

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

PERSONALIZED USER MODEL, L.L.P.,)	
)	
Plaintiff,)	
)	
v.)	
)	
GOOGLE, INC.,)	
)	
Defendant.)	
<hr/>		C.A. No. 09-525 (LPS)
GOOGLE, INC.,)	
)	
Counterclaimant,)	
)	
v.)	
)	PUBLIC VERSION -
PERSONALIZED USER MODEL, L.L.P.)	REDACTED
and YOCHAI KONIG,)	
)	
Counterclaim-Defendants.)	

**OPENING BRIEF IN SUPPORT OF PERSONALIZED USER MODEL, L.L.P. AND
YOCHAI KONIG’S MOTION FOR JUDGMENT AS A MATTER OF LAW ON THE
INFRINGEMENT AND VALIDITY OF THE PATENTS-IN-SUIT AND ON
GOOGLE’S BREACH OF CONTRACT COUNTERCLAIM**

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TABLE OF CONTENTS

	<u>Page</u>
I. PUM AND DR. KONIG ARE ENTITLED TO JMOL ON GOOGLE’S BREACH OF CONTRACT COUNTERCLAIM.	1
A. Google Did Not Present Sufficient Evidence To Prove That The Statute Of Limitations Was Tolloed.	1
B. Google Did Not Acquire SRI’s Right To Bring A Breach Of Contract Claim.	5
1. The Plain Language Of The Purchase Agreement Did Not Convey SRI’s Breach Of Contract Cause Of Action To Google.	5
2. The Assignment Of A Cause Of Action Must Be Express.	6
C. Google Failed To Prove That Dr. Konig “Conceived” Of The Invention While Working At SRI.	8
D. PUM Met Its Burden Of Proving That The Patented Inventions Did Not Result From The Work Dr. Konig Did At SRI And Was Not Related To Work Being Done By or Contemplated By SRI At That Time.	10
1. The Invention Was Not Related To The Work Being Done By Or Contemplated By SRI.	10
2. The Invention Did Not Result From the Work Dr. Konig Did at SRI.	12
II. PUM IS ENTITLED TO JMOL THAT THE ACCUSED PRODUCTS INFRINGE.	13
III. PUM IS ENTITLED TO JMOL ON GOOGLE’S CLAIMS OF INVALIDITY.	15
A. A Reasonable Jury Would Not Have A Legally Sufficient Evidentiary Basis To Determine The Asserted Claims Are Anticipated.	16
1. Google Presented Insufficient Evidence that the Mladenic Prior Art Reference Discloses Every Claim Limitation of Claim 1 of the ’040 Patent And Presented Insufficient Evidence Mladenic Renders Obvious Claim 1 of the ’276 Patent.	16

2.	Google presented insufficient evidence that the Mladenic prior art reference renders obvious Claim 1 the '276 patent.....	17
3.	Google Presented Insufficient Evidence that the Montebello Prior Art Reference Discloses Every Claim Limitation of Claim 1 of the '040 Patent or Claim 1 of the '276 Patent.....	17
4.	Google Presented Insufficient Evidence that the Wasfi Prior Art Reference Discloses Every Claim Limitation of Claim 1 of the '040 Patent.....	18
5.	Google Presented Insufficient Evidence that the Dependent Claims are Obvious.....	18
B.	A Reasonable Jury Would Not Have a Legally Sufficient Evidentiary Basis to Determine Invalidity as to Obviousness.	19
	CONCLUSION.....	20

TABLE OF AUTHORITIES

Page(s)

CASES

Arachnid, Inc. v. Merit Indus., Inc.,
939 F.2d 1574 (Fed. Cir. 1991).....7

Brandwein v. Butler,
218 Cal. App. 4th 1485 (Cal. App. 4th Dist. 2013)5, 6

Britton v. Co-op Banking Grp.,
4 F.3d 742 (9th Cir. 1993)5

Burrage v. U.S.,
No. 12-7515, 571 U.S. ___, 134 S. Ct. 881 (Jan. 27, 2014).....12

Cent. Mortg. Co. v. Morgan Stanley Mortg. Capital Holdings LLC,
No. 5140-CS, 2012 WL 3201139 (Del. Ch. Aug. 7, 2012).....2

Co-opportunities, Inc. v. Nat’l Broad. Co., Inc.,
510 F. Supp. 43 (N.D. Cal. 1981)7

Dyna–Med, Inc. v. Fair Employment & Housing Comm’n
43 Cal. 3d 1379 (Cal. App. 1987)7

Graham v. John Deere Co. of Kansas City,
383 U.S. 1 (1966).....19

Hopp v. City of Pittsburgh,
194 F.3d 434 (3d Cir. 1999)1

In re Jeannette Corp.,
130 B.R. 460 (Bankr. W.D. Pa. 1991).....7

Jones v. Cooper Indus., Inc.,
938 S.W.2d 118 (Tex. App. 1996).....7

Mangini v. Aerojet–Gen. Corp.,
230 Cal. App. 3d 1125 (1991)3

Medtronic Vascular, Inc. v. Advanced Cardiovascular Sys., Inc.,
No. 98-80-SLR, 2005 WL 388592 (D. Del Feb. 2, 2005).....2, 3

Medtronic Vascular, Inc. v. Advanced Cardiovascular Sys., Inc.,
No. 98-80-SLR, 2005 WL 46553 (D. Del. 2005)2

