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Microsoft moves for partial summary judgment of invalidity under 35 U.S.C. §§ 101 and 112 of claims 1-27, 37-38, 40-48, 52-70, and 75-76 of U.S. Patent No. 5,799,273 (the "273 patent"), the sole asserted patent in this case. Because these claims are invalid as a matter of law, Microsoft's motion should be granted.

I. INTRODUCTION AND SUMMARY OF ARGUMENT

The claims identified above violate fundamental principles governing the manner in which patentees must claim software-related inventions. These principles are at the root of ample precedent of this Court, the Federal Circuit, and the Supreme Court. Allvoice, by running afoul of these critical requirements, has attempted to obtain claim scope never authorized or intended by the Patent Act.

First, Allvoice has improperly attempted to claim software instructions in the abstract, not tied to any of the four categories of patentable subject matter set forth by 35 U.S.C. § 101 (limiting patentable inventions to a "process," a "machine," a "manufacture" or "composition of matter."). The Supreme Court, the Federal Circuit, and the Board of Patent Appeals and Interferences all have unequivocally held that claims to algorithms alone do not fall into one of these enumerated categories and, thus, are invalid. The 273 patent issued with 78 claims, all related generally to speech recognition technology. Many of these claims recite an "apparatus" (i.e., a computer), a "method," or a "computer usable medium," and are not at issue in this motion. Claims 60-68, however, undisputedly claim a pure software "interface" between one type of software application and another, and are not tied to any hardware, medium, or process. Indeed, Allvoice has emphatically insisted in its claim construction briefing that these claims require software "instructions" alone. Because there is no dispute that claims 60-68 fail to recite a process, machine, manufacture, or composition of matter, they are invalid as a matter of law under § 101.

Second, Allvoice has improperly attempted to obtain the benefits of functional claiming under 35 U.S.C. § 112(6), without paying the *quid pro quo* required by the statute and disclosing corresponding structure in the specification. A number of Allvoice's claims contain § 112(6) functional limitations that Allvoice contends are directed to pure software instructions. This Court and the Federal Circuit have repeatedly held that limitations such as these must be supported by a disclosure of a corresponding algorithm in the specification. Yet the only disclosure of corresponding structure that Allvoice can identify for these limitations amounts to little more than a repetition of the functional language in the claim. As this Court made abundantly clear in the *i4i v. Microsoft* case, mere repetition of functional language alone cannot satisfy the requirements of § 112(6). For the same reasons, claims 1-27, 52-55, 65, 69-70, and 75-76 of the 273 patent should be held invalid for indefiniteness under §§ 112(2) and 112(6).

Finally, Allvoice has improperly drafted several method claims in a manner that makes them insolubly ambiguous and so fatally indefinite. The claims at issue require certain steps or acts to be performed by the user of a speech recognition computer system. Several of these claims, however, contain limitations that appear to claim an optional use of the system rather an actual method step. A number of the claims, for example, contain the limitation "allowing a user to select whether to read and playback said audio message..." without ever saying whether the act of "playback" is required to perform the method. Such an ambiguity renders the determination of infringement impossible and, therefore, under Federal Circuit precedent, such claims are indefinite. Because claims 37-38, 40-48, and 56-59 of the 273 patent are insolubly ambiguous, they should be held invalid.

Each of the issues raised by this motion is, like the issue of claim construction, an issue of law for this Court to decide and so amenable to summary judgment.¹

II. BACKGROUND

The 273 patent generally relates to speech recognition technology. The patent refers to a number of prior art speech recognition systems on the market at the time of filing. These products enabled computer users to interact with their computer by speaking into a microphone instead of typing on a keyboard. The prior art products contained software called a “speech recognition engine” that uses sophisticated algorithms to decode the user’s voice signals and, based on various statistical calculations, make a determination of the words that were most likely spoken by the user. Once the speech recognition engine converted the user’s voice signals into recognized words, the recognized words could be displayed to the user in a dictation window on the computer monitor. 273 patent at 1:30-43.

