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11 Attorneys for Defendants
GOOGLE INC. and AOL INC.

12 UNITED STATES DISTRICT COURT
13 NORTHERN DISTRICT OF CALIFORNIA
14 SAN JOSE DIVISION

15
16 Case No. CV 08-03172 RMW

17 **IN RE GOOGLE LITIGATION**

**ANSWER AND COUNTERCLAIMS OF
GOOGLE INC. TO SOFTWARE
RIGHTS ARCHIVE LLC'S AMENDED
COMPLAINT**

1 Defendant Google Inc. (“Google”), by and through its attorneys, hereby answers the
2 Amended Complaint of Plaintiff Software Rights Archive, LLC (“SRA”). The headings and
3 numbered paragraphs below correspond to those in SRA’s Amended Complaint (Dkt. #309)
4 (“Amended Complaint”). Except as expressly admitted below, Google denies the allegations and
5 characterizations in SRA’s Amended Complaint.

6 **THE PARTIES**

7 1. Google is without knowledge or information sufficient to form a belief as to the
8 truth of the allegations of paragraph 1 of the Amended Complaint and, on that basis, denies all
9 such allegations.

10 2. Google admits that it is a Delaware corporation with its principal place of business
11 at 1600 Amphitheatre Parkway, Mountain View, CA 94043.

12 3. Google is without knowledge or information sufficient to form a belief as to the
13 truth of the allegations of paragraph 3 of the Amended Complaint and, on that basis, denies all
14 such allegations.

15 4. Google is without knowledge or information sufficient to form a belief as to the
16 truth of the allegations of paragraph 4 of the Amended Complaint and, on that basis, denies all
17 such allegations.

18 5. Google is without knowledge or information sufficient to form a belief as to the
19 truth of the allegations of paragraph 5 of the Amended Complaint and, on that basis, denies all
20 such allegations.

21 **JURISDICTION AND VENUE**

22 6. Google admits that SRA’s claims purport to arise under the United States Patent
23 Act, codified at 35 U.S.C. § 1 *et seq.*, but denies that such claims have merit. Google admits that,
24 for purposes of this action, this Court has subject matter jurisdiction over this action under 28
25 U.S.C. §§ 1331 and 1338(a).

26 7. Google admits that it engages in business activities in this District. Google
27 specifically denies that it has committed any acts of infringement in this or any other District.
28 Google admits that, for purposes of this action, this Court has personal jurisdiction over Google.

1 Google is otherwise without knowledge or information sufficient to form a belief as to the truth of
2 the remaining allegations of paragraph 7 and, on that basis, denies those allegations.

3 8. Google admits that it engages in business activities in this District. Google
4 specifically denies that it has committed any acts of infringement in this or any other District.
5 Google admits that, for purposes of this action, venue is proper in this District, and that the Court
6 in the Eastern District of Texas transferred the case to this District because venue was “clearly
7 more convenient” in this District. Google is otherwise without knowledge or information
8 sufficient to form a belief as to the truth of the remaining allegations of paragraph 8 and, on that
9 basis, denies those allegations.

10 **THE ‘352 PATENT**

11 9. Google admits that U.S. Patent No. 5,544,352 (“the ‘352 patent”) lists an issue date
12 of August 6, 1996. Google further admits that the ‘352 patent is entitled “Method and Apparatus
13 for Indexing, Searching and Displaying Data.” Google further admits that the face of the ‘352
14 patent identifies Daniel Egger as the inventor and Libertech, Inc. as assignee. Google further
15 admits that the ‘352 patent is attached to the Amended Complaint as Exhibit A. Google denies that
16 the ‘352 patent was lawfully issued. Google is otherwise without knowledge or information
17 sufficient to form a belief as to the truth of the remaining allegations of paragraph 9 and, on that
18 basis, denies those allegations.

19 10. Google denies the allegations of paragraph 10 to the extent such allegations are
20 directed towards Google. Google is otherwise without knowledge or information sufficient to form
21 a belief as to the truth of the remaining allegations of paragraph 10 and, on that basis, denies those
22 allegations.

23 11. Google denies the allegations of paragraph 11 to the extent such allegations are
24 directed towards Google. Google is otherwise without knowledge or information sufficient to form
25 a belief as to the truth of the remaining allegations of paragraph 11 and, on that basis, denies those
26 allegations.