<i>Norman v. Elkin</i> , 726 F. Supp. 2d 464 (D. Del. 2010)	2
<i>Pomeranz v. Museum Partners, L.P.</i> , No. 20211, 2005 WL 217039 (Del. Ch. Jan. 24, 2005)	3, 4
<i>Rapoport v. Dement</i> , 254 F.3d 1053 (Fed. Cir. 2001).....	16
<i>Robotic Vision Sys., Inc. v. View Eng'g. Inc.</i> , 189 F.3d 1370 (Fed. Cir. 1999).....	15
<i>Rockwell Int'l Corp. v. U.S.</i> , 147 F.3d 1358 (Fed. Cir. 1998).....	16
<i>Univ. of W. Va., Bd. of Trs. v. VanVoorhies</i> , 342 F.3d 1290 (Fed. Cir. 2003).....	7
OTHER AUTHORITIES	
11 Williston on Contracts (4th ed.1999) § 30.2.....	5
RULES AND STATUTES	
10 Del. C. § 8106	1
10 Del. C. § 8117	2
10 Del. C. § 8121	1
35 U.S.C. § 102.....	15, 16
35 U.S.C. § 103.....	15
35 U.S.C. § 282.....	15
California Labor Code § 2870.....	1, 10, 13
Federal Rule of Civil Procedure 50(a)	1

Pursuant to Rule 50(a) of the Federal Rules of Civil Procedure, Personalized User Model, L.L.P. (“PUM”) and Dr. Yochai Konig move the Court to grant judgment as a matter of law (“JMOL”) in their favor in furtherance of the stipulation that the parties may amplify their oral JMOLs in writing within three days. (D.I. 645.) This is PUM’s brief in support of that motion.

LEGAL STANDARD

Under Federal Rule of Civil Procedure 50(a), this Court should grant JMOL against the non-moving party when “it has been fully heard on an issue and there is no legally sufficient evidentiary basis for a reasonable jury to find for that party on that issue.” JMOL is appropriate where “the record is critically deficient of the minimum quantity of evidence from which a jury might reasonably afford relief.” *Hopp v. City of Pittsburgh*, 194 F.3d 434, 439 (3d Cir. 1999).

ARGUMENT

I. PUM AND DR. KONIG ARE ENTITLED TO JMOL ON GOOGLE’S BREACH OF CONTRACT COUNTERCLAIM.

Google failed to put forth sufficient evidence on which a reasonable jury could conclude that Dr. Konig breached his employment contract with SRI by assigning the patents to Utopy. Google’s claim is that Dr. Konig’s Employment Agreement required him to assign to SRI all inventions that he conceived during his employment that are related to SRI’s business or research as of 1999. JMOL is proper because: (1) Google’s claim is time-barred; (2) Google failed to prove it obtained the right to bring SRI’s breach of contract claim; (3) Google failed to prove that Dr. Konig conceived of the invention in the patent law sense while employed at SRI; and (4) PUM proved that the invention is protected by § 2870 of the California Labor Code.

A. Google Did Not Present Sufficient Evidence To Prove That The Statute Of Limitations Was Tolloed.

It is undisputed that Delaware’s borrowing statute applies such that the breach of contract claim is subject to Delaware’s three-year statute of limitations. 10 Del. C. §§ 8121, 8106.

Unless tolled, the breach of contract claim expired long ago, because Google contends that Dr. Konig breached the contract fourteen years ago when he assigned the patent to his invention to Utopy. *Medtronic Vascular, Inc. v. Advanced Cardiovascular Sys., Inc.*, No. 98-80-SLR, 2005 WL 46553, at *4 (D. Del. 2005) (“Medtronic I”) (period typically begins to “run at the time of the alleged wrongful act even if the plaintiff is ignorant of the cause of action”). The burden to prove tolling falls on Google. *See Norman v. Elkin*, 726 F. Supp. 2d 464, 470 (D. Del. 2010) (“Plaintiff maintains the burden of proving that the statute of limitations is tolled.”). Further, 10 Del. C. §8117 does not apply for the reasons set forth in PUM’s separate submission on this issue, which PUM incorporates by reference herein. (D.I. 610, 626).

Google did not put forth sufficient evidence to prove that SRI’s alleged injury was “inherently unknowable.” The inherently unknowable injury doctrine is a “narrowly confined exception” that tolls the statute of limitations only “where it would be practically impossible for a plaintiff to discover the existence of a cause of action.” *Cent. Mortg. Co. v. Morgan Stanley Mortg. Capital Holdings LLC*, No. 5140-CS, 2012 WL 3201139, at *22 (Del. Ch. Aug. 7, 2012). To toll the statute of limitations, Google must prove that it would have been practically impossible for SRI to discover the alleged wrongful assignment of the ’040 patent to Utopy. Even where “this ‘narrowly confined’ exception applies,” the statute, begins to run again when the plaintiff “becomes aware of facts sufficient to put [the plaintiff] on inquiry which, *if pursued*, would lead to the discovery [of the injury].” *Id.* at *22 (emphasis added). Patents are constructive notice of such facts because they put “the world on notice with respect to what the patentee claims to own and starts the limitations period running.” *Medtronic Vascular, Inc. v. Advanced Cardiovascular Sys., Inc.*, No. 98-80-SLR, 2005 WL 388592, at *2 n.4 (D. Del Feb. 2, 2005).

[REDACTED]

[REDACTED]

[REDACTED]

But that is not the correct test. Google confuses what SRI’s alleged injury was and focuses on only part of the inquiry. SRI’s alleged injury was not the *conception* of the patented invention, but rather the purportedly wrongful assignment of the patent to Utopy.

