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14   IN THE UNITED STATES DISTRICT COURT
              FOR THE EASTERN DISTRICT OF CALIFORNIA
15

    ICONFIND, INC.,   Case No. 2:11-cv-00319-GEB-JFM
16
                            Plaintiff,   **PLAINTIFF'S RESPONSE IN**
17   **OPPOSITION TO DEFENDANT'S**
              v.   **MOTION FOR JUDGMENT ON THE**
18   **PLEADINGS**
    GOOGLE INC.,
19
                            Defendant.
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    RESPONSE IN OPPOSITION TO MOTION FOR JUDGMENT (CASE NO. 11-00319 GEB JFM)
25

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Federal Rules

1 **I.   INTRODUCTION**

2   Plaintiff IconFind, Inc. ("IconFind") respectfully submits its response in opposition to

3 Defendant Google Inc.'s ("Google") Motion for Judgment on the Pleadings. Google's motion

4 fails as a matter of law on a number of procedural and substantive grounds. First, Google filed

5 this motion pursuant to Federal Rule of Civil Procedure 12(c), which requires that the pleadings

6 be "closed" when a Rule 12(c) motion is filed. The pleadings are not closed in this case –

7 IconFind has not answered Google's invalidity counterclaim.   Therefore, the motion is

8 procedurally improper.

9   Google alleges that the patent-in-suit is invalid for failure to meet the requirements for

10 patentability under Section 101 of Title 35 because it claims an "abstract idea." The law is clear:

11 invalidity due to Section 101 deficiencies is intimately tied to claim construction and involves

12 underlying legal and factual issues. This issue cannot be determined at this stage in the

13 litigation. Even further, Google asks the Court to declare <u>all claims</u> of the patent-in-suit invalid,

14 yet does not address <u>individually</u> why each claim is allegedly invalid. Hence, Google has

15 outright ignored and has plainly not met its "clear and convincing" burden of proof as to each

16 claim in the patent-in-suit.

17   Finally, should the Court reach the merits of Google's motion, the United States Patent

18 and Trademark Office ("USPTO") has indeed heard and has vetted the exact same argument that

19 Google now asserts. This is because it is clear that the claims are directed to patentable subject

20 matter under all applicable statutory and case precedent. This Court should find – just as the

21 USPTO found – that the claims of the patent-in-suit are directed towards much more than an

22 abstract idea and meet the requirements of Section 101.

23   For these and the following reasons, Google's motion should be denied.

24

25

II. THE PATENT-IN-SUIT

The Patent-In-Suit, U.S. Patent No. 7,181,459 B2 ("the '459 Patent") describes methods for categorizing network pages, such as web pages on the Internet. The '459 Patent recognizes that, in the context of the Internet, one problem with the organization of web pages was the lack of a standardized categorization system for the information contained on such web pages. ('459 Patent, Col. 1, ll. 38-48, Ex. A). The inventors set out to solve this problem by creating a method for categorizing network pages based upon the material on the page, including whether the pages contained commercial or non-commercial information, as well as the copyright status of the material on the page. ('459 Patent, Col. 3, ll.8-21, Ex. A). Claim 1 states:

> 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.

(Id. at Col. 12, ll. 24-38). Claim 1 identifies three types of categories: (1) a category for providing information; (2) a category for transacting business; and (3) a category based on copyright status of material on a page. ('459 Patent, Col. 12, ll. 24-38, Ex. A). The network page is assigned a label based on at least the copyright status of the material on the page. That label, along with the copyright status of the network page, are used to control usage of the page.

The two other independent claims are Claims 30 and 31. Claim 30 includes the step of providing a categorization code for labeling 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…

(Id. at Col. 14, Ex. A). Claim 31 includes more specific types of copyright categories to which the network pages may be assigned:

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…

Id. The other 28 dependent claims add additional details, for instance, concerning the types of categories to which a page may be assigned, what the categorization label is comprised of and that the label is recognizable by a search engine. (Id. at Col. 12-14).

III.   APPLICABLE LEGAL STANDARD

A.   Google's Motion Under FRCP 12(c) Is Improper Because The Pleadings Are Not "Closed"

Federal Rule of Civil Procedure 12(c) provides that "[a]fter the pleadings are closed — but early enough not to delay trial — a party may move for judgment on the pleadings." The Ninth Circuit has held that "the pleadings are closed for the purposes of Rule 12(c) once a complaint and answer have been filed," and that a motion for judgment on the pleadings is "premature" where no answer has yet been filed. Doe v. United States, 419 F.3d 1058, 1061 (9th Cir. 2005). Here, currently pending is IconFind's Motion to Dismiss Google's Counterclaim for Invalidity and Motion to Strike Google's Invalidity Defense (Dkt. No. 36) - which involves the very subject of Google's present motion. IconFind has not answered Google's Invalidity Counterclaim. Accordingly, the pleadings are not closed and until the Court rules on IconFind's Motion to Dismiss, and responsive pleadings are filed, Google's motion pursuant to Rule 12(c) is premature. KEMA, Inc. v. Koperwhats, 658 F.Supp.2d 1022, 1027 (N.D. Cal. 2009) (explaining

that where counterclaims are asserted, "the pleadings are closed only when the plaintiff serves his reply").

Indeed, until the pleadings are closed, the Court cannot even conduct a proper Rule 12(c) analysis. "For the purposes of the motion, the allegations of the non-moving party must be accepted as true, while the allegations of the moving party which have been denied are assumed to be false." Hal Roach Studios, Inc. v. Richard Feiner and Co., 896 F.2d 1542, 1550 (9th Cir. 1989). An assumption of truth or falsity cannot be applied to IconFind's reply, as it must under a proper analysis, because IconFind has not yet replied to Google's invalidity counterclaim.

On this procedural basis alone, Google's motion must be denied. Baker v. Kernan, 2008 WL 2705028, *2 (E.D. Cal. July 09, 2008) (denying plaintiff's Rule 12(c) motion for judgment as premature because it was filed before the "pleadings were closed"; defendant filed a motion to dismiss that was still pending at the time the plaintiff filed motion for judgment); Page v. Horel, 2011 WL 97715, *4 (N.D. Cal. Jan. 12, 2011) (denying motion for judgment as premature as defendant had yet to answer amended complaint).

