

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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**PLAINTIFF I/P ENGINE, INC’S MOTION TO COMPEL DEFENDANTS’
COMPLIANCE WITH THIS COURT’S SCHEDULING ORDER, OR
ALTERNATIVELY, MOTION FOR PROTECTIVE ORDER**

Plaintiff I/P Engine, Inc. (“I/P Engine”) moves to compel Defendants to comply with paragraph 13(c) of the Scheduling Order, which requires the parties to collectively identify ten claim terms to be construed. Defendants have instead insisted that the parties construe every single term in every limitation of all 14 of the claims at issue in the two patents-in suit – more than 90% of the words in the asserted claims. Defendants refuse to narrow their list of claim terms to ensure compliance with the Scheduling Order. Defendants are violating both the Scheduling Order and Federal Circuit precedent that grants this Court broad discretion in managing its docket, and makes clear that a court need not construe every claim term. Their approach will effectively require this Court to provide its judgment on the entire meaning of the claims.

The Scheduling Order requires that the parties exchange the claim constructions that they have collectively agreed upon today, March 21. I/P Engine has served its claim constructions on the terms that it understands are primarily in dispute. I/P Engine believes that, under the

Scheduling Order and Federal Circuit precedent, it is not obligated to submit claim constructions for every claim term in every limitation of each asserted claim, as Defendants insist. Because Defendants are refusing to comply with the Scheduling Order and identify a reasonable number of claim terms to be construed, simultaneously with the filing of this motion, I/P Engine moves in the alternative for a Protective Order excusing it from Defendants' unreasonable demands that Plaintiff disclose proposed constructions and supporting intrinsic and extrinsic evidence for virtually every limitation in the asserted claims.

As set forth in greater detail in the supporting brief and exhibits, paragraph 13(b) of the Court's Scheduling Order of February 15, 2012, provides: "The parties shall simultaneously exchange a list of claim terms to be construed, identifying any claim element that the party contends should be governed by 35 U.S.C. § 112(6) on or before **March 14, 2012**. (D.I. 90, at 5, emphasis in original). Plaintiff timely served its list of four claim terms: "informon", "relevance", "combining", and "scanning a network." Defendants simultaneously served a list consisting of *every limitation in every asserted claim* – more than 40 different claim terms. Defendants' inclusion of every limitation in every asserted claim violates Federal Circuit law: "[D]istrict courts are not (and should not be) required to construe every limitation present in a patent's asserted claims." *02 Micro Int'l. Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008) (citation omitted). The purpose of claim construction is to identify a reasonable set of specific terms that are vague or unexplained, which necessitate Court interpretation to further a just outcome. *Id.* Defendants, however, have made no effort to narrow their list of claim terms, even though the Court has made it clear that it would "construe no more than **ten (10) terms**." (D.I. 90, at 5, emphasis in original).

Between March 15 and 20, Plaintiff repeatedly attempted to resolve this dispute without filing a motion. On Thursday, March 15, Plaintiff objected to Defendants' regurgitation of every possible claim term, pointing out that paragraph 13(c) of the Scheduling Order requires the parties to collectively agree on the list of claim terms prior to the exchange of proposed constructions, along with all of their supporting intrinsic and extrinsic evidence, and requested that Defendants narrow their list. When Defendants refused to do so, the parties had a meet and confer on the afternoon of Monday, March 19. Plaintiff repeatedly sought to narrow Defendants' list of claim terms, but Defendants resisted, instead insisting that Plaintiff offer detailed constructions and evidence for every possible term in the asserted claims.

On Tuesday, March 20, Plaintiff made multiple attempts to secure Defendants' compliance with the Scheduling Order. Plaintiff first proposed that Defendants identify their "top 10" claim terms, as well as Plaintiff's four terms, and the parties exchange constructions and evidence on those. Defendants rejected that proposal. Alternatively, Plaintiff proposed that each party serve their proposed construction for their respective terms on Wednesday, March 21, with Defendants indicating which of their 40-plus terms were of greatest interest to them. The parties then would meet and confer by Friday, March 23 to determine whether there is any agreement, identify the ten claim terms to be construed, and exchange full constructions and supporting evidence by Wednesday, March 29. Defendants rejected that proposal.

Yesterday afternoon, Plaintiff offered a third proposal, proposing a list of twelve claim terms or concepts that incorporated Plaintiff's terms, plus the terms or concepts that were of greatest interest to Defendants. Defendants rejected that third attempt at compromise, refused to focus their list of claim terms for construction, and refused to further engage on the issue.

The parties are at an impasse. Plaintiff asks this Court to compel Defendants to comply with paragraph 13(c) of the Scheduling Order by identifying their top ten claim terms to be construed. Alternatively, Plaintiff moves for a Protective Order to ensure that its rights are preserved against Defendants' unauthorized demands.

Dated: March 21, 2012

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CERTIFICATE OF GOOD FAITH

In accordance with Local Rule 37(E), I certify that counsel conferred in good faith to resolve this dispute prior to the filing of the present Motion. Counsel's meet-and-confer efforts are set forth in the Background section of I/P Engine's accompanying brief, and included multiple email communications and telephonic meet-and-confers.

/s/Kenneth W. Brothers
Kenneth W. Brothers

CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of March, 2012, the foregoing **PLAINTIFF I/P ENGINE, INC.'S MOTION TO COMPEL DEFENDANTS' COMPLIANCE WITH THIS COURT'S SCHEDULING ORDER, OR ALTERNATIVELY, MOTION FOR PROTECTIVE ORDER**, was served via the Court's CM/ECF system, on the following:

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