UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF KENTUCKY
LEXINGTON DIVISION

Electronically Filed

iLOR, LLC	:	
	:	**CIVIL ACTION NO. 5:07-cv-00109-JMH**
	:	
Plaintiff,	:	
	:	
v.	:	
	:	**Judge Joseph M. Hood**
GOOGLE, INC.	:	
	:	
Defendant.	:	

iLOR's MEMORANDUM IN OPPOSITION TO
DEFENDANT GOOGLE'S
CROSS-MOTION FOR SUMMARY JUDGMENT

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I. Introduction

For the reasons that follow, Google's motion for summary judgment should be denied.[1] Since Google has consolidated its summary judgment and preliminary injunction briefing, iLOR incorporates by reference herein its arguments relating to claim construction, infringement and validity set froth in its Memorandum in Support of its motion for Preliminary Injunction**.**

iLOR agrees with Google that the underlying facts necessary to resolution of Google's Motion are not disputed, including the seven "material facts" set forth on pages 7 and 8 of Google's Brief in support of its Motion.

II. Argument

A. Claim 26 is not Directed to a "Bookmarking" Technique

Google incorrectly characterizes claim 26 as "directed to a very specific technique for 'bookmarking' web pages," and then uses that erroneous characterization to argue not only that Google Notebook uses something different, but that claim 26 simply describes old technology (which Google also calls "dog-ears," "short cuts," and "favorites."). This is a classic "red herring"[2] argument, based on a false premise – claim 26 is not directed to a "bookmarking" technique. Nowhere does the patent use the term "bookmarking,"[3] or any of Google's other terms. Rather, a method for enhancing a hyperlink – i.e., giving a hyperlink capabilities it didn't have before – for example, "interact[ing] with the hyperlink in a variety of ways without necessarily

[1] Actually, Google's Motion should more properly be termed a motion for *partial* summary judgment. Google has only sought adjudication of claim 26. There are 29 other claims in the '839 patent. Thus Google's motion is not case dispositive.

[2] Google approach would probably more accurately be characterized as *ignoratio elenchi.*

[3] PFFinder (part of fiLOR's PreFound product), which uses the patented technology, is not designed to be a social bookmarking tool either. Mansfield Tr., 32:8-33:7; 170:6-11, marked as Exhibit A to iLOR's Memorandum in Reply to Defendant Google's Response to Plaintiff iLOR's Motion for Preliminary Injunction . *See also* PreFound.com *(*"PreFound protected by US pat. . . . #7,206,839). In fact, Social bookmarking was never designed to be used in a social search environment. Mansfield Tr., 33:5-7. *id.*

having to open and/or follow the hyperlink." '839 patent, Abstract. While some of these interactions may resemble conventional "bookmarking," claim 26 is not directed to a "bookmarking" technique – it is a method for enhancing a hyperlink, as the claim language states. Accordingly, all of Google's misleading references to "bookmarking" should be ignored. Beginning at the wrong starting place simply leads along the wrong road to the wrong conclusion. The focus must be on the claim language, not an infringer's manufactured characterization of the iLOR's invention.

B. Claim 26 is Not Limited to a "Toolbar That Automatically Pops Up"

Likewise, nowhere in the '839 patent is there any description of a "toolbar that automatically pops up," or that the patented invention of claim 26 is limited to a "toolbar that automatically pops up." Again, Google creates its own false red herring, and then proceeds to use its false premise to prove its case by creating a limitation out of whole cloth and then importing that additional limitation into the claim. This is impermissible. *E.I. du Pont de Nemours & Co. v. Phillips Petroleum*, 849 F.2d 1430, 1433 (Fed. Cir. 1988) (holding that it is improper to import an extraneous limitation into the claim); *Phillips v. AWH Corporation*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc). All of Google's references to an automatic-pop-up-toolbar should be ignored. Once again, it is the only language of claim 26 that counts – not Google's creative portrayal of iLOR's invention.

C. A Brief Synopsis of the Claim 26 Invention

In very simplified language, claim 26 is directed to "a method for enhancing a hyperlink," which includes, among other characteristics, "a user-selectable link enhancement for a toolbar." This means making available a function in a toolbar, for example, an option inserted into the toolbar, which enhances a hyperlink by making it possible to do something with that hyperlink other than clicking to move to a new page. The specific way in which this "enhanced hyperlink"

is implemented as further described in claim 26, gives the user the ability to capture the URL of the "current" page that the user is viewing. This is one of the core novelties of the invention.

D. Claim Construction

Before infringement and validity can be adressed, the meaning of the terms must be determined by the court. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390-91 (1996). The meanings of only three claim terms are now in dispute.[4] Each of these is addressed below.

1. "being displayable"[5]

Google says this term means "is automatically displayed."[6] This is not correct. Claim construction must begin with the actual language of the claim itself. *Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, 279 F.3d 1357, 1370 (Fed. Cir. 2002)("Claim interpretation begins**,** as always, with the language of the claims.") There is nothing in this claim language that suggests that the toolbar is *automatically* displayed. The words simply mean that the toolbar is capable of being displayed – it can become visible – if certain conditions are met. There is no word in this claim phrase that implies that the display of the toolbar is "automatic."

Rather than interpret what a word already in the claim means, Google has imported a new word to further its automatic-pop-up "red herring" approach. Google arrives at its

[4] To simplify the issues for the present motions only, iLOR will assume *arguendo* Google's interpretation of the claim term "providing a user-selectable link enhancement for a toolbar" means "a toolbar entry that permits a user to selectively interact with a hyperlink." *See* Google Br., at 10. In agreeing with Google's definition, however, iLOR doesn't necessarily agree with Google's reasons in support of it position Google asserts this term relates primarily to its invalidity defense. *Id.*. Likewise, for the purpose of the present motion only, iLOR will assume *arguendo* Google's interpretation of the claim term "as a result of said first user selection, capturing said first URL associated with said first page" means "saving for later retrieval as a result of a second user selection of said graphical element the first URL." Google Br., at 22. However, should Google attempt to read limitations into Claim 26 through these two interpretations in a way that is not consistent with the plain meaning of the claim language, iLOR reserves the right to withdraw its consent to these constructions.

[5] The entire phrase reads: "the tool bar being displayable based on a location of a cursor in relation to a hyperlink in a first page in a first window of an application." Google asserts this limitation is "dispositive on the issue of direct non-infringement." Google Br., at 10.

[6] Google asserts different interpretations of its "automatic" language, depending on whether it is arguing non-infringement (Google Br., at 8-22) or invalidity (Google Br., at 29, Defendant's Exh. O). Claims must be construed the same way for infringement and validity. *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003).

"interpretation" by importing additional limitations into the claim language, which is improper. *E.I. du Pont de Nemours & Co.,* 849 F.2d at 1433.

