

**UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WISCONSIN**

INNOVAPORT LLC,

Plaintiff,

v.

TARGET CORPORATION,

Defendant.

Case No. 3:22-CV-00425-wmc

Jury Trial Demanded

**PLAINTIFF'S MEMORANDUM IN SUPPORT OF ITS MOTION FOR PARTIAL
SUMMARY JUDGMENT**

Dated: September 28, 2023

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I. Introduction

Innovaport is a company that was founded by John Pienkos, the named inventor of the patents that are asserted in this litigation as identified in Innovaport's First Amended Complaint (Doc. 28). Generally speaking, the Asserted Patents disclose and claim systems and methods of providing product location information to a user, as well as additional information such as a suggestion relating to a different type of product or availability information relating to the product about which a user inquired.

Innovaport attempted to commercialize its technology, creating various prototypes and hiring an outside consultant to assist with pitching the technology to major retailers throughout the United States. Among other retailers, Innovaport directed these marketing efforts to Target, sending various communications to Target requesting an opportunity to present Innovaport's technology to Target. *See, e.g.*, letter and email correspondence attached as Exhibits G (Doc. 28-7) and H (Doc. 28-8) to the First Amended Complaint.

Unfortunately, Target declined Innovaport's overtures and proceeded to implement a system that incorporated Innovaport's patented technology. Innovaport subsequently brought this lawsuit for patent infringement.

II. The Innovaport Patents

Innovaport has asserted six patents in this litigation: U.S. Patents 9,990,670 ("the '670 patent"), 9,489,690 ("the '690 patent"), 8,787,933 ("the '933 patent"), 8,775,260 ("the '260 patent"), 7,231,380 ("the '380 patent"), and 7,819,315 ("the '315 patent"). The six asserted patents each claim priority to the same provisional application No. 60/158,444 filed on October 9, 1999, and the patents share a common specification.

While Innovaport has alleged that Target has infringed 55 claims across the six patents, for the sake of efficiency, Innovaport is only moving for summary judgment on a subset of those

claims directed to Target's two primary implementations of the infringing technology, namely mobile devices and kiosks. The mobile device claims at issue on summary judgment are claim 1 of the '670 patent; claim 1 of the '690 patent; claim 15 of the '260 patent.¹ The kiosk claims at issue on summary judgment are claim 7 of the '260 patent, claim 1 of the '380 patent, and claim 1 of the '315 patent (and claim 15 of the '260 patent, which covers both the mobile and kiosk embodiments).

The patents explain that the field of the claimed inventions is "an apparatus and method for providing product location information to customers (or employees or others) in stores and other retail centers." The '670 patent, 1: 14-17, Griggs Sep. 28, 2023 Decl., Ex. C. The patent further explains that in or around October of 1999, "the number and variety of different products being sold in stores has increased... Because of this huge increase in the number of available products being sold in an individual store, shopping has become a frustrating experience for many shoppers. Instead of being able to quickly find the products in stores that they are interested in purchasing, shoppers often must seek the proverbial 'needle in the haystack' when searching for desired products or else must walk through every aisle of the store in order to guarantee that they are not missing the products that they desire." *Id.*, 1:20-37. The patentee describes the invention as providing a solution to this dilemma: "it is apparent that it would be advantageous if stores had systems within the stores for providing product location information to customers (or employees or others). It would further be advantageous if these systems were easily accessed by customers and provided information in a rapid and convenient manner." *Id.*, 2:51-60.

¹ Claim 15 of the '260 patent also reads on Target's implementation of kiosks when the kiosks engage in wireless communication.

Figure 5 (reproduced below) shows exemplary steps performed by one embodiment of the invention.

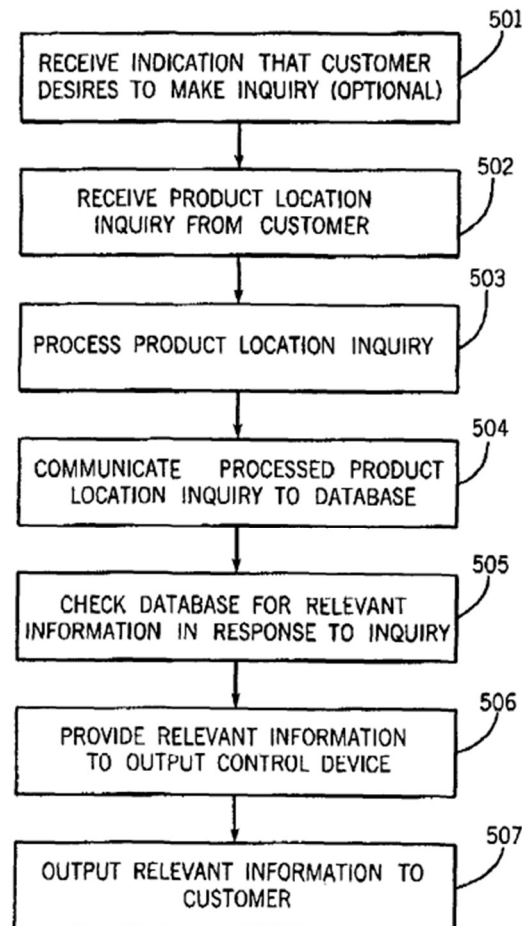


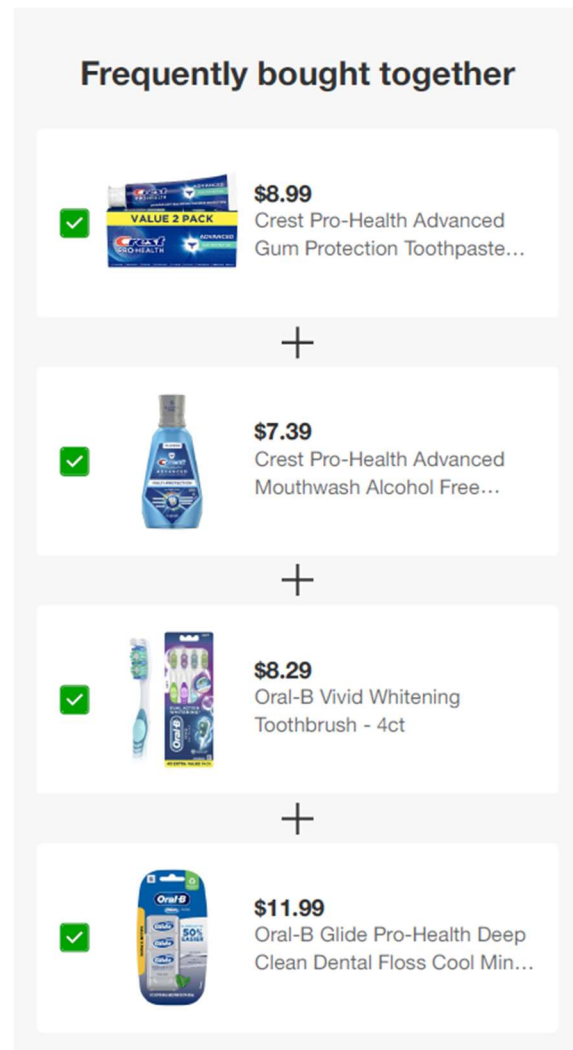
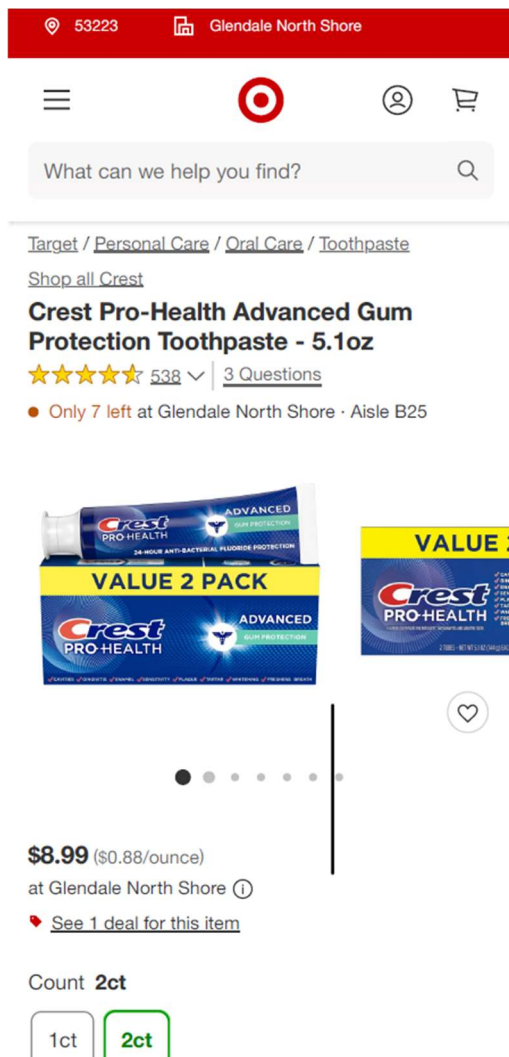
FIG. 5

In discussing the above flowchart, the specification explains many modifications and variations that can be incorporated into the implementation of the system and method described and claimed in the Asserted Patents. *See generally*, the '670 patent, 11:58-16:38. Further, the claims of the Asserted Patents specify particular implementations of the systems and methods. For example, some claims recite a device, such as an in-store kiosk, which is in a fixed location in a store. Customers may then use the device to search for products within the store. Other

claims involve the use of a mobile device that allows a user to search for the location of products within a store. The system will return at least two categories of information in response to the customer's inquiry: (i) product location information for the product about which the customer inquired; and (ii) information pertaining to a product about which the customer did not inquire.

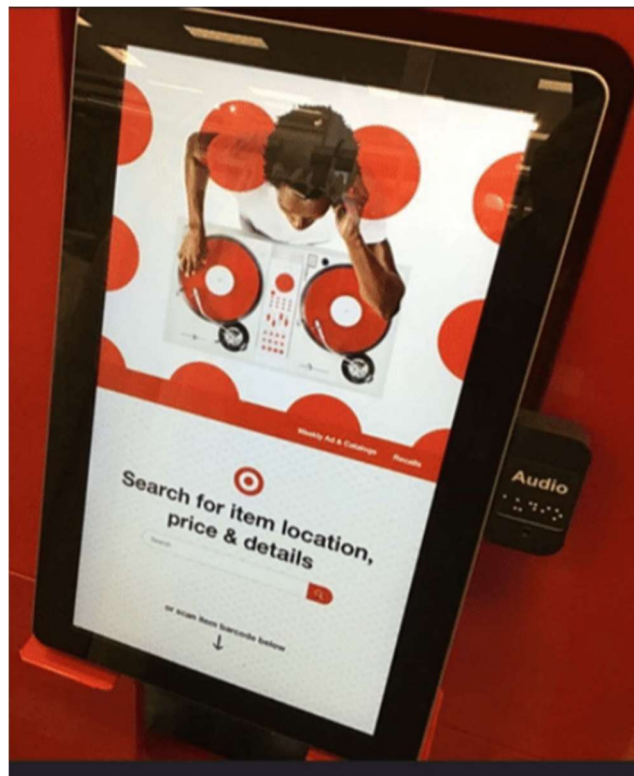
III. The Target System

Target implements a system (the "Target System") that enables a user to enter a product location inquiry and retrieve pertinent information in response. Below are screen shots that are exemplary of the mobile version of the system, which is implemented via a mobile application, a mobile website, and a traditional website. SOF 18 and 20.



As shown in the example above, in response to a search for “toothpaste,” the Target System returns product location information (Aisle B25), as well as additional information such as the price of the toothpaste (\$8.99), the quantity of toothpastes in-store (7 left), availability of the toothpaste (in Glendale North Shore), and suggestions relating to other products under the “Frequently bought together” heading (mouthwash, toothbrushes, and floss).

Target also implements this system on stationary kiosks positioned throughout its stores. SOF 41. Two exemplary images are shown below. The kiosks function the same as Target’s mobile application, mobile website, and website. SOF 19.





This section is meant to provide a general overview of the accused system. Innovaport addresses additional details of the Target System in the section on infringement below.

