

EXHIBIT E

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

16 ICONFIND, INC.,

17 Plaintiff,

18 v.

19 GOOGLE INC.,

20 Defendant.

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

**PLAINTIFF'S FIRST SET OF
REQUESTS FOR PRODUCTION TO
DEFENDANT GOOGLE INC. NOS. 1-45**

21 In accordance with Fed.R.Civ.P. 34, Plaintiff, Iconfind Inc. ("IconFind"), by and through
22 counsel, requests that Defendant, Google, Inc. ("Google"), produce the documents and things
23 described in the following requests for production within 30 (thirty) days of service. These
24 requests for production shall be deemed continuing so as to require the requested information as
25
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1 of the date of service of Google's answers thereto and also as to require prompt supplementation
2 whenever the conditions of Federal Rule of Civil Procedure 26(e) are met.

3 IconFind will examine the documents at the offices of its counsel, or where the
4 documents are maintained by Google, or at any other mutually agreeable location where
5 suitable examination and photocopying facilities exist or can be arranged. By accepting
6 photocopies, IconFind is not waiving its right to examine originals where necessary.

7 All electronically stored information that is responsive to one or more of the categories
8 set forth below shall be produced in the native format in which the information is kept in the
9 ordinary course of business, except for machine readable files such as object code, binary files
10 and the like which shall be produced electronically in a format that can reasonably be read and
11 understood using conventional word processing, file viewing or equivalent commercially
12 available software technology.

13 Where Google withholds documents for reasons of attorney-client privilege, work-
14 product immunity or the like, IconFind requests that it be served with a list of such documents
15 prepared in accordance with applicable case law, including at least the names and titles or
16 functions of the authors; any recipients; the date; the basis for withholding; and a description of
17 the document and its subject matter sufficient to allow IconFind to contest the claim. IconFind
18 will accept confidential documents under a suitable protective order.

19 In cases where Google believes there is no responsive document, or where it is
20 maintained for a different period or fiscal year, IconFind asks that Google produce the best
21 available documents from which the information sought by the request may be derived. (In the
22 case of financial information, it is usually possible to derive the desired information if it is not
23 already available).

1 "And," "or" as well as "and/or" shall be construed disjunctively or conjunctively as
2 necessary in order to bring within the scope of the request all responses which otherwise might
3 be construed to be outside its scope.

4 "Document(s)" refers to the broadest definition of document and electronically stored
5 information under the Federal Rules, e.g., anything which would be a "writing" or "recording"
6 pursuant to Rule 1001(1) of the Federal Rules of Evidence or "document" or "electronically
7 stored information" including software code, pursuant to Rule 34(a) of the Federal Rules of
8 Civil Procedure. A draft or a non-identical copy is a separate document within the meaning of
9 this term.

10 "Thing(s)" means any tangible item, and shall be construed as broadly as possible under
11 the Federal Rules of Civil Procedure.

12 "Person(s)" refers to both natural persons and corporate or other business entities
13 (including Google) whether in the employ of Google or not, and the acts of a person (including
14 Google) are defined to include the acts of directors, officers, owners, members, employees,
15 agents or attorneys acting on the person's behalf.

16 "Infringe," "infringes," or "infringed" refers to any form of infringement actionable
17 under United States law, including without limitation, direct infringement, contributory
18 infringement and inducement to infringe.

19 "Prior art" includes by way of example and without limitation, the subject matter
20 described in 35 U.S.C. § 103 and in each subdivision of 35 U.S.C. § 102.

21 "Lawsuit" or "Litigation" means Iconfind Inc. v. Google, Inc., Case No. 2:11-cv-00319-
22 GEB-JFM in the United States District Court for the Eastern District of California.

23 **REQUESTS**

24 Iconfind requests production of all documents and things relating to the following
25 categories:

1 1. All documents identified in Google's responses to any of Iconfind's
2 interrogatories in this action, such as Iconfind's First Set of Interrogatories (Nos. 1-15),
3 including, but not limited to, all documents consulted in the formulation of Google's responses
4 thereto as well as all documents relating to the subject matter of the interrogatories.

5 2. Documents sufficient to show the past and present organizational and operational
6 structure of Google since 2007, including all divisions or subsidiaries, entities owned or
7 controlled by Google, affiliates, predecessors or successors in interest, whether in the United
8 States or anywhere else in the world (such as, without limitation, corporate family
9 organizational charts), and the identity of any officers, employees and sales agents, or
10 representatives (such as, without limitation, departmental officer/employee organizational
11 charts).

12 3. All documents sufficient to identify past and present officers, employees, agents,
13 consultants or representatives of Google who has and/or has had any involvement in the
14 incorporation, integration, development, testing or past and present functionality of the Creative
15 Commons Feature in the Accused Google Instrumentality.

16 4. All documents pertaining to the reasons why and the circumstances under which
17 the Accused Google Instrumentality was conceived, designed, developed, manufactured, and
18 commercially exploited.

19 5. All documents pertaining to Google's decision to incorporate the Creative
20 Commons Feature into the Google Accused Instrumentality.

