

UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF MICHIGAN  
SOUTHERN DIVISION

NETJUMPER SOFTWARE, L.L.C.,  
a Michigan limited liability corporation,

Case No. 04-70366-CV  
Hon. Julian Abele Cook  
Magistrate Judge R. Steven Whalen

Plaintiff,

vs.

GOOGLE INC.,  
a Delaware corporation,

Defendant.

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SOMMERS SCHWARTZ, PC  
Andrew Kochanowski (P55117)  
Nabeel N. Hamameh (P60981)  
Attorneys For Plaintiff  
2000 Town Center, 9<sup>th</sup> Floor  
Southfield, MI 48075  
(248) 355-0300

---

DICKINSON WRIGHT, PLLC  
Kathleen A. Lang (P34695)  
L. Pahl Zinn (P57516)  
Attorneys For Defendant  
500 Woodward Ave., Ste. 4000  
Detroit, MI 48226  
(313) 223-3500

BANIAK, PINE & GANNON  
Michael Baniak  
Co-Counsel For Plaintiff  
150 N. Wacker Drive, Suite 1200  
Chicago, IL 60606  
(312) 673-0360

FISH & RICHARDSON P.C.  
Howard G. Pollack  
Attorneys For Defendant  
500 Arguello Street, Ste. 500  
Redwood City, CA 94063  
(650) 839-5070

FISH & RICHARDSON P.C.  
Frank E. Scherkenbach  
225 Franklin Street  
Boston, MA 02110-2804  
(617) 542-5070

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**PLAINTIFF/COUNTER-DEFENDANT'S MOTION TO COMPEL  
COMPLIANCE WITH AGREEMENT TO PRODUCE GOOGLE WITNESSES  
AFTER CLOSE OF DISCOVERY**

Pursuant to Rule 37(a) of the Federal Rules of Civil Procedure, Plaintiff NetJumper Software, L.L.C. (NetJumper"), respectfully moves this Court for an Order Compelling Google Inc. to produce

witnesses for deposition competent to testify on the various Topics in NetJumper's Rule 30(b)(6) Deposition Notice to Google Inc. NetJumper also moves this Court to compel Google Inc. to produce witnesses John Piscetello and Eric Frederickson, who were Google employees during relevant times, and the depositions of which were previously agreed to by Google Inc. NetJumper relies on the attached Memorandum in Support. Pursuant to LR 7.1, Plaintiff/Counter-Defendant has made reasonable attempts to obtain concurrence in the relief sought herein with Google Inc.'s counsel on numerous occasions, but concurrence was not granted.

Respectfully submitted,

Andrew Kochanowski (P55117)  
SOMMERS SCHWARTZ, P.C.  
Attorneys for Plaintiff  
2000 Town Center Drive, Suite 900  
Southfield, MI 48075  
(248) 355-0300  
akochanowski@sommerspc.com

DATED: January 24, 2006

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SOMMERS SCHWARTZ, PC  
Andrew Kochanowski (P55117)  
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Attorneys For Plaintiff  
2000 Town Center, 9<sup>th</sup> Floor  
Southfield, MI 48075  
(248) 355-0300

BANIAK, PINE & GANNON  
Michael Baniak  
Co-Counsel For Plaintiff  
150 N. Wacker Drive, Suite 1200  
Chicago, IL 60606  
(312) 673-0360

---

DICKINSON WRIGHT, PLLC  
Kathleen A. Lang (P34695)  
L. Pahl Zinn (P57516)  
Attorneys For Defendant  
500 Woodward Ave., Ste. 4000  
Detroit, MI 48226  
(313) 223-3500

FISH & RICHARDSON P.C.  
Howard G. Pollack  
Attorneys For Defendant  
500 Arguello Street, Ste. 500  
Redwood City, CA 94063  
(650) 839-5070

FISH & RICHARDSON P.C.  
Frank E. Scherkenbach  
225 Franklin Street  
Boston, MA 02110-2804  
(617) 542-5070

