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

12 ICONFIND, INC., )

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

13 Plaintiff, )

14 **LABARRE DECLARATION IN SUPPORT**  
**OF DEFENDANTS GOOGLE INC.'S**  
**MEMORANDUM IN OPPOSITION TO**  
**PLAINTIFF'S MOTION TO DISMISS**  
**PURSUANT TO FRCP 12(B)(6) AND**  
**MOTION TO STRIKE PURSUANT TO**  
**FRCP 12(F).**

15 v. )

16 GOOGLE INC., )

17 Defendant. )

18 \_\_\_\_\_ )

1 I, John LaBarre, hereby declare as follows:

2 1. I am an attorney admitted to practice in the State of New York (Bar No. 4396271)  
3 and the State of California (Bar No. 801166). I am an Associate Litigation Counsel for defendant  
4 Google Inc. (“Google”). I have personal knowledge of the material facts stated herein, and I  
5 submit this Declaration in support of Defendants Google Inc.’s Memorandum in Opposition to  
6 Plaintiff’s Motion to Dismiss Pursuant to FRCP 12(b)(6) and Motion to Strike Pursuant to FRCP  
7 12(f). If called to testify, I could and would testify to the facts as set forth herein.

8 2. I have reviewed the case docket in the matter *Oracle America, Inc. v. Google Inc.*  
9 pending in the federal district of the Northern District of California (Case No. 3:10-cv-03561-  
10 WHA). It is my understanding that Oracle America, Inc. (“Oracle”) filed a Motion to Dismiss  
11 Invalidation Counterclaims and Motion to Strike Certain Affirmative Defenses (Dkt. No. 35).  
12 Thereafter, Google filed an Answer and Counterclaims to Oracle’s Amended Complaint (Dkt.  
13 No. 51) in which Google plead invalidity as an affirmative defense: “Each of the Patents-in-Suit  
14 is invalid because it fails to meet the ‘conditions for patentability’ of 35 USC §§ 101, 102, 103,  
15 and/or 112 because the alleged invention thereof lacks utility; is taught by, suggested by, and/or,  
16 obvious in view of, the prior art; and/or is not adequately supported by the written description of  
17 the patented invention.” Google also included counterclaims of invalidity of the various patents-  
18 in-suit in that matter, with each counterclaim including language reciting that the respective  
19 patent was “invalid because it fails to meet the ‘conditions for patentability’ of 35 USC §§ 101,  
20 102, 103, and/or 112 because the alleged invention thereof lacks utility; is taught by, suggested  
21 by, and/or, obvious in view of, the prior art; and/or is not adequately supported by the written  
22 description of the patented invention. . . .” In its Reply Brief, Oracle declined to pursue its  
23 Motion to Dismiss and to Strike Google’s invalidity pleadings (Dkt. No. 54).

24 3. Exhibit 1 is a true and correct copy of Judge Alsup’s Order denying Oracle’s  
25 Motion to Dismiss and Strike in *Oracle America, Inc. v. Google Inc.* (Dkt. No. 55).

26 4. On Thursday, April 28, 2011, attorneys for the parties participated in a conference  
27 pursuant to Fed. R. Civ. Pro. 26(f) and this Court’s February 3, 2011 Order. Among the matters  
28

1 discussed at the conference was the case schedule. As part of the discussion, Plaintiff proposed  
2 formally including infringement and invalidity contentions as part of the discovery process and  
3 included the following language to the draft Joint Status Report circulated by Google:

4 On or before June 20, 2011, IconFind will provide initial  
5 infringement contentions containing the following information: 1) each asserted patent claim; 2) each accused instrumentality; 3) a  
6 chart identifying where each limitation of each asserted claim is found within the accused instrumentality; 4) the priority date to  
7 which each asserted claim is entitled; and 5) the bases for its willful infringement allegation. With its infringement  
8 contentions, and to the extent not already provided in discovery, IconFind will produce: 1) all documents evidencing conception  
9 and reduction to practice of each claimed invention; 2) a copy of the file history for the patent in suit; and 3) all documents  
10 evidencing ownership of the patents by IconFind. The foregoing contentions are to be deemed continuing, requiring prompt  
11 supplementation whenever the conditions of Fed.R.Civ.P. 26(e) are satisfied.

