

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

PROFECTUS TECHNOLOGY LLC,

Plaintiff,

v.

GOOGLE LLC,

Defendant.

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CIVIL ACTION NO. 6:20-cv-00101-ADA

JURY TRIAL DEMANDED

**DEFENDANT GOOGLE LLC'S MOTION FOR SUMMARY JUDGMENT
OF SUBJECT MATTER INELIGIBILITY UNDER 35 U.S.C. § 101**

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Defendant Google LLC (“Google”) moves for summary judgment that the asserted claims of U.S. Patent 6,975,308 (“’308 Patent”) are directed to ineligible subject matter under 35 U.S.C. § 101 and *Alice*.

I. INTRODUCTION

The ’308 Patent is directed to a digital picture frame capable of downloading, storing, and displaying digital images, but the patent does not claim any improved digital display screen, frame, memory, control circuitry, or other computer component. Instead, the patent merely invokes well-known, generic, and conventional components, and it admits that its alleged invention is meant to “replace a ***conventional*** picture frame.” Indeed, a named inventor of the ’308 Patent confirmed that the alleged invention is comprised of “off-the-shelf” components, including an “off-the-shelf” interface, microprocessor, memory, control circuitry, light sensor, motion sensor, clock, speaker, and microphone. Google’s expert, Dr. Andrew Cockburn, provided a detailed report, supported by more than ample evidence, explaining that the elements of the ’308 Patent claims were well-known, routine, and conventional at the time of the alleged invention, and ***Profectus’s expert offered no rebuttal or evidence to the contrary***. Applying the two-step test for eligibility set forth in *Alice Corporation Pty. Ltd. v. CLS Bank International*, 573 U.S. 208 (2014), claims of the type recited by the ’308 Patent have routinely been found ineligible under 35 U.S.C. § 101 and that analysis should give rise to the same result here.

At *Alice* step one, the ’308 Patent’s claims are directed to the abstract idea of displaying photos in response to an event. Claims directed to the display, capture, and/or organization of photos have been found to be abstract in numerous other cases. And the ’308 Patent merely provides a generic and conventional environment to carry out this abstract idea.

At *Alice* step two, the claims do not disclose any technical solution or inventive concept

as they recite only well-known components performing routine functions and arranged in a conventional way. There is no technological advance or inventive solution in a digital picture frame that can download, store, and display digital images. Such digital picture frames were known and sold as consumer products by the time of the '308 Patent. Likewise, the idea of turning the display on or changing the image to a different one in response to an event, such as a change in ambient light or sound, is not inventive. Indeed, Profectus's expert admitted that this abstract idea was "well known" and that the state of the art for digital picture frames before the alleged invention had already addressed the core deficiencies the '308 Patent purports to solve. Accordingly, the '308 Patent is invalid as directed to patent ineligible subject matter under § 101.

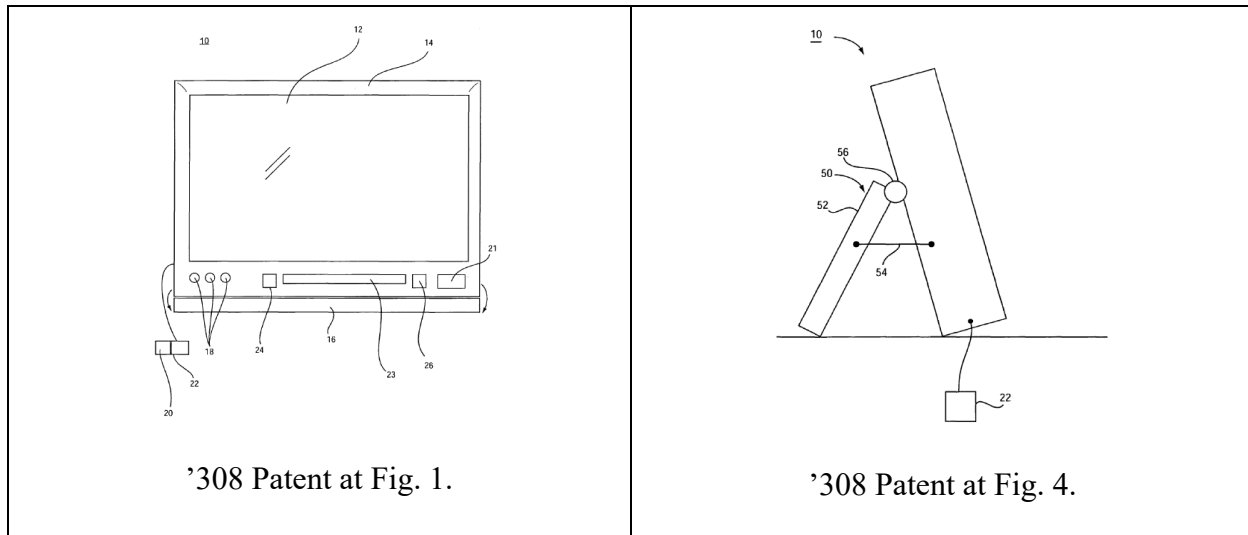
II. STATEMENT OF UNDISPUTED MATERIAL FACTS

A. Summary Of U.S. Patent No. 6,975,308 ("308 Patent")

1. The '308 Patent is titled "Digital Picture Display Frame," was filed on February 11, 2000, and claims priority to U.S. Provisional Patent No. 60/131,920, filed on April 30, 1999.¹ Ex. 1 at Cover.

