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11 **UNITED STATES DISTRICT COURT**  
 12 **FOR THE EASTERN DISTRICT OF CALIFORNIA**

13	ICONFIND, INC.,	)	Case No. 2:11-CV-00319 GEB JFM
14		)	
15	Plaintiff,	)	
16		)	
17	v.	)	
18	GOOGLE INC.,	)	
19		)	
20	Defendant.	)	
21		)	

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22 **DEFENDANT GOOGLE INC.'S INVALIDITY CONTENTIONS PURSUANT**  
 23 **TO JOINT STATUS REPORT**  
 24  
 25  
 26  
 27

1 Pursuant to the Joint Status Report (Dkt. 47), Defendant Google Inc., (“Google”) hereby  
2 provides its Invalidity Contentions to Plaintiff IconFind, Inc., (hereinafter “IconFind”) with  
3 respect to the asserted claims identified by IconFind in its July 1, 2011, Plaintiff’s Infringement  
4 Contentions To Google Inc. (“Infringement Contentions”).

5 Google’s investigation of the matters disclosed is ongoing. Google reserves the right to  
6 supplement or modify these disclosures as new information becomes available through fact and  
7 expert discovery or other investigation as provided in the Federal Rules of Civil Procedure, and  
8 if the claim(s) of U.S. Patent No. 7,181,459 (“the ’459 patent”) are construed by this Court or  
9 any other court. These Contentions are made without prejudice to Google’s right to obtain and  
10 present before or at trial any additional evidence that may be acquired through discovery or  
11 otherwise in this action.

12 **I. RESERVATIONS AND OBJECTIONS**

13 The information and documents produced are provisional and subject to revision as  
14 follows. For purposes of these Invalidity Contentions, Google identifies prior art references and  
15 provides element-by-element claim charts based in part on the apparent constructions of the  
16 asserted claims advanced by IconFind in its Infringement Contentions. Nothing in these  
17 disclosures shall be treated as an admission that Google agrees with IconFind regarding the  
18 scope of any of the asserted claims or claim constructions advanced by IconFind in its  
19 Infringement Contentions. Google’s claim constructions will be disclosed during the claim  
20 construction process. If the Court’s claim construction alters or changes the scope or meaning of  
21 an asserted claim or claim element, Google reserves its right to supplement these contentions.

22 In many instances, Google’s Invalidity Contentions are based on their understanding of  
23 the asserted claims in light of the positions apparently taken by IconFind in its Infringement  
24 Contentions, to the extent those contentions can be understood. In other words, to the extent the  
25 contentions employed by IconFind in alleging infringement is accepted (including any implicit  
26 claim constructions suggested by the infringement contentions), the claims are invalid. In  
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1 making such invalidity contentions, Google does not agree to nor acquiesce in IconFind's  
2 infringement contentions or its implicit claim constructions. Further, Google reserves all rights  
3 to amend these Invalidity Contentions should IconFind's contentions change.

4 Google also expressly reserves the right to revise, amend, and/or supplement its  
5 disclosures and document production should IconFind attempt to rely on any information that it  
6 failed to provide in its disclosures. Furthermore, because discovery has only recently begun,  
7 Google reserves the right to revise, amend, and/or supplement the information provided herein  
8 should further analysis and discovery lead to additional information, consistent with the Joint  
9 Status Report and the Federal Rules of Civil Procedure. In addition, Google's ultimate  
10 contentions concerning the invalidity of the asserted claims may change depending upon the  
11 Court's construction of the claims and/or positions that IconFind or its witnesses (including the  
12 purported inventors of the '459 patent) may take concerning claim interpretation, infringement,  
13 and/or invalidity issues, including but not limited to indefiniteness, conception, reduction to  
14 practice, inventorship, anticipation, obviousness, and secondary considerations.

15 Prior art not included in this disclosure, whether known or not known to Google, may  
16 become relevant. In addition, the obviousness combinations of references provided below under  
17 35 U.S.C. § 103 are merely exemplary and are not intended to be exhaustive. In particular,  
18 Google is currently unaware of the extent, if any, to which IconFind will contend that elements  
19 of the asserted claims are not disclosed in the prior art identified by Google. To the extent such  
20 an issue arises, Google reserves the right to identify other references that would render such  
21 element obvious.

