

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

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

**PERSONALIZED USER MODEL, L.L.P.’S OPENING BRIEF IN SUPPORT
OF ITS MOTION TO STRIKE DR. JORDAN’S LATE-DISCLOSED OPINIONS**

OF COUNSEL:	MORRIS, NICHOLS, ARSHT & TUNNELL LLP
	Karen Jacobs Loudon (#2881)
	Jeremy A. Tigan (#5239)
Marc S. Friedman	1201 N. Market Street
SNR DENTON US LLP	P.O. Box 1347
1221 Avenue of the Americas	Wilmington, DE 19899-1347
New York, NY 10020-1089	(302) 658-9200
(212) 768-6700	klouden@mnat.com
	jtigan@mnat.com
Jennifer D. Bennett	<i>Attorneys for Personalized User Model, L.L.P.</i>
SNR DENTON US LLP	<i>and Yochai Konig</i>
1530 Page Mill Road, Ste. 200	
Palo Alto, CA 94304-1125	
(650) 798-0300	

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NATURE AND STAGE OF PROCEEDINGS

This patent infringement case was filed over three years ago and is now in its final stages before a liability trial. The Court has issued its Claim Construction Opinion and Order, fact and expert discovery is complete, and the parties are now briefing case dispositive motions. P.U.M. is filing this motion to strike contemporaneously therewith.¹

SUMMARY OF ARGUMENT

The Court should enter an order striking the new obviousness opinions advanced by Google's invalidity expert, Dr. Michael I. Jordan ("Dr. Jordan"), for the first time and at the tail-end of his deposition.

For the first six hours and 45 minutes of his deposition, Dr. Jordan testified unequivocally and repeatedly that for claims that he opined were anticipated, he did not have any opinion on obviousness. At the end of the day, when P.U.M.'s questioning was near complete, counsel took a break. Then when Google's counsel examined Dr. Jordan on redirect a few minutes later, he did a 180 degree about-face, testifying for the first time that **all** patent claims were invalid for obviousness as well as for anticipation. Dr. Jordan also testified about numerous new obviousness combinations.

When P.U.M.'s counsel asked Dr. Jordan where he disclosed these opinions in his expert report, he conceded he had not disclosed them. Instead, he asserted that they were somehow **implicitly disclosed** in an exhibit to his report that makes no mention of obviousness. Simply stated, the Jordan Report discloses no such opinions. Rather, that report clearly specifies that Dr. Jordan relied on an anticipation theory for certain claims of the asserted patents and

¹ P.U.M. reserves the right to move in limine to exclude other evidence, including a motion in limine to preclude Google from referencing the reexamination proceedings before the jury, in accordance with the deadlines to be set by the Court.

obviousness for others. In his report, Dr. Jordan also specifically identified the references on which he relied for each theory. For no claims did the report discuss both anticipation and obviousness or disclose the new obviousness combinations asserted for the first time at his deposition.

Because Google did not timely disclose Dr. Jordan's new opinions in his expert report as required by Fed. R. Civ. P. 26(a)(2)(B), and because such omissions are not substantially justified or harmless, Dr. Jordan's new obviousness opinions should be stricken under Fed. R. Civ. P. 37(c)(1).

STATEMENT OF FACTS

A. Dr. Jordan's April 11, 2012 Expert Report

Pursuant to Rule 26(a)(2)(B), on April 11, 2012, Google served the 198-page Report of Defendants' Expert Michael I. Jordan Concerning Invalidity ("Jordan Report") (Louden Decl. Ex. 1). On October 3, 2012, P.U.M. served the 207-page Rebuttal Expert Witness Report of Jaime G. Carbonell to respond to and rebut Dr. Jordan's opinions ("Carbonell Report"). Dr. Jordan was deposed regarding the contents of his expert report on November 7, 2012 (Louden Decl. Ex. 2).

