

EXHIBIT D

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

OVERTURE SERVICES, INC.,)
a Delaware Corporation,)
Plaintiff,)
vs.) CO2-01991 JSW
GOGGLE INC., a California)
Corporation,)
Defendant.)

The videotaped deposition of JOHN G. RAUCH, taken before DEBORAH A. MILLER, a Notary Public within and for the County of DuPage, State of Illinois, and a Certified Shorthand Reporter of said state, at Suite 3600, 455 North Cityfront Plaza Drive, Chicago, Illinois, on the 23rd day of July, A.D. 2003, at 9:08 a.m.

ORIGINAL

00:18 1 drafted by Elaine Lee.

2 Q. Did you have an understanding as to why
3 Ms. Lee was not continuing to work on the file?

4 A. I did.

09:19 5 Q. Which was what?

6 A. She had left the firm.

7 Q. Okay. Did your starting work on the
8 GoTo.com application coincide with Ms. Lee's
9 departure?

09:19 10 A. No, it did not.

11 Q. Okay. Was there a gap between when she
12 left and when you began working?

13 A. Yes.

14 Q. How long was that gap?

09:19 15 A. I don't know the answer to that
16 question.

17 Q. Could you give me any estimate?

18 A. I would guess anywhere from a few weeks
19 to a couple of months.

09:19 20 Q. Okay. Do you know who at Brinks Hofer
21 was responsible for handling the prosecution of
22 the GoTo application during that period of time?

23 A. I don't know the answer, no.

24 Q. When you were involved in prosecuting

09:19 1 the GoTo application, did you work with any
2 attorneys from Brinks Hofer other than
3 Mr. Naughton?

4 A. Not that I recall.

09:20 5 Q. When you first began working on the
6 GoTo.com application, did you review the entirety
7 of the file history as it existed as of that time?

8 A. What do you mean by "review"?

9 Q. Did you read it?

09:20 10 A. I read closely portions of the file
11 history.

12 Q. Were there any portions of the file
13 history that you did not read?

14 A. Yes.

09:20 15 Q. What were those?

16 A. The petition to make special and its
17 exhibits.

18 Q. Why didn't you read the petition to
19 make special?

09:20 20 A. Because I saw that the petition to make
21 special had been granted and didn't see a need to
22 study closely the contents of it.

23 Q. What is your understanding as to the
24 criteria for when a petition to make special will

09:39 1 that would have suggested to you that it was not
2 necessary to perform any independent search for
3 prior art?

4 A. No.

09:39 5 Q. Did you ask anyone whether it would be
6 advisable to conduct a further search for prior
7 art in connection with the prosecution of this
8 patent application?

9 A. No, I didn't.

09:40 10 Q. Why not?

11 A. I don't know.

12 Q. Did you ever direct that any further
13 search for prior art be done either by Brinks
14 Hofer or by the client in connection with
09:40 15 prosecuting this patent application?

16 A. I reminded inventors and others
17 involved in the prosecution of the obligation to
18 come forward with and disclose to the PTO any
19 information that we had documents and other
09:40 20 information, but I did not direct anyone to go out
21 and search for anything that I recall.

22 Q. Okay. When did you remind the
23 inventors of that obligation?

24 A. Specific times I don't recall. It's my

10:14 1 more than one year prior to the filing date of the
2 application?

3 A. I believe I saw press releases, other
4 information that had been cited in an IDS
10:14 5 announcing some sort of system before the time,
6 more than one year prior to the application.

7 Q. Did reviewing those press releases
8 cause you to question whether the invention that
9 was being claimed in the application might have
10:14 10 been in public use more than one year prior to the
11 filing date?

12 A. It did.

13 Q. Did you conduct any investigation to
14 determine whether the invention that was being
10:15 15 claimed in the application had been in prior
16 public use more than one year prior to the filing
17 date?

18 A. I didn't need to conduct an
19 investigation.

10:15 20 Q. Why not?

21 A. Because I had been told by Jim Naughton
22 about a beta system that had been announced in
23 press releases prior to filing the patent
24 application.

10:15 1 Q. What did Mr. Naughton tell you about
2 that beta system?

3 A. At that time I think he simply told me
4 that a beta system had been made available to the
10:15 5 public. And that's all that I recall him telling
6 me at that time.

7 Q. Okay. What did you understand
8 Mr. Naughton to mean by a beta system?

9 A. A system with some features of the
10:16 10 final system or perhaps a later system, a beta
11 system. I also understood to include only partial
12 availability perhaps only to some -- some members
13 of the public or some advertisers or customers, a
14 test system.

10:16 15 Q. Did Mr. Naughton tell you that the beta
16 system had been available only to certain
17 specified users?

18 A. I don't recall if he told me that or if
19 I surmised that or drew that supposition from the
10:16 20 name beta system.

21 Q. Okay. Did you draw any conclusions
22 from this initial conversation with Mr. Naughton
23 as to how many people had had access to this
24 so-called beta system?

10:30

1 one year prior to the filing date?

