

No. 2007-1174

**IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

DAVID H. SITRICK,

Plaintiff-Appellant,

v.

DREAMWORKS, LLC, NEW LINE PRODUCTIONS, INC.,
NEW LINE HOME ENTERTAINMENT, INC., WARNER MUSIC GROUP,
INC., WARNER BROS. RECORDS, INC., WARNER-ELEKTRA-ATLANTIC
CORPORATION, WARNER HOME VIDEO (doing business as Warner Reprise
Video), WARNER BROTHERS ENTERTAINMENT INCORPORATED,
and WARNER BROTHERS PICTURES,

Defendants-Appellees.

Appeal from the United States District Court for the Central District of
California in Case No. 03-CV-4265, Judge Stephen V. Wilson

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August 10, 2007

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

SITRICK v. DREAMWORKS, No. 2007-1174

CERTIFICATE OF INTEREST

Counsel for the Defendants-Appellees certifies the following:

1. The full name of every party or amicus represented by me is:

DreamWorks L.L.C., New Line Productions Inc., New Line Home Entertainment, Inc., Warner Music Inc. (formerly known as Warner Music Group Inc.), Warner Bros. Records Inc., Warner-Elektra-Atlantic Corporation, Warner Bros. Home Entertainment Inc. (formerly known as Warner Home Video Inc.), Warner Bros. Entertainment Inc., and Warner Bros. Pictures (a division of WB Studio Enterprises Inc.).

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

Not applicable.

3. All parent corporations and any publicly held companies that own ten (10) percent or more of the stock of the party or amicus curiae represented by me are:

a. DreamWorks L.L.C.'s ultimate parent corporation is Viacom Inc. Viacom Inc. is a publicly held company. The assets of "Shrek" and "Spirit: Stallion of the Cimarron" are owned by DreamWorks Animation SKG, Inc., a publicly traded company.

b. The parent corporations of New Line Productions, Inc. and New Line Home Entertainment, Inc. are New Line Cinema Corporation, Warner Communications Inc., American Television and Communications Corporation, Time Warner Companies, Inc., Historic TW Inc., and Time Warner Inc. Time Warner Inc. is a publicly held company.

c. The parent corporations of Warner Music Inc. (formerly known as Warner Music Group Inc.) are WMG Acquisition Corp. and Warner Music Group Corp. Warner Music Group Corp. is a publicly held company.

d. The parent corporations of Warner Bros. Records Inc. are WMG Acquisition Corp. and Warner Music Group Corp. Warner Music Group Corp. is a publicly held company.

e. The parent corporations of Warner-Elektra-Atlantic Corporation are WMG Acquisition Corp. and Warner Music Group Corp. Warner Music Group Corp. is a publicly held company.

f. The parent corporations of Warner Bros. Home Entertainment Inc. (formerly known as Warner Home Video Inc. and formerly a division of Time Warner Entertainment Company, L.P.) are Warner Bros. Entertainment Inc., Warner Communications Inc., American Television and Communications Corporation, Time Warner Companies, Inc., Historic TW Inc., and Time Warner Inc. Time Warner Inc. is a publicly held company.

g. Warner Bros. Pictures is a division of WB Studio Enterprises Inc. The parent corporations of WB Studio Enterprises Inc. are Warner Bros. Enterprises LLC, Warner Bros. Entertainment Inc., Warner Communications Inc., American Television and Communications Corporation, Time Warner Companies, Inc., Historic TW Inc., and Time Warner Inc. Time Warner Inc. is a publicly held company.

h. The parent corporations of Warner Bros. Entertainment Inc. are Warner Communications Inc., American Television and Communications Corporation, Time Warner Companies, Inc., Historic TW Inc., and Time Warner Inc. Time Warner Inc. is a publicly held company.

4. There is no such corporation as listed in paragraph 3.

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

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STATEMENT OF RELATED CASES

Plaintiff-Appellant filed a prior appeal in this action, which this Court dismissed for lack of a final judgment giving rise to appellate jurisdiction. *See* Case No. 2006-1580. Counsel is not aware of any case pending before this or any other court that will directly affect, or be directly affected by, this Court's decision. Fed. R. App. P. 47.5(a).

STATEMENT WITH RESPECT TO ORAL ARGUMENT

Defendants-Appellees ("Defendants") believe that oral argument is warranted in light of the issues raised in this appeal.

STATEMENT OF THE ISSUES

Whether the District Court correctly granted summary judgment of invalidity based on the undisputed evidence that Claim 56 of U.S. Patent No. 5,553,864 ("the '864 patent") and the asserted claims of U.S. Patent No. 6,425,825 ("the '825 patent"), Nos. 1, 20, 49, 57, 58, 62, 64, and 69, were not enabled for their full scope, which were construed to encompass both video game and non-video game embodiments such as motion pictures.

Whether the District Court correctly granted summary judgment of invalidity based on the indefiniteness of every asserted patent claim in the '825 patent.

Whether the District Court correctly granted summary judgment of noninfringement and invalidity as to Claim 54 of the '864 patent for lack of

evidence of infringement and enabling disclosure for a voice synthesizer that models voices.

Whether Plaintiff has waived any challenge to the Illinois District Court's transfer of this action to the Central District of California.

STATEMENT OF THE CASE

Plaintiff-Appellant David H. Sitrick ("Plaintiff") is a practicing patent attorney who drafted patents for many years before he began prosecuting his own patents. In addition, he has an active business of licensing patents and pursuing patent litigation. A722-24, 549-550, 553-555, 900, 905.

As will be evident from a review of the asserted patents, the claims are either poorly drafted or, possibly, intentionally vague and difficult to understand so as to allow for manipulation following issuance. Significantly, Plaintiff's patents disclose and claim an empty box, but do not teach how this empty box can be constructed to perform the essential process of substituting a user-provided image into a pre-existing audiovisual presentation – particularly in motion pictures, which Plaintiff asserts are covered by the claims. In an effort to support claims broad enough to cover motion pictures, Plaintiff filled his patent with a surplus of confusing and repetitive discussions relating to such substitutions of user-provided images in video games and used claim terms that are hopelessly and insolubly vague, indefinite, and confusing.

Armed with these patents, Plaintiff sought licenses from several motion picture companies. In this action, Plaintiff alleged that Defendants distributed DVDs with add-on features known as “Make-A-Movie” and “ReVoice Studio” that purportedly infringed the ‘864 and the ‘825 patents. A1419-1423, A1357-1362. Almost two years after initiating this litigation, Plaintiff additionally alleged that Defendants’ entirely different products, the successful motion pictures, “Gladiator,” “The Lord of the Rings: The Return of the King,” and “The Matrix Reloaded,” also infringe these patents. A1624-21, 1624-25.

Throughout this case, Plaintiff has not been able to advance a coherent explanation of what his patent claims mean, how they are enabled in the context of motion pictures, or how they are infringed by Defendants’ products. Many have attempted to make sense of these patents and to assign coherent and workable meanings to the claims, including Defendants, multiple experts, and a Special Master. But, none has been successful.

Putting an end to this litigation, the District Court granted summary judgment in favor of Defendants based on three independent grounds. First, Claim 56 of the ‘864 patent and the asserted claims of the ‘825 patent were invalid because the specification did not enable the full scope of these claims, which the District Court construed to encompass both video games and motion pictures. A22 n.3, 70-85. Second, the claims of the ‘825 patent were also invalid for

indefiniteness due to the insoluble ambiguity of the limitations “plurality of background images” and “video.” A39-46, 48-56. Third, there existed no triable issue of fact as to infringement of Claim 54 of the ‘864 patent, which in any event was not enabled because it did not disclose how to synthesize a user’s voice by “input[ting] as a model” a user’s “voice parameter data” to a “voice synthesizer.” A84-91.

Now, even on appeal, Plaintiff cannot point to any evidence or reason to support the enablement, definiteness, or infringement of his patent claims. Because the District Court correctly ruled on all these issues, its summary judgment ruling should be affirmed in its entirety.

STATEMENT OF FACTS

I. THE TWO PATENTS AND ALLEGED INVENTIONS AT ISSUE

Plaintiff asserted literal infringement of two related patents. A1294. The ‘864 patent (filed on May 22, 1992) is entitled “User Image Integration Into Audiovisual Presentation System And Methodology.” A112. It purportedly describes a system for incorporating a user-provided image into a video game. A18-19. The specification states that “this invention relates to video games” and to providing a “methodology for smooth integration of user created video graphics into a predefined video game system.” A134 at 1:5-8.

In the Summary of the Invention, the '864 patent states that the system “provides an environment whereby a user can create a video or other image ... and whereby the user created image ... can be communicated and integrated into the audiovisual presentation, and game play of a video game.” A134 at 1:54-62. This incorporation of the user image occurs in a “*monolithic and homogeneous* fashion” A134 at 2:1-4 (emphasis added). Plaintiff, the inventor and drafter of the patent (A1300), testified that the terms “monolithic” and “homogeneous” mean that the resulting image “would appear to the user to be seamlessly integrated and all part of one structure. To the user, it shouldn't be obvious that there has been an integration” of an external user-provided image (A7550-551).

The '825 patent is entitled “User Image Integration And Tracking For An Audiovisual Presentation System And Methodology.” A154. It was filed as a continuation of U.S. Patent No. 5,830,065 (not at issue in this case), which was a continuation-in-part of the '864 patent.

The description of the '825 patent is similar to the '864 patent, but it also purports to extend the alleged inventions to pre-recorded movies, animations, and amusement park presentations. A19, 184. The '825 patent states that “this invention relates to predefined video and audiovisual presentations such as movies and video games.” A184 at 1:9-10. The Summary of the Invention provides that “the present invention encompasses an entertainment system capable of integrating

images into a predefined audiovisual presentation” through use of a so-called “controller” said to receive audio and video signals from any source and that “analyzes the audio and video signals and modifies the signals to integrate the user image into the audiovisual presentation.” A184 at 2:30-45.

