

REDACTED VERSION OF DOCUMENT SOUGHT TO BE SEALED

1 Bradley W. Caldwell (*pro hac vice*)  
 bcaldwell@caldwellcc.com  
 2 Jason D. Cassady (*pro hac vice*)  
 jcassady@caldwellcc.com  
 3 John Austin Curry (*pro hac vice*)  
 acurry@caldwellcc.com  
 4 Warren J. McCarty, III (*pro hac vice*)  
 5 wmccarty@caldwellcc.com  
 CALDWELL CASSADY & CURRY  
 6 2101 Cedar Springs Rd., Suite 1000  
 Dallas, TX 75201  
 7 Telephone: (214) 888-4848  
 8 Facsimile: (214) 888-4849

Christopher D. Banys (SBN 230038)  
 Jennifer L. Gilbert (SBN 255820)  
 BANYS, P.C.  
 1030 Duane Avenue  
 Santa Clara, CA 95054  
 Tel: (650) 308-8505  
 Fax: (650) 353-2202  
 cdb@banyspc.com  
 jlg@banyspc.com

9 **Attorneys for Plaintiff**  
 10 **Windy City Innovations, LLC**

11 UNITED STATES DISTRICT COURT  
 12 NORTHERN DISTRICT OF CALIFORNIA  
 OAKLAND DIVISION

13 WINDY CITY INNOVATIONS, LLC,  
 14 Plaintiff,  
 15 v.  
 16 FACEBOOK, INC.,  
 17 Defendant.

Case No. 4:16-cv-01730-YGR

**PLAINTIFF WINDY CITY INNOVATIONS,  
 LLC'S RESPONSE TO FACEBOOK INC.'S  
 MOTION FOR SUMMARY JUDGMENT  
 [Dkt. 160]**

**Date:** April 2, 2019  
**Time:** 2:00 p.m.  
**Ctrm:** Courtroom 1, Fourth Floor  
**The Honorable Yvonne Gonzalez Rogers**

1 I. INTRODUCTION .....1  
 2 II. LEGAL STANDARDS FOR SUMMARY JUDGMENT .....1  
 3 III. WINDY CITY OWNS U.S. PATENT NO. 8,458,245. ....1  
 4 A. The Claimed Inventions Are Outside the Scope of the Work for Hire Agreement.....2  
 5 B. The Work for Hire Agreement Is Not a Valid, Enforceable Contract.....4  
 6 1. Dr. Marks’s Testimony Does Not Support Facebook’s Theory. ....5  
 7 2. AIS’s Actual Course of Conduct Does Not Indicate Assent. ....5  
 8 3. The Work for Hire Agreement Is Not a Present Assignment. ....6  
 9 C. AIS Had No Rights in the ’491 Patent Family to Assign in June 1995.....7  
 10 IV. THE ’245 PATENT’S CLAIMS ARE SUBJECT MATTER ELIGIBLE. ....7  
 11 A. The ’245 Patent’s Claims Are Not Abstract. ....9  
 12 B. Facebook Has Failed to Establish the Lack of an Inventive Concept.....12  
 13 V. FACEBOOK MESSENGER INFRINGES U.S. PATENT NO. 8,458,245. ....14  
 14 A. Messenger Sends Communications in Real Time. ....14  
 15 B. Messenger Clients Send and Receive Private Messages. ....15  
 16 C. Facebook Is Liable for Direct Infringement. ....17  
 17 D. Facebook Is Liable for Inducing Infringement. ....22  
 18 E. Facebook Is Liable for Contributory Infringement.....24  
 19 VI. CONCLUSION.....25  
 20  
 21  
 22  
 23  
 24  
 25  
 26  
 27  
 28

**TABLE OF AUTHORITIES****Cases**

1		
2	<b><u>Cases</u></b>	
3		
4	<i>Aatrix Software, Inc. v. Green Shades Software, Inc.</i>	
5	890 F.3d 1354 (Fed. Cir. 2018).....	13
6	<i>Abraxis v. Bioscience, Inc. v. Navinata LLC</i>	
7	625 F.3d 1365 (Fed. Cir. 2010).....	7
8	<i>Acceleration Bay LLC v. Activision Blizzard Inc.</i>	
9	324 F. Supp. 3d 470 (D. Del. 2018).....	21
10	<i>Alice Corp. Pty. v. CLS Bank Int’l</i>	
11	573 U.S. 208 (2014).....	9, 11, 12, 13
12	<i>Arachnid, Inc. v. Merit Indus.</i>	
13	939 F.2d 1574 (Fed. Cir. 1991).....	6
14	<i>Baldwin Graphic Sys., Inc. v. Siebert, Inc.</i>	
15	512 F.3d 1338 (Fed. Cir. 2008).....	16
16	<i>Bascom Glob. Internet Servs., Inc. v. AT&amp;T Mobility LLC</i>	
17	827 F.3d 1341 (Fed. Cir. 2016).....	13
18	<i>Beech Aircraft Corp. v. EDO Corp.</i>	
19	990 F.2d 1237 (Fed. Cir. 1993).....	7
20	<i>Broadcom Corp. v. Qualcomm Inc.</i>	
21	543 F.3d 683 (Fed. Cir. 2008).....	24
22	<i>Cellspin Soft, Inc. v. Fitbit, Inc.</i>	
23	316 F. Supp. 3d 1138 (N.D. Cal. 2018).....	9, 10
24	<i>Celotex Corp. v. Catrett</i>	
25	477 U.S. 317 (1986).....	1
26	<i>Centillion Data Sys., LLC v. Qwest Comms. Int’l, Inc.</i>	
27	631 F.3d 1279 (Fed. Cir. 2011).....	17, 18, 19, 20, 22
28	<i>Centrak, Inc. v. Sonitor Techs., Inc.</i>	
	No. 2017-2510, 2019 WL 612573 (Fed. Cir. Feb. 14, 2019).....	20, 21
	<i>Centrak, Inc. v. Sonitor Techs., Inc.</i>	
	No. CV 14-183-RGA, 2017 WL 3730617 (D. Del. Aug. 30, 2017).....	21