B.   If The Court Treats Google's Improper FRCP 12(c) Motion as a Motion Pursuant to FRCP 12(b)(6), The Motion Is Still A Premature Attempt to File a Motion for Summary Judgment Before Even the Pleadings Stage of the Litigation is Complete

A court, in its discretion, may choose to treat a premature and improper Rule 12(c) motion as a motion to dismiss for failure to state a claim pursuant to Rule 12(b)(6). Culfin v. IBEW Local 11, 2010 WL 2465393, *1 (C.D. Cal. June 15, 2010). If the Court chooses to treat Google's 12(c) motion as a motion to dismiss, then the following legal principles apply.

A motion to dismiss for failure to state a claim under Rule 12(b)(6) should be granted only if the plaintiff fails to proffer "enough facts to state a claim to relief that is plausible on its face." Bell Atl. Corp. v. Twombly, 550 U.S. 544, 547 (2007); Johnson v. Riverside Healthcare

Sys. LP, 534 F.3d 1116, 1122 (9th Cir. 2008). In considering a motion to dismiss, the Court must accept the allegations of the complaint as true, <u>Erickson</u> v. <u>Pardus</u>, 551 U.S. 89, 90 (2007) (*per curiam*); <u>Albright</u> v. <u>Oliver</u>, 510 U.S. 266, 267 (1994), and the Court must construe the pleading in the light most favorable to the party opposing the motion and resolve all doubts in the pleader's favor. <u>Jenkins</u> v. <u>McKeithen</u>, 395 U.S. 411, 421 (1969); <u>Berg</u> v. <u>Popham</u>, 412 F.3d 1122, 1125 (9th Cir. 2005). As explained in detail below, the clear and overwhelming weight of authority holds that patent invalidity is not amenable to a motion to dismiss.

IV. INVALIDITY IS NOT AMENABLE TO A MOTION FOR JUDGMENT ON THE PLEADINGS (OR A MOTION TO DISMISS)

A patent is presumed valid. 35 U.S.C. § 282. Accordingly, the party challenging validity bears the very heavy burden of proving by clear and convincing evidence that the patent is invalid. <u>In re Comiskey</u>, 554 F.3d 967, 975 (Fed. Cir. 2009). While the determination of whether an asserted claim is invalid for lack of subject matter patentability under 35 U.S.C. § 101 is a question of law, <u>In re Bilski</u>, 545 F.3d 943, 950 (Fed. Cir. 2008) ("<u>Bilski I</u>"), the question may involve several factual underpinnings. <u>See</u> <u>In re Comiskey</u>, 554 F.3d at 975 (noting that "the legal question as to patentable subject matter may turn on subsidiary factual issues").

Moreover, in asking this Court to declare <u>all claims</u> of the '459 Patent invalid, Google plainly ignores its "clear and convincing" burden of proof as to each claim in the patent. (See Def.'s Mem., Dkt. No. 30, pp. 5-6, 13) ("[F]or the reasons above, the claims of the '459 should be declared invalid for lack of patentable subject matter"). "'The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.' … This burden '**exists at every stage of the litigation**.'" <u>Abbott Labs.</u> v. <u>Sandoz, Inc.</u>, 544 F.3d 1341, 1346 (Fed. Cir. 2008) (emphasis added). Google must meet this "clear and convincing"

1   burden of proof independently for <u>each claim</u> because "[e]ach claim carries an independent

2   presumption of validity, 35 U.S.C. § 282, and stands or falls independent of the other claims."

3   <u>Continental Can Co.</u> v. <u>Monsanto Co.</u>, 948 F.2d 1264, 1266-1267 (Fed. Cir. 1991) (citing

4   <u>Altoona Publix Theatres, Inc.</u> v. <u>American Tri-Ergon Corp.</u>, 294 U.S. 477, 487 (U.S. 1935)

5   ("And each claim must stand or fall, as itself sufficiently defining invention, independently of the

6   others")). Accordingly, it is reversible error to hold <u>any claim</u> invalid in the absence of clear and

7   convincing evidence specifically directed to that particular claim. <u>Sandt Tech., Ltd.</u> v. <u>Resco</u>

8   <u>Metal & Plastics Corp.</u>, 264 F.3d 1344, 1356 (Fed. Cir. 2001) ("Because dependent claims

9   contain additional limitations, they cannot be presumed to be invalid as obvious just because the

10   independent claims from which they depend have properly been so found").

11   Here, the '459 Patent has 31 claims, 12 of which were identified as representative

12   examples in the Complaint. (Compl., Dkt. No. 1). Google attempts to paint the claims with a

13   single broad brush, stating that all claims "recite the language 'a computer implemented

14   method.'" (Def.'s Mem., Dkt. No. 30, pp. 5-6). Google invites error by focusing solely on that

15   limitation. "The Supreme Court has stated that a § 101 patentability analysis is directed to the

16   claim as a whole, not individual limitations." <u>King Pharms., Inc.</u> v. <u>Eon Labs, Inc.</u>, 616 F.3d

17   1267, 1277 (Fed. Cir. 2010). Google's failure to address each claim and each limitation

18   independently is **fatal** to its motion. By definition, "each claim must be considered as defining a

19   separate invention." <u>Jones</u> v. <u>Hardy</u>, 727 F.2d 1524, 1528 (Fed. Cir. 1984) (citing 35 U.S.C.

20   282). Google wholly fails to address numerous limitations in all of the claims, such as "indicium

21   for each of said categories (claim 16), "icon" (claim 17) and "graphical user interface" (claim

22   29). ('459 Patent, Ex. A). Google's improper attempt to circumvent its burden of proof on the

23   invalidity of <u>each claim</u> is a fundamental error which, taken alone, demonstrates that its motion

24   should be denied.

25   PLAINTIFF'S RESPONSE IN OPPOSITION TO DEFENDANT'S MOTION FOR JUDGMENT ON THE   - 6 -
     PLEADINGS

Importantly, "[w]hether a claim is valid under § 101 is a matter of claim construction." CLS Bank Intern. v. Alice Corp. Pty. Ltd., 2011 WL 802079 at *14 (D.D.C. Mar. 9, 2011) (citing State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1370 (Fed. Cir. 1998)). As the court held in Cybersource Corp. v. Retail Decisions, Inc., 620 F. Supp. 2d 1068, 1073 (N.D. Cal. March 27, 2009), "claim construction is an **important first step** in a § 101 analysis." (emphasis added). In fact, the Federal Circuit in Bilski explicitly stated that this was so. Bilski I, 545 F.3d at 951 (citing State St. Bank & Trust Co. *v.* Signature Fin. Group, 149 F.3d 1368, 1370 (Fed. Cir. 1998) (noting that invalidity under § 101 "is a matter of both claim construction and statutory construction") (*overruled on other grounds*)). This makes perfect sense: how can the Court decide whether the claims of the '459 Patent are directed to patentable subject matter if the court has not determined the meaning of the claims? See also Deston Therapeutics LLC v. Trigen Laboratories Inc., 723 F. Supp. 2d 665, 670 (D. Del. 2010) ("[w]hile it is true that claim construction is a matter of law to be determined by the Court, the process for properly construing a patent claim is unsuited for a motion to dismiss").