First Google argues that the '839 Abstract "explains that ***the invention*** . . . requires a tool bar that automatically pops up." (underlining added) There is no such *requirement* in the Abstract quoted by Google, or any suggestion of "automatic pop up" – all it says is that the "tool bar is displayed." The claim language itself emphasizes that this display is possible as a result of the *location* of the cursor in relation to the hyperlink – that is, the particular toolbar can become visible when the cursor is over the hyperlink, but it doesn't have to. Once the appropriate relationship between the cursor and hyperlink is satisfied, the claim does not exclude some additional action (for example a right mouse click) to make the toolbar visible. There is simply no *requirement* in the *claim* that the display be "automatic" – that is, without any further action or stimulus by the user, for example a mouse right-click.. Google is improperly reading the word "automatic" into the claim *See E.I. du Pont de Nemours & Co., supra.*

It should also be noted that claim 26 covers a method "comprising" a number of steps. A method a claim employing the transitional term "comprising" does not exclude additional, unrecited steps. *Moleculon Research Corp. v. CBS, Inc*., 793 F.2d 1261,1271 n. 6 (Fed. Cir. 1986). Accordingly, claim 26 would not exclude an additional step of right clicking to display the toolbar after the required location between the cursor and hyperlink was met.[7]

Google also argues that the '839 patent "Summary of the Invention" "extol[s] automatic toolbar pop up as important feature of the *invention.*" (emphasis in original) Again there is nothing in this section of the patent that discusses an "automatic toolbar popup feature." All it says is the "toolbar is displayed." Once again, the claim language emphasizes that this display

[7] Likewise, an accused infringer does not avoid literally infringing a method claim having the transitional phrase "comprising" simply because it employs *additional* steps. *Moleculon Research Corp.,* 793 F.2d at 1271.

may occur based on the *location* of the cursor in relation to the hyperlink. Again, since claim 26 is directed to an enhanced hyperlink, the appearance of the toolbar is keyed to the hyperlink containing the enhancement. There is simply no *requirement* in the *claim* that the display be "automatic."

Next Google argues that "all of the embodiments in the patent feature toolbars that automatically pop up." That is not true. The first portion of the '839 patent cited by Google states that "[t]he Enhanced Hyperlink toolbar ***may*** be designed to appear when a user 'mouse over' a hyperlink." Col. 3, line 60-61 (emphasis added). This clearly suggests that this type of operation is not required, but is one possible alternative.[8] The patent then describes one of these possible alternatives: "[a]lternatively, the toolbar may display with the page ***or the toolbar may appear when the cursor or pointer is in a predetermined area around the hyperlink."*** Col. 3, lines 61-64 (emphasis added). Thus, the toolbar may appear when the cursor is on the hyperlink, or in a predetermined are around the hyperlink. These alternate embodiments also clearly relate potential display of the toolbar to the *location* of the cursor with respect to the hyperlink. There is no expressed or implied requirement that the toolbar automatically display. Since claim 26 is directed to an enhanced hyperlink, the appearance of the toolbar is keyed to the hyperlink containing the enhancement. Likewise there is nothing in the '839 patent description that excludes an additional action by the user, such as right clicking.

The second portion of the patent cited by Google states:[9]

> Thereafter, the user selects a hyperlink in block 102 by moving a cursor either "over" or near a hyperlink that the user wishes to select. When the cursor is "over" or near a hyperlink, the program displays a toolbar which illustrates the link enhancements available for that particular hyperlink in block 104. col. 5, lines 35-41.

[8] This embodiment is described as a "preferred," but not exclusive, way of accomplishing the function. col. 3, lines 64-67. Claims cannot be confined to a particular embodiment. *Phillips*, 415 F.3d at 1323.

[9] The opening part of this section emphasizes that the implementation described is "exemplary," not mandatory. Col. 5, line 32.

There is nothing in this description that suggests "automatic pop up." Rather, as in claim 26, display of the tool bar is tied to the locational relationship between the cursor and hyperlink. Again, because the patent is directed to "enhanced hyperlinks," the appearance of the toolbar is keyed to the hyperlink containing the enhancement. Thus, the particular toolbar can become visible when the cursor is over the hyperlink, but it doesn't have to. Further, this description is made with reference to Figure 1, which is depicted as "exemplary," col. 3, line 1, not mandatory or required.

The third section cited by Google is similar: "[w]hen the detector 70 detects the presence of a hyperlink near the location provided by cursor 74, the detector 70 sends a tool bar display signal 73 to the display controller 72," col. 7, lines 37-40. Again, the potential display of the toolbar is dependent on *location* of the cursor, not an automatic pop up feature. All this description says is that when the software program determines that there is the proper locational relationship between the cursor and hyperlink, a signal is sent indicating that the toolbar may be displayed. This description is also made with reference to the "exemplary" embodiment of Figure 1.

Finally, the forth passage referenced by Google states:

> In the illustrated implementation, the program activates if the user left the cursor in place for at a set period of time, illustrated by block 604. Alternatively, the program may activate anytime the cursor is over a hyperlink. Upon detecting this occurrence, the program may override the typical (standard pre-programmed) mouse-over event with the enhanced hyperlink action in block 608. ***Alternatively, the enhanced hyperlink 10' may just detect the presence of the hyperlink based on the mouse-over event and not override this event. Thereafter, the toolbar selected by the programmer is displayed.*** Col. 8, lines 10-20. (emphasis added)[10]

[10] This description is linked to Figure 4, which is described as "an exemplary flow chart of a second embodiment of the invention." col. 3, lines 7-8.

Once again, an alternate embodiment is described based on the *location* of the cursor – not "automatic pop up." The concluding sentence simply says that the toolbar is displayed at some point after the presence of the hyperlink is detected – not that the display "automatically" occurs. Again, this description does not exclude another action by the user, for example a right click, before the toolbar is actually displayed. As noted above, it would be improper to read this specific embodiment into claim 26.

Thus, although the specification may describe very specific embodiments of the invention, the Federal Circuit has repeatedly warned against confining the claims to those embodiments. *Phillips,* 415 F.3d at 1323; *Nazomi Communications, Inc. v. ARM Holdings, PLC,* 403 F.3d 1364, 1369 (Fed. Cir. 2005) (claims may embrace "different subject matter than is illustrated in the specific embodiments in the specification"). Further, the Federal Circuit has expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment. *Phillips,* 415 F.3d at 1323. Google cannot limit claim 26 to any of the embodiments described in the patent description.

Google incorrectly asserts that "the patent specification expressly states that using a right-click on the mouse to call up a toolbar is a bad idea and touts the automatic pop up feature – which eliminates any need to click at all – as the sole distinction of the invention over the prior art, including Netscape Navigator." Google Br., at 13. Google's argument is wrong. First, there is neither such a "bad idea" statement nor "touting" of an automatic pop up feature anywhere in the '839 patent. Second, the passages quoted by Google (col. 6, lines 22-29 and 44-53) are not describing the feature of claim 26.