[REDACTED]

[REDACTED]

[REDACTED] Further, SRI was on constructive inquiry notice when the ’040 patent issued in 2005, listing Dr. Konig as inventor and Utopy as its assignee, and listing on its face a December 1999 filing date, only a few months after Dr. Konig left SRI. PTX 1; *Medtronic*, 2005 WL 388592, at *2 n.4. Google presented no evidence to support that the actual notice of the invention in 2001, and the constructive notice of the invention, application date, and assignment in 2005 would not have at least put SRI on inquiry notice to determine if it had a claim. The application date and subject matter claimed in the ’040 patent, and the assignment to Utopy, were not practically impossible to discover as a matter of law. *Medtronic*, 2005 WL 388592, at *2 n.4.

In addition, to have “inquiry notice,” SRI need not have known when Dr. Konig conceived the invention, but merely needed to have enough information to warrant investigation. *Pomeranz v. Museum Partners, L.P.*, No. 20211, 2005 WL 217039, *13 (Del. Ch. Jan. 24, 2005) (“Once a plaintiff is on notice of facts that ought to make her suspect wrongdoing, she is obliged to diligently investigate and to file within the limitations period as measured from that time.”).¹

¹ See also *Mangini v. Aerojet-Gen. Corp.*, 230 Cal. App. 3d 1125, 1130 (1991) (Under analogous California law, “[s]ubjective suspicion is not required. If a person becomes aware of

Google offered no evidence that SRI did not know or could not have known sufficient facts to prompt further investigation. And indeed, the only evidence presented showed that SRI had notice of Dr. Konig's invention and could have pursued additional information had it wanted to do so. Google offered no evidence to suggest that SRI investigated at all. The only evidence came from Mr. Montes, [REDACTED]

In addition, Google's argument that "conception" was inherently unknowable presupposes that conception occurred prior to Dr. Konig leaving SRI and could only be determined by reviewing the confidential July 1999 Utopy slides. Tr. at 1987:11-14. Yet, Google does not contest what all the evidence supports (*see* § C *infra*): that conception according to the Court's definition did not occur until *after* Dr. Konig left SRI. 5/8/2013 Tr. 111:15-16; 111:20-23 ("[W]e acknowledge in our briefs we are not asserting that all the strictures of a patent law conception date were achieved by July '99 . . ."). Thus, the confidential slides and the fact that Dr. Konig did not disclose his invention prior to leaving SRI are red herrings.

SRI knew or easily could have known that Dr. Konig filed his patent application on December 28, 1999, a few months after he left SRI, PTX 1, and that an SRI engineer beta tested the invention a year after Dr. Konig left SRI. PTX 275. Thus, no reasonable jury could find that SRI did not have knowledge of facts that would lead a reasonable plaintiff "to diligently investigate and to file within the limitations period as measured from that time." *Pomeranz*, 2005 WL 217039, at *13. Once SRI had actual notice of invention by 2001 and constructive notice by 2005, SRI had a duty to inquire whether it had any claim. No reasonable jury could

facts which would make a reasonably prudent person suspicious, he or she has a duty to investigate further and is charged with knowledge of matters which would have been revealed by such an investigation.").

find that it was “practically impossible” for SRI to learn of the alleged injury after these dates.² As a result, JMOL should be entered that Google did not provide sufficient evidence to establish that the inherently unknowable exception was met.

B. Google Did Not Acquire SRI’s Right To Bring A Breach Of Contract Claim.

There is no record evidence to support Google’s claim that the Purchase Agreement conveyed a right to bring a breach of contract claim against Dr. Konig. Google has the burden to prove that it has standing to bring this claim. *See Britton v. Co-op Banking Grp.*, 4 F.3d 742, 746 (9th Cir. 1993) (“An assignee of a contractual right must prove the validity of his ownership claims.”). The Purchase Agreement must be interpreted under California law. DTX 412 § 9.6. “Whenever possible,” courts “attempt to discern the parties’ intent first from the plain language of the contract.” *Brandwein v. Butler*, 218 Cal. App. 4th 1485, 1505 (Cal. App. 4th Dist. 2013) (quoting 11 Williston on Contracts (4th ed.1999) § 30.2, p. 16).

Two years after PUM filed this lawsuit, [REDACTED] Google now claims that these rights included any breach of contract claim that SRI may have had against Dr. Konig. But the plain language of the Purchase Agreement, Federal Circuit precedent, and canons of contractual interpretation refute this assertion as a matter of law. Further, Google failed to provide any evidence at all to meet its burden of proving that it acquired a breach of contract claim (and not just speculative patent rights). Indeed, other than enter the Purchase Agreement into evidence, Google offered no proof and did not bring a single witness to trial to testify about the Purchase Agreement.

1. The Plain Language Of The Purchase Agreement Did Not Convey SRI’s Breach Of Contract Cause Of Action To Google.

² It is thus irrelevant that Dr. Konig did not disclose his invention before he left SRI.

The plain language of the Purchase Agreement conveyed to Google only “speculative” patent rights and causes of actions pertaining to those patents, and specifically called out that SRI made [REDACTED]

[REDACTED] The Agreement conveyed [REDACTED]

[REDACTED]

[REDACTED]

Id. at § 4.2(c) (emphasis added). As these provisions show, the agreement conveyed patents, and causes of action and enforcement rights for infringement and royalties relating to the patents, and nothing more. There is no mention of a breach of contract claim.

