

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF KENTUCKY
CENTRAL DIVISION
AT LEXINGTON

ELECTRONICALLY FILED

iLOR, LLC,

Plaintiff,

v.

GOOGLE INC.,

Defendant.

Civil Action No. 5:07-cv-00109-JMH

**DEFENDANT GOOGLE INC.'S REPLY MEMORANDUM IN SUPPORT OF ITS
CROSS-MOTION FOR SUMMARY JUDGMENT OF NO INFRINGEMENT**

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I. INTRODUCTION

iLOR clearly emphasized the automatic pop-up feature to get its patent, but now ignores or runs away from those statements to try to expand its rights beyond those granted. The law does not allow this. iLOR simply cannot ignore the language of claim 26 and the concessions it made to get that claim. The intrinsic evidence leaves no doubt that claim 26 requires automatic display of the link enhancement toolbar, especially given iLOR's disavowals in the specification and during prosecution. To argue otherwise, iLOR relies heavily on mischaracterizations and form-over-substance attorney argument instead of evidence and legal authority.

If the Court agrees that claim 26 requires automatic display, summary judgment is compelled because there is no dispute as to the way Google Notebook operates. iLOR "agrees with Google that the underlying facts ... are not disputed, including the seven 'material facts' ... on pages 7 and 8 of Google's Brief." (Opp. at 1.) Since no fact dispute exists, the only issues remaining are purely legal matters of claim construction.

Summary judgment must also be granted if Google prevails in its construction of "graphical element." The intrinsic record shows that "graphical element" has its ordinary meaning as an image, not text. iLOR marshals no compelling intrinsic evidence supporting its constructions. Since the accused feature of Notebook uses only text and no images, there is no infringement for this independent reason.

Perhaps realizing the precariousness of its position, iLOR asserts Google's motion "is not case dispositive" since there are "29 other claims" in the patent. (*Id.*, n.1.) This case is only about claim 26, and iLOR conceded this under oath at deposition. (Ex. A¹ at 170:6-8.) Moreover, iLOR bears the burden to show infringement, yet it has not identified—in its Opposition or elsewhere—

¹ All references to exhibits refer to those appended to the Declaration of Peter J. Kirk in support of Google's Consolidated Opposition to Plaintiff's Motion for Preliminary Injunction and Memorandum in Support of Its Cross-Motion for Summary Judgment of No Infringement, filed October 17, 2007.

any evidence of alleged infringement under any theory on any other claim.² Its failure to identify *any* basis on which a reasonable jury could find infringement of these other claims is in and of itself dispositive of non-infringement.

iLOR also seeks summary judgment on validity and enforceability, improperly raising these issues for the very first time in its Opposition. Even if these issues were properly before the Court, the best iLOR could hope for (and only if the Court adopts its improper claim constructions) is partial summary judgment that the two limitations at issue in this motion are present in Notebook, and nothing more. Its request for summary judgment on other issues misapprehends the burdens of proof on summary judgment and preliminary injunction motions.

II. ILOR FAILS TO PROVIDE ANY EVIDENCE OF INFRINGEMENT OF CLAIM 26, AS PROPERLY CONSTRUED

As the party *without* the burden of proof on infringement, Google met its summary judgment burden by “pointing out ... an absence of evidence to support the nonmoving party’s case.” *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1577 (Fed. Cir. 1989) (quoting *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986)). As Google made that showing, it was iLOR’s burden to present sufficient evidence that “a fair-minded jury could return a verdict for the plaintiff on the evidence presented,” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 252 (1986), and to submit “specific facts showing that there is a genuine issue for trial” on each element essential to its case and on which it bears the burden of proof. *Celotex*, 477 U.S. at 322; Fed. R. Civ. Proc. 56(e).

iLOR has failed, however, to submit evidence supporting infringement of claim 26, as properly construed by Google. *Celotex*, 477 U.S. at 323-24. iLOR has even admitted all seven of Google’s undisputed material facts. (Opp. at 1.) Its sole infringement theory under Google’s construction posits that “once the user right clicks” in Notebook, “the toolbar is automatically

² iLOR similarly fails to address the doctrine of equivalents, on which it also bears the burden.

displayed.” (Opp. at 18.) Common sense dictates that if a user must right-click to display the toolbar, its display is not “automatic.” User-involvement is the epitome of a manual process, and no reasonable jury could conclude otherwise.