The April 11, 2012 Jordan Report sets forth the basis for Dr. Jordan's opinion that the asserted claims of the patents-in-suit are invalid. Eighty-three of the 198 pages are dedicated to his discussion of how seven prior art references anticipate the asserted claims. Specifically, Dr. Jordan opines in paragraphs 130-314 of his expert report that each of seven references – Mladenic, Autonomy's Agentware, Montebello, Wasfi, Culliss, Refuah and Joachims – anticipate certain claims:

- (1) Mladenic and/or the Personal WebWatcher system anticipate claims 1, 11, 32 and 34 of the '040 Patent (but not claim 22 of the '040 Patent) and claims 1, 5,

6, 7, 21 and 22 of the '276 Patent (but not claim 3 of the '276 Patent) (Jordan Report, ¶¶ 125-160);

(2) Autonomy's Agentware anticipates claims 1, 11, 32 and 34 of the '040 Patent (but not claim 22 of the '040 Patent) and claims 1, 3, 7, 21 and 22 of the '276 Patent (but not claims 5 and 6 of the '276 Patent) (Id. ¶¶ 161-189);

(3) Montebello and PEA anticipate claims 1, 11, 32 and 34 of the '040 Patent (but not claim 22 of the '040 Patent) and claims 1, 6, 7, 21 and 22 of the '276 Patent (but not claims 3 and 5 of the '276 Patent) (Id. ¶¶ 190-216);

(4) Wasfi and ProfBuilfer anticipate claims 1, 22, 32 and 34 of the '040 Patent (but not claim 11 of the '040 Patent or any claim of the '276 Patent) (Id. ¶¶ 217-232);

(5) Culliss anticipates all claims of the '040 Patent and claims 1, 3, 6, 7, 21 and 22 of the '276 Patent (but not claim 5 of the '276 Patent) (Id. ¶¶ 233-259);

(6) Refuah anticipates all asserted claims of the '040 and '276 patents (Id. ¶¶ 260-286); and

(7) Joachims and WebWatcher anticipate claims 1, 11, 32 and 34 of the '040 Patent (but not claim 22 of the '040 Patent) and claims 1, 6, 7, 21 and 22 of the '276 Patent (but not claims 3 and 5 of the '276 Patent) (Id. ¶¶ 287-314).

The Jordan Report does not identify any alternative obviousness opinions for these claims. Nor does it identify any combination of prior art references for these claims or any motivation to combine them.

Beginning at page 145 of his report, Dr. Jordan then offers his opinion that the remaining asserted claims are invalid due to obviousness. Dr. Jordan prefaces his opinions by stating:

The discussion above demonstrated that the asserted claims are anticipated by one or more of Mladenic, Autonomy, Montebello, Wasfi, Culliss, and Refuah. To the extent that any of those references do not disclose limitations in the asserted claims, this section demonstrates that those limitations consist only of obvious applications of art known to one of ordinary skill, and thus the claims are invalid for obviousness in light of each reference. (Jordan Report, ¶ 315.)

Dr. Jordan then proceeds to discuss the remaining asserted claims which he states are obvious, and expressly identifies the specific obviousness combinations of prior art on which he relies. (See Jordan Report at ¶¶ 394-416.) Specifically, Dr. Jordan opines that:

- (1) Claim 22 of the '040 Patent and claim 3 of the '276 Patent are rendered obvious by Mladenec (Id. ¶¶ 394-396);
- (2) Claim 22 of the '040 Patent and claims 5 and 6 of the '276 Patent are rendered obvious by Autonomy's Agentware (Id. ¶¶ 397-398);
- (3) Claim 22 of the '040 Patent and claims 3 and 5 are rendered obvious by Montebello (Id. ¶¶ 399-401);
- (4) Claim 11 of the '040 Patent and every claim of the '276 Patent is rendered obvious by Wasfi (Id. ¶¶ 402-410);
- (5) Claim 5 of the '276 Patent is rendered obvious by Culliss (Id. ¶ 411); and
- (6) Claim 22 of the '040 Patent and claims 3 and 5 are rendered obvious by the '276 Patent (Id. ¶¶ 413-416).

The Jordan Report also states that “Mladenec anticipates all asserted claims of the '040 Patent except claim 22”, which contains additional elements that the report asserts were “explicit in Mladenec's follow-up conference paper, Machine Learning for Better Web Browsing”. (Id. ¶ 394.) It further alleges that “it would have been obvious to one of skill in the art to use Personal WebWatcher with a search engine, e.g., as disclosed in Montebello.” (Id. at ¶ 396.)