IV. Claim Construction

The parties have identified many terms for construction. However, Innovaport believes that only a few terms are germane to the issues of infringement and invalidity and therefore require construction by the Court. Some other claim construction issues are addressed in the infringement and validity sections below.

A. A method of providing product location information within a store (All asserted claims)

Target has taken the position that the preambles of the claims require the method to be implemented within the store. Innovaport does not believe that the preamble is limiting here, and, if the Court were to find that the preamble is limiting, it does not limit the claims to practicing the method within a store. The construction of these terms is not pertinent to the

question of liability as Target does not dispute that the Target System is used by customers when they are in a Target store. However, Dr. Turnbull asserts that use outside of a store is not infringing use based upon Target's interpretation of the claims, so Innovaport will seek claim construction of these limitations. Turnbull Infringement Report, pg. 34, ¶ 72 ("Defendant does not infringe any claim that Innovaport asserts based on activity that is not in-store, such as out-of-store use of Defendant's website and mobile application.").

The "within a store" limitations all derive from the preambles of the claims. Thus, as a threshold matter, the Court must determine whether the preambles are limiting. They are not. "In general, a preamble limits the invention if it recites essential structure or steps, or if it is 'necessary to give life, meaning, and vitality' to the claim. ... Conversely, a preamble is not limiting 'where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.'" *Shoes by Firebug LLC v. Stride Rite Children's Grp., LLC*, 962 F.3d 1362, 1367 (Fed. Cir. 2020) (quoting *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997)); *Neapco Drivelines LLC v. Am. Axle & Mfg., Inc.*, 847 F. App'x 856, 857–58 (Fed. Cir. 2021).

There is no indication in the claims, specifications, or prosecution histories of the Asserted Patents that it is necessary or essential for the customers to be within a store to practice the claimed systems or methods. See *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1378 (Fed. Cir. 2014) ("There is no suggestion that utilizing only a single field is important, essential, critical, or valuable to the present invention. There are no words of manifest exclusion. We conclude that 'message validation information' is limited to data fields within the message, but is not limited to a single data field."); see also *Neapco Drivelines*, 847 F. App'x at 858 (The

preamble of claim 11 is not limiting because the claim body defines a structurally complete invention).

Claim 1 of the '670 Patent and claim 1 of the '690 Patent each claim a structurally complete invention within the bodies of the claims and do not reference the term "store" in the bodies of those claims. Claim 15 references the term "store" in the body of the claim in two instances: "a quantity of a first product within the store" and "an availability or unavailability of the product within the store." Recitation of "the store" in the body of claim 15 is not necessary to the recited methodology. Rather, it clarifies that the information in a database pertains to products in a particular store. Thus, the preambles of the method claims should not be found limiting.

However, if the Court interprets the preamble as limiting, the term "a method of providing product location information within a store" should be given its plain and ordinary meaning: *A method of providing information regarding where a product is located within a store*. This term does not have any special meaning in the context of the Asserted Patents, nor do the Asserted Patents explicitly limit the term "a method of providing product location information within a store" to any particular embodiment or configuration. *See Kara Tech; InterDigital Commc'ns, LLC v. Int'l Trade Comm'n*, 690 F.3d 1318, 1324 (Fed. Cir. 2012) (Neither the specification nor prosecution history contain a restricted definition of the term "code," and the patentee did not disavow a broader interpretation of that term. The ordinary meaning of the term "code" therefore governs and is broad enough to cover both a spreading code and a non-spreading code.) Moreover, when the patentee wanted to claim a method of providing product location information within a store to customers who are within that store, the patentee explicitly did so. For example, claim 17 of the '260 patent (which depends from claim

15) explicitly recites “and wherein the at least one of the user interfaces provided by the mobile device *is utilized by a customer within the store.*” [emphasis added]. Thus, Target’s proposed construction relating to the preamble of claim 15 of the ‘260 patent would render the explicit limitation in the body of claim 17 redundant. *See Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (refusing to construe claim terms in a way that made other limitations meaningless); *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1288 (Fed. Cir. 2017) (“It is highly disfavored to construe terms in a way that renders them void, meaningless, or superfluous.”).²

Target’s proposed claim construction – implicitly requiring customers to be in a store – would render the explicit limitation of claim 17 of the ‘260 patent reciting “customers within the store” redundant and must therefore be rejected. *See Bicon and Wasica.* Instead, the term should be given its plain and ordinary meaning of a method of providing information regarding where a product is located within a store.

B. Information linking the product with an other product in a cross-referential manner (The ‘670 Patent: claim 1; the ‘690 Patent: claim 1; The ‘260 Patent: claim 15)

Construction of this term is important to the issue of invalidity as Target erroneously interprets the term very broadly so as to encompass providing information relating to any product in response to a location inquiry. However, the term “information linking the product with an other product in a cross-referential manner” should be given its plain and ordinary meaning in the context of the Asserted Patents and their prosecution histories, which is *data linking a*

² Additional claims recite “customers within the store” in the preamble, namely Claim 9 of the ‘260 patent and claim 1 of the ‘315 patent, further evidencing that the patentee included explicit language when intending to limit the claim in that fashion.

*product to a different type of product.*³ For example, the specification explains that “the system, in response to an inquiry regarding the location of product Y, can respond by stating ‘Product Y is located in aisle 3. Product Z, which is on sale, is also located in aisle 3.’” The ‘670 patent, 15:49-55.

During prosecution of the ‘670 patent, the patentee further clarified the limitation when distinguishing over the prior art. Specifically, the patentee stated that “rather than concerning operation in which at least one suggestion is provided regarding another product in response to the receipt of a product location inquiry concerning a specific product from a customer within a store, Berstis instead appears to concern providing location information in regards to products that ‘match’ products that were previously determined to be of interest...” Response to Office Action, Griggs Sep. 28, 2023 Decl., Ex. F, pg. 11. The patentee further stated that “the Applicant has not been able to find within Berstis any disclosure or suggestion of providing at least one suggestion *regarding any product differing from a product that was previously-determined as being of interest.*” *Id.* [emphasis added]. Thus, the patentee clarified that when the claims refer to “an other product” or “another product,” this means a different type of product than the product of interest. Accordingly, information linking the product (i.e., the product of interest) with an other product in cross-referential manner should be construed as *data linking a product to a different type of product.*

V. Applicable Law

A. Summary Judgment

Summary judgment is appropriate when, after both parties have had the opportunity to submit evidence in support of their respective positions and the court has reviewed such evidence

³ Target also asserts that the term should be given its plain and ordinary meaning, though Target does not propose its own construction. Therefore, Innovaport’s construction should be adopted.

in the light most favorable to the nonmovant, there remains no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. *Sunbeam Products, Inc. v. Homedics, Inc.*, 670 F. Supp. 2d 873, 884 (W.D. Wis. 2009), *citing* Fed. R. Civ. P. 56(c). A fact is material only if it might affect the outcome of the suit under the governing law. *Id.* Disputes over unnecessary or irrelevant facts will not preclude summary judgment. *Id.* A factual issue is genuine only if the evidence is such that a reasonable factfinder, applying the appropriate evidentiary standard of proof, could return a verdict for the nonmoving party. *Id.*, *citing* *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 254 (1986). Under Rule 56(e) it is the obligation of the nonmoving party to set forth specific facts showing that there is a genuine issue for trial. *Id.*

B. Infringement – Legal Standard

“A patent infringement analysis involves two steps: (1) claim construction and, (2) application of the properly construed claim to the accused product.” *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1323 (Fed. Cir. 2001) (citations omitted). “To find literal infringement, each limitation of the claim must be present in the accused device.” *Id.* at 1330. “[A] product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is ‘equivalence’ between the elements of the accused product or process and the claimed elements of the patented invention.” *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997). “An element in the accused product is equivalent to a claim limitation if the differences between the two are ‘insubstantial’ to one of ordinary skill in the art.” In determining whether the differences between the accused product and the claim limitation are “insubstantial,” it is axiomatic that we may determine whether the accused product performs the same function, in the same way with the same result.” *Searfoss v. Pioneer Consol. Corp.*, 374 F.3d 1142, 1150 (Fed. Cir. 2004). “In other words, two

physical components of an accused device may be viewed in combination to serve as an equivalent of one element of a claimed invention, as long as no claim limitation is thereby wholly vitiated.” *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1320 (Fed. Cir. 1998); *see also Searfoss*, 374 F.3d at 1151 (“[A] combination of physical components may serve as an equivalent to a single imitation of the claimed invention.”).

C. Obviousness – Legal Standard

Obviousness is a question of law based on underlying findings of fact. *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1361 (Fed. Cir. 2016). A patent is obvious if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *Id.* In reaching this conclusion, the court must avoid hindsight bias and must be cautious of arguments reliant upon ex post reasoning. *Id.* Though less common, in appropriate circumstances, a patent can be obvious in light of a single prior art reference if it would have been obvious to modify that reference to arrive at the patented invention. *Id.*

VI. Infringement – the mobile device claims

Innovaport has asserted many claims in this case, but, for the sake of efficiency, is only moving for summary judgment as to claim 1 of the ‘670 patent, claim 1 of the ‘690 patent, and claim 15 of the ‘260 patent, which are infringed by Target’s system when implemented using a mobile device. While Target has not admitted the presence of any of the below claim limitations in the Target System, Target’s expert, Dr. Donald Turnbull, only contests a few limitations. Dr. Turnbull’s silence as to most of the claim limitations should be construed as an admission, or waiver, by Target that those limitations are present in the Target System.

A. Claim 1 of the ‘670 Patent

- 1. [preamble] A method of providing product location information within a store, the method comprising the steps of:**

To the extent the preamble is construed as limiting, there is no dispute that the Target System is a method of providing product location or that customers use the application in the store or out of the store. Dr. Turnbull does not contest these facts.

- 2. [clause 1(a)] providing at least one information storage device including a database, wherein the at least one information storage device is configured to be at least indirectly in communication with at least one other device that includes at least one user interface, and wherein at least one of the at least one information storage device and the at least one other device with respect to which the at least one information storage device is configured to be at least indirectly in communication is or includes a mobile device;**

As explained by Mr. Greg Larson, the Senior Director of Technology at Target and Target’s 30(b)(6) witness relating to the structure and operation of the Target System, the Target System includes a component called RedSky. RedSky is a “data aggregation layer” that “integrates with Target’s back-end search platform based on the request coming from the guests when they search.” SOF 24 and 25; Stricchiola Sep. 28, 2023 Decl., pg. 3, ¶ 8.

Mr. Larson further identified various databases that are used in the Target system, i.e., that are accessed by RedSky, to provide product location information and other information to a user. For example, Mr. Larson identified the “Find It At A Target Store” system, or FIATS, which includes product location information. SOF 26 and 27; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 4, ¶ 10. Mr. Larson also identified the Core Item system that stores information that is presented in a product recommendation carousel, which presents other items a consumer may be interested in based upon a product location inquiry. SOF 31 and 32; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 4, ¶ 10.

RedSky, in combination with FIATS and Core Item, constitute “at least one information storage device including a database” as recited in the claim.⁴ Stricchiola Sep. 28, 2023 Decl., pg. 4, ¶ 9. Target’s mobile application communicates with RedSky, which constitutes “communication” between “at least one information storage device” and “a mobile device” as recited in the claim. SOF 23. No reasonable juror could find that the limitations recited in clause 1(a) of the claim are not present in the Target System.

3. [clause 1(b)] wherein the at least one information storage device includes both product location information and additional product-related information linking a product with an other product in a cross-referential manner;

As discussed above, the Target System includes a component called FIATS that stores product location information. SOF 26 and 27. The Target System further includes a component called Core Item, which is a system that stores “attributes or other information” that “links product to another.” SOF 31. Mr. Larson explained that the Target System uses product hierarchies that relate products to each other, and that the system uses these hierarchies to present a recommendations carousel to a user. SOF 28 and 29. Stricchiola Sep. 28, 2023 Decl., pg. 5, ¶ 14. An exemplary flowchart of Target’s product display page (the “PDP”) shows several different categories of product recommendations, such as “More to consider,” “Similar items,” and “Frequently bought together.” Target PDP, Griggs Sep. 28, 2023 Decl., Ex. P.