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**MEMORANDUM IN SUPPORT OF PLAINTIFF/COUNTER-DEFENDANT'S  
MOTION TO COMPEL COMPLIANCE WITH AGREEMENT TO PRODUCE GOOGLE  
WITNESSES AFTER CLOSE OF DISCOVERY**

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**STATEMENT OF ISSUES**

WHETHER GOOGLE INC. SHOULD BE COMPELLED TO PRODUCE WITNESSES WHO ARE CAPABLE OF COMPETENTLY TESTIFYING ON TOPICS 1 THROUGH 3, 20 AND 22 CONTAINED IN NETJUMPER SOFTWARE, LLC’S SECOND NOTICE OF RULE 30(B)(6) DEPOSITION NOTWITHSTANDING THAT GOOGLE HAS INDICATED A WILLINGNESS TO PRODUCE SUCH TOPICS.

Plaintiff/Counter-Defendant NetJumper Software, LLC answers “YES.”

WHETHER GOOGLE INC. SHOULD BE COMPELLED TO PRODUCE JOHN PISCETELLO AND ERIC FREDERICKSON PURSUANT TO THE DEPOSITION NOTICES SERVED UPON GOOGLE AND GOOGLE’S PRIOR REPRESENTATIONS THAT IT WOULD MAKE THESE WITNESSES AVAILABLE FOR DEPOSITION AFTER CLOSE OF DISCOVERY.

Plaintiff/Counter-Defendant NetJumper Software, LLC answers “YES.”

## INTRODUCTION

This is an action originally brought by NetJumper Software, LLC (“NetJumper”) against Google Inc. (“Google”) for infringement of patents relating to Internet search navigation. The infringing product at issue is the Google Toolbar which is distributed by Google either directly or through various computer or software manufacturers such as Sony or Real Networks. Consumers obtain the Google Toolbar (which is installed on an internet user’s internet browser, i.e., Microsoft Internet Explorer) either by downloading it directly from Google, through the Google Internet website, or by having it bundled with a new computer or with software that the user obtains from the Internet. Consumers therefore never pay Google directly for the Toolbar. Testimony related to the data concerning these “downloads” is one of the bases for this motion to compel.

On October 11, 2005, NetJumper served its Second Notice of Rule 30(b)(6) Deposition (the “Notice”) setting forth various topics on which NetJumper sought testimony (Please see attached **Exhibit A**). On October 19, 2005, Google served its Objections to the Notice (Please see **Exhibit B**). On July 25, 2005, NetJumper served deposition notices for John Piscetello and Eric Frederickson (Please see **Exhibit C**). The parties had agreed that the Piscetello and Fredrickson depositions would proceed after the close of discovery because Mr. Piscetello was away for several months in 2005, and Mr. Fredrickson had left Google and moved to Seattle. Google told NetJumper it would still represent Mr. Fredrickson in his deposition.

At issue in this motion are Google’s responses to Topics 1 through 3, 20 and 22 to the Notice, as well as Google’s failure to produce John Piscetello and Eric Frederickson for deposition. With respect to Topics 1 through 3, notwithstanding its objections, Google has represented that it would provide competent witnesses to testify on several of these topics, but as of date, has refused to do so. With respect to Topics 20 and 22, Google’s objections are without merit and NetJumper’s motion must be granted.

**1. GOOGLE’S RESPONSES TO NETJUMPER’S SECOND RULE 30(B)(6) DEPOSITION NOTICE ADMIT THAT GOOGLE WOULD PROVIDE A COMPETENT WITNESS TO TESTIFY TO THESE TOPICS**

The specific Topics for examination requested on which Google has indicated that it would produce a witness, but now has refused and/or failed to do so are as follows:

**TOPIC NO. 1** The method of distribution, sales and/or licensing of Google Toolbars to endusers, including the total number of Google Toolbars distributed, sold and/or licensed, and Google's knowledge concerning the amount/number of total Google Toolbar users since inception of the Google Toolbar.

