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

11	ICONFIND, INC.,	)	Case No. 2:11-CV-00319 GEB JFM
		)	
12	Plaintiff,	)	
		)	<b>DEFENDANT GOOGLE INC.'S</b>
13	v.	)	<b>OPENING CLAIM CONSTRUCTION</b>
		)	<b>BRIEF</b>
14	GOOGLE INC.,	)	
		)	
15	Defendant.	)	Date: July 23, 2012
		)	Time: 9:00 a.m.
16		)	Location: Courtroom 10
		)	The Honorable Garland E. Burrell, Jr.
17		)	
18		)	

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**NOTES ON CITATIONS**

The following citation conventions are used in this brief:

- Google = Google Inc.
- IconFind = IconFind, Inc.
- '459 patent = the patent-in-suit, U.S. Patent No. 7,181,459, attached as Exhibit A to the Joint Claim Construction Statement (Dkt. 93)
- XX:YY = column number: line number(s) of the '459 patent
- Pros. History = the prosecution history of the '459 patent, attached as exhibit B to the Joint Claim Construction Statement (Dkt. 93), each citation to the prosecution history will contain the Bates number(s) of the page(s) being cited
- The *Yahoo!* Case = *IconFind Inc. v. Yahoo! Inc.*, Case No. 09-109 WBS JFM (E.D. Cal.)
- Cl. Constr. = Memorandum And Order Re: Motion For Claim Construction in *IconFind Inc. v. Yahoo! Inc.*, Case No. 09-109 WBS JFM (E.D. Cal.), attached as exhibit 1
- Ex. = Exhibit

The following exhibits are attached to the Declaration of Kenneth M. Maikish in support of Google's Inc.'s Opening Claim Construction Brief:

<i>Exhibit</i>	<i>Description</i>
1	Memorandum And Order Re: Motion For Claim Construction ( <i>Yahoo!</i> Case, Dkt. 50)
2	Neil Randall and Dennis Jones, USING FRONTPAGE® 2000, 304-324, (Mark Taber, ed., Que 1999)
3	Selected screenshots from the Internet Archive's archive of the SourceForge website, collected between June 20, 2000 and December 5, 2000
4	IconFind's Objections and Responses to Interrogatory Nos. 1-8
5	Excerpt from Reporter's Transcript Of Proceedings, Defendant's Motion For Claim Construction Monday, December 7, 2009 ( <i>Yahoo!</i> case, Dkt. 54, pp. 71-76)
6	IconFind's <i>Ex Parte</i> Application For Leave To File A Supplemental Response To The Court's December 7, 2009 Question Regarding "Network Page" ( <i>Yahoo!</i> case, Dkt. 49)

1	7	Order On IconFind’s <i>Ex Parte</i> Application For Leave To File A Supplemental Response To The Court’s December 7, 2009 Question Regarding “Network Page” ( <i>Yahoo!</i> case, Dkt. 53)
2		
3	8	Stipulated Order Of Dismissal ( <i>Yahoo!</i> case, Dkt. 61)
4	9	A copy of the <i>About</i> page from Creative Commons’ website, available at <a href="http://creativecommons.org/about">http://creativecommons.org/about</a>
5		
6	10	A copy of the <i>About The Licenses</i> page from Creative Commons’ website, available at <a href="http://creativecommons.org/licenses/">http://creativecommons.org/licenses/</a>
7		
8	11	A copy of the <i>Our Supporters</i> page from Creative Commons’ website, available at <a href="http://creativecommons.org/supporters/">http://creativecommons.org/supporters/</a>
9	12	Plaintiff’s Response To Google Inc.’s First Set Of Requests For Admission
10	13	Deposition Transcript for Lee H. Grant, pp. 92-95
11	14	Joint Statement re Discovery Disagreement - Infringement Contentions (Dkt. 88)
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## **I. INTRODUCTION**

Google submits this claim construction brief to address the disputed terms of the claims of U.S. Patent No. 7,181,459. The parties agree that four claim terms should be construed exactly as Judge Shubb previously construed them in the *Yahoo!* Case. (Dkt. 93.) Plaintiff is now seeking to back away from its admission in the *Yahoo!* Case concerning a fifth term construed by Judge Shubb—an admission Judge Shubb relied upon in issuing his claim construction order. IconFind’s prior admission, and Judge Shubb’s reliance upon it, appeared to dispose of the *Yahoo!* Case. Three additional terms are in dispute.

10 Pursuant to Federal Circuit claim construction principles, Google proposes constructions firmly rooted in the intrinsic record, including the specification and the prosecution history, as well as prior claim constructions. Google further relies on IconFind’s own admission in the *Yahoo!* Case concerning the proper scope of its claims. IconFind, by contrast, offers only vague constructions that improperly delegate the duty of construing the terms to the jury. *See O2 Micro Int’l Ltd. v. Beyond Innovation Tech.*, 521 F.3d 1351 (Fed. Cir. 2008) (holding that where the parties raise an actual issue regarding the proper scope of a claim term, the court, not the jury, must resolve that dispute). And, contrary to the notions of both fairness and *stare decisis*, IconFind is further attempting to relitigate a matter that was settled in a prior claim construction proceeding involving the same patent.

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## **II. FACTUAL AND TECHNICAL BACKGROUND**

The ’459 patent issued on February 20, 2007 from an application filed on February 22, 2002. On February 3, 2011, Plaintiff IconFind filed this lawsuit against Google for infringement of the ’459 patent.



1           A.     The State Of The Prior Art

2           As of August 9, 2001,<sup>1</sup> methods of categorizing network pages (whether on the Internet or  
3 internal networks) based on subject matter were well known. The background section of the '459  
4 patent acknowledges as much in its description of "directories" and the Dublin Core system. (1:38-  
5 64.) Other well-known art was cited by the patent examiner in multiple rejections of the '459  
6 patent claims. (*See* Pros. History, IF000148-153 (rejecting the claims under 35 U.S.C. § 102(b) as  
7 being anticipated by U.S. Patent No. 5,933,827 ("Cole")); Pros. History, IF000119-125 (rejecting  
8 the claims under § 102(b) rejecting the claims under § 102(b) as being anticipated by Cole); Pros.  
9 History, IF000083-92 (rejecting the claims under 35 U.S.C. § 103 as being unpatentable over  
10 Cole)).

11           Also available prior to 2000, but not cited by the patentee or examiner, were systems that  
12 allowed the creator of a network page to choose between categories for "corporate" pages and  
13 categories for "discussion" pages, as well as mark the page(s) with a copyright status. For  
14 example, Microsoft FrontPage® 2000 ("FrontPage") was commercially available website design  
15 software that allowed a creators to design and publish network pages. FrontPage allowed creators  
16 to create network pages for a business using the "Corporate Presence Wizard." (*See* Ex. 2 at 304-  
17 14.) FrontPage also allowed creators to create network pages for posting and commenting on  
18 articles using the "Discussion Web Wizard." (*See id.* at 316-24.) FrontPage allowed creators to  
19 choose a copyright status for their network pages. (*See id.* at 310, Fig. 13.6.) FrontPage then  
20 created the website with code indicating the creator's selections. (*See id.* at 304-24.)

