

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

PERSONALIZED USER MODEL, L.L.P.,)
)
Plaintiff,)
)
v.) C.A. No. 09-525-LPS
)
GOOGLE INC.,) **JURY TRIAL DEMANDED**
)
Defendant.)

GOOGLE, INC.) **PUBLIC VERSION**
)
Counterclaimant,)
)
v.)
)
PERSONALIZED USER MODEL, LLP and)
YOCHAI KONIG)
)
Counterdefendants.)

**BRIEF IN SUPPORT OF GOOGLE INC.'S
MOTION FOR A STAY OF THE PROCEEDINGS**

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I. INTRODUCTION

This motion seeks a stay of this action in view of recent developments in the reexamination of each and every claim of the two patents asserted by plaintiff Personalized User Model (“PUM”). The USPTO has rejected every asserted claim of U.S. Patent No. 7,685,276 (the “‘276” Patent) on seven grounds and issued a Final Office Action including a Right of Appeal Notice (“FOA”) on August 17, 2012. The USPTO also rejected every asserted claim of U.S. Patent No. 6,981,040 (the “‘040 Patent”) on five grounds (including four independent grounds) in April. The parties have finished the subsequent briefing and the Final Office Action is expected to issue at any time. In short, both patents’ re-examinations are quite advanced, and the patents stand rejected subject only to a final appeal to the BPAI (for the ‘276 Patent) or a Final Office Action and subsequent BPAI appeal (for the ‘040 Patent). To permit this case to proceed in parallel with reexamination and appeal would create a risk of inconsistent outcomes and very probably waste both judicial and party resources in litigating patent claims that will ultimately be cancelled.

In determining whether to grant a request to stay, courts consider “(1) whether a stay will simplify the issues and trial of the case, (2) whether discovery is complete and a trial date has been set, and (3) whether a stay would unduly prejudice or present a clear tactical disadvantage to the non-moving party. Each of these factors favors a stay here.” Enhanced Security Research LLC v. Juniper Networks, C.A. No 10-605-LPS, 2010 WL 5420147 (D. Del. Dec. 27, 2010).

First, a stay will simplify the issues facing the Court and the parties. The PTO has called into severe question the validity of every asserted claim at issue, indicating a high likelihood that all further discovery, motion practice, and trial will ultimately go to waste. Second, although fact discovery has nominally closed, PUM continues to pursue additional discovery, and has

recently accused two new products of infringement. Lastly, there is no risk of prejudice to PUM. PUM, a non practicing entity, does not practice the patents in suit and can be fully redressed for any on-going infringement through money damages. In sum, all three factors favor a stay of this lawsuit. Indeed, this Court has granted stays in similar non-competitor patent infringement cases, where “the PTO has issued a Final Office Action [for one asserted patent] rejecting all claims and an Action Closing Prosecution [for the other asserted patent] reexamination also rejecting all claims.” Enhanced Sec. Research, 2010 WL 5420147 at *2; see, also Sigram Schindler Beteiligungsgesellschaft mbH, v. Cisco Sys., Inc., 726 F. Supp. 2d 396, 416 (D. Del. 2010) (stay granted in light of final office action invalidating or rejecting all but two asserted claims of two asserted patents).

Accordingly, Google respectfully requests that the Court immediately stay this litigation in its entirety pending completion of the reexaminations of the ‘040 Patent and any appeals therefrom, and completion of any appeal of the reexamination of the ‘276 Patent.

II. NATURE AND STAGE OF THE PROCEEDINGS

PUM filed this action on July 16, 2009, alleging that Google infringes the U.S. Patent No. 6,981,040 (the “‘040 Patent”) and U.S. Patent No. 7,320,031 (the “‘031 Patent”). (D.I. 1.) On September 8, 2009, Google answered the Complaint. (D.I. 8.) PUM filed its First Amended Complaint on April 22, 2010, alleging that Google infringes the ‘040 and ‘031 Patents and U.S. Patent No. 7,685,276 (the “‘276 Patent”). (D.I. 39.) Google answered the First Amended Complaint on May 10, 2010. (D.I. 48.) On April 22, 2011, PUM dropped the ‘031 Patent, leaving only the ‘040 and ‘276 Patents (collectively, the “Patents-in-Suit”) at issue. (Roberts Dec. at ¶ 1.)