Reading the entire Purchase Agreement “as a whole,” *Brandwein*, 218 Cal. App. 4th at 1505, confirms this. Section 1.2 of the Agreement states in full what SRI believed it was selling to Google (“Seller wishes to sell to Google *any rights it has in the Patents*”). DTX 412 at § 1.2. Likewise, [REDACTED]

[REDACTED] Accordingly, there is no plausible reading that would encompass the conveyance of more than “Patent Rights.”

2. The Assignment Of A Cause Of Action Must Be Express.

Google cannot sidestep the plain language of the Purchase Agreement by arguing that it implicitly includes a breach of contract claim.³ The law is clear that a conveyance of a cause of action must be express and cannot be implied, because a cause of action is an independent asset

³ Nor can Google claim that a breach of contract claim was necessary to perfect such rights, because Dr. Konig no longer held any patent rights that could be returned to SRI. Rather any action to perfect such rights had to be brought against the owner of such rights.

with its own monetary value. *In re Jeannette Corp.*, 130 B.R. 460, 463 (Bankr. W.D. Pa. 1991) (holding that party was not entitled to debtor’s settlement proceeds where Asset Purchase Agreement did not specifically include causes of action); *Co-opportunities, Inc. v. Nat’l Broad. Co., Inc.*, 510 F. Supp. 43, 46-47 (N.D. Cal. 1981) (“Although Mr. McGee arguably assigned his copyrights and ‘all’ the assets of BMC to plaintiff, there is no specific assignment of accrued causes of action.”).

The Federal Circuit has also made clear that the assignment of a patent does not include accrued causes of action, even if the causes of action relate to the patent, unless the assignment expressly states that it does. *See Arachnid, Inc. v. Merit Indus., Inc.*, 939 F.2d 1574, 1579 (Fed. Cir. 1991) (“assignment [of right to damages for an infringement committed before such assignment] **must be express**, and cannot be inferred from an assignment of the patent itself.”) (emphasis added); *see also Univ. of W. Va., Bd. of Trs. v. VanVoorhies*, 342 F.3d 1290, 1295 (Fed. Cir. 2003) (determining that scope of patent assignment agreement is limited by its plain language); *Jones v. Cooper Indus., Inc.*, 938 S.W.2d 118 (Tex. App. 1996) (assignor did not lose cause of action for breach of agreement concerning patents after patents were transferred).

Because Google cannot point to any language that expressly conveys a breach of contract claim, that asset was not conveyed. The doctrine of *expressio unius est exclusio alterius* dictates “that ‘the expression of certain things in a contract necessarily involves exclusion of other things not expressed.’” *Dyna–Med, Inc. v. Fair Employment & Housing Comm’n* 43 Cal. 3d 1379, 1391, n.13 (Cal. App. 1987). Applying that doctrine here, SRI conveyed only those causes of action relating to “enforcement rights under, or on account of, any of **the Patents . . .**” Any other causes of action, including any breach of contract claim, were thus excluded.

It was Google's burden to prove that SRI sold a breach of contract claim against Dr. Konig in addition to its alleged patent rights. Yet *Google offered no evidence* on this point. When a party with the burden of proof fails to offer any evidence, that failure is dispositive of its claim.

C. Google Failed To Prove That Dr. Konig “Conceived” Of The Invention While Working At SRI.

Google also had the burden to prove that Dr. Konig breached his contract by failing to assign an invention he “conceived . . . during the period of [his] employment” with SRI, which ended on August 5, 1999. Tr. 1028:6-8; 1090:7-12; DTX 163. As construed by the Court, conception is given its patent law definition: “the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention, such that, if the idea were communicated to a person having ordinary skill in the field of the technology, he or she would be able to make the invention without undue research or experimentation or the exercise of inventive skill.” Jury Instruction 5.3 (D.I. 663).

Yet, in response to the Court's question, Google conceded at the summary judgment hearing that it was not asserting that conception occurred under the patent law definition while Dr. Konig was working for SRI. 5/8/2013 Tr. 111:15-16 (“We are not making that assertion”); *see also* 111:20-23. Consistent with that, Google did not prove at trial that Dr. Konig conceived of the invention under the patent law definition while employed at SRI. Google's focus throughout the trial was on proving merely that Dr. Konig had “the idea” for the invention while at SRI, and on arguing that, contrary to the Court's construction, this was sufficient for conception. Tr. 1075:15-20; Tr. 1962:12-14 (arguing that “as early as '98, early '99, way, way before he left SRI, [Konig] was already talking about *this idea* with Mr. Twersky,”); Tr. 1967:16-17. But merely having an “idea” for an invention is not the test. As the Court

explained, “someone with just an abstract idea cannot transfer ownership of that idea because no ownership rights exist in ideas.” Tr. 1859:10-12.

Google relied on two marketing documents Dr. Konig and Mr. Twersky used to attract investors, which described their general goal and framework in the summer of 1999. *See, e.g.*, DTX 0151, DTX 161. Google offered no evidence whatsoever, however, that one skilled in the art could “make the invention without undue research or experimentation or the exercise of inventive skill” based on the information contained in those documents.

