

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

PERSONALIZED USER MODEL, L.L.P., )

Plaintiff, )

v. )

GOOGLE INC., )

Defendant. )

GOOGLE, INC. )

Counterclaimant, )

v. )

PERSONALIZED USER MODEL, LLP and  
YOCHAI KONIG )

Counterdefendants. )

C.A. No. 09-525-LPS

**JURY TRIAL DEMANDED**

**GOOGLE INC.'S OPPOSITION TO PUM'S MOTION TO STRIKE  
DR. JORDAN'S LATE-DISCLOSED OPINIONS**

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### **NOTE ON CITATIONS**

Unless otherwise noted, all Exhibits (denoted by “Ex.”) are Exhibits to the Declaration of Andrea Pallios Roberts (“Roberts Del.”), filed concurrently herewith.

1. Attached as Exhibit A is the Expert Report of Michael Jordan. Unless otherwise noted, all numerical citations to Exhibit A refer to page numbers (not paragraph numbers) from Dr. Jordan’s Report.
2. Attached as Exhibit B are cited excerpts of the deposition of Michael Jordan.
3. Attached as Exhibit C are cited excerpts of the Rebuttal Report of Jaime Carbonell.

### **Nature and Stage of Proceedings**

In this patent infringement case, expert discovery has closed and the parties are in the midst of summary judgment briefing. Plaintiff Personalized User Model, LLP (“PUM”) has filed a Motion to Strike certain opinions of Defendant Google Inc.’s (“Google”) invalidity expert, Dr. Michael Jordan. PUM filed its Motion eight months after Dr. Jordan’s expert report issued, one month after Dr. Jordan’s deposition, and on the same day that Google filed three motions for summary judgment.

### **Summary of Argument**

With all of its asserted claims having been repeatedly rejected as anticipated and/or obvious in the pending re-examinations, and facing a summary judgment motion on anticipation and obviousness, PUM now files a “Hail Mary” Motion to Strike Google’s entire obviousness case. Specifically, PUM requests that Dr. Jordan be precluded from: (1) providing obviousness opinions for any claim that he also opined was anticipated; and (2) relying on any prior art combination from Exhibit 3 of his report to argue obviousness. (*See* Motion at 18). Given Dr. Jordan’s opinion that every asserted claim is anticipated, PUM’s Request #1 alone is tantamount to requesting that Dr. Jordan be barred from providing obviousness opinions for every asserted claim. In other words, PUM seeks to bar Google’s obviousness case altogether.

Not only is PUM’s request breathtakingly broad, it is also meritless. Contrary to PUM’s assertions, Dr. Jordan’s opinions regarding obviousness were – at length – included in his expert report. Dr. Jordan’s Report includes an 83-page section opining that all asserted claims are anticipated and explaining how all the elements are in the art (Ex. A, 62-145), and a further 53-page section opining that all asserted claims are obvious. (*Id.*, 145-197). Dr. Jordan’s report further contains seven claim charts that are specifically incorporated and discussed in both the anticipation and obviousness sections of the body of his report. Only by ignoring nearly 40% of

Dr. Jordan's report can PUM allege that Dr. Jordan did not offer obviousness opinions for the same claims for which he also offered anticipation opinions.

Likewise, PUM's request that the Court strike "any alleged prior art combination listed in Exhibit 3 of Dr. Jordan's expert report that is not included in the body of his report" (Motion at 18) is based on PUM's unsupportable position that Exhibit 3 of Dr. Jordan's report is somehow not part of his report. But again, Dr. Jordan expressly incorporated Exhibit 3 into the main body of his report and stated that the prior art discussed in Exhibit 3 could be used to render the asserted claims obvious. (*See* Ex. A at 62, 145). Thus, it is baseless for PUM to argue that the prior art combinations in Exhibit 3 are outside the scope of Dr. Jordan's report.

Because the opinions that PUM seeks to strike are plainly disclosed in Dr. Jordan's report, that should be the end of the matter – there is no basis to strike opinions that Dr. Jordan disclosed in his report. Tacitly recognizing this problem, PUM bases its Motion heavily on supposed "gotcha" admissions from Dr. Jordan's deposition. For example, two full pages of PUM's Motion consist of testimony from Dr. Jordan's deposition, which PUM selectively highlights in a mistaken effort to show that Dr. Jordan disclaimed any obviousness opinions for claims that he had opined were anticipated. (*See* Motion at 5-6). In actuality, at best, this testimony shows only that PUM's counsel succeeded in temporarily confusing Dr. Jordan based on legal nuances: PUM's counsel asked Dr. Jordan which claims he felt were rendered obvious by a given reference, and Dr. Jordan responded by listing the claims that were only rendered obvious by that reference – *i.e.*, the claims that were not also anticipated by that reference. As PUM admits, Dr. Jordan later clarified in his deposition that he is also offering obviousness opinions for those claims that are anticipated. (*See* Motion at 7 (citing Ex. B, 373:4-19)).

