

MORRIS, NICHOLS, ARSHT & TUNNELL

1201 NORTH MARKET STREET
P.O. Box 1347
WILMINGTON, DELAWARE 19899-1347

302 658 9200
302 658 3989 FAX

MARYELLEN NOREIKA
302 351 9278
302 425 3011 FAX
mnoreika@mnat.com

February 17, 2011

REDACTED - PUBLIC VERSION

The Honorable Judge Leonard P. Stark
United States District Court
For the District of Delaware
844 North King Street
Wilmington, DE 19801-3556

VIA ELECTRONIC FILING

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

Dear Judge Stark:

In accordance with the Court's order setting a teleconference at 11:15 a.m. on February 22 and a corresponding briefing schedule, Defendants Yahoo! Inc. and Right Media LLC (collectively, "Yahoo!") respectfully submit the following letter brief outlining their dispute concerning Plaintiff Xerox Inc.'s infringement contentions in this case. Yahoo! seeks two forms of relief: (1) as to all '979 patent claims Xerox is permitted to pursue going forward, an order requiring Xerox to supplement its response to Interrogatory No. 1 to provide the complete basis for its infringement contentions, including by identifying *with specificity* where each limitation of each asserted claim is found within each accused instrumentality; and (2) an order precluding Xerox from asserting infringement of patent claims other than the claims of the '979 patent identified in Xerox's initial response to Yahoo!'s Interrogatory No. 1.

Background

Since receiving Xerox's infringement contentions more than eight months ago, Yahoo! proceeded with the understanding that (putting aside Xerox's withdrawn '994 patent) this case was about claims 1 and 18 of Xerox's '979 patent. Those asserted claims were the only things identified with particularity in woefully conclusory contentions that did little more than recite the language of those claims and assert that all accused products met each limitation. (See Xerox's Responses and Objections to Yahoo! Inc.'s and Right Media LLC's First Set of Interrogatories, attached hereto as Exhibit A, at pp. 4 -6.) For eight months, and long after its July 30, 2010 receipt of the source code and key design documents for the accused products, Xerox refused Defendants' repeated requests for more detailed contentions. During the February 3, 2011 teleconference with the Court regarding scheduling disputes, Xerox echoed those refusals when it represented that Xerox had provided "more than adequate contentions ...

identifying the products and reading the claims against them and so on.” (Transcript of February 3, 2011 Teleconference, attached hereto as Exhibit B, at 6.) At no time during the February 3 teleconference with the Court, or at any other time during the eight months following service of those infringement contentions, did Xerox suggest to Defendants or the Court that any claims of the ‘979 patent other than claims 1 and 18 were potentially at issue in the case, or that Xerox was even considering the possibility of attempting to assert additional claims. Xerox made no such suggestion or disclosure despite putting arguments concerning the substantive scope of the case front and center in its recent brief opposing Defendants’ motion for stay and in its very recent arguments for an accelerated case schedule.

The long-established deadline for the parties to exchange lists of claim terms to be construed along with proposed constructions was Monday, February 7, just two business days after the teleconference with the Court. That day, Defendants served Xerox—as Xerox must have expected they would—with a chart addressing terms from only claims 1 and 18. Shortly thereafter, Xerox served Defendants with a claim construction chart addressing not just claims 1 and 18 but also *seven* additional claims from the ‘979 patent. Two days later, Xerox served a revised chart addressing five claims in addition to claims 1 and 18 and also served supplemental infringement contentions addressing those seven claims in total. (*See* Xerox’s Supplemental Responses and Objections to Yahoo! Inc.’s and Right Media LLC’s First Set of Interrogatories, attached hereto as Exhibit C, at pp. 5-10, and Xerox’s Revised Initial Claim Constructions, attached hereto as Exhibit D.) The supplemental contentions made no reference to allegations against defendant Right Media, and Xerox clarified by email on February 11 that it was standing on its initial contentions with respect to Right Media.