21           Likewise, available prior to 2000, but not cited by the patentee or examiner, were systems  
22 like SourceForge that allowed the creator of a software package (containing source code, text files,  
23 images, and other files) to upload those files to a computer system. (*See* Ex. 3 at 1.) The creator  
24 could choose a subject matter "Topic," including "Education" and "Office/Business" for the files.

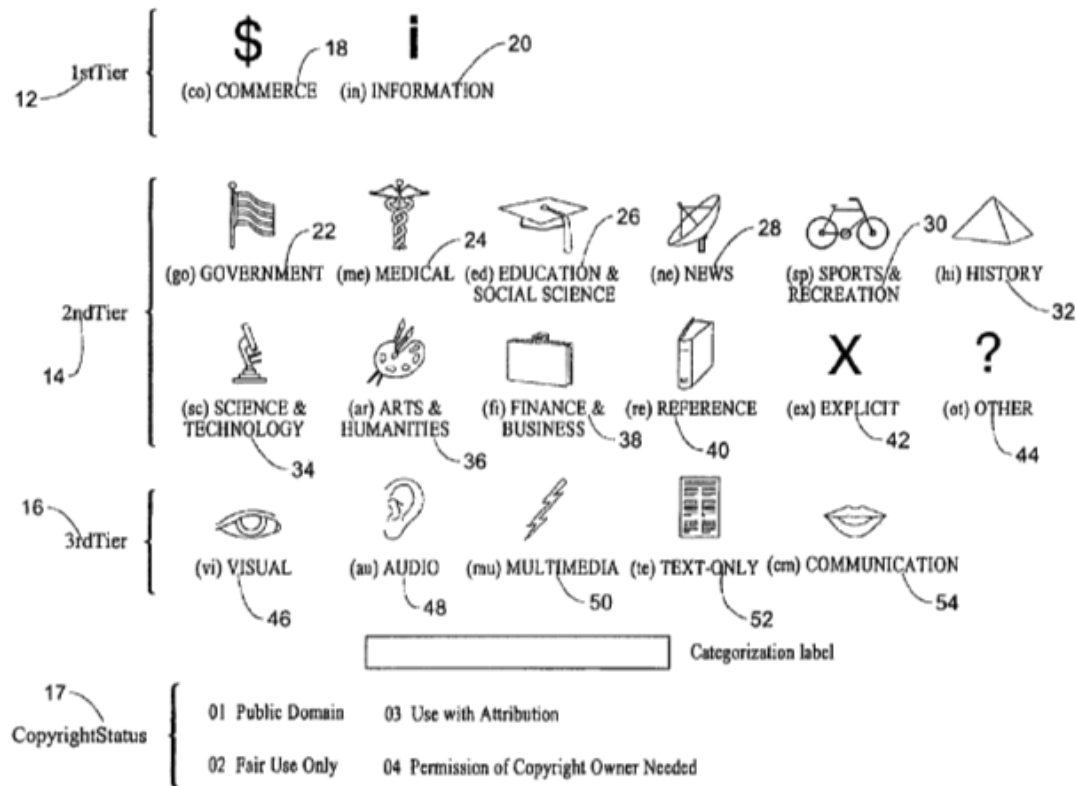
25  
26 \_\_\_\_\_  
27 <sup>1</sup> The filing date of Provisional Application No. 60/311,379 and IconFind's claimed priority date.  
28 (Ex. 4, at 4.)

(*Id.* at 2.) The creator could then choose a copyright license to designate to his or her files. (*Id.* at 3.) The computer system would then allow other users to download the software package on a page that displayed the subject matter as well as the license associated with the package. (*Id.* at 4, highlighted in red.)

Nevertheless, IconFind purports to have invented a new system in which the creator of a network page assigns that network page using a system that provides one of two sets of specific categories: (1) a category for transacting business, a category for providing information, and a category based on the copyright status of material on a page, (claims 1-30) or (2) categories related to public domain, fair use only, use with attribution, and permission of copyright owner needed (claim 31).

**B. Overview Of The Patent**

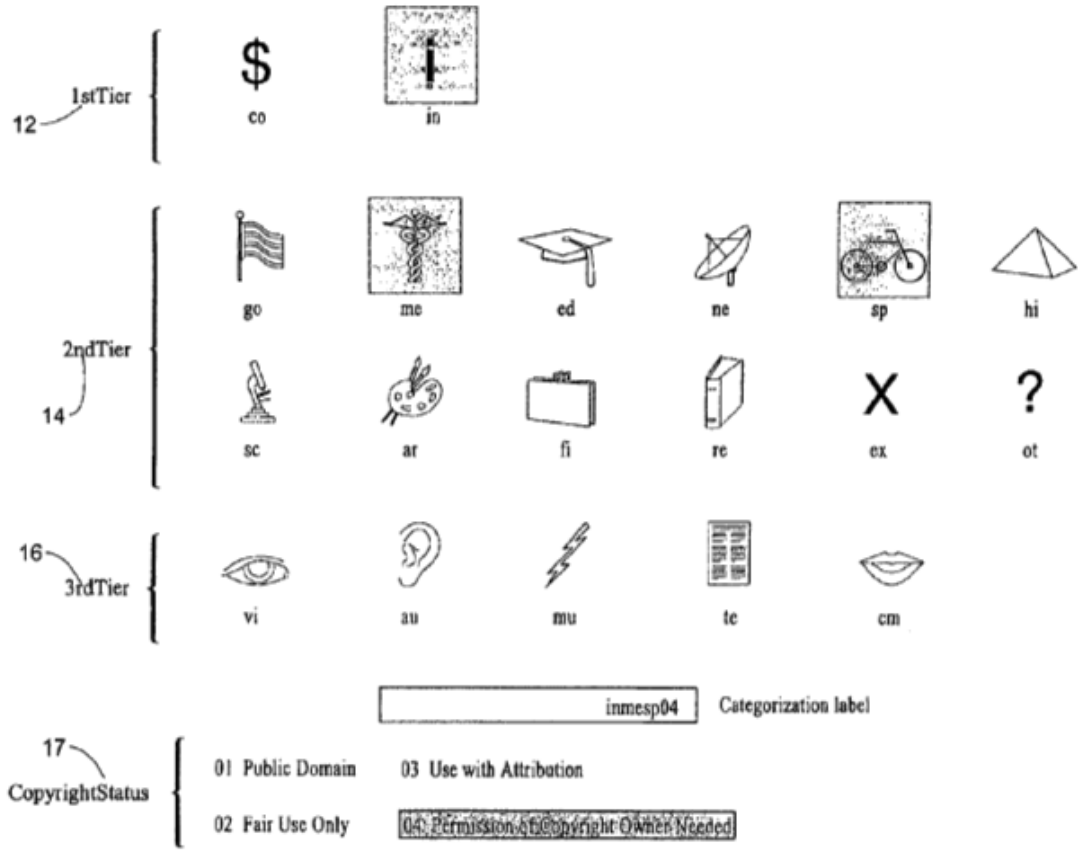
The '459 patent describes a computer-implemented method for categorizing network pages. The patent describes a computer system that provides four tiers of categories as illustrated in Fig. 1 of the patent.