In the Background of the Invention, the ‘825 patent characterizes as “crude” prior art systems in amusement parks that use a “blue screen, compositing computer system” to incorporate audience members into a movie clip.¹ A184 at 2:20-27. In such prior art, the “audience member’s image [merely] overlays the movie clip and is not blended into the movie.” *Id.* According to the ‘825 patent, “[u]sing this approach, there can be no realistic interaction between the audience member and the cast in the movie clip.” *Id.*

The ‘864 and ‘825 patents purport to “facilitate[] realistically integrating a user’s image into a video presentation or video game.” A184 at 2:25-26, 2:66-65 (“monolithic and homogeneous”); *see also* A134 at 1:7 (“smooth integration”). Assuming the alleged inventions could be implemented for visual information, a child could integrate a picture of his or her face for the face of a favorite character in “any ‘audiovisual image source [that] provides an audiovisual presentation output such as video (video cassette record, cable or broadcast television, laser

¹ Blue-screen technology is employed to overlay images – for example, a television weather forecaster onto a weather map. A7288-89.

disk, audiovisual, digital video tape, formatted image data [e.g., PICT]), audio tape or disk, which output is coupled to a display.” A72 (quoting A192 at 17:3-8). The purported inventions would account for variations in size, shape, position, and motion between the image of the child’s face and the face of the selected character. A134 at 1:7, 184 at 2:25-26, 2:66-65. If the selected character moved or spoke, then the integrated image of the child’s face would appear to move or speak in the same manner and with the same timing. *See id.* The child likewise could integrate his or her entire body for the entire body of the character. A190 at 13:2-4 (stating that “the present invention encompasses beyond facial views to cover heads, full body, hands, or pictures or images of anything”).

The patents also purport to work with “user images” that consist of aural information. In particular, the ‘864 patent describes two embodiments for working with aural user images, either (1) “by a direct playback of the words spoken by the user,” or (2) “by a device extracting voice parameters from a sample of the user’s voice so that the user’s voice can be modeled to say anything.” A19, 136 at 6:4-9.

Plaintiff has never built or demonstrated a working model of these alleged inventions. A1296. Furthermore, the specifications of the ‘864 and ‘825 patents disclose an “Intercept Adapter Interface System” (“IAIS”), but do not disclose how to make or use the IAIS’s associated “controller,” the critical component identified in the specifications as the means for selecting, analyzing, and integrating a user’s

image into a video or audiovisual presentation. A73-74. The “controller” is merely an empty box in the specification. A124-125, 166-167.

II. PLAINTIFF’S INFRINGEMENT ALLEGATIONS

In his original complaint, Plaintiff alleged that DVDs with the ReVoice Studio and Make-A-Movie add-on features infringed the ‘864 and ‘825 patents. A214-15, 217-18. ReVoice Studio is one of numerous add-on features on the DVDs distributed for the motion pictures “Shrek” and “Austin Powers in Goldmember,” and the music video collection “Barelaked Nadies.” A211-212, 332, 336. Similarly, Make-A-Movie is one of the add-on features on the DVD, “Spirit – Stallion of the Cimarron.” A212.²

Shortly after this action was filed in the Northern District of Illinois, it was transferred to California. A899-907. Plaintiff never moved in the District Court in California to transfer the action back to Illinois. A104-1 to 111-21.

As the close of discovery and trial approached, Plaintiff amended his complaint to allege that several motion pictures infringe his patents: “Gladiator,” “The Lord of the Rings: The Return of the King,” and “The Matrix Reloaded.”

² Plaintiff incorrectly states that like “Shrek,” the “Spirit” DVD allowed integration of user voice images using personal computer.” Pl.’s Br. p. 12. The “Spirit” DVD does not include the ReVoice Studio feature, and the Make-A-Movie feature does not record user’s voices nor substitute them for character’s voices. In any event, this issue is moot given that Plaintiff has abandoned his infringement claim against Make-A-Movie and does not appeal this issue. A11-15.

A1624-1 to 1624-35. Although Plaintiff was permitted to amend the scope of his infringement claims, the District Court exercised its discretion to sever and stay the issue of whether these motion pictures infringed Plaintiff's patents. A2713-15. As to his earlier asserted infringement claims, Plaintiff expressly abandoned his infringement claim directed against Make-A-Movie, and the District Court granted summary judgment of noninfringement as to that claim. A13-15, 86. As to the infringement claim directed against ReVoice Studio, the patent claims that were at issue at the time of the summary judgment motions were Claims 54 and 56 of the '864 patent and Claims 1, 20, 49, 57, 58, 62, 64, and 69 of the '825 patent.

ReVoice Studio allows users to record themselves speaking the spoken lines from a preselected scene in a motion picture. A20, 62-63, A7372-7377. For example, users can record themselves speaking a line from the motion picture *Shrek* that was spoken by the character Shrek. *Id.* ReVoice Studio then plays back that recording, adjusting the timing of the spoken line to synchronize with the timing of the same words spoken by Shrek in the preselected scene. *Id.* The result is that where the same line from the film is recorded by the user, the character Shrek would appear to speak the line in the user's voice. *Id.*

ReVoice Studio does not allow for the alteration of the visual portion of a motion picture. A20, 7375. ReVoice Studio also cannot take recorded speech and generate new speech; it merely plays back the recorded words spoken by the user

synchronized to the lip movements of the character. A20, 88-89, 7358-7360. If a user deviates from the dialogue originally spoken by a character, ReVoice Studio cannot take the characteristics of the user's voice to synthesize the words to conform to the original dialogue spoken by the character. *Id.* In such cases, ReVoice Studio can play back only what was uttered and recorded by the user, which, where the original dialogue is deviated from, will not match the original dialogue nor the lip movements of the character. *Id.*

III. DEFENDANTS' SUMMARY JUDGMENT MOTIONS

After the close of discovery, Defendants filed four summary judgment motions as to all of the asserted patent claims based upon: (1) noninfringement and/or invalidity under 35 U.S.C. § 102; (2) invalidity for lack of enablement and insufficient written description under 35 U.S.C. § 112, ¶ 1; (3) invalidity for indefiniteness under 35 U.S.C. § 112, ¶ 2; and (4) unenforceability, invalidity, and/or intervening rights based on inequitable conduct. A6436, 7704-23.

Plaintiff opposed each of the grounds for summary judgment raised in Defendants' motions, with the exception of: (1) noninfringement as to the Make-A-Movie product (which Plaintiff abandoned "with prejudice" (A11-12, 14-15 & nn. 3-5, 86, 8011, 8136, 8158-59, 8164, 10244)), and (2) non-infringement as to Claim 56 of the '864 patent (A86-87, 10243-45). Plaintiff's oppositions relied almost exclusively upon the opinion of his expert, Dr. Vacroux. On the question of

enablement, Dr. Vacroux offered a conclusory and tentative opinion, formulated in the negative, and prefaced with an admission that he was not “familiar with” the process of making motion pictures: “Following a thorough analysis of both of the patents-in-suit, I have found nothing that would lead me to conclude that the invention described in those patents could not be applied to the field of movie creation.” A76 (quoting Dr. Vacroux). Likewise, without reviewing the source code for ReVoice Studio, Dr. Vacroux offered the conclusory opinion that “The ReVoice Studio feature satisfies the ‘synthesizing’ and ‘interjecting’ limitation” of Claim 54 of the ‘864 patent and thus infringes Claim 54. A90. In addition, Dr. Vacroux opined “that transform analysis, a technique [he] claim[ed] was widely known in the field when the ‘864 patent was filed, would allow a character’s voice to be isolated from the rest of a soundtrack and replaced by a user’s voice (without affecting the background noises).” A65.

Defendants objected to these opinions by Dr. Vacroux as conclusory, speculative, beyond his claimed area of expertise, and untimely because they were belatedly disclosed only after discovery had closed and after a motion for summary judgment was filed by Defendants. A64-66, 76-77.

IV. THE DISTRICT COURT GRANTED SUMMARY JUDGMENT ON THREE INDEPENDENT GROUNDS

The District Court referred the summary judgment motions and motions to strike to a Special Master. Upon *de novo* review of the Special Master’s

recommendations, the District Court granted summary judgment of noninfringement and invalidity in favor of Defendants.

A. Claim 56 Of The ‘864 Patent And All Claims Asserted Under The ‘825 Patent Were Held Invalid For Lack Of Enablement

The District Court held that the patent specifications do not enable the claimed inventions for motion pictures. A70-85. The District Court assumed (without deciding) for the purpose of the summary judgment ruling that the system described in the patent was possibly enabled for video games (a proposition that Defendants dispute). A72-73. The District Court traced the lack of enablement for motion pictures to the inherent differences between video games and motion pictures (or other types of pre-recorded audiovisual presentations). A72-85.

The patents describe systems where “an interface adaptor would select,” for instance, character *X*’s face from a video game “as the character function to be replaced by the user image (the user’s face)... Because the face of character *X* had been selected as the character feature that would be replaced with the user’s image, ... [t]he user’s face would then be incorporated in place of the pre-existing face of Character *X*” in the video game. A19. To function, the systems described in the patents must (1) identify “specific character functions of predefined images,” (2) recognize “requests for those character functions,” (3) intercept the requests by the video game apparatus for those character functions, and then (4) reroute such

requests “so that the user image, rather than the predefined image” would be retrieved from the user’s storage card and appear in the audiovisual display. A73.

In video games, each character function or image (*e.g.*, the head, torso, arms, and legs) is discretely stored in memory and is “separately retrieved by discrete address signals, and the motion of each [character] is controlled by discrete control signals” A75. But, unlike in video games, “character images in pre-existing movies and animations are inseparable from other surrounding images. Pre-existing movies do not employ discrete address and control signals, or any other means for requesting separate image segments to be assembled into the character or the overall image within each frame of the presentation.” A75.

Based in part on these fundamental differences, the District Court concluded that the specifications were non-enabling for motion pictures because they “never discusse[d] how a character function or predefined image can be identified and separately carved out of the frame” in a motion picture. A75. The “analysis techniques” disclosed in the patents “for identifying character functions or intercepting character signals [have] no relevance to movies.” A74. Those analysis techniques could be relevant to video games to analyze when and at what memory location a portion of a character could be accessed and retrieved from memory. But they could not be relevant to motion pictures, wherein character

images are inseparable from the overall image that makes up the frame. A74-75; *see also* A7246-56.

