

# EXHIBIT J

**quinn emanuel trial lawyers | silicon valley**

555 Twin Dolphin Drive, 5th Floor, Redwood Shores, California 94065-2139 | TEL: (650) 801-5000 FAX: (650) 801-5100

WRITER'S DIRECT DIAL NO.  
**(650) 801-5023**

WRITER'S INTERNET ADDRESS  
**andreaproberts@quinnemanuel.com**

April 23, 2011

**VIA EMAIL**

Scott Leslie  
Cravath Swaine & Moore LLP  
Worldwide Plaza  
825 Eighth Ave.  
New York, NY 10019

Re: *Xerox Corp. v. Google Inc. et al.*, C.A. No. 10-136-LPS-MPT

Dear Scott:

Google would like to depose the current or former Xerox employees listed below. Please confirm by April 28, 2011 that you can accept service of deposition notices and/or subpoenas on behalf of each of the following individuals:

- Mathieu Chuat
- Michel Gastaldo
- Laurance Hubert
- Yutaka Yamauchi

Very truly yours,



Andrea Pallios Roberts

**quinn emanuel urquhart & sullivan, llp**

LOS ANGELES | 865 South Figueroa Street, 10th Floor, Los Angeles, California 90017-2543 | TEL (213) 443-3000 FAX (213) 443-3100  
NEW YORK | 51 Madison Avenue, 22nd Floor, New York, New York 10010-1601 | TEL (212) 849-7000 FAX (212) 849-7100  
SAN FRANCISCO | 50 California Street, 22nd Floor, San Francisco, California 94111-4788 | TEL (415) 875-6600 FAX (415) 875-6700  
CHICAGO | 500 W. Madison Street, Suite 2450, Chicago, Illinois 60661-2510 | TEL (312) 705-7400 FAX (312) 705-7401  
LONDON | 16 Old Bailey, London EC4M 7EG, United Kingdom | TEL +44(0) 20 7653 2000 FAX +44(0) 20 7653 2100  
TOKYO | NBF Hibiya Bldg., 25F, 1-1-7, Uchisaiwai-cho, Chiyoda-ku, Tokyo 100-0011, Japan | TEL +81 3 5510 1711 FAX +81 3 5510 1712  
MANNHEIM | Erzbergerstraße 5, 68165 Mannheim, Germany | TEL +49(0) 621 43298 6000 FAX +49(0) 621 43298 6100

# **EXHIBIT K**

## Andrea P Roberts

---

**From:** Andrea P Roberts  
**Sent:** Monday, May 09, 2011 6:11 PM  
**To:** Scott Leslie  
**Cc:** 'ahale@cravath.com'; 'aharasymiak@cravath.com'; AMayo@ashby-geddes.com; 'Fenwick, Anthony I.'; 'Lisson, David'; 'Moore, David E.'; Google-Xerox; jblumenfeld@mnat.com; jday@ashby-geddes.com; lmaguire@ashby-geddes.com; Matthew Cannon; mnoreika@mnat.com; 'Horwitz, Richard L.'; 'Richard Stark'  
**Subject:** RE: Xerox v. Google

Scott,

Is it possible to schedule Mr. Chuat and Mr. Gastaldo's depositions in the same week so that we can avoid multiple trips to New York?

Additionally, Defendants would like to depose Christer Fernstrom. Please confirm that you can accept service of a deposition notice and/or subpoena on his behalf and, if so, provide dates on which he is available for deposition.

### Andrea Pallios Roberts

Quinn Emanuel Urquhart & Sullivan, LLP

555 Twin Dolphin Drive, 5th Floor  
Redwood Shores, CA 94065  
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650.801.5000 Main Office Number  
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**From:** Scott Leslie [mailto:SLeslie@cravath.com]  
**Sent:** Friday, May 06, 2011 9:20 AM  
**To:** Andrea P Roberts  
**Cc:** 'ahale@cravath.com'; 'aharasymiak@cravath.com'; AMayo@ashby-geddes.com; 'Fenwick, Anthony I.'; 'Lisson, David'; 'Moore, David E.'; Google-Xerox; jblumenfeld@mnat.com; jday@ashby-geddes.com; lmaguire@ashby-geddes.com; Matthew Cannon; mnoreika@mnat.com; 'Horwitz, Richard L.'; 'Richard Stark'  
**Subject:** RE: Xerox v. Google

Andrea -

As you know, Mr. Chuat and Mr. Gastaldo live in France. Consequently, a deposition in New York will entail a considerable commitment of time and effort from both of them. After reviewing their personal and professional obligations over the next few months, they have each indicated that it would be difficult to schedule their depositions earlier.

In addition, Mr. Chuat has double-checked his schedule and will not be available for a deposition in New York until June 22-24, as opposed to June 15 as I stated in my prior email. We also have heard from Mr. Gastaldo, who would be available for a deposition in New York until June 29-30.

Please let us know soon which day between June 22 and 24 works for Defendants' deposition of Mr. Chuat, and which day between June 29-30 works for their deposition of Mr. Gastaldo, as both individuals would like to make their travel plans as quickly as possible.

Best,

Scott

Scott A. Leslie  
Cravath, Swaine & Moore LLP  
825 Eighth Avenue  
New York, NY 10019  
(212) 474-1778 (phone)  
(212) 474-3700 (fax)

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To: Scott Leslie <SLeslie@cravath.com>  
Cc: "ahale@cravath.com" <ahale@cravath.com>, "aharasymiak@cravath.com" <aharasymiak@cravath.com>, "Fenwick, Anthony I." <anthony.fenwick@davispolk.com>, "Lisson, David" <david.lisson@davispolk.com>, "Moore, David E." <dmoore@potteranderson.com>, Google-Xerox <Google-Xerox@quinnemanuel.com>, "Horwitz, Richard L." <rhowitz@Potteranderson.com>, "Richard Stark" <RStark@cravath.com>, "jday@ashby-geddes.com" <jday@ashby-geddes.com>, "Imaguire@ashby-geddes.com" <Imaguire@ashby-geddes.com>, "AMayo@ashby-geddes.com" <AMayo@ashby-geddes.com>, "jblumenfeld@mnat.com" <jblumenfeld@mnat.com>, "mnoreika@mnat.com" <mnoreika@mnat.com>, Matthew Cannon <matthewcannon@quinnemanuel.com>  
Date: 05/04/2011 03:22 PM  
Subject: RE: Xerox v. Google

