

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

**DEFENDANTS' RESPONSIVE CLAIM CONSTRUCTION BRIEF**

**Introduction**

The evidence cited in Plaintiff's Opening Claim Construction Brief largely supports Defendants' proposed constructions. For example, Plaintiff repeatedly states that the claimed invention requires "collaborative" feedback, or feedback from other users with similar interests or needs. This fully supports Defendants' construction of "[feedback system for] receiving information found to be relevant to the query by other users" as a system for determining "what information other users with similar interests or needs found to be relevant." Plaintiff also cites intrinsic and extrinsic evidence showing that the ordinary meaning of "scanning" entails a sequential, item-by-item crawl of a web spider, as Defendants' construction properly provides, not that "scanning" can merely be "looking for items" as Plaintiff contends.

Where Plaintiff's Opening Brief does not provide support for Defendants' constructions, it largely ignores Defendants' constructions altogether. For example, Plaintiff refuses to take a position on which method steps must occur in order, even though Defendants have clearly staked out a position on this issue. Plaintiff does not even defend its proposed construction (or attack Defendants' proposed construction) for the terms "individual user" and "first user," instead

ignoring these terms. And Plaintiff’s repeated baseless procedural complaints regarding the claim construction process do nothing to advance resolution of the important issues before the Court on claim construction.

Because Plaintiff’s brief does nothing to rebut Defendants’ constructions – indeed, because Plaintiff’s brief largely supports Defendants’ constructions – Defendants’ constructions should be adopted.

**Argument**

**I. COLLABORATIVE FEEDBACK AND RELATED TERMS**

<i>Term/Phrase</i>	<i>Defendants’ Construction</i>	<i>Plaintiff’s Construction</i>
“[feedback system for] receiving information found to be relevant to the query by other users” (‘664 Claim 1, 26)	[System using a process of filtering information by] determining what information other users with similar interests or needs found to be relevant	No construction necessary  - or -  [feedback system for] receiving information concerning what other users found to be relevant to the query
“collaborative feedback data” (‘420 Claim 10, 25)	data from users with similar interests or needs regarding what informs such users found to be relevant	information concerning what informs other users with similar interests or needs found to be relevant

**A. Defendants’ construction of “[feedback system for] receiving information found to be relevant to the query by other users” includes the collaborative element that even Plaintiff admits is necessary to the claimed invention.**

As shown in the parties’ Opening briefs, the parties generally agree that “collaborative feedback data” connotes data or information about what informs other users with similar interests or needs found to be relevant (though they disagree about the precise construction for this term). This point is critical, because the claimed invention requires a “collaborative” element. (See Defendants’ Opening Brief (“DOB”) at 7-9.) Thus, the “feedback system for

receiving information found to be relevant to the query by other users” in ‘664 claim 1 must be construed as a feedback system for receiving collaborative information – *i.e.*, information that other users with similar interests or needs found to be relevant. The step of “receiving information found to be relevant to the query by other users” in claim 26 must also be construed as requiring collaborative information. Only with these constructions would claims 1 and 26 contain the “collaborative” element that is necessary to the claimed invention.

Notably, Plaintiff itself acknowledges repeatedly that the claimed invention must include a “collaborative” element. For example, the first page of Plaintiff’s brief states that “[t]he Lang/Kosak patents teach innovative search engine techniques that provide high-quality search results by combining content-based data with collaborative feedback data from other users to optimally satisfy a user’s need for information”. (Plaintiff’s Opening Brief (“POB”) at 1 (emphasis added).) Elsewhere, Plaintiff explains that “[i]n this nascent search engine environment that Messrs. Lang and Kosak envisioned, the content analysis evaluates how well an item satisfies a user’s query, and the collaborative analysis evaluates feedback received from other users that previously searched using the same query.” (*Id.* at 4 (emphasis added).) Plaintiff also states: “Importantly, the specification describes how the search engine information processing system filters informons for relevance to a query using both content-based and collaborative feedback data.” (*Id.* (citation omitted) (emphases added).)

Plaintiff also acknowledges that, in the context of collaborative filtering required by the invention, “feedback from other users” is feedback from other users with similar interests or needs. Indeed, Plaintiff specifically states that “[c]ollaborative filtering, on the other hand, determines relevance based on feedback from other users – it looks to what items other users with similar interests or needs found to be relevant.” (*Id.* at 3 (citations omitted) (emphasis

added).) In other words, Plaintiff acknowledges that in context of the claimed invention, which requires a collaborative element, “other users” are “users with similar interests or needs” just as Defendants’ construction provides.

As Plaintiff’s own characterization of the claimed invention supports the position that “receiving information found to be relevant to the query by other users” be construed as “determining what information other users with similar interests or needs found to be relevant,” Defendants’ construction should be adopted.<sup>1</sup>

**B. Defendants’ construction of “collaborative feedback data” properly recognizes that the “data” must come from similar users.**

As explained in Defendants’ Opening Brief, the claims and specification repeatedly state that collaborative feedback data comes from other users with similar interests or needs. (DOB at 6.)

