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

16 ICONFIND, INC.,

17 Plaintiff,

18 v.

19 GOOGLE INC.,

20 Defendant.

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

**PLAINTIFF'S RESPONSE IN
 OPPOSITION TO DEFENDANT'S
 RENEWED MOTION FOR JUDGMENT
 ON THE PLEADINGS**

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1 **I. INTRODUCTION**

2 Plaintiff IconFind, Inc. ("IconFind") respectfully submits its response in opposition to
3 Defendant Google Inc.'s ("Google") Renewed Motion for Judgment on the Pleadings. Google’s
4 motion fails as a matter of law on a number of grounds.

5 First, Google alleges that the patent-in-suit is invalid for failure to meet the requirements
6 for patentability under Section 101 of Title 35 because it allegedly claims an “abstract idea.”
7 The law is unwavering: invalidity due to Section 101 deficiencies is intimately tied to claim
8 construction and involves underlying legal and factual issues. This issue simply cannot be
9 determined at this stage in the litigation. Even further, Google asks the Court to declare all
10 claims of the patent-in-suit invalid, yet does not address individually why each claim is allegedly
11 invalid. Hence, Google has outright ignored and has plainly not met its “clear and convincing”
12 burden of proof as to each claim in the patent-in-suit.

13 Second, the United States Patent and Trademark Office (“USPTO”) has indeed heard and
14 has vetted the exact same argument that Google now asserts. It is clear that the claims are
15 directed to patentable subject matter under all applicable statutory and case precedent. This
16 Court should find – just as the USPTO found – that the claims of the patent-in-suit are directed
17 towards much more than an abstract idea and meet the requirements of Section 101.

18 For these and the following reasons, Google’s renewed motion should be denied.

19 **II. THE PATENT-IN-SUIT**

20 The Patent-In-Suit, U.S. Patent No. 7,181,459 B2 (“the ‘459 Patent”) describes methods
21 for categorizing network pages, such as web pages on the Internet. The ‘459 Patent recognizes
22 that, in the context of the Internet, one problem with the organization of web pages was the lack
23 of a standardized categorization system for the information contained on such web pages. (‘459
24 Patent, Col. 1, ll. 38-48, Ex. A). The inventors set out to solve this problem by creating a method

1 for categorizing network pages based upon the material on the page, including whether the pages
2 contained commercial or non-commercial information, as well as the copyright status of the
3 material on the page. ('459 Patent, Col. 3, ll.8-21, Ex. A). Claim 1 states:

4 1. A computer implemented method of categorizing a network page,
5 comprising:

6 providing a list of categories, wherein said list of categories include a category for
7 transacting business and a category for providing information, and wherein said
8 list of categories include a category based on copyright status of material on a
9 page;

10 assigning said network page to one or more of said list of categories;

11 providing a categorization label for the network page using the copyright status of
12 material on the network page;

13 and controlling usage of the network page using the categorization label and the
14 copyright status of the network page.

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

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

22 providing a categorization code for labeling the network page with a
23 categorization label, wherein said categorization label indicates a set of categories
24 and subcategories to which the network page is assigned, and wherein said
25 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

1 comprises categories related to public domain, fair use only, use with attribution,
2 and permission of copyright owner needed...

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

6 **III. APPLICABLE LEGAL STANDARD**

7 **A. Invalidity is Not Amenable to a Motion for 8 Judgment on the Pleadings (or a Motion to Dismiss)**

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

16 "The burden of establishing invalidity of a patent or any claim thereof shall rest on the
17 party asserting such invalidity.' ... This burden 'exists at every stage of the litigation.'" Abbott
18 Labs. v. Sandoz, Inc., 544 F.3d 1341, 1346 (Fed. Cir. 2008) (emphasis added). Google must
19 meet this “clear and convincing” burden of proof independently for each claim because “[e]ach
20 claim carries an independent presumption of validity, 35 U.S.C. § 282, and stands or falls
21 independent of the other claims.” Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1266-
22 1267 (Fed. Cir. 1991) (citing Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294
23 U.S. 477, 487 (U.S. 1935) (“And each claim must stand or fall, as itself sufficiently defining
24 invention, independently of the others”). Accordingly, it is reversible error to hold any claim
25 invalid in the absence of clear and convincing evidence specifically directed to that particular

1 claim. Sandt Tech., Ltd. v. Resco Metal & Plastics Corp., 264 F.3d 1344, 1356 (Fed. Cir. 2001)
2 (“Because dependent claims contain additional limitations, they cannot be presumed to be
3 invalid as obvious just because the independent claims from which they depend have properly
4 been so found”).