2. The alleged invention is a "wall mounted or table top picture frame[] for displaying digital images." *Id.* at 1:14-16. Figures 1 and 4, reproduced below, show a front and side view of the alleged invention.

¹ The parties dispute whether the '308 Patent's claims are entitled to claim priority to the April 30, 1999 filing date of the provisional application. Google has submitted a separate motion for summary judgment on this issue. This dispute does not impact the present motion since the claims are directed to patent ineligible subject matter regardless of the filing date to which they are entitled.



3. The specification identifies alleged deficiencies in existing methods of viewing photographs. It states that special printers used to print digital photographs are expensive and do not produce photographs with sufficient detail or resolution. *Id.* at 1:28-32. Further, the specification states that storing digital images on a computer is “not suitable for every day [*sic*] use since the image must be retrieved from memory and displayed on the computer display.” *Id.* at 1:23-26. Conventional photographs, on the other hand, require a wait period before the photographs are developed and use harsh chemicals that may be environmentally unsafe. *Id.* at 33-38. And instant cameras produce images that are not as good as conventional photographs and require expensive film. *Id.* at 1:39-41.

4. To address these alleged deficiencies, the '308 Patent's purported solution is simply a “digital picture frame” that can “download[] digital images from a computer or digital camera” and store and display the digital images. *Id.* at 1:42-48.

5. The patent does not claim any technological improvement to a digital display, memory, processor, or control circuitry. Nor does it claim an improved operating system, microprocessor, sound sensor, motion sensor, or any other computer component. Instead, the specification admits that the alleged invention comprises well-known, generic, and conventional

components, including “**any other known** display” (*id.* at 3:67-4:2); a “**commercially available** operating system” (*id.* at 7:33-34); a “**conventional** microprocessor, such as those employed in higher end personal digital assistants (PDAs)” (*id.* at 7:9-11); “a solar cell **or other light sensitive element**” (*id.* at 6:41-42); and “[m]otion sensor devices 106 [that] are **known in the art**” (*id.* at 6:37-39).²

6. The specification further admits that the alleged invention is meant “to replace a **conventional** picture frame” and “permits a user to display digital photographs on a wall or a desktop as though the image were a **conventional** photograph.” *Id.* at 2:7-8, 3:50-53.

7. Profectus asserts the following claims in this case, with non-asserted base claims identified in square brackets and independent claims underlined: 1, 4, [8,] 9, [10,] 11, 22, [29,] 30.

8. Asserted independent Claim 22 recites:

A stand alone and mountable picture display for displaying still digital pictures, comprising:

[a] a wall mountable or desk top mountable picture frame adapted to digitally display at least one still image thereon;

[b] the picture frame being a stand alone unit including:

[c] a display screen for displaying the at least one still image stored in a memory;

[d] the memory for storing the at least one still image;

[e] a microprocessor coupled to the memory for managing display data for the at least one still image;

[f] control circuitry coupled to the microprocessor for one of automatically activating the display screen in accordance with an event and automatically changing an image displayed in accordance with the event;

[g] a speaker coupled to the control circuitry for providing sounds stored in the memory in accordance with the event;

[h] wherein the event includes a sound detected in proximity of the display;

[i] an interface coupled to the memory for downloading still images to the memory;

[j] and a power adapter for receiving a plug for a power source.

9. Asserted independent Claim 1 and independent Claim 29, on which asserted Claim

² All emphasis is added unless otherwise noted.

30 depends,³ similarly recite “[a] stand alone and mountable picture display for displaying still digital pictures” comprising a subset of the elements recited in Claim 22, and additionally recite “a change in light intensity” as an additional possible event. *See* Appendix A (Asserted Claims).

10. The asserted dependent claims are excerpted below, with any non-asserted base claims identified in square brackets.

Claim 4: The display as recited in claim 1, wherein the interface is adapted to receive image data from a digital camera, a VCR, a computer or the Internet.

[Claim 8: The display as recited in claim 1, further comprising an operating system stored in the memory for permitting a user to interact with the picture frame.]

Claim 9: The display as recited in claim 8, wherein the operating system stored in the memory permits the user to select from a plurality of images stored therein to display on the screen.

[Claim 10: The display as recited in claim 1, further comprising a speaker for providing sounds stored in the memory in accordance with an event.]

Claim 11: The display as recited in claim 10, wherein the event includes one of a predetermined time or date, a change in light intensity, a sound and motion detected in proximity of the display.

