

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

**BRIEF IN SUPPORT OF GOOGLE'S MOTION TO COMPEL PLAINTIFF TO
PROVIDE CONCEPTION, REDUCTION-TO-PRACTICE, AND PRIORITY DATE
INFORMATION FOR THE PATENTS-IN-SUIT**

I. INTRODUCTION

Pursuant to Federal Rule of Civil Procedure 37, Defendant Google Inc. ("Google") moves to compel Plaintiff I/P Engine, Inc. ("Plaintiff") to provide complete responses to Google's Interrogatories seeking routine information regarding the patents-in-suit, including definite priority dates, conception dates, and reduction-to-practice dates. Plaintiff has repeatedly refused to provide a direct answer to these straightforward Interrogatories. As to the patents' priority date – the date used to establish the novelty of the patented inventions relative to other art – Plaintiff stated that "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." (emphasis added). But Plaintiff refused to state whether it would rely on an earlier priority date, and in fact leaves open the possibility that it will do so. As to the conception and reduction-to-practice dates

– the dates the patented inventions were firmly conceived in the inventors’ minds and embodied in workable form, respectively – Plaintiff has refused to provide *any* of this information.

Plaintiff has never denied that it has the *ability* to provide the requested conception, reduction-to-practice, and priority date information to Google. Nor could it. Both named inventors are Plaintiff’s employees or consultants. And Plaintiff has long had custody of at least one inventor’s documents. Thus, Plaintiff has ample means to determine the patents’ priority date, conception date, reduction-to-practice date, and the individuals involved in conception and reduction to practice. Plaintiff just refuses to provide this information to Google. As to the requested conception and reduction-to-practice information, Plaintiff has stated that it will identify documents containing this information after reviewing the document production of third-party Lycos, Inc. This is flatly improper, as Plaintiff’s relationship with the inventors and custody of their documents allows Plaintiff to provide the requested information without the need for third-party input. Moreover, Plaintiff must provide a direct written response to this Interrogatory rather than merely identifying documents, since documents themselves would not disclose any definitive conception and reduction-to-practice date, or what Plaintiff contends those dates are.

There can be no legitimate dispute that Google’s requested information is relevant. It is routine for patent defendants to seek information on the conception, reduction-to-practice, and priority date of the patents-in-suit, and a defendant’s ability to present its case is greatly impaired if the plaintiff refuses to provide this information. For instance, Google cannot focus its prior art search on references that pre-date the patents’ priority date without knowing what priority date Plaintiff believes the patents are entitled to. Similarly, Plaintiff’s refusal to provide this information prevents Google from knowing what topics to explore in future discovery. For

instance, if Plaintiff asserts a conception or priority date that is the same as the filing date of the patent applications, then Google need not explore whether the inventors were diligent in reducing the invention to practice after they conceived it. By contrast, if Plaintiff asserts conception and priority dates that are significantly earlier than the filing date of the patent applications, then the inventors' diligence in reducing the invention to practice could be a critical issue in this case. By refusing to provide conception, reduction-to-practice, and priority dates, Plaintiff frustrates Google's ability to determine the key issues in this case. By the same token, Plaintiff's refusal to list the individuals who were involved in conception and reduction-to-practice makes it impossible for Google to determine who must be deposed on these topics.

For all these reasons, Google respectfully requests that the Court compel Plaintiff to provide the patents' priority dates, conception dates, reduction-to-practice dates, and the names of the individuals involved in conception and reduction-to-practice.

II. FACTUAL BACKGROUND

A. Google Seeks on Information on Conception, Reduction-to-Practice, and Priority Dates; Plaintiff Refuses to Provide This Information

On November 7, 2011, Google served Interrogatory No. 1 on Plaintiff. This Interrogatory reads as follows:

For each asserted claim of the PATENTS-IN-SUIT, describe in detail all facts RELATING TO its conception and reduction to practice, including but not limited to: IDENTIFYING the date of conception, the date of reduction to practice of its subject matter, all acts YOU contend represent diligence occurring between the dates of conception and reduction to practice, each person involved in such conception, diligence and/or reduction to practice, where the invention was first reduced to practice, when, where, and to whom the invention was first disclosed, and IDENTIFYING each person, including third parties, who worked on the development of the alleged invention(s) described and claimed in the PATENTS-IN-SUIT, describing each person's role (e.g., producer, developer, tester, technician, researcher, etc.), the dates and places each such person assisted, supervised, or was otherwise so involved, and the identity of all documents evidencing conception, diligence and reduction to practice.

