

)	
I/P ENGINE, INC.,)	
)	
Plaintiff,)	
v.)	Civ. Action No. 2:11-cv-512
)	
AOL, INC. et al.,)	
)	
Defendants.)	
)	

Plaintiff I/P Engine, Inc. (“I/P Engine”) provides this Memorandum in support of its Motion to Compel Defendants’ Compliance with this Court’s Scheduling Order, or alternatively, Motion for Protective Order.

Paragraph 13(b) of the Court’s Scheduling Order of February 15, 2012, provides: “The parties shall simultaneously exchange a list of claim terms to be construed, identifying any claim element that the party contends should be governed by 35 U.S.C. § 112(6) on or before **March 14, 2012**. (D.I. 90, at 5, emphasis in original). Plaintiff timely served its list of four claim terms: “informon,” “relevance,” “combining,” and “scanning a network.” Ex. 1 at 1-2. Defendants simultaneously served a list consisting of almost *every limitation in every asserted claim* – more than forty different claim terms. Ex. 2 at 1-3. Defendants’ inclusion of every limitation in every asserted claim violates Federal Circuit law: “[D]istrict courts are not (and should not be) required to construe every limitation present in a patent’s asserted claims.” *02 Micro Int’l. Ltd.*

v. Beyond Innovation Tech. Co., 521 F.3d 1351, 1362 (Fed. Cir. 2008) (citation omitted).

Defendants, however, have made no effort to narrow their list of claim terms, even though the Court has made it clear that it would “construe no more than **ten (10) terms.**” (D.I. 90, at 5, emphasis in original).

On Thursday, March 15, Plaintiff objected to Defendants’ regurgitation of every possible claim term, pointing out that paragraph 13(c) of the Scheduling Order requires the parties to collectively agree on the list of claim terms prior to the exchange of proposed constructions, along with all of their supporting intrinsic and extrinsic evidence, and requested that Defendants narrow their list. Ex. 3 at 1. When Defendants refused to do so, Plaintiff asked for an immediate meet and confer. Ex. 4 at 1. The meet and confer was held on the afternoon of Monday, March 19. Plaintiff repeatedly sought to narrow Defendants’ list of claim terms, and Defendants resisted, instead insisting that Plaintiff offer detailed constructions and evidence for every possible term in the asserted claims.

On Tuesday, March 20, Plaintiff made multiple attempts to secure Defendants’ compliance with the Scheduling Order. Plaintiff first proposed that Defendants identify their “top 10” claim terms, as well as Plaintiff’s four terms, and the parties exchange constructions and evidence on those. Ex. 5 at 3. Defendants rejected that proposal. *Id.* at 2.

Alternatively, Plaintiff verbally proposed that each party serve their proposed construction for their respective terms on Wednesday, March 21, with Defendants indicating which of their forty-plus terms were of greatest interest to them. The parties then would meet and confer by Friday, March 23 to determine whether there is any agreement, identify the ten claim terms to be construed, and exchange full constructions and supporting evidence by Wednesday, March 29. Defendants rejected that proposal. *Id.* at 2.

Yesterday afternoon, Plaintiff offered a third proposal, proposing a list of twelve claim terms or concepts that incorporated Plaintiff's terms, plus the terms or concepts that were of greatest interest to Defendants. *Id.* at 3-4. Defendants rejected that third attempt at compromise, refused to focus their list of claim terms for construction, and refused to further engage on the issue. *Id.* at 2.

Despite considerable good faith efforts by Plaintiff's counsel the parties are at an impasse. Plaintiff believes that Defendants have failed to comply with paragraph 13(c) of the Scheduling Order, which requires the parties to collectively agree on the list of claim terms prior to the exchange of proposed constructions. Simultaneous with the filing of this motion, Plaintiff has served Defendants with proposed claim constructions for twelve claim terms or concepts, along with supporting intrinsic and extrinsic evidence. Ex. 6. Plaintiff asks this Court to compel Defendants to comply with paragraph 13(c) of the Scheduling Order by identifying their top ten claim terms to be construed. Alternatively, Plaintiff moves for a Protective Order to ensure that its rights are preserved against Defendants' unauthorized demands.

II. BACKGROUND

Paragraphs 13(b-d) of this Court's Scheduling Order, dated February 15, 2012, state:

b. The parties shall simultaneously exchange a list of claim terms to be construed, identifying any claim element that the party contends should be governed by 35 U.S.C. § 112(6) on or before **March 14, 2012.**

c. The parties will simultaneously exchange a preliminary proposed construction of each claim term the parties collectively have identified for claim construction purposes on or before **March 21, 2012.** The parties shall also, for each element which any party contends is governed by 35 U.S. C. § 112(6), identify the structure(s), act(s), or material(s) corresponding to that element. The parties shall also identify all references from the specification or prosecution history that support its construction and an identification of any extrinsic evidence known to the party on which it intend to rely either to support its proposed claim construction or to oppose any other party's proposed claim construction, including, but not limited to, as permitted by law, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses.

d. The Court will construe no more than **ten (10) terms**.