III. GOOGLE’S PROPOSED CONSTRUCTIONS ARE CORRECT AND SHOULD BE ADOPTED BY THE COURT

A. Claim 26 Requires that the Toolbar Be “Automatically Displayed”

The plain language of claim 26 requires the toolbar to “be[] displayable based on a location of a cursor in relation to a hyperlink,” not due to any other action. (’839 patent at 12:62-64.) Claim 26 does not require the user to click the link to display the toolbar; the toolbar must be displayed automatically. Moreover, iLOR argued in prosecution that claim 26 (which includes this language) has similar scope to claims 1 and 9 (using similar but different words for automatic pop-up), and the Examiner agreed in his Statement of Allowance. (Ex. I at 8; Ex. K at 2.)

iLOR’s rebuttal to Google’s construction is that the specification does not expressly exclude manually activated toolbars and that claim 26 thus covers non-automatic toolbar display. It also disputes Google’s construction since the patent does not use the words “automatic” or “pop-up,” but Google never said otherwise. iLOR relies on literalist form-over-substance to ignore the patent’s teachings, which plainly describe automatically displayed toolbars and their advantages over manually activated toolbars that first require users to click a link.

1. Each and Every Embodiment of the Invention Requires the Toolbar to Pop Up Automatically

Rhetoric and semantics aside, iLOR fails to identify a single embodiment that does *not* require automatic toolbar display. Each and every embodiment, including those cited by iLOR, features a toolbar that automatically pops up based on the location of the cursor relative to the hyperlink. (’839 patent at 3:60-4:3, 5:35-40, 7:36-40, 8:10-20; Opp. at 5.) No embodiment includes

a toolbar displayed when the user right-clicks a hyperlink, and the specification describes that concept as well known in the prior art, and a bad idea to boot.

The specification paints automatic toolbar display as a significant advantage over the prior art. iLOR attempts to mischaracterize the Abstract as stating only that “the ‘tool bar is displayed.’” (Opp. at 4.) In truth, it says far more. It says the toolbar is displayed *when the cursor has remained near the link for a predetermined time*:

This invention permits the user to interact with a hyperlink in a variety of ways without necessarily having to open and/or follow the hyperlink. This *is accomplished by detecting the presence of a cursor near a hyperlink. When the cursor has remained near the hyperlink for a predetermined time period, a toolbar is displayed* containing one or more link enhancements

(’839 patent, Abstract (emphasis added).) The Abstract leaves no doubt that, once the cursor is positioned over a link, the only thing necessary to display the toolbar is the passage of a small predetermined period of time, not a requirement that the user also click the link. iLOR attempts sleight-of-hand by characterizing the Summary of the Invention as stating only that the “‘toolbar is displayed.’” (Opp. at 4.) In reality, like the Abstract, it says “a toolbar is displayed *when the pointer remains near the hyperlink greater than a predetermined time*.” (’839 patent at 2:55-60 (emphasis added).) Again, the only condition for displaying the toolbar after positioning the cursor is the passage of a small predetermined period of time, not manual user action.

The same point applies to each of the four passages from the “Detailed Description Of The Invention” discussed at page 13 of Google’s Opening Memorandum. Perhaps the most telling part of iLOR’s efforts to distinguish this extensive intrinsic evidence (Opp. at 5-7) is its selective treatment of the first passage. iLOR focuses on the statement that the cursor may be detected when either on or in a predetermined area around the hyperlink. (*Id.* at 5.) But iLOR misses the point, as the cited discussion concerns the location of the cursor relative to the hyperlink (on or near), not

what happens once it arrives there (in both cases, automatic toolbar display). iLOR conveniently ignores the rest of this passage, which states that once the cursor is positioned, the toolbar automatically pops up either instantly (the preferred approach) or after a short time delay (the alternative approach):

Preferably the toolbar is presented to the user instantly on mouse-over, or after the user keeps the mouse pointer on the hyperlink (or banner ad) for a predetermined time, for example one to three seconds. A short time delay prevents the browser from becoming jumbled with too much information if the user simply desires to click through on any given hyperlink.

(’839 patent at 3:64-4:3.)

iLOR errs further in arguing that the patent “does not exclude some additional action” like a mouse click “to make the toolbar visible.” (Opp. at 4.) To the contrary, the specification stresses that the invention does not require users to “click[] on a traditional hyperlink or banner ad,” calling this an advantage that “increase[s] the likelihood that the hyperlink will be used” and “significantly add[s] to the value of each link.” (’839 patent at 5:14-19.)

