

February 17, 2011

The Honorable Leonard P. Stark
United States District Court
844 King Street
Wilmington, DE 19801

Re: Xerox Corporation v. Google Inc., et al., C.A. No. 10-136-LPS

Dear Judge Stark:

Pursuant to the Court's February 3, 2011 Order, Defendant Google Inc. ("Google") respectfully files this letter brief, requesting that the Court: (1) order Xerox to provide a full and complete response to Google's Interrogatory No. 2; and (2) preclude Xerox from asserting patent claims against Google that were not identified in Xerox's original response to Interrogatory No. 2.

I. Xerox's Failure to Provide a Full and Complete Response to Google's Interrogatory No. 2.

Interrogatory No. 2, served April 23, 2010, asks Xerox to identify, with respect to each asserted claim of the patents-in-suit, every product Xerox contends infringes such claim "by explaining fully and completely how each such product allegedly infringes each such claim." (Ex. 1.) Xerox responded on May 27, 2010 with a claim chart that did nothing more than parrot the language of the asserted claims. For example, Xerox's chart for claim 1 and 18, element 1(c) of the '979 patent states:

'979 patent claim language	Xerox's contentions
(c) automatically categorizing the selected document content using the organized classification of document content for assigning the selected document content a classification label from the organized classification of content; and	Google AdSense/AdWords automatically categorizes webpages using an organized classification of document content and assigns each webpage a classification or classifications corresponding to a category or categories in the AdSense/AdWords information retrieval system.

(Excerpt of chart in Ex. 1.) Xerox did not identify the "classifications" or "categories" used, but just copied the claim language. The remaining contentions have the same ambiguity and lack of detail. (Ex. 1.) Xerox's charts also did not refer to a single document—not even publicly available documents. In June 2010, after Google advised Xerox that Xerox's response was insufficient, Xerox refused to supplement, saying that the response "provided sufficient detail . . . at this stage in the litigation." By July 30, Google made available for inspection over 1 million lines of source code and produced 15,000 pages of technical documents regarding the accused products. Thereafter, Google asked Xerox to supplement its response to Interrogatory No. 2 and Xerox again refused saying its response was sufficient given the "early stage of the litigation."

Thereafter, Google substantially completed its electronic document production, producing over 1.3 million additional pages of documents from agreed-upon custodians' files by December 10. Google also made additional source code available pursuant to Xerox's requests.

On January 18, Google asked Xerox again to supplement its interrogatory response. Xerox again refused, saying its response was adequate for this stage of the litigation.

One week later, Xerox provided a supplemental response to Interrogatory No. 2, which Xerox asserted cured any issues with its prior responses. (Ex. 2.) Xerox's supplemental response, however, does not cure the deficiencies in Xerox's original response. Rather, it suffers from essentially the same issues. For example, Xerox's chart for claim 1(c) provides:

'979 patent claim language	Xerox's contentions
(c) automatically categorizing the selected document content using the organized classification of document content for assigning the selected document content a classification label from the organized classification of content; and	Using CAT2 Mixer, RePhil and/or associated components, AdSense analyzes the content of a webpage for which AdSense will provide an ad and identifies phil clusters, verticals, and/or associated data and their respective identifying labels (category identifying labels).

(Excerpt of Ex. 2.) Like its original response, Xerox's supplemental response essentially parrots the claim language. For example, Xerox fails to identify the "categories" and "labels" it contends Google utilizes. And while Xerox refers to "CAT2 Mixer, RePhil and/or associated components" as somehow meeting element 1(c), those are at least three different systems. The remainder of the contentions suffer from the same ambiguity and lack of detail. Rather than merely parroting the claim elements (or Xerox's restatement of them), they should explain with specificity what features and/or functions of Google's products allegedly infringe the claims, and how they do so. Xerox's supplemental responses also do not cite any evidence whatsoever, even though Google has produced a mountain of documents and source code.

Xerox's supplemental response is further problematic as it does not clearly identify every Google product alleged to infringe the '979 patent. For example, Xerox uses the term "AdSense" but says that the term refers to "the technology embodied by" AdSense for Content and includes "any functionalities called or utilized by that technology, and any other products using that technology, regardless of how any of that technology, those functionalities or those products may be referred to by Google or its affiliates." This gives Google no notice of what, if any, other products or functionalities Xerox contends infringe the '979 patent. Further, the headings in Xerox's claim charts reference AdWords, but none of the entries in the charts actually mention AdWords.