The only scientific evidence presented at trial demonstrated that Dr. Konig conceived of the invention *after* leaving SRI.⁴ Dr. Konig did not begin to find a solution that could be implemented until after he left SRI in August 1999. Tr. 1028:6-8; 1090:7-12. This is consistent with every other statement Dr. Konig has made regarding the conception date in this case. [REDACTED]

[REDACTED]

[REDACTED]

⁴ Google relied heavily on the testimony of Mr. Twersky and erroneous interrogatory responses served earlier in the case. [REDACTED]

[REDACTED]

[REDACTED] In other words, Mr. Twersky made clear that he was not using the Court’s definition of conception when he was first deposed and that Dr. Konig was the authority on the topic. Accordingly, Mr. Twersky’s testimony was not probative of “conception” under the Court’s definition. [REDACTED]

[REDACTED] Google cannot rely on conflicting testimony or conflicting interrogatory responses to overcome its burden of proof, where Google offered no evidence at all to establish that one skilled in the art could have made the invention without undue experimentation based on the July slides. Because there was a complete absence of any such evidence, and the only testimony (*e.g.*, Tr. 1099:2-14) [REDACTED]

[REDACTED] JMOL should be granted.

Corroborating Dr. Konig's testimony, [REDACTED]

[REDACTED]
[REDACTED] Google presented no competent evidence of any disclosure of an actual user model before Dr. Konig left SRI. Accordingly, Google failed to show that Dr. Konig conceived his invention while at SRI or that he had any obligation to assign the patents to SRI. Thus no breach occurred as a matter of law.

D. PUM Met Its Burden Of Proving That The Patented Inventions Did Not Result From The Work Dr. Konig Did At SRI And Was Not Related To Work Being Done By or Contemplated By SRI At That Time.

Dr. Konig's employment agreement with SRI specifically exempted the assignment of inventions to SRI if such inventions qualify for an exclusion under § 2870 of the California Labor Code. DTX 0163. It is undisputed that Dr. Konig developed his invention on his own time and without using SRI resources. Tr. 1083: 15-16; Tr. 1083:23-1084:6; 1942; 1978:11-25; 1979:1-10 ("We don't have any evidence to contradict [this].") Because neither exception of § 2870 applies, the inventions are protected from assignment under § 2870.

1. The Invention Was Not Related To The Work Being Done By Or Contemplated By SRI.

The patents-in-suit do not "relate to" SRI's business simply because Dr. Konig used computers and machine learning. There was no evidence whatsoever that SRI was in the business of developing computers or machine learning. As SRI business person, Douglas Bercow, testified, SRI's business consisted of four research labs: Artificial Intelligence (AI), speech technology, computer science and vision technology. TR. 1673-74. The only evidence was that SRI *applied* long-existing machine learning tools to various areas of research. *See, e.g.*, Tr. 1655:19-1656:12; 1664:4-1666:7. Two former SRI engineers, Drs. Sonmez and Stolcke, testified that the same machine learning techniques Dr. Konig used at SRI were standard tools in

any machine learning professional's tool kit. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] [REDACTED] [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

The only witness on whom Google relied was Mr. Bercow, but Mr. Bercow was a business person, and he explicitly deferred to the head of the Artificial Intelligence Center, which was Dr. Perrault, as the proper person to consult about project details. Tr. 1680: 8-24. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] and Google offered no evidence that SRI – the entity in the best position to know -- *ever* expressed a belief that Dr. Konig’s invention related to any SRI business or research and development during the relevant time frame.

2. The Invention Did Not Result From the Work Dr. Konig Did at SRI.

Personalized internet searches or ads do not “result from” Dr. Konig’s speech recognition work. The California Labor Code does not define what “results from” means. But the Supreme Court recently explained that the statutory language “results from” must be interpreted narrowly, such that the patented invention would not have been created “but for” the work Dr. Konig performed for SRI. *Burrage v. U.S.*, No. 12-7515, 571 U.S. ___ at *10, 134 S. Ct. 881, 889 (Jan. 27, 2014) (“It is one of the traditional background principles against which Congress legislates that a phrase such as ‘results from’ imposes a requirement of but-for causation.”) (internal citations omitted).

Dr. Konig testified that his work at SRI involved statistical models relating to speech and speech recognition technologies. Tr. 446:23-447:9; 1084:14-16. Dr. Stolcke confirmed that Dr. Konig’s work was confined to speech recognition and speaker verification. Tr. 1667:3-6. Personalized search information is completely different because “you are working with different materials, if you will, and you have to provide a different output.” Tr. 1085:4-6. Drs. Sonmez and Stolcke each testified that the subject matter of the patents had nothing to do with what Dr. Konig worked on at SRI. Tr. 1663:15-22 (“I don’t recall any of these applications being specifically proposed or thought about by the people that I knew at SRI.”); Tr. 1658:16-1659:1 (“these patents to not seem, to me, in any way linked to what he was doing at SRI”). Dr. Franco confirmed that the STAR Lab “extracts[s] information from speech,” and that there were no projects at the STAR Lab during 1996-99 relating to personal internet search. Tr. 1154:1-7; 1157:15-18.

There was no evidence that Dr. Konig's invention would not have been created "but for" his speech recognition work at SRI. Dr. Konig confirmed that the technology behind the patents-in-suit was developed at Utopy, not SRI, and that the statistical models he used were completely different from those applied to speech. Tr. 1074:11-14; 1084:7-1085:6; 1086:15-1087:14. Moreover, Dr. Konig testified regarding his extensive background in machine learning and speech recognition prior to his employment at SRI. Tr. 432:21-443:25; *see also* Tr. 1665:10-15 (Dr. Stolcke: "[Dr. Konig's] experience is in evidence in his thesis, so therefore, it must have predated his work at SRI."); Tr. 1658:16-1659:1 (Dr. Sonmez: "These actually -- in terms of topic, [the patents-in-suit] do not relate to anything that STAR Lab did at that point in time. . . . [T]hese patents do not seem, to me, in any way linked what he was doing at SRI."). As a result, no reasonable jury could find that the patented inventions were not exempt from assignment under Section 2870 of the California Labor Code.

