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5 Attorneys for Third Party  
IPVALUE MANAGEMENT, INC.

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

10 GOOGLE, INC., and YOUTUBE, LLC,

11 Plaintiff(s),

12 v.

13 IPVALUE MANAGEMENT INC.,

14 Defendant.  
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Case No. C11-80016 MISC RS (BZ)

**DECLARATION OF ANDREW J. WU  
IN SUPPORT OF THIRD PARTY  
IPVALUE MANAGEMENT, INC.'S  
OPPOSITION TO GOOGLE, INC.'S  
AND YOUTUBE, LLC'S MOTION TO  
COMPEL PRODUCTION OF  
DOCUMENTS**

1 I, Andrew J. Wu, declare as follows:

2 1. I am a Vice President and Intellectual Property Counsel (“IP Counsel”) at  
3 IPVALUE Management, Inc. (“IPVALUE”). I submit this declaration in support of *IPVALUE’s*  
4 *Opposition To Google, Inc.’s and YouTube, LLC’s Motion To Compel Production of Documents*  
5 *from Third Party IPVALUE* (“Opposition”). I have personal knowledge of the facts set forth  
6 herein, and, if called upon to testify thereto, I am competent to do so and would do so.

7 2. IPVALUE is a patent licensing company that works with a select number  
8 of a handful of technology leaders, such as Xerox, British Telecom (BT), and NXP  
9 Semiconductors, to obtain a return on their R&D investments through commercialization of their  
10 patent portfolios.

11 3. In my capacity as IP Counsel for IPVALUE, I have been involved with  
12 IPVALUE’s production of discovery materials in response to other third party subpoenas. In  
13 addition, in my position, I am aware of IPVALUE’s general business practices and the impact on  
14 IPVALUE’s resources that are required to comply with subpoenas. I have carefully reviewed the  
15 document requests that are contained in the subpoena that was served on IPVALUE on or about  
16 November 11, 2011 by Google (“Subpoena”). Moreover, I am aware of the objections to the  
17 Subpoena that were served by IPVALUE on or about November 26, 2010. Since filing of  
18 Google’s motion to compel, I have been directly involved in the meet and confer discussions  
19 between Google and IPVALUE in order to narrow the issues, and I am personally aware to the  
20 remaining issues between the parties and the impact on IPVALUE that remains due to Google’s  
21 intransigence on those issues.

22 4. In my capacity as IP Counsel for IPVALUE, I am aware of the  
23 organization and the job duties of myself and IPVALUE’s other IP Counsel. IPVALUE is  
24 organized into certain groups. One group includes generally technical and financial specialists.  
25 One group focuses on license negotiations, whose members are typically designated as “Vice  
26 President, Licensing.” The Legal group focuses on providing legal advice to the company, and  
27 its members are designated as “Vice President, IP Counsel.” Their duties are to advise the  
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1 company regarding legal issues, such as patent infringement theories, and defenses to patent  
2 assertion.

3           5.       Because the entire function of an IP Counsel is to provide legal advice, a  
4 very high percentage of the data and documents of IPVALUE's IP Counsel will relate to advice  
5 and counseling to other IPVALUE personnel. Moreover, since it is these IP Counsels' job duty  
6 to provide legal advice – it would be necessary to perform an extremely thorough privilege  
7 review. I expect that we would have to collect and log well over 1000 documents. That process  
8 would be incredibly disruptive to IPVALUE. IPVALUE will not have the man-power resources  
9 to conduct such a privilege review or generate the privilege log without severely negatively  
10 impacting these individuals' job responsibilities. IPVALUE will have to hire the professional  
11 services of McMahon Serepca LLP to conduct the privilege review and prepare the privilege log.

12           6.       There is one IPVALUE attorney, Mr. Paul Riley, who was at one time a  
13 Vice President, IP Counsel, and is now a Vice President, Licensing. Because Mr. Riley has  
14 performed in both roles, IPVALUE has never sought to exclude his documents from collection  
15 or the privilege log.

16           7.       As an organization that focuses on patent licensing, IPVALUE deals with  
17 many, many patents. Some of the portfolios IPVALUE is working to commercialize include  
18 hundreds or thousands of patents. Because we deal with so many different patents, our  
19 communications will typically refer to the patent number of the patent at issue, as well as the  
20 name of client (such as Xerox, BT, or NXP). This is particularly true regarding a potential  
21 licensee, such as Google, that may be impacted by the patents of more than one client.

