**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' MOTION TO STRIKE
DEFENDANT GOOGLE INC.'S DEFICIENT OBVIOUSNESS DISCLOSURE
UNDER PATENT RULE 3-3(B)**

3251956v1/013149

In *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), Judge Folsom held that when it comes to an accused infringer's obviousness defense, "Patent Rule 3-3(b) requires disclosures of <u>combinations</u>, not just references, and <u>thus does not expect the patentee to consider every possible combination of the references cited</u>." (Emphasis added). In this case, Defendant Google Inc. ("Google") shirks its disclosure obligations, fails to identify a reasonable number of prior art combinations, and wants Plaintiffs Rockstar Consortium US LP and Netstar Technologies LLC ("Rockstar") to "consider every possible combination of the references cited," which numbers in the <u>millions</u>.

Further, instead of articulating a specific motivation to combine each combination as required by Rule 3-3(b) – which is nearly impossible under Google's flawed approach – Google relies on boilerplate language that any one of the millions of combinations "would have yielded predictable results" and "would have improved the primary or obviousness references in the same way."

The Patent Rules' disclosure requirements were designed to avoid this type of obviousness by ambush, and Google's deficient disclosure significantly prejudices Rockstar's prosecution of this case. Rockstar should not be made to go through discovery in the shadow of millions (or even thousands) of potential obviousness combinations only to have Google's expert select a small number of those combinations when opining on validity of the patents-in-suit. Because Google's obviousness disclosure does not provide the notice required by Patent Rule 3-3(b) and significantly prejudices Rockstar, it should be struck.

I.   Factual Background

In its May 23, 2014 Invalidity Contentions, Google provided claim charts for 39 allegedly anticipatory references. Google also appended "Exhibit B" to its Invalidity Contentions. Exhibit B contains seven tables, Table B1 to Table B7, that list several prior art

references and include a handful of quotations from each reference. Exhibit 1 (Exhibit B to Google's Invalidity Contentions).[1] According to Google, the references in these Exhibit B tables can be combined – in any number of ways – with any one of the 39 anticipatory references to form various obviousness combinations. As Google explains in its preamble to each of 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 <u>with any one or more</u> 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). Google has thus taken the position it can combine Anticipatory Reference A1 with Obviousness References B1, B2, and B3; or A1 with B1, B4, and B5; or A1 with B1, B2, B3, B4, and B5; and so forth to fashion any obviousness combination it wants to assert in this case and at trial. Google's flawed approach results in millions of potential obviousness combinations.[2]

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

[2] For example, Table B1 lists 28 individual references. Given 28 individual references and using the formula $\dfrac{n!}{(n-r)!(r!)}$ where n equals the number to choose from and r equals the number chosen, there are 378 possible combinations of <u>two</u> references; 20,475 combinations of <u>four</u> references; and 13,123,110 possible combinations of <u>ten</u> references. This data reflects the combinations of references from a single table in Exhibit B. Adding individual references from other tables increases the number of possible combinations by several orders of magnitude.

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 merely reducing the number of asserted claims 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.

Exhibit 3 (Lahad June 25 letter to Roberts) at 2. In the spirit of compromise, Rockstar proposed that "Google identify 50 references by September 16, 2014, wherein each obviousness

combination counts as a separate prior art reference, and describe with additional clarity the relevant motivations to combine." *Id*. at 3. Google declined, and again relied on its contention that Rockstar had asserted too many claims. Exhibit 7 (Yang June 30 letter to Lahad) at 1.

On July 2, 2014, Google advised Rockstar of its intent to withdraw 12 of its asserted anticipatory references in response to Rockstar's withdrawal of one of the patents-in-suit. Exhibit 4 (Yang July 2 email to Lahad). Google argued that this demonstrated the effect of reducing claims on the number of prior art combinations. *Id*. 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 on July 10, 2014, counsel for Google offered to submit a proposal to address Rockstar's concerns with Google's obviousness disclosure.

Eight days 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 5 (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 6 (Lahad July 21 email to Yang). Rockstar explained that Google's proposal would not cure the prejudice and provide the required notice. *Id*.

II.   Legal Standard

It is well established that "Local Patent Rules are a valid exercise of the court's authority to manage its docket in accordance with the Federal Rules of Civil Procedure." *Finisar Corp. v. DirecTV Group, Inc.*, 424 F. Supp. 2d 896, 899 (E.D. Tex. 2006). In *Cummins-Allison Corp. v. SBM Corp.*, No. 9:07-cv-196, 2009 WL 763926, at *1 (E.D. Tex. Mar. 19, 2009), the court explained that the purpose of the Patent Rules is to "further the goal of full, timely discovery,

and provide all parties with adequate notice and information with which to litigate their cases, not to create supposed loopholes through which parties may practice litigation by ambush." *See also Realtime Data, LLC v. Packeteer, Inc.*, No. 6:08-cv-144, 2009 WL 4782062, at *2 (E.D. Tex. Dec. 8, 2009) (citing *Cummins-Allison*).

