

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
NORFOLK DIVISION

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

I. INTRODUCTION

This motion focuses on Defendants’ disregard of this Court’s Scheduling Order, which required the parties to identify ten claim terms for construction, and obligated the parties to disclose their constructions and supporting evidence on March 21, 2012. Defendants insisted that I/P Engine construe every limitation in every asserted claim of the two patents-in-suit – more than 40 claim terms. Defendants continued to maintain that every limitation should be construed, while simultaneously inappropriately lumping together disparate claim terms in their proposed constructions. Defendants’ ongoing defiance of this Court’s Scheduling Order is illustrated by their assertion of wholly new claim constructions in their brief of April 12, 2012; contrary to the Scheduling Order, Defendants failed to disclose many of their constructions or supporting evidence. The penalty for Defendants’ non-compliance should be to reject Defendants’ request to evade the limits on the number of claim terms, and to preclude Defendants from relying on undisclosed constructions and evidence.

Defendants' opposition generally ignores their actions prior to March 21 that caused I/P Engine to file its motion. Instead, Defendants try to portray themselves as the victims. The facts tell the real story, however. Defendants' identification (at 1-2) of what they call "three critically false premises" with I/P Engine's Motion actually illustrates the problems that have been created by Defendants' actions.

Defendants first claim that I/P Engine's motion assumes this Court will not group similar terms together to keep the total number of terms below ten. Not only does this argument tacitly admit that Defendants violated this Court's Scheduling Order by submitting more than ten terms for construction, but Defendants themselves admit that the terms included in their groupings have different meanings.

Second, Defendants deny that they have proposed more than ten claim terms for construction. Defendants' math does not compute. There are more than 40 different terms in the asserted claims, and Defendants originally proposed to construe virtually all of them. Defendants' April 12 claim construction brief itself still contains more than 20 claim terms.

Third, Defendants deny that this Court's Scheduling Order required the parties to identify ten terms for construction and identify all evidence to support those constructions. There is no question that Defendants failed to limit their construction to ten terms, or timely disclose their evidence. For example, on March 21, Defendants proposed that the seven limitations that they lumped together in their "combining" and "scanning" groupings were all indefinite, and cited no evidence in support. On April 12, however, Defendants filed their claim construction brief where they abandoned their position that those claims were indefinite, and instead provided this Court with definite constructions, despite never providing I/P Engine with any supporting evidence prior to filing their claim construction brief.

I/P Engine has been significantly prejudiced by Defendants' refusal to comply with this Court's Scheduling Order. Facing Defendants' unnecessary and illegitimate proposal of every term of every asserted claim, I/P Engine has carried the weight in trying to reduce the number of terms in dispute. As illustrated by the claim construction briefs, Defendants still refuse to comply with the Scheduling Order and brief ten terms for construction.

Defendants' failure to comply with the Scheduling Order should preclude them from asserting their constructions and evidence that was not timely disclosed on March 21. Further, this Court should not construe all of the terms identified by Defendants and should instead limit its construction to no more than ten terms, as originally intended.

II. ARGUMENT

A. Defendants' Inclusion of Almost Every Limitation in Every Asserted Claim In Its Originally Proposed Constructions Violates This Court's Scheduling Order And Federal Circuit Law

Defendants do not dispute that their March 14 list of proposed claim terms included almost every word in every asserted claim. "[D]istrict courts are not (and should not be) required to construe every limitation present in a patent's asserted claims." *O2 Micro Int'l. Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008) (citation omitted). "Claim 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)). 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.*, 2010 WL 3291830, at *1 (E.D. Va. Aug. 19, 2010) (Markman Order). This is not what Defendants have done in the present litigation.

As an example, referring to what they called the “relevance limitations,” Defendants contend (at 4) that these limitations are appropriately grouped and present “the same issue for construction . . . namely, how the patents define relevance.” Opposition at 4. When I/P Engine suggested that the parties simply construe the term “relevance,” Defendants refused. Exs. 1 and 2. Instead of cooperatively working with I/P Engine to identify the disputed claim terms, Defendants refused to acknowledge where the actual and legitimate disputes existed.¹

Defendants cite (at 10) *Bid for Position, LLC v. AOL LLC*, No. 2:07-cv-582, 2008 WL 5784151 (E.D. Va. July 11, 2008) – another case handled by the same counsel – to support their argument that Defendants’ proposed groupings are appropriate. Defendants, however, mischaracterize the facts of their own case. In *Bid for Position*, the court construed similar phrases that had one single meaning. Here, Defendants have admitted that the similar terms in each group do not have the same meaning, but different meanings. Defendants, for example, have identified in group 1 four different limitations, and provided a different construction for

¹ Defendants open their Opposition Brief (at 1) by stating “today [April 9, 2012] Defendants provided 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’ / ‘informs 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.