The '839 patent describes two "examples" of possible types of "link enhancements," as shown below:

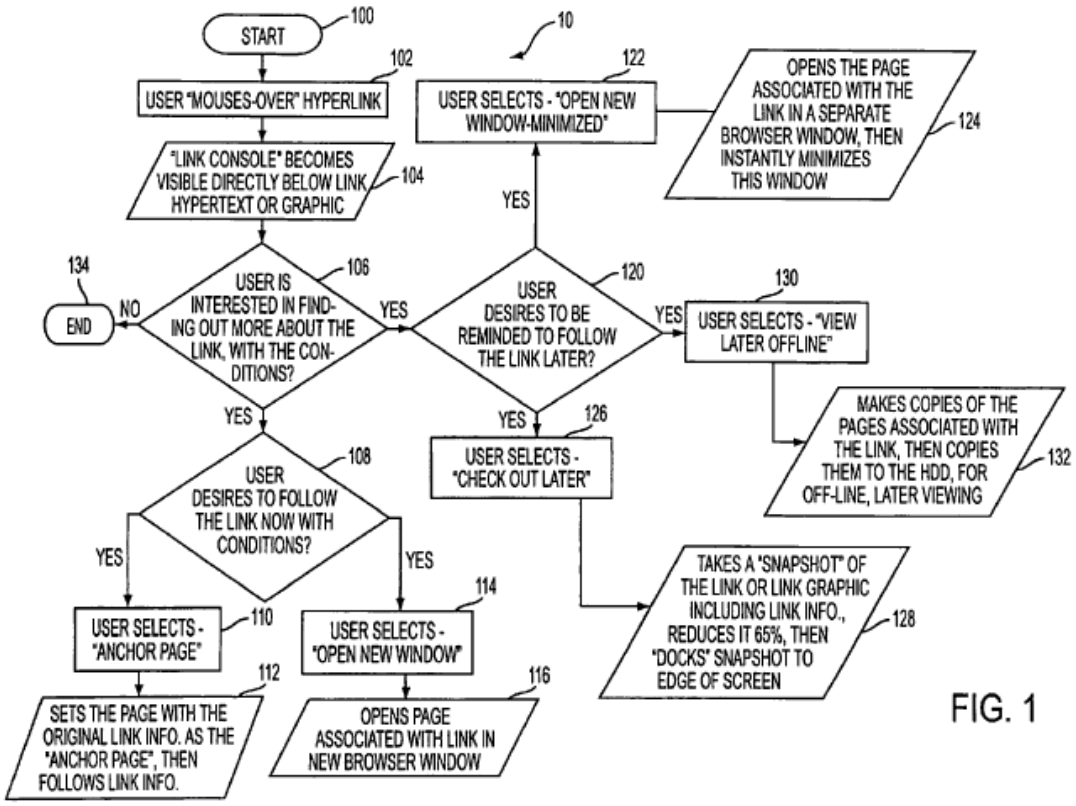

FIG. 1

The first example relates to the "anchor page" feature, and is described at col. 5, line 65-col. 6, line 17:

> An anchor page is a clickable item placed on the tool, bar, the desk top or some other convenient location. This clickable item is associated with or has as one of its properties, the uniform resource locator (URL) of the page that the user was viewing, i.e. the page prior to following the selected link. This "anchor page" provides an easy one click method for the user to return to this page. Consequently, the user is saved both the time and effort of clicking the back button a sufficient number of times to return the user to this page after following the selected link or from having to remember the URL of the page that they were on prior to following a selected link. Col. 6, lines 6-17.

This operation is shown in the left branch (blocks 110 and 112) from decision block 108 in Figure 1, and relates to the feature in claim 26 of capturing the URL of the "current" page that the user is viewing. As explained below, this feature was *not* present in Netscape Navigator. The

described operation is not limited to any particular type of activation of this feature. The patent mentions clicking on the capture "current" page as a way of immediately returning to that page.

Google's argument focuses on the different second type of link enhancement,[11] which is illustrated as the right hand branch (blocks 114 and 116) from decision block 108 in Figure 1. Here, a user can right click on the enhanced hyperlink to open a new window based on the URL of the hyperlink (the "target" window). The patent goes on to say that this type of enhanced hyperlink only requires a single right click, whereas current browsers, such as Netscape Navigator, required right clicking on the hyperlink, and then clicking on the "open new window" menu: multiple user actions. *See* col. 6, lines 22-29 and lines 44-51. The "single click" feature is not required by the anchor function, or the functionality described in claim 26.

Google's reliance on *Toro Co.* and *On Demand Machine Corp.* is misplaced because unlike the situation in those cases, the '839 patent does not emphasize (or even discuss) the importance of clicking or not clicking to accomplish the function of claim 26. Likewise, Google's reliance on *SciMed Life Sys.* and *Watts* is misplaced because unlike those cases, the '839 patent describes multiple ways of accomplishing the toolbar displaying function, and is not limited to a single limiting method, particularly Google's so-called "automatic pop up."

Google's arguments employing the prosecution history also fail to place the relied-upon isolated statements in proper context. At the time the quoted statements were made to the Patent Office, each of claims 178, 186, and 190 then under consideration contained the language "*detecting* a cursor in proximity to a hyperlink." Defendant's Exh. H at 3-6, 8 (emphasis added.) The first prosecution history statement that Google cites related to distinguishing that claimed "detecting" step from the prior art Newfield article:

[11] "The second illustrated link enhancement" – col. 6, lines 18-20.

> First, Newfield does not teach detecting a cursor **in proximity to** a hyperlink. Instead, Newfield teaches that a user must click on or select a hyperlink to access the breadth-first search system of Newfield. See Newfield, e.g., page 5, 3rd paragraph. In contrast, the present invention detects a cursor in proximity to the hyperlink. Defendant's Exhibit H at 10.

Google asserts that this statement excludes all manner of "clicking" from the scope of claim 26, and that only "automatic pop up" is covered. First, this prosecution history statement says nothing about Google's manufactured "automatic pop ups." More importantly the quoted arguments were not being made to distinguish the claim 26 language under discussion: "being displayable." In fact the "being displayable" language did not appear at all in the claims that were being examined. Rather the distinguishing arguments in the prosecution history were made in relation to the "detecting" step. This distinguishing characteristic is not applicable to claim 26 of the '839 patent because claim 26 does not have a "detecting" step – this claim describes a different feature of the invention. In fact, claim 26 was deliberately written to not require the "detecting" step in order to avoid being limited by the argument quoted above in the parent application. In contrast claims 1 and 9[12] of the '839 patent do contain the detecting step. "[D]ifferent words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope." *Karlin Tech. Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-72 (Fed. Cir. 1999). This common sense principle is called the doctrine of claim differentiation.

To further distort the Patent Office record, Google takes the statements in the prosecution history out of order, and therefore out of context. Placed in proper order and context, the second statement in the prosecution history reads:

> Second, Newfield does not teach **displaying a graphical toolbar in proximity to said cursor while said cursor is in proximity to said hyperlink.** Instead, Newfield opens a separate "Scratchpad" window, **not** a toolbar, that remains open for the duration of the browsing session, regardless of the location of the cursor. In

[12] These claims are not at issue in this Motion. iLOR does not concede that they require "automatic pop up" as Google asserts.

> contrast, the present invention displays a graphical toolbar in proximity to the cursor, and only while the cursor is in proximity to the hyperlink.

Google argues that this language shows that "the toolbar [of claim 26] is displayed if and only if and when the cursor is in a proximity to a hyperlink" – another way of saying "automatic pop up." Google is comparing apples and oranges. At the time the quoted statements were made to the Patent Office, each of claims 178, 186, and 190 then under consideration contained the language "displaying a graphical toolbar in proximity to said cursor *while* said cursor is in proximity to said hyperlink." Defendant's Exhibit H at 3-6, 8 (italics added). Accordingly, the applicants distinguished their invention *as* claimed as displaying the toolbar "only while the cursor is in proximity to the hyperlink." In contrast, claim 26 lacks the "while in proximity" language. Thus claim 26 is not so limited, and does not carry any limitations imposed by the prosecution arguments in the parent case. In fact, claim 26 was deliberately written to not require the "while" limitation in order to avoid being limited by the argument quoted above in the parent application. In contrast, claims 1 and 9 of the '839 patent do contain the "while" language. Again, common sense and the doctrine of claim differentiation require that "different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope." *Karlin Tech. Inc.*, 177 F.3d at 971-72.