Plaintiff asserts that requiring collaborative feedback data to come from such users “improperly imports an additional requirement [] that is not supported by the claim language or the specification.” (POB at 23.) In purported support of this argument, Plaintiff cites the specification’s definition of “collaborative filtering” and argues this definition does not say where the data to be filtered comes from. (*See id.* at 22, 23 (“[c]ollaborative filtering” involves “determining what informons other users with similar interests or needs found to be relevant.”))

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<sup>1</sup> Although Plaintiff never raised this issue in the parties’ meet and confers, Plaintiff now argues that Defendants’ construction does not account for the “to the query” portion of “[feedback system for] receiving information found to be relevant to the query by other users.” (POB at 24.) If the Court wishes to address this point, Defendants do not object to appending the words “to a query” to the end of their proposed construction. Plaintiff also argues that “there is no reason to add the ‘using a process of filtering’ limitation to this phrase when the phrase requires only the simple step of ‘receiving’ data.” (*Id.*) Plaintiff never raised this point before either. In any event, while Defendants’ construction properly acknowledges that the feedback system receives collaborative feedback data for later use in the “process of filtering” (*see* Abstract), Defendants also do not object to replacing “filtering” with “receiving” in their construction. The core dispute over this term is not the “filtering,” or the “query,” but whether the reference to “other users” must connote other users with similar interests or needs.

(citing 4:26-29).) But this is a non-sequitur. “Collaborative filtering” is a different term than “collaborative feedback data.” While both terms indisputably relate to other users with similar interests or needs, “collaborative filtering” is a filtering process that uses “collaborative feedback data.” (See Abstract (“A user feedback system provides collaborative feedback data for integration with content profile data in the operation of the collaborative/content-based filter.”).) The process of collaborative filtering itself does not come “from” users with similar interests or needs, so it is unsurprising that the specification’s definition of collaborative filtering does not contain this “from” element. On the other hand, the collaborative feedback data used in collaborative filtering does come “from” other users with similar interests or needs. As the specification states, “[c]ollaborative filtering employs additional data from other users”. (24:37-38 (emphasis added).) Thus, Defendants’ construction of “collaborative feedback data” as “data from users with similar interests or needs regarding what informons such users found to be relevant” is perfectly appropriate.

## II. “SCANNING” TERMS

<i>Term/Phrase</i>	<i>Defendants’ Construction</i>	<i>Plaintiff’s Construction</i>
“scan[ning] a network” (‘420 Claims 10, 25)	Spider[ing] or crawl[ing] a network	looking for items in a network
“a scanning system” (‘664 Claim 1)	a system used to scan a network	a system used to search for information

### A. Plaintiff’s own evidence supports Defendants’ construction for “scanning a network” and negates Plaintiff’s construction.

As explained in Defendants’ Opening Brief, the Patents repeatedly link “scanning” to the operation of a spider. (DOB at 11-12.) The evidence from Plaintiff’s own brief also consistently supports Defendants’ construction, which captures the applicable ordinary meaning of “scanning” in the context of the Patents.

For example, Plaintiff acknowledges that “the specification describes an embodiment using a spider system that ‘scans a network’”. (POB at 13 (citing 25:39-40).) In fact, Plaintiff points to nothing in the specification where “scanning” does not involve a spider, which further shows that Defendants’ construction of “scanning” as “spidering” is appropriate. *See Wang Labs., Inc. v. America Online, Inc.*, 197 F.3d 1377, 1383 (Fed. Cir. 1999) (“The only embodiment described in the ‘669 patent specification is the character-based protocol, and the claims were correctly interpreted as limited thereto.”) Nor does Plaintiff point to anything in the specification that supports Plaintiff’s generic “looking for items” construction.

Plaintiff also cites several dictionary definitions of “scanning.” (POB at 12 fn 5.) Each definition shows that “scanning” requires a sequential, item-by-item crawl. (*See id.* (“Scan -- . . . 2: to examine by point-to-point observation or checking, to investigate thoroughly by checking point-to-point”; “Scan – (3) to sequentially search a file”; “Scan – Computer Technology. 1. to examine sequentially each item in a list, each record in a file, each point of a display, or each input or output channel of a communication link.”) (citations omitted).) All these definitions show that scanning is a more narrow and specific process than merely “looking for items.”

Not only is a sequential, item-by-item search narrower than merely “looking for items” – thereby showing the incorrectness of Plaintiff’s construction – but it is precisely how spiders operate. *See* Ira S. Nathanson, *Internet Infoglut and Invisible Ink*, 12 HARV. J. L & TECH. 43, 61 (1998) (“A spider (also known as a robot, crawler or indexer) is a program that scans the Web, crawling from link to link”); Eric W. Guttag, *Applying the Printed Publication Bar in the Internet Age*, 16 VA. J. L. & TECH. 66, \*12 (2011) (“In web crawling, web pages are retrieved by a ‘crawler’ (also known as a ‘spider’), which is an automated web browser that follows every link on the web site from which the web pages are being retrieved (crawled).”) (emphasis

added). Accordingly, Plaintiff's own cited evidence supports Defendants' construction of "scan[ning] a network" as "spider[ing] or crawl[ing] a network."