Claim 30: The display as recited in claim 29, wherein the event includes motion detected in the proximity of the device.

B. State Of The Known Art

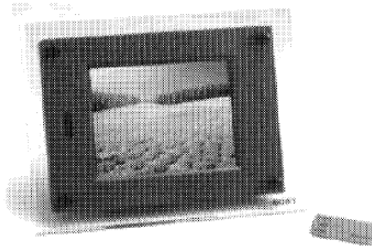
11. Digital picture frames were well-known before the application for the '308 Patent. For example, U.S. Patent No. 4,754,271 to Edwards (“Edwards”), which was filed in March 1987 (*more than 12 years* before the earliest claimed priority date of the '308 Patent), is titled “Liquid Crystal Photograph” and discloses a device that stored digital pictures in the device’s “self-contained programmed digital memory cartridge” and displayed those pictures on a “liquid crystal screen.” Ex. 2 at Abstract. “The picture itself which is to be displayed on the liquid crystal display

³ Claim 29 is not itself asserted but Claim 30, which depends on Claim 29, is asserted. This motion, therefore, addresses independent Claims 1, 22, and [29].

(LCD) originates from a digitally encoded picture frame.” *Id.* at 2:41-43.

12. Similarly, U.S. Patent Application No. 09/195,355 (“Kodak Patent Application”), which was filed in November 1998, is titled “Digital Media Frame” and discloses a “digital media frame” for “displaying digital pictures.” Ex. 3 at 5:3-4. The digital media frame displays “at least one digital image” and “is capable of receiving image data from various external input devices, such as, digital cameras, video cameras, computers, telephone lines, television cables, and Internet servers.” *Id.* at 5:11-14.

13. Digital picture frames were not only well-known, they were sold as consumer products by the time the application for the ’308 Patent was filed. For example, the Sony PHD-A55 Digital Photo Frame (“Sony Photo Frame”) was a “digital photo frame” that could display “digital images” recorded on a memory stick. Ex. 4 at SONY_0000003. It was announced in a Sony press release on February 18, 1999 and sold to the public in the U.S. beginning on April 1, 1999. *See* Ex. 5; Ex. 4; Ex. 6 at 85:2-88:8.



Id.

14. Profectus’s technical expert, Dr. Mitchell Thornton, confirmed that “a mountable picture frame adapted to digitally display at least one still image” existed before 1999. *See* Ex. 7 at 83:15-25. Dr. Thornton also testified that known digital picture frames, such as the Sony Photo Frame, already addressed the core alleged deficiencies that the ’308 Patent purported to solve because they: (1) provided a means to view digital images consistent with conventional film-based

photographs; (2) provided a means to display digital images without the need for special printers; (3) reduced wait-time because a user did not need to wait for conventional film to develop; and (4) avoided using harsh, environmentally unsafe chemicals required to develop conventional film. *See id.* at 91:8-92:7; *see also* Ex. 8 ¶ 90.

15. Jim Bitetto, one of the named inventors of the '308 Patent and the designated Rule 30(b)(6) witness concerning the conception of the claimed invention, confirmed that he did not invent a digital display, LCD display, display with digital images, digital camera, light sensor, speaker, microphone, microprocessor, memory, interface, control circuitry, disc drive, CD/DVD drive, operating system, and power supply. Ex. 9 at 144:25-146:1, 146:19-21, 147:1-2, 147:21-24, 148:6-7, 148:11-13, 157:23-158:11.

16. Jim Bitetto also confirmed that the alleged invention could be made from “off-the-shelf” components, including an “off-the-shelf” light sensor, motion sensor, clock, speaker, microphone, microprocessor, memory, interface, and control circuitry. *Id.* at 146:8-147:6, 148:2-10, 150:16-18, 152:2-18.

III. STATEMENT OF DISPUTED ISSUE TO BE DECIDED

Whether claims 1, 4, 9, 11, 22, and 30 of the '308 Patent (“Asserted Claims”) are invalid as directed to patent-ineligible subject matter under 35 U.S.C. § 101.

IV. LEGAL STANDARD

The Supreme Court has established a two-step framework for determining when a claim is invalid under § 101. The court must first determine whether a claim is “directed to” a patent-ineligible abstract idea. *Alice*, 573 U.S. at 217. If a claim is directed to an abstract idea, the court moves to step two where the court considers the elements of each claim individually and “as an ordered combination” to determine whether the additional elements “transform the nature

of the claim” into a patent-eligible application. *Id.* Patent eligibility under § 101 is an issue of law. While that legal determination in *Alice* step two “may contain underlying factual issues,” where, as here, there are **no** material factual disputes, summary judgment should be granted. *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 967 F.3d 1285, 1299 (Fed. Cir. 2020) (finding “no dispute of any material fact” and granting summary judgment that the asserted claims are not patent eligible). Summary judgment should be granted “if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a).