Nonetheless, PUM seeks to create an estoppel from Dr. Jordan's initial confusion, by

arguing that Dr. Jordan somehow forfeited the right to opine that claims which are anticipated are also obvious. This tactic should be rejected. It is clear, when viewed in its entirety, that Dr. Jordan's deposition testimony was that the relevant claims were both anticipated and obviousness. This opinion fully comports with Dr. Jordan's report, which clearly discloses obviousness opinions and anticipation opinions for the same claims. PUM cannot use any temporary "gotchas" at Dr. Jordan's deposition to erase the plain disclosures in Dr. Jordan's report.

PUM seeks to distract from the weakness of its Motion by making baseless ethical accusations against Google's counsel. Specifically, PUM alleges that Google's counsel violated the Local Rules by conferring with Dr. Jordan during breaks in the deposition. (*See, e.g.*, Motion at 7). To be clear, no such conferences took place, and PUM proffers no evidence to the contrary. In fact, the one time that PUM's counsel directly asked Dr. Jordan whether he conferred with Google's counsel during the preceding break, Dr. Jordan answered that he did not. (Ex. B, 98:6-9). Had PUM's counsel asked the same question after every break, it would have gotten the same answer. (Roberts Decl., ¶ 5).

#### **Statement of Relevant Facts**

#### **I. DR. JORDAN SUBMITS A TIMELY REPORT DISCLOSING OBVIOUSNESS OPINIONS.**

Pursuant to the case schedule, on April 11, 2012, Dr. Jordan submitted a report setting forth his opinions that each of the asserted claims is invalid. On the first page of his report, Dr. Jordan summarizes his opinions as follows:

2. My analysis covers claims 1, 11, 22, 32,<sup>1</sup> and 34 of U.S. Patent No. 6,981,040 (hereinafter “the ‘040 Patent”) and claims 1, 3, 5, 6, 7, 21, and 22 of U.S. Patent No. 7,685,276 (hereinafter “the ‘276 Patent”). It is my opinion that each of the asserted claims are invalid at least for anticipation and/or obviousness in light of the prior art.

(Ex. A, 1). After describing various prior art references, Dr. Jordan explains the bases for his opinion that each of the asserted claims is invalid as anticipated by one or more of seven different references. (*See id.* at 62-145.)

Dr. Jordan also incorporates by reference Exhibit 3 of his report. Exhibit 3 comprises seven different claim charts – one for each of the seven anticipatory prior art references – showing where each of the claim elements are found in each reference. In addition, Dr. Jordan explicitly states that the additional references would render each claim obvious should a finder-of-fact determine that the corresponding element is not present in the main prior art reference:

124. Exhibit 3 of this expert report contain element-by-element claim charts of each of the asserted claims in this case with references to the prior art, and are fully incorporated in their entirety into this report. The charts also list additional references that would render each claim obvious should a finder-of-fact determine that the corresponding element is not present in the prior art reference. Further narrative discussions of these references is below.

(*Id.* at 62). Then, beginning on page 145 of his report and continuing through page 197, Dr. Jordan sets forth further explanation of his opinion on obviousness. This section of his report begins as follows, once again explicitly referencing Exhibit 3:

## **VII. THE ASSERTED CLAIMS ARE OBVIOUS IN LIGHT OF THE PRIOR ART**

315. 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.

316. Exhibit 3 of this expert report is an element-by-element claim chart of each of the asserted claims in this case with references to the prior art, and is incorporated into the body of and is part of this report.

(*Id.* at 145). Thereafter, on pages 147-197, Dr. Jordan sets forth the bases for his opinion that each of the asserted claims is invalid for obviousness. Dr. Jordan explicitly anchors his obviousness analysis in the Supreme Court's obviousness precedent of *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) and *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966). (*See* Ex. A at 146-47, 164, 184-85, 193-97).

