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THE UNITED STATES DISTRICT COUR
FOR THE EASTERN DISTRICT OF VIRGINIA
Norfolk Division

I/P ENGINE, INC.,)	
)	
Plaintiff,)	CIVIL ACTION
)	
V.)	2:11CV512
)	
AOL INC., GOOGLE INC.,)	
IAC SEARCH & MEDIA, INC.,)	
GANNETT CO., INC., and)	
TARGET CORPORATION,)	
)	
Defendants.)	

TRANSCRIPT OF PROCEEDINGS

Norfolk, Virginia

October 31, 2012

JURY TRIAL - Day 11

(Pages 1796-1973)

Before: THE HONORABLE RAYMOND A. JACKSON
United States District Judge

1 Appearances:

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By: W. RYAN SNOW, ESQUIRE
DONALD C. SCHULTZ, ESQUIRE

and

DICKSTEIN SHAPIRO, LLP

By: JEFFREY K. SHERWOOD, ESQUIRE
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DR. JAIME CARBONELL
DIRECT BY MR. CIMINO 1818
CROSS BY MR. NELSON 1889

* * *

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* * *

1 (Court convened at 10:00 a.m.)

2 MR. BROTHERS: Your Honor, two brief
3 housekeeping matters before we bring in the jury. I
4 believe we can handle these without objection.

5 Yesterday your Honor indicated that a limited
6 version of Plaintiff's Exhibit 447, the S-1 statement
7 that was referenced, would be admitted. I have reviewed
8 this with opposing counsel. They have indicated there
9 are no objections, so we move to admit Exhibit 447.

10 THE COURT: All right. Hearing no objection, it
11 will be admitted.

12 MR. WILSON: No objection, your Honor.

13 (Plaintiff's Exhibit No. 447 was admitted.)

14 MR. BROTHERS: The second matter is with respect
15 to the video depositions. I understand it is this
16 Court's practice not to have those transcribed in the
17 part of the transcript, and I just wanted to state on the
18 record we have tendered to the Court all of the
19 deposition video, the transcripts that were played, and
20 we understand the Court will be making that a part of the
21 official record.

22 THE COURT: Thank you.

23 MR. BROTHERS: Thank you, your Honor.

24 THE COURT: Yesterday, counsel raised a series
25 of motions under Rule 50 for the Court's consideration,

1 and the Court has had an opportunity to consider those
2 motions and the Court will take the following action with
3 respect to those motions.

4 With respect to the plaintiff's motion for a
5 Rule 50 ruling as a matter of law on the question of
6 validity based on anticipation and obviousness, the Court
7 will deny that motion at this juncture. The motion is
8 denied.

9 With respect to their motion for judgment as a
10 matter of law regarding the invalidity because of alleged
11 inadequacy of written descriptions, that motion is
12 granted and there's no question that the defendants were
13 not going forward on that.

14 With respect to the motion for judgment as a
15 matter of law on laches, the Court has had an opportunity
16 to read the submission of the defendant regarding that
17 and consider plaintiff's response to that motion, and the
18 Court takes this view of that motion:

19 The course of defense of laches, as both parties
20 have well indicated, bars a plaintiff from winning any
21 damages accrued before the filing of a suit, and in this
22 case the Court has looked at the elements of laches.
23 There are basically two elements of laches, one requiring
24 the defendant to show that the plaintiff delayed filing
25 the suit for an unreasonable period of time or an

1 inexcusable delay.

2 The other one is that the delay in some way
3 affected prejudice or operated prejudice to the
4 disadvantage of the defendant.

5 Of course, there arises a presumption of laches
6 where the defendant can show that the plaintiff delayed
7 suing for more than six years after the patentee knew or
8 should have known of the alleged infringement in the
9 case.

10 In this case suit was filed on September 15th,
11 2011, in this case the claim was filed. The defendants
12 allege that plaintiffs were on constructive notice of the
13 infringement as early as July 2005 when Google put forth
14 a blog that was entitled Google Inside AdWords, Exhibit
15 176 in this case, Plaintiff's Exhibit 176, which in some
16 way described Quality Score, described parts of the
17 accused product in this case.

18 The plaintiffs, of course, contend that a
19 one-sentence blog is inadequate to put them on any type
20 of constructive notice of infringement. That's their
21 basic response in this case.

22 The Court understands that I/P Engine, of
23 course, acquired these patents. Lycos in 2005 was
24 certainly the owner of these patents, but the law
25 provides that when a patent transfers ownership, the

1 transferee of the patent must accept the consequences of
2 any dilatory conduct of immediate and remote
3 transferors. I think this case was quoted as the Eastman
4 Kodak case versus Goodyear Tire & Rubber Company, at 114
5 F.3d 1547, a 1997 Fed Cir. case.

6 In this case the Court has to examine the
7 question of whether the plaintiffs were on notice of the
8 alleged infringement in this case. Beyond the blog,
9 which plaintiffs object and finds short, the Court also
10 found, in reading the testimony of Mr. Blais and
11 Mr. Kosak and also in looking at the full record of this
12 case, that in 2005, as early as 2003, 2004, Lycos was in
13 a commercial relationship with Google.

14 During the course of that commercial
15 relationship the record reflects that, in fact, Lycos was
16 taking advantage of Google ads. They had a relationship
17 with Google, and they were using the Google ads product.
18 According to the testimony of Mark Blais, the general
19 counsel for Lycos, in 2004 Lycos was using Google's
20 products.

21 Certainly if Lycos was, in fact, using Google's
22 products, AdWords, they were in a position to consider
23 and scrutinize the product to determine whether their
24 product was in some way infringing on their technology.

25 According to the testimony of Mr. Kosak, one of

1 the inventors of the patents, the asserted patents in
2 this case, he had no reason to analyze the AdSense or
3 look at these products because he was not receiving any
4 revenue stream from the product, so he took no action to
5 determine whether Google was, in fact, infringing on the
6 product.

7 According to Mr. Blais, Lycos in 2005 had no
8 policy regarding patent infringement or enforcement.
9 They did not investigate in 2005 whether Google had
10 infringed any of its products. In 2005, 2006 they had no
11 policy on patent licensing. In 2005, 2006 Lycos did not
12 negotiate regarding the licensing of its patents. In
13 short, they did nothing regarding protecting their
14 patents.

15 But it is also clear under the law that a patent
16 owner is required to engage in some type of diligence or
17 some type of effort to determine whether someone is
18 infringing their technology.

19 I think one of the parties quoted the *Wanlass*
20 *versus General Electric Company* case, at 148 F.3d 1334, a
21 1998 Fed Cir. case, which says that ignorance will not
22 insulate a patentee from constructive knowledge under
23 certain circumstances regarding infringement of its case.

24 That particular case also had this line that is
25 important here: "A reasonable patentee must investigate

1 potentially infringing, pervasive, open and notorious
2 activity, including sales, marketing, publication or
3 public use of a product similar to or embodying
4 technology similar to the patented invention or published
5 description of the defendant's potential infringing
6 activities."

7 What the Court is saying, in a nutshell, is that
8 the plaintiff in this case, specifically Lycos, had some
9 responsibility to be proactive in determining whether its
10 patent was being infringed. Surely if the blog was
11 sufficient to be alleged in paragraph 43 of the
12 complaint, that same paragraph, the same blog should have
13 given at least a spark of interest to Lycos to determine
14 whether maybe Google was infringing its patent back in
15 2005.

16 More over, in view of the fact that there was a
17 close relationship between Google an Lycos, Lycos was, in
18 fact, benefiting from Google ads or Google's use of their
19 technology, again, should have placed them on notice
20 that, perhaps, their patent was being infringed.

21 The Court finds, in view of these facts, that
22 there arises a presumption of prejudice here to Google
23 for what the Court finds to be an unreasonable delay or
24 inexcusable time in bringing suit in this case. And that
25 being the fact that there is a presumption of prejudice,

1 a presumption that arises, a presumption of laches, then
2 the burden shifts to the plaintiffs in this case.

3 The Court finds in this case that plaintiff has
4 not produced sufficient evidence to overcome the
5 presumption of laches. The Court doesn't find anything
6 in the record to adequately explain the delay in bringing
7 this lawsuit. Nothing has been articulated, the Court
8 finds, adequate to explain the delay.

9 In terms of whether Google has been prejudiced,
10 one of the things that's often cited is memory loss or
11 inability to recall. The Court would note for the record
12 that Mr. Kosak, or is it Mr. Lang? One of the inventors
13 had substantial difficulty remembering anything. The
14 deposition is replete with I don't recall, I don't
15 remember things pertinent to this invention that would be
16 pertinent and relevant to the infringement.

17 So to the extent that the defendants cite that
18 memory loss and the inability to find this, that or the
19 other in the record as an example of prejudice, plaintiff
20 certainly has not responded to it. So the Court finds in
21 this situation that the defense of laches is appropriate
22 and should apply and so, therefore, the Court grants
23 defendant's motion on the defense of laches.

24 That being said, in this case the plaintiff's
25 damages must flow from the date of filing its complaint,

1 which was September 15th, 2011.

2 So I say this: When we look at the instruction
3 on determining when damages should be calculated, the law
4 talks about the damages flowing from the date of the
5 alleged infringement and notice of the infringement.
6 There was no evidence in this case that the plaintiff
7 Lycos or I/P Engine ever gave Google any notice of any
8 infringement before filing of the complaint, at least the
9 Court didn't hear that. I think the question was asked,
10 and there was no evidence that happened.

11 In any event, if you did not run into a problem
12 with laches, you probably would have had a problem when
13 you got down to getting an instruction on calculation of
14 damages, in any event. But the Court finds it's
15 appropriate to grant the motion.

16 So that being the case, the Court recognizes
17 granting its motion may, in fact, change the way you
18 intend to question your next witness and will certainly
19 impact on your closing argument in this case in terms of
20 what goes up before the jury now on the issue of
21 calculation of damages and so you may need some time to
22 make some adjustments, I don't know. But that's the
23 Court's ruling on that issue.

24 You know, I will note any objections you have
25 and you can take it up at some future point.

1 MR. BROTHERS: Your Honor, I appreciate the
2 Court giving plaintiff a moment to respond.

3 THE COURT: Oh, I wasn't giving you a moment to
4 respond. I was giving you my ruling.

5 MR. BROTHERS: No, I understand. This motion,
6 however, we have not filed a written response. This
7 motion was made yesterday, and we have not provided a
8 written response.

9 THE COURT: Well, let's put it this way: The
10 Court deemed you to be giving a response yesterday to the
11 motion for laches. And now you are telling me it's
12 something the Court -- no, not only that, Mr. Brothers.
13 I want you to understand this. The parties filed a
14 motion for summary judgment in this case on this very
15 same thing. The Court didn't rule on the motion for
16 summary judgment on laches. It waited to get a full
17 record, and the Court has a full record.

18 The Court also heard your response yesterday.
19 So now to tell the Court that somehow or another the
20 Court is prematurely ruling because you haven't filed a
21 written response, that's just plain not going to fly
22 here. But you can certainly -- you are free to file what
23 you wish to file on this motion and at a minimum you may
24 have to take it up with the Federal Circuit, but the
25 Court has ruled.

1 MR. BROTHERS: I understand, your Honor. In the
2 evidence that we have submitted to the Court, including
3 our opposition to the motion for summary judgment, I want
4 to point out some facts that I didn't hear the Court
5 referencing. I understand the Court's ruling, but with
6 regard to the Doctrine of laches, it is an inequitable
7 doctrine and the defendants must have unclean hands.

8 The sole document on which they refer,
9 Plaintiff's Exhibit 176, defendants have said is not
10 accurate. So to impute the running of the laches clause
11 on a document that the defendants themselves say wrongly
12 describes their system, because that document is
13 inaccurate --

14 THE COURT: Now, let me respond to that. The
15 Court assumed that. Let's assume that document, Exhibit
16 176, incorrectly described their product. That still
17 does not mean an incorrect document would not be
18 sufficient to raise the inference about what is going on,
19 the fact that it's inaccurate. More over, if you assume
20 that document is inaccurate, that's why the Court went
21 into examination about the relationship between Google
22 and Lycos because it's just not a matter of that
23 document, it's a matter of them being in the position to
24 receive information that they could analyze.

25 MR. BROTHERS: Understood. The relationship

1 between Lycos and Google started when Google was using
2 the DumbAds system. It was not a system that was
3 practicing the patents. So to impute knowledge to Lycos
4 when Lycos and Google entered into that relationship and
5 Google was not infringing, I believe, is error.

6 THE COURT: Well, in 2005, you take the position
7 that Google was not infringing in 2005?

8 MR. BROTHERS: No, sir, and I didn't mean to
9 say. The Court referred to the relationship starting in
10 2003 running into 2000 --

11 THE COURT: And the Court went to 2004 and 2005,
12 and the heart of the Court's ruling is based on that
13 relationship in 2005.

14 MR. BROTHERS: Understood. But what I'm trying
15 to do is put into context the relationship commenced when
16 Google was using a system that was not infringing.

17 THE COURT: It doesn't matter where it started.
18 The question is how soon did they learn of the potential
19 that there was infringing going on?

20 MR. BROTHERS: Yes. And the testimony that the
21 Court heard from Mr. Alferness was that Google didn't
22 want to reveal the details of the system, the technical
23 information about how the system worked. It wanted to
24 keep it a very high level the information it put out, so
25 as a result, there was insufficient information to put a

1 party on notice with regard to the technical operation of
2 the system until in years later all of the additional
3 evidence came out that was cited in the complaint, and we
4 cited a considerable amount of information that Google
5 made public in 2007, 2008, 2009, 2010 and 2011. That
6 information is what put --

7 THE COURT: Well, I understand that's your
8 view. The Court takes the position that Google had
9 sufficient information to put it on constructive notice
10 to do some investigation and some inquiry about whether
11 its patents were being violated.

12 MR. BROTHERS: I understand the Court's ruling.

13 THE COURT: You have made your record, and I'm
14 sure this won't be the end of it.

15 MR. BROTHERS: There's one other point that I
16 would like to address with regard to the Court said that
17 Lycos did nothing with regard to protecting its patent.
18 In fact, we have tendered evidence as part of our
19 opposition to motion for summary judgment that Lycos
20 between 2007 and 2010 was engaged in litigation with
21 other entities regarding this patent family, and the law
22 does not require that Lycos sue everybody at the same
23 time and that that is an excusable delay under Federal
24 Circuit case law that if Lycos is enforcing the patent
25 family against others, that that is appropriate and

1 sufficiently an excusable reason, and that is why laches
2 should not apply.

3 THE COURT: Okay. Thank you.

4 The Court does recall that, and the Court did
5 not cite that in its ruling a few minutes ago. The Court
6 did rule that you were doing some other things regarding
7 the patent in 2007 and 2008. The Court didn't mention
8 that in its ruling just now. The Court didn't construe
9 that as being something that totally barred you from
10 raising the issue of infringement with Google.

11 And the Court is aware of the fact that you
12 litigating somewhere else is something the Court may
13 consider. That doesn't mean that the Court is bound to
14 consider that and to consider that as a total defense to
15 the laches. You are right, you have indicated the Court
16 does have discretion in its equitable defense. The Court
17 doesn't have discretion in considering the facts in the
18 case in ruling on laches.

19 MR. BROTHERS: Well, because I think that in
20 addition to -- because I think this might be an issue
21 that would be appropriate on appeal, I would urge the
22 Court that we proceed through verdict and then in a JMOL
23 motion, assuming that there is a verdict for the
24 plaintiff, that then once we have that full verdict, then
25 the Court can so rule and then we can, if need be, go to

1 the Federal Circuit so we don't have to go through and
2 redo this again.

3 THE COURT: Now, Mr. Brothers, what you said,
4 the Court understands that, and that may very well be a
5 wise way to go, to avoid coming back and to reconsider it
6 again, but let's put it this way: That is the Court's
7 ruling on the issue of laches . But what the Court will
8 do is the Court will defer this and let it simply go, but
9 I want you to understand that when the verdict comes back
10 in here for the plaintiff, the Court is going to come
11 back to the issue of laches and the question -- I think
12 what you say is wise, to avoid us having to come back
13 here again or to deal with this issue again. So I just
14 want you to know that's what the Court's ruling is.

15 So the Court, gentlemen, as a matter of caution,
16 the Court will defer and hold it; but if the verdict
17 comes back in here for the plaintiff, the Court is going
18 to --

19 Yes, sir, Mr. Nelson.

20 MR. NELSON: I would just like to address that
21 issue, your Honor. I appreciate the Court's ruling and
22 understand what you are talking about, but there's a
23 fundamental problem with doing it that way because most
24 of their case, particularly on the damages side, is based
25 on this use, use, use, use. They are trying to use that

1 argument to prejudice the jury with a big number.

2 Now, if the jury really is not to be considering
3 that big number because they don't have any right to
4 claim it, they shouldn't be allowed to use that evidence
5 to try to prejudice the verdict and to achieve some kind
6 of compromise because the jury thinks, oh, there was a
7 lot of use on the one side and, therefore, they should be
8 able to get something out of it.

9 THE COURT: Let's put it this way, Mr. Nelson.
10 If the jury finds infringement, okay, they are simply
11 trying to calculate the damages. If they come in and
12 they calculate damages to come in with some large number,
13 the Court is simply saying it's very easy for the Court
14 to grant its motion for laches and cut down the size of
15 that verdict.

16 Now, I guess one problem may very well be --

17 MR. NELSON: Because, see, the problem we have,
18 your Honor, with that --

19 Okay. You are thinking. Let me know when I can
20 talk.

21 THE COURT: Go on. I'm thinking about what you
22 said.

23 MR. NELSON: Okay. So the problem we have with
24 that is, remember, the only evidence that Dr. Becker put
25 in goes back to 2005, right, mid-2005? So the jury has

1 the one number. He hasn't offered anything else about
2 what would be the case as of a different date. So they
3 are going to be arguing to the jury that they are
4 entitled because of this use by Google, as they keep
5 saying, that they are entitled to \$493 million in
6 damages.

7 Now we know from your Honor's ruling that's not
8 correct. So what happens if the jury comes back with a
9 verdict of \$50 million? What are we to take from that,
10 because they haven't been given the proper evidence in
11 terms of what the damages claims are to consider, and
12 then we don't know how to deal with that.

13 THE COURT: Okay. We are going backward and
14 forwards.

15 Mr. Brothers, Mr. Nelson's point is simply this,
16 and it reminds the Court that the Court has an
17 instruction in here -- the Court understands what you
18 want to do and the Court doesn't want to be in a position
19 it has to come back here again to try this case,
20 depending upon what happens, but that may be a reality
21 because there is an instruction in here that the Court
22 has to deal with to tell the jury from what date they are
23 to commence calculating damages in this case, and the
24 Court has to give them an appropriate date to commence
25 calculating damages.

1 In view of the Court's position on the laches
2 issue, I think it may be inappropriate then for the Court
3 to go back and tell them in that instruction to start
4 calculating damages in some other way. As a matter of
5 fact, we haven't even resolved that issue. The Court's
6 ruling certainly resolves that issue about when you start
7 calculating damages. You know, it's very clear to the
8 Court that one way or the other, based on the way you
9 counsel, both sides have tried this case, this is a case
10 the Court may be living with for the next five years, six
11 years. So, that's just the reality.

12 MR. BROTHERS: If I can propose, with the
13 Court's indulgence, I believe that there is a solution,
14 okay? First of all, Dr. Becker has provided evidence on
15 a quarter-by-quarter basis.

16 With respect to the total, both revenue based,
17 the rate, and remember that blue bar chart that went up,
18 that was on a quarter-by-quarter basis. So that evidence
19 has been referenced by the witness. Now, we haven't done
20 the specific math. That would be the quarter -- so we
21 would start fourth quarter of 2011 on that chart, and you
22 would be missing 15 days of September.

23 What I would propose is that the jury be given
24 two periods. So, In other words, for the award -- and
25 this is to preserve the record. So there's the total

1 award and then damages as of September 15, 2011.

2 So we have that question being presented to the
3 jury, we have the full record, and we have the answers to
4 the questions, so we don't need to retry the case. And I
5 believe that can be explained in instructions to the jury
6 where the jury can then say this is the total amount that
7 is sought; however, there is an issue or a question,
8 however the Court wants to phrase it, with regard to
9 damages prior to the filing of the lawsuit. The Court
10 instructs you that you are also to determine the
11 appropriate measure of damages as of the date of the
12 filing of the lawsuit.

13 So we have those two pieces of information and
14 we can tailor the summation accordingly. That, I
15 believe, will have all of the evidence in the record.

16 THE COURT: All right. Mr. Nelson, the Court is
17 going to have to decide this. The Court is trying to
18 accommodate you and understand what you are saying, but
19 --what else do you have to say?

20 MR. NELSON: So, your Honor, that's exactly the
21 purpose of a Rule 50(a) motion. It's something that
22 shouldn't go to the jury, and your Honor has ruled as a
23 matter of law. So the fact of the matter is in the jury
24 instructions we cannot go back to the jury and say,
25 please calculate damages from some period of time when

1 your Honor has already ruled that they are not entitled
2 to damages because, I mean, set aside the confusion issue
3 that we have already talked about, that's an advisory
4 verdict, your Honor. I mean, that's an Article 3 problem
5 right there.

6 I mean, I understand what it is they are trying
7 to do, but that is exactly the purpose of Rule 50(a).
8 It's something that shouldn't go to the jury.

9 THE COURT: Okay. Gentlemen, here's where we
10 stand. The Court is going to stick with its ruling.

11 Mr. Brothers, the Court understands what your
12 concern is and the Court has some concern, but the Court
13 has accepted the inevitability that with respect to this
14 case that is heavily litigated, it's heavily financed, so
15 you have all the time in the world and all the lawyers in
16 the world, that this case will go on, even after we are
17 gone. So the Court has granted the motion and the Court
18 will proceed to just let it take effect.

19 Gentlemen, you have an opportunity to again
20 renew your motions, depending upon the verdicts: Motions
21 for a new trial, motions for appeal. You have all kinds
22 of options out there, and I'm sure I will be hearing
23 about it.

24 Okay. That's it. Bring in the jury.

25 (Jury in.)

Dr. J. Carbonell - Direct

1 THE COURT: You may have a seat.

2 Let the record reflect all jurors are present in
3 the courtroom. Does counsel agree?

4 MR. CIMINO: Agreed.

5 MR. NELSON: Agreed.

6 THE COURT: Ladies and gentlemen, now the
7 plaintiffs have the opportunity to call a rebuttal
8 witness.

9 You may call your witness.

10 MR. CIMINO: Your Honor, the plaintiff calls
11 Dr. Carbonell, an expert, who will provide an opinion on
12 the validity of the '420 and '664 patents.

13 THE COURT: All right.

14 DR. JAIME CARBONELL, called as a rebuttal
15 witness, having been first duly sworn, was examined and
16 testified as follows:

17 DIRECT EXAMINATION

18 BY MR. CIMINO:

19 Q. Good morning.

20 A. Good morning.

21 Q. Could you please introduce yourself to the jury?

22 A. I am Jaime Carbonell.

23 Q. Where do you live, Dr. Carbonell?

24 A. I live in Pittsburgh, Pennsylvania.

25 Q. And why are you here today?

Dr. J. Carbonell - Direct

1 A. I'm here to testify on behalf of the plaintiff on
2 the validity of the asserted patents.

3 Q. Okay. So what's your current occupation?

4 A. I am a professor at Carnegie Mellon University, a
5 chaired professor, and I'm also the director of the
6 Language Technologies Institute, which is part of the
7 university.