(Kammerud Decl., Ex. A at 5).

On December 7, 2011, Plaintiff responded to Interrogatory No. 1. Plaintiff's response, however, contained no substantive information. Rather, Plaintiff stated: "I/P Engine, under Rule 33(d) of the Federal Rules of Civil Procedure, will produce documents from which information responsive to this Interrogatory may be derived or ascertained." (*Id.* at 5-6). From the time of Plaintiff's response until the present day, Plaintiff has not identified any documents that supposedly contain information responsive to Interrogatory No. 1.

Also on November 7, 2011, Google served Interrogatory No. 9 on Plaintiff. This Interrogatory asked: "For each of the PATENTS-IN-SUIT state the priority date PLAINTIFF claims for each claim and identify the portion(s) of the specification in any earlier application that support that priority date." (*Id.* at 14). Plaintiff responded on December 7, 2011, stating:

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 (based on the filing date of the patent application, U.S. Patent Application No. 09/204,149, that issued as the '420 patent). Additionally, 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.

(*Id.* (emphasis added).) Plaintiff has never supplemented its response to confirm the December 3, 1998 priority date or to provide an earlier date. Plaintiff's response that the priority date is "at least as early as" December 3, 1998 does not provide a definite priority date because it allows the priority date to be *any* date on or before December 3, 1998.

B. Plaintiff's Continued Refusal to Provide This Information Despite Google's Meet-and-Confer Efforts

On December 13, 2011, Google sent a letter pointing out that Plaintiff had failed to provide a substantive response to Interrogatory Nos. 1 or 9. (*Id.*, Ex. B). On December 19, 2011, Plaintiff's counsel responded that "[o]nce defendants make a prima facie showing that a priority date earlier than the date identified in plaintiff's interrogatory response is relevant,

plaintiff will review and supplement as appropriate.” (*Id.*, Ex. C). In response, Google pointed out that numerous courts have rejected the proposition that a patent plaintiff need not provide conception and reduction-to-practice dates until the defendant identifies its alleged prior art, citing a number of supporting cases. (*Id.*, Ex. D). Plaintiff made no response.

On December 22, 2011, the parties met and conferred by telephone regarding Plaintiff’s refusal to provide a substantive response to Interrogatory No. 1 and its refusal to provide a definite priority date in response to Interrogatory No. 9. On this call, Plaintiff stated that it would supplement its response to Interrogatory No. 1 only after it reviewed documents produced by third-party Lycos (in response to a subpoena served by *Google*, not Plaintiff). (*Id.*, ¶ 6). Plaintiff took this position even though both named inventors of the patents-in-suit are *Plaintiff’s* employees or consultants and *Plaintiff* had custody of one if not both inventors’ documents. During this call, Plaintiff also stated that the priority date for the patents-in-suit is December 3, 1998, but that it had not decided whether it would rely on earlier patent applications to pursue an earlier priority date. (*Id.*) In other words, Plaintiff refused to state whether it would contend that the patents-in-suit can claim priority to any pre-December 3, 1998 applications from the same patent family.

In a January 10, 2012 letter, Plaintiff stated that it would supplement its response to Interrogatory No. 9 (seeking the patents’ priority date) “when it deems it is appropriate to do so based on whether I/P Engine plans to use any date earlier than the identified date of December 3, 1998.” (*Id.*, Ex. E at 3). As to Interrogatory No. 1 (seeking the patents’ conception date, reduction-to-practice date, and the individuals involved in conception and reduction-to-practice), Plaintiff reiterated that it would supplement its response by identifying specific documents once it had a chance to review Lycos’ document production. (*Id.*)

In an email of February 8, 2012, Google summarized the parties' respective positions on Interrogatory Nos. 1 and 9, noted that the parties appear to be at an impasse, and made one final request that Plaintiff reconsider its position and provide adequate responses to these Interrogatories. (*Id.*, Ex. F). Plaintiff wrote back the next day, reiterating its prior positions on both Interrogatories. (*Id.*, Ex. G). Accordingly, Google has no choice but to bring the present Motion to Compel.