The patent also criticizes prior art requiring the user to manually click to display a toolbar. iLOR admits Netscape Navigator “required right clicking on the hyperlink” to display the toolbar, “and then clicking on” the desired link enhancement. (Opp. at 9.) As the specification explains:

Blocks 114 and 116 perform in essence the same functions that are performed when the user places the cursor over a hyperlink, ‘right clicks’ the hyperlink and then selects and clicks on the new open window command from the menu displayed (Netscape Navigator running on Windows 98). ***The advantage provided by the present invention is that the user can open the new window with just a single click. . . . [T]he present invention enables the user to accomplish in a single click what might otherwise take three or more user actions. The more user actions taken by the user, the greater the distraction from viewing the current page.***

(’839 patent at 6:22-53 (emphasis added).) This description of the “present invention” applies to the entire invention, not just a single embodiment as iLOR contends (Opp. at 9), and belies iLOR’s

claim that the patent does not counsel against right-clicking to display the toolbar (*id.* at 5, 7). Although this passage discusses saving a target page (where the user wants to go) instead of an anchor page (where the user is), absolutely nothing in the intrinsic record or common sense would suggest that avoiding a right-click is more important in the former context than the latter.

iLOR also misinterprets Figure 1 of the patent to distinguish this passage. (*Id.* at 8-9.) Focusing on decision blocks 110, 112, 114 and 116 showing link enhancements accessed by the toolbar, iLOR conveniently ignores blocks 102 (“user ‘mouses-over’ hyperlink”) and 104 (“‘link console’ becomes visible directly below link hypertext or graphic”), which are the only blocks relating to toolbar display. (*Id.* at 8, Fig. 1.) The absence of any other steps or requirements in these decision blocks shows that the toolbar is automatically displayed for *all* link enhancements. iLOR’s construction of “being displayable” in effect improperly inserts a right-click block between the hovering and pop-up steps shown in blocks 102 and 104.

iLOR in fact tacitly concedes at one point in its brief that all embodiments feature a toolbar that pops up automatically when it argues that, even if the specification contains only an automatic pop-up embodiment, the claims are not necessarily limited to that scope. (*Id.* at 7.) But in making this argument, iLOR overlooks the specification’s critical role in interpreting the claims. As explained in *Phillips w. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005), “claims must be read in view of the specification,” which is “always relevant,” usually “dispositive,” and the “single best guide to the meaning of a disputed term.” Since the specification emphasizes the importance to the invention of automatic toolbar display, the claims must be construed without requiring a right-click. *On Demand Machine Corp. v. Ingram Indus., Inc.*, 442 F.3d 1331, 1338 (Fed. Cir. 2006); *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1340-45 (Fed. Cir. 2001);

Watts v. XL Sys., Inc., 232 F.3d 877, 882-84 (Fed. Cir. 2000); *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999).³

2. The Prosecution History Confirms That The Invention Requires the Toolbar to Pop Up Automatically

The prosecution history further confirms that the link enhancement toolbar is displayed automatically. Claim 26 requires the toolbar “be[] displayable based on a location of a cursor in relation to a hyperlink,” not in response to a user right-click. (’839 patent at 12:62-64.) iLOR admitted as much when it told the Examiner that claim 26 had the same scope as claims 1 and 9, and the Examiner confirmed this reading in his Statement of Allowance. (Ex. I at 8; Ex. K at 2.)

As discussed at pages 14-15 of Google’s Opening Memorandum, the claims of the parent ’496 patent are limited to a method that displays the toolbar automatically, a point iLOR stressed to distinguish the invention of that patent from Newfield, which required the user to click a hyperlink to access the toolbar.⁴ (Ex. H at 10-11.) iLOR asserts that this and similar portions of the prosecution history were directed to limitations (“while in proximity” and “detecting a cursor in proximity to a hyperlink”) in claims 1 and 9 absent from claim 26,⁵ and that claim 26 was drafted to avoid these limitations. (Opp. at 9-11.) iLOR also contends “claim 26 was deliberately written to not require the ‘detecting’ step in order to avoid being limited by the argument quoted above in the parent application.” (*Id.* at 10.) This is unsupported attorney argument, and it contradicts the prosecution history. To obtain allowance, iLOR in effect told the Examiner that claims 1, 9 and 26 share the same scope. (Ex. I at 8.) So even though claims 1 and 9 and claim 26 use different words,

³ iLOR’s efforts to distinguish these cases are unavailing. (Opp. at 9.) *On Demand* and *Toro* are on point, as the patent highlights automatic toolbar display without right-clicking as an important aspect of the invention. *SciMed* and *Watts* also directly apply, as the patent’s toolbar display methods all require automatic toolbar display when the cursor is in certain proximity to the hyperlink, and none requires a user to right-click.