**B. Plaintiff misstates Defendants' indefiniteness position.**

Plaintiff alleges that "Defendants initially proposed that the term 'scanning a network' is indefinite." (POB at 13.) This is incorrect. Defendants never alleged that "scanning a network," standing alone, is indefinite. Rather, Defendants alleged that longer claim phrases that contain the words "scanning a network" are indefinite, in part because they are logically inconsistent with each other.<sup>2</sup>

For example, '420 claim 25 recites "scanning a network to make a demand search" while '664 claim 38 recites "scanning a network in response to a demand search." It is logically impossible to construe "scanning a network to make a demand search" and "scanning a network in response to a demand search" in a consistent manner, regardless of how "demand search" and "scanning a network" might be construed in isolation. "Scanning a network in response to a demand search" implies that a demand search is what causes a network to be scanned, while "scanning a network to make a demand search" implies that a demand search is made by scanning a network. It is logically impossible for Item A to be the cause of Item B and for Item A to also be made by Item B. The demand search is either the cause of the scanning or it is made by the scanning. It cannot be both.

Because "scanning a network to make a demand search" and "scanning a network in response to a demand search" cannot be construed in a logically consistent manner, both terms are indefinite. One of skill in the art could not read both terms and ascribe a sensible and consistent definition to each, which renders both terms indefinite as a matter of law. *See*

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<sup>2</sup> *See* Declaration of Jennifer J. Ghaussy ("Ghaussy Decl."), Ex. A (Defendants' Proposed Constructions for Claim Terms and Elements) at 2-3.)

*Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1251 (Fed. Cir. 2008) (“Even if a claim term’s definition can be reduced to words, the claim is still indefinite if a person of ordinary skill in the art cannot translate the definition into meaningfully precise claim scope.”)

Be that as it may, Defendants agreed that the indefiniteness of these longer phrases need not be decided during the *Markman* process. (See DOB at 10 fn. 5.) Plaintiff’s attempt to inject this indefiniteness issue back into the *Markman* process is perplexing, particularly since Plaintiff has complained that the list of issues to be decided during *Markman* is already too long and given that Defendants agreed to delay their indefiniteness arguments and instead construe the smaller phrase “scanning a network” at Plaintiff’s request. (See generally Plaintiff’s Motion to Compel Compliance with the Court’s Scheduling Order (Dkts. 99, 100); Defendants’ Opposition Brief (Dkt. 109).)

For the reasons stated above, the Court should construe “scan[ning] a network” as “spider[ing] or crawl[ing] a network.”

**C. “A scanning system” should be construed as “a system used to scan a network.”**

As explained in Defendants’ Opening Brief, the term “scanning system” appears in two independent claims: ‘664 claim 1 and ‘420 claim 25. Because it is undisputed that the “scanning system” of ‘420 claim 25 is used to “scan a network,” the same conclusion should hold for the “scanning system” of ‘664 claim 1 – particularly since there is no suggestion that the two “scanning systems” differ in any way. (DOB at 12.)

Plaintiff counters that construing “a scanning system” as “a system used to scan a network” would violate the doctrine of claim differentiation because “dependent claim 24 recites a further limitation on the scanning system, requiring it to ‘scan a network’”. (POB at 15.) Yet claim 24 actually recites “the search system of claim 1 wherein the scanning system further



comprises scanning a network upon a demand search request.” As explained in Defendants’ Opening Brief, the claimed invention can operate in “wire search” or “demand search” mode. (DOB at 19-20.) Thus, the “further limitation” added by dependant claim 24 is that the network scanning occur “upon a demand search request” (*i.e.*, in demand search mode), not that the network scanning occur at all. Rather, claim 24 presupposes that the scanning system scans a network and then adds the limitation that the network scanning occur in response to a demand search request.

Thus, Plaintiff’s claim differentiation argument is incorrect. Construing claim 1’s “scanning system” as “a system used to scan a network” would not render claim 24 superfluous, because claim 24 recites an additional limitation apart from “scanning a network.” *See SRAM Corp. v. AD-II Eng’g, Inc.*, 465 F.3d 1351, 1358 (Fed. Cir. 2006) (“AD-II’s claim differentiation argument lacks merit because claim 27 recites a series of down-shifts and would not be rendered superfluous by the district court’s claim construction.”); *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1326 (Fed. Cir. 2001) (rejecting claim differentiation argument where dependent claim “embraces additional limitations not encompassed within” the independent claim).

Just as Plaintiff has provided no valid reason to reject Defendants’ proposed construction of “a scanning system” as “a system used to scan a network,” Plaintiff has provided no valid reason to adopt its own proposed construction of “a scanning system” as “a system used to search for information.” As noted above and in Defendants’ Opening Brief, the intrinsic and extrinsic evidence shows that “scanning” is a narrower subset of searching, not a synonym for searching. Thus, “a scanning system” cannot simply be “a system used to search for

information,” since that would improperly equate “scanning” with “searching.” Plaintiff ignores this contradiction entirely.

