a seminar at the Massachusetts Institute of
14 Technology in 1992 in which students were asked to design the newspaper of the future. (Declaration of
15 Pascal Chesnais in Support of Yelp! Inc.’s Motion for Summary Judgment of Invalidity (“Chesnais
16 Decl.”) at ¶¶ 4, 12, Ex. B.) The seminar was co-taught by Pascal Chesnais, then Research Specialist at
17 the MIT Media Laboratory. (*Id.*) The result was a personalized newspaper available to any registered
18 user with an account on an MIT network. A first-time user was asked to fill out a registration form with
19 certain information about his hometown, his major, and interests the user might have. (Chesnais Decl. at
20 ¶ 26, Ex. F at 1.) This information was stored in a user profile. (Chesnais Decl. at ¶ 28, Ex. F at 1, 4.)
21 Thereafter, the user could access the Fishwrap service through a web server to receive a personalized
22 newspaper. (Chesnais Decl. at ¶¶ 21, 34, 42-44, Ex. F at 5.) An application framework called “Glue”
23 transmitted a set of links to articles, based on the “global topics of interest,” “personal topic definitions,”
24 and other information contained in the user’s Fishwrap profile. (Chesnais Decl. at ¶¶ 16, 41, Ex. F at 3-
25 4.) Fishwrap then “record[ed] any available observations: was the article read, in what order, did the
26 reader inspect all the topics, etc.” (Chesnais Decl. at ¶ 32, Ex. F at 3.) This information about the user’s
27 browsing habits was transmitted to the Glue module and stored in the user profile. (Chesnais Decl. at ¶¶
28 35-36, Ex. E at 22-24.) The additional information was later used to deliver an even more personalized

1 newspaper. (Chesnais Decl. at ¶ 37, Ex. F at 6.) An example of such a daily personalized newspaper is
 2 illustrated below:



17 (Chesnais Decl. at ¶ 15, Ex. G.) The links were selected and sent based on the content of the user's
 18 profile. Here, for example, Pascal Chesnais' personalized paper (the "lacsap edition", "lacsap" being
 19 "pascal" spelled backwards) included news from his hometown (in his case Cambridge, Massachusetts)
 20 and "Pascal's Picks", which were selected by Fishwrap based on his stated interests and viewing habits.
 21 He could click on any of these links and access articles of interest. (Chesnais Decl. at ¶¶ 43-44.)

22 Fishwrap went online at MIT in October 1993, and was available to any member of the MIT
 23 community with an MIT User Name, continuously through April 1995. (Chesnais Decl. at ¶ 14.) The
 24 system was also described in published academic papers and newspaper articles prior to April 1996.
 25 (Chesnais Decl. at ¶¶ 5, 6, 8-10, Exs. A, B, D-F.) The Chesnais Declaration describes the system as it
 26 existed in April 1995, more than one year prior to the filing date of the '837 patent.

27 II. ARGUMENT

28 Claim 40 is invalid as indefinite for lack of corresponding structure. Both claims 40 and 41 are

1 anticipated and rendered obvious by Fishwrap and the '938 patent.

2 **A. Claim 40 is Indefinite.**

3 Claim 40 is invalid under 35 U.S.C. § 112 ¶ 6 because it contains means-plus-function limitations
4 that lack sufficient corresponding structure in the specification. In its Claim Construction Order, the
5 Court held that the corresponding structure for the “means for receiving,” “means for transmitting,” and
6 “means for storing” limitations of claim 40 is the “master program.” For each of these three claim
7 elements, the Court found that the master program is the *only* structure identified in the '837 specification
8 as performing the relevant function. (ECF No. 134 at 14, 16, 18.) A master program is inadequate
9 corresponding structure as a matter of law.

10 Section 112 ¶ 6 permits a patentee to express a claim element as a means for performing a
11 specified function without reciting the structure that will perform the function. As *quid pro quo* for this
12 flexibility, the patentee must set forth the corresponding structure in the specification, and explicitly link
13 that structure to the claimed function to which it corresponds. *Kemco Sales, Inc. v. Control Papers Co.*,
14 208 F.3d 1352, 1360-61 (Fed. Cir. 2000).

15 Where the claimed function is to be performed by a computer, it is not sufficient to disclose a
16 general-purpose computer as the corresponding structure. *Aristocrat Techs. Australia Pty Ltd. v. Int'l*
17 *Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008). “Because general purpose computers can be
18 programmed to perform very different tasks in very different ways, simply disclosing a computer as the
19 structure designated to perform a particular function does not limit the scope of the claim to ‘the
20 corresponding structure, material, or acts’ that perform the function, as required by section 112 paragraph
21 6.” *Id.* Instead, the disclosure must include the algorithm that the computer will be programmed to carry
22 out in order to perform the claimed function. *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1367
23 (Fed. Cir. 2008). In other words, the corresponding structure cannot “simply describe[] the function to
24 be performed”; it must describe *how* those functions are performed. *Blackboard, Inc. v. Desire2Learn,*

1 *Inc.*, 574 F.3d 1371, 1384 (Fed. Cir. 2009) (citation omitted).¹ For purposes of the indefiniteness inquiry
2 under § 112, the relevant question is “whether the specification contains a sufficiently precise description
3 of the ‘corresponding structure’ to satisfy section 112, paragraph 6, not whether a person of skill in the
4 art could devise some means to carry out the recited function.” *Id.* at 1385.

5 The disclosure of a “master program” is not a sufficient corresponding structure under *Aristocrat*,
6 *Net MoneyIN*, and *Blackboard*. It does not disclose or describe any algorithm for performing the
7 “receiving,” transmitting” and “storing” functions. Indeed, it contains no information whatsoever about
8 how those functions are to be performed. “Master program” is indistinguishable from the “general
9 purpose computer” that was deemed inadequate in *Aristocrat* and its progeny. It is no more than an
10 abstraction; a statement that the claimed functions are performed in some unspecified computerized way.
11 The Federal Circuit has rejected such disclosures time and again.

