

EXHIBIT K

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IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

OVERTURE SERVICES, INC., a)
Delaware Corporation,)
)
Plaintiff,)
) Case No. C 02-01991
-vs-)
GOOGLE, INC., a California)
Corporation,)
)
Defendant.)

CERTIFIED COPY

Videotaped deposition of JAMES P. NAUGHTON,
ESQ., taken before MARGARET A. BACHNER, CSR, RMR, CRR,
and Notary Public, pursuant to the Federal Rules of Civil
Procedure for the United States District Courts
pertaining to the taking of depositions, at Suite 3600B,
NBC Tower, 455 North Cityfront Plaza Drive, Chicago,
Illinois, on the 15th day of April, A.D. 2004, at 8:38
a.m.

There were present at the taking of this
deposition the following counsel:



JAMES P. NAUGHTON

1 A. Not that I'm aware of.

2 Q. Can you describe for me, please, your
3 educational background?

4 A. I received a Bachelor's degree in electrical
5 engineering from the University of Illinois in 1978. I
6 received a law degree from the University of Illinois in
7 1981. I guess that would be the conclusion of my formal
8 academic education.

9 Q. Have you had other informal academic training
10 since then?

11 A. I don't believe so.

12 Q. What did you do workwise upon completing your
13 college degree?

14 A. I was first employed at a law firm called
15 Newman, Williams, Anderson & Olson.

16 Q. What was your position there?

17 A. I was an associate attorney.

18 Q. How long did you remain there?

19 A. I'm sorry?

20 Q. How long did you remain there?

21 A. At the firm?

22 Q. Yes.

23 A. Until approximately 1989 or 1990.

24 Q. Can you describe for me very generally the

JAMES P. NAUGHTON

1 nature of the work that you did at that firm?

2 A. I did intellectual property work, a mix of
3 patent, trademark, copyright and related matters.

4 Q. Did you handle both patent prosecution and
5 patent litigation?

6 A. Yes.

7 Q. In the course of your responsibilities in
8 patent litigation, would your duties involve such things
9 as drafting declarations?

10 A. I think on occasion I did.

11 Q. Responding to discovery requests?

12 A. Did I do that?

13 Q. Yes.

14 A. I believe I did.

15 Q. Did you ever make court appearances?

16 A. Yes, I did.

17 Q. I take it that you are a member of the patent
18 bar?

19 A. Yes, I am.

20 Q. Did you take any kind of review or study
21 course in connection with becoming a member of the patent
22 bar?

23 A. Yes.

24 Q. How long did that class last?

JAMES P. NAUGHTON

1 A. The formal class itself I believe lasted a
2 week or less.

3 Q. By whom was it given?

4 A. I don't recall.

5 Q. Did you take it here in Chicago?

6 A. I believe I did.

7 Q. And was it given by some national organization
8 that gives review sessions for taking the patent bar?

9 A. It would have been some sort of formal course.
10 Whether it was a national or some other level, I don't
11 recall.

12 Q. What did you do after leaving your employment
13 as an associate at the first firm that you worked at?

14 A. Well, the question lacks foundation. I did
15 not leave that firm as an associate.

16 Q. Fair enough. So, at some point you became a
17 partner at that firm?

18 A. Yes, I did.

19 Q. When was that?

20 A. In about 1986.

21 Q. As a partner did your job responsibilities
22 also encompass both patent prosecution and patent
23 litigation?

24 A. I believe so.

JAMES P. NAUGHTON

1 Q. What did you do after leaving that firm?

2 A. I began at another law firm.

3 Q. What was the name of that other law firm?

4 A. Roper & Quigg.

5 Q. Where is that firm located?

6 A. It has an office in Chicago.

7 Q. Were you based out of the Chicago office?

8 A. Yes, I was.

9 Q. Generally speaking, what were the nature of
10 your responsibilities at Roper & Quigg?

11 A. Again intellectual property law practice.

12 Q. Did that again encompass both patent
13 prosecution and patent litigation?

14 A. Yes.

15 Q. And did you again have occasion to submit
16 declarations?

17 A. I can't recall specifically if I personally
18 submitted a drafted declaration in that time frame.

19 Q. Did you have the opportunity to make court
20 appearances?

21 A. Yes.

22 Q. And I take it you certainly had the
23 opportunity to review declarations in the course of your
24 work as a patent litigator at a patent firm?

