

HONORABLE MARSHA J. PECHMAN

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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

INTERVAL LICENSING LLC,

Plaintiff,

v.

AOL, INC, et al.,

Defendants.

Case No.: 2:10-cv-01385-MJP

MOTION FOR RECONSIDERATION
AND CLARIFICATION OF COURT'S
FEBRUARY 16, 2011, SCHEDULING
ORDER, BY DEFENDANTS GOOGLE
INC. AND YOUTUBE, LLC

Note on Motion Calendar:

March 2, 2011

1 Pursuant to L.R. 7(h), Google Inc. and YouTube, LLC (collectively “Google”) seek
 2 partial reconsideration and clarification of the Court’s Scheduling Order of February 16, 2011
 3 (“Feb. 16 Order”) (Dkt. 178).¹

4 **I. INTRODUCTION**

5 Google understands that motions for reconsideration are disfavored and do not make the
 6 present motion for purposes of delay, but request reconsideration of a few items from the Court’s
 7 Feb. 16 Order. Google’s request is based upon intervening legal authority (*In re Katz*, 2011 WL
 8 607381 (Fed. Cir. Feb. 18, 2011)) and to prevent a manifest error that would result in the denial
 9 of Defendants’ due process rights.

10 The Feb. 16 Order limits the parties to a total of 20 claim terms (10 terms per track), from
 11 all four patents-in-suit, to be presented for construction, while allowing the Plaintiff to pursue an
 12 unlimited number of claims. (Dkt. 178 at 3:10-17). As clarified by the Federal Circuit decision
 13 in *Katz*, a patent litigant’s due process rights are implicated to the extent claim selection
 14 mechanisms may force the litigant to abandon legitimate claims (or defenses). Thus, the
 15 limitation on the number of claim terms that Defendants may dispute, particularly without any
 16 limitation on the number of claims Plaintiff may assert, implicates Google’s due process rights
 17 because it may force Google to abandon legitimate defenses, and subject Google to claims for
 18 infringement of claims that are not construed. Google therefore requests that the Court
 19 reconsider and/or clarify its Feb. 16 Order to (a) limit the number of claims Plaintiff may assert²
 20 and (b) remove the cap on the number of potentially disputed claim terms that that parties may
 21 present for construction.

22 As *Katz* makes clear, it is appropriate to limit the number of claims the Plaintiff may
 23 assert and doing so now will narrow the case and help reduce the number of disputed claim
 24 terms. *Katz*, 2011 WL 607381 at *4. It is not appropriate, however, to effectively preclude

25 _____
 26 ¹While Google recognizes that some of the potentially disputed claim terms may be resolved, given the fourteen day
 time limit for seeking reconsideration, Google files the present motion today.

27 ² Interval is currently asserting 67 claims, but has already indicated that once it had Defendants’ invalidity and non-
 infringement contentions it would be able to narrow the number of asserted claims. See Supplemental Joint Status
 Report Dkt. 167 at 22:8-10).

1 Defendants from raising legitimate defenses to the asserted claims by limiting the number of
2 terms the Court will construe. *Id.* at *4 & n. 9; see also *02 Micro Int'l Ltd v. Beyond Innovation*
3 *Tech, Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008) (“When the parties present a fundamental
4 dispute regarding the scope of a claim term, it is the court’s duty to resolve it.”). The
5 combination of no limit on the number of claims the Plaintiff may assert with a limit of 10 terms
6 per track that parties may present for claim construction presents the very real possibility that
7 Google will be denied the opportunity to present invalidity and non-infringement defenses that
8 depend, at least in part, on claim construction.

9 **II. ARGUMENT**

10 The claim construction limitation in the Court’s Scheduling Order will unavoidably force
11 Google to risk a trial for infringement of claims that have not been construed, in violation of the
12 principle that claim construction is a necessary first step in an infringement analysis. More
13 immediately, the limitation will prejudice Google’s ability to present certain legitimate § 112
14 invalidity defenses (as well as other invalidity or non-infringement defenses), because those
15 defenses inherently require construction of terms in the relevant claims.

