

United States District Court
For the Northern District of California

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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

VASUDEVAN SOFTWARE, INC.,

No. 11-cv-06638 RS

Plaintiff,

**ORDER GRANTING SUMMARY
JUDGMENT OF INVALIDITY**

v.

TIBCO SOFTWARE, INC.,

Defendant.

I. INTRODUCTION

Defendant TIBCO Software, Inc. (TIBCO) brings three separate motions for summary judgment of invalidity in connection with U.S. Patent Number 7,167,864 (the '864 patent) held by plaintiff Vasudevan Software, Inc. (VSi). VSi asserts that TIBCO's accused products infringe upon independent claim 26 of that patent, as well as claims 33, 36, 39, 41, 45, 46, 48 and 50 that are dependent upon it.¹ First, TIBCO moves for summary judgment of invalidity contending that the alleged invention of the '864 patent is obvious under 35 U.S.C. § 103 and therefore not patentable. It has also moved for summary judgment of invalidity on the grounds that the access code features of the alleged invention fail to meet the written description and enablement requirements of 35 U.S.C. §

¹ VSi initially asserted independent claim 1 and its dependent claims 2, 3, 8, 9, 11 through 14, and 16 through 25, as well as claims 27, 28, 34, 37, 38, 42 through 44, 47, and 49 that are dependent upon claim 26. As it is no longer asserting these additional claims, they are not discussed herein.

1 112. VSi, in turn, moves to strike TIBCO's motion for invalidity regarding the "access code" claim
2 elements, arguing that the invalidity contentions TIBCO filed under the Northern District of
3 California's Patent Local Rules failed to disclose adequately this invalidity theory. TIBCO's final
4 motion for summary judgment of invalidity argues that the claim elements of the '864 patent
5 regarding "disparate [] databases" also fall short of the written description and enablement
6 requirements.

7 For the reasons discussed below, VSi's motion to strike is denied. TIBCO has not met the
8 high bar of proving with clear and convincing evidence that the '864 patent is invalid due to
9 obviousness, nor that its asserted independent claim 26 is invalid for lack of written description or
10 enablement of the "access code" features. TIBCO's motion for a finding of invalidity of claim 26's
11 "disparate [] databases" limitations due to lack of written description and lack of enablement,
12 however, must be granted. As that claim constitutes the only independent claim allegedly infringed
13 in this action, summary judgment will be entered against VSi and in favor of TIBCO.

14 II. BACKGROUND

15 A. The '864 Patent

16 Mark Vasudevan is the sole named inventor of the '864 patent, which is a continuation of his
17 first patent, U.S. Patent Number 6,877,006 (the '006 patent), and claims priority to a provisional
18 application for the '006 patent with a priority date of July 19, 2000. The '864 patent relates to a
19 federated database system that retrieves data from disparate databases to create dynamically and to
20 display to a user a data structure called an online analytical processing (OLAP) cube. The parties
21 have agreed that an OLAP cube is "a data structure having more than two dimensions that provides
22 online analytical processing." OLAP systems typically use an intermediate data repository, such as a
23 "data warehouse," that is refreshed periodically with relevant data extracted from the multiple source
24 databases. VSi's claimed inventions, however, are directed to a specific OLAP implementation that
25 does not use an intermediate data warehouse. Instead, the '864 patent claims a system that populates
26 the OLAP cube dynamically on demand directly from the disparate source databases without going
27 through an intermediate repository.
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1 In 2004, VSi filed its application for the '864 patent, which issued in January 2007. VSi
 2 accuses TIBCO of infringing multiple claims of the '864 patent. The only asserted independent
 3 claim of that patent, claim 26, contains a "disparate [] database" limitation, requiring, among other
 4 things:

5 b. in response to the retrieval request, accessing with a computer a plurality of
 6 disparate digital databases and retrieving with a computer requested data from such
 databases,

7 c. assembling with a computer an OLAP cube of the retrieved data, wherein the OLAP
 8 cube is assembled dynamically on demand without accessing a multidimensional
 database of stored retrieved data,

9 The term "disparate [] databases" was construed as "databases having an absence of compatible keys
 10 or record identifier columns of similar value or format in the schemas or structures that would
 11 otherwise enable linking data." In response to the parties' request for a clarification, the following
 12 formulation proffered by a defendant in a related case, was adopted: "databases having an absence of
 13 compatible keys and an absence of record identifier columns of similar value and an absence of
 14 record identifier columns of similar format in the schemas or structures that would otherwise enable
 15 linking data."

16 As the dynamically federated OLAP cube of the alleged invention required live access of
 17 data stored in multiple different databases, it also created new data access security problems. These
 18 are addressed in the '864 patent by limitations pertaining to "access codes" in elements e, f, and j of
 19 independent claim 26:

20 e. providing a plurality of access codes, each access code corresponding to a number
 21 of disparate databases that may be accessed with the access code,

22 f. assigning each user an access code, and

23 j. [*sic*] receiving and responding to a data access request only if the request is from a
 24 user with code authorizing access to all relevant constituent databases with the
 requested data.

25 The language of these claim limitations constitute the entirety of the '864 patent's discussion of
 26 access codes or a code authorizing access. There are no disclosures of the "access code" claim
 27 elements in the '864 patent other than in asserted claim 26 elements e through j, quoted above, and
 28 identical language in unasserted independent claim 1.

1 B. Prosecution History

2 The provisional application included the “access code” security features, stating in the
3 summary of the invention, “a hierarchy of user access and data update authorization is enabled by
4 the present invention.” Claim 5 of the provisional application also discloses that the “user access . . .
5 authorization” can be implemented through the method described verbatim by elements e, f, and j of
6 claim 26 of the ’864 patent. Furthermore, it made the broad claim of being able to create OLAP
7 cubes from “digital databases.” In 2001, VSi filed a non-provisional application that claimed
8 priority to the provisional application and incorporated it by reference in its entirety. In July of
9 2003, the PTO rejected that application’s pending claims as obvious in light of U.S. Patent Number
10 6,516,324 (Jones). In an attempt to save the application over prior art Jones, Vasudevan amended
11 the application on October 30, 2003, so that the claims only covered creating OLAP cubes from
12 “disparate digital databases.” The ’006 patent issued in April 2005 and incorporates by reference the
13 provisional application.

14 The ’864 patent is a continuation of the ’006 patent, which issued based on an application
15 filed in 2004 claiming priority to the provisional application and again incorporating it by reference.
16 The ’864 patent issued in January 2007 including the same “disparate [] databases” limitation in
17 independent claim 26 that was introduced in the amended application for the ’006 patent.

18 VSi points out the provisional application, dating back to July 2000, included the language
19 describing the “access code” security features which it insists therefore demonstrates that Vasudevan
20 had possession of them since at least the time of first application filing. VSi concedes, however, that
21 Vasudevan had not reduced the invention to practice as of the filing date of the provisional
22 application. TIBCO counters that the only systems created by VSi which practice the contested
23 “access code” claim elements are certain versions of its “MIDaS” software, the first of which was
24 not implemented until July of 2003. TIBCO contends that the presence of the “access code”
25 language in the provisional application is only evidence that Vasudevan realized the dynamic
26 federated OLAP cube posed security problems necessitating the type of fix described by the “access
27 code” claim elements, but that they were not sufficiently described or enabled. TIBCO’s position is
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1 that Vasudevan did not accomplish enablement of the invention's security features until 2003, after
2 years of experimentation.

3 As for the "disparate [] databases" claim elements, it is undisputed that Vasudevan began
4 working on enabling these features at least as early as the fall of 2001, although TIBCO relies on
5 Vasudevan's own deposition testimony to argue that he tried to implement connectivity to disparate
6 databases as early as September or October of 2000. It is further agreed that his work on these
7 features was not complete until the fall of 2003. The preferred embodiment of the '864 patent
8 instructs those skilled in the art to use an object database, such as the Jasmine or Versant databases,
9 to implement the invention. VSi admits that during the period of experimentation, Vasudevan was
10 unable to develop a working prototype using Jasmine or Versant, and was forced to switch to
11 another database not identified or disclosed in the specification.

12 The PTO reexamined the '864 patent and issued an ex parte reexamination certificate
13 confirming the patentability of all of its claims in January of 2009. During the reexamination, VSi
14 submitted a claim chart titled "Application of Prior Art to the Claims," indicating that U.S. Patent
15 Number 5,918,232 to Pouschine et. al. (the Pouschine patent) may raise a substantial new question
16 of patentability as to every element of claim 26 except for j, which relates to the security features.
17 TIBCO argues that, in doing so, VSi conceded that every element of claims 26 is disclosed by
18 Pouschine except j, and that therefore as the only novel element of the '864 patent, the entire patent
19 must fall if that claim element is found to be invalid.

