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BY E-FILING

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

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

Dear Judge Stark:

We represent Plaintiff Personalized User Model, L.L.P. ("P.U.M.") in this patent infringement lawsuit against Defendant Google, Inc. ("Google"). This brief addresses two issues. *First*, P.U.M. respectfully requests that the Court rescind section nine of the Scheduling Order (D.I. 32) to the extent it bifurcates damages and willfulness from liability. This dispute is fully briefed (*see* D.I. 37, 41, and 43), but was not decided prior to Judge Farnan's retirement. *Second*, P.U.M. seeks the Court's assistance in requiring Google to respond to P.U.M.'s Interrogatory No. 13, seeking Google's invalidity contentions (Ex. 1), which was served more than eight months ago. As set forth more fully below, per the parties' agreement Google was to provide such contentions by August 27, 2010. One day before the deadline, however, Google reneged on that agreement, refusing to provide its invalidity contentions. *See* Ex. 2. P.U.M., therefore, moves the Court to compel Google to provide invalidity contentions to P.U.M.'s remaining asserted claims. The remainder of this brief is directed to this second issue.

Factual Background. The parties' previous discourse is important to understanding this issue. Per the Rule 16 Scheduling Order entered on April 13, 2010, "[e]xchange and completion of contention interrogatories, identification of fact witnesses and document production shall be commenced so as to be completed by June 18, 2010." D.I. 32, ¶ 4(a). Initially, per the parties' agreement, P.U.M. served Google with preliminary infringement contentions for one representative claim from each patent for each accused product on April 23, 2010, well before that deadline. These contentions were provided despite the fact that Google had not produced meaningful documents or any source code as of that date. Six days later, P.U.M., having received only 1,500 pages of documents and still no source code from Google, informed Google that unless it immediately produced source code and additional documents, P.U.M. would not be able to provide final infringement contentions by the June 18 deadline. Ex. 3. In an effort to resolve the issue, the parties agreed to the revised schedule set forth below:

- **May 25, 2010** – Google to complete its production of source code;
- **July 1, 2010** – P.U.M. to provide Google with a list of asserted claims;
- **July 16, 2010** – P.U.M. to supplement its infringement contentions. Google to provide invalidity contentions for the representative claims for which P.U.M. previously provided infringement contentions (date extended to July 19 at Google’s request); and
- **August 27, 2010** – Google to supplement its prior art interrogatory responses to provide invalidity contentions for P.U.M.’s remaining asserted claims. If, in good faith, Google finds that it cannot meet this deadline, the parties agreed to meet and confer regarding an alternative timeline. *See* Ex. 4.

P.U.M. fulfilled its obligations under the parties’ scheduling agreement. P.U.M. served Google with supplemental infringement contentions, in which it charted infringement for 67 claims. P.U.M. provided these supplemental infringement contentions despite Google’s continuing production deficiencies.¹ Google, on the other hand, did not fulfill its part of the agreement. Although Google did provide invalidity contentions addressing the four claims P.U.M. charted in its original infringement contentions on July 19, 2010, Google failed to follow through on the second part of the agreement when it unilaterally informed P.U.M. on August 26, 2010 – one day before the deadline – that it would not provide invalidity contentions for the remaining asserted claims stating that it was “unreasonable” for P.U.M. to expect that Google would chart 67 claims.²

Google’s Purported Reasons for Refusing to Honor the Parties’ Agreement are Without Merit. During the meet and confer, in an attempt to resolve this issue, Google argued that it was unreasonable for it to provide contentions for these claims and that P.U.M. should first reduce the number of claims.³ Google’s reasoning is fatally flawed.

First, Google’s claims of burden are overstated. The three patents-in-suit are in the same family, relate to the same technology, and have similar claim language. It is expected, therefore, that the prior art references will be similar. Moreover, many of the 67 claims

¹ *See, e.g.* P.U.M.’s detailed letters from J. Bennett requesting the production of specific documents and source code, dated May 18, 2010; June 8, 2010; June 15, 2010; June 23, 2010; June 29, 2010; July 20, 2010; and August 10, 2010, attached as Ex. 5. Google’s production is still not complete. Indeed, Google has still not produced many of the requested documents and source code, agreeing on August 26, 2010, that it would produce them on an undetermined date in mid-September. *See* Ex. 6.