12 In its opposition, EIT may argue that “master program” is sufficient corresponding structure
13 because “master program” is elsewhere described as having additional structure, namely: “a large server
14 preferably built on a Sybase SQL-Server platform” that includes a “Client control program,” an
15 “authentication program,” and a “web server.” (Novikov Decl. Ex. 2 at 3:50-60.) The Court has already
16 rejected this argument. During claim construction, EIT argued that the corresponding structure for the
17 “receiving” and “transmitting” limitations was the web server of the master program, and that the
18 corresponding structure for the “storing” element was the SQL server of the master program. The Court
19 found no clear link between EIT’s proposed structures and the claim limitations being construed, holding
20 that the only structure clearly linked or associated with the claim steps in question was the master
21 program. The Court went on:

22 In its supplemental claim construction brief, EIT argues that if “master
23 program” is the structure corresponding to the means-plus-function claim
24 elements, then “master program” should be further described as a server
25 platform. EIT cites a description of the preferred embodiment in which
26 “[m]aster program 140 is a large server” (col. 3:50) and emphasizes that

25 ¹ The Federal Circuit’s recent decision in *Typhoon Touch Technologies, Inc. v. Dell, Inc.*, ___ F.3d ___,
26 No. 2009-1589, 2011 WL 5289603 (Fed. Cir. 2011) is consistent with this formulation. In that case, the
27 court held that a detailed prose description of how a computer will be programmed to perform the
28 function of “cross-referencing” – as opposed to a recitation of a mathematical formula or computer
source code – sufficiently set forth “algorithmic structure for the routine programmatic procedures
needed.” *Id.* at *8. The description in question included the actual steps that the claimed software would
follow to perform the cross-referencing function. *Id.*

1 “the structure associated with the ‘master program’ in the specification is a
2 server platform and equivalents” (Dkt. No. 133 at 3–4). **This, however, is
3 not the relevant question. . . . The question is what structure is clearly
4 linked to “means for receiving” (and the other means-plus function
5 claim terms). The answer is “master program.”** There is no need to
6 construe the construction. Moreover, even if the phrase “master program”
7 were to be construed, it would not be construed by identifying an
8 associated structure, because it is not a means-plus-function limitation.

9 (ECF No. 134 at 15 (emphasis added).) The fact that “master program” is described as having certain
10 components is therefore immaterial to the question of whether “master program” is sufficient
11 corresponding structure. The Court has already found that the more specific descriptions of master
12 program components are not clearly linked or associated with the claimed functions in question. The
13 corresponding structure for “means for receiving,” “means for transmitting,” and “means for storing” is
14 “master program,” not “web server,” “SQL server,” or anything else. And “master program” is
15 insufficient. That is why EIT urged the Court at claim construction to construe these terms as requiring
16 something more than a “master program” in order to “retain[] the validity of the patent.” (ECF No. 133
17 at 4.) Claim 40 is therefore invalid under § 112.

18 **B. Claims 40 and 41 are Anticipated or Rendered Obvious by Prior Art.**

19 A patent is invalid as being anticipated under 35 U.S.C. § 102 if “each and every limitation is
20 found either expressly or inherently in a single prior art reference.” *Celeritas Techs., Ltd. v. Rockwell
21 Int’l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998). When there is no genuine issue of material fact,
22 anticipation is properly resolved on summary judgment. *See, e.g., PowerOasis, Inc. v. T-Mobile USA,
23 Inc.*, 522 F.3d 1299, 1301 (Fed. Cir. 2008) (affirming grant of summary judgment of anticipation under §
24 102(b)). In order to defeat summary judgment, the non-moving party must do “more than simply show
25 that there is some metaphysical doubt as to the material facts.” *Matsushita Elec. Indus. Co, Ltd. v. Zenith
26 Radio Corp.*, 475 U.S. 574, 586 (1986). Rather, the non-moving party must set forth “specific facts
27 showing that there is a genuine issue for trial.” Fed. R. Civ. P. 56(e); *Matsushita Elec.*, 475 U.S. at 587.

28 **1. The ’938 Patent Anticipates Claims 40 and 41.**

The ’938 patent, filed in October 1995, discloses every element of both asserted claims, in the
order in which those elements are arranged in the patent-in-suit. This motion first discusses claim 41,
and then goes on to consider claim 40’s relevant differences.

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a. Claim 41.

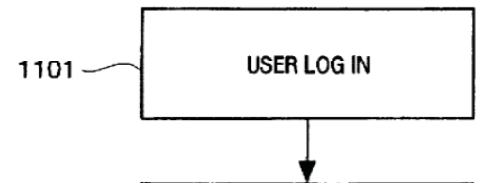
EIT correctly concedes in its interrogatory responses that the '938 patent discloses "a method for connecting information providers and user nodes coupled to a master node and a master database." (Novikov Decl. Ex. 1 at 8-10.) Those interrogatory responses should be binding. *Cf. Volterra Semiconductor Corp. v. Primarion, Inc.*, No. C-08-05129 JCS, 2011 WL 2559612, at *7 (N.D. Cal., May 4, 2011) (defendant making summary judgment motion may not rely on prior art arguments not disclosed during discovery); *Asyst Technologies, Inc. v. Empak, Inc.*, No. C 98-20451 JF, 2006 WL 3302476, at *6 (N.D. Cal., Dec. 20, 2006) (quoting *Net 2 Press, Inc. v. 58 Dix Avenue Corp.*, 266 F. Supp. 2d 146, 161 (D. Me. 2003) ("[W]hile supplementation of interrogatory answers may be allowed under some circumstances, it should not be allowed after the filing of dispositive motions and on the eve of trial in the absence of extraordinary circumstances.")).

EIT's admission is also well-founded. The '938 patent specification discloses a proxy server that provides users personalized references to target information from a variety of information providers. (Schmandt Decl. at ¶ 10, Ex. 1 at 9:7-50, 34:17-43.) A proxy server is a network server that acts as an intermediary between users and other information or resource providers. (*Id.* at ¶ 10.) In one embodiment of the '938 patent, a proxy server is deployed "to implement an automatic news clipping service which learns to select (filter) news articles to match a user's interests. . . ." (*Id.* Ex. 1 at 55:36-42.) The proxy server accesses the user's profile "to determine which news articles are most likely of interest to the user," and "present[s the] list of [relevant articles] to the user who can then select . . . any article for viewing." (*Id.* at Ex. 1 at 57:15-58:27.) This profile information is accessed from a master database using the proxy server's "database function." (*Id.* at ¶¶ 15-16, 21 n.1, Ex. 1 at 57:3-11.) The proxy server is also coupled to a master node in the form of a "network communication function" through which the proxy server establishes a "pseudonymous data communications connection" over a network so that it can receive log-in information and transmit articles to the user. (*Id.* at ¶¶ 10, 12, Ex. 1 at 34:25-36; 57:3-11.)

i. receiving through the master node a user id corresponding to a current user of the user node