### III. “COMBINING” (‘420 CLAIMS 10, 25; ‘664 CLAIMS 1, 26)

<i>Defendants’ Construction</i>	<i>Plaintiff’s Construction</i>
Plain meaning; alternatively, bringing together	uniting into a single number or expression

**A. Plaintiff’s construction of “combining” as “uniting into a single number of expression” defies the ordinary meaning of this term, the claim language, and the specification.**

Plaintiff argues that its construction of “combining” as “uniting into a single number or expression” accords with “the widely accepted meaning” of the term, the claim language, and the specification. (POB at 18-20.) However, Plaintiff’s construction actually defies all these evidentiary sources.

**1. Plaintiff’s construction defies the ordinary meaning of “combining.”**

Plaintiff asserts that “[i]n its ordinary usage, ‘combining’ two things means that the individual pieces are united or merged in a way to obscure individual characters or into a single number or expression.” (POB at 18.) This position is simply not credible. There are legions of contexts in which two things can be “combined” without “obscuring individual characters” or creating “a single number or expression.” For example, a high school curriculum might combine math and English, an Indiana Jones costume might combine a fedora with a bullwhip, and a tropical vacation might combine sunbathing with scuba diving. In none of these cases do the individual items lose their separate character or merge into a “single number or expression.” Thus, Plaintiff’s position that “combining” is limited to “uniting into a single number or expression” is contrary to the ordinary usage of this word.

**2. Plaintiff’s construction is inconsistent with the claim language.**

Plaintiff argues that “[i]n every instance that the claim term [“combining”] is used in the asserted independent claims, it is for the purpose of uniting the data into a single number or expression.” (POB at 18.) This is incorrect. For example, ‘664 claim 26[c] recites “combining the information found to be relevant to a query by other users with the searched information.” The “searched information” is the output of claim 26[a], which recites “searching for information relevant to a query.” Thus, in the context of this claim, both the “searched information” and the “information found to be relevant to a query by other users” are search results or other information entities that are relevant to a query. It makes no sense to “combine” these relevant information entities “into a single number or expression.” For instance, if these relevant information entities are web pages – as search engine results normally are<sup>3</sup> – how can a collection of web pages be combined “into a single number or expression?” Plaintiff’s “combining” construction makes no sense when applied to ‘664 claim 26, and it should therefore be rejected.

**3. Plaintiff’s construction would read preferred embodiments out of the claims.**

Plaintiff argues that the specification supports its construction of “combining,” but Plaintiff focuses exclusively on the specification embodiment shown in Figure 6. (*See* POB at 19-20.) As explained in Defendants’ Opening Brief, Plaintiff’s construction would read out other embodiments in which the claimed “combination” occurs through a sequential application of filters. (DOB at 15-17.) It is irrelevant that Plaintiff’s construction might support some

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<sup>3</sup> As the specification states, “[t]he present invention relates to information processing systems . . . wherein a search engine operates with collaborative and content-based filtering to provide better search responses to user queries.” (1:10-26 (emphasis added).) Thus, the information entities relevant to a query are preferably (if not exclusively) search results returned by a search engine.

embodiments from the specification (such as Figure 6) – because Plaintiff’s construction reads out other embodiments, it must be rejected. *See MBO Labs. v. Becton, Dickinson & Co.*, 474 F.3d 1323, 1333 (Fed. Cir. 2007) (“[A] claim interpretation that excludes a preferred embodiment from the scope of the claim is rarely, if ever, correct.”) (citation omitted).

**B. “Combining” should be given its plain meaning, as Defendants propose.**

As explained above, Plaintiff’s crabbed construction of “combining” as “uniting into a single number or expression” defies the plain meaning of the term and is inconsistent with at least some claims and preferred embodiments. Instead, “combining” should be given its plain meaning – *i.e.*, no narrowing construction is necessary – so that this term can properly support all the ways in which it is used in the claims and specification.

Plaintiff disputes Defendants’ alternative construction of “combining” as “bringing together,” arguing that “[i]tems can be ‘brought together’ without combining them”. (POB at 20-21.) As mentioned above, Defendants’ primary position is that “combining” needs no construction at all. Nonetheless, if Court desires to give a construction for “combining,” “bringing together” encompasses all the ways in which “combining” is used in the claims and specification. And while it may be true that items can be brought together without combining them, items cannot be combined without being somehow brought together. Plaintiff itself quotes a passage from the specification which shows that “combining” items entails bringing them together. (*See* POB at 20 (“Each weighted IRP 429a-d is brought together with other IRPs 429a-d in a combination function 427a-d.”) (quoting 14:56-58) (emphasis added).) The fact that this passage may contemplate a mathematical combination does not mean that “combining” should be limited to a mathematical definition (such as “uniting into a single number or expression”), given that the claims and specification also teach several non-mathematical combinations. *See* Section III(A)(2-3), *supra*.

