IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

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| PERSONALIZED USER MODEL, L.L.P., | ) | |
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| Plaintiff, | ) | |
| | ) | |
| v. | ) | |
| | ) | |
| GOOGLE, INC., | ) | |
| | ) | |
| Defendant. | ) | |
| | ) | C.A. No. 09-525 (LPS) |
| GOOGLE, INC., | ) | |
| | ) | |
| Counterclaimant, | ) | |
| | ) | |
| v. | ) | |
| | ) | |
| PERSONALIZED USER MODEL, L.L.P. and YOCHAI KONIG, | ) | |
| | ) | |
| Counterclaim-Defendants. | ) | |

**PERSONALIZED USER MODEL LLP'S RESPONSE TO LOCAL RULE 7.1.2.(B) NOTICE OF SUPPLEMENTAL INTRINSIC EVIDENCE FOR DEFENDANT GOOGLE INC'S CLAIM CONSTRUCTION BRIEFS**

Plaintiff Personalized User Model LLP ("PUM") submits this response to the Notice of Supplemental Intrinsic Evidence ("Notice") that Google, Inc. ("Google") filed on June 1, 2011 (D.I. 276), in which Google asserts that the PTO's Decision Granting Inter Partes Reexamination ("PTO Decision") supports its construction of the term "unseen document." The Notice, however, incorrectly characterizes the examiner's statements about a prior art reference in the non-final, PTO Decision made before PUM has had any opportunity to respond, which are irrelevant to claim construction in any event.

First, it is well established that statements made in preliminary reexamination proceedings are not relevant to claim construction because the statements are, as part of a document that merely begins the reexamination process, subject to change throughout the reexamination proceedings. *Presidio Components Inc. v. Am. Tech. Ceramics Corp.*, 723 F.

Supp. 2d 1284, 1301 (S.D. Cal. 2010) (refusing to consider a reexamination First Office Action in summary judgment ruling because "just like its name implies, the First Office Action is only a *preliminary* determination by the USPTO -- it is not a 'final' action, and the examiner could still change his decision or completely reverse it before issuing a final action."); *Cimcore Corp. v. Faro Techs., Inc.*, Civ. No. 03-cv-2355-B, 2007 WL 935665, at *2 (S.D. Cal. Mar. 12, 2007) (refusing to reconsider claim construction because "[a]s regards [to] the recent office action in the '148 reexamination, this information is not ripe for consideration. The office action is a first office action, not a final rejection by the USPTO."); *Monolithic Power Sys., Inc. v. O2 Micro Int'l Ltd.*, Civ. No. 04-2000, 2007 WL 6148491, at *1 (N.D. Cal. Apr. 2, 2007) (same). The cases Google cites are not to the contrary. Nowhere in *St. Clair Intellectual Property Consultants, Inc. v. Canon, Inc.*, No. 2009-1052, 2011 WL 66166 (Fed. Cir. Jan. 10, 2011) (nonprecedential), *Hemphill v. Procter & Gamble Co.*, 258 F. Supp. 2d 410, 415 (D.Md. 2003), or *Hemphill v. Procter & Gamble Co.*, 258 F. Supp. 2d 410, 415 (D.Md. 2003) does the court suggest that incomplete reexamination proceedings should be used for claim construction.[1]

Additionally, where, as here, the applicant has yet to submit a response to the examiner's statements, there is no prosecution history that can affect the meaning or scope of a claim. *See, e.g.*, *Cimcore*, 2007 WL 935665, at *2 ("[U]ntil the patentee addresses the rejections with argument or claim amendments and the reexamined patent issues, the prosecution history is incomplete and estoppel is yet to be determined."); *3M Innovative Properties Co. v. Avery Dennsion Corp.*, 350 F.3d 1365, 1373 (Fed. Cir. 2003) ("Prosecution history . . . cannot be used to limit the scope of a claim unless the *applicant* took a position before the PTO."); *Univ. of Virginia Patent Foundation v. General Elec. Co.*, 755 F. Supp. 2d 709, 722 (W.D.Va. 2010) (same).

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[1] The reexamination relied upon in *St. Clair* occurred in connection with an earlier-filed case and apparently involved findings by five different examiners. *Id.* at *5. Google's remaining two cases, *Hemphill* and *Procter & Gamble*, simply stand for the unremarkable proposition that an applicant's statements made during reissue proceedings may be relevant when interpreting claims.

Second, consistent with the legal principles set forth above, there is no new intrinsic evidence to present. Google is simply trying to use the examiner's statement in the PTO's Decision to reargue the prosecution history. As set forth in PUM's Opening Claim Construction Brief (D.I. 119, at 25-26), PUM's Responsive Claim Construction Brief (D.I. 132, at 19-20), and during the Hearing (1/11/11 Hearing Tr., 39-44), Gerace used memorization to determine the profile of a user. It did not teach generalization beyond the recorded history or memorized information. (D.I. 132, at 20, Ex. 9, at PUM 0067574-75). Google's recitation of the examiner's language from the PTO's Decision *omits* mention of this aspect of the prosecution history (*see* Ex. 1 to Google's Notice at 5). Specifically, Google fails to cite the portion of the examiner's statements indicating that Gerace determined "a user profile based purely on 'memorizing' the documents previously viewed by the user and did not suggest 'generalization [of a user profile] beyond the recorded history or memorized information.'" (PTO Decision at 5). This omission, combined with Google's citation of the examiner's "as recounted above" language in connection with certain alleged prior art references (*see* Notice at 2), provides an incomplete picture of the examiner's statements regarding the Gerace prosecution, which, as set forth previously, are not relevant in any event.

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June 6, 2011

## CERTIFICATE OF SERVICE

I hereby certify that on June 6, 2011, copies of the foregoing were caused to be served upon the following in the manner indicated:

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