The District Court also concluded that Plaintiff had failed to present any evidence that would raise a triable issue of material fact. Plaintiff's citations to the patent were "either *specifically* about video games or completely irrelevant." A76. The opinions of Plaintiff's expert, Dr. Vacroux, did not "create a material issue of fact" because they were "conclusory," "unsupported by any actual information," and rendered by a person who "admitted to not being skilled in the art of movie making" A76-78.

In addition, the District Court found a lack of an enabling disclosure in Plaintiff's patents regarding how to substitute audio (*e.g.*, dialogue) in motion pictures "either with or without the use of voice parameter models yielding a synthesized voice." A81-82. The District Court found that Defendants' expert presented clear and convincing evidence that such substitutions were difficult, if not impossible, and the "patents provide no guidance for overcoming these difficulties." A82-83.

Furthermore, the District Court struck as untimely Plaintiff's belatedly-submitted expert evidence regarding a so-called "transform analysis" technique which purportedly could isolate a single character's voice from within a motion picture soundtrack. A65-66. This purported evidence was submitted only after the

close of discovery and after Defendants had moved for summary judgment. The District Court found that Plaintiff had “not provided ‘substantial justification’” for not disclosing this opinion in response to Defendants’ experts’ opinions on nonenablement of audio substitution, “and the Court [could not] say that the omission was harmless.” A66. As a result, there was no evidence whatsoever in the record to rebut Defendants’ nonenablement evidence.

B. Claim Limitations In The ‘825 Patent Were Held Insolubly Ambiguous

The District Court also held that all of the asserted claims in the ‘825 patent were invalid due to the insoluble ambiguity of two claim limitations: the highly problematic term “*plurality of background images*” and the inconsistently used term “*video*.” A39-46, 48-56. The District Court did so only after considering every possible construction advanced by the parties and Special Master and after resolving “any uncertainty with respect to” indefiniteness “in favor of the patentee.” A40.

1. The District Court held “plurality of background images” indefinite

The District Court first addressed the phrase “plurality of background images” and considered three proposed constructions: (1) “background image” being a “screen shot” and a “plurality of background images” being a “sequential series of more than one screen shots” (proposed by the Special Master) (A41-42);

(2) “more than one movie or other type of presentation” (suggested by Defendants)³ (A44); or (3) a “screen shot” “comprised of multiple background images” (proposed by Plaintiff) (A42, 45).

The District Court rejected the Special Master’s recommended construction because it was inconsistent with the teachings of the ‘825 patent. A43-46. The District Court stated that “any definition of ‘plurality of background images’ must make sense of the explicit definition of ‘background image’ made in the patent,” and the Special Master’s construction did not. A46.

First, the District Court found that while the “Special Master’s definition of ‘screen shot’ reasonably captures” the patentee’s intention to “communicate that the background images[s] must be in motion by using ‘plurality of background images,’” this definition “ignore[s] the explicit definition in the specification and in the claims that ‘background image’ can mean ‘audio presentation.’” *Id.* Construing “background image” as a “screen shot” is “meaningless for an audio presentation” because a “screen shot” “certainly refers to visual images and not to sounds.” *Id.*; *see also* A44-45.

Second, the District Court also found the definition problematic because the intrinsic evidence is “internally inconsistent.” A43-44. The definition of a single

³ If the phrase was not held indefinite, Defendants proposed the explicit definition of Col. 30, ll. 3-5 and Claim 39 of the ‘825 patent. For reasons explained *infra*, however, even this explicit definition is contradicted within the patent.

“background image” as a single “screen shot” comes from the premise that a video or audiovisual presentation is “representative” (*i.e.*, made up) of a “*plurality of background images.*” *Id.*⁴ This definition contradicts the specification and claims, which expressly define a single “background image” as *the* “video presentation” or “audiovisual presentation.” *Id.*⁵ Simply put, the question is, do multiple background images make up a single video or audiovisual presentation, or does a single background image refer to a single video or audiovisual presentation? Although “one could argue that a video presentation, for example, could be construed as a still visual image, so that a plurality of background images would be more than one still visual images [sic],” “this interpretation of ‘video presentation’ as a still visual image contradicts the way ‘video presentation’ is used in [the claims], which clearly means to use ‘video presentation’ as a synonym for moving picture.” *Id.*

The Court also rejected both Defendants’ and Plaintiff’s proposed constructions. The Court noted that although Defendants’ suggested construction was based on an “explicit definition” in the patent defining a single “background

⁴ See, e.g., A184 at 1:9-10 (“This invention relates to predefined video and audiovisual presentations such as movies and video games”); Claim 16 (“video presentation representative of a plurality of background images”); Claims 26, 38, 57, and 62.

⁵ See A184 at 30:3-5 and Claim 39 (defining “background image” as a “video presentation,” “audiovisual presentation,” or “audio presentation”).

image” as a single “video presentation,” “audiovisual presentation,” or “audio presentation,” the proposed construction of “more than one movie or other presentation” was “totally contrary” to teachings of the patent. A44. Likewise, the Court rejected Plaintiff’s proposed construction of a “plurality of background images” as being multiple background images within a screen shot because such a construction would require the “user image” in Claim 1, for example, to “appear (or be heard) at least twice in the screen shot” because the claim expressly requires “at least two background images” to comprise at least one “common character function,” with which the “user image” is “integrated in place of.” A45. As to this, the Court found that “there is simply no such teaching in the patent.” *Id.*

Thus, the District Court held that the undisputed evidence “clearly and convincingly” established that “plurality of background images” is indefinite because “the issue goes beyond simple clarity of phrasing into the fundamental problem that it does not appear possible for any construction of the phrase ‘plurality of background images’ to fully make sense throughout the patent.” A46.

2. The District Court also held “video” indefinite

As to the claim term “video,” the Special Master had recommended Plaintiff’s proposed construction of “video” as referring “to a presentation having a visual component, and includes as a subset an audiovisual presentation (that is, a visual presentation that includes sound.)” A48. Defendants had proposed

construing “video” as referring exclusively to visual information. *Id.* The District Court concluded that no one meaning could be assigned to “video” and found it to be indefinite.

On the one hand, the Court found numerous instances in the intrinsic evidence that supported construing “video” as exclusively visual information, which construction is also supported by the extrinsic evidence. A50-54. Specifically, the terms “video” and “audiovisual” “are used [throughout the claims and specification] as alternatives to one another, which preclude them from being the same thing.” A50-51 (citing to the ‘825 Patent at Claim 30 — “the ancillary data is comprised of at least one of a video and an audiovisual presentation”); Claim 39, Fig. 5F, A184 at 1:9-11.⁶ Moreover, the claims refer to the “character function as having both *position* and *timing*” and the Court found that “it is very difficult to understand how audio can have position.”⁷ A50. Furthermore, the construction of “video” as “visual” also found support in the prosecution history where the examiner referred to “video image” as “silent films” and distinguished it from an “audiovisual image.” A51-52 (citing to A7516). Finally, the Court found that dictionary definitions distinguish “video” from “audio,” and define “video” as

⁶ The terms “video” and “audio” are likewise used to refer to different things. *See, e.g.,* A184 at 2:39 (“audiovisual source provides *audio* and *video* signals”) (emphasis added), 8:23, 9:44, 12:54-13:11, 20:54-55.

⁷ The District Court construed “position” to refer to “spatial placement.” A56-57.

“the visual portion of television” or “being, relating to, or involving images on a television screen or computer display.” A52. This definition was also supported by Defendants’ expert. *Id.*

On the other hand, the District Court found references to “video” in the intrinsic evidence as containing both visual and aural information and, in some instances, exclusively aural information. A54-56. Specifically, the District Court pointed to Claims 16 and 17 and to Claims 38 and 39 to show that the term “video” can refer to exclusively audio or sound data. A54-55. Moreover, reading Claims 1 and 10 together, the District Court found the claims to be problematic if “video” is “visual only” because the “user image,” which “can be voice data” as defined in dependent Claim 10, is to be integrated “in place of” the selected characteristics in the “video presentation.” *Id.* The District Court reasoned that “audio data from the user image cannot replace audio data in a video presentation if the video presentation does not have an audio component.” *Id.* The Court further found support in Col. 35, ll. 32-36 of the ‘825 patent that video presentation can include audio information because the specification describes an “alternative embodiment” “simulating the **user’s voice** and integrating it into the **video presentation.**” A55-56. The District Court reasoned that “[i]f a voice is integrated into a video presentation, the video presentation must have an aural component.” *Id.*

In the end, the District Court could “not see how one trying to determine the scope of the claimed invention could do so with any level of certainty.” A56. The District Court concluded that this “clearly and convincingly” demonstrated that one “skilled in the art” would not “understand what behavior would be infringing” and thus that claims containing the term “video” were invalid for indefiniteness. A56.

C. Claim 54 Of The ‘864 Patent Was Held Not Infringed And Not Enabled

The District Court held that, as to the alleged infringement of Claims 54 and 56 of the ‘864 patent by ReVoice Studio, and all asserted infringement claims against Make-A-Movie, Plaintiff failed to raise a triable issue of fact. A11-12, 14-15, 85-91. On appeal, Plaintiff attacks the judgment of noninfringement by ReVoice Studio only as to Claim 54 of the ‘864 patent (Pl.’s Br. pp. 8, 61-73), which the District Court also ruled invalid for lack of enablement (A84-85).

Initially, as to Claim 54, the District Court construed the limitation “input as a model to a voice synthesizer” to require a voice synthesizer that models users’ voices, rather than a voice synthesizer that plays back digitized speech. A88-89; *see also* A24-30. A construction that would broaden the alleged inventions to encompass “simply a playback of the user’s sample” would read out the word “model” from Claim 54. A26-27.

Next, the District Court assessed whether there was evidence that ReVoice Studio possessed a voice synthesizer that *models* users' voices. A88-91. It examined the opinions of Plaintiff's expert, Dr. Vacroux, and found them lacking. "Nowhere in [Dr. Vacroux's] analysis of the intersection between Claim 54 and ReVoice Studio [did] Dr. Vacroux indicate that such modeling and synthesizing take place." A91. At most, Dr. Vacroux had offered conclusory and ambiguous opinions about "modulation," which did "not indicate that the voice parameters" in ReVoice Studio were "input *as a model*." A91.

