

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

| | | |
|----------------------|---|------------------------------------|
| LEXOS MEDIA IP, LLC, | § | |
| | § | |
| v. | § | Civil Action No. 2:22-CV-00169-JRG |
| | § | (Lead Case) |
| AMAZON.COM, INC. | § | |

| | | |
|----------------------|---|------------------------------------|
| LEXOS MEDIA IP, LLC, | § | |
| | § | |
| v. | § | Civil Action No. 2:22-CV-00175-JRG |
| | § | (Member Case) |
| TARGET CORPORATION | § | |

| | | |
|----------------------|---|------------------------------------|
| | § | |
| LEXOS MEDIA IP, LLC, | § | |
| | § | Civil Action No. 2:22-CV-00273-JRG |
| v. | § | (Member Case) |
| | § | |
| OFFICE DEPOT, LLC. | § | |

**DEFENDANTS' P.R. 3-3 INVALIDITY CONTENTIONS
AND INELIGIBILITY CONTENTIONS**

TABLE OF CONTENTS

| | <u>Page</u> |
|--|-------------|
| I. Introductory Statement | 1 |
| II. Asserted Patents and Claims | 2 |
| III. Claim Construction | 4 |
| IV. P.R. 3-3(a) – Identification of Prior Art | 5 |
| A. Prior Art Patents..... | 5 |
| B. Prior Art Publications | 6 |
| C. Prior Art Sales/Public Uses..... | 7 |
| V. Primary References | 7 |
| A. U.S. Patent No. 6,437,800 (“Malamud”)..... | 8 |
| B. U.S. Patent No. 5,715,416 (“Baker”)..... | 9 |
| C. U.S. Patent No. 5,565,888 (“Selker”)..... | 9 |
| D. U.S. Patent No. 5,898,432 (“Pinard”)..... | 10 |
| E. U.S. Patent No. 5,898,419 (“Liu”)..... | 10 |
| F. U.S. Patent No. 5,463,728 (“Blahut”)..... | 11 |
| G. U.S. Patent No. 6,016,137 (“Evans”)..... | 12 |
| H. The Partial-Occlusion Effect: Utilizing Semitransparency in 3D Human- Computer Interaction (“Zhai”)..... | 12 |
| I. U.S. Patent No. 6,184,859 (“Kojima”) | 13 |
| J. U.S. Patent No. 5,801,704 (“Oohara”)..... | 13 |
| K. U.S. Patent No. 5,784,056 (“Nielsen ’056”)..... | 14 |
| VI. State of the Art and Obviousness..... | 15 |
| A. General Motivations for Making Combinations of Prior Art | 16 |
| B. Exemplary Combinations and Motivations for Making Combinations of Prior Art | 23 |
| 1. Exemplary Combinations for Claim 72 of the ’102 patent and Claim 53 of the ’449 patent..... | 23 |
| 2. Exemplary Combinations for Claims 1, 27 and 38 of the ’449 patent | 27 |
| C. Secondary Considerations..... | 31 |
| VII. P.R. 3-3(c) – Claim Charts | 32 |
| VIII. P.R. 3-3(d) – Invalidity Under 35 U.S.C. § 112 | 33 |
| A. Indefiniteness | 33 |

| | | |
|-----|---|----|
| B. | Lack of Written Description and/or Enablement | 36 |
| IX. | PATENT INELIGIBILITY UNDER 35 U.S.C. § 101 | 38 |

EXHIBITS, APPENDICES AND ATTACHMENTS

| | |
|--------------------------|--|
| Exhibits A1 – A11 | Invalidity Claim Charts for Primary References for '102 Patent |
| Exhibits B1 – B11 | Invalidity Claim Charts for Primary References for '449 Patent |
| Appendix A | Additional References and Obviousness Chart for '102 Patent |
| Appendix B | Additional References and Obviousness Chart for '449 Patent |
| Attachment A | Subject-Matter Eligibility Contentions for '102 Patent |
| Attachment B | Subject-Matter Eligibility Contentions for '449 Patent |

Pursuant to P.R. 3-3, the Court’s Docket Control Order (Dkt. 48) as modified by its November 1, 2022 Order (Dkt. 54), and its Standing Order Regarding Subject Matter Eligibility Contentions, Defendants Amazon.com, Inc., Office Depot, LLC, and Target Corp. (collectively, “Defendants”) hereby provide these P.R. 3-3 Invalidity Contentions (“Invalidity Contentions”) and Subject-Matter Ineligibility Contentions (“Ineligibility Contentions”) to Plaintiff Lexos Media IP, LLC (“Plaintiff” or “Lexos”).

I. INTRODUCTORY STATEMENT

These Invalidity and Ineligibility Contentions are based on Defendants’ current knowledge and understanding of U.S. Patent Nos. 5,995,102 and 6,118,449 (collectively, “the Asserted Patents”) and the prior art, along with Defendants’ understanding of Plaintiff’s infringement allegations and apparent claim interpretations based on those allegations, as set forth in Plaintiff’s Disclosure of Asserted Claims and Infringement Contentions (“Infringement Contentions”). These Invalidity and Ineligibility Contentions should not be construed to waive any objections to Plaintiff’s Infringement Contentions or as an admission that the Infringement Contentions were adequate or that Plaintiff’s apparent claim interpretations are correct, have merit, or should be adopted. Indeed, Plaintiff’s Infringement Contentions are deficient and fail to describe the accused functionality and Plaintiff’s interpretation of the claim language in a manner that would allow Defendants to fully respond, including in these invalidity contentions. Defendants expressly reserve the right to amend these contentions based on amendments to Plaintiff’s Infringement Contentions or when Plaintiff specifies its theories with greater clarity. Additionally, and as further explained below, where these Invalidity Contentions disclose that a prior art reference meets a claim limitation, such position may be based on Plaintiff’s apparent claim interpretations in its Infringement Contentions; Defendants do not necessarily agree that such interpretations are correct, have merit, or should be adopted.

Defendants’ investigation of the Asserted Patents, their file histories, and the prior art is ongoing, and Defendants expressly reserve the right to supplement these Invalidity and Ineligibility Contentions based on further discovery and in a manner consistent with the Federal Rules of Civil Procedure, the Local Patent Rules for the Eastern District of Texas, and any Docket Control Order, or otherwise in accordance with any order or direction of this Court or agreement of the parties. Defendants’ ongoing investigation includes, but is not limited to, serving subpoenas on prior artists and inventors regarding prior art, seeking additional information related to the references and prior art systems disclosed in these Invalidity and Ineligibility Contentions, seeking additional information regarding Plaintiff’s Infringement Contentions and the products and services accused of infringement, and seeking information regarding any prior sales and/or uses by the original assignees of the Asserted Patents. Defendants also reserve the right to rely on any prior art identified or disclosed by non-parties to this action that are involved in a suit or action involving one or more of the Asserted Patents, as well as any prior art produced or disclosed during the course of this litigation. Additionally, Defendants have not yet had the benefit of taking the depositions of the named inventors or those that worked with the named inventors, or of the named inventors, authors, and entities listed on any references or systems identified in these Invalidity Contentions.

II. ASSERTED PATENTS AND CLAIMS

Plaintiff asserts the following claims from the Asserted Patents (collectively, “the Asserted Claims”):

| Asserted Patent | Asserted Claims |
|------------------------|------------------------|
| ’102 patent | 72 |
| ’449 patent | 1, 38, 53 |

Plaintiff asserts a priority date for the '102 and '449 patents of June 25, 1997. Reference to an “asserted priority date” should not be construed to mean that Defendants agree that the Asserted Patents are in fact entitled to such priority dates, or that Plaintiff has provided proper notice as to its contentions for priority dates.

P.R. 3-2(b) requires Plaintiff to produce, contemporaneously with its Disclosure of Asserted Claims and Infringement Contentions,” “[a]ll documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified pursuant to P.R. 3-1(e), whichever is earlier.” Other than copies of the Asserted Patents and their file histories, Plaintiff did not produce any documents pursuant to P.R. 3-2(b). Defendants thus understand that Plaintiff is not asserting an invention date, or conception, reduction to practice, design, and/or development of the claimed invention, prior to the asserted priority dates identified above. To the extent Plaintiff later alleges that any such activities occurred prior to the priority dates identified above, Defendants reserve the right to object to such belated changes in position and/or to supplement these Invalidity Contentions to address any such contention, including by identifying and/or charting additional prior art that may become relevant in view of such assertion. Likewise, to the extent Plaintiff successfully establishes an invention date before any of the prior-art references relied on by Defendants, then those references serve as evidence of secondary considerations of obviousness, particularly, contemporaneous invention by others. To the extent Plaintiff alleges that any prior art relied on in these Invalidity Contentions does not actually qualify as prior art to the Asserted Patent, Defendants reserve the right to rebut those allegations (*e.g.*, by demonstrating an earlier critical date for the challenged prior art and/or a later priority date and/or date of invention for a particular Asserted Claim). Defendants also reserve the right to rely on additional documents, information, and evidence to demonstrate public availability or public

availability by a certain date of a prior art reference or to rebut any efforts by Plaintiff to allege any reference was not publicly available or publicly available by a certain date or otherwise available as prior art.

For purposes of these contentions, Defendants address only those claims specifically asserted by Plaintiff. Defendants reserve the right to amend or supplement this disclosure as necessary in view of any changes or amendments made, for any reason, to Plaintiff's infringement theories, infringement contentions, or Asserted Claims, including to Plaintiff's asserted priority and/or invention date(s).

