

Exhibit 1

**UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
NORFOLK DIVISION**

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

PLAINTIFF I/P ENGINE, INC.’S NOTICE OF SUPPLEMENTAL AUTHORITY

On December 18, 2012, Plaintiff I/P Engine, Inc. (“I/P Engine”) moved for an award of post-judgment royalties requesting enhanced ongoing royalties for Defendants’ continued, willful, post-verdict use of the adjudged infringing system. In opposition to that motion, Defendants contended that any ongoing royalty should not be enhanced—despite the adverse jury verdict against them—because of an interim communication issued during U.S. Patent & Trademark Office (“PTO”) proceedings that Defendants initiated:

. . . the patents are being re-examined by the Patent Office, which raises a serious question as to their validity. In the pending reexamination of the ‘420 patent, the PTO has issued a *Final* Office Action rejecting all asserted claims as anticipated or obvious in light of five prior-art references.

D.I. 938 at 21 (emphasis in original).

On July 24, 2013, however, the PTO rejected Defendants’ invalidity positions, and *confirmed the patentability of all reexamined claims*. See Notice of Intent to Issue Ex Parte Reexamination Certificate (“Notice of Intent”) attached as Exhibit A. In fact, the PTO found the claims valid for exactly the same reasons I/P Engine’s expert, Dr. Jaime Carbonell, testified they were valid:

. . . none of the cited references, alone or in combination, teach or suggest the following claimed features:

(Claim 10) “. . . the filter system combining pertaining feedback data from the feedback system with the content profile data in filtering each informon for relevance to the query.”

(Claim 25) “. . . combining pertaining feedback data with the content profile data in filtering each informon for relevance to the query.”

Notice of Intent at 9. Notably, the PTO confirmed all claims as valid under a lower burden of proof for invalidity as applied at trial. *See In re Swanson*, 540 F.3d 1368, 1377-78 (Fed. Cir. 2008) (in PTO reexaminations, the standard of proof, which is a preponderance of evidence, is substantially lower than in a civil case, and there is no presumption of validity). Thus, the Notice of Intent confirming validity of all of the asserted claims (even under the lower burden of proof) demonstrates that—post adverse jury verdict—Defendants could not have formed a good faith belief that the ‘420 patent was invalid. The PTO’s confirmation further supports the enhancement of the post-judgment royalties I/P Engine requested in its motion.

Dated: July 31, 2013

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Exhibit A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,991	05/24/2012	6314420	S0217.0002/P002-RE	4797

570 7590 07/24/2013
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EXAMINER

PROCTOR, JASON SCOTT

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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07/24/2013

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

QUINN EMANUEL URQUHART &
SULLIVAN, LLP
50 CALIFORNIA STREET, 22ND FLOOR
SAN FRANCISCO, CA 94111

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/009,991.

PATENT NO. 6314420.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

**Notice of Intent to Issue
Ex Parte Reexamination Certificate**

Control No. 90/009,991	Patent Under Reexamination 6314420
Examiner JASON PROCTOR	Art Unit 3992

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. Cf. 37 CFR 1.313(a). A Certificate will be issued in view of
 - (a) Patent owner's communication(s) filed: 10 July 2013.
 - (b) Patent owner's failure to file an appropriate timely response to the Office action mailed: _____.
 - (c) Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
 - (d) The decision on appeal by the Board of Patent Appeals and Interferences Court dated _____
 - (e) Other: _____.
2. The Reexamination Certificate will indicate the following:
 - (a) Change in the Specification: Yes No
 - (b) Change in the Drawing(s): Yes No
 - (c) Status of the Claim(s):
 - (1) Patent claim(s) confirmed: 10,14,15,25,27 and 28.
 - (2) Patent claim(s) amended (including dependent on amended claim(s)): _____
 - (3) Patent claim(s) canceled: _____.
 - (4) Newly presented claim(s) patentable: _____.
 - (5) Newly presented canceled claims: _____.
 - (6) Patent claim(s) previously currently disclaimed: _____
 - (7) Patent claim(s) not subject to reexamination: 1-9,11-13,16-24,26 and 29-36.
3. Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
4. Note attached NOTICE OF REFERENCES CITED (PTO-892).
5. Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
6. The drawing correction request filed on _____ is: approved disapproved.
7. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some* c) None of the certified copies have
 been received.
 not been received.
 been filed in Application No. _____.
 - been filed in reexamination Control No. _____.
 - been received by the International Bureau in PCT Application No. _____.

