

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. 13-cv-00893-RG
v.)
) **JURY TRIAL DEMANDED**
GOOGLE INC.)
) **FILED UNDER SEAL**
Defendant.)
)
)

GOOGLE INC.'S SUR-REPLY IN OPPOSITION TO PLAINTIFF'S MOTION TO STRIKE
GOOGLE INC.'S OBVIOUSNESS DISCLOSURE
UNDER PATENT RULE 3-3(b)

Rockstar's reply confirms that the issue it has with Google's invalidity contentions is that they allegedly disclose too many prior art combinations. But if that is the problem, it is entirely of Rockstar's own making. Indeed, Rockstar does not dispute that the number of Google's obviousness combinations is a proportionate and necessary response to Rockstar's 132 asserted claims, Rockstar also fails to address the inconsistency between its continued pursuit of 132 claims and its position on narrowing obviousness combinations with the Model Order of this Court, which requires a plaintiff to narrow asserted claims first. Rockstar also does not dispute that entry of the Model Order would reduce Google's obviousness combinations, even under its own "algebra." Moreover, the large number of overlapping prior art systems is a direct consequence of the fact that, as even named inventor Livermore has admitted, the patents rely entirely on preexisting technologies and add no "new technology" to the fields of Internet search engines and advertising. (8/14/2014 Livermore Depo., 270:7-15 ("Q: Do you think the associative search engine patents disclose any new type of technology? A: No."); 282:21.) ("We didn't need any new technology.")

While Rockstar complains that it is not on notice of Google's combinations, Google provided detailed and well articulated combinations in its invalidity contentions. Rockstar fails to identify any case where a court struck such combinations. Rockstar's litany of complaints about the allegedly "impermissibly high number of obviousness combinations" provide no basis for unilaterally restricting Google's properly disclosed invalidity defenses, and Rockstar's motion should be denied.

I. GOOGLE HAS REPEATEDLY ATTEMPTED TO AVOID DISPUTES REGARDING BOTH PARTIES' CONTENTIONS.

While Rockstar alleges that "Google did nothing" to address the parties disputes about their contentions until Rockstar filed its Motion to Strike, that is simply not true. Google's good faith attempts from the beginning of the case to narrow these disputes, the number of asserted claims, and the issues in this case are documented and unrebutted. (Dkt. 123, 3-6.) From the outset, on April 14, 2014, months before Rockstar raised any issue with combinations, Google requested that Rockstar

reduce its 144 originally-asserted claims, which were “far too many” and would “greatly increase the volume of Google’s invalidity contentions, which will be a burden to all parties.” (Dkt. 123-2, 2.) Rockstar did not respond. And while Rockstar advises that Google should have “run to the Court” (Dkt. 134, 1), Google sought to resolve the parties’ issues through the meet and confer process as Google understands is its duty to do. Google offered proposals to address Rockstar’s complaints regarding Google’s combinations and advocated for the entry of this Court’s Model Order. (Dkt. 123, 3-6; Dkt. 105, 4-6.) On September 3, 2014, Google even offered to remove the “one or more” language from its contentions—the language that Rockstar says is the source of Google’s allegedly “millions” of combinations. (Dkt. 117, 2; Dkt. 134, 2.) While this should have resolved Rockstar’s articulated concern, Rockstar rejected it. (Ex. A to Yang Decl.) These rejections reveal its true intention, namely, to leave Google with zero obviousness combinations to defend against 132 claims.

II. GOOGLE PROPERLY IDENTIFIED ITS OBVIOUSNESS COMBINATIONS.¹

Rockstar’s reply does not address any of Google’s cases showing that Google’s obviousness combinations comply with P.R. 3-3(b). Instead, Rockstar relies almost exclusively on *Personal Audio, LLC v. Togi Entm’t, Inc.*, Case No. 2:13-cv-13, Dkt. 251 (E.D. Tex. Aug. 6, 2014) (“*Personal Audio I*”). But *Personal Audio I* does not support Rockstar’s position that a high number of combinations necessarily violates P.R. 3-3(b). (Dkt. 134, 3.) Indeed, in *Personal Audio I*, “Plaintiff’s concern with regard to the Motion appear[ed] to be less about the total number of references disclosed, and more about whether the disclosure in the invalidity contentions is sufficient to provide notice to Plaintiff of Defendants’ invalidity theories.” *Id.*, 2. And the Court did not find P.R. Rule 3-3(b) limited the number of combinations.