III. ARGUMENT

A. Plaintiff Must Provide Definite Priority Dates

As recounted above, Plaintiff has refused to provide definite priority dates in response to Google's Interrogatory No. 9. Plaintiff's Interrogatory Response states that "[e]ach 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" (emphasis added), but Plaintiff has never supplemented this response to provide a definite priority date. Moreover, Plaintiff's communications with Google repeatedly stated that Plaintiff might assert an earlier priority date at some undisclosed future time.

It is improper for Plaintiff to provide such an ambiguous priority date. Rather, as numerous courts have recognized, a patent plaintiff must provide a definite and firm priority date so that the defendant can focus its prior art search on references that pre-date that priority date. *See, e.g., McKesson Info. Solutions LLC v. Epic Sys. Corp.*, 242 F.R.D. 689, 692 (N.D. Ga. 2007) ("Because the threshold question of whether the prior art is in fact 'prior' depends upon the '898 patent's priority date, the information Epic seeks [] is unquestionably relevant to a 'claim or defense,' and thus McKesson may not refuse to produce it"); *see also In re Papst Licensing GMBH & Co. KG Litig.*, 252 F.R.D. 7, 17 (D.D.C. 2008) ("Papst's response that conception

happened at an unknown time period between January and October 1996 is clearly overbroad and cannot be sustained . . . Papst’s failure to respond directly and candidly has sent its opponents down a rabbit hole, trying to ascertain prior art.”); *Invacare Corp. v. Sunrise Med. Holdings, Inc.*, No. 04-1439, 2005 WL 1750271, *3-4 (N.D. Ohio Jan. 21, 2005) (“Defendant claims that in order to ascertain the relevant prior art, plaintiff must provide the exact dates of conception and reduction to practice . . . the Court finds that plaintiff must provide a more definite response to defendant’s interrogatory. 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.”)

Plaintiff’s position that it need not provide a priority date until Google makes a prima facie showing of invalidity (Kammerud Decl., Ex. C) puts the cart before the horse. As noted above, a plaintiff must provide a definite and firm priority date precisely so that the defendant may focus its prior art search on references that pre-date the stated priority date. For this reason, courts have soundly rejected the proposition that a defendant must make a prima facie invalidity case before being entitled to the plaintiff’s asserted priority date. *See McKesson*, 242 F.R.D. at 692 (“Epic does not have to establish a prima facie case of invalidity in order to obtain discovery on the ‘898 patent’s priority date”); *Lamoureux v. Genesis Pharm. Serv’s, Inc.*, 226 F.R.D. 154, 157-60 (D. Conn. 2004).

In any event, Google *has* made a prima facie invalidity showing. Specifically, Defendants’ Preliminary Invalidity Contentions (served on January 24, 2012) cite no less than seven prior art references that invalidate the patents-in-suit. (Kammerud Decl., Ex. H). Thus, even under Plaintiff’s own incorrect logic, it is past time for Plaintiff to provide definite priority dates for the patents-in-suit.

For all these reasons, Google respectfully requests that the Court compel Plaintiff to provide definite priority dates for the patents-in-suit. If Plaintiff believes that the patents are entitled to a priority date of December 3, 1998, it should plainly say so – rather than making the ambiguous response that the priority date is “at least as early as” this date. Conversely, if Plaintiff believes that the patents are entitled to a priority date earlier than December 3, 1998, it should provide this earlier date – rather than stating that it might provide an earlier priority date at some future time.

B. Plaintiff Must Provide Conception Dates, Reduction-to-Practice Dates, and the Persons Involved in Conception and Reduction-to-Practice

As recounted above, Plaintiff has also refused to identify conception dates, reduction-to-practice dates, and the individuals involved in conception and reduction-to-practice in response to Google’s Interrogatory No. 1. Plaintiff responded to this Interrogatory by stating that it would produce responsive documents pursuant to Rule 33(d), and Plaintiff later stated that it would “supplement its response with bates range numbers, etc. once it has had a chance to review Lycos’s document production.” (Kammerud Decl., Ex. E at 3). To date, Plaintiff has not supplemented its response to this Interrogatory in any manner whatsoever.