* Certified copies not received: _____.
8. Note attached Examiner's Amendment.
9. Note attached Interview Summary (PTO-474).
10. Other: _____.

All correspondence relating to this reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

/Jason Proctor/
Primary Examiner, Art Unit 3992

cc: Requester (if third party requester)

DETAILED ACTION

This Office Action addresses claims 10, 14, 15, 25, 27, and 28 of US Patent No. 6,314,420 issued to Lang et al. ("the '420 Patent").

A Request for *Ex Parte* Reexamination was filed on 16 March 2012. The Office issued a Notice of Incomplete *Ex Parte* Reexamination on 26 April 2012, and vacated the filing date of the original Request. A corrected Request for *Ex Parte* Reexamination was filed on 24 May 2012 ("the Request").

It was determined in the Order Granting *Ex Parte* Reexamination entered on 18 July 2012 ("the Order") that the Request raised at least one Substantial New Question of Patentability regarding at least one patent claim. *Ex Parte* Reexamination was ordered for claims 10, 14, 15, 25, 27, and 28 of the '420 Patent.

Claims 10, 14, 15, 25, 27, and 28 were rejected in the Non-Final Office Action entered on 25 September 2012 ("the Non-Final Office Action"). Patent Owner filed a response on 26 November 2012 ("Patent Owner's Remarks"). An interview was conducted on 22 January 2013, and Patent Owner submitted an Interview Summary on 22 February 2013 ("Interview Summary"). The Examiner has fully considered these responses.

Claims 10, 14, 15, 25, 27, and 28 were rejected in the Final Office Action entered on 3 May 2013 ("the Final Office Action"). An interview was conducted on 13 June 2013, and Patent Owner submitted an Interview Summary as part of a response to the Final Office Action on 3 July 2013. In Patent Owner's Second Remarks, the text of the Remarks section was partially

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corrupted. Patent Owner submitted a replacement copy of the Remarks section on 10 July 2013 ("Patent Owner's Second Remarks"). The Examiner has fully considered these responses.

For reasons set forth below, claims 10, 14, 15, 25, 27, and 28 are confirmed.

Claims 1-9, 11-13, 16, 24, 26, and 29-36 are not subject to the present reexamination proceeding.

I. INFORMATION DISCLOSURE STATEMENTS

Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information. See MPEP 2256.

II. REFERENCES CITED

US Patent No. 6,202,058 to Rose et al. ("Rose")

US Patent No. 5,835,087 to Herz et al. ("Herz")

David Goldberg et al., "Using Collaborative Filtering to Weave an Information Tapestry," Communications of the ACM (December 1992) ("Goldberg")

Yezdezard Lashkari, "Feature Guided Automated Collaborative Filtering," MIT Masters Thesis (September 1995) ("Lashkari")

Paul Resnick et al., "GroupLens: An Open Architecture for Collaborative Filtering of Netnews," Proceedings of ACM 1994 Conference (1994) ("Resnick")

Shoshana Loeb, "Architecting Personalized Delivery of Multimedia Information," Communications of the ACM (December 1992) ("Loeb")

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III. STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION

The following is an Examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

Patent Owner submits that:

