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

11 ICONFIND, INC., )  
 )  
 12 Plaintiff, )  
 )  
 13 v. )  
 )  
 14 GOOGLE INC., )  
 )  
 15 Defendant. )  
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 16 )  
 17 )  
 18 )

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

**DEFENDANT GOOGLE INC.'S REPLY  
 IN SUPPORT OF ITS RENEWED  
 MOTION FOR JUDGMENT ON THE  
 PLEADINGS OF INVALIDITY OF U.S.  
 PATENT NO. 7,181,459**

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**NOTES ON CITATIONS**

The patent-in-suit, U.S. Patent No. 7,181,459 (“the ’459 patent”), is attached as Exhibit 1 to the Declaration of Kenneth Maikish (the “Maikish Decl.”) in Support of Google’s Renewed Motion for Judgment on the Pleadings of Invalidity of U.S. Patent No. 7,181,459 (“Maikish Decl.”) (Dkt. 75). References to the ’459 patent are indicated by column and line number. A reference to “3:15” means column 3, line 15.

Defendant Google Inc.’s Memorandum in Support of Its Renewed Motion for Judgment on the Pleadings of Invalidity of U.S. Patent No. 7,181,459, Dkt. 74, is cited as “Mot.” Plaintiff Iconfind’s Response in Opposition to Defendant’s Motion on the Pleadings, Dkt. 77, is cited as “Opp.”

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1     **I. INTRODUCTION**

2             The patent-in-suit in this matter is invalid because it is directed towards an abstract idea  
3     contrary to 35 U.S.C. § 101 and the Supreme Court’s controlling precedent relating to patentable  
4     subject matter. Rather than address this issue now, Plaintiff would have the parties and the Court  
5     waste their time and resources by ignoring this threshold issue. The question of invalidity under  
6     35 U.S.C. § 101 is a question of law. The resolution of this threshold question does not require  
7     claim construction, nor does it require discovery. There are no factual issues in dispute. In the  
8     interest of judicial economy and before having the parties embark on a long, resource-consuming,  
9     and expensive litigation matter, Google respectfully requests that this Court decide whether the  
10    ‘459 patent meets the § 101 threshold for patentability.

11            Plaintiff’s Opposition fails to rebut Google’s arguments in support of its position that the  
12    ‘459 patent is directed at an abstract idea. It is false that the United States Patent and Trademark  
13    Office (“PTO”) “has indeed heard and has vetted the exact same argument that Google now  
14    asserts.” (Opp. at 1.) In fact, the exact opposite is true. As described in Google’s Opening Brief,  
15    and is clear from the prosecution history, the Patent Examiner expressly rejected all of the claims  
16    of the patent-in-suit as being directed towards an abstract idea. The only reason the Examiner  
17    then allowed these claims was because Plaintiff added the phrase “a computer implemented  
18    method” to the preamble of each of the claims. But, the Supreme Court recently made clear that  
19    such a “cure,” which simply attempts to exalt form over function, is not viable.

20            Google’s Memorandum in Support of Its Renewed Motion applies the standards for  
21    addressing the question of patentable subject matter under 35 U.S.C. § 101 as articulated by the  
22    Federal Circuit and the Supreme Court and appropriately concludes that the ‘459 patent is invalid.  
23    As illustrated below, Plaintiff’s arguments to the contrary are unavailing. Accordingly, Google’s  
24    Motion should be granted.

25     **II. PLAINTIFF’S PROCEDURAL ARGUMENTS ARE WITHOUT MERIT**

26            Google’s Motion for Judgment on the Pleadings is ripe for adjudication. There is no  
27    claim construction that would change the analysis. It is telling that Plaintiff does not – and cannot  
28

1 – point to any such claim construction or any facts that would be relevant to this motion.  
2 Accordingly, the motion should be considered by this Court now. Furthermore, Plaintiff’s  
3 reference to the “clear and convincing” evidentiary standard is moot because the issue presented  
4 is a matter of law and there are no facts in dispute.

5 A. Determination Of Google’s Motion Does Not Require Claim Construction

6 As Plaintiff acknowledges (Opp. at 5), the Federal Circuit recently affirmed that claim  
7 construction is not a mandatory prerequisite to deciding a motion for invalidity pursuant to 35  
8 U.S.C. § 101. In the recent *Ultramercial* decision, the Federal Circuit indicated:

9 This court has never set forth a bright line rule requiring district courts to  
10 construe claims before determining subject matter eligibility. Indeed,  
11 because eligibility is a coarse gauge of the suitability of broad subject  
12 matter categories for patent protection, claim construction may not always  
13 be necessary for a § 101 analysis.

14 *Ultramercial, LLC v. Hulu, LLC*, 657 F.3d 1323, 1325 (Fed. Cir. 2011) (internal citations and  
15 quotations omitted). Google does not dispute that in deciding a § 101 challenge, it is sometimes  
16 the case that claim construction may play an important part of the analysis. Sometimes, however  
17 – as is the case here – claim construction is not necessary to determine whether a patent’s claims  
18 are impermissibly directed to abstract subject matter. Tellingly, while Plaintiff goes on at length  
19 regarding other cases where courts undertook claim construction prior to tackling a question of  
20 validity under § 101 (Opp. at 4-7), it fails to point to a single claim term that would require  
21 construction prior to ruling on the instant question of patentability before this Court. In short,  
22 Plaintiff both ignores the numerous cases in which such a determination was reached without  
23 claim construction, and, more importantly, Plaintiff fails to demonstrate why such analysis is  
24 required in this case.