The 273 patent also mentions a number of text processing applications that were commercially available at the time of the 273 filing, including Microsoft Word, Microsoft Excel, WordPerfect, and Lotus Word Pro. *Id.* at 2:46-52, 6:36-39. In order to transfer the recognized words from the speech recognition engine’s dictation window into a text processing application,

¹ See, e.g., *Prometheus Labs., Inc. v. Mayo Collaborative Servs.*, 581 F.3d 1336, 1341 (Fed. Cir. 2009) (whether a patent claim is directed to statutory subject matter is a question of law); *Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A.*, 412 F.3d 1291, 1298 (Fed. Cir. 2005) (“A determination of claim indefiniteness is a legal conclusion that is drawn from the court’s performance of its duty as the construer of patent claims. Indefiniteness, therefore, like claim construction, is a question of law that we review *de novo*. ...[I]f one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.”) (internal citations omitted); *Young v. Lumenis, Inc.*, 492 F.3d 1336, 1344 (Fed. Cir. 2007) (“A determination that a patent claim is invalid for failing to meet the definiteness requirement in 35 U.S.C. § 112, ¶ 2 is a legal question reviewed *de novo*”).

the user would cut and paste the text from the dictation window. *Id.* at 1:35-45. The disclosure and the claims of the 273 patent all relate to an "interface application" that, according to the patent, provides perceived improvements in the communication between prior art speech recognition engines and text processing applications.²

The 273 patent has a total of 78 claims, all of which are directed to hardware and/or software that speech recognition engines use to communicate with text processing applications. Most of the claims fall into the following four categories:

- Claims 1-14, 52-53, 69-70, 75-76 are all claims to a "data processing apparatus" (i.e., a computer).
- Claims 15-27, and 54-55 are all claims to a "data processing arrangement," which includes two or more computers working together (i.e., a "a data processing apparatus" and an "editor workstation").
- Claims 28-50, 56-59, 71-72, 77-78 are all claims to various "data processing method[s]."
- Claims 51 and 73-74 are claims to a "computer usable medium having computer readable instructions stored therein."

Claims 60-68, however, differ from all the other claims in the patent in that they attempt to cover pure software – that is, a software interface between a speech recognition engine and a text processing application, both of which are also software. These claims are not limited to a computer, a method, or a computer readable medium like the other claims, and accordingly would purport to cover a software algorithm in the abstract.

² The perceived problems and purported solution of the 273 patent are described more fully in Microsoft's co-pending claim construction brief.

III. STATEMENT OF THE ISSUES TO BE DECIDED

1. Are claims 60-68 invalid under 35 U.S.C. §§ 101 and/or 112(2) because they improperly attempt to claim pure software instructions not tied to any process, machine, manufacture, or composition of matter?
2. Are claims 1-27, 52-55, 65, 69-70, and 75-76 invalid under 35 U.S.C. §§ 112(2) and/or 112(6) because they recite means-plus-function limitations that have no corresponding structure in the specification?
3. Are claims 37-38, 40-48, and 56-59 invalid under 35 U.S.C. § 112(2) because they contain language that renders them insolubly ambiguous?

IV. STATEMENT OF UNDISPUTED MATERIAL FACTS

A. Claims 60-68 purport to cover pure software instructions

1. The preamble of claim 60, on which claims 61-63 depend, recites a "universal speech-recognition interface that enables operative coupling of a speech-recognition engine to at least any one of a plurality of different computer-related applications, the universal speech-recognition interface comprising:"
2. The preamble of Claim 64, on which claims 65-68 depend, recites a "A speech-recognition interface that enables operative coupling of a speech-recognition engine to a computer-related application, the interface comprising:"
3. The "speech-recognition engine" and "computer-related applications" of claims 60-68 are software applications.
4. The "speech-recognition interface" of claims 60-68 is an "interface application" that is "limited to software." Allvoice Opening Claim Construction Brief ("Allvoice Br.") at 10.
5. Claims 60-68 recite a series of means-plus function limitations.