III. CLAIM CONSTRUCTION

To the extent these Invalidity Contentions rely on or otherwise embody particular constructions of terms or phrases in the Asserted Claims, Defendants are not conceding that any such constructions are proper. For purposes of these Invalidity Contentions, Defendants may adopt alternative claim construction positions. In particular, portions of these Invalidity Contentions, including the claim charts attached as exhibits and appendices, may be based on the underlying claim constructions and/or interpretations in Plaintiff's Infringement Contentions, to the extent such constructions and/or interpretations are understood by Defendants. Defendants do not concede that any such constructions or interpretations by Plaintiff are proper, and expressly reserve the right to contest any such constructions. Defendants may also rely on the claim construction order and opinion issued in *Lexos Media IP, LLC v. APMEX, Inc.*, No. 2:16-CV-00747-JRG, 2017 WL 1021366 (E.D. Tex. Mar. 16, 2017) ("*Lexos I*").

Throughout the attached Exhibits and Appendices, Defendants provide examples of where references disclose subject matter recited in preambles, without regard to whether the preambles are properly considered to be limitations of the Asserted Claims. Defendants reserve the right to argue, at the appropriate stage of this case, that the preambles are or are not limitations. Further,

the fact that Defendants provide examples of any limitation does not mean that Defendants believe that the limitation is defined, or otherwise enabled, or comports with the requirements of the patent statute, including, but not limited to, 35 U.S.C. § 112.

Nothing disclosed herein is an admission or acknowledgement that any of Defendants' products or services infringes any of the Asserted Claims. Defendants reserve the right to supplement, modify, or otherwise amend these Invalidity Contentions, including based on the Court's claim construction rulings or opinions or the parties' positions or arguments taken in connection with the claim construction process. Moreover, Defendants reserve the right to rely on any disclosures in the accompanying P.R. 3-4(b) production as it believes necessary in view of positions Plaintiff may take with respect to the scope and meaning of the Asserted Claims.

IV. P.R. 3-3(a) – IDENTIFICATION OF PRIOR ART¹

A. Prior Art Patents

| Patent No. | Date of Issue/Publication | Filing Date |
|-------------------|----------------------------------|--------------------|
| 4,686,521 | August 11, 1987 | March 6, 1985 |
| 5,347,632 | September 13, 1994 | July 28, 1989 |
| 5,469,536 | November 21, 1995 | May 21, 1993 |
| 5,621,434 | April 15, 1997 | August 11, 1993 |
| 5,376,949 | December 27, 1994 | August 16, 1993 |
| 5,920,311 | July 6, 1999 | December 6, 1993 |
| 5,715,416 | February 3, 1998 | September 30, 1994 |
| 5,815,137 | September 28, 1998 | October 19, 1994 |
| 6,437,800 | August 20, 2002 | October 26, 1994 |
| 6,016,137 | January 18, 2000 | January 30, 1995 |
| 5,565,888 | October 15, 1996 | February 17, 1995 |
| 5,463,728 | October 31, 1995 | March 4, 1995 |
| 5,687,331 | November 11, 1997 | August 3, 1995 |

¹ Defendants also hereby identify any systems or products that embody the technology described in any patent or publication identified in these Invalidity Contentions. Defendants reserve the right to rely on any documents or other evidence regarding any such systems.

| Patent No. | Date of Issue/Publication | Filing Date |
|-------------------|----------------------------------|--------------------|
| 5,801,704 | September 1, 1998 | August 15, 1995 |
| 5,710,897 | January 20, 1998 | August 15, 1995 |
| 5,913,040 | June 15, 1999 | August 22, 1995 |
| 5,898,419 | April 27, 1999 | October 6, 1995 |
| 5,784,056 | July 21, 1998 | December 29, 1995 |
| 6,118,427 | September 12, 2000 | April 18, 1996 |
| 6,184,859 | February 6, 2001 | April 19, 1996 |
| 5,708,787 | January 13, 1998 | May 28, 1996 |
| 5,896,123 | April 20, 1999 | June 12, 1996 |
| 6,411,310 | June 25, 2002 | July 1, 1996 |
| 5,742,768 | April 21, 1998 | July 16, 1996 |
| 5,991,781 | November 3, 1999 | September 27, 1996 |
| 6,018,345 | January 25, 2000 | February 18, 1997 |
| 5,920,304 | July 6, 1999 | February 18, 1997 |
| 5,898,432 | April 27, 1999 | March 12, 1997 |
| 5,912,666 | June 15, 1999 | April 22, 1997 |
| 5,801,698 | September 1, 1998 | May 19, 1997 |

B. Prior Art Publications

| Title, Author(s), and Publisher | Date of Publication² |
|---|--|
| Bringing Icons to Life | 1991 |
| The Windows Interface--A Guide for Designing Software, Microsoft | Feb. 1995 |
| Guidelines for Multimedia on the Web, Nielsen Norman Group | November 30, 1995 |
| A Hypertext Display Component for a Graphical User Interface Development Environment | December 31, 1995 |
| Why Icons Cannot Stand Alone | May 1, 1996 |
| IICE: Bringing Interactivity to Image-based WWW Products | June 1996 |
| Comic Chat | August 1996 |
| Semantic Telepointers for Groupware | December 1996 |
| The Partial-Occlusion Effect: Utilizing Semitransparency in 3D Human-Computer Interaction | September 3, 1996 |
| A Case Study in the Use of VRML2.0 for Marketing a Product | April 1997 |

² The dates in this column are the latest dates on which the publications were publicly available. Defendants reserve the right to identify earlier dates should such dates be ascertained through discovery.

C. Prior Art Sales/Public Uses

| Item Offered for Sale and/or Publicly Used or Known | Date of Offer / Public Use / Knowledge³ |
|--|---|
| NeXTSTEP | 1995 |
| OS/2 | 1996 |
| ArcView | 1997 |
| InLarge | 1995 |
| CloseView | 1995 |
| Unwindows Project | 1995 |
| Command and Conquer: Red Alert | 1995 |
| Microsoft Windows | 1996 |

V. PRIMARY REFERENCES

The primary prior art references that Defendants rely on for the Asserted Patents are identified below. The exhibits to these Invalidity Contentions contain claim charts for the primary prior art references. Obviousness combinations of the primary prior art references are separately identified throughout these Invalidity Contentions (including below and in Appendices A–B).

Defendants’ reliance on each prior art reference identified throughout these Invalidity Contentions (whether primary references or obviousness references) includes the reference itself, anything incorporated by the reference, any system embodying the reference, and any testimony by those with knowledge of the reference, such as named authors and inventors.⁴ All such documents and information shall be considered one prior art reference to the extent they describe

³ The dates in this column are the latest dates on which the systems were publicly used or known. Defendants reserve the right to identify earlier dates should such dates be ascertained through discovery.

⁴ For example, for each patent identified as a prior art reference in these Invalidity Contentions, Defendants reserve the right to rely on the patent itself and/or any system that practices or embodies the patent to demonstrate invalidity.

a single prior art system or solution, or the closely related work of a single prior art author. In addition to the specific references below, Defendants reserve the right to rely on all admitted prior art in the Asserted Patents and their file histories, as well as anything admitted to be prior art by Plaintiff or its experts or representatives. Defendants reserve the right to supplement these Invalidity Contentions as discovery reveals further information about prior use and/or prior public knowledge of products, methods, or systems that Defendants have reason to believe anticipate or render obvious one or more of the Asserted Claims. Defendants further reserve the right to identify and rely on additional prior art in Plaintiff's possession, custody, or control that has not yet been produced or identified to Defendants.

The following primary references, alone or in combination with any other reference identified in this subsection or the references identified in Appendix A and B, render invalid one or more of the Asserted Claims of the '102 and '449 patents.

A. U.S. Patent No. 6,437,800 ("Malamud")

Malamud was filed on October 26, 1994, published on August 20, 2002, and issued on August 20, 2002. Malamud qualifies as prior art to the '102 and '449 patents under at least 35 U.S.C. § 102(e). Malamud anticipates and/or renders obvious (in combination with the knowledge of a person of ordinary skill in the art) all Asserted Claims of the '102 and '449 patents. The claim chart attached as Exhibits A-1 and B-1 provides representative, non-limiting examples of where Malamud discloses, either expressly or inherently, each element, thereby anticipating those claims. To the extent Plaintiff asserts that Malamud does not anticipate any Asserted Claim, such Asserted Claim would be obvious in view of Malamud alone and/or in view of the knowledge of one of ordinary skill in the art, and it would have been obvious to combine or modify Malamud with concepts from other prior art, including any of the other primary references or the references identified in Appendices A and B, or Section VI (State of the Art and Obviousness), and/or in view

of the knowledge of one of ordinary skill in the art, including as explained herein, to achieve the claimed inventions.