The District Court also rejected Plaintiff's assertion that he had been denied discovery. The District Court found that "Plaintiff's decision not to depose [Mr. Jeffrey] Bloom [the third-party inventor of ReVoice Studio and owner of the source code] or otherwise request the source code from a party with access to the source code seems to be the cause of the problem. Such a litigation strategy will not now help Plaintiff avoid summary judgment." A91; *see also* A10642-644.

Accordingly, the District Court held that Defendants were entitled to summary judgment that ReVoice Studio did not infringe Claim 54. A91. The District Court also independently ruled that Claim 54 was invalid for lack of enablement. A84-85. The un rebutted expert evidence established that "the voice qualities of a person include[ing] the voice pitch, cadence, coarticulation (affect on phoneme, or speech sound element, has on surrounding phonemes), and prosody

(stress) are difficult and problematic to map onto novel speech.” A84-85; *see also* A7210-7211, 7221-7223. The District Court determined that the ‘864 patent provides no guidance on how to overcome such issues. A84-85.

SUMMARY OF ARGUMENT

The alleged inventions claimed by Plaintiff do not subsist in a form that could remotely support the infringement allegations leveled against Defendants. Plaintiff, a patent attorney, cobbled together a series of contradictory and hopelessly vague limitations in an effort to claim the widest possible field of practice touching upon visual, audiovisual, and audio presentations, including video games and motion pictures. In doing so, he overreached. He failed to enable the full scope of his ambitious claims, and failed to ensure that the terms used in the patents were understandable to one skilled in the art. A41-46, 48-56, 70-85. In addition to these defects, Plaintiff also could not produce any evidence of infringement to avoid summary judgment. A85-91. For several reasons, the District Court’s judgment is correct and should be affirmed.

First, Defendants presented clear and convincing evidence that the patent specifications lack sufficient teachings to enable one of ordinary skill in the art to make and use the full scope of the asserted claims, which the District Court construed to encompass both video game and non-video game embodiments such as motion pictures. A22 n.3; *see infra* Argument § I. Plaintiff never rebutted that

evidence, but now argues that a patentee need not enable the full scope of the claims. Pl.’s Br. pp. 48-50. Because his position contradicts settled law, this Court can and should affirm the judgment of invalidity as to Claim 56 of the ‘864 patent and all asserted claims of the ‘825 patent based on lack of enablement alone.

Second, the District Court correctly ruled that the asserted claims in the ‘825 patent are invalid for indefiniteness. *See infra* Argument § II. It considered every construction of “plurality of background images” and “video” proposed by the parties and Special Master and rejected each one under applicable principles of claim construction. A39-46, 48-56. Notably, both before the District Court and now on appeal, Plaintiff has not been able to advance a single, coherent meaning for “plurality of background images” or reconcile the ambiguity of the term “video.”

Third, the District Court properly granted summary judgment of noninfringement and nonenablement as to Claim 54 of the ‘864 patent. *See infra* Argument § III. Plaintiff failed to present any admissible evidence to support his infringement allegations regarding ReVoice Studio. A89-91. He instead relied on the conclusory and speculative opinions of his expert, which as a matter of law could not raise a triable issue of fact. A91. Further, as to Claim 54, the undisputed evidence established that the ‘864 patent did not disclose how to enable a voice synthesizer that models users’ voices. A84-85.

Finally, Plaintiff has waived any objection to California as a venue by litigating this matter in California for years without filing a motion to transfer venue and now seeks to unwind an adverse result. *See infra* Argument § IV. In any event, the District Court in Illinois did not abuse its discretion in transferring this case.

STANDARD OF REVIEW

Orders granting summary judgment are review *de novo*. *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1377 (Fed. Cir. 2007). “Whether a claim satisfies the enablement requirement of 35 U.S.C. § 112, P 1 is a question of law.” *Id.* “Similarly, indefiniteness is a question of law.” *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1380 (Fed. Cir. 2005).

When review is sought from an order granting summary judgment of noninfringement, “the claims as construed by the court are compared to the allegedly infringing device. The determination as to whether the claims, as properly construed, read on the accused device presents an issue of fact that [the Federal Circuit] review[s] for clear error.” *Lacks Indus. v. McKechnie Vehicle Components USA*, 322 F.3d 1335, 1341 (Fed. Cir. 2003).

Evidentiary rulings are reviewed under the law of the regional circuit. *Genentech, Inc. v. Amgen, Inc.*, 289 F.3d 761, 768 (Fed. Cir. 2002). The Ninth Circuit reviews rulings excluding expert evidence for abuse of discretion. *Clausen*

v. M/V New Carissa, 339 F.3d 1049, 1055 (9th Cir. 2003); *accord Genentech*, 289 F.3d at 768. Similarly, the Ninth Circuit reviews determinations “of whether an individual’s qualifications are sufficient to testify as an expert for abuse of discretion.” *United States v. Benavidez-Benavidez*, 217 F.3d 720, 723 (9th Cir. 2000). Orders striking expert testimony under Rule 37(c) of the Federal Rules of Civil Procedure also are reviewed for abuse of discretion. *Yeti by Molly, Ltd. v. Deckers Outdoor Corp.*, 259 F.3d 1101, 1105-06 (9th Cir. 2001).

Orders transferring venue pursuant to 28 U.S.C. § 1404 are reviewed under the law of the regional circuit. *Storage Tech. Corp. v. Cisco Sys., Inc.*, 329 F.3d 823, 836 (Fed. Cir. 2003). Under either Ninth Circuit or Seventh Circuit law, such transfer orders are reviewed for abuse of discretion. *Posnanski v. Gibney*, 421 F.3d 977, 978 (9th Cir. 2005); *Storage Tech.*, 329 F.3d at 836 (affirming § 1404 transfer under the Seventh Circuit’s “clear abuse of discretion” standard).

ARGUMENT

I. CLAIM 56 OF THE ‘864 PATENT AND ALL OF THE ASSERTED CLAIMS OF THE ‘825 PATENT ARE INVALID FOR FAILURE TO ENABLE THE FULL SCOPE OF THE CLAIMS, WHICH PURPORT TO ENCOMPASS MOTION PICTURES

The first paragraph of 35 U.S.C. § 112 states that “the specification *shall* contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to *enable* any person skilled in the art to which it pertains ... to make and use the same” *Id.*

(emphasis added); *see Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 921 (Fed. Cir. 2004). Here, the evidence was clear and convincing that Plaintiff did not enable the full scope of his asserted claims. Specifically, the undisputed record shows that Claim 56 of the ‘864 patent and all asserted claims in the ‘825 patent were not enabled for motion pictures. A70-85.

A. The District Court Applied The Correct Legal Standard For Enablement

As recognized by the District Court, Plaintiff failed to adduce any admissible evidence to rebut Defendants’ evidence of lack of enablement as to motion pictures. A80-81, 83-85. Unable to point to any evidence of enablement for non-video game embodiments, Plaintiff now argues that the disclosures in the specification need not enable the full scope of the claims. Pl.’s Br. pp. 49-50. According to Plaintiff, evidence of enablement as to video games alone is sufficient, which the District Court incorrectly failed to consider. *Id.* at pp. 46-48. Finally, Plaintiff argues that the presumption of validity should save his claims notwithstanding his failure to provide evidence of enablement with respect to motion pictures. *Id.* at pp. 54-57. All of these arguments are incorrect.

As to Plaintiff’s first argument, this Court reaffirmed that the enablement requirement applies to “the full scope of the claimed invention....” *Liebel-Flarsheim*, 481 F.3d at 1378; *see also LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1346 (Fed. Cir. 2005); *AK Steel Corp. v. Sollac*, 344

F.3d 1234, 1244 (Fed. Cir. 2003); *Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1195, 1198 (Fed. Cir. 1999). The rationale for this statutory requirement is straightforward. Enabling the full scope of each claim is “part of the *quid pro quo* of the patent bargain” *AK Steel*, 344 F.3d at 1244. It is necessary to avoid “sweeping, overbroad claims” *LizardTech*, 424 F.3d at 1346. Thus, “[t]he scope of the claims must be less than or equal to the scope of the enablement” to “ensure[] that the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims.” *Nat'l Recovery*, 166 F.3d at 1195-96.⁸ Application of this rule in the present case is particularly necessary given plaintiffs’ infringement claims directed against some of Defendants’ most successful motion pictures. A1624-19 at ¶¶ 47-48.

As to Plaintiff’s second argument, the District Court correctly concluded that it need not consider Plaintiff’s purported evidence of enablement with respect to

⁸ Plaintiff’s cases are inapposite, as they do not support the proposition that a patent need only enable a portion of a claimed invention. Pl.’s Br. pp. 49. *Engel Indus., Inc. v. Lockformer Co.*, 946 F.2d 1528 (Fed. Cir. 1991) did not address the requirement of enabling the full scope of a claim. *Id.* Indeed, there was no evidence in *Engel* that the “invention as claimed was not enabled” *Id.* *EMI Group N. Am., Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342 (Fed. Cir. 2001) did not require a defendant to prove that no embodiment is enabled to “succeed in invalidating a patent.” Pl.’s Br. p. 49. Rather, it addressed an entirely different and unrelated patentability requirement that a “party alleging inoperability must show that each disclosed embodiment in the patents was impossible or not enabled.” *EMI*, 268 F.3d at 1349.

video games in order to conclude that the asserted claims were invalid. A73. It is uncontested on appeal and undisputed below, as the District Court determined, that video games and motion pictures are fundamentally different and that the technology that might be used to integrate a user image into a video game is not applicable to motion pictures. A74-75. Specifically, the District Court found that the “patent purports to be applicable to any ‘audiovisual image source [that] provides an audiovisual presentation output such as video (video cassette record, cable, or broadcast television, laser disk, audiovisual, digital video tape, formatted image data [e.g., PICT]), audio tape or disk, which output to a display.’” A72 (citing to ‘825 patent at 17:3-8); *see also* ‘825 Patent at 8:32-35 (“the present invention is also applicable to non-video game embodiments, such as pre-recorded movies, animations, etc.”).⁹

Unlike video games, the Court found that “pre-existing movies do not employ discrete address and control signals, or any other means for requesting separate image segments to be assembled into the character or the overall image that appear within each frame of the presentation,” as in video games. A75; *see also* A7247-7254. Thus, the Court was correct in requiring that the specifications

⁹ Before the District Court, Plaintiff prevailed against Defendants’ argument that the patent claims should be limited to “one type of digitized audiovisual presentation: a video game” and argued that “[t]o the contrary, both patents expressly point out that the technology can be used with any digitized audiovisual presentation.” A10516 (emphasis added).

enable a non-video game embodiment, specifically motion pictures, notwithstanding the disclosure directed to video games, including by teaching one of ordinary skill in the art how to integrate a user-image into a motion picture when the images within the frame are inseparable.