The '938 patent's proxy server operates using pseudonyms – i.e., user ids – that can identify the

1 user to the proxy server and to information providers without revealing the user's true identity. (*See*
 2 Schmandt Decl. at ¶ 11, Ex. 1 at 31:48-57 (“A pseudonym is an
 3 artifact that allows a service provider to communicate with users
 4 and build and accumulate records of their preferences over time,
 5 while at the same time remaining ignorant of the users' true
 6 identities, so that users can keep their purchases or preferences private.”).) The patented system requires
 7 the user to log in. (*See id.* at ¶ 12, Ex. 1, Fig. 10, above and at right.) In order to log into the system, the
 8 user transmits several pieces of information to the proxy server. One piece of information is the
 9 pseudonym itself, i.e. the user id, which constitutes “a unique string of bits (e.g., a random binary
 10 number) that is associated with the particular user.” (Schmandt Decl. at ¶ 11, Ex. 1 at 36:27-43; *see also*
 11 *id.* at 37:20-23 (“The user now sends proxy server S2 the pseudonym, which has been signed by Z to
 12 indicate the authenticity and uniqueness of the pseudonym.”).)

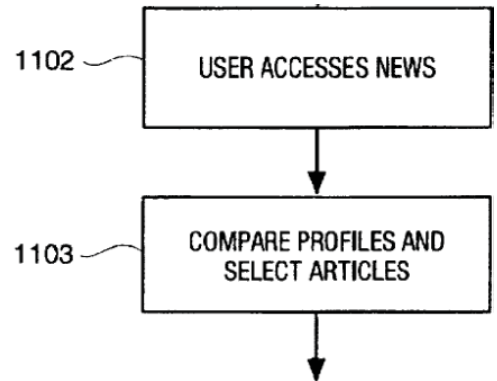


13 This information is received by the proxy server, over a network, through its “network
 14 communications function” – the master node. (*See id.* at ¶ 10, Ex. 1 at 34:25-36 (“A proxy server, e.g.
 15 S2, is a server computer with CPU, main memory, secondary disk storage and network communication
 16 function. . . .”), 57:3-11 (“At step 1101, the user logs into the data communication network N via their
 17 client processor C₁ and activates the news reading program. This is accomplished by the user
 18 establishing a pseudonymous data communications connection as described above to a proxy server S₂,
 19 which provides front-end access to the data communication network N.”).) The ’938 patent thus
 20 discloses the receiving step.

21 **ii. accessing from the master database user profile information**
 22 **corresponding to the user id and respective network address**

23 In its infringement contentions, EIT explains that the “accessing” limitation requires “stor[ing] a
 24 personalized online profile that gives users the ability to store and maintain personal information” and
 25 “receiv[ing] the network address of [the user’s] remote host through the HTTP request sent by the client
 26 device.” (Novikov Decl. Ex. 3 at 3, 8.) In its interrogatory responses, EIT also admits that the ’938
 27 patent discloses the accessing step. (Novikov Decl. Ex. 1 at 8-10.) So it does. After the user logs into
 28 the patented system, the proxy server accesses user profile information in a database in order to show the

1 user the most relevant news articles, as depicted in the pertinent
 2 portion of Fig. 10, at right. As the Abstract notes, “[t]he system
 3 . . . evaluates the target profiles [i.e., the possible references to
 4 target information] against the users’ target profile interest
 5 summaries to generate a user-customized rank ordered listing of
 6 target objects most likely to be of interest to each user so that
 7 the user can select from among these potentially relevant target
 8 objects, which were automatically selected by this system from the plethora of target objects that are
 9 profiled on the electronic media.” (Schmandt Decl. Ex. 1 at Abstract.) In describing the various
 10 functions of the proxy server, the specification states: “A second function of the proxy server is to record
 11 user-specific information associated with user U. This user-specific information includes a user profile
 12 and target profile interest summary for user U, as well as a list of access control instructions specified by
 13 user U, as described below, and a set of one-time return addresses provided by user U that can be used to
 14 send messages to user U without knowing user U’s true identity. All of this user-specific information is
 15 stored in a database that is keyed by user U’s pseudonym (whether secure or non-secure) on the proxy
 16 server.” (Schmandt Decl. Ex. 1 at 32:34-44.) The description of the news clipping service embodiment
 17 elaborates further: “When the user requests access to ‘news’ at step **1102**, the profile matching module
 18 **203** resident on proxy server S₂ sequentially considers each search profile p_k from the user’s search
 19 profile set to determine which news articles are most likely of interest to the user.” (Schmandt Decl. Ex.
 20 1 at 57:15-30.)



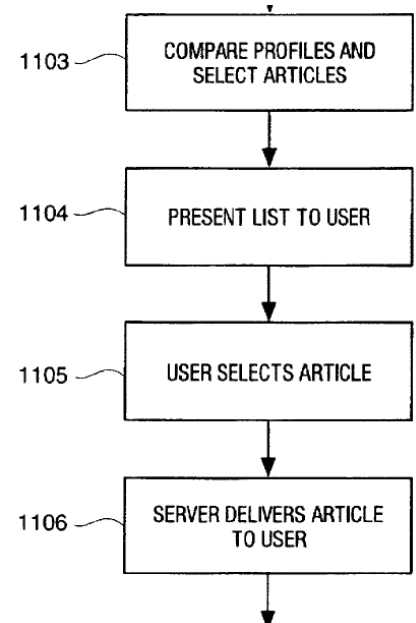
21 The user profile information is contained in a “master database” – a “collection of electronic
 22 information from which user profile information can be accessed.” (ECF No. 134 at 13.) As the
 23 specification explains, “[t]he structure of the user’s *database entry* consists of a user profile as detailed
 24 herein, a target profile interest summary as detailed herein, and a Boolean combination of access control
 25 criteria as detailed below, along with the associated public key for the pseudonym . . .” (Schmandt
 26 Decl. Ex. 1 at 37:39-44 (emphasis added).) The information in the database entries is accessed by a
 27 “database function” resident on the proxy server in order for the system to determine which target objects
 28 to transmit to the user. (Schmandt Decl. at ¶¶ 15-16, 21 n.1, Ex. 1 at 34:27-38.)

