

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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I/P ENGINE’S OPPOSITION TO DEFENDANTS’ EMERGENCY MOTION FOR SANCTIONS AND TO STRIKE PLAINTIFF’S SUPPLEMENTAL EXPERT REPORT

Defendants want to have it both ways. On the one hand, they produced source code, supplemental discovery responses, and other documents regarding infringement on September 14, after the close of all discovery, and after I/P Engine’s infringement expert had served his report and been deposed. On the other hand, they want to prohibit Plaintiff’s infringement expert from commenting on this newly produced evidence. That Defendants can get away with violating the Scheduling Order with their untimely production of evidence is improper. That Defendants now want to preclude Plaintiff’s expert from considering Defendants’ new infringement evidence is outrageous. Not only should this Court reject Defendants’ motion, but this Court should strike Defendants’ untimely evidence.

Defendants’ newly produced source code and related evidence pertains solely to infringement. Defendants acknowledged that it was produced to rebut the infringement opinions of Dr. Frieder. When this evidence was produced after the discovery cutoff, I/P Engine immediately sought a meet and confer. Counsel for Defendants conceded that the newly

produced information was produced after the cutoff for all discovery, but insisted that it nonetheless was timely. At the subsequent deposition of Defendants' technical expert, counsel for Defendants deposed its own expert witness to elicit new opinions based upon that newly produced evidence.¹ I/P Engine promptly moved to strike the untimely evidence. D.I. 282. Magistrate Judge Leonard denied I/P Engine's motion on October 9. D.I. 697. On October 10, I/P Engine requested that this Court review Judge Leonard's ruling on I/P Engine's motion to strike. D.I. 700. Last night, Defendants agreed to respond to I/P Engine's motion for review by 2 p.m. on October 15, and the parties will seek argument on that motion, and this motion, at 9 am on October 16.

Meanwhile, three days after Magistrate Judge Leonard denied I/P Engine's motion to strike the newly produced source code and related evidence, I/P Engine's expert, Dr. Frieder, submitted a supplemental report. Defendants acknowledge that Magistrate Judge Leonard granted Dr. Frieder leave to amend his report. In the context of granting in part Plaintiff's Second Motion for Sanctions, on October 9, Magistrate Judge Leonard authorized Plaintiff to serve a supplemental report from Dr. Frieder regarding non-infringing alternatives. D.I. 702 at page 44, lines 1-7. With regard to Plaintiff's Third Motion for Sanctions, after entertaining argument, Magistrate Judge Leonard denied the motion, then promptly adjourned for a brief break before convening a settlement conference. *Id.* at page 82, line 5-page 83, line 2. Because of the abrupt adjournment, I/P Engine did not have an opportunity to raise with the Court the issue of supplementation by Dr. Frieder to address the newly produced evidence.

¹ Defendants did not supplement their expert's report to reference the newly produced evidence. Pursuant to this Court's October 9 ruling, Defendants' expert is precluded from testifying regarding that source code, because it was not in his report.

Permitting I/P Engine's expert an opportunity to comment on Defendants' newly produced evidence is only fair. Until Defendants' counsel deposed his expert witness on September 23, Plaintiff did not know what use, if any, Defendants intended to make of the newly produced source code. On September 21, I/P Engine moved to strike that evidence. At the same time, I/P Engine requested that its infringement expert, Dr. Frieder, the chair of Georgetown University's Computer Science Department, review the newly produced evidence.

Dr. Frieder's supplemental report, served less than three weeks after Defendants' expert opined on the newly produced evidence, explains in two brief paragraphs how the newly produced information is consistent with his prior opinions. Contrary to Defendants' unsupported assertion, Dr. Frieder does not disclose a "new" infringement theory in his second supplemental report. Instead, Dr. Frieder concludes in paragraph 6 that the new source code is "similar to attribute templates identified in the prior source code productions." Paragraph 7 expressly states that Dr. Frieder is not asserting any new opinions:

The models produced on September 17, 2012 therefore further confirm that historical versions of SmartASS infringe the asserted patents for the same reasons as set forth in my July 25 report. Specifically, it confirms my conclusion, supported by the documents and testimony cited in my original report, that the accused AdWords systems have infringed the asserted claims of the '420 and '664 patents since the launch of SmartASS in 2004.

Accordingly, Defendants' alleged prejudice is without merit.

Defendants assert that they are unable to further respond to Dr. Frieder's analysis because trial starts on October 16. Defendants have turned discovery upside down. As set forth in greater detail in I/P Engine's Third Motion for Sanctions, I/P Engine repeatedly requested source code, beginning in November 2011, and on multiple additional occasions throughout discovery. Defendants maintain, however, that they are not obligated to produce factual information such as source code until after expert discovery, claiming (at 4) that, "[h]ad Dr. Frieder disclosed his new infringement theory promptly, Defendants might have had time to research the referenced

template and models or depose Dr. Frieder on his new theory.” But Defendants did not produce “the referenced template and models” until after Dr. Frieder served his report and sat for his deposition! Defendants have only themselves to blame for not timely producing the source code during discovery.

Defendants do not dispute that I/P Engine had the right to respond to Defendants’ newly produced evidence. Their only quibble is with the timing of the supplementation. They imply that, had Dr. Frieder supplemented by September 19, they would have not objected. But they do not disclose that it was not until Defendants deposed their own expert on September 23 that they revealed what use they intended to make of the newly produced code. Less than three weeks later, Dr. Frieder completed his analysis of the newly produced code and reaffirmed that it was consistent with his opinions that Defendants infringe I/P Engine’s patents.²

Dated: October 15, 2012

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² To the extent this Court deems it necessary and appropriate, I/P Engine requests leave for Dr. Frieder to supplement his report to reflect his analysis of the newly produced source code.

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Counsel for Plaintiff I/P Engine, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on this 15th day of October, 2012, the foregoing, **I/P ENGINE'S OPPOSITION TO DEFENDANTS' EMERGENCY MOTION FOR SANCTIONS AND TO STRIKE PLAINTIFF'S SUPPLEMENTAL EXPERT REPORT**, was served via the Court's CM/ECF system on the following:

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