As it did with “scanning a network,” Plaintiff also argues that “Defendants again initially took the position that ‘combining’ is indefinite and then abandoned that position.” (POB at 20.) Again, Plaintiff’s allegation is incorrect. Defendants never argued that “combining” is indefinite; rather, Defendants argued that larger phrases containing the word “combining” are indefinite. (*See* Ghaussy Decl., Ex. A at 8.) As with the larger phrases containing “scanning a network,” Defendants agreed to defer this indefiniteness issue until after the *Markman* process. And here too, it was Plaintiff who requested that Defendants construe “combining” rather than the longer phrases Defendants initially proposed. Plaintiff’s attempt to inject this indefiniteness issue back into the *Markman* process thus is again perplexing and uncalled for.<sup>4</sup>

**IV. THE SEPARATENESS OF THE CLAIMED SYSTEMS**

<i>Defendants’ Construction</i>	<i>Plaintiff’s Construction</i>
The claimed “system for scanning a network,” “content-based filter system,” and “feedback system” of ‘420 Claim 10 must be different systems	The claim language does not require the claimed system for scanning, content-based filter system, and feedback system of claim 10 of the ‘420 patent to be the same or different “systems”
The claimed “scanning system,” “feedback system,” and “content-based filter system” of ‘664 Claim 1 must be different systems	The claim language does not require the scanning system, content-based filter system, and feedback system of claim 1 of the ‘664 patent to be the same or different “systems”

As explained in Defendants’ Opening Brief, the disparately-claimed systems in ‘420 claim 10 and ‘664 claim 1 are different systems that perform different functions; they cannot be one and the same system. (DOB at 17-18.)

Plaintiff’s principal counterargument is to say that the number of processors involved in the invention may vary, depending on how these processors are combined or distributed. (POB

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<sup>4</sup> Finally, Plaintiff complains that it “still does not have the evidence Defendants intend to rely on for their definition” of “combining.” (POB at 20 fn. 11.) This complaint rings hollow, given Defendants’ position that “combining” needs no construction at all.

at 26-27 (quoting 10:3-23).) This is another non-sequitur. The specification’s “processors” – which appear nowhere in the claims – are simply the tangible hardware components that may be used with the claimed systems. (See 10:10-12 (stating that the “processors” may include the Intel Pentium-Pro microprocessor); Ghaussy Decl., Ex. B (WEBSTER’S NEW WORLD DICTIONARY OF COMPUTER TERMS (8<sup>th</sup> Ed. 2000)) at 344 (defining “microprocessor” as an integrated circuit fabricated on a piece of silicon and containing multiple functional units).) The fact that the processors used with the claimed systems may be arranged in various ways says nothing about whether the claimed systems themselves may be one and the same system. Rather, as explained in Defendants’ Opening Brief, the disparately-claimed systems in ‘420 claim 10 and ‘664 claim 1 are different systems performing different functions, regardless of how the microprocessors used in these systems might be arranged. Accordingly, these disparately-claimed systems cannot be one and the same system. See *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1300 (Fed. Cir. 2005) (holding that the claimed “originating processor” and “gateway switch” must be separate and distinct from each other because they perform different functions in the claimed process and information is transferred from one to the other).<sup>5</sup>

**V. “DEMAND SEARCH” (‘420 Claims 10, 25)**

<i>Defendants’ Construction</i>	<i>Plaintiff’s Construction</i>
search engine query	a one-time search performed upon a user request

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<sup>5</sup> Plaintiff’s citation to *Retractable Tech. Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296 (Fed. Cir. 2011) is misplaced. In *Retractable Tech.*, the Federal Circuit held that a claimed “retainer member” and “needle holder” need not be separate physical pieces because the claims stated that these pieces could overlap. See *id.* at 1303. By contrast, there is no suggestion in the Asserted Patents that the claimed systems perform overlapping functions. To the contrary, each system is given a discrete function separate and apart from the others.

As explained in Defendants' Opening Brief, the specification repeatedly states that "demand searches" are normal search engine queries performed by regular search engines, as distinguished from the continuous "wire" searches that require a stored query. (DOB at 19-20.)

Here too, Plaintiff's brief endorses Defendants' characterization of the intrinsic evidence. For example, Plaintiff's brief acknowledges that demand searches are performed by "regular search engine[s]" and further acknowledges that these demand searches are distinguished from the continuous "wire" searches. (POB at 21.) Nonetheless, Plaintiff disputes Defendants' construction of "demand search," stating that: "Defendants' definition is inaccurate because it disregards the intrinsic evidence's teachings that a demand search is a one-shot search upon a request from a user. Defendants' proposal omits any reference to 'one-shot' or to a user making the search demand, and instead proposes the vague concept of a 'search engine query.'" (*Id.* at 21-22.)

Plaintiff's allegation that Defendants are disregarding the intrinsic evidence is unfounded. As for the requirement that demand searches occur "upon a user request," that element is subsumed within Defendants' construction of "demand search" as "search engine query." A jury would understand that a "search engine query" is inherently "made upon user request" because normal search engines do not make searches unless users ask them to. Thus, there is no reason to add the redundant phrase "performed upon a user request." *See Walker Digital, LLC v. Capital One Servs., LLC*, No. 10-212, 2010 WL 2346642, \*3 (E.D. Va. June 8, 2010) ("the overarching goal of claim construction is to aid the jury's understanding of claim terms, not to be an 'exercise in redundancy.'")