V. ARGUMENT

A. *Alice* Step One: The Asserted Claims Are Directed To An Abstract Idea

1. The Asserted Claims Are Directed To The Abstract Idea Of Displaying Photos In Response To An Event

At *Alice* step one, the claims are considered in their entirety to ascertain whether their “character as a whole” is directed to excluded subject matter. *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015). Here, the claims and the specification demonstrate that the Asserted Claims are all directed to the abstract idea of displaying photos in response to an event, such as sound (*e.g.*, a voice). This is a human activity that has been done manually for decades, for example, as parents have eagerly pulled out their wallet to share photos of their kids upon a voice request.

Each asserted independent claim begins with the preamble “[a] picture display ***for displaying still digital pictures***” and recites conventional components of a digital picture frame. Included among these components is “control circuitry” for “automatically changing an image of the display screen” (Claims 22, [29]) or “automatically activating the display screen” (Claims 1, 22) “***in accordance with an event***” (all Asserted Claims), where the event can include “a sound

detected in proximity of the display” (all Asserted Claims) or “a change in light intensity” (Claims 1, [29]). Thus, the “character” of the claims as a whole is directed to the abstract idea of displaying photos in response to an event, such as a detected sound or change in light. The claims do not claim any improved computer technology but instead focus on “a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335-36 (Fed. Cir. 2016).

The specification confirms the claims’ core, abstract idea and demonstrates the relationship to the analogous, conventional manual process of showing photos based on voice requests. It explains that the digital picture display has “control circuitry” that can “change an image displayed” or “activat[e] the display” “in accordance with an event.” Ex. 1 at 2:15-17, 20-21. “The event may include one of a predetermined time or date, a change in light intensity, a sound and motion detected in proximity of the display.” *Id.* at 2:17-20. It further gives an example of a detected sound and explains that “[t]he images may be changed by hitting a button on the interface panel, **voice activation** through speaker/microphone 128 (FIG. 5), or a remote signal (similar to a remote control for a television set.” *Id.* at 6:2-6. The patent does not disclose an improved digital display, frame, memory, control circuitry, or any other computer component. Instead, as discussed in Section V.B.1 below, the patent merely invokes off-the-shelf, generic, and conventional components. Indeed, the core of the invention is disclosed as a collection of black boxes representing well-known components interconnected in a conventional manner. *Id.* at Fig. 5. Thus, according to the patent’s own description, its claims are directed to something that has long been performed manually and the claimed components merely provide a generic computer environment to carry out the abstract idea.

2. Claims Directed To Displaying Digital Photos Have Regularly Been Found Abstract

Courts have repeatedly found claims directed to downloading, storing, and displaying digital photos to be abstract. For example, in *CertusView Techs., LLC v. S & N Locating Servs., LLC*, the court found that claims reciting (1) ***electronically receiving photographic image data***; (2) ***displaying the image on a display device***; (3) adding a digital mark to the image; and (4) electronically transmitting and/or storing non-image data to be abstract. 111 F. Supp. 3d 688, 709 (E.D. Va. 2015), *aff'd*, 695 F. App'x 574 (Fed. Cir. 2017). The *CertusView* court found the asserted claims “embrace the abstract process of ***taking input information, in the form of an image; displaying it***; adding additional information to it— . . . and storing such information in a computer readable file.” *Id.*

Similarly, here, the Asserted Claims are all directed to a “display for ***displaying still digital pictures***” that “download[s] still images to the memory.” ’308 Patent at Claims 1, 22, 29. While the claims in the ’308 Patent display the images in response to an event, this does not render the subject matter non-abstract. Indeed, the claims in *CertusView* involved far more, including, for example, “adding . . . representation of [a] physical locate mark” to the images, and “generat[ing] a searchable electronic record.” *CertusView Techs.*, 111 F. Supp. 3d at 695.

Numerous other decisions have found ineligible similar patents directed to the display or manipulation of digital photos, without disclosing a technological improvement:

- In *Yu v. Apple Inc.*, the Federal Circuit found that claims reciting “[a]n improved digital camera” with circuitry, memory, and digital image processor for producing an “enhanced” digital image to be directed to the “abstract idea of taking two pictures (which may be at different exposures) and using one to enhance the other in some way.” 1 F.4th 1040, 1042-45 (Fed. Cir. 2021). The Federal Circuit further found that the claims recited only well-known and conventional components (e.g., image sensors, lenses, circuitry, memory, and digital image processor) that merely served as “a conduit for the abstract idea.” *Id.* at 1043-45.

- In *In re TLI Commc'ns LLC Pat. Litig.*, the Federal Circuit found that claims for taking digital images using a telephone, storing the images, and transmitting the images to a server that receives the images were directed to the “abstract idea of classifying and storing photographs in an organized manner.” 823 F.3d 607, 610, 613 (Fed. Cir. 2016).
- In *Intellectual Ventures I LLC v. Manufacturers & Traders Tr. Co.*, the court found that claims reciting a method, system, and apparatus for “automatically organizing digital images” by obtaining hard copy prints from a plurality of different sources, digitally scanning the hard copy prints to create digital image files, and automatically grouping and storing the digital image files to be directed to the “abstract” and “known” idea of organizing images in a photo album or photo storage. 76 F. Supp. 3d 536, 549-50 (D. Del. 2014).