Plaintiff's attempt to recast the accused product, ReVoice Studio, as a video game is immaterial. Pl.'s Br. pp. 46-47. As a matter of law, the enablement inquiry is *not* focused on the accused device, but on the teachings of the specification and the understanding of those skilled in the art at the time of the filing of the patent. *Durel Corp. v. Osram Sylvania, Inc.*, 256 F.3d 1298, 1306-1307 (Fed. Cir. 2001). Similarly, Plaintiff's attempt to support his enablement argument by referring to the accused motion pictures is also immaterial. Pl.'s Br. p. 47 (citing to "pages 16-18 supra," which discusses, *inter alia*, Plaintiff's amendment of his complaint to allege infringement of "Gladiator," "The Matrix Reloaded," and "The Lord of the Rings: The Return of the King").

Finally, the presumption of validity does not require a different result. This Court has affirmed decisions on summary judgment for lack of enablement where, as here, the undisputed evidence showed the full scope of the claims was not enabled. *Liebel-Flarsheim*, 481 F.3d at 1378; *LizardTech*, 424 F.3d at 1346; *AK Steel*, 344 F.3d at 1244; *Nat'l Recovery*, 166 F.3d at 1198; *see also Univ. of Rochester*, 358 F.3d at 930 (holding that, notwithstanding presumption of validity,

the opposing party must “set forth specific facts showing that there is a genuine issue”).

B. Claim 56 Of The ‘864 Patent And All Of The Asserted Claims Under The ‘825 Patent Lack Enabling Disclosures For Motion Pictures, Including Both Visual And Audio Substitutions In Motion Pictures

Claim 56 of the ‘864 patent and Claims 1, 20, 49, 57, 58, 62, 64, and 69 of the ‘825 patent purport to provide for “integration” or “substitution” of a visual or audio “user image” in place of a “pre-defined character image” or “character function” within a “presentation” such as a motion picture. A151, 204-208. The District Court correctly ruled that the patents do not disclose how the key component of the claimed inventions – the “Intercept Adapter Interface System” (“IAIS”) and its controller 260 – would operate on motion pictures and perform such necessary steps as “selecting” and “analyzing” the predefined character image, and “integrating” or “substitute[ing]” a user image into motion pictures. A70-81.

1. The asserted device claims based on the “IAIS” structure lack an enabling disclosure for motion pictures¹⁰

The District Court correctly ruled that the IAIS, which includes controller 260, is “the most fundamental part of both the ‘864 and ‘825 patents.” A72. But,

¹⁰ Claim 54 of the ‘864 patent, relating to a “voice synthesizer” that “model[s] a “user’s voice,” is also not enabled and is discussed in Section III.C *infra*, after a discussion of the construction of this claim.

despite their importance to the patents, the specifications do not disclose, and no admissible evidence in the record shows, how they would function for motion pictures. A73.

Plaintiff does not dispute any of the following three key points that are fatal to Claim 56 of the '864 patent and Claims 1 and 20 of the '825 patent (“the device claims”):

(1) The device claims employ means-plus-function claim language. 35 *U.S.C. § 112 ¶ 6*. Specifically, Claim 56 contains two “means-plus-function” clauses: a “means for analyzing” and “means for integrating.” A22-23 n.3. Claim 20 contains the means-plus-function clause “apparatus for integrating.” A10286. Claim 1 also contains a means-plus-function clause “means for mapping.” A7053; *see also* A7042, 7046-7047.

(2) The IAIS and its corresponding “controller” 260 are the structures corresponding to the means-plus-function clauses in the device claims. A22-23, n.3, 10286; *see also* A7053-54 (Plaintiff’s discovery responses, identifying these structures as corresponding to the “means for mapping” limitation in Claim 1 of the '825 patent).

(3) The device claims cannot operate without the IAIS *and* the “controller” 260, which is represented only as an empty box in the specifications. A124-125, '864 patent at 15:9, 16, 25, 35, 60, 19:50-51, 21:12 (variously

describing box 260 as the “analysis system,” “[a]nalysis means,” “control system,” “control circuit,” “controller,” and “controller circuit”); ‘825 patent at 17:34, 53, 18:16, 20, 42, 22:11, 27, 23:47 & Fig. 4C (variously describing this box as “main control system 260,” “control circuit 260,” “controller 260,” “controller circuitry 260,” “controller circuit 260,” “analysis system 260,” and “[a]nalysis means 260”) (hereinafter “Controller 260C”).¹¹

Thus, to enable the full scope of the device claims, the specification must disclose how to make this empty box – “Controller 260C,” which is the critical component of the IAIS structure – operate for motion pictures. The District Court scoured the patents and found no such disclosure. A72-78.

First, the District Court found that the patents do not disclose how to implement the “intercept logic functioning” of Controller 260C in the context of motion pictures. A72-74. Unlike in video games, where characters are discrete and separate images stored in memory, a character in a frame of a motion picture is meshed within and inseparable from the overall frame. *Id.* The principles of operation for the “intercept logic function” in a video games simply do not translate to motion pictures. *Id.*

¹¹ Plaintiff’s argument that the District Court erred by “suggesting that the Sitrick inventions could not operate without [the IAIS]” because “the ‘864 patent (A143, col. 20, ll. 33 et seq.) teaches that the IAIS could be implemented with a mapped set of addresses stored either in memory or in the IAIS” or in “game cartridges” is irrelevant because this implementation is for video games. Pl.’s Br. p. 52, fn. *.

Second, the techniques disclosed in the specification for analyzing and identifying the location and map of the memory address for character images stored on game cards have no application to images within a frame of a motion picture. *Id.* (citing A7251); *see also* A194 at 22:47-54 (“analysis techniques can be utilized to identify when particular predefined *player* graphic character *segments* are being accessed and transferred to the *video game apparatus*”) (emphasis added).

Third, as to sounds, the District Court also correctly found that it is difficult, if not impossible, to “select and isolate any one voice [from] the rest of the sounds” because “soundtracks in pre-existing movies are provided as combined tracks.” A82-83 (relying on the unrebutted explanations from Defendants’ experts, Dr. McGovern and Dr. Parent).¹²

On appeal, Plaintiff does nothing to address the lack of disclosure about how the “intercept logic function” of Controller 260C could be made to operate in the context of motion pictures. Instead, he argues that he need not disclose “every detail ... in the specification” Pl.’s Br. pp. 50-51. Citing *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1534 (Fed. Cir. 1987) as controlling authority,

¹² As to enablement of the audio substitution, the District Court properly struck the opinion of Plaintiff’s expert regarding the so-called “transform analysis” technique because it was belatedly disclosed after the close of discovery and after motions for summary judgment were filed. A65-66.

Plaintiff argues that a patent “need not teach, and preferably omits, what is well-known in the art.” Pl.’s Br. pp. 50-51.

But Plaintiff’s reliance on *Spectra-Physics* is misplaced. In *Spectra-Physics*, the record showed that the disclosures “permitted one skilled in the art to make and use the invention as broadly as it was claimed” *Liebel-Flarsheim*, 481 F.3d at 1379-80 (distinguishing *Spectra-Physics*). Here, there is no evidence that the missing disclosures in the ‘864 and ‘825 patents were “well-known in the art” such that “one skilled in the art” could “make and use the invention” for motion pictures. Furthermore, the missing disclosures here relate to the supposedly novel aspects of the claimed invention. “[T]he specification, not the knowledge of one skilled in the art, ... must supply the novel aspects of an invention in order to constitute adequate enablement.” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997).

Plaintiff next asserts that the District Court improperly decided enablement on a “contested factual record.” Pl.’s Br. pp. 50-53. But none of the three pieces of “evidence” Plaintiff cites raises a genuine issue of material fact as to either visual or audio substitutions for motion pictures.

First, Plaintiff refers to the testimony of his expert, Dr. Vacroux, as raising a disputed issue of fact as to enablement of visual substitutions for motion pictures. Pl.’s Br. pp. 53, n.*. However, the District Court correctly held that those opinions

could not raise a triable issue of fact because they were “conclusory,” “unsupported by any actual information,” and presented by a person who “admitted to not being skilled in the art of movie making” A76-78. Among other things, Dr. Vacroux lacked any understanding about how to modify the IAIS to work with motion pictures. A76-77. Plaintiff could *not* challenge the bases for these evidentiary rulings, cite any authority, or set forth any argument to suggest that the District Court abused its discretion. *See Genentech*, 289 F.3d at 768; Fed. R. App. P. 28(a)(5), (9). The District Court’s ruling rested on several recognized grounds for disregarding an expert’s testimony on summary judgment. A76-77; *see Dynacore Holdings Corp. v. U.S. Phillips Corp.*, 363 F.3d 1263, 1278 (Fed. Cir. 2004) (holding conclusory expert opinions cannot raise triable issues of material fact on summary judgment).

Second, also as to visual substitutions, Plaintiff relies on the Special Master’s recommendation as somehow raising a disputed issue of fact. Pl.’s Br. p. 51. The Special Master’s ruling on enablement constituted a ruling on a “question of law.” *See Liebel-Flarsheim*, 481 F.3d at 1377. The District Court properly rejected that legal ruling upon *de novo* review. Fed. R. Civ. P. 53(g)(3)-(4). Moreover, to the extent the Special Master relied on Dr. Vacroux’s testimony to find “that the signal processing techniques described in Sitrick patents were useful in performing the claimed function of the user image integration” (Pl.’s Br. p. 51),

that finding was rendered null when the District Court struck Dr. Vacroux’s opinions on that subject for both failing to disclose them prior to the close of discovery and as conclusory (A65-66, 76-78).

