

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

SKYHOOK WIRELESS, INC.,)	
)	
Plaintiff and)	
Counterclaim-Defendant,)	Case No. 1:10-cv-11571-RWZ
)	
v.)	
)	
GOOGLE INC.,)	
)	
Defendant and)	
Counterclaimant.)	
_____)	

JOINT STATEMENT

Pursuant to Rule 26(f) of the Federal Rules of Civil Procedure, Local Rules 16.1 and 16.6, and the Court's Notice of Scheduling Conference (Dkt. 8), Plaintiff Skyhook Wireless, Inc. ("Skyhook") and Defendant Google Inc. ("Google") hereby submit this Joint Statement for consideration by the Court.

I. DISCOVERY PLAN

1. Initial disclosures

The parties do not propose any changes to the timing, form, or requirement for disclosures under Fed. R. Civ. P. 26(a)(1). The parties have agreed to exchange initial disclosures on December 7, 2010.

2. Subjects on which discovery may be needed

The parties propose that discovery may be needed on at least the following subjects:

- The patents-in-suit and their prosecution;
- The conception, reduction to practice, design, and development of the technology disclosed and/or claimed in the patents-in-suit;

- Ownership or rights in the patents-in-suit;
- The research, development, design, manufacture, and functionality of the accused Google products and/or services;
- Prior art, or potential prior art, to the patents-in-suit and its disclosure to the U.S. Patent and Trademark Office;
- Claim construction;
- Facts relating to Skyhook's claim of infringement;
- Facts relating to Skyhook's claim of willful infringement;
- Facts relating to Skyhook's damages claims;
- Facts relating to Skyhook's claim for injunctive relief; and
- Facts relating to Google's claim that the asserted patents are invalid, not infringed and that Skyhook is entitled to no relief of any kind.
- Any other subject reasonably related to the allegations presented in the lawsuit.

3. When discovery should be completed

In accordance with the parties' proposed pretrial schedule, *see infra* Part II.1, the parties propose that claim construction discovery will be completed by August 30, 2011, fact discovery will be completed by 60 days following the claim construction ruling, and expert discovery will be completed by 125 days following the claim construction ruling.

4. Whether discovery should be conducted in phases or limited to particular issues

Skyhook proposes that discovery should not be conducted in phases or limited to any particular issues. Google proposes that discovery and trial on the legal issues of willfulness and damages be bifurcated from discovery and trial on liability, and that the case proceed first

through the liability phase. The willfulness and damages phase would begin only if Skyhook is successful during the liability phase of the case.

5. Electronically stored information

The parties shall reasonably cooperate to agree upon the scope of discovery for electronically stored information, the format and media for the production of electronically stored information, the procedure for such production, and the issues contained in L.R.

16.6(A)(7).

6. Any issues about claims of privilege or of protection as trial-preparation materials

The parties are attempting to reach agreement on a protective order that will be submitted to the Court, and the parties have agreed that the terms of that protective order, when finalized, and with the approval of this Court, shall govern and be entered in this case. The protective order will address and resolve any issues the parties have regarding claims of privilege or other protections and how to assert such claims after any inadvertent production.

7. Discovery limitations

a. Depositions

Fact Witness Depositions

Skyhook proposes that the limitation of 10 depositions per side imposed by L.R. 26.1(c) apply to all fact depositions, including 30(b)(6) depositions. Because a party could designate multiple witnesses for a 30(b)(6) deposition notice or even an individual 30(b)(6) deposition topic, for the purposes of this limitation, Skyhook proposes that each 30(b)(6) deposition notice will count as one deposition, regardless of the number of 30(b)(6) witnesses a party designates for the topics contained within that deposition notice. Alternatively, Skyhook proposes a limitation of 70 hours of depositions per side for fact depositions, including 30(b)(6) depositions.

Google proposes that the limitation of 10 depositions per side imposed by L.R. 26.1(c) apply to all fact depositions, including 30(b)(6) depositions.

Expert Witness Depositions

The parties also propose that each party may depose each expert for 7 hours if that expert only opines on one issue (e.g., patent infringement, invalidity, or damages), regardless of whether the expert addresses that issue in an opening and/or a rebuttal expert report. Each expert may be deposed for an additional 4 hours if the expert files reports on two or more issues (e.g., patent infringement and invalidity, for a total of 11 hours), regardless of whether the expert addresses those issues in an opening and/or a rebuttal expert report. In the event that an expert submits a supplemental report after the expert's deposition has been taken, the parties shall reasonably cooperate to agree upon a reasonable amount of additional deposition time for that expert if such report is allowed and either of the parties believes it to be necessary to discover the bases for the expert's supplemental report.