B. Alice Step Two: The Asserted Claims Do Not Disclose An Inventive Concept

1. The Patent Specification, Admissions Of The Inventor, And Testimony Of Both Side's Experts Clearly Establish That The Asserted Claims Recite No Inventive Concept

As the Supreme Court established in *Alice*, applying an abstract idea to “purely functional and generic” computers fails to add an inventive concept. 573 U.S. at 226. Yet that is exactly what the Asserted Claims here do. As shown in the below chart, the specification and Rule 30(b)(6) inventor testimony confirm that each component recited in the Asserted Claims was well-known, generic, and conventional. This is also demonstrated by the testimony of Google’s expert (cited below), who provides extensive support and to which Profectus has submitted *no rebuttal testimony or evidence to the contrary*.

Computer Component Recited in the Asserted Claims	Specification’s Description, Inventor Bitetto’s Testimony, and Testimony Of Google’s Expert, Dr. Cockburn
22[pre], 1[pre], [29[pre]]: “A standalone and mountable <i>picture display for displaying still digital pictures</i> , comprising:”	See 22[a] below.

Computer Component Recited in the Asserted Claims	Specification's Description, Inventor Bitetto's Testimony, and Testimony Of Google's Expert, Dr. Cockburn
<p>22[a]: "a wall mountable or desk top mountable picture frame adapted to digitally display at least one still image thereon;" <i>See also</i> 1[a], [29[a]].</p>	<p>"The picture frame is a stand-alone unit used to replace a conventional picture frame." '308 Patent at 2:8-9.</p> <p>Ex. 9 (J. Bitetto Dep. Tr. (May 27, 2021)) at 144:25-145:14 (admitting displays for displaying digital images existed before the '308 Patent).</p> <p>Ex. 10 (Cockburn Inv. Report) ¶ 1328 ("[D]igital picture frames for displaying digital pictures were well known and conventional. Indeed, several different brands of digital picture frames were already on the market by the time of the alleged invention of the '308 Patent."), ¶ 1329 ("[I]t was well-understood, routine and conventional for digital picture displays or picture frames to be standalone and mountable. For example, most digital picture frames had features for mounting the frame on a wall or table, and were standalone devices in that they operated independently.").</p>
<p>22[b], 1[b], [29[b]]: "the picture frame being a stand alone unit including;"</p>	<p><i>See</i> 22[a] above.</p>
<p>22[c], 1[c], [29[c]]: "a display screen for displaying the at least one still image stored in a memory;"</p>	<p>"Display 12 may include a liquid crystal display (LCD), a passive display, an active display or any other known display." '308 Patent at 3:67-4:2.</p> <p>Ex. 10 (Cockburn Inv. Report) ¶ 1328.</p>
<p>22[d], 1[d], [29[d]]: "the memory for storing the at least one still image;"</p>	<p>Ex. 9 (J. Bitetto Dep. Tr. (May 27, 2021)) at 148:6-10 (admitting he did not invent memory and the '308 Patent could use an "off-the-shelf memory").</p> <p>Ex. 10 (Cockburn Inv. Report) ¶ 1330 ("[I]t was well known and conventional for devices to have built-in memory").</p>

Computer Component Recited in the Asserted Claims	Specification's Description, Inventor Bitetto's Testimony, and Testimony Of Google's Expert, Dr. Cockburn
<p>22[e]: “a microprocessor coupled to the memory for managing display data for the at least one still image;”</p>	<p>“Microprocessor 124 may include a conventional microprocessor, such as those employed in higher end personal digital assistants (PDAs).” ’308 Patent at 7:9-11.</p> <p>Ex. 9 (J. Bitetto Dep. Tr. (May 27, 2021)) at 147:21-148:5 (admitting he did not invent a microprocessor and the ’308 Patent could use an “off-the-shelf microprocessor”).</p> <p>Ex. 10 (Cockburn Inv. Report) ¶ 1331 (“microprocessor[s] . . . were well-known and conventional at the time of the alleged invention”).</p>
<p>22[f]: “control circuitry coupled to the microprocessor for one of automatically activating the display screen in accordance with an event and automatically changing an image displayed in accordance with the event;” See also 1[f], [29[f]].</p>	<p>Ex. 9 (J. Bitetto Dep. Tr. (May 27, 2021)) at 151:10-152:18 (admitting he did not invent a control circuit and the ’308 Patent could use an “off-the-shelf control circuit”).</p> <p>Ex. 10 (Cockburn Inv. Report) ¶ 1331 (“control circuitry . . . were well-known and conventional at the time of the alleged invention”), ¶ 1333 (“automatically activating a display, automatically adjusting the brightness of a display, and automatically changing an image on a display based on ambient light, sound, or motion were all well-understood, routine and conventional techniques”).</p>
<p>22[g]: “a speaker coupled to the control circuitry for providing sounds stored in the memory in accordance with the event;” See also [10].</p>	<p>Ex. 9 (J. Bitetto Dep. Tr. (May 27, 2021)) at 146:19-25 (admitting he did not invent speakers and the ’308 Patent could use “off-the-shelf speakers”).</p> <p>Ex. 10 (Cockburn Inv. Report) ¶ 1332 (“[I]t was well-understood, routine and conventional for devices to include speakers for providing sounds in accordance with an event. For example by the time of the ’308 Patent, digital cameras included speakers that produced beep sounds in conjunction with events, and digital picture frames and cameras included speakers to play sounds associated with recorded movies.”).</p>

