

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)

REDACTED - PUBLIC VERSION

GOOGLE, INC.)

Counterclaimant,)

v.)

PERSONALIZED USER MODEL, L.L.P. and)

YOCHAI KONIG,)

Counterclaim-Defendants.)

[PROPOSED] FINAL PRETRIAL ORDER

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FOR THE DISTRICT OF DELAWARE

PERSONALIZED USER MODEL, L.L.P.,)
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Plaintiff,)
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GOOGLE, INC.,) C.A. No. 09-525 (LPS)
) **REDACTED - PUBLIC VERSION**
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PERSONALIZED USER MODEL, L.L.P. and)
YOCHAI KONIG,)
)
Counterclaim-Defendants.)

[PROPOSED] FINAL PRETRIAL ORDER

This matter comes before the Court at a final pretrial conference held pursuant to Rule 16 of the Federal Rules of Civil Procedure and Rule 16.3 of this Court. The parties are Plaintiff and Counterclaim-Defendant Personalized User Model, L.L.P. (“PUM”), Counterclaim-Defendant Yochai Konig and Defendant and Counterclaimant Google, Inc. (“Google”).

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I. Nature of the Case

1. This is a patent infringement action filed by Plaintiff PUM against Defendant Google. PUM alleges that Google infringes U.S. Patent Nos. 6,981,040 (“the ’040 Patent”) and 7,685,276 (“the ’276 Patent”) (collectively “the Patents-in-Suit”).

2. Google denies that it has infringed the Patents-in-Suit. Google further alleges that the asserted claims of the Patents-in-Suit are invalid. Google also filed counterclaims for a judicial declaration that it does not infringe any of the asserted claims of the Patents-in-Suit and that the asserted claims of the Patents-in-Suit are invalid. Google additionally filed a third party complaint and counterclaim for a judicial declaration that Google is a co-owner of the Patents-

in-Suit. Google further counterclaims for breach of contract by named inventor of the Patents-in-Suit Yochai Konig of his employment agreement with his former employer, conversion by PUM and Dr. Konig, and imposition of a constructive trust against PUM and Dr. Konig.

3. PUM denies that Google's claims have any merit and further contends that Google's claims are time-barred under the applicable statute of limitations and the doctrine of laches. PUM further contends that Dr. Konig's inventions are protected by Section 2870 of the California Labor Code.

II. Jurisdiction and Venue

4. PUM contends that subject matter jurisdiction over this action is proper under 28 U.S.C. §§ 1331, and 1338(a). Google believes that this matter must be dismissed for lack of standing and, thus, lack of subject matter jurisdiction upon resolution of Google's counterclaims. Further, Google understands that in denying its motion to dismiss for lack of standing, the Court rejected Google's assertion that title never passed to PUM because PUM did not exist as a legal entity at the time Levino Ltd. assigned the patents-in-suit to PUM. Google addresses this question of standing in **Exhibit 19** and requests clarification of the Court's finding on this issue.

5. Venue is proper under 28 U.S.C. §§ 1391(b), (c) and 1400(b) and the Court has personal jurisdiction over the parties for purposes of this action.

III. Facts

A. Uncontested Facts

6. Attached as **Exhibit 1** are facts that are not disputed or have been agreed to or stipulated to by the parties, and require no proof at trial.

B. Contested Facts

7. PUM's statement of the issues of fact that remain to be litigated, and its intended proofs, is attached as **Exhibit 2**.

8. Google's statement of the issues of fact that remain to be litigated, and its intended proofs, is attached as **Exhibit 3**.

IV. Issues of Law

9. PUM's statement of the issues of law that remain to be litigated is attached as **Exhibit 4**.

10. Google's statement of the issues of law that remain to be litigated is attached as **Exhibit 5**. Google has identified in this Exhibit the issues that it believes are questions of law to be decided by the Court.

V. Witnesses

11. PUM has identified in **Exhibit 6** the fact and expert witnesses it intends to call at trial, and has identified which witnesses will testify live, and which will testify by deposition.