II. PUM IS ENTITLED TO JMOL THAT THE ACCUSED PRODUCTS INFRINGE.

PUM demonstrated that each of Google's Search, Search Ads, Content Ads, and YouTube products infringe the asserted claims as a matter of law. Google did not even challenge that its products practiced: (i) the preambles of both the '040 and '276 patents, (ii) element 1(a) of the '040 patent and the "transparently monitoring ..." element of the '276 patent, and (iii) the receiving a search query and retrieving documents based on a search query elements of the '276 patent (for Search and Search Ads). Because PUM presented sufficient evidence to demonstrate that each of these elements is met, they cannot be disputed. *See* Testimony of Google engineers (Horling (Tr. 517:12-534:25, 1364:8-1383:22), Jeh (Tr. 535:10-538:1), Oztekin (Tr. 538:3-542:20), Havieliwala (Tr. 543:3-544:4), Golpalratnam (Tr. 544:14-552:17), Zamir (565:23-582:13), Ponnekanti (582:19-589:11), Weinberg (Tr. 591:2-

592:13), Illowsky (Tr. 592:19-596:15), Nemeth (Tr. 597:6-601:1), Testimony of Michael Pazzani (Tr. 601:24-608:2, 638:15-906:3, 929:1-936:10, 1002:10-1006:6), Testimony of Google's expert (Fox) (Tr. 1459:13-1480:21, 1604:20-1623:10), PTX 0011, PTX 0017, PTX 0022, PTX 0024, PTX 0115, PTX 0370, PTX 0395, PTX 0404. PUM also demonstrated that Google's Accused Products practiced each of the dependent claims. (Claim 22 – Tr. 867:14-873:10, PTX 0373, PTX 0375, PTX 0035, PTX 0378, PTX 0403, PTX 0404, PTX 0406, PTX 1268); (Claim 3 – Tr. 929:3-932:7, PTX 373, PTX 375); (Claim 7 – Tr. 932:9-934:6, PTX 436, PTX 407, PTX 1268, Zamir Tr. 565:23-582:13); (Claim 21 – Tr. 934:9-936:10, PTX 372, PTX 0386, PTX 0399, PTX 437).

PUM also demonstrated that each Accused Product performed each of the disputed claim elements. *See* PUM's Response to Opposition to Google's Motion for Judgment as a Matter of Law on Non-Infringement (D.I. 665) and the evidence cited therein, all of which is incorporated by reference. To summarize, PUM demonstrated that each accused Google Product performs:

- element 1(b) of the '040 patent, including that ads are documents or the equivalent of documents (Tr. 744:14-769:20, 1471:11-1478:14, 1479:2-1480:21, PTX 0576, PTX 0012, PTX 0013, PTX 0014, PTX 0015, PTX 0022, PTX 0140, PTX 0220, PTX 0356, PTX 0357, PTX 0365, PTX 0372, PTX 0373, PTX 0375, PTX 0376, PTX 0395, PTX 0399, PTX 0401, PTX 0403, PTX 406, PTX 0407, PTX 0408, PTX 0409, PTX 1113, PTX 1312, previously cited Google engineer testimony) and the “analyzing the monitored data to determine documents of interest to the user” step of the '276 patent (Tr. 876:10-881:4, PTX 0015, PTX 0373, PTX 0375, PTX 0403);
- element 1(c) of the '040 patent (Tr. 772:9-813:5, and the “estimating parameters of a user-specific learning machine ...” element of the '276 patent (Tr. 881:5-886:5, PTX 0022, PTX 0025, PTX 0095, PTX 0030, PTX 0112, PTX 0113, PTX 0213, PTX 0033, PTX 0034, PTX 0037, PTX 0038, PTX 0069, PTX 0076, PTX 0098, PTX 0223, PTX 0373, PTX 0375, PTX 0376, PTX 0379, PTX 0397, PTX 0398, PTX 0404, PTX 0869, PTX 0770);
- element 1(d) of the '040 patent (Tr. 813:6-820:1) and the “identifying properties of retrieved documents ...” portion of the '276 patent (Tr. 895:13-900:13, 898:8-899:18, 1479:2-1480:7 (Fox), PTX 0016, PTX 0403, PTX 0017, PTX 0024, PTX 0025, PTX 0030, PTX 0037, PTX 0115, PTX 018, PTX 0222, PTX 0397, PTX 0399, PTX 0400, PTX 0401, PTX 0402, PTX 0407, PTX 0408, PTX 0411, PTX 0413, PTX 0443, PTX 0876, PTX 0942, PTX 1457,

1458, 1462), and the previously cited Google engineer testimony);

- element 1(e) of the '040 patent (Tr. 820:2-859:11) and the “applying the identified properties ... to the user-specific learning machine ...” step of the '276 patent (Tr. 897:8-899:18, PTX 0017, 0022, 0024, 0030, 0097, 0115, 0180, 0200, 0222, 0382, 0385, 0397, 0400, 0401, 0402, 0408, 0413, 0433, 0729, 0730, 0942, 1457, 1458, 1462, previously cited testimony of Google engineers);
- element 1(f) of the '040 patent (Tr. 859:14-866:25) and the “using the estimated probabilities ...” element of the '276 patent (Tr. 900:25-905:3, PTX 0039, PTX 0041, 0044, 0110, 0200, 0223, 0403), including on the "presenting" portion of that element (Tr. 900:25-902:14, 903:25-906:3, 1621:23-1622:19, PTX 0017, PTX 0110).

