

1 WILKE, FLEURY, HOFFELT, GOULD & BIRNEY, LLP
Thomas G. Redmon (SBN 47090)
2 TRedmon@wilkefleury.com
Daniel L. Baxter (SBN 203862)
3 DBaxter@wilkefleury.com
400 Capitol Mall, 22nd Floor
4 Sacramento, CA 95814
Phone: (916) 441-2430
5 Fax: (916) 442-6664

6 NIRO, HALLER & NIRO
Raymond P. Niro (*Admitted Pro hac vice*)
7 RNiro@nshn.com
Raymond P. Niro, Jr. (*Admitted Pro hac vice*)
8 RNiroJr@nshn.com
Brian E. Haan (*Admitted Pro hac vice*)
9 BHaan@nshn.com
Anna B. Folgers (*Admitted Pro hac vice*)
10 AFolgers@nshn.com
181 West Madison, Suite 4600
11 Chicago, IL 60602-4515
Phone: (312) 236-0733
12 Fax: (312) 236-3137

13 Attorneys for Plaintiff, IconFind, Inc.

14 IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF CALIFORNIA

15 ICONFIND, INC.,

Case No. 2:11-cv-00319-GEB-JFM

16 Plaintiff,

**JOINT STATEMENT RE DISCOVERY
DISAGREEMENT**

17 v.

18 GOOGLE INC.,

Hearing Date: July 28, 2011

Time: 11:00 a.m.

8th Floor Courtroom

19 Defendant.

Before the Honorable Judge John F. Moulds

20
21 Pursuant to Local Rule 251, the Parties hereby submit to the Court a Joint Statement re
22 Discovery Disagreement. The Parties seek the Court's guidance on the disputed issues of
23 whether: (a) Google has properly calculated Iconfind's interrogatories; as exceeding twenty-

1 five; and, if so, (b) IconFind should be granted leave to serve additional interrogatories than the
2 twenty-five interrogatories provided for by Federal Rule of Civil Procedure 33(d).

3 **A. Details of the conference or conferences;**

4 On February 3, 2011, IconFind filed this suit in the United States District Court for the
5 Eastern District of California for infringement of its United States Patent No. 7,181,459 B2,
6 entitled "Method Of Coding, Categorizing, And Retrieving Network Pages And Sites," which
7 issued on February 20, 2007 ("the '459 Patent"). On May 17, 2011, IconFind served on Google
8 its First Set of Interrogatories Nos. 1-16 and First Set of Request for Production Nos. 1-45. (Ex.
9 A). On May 26, 2011, Google informed IconFind of its position that its interrogatories, as
10 originally served, materially exceeded the limit of twenty-five set forth in Fed.R.Civ.P. 33(a)(1)
11 – as calculated by Google – and requested IconFind to advise whether it would retract its
12 interrogatories and re-serve them. Google advised IconFind that if it was unwilling to retract and
13 re-serve its interrogatories, Google would respond to the first twenty-five only and object to the
14 remaining interrogatories as over the limit. The parties participated in a meet and confer on this
15 issue on May 31, 2011. During the meet and confer, Google informed IconFind of the bases for
16 its count of IconFind's interrogatories as originally served. IconFind responded that given
17 Google's position, additional interrogatories beyond the limit set forth in Rule 33 would be
18 necessary and requested Google to stipulate instead to seventy-five interrogatories. Google
19 declined to so stipulate and stated that the parties had already agreed that only 25 interrogatories
20 were necessary. Google reiterated its position that if agreement could not be reached, it would
21 only answer the first 25 interrogatories and object to the remainder. In an effort to expedite
22 obtaining relevant discovery, IconFind, without admitting that Google's objections have any
23 merit, withdrew (and reserved the right to re-serve) Interrogatory Nos. 2, 6, 7, and 9-16. (Ex. B).

Google on June 20, 2011 served its responses to Interrogatory Nos. 1, 3-5, and 8 (maintaining its objections that these interrogatories were compound). (Ex. C).

B. Statement of nature of the action and its factual disputes insofar as they are pertinent to the matters to be decided and the issues to be determined at the hearing;

This is an action for infringement of United States Patent No. 7,181,459 B2. IconFind has accused Google of infringement of at least claims Google has infringed and continues to infringe at least claims 1, 6, 9, 16, 17, 19, 20, 21, 22, 29, 30 and 31 of the '459 patent under 35 U.S.C. § 271(a) through Google's use, ownership and operation of websites in which it incorporates and facilitates Creative Commons licenses, including but not limited to Google Knol, Google Books and Google Picasa. (Complaint, ¶ 7, Dkt. No. 1).

IconFind in its discovery requests defined the "Accused Google Instrumentality" as "each Google website that incorporates and facilitates Creative Commons licenses ('the Creative Commons Feature'), including but not limited to Google Knol (www.knol.google.com), Google Books (www.books.google.com) and Google Picasa (www.picasa.google.com) and all software and hardware which provide and support these websites, including without limitation, databases, interfaces, computer networks, applications, servers, storage systems, entry systems and processing systems." (Ex. A).

