

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
NORFOLK DIVISION

I/P ENGINE, INC.

Plaintiff,

v.

AOL, INC., *et al.*,

Defendants.

Civil Action No. 2:11-cv-512

**OPPOSITION BRIEF TO PLAINTIFF'S MOTION TO COMPEL COMPLIANCE WITH
THE COURT'S SCHEDULING ORDER**

I. INTRODUCTION

Plaintiff's Motion to Compel Compliance With This Court's Scheduling Order should never have been filed and should be denied. Indeed, it rests on three critically false premises.

First, Plaintiff's motion assumes that this Court will not group similar terms to reach the limit of ten (10) terms in construing terms under the Court's Scheduling Order. Not only does this make logical sense, but it makes practical sense as well. This Court has grouped similar terms in the past and, if it were to agree to do so here, there would be no dispute.

Second, Plaintiff's motion incorrectly asserts that Defendants have proposed far beyond ten (10) claim term issues for construction. But just today Defendants provided to Plaintiff the following list of ten claim construction issues that remain for the Court to resolve:

1. "relevance to a query" / "relevance to at least one of the query and the first user" / "informons relevant to a query" / "information relevant to a query"
2. "scanning a network" / "a scanning system"

3. “collaborative feedback data” / “[feedback system for] receiving information found to be relevant to the query by other users”
4. “individual user” / “first user”
5. “combining”
6. “demand search”
7. “informon”
8. Antecedent basis issue for 7 term dyads
9. Separate systems issue
10. Order of steps for ‘420 claim 25 and ‘664 claim 26

Defendants indicated they intended to work with Plaintiff on numbers 1 and 7 to try to reach agreement on those terms as well, thus bringing the number of issues even lower. After Defendants negotiated in good faith until after 6 p.m. ET to attempt to solve the remaining issues, Defendants requested an extension of one day to see if the parties could finalize a resolution rather than engage in motion practice. Plaintiff refused. Indeed, at every turn, Defendants’ efforts to narrow the issues has been met with resistance. Compromises are met with threats, and getting Plaintiff to take any position at all on many terms has taken numerous calls, emails, and letters. Even today, a few days before the claim construction brief is due, Plaintiff still withholds constructions and positions for some terms.

Furthermore, I/P Engine’s motion is based on the third false premise that the Court’s Scheduling Order requires that each party initially may only identify for construction 10 words in the claims. To the contrary, Paragraph 13(b) states that 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)”, and Paragraph 13(c) goes on to state that

the “parties will simultaneously exchange a preliminary proposed construction of each claim term the parties collectively have identified for claim construction purposes”. (Dkt. 90, 5 (emphasis added).) This makes perfect sense. Parties exchange proposed constructions in advance of *Markman* briefs so they can determine which terms raise a legitimate claim construction dispute, thus requiring construction by the Court, and which terms do not—a process that typically results in substantial narrowing of the issues for presentation to the Court. In any event, as the parties have always agreed that they must meet and confer to establish a list of ten disputed terms for the Court’s construction, there is nothing to compel.

As “alternative” relief, Plaintiff asks that it be “excused” from disclosing proposed constructions. But Plaintiff has already, through self-help, refused to provide constructions for most terms when the parties were supposed to exchange constructions. Despite the impropriety of this self-help, and the inadequacy of Plaintiff’s proposed terms and constructions, Defendants tried to work with Plaintiff to establish what Defendants believe is a list of ten disputed terms for the Court’s construction. So just as there is nothing to compel, there is no issue on which a protective order could properly be sought – or on which one is even needed.

If anyone is entitled to relief it is Defendants for having to proceed through most of the claim construction process without Plaintiff’s constructions of its own patents, having its practical solutions rejected in favor of motions practice, and having to waste time responding to Plaintiff’s specious motion rather than focus on the substantive issues in the case.