Finally the third prosecution history statement quoted by Google does not advance its position either. The applicants merely argued that claims under consideration lacked the required "plurality of user-selectable link enhancements." Claim 26 does not have the "plurality" requirement.

Google argues that "the wording of claim 26 [of the ' 839 patent] is indeed very similar to that of claim 9." As shown above, this claim language is not "very similar" as Google asserts – it is critically different, describing different features of the invention in different ways. Google

argues that the patent applicants "linked Claim 26 to Claim 9 [by] representing to the Examiner that the two were 'similar' and that Claim 26 is 'allowable for at least the same reasons as'" Claim 9. As discussed above, claims 9 and 26 differ in at least two ways: the "detecting" and "while" language. However, each has the common language (which was added as a specific additional limitation) "wherein said first page is associated with a first uniform resource locator (URL) wherein said hyperlink is associated with a second URL and a second page." This is the "similarity" referred to. In fact, the Examiner noted that this language (which was one of the "specific added limitation[s]") that distinguished these claims from the prior art. Defendant's Exhibit K, at 2.

Google's interpretation of the Examiner's "reasons for allowance" of the '839 patent application (Defendant's Exhibit K) is not correct. The Examiner's "reasons" do not show that claim 26 requires a "pop up feature," a term not used by the Examiner. The Examiner lumped together his reasons why the claims were different from the prior art: (1) the "while" language, (which appears in independent claim 1 and 9, but not in claims 21 or 26); (2) a plurality of user selectable link enhancements (which is covered by at least claim 30); (3) the "wherein said first page . . ." language of claims 9, 21 and 26 quoted above; and (4) the "link snapshot" or "icon" language (which appears in all of the independent claims except claim 26). This clearly shows that the Examiner understood the differences between the claims. He could not have allowed claim 26 on the basis of the "while" or "detecting," language (which Google incorrectly characterizes as a pop up feature), or the or "plurality" language, because claim 26 does not contain the "while," detecting," or "plurality" language.

The *Elkay* and *Lemelson* cases relied on by Google are inapplicable here because the patent applicants did not disavow any subject matter in claim 26 – they never pointed out differences from prior art in claim 26. Rather, as the Examiner noted, it was allowed because of

the language quoted above – not because of an alleged pop up feature. In *ACCO Brands*, also cited by Google, the court noted that "the statement of an examiner will not necessarily limit a claim" particularly where (as in the present case) "the examiner simply repeated the arguments that the patentee had presented." 346 F.3d at 1079.

2. "based on a location of a cursor in relation to a hyperlink"[13]

Google argues that this language means that the toolbar that automatically pops up must simply have something to do with the relative location of the cursor to the hyperlink. This is not what the claim language says. Rather, the "special" toolbar[14] is displayable, that is becomes visible, based on a location of a cursor in relation to a hyperlink. The cursor cannot be located just anyplace on a web page for this special toolbar to appear; there must be some particular special relation between the cursor and the hyperlink. "A location" means some predefined location of the cursor in relation to the hyperlink. Again, claim 26 is directed to a method using an enhanced hyperlink where the cursor must be positioned over or near the enhanced hyperlink for the enhancement of the hyperlink to operate. Thus the scope of claim 26 extends to methods where the enhanced hyperlink only operates when the cursor is positioned over or near the enhanced hyperlink; it does not extend to methods where the enhanced hyperlink does not operate if the cursor is positioned over the hyperlink (even if the enhanced hyperlink operates if the cursor is located at some place on the web page other than over the hyperlink.) In other words, in the method of claim 26, there must be an enhanced hyperlink, and that enhanced hyperlink must operate if the cursor is positioned over the enhanced hyperlink.

In contrast, Google's interpretation is nonsensical, since the toolbar would automatically pop-up whenever the cursor was ***anywhere*** on the screen. Such a result would render the web

[13] Google asserts this limitation relates primarily to patent validity. Google Br., at 10.
[14] It is not just any toolbar that is displayable, but one that contains the "user selectable link enhancement."

browser completely unusable since the view would always be obstructed by a toolbar. Google's interpretation would also read out of the claim the requirement that the toolbar is only displayable when the cursor is in a particular relation to the hyperlink. This would make this claim limitation meaningless. *See Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532 (Fed. Cir. 1987) (claim limitations cannot be ignored). Finally, Google's interpretation leads to a claim that would not cover any of the embodiments described in the '839 patent. "A claim construction that excludes a preferred embodiment is rarely, if ever, correct." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996).

3. "graphical element"[15]

Google asserts that this claim term means "an image, not text." The parties are in agreement that "graphical element" is not simply unadorned text.[16] However, Google improperly limits the meaning to "an image."

Google first points to several web-based definitions of "graphical element" (Defendant's Exhibits L and M). Exhibit L doesn't mention "graphical element." Further, both Exhibits L and M are dated in 2004, four years after the '839 patent's effective filing date. These are irrelevant to the interpretation of "graphical element" as used in Claim 26, since claim term meaning is to be determined at the time the patent application was filed *See Phillips*, 415 F.3d at 1312-13 "(We have made clear, moreover, that the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.")(emphasis added).

Google argues that the use of different terms in other claims ("displayable element" [claim 1], "graphic element" [claim 7], and "textual element" [claim 8][17]) supports its

[15] Google asserts this limitation related to its non-infringement position. Google Br. , at 10.
[16] iLOR defines this term as "an element that includes some graphics attribute; it is not purely textual."

interpretation. This argument is not well founded. The doctrine of claim differentiation establishes that different terms used in different claims are presumed to have different meanings. Claim 26 uses "graphical element, not "displayable element," "graphic element," or "textual element." Therefore, "graphical element" is presumed to have a different meaning from the other three terms. Second, it is clear that "displayable element" is broad enough to cover both "graphic element" and "text element." This supports the conclusion that "graphic element " is different from plain "text element" (*See also* col. 1, line 21 distinguishing between graphics and text.) iLOR agrees with Google that "graphical element" is narrower that "displayable element," since it does not include plain text. Google's arguments about "claim differentiation" are also misplaced. Claims 7 and 8 can be differentiated because one covers *only* graphics while the other covers *only* plain text.

Google also points to the patent Abstract referencing "a clickable graphic/text string and/or icon." This shows that a text string is different from a graphic or an icon. Further, an "icon" is an "image." *See, e.g.,* http://www.thefreedictionary.com/icon. The '839 patent distinguishes between a graphical element and an icon. Col. 4, line 45. Therefore, "graphical element" must not be limited to a mere image, contrary to Google's interpretation.

Google dismisses iLOR's definition as "post hoc attorney argument," asserting that "[t]here is no such thing as 'bare unformatted text'". The term "bare unformatted text" was in use well before the '839 patent application was filed. *See*, e.g., Exhibit VV, U.S. patent 6,178,419, (priority date May 6, 1998), col. 9, lines 7 – 22 (discussing "bare, unformatted text"), attached hereto. In any event, color, boldface, and the like represent a graphical attribute -- but not simply plain text.