First, he explains how the asserted claims comprise a combination of prior art elements. (*Id.* at 147-164). *KSR*, 550 U.S. at 415 (expressing "the need for caution in granting a patent based on the combination of elements found in the prior art.") In this section, he identifies the various prior art references that disclose each element of all the asserted claims: transparent monitoring, updating user-specific files, estimating parameters of a learning machine, analyzing documents, estimating a probability, providing personalized services responding to users' search queries, interaction times, multiple media types, using a browser, monitoring different modes of user interaction, documents not of interest, documents corresponding to products, and identifying certain properties in documents. (*See* Ex. A, 147-164).

Next, Dr. Jordan explains that the combinations of known prior art elements in the asserted claims are predictable and do not yield any unpredictable results. (*Id.* at 164-184)

(citing *KSR*, 550 U.S. at 416 (“[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”)) In this section, he again discusses each of the elements in all the asserted claims to explain the basis for his opinion that the combinations of elements are predictable and do not yield any unpredictable results. (*Id.*) He also discusses each of the seven primary prior art references again. For each asserted claim that he did not opine was anticipated by each of these references, he explains why that claim is rendered obvious in light of that reference and in combination with others. (*Id.* at 176-184). And, rather than repeating how each of these primary prior art references discloses each element of the asserted claims that are anticipated, Dr. Jordan cites to the portions of his report explaining those anticipatory disclosures. (*See id.* at 176 (for Mladenic, citing to Section VI.A), 177 (for Autonomy, citing to Section VI.B), 178 (for Montebello, citing to Section VI.C), 179 (for Wasfi, citing to Section VI.D), 183 (for Culliss, Refuah, and Joachims, citing to Sections VI.E, VI.F, and VI.G, respectively).)

Dr. Jordan’s report goes on to explain that one skilled in the art would have been motivated to pursue the claimed combinations through market forces and trends. (*Id.* at 185-187). Dr. Jordan cites to evidence of these market forces and trends on which he bases his opinion. (*Id.*) He then addresses the *Graham v. John Deere* factors and opines that the asserted claims are obvious under those *Graham* factors. (*Id.* at 193-197).

Dr. Jordan’s 198 page report ends with a summary of his conclusions, which re-iterates: “All the Asserted Claims are anticipated. All the Asserted Claims are obvious.” (*Id.* at 198.)

## **II. PLAINTIFF’S EXPERT REBUTS DR. JORDAN’S OPINIONS.**

Although Google served Dr. Jordan’s report on April 11, 2012, PUM never once professed any confusion with his opinions in the five months before its rebuttal report. On September 28, 2012, PUM’s validity expert Dr. Jaime Carbonell submitted a report rebutting Dr.

Jordan's opinions. Despite PUM's current feigned confusion, Dr. Carbonell understood perfectly that Dr. Jordan had issued obviousness opinions for all asserted claims, saying: "[i]n paragraphs 320-365 of his report, Jordan opines that every claim of the patents-in-suit is obvious." (Ex. C, 158 (emphasis added)). Dr. Carbonell's obviousness discussion is organized in the same manner as Dr. Jordan's. First, Dr. Carbonell addresses various elements in the asserted claims and explains why he believes that these elements did not exist in the prior art. (*Id.* at 161-173). Then he explains why, in his opinion, the combinations in the asserted claims are not predictable and yield unpredictable results. (*Id.*, 173-191). Next, he opines that a person having ordinary skill in the art would not have been motivated to combine the claimed limitations. (*Id.* at 191-193). Finally, he explains why, in his opinion, the *Graham* factors support the non-obviousness of the claimed inventions. (*Id.* at 193-207).

### **III. IN DEPOSITION, DR. JORDAN CONFIRMS HIS OPINIONS ARE THOSE DISCLOSED IN HIS REPORT.**

PUM deposed Dr. Jordan on November 7, 2012. (Ex. B). This deposition lasted the full seven hours permitted by the Federal Rules, and PUM's counsel had every opportunity to question Dr. Jordan on the both the anticipation opinions and the obviousness opinions from his expert report. Nonetheless, PUM's counsel never asked Dr. Jordan about paragraph 315 of his report, where he explained "to the extent that any of those [anticipatory] 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." (Ex. A, ¶ 315). Nor did counsel question Dr. Jordan about the 51 pages of his report that explain how each element of the asserted claims existed in the prior art, that the combinations in the asserted claims are predictable and do not yield any

unpredictable results, that one skilled in the art would have been motivated to pursue the claimed combinations through market forces, and that the *Graham* factors demonstrate obviousness.

