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11 UNITED STATES DISTRICT COURT
12 NORTHERN DISTRICT OF CALIFORNIA
13 SAN JOSE DIVISION

14 VISTO CORPORATION,

15 Plaintiff,

16 vs.

17 SMARTNER INFORMATION SYSTEMS,
18 LTD.

19 Defendant.

) Case No. **CV 06 - 80339 MISC.**
) Case No. 2:05-CV-91 (TJW)
) (US District Court, Eastern District of Texas –
) Marshall Division)
) SMARTNER INFORMATION SYSTEMS,
) LTD.'S MOTION TO COMPEL DRAPER
) FISHER JURVETSON MANAGEMENT
) COMPANY TO COMPLY WITH RULE 45
) SUBPOENA

E-FILING

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NOV 22 2006

RICHARD W. WIEKING
CLERK U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE

PVT

RMW

1 Pursuant to Fed. R. Civ. P. 45, Defendant Smartner Information Systems, Ltd., (“Smartner”)
2 respectfully moves to compel Draper Fisher Jurvetson Management Company V, (“Draper”) to
3 produce documents pursuant to a subpoena properly served on October 26, 2006. Despite requests
4 from Smartner, Draper refuses to produce the requested documents.

5 The subpoena at issue relates to actions currently pending in the Eastern District of Texas:
6 (*Seven v. Visto*, E.D. Tex. Civil Action No. 2:05-CV-365TJW and *Visto v. Smartner*, E.D. Tex. Civil
7 Action No. 2:05-CV-91TJW, (the “Underlying Actions”)), as well as to Smartner’s currently pending
8 Motions to Compel Pamela Merkadeau and Greg Warder To Comply With Rule 45 Subpoenas,
9 currently assigned to Magistrate Judge Seeborg in this Division. In all actions, counsel representing
10 Visto and counsel representing Smartner and Seven Networks, Inc. (“Seven”) are the same. In the
11 underlying actions, Visto is asserting that Smartner has infringed three of its patents.

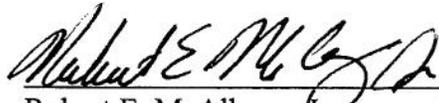
12 Draper is a venture capital company who was involved in Visto’s recent round of financing.
13 (*See* McAlhany Decl. Ex. A). In order to support its affirmative defenses and counterclaims, Smartner
14 seeks production of documents relating to any contribution made by Draper as well as documents
15 relating to its decision to contribute and/or participate in Visto’s recent round of funding. (*See*
16 McAlhany Decl. Ex. B). The documents requested are relevant to both damages (e.g., the alleged
17 value of the patents-in-suit and thus a reasonable royalty) and/or validity (e.g., commercial success or
18 the lack thereof). (*See generally*, *Georgia-Pacific Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116,
19 1120 (S.D.N.Y. 1970) (commercial success is a factor in the calculation of a reasonable royalty) and
20 *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (commercial success is a secondary consideration of
21 non-obviousness)).

22 Pursuant to Fed. R. Civ. P. 45(c)(2)(B), any objections to Smartner’s October 26 subpoena
23 were due by November 6, 2006, the requested date of production. Draper’s objections served on
24 November 13, 2006, eighteen days after service on Draper, are untimely. (*See* McAlhany Decl. Ex. C).
25 Therefore, Draper has waived all objections to Smartner’s subpoena. In the meet and confer on this
26 matter, counsel for Draper indicated that the sole reason for withholding the requested documents is on
27 the basis of relevance. As the requested documents are clearly relevant to issues of validity and
28 damages, as well as to Visto’s requested injunction against Smartner.

1 Pursuant to the foregoing, Smartner respectfully requests an Order compelling Draper to
2 produce the requested documents without further delay.

3 Dated: November 22, 2006

HOWREY LLP

4
5 By: 
6 Robert E. McAlhany, Jr.
7 Attorneys for Defendant
8 Smartner Information Systems, Ltd.
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CERTIFICATE OF CONFERENCE

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I hereby certify that counsel for Smartner conferred with counsel for Visto in an attempt to resolve this matter without Court intervention. Counsel for Visto informed counsel for Smartner that it opposes this motion.

Dated: November 22, 2006

By: 
Robert E. McAlhany, Jr.

CERTIFICATE OF SERVICE

I am a citizen of the United States and employed in San Mateo County, California. I am over the age of eighteen years and not a party to this action. My business address is 1950 University Avenue, 4th Floor, East Palo Alto, CA 94303. I am readily familiar with the firm's practices for collection and processing of correspondence for mailing with the United States Postal Service. On November 22, 2006, I sent copies of the attached document via email to the addresses below. I also placed with this firm at the above address for deposit with the United States Postal Service a true and correct copy of the within document(s):

SMARTNER INFORMATION SYSTEMS, LTD.'S MOTION TO COMPEL DRAPER FISHER JURVETSON MANAGEMENT COMPANY TO COMPLY WITH RULE 45 SUBPOENAS

In a sealed envelope, postage fully paid, addressed as follows:

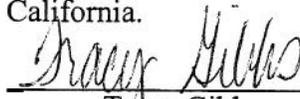
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(Via Email & U.S. Mail)

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Following ordinary business practices, the envelope was sealed and placed for collection and mailing on this date, and would, in the ordinary course of business, be deposited with the United States Postal Service on this date.

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed on November 22, 2006, at East Palo Alto, California.



Tracy Gibbs