6. Allvoice has taken the position that the corresponding structures for all of these means-plus function limitations are various "software instructions." *Id.*³
7. Allvoice has taken the position that "hardware limitations... should not be included" in Claims 60-68. *Id.*
8. None of claims 60-68 recite a "process" under 35 U.S.C. § 101.
9. None of claims 60-68 recite a "machine" under 35 U.S.C. § 101.
10. None of claims 60-68 recite a "manufacture" under 35 U.S.C. § 101.
11. None of claims 60-68 recite a "composition of matter" under 35 U.S.C. § 101.

B. Claims 1-27, 52-55, 65, 69-70, and 75-76 contain means-plus-function limitations that lack corresponding structure in the specification

Means for monitoring

12. Claim 1-27 and 65, either directly or through dependency, recite a "means [. . .] for monitoring changes in the positions of recognised words"
13. Claim 75, on which claim 76 depends, contains the limitation "processing means . . . which . . . monitors changes in the positions of the recognised words . . ."
14. The parties agree that the limitations "means for monitoring changes in the positions of recognized words . . ." and "processing means . . . which . . . monitors changes in the positions of the recognised words . . ." are governed by 35 U.S.C. § 112(6).
15. There is no algorithm disclosed in the specification corresponding to the "means for monitoring changes in the positions of recognised words . . ."
16. There is no algorithm disclosed in the specification corresponding to the "processing means . . . which . . . monitors changes in the positions of the recognised words . . ."

³ See also Allvoice's Constructions in the Joint Claim Construction Statement (Dkt. No. 100), Exh A at 1-3, 5-7, 9, 16.

17. The only mention of "monitoring" in the specification is contained in a single sentence that reads: "Thus, in accordance with this aspect of the present invention, positional changes of characters in the character string due to processing operations are monitored and the links which identify the corresponding audio component are updated accordingly." 273 patent at 2:22-26.

Means for selectively disabling

18. Claims 10-11, 19-20, 52-53, and 54-55, either directly or through dependency, recite "means for selectively disabling one of the receipt of the recognised [words/characters] . . . and the recognition of speech . . ."

19. The parties agree that the limitation "means for selectively disabling one of the receipt of the recognised [words/characters] . . . and the recognition of speech . . ." is governed by 35 U.S.C. § 112(6).

20. The sole corresponding structure that Allvoice identifies for the "means for selectively disabling" is a single passage of text found at 11:52-61. See Allvoice Br. at 19.

21. The 273 patent does not disclose an algorithm corresponding to the "means for selectively disabling . . ." at 11:52-61 or anywhere else in the specification.

Editor link means for linking... using the link data

22. Claims 15-27 and 54-55, either directly or through dependency, recite "editor link means for linking the audio data to the [word/character component] positions using the link data."

23. The parties agree that "editor link means for linking the audio data to the [word/character component] positions using the link data" is governed by 35 U.S.C. § 112(6).
24. There is no disclosure in the specification of any algorithm or other structure for linking audio data to word/character component positions using already existing link data.

Means for receiving . . . audio data; Means for storing . . . audio data

25. Allvoice contends that the means-plus-functions limitations "means for receiving . . . audio data" (contained in claims 1-27, 52-55, 69-70, and 75-76 either directly or through dependency) and "means for storing . . . audio data" (contained in claims 1-27, 52-55, 70 and 75-76 either directly or through dependency) are supported by corresponding structure that includes software alone, with no hardware.
26. There is no algorithm disclosed in the specification corresponding to the "means for receiving . . . audio data" or "means for storing . . . audio data."

C. Method claims 37-38, 40-48, and 56-59 contain language that renders their scope ambiguous

27. Each of method claims 37, 38, 45, 56-57, and 59 contain limitations that refer to the capability to perform a particular step, without stating whether or not one must actually perform that step to practice the claimed method.
28. Claims 37 and 56 contain a limitation that reads "allowing a user to select whether to read and playback said audio message associated with said file." This language does not specify whether one must actually "read and playback said audio message" in order to practice the claimed method.