21 6. Documents sufficient to establish when the Creative Commons Feature was first
22 used in and incorporated into the Accused Google Instrumentality and the circumstances
23 surrounding such first use and incorporation.

24 7. Documents sufficient to show the structure, function and operating
25 characteristics of the Accused Google Instrumentality including without limitation design

1 schematics (for both discrete parts and the entire system), source code, flowcharts, specification
2 documents, test plans, algorithms, pseudo-code, customer service/assistance manuals and
3 guidelines, and system protocols. All source code is specifically requested with comments
4 intact and on computer readable media.

5 8. To the extent not requested in No. 7, documents sufficient to show the structure,
6 function and operating characteristics of Creative Commons Feature in the Accused Google
7 Instrumentality including without limitation design schematics (for both discrete parts and
8 whole systems), source code, diagrams, flowcharts, specification documents, drawings,
9 datasheets, requirements documents, test plans, set-up guides, customer service/assistance
10 manuals and guidelines, instruction manuals, algorithms, pseudo-code, and system protocols.

11 9. All source code is specifically requested with comments intact and on computer
12 readable media.

13 10. Documents sufficient to identify the designer and/or supplier of the Accused
14 Google Instrumentality.

15 11. One copy of the hypertext markup language (html, xml, jhtml or any other
16 markup) code for the Accused Google Instrumentality including copies of all support files of
17 any type.

18 12. All documents relating to the existence, substance or circumstance of any
19 communications (i.e., the transmittal of information in the form of facts, ideas, inquiries, or
20 otherwise) or correspondence (such as notes, e-mail, letters, memoranda, telephone call notes,
21 calendar entries, etc.) between Google and any other person relating to the '459 Patent or the
22 Lawsuit.

23 13. All documents relating to the existence, substance or circumstance of any
24 communications (i.e., the transmittal of information in the form of facts, ideas, inquiries, or
25

1 otherwise) or correspondence (such as notes, e-mail, letters, memoranda, telephone call notes,
2 calendar entries, etc.) between Google and IconFind and/or Lee H. Grant.

3 14. All documents relating to the existence, substance or circumstance of any
4 communications (i.e., the transmittal of information in the form of facts, ideas, inquiries, or
5 otherwise) or correspondence (such as notes, e-mail, letters, memoranda, telephone call notes,
6 calendar entries, etc.) between Google and Creative Commons Corporation.

7 15. Documents sufficient to identify Google's business relationship with Creative
8 Commons Corporation, including but not limited to license agreements, software license
9 agreements, service agreements, support agreements, service agreements, confidentiality
10 agreements, partnership agreements, revenue sharing agreements, joint venture agreements, and
11 any other type of agreement or contract, between Google and Creative Commons

12 16. Documents sufficient to establish the total number of web pages, photographs,
13 books, pages of books or other media or content that have been designated with a Creative
14 Commons label or licensed with a Creative Commons license through the Accused Google
15 Instrumentality since February 20, 2007.

16 17. Summary documents relating to Google's revenues, costs (fixed and variable),
17 gross profit and net profit realized by Google from the operation and use of the Accused Google
18 Instrumentality, including without limitation advertising revenue from 2007 to the present, with
19 projections through calendar year 2010.

20 18. Summary documents relating to Google's revenues, costs (fixed and variable),
21 gross profit and net profit realized by Google from the operation and use of the Creative
22 Commons Feature of the Accused Google Instrumentality, including without limitation
23 advertising revenue from 2007 to the present, with projections through calendar year 2010.

1 19. Valuations pertaining to the Accused Google Instrumentality, specifically
2 including but not limited to valuations of the Creative Commons Feature.

3 20. All documents relating to business plans, business meetings, financial forecasts,
4 or other financial activities involving the Accused Google Instrumentality, specifically
5 including but not limited to the Creative Commons Feature.

6 21. All documents relating to communications with potential investors or other
7 financially interested parties relating to the Accused Google Instrumentality, specifically
8 including but not limited to the Creative Commons Feature.

9 22. Summary documents relating to the daily, weekly, monthly, quarterly and annual
10 website usage statistics of the Accused Google Instrumentality, including those provided by any
11 web analytics software or platform, from 2007 to the present.

12 23. All documents sufficient to establish the daily, weekly, monthly, quarterly and
13 annual website usage statistics of the Accused Google Instrumentality, including those provided
14 by any web analytics software or platform, including without limitation, (a) the number of client
15 requests made to Google's server(s) to assign a Creative Commons designation to a page; (b)
16 the number of client requests made to Google's server(s) to access pages containing a Creative
17 Commons designation; and (c) the number of client requests made to Google's server(s) to
18 search for a page with a Creative Commons designation, from 2007 to the present.

19 24. All documents that constitute, refer to, reflect or identify any marketing,
20 promotion and advertising pertaining to the Accused Google Instrumentality, specifically
21 including but not limited to the Creative Commons Feature, such as marketing research,
22 marketing plans, market demand analyses, market share analyses, market research, customer
23 surveys, and related press releases.