⁴ To the extent Target argues that the combination of these components does not literally infringe the claim, Target’s use of these components infringes under the doctrine of equivalents. *Ethicon*, 149 F.3d at 1320 (“In other words, two physical components of an accused device may be viewed in combination to serve as an equivalent of one element of a claimed invention, as long as no claim limitation is thereby wholly vitiated.”).



No reasonable juror could find that the limitations of clause 1(b) are not satisfied.

4. [clause 1(c)] receiving a product location inquiry signal regarding the product, the product location inquiry signal being at least indirectly based upon a product location inquiry received by way of the at least one user interface;

Mr. Larson explained during his deposition that Target's mobile application interfaces with RedSky to process inquiries. SOF 32. Thus, this limitation is satisfied when a customer makes product location inquiry via the Target mobile app (or Target mobile website) on a mobile phone, such as an iPhone or an Android phone. Signals are inherent to any computer system and are used to transmit data throughout the system. SOF 44 and 45; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 5, ¶ 17. When the Target System receives an inquiry from a user, it generates a signal that is processed by the system, e.g., by RedSky, so that the system can pull data that is responsive to the inquiry. *Id.* Dr. Turnbull does not dispute that the Target System generates a product location inquiry signal. With respect to the "user interface" limitation, all smartphones have a user interface, such as a touchscreen, through which a customer communicates with the

Target System. No reasonable juror could find that the limitations of clause 1(c) are not satisfied.

5. [clause 1(d)] processing the product location inquiry signal at a signal processing device to determine a processed product location inquiry signal;

Mr. Larson explained that RedSky “integrates with our back-end search platform based on the request coming from the guests when they search.” SOF 24. “RedSky, in turn, integrates with other back-end systems to pull the actual data.” SOF 25. Thus, via its integration with various systems to pull data to present search results to Target guests, RedSky processes the product location inquiry signal received by the customer to pull the data from the back-end systems. Stricchiola Sep. 28, 2023 Decl., pg. 6, ¶ 19. As discussed above, signals are inherent to computer systems. SOF 44 and 45. The Target System processes the product location inquiry signal to determine a processed product location inquiry signal, which RedSky uses to pull responsive data. *Id.* Dr. Turnbull does not dispute this. No reasonable juror could find that the limitations of clause 1(d) are not satisfied.

6. [clause 1(e)] querying the at least one information storage device to obtain portions of the product location information and additional product-related information in response to the processed product location inquiry signal;

As explained in the section above with respect to clause 1(d), RedSky integrates with the Target System’s “back-end search platform” to “pull the actual data” in response to an inquiry from a user. SOF 24 and 25. This satisfies the limitations recited in clause 1(e). Stricchiola Sep. 28, 2023 Decl., pg. 6, ¶ 21. No reasonable juror could find otherwise.

7. **[clause 1(f)] providing a product location information signal that is at least indirectly responsive to the processed product location inquiry signal;**

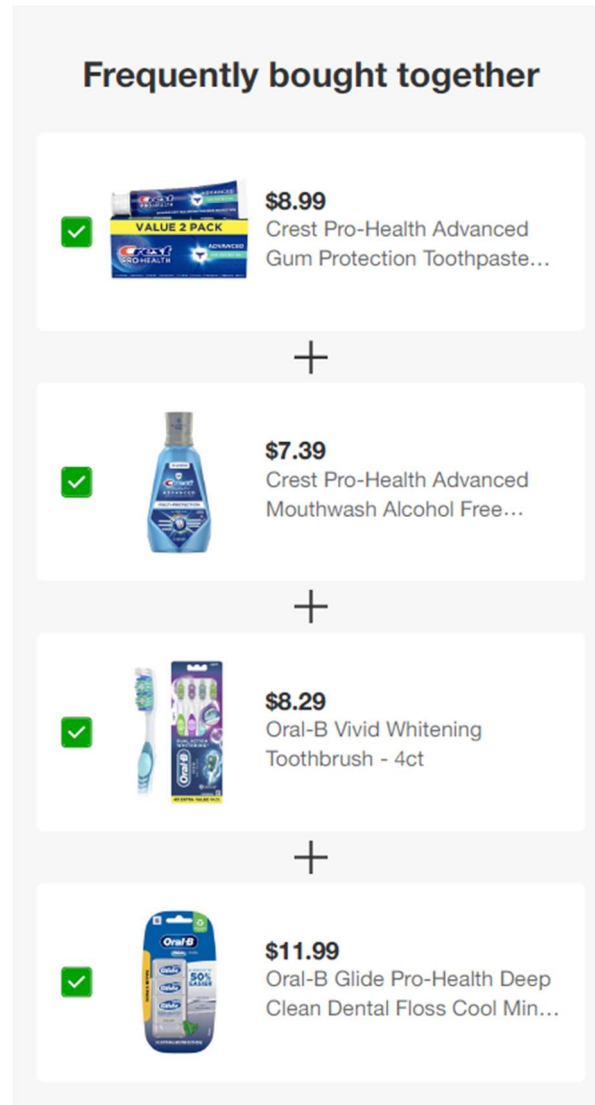
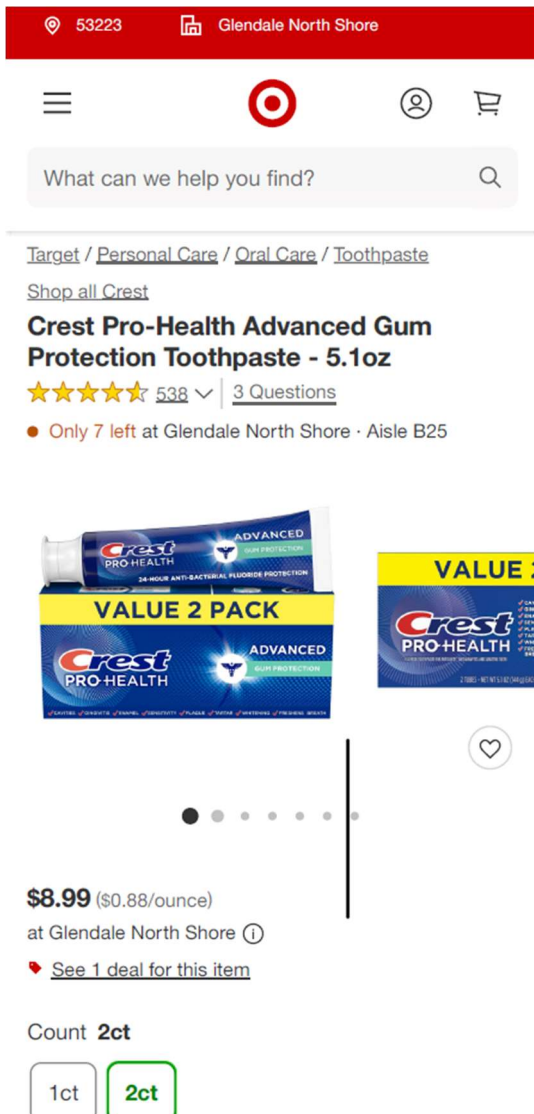
Similar to clauses 1(d) and 1 (e), RedSky processes the product location inquiry from the customer, pulls the responsive data, and returns it to the customer via the mobile application.

RedSky returns this data via a product location inquiry signal. Stricchiola Sep. 28, 2023 Decl., pg. 7, ¶ 23. This satisfies the limitations recited in clause 1(e) and is not disputed by Dr.

Turnbull. No reasonable juror could find otherwise.

8. **[clause 1(g)] wherein the product location information signal is configured to enable, at least indirectly, a providing of an output signal at an output device as a response to the product location inquiry that includes location information concerning the product and also provides at least one suggestion related to the other product.**

As shown in the exemplary images below (taken from the Target mobile website as shown on an iPhone), the Target system provides product location information (i.e., the toothpaste is located in Aisle B25) as well as suggestions, via a product recommendation carousel, relating to products for which the user did not search (i.e., mouthwash, toothbrushes, and floss). SOF 18, 19, and 20.



Mr. Larson testified at his deposition that the Target System uses product hierarchies to present a recommendations carousel, such as the “Frequently bought together” carousel shown above. SOF 28 and 29, *see also* Stricchiola Sep. 28, 2023 Decl., pg. 8, ¶ 26; *see also* Target PDP page with various product recommendations, Griggs Sep. 28, 2023 Decl., Ex. P . Further, the product location inquiry signal enables an output signal that displays the data on the screen. Stricchiola Sep. 28, 2023 Decl., pg. 7, ¶ 25. The limitations of clause 1(g) are satisfied. No reasonable juror could find otherwise.

9. Target’s defense to infringement of claim 1 of the ‘670 patent

Target’s technical expert on liability, Dr. Turnbull, presents only two arguments as to why the Target System purportedly does not infringe claim 1 of the ‘670 patent: (i) Target does not physically provide mobile phones; and (ii) that Innovaport has not specifically identified the mobile device, the user interface, and the output device referenced in the claims. Turnbull Infringement Report, pp. 35-36, ¶¶ 77 and 78. Since Dr. Turnbull has not contested any of the other limitations recited in claim 1, those limitations should be deemed admitted or waived.

Dr. Turnbull’s first defense is based on his misinterpretation of the claim. During his deposition, Mr. Turnbull confirmed that he interpreted claim 1 of the ‘670 patent as requiring the step of “providing” a mobile device to a user. Turnbull Report, pg. 35, ¶ 77; *see also* Turnbull Dep., 110:14-112:15, Griggs Sep. 28, 2023 Decl., Ex. G (“I’m saying that Target doesn’t do that, they’re not providing that [mobile] device, and so that would be one of the reasons that the claim is not infringed.”) However, the claim does not recite “providing” a mobile device (as does claim 1 of the ‘690 patent.)⁵ Rather, the claim recites “providing” an information storage device that communicates with a mobile device. *See* clause 1(a) of the claim. Dr. Turnbull’s argument – that Target does not provide a mobile device – is irrelevant because claim 1 of the ‘670 patent does not recite “providing” a mobile device.

Dr. Turnbull’s second defense is that Innovaport has not identified “a *distinct* ‘output device’” as recited in clause 1(g) of the claim. Turnbull Invalidity Report, pg. 35, ¶ 77, Griggs Sep. 28, 2023 Decl., Ex. I [emphasis added]. However, the specification of the Innovaport patents discusses that the input/output device used in conjunction with the system may be a

⁵ For claims that require “providing” a mobile device to a user, Innovaport asserts that Target satisfies this limitation under the doctrine of equivalents by providing a mobile application (or mobile website). This is discussed in greater detail below with respect to claim 1 of the ‘690 patent.

touchscreen. *See, e.g.*, the ‘670 patent, 10:21-24 (“In alternate embodiments, the respective output and input functioning of monitor 404 and keyboard input 406 are combined in a single unit, such as a touch screen display.”) Thus, the patent states that the input and output functioning may be combined into a “single unit,” such as the touch screen of a mobile phone.

Further, when analyzing the prior art, Dr. Turnbull identified the entire device when asked to identify the “mobile device,” the “user interface,” and the “output device.” Turnbull Dep., 46:01-47:02, Griggs Sep. 28, 2023 Decl., Ex. G. Thus, according to Dr. Turnbull, these limitations may be satisfied by the same device, such as a mobile phone or the wireless communication device depicted in Figure 2 of Asthana (a prior art reference relied upon by Target). *See* Asthana ‘670, Fig. 2, Griggs Sep. 28, 2023 Decl., Ex. S.

No reasonable juror could find that the Target system does not infringe claim 1 of the ‘670 patent. The claim does not require “providing” a mobile device, thus obviating Target’s first and primary defense to infringement of this claim. As for Target’s second defense, a mobile phone certainly has a user interface and an output device that enables a user to communicate with the Target System. Innovaport is entitled to summary judgment that claim 1 of the ‘690 patent is infringed.

