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22 UNITED STATES DISTRICT COURT  
 23 NORTHERN DISTRICT OF CALIFORNIA  
 24 SAN FRANCISCO DIVISION

25 OVERTURE SERVICES, INC.,  
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 27 Plaintiff,  
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 29 v.  
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 31 GOOGLE INC.,  
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 33 Defendant.

**E-Filing Case No.:** 02-01991 JSW (EDL)  
**PLAINTIFF OVERTURE SERVICES,  
 INC.'S NOTICE OF MOTION AND  
 MOTION TO COMPEL PRODUCTION  
 OF DAMAGES DOCUMENTS;  
 MEMORANDUM OF POINTS AND  
 AUTHORITIES IN SUPPORT OF  
 MOTION**

Hearing Date: March 2, 2004  
 Hearing Time: 9:00 a.m.  
 Hon. Elizabeth D. Laporte

1 **NOTICE OF MOTION AND MOTION TO COMPEL**

2 TO GOOGLE INC. AND ITS COUNSEL:

3 PLEASE TAKE NOTICE THAT on March 2, 2004, at 9 a.m., or at such time as the  
4 parties may agree and the court may allow, at the United States Courthouse, located at 450  
5 Golden Gate Avenue, San Francisco, California, in the Courtroom of Magistrate Elizabeth  
6 D. Laporte, plaintiff Overture Services, Inc. ("Overture") will move this Court for an order  
7 compelling defendant Google Inc. ("Google") to produce on or before April 1, 2004  
8 documents relating to damages and responsive to outstanding document requests, which  
9 documents Google has refused to produce and for which Google has refused to agree to a  
10 date certain for their production.

11 Pursuant to Federal Rules of Civil Procedure 26(b)(1) and 37(a)(2)(B), Overture  
12 moves this Court for an order compelling Google to produce on or before April 1, 2004 all  
13 documents relating to damages and responsive to Overture's document requests, including  
14 documents responsive to Requests for Production Nos. 26-29, 31-66, 78, 99, 107-110 and  
15 112. This motion is based on the Memorandum of Points and Authorities below, Appendix  
16 A attached to this brief, the Declaration of Andrew C. Byrnes ("Byrnes Decl.") filed  
17 herewith, and any oral argument or further briefing the Court may permit.

18 **MEMORANDUM OF POINTS AND AUTHORITIES**

19 **I. STATEMENT OF ISSUE TO BE DECIDED**

20 The issue to be decided by the Court is whether Google should be compelled to  
21 produce to Overture unquestionably responsive documents regarding damages on a date  
22 certain after the claim construction hearing, *i.e.*, April 1, 2004, where Google's justification  
23 for delaying production to date has been the parties' 2002 informal agreement that damages  
24 discovery should be produced only after the claim construction hearing, then set for March  
25 2003.

26 **II. FACTUAL BACKGROUND**

27 Overture brought the instant patent infringement lawsuit against Google on April 23,  
28 2002. In August 2002, at the parties' request, the Court set the claim construction hearing

1 for March 25, 2003. Byrnes Decl., Ex. A (8/19/2002 Joint Report, Case Management  
2 Statement and [Proposed] Order); *id.*, Ex. B (8/30/2002 Minute Order). That same month,  
3 on August 5, 2002, Overture propounded its first set of document requests, which included  
4 Requests Nos. 1-72. *Id.*, Ex. C (8/5/2002 Overture's First Set of Document Requests).  
5 Shortly thereafter, the parties came to an informal agreement that damages discovery would  
6 be postponed until after the claim construction hearing. *See, e.g., id.*, Ex. D (9/18/2002  
7 Berenzweig to Kwun Letter) at 3. While Google's written responses to Overture's  
8 document requests, for the most part, did not proffer the agreement as a specific objection to  
9 requests calling for damages discovery, Google in fact refrained from producing damages  
10 documents on that basis.

11 Later, in January 2003, the date for the claim construction hearing was extended to  
12 "on or after" July 9, 2003 due to the Magistrate Judge's granting Google's motion to extend  
13 time to provide its preliminary invalidity contentions. Byrnes Decl., Ex. E (1/7/2003  
14 Order). After the case was reassigned, Judge White first reset the claim construction  
15 hearing for July 17, 2003, *id.*, Ex. F (1/31/2003 Case Management Order), and subsequently  
16 reset it to August 7, 2003, *id.*, Ex. G (2/7/2003 Second Case Management Order). Later, the  
17 Court again continued the hearing, to October 22, 2003. *Id.*, Ex. H (3/31/2003 Order).  
18 Most recently, on September 2, 2003, upon granting Overture's miscellaneous  
19 administrative request to strike Google's oversized Responsive Claim Construction Brief,  
20 the Court set the hearing for its currently scheduled date, March 24, 2004. *Id.*, Ex. I  
21 (9/2/2003 Order). Therefore, the date for the claim construction hearing has been changed  
22 five times since the parties' agreement, and is now almost exactly one year after its  
23 originally scheduled date.

