

2/25/23

No. 22-819

In the
Supreme Court of the United States

FRANZ A. WAKEFIELD D/B/A
COOLTVNETWORK.COM,

Petitioner,

v.

BLACKBOARD, INC. ET AL.,

Respondents.

On Petition for a Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

35 U.S.C. § 282(a) provides that “[a] patent shall be presumed valid.” This Court has ruled that when a court reviews validity of a patent, the presumption can be overcome *only* by clear and convincing evidence. *Microsoft Corp., v. i4i Limited Partnership*, 564 U.S. 91 (2011). Failure of a court to comply with this statute; creates a manifest injustice, obliterating an Inventor’s right to Due Process, their 7th Amendment Rights, and erodes the “Patent Bargain.” *Therefore, the questions presented are:*

1. Whether a Magistrate Judge—unappointed by Senate, can set aside 35 U.S.C. § 282(a) by invalidating a patent, utilizing a preponderance of the evidence standard and by failing to follow the Four-Factor *Markman Test*; *in conflict* with decisions made by This Court, which has ruled said test is the force of Federal Law and correct procedure. *Markman et. al., v. Westview Instruments, Inc., et. al.*, 517 U.S. 370 (1996).

2. Whether The Federal Circuit can affirm, by Rule 36, invalidation of a software patent for indefiniteness pursuant to 35 U.S.C. § 112; when *The Prosecution History* of the patent, and record discloses clear and convincing evidence to the contrary-(1) a declaration of a (POSITA), including code proving enablement, and (2) sworn statements *raising a genuine issue of material fact*, that the statutory requirements of 35 U.S.C. § 112, was satisfied.

3. Whether *The Specification* of a patent must disclose everything necessary to practice an invention, *even what is well known in the art*—enabling full scope of the invention, 35 U.S.C. § 112; and whether *coextensive* structure in an (MPF) claim limitation overcomes the presumption of 35 U.S.C. § 112, ¶6.

PARTIES TO THE PROCEEDINGS

Petitioner

Petitioner, FRANZ WAKEFIELD, D|B|A COOLTVNETWORK.COM, was plaintiff in the district court and appellant in the court of appeals.

Respondents

Respondents BlackBoard, Inc., Meta Platforms, Inc., F|K|A Facebook, Inc., International Business Machines, Corp., Kaltura, Inc., Edgio, Inc., Microsoft Corporation, Ooyala, Inc., Snap, Inc., and Trapelo, Corp., were defendants in the district court and appellees in the court of appeals.

CORPORATE DISCLOSURE STATEMENT

Pursuant to This Court's Rule 29.6, Petitioner, FRANZ WAKEFIELD is an individual person who does business as COOLTVNETWORK.COM. Thus, there is no corporation, and no shareholders.

LIST OF PROCEEDINGS

U.S. Court of Appeals for the Federal Circuit, Nos.

2021-2191	2021-2192	2021-2193
2021-2195	2021-2196	2021-2197
2021-2198	2021-2199	2021-2200

Cooltvnetwork.com, Inc., *Plaintiff-Appellant v.*
Blackboard, Inc., Meta Platforms, Inc., fka Facebook,
Inc., International Business Machines Corporation,
Kaltura, Inc., Edgio, Inc., Microsoft Corporation,
Ooyala, Inc., Snap Inc., Trapelo Corp.,
Defendants-Appellees.

Date of Final Judgment: July 7, 2022

Date of Rehearing Denial: September 30, 2022

U.S. District Court for the District of Delaware

CoolTVNetwork.com, Defendant
Inc., Plaintiff

1:19-cv-00291-LPS-JLH Blackboard, Inc.

1:19-cv-00292-LPS-JLH Facebook, Inc.

1:19-cv-00293-LPS-JLH International Business
Machines Corporation

1:19-cv-00294-LPS-JLH Kaltura, Inc

1:19-cv-00295-LPS-JLH Limelight Networks, Inc.

1:19-cv-00296-LPS-JLH Microsoft Corporation

1:19-cv-00297-LPS-JLH Ooyala, Inc.

1:19-cv-00534-LPS-JLH Snap, Inc.

1:19-cv-00535-LPS-JLH Trapelo Corp.

Date of Final Judgments: July 16, 2021

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OPINIONS BELOW

The court of appeals' opinion, **Pet.App.1a-2a**, is unreported. The district court's opinions, **Pet.App.3a-7a, 8a-17a** are unreported.



JURISDICTION

The Federal Circuit entered judgment on July 7, 2022, **Pet.App.1a-2a**, and denied a combined petition for rehearing and rehearing en banc on September 30, 2022, **Pet.App.59a-60a**. The Court extended the time to file this petition to February 27, 2023 (Sup.Ct.22A515). This Court has jurisdiction under 28 U.S.C. § 1254(1).



STATUTORY PROVISIONS INVOLVED

The relevant provision of the Presumption of Validity Statute, 35 U.S.C. § 282, and the relevant provision of the Patent Act, 35 U.S.C. § 112, is set forth in the Appendix: **Pet.App.61a-64a**.



INTRODUCTION

The Federal Circuit’s Rule 36, affirmation of the district court’s decision is in *direct conflict* with long-standing precedents of This Court. 35 U.S.C. § 282(a) provides that “[a] patent shall be presumed valid,” and continues by stating that “[t]he burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.” This Court has held, in numerous decisions, that when a court reviews the validity of a patent, the presumption may *only* be overcome by clear and convincing evidence. *Microsoft Corp., v. i4i Limited Partnership.*, 564 U.S. 91 (2011); *Radio Corp. of America v. Radio Eng. Lab, Inc.*, 293 U.S. 1 55 S. Ct. 928, 79 L. Ed. 163 (1934); and *Bonito Boats, Inc., v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-151, 109 S. Ct. 971, 103 L. Ed. 2d 118 (1989).

Definiteness, as described by Section 112 of the Patent Act (*i.e.*, 35 U.S.C. § 112, ¶1), includes the knowledge of a person of ordinary skill in the art (POSITA), and raises technologically complex case-specific questions that tend to identify as factual disputes, which is “in large part encompassing warring expert testimony.” (*Law, Fact, and Patent Validity*; by Paul R. Gugliuzza; IOWA LAW REVIEW, Vol. 106:607 at page 655, footnote 289). It is almost exclusively extrinsic, thus requiring the resolution of critical factual issues more appropriately decided by a jury after trial. *Bombardier Recreational Prods. Inc., v. Arctic Cat. Inc.*, 785 F. App’x 858, 867 (Fed. Cir. 2019).

During the Prosecution History of The '696 Patent, The Examiner drafted the independent claims of The '696 Patent, with *presumed enabled*, means-plus-function (MPF) limitations, which was approved by the Primary Examiner, and PTO Supervisor. Pet.App.111a, item 4-112a, ¶1. The following is The Examiner's statement of allowance: "In regards to independent claims 1, 2, and 18, the prior art found does not teach a **multi-functional hot spot apparatus comprising** all of the following specific modes: a shop mode, a bid mode, an interact mode, an entertainment mode, and a link mode; wherein a specific mode is selected by *a user* through **an expandable graphical user interface bar**; wherein said specific mode further toggles based on time stamps in said digital video or digital audio file; and wherein **with the selection of a particular hot spot, a predetermined function** is executed **based on the mode currently active; in combination** with all of the other claim limitations." (emphasis added), DE[50].EXB.FH00000171; and Pet.App.94a-97a.

The '696 Patent is directed to an interactive software based system and device having processor readable code, stored on a tangible medium—(*i.e.*, a server or one or more hard drives) that facilitates the use of a digital media file, such as a digital video source or video stream as a conduit for **accessing, by clicking**, related or targeted information through Multifunctional Hot Spots—(*i.e.*, an area in or near the video on the screen display that contains hyperlinks to URL addresses and/or targeted databases) '696

¹ All reference to the record in the District Court, DE [], is based on: *CoolTvNetwork.com, Inc., v. Meta Platforms F|K|A Facebook, Inc.*, C.A. No. 19-292-LPS-JLH.