Google's position is that many of IconFind's interrogatories contain numerous discrete subparts: (1) Nos. 1-5 each constitute three separate interrogatories as they relate to three separate Google products; (2) No. 6 constitutes at least two interrogatories, one directed to when Google first became aware of the '459 Patent and another requesting information concerning action taken by Google with respect to designing around the patent-in-suit; (3) No. 7 constitutes at least two interrogatories, one directed at Google's contentions regarding a reasonable royalty and another requesting identification of documents; (4) No. 8 constitutes six interrogatories

1 because it relates to three separate Google products, and requests that Google, for each product,
2 include a non-infringement claim chart and identify persons “having knowledge relating to the
3 facts provided in response to this interrogatory”; (5) Nos. 9-15 each constitute at least two
4 interrogatories because they each request at least the following subparts: “identify all information
5 including, but not limited to, documents considered, reviewed and/or relied upon by Google as a
6 basis for the facts and assertions provided in response to this interrogatory, with reference to
7 Bates numbers in accordance with Fed.R.Civ.P. 33(d)” and “identify persons having knowledge
8 concerning facts provided in response to this interrogatory”; and (6) No. 16 constitutes at least
9 two interrogatories because it also requests that Google identify persons with relevant
10 information as well as documents to be consulted by that person in preparation for his or her
11 testimony. Thus, as to interrogatories numbered 1, 3-5, and 8 (which have been answered),
12 Google believes these should be counted as 18 interrogatories. As to the 11 interrogatories
13 retracted by Iconfind, Google believes these remaining interrogatories as previously propounded
14 would amount to 23 additional interrogatories, bringing the total to 41.

15 IconFind disagrees and seeks an order from the Court to order Google to answer retracted
16 Interrogatory Nos. 2, 7, and 9-16 as originally served. (Ex. A). In regards to Interrogatory No.
17 6, Iconfind concedes that this interrogatory could be interpreted as two interrogatories and will
18 reserve this interrogatory after this Court rules on the current dispute. However, should the
19 Court find that these interrogatories all contain discrete subparts, IconFind requests leave to
20 serve an additional fifty interrogatories than provided for in Rule 33, or, seventy- so that it can
21 reserve its highly relevant and proper interrogatories.

1 **C. Contentions of each party as to each contested issue, including a**
2 **memorandum of each party’s respective arguments concerning the issues in**
3 **dispute and the legal authorities in support thereof.**

4 **1. Plaintiff IconFind’s Contentions**

5 **(a) Google’s Objections to IconFind’s Interrogatories Are Unfounded**

6 The purpose of discovery is to make trial “less a game of blind man's bluff and more a
7 fair contest with the basic issues and facts disclosed to the fullest practicable extent possible.”
8 Duhn Oil Tool, Inc. v. Cooper Cameron Corp., 2010 WL 716306, *1 (N.D. Cal. Mar. 2, 2010)
9 (citing United States v. Procter & Gamble, 356 U.S. 677, 68S (1958)). Federal Rule of Civil
10 Procedure 26(b) establishes the scope of discovery and states in pertinent part: “[p]arties may
11 obtain discovery regarding any matter, not privileged, that is relevant to the claim or defense of
12 any party, including the existence, description, nature, custody, condition, and location of any
13 books, documents, or other tangible things and the identity and location of persons having
14 knowledge of any discoverable matter ... Relevant information need not be admissible at trial if
15 the discovery appears reasonably calculated to lead to the discovery of admissible evidence.”
16 “The party who resists discovery has the burden to show that discovery should not be allowed,
17 and has the burden of clarifying, explaining, and supporting its objections.” Duhn Oil Tool, Inc.,
18 2010 WL 716306, *1 (E.D. Cal. Mar. 2, 2010) (citing Oakes v. Halvorsen Marine Ltd., 179
F.R.D. 281, 283 (C.D. Cal. 1998)).

19 Pursuant to Rule 33(a), a party may not serve on its adversary more than twenty-five
20 interrogatories, including all discrete subparts. “Although the term ‘discrete subparts’ does not
21 have a precise meaning, courts generally agree that ‘interrogatory subparts are to be counted as
22 one interrogatory ... if they are logically or factually subsumed within and necessarily related to
23 the primary question.” Superior Communications v. Earhugger, Inc., 257 F.R.D. 215, 218 (C.D.
24 Cal. 2009). “An interrogatory containing subparts directed at eliciting details concerning a

1 ‘common theme’ should generally be considered a single question.” Swackhammer v. Sprint
2 Corp. PCS, 225 F.R.D. 658, 664-65 (D. Kan. 2004).

