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IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF CALIFORNIA

ICONFIND, INC., Plaintiff, v. GOOGLE INC., Defendant.	Case No. 2:11-cv-00319-GEB-JFM **PLAINTIFF ICONFIND, INC.'S RESPONSIVE CLAIM CONSTRUCTION BRIEF**

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Pursuant to the Court's Order on October 7, 2011 (Dkt. No. 72), Plaintiff IconFind, Inc. ("IconFind") hereby provides its Responsive Claim Construction Brief.

I. INTRODUCTION

Google violates the very basic rules of claim construction by importing extraneous requirements from preferred embodiments into its proposed constructions, by taking unambiguous claim terms and rewording them, and by misrepresenting the intrinsic record to suit its non-infringement arguments.

With respect to the term "network page," Google seeks to import a negative limitation which is not part of Judge Shubb's' claim construction Order, which is not supported by the intrinsic record and which is not consistent with the so-called "concession" made by IconFind's counsel at the prior *Markman* hearing. Regarding "assigning" the network page, Google seeks to require that the "creator" assign, when the patent was clearly amended to require that the assigning be performed by a computer. Lastly, Google seeks to require "each" of four exemplary copyright status categories for claim 31, when that claim expressly requires only "a category" (singular—not plural) based on copyright status.

In short, Google is attempting to turn this claim construction process into a word game divorced from the intrinsic record with absurd and nonsensical results that have no rational connection to the technologies at issue. The Court should reject Google's litigation-induced constructions "supported" only by attorney argument and, instead, adopt IconFind's constructions that are properly based on the intrinsic record and the rules of claim construction.

II. ICONFIND'S PROPOSED CLAIM CONSTRUCTIONS ARE THE CORRECT CONSTRUCTIONS

A. "Network Page" (Claims 1, 30, 31)

Terms	IconFind's Proposed Construction	Google's Proposed Construction

network page	Page on the Internet, private corporate network, intranet, local area network or other network	Page on the Internet, private corporate network, intranet, local area network or other network wherein an image on a page does not constitute a page

IconFind's—and not Google's—proposed construction of the term "network page" is the same claim construction adopted by the Court in the Yahoo! Litigation, and is fully supported by the intrinsic record.

1. Google's Construction Is Not Supported By Judge Shubb's Claim Construction Order

In the Yahoo! Litigation, Judge Shubb construed the term presently at issue, "network page," to mean "Page on the Internet, private corporate network, intranet, local area network or other network." (Ex. B, Yahoo! Markman Order, p. 8). As with the other four constructions provided by Judge Shubb (which both parties agree to and request adoption by this Court), IconFind also requests that this Court adopt Judge Shubb's construction of "network page." Google, however, requests that this Court change Judge Shubb's construction of "network page" to import further limitations to the term "page," when Judge Shubb explicitly held that "the term 'page' needs no further construction." Id. Worse yet, Google requests that this Court modify Judge Shubb's construction not by defining what a network page is, but instead, what a network page is not. In particular, Google proposes to improperly include the negative limitation "wherein an image on a page does not constitute a page." In support, Google directly misquotes from the December 7, 2009 claim construction hearing. Put simply, this is not proper claim construction procedure or analysis.

Claims are to be interpreted in view of the intrinsic evidence – namely the claims themselves, the specification and the prosecution history. Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc). Importantly, limitations from the preferred embodiments or specific examples in the specification cannot be read into the claims.

Innogenetics, N.V. v. Abbott Labs., 512 F.3d 1363, 1370 (Fed. Cir. 2008) ("[T]his court will not at any time import limitations from the specification into the claims."). Google asks this Court not to import a limitation from the specification (which itself would be improper), but rather, to import a limitation from dicta in a judicial decision. Google cites no case law or other support for this abomination of the claim construction practice, and counsel for IconFind could find none. Instead, Google provides an abundance of law on collateral estoppel, but as Judge Shubb recently recognized, "[e]ven where the requirements for collateral estoppel are met, the decision to apply the doctrine is within the court's discretion." Tech. Licensing Corp. v. Thomson, Inc., 2010 U.S. Dist. LEXIS 21735, at *16 (E.D. Cal. Mar. 9, 2010).