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**From:** Scott Leslie [<mailto:SLeslie@cravath.com>]  
**Sent:** Thursday, April 28, 2011 11:50 AM  
**To:** Andrea P Roberts  
**Cc:** 'ahale@cravath.com'; 'aharasymiak@cravath.com'; 'Fenwick, Anthony I.'; 'Lisson, David'; 'Moore, David E.'; Google-Xerox; 'Horwitz, Richard L.'; 'Richard Stark'; jday@ashby-geddes.com; Imaguire@ashby-geddes.com; AMayo@ashby-geddes.com; jblumenfeld@mnat.com; mnoreika@mnat.com; Matthew Cannon  
**Subject:** Re: Xerox v. Google

Andrea -

I write in response to your letter of April 23 concerning depositions of certain Xerox current and former employees.

We can accept deposition notices only on behalf of current Xerox employees Mathieu Chuat and Michel Gastaldo. Mr. Chuat is available to be deposed in New York starting on June 15, and we are currently trying to determine when Mr. Gastaldo will be available. We will let you know as soon as we are able to.

Laurence Hubert and Yutaka Yamauchi are no longer affiliated with Xerox.

Best,

Scott

Scott A. Leslie  
Cravath, Swaine & Moore LLP  
825 Eighth Avenue  
New York, NY 10019  
(212) 474-1778 (phone)  
(212) 474-3700 (fax)

From: Matthew Cannon <matthewcannon@quinnemanuel.com>  
To: 'Scott Leslie' <SLeslie@cravath.com>, "aharasyiak@cravath.com" <aharasyiak@cravath.com>, "ahale@cravath.com" <ahale@cravath.com>, 'Richard Stark' <RStark@cravath.com>  
Cc: Google-Xerox <Google-Xerox@quinnemanuel.com>, "Horwitz, Richard L." <rhorwitz@Potteranderson.com>, "Moore, David E." <dmoore@potteranderson.com>, "Fenwick, Anthony I." <anthony.fenwick@davispolk.com>, "Lisson, David" <david.lisson@davispolk.com>  
Date: 04/23/2011 03:55 PM  
Subject: Xerox v. Google

---

Counsel-

Please see attached.

Best,

Matt

Matthew Cannon

Quinn Emanuel Urquhart & Sullivan, LLP

50 California Street, 22nd Floor

San Francisco, CA 94111

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Main Phone: (415) 875-6600

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[attachment "4-23-11 Itr to Leslie.pdf" deleted by Scott Leslie/NYC/Cravath]

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This e-mail is confidential and may be privileged. Use or disclosure of it by anyone other than a designated addressee is unauthorized. If you are not an intended recipient, please delete this e-mail from the computer on which you received it.

# **EXHIBIT L**



IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

XEROX CORPORATION,

*Plaintiff,*

v.

GOOGLE INC., YAHOO! INC., RIGHT  
MEDIA INC., RIGHT MEDIA LLC,  
YOUTUBE, INC., and YOUTUBE, LLC,

*Defendants.*

C.A. No. 10-136-JJF-MPT

**XEROX'S INITIAL DISCLOSURES**

Pursuant to Rule 26(a)(1) of the Federal Rules of Civil Procedure, Plaintiff Xerox Corporation ("Xerox"), by and through its attorneys, hereby makes the following initial disclosures to Defendants Google Inc. ("Google"), Yahoo! Inc. ("Yahoo"), Right Media Inc. and Right Media LLC (collectively, "Right Media"), and YouTube, Inc. and YouTube, LLC (collectively, "YouTube"). Xerox makes these Disclosures based on information reasonably available to it as of the date hereof and reserves the right to amend and supplement these Disclosures. Xerox makes these Disclosures subject to, and without waiver of, any attorney-client or work product privilege or any other applicable privilege or immunities.

**A. Individuals Possessing Information**

**"[T]he name and, if known, the address and telephone number of each individual likely to have discoverable information--along with the subjects of that information--that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment;"**

Based on Xerox's investigation to date, the following individuals are likely to have discoverable information that Xerox may use in support of its claims or defenses. Each

subject of information identified represents only those broad areas of relevant information each individual is believed to possess, and may not be exhaustive in its scope.

Name	Area of Knowledge	Last Known Address and Telephone Number
Gregory T. Grefenstette	U.S. Patent 6,778,979	48 rue de Moscou 75008 Paris France Tel: +33 (0)6-32-66-31-13
James G. Shanahan	U.S. Patent 6,778,979	541 Duncan Street San Francisco, CA 94131 Tel: (415) 630-0890
Ronald M. Swartz	U.S. Patent 6,236,994	50 Berrywood Lane Dresher, PA 19025 Tel: (215) 237-1937
Jeffrey L. Winkler	U.S. Patent 6,236,994	To be determined.
Igor W. Markidan	U.S. Patent 6,236,994	1109 Willowdale Drive Cherry Hill, NJ 08003 Tel: (856) 795-7298
Qun Dou	U.S. Patent 6,236,994	1621 Hancock Road North Wales, PA 19454 Tel: (215) 661-1275
Evelyn A. Janos	U.S. Patent 6,236,994	346 Davis Circle West Chester, PA 19380 Tel: (610) 696-1366
Mathieu Chuat	Licensing negotiations related to the patents-in-suit.	Xerox Research Centre Europe 6 Chemin de Maupertuis Grenoble 38240, France Tel: +33 (0)4-76-61-50-50
Paul Schnose	Licensing negotiations related to the patents-in-suit.	Xerox Corporation Mailstop 0139-21A 800 Phillips Road Webster, NY 14580 Tel: (585) 422-1800
Thomas Zell	Licensing negotiations related to the patents-in-suit and prosecution of the patents-in-suit.	Xerox Research Centre Europe 6 Chemin de Maupertuis Grenoble 38240, France Tel: +33 (0)4-76-61-50-50
Duane Basch (formerly at Xerox Corporation)	Prosecution of the patents-in-suit.	Basch & Nickerson, LLP 1777 Penfield Road Penfield, NY 14526 Tel: (585) 899-3970