The fact that the goal of claim construction "is to aid the jury's understanding of claim terms" also explains why Defendants omitted "one-shot" or "one-time" from their construction

of “demand search.” As explained in Defendants’ Opening Brief (DOB at 20-21), this language would be utterly confusing to a jury. For example, if a demand search was issued by two different users at two different times, do these searches cease being “demand searches” because they are no longer “one-shot” or “one-time?” In the interest of avoiding this ambiguity and jury confusion, Defendants sensibly omitted “one-shot” or “one-time” from their proposed construction.

Furthermore, while the specification does describe “demand searches” as “one-shot,” it does so to distinguish “demand searches” from the disclosed continuous “wire searches.” Because no “wire search” claims are at issue in this litigation, however, the “one-shot” language is superfluous and bears no relation to this case. Rather, this language would only serve to confuse a jury, and should therefore be rejected.

**VI. “INDIVIDUAL USER” / “FIRST USER”**

<i>Defendants’ Construction</i>	<i>Plaintiff’s Construction</i>
particular user	No further construction necessary beyond other terms

Plaintiff has not briefed the parties’ respective constructions of “individual user” or “first user,” and so there is nothing for Defendants to respond to on this issue.

**VII. RELEVANT/RELEVANCE TERMS**

<i>Term/Phrase</i>	<i>Defendants’ Construction</i>	<i>Plaintiff’s Construction</i>
“relevance to at least one of the query and the first user” (‘664 Claims 1, 26)	how well information satisfies the information need of at least one of the query and the first user	No further construction necessary beyond other terms
“[informons/information] relevant to a query” (‘420 Claims 10, 25; ‘664 Claims 1, 26)	[informons/information] that satisfy the individual user’s information need expressed in the query	[informons/information] having relevance to the [individual/first] user’s information need in the query



Plaintiff's argument against Defendants' construction of "[informons/information] relevant to a query" attacks a straw man. Plaintiff argues that "[a]ccording to Defendants, 'relevant' apparently means the item absolutely satisfies the user's information need; an item is either 100% relevant or 0% relevant." (POB at 17.) Yet Defendants' construction of "[informons/information] relevant to a query" – "[informons/information] that satisfy the individual user's information need expressed in the query" – does not take such an absolutist position. Just as there are various degrees of how "relevant" an item might be, there are various degrees of how well an item might "satisfy" the user's information need. By saying that "relevant" items "satisfy" the user's information need, Defendants do not seek to read an "absolutely" or "100%" requirement into this term. Notably, the words "absolutely" and "100%" do not appear anywhere in Defendants' construction – rather, they are rhetorical flourishes injected by Plaintiff to mischaracterize Defendants' position.

While Defendants' construction is perfectly sensible – "relevant" items are those that "satisfy the individual user's information need" – Plaintiff's construction is not. As explained in Defendants' Opening Brief, Plaintiff's position that "relevant" be construed as "having relevance" is grammatically unsound, given the parties' agreement that "relevance to a query" means "how well an informon satisfies the individual user's information need in the query."<sup>6</sup> (DOB at 24-25.) Applying this agreed "relevance" construction to Plaintiff's proposed construction, the phrase "having relevance" in Plaintiff's proposed construction would mean

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<sup>6</sup> Plaintiff repeatedly misstates what the parties agreed to as to this term. On page 11 of its brief, Plaintiff states that the parties agreed to a construction of "relevance" as "how well an informon satisfies the [individual/first] user's information need in the query." (POB at 11.) On page 16, Plaintiff states that "[t]he parties agreed that the claim term 'relevance' means how well an informon satisfies the [individual/first] user's information need." (*Id.* at 16.) In fact, as the parties' correspondence makes clear, their actual agreement was that "relevance to a query" means "how well an informon satisfies the individual user's information need in the query." (Ghaussy Decl., Ex. C.)

“having how well . . .” which is grammatically unsound. *See In re Hyatt*, 708 F.2d 712, 714 (Fed. Cir. 1983) (“[a] claim must be read in accordance with the precepts of English grammar.”); *Karl Storz Endoscopy-Am., Inc. v. Stryker Corp.*, No. 09-355, 2011 WL 1659867, \*12 (N.D. Cal. May 3, 2011) (rejecting proposed construction that “contradicts the grammar of th[e] sentence.”) Notably, Plaintiff provides no explanation as to how its construction could be read with the claim language.

Plaintiff has not briefed the parties’ respective constructions of “relevance to at least one of the query and the first user,” and so there is nothing for Defendants to respond to on this issue.