1 In addition to storing “a set of one-time return addresses provided by user U that can be used to
 2 send messages to user U without knowing user U’s true identity” with the user profile, the ’938 patent
 3 also “receives the network address of [the user’s] remote host.” (Novikov Decl. Ex. 3 at 8.) The user’s
 4 request transmits a “set of envelopes for the return path,” which can be used by the system to transmit a
 5 return message to the user along the path specified by the envelopes. (Schmandt Decl. ¶ at 12, Ex. 1 at
 6 39:4-7, 46-54.) Since this set of envelopes enables the proxy server to transmit a message back to the
 7 user, it contains a network address for the user. (Schmandt Decl. at ¶ 12.) The specification also
 8 explains that the user terminal and the proxy server are each identified by an IP (“Internet Protocol”)
 9 address on the network through which they communicated. (Schmandt Decl. Ex. 1 at 29:3-8.) As part of
 10 the internet protocol, any message sent over the network contains the originating IP address. (Schmandt
 11 Decl. at ¶ 13.) Thus, the proxy server receives the user’s IP address as part of any request. (*Id.*)

12 **iii. transmitting to the user node, through the master node, a**
 13 **reference to target information corresponding to the accessed**
 14 **user profile**

15 After accessing the user’s profile to determine what articles are most likely to be of interest to the
 16 user, the news clipping embodiment of the ’938 patent transmits a list of those articles to the user. The
 17 user can then select one or more articles from that list, and request that the actual articles be sent to him.
 18 This process is illustrated in the portion of Fig. 10 reproduced below right. The “list” of articles
 19 referenced in step 1104 constitutes a set of “references” transmitted to
 20 the user because they refer to articles that the user can then select and
 21 retrieve. The specification elaborates further:

22 When the user requests access to “news” at step 1102,
 23 the profile matching module 203 resident on proxy server
 24 S2 sequentially considers each search profile pk from the
 25 user’s search profile set to determine which news articles
 26 are most likely of interest to the user. . . . Once the
 27 profile correlation step is completed for a selected user or
 28 group of users, at step 1104 the profile processing
 module 203 stores a list of the identified articles for
 presentation to each user. *At a user’s request, the profile
 processing system 203 retrieves the generated list of
 relevant articles and presents this list of titles of the
 selected articles to the user, who can then select at step
 1105 any article for viewing.*



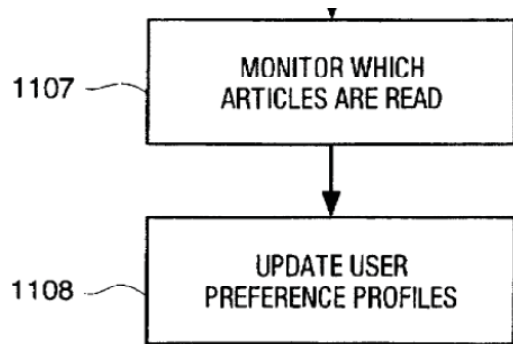
(Schmandt Decl. Ex. 1 at 57:15-58:27 (emphasis added).) The list of articles is transmitted to the user’s computer by the proxy server over a network, using the proxy server’s “network communication function” (the master node). (*See id.*, Schmandt Decl. at ¶¶ 10, 19, Ex. 1 at 34:25-36.) The list “correspond[s] to the accessed user profile” because it consists of “articles . . . most likely of interest to the user,” determined based on the content of that user’s profile. (Schmandt Decl. Ex. 1 at 57:15-58:27.) The ’938 patent therefore meets the “transmitting to the user node, through the master node, a reference to target information corresponding to the accessed user profile” limitation.

This parallels EIT’s infringement contentions. The ’938 patent transmitted a list of articles determined to be of interest to the user based on his profile, which the user could then use to retrieve the articles proper. This is identical in all relevant respects to the alleged functionality EIT identifies in Yelp’s systems: the transmission of HTML links to other web pages selected based on the contents of a user profile. (Novikov Decl. Ex. 3 at 4.)

iv. storing a user report from the user node

EIT’s infringement contentions allege that, with respect to Yelp, the automatic storage of “information related to your use of the [yelp.com] Site, such as the pages you view on the Site, your browser type, IP address, the phone numbers and names of businesses that you call through the Site, requested URL, browser language, referring URL, and the date and time of your visit” constituted “storing a user report from the user node.”

(Novikov Decl. Ex. 3 at 6.) The system described in the ’938 patent likewise automatically updates its user profiles based on the user’s activity on the system. (Schmandt Decl. at ¶ 20, Ex. 1 at 5:26-28.) This is illustrated in the relevant excerpt from Fig. 10, at right. The system collects user feedback, both active (with the user explicitly indicating his or her level of interest in a particular item) and passive (with the system inferring the user’s interest from the user’s behavior on the network). (Schmandt Decl. at ¶ 20, Ex. 1 at 17:18-44.) “Such feedback is stored long term in summarized form, as part of a database of user feedback information” (*Id.*) The feedback summary is transmitted to the proxy server and stored by the proxy server. (*See* Schmandt Decl. at ¶ 20, Ex. 1 at 40:37-51 (“A summary of such relevance feedback



1 information . . . is periodically transmitted through a secure mix path to the proxy server **S2**, whereupon
2 the search profile generation module **202** resident on server **S2** updates the appropriate target profile
3 interest summary associated with pseudonym P”) The user’s profile is updated with the
4 information “to reflect the user’s changing interests” so that future personalized results for the user
5 reflect the new interest information obtained from the user’s feedback. (Schmandt Decl. at ¶ 20, Ex. 1 at
6 6:56-58.) Thus, the information stored by the ’938 patent as feedback constitutes a user report.

7 **b. Claim 40.**

8 The ’938 patent anticipates claim 40 for largely the same reasons it anticipates claim 41. The
9 relevant differences between the two claims are discussed below.

10 **i. Preamble.**

11 EIT concedes that the ’938 patent discloses “a master program module coupled to a master node
12 and a master database for connecting information providers and user nodes for a computer network.”
13 (Novikov Decl. Ex. 1 at 8-10.) The ’938 specification discloses a master program in the form of a proxy
14 server. The proxy server is the brain of the patented system, performing the intelligent functions of
15 verifying the user’s identity and reading the user’s profile to determine what references to transmit to the
16 user, as well as receiving the user id and transmitting references to target information. (Schmandt Decl.
17 at ¶ 14, Ex. 1 at 32:20-50.) It is therefore the analog of the “master program” in the ’837 patent.
18 (Schmandt Decl. at ¶ 14.) As discussed for claim 41 above, the proxy server is coupled to a master
19 node in the form of a “network communication function” through which the proxy server establishes a
20 “pseudonymous data communications connection” over a network, and to a master database that stores
21 user profile information. (*Supra* at 10.)