8 Q. You mentioned chaired professor. Can you explain to
9 the jury what a chaired professor is?

10 A. Yes. I believe that we heard earlier three ranks of
11 professor, assistant, associate and full, and chaired
12 professor is one level above that in the university.

13 Q. What percentage of professors in the university
14 achieve the rank of chaired professor?

15 A. It's approximately five percent.

16 Q. Are there any ranks above chaired professor?

17 A. Not on the academic track. On the administrative
18 track you have the Provost or president.

19 Q. And how long have you been a chaired professor,
20 Dr. Carbonell?

21 A. At least 15 years.

22 Q. And as a chaired professor, have you focused on
23 search and information retrieval and related
24 technologies?

25 A. Yes, I have.

Dr. J. Carbonell - Direct

1 Q. Do you currently teach?

2 A. Yes, I do.

3 Q. What type of courses?

4 A. They are primarily graduate courses and graduate
5 studies.

6 Q. In what type of areas?

7 A. I teach in search, text mining, artificial
8 intelligent, machine learning.

9 Q. Now, you also mentioned that you are the director of
10 the Language Technologies Institute?

11 A. Yes.

12 Q. What's the Language Technologies Institute?

13 A. It's a research institute that conducts research in
14 all aspects of computer processing of language, spoken
15 language, speech recognition, textual language, machine
16 translation, search engines, information retrieval, text
17 mining, and so on.

18 Q. And you said that you are the director?

19 A. I am.

20 Q. What is the director position?

21 A. I have responsibility for the research agenda, the
22 educational programs and the administration of the
23 institute.

24 Q. And how long have you been the director?

25 A. Since it started in 1996.

Dr. J. Carbonell - Direct

1 Q. Did you have any involvement with starting the
2 institute?

3 A. Yes. I essentially founded the institute.

4 Q. How many people make up the Language Technologies
5 institute?

6 A. It's over 200 in total of which, I believe, 32 are
7 faculty members, a number of staff members for
8 post-doctoral fellows, Ph.D. and Master's students.

9 Q. Does the institute conduct research?

10 A. It certainly does.

11 Q. Can you give the jury a couple of examples of the
12 types of research that the institute does relating to
13 search and information retrieval?

14 A. Yes. The institute does research in the areas I
15 mentioned earlier. A couple of specific examples would
16 include working with IBM on the Watson system. This is
17 the Jeopardy Championship System. Two of the components
18 were developed in the institute.

19 Another example is search engines. The
20 institute has been responsible for two of the three most
21 popular open source search engines. One is called
22 Leamer, the other one is called Indri.

23 Q. Do you have any project teams you are responsible
24 for that conduct research?

25 A. Me personally, you mean?

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1 Q. Yes.

2 A. Yes, I do.

3 Q. Can you describe what types of research that project
4 does?

5 A. I'm responsible for a project that conducts research
6 with the U.S. Government, primarily DARPA. That is part
7 of the Department of Defense. That research is in areas
8 like text mining and machine learning for text mining,
9 an especially large scale. Another group focuses on
10 machine translation and text mining.

11 Q. Is in your view Carnegie Mellon University known for
12 computer science?

13 A. Yes, it is. I would say it's among the top three
14 with MIT and Stanford.

15 Q. How big is the College of Computer Science?

16 A. It's fairly large. There are over 200 faculty
17 members in total. Those include the ones I mentioned,
18 and over 800 students.

19 Q. And how long have you been there, Dr. Carbonell?

20 A. I have been there since 1979.

21 Q. Can you describe how your career progressed at CMU?

22 A. Yes. I was hired as an assistant professor for the
23 first five or six years there, then as an associate
24 professor, then I was awarded tenure, then as a full
25 professor, and most recently as a chaired university

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1 professor in the Language Technologies Institute.

2 Q. Can you describe a description of your educational
3 background for the jury?

4 A. My undergraduate education was at MIT, The
5 Massachusetts Institute of Technology where I have
6 degrees in mathematics and in physics. Then I went to
7 Yale University where I received a Master's degree and a
8 Ph.D, both in computer science.

9 Q. And when did you receive your Ph.D?

10 A. In 1979.

11 Q. Did you do a dissertation?

12 A. Yes, I did.

13 Q. What was your dissertation about for your Ph.D?

14 A. The dissertation was in the area of artificial
15 intelligence and text mining, and it received the
16 highest honor.

17 Q. Have you done any design of search and retrieval
18 systems? You mentioned the open source. Any others?

19 A. Yes, I have. I am the founder -- the founder of
20 Lycos was my Ph.D. student, Michael Mouldin. I provided
21 formal advice there. I was also the designer of another
22 search engine system called Condor, a search engine used
23 in Asia and, particularly, in Korea.

24 Q. Have you heard of a system called advise as a
25 memorandum?

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1 A. Yes. Vivisimo is a company, a spin-off of Carnegie
2 Mellon University, which works in the area of search, in
3 particular enterprise search. I was a scientific
4 advisor to Vivisimo. Vivisimo was recently acquired by
5 IBM and their search engine now becomes IBM's search
6 engine.

7 Q. You mentioned Lycos and the founder Michael Mauldin,
8 that you were an advisor. Were you a paid advisor?

9 A. I was paid my salary at the university. I received
10 nothing beyond that.

11 Q. When did advising Lycos and Michael Mauldin end?

12 A. Well, advising Michael Mauldin as a student ended in
13 the early 90's when he graduated, then I was an informal
14 advisor to Lycos, the company, and that ended, I
15 believe, in 1994 when it had its initial public
16 offering.

17 Q. Did you know Ken Lang?

18 A. I knew of Ken Lang. He was a student at Carnegie
19 Mellon. Not in the institute where I direct, but
20 elsewhere.

21 Q. Did you do any advising for WiseWire?

22 A. No, I did not.

23 Q. Is it uncommon for your students to pursue careers
24 in search engine technology?

25 A. No. On the contrary, it's quite common. Many of

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1 them go and work in search engine technologies in
2 various companies or in academia. We have more of our
3 Ph.D. students now working in Google than anywhere else,
4 including the five or six that I had advised myself are
5 Google employees. Others have gone to Microsoft and
6 other search engine companies.

7 Q. Other than the students that you advised going to
8 Google, does your language institute have any other
9 connection to Google?

10 A. Well, there's an informal connection in the sense
11 that I was a colleague of Andrew Moore, who is the
12 director of Google Pittsburgh. We taught courses
13 together and so forth. Also, two of the faculty at the
14 Language Technologies Institute have received grants
15 from Google. I personally have not.

16 Q. How about awards or honors, have you received any
17 awards or honors through your academic career?

18 A. I have received several such as the Simon Teaching
19 award. Maybe the most relevant one is a Best Paper
20 award for translating multilingual search engines. That
21 was in 1997 awarded by the International Jones
22 Conference on Artificial Intelligence.

23 Q. Dr. Carbonell, have you started any companies that
24 are involved in search or information retrieval?

25 A. Yes, I have.

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1 Q. Do you know what the Carnegie Group is?

2 A. The Carnegie group was started in the 1980s. It was
3 a company in artificial intelligence and text mining
4 and, essentially, the precursor of modern search
5 engines. That company had an IPO and was later
6 acquired.

7 Q. And you had involvement with that company?

8 A. I was the founder of that company.

9 Q. How about Carnegie Speech, have you heard of
10 Carnegie speech?

11 A. Yes, Carnegie Speech was founded about 12, 13 years
12 ago. It's in the area of computer assistance to teach
13 languages, to teach humans how to speak or write other
14 languages. I'm a co-founder of that one as well.

15 Q. How about Dynamix Corp., do you know what that
16 company is?

17 A. Sure. I was also a co-founder of Dynamix. Dynamix
18 is somewhat different. It does research and development
19 for the U.S. Government for various agencies in
20 different projects. It involves text mining, it
21 involves large scale systems, it involves search, and it
22 involves machine learning.

23 Q. And what's your connection to the company now?

24 A. My connection to the company now, I am the chief
25 scientific advisor to the company.

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1 Q. How about books, have you had any books published?

2 A. I've had five books published, three of which
3 essentially belongs to the current era of machine
4 learning. These were together with two of my
5 colleagues, Tom Mitchell and Ryszard Michalski, the late
6 Ryszard Michalski.

7 Q. What do you mean by launched the era of machine
8 learning?

9 A. Machine learning is a vibrant field now, but in the
10 early 80s' it was just beginning and we, the three of us
11 that I mentioned before, started the first conference,
12 the first journal, and the first three books in the
13 area. That was considered the genesis of that field.

14 Q. So are you aware of any books on machine learning
15 prior to yours?

16 A. Not in machine learning, per se, no. There were
17 other books that pertained to it in a more indirect way.

18 Q. How about publications, do you have any publications
19 directed to search or information retrieval?

20 A. Yes. I have 300 scientific articles in total, some
21 of which are pertaining to information retrieval and
22 search engines.

23 Q. How about patents, are you the named inventor on any
24 patents?

25 A. On four patents, on the four issued patents I'm the

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1 named inventor in areas of text analysis, machine
2 translation.

3 Q. Do you have any other inventions?

4 A. There's one which I believe is particularly
5 relevant.

6 Q. Could you please describe it to the jury?

7 A. Yes. It's called maximum marginal relevance.
8 That's a big name to just simply say diversity in search
9 engines. Search engines today, if you get diverse
10 results, it will give you copies of the same web page
11 for others that are almost identical because they
12 include both a relevance and a diversity criteria.
13 That's what maximum marginal relevance does. I did not
14 patent that. I published it as a paper. It has over
15 1,000 scientific citations.

16 Q. What does it mean to have over a thousand scientific
17 citations?

18 A. It means that a thousand others have based their
19 work on the maximum marginal relevance result or method
20 that I described in that paper.

21 Q. Dr. Carbonell, all in all, how long have you been
22 involved in the field of search and information
23 retrieval?

24 A. For a long time, roughly 28, 30 years.

25 MR. CIMINO: Your Honor, we offer the testimony

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1 of Dr. Jaime Carbonell as an expert in this case in the
2 field of search and information retrieval.

3 THE COURT: Do you wish to voir dire him on his
4 credentials?

5 MR. NELSON: No, sir, your Honor.

6 THE COURT: All right. Ladies and gentlemen,
7 you may accept Professor Carbonell as an expert in the
8 field of search and information retrieval.

9 BY MR. CIMINO:

10 Q. Dr. Carbonell, let's turn to your opinions in this
11 case.

12 And, your Honor, Dr. Carbonell has a
13 presentation that he would like to go through. The
14 majority of it are demonstratives or exhibits that are
15 already in evidence. There is one new exhibit that he
16 has a little bit later in his presentation, and I will
17 stop and have him look at the binder before that slide
18 goes up.

19 THE COURT: Okay.

20 BY MR. CIMINO:

21 Q. Dr. Carbonell, were you in the courtroom when
22 Dr. Ungar testified about validity?

23 A. Yes, I was.

24 Q. Do you agree with his conclusions that the '420 and
25 '664 asserted claims are invalid?

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1 A. I certainly do not disagree.

2 Q. Why not?

3 A. Because the asserted prior art fails to teach or
4 disclose some of the essential claim elements of the
5 asserted claims of claim 10 and 25 of the '420, and
6 claim 1 and 26 of the '664. Those are the independent
7 claims.

8 Q. So before we get into your detailed analysis there,
9 Dr. Carbonell, I was wondering if you could walk the
10 jury through a high-level explanation of why you believe
11 the '420 and '664 asserted claims are valid.

12 Now, what is the prior art date for the '420 and
13 '664 patents?

14 A. For both of them it is December 3rd of 1998.

15 Q. And what does that date mean?

16 A. That date means that in order to be qualifying prior
17 art, it would have to have been published prior to that
18 date.

19 Q. And what types of systems existed before that date?

20 A. Well, basically, there were two camps, two different
21 sets of systems. One was a search-based system, which
22 processed a query and retrieved the results. The other
23 camp was a profile or collaborative camp that had
24 long-term user needs or long-term user preferences, and
25 these systems filtered new incoming data for relevance

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1 to the filter and offered it to the person when it was
2 available. So one served an immediate information need
3 very quickly, that's a search, and the other one, a
4 long-term need, slowly.

5 Q. Can you pull up Dr. Carbonell's demonstrative.

6 Dr. Carbonell, I understand you have a simple
7 animation you wanted to walk the jury through to explain
8 the search systems?

9 A. Yes. I'm sure the jury is familiar with having used
10 search systems. Here we animate, essentially, how they
11 work, which is that information is collected from
12 external sources such as the web or it's already
13 available in internal sources such as libraries, files,
14 data bases. That information is aggregated in a
15 database and then an index is built. That index is
16 crucial to be able to search quickly.

17 That index is then made available to a query
18 server, as you can see on your bottom right-hand part of
19 the demonstrative, and then when the user issues a query
20 or a set of queries, a rank set or rank list of results
21 is offered back to the user, and that is based on the
22 index.

23 Q. Dr. Carbonell, what criteria is used to pull
24 information back to the user in a search system?

25 A. It's usually a query versus item match. Items are

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1 the things that are indexed. Terms are the words in the
2 query. And it's usually serving the immediate need of
3 the user as expressed in the query.

4 Q. And what do you mean by immediate need?

5 A. I mean the need that the user expressed at that
6 moment by virtue of formulating the query.

7 Q. Okay. And I understand that you have a similar
8 animation for profile systems?

9 A. Yes, I do.

10 Q. Before we get there, can you explain what you mean
11 by profile?

12 A. A profile is a long-term, long-standing need of one
13 user or of multiple users and uses shared profiles, or
14 shared parts of profiles can be used in the profiling
15 system to determine what to show to the first user.

16 So if another user with very similar interests
17 or needs has liked some books or some articles or some
18 items to purchase, then these are offered as potentially
19 relevant to the first user who is similar because of the
20 profile similarity.

21 Q. In a profile system, would I fill out a profile?
22 How would it be created?

23 A. It can be created in different ways. You can fill
24 it out over time. It could be based on things that you
25 have liked that the system has automatically extracted

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1 those features and put it into a profile, it can be
2 based on what other people have liked. If you liked the
3 same things that they have liked, you would essentially
4 borrow parts of their profile.

5 Q. Okay. Let's take a look at what you put together.

6 A. So the profile system in this demonstrative, instead
7 of searching the library for a book that this lady might
8 like, we match her to a collaborative profile, in other
9 words, find other people who have similar likes. That
10 goes to a persistent interest matching engine. That
11 means long-term interests are similar to others, and you
12 look at which other books the others have liked or which
13 other books are similar to books that she has liked in
14 the past. So she can be part of that group that you see
15 to your right, and that results in a recommendation. It
16 could be a single recommendation or it could be multiple
17 recommendations over time.

18 Q. What do you mean by over time?

19 A. I mean that a profile system does not represent an
20 immediate need. It represents a long-term standing
21 need, and the system, as new books come in or new
22 articles become available, it would be filtered through
23 the profile and then offered to the user.

24 Q. Would the user here, Dr. Carbonell, ask for the
25 books as new ones became available?

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1 A. No. That's not the way profile systems work. They
2 would establish a profile and they get recommendations
3 over time. It could be that these recommendations
4 accumulate, for example, the e-mail and the user chooses
5 to read the e-mail at a particular time or chooses to
6 read the recommendations once she is ready.

7 Q. Okay. So how would the prior art process result
8 from both systems?

9 A. Well, the prior art was divided into one or another
10 of these camps. It would either search their systems
11 that processed the query and provided immediate results
12 based on the immediate needs of a user, or they were
13 profile systems. At best, some prior art suggested that
14 the output of one could serve as the input to the
15 other. So, if you animate this slide, please.

16 Q. Sure. Would you walk the jury through this.

17 A. This shows the user using a query. The query server
18 producing a set of ranked results which are then,
19 metaphorically speaking, tossed over the wall to a
20 profile system, which then checks whether these results
21 are of interest to the long-term needs or long-term
22 likes of that user, producing some final results.

23 So in this case we see the output of the search
24 system or the query-based system serving as the input to
25 the profile system. Notice that in this case the query

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1 or the search criteria are not available to the profile
2 system in reading results.

3 Q. So is the query also passed over the wall to the
4 profile system?

5 A. No. The query is not passed over the wall and even
6 if it somehow were, the profile systems are not set up
7 to process a query. That is a search functionality.

8 Q. So what criteria would the profile system use on the
9 right-hand side of this demonstrative to select the
10 final results?

11 A. It would use the long-time profile, in other words,
12 the long-term information desires or preferences of that
13 user or those of other users which have very similar
14 profiles. So it is not a question answering or a query
15 serving process at all. It works very differently.

16 Q. Now, Dr. Carbonell, why is Mr. Lang and Mr. Kosak's
17 invention different from the prior art methods you
18 describe here?

19 A. Yes. Mr. Lang and Mr. Kosak worked in WiseWire,
20 which is a profile-based system or was at that time.
21 They were acquired by Lycos. Lycos was a search system,
22 and so now they had the combination of both approaches
23 available to them inside the same roof in Lycos.

24 What they did was find a way to tightly couple,
25 tightly integrate the two, collaborative analysis,

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1 content-based analysis with respect to a query, In other
2 words, to use the immediate information need, not just a
3 long-term standing need, of the users, and then filter
4 also with respect to the query, filter with respect to
5 the immediate need, not just simply filter with respect
6 to what they generally liked.

7 Q. Dr. Carbonell, in your review of the prior art, have
8 you seen any profile systems that would return results
9 with respect to relevance of the query?

10 A. No, I have not. This is unique.

11 Q. And, Dr. Carbonell, have you seen in prior art in
12 search systems that used the combination that you showed
13 here in yellow, collaborative and content data, to
14 provide results with respect to relevance to the query?

15 A. No, I have not seen that either. In particular,
16 search engines of the day were more primitive, if that
17 is an appropriate word, than the current ones and they
18 were struggling just to do a good job finding items that
19 were relevant to the query in the early days.

20 Q. In your opinion, Dr. Carbonell, would Mr. Lang and
21 Mr. Kosak's invention in the '420 and '664 patents
22 provide better results than the prior art systems you
23 studied?

24 A. Oh, they absolutely would, for more than one reason.

25 Q. Can you please explain those reasons?

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1 A. One is that you are now able to use multiple
2 criteria for selecting the information. You are able to
3 use criteria about the immediate need, as well as
4 criteria about what they generally like, as well as
5 criteria about what other people with similar likes or
6 even similar immediate needs, even similar queries would
7 have liked. That combination uses much more information
8 in making the selection, in making the ranking, in
9 making the filtering. That is the primary reason.

10 Another reason is that if you, quote, throw
11 something over the wall, the search results, you throw
12 them only by the criteria of search, not by the
13 relevance to the query, not by the criteria of other
14 things such as what they typically like, what their
15 friends typically like, and so forth. So you miss some
16 things. So after you filter them on a second pass, they
17 are only filtering those things that are actually
18 provided, not the ones that you missed that may have
19 proved better by the combination of all the criteria.
20 That's the results, surprising, in the sense they are
21 better.

22 Q. I believe Dr. Ungar testified that it would have
23 been easy to come up with what Ken Lang and Mr. Kosak
24 came up with. Did you hear that testimony?

25 A. I heard the testimony, yes.

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1 Q. Do you agree with that?

2 A. No, I definitely fundamentally disagree with that
3 testimony.

4 Q. Can you explain why?

5 A. Well, first of all, the two camps were indeed
6 separate. The camp that did the profile had no deep
7 knowledge of how a search method worked, and the same
8 was true the other way around. You needed somebody that
9 was well steeped in both camps to be able to see how to
10 do this tight integration and perform the profile and
11 content analysis with respect to the query and the
12 filtering also with respect to the query.

13 To attest to the difficulty, I was working in
14 the area at the time, the thought occurred to me that it
15 would be a good idea to do this and I failed to come up
16 with an effective method.

17 Q. Given the prior art you have reviewed in this case
18 and the prior art presented by Dr. Ungar, do you think
19 anyone else was successful prior to the December 3rd,
20 1998 coming up with the Lang and Kosak invention?

21 A. There's no evidence that anyone else was successful
22 or even close at the time.

23 Q. Okay. Dr. Carbonell, can you please provide the
24 jury with a summary of your opinions?

25 A. Yes. My opinions, in summary, are that all the

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1 asserted claims of the '420 patent are valid. This
2 would be claim 10 and 25 independent claims, and also
3 the dependent claims based upon them. All the asserted
4 claims of the '664 patent are valid. That would be
5 claim 1 and 26. Those would be the independent claims,
6 and all the dependent claims based on them.

7 In particular, no claim is anticipated by Bowman
8 or Culliss. Those are the two references cited by
9 Dr. Ungar as anticipating, and no claim is rendered
10 obvious in any of the patents by Balabanovic Lashkari,
11 Rose, Bowman and/or Culliss, or any combination thereof.

12 Q. I'm going to refer to the Balabanovic as Fab, okay?

13 A. Okay.

14 Q. Let's turn to your detailed analysis and start
15 talking a little bit about the technology. Before we
16 get there, though, can you please provide your
17 understanding of what anticipation is?

18 A. Yes. Anticipation means that a single prior art
19 must anticipate, in other words, must disclose and teach
20 every single element in a patent claim in the manner
21 described in that claim. So to turn that around, no
22 anticipation means that a claim is not anticipated if
23 even a single element of the claim is missing. In our
24 case, if it's missing from Bowman or Culliss.

25 Q. So what does it mean if a patent claim is

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1 anticipated?

2 A. Well, it means that every single one of the
3 elements, each and every one, must be contained in that
4 single prior art reference and, moreover, be used in a
5 combined in the manner described in the claim.

6 Q. And you heard Dr. Ungar testify that he believes two
7 references, Bowman and Culliss, anticipate and,
8 therefore, invalidate the '664 and '420 patent claims?

9 A. Yes, I have heard him testify.

10 Q. So for anticipation we only need to look at two
11 pieces of prior art?

12 A. Only the ones that he claimed anticipated.

13 Q. Okay. Let's look at the first one. Let's start
14 with Bowman. To keep it simple, let's focus our
15 analysis on claim 10 of the '420 patent. Is that okay?

16 A. That's okay. That's one of the independent claims.

17 Q. Okay. And then we will come back and talk about
18 some of the other asserted claims, okay?

19 In your opinion does Bowman anticipate claim 10
20 of the '420 patent?

21 A. Bowman certainly does not anticipate claim 10.

22 Q. Can you explain to the jury which claim elements you
23 believe are not shown in Bowman or disclosed by Bowman?

24 A. I will do so first with a reminder of the color
25 scheme that we are using, which is the same color scheme

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1 that was provided by Dr. Frieder and then also a color
2 code by Dr. Ungar. Yellow refers to search or query,
3 blue refers to content of items, green refers to
4 collaborative, and purple refers to filtering or
5 filtering combining relevance to the query.

6 So now to answer your question, it would be the
7 second and fourth claim, otherwise known as claim (b)
8 and claim (d) that were circled in red here, are not
9 anticipated.

10 Q. The ones settled in red you believe are missing from
11 the disclosure of Bowman; is that right?

12 A. That's exactly correct.

13 Q. Okay. So let's start with your description of what
14 Bowman actually teaches. How does the Bowman reference
15 work?