Lastly, Plaintiff tries to manufacture a disputed issue of fact by arguing, for the first time on appeal, that because Defendants alternatively contended that Claims 54 and 56 of the ‘864 patent are anticipated by the “Wordfit” prior art, then those claims must necessarily be enabled. Pl.’s Br. pp. 52-54. Plaintiff waived this argument by never presenting it to the District Court. *Sage Prods. v. Devon Indus.*, 126 F.3d 1420, 1426 (Fed. Cir. 1997) (an appellate court “does not ‘review’ [an argument] which was not presented to the district court”); A8218-219 (no mention of “Wordfit” prior art in Plaintiff’s opposition to Defendants’ nonenablement motion).¹³

2. The asserted method claims lack an enabling disclosure for motion pictures

The District Court also correctly held that Claims 49, 57, 58, 62, 64, and 69 of the ‘825 patent are invalid due to lack of enablement as to motion pictures. These are method claims that require “selecting” a portion of a predefined

¹³ Moreover, even if this new argument is considered, Wordfit is insufficient to enable the claims. “Wordfit” relates solely to audio substitutions. A6682-91. Therefore, the “Wordfit” prior art could not possibly supply the missing information needed to enable the full scope of the asserted patent claims, including substitutions of visual information in motion pictures (and in video games).

“presentation,” analyzing that portion, and “integrating” or substituting a “user image” for a predefined image in the “presentation” based on the selection and analysis. A206-208. Claim 69 also requires the “selecting” step to be based on undefined “program data” and then requires “integrating the user data with the selected portion responsive to the program data.” A208. In other words, these claims provide for the substitution or integration of user-provided images into video games and motion pictures. A22 n.3.

The District Court concluded, and Plaintiff does not dispute, that the ‘825 patent specification does not enable the predicate step for performing a substitution or integration into a motion picture – selecting and analyzing a “character function” within the frame of the motion picture. A72-78. As the District Court recognized, “[m]ovies do not have easily separable character functions, as video games do, and the patent does not explain how the IAIS either selects the character functions to be substituted for a user image or intercepts signals in order to effectuate the substitution.” A74; *see also* A7241, 7251-56; *Nat’l Recovery*, 166 F.3d at 1197 (affirming summary judgment of nonenablement where specification did not “describe[] how to perform [the] ideal selection step” needed to practice the invention). Likewise, the District Court cited the undisputed evidence that it is difficult, if not impossible, to “isolate any one voice [from] the rest of the sounds” in the soundtracks in pre-existing movies. A82.

Equally significant, the District Court concluded, and Plaintiff does not dispute, that the specification does not disclose how to perform the “integrating” step of these claims for motion pictures. A78-81. Plaintiff cannot assign any error to the District Court’s identification of numerous obstacles and challenges that would have to be overcome to substitute a user-image into a pre-existing motion picture. *See* A79-80 (substituting head images with different dimensions or substituting a “fat man” for a “thin man” results in distortion); 80-81 (specifications lack teaching on how to integrate a user image into a movie when the character is moving, turning, or going through different light). Because these challenges would require one skilled in the art to undertake “undue experimentation,” the District Court correctly concluded that “even if the pre-existing image could be separated from the rest of the frame and the IAIS could intercept a signal for that image and redirect that signal so that the user image was incorporated,” the patents do not teach and enable integration, let alone an integration that is “smooth,” “realistic,” “monolithic,” and “homogeneous.” A78, 134 at 1:8, 184 at 2:25-26, 2:66-65.¹⁴

¹⁴The patents also do not teach how to account for differences in size and shape between predefined character images and user images in the context of video games. Thus, the “integration” step is also not enabled for video games for the same reasons as in motion pictures. *See, e.g.*, A7247 (explaining the problem of “severe distortion” that will occur with substitutions of images of different sizes, which is not addressed in the patents). The District Court, however, did not reach this issue when it concluded that the asserted patent claims were not enabled.

II. CLAIM 56 OF THE '864 PATENT AND THE ASSERTED CLAIMS OF THE '825 PATENT ARE INVALID FOR INDEFINITENESS

Because Claim 56 and all of the asserted claims of the '825 patent are invalid for lack of enablement, this Court can affirm the judgment as to those claims without reaching any other issues. However, the District Court's ruling that those claims are also invalid for indefiniteness provides an additional and independent ground for affirmance. Specifically, the District Court held that the claim limitations of "plurality of background images" and "video" are "insolubly ambiguous" and "not amenable to construction" *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1353, 1358 (Fed. Cir. 2003). Moreover, the District Court reached this conclusion only after carefully examining the language of those claim limitations and concluding that such language is not capable of a single, meaningful construction.

A. A Claim Is Indefinite When It Contains Terms That Are Subject To Multiple Constructions

Paragraph 2 of 35 U.S.C. § 112 requires that the "specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The "purpose of the definiteness requirement is to ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee's right to exclude." *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed.

Cir. 2005). Each claim must be “sufficiently precise to provide competitors with an accurate determination of the metes and bounds of protection involved” *IPXL Holdings*, 430 F.3d at 1384 (internal quotations omitted).

A claim that is “insolubly ambiguous” and “not amenable to construction” is invalid. *Novo Indus.*, 350 F.3d at 1353, 1358 (internal quotations omitted); *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 451-53 (Fed. Cir. 1985) (affirming indefiniteness because claim term was “too vague”). For example, a claim is indefinite if it is susceptible to two or more constructions and the “intrinsic record does not compel a narrowing of the claim language to any one of the possible definitions.” *Honeywell Int’l, Inc. v. Int’l Trade Comm’n*, 341 F.3d 1332, 1338-41 (Fed. Cir. 2003); *Union Pacific Resources, Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 692 (Fed. Cir. 2001) (affirming indefiniteness ruling because claim term was capable of at least two constructions).

“[G]eneral principles of claim construction apply” to questions of indefiniteness. *Datamize*, 417 F.3d at 1348. In addition, an indefinite claim cannot be rewritten to preserve its validity. *Allen Eng’g Corp. v. Bartell Industries, Inc.*, 299 F.3d 1336, 1349 (Fed. Cir. 2002) (refusing to rewrite the claims to make “perpendicular” means “parallel”).

B. The Phrase “Plurality Of Background Images” Cannot Be Given A Single, Meaningful Construction

With the exception of Claim 58, all of the asserted ‘825 patent claims contain the limitation “plurality of background images.” The District Court concluded that this limitation lacks an ascertainable meaning. A41-46. Because this claim limitation cannot be given a definite construction without doing violence to the specification or claim language in the patent, affirmance of the District Court’s ruling that Claims 1, 20, 49, 57, 62, 64, and 69 of the ‘825 patent are invalid for indefiniteness is correct.

During this litigation, Plaintiff has advanced several possible meanings for the term “background image,” including:

- (1) a “screen shot” or frame (A10518; Pl.’s Br. p. 57 n.*);
- (2) an “imagery segment” such as a head or torso (A8101-8102);
- (3) visual and/or audio information “and the computer program data for displaying the presentation” (A8102); and
- (4) “computer program code” (A8102).

The ‘825 patent contains definitions and disclosures that further increase the number of possible constructions of “background image.” The patent alternatively defines “background image” as:

- (5) “e.g., a video presentation, an audiovisual presentation, and an audio presentation” (A198 at 30:3-5; A174 at Fig. 5F);

(6) “at least one of a video presentation, an audiovisual presentation, and an audio presentation” (A206 at 46:43-45 (Claim 39)); and

(7) “including the recognizable video presentation therewithin” A204 at 42:62-63; *see also, e.g.*, A206 at 46:12-13 (referring to “a recognizable video presentation for a respective character function *within* a plurality of background images”) (emphasis added); A206 at 46:332-34 (“having a recognizable video presentation *within at least some* of the background images”) (emphasis added).

Despite these numerous potential constructions, Plaintiff asserts that there is nothing “the least bit indefinite about ‘background images.’” Pl.’s Br. p. 58. But, even now, he is unable to propose a workable and consistent construction of the entire phrase “plurality of background images.” His brief first quotes from the specification and appears to adopt the following construction for “background image”: “a video presentation,” an “audiovisual presentation,” or “an audio presentation.” Pl.’s Br. p. 57. Plaintiff then endorses construing the term “background image” differently as a “screen shot” and a “plurality of background images” as “multiple images [or screen shots] played in sequence.” Pl.’s Br. p. 57 n.*.

Plaintiff’s first possible construction, taken from the express definition in the specification (A198 at 30:3-5, “e.g., a video presentation, an audiovisual presentation, and an audio presentation”), does not work when placed in the

context of the oft-repeated phrase “plurality of background images.” The patent states at the outset, “video and audiovisual presentations” refer to such things as “movies and video games” A184 at 1:9-10. Therefore, adopting Plaintiff’s first construction results in a “plurality of background images” meaning “more than one movie or other type of [audiovisual] presentation” However, the patent does not teach how to integrate a “user image” into two or more motion pictures or video games. A44. Additionally, when this interpretation is adopted, the language of the claims becomes non-sensical. *See, e.g.*, Claim 16 (“video presentation representative of a plurality of background images”); Claim 26 (“video presentation signals comprise[] video signals ... representative of a plurality of background images”); Claim 57 (“audiovisual presentation representative of a plurality of background images”).

Plaintiff’s second possible construction for “background image” as “screen shot” and “plurality of background images” as “screen shots,” “frames,” and “multiple images [or screen shots] played in sequence” respectively also does not withstand scrutiny. “Background images” can be audio information. A198 at 30:3-5. Indeed, as Plaintiff notes, “[a] background noise can clearly be, within the meaning of [his] patents, a ‘background image.’” Pl.’s Br. p. 58. However, a “screen shot” or “frame” refers to purely visual information, and both terms are meaningless in the context of audio information. A44-46. Moreover, construing a

single “background image” as a single “screen shot” also contradicts the explicit definition in the specification of “background image” as “a video presentation, an audiovisual presentation, and an audio presentation.” A198 at 30:3-5; A184 at 1:9-10; 206 at 46:43-45.