While some of the claim terms were construed in IconFind, Inc. v. Yahoo! Inc., No. Civ. 09-109 WBS JFM, Dec. 14, 2009 Order (Dkt. No. 50), Google does not rely on these constructions in its motion. Google instead has taken the position that the claim terms must be construed anew and/or that additional constructions are necessary because Google proposed a claim construction briefing schedule in the Parties' Joint Rule 26(f) Report, which it sent to IconFind on April 25, 2011.

Google cites only one case for the proposition that the issue of patent validity may be determined at this early stage of litigation without the benefit of a claim construction or expert testimony. See Ultramercial, LLC v. Hulu LLC, 2010 WL 3360098 (C.D. Cal. Aug. 13, 2010). However, numerous district courts have found otherwise, and even questioned the propriety of

the Ultramercial decision. For example, in Progressive Cas. Ins. Co. v. Safeco Ins. Co., 2010

WL 4698576, *4 (N.D. Ohio Nov. 12, 2010), a case on all fours with the present one, the district

court declined to apply Ultramercial, reasoning:

> *Ultramercial* did not discuss the procedural posture of the case or the presumption
> of validity and a patent challenger's burden to prove invalidity by clear and
> convincing evidence, noting only that the court was rejecting "[p]laintiff's
> argument that this motion should not be decided before claim construction"
> because "[t]he patent terms are clear and [p]laintiff has not brought to the Court's
> attention any reasonable construction that would bring the patent within
> patentable subject matter." Without such analysis, the Court finds that
> Ultramercial does not support defendants' argument that finding the patent to be
> invalid at such an early stage in the litigation is appropriate.

Id. at *5. Other district courts throughout the country have consistently held that where an issue

intimately tied to the claim construction process is the subject of a motion to dismiss, that motion

must be denied. The reason for this is simple: claim construction is an issue of law for the judge

to decide with the full benefit of the extrinsic **and** intrinsic records (e.g. patent, file history,

expert testimony, dictionaries, treatises, etc.) and the court on a motion to dismiss may only

consider the pleadings. As the court in Deston explained in denying defendant's motion to

dismiss for non-infringement:

> As a consequence, many courts in this circuit and elsewhere have declined to
> construe patent claims on a motion to dismiss …[listing cases] … The Court will
> follow this lengthy line of cases and conclude that claim construction is not
> appropriate upon the present record of this Rule 12(b)(6) motion.
>
> In light of the jurisprudence holding that claim construction is generally not
> appropriate on a motion to dismiss, the ambiguity and possible conflict between
> the plain language of the patent claims and the specifications, and the fact that
> Plaintiffs have not resolved these issues in their complaint, the Court will decline
> to engage in patent claim construction or find as a matter of law that Defendants
> [don't infringe].

Deston, 723 F. Supp. 2d at 671-672. See Cima Labs, Inc. v. Actavis Group HF, 2007 WL

1672229, *4 (D. N.J. Jun. 7, 2007) (denying motion to dismiss and stating "the proper time for

this Court to address claim construction is not on a motion to dismiss"); Yangaroo Inc. v.

Destiny Media Techs., Inc., 2009 WL 2836643, *3 (E.D. Wis. August 31, 2009) (denying motion to dismiss and stating "[w]hile claim construction is a matter of law involving a determination of the meaning and the scope of the patent claims asserted to be infringed, through a consideration of sources intrinsic to the claim, such as the claim itself, the specification, and the prosecution history, the proper time for this Court to address claim construction is not on a motion to dismiss"); Bird Barrier America, Inc. v. Bird-B-Gone, Inc., 2010 WL 761241, *3 (C.D. Cal. Mar. 1, 2010) (denying motion to dismiss , explaining "[a]lthough claim construction is a matter of law for the Court to decide, claim construction is inappropriate at this stage in the litigation. The proper time for this Court to address claim construction is not a motion to dismiss …The parties will have the opportunity to present evidence, both intrinsic and extrinsic, of their preferred claim constructions at summary judgment"); Technology Patents, LLC v. Deutsche Telekom AG, 573 F.Supp.2d 903, 919-920 (D. Md. 2008) (denying defendants motion to dismiss and stating "piecemeal arguments raised in various briefs have not afforded the parties a proper opportunity to assert their arguments in a coherent and complete fashion … the better approach is to have the claim construction issues fully briefed and presented to the court at a later date").

In sum, IconFind should be afforded the opportunity to fully brief this issue in its proper procedural context as were the parties in Progressive, Deston, Yangaroo, Cima, Bird Barrier, and Technology Patents. Invalidity involves underlying claim construction issues and it is clear that a matter of claim construction cannot be decided on a motion to dismiss. IconFind should also be given the opportunity to provide expert testimony or other extrinsic evidence on this issue, particularly in regards to whether the inventions of the '459 Patent are "tied to a particular machine" or are "transformative" under the law. Google's motion is premature.

V.   GOOGLE'S MOTION SHOULD BE DENIED ON THE MERITS

A.   Introduction to the Section 101 Exceptions, Tests, Factors and Precedent

Even if it were necessary to reach the merits of Google's motion at this early stage, it is clear that the '459 Patent meets the requirements for patentability under 35 U.S.C. § 101, and controlling Supreme Court and Federal Circuit precedent. Whether a claim is drawn to patent-eligible subject matter under Section 101 of the Patent Act is a question of law. In re Bilski, 545 F.3d 943, 950 (Fed. Cir. 2008) ("Bilski I"). While the Supreme Court has consistently construed Section 101 broadly, the Court's precedent provides three limited exceptions to the scope of Section 101 of Title 35: (1) laws of nature; (2) physical phenomena; and (3) abstract ideas. Bilski v. Kappos, 130 S. Ct. 3218, 3225 (2010) ("Bilski II"). Under these exceptions, Google only asserts that the '459 Patent is unpatentable for claiming an "abstract idea." The Federal Circuit has described the concept of an abstract idea as "whether the Applicants are seeking to claim a fundamental principle (such as an abstract idea) or mental process." Bilski I, 545 F.3d at 952.