5 Here, the ‘459 Patent has 31 claims, 12 of which were identified as representative
6 examples in the Complaint. (Compl., Dkt. No. 1). Google attempts to paint the claims with a
7 single broad brush, stating that all claims “recite the language ‘a computer implemented
8 method.’” (Def.’s Mem., Dkt. No. 74, pp. 6). Google invites error by focusing solely on that
9 limitation. “The Supreme Court has stated that a § 101 patentability analysis is directed to the
10 claim as a whole, not individual limitations.” King Pharms., Inc. v. Eon Labs, Inc., 616 F.3d
11 1267, 1277 (Fed. Cir. 2010). Google’s failure to address each claim and each limitation
12 independently is **fatal** to its motion. By definition, “each claim must be considered as defining a
13 separate invention.” Jones v. Hardy, 727 F.2d 1524, 1528 (Fed. Cir. 1984) (citing 35 U.S.C.
14 282). Google wholly fails to address numerous limitations in all of the claims, such as “indicium
15 for each of said categories (claim 16), “icon” (claim 17) and “graphical user interface” (claim
16 29). (‘459 Patent, Ex. A). Google's improper attempt to circumvent its burden of proof on the
17 invalidity of each claim is a fundamental error which, taken alone, requires that its motion be
18 denied.

19 Importantly, “[w]hether a claim is valid under § 101 is a matter of claim construction.”
20 CLS Bank Intern. v. Alice Corp. Pty. Ltd., 2011 WL 802079 at *14 (D.D.C. Mar. 9, 2011)
21 (citing State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1370 (Fed.
22 Cir. 1998)). As the court held in Cybersource Corp. v. Retail Decisions, Inc., 620 F. Supp. 2d
23 1068, 1073 (N.D. Cal. March 27, 2009), “claim construction is an **important first step** in a §
24 101 analysis.” (emphasis added). In fact, the Federal Circuit in Bilski explicitly stated that this

1 was so. Bilski I, 545 F.3d at 951 (citing State St. Bank & Trust Co. v. Signature Fin. Group, 149
2 F.3d 1368, 1370 (Fed. Cir. 1998) (noting that invalidity under § 101 “is a matter of both claim
3 construction and statutory construction”) (*overruled on other grounds*)). This makes perfect
4 sense: how can the Court decide whether the claims of the ‘459 Patent are directed to patentable
5 subject matter if the court has not determined the meaning of the claims? See also Deston
6 Therapeutics LLC v. Trigen Laboratories Inc., 723 F. Supp. 2d 665, 670 (D. Del. 2010) (“[w]hile
7 it is true that claim construction is a matter of law to be determined by the Court, the process for
8 properly construing a patent claim is unsuited for a motion to dismiss”).

9 While some of the claim terms were construed in IconFind, Inc. v. Yahoo! Inc., No. Civ.
10 09-109 WBS JFM, Dec. 14, 2009 Order (Dkt. No. 50), Google does not rely on these
11 constructions in its motion. Google instead has taken the position that the claim terms must be
12 construed anew and/or that additional constructions are necessary.

13 In Google’s initial motion, Google cited only one case for the proposition that the issue of
14 patent validity may be determined at this early stage of litigation without the benefit of a claim
15 construction or expert testimony. See Ultramercial, LLC v. Hulu LLC, 2010 WL 3360098 (C.D.
16 Cal. Aug. 13, 2010). Since that time, the Federal Circuit heard Ultramercial’s appeal and
17 reversed and remanded the district court’s decision, finding that “the claimed invention was not
18 so manifestly abstract as to override the statutory language of section 101.” Ultramercial, LLC
19 v. Hulu LLC, 657 F.3d 1323, 1330 (Fed. Cir. 2011) (*rehearing en banc denied Nov. 18, 2011*).
20 The Federal Circuit in Ultramercial, while stating that a claim construction was not necessary in
21 that particular case, explained why it is helpful:

22 On many occasions ... a definition of the invention via claim construction can clarify the
23 basic character of the subject matter of the invention. Thus, claim meaning may clarify
24 the actual subject matter at stake in the invention and can enlighten, or even answer,
25 questions about the subject matter abstractness.

1 657 F.3 1323 at 1325. This reasoning is applicable to this case and numerous other district
2 courts have agreed. For example in Progressive Cas. Ins. Co. v. Safeco Ins. Co., 2010 WL
3 4698576, *4 (N.D. Ohio Nov. 12, 2010), a case on all fours with the present one, the district
4 court explained:

5 *Ultramercial* did not discuss the procedural posture of the case or the presumption
6 of validity and a patent challenger's burden to prove invalidity by clear and
7 convincing evidence, noting only that the court was rejecting “[p]laintiff's
8 argument that this motion should not be decided before claim construction”
9 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.

10 Id. at *5. The reason for this is simple: claim construction is an issue of law for the judge to
11 decide with the full benefit of the extrinsic **and** intrinsic records (e.g. patent, file history, expert
12 testimony, dictionaries, treatises, etc.) and the court on a motion to dismiss may only consider
13 the pleadings. As the court in Deston explained in denying defendant's motion to dismiss for
14 non-infringement:

15 As a consequence, many courts in this circuit and elsewhere have declined to
16 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.

17 In light of the jurisprudence holding that claim construction is generally not
18 appropriate on a motion to dismiss, the ambiguity and possible conflict between
19 the plain language of the patent claims and the specifications, and the fact that
20 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].

