IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

LEADER TECHNOLOGIES, INC., a Delaware corporation,	)	
	)	Civil Action No. 08-862-JJF/LPS
Plaintiff-Counterdefendant,	)	
v.	)	
FACEBOOK, INC., a Delaware corporation,	)	
Defendant-Counterclaimant.	)	

PLAINTIFF LEADER TECHNOLOGIES, INC.'S REPLY TO DEFENDANT FACEBOOK, INC.'S CLAIM CONSTRUCTION BRIEF

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I. INTRODUCTION

In the nearly fifteen years of claim construction jurisprudence since *Markman*, courts have construed patent terms that needed construction, and afforded the ordinary meaning to those terms that need no further construction. There is a fundamental disagreement between the parties as to the Court's role in claim construction. Where Leader seeks to interpret only those terms in need of construction, Facebook believes the Court should rewrite the entire claim and construe even those terms that have a common ordinary meaning or are self-evident. With its proposed constructions, Facebook is asking this Court to interpret nearly forty terms, most of which should be afforded their ordinary meaning, and essentially re-write the claims of United States Patent No. 7,139,761 ("the '761 Patent") with a host of imported limitations.

Facebook's approach to the process and purpose of claim construction is disconcerting. Where it would have the Court construe everyday terms, Facebook urges the Court to disregard the explicit definition of the term "component" that the patentee provided in the patent specification. Facebook does not provide any compelling reason why the Court should ignore the patentee's explicit intent to be his own lexicographer; it merely states that the explicit definition is not helpful.

Further, Facebook is attempting to use claim construction to request summary judgment of invalidity of all the asserted claims based on a tortured and unsupported means-plus-function argument. Facebook requests this Court to construe several terms of the '761 Patent as means-plus-function elements, while it simultaneously argues that no construction is possible for those terms. Indeed, Facebook's argument that the Court should find all the asserted claims invalid as a matter of law during claim construction is contrary to the law, as the Court is to construe the claims to sustain their validity. *Laboratory Skin Care, Inc. v. Limited Brands, Inc.*, 616 F. Supp. 2d 468, 470 (D. Del. 2009).

Finally, while Facebook argues that the fundamental purpose of claim construction is to assist the trier of fact in understanding the claims, its proposed constructions transform straightforward claims into an absurd mess. Thus, inserting Facebook's proposed constructions

into the claims does not assist the trier of fact and unnecessarily convolutes and complicates the claims. Declaration of James Hannah in Support of Plaintiff Leader Technologies, Inc.'s Reply to Defendant Facebook, Inc.'s Claim Construction Brief ("Hannah Decl."), Ex. 1, (reciting the asserted independent claims "rewritten" with Facebook's most recently proposed constructions).

Facebook's attempt to deconstruct the '761 Patent claims is the result of it trying to read extraneous limitations into straightforward claims in order to avoid infringement. Because Facebook's proposals provide no additional insight as to the meaning of the claim terms to one of skill in the art, they should be ignored. *See Laboratory Skin Care*, 616 F. Supp. 2d at 475.

II. PROCEDURAL ABUSES

Facebook's proposed constructions are simply not credible, as they have been a "moving target" during the claim construction process. In addition to the obscene number of terms Facebook is attempting to have the Court construe, Facebook disclosed for the first time in its brief that it is dropping eight terms it originally identified as requiring construction. After Leader was forced to use over 20% of its argument section addressing Facebook's proposals on these now-dropped terms, Facebook provided no explanation why terms it insisted needed construction during the meet and confer process now no longer require construction. Facebook also changed its position for at least ten other terms, disclosing its new proposals in its claim construction brief with no prior notice to Leader. At this stage of the case, Facebook should not be permitted to treat the meaning of the claims as malleable and adaptable. How the meaning of the claim terms "changed" since the parties' agreed-upon November 30, 2009 exchange of proposed terms and constructions and subsequent meet and confer indicates Facebook's lack of support for its positions in the first place and undermines the integrity of the claim construction process. Hannah Decl., Ex. 3. Indeed, Facebook has gone as far as withdrawing a proposed construction, replacing it with the new argument that the term is indefinite. D.I. 191 at 29.

Facebook's tactics are unfairly prejudicial, leaving Leader inadequate time and space to address Facebook's new positions. Moreover, Facebook has achieved the improbable by changing its proposed construction on approximately 40% of the terms it insisted required

construction just a few weeks ago. Facebook's proposed constructions, including the proposals for its new terms and constructions (and indeed, any new proposals that it might proffer at the claim construction hearing), should be rejected because, as evident from its actions, its proposals are not supported and its actions are unfairly prejudicial.

III. BACKGROUND OF THE TECHNOLOGY

Facebook attempts to equate the technology of the '761 Patent to physical objects (backpacks, tethers and breadcrumbs) in an effort to dumb-down the technology at issue and ultimately advance a far-reaching invalidity argument. However, the analogies are neither helpful nor accurate. The technology involved in the '761 Patent is adequately disclosed in the patent specification. Facebook, nonetheless, spends five pages using simple physical objects (complete with Hansel & Gretel's breadcrumb trail) that are intended to represent the digital computer world. Simply put, while Facebook's discussion of the technology involved in this case may be ready for a Grimm's Fairy Tale, it does not translate into the real computer world or the technology of the '761 Patent because (1) data is not physically tethered to a user, and the way data is associated with a user is nothing like physically tethering, (2) a user can access or employ data from different contexts, but this does not mean that the data is placed in a magical backpack that is taken from place to place with the user, as the backpack analogy is the antithesis of the invention of the '761 Patent because the purpose of the invention is to have a central repository of information that allows users to access and share information easily, and (3) while it is unclear what Facebook is getting at with the breadcrumb analogy, such crumbs would certainly mess-up a hard drive.

IV. ARGUMENT

Tellingly, Facebook ignored the majority of the arguments in Leader's Opening Brief. Facebook overlooks most, if not all, of its proposals that Leader identified as a circular construction, a construction which is directly contrary to the claims, or constructions that are completely redundant to the claims. Rather than address Leader's arguments, Facebook usually states that its construction should be adopted because Leader does not propose a counter

construction. This, however, is not the law. Only terms that need construction should be construed. Claim construction is "not an obligatory exercise in redundancy," *see U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997), and while every word in a claim has meaning, not every word requires construction. *Orion IP, LLC v. Staples, Inc.*, 406 F. Supp. 2d 717, 738 (E.D. Tex. 2005).[1]

Facebook's proposed paradigm for claim construction would lead to potentially ludicrous situations and results. For example, in Facebook's proposed paradigm, the accused would identify and offer a construction for nearly every claim term. A patentee would have to offer a competing construction for each term, including those where the plain and ordinary meaning should be applied, because the failure to do so would mean the accused's construction would prevail otherwise, even if it is completely absurd. The result would be situations, like here, where Facebook claims the term "capturing" requires construction based on the premise that the jury might think the term refers to taking a person prisoner, rather than a computer capturing data. D.I. 191 at 35. Fortunately, the law does not require construction of terms that are understood by those skilled in the art. *Laboratory Skin Care*, 616 F. Supp. 2d at 475.

A. The Three "Components" Elements Recited in the Claims

The term "component" is recited in relationship to a "context component," "storage component" and "tracking component." The patentee explicitly defined and provided structure for the term "component" in the specification of the '761 Patent:

> As used in this application, the terms "component" and "system" are intended to refer to a computer-related entity, either hardware, a combination of hardware and software, software, or software in execution.

D.I. 180, Ex. 3, col. 5, ll. 54-57. Thus, the patentee has acted as his own lexicographer and defined how this term is used in a patent. *See Phillips Inc. v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005)(citation omitted). Facebook did not offer a proposed construction for this term. Instead, it advocated for a tortured means-plus-function interpretation of the component terms,

[1] *See also UCB, Inc. et al. v. KV Pharm. Co.*, C.A. No. 08-223-JJF, 2009 WL 2524519, at *8 (D. Del. Aug. 18, 2009) (Court refused to paraphrase "approximately" as "almost exactly.").

punctuated by an improper request for a summary finding of invalidity. Facebook's proposals fly in the face of the patentee's explicit definition that provides structure in that definition, which includes "hardware, a combination of hardware and software, software, or software in execution."

