

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
NORFOLK DIVISION

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

OPPOSITION TO GOOGLE’S MOTION TO COMPEL PLAINTIFF TO PROVIDE A NARRATIVE DESCRIPTION INSTEAD OF RULE 33(d) RESPONSE REGARDING PRIORITY DATE, CONCEPTION, AND REDUCTION-TO-PRACTICE

Google’s Motion to Compel is unnecessary and moot. Google filed its motion the morning of February 13, 2012; however, on February 10, 2012, Google proposed, and I/P Engine agreed, “that on Monday, February 13, I/P Engine and Google [will] exchange supplemental interrogatory responses citing to specific Bates ranges under Rule 33(d).” Ex. 1. Consistent with that agreement, the same day that Google filed its motion, I/P Engine served supplemental responses to Google’s Interrogatory Nos. 1 and 9. Ex. 2. I/P Engine’s supplemental responses identified a priority date for the patents-in-suit, and also identified pursuant to Rule 33(d) specific documents that reflect plaintiff’s present knowledge regarding conception and reduction to practice. I/P Engine’s supplemental responses are appropriate and complete under the rules and case law. Google’s motion is not directed to these supplemental responses, and thus the motion is moot.

Following service of Google’s motion, and of I/P Engine’s supplemental responses, the parties have discussed their differences. I/P Engine has offered to state that the date range for conception and reduction to practice is as reflected in the cited documents (Ex. 3), but Google has not responded to this offer. Ex. 4, ¶ 9. Instead, Google has insisted on a narrative interrogatory response instead of reliance upon Rule 33(d), as Google believes is required under the Northern District of California’s local patent rules. Not only are those rules inapplicable in this Court, but Google’s dispute is entirely theoretical, because Google has not asserted any prior art in its invalidity contentions that falls within the date range of I/P Engine’s cited documents.

I. ARGUMENT

A. I/P Engine has Provided a Complete and Adequate Response to Google’s Interrogatory No. 9

I/P Engine’s response that “each of the asserted claims of the patent-in-suit are entitled to a priority date at least as early as the effective date of ‘420 patent, i.e., December 3, 1998 (based on the filing date of the patent application, U.S. Patent Application No. 09/204,149, that issued as the ‘420 patent)” and citation of documents in accordance with Rule 33(d) is a sufficient response as a matter of law. In *Sprint Comm. Co. v. Big River Tel. Co.*, No. 08-2046, 2009 U.S. Dist. Lexis 47238, *6-8 (D. Kan. June 4, 2009), that court held that a priority date interrogatory response consisting of a date including “at least as early as” language and a Rule 33(d) response was a complete answer. I/P Engine’s response is essentially identical to the response in the *Sprint* case. Just as that response was held unambiguous and complete, so should I/P Engine’s.¹

¹ A party may supplement an interrogatory response requesting priority date information, if necessary, when further information becomes available based on its investigation. *See LG Display Co., Ltd. v. Au Optonics Corp.*, 265 F.R.D. 189 (D. Del. 2010) (holding that providing an answer to an interrogatory regarding an invention date that “expressly left open the possibility of . . . claiming an earlier invention date” and then supplementing the interrogatory response to overcome prior art provided by opposing party was acceptable); *Cross Med. Prods. v. Depuy Acromed, Inc.*, No. 00-876, 2003 U.S. Dist. LEXIS 26720 (C.D. Cal. Jan. 7, 2003) (holding that

Google’s only argument to the contrary is that “[i]t is improper for Plaintiff to provide such an ambiguous priority date.” Motion at 6. But Google’s own cited cases fail to support its argument. In *McKesson Info. Solutions LLC v. Epci Sys. Corp.*, 242 F.R.D. 689, 692 (N.D. Ga. 2007), plaintiff refused to provide *any* priority date and argued that such information is irrelevant – unlike here, where I/P Engine identified a date, and cited documents. In *In re Papst Licensing GMBH & Co. KG Litig’n*, 252 F.R.D. 7, 17 (D.D.C. 2008), plaintiff provided a conception date range that predated, and was not fully supported by, the supporting evidence – not the case here. Here, I/P Engine has identified a date and all relevant information regarding priority. Google’s third case, *Invacare Corp. v. Sunrise Med. Holdings, Inc.*, No. 04-1439, 2005 WL 1750271 (N.D. Ohio Jan. 21, 2005), is factually inapplicable. There, the cited documents contradicted the language of “at least as early as” by suggesting a date later than the provided date. *Id.* at *3-4. That is not the case here, both because the cited documents are consistent with the identified date, and because Google filed its motion *before* reviewing the supplemental response and documents cited pursuant to Rule 33(d).

