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8
 9 **UNITED STATES DISTRICT COURT**
 10 **FOR THE EASTERN DISTRICT OF CALIFORNIA**

11 ICONFIND, INC.,)
)
 12 Plaintiff,)
)
 13 v.)
)
 14 GOOGLE INC.,)
)
 15 Defendant.)
)
 16)
 17)
 18)

Case No. 2:11-CV-00319 GEB JFM

**DEFENDANT GOOGLE INC.'S
 RESPONSIVE CLAIM CONSTRUCTION
 BRIEF**

Date: July 23, 2012
 Time: 9:00 a.m.
 Location: Courtroom 10
 The Honorable Garland E. Burrell, Jr.

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NOTES ON CITATIONS

The following citation conventions are used in this brief:

- Google = Google Inc.
- IconFind = IconFind, Inc.
- '459 patent = the patent-in-suit, U.S. Patent No. 7,181,459, attached as Exhibit A to the Joint Claim Construction Statement (Dkt. 93)
- XX:YY = column number: line number(s) of the '459 patent
- Pros. History = the prosecution history of the '459 patent, attached as exhibit B to the Joint Claim Construction Statement (Dkt. 93), each citation to the prosecution history will contain the Bates number(s) of the page(s) being cited
- The *Yahoo!* Case = *IconFind Inc. v. Yahoo! Inc.*, Case No. 09-109 WBS JFM (E.D. Cal.)
- Cl. Constr. = Memorandum And Order Re: Motion For Claim Construction in *IconFind Inc. v. Yahoo! Inc.*, Case No. 09-109 WBS JFM (E.D. Cal.), attached as exhibit 1
- Ex. = Exhibit
- Pl. Brief = Plaintiff's Opening Claim Construction Brief (Dkt. 94)
- Def. Brief = Google's Opening Claim Construction Brief (Dkt. 98)

The following exhibits were attached to the Declaration of Kenneth M. Maikish in support of Google's Inc.'s Opening Claim Construction Brief:

<i>Exhibit</i>	<i>Description</i>
1	Memorandum And Order Re: Motion For Claim Construction (<i>Yahoo!</i> Case, Dkt. 50)
2	Neil Randall and Dennis Jones, USING FRONTPAGE [®] 2000, 304-324, (Mark Taber, ed., Que 1999)
3	Selected screenshots from the Internet Archive's archive of the SourceForge website, collected between June 20, 2000 and December 5, 2000
4	IconFind's Objections and Responses to Interrogatory Nos. 1-8

1	5	Excerpt from Reporter's Transcript Of Proceedings, Defendant's Motion For Claim Construction Monday, December 7, 2009 (<i>Yahoo!</i> case, Dkt. 54, pp. 71-76)
2		
3	6	IconFind's <i>Ex Parte</i> Application For Leave To File A Supplemental Response To The Court's December 7, 2009 Question Regarding "Network Page" (<i>Yahoo!</i> case, Dkt. 49)
4		
5	7	Order On IconFind's <i>Ex Parte</i> Application For Leave To File A Supplemental Response To The Court's December 7, 2009 Question Regarding "Network Page" (<i>Yahoo!</i> case, Dkt. 53)
6		
7	8	Stipulated Order Of Dismissal (<i>Yahoo!</i> case, Dkt. 61)
8	9	A copy of the <i>About</i> page from Creative Commons' website, available at http://creativecommons.org/about
9		
10	10	A copy of the <i>About The Licenses</i> page from Creative Commons' website, available at http://creativecommons.org/licenses/
11	11	A copy of the <i>Our Supporters</i> page from Creative Commons' website, available at http://creativecommons.org/supporters/
12		
13	12	Plaintiff's Response To Google Inc.'s First Set Of Requests For Admission
14	13	Deposition Transcript for Lee H. Grant, pp. 92-95
15	14	Joint Statement re Discovery Disagreement - Infringement Contentions (Dkt. 88)
16		

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20 The following exhibits are attached to the Declaration of Kenneth M. Maikish in support of
21 Google's Inc.'s Responsive Claim Construction Brief:

<i>Exhibit</i>	<i>Description</i>	
22		
23	15	Neil Randall and Dennis Jones, USING FRONTPAGE® 2000, 122-29, (Mark Taber, ed., Que 1999)
24		
25	16	Screenshot of the Firefox web browser displaying a copy of football.jpg located on a CD-ROM
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27	17	Screenshot of the Firefox web browser displaying a copy of football.jpg accessible over the Internet
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18	Screenshot of the Firefox web browser displaying a copy of football.jpg accessible over a corporate network
19	Screenshot of <i>Share files and folders over the network (from Windows Vista Inside Out)</i> , available from the Microsoft® website.
20	Screenshot of the Windows Picture and Fax Viewer displaying a copy of football.jpg located on a CD-ROM
21	Screenshot of the Windows Picture and Fax Viewer displaying a copy of football.jpg accessible over a corporate network

1 **I. RESPONSE TO ICONFIND’S ARGUMENTS**

2 Plaintiff is running away from a key concession it made in the *Yahoo!* Case—calling it a
 3 “comment” and referring to Judge Shubb’s reliance upon it as “dicta.” (Pl. Brief at 17.) Plaintiff’s
 4 attempt to trivialize its earlier representations to the court fail. Judge Shubb specifically requested
 5 Plaintiff’s position concerning what constitutes a “page” in order to resolve the dispute between the
 6 parties. At the hearing, Plaintiff’s counsel was given a full and fair opportunity to state its position.
 7 Judge Shubb reviewed the evidence and issued a Claim Construction Order in reliance on
 8 Plaintiff’s concession. Plaintiff is now attempting to recall its words and change its position. This
 9 about face is barred by collateral and judicial estoppel. Further, Plaintiff’s new argument that an
 10 image is transformed into a “page” based on whether the file is accessible over a network is
 11 directed at the wrong term, unsupported, and illogical.

12 Regarding the other terms at issue, Plaintiff offers only vague assertions of Google’s
 13 purported violations of claim construction law while offering no evidence to support its
 14 constructions. Plaintiff’s expansive and litigation-inspired constructions should be rejected.
 15 Google’s constructions are supported by the claims, specification, and the prosecution history and
 16 should be adopted.

17 **II. THE COURT SHOULD ADOPT GOOGLE’S PROPOSED CLAIM**
 18 **CONSTRUCTIONS**

19 A. “network page” (Claims 1-31)

Google’s Construction	IconFind’s Construction
<u>Network Page</u> : 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.	<u>Network Page</u> : Page on the Internet, private corporate network, intranet, local area network or other network.

20 Whether an image on a page is a “page” was fully litigated in the *Yahoo!* Case. An image
 21 on a page does not constitute a “page.” (Cl. Constr. at 8.) Plaintiff’s attempt to run away from the
 22 concession it made to Judge Shubb is futile. Judge Shubb relied on Plaintiff’s concession in the
 23 Court’s Claim Construction Order, and the law does not allow Plaintiff to relitigate this issue.
 24
 25
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1 **1. Plaintiff Is Collaterally Estopped From Taking A Position Contrary To**
2 **Judge Shubb's Order**

3 Judge Shubb's Claim Construction Order is binding on IconFind under collateral estoppel.
4 *Curtiss-Wright Flow Control Corp. v. Z & J Techs.*, 563 F. Supp. 2d 1109, 1121-22 (C.D. Cal.
5 2007) (ruling that a plaintiff is bound by a prior claim construction order issued by a Texas district
6 court); *Int'l Gamco v. Multimedia Games Inc.*, 732 F. Supp. 2d 1082, 1089-92 (S.D. Cal. 2010)
7 (applying Ninth Circuit law in holding that collateral estoppel applies to bar plaintiff from
8 challenging prior claim construction order).