1 ('459 patent, Fig. 1.) The "1st Tier" divides network pages into two broad but distinct categories  
2 depending on the purpose of the network page. (4:60-5:9.) Pages that "have as a purpose  
3 transacting business" are categorized as Commerce (co). (Cl. Const. at 13.) Pages that "have as a  
4 purpose the provision of information, for example network pages that contain articles, journals, or  
5 publications" are categorized as Information (in). (Cl. Const at 15.) The "2nd Tier" categorizes  
6 pages into subject matter. (5:10-28.) The "3rd Tier" categorizes pages according to the types of  
7 files associated with the page. (5:29-47.) The system also provides a "Copyright Status" tier  
8 which contains categories based on the copyright status of material on a page. (5:48-58.)

9       The creator of a network page manually assigns the categories that characterize the  
10 purpose(s), subject matter(s), file type(s), and copyright status of his or her network page. (6:12-  
11 60; *see also* Cl. Constr. at 3.) An example used in the patent is a network page that contains  
12 information about treating sports injuries where the creator wants to inform viewers that  
13 permission from the owner is needed in order to reuse the content. (7:40-47.) The creator of that  
14 page would assign the page to the Information (in), Medical (me), Sports & Recreation (sp), and  
15 Permission of Copyright Owner Needed (04) categories by selecting the indicia for each of the  
16 categories. (*Id.*) Then, once the creator has assigned the network page to certain categories, the  
17 computer system provides the "categorization label" to the creator of the network page as shown  
18 in Fig. 2 of the patent:  
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(’459 patent, Fig. 2.) As shown in Fig. 2, each of the selected categories is highlighted and the computer system has created the categorization label “inmesp04” in the box near the bottom of the Figure. The creator then either types or pastes the categorization label onto his or her network page so that it can be read by a search engine “web crawler,” or communicates the assigned categories directly to a search engine. (6:50-60; Cl. Const. at 3-4.) The specification further states that: “By selecting one of the four copyright-status indicia and placing it on the end of the categorization label, the creator adds the information governing the use of the material. For instance, if the creator wants to inform viewers that the page is available for use as long as an attribution is included, ‘03’ would be added to the end of the categorization label.” (7:31-37.) The network page can then be found by a user searching the Internet for information. In this way, the patent describes a method for categorizing and searching pages on the Internet. (1:22-25.)

1  
2 Exemplary claim 1 reads:

3 1. A computer implemented method of categorizing a  
4 network page comprising:  
5 providing a list of categories; wherein said list of categories  
6 includes a category for transacting business and a  
7 category for providing information; and wherein said  
8 list of categories includes category based on copyright  
9 status of material on a page;  
10 assigning said network page to one or more of said listed  
11 categories;  
12 providing a categorization label for the network page  
13 using the copyright status of material on the network  
14 page; and  
15 monitoring usage of the network page using the categorization  
16 label and the copyright status of the network  
17 page.

18  
19 C. Prosecution History Of The Patent

20 During prosecution, the Patent Office repeatedly rejected the claims of the '459 patent in  
21 light of prior art that disclosed categorizing web pages. As a result, IconFind's patent issued with a  
22 narrowed scope, claiming only systems that categorize network pages into one of two sets of  
23 specific and narrow categories. Judge Shubb's claim construction order confirms this reading of  
24 the prosecution history. (Cl. Constr. at 4 ("During the prosecution of the '459 patent, the inventors  
25 repeatedly had their patent rejected due to the prior art that disclosed categorizing web pages.  
26 [Citations.] The inventors eventually narrowed the claims of their patent to claim a categorization  
27 system which included at least the three categories of transacting business, providing information,  
28 and copyright status."))

Originally, IconFind's claim 1 recited:

1. A method of categorizing a network page, comprising the steps of:
- a. providing a list of categories; and,
  - b. providing the opportunity to assign a page to one or more of a plurality of said categories.

1 (Pros. History, IF000255.) The Patent Office rejected all the claims under § 102(b) and § 103 in  
 2 multiple rounds of rejections because the prior art already taught how to categorize network pages.  
 3 To avoid the prior art, IconFind amended its claims three times to require *specific categories* and  
 4 additional steps:

5 ~~Claim 1 (newly amended): A computer-implemented method of categorizing a network page,  
 6 comprising:  
 7 providing a list of categories, wherein said categories include a plurality of categories based  
 8 on the copyright status of material on a page; and  
 9 assigning said network page to one or more of a plurality of said list of categories.~~  
 10 ~~Claim 1 (newly amended): A computer-implemented method of categorizing a network page,  
 11 comprising:  
 12 providing a list of categories, wherein said categories include a plurality of categories based  
 13 on the copyright status of material on a page; and  
 14 assigning said network page to one or more of a plurality of said list of categories.~~

15 (Pros. History, IF000063.) This version of claim 1 was later allowed in this substantially narrower  
 16 version. (Pros. History, IF000023-26.)

17 IconFind's original claim 51, which issued as claim 31, was also substantially narrowed  
 18 during prosecution. Originally, claim 31 read:

19  
 20 **Claim 51 (new):** A method of categorizing a network page, comprising:  
 21 providing a list of categories, wherein said categories include a plurality of categories based  
 22 on the copyright status of material on a page; and  
 23 assigning said network page to one or more of a plurality of said list of categories.

24  
 25 (Pros. History, IF000144.) The Patent Office rejected this claim in light of the prior art:  
 26  
 27  
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1           8.     The limitations of claim 51 have been addressed above except for the following:  
2           wherein said categories include a plurality of categories based on the copyright status of  
3           material on a page [note: Cole et al. provides for user ability to define the category see  
4           column 4 lines 30-66; also note column 5 line 60 through column 6 line 4].

5  
6     (Pros. History, IF000123.) In response, IconFind narrowed its claim to include the *specific*  
7     copyright status categories recited below:

8     ~~Claim 31 (currently amended): A computer implemented method of categorizing a network page,~~  
9     ~~comprising:~~  
10           ~~providing a list of categories, wherein said categories include a plurality of categories based~~  
11           ~~on the copyright status of material on a page, and wherein the copyright status comprises categories~~  
12           ~~related to public domain, fair use only, use with attribution, and permission of copyright owner;~~  
13           ~~and~~  
14           ~~assigning said network page to one or more of a plurality of said list of categories.~~

15     (Pros. History, IF000113.) This version of claim 31 was later allowed in this substantially  
16     narrower version. (Pros. History, IF000023-26.)

17           D.     Prior Litigation

18           IconFind filed suit against Yahoo! Inc. (“Yahoo!”) for infringement of the ’459 patent on  
19           January 13, 2009. The Honorable William B. Shubb presided over the case. The accused product  
20           in that case was Yahoo!’s photo sharing service, “Flickr,” which, similar to an accused product in  
21           this case, allowed users to designate Creative Commons copyright licenses to uploaded photos.

22           At the claim construction hearing in front of Judge Shubb, Plaintiff made an important  
23           concession with regard to the construction of the term “network page.” (Ex. 5.) After the hearing,  
24           Plaintiff filed an *Ex Parte* Application For Leave To File A Supplemental Response To The  
25           Court’s [] Question Regarding “Network Page.” (Ex. 6.) The application was denied. (Ex. 7.)  
26           Judge Shubb incorporated Plaintiff’s concession into his claim construction order. (Cl. Constr. at  
27           8.) Plaintiff did not appeal the claim construction order, and the order was never vacated. The  
28

1 case settled several months after the claim construction order issued. (Ex. 8.) The Order Of  
2 Dismissal states that the Claim Construction Order “remains in full force and effect.” (*Id.*)

3 E. The Accused Products

4 The accused products in this case are Google Knol, Google Books, and Google’s Picasa  
5 Web Albums (“Picasa”). Each of these products allow users or publishers to upload and store  
6 digital content on Google’s computer servers: Google Knol stores articles; Google Books stores  
7 digital copies of print books; and Picasa stores images.