Significantly, the defendants in *Personal Audio I* attempted to rely on unidentified

¹ To the extent that Rockstar asserts that its motion would strike a single reference in combination with the knowledge of one of ordinary skill, it is mistaken. (Dkt. 134, 2.) It is well-established that “a single prior art reference” in light of the state of the art is not considered “a combination of items.” *SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1356 (Fed. Cir. 2000). Google has adequately identified its single reference obviousness allegations.

combinations, stating “Defendants’ inclusion of exemplary combinations does not preclude Defendants from identifying other invalidating combinations as appropriate.” *Personal Audio I*, 2. The Court found that “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.* Google, in contrast, does not rely on “exemplary combinations” to allow it to later rely on other combinations. Instead, Google provided notice of every combination on which Google intended to rely. (Dkt. 123, 3-6.) Rockstar’s briefing confirms that it understands exactly the combinations identified by Google.² (Dkt. 117, 1-2; Dkt. 134, 2.)

Moreover, Rockstar only tells half the story of *Personal Audio*. First, in *Personal Audio*, the parties’ had served expert reports and plaintiffs had narrowed the asserted claims to 4. Here, Google still must defend against 132 claims, and claim construction has not occurred. Second, *Personal Audio I* noted that “the Court may grant Defendants leave to utilize those specific combinations if Defendants are able to identify the portion of their invalidity contentions that served to put Plaintiff on notice as to that theory of obviousness.” *Id.* Defendants subsequently moved for a ruling that certain combinations were adequately identified under P.R. 3-3(b) and that motion was granted. *Personal Audio*, Dkt. 277, 1-2 (E.D. Tex. Aug. 20, 2014) (“*Personal Audio II*”).

While *Personal Audio II* came down the day before Rockstar filed its Reply, Rockstar ignores it entirely. Perhaps this is because Google’s identification of the combinations-at-issue closely mirrors the Court-approved disclosures in *Personal Audio II*. For example, the Court in *Personal Audio II* allowed use of the following combination the “Klemets” and “Surfpunk” references. *Id.*, 1. The cited language identifying this combination is reproduced below:

[A] POSITA would have been motivated to combine any one of [Lemay-1, Klemets, Jonas, Bobo, England-1, Astle, England-2, Hooper, Clanton, Chen, Story or other references] with any one of, for example: NCSA 3 , NRL, ABC Radionet, AudioNet,

² While Rockstar complains of Google’s allegedly “broad, non-binding language,” Google confirmed it will not rely on non-identified/charted combinations. (Ex. C to Yang Decl., 1.)

CBC, CBS News, APOD, PBS, RealAudio, CNN, TravelSound, Compton-1, Compton-2, Kenner-1, Kenner-2, Kent, Keating, Morrison, Surfpunk, RealAudio Content Creation Guide, Patrick, Malesky, Sackman-1, Cline, Notess, Sackman-2, Sackman-3, Orlando Sentinel, Luther-1, Luther-2, Luther-3, Clariant, The New Yorker, Stone, PBS Preview-1, PBS Preview-2, PBS Preview-3, Snyder, News@Clarinet, Newsbytes-2, Patent, Banks, Johnston, DC Watch, Richardson, Klisheimer, IAT, Hughes, Cacas, Ojeda-Zapata 1, Winitski, NOAA Report, Kramer, Surfer, APOD-June-20, APOD-June-21, Matthews, Reisman, Gabbe, Oliver, Karpinski, and Shafran.