3 Primarily at issue are two categories of interrogatories which seek highly relevant
4 information in this case: (1) Nos. 1-5 and 8 seek information related the instrumentalities
5 accused of infringement of the ‘459 Patent (Google Picasa, Google Books and Google Knol);
6 and (2) Nos. 9-15 seek the complete factual basis of Google’s contentions, the identity of all
7 information including, documents considered, reviewed and/or relied upon by Google as a basis
8 for the facts and assertions provided in response to each interrogatory, with reference to Bates
9 numbers in accordance with Fed.R.Civ.P. 33 and the identity of persons having knowledge
10 concerning facts provided in response to each interrogatory. (Ex. A). The contentions at issue in
11 Interrogatory Nos. 9-16 include:

- 12 • Google's Counterclaim II and Second Affirmative Defense that the “[t]he ‘459
13 patent is invalid under 35 U.S.C. § 101” (Ex. A, Interrogatory No. 9);
- 14 • Google’s Counterclaim II and Second Affirmative Defense that the ‘459 Patent is
15 invalid for failure to meet the “conditions of patentability of 35 USC § 102” (Ex.
16 A., Interrogatory No. 10);
- 17 • Google's Counterclaim II and Second Affirmative Defense that the ‘459 Patent is
18 invalid for failure to meet “the conditions for patentability” of 35 USC § 103 (Ex.
19 A, Interrogatory No. 11);
- 20 • Google's Counterclaim II and Second Affirmative Defense that the ‘459 Patent is
21 invalid because it fails to meet the conditions for patentability of 35 USC § 112
(Ex. A, Interrogatory No. 12);
- 22 • Google's Third Affirmative Defense that “IconFind’s claim for damages, if any,
23 against Google for alleged infringement of the ‘459 patent are limited by 35
24 U.S.C. §§ 286, 287, and/or 288” (Ex. A, Interrogatory No. 13);
- 25 • Google's Fourth Affirmative Defense that “[o]n information and belief,
IconFind’s claims for relief are barred, in whole or in part, by the equitable
doctrines of laches and estoppel” (Ex. A, Interrogatory No. 14); and
- Google’s Fifth Affirmative Defense that “[a]ny and all products or actions
accused of infringement have substantial uses that do not infringe and do not

1 induce or contribute to the alleged infringement of the claims of the '459 Patent"
2 (Ex. A, Interrogatory No. 15).

3 Interrogatory No. 16 seeks the identity of:

4 [E]ach and every person known to Google who it believes has knowledge of facts that
5 Google believes are pertinent or relevant to this Lawsuit (including, but not limited to,
6 any person whom Google intends to call as a fact witness under Fed. R. Evid. 702, 703,
7 or 705 and who is not retained or specifically employed to provide expert testimony in
8 this case by Google) by providing at least his/her name, most current or last known
9 address and, if known, phone numbers, a concise description of the nature of their
10 association with the parties and the substance of any such knowledge, and identification
11 of all persons and documents consulted or to be consulted by each such witness in
12 preparation for his or her testimony.

13 (Ex. A). Accordingly, Interrogatory No. 16 sits in a category of its own to the extent is
14 seeks essentially the same information that IconFind is entitled to obtain pursuant to
15 Fed.R.Civ.P. 26(a).

16 In regards to Category 1, Google asserts that because IconFind has accused three Google
17 instrumentalities of infringement, each interrogatory that requests information concerning the
18 Accused Google Instrumentality (which has been defined as including all three products),
19 constitutes not one interrogatory but three. Taken to its logical conclusion, if IconFind had
20 accused twenty-five Google instrumentalities of infringement of one claim of one patent,
21 **IconFind would be allowed to serve only one narrowly-tailored interrogatory under the**
22 **Federal Rules.** This is improper and is at odds with Fed.R.Civ.P. 33(d). See Advisory
23 Committee Note to 1993 Amendment to Fed.R.Civ.P. 33(d) ("the aim [of the numerical limit] is
24 not to prevent needed discovery, but to provide judicial scrutiny before parties make potentially
25 excessive use of this discovery device"). Through its Category 1 interrogatories, IconFind seeks
highly relevant information concerning the instrumentalities that it has accused Google of
infringement. (Ex. A). For example, Interrogatory Nos. 1-3 seek information concerning the
structure, function and operation of and the design and development history of the Accused

1 Google Instrumentalities which are relevant to IconFind's claims of infringement and Google's
2 claims of non-infringement. Interrogatory Nos. 4-5 seek usage statistics and financial
3 information necessary to prove IconFind's damages claims. Simply put, to accept Google's
4 argument would simply catapult form over substance to the prejudice of IconFind.

5 Google's reliance on Stamps.com v. Endicia, Inc., 2009 WL 2576371, *3 (C.D. Cal. May
6 21, 2009), for the proposition that the Category 1 interrogatories constitute numerous and
7 discrete subparts because they are directed toward all three of the accused products is
8 inappropriate. In Stamps.com, the plaintiff's non-infringement contention interrogatory
9 requested:

10 For each of the accused products with respect to which [defendants] deny [plaintiff's]
11 allegations of infringement or seek a declaration of non-infringement, identify such
12 product by name and description, and provide a claim chart showing with specificity on a
claim by claim basis, why the product does not infringe **each of the patents in suit**.

13 Id. at *1 (emphasis added). While the court found that this interrogatory was directed to
14 distinct subjects, this interrogatory seeks information concerning infringement of not one patent-
15 in-suit, which is the case here, but "over 600 claims" in twelve patents. Id. at *2, *4. In this
16 case, IconFind seeks Google's non-infringement positions for three products and twelve claims
17 of one patent. Clearly this case is distinguishable.