8 Each of these products allow Google users uploading content to choose licenses provided  
9 by Creative Commons to designate to their content. Creative Commons is a non-profit  
10 organization that provides free, standard licenses that content creators may use to inform others of  
11 the licensing restrictions associated with that content. (Ex. 9.) Creative Commons licenses are  
12 described as “some rights reserved” because they fall in between the two extremes of copyright  
13 licenses: “all rights reserved” and “public domain” (*i.e.*, no rights reserved.) (*See Exs. 9, 10.*)

14 The purpose of Creative Commons licenses is to allow content creators to communicate to  
15 others the rights the creator reserves in the work and the rights the creator waives for the benefit of  
16 the public. By incorporating the use of Creative Commons licenses into these products, Google  
17 and Creative Commons promote creativity, sharing, and innovation. (Ex. 9.) Creative Commons  
18 is supported by The John D. & Catherine T. MacArthur Foundation, The William and Flora  
19 Hewlett Foundation, The Bill & Melinda Gates Foundation, as well as many other corporations,  
20 law firms, and individuals. (Ex. 11.)

21 IconFind alleges that Google’s products’ use of Creative Commons licenses infringes the  
22 ’459 patent. However, none of these products incorporate any subject matter categories, let alone  
23 categories for “transacting business” and “providing information,” as required by claims 1-30.  
24 IconFind’s expansive reading of its claims would encompass any product that allows a content  
25 creator to choose any copyright designation for digital content and display indicia of that copyright  
26 designation along with the content. (*See IconFind’s Infringement Contentions (Dkt. 88), at Ex. 1.*)



1     **III.     THE LAW OF CLAIM CONSTRUCTION**

2             A.     Intrinsic Evidence Is Preferred

3             Construction of patent claims is a question of law to be decided by the Court. *Markman v.*  
4     *Westview Instruments, Inc.*, 517 U.S. 370, 371-73 (1996). “It is well-settled that, in interpreting an  
5     asserted claim, the court should look first to the intrinsic evidence of record, *i.e.*, the patent itself,  
6     including the claims, the specification and, if in evidence, the prosecution history. . . . Such  
7     intrinsic evidence is the most significant source of the legally operative meaning of disputed claim  
8     language.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (citation  
9     omitted).

10            The specification provides the context for the claim. “Importantly, the person of ordinary  
11     skill in the art is deemed to read the claim term not only in the context of the particular claim in  
12     which the disputed term appears, but in the context of the entire patent, including the  
13     specification.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (*en banc*). The  
14     claims “must be read in view of the specification, of which they are a part.” *Id.* Indeed, the  
15     specification “is always highly relevant to the claim construction analysis. Usually, it is  
16     dispositive; it is the single best guide to the meaning of a disputed term.” *Id.* “[T]he best source  
17     for understanding a technical term is the specification from which it arose, informed, as needed, by  
18     the prosecution history.” *Id.* at 1315 (internal quotation marks omitted).

19            The purpose of the invention, as described in the specification, also instructs claim  
20     construction. *MercExchange, LLC v. eBay, Inc.*, 401 F.3d 1323, 1337 (Fed. Cir. 2005), vacated  
21     and remanded on other grounds, 547 U.S. 388 (2006) (relying on the purpose of the invention  
22     stated in the specification of providing “a trusted network of consignment nodes” to construe the  
23     term “auction” as requiring a process over a trusted network or with a trusted intermediary).

24            B.     Patent Claims May Be No Broader Than The Supporting Disclosure

25            A patentee is only entitled to claims that are as broad as his disclosure will allow. *Gentry*  
26     *Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1480 (Fed. Cir. 1998). “[C]laims may be no  
27     broader than the supporting disclosure, and therefore [] a narrow disclosure will limit claim  
28

1 breadth.” *Id.* Claims that are broader than the supporting disclosure are invalid under 35 U.S.C. §  
2 112, ¶ 1 for failing the written description requirement. *Id.* at 1478-80.

3 The purpose of the written description requirement is to prevent the patentee from over-  
4 reaching by claiming subject matter that he did not invent. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d  
5 1555, 1561 (Fed. Cir. 1991) (“Adequate description of the invention guards against the inventor’s  
6 overreaching by insisting that he recount his invention in such detail that his future claims can be  
7 determined to be encompassed within his original creation.”) (citing *Rengo Co. v. Molins Mach.*  
8 *Co.*, 657 F.2d 535, 551 (3d Cir.), *cert. denied*, 454 U.S. 1055 (1981)).

9 C. The Inventor Must Convey That He Was In Possession Of The Invention And  
10 Enable A Skilled Artisan To Practice The Invention

11 The specification “must clearly allow persons of ordinary skill in the art to recognize that  
12 [the inventor] invented what is claimed.” *Id.* at 1563. The often-cited *Vas-Cath* case makes clear  
13 that “[t]he written description must communicate that which is needed to enable the skilled artisan  
14 to make and use the claimed invention.” *Id.*

15 D. The Patentee May Not Claim Subject Matter Surrendered During Prosecution

16 It is well settled that when a patentee narrows a claim in response to an examiner’s  
17 rejection, the patentee will be bound by the surrender of subject matter it made in the amendment.  
18 *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 33 (1966) (“Here, the patentee obtained his  
19 patent only by accepting the limitations imposed by the Examiner. The claims were carefully  
20 drafted to reflect these limitations and [the patentee] is not now free to assert a broader view of  
21 [the] invention.”).

22 The patentee may not attempt to reclaim, through the claim construction process, subject  
23 matter that was surrendered during prosecution because the additional limitation must be viewed as  
24 a disclaimer of the broader claim. *Board of Regents of the University of Texas System v. BENQ*  
25 *America Corp.*, 533 F.3d 1362, 1369–70 (Fed. Cir. 2008) (holding that the Court could not  
26 construe a claim term added during amendment as encompassing the very claim limitation that the  
27 amendment was meant to narrow). This is true even if the examiner’s rejection was erroneous.  
28 *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1572 n.6 (Fed. Cir.

1 1997). This is also true if the patentee surrendered more subject matter than necessary to overcome  
2 the prior art. *Norian Corp. v. Stryker Corp.*, 432 F.3d 1356, 1361-62 (Fed. Cir. 2005).

3 E. Judge Shubb's Claim Construction Order Is Binding On IconFind

4 Judge Shubb issued a claim construction order in the *Yahoo!* case on December 14, 2009.  
5 That order is binding on IconFind under collateral estoppel. *Curtiss-Wright Flow Control Corp. v.*  
6 *Z & J Techs.*, 563 F. Supp. 2d 1109, 1121-22 (C.D. Cal. 2007) (ruling a plaintiff is bound by a  
7 prior claim construction order issued by a Texas district court); *Int'l Gamco v. Multimedia Games*  
8 *Inc.*, 732 F.Supp.2d 1082, 1089-92 (S.D. Cal. 2010) (applying Ninth Circuit law in holding  
9 collateral estoppel applies to bar plaintiff from challenging prior claim construction order).