Computer Component Recited in the Asserted Claims	Specification's Description, Inventor Bitetto's Testimony, and Testimony Of Google's Expert, Dr. Cockburn
22[h]: "wherein the event includes a <i>sound detected</i> in proximity of the display; and" <i>See also</i> 1[f], [29[f]].	Ex. 9 (J. Bitetto Dep. Tr. (May 27, 2021)) at 147:1-10 (admitting he did not invent a microphone and the '308 Patent could use an " <i>off-the-shelf microphone</i> "). Ex. 10 (Cockburn Inv. Report) ¶ 1332 (" <i>sensors for detecting</i> light, motion, and <i>sound</i> were <i>well known and widely</i> used by the time of the '308 Patent").
22[i], 1[e], [29[e]]: "an <i>interface</i> coupled to the memory for downloading still images to the memory;"	Ex. 9 (J. Bitetto Dep. Tr. (May 27, 2021)) at 148:11-13, 150:16-18 (admitting he did not invent interface and the '308 Patent could use an " <i>off-the-shelf</i> " interface). <i>See also</i> 4 below.
22[j]: "a <i>power adapter</i> for receiving a plug for a power source."	"[F]rame 10 includes a plug 22 for accessing <i>standard AC power</i> . Plug 22 may include a DC transformer for converting the AC power as needed." '308 Patent at 6:52-56.
1[f]: "wherein the event includes one of a <i>change in light intensity</i> , and a sound detected in proximity of the display."	Ex. 9 (J. Bitetto Dep. Tr. (May 27, 2021)) at 146:8-11 (admitting the '308 Patent could use an " <i>off-the-shelf light sensor</i> "). Ex. 10 (Cockburn Inv. Report) ¶ 1332 (" <i>sensors for detecting light</i> , motion, and sound were <i>well known and widely</i> used by the time of the '308 Patent"). <i>See</i> 22[h] for "sound detected."

Computer Component Recited in the Asserted Claims	Specification's Description, Inventor Bitetto's Testimony, and Testimony Of Google's Expert, Dr. Cockburn
<p>4: "The display as recited in claim 1, wherein the interface is adapted to receive image data from a digital camera, a VCR, a computer or the Internet."</p>	<p>See 22[i] for "interface."</p> <p>Ex. 9 (J. Bitetto Dep. Tr. (May 27, 2021)) at 158:1-5 (admitting he did not invent a "disc drive" or "CD/DVD drive").</p> <p>Ex. 10 (Cockburn Inv. Report) ¶ 1330 ("[I]t was well known and conventional for devices to have . . . interfaces for portable memory devices, and be adapted to receive digital data, including digital image data, from a floppy disk, CD/DVD drive, and a memory card. It was also well-known and conventional to adapt an interface to receive such digital data from a digital camera, VCR, and computer, and to download digital data, including digital image data, from the Internet.").</p>
<p>9: "The display as recited in claim 8, wherein the operating system stored in the memory permits the user to select from a plurality of images stored therein to display on the screen." See also [8].</p>	<p>"Operating system 120 may include a commercially available operating system." '308 Patent at 7:33-34.</p> <p>Ex. 9 (J. Bitetto Dep. Tr. (May 27, 2021)) at 158:6-7 (admitting he did not invent "operating systems").</p> <p>Ex. 10 (Cockburn Inv. Report) ¶ 1331 ("operating system[s] were well-known and conventional at the time of the alleged invention, and use of such components to allow a user to select photos was similarly well-known, routine and conventional").</p>
<p>11: "The display as recited in claim 10, wherein the event includes one of a predetermined time or date, a change in light intensity, a sound and motion detected in proximity of the display."</p>	<p>Ex. 9 (J. Bitetto Dep. Tr. (May 27, 2021)) at 146:16-18 (admitting the '308 Patent could use an "off-the-shelf clock").</p> <p>See 1[f] for "a change in light intensity." See 22[h] for "sound." See 30 for "motion detected."</p>

