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 **JURY TRIAL DEMANDED**
GOOGLE, INC. Counterclaimant, v. PERSONALIZED USER MODEL, LLP and YOCHAI KONIG Counterdefendants.	)	**PUBLIC VERSION**

LETTER TO THE HONORABLE LEONARD P. STARK
FROM RICHARD L. HORWITZ, ESQUIRE

Richard L. Horwitz (#2246)
David E. Moore (#3983)
Bindu A. Palapura (#5370)
POTTER ANDERSON & CORROON LLP
Hercules Plaza, 6th Floor
1313 N. Market Street
Wilmington, DE 19801
Tel: (302) 984-6000
rhorwitz@potteranderson.com
dmoore@potteranderson.com
bpalapura@potteranderson.com

Attorneys for Defendant Google Inc.

Enclosures
cc: Clerk of Court (via hand delivery)
Counsel of Record

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Potter Anderson Corroon LLP

1313 North Market Street
P.O. Box 951
Wilmington, DE 19899-0951
302 984 6000
www.potteranderson.com

Richard L. Horwitz
Partner
Attorney at Law
rhorwitz@potteranderson.com
302 984-6027 Direct Phone
302 658-1192 Fax

January 23, 2014

VIA ELECTRONIC FILING

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

PUBLIC VERSION

Re: Personalized User Model, LLP v. Google Inc., C.A. No. 09-00525-LPS

Dear Judge Stark:

Google submits this letter pursuant to the Court's January 21, 2014 Order (D.I. 550.)

PUM should narrow its asserted claims and products. PUM is currently asserting eleven asserted claims among six different products, some of which have multiple separate and distinct features accused. PUM cannot realistically expect to present all of the currently asserted claims against all the features of the currently accused products at trial. In the parties' meet and confers, PUM did not directly refute this or offer any explanation of how it could present all of the currently asserted claims. Instead, PUM stated it may reduce the asserted claims or accused products, but would not tell Google when it would do so, or even when it would decide whether to do so.

Google proposed that the parties agree to a schedule under which PUM would reduce the number of claims it will assert at trial, when its portions of the Pretrial Order were due, January 20. Google would then reduce the number of obviousness references on which it will rely when its portions of the Pretrial Order are due, February 5. PUM would not agree.

It is only fair and logical that PUM, as plaintiff, reduce its infringement case before Google reduces its invalidity case. PUM will dictate the claims that Google will need to invalidate. Google should not have to spend time and resources analyzing which prior art best fits claims that PUM is going to drop. Google's reduction of prior art may also depend on the products PUM accuses because PUM applies claim limitations inconsistently as detailed in Google's summary judgment papers. [redacted] Yet PUM's validity expert asserts that the Mladenic reference does not meet the "analyze a document" limitation of the asserted claims because it considers the URL address rather than the content of the document itself. In contrast, PUM's decisions regarding which claims or products to drop do not depend on the obviousness references Google will assert.

PUM argues that it need not reduce its asserted claims because it already reduced them under Court order in the fall of 2010. But this was before the *Markman* Order, before most of discovery, and before PUM added two additional accused products to the case. Thus, PUM should be ordered to further meaningfully reduce the number of asserted claims and/or accused

products for trial to what PUM intends to try and practically can try in the allotted time. *ReRoof Am., Inc. v. United Structures of Am., Inc.*, 215 F.3d 1351, 1999 WL 674517, *4 (Fed. Cir. 1999) (unpub.) (affirming limitation of claims the plaintiff could present at trial from 18 to 5).

Google committed to a reasonable narrowing of its invalidity case. Unlike PUM, Google committed to narrow its case—to no more than six references for obviousness for any asserted claim, and no more than ten references total for all claims. Google committed to do so by February 5, less than two weeks from now and over a month before trial. Yet, PUM seeks that Google be ordered to "immediately identify no more than 10 references and no more than 10 obviousness combinations."

Google has already agreed to reduce its invalidity case to "no more than ten references," so other than its request to get the references a week or so earlier, the crux of PUM's requested relief is to limit Google to only ten "obviousness combinations." PUM does not cite a single case to support this relief. Rather, as is clear from the parentheticals in PUM's brief, PUM's cited cases order the reduction of prior art references, which Google has already committed to do.

That PUM cites no case to support its request is not surprising, as its focus on combinations mischaracterizes the obviousness inquiry. Obviousness "is not subject to any 'rigid rule' that requires an express 'discussion of obviousness techniques of combinations' in the prior art." *Stored Value Solutions, Inc. v. Card Activation Tech., Inc.*, 796 F. Supp. 2d 520, 529 (D. Del. 2011) . Rather, *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1996) requires analysis of the scope and content of the prior art, the differences between the claimed invention and the prior art, and the level of ordinary skill in the prior art. The reasonableness of Google's position is further shown by *KSR Intern. Co. v. Teleflex, Inc.*, 550 U.S. 398, 408-409 (2007), in which the Supreme Court discussed six references in finding a single claim invalid for obviousness.

