IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

PERSONALIZED USER MODEL, L.L.P., Plaintiff,	)	
v.	)	C.A. No. 09-525-LPS
GOOGLE INC., Defendant.	)	**JURY TRIAL DEMANDED**
GOOGLE, INC. Counterclaimant,	)	**PUBLIC VERSION**
v.	)	
PERSONALIZED USER MODEL, LLP and YOCHAI KONIG Counterdefendants.	)	

LETTER TO THE HONORABLE LEONARD P. STARK
FROM RICHARD L. HORWITZ

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cc: Clerk of the Court (via hand delivery)
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July 21, 2011

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

PUBLIC VERSION

Re: *Personalized User Model, LLP v. Google Inc.*, C.A. No. 09-00525-LPS

Dear Judge Stark:

Pursuant to the Court's July 18, 2011 Order, Defendant Google Inc. ("Google") respectfully files this letter brief, requesting that the Court order PUM to produce documents being withheld that are within the scope of the Court's June 29, 2011 Order regarding Google's motion to compel.

The Court ordered PUM to produce written communications with counsel concerning conception and other subjects. After the Court's previous order during the deposition of named inventor Roy Twersky that PUM must allow the named inventors to testify regarding the January 19 and February 7 meetings with counsel concerning conception, Google sought similar written communications concerning conception, the subject matters discussed at those meetings, and PUM's preparation of its Fourth Supplemental Response to Interrogatory No. 1. PUM refused. As detailed in Google's June 23 letter brief to the Court, these communications are relevant and appropriately discoverable because PUM is relying on communications between the inventors and counsel as a basis for changing the conception date of the patent-in-suit, which was already recognized by the Court as a critical issue in this case in its prior ruling during the Twersky deposition.

At the hearing, the Court found that "there has been a limited waiver of attorney-client privilege and work product protection as well, and it results from the change in the testimony and interrogatory responses on the important issue of the date of conception regarding the invention and subject in the patents in suit." (Ex. 1, June 29, 2011 Tr. at 16:4-9.) Specifically, the Court noted that, as it had previously held during the deposition, "Google is entitled to some discovery on the reasons for that changed testimony given that the contention from PUM is that the testimony changed at least in part as a result of the participation and input and discussion with counsel and information provided by counsel to the inventors." (*Id.* at 16:10-14.) Accordingly, the Court ordered PUM to "produce the written communications between counsel and the inventors relating to the scheduling of the January 19th and the February 7th meetings and the subjects discussed at those meetings to the extent those subjects relate to conception and the changed testimony or changed interrogatory responses relating to the date of conception." (*Id.* at

16:24-17:5.) The Court denied Google's request to compel communications regarding PUM's preparation of its Fourth Supplemental Response to Interrogatory No. 1, finding it "simply goes too far in reaching into attorney work product." (*Id.* at 17:6-10.)

PUM produces some, but not all, documents the Court ordered produced. On July 1, PUM produced 10 emails pursuant to the Court's Order. Google promptly expressed its concern to PUM that PUM's production was incomplete because it did not include all of the documents listed on PUM's June 10 privilege log concerning the documents in dispute. (Ex. 2; *see also* Ex. 4 (privilege log).) Specifically, the log contained nine entries on February 8, but PUM only produced one of those withheld documents. Notably, each of these entries were identical: "E-mail from attorney to client made in preparation and reflecting the substance of a confidential communication regarding ongoing litigation." And PUM claimed only attorney-client privilege, not work product protection, as to each of the documents in the log that PUM still did not produce.

PUM has indicated it is still withholding these 8 emails because they fall into a third category of Google's requests—communications regarding PUM's preparation of its Fourth Supplemental Response to Interrogatory No. 1—production of which the Court denied. (Ex. 2.) Despite Google's repeated requests, however, PUM has refused to confirm that that these documents do not also relate to conception and the changed testimony or changed interrogatory responses relating to the date of conception, which the Court specifically did compel.

