IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

XEROX CORPORATION,   )
)   **REDACTED**
                  Plaintiff-Counterclaim Defendant,   )   **PUBLIC VERSION**
)
        v.   )
)   C.A. No. 10-136-LPS
GOOGLE INC., YAHOO! INC., RIGHT MEDIA   )
INC., RIGHT MEDIA LLC, YOUTUBE, INC. AND   )
YOUTUBE, LLC,   )
)
                  Defendants-Counterclaim Plaintiffs.)

PLAINTIFF XEROX CORPORATION'S
RESPONSE TO DEFENDANTS' CLAIM CONSTRUCTION TUTORIAL

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{00511788;v1}

A.   Defendants Improperly Use Their Tutorial as a Forum For Advocating Their Claim Construction Positions.

Despite the Court's admonition in its February 15 Amended Scheduling Order

that "[t]he tutorial[s] should focus on the technology in issue and *should not be used to*

argue claim construction contentions" (D.I. 115 ¶ 8, emphasis added), Defendants use their

tutorial to argue for specific constructions of disputed claims. In their opening brief, for

example, Defendants argue that a query formulated in accordance with the claims must be

confined to performing a search only in a single category or "folder" of information.

Defendants attempt to support their position by citing both Figure 39 of the '979 Patent and the

patent's prosecution history. (*See* Defs.' Opening Br., D.I. 141, at 4-5, 8-9.) But as discussed in

Xerox's responsive brief, the specification's explanation of Figure 39 vitiates Defendants'

attempt to equate the asserted claims with the single sample query shown in that figure; the

specification expressly teaches that the formulated query need only be "focused" on (not

confined to) a category. (*See* 4/26/11 Xerox Resp. Br., at 10.) In addition, black-letter patent

law, the language of the claims and the specification all contradict Defendants' argument that

only a single classification label may be used in query formulation. (*Id.* at 3-5.) Finally, Xerox

never distinguished the '979 Patent from the Rennison patent (or any other prior art) on the basis

of Defendants' incorrect construction of "restrict". (*Id.* at 11-12.) Nor, as Defendants imply in

their tutorial, did the examiner allow the patent on the basis of Defendants' construction. (*See*

Ex. A, at 28/11:15-12:08.)[1] Instead, the examiner allowed the patent because Claim 1 was novel

as a whole. (*See* Ex. B.)

Nevertheless, Defendants' tutorial consistently attempts to repackage these claim

construction fallacies into seemingly neutral statements of fact. Thus, the tutorial repeatedly and

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[1] Citations to Defendants' tutorial refer to Defendants' hard copy slides (attached as Ex. A) and their accompanying video, as follows: "[hard copy page number]/[time in video]".

incorrectly implies that the technology of the '979 Patent is confined entirely to the sample query shown in Figure 39. (*See, e.g.*, Ex. A at 13/5:59-6:44; 16/8:01-8:22; 22/9:10-9:45.) The narration also repeatedly asserts that a classification label is "used to formulate a query to restrict a search to one assigned category". (*Id.* at 8/3:47-4:11; *see also id.* at 16/8:01-8:22; 22/9:10-9:23; 33-35/13:21-13:45.) Finally, Defendants wrongly imply that Xerox distinguished the Rennison prior art patent during prosecution on the basis of Defendants' proposed claim construction (*id.* at 28/11:15-12:08) and further wrongly imply that the examiner allowed the patent on this basis (*id.*). These assertions are all incorrect for the reasons above, as further explained in Xerox's responsive claim construction brief. (*See* Xerox Resp. Br. at 3-5, 10-12.)

Defendants also promote other incorrect claim constructions—*e.g.*, that a query is a "request for search results" and the steps of Claim 1 must be performed before the step of Claim 2 (D.I. 141, at 14, 18)—by discussing parts of the '979 Patent specification that have tangential relevance to the asserted claims. Thus, the tutorial devotes considerable time to a "Document Processing Flowchart" in which the system first generates and performs a query using entities and classification labels. Then, if the results obtained by using that query are "not sufficiently accurate", the system creates an "aspect vector" using terms surrounding the entities identified in the document. (Ex. A at 36-37/13:45-14:30.) At that point, according to Defendants, "[t]he process then attempts the search <u>again</u>, using the more precise query". (*Id.* at 37/14:25-14:30, emphasis added.) Defendants also refer to "search results" repeatedly throughout their discussion of this flowchart. (*See, e.g.*, *id.* at 33-36/13:20-14:01.) The apparent purpose of this exercise is to imply that the claimed query must be a request for search results or that the query of Claims 1 and 18 must be formulated before the terms of Claim 2 are added.