21 Deston, 723 F. Supp. 2d at 671-672; see Cima Labs, Inc. v. Actavis Group HF, 2007 WL
22 1672229, *4 (D. N.J. Jun. 7, 2007) (denying motion to dismiss and stating "the proper time for
23 this Court to address claim construction is not on a motion to dismiss"); Yangaroo Inc. v.
24 Destiny Media Techs., Inc., 2009 WL 2836643, *3 (E.D. Wis. August 31, 2009) (denying

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

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

22 **B. Introduction to the Section 101 Exceptions, Tests, Factors and Precedent**

23 Even if it were necessary to reach the merits of Google’s motion before a claim
24 construction in this case, it is clear that the ‘459 Patent meets the requirements for patentability

1 under 35 U.S.C. § 101, and controlling Supreme Court and Federal Circuit precedent. While the
2 Supreme Court has consistently construed Section 101 broadly, the Court’s precedent provides
3 three limited exceptions to the scope of Section 101 of Title 35: (1) laws of nature; (2) physical
4 phenomena; and (3) abstract ideas. Bilski v. Kappos, 130 S. Ct. 3218, 3225 (2010) (“Bilski II”).
5 Under these exceptions, Google only asserts that the ‘459 Patent is unpatentable for claiming an
6 "abstract idea." The Federal Circuit has described the concept of an abstract idea as “whether the
7 Applicants are seeking to claim a fundamental principle (such as an abstract idea) or mental
8 process.” Bilski I, 545 F.3d at 952.

9 The Supreme Court in Bilski II discussed the standards for resolving Section 101 disputes
10 and held that the so-called “machine or transformation test” (“MOT Test”) is a “useful and
11 important clue, an investigative tool, for determining whether some claimed inventions are
12 processes under §101,” but, contrary to the Federal Circuit majority in Bilski I, “is not the sole
13 test for deciding whether an invention is a patent-eligible ‘process.’” Bilski, 130 S. Ct. at 952.;
14 As the Federal Circuit in Ultramercial recently explained:

15 While the machine-or-transformation logic served well as a tool to evaluate the
16 subject matter of Industrial Age processes, that test has far less application to
17 inventions of the Information Age. Technology without anchors in physical
18 structures and mechanical steps simply defy easy classification under the
19 machine-or-transformation categories. As the Supreme Court suggests,
20 mechanically applying the physical test risks obscuring the larger object of
21 securing patents for valuable inventions without transgressing the public domain.

19 Ultramercial, 657 F.3d at 1327 (citations omitted). In this case, the inventions of the ‘459 Patent
20 are directed to assigning a network page to one or more categories based on at least the copyright
21 status of the material, and providing a label which is used to control usage of the page. As in
22 Ultramercial, the inventions have no “anchor in physical structure” as they involve the acts of
23 software that cannot be seen and network pages that cannot be touched. Hence, this is the
24

1 precise situation that the Federal Circuit identified where the application of the MOT test will be
2 less helpful, if at all.

3 Moreover, while Google correctly notes that the USPTO continues to use the MOT Test
4 as an **indicator** of patentability, what Google fails to mention (or analyze) is that the USPTO, in
5 offering guidelines on this issue, identified **a number of factors** that should be weighed to
6 determine whether a method claim is directed to an abstract idea, and is thus ineligible for patent
7 protection under 101. See *“Interim Guidance for Determining Subject Matter Eligibility for*
8 *Process Claims in View of Bilski v. Kappos,”* 75 Fed. Reg 43, 992 (July 27, 2010) (“Interim
9 Guidelines”) (Ex. B).

10 Additionally, the Supreme Court in Bilski II noted that lower courts should look to
11 Gottschalk v. Benson, 409 U.S. 63 (1972), Parker v. Flook, 437 U.S. 584 (1978) and Diamond v.
12 Diehr, 450 U.S. 175, 187 (1981)) as “guideposts” to enlighten this inquiry. See Bilski II, 130 S.
13 Ct. at 3229-3231. In addressing the Section 101 tools and authority in turn below, there is no
14 question that the ‘459 Patent meets the patentability requirements of Section 101.

15 C. The Subject Matter of the '459 Patent is Not An "Abstract" Idea

16 Since the Supreme Court's recent decision in Bilski II, the Federal Circuit has addressed
17 in several cases whether the subject matter of an invention was "abstract.” Several cases are
18 instructive here.

19 First, in Research Corporation Technologies vs. Microsoft Corporation, the Federal
20 Circuit assessed an invention for a "'process' for rendering a halftone image," which allows
21 computers to display numerous colors using a limited number of pixel colors. 627 F.3d 859,
22 863, 868 (Fed. Cir. 2010). The court recognized that the "Supreme Court did not presume to
23 provide a rigid formula or definition for abstractness," but instead, "invited this court to develop
24 'other limiting criteria that further the purposes of the Patent Act." Id. at 868. With that

1 guidance, the court stated that it "will not presume to define 'abstract' beyond the recognition that
2 this disqualifying characteristic should exhibit itself so manifestly as to override the broad
3 statutory categories of eligible subject matter and the statutory context that direct primary
4 attention on the patentability criteria of the rest of the Patent Act." Id.