B. Claim 1 of the ‘690 Patent

1. [preamble] A method of providing product location information within a store, the method comprising the steps of:

As with claim 1 of the ‘670 patent above, there is no dispute that the Target System is a method of providing product location information. Dr. Turnbull does not contest this fact.

2. **[clause 1(a)] providing a plurality of devices including a mobile device, wherein the plurality of devices are in communication with one another, wherein at least one of the devices includes at least one user interface, and wherein at least one of the devices includes at least one information storage device including a database,**

As distinct from claim 1 of the '670 patent, clause 1(a) of claim 1 of the '690 patent recites “providing a plurality of devices including a mobile device.” In other words, the claim requires providing a mobile device. The Target System satisfies this limitation under the doctrine of equivalents because Target provides a mobile application, a mobile website, and a website to users that users may access on their own mobile device, e.g., a smart phone.

Innovaport’s proposed construction for the term “mobile device” is “a portable device.” Target has proposed to construe the term by its plain and ordinary meaning, but Target does not offer any explanation as to what that may be. In any event, this limitation is satisfied under either proposed construction. Providing a mobile application to a user (as opposed to a physical mobile device) satisfies this limitation under the doctrine of equivalents. *See Cortland Line Co. v. Orvis Co.*, 203 F.3d 1351, 1359 (Fed. Cir. 2000) (“An element in the accused product is equivalent to a claim element if the differences between the two are ‘insubstantial’ to one of ordinary skill in the art.”).

In the context of the patent claim and implementing the claimed method, there is no meaningful difference between (i) providing a customer with a mobile device that has an application on it and (ii) providing an application to a customer who then uses his or her own mobile device to run the application. Stricchiola Sep. 28, 2023 Decl., pg. 8, ¶ 29. Indeed, Asthana, a prior art reference relied upon by Target, draws no distinction between the two. Asthana, 3:1-5 (“Referring to Figs 2 and 3, the communication device 20 is a high volume, hand-

held wireless unit that may either be owned by the customer and brought to the establishment or provided to the customer upon entering the establishment.”).

The reason for “providing” a mobile device is to facilitate a user’s interaction with the system and to enable a user to make a product location inquiry. There is no difference between providing a *mobile device* with the capability of processing such an inquiry and providing *an application* that is accessed on a user’s personal mobile device, which also has the capability of processing such an inquiry.⁶ Thus, providing a mobile application satisfies the “function, way, result” test because providing a mobile application enables a user to access the Target System and present an inquiry (the function) in the same way as providing a mobile device with an application on it. *Searfoss*, 374 F.3d at 1150. The result is also the same as a user is able to receive the results of the inquiry using either an application on their own mobile device or using a mobile device that would be provided by Target. No reasonable juror could find otherwise.

3. [clause 1(b)] wherein the at least one information storage device includes both product location information and additional product-related information linking a product with an other product in a cross-referential manner;

Clause 1(b) of the ‘690 patent is identical to clause 1(b) of the ‘670 patent, so the analysis above applies. The Target System includes a component called FIATS that stores product location information, SOF 26 and 27, and a component called Core Item that stores attributes or other information that links product to another. SOF 31. The Target System uses product hierarchies that relate products to each other to present a recommendations carousel to a user. SOF 28 and 29.

⁶ As an example, there is no difference between playing a game on your own phone and borrowing your friend’s phone to play the same game.

4. **[clause 1(c)] receiving a product location inquiry regarding the product by way of the at least one user interface;**

[clause 1(d)] processing the product location inquiry at a signal processing device to determine a product location inquiry signal;

[clause 1(e)] querying the at least one information storage device to obtain portions of the product location information and additional product-related information in response to the product location inquiry signal;

[clause 1(f)] providing a product location information signal in response to the product location inquiry signal;

Clauses 1(c)-(f) will be addressed together as they generally relate to fielding an inquiry from a user, processing the inquiry, querying the information storage device to obtain portions of product location information and additional product-related information, and providing a product location information signal in response to the product location inquiry signal. As discussed above, RedSky interfaces between Target's mobile application and the back-end system to process product location requests and return data in response to such a request.

Specifically, RedSky interfaces with Target's mobile application and mobile website to process inquiries. SOF 32. Thus, the limitation of clause 1(c) is satisfied when a customer makes a product location inquiry via the Target mobile app (or Target mobile website or website) on a mobile phone, such as an iPhone or an Android phone. All smartphones have a user interface, such as a touchscreen, through which a customer communicates with the Target System.

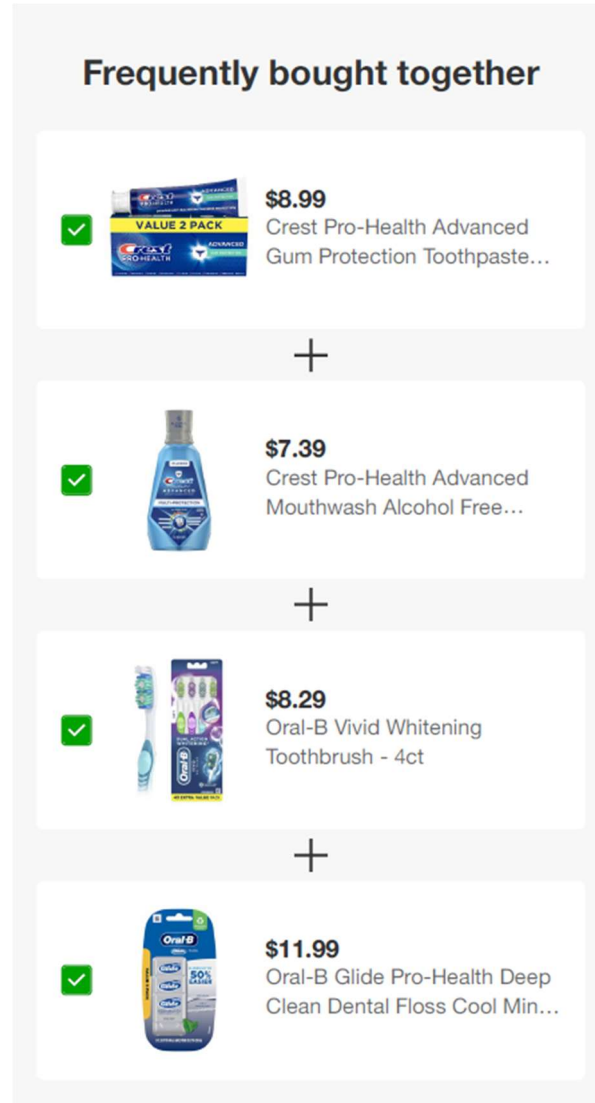
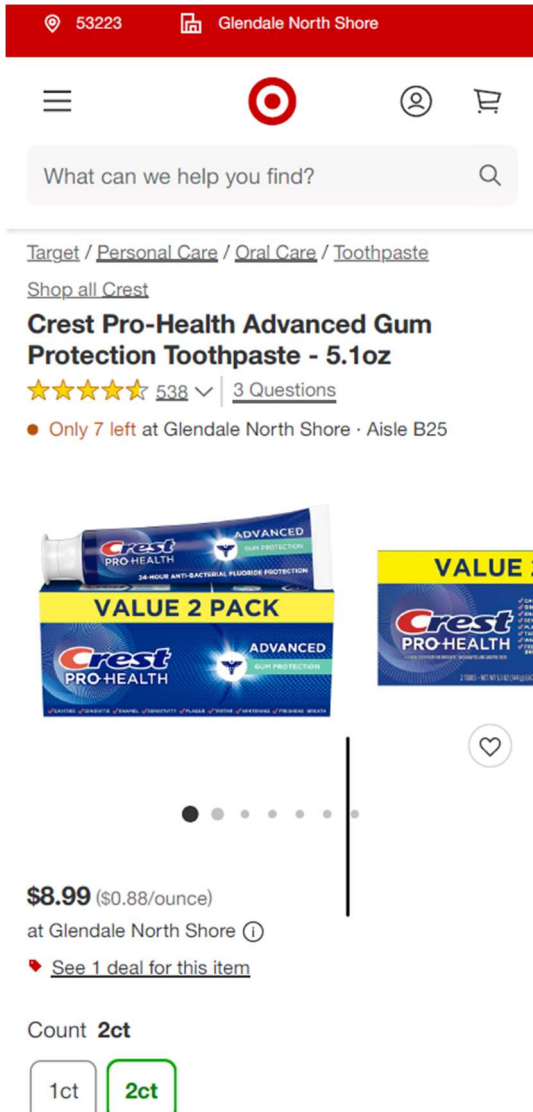
As Mr. Larson explained, RedSky "integrates with our back-end search platform based upon the request coming from the guests when they search." SOF 24. As part of this integration, RedSky processes a location inquiry from a customer and generates a product location inquiry signal. RedSky then pulls the data from the back-end system, that includes the databases such as

FIATS and Core Item. The signals recited in the claim are inherent in the Target System and are not disputed by Dr. Turnbull. SOF 44 and 45; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 5, ¶ 17.

The above limitations are satisfied when a user searches for a product using the Target mobile application or mobile website, as RedSky processes the customer's inquiry and returns information (including product location information and recommendations for other products) in response to the inquiry. No reasonable juror could find otherwise.

5. **[clause 1(g)] providing an output signal at an output device, the output signal being a response to the product location inquiry, wherein the output signal includes location information concerning the product and also provides at least one suggestion related to the other product.**

As shown in the exemplary images below (taken from the Target mobile website as shown on an iPhone), the Target System provides product location information (i.e., the toothpaste is located in Aisle B25) as well as suggestions, via a product recommendation carousel, relating to products for which the user did not search (i.e., mouthwash, toothbrushes, and floss). SOF 18, 19, and 20.



Mr. Larson testified at his deposition that the Target System uses product hierarchies to present a recommendations carousel, such as the “Frequently bought together” carousel shown above. SOF 28 and 29. The results are displayed (in the above instance on the screen of a mobile phone) via an output signal that is received by the mobile phone. Stricchiola Sep. 28, 2023 Decl., pg. 7, ¶ 25. No reasonable juror could find that the limitations of clause 1(g) are not met by the Target System.

6. Target's defenses to infringement of claim 1 of the '690 patent

Target's primary defense to infringement of claim 1 of the '690 patent is that Target does not provide mobile phones to its customers. Turnbull Infringement Report, pg. 40, ¶ 91 ("Defendant does not provide cell phones or tablets that would satisfy the 'mobile device' element."). Dr. Turnbull also presents the conclusory opinion that Innovaport "mistakenly alleges that a software application is equivalent to a user interface and mobile device." *Id.*, pg. 41, ¶ 92.

However, Dr. Turnbull offers no meaningful analysis in support of his conclusion. *Clark v. Takata Corp.*, 192 F.3d 750, 757 (7th Cir. 1999) ("An expert must substantiate his opinion; providing only an ultimate conclusion with no analysis is meaningless."). The entire sum and substance of his comments with respect to software and mobile devices is below:

That the Infringement Report conflates software and hardware further undermines its credibility, for a POSITA would understand that providing a device is distinct from providing the software that runs on the device. This is consistent with how there are companies that specialize in providing hardware (e.g., Dell), and companies that specialize in providing software (e.g., Mozilla). Thus, Defendant does not infringe any claim that requires a "user interface" where the Infringement Report alleges that element is satisfied by a software graphical user interface.

Turnbull Report, pp. 34-35, ¶ 73.

Dr. Turnbull's only opinion is that software is "distinct" from a mobile device, but this does not refute infringement under the doctrine of equivalents, which focuses on the "function, way, result" test. The question under the doctrine of equivalents is whether there are insubstantial differences between providing a mobile device to implement the claimed method and providing a software application so that a user can implement the method on their own

mobile device. Dr. Turnbull does not undertake this analysis. As discussed above, there is no difference in these two scenarios. Stricchiola Sep. 28, 2023 Decl., pg. 9, ¶ 29. No reasonable juror could find otherwise.

