

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

Filed Under Seal

**REPLY BRIEF IN SUPPORT OF DEFENDANTS GOOGLE INC.'S AND IAC SEARCH
& MEDIA, INC.'S MOTION TO COMPEL PLAINTIFF TO SUPPLEMENT ITS
INFRINGEMENT CONTENTIONS**

I. INTRODUCTION

Plaintiff's Opposition to Google's and IAC's Motion to Compel Plaintiff to Supplement its Infringement Contentions ("Opposition") ignores the fundamental issue raised in Defendants' Opening Brief – Plaintiff's duty to fully disclose its theories of infringement.

First, Plaintiff fails to show why it has not supplemented its preliminary contentions regarding Google Search and IAC's ASL products, based solely on publicly available documents, even though Plaintiff has been in the possession of technical documents as to these products for months. Plaintiff cannot credibly contend that Plaintiff's contentions that have no mention of the internal systems revealed in these documents put Google and IAC on notice of what aspects, if any, of Defendants' systems Plaintiff contends meet the elements of the asserted claims. This substantially prejudices Defendants in their ability to prepare their non-infringement and invalidity defenses, as well as in claim construction.

As to the AdWords and AdSense for Search products, Plaintiff fails to rebut that its contentions do not disclose how all of the limitations of all of the asserted claims are met in the accused products. Indeed, the block quotations that Plaintiff points to themselves demonstrate this. Here too, Plaintiff's refusal to provide this information substantially prejudices Google's ability to prepare its invalidity and non-infringement defenses and claim construction arguments.

Plaintiff's excuses and finger pointing in its Opposition do not hold water. For example, Plaintiff states that it "has committed to supplement on a timely basis," but has never, even in its brief, identified when it will do so or whether this supplementation would address all of the deficiencies raised by Defendants. Plaintiff also argues that it has no duty to supplement its infringement contentions under the parties' stipulation, but sidesteps the issue that it incorporated its contentions into an interrogatory response. And while Plaintiff now makes references to the need for further documents and depositions, Plaintiff never previously raised either as a reason why Plaintiff could not supplement its contentions to address the issues raised by Defendants. In any event, Plaintiff has technical documents produced by Defendants, as well as Google's supplemental non-infringement contentions, and yet still refuses to supplement its contentions.

Plaintiff's refusal to supplement its contentions is improper. Defendants' motion should be granted.

II. ARGUMENT

A. Plaintiff Should Supplement Its Contentions As To Google Search and ASL or Drop Its Allegations As To These Products.

Plaintiff bears the burden of proving infringement by showing that each accused product includes each and every element of the asserted claims. As such, Plaintiff must provide Defendants with clear notice of its infringement theories so that Defendants can adequately prepare their defense. *See Balsam Coffee Solutions Inc. v. Folgers Coffee Co.*, Civil Action No.

6:09cv89, 2009 WL 4906860 (E.D. Tex. Dec. 9, 2009) (granting motion to compel supplemental interrogatory response regarding infringement contentions). Without these contentions, Defendants cannot prepare their non-infringement and invalidity defenses with complete information. Additionally, Defendants are prejudiced in their ability to prepare claim construction arguments. Plaintiff does not dispute this.

As detailed in Defendants' Opening Brief, because Plaintiff refuses to supplement its infringement contentions based on the thousands of pages of technical documents that Defendants have already produced that provide the detail of Defendants' internal systems, Defendants do not know how Plaintiff contends that Search and ASL meet each limitation of the patents-at-issue, or what aspects of Defendants' systems are even at issue in the case. There can be no excuse for Plaintiff's failure to provide fulsome contentions given the extensive production of technical documents.

Nevertheless, Plaintiff argues that "[t]he mere fact that I/P Engine's contentions with respect to these systems rely on publicly available documentation does not in itself indicate any deficiency." (Opp., 16.) But that is only part of the issue. That Plaintiff cannot find anything, literally nothing – not even for a single fact, element, or limitation – supporting its contentions in the thousands of pages of technical documents produced shows that Plaintiff's infringement allegations regarding Search and ASL are baseless and should be dropped entirely.