II. BACKGROUND

A. The Parties’ Exchange of Terms for Construction under Paragraph 13(b) of the Scheduling Order

Paragraph 13(b) of the Court’s Scheduling Order states that the parties must exchange a list of claim terms for construction. (Dkt. 90, 5.) On March 14, 2012, pursuant to the

Scheduling Order, the parties exchanged proposed lists of terms to be construed. (Declaration of Joshua L. Sohn in Support of Defendants’ Opposition (“Sohn Decl.”), Exs. 1, 2.) Plaintiff’s list included just four terms: “scanning a network,” “informon,” “relevance,” and “combining.” (*Id.*, Ex. 1.) Plaintiff argues that Defendants listed “more than 40 different claim terms” in its March 14 submission. (Dkt. 100, 1.) This is false. Plaintiff is only able to arrive at this number by separately counting terms from Defendants’ list that present the same issue for construction.¹ For instance, Defendants sought construction for the patents’ “relevance” limitations: “informons relevant to a query,” “information relevant to a query,” “relevance to a query,” and “relevance to at least one of the query and the first user.” These terms present a common issue for resolution by the Court (namely, how the patents define relevance) and thus may be grouped together for purposes of claim construction.

In actuality, Defendants’ initial list of proposed terms raised at most fifteen issues for possible construction. (Sohn Decl., Ex. 2.)

B. The Parties’ Meet-and-Confer Efforts Following Their Exchange of Terms for Construction

After the parties exchanged their lists of proposed terms for construction on March 14, Plaintiff complained about the number of terms Defendants had proposed. (*Id.*, Ex. 3.) As it does now, Plaintiff argued that because the Court will only construe ten terms, the parties may only propose ten terms in their exchange of terms for construction. (*Id.*, 1.)

As Defendants pointed out in their response, though the Court will only construe ten terms, “this does not mean that the parties are required to discuss only ten terms.” Rather, “[t]he process provided in the Scheduling Order specifically allows the parties the time and opportunity to meet and confer regarding their list of terms and proposed constructions” so that they may

¹ Moreover, the asserted claims of the patents-at-issue – as is commonly the case for patents – contain multiple small variants on the same general claim limitations.

eventually reach agreement on a final list of ten terms for the Court to construe. (Sohn Decl., Ex. 4, 1-2.) Again, neither Paragraphs 13(b) nor 13(c) put a limit on the number of claim terms to be proposed or construed by the parties. (Dkt. 90, 5.)

After the parties met and conferred on March 19, Defendants sought to further narrow the disputed issues by dropping eight terms from their list. (Sohn Decl., Ex. 5, 10-11.) Defendants reiterated their position that many of their remaining proposed terms could be grouped together for purposes of claim construction, and proposed a revised list of eleven term groups.

Defendants also offered, as part of the parties' meet and confer process between March 14 and March 20, to postpone the deadline under Paragraph 13(c) in order to give Plaintiff more time to prepare proposed constructions and evidence in support. (*Id.*, 6.) Specifically, Defendants proposed that the parties delay their exchange of proposed constructions until Friday, March 23, and delay their exchange of supporting evidence until Wednesday, March 28. (*Id.*) Plaintiff rejected that offer. (*Id.*) Rather than provide a meaningful response, Plaintiff again repeated its request for Defendants to identify a list of "top 10 claim terms" and announced that the parties were at an impasse. (*Id.*, 5.)

C. The Parties' Exchange of Proposed Constructions and Plaintiff's Motion to Compel

Pursuant to Paragraph 13(c) of the Scheduling Order, the parties exchanged proposed constructions on the afternoon of March 21. Defendants' submission contained constructions for the 11 issues it identified for construction. (Sohn Decl., Ex. 6.) Plaintiff provided little in the way of constructions. In fact, it did not provide constructions for most of Defendants' issues. (*Id.*, Ex. 7.) Instead, Plaintiff offered constructions for a smaller number of isolated words that were contained within Defendants' term list. (*Id.*) After engaging in this self-help, Plaintiff filed its Motion to Compel the same day. (Dkt. 99.)

D. Defendants' Continued Efforts To Comply with the Court's Scheduling Order and Agree to a List of Ten Terms for the Court's Construction

In the days following their March 21 exchange, Defendants continued to work towards creating a final list of ten terms for the Court's construction despite Plaintiff's failure to provide constructions for most terms. On March 22, for instance, Defendants sent Plaintiff an email stating that "Plaintiff's Preliminary Proposed Claim Terms and Proposed Constructions reflects several areas of apparent agreement (or near-agreement) between Plaintiff and Defendants, raising the possibility that the parties could significantly narrow their list of claim terms in dispute." (*Id.*, Ex. 5, 3). Defendants then enumerated the areas where the parties appeared to have similar proposed constructions. Defendants also asked Plaintiff to respond to questions for which Defendants needed clarification. (*Id.*, 3-5.) In this same email, Defendants also agreed to one of Plaintiff's proposed constructions. (*Id.*, 3.) Plaintiff responded on March 23, but did not answer all of the questions raised by Defendants. (*Id.*) Plaintiff's March 29 letter again left questions unanswered. (*Id.*, Ex. 8; Ex. 9; Ex. 10, 2.)