Not only does this list contain at least 26 different issues, but as of April 9, Defendants refused to acknowledge during negotiations that, for group 1 the issue was “relevance”, even though they admitted (at 4) that the common issue was “how the patents define relevance.”

each. As Defendants wrote in their Opening Claim Construction Brief (at 25), “[w]hile it is true that the parties have agreed to a construction for ‘relevance to a query,’ which has some overlap with the longer phrase ‘relevance to at least one of the query and the first user,’ [two of the four limitations included in group 1] construing the shorter phrase does not eliminate the need to construe the latter.” The present case is distinct from the facts of *Bid for Position*.

I/P Engine’s proposal to construe the term “relevance,” on the other hand, is consistent with this Court’s precedent and identifies the “actual, legitimate dispute” between the parties. *Sunbeam Prods.*, 2010 WL 3291830 at *1. As Defendants admit, “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.” Opposition at 12. Thus, I/P Engine’s proposal to construe just the term “relevance” was the no-nonsense approach to claim construction – which is consistent with the Scheduling Order that the Court would “construe no more than **ten (10) terms**.” D.I. 90 at 5 (emphasis in original). Contrary to the assertions of Defendants, I/P Engine did not offer constructions for a smaller number of isolated words, but instead offered a construction for the actual and legitimate disputes between the parties.²

Defendants’ as-filed claim construction brief, with their “claim groups,” illustrates the consequences of Defendants’ non-compliance with the Scheduling Order. For example, although Defendants wrote in their Opposition that the “relevance/relevant” terms are the “same

² The purpose of claim construction is to identify a reasonable set of specific terms that are vague or unexplained, which necessitate Court interpretation to further a just outcome. *See O2 Micro*, 521 F.3d at 1362. Interpretation of all elements in the claims is contrary to the entire purposes of the claim construction process as it effectively requires the court to provide a judgment on the entire meaning of the claims. *Id.*

issue,” in their *Markman* brief, Defendants agreed to I/P Engine’s proposal on “relevance,” but not on “relevant.” Defendants instead proposed different definitions for each. Likewise, Defendants constructions for “scanning a network” and “a scanning system” similarly require separate analyses. Similarly, Defendants’ discussion of the “order of steps” issue for two different claims involves entirely separate discussions of claim structure, requiring separate charts for each of these claims. Each of these issues cannot reasonably be considered “one claim term.” While Defendants are entitled to seek different constructions for different terms, they cannot lump them together by association to avoid this Court’s ten claim term limit.

B. Defendants’ March 14 Proposed List of Terms And March 21 Constructions And Evidence Violated This Court’s Scheduling Order

Defendants are not confident about how many claim terms or issues they proposed for construction. Defendants contend that their “initial list of proposed terms [served on March 14, 2012] raised at most fifteen issues for possible construction.” Opposition at 4. Defendants then contend that, during a meet and confer on March 19, 2012, “to further narrow the disputed issues,” Defendants “[dropped] eight terms from their list.” *Id.* at 5. Then, Defendants contend that their March 21, 2012 exchange of proposed constructions “contained construction for the 11 issues it identified for construction.” And then, Defendants state that, as of April 9, 2012, the parties had “no more than 10 issues for the Court to address” with hopes that the parties would reach agreement on at least three of those terms. *Id.* at 7.

Defendants’ math simply does not add up. If Defendants started with “at most fifteen issues,” then “[dropped] eight terms from their list,” and hoped to reach agreement on a minimum of three other terms – there is no mathematical way, as of April 9, ten issues could remain for this Court to address. Perhaps to mask the facts, Defendants in their Opposition do not refer to claim “terms,” but to claim “issues,” even though the Scheduling Order refers to

terms. This illustrates how Defendants' grouping of terms and original list of claim terms/issues that I/P Engine complains about was nothing more than a guise to mask Defendants' desire to propose more than ten terms for construction, *i.e.*, almost every limitation in every asserted claim – perhaps to make a record for appeal.

C. The Appropriate Remedy Is To Limit The Constructions To 10 Terms, And Preclude Defendants From Asserting Constructions And Evidence Not Timely Disclosed

This Court should not construe all of the terms identified by Defendants, because to do so would permit Defendants' willful violation of the Scheduling Order. It would also encourage similar types of gamesmanship in other cases.

Defendants' failure to comply with the Scheduling Order should preclude them from asserting their constructions and evidence not timely disclosed on March 21. For example, this Court should hold Defendants to their position that the seven limitations that they originally asserted were indefinite, and should not consider the contrary positions on those limitations that Defendants now assert in their claim construction briefs. Moreover, this Court should hold Defendants to their position that all recited method steps must occur in their recited order.

III. CONCLUSION

For all these reasons as well as those set forth in I/P Engine's Memorandum in support of its motion, I/P Engine requests that this Court sanction Defendants for not complying with this Court's Scheduling Order by rejecting Defendants' non-compliance with the limits on the number of claim terms, and by precluding Defendants from relying on undisclosed constructions and evidence.

Dated: April 16, 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
Charles J. Monterio, Jr.
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 16th day of April, 2012, the foregoing **REPLY 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 _____