While the Court's Scheduling Order set the close of fact discovery on February 25, 2011, and exchange of opening claim construction briefs for August 13, 2010, the Order was repeatedly amended. (D.I. 32, 55, 74, 94, 104, 113, and 179.) The due date for opening claim construction briefs was pushed back more than three months, and numerous written discovery requests have been served, and several depositions taken, after the initial fact discovery cut-off. (D.I. 113, 345, 346, 368, 380.) The cut-off date for expert discovery, and the deadline for dispositive motions, have likewise been repeatedly pushed back. (See e.g., D.I. 104, 353, 359, and 367.) The parties continue to work through discovery issues related to PUM's Supplemental Expert Report (served on August 10, 2012) and the two entirely new Google products PUM now seeks to accuse of infringement. (D.I. 373.) PUM has offered no assurances that it will not continue to pursue still more discovery.

III. SUMMARY OF THE ARGUMENT

The Court should exercise its discretion and stay this case pending the outcome of the reexamination of the Patents-in-Suit for at least the following reasons:

- 1) The reexamination will simplify the issues in this case. The USPTO has determined that there are grave doubts about the patentability of every asserted claim of the Patents-in-Suit based on prior art. Every asserted claim of the '276 was rejected on seven grounds and a FOA has issued. Every asserted claim of the '040 was likewise rejected on five grounds, and a Final Office Action is expected at any time. If PUM does not or cannot successfully appeal the results of the reexaminations, this lawsuit will be over. If the claims are modified, the issues in this case may be streamlined and will in any event differ from those now presented. By allowing the reexamination

process to finalize, this Court will conserve significant judicial and party resources; still before the court is Google's Motion to Dismiss, while further motion practice, including summary judgment, is ensured if the case continues to move toward trial. A stay will avoid the risk of inconsistent rulings between the Court and USPTO.

- 2) The discovery process is on-going. PUM continues to pursue additional discovery on new technology, and has already served one supplemental expert report after the close of discovery. No trial date has yet been set. With a significant volume of discovery outstanding, and the possibility of even further discovery remaining, resources would be used most efficiently not by setting a trial schedule for a trial that may never happen, but rather by staying the litigation pending the outcome of the reexamination appeal.
- 3) PUM will not be prejudiced or tactically disadvantaged by a stay. PUM does not compete with Google and does not make or sell anything that practices the Patents-in-Suit. Google moves now for a stay because of the substantial likelihood that reexamination will moot many or all of the issues remaining in the case.

IV. STATEMENT OF FACTS

A. The PTO Has Rejected Each Asserted Claim of the '276 Patent on Seven Separate Grounds and Issued a Final Action and Right of Appeal Notice.

On August 3, 2011 —more than one year ago— Google requested *inter partes* reexamination of the '276 Patent. (Roberts Dec. at ¶3.)

The USPTO ordered reexamination of the '276 Patent on September 20, 2011. (*Id.*) On October 24, 2011, USPTO issued a non-final office action, finding substantial new questions of

patentability for every asserted claim. (Id.) On December 23, 2011, PUM filed its response to the non-final office action. (Id.) On January 23, 2012, Google filed its comments to the non-final office action. (Id.)

On February 10, 2012, the USPTO issued an Action Closing Prosecution (“ACP”) finding each asserted ‘276 claim invalid on seven separate grounds. (Id.) Google and PUM briefed and filed their responses on March 12, 2012 and April 10, 2012, respectively. (Id.)