The Supreme Court in Bilski II discussed the standards for resolving Section 101 disputes and held that the so-called "machine or transformation test" ("MOT Test") is a "useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under §101," but, contrary to the Federal Circuit majority in Bilski I, "is not the sole test for deciding whether an invention is a patent-eligible 'process.'" Bilski, 130 S. Ct. at 952. While Google correctly notes that the USPTO continues to use the MOT Test as an **indicator** of patentability, what Google fails to mention (or analyze) is that the USPTO, in offering guidelines on this issue, identified **a number of factors** that should be weighed to determine whether a method claim is directed to an abstract idea, and is thus ineligible for patent protection under

101. See "*Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos*," 75 Fed. Reg 43, 992 (July 27, 2010) ("Interim Guidelines") (Ex. B).

Additionally, the Supreme Court in Bilski II noted that lower courts should look to Gottschalk v. Benson, 409 U.S. 63 (1972), Parker v. Flook, 437 U.S. 584 (1978) and Diamond v. Diehr, 450 U.S. 175, 187 (1981)) as "guideposts" to enlighten this inquiry. See Bilski II, 130 S. Ct. at 3229-3231.   In addressing the Section 101 tools and authority in turn below, it is clear that the '459 Patent meets the patentability requirements of Section 101.

B.   The Subject Matter of the '459 Patent is Not "Abstract"

Since the Supreme Court's recent decision in Bilski II, the Federal Circuit has only squarely addressed the issue of whether the subject matter of an invention was "abstract" one time, and that decision is instructive here. In Research Corporation Technologies vs. Microsoft Corporation, the Federal Circuit assessed an invention for a "'process' for rendering a halftone image," which basically allows computers to display numerous colors using a limited number of pixel colors. 627 F.3d 859, 863, 868 (Fed. Cir. 2010). The court recognized that the "Supreme Court did not presume to provide a rigid formula or definition for abstractness," but instead, "invited this court to develop 'other limiting criteria that further the purposes of the Patent Act." Id. at 868. With that guidance, the court stated that it "will not presume to define 'abstract' beyond the recognition that this disqualifying characteristic should exhibit itself so manifestly as to override the broad statutory categories of eligible subject matter and the statutory context that direct primary attention on the patentability criteria of the rest of the Patent Act." Id.

Against that backdrop, the Federal Circuit reversed the district court's summary judgment that the patents did not claim patent-eligible inventions largely on two bases. Id. at 868-869. First, the court found that "[t]he invention presents functional and palpable applications in the field of computer technology. … Indeed, the court notes that inventions with specific

1 applications or improvements to technologies in the marketplace are not likely to be so abstract

2 that they override the statutory language and framework of the Patent Act." Id. Second, the

3 acknowledged that "[i]n determining the eligibility of respondents' claimed process for patent

4 protection under section 101, their claims must be considered as a whole. It is inappropriate to

5 dissect the claims into old and new elements and then to ignore the presence of the old elements

6 in the analysis." Id. Thus, though the patented claims incorporated algorithms, the court found

7 that "the patentees here 'do not seek to patent a mathematical formula. Instead, they seek patent

8 protection for a process of 'half-toning in computer applications.'" Id. Applying these principles

9 to the '459 Patent makes clear its subject matter is not abstract.

10 The subject matter of the '459 Patent is coding and categorizing network pages, such as

11 web pages on the Internet, based on the content of the network page. The inventions organize

12 network pages using categorization labels and codes based upon the content on the network

13 page, including whether the pages contain commercial or non-commercial information, as well

14 as the copyright status of the material. ('459 Patent, Col. 3, ll.8-21, Ex. A). A "network page" in

15 the context of the '459 Patent is a page on a network, such as the Internet, a private corporate

16 network, an intranet, a local area network or other network.[1] In Claim 1 of the '459 Patent, a

17 network page can be categorized for "transacting business" and/or categorized for "providing

18 information," for example, network pages that contain articles, journals or publications. After

19 the network page is "assigned" to one or more categories, it is labeled using at least the copyright

20 status of the material on the network page. Once the page has been labeled, use of the network

21 page is controlled using the label and copyright status. ('459 Patent, Col. 12, ll. 24 - 39, Ex. A).

22

23 [1] In IconFind Inc. v. Yahoo! Inc., No. Civ. 09-109 WBS JFM, Order of Dec. 14, 2009 (Dkt. No. 50), Judge Shubb construed the term "network page" as "page on the Internet, private corporate network, local area network or other network."

24

Independent Claim 30 is similar to Claim 1 but adds, among other things, that a categorization code is used for labeling the network pages. This code is a unique system of characters or symbols that represent the categories to which a page may be assigned. Independent Claim 31 adds, among other things, additional copyright categories, including "categories relating to the public domain, fair use only, use with attribution, and permission of copyright owner needed." ('459 Patent, Col. 14, ll. 36 - 43, Ex. A).

Like the patents addressed in the Research Corporation Technologies decision, IconFind's patent "presents functional and palpable applications in the field of computer technology." 627 F.3d at 868-869. As the background of the '459 Patent explains, "[t]he Internet contains over two billion Web pages. It has been estimated that two million Web pages are added to the Internet each day (The Industry Standard, Feb. 28, 2000). This vast amount of information is a tremendous resource for the public to use. However, there is no effective way for a user to obtain relevant information." ('459 Patent, Col. 1, ll. 27-32, Ex. A). The '459 Patent also explains that "it is often difficult for a user to determine the copyright status of material on the Internet. There is also no easy way for owners of content to indicate the copyright status of their material. This problem has hampered the flow of information and left both the owners of content and users confused and potentially in legal jeopardy." (Id. at Col. 2, ll. 66 - Col. 3, ll. 4, Ex. A). The inventions claimed in the '459 Patent were designed to address these problems, and thus have functional and palpable applications in the computer industry.

