# EXHIBIT A

Personalized User Model LLP v. Google Inc. Doc. 431 Att. 1

Dockets.Justia.com

EMPLOYMENT AGREEMENT

In consideration of my employment at SRI International, I agree:

1. To perform the duties assigned to me to the best of my ability, and to abide faithfully by SRI policies and practices.

2. To treat as confidential all results, intermediate and terminal, of SRI research activity in which I may participate or of which I may obtain knowledge during my employment, together with all formulae, specifications, secret processes, trade secrets, and such other confidential information belonging to SRI or its clients as may come to my knowledge in the course of or incidental to my employment, and that I shall at all times recognize and protect such property rights of SRI and its clients and not disclose same to unauthorized persons. Because much of the work done by SRI for the Government is classified, I am aware that my continued employment may depend on my ability to qualify for and to maintain an appropriate Government clearance. I also agree that I will not divulge to any unauthorized persons any classified information revealed to me during the period of my employment, and that all classified material received or generated by me will be handled in accordance with SRI Security Guide. I further warrant that to the best of my knowledge I do not at the time of my employment have in my possession, or under my control, any material which contains "CLASSIFIED INFORMATION" as defined in U.S. Government Industrial Security directives.

3. To promptly disclose to SRI all discoveries, improvements, and inventions, including software, conceived or made by me during the period of my employment, and I agree to execute such documents, disclose and deliver all information and data, and to do all things which may be necessary or in the opinion of SRI reasonably desirable, in order to effect transfer of ownership in or to impart a full understanding of such discoveries, improvements and inventions to SRI or to its nominee and to no other. I agree to comply with every reasonable request of SRI, its nominee, or the representative of either, for assistance in obtaining and enforcing patents. I understand that termination of this employment shall not release me from my obligations hereunder (as well as paragraph 2 above) provided, however, that time actually spent by me in discharging these obligations after termination of my employment shall be paid for by SRI at a reasonable rate. It is, of course, understood and agreed that I accept no responsibility for any out-of-pocket fees, costs, or expenses incurred or involved in the preparation, filing or prosecution of any application for patent or in the prosecution or defense of any litigation involving the same, and that I shall be reimbursed by SRI for any expense to which I may be put at the request of it or its nominee hereunder. This agreement does not apply to an invention which fully qualifies for the exclusion under Section 2870 of the California Labor Code which is reprinted on the reverse side of this agreement. However, all such inventions must be disclosed so that a determination can be made that they do in fact qualify for exclusion. All such disclosures will be treated as confidential.

4. That with respect to the subject matter thereof, this agreement covers my entire agreement with SRI, superseding any previous oral or written understandings or agreements with SRI or any representative thereof.

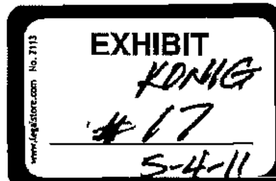
5. That my employment is not for any particular term and therefore this agreement is terminable, with immediate effect, at the will of either party.

Executed at Menlo Park, California this 8 day of April, 1996

Jernie Collins
Witness to Signature

Konig
Staff Member

Print Name: YOCHAI KONIG




By: [signature]
Human Resources, for SRI International

# CALIFORNIA STATE PATENT LAW

## Article 3.5
## Inventions Made by an Employee

§2870. Any provision in an employment agreement which provides that an employee shall assign or offer to assign any of his or her rights in an invention to his or her employer shall not apply to an invention for which no equipment, supplies, facility, or trade secret information of the employer was used and which was developed entirely on the employee's own time, and (a) which does not relate (1) to the business of the employer or (2) to the employer's actual or demonstrably anticipated research or development, or (b) which does not result from any work performed by the employee for the employer. Any provision which purports to apply to such an invention is to that extent against the public policy of this state and is to that extent void and unenforceable.

§2871. No employer shall require a provision made void and unenforceable by Section 2870 as a condition of employment or continued employment. Nothing in this article shall be construed to forbid or restrict the right of an employer to provide in contracts of employment for disclosure, provided that any such disclosures be received in confidence, of all of the employee's inventions made solely or jointly with others during the term of his or her employment, a review process by the employer to determine such issues as may arise, and for full title to certain patents and inventions to be in the United States, as required by contracts between the employer and the United States or any of its agencies.

§2872. If an employment agreement entered into after January 1, 1980, contains a provision requiring the employee to assign or offer to assign any of his or her rights in any invention to his or her employer, the employer must also, at the time the agreement is made, provide a written notification to the employee that the agreement does not apply to an invention which qualifies fully under the provisions of Section 2870. In any suit or action arising thereunder, the burden of proof shall be on the employee claiming the benefits of its provisions.

IF YOU HAVE ANY QUESTIONS ON THE ABOVE, PLEASE BE SURE THEY ARE ANSWERED BEFORE COMMENCING EMPLOYMENT.

# EXHIBIT B

THIS EXHIBIT HAS BEEN
REDACTED IN ITS ENTIRETY

# EXHIBIT C

THIS EXHIBIT HAS BEEN
REDACTED IN ITS ENTIRETY

# EXHIBIT D

THIS EXHIBIT HAS BEEN
REDACTED IN ITS ENTIRETY

# EXHIBIT E

THIS EXHIBIT HAS BEEN
REDACTED IN ITS ENTIRETY

# EXHIBIT F

# THIS EXHIBIT HAS BEEN REDACTED IN ITS ENTIRETY

# EXHIBIT G

**PURCHASE AGREEMENT**

This PURCHASE AGREEMENT (the "**Agreement**") is entered into by and between Google Inc., a Delaware corporation with its principal place of business at 1600 Amphitheatre Parkway, Mountain View, CA 94043 ("**Google**") and SRI International, with its principal place of business at 333 Ravenswood Avenue, Menlo Park, CA 94025 ("**Seller**") and is effective as of January 18, 2011 (the "**Effective Date**"). The parties hereby agree as follows:

## 1. BACKGROUND

1.1 Yochai Konig appears as a named inventor on U.S. Patent Nos. 6,981,040; 7,320,031; and 7,685,276 (each entitled "Automatic, Personalized Online Information and Product Services") (the "**Patents**").