On August 17, 2012, the USPTO issued a Final Office Action and Right of Appeal Notice (“FOA”). (Exhibit 1.) The FOA likewise rejected every asserted claim of the ‘276 Patent on seven separate grounds. (Id.) The FOA provides that the patent owner may file a notice of appeal with respect to any adverse decision within thirty days. (Id.)

B. The PTO Is Expected to Reject Every Asserted Claim of the ‘040 Patent.

On March 31, 2011—more than one year ago—Google requested *inter partes* reexamination of the ‘040 Patent. (Roberts Dec. at ¶4.)

The USPTO issued a non-final office action ordering reexamination of the ‘040 Patent on May 27, 2011, finding substantial new questions of patentability for every asserted claim. (Id.) On July 27, 2011, PUM filed a response to the non-final office action. (Id.) On August 29, 2011, Google filed its comments to the non-final office action. (Id.)

On April 19, 2012, the USPTO issued an ACP finding each asserted ‘040 claim invalid on five grounds, including four independent grounds. (Exhibit 2.) PUM and Google filed their responsive briefs on May 21, 2012, and June 20, 2012, respectively. (Roberts Dec. at ¶4.) Since June 22, 2012, the USPTO website has listed the status of the ‘040 reexamination as “Ready for Examiner Action Following ACP.” (Id.) Thus, a FOA is expected to issue any time.

C. Discovery in this Case Is On-Going.

Although this case has been proceeding for just over three years, and the original deadline for close of fact discovery was February 25, 2011 (D.I. 32), discovery has remained active and, indeed, is on-going.

On October 18, 2011, after the close of fact discovery, PUM noticed the 30(b)(6) deposition of Google on topics related to produced user profiles. (D.I. 330.) On December 16, 2011, PUM served its sixth set of interrogatories on Google. (D.I. 337.) On January 26, 2012, Google took the depositions of named inventors Yochai Konig and Roy Twersky. (Roberts Dec. at ¶¶ 5, 6.)

From February 2, 2012 through July 13, 2012, the Court entered a series of stipulations between the parties that repeatedly extended expert discovery and the deadline for dispositive motions. (See e.g., D.I. 104, 353, 359, 364, and 367).¹ The most recent stipulation, entered on July 13, 2012, provided that expert discovery would continue through October 2, 2012 and required dispositive motions by November 7, 2012. (D.I. 367.) This stipulation also provided for additional discovery solely relating to [REDACTED]. (Id.)

On July 17, 2012, PUM noticed Google's 30(b)(6) deposition on [REDACTED] topics. (D.I. 368.) On July 31, 2012, PUM took the 30(b)(6) deposition of Google on those topics. (Roberts Dec. at ¶7.) Google produced source code [REDACTED] by July 31, 2010, and produced [REDACTED] documents by August 6, 2012. (Roberts Dec. at ¶¶ 8-11.)

On August 10, 2012, pursuant to the most recent stipulation providing for additional discovery solely on [REDACTED], PUM served its Supplemental Expert Witness Report of Michael J.

¹ At least several of these extensions were made at PUM's own request in order to allow it discovery into new Google functionality. This includes the extensions in D.I. 364 which was made not only to accommodate Google's expert, but also to facilitate PUM's requests for additional discovery.

Pazzani, which accused Google Plus and YouTube Videos of infringement for the first time. (D.I. 373.) Moreover, as detailed in Google's letter brief filed August 29, 2012, the report addresses several aspects of these systems never subject to prior discovery, including (among others) what constitutes a "document" and the operation of the [REDACTED] in Google Plus, and certain [REDACTED] functionality in YouTube. (D.I. 384.) On August 16, 2012, Google moved to strike the report. (See D.I. 374.) On August 24, 2012, PUM served its Third Supplemental Responses to Google's Second Set of Interrogatories. (D.I. 380.)

The parties continue to work through discovery issues related to source code and other matters. PUM has offered no assurances that it will not continue to pursue still more discovery.