In any event, to the extent collateral estoppel applies, it supports IconFind's proposal that "network page" should be given the same claim construction rendered by Judge Shubb – "Page on the Internet, private corporate network, intranet, local area network or other network." (Ex. B, Yahoo! Markman Order, p.8). Google's added negative limitation was not part of Judge Shubb's construction, and it would be improper to apply collateral estoppel to claim terms specifically not construed by Judge Shubb. Google's attempt to stretch the doctrine of collateral estoppel beyond any logical limit is unsupportable.

If the Court is inclined to consider the reasoning behind Judge Shubb's decision not to further construe the term "page," IconFind notes that its representation to Judge Shubb at the December 7, 2009 claim construction hearing was as follows:

> **THE COURT:** …You do not claim that an image which is on a page is a, quote, page, unquote, itself.
>
> **MR. HAAN:** ***An image itself, in and of itself the image file is not a page.***
>
> **THE COURT:** All right.

(Ex. D, Transcript of Proceedings, p.75) (emphasis added). Google's proposed negative limitation "wherein an image on a page does not constitute a page" is entirely different than IconFind's representation that an image file "in and of itself" is not a page. As set forth fully in IconFind's opening claim construction brief, while an image file in and of itself is not a page, an image file accessible over a network can be a page. (Pl.'s Brf., Dkt. 94, p.18). If Google wants to add the "concession" into the claim construction here, at least it should accurately reflect what IconFind's counsel actually said at the December 7, 2009 hearing. For these reasons standing alone, Google negative limitation should be expressly rejected by this Court, but there are more.

2. Google's Negative Limitation Is Not Supported By The Intrinsic Record

The Federal Circuit has long held that negative limitations must be supported by clear, express intent in the intrinsic record. Omega Eng'g, Inc. v. Raytek Corp., 334 F.3d 1314, 1323 (Fed. Cir. 2003) ("Our independent review of the patent document … reveals no express intent to confer on the claim language the novel meaning imparted by this negative limitation. Accordingly, we must conclude that there is no basis in the patent specification for adding the negative limitation.") (citation omitted). Patent examiners at the USPTO are likewise instructed through the Manual of Patent Examining Procedure. MPEP § 2173.05(i) ("Any negative limitation or exclusionary proviso must have basis in the original disclosure."). Google's citations to "material on the page" do not preclude a page from being made up solely of any particular content alone, such as text, images or videos. Indeed, the '459 patent expressly contemplates and claims methods for categorizing pages based on the types of files associated with a page. See e.g. Claims 8, 13-15 (Ex. A, '459 Patent, Col. 12-13). The specification describes this as follows:

> Third tier 16 is a division into one or more categories according to the type of files associated with a Web page. There are several different types of files,

> including text, graphics, audio, video, multimedia, and files for communications between persons. … The preferred embodiment of the invention includes the following five file-type categories: Visual 46, Audio 48, Multimedia 50, Text-only 52, and Communication 54. Category 46, Visual, includes files containing pictures, charts, graphs, and diagrams.

(Ex. A, '459 Patent, Col. 5, ll. 29-40). Thus, according to the teachings of the '459 patent, many different file types may be associated with a page, including "graphics" and "pictures." This supports that a page can be made up of any particular content or file type, such as text, images or videos, either solely or collectively. It certainly does not provide the requisite intrinsic support for Google's negative limitation. For these additional reasons, the intrinsic record does not support Google's negative limitation, and IconFind's proposed constructions should be adopted.

3. Google's Reference To The Yahoo! Settlement Is Improper

Google's introductory paragraph falsely states that Judge Shubb's claim construction Order "appeared to dispose of the Yahoo! case" (Def.'s Brf. at 1, Dkt. 98) and that IconFind was basically forced to capitulate into a settlement with Yahoo! (Id., p. 1, 8-9). The truth is that IconFind offered Google the same relative settlement terms as Yahoo!, but Google rejected the proposal as being more than an order of magnitude too high – so much for Google's misleading reference to the Yahoo! settlement, which is not even a proper claim construction factor in any event. Likewise, as part of the Yahoo! settlement and joint request for dismissal, it was ***IconFind*** that insisted the claim construction Order should remain "in full force and effect," as IconFind is perfectly comfortable with the actual claim constructions in Judge Shubb's Order, as opposed to the mischaracterization of the December 7, 2009 hearing transcript reflected in Google's brief.