10 Indeed, the aim of the landmark *Markman v. Westview Instruments* decision was to create  
11 uniformity in the treatment of patents. 517 U.S. 370, 390 (1996). A plaintiff should not be given a  
12 second chance to litigate the construction of a claim term. *TM Patents, L.P. v. Int'l Business*  
13 *Machines Corp.*, 72 F.Supp.2d 370 (S.D.N.Y. 1999) (emphasizing the promotion of uniformity in  
14 construing a patent claim: "it is inconceivable that a fully-litigated determination after a first  
15 *Markman* [claim construction] hearing would not be preclusive in subsequent actions involving the  
16 same disputed claims under the same patent.").

17 However, that order is not binding on Google because Google was not a party to the *Yahoo!*  
18 Case. Due process requires that a newly accused infringer, not party to the prior action, must be  
19 given an opportunity to argue for a different or more precise claim construction. *Al-Site Corp. v.*  
20 *VSI Int'l, Inc.*, 174 F.3d 1308, 1322 (Fed. Cir. 1999).

1 **IV. THE COURT SHOULD ADOPT GOOGLE’S PROPOSED CLAIM**  
 2 **CONSTRUCTIONS**

3 A. “network page” (Claims 1-31)

<b>Google’s Construction</b>	<b>IconFind’s Construction</b>
<u>Network Page</u> : Page on the Internet, private corporate network, intranet, local area network or other network wherein an image on a page does not constitute a page.	<u>Network Page</u> : Page on the Internet, private corporate network, intranet, local area network or other network.

6 Google’s construction of the term “network page” is entirely consistent with Judge Shubb’s  
 7 claim construction order and is more precise than Plaintiff’s construction because it captures an  
 8 important concession made by Plaintiff in the *Yahoo!* Case and explicitly adopted by Judge Shubb  
 9 in construing the claims.

10  
 11 **1. Google’s Construction Is Supported By Judge Shubb’s Claim**  
 12 **Construction Order**

13 In his claim construction order, Judge Shubb construed the term “network page” by  
 14 construing only the term “network” and not the term “page.” The Court determined that “page”  
 15 did not require construction because counsel for plaintiff conceded at oral argument that “an image  
 16 on a ‘page’ did not constitute a ‘page’” thereby eliminating the dispute between Yahoo! and  
 17 Plaintiff. (Cl. Constr. at 8.) The transcript from the claim construction hearing shows that Judge  
 18 Shubb decided that “page” did not require construction because of Plaintiff’s concession:

19 THE COURT: What's wrong with [Plaintiff’s position] since nobody is going to  
 20 take the position that an image on a page is a page in and of itself?

21 MS. KASH [for Defendant Yahoo!]: If that is an admission that we have from  
 22 plaintiff and Your Honor is accepting of it, then network page is fine

23 ***THE COURT: All right. Well, if you want to just -- we can put it on the record.***  
***You do not claim that an image which is on a page is a, quote, page, unquote,***  
***itself.***

24 ***MR. HAAN [for Plaintiff IconFind]: An image itself, in and of itself the image***  
***file is not a page.***

25 THE COURT: All right.

26 MS. KASH: Thank you.

27 THE COURT: Okay.

28 MR. HAAN: So I guess I don't understand what the construction of this term is.  
 There is no construction?

1           ***THE COURT: No, there will be a construction. But I don't think we need to***  
2           ***define the word "page" because everybody understands what it means. It***  
3           ***doesn't mean an image, it means a page.***

4           (Ex. 5, at 75 (emphasis added).) Judge Shubb’s construction includes the concession. (Cl. Constr.  
5           at 8 (“At oral argument, counsel for the plaintiff conceded that an image on a ‘page’ did not  
6           constitute a ‘page.’ The parties then agreed that the term ‘page’ did not need to be further  
7           defined.”).)

8           Google does not seek a construction differing from Judge Shubb’s claim construction order.  
9           Google only seeks a construction that explicitly contains Judge Shubb’s reason for not separately  
10          construing “page.” If IconFind had not made this important concession, Judge Shubb would have  
11          been forced to construe the term “page” because the parties disagreed on its meaning. Therefore,  
12          Google’s construction of the term “network page” is more precise because it contains the Plaintiff’s  
13          concession that an image on a page does not constitute a page. And, for reasons discussed below,  
14          Plaintiff’s concession and Judge Shubb’s construction reliance thereon, are entirely consistent with  
15          the intrinsic evidence. Simply put, IconFind was correct when it admitted “an image itself...is not  
16          a page.”

17          Google has sought—and Plaintiff has refused to make—the same concession to Google in  
18          this case. (Ex. 12 (IconFind refused to admit that an image on a page is not a page in a Request For  
19          Admission served by Google in this case).)

## 20                           **2. Google’s Construction Is Supported By The Specification And The** 21                           **Claims**

22          Google’s proposed construction is supported by the specification and the claims because the  
23          specification and claims differentiate between the “page” and “material on the page.” In his  
24          discussion of this claim term, Judge Shubb recognized that the patent claims themselves “clearly  
25          distinguish ‘network page’ from ‘material on a page’ and ‘material on the network page.’” (Cl.  
26          Constr. at 8 (citing claim 1 of the ’459 patent).) The specification also distinguishes between the  
27          network page and material on the page. (3:47-50 (“It is also an object of the invention to provide a  
28

1 method for categorizing *a page on a network* . . . according to the copyright status of the *material*  
 2 *on the page.*”) (emphasis added).)

3 The claims recite a method for categorizing network pages into categories. It is the  
 4 categories that are based on the copyright status of material that is on a page, for example, an  
 5 image. (12:24-38; Cl. Constr. at 3.) The drafters of the ’459 patent knew the difference between a  
 6 “page” and “material on the page” and drafted the claims with that distinction in mind. If the  
 7 drafters had meant an image or other material on a page to be the same as a “network page,” they  
 8 could have drafted the claims to do so. They did not.

9 Google’s construction of “network page” is consistent with Judge Shubb’s claim  
 10 construction order as well as the specification and claims of the ’459 patent. It is also more precise  
 11 than Plaintiff’s definition because it encompasses Judge Shubb’s reason for not separately  
 12 construing “page.” Without Plaintiff’s concession on the record in this case, Plaintiff’s proposed  
 13 construction does not solve the parties’ dispute with respect to the term “page.” Therefore,  
 14 Google’s construction should be adopted.