But the asserted claims concern query formulation only. None of the asserted claims requires performing a search of any kind, nor a request for search results, nor the return of

search results to users. (*See* Xerox Resp. Br. at 5-8.) Defendants ignore the actual teachings

concerning query formulation earlier in the specification, which clearly indicate that a query is

defined by its content. By focusing solely on portions of the specification that go beyond the

subject matter of the asserted claims, Defendants distort the scope of those claims. Similarly,

Claim 2 of the '979 Patent says nothing about a query being formulated and executed only after a

search performed in accordance with Claim 1. Claim 2 merely requires that the formulated

query contain data corresponding to entities, terms and classification labels, all based on the

same document content. As discussed in Xerox's briefs, there is no reason that Claim 1 must be

performed before Claim 2, and the specification expressly discloses an embodiment in which the

step of Claim 2 begins before the steps of Claim 1 are complete—an embodiment Defendants

ignore in their tutorial. (*See* Xerox Opening Br., D.I. 142, at 18-19; Xerox Resp. Br. at 20.)

B. Defendants Make Incorrect Assertions in Discussing the '979 Patent

In addition to making incorrect claim construction arguments, Defendants'

tutorial makes various assertions that are inconsistent with undisputed aspects of the asserted

claims and their supporting specification sections. For example, the tutorial incorrectly asserts

that an entity "represents a concept about which a user may desire additional information". (Ex.

A at 9/4:10-4:25; 14/6:54-7:01.) But the '979 Patent explicitly defines "entities" as "something

recognized in a document (e.g., a person's name, a location, a medical term, a graphics entity

that may include image data, graphics data, audio data or video data) that can be in the form of

an image, text, embedded data, HTML, etc." ('979 at 6:65-7:2), and the parties adopted this

definition as the agreed construction for "entity". This definition says nothing about entities

being "concepts" based on user desire for information. In that regard, the tutorial also

incorrectly suggests that entity selection involves a user. (*See* Ex. A at 23/10:09-10:15.) In the

asserted claims and corresponding specification sections, however, entity identification and

query formulation are performed "automatically", *i.e.*, without any user involvement, and

Defendants have never argued that any user involvement is required by the claims.

      C.   **Defendants Mischaracterize the Relationship of the Asserted Claims of the '979 Patent with the Prior Art.**

Apparently attempting to frame validity arguments, Defendants use their

tutorial to mischaracterize the relationship of the '979 Patent's claimed technology with the

prior art. Thus, Defendants begin their tutorial with a discussion of "agent-based systems"

mentioned early in the specification and then segue into a discussion of systems that

performed agent-based functions prior to the '979 Patent. Defendants' attempts to frame the

asserted claims of the '979 Patent in terms of these prior agent-based systems are misleading

and inaccurate. The '979 Patent's specification—which it shares with 8 other issued U.S.

patents, most not claiming query formulation—describes a comprehensive document

management system.[2] Only one portion of that system concerns formulating queries based on

document content.[3] (*See* '979 Patent Section F.3, which also refers to Sections B.4 and F.1.)

Generating queries in a novel and unique manner that combines information ("entities")

recognized in document content with categorization of the same document content is the only

subject of the claims at issue in this case. In that regard, the '979 Patent expressly teaches that

its query formulation technique is intended "to improve the quality (e.g., in terms of precision

recall) of information retrieval systems"—not, as Defendants would have it in their tutorial, "the

asserted problem of document enrichment and management". (*See* Ex. A at 4/1:46-1:52.) None

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    [2] Indeed, the discussion of "agent-based systems" that Defendants cite in their tutorial is identical in all of those patents.

    [3] As the Federal Circuit has noted, "each claim does not necessarily cover every feature disclosed in the specification. When the claim addresses only some of the features disclosed in the specification, it is improper to limit the claim to other, unclaimed features." *Broadcom Corp. v. Qualcomm Inc.*, 543 F.3d 683, 689 (Fed. Cir. 2008) (quoting *Ventana Med. Sys., Inc. v. Biogenex Labs., Inc.*, 473 F.3d 1173, 1181 (Fed. Cir. 2006)).

of the prior document enrichment and management systems mentioned by Defendants teach the

'979 Patent's unique solution for increasing precision recall in information retrieval systems and

therefore shed little light on the novel technology actually at issue in this case.

D.   **Defendants Inaccurately Describe the Accused Products and Prematurely Argue Infringement Issues**

Defendants conclude their tutorial by inaccurately characterizing the operation

of the accused products in a premature effort to argue infringement issues.

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