25 Claim construction is only necessary where the Court’s ability to rule on the Motion  
26 hinges on how one or more terms from the claims are construed.<sup>1</sup> Numerous courts have ruled on

27 <sup>1</sup> Plaintiff’s reliance on *Deston Therapeutics LLC v. Trigen Laboratories Inc.*, 723 F. Supp. 2d  
28 665, 670 (D. Del. 2010) to suggest the contrary is misplaced. The court in *Deston* was faced with  
a motion to dismiss for *non-infringement*. As infringement is a question of fact, and as claim  
construction is routinely required for the determination of the question of infringement, the

(continued...)

1 § 101 motions without claim construction. *E.g.*, *Fuzzysharp Techs., Inc. v. 3D Labs Inc., Ltd.*,  
2 No. 07-5948, 2009 U.S. Dist. LEXIS 115493, at \*6-7 n. 1 (N.D. Cal. Dec. 11, 2009) (“Claims  
3 construction is not a prerequisite to ruling on the [motion for summary judgment of invalidity  
4 pursuant to 35 U.S.C. § 101].”); *see also* *Glory Licensing LLC v. Toys “R” Us, Inc.*, No. 09-4252,  
5 2011 U.S. Dist. LEXIS 51888 (D.N.J. May 16, 2011) (unpublished opinion) (granting  
6 defendant’s motion to dismiss and finding patent-in-suit invalid for failure to claim patentable  
7 subject matter pursuant to 35 U.S.C. § 101 without requiring claim construction); *CLS Bank Int’l*  
8 *v. Alice Corp. Pty, Ltd.*, 768 F. Supp. 2d 221 (D.D.C. 2011) (finding patent-in-suit invalid on  
9 Motion for Summary Judgment without having construed the claims); *Graff/Ross Holdings LLP*  
10 *v. Fed. Home Loan Mortg. Corp.*, No. 07-796, 2010 U.S. Dist. LEXIS 141399, at \*6-7 (D.D.C.  
11 Aug. 27, 2010) (“The undersigned finds it is unnecessary to construe the terms before deciding  
12 the issue of validity, and thus forgoes claim construction pending resolution of this motion to  
13 dismiss.”). Ironically, even the chief case relied upon by Plaintiff in arguing that claim  
14 construction is somehow necessary prior to making a determination under § 101 — *i.e.*, the  
15 Federal Circuit’s opinion in the *Ultramercial* matter, *see* Opp. at 5-6 — was itself decided in the  
16 absence of claim construction. *Ultramercial*, 657 F.3d 1323, 1330. While the Federal Circuit in  
17 *Ultramercial* overturned the District Court’s ruling and found that the claims were directed at  
18 statutory subject matter, it did so without claim construction. *Id.*

19 Moreover, Plaintiff’s argument that a court should not decide claim construction issues on  
20 a motion to dismiss is a red herring. (Opp. at 6-7.) Google is not proposing that the Court should  
21 conduct claim construction as part of a determination of this motion; rather, Google’s position is  
22 that claim construction is simply not necessary in this instance. Here there are no claim terms  
23 requiring construction for the Court to rule on the validity of the ‘459 patent under § 101. The  
24 most telling evidence of this is that Plaintiff – while devoting a long section of its Opposition to  
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26 \_\_\_\_\_  
27 court’s reluctance to reach decisions of claim construction on motion to dismiss is immaterial to  
28 the question of whether claim construction is required for the determination of *statutory subject*  
*matter* (*i.e.*, a question of law) on a motion to dismiss.



1 the “need” for claim construction prior to deciding this matter – *fails to point out a single specific*  
2 *term that requires construction*. Plaintiff points to no reason claim construction is necessary in  
3 this matter, for the simple reason that it is not. Google’s motion is not premature and does not  
4 require claim construction for the Court to reach conclusion.

5 B. Determination Of Google’s Motion Does Not Require Discovery, Nor The  
6 Application Of The “Clear And Convincing” Standard, Because There Are No  
7 Disputed Facts

8 Likewise, Plaintiff’s arguments that further unspecified factual and expert determinations  
9 are required before ruling on this motion fall flat. (Opp. at 7.) In its Opposition, Plaintiff  
10 correctly points out that a determination of invalidity under 35 U.S.C. § 101 is a question of law.  
11 (Opp. at 3) (citing *In re Bilski*, 545 F.3d 943, 950 (Fed. Cir. 2008) (“*Bilski I*”).) Plaintiff then  
12 cites *In re Comiskey* for the proposition that the issue of invalidity may nevertheless “turn on  
13 subsidiary factual issues.” (Opp. at 3) (quoting *In re Comiskey*, 554 F.3d at 975.) However, the  
14 full quote from *Comiskey* is instructive: “[w]hile there may be cases in which the legal question  
15 as to patentable subject matter may turn on subsidiary factual issues, *Comiskey* has not identified  
16 any relevant fact issues that must be resolved in order to address the patentability of the subject  
17 matter of *Comiskey*’s application.” *In re Comiskey*, 554 F.3d at 975. Such is the case here.  
18 Plaintiff has not and cannot point to any facts outside the judicially noticeable patent and file  
19 history that would even be relevant to this inquiry.