William F. Eipert	Prosecution of the patents-in-suit.	Xerox Corporation Mail Stop XRX2-020A 100 Clinton Ave. S. Rochester, NY 14644
Kapu Kumar	Licensing negotiations related to the patents-in-suit.	IPValue Management Inc. 991 Route 22 West, 3rd Floor Bridgewater, NJ 08807 Tel: (908) 546-5990
Paul Riley	Licensing negotiations related to the patents-in-suit.	IPValue Management Inc. 991 Route 22 West, 3rd Floor Bridgewater, NJ 08807 Tel: (908) 546-5990
Aikaterini Varsou	Licensing negotiations related to the patents-in-suit.	IPValue Management Inc. 991 Route 22 West, 3rd Floor Bridgewater, NJ 08807 Tel: (908) 546-5990
Steve Shin	Licensing negotiations related to the patents-in-suit.	IPValue Management Inc. 991 Route 22 West, 3rd Floor Bridgewater, NJ 08807 Tel: (908) 546-5990
Andres Diaz	Licensing negotiations related to the patents-in-suit.	IPValue Management Inc. 200 West Evelyn Avenue, Suite 100 Mountain View, CA 94041 Tel: (650) 230-4777
Sanjay Prasad (formerly at IPValue Management Inc.)	Licensing negotiations related to the patents-in-suit.	Intellectual Ventures 171 N. Main Street, # 271 Los Altos, CA 94022 Tel: (650) 868-6011
Google, Yahoo, Right Media and YouTube personnel.	The accused Google, Yahoo, Right Media and YouTube products and services and licensing negotiations related to the patents-in-suit.	To be determined.

The individuals specifically listed above should be contacted only through Xerox counsel.

Xerox's investigation is ongoing, and Xerox reserves the right to identify additional witnesses who are likely to have discoverable information that Xerox may use to support its claims or defenses.

**B. Documents, Data Compilations and Tangible Things**

**“A copy of, or a description by category and location of, all documents, data compilations, and tangible things that are in the possession, custody, or control of the party and that the disclosing party may use to support its claims or defenses, unless solely for impeachment”**

Xerox identifies the following categories of documents, data compilations and tangible things in the possession, custody or control of Xerox that, at present, may be used in support of Xerox's claims or defenses:

1. U.S. Patent Nos. 6,778,979 and 6,236,994 (the “patents-in-suit”) and the prosecution histories of the patents-in-suit;
2. Documents concerning the development of the inventions embodied in the patents-in-suit.
3. Documents concerning Xerox's licensing of the patents-in-suit.

Xerox reserves the right to object to the production of any document, data compilation and tangible thing within the categories described above on any basis permitted by the Federal Rules of Civil Procedure, by the local rules or orders of this Court or by any agreements or stipulations between the parties. The above documents are believed to be located at Xerox facilities in Rochester, NY; Webster, NY; and Grenoble, France. Xerox's investigation is ongoing, and Xerox reserves the right to identify additional documents, data compilations and other tangible things that Xerox may use to support its claims or defenses.

**C. Computation of Damages**

**“A computation of any category of damages claimed by the disclosing party, making available for inspection and copying as under Rule 34 the documents or other evidentiary material, not privileged or protected from disclosure, on which such computation is based, including materials bearing on the nature and extent of injuries suffered”**

Xerox is seeking injunctive relief and damages for infringement of the patents-in-suit, including increased damages for willful infringement up to three times the actual damages. Under the law, Xerox is entitled to at least a reasonable royalty for use of the patented inventions. *See* 35 U.S.C. § 184. Damages based on a reasonable royalty rate will be measured and calculated according to the tests and factors set forth in relevant case law. To analyze these factors, Xerox will need discovery from Google, Yahoo, Right Media and YouTube, and, potentially, discovery from third parties. Xerox will also likely rely on expert analysis and opinion concerning damages. As a result, Xerox is unable to provide a precise computation of its damages at this time.

**D. Insurance Agreements**

**“For inspection and copying as under Rule 34 any insurance agreement under which any person carrying on an insurance business may be liable to satisfy part or all of a judgment which may be entered in the action or to indemnify or reimburse for payments made to satisfy the judgment”**

Not applicable.

Dated: May 25, 2010

ASHBY

& GEDDES,

*/s/ John G. Day*

---

Lawrence C. Ashby (J.D. #468)  
John G. Day (J.D. #2403)  
Lauren E. Maguire (J.D. #4261)  
500 Delaware Avenue, 8th Floor  
P.O. Box 1150  
Wilmington, DE 19899  
(302) 654-1888  
lashby@ashby-geddes.com  
jday@ashby-geddes.com  
lmauire@ashby-geddes.com

*Attorneys for Plaintiff Xerox Corporation*

Of counsel:

Richard J. Stark (admitted *pro hac vice*)  
Andrei Harasymiak (admitted *pro hac vice*)  
CRAVATH, SWAINE & MOORE LLP  
Worldwide Plaza  
825 Eighth Avenue  
New York, NY 10019  
(212) 474-1000

**CERTIFICATE OF SERVICE**

I hereby certify that on May 25, 2010, the attached **XEROX'S INITIAL DISCLOSURES** was served upon the below-named counsel of record at the address and in the manner indicated:

Richard L. Horwitz, Esq.  
David E. Moore, Esq.  
POTTER ANDERSON & CORROON LLP  
Hercules Plaza, 6th Floor  
1313 N. Market Street  
Wilmington, DE 19801

VIA ELECTRONIC MAIL

Charles K. Verhoeven, Esq.  
David A. Perlson, Esq.  
Brian C. Cannon, Esq.  
Eugene Novikov, Esq.  
QUINN EMANUEL URQUHART & SULLIVAN, LLP  
50 California Street, 22nd Floor  
San Francisco, CA 94111

VIA ELECTRONIC MAIL

Jack B. Blumenfeld, Esq.  
Maryellen Noreika, Esq.  
MORRIS, NICHOLS, ARSHT & TUNNELL LLP  
1201 North Market Street  
P.O. Box 1347  
Wilmington, DE 19899