18 Moreover, each accused instrumentality is merely a logical extension of each "basic
19 interrogatory" of which they are a part. Chapman v. California Dep't. of Edu., 2002 WL
20 32854376, *1 (N.D. Cal. Feb. 6, 2002) ("...the question is whether ... the subparts are a logical
21 extension of the basic interrogatory"). The Category 1 interrogatories seeks information related
22 to only one specific question. (Ex. A). The information requested for each accused
23 instrumentality is logically and factually subsumed within and necessarily related to the primary
24 question asked in each interrogatory. Stamps.com, 2009 WL 2576371 at *3 (C.D. Cal. May 21,

2009) (“[a]lthough the term ‘discrete subparts’ does not have a precise meaning, courts generally agree that ‘interrogatory subparts are to be counted as one interrogatory ... if they are logically or factually subsumed within and necessarily related to the primary question”). The “common theme,” for instance, in Interrogatory No. 4 is the usage statistics of the Accused Instrumentalities; in Interrogatory No. 5, it is the quarterly revenues and quarterly profit of the Accused Instrumentalities. (Ex. A); Swackhammer v. Sprint Corp. PCS, 225 F.R.D. 658, 664-65 (D. Kan. 2004) (“An interrogatory containing subparts directed at eliciting details concerning a ‘common theme’ should generally be considered a single question”). As such, Google’s objections to these interrogatories as containing numerous and discrete subparts should be denied.

In regards to Category 2, Google asserts that because each interrogatory seeks fact supporting Google’s contentions, persons with knowledge of those facts, and documents containing those facts, that they are three separate requests. This district court held otherwise on this **precise issue** in Stamps.com v. Endicia, Inc., 2009 WL 2576371, *3 (C.D. Cal. May 21, 2009). The plaintiff in Stamps.com served an even broader interrogatory than the Category 2 interrogatories at issue here, seeking:

On a claim by claim basis, state with specificity all facts and reasons known to [defendants] that support [defendants’] allegation that each of the Patents in Suit are invalid, identify all natural persons with knowledge of such fact or reason, and identify all documents, references or facts that [defendants] contend **render the claim invalid either individual or in combination.**

For each of the accused products with respect to which [defendants] deny [plaintiff’s] allegations of infringement or seek a declaration of non-infringement, identify such product by name and description, and provide a claim chart showing with specificity on a claim by claim basis, why the product does not infringe each of the patents in suit.

Id. at *1 (emphasis added). The court plainly stated in response to defendants’ numerous and discrete subparts objection: “This court finds that the requests for facts, persons with

1 knowledge of those facts and documents containing those facts should be considered one
2 interrogatory because they are subsumed within the primary question of facts supporting
3 defendants' infringement and invalidity contentions." Id. at *3. The interrogatories at issue here
4 are even more narrow than the interrogatories served in Stamps.com: they separately address
5 each invalidity claim **per legal theory** (e.g. anticipation under Section 102, obviousness under
6 Section 103 and indefiniteness under Section 112) and **per affirmative defense**, rather than
7 grouping together in one interrogatory **all counterclaims and affirmative defenses together**
8 **under the umbrella of invalidity**. Accordingly, the Category 2 Interrogatories properly seek
9 the disclosure of facts, persons with knowledge of those facts and documents containing those
10 facts and are subsumed within the primary question of what facts support Google's contentions.

11 In regards to Interrogatory No. 16, Google has not articulated a substantive position as to
12 why this interrogatory constitutes multiple discrete subparts. IconFind asserts that this is due to
13 the fact that this interrogatory is directed towards one logically related topic: persons with
14 relevant information, their contact information and the identity of that relevant information.

15 In sum, each and every one of IconFind's interrogatories seeks highly relevant
16 information that IconFind is entitled to obtain pursuant to the Federal Rules. To deny IconFind
17 access to basic information, evidence and documents which are necessary to support its claims of
18 infringement and to defend against Google's counterclaims and affirmative defenses is
19 prejudicial and improper. As such, the Court should deny Google's objections and order Google
20 to answer all remaining interrogatories as originally served by IconFind (with the exception of
21 Interrogatory No. 6).

1 **(b) Should the Court Accept Google’s Objections, IconFind Respectfully**
2 **Requests Leave To Serve An Additional Fifty Interrogatories**

3 Under both Rule 26(b)(2) and Rule 33(a) a court may grant leave to serve additional
4 interrogatories and the “[l]eave to serve additional interrogatories shall be granted to the extent
5 consistent with the principles of Rule 26(b)(2).” The parties may also agree by written
6 stipulation to the service of additional interrogatories. See Fed.R.Civ.P. 29. In this case Google
7 has refused to stipulate and has instead refused to answer any interrogatory after the first twenty-
8 five it considered to be separate requests. While IconFind retracted several requests in an effort
9 to obtain at least some discovery information from Google expeditiously, IconFind must serve
10 additional interrogatories directed to the information it sought in its withdrawn interrogatories.
11 As such, should this Court agree with Google’s position, IconFind respectfully requests that this
12 court grant IconFind of leave to serve an additional fifty interrogatories as consistent with the
13 principals of Rule 26(b)(2).