20 Finally, TIBCO has identified certain prior art that was not before the PTO during the
21 prosecution of the '864 patent nor during the reexamination which it argues, in combination with the
22 Pouschine patent, renders the '864 patent obvious to a person of ordinary skill in the art. This prior
23 art includes: DataJoiner version 2.2.1, a commercial product developed and sold by IBM, publicly
24 available as of July 31, 1998; InterViso, publicly available as of 1995; WebFOCUS v3 release 3.2, a
25 commercial product developed and sold by Information Builders, made publicly available in May of
26 1998; and the book Data Warehousing for Dummies, which Vasudevan admitted purchasing in
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1 1997. VSi's technical expert, Dr. Alfonso Cardenas,² opines that at the time the provisional
2 application was filed, a person of ordinary skill in the art:

3 would have had an understanding of database technologies, digital
4 communications (including data sharing and exchange) technologies and OLAP
5 techniques. In general, a person of ordinary skill in the art would work in the area
6 of database software design or administration. Such a person of ordinary skill in
7 the art would have had at least a bachelor's degree in science or engineering with
8 emphasis on computer programming or information technology, as well as one
9 year of experience working on database research, design or administration, along
with some familiarity of OLAP techniques. As another alternative, such a person
of ordinary skill in the art would have had a Ph.D. degree in computer science. As
yet another alternative, such a person of ordinary skill in the art would have had a
Ph.D. in science or engineering with emphasis on computer programming or
information technology along with some experience with database research, design
or administration and familiarity of OLAP techniques.

10 Declaration of Joseph Loy in Support of TIBCO's Motion for Summary Judgment of Invalidity Due
11 to Obviousness (Loy Decl.), Ex. 26 (Cardenas Report) at ¶45. Although TIBCO's expert has
12 provided a different description of one of ordinary skill in the art, TIBCO acknowledges that for the
13 purposes of summary judgment all inferences must be drawn in favor of VSi as the nonmoving
14 party, and therefore VSi's formulation represents the operative definition here.

15 C. Procedural History

16 VSi served its disclosure of asserted claims and infringement contentions as required by
17 Patent Local Rule 3-1 on January 25, 2012. As discussed above, Claim 26 is among VSi's asserted
18 claims.³ TIBCO served its Patent Local Rule 3-3 invalidity contentions on April 12, 2012.
19 Although elements e through j each discusses the alleged invention's security features, TIBCO
20 quoted only element j in arguing that the '864 patent is invalid for lack of enablement and lack of an
21 adequate written description:

22 The '864 patent also fails to provide an enabling disclosure of "receiving and
23 responding to a data access request only if the request is from a user with code
24 authorizing access to all relevant constituent databases with the requested data" (claim
25 1, 26) because it does not disclose how the authorization procedure would be
performed. Particularly, it does not disclose how specific users and groups would be
globally and/or locally authenticated. The '864 patent further fails to provide an

26 ² While TIBCO has separately moved to strike certain portions of the expert reports of VSi's experts
27 Dr. Cardenas and Dr. Dennis McLeod, and to exclude them from offering certain testimony
28 regarding "disparate [] databases" to the jury, that motion is not relevant to the testimony discussed
herein.

³ As claim 26 is the only independent claim VSi asserts, its invalidity is dispositive of all of VSi's
claims for relief in this case.

1 enabling disclosure because VSi's overbroad assertions of "receiving and responding
2 to a data access request only if the request is from a user with code authorizing access
3 to all relevant constituent databases with the requested data" (claim 1, 26) are not
4 supported by the specification, which does not disclose how the authorization
5 procedure alleged to be infringed by VSi would be performed.

6 * * *

7 The '864 patent also fails to provide adequate written description of "receiving and
8 responding to a data access request only if the request is from a user with code
9 authorizing access to all relevant constituent databases with the requested data"
10 (claims 1, 26) because it does not disclose how the authorization procedure would be
11 performed. Particularly, it does not disclose how specific users and groups would be
12 globally and/or locally authenticated. The '864 patent further fails to provide adequate
13 written description because VSi's overbroad assertions of "receiving and responding
14 to a data access request only if the request is from a user with code authorizing access
15 to all relevant constituent databases with the requested data" (claims 1, 26) are not
16 supported by the specification, which does not reasonably convey to a person skilled
17 in the art that the inventor was in possession of the claimed subject matter at the time
18 of filing.

19 Declaration of Jordan Connors in Support of VSi's Motion to Strike, Ex. 2 (TIBCO's
20 Invalidation Contentions) at 42-43.

21 III. LEGAL STANDARD

22 A. Summary Judgment

23 Summary judgment is appropriate "if the movant shows that there is no genuine dispute as to
24 any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a).
25 The moving party bears the initial burden of demonstrating the absence of a genuine issue of
26 material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *see also* Fed. R. Civ. P.
27 56(c)(1)(A). If the movant succeeds, the burden then shifts to the nonmoving party to "set forth
28 specific facts showing that there is a genuine issue for trial." *Celotex*, 477 U.S. at 322 n.3; *see also*
Fed. R. Civ. P. 56(c)(1)(B). A genuine issue of material fact is one that could reasonably be
resolved in favor of the nonmoving party, and which could "affect the outcome of the suit."
Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986). On an issue for which the nonmoving
party will have the burden of proof at trial, the moving party need only point out "that there is an
absence of evidence to support the nonmoving party's case." *Celotex*, 477 U.S. at 325. All evidence
must be viewed in the light most favorable to the nonmoving party, drawing all justifiable inferences
in its favor. *See Anderson*, 477 U.S. at 255.

1 B. Validity of a Patent Under 35 U.S.C. § 103

2 It is settled law that all patents enjoy a presumption of validity that may be overcome only by
3 clear and convincing evidence. See 35 U.S.C. § 282; *State Contracting & Eng'g Corp. v. Condotte*
4 *Am., Inc.*, 346 F.3d 1057, 1067 (Fed. Cir. 2003). TIBCO moves for summary judgment on the basis
5 that the '864 patent is invalid because it is obvious in light of the prior art and the knowledge of one
6 of ordinary skill in that art. "Obviousness is a question of law, premised on underlying factual
7 determinations." *Beckson Marine, Inc. v. NFM, Inc.*, 292 F.3d 718, 722-23 (Fed. Cir. 2002).
8 "Therefore, a district court properly may grant summary judgment on obviousness . . . only when the
9 underlying factual inquiries present no lingering genuine issues." *Id.* at 723. "An obviousness
10 inquiry assesses 'the differences between the subject matter sought to be patented and the prior art'
11 to ascertain whether 'the subject matter as a whole would have been obvious at the time the
12 invention was made to a person having ordinary skill in the art to which said subject matter
13 pertains.'" *Id.* at 725 (quoting 35 U.S.C. § 103(a)). "The underlying factual inquiries are: (1) the
14 scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences
15 between the claimed invention and the prior art; and (4) objective evidence of nonobviousness." *Id.*
16 at 725-26 (internal quotation omitted).

17 In particular, the party "alleging invalidity must show prior art references which alone or
18 combined with other references would have rendered the invention obvious to one of ordinary skill
19 in the art at the time of invention." *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1323 (Fed. Cir.
20 1999). "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR*
21 *Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 421 (2007). "Common sense teaches, however, that familiar
22 items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary
23 skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 420.
24 "[T]he combination of familiar elements according to known methods is likely to be obvious when it
25 does no more than yield predictable results." *Id.* at 416.

26 "The party seeking patent invalidity based on obviousness must also show some motivation
27 or suggestion to combine the prior art teachings." *Al-Site Corp.*, 174 F.3d at 1323-24. "One of the
28 ways in which a patent's subject matter can be proved obvious is by noting that there existed at the

1 time of invention a known problem for which there was an obvious solution encompassed by the
2 patent's claims." *KSR*, 550 U.S. at 419-20.

3 Given that patents are strongly presumed to be valid, *see* 35 U.S.C. § 282, however, "a
4 defendant must show invalidity by facts supported by clear and convincing evidence." *Beckson*
5 *Marine*, 292 F.3d at 725. As it is presumed "that the Examiner did his duty and knew what claims
6 he was allowing," it follows that, "the challenger's burden is especially difficult when the prior art
7 was before the PTO examiner during prosecution of the application." *Al-Site Corp.*, 174 F.3d at
8 1323 (internal quotations omitted).