1. Facebook's Faulty Means-Plus-Function Argument

The basis for Facebook's far-fetched means-plus-function arguments is its claim that the "component" claim terms do not have sufficiently definite structure. Facebook attempts to overcome the strong presumption against the proposition that the asserted claims are in a means-plus-function format by completely ignoring the language of the claims and the explicit definition provided in the specification[2]. For example, the claims recite:

a computer-implemented context component of the network based system

While the claim recites a definite structure, Facebook is seeking to have this Court determine that this phrase is functional and not structural. It is difficult to imagine how the patentee could have been clearer that the claimed components are structural. To make sure that one skilled in the art understood what structure was being referred to in the claims, the patentee specifically defined the structure for the component element and then further described the type of component in each of the claims themselves, such as "a computer-implemented context component of the network based system," "a computer-implemented tracking component of the network-based system" and "a storage component of the network-based system." Thus, there is no reasonable basis for construing the "component" terms as means-plus-function elements.

Furthermore, when the patentee wanted to claim his invention in a means-plus-function format, it was done so unequivocally. In Claim 22, the structural terms "context component," "storage component," or "tracking component" were not used; rather the term "means" followed by functional language was employed, demonstrating a clear intent to utilize means-plus-

[2] "[T]he failure to use "means" invokes a presumption that § 112, ¶ 6 does not apply." *Desa IP, LLC v. EML Techs., LLC*, No. 06-1168, Order at 6 (Fed. Cir. Jan. 4, 2007), *citing Apex inc. v. Raritan Computer, Inc.*, 325 F.3d 1365, 1371-72 (Fed. Cir. 2003). Hannah Decl., Ex. 4.

function claim language. D.I. 180, Ex. 3, Col. 23, ll. 1-19 ("computer-implemented means for creating data…," "computer-implemented means for tracking movement…."). Also, as raised in Leader's Opening Brief ("Leader's Br."), it is improper to construe Claim 1 and Claim 22 to cover the same subject matter under the doctrine of claim differentiation. D.I. 179 at 23. Facebook's failure to address this argument speaks volumes.

2. "Context Component" and "Tracking Component"

Facebook did not attempt to construe the "context component" and "tracking component" terms. If the Court simply construes the terms "context" and "component" (as "tracking" should be given its ordinary meaning), then there is no need to separately construe "context component" or "tracking component," as Leader's constructions of the individual terms based on the intrinsic evidence make sense together and within the recited language of the claims.

3. "Storage Component"

Facebook's sudden about-face regarding the proposed construction of "storage component" at this late stage of the case is troubling. In its Answering Brief, Facebook replaced its original proposal that "storage component" means "memory" with the claim that the term now is invalid as indefinite, based on the same arguments it has made for "context component" and "tracking component." D.I. 191 at 29. It is impossible to reconcile how Facebook could interpret the term, but could no longer do so when it filed its Answering Brief. This is particularly suspect, where it is based on the same infirm arguments made during the meet and confer process for the other "component" claim terms, as this was not a new "position" to Facebook.

"[C]laims should be construed to uphold validity." *Laboratory Skin Care,* 616 F. Supp. 2d at 470 (citation omitted). Furthermore, Facebook's new untimely argument is highly prejudicial and contrary to its earlier position. D.I. 191 at 29. Accordingly, "storage component" does not require a separate construction independently from the term "component" and all arguments made by Facebook regarding this term should be rejected.

B. The "Context" Terms

"Context" appears in several of the asserted claims and in connection to other terms. For example, the claims recite "context component," "context information," "first context," and "second context." Accordingly, Leader requests construction of just the term "context" to mean "environment," a definition that can be used every time the term is recited in the claims. Indeed, the specification equates "environment" with "context." D.I. 180, Ex. 3, Col. 6, ll. 28-30. In contrast, Facebook's proposals are inconsistent, as it proposes a different construction or no construction based on how "context" appears in the claims. For example, it argues that "context" should mean "a collection of interrelated webs," "context information" should mean "data that identifies at least a specific context," and "context component" cannot be defined. Facebook's proposed constructions for the "context" elements render the claims incomprehensible (*see* Hannah Decl., Exs. 1-2) and create a circular definition because it uses the term to define itself, *i.e.*, "context information" means data that identifies at least a specific ***context***. Next to these proposals, Facebook's simultaneous claim that the term cannot be defined when it appears as "context component" is contrary to the law of claim construction. Claim terms, like "context," should be construed consistently throughout the claims and construed to uphold validity. *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed. Cir. 1995), *Laboratory Skin Care,* 616 F. Supp. 2d at 470.

Facebook raises a claim differentiation argument based on the faulty premise that the inventors chose to refer to a "context" in Claim 1 and an "environment" in Claim 9. While the inventors did refer to a "context" in Claim 1, they refer to a "user environment" in Claim 9 and not simply an "environment." Because Claim 1 is presumed to be the broadest claim, and dependent Claim 4 requires that a "user environment" is a subset of a "context," a "context" must be broader than, but also include, a "user environment." Manual of Patent Examining Procedure § 608.01(m) (8th ed. 2008) ("Claims should preferably be arranged in order of scope so that the first claim presented is the least restrictive."). This is exactly why "context" means "environment" because an "environment" is broader, and encompasses a "user environment."

Facebook's claim that "context" is distinct from environment is undermined by its statement that the terms "context" and "environment" are "interlocked." D.I. 191 at 14. Furthermore, the specification confirms that "context" means "environment." It recites in relevant part: "[t]he user automatically enters into a user workspace or a first context ... or environment. ***This environment*** can be a default user workspace, or workspace environment predesignated by the user...." D.I. 180, Ex. 3, Col. 6, ll. 26-33 (emphasis added). The only way Facebook can dispute this intrinsic evidence supporting Leader's position that the terms are interchangeable is by omitting the second sentence which explicitly recites "this environment" in connection with the term "context." Facebook's other statement regarding the "context level" and the "web level" is difficult to understand and appears to be an attempt to improperly import limitations from the specification into the claims.

C. The Terms "Ordering" and "Traversing" Found in Claim 17

There are important differences in the parties' proposals for the terms "ordering" and "traversing" recited in Claim 17. Facebook imports unwarranted limitations into its proposed constructions. For "ordering," Facebook insists on adding the limitation of a "fixed sequence," a limitation that is not found anywhere in the specification. The problem with the "fixed sequence" limitation is that it implies that there is a preordained sequential order of the subsequent claim terms and renders the claim nonsensical. Claim 17 with Facebook's proposed construction would read as follows:

placing into a fixed sequence two or more of the plurality of user collection of interrelated contexts which is a collection of interrelated webs which is a collection of interrelated boards/workspaces which is a collection of data and computer program designed to accomplish a specific task functionally related to a user-defined topic

In contrast, below is Leader's construction implemented in Claim 17:

organizing two or more of the plurality of user environments according to different arrangements of the user environments

Ordering is used in Claim 17 to refer to the user's environments. Implementing Facebook's proposal for environment (*i.e.*, collection of interrelated contexts) would mean the

claim would contain no less than four interrelated collections of claim terms and constructions, where each of these collections would need to be placed in a fixed sequence. Putting aside the fact that Facebook's proposed construction makes the claim nearly incomprehensible, nothing in the '761 Patent indicates that the claims require placing several interrelated collections of data or programs into a "fixed sequence." Facebook's unsupported citations to a "routing algorithm" are unclear and simply do not describe "ordering."

Furthermore, Facebook's proposed construction for "ordering" has no relationship to its proposal for "ordering information," even though these terms appear in the same claim. Facebook has provided two distinct proposed constructions for "ordering information," shown below, neither of which mean "placing into a fixed sequence."

Facebook's Original Construction	Facebook's New Construction
The information is retrieved in the second user environment, as distinct from uploading, adding or creating it	Data that specifies a particular order in which user environments must be traversed

In addition to the prejudice to Leader as a result of Facebook changing its claim construction after Leader filed its Opening Brief, there is no support for Facebook's new proposal and the importation of the limitation "must be traversed" into the claim term. Indeed, Facebook's proposed construction renders the claim nonsensical. *See* Hannah Decl., Ex. 1.

With respect to the "traversing" term, Leader is willing to agree that it means "navigating." Facebook's inclusion, however, of the unsupported and extraneous limitations that the navigation has to be "by a user" and "according to a specific path or route" is not supported by the '761 Patent and makes Claim 17 nonsensical. For example, the claim requires "traversing the different arrangements . . . . to locate the data . . .." If the "traversing" term was construed to be navigation "according to a specific path or route," then it would not need to "locate" the data because it would already know where it is located. If the term is construed to mean "searching" or "navigating," then the claim makes sense.