22 **ii. means for registering a first-time user of the computer network**

23 Claim 40 contains a “registering” step” not present in claim 41. EIT concedes that this claim step
24 is present in the ’938 patent. (Novikov Decl. Ex. 1 at 8-10.) The specification bears out EIT’s
25 admission. The user registers with the system upon first access in order to receive a pseudonym, or to
26 register a preexisting pseudonym with this particular service. (*See* Schmandt Decl. at ¶ 11, Ex. 1 at
27 37:66-38:4 (“Once a proxy server **S2** has authenticated and registered a user’s pseudonym, the user may
28 begin to use the services of the proxy server **S2**.”), claim 1.)

iii. means for receiving, through the master node, a user id and respective network address corresponding to a current user of the user node

The Court construed the corresponding structure for the means for receiving to be the master program. Claim 40’s “receiving” step is similar to the receiving step of claim 41, but contains the additional requirement that a “respective network address” for the user be received along with the user id. The ’938 patent discloses this limitation. When the user logs into the system, he transmits several pieces of information to the proxy server, including his pseudonym (user id), and a “set of envelopes for the return path,” which could be used by the system to transmit a return message to the user along the path specified by the envelopes. (Schmandt Decl. at ¶ 12, Ex. 1 at 39:4-7, 46-54.) Since this set of envelopes enables the proxy server to transmit a message back to the user, it contains a respective network address corresponding to the user. (Schmandt Decl. at ¶ 12.) Additionally, the ’938 patent explains that both the user’s terminal and the proxy server have IP addresses to enable communication between the two: “Each user terminal $T_1 - T_n$ and the information servers $I_1 - I_m$ have phone numbers or IP addresses on the network N which enable a data communication link to be established between a particular user terminal $T_1 - T_n$ and the selected information server $I_1 - I_m$.” (Schmandt Decl. Ex. 1 at 29:3-8.) As part of the internet protocol, any message sent between the user terminal and the proxy server – including the “log-in” message transmitting the user’s pseudonym – would include the originating IP address. (Schmandt Decl. at ¶ 13.) The patented system therefore receives “a user id and respective network address corresponding to a current user of the user node.”

iv. means for accessing from the master database user profile information corresponding to the user id

In its infringement contentions EIT explains that the “means for accessing” limitation requires “stor[ing] a personalized user profile that gives users the ability to store and maintain personal information” and “receiv[ing] the network address of [the user’s] remote host through the HTTP request sent by the client device.” (Novikov Decl. Ex. 1 at 8-10.) EIT further concedes that this limitation is present in the ’938 patent. *Id.* And those concessions were correct for the reasons discussed above with respect to claim 41.

///

v. **means for transmitting to the user node, through the master node, a reference to target information corresponding to the accessed user profile**

The Court held that the corresponding structure for the “means for transmitting” is a “master program.” As discussed in relation to claim 41 above, the “transmitting” step was performed by the proxy server – the ’938 patent’s master program analog. The remaining limitations of this element are addressed above with respect to claim 41.

vi. **means for storing a user report from the user node**

Here, too, the Court held that the corresponding structure for the means for storing is a “master program,” which is the proxy server, and the remaining issues concerning this limitation have been addressed above.

2. **The Freshman Fishwrap Anticipates Claims 40 and 41.**

The Freshman Fishwrap personalized newspaper service (hereafter “Fishwrap”), in public use at the Massachusetts Institute of Technology more than one year prior to the ’837 patent’s priority date, provided registered users with a personalized set of links to articles it determined to be of interest to those users based on their user profiles. In so doing, it also anticipated every element of both asserted claims.

a. **Fishwrap was in public use more than one year prior to the ’837 patent’s priority date.**

Pascal Chesnais was the MIT Research Specialist who supervised Fishwrap’s development, as well as the individual who wrote much of its code. (Chesnais Decl. at ¶¶ 12-13.) He also used the system on a near-daily basis from its inception until the end of his tenure at the MIT Media Lab. (*Id.* at ¶ 14.) Fishwrap went online at MIT in October 1993, and contained all of the features described here more than a year before the priority date of the ’837 patent. (*Id.*)

Dr. Chesnais’ testimony is amply corroborated by the contemporaneous documentary evidence cited throughout this motion and in his declaration, both as to Fishwrap’s functionalities and its public use. A paper published by Chesnais and two co-authors in June 1995 explains that the Fishwrap system had been in use in the MIT community “[s]ince the fall of 1993.” (Chesnais Decl. at ¶ 10, Ex. F at 1.) The MIT thesis describing the project, its use, and its functionality was written and submitted to MIT in

1 May 1994. (Chesnais Decl. at ¶ 9, Ex. E at 16 *et seq.*) Dr. Chesnais made a presentation describing the
2 system in December of 1993. (Chesnais Decl. at ¶ 7, Ex. C.) There can be no legitimate dispute that
3 Fishwrap was in public use more than one year prior to the '837 patent's priority date of April 15, 1996.

4 **b. Claim 41.**

5 EIT concedes that Fishwrap was “a method for connecting information providers and user nodes
6 coupled to a master node and a master database.” (Novikov Decl. Ex. 1 at 8-10.) The “nerve center” of
7 the Fishwrap system was the Glue application framework, which was “composed of interrelated
8 components that assemble an individual's news” based on that individual's user profile. (Chesnais Decl.
9 at ¶ 16, Ex. F 1.) Glue accessed user profile information from a library of files called Dtypes, which
10 constituted a collection of electronic information from which the user profile information could be
11 accessed – i.e., a “master database.” (Chesnais Decl. at ¶ 39, Ex. E at 20.) Glue received log-in
12 information and transmitted links to news articles through a web server, and was thus “coupled to a
13 master node.” (See Chesnais Decl. at ¶¶ 21, 34, 42-44, Ex. F at 1 (“Access to Fishwrap's personalized
14 news system appears as a World Wide Web (WWW) hypertext link . . . [S]tudents can get Fishwrap
15 from any computer connected to the MIT network . . . with a WWW browser.”).)