⁴ iLOR cannot disclaim the relevance of statements made during prosecution of the ’496 parent patent. As the Examiner noted, the claims of the ’496 patent “contain[] every element of” claims 1 and 9 of the ’839, and iLOR acquiesced in this statement by filing a Terminal Disclaimer without further challenge. (Ex. J at 2-5; Ex. I at 8.)

⁵ iLOR’s argument on this point is internally inconsistent, since elsewhere it denies that claims 1 and 9 require automatic toolbar display. (Opp. at 10 n.12)

they have the same substantive scope, and the claim differentiation doctrine does not broaden claim 26. *Seachange Int'l, Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1369 (Fed. Cir. 2005).

iLOR specifically described claim 26 during prosecution as “similar to” claim 9 and “allowable for at least the same reasons,” (Ex. I at 8), thus conceding they contain the same basic limitations. The Examiner relied on that representation in allowing claim 26, stating *inter alia* that the “prior art of record fails to teach or suggest a method for enhancing a hyperlink by **displaying a graphical toolbar in proximity to the cursor while the cursor is in proximity to the hyperlink**,” *i.e.*, the prior art fails to disclose the automatic pop-up feature. (Ex. K at 2 (emphasis added).) iLOR’s bald attorney argument to the contrary (Opp. at 12) attempts to rewrite the intrinsic record. The Examiner never said that only *certain* aspects of his Statement of Allowance were germane to *certain* claims. Neither iLOR nor the Examiner drew any distinctions between claim 26 and claims 1 and 9. iLOR even admits the Examiner “lumped together his reasons why the claims were different from the prior art,” just as it encouraged him to do. (Opp. at 12.)⁶

iLOR is bound by the statements it made to the Examiner to obtain claim 26, and cannot now try to broaden its scope to best serve its infringement position. It is blackletter law that a patentee cannot narrowly define its claims during prosecution to secure their allowance, then interpret them broadly in subsequent litigation. *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1207 (Fed. Cir. 1992); *Elkay*, 192 F.3d at 979; *ACCO Brands, Inc. v. Micro Sec. Devices, Inc.*, 346 F.3d 1075, 1079 (Fed. Cir. 2003).⁷

Nor is there any merit to iLOR’s argument that claim 26 does not exclude the “additional” step of right-clicking to display the toolbar because it uses the word “comprising” and “does not

⁶ iLOR had the right to dispute the Examiner’s Statement of Allowance, including his grouping together of claims 1, 9 and 26, but did not do so. *Elkay Mfg. Co. v. Ebc Co. Mfg. Co.*, 192 F.3d 973, 979 (Fed. Cir. 1999).

⁷ iLOR cannot differentiate *Elkay* and *Lemelson*, since it distinguished the prior art from claim 26 during prosecution by (1) casting claim 26 as coextensive with claims 1 and 9; and (2) distinguishing the entire invention from the prior art on the grounds that the latter required users to right-click to display the toolbar.

exclude additional, unrecited steps.” (Opp. at 4.) iLOR misses the point of Google’s claim construction: right-clicking on the link is not an “additional step” because the claimed method is automatic and *affirmatively excludes* manually-invoked toolbars. *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 951-52 (Fed. Cir. 1993). iLOR’s invention supplanted existing manually invoked toolbars with an automatic method for their display, and claim 26 cannot now be expanded to encompass such prior art manual processes. *SciMed*, 242 F.3d at 1340 (improper to construe claims to cover prior art structures distinguished in the specification); *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576 (Fed. Cir. 1997) (where all described embodiments “are ... non-smooth or conical” and the specification distinguishes prior art as “generally smooth-walled,” the invention “does not encompass a smooth-walled, completely cylindrical structure”).