The Jordan Report then discloses the following four obviousness combinations that purportedly render two, and only two, asserted claims invalid. Dr. Jordan opines that:

- (1) Claim 3 of the '276 Patent is rendered obvious by Mladenec in view of Montebello, Culliss, or Schuetze (Id. ¶ 395);
- (2) Claim 3 of the '276 Patent is rendered obvious by Montebello in view of Mladenec, Culliss, or Schuetze (Id. ¶ 400);
- (3) Claim 3 of the '276 Patent is rendered obvious by Joachims and WebWatcher in view of Montebello, Culliss, or Schuetze (Id. ¶ 414); and

(4) Claim 21 of the '276 Patent is rendered obvious by Joachims in view of Mladenec (Id. ¶ 416).

No other obviousness combinations are identified in the Jordan Report.

B. Dr. Jordan's November 7, 2012 Deposition Testimony

Dr. Jordan was deposed on November 7, 2012. During his deposition, Dr. Jordan repeatedly and explicitly testified that for the claims for which he provided an anticipation opinion, he did not also have an obviousness opinion. For example²:

A: Anticipation, *you don't need a combination. It's there, period, end of story.* So for a claim that I view as anticipated, **I did not believe that I needed to state obviousness.** (See Jordan Transcript, Louden Decl. Ex. 2, at 258:3-6)

Q: Where is that described explicitly in your report, the written portion of your report?

A: Claim 1 for Wasfi was in my judgment anticipated, so I'm not -- ***I didn't discuss that claim in the obviousness section because it was anticipated.*** (Id. at 256:10-15)

Q: So just to be clear, then, for the claims that you assert are anticipated, for example, Claim 1 of the '040 Patent, are you not additionally asserting that Claim 1 of the '040 patent is obvious by Wasfi?

Q: I don't have enough legal expertise to understand that distinction. **I thought anticipation was stronger than obviousness, and so I am asserting anticipation.** (Id. at 257:5-14)

Q: So to be clear, where you found a claim was anticipated, you did not also form an opinion as to obviousness of that claim.

A: Okay. So, again, my understanding of the legal distinctions being made here is, and this could be incorrect, but I understood obviousness to have to do with combinations, and so anticipation is not -- and once anticipation is inserted [sic: asserted], ***it doesn't need to be combined with anything.*** It's already there. Okay? So I'm not making any additional insertions [sic: assertions]. (Id. at 259:7-20)

Q: And with respect to the '276 patents -- '276 patent --which claims do you believe to be anticipated by Culliss?

² Emphasis in the quoted material is added unless otherwise noted.

A: 1, 3, 6, 7, 21, and 22.

Q: And what claim do you believe is rendered obvious by Culliss?

A: I think the only one missing is claim 5. (Id. at 265:6-13)

Q: What is your opinion with respect to Refuah? Which claims in your opinion, of the '040 patent are anticipated by Refuah?

A: 1, 11, 22, 3, 34.

Q: Do you believe any of the claims of the '040 patent are rendered obvious by Refuah?

A: I don't believe there's anything missing on that list (Id. at 299:1-8)

Q: Which claims of the '276 patent do you believe are rendered obvious by Joachims?

A: Five--and, again, I'll have to go to my claim charts to do that. I guess five.

Q: It is also your opinion Claim 3 is rendered obvious by Joachims?

A: Let me check. Claim 5? Yes, in my opinion.

Q: And Claim 3?

A: And Claim 3.

Q: Any other claims of the '276 patent you believe are rendered obvious by Joachims?

A: I believe that's all of the claims of that patent. (Id. at 322:16-323:9);

Q: What claims do you believe are rendered obvious by Mladenic?

A: Let me see. I believe it's only 22 that's remaining. (Id. at 342:11-15, 345:7-13).

Q: What claims of the '040 do you opine Autonomy renders obvious?

A: 22 (Id. at 346:15-18)

Q: What claims of the '276 patent do you claim Autonomy renders obvious?

A: I guess it's 6- sorry. Five and six. (Id. at 347:8-13).

Dr. Jordan then abruptly changed his opinions that were contained in his report as well as in his testimony to this point. Near the end of the deposition, after P.U.M.'s questioning was almost complete, Google's counsel conferred with Dr. Jordan during a break. When they returned, on redirect with Google's counsel, obviously as a result of their conferring, Dr. Jordan then purported to recant the testimony he had just given and asserted that he **was in fact** offering opinions on obviousness as to claims that he contended were anticipated. (Id. at 373:4-19).