Patent 4:37-5:7. The Multifunctional Hot Spots may access information within the user's system, a globally accessible network, or any local area network by **Launching the URL**—(i.e., *activating the URL*, *Id.* at 6:4-17; and 8:3-7), associated with the Hot Spot upon it being *clicked*—(i.e., by conventional hyperlink protocol; HTTP: Hypertext Transfer Protocol, which is *well known* to those skilled in the art, and is known as: 1. The **browser** looks up the IP address for the URL (domain), 2. The **browser** initiates TCP connection with the DNS (domain name server), 3. The **browser** sends the URL (HTTP domain) request to the DNS server, and 4. The *DNS (domain name server)* processes the request and sends back a response by displaying the *webpage* or content located at the URL.) *Microsoft Computer Dictionary, 5th Edition*; Pet.App. 114a, ¶4-Pet.App.115a,¶1; ROA[103].9-112. This process is completed by The ClickVideoShop™ Invention on a screen display, in a manner that does not transport the viewer from the host website, application, and/or video, when the Multifunctional Hot Spot is *clicked*—(i.e., *selected and activated*), hence dramatically reducing the viewer bounce rate from the playing video. *DDR Holdings, LLC., v. Hotels.com*, 773 F. 3d 1245, 157 (Fed. Cir. 2014), (where the Federal Circuit determined a hybrid website that did not transport a user away from the host website when a banner ad is clicked, was patent eligible.); '696 Patent, 2:43-63; 4:9-12; 4:37-58; 5:44-47; 5:57-6:21; FIG. 3—9:15-17; Pet.App.136a; Pet.App.169-172a; and Pet.App.98a-105a.

² All reference to the record in the Federal Circuit, ROA[], is based on: *Franz Wakefield, D|B|A, COOLTVNETWORK.COM, v. BLACKBOARD, INC.*, Appeal Docket No.: 2021-2191.

The '696 Patent Specification provides for programmable Hot Spots—(*i.e.*, Multifunctional, Pet.App. 133a-135a), a novelty over static hot spots, and discloses *two embodiments* for a Multifunctional Hot Spot Apparatus: 1. Where the Multifunctional Hot Spot is an object in the video on a screen display—(*i.e.*, in this embodiment the mode control button(s) are distinct from the Hot Spot), and 2. Where the Multifunctional Hot Spot is the mode control button(s)—(*i.e.*, mode-button hot spot) on the screen display, but not necessarily in the video. '696 Patent 2:64-3:3; 7:26-28; 8:14-17; DE[8].9-12, and Pet.App.137a-138a.

The fact that especially large amounts of money are involved in this litigation over the issue of statutory construction of The '696 Patented Technology is a pervasive factor that should mandate the correct application of the Due Process Clause of the 14th Amendment in favor of Petitioner. *Fidelity Fed. Bank & Trust v. Kehoe*, 126 S. Ct. 1612 (2006), and S. Shapiro et. al., *Supreme Court Practice* (9th ed. 2008), pg. 269.

Nevium, *Intellectual Property Damage Experts*, states: "Nevium calculated potential damages for component periods of the Analysis Period. Facebook's alleged infringing use of the '696 Patent is between 1% and 2%. As presented at Schedule 1, possible patent infringement damages are between **\$114 and \$874 million**, with a median indication of **\$337 million**. Nevium recommends the following *additional analyses and discovery* to refine the preliminary estimate of potential damages: [1.] Through discovery or additional research, obtain information indicating date or dates when Facebook and Instagram **Ad Manager** commenced use of '**hotspots**' in **Stories** and in *video-*

based advertising placements". (emphasis added) See, Pet.App.68a-70a.

I. Overview of the Proceedings Below

The Magistrate Judge invalidated The '696 Software Patent before conducting discovery, the opportunity for summary judgment and trial by jury, relying *only* on a thin record, and by blindly availing herself of the biased light provided by *only* the Respondents' expert in considering the Fourth Factor of The *Markman* Four-Factor Test; before fully grasping the complex technical aspects of the invention, and by utilizing a preponderance of the evidence standard rather than clear and convincing evidence; which was ultimately adopted by the District Judge. On October 19, 2020, at the *Markman* Hearing, *four days* before rendering a decision on October 23, 2020, the Magistrate Judge stated, regarding one of the two functional claim limitations of Claim 1: "I am trying to make sense of what this means to have 'means for *selecting* and *activating* at least one of said predetermined functions *by clicking*.' I mean, it seems to incorporate both software functionality with a human step of clicking, and *I am challenged to understand how to make sense of it.*" (emphasis added), Pet.App.179a-180a, and Pet.App. 169a, ¶3—Pet.App.170a. In her report and recommendation, announced from the bench on October 23, 2020, the Magistrate Judge states: "While *I only need to look to the patent itself to conclude that the means for performing language is indefinite*, I note that my conclusion is *consistent with the declaration of Defendants' expert.*" (emphasis added), Pet.App.35a, ¶3; Pet.App. 201a-206a; and Pet.App.211a-212a.

The District Court failed to satisfy the Second Factor, from the *Markman* Four-Factor Test, *the documentation of the patent during the process—(i.e., analyzing “The Prosecution History”)*, by not considering declaration evidence by a (POSITA), in The Prosecution History of The '696 Patent and the record that discloses clear and convincing evidence to the contrary of the patent being invalid, including: 1. Prototype software code evidence that proves enablement—(*i.e.*, by way of recreation of the invention from a single phone call, without undue experimentation), Pet.App.81a-93a, and 2. Sworn statements from the (POSITA) that *raises a genuine issue of material fact*, that The Petitioner would be able to proffer additional corroborating expert testimony during discovery, that proves that the statutory requirements of 35 U.S.C. § 112 was satisfied, and that the USPTO a qualified government agency, properly completed its job by writing the independent claims of The '696 Patent Application, and by GRANTING said patent. *Nautilus, Inc., v. Biosig Instruments, Inc.*, 572 U.S. 2124 (2014); *Vasudevan Software, Inc., v. MicroStrategy, Inc.*, 782 F. 3d 671 (Fed. Cir. 2015), (where expert testimony raised a genuine issue of material fact about serialized files, which *required* remand.); and *Hoist & Derrick Co., v. Sowa & Sons Inc.*, 725 F. 2d 1350, 1359 (Fed. Cir. 1984). The Magistrate Judge in her report and recommendation states: “I’m unpersuaded that a POSITA *would understand a mode control and a click to be the corresponding structure* for the means for *selecting and activating*. Indeed, the claim separately requires a mode control.” (emphasis added), Pet.App.42a, ¶3; '696 Patent 3:29-31; 4:9-12; Pet.App.206a-211a; Pet.App. 211a-212a; Pet.App.212a-214a; and ROA[103].6-15.

The Federal Circuit's affirmance of the district court's ruling is in *direct conflict* with This Court's long-standing precedents, is a departure from its own low written description bar for software patent claims, pursuant to 35 U.S.C. § 112, and is in *direct conflict* with its own software patent law precedents, which casts doubt on the proper determination of validity for existing and future software patents being tried and appealed nationwide. *Festo Corp., v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 727-28 (2002), and *S. Shapiro et. al., Supreme Court Practice* (9th ed. 2008), pg. 287.

This Petition for Certiorari presents *Questions* that are **identical with or very similar** to the 35 U.S.C. § 112, issues already pending before this Court in *Amgen et al., v. Sanofi et al.*, Docket No: 21-757; and *Novartis Pharm. Corp., v. HEC Et. Al.*, Docket No: 22-671; which 1. Certiorari has been GRANTED and is 2. PENDING before This Court. The issue is obviously important, and this Supervisory Court should GRANT this Petition and set the case for argument or postpone consideration of this Petition until the other cases have been decided and then make summary disposition of this case in accordance with these decisions.