To the extent that Google has discomfort with the phrase “at least as early as,” courts have accepted such language as proper. *See, e.g., Sprint Comm.*, 2009 U.S. Dist. Lexis 47238 at *7-8 (upholding a response indicating that a conception occurred “at least as early as about October 1993”); *see also Monsanto Co. v. E.I. Du Pont De Nemours and Co.*, No. 09-686, 2011 U.S. Dist. Lexis 56900 (E.D. Mo. May 6, 2011) (holding that plaintiff is not required to provide an absolutely definitive priority date in answering an interrogatory, as the plaintiff is entitled to argue an alternative effective priority date to overcome later-identified prior art).

a party may supplement its answer to an interrogatory requesting an invention date when more specific data is ascertained, even if supplementation comes after the close of discovery).

Google incorrectly asserts that I/P Engine is refusing to respond to Google’s interrogatory until Google has made a prima facie case of invalidity. Not so. I/P Engine provided a complete response to Google’s interrogatory. Of course, I/P Engine has the right to supplement its responses; it is both permitted and common practice to provide updated priority dates throughout the discovery process based on a party’s ongoing investigation.²

B. I/P Engine’s Supplemental Response to Google’s Interrogatory No. 1 is Complete and Adequate as a Matter of Law

I/P Engine’s supplemental response to Interrogatory No. 1 specifically identified twenty-three documents pursuant to Rule 33(d). This response was provided pursuant to the parties’ February 10th agreement that they would “exchange supplemental interrogatory responses citing to specific Bates ranges under Rule 33(d).” Ex. 1. Under both the agreement and the case law, I/P Engine’s response is a complete and proper answer to an interrogatory requesting conception and reduction-to-practice information. *See Sprint Comm.*, 2009 U.S. Dist. Lexis 47238, at *6-8

² Numerous courts have held that supplementing interrogatory responses regarding priority, conception, or reduction to practice dates is acceptable and even required. *See, e.g., Synventive Molding Solutions, Inc. v. Husky Injection Molding Sys.*, 262 F.R.D. 365, 378-79 (D. Vt. 2009) (holding that where, in response to an interrogatory requesting a conception date, documents indicating a patent filing date as a minimal constructive date for conception is a sufficient answer and that a party may supplement an interrogatory at a later time if and when they plan to rely on an earlier priority date); *see also Monsanto Co.*, 2011 U.S. Dist. Lexis 56900, at *14 (holding that plaintiff is entitled to argue alternative effective priority dates to overcome prior art); *Ajinomoto Co. v. Int’l Trade Comm’n*, 597 F.3d 1267, 1277 (Fed. Cir. 2010) (“A patentee may seek to rely on an earlier priority date to overcome intervening prior art” and “may also argue in the alternative for different priority dates at trial.”); *Cross Med. Prods.*, 2003 U.S. Dist. LEXIS 26720, at *7-9 (holding that a party may supplement an answer to an interrogatory requesting an invention date when more specific data is ascertained, even if supplementation comes after the close of discovery); *LG Display Co., Ltd.*, 265 F.R.D. at 197-98 (holding that providing an answer to an interrogatory regarding an invention date that “expressly left open the possibility of . . . claiming an earlier invention date” and then supplementing the interrogatory response to overcome prior art provided by opposing party was acceptable). Indeed, Google acknowledges (Motion at 9) that I/P Engine has a right of supplementation.

(noting that, pursuant to Rule 33(d), it is plaintiff's prerogative to respond to a conception and reduction to practice interrogatory by specifying documents).

The history of this response shows I/P Engine's diligence. On December 7, 2011, I/P Engine responded to Interrogatory No. 1 indicating that "I/P Engine, under Rule 33(d) of the Federal Rules of Civil Procedure, will produce documents from which information responsive to this Interrogatory may be derived or ascertained." Ex. 5 at 5-6. Between December 21, 2011, and February 1, 2012, four separate productions of relevant documents were made that related to conception and reduction to practice.³ See Ex. 4, ¶ 5. Pursuant to I/P Engine's agreement to Google's February 10th proposal, on February 13th, I/P Engine supplemented its Rule 33(d) response identifying twenty-three specific documents sourced from those various productions. See Ex. 2 at 3-4. In so doing, I/P Engine has presented Google with I/P Engine's currently known, relevant evidence on conception and reduction to practice.