1.2 Seller wishes to sell to Google any rights it has in the Patents, including with respect to any related foreign patents, reissues, reexaminations, continuations, continuations-in-part, or divisionals (the "**Patent Rights**").

1.3 Google wishes to purchase the Patent Rights.

## 2. DEFINITIONS

"**SRI Affiliate**" and "**Google Affiliate**" means any entity in whatever country organized, that controls, is controlled by or is under common control of SRI or Google respectively. The term "control" means possession, direct or indirect, of the power to direct or cause the direction of the management and policies of an entity, whether through the ownership of voting securities, by contract or otherwise.

"**SRI Partners**" means all SRI and/or SRI Affiliates, agents, representatives, suppliers, distributors, customers, advertisers, users, spin-offs and licensees.

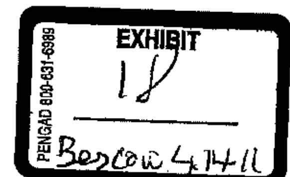
"**Google Partners**" means all Google and/or Google Affiliates, agents, representatives, suppliers, distributors, customers, advertisers and users.

## 3. PAYMENT

Payment. Google shall pay a one-time fee to Seller of $40,000 (the "**Payment**"). Google shall pay the one-time fee in a single payment within thirty business days of the Effective Date. This amount is the total compensation payable to Seller for rights granted in this Agreement, and no additional payment will be made by Google. Seller will be responsible for any duties, taxes, levies to which it is subject as a result of the Payment hereunder and Google shall not be liable at any time for any of Seller's taxes incurred in connection with or related to amounts paid under this Agreement. Payment shall be made by wire transfer to:

Wells Fargo Bank
400 Hamilton Avenue
Palo Alto, CA 94301
ABA# 121000248
For credit to the account of:
SRI International
Account # 4801-913435
Swift Code # WFBIUS6S





## 4. TRANSFER OF PATENT RIGHTS

4.1 Assignment of Patent Rights. Upon the Effective Date, Seller hereby sells, assigns, transfers, and conveys to Google, or shall have caused any SRI Affiliates to sell, assign, transfer and convey to Google the Patent Rights to which Seller has an interest, vested or otherwise. Such transfer includes, but is not necessarily limited to, any perfected or unperfected claims of ownership that Seller may have in the Patents.

4.2 Assignment of Additional Rights. Upon the Effective Date, Seller, to the extent that it has such right, title and interest, hereby also sells, assigns, transfers, and conveys to Google, or shall cause any SRI Affiliates to sell, assign, transfer and convey to Google, all its right, title and interest in and to all:

(a) inventions, invention disclosures, and discoveries described in any of the Patents to the extent that such inventions, invention disclosures and discoveries could be claimed in any patent or patent application (including reexaminations or reissues) claiming priority to any of the Patents.;

(b) rights to apply in any or all countries of the world for patents, certificates of invention and utility models claiming any inventions, invention disclosures, and discoveries described in any of the Patents to the extent that such inventions, invention disclosures and discoveries could be claimed in any patent or patent application (including reexaminations or reissues) claiming priority to any of the Patents.;

(c) causes of action (whether known or unknown or whether currently pending, filed, or otherwise) and other enforcement rights under, or on account of, any of the Patents and/or the rights described in Section 4.2(b), including, without limitation, all causes of action and other enforcement rights for (i) damages, (ii) injunctive relief, and (iii) any other remedies of any kind for past, current and future infringement; and (iv) rights to collect royalties or other payments under or on account of any of the Patents and/or any of the foregoing (excluding any Bayh-Dole rights under Section 4.3).

4.3 Existing Licenses. The transfers of the rights pursuant to Section 4.1 and 4.2 are subject to any rights relevant to the United States Government pursuant to Seller's obligations with respect to the Bayh-Dole Act. Other than such rights, Google will not assume the obligations under any existing licenses of, and covenants not to sue on, the Patents, and, for the avoidance of doubt, such existing licensing agreements and rights resulting from such agreements (including but not limited to royalties payable under such agreements) shall not be transferred to Google under this Agreement.

## 5. RELEASE

In consideration of the transfer of Patent Rights by Seller to Google and the Payment described in Section 3 above, the Seller releases any claims against Google as follows:

5.1 Seller and any SRI Affiliates hereby release and discharge Google, Google Affiliates, Google Partners, and their respective officers, directors, employees, agents, representatives, predecessors, successors, assigns and transferees from any and all claims, demands, damages, debts, liabilities, actions, causes of actions or suits of whatever kind or nature, asserted or not asserted, known or unknown, relating to the Patents, including, but not limited to the claims asserted in the Delaware Action (as that term is defined below).

5.2 With respect to the releases above, the parties hereby expressly waive and relinquish any and all rights under Section 1542 of the California Civil Code, which provides as follows:

> "A general release does not extend to claims which the creditor does not now know or suspect to exist in his or her favor at the time of executing



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the release, which, if known to him or her, must have materially affected his or her settlement with the debtor."