20 Plaintiff’s repeated reference in its Opposition to the “clear and convincing” evidentiary  
21 standard for establishing that a patent is invalid is another red herring. This standard only applies  
22 to disputed factual matters, and, as discussed above, there are no facts in dispute in this matter.  
23 Accordingly, because all that remains is for the Court to apply the law to the undisputed facts in  
24 this case, the question of what standard of proof applies is moot. *See, e.g., Bancorp Servs., L.L.C.*  
25 *v. Sun Life Assur. Co. of Can.*, No. 00-1073, 2011 U.S. Dist. LEXIS 14272, at \*9 (E.D. Mo. Feb.  
26 14, 2011) (“[Plaintiff] argues that to establish invalidity [Defendant] must present clear and  
27 convincing evidence of facts underlying the invalidity. However, whether asserted claims are  
28 invalid for failure to claim statutory subject matter under 35 U.S.C. § 101 is a question of law.”)  
(citing *In re Comiskey*, 554 F.3d 967, 975 (Fed. Cir. 2009)); *Prometheus Labs. v. Mayo*

1 *Collaborative Servs.*, No. 04-1200, 2008 U.S. Dist. LEXIS 25062, at \*45-46 (S.D. Cal. Mar. 28,  
2 2008) (reversed on other grounds) (The “clear and convincing” standard does not apply because  
3 plaintiff’s arguments “do not represent factual disputes, and instead concern interpretation of the  
4 claims and the proper application of § 101 to the facts of this case. These are clearly questions of  
5 law, and are thus appropriate for summary judgment.”).

6 Google’s Motion is timely because there are no terms requiring construction by the Court  
7 and there are no factual issues in dispute. In the interest of saving this Court and the parties a  
8 great deal of time and expense in litigating a patent that is invalid, Google requests that the Court  
9 reach the substance its Motion.

### 10 **III. PLAINTIFF’S SUBSTANTIVE ARGUMENTS ARE WITHOUT MERIT**

#### 11 **A. The Prosecution History Supports Google’s – Not Plaintiff’s – Position**

12 As the prosecution history and Google’s Opening Brief make clear, the limited back-and-  
13 forth between the Patent Examiner and the patentee regarding the § 101 rejection ended when the  
14 patentee took the Patent Examiner’s suggestion and amended its claims to include the language “a  
15 computer implemented method.”<sup>2</sup> At no time during the prosecution did the patentee dispute the  
16 § 101 rejection. Under the guidance of recent case law, it is clear that the allowance of the ’459  
17 patent based only on the addition of the phrase “a computer implemented method” was in error.

18 Plaintiff’s allegation that the PTO would somehow arrive at the same result today in  
19 analyzing this question as it did back in 2005, prior to the *Bilski v. Kappos*, 130 S. Ct. 3218  
20 (2010) (“*Bilski II*”) decision, is spurious. (Opp. at 24.) As discussed at length in Google’s  
21 Opening Brief, the Patent Examiner correctly identified the claims as being directed towards non-  
22 patentable subject matter. (Mot. at 2-3.) The only “cure” implemented to address this issue by

23 \_\_\_\_\_  
24 <sup>2</sup> In footnote 2 of its Opposition, Plaintiff points out the Google uses the words “a computer-  
25 implemented method” as part of the preamble of at least one of Google’s own patents in an  
26 attempt to suggest some inconsistency between Google’s arguments in its Motion and between its  
27 own real-world practice. Plaintiff’s argument is sophistry. Google does not argue that a claim  
28 should not contain the words “a computer-implemented method;” rather, Google argues that,  
absent additional elements within the claims themselves, the mere recitation of the words in the  
preamble is not sufficient to meet the machine prong of the machine-or-transformation test.

1 the patentee was to add the phrase “computer implemented method” to each of the independent  
2 claims. The recent cases dealing with patentable subject matter under § 101 make clear that  
3 simply taking – as the patentee in this instance did – an abstract idea and adding the phrase “a  
4 computer implemented method” does not make the abstract idea patentable. *See*, Mot. at 8-9. If  
5 the application leading to the issuance of the ’459 patent were to be prosecuted today, and if the  
6 Patent Examiner, as she did here, were to identify that the claims are directed to an abstract idea,  
7 Plaintiff cannot realistically expect this Court to believe that merely adding the words “a  
8 computer implemented method” would resolve the rejection. It would not.

9 Nor does the subsequent prosecution history — *i.e.*, the back-and-forth that occurred after  
10 the “resolution” of the § 101 rejection — change this analysis. Additional amendments to the  
11 claims were made by the patentee after the Patent Examiner withdrew her objection relating to  
12 § 101. All of these amendments were done to overcome the examiner’s objections under  
13 35 U.S.C. §§ 102 and 103 (*i.e.*, objections relating to the prior art identified by the Patent  
14 Examiner as related to the patentee’s application). In short, the subsequent back-and-forth  
15 between the patentee and the Patent Examiner and the resulting amendments had nothing to do  
16 with the Patent Examiner’s initial rejection under § 101 (which had already been withdrawn at  
17 that point of the prosecution) and did nothing to obviate or affect the § 101 analysis.

18 As Google points out in its Opening Brief, because the issue raised here is a question of  
19 law, the prosecution history corroborates that the patent claims are invalid for failure to claim  
20 patentable subject matter. The prosecution history provides insight into where the Patent  
21 Examiner and patentee went wrong during the prosecution of this patent in trying to cure the  
22 § 101 deficiency. It is useful for this Court to understand (with the benefit of further clarification  
23 from the Supreme Court on the question of patentable subject matter) how the Patent Examiner  
24 allowed an invalid patent to issue before the *Bilski* cases provided more guidance on this issue.  
25 Here, as the prosecution history demonstrates, in attempting to cure the § 101 objection correctly  
26 raised by the examiner in the first instance, Plaintiff adopted (and the Patent Examiner allowed) a  
27 cure, that under recent case authority, fails as a matter of law.