29. Claims 38, 45, 57, and 59 each contain the limitation "[said/the] audio message can be read and played back at any time" This language does not specify whether one must actually play back the audio message in order to practice the claimed method.

30. Claims 40-48 and 58-59, either directly or through dependency, contain the language "linking the audio data to the word positions using the link data." There is no disclosure in the specification explaining what the claim could mean by "linking" using already existing link data.

V. ARGUMENT

A. Allvoice's software "interface" claims are invalid because they improperly attempt to cover pure software instructions

Allvoice's attempt to claim a pure software "interface" in claims 60-68 runs afoul of the plain language of 35 U.S.C. § 101 and ample authority interpreting that statute. The Supreme Court, the Federal Circuit, and the Board of Patent Appeals and Interferences have all made it clear that inventions must fall under one of the four categories of patentable subject matter enumerated in 35 U.S.C. § 101. These same courts have made it equally clear that claims to pure software algorithms, such as those at issue here, fail to do so. For these reasons, Allvoice's claims must be held invalid.

Allvoice's pure software "interface" claims violate the plain language of 35 U.S.C. §101.

Section 101 reads:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The statute does not, by its express terms, contemplate claims on instructions or algorithms alone that are not tied to a machine, manufacture, composition of matter, or process. It is for precisely

that reason that the vast majority of software-related patent claims, including the majority of the claims of the 273 patent, are cast in terms of a "data processing apparatus" (i.e., a "machine"), a "method" (i.e., "process"), or a "computer readable medium" (i.e., purportedly a "manufacture" or "composition of matter"). Allvoice's claims do not fall into any of these categories.

The Supreme Court has made it clear that inventions not tied to one of the enumerated categories of subject matter are unpatentable. In *Bilski v. Kappos*, the Supreme Court recently confirmed that the starting point of any analysis of patentability under § 101 is a threshold determination of whether the invention falls within one of the enumerated categories of the statute. 130 S.Ct. 3218, 3225 (2010) ("The § 101 patent-eligibility inquiry is only a threshold test. Even if an invention qualifies as a process, machine, manufacture, or composition of matter, in order to receive the Patent Act's protection the claimed invention must also satisfy 'the conditions and requirements of this title.'"). See also, e.g., *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 483 (1974) ("[N]o patent is available for a discovery, however useful, novel, and nonobvious, unless it falls within one of the express categories of patentable subject matter."). In *Bilski*, the Court found that the claim at issue nominatively recited a "process," but nevertheless went on to analyze that claim and found that it was an unpatentable attempt to claim an abstract principle.

The present case provides a far more compelling basis for a § 101 rejection than *Bilski*. The Court in *Bilski* relied heavily on *Gottschalk v. Benson*, 409 U.S. 63 (1972), and *Parker v. Flook*, 437 U.S. 584 (1978). In those cases, the Court acknowledged that the claims at issue were on their face recited as "processes," but nevertheless rejected them under § 101 as disguised attempts to impermissibly claim an algorithm alone. See *Benson*, 409 U.S. at 71 (1972) (noting that "if the judgment below is affirmed, the patent would wholly pre-empt the mathematical

formula and in practical effect would be a patent on the algorithm itself."); *Flook*, 437 U.S. at 590. Allvoice, on the other hand, does not even attempt to disguise claims 60-68 as processes or machines, nor casts them as any of the other categories of patentable subject matter. Instead Allvoice contends that they cover pure software. *See* Allvoice Br. at 10 ("As indicated above, claims 60 and 67 according to their preamble are limited to the 'interface' which is described in the patent in suit as an 'interface application.' Hence, these claims are limited to software."); *id.* at 18 ("Microsoft . . . improperly includes hardware limitations into these claims, which by their preamble are directed solely to the interface application."). Allvoice's claims fail the threshold test under § 101 and should be held invalid without any further analysis.

