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August 17, 2010

The Honorable Judge Mary Pat Thyng
J. Caleb Boggs Federal Building
844 N. King Street, Unit 8, Room 2124
Wilmington, DE 19801-3555

VIA ELECTRONIC FILINGRe: Xerox Corp. v. Google, Inc., et al., C.A. No. 10-136-JJF-MPT

Dear Judge Thyng:

Plaintiff Xerox Corporation (“Xerox”) respectfully requests that the Court address the following issues during the August 19 teleconference.

I. Refusal to Produce Responsive Documents

Xerox’s Second Requests for the Production of Documents (Exh. A), served on May 21, 2010, sought documents produced by Defendants in two prior patent cases that involve many of the same products accused of infringement in this action. All such materials, by definition, have already been collected and reviewed for privilege. They either have been burned onto CDs or DVDs, or are readily retrievable from databases. When it served the Requests, Xerox asked Defendants to indicate promptly whether documents would be produced in thirty days. Defendants refused to do so, waited thirty days, and then simply served objections and refused to produce any documents. (*See* Exhs. B, C.)

Both in their objections and during meet-and-confer conferences with Xerox, Defendants argued that the Second Requests are overbroad and burdensome because their prior productions may include material not relevant to this action, allegedly forcing them to sift through the productions to cull out such material. But even if the productions contain extraneous material, any such burden will fall on Xerox, not on Defendants. Similarly, Defendants claimed that because some material may relate to damages or willfulness, the bifurcation of those issues somehow compels Defendants to locate and remove all such material. But the rationale for bifurcated discovery is simply to reduce the discovery burden in the initial phase of the case by deferring the collection of material that may never need to be produced. Here, because the documents Xerox seeks have already been collected and produced in other actions, that rationale does not apply, and there is no reason for any additional review by, or burden on, Defendants.

Defendants also objected that the productions from prior cases might contain third-party confidential documents. However, Xerox is not requesting documents produced by third parties in those cases, and any third-party confidential documents among the documents produced by Defendants would be fully protected by the Protective Order in this action.

Therefore, because Xerox's Second Requests seek only preexisting collections of previously produced documents and because Defendants' objections to the Second Requests are without merit, Xerox asks that the Court order Defendants immediately to produce documents responsive to the Second Requests.

II. Protective Order Issues

A. *Source Code Production Issues*

Xerox requests that the Court reject Defendants' arbitrary limits on printouts of accused computer source code, and their refusal to make the accused source code available at depositions.

Source code printing. The twelve accused products in this infringement action consist almost entirely of computer software. To date, Defendants' productions of source code for the accused software exceed the equivalent of approximately 650,000 printed pages (over 42 million lines of code), which does not yet include source code for all versions of the accused products. Nonetheless, Defendants insist that Xerox may print no more than 3,000 pages (less than one banker's box) of source code per Defendant. (*See* Exh. D at 8-9, ¶ 1.C.2(e).) Above that arbitrary limit, Defendants could unilaterally and repeatedly withhold individual printouts at any time, pending briefing, argument and decisions from this Court on whether to allow those printouts. *Id.*

Defendants try to defend their arbitrary proposed limit by citing purported security concerns. But Xerox has already accommodated any valid concerns by agreeing to a host of security measures. Xerox may inspect and print source code only on computers located at defense counsels' offices, with each inspection requiring two-day notice and compliance with strict protocols. Xerox can print only onto specially labeled paper, which is immediately turned over to Defendants for 48-72 hours before being produced to Xerox. Xerox can make only two copies of any printouts, with originals and copies to be stored in locked rooms. Xerox must log the locations of the locked rooms, as well as all persons who receive source code printouts, and those persons cannot include Xerox employees. Finally, Xerox cannot print in such volume so as to circumvent the intent of the source code protections. (*See* Exh. D at 6-13, ¶¶ 1.C.2(a)-(o).)