1           B.       Plaintiff Misapplies The Machine-Or-Transformation Test

2           Under *Bilski II*, the machine-or-transformation is an appropriate – although not  
3 exclusive – test to analyze the question of patentable subject matter. Plaintiff misapplies the test  
4 to conclude that the claims of the '459 patent pass both prongs of the test. The reality is that the  
5 claims pass neither.

6                   1.       The Claims Of The '459 Patent Are Not Tied To A Machine

7           The machine prong of the machine-or-transformation tests posits a simple question: are  
8 the claims tied to “a **particular** machine or apparatus.” *Bilski I*, 545 F.3d at 954 (emphasis  
9 added). As subsequent cases have clarified and expounded, the answer to this question is  
10 negative where – as here – the claims are simply tied to, without more, a general purpose  
11 computer. See *CLS Bank Int'l v. Alice Corp. Pty, Ltd.*, No. 07-974, 2011 U.S. Dist. LEXIS  
12 23669, at \*43 (D.D.C. Mar. 9, 2011) (“The Court concludes that nominal recitation of a general-  
13 purpose computer in a method claim does not tie the claim to a particular machine or apparatus or  
14 save the claim from being found unpatentable under §101.”); *Bancorp Servs., L.L.C. v. Sun Life*  
15 *Assur. Co. of Can.*, No. 00-1073, 2011 U.S. Dist. LEXIS 14272, at \*26-27 (E.D. Mo. Feb. 14,  
16 2011) (“The claims do not refer to a specific machine by reciting structural limitations that  
17 narrow the computer implemented method to something more specific than a general purpose  
18 computer [or] recite any specific operations performed that would structurally define the  
19 computer.”) (internal quotations omitted); *Graff/Ross Holdings LLP v. Fed. Home Loan Mortg.*  
20 *Corp.*, No. 07-796, 2010 U.S. Dist. LEXIS 141399, at \*18-19 (D.D.C. Aug. 27, 2010) (“The  
21 undersigned finds that independent claim 101 is not drawn to patentable subject matter because it  
22 recites nothing more than an abstract idea on a general purpose computer.”); *DealerTrack, Inc. v.*  
23 *Huber*, 657 F. Supp. 2d 1152, 1156 (C.D. Cal. 2009) (“The Court finds that none of these devices  
24 constitutes a ‘particular machine’ within the meaning of *Bilski*. The '427 Patent does not specify  
25 precisely how the computer hardware and database are ‘specially programmed,’ and the claimed  
26 central processor is nothing more than a general purpose computer that has been programmed in  
27 some unspecified manner.”); *Fuzzysharp*, 2009 U.S. Dist. LEXIS 115493 at \*12-13 (“The salient  
28 question is not whether the claims are tied to a computer. Rather, as [*Bilski I*] makes clear, the

1 question is whether the claims are ‘tied to a particular machine.’”) (citing *Bilski I*, 545 F.3d at  
2 961); *see also Glory Licensing LLC v. Toys “R” Us, Inc.*, 2011 U.S. Dist. LEXIS 51888, \*9-11  
3 (D.N.J. May 16, 2011) (unpublished opinion) (finding that claims that merely recite a “first  
4 computer” and “another computer” fail the machine prong of the machine-or-transformation test).

5 In its Opposition, Plaintiff argues “[t]he system could not be implemented without the use  
6 of the computer: the very heart of the invention is to categorize and label network pages (e.g.  
7 Internet web pages).” (Opp. at 17.) This statement is, at best, half correct. The “very heart” may  
8 be to categorize and label network pages, but the categorizing and labeling described in the  
9 claims does not require a computer. Claim 1, which is illustrative of the other claims of the ’459  
10 patent, has steps for providing a list of categories, assigning a network page to a list of categories,  
11 providing a label to a network page, and controlling usage of the network page using the label.  
12 (The ’459 patent, 12:24-38.) None of these steps explicitly or implicitly require the use of a  
13 computer. In fact, the Patent Examiner made this same observation in her initial § 101 rejection:  
14 “Note as presently written **the claim simply recites a series of steps [of] an abstract idea that**  
15 **can be implemented with a pen and paper.**” Maikish Decl., Ex. 6 (emphasis added). Because  
16 the claims do not mention a particular machine or apparatus and because the claims do not require  
17 the use of a particular computer, the claims do not meet the machine prong of the machine-or-  
18 transformation test.

19 In a similar vein, Plaintiff argues that “. . . in the context of the Internet, the claimed  
20 inventions may run on one or more server machines, or more specifically, Web servers.” (Opp. at  
21 15.) Plaintiff goes on to argue that “[t]he inventions of the ’459 Patent, to the contrary, not only  
22 explicitly recite that the inventions are ‘computer implemented,’ but the computer (*e.g.*, a web  
23 server in the context of the Internet), which consists of hardware and software, is essential to the  
24 inventions.” (Opp. at 17.) Plaintiff’s argument, however, makes the same mistakes the above-  
25 cited cases specifically counsel against. The claims are not directed to “a particular machine” as  
26 the machine-or-transformation test requires. Here, Plaintiff’s argument that the claims might run  
27 on “server machines” or “web servers” is no less problematic than saying that the claims run on  
28 “a computer.” Plaintiff merely substituted the notion of a general purpose computer for a general

1 purpose web server. As pointed out above, this argument has been soundly rejected by various  
2 courts and this Court should do so here.