12. Google has identified in **Exhibit 7** the fact and expert witnesses it intends to call at trial, and has identified which witnesses will testify live, and which will testify by deposition.

13. PUM's designations of deposition testimony that it may use at trial, along with Google's counter-designations and all objections to PUM's designations, PUM's objections to Google's counter-designations, and PUM's counter-counter designations, are attached as **Exhibit 8**. PUM also reserves the right to counter-designate any testimony that Google has designated, but that Google withdraws before or during trial.

14. Google's designations of deposition testimony that it may use at trial, along with PUM's counter-designations and all objections to Google's designations, Google's objections to PUM's counter-designations and Google's counter-counter designations are attached as **Exhibit 9**. Google also reserves the right to counter-designate any testimony that PUM has designated, but that PUM withdraws before or during trial.

15. The parties reserve the right to serve objections to the opposing party's counter-counter designations and will file those objections by February 25, 2014.

16. No witness called by a party shall be permitted to testify at trial if the witness was not identified pursuant to this Order, unless the Court determines that good cause exists and that in the interests of justice such witness should be called.

17. The listing of a witness on a party's witness list does not require the party to call that witness to testify, and does not mean that the listing party has the power to compel the live testimony of that witness.

18. The parties shall provide a list identifying the specific witnesses that they intend to call on direct, and the order in which they will be called, by 7:00 p.m. two days before they intend to call those witnesses at trial. This list shall be updated nightly by 7:00 p.m. so long as the party has remaining witnesses it intends to call on direct for their portion of the case.

19. Each party shall identify which witnesses will be called live and which will be offered by deposition. Except for good cause shown, each party shall be bound to call the witnesses identified in its list in the manner identified (*i.e.*, live or by deposition). As part of this notice, each party will provide specific deposition excerpts that it intends to introduce by 7:00 p.m. **[PUM's proposal: four days] [Google's proposal: three days] before** the start of the trial day on which that witness's testimony will be offered (*i.e.*, witnesses to be called by deposition on Monday must be disclosed by 7:00 p.m. the preceding **[PUM's proposal: Thursday] [Google's proposal: Friday]**, along with their proposed testimony). The other side must identify any objections to the designated testimony and any counterdesignations no later than **[PUM's proposal: 24 hours after the witnesses and deposition excerpts have been disclosed] [Google's proposal: 10:00 pm three days before the trial day on which that witness's testimony will be offered]**. The parties shall meet and confer as to any objections no

later than **[PUM's proposal: 10:00 p.m. the day the objections and counterdesignations are provided]** **[Google's proposal: 7:00 p.m. two days prior to the day the testimony will be played]**. To the extent that there are objections remaining after the parties meet and confer, the objecting party shall file a letter with the Court by 9:30 p.m. two days prior to the day the testimony will be played, identifying the objections and the bases for the objections. If the deposition testimony is going to be played in court by video, the party offering the deposition testimony in its case-in-chief shall provide a copy of the video to be played to the opposing party by 9:00 p.m. the night before the testimony is to be played.

20. The parties may call at trial some or all of the witnesses listed in the Joint Pretrial Order or offer at trial some or all of the deposition testimony set forth in the Joint Pretrial Order. A party's decision not to **[PUM's proposal: call any witness or]** introduce any deposition testimony appearing in the Joint Pretrial Order shall not be commented on during trial.¹

21. Any deposition testimony not specifically identified on a party's deposition designation list may still be used at trial for the purpose of impeachment, if otherwise competent for such purpose.

22. For those depositions that have been recorded by video, a party may introduce the deposition excerpt by video instead of or in addition to by transcript. If a party opts to introduce deposition testimony by video, any counter-designations of that same witness's deposition testimony must also be submitted by video. When deposition designation excerpts are introduced, all admissible deposition counter-designation excerpts, whether offered by video or by transcript, will be introduced simultaneously in the sequence in which the testimony was originally given, subject to the resolution of any objections to the designated or counter-

¹ Google does not believe that a blanket preclusion against any reference to any witness not appearing at trial is appropriate.

designated testimony. To the extent such designations are read or played in open court, each party will be charged for the time taken to read or play its designations, as measured by the proportion of lines of testimony for its designations to the total number of lines of testimony read or played.