9 C. Validity of a Patent Under 35 U.S.C. § 112

10 TIBCO moves for summary judgment on the basis that the '864 patent is invalid for failure to
11 meet two of the distinct requirements set forth under 35 U.S.C. § 112(a) (formerly 35 U.S.C. § 112,
12 ¶1), those of written description and enablement:

13 The specification shall contain a written description of the invention, and of
14 the manner and process of making and using it, in such full, clear, concise,
15 and exact terms as to enable any person skilled in the art to which it pertains,
16 or with which it is most nearly connected, to make and use the same

17 i. Written Description Requirement

18 "Written description is a factual inquiry." *In re Katz Interactive Call Processing Patent*
19 *Litig.*, 639 F.3d 1303, 1318 (Fed. Cir. 2011). "The written description requirement requires the
20 inventor to disclose the claimed invention so as to allow persons of ordinary skill in the art to
21 recognize that [the inventor] invented what is claimed." *Billups-Rothenberg, Inc. v. Assoc. Reg'l &*
22 *Univ. Pathologists, Inc.*, 642 F.3d 1031, 1036 (Fed. Cir. 2011) (internal quotation omitted). "In
23 other words, the test for sufficiency is whether the disclosure of the application relied upon
24 reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject
25 matter as of the filing date." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir.
26 2010) (en banc). Possession can be proven "by such descriptive means as words, structures, figures,
27 diagrams, formulas, etc., that fully set forth the claimed invention. Although the exact terms need
28 not be used in hanc verba, the specification must contain an equivalent description of the claimed
subject matter." *Trans Video Elecs., Ltd. v. Sony Elecs., Inc.*, 822 F. Supp. 2d 1020, 1045-25 (N.D.

1 Cal. 2011). “The purpose of the written description requirement is to ensure that the scope of the
 2 right to exclude, as set forth in the claims, does not overreach the scope of the inventor’s
 3 contribution to the field of the art as described in the patent specification.” *In re Katz Interactive*,
 4 639 F.3d at 1319 (internal quotation omitted).

5 ii. Enablement Requirement

6 “Enablement under § 112 is a question of law with underlying questions of fact regarding
 7 undue experimentation.” *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors*
 8 *USA*, 617 F.3d 1296, 1305 (Fed. Cir. 2010). “It is the specification, not the knowledge of one skilled
 9 in the art, that must supply the novel aspects of an invention in order to constitute adequate
 10 enablement.” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997). “To be
 11 enabling, the specification of a patent must teach those skilled in the art how to make and use the full
 12 scope of the claimed invention without undue experimentation.” *ALZA Corp. v. Andrx Pharms.*,
 13 LLC, 603 F.3d 935, 940 (Fed. Cir. 2010).

14 In *In re Wands*, the Federal Circuit set forth the factors that a court may consider when
 15 determining whether a disclosure requires undue experimentation:

16 (1) the quantity of experimentation necessary, (2) the amount of direction or
 17 guidance presented, (3) the presence or absence of working examples, (4) the
 18 nature of the invention, (5) the state of the prior art, (6) the relative skill of
 those in the art, (7) the predictability or unpredictability of the art, and (8) the
 breadth of the claims.

19 858 F.2d 731, 737 (Fed. Cir. 1988).

20 IV. DISCUSSION

21 A. Invalidity Due to Obviousness

22 TIBCO moves for summary judgment of invalidity due to obviousness. As previously
 23 mentioned, the presumption that patents are valid may only be overcome by clear and convincing
 24 evidence. See 35 U.S.C. § 282; *State Contracting & Eng’g Corp. v. Condotte Am., Inc.*, 346 F.3d
 25 1057, 1067 (Fed. Cir. 2003). TIBCO argues that the asserted claims of the ’864 patent are obvious
 26 in light of a combination of Pouschine, DataJoiner, and the knowledge of a person of ordinary skill
 27 in the art. It further argues that claim 26 is obvious in light of InterViso, WebFOCUS and the
 28

1 knowledge of a person of ordinary skill in the art. It further contends that the dependent claims of
2 the patent are obvious in light of a variety of prior art references.

3 i. Pouschine, DataJoiner, and the Knowledge of a Person of Ordinary Skill in
4 the Art

5 Pouschine was filed on November 26, 1997 and issued on June 29, 1999. VSi does not
6 dispute that it represents prior art. *See* 35 U.S.C. § 102(a), (b), & (e). That patent teaches a method
7 and system for dynamically assembling OLAP cubes from disparate databases in response to user
8 queries. VSi filed a request for *ex parte* reexamination of the '864 patent on the basis that Pouschine
9 may raise a substantial new question of its patentability. As discussed at greater length below with
10 respect to the motion for summary judgment of invalidity regarding the "access code" features,
11 during the reexamination VSi submitted a claim chart to the PTO identifying, for each claim of the
12 '864 patent, aspects of the Pouschine patent for which "a substantial likelihood that a reasonable
13 examiner would consider [it] . . . important in deciding whether or not the claim is patentable."
14 Manual of Patent Examining Procedure (MPEP) § 2242. For each element of each claim of the '864
15 patent, VSi identified a corresponding portion of Pouschine, except for element j of independent
16 claim 26, dependent claims 36, 39, 41, 45, and 50, for which it stated Pouschine "does not appear to
17 disclose this element." The PTO ultimately confirmed the patentability of the '864 patent over
18 Pouschine, noting that it did not disclose elements e, f, and j of claims 1, 26, 51, and 53 (the "access
19 code" features).

20 DataJoiner version 2.1.1 is a product developed and sold by IBM. VSi does not dispute that
21 it is prior art that was not considered by the PTO during the prosecution or reexamination of the
22 patent-in-suit. *See* 35 U.S.C. § 102(a), (b) & (g). During a previous case, VSi stated in response to
23 an interrogatory that the only elements of claim 26 of the '864 patent that were not present in
24 DataJoiner were elements c and d.

25 TIBCO argues that it is entitled to summary judgment, because VSi has admitted that
26 Pouschine discloses every element of independent claim 26 except j, DataJoiner discloses every
27 element of that claim except c and d, and that one of ordinary skill in the art would be motivated to
28 use his or her knowledge to combine the teachings of Pouschine and DataJoiner, which collectively

1 encompass all of the elements of independent claim 26 of the asserted patent, and practice the
2 alleged invention through the combination of these known elements.

3 TIBCO argues that each element of claim 26 was disclosed the prior art, rather than invented
4 by Vasudevan, and therefore the alleged invention would have been obvious to one of ordinary skill.
5 As discussed below in the context of TIBCO's motion for summary judgment of invalidity for lack
6 of written description and enablement of the "access code" features, the purpose of VSi's
7 reexamination claim chart was only to identify prior art that a reasonable examinee would consider
8 important in deciding whether or not its claims were patentable. Dr. Cardenas, VSi's expert, opines
9 that Pouschine fails to teach several elements of independent claim 26 of the '864 patent, including
10 elements b through f in addition to j. In reaffirming the validity of the '864 patent after
11 reexamination, the PTO itself indicated that Pouschine did not teach at least elements e, f, and j.
12 Drawing all inferences in favor of VSi, there is a question of material fact as to whether its
13 statements to the PTO constituted an admission that element j of claim 26 is the only novel aspect of
14 the alleged invention. With respect to DataJoiner, Dr. Cardenas opines that it fails to disclose any of
15 the elements of claim 26. Likewise, VSi has also raised material questions of fact as to the scope of
16 the admissions TIBCO claims Vasudevan, Dr. Cardenas, and VSi's additional technical expert Dr.
17 Dennis McLeod made during their depositions. TIBCO has not met its burden of proving by clear
18 and convincing evidence that Pouschine and DataJoiner, considered collectively by a person of
19 ordinary skill in the art, would render the alleged invention of the '864 patent obvious. Instead,
20 questions of material fact remain as to the scope of VSi's supposed admissions and the extent of the
21 disclosures made by the prior art.

22 ii. InterViso, WebFOCUS, Data Warehousing for Dummies, and the
23 Knowledge of a Person of Ordinary Skill in the Art

24 TIBCO refers to an article published in the Very Large Data Base Journal in 1995,
25 "InterViso: Dealing with the Complexity of Federated Database Access" as "InterViso." VSi
26 concedes that this article was publicly available and is prior art that was not before the PTO during
27 the prosecution or reexamination of the patent-in-suit. *See* 35 U.S.C. § 102(a) & (b). TIBCO
28 contends that VSi, in response to a request for admission served upon it during a previous case, has

1 conceded that InterViso discloses element e of claim 26, which related to providing access codes that
2 correspond to disparate databases.