3 Perhaps the most telling indication that Plaintiff's argument with respect to the machine  
4 prong of the machine-or-transformation test is incorrect is Plaintiff's complete inability to point to  
5 anything in the claims that firmly tie the claims to a particular machine or apparatus. Plaintiff  
6 would have this Court, in contradistinction to well-established case law, ignore the plain language  
7 of the claims (which recite no particular machine or apparatus) and essentially read-in an element  
8 of a "particular machine." However, because no such element is present in the claims, the claims  
9 fail the machine prong of the machine-or-transformation test. Because the claims do not  
10 explicitly or implicitly require a particular machine, the claims fail the machine prong of the  
11 machine-or-transformation test.

12 2. The Claims Of The '459 Patent Do Not Transform Network Pages Into A  
13 Different State Or Thing: The Claims Start With A Network Page And End  
14 With A Network Page

15 Plaintiff's Opposition misconstrues what it means to be transformative. As *Bilski I* clearly  
16 articulates, to be transformative under the transformation prong requires that the claims  
17 "transform an article into a different state or thing." 545 F.3d at 954. Plaintiff argues that the  
18 claims take a "network page" and "transform" that page by adding a label to it. (Opp. at 18-19.)  
19 Taking Plaintiff's description of the technology of the '459 patent at face value, merely labeling  
20 an article does not transform that article into "a different state or thing" as required by the test.  
21 *See, e.g., CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011)  
22 ("The mere collection and organization of data regarding credit card numbers and Internet  
23 addresses is insufficient to meet the transformation prong of the test. . . ."); *In re Ferguson*, 558  
24 F.3d 1359, 1364 (Fed. Cir. 2009) ("Nor do Applicants' methods, as claimed, transform any article  
25 into a different state or thing. At best it can be said that Applicants' methods are directed to  
26 organizing business or legal relationships in the structuring of a sales force (or marketing  
27 company)."). There is no transformation here; the claims start with a network page and end with  
28 a network page.

1           Trying to present this same argument from a different angle, Plaintiff argues that the  
2 claims are transformative because “. . . the methods [of the ’459 patent] transform network pages  
3 through the use of a ‘categorization label’ so that use of the page is restricted to the category or  
4 categories to which the page is assigned, including copyright status.” (Opp. at 18.) The adding of  
5 a label of the kind discussed in the claims to a network page is exactly the same kind of  
6 manipulation that *Bilski I* expressly decries as not being transformative. As *Bilski I* informs,  
7 “[p]urported transformations or manipulations simply of public or private legal obligations or  
8 relationships, business risks, or other such abstractions cannot meet the test because they are not  
9 physical objects or substances, and they are not representative of physical objects or substances.”  
10 545 F.3d at 963. This addition of a label relating to copyright status of a network page is a  
11 manipulation of a legal obligation (*i.e.*, the copyright status) and/or of abstract categorization.  
12 This kind of transformation is not enough to meet the transformation prong of the test under  
13 *Bilski I*.

14           Plaintiff, relying on the pre-*Bilski* case *In re Abele*, 684 F.2d 902 (CCPA 1982), argues  
15 that the method recited in the claims of the ’459 patent is analogous to the transformation that  
16 takes place in the patent-in-suit in *Abele* in which “raw data” is transformed into a visual  
17 depiction of an object. The Plaintiff’s reliance on *Abele* is misplaced. When faced with similar  
18 arguments regarding *Abele* as offered by Plaintiff here, the court in *Bancorp Servs., L.L.C. v. Sun*  
19 *Life Assur. Co. of Can.*, 2011 U.S. Dist. LEXIS 14272, at \*30-31 (E.D. Mo. Feb. 14, 2011),  
20 explained:

21           The invention at issue [in *Abele*] was directed to an improvement in computed  
22 tomography that reduced exposure to x-rays while improving the reliability of  
23 the image. Several claims recited a process of graphically displaying variances  
24 of data from average values; these were determined to be invalid as directed  
25 solely to a mathematical algorithm. Another claim was found to be valid  
26 because it specified that the data were “x-ray attenuation data produced in a two-  
27 dimensional field by a computed-tomography scanner.” “This data clearly  
28 represented physical and tangible objects, namely the structure of bones, organs,  
and other body tissues. Thus, the transformation of that raw data into a particular  
visual depiction of a physical object on a display was sufficient to render that  
more narrowly-claimed process patent-eligible.” . . . Unlike the valid claims in  
*Abele* and *Abstrax*, the claims here do not transform the raw data into anything  
other than more data and are not representations of any physically existing  
objects. The “concepts of fetching and processing data” are not patentable

1 processes but are “attempts to patent a mathematical algorithm - converting a  
value in one format to a value in another format.”

2 (citations omitted). The purported transformation of the '459 patent similarly is not saved by  
3 reference to *Abele*. The claims of the '459 patent take a network page and allow that page to be  
4 labeled. That the network page is, after the application of the claims of the '459 patent, a labeled  
5 network page is not analogous the kind of transformation that the court in *Abele* found took place  
6 when raw data was converted into a visual depiction of an object.

