

September 3, 2010

**VIA ELECTRONIC FILING**

The Honorable Leonard P. Stark  
United States District Court  
J. Caleb Boggs Federal Building  
844 King Street  
Wilmington, Delaware 19801

**Re: *Personalized User Model LLP v. Google Inc.*, C.A. No. 09-525-LPS**

Dear Judge Stark:

Pursuant to the Court's August 27 Order, Defendant Google respectfully files this letter brief in response to the letter filed on September 1 by Karen Jacobs Loudon on behalf of Plaintiff Personalized User Model LLP ("PUM"). The Court should not compel Google to provide invalidity charts for 68 asserted claims.

**Google has already provided invalidity contentions and has offered to provide more.**

It is undisputed that Google has already provided invalidity charts for three independent claims in accordance with the parties' prior agreement, and has provided the prior art references on which it currently intends to rely. Likewise, it is undisputed that Google has offered to provide additional claim charts for a reasonable subset of the currently asserted claims, and to do so by September 8. However, PUM insists that Google provide charts for every one of the 68 claims that PUM unjustifiably continues to assert in this case. Since, as PUM admits in its letter, PUM will have to drastically reduce the number of asserted claims, and soon, it would be a waste of time, money and resources to require Google to provide charts for each one of these claims now.

Though PUM's letter states that Google "unilaterally chose 10 claims for which it would provide supplemental invalidity contentions" (PUM letter at 2 n.3), this is not the case. Instead, Google provided a proposed list of claims that Google would chart and solicited comment, writing that "[i]f there is some reasonable number of additional (or different) claims that Plaintiff believes it will assert, and that it would be productive for Google to chart, please let us know . . . ." (Ex. 7 to PUM letter.) That PUM rejected this compromise demonstrates that PUM was not genuinely interested in resolving this issue, or in getting the information that it claims to need.

PUM appears to suggest that it requires charts for all 68 claims in order to be able to narrow the asserted claims. This argument is without merit. Initially, the prior art references that Google currently intends to rely on were produced months ago, and PUM is perfectly capable of evaluating those references on its own to determine the strength of its validity positions. Google should not be put to the task of charting an arbitrary number of claims so that PUM can more easily decide what claims it wishes to assert against Google.

PUM argues that Google should chart each of the 68 asserted claims because "[t]he three patents-in-suit are in the same family, relate to the same technology, and have similar claim language," and that the process and system claims are identical to one another. (Louden letter at 2-3.) This argument supports Google's position, not PUM's. If the references and claims are similar as PUM says, it is not clear why PUM insists on wasting Google's time charting them all, or what prejudice it would suffer by agreeing to accept charts for a reasonable subset of its choice. This too shows that PUM is not actually interested in resolving this dispute.

Finally, PUM's argument that Google is "legally obligated" to provide charts for all 68 claims is entirely meritless. The fact that Google asserted invalidity in its Answer does not mean that Google is obligated to provide complete invalidity charts for an arbitrary number of claims – particularly when PUM has not even provided infringement contentions for all 68 claims.<sup>1</sup> The cases cited by Plaintiff do not suggest the contrary. *Scovill Mfg. Co. v. Sunbeam Corp.* stated only that the party asserting invalidity must "briefly . . . state the bases for its contentions . . . and to set forth the prior art supporting such contentions." 61 F.R.D. 598, 601 (D. Del. 1973). As discussed above, Google has amply satisfied this standard. And *Sea Star Line, LLC v. Emerald Equip. Leasing Inc.* does not discuss invalidity contentions at all, saying simply that the Rules of Civil Procedure are "designed to eliminate surprise at trial." 2007 WL 4577903, at \*5 (D. Del. Dec. 28, 2007). However, this dispute has nothing to do with "eliminating surprise at trial," since it is undisputed that PUM will not be asserting all 68 claims at trial.<sup>2</sup>

**Google did not "renege" on the parties' agreement.** When negotiating the schedule Plaintiff cites, Google noted that its willingness and ability to provide supplemental prior art responses depended on the nature of Plaintiff's infringement interrogatory responses, including the number of claims asserted. In doing so, Google was attempting to forestall this very dispute. In fact, it is PUM that has failed to meet its obligations. As described in Google's September 1 letter, PUM wasted months refusing to provide any infringement contentions and refusing to identify the claims it would be asserting. It was not until nine months after the complaint was filed that PUM agreed to provide even the most basic contentions for "one representative claim for each patent." (Ex. B to Horwitz letter.) And it was not until July 1 that PUM identified a set of 88 asserted claims (Ex. C to Horwitz letter), which it narrowed to 68 just three weeks ago. (Ex. G to Horwitz letter.) And on the date PUM agreed to supplement its infringement contentions, it attempted to bury Google under 435 pages of incomplete charts for those claims. (Ex. F to Horwitz letter.)

