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June 24, 2011

The Honorable Leonard P. Stark
United States District Court
844 North King Street
Wilmington, DE 19801

PUBLIC VERSION
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Re: *Personalized User Model, L.L.P. v. Google, Inc.*
C.A. No. 09-525 (LPS)

Dear Judge Stark:

We write in advance of the June 29, 2011 teleconference (D.I. 284) and in response to Google Inc.'s ("Google") request to compel Personalized User Model, L.L.P. ("PUM") to disclose attorney work-product and privileged communications among counsel and the inventors of the patents-in-suit. At the May 5, 2011 deposition of Inventor Roy Twersky, Your Honor permitted Google to conduct a narrow inquiry into his meetings with counsel on January 19 and February 7, 2011, which concerned the conception date of the patents. Your Honor also ruled that "[i]f after that testimony comes out plaintiff thinks it still has a proper basis to direct the witness not to answer other questions due to privilege, plaintiff can give that instruction...." (Ex. A, 295:11-14). PUM has fully complied with the Court's Order.[1] Nevertheless, Google now seeks to compel the disclosure of work product and privileged communications in the months

[1] Even before the Court ruled, PUM had offered the testimony of the inventors as a compromise provided that Google would not seek a broader subject matter waiver but Google rejected that compromise. Mr. Twersky responded to Google's questions regarding the meetings. (Ex. A, 297:10-19). Google's counsel posed further inquiries regarding communications that took place outside of the meetings themselves. Counsel for PUM asserted privilege and advised that: "I'm willing to work with you to help you get testimony that lets you understand what happened at the meeting and why. But I don't want to be in a position where if I let [Mr. Twersky] answer this, then I get an argument from you, counsel, that we've waived the subject matter, because that's not what the Court ruled." (Ex. A, 298:8-17, 298:22-299:3). Google refused not to assert subject matter waiver, however.

before those two meetings. That request to expand the scope of the Court's ruling should be denied.

Google suggests a conspiracy theory of sorts as the sole basis for its expanded request. According to Google, counsel and the inventors took an "about face" concerning the date of conception after learning that Google had purchased the perceived rights of SRI in the work of Inventor Konig. Google's theory, based on mere supposition, is fatally flawed because it ignores at least the following key facts:

First, Google did not assert that it had ownership of the perceived SRI rights until *after* counsel and the inventors had already met to discuss the legal meaning of conception on January 19, 2011. Google *for the first time* provided notice to PUM that it had purchased the perceived SRI rights later that evening only after that meeting had occurred.[2] Indeed, Mr. Twersky testified at his May 5 deposition REDACTED

REDACTED

Based upon this timing alone, it is impossible that things are as Google supposes.[4]

Second, Inventor Konig has never wavered on his testimony about the date of conception. He testified on December 2, 2010 -- long before Google's disclosure of its purchase of the perceived SRI rights -- REDACTED

REDACTED He also later testified REDACTED

REDACTED Notwithstanding that Mr. Konig's testimony about conception has never changed, PUM has agreed to make Mr. Konig available for deposition to testify about the meetings with counsel on conception.

Third, neither SRI (nor Mr. Konig as its employee) performed work on what is claimed in the patents-in-suit during or as part of Mr. Konig's employment by SRI. In its response to a

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2 (Ex. B, Email with Letter from Eugene Novikov transmitting Google's letter notifying PUM of its purchase and seeking to Amend Answer to assert counterclaims).

3 (Ex. A, 310:12-15; 442:20-443:2; 444:5-20).

4 The conception confusion arose on or about December 1 after Mr. Twersky testified at deposition REDACTED (Ex. C 109:6-110:16). PUM would have met to clarify conception even earlier than January 19 but *Markman* preparation, tutorial and hearings intervened and Mr. Twersky was out of the country.

5 (Ex. D, 151:4-152:7; Ex E, 392:7-14, 420:10-11).

Subpoena requesting documents and testimony reflecting any work performed by SRI prior to Mr. Konig's last day of employment at SRI relating to "providing personalized information services to computer users through the use of machine learning" (*i.e.*, the subject of the patents), SRI responded that it had no such documents and could not provide any such testimony.[6]

Fourth, PUM has produced all documents relevant to the conception and reduction to practice of the patented inventions, including, but not limited to, all of the documents that the two inventors considered and reviewed during the two meetings with counsel.[7]

PUM's' good faith supplementation and clarification of its interrogatory responses should not be permitted to serve as a basis to discover the underlying privileged communications. Compelling production of such communications would have an unintended chilling effect on candid communications between attorneys and clients. *See In re Teleglobe Communications Corp.*, 493, F.3d 345, 360 (3rd. Cir. 2007); *WebXchange Inc. v. Dell Inc.*, 264 F.R.D. 123, 126 (D. Del. 2010). Communications between attorneys and clients along with related work product should remain privileged, even when leading to amended answers. *In re Joy Global, Inc.*, 2008 WL 2435552, at *5 (D. Del. June 16, 2008) ("disclosure that an attorney approved a course of conduct, does not waive the privilege otherwise attaching to communications between an attorney and client on the subject of the consultation"); *see also Lee National Corp. v. Deramus*, 313 F.Supp. 224 (D. Del. 1970) (requiring defendant to identify certain occasions on which particular subjects were discussed with counsel but refusing to extend the privilege beyond that limited waiver).

PUM has not, as Google suggests, asserted privilege as a sword. Rather, PUM asserts privilege as a shield only, and in the most ordinary of ways. Accordingly, PUM respectfully requests that the Court deny Google's request for disclosure of work product and privileged communications exchanged in the months before the two meetings between counsel and the inventors.

Respectfully,

/s/ Karen Jacobs Louden

Karen Jacobs Louden (#2881)

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6 (Ex. F at 4, SRI Response to RFP No. 1; Ex. G, SRI Response to Notice Topic No. 1).

7 (Ex. H).

KJL/cht
cc: Clerk of the Court (by hand)
All Counsel of Record (via e-filing and/or e-mail)

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