B. “Graphical Element” Can Only Mean an Image, Not Text

iLOR also seeks to rewrite claim 26 when it argues that a “graphical element” is not limited to an image. (Opp. at 14.) Unlike iLOR’s construction, Google’s construction is entirely consistent with the intrinsic record and the term’s ordinary meaning as an image, not text. (Exs. L, M.)⁸ iLOR’s sole response to Google’s dictionaries is the incredible suggestion that the term’s meaning *may* have changed over time. (Opp. at 14.) This is pure innuendo. iLOR does not contend the definition of “graphical element” changed between 2000 and 2004, and provides no evidence that it did. Quibbling over dates aside, iLOR offers no credible reason as to why the plain meaning of “graphical element” should not apply.

The other claims confirm that the ordinary meaning of “graphical element” applies. Claim 1 includes displayable elements, both “graphic” (as in dependent claim 7) and “textual” (as in

⁸ iLOR is mistaken that Exhibit L does not mention the term “graphical element” (Opp. at 14). In fact, it uses “graphical element” interchangeably with “image.” (Ex. L at 2.)

dependent claim 8), and iLOR crafted claim 26 more narrowly to require a “graphical element.”⁹ The claim differentiation doctrine requires that “graphic[al] element” and “textual element” be construed differently to avoid rendering either term superfluous. *RF Delaware, Inc. v. Pacific Keystone Techs., Inc.*, 326 F.3d 1255, 1263-64 (Fed. Cir. 2003). iLOR tries to escape this result by arguing “graphical element” covers only graphics and “textual element” covers only “bare unformatted” or “plain” text. (Opp. at 15.) But the concept of “bare unformatted” or “plain” text is manufactured by iLOR and wholly absent from the intrinsic record, as confirmed by iLOR’s failure to identify any intrinsic supporting evidence. Instead, it argues “bare unformatted text” was known in the art at the time of the application (*id.*), a point (if true) underscoring the significance of its absence from intrinsic record.

The specification itself confirms a “graphical element” is an image. The Abstract and Background of the Invention distinguish between text and graphics, calling link enhancements a “clickable graphic/text string, and/or icon”¹⁰ or “a string of text or a computer graphic.” (’839 patent, at Abstract, 1:24-25.) The specification takes pains to define a number of terms, but not “graphical element.” (*Id.* at 3:23-43.) Nothing in the specification equates text formatting to “graphical elements,” and iLOR cites nothing in the patent supporting its construction.

Nor does the intrinsic evidence cited by iLOR save its flawed construction. The Examiner’s statement it cites has no other intrinsic support and, standing alone, is an insufficient basis upon which to interpret “graphical element” contrary to its ordinary meaning and usage in the patent. *3M Innovative Props. Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1373-74 (Fed. Cir. 2003). An examiner’s statement cannot *broaden* the scope of the claims, even if prompted by an applicant’s

⁹ iLOR’s assertion that “graphical element” and “graphic element” have different meanings has no basis in logic or the intrinsic record. (Opp. at 15.) If they are different, then claims 1 and 26 are fatally indefinite and without sufficient written description under 35 U.S.C. § 112, as it is impossible to draw any distinction between the two.

¹⁰ The Abstract does not distinguish between a “graphic” and an “icon,” as iLOR posits (Opp. at 15); on the contrary, it uses “graphic” and “icon” interchangeably and only emphasizes that a “graphical element” is an image.

comment. *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 469 F.3d 1039, 1042 (Fed. Cir. 2006).¹¹

Even iLOR's own statements during prosecution directly contradict the notion that a textual attribute like typeface is a "graphical element." (Ex. H at 11.)

iLOR's extrinsic evidence also deserves no weight. (Opp. at 17-18). Non-dictionary extrinsic evidence is disfavored and should be disregarded when the intrinsic record and plain meaning are clear. *Phillips*, 415 F.3d at 1318. Contrary to iLOR's mischaracterization (Opp. at 17-18), the *Phillips* court actually cautioned that the "virtually unbounded universe of potential extrinsic evidence" encourages a party to "choose the pieces of extrinsic evidence most favorable to its cause." 415 F.3d at 1318-19.¹²

C. iLOR Concedes Google's Construction of "Capturing" Is Correct

"Capturing" the first URL means "saving for later retrieval as a result of a second user selection of said graphical element," as iLOR concedes in its Opposition. (Opp. at 3 n.4.)