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<sup>1</sup> Plaintiff's statement that it "was able to chart its infringement contentions for 67 claims for each of the accused products" is false. As explained in Google's September 1 letter, PUM provided no allegations at all for a number of the asserted claims and claim elements, instead simply reserving its right to add such allegations at some unspecified later date. (Google letter at 2.) Further, for many more of the 68 asserted claims, PUM has failed to provide contentions for each of the Google products or services PUM accuses of infringement; at most, PUM has charted *some* of its asserted claims against *some* of the accused products. (Ex. F to Horwitz letter.)

<sup>2</sup> The other cases cited by Plaintiff likewise do not address the issue of a plaintiff attempting to force a defendant to chart an unreasonably large number of claims, most of which cannot remain in the case. *Perfect Web Techs., Inc., v. Infousa, Inc.*, 2008 WL 725726, at \*2-3 (S.D. Fla. Mar. 17, 2008); *Digitronics Corp. v. Jewel Companies, Inc.*, 57 F.R.D. 649, 650 (N.D. Ill. 1972).

The issue is not, as PUM seems to suggest, Google's ability to meet an August 27 deadline. Rather, the issue is PUM's demand that Google chart all 68 claims, which would be a waste of time for the reasons discussed above. In the weeks approaching August 27, Google tried repeatedly to get PUM to narrow the set of asserted claims to a reasonable number. (See Google letter at 1.) PUM refused. Thus, on August 26, Google informed PUM that, consistent with its earlier position, it would not be providing PUM with charts for the 68 asserted claims, as doing so would be a waste of time. Shortly thereafter, Google offered the compromise of charting a reasonable subset of claims of PUM's choice, which PUM refused. Thus, PUM's contention that Google should have to chart all 68 claims should be rejected.

**PUM's complaints about Google's alleged discovery failings are misplaced and meritless.** PUM mentions perceived failures and delays in the production of documents and source code. Notably, PUM has not brought a motion to compel, because there is nothing to compel. Google has produced hundreds of thousands of pages of documents and lines of code, and has responded in detail to technical interrogatories. And the parties have been negotiating in good faith regarding PUM's follow-up requests, many of which have already been fulfilled.

In any event, PUM's apparent argument – that its failure to identify a reasonable number of claims it will assert at trial and produce adequate infringement contentions is somehow a function of Google's discovery failures – is baseless. A patent plaintiff must formulate the contours of its case prior to filing, including interpreting "the asserted . . . claims" and "compar[ing] the accused device with those claims." *Q-Pharma, Inc. v. Andrew Jergens Co.*, 360 F.3d 1295, 1300-01 (Fed. Cir. 2004). In fact, courts often require the plaintiff to disclose asserted claims and infringement contentions at the beginning of the case so that discovery can proceed based on the allegations in the contentions. See, e.g., *Safeclick LLC v. Vkisa Int'l Service Ass'n*, 208 Fed. Appx. 829, 833 (Fed. Cir. 2006) (requiring service of contentions 10 days after the case management conference); *EON Corp. IP Holdings, LLC v. Sensus USA Inc.*, 2010 WL 346218, at \*2 (E.D. Tex. Jan. 21, 2010) (noting that infringement contentions are required "before discovery has even begun" to "focus[] discovery and narrow[] issues for claim construction"). Put simply, PUM's argument that it cannot decide what claims to assert, or provide its infringement allegations, without further discovery rings hollow.

Thus, in light of Google's massive document and source code production, as well as detailed interrogatory responses, Plaintiff has no excuse for continuing to assert 68 claims at this stage in the case. PUM should be required to narrow the set of asserted claims to a reasonable number, and Google should not have to undertake the pointless exercise of providing invalidity charts for dozens of claims that are certain to drop out of the case in the near future.

**PUM's motion for reconsideration of the Court's Scheduling Order is not "fully briefed."** Judge Farnan's scheduling order bifurcates the issues of damages and willfulness from liability. (D.I. 32.) On April 22, 2010, without first informing Google or following any established procedure for making a motion to the Court, PUM filed a letter asking the Court to reverse its decision to bifurcate. (D.I. 37.) Google filed a short response noting that the letter was inappropriate, and refuting some of the points made therein (D.I. 41), but did not exhaustively brief the issue. PUM likewise did not inform Google that it would be raising the point again in its September 1 letter. PUM has never filed a motion for reconsideration, which would be untimely, and the issue was not "fully briefed" as PUM says. PUM's informal letters to the Court on the issue were correctly ignored, and the Court should not take them up now.

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Respectfully,

*/s/ Richard L. Horwitz*

Richard L. Horwitz

RLH/nmt/981011/34638

cc: Clerk of the Court (By Hand Delivery)  
Counsel of Record (By Electronic Mail)