If "traversing" is construed to be limited "to a specific path," the claim becomes illogical because it requires "traversing the different arrangements." With Facebook's proposed

construction, the claim would be problematic because "a specific path" is singular and "the different arrangements" is plural. "Different arrangements" will have different paths, not a specific path for a theoretically infinite number of arrangements.

D. The "Many-to-Many Functionality" Term Found In Claim 32

Facebook has no construction for the term "many-to-many functionality." Ignoring the intrinsic evidence (described in two pages in Leader's Opening Brief, D.I. 179 at 11-12), Facebook makes the unsupported declaration that this Court should find Claim 32 invalid. Because the '761 Patent specifically discusses that "many-to-many functionality" refers to multiple users being able to access multiple data files, the Court should construe this term as "two or more users able to access two or more data files." D.I. 180, Ex. 3, Col. 3, ll. 22-31 ("The tool…facilitates many-to-many relationships among data elements…").

E. Ordinary Meaning for Terms Used in Everyday Language

Facebook argues throughout its brief that terms which are readily understood should be construed. It agrees that words of a claim are generally given their ordinary and customary meaning. D.I. 191 at 8. Nonetheless, it seems to believe the Court must use the jury's understanding to construe the ordinary and customary meaning of the words of a claim. *Id.* The law is clear, however, that "the ordinary and customary meaning of a claim term is the meaning that the term would have to ***a person of ordinary skill in the art in question at the time of the invention***." *Phillips*, 415 F.3d at 1313 (emphasis added)(citations omitted). Thus, the yet-to-be-impaneled jury's understanding of the scope of the claims has no place during claim construction. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 977 (Fed. Cir. 1995) ("Construction of patent claims … is matter of law exclusively for court.")(citations omitted).

Furthermore, Facebook's case law citations provide no support for its threat to present claim construction evidence at trial if the Court does not construe its proposed terms. The situations in both *O2 Micro* and *American Patent Development* are distinguishable from this case. In those cases, both sides provided proposed construction of the ordinary meaning of certain terms by submitting competing dictionary definitions for them. Here the situation is

different because the dispute is not competing claim constructions. Rather the issue to be resolved is whether the 30 or so terms identified by Facebook need to be construed or whether, as Leader proposes, the ordinary meaning of those terms applies. Facebook will not be permitted to present evidence of its constructions at trial once this dispute is resolved.[3]

As set forth below and in Leader's Opening Brief, most of the claim terms have ordinary meaning to one of ordinary skill in the art (as well as lay individuals) and do not require construction. Given that there is no ambiguity regarding the meaning of these terms, Facebook's reliance on extrinsic evidence, namely an expert declaration and dictionary definitions, to import limitations is improper as a matter of law.

Upon reading Facebook's brief, it is clear that Facebook presents claim term constructions to this Court with a single goal in mind -- to deconstruct its way out of infringement by defining almost every term in a given claim, and linking each definition with the next. Because of this artificial linking of terms, Facebook purposefully creates a "funnel effect" with its latest proposed constructions. Each of these leads to an unsupported and legally untenable narrowing of the claims.

1. The Term "Environment"

"Environment" is a straightforward term, readily understood by those of skill in the art and lay persons. Facebook is attempting to make straightforward and readily understandable terms complicated. To define the claim term "environment" as found in Claims 4 and 9-20, Facebook contends that one must also define "context." To define "context," one must define "web," which itself requires the construction of the term "workspace." To define "workspace," one must define "application." Hannah Decl., Ex. 2. This linking relationship between Facebook's proposed constructions creates a funnel demonstrated in Figure 1 below:

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[3] *See Caddy Prods., Inc. v. American Seating Co.*, No. 05-800, 2008 WL 2447294, at *1 (D. Minn. June 13, 2008) (the Court was unpersuaded by defendant's use of *O2 Micro* and stated that a decision to adopt no definition for certain claim terms definitively resolved the meaning and scope of the disputed claims).

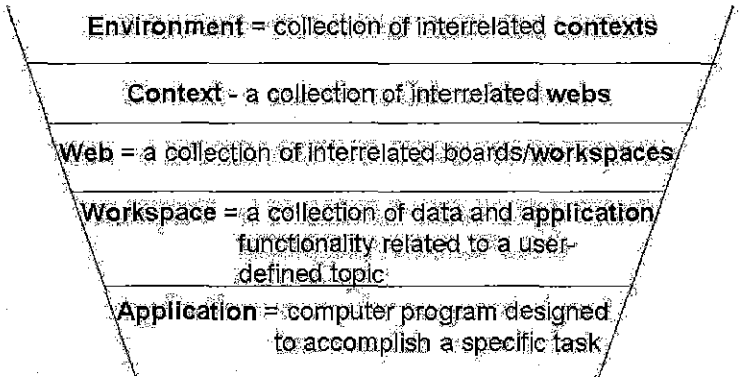

Figure 1

Importing numerous limitations into a single claim term, like "environment," results in an artificial narrowing of the claims -- the very thing Facebook wants in an attempt to escape infringement. In this one example, Facebook has added the limitations of "context," "web," "workspace" and "application" into Claim 9 by "back-dooring" those elements into proposed constructions of the claim term "environment." Thus, Facebook's proposed constructions make no sense when implemented in the claims and are not supported by the intrinsic evidence.

2. The Terms "Generating" and "Create"

There are several examples of Facebook's outrageous request for the Court to construe everyday terms. The proposed construction of the terms "generating" and "create" are near the top of the list of such ridiculous requests. Facebook would have the Court interpret "generating" to mean "create," and "create" to mean "bring into existence." Both of these terms can be understood by lay persons and those skilled in the art, and thus need no further construction. *Laboratory Skin Care,* 616 F. Supp. 2d at 475. Facebook's proposals become even more absurd because these two terms are used in Claim 17 and presumably, do not mean the same thing.[4]

3. The Term "Locate"

Facebook proposes that the Court construe the term "locate" to mean "find," begging the question how the term "find" is more helpful to the trier of fact than the term "locate." Contrary

[4] *See Applied Med. Resources Corp. v. U.S. Surgical Corp.*, 448 F.3d 1324, 1333 n.3 (Fed. Cir. 2006)(holding when different words are used in the same claim, they are required to have different meanings in order to maintain claim integrity and internal coherence).

to Facebook's assertion in its brief, Leader opposes construction of any term that does not require construction, including construing the term "locate."

4. The Term "Relationship" -- Now "Relationship Data"

During the parties' meet and confer process, Leader pointed out to Facebook that its proposed construction of "relationship" would result in nonsensical results for several claims, but Facebook insisted that the Court needed to construe this term. After reading Leader's Opening Brief showing the convoluted and ridiculous results of Facebook's proposed construction, Facebook now admits that its proposal for "relationship" is not appropriate. Rather than drop the term, however, Facebook has instead changed the requested term to be construed from "relationship" to "relationship data," compounding its abuses of the claim construction process. In addition to altering which claims are affected by this new proposed construction, the proposed construction for this new term does not cure the problems Facebook had with its original proposed construction. Namely, Claim 25 (the only claim with this term) is rendered nonsensical when Facebook's proposed construction is used. While this type of bait-and-switch tactic is bad enough, even more problematic is Facebook's false claim to this Court that since Leader "has offered no alternative construction" for this term, the Court should adopt Facebook's proposal. Indeed, as this is the first time Facebook has raised the "relationship data" term in this case, Facebook's argument is a complete misrepresentation to the Court. The ordinary meaning of this term should apply and it does not require construction.

5. The Terms "Accesses [the data]" and "[The data is] accessed"

Leader's Opening Brief makes clear that "accesses" and "accessed" are terms that need no construction as they are understood by a person of skill in the art and lay persons. Facebook ignored the arguments in Leader's Opening Brief. Notably, it failed to address three important issues detailed in Leader's Opening Brief, including the fact that the intrinsic record does not supports Facebook's construction, Claims 23 and 29 would be rendered nonsensical, and that Facebook's convoluted construction changes completely depending on the tense of the term.

It is well-established that "the claims of the patent will not read restrictively unless the patentee has demonstrated a clear intention to limit the scope using 'words or expressions of manifest exclusion or restriction.'" *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004)(quotation omitted). There is no evidence of any such clear intention to restrict this claim term. Facebook's reliance on the specification demonstrates a lack of intent to restrict the scope of the claim term. The specification states that "[v]arying levels of access ***can be*** provided to the uploaded data." D.I. 180, Ex. 3, Col. 11, ll. 30-31 (emphasis added). By mentioning that "access ***can be*** provided to the uploaded data," the patentee is demonstrating its intent ***not*** to limit the scope of the terms. Facebook's attempt to import this limitation into the construction is improper.