## 6. ADDITIONAL OBLIGATIONS AND CONSIDERATIONS

6.1 Further Cooperation. Seller understands that Google is currently involved in a patent infringement action brought by Personalized User Model, LLP currently pending in the Federal District Court of Delaware (Case No. 1:09-cv-525) (the "**Delaware Action**") involving the Patents. Seller further understands that Google and its outside attorneys in this matter may need to resort to litigation (either as part of the Delaware Action or otherwise) in order to perfect an interest in the Patents. Seller agrees that it will provide any and all reasonable support to Google in such actions, including voluntarily providing to Google any documentation and percipient (but not expert) witness testimony, including at trial, as reasonably necessary to support the defense of the Delaware Action.

6.2 Google Reimbursement. Google agrees that it will reimburse Seller for such support at Seller's usual and customary rates to the extent that such expenses are discussed by the Parties in advance of performance and to the extent permitted by law and consistent with local practice in the jurisdiction. Such reimbursement shall be made by Google within thirty (30) days of Google's receipt of SRI's invoices, which shall be provided to Google on no less than a quarterly basis.

6.3 Conduct. Except as required by law, Seller shall not engage in any act or conduct the result of which would invalidate any portion of any of the Patents or render any portion of them unenforceable or would abrogate or diminish Google's ability to perfect or enjoy an interest in the Patents.

6.4 Retained License. To the extent that it has or perfects right, title and interest in the Patents, Google grants SRI and SRI Affiliates a world-wide, non-exclusive, fully paid up and irrevocable license to make, have made, use, sell, offer to sell, export, import, and otherwise practice and/or have practiced all claims of the Patents. The license granted herein extends to all SRI Partners, but only to the extent their activities reasonably relate to their association with SRI.

## 7. SELLER'S OPTION

7.1 Option. Seller retains the right to purchase Google's interest in the Patents granted herein (the "Option"). Such Option is exercisable by the Seller any time after the final, non-appealable adjudication of the Delaware Action and any related actions and in no event within three years of the Effective Date. Seller shall give sixty days notice to Google prior to exercising the Option. The right to exercise the Option expires on December 31, 2022.

7.2 Exercise Price. To exercise the Option, Seller will notify Google and will pay Google $50,000 (the "**Option Payment**") per wire instructions to be provided by Google. Google will be responsible for any duties, taxes, levies to which it is subject as a result of the Option Payment hereunder and Seller shall not be liable at any time for any of Google's taxes incurred in connection with or related to amounts paid under this Agreement. Notice to Google shall be mailed to:

Google Inc.
Legal Department
John LaBarre
1600 Amphitheatre Parkway
Mountain View, CA 94043

or submitted via email at:



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jlabarre@google.com with a cc to legal@google.com

7.3 Retained License. Seller grants Google and Google Affiliates a world-wide, non-exclusive, fully paid up and irrevocable license under the Patents to make, have made, use, sell, offer to sell, export, import, and otherwise practice and/or have practiced all claims of the Patents in the event that Seller exercises its Option. The license granted herein extends to all Google Partners, but only to the extent their activities relate to a former, current or future Google and/or Google Affiliate product, service and/or website. Except as expressly set forth herein, no license to any other SRI patents or other intellectual property is granted by Seller, by implication, estoppel or otherwise.

## 8. REPRESENTATIONS AND WARRANTIES

Seller hereby represents and warrants to Google as follows that, as of the date this Agreement is entered into and as of the Effective Date:

8.1 Authority. Seller is a company duly formed, validly existing, and in good standing under the laws of the jurisdiction of its formation. Seller has the full power and authority and has obtained all third party consents, approvals, and/or other authorizations required to enter into this Agreement and to carry out its obligations hereunder, including, without limitation, the assignment of the Patent Rights to Google.

8.2 No Prior Agreements. Seller warrants that prior to the Effective Date, it has entered into no agreements with other parties that would affect its ability to transfer the Patent Rights to Google.

8.3 No Retained Rights. After the Effective Date, neither of Seller nor any SRI Affiliate will retain any rights or interest in the Patent Rights, except as otherwise provided for herein, and that all such rights and interest, to the extent possessed by Seller, will pass to Google.

8.4 No Known Litigation. Seller warrants that it is unaware of any prior or current causes of action (save for the Delaware Action) relating to the Patents and the Patent Rights.

Google hereby acknowledges that, as of the date this Agreement is entered into and as of the Effective Date:

8.5 Rights are Speculative. Google acknowledges that Seller's rights and interest in the Patents are speculative and that Seller provides no representations or warranties with respect to Google's ability to perfect such rights and interests.

## 9. MISCELLANEOUS

9.1 Disclaimer of Representations and Warranties. NEITHER PARTY MAKES ANY REPRESENTATION OR WARRANTY EXCEPT FOR THEIR RESPECTIVE REPRESENTATIONS AND WARRANTIES SET FORTH IN SECTION 8, AND EACH PARTY DISCLAIMS ALL IMPLIED WARRANTIES, INCLUDING, WITHOUT LIMITATION, THE IMPLIED WARRANTIES OF MERCHANTABILITY AND FITNESS FOR A PARTICULAR PURPOSE.

9.2 Limitation of Liability. NEITHER PARTY'S TOTAL LIABILITY UNDER THIS AGREEMENT WILL EXCEED THE PURCHASE PRICE SET FORTH IN SECTION 3.3. THE PARTIES ACKNOWLEDGE THAT THE LIMITATIONS ON POTENTIAL LIABILITIES SET FORTH IN THIS SECTION 9.2 WERE AN ESSENTIAL ELEMENT IN SETTING CONSIDERATION UNDER THIS AGREEMENT.

