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September 3, 2010

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

VIA ELECTRONIC FILING

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

Dear Judge Stark:

Plaintiff Personalized User Model, L.L.P. ("P.U.M.") files this letter in response to Defendant Google, Inc.'s ("Google") September 1, 2010 letter concerning the number of claims currently asserted against Google and the inventor depositions. (D.I. 76)

It is Unreasonable and Unfair at this Stage in the Litigation to Force P.U.M. to Reduce the Number of Asserted Claims to 10. Despite Google's assertion to the contrary, P.U.M. has not refused to further reduce the number of asserted claims. P.U.M., in fact, informed Google on numerous occasions that it will work with Google to further reduce the number of claims, and commits to do so again on or before September 8, 2010, which will give the parties ample time to prepare their opening claim construction briefs. *See e.g.*, Exs. D, E, H, J.¹ The issue, therefore, is not if, but when, such a further reduction will take place. Given Google's discovery conduct and the stage of this case, P.U.M. should not be forced to further reduce its asserted claims at this time, and certainly should not be limited to 10 claims. For the reasons set forth below, Google's motion should be denied.

First, Google's complaints about the number of asserted claims remaining are largely a problem of Google's own making. Google's discovery failures and refusal to provide invalidity contentions have and continue to prejudice P.U.M.'s ability to further limit the number of asserted claims. Google attempts to downplay its shortcomings by providing a one-sided description of its conduct in this case. For example, Google tries to characterize P.U.M. as a

¹ Citations to Exs. 1-7 refer to exhibits to P.U.M.'s Sept. 1, 2010 letter concerning Google's invalidity contentions (D.I. 78) and citations to Exs. A-J refer to exhibits cited by Google in support of its letter of the same day (D.I. 76). Exhibit 8 is attached hereto.

dilatory plaintiff, asserting that Google did not receive a claim chart until April 8, 2010 (which was well in advance of the deadline for contentions). (D.I. 76 at 1). In so arguing, Google simply ignores that it did not even begin to meaningfully participate in discovery until late April 2010 (just 4 months ago). In fact, as of April 29, 2010, Google had produced only 1,500 pages of documents and no source code. Once Google began to produce its documents and source code, P.U.M. promptly (on July 1, 2010) identified the asserted claims. P.U.M. then further (on July 19, 2010) reduced the number of asserted claims, and has indicated that it will work with Google to make further reductions. *See* Exs. H, J. Given P.U.M.'s concerted efforts to reduce the number of asserted claims to date, and the still incomplete information it has received from Google to date, there is simply no reason to limit P.U.M. to 10 claims at this stage of the case. *See, e.g., High Point Sarl v. Sprint Nextel Corp.*, No. 09-2269, 2010 WL 1292710, at *2-3 (D. Kan. Mar. 29, 2010) (finding it would be premature to limit the number of claims plaintiff may assert five months prior to the close of discovery, where plaintiff had narrowed an initial set of 178 claims asserted to 125 claims and served defendants with over 800 pages of infringement contentions, and where plaintiff anticipated eventually limiting the asserted claims to a manageable number).

Second, Google argues the P.U.M. is going about the process backwards, maintaining that P.U.M. should have identified the claims it planned to assert long ago, and “[i]f discovery were to reveal grounds for new allegations based on *previously unavailable information*, [P.U.M.] may be able to assert additional claims at that time.” (D.I. 76 at 2). It is Google, however, that has the process backwards. P.U.M. identified the claims that it alleges Google infringes. Google now attempts to prematurely force P.U.M. to choose 10 claims to assert from among the many claims Google infringes without providing P.U.M. the discovery or contentions necessary to enable P.U.M. to make a fully-informed decision about which claims to assert at trial. Google’s not-yet-completed production of documents and source code (Ex. 6) makes this request particularly unreasonable, as does Google’s failure to provide invalidity contentions for P.U.M.’s asserted dependent claims.