B. U.S. Patent No. 5,715,416 (“Baker”)

Baker was filed on September 30, 1994, published on February 3, 1998, and issued on February 3, 1998. Baker qualifies as prior art to the ’102 and ’449 patents under at least 35 U.S.C. § 102(e). Baker anticipates and/or renders obvious (in combination with the knowledge of a person of ordinary skill in the art) all Asserted Claims of the ’102 and ’449 patents. The claim chart attached as Exhibits A-2 and B-2 provides representative, non-limiting examples of where Baker discloses, either expressly or inherently, each element, thereby anticipating those claims. To the extent Plaintiff asserts that Baker does not anticipate any Asserted Claim, such Asserted Claim would be obvious in view of Baker alone and/or in view of the knowledge of one of ordinary skill in the art, and it would have been obvious to combine or modify Baker with concepts from other prior art, including any of the other primary references or the references identified in Appendices A and B, or Section VI (State of the Art and Obviousness), and/or in view of the knowledge of one of ordinary skill in the art, including as explained herein, to achieve the claimed inventions.

C. U.S. Patent No. 5,565,888 (“Selker”)

Selker was filed on February 17, 1995, published on October 15, 1996, and issued on October 15, 1996. Selker qualifies as prior art to the ’102 and ’449 patents under at least 35 U.S.C. §§ 102(a) and (e). Selker anticipates and/or renders obvious (in combination with the knowledge of a person of ordinary skill in the art) all Asserted Claims of the ’102 and ’449 patents. The claim chart attached as Exhibits A-3 and B-3 provides representative, non-limiting examples of where Selker discloses, either expressly or inherently, each element, thereby anticipating those claims. To the extent Plaintiff asserts that Selker does not anticipate any Asserted Claim, such Asserted

Claim would be obvious in view of Selker alone and/or in view of the knowledge of one of ordinary skill in the art, and it would have been obvious to combine or modify Selker with concepts from other prior art, including any of the other primary references or the references identified in Appendices A and B, or Section VI (State of the Art and Obviousness), and/or in view of the knowledge of one of ordinary skill in the art, including as explained herein, to achieve the claimed inventions.

D. U.S. Patent No. 5,898,432 (“Pinard”)

Pinard was filed on March 12, 1997, published on April 27, 1999, and issued on April 27, 1999. Pinard qualifies as prior art to the ’102 and ’449 patents under at least 35 U.S.C. § 102(e). Pinard anticipates and/or renders obvious (in combination with the knowledge of a person of ordinary skill in the art) all Asserted Claims of the ’102 and ’449 patents. The claim chart attached as Exhibits A-4 and B-4 provides representative, non-limiting examples of where Pinard discloses, either expressly or inherently, each element, thereby anticipating those claims. To the extent Plaintiff asserts that Pinard does not anticipate any Asserted Claim, such Asserted Claim would be obvious in view of Pinard alone and/or in view of the knowledge of one of ordinary skill in the art, and it would have been obvious to combine or modify Pinard with concepts from other prior art, including any of the other primary references or the references identified in Appendices A and B, or Section VI (State of the Art and Obviousness), and/or in view of the knowledge of one of ordinary skill in the art, including as explained herein, to achieve the claimed inventions.

E. U.S. Patent No. 5,898,419 (“Liu”)

Liu was filed on October 6, 1995, published on April 27, 1999, and issued on April 27, 1999. Liu qualifies as prior art to the ’102 and ’449 patents under at least 35 U.S.C. § 102(e). Liu anticipates and/or renders obvious (in combination with the knowledge of a person of ordinary skill in the art) all Asserted Claims of the ’102 and ’449 patents. The claim chart attached as

Exhibits A-5 and B-5 provides representative, non-limiting examples of where Liu discloses, either expressly or inherently, each element, thereby anticipating those claims. To the extent Plaintiff asserts that Liu does not anticipate any Asserted Claim, such Asserted Claim would be obvious in view of Liu alone and/or in view of the knowledge of one of ordinary skill in the art, and it would have been obvious to combine or modify Liu with concepts from other prior art, including any of the other primary references or the references identified in Appendices A and B, or Section VI (State of the Art and Obviousness), and/or in view of the knowledge of one of ordinary skill in the art, including as explained herein, to achieve the claimed inventions.

F. U.S. Patent No. 5,463,728 (“Blahut”)

Blahut was filed on March 4, 1995, published on October 31, 1995, and issued on October 31, 1995. Blahut qualifies as prior art to the '102 and '449 patents under at least 35 U.S.C. §§ 102(a), (b) and (e). Blahut anticipates and/or renders obvious (in combination with the knowledge of a person of ordinary skill in the art) all Asserted Claims of the '102 and '449 patents. The claim chart attached as Exhibits A-6 and B-6 provides representative, non-limiting examples of where Blahut discloses, either expressly or inherently, each element, thereby anticipating those claims. To the extent Plaintiff asserts that Blahut does not anticipate any Asserted Claim, such Asserted Claim would be obvious in view of Blahut alone and/or in view of the knowledge of one of ordinary skill in the art, and it would have been obvious to combine or modify Blahut with concepts from other prior art, including any of the other primary references or the references identified in Appendices A and B, or Section VI (State of the Art and Obviousness), and/or in view of the knowledge of one of ordinary skill in the art, including as explained herein, to achieve the claimed inventions.

G. U.S. Patent No. 6,016,137 (“Evans”)

Evans was filed on January 30, 1995, published on January 18, 2000, and issued on January 18, 2000. Evans qualifies as prior art to the ’102 and ’449 patents under at least 35 U.S.C. § 102(e). Evans anticipates and/or renders obvious (in combination with the knowledge of a person of ordinary skill in the art) all Asserted Claims of the ’102 and ’449 patents. The claim chart attached as Exhibits A-7 and B-7 provides representative, non-limiting examples of where Evans discloses, either expressly or inherently, each element, thereby anticipating those claims. To the extent Plaintiff asserts that Evans does not anticipate any Asserted Claim, such Asserted Claim would be obvious in view of Evans alone and/or in view of the knowledge of one of ordinary skill in the art, and it would have been obvious to combine or modify Evans with concepts from other prior art, including any of the other primary references or the references identified in Appendices A and B, or Section VI (State of the Art and Obviousness), and/or in view of the knowledge of one of ordinary skill in the art, including as explained herein, to achieve the claimed inventions.

H. The Partial-Occlusion Effect: Utilizing Semitransparency in 3D Human-Computer Interaction (“Zhai”)

Zhai was published at least as early as September 3, 1996. Zhai qualifies as prior art to the ’102 and ’449 patents under at least 35 U.S.C. § 102(a). Zhai anticipates and/or renders obvious (in combination with the knowledge of a person of ordinary skill in the art) all Asserted Claims of the ’102 and ’449 patents. The claim chart attached as Exhibits A-8 and B-8 provides representative, non-limiting examples of where Zhai discloses, either expressly or inherently, each element, thereby anticipating those claims. To the extent Plaintiff asserts that Zhai does not anticipate any Asserted Claim, such Asserted Claim would be obvious in view of Zhai alone and/or in view of the knowledge of one of ordinary skill in the art, and it would have been obvious to combine or modify Zhai with concepts from other prior art, including any of the other primary

references or the references identified in Appendices A and B, or Section VI (State of the Art and Obviousness), and/or in view of the knowledge of one of ordinary skill in the art, including as explained herein, to achieve the claimed inventions.

I. U.S. Patent No. 6,184,859 (“Kojima”)

Kojima was filed on April 19, 1996, published on February 6, 2001, and issued on February 6, 2001. Kojima qualifies as prior art to the '102 and '449 patents under at least 35 U.S.C. § 102(e). Kojima anticipates and/or renders obvious (in combination with the knowledge of a person of ordinary skill in the art) all Asserted Claims of the '102 and '449 patents. The claim chart attached as Exhibits A-9 and B-9 provides representative, non-limiting examples of where Kojima discloses, either expressly or inherently, each element, thereby anticipating those claims. To the extent Plaintiff asserts that Kojima does not anticipate any Asserted Claim, such Asserted Claim would be obvious in view of Kojima alone and/or in view of the knowledge of one of ordinary skill in the art, and it would have been obvious to combine or modify Kojima with concepts from other prior art, including any of the other primary references or the references identified in Appendices A and B, or Section VI (State of the Art and Obviousness), and/or in view of the knowledge of one of ordinary skill in the art, including as explained herein, to achieve the claimed inventions.

J. U.S. Patent No. 5,801,704 (“Oohara”)

Oohara was filed on August 15, 1995, published on September 1, 1998, and issued on September 1, 1998. Oohara qualifies as prior art to the '102 and '449 patents under at least 35 U.S.C. § 102(e). Oohara anticipates and/or renders obvious (in combination with the knowledge of a person of ordinary skill in the art) all Asserted Claims of the '102 and '449 patents. The claim chart attached as Exhibits A-10 and B-10 provides representative, non-limiting examples of where Oohara discloses, either expressly or inherently, each element, thereby anticipating those claims.

To the extent Plaintiff asserts that Oohara does not anticipate any Asserted Claim, such Asserted Claim would be obvious in view of Oohara alone and/or in view of the knowledge of one of ordinary skill in the art, and it would have been obvious to combine or modify Oohara with concepts from other prior art, including any of the other primary references or the references identified in Appendices A and B, or Section VI (State of the Art and Obviousness), and/or in view of the knowledge of one of ordinary skill in the art, including as explained herein, to achieve the claimed inventions.