The parties met and conferred on April 4, 2012. During that meet and confer and in subsequent correspondence, Defendants made efforts to narrow their list of disputed terms further in an effort to reach agreement on a list of ten or fewer terms for the Court's construction. (Sohn Decl., ¶ 17.) For instance, Defendants agreed not to seek construction of "searching [for information relevant to a query associated with a first user]." Defendants agreed to seek construction of the word "combining," as Plaintiff requested, rather than the larger phrases Defendants initially proposed. (*Id.*) Defendants also agreed to drop two phrases containing "scanning a network" and to instead just construe the term "scanning a network," as Plaintiff requested. (*Id.*) Incredibly, in return for Defendants' offering to construe the terms that Plaintiff requested, which were different than what Defendants had initially suggested, Plaintiff accused

Defendants of violating the Court's Scheduling Order because Defendants offered different constructions for these different terms. (*Id.*, Ex. 15, 3.) Of course, it is commonplace for parties to alter constructions throughout and as a result of the meet and confer process as they try to reduce the scope of disputes – indeed, this is the point of meet and confer. Plaintiff's allegation is also ironic given the evolving nature of Plaintiff's own constructions and the fact that Plaintiff itself provided constructions for almost no terms at all on the date provided in the Court's Scheduling Order. (*Id.*, Ex. 7.)

As part of the parties' correspondence following the meet and confer on April 4, the parties agreed to extend the deadline for Defendants' response to Plaintiff's Motion until April 9. (Dkt. 108.) On April 9, the parties further discussed their claim construction issues during a meet and confer. (O'Brien Decl., ¶ 2.) Defendants noted that they believed, as shown in the list above in the introduction, the parties already had no more than 10 issues for the Court to address. (Sohn Decl., Ex. 14.) Defendants further noted that they hoped to be able to reach agreement on Plaintiff's proposals for the terms "informon" and "user," as well as for the relevance terms. (O'Brien Decl., ¶ 2.) Counsel for Defendants agreed to discuss with their clients, and get back to Plaintiff as soon as possible. (*Id.*) Given the hour, however, the Defendants could not do that, and also get their Opposition on file that night. Thus, Defendants asked if Plaintiff would be willing to agree to a one or two day extension of time for Defendants' opposition to Plaintiff's motion, in order to focus their attention on resolving the claim construction issues and providing proposals, rather than finalize their Opposition to Plaintiff's motion. (*Id.*) Defendants pointed out this extension would not prejudice Plaintiff, as no ruling on Plaintiff's motion would be

likely before the parties file their Opening *Markman* brief just a few days later. Nevertheless, Plaintiff refused, forcing Defendants to file this Opposition.² (*Id.*)

III. ARGUMENT

A. There is Nothing for This Court to “Compel” Defendants to Do

Plaintiff’s Motion “requests that the Court compel Defendants to comply with paragraph 13(c) of the scheduling order by identifying the top ten claim terms to be construed.” (Dkt. 100, 11.) But this requested relief is both improper and unnecessary. It is improper because Paragraph 13(c) imposes no limit on the number of terms that may be exchanged between the parties. And it is unnecessary because the parties’ exchange of constructions under Paragraph 13(c) has long since passed.

1. Plaintiff’s Motion is Impractical and Ineffective

Plaintiff’s requested relief is impractical from a timing standpoint. Pursuant to the briefing schedule in the Court’s Local Rules, Plaintiff’s Motion may not even be fully briefed and ripe for decision until after the parties’ opening *Markman* briefs are due on April 12. (*See* Local Rule 7(F)(1); Federal Rules of Civil Procedure 6(a) and 6(d); Dkt. 90, ¶ 13(e); Dkt. 108.) Thus, by the time the Court rules on Plaintiff’s Motion, the parties will likely already have filed *Markman* briefs presenting ten terms for the Court’s construction.