B. Assigning said network page to one or more of [a plurality of] said list of categories (Claims 1, 31); A set of categories and subcategories to which the network page is assigned (Claim 30)

Terms	IconFind's Proposed Construction	Google's Proposed Construction
assigning said network page to one or more of [a plurality of] said list of categories	This element need not be construed separately and should be given its plain and ordinary meaning in the context of the intrinsic record as understood by a person of skill at the time of the invention. If the Court deems a construction is necessary, IconFind proposes: Assigning the network page to at least one of the categories	The creator of the web page choosing which one or more of [a plurality of] said list of categories characterize said network page
a set of categories and subcategories to which the network page is assigned	This element need not be construed separately and should be given its plain and ordinary meaning in the context of the intrinsic record as understood by a person of skill at the time of the invention. If the Court deems a construction is necessary, IconFind proposes: a set of categories and subcategories to which the network page is assigned where subcategories are combinations of categories	A set of categories and subcategories that were chosen by the creator of the web page as characterizing the network page

Google's arguments pertaining to the present limitations rely on its fundamentally flawed position that the '459 Patent "does not even suggest, much less support, a method in which a computer assigns network pages to categories." (Def.'s Brf. at 20, Dkt. 98). To the contrary, the '459 Patent was amended during prosecution to clarify that the series of steps are implemented on a computer. This amendment, like IconFind's construction, is fully supported. Google also seeks to add to and alter these limitations by including the "creator of the web page choosing,"

"chosen by the creator of the web page," "characterize said network page," and "characterizing the network page." These interpretations and additions are misguided and unnecessary.

1. The Prosecution History Demonstrates That The Claimed Step Of Assigning Is Implemented By A Computer, Not The Creator

Amendments made during prosecution clearly support—and require—that the claimed step of assigning is implemented by a computer, not the "creator" of the page.

Specifically, during prosecution of the application which issued as the '459 Patent, the examiner rejected all of the claims under 35 U.S.C. § 101, and stated "[t]he examiner suggest [*sic*] including limitation such as 'a computer implemented method' to clarify that the series of steps are implemented on a computer," as shown below:

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 3-32 ad 51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would not result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Note as presently written the claim simply recites a series of steps an abstract idea that can be implemented with a pen and paper. The examiner suggest including limitation such as "a computer implemented method" to clarify that the series of steps are implemented on a computer.

(Ex. C, Pros. History, IF000121). Consequently, the applicant amended all independent claims, stating "[i]n response, the preamble of claims 1, 32, and 51 are amended per the Examiner's

suggestion to satisfy the requirements of 35 U.S.C. § 101," (Ex. C, Pros. History, IF000114), as shown in exemplary amended claim 1 below:

> **AMENDMENTS TO THE CLAIMS**
>
> This listing of claims will replace all prior versions, and listings, of claims in the application:
>
> Claim 1 (currently amended): A computer implemented method of categorizing a network page, comprising:
>
> providing a list of categories, wherein said list of categories include a category for transacting business and a category for providing information, and wherein said list of categories include a plurality of categories based on the copyright status of material on a page; and
>
> assigning said network page to one or more of said list of categories.

(Ex. C, Pros. History, IF000109). Thus, as the prosecution history makes clear, the step of "assigning said network page" is performed by the computer.

Notably, this also undermines Google's argument that Judge Shubb's opinion supports that the claimed step of assigning is done manually. In particular, Google argues that its construction requiring that the creator assigns the network pages is consistent with Judge Schubb's statement that "[i]n the preferred embodiment, a designer of a network page manually assigns the page to appropriate categories by applying a 'categorization code' for each category to which the page is assigned." (Def.'s Brf., Dkt. 98, p. 19 (citing Ex. B, Yahoo! Markman Order, p.3)). Read in context, Judge Shubb's statement, including his citation to Col. 6:62-65 of the '459 Patent, clearly focus on the categorization code—not on the "manually" assigning. Indeed, the term "manual(ly)" appears nowhere in the '459 Patent or prosecution history. Even if Judge Shubb was correct as to his characterization of the preferred embodiment, the claims of the patent need not be construed as being limited to that embodiment. Gemstar-TV Guide Int'l, Inc. v. ITC, 383 F.3d 1352, 1366 (Fed. Cir. 2004). Thus, Judge Shubb's passing reference to "manually" assigning does not support Google's position and, more importantly, does not

overcome the clear import of the amendment made during prosecution requiring that the "assigning" step be implemented by a computer.

2. The Specification Supports The Computer Implemented Step Of Assigning The Network Page

Contrary to Google's assertions, the written description of the '459 Patent fully supports the claimed "computer implemented" method, including the step of "assigning" the network page.