C. Claim 15 of the ‘260 Patent

1. [preamble] A method of providing product location information within a first store, the method comprising:

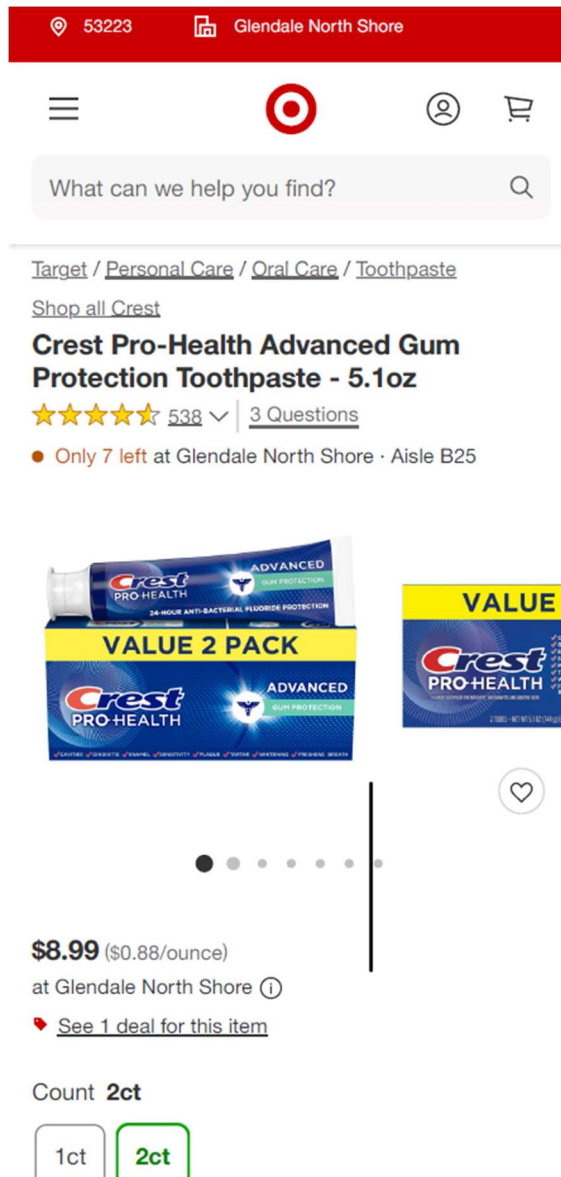
As with the other mobile device claims above, Target’s System implements a method of providing product location information.

2. [clause 1(a)] providing a hub that is at least indirectly in communication with each of a plurality of user interfaces, and that is capable of accessing at least one database, the at least one database including both product location information and additional product-related information,

Similar to clause 1(a) of the ‘670 and ‘690 patents, RedSky constitutes a hub that is in communication with a plurality of user interfaces (e.g., customers’ mobile phones). RedSky pulls data from the back-end systems of the Target System. SOF 25. FIATS stores product location information, SOF 27, and Core Item stores additional product-related information. SOF 32; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 11, ¶ 38.

3. [clause 1(b)] wherein the additional product-related information includes: information concerning a quantity of a first product within the store; information concerning a price of the product; information concerning an availability or unavailability of the product within the store; and information linking the product with another product in a cross-referential manner;

As shown in the image below, the Target System provides information relating to the quantity of a product within a store (e.g., “only 7 left”); the price of the product (e.g., “\$8.99”); and the availability of a product at a store (e.g., “at Glendale North Shore”). SOF 37.



Further, as discussed with respect to claim 1 of the '670 patent and claim 1 of the '690 patent, the Target System uses product hierarchies to present a recommendations carousel to a user. SOF 30. These hierarchies store attributes that link one product to another. SOF 31.

4. **[clause 1(c)] periodically engaging in the communication with each of the user interfaces, wherein the engaging in the communication includes:**

As discussed above, RedSky interfaces with a customer's mobile device to process product location inquiries from the customer. SOF 24 and 25; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 14, ¶ 44.

5. **[clause 1(d)] receiving inquiry signals from the user interfaces;**

[clause 1(e)] querying the database to obtain portions of the product location information in response to the inquiry signals; and

[clause 1(f)] providing information signals in response to the inquiry signals for receipt by the user interfaces, wherein the information signals include portions of both the product location information and the additional product-related information, whereby the user interfaces are able to provide output signals based upon the information signals;

[clause 1(g)] wherein at least some of the communication is wireless communication.

Clauses 1(d)-(g) will be addressed together as they generally relate to fielding an inquiry from a user, processing the inquiry, querying the information storage device to obtain portions of product location information and additional product-related information, and providing a product location information signal in response to the product location inquiry signal. As discussed above with respect to clauses 1(c)-(f) of claim 1 of the '690 patent, RedSky interfaces between Target's mobile application and the back-end system to process product location requests and return data in response to such a request. The Target System communicates wirelessly with mobile phones.⁷

⁷ Mr. Larson testified that the mobile application and website function the same as the kiosks when processing a location inquiry. SOF 39. Thus, a kiosk that communicates wirelessly infringes claim 15 of the '260 patent. As shown in the kiosk images (SOF 41), the kiosks are tablets that rely on wireless communication.

6. Target's defenses to infringement of claim 15 of the '260 patent

Target presents two defenses to infringement of claim 15 of the '260 patent: (i) Innovaport has not identified a "user interface;" and (ii) Innovaport has not demonstrated that the Target System engages in "periodic" communication with the user interfaces. Turnbull Infringement Report, pp. 56-57, ¶¶ 130-132.

With respect to the first defense, the claim recites "providing a hub that is at least indirectly in communication with each of a plurality of user interfaces." Thus, as with claim 1 of the '670 patent, this claim does not recite "providing" a user interface. Rather, it recites providing "a hub" that *communicates* with user interfaces. As discussed above, a mobile phone includes a user interface, e.g., a touch screen display, with which a user can access the Target System, via RedSky, to input an inquiry. Thus, the "user interface" limitation is satisfied.

Target's second defense is based upon an interpretation of the phrase "periodically communicating" as requiring communication at regular intervals.⁸ However, Target's construction contravenes the claim language, which defines what "periodically communicating" means. Specifically, the claim states "wherein the engaging in the communication includes: receiving inquiry signals from the user interfaces; querying the database..." Thus, periodic communication is initiated by the user when the user makes an inquiry. To suggest that users would make inquiries at regular intervals is nonsensical – there is no timing requirement for making inquiries. The term "periodically engaging in communication" should be given its plain and ordinary meaning in the context of the claim: *engaging in communication from time to*

⁸ Target did not present this as a term for construction when the parties exchanged claim construction terms, nor is it included in the list of terms for the Court to construe submitted in advance of this motion. See Joint Claim Construction Terms (Doc. 36). Accordingly, Target should be precluded from presenting this new construction in contravention of the Preliminary Pretrial Conference Order (Doc. 18).

time. See, e.g., <https://www.merriam-webster.com/dictionary/periodic> (“occurring repeatedly from time to time”) (last accessed September 26, 2023). Under the appropriate interpretation, there is no dispute that Target’s System satisfies this limitation.

VII. Infringement – the kiosk claims

A. Claim 7 of the ‘260 patent

1. [preamble] A method of providing product location information within a store, the method comprising:

As discussed with respect to the mobile device claims above, the Target System implements a method of providing product location information. Target’s kiosks function the same as Target’s mobile application, mobile website, and website, and they provide product location information. SOF 39 and 40; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 13, ¶ 51.

2. [clause 1(a)] affixing at least a first input device at a first location within the store, so that the first input device is substantially stationary;

Mr. Larson confirmed during his deposition that Target installed kiosks in its stores “in the 2019-2020 time frame.” SOF 38. As shown in the image below, the kiosk is substantially stationary in that a consumer does not carry the device with them as they move through the store.



3. **[clause 1(b)] providing a database containing product location information and additional product-related information including product availability information;**

As discussed above, RedSky pulls data from the back-end systems of the Target System.

SOF 25. FIATS stores product location information, SOF 27, and Core Item stores additional product-related information. SOF 32; see also Stricchiola Sep. 28, 2023 Decl., pg. 15, ¶ 56. The Target system stores information regarding the availability of the product. SOF 37.

4. **[clause 1(c)] obtaining an inquiry at the first input device;**
[clause 1(d)] processing the inquiry at a processing device to determine an inquiry signal;
[clause 1(e)] querying a database to obtain product location information in response to the inquiry signal;
[clause 1(f)] providing an information signal in response to the inquiry signal, the information signal at least sometimes including at least a first portion of the product location information and also depending at least sometimes upon a first portion of the product availability information;

[clause 1(g)] providing an output signal at an output device, the output signal being a response to the inquiry and being based upon the information signal,

Clauses 1(c)-(g) will be addressed together as they generally relate to fielding an inquiry from a user, processing the inquiry, querying the information storage device to obtain portions of product location information and additional product-related information, and providing a product location information signal in response to the product location inquiry signal. RedSky interfaces between the kiosk and the back-end system to process product location requests and return data in response to such a request. As shown in the image above, Target's kiosk states "Search for item location, price & details," and it provides a search bar to input an inquiry. SOF 41.

RedSky interfaces with Target's kiosk to process inquiries in the same manner as the mobile application and website. SOF 39. Thus, the limitation of clause 1(c) is satisfied when a customer makes product location inquiry via the kiosk.

As Mr. Larson explained, RedSky "integrates with our back-end search platform based upon the request coming from the guests when they search." SOF 24. As part of this integration, RedSky processes a location inquiry from a customer and generates a product location inquiry signal. RedSky then pulls the data from the back-end system, that includes the databases such as FIATS and Core Item. The signals recited in the claim are inherent in the Target System and are not disputed by Dr. Turnbull. SOF 44 and 45; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 5, ¶ 17. Moreover, Mr. Larson confirmed that the Target kiosks provide product availability information. SOF 42 and 43.

The above limitations (clauses 1(c)-(g)) are satisfied when a user searches for a product using a kiosk, as RedSky processes the customer's inquiry and returns information (including

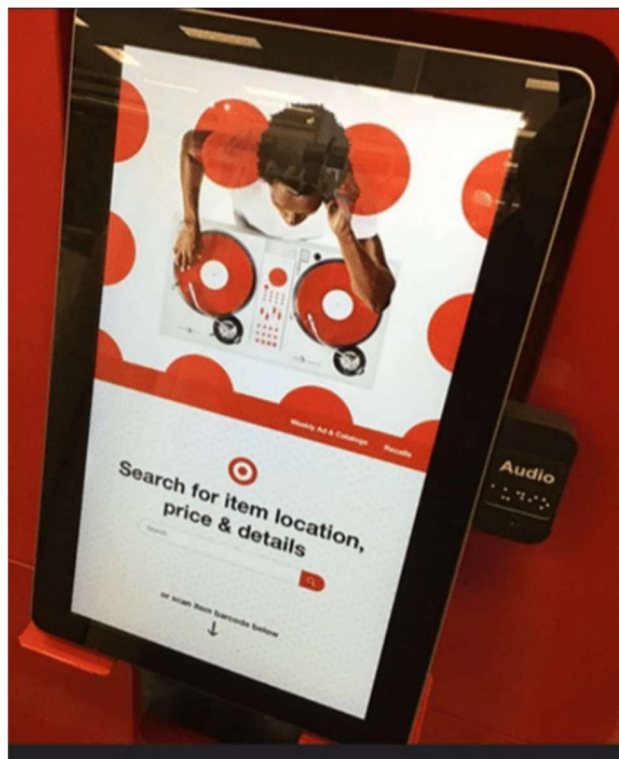
product location information and product availability information) in response to the inquiry. No reasonable juror could find otherwise.

5. **[clause 1(h)] whereby, when the product availability information indicates that the product is unavailable at a location, the information signal is configured so that the output signal does not provide an indication that the product is available at the location; and**

During his deposition, Mr. Larson confirmed that the Target kiosks will not indicate that a product is not available at a particular store when the product is in fact available at that store. SOF 42.