The Federal Circuit similarly has rejected attempts to claim inventions not tied to one of the enumerated categories of patentable subject matter. In *In re Nuijten*, 500 F.3d 1346, 1354-57 (Fed. Cir. 2007), *cert. denied*, 129 S. Ct. 70 (2008), for example, the Federal Circuit held a claim to a "signal" invalid because it did not fall within any of the categories of § 101. Similarly, in *In re Warmerdam*, 33 F.3d 1354 (Fed. Cir. 1994), the Federal Circuit explained that a claim to a software "data structure" alone, not expressed as a claim to a machine, similarly failed to fall within any of the § 101 categories. *Id.* at 1361-62 ("Warmerdam's reliance on *Bradley* is misplaced. The 'data structure' at issue in that case was a physical, interconnected arrangement of hardware and thus *embraced by the term 'machine.'* The same cannot be said of the data structure that is at issue in this case.") (emphasis added). That same court went on to hold that similar claims directed to a "machine" were patentable under § 101. *Id.* at 1357. The same analysis applies to this case, and requires that Allvoice's pure software "interface" claims be held invalid.

The Board of Patent Appeals and Interferences, relying on these precedents, has repeatedly held that claims to software instructions alone are unpatentable under § 101. *See, e.g., Ex parte Ramanujam*, Appeal No. 2009-002483 at *7 (BPAI Aug. 12, 2010) ("[T]hese claims are therefore directed to software per se, which falls outside the scope of patentable subject matter."); *Ex Parte Choo et al.*, Appeal No. 2009-006352 at *6 (BPAI July 29, 2010) ("The clear import of the above discussion is that the invention can exist solely in software and data structures Reciting descriptive material per se (e.g., data structures and computer programs), however, is nonstatutory."); *Ex Parte Proudler*, Appeal No. 2009-006599 at *3-4 (BPAI July 12, 2010) ("A claim that recites no more than software, logic or a data structure (i.e., an abstraction) does not fall within any statutory category."). Allvoice's claims for a pure software interface should be held invalid for the same reasons.⁴

Finally, the Manual of Patent Examining Procedure explicitly states that pure software claims, such as claims 60-68, are outside the bounds of § 101. The MPEP states that "computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical 'things.' They are neither computer components nor are they statutory processes, as they are not 'acts' being preformed." MPEP § 2106.01 (8th Ed., 8th Rev. 2010); *see also id.* ("Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as non-statutory functional descriptive material.").

⁴ Copies of these decisions of the Board of Patent Appeals and Interferences are included as Exhibits 1-3 to the Declaration of Paul E. Torchia, attached hereto.

The 273 patent includes many claims tied to an apparatus or a method. However, claims 60-68 attempt to claim pure software instructions and thus exceed the bounds of § 101 and are invalid.⁵ For the forgoing reasons, Microsoft's motion should be granted.

B. Allvoice's means-plus-function claims are indefinite because the specification does not disclose algorithms that correspond to them

Each of claims 1-27, 52-55, 65, 69-70, and 75-76 contains, either directly or by incorporation through dependency, a means-plus-function limitation that lacks the necessary supporting disclosure in the specification of corresponding structure, as required by 35 U.S.C. § 112(6). This Court and the Federal Circuit have repeatedly held that the absence of corresponding disclosure renders this form of claim indefinite as a matter of law. *See, e.g., Aristocrat Techs. Austl. PTY Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1332-1333 (Fed. Cir. 2008); *Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A.*, 412 F.3d 1291, 1298 (Fed. Cir. 2005); *i4i Ltd. P'ship v. Microsoft Corp.*, No. 6:07CV113, slip op. at 17-22 (E.D. Tex. Apr. 10, 2008); *Maurice Mitchell Innovations, L.P. v. Intel Corp.*, No. 2:04-CV-450, 2006 U.S. Dist. LEXIS 85194 at *15 (E.D. Tex. Nov. 22, 2006), *aff'd*, 249 Fed. Appx. (Fed. Cir. 2007). These courts also have held that 112(6) claims directed to software functions are indefinite unless they are supported by a specific corresponding algorithm in the specification. *See, e.g., Aristocrat Techs.* 521 F.3d at 1333-1334; *i4i Ltd. P'ship.*, No. 6:07-CV-113, slip op. at 21-22. Because