II. The Federal Circuit's Rule 36, Affirmance Is in Conflict with Its Own Precedents

The first major indication that the Federal Circuit viewed software as an art requiring little disclosure came *In Re Sherwood*, a 1980 case before the Court of Customs and Patent Appeals. *In Re Sherwood*, 613 F. 2d 809, 816 (CCPA 1980), the *Sherwood* Court found that a detailed program listing was not required to enable or disclose the best mode of a computer-related invention. By characterizing programming in this

way, the court apparently took the view that **programmers are quite skilled**, and a relatively low disclosure is necessary as long as the “trick” or functional goal is communicated. (*The Low Written Description Bar For Software Inventions*, by Ajeet P. Pai; 3/28/2008).

In Re Fonar Corp., v. General Electric Co., 107 F. 3d 1543 (Fed. Cir. 1997), the court then went on to further reduce the Section 112 disclosure burden for software, stating: “[F]low charts or source code listings are not a requirement for adequately disclosing the functions of software.” (*The Low Written Description Bar For Software Inventions*, by Ajeet P. Pai; 3/28/2008).

The '696 Patent Specification discloses a simple algorithm in the figures of the patent as flow charts, and as corresponding structure as text; that provide the necessary written description to perform the *coextensive functions* of the two means-plus-function claim limitations of independent Claim 1 of the patent. In addition, *The Prosecution History* of the patent—(*i.e.*, *Markman* Four-Factor Test, Step 2) discloses declaration evidence from a POSITA that proves enablement—(*i.e.*, by satisfying The *Wands* Factors) by clear and convincing evidence and offers cogent proof that the statutory requirements of 35 U.S.C. § 112 was satisfied during the prosecution of the patent application. *Wands*, 858 F. 2d 731 (Fed. Cir. 1988).

Failure of The Federal Circuit, and The Third District Court to comply with, and follow 35 U.S.C § 282(a), the *Markman* Four-Factor Test, established by This Court as Federal Law, and failure to follow its own precedents for enablement of software patents, by rendering a “quick decision” based on a thin record;

creates a manifest injustice that obliterates an Inventor's right to Due Process, their 7th Amendment Rights ordained by the Constitution of The United States, and systematically erodes the "Patent Bargain." Petitioner respectfully submits that review is warranted; this Petition should be granted for the reasons detailed *infra*.



STATEMENT OF THE CASE

I. Statutory Framework

This Court has ruled that “[j]udges, rather than juries, are responsible for determining the meaning of the words in patent claims.” *Markman et. Al., v. Westview Instruments, Inc., et. al.*, 517 U.S. 370 (1996). “As it cannot be expected, however, that judges will always possess the requisite knowledge of the meaning of the terms of the art or science used in letters patent, it often becomes necessary that they should avail themselves of the light furnished by experts relevant to the significance of such *words and phrases*. The judges are not, however, obliged to blindly follow such testimony.” (emphasis added), *A. Walker, Patent Laws* § 75, p. 68 (3d ed. 1895).

“A patent regularly issued, is presumed to be valid until the presumption has been overcome by convincing evidence of error.” *Radio Corporation of America et. al., v. Radio Engineering Laboratories, Inc.*, 290 U.S. 624. It is said that “the presumption of the validity of the patent is such that the defense of invention by another must be established *by the clearest proof—perhaps beyond reasonable doubt.*” (emphasis added),

Austin Machinery Co., v. Buckey Traction Ditcher Co.,
13 F (2d) 697, 700; and 35 U.S.C. § 282(a).

**A. Interpreting Software Claim
Limitations Under § 112, ¶ 6**

“Judge Rich [a principal drafter of the 1952 Patent Act, *In Re Hoist & Derrick Co.*], explained the need for according because the [US]PTO is: a qualified government agency presumed to have properly done its job, which includes one or more examiners who are assumed to have some expertise in interpreting the references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only valid patents.” (*Standard of Proof for Patent Invalidation in the U.S. and Japan*, by Yoshinari Oyama; Patent Invalidation No. 1:27).

Accordingly, pursuant to *Examination Guidelines for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications*, the United States Patent and Trademark Office explains in Federal Register, Volume 76, No. 27, that in 1. Determining Whether a Claim Limitation Invokes § 112, ¶ 6: “[t]he claim limitation is presumed to invoke § 112, ¶ 6 when it explicitly uses the phrase ‘means for’ or ‘step for’ and includes functional language. That presumption is overcome when the limitation further *includes the structure necessary to perform* the recited function. [Footnote 66: The Third District’s own precedent states *In Re] TriMed, Inc. v. Stryker Corp.*, 514 F. 3d 1256, 1259-60 (Fed. Cir. 2008) [that] (“[s]ufficient structure exists when the claim language specifies *the exact structure that performs* the function in question

without need to resort to other portions of the specification or extrinsic evidence for an adequate understanding of the structure.’)” (emphasis added).

This Court has recognized that for “[i]nventions secured by letters patent sometimes, *the claim is coextensive with the invention*. Improvements in machines [are also] protected by letters patent where all the ingredients of the invention are old, and where the invention consists entirely in a new combination of the old ingredients, whereby a new and useful result is obtained[.] **Such a combination is sufficiently described if the ingredients of which it is composed are named, their mode of operation given, and the new and useful result to be accomplished pointed out**, so that those skilled in the art and the public may know the extent and nature of the claim[.]” (emphasis added), *Seymour v. Osborne*, 78 U.S. (11 Wall) 516, 541-542 (1871).

B. The Federal Circuit’s Standard of Review for Software Patents Under § 112

In Re Teva Pharm. U.S., v. Sandoz, Inc., 574 U.S. 318 (2015), “[a]fter **considering conflicting expert evidence**, the District Court concluded that the patent claim was sufficiently definite[,] and the patent was thus valid.” (emphasis added).

Here, The Federal Circuit’s affirmance of the district court’s ruling invalidating The ’696 Patent by Rule 36, in this case, is erroneous and is in *direct conflict* with decisions of This Court, in light of *Microsoft Corp., v. i4i Limited Partnership*, 564 U.S. 91 (2011), and *Markman et. Al., v. Westview Instruments, Inc., et. Al.*, 517 U.S. 370 (1996); because the district

court: 1. Failed to follow the *Markman* Four-Factor Test, namely Step 2, *analysis of The Prosecution History*; to weigh clear and convincing declaration evidence from a POSITA, which proves enablement without undue experimentation, and further provides sworn statements proving that the statutory requirements of 35 U.S.C. § 112 was fulfilled, *See*, Pet.App.81a-93a, 2. Failed to follow the *Markman* Four-Factor Test, Step 4, *analysis of expert testimony*; by *only* weighing Respondents' expert testimony who Petitioner explained in its briefing that said expert was biased³ (Pet. App.111a, ¶1), and 3. Failing to allow Petitioner to proffer ***conflicting rebuttal expert evidence***; and thus Failing to analyze the opposing relevant supporting evidence of ***validity***—(*i.e.*, *In Re Radio Corp., of America*, the burden of proof is upon the *attacker* of validity). Pet.App.35a-38a; Pet.App.168a-169a, ¶C; ROA[49].13-14—I; and ROA[49].19. Ultimately, the district court invalidated The '696 Patent based on a thin record, and a preponderance of evidence standard, in *direct conflict* with long-standing and settled precedents of This Court; obliterating the Petitioner's right to Due Process, his 7th Amendment Right of trial by jury, and has diminished his "Patent Bargain,"

³ The Magistrate in her report and recommendation states in error: "In other words, neither side is saying not to *credit* the other side's expert because they are not a person of ordinary skill in the art." (emphasis added), DE[78].9:¶3. Petitioner did **not** retain an expert for the Markman Hearing—(*i.e.*, for *definiteness*, pursuant to 35 U.S.C. § 112), held on October 19, 2020; and **only** retained an expert to defend against the various Respondents' motions to dismiss for failure to state a claim, under 35 U.S.C. § 101, which was filed on June 27, 2019, more than one year before The Markman Hearing, in *CoolTvNetwork.com, Inc. v. Trapelo Corp.*, C.A. No. 19-535-LPS-JLH. *Id.* at DE[18-19].