K. U.S. Patent No. 5,784,056 (“Nielsen ’056”)

Nielsen ’056 was filed on December 29, 1995, published on July 21, 1998, and issued on July 21, 1998. Nielsen ’056 qualifies as prior art to the ’102 and ’449 patents under at least 35 U.S.C. § 102(e). Nielsen ’056 anticipates and/or renders obvious (in combination with the knowledge of a person of ordinary skill in the art) all Asserted Claims of the ’102 and ’449 patents. The claim chart attached as Exhibits A-11 and B-11 provides representative, non-limiting examples of where Nielsen ’056 discloses, either expressly or inherently, each element, thereby anticipating those claims. To the extent Plaintiff asserts that Nielsen ’056 does not anticipate any Asserted Claim, such Asserted Claim would be obvious in view of Nielsen ’056 alone and/or in view of the knowledge of one of ordinary skill in the art, and it would have been obvious to combine or modify Nielsen ’056 with concepts from other prior art, including any of the other primary references or the references identified in Appendices A and B, or Section VI (State of the Art and Obviousness), and/or in view of the knowledge of one of ordinary skill in the art, including as explained herein, to achieve the claimed inventions.

VI. STATE OF THE ART AND OBVIOUSNESS

The primary references identified above, as further described in the Exhibits, each discloses, either expressly or inherently, every element of the Asserted Claims of the identified Asserted Patent, thereby anticipating those claims. Additionally, each of the primary references alone (including in combination with the knowledge of a person of ordinary skill in the art) renders obvious such Asserted Claims. To the extent Plaintiff contends that any primary reference does not anticipate or render obvious the Asserted Claims as set forth above, it would have been obvious to combine or modify the primary references with concepts from other prior art, as explained throughout these Invalidity Contentions. In particular, for each limitation of the Asserted Claims that Plaintiff contends is not met by a particular primary reference, Defendants contend that the limitation (and claim as a whole) is obvious based on a combination of that particular primary reference with (1) any other primary reference disclosing that limitation, (2) any reference identified in Appendices A–B as disclosing that limitation, (3) any statements made in the intrinsic record of such Asserted Patent, and/or (4) the knowledge of one of ordinary skill in the art (as explained in additional detail below).

Defendants do not yet have the benefit of Plaintiff's positions regarding the prior art in the current litigation, including what element(s), if any, Plaintiff contends are not disclosed by each prior art reference, whether Plaintiff contends that a reference is not in fact prior art, and whether Plaintiff contends that a person of ordinary skill in the art would not be motivated to combine specific references. Defendants reserve the right to supplement these obviousness positions (including identifying additional prior art combinations and the associated reasons to combine) in view of such positions and/or as discovery in the case, including expert discovery, progresses.

The information discussed in the prior art raised in these Invalidity Contentions (including all referenced listed in the P.R. 3-3(a) – Identification of Prior Art) forms part of the background

knowledge of a person of ordinary skill in the art at the time each of the Asserted Patents was filed and would have been used in determining whether and how to combine references to achieve the claimed invention(s), as discussed herein.⁵ Indeed, the existence, nature, and content of each prior art reference, including the prior art references cited here, provide further evidence regarding the knowledge of a person of ordinary skill in the art at the relevant time. Defendants expressly reserve the right to rely on each of the prior art references, systems, concepts, and technologies discussed in these Invalidity Contentions, including to demonstrate that a particular claim element was known at the time of the Asserted Patents to a person of ordinary skill in the art, to show that the differences between a claimed invention and a prior art reference would have been obvious to a person of ordinary skill in the art, and to establish that a person of ordinary skill in the art would have been motivated to combine teachings of one or more references to achieve a claimed invention.

A. General Motivations for Making Combinations of Prior Art

Defendants believe that no showing of a specific motivation to combine prior art is required to combine the references disclosed in the attached charts; there was a reason to make each combination, each combination of art would have produced no unexpected results, and each combination at most would simply represent a known alternative to one of ordinary skill in the art. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 414–18 (2007) (rejecting the Federal Circuit’s “rigid” application of the teaching, suggestion, or motivation to combine test instead espousing an “expansive and flexible” approach). Indeed, the Supreme Court held that a person of ordinary skill in the art is “a person of ordinary creativity, not an automaton” and “in many cases a person of

⁵ *See Randall Mfg. v. Rea*, 733 F.3d 1355, 1362 (Fed. Cir. 2013) (stating that “the knowledge [of a person of ordinary skill in the art] is part of the store of public knowledge that must be consulted when considering whether a claimed invention would have been obvious”).

ordinary skill in the art will be able to fit the teachings of multiple patents together like a pieces of a puzzle.” *Id.* at 420–21.

Nevertheless, in keeping with the Local Patent Rules, in addition to the information contained elsewhere in these contentions, Defendants identify exemplary combinations, motivations, and reasons to combine the cited art. A person of ordinary skill in the art would have been motivated to combine the primary and additional prior art references as set forth above and in Appendices A–B. Multiple teachings, suggestions, and/or reasons to modify any of the references and/or to combine any two or more of the references come from many sources, including the prior art (specific and as a whole), common knowledge, common sense, predictability, expectations, industry trends, design incentives or need, market demand or pressure, market forces, obvious to try, the nature of the problem faced, and/or knowledge possessed by one of ordinary skill in the art.⁶ In addition, the patentee admits in the intrinsic record, including the specification and prosecution history of the Asserted Patents, that many of the claimed features were conventional and known in the art.

In general, a claimed invention is unpatentable if the differences between it and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a); *Graham v. John Deere Co.*, 383 U.S. 1, 13–14 (1966). The ultimate determination of whether an invention is or is not obvious is a legal conclusion based on underlying factual inquiries including: “(1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness.” *Miles Labs., Inc. v. Shandon, Inc.*, 997 F.2d 870, 877 (Fed. Cir. 1993).

⁶ Defendants reserve the right to present qualified expert testimony on any or all of these items.

KSR International Co. v. Teleflex Inc., et al., 550 U.S. 398 (2007) (“*KSR*”), reaffirmed *Graham*, holding that a claimed invention can be obvious even if there is no teaching, suggestion, or motivation for combining the prior art to produce that invention. In determining whether a claim is obvious, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 418. In determining whether a claim is obvious, “a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* When prior art elements are combined according to known methods to yield predictable results, the claimed invention is obvious. *Id.* at 417. In addition, “[o]ne of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of the invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 419–20. “Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 420.

Any suggested obviousness combinations set forth herein are in the alternative to Defendants’ anticipation contentions and are not to be construed to suggest that any reference included in any combination is not anticipatory in its own right or is not the basis for a single-reference obviousness defense. In particular, Defendants are currently unaware of the extent, if any, to which Plaintiff will contend that certain limitations of the Asserted Claims are not disclosed in the art identified by Defendants as anticipatory. To the extent an issue arises with respect to any such claim limitation, Defendants reserve the right to identify other references and

combinations, which may make obvious the allegedly missing limitation in the disclosed system or method.

The rationale to combine or modify prior art references is significantly stronger when the references seek to solve the same problem, come from the same field, and correspond well. *In re Inland Steel Co.*, 265 F.3d 1354, 1362–64 (Fed. Cir. 2001).

In view of the Supreme Court’s *KSR* decision, the PTO issued, and updated, a set of Examination Guidelines. See Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in view of the Supreme Court Decision in *KSR International Co. v. Teleflex, Inc.*, 72 Fed. Reg. 57526 (October 10, 2007); Examination Guidelines Update: Development in the Obviousness Inquiry After *KSR v. Teleflex*, 75 Fed. Reg. 53643-60 (September 2010); see also MPEP § 2141 (<https://www.uspto.gov/web/offices/pac/mpep/s2141.html>) (accessed July 6, 2022). These Guidelines summarized the *KSR* decision and subsequent case law, as well as identified various rationales for finding a claim obvious, including those based on other precedents. Those rationales include:

- (1) Combining prior art elements according to known methods to yield predictable results;
- (2) Simple substitution of one known element for another to obtain predictable results;
- (3) Use of known technique to improve similar devices (methods, or products) in the same way;
- (4) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (5) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (6) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and
- (7) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Defendants contend that one or more of these rationales apply in considering the obviousness of the Asserted Claims of the Asserted Patents.

To the extent that prior art identified by Defendants as anticipatory are found not to anticipate the Asserted Claims: (1) the prior art establishes that the claimed subject matter was obvious to a person of ordinary skill in the art at the time of the alleged invention; (2) the claims are nevertheless unpatentable because the Asserted Claims contain nothing that goes beyond “ordinary innovation”; (3) no Asserted Claim goes beyond combining known elements to achieve predictable results (particularly in the predictable art(s) of the Asserted Patent) or does more than choose between clear alternatives known to those of skill in the art; and/or (4) the prior art renders the Asserted Claims obvious either alone or in combination with each other or one or more of the other references identified in these Invalidity Contentions.

Motivation to make the proposed combinations of prior art references and knowledge of one skilled in the art generally exists within the references themselves as well as within the knowledge of one skilled in the art in the relevant time frame. Below are exemplary specific motivations to combine references.

