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10 Attorneys for Plaintiff
 11 OVERTURE SERVICES, INC.

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

15
 16 OVERTURE SERVICES, INC., a
 Delaware Corporation,
 17 Plaintiff,
 18 vs.
 19 GOOGLE INC., a California Corporation,
 20 Defendant.

No. C02-01991 JSW (EDL)
**DECLARATION OF CHARLES M.
 McMAHON IN SUPPORT OF
 OVERTURE'S MOTION TO COMPEL
 GOOGLE TO RESPOND TO
 INTERROGATORY NO. 10**
DISCOVERY MATTER
 Date: Tuesday, January 6, 2003
 Time: 9:00 a.m.
 Courtroom: E, 15th Floor
 Judge: Hon. Elizabeth D. Laporte

1 I, Charles M. McMahon, declare as follows:

2 1. I am an associate at the law firm of Brinks Hofer Gilson & Lione, counsel
3 of record for plaintiff Overture Services, Inc. ("Overture") in this matter. I make this
4 declaration in support of Overture's Motion to Compel Google to Respond to
5 Interrogatory No. 10. I make the following declaration based upon my personal
6 knowledge, and I could and would testify thereto under oath if called upon to do so.

7 **BACKGROUND**

8 2. Pursuant to Patent L.R. 3-1, Overture served Google with a copy of
9 Overture's Disclosure of Asserted Claims and Preliminary Infringement Contentions on
10 September 16, 2002.

11 3. Overture supplemented its preliminary infringement contentions on
12 January 14 and February 28, 2003. As part of its supplemental preliminary infringement
13 contentions, Overture identified 62 claims of the '361 patent that it alleges Google infringes.

14 4. Pursuant to Patent L.R. 3-3, Google subsequently served Overture with its
15 Preliminary Invalidity Contentions.

16 5. Pursuant to Patent L.R. 4, the parties have engaged in the claim
17 construction process, exchanging proposed interpretations of the disputed claim terms
18 and filing a Joint Claim Construction Statement. (See Dkt. No. 67.) The Court has
19 scheduled a claim construction hearing for March 24, 2004. (See Dkt. No. 98.)

20 **THE DISPUTED INTERROGATORY**

21 6. On September 22, 2003, Overture served Google with Overture's Fourth
22 Set of Interrogatories. A copy of Overture's Fourth Set of Interrogatories is attached as
23 Exhibit A to this declaration. The fourth set included a single interrogatory:

24 10. Fully describe Google's bases for its assertion of
25 noninfringement of the '361 patent, including an identification
26 of each claim limitation that Google contends is not present
27 in Google's Sponsored Search System, and a statement of
28 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.

1 7. Google served its Objections to Overture's Fourth Set of Interrogatories
2 (No. 10) on October 24, 2003. A copy of Google's objections is attached as Exhibit B to
3 this Declaration. Google did not provide any substantive response to Interrogatory
4 No. 10. Google's objections to Interrogatory No. 10 are reproduced below in their
5 entirety:

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

9 Google objects to this interrogatory to the extent that it seeks
10 information that is neither relevant to the subject matter of
11 this action nor reasonably calculated to lead to the discovery
12 of admissible evidence.

13 Google objects to the definitions to the extent they purport to
14 give meaning or legal significance to a document, fact or
15 purported fact, whose meaning or significance is the subject
16 of dispute between the parties.

17 Google objects to this interrogatory to the extent that it seeks
18 information protected from disclosure by the attorney-client
19 privilege, the work product doctrine, or any other privilege or
20 protection. Any inadvertent disclosure of such information
21 shall not be deemed a waiver of any such privilege or
22 protection.

23 Google objects to this interrogatory to the extent that it seeks
24 to impose obligations beyond that imposed by the Federal
25 Rules of Civil Procedure and applicable case law.

26 Google objects to this interrogatory to the extent that it seeks
27 information concerning any Google's Sponsored Search
28 System that ceased to be used prior to the issuance of the
Patent-in-Suit, on July 3 1,2001. Google's response is
limited to Google's Sponsored Search Systems that have
been in use since the issuance of the Patent-in-Suit.

Based on discussions between counsel for Overture and
Google, Google understands the term "Google's Sponsored
Search System" to be limited to advertising models that are
priced on a "cost-per-click" pricing model. Based on that
understanding and the time limitation noted above, as well
as Google's objections, Google understands the term
"Google's Sponsored Search System" to be limited to its
AdWords Select service ("AWS").

The interrogatory seeks "bases . . . including" claim
limitations not present in AWS and a statement of whether
AWS provides an equivalent to each claim limitation that is
not present in AWS, thereby implying that Overture may be

1 seeking further information beyond missing claim limitations
2 and/or equivalents. Google objects to this interrogatory to
3 the extent that it seeks any such further information,
because to that extent "bases" is vague, ambiguous and
unintelligible.

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

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

11 8. Other than the general averments in Google's Answer and Counterclaim
12 (see Dkt. No. 60), Google has never informed Overture of the bases for its assertion of
13 non-infringement. Google has not identified which of the 67 claims of the '361 patent it
14 alleges are not infringed.