On page 58 of the deposition transcript, PUM's counsel began asking Dr. Jordan about his anticipation opinions. (Ex. B, 58:24 *et. seq.*). On page 120, PUM's counsel next asked Dr. Jordan about his obviousness opinions, by eliciting testimony about how the Personal WebWatcher prior art system could be combined with other references to render obvious the claims that required search. (*Id.* at 120:7-122:8). PUM's counsel did not address Dr. Jordan's obviousness opinions again until page 217, where she questioned Dr. Jordan about his opinion that '276 claim 5 was obvious over the Montebello reference. (*Id.* at 217:16-218:8). The next discussion of Dr. Jordan's obviousness opinions came at page 240, where Dr. Jordan explained his opinion that '040 claim 11 and all of the '276 claims would be obvious over the Wasfi reference in combination with "any existing, at the time, search engine." (*Id.* at 240:8-17).

In its Motion, PUM argues that Dr. Jordan disclaimed having any opinions about prior art combinations involving Wasfi. (Motion at 7). PUM quotes deposition testimony as purportedly being: "'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.'" (*Id.*) This just misrepresents Dr. Jordan's testimony. The transcript actually shows that Dr. Jordan began answering "I don't –," at which point PUM's counsel cut off his answer with another question. (Ex. B, 242:6-12). After this interruption, Dr. Jordan reiterated at length how it would be obvious to combine Wasfi with any search engine reference to render obvious all the '276 claims and '040 claim 11. (*Id.* at 242:17-247:19). He also pointed PUM's counsel to two places in the main body of his report where he had opined that it would be obvious to combine personalization systems such as Wasfi with search engine systems. (*Id.* at 242:17-243:3; 244:7-22 (citing page 172 of his report)); 245:7-25

(citing pages 179-80 of his report)). He then pointed PUM's counsel to the places in Exhibit 3 of his report where he had opined that it would be obvious to combine Wasfi with several different search references. (*See id.* at 254:5-255:2) (citing page 10 of Exhibit 3-D to his report)).

PUM's counsel then asked Dr. Jordan to identify where in his report he opined that '040 claim 1 patent is obvious in light of Wasfi. (Ex. B, 256:5-11). Dr. Jordan responded that he did not discuss this in the obviousness section of his report because he had already discussed Wasfi in the context of anticipation. (*Id.* at 256:12-15; *see also* Ex. A, 179 (citing in the obviousness section of the report to Section VI.D discussing Wasfi's anticipation of asserted claims).) In contrast, because he did not opine that claim 11 of the '040 patent was anticipated by Wasfi, he discussed that claim in the obviousness section of his report. (Ex. B, 256:16-257:4). PUM's counsel then asked a question which left Dr. Jordan confused, and he stated as much:

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?

MS. ROBERTS: Objection to form.<sup>1</sup>

THE WITNESS: I don't have enough legal expertise to understand that distinction. I thought anticipation was stronger than obviousness, and so I am asserting anticipation.

Q: You are asserting anticipation with respect to Claim 1 of the '040 patent, and you're not certain whether you are asserting obviousness with respect to Claim 1 of the '040 patent? I'm just -- we're here today to try to figure out what your opinions are, so I'm just trying to understand your opinions.

A: We're talking about legal terminology on which I am not an expert. So my understanding is that obviousness has to do with combinations.

Q: That's correct.

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<sup>1</sup> PUM's citations to Dr. Jordan's deposition transcript misleadingly omit Google's counsel's objections.

A: Anticipation, you don't need a combination. It's there, period, end of story. So for a claim that I viewed as anticipated, I did not believe that I needed to state obviousness.

Q: Okay. And that's why that is not written in your report?

MS. ROBERTS: Objection to form.

THE WITNESS: What's in my report is there, and my interpretation of what's in my report, I'm trying to provide to you.

(*Id.* at 257:5-258:13) (emphasis added).

Similar exchanges occurred with regard to the other prior art references which Dr. Jordan opined both anticipate and render obvious the patents-in-suit. PUM's counsel asked him which claims he opined were rendered obvious by a particular reference, and Dr. Jordan responded by identifying the claims that he opined were only rendered obvious by that reference, *i.e.* those that were not also anticipated by that reference. (*See id.* at 264:19-265:23 (regarding Culliss), 299:1-18 (regarding Refuah), 322:3-323:10 (Joachims), 342:8-15 (Mladenic), 345:2-13 (same), 346:10-18 (Autonomy), 347:2-13 (same), 348:9-16 (Montebello), 349:1-16 (same).