16 The Federal Circuit has recently clarified the due process analysis as it applies to limiting
17 a party’s ability to contest claims as part of case management. In *Katz*, the patentee argued that
18 the District Court’s refusal to permit the assertion of claims beyond a certain total number was a
19 violation of its due process rights. *Katz*, 2011 WL 607381 at *2. The Federal Circuit affirmed
20 the limitation on the number of asserted claims, but explained that a patent litigant can be
21 improperly deprived of due process when a Court’s claim selection limitation prevents the
22 litigant from contesting claims that present “unique issues as to liability or damages.” *Id.* at *4.
23 While the Federal Circuit was addressing a patentee’s due process rights, the reasoning is even
24 more applicable to a defendant who has not had the benefit of choosing what claims will be
25 asserted against it or the pre-filing investigation of the claims. Thus, the due process concerns
26 considered in *Katz* are even more acute here because the limit on the number of terms to be
27 construed at this early stage of the litigation, particularly with no limit on the number of asserted

1 claims, will deprive Defendants of the ability to present legitimate defenses to the extent they
 2 depend on claim construction. *Id.* at *4 & n.9. Moreover, these limits disproportionately harm
 3 Defendants insofar as Plaintiff remains free to assert the claims without meaningful limitations
 4 on what the terms mean or whether they are supported by the patents' disclosure.

5 While Google understands that the potentially disputed claim terms are to be exchanged
 6 and potentially narrowed through the meet and confer process, and thus the parties have not
 7 determined exactly what will be in dispute, Google's preliminary identification of potentially
 8 disputed claim terms below demonstrates that a limit of 10 terms per track, particularly with no
 9 limit on the number of asserted claims, will deprive Defendants of the due process rights. For
 10 example, Defendants' invalidity contentions, served on February 28, 2011 (submitted herewith
 11 without claim charts as **Exhibits A and B to the Jost Declaration**) include § 112 defenses for a
 12 number of claims of each of the patents-in-suit, particularly since many of the claim limitations
 13 are hopelessly vague and indefinite, lack any support in the specifications and/or are means-plus-
 14 function terms that have no supporting structure disclosed. These § 112 defense inherently and
 15 inescapably involve claim construction.

16 For example, in the '507 patent, based upon Plaintiff's infringement contentions,
 17 Defendants' invalidity contentions and even just Google's non-infringement contentions, it
 18 appears that there may be as many as seventeen terms that are subject to a dispute over the
 19 meaning of the claim term/phrase. Specifically, the following terms (or portions thereof) may be
 20 in dispute:

- 21 • "a body of information"
- 22 • "segment"
- 23 • "each segment representing a defined set
of information in the body of
information"
- 24 • "acquiring data representing the body of
information"
- 25 • "generating a display of a first segment
of the body of information"
- 26 • "comparing data representing a segment
of the body of information to data
representing a different segment of the
body of information"
- 27 • "predetermined criteria"
- "generating a display of a portion of, or
a representation of, a second segment of
the body of information"
- "the display of the portion or
representation of the second segment is
generated in response to the display of a
first segment"
- "a first segment to which the second
segment is related"
- "determining the similarity of the subject
matter content of a segment to the
subject matter content of a different
segment"

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- 1 • “subject matter category/subject matter categories”
- 2 • “relevance feedback method”
- 3 • “a computer readable medium encoded with one or more computer programs”
- “substantially coextensive in time”
- “[predefined] degree of similarity” and
- “identifying one or more of the previously categorized segments as relevant to the uncategorized segment.”

4 Similarly for the ‘682 patent, there may be as many as eleven terms in dispute, without
 5 counting the several means-plus-function terms that either lack support in the specification
 6 and/or need to have the function and structure construed. Specifically, the following terms (or
 7 portions thereof) may be in dispute:

- 8 • “an indication that an item . . . is of current interest”
- 9 • “real time”
- 10 • “process the indication”
- 11 • “determine an intensity value to be associated with the indication”
- 12 • “determine . . . an intensity weight value”
- 13 • “adjusting the intensity value”
- 14 • “based on a characteristic for the item provided by the source”
- “inform the participant that the item is of current interest”
- “processing the indication comprises determining the intensity value for the indication . . . the intensity value representing the weight that will be given to the indication”
- “calculating an intensity rank for the item . . . the intensity rank indicating the level of current interest of the item relative to other items” and
- “attribute of the indication.