IV. THERE IS NO GENUINE DISPUTE AS TO ANY MATERIAL FACT RELATING TO INFRINGEMENT OR THE OPERATION OF GOOGLE NOTEBOOK

A. Google Notebook's Toolbar Is Not Automatically Displayed, But Appears Only After a User Right-Clicks

iLOR does not dispute that Google Notebook does not automatically display a link enhancement toolbar when the cursor is in proximity to the hyperlink, but instead requires users to right-click the link. (Opp. at 1; MUF ¶ 2.) There is no dispute regarding any material fact as to Google Notebook's operation for purposes of this limitation, and if Google's construction of "being displayed" is adopted, summary judgment of non-infringement is warranted.

B. Google Notebook Does Not Display "a Graphical Element Based on Said First URL" As Required By Claim 26

1. Google Notebook Does Not Display an Image Based on the Anchor Page

¹¹ iLOR is flatly wrong when it says this portion of *Amgen* appears in the dissent. (Opp. at 16.)

¹² iLOR's reliance on *In re Cortright* is just as misplaced, since the cited passage does not discuss the propriety of reliance on *extrinsic* prior art during claim construction. 165 F.3d 1353, 1358 (Fed. Cir. 1999).

iLOR cannot dispute that Google Notebook does not display an image based on the URL of the anchor page (“the first URL”), but instead shows the page title in boldface text. (Opp. at 1; MUF ¶¶ 4b, 5.) Because there is no dispute as to any material fact relating to Notebook’s operation for purposes of this limitation, summary judgment of non-infringement must be granted if Google’s construction of “graphical element” is adopted.

2. Even if iLOR’s Construction Is Adopted, Google Notebook Still Does Not Infringe Claim 26 Because It Does Not Display A Graphical Element “Based on the First URL”

Assuming *arguendo* that iLOR’s construction of “graphical element” applies, Google Notebook still does not infringe claim 26 as the alleged graphical element is not “based on the first URL.” The accused feature is the boldface type in which the anchor page title appears in Notebook. It is this boldface “attribute” of otherwise “bare unformatted” or “plain” text that iLOR identifies as claim 26’s alleged “graphical element,” but Notebook uses the same boldface “attribute” to display the title of each anchor page, regardless of URL. (MUF ¶ 6.) The alleged boldface “graphical element” is therefore not “based on the first URL” or any other.

iLOR misses the point when it argues that Notebook presents “different bold text of whatever ‘anchor page’ URL the user selected.” (Opp. at 19.) While each entry’s **text** derives from (and changes based upon) the title of each anchor page, its boldface “attribute”—the alleged “graphical element” of claim 26—is the same *regardless* of URL or title. iLOR ignores the text to focus on its boldface type when identifying the “graphical element,” yet ignores the boldface type to focus on the text when identifying the part of the “graphical element” “based on the first URL.” (*Id.* at 19-20.) iLOR simply cannot have it both ways.

C. Google Does Not Directly Infringe Claim 26

Even assuming *arguendo* that Notebook meets each element of claim 26, Google does not directly infringe as it does not perform each step the claim requires. There is no dispute that Google

does not “display[] a graphical element;” instead, as iLOR admits, *the user’s computer* displays a shortcut to the anchor page. (Opp. at 18.) Likewise, *the user’s computer*, not Google, performs the “receiving” step of claim 26. (MUF ¶ 3). While iLOR asserts both Google and its users perform this step (Opp. at 21 n. 18), iLOR bears the burden of proof and has failed to present any evidence on this issue.

There is no legal basis here for “joint infringement,” a theory rejected under similar circumstances in *BMC Resources, Inc. v. Paymentech*, 498 F.3d 1373, at *5 (Fed. Cir. 2007). iLOR cannot distinguish *BMC* on the basis of Google’s Privacy Policy and Terms and Conditions of Use (Opp. at 21-23), since those agreements do not require users to engage in allegedly infringing activity. To be a “mastermind” liable for direct infringement, Google would have to contractually control and direct users to perform each step of the method; merely explaining an optional feature is insufficient as a matter of law. 498 F.3d at 1380-82. There is no dispute Notebook contains many non-infringing features, and that users may use or ignore any feature, including the one alleged to infringe.