The popularization of e-commerce, online advertising, and networked computers provided strong motivation to combine content-specific cursors, which were well known in many contexts, including in the context of software applications that were not necessarily used online, with distributed computer systems such that the cursor on the user terminal is modified by a remote computer. That is, it was well known by the late-1990’s that one way to try to emphasize graphic user interface elements or otherwise modify a user’s experience with computer software was to alter the user’s cursor experience to reflect the content selected by the cursor. By the late-1990s, e-commerce advertisers were looking for ways to grab users’ attentions on web pages already

crowded with banner and pop-up advertisements. At the same time, industry publications were promoting technology that placed cursor-driven animation on screens. *See, e.g.*, Jakob Nielsen, Guidelines for Multimedia on the Web, Nielsen Norman Group (Nov. 30, 1995) (promoting the use of animation that is activated by cursor movements); Interactive: Networthy: Togglethis, AdAge (Apr. 28, 1997) (announcing Togglethis’s cursor-controlled animated online spokesperson that adopted the “advertiser’s verbal and visual metaphors”).⁷ The recognition that cursors could be modified to convey information to users had occurred (and the knowledge existed) even before the internet became popular. Early commercially available user interface operating systems like Windows 3.1 supported a variety of cursors to inform the user of available objects and operations, for example, using a magnifying glass symbol to represent the availability of a zoomed-in view. *See, e.g.*, The Windows Interface--A Guide for Designing Software, Microsoft (Feb. 1995) at 23. The application of these known techniques in the e-commerce, or online, world was not a patentable concept, and would have been obvious to a person of ordinary skill in the art. These disclosures are provided without prejudice to any arguments or objections concerning the relevance of motivation to combine in connection with any invalidity contentions.

It would have been obvious to try combining the prior art references identified above in Section II because there were only a finite number of predictable solutions and/or because known work in one field or endeavor prompted variations based on predictable design incentives and/or market forces either in the same field or a different one. Indeed, because each of these references are generally in the same field (*e.g.*, user interfaces, including cursors) and/or are directed to solving the same alleged problems, including as set forth in the aforementioned claim charts, a

⁷ <http://adage.com/article/news/interactive-networthy-togglethis/72847/>

person of ordinary skill in the art would be motivated to look for solutions in other references in that field or that solve the same alleged problems.

Relatedly, one of ordinary skill in the art would have been motivated to create combinations identified in these contentions using: known methods to yield predictable results; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or teaching, suggestion, or motivation in the prior art generally. Also, market forces in the industry, and the desire to improve features and performance, would motivate the addition of features to systems as they become available, become smaller, become less expensive, become more commonly used, provide better performance, reduce costs, or predictably achieve other clearly desirable results.

Many of these prior art references cite to, rely upon, incorporate, or are described as an inherent part of one another, including as set forth in the aforementioned claim charts. To the extent certain disclosures of graphic user interface techniques (e.g., involving changing the appearance of cursors) or protocols or standards describing the same are not already considered inherent to or part of such references, a person of ordinary skill in the art would be motivated to combine their teachings to achieve predictable results.

As shown in the attached Exhibits and appendices, each of the references identified comes from the same field. The problems sought to be solved by the identified references and systems were the same ones that had already been solved in the prior art. Indeed, the Asserted Claims recite one of a finite number of known, available alternatives to solve these known problems. The Asserted Claims simply combine previously known methods in a way that was explicitly and implicitly taught and suggested in the prior art. Implementing the teachings of the references

identified herein would achieve improved performance in the same way that the Asserted Patents describe their techniques as achieving improved performance.

The Asserted Claims are further obvious in view of the admitted prior art in the specification and file histories of the Asserted Patents. That is, the Asserted Patents themselves admit that certain features and claim elements were known in the prior art before the effective date of the Asserted Patents. Defendants reserve the right to rely on any admissions in the Asserted Patents as part of any obviousness combination, as part of the motivation to combine, and also to explain the state of the art at the time of the Asserted Patents.

B. Exemplary Combinations and Motivations for Making Combinations of Prior Art

As explained above, Defendants contend that a person of ordinary skill in the art would have been motivated to combine any of the primary references in these Invalidity Contentions with (1) any other primary reference, (2) any reference disclosed in Appendices A–B as disclosing a limitation missing in a primary reference, (3) any statements made in the intrinsic record of the Asserted Patents, and/or (4) the knowledge of one of ordinary skill in the art. By way of example only, Defendants provide the following exemplary combinations and some of the reasons a person of ordinary skill in the art would be motivated to combine references.

1. Exemplary Combinations for Claim 72 of the '102 patent and Claim 53 of the '449 patent

The illustrative combinations described below render claim 72 of the '102 patent and claim 53 of the '449 patent as invalid as obvious under 35 U.S.C. § 103. Defendants' contention that these combinations render these claims obvious under 35 U.S.C. § 103 are in no way an admission or suggestion that any reference or system/product does not independently anticipate the asserted claims under 35 U.S.C. § 102. Nor does the inclusion of the exemplary combinations below exclude other combinations of prior art. To the extent that any prior art reference or

system/product described in these contentions is found not to disclose a limitation of these claims, it would have been obvious to a person of ordinary skill in the art to combine that reference or system/product with any other reference or system/product described in these contentions to meet the limitation, and such persons would have been motivated to do so. Defendants incorporate by reference any statements and reasons set forth by the Examiner during prosecution of the '102 or '449 patents and related patent applications as to why it would have been obvious to modify or combine references or systems/products to achieve the limitations of these claims. As discussed above, the below list is a non-exhaustive subset of combinations. Defendants reserve the right to use any reference or system/product described in these contentions in combination with any other reference or system/product described in these contentions. A person of ordinary skill in the art at the time of the alleged invention also would have had a reasonable expectation of success in implementing the combinations.

By way of example only, to the extent that any reference or system/product described in these contentions is found not to disclose “receiving a request at [an] at least one server to provide specified content information to [a] user terminal” and “providing said specified content information to said user terminal in response to said request, said specified content information including at least one cursor display instruction and at least one indication of cursor image data corresponding to a specific image,” it would have been obvious to combine that reference or system/product with, for example, teachings of: U.S. Patent No. 5,920,311 to Anthias (“Anthias”) at Abstract, 1:24-33, 2:49-65, 3:2-7, 3:29-32, 4:18-25, Figs. 1-2; Liu at Abstract, 3:65-4:12, 4:58-55, 8:23-32, Figs. 6-7; Kojima at 3:23-38, 3:39-51, 4:6-65, 4:66-5:43, 12:22-29, Figs. 2, 7 & 9; Nielsen '056 at 2:33-43, 3:27-44, 3:65-4:25, 5:8-29; U.S. Patent No. 5,913,040 (“Rakavy”) at 2:60-3:33, 5:32-65; U.S. Patent No. 5,896,123 (“Nagahara”) at 2:25-31, 4:59-5:7, 5:20-35, 6:6-24, 6:62-

7:14, 7:58-65, 9:32-10:3, Fig. 5; U.S. Patent No. 5,347,632 (“Filepp”) at 91:14-25, 91:32-43, 94:14-25; U.S. Patent No. 5,801,968 (“Lecture”) at 4:37-67, 7:37-47, Fig. 4; “A Hypertext Display Component for a Graphical User Interface Development Environment” (“Love”) at Approach, Hypertext Features; and “IICE: Bringing Interactivity to Image-based WWW Products” (“Wojtowicz”) at 2.2, 4.1, 4.3. A person of ordinary skill in the art at the time of the alleged invention would have been motivated to incorporate these teachings because, for example, they related to techniques that were known in the prior art and implementing them would have yielded predictable results, including providing display content and cursor modifications instructions over a network (e.g., the Internet) from one computer (e.g., a server) to another (e.g., a user personal computer). The combination also would have improved systems into which the teachings were incorporated by providing several benefits, including facilitating access to a wealth of information for display on a user computer that is otherwise not stored, or which collectively could not be stored, on the user computer, and would have been the use of known techniques to improve similar systems and methods in the same way. The combination would have further improved systems into which the teachings were incorporated by providing several benefits, such as limiting network traffic and storage requirements and processing overhead in the server computer by offloading instructions for execution by a user computer, and would have been the use of known techniques to improve similar systems and methods in the same way. Moreover, this combination is a simple substitution of known elements (providing instructions for displaying images and cursors locally versus delivering remotely via a network such as the Internet) to obtain predictable results (delivering customized cursors for websites).

Additionally, to the extent that any reference or system/product described in these contentions is found not to disclose “wherein said cursor display instruction indicates a cursor

display code operable to process said cursor display instruction to modify said cursor image ... responsive to movement of said cursor image over a display of said at least a portion of said information to be displayed on said display of said user's terminal," it would have been obvious to combine that reference or system/product with, for example, teachings of: Baker at 5:18-23, 13:22-30, 13:47-52, 14:59-67, 20:15-24, 21:6-8, Figs. 3a-3c; Malamud at 3:6-8, 4:53-55, 5:47-57, Fig. 60; Pinard at 4:32-55; Nielsen '056 at 2:25-32, 4:40-65, Figs. 3-4; U.S. Patent No. 5,708,787 ("Nakano") at Abstract, 2:56-3:11, 6:51-60, 6:65-7:9, 7:61-64, Fig. 8; U.S. Patent No. 5,920,304 ("Berstis '304") at 6:7-28, 6:35-7:20, Figs. 4a-4d; Nagahara at 2:25-31, 4:59-5:7, 5:20-35, 6:6-24, Fig. 5; U.S. Patent No. 5,742,768 ("Gennaro") at 2:39-67; Love at Approach, Hypertext Features; A Case Study in the Use of VRML2.0 for Marketing a Product ("Burton") at 3.3 Interaction, 7.1 Design of Custom Interface; Wojtowicz at 4.1, 4.3. A person of ordinary skill in the art at the time of the alleged invention would have been motivated to incorporate these teachings because, for example, they related to techniques that were known in the prior art and implementing them would have yielded predictable results, including varying the user cursor based on the user interaction with the underlying display content. Moreover, this combination is a simple substitution of known elements (providing a static cursor versus changing the cursor) to obtain predictable results (modifying cursors commensurate with user interaction with underlying display content).