10:20

2 A. He indicated that he had been aware
3 along with Elaine Lee in preparing the patent
4 application of the beta system and that the patent
5 application had taken that into account.

10:21

6 Q. In terms of evaluating the
7 patentability of the claims that were then pending
8 in the application, did you deem the fact that
9 Mr. Naughton referred to the prior system as a
10 beta system to be in any way significant?

11 A. I'll say yes, I did.

12 Q. How so?

10:21

13 A. My understanding of the term "beta
14 system" is that it has limited functionality,
15 maybe exposed to a limited number of customers,
16 and probably not including all of the features
17 that are ultimately included.

10:21

18 Q. I take it then that you did not
19 understand the beta system to constitute an
20 experimental use?

21 MR. BERENZWEIG: May I hear that question
22 back, please. I believe there is a double
23 negative in there, and I want a clarification if
24 that's the case.

1 (WHEREUPON, the record was
2 read by the reporter.)

3 BY THE WITNESS:

4 A. You asked if I did not do anything, and
10:32 5 I don't think that's true.

6 BY MS. DURIE:

7 Q. Okay. What did you do in order to try
8 to ascertain which elements had not been in prior
9 public use or had not been invented prior to
10:33 10 commencing to prepare the Rule 132 declaration?

11 A. I think it probably came up as a matter
12 of discussion between me and Mr. Naughton at
13 different times, and as we talked about different
14 aspects of the system, I became aware of it in
10:33 15 that way.

16 Q. Okay. What do you recall Mr. Naughton
17 telling you during those conversations about which
18 elements of the claims had either not been in
19 prior public use or had not been invented until
10:33 20 less than a year prior to the filing date?

21 A. I recall being told that the direct
22 on-line advertiser access to their -- the
23 advertiser's search listings was not available in
24 the beta system. That a -- an editorial process

10:14 1 was available prior to the development of a
2 subsequent system.

3 Q. What did you understand that editorial
4 process to be?

10:34 5 A. The editorial process involved an
6 advertiser who wanted to make a change to a search
7 listing of the advertiser, making that change by
8 contacting a representative of GoTo either by
9 E-mail, telephone, or perhaps some other way, and
10:34 10 specifying the change to be made. In response to
11 that contact, an Overture -- I'm sorry, a GoTo
12 editor would make the change on behalf of the
13 advertiser and the search listing would be updated
14 that way.

10:35 15 Q. Is there anything else that you can
16 recall learning from Mr. Naughton prior to when
17 you commenced drafting the Rule 132 declaration
18 about which elements of the claims were new?

19 A. Nothing that I recall right now.

10:35 20 Q. Okay. And is there anything that you
21 did to learn which elements of the claims were new
22 prior to drafting the Rule 132 declaration other
23 than talking to Mr. Naughton?

24 MR. BERENZWEIG: May I hear that question

10:17

1 A. No, I don't. I'm afraid I don't.

10:38

2 Q. Can you recall the substance of any of
3 your conversations with Mr. Metzger which took
4 place during this same time frame between when you
5 started working on the application and when you
6 started drafting the Rule 132 declaration?

10:38

7 A. My conversations with Mr. Metzger
8 tended to be about the status of the application,
9 progress through the U.S. Patent and Trademark
10 Office, the examining process, and other -- other
11 patent matters.

12 Q. Can you remember any specifics?

10:38

13 A. At some point in time, and I don't know
14 if this falls into the time frame you're asking
15 about, the foreign filing of this application
16 became an issue. I know we talked quite a bit
17 about that, and the opportunity for filing
18 applications overseas.

10:38

19 Q. What were the issues surrounding the
20 foreign filing of this application?

21 MR. BERENZWEIG: I'm going to object at this
22 point on the basis of privilege. I've allowed you
23 to inquire into this area because it's relevant to
24 the file history; but once you're going beyond the

10:33 1 a result of your conversations with Mr. Soulanille
2 as to the nature of his duties at GoTo?

3 A. Yes, I did.

4 Q. Did you discuss with Mr. Soulanille
10:43 5 during these conversations prior to the filing of
6 the Rule 132 declaration whether he had
7 contributed in any way to the invention that was
8 being claimed?

9 A. I'm sorry. Could you ask it once
10:43 10 again? I lost the first few words.

11 Q. Yes.

12 During the conversations that you had
13 with Mr. Soulanille prior to the filing of the
14 Rule 132 declaration, did you discuss with him
10:44 15 whether he had contributed in any way to the
16 invention that was being claimed in the
17 application?

18 A. No.

19 Q. Why not?

10:44 20 A. I had no reason to discuss inventorship
21 or any contribution he might have made to that
22 subject matter.

23 Q. And was that because someone else had
24 already made a decision about who would be listed

10:44

1 as the inventors on the application?

2 A. In part, yes.

3 Q. What were the other reasons?

4 A. His involvement in development of that
5 invention was not something we discussed at that
6 time.

7 Q. I understand that. But was there any
8 reason for your not asking him about that other
9 than that someone else had already made a decision
10 about who the inventors on the application would
11 be?