PUM's argument that Google's commitment to reduce references is insufficient also rings hollow in light of PUM's current infringement case. PUM's claims present a far broader range of issues than what Google committed to. To demonstrate infringement, PUM will need to address each element, of each asserted claim, for each accused feature, of each accused product. Google, however, will not need to show each element of each asserted claim exists for the (maximum of) six references it will assert for each claim for obviousness.[1]

PUM refuses to follow the pretrial schedule called for by the Local Rules. PUM's position as to the ordering of the exchange of portions of the pretrial order has no support in the Local Rules, or the practice before this Court, absent agreement of the parties. L.R. 16.3(c)(1) requires inclusion in the pretrial order of "[a] statement of the nature of the action, the pleadings in which the issues are raised (e.g., third amended complaint and answer) and whether counterclaims, cross-claims, etc., are involved." L.R. 16.3(c)(10) further requires inclusion of "statements by counterclaimants or cross claimants comparable to that required of plaintiff." Thus, a counterclaimant is not a "plaintiff." The distinction between pretrial order disclosures for a plaintiff and other parties is further made clear in Rule 16.3(d)(1), which requires that the "plaintiff" provide its portions of the Pretrial Order at least 30 days before the deadline to file it.

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[1] PUM's claim that Google will rely on "as many as 210 obviousness combinations" is based on the incorrect assumption that combining Reference A with Reference B is different, and should be counted separately as combining Reference B with Reference A, etc…

It makes no mention that counterclaimants provide their portions on this date. Instead, Rule 16.3(d)(2) says "[n]o less than 14 days before the pretrial order is to be filed with the Court, all other parties shall provide the plaintiff and each other party with their responses to the plaintiff's draft order." Google raised these points with PUM, but PUM does not address them in its letter.

Although the Local Rules provide that the plaintiff must provide the sections relating to "plaintiff's case" as PUM argues, "plaintiff's case" is not limited to the issues on which plaintiff bears the burden of proof. If it was, the Local Rules would include a time for plaintiff to respond to a counterclaimant's portions of the Pretrial Order. They do not.[2]

PUM's suggestion that its position is reasonable because Google has not identified the claims it intends to pursue or the evidence on which it relies is without merit. Google disclosed its theories and contentions in discovery. That PUM does not know the exact evidence Google will present at trial (just as Google does not know the exact evidence PUM will present at trial) does not mean that PUM cannot address Google's counterclaims. Nor is it clear what disclosures from Google PUM needs. The statements of facts provided in PUM's portions of the Pretrial Order are very general; PUM could provide the same level of detail on all issues now. (Ex. A.) Although it is unclear what PUM omitted from the disclosures it made on January 20, PUM may add to its already lengthy exhibit and witness lists, and provide additional deposition designations sometime after February 5. There is not time for PUM to do so, and then for the parties to exchange objections and counter-designations prior to the filing of the Pretrial Order on February 19. Similarly, PUM's disclosures relating to Google's counterclaims may impact the issues on which Google files motions in *limine*. If PUM makes disclosures after February 5, the time for exchanging motions in *limine* prior to February 19 will be very compressed. There simply is not time for a third set of disclosures not contemplated by the Local Rules.[3] Any evidence or argument not timely disclosed by PUM should be excluded, Google should be permitted to present its invalidity and ownership cases first and be realigned as plaintiff, or PUM should be ordered to provide its portions of the Pretrial Order and trial be postponed to a time that works for the Court and the parties.

Google additionally seeks relief from PUM's voluminous trial exhibit list. PUM's list includes over 1500 exhibits, which it cannot reasonably expect to use at trial. It is prejudicial to require Google to prepare objections to this voluminous set of documents. PUM should be ordered to reduce the number of trial exhibits to no more than 500 (and provide copies) no later than January 28.

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[2] PUM argues that in some contexts, this Court has rejected distinctions between "plaintiffs" and "defendants," citing the Court's form patent scheduling order regarding deposition locations. But, the Court's standing order or form orders say nothing about altering the Local Rules' schedule for exchanging portions of the Pretrial Order. Thus, the Local Rules govern.

[3] Although PUM claimed it would be ready for trial in March 2014, and insisted that trial go forward then, PUM waited until December 30 to propose altering the pretrial schedule. It was Google that approached PUM on December 19, 2013 with a proposed schedule that set forth deadlines for those events that are not covered by the Local Rules, such as the deadline exchange objections and counter-designations to deposition designations. (Ex. B.) Google's schedule followed the Local Rules wherever they provided a deadline.

Respectfully,

/s/ Richard L. Horwitz

Richard L. Horwitz

RLH:nmt/1137841/34638

Enclosures
cc: Clerk of Court (via hand delivery)
Counsel of Record