6. The Term "Arrangements"

"Arrangements" is a term that needs no construction as it is understood by a person of skill in the art and lay persons. Facebook ignored Leader's arguments that Facebook's proposed construction would render the claims nonsensical and simply failed to offer any argument for its proposed construction, only mentioning "arrangements" in passing. There is simply no basis for Facebook's proposal to narrow "arrangements" to mean "a specifically-ordered set of items," as even Facebook's purported citation to the specification does not refer to the term "arrangements."

7. The Term "Capturing"

Facebook apparently agrees that "capturing" is a well known term that does not require construction, as it states in its opposition brief that the term "'capturing' is readily understood by one of reasonable skill in the art." Facebook's feigned concern that a jury may think of pirates, prisoners, or the like when discussing the "capturing" term is unfounded, as the parties' witnesses and experts are certain to make clear that the case is about computer science. Since both parties agree that "capturing" is a well known term to those skilled in the art, the term should be afforded its ordinary meaning and does not need to be construed.

8. The Terms "Associated/Association/Associating"

In the two lines that Facebook uses to address the terms "associated," "association," and "associating," Facebook provides no support for its construction. It does not address Leader's argument that a link is used in the '761 Patent in reference to a network communications link, other than saying it is irrelevant. Apparently, Facebook does not consider the construction of this term important, and neither should the Court.

9. The Terms "Based on the Change," "Change Information," and "Change in Access of the User."

Facebook provides no support for its proposed construction of "based on the change" and does not rebut any of Leader's arguments. Apparently, Facebook concedes that no construction of "based on the change" is necessary because the claims already define the term. Specifically, "based on ***the*** change" is defined in Claim 1 as "***a*** change of the user from the first context to the second context." D.I. 180, Ex. 3, Col. 21, ll. 8-9. Thus, no construction is necessary.

Facebook's convoluted arguments regarding "change information" and "change in the access of the user" are also not compelling. As an initial matter, Facebook does not address the fact that its constructions import multiple terms requiring further construction according to Facebook, such as "context," and "workspace." Furthermore, Facebook's constructions are inconsistent with its other proposed constructions, such as "access." Contrary to Facebook's claim, Leader's primary dispute is that this term does not require construction, as well as the importation of limitations, such as "movement" into the claim term. Facebook has provided no evidence that the applicant intended to limit these straightforward terms to require additional limitations.

Finally, Facebook's citations to the intrinsic record support the definition set forth by the claims, and not Facebook's construction. As discussed and emphasized by Facebook, "*[t]he change in a user context is captured dynamically.*" D.I. 191 at 19. In other words, the change in access is captured, not the movement of the user. Thus, Facebook's citation to the specification supports the definition set forth in Claim 23, and not Facebook's contrived

construction.

10. The Term "Updating"

"Updating" is a very common term to those skilled in the art, lay persons, and small children, thus needing no construction. Facebook's proposed construction is based solely on extrinsic evidence "pulled directly from a dictionary." Facebook's Br. at 40. Aside from the problem of using solely extrinsic evidence for claim construction, its proposal is not even consistent with this dictionary definition, which defines the term as "to change a system or data file to make it more current." Facebook's proposed construction of "modifying existing data to make current" adds an additional limitation of changing only "existing" data, whereas the proposed dictionary definition does not include this limitation. It is baffling that Facebook's proffered dictionary does not support its proposed construction.

Moreover, Facebook simply ignores the fact that Facebook's proposal for "updating" renders the claims nonsensical and redundant, that data can be updated by adding (or subtracting) data, and that even a lay person knows that "updating" means "up to date."

11. The Term "Dynamically"

Facebook's proposed construction of "dynamically" is another blatant attempt to import improper limitations into a straightforward term. Its proposal that "dynamically" means "automatically and in response to the preceding event" is hopelessly vague and improperly imports the limitation of "in response to the preceding event." It is contrary to how a person of ordinary skill in the art would understand the term. D.I. 181, ¶17; D.I. 191 at 20-22.

Facebook primarily relies on the argument that when the term dynamically is used in the '761 Patent, it is always "in response to the preceding action by the user." D.I. 191 at 20. This is incorrect. For example, the '761 Patent states that "[an embodiment] can relate those projects substantially simultaneously. It can relate those projects to one another using whatever workflow model(s) are required, and dynamically assign modular communications tools (e.g., mail, voice mail, fax, teleconferencing, document sharing, etc.) to those many projects as desired." D.I. 180, Ex. 3, Col. 13, ll. 61-66. There is no preceding action by the user in this

example. Furthermore, in the claims themselves where this term appears, there is no requirement of a preceding action by the user. *See, e.g.*, D.I. 180, Ex. 3, Col. 22, ll. 12-34. Nothing in the '761 Patent requires the term "dynamically" to perform actions "in response" to some undefined preceding event and Facebook's rigid definition is improper.

12. The Various Uses of the Term "Employs"

Leader has consistently maintained that "employs" is a term that needs no construction as it is understood by a person of skill in the art and lay persons. Facebook's new proposals surrounding the term "employs," where Facebook dropped one of its three differing constructions of the term and changed one of its proposals, still suffers from the same pitfalls, discussed in Leader's Opening Brief. Facebook attempts to improperly import limitations into the claim term, including the exclusion of "uploading, adding or creating" from the definition. Facebook does not make a single citation to the intrinsic record in its attempt to support its limitations into "employs." To the extent Facebook relies on its arguments for "accesses," Leader refers to its briefing here and its Opening Brief why the definitions of "access" and "employs" do not exclude "uploading, adding or creating." Indeed, Facebook never explains the similarities or differences between "access" and "employs." Since Facebook admits that "employs" is generally understood, it does not require construction.

13. The Term "Remote location"

Facebook has no basis for requesting the Court to construe the straightforward term "remote location." Facebook asserts that Leader's belief regarding its proposed construction for "remote location" would require the user to be in a different physical location is wrong.

F. Ordinary Meaning for Terms Used by Those Skilled in the Art

1. The Term "Application(s)"

Facebook provides no support for its proposed construction of the term "application" to mean "a computer program designed to accomplish a specific task." As set forth in Leader's Opening Brief, Facebook's proposal imports unnecessary limitations into the claims and is contrary to the claims, which explicitly provide that "applications" can perform a variety of

tasks, as opposed to "a specific task." Rather than address Leader's arguments, Facebook relies solely on extrinsic evidence, namely a dictionary definition, to support its improper definition. Because Facebook has no intrinsic support for its proposal, "application" should not be construed and given its plain and ordinary meaning.

2. The Term "File storage pointers"

Facebook provides no basis ***whatsoever*** for its proposed construction of "file storage pointers." It is a complete waste of the Court's and Leader's resources to propose terms for construction that are known to those of ordinary skill in the art without any support.

3. The Term "Metadata"

Facebook's construction of "metadata" is convoluted and confusing, not to mention completely unsupported by the specification and contrary to the claims. Its proposal improperly imports numerous unsupported limitations, including "context," "webs," "boards," "workspaces," "applications," "user workspace," "user environment," and "associated," terms that Facebook contends require construction. Incorporating these limitations into the definition of the term "metadata" convolutes the claim term and renders the claims nonsensical. *See* Hannah Decl., Ex. 1.

As pointed out in Leader's Opening Brief, and ignored by Facebook, the contents of the "metadata" are explicitly defined in the claims. For example, Claim 1 stores context information in metadata, while Claim 9 stores information related to the user, the data, the application and the user environment. Facebook's proposed construction does not cover all of this information about the various types of data. Thus, there is no reason to construe metadata.

Among the many limitations that Facebook's proposed construction improperly attempts to import into the meaning of "metadata" is the requirement that it must store where "the user and data currently reside" even though there is no mention of such limitations in the intrinsic record. In fact, the '761 Patent never contemplates storing where the user and the data reside in metadata. At most, and only in Claims 9 and 21, the '761 Patent stores information ***relating*** to the user and data. This information may or may not include where the user and data reside, but

there is certainly no requirement that it must store the location of the user and data in metadata. As for the remaining claims, context information, context data, and association data is stored in metadata. In these claims, there is no requirement to store anything about the user or the data, much less where they reside. Thus, Facebook's proposal is contrary to the intrinsic evidence. There is no need to construe "metadata" and the plain and ordinary meaning should apply.