JAMES P. NAUGHTON

1 A. I believe I did.

2 Q. What did you do next?

3 A. Then I became employed at another law firm.

4 Q. What was the name of the third law firm?

5 A. Brinks, Hofer, Gilson & Lione, although it had
6 a different name at the time.

7 Q. What was the name of the firm at the time?

8 A. I believe, if my recollection is correct, it
9 was Willen, Brinks, Hofer, Gilson & Lione.

10 Q. If we simply refer to it as Brinks, Hofer, you
11 will understand that I'm referring to the firm,
12 regardless of its name at the time?

13 A. Yes.

14 Q. What was your position when you first joined
15 Brinks?

16 A. I believe it was counsel or of counsel. I
17 forget which one.

18 Q. Did there come a time when you became a
19 partner of the firm?

20 A. I became a shareholder of the firm.

21 Q. When did that take place?

22 A. I believe it was January of 1996.

23 Q. Can you describe for me generally your duties
24 and responsibilities during the period of time that

JAMES P. NAUGHTON

1 you've been employed at Brinks?

2 A. Intellectual property law practice.

3 Q. Again encompassing both patent prosecution and
4 patent litigation?

5 A. Yes.

6 Q. Can you give to me the names of some of the
7 clients that you have had while at Brinks?

8 A. Some of the clients --

9 MS. THAYER: Before you go on, if you're going to be
10 naming clients where it's not publicly known that they
11 are a client of the firm or that would involve
12 confidential information, you need to designate that so
13 that we can have the record so -- so indicate.

14 If you simply name the clients, then it's a
15 matter of public record that they are clients of the
16 firm, then that's fine.

17 Is the distinction clear?

18 THE WITNESS: Yes.

19 BY THE WITNESS:

20 A. I certainly don't recall in each instance for
21 every client whether or not it was publicly known that
22 our firm represented them in a matter. So, let me think
23 about clients for which I do know that there's some
24 public knowledge of our firm having represented the

JAMES P. NAUGHTON

1 client.

2 Amp, Incorporated, now part of Tyco, Inc.

3 Herman Miller, Inc.

4 GoTo.com, Inc., now Overture.

5 Alpine Electronics, Inc.

6 Those are some of the major ones. I've worked
7 on matters for a great number of clients over the years.

8 Q. Have you ever been involved in the prosecution
9 of any patents as to which claims of inequitable conduct
10 were subsequently made?

11 A. Not to my knowledge.

12 Q. And something you said raised a good point.
13 GoTo became Overture Services. If I refer to GoTo or
14 Overture, will you understand that I am referring to the
15 two entities interchangeably?

16 A. In general, yes, unless the name somehow
17 becomes a distinction.

18 Q. Okay. Similarly, I may be referring to the
19 GoTo or Overture system as it existed on May 27th, 1998
20 or earlier. If I refer to such a system as the
21 precritical date system, will you understand what I'm
22 referring to?

23 MS. THAYER: I actually don't understand what you're
24 referring to when you say, "the system." Can you be more

JAMES P. NAUGHTON

1 A. No, I don't.

2 Q. Do you know the nature of the work that Mr.
3 Fleming had been doing for Overture Services prior to
4 your introduction to the company?

5 MS. THAYER: You can answer that yes or no.

6 BY THE WITNESS:

7 A. Yes.

8 BY MS. DURIE:

9 Q. Can you describe for me at a broad level of
10 generality the nature of that work?

11 A. The thing I'm aware of -- there may be other
12 activities -- he was involved, I believe, in a litigation
13 at that time on behalf of GoTo.com.

14 Q. Who was the adverse party in that litigation?

15 A. I believe it was Disney.

16 Q. Do you know whether -- well, first of all,
17 does Dave Fleming handle patent prosecution work?

18 A. Not to my knowledge.

19 Q. To your knowledge, did anyone from Brinks,
20 Hofer have any involvement in patent prosecution work for
21 Overture prior to your first introduction to Overture?