27 12. Google denies the allegations of paragraph 12 to the extent such allegations are
28 directed towards Google. Google is otherwise without knowledge or information sufficient to form

1 a belief as to the truth of the remaining allegations of paragraph 12 and, on that basis, denies those
2 allegations.

3 13. Google denies the allegations of paragraph 13 to the extent such allegations are
4 directed towards Google. Google is otherwise without knowledge or information sufficient to form
5 a belief as to the truth of the remaining allegations of paragraph 13 and, on that basis, denies those
6 allegations.

7 **THE '494 PATENT**

8 14. Google admits that U.S. Patent No. 5,832,494 (“the ‘494 patent”) lists an issue date
9 of Nov. 3, 1998. Google further admits that the ‘494 patent is entitled “Method and Apparatus for
10 Indexing, Searching and Displaying Data.” Google further admits that the face of the ‘494 patent
11 identifies Daniel Egger, Shawn Cannon, and Ronald D. Sauers as inventors and Libertech, Inc. as
12 assignee. Google further admits that the ‘494 patent is attached to the Amended Complaint as
13 Exhibit B. Google denies that the ‘494 patent was lawfully issued. Google is otherwise without
14 knowledge or information sufficient to form a belief as to the truth of the remaining allegations of
15 paragraph 14 and, on that basis, denies those allegations.

16 15. Google denies the allegations of paragraph 15 to the extent such allegations are
17 directed towards Google. Google is otherwise without knowledge or information sufficient to form
18 a belief as to the truth of the remaining allegations of paragraph 15 and, on that basis, denies those
19 allegations.

20 16. Google denies the allegations of paragraph 16 to the extent such allegations are
21 directed towards Google. Google is otherwise without knowledge or information sufficient to form
22 a belief as to the truth of the remaining allegations of paragraph 16 and, on that basis, denies those
23 allegations.

24 17. Google denies the allegations of paragraph 17 to the extent such allegations are
25 directed towards Google. Google is otherwise without knowledge or information sufficient to form
26 a belief as to the truth of the remaining allegations of paragraph 17 and, on that basis, denies those
27 allegations.

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1 18. Google denies the allegations of paragraph 18 to the extent such allegations are
2 directed towards Google. Google is otherwise without knowledge or information sufficient to form
3 a belief as to the truth of the remaining allegations of paragraph 18 and, on that basis, denies those
4 allegations.

5 **THE '571 PATENT**

6 19. Google admits that U.S. Patent No. 6,233,571 (“the ‘571 patent”) lists an issue date
7 of May 15, 2001. Google further admits that the ‘571 patent is entitled “Method and Apparatus for
8 Indexing, Searching and Displaying Data.” Google further admits that the face of the ‘571 patent
9 identifies Daniel Egger, Shawn Cannon, and Ronald D. Sauers as co-inventors. Google further
10 admits that the ‘571 patent is attached to the Amended Complaint as Exhibit C. Google denies that
11 the ‘571 patent was lawfully issued. Google is otherwise without knowledge or information
12 sufficient to form a belief as to the truth of the remaining allegations of paragraph 19 and, on that
13 basis, denies those allegations.

14 20. Google denies the allegations of paragraph 20 to the extent such allegations are
15 directed towards Google. Google is otherwise without knowledge or information sufficient to form
16 a belief as to the truth of the remaining allegations of paragraph 20 and, on that basis, denies those
17 allegations.

18 21. Google denies the allegations of paragraph 21 to the extent such allegations are
19 directed towards Google. Google is otherwise without knowledge or information sufficient to form
20 a belief as to the truth of the remaining allegations of paragraph 21 and, on that basis, denies those
21 allegations.

22 22. Google denies the allegations of paragraph 22 to the extent such allegations are
23 directed towards Google. Google is otherwise without knowledge or information sufficient to form
24 a belief as to the truth of the remaining allegations of paragraph 22 and, on that basis, denies those
25 allegations.

26 23. Google denies the allegations of paragraph 23 to the extent such allegations are
27 directed towards Google. Google is otherwise without knowledge or information sufficient to form
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1 a belief as to the truth of the remaining allegations of paragraph 23 and, on that basis, denies those
2 allegations.

