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15 WEBINAR.NET, INC.

16 UNITED STATES DISTRICT COURT
17 NORTHERN DISTRICT OF CALIFORNIA

18 ON24, Inc.,

19 *Plaintiff,*

20 vs.

21 Webinar.net, Inc.,

22 *Defendant.*

)
) Case Number: 3:21-cv-07721-EMC
)
) **DEFENDANT’S REPLY IN SUPPORT OF**
) **MOTION FOR PARTIAL SUMMARY**
) **JUDGEMENT**
)
) Judge: Edward M. Chen
) HEARING DATE: August 10, 2023
) TIME: 1:30 pm
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STATUTES

35 U.S.C. § 112(2)2, 7

35 U.S.C. § 112(6)1, 6

1 **I. INTRODUCTION**

2 ON24 has failed to avoid the holding of *Rain Computing, Inc. v. Samsung Elecs. Am.,*
3 *Inc.*, 989 F.3d 1002 (Fed. Cir. 2021). ON24’s primary argument is that the term “software
4 object” recited in the claims of the ‘480 patent is legally different from the term “software
5 module” at issue in *Rain Computing*. In support of this argument, ON24 submits a declaration
6 from an expert witness (Mr. Overby) who states that “software module” is different from
7 “software object” merely because the term “software object” refers to a particular type of
8 programming language known as “object oriented programming.” Changing the term “module”
9 to “object” does not overcome the holding of *Rain Computing* because both terms are merely
10 general terms for “software.” A patent owner cannot simply substitute one general term for
11 software “module” with another general term for software “object” and magically avoid the
12 holding of *Rain Computing* as this would elevate form over substance. In addition, other
13 observations by Mr. Overby actually support Webinar.net’s contention that this case is
14 indistinguishable from *Rain Computing*. For example, Mr. Overby observes that the ‘480 patent
15 specification describes the “communication manager object” in terms of “what it does” (i.e., its
16 functions) and “with what other components it interacts” (Dkt. 71-1, p. 6, para. 18) which is
17 exactly what *Rain Computing* held to be insufficient structure to overcome a “means-plus-
18 function” construction. *Id.* at 1006.

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20 ON24 also cites a number of unpublished district court cases in support of their assertion
21 that the term “object” connotes sufficient structure and is therefore not a nonce word. (Dkt. 71,
22 p. 18, ll. 3-14). Putting aside that ON24’s cited cases are unpublished and therefore non-
23 precedential, as well as District Court rather than Federal Circuit precedent (e.g., *Rain*
24 *Computing*), none of these cases even address the issue as to whether the term “object” is a nonce
25 word (i.e., claim construction under 35 U.S.C. § 112(6) was neither raised by the parties nor
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1 addressed by the courts). ON24 does cite one published district court case¹ that addressed claim
2 construction of the term “port control module” under 35 U.S.C. § 112(6); however, the court in
3 that case held the term is not “means-plus-function” because the claim *lacks a recited function*.
4 In this case, the claims clearly recite function (exchanging data with each component) performed
5 by the recited “communication manger object,” and ON24 concedes this point. (Dkt. 71, p. 18,
6 ll. 19-20).

7 Finally, ON24 argues that even if the term “communication manager object” is construed
8 as “means-plus-function,” the specification discloses the corresponding structure (in the form of
9 an algorithm) for performing the function of “exchanging data with each component” recited in
10 the claims, and is therefore not indefinite under 35 U.S.C. § 112(2). In support of this assertion,
11 ON24 points to various paragraphs in the ‘480 patent specification that merely include the word
12 “communication.” When discussing the only paragraph in the ‘480 patent specification that
13 actually describes the “communication manager object” (‘480 patent, 4:24-48), ON24 fails to
14 identify anything that can legally be considered an algorithm under *Rain Computing*. It does not
15 take an expert to read this paragraph (4:24-48) and see that it merely describes the
16 “communication manager object” in terms of *how it is connected to various parts of the system*
17 *and how it functions*, which the Federal Circuit clearly held is not enough to provide *sufficient*
18 *structure*. *Rain Computing* at 1006. ON24 also points to the conclusory statements in the
19 extrinsic evidence of Mr. Overby’s declaration, but other than describe the general concepts of
20 object oriented programming, Mr. Overby merely regurgitates what is obvious to any lay person:
21 the ‘480 patent specification merely describes the “communication manager object” by “what it
22 does” (i.e., its functions) and “with what other components it interacts” (Dkt. 71-1, p. 6, para.
23 18) which, as a matter of law, is not sufficient structure. *Rain Computing* at 1006.
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27 ¹ *Microchip Tech. Inc. v. Nuvoton Tech. Corp. Am.*, No. 19-CV-01690-SI, 2020 WL 978636, at
28 *11 (N.D. Cal. Feb. 28, 2020).