Dr. Jordan also purported to provide opinions at his deposition for obviousness combinations that were not disclosed in his expert report. By way of example, Dr. Jordan testified that claim 11 of the '040 Patent and all claims of the '276 Patent are rendered obvious by Wasfi in combination with Montebello. (Id. at 240:8-241:2.) There is no such disclosure in the Jordan Report. Dr. Jordan further testified that Wasfi could be combined with other prior art references, including Culliss, Refuah, Autonomy, and Schuetze. (Id. at 241:4-242:4.) Dr. Jordan could not identify where he had offered such an opinion in his expert report, however. (Id. at 242:5-10 ("BY MS. BENNETT: Q. And where do you opine that these things should be combined with Wasfi, and that it would be obvious to do so? A. Okay. I don't".)) Dr. Jordan then testified that his obviousness opinions were based on the combination of one of the seven identified primary references with existing search-engine technology known at the time. (Id. at 247:10-19 ("My general assertion is, is that profile-based machine-learning systems that could personalize selections of documents based on user interaction with documents, provided a general tool to be used to personalize search engines in general, and that was obvious as of 1999. So I would apply that across the board to the filtering-based systems like Wasfi that we're discussing here but others as well."); 248:3-4; 248:6-9; 248:18-19.) Again, Dr. Jordan was not able to identify any such disclosure in his report. In fact, Dr. Jordan admitted that his report did

not identify combinations of prior art references, but rather asserted obviousness based on the combination of a prior art reference with only the knowledge of one of ordinary skill in the art at the time.

Following the break with Google's counsel, Dr. Jordan contended that Exhibit 3 to his report **implicitly** disclosed such opinions. (Id. at 252:4-9.) When pushed, however, he was forced to concede that there was no explicit disclosure of such opinions.

Q. Where in the charts does it assert that these are combinations?

MS. ROBERTS: Objection to form.

THE WITNESS: It's not explicit -- certainly, it's implicit, so, for example -- *it's not explicit, it's implicit*. But I don't see the -- but they're combined, so if I go to -- we were talking about Wasfi before the break. So if I go to Exhibit 3D, here's Wasfi. And it describes Wasfi in terms of anticipation. (Id. at 252:10-253:19);

Q: And where do you state that you should combine Wasfi with these to render Claim 11 obvious? **Where is that explicit in the chart?**

A: I don't know. I didn't. (Id., 255:3-7).

Exhibit 3 provides no such disclosure. All Exhibit 3 provides is 157 pages of claim charts for each of the prior art references (Mladenic, Autonomy, Montebello, Wasfi, Culliss, Refuah and Joachims) on which Dr. Jordan relied for his anticipation opinions. The word "obviousness" is not mentioned in either the title or text of the charts. Further, the obviousness section in the Jordan Report states only that "Exhibit 3 is an element by element-by-element claim chart of each of the claims in this case with references to the prior art, and is incorporated into the body of this report."

Although some of the entries in the body of the charts in Exhibit 3 also list other references, the Jordan Report nowhere discloses that those other citations would be relied upon for obviousness purposes. Were this the case, these citations would amount to over 666

obviousness combinations. The body of the Jordan Report, however, only disclosed either an anticipation **or** an obviousness opinion for each of the asserted claims, and a select number of obviousness combinations for a subset of those claims.

ARGUMENT

Dr. Jordan's new obviousness opinions, disclosed for the first time in the last 15 minutes of two years of pretrial discovery, violates this Court's Scheduling Order (D.I. 363) and the Federal Rules of Civil Procedure, is without substantial justification, and prejudices P.U.M. at this late stage of the litigation. "In every trial there comes a time when discovery must be closed for issues to be resolved through summary judgment and/or trial." *Stambler v. RSA Sec., Inc.*, 21 F.R.D. 470, 472 (D. Del. 2003). For Google's invalidity opinions, that time was April 11, 2012.

I. APPLICABLE LEGAL STANDARDS

Federal Rule of Civil Procedure 26(a)(2)(B)(i) requires a testifying expert to prepare and sign a written report that contains, inter alia, "a complete statement of all opinions the witness will express and the basis and reasons for them" and "the facts or data considered by the witness in forming them." Rule 26(a)(2)(D) provides that "a party must make these [expert] disclosures at the time and in the sequence that the court orders."