Additionally, to the extent Lexos argues that a semi-transparent cursor which permits display through said cursor of page content underneath the position of the cursor can constitute the claimed modified cursor upon "transforming [an] initial cursor ... into the shape and appearance of [a] specific image," which "includes content corresponding to at least a portion of [the] information that is to be displayed on [the] display of [the] user's terminal," and any reference or system/product described in these contentions is found not to disclose a semi-transparent cursor,

it would have been obvious to combine that reference or system/product with, for example, teachings of: Evans at 2:30-44, 2:51-59, 2:60-3:3, 3:13-19, 4:15-25, 4:49-5:55:15-29, 5:42-49, 6:24-39, 6:40-51, 6:52-65; Blahut at 16:40-59, 16:60-17:17, 17:18-40. A person of ordinary skill in the art at the time of the alleged invention would have been motivated to incorporate these teachings because, for example, they related to techniques that were known in the prior art and implementing them would have yielded predictable results, including making a cursor semi-transparent. The combination also would have improved systems into which the teachings were incorporated by providing several benefits, such as ensuring that content beneath a cursor is not obscured and is still viewable to a user of the computer, and would have been the use of known techniques to improve similar systems and methods in the same way. Moreover, this combination is a simple substitution of known elements (opaque cursor image versus semi-transparent cursor image) to obtain predictable results (modifying cursors commensurate with user interaction with underlying display content).

2. Exemplary Combinations for Claims 1, 27 and 38 of the '449 patent

The illustrative combinations described below render claims 1, 27 and 38 of the '449 patent as invalid as obvious under 35 U.S.C. § 103. Defendants' contention that these combinations render these claims obvious under 35 U.S.C. § 103 are in no way an admission or suggestion that any reference or system/product does not independently anticipate the asserted claims under 35 U.S.C. § 102. Nor does the inclusion of the exemplary combinations below exclude other combinations of prior art. To the extent that any prior art reference or system/product described in these contentions is found not to disclose a limitation of these claims, it would have been obvious to a person of ordinary skill in the art to combine that reference or system/product with any other reference or system/product described in these contentions to meet the limitation, and such persons would have been motivated to do so. Defendants incorporate by reference any statements and

reasons set forth by the Examiner during prosecution of the '449 patent and related patent applications as to why it would have been obvious to modify or combine references or systems/products to achieve the limitations of these claims. As discussed above, the below list is a non-exhaustive subset of combinations. Defendants reserve the right to use any reference or system/product described in these contentions in combination with any other reference or system/product described in these contentions. A person of ordinary skill in the art at the time of the alleged invention also would have had a reasonable expectation of success in implementing the combinations.

By way of example only, to the extent that any reference or system/product described in these contentions is found not to disclose “a first server computer for transmitting specified content information to said remote user terminal, said specified content information including at least one cursor display instruction indicating a location of said cursor image data ... wherein said specified content information is transmitted to said remote user terminal by said first server computer responsive to a request from said user terminal for said specified content information,” it would have been obvious to combine that reference or system/product with, for example, teachings of: Anthias at Abstract, 1:24-33, 2:49-65, 3:2-7, 3:29-32, 4:18-25, Figs. 1-2; Liu at Abstract, 3:65-4:12, 4:58-55, 8:23-32, Figs. 6-7; Kojima at 3:23-38, 3:39-51, 4:6-65, 4:66-5:43, 12:22-29, Figs. 2, 7 & 9; Nielsen '056 at 2:33-43, 3:27-44, 3:65-4:25, 5:8-29; Rakavy at 2:60-3:33, 5:32-65; Nagahara at 2:25-31, 4:59-5:7, 5:20-35, 6:6-24, 6:62-7:14, 7:58-65, 9:32-10:3, Fig. 5; Filepp at 91:14-25, 91:32-43, 94:14-25; Lection at 4:37-67, 7:37-47, Fig. 4; Love at Approach, Hypertext Features; and Wojtowicz at 2.2, 4.1 and 4.3. A person of ordinary skill in the art at the time of the alleged invention would have been motivated to incorporate these teachings because, for example, they related to techniques that were known in the prior art and implementing them would have

yielded predictable results, including providing display content and cursor modifications instructions over a network (e.g., the Internet) from one computer (e.g., a server) to another (e.g., a user personal computer). The combination also would have improved systems into which the teachings were incorporated by providing several benefits, including facilitating access to a wealth of information for display on a user computer that is otherwise not stored, or which collectively could not be stored, on the user computer, and would have been the use of known techniques to improve similar systems and methods in the same way. The combination would have further improved systems into which the teachings were incorporated by providing several benefits, such as limiting network traffic and storage requirements and processing overhead in the server computer by offloading instructions for execution by a user computer, and would have been the use of known techniques to improve similar systems and methods in the same way. Moreover, this combination is a simple substitution of known elements (providing instructions for displaying images and cursors locally versus delivering remotely via a network such as the Internet) to obtain predictable results (delivering customized cursors for websites).

Additionally, to the extent that any reference or system/product described in these contentions is found not to disclose “wherein said cursor display code is operable to process said cursor display instruction to modify said cursor image to said cursor image in the shape and appearance of said specific image in response to movement of said cursor image over a display of said at least a portion of said information to be displayed on said display of said user's terminal,” it would have been obvious to combine that reference or system/product with, for example, teachings of: Baker at 5:18-23, 13:22-30, 13:47-52, 14:59-67, 20:15-24, 21:6-8, Figs. 3a-3c; Malamud at 3:6-8, 4:53-55, 5:47-57, Fig. 60; Pinard at 4:32-55; Nielsen '056 at 2:25-32, 4:40-65; Nakano at Abstract, 2:56-3:11, 6:51-60, 6:65-7:9, 7:61-64, Fig. 8; Berstis '304 at 6:7-28, 6:35-

7:20, Figs. 4a-4d; Nagahara at 2:25-31, 4:59-5:7, 5:20-35, 6:6-24, Fig. 5; Gennaro at 2:39-67; Love at Approach, Hypertext Features; A Case Study in the Use of VRML2.0 for Marketing a Product (“Burton”) at 3.3 Interaction, 7.1 Design of Custom Interface; Wojtowicz at 4.1, 4.3. A person of ordinary skill in the art at the time of the alleged invention would have been motivated to incorporate these teachings because, for example, they related to techniques that were known in the prior art and implementing them would have yielded predictable results, including varying the user cursor based on the user interaction with the underlying display content. Moreover, this combination is a simple substitution of known elements (providing a static cursor versus changing the cursor) to obtain predictable results (modifying cursors commensurate with user interaction with underlying display content).

Additionally, to the extent that any reference or system/product described in these contentions is found not to disclose “wherein said specified content information is transmitted in the form of HTML files that define a web page,” it would have been obvious to combine that reference or system/product with, for example, teachings of: Nielsen ’056 at 4:26-39, 5:8-29; U.S. Patent No. 5,991,781 to Nielsen (“Nielsen ’781”) at 1:46-67, 2:16-20, 2:34-45, 8:14-32, 8:34-52, 8:53-63, 8:64-9:8; Love at Approach, Hypertext Features; and Wojtowicz at 2.2, 4.1. A person of ordinary skill in the art at the time of the alleged invention would have been motivated to incorporate these teachings because, for example, they related to techniques that were known in the prior art and implementing them would have yielded predictable results, including providing web page content in HTML format.

Additionally, to the extent Lexos argues that a semi-transparent cursor which permits display through said cursor of page content underneath the position of the cursor can constitute the claimed “modified cursor image ... in the shape and appearance of [a] specific image” which

“relates to at least a portion of the information to be displayed on said display,” and any reference or system/product described in these contentions is found not to disclose a semi-transparent cursor, it would have been obvious to combine that reference or system/product with, for example, teachings of: Evans at 2:30-44, 2:51-59, 2:60-3:3, 3:13-19, 4:15-25, 4:49-5:55:15-29, 5:42-49, 6:24-39, 6:40-51, 6:52-65; Blahut at 16:40-59, 16:60-17:17, 17:18-40. A person of ordinary skill in the art at the time of the alleged invention would have been motivated to incorporate these teachings because, for example, they related to techniques that were known in the prior art and implementing them would have yielded predictable results, including making a cursor semi-transparent. The combination also would have improved systems into which the teachings were incorporated by providing several benefits, such as ensuring that content beneath a cursor is not obscured and is still viewable to a user of the computer, and would have been the use of known techniques to improve similar systems and methods in the same way. Moreover, this combination is a simple substitution of known elements (opaque cursor image versus semi-transparent cursor image) to obtain predictable results (modifying cursors commensurate with user interaction with underlying display content).

C. Secondary Considerations

A patentee bears the burden of production with respect to evidence of secondary considerations of non-obviousness. *ZUP, LLC v. Nash Mfg., Inc.*, 896 F.3d 1365, 1373 (Fed. Cir. 2018). As of the date of these Invalidity Contentions, Plaintiff has not identified any secondary considerations of non-obviousness. Defendants reserve all rights to respond to any secondary considerations of non-obviousness raised by Plaintiff, including by updating, modifying, and/or adding to these Invalidity Contentions. Defendants are not aware of any unexpected results (none is mentioned in the Asserted Patents or their file history), long felt need, commercial success (or any nexus to any allegedly successful commercial embodiment), or awards for the Asserted

Patents. Indeed, as shown in these Invalidity Contentions, dozens of other companies and individuals described, built, and/or patented the exact same concepts in the Asserted Patents before Plaintiff ever did—often many years before. Even where others’ inventions occurred at approximately the same time as the alleged invention in the Asserted Patents, such simultaneous invention further demonstrates the obviousness of the Asserted Patents.