6. **[clause 1(i)] comparing information regarding the inquiry with additional, information concerning products sold at the store.**

The Target System compares information regarding the inquiry with additional information relating to products at the store. For example, as shown in the image below, the kiosk returns information regarding “price” and “details” in response to a user inquiry.



In order to provide the price and details of a product, the Target System compares information regarding the inquiry with other information in the databases, such as the price and availability of the product. Stricchiola Sep. 28, 2023 Decl., pg. 19, ¶¶ 70-71.

Moreover, Mr. Larson testified that the Target System uses algorithms applied to sales history to recommend products to guests: “We have ways to designate certain products, trends. We can leverage algorithms that determine based on purchase history across the site. That could then be used to create a list of items that could be tied as trending bathroom...accessories.” SOF 47; *see also* Larson Dep. 35:05-17, Griggs Sep. 28, 2023 Decl., Exs. G and H. Thus, when a user makes a search, the Target System compares that search to “sales history” data to make recommendations to the user.

7. Target’s defenses to infringement of claim 7 of the ‘260 patent

Target presents three arguments that its kiosks do not infringe claim 7 of the ‘260 patent. First, Target argues that the claim requires a *single* database that stores both product location information and product availability information. Turnbull Infringement Report, pp. 52-53, ¶ 123. Importantly, Dr. Turnbull does not dispute that the system stores these types of information. Dr. Turnbull acknowledges that “the FIATS system... purportedly contains product location and availability information.” *Id.* Dr. Turnbull further admits that “[i]t would have been trivial for Target to use a method that splits the required information between more than one database so that a single database does not contain both types of information.” *Id.*, pg. 72, ¶ 171. Thus, Dr. Turnbull concedes that this information is stored in a single database in the system. Despite this admission, Dr. Turnbull asserts that “[b]ecause the allegations are that two different systems contain the information required, it cannot be that a single database contains the information required.” *Id.*

Neither of the parties have asked the Court to construe the term “database” as it appears in claim 7 of the ‘260 patent. As explained by Ms. Stricchiola, a POSA would understand that a database is “an organized collection of structured information, or data, typically stored electronically in a computer system.” Stricchiola Sep. 28, 2023 Decl., pg. 4, ¶ 9. Thus, the mere recitation of the term “database” does not limit it to a certain structure or configuration.

Even if the term “database” is construed in the narrow fashion applied by Mr. Turnbull, the database limitation is satisfied under the doctrine of equivalents. Dr. Turnbull admitted that it is “trivial” to store information in multiple databases as opposed to a single database. Thus, there are insubstantial differences between using a single database or using multiple databases under the doctrine of equivalents. *Searfoss*, 374 F.3d at 1151 (“[A] combination of physical components may serve as an equivalent to a single imitation of the claimed invention.”). Moreover, use of two or more databases does not “wholly vitiate” the requirement of “providing a database” in the claim. *Id.*

Second, Target argues that the kiosk somehow does not include an output device. Turnbull Infringement Report, pg. 53, ¶ 124. However, the specification of the Innovaport patents explains that “the respective output and input functioning of monitor 404 and keyboard input 406 are combined int a single unit, ***such as a touch screen display.***” The ‘670 patent, 10:21-24 [emphasis added]. Target’s kiosks operate via a touch screen display, which serves as the input device and the output device. The patent specification makes clear that these functionalities can be performed by the same device, such as a touch screen.

Finally, Dr. Turnbull argues that the kiosks do not perform the comparing step (clause 1(i)], whereby the system compares information regarding the inquiry with additional information concerning products sold at the store. However, as discussed above, the Target

System provides information such as “price” and “details” in response to an inquiry. Thus, the Target System compares information regarding an inquiry (e.g., a search for toothpaste) with information in the system about available toothpaste (e.g., the price of the toothpaste) and returns that information to the kiosk.

B. Claim 1 of the ‘380 Patent

1. [preamble] A system for providing product location information within a store, the system comprising:

As discussed with respect to claim 7 of the ‘260 patent, the Target System implements a method of providing product location information. Target’s kiosks function the same as Target’s mobile application and website, and they provide product location information. SOF 39 and 40.

2. [clause 1(a)] a first user interface positioned within the store in a substantially stationary manner, the first user interface configured to receive an input signal from a user related to a product that may be available within the store, to process the input signal and to provide a product inquiry signal in response to the input signal, the first user interface further configured to receive an information signal, and to provide an output signal in response to the information signal, and

Mr. Larson confirmed during his deposition that Target installed kiosks in its stores “in the 2019-2020 time frame.” SOF 38. The kiosks are substantially stationary in that a customer does not carry the device with them as they move through the store. SOF 41.

3. [clause 1(b)] an inventory information unit coupled to the first user interface and comprising a database containing product location information and additional product-related information including product availability information, the inventory information unit configured to provide the information signal to the first user interface after receiving the product inquiry signal from the first user interface,

As discussed above, RedSky pulls data from the back-end systems of the Target System. SOF 25. FIATS stores product location information, SOF 27, and Core Item stores additional

product-related information. SOF 32. *See also* Stricchiola Sep. 28, 2023 Decl., pg. 19, ¶ 76.

The Target system stores information regarding the availability of the product. SOF 37.

4. [clause 1(c)] wherein the information signal provided by the inventory information unit at least sometimes includes a first portion of the product location information, and

Mr. Larson testified at his deposition that the kiosks provide product location information. SOF 40. Signals are inherent in any computer system, and the Target System uses an information signal to transmit product location information for display by the kiosk. SOF 44 and 45; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 5, ¶ 7.

5. [clause 1(d)] wherein the information signal provided by the inventory information unit depends at least sometimes upon a first portion of the product availability information,

Mr. Larson testified that the kiosks will provide product availability information in addition to product location information. SOF 42 and 43; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 20, ¶ 80.

6. [clause 1(e)] whereby, when the input signal is indicative of a product location inquiry and the inventory information unit determines based upon the product availability information that the product is unavailable at a location, the inventory information unit configures the information signal so that the output signal provided by the user interface does not provide an indication that the product is available at the location.

The Target kiosks will not indicate that a product is available at a particular store when the product is in fact not available at that store. SOF 42.

7. Target's defenses to infringement of claim 1 of the '380 patent

Target presents two defenses to infringement of claim 1: (i) that Innovaport has not identified an inventory information unit; and (ii) the same "single" database argument presented with respect to claim 7 of the '260 patent. Turnbull Infringement Report, pg. 58, ¶¶ 136 and 137.

With respect to the inventory information unit, Dr. Turnbull does not assert that the Target System lacks an inventory information unit – he merely asserts that Innovaport has not identified it in the Target System. On the contrary, RedSky in combination with various databases, e.g., FIATS and Core Item, satisfy this limitation.

The claim recites “an inventory information unit... comprising a database.” RedSky pulls data from the back-end systems of the Target System. SOF 25. FIATS stores product location information, SOF 27, and Core Item stores additional product-related information. SOF 32. The claim further recites that “the inventory information unit [is] configured to provide the information signal to the first user interface.” This is precisely what RedSky does – it interfaces with the kiosk to provide information in response to an inquiry.

With respect to the database argument, Dr. Turnbull admits that “[i]t would have been trivial for Target to use a method that splits the required information between more than one database so that a single database does not contain both types of information.” *Id.*, pg. 72, ¶ 171. This implicitly acknowledges that the Target System satisfies the claim limitation. Moreover, even if the claim were interpreted as requiring use of a single database (which is an overly narrow interpretation that should not be applied), this limitation is satisfied because Dr. Turnbull has admitted that the difference between using a single database or multiple databases is “trivial.”

C. Claim 1 of the ‘315 Patent

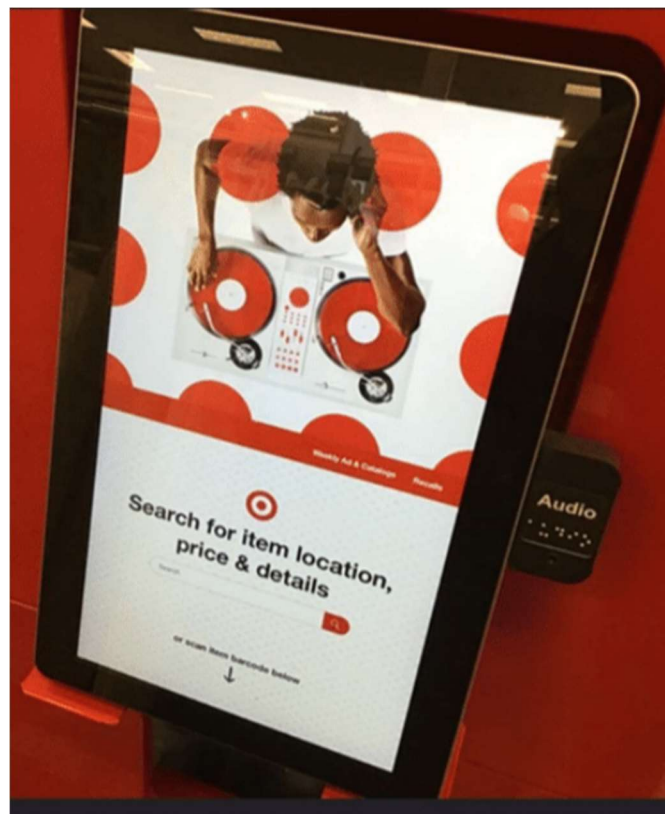
- 1. [preamble] A system for providing product location information regarding locations of products within a store to customers within the store, the system comprising**

As discussed with respect to claim 7 of the ‘260 patent and claim 1 of the ‘380 patent, the Target System implements a method of providing product location information. Target’s kiosks

function the same as Target's mobile application and website, and they provide product location information. SOF 39 and 40.

2. **[clause 1(a)] a plurality of user interfaces situated respectively at respective positions within the store in a substantially stationary manner, the user interfaces configured to receive input signals from the customers in the store and provide output signals to the customers in the store, wherein each of the user interfaces includes a memory unit; and**

Mr. Larson confirmed during his deposition that Target installed kiosks in its stores "in the 2019-2020 time frame." SOF 38. The kiosks are substantially stationary in that a customer does not carry the device with them as they move through the store. SOF 41. As shown in the image below, the kiosks include a touch screen display that receives input signals from a user and displays output signals with the results of a search.



The kiosks necessarily include a memory unit because memory is an essential component of modern digital computers. SOF 48 and 49; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 21, ¶ 85.

3. **[clause 1(b)] a hub that is at least indirectly in communication with each of the user interfaces, and that is capable of accessing at least one database, the at least one database including both product location information and additional store-related information,**

As discussed above, RedSky pulls data from the back-end systems of the Target System, which constitutes a hub that communicates with the kiosks. SOF 25. FIATS stores product location information, SOF 27, and Core Item stores additional product-related information. SOF 32; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 22, ¶ 88. The Target system stores information regarding the availability of the product, which constitutes additional store-related information (e.g., whether the product is available in that particular store). SOF 37.

4. **[clause 1(c)] wherein the hub is periodically in communication with each of the user interfaces and provides portions of the product location information thereto, and**

RedSky interfaces with Target's kiosk to process inquiries in the same manner as the mobile application and website. SOF 39. As Mr. Larson explained, RedSky "integrates with our back-end search platform based upon the request coming from the guests when they search." SOF 24. As part of this integration, RedSky processes a location inquiry from a customer and returns the results of that inquiry to the kiosk. Stricchiola Sep. 28, 2023 Decl., pg. 22, ¶ 90.

5. **[clause 1(d)] wherein, upon receiving a first of the input signals representative of a product location inquiry from a first of the customers at a first of the user interfaces, the first user interface obtains relevant product location information from the respective memory unit of the first user interface, and subsequently the first user interface provides a first of the output signals as a response to the first input signal based upon the relevant product location information.**

As discussed above, RedSky pulls data from the back-end systems of the Target System.

SOF 25. FIATS stores product location information, SOF 27, and Core Item stores additional product-related information. SOF 32. Mr. Larson testified at his deposition that the kiosks provide product location information. SOF 40. Signals are inherent in any computer system, and the Target System uses an information signal to transmit product location information for display by the kiosk. SOF 44 and 45; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 5, ¶ 17. The kiosk would necessarily store product location information in a memory unit to process the information and display it to a user. SOF 50; *see also* Stricchiola Sep. 28, 2023 Decl., pg. 23, ¶ 92.