9.3 Limitation on Consequential Damages. NEITHER PARTY WILL HAVE ANY OBLIGATION OR LIABILITY (WHETHER IN CONTRACT, WARRANTY, TORT (INCLUDING



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NEGLIGENCE) OR OTHERWISE, AND NOTWITHSTANDING ANY FAULT, NEGLIGENCE (WHETHER ACTIVE, PASSIVE OR IMPUTED), REPRESENTATION, STRICT LIABILITY OR PRODUCT LIABILITY), FOR COVER OR FOR ANY INCIDENTAL, INDIRECT, CONSEQUENTIAL, MULTIPLIED, PUNITIVE, SPECIAL, OR EXEMPLARY DAMAGES OR LOSS OF REVENUE, PROFIT, SAVINGS OR BUSINESS ARISING FROM OR OTHERWISE RELATED TO THIS AGREEMENT, EVEN IF A PARTY OR ITS REPRESENTATIVES HAVE BEEN ADVISED OF THE POSSIBILITY OF SUCH DAMAGES. THE PARTIES ACKNOWLEDGE THAT THESE EXCLUSIONS OF POTENTIAL DAMAGES WERE AN ESSENTIAL ELEMENT IN SETTING CONSIDERATION UNDER THIS AGREEMENT.

9.4 Compliance With Laws. Notwithstanding anything contained in this Agreement to the contrary, the obligations of the parties with respect to the consummation of the transactions contemplated by this Agreement shall be subject to all laws, present and future, of any government having jurisdiction over the parties and this transaction, and to orders, regulations, directions or requests of any such government.

9.5 Confidentiality of Terms. The parties hereto will keep the terms and existence of this Agreement and the identities of the parties hereto and their Affiliates confidential and will not now or hereafter divulge any of this information to any third party except (a) with the prior written consent of the other party; (b) as otherwise may be required by law or legal process, including, without limitation, in confidence to legal and financial advisors in their capacity of advising a party in such matters; (c) during the course of litigation, including in connection with the Delaware Action, so long as the disclosure of such terms and conditions is restricted in the same manner as is the confidential information of other litigating parties; (d) in confidence to its legal counsel, accountants, insurers, indemnitors, indemnitees, banks and financing sources and their advisors solely in connection with complying with its obligations under this Agreement; (e) by Google, in order to perfect Google's interest in the Patents with any governmental patent office; or (f) to enforce Google's right, title, and interest in and to the Patents. Without limiting the foregoing, Seller will cause its agents involved in this transaction to abide by the terms of this Section, including, without limitation, ensuring that such agents do not disclose or otherwise publicize the existence of this transaction with actual or potential clients in marketing materials, or industry conferences.

9.6 Governing Law; Venue/Jurisdiction. This Agreement will be interpreted, construed, and enforced in all respects in accordance with the laws of the State of California, without reference to its choice of law principles to the contrary. Seller irrevocably consents to the jurisdiction and venue of the courts identified in the preceding sentence in connection with any action, suit, proceeding, or claim arising under or by reason of this Agreement.

9.7 Relationship of Parties. The parties hereto are independent contractors. Nothing in this Agreement will be construed to create a partnership, joint venture, franchise, fiduciary, employment or agency relationship between the parties. Neither party has any express or implied authority to assume or create any obligations on behalf of the other or to bind the other to any contract, agreement or undertaking with any third party.

9.8 Voluntary. The Parties execute this Agreement freely and voluntarily and without acting under any duress or in reliance upon any threat made by or on behalf of the other Party. Each Party has consulted with or has had an opportunity to consult with counsel of its own choice about the legal effect of entering into this Agreement.

9.9 Remedies. Seller's sole and exclusive remedy in the event of any claim, dispute, or controversy under this Agreement will be the recovery of money damages, subject to the disclaimer and limitations set forth in this Agreement, including, without limitation, those in Sections 9.1 through 9.3.



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9.10 Severability. If any provision of this Agreement is found to be invalid or unenforceable, then the remainder of this Agreement will have full force and effect, and the invalid provision will be modified, or partially enforced, to the maximum extent permitted to effectuate the original objective.

9.11 Waiver. Failure by either party to enforce any term of this Agreement will not be deemed a waiver of future enforcement of that or any other term in this Agreement or any other agreement that may be in place between the parties.

9.12 Miscellaneous. This Agreement, including its exhibits, constitutes the entire agreement between the parties with respect to the subject matter hereof and merges and supersedes all prior agreements, understandings, negotiations, and discussions. Neither of the parties will be bound by any conditions, definitions, warranties, understandings, or representations with respect to the subject matter hereof other than as expressly provided herein. The section headings contained in this Agreement are for reference purposes only and will not affect in any way the meaning or interpretation of this Agreement. This Agreement is not intended to confer any right or benefit on any third party (including, but not limited to, any employee or beneficiary of any party), and no action may be commenced or prosecuted against a party by any third party claiming as a third-party beneficiary of this Agreement or any of the transactions contemplated by this Agreement. No oral explanation or oral information by either party hereto will alter the meaning or interpretation of this Agreement. No amendments or modifications will be effective unless in a writing signed by authorized representatives of both parties. The terms and conditions of this Agreement will prevail notwithstanding any different, conflicting or additional terms and conditions that may appear on any letter, email or other communication or other writing not expressly incorporated into this Agreement.