3 WebFOCUS v3 release 3.2 is a commercial product developed and sold by Information
4 Builders that was made available to the public in approximately May of 1998. *See* 35 U.S.C. 102(a),
5 (b), & (g). A manual entitled “Using the WebFOCUS Suite Version 3 Release 3.2” is provided to
6 customers who purchase the product. VSi does not contest that this prior art was absent before the
7 PTO during the prosecution or reexamination of the asserted patent. TIBCO characterizes
8 WebFOCUS as building OLAP cubes that avoid stale data by running dynamic reports from
9 virtually any corporate databases on any computer platform. WebFOCUS users also receive user
10 IDs and passwords that TIBCO argues are similar to the “access codes” claimed by the ’864 patent.
11 Furthermore, TIBCO contends that WebFOCUS’s OLAP control panel enables users to perform the
12 same functions claimed by the asserted dependent claims of the ’864 patent, including drill up, drill
13 down, and pivot data.

14 TIBCO makes a cursory argument that the combination of InterViso and WebFOCUS
15 renders the ’864 patent obvious in light of the knowledge of a person of ordinary skill in the art. It
16 has failed to meet its burden of providing clear and convincing evidence of such obviousness.
17 Instead, TIBCO’s presentation of this issue relies largely on legal conclusions that these prior art
18 references combine many of the same well-known elements as the asserted patent and a person of
19 ordinary skill in the art would have been motivated to combine them because they are all from the
20 same field of endeavor. Moreover, VSi has provided testimony from its expert Dr. Cardenas that
21 InterViso is missing at least elements a through d, f, and j of the ’864 patent’s claim 26 and that
22 WebFOCUS does not teach any element of the claim. TIBCO has not provided clear and convincing
23 evidence that InterViso and WebFOCUS collectively and in combination with the knowledge of the
24 person of ordinary skill in the art teach every element of claim 26.

25 iii. Obviousness of the Dependent Claims

26 TIBCO’s arguments in support of obviousness of dependent claims 33, 36, 39, 41, 45, 46, 48,
27 and 50 are similarly conclusory. TIBCO contends that the Pouschine/DataJoiner and
28 InterViso/WebFOCUS combinations render dependent claims 33, 36, 39, 41, 45, 46, and 48 obvious,

1 particularly in light of the knowledge of a person of ordinary skill in the art. For dependent claim
2 50, it relies only on the Pouschine /DataJoiner combination. In addition, TIBCO argues that claims
3 39, 41, 45, 46, 48, and 50, are obvious when the relevant prior art combinations are viewed in light
4 of the additional prior art reference “Data Warehousing for Dummies.”

5 Published in 1997 and part of the widely distributed “. . . for Dummies” series, Vasudevan
6 testified at his deposition that he purchased it that year and consulted it. *See* 35 U.S.C. § 102(a) &
7 (b). TIBCO notes that it discusses database querying and report, accessing multiple data sources,
8 OLAP, virtual data warehousing, multidimensional databases, and security needs in federated
9 database systems. It was not before the PTO during the prosecution or reexamination of the ’864
10 patent.

11 For each dependent claim, TIBCO states that a certain technology or technique covered by
12 the claim was well-known in the art, and therefore it would have been obvious to use it within the
13 context of the claimed invention, sometimes in combination with prior art. This type of conclusory
14 analysis simply does not meet the clear and convincing standard for proving obviousness. Again,
15 TIBCO’s assertions of obviousness are contradicted by VSi’s technical expert, Dr. Cardenas, who
16 has opined that each of the challenged dependent claims are not obvious. Accordingly, TIBCO’s
17 motion for summary judgment of invalidity due to obviousness must be denied.

18 B. Motion to Strike

19
20 VSi moves to strike TIBCO’s entire motion for summary judgment of invalidity for lack of
21 written description and enablement of the “access code” security features on the ground that
22 TIBCO’s invalidity contentions did not disclose any theory indicating the ’864 patent failed to
23 provide an enabling disclosure or adequate written description with respect to elements e or f.
24 Specifically, VSi contends that the arguments in TIBCO’s motion for summary judgment with
25 respect to elements e and f are so intertwined with those based on element j that the motion must be
26 struck in its entirety, even though they concede that TIBCO’s invalidity contentions disclosed an
27 invalidity theory based on element j.
28

1 TIBCO counters that even though its invalidity contentions do not quote from elements e and
2 f, they provided adequate notice that the asserted claims are invalid for failure to comply with the
3 written description and enablement requirements with respect to the access code scheme described
4 by all three elements: e, f, and j. Furthermore, TIBCO argues that VSi had actual notice of its theory
5 that the access code scheme renders the claims invalid because TIBCO deposed Vasudevan on that
6 subject and requested that VSi produce its responses to discovery requests from prior cases against
7 IBM and Oracle relative to that issue.

8 VSi argues that the Northern District of California routinely precludes parties in patent
9 infringement lawsuits from relying on theories that they failed to include in the disclosures required
10 by the Patent Local Rules, which were “designed to require parties to crystallize their theories of the
11 case early in the litigation and to adhere to those theories once they have been disclosed.” *O2 Micro*
12 *Int’l Ltd. v. Monolithic Power Systems, Inc.*, 467 F.3d 1355, 1366 n.12 (Fed. Cir. 2006). The
13 decisions from this district on which VSi relies in support of this contention are distinguishable from
14 the instant case. For example, both *Spectros Corp. v. Thermo Fisher Scientific*, 2012 WL 1965887
15 (N.D. Cal. May 31, 2012), and *Hologic, Inc. v. SenoRx, Inc.*, 2009 WL 8760730 (N.D. Cal. Oct. 30,
16 2009), are rulings based on Patent Local Rule 3-1, regarding infringement contentions, rather than
17 Patent Local Rule 3-3, which governs invalidity contentions. Infringement contentions under Patent
18 Local Rule 3-1 must be more specific. Patent Local Rule 3-1 requires a party claiming infringement
19 to disclose “a chart identifying specifically where each limitation of each asserted claim is found
20 within each Accused Instrumentality” By contrast, patent local rule 3-3(d) mandates that
21 invalidity contentions contain simply “[a]ny grounds of invalidity based on . . . enablement or
22 written description under 35 U.S.C. § 112(1) of any of the asserted claims.”

23 The plaintiff in *Spectros* was not permitted to assert infringement based on the doctrine of
24 equivalents when its Patent Local Rule 3-1 infringement contentions “specifically represented that it
25 was alleging a claim for literal infringement” and made no mention of the doctrine of equivalents.
26 2012 WL 1965887 at *6. In *Hologic*, defendant’s motion for summary judgment on the basis of
27 non-infringement was granted because the plaintiff had not disclosed its infringement theory
28

1 adequately in its Patent Local Rule 3-1 infringement contentions and was therefore precluded from
2 asserting it.

3 VSi has identified only one decision interpreting Patent Local Rule 3-3(d) in which a
4 defendant was prevented from advancing an invalidity theory based on a failure to disclose it
5 adequately—a slip opinion from the Central District of California. *See Biocell Tech. LLC v.*
6 *Arthuro-7, et. al.*, No. SACV 12-00516-JVS (RNBx) (C.D. Cal. Apr. 15, 2013). In that case,
7 defendants’ invalidity contentions only generically stated that fifteen claims were indefinite because
8 a person of ordinary skill in the art “would not understand the bounds of the claims in which they
9 appear when read in light of the specification.” *Id.* at 14. Defendants subsequently asserted that all
10 terms found in the patents in suit require their plain and ordinary meaning, and stipulated to a
11 construction of the claim term “average molecular weight.” Only after they had done so did they
12 seek to assert invalidity on the basis that the term “average molecular weight” and one other claim
13 term were indefinite. *Id.* at 15. Quite reasonably, the Central District found the invalidity
14 contentions’ “failure to be specific as to the ‘grounds of invalidity based on indefiniteness’ [to be]
15 striking” and prohibited defendants from “prejudice[ing] an opposing party by unexpectedly
16 reasserting an indefiniteness argument that was not previously or consistently raised and after
17 stipulating to claim construction.” *Id.* at 15, 16.