[17] Claim 8 does not use "textual element" but rather "text element."

Google also says that iLOR's definition "renders meaningless the difference between text and graphics" and belies common sense. In fact, iLOR's definition clearly *distinguishes* between graphics and text. As for common sense, a plain reading of the term suggests that "graphical element" is an element with a graphics attribute – plain unformatted text has no graphics attribute.

Google argues that iLOR is attempting to broaden the meaning of "graphical element." That is not true. iLOR simply has attempted to determine the meaning of "graphical element" as used in claim 26, which describes features of the '839 invention. Google also argues that "statements by the Examiner, standing alone and independent of statements by the patent applicant, generally do not bear on claim construction." (Google Br., at 20.) However, previous statements by the patent applicants directly prompted the Examiner's comments. *See* Plaintiff's Exh. CC, page 2 ("Applicant's arguments have been fully considered but they are not persuasive because of the following reasons:…"). Google's citation to and reliance on a dissenting opinion in *Amgen, Inc.* is not persuasive.

Google's lack of understanding of the significance of formatted text can be seen most clearly in arguments relating to statements made during prosecution of the related parent '786 patent application. (Google Br., at 20-21.) Google asserts that the patent applicants contradicted the examiner's interpretation of a "graphical element" by stating "Newfield adds a link to the pending links portion of the scratchpad window. The pending links list is a text list." Figure 2 from Newfield shows the context:

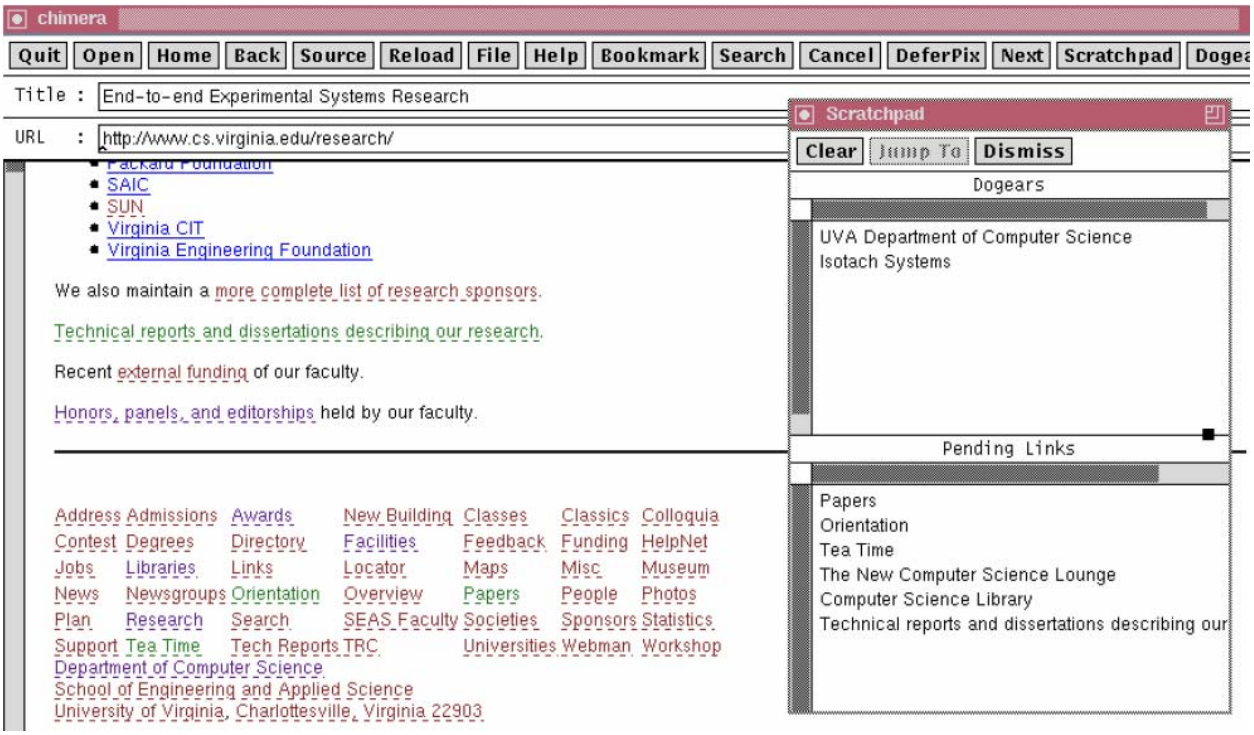

Figure 2: A screenshot of the Newfield Scratchpad.

As can be seen in Figure 2, Newfield shows generally that links in a browser window can be displayed in a variety of colors (blue, purple, brown and green). However, the entries in the scratchpad window are plain text, without color or other graphical attributes. This explains precisely (not "imprecisely" as Google asserts) why a graphical element does not include plain (that is unformatted) text, but must have some graphical attribute, such as color.

Finally, Google criticizes iLOR's reference to other contemporaneous usages of "graphical element," such as in the IBM patent, as unreliable extrinsic evidence. The use of such extrinsic is encouraged by the Federal Circuit "because extrinsic evidence can help educate the court regarding the field of the invention and can help the court determine what a person of ordinary skill in the art would understand claim terms to mean, it is permissible for the district court in its sound discretion to admit and use such evidence." *Phillips v. AWH Corporation*, 415 F.3d 1303, 1319 (Fed. Cir. 2005)(en banc). Clearly, prior patents can be helpful in determining

the meaning of disputed claim terms. *See, e.g., In re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999) (rejecting a claim interpretation by the patent office because "it conflicts with the meaning given to identical terms in other patents from analogous art."). Google's speculation that the definition of "graphical element" in the IBM patent may be non-standard is speculation – Google has not submitted any contemporaneous meanings of its own to show "how a person of ordinary skill in the art understands a claim term." *Phillips*, 415 F.3d at 1312-13.

E. Google Has Not Demonstrated That it Does Not Infringe Claim 26

1. Google's use of a right click does not avoid infringement

Google continues its faulty assertion that it cannot infringe claim 26 because the toolbar in Google Notebook does not automatically pop up when the cursor is moved over the hyperlink, but rather only appears when the user right clicks on the mouse. Since iLOR has shown convincingly that with the proper claim construction, claim 26 is not limited to and does not require "automatic pop up," and that the claim does not exclude right clicking, Google has not rebutted iLOR's *prima facie* showing that this claim limitation is met in Google Notebook.

Google also takes the position that the claim term "being displayable" means "is automatically displayed." Google Br., at 12 (Table). In Google Notebook, once the user right clicks the toolbar is automatically displayed. Accordingly, even under Google's interpretation the claim limitation is met. Since iLOR need only show that this claim element is met by a preponderance of the evidence, *Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc.*, 261 F.3d 1329, 1336 (Fed. Cir. 2001), it has carried that burden.

2. Notebook Displays "Graphical Elements"

Google argues that the claim limitation "graphical elements" is not met because "when the title of the page that the user is currently viewing is displayed in Notebook, it is only text with

a boldface font." Google Br., at 23. This is based on Google's faulty claim construction position that "graphical element" means "an image, not text." iLOR has met its burden of showing that using the proper claim construction, this claim limitation is met in Google Notebook, because, as Google concedes, when the title of the page that the user is currently viewing is displayed in Notebook, it is text with a boldface font. That makes it a "graphical element." Google has not rebutted iLOR's *prima facie* showing that this claim limitation is found in Google Notebook.