9.13 Counterparts. This Agreement may be executed in counterparts, each of which will be deemed an original, and all of which together constitute one and the same instrument.

In witness whereof, intending to be legally bound, the parties have executed this Patent Purchase Agreement as of the execution date set forth below.

| SELLER: | GOOGLE: |
|---|---|
| By: ______________________ | By: |
| Name: ______________________ | Name: Tim Alger |
| Title: ______________________ | Title: Deputy General Counsel |



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9.10 Severability. If any provision of this Agreement is found to be invalid or unenforceable, then the remainder of this Agreement will have full force and effect, and the invalid provision will be modified, or partially enforced, to the maximum extent permitted to effectuate the original objective.

9.11 Waiver. Failure by either party to enforce any term of this Agreement will not be deemed a waiver of future enforcement of that or any other term in this Agreement or any other agreement that may be in place between the parties.

9.12 Miscellaneous. This Agreement, including its exhibits, constitutes the entire agreement between the parties with respect to the subject matter hereof and merges and supersedes all prior agreements, understandings, negotiations, and discussions. Neither of the parties will be bound by any conditions, definitions, warranties, understandings, or representations with respect to the subject matter hereof other than as expressly provided herein. The section headings contained in this Agreement are for reference purposes only and will not affect in any way the meaning or interpretation of this Agreement. This Agreement is not intended to confer any right or benefit on any third party (including, but not limited to, any employee or beneficiary of any party), and no action may be commenced or prosecuted against a party by any third party claiming as a third-party beneficiary of this Agreement or any of the transactions contemplated by this Agreement. No oral explanation or oral information by either party hereto will alter the meaning or interpretation of this Agreement. No amendments or modifications will be effective unless in a writing signed by authorized representatives of both parties. The terms and conditions of this Agreement will prevail notwithstanding any different, conflicting or additional terms and conditions that may appear on any letter, email or other communication or other writing not expressly incorporated into this Agreement.

9.13 Counterparts. This Agreement may be executed in counterparts, each of which will be deemed an original, and all of which together constitute one and the same instrument.

In witness whereof, intending to be legally bound, the parties have executed this Patent Purchase Agreement as of the execution date set forth below.

SELLER:

By:

Name: John McIntire

Title: Deputy General Counsel

GOOGLE:

By:

Name: Tim Alger

Title: Deputy General Counsel



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# EXHIBIT H

## Andrea P Roberts

| | |
|---|---|
| **From:** | Andrea P Roberts |
| **Sent:** | Thursday, January 27, 2011 5:45 PM |
| **To:** | Bennett, Jennifer D. |
| **Cc:** | Google-PUM; Horwitz, Richard L.; Moore, David E. |
| **Subject:** | RE: PUM v. Google |
| **Attachments:** | 3926712_Google Amended Answer and Ownership Counterclaims.doc |

Jennifer,

Attached is a draft of the amended answer for your review. There are a few cite holes to be filled in, but that should not affect your review. Please promptly let us know whether PUM will consent to the filing of the attached.

Thanks,

Andrea

**Andrea Pallios Roberts**
Quinn Emanuel Urquhart & Sullivan, LLP

555 Twin Dolphin Drive, 5th Floor
Redwood Shores, CA 94065
650-801-5023 Direct
650.801.5000 Main Office Number
650.801.5100 FAX
andreaproberts@quinnemanuel.com
www.quinnemanuel.com

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**From:** Bennett, Jennifer D. [mailto:jennifer.bennett@snrdenton.com]
**Sent:** Thursday, January 20, 2011 7:28 PM
**To:** Eugene Novikov
**Cc:** Google-PUM
**Subject:** PUM v. Google

Gene-

Please see the attached correspondence.

Thanks,

Jennifer D. Bennett
Managing Associate
SNR Denton US LLP
D +1 650 798 0325
jennifer.bennett@snrdenton.com
snrdenton.com

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# EXHIBIT I

THIS EXHIBIT HAS BEEN REDACTED IN ITS ENTIRETY

# EXHIBIT J

**THIS EXHIBIT HAS BEEN REDACTED IN ITS ENTIRETY**

# EXHIBIT K

THIS EXHIBIT HAS BEEN
REDACTED IN ITS ENTIRETY

# EXHIBIT L

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

| | | |
|---|---|---|
| PERSONALIZED USER MODEL, L.L.P., | ) | C.A. No. 09-525 (LPS) |
| Plaintiff, | ) | |
| v. | ) | |
| GOOGLE, INC., | ) | |
| Defendant. | ) | |

**PLAINTIFF PERSONALIZED USER MODEL, L.L.P.'S THIRTEENTH SUPPLEMENTAL RESPONSES TO DEFENDANT GOOGLE, INC.'S FIRST SET OF INTERROGATORIES (NO. 1)**

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure and the Local Rules of the District of Delaware, Plaintiff Personalized User Model, L.L.P. ("P.U.M.") provides its thirteenth supplemental responses to Defendant Google, Inc.'s ("Google" or "Defendant") First Set of Interrogatories to Plaintiff (No. 1) as follows:

## GENERAL OBJECTIONS

1. P.U.M. incorporates by references its General Objections to Google's First Set of Interrogatories (Nos. 1-16).

## SPECIFIC RESPONSES AND OBJECTIONS TO INTERROGATORIES

### INTERROGATORY NO. 1:

For each claim of the PATENTS-IN-SUIT, describe in detail all facts RELATING TO its conception and reduction to practice, including IDENTIFYING the date of conception, the date of reduction to practice of its subject matter, all acts YOU contend represent diligence occurring between the dates of conception and reduction to practice, each person involved in such conception, diligence and/or reduction to practice, where the invention was first reduced to practice, when, where, and to whom the invention was first disclosed, and IDENTIFYING each person, including third parties, who worked on the development of the alleged invention(s) described and claimed in the PATENTS-IN-SUIT, describing each person's role (e.g., producer, developer, tester, technician, researcher, etc.) and the dates and places each such person assisted, supervised, or was otherwise so involved.

