

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

PERSONALIZED USER MODEL, L.L.P.,	)	
	)	
Plaintiff,	)	C.A. No. 09-525-LPS
	)	
v.	)	<b>JURY TRIAL DEMANDED</b>
	)	
GOOGLE INC.,	)	<b>PUBLIC VERSION</b>
	)	
Defendant.	)	

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

**Volume I**

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

Richard L. Horwitz (#2246)  
David E. Moore (#3983)  
POTTER ANDERSON & CORROON LLP  
Hercules Plaza, 6th Floor  
1313 N. Market Street  
Wilmington, DE 19801  
Tel: (302) 984-6000  
[rhorwitz@potteranderson.com](mailto:rhorwitz@potteranderson.com)  
[dmoore@potteranderson.com](mailto:dmoore@potteranderson.com)

*Attorneys for Defendant Google Inc.*

Dated: September 1, 2010  
Public Version Dated: September 8, 2010  
981439 / 34638

**Richard L. Horwitz**  
Partner  
Attorney at Law  
rhorwitz@potteranderson.com  
302 984-6027 Direct Phone  
302 658-1192 Fax

September 1, 2010  
Public Version Dated: September 8, 2010

**VIA ELECTRONIC FILING**

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

**PUBLIC VERSION**

**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, requesting that the Court compel Plaintiff Personalized User Model LLP ("PUM"): (1) to limit the asserted claims in the case to ten overall; and (2) to produce the named inventors of the patent-in-suit for two seven-hour deposition days as specified in the scheduling order.

**I. Plaintiff Should Be Required to Limit the Asserted Claims from 68 to 10.**

**Plaintiff refuses to reduce the asserted claims below 68.** PUM initially refused to identify any claims it asserted against Google. (Ex. A at 13.) Not until April 8, after repeated attempts to obtain a list of claims and basic infringement contentions and nine months after the complaint, did PUM finally agree to provide a claim chart for "one representative claim for each patent." It still would not agree to identify which claims it was asserting. (Ex. B.)

On July 1, nearly a year after the complaint, PUM supplemented its interrogatory responses to assert that Google infringed 88 claims of the three patents-in-suit. (Ex C at 2.) In response, Google's counsel explained that Google "cannot reasonably proceed with preparing constructions for the number of claim terms that 88 claims would require; nor can [Google] brief that many claim terms within the 20-page limit on claim construction briefs in Delaware" and requested that PUM limit its number of asserted claims to "a reasonable number (such as 10 claims)." (Ex. D at 1, 2.) PUM refused to do so on a July 15 meet-and-confer, instead stating that it would (at some point) reduce the number of asserted claims to "between 40 and 60 claims." (Ex. E.) On July 19, PUM served 435 pages of claim charts that accused various Google products of infringing 70 claims – though the charts cite no evidence for several claim elements and entire claims. (Ex. F.) PUM slightly trimmed the 70 claims down to 68 on August 12. (Ex. G at 2.) The parties held another meet-and-confer on August 25, but made no progress.

**Google's requested limit of 10 claims is reasonable and consistent with established authority.** Rather than identifying a reasonable number of claims at the outset of discovery, or even now after substantial discovery, PUM claims to need some unclear amount of further

discovery before it is able to identify even a remotely reasonable number of claims it plans to assert at trial. PUM, however, is going about the process backwards. As plaintiff, PUM should have been able to identify the claims it planned to assert long ago. If discovery were to reveal grounds for new allegations based on previously unavailable information, Plaintiff may be able to assert additional claims at that time. But it is entirely inappropriate for Plaintiff to assert nearly 70 claims, despite having no evidence at all that Google infringes several of them.<sup>1</sup>

Further, PUM's contention that it needs additional discovery to narrow the claims is meritless. Again, Google has produced hundreds of thousands of pages of documents in this case, as well as source code for the accused functionalities. Google has also produced additional documents responsive to PUM's follow-up requests, and provided detailed narrative interrogatory responses on aspects of its personalization technology. PUM cannot plausibly claim that it does not have sufficient discovery to determine which claims it intends to assert.

Plaintiff's assertion of 68 claims at this stage also presents numerous practical problems. The parties are due to identify the terms they wish construed and to exchange constructions by September 2, 2010. Claim construction briefing begins on October 1, 2010. The parties will be limited to two 20-page briefs during claim construction. It will be impossible for the parties to brief the number of terms necessitated by 68 claims within these limits, and the claim construction process will inevitably fail to resolve the disputes between the parties. Nor could Google be expected to identify all the potential claim construction disputes and corresponding terms to be construed among the 68 claims, which contain a total of over 4,000 words.

Moreover, Plaintiff has buried Google with 435 pages of infringement allegations for many (but not all) of the 68 different claims. (Ex. F.) Google needs to be able to effectively defend itself against Plaintiff's infringement claims. However, the contentions, which may themselves be the subject of a future dispute before the Court, are so long and scattershot that Google cannot process them to identify where the actual disputes regarding the operation of the accused products may lie. Thus, in addition to making claim construction unworkable, Plaintiff's continued assertion of 68 claims prejudices Google's non-infringement case.