6. Target’s defenses to infringement of claim 1 of the ‘315 patent

Target presents two defenses to infringement of claim 1 of the ‘315 patent: (i) that the kiosks do not engage in “periodic” communication with RedSky; and (ii) that Innovaport has not demonstrated that the kiosks have a “memory unit.” Turnbull Infringement Report, pp. 64-65, ¶¶ 150-151.

The defense based upon the kiosks “periodically” communicating with RedSky is discussed above and is premised on claim construction. The term should be interpreted as “*from time to time*” as that is the plain and ordinary meaning of the term and is consistent with how the term is used in the context of the claims, e.g., the user interfaces communicate with the hub to provide portions of the product location information in response to a user inquiry. In other

words, the user interface periodically communicates with the hub when a user makes an inquiry. Target’s proposed construction, which would require communication at regular intervals, makes no sense in the context of the claim.

With respect to the “memory unit” limitation, Dr. Turnbull offers no analysis, nor does he affirmatively allege that the kiosks do not contain a memory unit. Such an allegation would not be credible. As Ms. Stricchiola explains, all computers have memory units that are used to process information and display information to a user. Stricchiola Sep. 28, 2023 Decl., pg. 21, ¶ 85.

VIII. Invalidity

A. Obviousness based on Asthana alone (claim 1 of the ‘670, claim 1 of the ‘960)

With respect to the claims that are the subject of this motion for summary judgment, Target asserts that claim 1 of the ‘670 patent and claim 1 of the ‘690 patent are obvious over Asthana⁹ alone. “Though less common, in appropriate circumstances, a patent can be obvious in light of a single prior art reference if it would have been obvious to modify that reference to arrive at the patented invention.” *Arendi*, 832 F.3d at 1361. Asthana fails to disclose at least two limitations that are common to these claims: (i) linking one product to an other product in a cross-referential manner; and (ii) making a suggestion relating to the other product in response to a product location inquiry.

Generally speaking, Asthana discloses a system and method of providing information to a customer of an establishment based upon a customer profile that is stored in a database. *See, e.g.,* Asthana ‘670, Abstract (“The server (10) includes at least one general database containing

⁹ There are actually two Asthana references: a European patent application EP 0697670 (“Asthana ‘670”) and an article that purports to have been published in 1995 (“the Asthana article”).

information pertaining to products or services offered by the public establishment and a database comprised of personalized customer profiles for each regular customer of the establishment.”); Asthana Article, pg. 69 (“By integrating wireless, video, speech and real-time data access technologies, we can create a unique service that personalizes attention provided to a customer based upon individual needs and a shopping profile accumulated over time.”).

The system of Asthana includes a device called a personal shopping assistant (“PSA”) that is “a high volume, hand-held wireless unit that may either be owned by the customer and brought to the establishment or provided to the customer upon entering the establishment.” Asthana ‘670, 3:1-5. The PSA “permits the customer to communicate with the establishment’s centralized server 10...” *Id.*, 3:5-8.

1. Asthana does not disclose linking one product with an other product in a cross-referential manner (claim 1 of the ‘670 patent; claim 1 of the ‘690 patent)

In his report on invalidity, Dr. Turnbull identifies what he purports to constitute this limitation in Asthana. The entirety of Dr. Turnbull’s analysis is reproduced below:

A PHOSITA would understand that the server disclosed in Asthana also includes information that allows for comparing “the price of competing merchandise within the establishment, or [to] identify specific merchandise that the particular customer was looking for on a prior visit to the establishment but that was unavailable.” Asthana ‘670 at 2:44-58. This is an example of additional product-related information linking a product with another product in a cross-referential manner.

Turnbull Invalidity Report, pg. 52, ¶ 124.

As an initial matter, Asthana contains no disclosure regarding how data is actually stored in the disclosed database. Instead, Dr. Turnbull simply notes that the Asthana system allows for comparing the price of competing merchandise and then leaps to the conclusion that this

statement somehow constitutes evidence of linking one product with an other product in a cross-referential manner. Without stating it directly, Mr. Turnbull is making an inherency argument.

“Inherency, however, is a high standard, that is care-fully circumscribed in the context of obviousness.” *Persion Pharms. LLC v. Alvogen Malta Operations Ltd.*, 945 F.3d 1184, 1191 (Fed. Cir. 2019) [citations and quotations omitted]. The Federal Circuit further explains:

If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is “inherent” in its disclosure. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed.Cir.1991). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* at 1269, 948 F.2d 1264, 20 U.S.P.Q.2d at 1749 (*quoting In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A.1981)).

In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999).

Dr. Turnbull does not assert that comparing the price of competing merchandise may **only** be accomplished by linking one product with an other product in a cross-referential manner. On the contrary, a price comparison inquiry is performed in response to an inquiry whereby the system would search for the products and their associated price information and then present that information. Stricchiola Sep. 28, 2023 Decl., pp. 24-25, ¶ 97. There is no indication in Asthana that the system would have pre-determined associations between products for purposes of price comparisons. *Id.* Thus, the mere disclosure in Asthana that the system can compare the price of competing merchandise does not **necessarily** disclose linking one product with an other product in a cross-referential manner. *Id.*

Dr. Turnbull similarly concludes that identifying merchandise that the particular customer was looking for on a prior visit is also evidence of linking one product with an other product in a cross-referential manner. However, Dr. Turnbull does not explain this conclusion. As with the price comparison example discussed above, Dr. Turnbull is presenting an inherency argument that must be rejected for the same reasons above.

Further, the price comparison referenced in Asthana is directed to “competing merchandise,” which involves the same type of product. When appropriately construing “an other product” as “a different type of product” than the product about which a user inquires, performing a price comparison does not constitute “linking one product with an other product in a cross-referential manner.”

As with the price comparison example, there is no explicit disclosure as to how the Asthana system stores information relating to a product that a particular customer was looking for on a prior visit. However, it is most likely that the Asthana system would associate that information with a user profile that is utilized by the Asthana system. Stricchiola Sep. 28, 2023 Decl., pg. 25, ¶ 98. Moreover, this particular example only involves a *single* product – it does not involve linking two separate products together.

Dr. Turnbull presents no meaningful analysis to support his inherency argument. Moreover, there are alternative ways to present a price comparison and to identify a product that a customer was looking for on a past visit. Asthana does not inherently disclose linking one product with another product in a cross-referential manner because it is not necessary to use the particular database configuration recited in the claims to present price comparisons or to identify a product from a customer’s past visit.

Innovaport is entitled to summary judgment on Target’s invalidity defense based on Asthana. There simply is no evidence upon which a reasonable juror could find that Asthana necessarily discloses linking one product with an other product in a cross-referential manner. Nor is their evidence supporting the notion that a POSA would somehow modify the system of Asthana to incorporate this limitation. Stricchiola Sep. 28, 2023 Decl., pg. 25, ¶ 99. For at least these reasons, Innovaport is entitled to summary judgment on Target’s Asthana invalidity defense.

2. Asthana does not disclose making a suggestion relating to the other product in response to a product location inquiry

Asthana also does not disclose making a suggestion relating to the other product in response to a product location inquiry. As discussed above, Asthana does not disclose linking one product with “an other product” in a cross-referential manner. Because it does not disclose this limitation, it does not disclose making a suggestion relating to “the other” product, i.e., a different product that is linked with a product about which a user is inquiring.

In his report, Dr. Turnbull points to an example regarding peas, whereby the user states the word “peas” and the system returns the following information:

Customer:	“Peas”
The server responds:	“Fresh vegetables are in aisle 15.”
	“Frozen vegetables are in aisle 8.”
	“All Green Giant products are 25% off today.”

Turnbull Invalidity Report, pp. 55-56, ¶ 136.

This disclosure, however, is not exemplary of making a suggestion relating to “the other product,” i.e., a different product that is linked in a cross-referential manner. Stricchiola Sep. 28, 2023 Decl., pg. 26, ¶ 103. The first two responses above provide product location information

for peas (either fresh or frozen). *Id.* The third response provides promotional information relating to a brand, which is distinct from a product. *Id.* Indeed, the specification of the Innovaport patents draws a distinction between “types” of products and “brands” of products. *See* 2:13-19 (“Such inventory systems can keep track of, in addition to the types and brands of products being sold...”). Thus, providing information about a “brand” of products – which is responsive to the customer’s inquiry about peas – does not constitute providing a suggestion relating to “the other product,” i.e., a product about which the customer did not inquire – as recited in the claims.

Moreover, this “peas” example suffers from the same inherency problems as discussed above. Asthana does not disclose how data is stored in the database so as to present the information from the “peas” example exchange. In fact, immediately following the “peas” example, the Asthana Article states that “[t]he audio output can also be used for targeted marketing and providing information based on position.” Asthana Article, pg. 72. Thus, Asthana discloses providing promotional information based upon the location of a customer within the store.¹⁰ It certainly does not explicitly disclose making a suggestion based upon cross-linked information in a database, nor can such disclosure be inferred under the inherency doctrine.

For this additional reason, Innovaport is entitled to summary judgment on Target’s invalidity defense based on Asthana. There simply is no evidence upon which a reasonable juror could find that Asthana necessarily discloses making a suggestion about an “other product” that is linked to a product about which a customer is inquiring in a cross-referential manner. There is

¹⁰ Dr. Turnbull also acknowledges that Asthana uses a customer’s position data to present information to a customer. Turnbull Invalidity Report, pg. 56, ¶ 136.

also no evidence to support the notion that a POSA would modify the system of Asthana to incorporate this particular functionality. Stricchiola Sep. 28, 2023 Decl., pg. 28, ¶ 108.

B. Obviousness based on Ogasawara alone (claim 1 of the ‘670 patent; claim 1 of the ‘690 patent; claim 15 of the ‘260 patent)

Target asserts that claim 1 of the ‘670 patent, claim 1 of the ‘690 patent, and claim 15 of the ‘260 patent are obvious over Ogasawara. However, Ogasawara functions in a very different way than the claimed methodology and fails to disclose several limitations.

The system of Ogasawara is fundamentally different than the methods and systems claimed in the Innovaport patents. It requires the customer to input a list (e.g., via an OCR device or via a personal IC card) into the system and then, once the list is in the system, “the desired destination item is identified by processing the contents of the customer’s shopping list and choosing the closest item to the customer’s current location as the desired destination item.” Ogasawara, 2:55-60. Alternatively, “desired destination items are suitably chosen from a recommended replenishment item list with the closest item to the customer’s current location being chosen as the desired item.” *Id.*, 3:15-18. The customer’s location is determined as follows: “As a customer scans a bar code of a particular item, the store central computer assesses that item’s location information and assigns that particular location to be the customer’s current location.” *Id.*, 2:46-50.

1. Ogasawara does not disclose receiving a product location inquiry (claim 1 of the ‘670 patent; claim 1 of the ‘690 patent)

The claims recite “receiving a product location inquiry signal,” which Innovaport proposes to construe as a keyword search. During prosecution, the patentee distinguished over Berstis, a reference that discloses a system similar to Ogasawara. More specifically, the Berstis system identifies items of interest based upon either (i) coupons that had been downloaded by the customer, and (ii) a preprogrammed list of products. Response to Office Action, pp. 9-10,

Griggs Sep. 28, 2023 Decl., Ex. F. The patentee distinguished claim 20 (which ultimately issued as claim 1) over Berstis as follows:

Indeed, the Applicant submits that the aforementioned excerpts of Berstis provide an indication that Berstis is teaching away from the manner of operation recited in Applicant's claim 20. Rather than facilitating the providing of product location information substantially in real time to customers when they are in stores and have particular needs for such information, Berstis instead teaches helping customers locate products that have been pre-determined as being of interest prior to the customers having entered the stores, e.g., as part of process of coupon entry (see, e.g., col. 6, lines 61-65).