14 “In many cases, it will be appropriate for the court to permit a larger number of
15 interrogatories in the scheduling order entered under Rule 26(b).” Advisory Committee Notes,
16 1993 Amendments. This flexibility is consistent with the requirement that the Federal Rules of
17 Civil Procedure “be construed and administered to secure the just, speedy, and inexpensive
18 determination of ever action.” Fed.R.Civ.P. 1. Moreover, “[t]he aim of the [numerical limit] is
19 not to prevent needed discovery, but to provide judicial scrutiny before the parties make
20 potentially excessive use of the discovery device.” Safeco v. Rawstron, 181 F.R.D. 441, 443
21 (C.D. Cal. 1998) (citing Advisory Committee Notes, 1993 Amendments). Patent cases, in
22 particular, “where the issues are often more complex than the typical federal case for which the
23 presumptive limit was developed, leave to exceed 25 interrogatories may we be appropriate.”
24 Protective Optics, Inc. v. Panoptx, Inc., 2007 WL 963972, *2 (N.D. Cal. Mar. 30, 2007)

1 (granting motion to compel response to contention interrogatories seeking identification of
2 claims allegedly not met by the accused products); see also Collaboration Properties, Inc. v.
3 Polycom, Inc., 224 F.R.D. 473 (N. D. Cal 2004) (interrogatory limit expanded to 50 in patent
4 infringement suit).

5 In Chapman v. California Dept. of Educ., 2002 WL 32854376 (N. D. Cal. Feb. 6, 2002),
6 the court was faced with this exact issue assumed for the sake of argument that the requests were
7 two separate interrogatories and *sua sponte* granted the plaintiff leave to serve additional
8 interrogatories. In so holding, the court stated:

9 Here, although the thirty-four interrogatories are over the numerical limit imposed by
10 Rule 33(a), the interrogatories are neither cumulative nor duplicative. The subject matter
11 of the interrogatories (e.g., relating to assessment of the test validity, etc.) **appear**
12 **directly relevant to the issues in the case.** Moreover, the request to identify documents
13 (the second subpart of the interrogatory) could have been propounded as a request for
production of documents under Rule 34 for which the Rule 33(a) numerical limit of
interrogatories would not apply. **To limit discovery which is clearly relevant under**
these circumstances would exalt form over substance. Therefore, the Court *sua sponte*
grants Plaintiffs leave to serve the interrogatories at issue.

14 Id. at *2 (emphasis added). The same is true in this case. Iconfind is clearly entitled to
15 the information it seeks through both its Category 1 and 2 interrogatories. The Category 1
16 interrogatories seeks information concerning the instrumentalities accused of infringement in this
17 case. The Category 2 interrogatories seek all facts that Google intends to use to support its
18 counterclaim for non-infringement and invalidity and corresponding affirmative defenses.
19 Additionally, these interrogatories seek the identity of the persons with knowledge of the
20 interrogatory and the documents Google will use to support its contentions. These
21 interrogatories clearly request relevant information and Iconfind should be granted leave to serve
22 additional interrogatories to obtain this information should the court find that the Category 1 and
23 2 interrogatories contain numerous discrete subparts.

Moreover, had Google not unreasonably refused in contravention of the caselaw in this district to stipulate to the additional interrogatories requested, the parties would not have had to burden the court with the issue. This district court's analysis in Stamps.com, 2009 WL 2576371 at *3 (C.D. Cal. May 21, 2009) in regards to the cooperation expected amongst parties when dealing with situations such as this is telling: "[i]n any event, **given that defendant ...should have reasonably stipulated** to permitting a reasonable number of excess interrogatories in this action involving twelve patents ... the court would permit the additional interrogatories." (emphasis added). This district's sister court takes a similar approach: "reasonable parties should stipulate to appropriate additional interrogatories in a complex case [], rather than engage in motion practice." Protective Optics, Inc. v. Panoptx, Inc., (N.D. Cal. Mar. 30, 2007). The court in Protective Optics, "[i]n view of Defendant's unreasonable failure to do so," allowed additional interrogatories. Id. at *2. The court in this case, in light of Google's unreasonable refusal to stipulate to IconFind's request to serve additional interrogatories where they are obviously necessary in light of Google's own positions, should grant IconFind's motion for leave.

Accordingly, should this Court find that Google's objections have merit, IconFind respectfully requests that this Court grant IconFind leave to serve an additional fifty interrogatories in this case.

2. Defendant Google's Contentions

a. Only The Number Of Discrete Subparts Contained In Interrogatory Nos. 1, 3-5, And 8 Are Properly Before This Court

The only issue properly before this court is how many interrogatories have been served and answered at this point in the litigation. In order to determine that issue, the Court must decide how many discrete subparts are contained in IconFind's Interrogatory Nos. 1, 3-5, and 8. Fed.R.Civ.P. 33(a). Google's position is that these interrogatories amount to eighteen separate

1 interrogatories. If the Court agrees, then Iconfind has seven remaining interrogatories. The
2 parties, with the Court's guidance on this issue, can then evaluate whether or not Iconfind's
3 agreement to be bound by the twenty-five interrogatory limit must be revisited.

