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The Honorable Judge Leonard P. Stark
U.S. District Court for the District of Delaware
844 North King Street
Wilmington, DE 19801-3556

VIA ELECTRONIC FILING
REDACTED - PUBLIC VERSION

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

Dear Judge Stark:

Defendants Yahoo! Inc., Right Media LLC, and Google Inc., respectfully request that the Court deny Plaintiff Xerox Corporation's request for supplemental invalidity contentions.

This Court already considered the general adequacy of Defendants' invalidity contentions in February when it granted Defendants' motion to compel more specific infringement contentions from Xerox. At that time, the Court, after Defendants' motion had been fully briefed and argued, *sua sponte* ordered Defendants to submit their own contentions for the Court's consideration. After that unfiltered review, the Court concluded that Defendants' invalidity contentions were "significantly more detailed" than Xerox's and justified requiring more specific infringement contentions from Xerox. (Ex. 1 at 29:22-30:14.)

After the Court's ruling, Defendants agreed to further supplement their contentions to account for recently asserted dependent claims, which they did on April 15, 2011. In that supplemental response, Defendants also provided three new claim charts and additional details concerning their defenses under 35 U.S.C. §§ 102, 103, and 112. (*See* Xerox Ex. 20 at 20-28 and Appendices 14-16; Xerox Ex. 21 at 9-13 and Appendices N-P.) Not only did Defendants include an extended explanation of their defenses, but they also identified significant supporting documentary and testimonial evidence. (*See* Xerox Ex. 20 at 20-28; Xerox Ex. 21 at 9-13.) On May 11, Defendants provided new claim charts for a recently discovered prior art reference and

Google supplemented its explanation of its § 101 defense in response to Xerox's complaints. (Ex. 2 at 29 and Appendix B-17; Ex. 3 at Appendix Q.)¹

Defendants' invalidity contentions are detailed and specific. First, Xerox's surprising claim that Defendants have not provided a single anticipation or obviousness chart (Xerox Ltr. Br. at 2) is incorrect. Defendants have thus far provided 17 claim charts that pinpoint where specific limitations may be found in specific prior art references.² Certain charts demonstrate where every claim limitation of one or more asserted claims may be found in a single reference. (See Ex. 2 at Appendices B-1-3, B-7-13, B-17; Ex. 3 at Appendices A-J and Q.)³ Others demonstrate where each limitation may be found in specific combinations of references. (See Ex. 2 at Appendices B-4-6, B-14-16; Ex. 3 at Appendices K-P.) While these reference-specific charts include cross-references to additional pieces of prior art (to account for the possibility of alternative readings of a particular limitation), it is apparent that the charts locating all claim limitations in a single reference are anticipation charts while those showing combinations are exemplary obviousness contentions. See *Keithley v. The Homestore.com, Inc.*, 553 F. Supp. 2d 1148, 1150 (N.D. Cal. 2008) (holding invalidity contentions satisfactory because one can determine whether a chart is an anticipation or obviousness chart based on whether a single reference is charted against every element of the claims at issue). Indeed, this should be clear from references to §§ 102 and 103 and to anticipation and obviousness in the narrative response accompanying the claim charts. (See, e.g., Xerox Ex. 20, at 18-20.)

Second, each invalidity chart provided by Defendants identifies where each claim limitation may be found in a particular prior art reference by providing the specific language from that reference. This is standard practice in patent cases across the country and Xerox has cited no authority to suggest that further detail is required. See, e.g., *Avago Techs. Gen'l IP PTE Ltd. V. Elan Microelectronics Corp.*, No. C04-05385 JW (HRL), 2007 WL 951818, at *2 (N.D. Cal. Mar. 28, 2007) (finding disclosure of page numbers in claim charts sufficient). While Xerox highlights what it no doubt believes is the single best example of Defendants' purported

¹ Despite Xerox's assertion in the second paragraph of its letter, Yahoo! provided the basis for its defense under § 101 in its first supplemental response to Xerox's Interrogatory No. 7, which was served on July 09, 2010. (See Ex. 4 at 2-3.)