5 Against that backdrop, the Federal Circuit reversed the district court's summary judgment
6 that the patents did not claim patent-eligible inventions largely on two bases. Id. at 868-869.
7 First, the court found that "[t]he invention presents functional and palpable applications in the
8 field of computer technology. ... Indeed, the court notes that inventions with specific
9 applications or improvements to technologies in the marketplace are not likely to be so abstract
10 that they override the statutory language and framework of the Patent Act." Id. Second, the
11 acknowledged that "[i]n determining the eligibility of respondents' claimed process for patent
12 protection under section 101, their claims must be considered as a whole. It is inappropriate to
13 dissect the claims into old and new elements and then to ignore the presence of the old elements
14 in the analysis." Id. Thus, though the patented claims incorporated algorithms, the court found
15 that "the patentees here 'do not seek to patent a mathematical formula. Instead, they seek patent
16 protection for a process of 'half-toning in computer applications.'" Id.

17 In Ultramercial, 657 F.3d 1323, the Federal Circuit reversed a district court's dismissal of
18 Ultramercial's claims for failure to claim statutory subject under Section 101. The claimed
19 method was a method for monetizing and distributing copyrighted products over the Internet. In
20 finding that the invention "as a practical application of the general concept of advertising as
21 currency and improvement to prior art technology" was not "so manifestly abstract as to override
22 the statutory language of section 101," the Court first applied the analysis tool set forth in
23 Research Corp. and assessed whether the inventions had a specific application or improvement to
24 technologies in the marketplace. Id. at 657 F.3d at 1330, 1328. The Court noted that "[b]y its

1 terms, the claimed invention purports to improve existing technology in the marketplace” by
2 introducing a method of online advertising purported to solve the problem of declining
3 clickthrough rates through banner ads, for instance. Id. at 1328. The Court reasoned that while
4 the “mere idea that advertising can be used as a form of currency is abstract” it did “not simply
5 claim the age-old idea that advertising can serve as currency.” Id. To the contrary, the patent
6 “discloses a practical application of this idea.” To support this assertion the Court noted that
7 “[m]any of the steps are likely to require intricate and complex computer programming.” Id.
8 Moreover, “certain of these steps clearly require specific application to the Internet and cyber-
9 market environment.” Id. “One clear example is the third step, ‘providing said media products
10 for sale on an Internet website ... [a]nd, of course, if the products are to be ‘offered; for sale on
11 the Internet, they must be ‘restricted’ – step four – by complex computer programming as well.”

12 Notably for the purposes of this case the court explained:

13 Viewing the subject matter as a whole, the invention involved an extensive computer
14 interface. This court does not define the level of programming complexity required
15 before a computer-implemented method can be patent eligible. Nor does this court hold
that the use of an Internet website to practice such a method is either necessary or
insufficient in every case to satisfy § 101.

16 Id. at 1328.

17 Here, the subject matter of the '459 Patent is coding and categorizing network pages, such
18 as web pages on the Internet, based on the content of the network page. The inventions organize
19 network pages using categorization labels and codes based upon the content on the network
20 page, including whether the pages contain commercial or non-commercial information, as well
21 as the copyright status of the material. ('459 Patent, Col. 3, ll.8-21, Ex. A). A “network page” in
22 the context of the '459 Patent is a page on a network, such as the Internet, a private corporate
23
24

1 network, an intranet, a local area network or other network.¹ In Claim 1 of the '459 Patent, a
2 network page can be categorized for “transacting business” and/or categorized for “providing
3 information,” for example, network pages that contain articles, journals or publications. After
4 the network page is “assigned” to one or more categories, it is labeled using at least the copyright
5 status of the material on the network page. Once the page has been labeled, use of the network
6 page is controlled using the label and copyright status. (‘459 Patent, Col. 12, ll. 24 - 39, Ex. A).
7 Independent Claim 30 is similar to Claim 1 but adds, among other things, that a categorization
8 code is used for labeling the network pages. This code is a unique system of characters or
9 symbols that represent the categories to which a page may be assigned. Independent Claim 31
10 adds, among other things, additional copyright categories, including “categories relating to the
11 public domain, fair use only, use with attribution, and permission of copyright owner needed.”
12 (‘459 Patent, Col. 14, ll. 36 - 43, Ex. A).

13 Google relies on Cybersource Corp. v. Retail Decisions, Inc., 654 F.3d 1366 (2011) to
14 argue that the “substantive steps” of the claims of the ‘459 Patent “can essentially be performed
15 by the human mind” and hence, represent an unpatentable abstract idea. The patent-in-suit and
16 reasoning in Cybersource are easily distinguishable from the case at hand.

17 In Cybersource, the claim at issue “simply requires one to ‘obtain and compare intangible
18 data pertinent to business risks.’” Id. at 1370. Hence, the Court found that “[t]he mere
19 collection and organization of data regarding credit card numbers and Internet addresses is
20 insufficient to meet the transformation prong of the test, and the plain language of claim 3 does
21 not require the method to be performed by a particular machine, or even a machine at all”. Id.

22
23 ¹ In IconFind Inc. v. Yahoo! Inc., No. Civ. 09-109 WBS JFM, Order of Dec. 14, 2009
24 (Dkt. No. 50), Judge Shubb construed the term “network page” as “page on the Internet, private
corporate network, local area network or other network.”