At the end of the deposition, PUM's counsel requested a break before wrapping up the deposition. (*Id.* at 369:9-10). In its Motion, PUM accuses Google's counsel of conferring with Dr. Jordan during this break. (*See* Motion at 7). PUM offers no evidence to support this accusation, because there is none. Consistent with the Local Rules, Google's counsel did not confer with Dr. Jordan during any breaks. Indeed, on one occasion following a break, PUM's counsel expressly asked Dr. Jordan if he discussed his testimony with Google's counsel during the break, and he responded that he did not. (Ex. B at 98:6-9). Had PUM's counsel asked that question after every break, she would have gotten the same answer—no such conferences took

place. (Roberts Decl., ¶ 5). PUM's allegation that Google's counsel improperly conferred with Dr. Jordan during breaks is false, unsupported, and frankly unprofessional.<sup>2</sup>

After the final break requested by PUM's counsel, Google's counsel conducted a short re-direct examination to clarify the issues Dr. Jordan had expressed confusion about. During re-direct, Dr. Jordan confirmed: if not found to be anticipatory, the seven primary references render obvious the asserted claims, as laid out in his report; Exhibit 3 to his report comprises element-by-element claim charts of the asserted claims; Dr. Jordan incorporated these claim charts by reference into the body of his report; Dr. Jordan set out the basis for his opinion that the seven primary references render the asserted claims obvious in the obviousness section of his report, along with the claim charts; and the other, non-primary references disclosed in the Exhibit 3 claim charts can be used in combination with the primary references to render the asserted claims obvious. (Ex. B, 371:23-375:13; 377:23-380:3).

### **Argument**

#### **I. PUM'S MOTION SHOULD BE DENIED BECAUSE THERE ARE NO "NEW" OPINIONS NOT DISCLOSED IN DR. JORDAN'S REPORT**

PUM's Motion seeks to preclude two vague categories of obviousness opinions. First, PUM seeks to preclude Dr. Jordan from opining that any claim which is invalid for anticipation is also invalid for obviousness. Second, PUM seeks to preclude Dr. Jordan from relying on any prior art combination listed in Exhibit 3 of his report that is not also listed in the main body of his report. (*See* Motion at 18):

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

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<sup>2</sup> On page 8, PUM refers to testimony from Dr. Jordan after "the break," implying this was the last break of the deposition. (Motion at 8). PUM's citation, however, is to a portion of transcript 100 pages earlier than the re-direct examination, and following another break requested by PUM's counsel. (Ex. B, 251:14-15).

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.

As explained below, PUM's Motion is meritless as to both categories of obviousness opinions that PUM seeks to strike.

**A. Dr. Jordan's Report Discloses That the Claims Which are Invalid for Anticipation Are Also Invalid for Obviousness**

As recounted above, PUM "requests that this Court issue an Order: (1) striking any evidence or opinion that claims that Dr. Jordan opines are anticipated are also obvious." (Motion at 18). PUM argues that these opinions are improper because Dr. Jordan's report supposedly does not disclose that claims which are invalid for anticipation are also invalid for obviousness. (*See id.* at 11 ("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 . . . 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."))

The scope of PUM's request is breathtaking. In the anticipation section of his report – pages 62 to 145 – Dr. Jordan opines that every asserted claim is anticipated. Thus, PUM's position that Dr. Jordan may not offer obviousness opinions for any claim that he found anticipated is tantamount to saying that Dr. Jordan may not offer obviousness opinions for any asserted claim. In other words, even though Dr. Jordan's report devoted 51 pages (pages 147-197) to opining that every asserted claim was obvious and explicitly relied on and incorporated the further detail of Exhibit 3, PUM would preclude Dr. Jordan from offering any opinion of obviousness of any claim. This request fails the straight-face test.

Contrary to PUM's position, and as detailed above, Dr. Jordan's report discloses in numerous places that claims which are invalid for anticipation are also invalid for obviousness.