4. The Term "Portable wireless device"

Most people today walk around with a portable wireless device in their pocket -- it's called a cell phone. Even though Facebook cites no intrinsic or extrinsic support for its proposal, it nonetheless requests that the Court construe and limit this well-known term to include only a "device that can communicate with a computer network over a wireless communication medium." Because Facebook's proposal requires the use of two of the three words it is apparent the term does not need construction because "portable" is not a complicated term.

5. The Term "Relational storage methodology"

Facebook admits that this term is understandable by one of skill in the art. Because claim construction is undertaken through the eyes of one of skill in the art, no construction is needed.

6. The Term "Tagged"

Facebook admits that the term "tagged" is a term that is "understandable to one of ordinary skill in the art." Thus, the ordinary meaning should be used and there is no need to construe this term. Facebook's proposed construction for "tagged" to mean "attached" not only contradicts Facebook's admission that the term is understandable, but also indicates there is a physical proximity between items that have been tagged, which is improper. Because Facebook provides no support for it proposed construction, and because it is technically incorrect, the ordinary meaning should be used for this term.

7. The Term "Web"

Facebook failed to address Leader's arguments regarding its proposals for "web." In particular, Facebook ignores Leader's concerns that Facebook will improperly use its definition of "web" for the terms "web-based" and "web and video conferencing," which are separate terms

found in the claims. D.I. 179 at 39. "Web-based" refers to the World Wide Web or the Internet. *Id.*; *see also* D.I. 180, Ex. 3, Col. 14, ll. 51-60. This is illustrated with the applicant's description of Figure 14, which describes a web-based system accessed by Internet browsers and implemented by common Internet protocols such as SOAP, XML and HTTP. D.I. 180, Ex. 3, Col. 14, ll. 51-60. Moreover, "web" as used in Claim 30, refers to "web and video conferencing" which also refers to the World Wide Web. *Id.*, Col. 24, ll. 23-24.

When a special meaning is attributed to "web," it is found in the claim language. For example, as Facebook acknowledges, "web" is defined in Claim 3. It would be improper to import the limitations from Claim 3, which uses "web" in a special manner, into claims which use "web" as referring to the World Wide Web. *See e.g.,* D.I. 180, Ex. 3, Claims 9, 21, 23.

8. The Term "Workspace"

Facebook seeks to import limitations into a term that does not require construction. D.I. 191 at 12-13. Facebook's proposal is not supported by the claims and requires the Court to accept that ***all*** "workspaces" are "boards" (a limitation being read into the claims containing that term), and that "user-defined ***data***" is the same thing as "user-defined ***topic***" (a second limitation being read into the claims containing this term). For example, Claim 2 states in relevant part that "workspace … is a collection of data and application functionality related to the ***user-defined data***." D.I. 180, Ex. 3, Col. 21, ll. 13-15 (emphasis added). Facebook would have the Court construe "workspace" as "a collection of data…related to user-defined data" based on its assertion that "data" means "topic." D.I. 191 at 13. However, Claim 28 recites "related to a ***user-defined topic***," not "user-defined data." D.I. 180, Ex. 3 at Col. 24, l. 9 (emphasis added). Under the doctrine of claim differentiation, these terms are presumed to be non-equivalent. *See Comark Comm'ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1187 (Fed. Cir. 1998) (reciting the presumption that there is a difference in the meaning and scope when different words or phrases are used in different claims). Facebook does not rebut this presumption and wrongly uses the definition of the term "board" for its construction of "workspace." Accordingly, Facebook's construction should be dismissed because it is attempting to import limitations into the claims.

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Dated: December 30, 2009
947937

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

CERTIFICATE OF SERVICE

I, Philip A. Rovner, hereby certify that on December 30, 2009, the within document was filed with the Clerk of the Court using CM/ECF which will send notification of such filing(s) to the following; that the document was served on the following counsel as indicated; and that the document is available for viewing and downloading from CM/ECF.

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IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

LEADER TECHNOLOGIES, INC., a Delaware corporation,	)	
Plaintiff-Counterdefendant,	)	Civil Action No. 08-862-JJF/LPS
v.	)	
FACEBOOK, INC., a Delaware corporation,	)	
Defendant-Counterclaimant.	)	

DECLARATION OF JAMES HANNAH IN SUPPORT OF PLAINTIFF LEADER TECHNOLOGIES, INC.'S REPLY TO DEFENDANT FACEBOOK, INC.'S CLAIM CONSTRUCTION BRIEF

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Dated: December 30, 2009

I, James Hannah, hereby declare:

1. I am an attorney with the law firm King & Spalding LLP, counsel of record for Plaintiff Leader Technologies, Inc. ("Leader"). I have personal knowledge of the facts set forth in this declaration and can testify competently to those facts.

2. Attached hereto as Exhibit 1 is a true and correct copy of a re-writing of all the asserted independent claims of the United States Patent No. 7,139,761 (the "'761 Patent") using the proposed constructions from Defendant Facebook's ("Facebook") Answering Claim Construction Brief.

3. Attached hereto as Exhibit 2 is a true and correct copy of a document illustrating the layers of the proposed constructions from Facebook's Answering Claim Construction Brief.

4. Attached hereto as Exhibit 3 is a true and correct copy of the e-mails between the parties from November 19, 2009 to November 20, 2009 setting the claim construction briefing schedule.

5. Attached hereto as Exhibit 4 is a true and correct copy of the Order from *Desa IP, LLC v. EML Techs., LLC*, No. 06-1168 (Fed. Cir. Jan 4, 2007).

I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct. Executed this 30th day of December, 2009, at Redwood Shores, California.

James Hannah

EXHIBIT 1

EXHIBIT 1

Key:

BOLD - original claim language
UNDERLINE - Facebook's latest proposed terms
(BRACKET) - Facebook's latest proposed constructions

Original Claim	Claim with Facebook's Proposed Constructions
1. A computer-implemented network-based system that facilitates management of data, comprising:	**1. A computer-implemented network-based system that facilitates management of data, comprising:**
a computer-implemented context component of the network-based system for capturing context information associated with user-defined data created by user interaction of a user in a first context of the network-based system, the context component dynamically storing the context information in metadata associated with the user-defined data, the user-defined data and metadata stored on a storage component of the network-based system; and	**a computer-implemented context component** (non-existent structure) **of the network-based system for capturing** (obtaining) **context information** (data that identifies a specific context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) **associated** (linked) **with user-defined data created by user interaction of a user in a first context** (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **of the network-based system, the context component** (non-existent structure) **dynamically** (automatically and in response to the preceding event) **storing the context information** (data that identifies a specific context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) **in metadata** (a stored item of information associated (linked) with a user's

	data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/ workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))), user workspace (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) in which the user and the data currently reside) **associated** (linked) **with the user-defined data, the user-defined data and metadata** (a stored item of information associated (linked) with a user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))), user workspace (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside) **stored on a storage component** (non-existent structure) **of the network-based system; and**
a computer-implemented tracking component of the network-based system for tracking a change of the user from the first context to a second context of the network-based system and dynamically updating the stored metadata based on the change, wherein the user accesses the data from the	**a computer-implemented tracking component** (non-existent structure) **of the network-based system for tracking a change of the user from the first context** (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to

second context.	accomplish a specific task) functionality related to a user-defined topic))) **to a second context** (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **of the network-based system and dynamically** (automatically and in response to the preceding event) **updating** (modifying the existing data to make it current) **the stored metadata** (a stored item of information associated (linked) with a user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))), user workspace (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) in which the user and the data currently reside) **based on the change** (in response to the user's movement from the first context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) to the second context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))), **wherein the user accesses** (retrieves information in the second context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality

	related to a user-defined topic))) as distinct from uploading, adding or creating it) **the data from the second context** (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))).