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

15 Additionally, like the underlying decision in Research Corporation Technologies,
16 Google's analysis falls short for failing to consider the claims as a whole, and instead, focusing
17 principally on the "computer implemented method" limitation. (See e.g. Def.'s Mem., Dkt. No.
18 74, pp. 6). As discussed above, Claim 1 of the '459 Patent claims a computer implemented
19 method of categorizing a network page, including providing categories (such as copyright
20 status), assigning the network page to categories, providing a categorization label and controlling
21 usage of the network page using the categorization label and copyright status. ('459 Patent, Col.
22 12, ll. 24-38, Ex. A). These multi-faceted inventions plainly have practical applications in
23 Web/Internet development. Clearly, under Ultramercial and Research Technologies, the '459
24 Patent's inventions are not so manifestly abstract as to override the broad statutory categories of

1 eligible subject matter. See 35 U.S.C. § 101. They are not abstract ideas and they are not simply
2 “mental steps” that can occur in the mind of a person.

3 **D. The '459 Patent Claims Patent-Eligible Subject Matter**
4 **Under the Machine or Transformation Test (“MOT”)**

5 Google highlights the MOT test in its briefing. However, as noted above, the MOT test
6 is much less helpful in cases such as the present one, which involve technology without anchors.
7 Ultramercial, 657 F. 3d at 1327. IconFind still addresses Google’s assertions under this test for
8 the purposes of providing to the Court a clear and accurate briefing on which to base its decision.

9 Under the MOT test a method is patent eligible if: (1) “it is tied to a particular machine or
10 apparatus,” or (2) “it transforms a particular article into a different state or thing.” Bilski I, 545
11 F.3d at 954. “The use of a specific machine or transformation of an article must impose
12 meaningful limits on the claim’s scope to impart patent-eligibility.” Id. at 962 (citing Benson,
13 409 U.S. at 590). In order for a patent to meet the “transformation test,” the invention must
14 “transform[] an article into a different state or being.” Id. at 962. The '459 Patent satisfies bot
15 prongs of the test, though it need only satisfy one to be patent eligible.

16 **1. The Claims of the ‘459 Patent Meet**
17 **the Machine Prong of the MOT Test**

18 The machine prong of the MOT Test requires that the invention(s) be “tied to a particular
19 machine or apparatus.” Bilski I, 545 F.3d at 954. The Supreme Court has defined the term
20 “machine” as “a concrete thing, consisting of parts, or of certain devices and combination of
21 devices.” Burr v. Duryee, 68 U.S. (1 Wall.) 531, 570 (1863); see also In re Nuijten, 500 F.3d
22 1346, 1356 (Fed. Cir. 2007). This “includes every mechanical device or combination of
23 mechanical powers and devices to perform some function and produce a certain effect or result.”
24 In re Nuijten, 500 F.3d at 1356 (citing Corning v. Burden, 56 U.S. 252, 267 (1853)).

1 The inventions of the '459 Patent are directed to providing a solution for "categorizing
2 and searching for information on a network and, more specifically, to categorizing and searching
3 Web pages over the Internet." ('459 Patent, Col. 1, ll. 21-25, Ex. A). Accordingly, the methods
4 as claimed are applicable in a client-server network, which includes tangible devices integral to
5 the functioning of the system as a whole. For example, in the context of the Internet, the claimed
6 inventions may run on one or more server machines, or more specifically, Web servers. These
7 servers and software applications thereon provide categories, categorization labels and
8 categorization codes; they also assign and control usage of the page. The thrust of Google's
9 argument on the machine prong is that "[t]he computer referenced in the preamble of all the
10 claims is merely an 'insignificant extra-solution." (Def.'s Mem., Dkt. No. 74, p. 9). Google
11 totally misses the mark on the legal concept "post-solution activity"; this concept only applies to
12 claims that include a mathematical algorithm or formula (i.e. "post-solution" means after the
13 mathematical problem is solved). As the Supreme Court explained in Bilski II, the concept of
14 "post-solution activity" surfaced in Flook, 437 U.S. at 585-586. Bilski II, 130 S.Ct. 3218, 3230
15 (2010). In Flook, the claims were directed towards a procedure for monitoring the conditions in
16 the oil industry and the only element the invention added over the prior art was a specific
17 mathematical algorithm. 437 U.S. at 585-586. The claim limited its application however to only
18 the petrochemical and oil-refining industries so that the algorithm could still "be freely used
19 outside the petrochemical and oil-refining industries." Id. at 589-590. The Court held that the
20 process at issue was unpatentable under Section 101, "because once that algorithm [wa]s
21 assumed to be within the prior art, the application, considered as a whole, contain[ed] no
22 patentable invention." Id. at 594. As the Supreme Court explained in Bilski II, what Flook
23 really stood for was the "proposition that the prohibition against patenting abstract ideas 'cannot
24 be circumvented by attempting to limit the use of the formula to a particular technological

1 environment' or adding 'insignificant post-solution activity.'" 130 S Ct. at 3230; see also In re
2 Schrader, 22 F.3d 290, 294 (Fed. Cir. 1994) ("the recitation of insignificant post-solution activity
3 in a claim involving the solving of a mathematical algorithm could not impart patentability to the
4 claim").

5 Accordingly, "post-solution" activity refers to activities **after the mathematical**
6 **problem is solved**. The claims of the '459 Patent do not include a mathematical algorithm or
7 formula, so Google's "post-solution activity" arguments are totally misplaced.