22 A. Not to my knowledge.

23 Q. Approximately when were you first introduced
24 to someone from Overture?

JAMES P. NAUGHTON

1 A. I think it would have been the first half of
2 1999.

3 Q. '99?

4 A. Yes.

5 Q. If you can turn in the binder in front of you
6 to what's been marked -- previously marked as Exhibit 2,
7 do you recognize Exhibit 2 as a copy of the '361 patent?

8 A. I recognize the first page. I'll take your
9 word for it that it's a complete copy.

10 Q. You see on the first page that it says that
11 there's a filing date of May 28th, 1999?

12 A. Yes.

13 Q. Does that assist your recollection in trying
14 to recall when it was that you first had any
15 communications with anyone from Overture?

16 A. It -- it corroborates that it was in the first
17 half of 1999.

18 Q. Can you be any more specific?

19 A. I believe it would have been sometime between
20 February and April 1999, with the bell curve being
21 centered somewhere over March.

22 Q. Right. Understood. I want to start by
23 focusing on your first meeting with anyone at Overture.
24 Who was present at that meeting?

JAMES P. NAUGHTON

1 A. The first in-person meeting?

2 Q. Yes.

3 A. I can't recall specifically who the very first
4 person was that I met.

5 Q. Okay. Can you isolate some group of initial
6 meetings and tell me who was present at those?

7 A. There did occur an initial visit by me to GoTo
8 in Pasadena. I believe I met with at least Joshua
9 Metzger in that first trip. And I likely met with a
10 number of other people, but I can't specifically recall
11 who I met on which trip.

12 Q. Let me try to focus your attention generally
13 speaking on the time frame before May of 1999.

14 A. Mm-hmm.

15 Q. During that time frame did you ever have any
16 face-to-face meetings with Tom Soulanille?

17 A. Again, it's hard for me to specifically recall
18 when I first met Mr. Soulanille.

19 Q. So, I take it that you did meet Mr. Soulanille
20 at some point?

21 A. Yes.

22 Q. And you're having a hard time placing it
23 before or after May of 1999?

24 A. The first meeting?

JAMES P. NAUGHTON

1 Q. Yes.

2 A. Mm-hmm.

3 Q. Have you ever met Steve Skovran?

4 A. Can you tell me what he looks like?

5 Q. No.

6 A. I may have.

7 Q. Do you recall whether you met him before May
8 1999?

9 A. No, I don't.

10 Q. Have you ever met a gentleman named Matthew
11 Derer? He goes by the nickname Xeno.

12 A. Yes, I believe I did.

13 Q. When did you first meet him?

14 A. I don't recall when I first met him.

15 Q. Do you recall whether it was before or after
16 May 1999?

17 A. I don't recall if the first meeting was before
18 or after that date.

19 Q. Did you meet these gentlemen all at the same
20 time or in meetings that took place over more than one
21 visit to Pasadena?

22 MS. THAYER: Objection. Compound.

23 BY THE WITNESS:

24 A. It's a good objection. Can you rephrase the

JAMES P. NAUGHTON

1 question?

2 BY MS. DURIE:

3 Q. You can answer.

4 A. Are we talking about the first time I met the
5 various people?

6 Q. Sure.

7 A. I would not have met all of them for the first
8 time at the same time.

9 Q. Okay. So, I take it you took multiple trips
10 out to Pasadena?

11 A. I have taken multiple trips to Pasadena over
12 time.

13 Q. What is your best estimate of when it was that
14 you first met Tom Soulanille?

15 A. I don't recall specifically, but I believe it
16 likely I would have first met him in 1999.

17 Q. Is it possible for you to be more precise as
18 to when in 1999 you first met him?

19 A. Not -- not at the moment.

20 Q. Okay. When did you first meet Steve Skovran?

21 A. I'm not sure if I have met him. I'm also not
22 sure when it would have been that I first met him, if I
23 did.

24 Q. When did you first meet Matthew Derer, a/k/a