II. CLAIM CONSTRUCTION AT PTAB

ON24 asserts the “parties had previously agreed that ‘communication manager object’ should be construed to have its plain and ordinary meaning as understood by one skilled in the art.” (Dkt. 71, p. 8, ll. 8-9). Presumably, ON24 is referring to the *Inter Partes* Review petition filed by Webinar.net. However, since ON24 has failed to prove the elements for judicial estoppel, it is well established that Webinar.net has the right to assert an alternate claim construction in District Court.²

III. PROSECUTION HISTORY

Although the prosecution history is relevant intrinsic evidence in construing claim language, ON24 merely cites the examiner’s reasons for allowance in the notice of allowance. As is often the case, the examiner merely parroted the claim language when drafting the “reasons for allowance” which sheds no light on claim construction.

IV. DYFAN, LLC V. TARGET CORP.

In *Rain Computing*, the Federal Circuit held that the claim term “user identification module” does not connote sufficient structure to one skilled in the art. ON24 relies on a follow-on case, *Dyfan, LLC v. Target Corp.*, 28 F.4th 1360 (Fed. Cir. 2022), to assert the term “communication manager object” does connote sufficient structure to one skill in the art. (Dkt. 71, p. 15, ll. 19-23). However, the Federal Circuit in *Dyfan* merely clarified that a general software term such as “code” may connote structure if the corresponding software component “could be implemented using ‘off-the-shelf’ code” readily available to those skilled in the art at the time the patent application was filed. *Id.* at 1368. In particular, the Federal Circuit in *Dyfan* relied on testimony from the patent owner’s expert witness (Mr. Goldberg) who testified:

² *Panduit Corp. v. Corning Inc.*, No. 5:18-CV-229-FL (W.D.N.C. July 2, 2021); *King v. Herbert J. Thomas Mem’l Hosp.*, 159 F.3d 192, 196 (4th Cir. 1998).

1 “a person of ordinary skill would have known that the claimed function of
2 displaying information could be implemented using ‘off-the-shelf’ code or
3 applications. J.A. 884–85 (Goldberg Dep. 53:21–54:18).” *Id.* at 1368.

4 The Federal Circuit in *Dyfan* further referenced the holding in *Zeroclick*³ where it found the term
5 “user interface code” did connote sufficient structure to one skilled in the art because it is a
6 reference to “conventional programs or code ‘existing in [the] prior art at the time of the
7 invention [.]’”. *Id.* at 1368.

8 Accordingly, from the Federal Circuit holdings in both *Rain Computing* and *Dyfan*, the
9 clear issue in this case is whether the term “communication manager object” in the ‘480 patent
10 claims refers to “conventional” or “off-the-shelf” code available to one skilled in the art at the
11 time the patent application was filed.⁴ If the term “communication manager object” refers to
12 “conventional” or “off-the-shelf” code, then it connotes sufficient structure to one skilled in the
13 art... otherwise it does not.

14
15 Turning first to the extrinsic evidence provided by the testimony of Mr. Overby relied on
16 by ON24, Mr. Overby’s main contention is that the term “object” would connote structure to one
17 skilled in the art simply because the term “object” refers to a particular programming language
18 known as “object oriented programming” or OOP.⁵ (Dkt. 71-1, para. 7, 16). Nowhere does
19 Mr. Overby in his testimony describe the “communication manager object” as being a
20 “conventional” or “off-the-shelf” code or “object” known to one skilled in the art at the time the
21 patent application was filed as required by the Federal Circuit in *Dyfan*. Certainly if such an
22 “off-the-shelf” programming component had been in existence (in the form of an OOP Object

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24 ³ *Zeroclick, LLC v. Apple Inc.*, 891 F.3d 1003, 1007 (Fed. Cir. 2018).

25 ⁴ The priority date of the application which is April 7, 2010.

26 ⁵ “Object Oriented Programming” is one of the five common types of computer programming,
27 together with “Procedural Programming”, “Functional Programming”, “Scripting Languages”,
28 and “Logic Programming.” <https://www.coursera.org/articles/types-programming-language>

1 or otherwise), Mr. Overby would have identified it in his testimony. To the contrary, Mr. Overby
2 explained explicitly in his testimony that it would have been up to one skilled in the art to
3 implement the "communication manager object" in view of the patent specification alone (Dkt.
4 71-1, para 16, 17), rather than point to an "off-the-shelf" known software component available
5 at the time the patent application was filed. Further, Mr. Overby's own testimony relies on the
6 '480 patent specification as describing the "communication manager object" in terms of "what
7 it does" (i.e., its functions) and "with what other components it interacts" (Dkt. 71-1, p. 6, para.
8 18) which is exactly what the Federal Circuit in *Rain Computing* held to be insufficient structure
9 to overcome a "means-plus-function" construction. *Id.* at 1006.