3. The "Graphical Element" is "Based on Said First URL"

Google asserts that even if Google notebook has a "graphical element" such as bold-faced text, it is not "based on said first URL" as required by claim 26. Rather, Google argues, "Notebook does not display that bold text 'based on' any URL. It is the same bold text every time." This is a disingenuous position. The claim limitation (which must be considered in it entirety), reads "wherein said selectable link enhancement is adapted to display a graphical element based on said first URL." The '839 patent specification gives an example of this function:

> An anchor page is a clickable item placed on the tool, bar, the desk top or some other convenient location. This clickable item is associated with or has as one of its properties, the uniform resource locator (URL) of the page that the user was viewing, i.e. the page prior to following the selected link. Col. 6, lines 6-11.

The "clickable item" is an example of a "graphical element." That "clickable item" has associated with it or as one of its properties, the URL of the anchor page, which is "said first URL." To a user, the "clickable item" might appear as a title in color and bold type. Associated with that hyperlink (and not necessarily visible to the user) is the URL of the website that was being viewed. Thus the "graphical element" is "based on the first URL." Contrary to Google's argument it is not "the same bold text every time." Rather, it is a different bold text of whatever "anchor page" URL the user selected.

The same operation occurs in Google Notebook. When a user selects the "Note this item (Google Notebook)" option in the menu, a new notebook entry is created which includes a bolded title. That bolded title is associated with the URL of the page that the user was viewing when he or she clicked "Note this item (Google Notebook)". This title is not "the same bold text every time" as is asserted by Google, but will vary, depending on what page the user was viewing at the time. For example, if a user were viewing the site (http://www.kyed.uscourts.gov/) and selected "Note this item (Google Notebook)," the title of the resulting Notebook entry might be "**US District Court East"** If the user selected "Note this item (Google Notebook)" while viewing Kentucky.com, the resulting Notebook entry might be **Homepage | www.kentucky."** The following demonstrates an actual screen capture showing two Notebook entries created from these two exemplary different websites.

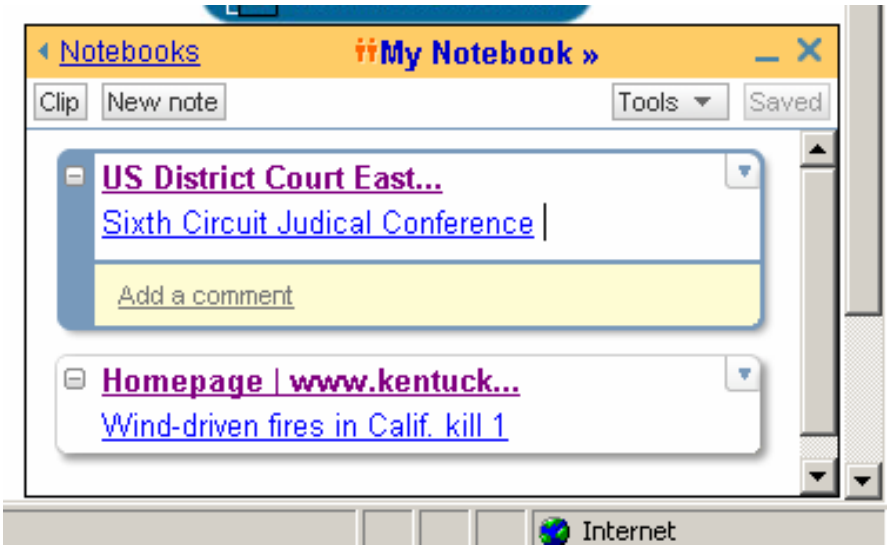

Figure 2: Two Notebook entries showing different titles, one from US District Court website and one from Kentucky.com.

Thus, the bold text used as a title for a notebook entry "Graphical element" varies from site to site. Contrary to Google's assertion, the particular title is dependent on the particular URL of the page the user is currently viewing.

4. Google Notebook Has All the Limitations of Claim 26

iLOR has established that the use of Google Notebook meets all of the claim limitations in dispute and discussed above. Google also does not dispute that the use of Google Notebook also employs the remaining limitations of claim 26. Accordingly, iLOR has made out a *prima facie* case of patent infringement.

5. Google Directly Infringes Claim 26 as a Joint Infringer

Google argues that it avoids direct infringement because Google itself does not perform all of the steps of claim 26 inasmuch as the "displaying" step is done on the user's computer,[18] relying on *BMC Resources, Inc*. In that case, the plaintiff sought to show that the defendant, who did not perform all steps of a patented method, should be liable for patent infringement because all steps in the patented method were performed through the combined acts of the defendant and other parties, including debit networks and financial institutions. The court found no infringement, noting that, while the plaintiff showed that the defendant provided data to the debit networks, it did not show that the defendant had provided any "instructions or directions" regarding the use of that data. *Id*., at *19-20. The Federal Circuit also noted that "the record contained no evidence even of a contractual relationship between [the defendant]…and the financial institutions." *Id*., at *20. The court further noted that "[w]ithout this direction or control of both the debit networks and the financial institutions, [the defendant] did not perform or cause to be performed each and every element of the claims." *Id*., at *20-21. Finally the court concluded that "[a] party cannot avoid infringement, however, simply by contracting out steps of a patented process to another entity. In those cases, the party in control would be liable for direct

[18] On page 25 of its opposition, Google asserts that there are actually two steps which are performed by its users, rather than by Google itself: "displaying a graphical element" and "receiving an indication." However, while iLOR's original preliminary injunction motion explained clearly why both Google and its users perform the step of "receiving an indication," Google provides no analysis to show why it does not perform the step of "receiving an indication." Therefore, the bald assertion by Google that it does not "receive an indication" should be rejected.

infringement. It would be unfair indeed for the mastermind in such situations to escape liability." 498 F.3d 1373, at *17.

In the present case, Google -- a.k.a. "the mastermind" -- cannot escape liability for direct infringement. Notebook users are directly under the control of Google. Before allowing potential users to download the Notebook software, Google requires those users to agree to its terms of service and a privacy policy. *See*, respectively, Exhibit WW (Google Notebook Privacy Policy) and Exhibit XX (Google Notebook Terms of Service). First, these agreements establish a contractual relationship between Google and it notebook users (unlike the situation in *BMC Resources*). Second, unlike the circumstances in *BMC Resources*, Google strictly controls the users' use of Google notebook (a) by prohibiting reverse engineering[19] of the Notebook; (b) by prohibiting access to Notebook by any means other than that provided by Google (Ex. XX, at § 4, at 2); and (3) by reserving the right to terminate any user's access to the Notebook at any time or for any reason (Ex. XX, at § 4, at 3-4). Third, also unlike *BMC Resources*, Google provides detailed "instructions or directions " to users about the how to use Google in a manner which causes the infringement of claim 26. *See* Exhibit YY, attached hereto; iLOR's Exh. K, paragraph 7 ("right-click on the text, image or link you want and click Note this (Google Notebook) from the menu").