VI. Exhibits

A. Exhibits

23. The parties will offer at trial one or more of the exhibits set forth in their respective lists. These exhibit lists include exhibits that may be introduced at trial but not necessarily be admitted as evidence. The exhibit lists may also include certain documents relied upon by experts in rendering opinions, which will not necessarily be admitted into evidence. The parties reserve the right to seek to supplement their exhibit lists to add documents newly produced by the opposing party, or in further rebuttal to information newly disclosed by the opposing party, without conceding that any such newly produced or disclosed documents or information is appropriate.

24. Each exhibit list contains all of the exhibits² that a party intends to present at trial other than solely for impeachment. With the exception of those exhibits used solely for impeachment, exhibits not listed on a party's exhibit list or on the opposing party's exhibit list will not be admitted unless good cause is shown.

25. The parties agree that any description of a document on an exhibit list is provided for convenience only and shall not be used as an admission or otherwise as evidence regarding the listed document or any other listed document.

26. PUM's list of pre-marked exhibits that it may offer at trial is attached as **Exhibit 10.**

² Demonstrative exhibits shall not be listed, and their exchange is addressed separately.

27. Google's list of pre-marked exhibits that it may offer at trial is attached as **Exhibit 11**.

28. The parties will file their objections to the opposing party's pre-marked exhibits by February 21, 2014.

29. Exhibits that a party seeks to move into evidence to which no objection has been made will be received into evidence by operation of the Final Pretrial Order without the need for additional foundation testimony once introduced by a testifying witness. Every exhibit offered into evidence must be formally moved into evidence.

30. The parties' Stipulation Regarding Documentary Evidence remains in effect. (D.I. 300.)

31. Any trial exhibit, including source code, that was produced in discovery by a party that on its face appears to have been authored by an employee, officer, or agent of the party producing such document, shall be deemed to be a true and correct copy of a document maintained in that party's files as of the date of the party's document collection under Federal Rule of Evidence 901.

32. Any trial exhibit that is a publication or article that was produced in discovery by a party that on its face appears to have not come from that party's files, shall be deemed to be a true and correct copy of that publication or article from the source it originates under Federal Rule of Evidence 901. To the extent the publication or article (or corresponding bibliographic data) specifies a date of that document (e.g., timing of publication, print, authorship, disclosure, etc.) and/or the source (e.g., name of journal or proceedings), that publication or article shall be attributed with such date and/or source specified.

33. Legible photocopies of United States and foreign patents, published applications, and the contents of their associated file histories may be offered and received into evidence in

lieu of certified copies thereof, subject to all other objections that may be made to the admissibility. In addition, copies of such documents are deemed to be authentic under the Federal Rules of Evidence, including Rule 901.

34. None of the foregoing stipulations in paragraphs 31-33 shall serve as a waiver of any other objections a party may have to the trial exhibits, or abrogate the requirement that the party offering the document into evidence satisfy any other rules governing the admissibility of evidence set forth in the Federal Rules of Evidence, the Federal Rules of Civil Procedure, Local Rules, the Court's individual practices, or any other applicable rule or regulation. The parties agree to meet and confer in good faith to resolve objections to trial exhibits prior to their introduction at trial.

35. The parties reserve the right to add additional deposition designations solely to establish the foundation and authenticity of an exhibit to the extent the admissibility of a particular document is challenged.