VIA ELECTRONIC MAIL

Matthew B. Lehr, Esq.  
Anthony I. Fenwick, Esq.  
Jesse Dyer, Esq.  
Jill Zimmerman, Esq.  
DAVIS POLK & WARDWELL LLP  
1600 El Camino Real  
Menlo Park, CA 94025

VIA ELECTRONIC MAIL

*/s/ Scott A. Leslie*

---

Scott A. Leslie

# **EXHIBIT M**



**THIS EXHIBIT HAS BEEN  
REDACTED IN ITS ENTIRETY**

# **EXHIBIT N**

## Andrea P Roberts

---

**From:** Scott Leslie [SLeslie@cravath.com]  
**Sent:** Wednesday, May 11, 2011 9:13 AM  
**To:** Andrea P Roberts  
**Cc:** 'ahale@cravath.com'; 'aharasymiak@cravath.com'; AMayo@ashby-geddes.com; 'Fenwick, Anthony I.'; 'Lisson, David'; 'Moore, David E.'; Google-Xerox; jblumenfeld@mnat.com; jday@ashby-geddes.com; Imaguire@ashby-geddes.com; Matthew Cannon; mnoreika@mnat.com; 'Horwitz, Richard L.'; 'Richard Stark'  
**Subject:** RE: Xerox v. Google

Andrea -

It would be possible to schedule Mr. Chuat's and Mr. Gastaldo's depositions for the same week. However, this would require scheduling Mr. Chuat's deposition for Wednesday, June 29, and Mr. Gastaldo's deposition for Friday, July 1. Please let us know if this works for Defendants.

Christer Fernstrom is no longer affiliated with Xerox.

Best,

Scott

Scott A. Leslie  
Cravath, Swaine & Moore LLP  
825 Eighth Avenue  
New York, NY 10019  
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(212) 474-3700 (fax)

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Cc: "ahale@cravath.com" <ahale@cravath.com>, "aharasymiak@cravath.com" <aharasymiak@cravath.com>, "Fenwick, Anthony I." <anthony.fenwick@davispolk.com>, "Lisson, David" <david.lisson@davispolk.com>, "Moore, David E." <dmoore@potteranderson.com>, Google-Xerox <Google-Xerox@quinnemanuel.com>, "Horwitz, Richard L." <rhowitz@Potteranderson.com>, 'Richard Stark' <RStark@cravath.com>, 'jday@ashby-geddes.com' <jday@ashby-geddes.com>, 'Imaguire@ashby-geddes.com' <Imaguire@ashby-geddes.com>, "AMayo@ashby-geddes.com" <AMayo@ashby-geddes.com>, 'jblumenfeld@mnat.com' <jblumenfeld@mnat.com>, "mnoreika@mnat.com" <mnoreika@mnat.com>, Matthew Cannon <matthewcannon@quinnemanuel.com>  
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**Andrea Pallios Roberts**

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andrea@roberts@quinnemanuel.com  
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**From:** Scott Leslie [<mailto:SLeslie@cravath.com>]

**Sent:** Thursday, April 28, 2011 11:50 AM

**To:** Andrea P Roberts

**Cc:** 'ahale@cravath.com'; 'aharasymiak@cravath.com'; 'Fenwick, Anthony I.'; 'Lisson, David'; 'Moore, David E.'; Google-Xerox; 'Horwitz, Richard L.'; 'Richard Stark'; jday@ashby-geddes.com; Imaguire@ashby-geddes.com; AMayo@ashby-geddes.com; jblumenfeld@mnat.com; mnoreika@mnat.com; Matthew Cannon

**Subject:** Re: Xerox v. Google

Andrea -

I write in response to your letter of April 23 concerning depositions of certain Xerox current and former employees.

We can accept deposition notices only on behalf of current Xerox employees Mathieu Chuat and Michel Gastaldo. Mr. Chuat is available to be deposed in New York starting on June 15, and we are currently trying to determine when Mr. Gastaldo will be available. We will let you know as soon as we are able to.

Laurence Hubert and Yutaka Yamauchi are no longer affiliated with Xerox.

Best,

Scott

Scott A. Leslie  
Cravath, Swaine & Moore LLP  
825 Eighth Avenue  
New York, NY 10019  
(212) 474-1778 (phone)  
(212) 474-3700 (fax)

From: Matthew Cannon <matthewcannon@quinnemanuel.com>  
To: 'Scott Leslie' <SLeslie@cravath.com>, "aharasymiak@cravath.com" <aharasymiak@cravath.com>, "ahale@cravath.com" <ahale@cravath.com>, 'Richard Stark' <RStark@cravath.com>

Cc: Google-Xerox <Google-Xerox@quinnemanuel.com>, "Horwitz, Richard L." <rhorwitz@Potteranderson.com>, "Moore, David E." <dmoore@potteranderson.com>, "Fenwick, Anthony I." <anthony.fenwick@davispolk.com>, "Lisson, David" <david.lisson@davispolk.com>  
Date: 04/23/2011 03:55 PM  
Subject: Xerox v. Google

---

Counsel-

Please see attached.

Best,

Matt

Matthew Cannon

Quinn Emanuel Urquhart & Sullivan, LLP

50 California Street, 22nd Floor

San Francisco, CA 94111

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[attachment "4-23-11 ltr to Leslie.pdf" deleted by Scott Leslie/NYC/Cravath]

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# **EXHIBIT O**



**Yutaka Yamauchi**  
Social Scientist at PARC  
San Francisco Bay Area | Research

- Current**
  - Senior Lecturer / Assistant Professor at Kyoto University Graduate School of Management
  - Member of Research Staff II at Palo Alto Research Center (PARC)
- Education**
  - University of California, Los Angeles - The Anderson School of Management
  - Kyoto University
- Connections** 81 connections

### Yutaka Yamauchi's Experience

**Senior Lecturer / Assistant Professor**  
**Kyoto University Graduate School of Management**  
Research industry  
September 2010 – Present (9 months)

**Member of Research Staff II**  
**Palo Alto Research Center (PARC)**  
Public Company; Research industry  
2004 – Present (7 years)

### Yutaka Yamauchi's Education

**University of California, Los Angeles - The Anderson School of Management**  
Ph.D., Management  
2000 – 2006

**Kyoto University**  
Master, Computer Science  
1994 – 2000

### Yutaka Yamauchi's Additional Information

- Groups and Associations:
-  Kyoto University North American Alumni Association
  -  PARC (& Xerox PARC)

### Yutaka Yamauchi's Contact Settings

Yutaka Yamauchi is not currently open to receiving Introductions or InMail™.