22 Furthermore, Google's claim charts cite particular teachings and/or disclosures of the  
23 prior art as applied to features of the asserted claims. However, persons of ordinary skill in the  
24 art generally may view an item of prior art in the context of other publications, literature,  
25 products, and technical knowledge. As such, Google reserves the right to rely on uncited  
26 portions of the prior art references, related file histories, other publications, and testimony as aids  
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1 in understanding and interpreting the cited portions, as providing context to them, and as  
2 additional evidence that the prior art discloses a claim element. Google further reserves the right  
3 to rely on uncited portions of the prior art references, related file histories, other publications,  
4 and testimony to establish that a person of ordinary skill in the art would have been motivated to  
5 combine certain of the cited references so as to render the claims obvious.

6 Google has only produced claim charts for those claims that are currently asserted against  
7 Google, according to Plaintiff's Infringement Contentions (the "Asserted Claims"). If Plaintiff  
8 revises its Infringement Contentions to include additional claims, Google expressly reserves the  
9 right to supplement its claim charts.

10 Google further reserves the right to rely on invalidity based on 35 U.S.C. § 101 and §  
11 112(1) and (2) beyond that which is discussed below to the extent those defenses arise based  
12 upon discovery of additional facts or changes in the law. Nothing in these disclosures shall be  
13 treated as an admission that Google is obligated to produce documentation not under its custody  
14 or control, or that can be obtained from some other source that is more convenient, less  
15 burdensome and/or less expensive, or for which the burden or expense outweighs its likely  
16 benefit. Google expressly reserves the right to revise, amend, and/or supplement its disclosures  
17 and document production should additional documentation become available.

## 18 **II. INVALIDITY CONTENTIONS**

### 19 **A. Identification of Prior Art**

20 Google identifies the following prior art. Google may also rely on any of the references  
21 disclosed in the '459 patent.

22 For the reasons set out above, Google may rely upon any of the prior art listed below, and  
23 may also identify or rely upon additional references, either individually or in combination, that  
24 anticipate or render obvious the Asserted Claims.

- 25 • U.S. Patent No. 5,933,827 (filed September 25, 1996; issued August 3, 1999 to Cole  
26 and Engleman) ("*Cole*")

- 1           • U.S. Patent No. 6,112,181 (filed November 6, 1997; issued August 29, 2000 to Shear,  
2           et al.) (“*Shear*”)
- 3           • U.S. Patent No. 6,094,657 (filed October 1, 1997; issued July 25, 2000 to Hailpern, et  
4           al.) (“*Hailpern*”)
- 5           • U.S. Patent No. 5,835,905 (filed April 9, 1997; issued November 10, 1998 to Pirolli,  
6           et al.) (“*Pirolli*”)
- 7           • MELVYL<sup>®</sup> Catalog developed by the University of California in 1980. The  
8           MELVYL<sup>®</sup> Catalog is described in, for example:
  - 9               ○ “MELVYL<sup>®</sup> Reference Manual”, Regents of the University of California,  
10              1985 (“*MELVYL*”)
- 11          • Paul Resnick and James Miller, “PICS: Internet Access Controls Without  
12          Censorship”, Communications of the ACM 39 (10): 87–93, published October, 1996  
13          (“*Resnick*”)
- 14          • Miller, J., Resnick, P., and Singer, D., “Rating Services and Rating Systems (and  
15          Their Machine Readable Descriptions)”, World Wide Web Consortium, published  
16          May 5, 1996 on www.w3.org (“*Resnick Ratings*”)
- 17          • Krauskopf, T., Miller, J., Resnick, P., and Treese, G.W., “Label Syntax and  
18          Communication Protocols”, World Wide Web Consortium, published May 5, 1996 on  
19          www.w3.org (“*Resnick Label Syntax*”)
- 20          • Rohit Khare & Joseph Reagle, “Rights Management, Copy Detection, and Access  
21          Control” (Proceedings of NRC/SCTB/Information Systems Trustworthiness Project),  
22          published June 6, 1997 on www.w3.org (“*Khare*”)
- 23          • A. Daviel, “Copy Control for Web Documents”, Vancouver Webpages, Internet  
24          Draft, published November 1996 (“*Daviel*”)
- 25          • Diane Hillmann, “Using Dublin Core,” published July 16, 2000 on dublincore.org  
26          (“*Dublin*”)
- 27          • DCMI, “DCMI Type Vocabulary.” published July 11, 2000 on dublincore.org  
28          (“*Dublin Type Vocabulary*”)
- World Wide Web Consortium, “HTML 4.0 Specification,” published April 24, 1998  
          on www.w3.org (“*HTML 4.0*”)
- Ricardo Baeza-Yates and Berthier Riberio-Neto, “Modern Information Retrieval,”  
          Addison Wesley Longman Publishing Co. Inc., May 15 1999 (“*Baeza-Yates*”)