Additionally, like the underlying decision in Research Corporation Technologies, Google's analysis falls short for failing to consider the claims as a whole, and instead, focusing principally on the "computer implemented method" limitation. (See e.g. Def.'s Mem., Dkt. No. 30, pp. 6, 9 and 13). As discussed above, Claim 1 of the '459 Patent claims a computer implemented method of categorizing a network page, including providing categories (such as

copyright status), assigning the network page to categories, providing a categorization label and

controlling usage of the network page using the categorization label and copyright status. ('459

Patent, Col. 12, ll. 24-38, Ex. A). These multi-faceted inventions plainly have practical

applications in Web/Internet development. Clearly, under <u>Research Technologies Corporation</u>,

the '459 Patent's inventions are not so manifestly abstract as to override the broad statutory

categories of eligible subject matter. <u>See</u> 35 U.S.C. § 101.

C. The '459 Patent Claims Patent-Eligible Subject Matter Under the Machine or Transformation Test

To determine whether a method claims subject matter that is patent eligible, a court may

look to the MOT Test for guidance. <u>Prometheus Labs., Inc.</u> v. <u>Mayo Collaborative Servs. &</u>

<u>Mayo Clinic Rochester</u>, 628 F.3d 1347, 1355 (Fed. Cir. 2010). Under the MOT Test, a method

is patent eligible if: (1) "it is tied to a particular machine or apparatus," or (2) "it transforms a

particular article into a different state or thing." <u>Bilski I</u>, 545 F.3d at 954. "The use of a specific

machine or transformation of an article must impose meaningful limits on the claim's scope to

impart patent-eligibility." <u>Id.</u> at 962 (citing <u>Benson</u>, 409 U.S. at 590). In order for a patent to

meet the "transformation test," the invention must "transform[] an article into a different state or

being." <u>Id.</u> at 962. As set forth fully below, the '459 Patent satisfies either prong of the test.

1. The Claims of the '459 Patent Meet the Machine Prong of the MOT Test

The machine prong of the MOT Test requires that the invention(s) be "tied to a particular

machine or apparatus." <u>Bilski I</u>, 545 F.3d at 954. The Supreme Court has defined the term

"machine" as "a concrete thing, consisting of parts, or of certain devices and combination of

devices." <u>Burr</u> v. <u>Duryee</u>, 68 U.S. (1 Wall.) 531, 570 (1863); <u>see also</u> <u>In re Nuijten</u>, 500 F.3d

1346, 1356 (Fed. Cir. 2007). This "includes every mechanical device or combination of

1   mechanical powers and devices to perform some function and produce a certain effect or result."

2   In re Nuijten, 500 F.3d at 1356 (citing Corning v. Burden, 56 U.S. 252, 267 (1853).

3   The inventions of the '459 Patent are directed to providing a solution for "categorizing

4   and searching for information on a network and, more specifically, to categorizing and searching

5   Web pages over the Internet." ('459 Patent, Col. 1, ll. 21-25, Ex. A). Accordingly, the methods

6   as claimed are applicable in a client-server network, which includes tangible devices integral to

7   the functioning of the system as a whole. For example, in the context of the Internet, the claimed

8   inventions may run on one or more server machines, or more specifically, Web servers. These

9   servers and software applications thereon provide categories, categorization labels and

10   categorization codes; they also assign and control usage of the page. The thrust of Google's

11   argument on the machine prong is that "[t]he computer referenced in the preamble of all the

12   claims is merely an 'insignificant extra-solution." (Def.'s Mem., Dkt. No. 30, p.9); (Id. ("[T]he

13   notion that the methods of the claims of the '459 Patent are 'computer implemented' is merely

14   "extra-solution" activity.")). Google totally misses the mark on the legal concept "post-solution

15   activity"; this concept only applies to claims that include a mathematical algorithm or formula

16   (i.e. "post-**solution**" means after the mathematical problem is **solved**). As the Supreme Court

17   explained in Bilski II, the concept of "post-solution activity" surfaced in Flook, 437 U.S. at 585-

18   586. Bilski II, 130 S.Ct. 3218, 3230 (2010). In Flook, the claims were directed towards a

19   procedure for monitoring the conditions in the oil industry and the only element the invention

20   added over the prior art was a specific mathematical algorithm. 437 U.S. at 585-586. The claim

21   limited its application however to only the petrochemical and oil-refining industries so that the

22   algorithm could still "be freely used outside the petrochemical and oil-refining industries." Id. at

23   589-590. The Court held that the process at issue was unpatentable under Section 101, "because

24   once that algorithm [wa]s assumed to be within the prior art, the application, considered as a

whole, contain[ed] no patentable invention." <u>Id.</u> at 594. As the Supreme Court explained in <u>Bilski II</u>, what <u>Flook</u> really stood for was the "proposition that the prohibition against patenting abstract ideas 'cannot be circumvented by attempting to limit the use of the formula to a particular technological environment' or adding 'insignificant post-solution activity.'" 130 S Ct. at 3230; see also <u>In re Schrader</u>, 22 F.3d 290, 294 (Fed. Cir. 1994) ("the recitation of insignificant post-solution activity in a claim involving the solving of a mathematical algorithm could not impart patentability to the claim").

Accordingly, "post-solution" activity refers to activities **after the mathematical problem is solved.** The claims of the '459 Patent do not include a mathematical algorithm or formula, so Google's "post-solution activity" arguments are totally misplaced. Notably, Google repeats this nonsensical argument throughout its brief. (See Def.'s Mem., Dkt. No. 30, pp. 4, 5, 7, 8, 9, 13). The Court should reject each such instance of this argument.

Google's other chief argument under the machine prong is that the recitation of a general purpose computer cannot save the '459 Patent's claims from being found unpatentable under Section 101.[2] (Def.'s Mem., Dkt. No. 30, p. 8). However, the cases Google cites for the proposition that the recitation in a method of claim of a "general purpose computer" is not sufficient structure to meet the MOT test are distinguishable from the case – and the claims – at hand.

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[2] The crux of Google's motion is that the mere recitation of "computer implemented method" is not enough to meet the MOT Test. However, Google uses the same language to procure its own patent rights. Specifically, as noted in the Complaint, Google cited IconFind's patent as prior art during prosecution of its own U.S. Patent No. 7,788,274, entitled "Systems and methods for category-based search." (Compl., Dkt. No. 1, ¶9); ('274 Patent, Ex. C). The claims of the '274 Patent include "A computer-implemented method for category-based search…" ('274 Patent, Ex. C). As such, it is quite ironic that while Google insists that IconFind's technology is unpatentable, it nevertheless continues to seek patent protection on comparable technology and similar claim language.