VII. P.R. 3-3(c) – CLAIM CHARTS

The attached claim charts (Exhibits A1–B11 and Appendices A–B) are based, in whole or in part, on Plaintiff’s asserted theories of infringement in this case, to the extent discernible from Plaintiff’s Infringement Contentions. As an initial matter, all portions of each prior art reference cited in each of the attached claim charts are relied upon to support the disclosure of each patent claim limitation, as all portions provide general support. Representative descriptions and supporting citations are nevertheless provided, but are merely exemplary; they do not necessarily reflect every instance where a particular claim term or claim limitation may be disclosed in or taught by the prior art reference. References to figures or drawings refer to the figures/drawings themselves, as well as to any accompanying text or text necessary to understand the figures or drawings. References to text refers to the text itself, as well as the accompanying figures or drawings that accompany the text. Defendants reserve the right to rely on additional, or different, portions of the prior art references, other publications and expert testimony to establish what these references would have taught one of ordinary skill in the art, or in what manner they would have motivated a particular combination of references. Defendants reserve the right to rely on any and all documents that describe or relate to prior art systems, including relying on the system itself. Defendants also reserve the right to rely on the testimony of the authors, named inventors, or anyone else with knowledge of the prior art references and systems identified herein, as well as expert testimony regarding any such references or systems.

VIII. P.R. 3-3(d) – INVALIDITY UNDER 35 U.S.C. § 112

Defendants provide the following grounds for invalidity under 35 U.S.C. § 112, ¶¶ 1–2. Defendants’ investigation of the Asserted Patents is ongoing, and Defendants reserve the right to amend or supplement these disclosures based on further investigation and in a manner consistent with the Federal Rules of Civil Procedure, the Local Patent Rules for the Eastern District of Texas, and the Docket Control Order, or otherwise in accordance with any order or direction of this Court or agreement of the parties. Further, Plaintiff’s Infringement Contentions fail to provide sufficient detail to fully understand its proposed application of the Asserted Claims, and Defendants reserve the right to assert additional grounds for invalidity under 35 U.S.C. § 112 in response to Plaintiff’s claim interpretations. Defendants also reserve the right to supplement, modify, or otherwise amend these grounds for invalidity under 35 U.S.C. § 112 based on the Court’s claim construction rulings or opinions or the parties’ positions or arguments taken in connection with the claim construction process.

In addition, Defendants identify claims below that are indefinite under 35 U.S.C. § 112 ¶ 2, which Defendants will more fully address these grounds as part of claim construction.⁸ Defendants reserve the right to provide additional explanation and/or argument for their Invalidity Contentions under Section 112, including, for example, based on expert testimony.

A. Indefiniteness

The Asserted Claims of the ’102 and ’449 patents are invalid as set forth below under 35 U.S.C. § 112, ¶ 2 for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the alleged invention. For example, the scope of the following claim terms

⁸ Any dependent claim is invalid if it depends, directly or indirectly, on another claim that is invalid under 35 U.S.C. § 112.

is not reasonably certain, rendering the Asserted Claims in which they appear (and any claims depending therefrom) invalid as indefinite:

- a. ***“said specific image includes content corresponding to at least a portion of said information that is to be displayed on said display of said user’s terminal” (claim 72 of ’102 patent, claim 53 of ’449 patent) and “said specific image relates to at least a portion of said information to be displayed on said display of said remote user’s terminal” (claims 1 and 27/38 of the ’449 patent)***

The scope of these terms are indefinite in view of the intrinsic record including the common specification of the ’102 and ’449 patents (“Common Specification”). The specification does not provide sufficient guidance regarding the scope of this term and what “corresponding to” or “relates to” mean in the context of the claim. Read in light of the Common Specification, these claims fail to inform, with reasonable certainty, those skilled in the art about the scope of the alleged invention.

While the Court in *Lexos I* construed some of these terms in its claim construction order, to the extent that order is not adopted here, Defendants reserve the right to argue indefiniteness for the reasons discussed above.

- b. ***“said specified content information including at least one cursor display instruction and at least one indication of cursor image data corresponding to a specific image” (claim 72 of ’102 patent, claim 53 of ’449 patent) and “said specified content information including at least one cursor display instruction indicating a location of said cursor image data” (claims 1 and 27/38 of the ’449 patent)***

The scope of these terms are indefinite in view of the intrinsic record including the Common Specification. These claims recite “specified content information including” either an “indicati[on of] a location of said cursor image data” or “at least one indication of cursor image data corresponding to a specific image.” The Common Specification provides no guidance so to what “indicating” or “indication” mean in the context of the claim. Read in light of the Common

Specification and the prosecution history, the Asserted Claims fail to inform, with reasonable certainty, those skilled in the art about the scope of the alleged invention.

- c. ***“said specified content information includes information that is to be displayed on said display of said user’s terminal” (claim 72 of ’102 patent, claim 53 of ’449 patent) and “said specified content information further comprises information to be displayed on said display of said user’s terminal” (claims 1 and 27/38 of the ’449 patent)***

The scope of these terms are indefinite in view of the intrinsic record including the Common Specification. These claims recite “information [that is] to be displayed on said display of said user’s terminal.” The Common Specification provides no guidance as to what constitutes “information to be displayed” or how it differs from the information already displayed on the user’s terminal. Read in light of the Common Specification and the prosecution history, the Asserted Claims fail to inform, with reasonable certainty, those skilled in the art about the scope of the alleged invention.

- d. ***“responsive to movement of said cursor image over a display of said at least a portion of said information to be displayed on said display of said user’s terminal” (claim 72 of the ’102 patent) and “in response to movement of said cursor image over a display of said at least a portion of said information to be displayed on said display of said user’s terminal” (claims 1 and 53 of the ’449 patent) and “in response to movement of said cursor image over a specified location on said display of said user’s terminal” (claims 27/38 of the ’449 patent)***

The scope of these terms are indefinite in view of the intrinsic record including the Common Specification. These claims recite code that modifies a cursor image “in response to” movement of the cursor image “over a display of at least a portion of said information to be displayed on said display of” or “over a specified location on said display of” the user’s terminal. The Common Specification provides no guidance so to the type of movement that would trigger cursor modification or what element identifies the triggering movement. Read in light of the

Common Specification and the prosecution history, the Asserted Claims fail to inform, with reasonable certainty, those skilled in the art about the scope of the alleged invention.

* * *

In view of the specification and file history of the Asserted Patents, the above terms (and any other similar terms in any of the Asserted Claims) fail to inform those skilled in the art about the scope of the invention with reasonable certainty. *See Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014) (holding that “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention”). As such, the asserted claims identified above are invalid for being indefinite. *See id.*

B. Lack of Written Description and/or Enablement

The Asserted Claims of the '102 and '449 patents are invalid for failure to comply with the written description and/or enablement requirements of Section 112, ¶ 1. For example, the common specification of the '102 and '449 patents do not provide sufficient written description or enablement of the aspects of the alleged invention corresponding to following claim limitations, rendering the Asserted Claims in which they appear (and any claims depending therefrom) invalid:

- a. **“transform[ed]”/“modified” cursor in the “shape and appearance of [a] specific image” which “includes content corresponding”/“relates” to information displayed**

| Claim Term | Asserted Claims |
|--|--------------------------------------|
| “transforming said initial cursor image displayed on said display of said user terminal into the shape and appearance of said specific image in response to said cursor display instruction,” ... “said specific image includes content corresponding to at least a portion of said information that is to be displayed on said display of said user’s terminal” | 72 ('102 patent) 53 ('449 patent) |
| “display a modified cursor image on said user's display in the shape and appearance of said specific image” ... “said specific image relates to at | 1 & 27/38 ('449 patent) |

| Claim Term | Asserted Claims |
|---|-----------------|
| least a portion of said information to be displayed on said display of said remote user's terminal" | |

To the extent Lexos argues that a semi-transparent cursor which permits display through said cursor of page content underneath the position of the cursor can constitute the claimed "modified cursor image ... in the shape and appearance of [a] specific image" which "relates to at least a portion of the information to be displayed on said display," or similarly constitutes the claimed modified cursor upon "transforming [an] initial cursor ... into the shape and appearance of [a] specific image," which "includes content corresponding to at least a portion of [the] information that is to be displayed on [the] display of [the] user's terminal," then the '102 and '449 patents fail to provide sufficient written description or an enabling disclosure. The Common Specification of the '102 and '449 patents lack any written description to inform a person of ordinary skill in the art as to generating a semi-transparent cursor. Additionally, because the Common Specification provides no guidance on generating a semi-transparent cursor, these claims are invalid for lacking enablement.

b. "specific image including content corresponding to" / "specific image relates to"

| Claim Term | Asserted Claims |
|--|--------------------------------------|
| "said specific image includes content corresponding to at least a portion of said information that is to be displayed on said display of said user's terminal" | 72 ('102 patent) 53 ('449 patent) |
| "said specific image relates to at least a portion of said information to be displayed on said display of said remote user's terminal" | 1 & 27/38 ('449 patent) |

The '102 and '449 patents fail to provide sufficient written description or an enabling disclosure with respect to the above claim terms (and any other similar terms in any of the Asserted Claims). For example, because "said specific image including content corresponding to at least a

portion of said information to be displayed on said display of said user's terminal" and "said specific image relates to at least a portion of said information to be displayed on said display of said remote user's terminal" both appear in claim 1 and in claim 27 of the '449 patent, the meaning of one claim term necessarily differs from the other. But the Common Specification of the '102 and '449 patents lack any written description to inform a person of ordinary skill in the art as to the difference. Additionally, because the Common Specification provides no guidance on the difference between these two claim terms, these claims are invalid for lacking enablement.