**RESPONSE TO INTERROGATORY NO. 1:**

In addition to the foregoing general objections, P.U.M. specifically objects to this interrogatory as compound. P.U.M. further objects to this interrogatory as overly burdensome. Specifically, the patents-in-suit are presumed valid. Google has not at this time presented any evidence of anticipation such that would require that P.U.M. establish diligence between conception and reduction to practice. P.U.M. additionally objects to this interrogatory to the extent that it seeks a legal conclusion regarding the dates of "conception" and "reduction to practice," which are terms with specific legal meanings.

Subject to and without waiving the foregoing general or specific objections, P.U.M. responds that, pursuant to Fed. R. Civ. P. 33(d), P.U.M. will produce relevant non-privileged documents relating to the discovery and development of the inventions claimed in the patents-in-suit from which the information sought may be obtained. P.U.M. further identifies Messrs. Yochai Konig, Roy Twersky and Michael Berthold as individuals who conceived and worked on the development of the invention(s) described and claimed in the patents-in-suit. P.U.M. also responds that its investigation into the facts of this case is ongoing and P.U.M., accordingly, reserves its right to supplement its response to this interrogatory as discovery moves forward.

**FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 1:**

P.U.M. incorporates by references its general and specific objections set forth above. Subject to and without waiving the foregoing general and specific objections, P.U.M. further responds that the inventions claimed in the patents-in-suit were conceived no later than September 1999, based on privileged communications between the inventors and prosecuting counsel at Lumen, including, for example, the documents logged on the P.U.M. privilege log as PRIV 1, 7, 8, 959, 961, 962, 963, and 964.

Additionally, a provisional patent application was notarized in approximately early November of 1999. P.U.M. has been attempting to locate such notarized application and, to date, has been unable to locate such application. P.U.M. is continuing to search for the notarized

application and upon finding the notarized application will produce such notarized application and further supplement its response to this interrogatory.

Accordingly, P.U.M. specifically reserves its right to supplement this Interrogatory Response.

**SECOND SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 1:**

P.U.M. incorporates by references its General and Specific objections set forth above. Subject to and without waiving the foregoing general and specific objections, P.U.M. further responds that the inventions claimed in the patents-in-suit were conceived and/or reduced to practice by Roy Twersky and Yochai Konig no later than July 1999. The conception and reduction to practice of the patented invention are reflected in documents that have been produced to date, including by way of example but not limited to PUM 0000036, PUM 0000038, PUM 0000053, PUM 0000399, PUM 0002015, PUM 0002170, PUM 0042165, PUM 0042214, PUM 0042236, PUM 0042249, PUM 0042264, PUM 0042280, PUM 0042291, PUM 0042304, PUM 0042430, PUM 0069910, PUM 0069912, PUM 0080456, PUM 0082289, PUM 0085334, PUM 0085351, and PUM 0085365. These produced documents also evidence the subsequent development, diligence in reducing to practice, and reduction to practice of the inventions claimed by the patents-in-suit and the involvement of Roy Twersky, Yochai Konig, and Michael Berthold therein. The conception, subsequent development, diligence in reducing to practice, and reduction to practice of the inventions claimed in the patents-in-suit are further evidenced in privileged communications between the inventors and prosecuting counsel at Lumen, including, for example, the documents logged on the P.U.M. privilege log as PRIV 1, 7, 8, 959, 961, 962, 963, and 964.

Michael Berthold contacted Utopy about a position as an applied machine learning and statistical pattern recognition expert with the company in December 1999 and was offered a position with Utopy in January 2000. While with Utopy, Michael Berthold developed, among other things, various clustering algorithms, topic classifier algorithms, and product feature elements, some of which were incorporated into the patented invention no later than March 2000.

Michael Berthold's contribution to the patented invention and role with Utopy are reflected in the documents produced to date, including, but not limited to PUM 0000059, PUM 0069541, PUM 0069524, PUM 0069910, PUM 0069912, PUM 0071470, PUM 0071471, PUM 0074617, PUM 0074619, PUM 0074553, PUM 0074554, PUM 0074619, PUM 0074892, PUM 0075013, PUM 0077775, PUM 0077852, PUM 0078960, PUM 0078961, PUM 0079011, PUM 0080445, PUM 0080455, PUM 0080456, PUM 0085750, PUM 0085770, and PUM 0086383.

Thomas J. ("Tom") McFarlane worked as a patent agent at the Lumen Patent Firm ("Lumen") in 1999 and 2000. Mr. McFarlane reviewed the preliminary disclosure provided to Lumen by Roy Twersky and Yochai Konig in September 1999 and advised them on the contents of patent applications, generally. At that time, Mr. McFarlane also forwarded to Yochai Konig and Roy Twersky a list of prior art references which were later disclosed in an Information Disclosure Statement. Employees of Utopy, including, but not limited to Baruch Katz, Dudi (David) Konig, Yochai Konig, Roy Twersky, Michael Berthold, Guy Ray, Onn Brandman, Ernan Guelman, Ron Harlev, Yoav Banin, Eran Amit, and Michael Elbaz participated in reducing to practice the invention claimed in the patents-in-suit beginning no later than September 1999. In addition to the documents referenced above, documents further evidencing Utopy's reduction to practice have been produced and include, without limitation, BERTHOLD 000001, BERTHOLD 000035, BERTHOLD 000041, BERTHOLD 000042, BERTHOLD 000050, PUM 0000011, PUM 0000026, PUM 0000128, PUM 0000251, PUM 0000384, PUM 0069935, PUM 0069940, PUM 0078960, PUM 0078961, PUM 0085333, and PUM 0082289.