24 25. All documents that constitute, refer to, reflect or identify any report, business
25 plan, strategic plan, prospectus, offering memorandum or similar document pertaining to the

1 Accused Google Instrumentality, specifically including but not limited to the Creative
2 Commons Feature, such as financial forecasts, business meetings, and related press releases.

3 26. All documents pertaining to the Accused Google Instrumentality, specifically
4 pertaining to but not limited to the Creative Commons Feature, used, distributed, displayed or
5 presented in trade shows, technical workshops, user conferences, user forums, user summits,
6 developer conferences, developer forums, developer summits or similar documents, such as
7 presentations, demonstrations and technical papers.

8 27. All documents pertaining to the existence, substance or circumstance of any
9 feedback (positive and negative) between Google and its customers pertaining to the Creative
10 Commons Feature of the Accused Google Instrumentality, including, without limitation, all
11 troubleshooting communications.

12 28. All documents pertaining to recognition, praise, awards and the like for the
13 Accused Google Instrumentality, including documents pertaining to but not limited to the
14 Creative Commons Feature.

15 29. All documents pertaining to the existence, substance or circumstance of any
16 competitive analyses pertaining to the Accused Google Instrumentality, including documents
17 pertaining to, but not limited to, the Creative Commons Feature.

18 30. Documents sufficient to identify the date Google first learned of and/or received
19 "notice of infringement" of the '459 Patent.

20 31. Any and all document retention policies in effect at Google since 2007.

21 32. All documents Google intends to use to support its Counterclaim I and First
22 Affirmative Defense alleging that "Google has not infringed and does not infringe, directly or
23 indirectly, any valid and enforceable claim of the '459 patent."

1 33. All documents Google intends to use to support its Counterclaim II and Second
2 Affirmative Defense that the “[t]he ’459 patent is invalid under 35 U.S.C. § 101 because it “fails
3 to claim patentable subject matter insofar as it seeks to claim an abstract idea.”

4 34. All documents Google intends to use to support its Counterclaim II that the ’459
5 Patent is invalid for failure to meet the “conditions of patentability of 35 USC § 102 because the
6 inventions are “is taught by” or “suggested by” the “prior art.”

7 35. All documents Google intends to use to support its Counterclaim II and Second
8 Affirmative Defense that the ’459 Patent is invalid for failure to meet “the conditions for
9 patentability” of 35 USC § 103 because the alleged invention are “obvious in view of” the
10 “prior art.”

11 36. All documents Google intends to use to support its Counterclaim II and Second
12 Affirmative Defense that the ’459 Patent is invalid because it fails to meet “the conditions for
13 patentability” of 35 USC § 112 because the inventions are “unsupported by the written
14 description of the patented invention.”

15 37. All documents Google intends to use to support its Third Affirmative Defense
16 that “IconFind’s claim for damages, if any, against Google for alleged infringement of the ’459
17 patent are limited by 35 U.S.C. §§ 286, 287, and/or 288.”

18 38. All documents Google intends to use to support its Fourth Affirmative Defense
19 that “[o]n information and belief, IconFind’s claims for relief are barred, in whole or in part, by
20 the equitable doctrines of laches and estoppel.”

21 39. All documents Google intends to use to support its Fifth Affirmative Defense
22 that “[a]ny and all products or actions accused of infringement have substantial uses that do not
23 infringe and do not induce or contribute to the alleged infringement of the claims of the ’459
24 Patent.”

25 40. All documents and things that Google contends are prior art to the ’459 Patent.

1 41. All documents and things obtained or acquired through all validity, non-
2 infringement or patentability prior art searches or investigations relied upon, reviewed,
3 generated, performed, commissioned, ordered, requested, received, contracted or purchased by
4 or on behalf of Google that relates in any way to the '459 Patent.

5 42. To the extent not requested above, any documents relating to any opinions of
6 counsel sought or obtained by Google that relate in any way to the '459 Patent or the subject
7 matter of this Lawsuit.

8 43. Any and all documents relating to Google's contentions of the level of skill of a
9 person of ordinary skill in the art of the '459 Patent.

10 44. All documents which Google contends are relevant to claim construction in this
11 Lawsuit.

12 45. All intellectual property licenses/agreements between Google and any third party
13 pertaining to the Creative Commons Feature of the Accused Google Instrumentality.

14 Respectfully submitted,

15 /s/ Anna B. Folgers
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Attorneys for Plaintiff, IconFind, Inc.

1 **CERTIFICATE OF SERVICE**

2 The undersigned hereby certifies that on May 17, 2011 the foregoing

3 **PLAINTIFF'S FIRST SET OF REQUESTS FOR PRODUCTION TO DEFENDANT**
4 **GOOGLE INC. NOS. 1-45**

5 was served via electronic transmission to the following counsel of record:

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16 **Attorneys for Defendant Google Inc.**

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

18 /s/ Anna B. Folgers
19 _____
20 Attorneys for Plaintiff
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