15 The means-plus-function terms in the ‘682 patent also present somewhat unique issues insofar as
 16 they are “computer-implemented” and thus require a disclosure of a supporting algorithm or
 17 other specific description of the “steps and operations” of used by any software that to perform
 18 the recited function (not merely a repetition of the function); otherwise the claims, as asserted by
 19 Defendants in this case, are invalid as indefinite. See e.g., *Aristocrat Techs. Austl. Pty Ltd. v.*
 20 *Int’l Game Tech.*, 521 F.3d 1328, 1333-35 (Fed. Cir. 2008); see also Ex. A (Defs.’ Invalidation
 21 Contentions for the ‘507 and ‘682 Patents) at 39-40. There are approximately five such means-
 22 plus-function terms in the asserted claims of the ‘682 patent. Assessing whether there is any
 23 structure supporting these terms, and what that structure might be, is necessarily bound up with
 24 claim construction.

25 Similarly, for the ‘652 and ‘314 patents, there may be as many as fifteen terms in dispute,
 26 without counting the several means-plus-function terms that either lack support in the
 27

1 specification and/or need to have the function and structure construed. Specifically, the
 2 following terms (or portions thereof) may be in dispute:

- | | |
|--|--|
| <ul style="list-style-type: none"> 3 • “peripheral attention [of a user]” 4 • “attention manager/during operation of an attention manager” 5 • “establish(es) a link” 6 • “set of content data” 7 • “selectively displaying” 8 • “in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus” 9 • “control option(s)” 10 • “temporal constraints on the display” 11 • “scheduling/scheduling instructions” | <ul style="list-style-type: none"> • “[audit instructions for monitoring /auditing the] usage of the content display system to selectively display an image or images generated from a set of content data” • “without the content data being aggregated” • “content providing system” • “acquire/acquiring a set of content data” • “image or images generated from a set of content data” and • “providing a set of content data.” |
|--|--|

12 There are approximately twenty means-plus-function terms in the asserted claims, many of
 13 which are not supported by an adequate disclosure. See Ex. B (Defs.’ Invalidation Contentions for
 14 the ’652 and ’314 Patents) at 13-16; 28-30. Assessing whether there is any structure supporting
 15 these terms, and what that structure might be, is necessarily bound up with claim construction.

16 Although the number of disputed terms may be narrowed as the process proceeds, it is
 17 clear that the present limit of 10 terms per track would deprive Defendants of their due process
 18 rights because it may prematurely impair Defendants ability to present legitimate defenses.

19 Availability of Additional Markman Proceedings

20 According to Local Patent Rule 132(c), “The Court will construe a maximum of ten
 21 claim terms at the *initial* Markman hearing, unless the Court determines otherwise. Prioritization
 22 should be guided by the twin goals of narrowing the issues and choosing the ten claim terms for
 23 which claim construction would be most productive in terms of setting the groundwork for
 24 possible settlement” (emphasis added). This rule, along with LPR 135, implies that the Court
 25 may conduct serial Markman hearings to address an aggregate total of more than 10 claim terms.
 26 In contrast, the Feb. 16 Order appears to limit each track to 10 claim terms total. Thus, in the
 27 alternative to the relief requested above, Google requests clarification that, to the extent there are
 more than 10 terms in dispute, the Court permit the parties to present additional terms for claim
 construction and that the limits not be applied to prevent the Defendants from arguing that

1 certain claims are invalid under Section 112 because the terms are indefinite, lack a written
2 description or are not enabled.

3 **III. CONCLUSION**

4 For the foregoing reasons, Google seeks partial reconsideration of the Scheduling Order
5 to (a) limit the number of claims Plaintiff may assert and (b) remove the cap on the number of
6 potentially disputed claim terms that that parties may present for construction; or in the
7 alternative for clarification that the Scheduling Order does not preclude additional Markman
8 proceedings, if necessary, or prevent the Defendants from arguing that certain claims are invalid
9 under Section 112, whether construed as part of the original Markman hearing or not.

10 DATED this 2nd day of March, 2011.

11 STOKES LAWRENCE, P.S.

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CERTIFICATE OF SERVICE

I hereby certify that on March 2, 2011, I caused the foregoing Motion for Reconsideration and Clarification of Court's February 16, 2011, Scheduling Order, by Defendants Google Inc. and YouTube, LLC to be:

electronically filed with the Clerk of the Court using the CM/ECF system which will send notification of such filing to the following:

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