**OBJECTIONS TO TOPIC NO. 1** Google incorporates its General Objections as if each were fully set forth herein and states the following Specific Objections. Google objects to this topic on the ground that the phrases "the total number of Google Toolbars distributed, sold and/or licensed" and "the amount/number of total Google Toolbar users since inception of the Google Toolbar" render the topic vague and ambiguous. Google objects to this topic on the ground that it is overly broad and unduly burdensome to the extent it seeks information not relevant to any claim or defense presented by either party to this litigation. Google objects to this topic on the ground that it is not described with reasonable particularity. Subject to and without waiving the foregoing objections, Google will produce a witness able to testify to the number of Google Toolbars distributed, the method of distribution, and sales and licensing.

\* \* \* \*

**TOPIC NO. 2** The substance of any and all license agreements with any and all manufacturers (e.g., Sony, Dell, Hewlett Packard, Compaq for the Google Toolbar, regardless of whether such agreements are still in effect or the technology no longer employed.

**OBJECTIONS TO TOPIC NO. 2** Google incorporates its General Objections as if each were fully set forth herein and states the following Specific Objections. Google objects to this topic on the ground that the phrase "any and all license agreements with any and all manufacturers" renders the topic vague and ambiguous. Google objects to this topic as overly broad and unduly burdensome to the extent it seeks information not relevant to any claim or defense presented by either party to this litigation, particularly in that it seeks information. "regardless of whether such agreements are still in effect or the technology no longer employed." Google objects to this topic on the ground that it is not described with reasonable particularity. Subject to and without waiving the foregoing objections, Google will produce a witness able to testify to license agreements Google has with computer manufacturing companies for the Google Toolbar.

\* \* \* \*



**TOPIC NO. 3** The number or amount of Google Toolbars downloaded from date of inception through the present.

**OBJECTIONS TO TOPIC N0. 3** Google incorporates its General Objections as reach were fully set forth herein and states the following Specific Objections. Google objects to this topic on the ground that the undefined term "downloaded" renders the topic vague and ambiguous. Google objects to this topic as overly broad and unduly burdensome to the extent it seeks information not relevant to any claim or defense presented by either part)r to this litigation. Subject to and without waiving the foregoing objections, Google will produce a witness able to testify to the number of Google Toolbars obtained from Google over the Internet.

These Rule 30(b)(6) topics are directly related to NetJumper's damages as well as Google's acts of infringement.

As to Topics 1 and 3, Google has failed and/or otherwise refused to produce an individual to testify on these topics despite representations to the contrary. NetJumper has deposed the two witnesses that Google forwarded in response to the Notice, and neither witness would or could testify how many Google Toolbars have been downloaded since Google began distributing the Toolbar. Google should now be compelled to produce a witness competent to testify as to these Topics.

Specifically with respect to Topic 3, Google produced an individual named Alex Pau to testify about the number of Google Toolbars "installed." When asked about the number of Google Toolbars directly downloaded from its servers by internet users (regardless of whether they were actually installed), Mr. Pau testified that he was only able to offer testimony relating to the number of Google Toolbars installed by users, not the greater number downloaded but not necessarily installed. (See **Exhibit D**, which is an excerpt from the deposition of Alex Pau).

Mr. Pau's testimony and his preparation is insufficient. Google never objected that the number of downloads is unknown: it represented it would provide a witness sufficient for Plaintiff to learn how many Toolbars were in fact downloaded. Google must produce a witness competent to testify on Topic 3. If it appears at the deposition that the witness designated by the corporation is unable to answer

questions on matters specified in the deposition notice, a corporate party must immediately designate a new witness. *Marker v Union Fidelity Life Ins. Co.* 125 FRD 121, 126 (M.D. NC 1989). Accordingly, since Alex Pau was unable to testify about the number of Google Toolbar downloads, Google must designate a new witness competent to testify as to this Topic. Moreover, the designation of Alex Pau to testify on this Topic could be deemed improper. (See *Bon Air Hotel, Inc. v Time, Inc.* 376 F2d 118, 121 (5<sup>th</sup> Cir. 1967); *FDIC v Butcher* 116 FRD 196, 201 (E.D. TN 1986) (Designation of deponent with limited knowledge about transactions held improper)).