Likewise, the purpose of P.R. 3-3 is to place the plaintiff on notice of potentially invalidating art that a defendant will assert in their case and at trial. *Id*.; *see also Cummins-Allison*, 2009 WL 763926, at *4. P.R. 3-3(b) requires:

> Not later than 45 days after service upon it of the "Disclosure of Asserted Claims and Infringement Contentions," each party opposing a claim of patent infringement, shall serve on all parties its "Invalidity Contentions" which must contain the following information:
>
> …
>
> (b) Whether each item of prior art anticipates each asserted claim or renders it obvious. If a combination of items of prior art makes a claim obvious, each such combination, and the motivation to combine such items, must be identified.

As Judge Clark warned, "[m]ere 'suggestion' does not suffice." *Cummins-Allison*, 2009 WL 763926 at *4.

III.   Google's Obviousness Disclosure Does Not Comply with Patent Rule 3-3(b)

Patent Rule 3-3(b) requires a party challenging the validity of a patent to provide a complete and specific disclosure: "If a combination of items of prior art makes a claim obvious, each such combination, and the motivation to combine such items, must be identified." (Emphasis added). It is not sufficient notice to "identify" millions or even thousands of possible combinations, which is what Google has done.

Google's failure to disclose obviousness combinations significantly prejudices Rockstar. How can Rockstar be expected to conduct discovery into Google's invalidity case without notice of the combinations in play? To date, Google has issued several third-party subpoenas, and

likely will issue dozens more, regarding validity. Will the subjects of these subpoenas be part of

Google's obviousness case, and if so, how? The disclosures required by P.R. 3-3(b) are intended

to answer these questions. Google's disclosures do not. This hide-the-ball approach to

obviousness does not comply with the letter and spirit of P.R. 3-3(b), and Google's Exhibit B

should be struck.

The motivation behind Google's approach is no secret. By disclosing two sets of

references and claiming that one of ordinary skill in the art would be motivated to combine a

reference in the first set with any one or more references in second set, Google (and its expert)

seeks to reserve for later use any combination it sees fit. When later challenged on a

combination, Google will point to this purported disclosure and argue that Rockstar had notice of

the combination.[3] But notice of millions of combinations is no notice at all.

In *LML Patent Corp.*, the plaintiff moved to strike 28 previously-unidentified prior art

combinations. Defendant responded that the challenged combinations were "merely new

combinations of previously disclosed references." 2011 WL 5158285 at *1. Defendant added

that the plaintiff would suffer no prejudice because it was "already familiar with the references at

issue" and "had an opportunity to take discovery regarding them." *Id.* Citing P.R. 3-3(b), Judge

Folsom rejected this argument:

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[3] Google's obfuscation of the relevant combinations until later in litigation would not be unique
to this case. In *Superspeed, LLC v. Google Inc.*, pending in the Southern District of Texas
before Judge Lake, the plaintiff moved to strike portions of Google's expert's invalidity report
because he "ignores the majority of references cited in Google's contentions and instead devotes
a substantial section of his report to arguments about such previously undisclosed combinations,
picking and choosing components from disparate sections of the Invalidity Disclosures and
arguing that together they render obvious certain claims in the Plaintiff's patents." SuperSpeed's
Motion at 1, *SuperSpeed, LLC v. Google Inc.*, No. 4:12-cv-1688 (S.D. Tex. July 7, 2014), ECF
No. 160. Rockstar seeks to avoid this exact situation by bringing this motion.

On one hand, Defendants served Plaintiff with their new combinations more than three months before the trial setting, which would appear to allow Plaintiff sufficient time to analyze them and respond before trial. On the other hand, Patent Rule 3–3(b) requires disclosure of combinations, not just references, and thus does not expect the patentee to consider every possible combination of the references disclosed. P.R. 3–3(b) ("If a combination of items of prior art makes a claim obvious, each such combination, and the motivation to combine such items, must be identified.").

Id. at *4. The court added, "Defendants present no authority holding that new combinations are permissible simply because the constituent references were previously disclosed." *Id.* at *6. Here, as the defendant did in *LML Patent Corp.*, Google discloses several constituent references and wants Rockstar to consider every possible combination of them. As Judge Folsom found, this approach does not comply with P.R. 3-3(b).

In *Realtime Data*, the plaintiff similarly sought to preclude the defendant's reliance on previously-undisclosed obviousness combinations. The court found that "invalidity theories relying on these references violate the express requirements and underlying purpose of Patent Rule 3-3." 2009 WL 4782062 at *3. The court rejected the defendant's argument that an appendix listing over 500 prior art references and a clause purporting to "reserve the right to combine references" found in that appendix provided adequate notice of potential combinations. *Id.* According to the court, "this type of disclosure cannot serve as sufficient notice because Citrix disclosed over 500 prior art references in Appendix J, <u>resulting in an impossibly high number of combinations to reasonably serve the notice function contemplated by the Patent Rules</u>." (Emphasis added). Like the *Realtime Data* defendant's disclosure, Google's Exhibit B fails to adequately identify specific obviousness combinations, results in an impermissibly high number of combinations, and fails to reasonably serve the notice function of P.R. 3-3(b).