36. A party may not add exhibits to its exhibit list after the date the Final Pretrial Order is entered by the Court, except for good cause shown or by agreement of the other party. Any party may use an exhibit that is listed on the other party's exhibit list, to the same effect as though it were on its own exhibit list, subject to all evidentiary objections. Any exhibit, once admitted at trial, may be used equally by each party for any proper purpose in accordance with the Federal Rules of Evidence. The listing of a document on a party's exhibit list is not an admission that such document is relevant or admissible when offered by the opposing party for the purpose that the opposing party wishes to enter the document into evidence. The fact that an exhibit is listed on a party's exhibit list does not mean that party believes the exhibit would be admissible if offered by the other party. If a party attempts to introduce an exhibit listed only on

the other party's exhibit list, the listing party reserves the right to object to such introduction, and need not list objections to its own exhibits as part of the Pretrial Order.

37. On or before the first day of trial, counsel will deliver to the Courtroom Deputy a completed AO Form 187 exhibit list for each party.

38. Any non-demonstrative exhibits to be used with any live witnesses on direct examination must be identified no later than **7:00 p.m. [PUM's proposal: two nights before] [Google's proposal: the night before]** the start of the trial day on which that witness's testimony will be offered (*i.e.*, non-demonstrative exhibits for witnesses to be called on Monday must be disclosed by 7:00 p.m. the preceding **[PUM's proposal: Saturday] [Google's proposal: Sunday]**). Objections shall be provided no later than **[PUM's proposal: 7:00 p.m. the night before the exhibits are to be offered] [Google's proposal: 9:00 p.m. the night before the exhibits are to be offered]**. **The parties shall meet and confer regarding any objections by 10:00 p.m. the night before the exhibits are to be offered**. If good faith efforts to resolve the objections fail, the party objecting to the exhibits shall bring its objections to the Court's attention prior to the witness being called to the witness stand.³

39. Each side shall provide direct-exhibit binders to opposing counsel and to the Court at the beginning of each direct examination. Each side shall provide cross-exhibit binders to opposing counsel and to the Court at the beginning of each cross examination. There is no duty to identify cross-examination exhibits prior to cross examination. Neither will providing a cross-exhibit binder prevent a party from using exhibits not originally included in that binder that are required as a result of the direct examination.

³ It is Google's position that if a party calls an adverse witness live as part of their case, that party does not need to disclose the non-demonstrative exhibits to be used on direct examination. In that case, the party with whom that witness is associated is required to disclose the non-demonstrative exhibits to be used with that witness in cross-examination by the time stated in this paragraph.

40. Any document not offered into evidence may still be used at trial for the purpose of cross-examination, impeachment, refreshing recollection, rehabilitation, or other proper purpose, if otherwise competent for such purposes.

B. Demonstrative Exhibits

41. Demonstrative exhibits need not be included in the parties' respective exhibit lists. Except for demonstratives to be used in opening and closing statements, animations and demonstratives, including those used direct examination, shall be provided to opposing counsel no later than **7:00 p.m. [PUM's proposal: two nights before] [Google's proposal: the night before]** their intended use at trial (*i.e.*, animations and demonstratives to be used on Monday must be disclosed by 7:00 p.m. the preceding **[PUM's proposal: Saturday] [Google's proposal: Sunday]**). This agreement does not include demonstrative exhibits to be used solely for the purpose of cross-examination.⁴ If any of demonstratives are added or changed after the deadline for exchange, the party intending to use the new or changed demonstrative shall promptly notify the opposing party of the additions or changes.

42. The other side shall identify any objections to animations and demonstratives no later than **[PUM's proposal: 7:00 p.m.] [Google's proposal: 9:00 p.m.] the night before** their intended use at trial. **[PUM's proposal: The parties will cooperate in seeking to have the Court resolve prior to the proposed testimony any objections they are unable to resolve among themselves.] [Google proposal: The parties shall meet and confer regarding any objections by 10:00 p.m. the night before the exhibits are to be offered. If good faith efforts to resolve the objections fail, the party objecting to the demonstrative exhibits shall**

⁴ It is Google's position that if a party calls an adverse witness live as part of their case, that party does not need to disclose the demonstrative exhibits to be used on direct examination. In that case, the party with whom that witness is associated is required to disclose the demonstrative exhibits to be used with that witness in cross-examination no later than 7:00 p.m. the night before their use during trial.

bring its objections to the Court's attention prior to the witness being called to the witness stand.]

