

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. )  
 )  
 Counterclaimant, )  
 )  
 v. )  
 )  
 PERSONALIZED USER MODEL, L.L.P. and )  
 YOCHAI KONIG, )  
 )  
 Counterclaim-Defendants. )

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

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Google's Opposition (D.I. 449) ignores the opinions that Dr. Jordan actually disclosed in his April 11, 2012 expert report ("Jordan Report"). Google does not contest, because it cannot, that (1) in the anticipation section, Dr. Jordan identified seven references that he contends anticipate certain claims, and (2) in the obviousness section, he provided obviousness opinions for the remaining claims. (D.I. 416, at 2-5; D.I. 421, Ex. 1, at ¶¶ 130–314, 394–416.) Notwithstanding this, in the last fifteen minutes of his deposition, Dr. Jordan for the first time asserted that the anticipated claims are also obvious,<sup>1</sup> and alluded to potentially countless previously undisclosed combinations of prior art.

Google does not contest that there was no such disclosure in the obviousness section of the Jordan Report, but argues only that Exhibit 3 somehow provided an "implicit" disclosure. But Exhibit 3 does not identify any obviousness combinations.<sup>2</sup> Nor does it state why one skilled in the art would combine any of these references. Tellingly, the word "obvious" is not even mentioned in the 157 pages of charts of Exhibit 3. Google should be held to the opinions that its expert set forth in his report, and not be permitted to greatly expand the scope of its invalidity case based on so-called "implicit" disclosures (*i.e.*, disclosures that were not actually made) of potentially thousands of combinations.

The relief PUM seeks is narrowly tailored to prevent the unfair prejudice arising from Google's failure to properly disclose these new opinions. Contrary to Google's assertion,

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<sup>1</sup> This testimony occurred immediately after PUM's examination concluded and during the last 15 minutes of Dr. Jordan's deposition on redirect from Google's counsel. PUM's examination concluded immediately after a break. This "new" testimony contradicted Dr. Jordan's previous testimony where he testified that he did not have obviousness opinions for claims which he offered anticipation opinions. (D.I. 421, Ex. 2 at 371:23-373:19.)

<sup>2</sup> Google also cannot rely on boilerplate or conclusory statements in the Jordan Report, or the discussion of the alleged predictability of the inventions, because they likewise do not disclose any obviousness opinions for the claims Dr. Jordan opined are anticipated.

PUM is not seeking to strike “Google’s entire obviousness case.” (D.I. 449 at 1) (emphasis in original). Nor is PUM seeking to strike any properly disclosed obviousness combination merely because the references were also identified in Exhibit 3. (*Id.*) Instead, it is seeking to limit Google to the opinions its expert actually disclosed, which include 53 pages devoted to the issue of obviousness.

Google had an obligation to identify the particular obviousness combinations on which it would rely under Fed. R. Civ. P. 26(a)(2)(B)(i). Because it failed to do so in the Jordan Report, it should be precluded from doing so at trial.

### **ARGUMENT**

#### **I. DR. JORDAN SHOULD BE LIMITED TO THE OBVIOUSNESS OPINIONS ACTUALLY DISCLOSED IN THE JORDAN REPORT.**

Google, and its expert Dr. Jordan, had both the opportunity and the obligation to disclose in his expert report a “complete statement of all opinions the witness will express and the basis and reasons for them.” Fed. R. Civ. P. 26(a)(2)(B)(i). Dr. Jordan presumably did that in the 83-page section of his report detailing his anticipation opinions, and the 53-page section of his report detailing his obviousness opinions. Now, however, at the end of expert discovery, Google seeks to expand those obviousness opinions to include previously undisclosed opinions and combinations of prior art.

Google begins its attack on PUM’s argument by stating that “[b]ecause the opinions that PUM seeks to strike are plainly disclosed in Dr. Jordan’s report [via Exhibit 3], that should be the end of the matter.” (D.I. 449 at 2.) The issue, however, is not whether Exhibit 3 was attached to the Jordan Report but whether it actually discloses the opinions on which Google now wants to rely.

The Jordan Report nowhere discloses the new obviousness opinions that are the subject of this motion. As the table of contents of the Jordan Report reflects, Dr. Jordan identified the specific bases for his anticipation and obviousness opinions in separate sections. (See D.I. 421, Ex. 1 at Sections VI and VII.) There is no section of the Jordan Report that addresses the alleged obviousness of the claims he contends are anticipated, let alone any particular obviousness combinations. For example, Dr. Jordan alleges that claim 3 of the '276 patent is *anticipated* by Autonomy, Culliss, and Refuah; however, he does not opine that claim 3 of the '276 patent also is rendered obvious by these references, alone or in combination. Indeed, Google concedes that Dr. Jordan only offered specific obviousness opinions for claims for which he did not offer an anticipation opinion. (See D.I. 449 at 6 (“For each asserted claim that [Dr. Jordan] 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.”).)