The "assigning" step is described in the written description of the '459 Patent at Column 6, among other places, stating in pertinent part:

> The creator of a Web page may assign the Web page to any number or combination of the categories of three tiers 12,14, and 16, and one of the copyright-status categories 17, depending on which categories best characterize the Web page. **The steps of assigning a page to categories may be performed in several different ways known to those skilled in the art.** The creator may also decide not to assign the page to any of the categories of a particular tier. The creator may assign the page to one of the copyright-status 17 categories with or without also assigning the page to any of the categories of three tiers 12, 14, and 16. Thus, the copyright status categories 17 can be used in connection with the categories of some or all of three tiers 12, 14, and 16, alone, or not at all. The outcome of the categorization method is that a page is designated to be "in" or "within" the categories that best characterize the page.

(Ex. A, '459 Patent, Col. 6, ll. 12-27) (emphasis added). Ignoring this passage, Google argues that "[t]he '459 patent specification does not even suggest, much less support, a method in which a computer assigns network pages to categories." (Def.'s Brf., Dkt. 98, p. 20). To the contrary, the step of assigning is fully supported by this passage, including the statement that "[t]he steps of assigning a page to categories may be performed in several different ways known to those skilled in the art." That the written description does not spell out every last detail of how the computer assigns is of no consequence. The inventors are entitled to rely on the knowledge of those skilled in the art, and do not claim to have invented the single step of assigning a page, but rather, the novel combination of numerous steps including providing categories (including for

copyright status), assigning a page, providing a categorization label and controlling usage. The inventors expressly note that the step of assigning a page could be implemented by various ways known to those skilled in the art, which is consistent with black letter law on the written description requirement:

> the patent specification is written for a person of skill in the art, and such a person comes to the patent with the knowledge of what has come before. In re GPAC Inc., 57 F.3d 1573, 1579 (Fed. Cir. 1995). Placed in that context, it is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a person of skill in the art that the inventor possessed the invention and to enable such a person to make and use the invention without undue experimentation.

LizardTech, Inc. v. Earth Res. Mapping, Inc., 424 F.3d 1336, 1345 (Fed. Cir. 2005). Thus, the written description of the '459 Patent fully supports the claimed "computer implemented" method, including the step of "assigning" the network page.

3. Google's Proposals To Add The "creator of the web page choosing" and "chosen by the creator" Are Misguided

That the assigning step is performed by the computer also forecloses Google's argument that the present claim limitations pertain to the "creator" of the network page "choosing" categories. While **the specification** discusses "selection" or "choosing" of categories by a "creator" during application of the invention, it is clear from the prosecution history that **the claims** were written from the perspective of the computer. By importing the "creator" into the claims, Google inappropriately conflates the specification and claims. As the Federal Circuit has long held: "Specifications teach. Claims claim." Rexnord Corp. v. Laitram, 274 F.3d 1336, 1344 (Fed. Cir. 2001). When the inventors meant to use the terms "select" or "choose" in the written description, they did. For instance, the specification states "[b]y **selecting** one of the four copyright-status indicia and placing it on the end of the categorization label, the creator adds the information governing the use of the material." (Ex. A, '459 Patent, Col. 7, ll. 31-34) (emphasis

added). The specification further states "[t]he creator may or may not **choose** to include the copyright-status categories." (Ex. A, '459 Patent, Col. 8, ll. 1-2) (emphasis added). However, with respect to "assigning," the specification states "[t]he steps of **assigning** a page to categories may be performed in several different ways known to those skilled in the art." (Ex. A, '459 Patent, Col. 6, ll. 12-27) (emphasis added). "[W]hen an applicant uses different terms in a claim it is permissible to infer that he intended his choice of different terms to reflect a differentiation in the meaning of those terms." Innova/Pure Water v. Safari Water Filtration, 381 F.3d 1111, 1119 (Fed. Cir. 2004). Thus, the inventors' choice to use the term "assigning" in the claim language rather than "selecting" or "choosing" should be given deference. Moreover, that the assigning "may be performed in several different ways known to those skilled in the art" further supports that the step of "assigning" is not merely "selecting" or "choosing." Why would the expertise of a person skilled in the art be required if "assigning" merely meant "selecting" or "choosing"?