16 A. Okay. If you would bear with me a minute, I am
17 showing in this demonstrative a figure from Bowman.
18 It's Fig. 4. It shows what he calls the item rating
19 table or just the rating table.

20 The rating table contains number of clicks each
21 time a word and item appear. In other words, when the
22 user issued a query that contained the word "dynamics"
23 and different items were shown to the user -- these
24 items are by those long numbers here -- the column on
25 the right is a number of times a user clicked on it.

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1 So, if you would animate.

2 Q. Sure. What is shown here?

3 A. This is simply to illustrate that if a user typed
4 the word "dynamics" as a query, the document that begins
5 with 1883 was clicked on 23 times by other users. So it
6 would have the highest score according to that query
7 term in this example that he shows.

8 Q. Okay. Dr. Ungar believes that Bowman discloses the
9 content analysis in the manner called for by the
10 asserted claims; is that right?

11 A. He has stated as much. I disagree with him.

12 Q. Why do you disagree with him?

13 A. Well, as you saw on that item rating table, what
14 Bowman is doing is he's matching a query term against an
15 entry in the table. A query term against entry in the
16 table, not against the content of the items. It does
17 not look at the content of the items. He does not match
18 against the content of the items. In fact --

19 Q. Dr. Carbonell, up on the screen is a part of Bowman
20 DX-59, if you will read the passage in column 4:38 to
21 48. Can you explain whether that supports your opinion?

22 A. Yes. In fact, that very strongly supports my
23 opinion. This passage comes from two different parts of
24 Bowman, column 2 and column 4. It's clearly central to
25 the way his facility operates, and he says that the

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1 query results are produced in accordance with a
2 collective and individual user behavior. Collective and
3 individual user behavior. That is collaborative. That
4 is what other users have done in the past.

5 And then it goes on to say, "rather than in
6 accordance with the attributes of the items."
7 Attributes are the content of the items. He's saying
8 rather than. He's disallowing looking at the content.
9 He's teaching explicitly the behavioral part and
10 teaching away from the content part.

11 Q. So Dr. Carbonell, in your view what would this
12 sentence here circled in red say to a person in the
13 field in 1998 reading Bowman?

14 A. If a person of ordinary skill in the field was
15 reading Bowman, he would, she would, interpret it to
16 mean perform the search based on collaborative criteria
17 and collaborative criteria only.

18 Q. Now, Dr. Ungar in his analysis mentioned something
19 about matching in Bowman. Do you agree that discussion
20 in Bowman about matching provides a content analysis?

21 A. No, I disagree with that. Bowman does use the word
22 "matching," but he means matching to the rating table.

23 Q. Let's take a look here at DX-59, the Bowman patent
24 Fig. 9. Does Fig. 9 of the Bowman patent support your
25 view about what matching means?

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1 A. Yes. Not just Fig. 9, but Fig. 9 is a good
2 illustration. If we look at the second processing item,
3 901 that is called out in this figure, Bowman talks
4 about identifying entries matching the term having the 3
5 highest rating scores. So by matching, he's matching
6 the term, that is the word in the query, with the entry
7 which is in the rating table. So nothing about
8 content. He's looking at the rating scores. The rating
9 scores are user ratings, number of clicks, purely
10 collaborative, and Bowman is very clear on this.

11 Q. Okay. Dr. Carbonell, I believe you have up here a
12 demonstrative that was used by Dr. Ungar, DDX-3.59. Can
13 you explain how your view is different from Dr. Ungar's?

14 A. Yes. This demonstrative is one of Ungar's slides
15 where he characterizes or mischaracterizes my position
16 from a report that I provided earlier. He says -- he
17 cites to claim 29 of Bowman that uses the word
18 "matching," adjusting the ranking value for use in each
19 item in the query results to reflect the number of terms
20 specified by the query are matched. So he's just simply
21 pointing to the use of the word "matching." And as we
22 saw, the word "matching" is used to match the term in a
23 rating table in order to look at the number of clicks,
24 the number of times that people have liked -- the
25 popularity of the item, as it were. So matching means

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1 looking up the popularity. It does not mean looking at
2 the content or doing anything else with the content.

3 Q. Now, the color coding here is blue. What does blue
4 stand for?

5 A. Blue stands for content, and I believe that he is
6 wrong in that. So if we were to modify that coloring
7 scheme to make it green, collaborative, then I would
8 agree with his statement of what that frame is actually
9 disclosing.

10 By the way, the word "matching" must be used in
11 a consistent way throughout the patent description and
12 the patent claims.

13 Q. Yes. And Dr. Ungar has part of the patent
14 specification on the same page below the claim 29 we
15 just looked at. What does that passage say to a person
16 of ordinary skill in the art?

17 A. This, I believe, is the same passage that I have
18 shown earlier that Dr. Ungar highlighted. It says that
19 the individual user behavior rather than in accordance
20 with attributes of the items.

21 This basically supports my opinion, rather
22 than. The word could not be more clear that it says not
23 to do it with respect to the attributes of the item. So
24 it definitely does not look at content.

25 Q. Does this passage help you to understand what was

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1 meant by the word "matching" in Bowman?

2 A. This passage and the figure that we just saw and the
3 rest of the mentions of matching within Bowman. So your
4 answer is yes.

5 Q. In his direct testimony did Dr. Ungar take this
6 passage into account in his interpretation of the word
7 "matching"?

8 A. Insofar as I can see, Dr. Ungar conveniently ignored
9 this passage and many others that did not support his
10 opinion.

11 Q. Okay. Thank you, Dr. Carbonell.

12 Let's talk about filtering. Dr. Ungar testified
13 that Bowman discloses filtering in the manner recited by
14 the asserted claims. Do you agree with that opinion?

15 A. No, I disagree with that opinion.

16 Q. Why?

17 A. Well, because filtering is different from ranking
18 and Bowman discloses ranking and does not disclose
19 filtering.

20 Q. Okay. I believe that you have prepared a
21 demonstrative to explain the difference between
22 filtering and ranking. Can you provide your view of how
23 the industry would understand filtering and ranking in
24 1998?

25 A. Yes, I would. First let me apologize for my lack of

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1 artistic ability. Filtering operates by taking a set of
2 items, as you see on that group of cloud to the left,
3 and looks at one item at a time one by one and looks at
4 the one or more attributes of that item and then decides
5 whether to accept it or reject it, whether to keep it or
6 to throw it away. So filtering is done with a fixed
7 criterion, a criterion that does not depend on the other
8 items, and it does the processing one at a time without
9 comparing one item to another.

10 Q. And ranking?

11 A. And ranking in contrast takes the same input, a set
12 of items, but then compares them with each other. It
13 uses a ranking function or a ranking score, for example,
14 popularity, as Bowman does, and then outputs a rank
15 list, also known as a sorting list. Ranking and sorting
16 are very similar concepts. So the outputs are very
17 different. Instead of a region set and subset, it
18 operates a rank list.

19 I also should mention that a filtering system
20 could accept everything or could reject everything. It
21 doesn't have to have members of both of those sets.

22 Q. So why would a person of ordinary skill in the art
23 in 1998 use filtering versus ranking?

24 A. They would use filtering if all they wanted to do
25 was to select some items that were, for example, of very

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1 high quality and they have none, in which case the
2 accepts would have been empty, or it could have been
3 many, in which case that set would dominate the rejects
4 set.

5 To rank them would be putting them in order.
6 Even the one at the top of the order could be low
7 quality or the top of the order in many more could be of
8 high quality. Ranking is just a different kind of
9 operation. Search engines typically rank because you
10 have to have some output. So, the best you can, whether
11 it's good or not.

12 Q. Now, Dr. Carbonell, I believe you have a witness
13 binder in front of you?

14 A. Yes, I do.

15 Q. Hopefully it's pretty thin. Can you take a look at
16 PX-434?

17 A. Yes, I have it here.

18 Q. Can you identify this document?

19 A. Yes. This document is an article written by David
20 Lewis of AT&T Research. It pertains to the so-called
21 TREC evaluations. TREC is an evaluation conducted by
22 the U.S. Department of Commerce through the National
23 Institute of Standards and Technology. They are
24 evaluations of different kinds of information retrieval
25 and information processing systems.

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1 MR. CIMINO: Your Honor, we would seek to admit
2 PX-434 into evidence.

3 THE COURT: Any objection?

4 MR. NELSON: Well, your Honor, it wasn't
5 discussed in his report, but it's in the materials
6 considered. So we can move it along, I am fine with
7 that.

8 THE COURT: All right. It will be admitted.
9 (Plaintiff's Exhibit 434 was admitted.)

10 MR. CIMINO: I have to add an objection. I do
11 disagree that it was not discussed in his report, but we
12 can move on.

13 So, your Honor, the next demonstrative pulls up
14 a passage from that. I would like to be able to have
15 that published for the jury.

16 THE COURT: All right.

17 MR. CIMINO: I believe the rest of the
18 presentation is all based on either demonstratives or
19 admitted exhibits, your Honor.

20 BY MR. CIMINO:

21 Q. Dr. Carbonell, is your understanding of filtering
22 consistent with how those in the field refer to the
23 method?

24 A. It is completely consistent, yes.

25 Q. Can you explain how the TREC article you just

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1 mentioned, PX-434, supports your opinion?

2 A. Yes. The U.S. Department of Commerce through the
3 National Institute of Science and Technology -- I will
4 abbreviate that as NIST -- wanted a way to evaluate the
5 science or evaluate the technology, primarily the
6 technology. It had a retrieval conference called TREC
7 which had more than one TREC, more than one part of that
8 conference.

9 One part of that conference focused on
10 filtering, a different part focused on ad hoc retrieval,
11 and so on. The abstract of this paper describing the
12 TREC-4 conference -- this would be the fourth time the
13 evaluations were done -- stated that the TREC-4
14 filtering track was an experiment in the evaluation of
15 binary text classification systems, accept or reject --
16 that's binary -- in contrast with ranking systems.

17 So the field was using classification or, in
18 this case, filtering. Binary classification and
19 filtering are the same thing. We were contrasting it
20 with ranking systems with a separate evaluation for
21 ranking systems for what they call the ad hoc retrieval
22 track. That's the only point I really wish to make
23 here. The paper goes on in scientific detail as to how
24 each evaluation was conducted.

25 Q. Do you know whether Dr. Ungar agrees that filtering

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1 and ranking are different?

2 A. Well, originally Dr. Ungar disagreed, but he changed
3 his opinion and by the time he testified, he stated that
4 they are indeed different. So the witness for the
5 defense and I have the same opinion.

6 Q. Now, in Bowman, does Bowman discuss presenting its
7 results through filtering or ranking?

8 A. Through ranking.

9 Q. Dr. Ungar in attempting to show that Bowman
10 discloses filtering mentioned a term called subsetting.
11 Do you remember that?

12 A. Yes.

13 Q. Is there a difference between subsetting and
14 filtering?

15 A. Yes, there is. If I may have the next slide.

16 Q. Can you please explain the difference?

17 A. Okay. The part on the left is filtering. I am not
18 going to walk you through it a second time. The part on
19 the right is a one additional step performed after
20 ranking. So subsetting means that you first rank the
21 items according to a score. That's the one at the top,
22 for example, and so on down the list. And then you take
23 that sorted list and you snip it, you say I'm going to
24 keep the top 3 or the top 10. Search engines typically
25 return the top 10 best results. That is a subset.

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1 You could also subset with respect to a ranking
2 value. For example, the median value and keep the top
3 half of that list. Notice that subsetting is with
4 respect to the rank list. It's not an item-by-item
5 selection. It is not based on the specific properties
6 of the item. Hence, it is quite different from
7 filtering.

8 Q. Dr. Carbonell, does ranking occur first when you do
9 a subsetting technique?

10 A. Ranking is a requisite step to do subsetting.

11 Q. Okay. Well, let's take a look at Bowman. Does
12 Bowman's discussion of subsetting meet the filtering
13 requirement of the asserted claims?

14 A. It does not. Bowman describes the subsetting
15 process that I have just described quite clearly. First
16 he talks about ranking, generating ranking values for
17 the items, and then he talks about ordering the items,
18 that is, putting them in a rank list, and then he talks
19 about subsetting the items, that is, keeping part of
20 that rank list. He's very clear on his description.

21 Q. Do you recall what Bowman describes as the criteria
22 for subsetting?

23 A. Bowman describes two possible criteria for
24 subsetting. One of them is keeping a fixed number of
25 items, the top 3 or top 10 or top 20. And the other one

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1 is based on a ranking value, a particular value that was
2 generated while the ranking was being done and he
3 decided to keep all the ones above that value.

4 Q. Okay. So up on the screen I believe you have
5 another demonstrative that Dr. Ungar used, DDX-3.57.

6 A. That's correct.

7 Q. What is your take on Dr. Ungar's position that
8 Bowman discloses filtering?

9 A. Well, Dr. Ungar merely states it discloses
10 filtering. He does not argue why it discloses
11 filtering, and he is wrong with respect to Bowman
12 disclosing filtering. You see on the top left that's a
13 recitation of claim element (b) of claim 10 of the '420
14 which requires content-based filtering. Of course, it
15 is not content based, as we discussed before. It is
16 also not filtering.

17 Ungar cites to Bowman in a different part than
18 the one that I cited, which says pretty much the same
19 thing. In "Step 808 preferably involves sorting the
20 items in a query result --" sorting, that's the same
21 thing as ranking, "-- in decreasing order of their
22 ranking values --" he's using ranking values in the
23 exact same way I described before, "-- and/or subsetting
24 the items in the query to include only those items above
25 a threshold ranking value." So he has to generate the

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1 ranking values and pick one for the median or one that's
2 close to the top so you can only return the top results
3 and use that as the subsetting guide after he has the
4 rank list. So this is clearly subsetting as I described
5 it and not filtering.

6 Q. Okay. Dr. Carbonell, I believe here you have
7 DDX-3.68. This was Dr. Ungar's summary of all the
8 disclosures in Bowman that met the claim elements. Do
9 you agree with this?

10 A. No, I disagree with this.

11 Q. Where do you disagree?

12 A. I disagree with respect at least with respect to
13 claim element (b) and claim element (d). Bowman does
14 not disclose content-based anything and does not
15 disclose a filtering system, and those two claim
16 elements are not disclosed or taught by Bowman and,
17 hence, Bowman does not anticipate claim 10.

18 Q. And in your opinion is claim 10 of the '420 patent
19 valid over Bowman then?

20 A. Since it is not anticipated by Bowman, it is valid
21 over Bowman, yes.

22 Q. Okay. Thank you.

23 Let's move to the second prior art reference.
24 What is the second prior art reference that Dr. Ungar
25 asserts is anticipated?

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1 A. Yes. That is a patent by Gary Culliss.

2 Q. And, Dr. Carbonell, like you did on Bowman, let's
3 focus just on claim 10 of the '420 patent for now to try
4 to keep this as simple as possible.

5 Do you believe that claim 10 of the '420 patent
6 is anticipated and, therefore, invalid over Culliss?

7 A. No, I do not believe that claim 10 is anticipated
8 and so, therefore, claim 10 is valid over Culliss.

9 Q. Which claim elements do you believe are missing in
10 Culliss?

11 A. It is the same ones that were missing under Bowman.
12 That would be claim element (b) and claim element (d),
13 the two that are circled in red.

14 Q. The two circled in red?

15 A. Yes.

16 Q. Okay. So like with Bowman, let's first start by
17 having you describe to the jury how Culliss would
18 actually work.

19 A. Yes, actually Culliss works in a way that is very
20 similar to Bowman so maybe I can make my description a
21 little more rapid. Bowman discloses something he calls
22 a rating index. That rating index is very similar to --
23 excuse me, Culliss. I misspoke. Culliss describes a
24 rating index that is very similar to Bowman's rating
25 table. Culliss states that his invention monitors

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1 searching activity, that is, selections and clicks by
2 different users to organize articles in accordance with
3 the searching activity of one or more users. Purely a
4 collaborative process.

5 Q. How would it monitor searching activity?

6 A. It will take into account what queries were issued,
7 what were the terms in those queries, and then what was
8 clicked by the user of the different squares or
9 summaries generated in the results page, whether they
10 clicked on No. 1 or they clicked on No. 3, or clicked on
11 both and not the others.

12 Q. Okay. I believe you just read from column 2:62-64.
13 You also show here a part of the specification at column
14 4:57-64, an index at the bottom of this demonstrative.
15 Can you explain for the jury what that index is and how
16 it would work?

17 A. Yes. That index is what he calls his rating index.
18 Alpha and Beta are meant to stand for query terms like
19 "human" or "dynamics" that we saw earlier. And then A1,
20 A2 and A3, that represents articles -- that's why he
21 calls them A -- or items. And the numbers represent the
22 clicks. So, for example, if you look under Gamma, A2 --
23 excuse me, A3 has two clicks under that index. So,
24 again, this rating table is purely collaborative in the
25 instruction.

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1 Q. And how would Culliss then serve results in
2 accordance with this index?

3 A. Culliss will look up in the index, it would match
4 the query terms against the index entries and it would
5 output the ones that have the highest number of clicks,
6 the most popular ones, the ones that were most liked by
7 other users or by the same user.

8 Q. Now, Dr. Carbonell, Dr. Ungar testified that Culliss
9 discloses content analysis in the manner called for by
10 the asserted claims. Do you remember hearing that
11 testimony?

12 A. I remember hearing it.

13 Q. And do you agree with that?

14 A. No, I certainly disagree with that.

15 Q. Okay. Pull up part of DX-58, the Culliss patent.
16 Here's the abstract.

17 Can you explain to the jury why you don't
18 believe Culliss teaches the content elements as required
19 by the asserted claims?

20 A. Because Culliss specifically teaches or discloses
21 the collaborative or popularity-based aspect.

22 We see here as users enter search queries and
23 select articles, the scores are altered. These are the
24 scores in that rating index that I just mentioned. The
25 scores have been used in subsequent searches to organize

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1 the articles that match a search query. So he used the
2 scores, the number of clicks that users have done. If
3 they liked article 3 and not liked article 1, article 3
4 will come up the next time. Culliss thinks that this is
5 a good way for searching, a collaborative way.

6 Q. And that would not take into account the content of
7 the article?

8 A. That process does not take into account the content
9 of the article at all. It takes into account the search
10 terms and it takes into account the popularity of the
11 articles.

12 Q. Well, Dr. Ungar testified that Culliss's index,
13 which we just saw, could be initialized with a content
14 analysis. Do you recall that?

15 A. I recall that.

16 Q. So, first, what does it mean that the index could be
17 initialized?

18 A. Okay. Let me explain initialization a little bit.
19 Initialization means before you start, before the system
20 starts to function you can have some initial values.
21 They could all be blank, zero. They could all be set by
22 a human. In fact, Culliss discloses both of those
23 possibilities. Culliss also says that the initial value
24 could be set by whether a term is contained in an
25 article or the number of times that term is contained in

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1 an article. That would be the initialization step.

2 Q. Well, what role does initialization play in the
3 index in serving results?

4 A. It plays virtually no role whatsoever. As you will
5 see later in another example, Culliss itself ignores the
6 initialization.

7 If we look at the highlighted region of the
8 abstract, Culliss is talking about millions of people
9 using the Internet typing in millions of queries. That
10 was back in 1998. Today we are talking about billions
11 of queries being served. So you would have billions of
12 click-throughs having initialization value of 1,
13 regardless of how that was arrived at, becomes totally
14 immaterial. Or even in this subsetting value of 3, the
15 word would occur 3 times.

16 So the initialization is immediately swamped by
17 the use of the system in the Internet over time. So it
18 doesn't matter how the initialization was done. The
19 initial operation of the system is purely collaborative,
20 pure profile, pure popularity-based system, and that's
21 what governs.

22 Q. Okay. How many figures are there in the Culliss
23 patent?

24 A. There's only one figure in Culliss's patent and that
25 is the one that you see before you here.

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1 Q. Does this figure describe the operation of the
2 Culliss system?

3 A. Yes, it does. That's why Culliss put the figure in
4 there in the first place.

5 Q. Does this figure describe content analysis?

6 A. The figure does not describe content analysis.

7 Q. What does the figure describe about the operation of
8 the Culliss patent?

9 A. It describes the normal operation of the Culliss
10 system. If we look at the top -- I'm sorry that my
11 glasses are not great -- the first step he's talking
12 about receiving a search query from the first user. The
13 next step, Step 20 is presenting articles. The third
14 step is allowing the first user to select one or more
15 articles. That means to click on one or more articles.
16 And then you alter the index according to the
17 selections. In other words, you add one if the person
18 liked it and don't do anything if the person did not
19 click on it.

20 Then when you get a search query from another
21 user, the user's popularity rating table. So he's
22 describing the operation of it. He doesn't even bother
23 to mention the initialization step in his figure because
24 it is irrelevant for the normal running of the system.

25 The last step, by the way, when he presents the

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1 article, he presents it in ranked order, so he's
2 disclosing ranking and not filtering, in addition to not
3 doing any content analysis.

4 Q. Okay. Thank you.

5 So just on the content analysis, do any of the
6 boxes, 10, 20, 30, 40, 50 or 60 that describe the
7 operation of Culliss, provide any information about a
8 content analysis for selecting the results?

9 A. No, they do not. They all refer to the
10 collaborative process. Not a single step refers to
11 content.

12 Q. All right. Let's move on to the other issue of
13 filtering. Dr. Ungar testified that Culliss discloses
14 filtering is embodied in the asserted claims. Do you
15 agree?

16 A. No, I disagree.

17 Q. And why is that?

18 A. Well, first of all, Culliss -- there's more than one
19 part to Culliss's patent. The main part is the main
20 facility, the one that we just described now, discloses
21 only ranking. I don't know whether the next slide
22 demonstrates that as well or not.

23 Q. Well, first of all, you mentioned facility. Can you
24 explain to the jury what you mean when you say the
25 Culliss facility?

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1 A. Facility is the Culliss system. I'm using the word
2 that Bowman used to describe his system. He called it a
3 facility. So I'm using the same word both in Culliss
4 and Bowman.

5 Q. Okay. Dr. Ungar, I believe, when he talked about
6 Culliss teaching filtering referred to the rating index
7 here in DX-50 in the Culliss patent at column 2, line 63
8 to column 3, line 2. Do you believe that the ratings
9 index discloses filtering?

10 A. I believe that the -- first of all, let me explain.
11 The main part of the Culliss patent is exactly what we
12 described before. It's an add-on part where he's
13 disclosing a rating system. You see that figure here in
14 front of you from the Culliss patent describing the
15 other part, and that other part purports to disclose
16 filtering. First of all, it is not content-based
17 filtering and, second, it's not even a workable
18 filtering.

19 Q. What do you mean by it's not a workable filter?

20 A. So, you bear with me a bit, I will explain what
21 Culliss has described.

22 Q. Yes, please do.

23 A. Okay. So Culliss described a method that he claims
24 is useful for ratings. In this case he's talking about
25 G-rated and X-rated for material. G-rated being

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1 appropriate for everybody and X-rated being appropriate
2 for only adults.

3 He gives an example of a table in which he has
4 initialized, this is the early step, initialized A1 and
5 A3 to be G-rated and A1, A2 and A3 to be X-rated.

6 First of all, that is initialization strikes me
7 as somewhat absurd because A1 and A3 are rated as both
8 G-rated and X-rated, but nonetheless, Culliss quickly
9 dismisses the initialization step anyway, so it actually
10 doesn't matter. This initialization, whether
11 content-based or otherwise, plays no role.