Original Claim	Claim with Facebook's Proposed Constructions
9. A computer-implemented method of managing data, comprising computer-executable acts of:	**9. A computer-implemented method of managing data, comprising computer-executable acts of:**
creating data within a user environment of a web-based computing platform via user interaction with the user environment by a user using an application, the data in the form of at least files and documents;	**creating data within a user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) **of a web-based computing platform via user interaction with the user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)))) **by a user using an application** (a program designed to accomplish a specific task), **the data in the form of at least files and documents**;
dynamically associating metadata with the data, the data and metadata stored on a storage component of the web-based computing platform, the metadata includes information related to the user, the data, the application, and the user environment;	**dynamically** (automatically and in response to the preceding event) **associating** (linking) **metadata** (a stored item of information associated (linked) with the user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside) **with the**

	data, the data and metadata (a stored item of information associated (linked) with the user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside) **stored on a storage component** (non-existent structure) **of the web-based computing platform, the metadata** (a stored item of information associated (linked) with the user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside) **includes information related to the user, the data, the application** (a program designed to accomplish a specific task), **and the user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))); **tracking movement of the user from the user environment of the web-based computing platform to a**	**tracking movement of the user from the user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection

second user environment of the web-based computing platform; and	of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **of the web-based computing platform to a second user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **of the web-based computing platform; and**
dynamically updating the stored metadata with an association of the data, the application, and the second user environment wherein the user employs at least one of the application and the data from the second environment.	**dynamically** (automatically and in response to the preceding event) **updating** (modifying existing data to make current) **the stored metadata** (a stored item of information associated (linked) with the user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside) **with an association** (linking) **of the data, the application** (a program designed to accomplish a specific task), **and the second user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **wherein the user employs** (uses at least one of the application (a program designed to accomplish a specific task) and the data that is already in the second user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection

	of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))), as distinct from uploading, adding or creating them) **at least one of the application** (a program designed to accomplish a specific task) **and the data from the second environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))).

Original Claim	Claim with Facebook's Proposed Constructions
17. A computer-implemented method of managing data, comprising computer-executable acts of:	**17. A computer-implemented method of managing data, comprising computer-executable acts of:**
generating a plurality of user environments in a web-based system;	**generating** (creating) **a plurality of user environments** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **in a web-based system;**
ordering two or more of the plurality of user environments according to different arrangements of the user environments;	**ordering** placing into a fixed sequence **two or more of the plurality of user environments** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **according to different arrangements** (a specifically-ordered set of items) **of the user environments** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)));)
providing a plurality of applications for generating and processing data in the user environments, data of a user environment is dynamically associated with the user environment in metadata that corresponds to the data;	**providing a plurality of applications** (a program designed to accomplish a specific task) **for generating** (creating) **and processing data in the user environments** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))), **data of a**

	user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **is dynamically** (automatically and in response to the preceding event) **associated** (linked) **with the user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **in metadata** (a stored item of information associated (linked) with the user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside) **that corresponds to the data;**
creating an association of the data with a second user environment when the data is accessed from the second user environment;	**creating an association** (linking) **of the data with a second user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **when the data is accessed** (the information is retrieved in the second user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a

	specific task) functionality related to a user-defined topic))), as distinct from uploading, adding or creating it) **from the second user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic)));
dynamically storing the association of the data and the second user environment in the metadata;	**dynamically** (automatically and in response to the preceding event) **storing the association** (linking) **of the data and the second user environment** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **in the metadata** (a stored item of information associated (linked) with the user's data that identifies at least the context (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) or user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) in which the user and the data currently reside);
storing in a storage component ordering information related to the ordering of the two or more of the plurality of user environments; and	**storing in a storage component** (non-existent structure) **ordering information** (data that specifies a particular order in which user environment (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) must be traversed (navigation by

	the user according to a specific path or route) **related to the ordering** (placing into a fixed sequence) **of the two or more of the plurality of user environments** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))); **and**
traversing the different arrangements of the user environments with one or more of the applications based on the ordering information to locate the data associated with the user environments.	**traversing** (navigation by the user according to a specific path or route) **the different arrangements** (a specifically-ordered set of items) **of the user environments** (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and application (a program designed to accomplish a specific task) functionality related to a user-defined topic))) **with one or more of the applications** (a program designed to accomplish a specific task) **based on the ordering information** (data that specifies a particular order in which user environments (collection of interrelated contexts (a collection of interrelated webs (a collection of interrelated boards/workspaces (a collection of data and appli

EXHIBIT 2

Environment -- 5 Layers

environment = collection of interrelated contexts

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

Context -- 4 Layers

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

Web -- 3 Layers

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

Workspace -- 2 Layers

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

Metadata -- 7 Layers

metadata = a stored item of information associated with the user's data that identifies at least the context, user workspace or user environment in which the user and the data currently reside

↓

associated = linked

environment = collection of interrelated contexts

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

Context Information -- 5 Layers

context information = data that identifies at least a specific context

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

Change Information-- 3 Layers

change information = data that records the movement of a user from one workspace to another

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

Change in Access of the User -- 6 Layers

change in access of the user = movement of a user from the first workspace to the second workspace to facilitate access in the second workspace

↓

accesses = retreives information in the second context or user workspace as distinct from uploading, adding or creating it

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

Based on the Change -- 5 Layers

based on the change = in response to the user's movement from the first context to the second context

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

Accesses -- 5 Layers

accesses = retrieves information in the second context or user workspace as distinct from uploading, adding or creating it

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

Accessed -- 6 Layers

accessed = the information is retrieved in the second user environment, as distinct from uploading, adding or creating it

↓

environment = collection of interrelated contexts

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

Employs -- 6 Layers

employs = uses at least one of the application and the data that is already in the second user environment, as distinct from uploading, adding or creating them

↓

environment = collection of interrelated contexts

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

Employs -- 3 Layers

employs = uses at the application and data that is already in the second user workspace, as distinct from uploading, adding or creating them

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

Ordering Information -- 7 Layers

ordering information = data that specifies a particular order in which user environments must be traversed

↓

environment = collection of interrelated contexts

↓

context = a collection of interrelated webs

↓

web = a collection of interrelated boards/workspaces

↓

workspace = a collection of data and application functionality related to a user-defined topic

↓

application = a computer program designed to accomplish a specific task

traversing = navigation by the user according to a specific path or route

EXHIBIT 3

From: Hannah, James
Sent: Friday, November 20, 2009 3:24 PM
To: 'Norberg, Jeffrey'
Cc: 'Steven Caponi'; 'Stackel, Mary Ellen'; Weinstein, Mark; 'Patti Clark'; 'Thomas Preston'; Andre, Paul; Keefe, Heidi; 'Rovner, Philip A.'; Kobialka, Lisa; Kastens, Kristopher; Keyes, Melissa
Subject: RE: Leader v. Facebook - Claim Construction Schedule

Jeff,

As we discussed on the phone, the parties will follow the following claim construction briefing schedule:

November 23rd - Parties exchange claim terms
November 25th - Parties meet and confer regarding claim terms
November 30th - Parties exchange claim constructions
December 2nd - Parties meet and confer regarding claim constructions
December 10th - Leader files opening claim construction brief
December 23rd - Facebook files response claim construction brief
December 30th - Leader files reply claim construction brief

We also agreed that all people on this email chain shall be served the claim construction briefs by email on the above provided due dates.

Let me know if you have any questions.

James

From: Norberg, Jeffrey [mailto:jnorberg@cooley.com]
Sent: Friday, November 20, 2009 2:22 PM
To: Hannah, James
Cc: 'Steven Caponi'; 'Stackel, Mary Ellen'; Weinstein, Mark; 'Patti Clark'; 'Thomas Preston'; Andre, Paul; Keefe, Heidi; 'Rovner, Philip A.'; Kobialka, Lisa; Kastens, Kristopher
Subject: RE: Leader v. Facebook - Claim Construction Schedule

James,

To facilitate a more meaningful meet and confer process, we propose the following schedule:

November 23rd - Parties exchange claim terms
November 25th - Parties meet and confer regarding claim terms
November 30th - Parties exchange claim constructions
December 2nd - Parties meet and confer regarding claim constructions

December 9th - Leader files opening claim construction brief
December 23rd - Facebook files response claim construction brief
December 30th - Leader files reply claim construction brief

Sincerely,

Jeff

From: Hannah, James [mailto:jhannah@KSLAW.com]
Sent: Friday, November 20, 2009 12:00 PM
To: Norberg, Jeffrey
Cc: 'Steven Caponi'; 'Stackel, Mary Ellen'; Weinstein, Mark; 'Patti Clark'; 'Thomas Preston'; Andre, Paul; Keefe, Heidi; 'Rovner, Philip A.'; Kobialka, Lisa; Kastens, Kristopher
Subject: RE: Leader v. Facebook - Claim Construction Schedule

Jeff,

Please confirm that Facebook agrees to the briefing schedule provided below and that Facebook agrees to serve all briefs by email. Thanks.

