

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

REDACTED PUBLIC VERSION

**REPLY BRIEF IN SUPPORT OF GOOGLE’S MOTION TO COMPEL PLAINTIFF TO
PROVIDE CONCEPTION, REDUCTION-TO-PRACTICE, AND PRIORITY DATE
INFORMATION**

I. INTRODUCTION

Google’s Motion to Compel responses to its Interrogatories that seek conception, reduction-to-practice, and priority dates from Plaintiff is not “unnecessary and moot” due to Plaintiff’s supplemental responses as I/P Engine argues. (Opp. Br. at 1). Rather, I/P Engine’s supplemental responses are infirm for the same reasons that Google identified to I/P Engine before its Motion and addressed in Google’s Motion: they still do not provide specific priority, conception, and reduction-to-practice dates for the Asserted Patents.

I/P Engine improperly argues it should be excused from providing a response with these dates because it has supplemented its responses to identify documents under Rule 33(d). A party, however, may rely on Rule 33(d) only when “the burden of deriving or ascertaining the answer will be substantially the same for either party.” While Plaintiff argues that “Google is now in the same position with the same documents as I/P Engine,” this is incorrect. As Google indicated in its Motion to Compel and to Plaintiff before Google filed that Motion, both named

inventors are I/P Engine's employees or consultants, thus providing it unfettered access to the very people – the only people – who undeniably have the ability to provide the requested precise conception, reduction-to-practice, and priority date information. Google does not have this access.

Moreover, the documents that Plaintiff points to in its responses demonstrate Rule 33(d) is inapplicable here. For example, of the 1,772 pages Plaintiff points to in its purported response to these Interrogatories, 1,589 pages are simply the prosecution history of the Asserted Patents that give no clue as to what Plaintiff contends are the priority, conception, or reduction-to-practice dates of the Patents. Nearly one third of the remaining documents are undated, rendering them useless for the information Google seeks as well. The remainder of the documents, manuals or product specifications for various WiseWire or Lycos programs, have no cognizable relevance either given that Plaintiff does not contend any WiseWire or Lycos ever embodied or product ever embodied or practiced the Asserted Patents. In short, the documents pointed to by Plaintiff fail to provide an answer to Google's Interrogatories.

Ironically, Plaintiff's supplemental responses did point to one document, a "Disclosure of Invention," that has a "conception date" and "reduction to practice date" on it. But 3 days after Plaintiff filed its Opposition, Plaintiff indicated it planned to remove from its supplemental responses any reference to this document. As discuss below, because this document references dates that materially pre-date the filing of the parent patent's application, it appears that Plaintiff realized that any reliance on this document for a date of conception and/or reduction to practice would effectively amount to admission that the Asserted Patents are invalid for public disclosure under 35 U.S.C. § 102(b). Not only does this about face highlight that the documents Plaintiff relies on under 33(d) are insufficient to provide the information that Google seeks, it

demonstrates the need for a definite response now, so that I/P Engine may not be allowed to alter its priority date throughout the case for strategic purposes as it sees fit.

As to the case law, I/P Engine suggests that Google's cited cases are based on the Northern District of California Rules. This is clearly false; none of the holdings in those cases actually rely on those rules. Nor do any of the cases I/P Engine cites support its position.

Accordingly, Google's Motion to Compel should be granted.

II. ARGUMENT

A. I/P Engine's Supplemental Interrogatory Responses Do Not "Moot" Google's Motion to Compel as They Still Do Not Identify a Specific Priority Date, or Conception or Reduction-to-Practice Dates.

Google's Motion to Compel seeks a definite priority date in response to Interrogatory No. 9. As with its prior response, I/P Engine's supplemental interrogatory response does not provide this information. Instead, I/P Engine's response to Interrogatory No. 9 states that "each of the asserted claims of the patents-in-suit are entitled to a priority date *at least as early* as the effective date of the '420 patent, i.e., December 3, 1998." It then goes on to state that "each of the asserted claims of the patents-in-suit may be entitled to an earlier effective date based on, without limitation, the filing of earlier related patent applications." (Opp. Br., Ex. 5 at 14 (emphasis added).) As its prior response, by placing the priority date is "at least as early as" December 3, 1998, which means that the priority date could be *any* date on or before December 3, 1998. *Cf. Invacare Corp. v. Sunrise Med. Holdings, Inc.*, No. 04-1439, 2005 WL 1750271, *4 (N.D. Ohio Jan. 21, 2005) ("Plaintiff's responses are essentially non-responses in that they entirely leave open the critical time period, i.e., the earliest date on which the invention was conceived and reduced to practice. For example, plaintiff responded that the invention was

conceived ‘at least August 1997’ [sic]. Obviously, this response could be read to mean a date of 1995, 1994 or even earlier.”) (emphasis in original).¹

Google’s Motion to Compel also seeks a definite response to Interrogatory No. 1 as to the Asserted Patents’ conception date, reduction-to-practice date, or any individuals involved in conception or reduction to practice. I/P Engine’s supplemental response still does not provide any of this information.