22           8.       IPVALUE has obtained one estimate relating to the cost of the  
23 professional services of an electronic discovery firm to harvest, cull, process, and prepare for  
24 attorney review the scope of documents demanded by the meet a confer efforts of Google.  
25 Depending upon the number of custodians ordered to produce, and the number of search terms  
26 imposed – a conservative estimate of the information for each custodian would subject  
27 IPVALUE to electronic discovery costs ranging between \$20,000 - \$35,000. Since IPVALUE is  
28 a 39-employee company, this expense would be significant. However, if the 59 search terms

1 proposed by Google are required – those costs could exponentially increase as the amount of  
2 data increases.

3 9. IPVALUE has produced all external communications regarding assertion  
4 of the patents in question to Xerox for its privilege review, and I am informed and believe that  
5 those documents have been (or will be shortly) produced on a rolling basis.

6 10. I have attached to this declaration a true and correct copy of an email  
7 string documenting most of the meet and confer since the February 3, 2001 teleconference in this  
8 matter.

9 I declare under penalty of perjury under the laws of the United States of America  
10 that the foregoing is true and correct. Executed in Mountain View, California on March 4, 2011

11   
12 \_\_\_\_\_  
13 Andrew J. Wu

## Andrew Wu

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**From:** David Perlson [davidperlson@quinnemanuel.com]  
**Sent:** Thursday, March 03, 2011 7:26 PM  
**To:** 'peter@mllp.com'; Andrew Wu; Andrea P Roberts  
**Subject:** RE: Xerox v. Google / subpoena to IPVALUE

Peter, I'm not sure that we are actually close to agreement.

Taking the last issue first, we are confused by Andrew's statement regarding commitments made by Cravath. Cravath served objections and responses to the subpoena Google served on IPValue as IPValue's counsel. In response to Google's document requests, IPValue (through its counsel) agreed to produce several categories of documents. (See Ex. F to the Declaration of Eugene Novikov in support of Google's Motion to Compel). Those requests were not the subject of Google's motion to compel because IPValue had already agreed to produce them. Similarly, Google has not been focusing on those documents during these negotiations because we assumed that IPValue was going to produce what it already committed to produce. Please confirm that IPValue's position as to these documents has not changed.

Regarding search terms, it is not clear whether IPValue is agreeing to Google's list. Can you please confirm that IPValue has agreed? Also, we did not receive response regarding the damages documents IP Value intends to withhold.

Finally, like DSC, IPValue's business is to analyze and investigate patents, including the '979 patent. Thus, when an employee of IPValue, even if an attorney, goes through the process of evaluating a patent and targets to assert that patent against, that is a business function and documents relating to that function are not privileged or work product. Based on your email below, it sounds like IPValue's in-house counsel are involved in these functions. If so, they should be included in the list of custodians whose files are searched. This is our position. Communications between Quinn and Google have nothing to do with this.

The parties have been negotiating these issues for several weeks now and Google has already granted IPValue a one-week extension to file its opposition. This is after Google spent time meeting and conferring with Cravath before filing its motion to compel. We cannot continue to delay resolution of this issue. Does IP Value need a full week to prepare a response to Google's motion to compel?

Thanks,

David

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**From:** Peter C. McMahon [mailto:peter@mllp.com]  
**Sent:** Thursday, March 03, 2011 4:08 PM  
**To:** 'Andrew Wu'; David Perlson; Andrea P Roberts  
**Subject:** RE: Xerox v. Google / subpoena to IPVALUE

Andrew, David,

From the sound of the last few emails, it seems that Google and IPValue are very close to an agreement – am I understanding that correctly?

Also, if IPValue is going to obtain the services of EDisc. Vendor – I will need until at least mid-week next week to get that in place, with the agreed to terms and custodians.

Can we stipulate to another week extension? If so, I'd like to get that on file ASAP – rather than surprising Magistrate Zimmerman again.

Please let me know.