Patent Law's "*quid pro quo*." *Universal Oil Prods. Co. v. Globe Oil & Refin. Co.*, 322 U.S. 471, 484 (1944).

II. Proceedings Below

A. Petitioner Invents Software That Revolutionizes Digital Advertising; Exponentially Increasing Consumer Reach, Engagement, Impressions, and Conversions to Sales

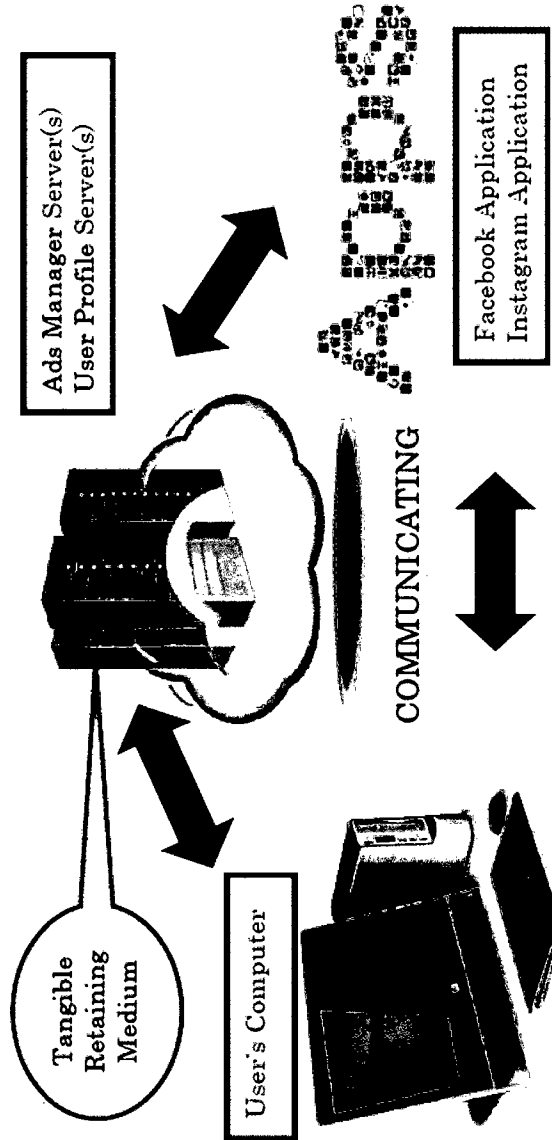
The COOLTVNetwork offer[s] *an interactive marketing/advertising tool* through *Click Video [T]echnology*, that gives corporations *a standardized and effective method for tracking 'click-through' rates (an effective alternative to banner advertisements).*" (emphasis added), Pet.App.157a-159a—1999 Business Plan, Written By The Petitioner; Pet.App.142a-145a; '696 Patent 9:37-67; and ROA[49].5.

The Respondents in this case have infringed The '696 Patent by making, using, and selling advertisements (*i.e.*, ad units) through a software **Ads Manager** or a **digital console** designed with one or more expandable graphical user interface bars—(*i.e.*, mode control bars) that are used to create (*i.e.*, program), publish, and communicate with Multifunctional Hot Spots placed on videos streaming on the Internet—(*i.e.*, utilizing the reach of a globally accessible network). For example, a "Swipe-Up-To-Shop" Hot Spot—(*i.e.*, a hyperlink) can be created with the Facebook **Ads Manager** software and then published on an Instagram or Facebook, **Stories Video Advertisement Reel** within the respective software applications, which can be executed, by a viewer *clicking* on the visual cue (*i.e.*, the "Swipe-Up-To-Shop" Hot Spot) present on the video, running in the **Stories Video Reel**, which will

direct the viewer to the specific URL of the seller's website, to complete the shopping transaction without transporting the viewer away from the Instagram or Facebook host application/video; which ultimately solves the problem of the old Internet marketing mechanism of digital *banner advertisements*. An integral part of the process is *communication* between the *mode control bar(s)* used by the programmer/advertiser to *create* the Hot Spot(s), and *select* the modes—(i.e., program the functions of the Hot Spots with the **Ads Manager** software) and the *Multifunctional Hot Spot(s)* being viewed by the user on the Internet based **Stories Video Advertisement Reel**, which is *accessed* via the respective Facebook and Instagram Applications. This *ambidextrous communication* includes various data regarding the viewer's interaction with the Hot Spot, being communicated back to the server running said software **Ads Manager**; for data analytics, target marketing, and/or storage: ROA[49].3-7; DE[50].EXB. FH0000265-266; DE[8].9-12; '696 Patent 2:4-6; 2:55-57; 3:55-58; 4:55-57; 7:9-16; Pet.App.134a-138a; and Pet.App.98a-105a.

DIAGRAM 1

See, DE[8].9-12; and ROA[49].5.



The Inventor, and Petitioner, in this case is not a Patent Assertion Entity—(i.e., P.A.E. or “patent troll”)

and is not a Non-Practicing Entity—(*i.e.*, N.P.E.). The Inventor was trained in visual arts at New World School of the Arts, in Miami, Florida; he is the winner of the 1989 Congressional Art Competition, and was honored at the Capitol in ceremonies in Washington D.C., by the late Congressman William Lehman, Actress Mrs. Sarah Jessica Parker, and Actor Mr. Robert Downey Jr.. Petitioner is an American Cancer Society Research Fellow, a Ronald E. McNair, NASA Research Fellow, and has a bachelor's degree in chemical engineering from The University of Florida. Pet.App.125a-132a; Pet.App.139a-141a, ¶1; Pet.App.164a-167a; DE[50].EXB.FH0000271; and Pet.App.141a-142a, ¶2-3.

The '696 Patented Invention—(United States Patent No: 7,162,696), discloses in painstaking detail, a roadmap of the ClickVideoShop™ Technology, and teaches those skilled in the art, *how* to make, by harnessing the knowledge of ***old hyperlinking technology***—(*i.e.*, '696 Patent 2:61-63), a ***powerful new combination***; by implementing the know-how of *hypertext links* being highlighted in an HTML format on a webpage, which act as links when *a cursor* moves over them. Pet.App.140a. A person of ordinary skill in the art can easily recreate *the powerful new combination consisting of*: a Multifunctional Hotspot Software Apparatus, with ***communicating expandable graphical user interface bars***—(*i.e.*, mode control bars) that utilize the new and unique *combination of specific modes*—(*i.e.*, shop, bid, interact, entertain, and link modes), all of which facilitate the ***Launching of a particular URL*** from a video being displayed, at a designated time interval during the playback of the video. This process is ***analogous*** to the well-known mechanism—(*i.e.*, conventional hyperlink protocol; one

of which is *known as* HTTP: Hypertext Transfer Protocol) a process well known in the creation of webpages that utilize *hypertext links*, to create what is commonly known in the industry, as an *HTML document*. ROA [103].9-11; '696 Patent 1:48-59; 2:43-63; 5:57-6:21; 6:26-7:67; and 8:1-9:26. This is done seamlessly within the main video playback window or in adjacent windows—(*i.e.*, multicast windows: *Id.* at 5:44-47; and 9:15-26), without transporting the viewer away from the host website, application, and/or video; which has been proven to exponentially increase consumer reach, engagement—(*i.e.*, by reducing viewer bounce rate), impressions—(*i.e.*, views of advertisements), and conversions to sales. Pet.App.134a-136a; Pet.App.148, ¶3-Pet.App.149a, ¶1; Pet.App.155a-156a, Section 3.4; and Pet.App.159a-163a.