(D.I. 90, at 5, emphasis in original).

On March 14, 2012, the parties exchanged a list of claim terms to be construed. Plaintiff provided Defendant with a list of four proposed terms for construction: “scanning a network,” “informon,” “relevance,” and “combining.” Ex. 1 at 1-2. Defendants provided a list of forty-one proposed terms or phrases for construction, and four additional issues to be decided by the Court. Ex. 2 at 1-3. Defendants’ proposed list listed virtually every element of the asserted claims, was unfocused, repetitive, and made no effort to focus on key issues in dispute. Defendants’ list consisted of the following terms or phrases:

- 1) “informons relevant to a query”
- 2) “information relevant to a query”
- 3) “relevance to a query”
- 4) “relevance to at least one of the query and the first user”
- 5) “informon”
- 6) “scanning a network to make a demand search for informons relevant to a query from an individual user”
- 7) “a scanning system for searching for information relevant to a query associated with a first user in a plurality of users”
- 8) “wherein the searching step comprises scanning a network in response to a demand search for the information relevant to the query associated with the first user”
- 9) “demand search”
- 10) “searching [for information relevant to a query associated with a first user]”
- 11) “user”
- 12) “individual user”
- 13) “first user”
- 14) “content-based filter”
- 15) “content-based filter system”
- 16) “content-based filter for receiving informons from the scanning system”
- 17) “receiving the informons in a content-based filter system from the scanning system”
- 18) “content profile”
- 19) “content profile data”
- 20) “a feedback system for receiving collaborative feedback data from system users relative to informons considered by such users”
- 21) “feedback system for receiving information found to be relevant to the query by other users”
- 22) “collaborative feedback data”
- 23) “passive feedback data”

- 24) “combining the information from the feedback system with the information from the scanning system”
- 25) “combining the information found to be relevant to the query by other users with the searched information”
- 26) “filtering the combined information for relevance to at least one of the query and the first user”
- 27) “informons”
- 28) “the informons”
- 29) “users”
- 30) “such users”
- 31) “a query”
- 32) “the query”
- 33) “a feedback system”
- 34) “the feedback system”
- 35) “a scanning system”
- 36) “the scanning system”
- 37) “a first user”
- 38) “the first user”
- 39) “a content-based filter system”
- 40) “the content-based filter system”
- 41) “the scanning system”

In addition, Defendants sought resolution of the following issues:

- 42) whether “the system for scanning, content-based filter system, and feedback system must all be different systems,”
- 43) whether “the scanning system, feedback system, and content-based filter system must all be different systems,”
- 44) the “order of steps of ‘420 Patent Claim 25,” and
- 45) the “order of steps of ‘664 Patent Claim 26.”

Id.

Immediately after receipt of Defendants’ list, Plaintiff wrote that it was “unreasonable for the parties to exchange constructions for more than thirty terms or phrases when the Court has expressly limited its construction to ten terms.” Ex. 3 at 1. Plaintiff suggested that, since Defendants had included in their list the four terms from Plaintiff’s list, Defendants should identify an additional six claim terms to be construed. *Id.* The next day, Defendants replied, refusing to modify their list of claim terms in any way. Ex. 7 at 1-2. Defendants acknowledged that their approach was based upon a dissatisfaction with the Court’s limitation of construing no

more than ten claim terms, insisting that “this does not mean that the parties are required to discuss only 10 terms.” *Id.* at 1. By placing virtually every word of the asserted claims at issue for construction, Defendants are trying to make a record that there are more than ten claims potentially in dispute. *Id.*

The problem with Defendants’ approach, of course, is that it fails to make any progress towards identifying the issues that are fundamentally in dispute, and that are relevant to issues of infringement or validity. Instead, Defendants are employing a scattergun approach of disputing everything, and refusing to narrow the list of terms.

Hoping to resolve the matter, Plaintiff requested a meet and confer for the next business day, Monday, March 19. Ex. 4 at 1. During the meet and confer, Plaintiff explained that it was unreasonable for the parties to exchange constructions and supporting evidence for over forty claim terms when the objective was to identify ten disputed terms. Plaintiff also explained that requirements of the Scheduling Order to identify all intrinsic and extrinsic evidence for every term, of every limitation, of every asserted claim, was unduly burdensome, especially since more than 75% of those terms would not be the subject of the Court’s *Markman* hearing. Plaintiff urged Defendants to eliminate the repetition of terms, and to identify their key terms to help narrow the list of terms for construction. Defendants resisted narrowing their list of forty-plus terms (although they did say they would “defer” some duplicative terms). After approximately ninety minutes of negotiating, the parties concluded the meet and confer with an agreement that Defendants would send Plaintiff a revised list of claim terms later that evening.