Id., pg. 10.

Thus, the patentee distinguished over a system that provided location information based upon a pre-determined list of products, which is precisely the methodology disclosed in Ogasawara. *See, e.g.*, Ogasawara, 2:55-58. (“In one particular aspect of the invention, the desired destination item is identified by processing the contents of a customer's shopping list and choosing the closest item to the customer's current location as the desired destination item.”).

Inputting a list and then providing product location information based upon that list falls outside the scope of the claims as set forth in the prosecution history. Rather, the system must have the ability to process a real-time inquiry from a customer, which neither Berstis nor Ogasawara can do. Stricchiola Sep. 28, 2023 Decl., pg. 30, ¶ 116. For this reason alone, Target's validity defense relating to claim 1 of the '670 patent and claim 1 of the '690 patent must fail.

2. Ogasawara does not disclose linking one product with an other product in a cross-referential manner (claim 1 of the ‘670 patent; claim 1 of the ‘690 patent; claim 15 of the ‘260 patent)

Ogasawara merely helps a customer find items on a pre-programmed shopping list. The system of Ogasawara does not process a location inquiry, nor does it return information relating to “an other” product. Thus, Ogasawara fails to disclose linking one product with an other product in a cross-referential manner.

Dr. Turnbull ignores this limitation of the claims. He points to various tables that include “merchandise specific information,” but these tables (and the corresponding written disclosure) do not disclose linking one product with another. *See* Turnbull Invalidity Report, pp. 68-70, ¶¶ 189-192. Dr. Turnbull does not specifically point to any disclosure in Ogasawara that purports to constitute linking one product with another in a cross-referential manner, which is unsurprising because Ogasawara does not disclose this limitation. Stricchiola Sep. 28, 2023 Decl., pg. 31, ¶ 119. Innovaport is entitled to summary judgment on Target’s validity defense based on Ogasawara for this additional reason.

3. Ogasawara does not disclose making a suggestion relating to the other product in response to a product location inquiry (claim 1 of the ‘670 patent; claim 1 of the ‘690 patent)

As discussed above, the system of Ogasawara simply does not make a suggestion relating to an “other product” in response to a product location inquiry. Stricchiola Sep. 28, 2023 Decl., pg. 31, ¶ 120. Dr. Turnbull acknowledges this fact and opines that “a POSITA would understand that the invention disclosed in Ogasawara *is capable of* providing ‘at least one suggestion relating to the other product’ along with ‘product location information.’” Turnbull Invalidity Report pg. 88, ¶ 262 [emphasis added]. Thus, Dr. Turnbull does not opine that Ogasawara explicitly discloses this limitation. As discussed above, “[i]nherency, however, may not be

established by probabilities or possibilities.” *Robertson*, 169 F.3d at 745. Innovaport is entitled to summary judgment as to Target’s validity defense based on Ogasawara.

C. Obviousness based on Asthana and Rowley (claim 1 of the ‘380 patent)

Claim 1 of the ‘380 patent is directed to a user interface that is positioned within a store in a “substantially stationary manner.” In contrast, Asthana is directed to “portable communication devices.” Asthana ‘670, 1:7-11. Asthana disparages the use of “programmable displays in the aisles of the establishment,” saying they “may not be effective means of advertising.” *Id.*, 1:26-33. Asthana further touts the benefits of providing “personalized assistance services without limiting the customer’s movement within the establishment.” *Id.*, 1:47-51; *see also* Asthana Article, pg. 69 (providing personalized attention to a customer “without limiting his movement”). A stationary kiosk, by nature, would require customers to walk to its static location within a store, whether or not the kiosk is near products the customer wishes to purchase. In contrast, the system of Asthana is dependent upon a customer’s ability to move throughout the store while using the system and therefore generally teaches away from the use of a fixed kiosk in a store. Stricchiola Sep. 28, 2023 Decl., pg. 32, ¶ 126.

Dr. Turnbull states that a problem addressed by Asthana is that promotional information is not targeted to customers and is typically “impersonal.” Turnbull Invalidity Report, pg. 102, ¶ 314. Mr. Turnbull then suggests that this problem can be overcome using kiosks. However, Asthana’s solution to this problem is the use of mobile PSAs that rely upon user profiles to present information to a customer. Since Asthana already offers a solution to this problem, a POSA would not look beyond the teachings of Asthana for a solution. Stricchiola Sep. 28, 2023 Decl., pg. 33, ¶ 127.

Dr. Turnbull identifies another problem recited in Asthana, which is that customers become frustrated by the inefficient waste of time to determine the location of or the price of certain merchandise within a store. Turnbull Invalidity Report, pg. 102, ¶ 315. Again, Asthana presents a solution to that problem via the mobile PSA system disclosed in Asthana. A POSA would not look beyond those teachings, nor would a POSA incorporate kiosks into the system of Asthana due to Asthana's emphasis of and desire not to interfere with a customer's movement throughout the store. Stricchiola Sep. 28, 2023 Decl., pg. 33, ¶ 128.

Moreover, the Rowley Article expresses skepticism about the use and implementation of kiosks in the retail setting. For example, Rowley notes that "the technology remains rare and experimental in the retail industry." Rowley Article, pg. 37, Griggs Sep. 28, 2023 Decl., Ex. U. Rowley further notes that "one of the factors hindering the wider adoption of kiosks is that kiosks have no proven return on investment (ROI) for retailers." *Id.* In this manner, Rowley teaches away from the implementation of kiosks into a retail setting, and Asthana offers nothing to overcome the concerns with kiosks expressed in Rowley.¹¹ Stricchiola Sep. 28, 2023 Decl., pg. 33, ¶ 129. Instead, Asthana offers a completely different solution by encouraging the use of mobile PSAs.

Dr. Turnbull has failed to identify any motivation to combine the teachings of Asthana and Rowley so as to implement the Asthana system – of which the primary focus is customer

¹¹ The skepticism expressed by Rowley also constitutes evidence of secondary considerations in rebuttal to Turnbull's opinion on obviousness. *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1335 (Fed. Cir. 2016) ("Evidence of industry skepticism weighs in favor of non-obviousness. If industry participants or skilled artisans are skeptical about whether or how a problem could be solved or the workability of the claimed solution, it favors non-obviousness. Doubt or disbelief by skilled artisans regarding the likely success of a combination or solution weighs against the notion that one would combine elements in references to achieve the claimed invention.").

mobility in the store – on a stationary kiosk, the practical use and application of which Rowley is extremely skeptical.

D. Obviousness based on Ogasawara in view of Rowley

Similar to the analysis with respect to the proposed combination of Asthana and Rowley, a POSA would not combine Ogasawara with Rowley. The Ogasawara system helps a customer navigate a store to find items on the customer’s predetermined shopping list by utilizing an “electronic personal shopping system” which includes a mobile terminal “which may be either hand-held or mounted on a shopping cart at the desire of the customer.” Such a system could not be implemented using a stationary (non-mobile) kiosk, nor would it be useful or helpful to implement this system on a stationary kiosk, as Ogasawara aims to reduce the amount of time it takes a customer to locate the items that need to be purchased. Requiring a customer to repeatedly return to stationary kiosks in order to navigate to the items on their shopping list would defeat the purpose of the Ogasawara invention. Stricchiola Sep. 28, 2023 Decl., pg. 34, ¶ 131.

Moreover, as discussed above, the Rowley Article expresses skepticism about the use and implementation of kiosks in the retail setting, noting that “the technology remains rare and experimental in the retail industry.” Rowley Article, pg. 37, Griggs Sep. 28, 2023 Decl., Ex. U. Rowley further notes that “one of the factors hindering the wider adoption of kiosks is that kiosks have no proven return on investment (ROI) for retailers.” *Id.* In this manner, Rowley teaches away from the implementation of kiosks into a retail setting. Thus, a POSA would not combine the teachings of Ogasawara (relating to a mobile shopping terminal that is essential to the functionality of the Ogasawara system) with Rowley (relating generally to the use of stationary kiosks in retail settings). Stricchiola Sep. 28, 2023 Decl., pg. 34, ¶ 132.

Dr. Turnbull asserts that Ogasawara's statement that prior art point-of-sale systems do not help reduce time during the shopping process would motivate a POSA to somehow incorporate stationary kiosks into the system of Ogasawara. Turnbull Invalidity Report, pg. 125, ¶ 410. However, the point-of-sale systems disparaged by Ogasawara are stationary "check-out terminals." Ogasawara, 1:1825. Further, Ogasawara's solution to reducing the time spent shopping is to implement a mobile shopping terminal, which is the opposite of a stationary kiosk. And as described above, stationary kiosks do not address the problem of reducing time during the shopping process when, instead of receiving product location information while navigating the shortest path between products by using a mobile device, a customer would have to go out of their way to access stationary kiosks to obtain the same product location information and in-store directions. Stricchiola Sep. 28, 2023 Decl., pp. 34-35, ¶ 133.

The system of Ogasawara is incompatible with a stationary kiosk. A POSA would not, and could not, incorporate a kiosk into the system of Ogasawara as intended, or conversely, implement the system of Ogasawara as intended on a kiosk. Moreover, as discussed above, Rowley identifies several problems about the implementation of kiosks in the retail setting (such as expense, return on investment) without offering any solutions to overcome those problems. Rowley further expresses strong skepticism about the practical use of kiosks in the retail setting, describing instances of such use as "rare and experimental," essentially teaching away from the use of kiosks in a retail setting. Stricchiola Sep. 28, 2023 Decl., pg. 35, ¶ 134.

E. Obviousness based on Asthana in view of Ogasawara and Rowley (claim 7 of the '260 patent)

For the reasons stated above, a POSA would not combine Asthana and Rowley. Stricchiola Sep. 28, 2023 Decl., pg. 35, ¶ 135. Moreover, Ogasawara is similar to Asthana in that a customer uses a barcode scanner to scan items while walking through the store. In other

words, the system of Ogasawara is dependent on the customer's ability to move throughout the store while using the system. Thus, a POSA would not, and could not, implement the systems of Asthana or Ogasawara on a stationary kiosk.

F. Patent Eligibility

This Court previously held that the claims of the Innovaport patents are directed to patent eligible subject matter. *See Innovaport LLC v. Lowe's Home Centers, LLC*, 2022 WL 1078548, (W.D. Wis. Apr. 11, 2022). Here, Target presents the exact same patent eligibility argument, which should be rejected consistent with the Court's prior ruling.

For example, Dr. Turnbull opines that the claims are "directed to the abstract idea of collecting information and responding to queries," in similar fashion to the *Lowe's* case. Turnbull Invalidity Report, pg. 166, ¶ 577. This Court noted that "defendant's description of the asserted claims arguably 'overgeneralize' in a way that the Federal Circuit has cautioned against." *Lowe's* at *3. Target's patent eligibility defense should be rejected with respect to Step 1 of the analysis because Target has overgeneralized the subject matter of the claims, which are not directed to an abstract idea.

Further, this Court held that "[e]ven assuming that the patents are directed at an abstract idea, and thus, satisfy step one of the *Alice* test for ineligibility, defendant's argument still fails at step two." *Id.* "The asserted claims' requirement that the system's response also provide additional information (e.g., information about related products or the fact that the product is on sale) is at least facially the very type of "inventive concept sufficient to transform the claimed abstract idea into a patent eligible application." *Id.*

The Court previously held that the claims of the Innovaport patents are directed to patent eligible subject matter, and there is no reason to deviate from that ruling. Target's defense based

upon patent eligibility under 35 U.S.C. § 101 must be denied in view of this Court's ruling in the *Lowe's* case.

IX. Conclusion

WHEREFORE, Innovaport respectfully requests that the Court *grant* Innovaport's motion for partial summary judgment that (i) claim 1 of the '670 patent is valid and infringed; (ii) claim 1 of the '690 patent is valid and infringed; (iii) claim 15 of the '670 patent is valid and infringed; (iv) claim 7 of the '260 patent is valid and infringed; (v) claim 1 of the '380 patent is valid and infringed; and (vi) claim 1 of the '315 patent is valid and infringed.

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