12 This table shows after the system has been in
13 use for a while or the facility has been in use for a
14 while that G-rated people liked both A1 and A3 because
15 they clicked on A3, 21 times after it was shown to them
16 22 times, and they clicked on A1 all 4 times it was
17 shown to them. And the adults liked A3 a lot. They
18 clicked on it 45 times out of 45, but they did not like
19 A1 and A2 as much. They only clicked on it twice, even
20 though it was shown more often.

21 From that Culliss concludes that A3 must be
22 X-rated. I'm not sure how he concludes that. Both the
23 G-rated and the X-rated people liked it. Maybe just
24 because the adults liked it, he concludes that it must
25 be X-rated.

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1 Of course, adults can like all kinds of things
2 that are not X-rated. Even if it was adult males, they
3 could like football, they could like popcorn while they
4 watched the football. They could like a number of
5 things that are completely appropriate for G-rated. You
6 would not want to deny the children their popcorn also
7 because their fathers also liked the popcorn.

8 Moreover, even if it worked in the manner
9 Culliss describes, it would require the G-rated crowd to
10 view X-rated material, if A3 is indeed X-rated material,
11 22 times prior to it being finally labeled X-rated.

12 So my conclusion is this so-called rating system
13 is absurd. It does not work. It does not provide what
14 Culliss wishes. Culliss is trying to come up with a way
15 of rating based on collaborative feedback data. The way
16 that he describes it, by his own example, just doesn't
17 work.

18 Q. Okay. Thank you, Dr. Carbonell.

19 Up is one of Dr. Ungar's slides about claim
20 element 10(d), DDX-3.107. What is your take on
21 Dr. Ungar's conclusion here?

22 A. Well, Dr. Ungar has two conclusions, both of which
23 are wrong. The first conclusion is he claims that
24 Culliss teaches a content profile, because of that
25 initialization step that we have already discussed and

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1 dismissed as irrelevant, that's the blue one at the top.

2 Second, he claims that it discloses a filter
3 system combining data because Culliss is talking about
4 altering items in the index. For the life of me, I
5 can't see how altering refers to combining or
6 filtering. All it's doing is adding one to the
7 collaborative score. He's clearly in a collaborative
8 area. Even Dr. Ungar colors that part green, but
9 altering a score means you add one to the score. The
10 person clicked on it, he liked it, so, therefore, the
11 score is now bigger. That is not combining; that is not
12 filtering. So, therefore, I disagree with both parts of
13 his slide here.

14 Q. I believe you have colored some more of 10(d) here
15 to make your point?

16 A. Yes, I colored some more because Dr. Ungar failed to
17 color the filtering part that is also required by this
18 claim element, so I extended the color.

19 Q. Okay. Again, now, we have the summary of the
20 anticipation slide that Dr. Ungar used for Culliss. Do
21 you agree that there should be a check in each of these
22 boxes?

23 A. No, I disagree.

24 Q. Why?

25 A. Because Culliss does not teach claim element (b) and

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1 he does not teach claim element (d). Therefore,
2 Culliss's contention is incorrect, and the claim is not
3 anticipated by Culliss.

4 Q. Thank you, Dr. Carbonell.

5 So we just went through claim 10 of the '420
6 patent for both Bowman and for Culliss. Let's talk about
7 the other asserted claims.

8 A. Okay.

9 THE COURT: Before you start, let's just take a
10 15-minute break before you start on the other asserted
11 claims.

12 MR. CIMINO: Yes, your Honor.

13 THE COURT: All rise.

14 (Jury out.)

15 THE COURT: You may step down.

16 (A recess was taken at 11:40 a.m., after which
17 court reconvened at 12:08 p.m.)

18 MR. BROTHERS: Your Honor, before you bring the
19 jury back in, I would like to raise one issue with the
20 Court.

21 With respect to the ruling this morning, I want
22 to alert the Court that we believe its procedurally
23 improper because once the Court found that the burden had
24 shifted after they presented their evidence in their
25 case, in our rebuttal case we are permitted to respond to

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1 their evidence of laches because they have the initial
2 burden of going forward. So for the Court to have ruled
3 prior to the receipt of our evidence, we believe is
4 procedurally improper, that we should have had an
5 opportunity to present evidence and we would propose
6 calling Mr. Blais as a rebuttal witness -- it was
7 disclosed in the pretrial order -- to explain with regard
8 to what was going on at Lycos because he joined Lycos in
9 2005. But to do that, we need to get him down here
10 immediately.

11 And we would also make proffers with regard to
12 other evidence, but we can take that up later as long as
13 your Honor is willing to receive this evidence.

14 THE COURT: Thank you.

15 Mr. Brothers, you can have a seat.

16 MR. BROTHERS: Thank you.

17 THE COURT: There's two things the Court didn't
18 do that it usually does a few minutes ago. Indicate to
19 counsel the Court reserves the right, and frequently
20 does, in a written memorandum order to explain its
21 ruling.

22 Second, you indicated, and the record will
23 reflect, that you had one rebuttal witness that you were
24 calling, and that was Dr. Carbonell on the question of
25 validity. So the Court did not rule foreclosing you an

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1 opportunity to put on rebuttal evidence on the issue of
2 laches because you told the Court -- the Court was aware
3 of it -- that you were calling one witness, and the Court
4 ruled based upon what was then a complete record on this
5 issue.

6 Secondly, in terms of you providing written
7 submissions, the Court indicated it was ruling
8 yesterday. You never indicated that, Judge, after you
9 made your oral presentation, we want an opportunity to
10 file a written response, though it might be short, and
11 you didn't say it this morning when the Court commenced
12 to rule on laches. You only said it after the Court made
13 an adverse ruling, just as you are now bringing up the
14 question about you have not had an opportunity to rebut
15 after you told the Court that you only had one witness
16 left, and this was the witness that's on the stand.

17 So at this juncture, the Court hears you. The
18 Court is not granting that opportunity. The Court will
19 keep in mind what you said, but I'm telling you, you had
20 a full opportunity and you told the Court you were only
21 bringing Dr. Carbonell. You expressed no interest in
22 bringing anybody in here on the question of laches.

23 Bring in the jury.

24 (Jury in.)

25 THE COURT: You may be seated.

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1 Let the record reflect all jurors are present in
2 the courtroom. Does counsel agree?

3 MR. NELSON: Yes, your Honor.

4 MR. CIMINO: Agreed.

5 THE COURT: Okay. You may continue.

6 MR. CIMINO: Thank you, your Honor.

7 BY MR. CIMINO:

8 Q. Dr. Carbonell, before we broke, you were going to
9 talk about the other asserted claims in your opinions
10 about validity. Do you remember that?

11 A. Yes.

12 Q. We have already done claim 10 of the '420 patent and
13 you provided your opinions on Bowman and Culliss with
14 respect to that claim, right?

15 A. Correct. I provided the opinion that Bowman and
16 Culliss did not anticipate that claim.

17 Q. Okay. So let's look at the other claims. First,
18 does Bowman anticipate claim 25 of the other independent
19 claim of the '420 patent?

20 A. No. Bowman does not anticipate claim 25 of the
21 '420. It's a method claim otherwise equivalent to claim
22 10.

23 Q. And why doesn't it anticipate?

24 A. For exactly the same reasons that claim 10 is not
25 anticipated.

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1 Q. Okay. Up on the screen, on the right side of the
2 screen is Dr. Ungar's chart for claim 1 of the '664
3 patent. Does Bowman anticipate claim 1 of the '664
4 patent?

5 A. No, Bowman does not anticipate claim 1 of the '664
6 patent.

7 Q. Can you explain why not?

8 A. Because it does not meet claim element (c) which
9 requires content-based filtering with respect to the
10 query.

11 Q. Is your analysis in any way different from your
12 analysis for the '420 patent?

13 A. No, it's the same analysis.

14 Q. Okay. How about claim 26, the other independent
15 claim of the '664 patent, what does that claim require
16 and do you believe that it's anticipated by Bowman?

17 A. Claim 26 of the '664 patent is a method claim
18 corresponding to claim 1 and it is also not anticipated,
19 and it's not anticipated for the same reasons that claim
20 1 of the '664 is not anticipated.

21 Q. Okay. Let's talk about Culliss. Again, you have
22 provided an opinion about claim 10 of the '420 patent,
23 correct?

24 A. That's correct.

25 Q. How about claim 25 of the '420 patent, do you

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1 believe that claim 25 of the '420 is anticipated by
2 Culliss?

3 A. Claim 25 of the '420 patent, as I mentioned before,
4 is a method version of claim 10 of the '420 and it is
5 not anticipated by Culliss because he fails to disclose
6 claim element (b) or (d) of the that claim and, hence,
7 is not anticipated for the same reasons that claim 10 is
8 not anticipated.

9 Q. How about claim 1 of the '664 patent, does Culliss
10 anticipate claim 1 of the '664 patent?

11 A. Culliss does not anticipate claim 1 of the '664
12 patent. It does not disclose the third claim element,
13 element (d).

14 Q. You show that down here in the bottom right-hand
15 corner?

16 A. Yes.

17 Q. And how about claim 26 of the '664 patent, in your
18 opinion does Culliss anticipate claim 26?

19 A. No. Once again, claim 26 is a method claim
20 corresponding to claim 1 of the '664 and Culliss does
21 not anticipate that claim for the same reasons that
22 Culliss does not anticipate the claim 1 for the '664.

23 Q. Okay. And there are some dependent claims that are
24 asserted in this case. Are any of the dependent claims
25 asserted by Bowman or Culliss?

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1 A. Without going into each one of these dependent
2 claims, they are all dependent upon one of these four
3 independent claims and they are not anticipated, at
4 least because the independent claims on which they
5 depend are themselves not anticipated.

6 Q. So, Dr. Carbonell, in your opinion is there any
7 asserted claim anticipated by Bowman or Culliss?

8 A. No, none of the asserted claims are anticipated by
9 either Bowman or Culliss.

10 Q. Does that complete your anticipation analysis?

11 A. Yes, it does.

12 Q. Okay. Let's move on to obviousness. Can you
13 provide a brief overview of your obviousness
14 conclusions?

15 A. Yes. My conclusions are that the asserted claims of
16 the '420 and '664 are not rendered obvious by the cited
17 prior art, namely the Lashkari, Fab and Rose by
18 themselves or in combination with Culliss are not.

19 Q. Lashkari, Fab and Rose, are those the three pieces
20 of prior art that Dr. Ungar identified for the purposes
21 of obviousness?

22 A. Those are exactly the three that he identified, yes.

23 Q. Now, did you hear Dr. Ungar testify that all
24 elements of the asserted claims are shown in the prior
25 art?

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1 A. He has indeed testified to that.

2 Q. Do you agree with that?

3 A. No, I disagree. I believe that there are claims
4 that are entirely missing -- claim elements, excuse me,
5 that are entirely missing from the cited prior art.

6 Q. Can you explain that opinion to the jury, please?

7 A. Yes. It is not possible to render obvious by
8 combining claim elements if some of the claim elements
9 are not disclosed or taught by any of the cited prior
10 art. In particular, four claim elements are missing
11 from all of the cited prior art.

12 As we can see in this demonstrative here, claim
13 (d) of the '420 -- excuse me, element (d), claim 10 of
14 the '420, element (d) of claim 25 of the '420, element
15 (c) of claim 1 of the '664 and element (c) and (d) of
16 claim 26 of the '664.

17 Q. And what is the consequence of obviousness if there
18 are elements missing from all cited prior art?

19 A. It means that it is not possible for the cited prior
20 art to render the asserted claims obvious. You cannot
21 combine that what you don't have.

22 Q. Now, earlier you talked about having two camps of
23 prior art. Do Rose, Lashkari and Fab fall into either
24 of those two camps?

25 A. Yes, they do. As you can see, this is the

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1 non-animated version of my earlier demonstrative. All
2 three, Lashkari, Fab and Rose, fall into the profile
3 system side, in other words the right side of this wall.

4 Q. So they should be shown on the right side?

5 A. That's right.

6 Q. Do Rose, Lashkari or Fab, the filtering aspect in
7 ranking, do either of them have access or use of the
8 query?

9 A. Yes. First, Rose does not teach filtering. It
10 mentions it, but does not teach us how to do it, and
11 none of the three describe how to perform any of their
12 operations with respect to the query. In fact, none of
13 them use the query, none of them access the query, none
14 of them process the query, none of them filter with
15 respect to the query, none of them perform the content
16 or collaborative analysis with respect to the query.

17 Q. So, Dr. Carbonell, over here on the right side where
18 it says profile system, you have Rose, Lashkari and Fab,
19 what criteria do they use to select the final results
20 for the user?

21 A. Well, they do not use the query. Instead they use
22 the longstanding profile, the set of things that each
23 person or each user is interested in, and the set of
24 things which other users have a longstanding interest in
25 if their first user's interests match theirs.

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1 Q. Now, you heard the testimony of Dr. Ungar in court?

2 A. Yes, I have.

3 Q. Does he agree that profile systems and search
4 systems are different?

5 A. He agrees that they are indeed different, as you can
6 see from his quote here. He says that they are
7 different, they being the profile systems are different
8 from the demand search systems. So the answer is yes.

9 Q. Okay. Dr. Carbonell, so what is the difference
10 between the profile systems of Rose, Lashkari and Fab
11 and the Lang and Kosak invention?

12 A. Well, Lang and Kosak disclose a tight integration
13 among all of the different parts. As you can see here
14 from element (d) of claim 10 of the '420 and element (c)
15 of claim 1 of the '664, they require all of the
16 components, the filtering, the combining, the pertaining
17 feedback data, the content profile and the relevance to
18 the query to be tightly or closely integrated. In fact,
19 they perform all of those operations, the filtering, the
20 combining with the feedback with respect to the query.
21 That is something that all of the cited prior art fails
22 to do.

23 Q. In your opinion is it better to do it this way than
24 the Lang and Kosak tightly integrated way, rather than
25 the over-the-wall method that you explained earlier

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1 about how the prior art would take the output of one
2 system and use it as an input of another system?

3 A. It is indeed better to do the Lashkari integration.
4 I think I have alluded to this before. If you perform a
5 multi-factor analysis, you combine the content, you
6 combine the profile, you combine the collaborative and,
7 most importantly, you combine the immediate information
8 need as represented in the query in order to find the
9 best possible items that satisfy a combination of all of
10 these ingredients. That yields better results. That's
11 why this reflects the current practice.

12 Q. Okay. Dr. Carbonell, let's take a closer look at
13 the three pieces of prior art Dr. Ungar identified for
14 obviousness, and let's start with Rose.

15 So, can you tell the jury which elements you
16 believe are missing from the Rose patent? And, again,
17 let's start with claim 10 of the '420 patent so we have
18 got a consistent base by which to have you explain your
19 opinions.

20 A. Okay. Let's do that. It's claim element (a), (b)
21 and (d). Those are the three circled in red are missing
22 from Rose. Rose does not scan a network and find items
23 relative to a query. Content-based analysis is not
24 relevance to the query, and Rose does not teach
25 filtering or combining with relevance to the query.

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1 Q. Let's scroll down a little bit. Does Rose teach
2 filtering in the manner required by the asserted claims?

3 A. Actually, Rose does not teach filtering in that
4 manner. Rose teaches ranking. It mentions ranking
5 throughout, as you can see from this passage which I
6 will save time by not reading.

7 Rose does mention filtering, but doesn't mention
8 out how to do the filtering or how to combine it.

9 Instead, it mentions and teaches that one should rank.

10 Q. Okay. Dr. Carbonell, does Rose teach relevance to
11 the query in a manner required by the asserted claims?

12 A. No, Rose does not teach relevance to the query. In
13 fact, Rose doesn't have a query, doesn't have access to
14 a query. Instead, Rose has a basic profile system
15 focusing on long-term likes, long-term needs, long-term
16 interests of users.

17 This is an example of Fig. 7 from Rose in which
18 it is updating and making recommendations about movies
19 to a particular user. You can see on the right that it
20 says movie recommendations and it's an had ordered list,
21 a rank list. It's ranking, that is disclosing, and
22 ranking with respect to filtering. Excuse me, I said it
23 wrong. Ranking with respect to the items that it is
24 recommending in this case with respect to profile is
25 what I meant to say.

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1 Q. Would the recommendations here be developed over a
2 long-term need or an immediate need?

3 A. It will be developed over a long-term need. The
4 movie recommendations are based on what movies they
5 liked and it would be updated if they liked other
6 movies, and it would be updated with other people with
7 similar tastes who have seen other movies, and so on.
8 It's a long-term profile, long-term needs.

9 Q. So in your opinion, Dr. Carbonell, does Rose make
10 claim 10 of the '420 patent obvious?

11 A. No, it does not, for the reasons cited, lack of
12 teaching filtering and, particularly, lack of teaching
13 filtering with respect to the query. It fails to meet
14 three of the claim elements.

15 Q. What about the other asserted claims?

16 A. It doesn't render obvious claim 25 of the '420, for
17 example, for the same reasons, that is it's a method
18 version of claim 10.

19 It also does not render obvious the '664 claims,
20 claim 1 and claim 26, because it does not perform any of
21 the operations with respect to the query.

22 Q. Okay. Thank you.

23 Let's move on to Lashkari. Let's put up claim
24 10 of the '420 patent.

25 Do you believe there are elements missing in

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1 Lashkari that are in claim 10 of the '420 patent?

2 A. Yes, I do. The missing elements are, once again,
3 (a), (b) and (d), the same missing elements as for Rose,
4 because Lashkari does not teach to do anything with
5 respect to the query. It does not process the user's
6 immediate information need.

7 Q. Okay. Let's take a look at that.

8 Does Lashkari teach relevance to the query in
9 the manner required by the asserted claims?

10 A. Lashkari does not. As evidence of that, we take
11 Lashkari's own summary of his method, the ACF
12 algorithms. Those are the ones Lashkari disclosed.
13 Take the following steps. He then elaborates on the
14 steps, but you can see here in summary, he constructs a
15 profile of a user, a profile, not a query, long-term
16 need, long-term interest.

17 It compares the profile to the profile of other
18 users, collaborative. Profile again.

19 It constructs a set of nearest neighbors for
20 this user. That just simply means other users with
21 similar preferences.

22 And then it uses that set to make
23 recommendations. So it doesn't provide answers or
24 results in the query sense. It makes recommendations
25 over time. Nowhere does he mention search, nowhere does

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1 he mention query, nowhere does he mention information
2 need.

3 Q. So, Dr. Carbonell, Dr. Ungar cited section 7.2,
4 Filtering Search Engine Query Results, as evidence it
5 disclosed search and query. What's your opinion about
6 this section 7.2?

7 A. So, first of all, to put it in context, section 7.2
8 is part of Chapter 7 of Lashkari, which is conclusions
9 and future work. Lashkari discloses that one possible
10 future work is to perform one of these over-the-wall
11 operations where a search engine such as Lycos produces
12 results. These results are then thrown over the wall to
13 the Lashkari system who then uses them as input to do
14 its profile systems. So what Lashkari is disclosing is
15 that it could be one of these over-the-wall systems.

16 The query itself is not even accessed by
17 Lashkari's method. It is certainly not processed or
18 integrated.

19 Q. Does the Lashkari filter, then -- let me ask it
20 differently, Dr. Carbonell.

21 What criteria does the Lashkari filter use,
22 then, to select the final results for presentation to the
23 user?

24 A. It uses the user's profile and the similarity of
25 that profile to the items or the similarity of that

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1 profile to other profiles of other users to see what
2 they had liked. It is the typical profile-based system.

3 Q. So in your opinion, Dr. Carbonell, does Lashkari
4 render claim 10 of the '420 patent obvious?

5 A. Lashkari does not by itself or in combination and it
6 also does not render the other claims, claim 25,
7 obvious, which is the same or equivalent to claim 10, or
8 the '664, claim 1 or claim 26, does not render them
9 obvious either for the same reasons.

10 Q. Okay. Let's move on to the final reference,
11 Dr. Ungar asserted which we are calling the Fab
12 reference. Does Fab render the asserted claims obvious?

13 A. Fab does not render the asserted claims obvious
14 either.

15 Q. Let's take a look at part of Fab PX-50 at
16 G-IPE-0217927.

17 Can you explain the Fab system with respect to
18 this drawing?

19 A. Yes. First of all, the cited references at the
20 position paper, it describes more of a desire of what.
21 It does not describe a method or a how, other than by
22 presenting this figure. So this figure comes closest to
23 describing a method, which is why I have selected it
24 here.

25 This is an overview of the Fab architecture.

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1 It's, essentially, a recommendation system. It is
2 recommending pages to a user. The user is clicking --
3 you see his finger there -- as to whether he likes
4 him -- it looks more like a he, I suppose. Whether he
5 likes them or he doesn't like them. Nowhere here do you
6 see search, nowhere here do you see query, nowhere do
7 you see relevance to the query. So it is also a profile
8 system very similar to the ones we have just finished
9 discussing.

10 Q. Can you summarize for the jury which elements of the
11 asserted claims, then, are not disclosed by the Fab
12 reference?

13 A. Yes. To save time we don't have to look at it
14 again. It's, again, claim elements (a), (b) and (d) of
15 the claim 10 of the '420 and the corresponding claim
16 elements for claim 25 of the '420, and it's, in fact,
17 all of the elements from claim 1 and claim 26 of the
18 '664 patent. None of those are disclosed; therefore, it
19 does not render obvious.

20 Q. Okay. Dr. Carbonell, I'm switching gears a little
21 bit. What is your view of the person of ordinary skill
22 in the art in 1998?

23 A. A person of ordinary skill in the art would have a
24 bachelors degree in computer science or a related field,
25 computer engineering, for example, and would have two or

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1 three years of experience in an area roughly called
2 information systems. That would include databases,
3 programming, algorithms, and so on.

4 This is very similar to what Dr. Ungar
5 described, the exception being is that he said it had to
6 be experienced in information retrieval and search
7 engines. In 1998, these were just becoming popular.
8 There were precious few people with experience in that
9 area, so I think a somewhat broader experience, rather
10 than narrowing this area, would be appropriate for
11 somebody of ordinary skill in the art.

12 Q. Dr. Carbonell, you testified earlier that you
13 believed there are some claim elements in the '420 and
14 '664 asserted claims that are not present in the prior
15 art at all; is that right?

16 A. That is correct. So some claim elements, claim
17 element (d), claim 10 of the '420 and claim 25, claim
18 element (c) of claim 1 of the '664, and claim elements
19 (c) and (d) of claim 26 of the '664 are missing from all
20 of the cited prior art.

21 Q. In your view would it have been obvious for a person
22 of ordinary skill in the art, as you have defined or as
23 Dr. Ungar has defined, to supply those missing elements
24 to the prior art to arrive at the claimed invention?

25 A. I think it would have been very far from obvious and

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1 would not have been obvious for somebody of ordinary
2 skill in the art, even under Dr. Ungar's narrower
3 definition or narrower assertion, to have created those
4 missing claim elements. That would have required deep
5 skill in both camps, in the search camp and in the
6 profile camp. That did not happen until some event such
7 as the acquisition of WiseWire by Lycos.

8 Q. Similarly, would you believe that a person of
9 ordinary skill in the art in 1998, as you defined or
10 Dr. Ungar has defined, would have appreciated the
11 advantage provided in the '420 patents and '664 patents?

