

## **EXHIBIT K (CONT.)**

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1 Q. Yes.

2 A. I don't know whether it was comprehensive or  
3 not.

4 Q. Okay. What sorts of articles did you have?

5 A. Lots of different articles. I can't recall  
6 specific ones.

7 Q. Okay. Were these articles about the GoTo.com  
8 system, articles about other possible prior art systems  
9 or both?

10 A. My initial investigation even at that point  
11 would have included -- I would have been interested in  
12 any other prior art, potential prior art that they were  
13 aware of. So, it may have included articles or mentions  
14 of other things.

15 Q. Were you familiar at that time with Open Text?

16 A. At some point I heard of something called Open  
17 Text.

18 Q. Did you hear about Open Text in connection  
19 with your initial investigation?

20 A. I don't recall if it was in connection with  
21 that initial investigation or not.

22 Q. Can you sort of bookmark for me the time frame  
23 in which you heard about Open Text?

24 A. Likely 1999. And if it was referred to in the

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1 information disclosure statements filed in the Patent  
2 Office in connection with this application, then that was  
3 an outside -- or latest time by which I became aware of  
4 it.

5 Q. Okay. Is there anything else you can tell me  
6 more specifically about the documentation that you  
7 received as part of your initial investigation?

8 A. It was faxed to me initially.

9 Q. Okay.

10 A. 'Cuz I wanted to start getting into it  
11 quickly. I can't presently recall further details.

12 Q. Okay. You said that there was also prior art  
13 we gathered to submit to the PTO?

14 A. Yes.

15 Q. Who participated in the process of gathering  
16 prior art to submit to the PTO?

17 A. By that point I had asked Elaine Lee to  
18 participate in the preparation of this patent  
19 application. And it would have been during that time  
20 period that we would have made this more specific request  
21 to the client to gather all prior art you're aware of,  
22 such-and-such, for us to submit to the Patent Office.

23 Q. Who made that request to the client?

24 A. I don't recall specifically.

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1 Q. To whom at the client was that request made?

2 A. I don't recall specifically.

3 Q. Okay. Did someone at GoTo submit to you or  
4 Ms. Lee a set of prior art in response to that request?

5 A. I believe so.

6 Q. Okay. And was everything that was received  
7 from your client then submitted to the PTO?

8 A. I can't recall if we weeded out anything as,  
9 for example, being just clearly irrelevant and not  
10 constituting prior art. I certainly do not recall  
11 weeding out anything that arguably was prior art.

12 Q. Did you weed out any press releases?

13 A. Not, not to my recollection.

14 Q. Did you ask for all press releases relating to  
15 the precritical date system to be submitted to the PTO?

16 A. I don't recall if there was a specific request  
17 for each and every press release. I just don't recall  
18 that specifically.

19 Q. Well, was it your intent that all press  
20 released relating to the precritical date system should  
21 be submitted to the PTO?

22 A. I can't -- I don't recall that being a  
23 specific intent that -- that -- we specifically were  
24 interested in making sure that each and every single

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1 press release was submitted to the Patent Office. We  
2 certainly, I recall, wanted to be as comprehensive as  
3 reasonably possible.

4 On the other hand, in patent matters if  
5 something is purely cumulative, you don't need to submit  
6 it to the Patent Office. So, for example, if there were  
7 two press releases reported in two different places but  
8 they said exactly the same thing, you might decide not to  
9 submit both of them. I don't recall if that occurred  
10 here, but that's an example of where you may not submit  
11 every single item of an article or a press release in a  
12 particular category.

13 But on the other hand, we certainly intended  
14 to be as comprehensive as we possibly could.

15 Q. In the situation of two press releases saying  
16 the same thing where one's gonna get weeded out, would it  
17 be your practice to have both of those press releases  
18 sent to you or one of the attorneys that you were working  
19 with to make that determination?

20 A. If someone asked me should they send me both,  
21 I would say yes, send me both.

22 Q. And I take it you didn't instruct people to  
23 weed out things that were duplicative before they were  
24 sent to you?

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1 A. Not that I recall.

2 Q. And press releases was certainly one of the  
3 categories of information that you were seeking to obtain  
4 in order to provide to the PTO, right?

5 A. I don't recall specifically identifying press  
6 releases, but as I recall there were press releases among  
7 the information. So, it was something we were aware of  
8 and the client provided to us. So, it was in the mix.

9 Q. Okay. Well, I take it you certainly -- you  
10 certainly understood that press releases were a  
11 potentially important source of public statements about  
12 the features of Overture's precritical date system?

13 A. I believe I understood that the press releases  
14 could be one category of potential prior art.

15 Q. Did you or Overture retain an outside searcher  
16 to conduct a prior art search?

17 A. Yes.

18 Q. What was the name of that entity?

19 A. I'm not sure what the entity may have been  
20 called, if even there was an entity associated --

21 Q. What was the name of the person?

22 A. Richard Turer, T-u-r-e-r.

23 Q. When was Mr. Turer retained?

24 A. I believe that I requested that he perform a

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1 patentability search in 1999.