The most succinct summary of these disclosures comes on page 198 of the report, which states: “All the Asserted Claims are anticipated. All the Asserted Claims are obvious.” (Ex. A, 198). Likewise, PUM’s rebuttal expert Dr. Carbonell understood perfectly that Dr. Jordan was asserting obviousness for every asserted claim. (Ex. C, 158 (“[i]n paragraphs 320-365 of his report, Jordan opines that every claim of the patents-in-suit is obvious.”) (emphasis added)).

A more granular look at Dr. Jordan’s report likewise shows that Dr. Jordan certainly did provide obviousness opinions for those claims that he also found anticipated. For example, at pages 164-176 of his report, Dr. Jordan marches through every element of every asserted claim to show how “The Combinations In the Asserted Patent Claims Are Predictable And Do Not Yield Any Unpredictable Results.” (Ex. A, 164). This was done as part of his broader analysis of how all asserted claims are obvious. (*See id.* at 145-197). Dr. Jordan’s discussion of predictability at pages 164-176 covers all asserted claims, even though Dr. Jordan had previously provided anticipation opinions for those same claims. For example, at pages 165-171 (¶¶ 368-381) Dr. Jordan discusses the predictability of the elements from ‘040 claim 1, even though Dr. Jordan had previously explained why ‘040 claim 1 was anticipated. (*See, e.g., id.* at 64-72, 78-84, 90-97). At ¶ 384 (page 172), Dr. Jordan discusses the predictability of monitoring interaction times, as called for by ‘040 claim 22, even though Dr. Jordan had previously explained why ‘040 claim 22 is anticipated. (*See id.* at 116, 127-28). At ¶¶ 385-86 (page 173), Dr. Jordan discusses the predictability of analyzing documents of multiple media types, as called for by ‘040 claim 34, even though Dr. Jordan had previously explained why ‘040 claim 34 is anticipated. (*See, e.g., id.* at 73, 85-86, 98-99). And so on: the obviousness analysis in Dr. Jordan’s report addresses every claim that he also opined was anticipated. There is no merit to PUM’s position that Dr. Jordan’s report did not provide obviousness opinions for those claims that he opined

were anticipated. Thus, PUM's request that the Court "stri[k]e any evidence or opinion that claims that Dr. Jordan opines are anticipated are also obvious" (Motion at 18) should be denied.

**B. Dr. Jordan's Report Contains the Prior Art Combinations Listed in Exhibit 3 Because Exhibit 3 Is Part of Dr. Jordan's Report**

As discussed above, PUM's second preclusion request is "that this Court issue an Order . . . (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." (Motion at 18). PUM nowhere specifies or enumerates which prior art combinations this request even applies to. But in any event, there is no basis for PUM to allege that any prior art combinations from Exhibit 3 are outside the scope of Dr. Jordan's report, because all of Exhibit 3 is part of Dr. Jordan's report. For example, at page 62 of his report, Dr. Jordan states: "Exhibit 3 of this expert report contain element-by-element claim charts of each of the asserted claims in this case with references to the prior art, and are fully incorporated in their entirety into this report. The charts also list additional references that would render each claim obvious should a finder-of-fact determine that the corresponding element is not present in the prior art reference." (Ex. A, 62) (emphasis added). At page 145 – in the obviousness section of Dr. Jordan's report – Dr. Jordan similarly explains that "Exhibit 3 of this expert report is an element-by-element claim chart of each of the asserted claims in this case with references to the prior art, and is incorporated into the body of and is part of this report." (*Id.* at 145) (emphasis added). Because Exhibit 3 is part of Dr. Jordan's report, there is no basis to strike the prior art combinations from Exhibit 3 on the theory that such combinations are outside the scope of his report.

As a fall-back position, PUM argues that Dr. Jordan should not be able to rely on any of the prior art combinations in Exhibit 3 to argue obviousness because "[n]one of the charts in Exhibit 3 disclose any obviousness opinions or any obviousness combinations." (Motion at 12;

*see also id.* at 8 (“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.”)) This is a willful misreading of Dr. Jordan’s report – both Exhibit 3 and the main body of the report.

As detailed above, the body of the report explains that the references at the bottom of each claim chart cell are references that could be combined with the primary reference from that claim chart to render the claim at issue obvious. (*See id.* at 62):

Exhibit 3 of this expert report contain element-by-element claim charts of each of the asserted claims in this case with references to the prior art, and are fully incorporated in their entirety into this report. The charts also list additional references that would render each claim obvious should a finder-of-fact determine that the corresponding element is not present in the prior art reference.