7 Plaintiff's final argument that the claims are transformative because the claims change  
8 “the underlying code that makes up the pages” is spurious. (Opp. at 19.) Such a purported  
9 “transformation,” as discussed above does not constitute a **physical** transformation as required  
10 under *Bilski I*. More importantly, however, the machine-or-transformation test is appropriately  
11 applied to the claims of the patent. There is no element in any of the claims of the '459 patent  
12 that discusses changing or modifying of source code. *See, e.g., Ass'n for Molecular Pathology v.*  
13 *United States PTO*, 653 F.3d 1329, 1356 (Fed. Cir. 2011) (refusing similar attempts by a plaintiff  
14 to read in additional transformative steps not actually present in the claims where the plaintiff  
15 argued that additional steps “necessarily precede[d]” certain steps present in the claims).  
16 Plaintiff's similar attempt to read in modification of the network page code should be rejected.

17 Because any purported transformations that are occurring here are not transforming the  
18 network pages into “a different state or thing” and because the purported transformation does not  
19 act upon “physical objects or substances,” the '459 patent's claims fail the transformation prong  
20 of the machine or transformation test.

21 C. Plaintiff's Attempt To Align Its Claims With The Supreme Court's Holding In  
22 *Diehr* Fails

23 Plaintiff relies on the Supreme Court's reasoning in *Diamond v. Diehr*, 450 U.S. 175  
24 (1981), to argue that the claims of the '459 patent are not an abstract idea. *Diehr*, however, is  
25 inapposite.

26 The invention in *Diehr* was directed to a method of curing rubber that was controlled by  
27 computer program utilizing a particular, and well-known, mathematical formula. By repeatedly  
28 applying the formula, the method of the patent allowed for a more accurate process for curing



1 rubber. *Diehr*, 450 U.S. 175 (1981); *see also*, *Bilski I*, 545 F.3d at 953. The core issue in *Diehr*  
2 was whether the use of a well-known mathematical formula rendered the claim invalid as directed  
3 toward unpatentable subject matter. The Supreme Court found that it was not invalid because the  
4 specific use to which the formula was directed was new. In other words, *Diehr* was not seeking  
5 to patent all uses of the formula, only its particular use in a particular set of steps laid out in the  
6 *Diehr* patent that resulted in cured rubber products. Accordingly, *Diehr* is inapposite to the  
7 subject matter of '459 patent because the '459 patent is not directed towards the use of a  
8 mathematical formula to transform a physical substance.

9 D. Plaintiff Fails To Rebut The Examiner's Conclusion That The Claims Are Directed  
10 To An Abstract Idea Capable Of Being Performed With "Pen And Paper"

11 During the course of prosecution, the Patent Examiner rejected the claims of the '459  
12 patent as directed towards an abstract idea capable of being performed "with a pen and paper."  
13 *See* Mot. at 2-3. Plaintiff attempts to deflect from this fact and rebut Google's argument that the  
14 patent is directed to unpatentable mental steps (*i.e.*, a sub-category of abstract idea) through  
15 reliance on the Federal Circuit decisions in *Ultramercial* and *Research Corp. Techs.* Such  
16 reliance is misplaced.<sup>3</sup>

17 1. Plaintiff's Reliance On *Ultramercial* Is Misplaced

18 Plaintiff attempts to liken its claims to the claims of the patent-in-suit in the Federal  
19 Circuit's recent *Ultramercial* decision. (Opp. at 10-12.) The claims at issue in the *Ultramercial*  
20 decision relate to a purportedly complex algorithm for "distributing copyrighted products over the  
21 Internet where the consumer receives a copyrighted product for free in exchange for viewing an  
22 advertisement, and the advertiser pays for the copyrighted content." *Ultramercial, LLC v. Hulu*,

23  
24 <sup>3</sup> Google notes that Plaintiff's Opp. makes passing reference to the U.S. Patent Office's "Interim  
25 Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v.*  
26 *Kappos*," 75 Red. Reg 43, 992 (July 27, 2010) (Opp. at 9, Ex. B to the Folger Decl.). While the  
27 PTO's guidance on this issue is not binding on this Court, Google's position offered in Motion  
28 and in this Reply, nevertheless, fully conform to the PTO's guidance.

1 LLC, 657 F.3d 1323, 1324 (Fed. Cir. 2011). The elements of the exemplar claim discussed in the  
2 decision are:

3 (1) receiving media products from a copyright holder, (2) selecting an  
4 advertisement to be associated with each media product, (3) providing said  
5 media products for sale on an Internet website, (4) restricting general  
6 public access to the media products, (5) offering free access to said media  
7 products on the condition that the consumer view the advertising, (6)  
8 receiving a request from a consumer to view the advertising, (7)  
9 facilitating the display of advertising and any required interaction with the  
10 advertising, (8) allowing the consumer access to the associated media  
11 product after such display and interaction, if any, (9) recording this  
12 transaction in an activity log, and (10) receiving payment from the  
13 advertiser.

14 *Id.* at 1328.

