

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

**ROCKSTAR CONSORTIUM US LP
AND NETSTAR TECHNOLOGIES
LLC,**

Plaintiffs,

v.

GOOGLE INC.,

Defendant.

Civil Action No. 2:13-cv-893

JURY TRIAL DEMANDED

**PLAINTIFFS' RESPONSE IN OPPOSITION TO
GOOGLE'S MOTION FOR THE COURT TO ENTER ITS [MODEL] ORDER
FOCUSING PATENT CLAIMS AND PRIOR ART TO REDUCE COSTS, TO LIMIT
THE NUMBER OF ASSERTED CLAIMS, AND TO EXTEND THE DEADLINE FOR
THE PARTIES TO COMPLY WITH P.R. 4-2**

This Court should deny Defendant Google Inc.'s ("Google") July 2, 2014 Motion for the Court to Enter its [Model] Order Focusing Patent Claims and Prior Art to Reduce Costs, and to Limit the Number of Asserted Claims, and To Extend the Deadline for the Parties to Comply with P.R. 4-2 (Doc. 105). In its Motion, Google asks this Court to order Plaintiffs Rockstar Consortium US LP and Netstar Technologies LLC ("Rockstar") to select 15 claims per patent and no more than 50 total claims by July 14, 2014, "or soon thereafter as this matter can be heard." Doc. 105 at 1. Google also requests that this Court extend the deadline for Patent Rule 4-2 disclosures from July 15, 2014 to July 18, 2014. As Google's requested deadlines have passed, Google's Motion is now moot, and this Court should deny the Motion as moot.

Should this Court not consider Google's Motion moot, it should nevertheless deny the Motion. Google's own actions betray its arguments, and confirm that Google simply seeks to

impose an additional and unnecessary burden on Rockstar with no good cause. Further, the number of asserted claims in this case pales in comparison to the thousands of prior art combinations Google seeks to rely on in showing that the asserted claims are obvious. As explained to Google, Plaintiffs would be amenable to entry of the Model Order provided that Google identifies with reasonable clarity its obviousness combinations as required by this District's Patent Rules. Until then, this Court should forego entry of the Model Order.

I. Factual Background

On March 24, 2014, Rockstar served its infringement contentions pursuant to Patent Rule 3-1. As required by Rule 3-1(c), Rockstar provided claim charts "identifying specifically where each element of each asserted claim is found within each Accused Instrumentality."¹

On April 14, 2014, Google complained that the number of claims charted and asserted by Rockstar was "far too many." *See* Doc. 105-3 at 2 (Roberts April 14 email). Google added:

Not only is it extremely difficult for Google to analyze Rockstar's infringement contentions, but it will greatly increase the volume of Google's invalidity contentions, which will be a burden to all parties. Moreover, Rockstar cannot possibly try anything remotely close to 144 claims and must know that it will, at least eventually, have to reduce the number of asserted claims. Indeed, under the Court's Model Order Focusing Patent Claims and Prior Art to Reduce Costs, Rockstar will need to limit itself to 32 asserted claims by the close of claim construction discovery. Rockstar should reduce the number of asserted claims now, before Google serves its invalidity contentions under P.R. 3-3.

Id. Rockstar declined Google's demand to prematurely limit the number of asserted claims, and responded that under the Model Order, "the earliest Rockstar would have to make an election is

¹ In its Motion, Google complains that Rockstar accused "a broad and vaguely defined set of products and services." Dkt. 105 at 2-3. This can hardly be the case when Rockstar identified by name several Google products and services, including Google Ads, Google, AdWords, Google AdWords Express, the Google Search App, and AdSense for Search.

‘by the date set for completion of claim construction discovery.’” *Id.* at 1 (Lahad April 18 email to Roberts). Google did not reply.

Google served its invalidity contentions on May 23, 2014. Google provided charts for 39 anticipatory references. Google also appended “Exhibit B” to its invalidity contentions that contained seven tables, Table B1 to Table B7. Exhibit 1 (Exhibit B to Google’s Invalidity Contentions).² According to Google, these tables contain the prior art references that could be combined – in any number of ways – with any one of the 39 anticipatory references to form various obviousness combinations. As Google explained in its preambles to the tables:

To the extent the references addressed in claim charts A-1 to A-39 does [sic] not disclose the limitations identified in each chart citing Table B1, one of ordinary skill in the art would be motivated to combine the references addressed in claim charts A-1 to A-39 with any one or more of the Table B1 references listed below because: it would have yielded predictable results; using the techniques of the Table B1 references would have improved the primary or obviousness references in the same way; and applying the techniques of the Table B1 references to improve primary or obviousness references would have yielded predictable results.

Id. at 4 (emphasis added). In other words, Google’s position is that it can combine any charted anticipatory reference with any combination of the dozens of references in its Exhibit B tables. Table B1, for example, has over two dozen references. Thus, under Google’s approach, it could combine Anticipatory Reference A1 with Obviousness References B1, B2, and B3 or A1 with B1, B4, and B17, or A1 with B1, B2, B3, B4, and B5 and so forth. This results in literally millions of potential obviousness combinations.