b. Requests for production

The parties propose that there is no default limit on either the number of requests for production or the number of sets of requests for production. The parties also propose that any such requests shall be served no later than 45 days before the close of the relevant discovery period (e.g. if the request relates to claim construction, it shall be served 45 days before the close of claim construction discovery).

c. Requests for admission

The parties propose that there is a limit of 100 requests for admissions as to authentication and/or other admissibility issues, but the parties agree to work on a stipulation at the appropriate time to avoid such requests where possible.

d. Date cutoff

The parties have agreed that no party shall be required to identify on its respective privilege log any document or communication created on or after September 15, 2010, which, absent this agreement, the Party would have been obligated to so identify on said privilege log.

e. Expert witnesses

In addition to the protections afforded under Fed. R. Civ. P. 26(b)(4), the parties have agreed that draft expert reports, expert work product, and communications between attorneys and experts in this matter are not subject to discovery, except to the extent that such documents or communications are relied upon for an expert's opinion.

f. Email service agreement

The parties propose that documents not filed electronically with the Court shall be served via e-mail to distribution lists specified by each respective party for itself. The parties will formalize the terms for this e-mail service option in an agreement.

II. LOCAL RULE 16.1 TOPICS

1. Proposed pretrial schedule

Event	Rule	Proposed Date/Deadline
Exchange Initial Disclosures	FRCP 26(a)(1)	December 7, 2010
Scheduling Conference	FRCP 16(b) L.R. 16.1	December 14, 2010
File Preliminary Infringement Disclosure and produce accompanying documents	L.R. 16.6	February 14, 2011 (60 days from Scheduling Conference)
File Preliminary Invalidity and Non-Infringement Disclosures and produce accompanying documents	L.R. 16.6	April 15, 2011 (60 days from Preliminary Infringement Disclosure)
Deadline to join additional parties without leave of Court		May 16, 2011 (30 days from Preliminary Invalidity Disclosures)
Deadline to file amended pleadings		May 16, 2011 (30 days from Preliminary Invalidity

Event	Rule	Proposed Date/Deadline
without leave of Court		Disclosures)
Exchange List of Claim Terms To Be Construed		July 25, 2011 (100 days from Preliminary Invalidity Disclosures)
Exchange List of Proposed Constructions		August 15, 2011 (20 days from List of Claim Terms)
Deadline for claim construction discovery		August 30, 2011 (15 days from List of Proposed Constructions)
Meet and confer to narrow differences in proposed constructions		September 2, 2011
File Preliminary Claim Construction Briefs	L.R. 16.6	September 14, 2011 (30 days from List of Proposed Constructions)
File Reply Claim Construction Briefs	L.R. 16.6	September 28, 2011 (14 days from Preliminary Briefs)
File Joint Claim Construction and Prehearing Statement	L.R. 16.6	October 13, 2011 (15 days from Reply Briefs)
Deadline to amend Preliminary Infringement/Non-Infringement and Invalidity Disclosures	L.R. 16.6	30 days before Claim Construction Hearing
Claim Construction Hearing		Scheduled by the Court
Court's Claim Construction Ruling		Scheduled by the Court
Deadline to amend Preliminary Infringement/Non-Infringement and Invalidity Disclosures (noting whether any infringement or invalidity contentions are withdrawn)	L.R. 16.6	30 days after Claim Construction Ruling
Deadline for fact discovery		60 days after Claim Construction Ruling
Deadline for disclosure of expert testimony on issues for which a party bears the burden of proof	FRCP 26(a)(2)	70 days after Claim Construction Ruling
Deadline for disclosure of rebuttal expert testimony		105 days after Claim Construction Ruling
Deadline for expert discovery		125 days after Claim Construction Ruling

Event	Rule	Proposed Date/Deadline
Deadline to file dispositive motions		145 days after Claim Construction Ruling
Deadline to file <i>Daubert</i> motions		145 days after Claim Construction Ruling

2. Consent to trial by magistrate judge

The parties do not consent to trial by magistrate judge.

3. Filing of motions

Neither party requests a departure from the Court's rules on motions at this time.

4. Certifications

The certifications required under Local Rule 16.1(d)(3) are attached hereto as exhibits A and B.

III. LOCAL RULE 16.6 TOPICS

1. Timing for disclosing initial infringement and invalidity positions

In accordance with the parties' proposed pretrial schedule, *see supra* Part II.1, the parties propose that Skyhook shall file its preliminary infringement disclosure by February 14, 2011, and Google shall file its preliminary invalidity and non-infringement disclosures by April 15, 2011. Google requests that Skyhook shall produce documents evidencing the conception and reduction to practice of the subject matter claimed in the patents in suit and documents evidencing communications with third parties regarding the subject matter of the patents in suit prior to the filing date of the patent with its preliminary infringement disclosures if not produced prior to this date in response to discovery.