Plaintiff also argues that Defendants' arguments regarding the deficiencies in Plaintiff's contentions do not make sense or solely relate to claim construction, because Plaintiff cannot understand the relationship between "collaborative feedback" and "collaborative filtering," and Plaintiff has no requirement to supplement its contentions to address "a non-existent claim limitation." (Opp., 14-16.) Yet, in Plaintiff's Opening Claim Construction Brief, Plaintiff

acknowledges the relationship between them: “Collaborative 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.” (Dkt. 129, 3 (emphasis added).) Plaintiff thus understands exactly what Defendants are seeking and what its contentions regarding ASL and Search lack – disclosure of where the collaborative elements are met in the accused products. Plaintiff seeks to dodge this issue because, as the technical documents have likely shown to Plaintiff, “collaborative” feedback data and “collaborative” filtering do not exist in ASL and Search. But again, that just shows that Plaintiff should drop these allegations entirely. It provides no excuse for Plaintiff to refuse to supplement contentions.

B. Plaintiff Fails to Show Its Contentions Regarding AdWords and AdSense for Search Are Sufficient.

The issues raised by Google regarding Plaintiff’s contentions for AdWords and AdSense for Search are not “based upon its disagreement with the facts, or based upon its own claim constructions,” as Plaintiff suggests. (Opp., 10.) Rather, Plaintiff’s contentions are wholly deficient in identifying the aspects of the accused products that meet the limitations of the asserted claims. (Opening Br., 9-11.) Plaintiff fails to rebut any of these deficiencies.

1. Plaintiff’s contentions do not identify what “collaborative feedback data” is received by Google AdWords or AdSense for Search.

As argued in Defendants’ Opening Brief, Plaintiff fails to explain what is the collaborative feedback data in the AdWords and AdSense for Search systems. While Plaintiff cites two paragraphs from its contentions regarding AdWords and AdSense for Search to argue that its contentions disclose “receiving collaborative feedback data from system users relative to informons considered by such users,” (Opp., 10-11) as Plaintiff admits, I/P Engine’s contentions omit the requirement of “collaborative feedback data,” [REDACTED] (Opp., 11 (emphasis added).)

Because Plaintiff purposefully omits the term “collaborative” from its contentions, Google does not know what Plaintiff contends regarding “collaborative feedback data.”

While Plaintiff argues that its contentions must have been clear because Google was able to prepare non-infringement contentions (Opp., 11-12), Google pointed to the same problem in its interrogatory response as in Defendants’ Opening Brief. “Plaintiff points to nothing in its infringement contentions that it asserts meets the ‘collaborative feedback data’ limitation of claim 10(d).” (O’Brien Reply Decl., Ex. AA, 33.) That Google went on to state that [REDACTED]

[REDACTED] (*id.*), is not an “admission” that I/P Engine has identified what meets the “collaborative feedback data.” Indeed, it reveals the problem with Plaintiff’s infringement contentions – Defendants are forced to guess as to what Plaintiff believes infringes.

2. Plaintiff’s contentions do not identify how AdWords and AdSense for Search meet the “filtering each informon for relevance to the query” limitation.

Plaintiff argues that it has disclosed how this limitation is met in AdWords and AdSense for Search because it has disclosed where there is “filtering” in AdWords and AdSense for Search. (Opp., 12.) But the patents do not just claim “filtering”; they claim filtering information for relevance to the query. That Plaintiff’s contentions mention that AdWords and AdSense for Search “filter” information generally does not show what Plaintiff contends meets what is actually required by the claim limitation. Plaintiff does not contend otherwise.

3. Plaintiff’s contentions do not identify what in AdWords or AdSense for Search involves “scanning a network,” a “scanning system,” or a “feedback system.”

Plaintiff argues that its contentions “disclose in detail how the accused features meet the ‘scanning a network’ limitation.” (Opp., 13.) It’s difficult to comprehend this argument given

that Plaintiff's contentions do not identify any "scanning a network" done in AdWords and AdSense for Search. (O'Brien Decl., Ex. M.) Plaintiff must identify how the specific elements of the claims are met in the accused products. *See Shared Memory Graphics LLC v. Apple, Inc.*, 812 F. Supp. 2d 1022, 1025-6 (N.D. Cal. 2010).

Plaintiff similarly argues that its infringement contentions "include a thorough description of the 'scanning system' of Google AdWords" and the "feedback system" in AdWords. (Opp., 13-14.) But even in its motion, Plaintiff fails to articulate what specifically it contends are the "feedback system" and the "scanning system" as those systems are claimed in the patents-at-issue, or point to any language from its contentions that properly identifies what Plaintiff contends meets these systems in the accused products.