D. PUM is a Non-Practicing Entity that Does Not Compete with Google.

PUM purported to acquire the asserted patents from Levino on May 23, 2007. (D.I. 302.) PUM itself did not come into existence until August 14, 2007. (D.I. 302.) PUM then waited almost two years to bring this suit. (D.I. 1) PUM does not make or sell any products that practice the Patents-in-Suit.

V. ARGUMENT

"Whether or not to stay litigation pending a PTO reexamination is a matter left to the Court's discretion." Enhanced Sec. Research LLC v. Juniper Networks Inc., C.A. 10-605-LPS, 2010 WL 5420147 at *1 (D. Del. Dec. 27, 2010). A stay is properly granted "pending conclusion of a PTO reexamination." Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1427 (Fed. Cir. 1988); see also Enhanced Sec., 2010 U.S. Dist. LEXIS 63789 at *10; Vehicle IP, LLC v. Wal-Mart Stores, Inc., C.A. No. 10-503-SLR, 2010 U.S. Dist. LEXIS 123493, at *7 (D. Del. Nov. 22, 2010). In fact, the Federal Circuit has emphasized that "[t]he stay of pending litigation to enable PTO review of contested patents was one of the specified purposes of the reexamination

legislation.” Patlex Corp. v. Mossinghoff, 758 F.2d 594, 606 (Fed. Cir. 1985), rev’d on other grounds, 771 F.2d 480 (Fed. Cir. 1985); see also Pegasus Dev. Corp. v. DirectTV, Inc., C.A. No. 00-1020-GMS, 2003 U.S. Dist. LEXIS 8052, at *7 (D. Del. May 14, 2003) (reexamination proceedings “should be deferred to by the courts” whenever possible) (quotation omitted); ASCII Corp. v. STD Entm’t USA, Inc., 844 F. Supp. 1378, 1381 (N.D. Cal. 1994) (“[T]here is a liberal policy in favor of granting motions to stay proceedings pending the outcome of USPTO reexamination or reissuance proceedings.”).

As explained below, a stay is appropriate here under the three-factor test outlined by this Court in Enhanced Security Research, 2010 WL 5420147, at *1.

A. A Stay Will Serve the Interests of the Parties and the Court by Simplifying the Issues for Discovery and Trial.

Judicial efficiency benefits from a stay pending reexamination in numerous ways: “(1) many discovery problems relating to the prior art may be alleviated; (2) the record of the reexamination likely would be entered at trial, reducing the complexity and length of the litigation; (3) the issues, defenses, and evidence will be more easily limited in pre-trial conferences following a reexamination; (4) the outcome of the reexamination process may encourage a settlement without further involvement of the court; and (5) if the patent is declared invalid, the suit likely will be dismissed as to that patent.” Pegasus, 2003 U.S. Dist. LEXIS 8052 at *5-6 (internal citations omitted).

A stay is especially appropriate where, as here, every asserted claim has already been rejected by the USPTO on multiple grounds. See Canady v. Erbe Elektromedizin GmbH, 271 F. Supp. 2d 64, 68 (D. D.C. 2002) (“wait[ing] for reexamination results . . . will simplify litigation by eliminating, clarifying, or limiting the claims.”) (citing Ethicon, 849 F.2d at 1428). The USPTO issued a FOA rejecting each asserted claim of the ‘276 Patent on seven independent

grounds, and an ACP rejecting each asserted claim of the '040 Patent on four independent grounds, calling into question whether any part of the Patents-in-Suit will survive reexamination at all. Thus, there is a significant possibility that this suit would be dismissed in its entirety upon the close of reexamination. See Mission Abstract Data L.L.C. v. Beasley Broadcast Group Inc., C.A. No. 11-176-LPS 2011 LEXIS 130934, at *7-8 (D. Del. Nov. 14, 2011).