Further, PUM has stated that it intends to seek to compel Google to provide invalidity claim charts for all 68 asserted claims – despite the fact that Plaintiff has not itself provided infringement allegations for all of these claims, and despite the fact that PUM concedes the vast majority of these claims are certain to drop out before trial. This would be a waste of time, and it is demonstrably unfair for PUM to seek to force Google to undertake this pointless exercise.

Given such practical issues, Courts in this District have often limited the number of asserted claims to ten or fewer. *See, e.g., Fenster Family Patent Holdings, Inc. v. Elscint Ltd.*, 2005 WL 2304190, at \*3 (D. Del. Sept. 20, 2005) (limiting plaintiff to ten asserted claims); *LG Display Co., Ltd. v. AU Optronics Corp.*, 686 F. Supp. 2d 429, 434 (D. Del. 2010) (noting that the Court had earlier limited plaintiff and counterclaimant to seven asserted claims each). As the *Fenster* Court held, a limitation of ten asserted claims is “appropriate from the viewpoint of the typical patent litigation.” *Id.* at \*3. Indeed, other districts have followed this District's lead in limiting patent plaintiffs to ten or fewer asserted claims. *See, e.g., Nextec App. v. Brookwood*

---

<sup>1</sup> Plaintiff asserts several claims but merely “reserves its rights” to add evidence later. *See* Ex. F at '040 patent claims 7(d), 8(g)-(k), 38(d), 39(g)-(k); '276 patent claims 10, 11, 16, 17, 20.

*Co., Inc.*, 2010 WL 1257447, at \*3 (S.D.N.Y. Mar. 31, 2010) (noting that the parties had followed a Court-established procedure to narrow the number of asserted claims to ten); *Ex. K, Hearing Components, Inc. v. Shure, Inc.*, No. 07-104 (E.D. Tex. June 13, 2008) at 1-2 (limiting Plaintiff to three representative claims for each patent).

Despite the practical problems its 68 claims present and contrary to well-established legal authority, Plaintiff asserts that reducing the number of claims is not necessary at this time. According to PUM, this is so because it is "only" asserting six independent claims, the patents are part of the same family and have identical specifications, and some of the claims are similar to each other. (Ex. H.) But 68 claims is unworkable no matter how many patents are in the case, for the reasons stated above. Further, though Plaintiff is asserting "only" 6 independent claims, there are still 62 separate dependent claims, several of which have numerous sub-elements. (See e.g. 7 and 8 of the '040 patent.) And while some of the claims have some overlapping terms, each claim is obviously different, which is presumably why Plaintiff asserts all 68.

## **II. Plaintiff Should Be Required to Produce the Inventors for Two Seven-Hour Depositions, as Specified in the Scheduling Order.**

One of the issues raised during the negotiation of the scheduling order in this case was inventor depositions. Given the importance of these depositions, Google did not wish to be limited to a single seven-hour deposition with each inventor. The scheduling order reflects the parties' agreement that "[e]ach of the named inventors may be deposed for two seven-hour (7) days." (D.I. 32, at 2.) Thus, in response to Google's request for deposition dates for named inventors of the patents-in-suit and PUM's partners, PUM provided a single available date for each inventor in late August, which Google accepted. Then, on August 18, Google served notices for the inventors, each of which read: "The deposition will be for one seven-hour day without prejudice to resume in accordance with the Scheduling Order in this case." (D.I. 71, 72.) Despite the agreed provision in the scheduling order, on August 23, PUM stated that the inventor depositions will be "closed" if Google does not take the second deposition day the following day (in the case of Mr. Twersky) and the following week (in the case of Mr. Konig). (Ex. I.) Plaintiff argues this is because these depositions must be "close together in time." (Ex. J at 2.)

But the scheduling order does not require or suggest that the two days of inventor depositions need be "close in time." Instead, it states that "[e]ach of the named inventors may be deposed for two seven-hour days." (D.I. 32 at 2.) Consistent with this agreed language, Google seeks (for each of Mr. Twersky and Mr. Konig) to take one of these "two" days now. Plaintiff's arbitrary "close together in time" restriction, appears to be a litigation tactic to undo what PUM already agreed to in the scheduling order. This restriction was never raised by Plaintiff during the discussion between the parties that led to the agreement in the scheduling order. In fact, it appears Plaintiff itself had not thought of this arbitrary restriction when it offered deposition dates for the named inventors, offering each for a single day.<sup>2</sup>

---

<sup>2</sup> It is noteworthy that Plaintiff's lead counsel at the time the scheduling order was negotiated has since withdrawn from the case, and been replaced by different counsel. (D.I. 22, 75.)

The Honorable Leonard P. Stark  
September 1, 2010  
Page 4

In accordance with the scheduling order, PUM should be required to make the inventors available for two deposition dates within the prescribed discovery period, with no further restrictions other than those imposed by the availability of witnesses and counsel.

Respectfully,

*/s/ Richard L. Horwitz*

Richard L. Horwitz

RLH/nmt/981439 / 34638

Enclosures

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