B. Proceedings Before the District Court

On October 19, 2020, the Magistrate Judge held a *Markman* hearing; four days later, on October 23, 2020, the Magistrate Judge announced from the bench her report and recommendation. [DE]78. In the Magistrate's report and recommendation, the Magistrate ruled in favor of Respondents on every term and phrase that was in controversy between the parties; except for "***expandable graphical user interface bar.***" DE[80].24; and Pet.App.52a-54a. On November 9, 2020, Petitioner filed objections to the report and recommendation; itemizing its objections to the report, and to the construction of six claim terms/phrases that are ***critical*** to the correct framing of the '696 Patent. DE[81-82]. On November 23, 2020, The Respondents filed a response to Petitioner's objections. DE[86-87]. On May 20, 2021, the District Judge, issued an order adopting the Magistrate Judge's report in its entirety.

DE[89]. The District Judge states, in part: “[t]he Report correctly concluded that nothing in the specification or figures discloses an algorithm for *how* to perform the function. (See *id.* at 12-13) (citing Plaintiff’s use of functional language such as ‘*activate*’ and failure to provide corresponding algorithm explaining how to achieve activation function)”. (emphasis added), DE [89].4; and Pet.App.109a-124a. The court, in adopting the report and recommendation, **erred by *conflating*⁴ the performance of a predetermined function, that can be supplied within a mode, with the mode itself**, which is a result of a failure to analyze The Specification and Prosecution History of the patent. ROA[49].47-60. Petitioner timely filed a notice of appeal on August 2, 2021 and paid the fee. DE[101].

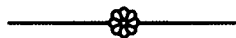
C. Proceedings Before the Federal Circuit

On August 3, 2021, Petitioner’s appeal was docketed in the Federal Circuit. ROA[1].

On November 15, 2021, Petitioner filed its’ Corrected Opening Brief (ROA[49]), and on January 28, 2022, The Respondents filed a Corrected Response Brief (ROA[64]). On March 4th and March 11th, 2022, Petitioner filed a Reply Brief and Appendix (ROA[70-71]). On July 5, 2022, both parties argued in Washington, D.C., before a three-judge panel. ROA[93]. On July 7, 2022, the three-judge panel affirmed the district court’s ruling, by Rule 36; invalidating The ’696 Software Patent for indefiniteness pursuant to 35 U.S.C.

⁴ The Magistrate made ***Clear Error*** by ruling that ***a mode was equal to a function***. See, Pet.App.34a, ¶3. A *mode*: “allows,” or “facilitates” a function as construed by the court. See, Pet. App.21a, and Pet.App.23a.

§ 112; (ROA[94]). On August 17, 2022, Petitioner filed a combined petition for rehearing and rehearing en banc requesting consideration by the full Court. *See*, ROA[103]. The combined petition was DENIED on the date of September 30, 2022. ROA[106].



REASONS FOR GRANTING THE PETITION

This Court, and Congress with the enactment and enforcement of 35 U.S.C. § 282(a), and The *Markman* Four Factor Test, realizes that the American Inventor is the cornerstone of the United States Economy. This Court, and Congress understands that patents from small entities, minorities, and women; in particular, are statistically rare anomalies that should be treated like *endangered species* in the confines of a patent monopoly system, weakened by the intrinsic thickets of a judicial process that is financially harsh on the enforcement of patent rights owned by the small inventor anomaly, who are often faced with David *versus* Goliath odds during the judicial process; including limited access to capital, and legal expertise. This Court has ratified through precedent, nationally binding rules of law that are imperative in patent litigation, with the aim of *leveling the playing field*, and infusing value into the “Patent Bargain,” America’s “*quid pro quo*.” *Bonito Boats, Inc., v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-151, 109 S. Ct. 971, 103 L. Ed. 2d 118 (1989).

In allowing the erroneous judgment of The Lower Tribunal to stand, by removing the statutory and precedential underpinnings that reinforce and bolster the

American Patent System, would undoubtedly earmark widespread adverse economic consequences that would open the flood gates to dire repercussions in the stability and foreseeability of the American Patent System; causing a downward spiral on a national level that would affect every aspect of the economy and the progress of society. Review is warranted.

I. THE DECISION OF THE THIRD DISTRICT COURT, CANNOT BE RECONCILED WITH THIS COURT'S PRESUMPTION OF VALIDITY, AND INTERPRETATION OF PATENT CLAIM RULINGS, AND THREATENS ADVERSE ECONOMIC CONSEQUENCES ON A NATIONAL LEVEL

At the nucleus of the *direct conflict* with precedents set by This Court *In Re Markman et.al., vs. Westview Instruments, Inc.*, and *Microsoft Corp., vs. i4i Limited Partnership*; is the “quick decision” motif; which is painted onto the canvas of patent litigation, under the guise of economizing judicial resources. “[M]any of the recent changes in patent law that facilitate quicker decisions do so by favoring accused infringers. One might therefore worry that the trend toward quick decisions decreases the innovation incentives provided by patent rights. [I]t can be difficult to achieve speed, low costs, and high accuracy when the underlying legal doctrines involve complex and fact-intensive questions. *See, Bone, Trade Secret Law, supra* note 46, at 279. [The decision in *Blonder-Tongue Laboratories, Inc., v. University of Illinois Foundation*, 402 U.S. 313 (1971)] exacerbates the error costs of an inaccurate decision of invalidity because the owners of those patents will not only pay their litigation expenses, ‘they also lose all future value from their patents.’ *See, Anup Malani & Jonathan S. Masur, Raising the*

Stakes in Patent Cases, 101 GEO. L.J. 637, 651 (2013).” (emphasis added), (*Quick Decisions in Patent Cases*, by Paul R. Gugliuzza (2018). “Whatever the cause, imposing the risk of litigation and mistaken invalidation on valid patents reduces the fraction of social surplus that an inventor obtains through a patent. This results in a weakening of the incentive the patent system employs to get inventors to work on the most socially valuable patents.” (*Raising The Stakes In Patent Cases*; Anup Malani & Jonathan S. Masur (2013).

A. The District Court’s Ruling Is Erroneous, and Cannot Be Reconciled.

The District Court’s ruling is erroneous and invalidates The ’696 Patent for indefiniteness, but The ’696 Patent independent Claim 1, provides *structure* within the claim:

“What is claimed is:

A Multifunctional Hot Spot apparatus comprising⁵:

at least **one hot spot defined by a communication with instructions stored on a tangible retaining medium;**

at least one of the hot spots being accessible from a globally accessible network;

⁵ “*In re KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F. 3d 1351, 1356 (Fed. Cir. 2000) ‘an indefinite article ‘a’ or ‘an’ in patent parlance carries the meaning of ‘one or more’ in open-ended claims containing the transitional phrase ‘comprising.’” (emphasis added), *See, McRO, Inc., v. Bandai Namco Games Am. Inc.*, 959 F. 3d 1091 (Fed. Cir. 2020).

means for performing at least one of a plurality of predetermined functions executed with the selection of each particular hot spot;

wherein said hot spots reside on and are accessible from a digital video or audio file;

wherein said predetermined functions are selected from ***a mode control***;

wherein the mode control comprises a plurality of modes;

wherein the plurality of modes comprise ***a shop mode, a bid mode, an interact mode, an entertainment mode, and a link mode***;

wherein a specific mode is selected by ***a user*** through an ***expandable graphical user interface bar***;

wherein said specific mode further toggles based on time stamps in said digital video or digital audio file;

wherein said hot spots are visualized by outlines, shading, or illumination or a combination of each, at a predetermined area ***on the display***;

wherein said ***Multifunctional Hot Spot apparatus*** is made to reside on and is ***executing on a computing system***;

means, defined by said instructions, for selecting and activating at least one of said predetermined functions by clicking on each particular Multifunctional Hot Spot.