Even if PUM successfully appeals some of the rejections, proceedings before the Board of Patent Appeals and Interferences (the "BPAI") will still work to simplify and clarify the issues remaining for discovery, summary judgment, and trial. See Id. ("If all or some of the asserted claims emerge from the reexaminations with modifications, that, too, could narrow the issues for the Court."). The prosecution history of the Patents-in-Suit will no doubt enter into evidence at trial, and while a complete history may be helpful to the jury, the jury might well be confused as to why a trial is proceeding at all, given that the history to date demonstrates that the USPTO believes every asserted claim should be cancelled. See Dura Global Techs., LLC v. Manga Int'l Inc., 2011 U.S. Dist LEXIS 122679, at *14 (E.D. Mich. Oct. 24, 2011) ("A stay will give the district court the benefit of having the prosecution history of the reexamination [for use] at trial.") Finally, there is also a significant possibility that the completion of the reexamination process will encourage settlement without further involvement of the Court.

On the other hand, "[n]ot staying the proceedings runs the risk of inconsistent adjudications or issuance of advisory opinions." Gioello Enters. Ltd. v. Mattel, Inc., C.A. No. 99-375-GMS, 2001 U.S. Dist. LEXIS 26158, at *3-4 (D. Del. Jan. 29, 2001); see also, e.g., Translogic Tech., Inc. v. Hitachi, Ltd., 250 Fed. App'x 988, 988 (Fed. Cir. 2007) (unpublished) (ordering district court to vacate and dismiss judgment finding patent valid and infringed after upholding USPTO's determination in reexamination that patent was invalid for obviousness).

And, as explained below, it would be extremely wasteful for this Court and the parties to “expend their assets addressing invalid claims,” which is the likely result of proceeding in parallel with reexamination proceedings that have repeatedly rejected every asserted claim. Pegasus, 2003 U.S. Dist. LEXIS 8052 at *7 (quotation omitted); see Hewlett-Packard Co. v. Acuson Corp., No. C-93-0808 MHP, 1993 U.S. Dist. LEXIS 6449, at *4 (N.D. Cal. May 6, 1993) (courts should avoid “expend[ing] unnecessary judicial resources by attempting to resolve claims which may be amended, eliminated, or lucidly narrowed by the patent reexamination process and the expertise of its officers.”) (citation omitted).

B. A Stay is Appropriate Because Discovery in this Case Is On-Going and No Trial Date Has Been Set.

Notwithstanding the nominal close of fact discovery on February 25, 2011, discovery is active and on-going. PUM has made no indication that it will stop pursuing discovery on new areas of technology. Indeed, discovery has been active over the past several months. (See e.g., Roberts Dec. at ¶¶ 7-11, 16-22.) On August 10, 2012, PUM issued its Supplemental Expert Report accusing two entirely new products of infringement, which may require production of further documents, source code, and witnesses. Because discovery is ongoing, and as explained above, Google stands to waste significant resources responding to demands, dealing with new issues, engaging in motion practice, and preparing for trial in a case that will likely be mooted entirely by the reexamination proceedings.

The Court, too, stands to waste significant resources deciding motions (including a pending motion to dismiss at D.I. 301 and 302, motions for summary judgment, and any other pre-trial motions) and setting a trial date. A stay would be proper even if a trial were scheduled. See, e.g., Pegasus, 2003 U.S. Dist. LEXIS 8052 at *2, 7 (staying more than two-year-old case with scheduled trial date); Abbott Diabetes Care, Inc. v. DexCom, Inc., C.A. No. 05-590-GMS,

2006 U.S. Dist. LEXIS 57469, at *20 (D. Del. Aug. 16, 2006) (staying case with scheduled trial date). However, because “few of this Court’s resources have yet been expended” scheduling a trial and setting related deadlines amidst its already bustling docket, the Court stands to conserve significant resources by issuing a stay and setting a trial date only in the unlikely event that any of the asserted claims survive reexamination. Enhanced Sec. Research, 2010 WL 5420147 at *2; see also Enhanced Sec., 2010 U.S. Dist. LEXIS 63789 at *10-11 (granting stay where “no trial date has been set and [] discovery is not yet complete.”).

