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January 22, 2014

The Honorable Leonard P. Stark
United States District Court
844 North King Street
Wilmington, DE 19801

BY E-FILING

Re: *Personalized User Model, L.L.P. v. Google, Inc.*
C.A. No. 09-525 (LPS)

Dear Judge Stark:

Pursuant to the Court's January 21, 2014 Order (D.I. 550), we write on behalf of PUM to request the Court's assistance with two disputes that are hindering PUM's trial preparation and impeding the preparation of the Pretrial Order: (1) Google's refusal to meaningfully or timely reduce its invalidity contentions, including the number of prior art references and obviousness combinations on which it relies, and (2) Google's insistence that PUM provide its position on all issues in the case first, including on issues for which Google bears the burden of proof, notwithstanding that Google has not even provided notice of the claims it intends to pursue or the evidence on which it will rely.

Prior Art References and Invalidity Contentions

As the Court is aware from the briefing related to PUM's motion to strike the late-disclosed invalidity opinions of Google's expert, Dr. Jordan (D.I. 415), and oral argument at the May 8, 2013 hearing, Google has asserted "600 or more" anticipatory references and obviousness combinations during expert discovery (*see* 5/8/13 Tr. at 89). Whatever the exact number, the total is clearly several orders of magnitude above the number of references that could possibly be presented to a jury, something that Google's counsel has admitted. *See id.* ("Are we going to go to trial and assert every single one of these things? No, of course not.") As the Court noted in its Opinion, "Dr. Jordan's extensive opinion on obviousness theoretically encompasses hundreds of combinations of prior art, and Google will have to reduce those combinations prior to trial." D.I. 521 at 18.

Notwithstanding the Court's admonition, Google has been unwilling to timely or meaningfully reduce the number of references or obviousness combinations on which it will rely. Indeed, Google has refused to commit to identifying *any* of the prior art combinations. Despite extensive meet and confers, Google has only offered to "include no more than six references for obviousness for any asserted claim, and no more than ten references total for all claims." (Ex. 1; Jan. 9, 2014 ltr. from D. Perlson to J. Bennett at 2.) This is not a meaningful reduction because

Google has already identified the 7 references it intends to use in support of its anticipation contentions. The real issue is the number of possible obviousness combinations Google has left itself room to assert. Google has not agreed to identify any of the combinations on which it will rely and instead purports to reserve the right to assert still hundreds of potential combinations.¹ Moreover, Google has only offered to provide this “reduction” on February 5, when its sections of the Pretrial Order are due, notwithstanding its (incorrect) assertion that PUM must submit its sections of the Pretrial Order *on all issues* by January 20 (see below).

This Court has repeatedly required parties to limit their prior art contentions much earlier in a case. *See, e.g., Intellectual Ventures I, LLC v. Check Point Software Techs. Ltd.*, No. 101-1067-LPS, tr. at 19 (D. Del. Feb. 22, 2012) (ordering a reduction of prior art references prior to the *Markman* hearing) (Ex. 2). More recently, the Court has required defendants to reduce the number of references shortly after the *Markman* opinion issues. *See, e.g., Clouding IP, LLC v. Google Inc.*, No. 12-639-LPS, tr. at 25 (D. Del. Dec. 20, 2013) (“75 days after receiving the Court’s claim construction, at that point, on the 75th day, I want the language to read something to the effect that the parties will submit their proposal or proposals for the defendants to reduce the number of prior art references”) (Ex. 3). The Court’s *Markman* opinion in this case issued almost two years ago. (D.I. 347.) Google’s refusal to reduce its prior art contentions until a month before trial is unreasonable under the circumstances.

In meet and confers between the parties, Google has insisted that PUM must reduce the number of claims asserted against accused products before it can pare down its invalidity case. At Google’s insistence, however, PUM was already Ordered to reduce the number of asserted claims from 68 to 15 more than three years ago. 9/8/10 Tr. at 26. It is only currently asserting 11 claims (only two of which are independent claims). Furthermore, not all claims are asserted against all products.² Therefore, there is no basis to condition Google’s election of prior art references and obviousness combinations on a further reduction in the number of asserted claims.