- 15 B. “assigning said network page to one or more of [a plurality of] said list of  
 16 categories” (Claim 1-29, 31) and “a set of categories and subcategories to which the  
 17 network page is assigned” (Claim 30)

Google’s Construction	IconFind’s Construction
<p>18 <u>Assigning said network page to one or more of</u>                      19 <u>[a plurality of] said list of categories:</u> the creator                      20 of the web page choosing which one or more of                      21 <u>[a plurality of] said list of categories</u>                      22 <u>characterize said network page</u></p> <p>23 <u>A set of categories and subcategories to which</u>                      24 <u>the network page is assigned:</u> a set of categories                      25 and subcategories that were chosen by the                      26 creator of the web page as characterizing the                      27 network page</p>	<p>18 <u>Assigning said network page to one or more of</u>                      19 <u>[a plurality of] said list of categories:</u> This                      20 element need not be construed separately and                      21 should be given its plain and ordinary meaning                      22 in the context of the intrinsic record as                      23 understood by a person of skill at the time of the                      24 invention.</p> <p>25 If the Court deems a construction is necessary,                      26 IconFind proposes:                      27 Assigning the network page to at least one of                      28 the categories</p> <p><u>A set of categories and subcategories to which</u>  <u>the network page is assigned:</u> This element need                      not be construed separately and should be given                      its plain and ordinary meaning in the context of</p>

the intrinsic record as understood by a person of skill at the time of the invention.

If the Court deems a construction is necessary, IconFind proposes:<sup>7</sup>

A set of categories and subcategories to which the network page is assigned where subcategories are combinations of categories

The primary dispute between the parties is whether any entity may perform the assignment or whether it must be performed by “the creator.” Google’s construction requires that the assignment be performed by the creator and is consistent with the specification. Plaintiff’s construction impermissibly broadens the scope of this claim to cover inventions outside the specification’s disclosure.

**1. The Specification Demonstrates That The Creator Performs The Assigning**

Google’s construction is well-supported by the ’459 patent specification. The specification repeatedly, consistently, and exclusively states that “*the creator*” of the network page assigns the page to categories. (5:62-67; 6:12-16; 6:19-22; 6:31-33; 6:39-40; 6:43-44; 6:47-49; 6:50-60; 6:63-7:3; 7:12-15; 7:66-8:9.)

The specification describes a system in which “the creator” uses a user interface (depicted in Fig. 1) in order to choose the categories to assign to the network page. (6:12-60.) The user interface then provides the “categorization label” to “the creator.” (7:40-47 (explaining that Fig. 2 provides the categorization label “inmesp04”).) The categorization label is preferably placed or typed on the network page. (9:16-18.) Then, the label can be read by a computer program known as a “web crawler” that reads pages on the Internet in order to aid search engines. (9:18-21.) The assignment is *not* carried out by the web crawler. The assignment is performed by the creator before the web crawler reads the labels. (Cl. Constr. at 4; 9:33-35 (“The categorization labels will then be read [by the Web crawler] and each category assigned [by the creator] to the page recognized by its two-letter or two-numeral indicium.”).) Alternatively, “the creator” may

1 communicate the assigned categories to the search engine directly without placing the  
2 categorization label on the network page. (6:54-58 (“In addition, or alternatively, the creator may  
3 communicate the categories to which the page is assigned to one or more search engines for the  
4 purpose of allowing such search engines to locate or recognize the page, by its assigned categories,  
5 in conducting a search.”).)

6 Throughout the ’459 patent, the creator assigns the network page. No other form of  
7 assignment is described in the specification. Where a patent repeatedly and consistently describes  
8 the invention in a certain manner, the proper construction of the claim terms must be consistent  
9 with that description even if the claim term itself could be construed more broadly. *See Hologic,*  
10 *Inc. v. SenoRx, Inc.*, 639 F.3d 1329, 1338 (Fed. Cir. 2011) (limiting the construction of a term  
11 where the specification disclosed only one embodiment, and “that is clearly what the inventors of  
12 the ... patent conceived of”); *Eon-Net LP v. Flagstar Bancorp*, 653 F.3d 1314, 1321-23, 1328-29  
13 (Fed. Cir. 2011) (affirming the district court’s construction of the terms “document” and “file” as  
14 limited to hard copy documents because the written description “repeatedly and consistently”  
15 described the embodiments using hard copy documents, and affirming the district court’s  
16 imposition of Rule 11 sanctions against plaintiff for its “illogical” construction of its claims).

17 In *Hologic*, the claim term was a “radiation source [] *asymmetrically* located and arranged .  
18 . . .” *Hologic*, 639 F.2d at 1331. The Federal Circuit held that even though the claim did not  
19 specify a reference axis for the asymmetry, the claim required asymmetry about the longitudinal  
20 axis because the specification limited its description and figures to that embodiment. *Id.* at 1338  
21 (“Because the specification, including the figures, consistently and exclusively shows radiation  
22 sources located asymmetrically about the longitudinal axis, and because that is clearly what the  
23 inventors of the ’142 patent conceived of, claim 1 is properly construed as referencing radiation  
24 sources that are [asymmetric about the longitudinal axis.]”). The same logic applies in this case.  
25 The specification limited its description by consistently and exclusively describing a method where  
26 the creator assigns the network pages. Therefore, the claims should be limited to that system.  
27  
28



## 2. Google's Construction Is Consistent With The Goals Of The '459 Patent

The '459 patent describes various prior art systems, such as directories, that categorized network pages. In a directory, the network pages are assigned to categories by directory editors or contributors. (1:52-55 (“Directories or indices are human-compiled databases of Web sites or pages. Most directories use editors to review and categorize Web sites. Some use contributions by their visitors.”).) Because the network pages were assigned to categories by editors or contributors, directories suffered from two drawbacks: (1) categorization was “haphazard,” and (2) directories tended to be small. (1:52-64.) The inventors set out to fix the small and haphazardly categorized Internet directories.

The '459 patent also describes the prior art Dublin Core system, which was a “cataloging system for the Internet.” (1:41-42.) The drawbacks of the Dublin Core system, according to the inventors, are that it “requir[es] a high degree of cataloging knowledge and [is] time-consuming and very expensive.” (1:44-46.) Because Dublin Core was complicated and required training, the inventors set out to create a system that was accessible to everyone.

The specification states that “[t]he method for categorizing and retrieving network pages and sites of *the present invention* are adapted to overcome [the shortcomings described above.]” (3:8-10 (emphasis added).) The solution to these problems, according to the inventors, was a system that provided *the creator* an opportunity to assign his or her network page to the category of his or her choosing. First, if each creator assigned his or her own web pages, then the entire Internet could be categorized instead of only a small percentage. Second, if the assignment was carried out by the creator, the categorization would be more accurate than if it were carried out by a third-party because the creator knows which categories “best characterize” his or her network pages. (6:12-16. Ex. 13 at 95 (“The patent describes how the creator categorizes a web page.”).) Third, the assignment process was “simple,” as opposed to complicated like Dublin Core, because

1 the creator could just type or paste the label onto his or her network page.<sup>2</sup> (7:5-7; 7:19-22.) Thus,  
2 the inventors clearly contemplated a system where the creator of a web page must assign the page  
3 to the categories.

4 Federal Circuit case law supports limiting a claim term by relying on the stated purpose of  
5 the invention. *MercExchange, LLC v. eBay, Inc.*, 401 F.3d 1323, 1337 (Fed. Cir. 2005), vacated  
6 and remanded on other grounds, 547 U.S. 388 (2006) (relying on the purpose of the invention  
7 stated in the specification of providing “a trusted network of consignment nodes” to construe the  
8 term “auction” as requiring a process over a trusted network or with a trusted intermediary);  
9 *Howmedica Osteonics Corp. v. Tranquil Prospects, Ltd.*, 401 F.3d 1367, 1372 (Fed. Cir. 2005)  
10 (using purpose of the invention to construe a claim term).