Under these circumstances, Xerox should be ordered to supplement its response to Interrogatory No. 2 to provide a full and complete response. *Balsam Coffee Solutions Inc. v. Folgers Coffee Co.*, 2009 WL 4906860 (E.D. Tex. Dec. 9, 2009) (granting motion to compel supplemental interrogatory response regarding infringement contentions). Xerox should be required to provide Google with clear notice of Xerox's infringement theories so that Google can adequately prepare its defense. See *In re Papst Licensing GMBH & Co. KG Litigation*, Misc. Action No. 07-493 (RMC) (D. D.C. Feb. 8, 2011) (attached as Ex. 3); *Shared Memory Graphics LLC v. Apple, Inc.*, 2010 WL 5477477, *2-3 (N.D. Cal. Dec. 30, 2010) (granting motion to compel supplementation of infringement contentions); *Diagnostic Sys. Corp. v. Symantec Corp.*, 2009 U.S. Dist. Lexis 53916, * 6 (C.D. Cal. June 5, 2009) (same); *McKesson Information Solutions LLC v. Epic Systems Corp.*, 242 F.R.D. 689, 693 (N.D. Ga. 2007) (same); *Connectel, LLC v. Cisco Systems, Inc.*, 391 F. Supp. 2d 526 (E.D. Tex. 2005) (rejecting infringement contentions mimicking the claim language and requiring further specificity, especially in light of plaintiff's access to defendant's source code).

Xerox will likely argue that it needs additional information from Google, such as documents, or that it will provide further supplementation after claim construction. But neither is an excuse for refusing to provide supplementation now. *Balsam*, 2009 WL 4906860 at *4. To

the extent Xerox's understanding of the basis for its infringement theory changes due to new information acquired through discovery or the Court's claim construction, Xerox can supplement its response to Interrogatory No. 2 as it is required to do under Rule 26(e). Fed. R. Civ. P. 26(e). This should not, however, preclude Xerox from providing a full and complete response based upon the information available now. This Court should order Xerox to do so.

II. Xerox Should Not be Permitted to Assert New Patent Claims Against Google.

When Xerox first responded to Google's Interrogatory No. 1 on May 27, 2010, it asserted only claims 1 and 18 of the '979 patent. (Ex. 1.) In the eight months following, Google repeatedly asked Xerox to supplement its interrogatory responses, but Xerox refused. Xerox did so most recently during the February 3 Scheduling Conference, saying its infringement contentions were "more than adequate ... identifying the products and reading the claims against them and so on." (D.I. 116, 2/3/11 Tr. at 6:22-25.) At that same conference, Xerox argued for, and obtained, an accelerated schedule based on its representations that it is narrowing the case.

The parties were to exchange proposed terms and claim constructions two business days later, on February 7. After Defendants identified their proposed constructions for terms in claims 1 and 18, Xerox's proposal included constructions for claims 2, 3, 4, 5, 10, 19, and 20, which Xerox had never previously asserted in Xerox's discovery responses or otherwise. Two days later, Xerox served its supplemental responses to Interrogatory Nos. 1 and 2 identifying, for the very first time, claims 2, 3, 5, 10, and 19 as asserted against Google.

Defendants informed Xerox they objected to Xerox's tardy assertion of these claims for several reasons. Defendants explained Xerox did not provide fair notice of its assertion of these claims before the claim construction process, despite the passage of many months and Defendants' repeated requests for supplemented infringement contentions. Defendants also noted that Xerox's conduct was inconsistent with its representations to Defendants and the Court concerning the adequacy of Xerox's previously served infringement contentions and the supposedly "narrower" scope of the case going forward. Defendants asked Xerox whether it had any explanation for its failure to disclose earlier its intent to assert these claims. Yet, Xerox has never provided an explanation for hiding the ball in this manner.

Instead, Xerox argued that there is no prejudice from its conduct. Yet, the prejudice is substantial. As it had no reason to do so, Google has not considered the elements of the defendant claims in preparing its defenses, collecting documents, and determining case strategy. And knowing the claims at issue is obviously essential to considering and determining what claim construction disputes should be addressed. This is done not just in light of the patent itself and the prosecution history, but also in reference to the accused technology and prior art to determine what might be in dispute that would warrant construction of certain terms. Patent parties typically analyze these issues for months. This task is made all the more difficult by the ambiguity in Xerox's contentions, which were not even provided to Google for these new claims until two days after Defendants were supposed to provide constructions. The parties' joint claim construction charts are now due on February 28 and opening claim construction briefs are due on March 25. Google is at a serious disadvantage given Xerox's head-start in analyzing these claims that they must have known they would assert before the day claim constructions were due to be exchanged. It demonstrably unfair for Xerox to obtain this strategic advantage through its own continued failure to provide complete and detailed infringement contentions.

Based on the above, Xerox should not be permitted to assert claims 2, 3, 5, 10 and 19 against Google.

February 17, 2011

Page 4

Respectfully,

/s/ Richard L. Horwitz

Richard L. Horwitz

RLH/nmt/1001705/35374

Enclosures

cc: Clerk of Court (via hand delivery)
Counsel of Record (via electronic mail)