1   In <u>CLS Bank Intern.</u> v. <u>Alice Corp. Pty. Ltd.</u>, 2011 WL 802079, *2 (D.D.C. Mar. 9,

2   2011), the inventions of the four patents-in-suit were directed towards a "methods or systems

3   that help lessen settlement risk using a computer system." The defendants asserted – and the

4   court agreed – that the methods "attempt[ed] to patent the abstract idea of 'exchanging an

5   obligation between parties' after ensuring that there is 'adequate value' in independent accounts

6   maintained for the parties.'" <u>Id.</u> at 19. The claims recited "electronically adjusting" records

7   and/or accounts and contained no explicit recitation of any machine or apparatus, such as a

8   computer. <u>Id.</u> at *13. The court presumed for the purpose of the motion that the inventions were

9   to be realized through use of a computer with specific programming. <u>Id.</u> at *14. The court went

10   on to explain that "[t]he single fact that [plaintiff's] method claims are implemented by a

11   computer does not mean the methods are tied to a particular machine under the MOT test,"

12   explaining "the claims before the court at most implicitly recite a computer by claiming

13   electronic adjustment of records or accounts." <u>Id.</u> at *14-16. The court then assessed whether a

14   computer "imposed any meaningful limitation on the processes themselves" and found that while

15   "a computer may facilitate and expedite the claimed methods, [] the methods before the court

16   could be performed without the use of a computer." <u>Id.</u> at *18.

17   The inventions of the '459 Patent, to the contrary, not only explicitly recite that the

18   inventions are "computer implemented," but the computer (e.g. a web server in the context of the

19   Internet), which consists of hardware and software, is essential to the inventions. As explained

20   above, these components provide the following functionality: providing a list of categories;

21   assigning network pages to these categories; providing a categorization label for the network

22   page using the copyright status of the material on the page; and controlling the usage of the

23   network page using the label and the copyright status. The system could not be implemented

24   without the use of the computer: the very heart of the invention is to categorize and label

25

network pages (e.g. Internet web pages). This **cannot** be done with a pencil and paper, as Google contends. See SIRF Tech., Inc. v. Int'l Trade Comm'n, 601 F.3d 1319, 1332 (Fed. Cir. 2010) ("A GPS receiver is a machine and is integral to each of the claims at issue.").

Google's other citations are likewise distinguishable. In Bancorp Services, L.L.C. v. Sun Life Assur. Co. of Canada, 2011 WL 665679, *1 (E.D. Mo. Feb 14, 2011), the patents-in-suit were drawn to systems for administering and tracking the value of separate-account life insurance policies. The court found that the "specified machines [in the claims] appear to be no more than 'object[s] on which the method operates' and that 'the steps of tracking, reconciling and administering a life insurance policy with a stable value component can be completed manually.'" Id. at *9. Similarly, in Fuzzysharp Technologies Inc. v. 3DLabs Inc., Ltd., 2009 WL 4899215, *1 (N.D. Cal. Dec. 11, 2009), the inventions of the patents-in-suit were "directed to improving 3D computer graphics 'through provision of an improved method for performing visibility calculations'" and the claims were "drawn to mathematical algorithms that can be used to reduce the number of calculations required to determine whether a 3D surface is visible or invisible on a display screen." As the court explained:

> The claim language clearly states that these claims are drawn to mathematical calculations and algorithms for calculating whether certain surfaces are visible or invisible in 3D graphics … Though the calculations may be "performed by a computer," they are not tied to any *particular* computer. For these reasons, the claims of the '047 and '067 Patent fail to pass muster under the *Bilski* machine implementation test for patentability under 35 U.S.C. § 101.

Id. at *5. In this case, the claims of the '459 Patent are not drawn to a mathematical calculation or algorithm (or any other fundamental law of nature) that was made electronic through the use of a computer for efficiency purposes, as was the case in Fuzzysharp and Bancorp. The inventions of the '459 Patent are new and useful methods for categorizing network pages according to content and copyright status. The invention could not be possible without the use of

1   the "computer." Without the "computer" in <u>Fuzzysharp</u>, all that was left was an algorithm, and

2   without the "computer" in <u>Bancorp</u>, one would only be left with an idea for administering and

3   tracking the value of separate-account life insurance policies; in this case, without the

4   "computer," **there would be no inventions**. <u>See</u> <u>SIRF Tech., Inc.</u>, 601 F.3d at 1333 (holding

5   that the inventions "require the use of a particular machine (a GPS receiver) and could not be

6   performed with the use of such a receiver").

7   Lastly, with respect to the machine prong, Google cites <u>Ultramercial</u> and <u>Cyberspace</u>

8   <u>Corp.</u> v. <u>Retail Decisions, Inc.</u>, 620 F. Supp. 2d 1068 (N.D. Cal. 2009), for the proposition that a

9   "network" is not a "machine" for the purposes of the MOT test. In <u>Ultramercial</u>, the claims of

10   the invention disclosed a method for allowing internet users to view copyrighted material free of

11   charge in exchange for watching certain advertisements. <u>Ultramercial, LLC</u>, 2010 WL 3360098

12   at *1 (C.D. Cal. Aug. 13, 2010). The claims included a number of steps that comprise the

13   process of displaying advertisements in exchange for access to copyrighted media and did not

14   recite anything that could be construed as a "machine" aside from the words "facilitator" and

15   "Internet." <u>Id.</u> at *4. The claims and the specification, to the court, made clear that the claims

16   were "not aimed at a computer-specific application; it is **a broad claim to the concept of**

17   **exchanging media for advertisement viewing**." <u>Id.</u> (emphasis added).

18   This is clearly not the case with respect to IconFind. The '459 Patent does not broadly

19   claim the concept of categorizing, but instead, a computer implemented method of categorizing

20   network pages including numerous specific machine-implemented (e.g. web server) steps.

21   Additionally, the fact that the <u>Ultramercial</u> court held that the recitation of the "Internet" did not

22   save the patent because the "Internet is not a machine" is also not on point here. <u>Id.</u> The

23   inventions of the '459 Patent are much more than a mere idea that functions over the Internet;

24

they are specific computer-implemented methods of coding, categorizing and labeling pages that reside on the Internet or other networks.