### View Yutaka Yamauchi's full profile to...

- See who you and Yutaka Yamauchi know in common
- Get introduced to Yutaka Yamauchi
- Contact Yutaka Yamauchi directly

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# **EXHIBIT P**

# CRAVATH, SWAINE & MOORE LLP

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DANIEL SLIFKIN  
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PHILIP J. BOECKMAN  
ROGER G. BROOKS  
WILLIAM V. FOGG

November 26, 2010

Xerox v. Google, et al., Case No. 10-136-LPS-MPT

Dear Gene:

Enclosed please find IPValue Management Inc.'s ("IPValue") Responses and Objections to Defendants Google Inc.'s and YouTube LLC's Subpoena. As Cravath is IPValue's counsel, please direct any communications regarding these Responses and Objections to the Cravath attorneys currently on the service list used by the parties in this matter.

Very truly yours,

/s/

Richard J. Stark,

Eugene Novikov  
Quinn Emanuel Urquhart & Sullivan, LLP  
50 California Street, 22nd Floor  
San Francisco, CA 94111

Encl.

FIRST CLASS MAIL

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

XEROX CORPORATION

Plaintiff,

vs.

GOOGLE INC., YAHOO! INC., RIGHT  
MEDIA INC., RIGHT MEDIA LLC,  
YOUTUBE, INC. AND YOUTUBE, LLC

Defendants.

CASE NO. 10-136-LPS-MPT

(Action pending in the District of Delaware)

**NON-PARTY IPVALUE'S RESPONSES  
AND OBJECTIONS TO DEFENDANTS  
GOOGLE INC.'S AND YOUTUBE LLC'S  
SUBPOENA**

Pursuant to Rule 45 of the Federal Rules of Civil Procedure, non-party IPValue Management Inc. ("IPValue") hereby responds and objects to Defendants Google Inc.'s and YouTube LLC's (collectively, "Google") Subpoena to Produce Documents, Information, or Objects (the "Subpoena"), served on IPValue on November 11, 2010.

**GENERAL OBJECTIONS**

1. IPValue's responses and objections herein and IPValue's production of any documents in response to the Subpoena shall not waive or prejudice any objections IPValue may later assert, including, but not limited to, objections as to relevancy, materiality or admissibility of any document in subsequent proceedings or at the trial of this or any other action.

2. IPValue objects to the Subpoena to the extent that it purports to impose obligations beyond those imposed by the Federal Rules of Civil Procedure, the local rules of this court or other applicable law.

3. IPValue objects to the Subpoena to the extent it requires production of all responsive documents by December 1, 2010. IPValue will produce documents in response to the Subpoena on a rolling basis as soon as practicable.

1           4.     IPValue objects to the Subpoena to the extent it seeks discovery of  
2 information that is prepared in anticipation of litigation, or is subject to the attorney-client privilege,  
3 the attorney work-product doctrine or other applicable privileges, including without limitation  
4 common-interest privilege (collectively, "Privileged Information"). IPValue hereby claims such  
5 privileges, protections and immunities to the extent implicated by each request. Inadvertent  
6 disclosure of Privileged Information shall not constitute a waiver of any privilege or any other  
7 ground for objecting to discovery with respect to such information.

8           5.     IPValue objects to the Subpoena to the extent it seeks documents not in  
9 IPValue's possession, custody or control.

10          6.     IPValue objects to the Subpoena to the extent it seeks documents that are  
11 already in Google's possession, custody or control.

12          7.     IPValue objects to the Subpoena to the extent it seeks documents that are  
13 publicly available, or are otherwise readily available to Google from other sources, in particular  
14 Plaintiff Xerox Corporation ("Xerox") and/or Defendants, on the grounds that such documents are  
15 equally available to Google and the burden and expense of obtaining such documents is not greater  
16 for Google than it is for IPValue.

17          8.     IPValue objects to the Subpoena to the extent it seeks documents that are not  
18 permitted to be disclosed under the statutory or common law, regulation, policy or rules of the  
19 country in which those documents are located.

20          9.     IPValue objects to the Subpoena to the extent it is cumulative or duplicative  
21 of document requests made on other parties in this action, in particular Plaintiff Xerox.

22          10.    IPValue objects to the Subpoena to the extent it is vague, ambiguous and  
23 unclear.

24          11.    IPValue objects to the Subpoena to the extent it seeks production and  
25 disclosure of information that is not relevant to any claim or defense in this action.  
26

1           12. IPValue objects to the Subpoena to the extent it is overbroad and unduly  
2 burdensome, including without limitation to the extent it seeks "all" or "any" documents and/or  
3 communications (or analogous formulations), and to the extent it seeks documents "referring to" or  
4 "relating to" a given subject.

5           13. IPValue objects to the Subpoena to the extent it is premature in light of the  
6 Delaware court's bifurcation of issues in this action.

7           14. IPValue objects to the Subpoena on the grounds and to the extent that it  
8 requires IPValue to produce materials at substantial cost without payment by Google of attorneys'  
9 fees, costs and expenses incurred by IPValue in responding to the Subpoena.

10           15. IPValue objects to the Subpoena to the extent it seeks documents that  
11 constitute or contain confidential third-party information disclosed to IPValue on the condition that,  
12 or subject to an obligation that, IPValue keep that information confidential.

13           16. IPValue objects to the Subpoena to the extent it requires IPValue to search for  
14 or produce any electronically stored information that is not readily accessible without undue burden  
15 or cost. IPValue also objects to the Subpoena as unduly burdensome to the extent it calls for  
16 IPValue to search central repositories, including, for example, databases, that are unduly  
17 burdensome in either number or size.

18           17. The responses and objections to the Subpoena provided herein do not  
19 constitute IPValue's agreement with any of the definitions set forth in the Subpoena. IPValue  
20 further objects to the Subpoena to the extent it assumes disputed facts or legal conclusions in  
21 defining the documents requested. Any production of documents by IPValue in response to any  
22 request is without prejudice to this objection.