Regards,

Peter

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**From:** Andrew Wu [mailto:andrew.wu@ipvalue.com]  
**Sent:** Thursday, March 03, 2011 3:56 PM  
**To:** David Perlson; Andrea P Roberts  
**Cc:** peter@mllp.com  
**Subject:** RE: Xerox v. Google / subpoena to IPVALUE

David,

Regarding excluding IPVALUE's IP counsel from the document collection and privilege log (as suggested by Judge Zimmerman), again, IPVALUE's in house counsel provide legal advice to the organization. In the context of patent licensing, they provide advice regarding the legal aspects of patent assertion; employees other than in house counsel address the business aspects. One exception is Paul Riley, who was previously in the VP IP Counsel role, and who is now a VP of Licensing; since his current role is a licensing role rather than a counsel role, we are not excluding him from the document collection or privilege log requirements. I don't want to misconstrue your e-mail, but if it is your position that no communications are privileged if they further the business goals of the client, please confirm -- that rule would apply to Google and Quinn Emmanuel's communications as well.

Regarding search terms, in light of Google's insistence on a large number of search terms, including Boolean terms, we believe an outside vendor will be required. We are looking into that option, as well as whether the cost will be reasonable.

Regarding Cravath's agreement with Google, I am not aware of any such agreement. IPVALUE has not asked Cravath to limit its production except for IPVALUE privilege.

I will take a look at the Protective Order.

Thanks,  
Andrew



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**From:** David Perlson [mailto:davidperlson@quinnemanuel.com]  
**Sent:** Wednesday, March 02, 2011 6:32 PM  
**To:** Andrew Wu; Andrea P Roberts  
**Cc:** 'peter@msslip.com'  
**Subject:** RE: Xerox v. Google / subpoena to IPVALUE

Andrew,

As we have previously stated, under the circumstances of this case and IPValue's relationship with Xerox, we do not believe that cost-shifting is warranted, and IP Value has not demonstrated otherwise.

To clarify what is meant by "business function" in this context, in Diagnostic Systems Corp. v. Symantec, the court explained that documents 'created when DSC employees were functioning in the capacity of business executives furthering the business goals of DSC,' were not privileged. On the other hand, documents created when employees were functioning primarily as attorneys representing DSC were privileged. Accordingly here, documents created by or communications with IPValue's in-house counsel that are in furthering the business goals of IPValue--in this context, for example, to license the '979 patent--are not privileged. Can IPValue represent that IPValue's counsel did not do work related to IP Value's attempts to license or otherwise enforce the '979 patent? If IPValue cannot make such a representation, then we cannot agree that IPValue need not search their files. If IPValue can we would be willing to table our request to search these individual's files for now, but we would retain our right to ask for their files to be searched if it later appears that they may have non-privileged documents.

Regarding search terms, please provide an update on IPValue's capability of running Boolean searches. Based on your email below, we would suggest adding "not Multimedia Patent Trust" or "not MPT" to the various search strings that might identify documents relating to that matter. As for the other suggested limitations of search terms, we do not agree to cut words like "complaint" as such documents may be responsive to Google's document requests. If they are, but IP Value asserts they are privileged, then they should be included on a privilege log. Further, the search terms proposed by Google are likely to identify responsive documents and IPValue has not suggested otherwise with any specific showing. We also do not see a reason to limit production to the time the complaint was filed. While we acknowledge that discovery as to damages has been bifurcated, we are not clear as to what you intend to exclude on that basis. For what requests does IPValue intend to withhold documents?

Finally, Cravath, acting as IPValue's counsel, already committed to producing certain categories of external communications. We expect that IPValue will live up to that commitment. As Cravath likely also informed you, we already have a protective order in this case (attached), which can be used by third parties.

David

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**From:** Andrew Wu [mailto:andrew.wu@ipvalue.com]  
**Sent:** Tuesday, March 01, 2011 5:46 PM  
**To:** David Perlson; Andrea P Roberts  
**Cc:** peter@msslip.com  
**Subject:** RE: Xerox v. Google / subpoena to IPVALUE

David,

Here are my responses to the points raised in your previous e-mail:

- Regarding cost shifting, we have proposed that Google share half of the costs, based on Judge Zimmerman's suggestion and relevant authority. Google has refused to share any of the costs. If Google is willing to pay any of IPVALUE's costs, please let me know.