² Although the parties’ agreement allowed that the parties would confer if Google in good faith found that it could not meet the deadline, it did not permit Google to unilaterally refuse to provide any supplemental contentions on the eve of the deadline. Nor does Google contend that the deadline could not be met, only that it would be burdensome for Google to respond to the number of claims asserted.

³ Google offered to provide invalidity contentions for a subset of P.U.M.’s claims, but would not agree to forego its planned motion (filed by Google today) to limit P.U.M. to 10 claims to permit P.U.M. time to evaluate these yet-to-be-provided contentions and to evaluate the yet-to-be-produced documents and source code. Google then unilaterally chose 10 claims for which it would provide supplemental invalidity contentions. *See* Ex. 7.

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remaining in issue are quite similar. For example, the 34 remaining asserted claims of the '040 Patent comprise 17 process claims and 17 system claims. The 34 claims – apart from half referring to a process and half to a system – are otherwise identical to one another. Many of the other asserted claims are dependent claims that add but a single feature. Further, P.U.M. was able to chart its infringement contentions for 67 claims for each of the accused products and did so with the understanding that Google would respond in kind.

Second, Google is legally obligated to provide such contentions. Google affirmatively asserted in its Answer and Counterclaims that the patents-in-suit are invalid, and must have had a basis for those allegations. D.I. 48. P.U.M. “is entitled to know the basis, if any, for the allegation.” *Scovill Mfg. Co. v. Sunbeam Corp.*, 61 F.R.D. 598, 601 (D. Del. 1973) (granting motion to compel defendant “to state the bases for its contentions that each patent in suit is invalid and to set for the prior art supporting such contentions”). As such, invalidity contentions which fail to address all of the defenses pled are insufficient. *See Sea Star Line, LLC v. Emerald Equip. Leasing Inc.*, No. 05-245, 2007 U.S. Dist. LEXIS 95070, at *16 (D. Del. Dec. 28, 2007) (stating the Federal Rules of Civil Procedure relating to discovery are “designed to eliminate surprise at trial”). Courts frequently compel accused infringers to supplement contention interrogatories calling for detailed explanations as to how each purported prior art reference affects the validity of the patents-in-suit. *Perfect Web Techs., Inc. v. Infousa, Inc.*, No. 07-80286, 2008 WL 725726, at *2-3 (S.D. Fla. Mar. 17, 2008) (citing *Motorola, Inc. v. Alexander Mfg. Co.*, No. 90-3062, 1991 WL 325499, at *1 (N.D. Iowa Dec. 30, 1991)); *Digitronics Corp v. Jewel Companies, Inc.*, 57 F.R.D. 649, 650 (N.D. Ill. 1972).

Finally, Google’s argument that P.U.M. must first reduce the number of asserted claims before it supplements its invalidity contentions puts the cart before the horse. Google attempts to force P.U.M. to prematurely narrow its case based on Google’s failure to provide information that P.U.M. is not only entitled to, but that Google previously agreed to provide (e.g., invalidity contentions, source code, and additional documents), should be rejected. P.U.M. is committed to reducing the number of asserted claims, but can only do so after Google makes the necessary and bargained-for disclosures.

Google’s ongoing refusal to meet its production obligations and supplement its invalidity contentions is prejudicing P.U.M.’s ability to move forward and meet other deadlines in this case. Most immediately, on September 2, 2010, the parties are to exchange claim terms and proposed constructions. On October 1, 2010, opening claim construction briefs are due. For these reasons, P.U.M. respectfully requests that this Court order Google to immediately supplement its response to P.U.M.’s Interrogatory No. 13 and provide detailed invalidity contentions for each of the currently-asserted claims.

Respectfully,

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

KJL/lm

cc: Clerk of the Court (by e-filing and hand delivery)
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