Given the size of the productions and the extensive security measures in the Protective Order, Defendants' proposed limits would severely and unnecessarily hamstring Xerox's ability to litigate this action. The source code for the accused software products—all of which has been produced by Defendants as relevant and responsive—is critical evidence of infringement, and it is difficult to predict in advance how much of that code will be particularly relevant. For Xerox to prepare its case, its technical advisors must perform lengthy, detailed analysis of the relevant source code; its experts must refer to that code in preparing their reports; and its counsel must reference that code in preparing for depositions or writing briefs. Yet Defendants would limit Xerox to printing less than 1% of the initial production alone. Above that arbitrary limit, Defendants could withhold all printouts. Xerox would then be forced repeatedly to litigate production of individual printouts of relevant, responsive documents. This is a recipe for delay, inefficiency and needless burdens on the Court. As a result, Xerox requests that the Court reject Defendants' proposed language for Paragraph 1.C.2(e) of the final Protective Order. (Exh. D at 8-9.)

Source code computers. Xerox asked each Defendant to make a computer containing produced source code available at relevant fact or expert depositions. To eliminate any security

or burden concerns, Xerox proposed that such depositions occur at the offices of Defendants' counsel, precisely where the computers are kept for inspection. (*See* Exh. D at 11-12 ¶ 1.C.2(k)(4).) Defendants refused, arguing that Xerox should instead print out in advance all source code that might be used at a given deposition (subject to Defendants' proposed printing restrictions).

Defendants' position is baseless and would prevent Xerox counsel from conducting depositions effectively. Although Xerox will try to print out all relevant exhibits in advance (assuming it can do so without being hampered by arbitrary limits), deponents could still stymie questioning by, for example, referencing other portions of code or stating that they cannot recall which code implements a particular function—all for want of an already-prepared computer located in the same building. Defendants' proposal will thus lead to needless delays and otherwise avoidable motion practice concerning deposition continuations. Xerox therefore requests that the Court enter its proposed version of Paragraph 1.C.2(k)(4). (Exh. D at 11-12.)

B. *Counsel Participation in Reexamination Proceedings*

Despite Judge Robinson's rejection of their position in *Kenexa Brassring Inc. v. Taleo Corp.*, Civ. A. No. 07-521-SLR, 2009 WL 393782 (D. Del. Feb. 18, 2009), and the weight of authority in other jurisdictions, Defendants seek to bar Xerox counsel from participating in reexaminations of the asserted Xerox patents if counsel have been exposed to Defendants' confidential information—which, as a practical matter, encompasses all Xerox trial counsel. Under Defendants' proposal, Xerox counsel could not advise Xerox in connection with a reexamination of the patents-in-suit, while Defendants' counsel could advise their clients in connection with both that reexamination and this action. Xerox requests that this Court follow Judge Robinson's reasoning in *Kenexa*, as well as decisions from other jurisdictions, *see, e.g.*, *Document Generation Corp. v. Allscripts, LLC*, Civ. A. No. 6:08-479, 2009 WL 1766096, at *2 (E.D. Tex. June 23, 2009) (collecting cases), and reject Defendants' one-sided proposal.

As Judge Robinson held, “[b]ecause reexamination involves only the patent and the prior art, defendant’s confidential information is ‘basically irrelevant to the reexamination’.” *Kenexa*, 2009 WL 393782 at *2 (citation omitted). Furthermore, the scope of patent claims cannot be broadened in reexamination. *See* 35 U.S.C. §§ 305, 314. Since products that do not infringe the original asserted patent claims could never infringe any claims that emerge from reexamination, a plaintiff’s counsel’s exposure to confidential information cannot prejudice defendants. *Kenexa*, 2009 WL 393782 at *2. Finally, a reexamination filed by a defendant effectively may be considered an extension of the litigation. *Id.* Because trial counsel will be extensively familiar with the relevant patents and will need to review reexamination prior art in any event, that counsel should be able to assist its client to avoid duplicating work and increasing costs.

In sum, Defendants' position is groundless, conflicts with Delaware case law and is against the weight of authority in other jurisdictions. *See Document Generation*, 2009 WL 1766096 at *2 (“The bulk of recent cases, [analyzing this issue], have determined that the confidentiality concerns cited by Defendant[s] are mitigated by the nature of the reexamination process.”) (brackets in original; citation and internal quotations omitted). Xerox therefore requests that the Court enter Xerox's proposed language for Paragraph 2.C of the final Protective Order. (Exh. D at 14.)

Respectfully,

/s/ *Lauren E. Maguire*

Lauren E. Maguire

LEM/dmf
Attachments

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