(emphasis added), See, '696 Patent 9:38-67; and See, *Core Wireless Licensing v. LG Elec., Inc.*, 880 F. 3d

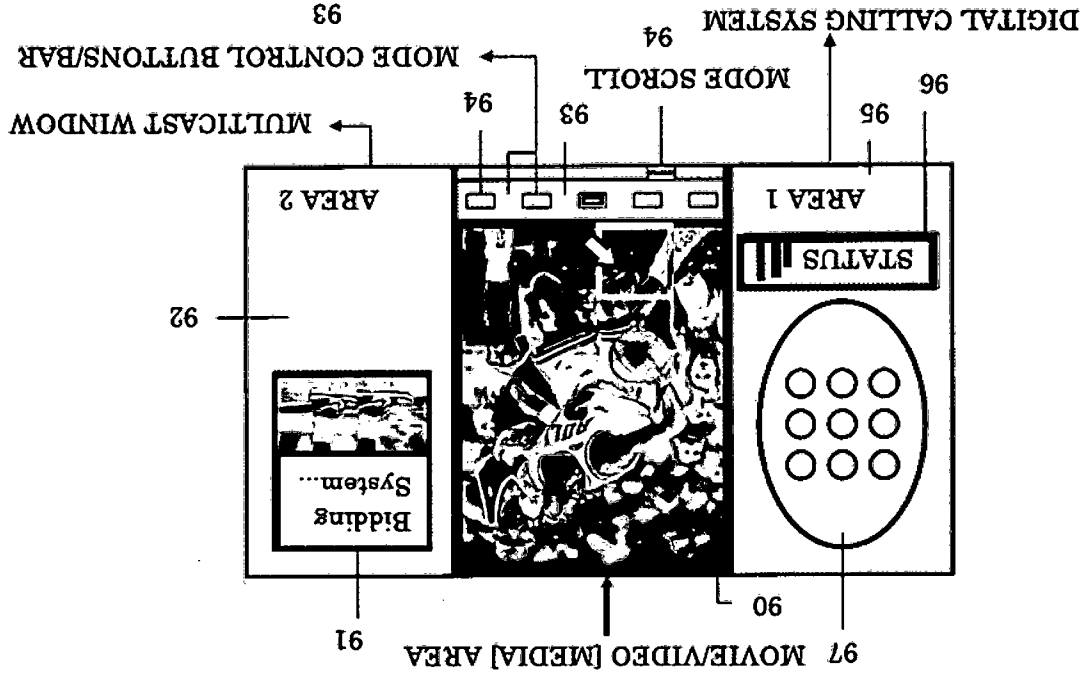
1356 (Fed. Cir. 2018), (where the independent claims of subject patents were ruled valid by The Federal Circuit, and are highly similar in structure and subject matter to The '696 Patent).

The 1999 Business Plan, written by Petitioner which forms part of The '696 *Prosecution History* states:

“3.4 Sourcing

[While watching your favorite sports video] [w]hat *if you had the opportunity to click on the Nike or Chicago Bulls logo, pause the video, and link to their respective websites, or click on Michael Jordan’s sneakers, and add it to your digital shopping cart, while caught in the awe of The Legend himself.* (emphasis added), See, Pet.App.155a, ¶3-156a, ¶1.

DIAGRAM 2
See, '696 Patent Figure 3.



Note: AREA 1, and AREA 2 above *only* opens when the respective mode is *selected* and *activated* by the viewer-user *clicking*, or by *automatic* routine. *Id.* at 8:22-28; 9:15-22; and 5:44-47.

An example, of logic and structure that can be extrapolated from The '696 Patent Specification to recreate *shop mode*, one of the predetermined modes *allowing shop functionality*, supports the means-plus-function limitation: “performing *at least one* of a plurality of predetermined functions executed with the selection of each particular hot spot” which proves the *validity* of the first (MPF) claim limitation as follows:

EXAMPLE 1:

Programmer-user programs the Hot Spot Data File (HSDF) to contain the following:

1. **Preset parameter:** Michael Jordan's Shoes an active and visible Hot Spot for *Shop Mode* during video playback from Time = (1 sec.) thru Time = (10 sec.)
2. Upon *selection* and *activation* by the viewer *Clicking*, said hot spot:
 - a. **Shop Mode, TAG 1 = *Launch*** Nike Website with native shopping cart
 - b. **Shop Mode, TAG 2 = *Add*** Michael Jordan's Shoes to shopping cart
 - c. **Shop Mode, TAG 3 = *Unpause & restart*** video; Shopping Complete Pet. App.106a-115a, ¶1.

The logic and structure of the example above can be interpolated by a POSITA, as evidenced by the declaration and prototype code in The Prosecution History—(i.e., Pet.App.81a-93a), from The '696 Patent Specification at 5:57-6:21, which exemplifies an electronic signature that identifies the viewer and the product in the video. When the viewer clicks the shoes (i.e. the Hot Spot) during the time interval when *shop mode* is active (i.e. between 1 and 10 seconds), the sequence of coded instructions, The ClickVideoShop™ Applet, **pauses** the video, **opens** the Nike website with their native shopping cart technology in the main movie window on the interface, as referenced above in Diagram 2—(i.e., *Id.* at Fig. 3), without transporting the viewer away from the original video, website, and/or application; and **adds** the Nike Shoes to the viewer's shopping cart and allows the viewer to resume the video where they left off.

The *Prosecution History* of The '696 Patent provides a high resolution detailed roadmap of *the nature* of the ClickVideoShop Invention by a detailed business plan—(i.e., Pet.App.146a-163a; and Pet.App.164a-167a), the *state of the prior art*—(The '696 Patent at 1:29-2:27—Background of The Invention; and Pet.App. 159a-161a, Video¶), the *predictability* of the art—(*Id.* at Video¶-direction of technology), and contains a working prototype example—(i.e., Pet.App.81a-93a), with software code that recreates the invention, with information provided by the Petitioner to The POSITA, in one phone call. Said POSITA, has a bachelor's degree in Electrical Engineering, and a Master's Degree in Computer Science and Engineering from highly accredited American Universities. *See*, ROA[103].15.

1. The Performing Function of the Means-Plus-Function Limitation Is Definite.

The Magistrate's report and recommendation, (Pet.App.32a-37a) which sets aside the clear and convincing standard of proof, and The *Markman* Four-Factor Test required by This Court; states:

“For example, the flow charts set forth in [sic] the figures disclose that, *depending on the mode, clicking on a hot spot will activate one of the predetermined functions*. But the claim calls for a means for performing one of the predetermined functions, not a means for determining which predetermined function to perform⁶ out of a plurality of predetermined functions. And nothing in the figures or specification describes how the claimed predetermined functions are performed. Consequently, they don't support the means for performing limitation.

While *I only need to look to the patent itself to conclude* that the *means for performing language is indefinite*, I note that *my conclusion is consistent with the declaration of Defendants' expert.*” (emphasis added).