### 11 3. Google’s Construction Is Consistent With Judge Shubb’s Claim 12 Construction Order

13 Judge Shubb’s claim construction order is clear on this point: *the creator* assigns the  
14 network pages. “In the preferred embodiment, a designer of a network page manually assigns the  
15 page to appropriate categories by applying a ‘categorization code’ for each category to which the  
16 page is assigned. The network designer then combines various ‘codes’ to form a ‘categorization  
17 label’ that is placed on a network page.” (Cl. Constr. at 3-4.) “Categorization label” was  
18 construed as a “label indicating a category or categories to which a page is assigned.” (*Id.* at 19.)

19 Judge Shubb’s claim construction order only discusses the creator (or “designer”) of the  
20 network page assigning the network page. (*E.g., id.* at 18 (“A network page creator could assign a  
21 network page two categorization labels, each indicating only some of the categories to which a  
22 page is assigned.”).)

23  
24  
25  
26 <sup>2</sup> Of course, the inventors did not solve the problem of standardizing categorization codes across  
27 the Internet, but that is not relevant here.

#### 4. Plaintiff's Construction Is Impermissibly Broad

1  
2  
3 A patentee may not claim a system or method which he or she did not invent. In the  
4 landmark *Gentry Gallery* case, the Federal Circuit reaffirmed the essential rule that patent claims  
5 may be no broader than the supporting disclosure. *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d  
6 1473, 1480 (Fed. Cir. 1998) (Case law “make[s] clear that claims may be no broader than the  
7 supporting disclosure, and therefore that a narrow disclosure will limit claim breadth.”).

8 In *Gentry*, a claim for a sectional sofa with “a pair of control means” “mounted on the  
9 double reclining seat sofa section” was limited to control means mounted to the section *between*  
10 the reclining seat sofa sections, known as the console. *Id.* at 1475. The Federal Circuit held that  
11 because the patent’s disclosure did not support claims with the control means located anywhere  
12 else on the double reclining seat sofa section, the claim term must be limited. *Id.* at 1479. The  
13 panel found this narrower construction to be correct even though the claim language itself did not  
14 require the control means to be mounted to the console. *Id.* To rule otherwise, the panel found,  
15 would result in a claim that is not supported by the written description and would thus be invalid  
16 under § 112, ¶ 1. *Id.*

17 The '459 patent specification does not even suggest, much less support, a method in which  
18 a computer assigns network pages to categories. Therefore, IconFind’s construction is  
19 impermissibly broad because it suggests that any party or system could accomplish the assigning  
20 step. *Gentry* at 1479 (“No similar variation [of control means location] beyond the console is even  
21 suggested.”). Patentee IconFind did not invent or describe a system in which a computer assigns  
22 categories to network pages and therefore may not claim such a system. *Id.* To construe this term  
23 so that it encompasses a system in which a computer performs the assigning step would invalidate  
24 the claim under § 112, ¶ 1.

25 “The written description must communicate that which is needed to enable the skilled  
26 artisan to make and use the claimed invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563  
27 (Fed. Cir. 1991) (citation omitted). Because the '459 patent does not describe a system in which a  
28 computer performs the assigning step, a skilled artisan would not have been able to make the

1 invention perform in that manner. Therefore, IconFind’s construction is impermissibly broad.  
 2 Adequate written description is required so that the public knows the bounds of the claimed  
 3 invention. *Id.* at 1560-62 (discussing the policy reasons behind the written description  
 4 requirement).

5 “[T]he description must clearly allow persons of ordinary skill in the art to recognize that  
 6 [he or she] invented what is claimed,” *Id.* at 1563 (citation omitted). If a patentee wishes to claim  
 7 a method carried out by software means, the patentee must, at least, disclose the functions that the  
 8 software would execute to meet the written description requirement. *See Robotic Vision Sys. v.*  
 9 *View Eng’g Inc.*, 112 F.3d 1163, 1166 (Fed. Cir. 1997) (“[W]hen disclosure of software is required,  
 10 it is generally sufficient if the functions of the software are disclosed.”). Because the ’459 patent  
 11 does not disclose the functions of software that could assign network pages to categories, IconFind  
 12 may not claim a system where software assigns the network pages.

13 Google’s construction is consistent with the specification, the goals of the ’459 patent, as  
 14 well as Judge Shubb’s claim construction order and should be adopted.

15 C. “categories related to public domain, fair use only, use with attribution, and  
 16 permission of copyright owner needed” (Claims 6 and 31)

<b>Google’s Construction</b>	<b>Plaintiff’s Construction</b>
<p>17 <u>Categories related to public domain, fair use</u>                      18 <u>only, use with attribution, and permission of</u>                      19 <u>copyright owner needed</u>: categories that indicate                      20 that the network page may be subject to each                      21 of the following licensing restrictions: (1) the                      22 network page may be used by others without                      23 any restrictions; (2) the network page may only                      24 be used for fair uses; (3) the network page may                      25 be used if attribution to the copyright owner is                      26 given; and (4) the network page may be used                      27 only when permission is granted by the                      28 copyright owner.</p>	<p>17 <u>Categories related to public domain, fair use</u>                      18 <u>only, use with attribution, and permission of</u>                      19 <u>copyright owner needed</u>: This element need not                      20 be construed separately and should be given its                      21 plain and ordinary meaning in the context of the                      22 intrinsic record as understood by a person of                      23 skill at the time of the invention.</p> <p>24 If the Court deems a construction is necessary,                      25 IconFind proposes:                      26 Categories related to material that can be used                      27 freely without any restrictions, material meant                      28 to be used in accordance with accepted fair use                      guidelines, material accompanied by an                      attribution to the author or copyright owner, and                      material that cannot be used unless the                      copyright owner is first contacted for                      permission.</p>

1  
2 Claim 6, which depends on claim 1, and independent claim 31 require the method to  
3 provide the categories recited in this claim element. This claim element contains four distinct  
4 categories: (1) public domain, (2) fair use only, (3) use with attribution, and (4) permission of  
5 copyright owner needed. The parties generally agree on the meaning of each of the four categories,  
6 but differ on the construction in two respects. First, Google’s construction requires that the  
7 copyright status category is applied to *the network page*. Plaintiff’s construction, by contrast,  
8 states that the copyright status category is applied to *material on the network page*. Second,  
9 Google’s construction requires that the method provide four mutually exclusive categories as the  
10 claims require. By contrast, Plaintiff’s construction implies that a single copyright status category  
11 could meet this claim limitation because it could be related to all four claimed categories.  
12 Google’s construction is consistent with the claims, the specification and the prosecution history.

### 13 14 **1. Google’s Construction Is Supported By The Claims**

15 The claims of the ’459 patent are for a “method of categorizing a network page” by  
16 “providing a list of categories” and assigning the network page to “one or more of the list of  
17 categories.” (’459 patent, claim 1.) The list of categories includes copyright status categories.  
18 Therefore, it is the network page that is assigned to a copyright status category, not material on the  
19 network page. (Cl. Constr. at 8 (the claims “clearly distinguish ‘network page’ from ‘material on a  
20 page’ . . .”).) Therefore, the copyright status categories must indicate that the network page  
21 (including all the material on the page) is subject to the recited copyright licenses. Plaintiff’s  
22 construction suggests that some of the material may be subject to the copyright status category  
23 while other material may not be.