⁵ As discussed above, Allvoice has repeatedly taken the position that the means-plus-function limitations recited in claims 60-68 cover software alone. To the extent Allvoice tries to retreat from its position to save these claims and argues that they do include hardware, claims 60-68 still should be held invalid under 35 § 112(2). Any construction that included hardware elements in the body of these claims would contradict their software preambles, and thus render the claim insolubly ambiguous and indefinite. *See In re Cohn*, 438 F.2d 989, 1001 (C.C.P.A. 1971) (holding a claim indefinite under § 112(2) for including a preamble whose scope was inconsistent with the recited elements in the subsequent limitations).

each of the limitations discussed below suffers from this same fatal defect, all of the claims that contain them should be held invalid.

1. There is no algorithm corresponding to the "means for monitoring"

There is no algorithm corresponding to the "means for monitoring" in the specification. In fact, the word "monitor" appears only once in the patent outside of the claims, in a solitary passage that reads as follows:

Thus, in accordance with this aspect of the present invention, positional changes of characters in the character string due to processing operations are monitored and the links which identify the corresponding audio component are updated accordingly.

273 patent at 2:22-26 (emphasis added). This passage, however, does nothing to disclose an algorithm for "monitoring" or to in any other way describe how that function is performed. Rather, it merely restates the functional language of the claim. This Court and the Federal Circuit have held that mere restatement of the functional language of a § 112(6) limitation in this fashion cannot satisfy the patentee's duty to disclose corresponding structure as a matter of law. *See, e.g., Biomedino LLC v. Waters Techs. Corp.*, 490 F.3d 946, 953 (Fed. Cir. 2007) (holding that a figure with box labeled "control" and disclosure that unidentified "known" techniques could be used was insufficient structural disclosure for "control means" to satisfy section 112(6)); *i4i Ltd. P'ship*, No. 6:07CV113, slip op. at 17-22 (E.D. Tex. Apr. 10, 2008) ("The diagrams and the accompanying text do not disclose an algorithm and merely restate the claimed function."); *Finisar Corp. v. DirecTV Group, Inc.*, 416 F. Supp. 2d 512, 519 (E.D. Tex. 2006), *holding aff'd, rev'd in part*, 523 F.3d 1323 (Fed. Cir. 2008) (holding that reference to "software 132," which was merely a box labeled with the function to be performed by the software, was "nothing more than a restatement of the function, as recited in the claim," and hence failed to satisfy section 112(6)).

Allvoice has attempted to point to a number of irrelevant portions of the specification in an attempt to identify corresponding structure for this limitation. However, a structure disclosed in the specification qualifies as "corresponding" structure only if the specification or prosecution history "clearly links or associates that structure to the function recited in the claim." *Default Proof*, 412 F.3d at 1298 (quoting *B. Braun Medical v. Abbott Lab.*, 124 F.3d 1419, 1424 (Fed. Cir. 1997)). Because none of the disclosure Allvoice identifies is clearly linked to the "monitoring function," it cannot constitute corresponding structure.

Specifically, Allvoice has identified passages of the specification and figures relating to the "updating" and "determining" functions as supporting structure for the claimed "monitoring" function. See Allvoice Br. at 11. The first passage that Allvoice cites, which is illustrative of the others, reads:

If dictation has finished, in step S37 it is determined whether the dictated text is inserted into previously dictated text and, if so, the link data is updated to take into consideration the change in character positions of the previously dictated words.