Third, the law does not support limiting P.U.M.’s asserted claims at this stage of the case. None of the cases cited by Google support such a limitation. For example, in *Fenster Family Patent Holdings, Inc. v. Elscint Ltd.*, the Court limited plaintiff to ten asserted claims and five accused products **after the close of fact discovery**, after dispositive motions were filed, and less than two months before the pretrial conference. No. 04-038-JJF, 2005 WL 2304190, at *3 (D. Del. Sept. 20, 2005)²; *see also LG Display Co., Ltd. v. AU Optronics Corp.*, 686 F.Supp.2d 429, 434 (D. Del. 2010) (limiting plaintiff and counterclaimant to seven asserted claims roughly 20 months after the case was filed)³. The circumstances are entirely different here. This case

² Also, the plaintiff in *Fenster* had broadened the scope of the case only five weeks prior to the close of discovery by asserting 90 claims from “eight unrelated patents” against 49 different products. 2005 WL 2304190 at *1-*2.

³ Although the Court in *LG* had earlier limited plaintiff and counterclaimant to seven asserted claims each, the opening sentence of the Court’s opinion highlights the non-analogous nature of the action, stating “[t]hese proceedings involve three related patent infringement cases involving 23 patents.” 686 F. Supp. 2d at 429. Further, while the Court requested the parties proceed with seven asserted claims each, the Court

has been pending for little more than a year, more than six months remain for fact discovery, no technical depositions of Google witnesses have been taken, P.U.M. has been working diligently to reduce the number of claims, and P.U.M. is still waiting for Google to produce relevant documents and source code (Ex. 6).⁴

Google Should Not Get Two Bites At The Inventors By Depositing Each Of Them In Two, Separate 7-Hour Depositions. P.U.M. does not dispute Google is entitled to fourteen hours of testimony (two seven-hour days) from each inventor. Google, however, attempts to take what was understood to be a single 14-hour deposition and turn it into two separate depositions spaced far apart in time. P.U.M. initially agreed to produce the inventors for twelve hours as a courtesy. *See* Ex. 8. In an effort to reach an agreement on the terms of the Scheduling Order, including increasing the number of interrogatories from 25 to 35, P.U.M. agreed to produce the inventors for two additional hours, or a total of fourteen hours (two seven-hour days). *Id.* It was never P.U.M.'s intent, nor would P.U.M. have agreed, that two seven-hour days entitles Google to take two separate depositions of the inventors. Only after P.U.M. sent Google a courtesy letter informing it of the inventors' availability should their depositions exceed seven hours and roll-over to 14 hours (Ex. I)⁵, did P.U.M. learn that Google intended to take two non-consecutive depositions of the inventors. Just as Google refused to produce its own witnesses twice in response to P.U.M.'s Rule 30(b)(6) deposition notices, P.U.M. never intended, and should not be forced, to produce the inventors on two separate occasions. *See* Ex. J. The Court should deny Google's motion on this point.

Respectfully,

/s/ Karen Jacobs Loudon
Karen Jacobs Loudon (#2881)

(... continued)

recognized that a total of 27 claims remained at issue in the case as both sides had chosen to assert several dependent claims.

⁴ The other cases Google cite also fail to support its argument. For example, in *Nextec App. v. Brookwood Co.*, No. 07-6901, 2010 WL 1257447, at *3 (S.D.N.Y. Mar. 31, 2010), the Court required plaintiff to designate 25 patent claims three months prior to the close of expert discovery; narrow those 25 claims down to 18 claims seven weeks prior to the close of expert discovery; and ***identify a final set of 10-15 claims one week after the close of expert discovery.*** Thus, the court's schedule in *Nextec* supports P.U.M.'s position (expert discovery does not begin until 30 days after this Court's *Markman* Order (D.I. 32), and does not close for 60 days after that), but also counters Google's argument that P.U.M. is approaching "the process backwards," since plaintiff was ordered to narrow the number of asserted claims over time and not add claims to the case over time, as Google proposes.

⁵ Dr. Konig's deposition was scheduled on Friday, August 27, 2010, and Mr. Twersky's on Tuesday, August 31, 2010. Because Dr. Konig was not available the day immediately following his scheduled deposition, Saturday, August 28, P.U.M. proposed dates the following week that would work with Dr. Konig's schedule. Mr. Twersky was available, however, on Wednesday, September 1, 2010, the day after his scheduled deposition, so P.U.M. notified Google of his availability. *See* Ex. I.

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KJL/dlb
Enclosure

cc: Clerk of the Court (Via Hand Delivery; w/ encl.)
Richard L. Horwitz, Esq. (Via Electronic Mail; w/ encl.)
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