

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

DIGITALDOORS, INC.,

Plaintiff,

v.

INTERNATIONAL BUSINESS MACHINES
CORPORATION,

Defendant.

Civil Action No. 2:22-CV-00457-JRG-RSP

JURY TRIAL DEMANDED

DEFENDANT'S INVALIDITY CONTENTIONS

Pursuant to Local Patent Rule 3-3 and the Court's Amended Docket Control Order (D.I. 29), International Business Machines Corporation ("IBM") hereby sets forth its Invalidity Contentions concerning U.S. Patent Nos. 7,313,825 ("the '825 Patent"), 7,322,047 ("the '047 Patent"), 7,349,987 ("the '987 Patent"), 7,552,482 ("the '482 Patent"), 7,721,344 ("the '344 Patent"), 7,958,268 ("the '268 Patent") and 8,468,244 ("the '244 Patent") (collectively, the "Asserted Patents"). Plaintiff DigitalDoors, Inc. ("DigitalDoors") has asserted claim 81 of the '825 Patent, claims 1, 2, 10, 15, 16, 19, 33, 34, 42, 47, 48, and 51 of the '047 Patent, claims 1, 6, 9, 10, 11, 15, 16, 21-23, and 27 of the '987 Patent, claims 1, 5, 25, 26, 30, and 50 of the '482 Patent, claims 1-5, 8, 16, 39-41, 43, 52, 53, 55, 79, 80, 82, 106, 107, and 113 of the '344 Patent, claims 31, 36, and 41 of the '268 Patent, and claim 1 of the '244 Patent (collectively, the "Asserted Claims"). IBM contends that each of the Asserted Claims is invalid under at least one or more of 35 U.S.C. §§ 101, 102, 103, and 112.

I. SCOPE OF THESE INVALIDITY CONTENTIONS

These Invalidity Contentions: (i) identify each prior art reference IBM is currently aware of that either anticipates or renders obvious one or more of the Asserted Claims; (ii) specify

is that of the object.”); McHugh at 733 (“Recombination is the process of forming a view of a relation at a particular security level. The recombination operation at a security level L will involve all tuples of the relation dominated by L.”).

9. Exemplary '268 Patent Obviousness Combinations

Below is a list of examples of certain combinations of prior art references that a person of ordinary skill in the art would have been motivated to combine around the time of the alleged invention of the '268 Patent. The combinations listed below are meant to provide additional clarity on motivations to combine some of the references, but is not meant to list every possible combination and is not an admission that unlisted combinations would not have been obvious to a person of ordinary skill in the art. IBM reserves the right to amend or add exemplary obviousness combinations as discovery continues and after any change in DigitalDoors' positions.

As a person of ordinary skill would have understood, the references identified above are generally in the same field of endeavor and are directed to addressing related problems. A person of ordinary skill would have been motivated and found it obvious to combine one or more of those similar references having complementary systems that address related problems. For example, the references generally relate to the field of data storage systems and contemplate the same or similar architectures and protocols for storing data in their systems. *See, e.g.,* Merenda at Fig. 1, [0007] (“In an embodiment of the invention, data entered by a consumer into a Web form is separated into related records in a public and private data set. The public records would be available without restriction for read access by a population of merchants. The private records would be available only per the indication of the consumer to the merchant in the population.”); Kohane at Abstract (“Described are a system and method for maintaining confidential records of an individual over a publicly accessible network. The system and method provide adequate confidentiality of the confidential records, mobility of individual access to the records, security of the data in the records,

combining or substituting well-known, conventional prior art elements according to known methods to yield predictable results. Some specific examples are discussed below, and further examples and discussion are provided in the attached charts for these references.

For example, a skilled artisan would have been motivated to combine one or more file storage references listed above (e.g., Merenda, Kohane, Singhal, Thuraisingham I, Bossemeyer, Thuraisingham II, Kou, Chiganti, Fujitsu SafeFile, Honeywell LDV, MITRE Inference Controller, Unisys SDDM, GPFS, Legato Networker) with each other and/or with one or more additional references (e.g., Shimada, Carpenter, Glick, Carmichael, McDonnell, Clark, Hastings, Piccionelli, Brunts, Tsumura, Grube, MacDoran, Dwyer, Chaum, Kubiawicz, Kirshenbaum, Paltenghe, Fukuda, Brown, Okano, Ozaki, Kramer, Nesamoney, Snowden, Ho, Shah, For The Record, Schoenberg, Feinberg, Wylie, Fahlman, Blarkom, Gardner, Trusted Computer, O’Flaherty, Rubin, Bax, Gifford, Blumenau, Boebert, Survey of Distributed File Systems, C4 Software, Moulton, Prihoda, Morar, PVFS, O’Hare, Ke, Baker, Cromer, Linux Kernal, Fundamentals of Database Systems, Dickinson, Turba, Abraham, Information Architecture For The Battlefield, Swift/RAID, Scrub, Datafly System, CXFS, Meijer, Momose, Beech, Seaview, Kogan, Rubinovitz, Thuraisingham, Chang, McHugh, Kang, Froscher, Stonebraker, TruData, Rabin, Garay, Efficient Dispersal) to implement securing data having one or more security sensitive words, characters, data object, or icons. As examples, the prior art recognizes the need for providing methods for securely storing and controlling access to such sensitive data. *See, e.g.,* Merenda at [0023] (“Fundamental to the implementation of the present invention is the notion that a set of data may be parsed into private and non-private elements. At the most simplistic level this might entail, for example, identifying input fields on a Web page as requiring sensitive data input such as an address, credit card or social security number, versus non-sensitive information such as the name

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Respectfully submitted,

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