

EXHIBIT B

Haan, Brian

From: John LaBarre [jlabarre@google.com]
Sent: Monday, April 11, 2011 5:37 PM
To: Daniel L. Baxter; Niro, Raymond P Jr
Cc: Malecek, Michael; Kenneth Maikish; Niro, Raymond P; tredmon@wilkefleury.com; Folgers, Anna; Haan, Brian
Subject: IconFind - First Amended Answer
Attachments: Google - IconFind First Amended Answer and Counterclaims.pdf

Ray and Daniel -

Attached is a copy of Google's recently filed First Amended Answer and Counterclaims. Without addressing any issues raised in your recently filed Motion to Dismiss/Strike, in the interests of seeking to have the Court and the parties focus on the merits of this matter, we believe that this Amended Answer moots the substance of your motion. Accordingly, please let us know by COB Tuesday, April 12, 2011, whether Plaintiff agrees to withdraw its motion.

Regards,

John

--

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April 12, 2011

Via email jlabarre@google.com

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**Re: IconFind, Inc. v. Google Inc., Case No. 2:11-CV-00319 GEB;
Invalidity Counterclaim**

Dear John,

I am writing in response to your request that IconFind withdraw its Motion to Dismiss/Strike, Dkt. Nos. 22-24, in view of Google's First Amended Answer and Counterclaims. IconFind does not agree that the amended counterclaim and affirmative defense of patent invalidity moots the substance of its motion. For instance, paragraph 12 of Google's counterclaim Count Two states that the patent is invalid under Sections 102, 103 and/or 112 because, among other things, the invention "is taught by, suggested by, and/or obvious in view of, the prior art." However, Google still does not specify which of the numerous independent grounds of invalidity under Section 102 on which it is relying, much less provide any factual allegations in support, such as citing any items of prior art. (See Pls.' Mem., Dkt. No. 23, pp. 6-7). Likewise, Google's vague allegation in paragraph 12 that the invention "is unsupported by the written description" fails to specify the specific grounds on which it is relying under Section 112, such as written description, lack of enablement, claim indefiniteness or best mode; nor does it identify any claim element that is allegedly unsupported.

Notwithstanding IconFind's continuing concerns with Google's amended pleading, IconFind would prefer to proceed beyond the pleading stage of the litigation. However, as set forth in IconFind's memorandum, IconFind is still concerned that instead of having fair notice of Google's claims in the pleading, it will be forced to extract Google's invalidity theories through the expensive and time consuming discovery process, including motions to compel. For instance, defendants often object to interrogatories concerning their invalidity counterclaims as premature contention

John LaBarre
Google Inc.
April 12, 2011
Page 2

interrogatories, premature as seeking expert testimony or premature for lack of discovery from the plaintiff. If Google is willing to represent that it will substantively respond in good faith to interrogatories concerning its counterclaims in lieu of such objections, then IconFind is willing to withdraw its motion. Please confirm that Google is willing to make such a representation and produce full and complete discovery responses on these issues.

We look forward to hearing from you.

Sincerely,

A handwritten signature in black ink, appearing to read 'B. E. Haan', written in a cursive style.

Brian E. Haan

BEH/cas

Haan, Brian

From: John LaBarre [jlabarre@google.com]
Sent: Tuesday, April 12, 2011 5:19 PM
To: Sucic, Carolyn; Haan, Brian
Cc: Michael.malecek@kayescholar.com; Kenneth.maikish@kayescholar.com; Niro, Raymond P Jr; Folgers, Anna; dbaxter@wilkefleury.com
Subject: Re: IconFind Inc. v. Google Inc. / Case No. 2:11-cv-00319-GEB-JFM
Attachments: 2001_WL_36043487_Network Caching Tech.pdf

Brian -

I write in response to your letter from earlier today in which you suggest that you will withdraw your motion to dismiss in light of Google's Amended Answer if Google is willing to agree to substantively respond to as-of-yet unserved discovery requests. Your motion goes to the notion of sufficiency of pleadings, and, we believe our Answer and Counterclaims provide you with the level of detail to which you are entitled at this stage of the matter. *See, e.g., Network Caching Technology, LLC v. Novell, Inc.*, 2001 WL 36043487, *2 (N.D. Cal. Dec. 31, 2001) which cites the exact language in our Amended Answer as being sufficient at this stage of a litigation (relevant portions highlighted in the attached).

I certainly do not mean to suggest that Google will be obstructionist in its discovery responses; we won't. Beyond that assurance, however, it is simply not possible for Google to agree to waive objections to interrogatory requests that it has not yet seen.