C. The Word “Video” Is Not Subject To A Single Construction

The most straightforward construction of “video” is that it refers to purely visual information. This follows from the contrasting use of “video” in the ‘825 patent with terms that refer to both audio and visual information (*i.e.*, “audiovisual”) or to exclusively aural information (*i.e.*, “audio”). *See Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1579 (Fed. Cir. 1996) (construing terms used in close proximity as having different meanings). For instance:

- At its outset, the ‘825 patent contrasts “video and audiovisual presentations....” A184 at 1:9-10.
- In the Summary of Invention, the ‘825 patent contrasts “video signals” and “audio signals” provided by “an audiovisual source” A184 at 2:39-40.
- In the Figures and Detailed Description, the ‘825 patent contrasts the terms “video presentation, audiovisual presentation, [and] an audio presentation” A174 at Fig. 5F; A198 at 30:3-5.

Thus, the ‘825 patent was drafted with the clear intent that a “video” presentation means something distinct from an “audiovisual” presentation and an

“audio” presentation. More specifically, the term “video” can only mean exclusively visual information.

Further, during prosecution, the examiner equated “video image” with “silent films.” A7516. This interpretation of “video” as referring to visual only is consistent with the understanding of persons skilled in the art as reflected in dictionary definitions and by ordinary usage. *See* A51-53; *see also* A7408, 7422 (dictionary defining “video” as “relating to or used in the transmission or reception of the television image compare AUDIO”; defining “audio” as “the transmission, reception, or reproduction of sound”); A7258-59 (explaining that, “[a]s ordinarily understood in the art ... a ‘video output’ is that which relates to transmission of signals representing the visual data, and ‘audio output’ is that which relates to the transmission of sound data”).

The District Court, however, correctly determined that there is an “internally inconsistent use of ‘video’ throughout the patent,” and therefore, the term is indefinite. A49, 56. For instance, in addition to finding support in the patent for interpreting “video” to refer to exclusively visual information, the District Court also found support in the patent that the term “video” could mean *exclusively audio*. A54-55.

A review of the claims provides weighty evidence that no uniform interpretation of “video” is possible and, therefore, claims containing that term are

insolubly ambiguous. For example, in Claim 38, “video” can mean purely visual, purely aural, or including both visual and aural information.¹⁵ Likewise, in Claim 16, “video” can mean purely aural information as well.¹⁶ In Claim 1, however, the same term “video” cannot mean purely visual or purely aural if the system is to be operative.¹⁷ And in Claims 30, 39, and 41, “video” can only mean purely visual.¹⁸ Similarly, in Claim 20, “video” can only mean visual because the “recognizable

¹⁵ Claim 38 recites a “background *video* representative of a plurality of background images,” and “background image” is defined in dependent Claim 39 as “at least one of a video presentation, audiovisual presentation, and audio presentation.” A206. Because Claim 39’s “audio presentation” refers exclusively to aural information, “background video” in Claim 38 can be represented by exclusively aural information.

¹⁶ Claims 16 recites “external image signals defining an external *video* image,” and “external image signal” is defined in dependent Claim 17 as possibly consisting of exclusively “digital audio data.” A205. Thus, the “external video image” could be “defined” by exclusively “audio data.”

¹⁷ In Claim 1, the “user image” is “integrated into the respective background images *in place of* the respective recognizable *video* presentation” A204. Dependent Claim 10 states that a “user image” can be exclusively “voice data” or can be exclusively visual data such as “facial expression features.” *Id.* If “video” means exclusively visual information, then Claim 1 would require the substitutions of visual information with audio information when “user image” is “voice data.” Vice versa, if “video” means exclusively aural information, then Claim 1 would require substitutions of audio with visual information when “user image” is “facial expression features.” Such substitutions would lead to inoperability. *See* A54, 7258-59. Thus, in Claim 1, “video” includes both sound and visual information.

¹⁸ These claims contrast the terms: “video” with “audiovisual” and “audio.” Construing “video” here as including both visual and aural information, or as being purely aural, will render the terms “audiovisual” and “audio” meaningless.

video presentation” are associated with “position” and “timing,” and “position” refers to spatial characteristics. A56-57.

Accordingly, given the multiple and conflicting meanings of “video,” the “semantic indefiniteness” of the ‘825 patent “is obvious.” *Allen Eng’g*, 299 F.3d at 1349; *Union Pacific*, 236 F.3d at 692. Absent rewriting the specification and claims, which is not permitted, there is no way to assign “video” a meaning consistent with the claim language and specification. *Id.* Consequently, as correctly determined by the District Court, all of the asserted claims that contain “video” are invalid for indefiniteness.

III. THE DISTRICT COURT CORRECTLY CONCLUDED THAT DEFENDANTS DID NOT INFRINGE CLAIM 54 OF THE ‘864 PATENT

“Summary judgment of noninfringement is [] appropriate where the patent owner’s proof is deficient in meeting an essential part of the legal standard for infringement, because such failure will render all other facts immaterial.” *TechSearch L.L.C. v. Intel Corp.*, 286 F.3d 1360, 1369 (Fed. Cir. 2002). “To establish infringement of a patent, every limitation set forth in a claim must be found in an accused product or process exactly or by a substantial equivalent.” *Becton Dickinson & Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 796 (Fed. Cir. 1990). Accordingly, if one limitation is missing in the accused product, then the accused product cannot infringe. *Id.*

A. The District Court Correctly Construed Claim 54 To Require A Voice Synthesizer That Models Voices

To the extent the '864 patent discloses incorporation of “aural images” into pre-existing displays, the District Court correctly found that the '864 patent describes two different embodiments to accomplish this step, either (1) “by a direct playback of the words spoken by the user,” or (2) “by a device extracting voice parameters from a sample of the user’s voice so that the user’s voice can be modeled to say anything.” A19. The District Court correctly determined that Claim 54 is directed to the second embodiment. A25-27.

The method of Claim 54 comprises the steps of “sampling the user’s voice,” “analyzing the sampled user’s voice” to extract “user voice parameter data representative of the user’s voice” and “inputting” “the user voice parameter data ... as a *model* to a voice synthesizer,” effecting an “integrati[on] of the user’s voice into the presentation output” A151 (emphasis added). The District Court construed this claim language as requiring a voice synthesizer that models voices based on extracted voice parameter data, rather than a voice synthesizer that simply plays back digitized speech. A28-29 (citing *Oak Tech., Inc. v. Int’l Trade Comm’n*, 248 F.3d 1316, 1330 (Fed. Cir. 2001) (construing claims to be limited to a particular type of a “cyclic redundancy checker” device because of explicit limitations imposed by the claim language)). In view of the express claim

language requiring “input as a model to a voice synthesizer,” the correctness of the District Court’s construction is evident.

On appeal, Plaintiff contends that the District Court erred in its construction. Citing column 26 of the patent, Plaintiff argues that Claim 54 is directed to the first embodiment above (direct playback of digitized speech). Pl.’s Br. p. 65. But Plaintiff’s construction is inconsistent with the very portion of the specification he cites. Column 26:28-38 contrasts “digitized” speech and word phrases for playback with “model parameters extracted” for “utilization by a sound synthesizer to operate in accordance to the *model* parameters.” A146 (emphasis added).

Plaintiff also accuses the District Court of reading Claim 54 as requiring that “the user voice parameter data is used to generate new words that the user did not actually say” Pl.’s Br. p. 65. The District Court did no such thing, explaining:

[W]hat the user actually said is immaterial – it is the extraction of the voice parameters from that utterance and the translation of those parameters into a voice that can say anything and can sound like the user’s voice (based on the analysis of the voice parameters).

The only thing that the Court clarifies regarding Defendants’ proposed definition is that the synthetic voice could say precisely what the user had said in the sample, and this would be within the claim, *as long as* the voice was not simply a playback of the user’s sample, but was generated from the sample and the extracted voice parameters.

A27. Thus, the District Court’s construction did not improperly limit the claim, and its construction should be affirmed.

B. ReVoice Studio Does Not Contain A Voice Synthesizer That Models Voices

Plaintiff adduced no evidence that the accused ReVoice Studio inputs “user voice parameter data” as a “model to a voice synthesizer” as required by Claim 54 of the ‘864 patent. The District Court correctly found that Plaintiff’s expert had never stated that the “user voice parameter data” in ReVoice Studio is “input as a model.” A90-91. In addition, Defendants’ experts testified that ReVoice Studio lacked modeling. A7356-60 (stating that “Dr. Vacroux cannot point to any modeling based on the user voice parameter data occurring with the ReVoice Studio, and I cannot find any”); A7377-78 (stating that “Dr. Vacroux completely ignores the limitation, ‘the user voice parameter data is input as a model to a voice synthesizer,’ evidently because that limitation cannot be reconciled with the operation of the ReVoice Studio.”)

Instead, Plaintiff solely relied on his expert’s unfounded and conclusory assertions of infringement. However, such opinions on the “ultimate issue” of infringement cannot raise a triable issue of fact. *Dynacore*, 363 F.3d at 1278.¹⁹

¹⁹ In addition, the infringement analysis of Plaintiff’s expert is also incorrect. Dr. Vacroux speculated that “the user voice parameter data functions as input to voice synthesizing software whereby the timing and modulation characteristics of the user’s voice are matched to those of the predefined image.” A90. Claim 54, however, requires modeling the synthesized voice based on the “user voice parameter data” associated with the *user’s sampled voice*, not the “user voice parameter data” associated with the *predefined character*.