9 Under Ninth Circuit law, collateral estoppel applies if: "(1) the issue necessarily decided at
10 the previous proceeding is identical to the one which is sought to be relitigated; (2) the first
11 proceeding ended with a final judgment on the merits; and (3) the party against whom collateral
12 estoppel is asserted was a party or in privity with a party in the first proceeding." *Hydranautics v.*
13 *FilmTec Corp.*, 204 F.3d 880, 885 (9th Cir. 2000). Ninth Circuit law, not Federal Circuit law,
14 controls this issue. *See Int'l Gamco, Inc. v. Multimedia Games Inc.*, 732 F. Supp. 2d 1082, 1091
15 (S.D. Cal. 2010). In this case, the first element is satisfied because construction of the same term is
16 at issue. The last element is also satisfied because Plaintiff was a party to the *Yahoo!* Case.

17 With regard to the second element, the first proceeding, the *Yahoo!* Case, ended with a final
18 judgment because a *Markman* Order is sufficiently final under Ninth Circuit precedent, even where
19 the parties settle prior to a ruling on validity or infringement. *See Int'l Gamco*, 732 F. Supp. 2d at
20 1091 (finding that collateral estoppel barred plaintiff from relitigating the construction of claim
21 terms previously construed by another district court even though the parties settled after the claim
22 construction and before a ruling on infringement or validity). Furthermore, Plaintiff could have
23 moved the Court to vacate the Claim Construction Order in dismissing the *Yahoo!* Case. *See Dana*
24 *v. E.S. Originals, Inc.*, 342 F.3d 1320, 1328-29 (Fed. Cir. 2003) (Dyk, J., concurring) (noting that
25 parties to patent infringement actions should consider requesting that the district court vacate
26 judgments as part of the settlement to avoid future estoppel). Plaintiff chose not to move the Court
27 to vacate the Claim Construction Order. In fact, the Order Of Dismissal, proposed by **both** parties
28 in the settlement agreement, specifically states that the Claim Construction Order "remains in full

1 force and effect.” (Ex. 8 at 2.) Therefore, Plaintiff is estopped from taking positions contrary to
2 Judge Shubb’s Order. *See TM Patents, L.P. v. Int’l Business Machines Corp.*, 72 F. Supp. 2d 370
3 (S.D.N.Y. 1999) (barring plaintiff from relitigating the construction of claims construed in a
4 previous action on the same patent, even though the previous case settled before the jury ruled on
5 infringement or validity).

6 Plaintiff argues that it is not asserting a position contrary to Judge Shubb’s Order by
7 asserting that its argument is with Google: “Google twists [IconFind’s concession at oral
8 argument] to argue that an image ‘on’ a page is not a ‘network page.’ This is simply not the case.”
9 (Pl. Brief at 18.) However, it was not Google that concluded “an image on a ‘page’ does not
10 constitute a ‘page,’” *it was Judge Shubb*. (Ex. 5 at 75-76 (“I don’t think we need to define the
11 word ‘page’ because everybody understands what it means. It doesn’t mean an image, it means a
12 page.”); Cl. Constr. at 8 (“At oral argument, counsel for the plaintiff conceded that an image on a
13 ‘page’ did not constitute a ‘page.’ . . . Therefore, the term ‘page’ needs no further construction, . . .
14 .”).) Plaintiff is attempting to overturn Judge Shubb’s ruling, not Google’s argument, by arguing
15 that an image on a page is a “page.” Plaintiff is collaterally estopped from making this argument.

16 **2. Google’s Construction Adopts The Basis For Judge Shubb’s** 17 **Construction Of The Term “Network Page”**

18 Plaintiff presented its current construction of the term “page” in the *Yahoo!* Case. During
19 oral argument, Judge Shubb established that neither party contended that an image on a page
20 constituted a page. (Ex. 5 at 74-75.) Judge Shubb summarized Plaintiff’s position and gave
21 Plaintiff’s counsel an opportunity to disagree with his conclusion:

22 THE COURT: ... You do not claim that an image which is on a page is a, quote,
23 page, unquote, itself.

24 MR. HAAN [for Plaintiff IconFind]: An image itself, in and of itself the image file is not a
25 page.

26 THE COURT: All right.

27 (*Id.* at 75.) If Plaintiff’s counsel disagreed with the Court’s interpretation of Plaintiff’s argument,
28 counsel had the opportunity to correct the Court. Plaintiff’s counsel did not, and, instead, agreed

1 with the Court’s interpretation. The Court understood this concession to mean that an image on a
2 page was not a “page”:

3 THE COURT: ... I don't think we need to define the word "page" because
4 everybody understands what it means. It doesn't mean an image, it means a page.
5 (*Id.* at 75-76.) The Court’s Claim Construction Order did not separately construe the term “page”
6 *because* of Plaintiff’s concession. (Cl. Constr. at 8 (“At oral argument, counsel for the plaintiff
7 conceded that an image on a ‘page’ did not constitute a ‘page.’ The parties then agreed that the
8 term ‘page’ did not need to be further defined. *Therefore*, the term ‘page’ needs no further
9 construction, and the court concludes that the term ‘network page’ means ‘Page on the Internet,
10 private corporate network, intranet, local area network of other network.”) (emphasis added).)
11 Judge Shubb found that the term “page” did not require construction because the parties agreed that
12 an image on a page does not constitute a page. (*Id.*)

13 Plaintiff now calls this section of Judge Shubb’s Order “dicta.” (Pl. Brief at 17.) This
14 assertion is contradicted by the Order itself. First, as shown above, the concession was the basis
15 for the decision not to construe the term “page.” Second, Judge Shubb devoted only six sentences
16 to explain the construction of “network page.” Far from dicta, the three sentences quoted above
17 constitute the most substantive part of Judge Shubb’s essential determination. *See Export Group v.*
18 *Reef Indus., Inc.*, 54 F.3d 1466, 1472 (9th Cir. 1995) (adopting Black's Law Dictionary definition
19 of “dictum” as “an observation or remark ... not necessarily involved in the case or essential to its
20 determination”). In addition to the quoted sentences, the Order states alternative support for its
21 finding that an image on a page is not a page in the claim language itself. (Cl. Constr. at 8 (“The
22 patent claims clearly distinguish ‘network page’ from ‘material on a page’ and ‘material on the
23 network page.’”)) The remainder of that section addresses the nature of the dispute and the
24 construction of “network.” (*Id.*)

25 Plaintiff’s argument that Judge Shubb’s discussion of Plaintiff’s concession was merely
26 “dicta” is unsupportable. Plaintiff’s concession at oral argument was the basis for Judge Shubb’s
27 construction of the term “network page” and should be incorporated into this Court’s Order.
28

1 **3. Google's Construction Is Proper In Light Of The Record In**
2 **The *Yahoo!* Case**

3 Google's construction is correct because it provides the jury with Judge Shubb's important
4 findings. Without the additional language in Google's construction, the jury would have to arrive
5 at this conclusion without Judge Shubb's guidance.