18 The difference between the behavior of the defendants in *Biocell* and this case are significant.
19 TIBCO’s invalidity contentions specifically give notice of its position that:

20 each identified claim of the ’864 patent is invalid because the ’864 patent
21 specification does not include sufficient written description of the alleged
22 invention, and the manner and process of making and using it, in such full, clear,
23 concise, and exact terms as to enable any person skilled in the art to which it
pertains, or with which it is most[] nearly connected, to make and sue the alleged
inventions. See 35 U.S.C. § 112, ¶ 1.

24 Moreover, the invalidity contentions specifically identified at least element j as the subject of this
25 invalidity contention, quoting it directly:

26 The ’864 patent also fails to provide an enabling disclosure of “receiving and
27 responding to a data access request only if the request is from a user with code
28 authorizing access to all relevant constituent databases with the requested data”
(claim 1, 26) because it does not disclose how the authorization procedure would
be performed.

1 The gravamen of this dispute is whether Patent Local Rule 3-3(d)'s requirement that a party's
2 invalidity contentions contain "[a]ny grounds of invalidity based on . . . enablement or written
3 description under 35 U.S.C. § 112(1) of any of the asserted claims" demands that TIBCO quote or
4 explicitly cite to elements e and f of independent claim 26. TIBCO's invalidity contentions state that
5 the '864 patent "fails to provide an enabling disclosure of" and "fails to provide an adequate written
6 description of" element j "because it does not disclose how the authorization procedure would be
7 performed." TIBCO argues that the "authorization procedure" to which its invalidity contentions
8 refers encompasses elements e and f as well as j, as all three elements discuss the same "access
9 codes" or "code authorizing access."

10 "[T]he disclosure standard for invalidity contentions based upon enablement and written
11 description is lower than that required for a claim of obviousness [under patent local rule 3-3(c)] . . .
12 but high enough that it must give the other party enough notice that it can engage in full, timely
13 discovery and litigate its case." *MedImmune, LLC v. PDL BioPharma, Inc.*, 2010 WL 760443, at *3
14 (N.D. Cal. Mar. 4, 2010). Even if TIBCO's "disclosure leaves many important questions
15 unanswered . . . the disclosure nonetheless meets the requirements of the local rules." *Id.* VSi
16 "obviously has an in-depth understanding of its own patent specification," including that the "code
17 authorizing access" referenced in element j is the same as the "access codes" discussed in elements e
18 and f, such that if there were inadequacies alleged with the written description or enablement of the
19 former, there would necessarily be similar inadequacies in the latter. VSi contends the invalidity
20 contentions in *MedImmune* "identifie[d] the very specific grounds for [defendant's] conclusion" that
21 the patent-in-suit failed to meet the written description and enablement requirements whereas, by
22 contrast, TIBCO's invalidity contentions are vague and general. However, even if TIBCO's
23 invalidity contentions could have been more specific, they are nonetheless adequate under the
24 standard set by Patent Local Rule 3-3(d). Accordingly, the motion to strike is denied.⁴

25 ⁴ TIBCO presents an additional argument that, beyond providing notice to VSi of its
26 invalidity theories through its invalidity contentions, VSi received actual notice that it would assert
27 these theories because TIBCO took discovery on topics relevant to them. TIBCO has provided no
28 support for the notion that asking deposition questions or requesting the production of documents
related to an invalidity theory undisclosed in a party's invalidity contentions under the local rules
could somehow "cure" such a deficiency in the invalidity contentions. To the contrary, the Patent
Local Rules were designed to require the parties to crystallize their theories early on in the litigation
to prevent parties from constantly shifting their theories throughout the case. Although the parties

C. Invalidity Due to Lack of Written Description of Access Code Feature

1
2 Although the '864 patent's specification does not discuss the "access code" security features,
3 they are described by elements e, f, and j of independent claim 26. Original claims filed with the
4 application to which the patent claims priority "are part of the original specification." *Id.* at 1349.
5 Here, claim 5 of the provisional application discloses that "user access . . . authorization" can be
6 implemented through the method described verbatim by elements e, f, and j of claim 26 of the '864
7 patent. Accordingly, "[t]o prevail, [TIBCO] must show that the description contained in the original
8 claims does not adequately describe the invention. . . . [TIBCO]'s mere observation that the
9 limitation language is not described in the specification or the drawings does not entitle it to
10 summary judgment of invalidity." *Cybersource Corp. v. Retail Decisions, Inc.*, 2008 U.S. Dist.
11 LEXIS 80370, at *11-12 (N.D. Cal. Oct. 10, 2008). "[T]he level of detail required to satisfy the
12 written description requirement varies depending on the nature and scope of the claims and on the
13 complexity and predictability of the relevant technology." *Ariad*, 598 F.3d at 1351.

14 TIBCO characterizes elements e, f, and j of claim 26 as recognizing the need for federated
15 OLAP cubes to have a data security mechanism for mapping user credentials to disparate databases
16 in order to grant users access to view, edit, and delete only the underlying information to which they
17 should have access, but failing to disclose how to solve this problem. It argues that the claims do not
18 meaningfully disclose the claimed invention, thereby failing to fulfill the purpose of the written
19 description requirement. Instead, TIBCO's position is that the claims simply indicate that
20 Vasudevan had identified and wished to solve this security problem as of the filing date of the
21 provisional application.

22 VSi attempts to bolster the claim language by pointing to Figure 6 in the patent specification,
23 language in the summary of the invention, and figures in the provisional application as further
24 written description of the patent's security features. First, Figure 6 does not describe the security
25 features because it makes no reference to access codes and fails to identify that the invention would
26 only "receiv[e] and respond[] to a data access request only if the request is from a user with code

27
28 dispute whether the deposition questions and requests for the production of documents posed by
TIBCO were sufficient to put VSI on actual notice of TIBCO's invalidity theories regarding
elements e and f, such an inquiry is irrelevant. TIBCO's invalidity contentions are sufficient.

1 authorizing access to all relevant constituent databases with the requested data” as required by the
2 asserted claims. Instead, it indicates only that a software application can establish a database link
3 using “connection methods and protocols 655.” VSi argues that the specification provides at least
4 one example of the “connection methods and protocols” mentioned in Figure 6: “OLE-DB” which
5 “allows access to most databases” and “native connection method[s].” VSi does not explain how
6 “OLE-DB” relates to, let alone describes, the claimed security features. Next, the summary of
7 invention states the “present invention, for the first time, assembles an OLAP [cube] at run time, in
8 response to a data query by a user, by accessing a plurality of incompatible source databases.” VSi
9 characterizes this as a description of the security features. This passing reference to “accessing” a
10 database, however, does not expressly tie user access authorization to accessing disparate databases.
11 Finally, VSi argues that Figures 20 through 22 of the provisional application disclose the access
12 codes of the alleged invention. Yet, these figures make no mention whatsoever of access codes.
13 Aside from the claim language itself, nothing in the patent’s written description nor the provisional
14 application mentions “access codes” or “codes authorizing access.”

15 VSi maintains that the original claim language, alone, still satisfies the written description
16 requirement. “Original claims are part of the specification and in many cases will satisfy the written
17 description requirement.” *Crown Packaging Tech., Inc. v. Ball Metal Beverage Container Corp.*,
18 635 F.3d1373, 1380 (Fed. Cir. 2011). VSi argues that they do so here by virtue of Vasudevan’s
19 description of an aspect of the invention in a claim filed as part of the original application which
20 strongly suggests that he was in possession of that aspect of the invention as of the application filing
21 date. From VSi’s perspective, the mere fact that an original claim of the provisional application
22 recited the same language as elements e, f, and j of claim 26 of the ’864 patent demonstrates that
23 Vasudevan had possession of the access code security features as of the provisional application’s
24 filing in 2000, and no further description of them is required for the patent to satisfy the written
25 description requirement.

26 TIBCO disputes that the written description requirement can be automatically satisfied in that
27 fashion. Indeed, the Federal Circuit has affirmed that district courts may grant summary judgment
28 of invalidity for lack of written description in such circumstances. *See Ariad*, 598 F.3d at 1349;

1 *Fiers v. Revel*, 984 F.2d 1164, 1170 (Fed. Cir. 1993). Even if the provisional application included
2 the same claim language as the patent, if the written description in the provisional application's
3 original claims merely evinced the inventor's "wish" or "plan" to invent what was claimed, the
4 patent may be invalid for lack of written description. *Fiers*, 984 F.2d at 1170. "Although many
5 original claims will satisfy the written description requirement," VSi concedes, "certain claims may
6 not." *Ariad*, 598 F.3d at 1349. "For example, a generic claim may define the boundaries of a vast
7 genus of chemical compounds, and yet the question may still remain whether the specification,
8 including original claim language, demonstrates that the applicant has invented species sufficient to
9 support a claim to a genus." *Id.* VSi argues that original claims are more likely to be insufficient in
10 unpredictable, primitive, or uncertain technology areas, such as chemistry and life sciences, but not
11 in more advanced and established fields such as computer science.