D. Google Does Not Indirectly Infringe Asserted Claim 26

iLOR also fails to prove indirect infringement, and offers no evidence that Google Notebook’s users commit the entire act of direct infringement. Notebook’s users do not practice two steps of claim 26: providing the Notebook software, and “capturing said first URL.” *Google* makes Notebook available to its users (MUF ¶ 1), and “captur[es] said first URL” and stores it on Google’s servers (MUF ¶ 4a). The user does not “provid[e] a user-selectable link enhancement” simply by downloading and running Notebook (Opp. at 23); it is Google itself that provides this functionality. Likewise, the user’s computer does not perform the “capturing” step (Opp. at 23-24); if it did, users could only access a Notebook entry with the same computer on which it was created, which iLOR

admits is not the case. iLOR supplies no evidence for its claims that Google's users perform these steps, instead relying on impermissible attorney argument. *Johnston*, 885 F.2d at 1581 ("Attorneys' argument is no substitute for evidence.").

E. iLOR Makes No Showing Under the Doctrine of Equivalents

iLOR marshals no evidence to show Google infringes under the doctrine of equivalents. As the party with the burden of proof, it was incumbent on iLOR to present evidence creating a material issue of fact. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1389 (Fed. Cir. 1992). iLOR's wholesale failure to carry its burden is fatal to any claim that Google infringes under the doctrine of equivalents, and warrants summary judgment of non-infringement on this theory.

V. ILOR'S MISPLACED INVALIDITY ARGUMENTS SHOULD BE REJECTED

iLOR seems to argue that summary judgment should be granted in its favor on validity and enforceability (Opp. at 24, 29), despite neither party having moved for summary judgment on these issues. Moreover, iLOR misunderstands the burdens of proof on a motion for preliminary injunction. Google need not present "clear and convincing evidence" of the level of ordinary skill in the art to show the likelihood claim 26 will be found obvious. (Opp. at 27.) The standard of proof on these issues is actually much lower at the preliminary injunction stage, and Google need only show a substantial question as to unenforceability or invalidity for denial of the injunction. *Abbott Labs. v. Andrx Pharms., Inc.*, 452 F.3d 1331, 1335 (Fed. Cir. 2006).

The merits of iLOR's invalidity arguments fare no better. iLOR principally attacks a straw man of Google's construction of "based on a location of a cursor in relation to a hyperlink," ignoring the term's ordinary meaning. (Opp. at 13.) Google's construction—taken straight from the plain language of the claim—does not lead to the result that the toolbar appears "whenever the cursor was anywhere on the screen" as iLOR contends. (*Id.* at 13-14.) Nothing in Google's construction of this term requires the toolbar to automatically appear no matter where the cursor is on the screen; it

simply tracks the language iLOR chose when drafting claim 26, which requires that the toolbar “be[] displayable based on the location of the cursor in relation to the hyperlink.” iLOR’s construction improperly narrows the claim to apply only when the cursor is directly over the hyperlink, but the claim does not support this limitation. A menu that appears only when the cursor *is not* over the hyperlink, and a menu that appears only when the cursor *is* over the hyperlink, are equally “based on a location of a cursor in relation to a hyperlink.”

iLOR’s second attempt to distinguish Navigator also rests on an improper construction. iLOR contends claim 26 requires “display of a ‘graphical element’ [as] the result of the user selection of the link enhancement.” (*Id.* at 25.) But claim 26 only says the link enhancement is “*adapted to display* a graphical element based on said first URL.” Being “adapted to display” does not require “displaying as a result of user selection of the link enhancement.”

Finally, iLOR argues that the Kaehler patent is cumulative of other prior art cited during prosecution. However, iLOR clearly did not view it as cumulative when it cited Kaehler during prosecution of a related patent application. Google, moreover, cites Kaehler as a *secondary* reference. iLOR does not dispute that Google’s *primary* reference is not cumulative. The differences between Navigator and claim 26 (as properly construed) are slight, and the few that exist are disclosed by Kaehler.

VI. CONCLUSION

For all the foregoing reasons, Defendant Google Inc. respectfully requests that the Court grant its Motion and enter summary judgment of non-infringement in its favor.

Dated: November 14, 2007

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CERTIFICATE OF SERVICE

It is hereby certified that I electronically filed the foregoing Reply Memorandum in Support of Defendant Google Inc.'s Cross-Motion for Summary Judgment of No Infringement with the clerk of the court by using the CM/ECF system, which will send a notice of electronic filing to the following:

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