⁶ The *Determining Step*—(i.e., the *mode identification routine*, See, '696 Patent 7:5-8.), in the sequence of coded instructions described in the '696 Patent, that is corresponding structure for The *Performance Function*—of the first means-plus-function limitation, is NOT The *Performing Step*—(i.e., the *Launching of a URL*, *Id.* at 6:7-8), as the Magistrate ruled, which is *Clear Error that the District Court used to invalidate The '696 Patent.*

**a. Sufficient Corresponding
Structure Exists in the
Specification of the '696 Patent.**

The '696 Patent has sufficient corresponding structure to support the two means-plus-functions limitations described *supra*, the flowcharts and The Specification describe a sequence of coded instructions—(*i.e.*, the instant invention “comprise source code that is convertible to executables as is known in the art.” See, '696 Patent 2:41-43) for a digital computer with a display—(*i.e.*, a Multifunctional Hot Spot Apparatus—*Id.* at 3:65-4:12; and 9:59-61.) that is executing on a computing system—(*Id.* at 2:31-41; 6:26-31; and 9:62-63.) with representative “screen displays”—(*Id.* at 6:1-4; 9:15-17; and 9:22-23), programmed to *access*, read, and reference a sequence of coded instructions in a data file at start-up called an HSDF—(*i.e.*, a *Hot Spot Data File*, which describes hot spot origin in a particular video via a start/stop time, object hot spot, or mode-button hot spot location on the display, and/or other *parameters*—coded inside a ***custom-defined object***. *Id.* at 7:24-28), which occurs when a user ***launches a web browser*** and loads a particular ***HTML Document***—(*i.e.*, web page—*Id.* at 2:48-50) that contains ***tags***⁷ that pass the *parameters* to The Click-VideoShop™ Java Applet—(*i.e.*, or ***custom plug-in***, *Id.* at 5:57-6:25, ***core corresponding structure***) that

⁷ If the Magistrate would have complied with The *Markman* Four-Factor Test, Step 3: Analysis of English Dictionaries, it would be evident that “tags”—(*i.e.*, “a key or an address that identifies a record and its storage location in another file.” See, Microsoft Computer Dictionary 5th Edition) are corresponding structure in The '696 Patent Specification that supports the two means-plus-function limitations.

performs the predetermined functions of the modes: shop, bid, interact, entertainment, and link, after the user *selects and activates* the Multifunctional Hot Spot—(i.e., *hyperlink*—*Id.* at 2:18-27) by *clicking it* with the *cursor*—(i.e., *Id.* at 3:49-53) of a mouse. *Id.* at 8:1-28.

“[I]f a claim recites a means for sitting, and chairs are described in the specification, then the ‘means’ element should be construed to cover chairs.” (emphasis added), *See, (Computer Software Patentability and the Role of Means-Plus-Function Format in Computer Software Claims;* by Lawrence Kass; *Pace Law Review*, Volume 15; Issue 3; Spring 1995; April 1995).

A simple example of *how* The '696 Patent exemplifies corresponding structure to support the two means-plus-function limitations is shown in The Specification of The '696 Patent at 5:13-14, which states: “The shop mode allows a user to click a hot spot and add items to a shopping cart.” The *how* this mode performs this function is done as described in Figure 2B, Step 242, which says, “the applet [i.e., the sequence of coded instructions written in the JAVA programming language] adds the item specified by the custom-defined object to the user’s shopping cart.” This means the video stream was already viewed by a programmer, the products that would be determined to be hot spots were identified and coded with *tags* and/or *electronic signatures* so that when a viewer-user *activates* the hot spot on the video by clicking it, when it is defined for shopping, then that particular product is automatically added to the website’s shopping cart. The viewer-user could then continue shopping for other products on the website, opened in the main or an

adjacent window to the video-frame, check-out and return to the host video, or alternatively cancel the transaction and return to the host video. Any POSITA would know how to “bridge this gap” of the corresponding structure provided by the algorithm (*Id.* at 7:21-51.) to recreate the invention. This evidence in The Specification of *how* a POSITA may recreate the invention states: “[a] data file [*i.e.*, a custom-defined object which] contains **tags** that specify various functions when a hot spot is *activated*, such as, whether the video file should only play once or play in a continuous loop; the URL of the web page or website to open when a hot spot is activated; an electronic signature that uniquely identifies a user and item(s) for adding to a shopping cart,” (emphasis added), *Id.* at 6:4-10.

The Specification also explains to a POSITA *how* the sequence of coded instructions should be configured to display the output of the **hyperlink(s)**, representative of each mode, contained in the Multifunctional Hot Spot, on the screen display when the user *selects and activates* the hot spot by *clicking it*—(*Id.* at 8:41-46.); without transporting the viewer away from the host website, application, and/or video. “[H]ot spots in the main audio and video file are initiated and open web pages, websites or other URL addresses in an adjacent browser or window or in a main playback browser/window.” *Id.* at 5:44-47. “The windows [*i.e.*, Multicast Windows adjacent to, or inside the main browser/window] only appear when the video is placed in a particular mode”. *Id.* at 9:15-17.

All of the other modes: *bid mode*, *interact mode*, *entertainment mode*, and *link mode* are performed by the **computing system** on **the display** of the computer,

in a unique configuration on the interface, that reduces the *bounce rate*, in the same manner as *shop mode*; by the *Launching of a URL* using *conventional hypertext transfer protocol*. For example, The '696 Patent states: “[w]ith reference to FIG. 1B, the software 100 determines whether the user has selected *bid mode* (112). If yes, then the software 100 *initiates* a ClickVideoBay™ in a ClickVideoHub™, which is a multicast communication interface [*i.e.*, the software *Launches the URL* of the clickvideohub.com website]” (emphasis added), *Id.* at 6:51-55. The Specification describes for a POSITA, the sections that comprise the *bid mode interface*, when the website is *Launched*. *See*, Pet.App.117a-119a. The Specification of The '696 Patent continues in painstaking detail with corresponding structure supporting the *Performance Function* of the first means-plus-function limitation of Claim 1, of *all* of the other modes. *See*, The '696 Patent 7:51-63; Pet.App.111a-112a, ¶1; Pet.App. 183a-187a, 192a-196a, 196a-198a; and *Winans v. Denmead*, 56 U.S. 330 (1853) (scope of patent not limited to literal terms).

Any POSITA at the time of the filing and prosecution of The '696 Patent would know the *activate* mechanism and process of *Launching a URL by conventional hypertext protocol*, and also know that there are different types of URLs that can be *Launched* from a hyperlink object—(*i.e.*, a hot spot). *See*, ROA [103].9; Pet.App.174a, ¶44-Pet.App.176a-¶45, 47, and 48; and *See*, Pet.App.170a, ¶ 2—*Internet Hyperlink Protocol*.

A further description of *how* a POSITA could recreate the invention is from existing hot spot knowledge in prior art referenced in the “Background of

The Invention” section of The ‘696 Patent, and the state of technology at the time the application was filed in 2000 and 2001. *Id.* at 1:29-2:27. The ‘696 Patent states: “The Multifunctional Hot Spots preferably comprise hyperlinks to other URL addresses and/or targeted databases.” *Id.* at 2:55-57. “The multifunction hot spots are preferably delineated by outlines or illumination as visual cues to alert the user that **clicking** within the ‘multifunctional hot spot area will’ give them access to additional information, files or locations. This is analogous to a hypertext link being highlighted in an HTML format when the *cursor* moves over it.” (emphasis added), *Id.* at 2:55-63.

The Federal Circuit’s precedent states that “the specification ... must teach those skilled in the art how to make and use the full scope of the claimed invention without ‘undue experimentation.’ *ALZA Corp., v. Andrx Pharm., LLC*, 603 F. 3d 935, 940 (Fed. Cir. 2010) (citing *Genentech Inc., v. Novo Nordisk A/S*, 108 F. 3d 1361, 1365 (Fed. Cir. 1997).” (emphasis added), *See, McRO, Inc., v. Bandai Namco Games Am. Inc.*, 959 F. 3d 1091 (Fed. Cir. 2020).

2. The Selecting and Activating Function of the Means-Plus-Function Limitations Is Definite

The Magistrate Judge in her report and recommendation, (*See*, Pet.App.39a, ¶5-43a), erroneously rules that “the specification does not disclose corresponding structure to perform the function,” of *select-*

ing and *activating* at least one predetermined function *by the user clicking*⁸ (See, '696 Patent 9:64-67.), on each particular Multifunctional Hot Spot. The Third District's own precedent states: "[s]ufficient structure exists when *the claim language specifies the exact structure that performs the function in question without need to resort to other portions of the specification or extrinsic evidence* for an adequate understanding of the structure." (emphasis added), See, *TriMed, Inc., v. Stryker Corp.*, 514 F. 3d 1256, 1259-60 (Fed. Cir. 2008); and See, *Altris, Inc. v. Symantec Corp.*, 318 F. 3d 1363, 1376 (Fed. Cir. 2003). The Federal Register Volume 76, No. 27, at page 7167 states that the "presumption [of § 112 ¶6] is overcome when the [claim] limitation further includes the structure necessary to perform the recited function." (emphasis added). The *M2M Solutions LLC., v. Sierra Wireless America, Inc.*, No. CV 12-30, 2015 WL 5826816 (D. Del. Oct. 2, 2015), case "illustrates how future patent applicants can try to draft around Williamson by merely including some details in the claim itself about how the function is performed, even if the structure disclosed is, as the patentee's own expert stated in *M2M*, 'simple.'" (emphasis added), See, (*Early Filing And Functional Claiming*, by Paul Gugliuzza; Boston University School of Law; (2016)).