10:45

12 A. There was -- there was no reason for me
13 to inquire, so I guess the answer to your question
14 is no.

10:45

15 Q. Did it occur to you when you spoke with
16 Mr. Soulanille during this time frame, based upon
17 the nature of his job responsibilities, that he
18 might have had some involvement in the invention
19 that was being claimed?

10:45

20 A. No.

21 Q. During this time frame prior to the
22 filing of the Rule 132 declaration, did you have
23 an understanding of any of the specific
24 contributions of any of the inventors who were

1 (WHEREUPON, the record was
2 read by the reporter.)

3 BY THE WITNESS:

10:48 4 A. I had no reason to doubt that the
5 correct inventors and all the correct inventors
6 had been listed.

7 BY MS. DURIE:

10:48 8 Q. But you were simply relying on whatever
9 it was that Ms. Lee and Mr. Naughton had done,
10 correct?

11 A. That's correct.

12 Q. Did you yourself have any knowledge
13 apart from simply relying on the work that they
14 had done that the correct inventors had been
10:48 15 listed?

16 A. When?

17 Q. At any time.

18 A. After the patent was granted,
19 Mr. Soulanille inquired of me about inventorship,
10:48 20 what goes into being an inventor.

21 I explained to him my understanding of
22 that determination, and he said, "Then I should
23 probably --" meaning Mr. Soulanille should
24 probably be listed as an inventor.

10:38

1 Q. Do you know what it was that prompted
2 Mr. Soulanille to ask that question?

3 A. I really don't.

10:49

4 Q. Okay. Prior to the conversation with
5 Mr. Soulanille in which he inquired as to the
6 criteria for inventorship, did you have any basis
7 for believing that the patent application recited
8 the correct inventors other than simply relying
9 on the work that had been done by Ms. Lee and
10 Mr. Naughton?

10:49

11 A. No.

12 Q. Okay. Had you had any conversations
13 with Mr. Soulanille about his involvement in the
14 development of the GoTo system prior to the
15 conversation in which he asked about the criteria
16 for inventorship?

10:50

17 A. No.

18 Q. How many times had you spoken with him
19 up to that point?

10:50

20 A. At what point?

21 Q. The point at which he inquired about
22 the criteria for inventorship.

23 A. Perhaps 10 to 20 times.

24 Q. If you added up those 10 to 20 times,

10:50

10:51

10:51

10:51

1 how many hours are we talking about?
2 A. About one to two hours, I would guess.

3 Q. During the entirety of the
4 prosecution of the application, did you ever ask
5 Mr. Soulanille whether he had contributed in any
6 way to the development of the GoTo system?

7 MR. BERENZWEIG: Can you define "GoTo
8 system"?

9 MS. DURIE: Fair enough.

10 BY MS. DURIE:

11 Q. Let me define the GoTo system as being
12 whatever GoTo system was that was up on its Web
13 site at a particular point in time.

14 MR. BERENZWEIG: What is that particular
15 point in time as to your question?

16 MS. DURIE: The system changed over time, so
17 I'm including all the various iterations of the
18 system as they existed at various points in time.

19 MR. BERENZWEIG: And what is your question
20 now?

21 BY MS. DURIE:

22 Q. My question is: During the period of
23 time when you were prosecuting the patent
24 application, did you ever ask Mr. Soulanille

10:52 1 whether he had made any contributions to the GoTo
2 system as it may have changed over time?

3 A. What -- what do you mean by
4 "contributions"?

10:52 5 Q. Whether he had had any role whatsoever
6 in the development of that system.

7 A. I didn't ask him about that, no.

8 Q. Did you have an understanding as to
9 that?

10:52 10 A. Over the course of the prosecution of
11 this application, my awareness of his position at
12 GoTo came to be one that he was a supervisor of
13 technical people. I didn't know with any degree
14 of certainty his technical involvement or
10:53 15 technical contribution or if he was just a manager
16 or what.

17 Q. What was Mr. Soulanille's title during
18 the prosecution -- during your involvement in the
19 prosecution of the patent application?

10:53 20 A. I'm not certain, but I think that it
21 was chief engineer.

22 Q. When did you learn what
23 Mr. Soulanille's title was?

24 A. I think during correspondence with him

1 regarding a continuing application that we filed
2 on his behalf.

3 Q. Do you remember when that was?

4 A. Either shortly before or shortly after
5 this patent was granted.

6 Q. Okay. When you first had conversations
7 with Mr. Soulanille, do you recall whether you
8 asked him, "Hey, what's your title"?

9 A. I recall that I didn't ask him that
10 question.

11 Q. Do you recall whether you asked him
12 what his job was?

13 A. I recall that I didn't ask him that.

14 Q. Why not?

15 A. Because we were talking about technical
16 issues, and I believe he called me with questions
17 about patent matters, patent application matters,
18 and so forth.