- All Asserted Claims of the '459 patent are rendered obvious by *Khare* in view of *Dublin*, or, alternatively, in view of *Resnick*
- All Asserted Claims of the '459 patent are rendered obvious by *Pirolli* in view of *Khare*
- All Asserted Claims of the '459 patent are rendered obvious by *Hailpern* in view of *Khare*, or, alternatively, in view of *Dublin*, or, alternatively, in view of *Daviel*, or, alternatively, in view of *Resnick*
- All Asserted Claims of the '459 patent are rendered obvious by MELVYL®

### C. 35 U.S.C. § 101 Invalidity Contentions

The '459 patent is directed to an abstract idea and therefore does not claim patentable subject matter as required under 35 U.S.C. § 101. To determine whether a method claim is directed towards patentable subject matter, a court may apply the machine-or-transformation test for guidance. *Prometheus Labs., Inc. v. Mayo Collaborative Servs. & Mayo Clinic Rochester*, Case No. 2008-1403, 2010 U.S. App.LEXIS 25956, \*19-20 (Fed. Cir. Dec. 17, 2010). The '459 patent does not satisfy the machine prong of the machine-or-transformation test because its nominal recitation of a “computer” does not impose meaningful limits on the scope of the claims as required by the relevant case law. In order for claims to be considered as being implemented on a machine, they need to recite “structural limitations that narrow the computer implemented method to something more specific than a general purpose computer [or] recite any specific operations performed that would structurally define the computer.” *See, e.g., Ex Parte Cherkas*, No. 2009-11287, 2010 WL 4219765, at \*3 (October 25, 2010). In the claims of the '459 patent, no such limitation or specific operation exists; accordingly, the claims fail the machine prong of the machine-or-transformation test.

The '459 patent also fails the transformation prong of the machine-or-transformation test. “Transformation and reduction of an article ‘to a different state or thing’ is the clue to patentability of a process claim that does not include particular machines.” *Bilski v. Kappos*, 130 S. Ct. 3218, 3227 (2010). Neither the “network pages” in the '459 patent, nor anything else in

1 the claims are transformed in any way. Rather, at most, they are being categorized, and the  
2 claimed categorizations are themselves a mere abstraction.

3 The claims of the '459 patent do nothing more than recite the abstract idea of  
4 categorizing a “network page” by the page’s copyright status and whether the page is related to  
5 “transacting business” or “providing information” as well as controlling access to the network  
6 page based on its characterizations; therefore the claims are invalid under 35 U.S.C. § 101. *See*  
7 Google’s Memorandum Of Law In Support Of Its Motion For Judgment On The Pleadings, (Dkt.  
8 30); Google’s Reply In Support Of Its Motion On The Pleadings (Dkt. 49). Furthermore,  
9 because the claims are directed at an abstract idea they also lack utility as required 35 U.S.C. §  
10 101.

11 **D. 35 U.S.C. § 112 Invalidity Contentions**

12 **i. 35 U.S.C. § 112 Contention - Indefiniteness**

13 The Asserted Claims of the '459 patent are invalid because each includes the indefinite  
14 claim limitation “controlling usage of the network page using the categorization label and the  
15 copyright status of the network page.”