James

From: Hannah, James
Sent: Thursday, November 19, 2009 12:08 PM
To: Norberg, Jeffrey
Cc: 'Steven Caponi'; 'Stackel, Mary Ellen'; Weinstein, Mark; 'Patti Clark'; 'Thomas Preston'; Andre, Paul; Keefe, Heidi; Rovner, Philip A.; Kobialka, Lisa; Kastens, Kristopher
Subject: Leader v. Facebook - Claim Construction Schedule

Jeff,

As a follow up to our conference this morning, we propose the following claim construction schedule:

November 23rd - Parties exchange claim terms
November 24th - Parties meet and confer regarding claim terms
November 25th - Parties exchange claim constructions
November 30th - Parties meet and confer regarding claim constructions
December 9th - Leader files opening claim construction brief
December 23rd - Facebook files opposition claim construction brief
December 30th - Leader files reply claim construction brief

Please let us know if Facebook agrees to the above claim construction briefing schedule. Also, due to the holiday season, we propose that all briefs be served by email to all parties addressed on this email. Please confirm that Facebook is agreeable to serve all briefs by email. Thanks.

James

James Hannah
Attorney At Law
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EXHIBIT 4

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit
(CORRECTED)

06-1168

DESA IP, LLC,

Plaintiff-Appellant,

v.

EML TECHNOLOGIES, LLC
and COSTCO WHOLESALE CORPORATION,

Defendants-Appellees.

James R. Higgins, Jr., Middleton Reutlinger, of Louisville, Kentucky, argued for plaintiff-appellant. With him on the brief were Augustus S. Herbert and Robert J. Theuerkauf.

Roger L. Cook, Townsend and Townsend and Crew LLP, of San Francisco, California, argued for defendants-appellees. With him on the brief was Iris Sockel Mitrakos.

Appealed from: United States District Court for the Middle District of Tennessee

Judge Aleta A. Trauger

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

06-1168

DESA IP, LLC,

Plaintiff-Appellant,

v.

EML TECHNOLOGIES, LLC
and COSTCO WHOLESALE CORPORATION,

Defendant-Appellees.

DECIDED: January 4, 2007

Before MICHEL, Chief Judge, PLAGER, Senior Circuit Judge, and RADER, Circuit Judge.

MICHEL, Chief Judge.

In this patent case, DESA IP, LLC ("DESA") appeals from a stipulated judgment of non-infringement, entered by the United States District Court for the Middle District of Tennessee following a claim construction hearing. Desa IP, LLC v. EML Techs., LLC, No. 3-04-0160 (Nov. 21, 2005). Because the district court erred in construing "sensor means" and other disputed terms, we vacate and remand.

I. BACKGROUND

DESA is the owner of United States Patent No. 5,598,066 ("the '066 patent"), directed to motion-activated security lights. The '066 patent discloses a light that

illuminates at two levels: (1) a dim "accent" level when dusk is detected by a photocell within the apparatus and (2) a brighter "security" level which is rapidly activated when motion is detected by a passive infrared motion sensor. The lamp remains illuminated at the "security" level as long as the motion sensor continues to detect motion (which resets an internal timer), but eventually returns to "accent" mode. When the photocell senses daylight, however, the lamp is turned off.

The '066 patent further discloses that, in the preferred embodiment, there is a "manual override" feature, which keeps the light continuously on at the brighter "security level" until daylight. The preferred embodiment also has a "pulse counting" feature, which avoids false triggering by activating the "security" mode only when motion is twice detected by the sensor within a specified time period. These additional features, (neither of which are present in the accused device), are explicitly recited in some, but not all, of the claims.

On February 27, 2004, DESA filed suit against EML Technologies LLC ("EML") and Costco Wholesale Corporation ("Costco"),[1] alleging infringement of claims 6, 9, 10 and 11 of the '066 patent. Claim 6 recites:

> An apparatus comprising:
>
> first sensor means for detecting a first predetermined condition external to said apparatus, said first predetermined condition being motion relative to said first sensor means of a person or object separate from said apparatus;
>
> second sensor means for detecting a second predetermined condition, said second predetermined condition being a predetermined level of light external to said apparatus;

[1] Costco imports and sells the allegedly infringing motion-activated security lights manufactured by EML.

> a lamp which can emit a first level of illumination and which can emit a second level of illumination substantially greater than said first level of illumination, said lamp being capable of switching rapidly from said first level of illumination to said second level of illumination; and
>
> control circuit means coupled to said lamp and responsive to said first and second sensor means for causing said lamp to emit light at said first level of illumination in the absence of said first predetermined condition in response to said second predetermined condition, and for causing said lamp to emit light at said second level of illumination in response to detection of said first predetermined condition;
>
> wherein said control circuit means includes means responsive to detection of said first predetermined condition for initiating measurement of a predetermined time interval, and responsive to expiration of said time interval for causing said lamp to thereafter emit light at said first level of illumination in response to said second predetermined condition in the absence of a recurrence of said first predetermined condition.

Claim 9 recites:

> sensor means for detecting a predetermined condition external to said apparatus;
>
> a lamp which can emit a first level of illumination and which can emit a second level of illumination substantially greater than said first level of illumination, said lamp being capable of switching rapidly from said first level of illumination to said second level of illumination; and
>
> control circuit means coupled to said lamp and responsive to said sensor means for causing said lamp to emit light at said first level of illumination in the absence of said predetermined condition, and for causing said lamp to emit light at said second level of illumination in response to detection of said predetermined condition, wherein said control circuit means is powered by an AC voltage, and wherein said control circuit means include switching means for selectively permitting and preventing the application of said AC voltage to said lamp and means for causing said switching means to be actuated for a selected portion of each half wave cycle of said AC voltage, said portion of said half waves being greater for said second level of illumination than for said first level of illumination.

Claims 10 and 11, although likewise drafted as independent claims, merely add additional limitations to those recited by claim 9.

The district court appointed as technical advisor Dr. Charles Carnal, a professor of electrical engineering at Tennessee Technological University. It held a three-day Markman hearing, during which multiple experts for both sides testified as to (1) the applicability of 35 U.S.C. § 112, ¶ 6 and (2) the meaning of the disputed claim terms.[2] At the end of the hearing, the court orally rendered its claim construction ruling. Hr'g Tr. 656-78, Oct. 27, 2005.

Most relevant to this appeal, the district court construed the disputed terms "sensor means," "control circuit means," and "switching means." As a preliminary matter, the court concluded that 35 U.S.C. § 112, ¶ 6 applied to all three of these phrases because the asserted claims did not recite sufficient structure, materials, or acts to perform the recited functions. Id. at 659:8-11.

The court found the corresponding structure for "first sensor means for detecting a first predetermined condition external to said apparatus" in claim 6—where "first predetermined condition" was internally defined within claim 6 to be "motion relative to said first sensor means of a person or object separate from said apparatus"—described at col.3 l.24-col.4 l.5 of the specification. Id. at 664:6-14. This definition includes not only the passive infrared sensors Q1 and Q2, but also what Professor Massengill dubbed "selection circuitry," i.e., circuits 43, 46, 47, 48 and 51 of Figures 2A and 2B. See id. at 481:5-11. The same meaning was ascribed to "sensor means for detecting a predetermined condition external to said apparatus" in claims 9, 10 and 11. Id. at 665:16-25.

---

[2] Mark Patterson, William Raper, Thomas J. Paulus, and Steven Carlson testified for DESA. J. Michael Thesz, Scott Evans, and Professor Lloyd Massengill testified on behalf of EML and Costco.

As for "control circuit means," the court found that this described, in plain language, "the means for causing the lamp to go on at accent level when there is no motion but it's dark or dusk, and then going up to the higher level of illumination, which I believe is 95%, in response to detection of the motion of a person or object." Id. at 667:15-22. It found the corresponding structure for this function described at col.5 l.63-col.6 l.14. Id. at 667:24-668:4.

Finally, "switching means for selectively permitting and preventing the application of said AC voltage to said lamp" was described by the court in plain language as "basically a switch that allows the lamp to either be on or off." Id. at 670:5-6. The court found the corresponding structure described at col.5 ll.13-25, which was, as EML and Costco had argued, "more than just the triac."[3] Id. at 670:22.

The court then stressed that all of the means-plus-function terms were being construed to include structural equivalents, too. Id. at 672:17. On October 31, 2005, the court issued a written order adopting these oral rulings without further explanation.

