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

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

OF COUNSEL:

Charles K. Verhoeven
David A. Perlson
Antonio R. Sistos
Margaret Pirnie Kammerud
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
50 California St.
San Francisco, CA 94111
Tel.: (415) 875-6600

Joshua Lee Sohn
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
777 6th Street NW, 11th Floor
Washington, DC 20001-3706
Tel: (202) 538-8000

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

Andrea Pallios Roberts
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
555 Twin Dolphin Drive, Suite 560
Redwood Shores, CA 94065
Tel.: (650) 801-5000

Attorneys for Defendant Google Inc.

Dated: February 7, 2014
Public Version Dated: February 14, 2014
1139455/ 34638

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

February 7, 2014; Public Version Dated
February 14, 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 in response to PUM's February 7, 2014 letter to the Court. (D.I. 573.) Google does not believe that any of the issues raised by PUM warrant burdening the Court prior to the Pretrial Conference. In fact, PUM's complaints are actually motions *in limine* which seek to preclude Google from relying on evidence. PUM should not be permitted to bring additional issues in a piecemeal fashion outside of the normal procedures of the Court, especially given the nature of the issues it raises. To the extent that the Court permits PUM to do so, Google requests that it have the opportunity to file letter briefs addressing these disputes.

1. PUM cannot show that Google should be precluded from relying on Dr. Pazzani's articles as prior art to the patents-in-suit. Google identified them as prior art in an interrogatory response served on June 9, 2011. And Google questioned Dr. Pazzani about those articles during his deposition. Thus, PUM has long been on notice that Google considered his articles to be prior art. That Google's invalidity expert did not rely on them does not mean they are inadmissible. PUM does not cite any case which indicates that Google can be precluded from providing evidence of the state of the art separate and apart from what an expert relies on. Nor could it. Obviousness is a question of law, and "precedent does not require 'expert' opinions on matters of law." *Soverain Software LLC v. Newegg Inc.*, 705 F.3d 1333, 1336, 1341 (Fed. Cir. 2013); *see also Friskit, Inc. v. RealNetworks, Inc.*, 499 F. Supp. 2d 1145 (N.D. Cal. 2007), *aff'd per curiam*, 306 Fed. Appx. 610 (Fed. Cir. 2009) (granting summary judgment of obviousness without relying on expert testimony). PUM also cannot demonstrate any prejudice here. Not only is Dr. Pazzani under PUM's control as its expert, but Google has advised PUM that it is willing to rely only on Dr. Pazzani's deposition testimony regarding his articles, rather than calling him live, if PUM agrees that it will not present live testimony from Dr. Pazzani regarding his articles or otherwise open the door to the articles during Dr. Pazzani's testimony. PUM's effort here is simply to eliminate evidence it does not like.

2. PUM also cannot show that Google should be precluded from relying on the testimony of Mr. Montebello. Google disclosed Mr. Montebello in its Initial Disclosures on May 4, 2011, his

article was disclosed as prior art in an interrogatory response served on May 12, 2011, and Google's invalidity expert relied on his article as anticipatory prior art. And while PUM suggests that Google should have disclosed Mr. Montebello earlier as a "trial witness," Google disclosed him as a trial witness the day such disclosures were due, January 31, 2014. Here too, there is no prejudice. PUM made no effort to take any discovery as to any prior witness throughout the case, and never even asked Google which prior art witnesses it might rely on at trial during discovery. Nevertheless, and notwithstanding the fact that it is well after the close of fact discovery, Google has told PUM it would not object to Mr. Montebello (who resides in Malta and is not in Google's control) being deposed in the U.S. prior to trial. Google proposed that Mr. Montebello travel to the U.S. early for trial and be deposed prior to the start of trial when counsel will likely all be in Wilmington, which Mr. Montebello is willing to do. PUM has put forward no valid reason why it would need the deposition of this third party witness before then. Further, the testimony of a prior art inventor or author is admissible. *See e.g.*, *Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 687, 689 (Fed Cir. 1985) (holding asserted patent anticipated by prior art patent, based in part on testimony of the prior art patent's inventor). Here too, PUM is just seeking to exclude evidence it believes is harmful to its case.