Google also tries to rely on the conclusion in the Jordan Report that “All the Asserted Claims are Anticipated. All the Asserted Claims are Obvious.” However, Dr. Jordan offered no such opinions in the body of the report or anywhere else. Dr. Jordan also did not disclose any bases for asserting obviousness for claims he contends are anticipated, as Rule 26(a) requires. Nor is Google aided by Dr. Jordan’s discussion of the predictability of certain claims, as Google contends (D.I. 449, 13–14), because Dr. Jordan does not disclose any obviousness opinions for these claims in that section either. For example, nowhere in those pages does Dr. Jordan opine that any of the claims purportedly anticipated by a particular reference are also rendered obvious by that reference. Rather, in the 53-page section of the Jordan Report, entitled “The Asserted Claims Are Obvious In Light Of The Prior Art,” at paragraphs 394–416,

Dr. Jordan only provides opinions why claims that purportedly are not anticipated by certain references are obvious in view of those references.<sup>3</sup>

Exhibit 3 also does not identify obviousness combinations. Exhibit 3 merely cross-references sections in other charts without describing how to combine the references or why a person of ordinary skill would be motivated to do so. As Google admits, “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 [purportedly] found in the *anticipatory* reference that particular chart address.” (D.I. 449, 15) (emphasis added). Were each reference combined with only one other reference in the chart, there would be 666 new obviousness combinations. When multiple combinations, are considered—for example, in Exhibit 3-B on page 11, combining Autonomy with Schuetze and Mladenic—there are potentially thousands of previously undisclosed combinations that, if allowed, PUM and its rebuttal expert Dr. Carbonell could only guess at during trial.

Clearly, a disclosure of thousands of potential combinations does not put PUM or its expert on notice of the actual opinions that may be offered at trial. *See Oxford Gene Tech. Ltd. v. Mergen Ltd.*, 345 F. Supp. 2d 431, 437-39 (D. Del. 2004) (finding expert report on obviousness that “does not specifically discuss which elements combine to form the basis for his

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<sup>3</sup> As noted in PUM’s opening brief, Dr. Jordan’s own earlier deposition testimony supports PUM’s position. Dr. Jordan testified unequivocally that he had no obviousness opinions for claims he contends are anticipated. (D.I. 421, Ex. 2, at 258:3-6, 256:10-15, 257:5-14, 259:7-20, 265:6-13, 299:1-8, 322:16-323:9, 342:11-15, 345:7-13, 346:15-18, 347:8-13.) It was not until redirect examination by Google’s counsel that Dr. Jordan did a 180-degree pivot, changing his testimony to state that he was now offering obviousness opinions for claims he previously opined only were anticipated by a reference. (*Id.*, 373:4-19.) Google dismisses Dr. Jordan’s admissions during the majority of his deposition as temporary confusion “based on legal nuances.” (D.I. 449 at 2.) But this is mistaken. Dr. Jordan’s admissions were not the product of confused testimony. Rather, they were a reflection of what Dr. Jordan actually had disclosed in his report.

opinion” failed to satisfy Fed. R. Civ. P. 26(a)(2)(B)); *Metso Minerals, Inc. v. Powerscreen Int’l Distrib. Ltd.*, 681 F. Supp. 2d 309, 327-28 (E.D.N.Y. 2010) (precluding introduction of prior art combinations not listed in expert report); see also *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 (Fed. Cir. 2008) (affirming district court ruling precluding obviousness testimony, finding expert report failed to “state how or why a person ordinarily skilled in the art would have found the claims . . . obvious in light of some combination of those particular references.”). Pursuant to Rule 26(a)(2)(B), Dr. Jordan was required to provide in his report “the basis and reasons” of his invalidity opinions, and these omissions in his Report are not remedied by the blanket conclusions or boilerplate reservations. See *Oxford Gene Tech.*, 345 F. Supp. 2d at 437–39.<sup>4</sup>

Contrary to Google’s assertion, the relief PUM seeks is not “breathtaking.” (D.I. 449 at 12.) Nor does PUM seek to “preclude Dr. Jordan from offering any opinion of obviousness of any claim.” (*Id.*) Rather, it seeks to preclude Google from relying on obviousness combinations that it had every opportunity, but failed, to disclose. Simply put, Google cannot point to 157 pages of charts that do not identify any particular combinations, but instead merely list references by each claim element, without any discussion of the particular references one skilled in the art would combine, or why he or she would do so. PUM, and its expert, should not be left to guess as to which of the potentially thousands of combinations Google may advance at trial, or the basis for each of those opinions.