B. I/P Engine’s Reliance on Rule 33(d) Is Improper and Insufficient.

For both its supplemental responses to Interrogatory Nos. 1 and 9, Plaintiff states that “I/P Engine, and third parties, have produced documents from which information responsive to this Interrogatory may be derived or ascertained” and lists the same 1,772 pages of documents. (Opp. Br., Ex. 2 at 4, 14). Plaintiff’s reliance on these documents is improper for several reasons.

1. To the extent it is possible at all, the burden of ascertaining a concrete response from the cited documents is not the same for Plaintiff and Google.

Initially, Rule 33(d) may only be invoked when “the answer to an interrogatory may be determined by examining, auditing, compiling, abstracting, or summarizing a party’s business records (including electronically stored information), and if the burden of deriving or ascertaining the answer will be substantially the same for either party.” Even if the documents

¹ I/P Engine attempts to distinguish *Invacare* on the ground that “the cited documents [in *Invacare*] contradicted the language of ‘at least as early as’ by suggesting a date later than the provided date.” (Opp. Br. at 3). Yet, the *Invacare* court rejected defendant’s argument that plaintiff’s interrogatory responses were insufficient merely because the asserted conception date was inconsistent with the cited documents. *See Invacare*, 2005 WL 1750271 at *4 (“With regard to the disparity between the documentary evidence and the dates provided, the Court agrees with plaintiff.”) Rather, as recited above, *Invacare* held that plaintiff’s interrogatory responses were insufficient because they used vague “as early as” language that provided no certainty as to the asserted dates. Such is the case here – I/P Engine’s position that the priority date is “at least as early as” December 3, 1998 provides no certainty as to the actual priority date that I/P Engine asserts.

pointed to by I/P Engine contained within them the information Google seeks (which is doubtful as noted below) , I/P Engine cannot meet this standard here because it is only with information from both named inventors – who are employees or consultants of Plaintiff – that a complete response to Google’s Interrogatories could be derived. Because of its relationship with both inventors , I/P Engine should easily be able to provide definite dates in response to Interrogatory Nos. 1 and 9.

By contrast, I/P Engine’s decision to identify documents instead of providing this information imposes a significant burden on Google. Even after reviewing the 1,772 pages of documents identified by I/P Engine, Google cannot ascertain I/P Engine’s contentions on when conception and reduction to practice occurred, and the priority date this subject – which is what Interrogatory Nos. 1 and 9 request. The identification of documents simply does not provide the definite explanation of I/P Engine’s view on the subject such contention interrogatories require. *See Boston Sci. Corp. v. Micrus Corp.*, No. 04-4072, 2007 WL 174475, *1 (N.D. Cal. Jan. 22, 2007) (“Although this interrogatory was not phrased as a contention interrogatory per se, it does request Boston Scientific to “identify” the date of conception; as such, it reasonably calls for *Boston Scientific* to disclose *its* view as to when the inventions were conceived.”) (emphasis in original); *Fresenius Med. Care Holding Inc. v. Baxter Intern., Inc.*, 224 F.R.D. 644, 650 (N.D. Cal. 2004) (a plaintiff must directly state a patents’ alleged conception and reduction-to-practice dates in response to interrogatories seeking this information, and cannot merely identify documents in response to such interrogatories).

2. The documents Plaintiff points to do not reveal conception, reduction-to-practice, or priority dates.

Initially, 1,589 pages of the documents that I/P Engine points to in its supplemental responses contain the prosecution histories of the patents-in-suit. Included in these file histories

are a myriad of office actions, correspondence, and other documentation. Plaintiff provides no indication as to what in the prosecution histories supposedly supports Plaintiff's unidentified priority, conception or reduction-to-practice dates, whether it is relying on an earlier application for an earlier priority date, or anything else. As invocation of Rule 33(d) "requires first that the information actually be obtainable from the documents," Plaintiff's use of Rule 33(d) is improper. *See In re Sulfuric Acid Antitrust Litigation*, 231 F.R.D. 320, 325-26 (N.D. Ill. 2005) (granting motion to compel where answering party had not shown that burden of ascertaining answer was substantially the same for both parties or that a complete answer could be found in the documents).