C. PUM Will Not Suffer Prejudice Nor Will Google Gain a Tactical Advantage if this Case is Stayed.

The delay caused by a reexamination proceeding “does not, by itself, amount to undue prejudice.” Wall Corp. v. Bonddesk Group, LLC, C.A. No. 07-844-GMS, 2009 U.S. Dist. LEXIS 20619, at *4 (D. Del. Feb. 24, 2009). Rather, in evaluating the potential for prejudice, this Court considers a range of factors, including (1) the timing of the request for reexamination, (2) the timing of the request for a stay, (3) the status of the reexamination proceedings, (4) whether the parties are direct competitors, and (5) the remaining term of the asserted patents. E.g., Mission Abstract Data, 2011 U.S. Dist. LEXIS 130934 at *5-6; Vehicle IP, 2010 U.S. Dist. LEXIS 123493 at *5-6; Enhanced Sec., 2010 U.S. Dist. LEXIS 63789 at *12. These and other factors demonstrate that PUM will not be prejudiced by a stay, and that Google would not gain any tactical advantage. To the contrary, proceeding with this case in parallel to the reexamination would work a hardship on Google.

i. Reexamination was Requested at an Early Stage of Litigation

Google requested reexamination of the Patents-in-Suit more than a year ago. Google recognized early on that reexamination was appropriate given the strength of the prior art, and Google did not bring a tardy reexamination request merely to gain a tactical advantage.

That reexamination was requested early in the suit suggests that PUM would not be prejudiced by a stay. See, e.g., Wall Corp., 2009 U.S. Dist. LEXIS 20619 at *4 (granting stay when reexamination was requested more than 5 months after filing of lawsuit); Enhanced Sec., 2010 U.S. Dist. LEXIS 63789 at *10 (granting stay when reexamination of one asserted patent was requested approximately 6 months after filing of lawsuit).

ii. The Reexamination Proceedings Are at an Advanced Stage.

As described above, Google prepared and filed the instant motion upon the issuance of a FOA for the '276 Patent, while a FOA is expected to issue with respect to the '040 Patent at any time. Far from seeking a tactical advantage, Google requests a stay now that this point of finality and clarity has been reached: after all these repeated rejections, it is clear that every asserted claim of the Patents-in-Suit stands a high likelihood of cancellation. See Southwire Co. v. Cerror Wire Inc., 750 F. Supp. 2d 775, 777, 780 (E.D. Tex. 2010) (granting stay where USPTO issued FOA and RAN rejecting all asserted claims of one patent, and an initial rejection of all asserted claims of another patent).

The USPTO has already expended significant time and resources reexamining the Patents-in-Suit. That the USPTO has already taken a close look at all of the asserted claims, and concluded that each can be rejected on at least 4 separate grounds, demonstrates the high likelihood that the Patents-in-Suit will not survive reexamination. A stay is therefore appropriate while the final appeal of the USPTO rejections takes place. Enhanced Sec. Research, 2010 U.S. Dist. WL 5420147 at *2 (granting stay where “the PTO has issued a Final Office Action in [one asserted patent] reexamination rejecting all claims and an Action Closing Prosecution in [another asserted patent] reexamination also rejecting all claims.”).

As of July 27, 2011, the BPAI reversed with the examiner's patentability decisions only about 17.8% of the time in appeals from *inter partes* reexaminations. (Roberts Dec. at ¶15.) In July 2012 (the most recent month for which statistics are available), the BPAI reversed the Central Reexamination Unit's² decision on *ex parte* reexamination only about 13% of the time. (Roberts Dec. at ¶12.) Notably, in *all* the *inter partes* reexamination certificates issued from 1999 to June 2012, certificates with all claims confirmed were only 11%. (Roberts Dec. at ¶14.) Certificates with all claims canceled (or disclaimed) were 42%. (*Id.*) Certificates with claim changes were 47%.³ (*Id.*) Here, both patents have *already* gone through numerous rejections. Therefore, there is no doubt that the Patents-in-Suit now stand a very high likelihood of ultimate cancellation.

iii. PUM Does Not Compete with Google.