6 Plaintiff now argues that the concession in the *Yahoo!* Case was qualified by Plaintiff
7 counsel's use of the words "in and of itself." (Pl. Brief at 18 (quoting Ex. 5 at 75).) There are four
8 problems with this argument.

9 First, the argument that Plaintiff's counsel made a meaningful qualification at the claim
10 construction hearing is belied by the transcript and the Order. Judge Shubb understood Plaintiff's
11 concession to be an unqualified admission that an image on a page does not constitute a page. (Ex.
12 5 at 75-76 ("THE COURT: . . . I don't think we need to define the word 'page' because everybody
13 understands what it means. It doesn't mean an image, it means a page"); Cl. Constr. at 8 ("At oral
14 argument, counsel for the plaintiff conceded that an image on a 'page' did not constitute a
15 'page.'")) Plaintiff's counsel had a chance to correct Judge Shubb at oral argument but did not do
16 so. As a result, Judge Shubb understood Plaintiff's concession to mean that an image on a page
17 does not constitute a "page." Plaintiff's current attempts to recall its words should be denied.

18 Second, the words "in and of itself" do not mean anything in this context and Plaintiff fails
19 to explain their alleged significance. (Pl. Brief at 18.) In this context, an image is a digital file.
20 Plaintiff does not articulate how these words alter that meaning. (*Id.*) Furthermore, Plaintiff fails
21 to explain why the words "in and of itself" support its new theory that an image "accessible over a
22 network" is somehow transformed into a "page." (*Id.*)

23 Third, in addition to relying on Plaintiff's concession, Judge Shubb relied on the claim
24 language to support his finding that an image on a page is not a "page." (Cl. Constr. at 8 ("The
25 patent claims clearly distinguish 'network page' from 'material on a page' and 'material on the
26 network page.'")) As a result, even if Plaintiff's supposed qualification changes the meaning of
27 the statement, Judge Shubb independently concluded that an image on a page does not constitute a
28 "page" based on an analysis of the claim language. His conclusion should stand.

1 Last, Judge Shubb considered and rejected Plaintiff's current position regarding the image
2 "in and of itself." Plaintiff advanced this same argument in a motion following the claim
3 construction hearing. (Ex. 6.) Judge Shubb considered and denied the motion. (Ex. 7.) Thus, this
4 is Plaintiff's *third* attempt to litigate its position on the construction of the term "page."

5 Plaintiff's admission that an image on a page does not constitute a "page" should be
6 incorporated into this Court's Order so that the jury may benefit from Judge Shubb's findings.

7 **4. An Image On A Page Does Not Constitute A "Page" Regardless Of**
8 **Whether The Image Is "Accessible Over A Network"**

9 After claim construction briefing, oral argument, and the motion to supplement, Judge
10 Shubb concluded that an image on a page does not constitute a "page." (Cl. Constr. at 8.)
11 Reversing course from its position at oral argument in the *Yahoo!* Case, Plaintiff now argues that
12 an image on a CD-ROM is not a page, but that *same* image is a "page" when it is "accessible over
13 a network." (Pl. Brief. at 18.) As discussed above, this argument is contradicted by Plaintiff's
14 concession in the *Yahoo!* Case as well as Judge Shubb's Order. It is also wrong.

15 Making a file accessible over a network does not change the file. An image file on a CD-
16 ROM is not transformed into a "page" when it is placed on a server accessible over a network. The
17 image file on the CD-ROM and the image file on the server are identical. No definition of the term
18 "page" discusses whether the file is accessible over a network or not. Plaintiff's argument is that
19 the manner in which the file is *accessed* transforms the image into a "page." (*Id.*) This argument
20 is directed at the wrong term, unsupported, and illogical.

21 **a. Plaintiff's Argument Is Directed At The Wrong Term**

22 Plaintiff's "access theory" is directed at the wrong term. The "network" part of the term
23 "network page" describes the means by which the "page" may be accessed, not the "page" part.
24 Judge Shubb construed the term "network" to mean "Internet, private corporate network, intranet,
25 local area network or other network" in order to address how the "page" might be accessed. (Cl.
26 Constr. at 8.) Judge Shubb understood that a "page" could be accessed by a variety of means and
27 incorporated those means into his construction of the term "network." Yet, Plaintiff asserts that the
28

1 means of access determine whether an image is a “page.” (Pl. Brief at 18 (“While an image file in
2 and of itself is not a page, an image file accessible over a network can be a page.”).) This
3 argument is contradicted by Judge Shubb’s construction of the term “network page” which already
4 states that a “page” may be accessed over a network. (Cl. Constr. at 8 (construing the term
5 “network page” to mean “Page on the Internet, private corporate network, intranet, local area
6 network or other network).)

7 Plaintiff’s theory requires this Court to consider the means by which digital content, *e.g.*, an
8 image, is accessed in order to determine whether or not the digital content is a “page.” But, the
9 method of access was addressed in Judge Shubb’s construction of the term “network.” It has no
10 place in the definition of the term “page.” Therefore, Plaintiff’s argument is directed at the wrong
11 term.

12 **b. Plaintiff’s Argument Is Wholly Unsupported**

13 Plaintiff offers no explanation for its new “access theory” other than offering an URL¹ that
14 points to an image (<http://statefansnation.com/wp-content/uploads/2009/06/football.jpg>) and then
15 stating its conclusion. (Pl. Brief at 18.) The URL offered by Plaintiff is the address of a file called
16 ‘football.jpg,’ which is a JPEG image file. Plaintiff does not explain why making the image file
17 accessible over a network transforms the image into a “page,” it simply states its conclusion as its
18 argument. (Pl. Brief at 18 (“As that address clearly indicates, that particular page is made up solely
19 of an image.”).) Plaintiff also offers no support (no citation to the patent, the file history, or even
20 to any extrinsic evidence) for its litigation-inspired theory that the accessibility of an image
21 transforms the image into a “page.” A JPEG file is an image regardless of its location and
22 regardless of its accessibility from a network. (*See* Ex. 15 at 122 (“Graphics inserted into a Web
23 page are called inline images. The two most common graphic file formats for Web publications
24 are GIF [...] and JPEG (Joint Photographic Experts Group”).)