12 A. No, I do not believe that they would have
13 appreciated those advantages, the advantages of tight
14 integration, the advantages of this multi-pictorial
15 taking all of the different factors into account,
16 especially the immediate information needed relevance to
17 the query.

18 As evidence of that is the cited prior art. It
19 does not suggest any kind of tight integration, it does
20 not suggest serving the immediate information need, it
21 does not suggest performing the collaborative or the
22 content-based analysis or the filtering with respect to
23 the query. Not only does it not teach how, it doesn't
24 even suggest doing so.

25 Q. Would the results obtained by the '420 and '664

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1 patents have been predictable to the person of ordinary
2 skill in the art as you have defined here or as
3 Dr. Ungar has defined in 1998?

4 A. No, it definitely would not have been predictable.
5 They did not know how to do it and they did not know
6 what the outcome of doing it would have been, the higher
7 quality search results from modern search engines that
8 can be achieved by this kind of tight integration.

9 Q. Do you believe it would have been difficult for
10 those of skill in the art under your definition or
11 Dr. Ungar's definition to have achieved the invention of
12 the '420 and '664 patent in 1998?

13 A. It would have been extremely difficult.

14 Q. And why do you say so?

15 A. It required a skill that was not present by somebody
16 of ordinary skill in the art. They may have had present
17 a skill of some of the components at best. They
18 certainly did not have the skill in all of the different
19 art that would have been required to perform that
20 combination and to have invented the missing elements in
21 the claims. So, therefore, it would not be rendered
22 obvious in the sense that somebody of ordinary skill in
23 the art would not have been able to perform the
24 requisite combination and the requisite invention of the
25 patents.

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1 Q. Thank you.

2 Let's talk about secondary considerations of
3 non-obviousness. Can you first explain to the jury what
4 secondary considerations of non-obviousness are?

5 A. Yes. These are additional considerations that would
6 provide further evidence as to whether an invention is
7 obvious or is not obvious by combining elements from
8 prior art.

9 Q. And have you formed an opinion as to whether there
10 are any secondary considerations of non-obviousness that
11 are relevant to your analysis of the '420 and '664
12 patent claims?

13 A. Yes. I formed that opinion with regard to three
14 secondary considerations.

15 Q. Okay. Let's start with the first one. Can you
16 describe for the jury the first bullet point Commercial
17 Success, how it might impact your analysis of
18 obviousness?

19 A. Yes. Commercial success means that if something
20 succeeded commercially, there would have been a reason
21 to do it, there would have been people trying very hard
22 to do it. And if they tried hard to do it and it was
23 still not done, that would provide strong evidence that
24 it was not obvious. And, in fact, the commercial
25 success of modern search engines, Google included, that

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1 use the teachings of these patent claims is strong
2 evidence that the commercial success criterion is met
3 and yet nobody else had come up with that invention at
4 that time.

5 Q. How about the second one, Long-Felt but Unmet
6 Needs. How does that affect your opinion of
7 non-obviousness?

8 A. That, again, if there were long-felt needs but
9 nobody figured out how to meet those needs, it means
10 that it must not have been obvious to replicate or
11 create the equivalent of the claims taught by the
12 patent. In fact, the long-felt needs were recognized
13 even in the cited prior art. They talked about possible
14 combining, but they came up with the over-the-wall
15 method, the output of one becomes the input of the
16 other. So, therefore, those needs were there, but they
17 were not met.

18 Q. If the patent claims here were obvious, do you
19 believe that would have been disclosed, the tight
20 integration that you talk about would have been
21 disclosed in Rose, Lashkari and Fab?

22 A. It certainly would have been disclosed in those
23 three and elsewhere because then this would have enabled
24 them to gain the upper ground or the upper hand to come
25 up with the invention that is effective.

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1 Q. And the final one is Failure of others. Can you
2 explain what you mean here by failure of others?

3 A. Yes. If others have tried to achieve the same
4 invention or the same effect, what it means is this
5 would have shown it could be done. The failure, having
6 tried and failed, indicates that it's not obvious. Had
7 it been obvious, they would have succeeded. So others
8 have tried, the prior art has tried, as I mentioned in
9 passing, I myself tried and did not succeed in arriving
10 at this kind of tight integration in performing all
11 these operations with respect to the query, with respect
12 to the immediate information need and the tight
13 integration.

14 Q. Okay. Dr. Carbonell, can you provide the
15 conclusions of your validity study to the jury, please.

16 A. Yes. These are my overall conclusions. The first
17 conclusion I said, No asserted claim is anticipated by
18 the cited prior art, that is, by Bowman and Culliss; no
19 asserted claim is rendered obvious by the cited prior
20 art or by any combination of the cited prior art for the
21 reasons stated, including the secondary considerations;
22 that Dr. Ungar's anticipation and obviousness theories
23 are in incorrect and unfounded; and that all asserted
24 claims are, therefore, valid.

25 MR. CIMINO: Thank you, Dr. Carbonell.

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1 Your Honor, I pass the witness.

2 THE COURT: Cross-examination?

3 MR. NELSON: Yes, your Honor. May I proceed?

4 THE COURT: You may.

5 CROSS-EXAMINATION

6 BY MR. NELSON:

7 Q. Good afternoon, Dr. Carbonell?

8 A. Good afternoon.

9 Q. Nice to see you again. I'm Dave Nelson, in case you
10 don't remember me.

11 A. Yes, I remember you.

12 Q. I have a few questions for you. Well, maybe more
13 than a few.

14 Something you said there at the end when you
15 were talking about commercial success. You referenced
16 the commercial success of search engines generally like
17 Google, do you remember?

18 A. Yes.

19 Q. You understand that search engine is not accused in
20 this case, right?

21 A. I understand that the ads functionality is what's
22 being accused. I do not know the details because I'm
23 not part of the infringement.

24 Q. Oh, so you didn't ever get to see Dr. Carbonell's --
25 excuse me, you are Dr. Carbonell -- Dr. Frieder's

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1 reports or anything like that?

2 A. No, I did not.

3 Q. And you didn't see his testimony here on the
4 infringement case?

5 A. No, I did not.

6 Q. So you are not aware of what he's saying infringes
7 these patents?

8 A. Only with respect to very generally what counsel has
9 reported.

10 Q. Okay. Let me talk about the Lashkari patent, first
11 of all. So, I think what I heard you say is that --

12 A. That's incorrect. Lashkari is not a patent.

13 Q. Can we call it a WebHound. That's easier for me to
14 remember.

15 A. Whatever is easiest.

16 Q. That's the WebHound reference; is that okay?

17 A. Yes.

18 Q. I think I heard you say you didn't think that the
19 WebHound reference disclosed filtering with relevance to
20 the query, right?

21 A. That's correct.

22 Q. Okay. But you agree that it discloses a combination
23 of content-based and collaborative filtering, right?

24 A. Yes.

25 Q. Okay. And you agree that at least in the page 78,

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1 which I think you cited, it talks about combining that
2 filtering, the content and collaborative, with search
3 engine functionality, right?

4 A. That's not what I said. I said that it can use as
5 input the output of a search engine.

6 Q. Okay. So I think I heard you say that you didn't
7 believe that modern -- excuse me, not modern, going back
8 to 1998 and before, search engines did any filtering; is
9 that right?

10 A. No, I did not say that either. I said that search
11 engines typically performed ranking.

12 Q. But you are aware that search engines out there did
13 filtering for relevance to the query themselves prior to
14 1998, aren't you?

15 A. I did not offer an opinion on that.

16 Q. Well, I understand. I'm asking you whether you are
17 aware of that?

18 A. The cited prior art performed ranking instead of
19 performing filtering? I would have to go back and
20 analyze at that time period to see whether they
21 performed filtering in order to be able to answer your
22 question with confidence.

23 Q. Okay. So you have reviewed the '420 patent, haven't
24 you?

25 A. Yes, I have.

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1 Q. And that includes the background section of the
2 patent; is that right?

3 A. Yes, it does.

4 Q. Before I go further, did I give you the binders,
5 your Honor?

6 THE COURT: Yes.

7 BY MR. NELSON:

8 Q. So, can we look at DDX-6.7?

9 THE COURT: 6 what?

10 MR. NELSON: It's one of the demonstratives,
11 your Honor.

12 THE COURT: What number was it?

13 MR. NELSON: It's slide 7, 6.7.

14 THE WITNESS: Can you point to me where I'm
15 supposed to look?

16 BY MR. NELSON:

17 Q. Yeah. Well, you can look on the screen, or this is
18 the '420 patent.

19 A. Okay. I will look on the screen.

20 Q. So here on the '420 patent you are aware that in
21 column 1 and 2 it talks about the background of the
22 invention, right?

23 A. Yes.

24 Q. Okay. And your understanding of the discussion of
25 the background of the invention, those are the things

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1 that are in the prior art?

2 A. That's generally what it is, yes.

3 Q. Okay. Well, what I want to draw your attention here
4 to, this is an excerpt we have from column 2. This is
5 lines 4 through 20. You see picking up at about --
6 well, it's probably about line 10 there's a sentence
7 that says, "Thus, the integrated information filter
8 system performs continued long-term searching, i.e., it
9 compares -- you don't need to worry about that. Let me
10 start over again.

11 Picking up at about line 12, you see it says,
12 "Thus, the integrated information filter system performs
13 continued long-term searching, i.e., it compares network
14 informons to multiple users' queries to find matching
15 informons for various users' wires over the course of
16 time." So let me stop there. Is that what you are
17 describing as these various profile systems?

18 A. So this is incomplete for me to be sure, but with
19 respect to long-term searching comparing informons to
20 multiple users' queries over time and use of wires,
21 wires represented profiles under the Lang work in
22 general. So the answer appears to be yes.

23 Q. Okay. So then let me pick up the second part of
24 that. See where it says, "Whereas, conventional search
25 engines initiate a search in response to an individual

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1 user's query and use content-based filtering to compare
2 the query to accessed network informons typically to
3 find matching informons during a limited, short-term
4 search time period." Do you see that?

5 A. Yes.

6 Q. Okay. So your understanding is that this is a
7 description of prior art search engines, correct?

8 A. Yes.

9 Q. So, in fact, according to the patent, prior art
10 search engines did, in fact, compare content-based
11 filtering for relevance to the query, correct?

12 A. According to this description, that's what it says.
13 I'm not sure. I would have to read more context to know
14 whether they were using the word "filtering" precisely
15 or loosely, but, yes.

16 Q. So at least, then, with respect to certain search
17 engines out there, there was content-based filtering for
18 relevance to the query, right?

19 A. That is according to the background section of the
20 patent description, yes.

21 Q. So now let's go back to DDX-6.6.

22 So this is the excerpt from the WebHound
23 reference at page 78 that you looked at, correct?

24 A. That is correct.

25 Q. So here what you said is a description of -- I think

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1 you called it an over-the-wall technique?

2 A. Yes.

3 Q. Providing the search results to the filtering
4 engine; is that right?

5 A. That's correct.

6 Q. Okay. Now, with respect to the WebHound reference,
7 you said that there's no disclosure whatsoever about
8 filtering for relevance to the query, correct?

9 A. That's right.

10 Q. In fact, that's the only thing that you said was
11 absent from the WebHound reference, correct?

12 A. No. I said that it did not meet claim elements (a),
13 (b) and (d), so it does not search and it does not do
14 the combination with respect to the query and it does
15 not do the filtering with respect to the query.

16 Q. Okay. So the last two are with respect -- those are
17 both based upon your notion that it doesn't disclose
18 filtering with respect to relevance to the query, right?

19 A. It doesn't combination and filtering with respect to
20 the query.

21 Q. Now you say it doesn't disclose search?

22 A. It doesn't perform search.

23 Q. Well, doesn't it say right here to combine it with a
24 search engine query such as Lycos, WebCrawler and Yahoo?

25 A. Well, it says right here that the two are

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1 complimentary. In other words, what Lashkari did or
2 WebHound did is different from what search engines did,
3 and it's talking about putting one in front of the other
4 for WebHound to then do its filtering on the output of a
5 search engine. It does not say anywhere that that
6 filtering is done with respect to the query or that any
7 type of combination that WebHound does internally,
8 WebHound combines content and filtering not with respect
9 to a query.

10 Q. But you agree that WebHound discloses combining
11 content-based and collaborative filtering, right?

12 A. Yes. Not with respect to the query, but it does
13 disclose as you just stated.

14 Q. Okay. Now, let's look at this. This is on page 78
15 of DX-49. That's the exhibit number.

16 Right below the highlighted part it says, "as a
17 concrete example, let's say a user is looking for
18 documents on Indian Cooking. He types the keywords
19 Indian Cooking into the Lycos search form. The number
20 of documents matching both keywords numbers in the
21 hundreds," and continues on. Do you see that?

22 A. I see that.

23 Q. So that's not a disclosure of search?

24 A. That is a disclosure that the user can use a search
25 engine. That is not a disclosure that search is

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1 integrated with the -- I don't know whether to call it
2 system or facility that is taught by Lashkari. In other
3 words, WebHound does not use a query. WebHound uses the
4 results of a search engine as its input.

5 Q. Right, but we've established that there are search
6 engines out there in the prior art that did filter with
7 respect to relevance to the query, right?

8 MR. CIMINO: Objection, misleading. That wasn't
9 his testimony.

10 THE COURT: Well, I'm going to overrule it and
11 permit the doctor to correct it if that's the case.

12 THE WITNESS: What I said was that filtering
13 with respect to the query is -- filtering and combining
14 with respect to the query are not disclosed by WebHound
15 or by any of the other prior art.

16 BY MR. NELSON:

17 Q. So let's talk a little bit about the inventors here.

18 Now, at least as of the time of your expert
19 report, wasn't it your understanding that neither
20 Mr. Kosak nor Mr. Lang worked on search technologies
21 until they joined Lycos?

22 A. I was not aware that they had worked on it.

23 Q. Right. So you are not aware of any information to
24 indicate that Mr. Lang or Mr. Kosak ever had experience
25 with search technology before joining Lycos, right?

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1 A. I do not know one way or the other.

2 Okay. Well, let me see if I can refresh your
3 recollection on that. This is from paragraph 140 of your
4 expert report. We have it on a slide DDX-6.11. So you
5 prepared an expert report in this case, right?

6 A. Yes, I prepared an expert report.

7 Q. And you disclosed in that all of your opinions and
8 the bases for your opinions, right?

9 A. That's correct.

10 Q. So here from paragraph 140 of your report you say,
11 "For example, as I understand it, Mr. Kosak and Mr. Lang
12 themselves worked on filtering techniques and did not
13 become involved with search technologies until they
14 joined Lycos." Do you see that?

15 A. That's correct.

16 Q. So does that refresh your recollection that your
17 understanding is they did not have any experience with
18 search technologies before joining Lycos?

19 A. It means that I do not know if they had any such
20 experience. I believe they did not, but I cannot say
21 for sure. After they joined Lycos, of course, that
22 changes.

23 Q. Now let's talk about the timing of that. So the
24 patent, you said, was filed December 3rd, 1998, right?

25 A. Yes.

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1 Q. Okay. And the purchase of Lycos or Lycos's purchase
2 of WiseWire -- WiseWire, you understand, was Mr. Lang's
3 and Kosak's prior company?

4 A. Yes.

5 Q. That occurred sometime in mid-1998; is that right?

6 A. I do not recall the date. I recall that there was a
7 extensive period of negotiation and discussion prior to
8 the actual finalization of the purchase.

9 Q. Right. You were at Lycos still, or as a consultant,
10 you said, up through 1998, right?

11 A. No. I was actually -- through the IPO I was by that
12 time no longer affiliated with Lycos.

13 Q. So then do you know how long it was that Mr. Kosak
14 and Mr. Lang were at Lycos before they filed this patent
15 on December 3rd, 1998?

16 MR. CIMINO: Objection, beyond scope.

17 THE COURT: Objection sustained.

18 MR. NELSON: Well, your Honor --

19 THE COURT: The objection is sustained.

20 MR. NELSON: All right.

21 BY MR. NELSON:

22 Q. Now, you have never discussed with Mr. Lang or
23 Mr. Kosak their patents; is that correct?

24 A. That's correct.

25 Q. Okay. So you don't know whether they encountered

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1 any technical hurdles when they combined their filter
2 technology with the search technology at Lycos?

3 A. That's right, because at that time I no longer was
4 affiliated with Lycos so I did not have privy or I don't
5 have an inside track.

6 Q. So we are going to talk about some other things here
7 in your report. You have talked a lot about tight
8 integration, would you agree?

9 A. Yes.

10 Q. Now, the words "tight integration" don't appear
11 anywhere in the claims of this patent, right?

12 A. Those exact words do not. The concept does.

13 Q. Right. And the words "tight integration" don't
14 appear in the patent itself, right?

15 A. If you say so. I would have to check.

16 Q. I'm just asking whether you know?

17 A. Okay. The concept of tight integration appears, not
18 the words, insofar as I know.

19 Q. Okay. So now I want to look here, if we can look at
20 DDX-6.9, and this begins on page 44 of your report and
21 continues on to page 45. The highlighted sentence that
22 says, "The combination of query, content and
23 collaborative feedback to filter in a single engine can
24 yield results superior to applying less than all of them
25 or applying them in sequence." Do you see that?

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1 A. Can you pull it up some more?

2 Q. Sure, absolutely.

3 A. Okay. Now I can read it. Thank you.

4 Q. Do you see that? So is it your understanding that
5 the '420 and the '664 patent require all of the elements
6 of the claim to be in a single search engine?

7 A. What my understanding is that they are all required
8 to be inside the same system. Whether the system is --
9 whether you use search engine expansively to refer to
10 the combination or not is less important.

11 Q. So is that where your understanding of tight
12 integration comes from?

13 A. My understanding of tight integration comes from my
14 experience over 30 years. I know what tight integration
15 means. As it applies to this work, it is the fact that
16 all of the elements -- excuse me, all of those
17 ingredients are combined in the same claim elements, and
18 it's also consistent with the patent description and
19 with the figures that we did not analyze here that shows
20 how all of the items -- teaches how all of the items are
21 tightly integrated.

22 Q. Okay. Well, let's put up claim 10, for example, of
23 the '420 patent.

24 THE COURT: Mr. Nelson, the Court hates to
25 interrupt, but I don't know how much longer you have for

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1 this witness, but we are simply going to go on and take a
2 lunch break and come back in and continue with the
3 cross-examination after lunch.

4 MR. NELSON: Okay.

5 THE COURT: Ladies and gentlemen, please rise.
6 I want the jury to come back prepared to go forward at
7 2:30, please.

8 (Jury out.)

9 THE COURT: You may step down, Doctor.
10 For planning purposes, do you know approximately
11 how long your cross of this witness will take?

12 MR. NELSON: I think maybe another 30 or 45
13 minutes, your Honor.

14 THE COURT: All right. The Court will be in
15 recess until 2:30.

16 (A luncheon recess was taken at 12:58 p.m.,
17 after which court reconvened at 2:34 p.m.)

18 **AFTERNOON SESSION**

19 THE COURT: Bring the jury in.

20 (Jury in.)

21 THE COURT: You may be seated.

22 Let the record reflect all jurors are present.
23 Does counsel agree?

24 MR. CIMINO: Yes, your Honor.

25 MR. NELSON: Agreed, your Honor.

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1 THE COURT: All right. You may resume your
2 cross-examination.

3 MR. NELSON: Thank you, your Honor.

4 BY MR. NELSON:

5 Q. Good afternoon.

6 A. Good afternoon.

7 Q. So let's put DDX-6.9 back on the screen. This is
8 the demonstrative we were looking at before lunch.

9 So I want to explore a little bit more of this
10 statement you have in your report about the combination
11 of query and content and collaborative feedback to filter
12 in a single engine, okay?

13 A. Okay.

14 Q. So let's put up claim 10 of the '420 patent.

15 Now, you see the first element of claim 10 says
16 a system for scanning a network. Do you see that?

17 A. Yes.

18 Q. And then the next one says a content-based filter
19 system. Do you see that?

20 A. Yes.

21 Q. And the third says a feedback system. Do you see
22 that?

23 A. Yes.

24 Q. So do you believe that all three of those systems
25 have to be in a single search engine system?

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1 A. I believe that all three have to be integrated, all
2 the elements in those three have to be combined. One
3 way to do it is a search engine system, but that's not
4 the only way.

5 Q. Okay. So the claim, you agree, talks about separate
6 systems, right, the elements of the claim?

7 A. No. They are separate elements of the claim.

8 Q. Right, but the first one says a system for scanning
9 a network, right?

10 A. Correct.

11 Q. And then, I don't need to go through it again, but
12 they are all each introduced as a system, correct?

13 A. They are all introduced as a system.

14 Q. Right. So they are separate systems?

15 A. No, sir. They are combined, as it says so on the
16 third element in which the feedback system for receiving
17 collaborative feedback data from systems used relevant
18 to informons considered by other users, and then it goes
19 on the filtering system combining and so forth. The
20 combining is an integral part of the claim, in my review
21 of it.

22 Q. Okay. Let's go back to DDX-6.9.

23 So what does that have to do with being a single
24 search engine?

25 A. It has to be an integrated system. As I said a

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1 moment ago, a search engine is one way to integrate it.
2 It's not the only way. It can be combined without it
3 being a single search engine. It could be integrated.

4 Q. So, in other words, you could take, as you say,
5 separate systems and they can still be integrated,
6 correct?

7 A. I did not say separate systems. Those are your
8 word, not mine, sir.

9 THE COURT: I think this has been asked and
10 answered. He said they are elements.

11 MR. NELSON: Right.

12 BY MR. NELSON:

13 Q. So you are not saying the elements all need to be
14 combined in one system, correct?

15 A. I'm saying the elements only need to be tightly
16 integrated.

17 Q. Okay. Now, let's talk a little bit about Rose. Did
18 I understand you to say that you don't believe that Rose
19 disclosed a search?

20 A. Rose does not -- the Rose facility is not a search
21 facility. Rose mentions search externally to the Rose
22 facility and it can be connected in terms of Rose
23 operating on the output of a search system as input to
24 Rose, in the same manner as Lashkari.

25 Q. Okay. So let's talk about that a little bit. Let's

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1 put up DDX-6.2, this is an excerpt from the Rose
2 patent. And, by the way, you have that in your binder
3 if you wish to look at the binder.

4 A. I have got several binders. I'm not sure which is
5 which.

6 Q. It would be the white one.

7 MR. CIMINO: He has three white ones.

8 BY MR. NELSON:

9 Q. Oh, you have three white ones?

10 A. Okay. I found it.

11 Q. Okay. So what I'm showing here is an excerpt from
12 the Rose patent. This comes at column 1, lines 33 to
13 40. Do you see that?

14 A. I see that.

15 Q. So I have something highlighted here from the Rose
16 patent. It says, "Using a text searching tool,
17 individual users can locate documents matching a
18 specific topical query." Do you see that?

19 A. Yes.

20 Q. So now let's take a look at another part of the Rose
21 patent at column 2, line 51-57, which would be in
22 DDX-6.13.

23 You see it says, "The relevance predicting
24 technique of the present invention is applicable to all
25 different types of information access systems. For

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1 example, it can be employed to filter messages provided
2 to a user in an electronic mail system and search results
3 obtained through an on-line text retrieval service." Do
4 you see that?

5 A. Yes.

6 Q. So you agree that Rose says that the relevance
7 predicting technique in the present invention can be
8 used with an on-line text retrieval service, right?