In addition, PUM demonstrated that the receiving a search query and retrieving a plurality of documents⁵ based on that query elements of the '276 patent was performed by each of Google's Accused Products. Google did not dispute these elements for Google Search and Search Ads, but in any event the elements are performed. (Tr. 889:17-890:19 PTX 0017, 0024, 0115). The elements are also performed for Content Ads/YouTube. (Tr. 890:16-895:10, PTX 0407, 0416, Illowsky (Tr. 594:12-595:13), Zamir (Tr. 571:10-18)).

III. PUM IS ENTITLED TO JMOL ON GOOGLE'S CLAIMS OF INVALIDITY.

Google asserts that the patents-in-suit are invalid as anticipated under 35 U.S.C. § 102 and invalid as obvious under 35 U.S.C. § 103. Google has a heavy burden because the patents are presumed valid. 35 U.S.C. § 282. Google had to prove invalidity by clear and convincing evidence. *Robotic Vision Sys., Inc. v. View Eng'g. Inc.*, 189 F.3d 1370, 1377 (Fed. Cir. 1999).. Google failed to prove by clear and convincing evidence that any of the references anticipated

⁵ The term “document” should not have been construed to include an “electronic file” requirement, but even with that requirement, PUM showed that the Accused Products met the “documents associated with a user” limitation. In addition, PUM showed that the Accused Products learn over time, and the Court never determined that there was a minimum period of time required for infringement as Google argued. Finally, Google erroneously argued that its products do not meet the “estimating parameters” limitation because Google's estimates are too precise, but Dr. Fox agreed that a precise number can still be an estimate.

any claims of the two patents-in-suit. Throughout his testimony, Dr. Jordan failed to apply the claim language of the elements to his analysis, and for this reason alone, Google failed to provide clear and convincing evidence of anticipation. Also, Google failed to bring forth clear and convincing evidence that any of the combinations of the references rendered obvious any claims of the two patents-in-suit. Accordingly, JMOL is appropriate and necessary in this case.

A. A Reasonable Jury Would Not Have A Legally Sufficient Evidentiary Basis To Determine The Asserted Claims Are Anticipated.

To anticipate a claim under 35 U.S.C. §102, a single prior art reference must disclose every limitation of the claim. *Rockwell Int'l Corp. v. U.S.*, 147 F.3d 1358, 1363 (Fed. Cir. 1998). Anticipation is a question of fact that is shown only by rigorous proof. *See Rapoport v. Dement*, 254 F.3d 1053, 1057–58 (Fed. Cir. 2001).

1. Google Presented Insufficient Evidence that the Mladenic Prior Art Reference Discloses Every Claim Limitation of Claim 1 of the '040 Patent And Presented Insufficient Evidence Mladenic Renders Obvious Claim 1 of the '276 Patent.

Mladenic fails to teach at least claim limitations 1(c)-(f) of the '040 patent. DTX 264. Dr. Jordan presented insufficient evidence Mladenic anticipates these limitations. With respect to limitation 1(c), Dr. Jordan failed to identify the learning machine and the parameters that would be estimated by the learning machine. Tr. 1229:19-1230:13. Dr. Carbonell testified Mladenic teaches that the k-nearest neighbor approach is a non-parametric method and contains no parameters. Tr. 1702:3-20. This is undisputed.

With respect to claim limitation 1(d), Dr. Jordan testified that hyperlinks are not documents. Tr. 1296:24-25. Dr. Jordan's testimony corroborates Dr. Carbonell's testimony regarding claim 1(d). Dr. Carbonell also testified that Mladenic "does not operate documents. It operated on hyperlinks." Tr. 1703:8-18. Hyperlinks and documents are very different. *Id.*

Because Mladenec recommended only hyperlinks not actual documents, Mladenec never analyzes or considers the file to which the hyperlink points.

With respect to claim limitations 1(e) or 1(f), Mladenec teaches mapping to Boolean categories not actually mapping to probabilities. Tr. 1704:15-1705:10. Dr. Jordan testified that Boolean categories are not probabilities. Tr. 1297:14-15. Boolean categories are two-valued logic and, therefore, Boolean categories cannot be probabilities. Tr. 1704:15-1705:10. The Court's construction is also constructive as defining "probability" to mean "a numerical degree of belief or likelihood." Tr. 1615:11-12.

2. Google presented insufficient evidence that the Mladenec prior art reference renders obvious Claim 1 of the '276 patent.

By Dr. Jordan's own admission, the Personal WebWatcher System did not teach combining search with this system. Tr. 1298:8-16. Moreover, Mladenec could not be combined with any search system since Mladenec was a navigation system. Tr. 170:18-1707:8. Joachims WebWatcher was also a navigation system, it too did not receive any queries and therefore, could not cure the missing "query" elements from claim 1 of the '276 patent and render the claim obvious. Moreover, Joachims indisputably an aggregate model, not a personalized model. *Id.*

3. Google Presented Insufficient Evidence that the Montebello Prior Art Reference Discloses Every Claim Limitation of Claim 1 of the '040 Patent or Claim 1 of the '276 Patent.