Please advise whether you will withdraw your motion.

Regards,

John

--

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On Tue, Apr 12, 2011 at 10:08 AM, Sucic, Carolyn <csucic@nshn.com> wrote:

The attached email correspondence has been transmitted on behalf of Brian E. Haan.

Thank you.

Carolyn A. Sucic

Assistant to Richard B. Megley, Jr., Tahiti Arsulowicz and Brian E. Haan

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April 13, 2011

Via email jlabarre@google.com

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**Re: IconFind, Inc. v. Google Inc., Case No. 2:11-CV-00319 GEB;
Invalidity Counterclaim**

Dear John,

I am writing in response to your further request that IconFind withdraw its Motion to Dismiss/Strike in view of Google's First Amended Answer and Counterclaims and your citation to Network Caching Technology, LLC v. Novell, Inc., 2001 WL 36043487, *2 (N.D. Cal. Dec. 31, 2001). Most importantly, IconFind is troubled that Google is unwilling to provide assurance that it will substantively respond to interrogatories concerning its counterclaims, and that it will not object to such interrogatories as premature contention interrogatories, premature as seeking expert testimony or premature for lack of discovery from IconFind.

Additionally, IconFind does not agree that the above-cited case, which was decided long before Twombly and Iqbal, supports the sufficiency of Google's pleading. To the contrary, your admission that Google copied the exact language in its counterclaim from the cited case only confirms that Google intended its allegations to serve as a mere placeholder, rather than preparing and providing its own allegations. As set forth in my letter of April 12, Google's amended counterclaim fails to rectify the insufficiencies in its pleadings. Instead, the amended pleading only raises further plausibility concerns. For instance, Google's amended allegations copied from the above-cited case state, among other things, that "[t]he '459 patent is invalid because it fails to meet the 'conditions for patentability' of 35 USC §§ 102, 103, and/or 112 because the alleged invention thereof lacks utility..." This allegation is nonsensical because lack of utility is an issue brought under Section 101, not Sections 102, 103 and 112. See 35 U.S.C. § 101 ("Whoever invents or

John LaBarre
Google Inc.
April 13, 2011
Page 2

discovers any new and *useful* process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor ...").

As previously mentioned, IconFind would prefer to proceed beyond the pleading stage of the litigation. To that end, please confirm that Google will provide the requested assurance that Google will substantively respond to IconFind's interrogatories in lieu of the objections discussed above. If Google is unwilling to provide such assurance, IconFind has no choice but to go forward with its motion.

We look forward to hearing from you.

Sincerely,

A handwritten signature in black ink, appearing to read 'B. E. Haan', with a stylized flourish at the end.

Brian E. Haan

BEH/cas

Haan, Brian

From: John LaBarre [jlabarre@google.com]
Sent: Thursday, April 14, 2011 12:41 PM
To: Sucic, Carolyn; Haan, Brian
Cc: Michael.malecek@kayescholer.com; Kenneth.maikish@kayescholer.com; Niro, Raymond P Jr; Folgers, Anna; dbaxter@wilkefleury.com
Subject: Re: IconFind Inc. v. Google Inc. / Case No. 2:11-cv-00319-GEB-JFM

Brian -

I write to follow up to your letter from yesterday. It seems we are still in the same place. Our position remains that, especially as amended, our Answers and Counterclaims are sufficient. And again, I reiterate that it is not Google's intent or practice to be obstructionist in its response to discovery requests. That said, Google can not (and will not) agree to waive objections to discovery requests it has not yet seen.

If you agree to withdraw your motion, please let us know. If not, we will proceed with motion practice.

Regards,

John

--

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On Wed, Apr 13, 2011 at 12:12 PM, Sucic, Carolyn <csucic@nshn.com> wrote:

The attached email correspondence has been transmitted on behalf of Brian E. Haan.

Thank you.

Carolyn A. Sucic

Assistant to Richard B. Megley, Jr., Tahiti Arsulowicz and Brian E. Haan

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April 15, 2011

Via email jlabarre@google.com

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**Re: IconFind, Inc. v. Google Inc., Case No. 2:11-CV-00319 GEB;
Invalidity Counterclaim**

Dear John,

I am writing in response to your April 14 email. I regret that we have been unable to resolve our dispute over the sufficiency of Google's original and amended pleadings. Nevertheless, because IconFind's motion to dismiss is directed at Google's original answer and counterclaims, IconFind is withdrawing its motion without prejudice and reserving all rights to answer or otherwise respond to Google's first amended answer and counterclaims.

Sincerely,



Brian E. Haan

BEH/cas