The documents cited pursuant to Rule 33(d) reflect I/P Engine's current information regarding conception and reduction to practice. Google is now in the same position with the same documents as I/P Engine. Under the Federal Rules, I/P Engine has fully responded, and is withholding nothing.⁴

³ Google misrepresented the facts regarding one of those productions. In its Motion (at 9), Google appears to accuse I/P Engine of not producing documents that are in its possession, in particular those of one of the inventors Mr. Kosak. As I/P Engine has explained to Google, Mr. Kosak did not possess any documents relevant to this litigation. Ex. 4, ¶ 3. And contrary to Google's assertions, the Lycos third party documents to which Google refers were produced to defendants on February 1, 2012, almost two weeks before Google filed its Motion. Ex. 4, ¶ 4. Google's assertion that I/P Engine delayed its response based on Lycos' production of documents is inaccurate. Those documents were promptly made available to Google (*Id.*), and the fact that Google did not review them in the two weeks preceding the filing of its motion is its own issue.

⁴ I/P Engine speculates that Google is concerned that I/P Engine could later assert a conception date that might undermine Google's invalidity contentions. Such a concern is both remote and theoretical. The earliest possible date for conception based on the cited documents is not early

Google’s principal argument – that “[t]o date, Plaintiff has not supplemented its response to this Interrogatory in any manner whatsoever” – is both misleading in view of the parties’ agreement reached *before the motion was filed*, and is mooted by I/P Engine’s supplementation served on February 13, 2012.

Google’s fallback arguments are equally unpersuasive. First, Google suggests (Motion at 8) that I/P Engine’s identification of documents pursuant to Rule 33(d) is inadequate because I/P Engine does not explain, via a narrative, the contents of the documents. That argument ignores the fact that I/P Engine’s Rule 33(d) response satisfies its discovery obligations. I/P Engine’s reliance upon Rule 33(d) is proper. If Google wishes to further explore the documents by deposition, it is entitled to do so. *See Sprint Comm.*, 2009 U.S. Dist. Lexis 47238, at *8.

Google tries to import the Northern District of California patent rules and case law to support its argument (Motion at 8-9) that I/P Engine cannot assert Rule 33(d) when “both named inventors are Plaintiff’s employees or consultants.” Google cites two Northern District of California cases, neither of which stand for the general proposition. In *Fresenius Med. Care Holding Inc. v. Baxter Intern., Inc.*, 224 F.R.D. 644 (N.D. Cal. 2004), the court ordered Baxter to update its response because the local patent rules obligated it to do so – not because Baxter had access to the inventors and could interview them. There is no such patent rule in this Court.⁵ In *Boston Sci. Corp. v. Micrus Corp.*, No. 04-4072, 2007 WL 174475 (N.D. Cal. Jan. 22, 2007), the

enough to affect any of the cited references disclosed in Google’s current invalidity contentions (the latest being dated March 1997). Ex. 4, ¶ 7. Furthermore, as recently as two weeks ago, Google indicated that it did not intend to assert any additional prior art. *Id.* at ¶ 8.

⁵ The local patent rule at issue in *Baxter* provided: “a party claiming patent infringement shall serve on all parties . . . the priority date to which each asserted claim allegedly is entitled” and “[a]ll documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified pursuant to Patent L.R. 3-1(f).” N.D. Cal. Patent L.R. 3-1(f) and 3-2(b).

court *rejected* an assertion identical to Google's assertion here, and instead held that a definite date need not be provided if plaintiff provides in good faith what it believes to be the approximate dates of conception and reduction to practice. I/P Engine's cited documents do just that. Because I/P Engine appropriately has identified all information available to the parties regarding priority date, as well as conception and reduction to practice, no further response is required.

II. CONCLUSION

I/P Engine's interrogatory responses are sufficient and complete as a matter of law.

Dated: February 27, 2012

By: /s/ W. Ryan Snow
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 certify that on the 27th day of February 2012, I electronically filed the foregoing with the Clerk of Court using the CM/ECF system, which will send electronic notification of such filing to the following:

Stephen E. 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/ W. Ryan Snow