25
26
27 ¹ An URL is a Uniform Resource Locator used to define a reference to any object on a network.
28

1 Following Plaintiff’s line of reasoning, *any file* stored on a server and “accessible over a
2 network” constitutes a “page.” (Pl. Brief at 18.) This would include applications or programs
3 accessible over a network. For example, the VLC media player application from VideoLAN is
4 accessible over a network at [http://download.videolan.org/pub/videolan/vlc/2.0.1/win32/vlc-2.0.1-](http://download.videolan.org/pub/videolan/vlc/2.0.1/win32/vlc-2.0.1-win32.exe)
5 [win32.exe](http://download.videolan.org/pub/videolan/vlc/2.0.1/win32/vlc-2.0.1-win32.exe). This URL allows a user to download and install the application. The fact that the VLC
6 application is accessible over a network does not transform it into a “page,” it is still an application
7 (as shown by its .exe extension). In fact, any digital file on a server can be accessed over a
8 network by pointing appropriate software to the URL, this includes videos (*e.g.*, .mpg and .wmv
9 files), source code files (*e.g.*, .java and .c files), audio files (*e.g.*, .mp3 and .wav files), compressed
10 files (*e.g.*, a .zip file), emails (*e.g.*, a .msg file), TurboTax® files (*e.g.*, a .tax file), and many other
11 types of files. The fact that a file is accessed over a network does not transform the file into
12 something else. An image file accessed on a CD-ROM, like an executable application file, is
13 identical to a copy of that same file accessible over a network.

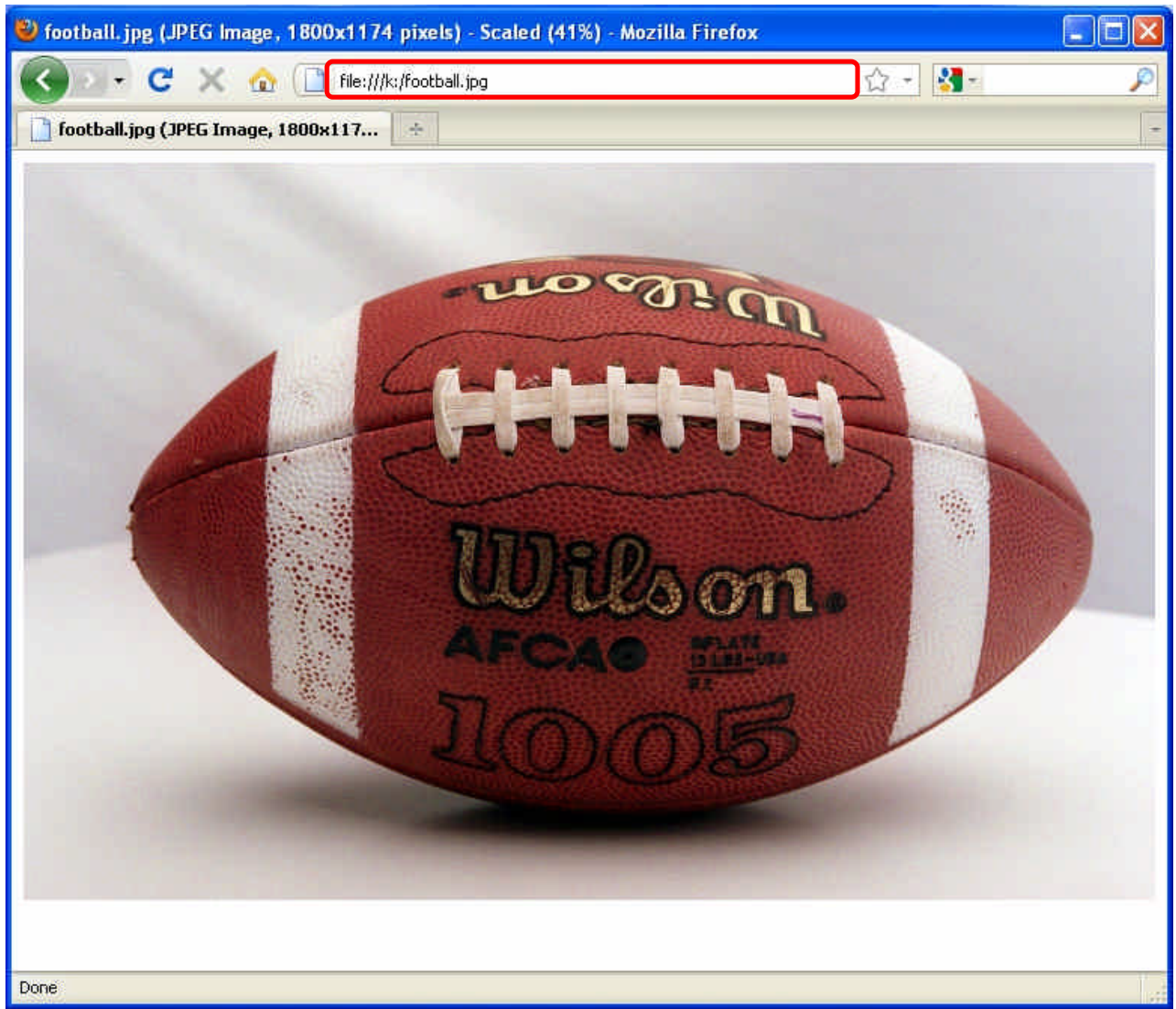
14 Documentary evidence also illustrates the flaws in Plaintiff’s theory. For example, the
15 Using Microsoft® FrontPage® User Manual² explains how a user places an image on a web page
16 when the image is in a local folder, for instance a CD-ROM drive. (Ex. 15 at 124 (“Putting an
17 Image onto a Page After you add a graphic to the *images* folder, use the following steps to
18 insert it onto your page:”)) The FrontPage Manual also explains how a user places an image onto
19 a page where the image is on a remote site, available over the Internet. (Ex. 15 at 128 (“Inserting
20 Images from a Remote Site: You can also access image at other sites, both in webs on your local
21 host and on the World Wide Web”)) The FrontPage Manual illustrates that those skilled in the art
22 recognize that images are often incorporated as an element on web pages regardless of whether the
23 images are accessible over a network or on a local drive, such as a CD-ROM drive. Further, the
24 FrontPage Manual shows that those skilled in the art recognize that an “image” is distinct from a
25 “page.” (See Ex. 15 at 124 (“Putting an Image onto a Page”))

26 ² Neil Randall and Dennis Jones, Using FrontPage® 2000 (Mark Taber, ed., Que 1999)
27 [hereinafter “FrontPage Manual”].

c. **Plaintiff's Argument Is Illogical Because Images Accessed Over A Network Are Identical To Those Accessed From A CD-ROM**