3 **JURY DEMAND**

4 24. Google admits that the Amended Complaint sets forth a demand for trial by jury in
5 paragraph 24. Paragraph 24 does not require an additional answer.

6 **PRAYER FOR RELIEF**

7 Google denies the allegations of SRA's Prayer for Relief against Google and denies that
8 SRA is entitled to any relief whatsoever.

9 To the extent that any allegations of the Amended Complaint have not been previously
10 specifically admitted or denied, Google denies them.

11 **AFFIRMATIVE DEFENSES**

12 Google asserts the following affirmative defenses in response to SRA's Amended
13 Complaint. Google reserves the right to allege additional affirmative defenses as they become
14 known throughout the course of discovery.

15 **FIRST AFFIRMATIVE DEFENSE**

16 25. Google has not infringed, willfully or otherwise, and does not currently infringe
17 (either directly, contributorily, or by inducement) any valid claim of the '352, '494, or '571
18 patents.

19 **SECOND AFFIRMATIVE DEFENSE**

20 26. The claims of the '352, '494, and '571 patents are invalid because they fail to
21 satisfy one or more conditions for patentability set forth in 35 U.S.C. § 101 *et seq.*, including,
22 without limitation, Sections 101, 102, 103, and 112.

23 **THIRD AFFIRMATIVE DEFENSE**

24 27. SRA's claims are barred, in whole or in part, by the equitable doctrines of laches,
25 unclean hands, estoppel, and/or waiver.

1 **FOURTH AFFIRMATIVE DEFENSE**

2 28. SRA's claims are barred by the doctrine of prosecution history estoppel based on
3 statements, representations, and admissions made during prosecution of the patent applications
4 resulting in the '352, '494, and '571 patents and in related patent applications.

5 **FIFTH AFFIRMATIVE DEFENSE**

6 29. SRA's claims for damages are statutorily limited by 35 U.S.C. §§ 286 and/or 287.

7 **SIXTH AFFIRMATIVE DEFENSE**

8 30. Google reserves all affirmative defenses under Rule 8(c) of the Federal Rules of
9 Civil Procedure, the Patent Laws of the United States, and any other defenses at law or in equity
10 that may exist now or that may be available in the future based on discovery and further factual
11 investigation in this action.

12 **SEVENTH AFFIRMATIVE DEFENSE**

13 31. On information and belief, the '494 patent is unenforceable due to inequitable
14 conduct during the prosecution of the application that led to its issuance. On information and
15 belief, those with a duty of candor and good faith as required by 37 C.F.R § 1.56, in breach of that
16 duty and with the intent to deceive the PTO, did not disclose to the PTO all information known to
17 be material to patentability during the prosecution of the '494 patent.

18 32. Those with a duty of candor and good faith knew of but failed to disclose PCT
19 Publication No. WO 95/00896 ("the '896 Publication") (attached as Exhibit A). Specifically,
20 Daniel Egger, an inventor listed on the face of the '494 patent and Aldo Noto, an attorney who
21 prosecuted the '494 patent, are listed on the face of the '896 Publication. Thus, Mr. Egger and Mr.
22 Noto and/or their agents knew of the '896 Publication as early as January 5, 1995, the date that the
23 '896 Publication was published. The '896 Publication is based on and nearly identical to the
24 application which led to the issuance of the '352 patent.

25 33. The '494 patent is a continuation-in-part of U.S. Patent Application No. 76,658,
26 which issued as the '352 patent. The '352 patent is also the parent of the PCT application which
27 was published as the '896 Publication.
28

1 34. During the prosecution of the '494 patent, the examiner concluded that the
2 allowed claims were not entitled to the priority date of the '352 patent application:

3 "3. A word search of the parent, USP 5,544,352, reveals that the words link(s) and
4 node(s) do not appear, and the term cluster appears once in passing. therefore this
5 group of claims is considered to have 5/17/96 as their priority date for purposes of
6 examination in terms of prior art." (Exhibit B, '494 Prosecution History, Notice of
7 Allowability at 3.)

8 35. Although put on notice that the claims of the '494 patent are not entitled to an
9 earlier priority date, Mr. Noto filed an Amendment After Notice of Allowance on behalf of the
10 applicants, disputing the examiner's conclusion:

11 "Applicants disagree with the statement at page 3, paragraph 3 of the Notice of
12 Allowance regarding the priority date for the claims under this Continuation-In-
13 Part application. In particular, Applicants believe that many of the claim features
14 are supported in the original disclosure. (Exhibit C, '494 Prosecution History,
15 Amendment After Allowance, at 12.)