23           18. IPValue objects to the definition of "YOU" or "YOUR" in the Subpoena as  
24 irrelevant, as the definition includes Amazon.com, Inc., a third party unrelated to IPValue. IPValue  
25 will construe "YOU" and "YOUR" as used in the Subpoena to mean IPValue Management, Inc., and  
26

1 will produce only non-privileged responsive documents that may be located within the possession,  
2 custody or control of IPValue so construed.

3 19. IPValue objects to the definition of "RELATED  
4 PATENTS/APPLICATIONS" in the Subpoena as overbroad and unduly burdensome.

5 20. IPValue objects to the Subpoena to the extent it calls for confidential  
6 information. IPValue will produce non-privileged, responsive confidential documents in response to  
7 the Subpoena in accordance with the Protective Order entered in this action on September 23, 2010.

8 21. A response that IPValue will produce documents responsive to any Request  
9 does not imply that IPValue has located any responsive documents, but only that IPValue will  
10 produce all such non-privileged documents that it has located following a search of reasonable  
11 scope.

12 22. IPValue reserves the right to supplement its responses and objections to the  
13 Subpoena.

#### 14 **SPECIFIC OBJECTIONS AND RESPONSES**

##### 15 Request No. 1

16 All communications with XEROX regarding DEFENDANTS, DEFENDANTS'  
17 alleged infringement of PATENTS-IN-SUIT, or this lawsuit.

##### 18 Response to Request No. 1

19 IPValue incorporates by reference its general objections as though they were set forth  
20 fully herein. IPValue further objects to this Request on the grounds that it is vague and ambiguous,  
21 is overbroad and unduly burdensome, and seeks information that is not relevant to any claim or  
22 defense in this action, including without limitation information or communications concerning  
23 Defendants that do not involve the patents-in-suit or this lawsuit. IPValue further objects to this  
24 Request to the extent it seeks disclosure of Privileged Information.

25 Subject to and without waiving its foregoing general and specific objections, IPValue  
26 will produce non-privileged documents responsive to this Request after a search of reasonable scope.

1 Request No. 2

2 All communications with DEFENDANTS regarding the PATENTS-IN-SUIT.

3 Response to Request No. 2

4 IPValue incorporates by reference its general objections as though they were set forth  
5 fully herein. IPValue further objects to this Request as unduly burdensome to the extent it seeks  
6 documents that are already within Google's possession, custody or control.

7 Subject to and without waiving its foregoing general and specific objections, IPValue  
8 will produce non-privileged documents responsive to this Request after a search of reasonable scope.

9 Request No. 3

10 All communications with the INVENTORS.

11 Response to Request No. 3

12 IPValue incorporates by reference its general objections as though they were set forth  
13 fully herein. IPValue further objects to this Request on the grounds that it is overbroad, unduly  
14 burdensome, and seeks information that is not relevant to any claim or defense in this action.  
15 IPValue further objects to this Request to the extent that it seeks disclosure of Privileged  
16 Information.

17 Subject to and without waiving its foregoing general and specific objections, IPValue  
18 will produce non-privileged documents that are responsive to this Request and that have been  
19 communicated to or from Xerox after a search of reasonable scope.

20 Request No. 4

21 All DOCUMENTS and THINGS that REFER or RELATE to any analysis of whether  
22 any entity or individual infringes either of the PATENTS-IN-SUIT.

23 Response to Request No. 4

24 IPValue incorporates by reference its general objections as though they were set forth  
25 fully herein. IPValue further objects to this Request on the grounds that it is vague and ambiguous,  
26 is overbroad and unduly burdensome, and seeks information that is not relevant to any claim or

1 defense in this action. IPValue further objects to this Request to the extent that it seeks disclosure of  
2 Privileged Information.

3           Subject to and without waiving its foregoing general and specific objections, IPValue  
4 will produce non-privileged documents that have been communicated to or from Xerox and that  
5 relate to analyses of whether the Defendants in this action infringe either of the patents-in-suit after a  
6 search of reasonable scope.

7 Request No. 5

8           All DOCUMENTS and THINGS that REFER or RELATE to any analysis of whether  
9 the PATENTS-IN-SUIT are valid.

10 Response to Request No. 5

11           IPValue incorporates by reference its general objections as though they were set forth  
12 fully herein. IPValue further objects to this Request on the grounds that it is vague and ambiguous,  
13 is overbroad and unduly burdensome, and seeks information that is not relevant to any claim or  
14 defense in this action. IPValue further objects to this Request to the extent that it seeks disclosure of  
15 Privileged Information.

16           Subject to and without waiving its foregoing general and specific objections, IPValue  
17 will produce non-privileged documents that are responsive to this Request and that have been  
18 communicated to or from Xerox after a search of reasonable scope.

19 Request No. 6

20           All DOCUMENTS and THINGS that REFER or RELATE to the ownership of the  
21 PATENTS-IN-SUIT.

22 Response to Request No. 6

23           IPValue incorporates by reference its general objections as though they were set forth  
24 fully herein. IPValue further objects to this Request on the grounds that it is vague and ambiguous,  
25 is overbroad and unduly burdensome, and seeks information that is not relevant to any claim or  
26



1 defense in this action. IPValue further objects to this Request to the extent that it seeks disclosure of  
2 Privileged Information.

3           Subject to and without waiving its foregoing general and specific objections, IPValue  
4 will produce non-privileged documents that are responsive to this Request and that have been  
5 communicated to or from Xerox after a search of reasonable scope.

6 Request No. 7

7           All DOCUMENTS and THINGS that REFER or RELATE to the prosecution of the  
8 PATENTS-IN-SUIT.

9 Response to Request No. 7

10           IPValue incorporates by reference its general objections as though they were set forth  
11 fully herein. IPValue further objects to this Request on the grounds that it is vague and ambiguous,  
12 is overbroad and unduly burdensome, and seeks information that is not relevant to any claim or  
13 defense in this action. IPValue further objects to this Request to the extent that it seeks disclosure of  
14 Privileged Information. IPValue further objects to this Request to the extent it seeks documents that  
15 are publicly available, or are otherwise readily available to Google from other sources, in particular  
16 Plaintiff Xerox.