Computer Component Recited in the Asserted Claims	Specification’s Description, Inventor Bitetto’s Testimony, and Testimony Of Google’s Expert, Dr. Cockburn
30: “The display as recited in claim 29, wherein the event includes <i>motion detected</i> in the proximity of the device.”	<p>“Motion sensor devices 106 <i>are known in the art</i> and can be adapted to be employed in accordance with the present invention.” ’308 Patent at 6:37-39.</p> <p>Ex. 9 (J. Bitetto Dep. Tr. (May 27, 2021)) at 146:12-15 (admitting the ’308 Patent could use an “<i>off-the-shelf motion sensor</i>”).</p> <p>Ex. 10 (Cockburn Inv. Report) ¶ 1332 (“<i>sensors for detecting</i> light, <i>motion</i>, and sound were <i>well known and widely used</i> by the time of the ’308 Patent”).</p>

That the claims require “control circuitry” configured to have certain attributes—“activating the display screen” or “changing an image displayed” “in accordance with an event”—does not transform the subject matter of the claims into a technological improvement or an inventive concept. First, as noted in the above chart, the Rule 30(b)(6) designated inventor admitted that the alleged invention could comprise “*off-the-shelf*” control circuitry. Ex. 9 at 152:2-18. And Profectus’s technical expert, Dr. Thornton, confirmed that the claimed “control circuitry” is “a recognized structure” and “may be realized with a variety of different known structures.” Ex. 8 ¶¶ 98, 101; *see also id.* ¶ 103. Indeed, Dr. Thornton explained at some length the various known structures that could be used to implement the control circuitry. *Id.* ¶¶ 98-103. Further, Dr. Thornton admitted it was “well known” to use such known “control circuitry” to display photos (*e.g.*, activate a display) in response to an event, such as a sensor input. *Id.* ¶ 100 (“*Control circuitry is well known to activate output devices, including displays, in response to the state of a sensor.*”).

Even without Dr. Thornton’s admissions, the claims here do not recite an inventive concept as a matter of law. The configuration or programming of such well-known “control circuitry” to “activat[e] the display screen” or “change an image displayed” “in accordance with an event” does

nothing more than implement the abstract idea of displaying photos in response to an event. But “[i]f a claim’s only ‘inventive concept’ is the application of an abstract idea using conventional and well-understood techniques, the claim has not been transformed into a patent-eligible application of an abstract idea.” *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1290-91 (Fed. Cir. 2018). Thus, the claimed “control circuitry” is not inventive. *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1244 (Fed. Cir. 2016) (“[a] claim that merely describes an ‘effect or result dissociated from any method by which [it] is accomplished’ is not directed to patent-eligible subject matter”); *see also In re TLI Commc’ns*, 823 F.3d at 615 (finding claims ineligible where “the recited physical components behave exactly as expected according to their ordinary use”).

Lastly, as an ordered combination, the component devices also fail to disclose an inventive concept. The ’308 Patent does not claim that any of its elements or their arrangement is inventive or novel technology. To the contrary, Figure 5 (below) shows a block diagram of the alleged invention in which the generic elements are shown connected to each other in a conventional way. *See Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (finding no inventive concept when the “claim uses a conventional ordering of steps . . . with conventional technology to achieve its desired result”). The ordered combination adds nothing “because it follows from the underlying idea” of displaying photos in response to an event. *See Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.*, 558 Fed. App’x 988, 993 (Fed. Cir. 2014).

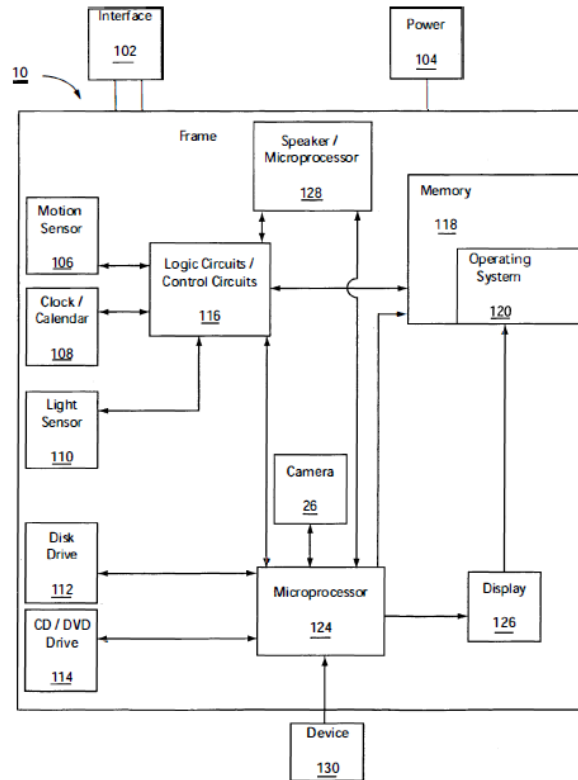


FIG. 5

Ex. 1 at Fig. 5.