As the Patent Owner conceded during the interview, and as it now specifically affirms and represents, the claim language is not broad enough to include or cover "over the wall" systems (regardless of whether they are prior art or current commercial embodiments), even under the claims broadest reasonable interpretation. Patent Owner's claims do not cover "over the wall" systems because, for example, the claim language requires each document's content data and collaborative data (e.g., its content score and collaborative score) to be considered together in filtering for relevance to the query. (See, e.g., Figs. 6 and 9 of the 420 patent). "Over the wall" systems, however, perform content-filtering (based on a query) separate and apart from collaborative-filtering (based on general item ratings or a user profile instead of a query). Thus, the underlying data for each document is not considered together in filtering for relevance to the query. Because "over the wall" systems involve two separate and distinct processing steps, at least some potential documents will not be selected by the query server to be thrown "over the wall." Accordingly, filtering based on the combined content data and collaborative feedback data is not performed on "each" document, as required by Patent Owner's claim language.

The Claim Language Excludes "Over the Wall" Systems

The claim language describes a filter system that combines content data and collaborative data in filtering each informon for relevance to the query. Specifically, claim 10 recites:

the filter system combining pertaining feedback data from the feedback system with the content profile data in filtering each informon for relevance to the query

Claim 25 similarly recites:

combining pertaining feedback data with the content profile data in filtering each informon for relevance to the query

The claims exclude the "over the wall" systems based on three related, but independent portions of the claim language. First, the claims require the filter

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system to "combin[e] pertaining feedback data..., with the content profile data." The claimed "data" is not the informon itself, but underlying properties associated with the informon, e.g., its content ranking and its feedback ranking. (See, e.g., Figs. 6 and 9). "Over the wall" systems do not combine that content and feedback data for use together as a selection criteria in filtering. Instead, in "over the wall" systems, documents are first processed and selected based on content data (e.g., content matching to the query), and then they are passed "over the wall" to the profile system, which processes and selects documents based on feedback data (e.g., user ratings). The two sets of data (i.e., content and feedback data) are not used together on either side of the wall and therefore not combined in the manner the claims require.

Second, the claims require the filter system to use the combined data in filtering "each informon" for relevance to the query. That is, "each informon" considered must be filtered using the combination of content data and collaborative data. Over the wall systems do not filter "each informon" based on that combination of data because at least some documents will not be selected by the query server (the first content-matching process). As such, those documents not selected by the query server will never make it "over the wall," and will therefore never be filtered based on collaborative data by the profile system. Because some documents are filtered and discarded based solely on their content data, "over the wall" systems do not filter "each informon" based on the combination of content and collaborative-based data.

Third, the claims require that the filter system use the combined content and feedback data "in filtering..., for relevance to the query." Accordingly at the point when the combined data is used "in filtering," the filter system must consider the "query" to determine an informon's relevance (it cannot solely be feedback). The prior art does not use the combined data to filter "for relevance to the query." At the point of the alleged combination in the "over the wall systems" (i.e., at the profile system), the query is not a criteria used to determine the documents relevance. In the "over the wall" systems, the profile system does not filter "for relevance to the query."

(Patent Owner's Second Remarks, pages 6-7, emphasis in original)

The Examiner has fully considered these remarks and agrees with Patent Owner's interpretation that the claims exclude an "over the wall" system by way of the "three related, but independent portions of the claim language" identified by Patent Owner.

In response to the previous Rejection 1 of claims 10 and 25 under 35 U.S.C. § 102(e) as being anticipated by Rose, Patent Owner argues that:

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Patent Owner understands the Examiner agrees that Rose is an "over the wall" system that uses sequential steps for content analysis and collaborative analysis. But, the Office Action at pp. 5-8 asserts that the claim language is broad enough to include the "over the wall" type systems. As explained above, the broadest reasonable interpretation of claims 10 and 25 in light of and consistent with the specification excludes the "over the wall" type system because it does not (1) combine content data and feedback data (2) in filtering each informon (3) for relevance to the query.

First, Rose does not combine a document's "content data" and its "collaborative data" and use that data together as a criteria for filtering. To the extent that Rose performs any content-based filtering with respect to a query, this occurs only to collect documents from an on-line text retrieval service, and, as the Examiners agreed during the interview, this is prior to the use of collaborative data in a separate filtering step that the ranking system performs. Rose does not use content data from the analysis of relevance to the query (e.g., a relevancy score) together with collaborative data (e.g., user ratings) as a criteria in filtering documents to present to the user.