At 9:04 p.m., Defendants emailed a revised list of claim terms, phrases, and concepts that did not meaningfully narrow anything. Ex. 5 at 5-7. Defendants continued to insist that the parties construe virtually every claim term and limitation in the asserted claims. In fact,

Defendants added to their list, claiming that their March 14 list inadvertently omitted the phrases “receiving information found to be relevant to the query by other users” and “a feedback system for receiving information found to be relevant to the query by other users.” *Id.* Defendants offered to defer “without prejudice to raising these terms at some later time” eight terms.¹ Defendants’ revised list, however like their original list, demands construction of over 90% of the words in the asserted claims. Ex. 8. With no trace of irony, Defendants stated, “We feel this a very reasonable list.” Ex. 5 at 6.

Yesterday, Plaintiff made repeated efforts to find a compromise, since all parties agreed that, by the time the briefs were submitted, there would be no more than ten claim terms in dispute. Plaintiff reiterated to Defendants that requiring proposed constructions for such a large number of claim terms was inconsistent with the Court’s Scheduling Order. *Id.* at 3-4. In its email, Plaintiff stated that the process of collecting and preparing all of the information required by paragraph 13(c) of the Scheduling Order for every claim limitation was unworkable. *Id.* at 3.

During the day of March 20, Plaintiff proposed three alternative compromises. First, Plaintiff proposed that Defendants identify their “top 10” claim terms, as well as Plaintiff’s four terms, and the parties exchange constructions and evidence on those. *Id.* Alternatively, Plaintiff verbally proposed that each party serve their proposed construction for their respective terms on Wednesday, March 21, with Defendants indicating the terms that were of greatest interest to them; then, the parties would meet and confer by Friday, March 23, to determine whether there is any agreement; and the parties would then identify ten claim terms that could not be agreed upon

¹ The eight terms were “content-based filter,” “content-based filter system,” “content-based filter for receiving informons from the scanning system,” “receiving the informons in a content-based filter system from the scanning system,” “content profile,” “content profile data,” “passive feedback data,” and “the scanning system.” Ex. 5 at 7.

to be construed and exchange full constructions and supporting evidence Wednesday, March 29. Defendants rejected both proposals. *Id.* at 2.

That afternoon, Plaintiff put forward a list of twelve claim terms or concepts that it perceived to reflect the terms that were of greatest interest to the parties. *Id.* at 3-4. Defendants rejected that list, refused to identify their top ten claim terms for construction, and refused to further limit their list of virtually all claim terms to be construed. *Id.* at 2. Defendants also declined to continue negotiations, resulting in an impasse. *Id.* at 1.

Simultaneous with the filing of this motion, Plaintiff served proposed construction for the twelve claim terms or concepts on Defendants, along with supporting intrinsic and extrinsic evidence, as proposed as a compromise as required in the Scheduling Order. Ex. 6.

III. ARGUMENT

“Under both Rule 48(b) and its supervisory power, a district court has broad discretion to manage its docket and to impose a wide range of sanctions against parties who violate the court’s scheduling order.” *United States v. Goodson*, 204 F.3d 508, 514 (4th Cir. 2000). This discretion includes limiting the number of claim terms that a court will construe. “[D]istrict courts are not (and should not be) required to construe every limitation present in a patent’s asserted claims.” *02 Micro Int’l.*, 521 F.3d at 1362. Instead, “[c]laim construction is a matter of resolution of disputed meanings and technical scope, to clarify and when necessary to explain what the patentee covered by the claims, for use in the determination of infringement.” *Id.* (quoting *U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997)). Accordingly, a claim term should only be construed when “there is an actual, legitimate dispute as to the proper scope of the claims.” *Sunbeam Prods., Inc. v. Hamilton Beach Barnds, Inc.*, No. 2010 WL 3291830, at *1 (E.D. Va. Aug. 19, 2010) (Markman Order).

Defendants' approach to claim construction in this case, however, ignores these principles. This Court already has told the parties that it would construe no more than ten terms, yet Defendants initially proposed forty-five terms/issues for claim construction. Ex. 2 at 1-3. Defendants continue to insist that more than 90% of the words in the asserted claims must be construed. Defendants' approach is unreasonable, for three reasons.

