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 11 OVERTURE SERVICES, INC.

12 UNITED STATES DISTRICT COURT
 13 NORTHERN DISTRICT OF CALIFORNIA
 14 SAN FRANCISCO DIVISION

16 OVERTURE SERVICES, INC., a
 Delaware Corporation,
 17 Plaintiff,
 18 vs.
 19 GOOGLE INC., a California Corporation,
 20 Defendant.
 21

No. C02-01991 JSW (EDL)

**OVERTURE'S MOTION TO COMPEL
 GOOGLE TO RESPOND TO
 INTERROGATORY NO. 10**

DISCOVERY MATTER

Date: Tuesday, January 6, 2004
 Time: 9:00 a.m.
 Courtroom: E, 15th Floor
 Judge: Hon. Elizabeth D. Laporte

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MOTION

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2 Plaintiff Overture Services, Inc. (“Overture”) hereby moves, pursuant to Fed. R.
3 Civ. P. 37(a) and Civ. L.R. 37-2, for an order compelling Google to respond to
4 Overture’s Interrogatory No. 10. Pursuant to Civil L.R. 7-2, Overture has noticed this
5 motion for hearing before the Honorable Elizabeth D. Laporte at 9:30 a.m. on Tuesday,
6 December 30, 2003.

7 Overture’s Interrogatory No. 10 seeks an explanation of Google’s basis for its
8 assertion that it does not infringe Overture’s U.S. Patent No. 6,269,361 (the “’361
9 patent”). Google refused to provide any substantive response to this interrogatory.
10 Instead, Google objected to the interrogatory in its entirety on the basis that the
11 interrogatory allegedly includes multiple subparts beyond the number permitted by Fed.
12 R. Civ. P. 33. Google also objected that the interrogatory is unduly burdensome and
13 premature because the Court has not construed the claims of the ’361 patent. Google’s
14 objections are baseless.

15 Google has asserted non-infringement as both an affirmative defense and a
16 declaratory judgment counterclaim in this case. Interrogatory 10 merely requires
17 Google to explain the basis for its assertion of non-infringement. The interrogatory is
18 limited to this single discrete question; it does not include multiple subparts. Moreover,
19 the interrogatory is neither unduly burdensome nor premature. Google does not need a
20 final claim construction to respond to Interrogatory 10. In that sense, Interrogatory 10 is
21 no more burdensome than Patent L.R. 3-1, which required Overture to fully explain the
22 basis for its assertion of infringement prior to the claim construction proceedings.
23 Google can respond to the interrogatory based on its proposed interpretations of the
24 disputed claim terms and, if necessary, supplement its response after the Court
25 construes those terms.

26 For these reasons, and as further explained in the following Memorandum of
27 Points and Authorities, Overture respectfully requests that the Court order Google
28 immediately to provide a complete response to Interrogatory No. 10.

1 **MEMORANDUM OF POINTS AND AUTHORITIES**

2 **I. STATEMENT OF FACTS**

3 Overture alleges that Google is infringing the '361 patent. (Amended Complaint,
4 Dkt. No. 57.) By its answer and counterclaims, Google has asserted an affirmative
5 defense of non-infringement. (Answer and Counterclaim, Dkt. No. 60.) Google also
6 has asserted a counterclaim for declaratory judgment of non-infringement. (*Id.*)

7 Pursuant to the Patent Local Rules, the parties have exchanged preliminary
8 contentions regarding the infringement and validity of the '361 patent. On September
9 16, 2002, Overture provided its Disclosure of Asserted Claims and Preliminary
10 Infringement Contentions pursuant to Patent L.R. 3-1. (See December 2, 2003
11 Declaration of Charles M. McMahon, ¶ 2.) Overture supplemented its preliminary
12 infringement contentions on January 14 and February 28, 2003. (See *id.* at ¶ 3.) As
13 part of its contentions, Overture identified 62 claims of the '361 patent that it alleges
14 Google infringes. Google has since provided its Preliminary Invalidity Contentions
15 pursuant to Patent L.R. 3-3, and the parties have been engaged in the claim
16 construction process required by Patent L.R. 4. (See *id.* at ¶¶ 4-5.)

17 On September 22, 2003, Overture served Google with Overture's Fourth Set of
18 Interrogatories. (See *id.* at ¶ 6.) The fourth set included a single interrogatory:

19 10. Fully describe Google's bases for its assertion of
20 noninfringement of the '361 patent, including an identification
21 of each claim limitation that Google contends is not present
22 in Google's Sponsored Search System, and a statement of
whether Google's Sponsored Search System provides an
equivalent to each claim limitation that Google alleges is not
present in Google's Sponsored Search System.