24 Google’s construction is helpful to the jury because it provides the jury with clarity on this  
25 point. Furthermore Google’s construction clarifies the fact that the four categories must be  
26 mutually exclusive. This point is also supported by the claim language.  
27  
28



1 cannot have more than one copyright status. For example, a page cannot be in the public domain  
2 and, at the same time, require attribution if reused. Further, a page cannot be reused in accordance  
3 with fair use principles and, at the same time, require the permission of the copyright owner to  
4 reuse. The proper construction of this term must include four *mutually exclusive* categories as  
5 described in the specification.

6 Plaintiff's position is that "a [single] category can be related both to public domain and fair  
7 use only." (Ex. 14 at 12.) This position is illogical. Content that is in the public domain is, by  
8 definition, free to copy and therefore *not* restricted to only fair uses. *Compco Corp. v. Day-Brite*  
9 *Lighting, Inc.*, 376 U.S. 234, 237 (1964). Plaintiff's over reliance on the words "related to"  
10 underscore the weakness of its position.

11 To illustrate Plaintiff's expansive reading of this claim, imagine the same claim language  
12 with simpler categories. The claim would read: *providing a list of categories, wherein said*  
13 *categories include a category based on color, and wherein the color comprises categories related*  
14 *to white, black, dark gray, and light gray.* Under Plaintiff's reading, providing a category for black  
15 would meet this limitation.

16 The only section of the specification that discusses these categories states: "The set of  
17 copyright-status categories 17 includes the following four categories. Public Domain is material  
18 that is in the public domain and can be used freely without any restrictions. Fair Use Only is  
19 material meant to be used in accordance with accepted fair use guidelines. Use with Attribution is  
20 material that can be used as long as its use is accompanied by an attribution to the author or  
21 copyright owner. Permission of Copyright Owner Needed is material that cannot be used unless  
22 the copyright owner is first contacted for permission, which may or may not be granted and may  
23 include fees and additional terms." 5:48-58. There is no indication that more than one of these  
24 categories may apply to a page at the same time.

25 Google's construction also instructs the jury that the copyright status category is applied to  
26 the network page. Beyond the fact that all the claims specifically claim a method for categorizing  
27 network pages, as opposed to material on pages, the specification confirms that the copyright status  
28

1 categories indicate the copyright status of the page. (6:50-54 (“After the creator decides to which  
2 categories to assign the page, the creator may mark or tag the page as belonging in or within the  
3 assigned categories by associating, with the page, the corresponding indicium for each assigned  
4 category.”).) Categories may not be applied to some material on the page and not other material as  
5 suggested by Plaintiff.

### 6 **3. Google’s Construction Is Supported By The Prosecution History**

7  
8 The patentee’s original claim 51 recited “a list of categories, wherein said categories  
9 include a plurality of categories based on the copyright status of material on a page.” (Pros.  
10 History, IF000144.) The Patent Office rejected this claim as anticipated by the prior art. (Pros.  
11 History, IF000123.) The patentee added the limitation containing the four specific categories to  
12 overcome this rejection. (Pros. History, IF000113.) Plaintiff is now attempting to recapture this  
13 surrendered subject matter with its expansive reading of this claim term in violation of established  
14 Federal Circuit precedent. *See Board of Regents of the University of Texas System v. BENQ*  
15 *America Corp.*, 533 F.3d 1362, 1369–70 (Fed. Cir. 2008) (holding that the Court could not  
16 construe a claim term added during amendment as encompassing the very claim limitation that the  
17 amendment was meant to narrow).

18 Plaintiff’s position is that “all that needs to be present [in order to meet this claim  
19 limitation] are one or more categories that are related to *either* (1) public domain; (2) fair use only;  
20 (3) use with attribution; or (4) permission of the copyright owner.” (Ex. 14 at 12 (emphasis  
21 added).) If a single category “related to” any one of these four recited categories meets this  
22 limitation, then *any* single copyright status category meets this limitation because the recited  
23 categories span the spectrum of copyright statuses. Thus, Plaintiff’s construction impermissibly  
24 creates an amended claim that is actually broader than the claim that was rejected by the Patent  
25 Office.

26 Plaintiff asserts that “[Google’s] ‘do not allow reuse (all rights reserved)’ is a category  
27 related to ‘permission of copyright owner needed’” and that this *single category* meets this claim  
28



1 limitation. (*Id.* at 12-13.) But, that is precisely the subject matter that the patentee surrendered in  
2 amending its claim from the broad “categories based on the copyright status of material on a page.”  
3 (Pros. History, IF000144.) The amendment was made to overcome prior art recited by the Patent  
4 Examiner. (Pros. History, IF000123.) Therefore, the issued claim cannot cover a broader scope  
5 than the original, rejected, claim. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 33 (1966)  
6 (“claims that have been narrowed in order to obtain the issuance of a patent by distinguishing prior  
7 art cannot be sustained to cover that which was previously by limitation eliminated from the  
8 patent”).

9 To return to our color example, it is as if Plaintiff attempted to claim *providing a list of*  
10 *categories, wherein said categories include a plurality of categories based on color*. Then, after a  
11 rejection by the Patent Office, Plaintiff amended its claim to read *providing a list of categories,*  
12 *wherein said categories include a category based on color, and wherein the color comprises*  
13 *categories related to white, black, dark gray, and light gray*. And, Plaintiff now attempts to argue  
14 that providing a single category for black was not surrendered.

15 A construction that allows this claim element to be met by a single category runs contrary  
16 to well-settled patent law. *See id.* Plaintiff attempted to claim providing *a plurality* of categories  
17 based on copyright status and that claim was rejected. Plaintiff narrowed the claim in order to  
18 overcome the rejection by reciting four categories. Now, Plaintiff asserts that this narrowed claim  
19 is actually broader than the original claim by arguing that a *single* category based on copyright  
20 status meets this limitation. Such a reading runs contrary to the prosecution history and Supreme  
21 Court law. *See id.* (“Here, the patentee obtained his patent only by accepting the limitations  
22 imposed by the Examiner. The claims were carefully drafted to reflect these limitations and [the  
23 patentee] is not now free to assert a broader view of [the] invention.”).

#### 24 **4. Plaintiff’s Construction Ignores The Claim Language In Order To Fit** 25 **Its Infringement Theory**

26 Plaintiff attempts to fold all four categories of this limitation into one broad copyright status  
27 category so that any copyright status could meet this limitation. If a single copyright status  
28

1 category need only be related to any one of the four recited categories, then *any* copyright status  
2 meet this limitation because the four recited categories span the entire range of copyright statuses.  
3 Such a construction renders the recitation of the four categories in the claim meaningless as the  
4 claim could just read “category based on the copyright status of material on a page” — just like  
5 claims 1 and 30 (and the rejected original claim 51). Such a construction is illogical and is  
6 contradicted by the prosecution history of the ’459 patent.

7 Google’s construction aids the jury by clearly stating that (1) the network page is subject to  
8 the copyright licenses, and (2) the four copyright status categories must be four mutually exclusive  
9 categories. This construction is consistent with the intrinsic evidence and should be adopted.

10  
11 Dated: May 22, 2012

Respectfully submitted,

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