Here Google's assertion that users of Notebook "are outside of Defendant's control and are free to use Notebook as they see fit, in their unfettered discretion" is simply not true. Users

[19] "[T]he process of discovering the technological principles of a device or object or system through analysis of its structure, function and operation. It often involves taking something (e.g. a mechanical device, an electronic component, a software program) apart and analyzing its workings in detail, usually to try to make a new device or program that does the same thing without copying anything from the original." http://en.wikipedia.org/wiki/Reverse_engineering.

cannot use Notebook "as they see fit, in their unfettered discretion." Google is the mastermind in control,[20] and therefore is liable for joint direct infringement.

6. Google Indirectly Infringes Claim 26 as an Inducer of Infringement

Google argues that it cannot be an indirect infringer for inducing infringement because there is no direct infringement by its users. Specifically Google asserts that it, not its users, its perform the steps of "providing a user-selectable link enhancement for a toolbar," and "capturing said first URL associated with said first page."

However, Defendant's conclusion (that its users do not perform a step) does not follow from its premise (that Defendant performs the step). In the case of the "providing" step, Google makes the "Note this item (Google Notebook)" option readily available to users from the Google website. However, the users of the Notebook also make this option available by downloading the Google-furnished plug-in, which makes the interaction ready for use on the user's computer. The users also make the interaction represented by the "Note this item (Google Notebook)" available by running a browser augmented with the Notebook plug-in,[21] which results in the interaction being at hand for activation. Thus, the first step of claim 26, "providing a user-selectable link enhancement for a toolbar" is performed not only by Google, but also by end users of the Google Notebook.

The "capturing" step is also performed by a user of the Google Notebook. When a user selects the "Note this item (Google Notebook)" option, a new notebook entry is displayed in the Mini-Notebook window on the user's computer. The notebook entry includes a title which, when selected, takes the user to the page located at the first URL. For this to take place, the notebook entry, including the first URL, is saved by the computer the user is using to browse the internet.

[20] In *BMC Resources*, unlike the present case, there was no evidence that the defendant was a "mastermind" who should be held liable. 498 F.3d 1373, at *19-20.
[21] A "Plug-in" is "an auxiliary computer program." http://en.wikipedia.org/wiki/Plug-in.

Therefore, since using the parties' agreed-upon claim construction "capturing said first URL associated with said first page" means "saving for later retrieval as a result of a second user selection of said graphical element the first URL," the user of the Google Notebook clearly performs the third step of the method of claim 26.

F. Google Has not Proved Claim 26 Invalid

Because a patent is presumed to be valid, Google must show patent invalidity by clear and convincing evidence. *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1238-39 (Fed. Cir. 2003). Google has not met that burden.[22]

1. Google Has Not Proven claim 26 Invalid for Anticipation

Google asserts that if iLOR's claim meanings are applied, claim 26 invalid as "anticipated" by Netscape Navigator. A claim is invalid for anticipation only if each limitation of the claim is found in a single prior art reference, either expressly or inherently. *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1376 (Fed. Cir. 2005); *Sandt Tech., Ltd v. Resco Metal & Plastics Corp.*, 264 F.3d 1344, 1350 (Fed. Cir. 2001) ("Anticipation under §102 requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in that claim.").

First, Google says that Navigator is relevant to claim 26 because it used "bookmarking." As discussed above, "bookmarking" is not relevant to claim 26.

Second, in support of it argument, Google has supplied a "claim chart" comparing each limitation of claim 26 to Navigator. (Google Exh. N). That claim chart is not accurate. That

[22] The fact that a prior art reference may not have been before the patent does not change the presumption of validity. *See Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1569 (Fed. Cir. 1996).

claim chart initially obscures the fact that the "Add Bookmark" entry in the Navigator toolbar behaves differently depending on whether the user invokes that toolbar by clicking over a hyperlink or over an area of a web page where there is no hyperlink. Google's claim chart also obscures the fact that, regardless of where the user clicks to invoke the toolbar, at least two elements recited in claim 26 are absent from Navigator.

When a user invokes the toolbar by clicking over a non-hyperlinked area of a web page, Navigator does not perform the steps in claim 26 of: 1) providing a user selectable link enhancement; and, 2) displaying a graphical element as a result of the user selection of the link enhancement. Even Google concedes that Navigator can only create a "bookmark" for the page that the user is viewing if "the mouse cursor is located within the web page at a location other than a hyperlink." Google Br., at 5. Given the construction which iLOR has accepted for the purpose of this motion, a link enhancement must permit a user to selectively interact "*with* a hyperlink." A toolbar entry which can *only* be selected when the user is not interacting with a hyperlink therefore cannot meet the requirement of providing a user selectable link enhancement.

Similarly, Google, on page 5 of its brief, concedes that the "bookmark" created by right clicking the "Add Bookmark" menu option is not displayed as a result of the user selection of the "Add Bookmark" entry. Rather, "the user can display the bookmarks by clicking the 'Bookmarks' button in the menu bar." Therefore, the display of a "graphical element" in Navigator is not the result of the user selection of the link enhancement (as required by claim 26), but is instead the result of the selection of Navigator's "Bookmarks" menu button.

The method performed when the user right clicks over a hyperlink and selects "Add Bookmark" similarly fails to anticipate claim 26, because it lacks at least the elements of: 1) capturing the URL of the page being viewed as a result of the selection of the link enhancement; and, 2) displaying a graphical element as a result of selecting the link enhancement. The step of

displaying a graphical element as a result of selecting the link enhancement is absent because, whether a "bookmark" is created when the user right clicked over a hyperlink, or over a non-linked area, some additional action (i.e., clicking the "Bookmarks" button) is necessary to display the "bookmark." Similarly, the step of capturing the URL associated with the page being viewed as a result of selecting the link enhancement is absent because, when a user clicks "Add Bookmark" after right clicking on a hyperlink, the "bookmark" created has the URL of the hyperlink's target page – not the URL of the page which was being viewed. As noted above, this ability was a key feature of claim 26.

In short, no method of creating a "bookmark" from Navigator anticipates claim 26. If a "bookmark" is created by right clicking over a non-linked area of a web page, then the requirement of a "link enhancement" is not met. If a "bookmark" is created by right clicking over a hyperlink, then the required capture of the URL of the page being viewed is not performed. Regardless of how a "bookmark" is created, it is never displayed as a result of the selection (e.g., "Add Bookmark") which created it, but instead requires at least one additional selection (e.g., "Bookmarks" button) to be displayed. Since every limitation of claim 26 is not present in Navigator, the claim cannot be invalid for anticipation. *Perricone, supra.*

A clear outline of the methods of creating a "bookmark" in Navigator described above, and an explanation of how those methods are different from the method of claim 26 is provided in Exhibit ZZ hereto.

2. Google Has Not Proved Claim 26 Invalid for Obviousness

Google asserts that claim 26 is invalid for obviousness over the combination of Netscape Navigator and U.S. Patent 5,515,496 ("Kaehler") under 35 U.S.C. § 103. This statute states:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

> subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

In *KSR International Co., v. Teleflex Inc.*, 127 S. Ct. 1727,1734, 167 L. Ed. 2d 707 (2007), the court discussed the framework for determining obviousness:

> *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545, (1966) set out an objective analysis for applying § 103: The scope and content of the prior art are…determined; differences between the prior art and the claims at issue are … ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." While the sequence of these questions might be reordered in any particular case, the factors define the controlling inquiry. If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under § 103." (internal cites omitted).

However, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR International*, 127 S. Ct. at 1741. To be invalid under §103, "the subject matter of the whole" claim must be considered. 35 U.S.C. § 103. When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious. *KSR International*, at 127 S. Ct. at 1740. In addition, courts must not use hindsight reasoning to find a patent claim invalid. *KSR International*, 127 S. Ct. at 1742, *citing Graham*, 383 U.S., at 36 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "'guard against slipping into the use of hindsight.'")

a. the level of skill in the art

To prove obviousness, Google was required to submit clear and convincing evidence showing the level of ordinary skill in the field of the invention. *Graham*, 383 U.S. 1, 17-18;

Kahn v. General Motors Corp., 135 F.3d 1472, 1480 (Fed. Cir. 1998). Since Google has submitted no evidence of this level of skill, its obviousness challenge must fail.

b. differences between the prior art and the claims at issue

There are significant differences between Netscape Navigator and claim 26 as discussed above that weigh heavily against obviousness. *See* the second *Graham* factor above.

More importantly, Google fails to show how the Kaehler patent supplies any of these deficiencies. First, Google admits that Kaehler does not deal with hyperlinks. Google Br., at 7. In fact, Kahler has nothing at all to do with the internet or web pages. That lack of relevance is fatal to Google's obviousness defense.

Google asserts that Kaehler shows the well-known idea that a "pop up" menu or toolbar can be opened by an action other than right clicking, for example, a "mouse-over."[23] However, information relating to "pop up" menus which were activated without right clicking was already before the examiner when he was examining the '839 patent application. *For example*, the '768 Gennaro patent, which was considered by the Patent Office and cited in the '839 patent discusses pop up menus that activate when the mouse cursor is over a particular "hot spot" on the web page. *See also*, Exhibit AAA (Office Action dated August 15, 2002 regarding 09/594,786) attached hereto, at 2 ("Gennaro teaches a method comprising displaying a toolbar without the user executing a click event".). Thus, even if relevant to Google's automatic pop up theory, Kaehler is simply cumulative to other prior art before the examiner and adds nothing to the "obviousness" of claim 26. There is no requirement to bring cumulative references to the Patent Office's attention. *Upjohn Company v. Mova Pharmaceutical Corp*., 225 F.3d 1306, 1312 (Fed. Cir 2000).

[23] This is yet another Google red herring. iLOR is not asserting it invented right clicking or mouse-overs – it did invent the specific hyperlink enhancement defined by claim 26.

Google also argues that Kahler is important because it was cited by the European Patent Office in connection with a foreign patent application related to the '839 patent application. Statements made during prosecution of foreign counterparts to a U.S. patent application are irrelevant to claim construction because they were made in response to patentability requirements unique to European law. *Pfizer Inc. v. Ranbaxy Labs.*, 457 F.3d 1284, 1290 (Fed. Cir. 2006).

Google has not proved by clear and convincing evidence that claim 26 in invalid for obviousness.

3. Google Has not Proven That iLOR Committed Inequitable Conduct.

In a closing throwaway footnote, Google asserts that iLOR has committed "inequitable conduct" by failing to cite Navigator to the Patent Office, rendering the '839 patent unenforceable. Google has not proved that charge.[24]

Inequitable conduct is not "established upon a mere showing that art or information having some degree of materiality was not disclosed. To be guilty of inequitable conduct, one must have intended to act inequitably." *FMC Corp. v. Manitowoc Co.*, 835 F.2d 1411, 1415 (Fed. Cir. 1987). In determining whether inequitable conduct occurred, a court must determine whether the party asserting the inequitable conduct defense has shown by clear and convincing evidence that the alleged nondisclosure or misrepresentation occurred, that the nondisclosure or misrepresentation was material, and that the patent applicant acted with the intent to deceive the United States Patent and Trademark Office. *Honeywell Int'l Inc. v. Universal Avionics Sys. Corp.*, 488 F.3d 982, 999 (Fed. Cir. 2007).

[24] In fact, it is uncommon to determining at summary judgment that a patent is unenforceable for inequitable conduct. *Digital Control Inc. v. The Charles Machine Works*, 437 F.3d 1309, 1313 (Fed. Cir. 2006).

First, Google has submitted no evidence whatsoever, let alone clear and convincing evidence, that the '839 patent applicants intended to deceive the Patent Office. Even if an omission is found to be material, the omission must also be found to have been made with the intent to deceive. *Ferring B.V. v. Barr Labs., Inc.*, 437 F.3d 1181, 1190-91 (2006); *Young v. Lumenis, Inc.*, 492 F.3d 1336, 1343 (Fed. Cir. 2007) ("Both elements of a conclusion of inequitable conduct, intent and materiality, are questions of fact and must be proven by clear and convincing evidence."). "Materiality does not presume intent, which is a separate and essential component of inequitable conduct." *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 552 (Fed. Cir. 1990).

Second, while the '839 patent itself shows the inventors did disclose certain features of Navigator to the Patent Office (*see*, col. 6, lines 22-53), Google has not established that at the time the '839 patent was pending, the patent applicants knew about any of the unidentified "bookmarking features" that Google asserts would have been "material" to the patent application. Inequitable conduct is not established if the patent applicants didn't know about the information. *FMC Corp.*, 835 F.2d at 1415.

Third, as shown above, the operation of Navigator is substantially different from the invention of claim 26, and is therefore would not have been material to the patentability of claim 26. Google has failed to show clearly and convincingly that the Patent Office would not have allowed claim 26 if the Examiner had the complete Navigator before him. Google only says that Navigator is relevant to claim 26 because it used "bookmarking." As discussed above, "bookmarking" is not relevant to claim 26. Even if "bookmarking" were relevant, the Patent Office was clearly made aware of the use of "bookmarking" in connection with the '839 patent application through Newfield and published application 2003/0030679 ("Jain"). *See Plaintiff's* Exh. DD at 7) (discussing the use of bookmarks and noting that "Jain discloses a system and

method for adding graphical images to bookmarks."). Thus the Examiner already had information relating to "bookmarking," but found claim 26 patentable. Accordingly, information in Navigator relating to "bookmarking" would have been cumulative to the information provided by Newfield and Jain. There is no requirement that iLOR bring cumulative references to the Patent Office's attention. *See, e.g., Upjohn Company v. Mova Pharmaceutical Corp.*, 225 F.3d 1306, 1312 (Fed. Cir 2000) ("a reference need not be provided to the examiner if it is merely cumulative to or less material than other references before the examiner.")

In view of the above, Google has not clearly and convincingly established this defense.

III. CONCLUSION

For the reasons stated herein and in iLOR's Memorandum in support of its motion of preliminary injunction, iLOR respectfully requests that this Court deny Defendant's cross-motion for summary judgment, and that the Court grant partial summary judgment on the issues of infringement, invalidity and unenforceability in iLOR's favor.

Respectfully submitted,

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CERTIFICATE OF SERVICE

This is to certify that on this 2nd day of November, 2007, the foregoing was filed with the clerk of the court by using the CM/ECF system and that a true and correct copy of the foregoing will be served on counsel fro Defendants through the CM/ECF system.

s/ David E. Schmit