Further, the Federal Rules of Civil Procedure provide an automatic exclusion sanction for failure to comply with discovery obligations. Pursuant to Rule 37(c)(1), the Court has the power to exclude evidence as a sanction for a party's failure to comply with its obligations under the rules, including the specific deadlines and obligations imposed by a scheduling order. In pertinent part, Rule 37(c)(1) provides that "[i]f a party fails to provide information or identify a witness as required by Rule 26(a) or (e), the party is not allowed to use

that information or witness to supply evidence on a motion, at a hearing, or at trial, unless the failure was substantially justified or is harmless.” Fed. R. Civ. P. 37(c)(1). The determination of whether to exclude evidence is committed to the discretion of the Court. See *Konstantopoulos v. Wesvaco Corp.*, 112 F.3d 710, 719 (3d Cir. 1997).

The exclusion of expert evidence is **automatic** under Rule 37(c)(1), Fed. R. Civ. P. for failure to disclose as required by Fed. R. Civ. P. 26(a) unless such failure is “harmless” or occurs with “substantial justification.” See, e.g., *ArthroCare Corp. v. Smith & Nephew, Inc.*, 310 F. Supp. 2d 638, 669 (D. Del. 2004), *aff’d in part, vacated in part, rev’d in part on other grounds*, 406 F.3d 1365 (Fed. Cir. 2005); *AMEX, LLC v. Mopex, Inc.*, 215 F.R.D. 87, 93 (S.D.N.Y. 2002). In determining whether a failure to disclose is harmless or substantially justified, the Third Circuit considers such factors as: (1) the importance of the information withheld; (2) the prejudice or surprise to the party against whom the evidence is offered; (3) the likelihood of disruption of the trial; (4) the possibility of curing the prejudice; (5) the explanation for the failure to disclose; and (6) the presence of bad faith or willfulness in not disclosing the evidence (the “Pennypack factors”). See *Konstantopoulos*, 112 F.3d at 719 (citing *Meyers v. Pennypack Woods Home Ownership Ass’n*, 559 F.2d 894, 904-05 (3d Cir. 1997); *Bridgestone v. Acushnet*, No. 05-132-JJF, 2007 WL 521894 (D. Del. Feb. 15, 2007) (granting Plaintiff’s motion to preclude use of untimely disclosed prior art references).

This Court on several occasions has precluded parties from relying on prior art and related contentions that were not fairly disclosed during discovery, even where the party was aware of the prior art reference. See, e.g., *Bridgestone*, 2007 WL 521894 (“[Plaintiff’s] prior knowledge of these references does not excuse [Defendant’s] failure to timely disclose them.”); *Praxair, Inc. v. ATMI, Inc.*, No. 03-1158-SLR, 2005 WL 3159054 (D. Del. Nov. 28, 2005)

(“Prior art references must be disclosed during fact discovery and the parties must disclose their intent to rely thereon, regardless of whether or not the opposing party is aware of the reference.”).

II. DR. JORDAN IMPROPERLY SOUGHT TO INTRODUCE NEW OBVIOUSNESS OPINIONS AT HIS DEPOSITION NOT PREVIOUSLY DISCLOSED IN HIS EXPERT REPORT

Dr. Jordan’s new obviousness opinions and prior art combinations that were not disclosed in the Jordan Report should be precluded. During his deposition, Dr. Jordan (1) recanted his sworn testimony and offered new opinions on redirect examination with Google’s counsel that claims for which he had provided an anticipation opinion are also obvious, and (2) identified several previously undisclosed combinations of prior art references as a basis for his opinion that the asserted patent claims are invalid. Because these opinions and combinations were not properly disclosed or explained in his expert report, Dr. Jordan should be precluded from presenting these opinions and combinations at trial. *MobileMedia Ideas, LLC, v, Apple Inc.*, No. 10-258-SLR, 2012 WL 6019305, at *1 (D. Del. Dec. 3, 2012) (precluding plaintiff’s expert from offering at trial testimony not included in his expert report on infringement).

Under Rule 26, Dr. Jordan was required to prepare and sign a written report containing “a complete statement of all opinions to be expressed and the basis and reasons for them” by April 11, 2012. Pursuant to the Federal Rules of Civil Procedure and the Court’s Scheduling Order, Dr. Jordan prepared and signed a written report setting forth his opinion that the asserted claims of the patents-in-suit are invalid and explicitly disclosing the basis and reasons that each of the asserted claims are either anticipated or obvious in view of the prior art and the knowledge of one of ordinary skill in the art at the time of the invention.