Xerox’s Infringement Contentions Remain Inadequate

In its first response to Yahoo!’s Interrogatory No. 1, Xerox provided a single chart naming Yahoo! Content Match, Y!Q Contextual Search and Right Media Exchange, listing the limitations of claims 1 and 18 of the ‘979 patent, and stating that each accused product practiced those limitations. Rather than identifying where each limitation could be found in each product, however, Xerox simply repeated the claim language. (*See* Exhibit A.) In its amended response, Xerox provided a new chart purporting to lay out amended infringement contentions against Yahoo! Content Match and Y!Q Contextual Search, but again failed to provide any substantive explanation as to how either product allegedly infringed. Instead, Xerox simply parroted its initial proposed claim construction language and added reference to high level Yahoo! system names. (*See* Exhibits C and D.) Xerox failed to supplement its response concerning Right Media Exchange in any way, such that the totality of the contentions concerning that product remains the repetition of claims 1 and 18 found in Xerox’s original response.

These contentions remain wholly inadequate to provide any meaningful notice to Yahoo! of Xerox’s infringement theories. While Xerox has attempted to justify its anemic responses on the grounds that document production is not complete, Yahoo! produced the source code and key design documents for all of the accused products many months ago. This is more than sufficient to enable Xerox to attempt to make out its case. Indeed, courts have consistently

required plaintiffs to supplement their infringement contentions with citations to the source code once that source code has been made available to them. *See, e.g., Big Baboon Corp. v. Dell, Inc.*, 723 F. Supp. 2d 1224, 1228 (C.D. Cal. 2010) (holding that plaintiff must provide more detailed infringement charts, including pinpoint citations to defendant's source code, because it had been given access to that source code more than four months earlier); *Diagnostic Sys. Corp. v. Symantec Corp.*, No. SACV 06-1211, 2009 U.S. Dist. Lexis 53916, at *6 (C.D. Cal. June 5, 2009) (holding that plaintiff must expressly identify and describe what source code for specific accused software products infringed); *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). Accordingly, Xerox should be required to provide a full and detailed response setting forth complete contentions against all products that it accuses of infringement, including identification of the exact portions of the source code that it contends satisfy the limitations of the asserted claims. If Xerox cannot do so after many months of analysis of the accused software, then the case should be dismissed.

Xerox Should Be Precluded From Asserting Claims Other Than Claims 1 and 18

Xerox has provided no explanation as to why it waited *until the deadline for exchange of proposed claim constructions*, nearly a year after the commencement of this litigation and more than eight months after identifying '979 patent claims 1 and 18 as the asserted claims, before providing any indication that it intended to assert additional claims. Nor has Xerox explained why, just a few days earlier, when pressing the Court for an accelerated case schedule based on its withdrawal of the single asserted claim of the '994 patent, Xerox did not disclose to the Court and to Defendants that it intended in the coming days to more than triple the number of asserted claims in the case. Nor has Xerox explained why it continued to endorse the sufficiency of its infringement contentions identifying claims 1 and 18 as the asserted claims while at the same time preparing its assertion of additional claims.

Over the months prior to February 7, Yahoo! had no reason to believe that it should be considering and developing claim construction positions—let alone noninfringement positions and invalidity positions—with respect to any claims of the '979 patent other than claims 1 and 18. Joint claim construction charts are due to be filed with the Court on February 28. It would be unfairly prejudicial to require Yahoo! to begin now to litigate the five additional claims that Xerox seeks to assert.

For these reasons, Xerox should be precluded from asserting any claims other than claims 1 and 18 of the '979 patent.

Respectfully,

/s/ Maryellen Noreika

Maryellen Noreika (#1014)

The Honorable Leonard P. Stark

February 17, 2011

Page 4

Enclosures

cc: Clerk of Court (Via Hand Delivery; w/ encl.)
John G. Day, Esquire (Via Electronic Mail; w/ encl.)
Richard J. Stark, Esquire (Via Electronic Mail; w/ encl.)
Richard L. Horwitz, Esquire (Via Electronic Mail; w/ encl.)
Charles K. Verhoeven, Esquire (Via Electronic Mail; w/ encl.)
Andrea Pallios Roberts, Esquire (Via Electronic Mail; w/ encl.)
Anthony I. Fenwick (Via Electronic Mail; w/ encl.)