15 The claims at issue in the *Ultramercial* are distinguishable from the claims of the '459  
16 patent. As indicated in Google's Opening Brief, each of the claim elements of the '459 patent  
17 (and collectively all of the claims) can be performed in a person's head (*i.e.*, constitute a mental  
18 process), unlike those elements recited above with respect to *Ultramercial* claims. *See* Mot. at  
19 12-14. With respect to the patent claims in the *Ultramercial* case, it is not possible in one's head  
20 to, for example, "provid[e] the media product for sale at an Internet website" or to "record[] the  
21 transaction event to the activity log." On the other hand, the very simple claims of the '459  
22 patent are susceptible to being performed in one's head. (Mot. at 12-14.) The more detailed  
23 claims at issue in the *Ultramercial* decision were found by the Federal Circuit to contain enough  
24 substance and specificity to meet the requirements of § 101 but as detailed in Google's Opening  
25 Brief and in this Reply, Plaintiff's claims in the instant matter are lacking such substance. In  
26 short, Plaintiff's attempt at analogy to the more complete claims in the *Ultramercial* patent-in-suit  
27 falls short.

## 28 2. Plaintiff's Reliance On *Research Corp. Techs.* Is Misplaced

In *Research Corp. Techs. v. Microsoft Corp.*, 627 F.3d 859, 864 (Fed. Cir. 2010), the panel overturned a lower court decision that certain of the various asserted claims were invalid as directed toward an abstract idea. The relevant claims in that matter were directed to a "process for rendering a halftone image." *Research Corp. Techs.* at 868 (internal quotations omitted). In that matter, the panel determined, likening its holding to the Supreme Court's determination in

1 *Diehr*, that the patentee was not seeking patent protection for mathematical formula, but rather  
2 was seeking “patent protection for a process of halftoning in computer applications.” *Id.* at 869  
3 (internal quotations omitted) (citing *Diamond v. Diehr*, 450 U.S. 175, 187 (1981)). In the instant  
4 matter, there is no allegation that Plaintiff’s patent seeks to impermissibly claim a mathematical  
5 formula being applied for transformative purposes; accordingly, Plaintiff’s attempt to analogize  
6 its claims to those at issue in *Research Corp. Techs.* (similar to its attempts to analogize to *Diehr*)  
7 falls short.

8 3. Like In *CyberSource And Ass’n For Molecular Pathology*, The ’459 Patent  
9 Impermissibly Seeks To Patent “Pen And Paper” Claims

10 Google is not alone in its argument that the claims of the ’459 patent are directed to an  
11 abstract idea. The Patent Examiner herself reached the same conclusion explaining that “the  
12 claim simply recites a series of steps [of] an abstract idea that can be implemented with pen and  
13 paper.” Maikish Decl., Ex. 6. It is only through flawed reliance on the notion that adding the  
14 words “computer implemented” to the preamble of the claims somehow made the claims  
15 patentable that the patent ultimately issued. In seeking to refute that the claims of the ’459 patent  
16 are not directed to an abstract idea, Plaintiff disingenuously focuses on the patent’s specification  
17 and not on the claim language itself. (Opp. at 12-13.) Even if one agrees that the discussion cited  
18 by Plaintiff from the patent specification is sufficiently non-abstract, that the patent **specification**  
19 discusses such things as Internet searching and the problems in users finding relevant information  
20 on the Internet, does not somehow, as Plaintiff states, make the **claims** directed at “functional  
21 and palpable applications in the field of computer technology.” (Opp. at 13 quoting *Research*  
22 *Corp. Techs.*, 627 F.3d at 868-69.)

23 The notion that a party cannot patent that which can be performed through mental process  
24 has recently been reaffirmed by the Federal Circuit in both *CyberSource* and in *Ass’n for*  
25 *Molecular Pathology*. As discussed in Google’s Opening Brief (Mot. at 12-14), the Federal  
26 Circuit’s recent decision in *CyberSource* is instructive here. In *CyberSource*, the Federal Circuit  
27 upheld a district court’s decision that the patent-in-suit was invalid under 35 U.S.C. § 101. The  
28 exemplar claim in that matter reads:

1 3. A method for verifying the validity of a credit card transaction over the  
2 Internet comprising the steps of:

3 a) obtaining information about other transactions that have utilized an  
4 Internet address that is identified with the [ ] credit card transaction;

5 b) constructing a map of credit card numbers based upon the other  
6 transactions and;

7 c) utilizing the map of credit card numbers to determine if the credit card  
8 transaction is valid.

9 *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011) (citing the  
10 patent-in-suit). After affirming the district court's finding that the claims failed the machine-or-  
11 transformation test, the panel went on to reaffirm prior authority relating to the unpatentability of  
12 mental processes concluding:

13 Thus, claim 3's steps can all be performed in the human mind [or by a  
14 human using a pen and paper.] Such a method that can be performed by  
15 human thought alone is merely an abstract idea and is not patent-eligible  
16 under § 101. Methods which can be performed entirely in the human mind  
17 are unpatentable not because there is anything wrong with claiming mental  
18 method steps as part of a process containing non-mental steps, but rather  
19 because computational methods which can be performed entirely in the  
20 human mind are the types of methods that embody the basic tools of  
21 scientific and technological work that are free to all men and reserved  
22 exclusively to none.

23 *Id.* at 1373 (Fed. Cir. 2011) (internal citations and quotations omitted). The claims of the '459  
24 patent are no different.