The remaining 183 pages of documents identified in Plaintiff's Supplemental Response comprise 22 discrete documents. Nine of these documents have no date at all. Given that these documents have no dates, Plaintiff cannot credibly say that the burden is substantially the same on Google to ascertain the priority, conception, or reduction-to-practice dates from these documents. Indeed, it is unclear how these undated documents are relevant to these issues at all.

The documents that actually do have dates on them also provide no answers to Google's Interrogatories either. They appear to concern various products and projects from WiseWire and Lycos from 1997-1998. Most of these documents appear to be manuals or product specifications for various WiseWire or Lycos programs such as the following examples:

- REDACTED (*see* Kammerud Decl. at Ex. L (IPEL0001270-1273));
- REDACTED (*see* Kammerud Decl. at Ex. M (IPEL0001395-1399));
- REDACTED (*See* Kammerud Decl. at Ex. N (IPEL0001557-1561)).

These documents bear no apparent relationship to the Asserted Patents. They certainly do not provide any basis for Google to ascertain I/P Engine's contended priority, conception, or reduction-to-practice dates for the Patents.

Further, the inclusion of WiseWire product manuals and specifications is puzzling given I/P Engine's Response to Interrogatory No. 5, which requests that I/P Engine identify any product or software that practices or practiced any claim of the patents-in-suit or that embodies any invention claimed in the patents-in-suit. (Motion, Kammerud Decl. at Ex. A). I/P Engine does not identify any WiseWire or Lycos product or software in response to Interrogatory No. 5. Thus, it is unclear how technical documents for WiseWire products have any relationship to the patents-in-suit, let alone how Google can use such documents to ascertain I/P Engine's contentions as to the conception, reduction-to-practice, or priority dates of the Patents.

Notably, each of the dated documents from this set predates December 3, 1998 – the filing date of the '420 Patent. This suggests that, although I/P Engine now states that the priority date is "at least as early as" December 3, 1998, it may likely seek a priority date earlier than that.

3. Plaintiff seeks to remove an "Invention Disclosure" from its responses that would demonstrate the Patents' invalidity for public disclosure under 102(b).

Moreover, Plaintiff has now removed the only document among those identified that actual does provide any conception or reduction-to-practice date. After Plaintiff filed its Opposition, on March 1, 2012, Plaintiff's counsel sent an email indicating that Plaintiff intends to again supplement its responses in order to delete certain documents from its responses to Interrogatory Nos. 1 and 9. (Kammerud Decl., Ex. O). In other words, Plaintiff itself has already revised the very response that Plaintiff represented was adequate just a week ago.

One of these documents is REDACTED. (See Kammerud Decl. at Ex. P (LANG0007021-7028)). It states REDACTED. It goes on to state:

REDACTED

(*Id.* at LANG0007023.) Given that Plaintiff did not apply for the patent until December 3, 1998, REDACTED would invalidate the patent under 35 U.S.C. § 102(b), which provides that an

invention is not patentable if “the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” While Plaintiff saw fit to rely on this document to show the Court it was providing conception and reduction-to-practice dates for the Asserted Patents, it has apparently now thought the better of it, likely recognizing reliance on this document to show these dates is an admission that the Patents are invalid.

That I/P Engine would point to a document with conception and reduction-to-practice dates to argue that its interrogatory response is sufficient, only to remove that documents days later, shows why Google’s Motion must be granted. Plaintiff should be ordered to provide a response with actual dates. Alternatively, Plaintiff should be forced to stick with its initial supplemental response which included the above document – a document that Plaintiff represented to the Court provided the conception and reduction to practice of the Asserted Patents and which seemingly renders the Patents invalid under 35 U.S.C. § 102(b).

C. **The Parties Did Not Agree That Identification of Documents Pursuant to Rule 33(d) Would Provide Sufficient Responses to Interrogatory Nos. 1 and 9.**

Also unfounded is I/P Engine’s suggestion that the parties had any agreement by which I/P Engine could respond to Interrogatory Nos. 1 and 9 by identifying documents under Rule 33(d). (*See* Opp. Br. at 4). There was no such agreement. Rather, as explained in the Background section of Google’s Motion to Compel, Google repeatedly made clear during the meet-and-confer process that I/P Engine must provide a definite priority date in response to Interrogatory No. 9 and must respond to Interrogatory No. 1 *without* relying on Rule 33(d). (*See* Opening Br. at 4-6).