C. Plaintiff's Excuses and Finger Pointing Do Not Justify its Refusal to Supplement its Infringement Contentions.

1. Plaintiff's offer to "supplement its infringement contentions as appropriate" is insufficient.

While Plaintiff argues that "IP Engine repeatedly has advised Defendants that it will reasonably supplement its infringement contentions as discovery progresses," (Opp., 6.) Defendants repeatedly asked Plaintiff to supplement its infringement contentions to address the issues raised by Defendants but Plaintiff repeatedly refused, choosing instead to stand on its contentions as served. (Opening Br., 3-6.) While after Defendants informed Plaintiff that it intended to move on this issue Plaintiff suggested it may supplement its contentions, Plaintiff refused to provide a date certain for this supplementation or assurance that it would address Defendants' concerns.¹ (*Id.*, 5-6.) Of course, Plaintiff has never supplemented its contentions.

¹ Plaintiff states in its brief that, prior to filing their motion on March 27, Defendants failed to respond to a March 16 voicemail that Plaintiff left Mr. Noona, while he was in court for another matter, informing Defendants that Plaintiff intended to supplement its contentions as discovery progressed. (Opp., 6.) Prior to March 16, however, Defendants informed Plaintiff that

2. Plaintiff's newly proffered need for documents and depositions to supplement its contentions is without merit.

Plaintiff argues that it is incapable of supplementing its infringement contentions regarding any of Google's accused products without production of additional documents, as it has not yet received Google's custodial documents and "has received very few technical documents apart from Google's repository document production." (Opp., 7 (emphasis added).) Initially, Plaintiff never previously claimed that it could not supplement its contentions due to any failure of Google to produce custodial documents. In any event, Plaintiff's argument ignores the numerous technical documents previously produced to it related to the accused products. It is the 200,000 pages of documents from Google's technical repositories that contain the technical documents describing the functioning of the accused products, which are far more likely to be relied upon by Plaintiff and its expert for their infringement analyses.²

Plaintiff also argues it "seeks additional documents that further describe the use of click through rate ('CTR') in [Google's] search ranking algorithm," pointing to a single document that it asserts does not provide relevant details regarding the use of click-through-rate in Search.³ (Opp., 7.) But Plaintiff has never asked Google for more documentation to provide more detail

they would move on this issue if Plaintiff did not agree to supplement by a date certain. (O'Brien Decl., Exs. T, V.) Additionally, to the extent there was still hope for a resolution to this issue, Plaintiff could have raised this issue in any of the further meet and confers and correspondence with Defendants before Defendants' filed their motion. (O'Brien Reply Decl., ¶ 8.) Plaintiff did not do so.

² Plaintiff incorrectly states that "[a]s of the date of this brief, Google promised to produce its custodial documents by June 15". (Opp., 7.) Google offered to produce documents from the first custodian by April 27, the next two priority custodians by May 11, and a final complete custodial production by May 30. (O'Brien Reply Decl., Ex. BB.)

³ Plaintiff's speculation that a Google document is "vague and incomplete" "perhaps due to infringement concerns" is not well-taken. (Opp., 7.) Plaintiff's hypothesis seems solely designed to paint Google in a negative light, rather than to actually illustrate a concern regarding discovery in this case.

regarding this specific document. Plaintiff should supplement its contentions based on the voluminous technical information and documents it has.

Plaintiff also argues that it has faced “difficulties in understanding the relevant features of IAC’s systems from the presently-produced documents,” but Plaintiff admits that it has not completed its review of the documents produced by IAC Search, even though those documents were produced by January. (Opp., 8.) Plaintiff cannot use its own failure to review documents as justification for its failure to supplement its infringement contentions.

Plaintiff further states that it “intends to supplement its infringement contentions” after taking 30(b)(6) depositions of Defendants. (Opp., 8.) Notably, however, Plaintiff’s “liability” Rule 30(b)(6) deposition notices include no topics specifically related to Google Search or ASL. (O’Brien Decl., Exs. X-Y.) Plaintiff cannot be heard to complain about the need to take depositions it has not even asked for. Nor is it appropriate for Plaintiff to unilaterally withhold supplemental contentions of the information it has to date simply because depositions may provide a basis to further supplement down the road. *See Balsam*, 2009 WL 4906860 at *3-4.

3. Plaintiff’s proposed stipulations are irrelevant to this motion.

Plaintiff seeks to shift blame for its own infirm disclosures by seeking to criticize Google for not entering a stipulation “that the case be streamlined by focusing on the Google AdWords system.” (Opp. 8, n.6.) But Plaintiff’s proposed stipulation asks Google to undertake liability and damages for all other defendants and was properly rejected. If anything, Plaintiff’s offer to dismiss ASL further illustrates that Plaintiff is aware it has no good faith basis for continuing to assert infringement of ASL.

Plaintiff also refers to statements made by Google in response to another stipulation proposed by Plaintiff – this one offering to drop its Google Search allegations if Google could represent that Google Search does not use click-through rates to rank/return search results.