16 36. Despite being on notice that the priority date of the allowed claims was May 17,
17 1996, the applicants failed to disclose the '896 Publication, dated January 5, 1995, which shares
18 a nearly identical disclosure as the '352 patent, to which the applicant attempted to claim priority.

19 37. By insisting that the claim features of the continuation-in-part application are
20 supported in the original disclosure, the applicants conceded that it necessarily considered the
21 PCT publication, with its nearly identical disclosure to the original application to be highly
22 material. An inference of an intent to deceive is demonstrated at least by the fact that the
23 applicants withheld a highly material document authored by one of the named inventors and
24 handled by the prosecuting attorney of the '494 patent.

25 38. The Abstract of the '896 Publication states:

26 "A computer research tool (26) for indexing, searching and displaying data is
27 disclosed. Textual objects and other data in a database (54) are indexed by creating
28 a numerical representation of the data. An indexing technique called proximity
indexing indexes the data by using statistical techniques and empirically developed
algorithms. Using proximity indexing, an efficient search for pools of data can be
effectuated. The Computer Search program called the Computer Search Program
for Data represented in Matrices (CSPDM), provides efficient computer search
methods. The CSPDM rank orders data in accordance with the data's relationship to
time, a paradigm datum, or any similar reference. The user interface program,
called the Graphical User Interface (GUI), provides a user friendly method of
interacting with the CSPDM program and prepares and presents a visual graphical
display. The graphical display provides the user with a two dimensional spatial
orientation of the data."

1 39. The Abstract of the ‘494 patent states, in part: “[a] computer research tool for
2 indexing, searching, and displaying data is disclosed.”

3 40. Thus, the ‘896 Publication is material to the patentability of the ‘494 patent.

4 41. Because the ‘896 Publication was published more than one year to the filing of the
5 application that led to the ‘494 patent, the ‘896 Publication is prior art to the ‘494 patent.

6 42. Accordingly, Google is informed and believes, and therefore alleges that the failure
7 of those with a duty of candor and good faith as required by 37 C.F.R. § 1.56 to disclose known
8 material prior art to the PTO during the prosecution of the ‘494 patent, with the intent to deceive
9 the PTO, renders it unenforceable.

10 43. Also, on information and belief, the ‘571 patent is unenforceable due to inequitable
11 conduct during the prosecution of the application that led to its issuance. On information and
12 belief, those with a duty of candor and good faith as required by 37 C.F.R § 1.56, in breach of that
13 duty and with the intent to deceive the PTO, did not disclose to the PTO all information known to
14 be material to the patentability during the prosecution of the ‘571 patent.

15 44. Those with a duty of candor and good faith knew of but failed to disclose PCT
16 Publication No. WO 95/00896 (“the ‘896 Publication”) (attached as Exhibit A). Specifically,
17 Daniel Egger, an inventor listed on the face of the ‘571 patent, is listed as the inventor on the face
18 of the ‘896 Publication. Thus, Mr. Egger and/or his agents knew of the ‘896 Publication as early
19 as January 5, 1995, the date that ‘896 Publication was published.

20 45. The ‘571 patent is a divisional of the continuation-in-part application that issued as
21 the ‘494 patent. Thus, it shares effectively the same disclosure as the ‘494 patent.

22 46. During the prosecution of the ‘571 patent, the examiner concluded that the claims
23 of the ‘571 patent were not entitled to the priority date of the continuation-in-part parent
24 application:

25 “It is also noted that the application of which the parent of this case is a CIP, has no
26 apparent support for hyperjumps to a Web page, and so its priority date is moot.”
27 (Exhibit D, ‘571 Prosecution History, July 19, 2000, Final Office Action, at 3.)
28

1 47. The applicants did not challenge the examiner’s observation about the priority of
2 the ‘571 patent and therefore implicitly conceded that the claims of the ‘571 patent are not entitled
3 to the priority of the continuation-in-part parent.

4 48. Despite being on notice that the claims of the ‘571 patent were not entitled to the
5 priority of the ‘494 patent or the ‘352 patent, the applicants withheld the ‘896 Publication, dated
6 January 5, 1995.