PUM is improperly withholding the remaining documents on the log. While the Court did not grant the entirety of Google's request, the Court did grant Google's request for communications concerning conception and the changed testimony or changed interrogatory responses relating to the date of conception. Thus, to the extent the withheld communications concern these subjects, PUM must produce them.[1]

Nevertheless, PUM seems to be arguing that because these documents also concern the preparation of the fourth supplemental interrogatory response, they need not be produced at all. But when presented with this very issue at the June 29 hearing, the Court found to the contrary. In response to a question from PUM's counsel seeking clarification on the Court's ruling, the

[1] In the parties' July 13 meet and confer, PUM suggested that the Court's ruling was somehow limited to communications between the January 19 and February 7 meetings that were at issue at the May 4 teleconference during Twerksy's deposition. But at the telephonic hearing on Google's motion, the Court asked Google for clarification of the time period for which Google sought documents. Google specifically indicated the timeframe of documents sought was between December 2, 2010 (Konig's deposition) and February 8 (the supplemented interrogatory response), and the Court did not place any further time limitation in its ruling. (Ex 1. at 9:2-16.) The Court also asked why Google was seeking communications regarding "all of the subjects" discussed at the meetings. (*Id.* 9:17-21.) Google clarified it was seeking communications on "all of the subjects regarding conception and the change in interrogatory response." (*Id.* 9:22-24.)

Court noted that "certainly we did not discuss what to do about a communication that falls within Category A and not Category C." After hearing further argument, the Court held as follows:

> I agree with Mr. Nelson on this one. I am drawing a line between attorney-client privilege and work product, and the defendant has every iteration that has been filed of the interrogatory response and can see and can show, for instance, to a jury how those interrogatory responses changed. The defendant further had, and will have, additional discovery as to communications between the attorneys and the inventors relating to the meetings around the time of the preparation of the supplemental interrogatory. So to the extent that drafts of the supplemental interrogatory response are attached to an e-mail, for instance, relating to the scheduling of the meeting, that attachment need not be produced under my order today.

(Ex. 1 at 19:25-20:12 (emphasis added).) In other words, where there is a document that concerns both the preparation of the fourth set of interrogatories, which the Court did not allow, and also subject matter upon which the Court did order produced, PUM may withhold work product of the draft interrogatories themselves. Given that PUM's log does not assert work product for any of the logged, but still withheld documents, that Google seeks, that aspect of the ruling is inapplicable.

Google is mindful that the Court indicated at the June 29 hearing that it did not want to revisit this issue or allow more discovery on this topic. Google, however, raises the instant dispute not to allow more discovery, but rather to obtain the discovery the Court already ordered PUM to provide. Indeed, the previously withheld documents PUM did produce show just how important the documents at issue are in this case. For example, PUM has suggested that the change in its interrogatory response on conception is unrelated to SRI ownership rights to the patents-in-suit. In its June 24 letter brief, PUM stated that Mr. Twersky testified at his May 5 deposition [redacted] (D.N., 289 at 2.) Yet, one of the documents PUM produced pursuant to the Court's Order is a January 30, 2011 email between those meetings among Konig, Twersky, and PUM's counsel discussing SRI precisely in the context of conception:

REDACTED

(Ex. 3 (highlighting added)). This email strongly suggests that SRI was likely also discussed at one or both of these meetings in connection with conception, contrary to Twerksy's testimony and PUM's representations to the Court. At a minimum, it shows that the SRI ownership issue, and the relevance of the conception date thereto, was on everyone's mind before PUM changed its interrogatory response on the conception date. Google respectfully requests that PUM be

ordered to produce remaining withheld documents so it may obtain the complete discovery on this issue already ordered by the Court and that is critical to this case.

Respectfully,

/s/ Richard L. Horwitz

Richard L. Horwitz (#2246)

RLH/nmt/1021930/34638
PUBLIC VERSION DATED: July 28, 2011

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