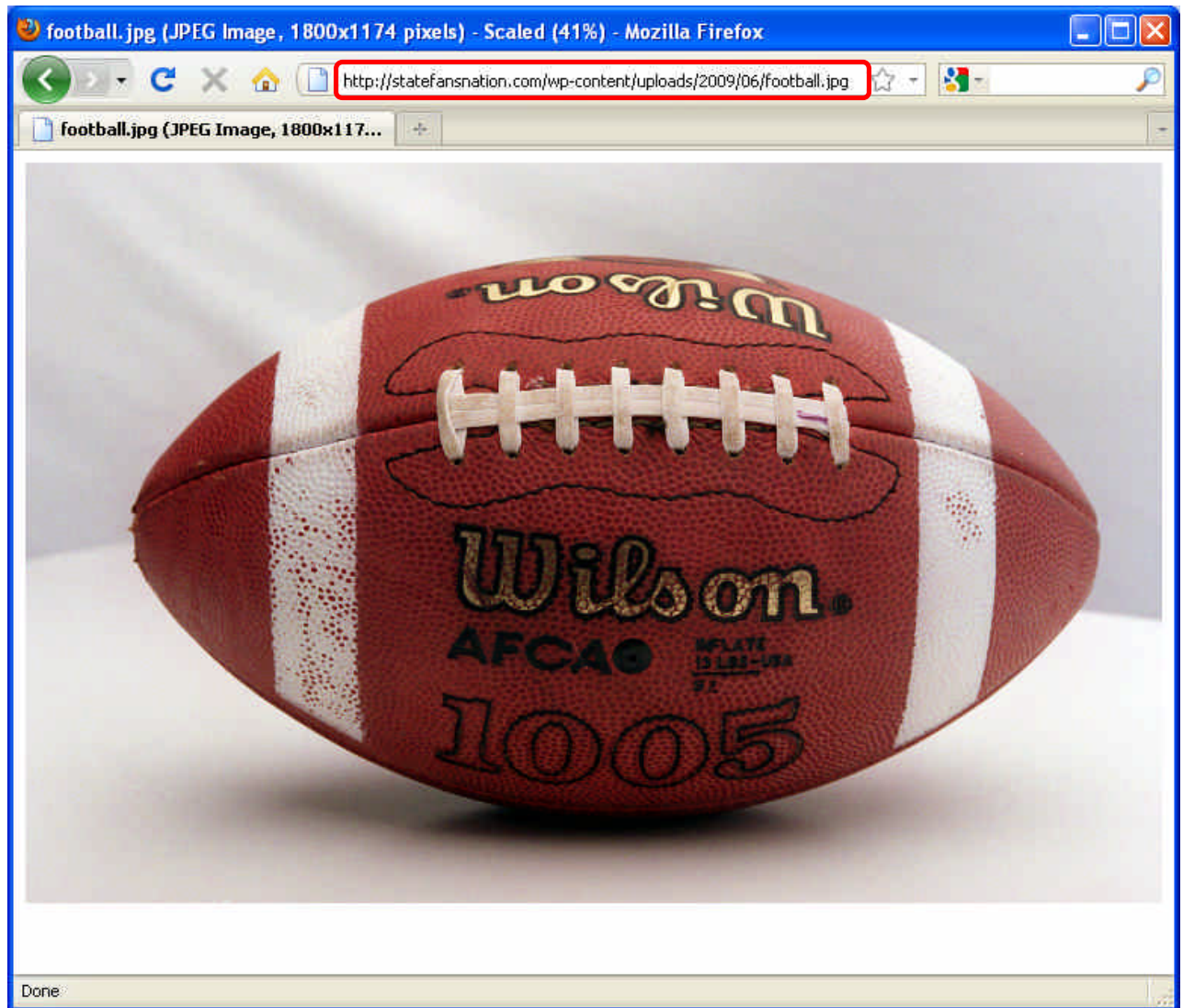
Images are not pages, they are images. No logical argument supports Plaintiff's "access theory." To illustrate this fact, three screenshots are provided below. In the first, a copy of football.jpg is accessed from a CD-ROM by a common application, the Firefox web browser. In the second, a copy of football.jpg is accessed from the URL provided by Plaintiff. In the third, a copy of football.jpg is accessed over a corporate network. There is no difference between the exhibits except for the URL in the address bar (highlighted in red).

First, Firefox accessing football.jpg from a CD-ROM:



(Ex. 16.)

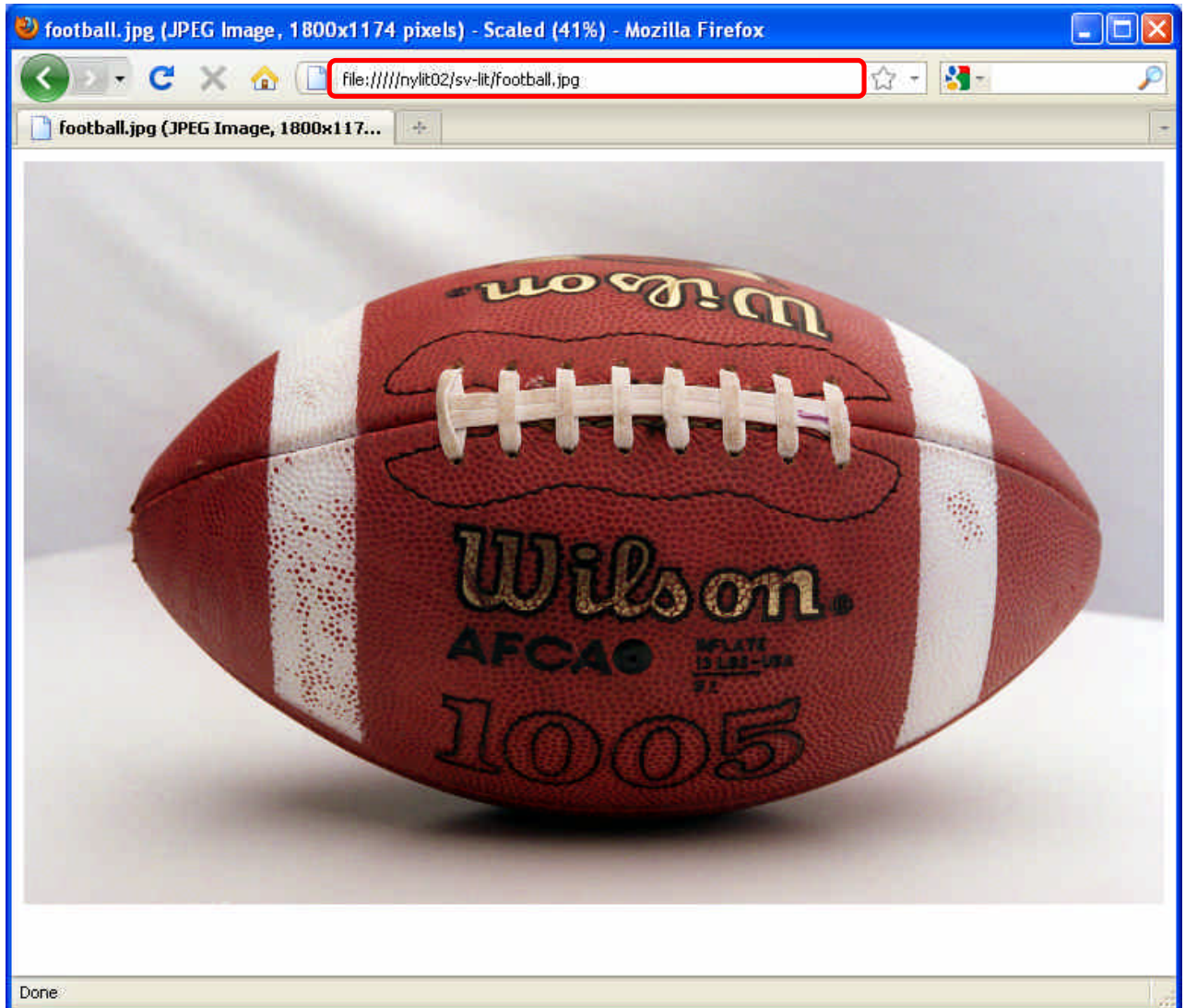
1 Next, Firefox accessing football.jpg over a network at the location provided by the Plaintiff:



(Ex. 17.) The exhibits are identical except for the URL in the address bar. Yet, Plaintiff asserts that Ex. 16 is displaying an image and Ex. 17 is displaying a “page.” Plaintiff offers no explanation for why these two identical files are different.