12 VSi's technical expert, Dr. Cardenas, opines that the claim language of elements e, f, and j
13 sufficiently convey to a person of ordinary skill in the art (whom he describes as having an "M.S. or
14 Ph.D. degree in computer science") that Vasudevan had possession of the "access code" security
15 features as of the filing date of the provisional application. Dr. Cardenas declares that "[p]ersons of
16 ordinary skill have known of database 'access codes,' such as a username and password—certainly
17 by July 2000 priority date of VSI's '864 patent." Dkt. 132-10 at 5. As an example that this
18 knowledge was commonplace by 2000, Dr. Cardenas points to his own book, which described such
19 security features as early as 1979. Accordingly, Dr. Cardenas concludes, "persons of ordinary skill
20 certainly would have known how to make and use a data storage medium that provided such 'access
21 codes' without undue experimentation." *Id.* at 5. Although TIBCO discounts Dr. Cardenas's
22 opinion as conclusory, it has not submitted any contrary evidence. The Federal Circuit counsels that
23 "[w]here there is a material dispute as to the credibility and weight that should be afforded to
24 conflicting expert reports, summary judgment is usually inappropriate." *Crown Packaging*, 635 F.3d
25 at 1384. Given that TIBCO did not submit conflicting expert testimony, but merely questions the
26 weight that should be given to that of VSi's expert, summary judgment on the basis of lack of
27 adequate written description is unwarranted. VSi has raised a material question of fact as to whether
28 the claim language alone provided a sufficient written description of the "access code" security

1 features to demonstrate that Vasudevan was in possession of them at the time he filed the provisional
2 application.

3
4 D. Invalidity Due to Lack of Enablement of the Access Code Features

5 TIBCO argues that there is no need for the Court to apply the *Wand* factors here because the
6 '864 patent provides no enabling disclosure whatsoever. VSi contends that those factors should be
7 applied because the original claims themselves constitute the disclosure. As previously noted,
8 original claims filed with the application to which the patent claims priority constitute part of the
9 original specification. *See Ariad*, 598 F.3d at 1349. Accordingly, the *Wands* factors are applied
10 below to determine whether this original claim language enables the claimed invention.

11 TIBCO contends that the quantity of experimentation necessary for Vasudevan to enable the
12 alleged invention is undue. Certainly a significant time lapse transpired between August 1999, when
13 Vasudevan allegedly conceived of the invention and July 2003, the date he finally reduced it to
14 practice. Additionally, Vasudevan claims that he worked during these nearly four years at a rate of
15 more than 2000 hours a year in order to implement the claims of the '864 patent to practice. VSi
16 concedes that Vasudevan did not have a working example of his alleged invention practicing the
17 '864 patent's "access code" security features at the time the provisional application was filed. It
18 further admits that it took Vasudevan years to build an embodiment of *all* of the claims of the '864
19 patent, but argues that only approximately 200 hours of experimentation were needed to implement
20 the "access code" security features. Vasudevan testified that once he began working on them, he
21 implemented them "within a few months" and "it didn't take long at all." Declaration of Eric Enger
22 in Support of VSi's Opposition to TIBCO's Motion for Summary Judgment of Invalidity for Lack of
23 Written Description and Enablement of "Access Code" Features, Ex. 10 (Vasudevan Depo.) at
24 227:15-229:24. As all factual disputes must be resolved in favor of VSi, as the nonmoving party, the
25 200 hour period of experimentation is taken as true for purposes of summary judgment. Although
26 the absence of a working embodiment upon the filing of the provisional application weighs against
27 enablement, the relatively minor amount of experiment required to embody the "access code"
28 features weighs in the opposite direction.

1 VSi characterizes the specification's guidance for enabling the "access code" features as
2 meaningful, describing the claims as detailed and clearly identifying the functionality of the security
3 features. Given that the claim language itself is the only guidance regarding the "access code"
4 features provided in the specification, and that claim language is rather spare, VSi's description of it
5 is unconvincing. The amount of direction or guidance provided by the specification weighs against
6 enablement.

7 Nonetheless, VSi argues that the relatively cursory discussion of the "access code" features
8 in the '864 patent is sufficient to enable them because a person of ordinary skill in the art would
9 have been able to recognize the contours of this functionality from the disclosures based on
10 Vasudevan's deposition testimony that a person of ordinary skill in the art in 2000 could have
11 implemented the access codes simply by referring to Figure 6's reference to "connection methods
12 and protocols." Additionally, Dr. Cardenas opines that the claim language alone enables the
13 challenged limitations because in 2000, when the provisional application was filed, techniques for
14 providing access codes for databases were well known to persons of ordinary skill in the art.

15 Essentially, VSi contends that the security features are enabled despite the minimal
16 description of them provided by the patent because such features would have been well-known to
17 one of ordinary skill in the art in the year 2000. VSi admits that the state of the prior art includes
18 such security features. According to Dr. Cardenas, the relative skill of those in the art is fairly high,
19 as such persons would have a "M.S. or Ph.D. degree in computer science." VSi argues that given
20 the advanced state of the prior art, a person of ordinary skill in the art, in a predictable field such as
21 software, would have been able to code the security features without undue experimentation.

22 TIBCO asserts that VSi is estopped from advancing such arguments because, during the
23 reexamination of the '864 patent, it conceded to the PTO that element j of claim 26 is the only
24 element not disclosed by prior art Pouschine. "The prosecution history constitutes a public record of
25 the patentee's representations concerning the scope and meaning of the claims, and competitors are
26 entitled to rely on those representations when ascertaining the degree of lawful conduct, such as
27 designing around the claimed invention." *Seachange Int'l, Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1372
28 (Fed. Cir. 2005). From TIBCO's perspective, VSi's statements to the PTO were tantamount to an

1 admission that element j of claims 26 represents the only novel aspect of the invention leading the
2 PTO to confirm the patentability of the '864 patent over Pouschine based on that representation.
3 TIBCO argues, therefore, that VSi may not rely upon one having ordinary skill in the art to “flesh
4 out” or supplement the claim language in lieu of an enabling disclosure because it is “the
5 specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an
6 invention in order to constitute adequate enablement.” *Genentech*, 108 F.3d at 1366. “The novel
7 aspects of the invention must be disclosed and not left to inference, that is, a patentee may not rely
8 on the inference of a person of ordinary skill in the pertinent art to supply such novel aspects.”
9 *Crown Operations Int'l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1380 (Fed. Cir. 2002).

10 The Examiner ultimately described element j as the most important element of the
11 independent claims and granted a reexamination certificate based on the Pouschine patent's lack of
12 the access code scheme. TIBCO argues that VSi's may not now disavow its statements to the PTO
13 during reexamination. It insists that, alone, the claim language does not supply the novel aspects of
14 element j, and therefore application of estoppel against VSi would be fatal to the validity of the '864
15 patent.

16 VSi denies that the statements it made in the reexamination are binding on its litigation
17 positions because the standards applied during each procedure are different. During reexamination,
18 VSi, as the requester, had the obligation to identify to the PTO the claims for which it was requesting
19 reexamination and to disclose to the PTO prior art that could “raise[] a substantial question of
20 patentability where there is a substantial likelihood that a reasonable examiner would consider the
21 prior art patent . . . important in deciding whether or not the claim is patentable.” Manual of Patent
22 Examining Procedure (MPEP) § 2242. Furthermore, the claims that are the subject of reexamination
23 should be given their broadest reasonable construction consistent with the specification, which may
24 result in the PTO construing them differently than they are later construed in litigation. *See*
25 *Therasense, Inc. v. Becton, Dickenson & Co.*, 649 F.3d 1276, 1292 (Fed. Cir. 2011) (en banc); *see*
26 *also* MPEP § 2258(1)(G). Finally, the PTO applies a preponderance of the evidence standard to
27 invalidity claims by an accused infringer during reexamination, whereas here, the clear and
28 convincing standard applies. *See Therasense*, 649 F.3d at 1292. VSi explains that its reexamination

1 claim chart does not constitute an admission that the security features in element j of claim 26 are the
2 only novel limitations of the '864 patent owing to these differences between the standards applied by
3 the PTO during reexamination and those applicable in federal courts. For this reason, VSi's
4 reexamination request explicitly underscored "that the validity positions described herein . . . are not
5 necessarily the positions VSi would take in . . . any litigations."