19 Q. During the time that you were
20 prosecuting the patent application, did you ever
21 ask anyone at GoTo who the head of engineering
22 was?

23 A. No.

24 Q. When you were prosecuting the patent

11:19

1 MR. BERENZWEIG: And you're talking about
2 this --

3 MS. DURIE: The second conversation.

4 MR. BERENZWEIG: Second. Okay.

5 BY THE WITNESS:

6 A. I would estimate 15 to 20 minutes.

7 BY MS. DURIE:

8 Q. What did you and he discuss?

11:19

9 A. I explained to him the status of the
10 application at that point. I explained to him the
11 interview that we had had with the examiner. I
12 explained to him the examiner's request for more
13 information about the differences between the
14 systems. I guess I should say between the claims
11:19 15 and the beta system. I asked him if he had
16 information about that and could help me prepare
17 that, the necessary declaration. I explained that
18 we concluded that a declaration on the part of
19 someone at GoTo was the appropriate way to respond
11:20 20 to the examiner's request for information.

21 Q. Did you tell Mr. Davis anything about
22 the qualifications that the person signing that
23 declaration would need to have other than
24 employment at GoTo?

11:16 1 Q. Okay. Other than the assumption that
2 you made based upon the fact that Mr. Davis was
3 listed as an inventor and whatever information you
4 gleaned from reading the petition to make special,
11:26 5 did you have any other basis for assuming that he
6 had worked at GoTo from time immemorial as you put
7 it?

8 A. No.

9 Q. During this conversation with
11:27 10 Mr. Davis, do you recall whether he told you
11 anything about the features of the GoTo beta
12 system?

13 A. I believe he told me that the beta
14 system was just an editorial driven system, that
11:27 15 what they referred to as the DTC system or the
16 on-line access provided to advertisers was --
17 wasn't existing in the beta system.

18 Q. Can you recall anything else that
19 Mr. Davis told you during that conversation?

11:28 20 A. During that conversation, Mr. Davis and
21 I at our respective locations looked at each of
22 the independent claims, and I asked him to tell me
23 in each respective claim what was not existing, at
24 least one limitation that was not existing in the

10:28

1 beta system.

2 This was what the examiner had asked
3 for, and this was already explained, and I needed
4 to -- from Mr. Davis in order to complete the
5 declaration. And this was specifically what I
6 asked him for, and that's what he told me.

11:28

7 MS. DURIE: Okay. Let me mark as Exhibit 28
8 a copy of a response. It's bates stamped GOG31652
9 and it's part of the file history in the case.

10 (WHEREUPON, a certain document
11 was marked Rauch Deposition
12 Exhibit No. 28, for identification,
13 as of 7/23/03.)

14 BY MS. DURIE:

11:29

15 Q. Mr. Rauch, do you recognize what's been
16 marked as Exhibit 28?

17 A. Yes.

18 Q. Did you draft it?

19 A. Yes, I did.

11:30

20 Q. I'd like you to turn to the second page
21 under claim rejections, and I'd like to direct
22 your attention to the second paragraph. Please
23 read it to yourself.

24 A. Okay.

11:44

1 away?

2 A. Yes.

3 Q. Okay. When you read -- well, strike
4 that.

11:44

5 Obviously you were aware of the
6 existence of Exhibit 10 as of the date that you
7 drafted Exhibit 28, right?

8 A. Yes.

11:44

9 Q. Okay. When you read Exhibit 10, did it
10 raise any concerns in your mind as to whether the
11 invention that was being claimed in any of the
12 claims of the patent application had been in prior
13 public use more than a year before the filing
14 date?

11:45

15 A. Yes, it did. It made me wonder about
16 that.

17 Q. Did you conduct any investigation to
18 satisfy yourself that that was not the case?

11:45

19 A. I spoke to Jim Naughton. I showed him
20 a copy of the Office Action, including the
21 rejection and the references cited, and discussed
22 the nature or the basis of the rejection.

23 Q. What did Mr. Naughton tell you?

24 A. I'm trying to recall completely. All I

11:45 1 recall is that he said this related to the beta
2 system which was announced publicly before the
3 time, a year before the patent application was
4 filed, and that the currently claimed system was
11:46 5 different from that.

6 Q. Did Mr. Naughton tell you why he
7 believed that the currently claimed system was
8 different from the system disclosed in Exhibit 10?

9 A. I don't recall what he stated about
11:46 10 that.

11 Q. Okay. You see that the date of
12 Exhibit 10 is May 19th, 1998?

13 A. I see that.

14 Q. I will represent to you that the patent
11:46 15 application was filed on May 28th, 1998.

16 A. Okay.

17 Q. I mean, 1999. I'm sorry.

18 A. I understand.

19 Q. If I referred then to May 28th, 1998,
11:47 20 as "the critical date," will you understand what I
21 mean by that?

22 A. I do.

23 Q. Okay. Did you have any discussion with
24 Mr. Naughton about whether the patent application

02:44 1 application, the subject matter of this claim as a
2 whole was not disclosed in the May 19th, 1998
3 press release."