23 (*See id.*) Google served its objections to Interrogatory 10 on October 24, 2003. (*See*
24 *id.* at ¶ 7.) Google raised a number of objections, but counsel for Google has indicated
25 that Google's refusal to respond is based on three specific objections:

26 Google objects to this interrogatory and to Overture's
27 definitions to the extent that they are vague, ambiguous,
overly broad, or unduly burdensome.

28 * * *

1 Google objects to this interrogatory because it is premature,
2 because the Court has not yet construed the asserted
3 claims, and Overture has not yet served its final infringement
4 contentions.

5 Google objects to this interrogatory because it is compound,
6 in that it seeks information concerning each limitation of
7 each of the sixty-two asserted claims of the '361 patent, and
8 also in that it seeks information concerning both the lack of
9 literal infringement and the lack of infringement under the
10 doctrine of equivalents. In light of the compound nature of
11 this request, Google objects to this interrogatory in its
12 entirety.

13 (See *id.* at ¶¶ 7, 10.)

14 Other than the general averments in Google's answer and counterclaim, Google
15 has never explained the bases for its assertion of non-infringement. (See *id.* at ¶ 8.)
16 Indeed, Google has not even identified which of the 67 claims it alleges are not
17 infringed. (See *id.*)

18 **II. OVERTURE'S ATTEMPTS TO RESOLVE THIS DISPUTE INFORMALLY**

19 In a letter dated November 4, 2003, counsel for Overture requested that Google
20 withdraw its objections and provide a substantive response to Interrogatory 10. (See
21 McMahon Decl. ¶ 9.) In subsequent telephone conversations on November 12 and 14,
22 2003, counsel for the parties discussed their respective positions, but were unable to
23 resolve their differences. (See *id.* at ¶¶ 10-11.) Google maintained its objections and
24 refused to provide a substantive response to the interrogatory. (See *id.* at ¶ 13.) As a
25 result, Overture filed this motion.

26 **III. LEGAL STANDARDS**

27 Rule 33(a) provides in part, "[w]ithout leave of court or written stipulation, any
28 party may serve upon any other party written interrogatories, not exceeding 25 in
29 number including all discrete subparts" Fed. R. Civ. P. 33(a). An interrogatory is
30 not necessarily objectionable simply because it is compound or contains subparts.

31 *Zapata v. IBP, Inc.*, No. C93-2366, 1997 WL 50474, at *1 (D. Kan., Feb. 4, 1997).

32 Interrogatory subparts are objectionable only when they pose separate **discrete**
33 questions. *Safeco of Am. v. Rawstron*, 181 F.R.D. 441, 443-44 (C.D. Cal. 1998). A

1 subpart is discrete and regarded as a separate interrogatory when it is **logically or**
2 **factually independent** of the question posed by the basic interrogatory. *Kendall v.*
3 *GES Exploration Svcs., Inc.*, 174 F.R.D. 684, 685 (D. Nev. 1997).

4 The numerical limit was added to Rule 33(a) in 1993. See *Safeco*, 181 F.R.D. at
5 443. Before then, sheer numerosity of interrogatories was not a valid objection. See *id.*
6 The amendment was intended to prevent harassment in the form of excessively
7 numerous interrogatories. See *id.* For this reason, the amendment also limited the
8 number of discrete subparts so that a party could not evade the numerical limit by
9 joining as subparts unrelated questions that seek information about discrete and
10 separate subjects. See *id.*

11 The amended rule, however, does not prohibit the use of subparts altogether.
12 Rather, the “discrete subparts” language was intended to provide a balanced approach
13 to determining when subparts should and should not count as separate interrogatories.

14 For instance,

15 a question asking about communications of a particular type
16 should be treated as a single interrogatory even though it
17 requests that the time, place, persons present, and contents
be stated separately for each such communication.

18 See *id.* (quoting Advisory Committee Note to 1993 Amendment to Fed. R. Civ. P. 33,
19 146 F.R.D. 675, 675-76 (1993)).

20 Although the question of discrete subparts depends largely on the facts of a
21 given case, the Rule 33(a) standard may be summarized as follows:

22 ***[I]t would appear that an interrogatory containing***
23 ***subparts directed at eliciting details concerning the***
24 ***common theme should be considered a single question,***
25 although the breadth of an area inquired about may be
disputable. On the other hand, an interrogatory with
subparts inquiring into discrete areas is more likely to be
counted as more than one for purposes of the limitation.

26 See *id.*, 181 F.R.D. at 444 (quoting 8A CHARLES A. WRIGHT, ARTHUR R. MILLER &
27 RICHARD L. MARCUS, FEDERAL PRACTICE AND PROCEDURE § 2168.1, at 261 (2d ed. 1994))
28 (emphasis added).