**VIII. ORDER OF STEPS (‘420 CLAIM 25; ‘664 CLAIM 26)**

<i>Defendants’ Construction</i>	<i>Plaintiff’s Construction</i>
‘420 Claim 25: Step [a] must be performed before Step [b]; Steps [b] and [c] must be performed before Step [d]	No construction necessary
‘664 Claim 26: Steps [a] and [b] must be performed before Step [c]; Step [c1] must be performed before Step [c2]	

Plaintiff does not actually dispute Defendants’ position regarding which method steps must be performed in order for ‘420 claim 25 and ‘664 claim 26. Instead, while implicitly acknowledging that at least some order is required in the claims, Plaintiff refuses to take a clear position on what the order is. Rather, Plaintiff states that “[t]o the extent that some limitations presuppose that one of the earlier limitations has been performed, that (limited) required ordering of limitations is clear from the claim language itself and no construction is necessary.” (POB at 25.)

Plaintiff’s refusal to take a position is unjustified. Determining the requisite order of steps is a proper matter for claim construction. (*See* DOB at 28 (citing Federal Circuit cases in which the order of steps was decided as a matter of claim construction.)) And Defendants have

clearly stated which steps they believe must be performed in order. There is no valid justification for Plaintiff’s refusal to address this issue.

Plaintiff tries to justify its refusal to provide an order of steps construction by stating that construing the order of steps “is an improper attempt to argue non-infringement during the Markman stage, rather than waiting for trial.” (POB at 25.) But in proposing their order of steps construction, Defendants make no attempt to argue whether or not the accused services perform steps in the order required by the claims. To be sure, the Court’s order of steps construction might impact Defendants’ non-infringement arguments, but the same is true of any construction that the Court provides for any term. Plaintiff’s attempt to conflate an order of steps construction with a non-infringement argument has no basis in law or fact.

#### IX. ANTECEDENT BASIS TERMS

<i>Term/Phrase</i>	<i>Defendants’ Construction</i>	<i>Plaintiff’s Construction</i>
“informons” / “the informons” (‘420 Claims 10, 25)	“informons” and “the informons” are the same informons	“informons” provides antecedent basis for “the informons”
“users” / “such users” (‘420 Claims 10, 25)	“users” and “such users” are the same users	“users” provides antecedent basis for “such users”
“a query” / “the query” (‘420 Claims 10, 25; ‘664 Claims 1, 26)	“a query” and “the query” are the same query	“a query” provides antecedent basis for “the query”
“a feedback system” / “the feedback system” (‘420 Claim 10; ‘664 Claim 1)	“a feedback system” and “the feedback system” are the same feedback system	“a feedback system” provides antecedent basis for “the feedback system”
“a scanning system” / “the scanning system” (‘664 Claim 1)	“a scanning system” and “the scanning system” are the same scanning system”	“a scanning system” provides antecedent basis for “the scanning system”
“a first user” / “the first user” (‘664 Claims 1, 26)	“a first user” and “the first user” are the same first user	“a first user” provides antecedent basis for “the first user”
“a content-based filter	“a content-based filter system’	“a content-based filter

system” / “the content-based filter system” (“664 Claims 1, 21)	and “the content-based filter system” are the same content-based filter system	system” provides antecedent basis for “the content-based filter system”
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As explained in Defendants’ Opening Brief, Plaintiff concedes that the first term in each dyad shown above “provides antecedent basis for” the second term, but Plaintiff refuses to acknowledge the consequence of the antecedent basis canon – namely, that the second term in each dyad must be the same as the first. (DOB at 29-30.)

Tellingly, Plaintiff does not actually dispute that the second term in each dyad is the same as the first – instead, Plaintiff just argues that there is no need for a construction stating this point. (*See* POB at 28-29.) Yet there is every reason to provide a construction stating that the second term in each dyad is the same as the first, because this informs the jury about the meaning of the claims. A lay jury would have no comprehension of the phrase “antecedent basis,” and so merely instructing the jury that the first term in each dyad “provides antecedent basis for” the second – as Plaintiff proposes – would only create jury confusion. (*See* DOB at 30.) By contrast, instructing the jury that the second term in each dyad is the same as the first would provide meaningful guidance about the scope and meaning of the claims.

Plaintiff seems to fault Defendants for arguing that antecedent basis law has consequences for the scope of the claims and the parties’ infringement or non-infringement positions. (POB at 28 (“Defendants . . . insisted that their ‘the same as’ language would impose ‘certain consequences’ that they hope to argue for non-infringement purposes.”).) Again, however, any claim construction can have consequences – otherwise, there would be no reason to conduct claim construction in the first place.

Plaintiff cites *Personalized User Model (PUM) LLP v. Google Inc.*, 2012 WL 295048 (D. Del. Jan. 25, 2012) to support its antecedent basis position, but *PUM* supports Google’s position

more than Plaintiff's. In *PUM*, as in this case, there were numerous term dyads in which a term was first introduced with an indefinite article and later referred to with a definite article. Google sought a construction that "the latter term must be referring to the former term," and the Court agreed with Google for almost every dyad at issue:

"Google argues that, '[a]s a matter of common sense, where these terms are first introduced with 'a,' and then later used with 'the,' the latter term must be referring to the former term.' *PUM* responds that none of the disputed claim terms require construction . . . For the most part, the Court agrees with Google. For all except two of the antecedent basis terms . . . the Court finds that the terms using definite articles refer to the former terms in the same limitation."