- The IP Counsel at IPVALUE provide legal advice to the company. Although I'm not sure what you mean by a business function, the IP Counsel serve a legal, not business, function. In the corporate setting, many in house counsel have a Vice President title, and that title does not prevent them from providing legal advice to the company, or having those communications protected by the attorney-client privilege. Regarding your inquiry, we expect that there are over 1000 documents that would have to be logged. (Since this may end up being the largest component of IPVALUE's costs, this issue is somewhat tied to the cost-shifting issue). To date, Google has not agreed to limit collection on IPVALUE's in house counsel. Let me know if Google has changed position.
- Regarding search terms, Google has not agreed to drop any of its 59 proposed search terms. Let me know if your position has changed. We have proposed the search terms below because we believe they will encompass all non-privileged internal electronic documents stored in connection with the assertion of the '979 patent against Google and Yahoo. If there are a few more search terms (reasonable in scope), we are open to considering. Also, in response to your inquiry, IPVALUE has assisted in at least one other assertion against Google. That assertion involved Quinn Emanuel's client, the Multimedia Patent Trust (MPT). Again, we assume that Google has no interest in production of those documents.

As it stands, and without waiving any objections, IPVALUE's current proposal is as follows:

- Non-privileged external e-mail to Xerox relating to the assertion of the '979 patent against Google, Yahoo, and Right Media. This should encompass all external communications with Xerox regarding the assertion of the patent in suit, or regarding infringement assertions against the defendants in the patent case. We have already collected most of these documents, and are providing them on a rolling basis to Xerox's attorneys for review regarding Xerox confidentiality and privilege.
- External communications with Google and/or Yahoo relating to the assertion of the '979 patent. This should encompass communications regarding the patent in suit, Google and YouTube's infringement of the patents in suit, and the lawsuit.
- All other external communications relating to the assertion of the '979 patent sent to or from other companies against which IPVALUE/Xerox has asserted the '979 patent. This should encompass communications with other parties regarding the patent in suit.
- Non-privileged internal e-mail in the e-mail files of IPVALUE employees, other than in house counsel, that worked on the assertion of the '979 patent against Google and/or Yahoo/Right Media, that include the Search Terms. These employees were identified in Xerox's Initial Disclosures and/or Xerox's response to Google and YouTube's Interrogatory No. 4.
- IPVALUE organizes electronic documents in a document management system ("Worksite"). Non-privileged documents in the Worksite files relating to assertion of Xerox patents against Google and Yahoo that include the Search Terms. This should encompass all internal electronic documents stored in connection with the assertion of the '979 patent against Google and Yahoo.

The Search Terms are as follows:

6778979  
 979  
 Grefenstette  
 Shanahan  
 Xerox /20 patent  
 Organized classification of document content  
 Automatically identifying a set of entities  
 Automatically categorizing the selected document content  
 Automatically formulating the query to restrict a search



Formulat! /3 query  
DocSouls  
Document Souls  
XLP56  
XLP57  
XLP58

All of these categories would be filtered for false hits and privileged information. Also, documents relating to damages would not be included. Google agrees to pay for half of the out-of-pocket expenses of IPVALUE's production, including half of the fees to prepare any privilege log. The files and e-mails of IPVALUE's in house counsel (identified above) would not be searched or logged, nor would e-mails to IPVALUE's in house counsel. Also, the date cut-off will be the date of filing of the complaint. Finally, we'll need to work out a Protective Order regarding IPVALUE confidentiality.

If you have any other issues regarding IPVALUE's proposal, or any other suggestions that could help resolve this dispute, please let me know immediately. Obviously, time is short if we are going to keep to the current briefing schedule.

Thanks,  
Andrew



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**From:** David Perlon [mailto:davidperlon@quinnemanuel.com]  
**Sent:** Monday, February 28, 2011 1:26 PM  
**To:** Andrew Wu; Andrea P Roberts  
**Cc:** peter@msllp.com  
**Subject:** RE: Xerox v. Google / subpoena to IPVALUE

Andrew, see responses to your bullet points below:

- Regarding cost-shifting, my proposal was based on Judge Zimmerman's comment asking if cost-shifting would ease the burden on IPVALUE. His comment reflected the protections to third parties afforded by Rule 45 and the corresponding body of case law demonstrating that cost shifting is appropriate in circumstances such as ours. Indeed, it is highly likely that, for the expansive production Google seeks (which we have tried to accommodate), IPVALUE may have to rely on professional services to accomplish the harvesting and review of its data or suffer significant losses in employee productivity. I'm sure you are aware that such professional services can be very expensive. We understand (and we

believe Judge Zimmerman does too) that a certain amount of burden is appropriate for IPVALUE to bear as a cost of doing business. However, beyond that – it is only reasonable that the Subpoenaing Party should bear at least some of the expense.