Montebello fails to teach (and Dr. Jordan presented insufficient evidence) claim limitations 1(c), 1(e), and 1(f) of the '040 patent, and the related limitations of the '276 patent, namely claim limitations 1(c), 1(f) and 1(g). With respect to claim limitation 1(c) of both patents. Dr. Jordan incorrectly testified that a "bag of words" was sufficient to meet the Court's construction to "parameters" that the court defined as weights or coefficients used in forming a similarity or match score. Tr. 1230:4-1231:7. These values are not learned. Dr. Carbonell

testified that this limitation 1(c) also fails because Montebello does not disclose any learning machine. Tr. 1713:6-10; 1714:2-17. For at least the same reason, Montebello does not teach limitations 1(e) and 1(f) of the '040 patent and 1(f) and 1(g) of the '276 patent. Moreover, each of these limitations requires “a probability.” Dr. Jordan testified that Montebello did not explicitly teach generating a match score and did not teach logistic regression. Tr. 1282:16-1283:12. Dr. Carbonell testified that Montebello provides no support to claim that match scores are inherent nor does Montebello disclose match scores or any synonyms of “match score.” Tr. 1715:10-12, 1714:18-1715:21.

4. Google Presented Insufficient Evidence that the Wasfi Prior Art Reference Discloses Every Claim Limitation of Claim 1 of the '040 Patent.

Wasfi fails to teach claim limitations 1(c), (e), and (f) of the '040 patent. Claims limitation 1(c) requires “parameters” and limitations 1(e) and 1(f) require “a probability.” Dr. Jordan testified that the similarity score in Wasfi, defined by the stochastic entropy, ranges from minus infinity to infinity. Tr. 1294:5-9. Dr. Carbonell testified that Dr. Jordan was incorrect in evaluating Wasfi’s entropy equation. Tr. 1717:21-17:19:9. By teaching the wrong equation, Wasfi actually teaches away from or the opposite of the intention of the patents, does not estimate any “parameters” or “probabilities.” Tr. 1717:17-1720:12. The entropy equation was not only incorrect, but Wasfi returns websites that are most different from the user interests. Tr. 1719:2-9.

5. Google Presented Insufficient Evidence that the Dependent Claims are Obvious.

Dr. Jordan presented insufficient evidence from which a reasonable jury could conclude that Claim 22 is obvious. Tr. 1283:20-1284:24. Contrary to Dr. Jordan’s testimony, Refuah does not disclose a sequence of interaction times or provide any motivation to combine the two.

Tr. 1722:1-15. Refuah focuses on improving the user experience through the look and feel of the web site whereas the '040 patent focuses on getting the right information to the user to provide a personalized search. Tr. 1723:9-1724:6. Moreover, because Mladenic operated on hyperlinks, the Personal WebWatcher system could not even use a sequence of interaction times.

Google also presented insufficient evidence that the Montebello prior art reference in view of Refuah discloses Claims 3, 7, and 21 the '276 patent. Refuah does not teach the additional limitations of the dependent claims. For example, Refuah does not disclose search, therefore, claim 21, requiring the relevance of the document to the query fails. Tr. 1723:21-22. Moreover, there would be no motivation to combine Montebello and Refuah. Tr. 1723:13-14, Tr. 1724:3-6. Montebello was just a position paper and one of ordinary skill in the art would not look to Montebello. And Refuah does not address the information overload problem but rather the look and feel of the browser. Tr. 1723:23-1724:2.

B. A Reasonable Jury Would Not Have a Legally Sufficient Evidentiary Basis to Determine Invalidity as to Obviousness.

Google's expert, Dr. Jordan, only offered conclusory testimony that the prior art was all addressing the same problem of information overload therefore the "combinations are predictable." Tr. 1268:4-7. Dr. Jordan provided no analysis of how the combinations interacted except that the conclusion was drawn that the combinations are predictable. To determine obviousness, a court must consider: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, such as commercial success, long felt but unsolved needs, and the failure of others. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966). Google failed to meet its heavy evidentiary burden for any of these factors for the prior art..

Google failed to set forth sufficient proof that the prior art contains core limitations of the patents-in-suit, much less have similar scope and content. As an example, the prior art focused primarily on navigation within a single website. Tr. 1729:14-18. Since the prior art references do not disclose all limitations of the patents-in-suit there are critical differences in the claims and prior art. With such disparate references, no one skilled in the art would have known how to arrive at the patents-in-suit. Tr. 1729:24-1730:4.

The jury heard evidence at trial further demonstrating the non-obviousness of the asserted claims. Dr. Carbonell explained that secondary factors such as commercial success, long-felt but unresolved need, and failure of others all support a conclusion that the patents-in-suit are non-obvious. Tr. 1730:8-24. The jury was presented with evidence supporting many of these factors. Google's own blog announcement admitted that personalized services were necessary and as a result Google extended personalized search to all Goggle users, signed-in and signed-out in December 2009. Tr. 1731:17-1732:5, PTX 0331. Dr. Carbonell testified that Google reported increased revenue of twenty-six percent from the fourth quarter of 2009 to the fourth quarter of 2010 (year-over-year) after the launch of personalized search to all users in December 2009.

In addition, the jury heard evidence that there was a long-felt and unresolved need for personalized search in the industry dating back to at least 2003. PTX 0342. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Moreover, there

was significant evidence that others failed. Tr. 1740:18-1741:2.

CONCLUSION

For the foregoing reasons, the Court should enter JMOL for PUM and Dr. Konig.

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CERTIFICATE OF SERVICE

I hereby certify that on April 8, 2014, 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 8, 2014, upon the following individuals in the manner indicated:

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