² Unless otherwise noted, all exhibit citations are to the exhibits attached to the declaration of John P. Lahad.

Rockstar complained to Google that its approach to obviousness vitiated the notice function of Patent Rule 3-3(b), which requires identification of each combination and the motivation to combine each item of prior art. Google disagreed. According to Google:

[T]he number of possible obviousness combinations disclosed in Google's invalidity contentions is a function of the number of claims Rockstar has asserted against Google. If Rockstar is concerned with the breadth of Google's invalidity case, Google proposed a solution: entry of the Court's Model Order, which will streamline the case. Google will narrow the scope of its invalidity case under the timeline set forth in the Model Order.

Exhibit 2 (Roberts June 23 letter to Lahad).

In response, Rockstar explained that the Model Order would not cure the prejudice to Rockstar caused by Google's impermissibly high number of obviousness combinations:

We disagree, however, that entry of the Order reducing claims and prior art references "provides a solution to at least one of Rockstar's complaints regarding Google's invalidity contentions," as you suggest in your letter. Regardless of the number of claims asserted, Google improperly wishes to rely on an impermissibly high number of obviousness combinations. Contrary to your statement, the number of possible obviousness combinations is not a function of the number of the claims asserted. The numbers prove this.

Each table in Google's Exhibit B includes an introductory statement that "one of ordinary skill in the art would be motivated to combine the references addressed in claim charts A-1 to A-39 with any one *or more* of the Table [] references listed below..." Table B1 contains over two dozen references. If Plaintiffs asserted only the claims from the '969 Patent and Google likewise asserted only the various combinations of references in Table B1, Plaintiffs would still be forced to prosecute their case in the face of millions of prior art combinations. Google cannot simply establish a massive pool of prior art references and then extract any number of combinations at any time. This is insufficient notice of Google's invalidity theories, and entry of the Model Order does nothing to resolve this.

Doc. 105-5 (Lahad June 25 Letter to Roberts) at 2.

As a compromise, Rockstar proposed that Google agree to identify 50 references initially – instead of the 40 references provided for by the Model Order – wherein each obviousness

combination counts as a separate reference. *Id.* at 3. Google declined, and prepared a joint motion to adopt the Model Order “as-is” – incorrectly claiming that Rockstar had agreed to the unmodified Model Order. Doc. 105-6 (Yang June 30 email to Lahad) at 2. That is, Google proposed adoption of the Model Order without modification just two days before it filed its current Motion.

On July 2, 2014, Google advised Rockstar of its intent to withdraw 12 anticipatory references in response to Rockstar’s withdrawal of one of the patents-in-suit. Exhibit 3 (Yang July 2, 2014 email to Lahad). Google argued that this demonstrated the effect of reducing claims on the number of prior art combinations. Rockstar disagreed, and on July 3, 2014, Rockstar informed Google that it intended to move to strike Google’s obviousness combinations. *Id.* During the subsequent in-person meet and confer, counsel for Google offered to submit a proposal to address Rockstar’s concerns with Google’s obviousness combinations. More than one week later, Google proposed limiting its obviousness case to no more than five references for each table in Exhibit B and no more than 30 references total. Exhibit 4 (Yang July 18 email to Lahad). Google also “reserve[d] its right to rely on the other references identified in Exhibit B as the case evolves.” *Id.*

Rockstar declined Google’s proposal. Exhibit 5 (Lahad July 21 email to Yang). Rockstar explained that Google’s proposal does not cure the prejudice and provide the required notice. *Id.* Despite the reduction in the number of references, Google’s proposal still yields thousands of possible combinations and does not identify sufficiently the prior art combinations Google will assert. *See, e.g., LML Patent Corp. v. J.P. Morgan Chase & Co.*, No. 2:08-cv-448, 2011 WL 5158285, at *4 (E.D. Tex. Aug. 11, 2011) (Folsom, J.) (“Patent Rule 3-3(b) requires disclosures of combinations, not just references, and thus does not expect the patentee to

consider every possible combination of the references cited.”). This is further compounded by Google’s reservation of “its right to rely on the other references identified in Exhibit B as the case evolves.” Rockstar cannot agree to entry of the Model Order limiting claims without knowing the bases for Google’s obviousness case.³

II. There is No Good Cause For Intermediate Selection

In its present Motion, Google demands that this Court order Rockstar “to reduce the number of asserted claims to 15 claims per patent and no more than 50 total by July 14, 2104, or as soon thereafter as this matter can be heard.” Doc. 150 at 9. There is no good cause for this intermediate selection of claims, and Google’s purported justifications were considered and rejected by the Eastern District of Texas Local Rules Committee during its drafting of the Model Order.

Google argues that “[a] reduction in the number of claim terms by September 2, the close of claim construction discovery, is too late to substantially reduce the costs associated with claim construction.” *Id.* at 10. The original version of the Model Order required preliminary election of claims within “40 days after the accused infringer is required to produce documents sufficient to show the operation of the accused instrumentalities.” Exhibit 6 (General Order 13-20) at 7.