16 The specification does not discuss the meaning of this claim term. Furthermore, the term  
17 “controlling usage” is not a term of art and has no special meaning in the field of computer  
18 programming. When applying a categorization label to a network page, a person having ordinary  
19 skill in the art would have no objective way to determine whether that categorization label is  
20 “controlling usage” of the network page because the specification does not teach one how to  
21 make that determination. Thus, this claim limitation is indefinite because it fails to meet the  
22 requirements of 35 U.S.C. § 112, ¶ 2. *See Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d  
23 1342 (Fed. Cir. 2005).

24 **ii. 35 U.S.C. § 112 Contention – Lack of Enablement**

25 The Asserted Claims of the '459 patent are invalid under 35 U.S.C. § 112, ¶ 1 due to lack  
26 of enablement. Each claim includes the claim limitation “controlling usage of the network page  
27



1 using the categorization label and the copyright status of the network page,” which is not enabled  
2 by the specification.

3 This claim element is not discussed in the specification or the prosecution history.  
4 Furthermore, the term “controlling usage” is not a term of art and has no special meaning in the  
5 field of computer programming. If this claim term is not found to be indefinite, it must be given  
6 its ordinary and customary meaning. See *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F. 3d 1359,  
7 1365-66 (Fed. Cir. 2002). The ordinary and customary meaning of this claim term is restricting  
8 or restraining usage of the network page, *i.e.*, disabling some functionality or usage of the  
9 material, for example, disabling the ability to copy text from a network page or disabling the  
10 ability to print a network page. The specification does not teach one skilled in the art how to  
11 restrain the usage of the network page using the categorization label. Therefore, this limitation is  
12 not enabled and the Asserted Claims are invalid under 35 U.S.C. § 112, ¶ 1. See *Genentech Inc.*  
13 *v. Novo Nordisk A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997) (Patents are required to “teach those  
14 skilled in the art how to make and use the full scope of the claimed invention without ‘undue  
15 experimentation.’”).

16 **iii. 35 U.S.C. § 112 Contention – Failure of Written Description**

17 The Asserted Claims of the '459 patent are invalid under 35 U.S.C. § 112, ¶ 2 because  
18 each asserted claim fails to meet the written description requirement. Each claim includes the  
19 claim limitation “controlling usage of the network page using the categorization label and the  
20 copyright status of the network page,” which is not supported by the specification.

21 This claim element is not discussed in the specification or the prosecution history.  
22 Furthermore, the term “controlling usage” is not a term of art and has no special meaning in the  
23 field of computer programming. If this claim term is not found to be indefinite, it must be given  
24 its ordinary and customary meaning. See *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F. 3d 1359,  
25 1365-66 (Fed. Cir. 2002). The ordinary and customary meaning of this claim term is restricting  
26 or restraining usage of the network page, *i.e.*, disabling some functionality or usage of the  
27

1 material, for example, disabling the ability to copy text from a network page or disabling the  
2 ability to print a network page. The specification does not adequately convey to a person having  
3 ordinary skill in the art that the inventor was in possession of an invention that controlled usage  
4 of a network page; therefore, the Asserted Claims of the '459 patent are invalid because each  
5 claim fails to meet the written description requirement. *See LizardTech v. Earth Resources*  
6 *Mapping*, 424 F.3d 1336 (Fed. Cir. 2005) (invalidating a patent under § 112 because the claims  
7 encompassed more than the specification described).

8 **iv. 35 U.S.C. § 112 Contention - Indefiniteness**

9 Claims 27 and 28 of the '459 patent are invalid because each include the phrase  
10 “recognizable to a search engine.” This claim element is insolubly ambiguous and therefore  
11 invalid. *See Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005).

12 The specification does not discuss how to make a categorization label “recognizable to a  
13 search engine.” The '459 patent fails to provide any objective way to determine whether a  
14 categorization label is “recognizable to a search engine.” Thus, the claim limitation fails to meet  
15 the requirements of 35 U.S.C. § 112, ¶ 2.

16  
17 Dated: August 12, 2011

Respectfully submitted,

KAYE SCHOLER LLP

19 By: /s/ Michael J. Malecek

20 Michael J. Malecek  
21 Attorney for Defendant  
22 GOOGLE INC.