A. Dr. Jordan's New Obviousness Opinions For Claims As To Which He Had Only Asserted Anticipation Should Be Stricken.

As explained in section III.A. above, Dr. Jordan disclosed only anticipation opinions for the majority of the claims of the '040 and '276 patents. And during the first six hours and 45 minutes of his deposition testimony, Dr. Jordan repeatedly confirmed that he had no other opinions as to those claims. (See pages 5-6, *supra*).

Google's attempt to inject new, contrary opinions on redirect, with 15 minutes of the deposition remaining, should be rejected. Google cannot belatedly rely on Exhibit 3 to the Jordan Report to remedy the lack of disclosure. None of the charts in Exhibit 3 disclose any obviousness opinions or any obviousness combinations. Stated simply, the word obviousness does not even appear anywhere in Exhibit 3. Dr. Jordan conceded as much at his deposition. After being coached by Google's counsel, Dr. Jordan stated only that that the references listed under each limitation in Exhibit 3 were **implicit** disclosures of obviousness combinations. (See p. 7, *supra*).

Paragraph 124 in the anticipation section of the Jordan Report also provides a short description of Exhibit 3. It similarly provides that Exhibit 3 sets forth where each claim element is found in the prior art. It further states, "The charts also list additional references that would render each claim obvious should a finder-of-fact determine that the corresponding reference is not present in the prior art reference." However, no combinations are identified, explained or disclosed in Exhibit 3 or the body of the Jordan Report. The only obviousness combinations that Dr. Jordan disclosed are those combinations that are explicitly described in paragraphs 394-416 of his report. Any combinations not identified in these paragraphs should be stricken under Fed. R. Civ. P. 37.

III. GOOGLE’S FAILURE TO DISCLOSE THE OBVIOUSNESS COMBINATIONS IS NEITHER HARMLESS NOR SUBSTANTIALLY JUSTIFIED

The timing of Dr. Jordan’s last-minute “Hail Mary” opinions is highly prejudicial to P.U.M. and cannot be excused as harmless or substantially justified. As a result of Google’s failure to disclose the obviousness opinions and combinations on which it now seeks to rely, P.U.M.’s invalidity expert Dr. Carbonell was not able to evaluate and address the newly-crafted obviousness opinions and combinations when drafting rebuttal reports during the expert discovery period. Now, P.U.M.’s ability to prepare for summary judgment on invalidity, should Google make such a motion, and to prepare for trial, has been greatly prejudiced by Dr. Jordan’s untimely opinions. Because Google’s failure to disclose each of Dr. Jordan’s obviousness theories based on a massive number of combinations of previously identified prior art references is neither harmless nor substantially justified under the Pennypack factors, these opinions should be precluded under Fed. R. Civ. P. 37. See Pennypack, 559 F.2d at 904-05 (holding the district court properly exercised its discretion in excluding untimely disclosed expert testimony).

A. Importance Of The Information Withheld

The additional obviousness opinions for claims that Dr. Jordan opines are anticipated, and the additional prior art combinations identified by Dr. Jordan during his deposition but not explicitly identified in his report, are, according to Dr. Jordan himself, of little importance to Google’s invalidity case. As Dr. Jordan stated during his deposition, in his opinion, “I thought anticipation was stronger than obviousness, and so I am asserting anticipation.” Jordan Dep., Louden Decl. Ex. 2, at 257:13-14.

Moreover, P.U.M. is not seeking to strike Dr. Jordan’s testimony in its entirety. See *Allen v. Parkland Sch. Dist.*, 230 Fed. App’x 189, 194 (3d Cir. 2007) (concluding partial

exclusion of expert testimony was “not too harsh of a sanction”); see also *Bridgestone*, 2007 WL 521894, at *5 (“the Court finds [Defendant] has similar invalidity evidence available to it such that the exclusion of this evidence will not cripple [Defendant’s] invalidity case”). Limiting Dr. Jordan’s opinions at trial and during summary judgment to only those anticipation and obvious opinions disclosed in his expert report will only confine him to those opinions he actually expressed.