7 49. The Abstract of the ‘896 Publication states:

8 “A computer research tool (26) for indexing, searching and displaying data is
9 disclosed. Textual objects and other data in a database (54) are indexed by creating
10 a numerical representation of the data. An indexing technique called proximity
11 indexing indexes the data by using statistical techniques and empirically developed
12 algorithms. Using proximity indexing, an efficient search for pools of data can be
13 effectuated. The Computer Search program called the Computer Search Program
14 for Data represented in Matrices (CSPDM), provides efficient computer search
15 methods. The CSPDM rank orders data in accordance with the data's relationship to
16 time, a paradigm datum, or any similar reference. The user interface program,
17 called the Graphical User Interface (GUI), provides a user friendly method of
18 interacting with the CSPDM program and prepares and presents a visual graphical
19 display. The graphical display provides the user with a two dimensional spatial
20 orientation of the data.”

21 50. The Abstract of the ‘571 patent states, in part: “[a] computer research tool for
22 indexing, searching, and displaying data is disclosed.”

23 51. Thus, the ‘896 Publication is material to the patentability of the ‘571 patent.

24 52. Because the ‘896 Publication was published more than one year to the filing of the
25 application that led to the ‘571 patent, the ‘896 Publication is prior art to the ‘571 patent.

26 53. Accordingly, Google is informed and believes, and therefore alleges that the failure
27 of those with a duty of candor and good faith as required by 37 C.F.R. § 1.56 to disclose known
28 material prior art to the PTO during the prosecution of the ‘571 patent, with the intent to deceive
the PTO, renders it unenforceable.

GOOGLE’S COUNTERCLAIMS FOR DECLARATORY RELIEF

Google, for its counterclaims against Plaintiff SRA, states and alleges as follows:

NATURE OF THE ACTION

54. This counterclaim seeks declaratory judgments of noninfringement and invalidity
of the ‘352, ‘494, and ‘571 patents asserted by SRA in this action. Google seeks judgment under

1 the patent laws of the United States, 35 U.S.C. § 101 *et seq.*, and the Declaratory Judgment Act,
2 28 U.S.C. §§ 2201, 2202.

3 **PARTIES**

4 55. Google is a Delaware corporation with a principal place of business at 1600
5 Amphitheatre Parkway, Mountain View, CA 94043.

6 56. On information and belief based on paragraph 1 of the Amended Complaint, SRA
7 is a limited liability company organized and existing under the laws of Delaware.

8 **JURISDICTION AND VENUE**

9 57. This Court has subject matter jurisdiction over these counterclaims pursuant to 28
10 U.S.C. §§ 1331, 1338, the patent laws of the United States, 35 U.S.C. §§ 101 *et seq.*, and the
11 Declaratory Judgment Act, 28 U.S.C. §§ 2201, 2202.

12 58. Plaintiff SRA has consented to the personal jurisdiction of this Court by filing its
13 action for patent infringement in this judicial district, as set forth in its Amended Complaint.

14 59. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391(b), (c), and 1400(b).

15 60. The ‘352 patent was issued by the United States Patent and Trademark Office on
16 August 6, 1996. Plaintiff SRA, based on averments in its Amended Complaint, claims to be the
17 assignee of the ‘352 patent and claims to hold the right to sue and recover for past, present, and
18 future infringement thereof. Plaintiff SRA also claims that Google has infringed the ‘352 patent.

19 61. The ‘494 patent was issued by the United States Patent and Trademark Office on
20 November 3, 1998. Plaintiff SRA, based on averments in its Amended Complaint, claims to be the
21 assignee of the ‘494 patent and claims to hold the right to sue and recover for past, present, and
22 future infringement thereof. Plaintiff SRA also claims that Google has infringed the ‘494 patent.

23 62. The ‘571 patent was issued by the United States Patent and Trademark Office on
24 May 15, 2001. Plaintiff SRA, based on averments in its Amended Complaint, claims to be the
25 assignee of the ‘571 patent and claims to hold the right to sue and recover for past, present, and
26 future infringement thereof. Plaintiff SRA also claims that Google has infringed the ‘571 patent.

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DATED: February 11, 2011

Respectfully submitted,

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