02:44 4 First of all, did you draft this
5 declaration?

6 A. Yes, I did.

02:44 7 Q. Okay. Is there a reason that with
8 respect to Claim 15 you did not recite the
9 limitation that you had recited in Exhibit 28 in
10 Mr. Davis' declaration?

11 A. I was repeating in this declaration
12 what Mr. Davis told me in response to my request
13 conveyed to him from the examiner.

02:45 14 Q. Okay. Did you ask Mr. Davis whether
15 the limitation that you had specified in
16 Exhibit 28 for Claim 15 was present in the GoTo
17 beta system?

18 A. I did not.

19 Q. Why not?

02:45 20 A. I asked him to review each of the
21 independent claims and tell me what was new in the
22 claim.

23 Q. Did you ask him whether the statement
24 that you had made to the examiner about Claim 15

01:17

1 for Claim 30 was present in the beta system?

2 A. No, I did not.

3 Q. Was there any reason you didn't ask him
4 that?

02:47

5 A. No reason that I'm aware of.

6 Q. And I take it your answers would be the
7 same with respect to Claim 52 and Claim 68? You
8 didn't ask him and you don't know why?

02:47

9 A. I didn't ask him. I asked him other
10 questions. I didn't ask him that specific
11 question you're inquiring about.

12 Q. What other questions did you ask him?

13 A. I asked him with respect to each claim
14 what's new in this claim that wasn't present in
15 the beta system.

02:48

16 Q. And with respect to Claims 15, 30, 52,
17 and 68, he told you the subject matter of the
18 claim as a whole?

02:48

19 A. He told me the whole thing. This
20 didn't exist at that time.

21 Q. Okay. Did you ask him on a
22 limitation -- did you understand that to mean that
23 each and every limitation of the claim was not
24 present in the beta system?

00:18 1 A. The claim as a whole, the whole claim.

2 Q. Okay. I understand that, but -- I
3 understand those words, but I want to make sure
4 that I understand what you mean by those words.

02:48 5 When Mr. Davis said the whole thing is
6 new, did you understand that to mean that none of
7 the limitations in those claims were present in
8 the prior system?

9 A. No. I understood that to mean that the
02:49 10 system or method that is claimed or defined by
11 that claim wasn't present.

12 Q. Okay. Did you ask Mr. Davis to be more
13 specific as to which features or aspects of that
14 system were new?

02:49 15 A. I did not.

16 Q. Why not?

17 A. He was very adamant that the whole
18 thing wasn't existent -- wasn't existing then.

19 Q. Okay. Did you understand that there
02:49 20 were at least some elements of Claim 15 that had
21 existed in the prior system?

22 A. I don't know that I really considered
23 it. I asked him for the information and he
24 provided it -- provided it to me.

01:49 1 Q. Okay. If you take a look at Claim 15,
2 leaving the preamble to one side, the first
3 limitation is "maintaining an account database
4 having --"

02:50 5 MR. BERENZWEIG: Which Claim 15?

6 MS. DURIE: Claim 15 as it existed. I'm
7 looking at the January 18th, 2000 preliminary
8 amendment.

9 BY THE WITNESS:

02:50 10 A. Okay.

11 BY MS. DURIE:

12 Q. Okay. So if you take a look at
13 Claim 15 in the January 18th, 2000 preliminary
14 amendment, the first limitation after the preamble
02:50 15 is: "maintaining an account database having at
16 least one account record for each of a plurality
17 of network information providers, said account
18 record including."

19 Was it your understanding that what

02:50 20 Mr. Davis was telling you was that that element
21 was new?

22 A. My understanding was that the claim as
23 a whole was new, the whole method in this case was
24 new.

03:02 1 retrieval request event, et cetera, as being new,
2 correct?

3 A. Correct.

4 Q. With respect to Claim 15, he told you
03:03 5 the claim as a whole is new --

6 A. Correct.

7 Q. -- correct?

8 Okay. Did you -- when Mr. Davis told
9 you that the claim as a whole is new, did you
03:03 10 understand that to mean something different from
11 there being at least one new limitation in the
12 claim?

13 A. Yes, I did.

14 Q. Okay. What was the difference?

03:03 15 A. The difference is what Mr. Davis told
16 me as being --

17 Q. But I want to understand what you --
18 what you understood that difference to be, not
19 just the -- not the words he used, but what you
03:03 20 understood it to be.

21 A. What I understood was that Mr. Davis
22 identified this particular claim limitation of
23 Claim 1 as being something not present in the beta
24 system, and the overall systems of -- forgive me,

03:04 1 method of Claim 15 as defined by the entire claim
2 in its entirety starting at the preamble.

3 Q. Okay. Based on what Mr. Davis told
4 you, would it have been accurate to summarize it
03:04 5 as to Claim 1 by saying the system as a whole is
6 new?

7 A. It could have been. I don't know.

8 Q. Well, as you sit here today, do you
9 have any reason to think that that would not have
03:05 10 been an accurate way to summarize what Mr. Davis
11 told you with respect to Claim 1?