17 Request No. 8

18           All DOCUMENTS and THINGS that REFER or RELATE to the alleged inventions  
19 claimed in the PATENTS-IN-SUIT, including the conception or reduction to practice  
20 of those alleged inventions.

21 Response to Request No. 8

22           IPValue incorporates by reference its general objections as though they were set forth  
23 fully herein. IPValue further objects to this Request on the grounds that it is vague and ambiguous,  
24 is overbroad and unduly burdensome, and seeks information that is not relevant to any claim or  
25 defense in this action. IPValue further objects to this Request to the extent that it seeks Privileged  
26 Information. IPValue further objects to this Request to the extent it seeks documents that are  
publicly available, or are otherwise readily available to Google from other sources, in particular

1 Plaintiff Xerox, including without limitation documents that refer or relate to the conception or  
2 reduction to practice of inventions claimed in the patents-in-suit.

3           Subject to and without waiving its foregoing general and specific objections, IPValue  
4 will produce non-privileged documents that are responsive to this Request and that have been  
5 communicated to or from Xerox after a search of reasonable scope.

6 Request No. 9

7           All prior art to the PATENTS-IN-SUIT, and/or all DOCUMENTS and THINGS that  
8 any entity or individual represented to IPVALUE constitute prior art to the  
PATENTS-IN-SUIT.

9 Response to Request No. 9

10           IPValue incorporates by reference its general objections as though they were set forth  
11 fully herein. IPValue further objects to this Request on the grounds that it is vague and ambiguous,  
12 is overbroad and unduly burdensome, and seeks information that is not relevant to any claim or  
13 defense in this action. IPValue further objects to this Request to the extent that it seeks Privileged  
14 Information.

15           Subject to and without waiving its foregoing general and specific objections, IPValue  
16 will produce non-privileged documents that are responsive to this Request and that have been  
17 communicated to or from Xerox after a search of reasonable scope.

18 Request No. 10

19           All DOCUMENTS and THINGS that REFER or RELATE to any efforts to license  
20 the PATENTS-IN-SUIT.

21 Response to Request No. 10

22           IPValue incorporates by reference its general objections as though they were set forth  
23 fully herein. IPValue further objects to this Request on the grounds that it is vague and ambiguous,  
24 is overbroad and unduly burdensome, and seeks information that is not relevant to any claim or  
25 defense in this action. IPValue further objects to this Request as premature in light of the Delaware  
26

1 court's bifurcation of issues in this action. IPValue further objects to this Request to the extent that  
2 it seeks disclosure of Privileged Information.

3           Subject to and without waiving its foregoing general and specific objections, IPValue  
4 will produce non-privileged documents that are responsive to this Request and that have been  
5 communicated to or from Xerox after a search of reasonable scope.

6 Request No. 11

7           All DOCUMENTS and THINGS that REFER or RELATE to any efforts to license  
8 patents in the area of automatic generation of information, including but not limited to  
queries.

9 Response to Request No. 11

10           IPValue incorporates by reference its general objections as though they were set forth  
11 fully herein. IPValue further objects to this Request on the grounds that the phrase "[a]ll  
12 DOCUMENTS and THINGS that REFER or RELATE to any efforts to license patents in the area of  
13 automatic generation of information, including but not limited to queries" is vague and ambiguous,  
14 is overbroad and unduly burdensome, and seeks information that is not relevant to any claim or  
15 defense in this action. IPValue further objects to this Request as premature in light of the Delaware  
16 court's bifurcation of issues in this action. IPValue further objects to this Request to the extent that  
17 it seeks disclosure of Privileged Information.

18           Subject to and without waiving its foregoing general and specific objections, IPValue  
19 will produce non-privileged documents that relate to efforts to license the '979 Patent and that have  
20 been communicated to or from Xerox after a search of reasonable scope.

21 Request No. 12

22           All DOCUMENTS and THINGS that REFER or RELATE to any efforts to license  
23 patents in the area of knowledge management technology, including but not limited to  
24 the interoperability and synchronization of heterogeneous data sources.  
25  
26

1 Response to Request No. 12

2 IPValue incorporates by reference its general objections as though they were set forth  
3 fully herein. IPValue further objects to this Request on the grounds that the phrase “[a]ll  
4 DOCUMENTS and THINGS that REFER or RELATE to any efforts to license patents in the area of  
5 knowledge management technology, including but not limited to the interoperability and  
6 synchronization of heterogeneous data sources” is vague and ambiguous, is overbroad and unduly  
7 burdensome, and seeks information that is not relevant to any claim or defense in this action.  
8 IPValue further objects to this Request as premature in light of the Delaware court’s bifurcation of  
9 issues in this action. IPValue further objects to this Request to the extent that it seeks disclosure of  
10 Privileged Information.

11 Subject to and without waiving its foregoing general and specific objections, IPValue  
12 will produce non-privileged documents that relate to efforts to license the ’994 Patent and that have  
13 been communicated to or from Xerox after a search of reasonable scope.

14 Request No. 13

15 DOCUMENTS sufficient to show the identities of all IPVALUE employees and  
16 consultants involved in any analysis of the PATENTS-IN-SUIT or any efforts to  
license the PATENTS-IN-SUIT.

17 Response to Request No. 13

18 IPValue incorporates by reference its general objections as though they were set forth  
19 fully herein. IPValue further objects to this Request on the grounds that it is vague and ambiguous,  
20 is overbroad and unduly burdensome, and seeks information that is not relevant to any claim or  
21 defense in this action. IPValue further objects to this Request to the extent that it seeks disclosure of  
22 Privileged Information.

23

24

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26

1                   Subject to and without waiving its foregoing general and specific objections, IPValue  
2 will produce non-privileged documents that are responsive to this Request after a search of  
3 reasonable scope.

