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.	)	

PUM'S RESPONSE TO GOOGLE'S NOTICE OF SUPPLEMENTAL AUTHORITY FOR SUMMARY JUDGMENT BRIEFING

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Google's so-called "Notice of Supplemental Authority" (D.I. 508, "Notice") should be stricken because it contains improper attorney argument in violation of D. Del. L.R. 7.1.2(b). That rule sets forth the standard briefing structure, and then states that "[e]xcept for the citation of subsequent authorities, no additional papers shall be filed absent Court approval." Google's Notice goes far beyond a "citation" of authority and instead reargues its summary judgment position. This is improper and should be rejected.

To the extent the Court is nonetheless inclined to consider the Notice, *Bayer* is inapposite to this dispute. *Bayer Healthcare Pharm., Inc. v. Watson Pharm., Inc.*, Case Nos. 2012-1397, -1398, -1400 (Fed. Cir. Apr. 16, 2013). The *Bayer* ruling was specific to the facts before the Court; those facts have no application here. The *Bayer* Court held that because the references at issue expressly disclosed the same solution to the same problem, they provided a motivation to combine for obviousness purposes. Here, in contrast, Google's prior art consists of references that provide different solutions to different problems, for example, recommending hyperlinks within a web site, or finding documents most unlike those the user has previously visited. Google does not point to any express statement in the art, as existed in *Bayer*, that would provide a motivation for a person of ordinary skill to combine the references.

The claims in *Bayer* concerned a dosing regimen for low-dose birth control. *Id.* at 3. At the time, birth control dosing conventionally used a 21/7 dosing regimen (*i.e.*, cycles of 21 days of oral contraceptives followed by 7 days of placebos). *Id.* at 7. A problem with the 21/7 dosing regimen was that a woman could become pregnant if she missed a dose. *Id.* at 5. Bayer patented 23/5 and 24/4 dosing regimens for low-dose birth control, which solved the missed-dose problem. *Id.* at 5-6.

Bayer's patent had three elements: (1) estrogen ethinylestradiol ("EE"); (2) progestin drospirenone ("DSRP"); and (3) a 23/5 or 24/4 dosing regimen. *Id.* at 11. The Court noted that, unlike here, it is not "disputed that the cited prior art references disclosed each of those limitations." *Id.* Specifically, the Court noted that an EP reference disclosed using EE on a 24/4 dosing regimen, and that an AU reference disclosed using DSRP with EE. *Id.* Moreover, the AU reference "refer[red] expressly" to the EP reference, "stating that the disclosed EE/DRSP preparations can be used 'analogously' to the [EP reference]." The AU references also "expressly incorporat[ed] the disclosed of [the EP reference] by reference." *Id.* The only issue before the Court was "whether a person of ordinary skill in the art would have been motivated to combine those teachings to derive the claimed subject matter with a reasonable expectation of success." *Id.* at 11-12.

The Court held that the prior art expressly provided the motivation to combine the teachings. *Id.* at 12. It noted that several of the references disclosed that "inadvertently extending the traditional pill-free interval via one or more missed pills could lead to escape ovulation and unintended pregnancy," *id.* at 12, and that "the references in this case go beyond just illuminating a known problem; they also expressly propose the claimed solution." *Id.* at 13. Three additional prior art references expressly disclosed using 23/5 or 24/4 dosing to solve the missed-dose problem. *Id.* at 13. Based on these facts, the Court held that "the prior art's direct recommendations to use 24/4 and 23/5 dosing regimens to minimize the risks of escape ovulation would have motivated one of ordinary skill in the art to implement such a shortened pill-free interval for use with known low-dose [birth control]." *Id.*; *see also id.* at 10 (holding that the prior art "provide express motivation to combine those teachings to derive the claimed [birth control]").

The facts here have very little in common with *Bayer*. First, in *Bayer*, unlike here, there was no dispute that every element of the claims was present in two prior art references. *Id.* at 11; *compare* PUM Opposition, D.I. 455. Second, unlike in *Bayer* where the prior art addressed the same problem and same solution, none of the cited art here contains an express statement providing motivation to combine references. Indeed, instead of identifying any express statement, Google vaguely cites to five pages of its summary judgment brief. D.I. 508, at 2. In none of those pages, however, did Google even identify any motivation to combine references. On the contrary, even a cursory examination of the references show that they purport to solve different problems in different ways.[1]

For these reasons, to the extent the Court is inclined to consider it, *Bayer* has no relevance here.

[1] For example, Wasfi sought to assist a website visitor by recommending pages from that particular website most unlike those previously visited by the user, by using a non-standard entropy calculation. Mladenic sought to aid the user in finding hyperlinks in a website based only on the text of the hyperlink, and was a system that never actually worked. Montebello sought to aid the user in web searching by sifting through search results based on a user profile, but provided no solution for accomplishing such a task. D.I. 455, at 11-12. Google attempts to oversimplify the situation by referring to all of the references as providing "personalized information services," but the references each address different issues and solve them in different ways.

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CERTIFICATE OF SERVICE

I hereby certify that on April 25, 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 April 25, 2013, upon the following individuals in the manner indicated:

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