12 A. The system -- the method defined by
13 Claim 1 is novel, and that includes previously
14 known features.

03:05 15 Q. Okay. So when Mr. Davis told you with
16 respect to Claim 15 a system as a whole is new,
17 what you understood that to mean was the system as
18 a whole had some novelty; is that right?

19 A. Right.

03:05 20 Q. Okay. Is there any reason that you --
21 with respect to Claim 1 specified a limitation and
22 with respect to Claim 15 simply said the invention
23 as a whole -- the invention claimed as a whole is
24 new?

01:05 1 A. There is a reason.

2 Q. Which is what?

3 A. That's what Darren told me.

4 Q. Okay.

03:06 5 A. I was drafting Mr. Davis' declaration
6 using the information he gave me.

7 Q. And although you understood -- well,
8 strike that.

9 I want to be clear. So when Mr. Davis
03:06 10 said to you the invention of Claim 15 as a whole
11 is new, what you understood that to mean is at
12 least -- at least one of the elements of Claim 15
13 was new?

14 A. What I understood that to mean is that
03:06 15 the entire invention defined by Claim 15 was new.

16 Q. Let's say that with respect to
17 Claim 15 -- strike that.

18 Let's say you had a claim and one
19 aspect of it was new and other aspects of it were
03:07 20 not, would it be misleading in any way to say with
21 respect to that claim the invention as a whole is
22 new?

23 MR. BERENZWEIG: Objection speculative,
24 hypothetical.

00:19 1 understand?

2 A. That's not my practice.

3 Q. Okay. Did you discuss Paragraph 12
4 with Mr. Davis?

03:20 5 A. I did.

6 Q. What did you tell him?

7 A. I explained that the paragraph at the
8 end is a recitation of his legal obligation under
9 U.S. patent law to make truthful statements.

03:20 10 That's the conventional explanation I give to
11 inventors when they're signing declarations for
12 their patent applications and other documents as
13 well.

14 Q. Did Mr. Davis ask you any questions
03:20 15 about what Paragraph 12 meant?

16 A. Not that I recall.

17 Q. At the time that Mr. Davis executed
18 Exhibit 12, did you have a belief as to whether he
19 had personal knowledge of the facts that are set
03:21 20 forth in Exhibit 12?

21 A. I think it was my belief that he did,
22 yeah.

23 Q. What was the basis of that belief?

24 A. My awareness of his responses to the

03:21 1 request for information that I presented to him in
2 order to prepare this declaration, his level of
3 involvement in the file history before, making the
4 previous affidavit in connection with the
03:21 5 previously filed petition, his status as an
6 inventor of the application.

7 Q. Is your belief that he had personal
8 knowledge of the facts recited in Exhibit 12 the
9 reason that you did not identify any statements in
03:22 10 Exhibit 12 that were being made on information and
11 belief?

12 A. No, that's not -- that information and
13 belief language is not something I have used
14 before, so it's not part of my practice to use it.

03:22 15 Q. Have you ever before submitted an
16 affidavit where a witness was relying on
17 secondhand information where you did not specify
18 that the witness' declaration was being made on
19 information and belief?

03:22 20 A. I have not.

21 Q. Okay. Do you understand that it is
22 your obligation as an attorney in drafting a
23 declaration to specify if statements are being
24 made on information and belief?

01:30

1 A. That sounds reasonable, yes.

2 Q. Okay. So if you were to learn that

3 Mr. Davis had only secondhand knowledge about the

4 features of the beta system and today you were

03:30

5 drafting a declaration for him to sign, would you

6 specify that the information that he was providing

7 was being provided on information and belief?

8 MR. BERENZWEIG: Objection, hypothetical.

9 BY THE WITNESS:

03:30

10 A. At this time I suppose I would change

11 it.

12 MR. BERENZWEIG: Daralyn, we've been going

13 for almost an hour and a half.

14 MS. DURIE: Fine. That's fine. We can take

03:31

15 a break.

16 THE VIDEOGRAPHER: Off the record at 3:31

17 p.m.

18 (WHEREUPON, a recess was had.)

19 THE VIDEOGRAPHER: Back on the video record

03:39

20 at 3:39 p.m.

21 BY MS. DURIE:

22 Q. Mr. Rauch, I'm looking at Exhibit 31,

23 Page 6, the first paragraph. It says, "Claim 1 is

24 amended to clarify that a retrieval request event

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

OVERTURE SERVICES, INC.,)
a Delaware Corporation,)
Plaintiff,)

vs.) CO2-01991 JSW

GOGGLE INC., a California)
Corporation,)
Defendant.)

I hereby certify that I have read the foregoing transcript of my deposition given at the time and place aforesaid, consisting of Pages 1 to 252, inclusive, and I do again subscribe and make oath that the same is a true, correct and complete transcript of my deposition so given as aforesaid, and includes changes, if any, so made by me.

JOHN G. RAUCH

SUBSCRIBED AND SWORN TO
before me this day
of , A.D. 200 .