Personal Audio, Dkt. 109-6 (E.D. Tex. April 17, 2014). The form of this allowed disclosure is virtually identical to Google's disclosures in this case, except that Google does not just identify exemplary combinations, it identifies all asserted combinations. For example, for the limitation "providing the search results to the user," Google's Chart for the Adapt/X anticipatory reference identifies the combination references in Table B1 (Dkt. 123-9, 14) and Table B1 states:

One of ordinary skill in the art would be motivated to combine the references addressed in claim charts A-1 to A-39 [which identify Alta Vista, Buckley, Bull, Dasan, Dedrick 1994, Dedrick 1995, Dedrick Patent, DoubleClick, Merriman I, Merriman II, Excite, Filepp, FMQA, Fox, Gallagher, HealthGate, HotBot, Infoseek, Kohda '96, Kohda, Larsen, Mooney, Myaeng, Naqvi WO, NetGravity, Open Text, PBS, Peckover, Phillips, PR News, Radecki, Reese, Smart, Submit-IT, Tognazzini, Turpeinen, Lycos, Webcrawler, Wilms, and Yahoo!] with any one or more of the Table B1 references listed below [which identifies Peckover, Dow Jones Services References, Dedrick Patent, Reese, Another Search Engine, The 'Hottest' Search Engine, Filepp, Knoblock, Dummies, Naqvi WO, Bull, HealthGate, InfoSeek, Open Text, PR News, Kohda '96, Kohda '853, Fox 1993, Fox 1991, Short History, Pinkerton, Frook, Verity, Sullivan, Meeker, Dedrick 1994, Dedrick 1995, Gallagher].

(Ex. B to Yang Decl., 2.) These well articulated identifications of combinations fully satisfy P.R. 3-3(b).³

III. GOOGLE PROPERLY IDENTIFIED THE MOTIVATIONS TO COMBINE.

While Rockstar suggests that Google's disclosures of motivations to combine under P.R. 3-3(b) are merely "serial descriptions of prior art" (Dkt. 134, 5), this is demonstrably false. Google's 32-page narrative dedicated to motivations to combine is replete with specific motivations.

³ To the extent that the Rockstar argues that the "one or more" language in Google's contentions distinguishes this case from *Personal Audio*, Google disagrees. Further, Google offered to remove the "one or more" language on September 3, 2014. Rockstar, however, rejected the offer. (Ex. A to Yang Decl.).

For example, as relevant to user profiles and delivering search results and ads, Google stated:

These publications, as well as the others cited herein, recognize the problem to be solved: assisting Internet users in locating relevant information. They also evidence a trend in finding ways to solve this problem and personalize a computer users' experience through, for example user profiles and other known methods. This problem and trend would motivate one skilled in the art to integrate the elements in the Asserted Patents into a new application.

(Dkt. 123-11, 14.) The alleged “serial descriptions of the prior art” also demonstrate that the claimed features were well known, that their combination would have generated predictable results, and that one of ordinary skill would have been motivated to combine them. The passage that Rockstar complains of even states that “user preferences and user profiles were used to identify content that might be of interest to a particular user, specifically to try to solve the problem of ‘information overload’” (Dkt. 123, 9-10) and “a motivation may be found implicitly in the prior art.” *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1291 (Fed. Cir. 2006) (emphasis added). Google has more than adequately identified the motivations, as a comparison of the Court-approved motivations in *Personal Audio* further confirms. (*Compare Personal Audio I*, Dkt. 109-6, 29-30 with Dkt. 123-11, 13-44.) *KSR* also authorizes additional reasons why combinations may be obvious, such as design or market trends. Rockstar does not dispute that Google has provided these reasons. (Dkt. 123-11, 10.)

IV. ROCKSTAR FACES NO PREJUDICE.

Rockstar admits that it is not asserting that it would be prejudiced by the amount of discovery resulting from the number of Google's combinations. (Dkt. 134, 5.) Instead, Rockstar alleges that “If [a reference] might be combined with any other reference to form an obviousness combination, Rockstar is entitled to know.” (Reply, 5 (emphasis added).) Google has provided this exact information in its invalidity contentions (*See, e.g.*, Dkt. 123, 7.) Google's specific combinations are easily identified and because each combination reference is separately charted, Rockstar has not been prejudiced, even under its own “algebra” or interpretation of P.R. 3-3(b).

For the foregoing reasons, Rockstar's motion should be denied in its entirety.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3) on September 4, 2014.

/s/ Lance Yang _____

Lance Yang