Additionally, a provisional patent application constituting constructive reduction to practice was notarized in approximately early November of 1999. P.U.M. has been attempting to locate such notarized application and, to date, has been unable to locate such application. P.U.M. is continuing to search for the notarized application and upon finding the notarized application will produce such notarized application and further supplement its response to this interrogatory.

Accordingly, P.U.M. specifically reserves its right to supplement this Interrogatory Response.

**THIRD SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 1:**

P.U.M. incorporates by references its General and Specific objections set forth above. Subject to and without waiving the foregoing general and specific objections, P.U.M. further responds that the inventions claimed in the patents-in-suit were conceived and/or reduced to practice by Roy Twersky and Yochai Konig no later than July 1999. The conception and reduction to practice of the patented invention are reflected in documents that have been produced to date, including by way of example but not limited to PUM 0042214, which was created July 13 1999 and modified July 15, 1999; PUM0042165, which was created July 13, 1999 and modified August 10, 2009; and PUM0086523, which is an email from Yochai Konig to Roy Twersky, dated September 21, 1999, with PUM0091543-54 attached. The attachment led to the filing of the provisional application.

Accordingly, P.U.M. specifically reserves its right to supplement this Interrogatory Response.

**FOURTH SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 1:**

P.U.M. incorporates by references its General and Specific objections set forth above. Subject to and without waiving the foregoing general and specific objections, P.U.M. further responds that the inventions claimed in the patents-in-suit were conceived by Roy Twersky and Yochai Konig in September 1999, as PUM contended in its First Supplemental Response above. By September 1999, as demonstrated by PUM0091543-54, which is an attachment to an email dated September 21, 1999 (PUM0086523), the inventions disclosed in at least claims 1, 4-5, 7-8, 11-12, 16-18, 23-24, 32, 35-36, 38-39, 42-43, 47-49 and 54-55 of the '040 patent, and claims 1-4, 12-13, 21 and 23 of the '276 patent were definite and permanent ideas which were sufficiently clear to enable one of skilled in the art to reduce the invention to practice.

PUM's previous two supplemental responses indicated a July 1999 conception date. Upon further review of the two power point documents (PUM 0042214 and PUM 0042165)

previously relied upon for the July 1999 conception date, Messrs. Twersky and Konig determined that the invention(s) were not yet conceived as definite and permanent ideas which were sufficiently clear to enable one of skilled in the art to reduce the invention to practice in July 1999. The September conception date is further supported by the deposition testimony of Yochai Konig, including, at least testimony found at 57:4-61:24; 71:10-72:9; 151:4-152:7; 155:12-156:3; 189:20-191:6: 200:1-205:12. Further, PUM 0092036, a recently opened password protected document dated October 16, 1999, describes the early prototyping of Utopy's embodiment of the claimed invention(s), corroborating Mr. Konig's testimony that the invention(s) were conceived in the timeframe described in Mr. Konig's deposition. PUM further states that the inventions disclosed in claims 9-10, 13-15 of the '040 patent and claims 7-11, and 25-26 of the '276 patent were conceived by Roy Twersky, Yochai Konig and Michael Berthold by March 2000.

The subsequent diligence in reducing to practice and reduction to practice of the patented invention(s) are reflected in documents that have been produced to date, including by way of example but not limited to PUM 0092036. Additional documents supporting diligence in reducing to practice and reduction to practice are: BERTHOLD 000001, BERTHOLD 000035, BERTHOLD 000041, BERTHOLD 000042, BERTHOLD 000050, PUM 0000011, PUM 0000026, , PUM 0000036, PUM 0000038, PUM 0000053, PUM 0000059, PUM 0000128, PUM 0000251, PUM 0000384, PUM 0000399, PUM 0002015, PUM 0002170, PUM 0041825, PUM 0041854, PUM 0042165, PUM 0042214, PUM 0042236, PUM 0042249, PUM 0042264, PUM 0042280, PUM 0042291, PUM 0042304, PUM 0042430, PUM 0069541, PUM 0069524, PUM 0069910, PUM 0069912, PUM 0069935, PUM 0069940, PUM 0071470, PUM 0071471, PUM 0074617, PUM 0074619, PUM 0074553, PUM 0074554, PUM 0074619, PUM 0074892, PUM 0075013, PUM 0077775, PUM 0077852, PUM 0078960, PUM 0078961, PUM 0079011, PUM 0080445, PUM 0080455, PUM 0080456, PUM 0085750, PUM 0082289, PUM 0085333, PUM 0085334, PUM 0085351, PUM 0085365, and PUM 0085770. Employees and/or consultants of Utopy, including, but not limited to Baruch Katz, Dudi (David) Konig, Yochai Konig, Roy

Twersky, Michael Berthold, Guy Ray, Onn Brandman, Ernan Guelman, Ron Harlev, Yoav Banin, Eran Amit, and Michael Elbaz participated in reducing to practice the invention claimed in the patents-in-suit beginning no later than September 1999.