6 TIBCO has identified only one case in support of the proposition that statements before the
7 PTO similar to those made by VSi constitute a binding admission that a particular claim element is
8 the only novel limitation of a patent. *DatCard Sys., Inc. v. Pacsgear, Inc.*, a slip opinion from the
9 Central District of California, held that the patentee's statements to the PTO regarding what
10 elements of the alleged invention were disclosed in the prior art were binding for purposes of an
11 obviousness determination on summary judgment of invalidity. No. 8:10-cv-012288-MRP-VBK
12 (C.D. Cal. Mar. 12, 2013), Slip Op. at 9. In *DatCard*, however, the patentee made its statements in
13 the context of an Accelerated Examination Support Document (AESD) during an Accelerated
14 Examination procedure. To participate in that specialized procedure, a patentee must file an AESD
15 identifying references in the prior art most closely related to the claims and make admissions
16 regarding which references disclose elements of the claimed features. *See* Changes to Practice for
17 Petitions in Patent Applications To Make Special and for Accelerated Examination, 71 Fed. Reg.
18 36324-25 (June 26, 2006). In other words, in exchange for a quicker examination, an applicant is
19 required to make statements that will trigger prosecution history estoppel. VSi, by contrast, was not
20 participating in an Accelerated Examination and the PTO did not necessarily consider its claim chart
21 to constitute such admissions. Rather, the purpose of VSi's claim chart was only to identify prior art
22 that a reasonable examiner would consider important in deciding whether or not its claims were
23 patentable.

24 Drawing all inferences in favor of VSi as the nonmoving party, there is at least a question of
25 material fact as to whether it admitted to the PTO that element j of claims 26 is the only novel aspect
26 of the alleged invention. If element j is not, it is permissible for the person of skill in the art to
27 supplement the language of element j with his or her own knowledge of the prior art to enable the
28 claimed security features. Given Vasudevan and Dr. Cardenas's testimony that a person of ordinary

1 skill in the art would have sufficient knowledge to enable the features without undue
2 experimentation, and considering the fairly high skill of such a person, the advanced state of the
3 prior art, the predictability of the art, and the relatively small quantity of experimentation necessary
4 for Vasudevan himself to enable the security features, TIBCO's motion for summary judgment of
5 invalidity cannot be granted to the extent it is specifically based on the enablement of the "access
6 code" features

7 E. Invalidity Due to Lack of Written Description of the "Disparate [] Databases" Features
8

9 TBICO moves for summary judgment of invalidity for lack of written description of the
10 "disparate [] databases" features of the alleged invention. It argues that the provisional application
11 does not contain any disclosure regarding how to access, retrieve, or aggregate data from disparate
12 databases in its specification or its claims. Given that the "disparate [] databases" limitation was not
13 added until three years after the filing of the provisional application, such an omission is
14 unsurprising. TIBCO contends that the only mention of the phrase "disparate [] databases" in the
15 '864 patent is in the context of the prior art, stating that in order to access disparate databases using
16 the prior art, the databases have to be "pre-configured at the design-time of the information
17 systems." The figures in the '864 patent are identical to those that were contained in the provisional
18 application. Indeed, Vasudevan admitted that among screenshots included as figures in the
19 provisional application to illustrate the alleged invention are those from software that was not able to
20 access and retrieve data from disparate databases, and therefore does not practice the patent-in-suit.
21 Accordingly, TIBCO argues that the written description in the '864 patent is inadequate because,
22 rather than describing the "disparate [] databases" limitation, it describes a system that cannot access
23 and retrieve data from disparate databases.

24 The provisional application to which the '864 patent claims priority was amended in 2003 to
25 overcome prior art Jones, narrowing its claims from covering the accessing of all "digital databases"
26 to accessing only "disparate digital databases." VSi concedes that the patent statute prohibits an
27 amendment to a patent application from "introduce[ing] new matter into the disclosure of the
28 invention." 35 U.S.C. § 132(a); *see also Stored Value Solutions, Inc. v. Card Activation Techs., Inc.*,

1 499 Fed. Appx. 5, 9, 13-14 (Fed. Cir. 2012) (affirming lack of written description because the
2 patentee added a limitation that improperly expanded the claim scope beyond the patent disclosure).
3 VSi argues, however, that limiting the patent’s scope to “disparate digital databases” rather than all
4 “digital databases” did not introduce new matter into the disclosure of the invention because the
5 patent’s coverage was narrowed to include only a subset of digital databases, rather than expanded.
6 This argument, while clever, is unpersuasive for two reasons. First, VSi does not point to a single
7 case in which the “narrowing” argument it advances was adopted. Second, although “disparate
8 digital databases” are a sub-set of all digital databases, it does not logically follow that the
9 amendment Vasudevan made to the provisional application “narrowed” its claims. Indeed, the
10 amendment was filed in order to distinguish his purported invention over the prior art, by, for the
11 first time claiming that it did something new and different than what was disclosed by Jones. While,
12 for example, data from digital databases that are not disparate can be accessed and joined through
13 the use of key values that the different databases share in common, Vasudevan’s purported invention
14 operates without reliance on that previously-known method to tackle the novel challenge of
15 accessing “disparate [] databases.”

16 “[A] patent can be held invalid for failure to meet the written description requirement, based
17 solely on the language of the patent specification.” *Univ. of Rochester v. G.D. Searle & Co.*, 358
18 F.3d 916, 927 (Fed. Cir. 2004). Nonetheless, to contest TIBCO’s conclusion, VSi offers the opinion
19 of its technical expert, Dr. Cardenas, that Figures 1, 4, 6, and 8 and their accompanying text describe
20 how the alleged invention accesses and retrieves data from “disparate [] databases.” Dr. Cardenas
21 believes these passages show that Vasudevan had possession of the claimed invention at the time of
22 the filing of the provisional application. The conclusory expert opinion provided by VSi is not
23 sufficient to create a material question of fact for trial, because it remains undisputed that Vasudevan
24 amended his patent application to “claim[] a distinct invention from that disclosed in the
25 specification” of the provisional application. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565,
26 1572 (Fed. Cir. 1997) (affirming the district court’s grant of invalidity “by looking solely at the
27 applications themselves” and disregarding patentee’s expert declaration because “each application in
28 the chain must describe the claimed features”); *see also Trans Video Elecs, Ltd. V. Sony Elecs., Inc.*,

1 822 F. Supp. 2d 1020 (N.D. Cal. 2011) (disregarding expert testimony on written description that
2 “essentially contradicts” the claim construction). There is no question of material fact as to whether
3 the written description of the databases features would reasonably convey to those skilled in the art
4 that Vasudevan had possession of that aspect as of the filing date of the provisional application.
5 TIBCO’s motion for summary judgment on this issue must, therefore, be granted.

6 F. Invalidity Due to Lack of Enablement of the “Disparate [] Databases” Features
7

8 TIBCO next argues that the ‘864 patent is invalid due to its failure to teach those skilled in
9 the art how to make and use the full scope of the claimed invention’s “disparate [] databases”
10 features without undue experimentation, as evidenced by Vasudevan’s own failure to enable those
11 limitations without undue experimentation. Again, TIBCO takes the position that it is unnecessary
12 to apply the *Wands* factors because the patent lacks sufficient written disclosure of the “disparate []
13 databases” limitations. See *Nat’l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d
14 1190, 1195-98 (Fed. Cir. 1999); *Genentech*, 108 F.3d at 1366. As discussed above, however, VSi
15 has raised at least a material question of fact as to whether the written description of the “disparate []
16 databases” limitations are sufficient. Accordingly, the *Wands* factors are again weighed below to
17 determine whether that claim language is sufficiently enabled.

18 VSi admits that the period of Vasudevan’s experimentation lasted from at least the fall of
19 2001 through the fall of 2003. It argues, however, that Vasudevan spent less than one year of his
20 time during this period working to enable the “disparate [] databases” features, and that his
21 additional work during the period related to other features or products. VSi describes Vasudevan’s
22 experimentation as necessary to overcome the deficiencies in existing products such as Jasmine ii
23 and Versant. It contends that during the period of experimentation, 90% of Vasudevan’s efforts
24 were directed to the MIDaS product as a whole, and approximately 50% of his MIDaS efforts were
25 focused on the “disparate [] databases” features in particular. Vasudevan provided a declaration
26 stating that from late 2001 through 2003, he worked 60-80 hours per week.