16 **i. receiving through the master node a user id corresponding to a**
17 **current user of the user node**

18 One way to access Fishwrap was to log in to one of 400 Athena workstations distributed around
19 the MIT campus. (Chesnais Decl. at ¶ 20, Ex. E at 18-19 (“The most commonly used front-end
20 application (or interface) to Fishwrap was the HTML version, which was accessed on the Athena
21 network through an application called Mosaic.”).) In order to log into an Athena workstation, a user
22 would need to enter his/her Athena user name. Once the user logged into the MIT workstation and
23 selected Fishwrap, the user's user name would authenticate the user to Fishwrap as a member of the MIT
24 community. (Chesnais Decl. at ¶¶ 21-25, Ex. F at 5 (“The server verifies that the user is authorized to
25 access our service.”).) This interaction occurred through the Fishwrap web server. (Chesnais Decl. at ¶
26 21, Ex. F at 5 (“The Fishwrap user begins his or her session by connecting to our WWW servers.”).)

27 Fishwrap therefore received a user id corresponding to a current user of the user node, through the
28 Fishwrap web server – i.e., a “point of connection” into the MIT network, or a “master node.”

ii. **accessing from the master database user profile information corresponding to the user id and respective network address**

As discussed with respect to the '938 patent, EIT's infringement contentions explain that this limitation requires "stor[ing] a personalized user profile that gives users the ability to store and maintain personal information" and "receiv[ing] the network address of [the user's] remote host through the HTTP request sent by the client device." (Novikov Decl. Ex. 3 at 8.) Fishwrap contained these functionalities. The Glue module stored user profile information in a data structure consisting of a library of files called Dtypes. (Chesnais Decl. at ¶ 39, Ex. F at 4.) Each user was associated with a Dtype. (Chesnais Decl. at ¶¶ 28, 39; Schmandt Decl. at ¶ 26.) The Dtype contained information about the user, including the information initially obtained through the registration process (such as hometown and major), any other biographical information the user may have provided, the user's topic subscriptions, and observations from the user's Fishwrap activity, such as what articles the user has read and what topics the user has accessed. (Chesnais Decl. at ¶¶ 28, 36, 39, Ex. F at 4 ("Fishwrap maintains a number of data structures, the most important being the 'user profile' . . . This Dtype has all the personal and global topic subscriptions, biographical information, and the reader's home town information.")) The Dtype library was therefore "a collection of electronic information from which user profile information can be accessed" – i.e., a "master database" as construed by the Court. (Chesnais Decl. at ¶ 39; Schmandt Decl. at ¶ 26.) (ECF No. 134 at 13.)

Upon being queried by a user for a personalized newspaper, Glue accessed that user's profile information from the library, and used it to select links to articles to present to the user. (Chesnais Decl. at ¶ 41, Ex. E at 17 ("Article selection is performed by an extensible application framework called 'Glue', which takes care of interactions with the user modeling system, news database article retrieval, knowledge representation, and article topic designation.")) User profile information was utilized in various ways. For example, the hometown information stored in the user's profile would be accessed in order to generate a "regional" news section of the user's personalized newspaper. (Chesnais Decl. at ¶ 38, Ex. C at 12.) Glue would also access the user's topical preferences, both those explicitly specified by the user and those implicitly derived from the user's activity, in order to determine what topics and articles to present to the user. (Chesnais Decl. at ¶¶ 30-31, 36-37, Ex. E at 21.) For example, if a user

1 frequently read articles about sports, then articles about sports might be presented at the top of the list of
2 suggested articles. (Chesnais Decl. at ¶ 37, Ex. F at 6 (“While a person is reading their paper, the system
3 observes and records his/her behavior. On subsequent generations, those sections and topic filters that
4 the users paid the most attention to in the past will appear closer to the top of their paper.”).)

5 In addition, Fishwrap “receiv[ed] the network address of [the user’s] remote host through the
6 HTTP request sent by the client device.” (Novikov Decl. Ex. 3 at 8.) Since Fishwrap was accessed
7 through the World Wide Web, it would “receive the network address of the remote host through the
8 HTTP request sent by the client device.” (Schmandt Decl. at ¶ 13.) Indeed, as part of the log-in process,
9 Fishwrap received the user’s IP address and verified that it came from a computer associated with MIT.
10 (Chesnais Decl. at ¶¶ 21-25.) Fishwrap therefore practiced the “accessing” step.

11 **iii. transmitting to the user node, through the master node, a**
12 **reference to target information corresponding to the accessed**
13 **user profile**

14 As discussed above, upon being queried for a personalized newspaper, Fishwrap’s Glue module
15 transmitted to the user, through its web server, a series of links to articles it deemed to be of interest to
16 that user. (Chesnais Decl. at ¶¶ 41-45.) The main page initially presented to the user “shows which
17 [category] filters have found news content. The reader can then focus in on that news category and see
18 summaries of stories that matched the filter. If an article summary seems interesting, the reader can
19 expand on it - getting the full text and relevant graphics or audio augmentation.” (Chesnais Decl. at ¶¶
20 43-45, Ex. F at 1-2.) Below is an illustration of such a personalized newspaper:



(Chesnais Decl. at ¶ 44, Ex. F at 2.) The page on the left consists of a set of links to categories of interest to the user. The middle page consists of links to articles determined to be of interest to the user, which the user can reach by clicking on one of the categories (in this case “OK News” for Oklahoma). In the web page shown on the right, the user has reached a particular article of interest.

Both the links to the category pages and the links to the articles constitute “references” within the meaning of the ’837 patent. As the Court explained in its Claim Construction Order, the “patent used the term [“reference”] generally to mean something that refers to something else.” (ECF No. 134 at 7.) Both sets of links “refer” the user to something else – either another page of links of interest to the user, or a news article of interest to the user. The references further correspond to the accessed user profile because they were determined to be of interest to the user based on information contained that user’s profile. (*Supra* at 19-20; Chesnais Decl. at ¶ 41.) And they were transmitted to the user through Fishwrap’s web server, which functioned as a “point of connection into a network, through which items are transmitted and received, to facilitate communication between an information provider and a user node” – i.e., a master node. (Chesnais Decl. at ¶ 17, Ex. E at 18-19 (noting that Fishwrap was most commonly accessed in HTML through the Mosaic web browser).)

This is also consistent with EIT’s infringement contentions against Yelp. EIT accuses HTML links provided by Yelp on its website, and alleges that they are selected based on information and preferences contained in a user profile. (Novikov Decl. Ex. 3 at 4.) EIT contends that these links

1 infringe whether they point to “target information servers stored within the Yelp network or stored within
2 external networks such as advertising or content networks.” (*Id.*) EIT cannot both assert that providing
3 allegedly personalized HTML links on a web site meets the “transmitting” limitation and argue that the
4 same functionality in the prior art does not anticipate.