Further, in the case of sophisticated, complex litigation involving parties represented by competent counsel, as is the case here, Courts applying the Pennypack factors have been less indulgent in their application and more willing to exclude evidence without a strict showing that each of the Pennypack factors has been satisfied. *AstraZeneca AB v. Mutual Pharm. Co.*, 278 F. Supp. 2d 491, 506 (E.D. Pa. 2003) (granting motion to exclude newly raised invalidity allegations, holding that “[a]llowing Defendant to assert an entirely new basis of invalidity at the very end of the process is simply not fair to Plaintiffs.”). The parties to this litigation are sophisticated business entities, represented by counsel well-versed in complex patent litigation. Considering these circumstances, as well as the nature of the evidence sought to be stricken, Google should be precluded from relying on its untimely disclosed obviousness opinions and prior art combinations. See *Bridgestone*, 2007 WL 521894, at *4 (considering sophistication of the parties and competence of patent litigation counsel in precluding reliance on untimely disclosed references).

B. Prejudice To P.U.M.

P.U.M. was both surprised and prejudiced by Dr. Jordan’s last-minute disclosure of potentially 666 obviousness combinations and obviousness opinions, and will suffer prejudice if Google is allowed to introduce these new theories at trial (or in a summary judgment motion).

Both fact and expert discovery have closed, and P.U.M. has not had the opportunity to refute Dr. Jordan's last-minute new theories. See *Trilogy Commc'ns, Inc. v. Times Fiber Commc'ns Inc.*, 109 F.3d 739, 745 (Fed. Cir. 1997) ("When scheduling orders are violate, an opposing party is often prejudiced by the ensuing delay and resultant expense."); see also *Bridgestone Sports Co. Ltd.*, 2007 WL 521894, at *5 (finding prejudice to defendant is outweighed by the prejudice plaintiff will suffer if the references are allowed).

Were Google permitted to rely on these last-minute opinions and combinations, P.U.M. would need to submit a supplemental report to address these new opinions. The time needed to prepare a report on potentially hundreds of combinations would further delay this already much delayed trial. The additional time and significant additional expense that would follow are consequences which could have been avoided. Accordingly, there is no basis upon which to allow Google to rely on these untimely disclosed opinions and prior art combinations. See e.g., *Philips Elecs. N. Am. Corp. v. Contec Corp.*, No. 02-123-KAJ, 2004 WL 769371, at *1 (D. Del. Apr. 5, 2004) (precluding party from using untimely produced documents at trial where there was no reasonable excuse for the delay and acknowledging that "an 'A' for effort [in complying with Rule 37] does not excuse [a party's] failure to abide by its disclosure obligations"); *AstraZeneca AB v. Mutual Pharm. Co.*, 278 F. Supp. 2d 491, 508 (E.D. Pa. 2003) (excluding defendant's reliance on prior art patent where ensuing delay would not disrupt the trial date and no bad faith was shown, but defendant offered no excuse sufficient to ignore the Court's scheduling deadlines).

Moreover, any prejudice to Google is outweighed by the prejudice that P.U.M. would suffer if Dr. Jordan were allowed to testify regarding the previously undisclosed opinions and prior art combinations. Although Google may argue that the cited references were

previously known to P.U.M, P.U.M. was not aware of Dr. Jordan's undisclosed obviousness theories, including the hundreds of purported combinations and any alleged motivation to combine them. See e.g., Praxair, 2005 WL 3159054, at *4 (acknowledging that “[p]rior art references must be disclosed during fact discovery and the parties must disclose their intent to rely thereon, regardless of whether or not the opposing party is aware of the reference”). And as noted above, there would be very little if any prejudice to Google by excluding these new opinions and combinations because Dr. Jordan himself admitted that his anticipation opinions were much stronger than any obviousness opinions would be.

C. Likelihood Of Disruption Of The Trial

The case will suffer further delay and prolonged disruption if the Court allows additional expert reports and discovery at this time. Although no trial date has yet been set, P.U.M. has requested one, and this Court has recognized that “the case will be ready for trial following resolution of case dispositive motions.” (D.I. 407, p. 3 (Denying Google's recent Motion to Stay the proceedings); see also Transcript of August 31, 2012 Teleconference before Judge Stark, 24:1-6 (“The parties should be mindful, though, that if the case is not stayed and is not dismissed and there are claims that survive case dispositive motions, then at that point, the case will be ready for trial, and we will move to trial as promptly as everybody's schedule permits at that point.”)). Moreover, the addition of potentially hundreds of obviousness combinations would undoubtedly disrupt and prolong the trial, and certainly confuse the jury.