(Opp., 7-8; O'Brien Reply Decl., Ex. Z, 3.) Of course, Google has no obligation to enter into any such stipulation, especially where it is unclear and seems to rest on the false premise that Plaintiff's patents cover any use of a click through rate. In any event, here too, Plaintiff's offered stipulation does not excuse Plaintiff from supplementing its contentions regarding Search, but rather suggests that Plaintiff recognizes that it has no basis to accuse Search.

4. Whether by interrogatory response, or Plaintiff's stipulated agreement, Defendants are entitled to Plaintiff's infringement contentions.

Google's Interrogatory No. 7 seeks for each Google product that Plaintiff claims infringes each asserted claim of the patents-at-issue a "detailed explanation, with all evidence and reasons, how each product meets each element of every claim...." (O'Brien Decl., Ex. J, 11-12.) As Plaintiff itself acknowledges, Plaintiff incorporated by reference its infringement contentions regarding the accused Google products into its response to this interrogatory. (Opp., 9 n.7.) Yet, Plaintiff appears to believe that incorporating its infringement contentions regarding Google's products by reference in its response to Google's interrogatory does not make these contentions part of the interrogatory response, stating, "even if I/P Engine's reference to its infringement contentions in an interrogatory response somehow transformed the contentions into a formal interrogatory response...." (Opp., 9 n.7 (emphasis added).) If that belief were correct, then Plaintiff has entirely failed to respond to Google's Interrogatory No. 7 as it has provided no response to this interrogatory other than its reference to its contentions. (O'Brien Decl., Ex. J, 12-13.) Either Plaintiff has failed in its obligation to respond to Google's Interrogatory No. 7, or Plaintiff has failed to supplement its response to Interrogatory No. 7. In either event, Plaintiff has failed to adequately respond and should be compelled to do so.

Plaintiff also argues that it is not required to supplement because its contentions were served pursuant to a stipulation between the parties, rather than under the Local Rules of the

Eastern District of Virginia. (Opp., 8-9.) Plaintiff's argument that such signed written disclosures, because they were made by stipulation, are somehow not disclosures under Federal Rule of Civil Procedure 26 is nonsensical and inconsistent with its own reading of Rule 26(b). (See Dkt. 118, 6.) If the parties could not be bound under Federal Rules of Civil Procedure 26 and 37 by these disclosures, then what was the point in making them?⁴

5. Plaintiff's claims regarding non-infringement contentions are irrelevant and inaccurate.

Plaintiff oddly also seeks to excuse its failure to provide adequate infringement contentions by arguing that Defendants have failed to supplement their non-infringement contentions. (Opp., 3-4.) As a matter of common sense, however, non-infringement contentions logically come after infringement contentions. In any event, despite Plaintiff's failure to provide full infringement contentions, Google provided a detailed narrative regarding its non-infringement contentions on March 30, and Plaintiff does not argue that this supplemental response was insufficient.⁵

⁴ Plaintiff argues that Defendants failed to honor the parties' discovery agreement by failing to serve any supplemental invalidity contentions on March 2. (Opp., 9.) However, as Defendants explained at the time, the only reasons to supplement the invalidity contentions would be if: (1) Plaintiff's supplemental infringement contentions identified new theories regarding the patents-at-issue, which brought additional prior art into play; or (2) if Defendants found new prior art. Defendants found no such new art. And Plaintiff's refusal to properly supplement its infringement contentions meant that Defendants were unable to identify any new theories requiring additional art to be asserted. Unlike for Plaintiff who has received over 200,000 pages of technical documents, Defendants had no additional information to disclose as of that date, and so no supplementation was necessary.

⁵ While Plaintiff asserts that "[o]nly upon the threat of an imminent motion to compel did Defendants begin to explain their non-infringement positions on March 30" (Opp., 4 n.3), this is demonstrably false. On March 13 and March 15, Google agreed to provide a second supplemental response to Plaintiff's Interrogatory No. 6 and confirmed that this supplementation would be served by March 30. (O'Brien Decl., Ex. T; Ex. V, 2.) This confirmation was not in response to a threatened motion; it was not until after Google offered to supplement its response to Interrogatory No. 6 that Plaintiff began threatening to move to compel Google's non-infringement contentions. (O'Brien Reply Decl., ¶ 7.)

III. CONCLUSION

For the foregoing reasons, Defendants Google and IAC Search respectfully request that the Court compel Plaintiff to supplement its infringement contentions.

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CERTIFICATE OF SERVICE

I hereby certify that on April 19, 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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