4 On May 17, 2011, Iconfind served eighteen interrogatories consisting of more than
5 twenty-five discrete subparts. Rather than answering the first twenty-five interrogatories and
6 objecting to the remaining interrogatories and thereby foreclosing IconFind's ability to prioritize
7 its discovery requests, Google, in good faith and exactly as Moore's Federal Practice suggests,¹
8 alerted IconFind to its positions and allowed it to re-serve its prioritized requests. IconFind
9 elected to retract eleven interrogatories. Google responded to the five unretracted interrogatories
10 (which amount to eighteen interrogatories). (Ex. C). Only interrogatories that are served and
11 cause a responding party to undertake the burden of preparing and serving responses are counted
12 toward the numerical interrogatory limit for purposes of Rule 33(a). Walker v. Lakewood
13 Condominium Owners Ass'n, 186 F.R.D. 584, 587 (C.D. Cal. 1999); Benas v. Baca, No. 00-
14 11507, 2003 WL 21697750, at *1 (C.D. Cal. July 16, 2003). Because Google did not undertake
15 the burden of preparing and serving responses to Interrogatories 2, 6, 7, and 9-16, those
16 interrogatories do not count toward the numerical limit agreed to by IconFind in the Joint
17 Statement (Dkt. 47) and prescribed by Rule 33(a).

18 The parties properly seek the Court's guidance on the number of discrete subparts
19 contained in the five unretracted interrogatories. Beyond seeking this guidance, IconFind also
20 seeks *an advisory opinion* on whether it would be over the agreed limit of twenty-five had it not
21 retracted Interrogatories 2, 6, 7, and 9-16. IconFind also prematurely requests that this Court
22 triple the number of interrogatories allotted to it before it has even reached the agreed limit of

23 ¹ 7-33 Moore's Federal Practice - Civil § 33.30 ("[T]he better rule is to require the
24 responding party to answer the first 25 interrogatories, and object to the remainder.").

1 twenty-five. Google respectfully requests that this Court address only the issue properly before
2 it. IconFind's additional requests should be denied.

3 **b. Interrogatory Nos. 1-5, and 8 Constitute Three Discrete**
4 **Subparts Because They Are Directed At Distinct Products**

5 Interrogatory Nos. 1-5 and 8² contain three discrete subparts each because they are
6 directed at three distinct subjects — three separate and distinct products. See Collaboration
7 Props., Inc. v. Polycom, Inc., 224 F.R.D. 473, 474-75 (N.D. Cal. 2004) (ruling that an
8 interrogatory directed at twenty-six different accused products has twenty-six discrete subparts
9 because “a party cannot avoid the numerical limits by asking questions about *distinct subjects*,
10 but numbering the questions as subparts.” (quoting 7-33 Moore's Fed. Prac.-Civ. § 33.30[2]
11 (Magistrate Judge Chen's emphasis))); Stamps.com v. Endicia, Inc., No. 06-7499, 2009 WL
12 2576371, at *3 (C.D. Cal. May 21, 2009) (ruling that “interrogatories seeking facts relating to
13 separate patents *or separate accused products* seek information concerning distinct subjects and,
14 therefore, constitute separate interrogatories” (emphasis added)). Magistrate Judge Austin
15 recently used interrogatories directed at multiple products as an example of interrogatories
16 containing discrete subparts. Singleton v. Hedgepath, No. 08-95, 2011 WL 1806515, at *7 (E.D.
17 Cal. May 10, 2011) (citing Collaboration Props.).

18 Despite IconFind's conclusory argument that the information requested for each accused
19 instrumentality is “logically and factually subsumed within and necessarily related to the primary
20 question,” the fact remains that these interrogatories request three distinct sets of information. In
21 answering the interrogatories that ask Google to identify documents associated with the accused

22 ² Interrogatory No. 8 actually consists of six discrete subparts because it falls into
23 Category 1 (interrogatories requesting information related to all three accused products) and
24 Category 2 (interrogatories requesting identification of facts, documents and persons with
knowledge of those facts). Google presents these arguments in different sections for clarity.

1 products (1, 3-5 and 8), Google will identify three independent sets of document. The three
2 accused products are not related in any material way apart from the fact that they are all accused
3 of infringement by IconFind. Each was developed by different groups of engineers at a different
4 time for a different purpose. In order to answer these interrogatories, Google attorneys will have
5 to speak with three different sets of engineers and will need to pull data and documents from
6 various product-specific resources. IconFind's decision to label them in the singular ("Accused
7 Google Instrumentality") does not make them a single product, or even a group of related
8 products.

9 IconFind also asserts that Google's position is incorrect because if, hypothetically,
10 IconFind had accused twenty-five products it would only be allowed to ask one interrogatory. In
11 Collaboration Props., where twenty-six products were accused, Judge White imposed a fifty
12 interrogatory limit and Magistrate Judge Chen found that interrogatories directed at all accused
13 products contained twenty-six discrete subparts. So, not only is IconFind's hypothetical
14 completely irrelevant to the facts of this case, it has also been decided in favor of Google's
15 position in prior case law.

