

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

PERSONALIZED USER MODEL, L.L.P., )  
 )  
 Plaintiff, )  
 )  
 v. )  
 )  
 GOOGLE INC., )  
 )  
 Defendant. )  
 \_\_\_\_\_ )  
 GOOGLE, INC. )  
 )  
 Counterclaimant, )  
 )  
 v. )  
 )  
 PERSONALIZED USER MODEL, LLP and )  
 YOCHAI KONIG )  
 )  
 Counterdefendants. )

C.A. No. 09-525-LPS

**JURY TRIAL DEMANDED**

**LOCAL RULE 7.1.2(b) NOTICE OF SUPPLEMENTAL INTRINSIC EVIDENCE FOR  
DEFENDANT GOOGLE INC.’S CLAIM CONSTRUCTION BRIEFS**

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Dated: June 1, 2011  
 1014903 / 34638

On May 31, 2011, after claim construction briefing was complete, Google received a Decision Granting Inter Partes Reexamination of U.S. Patent No. 6,981, 040 ("the '040 patent") from the U.S. Patent and Trademark Office. The Decision Granting Inter Partes Reexamination is attached hereto as Exhibit 1. Local Rule 7.1.2(b) (permitting citation to subsequent authorities after submission of reply briefs).<sup>1</sup>

In the Decision Granting Inter Partes Reexamination, the Examiner made statements that are relevant to the parties' dispute regarding the construction of the phrase "unseen document." Google has proposed the phrase be construed as "document not previously seen by any user," while Plaintiff Personalized User Model, LLC ("PUM") proposed the phrase be construed as "document not previously seen by the user." (See Google's Opening Brief on Claim Construction, at 21-23, D.I. 116; Plaintiff's Opening Claim Construction Brief, at 25-26; D.I. 119; Google's Responsive Brief on Claim Construction, at 17-18, D.I. 131; Plaintiff's Responsive Claim Construction Brief, at 19-20, D.I. 132; *see also* 1/11/11 Hearing Tr., 39:18-44:3, 97:20-102:16) (emphasis added).

In the Decision Granting Inter Partes Reexamination, the Examiner made the following statements that are consistent with, and support, Google's construction that an unseen document is one that is unseen by any user:

- Describing the "pertinent" prosecution history, the Examiner stated: "The Applicants further argued that Gerace required an initial set of users to view a given document before determining whether to show that document to similar users. Accordingly, the Applicants argued that Gerace had no way of recommending a document that was entirely unseen by any user. The Examiner subsequently allowed these all [sic] claims. Based on the *above*, during the prosecution of the '975 application, claims 1-62 were deemed allowable because step (e) of the independent claims originally required 'estimating a probability P(u/d) that the document d is of interest to the user u,' the amended step (d) required 'estimating a

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<sup>1</sup> That same day, Google received a non-final Office Action, attached hereto as Exhibit 2, rejecting each of the asserted claims of the '040 patent on the bases on which Google sought re-exam. Ex. 2.

probability that an unseen document *d* is of interest to the user *u*." (Ex. 1, Decision Granting Inter Partes Reexamination, at 5) (internal citations omitted).

- In reference to the disclosures in *Mladenic*, the Examiner stated: "As recounted *above*, the ability to recommend documents that had not been previously viewed by anyone was one of the ways in which the applicants sought to distinguish the '040 patent over the prior art during prosecution." (Ex. 1, Decision Granting Inter Partes Reexamination, at 6).
- In reference to the disclosures in *Wasfi*, the Examiner stated: "As recounted above, the ability to recommend unseen documents—*i.e.*, documents that had not been previously viewed by any user—was one of the ways in which the Applicants sought to distinguish the *Konig '040* patent over the prior art during prosecution." (Ex. 1, Decision Granting Inter Partes Reexamination, at 7.)
- In reference to the disclosures in *Refuah*, the Examiner stated: "As recounted *above*, the ability to recommend documents that had not been previously viewed by anyone was one of the ways in which the applicants sought to distinguish the '040 patent over the prior art during prosecution." (Ex. 1, Decision Granting Inter Partes Reexamination, at 8.)

Exhibits 1 and 2 are part of the prosecution history of the '040 patent and, thus, Google respectfully submits that they should be considered along with the prosecution history filed as Exhibit C to Google's Opening Claim Construction Brief. (D.I. 118); *St. Clair Intellectual Property Consultants, Inc. v. Canon Inc.*, slip op., 2011 WL 66166 (Fed. Cir. Jan. 10, 2011) ("Reexamination statements 'are relevant prosecution history when interpreting claims'") (quoting *E.I. du Pont de Nemours & Co. v. Philips Petroleum Co.*, 849 F.2d 1430, 1439 (Fed. Cir. 1988)); *Hemphill v. Proctor & Gamble Co.*, 258 F.Supp.2d 410, 415 (D. Md. 2003) (same).

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**CERTIFICATE OF SERVICE**

I, David E. Moore, hereby certify that on June 1, 2011, the attached document was electronically filed with the Clerk of the Court using CM/ECF which will send notification to the registered attorney(s) of record that the document has been filed and is available for viewing and downloading.

I further certify that on June 1, 2011, the attached document was Electronically Mailed to the following person(s):

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