There is no difference. Firefox even informs the viewer that it is displaying *an image* in both exhibits. The title bar states “football.jpg (JPEG Image, 1800x1174 pixels)” in both exhibits. (Exs. 16 and 17.)

1 As another example, Ex. 18 shows Firefox accessing the image over a corporate network:



20 Again, the exhibit is identical except for the address.

21 Many people access files over a network without being aware that they are doing so
22 because the file is accessed in exactly the same way regardless of its location. At many
23 corporations, and some home networks, files may be placed in a folder on a server, commonly
24 referred to as a “network folder,” “share folder,” or “share drive.” These files are accessible over
25 the network, but the user’s interaction with these files is identical to their interaction with local
26 files, like files on a CD-ROM. (See Ex. 19 (“This article shows you how browsing through a
27 network folder is just like browsing through a folder on your [local] hard disk.”).) Ex. 20 shows
28 Microsoft’s standard Windows Picture and Fax Viewer application displaying a copy of

1 football.jpg located on a CD-ROM. Ex. 21 shows the same application displaying a copy of
2 football.jpg located on a remote server accessed over a corporate network. The only difference
3 between the exhibits is the location of the file. *See* Declaration Of Kenneth M. Maikish In Support
4 Of Google's Inc.'s Responsive Claim Construction Brief, at ¶¶ 7-8 (filed herewith).

5 In short, beyond the fact that Plaintiff is now walking away from a concession made at oral
6 argument and relied on by Judge Shubb in his Claim Construction Order, Plaintiff's argument is
7 directed at the wrong term, unsupported, and illogical. Making an image accessible over a network
8 does not transform the image into a "page." This argument should be rejected.

9 **5. Plaintiff Is Judicially Estopped From Taking A Position Contrary To Its**
10 **Position In The *Yahoo!* Case**

11 Plaintiff is judicially estopped from arguing that an image on a page does not constitute a
12 page. Judicial estoppel "prevents a party from asserting a claim in a legal proceeding that is
13 inconsistent with a claim taken by that party in a previous proceeding." *New Hampshire v. Maine*,
14 532 U.S. 742, 749 (2001) (citing 18 Moore's Federal Practice § 134.30, p. 134-62 (3d ed. 2000)).
15 The Supreme Court outlined the guidelines for finding judicial estoppel in federal courts: (1) a
16 party's later position must be "clearly inconsistent" with its earlier position; (2) the party must have
17 succeeded in persuading a court to accept that party's earlier position; and (3) the party would
18 derive an unfair advantage or impose an unfair detriment on the opposing party if not estopped. *Id.*
19 at 750-51.

20 With regard to the first element, Plaintiff's positions are "clearly inconsistent." In the
21 *Yahoo!* Case, Plaintiff's counsel stated that an image on a page does not constitute a page:

22 THE COURT: Is it your position that page could be an image which is found on a
23 web page?

24 MR. HAAN [counsel for IconFind]: That the image itself constitutes a network
25 page?

26 THE COURT: Yeah. Is that your position?

27 MR. HAAN: No, that's not our position.
28

1 (Ex. 5 at 74.) In this case, in its opening brief, Plaintiff used two and a half pages to argue that
2 Google's construction is incorrect because it includes the statement "wherein an image on a page
3 does not constitute a page." (Pl. Brief at 16-18.) These are "clearly inconsistent" positions.

4 With regard to the second element, Plaintiff succeeded in persuading the Court to adopt its
5 position. As discussed above, this concession was incorporated into Judge Shubb's Order. (Cl.
6 Constr. at 8 ("At oral argument, counsel for the plaintiff conceded that an image on a 'page' did not
7 constitute a 'page.' . . . Therefore, the term 'page' needs no further construction,"))

8 With regard to the third element, Plaintiff would derive an unfair advantage if it were
9 allowed to walk away from its earlier position. The goal of the *Markman v. Westview Instruments*
10 *Inc.* decision was to create uniformity in the treatment of patents. 517 U.S. 370, 390 (1996). If
11 patentees were allowed to change the construction of claim terms depending on the defendant,
12 there would be no uniformity in patent enforcement. To allow Plaintiff to reverse course on the
13 meaning of a claim term would undermine the Supreme Court's goal of patent uniformity to the
14 disadvantage of both patentees and defendants.

15 Thus, judicial estoppel is applicable here where IconFind is asserting (1) a position contrary
16 to the position it advanced previously, (2) a position that was accepted and relied upon by Judge
17 Shubb, and (3) a position that would give Plaintiff an unfair advantage by allowing it to take
18 inconsistent positions against different defendants. Judicial estoppel may be applied where a
19 patentee attempts to argue for an inconsistent construction of a claim term in a second litigation.
20 *See Solomon Techs., Inc. v. Toyota Motor Corp.*, No. 05-1702, 2010 WL 715243, *2-*3 (M.D.
21 Fla., Jan. 26, 2010) (barring a patentee from arguing that certain claims were not means-plus-
22 function claims in district court because the patentee stipulated that the claims were means-plus-
23 function claims to the International Trade Commission); *see also Transclean Corp. v. Jiffy Lube*
24 *Intern., Inc.*, 474 F.3d 1298, 1307 (Fed. Cir. 2007) (noting that "a party may be judicially estopped
25 from asserting clearly inconsistent positions on claim construction, which is a question of law," and
26 ruling that plaintiff Transclean would be held to its concession regarding privity in a previous
27 case).

Judicial estoppel is an equitable doctrine “intended to prevent the perversion of the judicial process.” *New Hampshire*, 532 U.S. at 750 (citation omitted). Acceptance of Plaintiff’s theory in this case would create the perception that Judge Shubb’s Court was misled, the exact situation that the doctrine of judicial estoppel is meant to prevent. *Id.* (citing *Edwards v. Aetna Life Ins. Co.*, 690 F. 2d 595, 599 (6th Cir. 1982)). Therefore, Plaintiff is estopped from arguing the inconsistent position it advances in its brief.

B. “assigning said network page to one or more of [a plurality of] said list of categories” (Claim 1-29, 31) and “a set of categories and subcategories to which the network page is assigned” (Claim 30)

Google’s Construction	IconFind’s Construction
<p><u>Assigning said network page to one or more of [a plurality of] said list of categories</u>: the creator of the web page choosing which one or more of [a plurality of] said list of categories characterize said network page</p> <p><u>A set of categories and subcategories to which the network page is assigned</u>: a set of categories and subcategories that were chosen by the creator of the web page as characterizing the network page</p>	<p><u>Assigning said network page to one or more of [a plurality of] said list of categories</u>: 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.</p> <p>If the Court deems a construction is necessary, IconFind proposes: Assigning the network page to at least one of the categories</p> <p><u>A set of categories and subcategories to which the network page is assigned</u>: 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.</p> <p>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</p>

The primary dispute between the parties is whether any entity may perform the assignment or whether it must be performed by “the creator.”