Is it your position that you do not recall that part of the discussion, or that cost-shifting is unacceptable despite Judge Zimmerman’s comment? If it is the former, we may be able to get a transcript of the call.

I recall that Judge Zimmerman said that if IP Value asserted burden, it would need to make a detailed showing of burden to make such an objection, and that one possible way of addressing such a burden could be cost-shifting. There was no ruling that it would be appropriate here and Google’s position remains that it is not for the reasons previously stated.

While IP Value is free to seek to obtain a transcript of the call, we continue to believe it will not reveal anything inconsistent with Google’s position.

- Regarding exclusion of in house counsel, we would exclude the following:

Steve Shin, VP and IP Counsel

Sanjay Prasad, VP and IP Counsel (former employee)

Mitch Rosenfeld, VP and IP Counsel (former employee)

Keith Wilson, Sr. VP, Legal

Although I do not know exactly what documents were at issue in the *DSC* case, our situation is very different. The *DSC* opinion describes a management team of 5 attorneys who functioned both as attorneys and as corporate executives. IPVALUE is a larger organization with a defined legal group, comprised of IP counsel, whose role is to provide legal advice.

Is it IP Value’s position that the above individuals have no business role with IP Value at all? Each one of the individuals you list is a vice-president, not just counsel—just like in *DSC*. Also, do you have a sense of the volume of emails these individuals would have been involved in relating to the ‘979 patent? It would seem that before you exclude them entirely from a search it would be appropriate to have some idea of the volume of materials you seek to avoid reviewing to understand the burden you are asserting.

- Regarding search terms, your list of 60 proposed searches, is unworkable and would encompass many documents that have nothing to do with Xerox’s suit against Google and Yahoo. As Google is well aware, IPVALUE has been involved in assertion of patents against Google involving patent-owners other than Xerox. Documents relating to those assertions, or relating to Xerox assertions (or possible assertions) of patents unrelated to the patent in suit in your case. Let me know if you disagree. Further, search terms that are expressly directed toward privileged communications (such as “complaint” or “lawsuit”) will only needlessly increase the privilege log. Also, at the moment, we have no way of running Boolean searches on the documents, although we are working on a solution.

I was not aware that IPVALUE has been involved in assertion of other patent owners against Google. How many such assertions have there been such that you think the “Google” terms will bring up a number of irrelevant documents. I do not agree, however, that words such as complaint or lawsuit are expressly directed toward privileged communications. Nor do I see how it would “needless” increase the privilege log, which is supposed to log responsive and privileged documents. If they are not responsive, they do not need to be logged. If they are responsive, they should be. Please update on Boolean searching. Obviously, that can be a useful way of limiting search terms.

We look forward to your responses to above.

David

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**From:** David Perlson [mailto:davidperlson@quinnemanuel.com]  
**Sent:** Wednesday, February 23, 2011 3:25 PM  
**To:** David Perlson; Andrew Wu  
**Cc:** Andrea P Roberts  
**Subject:** RE: Xerox v. Google / subpoena to IPVALUE

Andrew, one thing I forgot to mention. Please let us know if IP Value used any shorthand, abbreviations, or codes to refer to anything that might be relevant to subpoena—i.e. codes for Google, Yahoo!, '979 patent, etc ... If so, we would like them added to the search terms as well.

Thanks

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**From:** David Perlson  
**Sent:** Wednesday, February 23, 2011 3:15 PM  
**To:** David Perlson; 'Andrew Wu'  
**Cc:** Andrea P Roberts  
**Subject:** RE: Xerox v. Google / subpoena to IPVALUE

Andrew, below is a list of suggested search terms. Please let us know your thoughts. Also, please respond to my inquiries below.