9 A. It says there explicitly that it can be applied to
10 the output, in other words, the results is Rose's words,
11 obtained from an on-line text retrieval system or an
12 electronic mail system.

13 Q. And that could include a query-based search system,
14 right?

15 A. It could apply to the output of -- yes, it could be
16 applied to the output of different kinds of information
17 retrieval systems, presumably a search system as well.

18 Q. A query-based search system, right?

19 A. Yes.

20 Q. Now, here in this same passage that I have up now --
21 we don't need to go to a new one -- you see where it
22 says, "For example, it can be employed to filter
23 messages provided to a user in an electronic mail
24 system." You see that?

25 A. Yes.

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1 Q. Okay. So the Rose patent actually says it does
2 filtering, right?

3 A. The Rose patent in the summary mentions filtering,
4 that is correct. It does not teach how to do
5 filtering. The internal description describes ranking.

6 Q. Okay. So then what you are saying is that in order
7 to figure out whether something meets the claims of
8 these patents, you need to look at how it actually
9 operates and not just some high-level words, right?

10 A. I'm saying exactly what I said, that it mentions
11 that filtering can be employed, and it actually
12 describes how to do it with a ranking system.

13 Q. Now, let's move on and talk about your opinions with
14 respect to the Bowman patent a little bit.

15 The Bowman patent is Tab 7 in your binder. It's
16 DX-59, for the record.

17 So I heard you say two things about Bowman, why
18 you thought it didn't anticipate. The first one, you
19 didn't think that it shows filtering, right?

20 A. Correct.

21 Q. And the second thing is you didn't think it showed a
22 content-based analysis; is that right?

23 A. That's also correct.

24 Q. Okay. So let's take that first one. Let's focus on
25 the filtering. So, can we show DDX-6.15. And let's

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1 blow up that bottom part. This is from column 9 and
2 this excerpt is from lines 53-65 of the patent, if you
3 want to take a look at that, and I will give you a
4 moment. When you are there, let me know.

5 A. I'm there.

6 Q. Okay. So it says, "Step 808 preferably involves
7 sorting the items in the query result in decreasing
8 order of their ranking values, and/or subsetting the
9 items in the query result to include only those items
10 above a threshold ranking value, or only a predetermined
11 number of items having the highest ranking values." Do
12 you see that?

13 A. Yes.

14 Q. Do you believe that this is an accurate description
15 of the Bowman system?

16 A. I wouldn't see any reason to dispute that.

17 Q. Okay. So let me focus in on this a little bit. You
18 see where it says and/or?

19 A. And/or subsetting, yes.

20 Q. Right. So, in other words, you understand that to
21 mean that the subsetting, or that part of the sentence
22 that comes after the and/or can be used by itself
23 without the ranking referred to in the first part of the
24 sentence, right?

25 A. No, that's not right. The system will rank and may

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1 or may not also do the subsetting, the step that
2 follows.

3 Q. Well, let's talk about that. So you see it says,
4 "Step 808 preferably involves," preferably, right? You
5 see that word?

6 A. I see that word.

7 Q. So that means it doesn't necessarily involve sorting
8 the items, correct?

9 A. Yes. The rest of the sentence is in the context of
10 that same preferably involving sorting the items.

11 Q. Okay. So let's just pick it up, Step 808 preferably
12 involves sorting the items in the query result in
13 decreasing order of their ranking values, and/or
14 subsetting the items in the query result to include only
15 those items above a threshold ranking value."

16 Let's stop there. So you agree that one of the
17 things the Bowman patent teaches is that you could subset
18 the items in the query result to include only those items
19 above a threshold ranking value, correct?

20 A. Yes, that is correct. In order to do the
21 subsetting, it must do the ranking to be able to
22 subset.

23 Q. Well, that's not what the sentence structure says,
24 though, is it?

25 A. The sentence says, "involves sorting the items in

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1 order of the ranking values," and then it may or may not
2 do the subsetting.

3 Q. Well, let's go a little bit farther up in this same
4 column 9 and let's just see what it talks about.

5 So if we can go to DDX-6.16, and we will have to
6 blow these up individually, but this is from column 9.
7 This goes from about line 28 to line 65 of the patent, if
8 you have it in front of you.

9 So you see first it says, "The facility uses
10 rating tables that it has generated to generate ranking
11 values for items in new query results." Do you see that?

12 A. Yes, I see that. It was right on my ranking table
13 on direct.

14 Q. Right, understood. And an example of that you gave
15 was in Fig. 4, right?

16 A. Correct.

17 Q. But there's also an example in Fig. 6 of the Bowman
18 patent; isn't there?

19 So let's show Fig. 6 of the Bowman patent.

20 A. Yes, that's also an example.

21 Q. Okay. So you agree that this is an example of a
22 ranking table or what you called a rating table, I
23 guess, right?

24 A. I'm using Bowman's words. He calls it a rating
25 table, so I'm calling it the same thing.

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1 Q. Okay. So let's go back to DDX-6.16, and let's blow
2 up the middle highlighting there.

3 You see here it says, "In Step 806, the facility
4 combines the scores for the current item to generate a
5 ranking value for the item." Do you agree that's an
6 accurate description of what's going on?

7 A. Yes.

8 Q. "As an example, with reference to Fig. 6 --"

9 Is there any way we can get Fig. 6 up at the
10 same time maybe?

11 Okay. Then let's pull up that middle part
12 again.

13 Okay. Can you see that? Let me begin again.
14 "As an example, with reference to Fig. 6, in processing
15 datum having item identifier '1883823064' --" That would
16 be in the middle column. That would be the identifier,
17 right?

18 A. Correct. This is the same I illustrated in Fig. 4.

19 Q. Okay. So I think he's highlighted there the item
20 that corresponds to the term, the key term "dynamics,"
21 right?

22 A. Yes, sir.

23 Q. Then if we look below, there's another reference to
24 item 1883823064; is that correct?

25 A. That is correct.

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1 Q. And that's with respect to a key term "human"; is
2 that correct?

3 A. That is also correct.

4 Q. So picking up at the description of this says, "the
5 facility combines the score '116' extracted from the
6 entry 602 for this item and the term "dynamics" and the
7 score '211' extracted from the entry 605 for this item
8 and the term "human"." Do you see that?

9 A. Yes, I do.

10 Q. So then what's taught there is you would take the
11 116 corresponding to the term "dynamics" which is the
12 rating score for that, correct?

13 A. Yes, it is a rating score in the middle of this.

14 Q. Right. And then you would take 211, which is the
15 score for the term "human" with respect to that item,
16 correct?

17 A. That's correct. That would be the number of times
18 that item was clicked when the term "human" was in the
19 query.

20 Q. So you add them together and you get 317, right?

21 A. No, you get 327.

22 Q. 327. Actually, I got that right at the deposition
23 and got it wrong today, didn't I?

24 A. Right. I was impressed.

25 Q. Yes. So, 327?

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1 A. Yes.

2 Q. So what we just walked through, 327 would be the
3 ranking value for item 1883823064 in this example,
4 right?

5 A. If the query was human dynamics, that is correct.

6 Q. So then if we go further down to what we were
7 looking at before on the previous slide -- let's go back
8 to 6.15.

9 So I just want to take that last piece or after
10 the or. "Subsetting the items in the query result to
11 include only those items above a threshold ranking
12 value." Do you see that?

13 A. I see that.

14 Q. Okay. So in this example, the ranking value for the
15 item we just walked through would be 327, correct?

16 A. Yes.

17 Q. And what this section that I just read says that you
18 can subset based upon whether that ranking value is
19 above a certain threshold value, correct?

20 A. That is correct. That threshold value would
21 typically be derived from the rank, as you illustrated.

22 Q. So, for example, if the threshold value was 300,
23 then with respect to the item we just walked through, it
24 would be displayed in Bowman, correct?

25 A. That is correct.

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1 Q. And if the threshold value is 350, it would not be
2 displayed, correct?

3 A. That is also correct.

4 Q. So you don't think that determining whether a score
5 is above or below a threshold level is filtering for the
6 purposes of this patent?

7 A. No, I did not say that. In this case the ranking
8 value is derived -- would normally be derived from the
9 rank list. So, for example, as more and more items are
10 ranked, if the number is poor, you get fewer items
11 ranked. If you had a ranking of 300, everything would
12 be excluded. Over time more clicks happen, hundreds,
13 thousands, maybe millions of clicks happen, the ranking
14 value has to be adjusted to be selected from the actual
15 set of values that are generated in the rank list.
16 Typically you would select -- I'm sorry.

17 Q. But that would still be a threshold value.

18 THE COURT: Excuse me, Doctor, if you would
19 please raise your voice. There's some problem hearing
20 you.

21 THE WITNESS: Should I repeat the answer?

22 THE COURT: Repeat the answer.

23 THE WITNESS: Okay. My answer was that the
24 threshold value is a ranking value and would be derived
25 from the other ranking values in the rank list. So, for

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1 example, 300 is a potentially reasonable one in Fig. 6.
2 It would be unreasonable in Fig. 4 because that would
3 exclude everything and the search engine would return
4 nothing. That's not a good search engine. Or after a
5 while there would be thousands, maybe millions of user
6 clicks, and at that time a rank of 300 would allow
7 everything to come through. So the normal operation
8 would be setting the ranking value -- selecting a ranking
9 value as a threshold based upon the other ranking values
10 on the rank list.

11 BY MR. NELSON:

12 Q. So what you are saying is the threshold value could
13 change over time, right?

14 A. It can change over time and over query.

15 Q. Right, but it's, nonetheless, a threshold value,
16 correct?

17 A. It is a threshold value derived from the ranking.

18 Q. So let's talk about the second part where you say
19 Bowman doesn't engage in content analysis.

20 A. Okay.

21 Q. Okay? So let's take a look at -- and you have it as
22 Tab 7 still, if you are still on the Bowman patent.

23 A. Yes, I am.

24 Q. Look at column 1, lines 29 to 45.

25 A. Could you repeat the line numbers, please?

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1 Q. Excuse me?

2 A. Could you please repeat the line numbers?

3 Q. Sure, absolutely. Column 1, lines 29 to 45. They
4 have it on a slide. We can put it up, 6.17.

5 So I'm not going to read all of this, but some
6 of the relevant parts. It starts, "In order to perform a
7 search, a user submits a query containing one or more
8 query terms." Do you see that?

9 A. Yes.

10 Q. Do you agree that's an accurate description of
11 Bowman?

12 A. No, that's an accurate description of the prior art
13 as disclosed by Bowman.

14 Q. Okay. You agree that in Bowman there is a search
15 performed where user submits query terms as well,
16 correct?

17 A. Bowman discloses that that's what the prior art
18 does, yes, that is correct.

19 Q. All right. So let's talk about this. Now, we have,
20 "A query server program processes the query to identify
21 within the domain items matching the terms of the
22 query." Do you see that?

23 A. I see that.

24 Q. Now we go on and skip a sentence, it says, "In the
25 example, a query result is a list of books whose titles

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1 contain some or all of the query terms." Do you see
2 that?

3 A. Yes.

4 Q. Okay. So what Bowman is saying there with respect
5 to the prior art is matching the terms in the query to
6 the list of books involves looking at what words appear
7 in a title, correct?

8 A. Yes. Bowman is describing how a search engine prior
9 to Bowman's invention or Bowman's patent functioned.

10 Q. Okay. And then finally if we look at the last
11 sentence I have highlighted it says, "As another
12 example, the list may be ordered based on the extent to
13 which each identified item matches the terms of the
14 query." Do you see that?

15 A. Yes.

16 Q. Okay. So with respect to the prior art you would
17 agree that when Bowman is talking about matching here,
18 it's referring to comparing terms of the query to words
19 that are in the article or, in this case, the book,
20 right?

21 A. In this case a title, not the list, yes.

22 Q. Right. So that's a content-based analysis, right?

23 A. Bowman is disclosing that the prior art is based on
24 content-based analysis, correct.

25 Q. Right. So now if we go to what we looked at

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1 earlier, and I believe we looked at this in your
2 direct -- if we could go to 6.16. It's in column 9 of
3 the Bowman patent again, very close to what we were
4 looking at before, about line 43.

5 So here it says, "in particular, scores may be
6 adjusted to more directly reflect the number of query
7 terms that are matched by the item, so that items that
8 match more query terms than others are favorable in the
9 ranking." Do you see that?

10 A. I see that.

11 Q. So it's the same terminology that we looked at with
12 respect to the prior art, correct?

13 A. It's the same terminology with respect to the prior
14 art but different than Bowman himself had disclosed
15 prior to this passage. He had defined matching in a
16 different way to be the number of clicks.

17 Q. Okay. So then your opinion that Bowman doesn't
18 disclose content analysis -- well, first of all, you
19 agree it discloses content analysis in the prior art,
20 correct?

21 A. Yes.

22 Q. Your opinion that Bowman doesn't disclose content
23 analysis is based on the fact the term "matching" is
24 used differently in column 9 than it is in column 1,
25 correct?

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1 A. Correct. It's not just in column 9, but throughout
2 the description of his facility.

3 Q. Right. So let's pull up claim 28 and 29 of the
4 Bowman patent.

5 So you talked about these on direct, right?

6 A. Yes, I did.

7 Q. So focusing on claim 29 for a moment, claim 29 says,
8 "The computer-readable medium of claim 28." First of
9 all, that means 29 depends from 28, correct?

10 A. Right.

11 Q. So you agree whatever is covered by claim 29 has to
12 be included in claim 28, right?

13 A. Yes. That's the definition of a dependent claim.

14 Q. Right. So here it says, "Wherein the contents of
15 the computer-readable medium further cause the computer
16 system to perform the step of adjusting the ranking
17 value produced for each item identified in the query
18 result to reflect the number of terms specified by the
19 query that are matched by the item." You see that?

20 A. I see that.

21 Q. So your opinion that claim 29 is going to talk about
22 content analysis is, again, based on the fact that the
23 term "matched" as used in claim 29 means something
24 different than when it's used in column 1, correct?

25 A. The word "matched" is used when Bowman describes the

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1 last piece of his facility, which is in the vast
2 majority of the patent specification, and so the word
3 "matched" must be interpreted in a manner consistent
4 with what Bowman disclosed as to how his facility
5 worked.

6 Q. Okay. So let's go back to 6.16. And let's blow up
7 that middle step.

8 So we walked through this example with respect
9 to Fig. 6 and we established that the ranking value, the
10 score in Bowman is going to result from determining which
11 key terms are matched by the item, correct?

12 A. Yes, that's correct.

13 Q. So in this example it would be 327, correct?

14 A. If the combination function is an addition, which
15 typically would be, yes, I agree.

16 Q. Right. So, in other words, in order to get that
17 ranking value that we walked through with respect to
18 Fig. 6, we already took the query terms and matched them
19 to items that were in the table, correct?

20 A. That's right.

21 Q. So now just below that it says, "In particular,
22 scores may be adjusted to more directly reflect the
23 number of query terms that are matched by the item, so
24 that items that match more query terms than others are
25 favored in the ranking." Do you see that?

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1 A. I see that.

2 Q. Okay. So just above that, in order to get the
3 ranking value we have already determined which query
4 terms are matched by the items, correct?

5 A. Which query terms are matched by the ranking table.

6 Q. Exactly.

7 A. Which references the items, yes.

8 Q. Okay. And immediately below that it says we are
9 going to adjust the score based upon the number of query
10 terms that are matched by the item, correct?

11 A. That is correct.

12 Q. Okay. So if we already got the score by determining
13 which query terms are present in the ranking table, you
14 still think that we would be adjusting that score by
15 determining which query terms matched terms in the
16 ranking table?

17 A. Yes, sir, because you could have -- first of all,
18 you can match an item in the ranking table even if that
19 term is not contained in the item. All we need is
20 somebody to have clicked on that particular item. So if
21 I say my query is automobile insurance and the item
22 mentions vehicle policies and people click on it, then
23 that one will rank high, will start to rank high as more
24 people click on it, even though it contains neither of
25 my query terms, according to the Bowman facility.

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1 To address your specific question here, if a
2 query has, let's say, four terms and one item has a
3 score for all four of the terms and another item only
4 has scores for two of the terms, then this is saying
5 that you will get a bonus -- it doesn't say how to do a
6 bonus, but it's saying you will get a bonus if it has
7 scores for all four terms because it matches,
8 essentially, all four terms. So Bowman is favoring one
9 that has some user clicks or user relevance to as many
10 terms, or in this case, all of the terms in the query.
11 It's a sensible thing to do.

12 Q. I'm sorry, I didn't know you weren't finished.

13 A. I'm done.

14 Q. Okay. But you agree that -- it's okay?

15 THE COURT: Go on.

16 MR. NELSON: All right. Just checking.

17 BY MR. NELSON:

18 Q. The original ranking value is going to come from how
19 many terms in the table match words in the query, right?

20 A. Not how many, the sum of the scores as in your
21 example.

22 Q. Right.

23 A. So you could have five of them with low scores
24 versus two terms that are matched with high scores. The
25 two terms with high scores with high clicks would

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1 dominate the five. This one is sort of curing that to
2 some extent by giving a bonus score if all of the terms
3 in the query are contained in the rating table, or have
4 scores in the rating table.

5 Q. Okay. So let's talk about your opinions concerning
6 the Culliss reference now.

7 A. Okay. This is going to be at Tab 8 in your binder.
8 It's DX-58.

9 Now, on your direct examination I think you said
10 that you thought Culliss didn't disclose filtering and
11 didn't disclose content-based analysis; is that right?

12 A. That's right.

13 Q. So you agree that Culliss includes the collaborative
14 feedback elements of the asserted claims, correct?

15 MR. CIMINO: Objection, beyond the scope. He
16 talked about two things that were missing and he didn't
17 talk about anything else in the reference.

18 THE COURT: No, the objection overruled.

19 THE WITNESS: I did not offer an opinion as to
20 whether it disclosed the collaborative part. By
21 Dr. Ungar's definition of collaborative filtering, it
22 will actually not be disclosed; however, my understanding
23 of collaborative filtering is different from that of
24 Dr. Ungar's.

25 BY MR. NELSON:

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1 Q. Okay. How about if you use Dr. Frieder's
2 definition?

3 A. I was not here for Dr. Frieder's testimony.

4 Q. So you don't know what Dr. Frieder's definition of
5 collaborative filtering is?

6 A. I know what Dr. Ungar's is. I know what mine is.

7 Q. All right. So let's talk about this content-based
8 first, and we are going to need to walk through the
9 patent a little bit. So let's put up DDX-6.18. This
10 comes from column 3 at about line 42.

11 You see at the bottom it says "This data may
12 comprise articles, databases, data collections, web
13 sites, web pages, graphics, encryption, audio, video or
14 any other type of information collectively referred to as
15 articles and designated herein by the generic labels A1,
16 A2, A3, etc."

17 A. Yes, I believe these are references of performance.

18 Q. Okay. So when we see A1, A2, and A3 in the Culliss
19 reference, it would include, among other things,
20 articles, correct?

21 A. Yes.

22 Q. So let's just stick with articles because we don't
23 want to recite this litany each time we talk about it,
24 okay? Does that work?

25 A. It works for me.

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1 Q. All right. Now, if we look a little bit further
2 down, and this is in DDX-6.19. It begins at about line
3 62. It says, "The articles are each associated with one
4 or more of these key terms by any conceivable method of
5 association, such as through indexing all words or
6 through meta-tag headers containing keywords selected by
7 the author or editor." Do you see that?

8 A. That's correct, yes.

9 Q. So you agree that Culliss teaches that the key terms
10 can be selected by indexing actual words that are in the
11 articles, correct?

12 A. Yes. This is the initialization step. One of the
13 ways of doing it is by presence in the article. Another
14 is through a human editor assigning it to a meta-tag and
15 so on.

16 Q. Okay. So let's stick to the example in Culliss
17 where the key terms come from indexing actual words,
18 content that appears in the article, okay?

19 A. Okay.

20 Q. So now let's put go to 6.20, and this is from
21 shortly after we just read. It's from column 4,
22 beginning at line 1 and 9. I think you actually showed
23 this table in your direct, didn't you?

24 A. I believe I showed the table at the bottom of that
25 column.

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1 Q. Okay. So this table, then, you agree that this
2 table is representative of an initialization of the
3 index settings in the Culliss reference, right?

4 A. That would be correct. That would be before Culliss
5 begins to operate.

6 Q. Okay. So let's just talk about this a little bit,
7 and let's take, first, article A1. Do you see article
8 A1 there?

9 A. Yes.

10 Q. So what this table is telling us that article A1
11 contains the word alpha, for example, right?

12 A. And Beta and Gamma.

13 Q. Yeah, I was going to go through them one at a time.

14 A. I'm trying to save you some time, sir.

15 Q. Okay. Thank you. Fair enough. So you do agree,
16 then, this table shows that article A1 contains the
17 words Alpha, Beta, Gamma and Epsilon, right?

18 A. Right. Under that particular embodiment, yes.

19 Q. And, similarly, you would agree that this table
20 shows that article A2 contains the words alpha and
21 Delta, correct?

22 A. Yeah. Actually, article A1 does not contain the
23 word Delta.

24 Q. I skipped Delta.

25 A. Oh, I did not hear it. You are correct.

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1 Q. And then you would, similarly, agree this table
2 shows that article A3 would contain the words Alpha,
3 Gamma, delta and Epsilon, correct?

4 A. Yes.

5 Q. So you agree that's what's shown here in this table
6 would be a content-based initialization, right?

7 A. If the ones come from whether or not the article
8 contains it, yes, and that is one of the possibilities.

9 Q. So that's a content-based association, right?

10 A. Yes.

11 Q. So now let's go to DDX-6.21. This is in column 4 of
12 the patent, and it says, "The invention will accept a
13 search query from a user and a search engine will
14 identify key terms which match the search query." Do
15 you see that?

16 A. Yes.

17 Q. And you agree that's an accurate description of
18 Culliss?

19 A. That's an incomplete description, yeah.

20 Q. Right, but just focus on this sentence. You don't
21 quibble with that?

22 A. No.

23 Q. So then what this is saying is that the query will
24 be content-based in the sense of matching the index key
25 terms in a query, correct?

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1 A. No, it doesn't say one way or the other here. It
2 will accept a search query from the user and will
3 identify the key terms which match the search query.
4 The key terms are those entries in the table.

5 Q. Right, and those key terms come from words in the
6 article in our example, right?

7 A. In the initialization step only.

8 Q. Okay. So let's talk about that a little bit. So
9 you agree in the initialization step that Culliss
10 discloses a content-based analysis, correct?

11 A. A content-based initialization.

12 Q. Right. So the key terms are associated with content
13 in the article, correct?

14 A. Yeah. We have been over this before. Yes. There
15 are other ways of doing it as well. This is one of the
16 ways.

17 Q. Okay. Understood, this is one of the ways, so let's
18 just stick with this example.

19 So but what you are saying is that what Culliss
20 describes is the feedback, in other words, how many times
21 users actually clicked on the various articles will
22 increase the initialization score, correct?

23 A. Yes, that's correct.

24 Q. Okay. So for that reason you don't believe that
25 Culliss shows a content-based analysis, correct?

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1 A. The short answer is yes. To elaborate a little,
2 over time, and usually over very little time, the users
3 will click and click and click some more. There are
4 millions of queries or billions of queries everyday, and
5 the number of clicks will totally overwhelm the
6 initialization, whether it be one, as in this example,
7 or whether it be some other small number from another
8 example. So during the operational phase it will be
9 purely collaborative. During the initialization step,
10 which is not the operational step, it will be
11 content-based, as you described.