273 patent at 9:7-11 (emphasis added). These "determining" and "updating" functions, however, are different functions from the "monitoring" function and are in fact each separately claimed as separate means-plus-function limitations. See, e.g., claim 64 (means for determining); claim 65 (means for monitoring); and claim 66 (means for updating). Indeed, the claim language itself shows that the determining function relates to finding out where the characters are, whereas monitoring relates to watching for changes in their positions, and updating relates to updating a data structure that maintains their positions. The disclosure for the "determining" and "updating" functions, far from being "clearly linked" to the monitoring function, is plainly intended to correspond to different claimed functions. There simply is no disclosure of any kind relating to how the monitoring function actually works, and Allvoice's

attempt to rely on unrelated disclosure is telling. Accordingly, claims 1-27, 65, and 75-76 should be held invalid as indefinite.

2. There is no algorithm corresponding to the "means for selectively disabling"

There is no algorithm corresponding to the "means for selectively disabling one of the receipt of the recognised [words/characters]... and the recognition of speech..." in the specification. In fact, the only portion of the specification that even Allvoice has pointed to does nothing more than restate the claimed function:

This aspect of the present invention illustrated in FIGS. 9A, 9B, and 10 allows for a user to dictate one or more messages which is stored in association with a document. During the dictation of an audio message no recognised text is input to the text processor application 13. This is achieved in the specific embodiment by failing to pass the text to the text processor application 13. This could alternatively be achieved by disabling the recognition capability of the speech recogniser engine application 11 so that only the audio data is stored.

Id. at 11:52-61 (emphasis added). In the passage above, the two alternative disabling functions set forth in the claim are merely restated in the specification using equivalent language. Mere restatement of functional language, as discussed above, cannot satisfy the burden to disclose corresponding structure. Because there undisputedly is no other disclosure relating to these limitations anywhere in the patent, claims 10-11, 19-20, and 52-55 should be held invalid as indefinite.

3. There is no algorithm corresponding to the "editor link means for linking... using the link data"

There is no algorithm corresponding to the "editor link means for linking... using the link data" in the specification. The patent nowhere discloses how the claimed editor workstation could "link" audio data to character position data "using" already existing "link data." That is because there would be no need for the editor to create link data if the link data already existed.

Indeed, the patent universally discloses the "linking" process as the one that leads to the formation of "link data"- not the other way around. Consequently it is no surprise that there is no algorithm in the specification corresponding to this function.

Not even Allvoice identifies an algorithm corresponding to this function. Rather, Allvoice attempts to rewrite the functional language to mean something totally different than what it says, thereby enabling Allvoice to point to irrelevant disclosure in the specification and avoid the mandate of § 112(6). Allvoice construes the functional language to mean "the IAP retrieves from memory or otherwise receives a copy of the link data," and then points to a disclosure relating to this new function found nowhere in the claims. Allvoice's maneuver is nothing more than an impermissible attempt to fix critical defects in a claim in a manner inconsistent with its plain language. *See Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1349 (Fed. Cir. 2002) (noting that, "[i]t is not our function to rewrite claims to preserve their validity" in the context of holding claims invalid for indefiniteness under § 112(2)) (citation omitted); *Generation II Orthotics Inc v. Medical Tech., Inc.*, 263 F.3d 1356, 1375 (Fed. Cir. 2001) ("[C]laims can only be construed to preserve their validity where the proposed claim construction is 'practicable,' is based on sound claim construction principles, and does not revise or ignore the explicit language of claims."). Because Allvoice can identify no structure corresponding to the function as properly construed, claims 15-27, and 54-55 should be held invalid as indefinite.

4. There is no algorithm corresponding to the "means for receiving . . . audio data" or "means for storing . . . audio data"

There is no algorithm corresponding to the "means for . . . receiving audio data" or "means for storing . . . audio data" in the specification. Microsoft has contended that the corresponding structure for these limitations includes hardware and certain types of files stored

in non-volatile memory. To the extent the Court agrees with Allvoice, however, and determines that the corresponding structure for these limitations is limited to software instructions alone, the claims are indefinite due to failure to disclose corresponding algorithms in the specification.

Allvoice has not identified algorithms that would correspond to either of these functions. Instead, Allvoice points to passages in the specification that merely state the fact that the audio data is received and stored in certain files in non-volatile memory. Allvoice Br. at 15. If Allvoice's position is accepted, and the files and memory recited in these passages are found not to be corresponding structure, then Allvoice is left with no corresponding structure at all, and claims 1-27, 52-55, 69-70, and 75-76 are indefinite.