24 In the interim, on August 12, 2003, Overture propounded its Fourth Set of Document  
25 Requests, which included Request No. 78. *Id.*, Ex. J (8/12/2003 Overture's Fourth Set of  
26 Document Requests). Later, on December 5, 2003, Overture propounded its Fifth Set of  
27 Document Requests, which included Requests Nos. 99, 107-110 and 112. *Id.*, Ex. K  
28 (12/5/2003 Overture's Fifth Set of Document Requests).

1 On January 8, 2004, counsel for Overture requested that Google, in light of the  
2 rescheduling of the claim construction hearing and the length of time the case has been  
3 pending, respond to Overture's damages discovery in full by February 6, 2004. *Id.*, Ex. L  
4 (1/8/2004 Byrnes to Durie Letter). Google rejected Overture's proposal, citing the parties'  
5 2002 agreement. *Id.*, Ex. M (1/9/2004 Sun to Byrnes Letter). On January 12, Overture's  
6 counsel wrote to ask that Google reconsider its objection, *id.*, Ex. N (1/12/2004 Byrnes to  
7 Sun letter), and, having received no response in one week, left a voicemail message for  
8 Google's counsel on January 20 suggesting that Overture was interested in reaching a  
9 compromise and avoiding motion practice on this issue. *Id.*, ¶ 17. In a telephone  
10 conversation on January 21, Overture made a compromise proposal that the parties set a  
11 date certain shortly after the claim construction hearing, *e.g.*, April 1, 2004, on which they  
12 would exchange damages discovery, emphasizing the need for timely resolution of the  
13 parties' dispute and timely production of the responsive documents. *See id.*; *id.*, Ex. O  
14 (1/22/2004 Byrnes to Sun Letter); *id.*, Ex. P (1/23/2004 Byrnes to Sun Letter). Google's  
15 counsel stated that she would try, if possible, to respond to Overture's proposal on or before  
16 January 23, 2004. *See id.*; *see also id.*, Ex. Q (1/23/2004 Sun to Byrnes Letter). On January  
17 26, Google's counsel phoned Overture's counsel and made a counterproposal that Google  
18 produce "summary financial data" in "early April" and the remaining damages discovery at  
19 some unspecified later time. *Id.*, ¶ 21; *id.*, Ex. R (1/27/2004 Byrnes to Sun Letter).  
20 Overture rejected that proposal as failing to provide the appropriate certainty and timeliness  
21 of the production, and now brings this motion. *Id.*, ¶¶ 21-22; *see id.*, Ex. R.

### 22 **III. ARGUMENT**

23 Overture is entitled to discovery from Google that relates to facts that could form the  
24 basis for Overture's damages claim. There is no question that the documents responsive to  
25 the requests at issue are relevant to the damages to which Overture is entitled by this  
26 lawsuit. *See Fed. R. Civ. P. 26(b)(1)*. The discovery requested is proportional to the  
27 importance of the damages issue to the case and Overture's need for the information, is not  
28 unreasonably cumulative or duplicative, and for the most part cannot be found from a

1 source other than Google without substantial difficulty, if at all. *See* Fed. R. Civ. P.  
2 26(b)(2). Overture has a substantial need to obtain these critical documents now to conduct  
3 its damages analysis and prepare its case. The recent mediation, in particular, further  
4 highlighted the need for this information.

5 Google's justification for postponing its production of these documents is the parties'  
6 August 2002 informal agreement to delay production until after the claim construction  
7 hearing, which was then set for March 2003 and is now set to occur on March 24, 2004.  
8 Given the repeated postponement of the claim construction hearing, and the continued  
9 pendency of this now nearly-two-year-old case, Google's justification no longer makes  
10 sense. Even assuming *arguendo* that the justification retains merit, it will be moot by April  
11 1, 2004, the date by which Overture requests the production be made.

12 Nor is there justification for further delay, particularly since the vast majority of the  
13 document requests at issue have been outstanding since August 2002 and Google will have  
14 had ample time, prior to the press of the claim construction hearing, to search for responsive  
15 documents.

16 In Appendix A, attached to this motion, Overture sets forth each request that calls for  
17 documents related to damages and is therefore the subject of this motion, Google's written  
18 objections and responses, and Overture's contention regarding why Overture is entitled to  
19 production of these documents on or before April 1, 2004. Civ. L. R. 37-2.<sup>1</sup>

#### 20 **IV. CONCLUSION**

21 For all of the reasons stated above, this Court should require that Google produce on  
22 or before April 1, 2004 all "damages documents" responsive to Overture's outstanding  
23 document requests, including Requests Nos. 26-29, 31-66, 78, 99, 107-110 and 112.  
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27 <sup>1</sup> Overture is, of course, willing to reciprocate and produce damages documents responsive  
28 to Google's outstanding document requests on the same date.

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DATED: January 28, 2004

HELLER EHRMAN WHITE & McAULIFFE LLP

By //s// Andrew C. Byrnes

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ANDREW C. BYRNES

Attorneys for Plaintiff  
OVERTURE SERVICES, INC.