12 Q. Okay. So you don't think, then, that doing an
13 operation where I match the query terms to key terms and
14 use that to access a feedback score meets the
15 content-based filter limitation of this patent?

16 A. That's right.

17 Q. Okay. So let's talk a little bit more about this
18 content-based initialization and what Culliss teaches.
19 So if we go to 6.23, and this comes from column 14. If
20 you have that in front of you, you can turn to that and
21 let me know when you are there.

22 A. I got here already.

23 Q. So here it says, "Initially, the key terms, category
24 key terms and rating key terms may be associated with
25 words or other information in the article, or may be

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1 arbitrarily associated with the article in any manner."

2 Do you see that?

3 A. Yes.

4 Q. So this is another description of initializing the
5 key terms to content in the articles, correct?

6 A. Only one of the alternatives is with context in the
7 article to the article. Associated with words or other
8 information in the article, that is content for
9 initialization, sir, but it also says may be arbitrarily
10 associated with the article in any manner. So there's
11 more than one possible way.

12 Q. And if we look to 6.24, it's a little bit farther
13 down in column 14, it says "Although the scores in the
14 index are initially shown at 1, they can be initially
15 set to any desired score. For example, the scores can
16 be initially set to correspond with the frequency of the
17 term occurrence in the article." Do you see that?

18 A. That's correct.

19 Q. So you could provide a content score of anything
20 other than 1, right?

21 A. If the word occurred 3 times, you could initial lies
22 it at 3, for example.

23 Q. Right. Or you could initialize it at 3,000 if you
24 wanted to, correct?

25 A. It would be arbitrary. I guess it's permitted, yes.

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1 Q. Okay. So you agree, then, that the initialization
2 to the frequency of the words in the article is the
3 content-based initialization, correct?

4 MR. CIMINO: Objection, asked and answered.

5 THE COURT: Sustained. This is about the third
6 time, I think, Mr. Nelson.

7 MR. NELSON: Well, this is just going to the
8 frequency, your Honor, but that's fine. I will go
9 quickly through this.

10 BY MR. NELSON:

11 Q. So you agree that that content-based initialization
12 never goes away, correct?

13 A. No. Content-based initialization is completely
14 swamped. It doesn't matter whether it's there or not.
15 If you have a million clicks does it matter the real
16 score should have been a million and one? The facility
17 will work in the same way whether or not the
18 initialization is there or initialization is not there.
19 So from an engineering perspective, the content goes
20 away.

21 Q. So what you are saying is if the content piece is a
22 very small part of the score, then that's not
23 content-based filtering, correct?

24 A. I'm saying that it doesn't have any effect. So for
25 all practical purposes, it is not content-based

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1 filtering.

2 Q. Now, you have been in, I think you said, in the
3 search industry for a long time, right?

4 A. That's correct.

5 Q. And we heard about your background. You have been
6 in it for 30 years, probably?

7 A. Yes.

8 Q. Okay. So you are not aware, at least as of the time
9 of your report, of any praise of this claimed invention
10 by anybody in the industry, correct?

11 A. This claimed invention refers to --

12 Q. In the '420 and '664 patent.

13 A. Okay. You aren't talking about Culliss?

14 Q. Correct. I'm sorry.

15 A. I was wondering if you were asking about praise for
16 Culliss. No, I do not know of any praise that those
17 inventions received. I don't know of any for Culliss
18 either.

19 Q. Okay. Just so we are clear, as to the '420 and '664
20 patents, you are not aware of any praise those
21 inventions ever received?

22 A. No, I have not.

23 MR. NELSON: That's all the questions I have,
24 your Honor. I pass the witness.

25 THE COURT: Any redirect?

1 MR. CIMINO: No redirect.

2 THE COURT: Okay, Doctor. You may step down.
3 May the witness be permanently excused?

4 MR. CIMINO: Yes, your Honor.

5 THE COURT: All right. You may be excused,
6 Doctor.

7 (Witness excused.)

8 THE COURT: Your next witness?

9 MR. BROTHERS: Your Honor, we have some matters
10 we need to take up with the Court that I think are best
11 outside the presence of the jury.

12 THE COURT: Okay. Are there any more witnesses?

13 MR. BROTHERS: No witnesses for the jury's
14 consideration, your Honor.

15 THE COURT: All right. Ladies and gentlemen, if
16 you would step into the jury room for a few minutes and
17 let me get a handle on this.

18 (Jury out.)

19 THE COURT: You may be seated.

20 Yes, sir.

21 MR. BROTHERS: Your Honor, this relates to the
22 discussion that we initiated this morning with respect to
23 our proposed rebuttal on the issue of laches.

24 As your Honor will recall, yesterday plaintiff
25 moved for JMOL under Rule 50 for laches. The defendants

1 did not move. The defendants were responding to our
2 motion when they tendered the proffer, and it's clear. I
3 just went back and reread the transcript at pages 1771.
4 It was my motion that I made saying that the defendants
5 had not satisfied their burden with regard to laches and
6 made the argument to the Court. And in response to
7 plaintiff's motion, defense counsel explained that they
8 believed that they had, but the defendants did not have a
9 pending motion with regard to laches.

10 THE COURT: So now your argument is that the
11 Court ruled on a laches motion without their being a
12 motion for laches?

13 MR. BROTHERS: It granted -- it precluded
14 through the Court's ruling this morning damages prior to
15 the day of suit without their having been a pending
16 motion, that's correct.

17 And we had no -- plaintiff had no opportunity,
18 no notice to be heard, as required under Rule 50(b) on
19 that motion and because that motion was not made, and we
20 had no opportunity to present rebuttal evidence.

21 The Federal Circuit has ruled in the Wanlass
22 case that once the presumption of laches is applied,
23 which is what your Honor implied this morning, a prima
24 facie defense of laches is made with the presumption the
25 facts of unreasonable and inexcusable delay has produced

1 or inferred absent rebuttal evidence. Once the
2 presumption is established, the patentee may introduce
3 evidence sufficient to support a finding of the
4 nonexistence of presumed facts.

5 That is what plaintiff proposes to do, and I can
6 tender a copy of this court decision to your Honor.

7 THE COURT: The Court is familiar with the
8 decision. The Court quoted from that case this morning
9 when the Court ruled.

10 MR. BROTHERS: Yes, and I wanted to point out
11 the specific language of the Federal Circuit stating that
12 once the presumption was found, again, without a motion
13 having been made, we, plaintiff, has the opportunity to
14 respond by providing in rebuttal that evidence.

15 We also understood pursuant to the discussion at
16 the pretrial conference that laches was going to be
17 heard, for the most part, outside the jury.

18 Your Honor indicated if there was specific
19 witnesses, maybe we could ask a few questions.

20 THE COURT: I wanted to let you go on, but,
21 Mr. Brothers, I think you are redefining some things
22 here. You had an opportunity to present evidence on
23 laches if you wanted to do it. Now you are Johnny come
24 lately with this argument because you found that the
25 Court has held against you, but you had no intentions and

1 expressed no intentions of calling any witness in here on
2 laches.

3 Now, no matter what the Court does, that's what
4 the record reflects. Now, you can reinvent history, but
5 you did not intend to call a single witness in here after
6 this witness, and you told the Court that more than one
7 time. And to tell the Court now that somehow or another
8 you haven't been given a chance to do what you were not
9 going to do, the Court finds that disingenuous. You can
10 go on and tell anything else you want to say about what
11 you are in the process of presenting to the Court.

12 MR. BROTHERS: To clarify, your Honor, we never
13 believed we needed to call witnesses for the jury with
14 regard to laches. We had understood from the conference,
15 from the pretrial conference, that the Court would take
16 up laches after the close of evidence to the jury.

17 THE COURT: Mr. Brothers, you never indicated to
18 this Court anything about calling any more witnesses on
19 this issue. Now, when they presented that transcript
20 yesterday, the Court indicated yesterday that it would
21 consider that transcript and rule on that issue this
22 morning, you never said a word, and you have got enough
23 lawyers over there if you forgot it, for somebody to say
24 something about it. You never said a word.

25 MR. BROTHERS: I'm sorry, your Honor. I won't

1 interrupt.

2 THE COURT: You know something, the Court finds
3 it troubling that you would now come in here and raise an
4 issue you never had a chance to really raise, to put
5 forth evidence.

6 Let me hear from your opponent just in case the
7 Court missed something here on this issue.

8 Have a seat.

9 Yes, sir.

10 MR. NELSON: We did move on laches. I mean,
11 actually we've talked about it in chambers many times.
12 We submitted the evidence and we filed a written JMOL on
13 this issue.

14 Yesterday after the argument on the issue, which
15 was an argument on the laches issue consistent with the
16 summary judgment briefing, as your Honor referenced
17 earlier this morning that we had filed previously,
18 Mr. Brothers actually said, your Honor, it's okay if we
19 don't file anything? He didn't want to file anything
20 else. They went through -- he specifically said we have
21 no more witnesses to call. This is the only witness that
22 we have. They never intended to offer any additional
23 evidence, never did they ask the Court, never did they
24 apprise us that they wanted to offer any additional
25 evidence on laches.

1 We made the submission. They specifically asked
2 if they could not file anything with your Honor.
3 Therefore, they could have done the same thing. If they
4 believed that they had some evidence and wanted to make a
5 proffer, as we did to your Honor, then they could have
6 done that, but they chose not to do that. And now what
7 they are doing is exactly what your Honor has said. Now
8 they got an adverse ruling. What we have here is a
9 situation where they just didn't take the defense
10 seriously. They didn't think they needed to put on
11 evidence. They didn't think that they needed to do
12 anything. It was a serious defense. It's been a serious
13 defense from the beginning, and with all due respect to
14 them, they have been on notice of this since the
15 beginning of the case. If they chose not to come in and
16 offer your Honor any more evidence on that, well, that's
17 too bad. That would be just like I rested my case
18 yesterday. Now I'm supposed to come back and say, oh,
19 your Honor, I thought of one more thing and I didn't have
20 an opportunity to be heard. That's not the way trials
21 work.

22 THE COURT: Well, I just want to be clear the
23 Court wasn't imagining that's what the Court heard
24 yesterday afternoon --

25 I'm not ready to hear from you again,

1 Mr. Brothers.

2 Before the Court indicated that it would rule on
3 this matter and read those transcripts last night, the
4 Court's reasonable expectation would have been that you
5 would have said then, once he tendered those transcripts
6 for the Court to read, that, Judge, there's something
7 else I want you to consider on this motion before you
8 make any determination on this issue based on reading
9 those transcripts. That's what the Court would have
10 expected to be done. It never happened.

11 You also indicated to the Court that there were
12 not going to be any more witnesses because the Court's
13 concern in not addressing the motion for summary judgment
14 in the first place was that the Court wanted to make sure
15 it knew what was in the record on this issue before it
16 did anything.

17 The Court clearly recalls, I think you,
18 Mr. Brothers, responding to one of the Court's questions
19 about what were you doing? And the response was, Judge,
20 this goes to laches.

21 So you knew you had to put on some evidence.
22 You made reference to putting on evidence in the case, in
23 your case in chief when the Court questioned you. So you
24 have had more than ample opportunity to address this
25 issue, and so the Court absolutely rejects any suggestion

1 that you have been foreclosed with going forward with any
2 evidence in this case on the issue of laches. I think
3 this is a procedural issue and the Court is not prepared
4 to go back and run a trial this way. It's just not the
5 Court's experience as soon as the Court rules against a
6 party, then we start all over again with a new record.

7 The record on appeal is based on what the Court
8 considered before it ruled, not what you introduce after
9 the Court rules. If you wanted me to know something
10 more, you should have introduced it before the Court
11 ruled. And you knew I was going to rule because I gave
12 you overnight to do it. And if you didn't think about it
13 yesterday, you had an opportunity to think about it this
14 morning when the Court sat down and started to rule. You
15 still had an opportunity to stand up and say something
16 about it. You did not. You waited, and that's not the
17 way we are going to operate in here. A trial will never
18 end if a party can come in wanting to present new
19 evidence after you get an adverse ruling. And so, no,
20 the Court has ruled on that matter.

21 So, now what is it that you now intend to offer
22 so I will know exactly what the Court is rejecting?

23 MR. BROTHERS: I would simply point out to your
24 Honor that last night with regard to the transcript I
25 noted that the defendants had renewed their Rule 50

1 motion last week which the Court had denied, and I said
2 this morning, in reading from the transcript, "This
3 morning we --" I'm sorry. This is at page 1792, "This
4 morning they filed essentially the same thing. Do you
5 require a written response?"

6 And the Court said, "I don't require written
7 response. I think we recall where you went."

8 And on that issue we understood that the Court
9 was not going to accept a further written response.

10 THE COURT: No. You asked me did the Court
11 require an additional response? The Court indicated no.
12 That's not the same as you saying, Judge, I want to
13 supplement the record with what I have presented. That's
14 a different question. You didn't say, Judge, I want, as
15 a party, to supplement the record with what I have
16 presented. That's what you are called upon to do as a
17 lawyer. So, now, let's not misinterpret what happened
18 here.

19 MR. BROTHERS: Well, I understand the Court's
20 comments. The context as I understood, our having made
21 the JMOL, we were the moving party, and very clearly in
22 the record after I made that motion, a response was made
23 to our JMOL on laches.

24 THE COURT: And then they made a motion, a JMOL
25 on laches, and you stood up and you responded to it

1 yesterday afternoon.

2 MR. BROTHERS: Your Honor, the record indicates
3 that Mr. Sohn in his response was responding to our
4 motion on laches. This is at page 1785 and 1786 of the
5 transcript. I can proffer it to your Honor, but to be
6 clear, this was a response to plaintiff's motion.

7 THE COURT: Well, let me ask you something.
8 What do you call yourself doing yesterday when he stood
9 up and argued on laches and then you responded? What was
10 that?

11 MR. BROTHERS: I'm sorry, that was his response
12 to plaintiff's motion, and the Court said it would take
13 and it would review the materials that had been proffered
14 with regard to whether the Court was going to grant or
15 deny the plaintiff's motion.

16 THE COURT: The Court also addressed the matter
17 of the JMOL, so now you are standing here and telling the
18 Court that you didn't understand the Court was going out
19 and coming back and ruling on laches. Is that your
20 argument?

21 MR. BROTHERS: No, your Honor. I'm sorry if I'm
22 being unclear. It was plaintiff's motion on Rule 50 that
23 the defendants had not met their burden of proof on
24 laches. That was the pending motion. And we understood
25 that the Court was going to consider the materials

1 proffered by the defendants to determine whether it was
2 going to grant or deny the plaintiff's motion for JMOL on
3 laches.

4 THE COURT: So, in other words, you are saying
5 to the Court you didn't expect the Court in any way to
6 address whether the defendant's motion for laches should
7 be granted?

8 MR. BROTHERS: That's entirely correct, because
9 no motion was made. It's not here in the transcript and
10 we had understood, quite frankly, from the pretrial
11 conference and the Court's comments that laches would be
12 determined by the Court outside the presence of the jury.

13 THE COURT: And it did.

14 MR. BROTHERS: I'm sorry?

15 THE COURT: And it did. I tell you what, if the
16 Court has made an error, I'm sure the Federal Circuit
17 will correct me.

18 MR. BROTHERS: Will the Court permit us to make
19 our written proffer with regard to our proposed rebuttal
20 evidence regarding laches? Can we make that written
21 submission?

22 THE COURT: Well, the Court has ruled, number
23 one, you presented your evidence and you told the Court
24 that you had no further evidence to present. Now you are
25 coming back through the door suggesting you have

1 something.

2 Well, I can tell you what, just as a matter of
3 policy, the Court will permit you to give it to me, but
4 it's rejected, just for the record, but I'm not confident
5 that any Court of Appeals will let you attempt to game
6 the trial court this way, Mr. Brothers.

7 MR. BROTHERS: Your Honor, I respectfully
8 disagree that that's what we were trying to do.

9 THE COURT: That's not what you were trying to
10 do, that's what you are trying to do now.

11 Call the witness. Call him. Who are you going
12 to call, Mr. Blais?

13 MR. BROTHERS: We are prepared to proffer a
14 declaration from Mr. Blais, but you have already told us
15 you wouldn't hear that testimony.

16 THE COURT: Well, you can give a declaration of
17 Mr. Blais. I will let you proffer it for the record,
18 purely for the purposes of appeal.

19 MR. BROTHERS: And we expect to make a written
20 submission, your Honor, with regard to the other evidence
21 that we think that the Court disregarded in its
22 determination.

23 THE COURT: Well, I can tell you, you can appeal
24 it. You can file whatever motions you want. The Court
25 also -- you may want to wait until the Court issues a

1 memorandum order on its ruling, which the Court has the
2 authority to do. I mean, since you are now saying you
3 are going to issue -- you wait until the record is ripe
4 if you want to do any such a thing. Otherwise, that
5 will, likewise, be out of order and upside down as you
6 are on this motion here.

7 Okay. This declaration of Mark Blais, when did
8 you prepare this?

9 MR. BROTHERS: When we received your Honor's --

10 THE COURT: Ruling?

11 MR. BROTHERS: -- ruling. This is a proffer of
12 declaration. I'm sorry, let me hand it to opposing
13 counsel also. So I left the courtroom and I had a
14 conference call with Mr. Blais today, and so we tender
15 this information to the Court.

16 THE COURT: The Court will note, just even
17 glancing at it, this seems to be add odds with part of
18 his deposition testimony. But anyway, mark it as an
19 exhibit. The Court, basically, refuses the declaration.
20 It's submitted after the fact and with the benefit of the
21 Court's ruling, made after the Court had articulated its
22 ruling on the issue.

23 All right. Anything else?

24 MR. BROTHERS: We need to discuss, your Honor,
25 how we are going forward now in light of the Court's

1 ruling with regard to the evidence.

2 THE COURT: Okay. Let's do this. Let's bring
3 the jury back in and let them go home.

4 MR. BROTHERS: Thank you, your Honor.

5 THE COURT: Hold on, Mr. Taylor.

6 Let's be clear. Are there any more witnesses?

7 MR. BROTHERS: There are no more witnesses for
8 the jury's consideration, your Honor. The only witnesses
9 that we would proffer, which we understand the Court will
10 not hear, relates to the equitable defense of laches
11 based on the Court's ruling.

12 THE COURT: What witnesses? You told me you had
13 a declaration from Mr. Blais.

14 MR. BROTHERS: Well, we proffered Mr. Blais this
15 morning and asked if we could call him. You said no,
16 don't bring him down.

17 In addition, we would proffer for the Court --
18 again, this is not for the jury. This is for the Court
19 because it goes solely to laches -- Mr. Kosak on the
20 issue of laches.

21 THE COURT: You have had Mr. Kosak in here as a
22 witness in this case. You had him in here as a witness
23 in the case. You are now asking the Court to put it in
24 the record after the fact. I mean, you had an
25 opportunity to do that, Mr. Brothers, so, no, the Court

1 is not going to call Mr. Kosak as a witness. If you want
2 to make an oral proffer of what he would say, you are
3 welcome to do that, but the Court is not going to put him
4 back on the stand.

5 MR. BROTHERS: We will submit a written proffer
6 or I can make an oral proffer, but I believe we can let
7 the jury go home before we do that.

8 THE COURT: Well, you know, I'm prepared for you
9 to make your proffer right now. How long are you going
10 to be? You know what he's going to say. You are
11 pressing me to call him, so you obviously know what he's
12 going to say. You can make the proffer now.

13 MR. BROTHERS: Okay.

14 MR. NELSON: Judge --

15 THE COURT: Just a minute, Mr. Nelson.

16 MR. NELSON: May I say something, your Honor?

17 Just so you know and so the record is clear on
18 this, Mr. Kosak is not only sitting in here again
19 listening to all the testimony, he's been sitting here
20 listening to all the arguments. Your Honor ruled on this
21 issue yesterday on the 615 and now they want to call him
22 back up again after they chose not to heed your Honor's
23 ruling.

24 THE COURT: I tell you what, Mr. Brothers. You
25 can make a written proffer and you can put that in the

1 record along with Mr. Kosak, but the record will reflect
2 that the Court has already excluded him once before and
3 dealt with this issue. So you can, likewise, give me a
4 written proffer tomorrow morning and we will put it in
5 there as refused purely for appellate purposes.

6 MR. BROTHERS: We will do that, your Honor.
7 Thank you.

8 THE COURT: Bring the jury in.

9 (Jury in.)

10 THE COURT: You may be seated.

11 Let the record reflect all jurors are present in
12 the courtroom. Does counsel agree?

13 MR. CIMINO: Yes, your Honor.

14 MR. NELSON: Agreed, your Honor.

15 THE COURT: All right. Ladies and gentlemen,
16 all of the evidence is in in this case and the parties
17 have concluded, but what the Court has to do now is meet
18 with counsel to review the final instructions that you
19 will be given, and that's a lengthy process. So what the
20 Court is going to do is the Court is going to excuse you
21 to come back tomorrow morning at 9:30 a.m. We will start
22 with the -- no, no, hold on. 10:30, 10:30 a.m. so that
23 we can start with the closing arguments, and you should
24 get this case tomorrow for your deliberation.

25 Although the evidence is all in, the precautions

1 that the Court gave you in the beginning of this case
2 certainly apply. It's not time to conduct any research,
3 or to make up your mind, or do anything. Just wait until
4 tomorrow afternoon when you have an opportunity to get in
5 and deliberate.

6 Thank you for your attention. The Court will
7 see you in the morning at 10:30.

8 All rise.

9 (Jury out.)

10 THE COURT: You may be seated.

11 Yes, sir.

12 MR. NELSON: So at this point, your Honor, we
13 have a Rule 50(a) motion with respect to invalidity. We
14 also renew our prior Rule 50(a) motions.

15 I don't know how much argument you want on this,
16 your Honor, but with respect to the invalidity case, I
17 think on the anticipation first, with respect to the
18 Bowman reference you have just heard not only the
19 testimony of Dr. Ungar establishing that all the elements
20 are, in fact, present, but in addition you heard the
21 admissions of Dr. Carbonell here today that indicate
22 that, in fact, he says it doesn't disclose content-based
23 analysis. He says it doesn't disclose filtering, but as
24 to the filtering he admitted that there is a threshold
25 value and that things above the threshold will be

1 maintained, things below the threshold will be tossed
2 out, which is exactly what Dr. Frieder has accused of
3 infringement in the case.

4 Furthermore, with respect to the content-based
5 analysis in the Bowman reference, what Dr. Carbonell's
6 opinion is based solely upon the notion that words have
7 different meanings throughout the patent. He
8 acknowledges that the term "matching" in the first
9 instance in the patent refers to a content-based analysis
10 and content matching, but then contends when exactly the
11 same terminology appears later in the patent, that that
12 does not refer to a content-based matching.

13 With respect to the Culliss reference, your
14 Honor, he has indicated -- or there are two elements that
15 are challenged by the plaintiff's counsel. With respect
16 to the content-based analysis, similar to what we just
17 saw with Bowman, Dr. Carbonell just admitted that, in
18 fact, there is content-based analysis. He says that that
19 is overwhelmed eventually, but the initialization is
20 content-based and the claims themselves don't require a
21 particular amount. Therefore, based upon his own
22 admissions, that element is, in fact, present.