25 Similarly instructive, is the Federal Circuit's recent decision in *Ass'n for Molecular*  
26 *Pathology*, 653 F.3d 1329 (Fed. Cir. 2011). In that matter, certain claims of the patents-in-suit  
27 were directed at "comparing" and "analyzing" certain gene sequences. *Ass'n for Molecular*  
28 *Pathology*, 653 F.3d at 1355. The Federal Circuit upheld the lower court's finding of invalidity  
under 35 U.S.C. § 101 finding:

We conclude that Myriad's claims to "comparing" or "analyzing" two  
gene sequences fall outside the scope of § 101 because they claim only  
abstract mental processes. The claims recite, for example, a "method for  
screening a tumor sample," by "comparing" a first BRCA1 sequence from  
a tumor sample and a second BRCA1 sequence from a non-tumor sample,  
wherein a difference in sequence indicates an alteration in the tumor  
sample. '001 patent claim 1. This claim thus recites nothing more than the  
abstract mental steps necessary to compare two different nucleotide  
sequences: look at the first position in a first sequence; determine the

1 nucleotide sequence at that first position; look at the first position in a  
2 second sequence; determine the nucleotide sequence at that first position;  
3 determine if the nucleotide at the first position in the first sequence and the  
4 first position in the second sequence are the same or different, wherein the  
5 latter indicates an alternation; and repeat for the next position.

6 *Id.* at 1355-1356 (internal citations omitted).

7 Much like comparing two nucleotide sequences as in *Ass'n for Molecular*  
8 *Pathology*, or obtaining information, constructing a map and using the map as in  
9 *CyberSource*, categorizing network pages can be performed in the human mind. One could  
10 label each of the network pages and put it into a pile of other network pages in that category  
11 without using a computer or other apparatus except a pen. The claims of the '459 patent are  
12 directed toward mental steps performable with pen and paper and are, accordingly, invalid.

13 E. Google's Argument Applies To Each Of The Claims

14 Each of the claims of the '459 patent are directed towards a "method" of taking a network  
15 page, categorizing the page, and labeling the page. There are only three independent claims:  
16 Claims 1, 30, and 31. While Google has directed its analysis primarily at the language of Claim  
17 1, from a practical point of view and for the purposes of the section 101 analysis, there are no  
18 material differences between the three independent claims. Claim 30 provides the additional  
19 limitation over Claim 1 of providing a categorization code for labeling the network page with a  
20 categorization label, "wherein said categorization label indicates a set of categories and  
21 subcategories to which the network page is assigned." Claim 31 is identical to Claim 1 except  
22 that Claim 31 recites different categories. Plaintiff recites the text of these independent claims,  
23 but makes no arguments that one is different from the other in any way that is relevant to the  
24 section 101 analysis (or otherwise). (Opp. at 2-4.) These additional limitations do not direct the  
25 claims to a more specific machine or apparatus or change the nature of any claimed  
26 "transformation." Claims 30 and 31, like Claim 1, are just a categorization method that could be  
27 done with pen and paper as the Examiner found and as patentee did not dispute.

28 Dependent Claims 2-15 simply specify the kinds of categories that can be included in the  
list of categories recited in claim 1 and, thus, do not alter the section 101 analysis. Dependent  
Claims 16-18 add the limitation of "providing an indicium" for each of the categories comprised

1 of letters (Claim 18) or an icon (Claim 17). Any indicium could be added to the page using a pen,  
2 so these minor changes keep these claims firmly within the “pen and paper” realm regardless of  
3 the construction of “providing an indicium.” Dependent Claims 19-22 add the limitation of  
4 “providing a categorization code that can be used to label the page” with and without “indici-  
5 um” for the categories. It is difficult to imagine a limitation more firmly capable of being carried out  
6 with a pen and paper than that of labeling a page with a code as millions of people, such as  
7 administrative assistants, have been doing with pen and paper for decades. Dependent Claims 23-  
8 28 further define the categorization label and categorization code and do not change the § 101  
9 analysis. Finally, dependent Claim 29 provides for the list of categories to be provided on a  
10 graphical user interface. Using pen and paper one could, and many people have, listed categories  
11 with “checkboxes” in which a person could select categories for their page. The specification  
12 itself shows a “preferred graphical user interface used for categorizing [a page]” in Figures 1 and  
13 2 that can, and in these examples has, been implemented on pen and paper.

14 Because none of the claims are directed to a particular machine or apparatus, none of the  
15 claims transform a network page into a different state or thing, and all of the claims merely  
16 represent the abstract concept of categorizing a network page and applying a label, none of the  
17 claims are directed at patentable subject matter and accordingly all of the claims should be ruled  
18 invalid. Plaintiff’s argument that Google fails to consider the claims of the ’459 patent as a whole  
19 because Google focuses “principally on the ‘computer implemented method’ limitation” misses  
20 the mark. (Opp. at 13.) As discussed above and in its opening Brief, Google’s argument is not  
21 focused on the fact the claims recite “a computer implemented method.” Rather, Google’s  
22 argument is that each of the claims of the patent are invalid as directed towards an abstract idea  
23 and are not “saved” from this fate by an insubstantial reference to a computer in the preamble of  
24 the three independent claims.

#### 25 **IV. CONCLUSION**

26 Google’s Motion for Invalidity of the ’459 patent is ripe for adjudication. While Google  
27 acknowledges the presumption of validity afforded to issued patents under 35 U.S.C. § 282, that  
28 presumption is clearly overcome where, as here, the Patent Office’s error in allowing the patent to

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issue is manifest. Whether one analyzes the issue through *Bilski*'s machine-or-transformation test, comparison to the Supreme Court's decisions in *Benson*, *Flook*, and *Diehr*, through exposition of what is means to be an "abstract idea", or some amalgam of such tests, the claims of the '459 patent are directed to an abstract idea. The claims passing reference to being implemented on a computer does not change this fact. Accordingly, the '459 patent is invalid. Google's Motion should be granted.

Dated: January 13, 2012

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