10 Turning now to the more significant *intrinsic evidence* that is the '480 patent
11 specification (which the Federal Circuit in *Phillips* has stressed heavy reliance when construing
12 claims),⁶ nothing in the '480 patent specification would suggest that the "communication
13 manager object" is a "conventional" or "off-the-shelf" software component known to those
14 skilled in the art at the time the patent application was filed. To the contrary, the '480 patent
15 specification describes the "communication manager object" in terms of a "complex" software
16 component that accomplishes various functions as compared to the conventional "mashup" of
17 components ('480 patent, 4:24-48):

19 The **complex** interaction within the various components is managed by a
20 central "Communications Manager" object, which registers events or requests from
21 individual components, identifies the priority of each event, and determines the
22 callback mechanism to deliver information back to the calling component...
23 **Contrast this organized platform approach with a mashup of components**—
24 each unaware of the other, and each competing for the limited resources available
25 to the browser (CPU, threads, number of concurrent request to the back-end
26 systems available, etc.), degrading performance in unpredictable and undesirable
27 ways.

28 ⁶ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005).

1 Accordingly, the above paragraph (which is the only description of the “communication manager
2 object”) describes the “mashup” approach as the “conventional” or “off-the-shelf” known
3 technique at the time the patent application was filed, and describes the *complex*
4 “communication manager object” as an improvement to these conventional, known
5 programming techniques. The only reasonable interpretation of this paragraph is that the
6 “communication manager object” is an *inventive, new programming technique* that improves
7 upon the prior art “mashup” technique and therefore, by definition, cannot be considered a
8 “conventional” or “off-the-shelf” component known to those skilled in the art at the time the
9 patent application was filed.

10 Webinar.net raised the issue of a “conventional” or “off-the-shelf” software component
11 in their original motion for partial summary judgement (Dkt. 70, p.8, ll. 3-12), yet ON24 was
12 silent on this issue in their response.⁷ In addition, ON24’s own expert witness (Mr. Overby)
13 described the recited “communication manager object” not as a “conventional” or “off-the-shelf”
14 software component (or “object”) at the time the patent application was filed, but rather as a
15 software component (object) that one skilled in the art would need to implement based on the
16 teachings of the ‘480 patent specification. Still further, the ‘480 patent specification itself (which
17 carries the most weight in claim construction) describes the “communication manager object” as
18 a “complex” software component that overcomes drawbacks of the known, prior art “mashup”
19 techniques, and therefore the ‘480 patent specification itself admits that the “communication
20 manager object” was not a “conventional” or “off-the-shelf” component at the time the patent
21 application was filed. Accordingly, Webinar.net has offered sufficient evidence that the term
22 “communication manger object” is not a “conventional” or “off-the-shelf” component, which
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26 ⁷ The Court should infer admission in the face of ON24’s silence. *Harmon v. Mifflin County*
27 *School Dist*, 684 A.2d 651, 655 (Pa. Cmmw. Ct. 1996).

1 means the term is a nonce term under *Rain Computing* as well as under *Dyfan* and should
2 therefore be construed as a “means-plus-function” term under 35 U.S.C. § 112(6).

3 Having established the term “communication manager object” should be construed under
4 35 U.S.C. § 112(6), all of the claims should be found indefinite and therefore invalid under 35
5 U.S.C. § 112(2) for failing to disclose a corresponding algorithm in the ‘480 patent specification.
6 Describing the “communication manager object” in terms of “what it does” (i.e., its functions)
7 and “with what other components it interacts” (Dkt. 71-1, p. 6, para. 18) is, as a matter of law,
8 not sufficient structure under *Rain Computing*,⁸ and therefore this description also cannot be
9 considered an algorithm (structure) required under *Rain Computing*.⁹
10

11 **VI. CONCLUSION**

12 For the foregoing reasons, Webinar.net’s Motion for Partial Summary Judgement should
13 be granted, and all claims of the ‘480 patent should be found indefinite and therefore invalid
14 under 35 U.S.C. § 112(2).
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27 ⁸ *Rain Computing. Id.* at 1006.

28 ⁹ *Rain Computing. Id.* at 1008.

1 Dated: April 24, 2023

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the above and foregoing document has been served on April 24, 2023 to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system.

Executed on April 24, 2023, at Scottsdale, Arizona.

/s/ Howard H. Sheerin

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