23 Additionally, he's just admitted on the stand
24 that -- well, actually that's a noninfringement argument,
25 your Honor. Never mind.

1 He has admitted that his opinion is completely
2 inconsistent with Dr. Frieder's infringement opinion, but
3 with respect now to the filtering, we've shown that the
4 filtering is, in fact, disclosed in the patent, that is
5 the rating term. He agrees that that is disclosed in the
6 patent. His argument is that he doesn't think it works,
7 which is, of course, an enablement argument, which was
8 never testified to nor raised.

9 As to the obviousness arguments, your Honor, he
10 based his arguments on a faulty application of the law.
11 He said that if he can find one of the elements that are
12 absent from the prior art, then there can be no
13 invalidity as a matter of law, which, of course, is not
14 the case.

15 He did not address the Graham factors. He did
16 not address the KSR standards, and furthermore, as to the
17 only element that he said was missing from the prior art,
18 this showing of searching for filtering for relevance to
19 the query, he, in fact, admitted that that is shown in
20 the prior art and, in fact, is disclosed in the
21 background section of the patent.

22 And then in addition to that, of course, we have
23 Dr. Ungar's testimony addressing the Graham versus John
24 Deer factors, addressing the KSR and establishing that it
25 would be obvious to one of ordinary skill in the art

1 given the disclosure in the prior art.

2 So that's the invalidity JMOL, your Honor. And,
3 of course, the obviousness goes to all the references
4 that we had submitted, the Fab article, the WebHound, the
5 Rose patent, as well as Bowman and Culliss, which
6 Dr. Ungar testified to the various combinations.

7 In addition, on the 50(a) I don't know if you
8 want any more argument on the previous 50(a) motions,
9 whether there are any more of those your Honor would be
10 interested in hearing further about. If there are, I'm
11 happy to address those, but I would leave that to your
12 Honor.

13 Now, as to damages, based upon your Honor's
14 ruling here, we have an additional issue because we have
15 a complete failure of evidence to support any damages
16 claim post-September 15th, 2011.

17 What Dr. Becker testified to, the only
18 evidence -- remember, his theory is royalty base times
19 the royalty rate equals a royalty. The only evidence
20 that he chose to put in the record was a cumulative
21 apportionment of royalties for the entire period, which
22 he put in at a big number. I'm not going to mention the
23 number here, your Honor. But he did not write that down
24 by quarters. There's no evidence of what the revenues
25 are by quarter, whether it be post-September 15th, 2011

1 or pre-September 15th, 2011.

2 That was plaintiff's choice. They wanted to
3 have Dr. Becker state a big number to the jury and they
4 chose not to break his apportionment down by quarters, so
5 they have a complete failure of proof.

6 Now, in response to some of the discussion and
7 your Honor's ruling this morning, there were several
8 references made to a chart that Dr. Becker had shown to
9 the jury that showed bars by quarter. That's a
10 demonstrative, first of all, so that's not evidence. He
11 never provided any testimony as to what the individual
12 amounts of the royalties would be on a per quarter
13 basis. There's no testimony in the record whatsoever to
14 support whether it be a royalty base to apply his royalty
15 to or a final royalty amount post-September 15th, 2011.

16 Now, this is plaintiff's choice. They knew --

17 THE COURT: Suppose the jury decides that, you
18 know, they find infringement? Suppose they find
19 infringement and the patent is still being used and they
20 assume that Dr. Becker's calculation of a 3.5 percent
21 royalty rate is appropriate? What's stopping the jury
22 from using the 3.5 percent running royalty figure from
23 the date -- whatever date the Court gives them?

24 MR. NELSON: Well, the problem is, your Honor,
25 they don't have anything to apply it to. There's no

1 evidence in the record to apply that to a revenue base.
2 They chose not to break that down on a post-September
3 15th, 2011 base despite the fact that they knew this
4 motion was out there and despite the fact that there were
5 other issues concerning infringement regarding their
6 source code, when certain templates were identified. So
7 this is something that plaintiff has been on notice of
8 and this was a trial strategy decision by them to try to
9 offer only a lump revenue in order to make that number
10 bigger. So, there is nothing for the jury to apply the
11 3.5 percent to, even if they would choose that the 3.5
12 percent is the appropriate amount.

13 THE COURT: Suppose they decided a lump sum
14 would be appropriate?

15 MR. NELSON: Well, then, your Honor, the only
16 evidence in the record is what Dr. Ugone testified to,
17 which would be the \$3 to \$5 million figure.

18 THE COURT: That's something.

19 MR. NELSON: No, I understand that that's
20 something.

21 THE COURT: Your argument was there was nothing
22 in the record.

23 MR. NELSON: Well, with respect to the running
24 royalty.

25 THE COURT: Okay.

1 MR. NELSON: So, I mean, if they want to argue
2 that Dr. Ugone's number is correct, they can do that, but
3 they can't argue as to the running royalty because they
4 have no evidence in the record to support a damages award
5 based on such an analysis.

6 THE COURT: All right. Fine. Let me hear
7 from --

8 Okay. Now, with respect to your motion, you
9 made a Rule 50 motion based on invalidity.

10 MR. NELSON: Correct, your Honor, as well as the
11 previous ones on noninfringement and damages, your Honor.

12 THE COURT: Okay.

13 MR. NELSON: And then, of course, the JMOL on
14 the laches, but that's already been granted, your Honor.

15 THE COURT: All right.

16 MR. CIMINO: Your Honor, I can address the
17 invalidity?

18 If it please the Court. I prefer to do it in
19 writing, if that's okay, but I could summarize the
20 testimony that was just given, if the Court would like.

21 THE COURT: Let's put it this way: You could
22 address it in writing. The simple truth is by the
23 schedule we are operating on, we would end up ruling on
24 it in the morning, and the Court intends to take up the
25 jury instructions with counsel. So you can give me your

1 oral statements now, but that's the Court's view. I
2 think that you, hopefully, should be able to address it
3 now.

4 MR. CIMINO: Sure. So, Mr. Nelson didn't
5 mention the burden of proof. The burden of proof for
6 invalidity is high. It's clear and convincing evidence.
7 That's what we are allowed by the patent office. So
8 everything is in the context of clear and convincing
9 evidence, and they have not met their burden of clear and
10 convincing evidence of invalidity.

11 On Bowman, the first point he mentioned was
12 filtering. There was clear testimony by Dr. Carbonell,
13 an established and well-respected expert in the field,
14 that it is not filtering according to the '420, '664
15 patent. It is a relative analysis by taking a ranking
16 threshold, not a clear threshold, or not an absolute
17 threshold in doing a one-by-one analysis.

18 In the Google product they filter first, then
19 rank. In the Bowman patent there was testimony by
20 Dr. Carbonell that what happens first is they rank all of
21 them and then they use a ranking, relative ranking
22 threshold to remove some. That is the difference between
23 the two products.

24 He also addressed the content analysis that
25 Dr. Carbonell says is missing. He says Dr. Carbonell is

1 reading words in the patent two different ways. Words in
2 the patent should be interpreted in accordance with the
3 contextual use in the patent. Dr. Carbonell was very
4 clear every time counsel pointed him to the word
5 "matched," whether it was in the background or whether it
6 was in the actual description of the Bowman facility.

7 In the background Bowman says that prior art
8 ways of doing it would match content of the article.
9 Then if you remember, your Honor, there was a statement
10 in Bowman that says, What I'm going to do is to look at
11 collaborative information rather than the attributes of
12 the item. I'm going to look solely at collaborative
13 rather than content. And then when he describes his
14 facility, he uses the word "matched" with different
15 prepositions. And when he uses the word "matched" later,
16 Dr. Carbonell has testified he's talking about the
17 keyword. So Dr. Carbonell did not take an inconsistent
18 position. The patent has to be put in context. He was
19 talking about the prior art, how it did it.

20 The part that Mr. Nelson left out of his
21 cross-examination was the transition. I don't want to do
22 it that way anymore. I'm going to do it the new way just
23 based on collaborative information and when he used
24 matched throughout the patent later, it was always with
25 respect to collaborative information. So matching,

1 Dr. Carbonell interpreted in context the way a person of
2 ordinary skill in the art would do in 1998 in view of the
3 entire reference.

4 He mentioned Culliss. Dr. Carbonell was very
5 clear that initialization is different, in his view, from
6 what happens when the Culliss facility is actually
7 processing articles. There is nothing in Culliss similar
8 to the Fig. 6 to the patent where you take content and
9 collaborative and combine them for a score. You set up
10 an initial index. It can be done in many different
11 ways. One of them could be content, but then as the
12 facility is running, it's purely collaborative.

13 Mr. Nelson mentioned filtering. Filtering was
14 not connected to the embodiment that was discussed about
15 how Culliss works. There is a separate embodiment that
16 talks about these ratings for X-rated and G-rated
17 content. The X-rated and G-rated labels are selected by
18 human judgment or by default. It's not content-based.
19 And Dr. Carbonell clearly indicated that that was a
20 separate rating from the actual discussion of how Culliss
21 is going to work and also indicated the problems in the
22 patent about how the filtering would be accomplished,
23 even if it was filtering.

24 He mentioned obviousness. Dr. Carbonell went
25 through the three references, said that Dr. Carbonell

1 didn't discuss the Graham factors. He didn't use the
2 term "Graham factors", but he went through the scope of
3 the prior art in detail. He showed profile systems, how
4 they worked; he showed search systems, how they worked
5 both in 1998; he showed the over-the-wall system, how
6 they worked; and then went into a detailed discussion of
7 how the claims are different, that the claims require
8 analysis of content data, collaborative data combined
9 together and then filtered with respect to relevance to
10 the query. While the query was on one side, it wasn't on
11 the other, and here's where the filtering was being done.

12 He also said that Dr. Carbonell did not do a KSR
13 analysis. That's untrue. He didn't use the case name,
14 but the issue in KSR is whether combination is
15 predictable. I clearly asked him whether he thought they
16 would be predictable to a person of ordinary skill in the
17 art to take the prior art methods and come up with the
18 claimed invention, and Dr. Carbonell went through several
19 different reasons, both academic and based on his
20 personal experience as to why that wouldn't be done.

21 Dr. Ungar had never taken the prior art and
22 stated how it would be combined to meet all of the
23 elements. He just said all of the elements were there.
24 So since it is defendant's burden to prove invalidity,
25 Dr. Carbonell did not have to build a strong combination

1 to then say that it didn't meet all of the elements. So
2 he didn't do that. But what he did say is there are four
3 elements, an element in every claim, that's totally
4 absent in the prior art, and I specifically asked him
5 whether a person of ordinary skill in the art in 1998
6 would be able to find that missing element and then
7 combine it to come up with the claimed invention. So the
8 testimony from Dr. Carbonell on both the two anticipation
9 and on all the prior art refutes JMOL of invalidity.

10 THE COURT: Thank you.

11 All right. The Court heard the defendant's
12 motion for judgment as a matter of law on the question of
13 invalidity. That motion is denied on all grounds.

14 The Court also denies your Rule 50 motion for
15 judgment as a matter of law on the issue of
16 noninfringement.

17 With respect to the issue of invalidity based on
18 obviousness, I think the simple fact is the question of
19 obviousness is a legal determination for the Court, not
20 for the jury. But the jury is responsible for making
21 certain underlying factual determinations, so the Court
22 in the verdict will submit certain interrogatories to the
23 jury on the issue of obviousness, and the Court will make
24 the ultimate determination on the issue of obviousness
25 based on using those factual findings in an advisory

1 capacity. That's what the case law provides and that's
2 what the Court will do.

3 With respect to some guidance on the issue of --
4 Let's see. What else did I miss here? Damages.

5 MR. BROTHERS: Your Honor, we have not yet
6 responded on the issue of damages.

7 THE COURT: Oh, yes. I think that's something
8 that you need to do.

9 MR. BROTHERS: Okay. On the issue of damages,
10 your Honor, the plaintiff concedes that Dr. Becker did
11 not provide a number for the amount of damages from
12 September 15, 2011 forward. What the jury did see was
13 this graphic with regard to the reasonable royalties by
14 quarter, and so starting effective the fourth quarter of
15 2011 this information was presented to the jury and so
16 that information is at least sufficient for, we believe,
17 the jury to have accepted and make a determination if the
18 Court instructs that damages need to be calculated solely
19 from September 15th forward.

20 THE COURT: Was that document introduced? What
21 exhibit number is this?

22 MR. BROTHERS: This is PDX-083. This was a
23 demonstrative exhibit.

24 THE COURT: So it was never even introduced?

25 MR. BROTHERS: As a demonstrative exhibit. It

1 was never marked and admitted into evidence.

2 THE COURT: They received the information. They
3 got the date of it and never got the physical exhibit
4 regarding the --

5 MR. BROTHERS: Well, this is not an exhibit they
6 will take back to the jury room, but the information on
7 this the jury was shown.

8 THE COURT: All right.

9 MR. BROTHERS: But you are correct, your Honor,
10 in that this exhibit itself was not marked as an admitted
11 exhibit.

12 So I think with regard to where we are left -- I
13 think the premise that there is an absence of proof to
14 support the plaintiff's case with regard to Dr. Becker's
15 testimony, I believe the evidence is in the record,
16 although I concede the specific number as of September
17 15, 2011 is not in there, and I believe we will require
18 guidance from the Court on how we present that to the
19 jury in our summations.

20 THE COURT: Well, you certainly cannot go back
21 to the jury and present information on a running royalty
22 as Dr. Becker calculated. The question for the Court was
23 whether there was sufficient information in the record
24 from which the jury could reasonably fashion a lump sum
25 royalty or a lump sum figure if they found infringement

1 based on infringement from the 11th of September forward
2 and the Court's view, based on what it's heard here,
3 there is sufficient information there for the jury to do
4 so.

5 Now, I know defendants would like to suggest
6 that, well, there's nothing there, so we are caught
7 between a choice of, I was going to say, a devil in a
8 dark blue suit, but I don't think so. I think there's
9 sufficient evidence in the record for the jury to make a
10 reasonable estimate damages, notwithstanding the fact
11 that Dr. Becker didn't give them a specific figure for
12 the period September 11th through the current date and
13 time. That's just the Court's view.

14 Now, where you find it in the record is
15 something counsel, I think, would probably be more adept
16 than the Court, but the Court believes it's there.

17 Mr. Nelson.

18 MR. NELSON: Your Honor, might I show you on the
19 Elmo, if I can, there were two questions and answers
20 regarding PDX-83, which is what he just showed you.

21 There we go.

22 So here we go. This is right after the question
23 you can see up at line 6 where he talks about this
24 overall number.

25 He goes down to PDX-83. "This is PDX 83?"

1 "Answer: It is.

2 "Can you explain this to the jury, please?

3 "This takes the total royalties that we just
4 talked about, the 493 million that is the result of
5 adding everything up through the third quarter of 2012,
6 and this shows the amounts by quarter that you would have
7 under a running royalty structure."

8 Okay. No testimony about amounts, revenues, any
9 of those kinds of things.

10 Next question. "So at the time of the high
11 hypothetical negotiations, according to PDX-83, what
12 would Google have paid, approximately?

13 "Answer: Well, in the hypothetical negotiation
14 time period, sort of off to the left on this chart
15 because it's in 2004, but you can clearly see the trend.
16 It would be amounts less than what you are seeing in the
17 quarterly payment, for example, in the fourth quarter of
18 2005, which are somewhere between 5 and 10 million, so it
19 would be a quarterly payment less than that."

20 So there's nothing for the jury to base it on
21 other than pure speculation. I mean, one, they are not
22 going to have the demonstrative; and, two, the only
23 thing, based upon this testimony they could even do, I
24 guess, is take out a ruler and measure the heights of
25 those bars.

1 THE COURT: This says that the quarterly
2 payments are somewhere between 5 million and 10 million.
3 That was in 2005. So now you are in 2012 trying to
4 estimate what would the approximate amount be. They do
5 know that.

6 MR. NELSON: But they don't have any information
7 to that, your Honor. It's just pure speculation. If
8 they want to argue for the lump sum that Dr. Ugone
9 submitted, that's their prerogative. That's evidence in
10 the record. But to argue for running royalty based upon
11 no evidence of what the revenues are or what the royalty
12 amount is would just lead the jury to pure speculation at
13 this point, your Honor, and that's their failure. They
14 had to opportunity to offer the proof and they didn't do
15 it.

16 THE COURT: Thank you.

17 MR. BROTHERS: Your Honor, I would note, first
18 of all, PX-64, which is the Google bar chart, has revenue
19 information which is a reference point for the jury.

20 I would also note that with regard to total
21 revenues, as the Court recalls, there was considerable
22 discussion during the course of trial whether the total
23 revenues would be admitted, and your Honor, I believe
24 where we eventually ended up was the total revenues of 67
25 billion would not be presented to the jury, rather what

1 got to the 14 billion, which was the allocated number,
2 that was something Dr. Becker would be permitted to speak
3 to but that the defendants were not going to be
4 separately attacking the revenue numbers for that, and
5 that was our understanding on which the evidence was
6 proffered.

7 Now we have a change of position in which the
8 defendants are saying there's an absence of proof with
9 regard to the revenue numbers because of your Honor's
10 concern with regard to the total amount of revenues and
11 limiting how the allocative revenues were going to be
12 provided to the jury. So based on the Court's prior
13 rulings, we had proceeded one way and now the defendants
14 are saying that there's a failure of proof because of the
15 evidence as it came in.

16 THE COURT: I don't think the Court's prior
17 ruling with respect to the \$67 billion or having
18 Dr. Becker focus on the 14 million in any way restrained
19 the capacity of the plaintiff to put in evidence about
20 what the revenue figures were.

21 You had the bar chart. He could have just
22 easily put in dollar figures as measuring -- by using a
23 ruler to measure it. That didn't restrain you from
24 putting in the actual dollar figures. The Court didn't
25 do that.

1 I'm not so confident still, just based on
2 listening to what you are arguing, that there's still not
3 a reasonable way for the jury to find a lump sum that the
4 plaintiff is due if they find that there has been an
5 infringement of this patent. You spent a considerable
6 amount of time talking about the worth of this patent and
7 etc., so I'm not convinced of that. So you are probably
8 going to have to think about it and you probably will
9 have to take it up again in the morning if you don't have
10 an answer to it. But I don't believe that there's just
11 nothing in the record so here we are if we get a verdict,
12 we can't figure out the damages. The Court rejects that.

13 MR. NELSON: No, no, I understand your Honor.
14 Just for clarification, they are not allowed to argue for
15 a running royalty, right? I mean, there is no evidence
16 in the record to support a damage award based on that.
17 If they want to argue a lump sum, then from what I
18 understand your Honor is saying --

19 THE COURT: They certainly can't argue a running
20 royalty from 2004 to September 2011, but if they find the
21 patent is still being infringed and it's being infringed
22 from September 2011 to the current date, they certainly
23 can suggest that a royalty is due for that period of
24 time. You just can't do it for the period that the Court
25 has excluded.

1 MR. NELSON: I understand, your Honor, but what
2 would the jury base the number on? That's my question
3 with respect to it. What would they apply the royalty
4 to?

5 THE COURT: What would they apply it to?

6 MR. NELSON: Correct.

7 THE COURT: As I recall, for each of the
8 quarters Dr. Becker came to and he calculated a certain
9 percentage for each one of these quarters starting back
10 in 2004-2005. When he was doing that, he was looking at
11 the amount of increase that Google had experienced -- had
12 derived from the accused product and he was using that to
13 calculate a percentage increase. So I'm suggesting that
14 everything is not tainted in this case. Only the
15 revenues and the calculation for that period in 2004 up
16 to September 11th, as far as the Court is concerned, is
17 at stake here. Now, you might want to throw out the baby
18 and the wash water, too, but the Court just doesn't
19 believe that.

20 MR. NELSON: No, no, I understand that. I was
21 just trying to get an idea what they would be allowed to
22 argue since there is actually no evidence of the revenues
23 for that --

24 THE COURT: Let's put it this way. Counsel know
25 their case better than the Court does, and I will wait

1 for a suggestion from counsel on exactly where they want
2 to go, understanding what the restrictions are.

3 MR. NELSON: Okay.

4 THE COURT: You cannot argue for a running
5 royalty from 2004 to 2011. In fact, it's going to come
6 up on the jury instructions. I was trying to remember
7 who proposed asking the jury if they found infringement,
8 whether they were going to base any award on the running
9 royalty or a lump sum, and the Court when it initially
10 drafted these jury instructions had, in fact, included
11 that. That was before the Court ruled on the laches
12 motion.

13 But the Court has to evaluate and counsel need
14 to evaluate whether it's appropriate under those
15 circumstances to pose that question to the jury.

16 MR. BROTHERS: Your Honor, I believe that
17 putting an interrogatory to the jury with regard to if
18 the jury believes that a running royalty is appropriate,
19 the running royalty rate is appropriate. There is
20 considerable evidence --

21 THE COURT: Yes, if you put the question up
22 there on the running royalty, the second question the
23 Court certainly would include would be what do you
24 believe the running royalty rate should be?

25 MR. BROTHERS: Yes, and there's considerable

1 evidence with regard to the rate.

2 THE COURT: Okay. What we want to be sure of is
3 the whole question of whether you should pose the
4 question of a running royalty rate, and the Court has
5 suggested it might be a short running, but it's possible
6 based on the evidence.

7 The Court has to fashion a charge that takes
8 reasonable account of the testimony and the evidence in
9 the case. Now, the Court doesn't believe at this
10 juncture, unless someone wants to persuade the Court,
11 that all potential evidence for running royalty has been
12 excluded from the case. It's short, but that's the
13 Court's view on that.

14 It was the Court's original intent to try to
15 meet with counsel to go over this charge this afternoon,
16 but it's clear that the Court has to go back and rework
17 the verdict sheet. The verdict sheet needs to be
18 substantially reworked to include some interrogatories on
19 the Graham factors, and neither party proposed any
20 interrogatories on the question of obviousness. The
21 Court didn't see it. I looked at your verdict sheets and
22 it's not on your verdict sheets. I have been living with
23 those verdict sheets and it's not on the verdict sheets,
24 the list of questions. So the Court has to go back and
25 rework that.

1 So what the Court is going to do is direct
2 counsel to meet with the Court tomorrow morning at 9 so
3 that we can take a look at this charge, get a chance to
4 go through it and try to rework parts of it that needs to
5 be reworked.

6 For the most part, the parties, I'm sure you saw
7 each other's charge. You proposed the same thing with
8 the exception of some matters that defendants raised that
9 the Court traditionally does not give in patent cases and
10 I don't think I'm going to give them in this case, so we
11 will deal with that when we get to the charge
12 conference. I don't think that it's necessary.

13 The Court has great respect for the law, but
14 sometimes we can misstate case law in giving jury
15 instructions and so the Court has a tendency to stay away
16 from that. So I'm just putting you on notice.

17 All right. I will see you tomorrow morning at
18 9:00. Meanwhile, you think about how you want to
19 approach the damages. I think that's something that
20 counsel has to deal with here.

21 (Court adjourned for the evening recess at
22 4:14 p.m.)

23 * * *

24 CERTIFICATION

25 I certify that the foregoing is a correct

1 transcript from the record of proceedings in the
2 above-entitled matter.

3
4 X /s/ Sharon B. Borden X

5 Sharon B. Borden, RMR, FCRR

6 X October 31, 2012 X

7 Date
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