Faced with a lack of evidence of infringement, Plaintiff nonetheless advances a number of immaterial arguments. He suggests, for instance, that an issue of fact exists about whether ReVoice Studio operates differently than “Wordfit,” a prior art reference. Pl.’s Br. pp. 62-64; *but see* A9941-46 (explaining how Plaintiff took testimony out of context to manufacture alleged differences between ReVoice Studio and Wordfit). Any purported differences between ReVoice Studio and Wordfit are irrelevant to a determination of infringement, which turns on whether an accused device reads on an asserted patent claim, not whether the accused device reads on the prior art. *Becton Dickinson*, 922 F.2d at 796. Plaintiff also quotes at length from deposition transcripts. Pl.’s Br. pp. 66-72. Notably, none of these quotes deals with the requirement in Claim 54 that “user voice parameter data” be “input as a model to a voice synthesizer.” *See id.*

In addition, Plaintiff blames Defendants for his own failure to secure the testimony of third-party witness Mr. Bloom, the person most knowledgeable about ReVoice Studio, who owned the source code. Pl.’s Br. pp. 71-72. Plaintiff fails to explain how the District Court’s refusal to excuse Plaintiff from the consequences of his own “litigation strategy” amounts to an abuse of discretion. *Genentech*, 289 F.3d at 768. Moreover, Plaintiff never moved under Rule 56(f) to conduct additional discovery to oppose summary judgment, even though Defendants identified Mr. Bloom as the key witness regarding the operation of ReVoice Studio

at the outset of the litigation. A730-31 (Plaintiff stating that the “relevant work” for ReVoice Studio was performed by Synchro Arts in England, headed by Mr. Bloom).

Plaintiff complains that he “demanded production of the software in the very first set of document requests he propounded.” Pl.’s Br. p. 71. However, he ignores the futility of this request as to the source code given that Defendants never had possession, custody or control of the source code, which was owned by Mr. Bloom’s Synchro Arts.²⁰ Plaintiff conceded this fact by not seeking production of the source code when he filed a motion to compel discovery responses immediately prior to Defendants’ motions for summary judgment. A3083-84, 3113-8 to 1331-85. By this time, Plaintiff had repeatedly been advised by Defendants that they did not possess the source code, but would help arrange for the taking of Mr. Bloom’s deposition “even though he resided outside of the range of the subpoena power of the court. For tactical reasons sufficient to himself, plaintiff declined to do so.” A10293.

²⁰ Source code is the human readable code of instructions written by programmers before the computer program is compiled into an object code. Object code cannot be read by a human and is the software code physically placed on the DVDs. The Defendants did not require possession of the source code to use the ReVoice Studio object code on their DVDs.

C. The District Court Correctly Held That Claim 54 Of The ‘864 Patent Is Not Enabled

In addition to noninfringement, the District Court determined, based on clear, convincing, and un rebutted evidence that Claim 54 was not enabled to model voices. A84-85. One of Defendants’ experts, Dr. Parent, explained that “the voice qualities of a person includ[ing] the voice pitch, cadence, coarticulation (affect one phoneme, or speech sound element, has on surrounding phonemes), and prosody (stress) are difficult and problematic to map onto novel speech” A84; *see also* A7222. The ‘864 patent, however, provides no disclosures that address those challenges. The lack of disclosures is not surprising because “[e]xtracting parameters that describe the coarticulation and prosody of a specific individual in order to be used in the synthesis of novel audio-visual speech was not in the state of the art at the time of filings of these patents” A7223. Accordingly, the ‘864 patent fails to enable a voice synthesizer that can model speech.

On appeal, Plaintiff does not dispute Dr. Parent’s expert opinion or the Court’s finding that “implementing the specific objectives quoted” in the patent “is a difficult task, even with current technology.” A84. Rather, Plaintiff tries to recast prior art arguments made by Defendants below (based on the “Wordfit” prior art system) as inconsistent with the District Court’s ruling of nonenablement. Pl.’s Br. pp. 52-53. Plaintiff’s arguments lack merit for two reasons.

First, the District Court made no finding that “Wordfit” anticipates Claim 54. Second, Defendants’ anticipation arguments based on “Wordfit” were consistent with its enablement arguments. The two arguments rested upon alternative constructions of Claim 54. Defendants’ anticipation argument, on the one hand, assumed the adoption of Plaintiff’s proposed construction of Claim 54, which the District Court subsequently rejected, as a voice synthesizer that plays back digitized speech. A7262-78. Defendants’ nonenablement argument, on the other hand, assumed that the District Court would adopt Defendants’ proposed construction of Claim 54. When the District Court adopted Defendants’ proposed construction, Defendants’ anticipation argument became immaterial.

IV. THIS LITIGATION WAS PROPERLY TRANSFERRED

A. Plaintiff Waived Any Objection To The Order Transferring Venue And Consented To Litigation In California

Plaintiff’s objection to the transfer of this action from Illinois to California was waived. Well-settled law establishes that “[o]bjections to venue are waivable.” *Transcapital Leasing Assocs., 1990-II, L.P. v. United States*, 398 F.3d 1317, 1322 (Fed. Cir. 2005); *see also* Fed. R. Civ. P. 12(h)(1). Moreover, the law of the regional circuit controls as “to the procedural question of waiver.” *Riverwood Int’l Corp. v. R. A. Jones & Co.*, 324 F.3d 1346, 1352 (Fed. Cir. 2003). Under either Ninth Circuit or Seventh Circuit law, once a motion to transfer has been granted, the losing party must make a motion to retransfer the case in the

transferee district court to preserve the issue for appeal. *See Posnanski*, 421 F.3d at 980-81; *Illinois Tool Works, Inc. v. Sweetheart Plastics, Inc.*, 436 F.2d 1180, 1187-88 (7th Cir. 1971); *accord* 17 James Wm. Moore *et al.*, Moore’s Federal Practice § 1164[2][b] (3d ed. 1999).²¹

Here, Plaintiff waived any objection to California as the venue for this action by litigating in California for more than three years without moving to retransfer to Illinois or to some other forum. After this action was transferred at the outset of the litigation, the first and only time that Plaintiff renewed his request that California was an inappropriate forum arose in its present appeal well after the California District Court ruled against him on summary judgment. Indeed, Plaintiff expressly consented to litigating in California by filing multiple amended complaints there, which acknowledge that “[v]enue properly lies in [the Central District of California]” (A1624-1 to 1624-17 at ¶ 40; A2823-2838 at ¶ 40), and by not objecting to the setting of dates for trial in California.

B. The Illinois District Court Did Not Abuse Its Discretion In Transferring The Case To California

Even if Plaintiff could challenge the transfer order at this point, the Illinois District Court did not abuse its discretion in transferring this case to California at

²¹ The Federal Circuit has not yet applied this rule, except in an unpublished, nonprecedential decision. *See Hoffmann v. United States*, 17 Fed. Appx. 980, 985-986 (Fed. Cir. 2001) (unpublished) (following the D.C. Circuit’s rule on waiver and refusing to review a transfer order).

the time the motion was decided. *Storage Tech.*, 329 F.3d at 836. For example, the record demonstrates that when the transfer motion was decided every fact witness identified by Plaintiff (other than himself) resided in Los Angeles. A692, 904.

On appeal, Plaintiff speciously claims the only “principal witnesses” are himself and Mr. Bloom, “the inventor of the ‘ReVoice Studio’ feature, who resides in the United Kingdom. Pl. Br. pp. 73-74. Plaintiff mischaracterizes the record when he suggests that other witnesses identified by Defendants “have had precious little to do with this lawsuit” and that after the transfer “no one heard anything further about most of those critical witnesses.” *Id.* at pp. 1, 73-74.

First, any reliance on those portions of the lower court record, established years after the case was transferred, is misplaced; especially when Plaintiff materially changed his claims after the transfer occurred. For example, at the time of the transfer, Plaintiff’s allegations included claims of infringement relating to the Make-A-Movie DVD add-on feature. A900. Make-A-Movie was designed and developed entirely in California by a third-party vendor, Media Revolution. A904. Plaintiff’s decision to abandon his claim against Make-A-Movie, in the face of a complete failure of proof of infringement, years after the motion to transfer was granted, however, does not *retroactively* render the Illinois Court’s decision an abuse of discretion when it considered the location of these witnesses.

Second, because this action was decided on summary judgment, the full list of material (e.g., trial) witnesses from Los Angeles, especially those employed by the Defendants and third parties supportive of the Defendants or within the subpoena power of the California District Court, was never a matter of record. While Defendants had identified numerous knowledgeable individuals and entities in compliance with Fed. R. Civ. P. 26(a)(1), most of whom resided outside of Illinois (A706-718, 760-780), Plaintiff chose for strategic reasons to depose only a few of these individuals. Plaintiff's decision not to depose the numerous other individuals and entities with knowledge about the "selection, design, development, and implementation of the accused features" or the other issues in the litigation (e.g., validity and damages), does not establish any error by the Illinois District Court when it relied on the Defendants' identification of these individuals in support of its motion to transfer. A904-905.

In addition, Plaintiff faults the Illinois Court for "los[ing] sight of the need for Sitrick to travel to California, his counsel to travel to California, and the need to employ local counsel in California." Pl.'s Br. p. 75. The Illinois District Court specifically addressed this issue and found based on the undisputed record that the burden of travel for Plaintiff and his counsel was minimal. A905. Furthermore, Plaintiff cannot point to any evidence that he was unable to prosecute his case vigorously because of the transfer.

Finally, Plaintiff accuses the Illinois District Court of “add[ing] an additional requirement” that patentees must make or sell their patented product if they “wish to enforce [their] patents in [their] home jurisdiction.” Pl. Br. pp. 75-76. The Illinois District Court did no such thing. The Court simply analyzed whether Plaintiff had ever reduced his claimed inventions to practice as one factor among many that favored transfer. A906-907.

CONCLUSION

For the foregoing reasons, Appellees respectfully request that the Court sustain the rulings by the District Court in all respects.

Dated: August 10, 2007

Respectfully submitted,

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PROOF OF SERVICE

On August 10, 2007, an original and eleven (11) copies were served pursuant to Rule 25(a)(2)(B) of the Federal Rules of Appellate Procedure by Federal Express on the Clerk for the United States Court of Appeals, Federal Circuit, 717 Madison Place, N.W., Washington, DC 20439 for delivery within three (3) calendar days. I also served counsel for plaintiff each with two (2) bound copies by Federal Express and another copy by electronic mail as follows:

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CERTIFICATE OF COMPLIANCE

I hereby certify that the foregoing brief complies with the type-volume limitation set forth in Rule 32(a)(7)(B) of the Federal Rules of Appellate Procedure. Based on the word-count function in Microsoft Word, the brief contains 13,695 words.

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