12 On or before August 1, 2011, Google will provide initial  
13 invalidity contentions containing the following information: 1) the identify of each item of prior art on which Google intends to rely;  
14 2) whether each item of prior art anticipates each asserted claim or renders it obvious, including an explanation of why the prior  
15 art renders the asserted claim obvious and an identification of any combinations of prior art; 3) a chart identifying where in each  
16 item of prior art each limitation of each asserted claim is found; 4) any grounds for invalidity under 35 U.S.C. §§ 101 and 112. With  
17 its invalidity contentions, and to the extent not already provided in discovery, Google will produce: 1) source code, specifications,  
18 schematics, flow charts, artwork, formulas, or other documentation sufficient to show the operation of any aspects or  
19 elements of the accused instrumentality identified by IconFind; and 2) a copy of each item of prior art identified in Google's  
20 invalidity contentions. The foregoing contentions are to be deemed continuing, requiring prompt supplementation whenever  
21 the conditions of Fed.R.Civ.P. 26(e) are satisfied.

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23  
24 5. During the Rule 26(f) Conference, I, on behalf of Google, inquired whether, if  
25 Google agreed to the substance of Plaintiff's proposal regarding the inclusion of formal  
26 infringement and invalidity contentions into the case schedule, Plaintiff would agree to withdraw  
27 Plaintiff's Motion to Dismiss Pursuant to FRCP 12(b)(6) and Motion to Strike Pursuant to FRCP

1 12(f). Mr. Brian Haan, of Niro, Haller & Niro indicated that he would revert back to Google by  
2 the following day.

3 6. On Friday, April 29, 2011, in a phone discussion between Mr. Haan and myself,  
4 Plaintiff indicated that it would withdraw its Motion if Google was also willing to withdraw its  
5 Motion for Judgment on the Pleadings of Invalidity of the U.S. Patent No. 7,181,459. On behalf  
6 of Google, I declined. Nevertheless, I informed Mr. Haan that Google agrees to the basic  
7 substance of Plaintiff's proposal regarding the inclusion of formal infringement and invalidity  
8 contentions into the case schedule, and that in light of such agreement, urged Plaintiff to  
9 reconsider withdrawing its Motion. Plaintiff declined to withdraw.

10 7. Exhibit 2 to this Declaration is a true and correct copy of Yahoo!'s Answer in  
11 *IconFind, Inc. v. Yahoo! Inc.*, Case No. 2:09-cv-00109 (E.D. Cal. 2009). My review of the case  
12 docket in that matter concludes that, in that matter, IconFind did not file a Motion to Dismiss  
13 Yahoo!'s counterclaims of invalidity nor did it file a Motion to Strike Yahoo!'s affirmative  
14 defense of invalidity.

15 8. Exhibit 3 to this Declaration is a true and correct copy of Recovery Database  
16 Network's Answer in *MVConnect, LLC v. Recovery Database Network, Inc.*, Case No. 10-cv-  
17 6247 (N.D. Ill. 2010). The signature page of this Answer indicates that the defendant was  
18 represented by attorneys from Niro, Haller & Niro, the same firm that is representing Plaintiff in  
19 this matter.

20 9. Exhibit 4 to this Declaration is a true and correct copy of The Black and Decker  
21 Corp.'s Answer in *Byrne v. The Black and Decker Corp.*, Case No. 2:04-cv-262 (E.D. Ky. 2004).  
22 This Answer indicates the defendant in that matter was represented by attorneys from Niro,  
23 Scavone, Haller & Niro. It is my understanding that the Niro, Scavone, Haller & Niro firm is  
24 the predecessor firm to Niro, Haller & Niro, the same firm that is representing Plaintiff in this  
25 matter.

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I declare pursuant to 28 U.S.C. § 1746 and under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed this 2nd day of May, 2011.

/s/ John LaBarre (original signature retained by attorney Kenneth Maikish)  
John LaBarre  
IP Litigation Manager for Defendant, GOOGLE INC.