In correspondence on this issue, Google tried to distinguish *Realtime Data* on the grounds that it "dealt with invalidity defenses raised after the close of expert discovery." Exhibit 7 (Yang June 30 letter to Lahad). This distinction, if it is one, is immaterial. The court specifically addressed the obligations imposed by P.R. 3-3(b) and found them unmet by "an impossibly high number of combinations."

Google also sought to distinguish *Realtime Data* by arguing that the "references in *Realtime* were listed in an appendix 'without any explanation of how the references anticipate or render obvious the asserted claims.'" *Id*. Regardless of any absence of explanations, the court unambiguously found that the failure to enumerate the obviousness combinations that would be in play warranted exclusion. The court could not have been clearer: "Despite narrowing the number of relevant references, however, the Court finds that it remains difficult, if not impossible, to assess which combinations Citrix intends to assert against the specific claims at issue here." *Realtime Data*, 2009 WL 4782062 at n.7.

The holdings of *LML Patent Corp*. and *Realtime Data* confirm the inadequacy and non-compliance of Google's obviousness disclosures under P.R. 3-3(b). Accordingly, this Court should strike Google's Exhibit B.

IV.   Google's Boilerplate Motivations to Combine Do Not Suffice

Google prefaces each table in Exhibit B with the same preamble:

> 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 B[], 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 B[] references listed below because: it would have yielded predictable results; using the techniques of the Table B[] references would have improved the primary or obviousness references in the same way; and applying the techniques of the Table B[] references to improve primary or obviousness references would have yielded predictable results.

Exhibit 1 at 4, 28, 53, 81, 151, 207, and 219. Thus, according to Google, regardless of the scope and content of the references combined, regardless of the number of references combined, and regardless of the claims against which the combination is asserted, the motivation to combine is identical. This, too, does not accord with P.R. 3-3(b). P.R. 3-3(b) requires identification of motivations to combine with the same specificity as the actual combinations. *Realtime Data*, 2009 WL 4782062 at *2 (describing the requirements of P.R. 3-3 to include "the identity of the combination of items of prior art that makes a claim obvious <u>and the motivation to combine such items</u>") (emphasis added). This further supports striking Google's deficient disclosure.

V.   Google's Proposal Does Not Cure Its Defective Disclosure

In response to Rockstar's complaints, Google tacitly acknowledged the deficiency in its approach and offered to reduce the number of references in its Exhibit B tables. Yet even with this reduction in references, Google's proposal still fails to identify sufficiently the prior art combinations Google may assert. Under conservative estimates, Google's proposal results in several thousand combinations, which is still far too numerous to provide the required notice. Indeed, that Google's proposal does not cure its defective disclosure speaks volumes about the intrinsic inadequacy of its approach.

Moreover, Google's "narrowing" proposal has no teeth because Google refuses to be bound by its selection. Instead, Google "reserve[s] its right to rely on the other references identified in Exhibit B as the case evolves." In other words, Google wishes to retain the option to resurrect any unselected reference and cobble together a new combination at its whim. In *Realtime Data*, the court rejected this end run around the rules:

> The Court does not find that reserving the right to combine any charted prior art references offers a plaintiff sufficient notice to adequately rebut a defendant's largely undisclosed invalidity theories. Language preserving a defendant an

opportunity to later rely upon undisclosed combinations does not "clearly suggest" the combination in the manner required by Patent Rule 3-3.

2009 WL 4782062 at *3 (citing *Cummins-Allison*, 2009 WL 763926, at *3-4); *see also LML Patent Corp.*, 2011 WL 5158285 at *6 (citing *Realtime Data*).

VI.   Conclusion

Google's approach to obviousness indisputably does not comply with P.R. 3-3(b). At each turn, Google has argued that the number of asserted claims excuses its failure to comply. However, this Court's "no-excuses" policy means that Google must comply with its discovery obligations regardless of its views on the number of asserted claims. Google repeatedly has refused to do so. Accordingly, Rockstar respectfully requests that this Court strike Exhibit B to Google's May 23, 2014 Invalidity Contentions.

DATED: July 23, 2014   Respectfully submitted,

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CERTIFICATE OF CONFERENCE

I hereby certify that between June 18 and July 21, 2014 counsel for Plaintiffs (Justin Nelson, John Lahad, Amanda Bonn, Jeff Rambin, Elizabeth Derieux) repeatedly met and conferred via email and telephone with counsel for Defendant (David Perlson, Andrea Roberts, Lance Yang) regarding the issue presented in this Motion. I further certify that lead and local counsel for Plaintiffs (Max Tribble, John Lahad, Jeff Rambin) met and conferred in person with

lead and local counsel for Defendant (Charles Verhoeven, Andrea Roberts, Blake Thompson) on

July 10, 2014. The parties were unable to reach agreement on the issue presented in this Motion.

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 /s/ John P. Lahad
John P. Lahad

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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 23rd day of July, 2014 with a copy of this document via the Court's CM/ECF system per Local Rule CD-5(a)(3).

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 /s/ John P. Lahad
John P. Lahad

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