27 Relying on Vasudevan’s own representations, TIBCO calculates that he spent between 3,159
28 and 4,212 hours just to reduce the “disparate databases” limitation to practice. TIBCO argues that

1 this amount of experimentation is undue, representing between one and a half and two years of labor.
2 VSI does not quibble with TIBCO's math, but describes the number of hours worked as the
3 equivalent of only one year of experimentation. Working at an aggressive pace of fifty hours a week
4 during fifty weeks of a year still only amounts to 2,500 hours of work during that period, far below
5 the minimum of 3,159 hour of work that Vasudevan concedes having spent experimenting to enable
6 the "disparate [] databases" features. A more reasonable pace of forty hours a week for fifty weeks
7 of the year would result in 2,000 hours of work. At that pace, Vasudevan's own calculations lead to
8 the conclusion that enabling the "disparate [] databases" features would require a person of ordinary
9 skill in the art to experiment for eighteen to twenty-five months to enable the features. This
10 extended period of experimentation weighs heavily in favor of a finding of invalidity.

11 The amount of guidance provided is a factor closely related to the issue of whether the patent
12 contains an adequate written description, as discussed above. The parties hotly dispute the amount
13 of guidance provided by the specification for enabling the invention, raising many of the same
14 arguments advanced with respect to the adequacy of the patent's written description. TIBCO
15 describes the patent's guidance as minimal, arguing that the only mention of "disparate databases" in
16 the specification states that although prior-art systems "can perform complex collation and
17 correlation of data derived from a large and disparate set of databases, the databases have to be pre-
18 configured at the design-time of the information systems." The specification identifies "key
19 parameters" as the "solution" to this issue, but TIBCO argues that it provides no guidance on how to
20 devise such a "parameter." VSi, by contrast, describes the specification as providing paragraph after
21 paragraph of enabling description, including figures that demonstrate how to connect to disparate
22 databases and to assemble an OLAP cube from the retrieved data. In particular, VSi's technical
23 expert, Dr. Cardenas, opines that the invention is enabled by disclosure of a serialized file and
24 correlation parameters. TIBCO dismisses this testimony as an expert's impermissible attempt to
25 "rewrite" the specification in an effort to create a genuine issue of fact. *See Default Proof Credit*
26 *Card Sys. Inc. v. Home Depot USA, Inc.*, 412 F.3d 1291, 1302 (Fed. Cir. 2005) ("[patent holder]
27 cannot use the declaration of its expert to rewrite the patent's specification.").

28

1 TIBCO raises an additional argument regarding the guidance provided by the patent that is
2 persuasive. It points out that, in certain respects, the specification teaches away from a working
3 embodiment. TIBCO notes, and VSi does not dispute, that a number of figures in the patent are
4 screenshots from software that does not and cannot practice the claimed invention. Moreover, the
5 specification describes the preferred embodiment of the invention as being implemented through the
6 use of the Jasmine database. Vasudevan, however, testified that despite his best efforts, he could not
7 implement the invention using that particular database, as the specification instructs. Rather than
8 teaching how to make the invention, the specification teaches away from a working embodiment;
9 evidence that the specification does not enable the invention. *See Liebel-Flarsheim Co. v. Medrad,*
10 *Inc.*, 481 F.3d 1371, 1379 (Fed. Cir. 2007).

11 VSi concedes that Vasudevan lacked a working example of the invention at the time the
12 provisional application was filed, but argues that the law does not require reduction to practice prior
13 to filing. *See Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 61-62 (1998). Nonetheless, this factor too
14 weighs against enablement.

15 The nature of the invention also weighs against enablement as VSi's own expert testified that
16 the problem solved by the invention confounded inventors for 20 years, just as the creation of an
17 OLAP cube from "disparate [] databases" was unknown previously. As to the next factor, state of
18 the prior art, VSi contends that it included both OLAP and federation technology, and that its patent
19 merely combines them in a novel way. Accordingly, VSi insists that one of ordinary skill in the art
20 would be able to rely on his or her knowledge of the advanced state of the prior art to enable the
21 invention without undue experimentation. The testimony of VSi's own expert, Dr. Cardenas, that
22 "there was no teaching to perform OLAP using a federated database" at the time of the invention,
23 undermines this position. Both Vasudevan and Dr. Cardenas testified that they knew of others who
24 had tried and failed to implement the invention prior to the filing of the provisional application,
25 including well-established computer software company, Computer Associates. This failure of others
26 to practice the alleged invention even in light of the state of the prior art weighs against enablement.

27 VSi's technical expert, Dr. Cardenas, describes the relative skill of those in the art as high,
28 having at least a bachelor's degree in computer science or engineering with an emphasis on

1 computer programming or information technology, a few years of work experience, and familiarity
2 with OLAP techniques. TIBCO disagrees with Dr. Cardenas's characterization of the relative skill
3 of those in the art as being relatively high. Dr. Cardenas opines that a person with only a bachelor's
4 degree could qualify as a person of ordinary skill in the art if they also had additional work
5 experience and familiarity with OLAP techniques. As previously discussed, his definition also
6 includes those who have a Ph.D. degree in computer science or a Ph.D. in science or engineering
7 with emphasis on computer programming or information technology along with some experience
8 with database research, design or administration and familiarity with OLAP techniques. Thus, the
9 relative skill of those in the art is high. It is also worth noting that Dr. Cardenas describes
10 Vasudevan as a person of extraordinary skill in the art, yet it admittedly took Vasudevan at least
11 three thousand hours of experimentation to reduce the alleged invention to practice. Presumably, the
12 experimentation required of one of merely ordinary skill in the art to achieve the same results would
13 be even greater.

14 Predictability of the art favors enablement because, as VSi posits, the invention is in the
15 software filed, which is a predicable art with well-developed computer languages. Coding in such
16 languages would be within the ken of the person of ordinary skill in the art. Furthermore, database
17 technologies have existed for many years. Although TIBCO points to Vadudevan's own inability to
18 predict which third-party tools could be used to implement the invention to argue that the art is
19 unpredictable, this argument is properly directed to the amount of experimentation required. It is not
20 a commentary on the state of computer science or software as a field, which has reached a level of
21 predictability.

22 VSi describes the claims as "drawn to a niche area in OLAP technology" and therefore
23 favoring enablement. TIBCO characterizes the claims as broad because they encompass every
24 method of accessing incompatible or disparate databases to generate OLAP cubes, rather than one
25 specific method. It notes that VSi has only identified one enablement of its "disparate [] database"
26 features, involving correlation parameters and serialized files. Enablement, however, must be
27 commensurate with the scope of the patent claim. *Nati'l Recovery Techs., Inc. v. Magnetic*
28 *Separation Sys., Inc.*, 166 F.3d 1190, 1195-96 (Fed. Cir. 1999). "The scope of the claims must be

1 less than or equal to the scope of the enablement.” *Id.* at 1196. Here, because the relative breadth of
 2 the claims is greater than the scope of the enablement, and they fail to explain how the patent’s
 3 disclosures could be used to generate OLAP cubes from the wide variety of databases VSi claims are
 4 disparate, this factor weighs against enablement.

5 Overall, the *Wands* factors weigh heavily in favor of invalidity due to lack of enablement.
 6 While the burden of proving invalidity by clear and convincing evidence is high, TIBCO has met it in
 7 this instance. It is undisputed that at the time Vasudevan filed the provisional application, he was not
 8 in possession of a working example of the “disparate [] databases” features it claimed. The
 9 specification of that provisional application included screen shots from software that could not be
 10 used to practice the alleged invention, thereby teaching away from enablement. Moreover, it took
 11 Vasudevan, whose own expert described him as one of extraordinary skill in the art, more than three
 12 calendar years to enable those features. During that period of experimentation, Vasudevan’s own
 13 declaration undisputedly establishes that he spent a minimum of 3,159 and as many as 4,212 hours
 14 working to reduce the “disparate [] databases” limitations to practice. TIBCO’s motion for summary
 15 judgment of invalidity of the ’864 patent must therefore be granted due to lack of enablement
 16 regarding the “disparate [] databases” features.

17 V. CONCLUSION

18 VSi has alleged that TIBCO’s accused products infringe upon independent claim 26 of the
 19 ’864 patent. In that invalidity due to lack of written description and lack of enablement infects this
 20 sole asserted independent claim, the effect of this order is that summary judgment of invalidity is
 21 entered in favor of TIBCO and against VSi.

22 IT IS SO ORDERED.

23
 24 Dated: 10/17/13

25 
 RICHARD SEEBORG
 UNITED STATES DISTRICT JUDGE

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