

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

NORTHEASTERN UNIVERSITY and JARG
CORPORATION,

Plaintiffs,

v.

GOOGLE INC.,

Defendant.

Civil Action No. 2:07-CV-486-CE

Jury Trial Demand

**DEFENDANT GOOGLE INC.'S REPLY IN SUPPORT OF ITS MOTION FOR
SUMMARY JUDGMENT OF INVALIDITY FOR LACK OF WRITTEN
DESCRIPTION AND FAILURE TO DISCLOSE THE BEST MODE**

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I. INTRODUCTION

The specification of U.S. Patent No. 5,694,593 (“the ’593 patent”) does not provide any description at all of how to fragment a query nor does it even mention the terms “fuzzy queries” and “randomly selecting.” Plaintiffs’ excuse for this lack of description is that, according to their expert, one of ordinary skill in the art could read the ’593 patent specification as inherently disclosing these three claim limitations. This is not enough when considering that the sole inventor, Dr. Kenneth Baclawski, testified regarding the difficulty and subtleties of fragmenting and the lack of any disclosure of “fuzzy queries” and “randomly selecting.” Moreover, there is also no dispute that Dr. Baclawski alleges that he implemented specific fragmenting algorithms in an embodiment of the ’593 patent – KEYNET – before the patent was filed. None of those fragmenting algorithms were disclosed in the ’593 patent specification and thus the ’593 patent is invalid for failure to disclose the best mode.

II. ARGUMENT

A. **The ’593 Patent Specification Fails to Show that Dr. Baclawski Possessed the Claimed Subject Matter**

As an initial matter, Google never “dropped” or “withdrew” its written description defense for the “fragmenting” limitation. Google’s December 29, 2010 Invalidity Contentions specifically did not limit Google to only the § 112(1) defenses listed – “the asserted claims fail to meet [the best mode, enablement, and written description] requirements for *at least* the following reasons.” D.I. 179-4 at 34 (emphasis added). Further, although Google did not state “written description” for “fragmenting” in the chart following this statement, there is no dispute that the chart in Google’s May 17, 2010 Invalidity Contentions asserted Google’s written description defenses. D.I. 85 at 39. Plaintiffs never requested clarification or suggested before the belief that Google dropped any of those defenses.

Plaintiffs attempt to escape summary judgment by ignoring the evidence and relying solely on the testimony of its own expert claiming that “fragmenting” is trivial and well known in the art. D.I. 179 (Plaintiffs’ Response) at 7-8. Plaintiffs’ reliance on the alleged “trivial” nature of “fragmenting” – even if not directly contrary to the contemporaneous evidence from the inventor himself – confuses the written description requirement with the separate enablement requirement. Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co., 598 F.3d 1336, 1351 (Fed. Cir. 2010) (“this court has consistently held that § 112, first paragraph, contains a written description requirement separate from enablement”). In other words, “if the claimed invention does not appear in the specification ... the claim ... fails regardless whether one of skill in the art could make or use the claimed invention.” Id. at 1348.

The written description requirement is “an objective inquiry into the *four corners of the specification* from the perspective of a person of ordinary skill in the art.” Id. at 1351 (emphasis added). When using functional language (e.g., “fragments” or “fragmenting”) to define the boundaries of a claim, the “specification must demonstrate that the applicant has made a generic invention that achieves the claimed result” Id. at 1349. Here, Dr. Baclawski and Plaintiffs’ expert, Dr. Arthur Keller, admit that no fragmenting algorithm (or any specific method for fragmenting) is described in the specification. D.I. 152-2 at 116:14-21; D.I. 152-3 at 23:16-20. At best, the ’593 patent describes the result that one might achieve from fragmenting a query and, thus, fails to meet the written description requirement. See Regents of the University of California v. Eli Lilly & Co., 119 F.3d 1559 (Fed.Cir.1997) (“The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention.”).

Plaintiffs rely on a Federal Circuit case, In re Hayes Microcomputer Prods. Inc. Patent

Litig., 982 F.2d 1527 (Fed. Cir. 1992), and claim that Google’s arguments are identical to that case. D.I. 179 at 8-9. Plaintiffs analogize the disclosure in the Hayes patent of a microprocessor performing certain functions to the “fragmenting” limitation in this case. Id. The patent specification in Hayes, however, is quite different from the ’593 patent. In Hayes, the specification described the exact steps that the microprocessor must perform. 982 F.2d at 1534 (“One skilled in the art would know how to program a microprocessor to perform the necessary steps *described in the specification.*”). In contrast, there is no description at all in the ’593 patent specification regarding the necessary steps for performing the “fragmenting” limitation.

Assuming *arguendo* that the general concept of “fragmenting” was known in the art, Dr. Baclawski testified that, in his invention, the fragmenting algorithm used was “subtle” and required one to be “a little careful.” See D.I. 152-2 at 118:22-25 (“You have to be a little careful in your algorithm to make sure you don’t have these problems.”); D.I. 152-4 at JAR0002756 (“The algorithm is more subtle than one would expect”). Without a description of these subtleties or problems of his fragmenting algorithm, it would be impossible for one skilled in the art to conclude that Dr. Baclawski was in possession of the invention.¹

B. The ’593 Patent Specification Fails to Provide Any Description of “Fuzzy Queries” or “Randomly Selecting”²

Making almost the same argument as they did with respect to “fragmenting,” Plaintiffs

¹ Plaintiffs claim that Google’s summary judgment motion should be denied because Google’s technical expert, Dr. Vitter, “did not offer an opinion in his report concerning this issue.” D.I. 179 at 7. There is no requirement, however, that the written description defense be proven by expert testimony. See, e.g., Board of Trustees of Leland Stanford Junior University v. Visible Genetics, Inc., No. C 01-03671 CRB, 2002 WL 31119949, *4 (N.D. Cal. Sept. 18, 2002) (citing TurboCare Div. of Demag Delaval Turbornachinery Corp. v. General Elec. Co., 264 F.3d 1111, 1119 (Fed. Cir. 2001)).