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<sup>4</sup> Furthermore, it is not PUM’s obligation to divine through a deposition what Dr. Jordan’s opinions may be or the reasons for them. It is Google’s obligation to clearly disclose the opinions and reasoning in its written expert report. See *Bonesmo v. The Nemours Found.*, 253 F. Supp. 2d 801, 811 (D. Del. 2003).



Google's reliance on *B. Braun Melsungen AG v. Terumo Medical Corp.*, 749 F. Supp. 2d 210, 220–21 (D. Del. 2010), is misplaced because, unlike in that case, Dr. Jordan's previously undisclosed obviousness opinions are not critical to Google's case. As Dr. Jordan conceded, "I thought anticipation was stronger than obviousness, and so I am asserting anticipation." (D.I. 421, Ex. 2, at 257:13–14.) Indeed, had Dr. Jordan's new opinions truly been critical, he would have properly disclosed them in his report.

Google's reliance on *Dow Chemical Co. v. Nova Chemicals Corp. (Canada)*, No. 05-737-JJF, 2010 WL 2044931 (D. Del. May 20, 2010), is also unfounded. In *Dow Chemical*, the Court found an expert declaration elaborating on processes used to reproduce an allegedly infringing product was permissible because the expert's initial declaration noted he had reproduced the allegedly infringing product, the conditions he did so in, and his belief that the reproduction was accurate. *See id.* at \*2–3. The opinions at issue here are not merely elaborations on opinions previously disclosed by Dr. Jordan. The issue here is that there was no disclosure of the obviousness opinions on which Google now wants to rely.

## **II. PRECLUSION IS PROPER BECAUSE GOOGLE'S FAILURE TO TIMELY DISCLOSE ITS NEW OBVIOUSNESS OPINIONS IS NEITHER HARMLESS NOR SUBSTANTIALLY JUSTIFIED.**

Allowing Google to proceed at trial with hundreds, if not thousands, of new obviousness combinations would be highly prejudicial to PUM (and certainly confusing to a jury). First, PUM's invalidity expert Dr. Carbonell did not have any opportunity to rebut what are still undisclosed opinions. Although Google argues that "Dr. Carbonell understood perfectly that Dr. Jordan had issued obviousness opinions for all asserted claims," all Google can point to is the similar organization of the two experts' reports. (D.I. 449 at 7.) This is meaningless. It is hardly surprising that the structure and organization of Dr. Carbonell's rebuttal report mirrors

that of Dr. Jordan's, because it serves as a rebuttal thereto. What is important is that Dr. Carbonell did not and, of course, could not rebut opinions that Dr. Jordan did not disclose as required by Rule 26(a)(2)(B). It was not until after Dr. Jordan's deposition on November 7, 2012, over a month after Dr. Carbonell submitted his rebuttal report, that Dr. Carbonell understood Exhibit 3 was meant to include thousands of possible combinations. (*See* Declaration of Jaime Carbonell in support of PUM's Reply Brief in Support of Its Motion to Strike Dr. Jordan's Late Disclosed Opinions, ¶ 3.)

Indeed, the sheer number of combinations itself is prejudicial. Not surprisingly, Google's Opposition ignores the number of combinations Google is attempting to support through Exhibit 3. This Court routinely limits the number of prior art references Defendants are allowed to take to trial, and the same reasoning should apply here. *See Intellectual Ventures I, LLC v. Checkpoint Software Techs. Ltd.*, No. 10-1067-LPS, Tr. at 19 (D. Del. Feb. 27, 2012) (Ex. A) (limiting the number of prior art references on which defendants could rely); *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.*, No. 04-1371-JJF, 2006 WL 2724879, at \*6 (D. Del. Sept. 20, 2006) (limiting Defendants to the same number of prior art references as asserted claims in the litigation (seven)). PUM should not have to respond to countless combinations that have not even been identified.

Nor is the omission substantially justified. Google and Dr. Jordan had every opportunity to set forth the opinions on which he would rely at trial. No new facts have come to light justifying this new disclosure. Nor is preclusion unduly prejudicial to Google. PUM only seeks to limit Dr. Jordan to the opinions he expressed in his report. As Dr. Jordan admitted, he chose not to address obviousness of the claims that he contends are anticipated because he did not deem them critical.

## CONCLUSION

For the foregoing reasons, Dr. Jordan should be precluded from offering any opinions as to any obviousness opinions at trial that were not disclosed in the body of the Jordan Report.

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February 8, 2013  
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**CERTIFICATE OF SERVICE**

I hereby certify that on February 8, 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 February 8, 2013, upon the following individuals in the manner indicated:

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