2. Defendants Have Respected the Court’s Scheduling Order

Plaintiff disingenuously argues that Defendants are “challenging this Court’s Scheduling Order.” (Dkt. 100, 9.) To the contrary: Defendants respect the Scheduling Order and the Court’s authority to manage its docket. Nothing in Paragraphs 13(b) and 13(c) of the Scheduling

² Even after Defendants told Plaintiff that they could not engage in further meeting and conferring on the claim construction terms the evening of April 9 because they needed to focus on finishing this brief, Plaintiff continued to press for agreement on its proposed constructions and also misrepresent the statements made by Defendants’ counsel regarding those constructions. (O’Brien Decl., ¶ 3.)

Order places a limit on the number of claim terms or proposed constructions to be exchanged. (Dkt. 90, 5.) As noted above, the exchange of proposed constructions is the mechanism by which the parties can identify the extent to which they do or do not have a dispute for their proposed terms. The parties can then meet and confer to identify the ten terms for which they have a fundamental dispute, in order to present this final, narrowed list to the Court for construction. *See 02 Micro Int'l Ltd. v. Beyond Innovation Tech. Co., Ltd.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008) (holding that the court construes terms when “the parties present a fundamental dispute regarding the scope of a claim term”).

Defendants have at all times attempted to engage in that process in good faith. The fundamental problem here is that *Plaintiff* refuses to engage in the process of determining which terms are in dispute.

3. **Defendants' List of Terms is Reasonable**

Plaintiff fails to acknowledge that Defendants' list of proposed constructions comprises just ten terms, each presenting a single claim construction issue for resolution. (Sohn Decl., Ex. 14.) Defendants' decision to present certain term groups (rather than individual terms) for construction is both reasonable and efficient; this Court has allowed such grouping before for similar terms. For instance, it makes perfect sense to construe the terms “relevance to a query” / “relevance to at least one of the query and the first user” / “informons relevant to a query” / “information relevant to a query” together, given that these terms present the common issue of what the patents mean when they state that an entity is relevant to another entity. It likewise makes sense to construe the terms “informons” “the informons” / “users” “such users / “a query” “the query” / “a feedback system” “the feedback system” / “a scanning system” “the scanning system” / “a first user” “the first user” / “a content-based filter system” “the content-based filter

system” together, since these term dyads present a common “antecedent basis” issue – *i.e.*, whether the second mention of an entity in a claim must refer back to the first mention of that entity in the claim. Indeed, Plaintiff has now agreed to group these terms in this manner.

The same logic applies to all of Defendants’ term groups – each group should be counted as an individual term for purposes of the Scheduling Order because each group presents a single discrete issue for claim construction. Other than the fact that the words in the phrases are not identical, Plaintiff fails to acknowledge that those issues can and should be addressed together as is commonly done in patent cases where, like here, the patentee has stated a similar concept in several different ways. *See Bid for Position, LLC v. AOL LLC*, No. 2:07cv582, 2008 WL 5784151 at *5-6 (E.D.Va. July 11, 2008) (construing the similar phrases “information for selecting one of the two or more positions of priority that the first bidder wishes to maintain in the auction” and “selected one of the two or more positions of priority that the first bidder wishes to maintain in the auction” together and finding both to have the same meaning, “information entered by the bidder that indicates the bidder’s choice of one of the two or more positions of priority in the auction.”).

Plaintiff’s refusal to withdraw its motion to compel also ignores the numerous compromises that Defendants have made in meeting and conferring with Plaintiff to reach an agreed list of ten terms. As part of the meet and confer process, Defendants have agreed to withdraw the following proposed terms: “feedback system for receiving collaborative feedback data from system users relative to informons considered by such users”, “filtering the combined information for relevance to at least one of the query and the first user”, and “searching [for information relevant to a query associated with a first user]” (Sohn Decl., ¶ 17.) Defendants also agreed to withdraw its broader “combining”, “scanning a system”, and “scanning a network”

terms, in favor of Plaintiff's more narrow terms. (*Id.*) Defendants have also agreed to Plaintiff's proposed constructions for "query," and have reached a partial agreement regarding the order of steps for claim 25 of the '420 Patent and claim 26 of the '664 Patent. (*Id.*, Sohn Decl., ¶ 17; *id.*, Ex. 5, 2; Ex. 12; Ex. 13.) Finally, the parties appear to be near agreement on the relevance terms, "user" and "informon." (O'Brien Decl., ¶ 2.) Despite all of these efforts, Plaintiff has refused to withdraw its motion to compel.