The patent specification, named inventor, and Google’s expert, thus, all confirm that the claims fail to recite any inventive concept or technological improvement. Where, as here, Profectus and its expert have not (and cannot) provide affirmative evidence showing a genuine dispute of material fact, summary judgment should be granted. *Moayedi v. Compaq Computer Corp.*, 98 F. Appx. 335, 338 (5th Cir. 2004) (No “mere denial of material facts nor . . . unsworn allegations [nor] arguments and assertions in briefs or legal memoranda” will suffice to carry nonmovant’s burden).

2. Prior Art Confirms The Lack Of An Inventive Concept

As Profectus’s expert admitted, digital display frames were already “known” at the time the ’308 Patent was filed. *See* Ex. 7 at 83:15-25. For example, Edwards, which was filed *more*

than 12 years before the earliest claimed priority date of the '308 Patent, discloses a device that stores and displays digital pictures on a liquid crystal display. Ex. 2 at Abstract. Similarly, the Kodak Patent Application, which was filed in November 1998, discloses a “digital media frame” that receives and displays digital images. Ex. 3 at 5:3-4, 5:11-14. Likewise, the Sony Photo Frame was a “digital photo frame” sold in the U.S. beginning on April 1, 1999, that could display “digital images” and which—as Dr. Thornton admitted—already addressed the core alleged deficiencies the '308 Patent purports to solve. *See* Ex. 5; Ex. 4; Ex. 6 at 85:2-88:8; Ex. 7 at 91:8-92:7.

The state of the art of digital picture frames predating the '308 Patent thus confirms what is apparent from the '308 Patent itself—there is nothing inventive or unconventional about applying existing technologies (*e.g.*, existing digital displays, control circuitry, memory, and sensors) to display photos in response to an event.

VI. CONCLUSION

For the foregoing reasons, summary judgment of subject matter invalidity under § 101 should be granted for the Asserted Claims of the '308 Patent.

Dated: August 24, 2021

Respectfully submitted,

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Appendix A: Asserted Claims⁴

1. A stand alone and mountable picture display for displaying still digital pictures, comprising:	22. A stand alone and mountable picture display for displaying still digital pictures, comprising:	29. A stand alone and mountable picture display for displaying still digital pictures, comprising:
[a] a mountable picture frame adapted to digitally display at least one still image thereon;	[a] a wall mountable or desk top mountable picture frame adapted to digitally display at least one still image thereon;	[a] a mountable picture frame adapted to digitally display at least one still image thereon;
[b] the picture frame being a stand alone unit including:	[b] the picture frame being a stand alone unit including:	[b] the picture frame being a stand alone unit including:
[c] a display screen for displaying the at least one still image stored in a memory;	[c] a display screen for displaying the at least one still image stored in a memory;	[c] a display screen for displaying the at least one still image stored in a memory;
[d] the memory for storing the at least one still image;	[d] the memory for storing the at least one still image;	[d] the memory for storing the at least one still image;
[e] an interface coupled to the memory for downloading still images to the memory; and	[i] an interface coupled to the memory for downloading still images to the memory;	[e] an interface coupled to the memory for downloading still images to the memory; and
	[e] a microprocessor coupled to the memory for managing display data for the at least one still image;	
[f] control circuitry coupled to the display screen for	[f] control circuitry coupled to the microprocessor for one of	[f] control circuitry coupled to the display screen for
automatically activating the display screen in accordance with an event,	automatically activating the display screen in accordance with an event and	
	automatically changing an image displayed in accordance with the event;	automatically changing an image of the display screen in accordance with an event,
wherein the event includes one of a change in light intensity, and		wherein the event includes one of a change in light intensity, and
a sound detected in proximity of the display.	[h] wherein the event includes a sound detected in proximity of the display; and	a sound detected in proximity of the display.
[Claim 10 below]	[g] a speaker coupled to the control circuitry for providing sounds stored in the memory in accordance with the event;	

⁴ The elements of Claim 22 have been reordered to illustrate the correspondence with the other independent claims. The lettering for the limitations of Claim 22 indicates the original order.

	[j] a power adapter for receiving a plug for a power source.	
4. The display as recited in claim 1, wherein the interface is adapted to receive image data from a digital camera, a VCR, a computer or the Internet.		
[8. The display as recited in claim 1, further comprising an operating system stored in the memory for permitting a user to interact with the picture frame.] 9. The display as recited in claim 8, wherein the operating system stored in the memory permits the user to select from a plurality of images stored therein to display on the screen.		
[10. The displays as recited in claim 1, further comprising a speaker for providing sounds stored in the memory in accordance with an event.]	[See 22[g] above]	
11. The display as recited in claim 10, wherein the event includes one of a predetermined time or date, a change in light intensity, a sound and motion detected in proximity of the display.		30. The display as recited in claim 29, wherein the event includes motion detected in the proximity of the device.

CERTIFICATE OF SERVICE

Pursuant to the Federal Rules of Civil Procedure and Local Rule CV-5, I hereby certify that, on August 24, 2021, all counsel of record who have appeared in this case are being served with a copy of the foregoing via the Court's CM/ECF system.

Dated: August 24, 2021

/s/ Michael O'Donnell

Michael O'Donnell