(emphasis added). If there were any doubt on this score, Dr. Jordan makes another reference to Exhibit 3 in the obviousness section of his report. (*See id.* at 145 (“Exhibit 3 of this expert report is an element-by-element claim chart of each of the asserted claims in this case with references to the prior art, and is incorporated into the body of and is part of this report.”)). As noted above, the seven claim charts that comprise Exhibit 3 (Exhibit 3-A through Exhibit 3-G) each cover one primary, anticipatory reference. Exhibit 3-A shows how the claims are anticipated by Mladenec, Exhibit 3-B shows how the claims are anticipated by Autonomy, etc. Accordingly, for each row in the Exhibit 3 claim charts, the left-hand column recites a given claim element while the right-hand column recites where that element is found in the anticipatory reference that the particular chart addresses. For example, below is an excerpt from Exhibit 3-A (the Mladenec claim chart), showing where the added element from claim 11 is found in Mladenec:

Claim 11	
11. The method of claim 1 further comprising estimating a posterior probability $P(u d,q)$ that the document $d$ is of interest to the user $u$ , given a query $q$ submitted by the user.	<p>MLADENIC, p. 2: "WebWatcher can be described as an agent that assists users in locating information on the WWW. It learns by observing a user on her/his way through the WWW and suggests interesting hyperlinks whenever it is confident enough. The idea is that the user provides a few keywords describing a search goal and WebWatcher highlights related hyperlinks on the current page and/or adds new hyperlinks to the current page."</p> <p><i>See also:</i></p> <p>CULLISS at 2:39-51, 9:41-49, 10:1-7, 10:47-52.</p> <p>REFUAH at 17:21-43.</p> <p>SCHUETZE at 21:57 – 22:16, 22:31-48, 30:58 – 31:13.</p>

(Ex. A, Ex. 3-A at 11). As shown in this excerpt, the Mladenic claim chart also lists other references (Culliss, Refuah, and Schuetze) after its explanation of how Mladenic anticipates claim 11. These other references are references that could be combined with Mladenic to render claim 11 obvious. By explicitly incorporating Exhibit 3 into the obviousness section of his report, Dr. Jordan disclosed that the references listed in Exhibit 3 for each claim element could be used together to render that claim element obvious. Thus, PUM's allegation that "the Jordan Report nowhere discloses that those other citations [in Exhibit 3] would be relied upon for obviousness" (Motion at 8) is demonstrably incorrect. At page 62 and page 145 of his report, Dr. Jordan stated that the prior art combinations in Exhibit 3 were being used for obviousness.

In sum, the prior art combinations listed in Exhibit 3 are part of Dr. Jordan's report, and Dr. Jordan explained in at least two places in his report (page 62 and page 145) that these combinations are obviousness combinations. Accordingly, there is no basis to strike these combinations or rule that Dr. Jordan cannot rely on them for obviousness.

PUM's request to strike the combinations in Exhibit 3 is also quixotic, as the "question of obviousness also is not subject to any 'rigid rule' that requires an express 'discussion of obvious techniques or combinations' in the prior art." *Stored Value Solutions, Inc. v. Card Activation Tech., Inc.*, 796 F.Supp. 2d 520, 529 (D. Del. 2011) (quoting *KSR*, 550 U.S. at 419). Dr.

Jordan's obviousness opinions illustrate this point. For example, as discussed above, Dr. Jordan opined that the "search" claims would be rendered obvious by Wasfi in combination with any basic search functionality, not that Wasfi needed to be combined with any specific search reference(s) in order to render these claims obvious. (Ex. B at 242:17-247:19; 254:5-255:2). More generally, Dr. Jordan's obviousness opinions rely on the presence of all claim elements in the prior art (Ex. A at 147-164), the predictability of the claimed combinations (*id.* at 165-185), the market forces that would have motivated one of skill in the art to pursue these combinations (*id.* at 185-87), and the *Graham* factors. (*Id.* at 193-97). These opinions are not reliant on any specific combination of references, nor does the law requires that obviousness opinions be limited to such combinations. See *Stored Value Solutions*, 796 F. Supp. 2d at 529. Thus, PUM's attempt to limit Dr. Jordan to the particular prior art combinations in Exhibit 3 – and to then argue that he cannot opine on obviousness because the Exhibit 3 combinations are not part of his report – is a mischaracterization of what Dr. Jordan's obviousness opinions actually are.