Plaintiff also claims that Defendants' list of terms is "over-inclusive as it encompasses every element of the asserted claims," rather than "a reasonable set of specific terms that are vague or unexplained." (Dkt. 100, 9-10.) It is unclear why Plaintiff chose to seek the intervention of the Court with respect to this issue, because to the extent that Plaintiff believes that terms in the patent are not vague or unexplained, Plaintiff is free to assert that they should be construed according to their plain meaning.

B. No "Protective Order" is Justified.

There is no merit to Plaintiff's alternative request "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." (Dkt. 100, 11.) Because Paragraph 13(c) does not limit the number of proposed constructions that the parties may exchange, Defendants have done nothing "unauthorized." The Scheduling Order sets forth a process by which the parties identify each term they believe might require construction. Under this process, the exchange of constructions would then reveal the extent to which the parties do or do not have a dispute. Should the parties have a dispute over more than ten terms, the parties would then meet and confer to agree upon a final, narrowed list to present to the Court for construction.

Rather than engage in this process in good faith, Plaintiff instead chose to engage in obstructionist self-help.³ Plaintiff refused to provide constructions for the terms that Defendants proposed on March 21, as required by the Court’s Scheduling Order. Instead, Plaintiff provided constructions for a small subset of words in isolation. (Sohn Decl., Ex. 7.) For example, Plaintiff provided a construction for the word “relevance,” rather than a construction of the terms “informons relevant to a query,” “information relevant to a query” “relevance to a query,” “relevance to at least one of the query and the first user,” or “relevance to at least one of the query and the first user.” (*Id.*, Ex. 6, 2; Ex. 7, 4.)

Despite the impropriety of Plaintiff’s self-help, Defendants have repeatedly attempted to engage with Plaintiff to harmonize the parties’ lists and arrive at ten terms to present to the Court for construction. In addition to withdrawing proposed claim terms entirely, Defendants also agreed to withdraw the broader claim terms for construction that Defendants initially proposed – and believed to be appropriate – in favor of more narrow terms proposed by Plaintiff. (Sohn Decl., ¶ 12; *id.*, Ex. 11.) Defendants agreed to and provided constructions for narrower claim terms at Plaintiff’s request. (*Id.*, Ex. 11.) As detailed above, Plaintiff responded by accusing Defendants of violating the Scheduling Order, and asserting that these constructions should be withdrawn or else Plaintiff will go to the Court on this issue as well. (*Id.*, Ex. 15, 3.)

³ Plaintiff’s unreasonable refusal to engage in the process of claim construction is part of a pattern of behavior throughout this litigation. Plaintiff refused to respond to interrogatories posing basic questions critical to Defendants’ defenses, like conception and reduction to practice dates. As a result of Plaintiff’s repeated refusals, Defendants were forced to move to compel Plaintiff to provide these dates. (Dkt 87.) Plaintiff similarly refused to provide adequate and sufficient infringement contentions despite Defendants’ extensive early technical production. Again, Defendants Google and IAC Search were forced to move to compel Plaintiff to provide sufficient infringement contentions. (Dkt 104.)

Defendant has repeatedly attempted in good faith to reach a solution that takes into account the spirit of the Court's Scheduling Order while presenting to the Court the key claim construction terms central to the patents in suit. Plaintiff's continued pattern of refusing to engage in good faith with Defendants to reach a compromise on claim construction is improper, and should not be rewarded. Just as there is nothing to compel, there is no issue for which Plaintiff needs or deserves a protective order.

IV. CONCLUSION

For the foregoing reasons, Plaintiff's Motion should be denied. Given the Plaintiff's lack of reasonable cooperation and the additional cost heaped upon the Defendants, any relief awarded should be awarded to the Defendants. As such, this Court should award the Defendants all relief reasonable and just under the circumstances.

DATED: April 9, 2012

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CERTIFICATE OF SERVICE

I hereby certify that on April 9, 2012, I will electronically file the foregoing with the Clerk of Court using the CM/ECF system, which will send a notification of such filing (NEF) to the following:

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