15 **OVERTURE'S ATTEMPTS TO RESOLVE THIS DISPUTE INFORMALLY**

16 9. Attached as Exhibit C is a copy of a letter dated November 4, 2003, in
17 which counsel for Overture requested that Google withdraw its objections and provide a
18 substantive response to Interrogatory No. 10.

19 10. On November 12, 2003, I participated in a telephone call with Mr. Ravind
20 Grewal, counsel for Google, during which we discussed the parties' positions but were
21 unable to resolve their differences. During this conversation, Mr. Grewal explained that
22 Google's refusal to provide a substantive response is based on three specific
23 objections:

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

26 * * *

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

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

9 11. On November 14, 2003, I participated in a second telephone call with
10 Mr. Grewal, during which we again discussed the parties positions but still were unable
11 to resolve their differences.

12 12. Overture maintains that Interrogatory No. 10 is proper and that Google
13 should immediately provide a complete response to the interrogatory.

14 13. Google maintains its objections to Interrogatory No. 10 and refuses to
15 provide a substantive response.

16 I declare under penalty of perjury under the laws of the United States of America
17 that the foregoing is true and correct. Executed on this 10th day of October 2002 at
18 Chicago, Illinois.

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/s/ Charles M. McMahon
Charles M. McMahon

Exhibit A

1 LATHAM & WATKINS
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2 Allon Stabinsky (Bar No. 197642)
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10 Attorneys for Plaintiff
11 OVERTURE SERVICES, INC.

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

15
16 OVERTURE SERVICES, INC., a
Delaware Corporation,

17 Plaintiff,

18 vs.

19
20 GOOGLE INC., a California
Corporation,

21 Defendant.
22

No. C02-01991 JSW

**OVERTURE SERVICES, INC.'S
FOURTH SET OF
INTERROGATORIES (NO. 10) TO
GOOGLE INC.**

23 Pursuant to Rule 33 of the Federal Rules of Civil Procedure, Plaintiff Overture
24 Services Inc. ("Overture") propounds the following interrogatory to Defendant,
25 Google Inc. ("Google") to be answered fully, in writing and under oath, by an officer
26 or agent within 30 days after service hereof, in accordance with the provisions of
27 Rule 33 of the Federal Rules of Civil Procedure.
28

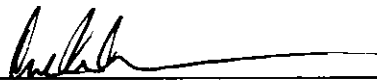
DEFINITIONS AND INSTRUCTIONS

The definitions and instructions set forth in Overture's First Set of Requests for Production of Documents are hereby incorporated by reference.

INTERROGATORIES

10. Fully describe Google's bases for its assertion of noninfringement of the '361 patent, including an identification of each claim limitation that Google contends is not present 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.

Dated: September 22, 2003

By: 

BRINKS HOFER GILSON & LIONE
Jack C. Berenzweig (*Pro Hac Vice*)
William H. Frankel (*Pro Hac Vice*)
Jason C. White (*Pro Hac Vice*)
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CERTIFICATE OF SERVICE

The undersigned hereby certifies the foregoing OVERTURE SERVICES, INC.'S FOURTH SET OF INTERROGATORIES (NO. 10) TO GOOGLE INC., was served this 22nd day of September, 2003, via facsimile, with confirmation copy via first-class mail, upon:

facsimile number (415) 397-7188

Michael S. Kwun, Esq.
Keker & Van Nest, LLP
710 Sansome Street
San Francisco, CA 94111-1704

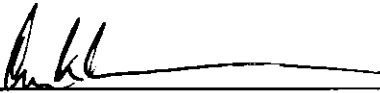


Exhibit B

1 KEKER & VAN NEST, LLP
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2 DARALYN J. DURIE - #169825
MICHAEL S. KWUN - #198945
3 CHRISTINE P. SUN - #218701
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5 Facsimile: (415) 397-7188

6 Attorneys for Defendant and Counterclaimant
GOOGLE INC.

7

8

UNITED STATES DISTRICT COURT

9

NORTHERN DISTRICT OF CALIFORNIA

10

SAN FRANCISCO DIVISION

11

12 OVERTURE SERVICES, INC., a Delaware
corporation,

Case No. C 02-01991 JSW (EDL)

13

Plaintiff and Counterdefendant,

**GOOGLE INC.'S OBJECTIONS TO
OVERTURE SERVICES, INC.'S
FOURTH SET OF INTERROGATORIES
(NO. 10)**

14

v.

15

GOOGLE INC., a California corporation,

16

Defendant and Counterclaimant.