Second, Rose does not filter "each" informon using content and collaborative data. Documents that have been excluded by the on-line text retrieval service will not make it "over the wall" to the Rose collaborative ranking system. The excluded documents, therefore, are not filtered based on collaborative data but, rather, the excluded documents are filtered only based on content data by the retrieval service. Accordingly, the system does not use the combination of content and collaborative data in filtering "each" informon (i.e., each document).

Third, the Rose collaborative ranking system operates independently of the original query. The part of the system the Office Action alleges performs the combination of data is the collaborative ranking system. (See Exhibit CC-1 to Request, which was adopted by the Examiner). To meet the claims, that collaborative ranking system must filter "for relevance to the query." Because the collaborative ranking system does not have access to the query, it cannot filter "for relevance to the query." As conceded by Requester's expert, Rose ranking system considers relevance to a user, not relevance to a query. See, e.g., Ungar Expert Report at page 92.

For at least the reasons described above, Patent Owner respectfully requests reconsideration and withdrawal of the rejection of claims 10 and 25 based on Rose.

(Patent Owner's Second Remarks, pages 12-14, emphasis in original)

The Examiner has fully considered this argument and has found it persuasive.

Accordingly, the previous Rejection 1 is withdrawn.

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In response to the previous Rejection 6 of claims 10 and 25 under 35 U.S.C. § 102(e) as being anticipated by Lashkari, Patent Owner argues that:

Like Rose, Lashkari discloses an "over the wall" approach to document retrieval. In fact, Lashkari's description at page 78 of using the third-party Lycos search engine along with the "Webhound" FGACF interface epitomizes the prior art "over the wall approach"...

As in the Rose rejection, the Office Action at pp. 18-19 says the claims are broad enough to encompass this "over the wall" approach. Under the claims' broadest reasonable construction, however, Lashkari's "over the wall" system does not (1) combine content data and feedback data (2) in filtering each informon (3) for relevance to the query.

(Patent Owner's Second Remarks, pages 14-15, emphasis in original)

The Examiner has fully considered this argument and has found it persuasive. Accordingly, the previous Rejection 6 is withdrawn.

In response to the previous Rejection 4 of claims 10, 14, 15, 25, 27, and 28 under 35 U.S.C. § 102(e) as being anticipated by Herz, Patent Owner argues that:

Herz does not anticipate the claims for similar reasons to those described above for Rose and the "over the wall" systems. Herz does not combine content data and collaborative data and use that data together as a criteria to filter each informon for relevance to a query. Instead, Herz describes an initial content search (based on a search profile) followed by a user rating system that develops a user profile. That user profile is then stored and changes over time for periodic application in filtering new documents entering the system. At these ongoing filtering steps, other user information may be used, but like the "over the wall" systems, the initial search is conducted based purely on content data, and the later ongoing filtering steps, which may use collaborative feedback data, do not filter "each" document ("each" informon) for relevance to a query.

(Patent Owner's Second Remarks, pages 17-18, emphasis in original)

The Examiner has fully considered this argument and has found it persuasive. Accordingly, the previous Rejection 4 is withdrawn.

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In response to the previous Rejection 5 of claims 10, 14, 15, 25, 27, and 28 under 35 U.S.C. § 102(e) as being anticipated by Goldberg, Patent Owner argues that:

As recognized by the Office Action, the "filtering" performed by Goldberg occurs first at the Filterer, and second at the Appraiser. Specifically, the Little Box throws the items that are the search results over the "server-client" wall (See Goldberg at Figure 2) to the Appraiser, which runs a separate filtering step. Accordingly, like the "over the wall" systems discussed above, Goldberg does not (1) combine content data and feedback data (2) in filtering each informon (3) for relevance to the query.