5 **iv. storing a user report from the user node**

6 Fishwrap’s Glue module stored information about the user’s activity on the system for later use.
7 (Chesnais Decl. at ¶¶ 32-38.) “Another aspect of the implementation of the algorithm is the gray arrow
8 labeled ‘feedback’ that comes from the front-end application back into the Fishwrap’s back-end code.²
9 This feedback loop represents the insertion of information derived from the user’s reading session into
10 the determination of the structure of future editions of the newspaper.” (Chesnais Decl. at ¶ 34, Ex. E at
11 19-20.) Fishwrap would record “each time a user entered a new section of his paper . . . as well as each
12 time he opened up a news article.” (Chesnais Decl. ¶ 35, Ex. E at 22.) This feedback was initially stored
13 in temporary files in the user’s browser (i.e., on the user node), and then incorporated into the user profile
14 on the server the next time the user requests a personalized newspaper. (Chesnais Decl. at ¶¶ 35-36, Ex.
15 E at 22-24, Ex. L.) The feedback recorded had an immediate effect on future requests for a new edition
16 of the personalized newspaper. (Chesnais Decl. at ¶ 36-37, Ex. E at 24, Fig. 3.6.)

17 The information stored by Fishwrap as feedback constitutes a user report. As with the ’938
18 patent, this is consistent with EIT’s infringement contentions, which allege that storing information about
19 the user’s activity on the network constituted storing a user report.

20 **c. Claim 40.**

21 Fishwrap anticipates claim 40 for the same reasons that it anticipates claim 41. The relevant
22 differences are highlighted below.

23 **i. Preamble.**

24 EIT concedes that Fishwrap contained a “master program module coupled to a master node and a
25 master database for connecting information providers and user nodes for a computer network.” (Novikov
26

27 ² The “gray arrow” referenced in the quote can be seen at Fig. 3.2 in the Fishwrap Thesis. (Chesnais
28 Decl. Ex. E at 18.) The figure illustrates, among other things, that the “feedback” was received and
stored by the Glue module.

Decl. Ex. 1 at 8-10.) Fishwrap’s equivalent of a “master program module” was the Glue application framework, which was responsible for authenticating the user, accessing his profile, and using its contents to assemble the user’s personalized newspaper. (Chesnais Decl. at ¶ 16, Ex. E at 17-20.) Glue was coupled to a “master database” (its Dtype library) and received and sent information through a master node (its web server). (*Supra* at 18.)

ii. means for registering a first-time user of the computer network

EIT also concedes that Fishwrap included the means for registering. And that limitation is demonstrably present. A member of the MIT community had to register in order to use the Fishwrap service for the first time:

Access to Fishwrap’s personalized news system appears as a World Wide Web (WWW) hypertext link. This link calls upon programs to subscribe the individual to the news service. At this time an individual access password is provided.

(Chesnais Decl. at ¶¶ 18-19, 26-27, Ex. F at 1.) The registration process included filling out a registration form that required the user to answer questions such as “Where are you from?” and “What majors interest you?” so that the system could later customize the user’s newspaper based on his answers. (Chesnais Decl. at ¶¶ 26-27, Ex. F at 1.) Fishwrap therefore contained “means for registering a first-time user of the computer network.”

iii. means for receiving, through the master node, a user id and respective network address corresponding to a current user of the user node

The Court held that the corresponding structure for the “means for receiving” is a “master program.” As discussed in relation to claim 41 above, the “receiving” step was performed by the Glue module, which was Fishwrap’s “master program” analog. Claim 40’s additional requirement that the system receive the user’s respective network address as well as his user id is met here, as already discussed in relation to claim 41’s “accessing” limitation above. To reiterate, as part of Fishwrap’s login process, the system would receive the user’s IP address and verify that it came from a computer associated with MIT. (Chesnais Decl. at ¶¶ 21-25, Ex. F at 5.) The user id and IP address “correspond[ed] to a current user of the user node” because they were associated with the current user of the Athena workstation. (*Id.* at 1.)

1 **iv. means for accessing from the master database user profile**
2 **information corresponding to the user id**

3 Glue accessed user profile information corresponding to the user id from the Dtypes, as discussed
4 above with respect to claim 41. Though “means for accessing” was not construed by the Court, EIT may
5 argue that the corresponding structure for the means for accessing is an “SQL server,” and thus that
6 Fishwrap would need to have a “SQL server” in order to invalidate. However, Fishwrap discloses an
7 equivalent of an SQL server that falls within the scope of the claim limitation. In order to show statutory
8 equivalence under § 112 ¶ 6, Yelp must show that the function of the substitute structure is identical, and
9 that the “way” the structure performs the claimed function and the “result” of that performance are
10 substantially similar. *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1268 (Fed. Cir. 1999).

11 SQL, or Structured Query Language, is a programming interface for databases that had been
12 developed and commercialized by the early 1980s. (Schmandt Decl. at ¶ 28.) The Sybase SQL server
13 (the specific technology referenced in the ’837 patent’s preferred embodiment) was simply an out-of-the-
14 box server platform for managing large databases using SQL, commercially available and in widespread
15 use in 1996. (*Id.*) As used in the ’837 patent, an SQL server is therefore merely one commercially
16 available and commonly used database platform equipped to query a database using Standard Query
17 Language, with the result that the desired block of information is retrieved. (Schmandt Decl. at ¶¶ 26-
18 29.)

19 As a matter of design choice, Fishwrap did not use an SQL server. (Chesnais Decl. at ¶ 40.)
20 Instead, Fishwrap used a library of datatype objects, or Dtypes. (*Supra* at 18-19.) By accessing the
21 correct Dtype from its library, Fishwrap performed the function of “accessing from the master database
22 user profile information corresponding to the user id.” And it did so in a substantially similar way, with a
23 substantially similar result to the ’837 patent’s SQL server – by looking up the appropriate Dtype for the
24 user and retrieving a chunk of data keyed to the user id. (Schmandt Decl. at ¶ 25-26.) As the ’837
25 specification itself noted, “one of ordinary skill in the art can easily substitute the Sybase SQL-Server
26 with other similar database technology.” (Novikov Decl. Ex. 2 at 3:51-53.) The use of Dtypes in
27 Fishwrap is nothing more than such a substitution. (Schmandt Decl. at ¶¶ 25-29.)