Plaintiff’s position on this Interrogatory is unjustified on numerous levels. First, the documents alone will not provide any clear date of when conception or reduction-to-practice occurred, making Rule 33(d) inapplicable. Nor will documents disclose Plaintiff’s contentions on this subject. Rather, Google can only discern Plaintiff’s contentions about when conception and reduction-to-practice occurred if Plaintiff gives a direct, written Interrogatory response that plainly states this information.

Second, both named inventors are Plaintiff’s employees or consultants, and Plaintiff possesses the documents of at least the first named inventor, Andrew “Ken” Lang. (*Id.*, Ex. I).

As for the other named inventor, Donald Kosak, Plaintiff alleges that Lycos possesses Mr. Kosak's documents – yet Plaintiff also stated that it “recently received Lycos's permission to produce them to Defendants.” (*Id.*, Ex. J). Thus, Plaintiff apparently has sufficient control over Mr. Kosak's documents to produce them to Defendants (even though this production has not yet been made.)

A plaintiff cannot respond to a conception and reduction-to-practice interrogatory by merely producing documents under Rule 33(d) where (as here) the plaintiff's close relationship with the inventors would allow it to provide a direct response. *See, e.g., Fresenius Med. Care Holding Inc. v. Baxter Intern., Inc.*, 224 F.R.D. 644, 650 (N.D. Cal. 2004) (ordering patent-owner to respond to a conception and reduction-to-practice interrogatory “without reference to Rule 33(d),” while crediting the opposing party's argument that “Rule 33(d) procedures are not available to Baxter . . . because Baxter has access to the inventors and can interview them at will.”); *Boston Sci. Corp. v. Micrus Corp.*, No. 04-4072, 2007 WL 174475, *1 (N.D. Cal. Jan. 22, 2007) (rejecting plaintiff's attempt to “point[] to documents and testimony of inventors” in response to an interrogatory seeking patent conception dates.)

Third, it is unjustifiable for Plaintiff to delay its response to Interrogatory No. 1 until it reviews Lycos's document production. While Lycos was a former owner of the patents-in-suit, both named inventors are *Plaintiff's* employees or consultants and *Plaintiff* possesses the documents of named inventor Andrew Lang. Thus, Plaintiff can identify the patents' conception date, reduction-to-practice date, and the individuals involved in conception and reduction-to-practice based on the files and recollections of the inventors themselves. If Plaintiff uncovers additional relevant information after reviewing Lycos' production, then Plaintiff of course has the right (and the duty) to supplement its Interrogatory response. *See Fed. R. Civ. P. 26(e)*. But

Plaintiff cannot delay *any* response until some unspecified future time after it has reviewed Lycos's document production. This case is on a tight discovery schedule, and Google is entitled to a prompt Interrogatory response regarding the patents' conception and reduction-to-practice so that it can properly take depositions or serve document subpoenas on this topic.

In any event, Lycos has produced its documents over a month ago. (Kammerud Decl., Ex. K). Thus, even under Plaintiff's own logic, it is time for Plaintiff to provide Google's requested conception and reduction-to-practice information. For the reasons stated above, Google should not be forced to wait some unspecified time until Plaintiff fully digests Lycos's document production. Rather, Google is entitled to a prompt Interrogatory response, regardless of the speed with which Plaintiff chooses to review Lycos's production.

IV. 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, without resort to the procedures of Rule 33(d).

DATED: February 13, 2012

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CERTIFICATE OF CONSULTATION

In accordance with Local Rule 37(E), I certify that counsel conferred in good faith to resolve the this dispute prior to the filing of the present Motion to Compel. Counsel's meet-and-confer efforts are set forth in Section II(B) of Google's brief, and included a telephonic meet-and-confer on December 22, 2011.

/s/ David A. Perlson
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CERTIFICATE OF SERVICE

I hereby certify that on February 13, 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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