1. Google's Construction Is Consistent With The Specification

As explained in Google's Opening Claim Construction Brief, the narrow disclosure of the '459 patent discloses only one method of assigning: assignment by the creator. (Def. Brief at 16-21.) There is no suggestion, much less support, in the specification for assignment carried out by a computer. A claim may be no broader than the supporting disclosure. *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1480 (Fed. Cir. 1998) (Case law "make[s] clear that claims may be no broader than the supporting disclosure, and therefore that a narrow disclosure will limit claim breadth.").

Google's construction is the only construction supported by the specification. Plaintiff portrays Google's arguments as improper importations of limitations from the specification, (Pl. Brief at 22,) because it cannot point to any support in the specification for its position that a computer may perform the assignment step. First, Plaintiff argues that the inventors "chose not to expressly identify an actor to perform the steps of the claim." (*Id.*) However, the inventors mentioned only one method of assigning pages. A patentee's choice of claim language does not abolish the written description requirement. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991) ("The written description must communicate that which is needed to enable the skilled artisan to make and use the claimed invention.") (citation omitted). The patent does not teach the skilled artisan to make or use a computer that assigns network pages to categories. Thus, Plaintiff's construction is impermissibly broad.

Next, Plaintiff argues that Google is improperly importing a limitation from the specification because the claim does not include the term "creator." To support its argument Plaintiff cites *Innogenetics, NV v. Abbott Labs.*, 512 F.3d 1363 (Fed. Cir. 2008). However, in *Innogenetics*, the Court refused to narrow a claim term because adequate support for the construction was provided in the specification. *Id.* at 1370. The Court found that the specification's "sparse but broad statements" supported a broader reading of the claim term. *Id.* at 1370. By contrast, the '459 patent specification does not contain sparse but broad statements, it repeatedly, consistently and exclusively states that the creator assigns the network pages. (5:62-67;

1 6:12-16; 6:19-22; 6:31-33; 6:39-40; 6:43-44; 6:47-49; 6:50-60; 6:63-7:3; 7:12-15; 7:66-8:9; 9:46-
2 48.)

3 The other cases cited by Plaintiff also fail to support its position. In *Laryngeal Mask Co.*
4 *Ltd. v. Ambu*, 618 F.3d 1367 (Fed. Cir. 2010), the Court refused to construe the term “backplate” to
5 include a tube joint because the patentee had first claimed a backplate with a tube joint and later
6 amended its claims to remove the tube joint limitation. The Court found that the removal of the
7 limitation indicated that it would be improper to read the removed term back into the claim. *Id.* at
8 1373 (“we agree with [patentee] that it would be improper to read a tube joint limitation back into
9 the backplate.”). Unlike the facts of *Laryngeal*, in this case, the patentee did not amend the claims
10 to *remove* the creator from the claim language. In fact, Plaintiff does not advance an argument
11 based on the prosecution history, so *Laryngeal* is inapplicable.

12 Plaintiff also cites *Gemstar-TV Guide v. Int’l Trade Comm’n*, 383 F.3d 1352 (Fed. Cir.
13 2004). In *Gemstar*, the specification of the patent-at-issue explained how a “conventional cursor”
14 could perform as a “visual identification.” *Id.* at 1365. The patent also described its preferred
15 “innovative cursor.” *Id.* The issue in *Gemstar* was whether the patentee disclaimed the broader
16 construction. *Id.* at 1366. The Court found that the term “visual identification” was not limited to
17 the innovative cursor because the specification stated that the conventional cursor could function as
18 the visual identification. *Id.* In this case, unlike in *Gemstar*, the ’459 patent does not describe how
19 a computer could perform the assigning step and then state that the step could be improved by
20 having the creator perform the step. Instead, the ’459 patent *never mentions* a computer
21 performing the assigning step, much less actually describes *how* a computer might perform that
22 step.

23 No cited case supports Plaintiff’s position that a broad claim term captures every possible
24 construction without support from the specification. The specification of the ’459 patent simply
25 does not support a construction of this claim term that encompasses a computer performing the
26 assigning step.

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

Google’s Construction	Plaintiff’s Construction
<p><u>Categories related to public domain, fair use only, use with attribution, and permission of copyright owner needed</u>: 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.</p>	<p><u>Categories related to public domain, fair use only, use with attribution, and permission of copyright owner needed</u>: 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.</p> <p>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.</p>

The parties disagree on two aspects of this claim term. First, the copyright status category, like the other categories, must apply to the network page itself. Plaintiff instead attempts to change the claim language so that undefined “material” is categorized rather than the page. Second, the claim language as well as the specification and prosecution history require this claim term be construed to include four mutually exclusive categories. Plaintiff instead asserts that any single copyright status meets this claim language—even though the patentee surrendered that subject matter during the prosecution of the ’459 patent.

Plaintiff’s construction does not aid the jury, it simply defines the copyright statuses, which are not the subject of disagreement. Google’s construction settles the two areas of disagreement by indicating that the copyright status category applies to the network page and that four mutually exclusive categories are required. Thus, Google’s construction should be adopted over Plaintiff’s vague and unhelpful construction.

1 **1. The Claim Language Supports Google’s Interpretation That The**
2 **Copyright Status Categories Apply To The Network Page**

3 The ’459 patent claims a method for categorizing network pages, not a method for
4 categorizing material on pages. Plaintiff attempts to change the claim language in order to advance
5 its infringement theory. Claim 31 of the ’459 patent reads:

6 A computer implemented method of *categorizing a network page*, comprising:
7 providing a list of *categories*, wherein said categories include a category
8 based on the copyright status of material on a page, and wherein the
9 copyright status comprises categories related to public domain, fair use
10 only, use with attribution, and permission of copyright owner needed;
11 *assigning said network page* to one or more of a plurality of said list of
12 *categories*

13 (14:35-42 (emphasis added).) According to the claim, network pages are assigned to categories.
14 Material is not assigned. As further illustration of this interpretation, every independent claim of
15 the ’459 patent contains the following element:

16 controlling usage of the network page using the categorization label and *the*
17 *copyright status of the network page.*

18 (12:36-38; 14:31-33; 14:49-51 (emphasis added).) As shown in the claim language, the copyright
19 status category, like the other claimed categories, applies to the network page. There is nothing in
20 the claim language to suggest otherwise.

21 Plaintiff’s construction suggests that the copyright status category applies to “material.”
22 The only mention of “material” in the claims is the section of the claim that defines the basis for
23 the categories themselves: “providing a list of categories, wherein said categories include *a*
24 *category based on the copyright status of material on a page.*” (14:37-42 (emphasis added).)
25 Accordingly, the material on a page is the basis for a category. The claim language does not
26 support a construction where the *material* is assigned to the copyright status. (Cl. Constr. at 8 the
27 claims “clearly distinguish ‘network page’ from ‘material on a page’ and ‘material on the network
28 page.’”).)

 Google’s interpretation of the claim element in this respect is consistent with the claim
 language and should be adopted.