43. The parties agree to exchange demonstratives to be used in opening statements no later than March 9, 2014, at **[PUM's proposal: 3:00 p.m.] [Google's proposal: 7:00 p.m.]** The parties shall meet and confer to resolve any possible disputes or objections to such demonstratives on March 9, 2014, at or before 9:00 p.m. Demonstratives to be used in closing statements shall be exchanged no later than 7:00 p.m. the night before closing arguments. The parties shall meet and confer to resolve any possible disputes or objections at or before 9:00 pm.

44. The provisions of the preceding paragraphs governing demonstratives do not apply to demonstratives created during testimony or demonstratives to be used for cross-examination, neither of which need to be provided to the other side in advance of their use. In addition, blow-ups or highlights of exhibits of parts of exhibits or testimony made at trial are not required to be provided to the other side, so long as these demonstratives were not prepared in advance of their use.

45. If good-faith efforts to resolve objections to animations and demonstrative exhibits fail, the objecting party shall bring its objections to the Court's attention prior to opening or closing statements, or prior to the applicable witness being called to the witness stand.

VII. Bifurcated Trial

46. Damages and willfulness are bifurcated. In addition, there are certain legal and equitable issues for the Court to decide, as set forth in **Exhibits 4, 5, 12, 18, and 19.**

VIII. Motions *in Limine*

47. The opening, opposition, and reply briefs concerning PUM's first motion *in limine* are attached as **Exhibit 12.**

48. The opening, opposition, and reply briefs concerning PUM's second motion *in limine* are attached as **Exhibit 13**.

49. The opening, opposition, and reply briefs concerning PUM's third motion *in limine* are attached as **Exhibit 14**.

50. The opening, opposition, and reply briefs concerning Google's first motion *in limine* are attached as **Exhibit 15**.

51. The opening, opposition, and reply briefs concerning Google's second motion *in limine* are attached as **Exhibit 16**.

52. The opening, opposition, and reply briefs concerning Google's third motion *in limine* are attached as **Exhibit 17**.

IX. Discovery

53. The parties have completed discovery.

X. Number of Jurors

54. There shall be eight jurors. The Court will conduct jury selection through the "struck juror" method.

XI. Length of Trial

55. The jury trial is set for 10 days of trial, and will be timed, with each side to receive a maximum of 22 hours.⁵ (D.I. 537, 4.) Time will be charged to a party for its opening statement, direct and redirect examinations of witnesses it calls, cross-examinations of witnesses called by any other party, and closing argument. The Courtroom Deputy, with the assistance of the parties, will keep a running total of trial time used by counsel.

⁵ Google does not believe that ten full days will be required for trial. Rather, as stated in the parties' September 30, 2013 Joint Status Report, depending on the number of products PUM ultimately presents at trial, Google believes that 8 days should be allocated to trial. (D.I. 529, 3.)

XII. Amendments of the Pleadings

56. The parties are not seeking any amendments of the pleadings at this time.

XIII. Additional Matters

57. A brief list of miscellaneous issues that PUM wishes to address at the pretrial conference is set forth in **Exhibit 18**.

58. A brief list of miscellaneous issues that Google wishes to address at the pretrial conference is set forth in **Exhibit 19**.

59. The list of prior art references and "combinations" for obviousness ordered by the Court is set forth in **Exhibit 20**.⁶

XIV. Settlement

60. The parties certify that they have engaged in a good-faith effort to explore the resolution of the controversy by settlement, including by mediation conducted on January 23, 2014, before Magistrate Judge Thyng.

IT IS HEREBY ORDERED that this Final Pretrial Order shall control the subsequent course of the action, unless modified by the Court to prevent manifest injustice.

DATE

UNITED STATES DISTRICT JUDGE

⁶ As set forth in PUM's Miscellaneous Issues, PUM asserts that certain of these combinations were not properly disclosed.

APPROVED AS TO FORM AND SUBSTANCE:

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