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

Iconfind, Inc.,)	
)	2:11-cv-00319-GEB-JFM
Plaintiff,)	
)	
v.)	<u>ORDER</u> *
)	
Google, Inc.,)	
)	
Defendant.)	
_____)	

Plaintiff Iconfind moves for an order dismissing Defendant Google's invalidity counterclaim and striking Google's invalidity affirmative defense. Iconfind argues Google's invalidity allegations are not facially plausible claims, and therefore Iconfind has not been provided with fair notice of the claimed invalidity.

The motion concerns Google's second affirmative defense and second counterclaim in which it alleges that the patent-in-suit, U.S. Patent No. 7,181,459 (the "'459 patent"), is invalid. These allegations are identical and are the following:

The Claims of the '459 patent are invalid under 35 U.S.C. § 101 because they fail to claim patentable subject matter insofar as each seeks to claim an abstract idea; [and] because they fail to meet the 'conditions for patentability' of 35 U.S.C. §§ 102, 103, and/or 112 because the claims lack utility; are taught by, suggested by, and/or obvious in view of, the prior art; and/or are not adequately

* This matter is deemed suitable for decision without oral argument. E.D. Cal. R. 230(g).

1 supported by the written description of the
2 patented invention.

3 A counterclaim may be dismissed for "failure to state a claim
4 on which relief can be granted." Fed. R. Civ. P. 12(b)(6). Further,
5 "the court may strike from a pleading [any] insufficient defense
6" Fed. R. Civ. P. 12(f).

7 A pleaded claim or defense must "give . . . fair notice of
8 what the . . . claim [or defense] is and the grounds upon which [relief]
9 rests" Bell Atlantic Corp. v. Twombly, 550 U.S. 544, 555
10 (2007); see also Qarbon.com, Inc. v. eHelp Corp., 315 F. Supp. 2d 1046,
11 1048-49 (N.D. Cal. 2004). A pleading must allege "enough facts to
12 [show] relief . . . is plausible on its face." Twombly, 550 U.S. at
13 570. Facial plausibility means the pled "factual content [is sufficient
14 for a court] to draw the reasonable inference" that the pleader is
15 entitled to relief. Ashcroft v. Iqbal, 129 S. Ct. 1937, 1949 (2009).

16 Under the applicable pleading standard, the court "accept[s]
17 as true all facts [pled]. . . , and draw[s] all reasonable inferences in
18 favor of the [non-movant]." Al-Kidd v. Ashcroft, 580 F.3d 949, 956 (9th
19 Cir. 2009). However, neither conclusory statements nor legal
20 conclusions are entitled to a presumption of truth. See Iqbal, 129 S.
21 Ct. at 1949-50.

22 Google's invalidity allegations are comprised solely of legal
23 conclusions and/or conclusory factual allegations. First, Google
24 alleges that the '459 patent is invalid under 35 U.S.C. § 101 because
25 the patent "seeks to claim an 'abstract idea.'" This conclusory
26 allegation is insufficient under the pleading standard since it does not
27 contain factual allegations sufficient to support drawing a reasonable
28 inference that '459 patent does not contain patentable ideas. "A
reference to a doctrine, like a reference to statutory provisions, is

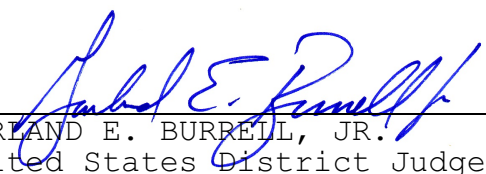
1 insufficient notice[]" of the basis for the relief the pleader seeks.
2 Qarbon, 315 F. Supp. 2d at 1049.

3 Google's prior art invalidity allegations, alleged under 35
4 U.S.C. §§ 102 and 103, are also insufficient since Google fails to
5 allege facts sufficient for a reasonable inference to be drawn that the
6 claimed invention is invalid in light of prior art. Cf., VG
7 Innovations, Inc. v. Minsurg Corp., No. 10-1726, 2011 U.S. Dist. LEXIS
8 41756, at *4-5, 2011 WL 1466181, at *2 (M.D. Fla. Apr. 18, 2011)
9 (examining an allegation that the patent-in-suit was invalid "in light
10 of the Stein Paper and other prior art, including scholarly articles and
11 patents disclosing the use of minimally invasive surgical portals and
12 approaches").

13 Lastly, Google's allegation that the claims of the '459 patent
14 "are not adequately supported by the written description of the patented
15 invention" is a legal conclusion since no factual allegations are pled
16 from which a reasonable inference could be drawn that Iconfind failed to
17 provide an adequate written description of the '459 patent.

18 Therefore, Iconfind's motion to dismiss Google's second
19 counterclaim and to strike Google's second affirmative defense is
20 granted. Google is granted ten (10) days from the date on which this
21 order is filed to amend the deficiencies in its pleading addressed in
22 this Order. Failure to amend within this leave period could result in a
23 dismissal order issuing with prejudice.

24 Dated: August 2, 2011

25
26 
27 GARLAND E. BURRELL, JR.
28 United States District Judge