C. Allvoice's method claims are indefinite because they contain language that renders them insolubly ambiguous

The 273 patent contains a number of method claims that contain language that renders them so ambiguous that one of skill in the art cannot determine whether or not they are infringed. Patent claims that are insolubly ambiguous in this manner are invalid as indefinite. *See Datamize LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005) (holding that claims are considered indefinite when they are "not amenable to construction" or are "insolubly ambiguous."). All of the claims discussed below contain fatal ambiguities.

1. Claims 37, 38, 45, 56-57, and 59 are indefinite because they refer to capabilities to perform certain method steps without specifying whether those steps are required

The 273 patent contains a number of method claims that recite method elements that appear to claim the capability of a system to perform a step, rather than actually setting forth that step as clear claim requirement. All of claims 37, 38, 45, 56-57, and 59 contain such limitations. The excerpted language of claim 56 below provides an illustrative example:

56. A data processing method comprising:

receiving recognition data and corresponding audio data from a speech recognition engine . . . ,

. . . storing the audio data for the period of time as an audio message associated with the file;

. . . allowing a user to select whether to read and playback said audio message associated with said file.

The claim language in the first portion of claim 56 above requires that one store an audio message in order to perform the method step. The last limitation of the claim, however, merely states that the user is "allowed" to select whether to read or playback the audio message.

"Allowing" a user to perform presumably refers to building a particular feature into a product or otherwise providing a user with access to that feature. The "allowing" limitation consequently describes, at most, a capability of a system, and not true a method step.

The Federal Circuit has held that claims that attempt to mix capabilities of a system and a method in this manner are indefinite precisely because it makes the determination of infringement impossible. In *IPXL Holdings v. Amazon.com*, 430 F.3d 1377 (Fed. Cir. 2005), the Court held indefinite a claim that attempted to claim both the use of a system and the structure of the system itself. *Id.* at 1383. The Court explained that it was "unclear whether infringement of claim 25 occurs when one creates a system that *allows* the user to [perform the step at issue], or whether infringement occurs when the user actually [performs the step at issue]." *Id.* at 1384 (emphasis added).

Microsoft is faced with the same irresolvable uncertainty in this case. The claims at issue do not specify whether the user must actually perform the step of playing back the audio message in order to practice the method, or whether it is enough that an accused system is merely provided with that capability, regardless of whether it is actually used. One of ordinary skill in the art would consequently not know whether one who performed all acts but for this last

"allowed" element infringed the claim. There is nothing in the rest of the claim or the specification that would solve this ambiguity, and not even Allvoice has offered a curative construction. Claims 37, 38, 45, 56-57, and 59 should consequently be held indefinite.

2. Claims 40-48 and 58-59 are indefinite because the phrase "linking... using the link data" makes no sense in light of the teachings of the specification

Claims 40 and 58, and their dependents, are indefinite because the term "linking... using the link data" is internally inconsistent and makes no sense in light of the teachings of the specification. As discussed above in section III.B.3, the patent universally discloses the "linking" process as the one that leads to the formation of "link data." Nowhere does the patent ever disclose performing the "linking" process by "using" already existing link data, or suggest how this could possibly be done. Allvoice's attempt to run from this language and to rewrite this claim to preserve its validity evinces the problem, and is contrary to established precedent. *See Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d at 1349; *Generation II Orthotics*, 263 F.3d at 1375. Claims 40-48 and 58-59 should be held invalid as indefinite.

VI. CONCLUSION

For the foregoing reasons, Microsoft motion should be granted, and claims 1-27, 37-38, 40-48, 52-70, and 75-76 of the 273 patent should be held invalid under 35 U.S.C. §§ 101 and 112.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

This is to certify that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3) on this the 12th day of October, 2010.

/s/ Eric H. Findlay

Eric H. Findlay