PUM “is a non-practicing entity, which does not manufacture or sell the products covered by the patents in suit and seeks to collect licensing fees,” and, thus, does not compete directly with Google. Mission Abstract Data, 2011 U.S. Dist. LEXIS 130934 at *11-12. Because a delay in the adjudication of PUM's claims will not result in any type of irreparable or competitive harm, this factor strongly favors a stay. Vehicle IP, 2010 U.S. Dist. LEXIS 123493 at *4 (granting stay and holding that “[o]f particular importance is the fact that plaintiff does not develop or sell any products of its own and is not a competitor of defendants. Any additional

² The Central Reexamination Unit (or “CRU”) is responsible for the reexamination of the Patents-in-Suit.

³ Any amendment that PUM would make, to the extent it would even be allowed to do so at this late stage in the reexamination, would only be a further reason that would justify a stay, as it makes no sense to litigate claims that Plaintiff is simultaneously amending. See Auto Techs. Int'l Inc. v. Am. Honda Motor Co., C.A. No. 06-187-GMS, 2009 U.S. Dist. LEXIS 85156, at *6 (D. Del. Sept. 15, 2009) (parties and court would be spared from “wasting time litigating claims that are subsequently amended” by continuation of stay).

infringement of the Patents-in-Suit resulting from a stay is fully compensable through monetary damages.

iv. The Term of the Patents-in-Suit Will Not Expire for Many Years.

If valid, the '040 Patent will not expire until 2025, and the '276 Patent will not expire until 2030. The large amount of time remaining in the terms of each of the Patents-in-Suit favors a stay. E.g., Enhanced Sec., 2010 U.S. Dist. LEXIS 63789 at *12 (“Plaintiffs’ contention that a stay pending reexamination will prejudice their rights to enforce the exclusivity of the [patents-in-suit] is largely speculative, and in any event, is counterbalanced by the fact that the patents do not expire until [six years from date of opinion].”).

v. Defendants Will Be Harmed if This Case Is Not Stayed.

Unlike PUM, Google is likely to be harmed if this litigation proceeds while the Patents-in-Suit are reexamined, given that the USPTO has issued a FOA rejecting each asserted claim of the '276 Patent on seven independent grounds, and an ACP rejecting each asserted claim of the '040 Patent.

If the asserted claims are either cancelled or amended in reexamination (which, given the late stage of the proceedings and various grounds for rejection of every asserted claim, is very likely), Google (and the Court) will be burdened by needlessly litigating a dispute—including ongoing expert discovery, summary judgment and a trial—that is ultimately mooted by the reexamination. See, e.g., In re Translogic Technology, Inc., 504 F.3d 1249, 1251, 1262 (Fed. Cir. 2007) (upholding USPTO’s determination in reexamination that patent was invalid for obviousness after judgment of infringement entered against defendant following jury trial). A stay is appropriate to ensure that Google (and the Court) benefit from the results of the reexaminations and do not “invest[] substantial resources litigating . . . patent claims that will

look quite different after the reexaminations.” Mission Abstract, 2011 U.S. Dist. LEXIS 130934, at *7; See also Enhanced Sec., 2010 U.S. Dist. LEXIS 63789 at *12 (noting prejudice to movants for stay where litigation during reexam “will likely entail significant discovery expenditures”).

VI. CONCLUSION

For the foregoing reasons, Defendant Google respectfully request that the Court grant its motion to stay this litigation in its entirety pending completion of the reexaminations of the Patents-in-Suit and any appeals therefrom.

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

CERTIFICATE OF SERVICE

I, David E. Moore, hereby certify that on September 6, 2012, 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 September 6, 2012, the attached document was Electronically Mailed to the following person(s):

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