Importantly, that the claims were written from the perspective of the computer, including "assigning" categories, does not foreclose the selecting or choosing of categories by a human in practical application. The claimed inventions can in fact be employed in a system where a human selects or chooses the categories, and the corresponding assignment of such categories to the web page is carried out by the computer. The claims do not require that the computer "automatically" assign the categories, or detect the content and assign categories. Accordingly, as claimed, the computer can assign categories based on selections or choices made by humans. Thus, contrary to Google's arguments, IconFind's constructions are neither inconsistent with the goals of the '459 Patent nor impermissibly broad. For at least these reasons, the Court should reject Google's proposals to interpret the present limitations to include the "creator of the web page choosing" and "chosen by the creator."

4. The Court Should Also Reject Google's Attempt To Import The Limitations "characterize said network page" And "characterizing the network page"

Reviewing the present limitations in the context of the claims in which they appear demonstrates that Google's proposed language "characterize said network page" and "characterizing the network page" is simply unnecessary, and instead is just a transparent attempt to import limitations into the claims.

The terms "assigning said network page to one or more of said list of categories" and "a set of categories and subcategories to which the network page is assigned" are found in claims 1 and 30, respectively, as set forth below:

> 1. A computer implemented method of categorizing a network page, comprising: providing a list of categories, wherein said list of categories include a category for transacting business and a category for providing information, and wherein said list of categories include **a category based on copyright status of material on a page**; **assigning said network page to one or more of said list of categories**; providing a categorization label for the network page using the copyright status of material on the network page; and controlling usage of the network page using the categorization label and the copyright status of the network page.
>
> 30. A computer implemented method for categorizing a network page, comprising: providing a list of categories, wherein said list of categories include a category for transacting business and a category for providing information, and wherein said list of categories include a plurality of **categories based on the copyright status of material on a page**; providing a categorization code for labeling the network page with a categorization label, wherein said categorization label indicates **a set of categories and subcategories to which the network page is assigned**, and wherein said categorization label indicates the copyright status of material on the network page; and controlling usage of the network page using the categorization label and the copyright status of the network page.

(Exhibit A, '459 Patent, Col.12-13) (emphasis added). Significantly, the claim language also includes, as the inventors so intended, that the copyright status category(ies) pertain to "material on a page." Google's proposed language inappropriately modifies and broadens this limitation, requiring that categories "characterize said network page" and that the categorization label indicates categories "characterizing the network page." This proposal conflicts with the plain

language of the claims, which merely require for the category(ies) based on copyright status, that the category(ies) pertains to "material on a page,"—not that it necessarily "characterize" the whole network page. Google's construction clearly diverges from the claim language, when instead, the analytical focus of claim construction must begin with and remain centered on the language of the claims themselves. Interactive Gift Express, Inc. v. Compuserve, Inc., 256 F.3d 1323, 1331 (Fed. Cir. 2001).

While the specification may be used to aid in the interpretation of the claims, it may not be used as a source for adding extraneous limitations. To help avoid importing limitations, the en banc Federal Circuit court in Phillips explained that:

> One of the best ways to teach a person of ordinary skill in the art how to make and use the invention is to provide an example of how to practice the invention in a particular case. Much of the time, upon reading the specification in that context, it will become clear whether the patentee is setting out specific examples of the invention to accomplish those goals, or whether the patentee instead intends for the claims and the embodiments in the specification to be strictly coextensive.

Phillips v. AWH Corp., 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc). The specification discusses both "categorizing a page on a network, during or after the time that the page is created, according to the copyright status of the **material on the page**," and assigning "any number or combination of the categories of three tiers 12,14, and 16, and one of the copyright-status categories 17, depending on which categories best **characterize the Web page**." (Exhibit A, '459 Patent, Col. 3, ll.48-51 & Col. 6, ll. 13-16) (emphasis added). However, what the inventors expressly chose to include in the claims was "material on the page." Google's after-the-fact attempt to import "characterize said network page" and "characterizing the network page" into the claims improperly usurps the inventors' express intent, and should be rejected by the Court.

Google's proposals instead appear to be sought for the sole purpose of supporting its non-infringement case. In particular, requiring that categories "characterize" the page is inherently subjective. The categories must "characterize" the page according to whom? A web page creator? A web page viewer? Clearly, Google merely seeks to inject ambiguity into the claims so it can argue to the jury that its categories do not "characterize" the page. For this additional reason, the Court should reject Google's attempt to read "characterize said network page" and "characterizing the network page" into the claims.