## **II. PUM'S CASELAW AND DEPOSITION CITES ARE BESIDE THE POINT**

PUM cites several cases in which courts excluded evidence or opinions that were not properly disclosed during discovery. (See Motion at 9-11). PUM then runs through the *Pennypack* factors (*id.* at 13-17), which give guidance as to when evidence should be excluded as a sanction for a party's failure to abide by the Federal Rules or Court scheduling deadlines. *B. Braun Melsungen AG v. Terumo Med. Corp.*, 749 F. Supp. 2d 210, 221 (D. Del. 2010) (explaining that "the 'Pennypack factors'" apply when a court is considering whether 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.")

But PUM's cited cases and PUM's analysis of the *Pennypack* factors are beside the point, because Google did not violate the Federal Rules or the Court's scheduling deadlines with

respect to Dr. Jordan's challenged opinions. As explained above, Dr. Jordan disclosed these opinions in his expert report, which is precisely what the Federal Rules and the Court's scheduling deadlines require.

Equally unavailing is PUM's lengthy recitation of Dr. Jordan's deposition testimony, which PUM cites in an effort to show that Dr. Jordan did not put forth obviousness opinions and anticipation opinions for the same claim and did not disclose obviousness combinations in Exhibit 3 of his report. (*See* Motion at 5-8). As explained above, this deposition testimony shows only that Dr. Jordan was temporarily confused by PUM's questions. *See* Statement of Relevant Facts (III), *supra*. PUM's counsel asked Dr. Jordan which claims he opined were rendered obvious by a particular reference, and Dr. Jordan initially responded by identifying the claims that he opined were only rendered obvious by that reference, *i.e.* the claims that were not also anticipated by that reference. *See id.*

PUM's ability to temporarily confuse Dr. Jordan at deposition is not grounds to strike opinions that manifestly do appear in Dr. Jordan's report, especially when, as here, his later deposition testimony resolved the confusion. The propriety of Dr. Jordan's opinions is governed by whether those opinions appear in his report, *see* Fed. R. Civ. P. 26(a)(2)(B), not whether PUM's counsel was able confuse Dr. Jordan and elicit supposed admissions in deposition. For example, in *Braun*, this Court denied a motion to strike expert opinions despite the movant's argument that these opinions "contradict [the expert's] previous deposition testimony." *Braun*, 749 F. Supp. 2d at 220-21. The Court noted that exclusion of critical evidence, such as expert reports, is an "extreme sanction, not normally to be imposed absent a showing of willful deception or flagrant disregard of a court order." *Id.* (quoting *In re Paoli R.R. Yard PCB Litig.*, 35 F.3d 717, 791-92 (3d. Cir. 1994)). So here too, the "extreme sanction" of preclusion is not

warranted merely because PUM's counsel was able to temporarily confuse Dr. Jordan at his deposition. PUM has not made any plausible showing that Google or Dr. Jordan engaged in "willful deception or flagrant disregard of a court order," as required for preclusion.

Even though Dr. Jordan incorporated Exhibit 3 into the obviousness section of his report (Ex. A, 145), and even though he elsewhere said that the Exhibit 3 claim charts "list additional references that would render each claim obvious should a finder-of-fact determine that the corresponding element is not present in the [primary] prior art reference" (*id.* at 62), PUM might argue that it was still not clear whether the prior art references listed in each cell of Exhibit 3 were obviousness combinations for the corresponding claim. Even giving PUM every benefit of the doubt on this point, and accepting PUM's assertion that it honestly did not understand that the prior art combinations in Exhibit 3 were obviousness combinations, Dr. Jordan explained in the redirect portion of his deposition that Exhibit 3 does disclose obviousness combinations. (Ex. B, 371:23-375:13; 377:23-380:3). Thus, Dr. Jordan's testimony on this point was merely an explanation of Exhibit 3, not a departure from it. It is well-settled that explanations and elaborations of prior expert testimony are proper and should not be stricken. *See Braun*, 749 F. Supp. 2d at 220; *Dow Chem. Co. v. Nova Chems. Corp.*, C.A. No. 05-737-JJF, 2010 WL 2044931, at \*2 (D. Del. May 20, 2010) (denying motion to strike based on finding that expert declarations "consist[ed] of consistent and appropriate elaborations of prior opinions and statements.")

### **Conclusion**

For the foregoing reasons, Google respectfully requests that the Court deny PUM's Motion to Strike.

Respectfully submitted,

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

**CERTIFICATE OF SERVICE**

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