Thanks

6778979  
979  
Grefenstette  
Shanahan  
Xerox /20 patent  
(Google or Yahoo!)/5 "prior art"  
Organized classification of document content  
Automatically identifying a set of entities  
Automatically categorizing the selected document content  
Automatically formulating the query to restrict a search  
Formulat! /3 query  
AdSense for Content  
Content Ads  
AFC  
(Google or Yahoo!) w/10/prior art/  
(Google or Yahoo!) w/10 979  
(Google or Yahoo!) w/10 automat\*  
(Google or Yahoo!) w/10 complaint\*  
(Google or Yahoo!) w/10 court\*  
(Google or Yahoo!) w/10 generat\*  
(Google or Yahoo!) w/10 infring\*  
(Google or Yahoo!) w/10 investigat\*  
(Google or Yahoo!) w/10 Xerox  
(Google or Yahoo!) w/10 judg\*  
(Google or Yahoo!) w/10 law  
(Google or Yahoo!) w/10 laws

(Google or Yahoo!) w/10 lawsuit\*  
(Google or Yahoo!) w/10 lawyer  
(Google or Yahoo!) w/10 legal\*  
(Google or Yahoo!) w/10 patent\*  
(Google or Yahoo!) w/10 quer\*  
(Google or Yahoo!) w/10 sue  
(Google or Yahoo!) w/10 sued  
(Google or Yahoo!) w/10 sues  
(Google or Yahoo!) w/10 suit  
(Google or Yahoo!) w/10 violat\*  
(Google or Yahoo!) w/25 licens\*  
(Google or Yahoo!) w/25 offer\*  
(Google or Yahoo!) w/25 proposal\*  
(Google or Yahoo!) w/5 case  
(Google or Yahoo!) w/5 cases  
(Google or Yahoo!) w/5 content\*  
(Google or Yahoo!) w/5 context\*  
(Google or Yahoo!) w/5 exchang\*  
(Google or Yahoo!) w/5 market\*  
(Google or Yahoo!) w/ match\*  
(Google or Yahoo!) w/ matter\*  
(Google or Yahoo!) w/5 network  
Content Match  
Y!Q  
Contextual Search  
Right Media  
RMX  
Yahoo! Publisher Network  
Yahoo! Search Marketing  
DocSouls  
Document Souls  
XLP56  
XLP57  
XLP58

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**From:** David Perison  
**Sent:** Tuesday, February 22, 2011 10:53 AM  
**To:** 'Andrew Wu'  
**Cc:** Andrea P Roberts  
**Subject:** RE: Xerox v. Google / subpoena to IPVALUE

Andrew, as we indicated, under the circumstances of IP Value's involvement in this case we do not believe cost shifting to Google is warranted and that remains our position. I don't think that position is inconsistent with anything Judge Zimmerman said. If you are referring to something specific from the call let me know.

Regarding the second point, can you please identify the in-house counsel who you would like to preclude from the search. As made clear in the attached opinion, the mere status of someone as an attorney does not alone render them immune to discovery. Can IP Value represent that none of the in house counsel you seek to exclude from searching have any documents of the type that were found to not be privileged in the attached case?

Regarding search terms, we will come up with a counter-proposal.

David

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**From:** Andrew Wu [mailto:andrew.wu@ipvalue.com]  
**Sent:** Thursday, February 17, 2011 4:17 PM  
**To:** David Perlson  
**Cc:** Andrea P Roberts  
**Subject:** RE: Xerox v. Google / subpoena to IPVALUE

David,

Regarding cost-shifting, it was Judge Zimmerman's suggestion that cost-shifting could ease the burden on IPVALUE. We are willing to be reasonable, of course. The most burdensome part of the out of pocket expense could well be preparation of a privilege log (depending on the scope of such a log). We may be willing to limit our request for cost-shifting to the privilege log.

I proposed to limit collection regarding IPVALUE's in house legal counsel, i.e., those whose job is to provide legal advice to the company. Some of our other employees are attorneys and/or have legal degrees, but their roles relate to, for example, negotiations, or technical analysis. Their documents would be collected (although we would still review for privilege). We are not trying to over-exclude.

For e-mails to/from Xerox, I proposed searching for 979 or Google, Yahoo, or Right Media; for the other categories, I believe that searching for 979 will capture the relevant documents. If documents existed regarding assertion of patents other than the patent-in-suit, or that had no connection to patent assertion, they would not be even arguably relevant. If there are other search terms that you think would be reasonable, please let me know.

