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 6 GOOGLE INC.

7 UNITED STATES DISTRICT COURT  
 8 NORTHERN DISTRICT OF CALIFORNIA  
 9 SAN FRANCISCO DIVISION

11 OVERTURE SERVICES, INC.,  
 12 Plaintiff and Counterdefendant,  
 13 v.  
 14 GOOGLE INC.,  
 15 Defendant and Counterclaimant.  
 16

Case No. C 02-01991 JSW (EDL)

**[PROPOSED] ORDER GRANTING  
 GOOGLE INC.'S MOTION TO COMPEL  
 PRODUCTION OF DOCUMENTS AND  
 TESTIMONY RE: PROSECUTION OF  
 THE '361 PATENT**

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1 The hearing on Defendant and Counterclaimant Google Inc.'s ("Google") Motion to  
2 Compel Production of Documents And Testimony Re: Prosecution of the '361 Patent came on  
3 regularly for hearing on August 3, 2004 at 9:00 a.m. before this Court. Upon consideration of  
4 the papers filed in support of and in opposition to the Motion to Compel, and the arguments of  
5 counsel in connection therewith, as well as the relevant papers and pleadings in this action, the  
6 Court finds:

7 1. Plaintiff and Counterdefendant Overture Services, Inc. ("Overture") has waived the  
8 attorney-client privilege over any and all communications related to the prosecution of U.S.  
9 Patent 6,269,361 ("the '361 patent") by voluntarily disclosing the substance of such  
10 communications on that subject matter. *See Weil v. Inv. Indicators*, 647 F.2d 18, 24 (9th Cir.  
11 1981); *ACLARA Biosciences, Inc. v. Caliper Tech. Corp.*, 2001 WL 777083,\*6 (N.D. Cal. June  
12 16, 2000).

13 2. Brinks, Hofer, Gilson & Lione ("Brinks Hofer"), prosecution counsel for the '361  
14 patent, has not met its burden of establishing that its attorney work product related to the '361  
15 patent was created in anticipation of litigation. *See Connor Peripherals, Inc. v. Western Digital*  
16 *Corp.*, 1993 WL 726815, \*4 (N.D. Cal. June 8, 1993). The Court further finds that Brinks Hofer  
17 has voluntarily revealed the prosecuting attorneys' mental impressions about the events that are  
18 at the core of Google's inequitable conduct allegations. Thus, to the extent that work product  
19 immunity applies to information related to the '361 prosecution, Brinks Hofer's disclosure has  
20 placed such information directly at issue and Google's need for production of that information is  
21 compelling. *See Bio-Rad Labs., Inc. v. Pharmacia, Inc.*, 130 F.R.D. 116, 122 (N.D. Cal. 1990);  
22 *ACLARA Biosciences, Inc.*, 2001 WL 777083 at \*9.

23 3. Google has met its burden of making a *prima facie* showing that inventor Darren  
24 Davis and attorney John Rauch committed fraud on the patent office during the prosecution of  
25 '361 patent. *See Starsight Telecast, Inc. v. Gemstar Dev. Corp.*, 158 F.R.D. 650, 655 (N.D. Cal.  
26 1994).

27 Good cause appearing therefore, IT IS HEREBY ORDERED THAT:

28 1. Overture shall produce any and all communications within its possession, custody, or

1 control between and among Brinks Hofer and Overture (including GoTo.com) related to the  
2 prosecution of the '361 patent, including but not limited to any and all documents summarizing  
3 or reflecting such communications, by no later than August 31, 2004.

4 2. Overture shall permit any and all testimony about the communications between and  
5 among Brinks Hofer and Overture (including GoTo.com) related to the prosecution of the '361  
6 patent.

7 3. Overture shall produce any and all work product of Brinks Hofer within its  
8 possession, custody, or control related to the prosecution of the '361 patent by no later than  
9 August 31, 2004.

10 4. Overture shall permit any and all testimony about the work product of Brinks Hofer  
11 related to the prosecution of the '361 patent.

12 5. Overture shall make James Naughton available for a second day of deposition and  
13 permit Google to obtain testimony that is consistent with Order.

14 6. In the alternative, Overture shall produce any and all communications between Mr.  
15 Rauch and Mr. Davis within its possession, custody, or control for an *in camera* inspection by  
16 the Court, so that the Court may determine if those communications were made in furtherance of  
17 fraud, by no later than August 31, 2004.

18 IT IS SO ORDERED.

19 Dated: \_\_\_\_\_

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21 Honorable Elizabeth D. Laporte  
22 Magistrate Judge of the United States  
23 District Court, Northern District of  
24 California