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

ROCKSTAR CONSORTIUM US LP AND NETSTAR TECHNOLOGIES LLC,	
Plaintiffs,	Civil Action No. 2:13-cv-893
v.	
GOOGLE INC.,	JURY TRIAL DEMANDED
Defendant.	

**PLAINTIFFS' REPLY IN SUPPORT OF
THEIR MOTION TO STRIKE DEFENDANT GOOGLE INC.'S DEFICIENT
OBVIOUSNESS DISCLOSURE UNDER PATENT RULE 3-3(B)**

In response to Plaintiffs' Motion to Strike its Deficient Obviousness Disclosures, Google points fingers, makes excuses, and demands praise for asserting over 125 prior art references. Google does not, however, make any effort to identify for the Court (or Rockstar) the obviousness combinations it presently asserts. Indeed, such a disclosure would choke this Court's electronic filing system. Further, contrary to Google's argument, Rockstar's prejudice stems from having to litigate against a nebulous obviousness case that Google can fashion and refashion at will.

Two weeks ago, this Court condemned a strikingly similar approach to disclosing obviousness combinations. In *Personal Audio, LLC v. Togi Entertainment, Inc*., Case No. 2:13-cv-13, at 1 (E.D. Tex. Aug. 6, 2014) (ECF No. 251), the defendants, like Google, reserved the right to rely on thousands of possible obviousness combinations. This Court rejected defendants' approach and found that "Defendants have failed to put Plaintiff on notice for the bulk of the thousands of possible combinations that result from the broad language in Defendants' invalidity contentions." In striking the defendants' disclosures, this Court rightly stated that "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*. (emphasis added).

I.   Google's Complaints Regarding Rockstar's Infringements Contentions are Immaterial

Google's complaints regarding Rockstar's infringement contentions are offered solely to distract the Court. After lodging its initial baseless complaint regarding Rockstar's infringement contentions, Google did nothing. If Rockstar's contentions were as "unreasonable" as Google claims, Google would have run to the Court as soon as practicable. Instead, Google served invalidity contentions and engaged in claim construction. Not until Rockstar filed its Motion to Strike did Google seek relief from this Court.

II.   Google Did Not Comply With P.R. 3-3(b)

Google argues that its invalidity contentions conform to P.R. 3-3(b) and "indicate each such combination." Response at 6-7. For support, Google cites an explanation from a June 3, 2014 email in which it provided an example based on Tables A-1 and B1. Examining the foundation of Google's purported explanation confirms the fallacy in Google's argument and its intent to hide the ball with respect to its obviousness case.

Google cites page 12 of Google's Table A-1, which includes the following statement:

> To the extent this reference does not teach this claim element, this reference in combination with the knowledge of one of ordinary skill in the art renders this claim element obvious. *See, e.g.:* Table B1.

Doc. 123-9 at 14. This phrase describes the first potential obviousness combination: Adapt/X plus "the knowledge of one of ordinary skill in the art." The statement also refers to Table B1, the preamble of which states:

> To the extent the references addressed in claim charts A-1 to A-39 does 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.

Doc. 117-2 at 5 (emphasis added). Table B1 includes over two dozen references. Thus, the possible prior art combinations at issue are (1) Adapt/X plus B1-A or (2) Adapt/X plus B1-A and B1-B or (3) Adapt/X plus B1-A, B1-B, and B1-C or (4) Adapt/X plus B1-A and B1-C, but not B1-B, and so forth for each possible combination. As proved in Rockstar's Motion, this amounts to millions of combinations.

Google does not dispute Rockstar's algebra. Instead, Google argues that "Rule 3-3(b) does not impose a limit on the number of combinations that may be asserted at this stage of the litigation." Response at 8. As several courts in this District have held, however, the absence of an explicit limit on the number of combinations does not give a defendant *carte blanche* to allege millions or thousands of obviousness combinations.[1]

In *Personal Audio, LLC v. Togi Entertainment, Inc*., Case No. 2:13-cv-13 (E.D. Tex. Aug. 6, 2014) (ECF No. 251), the defendants tried to rely on thousands of invalidating combinations to show obviousness. According to the *Personal Audio* defendants:

> As it would be unduly burdensome to create detailed claim charts for the thousands of invalidating combinations, Defendants have provided illustrative examples of such invalidating combinations below. For at least the reasons described above and below in the examples provided as well as in the attached claim charts, it would have been obvious to one of ordinary skill in the art to combine any of a number of prior art references, including any combination of those identified herein, to meet the limitations of the asserted claims. **As such, Defendants' inclusion of exemplary combinations does not preclude Defendants from identifying other invalidating combinations as appropriate.**

Id. at 2. This Court disagreed with the notion of "exemplary combinations" and rejected defendants' attempt to rely on thousands of references. According to this Court, "simply providing a small number of 'exemplary combinations' does not serve the notice function of the invalidity contentions as to every possible combination of a universe of references." *Id*. This Court added:

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[1] Google dedicates a few pages of its Response to describing its so-called "good faith efforts to focus the issues in the case." Response at 3-6. All Google does is recount the parties' efforts to meet and confer in good faith, which is something typically required of litigants in this District. Google's unorthodox approach to disclosing obviousness was the subject of much discussion, and as its understanding of Google's approach grew, Rockstar recognized that Google did in fact seek to rely on a massive number of obviousness combinations, which undermined any purported notice.

> The Court finds that Defendants have failed to put Plaintiff on notice for the bulk of the thousands of possible combinations that result from the broad language in Defendants' invalidity contentions. Accordingly, the Court holds that striking Defendants' multi-reference obviousness contentions is appropriate here.

Id. at 2-3.

This case is even more egregious than *Personal Audio* because here, Google did not see fit to provide exemplary combinations. And like the *Personal Audio* defendants, Google holds thousands of combinations in reserve and repeatedly relies on broad, non-binding language in its disclosures. *See, e.g.,* Doc. 123-11 (Google's Invalidity Contentions) at 12 ("Google reserves the right to rely on any combination of any prior art references disclosed herein."); Doc. 117-2 (Google's Obviousness Disclosure) at 1 ("Google reserves the right to rely on un-cited portions of the prior art references."). As this Court held, this tactic does not put a plaintiff on sufficient notice.

Further, in response to Rockstar's argument that Google's approach forces Rockstar to consider every possible combination, Google cites a single reference, Schiller, that it claims is asserted against five claims. Response at 7. Google deliberately mischaracterizes Rockstar's argument and its use of Schiller. Rockstar's argument is that it must consider every possible combination of the references cited in each of Google's obviousness tables. For example, the Schiller reference is found in Table B6 along with 15 other references. Table B6 includes the same preamble as the other tables, which allows Google "to combine the references addressed in claim charts A-1 to A-39 with any one or more of the Table B6 references listed below…." Thus, under Google's approach, one combination could be Adapt/X plus Schiller and one of the other 15 references. Another combination could be Adapt/X plus Schiller and two of the other 15 references. That is what is meant by considering every possible combination.

III.   Descriptions of the Prior Art are Not Motivations to Combine

To rebut Rockstar's argument that Google did not provide sufficient motivations to combine, Google block quotes a description of a handful of prior art references and argues that these "detailed narratives" serve as motivations to combine. This argument suffers from two main flaws. First, Google's cited excerpt does not demonstrate how a person of ordinary skill in the art would be motivated to combine the specific references cited. In fact, the cited excerpt does not even use the words motivation or combine. Simply describing prior art references does not give rise to a motivation to combine. Second, assuming Google can meet its obligation to disclose a motivation to combine through serial description of prior art, where are the remaining motivations to combine? It is undisputed that Google asserts millions of prior art combinations. Accordingly, there should be millions of motivations to combine, as P.R. 3-3(b) demands, and boilerplate recitations are not enough.

IV.   Rockstar Faces Significant Prejudice

Google adds that "Rockstar's real issue appears to be with the amount of discovery resulting from Google's combinations." Response at 12. Wrong again. Rockstar's issue is that it must go through discovery without sufficient notice of Google's obviousness theories. Google again refers to the Schiller reference and states that its contentions "identify the exemplary disclosure in Schiller, as well as each element, claim and patent implicated by Schiller." *Id*. Google, however, omits that its contentions also state that Schiller may or may not be combined with any one of several dozen references to show obvious. If Schiller might be combined with any other reference to form an obviousness combination, Rockstar is entitled to know. This is precisely the reason why P.R. 3-3(b) exists.

This Court should grant Rockstar's Motion and strike Google's obviousness disclosure.

DATED: August 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 August, 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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