² Xerox correctly notes that Defendants have not provided a chart for every single prior art reference it has identified. Defendants have provided charts for the references identified to date that they believe to be most significant given Xerox's apparent contentions, unresolved claim disputes, and the current state of discovery. Defendants will provide additional charts if additional facts or arguments come to light or the Court's claim constructions affect the relevance of the additional references.

³ Xerox improperly creates its Exhibit 7 out of thin air. Not only is the newly-minted exhibit an attempt to avoid the Court's restriction on the length of discovery dispute letters, but it also obscures the clear identification of the corresponding claim limitation in Defendants' charts (in this case, the "automatically categorizing" step).

shortcomings, that example demonstrates the specificity of Defendants' contentions. (Xerox Ltr. Br. at 2-3.) The cited portion of Ford states that "[t]he appearance of such keywords would be used to infer the general topic or subject matter of the communication or conversation" and that "[o]nce the general subject area of the conversation has been (probabilistically) deduced, the present invention may be used to present advertisements in the chat room that match the theme of the conversation." It is hard to imagine that Xerox does not understand that a "class" may correspond to "general topic" or "subject matter" or that (especially in view of Xerox's proposed constructions) the selection of advertisements to match the subject matter could indicate a search of "categories of information" in an "information retrieval system" where the ads are stored. Indeed, this concept is central to Xerox's infringement theories.

Third, Defendants have explained why the '979 Patent's admitted "combination of known technologies" was obvious under § 103. (*See* Ex. 5 at XRX01040280.) In addition to providing the basis for their contentions, Defendants have provided citations to supporting inventor testimony and documentary evidence as well as exemplary charts showing how specific references may be combined. (*See* Ex. 2, at 24-26 and Appendices B-4-6, B-14-16; Ex. 3, at 11-12 and Appendices K-P.) Apparently, Xerox would now have Defendants go further and provide a chart for every combination of identified prior art, resulting in hundreds if not thousands of claim charts of every single precise combination possible, and separate narrative explanations for each of these combinations. Such an exercise would be unduly burdensome and is not warranted. *See, e.g., Keithley*, 553 F. Supp. 2d at 1150 (permitting invalidity contentions that grouped combination references into categories). Moreover, Xerox would undoubtedly have complained had Defendants produced that many charts in the first instance given that it is now complaining that Defendants included too many cross-references in its current charts.

While Xerox suggests that its demands are somehow justified in light of its infringement contentions, the comparison fails. As the Court previously highlighted, Defendants' invalidity contentions are in no way equivalent to Xerox's previous bare-boned infringement contentions that merely repeated the claim language. (Ex. 1 at 29:22-30:14.) Moreover, even after supplementation, Xerox's contentions remain ambiguous in many respects. Further, although Xerox complains that Defendants merely quote from prior art references, Xerox's infringement contentions do the very same thing. For each claim element, Xerox repeats the claim language and states that the accused product practices that element. Xerox then summarizes Defendants' documents and, to give the illusion of length and substance, pastes images of those documents into the contentions, rather than a simple cite to that document. It includes images of different documents that say the very same things or make the very same points over and over again—also giving the illusion of substance. (*See, e.g., Ex. 6.*)

To the extent that any ambiguity exists as to how a specific cite in Defendants' charts reads on a corresponding claim limitation, it arises from the need to account for Xerox's unclear infringement theories and various possible claim constructions. To require Defendants to supplement their invalidity contentions in the manner proposed by Xerox now would impose a meaningless make-work project designed simply to impose costs.

For the foregoing reasons, Defendants request that the Court deny Xerox's request.

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Respectfully,

/s/ Jeremy A. Tigan

Jeremy A. Tigan (#5239)

JAT/dla

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