The Magistrate states: "Plaintiff suggested [in its reply brief] that *the interface* [which contains a mode control] set forth in Figure 3 was the means for

⁸ The Magistrate *concedes* in her order that the second (MPF) limitation of Claim 1 indicates *the exact structure* that *performs the function* in question—(i.e., *selecting* and *activating*) by *clicking*; thus the presumption of § 112 ¶6 should be overcome. See, App.46a, ¶3-4.

selecting and activating, *including the buttons* [i.e., the embodiment where the mode-button is the hot spot]. Then, at the *Markman* hearing, Plaintiff's counsel represented to the Court that 'today we will show what the means for *selecting* and means for *activating* actually is. It is actually the *cursor or click* is the *means for selecting*, and the *mode control* is the *means for activating*.' I'm unpersuaded that a POSITA would understand a *mode control* and *click* to be the corresponding structure for the means for *selecting* and *activating*." (emphasis added), *See*, Pet.App.42a; and *See*, ROA[49].34-37;42-47.

The Abstract of The '696 Patent, proves Petitioner's assertion, and states: "wherein the functions are *selected* based on *user inputs* or *predetermined parameters* and are *activated* by *clicking* a predetermined hot spot."⁹ (emphasis added), *See*, Also The '696 Patent at 4:4-8; *activation* from a menu bar—(i.e., a control bar) which can be referenced by a POSITA in The Specification as "the *hot spots* may be programmed with multiple objects and/or functions that *may be activated or deactivated* through a menu bar 93 [i.e., a control bar, as referenced in Figure 3] having a plurality of modes and *means for activating same, such as control buttons* 94 that define the hot spot(s) with a *predetermined function in response to successful user interaction with the buttons* 94 in accordance with the invention." (emphasis added), *Id.* at 4:49-55. The '696 Patent draws a roadmap in painstaking detail for a POSITA of *how* a hot spot is activated stating: "[a] multifunctional hot spot is activated

⁹ The *algorithm*, supporting structure, and functionality for the second MPF Limitation of Claim 1 was revealed, noted, but not weighed by the court. *See*, App.55a, ¶3-56a, ¶1.

when a user moves the *cursor* into the designated area at a point in time within the time-stamped interval in which the hot spot is specified to be active for a certain activity.” (emphasis added), *Id.* at 3:50-65, and Pet. App.181a-183a, 183a-187a, 187a-192a, 192a-194a, and 198a-200a.

3. Both Means-Plus-Function Limitations are *Coextensive* With the Structure of a General-Purpose Computer

In summary, any POSITA would know that any general-purpose computer with an Internet connection and any *web browser* can *Launch a URL*, by a user *clicking* the hyperlink that contains the URL, to satisfy *The Performing Function*. The function of Launching a URL (*i.e., performing* a function of a mode, as defined by The '696 Patent) is *coextensive* with the corresponding structure *analogous* to a general-purpose computer *accessing* an HTML document loaded by any *web browser*. See, The '696 Patent 2:55-63.

Further, any POSITA would know that *a cursor* is corresponding structure indicative of a mouse used on a computer as a pointing device for *selecting* and *activating* by *clicking; any mouse can perform “clicking” without any special programming.* See, ROA[103].6-15.

“Claim construction is a legal question that may involve underlying factual findings.” See, *Teva Pharms. USA, Inc., v. Sandoz, Inc.*, 574 U.S. 318, 331-32, 135 S. Ct. 831, 190 L. Ed. 2d 719 (2015). This Court *In Re Nautilus II*, 134 S. Ct. at 2124, and rulings by The

Federal Circuit, from various District Courts, including the Third District Court, has ruled that: “a patent is invalid for indefiniteness [*only*] if its claims, read in light of The Specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” An “artisan’s knowledge of the prior art and routine experimentation can often fill gaps, interpolate between embodiments, and perhaps even extrapolate beyond the disclosed embodiments, depending upon the predictability of the art,” *See, AK Steel*, 344 F. 3d at 1244, and a “patent need not teach, and preferably omits, what is well known in the art,” *Spectra-Physics, Inc., v. Coherent, Inc.*, 827 F. 2d 1524, 1534 (Fed. Cir. 1987). “[The] Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in *re Forman*. They include (1.) the quantity of experimentation necessary, (2.) the amount of direction or guidance presented, (3.) the presence or absence of working examples, (4.) the 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.” (emphasis added), *In Re Wands*, 858 F. 2d 731 (Fed. Cir. 1988); and *Nautilus, Inc., v. Biosig Instruments, Inc.*, 572 U.S. 2124 (2014).

4. A Devastating Result, Looms in the Lower Tribunal’s Error in Judgment

The real-world implications of the Third District Court failing to follow the supervisory guidelines set by This Court *In Re Markman et. Al., v. Westview Instruments, Inc., et. al.*, 517 U.S. 370 (1996), and *Microsoft Corp., v. i4i Limited Partnership.*, 564 U.S.

91 (2011); and the affirmance of such an erroneous decision by The Federal Circuit, is devastating. This Court, and Congress has created the *Presumption of Validity*, and the *Markman Four-Factor Test* as pillars to support the structure of economic growth, and national security in America to foster innovation and manufacturing in The United States to expand domestic production of leading technology, R&D, and to create good-paying manufacturing jobs. If a patented technology like The '696 Patent, from an individual inventor, the *cornerstone* of the American Patent System and Economy, with such considerable reach, and projected economic damages based on the asserted infringement; can be so easily invalidated, it would create a domino-effect that would undoubtedly earmark the eminent collapse of our patent system. This is a serious national issue that destroys the inventing community. This case is the *ideal-vehicle* to exercise This Court's supervisory powers once again; to reverse the process and the systemic erosion of the patent system based on the "quick decision" motif, and implement new guidelines for assisting individual and small inventors, enforce their patent rights in Federal District Court, similar and parallel to the new provisions, included in The CHIPS Act, also being set by Congress to protect the integrity and stability of Innovation in America.

"The CHIPS and Science Act (P.L. 117-167) [will implement \$50 billion to establish and expand domestic production of leading-edge semiconductors in the US, of which the US currently makes 0% and] directs a number of federal agencies and departments to create regional innovation hubs and programs to spur devel-

opment in under-resourced regions. H.R. 8697, introduced during the 117th Congress, would direct [The] USPTO to establish a satellite office in the Southeast region and increase outreach to underrepresented groups to increase their participation in the patent system.” (*Equity in Innovation: Trends in U.S. Patenting and Inventor Diversity*; November 30, 2022: Congressional Research Service).

How well will our Country’s capital be invested, if these same underrepresented groups are unable to enforce their patent rights, after obtaining patents under such dire odds, and financial circumstances?

Such an erroneous judgment of The Federal Circuit and The Third District Court creates a manifest injustice that obliterates an Inventor’s right to Due Process, their 7th Amendment Rights ordained by the Constitution of The United States, and systematically erodes the “Patent Bargain.”



CONCLUSION

This Petition should be granted, the judgment should be vacated, and a summary reversal should be ordered in light of *Microsoft Corp., v. i4i Limited Partnership*, 564 U.S. 91 (2011).

Respectfully submitted,

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