Regards,  
Andrew



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**From:** David Perlson [mailto:davidperlson@quinnemanuel.com]  
**Sent:** Tuesday, February 15, 2011 7:00 PM  
**To:** Andrew Wu  
**Cc:** Andrea P Roberts; David Perlson  
**Subject:** RE: Xerox v. Google / subpoena to IPVALUE

Andrew, given your response, your suggestion that Google should foot the bill is not acceptable. It is also not consistent with Cravath's prior representations that certain documents would be collected and produced without mention of such

cost-shifting. To be clear, is it IP Value's position that no documents will be produced unless Google agrees to pay out of pocket costs?

Further, while I think we need more information to understand it, it seems your proposal is unduly limiting. Who do you intend to exclude that has done work regarding the 979 patent? As you know, merely because someone is a lawyer does not make a communication or document authored by them privileged.

Also, is your suggestion that you would be searching only for documents or email using the number 979? Although this discussion should have occurred long ago, we are willing to discuss reasonable terms for searching documents. This single term does not seem reasonable.

Thanks,

David

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**From:** Andrew Wu [mailto:andrew.wu@ipvalue.com]  
**Sent:** Tuesday, February 15, 2011 4:45 PM  
**To:** David Perlson; Andrea P Roberts  
**Subject:** RE: Xerox v. Google / subpoena to IPVALUE

David,

The details of our relationship with Xerox are confidential. I can say that IPVALUE typically works on a success-fee basis. I do not believe that IPVALUE has been compensated for its work on this litigation. Could you provide a response to my proposal regarding the document production?

Thanks,  
Andrew

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INTELLECTUAL PROPERTY COUNSEL  
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**From:** David Perlson [mailto:davidperlson@quinnemanuel.com]  
**Sent:** Tuesday, February 15, 2011 11:34 AM  
**To:** David Perlson; Andrew Wu; Andrea P Roberts  
**Subject:** RE: Xerox v. Google / subpoena to IPVALUE

Andrew, following up on our inquiry here.

Thanks,

David

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**From:** David Perlson  
**Sent:** Thursday, February 10, 2011 2:17 PM  
**To:** Andrew Wu; Andrea P Roberts  
**Subject:** Re: Xerox v. Google / subpoena to IPVALUE

Andrew we will review and get back to you. One threshold issue we would like an answer on is does IP value hold any interest based on the outcome of this litigation. If not has it been compensated by Xerox in connection with the work it has done or is currently doing relating to the patent. These inquiries are relevant to IP values claims of burden. Thanks

Andrew Wu wrote:  
Hi Dave,

Per my voicemail, we have been trying to identify a reasonable scope of production that will capture the documents Google seeks. Without waiving any objections, we think something along the lines of the following may work:

- Non-privileged external e-mail to Xerox that include the number 979, or that include the terms Google, Yahoo, or "Right Media." This should encompass all external communications with Xerox regarding the assertion of the patent in suit, or regarding infringement assertions against the defendants in the patent case.
- External communications with Google and/or Yahoo that include the number 979. This should encompass communications regarding the patent in suit, Google and YouTube's infringement of the patents in suit, and the lawsuit.
- All other external communications that include the number 979 sent to or from other companies against which Xerox had asserted the '979 patent. This should encompass communications with other parties regarding the patent in suit.
- Non-privileged internal e-mail in the e-mail files of IPVALUE employees, other than in house counsel, that worked on the assertion of the '979 patent against Google and/or Yahoo/Right Media, that include the number 979. These employees were identified in Xerox's Initial Disclosures and/or Xerox's response to Google and YouTube's Interrogatory No. 4.
- IPVALUE organizes electronic documents in a document management system ("Worksite"). Non-privileged documents in the Worksite files relating to assertion of Xerox patents against Google and Yahoo that include the number 979. This should encompass all internal electronic documents stored in connection with the assertion of the '979 patent against Google and Yahoo.

All of these categories would be filtered for false hits and privileged information. Also, documents relating to damages would not be included. Google agrees to pay for the out-of-pocket expenses of IPVALUE's production, including the fees to prepare any privilege log. The files and e-mails of IPVALUE's in house counsel would not be searched or logged, nor would e-mails to IPVALUE's in house counsel.

Please let me know your thoughts.

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