Notary Public

1 STATE OF ILLINOIS)

2) SS:

3 COUNTY OF C O O K)

4 I, DEBORAH A. MILLER, a Notary Public
5 within and for the County of DuPage, State of
6 Illinois, and a Certified Shorthand Reporter of
7 said state, do hereby certify:

8 That previous to the commencement of
9 the examination of the witness, the witness was
10 duly sworn to testify the whole truth concerning
11 the matters herein;

12 That the foregoing deposition
13 transcript was reported stenographically by me,
14 was thereafter reduced to typewriting under my
15 personal direction and constitutes a true record
16 of the testimony given and the proceedings had;

17 That the said deposition was taken
18 before me at the time and place specified;

19 That I am not a relative or employee or
20 attorney or counsel, nor a relative or employee of
21 such attorney or counsel for any of the parties
22 hereto, nor interested directly or indirectly in
23 the outcome of this action.

24 IN WITNESS WHEREOF, I do hereunto set

1 my hand and affix my seal of office at Chicago,
2 Illinois, this 28th day of July, 2003.

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Deborah A. Miller
Notary Public, DuPage County, Illinois.

My commission expires 3/01/06.

C.S.R. Certificate No. 84-3889.



Jason C. White
312-321-4225
E-mail: jcw@brinkshofer.com

BRINKS
HOFER
GILSON
& LIONE

August 27, 2003

VIA FACSIMILE (312) 704-4950

Deborah A. Miller
Esquire Deposition Services
155 N. Wacker Drive, 10th Floor
Chicago, Illinois 60606

Re: **John G. Rauch Deposition Transcript**
July 23, 2003
Overture Services, Inc. v. Google Inc.

A PROFESSIONAL CORPORATION
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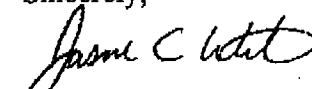
Dear Ms. Miller:

Enclosed herewith are an errata sheet (6 pages) indicating the changes to be made to John Rauch's deposition transcript and a signature page for Mr. Rauch's transcript.

Please note that in addition to the changes detailed in the errata sheet, page 8, line 9 through page 9, line 9 and page 11, line 19 through page 251, line 24 should be classified as CONFIDENTIAL. The remainder of the transcript should be non-confidential.

Please feel free to contact me if you have any questions.

Sincerely,



Jason C. White

enclosures

cc Michael S. Kwun w/enclosures (via facsimile 415-397-7188)

Errata Sheet

Deletions are in [brackets], additions are underlined

Page 5, lines 20-21:

Arizona State University [,] and the University of Minnesota

Page 5, lines 21-22

Illinois Institute of Chicago [in] Chicago[,] - Kent College of Law.

Page 10, line 18

the [graded] Davis patent itself

Page 11, line 22-23

[Erickson] Ericsson Incorporated

Page 12, line 1

[Trader] Schrader

Page 18, line 7

[petition's] petitions

Page 21, lines 16-17

office, being given special treatment

Page 22, line 3

generally, to see

Page 23, line 22

[supposed] posed

Page 29, line 7:

because of the negatives

Page 40, line 22

[past] passed

Page 42, line 8

[preferences] references

Page 47, line 11

I also understood it to include

Page 67, line 4

[inventors] inventors'

page 71, line 12
[one]

Page 81, line 13
differences and

Page 88, line 23
[He] It was clear that

Page 108, lines 20-24
[That—to] To me, that sentence is drawing a distinction between advertisers paying for [the word] “exposures”, as it’s used here, or its analog, impressions, versus paying for, what it says, actual visits to sites of an advertiser.

Page 110, line 17
[the] a retrieval request event

Page 111, lines 12-15
[I was going to state that for] For the exemplary embodiment described in this patent application, [I guess its] line 29 of page 15 states that

Page 112, lines 13-16
[And a – well limited to] The term “retrieval request event” also includes other embodiments I might not be aware of, as I sit here, without going through [it] the patent application more closely, and [equivalence] the term “retrieval request event” also includes equivalents of this disclosed embodiment.

Page 115, lines 21-22
[with a] of that claim limitation

Page 116, line 9
[a distinguished --] a prior art

Page 118, line 8
advertiser [system] systems

Page 125, line 16
Positions,

Page 128, lines 14-16

[I guess the first question] I have to ask you [is] when?, at what time are you asking about? [And the second, could you -- it] It sounded

Page 129, line 11

[Internet --] conventional Internet technology

Page 139, lines 14-15

and say, "this isn't there."

Page 139, line 20

Related to that, one other reason is just the general

Page 148, line 9

"receiving from a network information provider a

Page 148, line 11

information provider's account," is receipt over an

Page 149, lines 3-6

I think [at -- as the term] that as the terminology we're discussing here is used in this patent application, [it's --] it doesn't include that option of making a telephonic request.