*See id.* at \*25 (emphasis added).

For all these reasons, Defendants' construction that the second term in each dyad is the same as the first is far preferable to Plaintiff's construction that the first term in each dyad "provides antecedent basis for" the second. Thus, Defendants' construction should be adopted.

#### **X. PLAINTIFF'S ATTEMPT TO PRECLUDE DEFENDANTS' CONSTRUCTIONS IS MERITLESS AND HYPOCRITICAL**

At various points, Plaintiff argues that Defendants' constructions should be precluded because Defendants modified these constructions from the original proposed constructions that Defendants served on March 21, 2012. (*See* POB at 13 fn. 7, 15 fn. 8, 20.) This argument is not only meritless, but ignores Plaintiff's own evolving positions since the initial exchange in March.

The parties' mutual exchange of proposed constructions on March 21 was the beginning of their negotiation over a final list of terms for construction, and both parties have modified their lists of disputed terms and proposed constructions numerous times throughout this process. For instance, Plaintiff's March 21 submission did not even contain constructions for "a scanning system" or "[informons/information] relevant to a query," and Plaintiff's antecedent basis construction was different from its current position. (*See* Ghaussy Decl., Ex. D.) Defendants did not seek to preclude Plaintiff's proposed constructions just because its list of disputed terms and

proposed constructions has evolved since the March 21 exchange. Likewise, Plaintiff has no basis to preclude Defendants' constructions.

In fact, Plaintiff's attempt to preclude any proposed construction that varies from the initial March 21 exchange would mean that the parties' post-March 21 negotiations over a final list of terms and constructions were meaningless. If the parties' proposed constructions must be fixed and frozen as of March 21, then there would be no point to these negotiations. Yet the parties did negotiate at length about their proposed constructions, and both parties modified their lists of terms and constructions in an attempt to reach common ground and narrow the disputed issues. (*See* Dkt. 109 at 6-7 (recounting the parties' post-March 21 negotiations).) Plaintiff's attempt to render these negotiations meaningless should be rejected. Rather, the Court should evaluate both parties' proposed constructions on the merits and should reject Plaintiff's attempt to preclude Defendants' constructions.

### **Conclusion**

For the foregoing reasons, Defendants' constructions should be adopted.

Dated: May 3, 2012

By: /s/ Stephen E. Noona  
Stephen E. Noona  
KAUFMAN & CANOLES, P.C.  
150 West Main Street  
Post Office Box 3037  
Norfolk, VA 23514  
Telephone: (757) 624.3000  
Facsimile: (757) 624.3169

David A. Perlson  
QUINN EMANUEL URQUHART &  
SULLIVAN LLP  
50 California Street, 22nd Floor  
San Francisco, CA 94111  
Telephone: (415) 875-6600  
Facsimile: (415) 875-6700

*Counsel for Defendants* GOOGLE INC., IAC  
SEARCH & MEDIA, INC., TARGET CORP., and  
GANNETT COMPANY, INC.

By: /s/ Stephen E. Noona

Stephen E. Noona  
KAUFMAN & CANOLES, P.C.  
150 West Main Street  
Post Office Box 3037  
Norfolk, VA 23514  
Telephone: (757) 624.3000  
Facsimile: (757) 624.3169

Robert L. Burns  
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP  
Two Freedom Square  
11955 Freedom Drive  
Reston, VA 20190  
Telephone: (571) 203-2700  
Facsimile: (202) 408-4400

Cortney S. Alexander  
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP  
3500 SunTrust Plaza  
303 Peachtree Street, NE  
Atlanta, GA 94111  
Telephone: (404) 653-6400  
Facsimile: (415) 653-6444

*Counsel for Defendant* AOL, INC.

**CERTIFICATE OF SERVICE**

I hereby certify that on May 3, 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:

Jeffrey K. Sherwood  
Kenneth W. Brothers  
DICKSTEIN SHAPIRO LLP  
1825 Eye Street NW  
Washington, DC 20006  
Telephone: (202) 420-2200  
Facsimile: (202) 420-2201  
sherwoodj@dicksteinshapiro.com  
brothersk@dicksteinshapiro.com

*Counsel for Plaintiff, I/P Engine, Inc.*

Stephen E. Noona  
Virginia State Bar No. 25367  
KAUFMAN & CANOLES, P.C.  
150 W. Main Street, Suite 2100  
Norfolk, VA 23510-1665  
Telephone: (757) 624-3239  
Facsimile: (757) 624-3169  
senoona@kaufcan.com

*Counsel for AOL Inc., Google, Inc.,  
Gannett Co., Inc., Target Corporation and  
IAC Search & Media, Inc.*

/s/ Stephen E. Noona  
Stephen E. Noona  
Virginia State Bar No. 25367  
KAUFMAN & CANOLES, P.C.  
150 West Main Street, Suite 2100  
Norfolk, VA 23510  
Telephone: (757) 624-3000  
Facsimile: (757) 624-3169  
[senoona@kaufcan.com](mailto:senoona@kaufcan.com)

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