1 **IV. ARGUMENT**

2 None of its objections excuse Google from responding to Interrogatory No. 10 at
3 this time. It appears that Google is attempting to stall legitimate discovery by hiding
4 behind illegitimate objections. The Rule 33(a) standards set forth above reveal that
5 Interrogatory 10 does not include multiple discrete subparts, and it does not place an
6 undue burden on Google. Accordingly, Google must provide a complete response to
7 the interrogatory. Moreover, Interrogatory 10 is not premature at this time, so Google
8 cannot wait until after claim construction to provide its response; Google must respond
9 to Interrogatory 10 now.

10 **A. Interrogatory No. 10 Does Not Include Multiple Subparts**

11 Interrogatory 10 poses a single question—Google must explain the bases for its
12 assertion of non-infringement. Google asserts that Interrogatory 10 includes multiple
13 discrete subparts because it requires Google to identify each claim limitation that
14 Google contends is absent in the accused system. This information, however, is
15 essential to an explanation of Google’s bases for alleging non-infringement. As a result,
16 Interrogatory 10 does not include multiple *discrete* subparts.

17 To establish non-infringement, Google must demonstrate that at least one
18 limitation of every asserted claim is absent from its accused system. Thus, to explain
19 the bases for its assertion of non-infringement, Google necessarily must identify each
20 limitation that it believes is absent from the accused system. Google’s so-called
21 “subparts” are *logically and factually subsumed* within the single primary question.
22 See *Kendall*, 174 F.R.D. at 685 (subparts are considered part of a single interrogatory
23 when they are logically or factually subsumed within the basic interrogatory). Likewise,
24 the alleged “subparts” are not discrete for purposes of Rule 33(a) because they are
25 “directed at eliciting details concerning the common theme” and “should be considered
26 a single question.” See *Safeco*, 181 F.R.D. at 444 (quoting WRIGHT & MILLER § 2168.1).
27 Accordingly, Interrogatory No. 10 constitutes a single interrogatory under Rule 33(a).

1 **B. Interrogatory No. 10 Is Not Unduly Burdensome To Google**

2 Google also objects to Interrogatory No. 10 on the basis that it is unduly
3 burdensome. Apparently, Google believes that it would be an undue burden to identify
4 all of the claim limitations that it alleges to be missing from its accused system. This
5 objection is entirely unfounded. Overture is entitled to explore all the bases underlying
6 Google's affirmative defense and counterclaim of non-infringement. Otherwise, Google
7 could withhold its non-infringement contentions and ambush Overture at trial.

8 The insufficiency of Google's objection is apparent in view of the Patent Local
9 Rules. Patent Local Rule 3-1 requires Overture to provide Preliminary Infringement
10 Contentions that address **every** limitation of **every** asserted claim. Yet, this rule cannot
11 be said to place an undue burden on Overture. By comparison, Interrogatory 10 is even
12 less burdensome on Google. Interrogatory 10 does not require Google to address
13 every claim limitation, but only those limitations that Google alleges are absent from its
14 accused system. Just as Patent Local Rule 3-1 requires Overture to fully explain its
15 infringement contentions, Google should be required to fully explain its non-infringement
16 contentions in response to Interrogatory No. 10. There simply is no undue burden.

17 **C. Interrogatory No. 10 Is Not Premature**

18 Finally, Google objects to Interrogatory No. 10 as premature because the Court
19 has not yet construed the disputed claim terms. This objection is just as improper as
20 Google's other objections. Google does not need a final claim construction before
21 responding to Interrogatory 10. By necessity, Google must already have identified the
22 bases for its assertion of non-infringement. At least that much was necessary for
23 Google's answer and counterclaim to satisfy Fed. R. Civ. P. 11. Overture is entitled to
24 discover those bases now—without waiting for a final claim construction.

25 Moreover, Google will not be prejudiced by responding to Interrogatory 10 now.
26 Pursuant to Fed. R. Civ. P. 26(e), Google will have the opportunity—indeed, the duty—
27 to supplement its interrogatory response if necessary after the Court construes the
28 disputed claim terms. Accordingly, there is no risk of prejudice to Google in explaining

1 its non-infringement allegations before a final claim construction, and Google should
2 provide a complete response to Interrogatory 10 at this time.

3 **V. CONCLUSION**

4 Google's objections are improper and do not excuse Google from providing a
5 response to Interrogatory No. 10 at this time. Overture respectfully requests that the
6 Court order Google to explain fully and immediately the bases for its assertion of non-
7 infringement in response to Interrogatory No. 10.

8
9 Dated: December 2, 2003

By: /s/ Charles M. McMahon

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