2. The Claims of the '459 Patent Meet the Transformation Prong of the MOT Test

The "transformation" prong of the MOT Test is met where the method "transforms an article into a different state or thing." Bilski I, 545 F.3d at 962. This transformation must also be "central to the purpose of the claimed process." Id. at 962. As explained above, the methods transform network pages through the use of a "categorization label" so that use of the page is restricted to the category or categories to which the page is assigned, including copyright status. The pages are transformed when they are correctly labeled. This is important because the pages, when labeled, provide the ability to notify others of the copyright status of that content. As the patent explains, "[t]he categorization label will be readable by Web crawlers and may be visible to users. … By 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." ('459 Patent, Col. 7, ll. 27-28, Ex. A). As required by Bilski I, this "categorization label" transformation is "central to the purposes of the claimed process." Bilski I, 545 F.3d at 962.

Google cites CS Bank Int'l in asserting that it would be incorrect to argue that "the underlying categorizations are taking place on a computer and, thus, the underlying electrons of the various memory systems are being "transformed." (Def.'s Mem., Dkt. No. 30, p. 10). Google misses the mark on this preemptive argument. Quite to the contrary, IconFind is not arguing that network pages are transformed because the underlying electrons of the data are being transformed. First, the network pages themselves are being transformed i.e. the underlying code that makes up the pages. Additionally, the network pages may also be transformed by the placement of a visible label. In any event, the network page is being transformed. Bilski I's

discussion of <u>In re Abele</u> is instructive on this point. 545 F.3d at 962-963. The <u>Bilski I</u> court

noted that "the transformation of that raw data into a visual depiction of a physical object on a

display was sufficient to render that more narrowly-claimed process patent-eligible." Like the

raw data in <u>In re Abele</u>, the underlying code of a network page (e.g. a Web page) is rendered into

visual depictions of physical objects (e.g. Amazon.com depicts physical items for purchase).

Clearly, the invention transforms network pages – a purpose of the invention was to

categorize the pages in a certain way (i.e. through a label) so that the use of the network pages

would be restricted according to the content and copyright status. Accordingly, the '459 Patent

passes muster under the transformation prong of the MOT Test.

D.   The Interim Guidelines Support a Finding That the Claims of the '459 Patent Are Directed To Patentable Subject Matter

Several factors cited by the USPTO in its Interim Guidelines support a finding that the

claims in the '459 Patent are not drawn to an abstract idea. The first factor mirrors the

"machine" prong of the MOT Test and includes the following additional factors applicable

where, as here, a machine is expressly recited in the claims (which is in and of itself a factor

weighing in favor of patentability):

> Whether the machine or apparatus implements the steps of the method. Integral
> use of a machine or apparatus to achieve performance of the method weighs
> toward eligibility ….   [T]he extent to which (or how) the machine or apparatus
> imposes meaningful limits on the execution of the claimed method steps.

(75 Fed. Reg. at 43,925, Ex. B). These factors clearly weigh toward eligibility in this case. Each

computer on which the invention performs, whether it be a web server in the context of the

Internet or another server machine in a private corporate network, is clearly integral to the

process of providing and assigning categorization labels and codes to network pages. The

computer is not "merely an object on which the method operates." The web server is integral to

the method of categorizing, labeling and coding pages that reside on the Internet – it is what

makes the functional actions and palpable results of the methods possible.

The next consideration mirrors the "transformation" prong of the MOT Test and includes

the following additional factors, where, as here, transformation exists (which is in and of itself

also a factor weighing in favor of patentability):

> The particularity or generality of the transformation. …The nature of the
> transformation in terms of the type or extent of change in state or thing, for
> instance by having a different function or use, which would weigh toward
> eligibility[.] … A transformation that contributes only nominally or
> insignificantly to the execution of the claimed method (e.g., in a data gathering
> step or in a field-of-use limitation) would weigh against eligibility.

(75 Fed. Reg. at 43,925, Ex. B). These factors also weigh toward patentability in this case. As

explained above, the pages are transformed when they are correctly labeled. Transformation

clearly occurs and this transformation is **essential** to the claimed inventions: the pages, now

labeled, provide the ability to notify others of the copyright status of content on the network

page. After a page is labeled, search engines may recognize the label on the page. For all of

these reasons, the USPTO's guidelines support patentability of the subject matter of the '459

Patent.

> **E.   The Claims of the '459 Patent Are Directed
> To Patentable Subject Matter In Light of
> The Supreme Court's "Guidepost" Set of Cases**

The Supreme Court in Bilski II noted that lower courts should look to Gottschalk v.

Benson, 409 U.S. 63 (1972), Parker v. Flook, 437 U.S. 584 (1978) and Diamond v. Diehr, 450

U.S. 175, 187 (1981)) as "guideposts" to enlighten this inquiry. See Bilski II, 130 S. Ct. at 3229-

3231.

In Benson, the Supreme Court rejected a patent application for a method for

programming a general-purpose computer to convert binary-coded decimal numerals into pure

binary numerals. 409 U.S. at 65. The process used a piece of hardware—the reentrant shift register—to carry out calculations. Id. at 73. The Court held that the application at issue was not a "process," but an unpatentable abstract idea, stating "it is conceded that one may not patent an idea. But in practical effect that would be the result if the formula for converting ... numerals to pure binary numerals were patented in this case." Id. at 71. A contrary holding "would wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself." Id. at 72. The claims at issue in the '459 Patent are not directed towards a specific formula or algorithm; instead, the claims at issue here concern a specific method of categorizing and labeling network pages. Thus, Benson does not dictate, or even support, a finding that the '459 Patent's subject matter is unpatentable.

As discussed above, the Bilski II court acknowledged that Flook "stands for the proposition that the prohibition against patenting abstract ideas 'cannot be circumvented by attempting to limit the use of the formula to a particular technological environment' or adding 'insignificant post-solution activity.'" 130 S Ct. at 3230. As noted above, no algorithm is required in the claims of the '459 Patent; the claims of the '459 Patent are directed to a methods for categorizing and labeling network pages to allow for more informed and organized access to them and their copyright status.

Google notably did not cite Diehr in its brief despite the Supreme Court's explicit direction to lower courts to take into account Benson, Flook **and** Diehr. This is because Diehr does not support Google's position. In Diehr, "the Court established a limitation on the principles articulated in *Benson* and *Flook*." Bilski II, 130 S. Ct. 3230. The claims in Diehr were directed to a previously unknown method for "molding raw, uncured synthetic rubber into cured precision products," using a mathematical formula to complete some of its several steps by way of a computer. Diehr, 450 U.S., at 177. The Court explained that while an abstract idea,

law of nature, or mathematical formula could not be patented, "an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection." Id. at 187. Hence, Diehr "emphasized the need to consider the invention as a whole, rather than 'dissect[ing] the claims into old and new elements and then ... ignor[ing] the presence of the old elements in the analysis.'" Bilski II, 130 S. Ct. at 3230 (citing Diehr, 450 U.S. at 188, 101 S.Ct. 1048). The Diehr court concluded that because the claim was not "an attempt to patent a mathematical formula, but rather [was] an industrial process for the molding of rubber products," it fell within § 101's patentable subject matter." Id. (citing Diehr, 450 U.S. at 188, 101 S.Ct. 1048).