8 Google's other chief argument under the machine prong is that the recitation of a general
9 purpose computer cannot save the '459 Patent's claims from being found unpatentable under
10 Section 101.² (Def.'s Mem., Dkt. No. 74, p. 8). However, the cases Google cites for the
11 proposition that the recitation in a method of claim of a "general purpose computer" is not
12 sufficient structure to meet the MOT test are distinguishable from the case – and the claims – at
13 hand.

14 In CLS Bank Intern. v. Alice Corp. Pty. Ltd., 2011 WL 802079, *2 (D.D.C. Mar. 9,
15 2011), the inventions of the four patents-in-suit were directed towards a "methods or systems
16 that help lessen settlement risk using a computer system." The defendants asserted – and the
17 court agreed – that the methods "attempt[ed] to patent the abstract idea of 'exchanging an
18 obligation between parties' after ensuring that there is 'adequate value' in independent accounts
19

20 ² The crux of Google's motion is that the mere recitation of "computer implemented
21 method" is not enough to meet the MOT Test. However, Google uses the same language to
22 procure its own patent rights. Specifically, as noted in the Complaint, Google cited IconFind's
23 patent as prior art during prosecution of its own U.S. Patent No. 7,788,274, entitled "Systems and
24 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 maintained for the parties.” Id. at 19. The claims recited “electronically adjusting” records
2 and/or accounts and contained no explicit recitation of any machine or apparatus, such as a
3 computer. Id. at *13. The court presumed for the purpose of the motion that the inventions were
4 to be realized through use of a computer with specific programming. Id. at *14. The court went
5 on to explain that “[t]he single fact that [plaintiff’s] method claims are implemented by a
6 computer does not mean the methods are tied to a particular machine under the MOT test,”
7 explaining “the claims before the court at most implicitly recite a computer by claiming
8 electronic adjustment of records or accounts.” Id. at *14-16. The court then assessed whether a
9 computer “imposed any meaningful limitation on the processes themselves” and found that while
10 “a computer may facilitate and expedite the claimed methods, [] the methods before the court
11 could be performed without the use of a computer.” Id. at *18.

12 The inventions of the ‘459 Patent, to the contrary, not only explicitly recite that the
13 inventions are “computer implemented,” but the computer (e.g. a web server in the context of the
14 Internet), which consists of hardware and software, is essential to the inventions. As explained
15 above, these components provide the following functionality: providing a list of categories;
16 assigning network pages to these categories; providing a categorization label for the network
17 page using the copyright status of the material on the page; and controlling the usage of the
18 network page using the label and the copyright status. The system could not be implemented
19 without the use of the computer: the very heart of the invention is to categorize and label
20 network pages (e.g. Internet web pages). This **cannot** be done with a pencil and paper, as
21 Google contends. See SIRQ Tech., Inc. v. Int’l Trade Comm’n, 601 F.3d 1319, 1332 (Fed. Cir.
22 2010) (“A GPS receiver is a machine and is integral to each of the claims at issue.”).

23 Google’s other citations are likewise distinguishable. In Bancorp Services, L.L.C. v. Sun
24 Life Assur. Co. of Canada, 2011 WL 665679, *1 (E.D. Mo. Feb 14, 2011), the patents-in-suit

1 were drawn to systems for administering and tracking the value of separate-account life
2 insurance policies. The court found that the “specified machines [in the claims] appear to be no
3 more than ‘object[s] on which the method operates’ and that ‘the steps of tracking, reconciling
4 and administering a life insurance policy with a stable value component can be completed
5 manually.’” Id. at *9.

6 In this case, the claims of the ‘459 Patent are not drawn to a mathematical calculation or
7 algorithm (or any other fundamental law of nature) that was made electronic through the use of a
8 computer for efficiency purposes, as was the case in Bancorp. The inventions of the ‘459 Patent
9 are new and useful methods for categorizing network pages according to content and copyright
10 status. The invention could not be possible without the use of the “computer.” Without the
11 “computer” in Bancorp, one would only be left with an idea for administering and tracking the
12 value of separate-account life insurance policies; in this case, without the “computer,” **there**
13 **would be no inventions.** See SIRF Tech., Inc., 601 F.3d at 1333 (holding that the inventions
14 "require the use of a particular machine (a GPS receiver) and could not be performed with the
15 use of such a receiver").

16 2. The Claims of the ‘459 Patent Meet 17 the Transformation Prong of the MOT Test

18 The “transformation” prong of the MOT Test is met where the method “transforms an
19 article into a different state or thing.” Bilski I, 545 F.3d at 962. This transformation must also
20 be “central to the purpose of the claimed process.” Id. at 962. As explained above, the methods
21 transform network pages through the use of a "categorization label" so that use of the page is
22 restricted to the category or categories to which the page is assigned, including copyright status.
23 The pages are transformed when they are correctly labeled. This is important because the pages,
24 when labeled, provide the ability to notify others of the copyright status of that content. As the

1 patent explains, "[t]he categorization label will be readable by Web crawlers and may be visible
2 to users. ... By selecting one of the four copyright-status indicia and placing it on the end of the
3 categorization label, the creator adds the information governing the use of the material." ('459
4 Patent, Col. 7, ll. 27-28, Ex. A). As required by *Bilski I*, this "categorization label"
5 transformation is "central to the purposes of the claimed process." *Bilski I*, 545 F.3d at 962.