1 **2. The Prosecution History And Court Precedent Require Four Mutually**
2 **Exclusive Categories**

3 During prosecution of the '459 patent, the patentee surrendered the same territory Plaintiff
4 now asserts is claimed. The patentee submitted the following claim to the Patent Office:

5 **Claim 51 (new): A method of categorizing a network page, comprising:**
6 **providing a list of categories, wherein said categories include a plurality of categories based**
7 **on the copyright status of material on a page, and**
8 **assigning said network page to one or more of a plurality of said list of categories.**

9 (Pros. History, IF000144.) This claim was rejected under 35 U.S.C. § 102(b) because it was
10 anticipated by prior art. (Pros. History, IF000122-23.) The examiner rejected the claim because
11 the prior art reference ("Cole") taught how to categorize and assign network pages. (*Id.*)
12 Importantly, the examiner also explicitly found that the Cole reference taught "a plurality of
13 categories based on the copyright status of material on a page":

14
15 **8. The limitations of claim 51 have been addressed above except for the following:**
16 **wherein said categories include a plurality of categories based on the copyright status of**
17 **material on a page [note: Cole et al. provides for user ability to define the category see**
18 **column 4 lines 30-66; also note column 5 line 60 through column 6 line 4].**

19
20 (Pros. History, IF000123.) The patentee then amended this claim element to overcome the
21 examiner's rejection by adding the underlined claim element at issue here:

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

(Pros. History, IF000113.)

1 An amendment made to overcome a prior art reference creates a *narrower* claim. *See Bd.*
2 *of Regents of the Univ. of Texas Sys. v. BENQ America Corp.*, 533 F.3d 1362, 1369–70 (Fed. Cir.
3 2008) (holding that the Court could not construe a claim term added during amendment as
4 encompassing the very claim limitation that the amendment was meant to narrow). The patentee
5 added these four categories because the broader term, categories based on the copyright status of
6 material on a page, was already known in the prior art. (Pros. History, IF000123.) By amending,
7 the patentee acquiesced to the examiner’s rejection and cannot reclaim the surrendered subject
8 matter. *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 443 (1926) (“If dissatisfied with the
9 rejection he should pursue his remedy by appeal; and where, in order to get his patent, he accepts
10 one with a narrower claim, he is bound by it.”). Therefore, the patentee has claimed these four
11 specific categories and surrendered a single copyright status category.

12 Under Plaintiff’s construction, this claim element is actually *broader* than the rejected
13 claim element. The claim element “a plurality of categories based on copyright status of material
14 on a page” was rejected. Plaintiff amended to overcome the rejection and now asserts that a
15 *single* copyright status category meets this limitation: “all that needs to be present [in order to
16 meet this claim limitation] are one or more categories that are related to *either* (1) public domain;
17 (2) fair use only; (3) use with attribution; or (4) permission of the copyright owner.” (Ex. 14 at 12
18 (emphasis added).) In its infringement contentions, Plaintiff asserts that an “all rights reserved”
19 category alone meets this limitation because it is “related to” the “permission of copyright owner
20 needed” category. (Dkt. 88 at 9 (citing Ex. 1 to Dkt. 88 (Plaintiff’s Infringement Contentions) at
21 108).) If a single category, such as “all rights reserved,” meets this limitation then *any* single
22 copyright status category meets this limitation because the recited categories span the spectrum of
23 copyright statuses. Thus, under Plaintiff’s interpretation, no subject matter was surrendered by
24 the patentee’s amendment and subject matter was added (a single category based on copyright
25 status of material on a page).

26 Plaintiff’s construction is improper in light of established law on surrender of claim
27 language. *See, e.g., Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 33 (1966) (“Claims as
28

1 allowed must be read and interpreted with reference to rejected ones and to the state of the prior
2 art; and claims that have been narrowed in order to obtain the issuance of a patent by
3 distinguishing prior art cannot be sustained to cover that which was previously by limitation
4 eliminated from the patent.”).

5 The patentee surrendered the broad *categories based on copyright status of material on a*
6 *page* language for the specific categories listed in this claim term. Plaintiff is now attempting to
7 have this claim language construed so that any single copyright status meets this claim limitation.
8 The Court should reject such a construction.

9 3. This Claim Element Requires Four Distinct Categories

10 As discussed in Google’s Opening Brief, the specification and prosecution history of the
11 ’459 patent require this claim element to contain four mutually exclusive categories. (Def. Brief at
12 22-27.) Plaintiff’s position is that this claim element is met by any single copyright status
13 category and its construction is crafted to fit this theory. (Ex. 14 at 12.) However, this
14 construction would essentially read this claim element out of the claim and consequently must be
15 rejected.
16

17 The step in claim 31 that contains this element reads:

18 providing a list of categories, wherein said categories include a category based on the
19 copyright status of material on a page, and wherein the copyright status comprises
20 categories related to public domain, fair use only, use with attribution, and permission of
21 copyright owner needed;

22 The corresponding step in claim 1 (with the two top-tier categories omitted) reads:

23 providing a list of categories [. . .] wherein said list of categories include a category based
24 on copyright status of material on a page;

25 Under Plaintiff’s construction, these claim elements have the same meaning and a single copyright
26 status category, such as “all rights reserved,” would meet both of these claim elements. (Dkt. 88, at
27 9, citing Ex. 1 to Dkt. 88 (Plaintiff’s Infringement Contentions) at 108.) Therefore, Plaintiff’s
28 construction violates the canon of claim differentiation. *Tandon Corp. v. U.S. Int’l. Trade*

1 *Comm'n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987) (“There is presumed to be a difference in meaning
2 and scope when different words or phrases are used in separate claims.”)

3 Furthermore, dependent claim 6 reads:

4 The method of claim 1 wherein said plurality of categories based on the copyright
5 status of material on a page comprise categories related to public domain, fair use
6 only, use with attribution, and permission of copyright owner needed.

7 Because claim 6 depends on claim 1, it must narrow the claim. *Dow Chem. Co. v. U.S.*, 226 F.3d
8 1334, 1341-42 (Fed. Cir. 2000) (concluding that an independent claim should be given broader
9 scope than a dependent claim to avoid rendering the dependent claim redundant). Plaintiff’s
10 construction allows a single category, located anywhere along the spectrum of copyright status
11 categories, to meet this claim limitation. (Ex. 14 at 12 (“all that needs to be present [in order to
12 meet this claim limitation] are one or more categories that are related to either (1) public domain;
13 (2) fair use only; (3) use with attribution; or (4) permission of the copyright owner”).) Plaintiff’s
14 broad construction of this claim element is redundant because it does not limit claim 1. Thus, its
15 construction is against the laws of claim construction. *Dow Chem.*, 226 F.3d 1334 at 1341-42.

16 The embodiments described in the specification contain four mutually exclusive categories.
17 (6:48-49 (“The creator may assign the page to one of the four copyright-status categories.”).)
18 Nothing in the specification or claim language suggests that this claim element may be met by a
19 single copyright status category. The list of four recited categories in claim 31 was added to
20 overcome a rejection and the same element in claim 6 must have a meaning that narrows the claim
21 on which it depends. Therefore, Plaintiff’s construction, which suggests to the jury that this
22 element may be met by a single copyright status category, must be rejected.

23 Google’s construction makes these important points clear to the jury. It is also supported
24 by the specification and the claim language. Google’s construction should be adopted.

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Respectfully submitted,

KAYE SCHOLER LLP

Dated: June 12, 2012

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