1	<i>Commil USA, LLC v. Cisco Sys., Inc.</i>	
2	135 S.Ct. 1920 (2015).....	22
3	<i>Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.</i>	
4	880 F.3d 1356 (Fed. Cir. 2018).....	11
5	<i>Data Engine Techs. LLC v. Google LLC</i>	
6	906 F.3d 999 (Fed. Cir. 2018).....	11
7	<i>DDB Techs. LLC v. MLB Advanced Media LP</i>	
8	517 F.3d 1284 (Fed. Cir. 2008).....	2, 6
9	<i>DDR Holdings, LLC v. Hotels.com, L.P.</i>	
10	773 F.3d 1245 (Fed. Cir. 2014).....	9, 11
11	<i>Embrex, Inc. v. Serv. Eng'g Corp.</i>	
12	216 F.3d 1343 (Fed. Cir. 2000).....	21
13	<i>Enfish, LLC v. Microsoft Corp.</i>	
14	822 F.3d 1327 (Fed. Cir. 2016).....	9, 10, 11
15	<i>Fantasy Sports Props., Inc. v. Sportsline.com, Inc.</i>	
16	287 F.3d 1108 (Fed. Cir. 2002).....	19
17	<i>Finjan, Inc. v. Blue Coat Sys., Inc.</i>	
18	879 F.3d 1299 (Fed. Cir. 2018).....	9
19	<i>Finjan, Inc. v. Juniper Network, Inc.</i>	
20	2018 WL 4184338 (N.D. Cal. Aug. 31, 2018) .....	12
21	<i>Finjan, Inc. v. Secure Computing Corp.</i>	
22	626 F.3d 1197, 1204 (Fed. Cir. 2010).....	25
23	<i>Fujitsu Ltd. v. Netgear Inc.</i>	
24	620 F.3d 1321 (Fed. Cir. 2010).....	22, 24, 25
25	<i>Getz v. Boeing Co.</i>	
26	No. CV-07-6396, 2008 WL 2705099 (N.D. Cal. July 8, 2008).....	5
27	<i>Global-Tech Appliances, Inc. v. SEB S.A.</i>	
28	563 U.S. 754 (2011).....	23, 24
	<i>Hodosh v. Block Drug Co.</i>	
	833 F.2d 1575 (Fed. Cir. 1987).....	25
	<i>Immersion Corp. v. Fitbit, Inc.</i>	
	313 F. Supp. 3d 1005 (N.D. Cal. 2018).....	10

1  
2 *In re CTP Innovations, LLC*  
3     No. 14-cv-3894-MJG, 2016 WL 6996738 (N.D. Cal. Nov. 30, 2016)..... 7  
4  
5 *In re Cygnus Telecomms. Tech., LLC, Patent Litig.*  
6     536 F.3d 1343 (Fed. Cir. 2008)..... 24  
7  
8 *In re Maxim Integrated Prods., Inc.*  
9     2013 WL 5777295 (W.D. Pa. 2013)..... 24  
10  
11 *Info-Hold, Inc. v. Muzak LLC*  
12     783 F.3d 1365 (Fed. Cir. 2015)..... 23  
13  
14 *Int’l Bus. Machs. Corp. v. Groupon, Inc.*  
15     289 F. Supp. 3d 596 (D. Del. 2017)..... 12  
16  
17 *IOENGINE, LLC v. PayPal Holdings, Inc.*  
18     No. CV 18-452-WCB, 2019 WL 330515 (D. Del. Jan. 25, 2019) ..... 23  
19  
20 *James v. J2 Cloud Servs., LLC*  
21     887 F.3d 1368 (Fed. Cir. 2018)..... 2  
22  
23 *Landmark Props., Inc. v. Architects Int’l-Chicago*  
24     526 N.E.2d 603 (Ill. App. Ct. 1988) ..... 5  
25  
26 *Lundin v. Egyptian Constr. Co., Inc.*  
27     331 N.E.2d 208 (Ill. App. Ct. 1975) ..... 6  
28  
*M2M Sols. LLC v. Motorola Sols., Inc.*  
   No. CV 12-33-RGA, 2016 WL 70814 (D. Del. Jan. 6, 2016) ..... 25  
  
*Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*  
   475 U.S. 574 (1986)..... 1, 6  
  
*Mayo Collaborative Servs. v. Prometheus Labs., Inc.*  
   566 U.S. 66 (2012)..... 13  
  
*Moleculon Research Corp. v. CBS, Inc.*  
   793 F.2d 1261 (Fed. Cir. 1986)..... 20  
  
*Motio, Inc. v. BSP Software LLC*  
   No. 4:12-cv-647, 2015 WL 8770356 (E.D. Tex. Dec. 15, 2015) ..... 3  
  
*N. Telecom, Inc. v. Datapoint Corp.*  
   908 F.2d 931 (Fed. Cir. 1990)..... 17  
  
*Nanosys, Inc. v. QD Vision, Inc.*

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.