6 Google cites *CLS Bank Int'l* in asserting that it would be incorrect to argue that "the
7 underlying categorizations are taking place on a computer and, thus, the underlying electrons of
8 the various memory systems are being "transformed." (Def.'s Mem., Dkt. No. 74, p. 11). Google
9 misses the mark on this preemptive argument. Quite to the contrary, *IconFind* is not arguing that
10 network pages are transformed because the underlying electrons of the data are being
11 transformed. First, the network pages themselves are being transformed i.e. the underlying code
12 that makes up the pages. Additionally, the network pages may also be transformed by the
13 placement of a visible label. In any event, the network page is being transformed. *Bilski I*'s
14 discussion of *In re Abele* is instructive on this point. 545 F.3d at 962-963. The *Bilski I* court
15 noted that "the transformation of that raw data into a visual depiction of a physical object on a
16 display was sufficient to render that more narrowly-claimed process patent-eligible." Like the
17 raw data in *In re Abele*, the underlying code of a network page (e.g. a Web page) is rendered into
18 visual depictions of physical objects (e.g. Amazon.com depicts physical items for purchase).

19 Clearly, the invention transforms network pages – a purpose of the invention was to
20 categorize the pages in a certain way (i.e. through a label) so that the use of the network pages
21 would be restricted according to the content and copyright status. Accordingly, the '459 Patent
22 passes muster under the transformation prong of the MOT Test.

1 **E. The Claims of the ‘459 Patent Are Directed**
2 **To Patentable Subject Matter In Light of**
3 **The Supreme Court’s “Guidepost” Set of Cases**

4 The Supreme Court in Bilski II noted that lower courts should look to Gottschalk v.
5 Benson, 409 U.S. 63 (1972), Parker v. Flook, 437 U.S. 584 (1978) and Diamond v. Diehr, 450
6 U.S. 175, 187 (1981)) as “guideposts” to enlighten this inquiry. See Bilski II, 130 S. Ct. at 3229-
7 3231.

8 In Benson, the Supreme Court rejected a patent application for a method for
9 programming a general-purpose computer to convert binary-coded decimal numerals into pure
10 binary numerals. 409 U.S. at 65. The process used a piece of hardware—the reentrant shift
11 register—to carry out calculations. Id. at 73. The Court held that the application at issue was not
12 a “process,” but an unpatentable abstract idea, stating “it is conceded that one may not patent an
13 idea. But in practical effect that would be the result if the formula for converting ... numerals to
14 pure binary numerals were patented in this case.” Id. at 71. A contrary holding “would wholly
15 pre-empt the mathematical formula and in practical effect would be a patent on the algorithm
16 itself.” Id. at 72. The claims at issue in the ‘459 Patent are not directed towards a specific
17 formula or algorithm; instead, the claims at issue here concern a specific method of categorizing
18 and labeling network pages. Thus, Benson does not dictate, or even support, a finding that the
19 ‘459 Patent’s subject matter is unpatentable.

20 As discussed above, the Bilski II court acknowledged that Flook “stands for the
21 proposition that the prohibition against patenting abstract ideas ‘cannot be circumvented by
22 attempting to limit the use of the formula to a particular technological environment’ or adding
23 ‘insignificant post-solution activity.’” 130 S Ct. at 3230. As noted above, no algorithm is
24 required in the claims of the ‘459 Patent; the claims of the ‘459 Patent are directed to a methods

1 for categorizing and labeling network pages to allow for more informed and organized access to
2 them and their copyright status.

3 Google notably did not cite Diehr in its brief despite the Supreme Court’s explicit
4 direction to lower courts to take into account Benson, Flook **and** Diehr. This is because Diehr
5 does not support Google’s position. In Diehr, “the Court established a limitation on the
6 principles articulated in *Benson* and *Flook*.” Bilski II, 130 S. Ct. 3230. The claims in Diehr
7 were directed to a previously unknown method for “molding raw, uncured synthetic rubber into
8 cured precision products,” using a mathematical formula to complete some of its several steps by
9 way of a computer. Diehr, 450 U.S., at 177. The Court explained that while an abstract idea,
10 law of nature, or mathematical formula could not be patented, “an *application* of a law of nature
11 or mathematical formula to a known structure or process may well be deserving of patent
12 protection.” Id. at 187. Hence, Diehr “emphasized the need to consider the invention as a
13 whole, rather than ‘dissect[ing] the claims into old and new elements and then ... ignor[ing] the
14 presence of the old elements in the analysis.’” Bilski II, 130 S. Ct. at 3230 (citing Diehr, 450
15 U.S. at 188, 101 S.Ct. 1048). The Diehr court concluded that because the claim was not “an
16 attempt to patent a mathematical formula, but rather [was] an industrial process for the molding
17 of rubber products,” it fell within § 101's patentable subject matter.” Id. (citing Diehr, 450 U.S.
18 at 188, 101 S.Ct. 1048).