17

18

19

20 PROPOUNDING PARTY: Overture Services, Inc.

21 RESPONDING PARTY: Google Inc.

22 SET NUMBER: Four (No. 10)

23 Google Inc. ("Google") hereby objects to Overture Services, Inc.'s ("Overture's") Fourth

24 Set of Interrogatories as follows:

25

OBJECTION TO INTERROGATORY

26

INTERROGATORY NO. 10:

27

Fully describe Google's bases for its assertion of non-infringement of the '361 patent,

28

including an identification of each claim limitation that Google contends is not present in

1 Google's Sponsored Search System, and a statement of whether Google's Sponsored Search
2 System provides an equivalent to each claim limitation that Google alleges is not present in
3 Google's Sponsored Search System.

4 **RESPONSE TO INTERROGATORY NO. 10:**

5 Google objects to this interrogatory and to Overture's definitions to the extent that they
6 are vague, ambiguous, overly broad, or unduly burdensome. Google objects to this interrogatory
7 to the extent that it seeks information that is neither relevant to the subject matter of this action
8 nor reasonably calculated to lead to the discovery of admissible evidence.

9 Google objects to the definitions to the extent they purport to give meaning or legal
10 significance to a document, fact or purported fact, whose meaning or significance is the subject
11 of dispute between the parties.

12 Google objects to this interrogatory to the extent that it seeks information protected from
13 disclosure by the attorney-client privilege, the work product doctrine, or any other privilege or
14 protection. Any inadvertent disclosure of such information shall not be deemed a waiver of any
15 such privilege or protection.

16 Google objects to this interrogatory to the extent that it seeks to impose obligations
17 beyond that imposed by the Federal Rules of Civil Procedure and applicable case law.

18 Google objects to this interrogatory to the extent that it seeks information concerning any
19 Google's Sponsored Search System that ceased to be used prior to the issuance of the Patent-in-
20 Suit, on July 31, 2001. Google's response is limited to Google's Sponsored Search Systems that
21 have been in use since the issuance of the Patent-in-Suit.

22 Based on discussions between counsel for Overture and Google, Google understands the
23 term "Google's Sponsored Search System" to be limited to advertising models that are priced on
24 a "cost-per-click" pricing model. Based on that understanding and the time limitation noted
25 above, as well as Google's objections, Google understands the term "Google's Sponsored Search
26 System" to be limited to its AdWords Select service ("AWS").

27 The interrogatory seeks "bases . . . including" claim limitations not present in AWS and a
28 statement of whether AWS provides an equivalent to each claim limitation that is not present in

1 AWS, thereby implying that Overture may be seeking further information beyond missing claim
2 limitations and/or equivalents. Google objects to this interrogatory to the extent that it seeks any
3 such further information, because to that extent "bases" is vague, ambiguous and unintelligible.

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

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

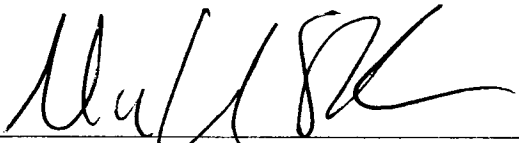
11

12 Dated: October 24, 2003

KEKER & VAN NEST, LLP

13

14

By: 
MICHAEL S. KWUN
Attorneys for Defendant and
Counterclaimant GOOGLE INC.

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Exhibit C

Charles M. McMahon
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cmcMahon@brinkshofer.com

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& LIONE

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SAN JOSE, CA
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ARLINGTON, VA

November 4, 2003

via facsimile and first class mail

Michael S. Kwun, Esq.
KEKER & VAN NEST, L.L.P.
710 Sansome Street
San Francisco, CA 94111-1704
Facsimile: (415) 397-7188

Re: *Overture Services, Inc. v. Google Inc.*,
Civ. No. C02-01991 (N.D. Cal.)

Dear Michael:

We received Google's Objections to Overture's Fourth Set of Interrogatories (No. 10). Interrogatory No. 10 calls for Google's bases for its assertion of non-infringement of the '361 patent.

Google objected to Interrogatory No. 10 in its entirety, and refused to provide any substantive response whatsoever, on the basis that the interrogatory is compound. Google's alleged basis for this objection is that the interrogatory seeks information concerning each limitation of each asserted claim, and also seeks information related to both literal infringement and infringement under the doctrine of equivalents.

Google's objection that Interrogatory No. 10 is compound is not well-founded. Interrogatory No. 10 poses a single primary question—that is, to explain Google's bases for its assertion of non-infringement. Whether or not a particular claim limitation is absent from Google's Sponsored Search System is a secondary question that is both logically and factually subsumed within the primary question. Likewise, whether or not Google's Sponsored Search System provides an equivalent to an otherwise absent claim limitation also is a secondary question that is both logically and factually subsumed within the primary question. Because Interrogatory No. 10 poses only a single primary question, the interrogatory is not compound.

Michael S. Kwun
November 4, 2003
Page 2

We request that Google withdraw this objection and immediately provide a substantive response to Interrogatory No. 10. If Google chooses to maintain this objection, please let me know when you will be available for a telephone conference on November 6 or 7, during which we may meet and confer pursuant to Local Rule 37-1(a).

Best regards,

A handwritten signature in black ink, appearing to read 'C. McMahon', with a long horizontal flourish extending to the right.

Charles M. McMahon