D. Possibility Of Curing The Prejudice

Allowing Dr. Jordan to testify on obviousness opinions and combinations beyond those expressly identified in his expert report circumvents Fed. R. Civ. P. 26 and would allow Google to advance invalidity theories that were not thoroughly vetted and weighed by P.U.M.'s

experts during the course of discovery. See *Convolve, Inc. v. Compaq Computer Corp.*, No. 00-5141, 2006 WL 2527773, at *6-7 (S.D.N.Y. Aug. 31, 2006) (observing that a long extension of deadlines cannot cure prejudice when an adversely affected party, having already spent substantial time and expense opposing one set of contentions, would be forced to spend additional time and money to respond to newly disclosed infringement contentions); see also *Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co.*, 270 F. Supp. 2d 519, at 524 (D. Del. 2003) (agreeing with Plaintiff's contention that it would "be severely prejudiced" if parties were allowed to introduce voluminous new discovery, even though there was time for response to new discovery prior to new trial date.) Accordingly, this factor weighs in P.U.M.'s favor.

E. Explanation For The Failure To Disclose

Google has no valid explanation why Dr. Jordan did not disclose the newly asserted obviousness opinions and combinations in his expert report rather than in the last 15 minutes of all pretrial discovery. Indeed, the Jordan Report only explicitly identifies four sets of combinations that are alleged to render several of the asserted claims obvious. Dr. Jordan's failure to set forth additional combinations of known references is inexcusable and this factor weighs heavily in favor striking any obviousness opinion or combination not explicitly identified in the Jordan Report.

F. Presence Of Bad Faith Or Willfulness In Not Disclosing The Evidence

Google acted in bad faith by interfering with Dr. Jordan's deposition testimony, conferring with him, and then immediately having him recant his sworn testimony on redirect. Google also tried to have Dr. Jordan patch the holes in his report by asserting potentially hundreds of new obviousness combinations.

CONCLUSION

For the foregoing reasons, P.U.M respectfully requests that this Court issue an Order: (1) striking any evidence or opinion that claims that Dr. Jordan opines are anticipated are also obvious, and (2) striking any alleged prior art combination from Exhibit 3 of Dr. Jordan's expert report that is not included in the body of his report.

MORRIS, NICHOLS, ARSHT & TUNNELL LLP

/s/ Karen Jacobs Louden

Karen Jacobs Louden (#2881)

Jeremy A. Tigan (#5239)

1201 N. Market Street

P.O. Box 1347

Wilmington, DE 19899-1347

(302) 658-9200

klouden@mnat.com

jtigan@mnat.com

Attorneys for Personalized User Model, L.L.P.
and Yochai Konig

OF COUNSEL:

Marc S. Friedman

SNR DENTON US LLP

1221 Avenue of the Americas

New York, NY 10020-1089

(212) 768-6700

Jennifer D. Bennett

SNR DENTON US LLP

1530 Page Mill Road, Ste. 200

Palo Alto, CA 94304-1125

(650) 798-0300

December 6, 2012

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CERTIFICATE OF SERVICE

I hereby certify that on January 14, 2013, I caused the foregoing to be electronically filed with the Clerk of the Court using CM/ECF which will send electronic notification of such filing to all registered participants.

Additionally, I hereby certify that true and correct copies of the foregoing were caused to be served on January 14, 2013, upon the following individuals in the manner indicated:

BY E-MAIL

Richard L. Horwitz
David E. Moore
POTTER ANDERSON & CORROON LLP
1313 N. Market St., 6th Floor
Wilmington, DE 19801

BY E-MAIL

Brian C. Cannon
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
555 Twin Dolphin Dr., 5th Floor
Redwood Shores, CA 94065

Charles K. Verhoeven
David A. Perlson
Antonio R. Sistos
Andrea Pallios Roberts
Joshua Lee Sohn
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
50 California Street, 22nd Floor
San Francisco, CA 94111

/s/ Jeremy A. Tigan

Jeremy A. Tigan (#5239)