First, the Scheduling Order provides that the Court will construe no more than ten terms, and emphasizes cooperation between the parties in identifying those terms to be construed. Defendants, however, have refused to cooperate or collaborate. Since their original proposal of over forty-five terms or concepts, Defendants have refused to meaningfully narrow their list of terms. Their offer to defer eight duplicative terms changes very little, because most of those terms still are encompassed by their remaining terms. Ex. 5 at 5-7.²

The Scheduling Order requires collaboration in identifying the 10 terms to be construed by this Court. Defendants are refusing to collaborate. Instead, they are challenging this Court's Scheduling Order, and trying to invent as many disputes as possible, perhaps to make a record for appeal. To comply with the Scheduling Order, Defendants must reduce and prioritize their list of terms.

Second, Defendants' list of terms is over-inclusive as it encompasses every element of the asserted claims. If this Court were to underline each of Defendants' proposed terms against one of the asserted claims, for example, claim 1 of U.S. Patent No. 6,775,664, there would only be three words not underlined – and many terms would be underlined multiple times. Ex. 8. The purpose of claim construction is to identify a reasonable set of specific terms that are vague or

² Defendants further attempted to disguise the breadth of their list by organizing the terms into categories of similarly suited terms. Yet, despite the admitted similarity, they still insist that Plaintiff provide proposed constructions for all of them.

unexplained, which necessitate Court interpretation to further a just outcome. *See 02 Micro Int'l.*, 521 F.3d at 1362. Interpretation of all elements in the claims is contrary to the entire purpose of the claim construction process as it effectively requires the court to provide a judgment on the entire meaning of the claims. *Id.* The Court recognizes this as it has specifically limited the terms that it will construe to ten. (D.I. 90, at 5). Defendants' refusal to focus their list is inconsistent with the Federal Circuit's decision in *02 Micro*.

Third, Defendants' list of terms is repetitive. It is possible to boil down Defendants' list to form a succinct and reasonable list of terms for construction. Defendants tacitly recognized this fact when they categorized their terms and phrases into themed sets based upon claim terms such as "relevance" or "scanning" or "feedback system" or "combining." Ex. 5 at 5-7. Plaintiff's proposed list of claim terms (and its proposed list of constructions) is consistent with Defendants' own themes. Ex. 6. But despite the similarity of the terms and the multiple elements within each phrase, Defendants insisted that the parties still provide separate constructions for virtually all of the terms in the asserted claims. This Court should compel Defendants to reduce their list by eliminating the redundancies.

IV. CONCLUSION

For all these reasons, Plaintiff requests that this Court compel Defendants to comply with paragraph 13(c) of the Scheduling Order by identifying the top ten claim terms to be construed. Alternatively, Plaintiff requests that this Court grant a Protective Order excusing it from Defendants' unauthorized demand that Plaintiff disclose proposed constructions and supporting intrinsic and extrinsic evidence for virtually every limitation in the asserted claims.

Dated: March 21, 2012

By: /s/ Jeffrey K. Sherwood
Donald C. Schultz (Virginia Bar No. 30531)
W. Ryan Snow (Virginia Bar No. 47423)
CRENSHAW, WARE & MARTIN PLC
150 West Main Street
Norfolk, VA 23510
Telephone: (757) 623-3000
Facsimile: (757) 623-5735

Jeffrey K. Sherwood (Virginia Bar No. 19222)
Frank C. Cimino, Jr.
Kenneth W. Brothers
DeAnna Allen
DICKSTEIN SHAPIRO LLP
1825 Eye Street, NW
Washington, DC 20006
Telephone: (202) 420-2200
Facsimile: (202) 420-2201

Counsel for Plaintiff I/P Engine, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of March, 2012, the foregoing **MEMORANDUM IN SUPPORT OF PLAINTIFF I/P ENGINE, INC.'S MOTION TO COMPEL DEFENDANTS' COMPLIANCE WITH THIS COURT'S SCHEDULING ORDER, OR ALTERNATIVELY, MOTION FOR PROTECTIVE ORDER**, was served via the Court's CM/ECF system, on the following:

Stephen Edward Noona
Kaufman & Canoles, P.C.
150 W Main St
Suite 2100
Norfolk, VA 23510
senoona@kaufcan.com

David Bilsker
David Perlson
Quinn Emanuel Urquhart & Sullivan LLP
50 California Street, 22nd Floor
San Francisco, CA 94111
davidbilsker@quinnemanuel.com
davidperlson@quinnemanuel.com

Robert L. Burns
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
Two Freedom Square
11955 Freedom Drive
Reston, VA 20190
robert.burns@finnegan.com

Cortney S. Alexander
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
3500 SunTrust Plaza
303 Peachtree Street, NE
Atlanta, GA 94111
cortney.alexander@finnegan.com

/s/ Jeffrey K. Sherwood _____