19 Accordingly, Diehr instructs the Court to take into account the inventions claimed in the
20 ‘459 Patent as a whole in assessing whether it meets the requirements of Section 101. Google
21 characterizes the invention as merely methods of categorizing a network page. However, in
22 assessing the inventions and claims as a whole, as IconFind has done in this memorandum, it is
23 clear that the claims are directed to not just the mere categorization of network pages, but the
24 categorization, assignment, labeling and coding of those pages so the creators can notify others

1 regarding the copyright status of that content, others are aware of how they are allowed to use the
2 content of the network page according to the label on the page, and search engines can recognize
3 network pages assigned to certain categories.

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

6 Google clings to the prosecution history of the ‘459 Patent to support its argument that its
7 claims are drawn to ineligible subject matter under Section 101. Google argues that the rejection
8 of the claims under Section 101 and the subsequent addition of the phrase “computer
9 implemented” support a finding of unpatentability. To the contrary, this supports a finding that
10 the USPTO, when presented with the exact same question the Court is faced with today, found
11 that the ‘459 Patent was directed to eligible subject matter.

12 First, Google self-servingly plucks out portions of the file history without context.
13 Google makes it seem as though Section 101 was the only rejection in the file history, and
14 improperly infers that the applicant simply added “a computer implemented method” to cure this
15 problem. However, the independent claims as amended at the time of that rejection were
16 different than they are today; for instance, Claim 1 read:³

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

20 (See Google’s Request for Judicial Notice, Ex. 1-2, p. 43 (Dkt. No. 31-2)). After a telephone
21 interview concerning a separate Section 102 rejection, the examiner issued an Interview
22 Summary which indicated that the claims still stood as rejected under Section 101. In the

23 _____
24 ³ The crossed through words were deleted and the underlined words were added by the
25 applicant.

1 applicants' response to the examiner's Section 101 rejection, the applicant amended the claims as
2 follows:

3 **Claim 1 (currently amended): A computer implemented method of categorizing a network page,**
4 **comprising:**
5 **providing a list of categories, wherein said list of categories include a category for**
6 **transacting business and a category for providing information, and wherein said list of categories**
7 **include a plurality of categories based on the copyright status of material on a page; and**
8 **assigning said network page to one or more of said list of categories.**

9 (See Google's Request for Judicial Notice, Ex. 1-2, p. 75 (Dkt. No. 31-2)). The examiner in his
10 response cited no Section 101 rejection. (See Google's Request for Judicial Notice, Ex. 1-3, pp.
11 10-18 (Dkt. No. 31-3)). Still, the claims were amended further to include, for Claim 1, the steps
12 of "providing a categorization label..." and "controlling usage of the network page...". (See
13 Google's Request for Judicial Notice, Ex. 1-3, p. 24 (Dkt. No. 31-3)). **Those** are the claims of the
14 '459 Patent **as issued**. Indeed, the examiner expressly relied on the additional steps "assigning
15 said network page...", "providing a categorization label...", and "controlling usage of the
16 network page..." as the reasons for allowance – not the "computer implemented method"
17 language. (See Google's Request for Judicial Notice, Ex. 1-3, pp. 73-76 (Dkt. No. 31-3)).

18 As such, for Google to suggest that the claims were amended solely because of or in
19 response to a Section 101 rejection is improper. For Google to imply that the claims as rejected
20 under Section 101 were identical to the issued claims with the exception of the phrase "a
21 computer implemented method" is simply an incorrect characterization of the file history.

22 Second, the fact that the PTO, after assessing this precise issue, confirmed the
23 patentability of the claims of the '459 Patent undercuts Google's arguments. See Hyatt v.
24 Kappos, 625 F.3d 1320, 1334 (Fed. Cir. 2010) (*en banc*) (recognizing the deference owed the
25 PTO as "the knowledgeable agency charged with assessing patentability"); Applied Materials,
Inc. v. Advanced Semiconductor Materials Am., Inc., 98 F.3d 1563, 1569 (Fed. Cir. 1996) ("The

1 presumption of validity is based on the presumption of administrative correctness of actions of
2 the agency charged with examination of patentability”).

3 Finally, any attempt by Google to argue that the PTO’s decision would have been
4 different in a post-Bilski II era would also invite legal error. Google mischaracterizes the
5 Supreme Court’s Bilski II decision by stating that the Court “recently made clear, however,
6 abstract ideas – which are unpatentable as a matter of law – cannot otherwise be made patentable
7 simply by directing them to run on a general purpose computer.” (Def. Mem, Dkt. No. 30., p.
8 2,). However, Bilski II simply clarified that the MOT Test was not the exclusive test, as the
9 Federal Circuit had held in Bilski I, and that it is instead a “useful and important clue, an
10 investigative tool.” Bilski II, 130 S. Ct. at 3226; see also Prometheus Labs., Inc., 628 F.3d at
11 1355. The law regarding Section 101 remains the same post-Bilski; the Court merely clarified
12 that the MOT Test is not the exclusive test. Accordingly, that the prosecution of the ‘459 Patent
13 occurred pre-Bilski II is of no consequence. The examiner still had the benefit of the authorities
14 relied upon by Bilski II (i.e., Benson, Flook, and Diehr) as well as the MOT Test.

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

18 **IV. CONCLUSION**

19 WHEREFORE, for the foregoing reasons, IconFind respectfully requests that this Court
20 deny Google’s renewed motion for judgment.

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Respectfully submitted,

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