DESA subsequently conceded that none of the asserted claims were infringed, and a stipulated judgment was entered on November 21, 2005. This judgment is expressly conditioned upon the district court's interpretation of "sensor means" being upheld on appeal. A timely notice of appeal was filed on December 16, 2005. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

II. DISCUSSION

Claim construction is a question of law reviewed de novo. Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1454-56 (Fed. Cir. 1998) (en banc). When construing

[3] A triac is a type of electronic switch.

claim terms, the court determines the customary meaning of claim terms as understood by a person of ordinary skill in the art according to the methodology set forth in Vitronics Corp v. Conceptronics, Inc., 90 F.3d 1576, 1582-83 (Fed. Cir. 1996) and reaffirmed in Phillips v. AWH Corp., 415 F.3d 1303, 1312-19 (Fed. Cir. 2005) (en banc).

A

Where an element in a claim is expressed as a means or step for performing a specified function without reciting structure, it "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112, ¶ 6. This two-step inquiry involves determining (1) whether § 112, ¶ 6 applies and, if it does, (2) identifying the claimed function and corresponding structures in the written description. Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352, 1360 (Fed. Cir. 2000).

The use of the word "means" in the claim language invokes a rebuttable presumption that § 112, ¶ 6 applies; conversely, the failure to use "means" invokes a presumption that § 112, ¶ 6 does not apply. Apex Inc. v. Raritan Computer, Inc., 325 F.3d 1365, (Fed. Cir. 2003). Here, the key disputed phrases are "sensor means," "control circuit means," and "switching means." Nonetheless, the presumption that § 112, ¶ 6 applies may be rebutted if the claim recites no function or recites sufficient structure for performing that function. Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1427 28 (Fed. Cir. 1997).

The trial court recognized that the use of the word "means" invoked the presumption that § 112, ¶ 6 applied, but resorted to expert testimony to resolve whether that presumption was rebutted. DESA presented evidence from Mr. Patterson that the

use of "means" language was ambiguous because it was commonly used in electronics patents without necessarily intending to invoke § 112, ¶ 6. Mr. Carlson and Mr. Raper further testified that the modifiers "sensor," "control circuit," and "switch" were commonly understood by those skilled in the art to describe structure. Defendants' experts testified to the contrary. The district court ultimately rejected DESA's argument that the asserted claims contained sufficient structural language to escape the application of § 112, ¶ 6. Hr'g Tr. at 659:12-15.

Although the district court seemed to rely upon expert testimony,[4] we note that its conclusion could have been reached without the aid of extrinsic evidence. First, the claims use both means-plus-function language (i.e., "sensor means," "control circuit means," etc.) and structural language (i.e., lamp, zero crossing detect circuit, etc.), which suggests that the patentee intentionally used "means" language to invoke § 112, ¶ 6. Second, the claims recite a function for each of these "means" limitations without specifying what structure(s) would be required to perform that function. Third, we reject DESA's argument that the use of "sensor, "control circuit," and "switching" before the word "means" was sufficient to denote structure. Rather, those modifiers were simply used to distinguish between subsequent references to different "means" limitations within the same claim, i.e., "said first and second sensor means" as opposed to "said control circuit means." Finally, DESA argues that this court has previously stated that "it is clear that the term 'circuit' by itself connotes some structure." Apex, 325 F.3d at 1373. In Apex, however, the word "means" was not used, so the reverse

[4] While the court did not explain in detail the reasons behind its oral decision, we infer that the court found the expert testimony of Mr. Thesz and Professor Massengill to be more persuasive.

presumption—i.e., that § 112, ¶ 6 does not apply—was invoked. Here, we agree with the district court that DESA failed to overcome the presumption that § 112, ¶ 6 does apply to "sensor means," "control circuit means," and "switching means."

B

We now consider whether the district court correctly identified the claimed functions and corresponding structures of the disputed phrases. We conclude that it erred in relying upon Professor Massengill's expert testimony. In doing so, the district court construed each disputed claim term by simply referring to various passages in the specification that corresponded to portions of Figures 2A and 2B, which depict the preferred embodiment. Expert testimony in conflict with the intrinsic evidence, however, should have been accorded no weight. Phillips, 415 F.3d at 1318; see also Markman v. Westview Instruments, 517 U.S. 370, 390 (1996) (holding that expert testimony must be evaluated in a manner that "fully comports with specification and the claims" and "preserve[s] the patent's internal coherence").

1

With respect to "first sensor means" (of claim 6) or "sensor means" (of claims 9, 10, and 11) for detecting motion, the central dispute is whether this includes "selection circuitry" such as the pulse-counting function, as Professor Massengill testified. On appeal, DESA reiterates its argument that only Q1 and Q2—i.e., the passive infrared sensors depicted in Figure 2A—perform the motion-detecting function. We agree that "sensor means" is properly construed as "Q1 and Q2 or equivalents." All the other parts of Figures 2A and 2B, including the pulse-count function at 51, are part of the control circuit in the preferred embodiment.

Not only does the specification of the '066 patent repeatedly refer to the passive infrared sensors Q1 and Q2 as the "sensors," it even explicitly states that "[t]he sensors Q1 and Q2 are each coupled to a detector portion 43 of the circuit," (emphasis added) and then goes on to describe the additional functions of the circuit—i.e., selecting and amplifying the "signals most likely to correspond to infrared signals from a human body." Col.3 ll.34-35, 38-39. Because the intrinsic evidence clearly sets forth the corresponding structure for "sensor means," it was improper to rely upon contrary extrinsic evidence to construe this term.[5]

2

Although the stipulated judgment was only conditioned upon the claim construction of "sensor means," we now address the proper construction of "control circuit means." EML and Costco argue that the patentee distinguished certain prior art on the basis that the invention had a pulse-counting feature as "generally disclosed." Thus, they argue, the pulse-counting feature is a limitation of every claim, and if "sensor means" does not limit the invention to those devices with a pulse-counting function, then "control circuit means" does. We disagree.

The structure corresponding to "control circuit means" (i.e., everything except the lamp, the passive infrared sensors, and the photocell) necessarily varies from claim to claim, depending on the functions disclosed. For example, claim 6 contains a limitation wherein the lamp will revert to the first level of illumination after a predetermined time

[5] In any event, we reject with Professor Massengill's testimony that the "selection circuitry" is part of the "sensor means." Rather, the passive infrared sensors Q1 and Q2 detect motion, while the pulse-counting feature and other parts of the circuit are used to decide whether the lamp switches to the brighter level of illumination in response or whether the detected motion is ignored.

interval if additional motion is not detected, see col.8 ll.12-19, so a control circuit would have to include portion 52 of Figure 2B or its equivalent to be within the scope of claim 6. Claims 9-11, however, lack this particular limitation and would not require portion 52 to be part of an infringing control circuit. The same holds true for the pulse-counting function, which is expressly recited as a limitation only in claim 12.

Moreover, the Jensen/McCavit declaration in the prosecution history states that the prior art also lacked "other features as recited in the claims," not just the pulse-counting function. Specifically, the Nippon reference was distinguished on several grounds. Some claims recite the manual-override function, others recite the pulse-counting function, and "[i]n addition, [application] claims 2, 10, 11 and 12[6] are directed to features clearly not disclosed or suggested in the instruction manual." Although the validity of these claims remains to be decided, nothing in the prosecution history suggests that either the manual-override function or the pulse-counting function was intended to be a limitation of every claim. Unlike application claim 16 (which ultimately issued as claim 12), the claims asserted by DESA were not distinguished over prior art on the basis of the pulse-counting function.

3

Finally, as to "switching means" in claims 9, 10 and 11, we agree with DESA that this claim term is properly construed to mean "triac Q3 or equivalents." The other structures described in the portion of the specification referenced by the district court correspond to the "means for causing said switching means to be actuated for a

---

[6] These claims were renumbered and issued as claims 6, 9, 10, and 11.

selected portion of each half wave cycle of said AC voltage." Again, the court erred in relying upon expert testimony that was inconsistent with the intrinsic evidence.

III. CONCLUSION

For the aforementioned reasons, we vacate the stipulated judgment of non-infringement and remand for further proceedings consistent with this opinion. We expressly encourage the district court to revisit its claim construction for any other terms it deems necessary.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

CERTIFICATE OF SERVICE

I, Philip A. Rovner, hereby certify that on December 30, 2009, the within document was filed with the Clerk of the Court using CM/ECF which will send notification of such filing(s) to the following; that the document was served on the following counsel as indicated; and that the document is available for viewing and downloading from CM/ECF.

BY CM-ECF

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