² Despite repeated requests, Plaintiffs have refused to provide a written covenant not to sue Google for infringement with respect to its other products, IndexServer and Mustang. Ex. K (April 5, 2011 Email String between Ruffin Cordell and Michael Valek). Thus, claims 1-3 are still an active part of the case and this Court has jurisdiction over Google’s invalidity claims.

rely solely on its expert's argument that the specification provides a written description of "fuzzy queries" and "randomly selecting." These terms, however, were added as amendments during prosecution and Dr. Baclawski could not identify discussion of these terms anywhere in the specification. See 152-2 (Deposition of Dr. Baclawski, 12/13/10) at 90:22-93:16, 94:21-95:19. Thus, there is simply no description at all in the patent application as originally filed to support these additional limitations, which also renders claims 1-3 invalid for lack of written description.

C. Dr. Baclawski Failed to Disclose His Preferred Fragmenting Algorithm in the '593 Patent Specification

Dr. Baclawski characterized the fragmenting process in the claimed invention as "subtle" and required one to be "a little careful." D.I. 152-4 (Dr. Baclawski's March 31, 1994 Paper) at JAR0002756; D.I. 152-2 (Deposition of Dr. Baclawski, 12/13/10) at 117:2-118:25, 119:5-22. Plaintiffs admit that Dr. Baclawski's KEYNET prototype contains "complexities," but attempt to discredit those "complexities" by claiming that KEYNET has "nothing to do with the invention claimed in the '593 patent and therefore did not necessitate the disclosure of KEYNET's fragmenting algorithm in the specification." D.I. 179 at 15 n.70. However, Dr. Baclawski testified and Plaintiffs alleged that the KEYNET papers and the KEYNET prototype were an embodiment of the '593 patent. See D.I. 152-5 at 135:25-136:2 ("The KEYNET paper is an embodiment, so this is not so limited by that but does furnish an example which is what an embodiment does."); D.I. 185-9 at 3-5 (identifying various KEYNET papers as embodiments). All of this evidence clearly show that "fragmenting" a query was not simply a "routine detail." Yet, the '593 patent specification fails to disclose any fragmenting algorithm or provide any explanation on how to handle the issues associated with fragmenting a query.

Plaintiffs take the position that Google must obtain testimony from the inventor in order to prove that he considered one mode to be superior to all other modes. D.I. 179 at 12-13. As

discussed in Google’s motion for summary judgment (D.I. 152) and Google’s response to Plaintiffs’ motion for summary judgment (D.I. 185), which are both incorporated by reference, testimony from an inventor is not, and should not be, the only evidence regarding the subjective portion of the best mode inquiry. See Dana Corp. v. IPC Ltd. Partnership, 860 F.2d 415, 419-20 (Fed. Cir. 1988) (considering documents and other testimony together in concluding that the inventor failed to disclose his “best mode” for carrying out the invention); see also Medichem, S.A. v. Rolabo, S.L., 437 F.3d 1157, 1170 (Fed. Cir. 2006) (in the context of inventorship, “the corroboration requirement provides an additional safeguard against courts being deceived by inventors who may be tempted to mischaracterize the events of the past through their testimony”). The entire record of evidence should be considered as a whole.

Plaintiffs then attack the relevancy and admissibility of Shalom Wertsberger’s e-mail. D.I. 179 at 15-16. As discussed in Google’s response to Plaintiffs’ motion for summary judgment, Mr. Wertsberger’s e-mail demonstrates the importance of the fragmenting algorithm and is admissible under several hearsay objections. D.I. 185 at 6-8. Plaintiffs also appear to rely on Hayes for the proposition that the best mode requirement is not violated simply because software was maintained as a trade secret. D.I. 179 at 16. The inventor in Hayes, however, actually disclosed the best mode for practicing the invention. 982 F.2d at 1537. In contrast, Dr. Baclawski failed to disclose *any* method for fragmenting a query in his patent despite implementing a prototype and writing papers that embodied the claimed invention.

The evidence establishes that Dr. Baclawski failed to disclose his preferred method for “fragmenting” a query and the ’593 patent is also invalid for failure to disclose the best mode.

III. CONCLUSION

For the above reasons the ’593 patent is invalid under 35 U.S.C. § 112(1).

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on April 6, 2011, a true and correct copy of DEFENDANT GOOGLE INC.'S REPLY IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT OF INVALIDTY FOR LACK OF WRITTEN DESCRIPTION AND FAILURE TO DISCLOSE THE BEST MODE was served on all counsel of record for NORTHEASTERN UNIVERSITY and JARG CORPORATION in the manner agreed to by the parties, via an e-mail to: northeastern@velaw.com.

/s/ Jerry T. Yen

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