16 The purpose of the numerical limit to interrogatories is to prevent discovery that is
17 unduly burdensome. See Advisory Committee Note to 1993 Amendment to Fed.R.Civ.P. 33(a)
18 ("the aim [of the numerical limit ...] is to provide judicial scrutiny before parties make potentially
19 excessive use of this discovery device"). Gathering the requested information on an accused
20 product is burdensome, and Interrogatory Nos. 1-5, and 8 are each three times as burdensome
21 because they are directed at three distinct products. Under the law, interrogatories directed at
22 distinct products are properly considered as separate interrogatories.

1 **c. Interrogatories Nos. 6-16 Each Contain Multiple Subparts**
2 **Because They Require Identification Of Facts, Documents And**
3 **Persons With Knowledge Of Those Facts**

4 Interrogatory Nos. 8-16 each seek identification of “all information, including but not
5 limited to documents...” as well as “all persons having knowledge related to [the information
6 provided in subpart 1].” Thus, each of these interrogatories contains at least two discrete
7 subparts: identification of persons and identification of documents. See Superior Comm’ns v.
8 Earhugger, Inc., 257 F.R.D. 215, 218 (C.D. Cal. 2009). In Superior, Interrogatory no. 1 read:
9 “State all of the facts that support or undermine the allegation in YOUR answer to the
10 Complaint. Identify all PERSONS who have knowledge of these facts. Identify all
11 DOCUMENTS and things that RELATE or refer to those facts.” The court found that this
12 interrogatory consisted of three discrete subparts: “facts; persons; and documents.” Id. (citing
13 Safeco v. Rawstron, 181 F.R.D. 441, 445-48 (C.D. Cal. 1998)); U.S. ex rel. Pogue v. Diabetes
14 Treatment Centers of Am., Inc., 235 F.R.D. 521, 527 (D.D.C. 2006) (Interrogatory seeking “all
15 facts supporting Relator's contention that [defendant] was aware of the illegal conduct of the
16 medical directors ...; asks Relator to identify each person who knew, and to explain how they
17 knew, of the violations [and] requests that Relator identify all documents that support the
18 contention as to each medical director” is “more accurately counted as three separate
19 interrogatories.”).

20 IconFind’s argument that counting each discrete subpart as an additional interrogatory
21 will result in it being denied evidence and documents necessary to support its claims is an
22 exaggeration. All the documents that IconFind seeks identification of in these interrogatories
23 will be produced pursuant to IconFind’s Requests For Production. See Iconfind’s Requests For
24 Production, attached as Exhibit D, and compare Interrogatory 8(a) to RFP 32; Interrogatory 9(a)
25 to RFP 33; Interrogatory 10(a) to RFP 34; Interrogatory 11(a) to RFP 35; Interrogatory 12(a) to

1 RFP 36; Interrogatory 13(a) to RFP 37; Interrogatory 14(a) to RFP 38; Interrogatory 15(a) to
2 RFP 39. Thus, IconFind will have the names of all the people that it may want to depose from
3 these interrogatories as well as all the documents it wishes to review from its requests for
4 production regardless of how these interrogatories are counted.

5 Similar to Nos. 8-16, Interrogatory No. 7 requests that Google (1) “describe in detail the
6 complete factual basis” for its reasonable royalty calculation; (2) identify the documents relied
7 on; and (3) identify all factors relevant to a hypothetical negotiation. Again, identification of
8 documents and identification of facts constitute two discrete subparts. Superior Comm’ns, 257
9 F.R.D. at 218. IconFind has conceded that Interrogatory No. 6 contains two discrete subparts.

10 Google respectfully requests that the Court find that each of these interrogatories contain
11 at least two discrete subparts.

12 **d. IconFind’s Request For Additional Interrogatories Should Be**
13 **Denied Because It Is Unnecessary And Premature**

14 IconFind agreed that “[t]he limitations of the Federal Rules of Civil Procedure shall
15 govern depositions, interrogatories and all other discovery, absent further agreement of the
16 parties or leave of the Court.” Joint Status Report (Dkt. 47) at 6. Now, before it has even
17 reached the limit to which it agreed, IconFind prematurely asks this Court to *triple* the number of
18 interrogatories it may propound.

19 Despite IconFind’s accusations, Google has not unreasonably refused to stipulate to
20 additional interrogatories. First, the parties discussed the interrogatory limit months ago and
21 both sides agreed that the limit supplied by the Rule 33(a) would be appropriate in this case and
22 memorialized that agreement and communicated it to the Court in the Joint Status Report. Dkt.
23 47. It is not unreasonable for a party to hold another party to its prior agreements. Second,

1 IconFind has proposed tripling the number of interrogatories without providing any reason why
2 that is required. Obviously, responding to 75 interrogatories is very burdensome.