Concurrent with their meet-and-confer efforts over Interrogatory Nos. 1 and 9, the parties did agree on a date by which they would identify specific documents for all the interrogatories

that they intended to respond to through Rule 33(d). But Google *never* agreed that a Rule 33(d) response would be sufficient for Google’s Interrogatory Nos. 1 and 9. In fact, during the parties’ meet and confer conferences on this issue, Google explicitly stated that identifying documents was not sufficient to answer these Interrogatories, and that full responses required the provision of the specific dates requested. (*See, e.g.*, Kammerud Decl., Ex. Q at 2).

D. The Duty to Supplement Does Not Excuse Plaintiff’s Obligation to Provide a Response Now.

I/P Engine argues that “[a] party may supplement an interrogatory response requesting priority date information, if necessary, when further information becomes available based on its investigation” (Opp. Br. at fn. 1) and “[n]umerous courts have held that supplementing interrogatory responses regarding priority, conception, or reduction to practice is acceptable and even required.” (*Id.* at fn. 2). This argument attacks a straw-man. Regardless of whether the parties may supplement their respective interrogatory responses under appropriate circumstances later in this matter, Plaintiff must state its current knowledge and contentions as to the priority, conception, and reduction-to-practice to dates.

E. Plaintiff Fails to Rebut Google's Cited Authority; Plaintiff's Authority Is Inapposite.

I/P Engine argues that Google’s citation to the *Fresenius* and *Boston* cases is an attempt “to import the Northern District of California patent rules” to this case. (Opp. Br. at 6). This position is incredible. First, the *Boston* case does not even *mention* the Northern District of California’s local patent rules, much less rely on these local rules to support its holding that a plaintiff must directly state the asserted patents’ conception and reduction-to-practice dates. 2007 WL 174475.

Further, *Fresenius*’s central holding is that the patentee must directly provide conception and reduction-to-practice dates without resort to Rule 33(d). It based this holding on the fact that

the patentee's close relationship with the inventors gave it a comparative advantage in ascertaining the dates of conception and reduction to practice, rendering Rule 33(d) inapplicable. *See* 224 F.R.D. at 650. Such is the case here: both named inventors are employees or consultants of I/P Engine, and I/P Engine can use its contacts with these inventors to directly state the dates when the Patents were allegedly conceived and reduced to practice. *Fresenius* did not rely at all on the local patent rules to reach this holding. Instead, *Fresenius* invoked the local patent rules only to dispose of the patentee's argument that it was premature to serve an interrogatory seeking dates for conception and reduction to practice. *See id.*

I/P Engine relies heavily on *Sprint Comm'ns Co. v. Big River Tel. Co.*, No. 08-2046, 2009 U.S. Dist. Lexis 47238 (D. Kan. June 4, 2009) in arguing that its "at least as early as" response is proper. (*See* Opp. Br. at 2, 4). But I/P Engine reads a holding into *Sprint* that does not exist.

In *Sprint*, Defendants moved to compel a narrative response describing the circumstances of conception and due diligence rather than a mere identification of documents on these topics. *See* 2009 U.S. Dist. Lexis 47238 at *8 ("Big River challenges Sprint's response as incomplete, suggesting Sprint should have provided a written description of the 'due diligence' and the circumstances surrounding the alleged conception of the claimed inventions.") While the Plaintiff's interrogatory response in that case did use language stating that conception occurred "at least as early as about October 1993," that was not the subject of Defendants' motion. *See id.* at *7. Thus, the *Sprint* court did not decide, and no reason to decide whether plaintiff's asserted conception date of "at least as early as about October 1993" was proper. I/P Engine's argument that the *Sprint* court endorsed "at least as early as" language is simply false.

I/P Engine also cites *Monsanto Co. v. E.I Du Pont De Nemours and Co.*, No. 09-686, 2011 WL 2119397 (E.D. Mo. May 26, 2011). But in *Monsanto* the plaintiff did not, like I/P Engine, refuse to provide *any* specific priority dates or use the “at least as early” language that I/P Engine does here. *See id.* at *3. (allowing plaintiff to “argue in the alternative” for two specific priority dates.). Thus, *Monsanto* is of no help to I/P Engine’s position either.

III. CONCLUSION

For the foregoing reasons, Google respectfully requests that the Court compel Plaintiff to provide definite priority dates in response to Google’s Interrogatory No. 9. Google also respectfully requests that Court compel Plaintiff to provide definite conception dates, reduction-to-practice dates, and the names of the individuals involved in conception and reduction-to-practice in response to Interrogatory No. 1, without resort to the procedures of Rule 33(d).

DATED: March 5, 2012

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CERTIFICATE OF SERVICE

I hereby certify that on March 5, 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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