Page 149, lines 8-10

Well, I don't think it's described that way in here. It's described in the patent application as an on-line access. Also, making a telephonic request to change a listing was in the prior art beta system. A claim can not be interpreted so broadly as to read on the prior art, so claim 15 can not include that option.

Page 150, lines 5-8

[And equivalence yeah, and any other embodiments that might be described that aren't -- that aren't jumping off the page at me now]. The scope of the claim element "updating a search listing" should be interpreted to have the full range of its ordinary meaning as understood by persons ordinarily skilled in the art to which the invention pertains. The ordinary meaning may be determined using sources such as dictionaries and treatises. If necessary, the intrinsic record should be consulted to identify which of different possible dictionary meanings of the claim element "updating a search listing" is consistent with the inventors' meaning. Also, the intrinsic record should be consulted to determine whether the presumption that the ordinary and customary meaning intended for the claim element "updating a search listing" has been rebutted.

Errata Sheet

Page 150, line 14

And [equivalence thereof, yes.] My understanding is that the scope of that claim element should be interpreted to have the full range of its ordinary meaning as understood by persons ordinarily skilled in the art. The ordinary meaning may be determined using sources such as dictionaries and treatises. If necessary, the intrinsic record should be consulted to identify which of different possible dictionary meanings of that claim element is consistent with the inventors' meaning. Also, the intrinsic record should be consulted to determine whether the presumption that the ordinary and customary meaning intended for that claim element has been rebutted.

Page 150, lines 19-22

[It could be. I think, if there's a suggestion here that --that said alternatively it could be. Alternatively, it could done by receiving an E-mail.]
I'm not sure what the question means by the words "to do an on-line to pick up the phone and call someone..." This language is confusing and seems contradictory. However, in my view, "picking up the phone and calling someone and asking that account information be changed" would not be an equivalent to receiving a change request for a search listing, since a claim can not encompass as an equivalent subject matter which is in the prior art. Here, receiving a phone call was part of the GoTo beta system, so the scope of claim 15

Page 152, line 5

[I think it probably would be yes.] No, it would not be equivalent since that was part of the prior art beta system, and a claim's scope can not be extended under the doctrine of equivalents to cover something in the prior art.

Page 152, lines 12-14

[I think my understanding is that the -- what you -- what I believe] It is my understanding that what you just described was present in the beta system, and the scope of Claim 15 could not encompass such a prior art system under the doctrine of equivalents. Therefore, the scope of Claim 15 can not encompass a system in which a search listing is updated by picking up the phone and calling an account administrator and asking that a change to the search listing.

Page 152, line 23- page 153 line 3

Focusing just on this claim limitation, [because] as I understand it, that feature was a part of the beta system. [, the] The scope of Claim 15 could not include that feature as I understand you're describing it.

Page 156, line 3

From the perspective of the embodiments and equivalents thereof that are described in the specification, updating a search listing could hypothetically include updating a search listing telephonically, to the extent that does not read on the prior art. However, as previously stated, that was disclosed in the beta system. Under the Doctrine of Equivalents, considering both what is described in the specification and what is in the prior art, the range of equivalents can not be so broad as to include updating a search listing telephonically.

[Equivalently, yes, I do].

Page 157, line 4

stated in response to these questions, including that my understanding is that a search listing updated telephonically was part of the GoTo beta system and therefore in the prior art, so that the range of equivalents for the term "updated search listing" Claim 15 can not encompass a search listed updated telephonically.

Page 159, line 18

[promoter] promoters

Page 173, lines 19-20

He told me, "the whole this. This didn't exist at that time."

Page 177, line 14

To the best of my knowledge, he [didn't] did.

Page 183, lines 16-18

limitation "recording a retrieval request [--excuse me, retrieval request] event in an account database corresponding to the searcher's retrieval request."

Page 185, lines 12-14

The [system – the] method defined by Claim 1, taken as a whole, is novel, and that includes previously known features.

Page 189, lines 18-19

I think the language, "was not yet in existence" means that it had not yet been invented,

Page 206, line 5

April 6th, I think was the date I [saw] called him.

Page 223, line 23 – page 224, line 2

telephonic interview. I don't know if the [The] phone call was initiated [I don't know] from our end or from the examiners calling us. The supervisor, Mr. Millin stated that he and [seen] reviewed with Mr. Nguyen our draft

Errata Sheet

Page 224, line 5
that we proposed [it had] to add.

Handwritten initials

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

OVERTURE SERVICES, INC.,)
a Delaware Corporation,)
Plaintiff,)
vs.) CO2-01991 JSW
GOGGLE INC., a California)
Corporation,)
Defendant.)

I hereby certify that I have read the foregoing transcript of my deposition given at the time and place aforesaid, consisting of Pages 1 to 252, inclusive, and I do again subscribe and make oath that the same is a true, correct and complete transcript of my deposition so given as aforesaid, and includes changes, if any, so made by me.

John G. Rauch
JOHN G. RAUCH

SUBSCRIBED AND SWORN TO
before me this 27th day
of August, A.D. 2003.

Notary Public
Brenda S. Skinner



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