2 Q. Do you recall when in 1999?

3 A. Not specifically.

4 Q. Was it prior to the filing of the application?

5 A. I can't be sure, but I think it may have been  
6 afterwards.

7 Q. Okay. Do you recall whether Mr. Turer located  
8 any items of potential prior art?

9 A. I believe he identified some search results.

10 Q. Can you tell me what any of those search  
11 results were?

12 A. Not by name or patent number.

13 Q. Okay. Was everything that Mr. Turer  
14 identified disclosed to the PTO?

15 A. That's my recollection.

16 Q. Is there someplace a list of those things that  
17 Mr. Turer identified?

18 A. I can't recall if there is such a specific  
19 list or not.

20 Q. Okay. Did Mr. Turer typically give reports in  
21 writing?

22 A. I believe he did.

23 Q. Do you have any reason to think that his  
24 report in this case would have been discarded?

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1 "It is therefore an object of the  
2 present invention to provide a system and  
3 method for enabling promoters to influence a  
4 position on a search result list generated by  
5 an Internet search engine for a specified set  
6 of search terms."

7 MS. THAYER: It actually says, "search result  
8 listing." I don't know if it --

9 MS. DURIE: You're right.

10 MS. THAYER: -- makes a difference or not, but --

11 BY MS. DURIE:

12 Q. Taking just that paragraph in isolation, did  
13 what we have been referring to as the beta system, which  
14 was in public use prior to May 28th, 1998, satisfy just  
15 the one paragraph that I have read?

16 MS. THAYER: Objection. Vague and ambiguous.

17 BY THE WITNESS:

18 A. I don't think so, to the extent I understand  
19 your question.

20 BY MS. DURIE:

21 Q. Okay. Did the beta system that was in public  
22 use prior to May 28th, 1998 provide a system and method  
23 for enabling promoters to influence a position on a  
24 search result listing generated by an Internet search



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1 engine for a specified set of search terms?

2 A. I don't believe so.

3 Q. Why not?

4 A. I don't believe the beta system had this  
5 capability.

6 Q. And which capability specifically are you  
7 referring to?

8 A. I don't believe the beta system provided a  
9 system and method for enabling promoters to influence a  
10 position on a search result list generated by the beta  
11 system, which we can call an Internet search engine, for  
12 a specified set of search terms.

13 Q. Okay. Did the beta system involve the use of  
14 an Internet search engine?

15 A. I think that's a fair characterization to the  
16 extent I understand both the phrase "Internet search  
17 engine" and the functionality of the beta system as that  
18 phrase is used often colloquially.

19 Q. Okay. Did the beta system allow website  
20 promoters to bid on the placement of search result  
21 listings?

22 A. Did the beta system allow that?

23 Q. Yes.

24 A. No, to my understanding.

JAMES P. NAUGHTON

1 STATE OF ILLINOIS )

)

2 COUNTY OF DU PAGE )

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4 The within and foregoing deposition of the  
5 aforementioned witness was taken before MARGARET A.  
6 BACHNER, CSR and Notary Public, at the place, date and  
7 time aforementioned.

8 There were present during the taking of the  
9 deposition the previously named counsel.

10 The said witness was first duly sworn and  
11 was then examined upon oral interrogatories; the  
12 questions and answers were taken down in shorthand by  
13 the undersigned, acting as stenographer and Notary  
14 Public; and the within and foregoing is a true, accurate  
15 and complete record of all of the questions asked of and  
16 answers made by the aforementioned witness, at the time  
17 and place hereinabove referred to.

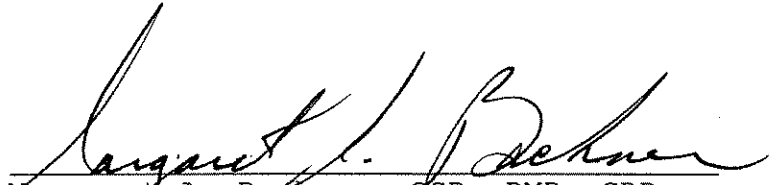
18 The signature of the witness was not waived,  
19 and the deposition was submitted, pursuant to Rules 30(e)  
20 and 32(d) of the Rules of Civil Procedure for the United  
21 States District Court, to the deponent per copy of the  
22 attached letter.

23

24

1                   The undersigned is not interested in the  
2 within case, nor of kin or counsel to any of the parties.

3                   Witness my official signature and seal as  
4 Notary Public in and for DuPage County, Illinois, on this  
5 19<sup>th</sup> day of April, A.D. 2004.

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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. )

I, JAMES P. NAUGHTON, ESQ. Hereby certify that  
I have read the foregoing transcript of my deposition  
given at the time and place aforesaid, consisting of  
Pages 1 to 277, 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, made by me.

*James P. Naughton*  
JAMES P. NAUGHTON ESQ.

SUBSCRIBED AND SWORN TO before me this  
17 day of May 2004.

*Karen S. Imundo*  
Notary Public

