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UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA

GOOGLE INC. AND YOUTUBE LLC,
 Plaintiffs,
 v.
 IPVALUE MANAGEMENT INC.
 Defendant.

CASE NO. 3:11-MC-80016-RS
**GOOGLE INC.'S RESPONSE TO
 IPVALUE'S DECLARATIONS IN
 RESPONSE TO GOOGLE'S MOTION TO
 COMPEL**

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Pursuant to this Court’s March 31, 2011 Minute Order, Plaintiff Google Inc. (“Google”) respectfully files this response to the declarations of Keith Wilson, Steve Shin, Mitchell Rosenfeld, and Sanjay Prasad in opposition to Google’s Motion to Compel.

I. IPVALUE’S DECLARATIONS SUPPORT GOOGLE’S MOTION TO COMPEL.

Notwithstanding the conclusory statements to the contrary throughout, the declarations submitted by IPValue support Google’s position that the files of Wilson, Shin, Rosenfeld, and Prasad should be searched in response to Google’s subpoena for production of documents by IPValue. These declarations do not meet IPValue’s burden of establishing that each custodian wore only a “legal hat,” such that he is not likely to have responsive, non-privileged documents. To the contrary, it is evident that their files are very likely to include documents that should be produced to Google.

First, Keith Wilson, Steve Shin, and Sanjay Prasad each testified that they were present at meetings with Google and/or on calls with Google regarding licensing and Xerox’s patent assertion against Google, and that they assisted in preparation for those meetings. (Wilson Dec., ¶ 14; Shin Dec., ¶ 3; and Prasad Dec., ¶ 3.) Prasad testified that he was at these meetings “to explain legal positions and answer legal questions from Google’s team.” (Prasad Dec., ¶ 4.) In other words, each of these individuals sat across the table from Google in licensing discussions. Their assistance in preparing for these meetings, including discussions about what to say to Google at these meetings and what strategy to take in these licensing negotiations, are not privileged. They are in furtherance of IPValue’s business objective of enforcing the ‘979 patent.

Second, although Wilson, Shin, and Prasad each testified that they provided legal advice regarding patent assertions and counter-arguments, this information is also in furtherance of IPValue’s business objectives. For example, although Wilson, Shin, and Prasad testified that they advised IPValue regarding Google and/or Yahoo!’s alleged infringement of the patent and the counter-arguments made by Google (Wilson Dec., ¶ 14; Shin Dec., ¶ 3; and Prasad Dec., ¶ 4), such work is a business function. The same is true of Shin’s documents relating to claim construction, invalidity, and damages. (See Shin Dec., ¶ 6.) For a licensing company like

1 IPValue, identifying patents to acquire and targets to assert them against, assessing the value of
2 patents, and developing assertion plans, are its business. Thus, it is not appropriate for IPValue to
3 make blanket privilege assertion as to all of them. (*See* Exhibit 1 to Google’s Reply Brief
4 (*Diagnostic Systems Corp. v. Symantec Corp.*), at 10 (“These functions are clearly business
5 functions, and documents resulting from these functions cannot be categorized in sweeping
6 assertions of privileges and protection in order shield [sic] the documents from discovery simply
7 because [the author] is a lawyer”)).

8 Third, Rosenfeld’s sparse declaration does not explain what kinds of tasks he performed.
9 (Rosenfeld Dec., ¶ 4.) He simply states that “all work he recalls performing in relation to Google
10 Inc. or Yahoo, Inc. involved providing legal advice and services to IPVALUE.” (*Id.*) In the
11 context of IPValue’s business, this does not given Google and the Court any indication as to the
12 specific tasks Rosenfeld perceives to be “legal advice and services.”

13 Based on the above, the four declarations filed by IPValue fail to establish that each
14 custodian solely wore a “legal hat” such that their files should not be searched for documents
15 responsive to Google’s proper subpoena. The simple fact that the custodians’ files include
16 privileged communications does not mean that they do not also include non-privileged, responsive
17 documents and their declarations suggest that they do. IPValue should be ordered to search for
18 and produce such documents.

19 **II. IPVALUE’S DECLARATIONS ARE OBJECTIONABLE.**

20 In addition to supporting Google’s Motion to Compel, several portions of the IPValue
21 declarations are objectionable and contain irrelevant information. For example, Wilson’s
22 testimony about what the other custodians did should be disregarded because he lacks personal
23 knowledge of the specific tasks each of the other custodians performed. (Wilson Dec. ¶¶ 10-11.)
24 With respect to Rosenfeld, Shin, and Prasad’s work, this Court should look to their own
25 declarations, not Wilson’s.

26 Paragraphs 17-19 of the Wilson Declaration are irrelevant. Paragraph 17 references an
27 invoice received from Xerox’s counsel; that is for work reviewing “external communications” that
28 Xerox agreed to produce and were thus not the subject of Google’s Motion to Compel.

1 Paragraphs 18-19 seem to be an attempt to articulate the burden of searching these four
2 custodians' files. But, paragraph 18 discusses an invoice for searching and processing the files of
3 other custodians, not the four who submitted declarations. Even with this notice, the cost of
4 searching in-house counsel's files cannot be calculated because IPValue does not indicate what the
5 volume is of each custodian's files. Nor is IPValue's conclusion about the overall cost supported.
6 IPValue estimates that 50% of the volume will be reduced by the search terms, but it does not
7 provide any basis for that conclusion. For example, IPValue did not run test searches to determine
8 the percentage of documents likely to be culled out by those search terms, many of which will
9 include filters to exclude documents relating to other matters on which IPValue is working. It is
10 entirely possible that these searches, particularly with the filters in place, will greatly reduce the
11 volume of documents that must be reviewed.

12 For the foregoing reasons, this Court should order IPValue to search the files of Wilson,
13 Shin, Prasad, and Rosenfeld for non-privileged documents responsive to Google's subpoena.

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DATED: April 8, 2011

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