3 In its papers, IconFind advances a new standard for allowing additional interrogatories:
4 if the interrogatories “clearly request relevant information” then they should be allowed. This
5 new standard is not supported by the Federal Rules or relevant case law. IconFind cites
6 Chapman v. California Dept. of Educ., No. 01-1780, 2002 WL 32854376 (N. D. Cal. Feb. 6,
7 2002) to support its new standard. In Chapman, the Court granted the plaintiff additional
8 interrogatories because (1) the interrogatories were neither cumulative nor duplicative; and (2)
9 the requests to identify documents “*could have been propounded* as a request for production of
10 documents under Rule 34 for which the Rule 33(a) numerical limit of interrogatories would not
11 apply.” Id. at *2 (emphasis added). In this case, the request for identification of documents
12 requested in Interrogatory Nos. 9-15 *has already been propounded* as a request for production of
13 documents. Thus, these interrogatories are clearly duplicative of other discovery requests. There
14 is no reason to grant additional interrogatories in order to request identification of materials
15 already requested. Finally, the Chapman Court *sua sponte* granted additional interrogatories that
16 had actually been served by the plaintiff and objected to by the defendant as over the limit.
17 Plaintiff Chapman did not receive additional interrogatories before reaching the limit imposed by
18 the Federal Rules or before it had actually informed the defendant of the scope of the additional
19 requested discovery as IconFind now requests of this Court.

20 In the Joint Status Report the parties agreed to follow the Northern District of
21 California’s Patent Local Rules with regard to invalidity contentions. Dkt. 47 at 5(d). Google’s
22 invalidity contentions are due August 15th and require Google to exchange the same substantive
23 materials requested in Interrogatory Nos. 9-12. To the extent that these interrogatories call for
24

1 non-privileged information, they are cumulative of the required invalidity contentions.
2 Therefore, these interrogatories are unnecessary.

3 IconFind claims that it is entitled to additional interrogatories beyond the agreed limit
4 because this is a complex patent case and cites other patent cases where more than twenty-five
5 interrogatories were propounded. Protective Optics, Inc. v. Panoptx, Inc., No. 05-2732, 2007
6 WL 963972 (N.D. Cal. Mar. 30, 2007) (ordering defendant to answer particular interrogatories
7 already served and objected to beyond the limit of twenty-five where *fourteen separate products*
8 *were accused*); Collaboration Props., Inc. v. Polycom, Inc., 224 F.R.D. 473 (N. D. Cal 2004)
9 (limit of fifty interrogatories imposed by Judge White where *twenty-six different products were*
10 *accused* and each interrogatory aimed at the accused product counted as twenty-six discrete
11 subparts). In this case, three separate products are accused of infringing one patent. This case
12 does not come close to the complexity of the cited cases. Furthermore, neither case granted the
13 plaintiff anything that even approached twenty-five interrogatories per accused product, as
14 IconFind now requests.

15 Therefore, Google respectfully requests that IconFind's request for additional
16 interrogatories be denied so that IconFind is held to the agreed limit of twenty-five. Should
17 Iconfind wish to serve interrogatories exceeding the agreed to 25 limit, Google will negotiate
18 with them in good faith to determine whether the interrogatories are not cumulative or otherwise
19 designed merely to increase the costs of litigation.

21 Respectfully submitted,

22 /s/ Anna B. Folgers

23 NIRO, HALLER & NIRO

24 Raymond P. Niro (*Pro hac vice*)

RNiro@nshn.com

Raymond P. Niro, Jr. (*Pro hac vice*)

Respectfully submitted,

/s/ Kenneth M. Maikish

KAYE SCHOLER LLP

Michael J. Malecek (*Pro hac vice*)

michael.malecek@kayescholer.com

Kenneth M. Maikish (*Pro hac vice*)

1 RNiroJr@nshn.com

Brian E. Haan (*Pro hac vice*)

2 BHaan@nshn.com

Anna B. Folgers (*Pro hac vice*)

3 AFolgers@nshn.com

4 WILKE, FLEURY, HOFFELT, GOULD &
BIRNEY, LLP

5 Thomas G. Redmon (SBN 47090)

TRedmon@wilkefleury.com

6 Daniel L. Baxter (SBN 203862)

DBaxter@wilkefleury.com

7 Attorneys for Plaintiff, IconFind, Inc.

kenneth.maikish@kayescholer.com

Attorneys for Defendant, Google Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on July 21, 2011 the foregoing

JOINT STATEMENT RE DISCOVERY DISAGREEMENT

was filed with the Clerk of Court using the CM/ECF system, which will then send a notification of such filing to the following counsel of record.

Michael J. Malecek

Michael.malecek@kayescholer.com

Kenneth Maikish

Kenneth.maikish@kayescholer.com

Kaye Scholer LLP

Two Palo Alto Square, Suite 400

3000 El Camino Real

Palo Alto, California 94306

Telephone: (650) 319-4500

Facsimile: (650) 319-4700

Attorneys for Defendant Google Inc.

I certify that all parties in this case are represented by counsel who are CM/ECF participants.

/s/ Daniel L. Baxter

Attorneys for Plaintiff