C. Categories related to public domain, fair use only, use with attribution, and permission of copyright owner needed (Claims 6, 31)

Term	IconFind's Proposed Construction	Google's Proposed Construction
categories related to public domain, fair use only, use with attribution, and permission of copyright owner needed	This element need not be construed separately and should be given its plain and ordinary meaning in the context of the intrinsic record as understood by a person of skill at the time of the invention. If the Court deems a construction is necessary, IconFind proposes: Categories related to material that can be used freely without any restrictions, material meant to be used in accordance with accepted fair use guidelines, material accompanied by an attribution to the author or copyright owner, and material that cannot be used unless the copyright owner is first contacted for permission	Categories that indicate that the network page may be subject to each of the following licensing restrictions: (1) the network page may be used by others without any restrictions; (2) the network page may only be used for fair uses; (3) the network page may be used if attribution to the copyright owner is given; and (4) the network page may be used only when permission is granted by the copyright owner

Google's construction is grammatically incorrect in the context of the claim, otherwise contradicts the claim language, is at odds with the specification and is not supported by the prosecution history.

1. Google's Construction Violates Precepts Of English Grammar, And Improperly Applies The Copyright Status Category To The Whole Network Page

First, viewing the claim language as a whole demonstrates that Google's requirement that the network page be subject to "each of the following licensing restrictions" is grammatically incorrect. Claim 31 reads as follows:

> 31. A computer implemented method of categorizing a network page, comprising: providing a list of categories, wherein said categories include **a category based on the copyright status of material on a page**, and wherein the copyright status comprises **categories related to public domain, fair use only, use with attribution, and permission of copyright owner needed**; assigning said network page to one or more of a plurality of said list of categories; providing a categorization label for the network page using the copyright status of material on the network page; and controlling usage of the network page using the categorization label and the copyright status of the network page.

(Exhibit A, '459 Patent, Col. 14, ll. 34-51) (emphasis added). The present limitation (the second bolded phrase) appears in a wherein clause that modifies the preceding clause, "a category based on the copyright status of material on a page" (the first bolded phrase). Google's interpretation of the second phrase as subjecting the page to "each of the following licensing restrictions"—i.e. multiple categories—contradicts the clause it modifies, which merely requires "**a category** based on the copyright status"—i.e. a single category. As courts in this District and the Federal Circuit have recognized, "patent claims 'must be read in accordance with precepts of English grammar.'" Chiron Corp. v. Genentech, Inc., 266 F. Supp. 2d 1172, 1179 (E.D. Cal. 2002) (Shubb, J.) (quoting In re Hyatt, 708 F.2d 712, 714 (Fed. Cir. 1983)). Google's grammatically incorrect construction is simply wrong—"each" of the four categories need not be represented in the claimed "a category." Notably, the present limitation also appears in claim 6, which depends on independent claim 1. Like claim 31, claim 1 only requires "**a category** based on copyright

status…" (Exhibit A, '459 Patent, Col. 12, ll. 24-39).[1] Thus, Google's construction is likewise grammatically inconsistent with claim 1.

Second, Google's construction is otherwise at odds with the claim language because the first bolded phrase above plainly states "a category based on the copyright status of **material on a page**". Thus, the category pertains to "material on a page," and not necessarily the whole page. Google's interpretation of the second clause contradicts this clause by inappropriately requiring the following restrictions: "(1) **the network page may be used** by others without any restrictions; (2) **the network page may only be used** for fair uses; (3) **the network page may be used** if attribution to the copyright owner is given; and (4) **the network page may be used** only when permission is granted by the copyright owner." As the preceding claim language makes clear, the copyright status category merely pertains to "material on a page," so Google's "network page may only be used" language is overly restrictive, and not well-founded. For these reasons, Google's construction is contrary to the plain language of the claims.

2. IconFind's—Not Google's—Construction Is Supported By the Specification

IconFind's construction of this element includes the express definition of the categories provided in the specification of the '459 Patent, whereas Google seeks to include its own, unsupported definitions. The table below displays this clearly.