4  
5 November 26, 2010

6  
7 CRAVATH, SWAINE & MOORE LLP

8  
9 by 

Richard J. Stark  
Andrei Harasymiak  
Worldwide Plaza  
825 Eighth Avenue  
New York, NY 10019  
(212) 474-1000

*Attorneys for non-party  
IPValue Management Inc.*

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# **EXHIBIT Q**

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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

GOOGLE INC AND YOUTUBE LLC, )	
Plaintiff(s), )	No. C11-80016 MISC RS (BZ)
v. )	
IPVALUE MANAGEMENT INC, )	<b>ORDER GRANTING</b>
Defendant(s). )	<b>MOTION TO COMPEL</b>

Before me is plaintiffs' motion to compel IP Value to provide responses to plaintiffs' November 4, 2010 subpoena. Docket No. 5. At the March 30, 2011 hearing on this matter, the parties resolved many of the outstanding issues regarding plaintiffs' motion. The only issue that currently requires my ruling is whether IP Value shall be required to search for and produce responsive documents from its in-house counsel (Steve Shin, Sanjay Prasad, Keith Wilson, and Mitch Rosenfield), and, if so, whether some of the costs associated with this production shall be shifted to the plaintiffs. Having considered the arguments presented by counsel and reviewed the papers submitted, **IT IS HEREBY ORDERED** that plaintiffs' motion

1 is **GRANTED** for the reasons explained below.

2 It is IP Value's burden to establish that the attorney-  
3 client privilege would apply to its in-house counsel's  
4 documents. See von Bulow by Auersperg v. von Bulow, 811 F.2d  
5 136, 144 (2d Cir. 1987) ("[t]he burden is on a party claiming  
6 the protection of a privilege to establish those facts that  
7 are the essential elements of the privileged relationship").  
8 If IP Value's in-house counsel were functioning in a capacity  
9 to further the business goals of IP Value, then their  
10 documents would not be privileged. But if counsel were  
11 providing legal advice to IP Value, then their documents may  
12 potentially be privileged. See Diagnostic Systems Corp. v.  
13 Symantec, CV06-1211 at \*8-9 (C.D. Cal. 2008);<sup>1</sup> In re Sealed  
14 Case, 737 F.2d 94, 99 (D.C. Cir. 1984) (a company can only  
15 shelter its in-house counsel's advice upon a clear showing  
16 that he gave it in a professional legal capacity and not while  
17 performing his non-legal functions as the company's vice  
18 president).

19 Here, IP Value has submitted declarations from its in-  
20 house counsel explaining IP Value's business model and  
21 counsel's job duties. Contrary to the conclusory statements  
22 in these declarations that counsel only wear a "legal" hat  
23 while performing their work, the declarations show that  
24 counsel do function in a capacity to further the business  
25 goals of IP Value. For instance, Wilson's declaration  
26 explains that IP Value's business consists of two major

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28 <sup>1</sup> This case was submitted by plaintiffs as appendix A  
to their reply.



1 components: "(1) the identification of patent  
2 commercialization opportunities, and (2) the conduct of  
3 licensing or sales that comprise that commercialization."  
4 Wilson Decl. at ¶ 4. Wilson then testifies that Prasad,  
5 Rosenfield, and Shin may have participated in negotiations  
6 with plaintiffs led by IP Value's licensing group. Id. at ¶  
7 10. Thus, IP Value's in-house counsel were involved in  
8 licensing negotiations, one of the main functions of IP  
9 Value's business. IP Value concedes that it believes that  
10 about 10% of the disputed documents are not privileged and  
11 other than cost, presents no reason for not disclosing them.

12 Wilson's testimony that counsel mainly provided advice to  
13 IP Value regarding patent infringement theories and defenses  
14 to patent assertions also shows that counsel worked in the  
15 capacity of furthering IP Value's business goals. IP Value's  
16 decision to use attorneys for this function does not result in  
17 all communications relating to the counsel's work becoming  
18 privileged. See U.S. v. Cohn, 303 F.Supp.2d 672, 684 (D. Md.  
19 2003) (holding that a telemarketing company's in-house  
20 counsel's communications regarding her review of telemarketing  
21 scripts were not privileged because counsel's advice, although  
22 partly legal, was mainly intended to help the company increase  
23 profits and therefore constitutes business advice). Like  
24 Cohn, the primary purpose behind IP Value's in-house counsel's  
25 advice was to increase IP Value's business.<sup>2</sup> For the

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27 <sup>2</sup> Another reason that Cohn held that in-house counsel's  
28 advice was not privileged was because the advice was  
"customarily reviewed by both legal and non-legal personnel,  
thereby undermining any claim to confidentiality necessary to a

1 foregoing reasons, IP Value has not met its burden of  
2 establishing that the attorney-client privilege would apply to  
3 the documents at issue. IP Value shall therefore search for  
4 and produce any responsive documents requested by plaintiffs  
5 from Shin, Prasad, Wilson, and Rosenfield.

6 IP Value's request to shift some of the costs associated  
7 with this production onto plaintiffs is denied. IP Value has  
8 chosen to enter a business in which it commercializes patents  
9 for other companies. Its role as Xerox's agent in the  
10 instigation of this suit distinguishes it from a true non-  
11 party, as to whom the Court might be more concerned about  
12 saddling it with costly discovery. IP Value should have been  
13 aware that its efforts to enforce others' patents might lead  
14 to litigation that would require it to search for and produce  
15 documents through the discovery process. It could have  
16 developed a better system for filing privileged documents.

17 See e.g. The Sedona Conference Working Group, The Sedona  
18 Principles: Best Practices Recommendations & Principles for  
19 Addressing Electronic Document Production, Comment 5.b  
20 (Jonathan M. Redgrave et al. eds., 2d ed. 2007). Or it could  
21 have passed these costs on to its clients. Having done

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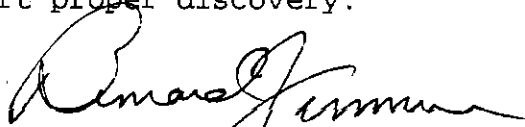
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26 claim of attorney-client privilege." 303 F.Supp.2d at 684-85.  
27 Although neither of the parties addressed this issue in their  
28 papers or at the hearing, it appears likely from IP Value's  
declarations that in-house counsel's advice was not kept  
confidential and was used by non-management personnel in  
running the day-to-day aspects of IP Value's business.

1 neither, it cannot thwart proper discovery.

2 Dated: April 28, 2011

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5 Bernard Zimmerman  
6 United States Magistrate Judge

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