IX. PATENT INELIGIBILITY UNDER 35 U.S.C. § 101

Each of the Asserted Patents fail to meet the requirements of 35 U.S.C. § 101—namely the Asserted Claims of the Asserted Patents are directed to an abstract idea and are, therefore, not patentable subject matter. The appended Attachments A and B contain detailed explanations as to why this is the case. Furthermore, the Asserted Claims of the Asserted Patents recite well-understood, routine, and conventional activity within the fields of the Asserted Patents. *See generally Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1338 (Fed. Cir. 2017) (“To determine whether the exception applies, the Supreme Court has set forth a two-step inquiry. Specifically, a court must determine: (1) whether the claim is directed to a patent-ineligible concept, i.e., a law of nature, a natural phenomenon, or an abstract idea; and if so, (2) whether the elements of the claim, considered both individually and as an ordered combination, add enough to transform the nature of the claim into a patent eligible application.”).⁹ For *Mayo/Alice* Step 1, the Federal Circuit has identified “two inquiries of significance” when determining whether computer-related claims are directed towards eligible subject matter at Step

⁹ As further discovery occurs, Defendants’ patent eligibility theories may develop further. Defendants reserve the right to amend these theories before trial.

1: “[1] whether the focus of the claimed advance is on a solution to a problem specifically arising in the realm of computer networks or computers; and [2] whether the claim is properly characterized as identifying a specific improvement in computer capabilities or network functionality” *TecSec, Inc. v. Adobe Inc.*, 978 F.3d 1278, 1293 (Fed. Cir. 2020) (internal citations and quotations omitted).

In conducting the *Mayo/Alice* two-step analysis, a representative claim may be used for claims that are “substantially similar and linked to the same abstract idea.” *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014); *Smart Sys. Innovations, LLC v. Chicago Transit Auth.*, 873 F.3d 1364, 1368 n.7 (Fed. Cir. 2017) (concluding that claims “should rise or fall together” when they “contain only minor differences in terminology but require performance of the same basic process”) (internal quotation omitted). Likewise, the Asserted Claims of the Asserted Patents are similarly linked to the same abstract idea and therefore are equally ineligible under § 101.

This Court applies a burden-shifting framework, in which “[t]he party asserting invalidity may overcome the presumption of independent validity by offering a substantial rationale for treating a claim as representative.” *PPS Data, LLC v. Jack Henry & Assocs.*, 404 F.Supp.3d 1021, 1029-30 (E.D. Tex. 2019) (Gilstrap, J.). “Once the defendant has made a prima facie case the burden shifts to the plaintiff to identify limitations that are present in the asserted claims but that are not represented by the allegedly representative claim.” *Id.* at 1031-32. Further, “the representativeness inquiry must be ‘directly tethered to the claim language.’” *Id.* at 1030-31 (quoting *Solutran, Inc. v. Elavon, Inc.*, 931 F.3d 1161, 1168 (Fed. Cir. 2019)).

Pursuant to this Court’s Standing Order Regarding Subject-Matter Eligibility Contentions Applicable to All Patent Infringement Cases Assigned to Chief District Judge Rodney Gilstrap

(the “Standing Order”), Defendants set forth below its positions regarding subject matter eligibility for each of the Asserted Patents.

A. The ’102 Patent (Attachment A)

This patent—entitled “Server System and Method for Modifying a Cursor Image”—did not invent modifying a cursor in response to the cursor’s location on a webpage, nor does it even purport to improve the computer functionality involved in modifying a cursor on a webpage. Instead, the purported invention is merely directed to the abstract idea of modifying a cursor to an image related to the content displayed on a webpage. This is an ineligible abstract idea. *See, e.g., Yu v. Apple Inc.*, 1 F.4th 1040, 1043 (Fed. Cir. 2021), cert. denied, 142 S. Ct. 1113 (2022) (“claim 1 is directed to the abstract idea of taking two pictures (which may be at different exposures) and using one picture to enhance the other in some way.”), *In re Sturgeon*, 839 F. App’x 517, 518-520 (Fed. Cir. 2021) (“[a] method of creating a floral arrangement on an electronic display screen” was an abstract idea “described at a high level of generality and require only generic computer implementation”), *Plotagraph, Inc. v. Lightricks, Ltd.*, No. CV H-21-3873, 2022 WL 3213028, at *1 (S.D. Tex. Aug. 9, 2022) (“[a]nimating images by manipulating the pixels on an electronic device” is an abstract idea); *see also Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369-70 (Fed. Cir. 2015) (finding abstract a system that generated targeted online advertisements based on certain criteria).

At a minimum, the focus of the claimed advance is not a solution to “a problem specifically arising in the realm of computer networks or computers.” *TecSec*, 978 F.3d at 1293 (quoting *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257-58 (Fed. Cir. 2014)). In relevant part, the specification states:

[T]here is a need for a simple means to deliver advertising elements, i.e. logos, animations, sound impressions, text, etc., without the annoyance of totally

interrupting and intrusive content delivery, and without the passiveness of ordinary banner and frame advertisements which can be easily ignored.

'102 patent at 2:27-32.¹⁰ Thus, the Asserted Patents seek to resolve an issue related to presenting images on a webpage to improve, for example, the effectiveness of online advertisements, not a problem with computer networks or computers.

Nor is the claimed advance a “specific” improvement to computer networks or computers. *TecSec*, 978 F.3d at 1293. The specification admits that computer networks and computers had the ability to modify cursors and that the purported improvement over the prior art is modifying the cursor to, for example, “convey advertising.” '102 patent at 3:46-49.

In sum, the Asserted Claims of the Asserted Patents are not only directed to the abstract idea of modifying a cursor image to an image related to the content displayed, but the Asserted Claims fail both to address a problem with computer networks or computers and to provide a specific improvement.

Moving to *Alice/Mayo* Step 2, the purported “invention” fares no better at Step 2. Claim 72 of the '102 patent, the only Asserted Claim of that patent, generally recites three steps: (1) receiving a request at a server to provide information to a user terminal; (2) providing the requested information to the user terminal; and (3) “transforming” a cursor on the user terminal based on the information received from the server. None of these steps, either taken individually or as an ordered combination, provide significantly more than the abstract concept of modifying a cursor to an image related to the content displayed.

Furthermore, the specification is replete with references to conventional steps that occur over the Internet and conventional computer components. *See, e.g., id.* at 4:12-24 (describing a

¹⁰ The Asserted Patents share a common specification as the '449 patent is continuation of the '102 patent.

generic computer with a processor, operating system, a video monitor, and a HTTP-compliant web browser); *see also id.* at 10:23-41 (describing the general process of retrieving an HTML file containing instruction to modify a cursor from a server using conventional programming steps). Because Claim 72 fails to recite anything beyond well-understood, routine, and conventional steps and components in the relevant field, the claim fails to supply an inventive concept that would save it from being found ineligible at Step 2. As Claim 72 fails at both steps of the *Alice/Mayo* framework, it is not patentable subject matter under 35 U.S.C. § 101.

B. The '449 Patent (Attachment B)

Similar to the Asserted Claim of the '102 patent, the Asserted Claims of the '449 patent—which is also entitled “Server System and Method for Modifying a Cursor Image”—fails at both steps of the *Alice/Mayo* framework. Comparing Claim 1 of the '449 patent to Claim 72 of the '102 patent, the claims are directed to the same abstract idea, with the difference being Claim 72 of the '102 patent is a method claim, whereas, Claim 1 of the '449 patent is a system claim.

Given the similar focus of the claims and that Asserted Patents share a common specification, the Step 1 analysis above similarly applies to the Asserted Claims of the '449 patent. Claim 1 of the '449 patent, which is representative of the other Asserted Claims from that patent, is a system for modifying a cursor image to an image related to the content displayed on a webpage. This is the same abstract idea. *See Capital One Bank*, 792 F.3d at 1369-70. At a minimum, Claim 1 fails to address a problem with computer networks or computers and fails to provide a specific solution. Therefore, the claims of the '449 patent are ineligible at Step 1.

Moving to Step 2, although Claim 1 includes more limitations than Claim 72 of the '102 patent, these additional limitations are simply generic computer components. Thus, the Asserted Claims of the '449 patent, like the claims of the '102 patent above, fail to provide an inventive

concept sufficient to save the claims from abstraction. The limitations of the other Asserted Claims of the '449 patent do not change this analysis in any material way. Therefore, the Asserted Claims of the '449 patent fail at both steps of the *Alice/Mayo* framework and are not patentable subject matter under 35 U.S.C. § 101.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on November 14, 2022, the foregoing was served upon all counsel of record who have consented to electronic service.

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