(Patent Owner's Second Remarks, page 22, emphasis in original)

The Examiner has fully considered this argument and has found it persuasive. Accordingly, the previous Rejection 5 is withdrawn.

In response to the previous Rejection 9 of claims 10 and 25 under 35 U.S.C. § 102(e) as being anticipated by Resnick, Patent Owner argues that:

Resnick is a purely collaborative filter. The portions of Resnick cited by the Examiner as disclosing the combination of content and collaborative filtering do not describe the actual Resnick system, which is entitled "GroupLens." Rather, the cited portions are part of a summary description of other systems (under the "Related Work" heading). Specifically, the statement that "a reader could request articles containing the word 'CSCW' that Joe has evaluated and where the evaluation contains the word, 'excellent'" does not refer to Resnick's GroupLens system, it refers to the "Tapestry" system taught by Goldberg. (See Resnick at p. 3, and FN6, citing Goldberg). The Tapestry system taught by Goldberg does not meet the limitations of the claims for the reasons described above.

The Examiner has fully considered this argument and has found it persuasive. Accordingly, the previous Rejection 9 is withdrawn.

In response to the previous Rejections 2, 3, 7, 8, 10, and 11, Patent Owner argues that:

Dependent claims 14, 15, 27, and 28 stand rejected under 35 U.S.C. 103(a) as being obvious over Rose in view of Herz, Rose in view of Loeb, Lashkari in

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view of Herz, Lashkari in view of Loeb, Resnick in view of Herz, and Resnick in view of Loeb, respectively. As described above, each of Rose, Herz, Lashkari, and Resnick fail to teach or suggest combining pertaining feedback data with the content profile data in filtering each informon for relevance to the query as required by independent claims 10 and 25. For at least the reasons recited above and in Patent Owner's November 26, 2012 Response, both Herz and Loeb fail to compensate for the deficiencies in the other cited references. Accordingly, claims 14, 15, 27, and 28 are allowable for at least the same reasons that their respective independent claims are allowable.

The Examiner has fully considered this argument and has found it persuasive. Accordingly, the previous Rejections 2, 3, 7, 8, 10, and 11 are withdrawn.

Therefore, none of the cited references, alone or in combination, teach or suggest the following claimed features:

(Claim 10) "...the filter system combining pertaining feedback data from the feedback system with the content profile data in filtering each informon for relevance to the query."

(Claim 25) "...combining pertaining feedback data with the content profile data in filtering each informon for relevance to the query."

Dependent claims 14, 15, 27, and 28 incorporate this language and are allowable for at least the same reason.

Any comments considered necessary by PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the patent owner should be labeled: "Comments on Statement of Reasons for Patentability and/or Confirmation" and will be placed in the reexamination file.

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IV. CONCLUSION

For reasons set forth below, claims 10, 14, 15, 25, 27, and 28 are confirmed.

Claims 1-9, 11-13, 16, 24, 26, and 29-36 are not subject to the present reexamination proceeding.

Any paper filed with the USPTO, *i.e.*, any submission made, by either the Patent Owner or the Third Party Requester must be served on every other party in the reexamination proceeding, including any other third party requester that is part of the proceeding due to merger of the reexamination proceedings. As proof of service, the party submitting the paper to the Office must attach a Certificate of Service to the paper, which sets forth the name and address of the party served and the method of service. Papers filed without the required Certificate of Service may be denied consideration. 37 CFR 1.903; MPEP 2266.03.

All correspondence relating to this *ex partes* reexamination proceeding should be directed as follows:

By U.S. Postal Service Mail to:

Mail Stop *Ex Partes* Reexam
ATTN: Central Reexamination Unit
Commissioner for Patents P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand to: Customer Service Window
Randolph Building
401 Dulany St.
Alexandria, VA 22314

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By EFS-Web:

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at

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EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/Jason Proctor/
Primary Examiner
AU 3992

/FOF/

/Alexander J Kosowski/
Supervisory Patent Examiner, Art Unit 3992