Term	Specification (Col. 5, ll. 48-58)	IconFind's Construction	Google's Construction
public domain	material that is in the public domain and can be used freely without any restrictions	material that can be used freely without any restrictions	the network page may be used by others without any restrictions
fair use only	Fair Use Only is material	material meant to be used	the network page

[1] Exhibits A through D of Plaintiff's opening brief, all cited herein, are filed again herewith for the Court's convenience, as well as to correct Exhibit C (prosecution history) which was incomplete as originally filed at Dkt. 94-3 through 94-8.

	meant to be used in accordance with accepted fair use guidelines	in accordance with accepted fair use guidelines	may only be used for fair uses
use with attribution	Use with Attribution is material that can be used as long as its use is accompanied by an attribution to the author or copyright owner	material accompanied by an attribution to the author or copyright owner	the network page may be used if attribution to the copyright owner is given
permission of copyright owner needed	Permission of Copyright Owner Needed is material that cannot be used unless the copyright owner is first contacted for permission	material that cannot be used unless the copyright owner is first contacted for permission	the network page may be used only when permission is granted by the copyright owner

See (Exhibit A, '459 Patent, Col. 5, ll. 48-58). As shown in the table, IconFind's construction of each of the categories is taken verbatim from the specification. Google's construction modifies these categories and, curiously, Google provided no support for these modifications in its opening brief. As an example, IconFind's construction of "fair use only" is "material meant to be used in accordance with accepted fair use guidelines," as expressly provided in the specification. For what reason should this Court interpret this element to mean "the network page may only be used for fair uses," as Google proposes? Because Google has offered no support for these modifications, its construction should be rejected.

3. Google Mischaracterizes The Prosecution History

Through its characterization of the prosecution history, Google would have this Court believe that the claims of the '459 Patent were allowed because the applicants added four specific copyright categories. Not so. While the four categories were added through amendment to the claim that ultimately issued as claim 31, the examiner sustained his rejection of claim 31 in view of the same prior art after the amendment. The applicant first amended claim 31 (prosecution claim 51) as follows:

> Claim 51 (currently amended): A computer implemented method of categorizing a network page, comprising:
>
> providing a list of categories, wherein said categories include a plurality of categories based on the copyright status of material on a page, and wherein the copyright status comprises categories related to public domain, fair use only, use with attribution, and permission of copyright owner needed; and
>
> assigning said network page to one or more of a plurality of said list of categories.

(Ex. C, Pros. History, IF000113). Subsequently, the examiner rejected the claim in view of the same prior art, stating in pertinent part:

> 7. Claims 1, 3-6, 8-32 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole et al. US Patent 5,933,827.

> 9. Regarding claim 51, "wherein said categories include a plurality of categories based on copyright status of material on a page..." [note: Cole et al. provides for user ability to define the category see column 4 lines 30-66; also note column 5 lines 60 through column 6 line 4].

(Ex. C, Pros. History, IF000113). Though the applicant continued to debate with the examiner over whether the prior art disclosed these categories, the applicant otherwise amended claim 31 (prosecution claim 51) adding further steps to the method to obtain allowance, as follows:

> Claim 51 (Currently amended): A computer implemented method of categorizing a network page, comprising:
>
> providing a list of categories, wherein said categories include a [[plurality of categories]] category based on the copyright status of material on a page, and wherein the copyright status comprises categories related to public domain, fair use only, use with attribution, and permission of copyright owner needed; [[and]]
>
> assigning said network page to one or more of a plurality of said list of categories[[.]];
>
> providing a categorization label for the network page using the copyright status of material on the network page; and
>
> controlling usage of the network page using the categorization label and the copyright status of the network page.

(Ex. C, Pros. History, IF000067). These last two method steps were identified in the examiner's statement of reasons for allowance, while the four specific copyright categories were not. (Ex. C, Pros. History, IF000025). Thus, the four specific copyright categories were not what the examiner deemed novel over the prior art, as Google submits.

Not insignificantly, while amending claim 31 to add the last two steps, the applicant also deleted the requirement of a "plurality of categories" based on copyright status, as the figure above clearly shows. This demonstrates an express intent by the inventors that claim 31 does not require a plurality of copyright status categories as Google proposes, but instead, that the single copyright status category required is related to any (not each) of the four categories provided, as IconFind's construction properly conveys. For this additional reason, standing alone, Google's construction must be rejected.

III. CONCLUSION

For all of the foregoing reasons, IconFind's proposed constructions are the correct constructions, and IconFind requests that the Court adopt them in their entirety.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on June 12, 2012 the foregoing:

PLAINTIFF ICONFIND, INC.'S RESPONSIVE CLAIM CONSTRUCTION BRIEF

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