According to the Rules Committee, however:

[T]he later preliminary election reflects the fact that the completeness of an accused infringer’s initial production of documents sufficient to show the operation of the accused instrumentality is often subject to reasonable debate. The later preliminary election allows time to resolve such matters.

Id. at 12. This case is not immune from the debate underscored by the Committee. In fact, Google will not be producing source code until August at the earliest, and the completeness and

³ As explained in Rockstar’s forthcoming Motion to Strike, Google’s approach to obviousness does not comply with the letter and spirit of P.R. 3-3, and its Exhibit B should be struck.

scope of this source code production – and of Google’s production as a whole – remains to be seen.⁴

Google also argues that the Court should accelerate claim election in order “to allow the parties to focus on construing a more reasonable number of asserted claims, and not waste time and resources on claims that will never see trial.” Doc. 105 at 10. The Local Rules committee likewise accounted for this issue in crafting the Model Order:

[T]he later deadline allows initial claim construction disclosures to take place, giving the parties the benefit of each other’s claim construction positions in making their preliminary elections. At the same time, the preliminary election is early enough to avoid undue expense from briefing and arguing excess claim construction issues.

Exhibit 6 at 13 (emphasis added). Google’s proposal is inconsistent with one of the goals of the Model Order, *i.e.*, to allow for election after proposed constructions have been exchanged.

Google closes by referencing the parties’ identification of 110 claim terms for construction. Doc. 105 at 11. Google forgets to mention that it is responsible for 100 of those

⁴ P.R. 3-4(a) requires a party opposing a claim of patent infringement to produce or make available for copying or inspection source code for the accused instrumentalities at the time it serves its invalidity contentions. The Protective Order in this case, issued by this Court on June 19, 2014, states that source code will be made available for inspection “upon reasonable notice to [Google], which shall not be less than three business days in advance of the requested inspection.” Google failed to produce source code with its invalidity contentions or after receiving the agreed-upon three days’ notice. During discussions on this issue, Google took the erroneous position that production of other technical documents was sufficient under the Patent Rules. In *Edward D. Ioli Trust v. Avigilon Corp.*, No. 2:10-cv-605, 2012 WL 5830711, at *3 (E.D. Tex. Nov. 16, 2012), Judge Gilstrap held that “[t]his District’s P.R. 3-4(a) requires the alleged infringer to produce any and all documents describing the operation of any aspects or elements of an accused instrumentality,” and that P.R. 3-4(a) “clearly covers source code, regardless of what additional materials may exist to disclose the functionality of the technology at issue.” (Emphasis added). Google still has not produced a single line of source code and has committed only to produce a “substantial” portion of its source code in August. Google cannot drag its feet on source code production and simultaneously demand reduction in asserted claims. This, too, does not comport with the Model Order.

terms despite the fact that, as Google concedes at 3, “the asserted claims are highly repetitive, and many are method and system analogs.” In other words, the number of asserted claims does not reflect the number of potential claim construction disputes.

III. Rockstar Would Be Amenable to the Model Order Provided Google Complies with Its Patent Rule 3-3 Obligations

Entry of the Model Order and the parties’ disclosure obligations under the Patent Rules are mutually exclusive; however, the Model Order is premised on the parties meeting their disclosure obligations. As the Local Rules Committee recognized:

In the experience of the members of the working group, the costs associated with invalidity contentions and claim construction are two of the most significant costs incurred in the pretrial phase of patent cases. However, reducing the cost of invalidity contentions through an early election has proved elusive considering the early stage at which invalidity contentions are served and the overriding need to give both plaintiffs and defendants sufficient information to make a meaningful election.

Exhibit 6 at 11. In this case, Rockstar would be amenable to entry of the Model Order provided that Google identify with specificity the obviousness combinations it intends to assert. As it currently stands, the Model Order would require Rockstar to select claims in the face of thousands of obviousness combinations. This is hardly the “sufficient information” needed to make a “meaningful election” under the Model Order.

In response to Rockstar’s demand for further clarity, Google’s has said that it will specifically identify prior art combinations as required under the Model Order, which means that it will identify combinations on January 19, 2015, two weeks after the close of discovery. This is too late. P.R. 3-3 requires identification of combinations now.

The Rules Committee cited the need for “increased flexibility” for defendants to “develop the appropriate combinations as discovery proceeds.” Exhibit 6 at 15. This flexibility to develop appropriate combinations, however, does not give defendants freedom to drown plaintiffs in a

pool of potential references “any one or more” of which could be combined with references from another pool to create an obviousness case. Because, as the Rules Committee appreciated, “[a] small number of prior art references can be combined to form an exponentially greater number of bases for invalidity,” Exhibit 6 at 14, the Model Order’s provision for identification of specific combinations after the end of discovery does not remedy Google’s deficient disclosures.

This Court should deny Google’s Motion.

DATED: July 21, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that all counsel of record, who are deemed to have consented to electronic service are being served this 21st day of July, 2014 with a copy of this document via the Court's CM/ECF system per Local Rule CD-5(a)(3).

/s/ John P. Lahad
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