2. Process for identifying disputed claim terms, exchanging proposed claim constructions, and claim construction briefing

The parties propose the following with respect to the process for identifying disputed claim terms and exchanging proposed claim constructions:

No later than 100 days after completion of the preliminary disclosures, the parties shall simultaneously exchange a list of claim terms to be construed. The parties shall thereafter meet and confer for the purposes of limiting the terms in dispute.

No later than 20 days after the exchange of the list of claim terms to be construed, the parties shall simultaneously exchange proposed constructions of each term identified by either party. Each party shall also identify all references from the specification or prosecution history that support its proposed construction and designate any supporting extrinsic evidence including, without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses. Extrinsic evidence shall be identified by production number or by producing a copy if not previously produced. With respect to any supporting witness, percipient or expert, the identifying party shall also provide a description of the substance of that witness' proposed testimony that includes a listing of any opinions to be rendered in connection with claim construction.

With the exception of extending the deadlines for exchanging and filing preliminary claim construction briefs and specifying additional disclosures relating to claim construction evidence prior to the briefing, the parties have agreed to conform to the process for claim construction briefing as outlined in Section B of the Sample Special Scheduling Order for Patent Infringement Cases Appendix attached to Local Rule 16.6. The corresponding dates and deadlines for these events are listed in the parties' proposed pretrial schedule. *See supra* Part II.1.

3. Claim construction hearing

- a. Whether the Court will decide claim construction through live testimony at a hearing or based on the papers and attorney argument*

The parties believe that it is too early to determine whether live testimony will be required. The parties expect to address this issue in their joint claim construction and prehearing statement.

b. The timing of claim construction

The dates and deadlines for claim construction are listed in the parties' proposed pretrial schedule. *See supra* Part II.1.

4. The form, scope, and timing of the claim construction tutorial

The parties believe that a tutorial on the relevant technology will benefit the Court. The parties look to the Court for guidance as to the form, scope, and timing of the tutorial. The parties expect to address this issue in their joint claim construction and prehearing statement.

5. The identification of dispositive issues that may lead to an early resolution of the litigation

The parties believe that, at this time, there are no dispositive issues that may lead to an early resolution of the litigation.

6. Whether the Court should authorize the filing under seal of any documents that contain confidential information

The parties request that the Court authorize the filing under seal of any documents that contain confidential information.

7. Electronically stored information

See supra Part I.5.

Dated: December 7, 2010

Respectfully submitted,

By: /s/ Douglas R. Tillberg, Esq.

Thomas F. Maffei (BBO 313220)
tmaffei@gtmlp.com
Douglas R. Tillberg (BBO 661573)
dtillberg@gtmlp.com
GRIESINGER, TIGHE & MAFFEI, LLP
176 Federal Street
Boston, Massachusetts 02110
(617) 542-9900

Morgan Chu (pro hac vice)
mchu@irell.com
John C. Hueston (pro hac vice)
jhueston@irell.com
Samuel K. Lu (pro hac vice)
slu@irell.com
IRELL & MANELLA LLP
1800 Avenue of the Stars, Suite 900
Los Angeles, California 90067-4276
(310) 277-1010

OF COUNSEL:
Glenn K. Vanzura
gvanzura@irell.com
Ofer Bleiweiss
obleiweiss@irell.com
S. Albert Wang
swang@irell.com
Blake B. Greene
bgreene@irell.com
IRELL & MANELLA LLP
1800 Avenue of the Stars, Suite 900
Los Angeles, California 90067-4276
(310) 277-1010

**ATTORNEYS FOR PLAINTIFF
SKYHOOK WIRELESS, INC.**

Dated: December 7, 2010

Respectfully Submitted,

Google Inc.,

By its attorneys,

/s/ Susan Baker Manning, Esq.

Jonathan M. Albano, BBO #013850

jonathan.albano@bingham.com

BINGHAM McCUTCHEN LLP

One Federal Street

Boston, MA 02110-1726, U.S.A.

617.951.8000

William F. Abrams (*admitted pro hac vice*)

william.abrams@bingham.com

BINGHAM McCUTCHEN LLP

1900 University Avenue

East Palo Alto, CA 94303-2223

650.849.4400

Robert C. Bertin (*admitted pro hac vice*)

robert.bertin@bingham.com

Susan Baker Manning (*admitted pro hac vice*)

susan.manning@bingham.com

BINGHAM McCUTCHEN LLP

2020 K Street, NW

Washington, DC 20006-1806

202.373.6000

CERTIFICATE OF SERVICE

I hereby certify that this document filed through the ECF system will be sent electronically to the registered participants as identified on the Notice of Electronic Filing (NEF) and paper copies will be sent to those indicated as non-registered participants on December 7, 2010.

/s/ Susan Baker Manning, Esq.
susan.manning@bingham.com