PUM therefore requests that Google be required to immediately identify no more than 10 references and no more than 10 obviousness combinations on which it will rely at trial.

Pretrial Order Exchanges

PUM filed the original Complaint in this action, asserting infringement of the patents-in-suit. For its part, Google filed counterclaims seeking declaratory judgments that the patents are invalid and that it does not infringe. Google also filed a third-party complaint asserting breach of contract by Dr. Konig and seeking a declaration as to ownership of the patents-in-suit (D.I. 180). Notwithstanding that Google unquestionably bears the burden of proof on these issues, Google has insisted that D. Del. LR 16.3 requires PUM provide its sections of the Pretrial Order addressing these issues, before Google has even identified the claims it intends to pursue or the evidence on which it relies. In this way, Google seeks to preview PUM’s rebuttal case before it

¹ Assuming that Google selects potential combinations from any of 10 prior art references, PUM calculates that Google is currently reserving the right to assert as many as 210 obviousness combinations.

² For example, only three claims from the ’040 patent (and none from the ’276 patent) are being asserted against Google’s YouTube Video Recommendations service, Google+, and Google’s Topic-Based Implicit News Personalization System, respectively.

presents any disclosure of its case in chief on these issues.³ It also seeks to delay any disclosure of its case until February 5, barely a month before trial, and without leaving PUM a reasonable opportunity to respond thereto, or the parties time to meet and confer, before the Pretrial Order is due to be filed on February 19.⁴

Google's position cannot be squared with D. Del. LR 16.3(d)(1) and (2), which provide in relevant part (emphasis added):

(1) The plaintiff shall provide a draft pretrial order to all other parties ... ***The draft shall include proposed language for the sections of the pretrial order submitted by all parties, as well as the sections relating to plaintiff's case. . . .***

(2) All other parties['] ... ***responses shall include the party's response to the plaintiff's proposed language for sections of the pretrial order to be jointly submitted by all parties, as well as the sections relating to the party's case. . . .***

Thus, the Local Rule makes clear that PUM need only provide "language for the sections of the pretrial order submitted by all parties" [i.e., the joint pretrial order] and the sections [i.e., exhibits] of the Pretrial Order "relating to plaintiff's case." By its very terms, the Local Rule does not require PUM to provide sections of the Pretrial Order on all issues, but only those jointly submitted or "relating to plaintiff's case."⁵ Google ignores the fact that it is a "plaintiff" on both its declaratory judgment claims and third party complaint.⁶ Google's insistence that PUM nonetheless go first on these issues that relate to Google's, not plaintiff's, case, makes no sense, is contrary to the Local Rules, and is impeding PUM's trial preparation.

Respectfully,

/s/ Karen Jacobs

Karen Jacobs (#2881)

cc: All Counsel of Record (by e-mail)
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³ Because PUM's sections of the Pretrial Order were due on January 20, PUM has included discussion of Google's issues to the extent it was able without the benefit of having Google's portions of the Pretrial Order.

⁴ PUM had proposed a schedule by which the parties would exchange various portions of the Pretrial Order simultaneously on issues for which they bear the burden of proof, followed by simultaneous exchanges of rebuttal sections. (Ex. 4). Google refused even to discuss this proposal.

⁵ Throughout the parties' correspondence, as well as in Google's January 17 letter to the Court (D.I. 549), Google has repeatedly omitted the portion of the Local Rule that refers to sections of the Pretrial Order "relating to plaintiff's case."

⁶ In a number of contexts, this Court has rejected distinctions between "plaintiffs" and "defendants" that ignore which parties are asserting which claims in a case. For example, the provision of the Court's form patent scheduling order directed to deposition location states that "[a] defendant who becomes a counterclaimant, cross-claimant, or third-party plaintiff shall be considered as having filed an action in this Court for the purpose of this provision." ¶ 3(e)(ii).