28 Even if it were not equivalent, an SQL Server would be an obvious modification. “A patent may

1 not be obtained...if the differences between the subject matter sought to be patented and the prior art are
 2 such that the subject matter as a whole would have been obvious at the time the invention was made to a
 3 person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103. Even if a
 4 given reference is not anticipatory, the combination of familiar elements according to known methods is
 5 likely to be obvious when it does no more than yield predictable results. *KSR Int’l Co v. Teleflex, Inc.*,
 6 550 U.S. 398, 418-19 (2007). One of ordinary skill in the art, faced with the problem of how to store and
 7 access user profile information, would have known how to implement a system using an SQL server.
 8 (Schmandt Decl. at ¶¶ 27-31; Chesnais Decl. at ¶ 40.) Indeed, given the prominence of database
 9 software and broadly available commercial platforms like the Sybase SQL Server, doing so would have
 10 been the obvious choice – even more so than a Dtype library. (Schmandt Decl. at ¶¶ 28-29; Chesnais
 11 Decl. at ¶ 40.) There can be no legitimate dispute that SQL servers were known in the art in 1996, and
 12 that one of ordinary skill in the art would have known that user profile information could be accessed by
 13 a SQL server. Thus, even if the “means for accessing” limitation requires the structure of an SQL server,
 14 implementing such a structure would have been an obvious modification to the Fishwrap system.
 15 (Schmandt Decl. at ¶¶ 27-31; Chesnais Decl. at ¶ 40.)

16 **v. means for transmitting to the user node, through the master**
 17 **node, a reference to target information corresponding to the**
 18 **accessed user profile**

18 The Court held that the corresponding structure for the “means for transmitting” is a “master
 19 program.” As discussed in relation to claim 41 above, the “transmitting” step was performed by the Glue
 20 module, which was Fishwrap’s “master program” analog. The remaining limitations of this element are
 21 addressed above with respect to claim 40.

22 **vi. means for storing a user report from the user node**

23 Here, too, the Court held that the corresponding structure for the means for storing is a “master
 24 program” and the remaining limitations have been addressed above.

25 **CONCLUSION**

26 For the reasons discussed above, Yelp respectfully requests an order granting summary judgment
 27 that claim 40 is invalid for indefiniteness, and that both claims 40 and 41 are anticipated and/or rendered
 28 obvious by the prior art discussed in this motion.

1 Dated: November 18, 2011

DURIE TANGRI LLP

2
3 By: /s/ Eugene Novikov
 EUGENE NOVIKOV

4 Attorneys for Defendant and Counterclaim
5 Plaintiff YELP! INC.
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1 DURIE TANGRI LLP
2 DARALYN J DURIE (SBN 169825)
3 ddurie@durietangri.com
4 RYAN M. KENT (SBN 220441)
5 rkent@durietangri.com
6 EUGENE NOVIKOV (SBN 257849)
7 enovikov@durietangri.com
8 217 Leidesdorff Street
9 San Francisco, CA 94111
10 Telephone: 415-362-6666
11 Facsimile: 415-236-6300

12 Attorneys for Defendant and Counterclaim Plaintiff
13 YELP! INC.

14
15 IN THE UNITED STATES DISTRICT COURT
16 FOR THE NORTHERN DISTRICT OF CALIFORNIA
17 SAN FRANCISCO DIVISION

18 EIT HOLDINGS, LLC, a Delaware company

19 Plaintiff and Counterclaim Defendant,

20 v.

21 YELP! INC., a Delaware corporation

22 Defendant and Counterclaim Plaintiff.

Case No. 3:10-cv-05623-WHA

**[PROPOSED] ORDER GRANTING YELP!
INC.'S MOTION FOR SUMMARY
JUDGMENT OF INVALIDITY**

Date: January 19, 2012

Time: 8:00 a.m.

Ctrm: 8, 19th Floor

Judge: Honorable William Alsup

1 Yelp! Inc. (“Yelp!”) has moved for summary judgment that Claim 40 of U.S. Patent No.
2 5,828,837 is invalid pursuant to 35 U.S.C. § 112, and that claims 40 and 41 of the U.S. Patent No.
3 5,828,837 are invalid pursuant to 35 U.S.C. §102 and/or § 103. Having considered Yelp!’s Motion, the
4 papers in support and opposition, arguments of counsel, and all other matters presented to the Court,
5 Yelp!’s Motion for Summary Judgment of Invalidity is GRANTED.

6 The ’837 Asserted Claims are hereby DECLARED invalid.

7 SO ORDERED.

8 Dated: _____

HONORABLE WILLIAM ALSUP
UNITED STATES DISTRICT JUDGE

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Motions

[3:10-cv-05623-WHA EIT Holdings LLC v. Yelp!, Inc. et al](#)

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Northern District of California
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Case Name: EIT Holdings LLC v. Yelp!, Inc. et al

Case Number: [3:10-cv-05623-WHA](#)

File: Yelp!, Inc.

Document Number: [135](#)

Docket Text:
MOTION for Summary Judgment *Yelp! Inc.'s Motion for Summary Judgment of Invalidity* filed by Yelp!, Inc.. Motion Hearing set for 1/19/2012 08:00 AM in Courtroom 9, 19th Floor, San Francisco before Hon. William Alsup. Responses due by 12/2/2011. Replies due by 12/9/2011. (Attachments: # (1) Proposed Order)(Novikov, Eugene) (Filed on 11/18/2011)

3:10-cv-05623-WHA Notice has been electronically mailed to:

Alisa Anne Lipski alipski@gfpiplaw.com, alipski@gviplaw.com

Daralyn J. Durie ddurie@durietangri.com, docketing@durietangri.com

Edward W. Goldstein egoldstein@gliplaw.com, jvillegas@gviplaw.com, vhernandez@gliplaw.com

Eugene Novikov enovikov@durietangri.com

Harry Lee Laxton, Jr hlaxton@gliplaw.com

Jesse Geraci jgeraci@durietangri.com, jcotton@durietangri.com, records@durietangri.com

Jody M. Goldstein jgoldstein@gfpiplaw.com

Mark W. Good mgood@terra-law.com, bomahoney@terra-law.com

P.J. Benedict O'Mahoney bomahoney@terralaw.com, dmalone@gviplaw.com

Ryan Marshall Kent rkent@durietangri.com, docketing@durietangri.com, jcotton@durietangri.com, records@durietangri.com

3:10-cv-05623-WHA Please see [General Order 45 Section IX C.2 and D](#); Notice has NOT been electronically mailed to:

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[STAMP CANDStamp_ID=977336130 [Date=11/18/2011] [FileNumber=8041039-0]

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