Accordingly, Diehr instructs the Court to take into account the inventions claimed in the '459 Patent as a whole in assessing whether it meets the requirements of Section 101. Google characterizes the invention as merely methods of categorizing a network page. However, in assessing the inventions and claims as a whole, as IconFind has done in this memorandum, it is clear that the claims are directed to not just the mere categorization of network pages, but the categorization, assignment, labeling and coding of those pages so the creators can notify others regarding the copyright status of that content, others are aware of how they are allowed to use the content of the network page according to the label on the page, and search engines can recognize network pages assigned to certain categories.

**F.   The Prosecution History of the '459 Patent Supports
A Finding That the '459 Patent is Directed To Eligible Subject Matter**

Google clings to the prosecution history of the '459 Patent to support its argument that its claims are drawn to ineligible subject matter under Section 101. Google argues that the rejection of the claims under Section 101 and the subsequent addition of the phrase "computer implemented" support a finding of unpatentability. To the contrary, this supports a finding that

the USPTO, when presented with the exact same question the Court is faced with today, found

that the '459 Patent was directed to eligible subject matter.

First, Google self-servingly plucks out portions of the file history without context.

Google makes it seem as though Section 101 was the only rejection in the file history, and

improperly infers that the applicant simply added "a computer implemented method" to cure this

problem. However, the independent claims as amended at the time of that rejection were

different than they are today; for instance, Claim 1 read:[3]

> Claim 1 (currently amended): A method of categorizing a network page, comprising the steps of:
>   a.   providing a list of categories, wherein said list of categories include a category for transacting business and a category for providing information; and
>   b.   providing the opportunity to assigning [[a]] said network page to one or more of a plurality of said list of categories.

(See Google's Request for Judicial Notice, Ex. 1-2, p. 43 (Dkt. No. 31-2)). After a telephone

interview concerning a separate Section 102 rejection, the examiner issued an Interview

Summary which indicated that the claims still stood as rejected under Section 101. In the

applicants' response to the examiner's Section 101 rejection, the applicant amended the claims as

follows:

> 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.

(See Google's Request for Judicial Notice, Ex. 1-2, p. 75 (Dkt. No. 31-2)). The examiner in his

response cited no Section 101 rejection. (See Google's Request for Judicial Notice, Ex. 1-3, pp.

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[3] The crossed through words were deleted and the underlined words were added by the applicant.

1   10-18 (Dkt. No. 31-3)). Still, the claims were amended further to include, for Claim 1, the steps

2   of "providing a categorization label…" and "controlling usage of the network page…". (See

3   Google's Request for Judicial Notice, Ex. 1-3, p. 24 (Dkt. No. 31-3)). **Those** are the claims of the

4   '459 Patent **as issued**. Indeed, the examiner expressly relied on the additional steps "assigning

5   said network page…", "providing a categorization label…", and "controlling usage of the

6   network page…" as the reasons for allowance – not the "computer implemented method"

7   language. (See Google's Request for Judicial Notice, Ex. 1-3, pp. 73-76 (Dkt. No. 31-3)).

8   As such, for Google to suggest that the claims were amended solely because of or in

9   response to a Section 101 rejection is improper. Additionally, for Google to imply that the

10 claims as rejected under Section 101 were identical to the issued claims with the exception of the

11 phrase "a computer implemented method" is simply an incorrect characterization of the file

12 history.

13   Second, the fact that the PTO, after assessing this precise issue, confirmed the

14 patentability of the claims of the '459 Patent undercuts Google's arguments. See Hyatt v.

15 Kappos, 625 F.3d 1320, 1334 (Fed. Cir. 2010) (*en banc*) (recognizing the deference owed the

16 PTO as "the knowledgeable agency charged with assessing patentability"); Applied Materials,

17 Inc. v. Advanced Semiconductor Materials Am., Inc., 98 F.3d 1563, 1569 (Fed. Cir. 1996) ("The

18 presumption of validity is based on the presumption of administrative correctness of actions of

19 the agency charged with examination of patentability").

20   Finally, any attempt by Google to argue that the PTO's decision would have been

21 different in a post-Bilski II era would also invite legal error. Google mischaracterizes the

22 Supreme Court's Bilski II decision by stating that the Court "recently made clear, however,

23 abstract ideas – which are unpatentable as a matter of law – cannot otherwise be made patentable

24 simply by directing them to run on a general purpose computer." (Def. Mem, Dkt. No. 30., p.

25

2,). However, <u>Bilski II</u> simply clarified that the MOT Test was not the exclusive test, as the Federal Circuit had held in <u>Bilski I</u>, and that it is instead a "useful and important clue, an investigative tool." <u>Bilski II</u>, 130 S. Ct. at 3226; <u>see also</u> <u>Prometheus Labs., Inc.</u>, 628 F.3d at 1355. The law regarding Section 101 remains the same post-<u>Bilski</u>; the Court merely clarified that the MOT Test is not the exclusive test. Accordingly, that the prosecution of the '459 Patent occurred pre-<u>Bilski II</u> is of no consequence. The examiner still had the benefit of the authorities relied upon by <u>Bilski II</u> (i.e., <u>Benson</u>, <u>Flook</u>, and <u>Diehr)</u> as well as the MOT Test.

For the foregoing reasons, this Court has the benefit of the expertise of the PTO on this precise issue and should follow the lead of the examiner in finding that the claims are directed to patentable subject matter under Section 101.

VI.   CONCLUSION

WHEREFORE, for the foregoing reasons, IconFind respectfully requests that this Court deny Google's motion for judgment on the pleadings pursuant to Rule 12(c) because, as that rule requires, the pleadings are not yet "closed." Should the Court convert Google's motion to a motion to dismiss for failure to state a claim pursuant to Rule 12(b)(6), or a motion for summary judgment, IconFind respectfully requests that this Court deny Google's motion on the merits.

Respectfully submitted,

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