Dated: February 8, 2011

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February 8, 2011

# EXHIBIT M

THIS EXHIBIT HAS BEEN
REDACTED IN ITS ENTIRETY

# EXHIBIT N

1 IN THE UNITED STATES DISTRICT COURT
2 FOR THE DISTRICT OF DELAWARE
3
4 PERSONALIZED USER )
5 MODEL, LLP, )
6 Plaintiff, )
7 vs. ) CA number 09-525 (LPS)
8 GOOGLE, INC., )
9 Defendant. )
10 - - - - -
11 VIDEOTAPED DEPOSITION OF JAIME CARBONELL
12 WASHINGTON, D.C.
13 NOVEMBER 27, 2012
14 The videotaped deposition of JAIME CARBONELL was
15 convened on Tuesday, November 27, 2012,
16 commencing at 10:05, at the law offices of SNR
17 Denton, located at 1301 K Street, Northwest, in
18 Washington, D.C., before Paula G. Satkin,
19 Registered Professional Reporter and Notary
20 Public.
21 - - - - -
22
23
24
25 Job No. CS1565706

1 A. You can ignore the tool bar and
2 still use the computer in the same way and the
3 way you use a tool bar would be for something
4 that you normally would do, which is to initiate
5 a search in a normal way.
6 Q. Okay. So as long as you're using
7 some new addition in a way that's similar to
8 what you otherwise would do, that could still be
9 normal use?
10 A. If you use an addition to do
11 something in a way you normally would do any way
12 in the same manner, for example, typing words in
13 a search box, then I would consider that being
14 normal use. You don't have to learn to interact
15 with a computer differently or have something
16 that looks radically different than before that
17 is calling your attention to do something else
18 in the computer. When you have eyeballs popping
19 up on the screen and you have some links
20 flashing and you have did you like this tour or
21 did you like that tour better or did you not
22 like any of them that you have to answer before
23 you go on and do anything else, that is beyond
24 normal use.
25 Q. What if you have to sign in to

1 some interface? Is that the normal use of a
2 computer?
3 A. If you would normally have to sign
4 for that interface, do your other jobs, then
5 that would be normal use. If you're now giving
6 additional hurdles that you have to jump through
7 you go beyond normal use.
8 Q. Right. So, you know, Google you
9 can use without signing in; correct?
10 A. I use it without signing in.
11 Q. And are you aware you can sign in
12 and have an account with Google?
13 A. I am reminded constantly with
14 Google encouraging me to sign in when I don't
15 particularly want to.
16 Q. And if you did sign in and would
17 that no longer be the normal use of the
18 computer?
19 A. If I was signing in to do my usual
20 work and signing in was part of my routine, then
21 that would be normal use of a computer. If I am
22 required to sign in to get to some additional
23 functionality or get some additional things that
24 I normally don't do, then it would go beyond the
25 normal use of a computer.

1 Q. So in light of the prior art that
2 existed, how would you describe the innovation
3 in the patents at issue here?
4 MS. BENNETT: Objection. Form.
5 THE WITNESS: Well, the main
6 innovation is to customize or personalize the
7 search results to an individual user. And that
8 is being done by having monitored that user's
9 interaction over time, having monitored it
10 transparently, having built in the background
11 the user specific user model. That means a -- a
12 learning machine where the parameters are
13 estimated for that user based on that user's
14 interaction, based on the data that that user
15 has accessed based on what they have clicked,
16 based on what they have ignored, based on
17 anything they may have explicitly rejected or
18 not, as the case may be, and then providing more
19 appropriate, more relevant search results going
20 forward by using that user model to estimate the
21 probability that they would be interested in new
22 documents and using that to help rank or rather
23 rerank the search results.
24 BY MR. PERLSON:
25 Q. And is that your understanding

1 that would be the innovation of both of the
2 patents?
3 MS. BENNETT: Objection. Form.
4 THE WITNESS: In general terms.
5 Yes. It would also go beyond simply the
6 retrieved search pages. It could go to other
7 items the user might be interested in,
8 advertisements, for example.
9 BY MR. PERLSON:
10 Q. But the innovation is using these
11 various user models and user specific learning
12 machines in the context of search?
13 MS. BENNETT: Objection. Form.
14 THE WITNESS: That is the primary
15 innovation.
16 BY MR. PERLSON:
17 Q. Do you think that one of ordinary
18 skill in the art would have been able to reduce
19 the patents in suit to practice and actually
20 provide useful results in 1999?
21 MS. BENNETT: Objection. Form.
22 THE WITNESS: If that person had
23 access to a search engine as well, yes.
24 BY MR. PERLSON:
25 Q. What do you mean if that person

1 had access to a search engine as well?
2 A. The short answer is yes. I mean,
3 if building a search engine is a major
4 engineering endeavor. It would typically
5 require a team, rather than an individual. So
6 combining the engineering requirements for a
7 search engine with the full description of the
8 patents then, yes.
9 Q. Okay. The patents don't
10 themselves disclose how to build a search
11 engine?
12 A. They do not, but that was the
13 knowledge of how to build a search engine
14 pre-existed. Search engines keep getting better
15 all the time. Today search engines are better
16 than they were back then.
17 Q. So one of skill in the art would
18 have had the skill to build a search engine in
19 1999?
20 A. One of skill in the art -- how to
21 build a search engine was published by that
22 time. So the knowledge how to do it is clearly
23 there. Now, going from the knowledge of how to
24 do it to actually building it requires
25 significant effort. So it would have required

# EXHIBIT O

THIS EXHIBIT HAS BEEN REDACTED IN ITS ENTIRETY