3. PUM has further failed to demonstrate that Google should be precluded from relying on live testimony regarding the accused [redacted] functionality. When PUM reopened fact discovery in the summer of 2012 to take discovery on Google's [redacted] functionality, Google provided a 30(b)(6) witness to testify on the company's behalf regarding that functionality. That witness, Max Ventilla, has since left Google. Accordingly, in the course of Google's trial preparations, Google sought to identify whether any of its already-disclosed witnesses were competent to testify regarding the accused [redacted] functionality. Google promptly informed PUM that one of two trial witnesses who Google disclosed years ago in the case, and that PUM has already deposed on other issues, may testify about [redacted]. Google made clear that these witnesses' testimony would be within the scope of the 30(b)(6) topics noticed by PUM. Google should not be limited to presenting Mr. Ventilla's deposition testimony as PUM suggests. PUM is effectively demanding that Google present a cross-examination by PUM on the accused [redacted] functionality, and that Google is precluded from presenting its own direct examination. There is little to no prejudice to PUM in Google having a witness testify within the scope of the topics PUM itself noticed for deposition. In contrast, there is real prejudice to Google if it cannot present live testimony from a Google employee regarding an accused product.[1]

4. The number of potential live witnesses on Google's witness list is a direct result of PUM's own trial witness list and the unreasonable breadth of PUM's infringement case. PUM designated deposition testimony from 15 Google witnesses (current and former Google employees) and 24 witnesses total. It is unlikely that PUM intends to play all of the deposition testimony it designated. Indeed, Google estimates that PUM's designations would run nearly 34 hours, far beyond the maximum of 22 hours that PUM will be allotted *for the entire trial.* Yet, PUM has steadfastly refused to narrow its case. PUM takes issue with the fact that Google listed 13 of those Google witnesses as potential live witnesses. In other words, PUM apparently believes that it will need to rely on these witnesses' testimony to prove its infringement claims,

---

[1] PUM's actual motivation in seeking to preclude this testimony may be to prevent Google from presenting testimony that the accused [redacted] functionality is about to be abandoned, something PUM indicates in its pre-trial submissions that it seeks to do.

but is seeking to preclude Google from having the ability to rely on those same witnesses' testimony to rebut PUM's claims. This is patently unfair.

Google is willing to work with PUM cooperatively to reduce the scope of the case, including the witnesses to be called. But, Google has explained to PUM that it cannot narrow its witness list if PUM does not do so first and, more importantly, if PUM does not first reduce the number of accused products. If a product is dropped from PUM's case, then Google can drop from its witness list those witnesses who would testify about that product. If products remain in the case, however, then Google needs to have the right to call its witnesses with knowledge about that product to rebut whatever points PUM makes in its case-in-chief. Thus, to the extent that the Court is going to address this issue in advance of the Pretrial Conference, Google requests that the Court order PUM to narrow the scope of the case before Google is required to narrow its witness list.

5. Finally, to the extent that the Court is going to address these issues in advance of the Pretrial Conference, Google requests that the Court clarify that when PUM serves its "revised" trial exhibit list, that it should be substantially reduced in size. It currently includes over 1500 exhibits. Google asked PUM to confirm that the "revised" list will be substantially reduced, but PUM only stated it "will comply with the Court's order" without saying what that means. Google raises this issue now so that the parties do not end up in the same dispute regarding the reasonableness of PUM's exhibit list next week. PUM cannot possibly expect to use even a small fraction of the exhibits on its list at trial. Google should not have to spend the time and resources analyzing and preparing objections to these voluminous exhibits which will never appear at trial.

Respectfully,

/s/ Richard L. Horwitz

Richard L. Horwitz

RLH:mah/1139455/34638

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