As to Topic 2, Google similarly never produced a witness competent to testify. It should be compelled to do so. The substance of additional discovery relating to the third-party distribution agreements is set forth below.

**2. GOOGLE’S OBJECTIONS TO TOPICS 20 AND 22 NETJUMPER’S SECOND RULE 30B6 DEPOSITION NOTICE ARE WITHOUT MERIT**

In its Second Notice of Rule 30(b)(6) Deposition, Topics 20 and 22, NetJumper requested a competent witness to testify to the many different agreements through which Google pays third party vendors to distribute its Toolbar. Google’s objections are as follows:

**TOPIC NO. 20** With respect to the following agreements: (1) their contents (2) the number of Google Toolbars downloaded as a result of each agreement, (3) the revenues generated by each agreement, (4) the amounts) paid by Google under each agreement, and (5) the costs associated with each agreement.

- a. The Google Promotion and Distribution Agreement with RealNetworks, Inc, as set forth in G005470-005555.
- b. The Google Toolbar Promotion and Distribution Agreement between Google and Toshiba America Information Systems, Inc., Google's G005556-005568.
- c. The Google Toolbar Promotion and Distribution Agreement between Google and AG, Com., Inc., Google's G005597-005631.
- d. The Google Promotion and Distribution Agreement between Google and Atom Shockwave Corp., Google's G005597-005631.

- e. The Google Toolbar Distribution Agreement between Google and Computer Shopper Magazine, Google's G005632-005637.
- f. The Google Promotion and Distribution Agreement between Google and Cyberlink Corp., Google's G005638-005671.
- g. The Google Promotion and Distribution Agreement between Google and Cyberlink Corp., Google's G005672-005715.
- h. The Amendment to Google Toolbar and Google Desk Bar Promotion and Distribution Agreement between Google and Div-Xnetworks, Inc., Google's G005716-005755.
- i. Google Toolbar Distribution Agreement between Google and Edizioni Master SRL, Google's G005756-005761.
- j. The Google Toolbar Promotion and Distribution Agreement between Google and Fujitsu Computer Systems Corporation, Google's 6005762005773.
- k. The Google Toolbar Promotion and Distribution Agreement between Google and Globalscape Texas, LP, Google's 6005774-005798.
- l. The Google Toolbar Promotion and Distribution Agreement between Google and Hewlett-Packard Company, Google's 6005799-005842.
- m. The Google Toolbar and Google Desk Bar Promotion and Distribution Agreement between Google and IGN Entertainment, Inc., Google's 005843-005883.
- n. The Google Toolbar Distribution Agreement between Google and Sony (including Sony USA, and other Sony entities throughout the world).
- o. The Google Distribution Agreement between Google and the three entities referenced in a letter dated July 21, 2005 from Julie M. Wheeler, litigation case manager, to Nabeel Hamameh.

**OBJECTIONS TO TOPIC NO. 20** Google incorporates its General Objections as if each were fully set forth herein and states the following specific Objections. Google objects to this topic because it seeks testimony on subject matter that is protected by the attorney-client privilege and/or the attorney work-product doctrine. Google further objects to this topic to the extent it is duplicative of Topics Nos. 1, 2 and possibly 9. Google objects to this topic because it is formulated in a compound and confusing manner, with many discrete subparts, and, furthermore, while styled as a Rule 30(b)(6) topic, it appears to be a compound interrogatory.

**TOPIC NO. 22** The rationale, financial analysis, and basis for Google's payments under the above agreements.

**OBJECTIONS TO TOPIC NO. 22** Google incorporates its General Objections and Objections to Additional Topic No. 1 as if each were fully set forth herein and states the following Specific Objections. Google objects to this topic because it seeks testimony on subject matter that is protected by the attorney-client privilege and/or the attorney work product doctrine. Google further objects to this topic to the extent it is duplicative of Topics Nos. 1 and 2. Google further objects to this topic because it is overbroad and not described with reasonable particularity. Google objects to this topic on the ground that the terms "rationale", "financial analysis", and "basis for Google's payments" render the topic vague and ambiguous.

The deposition of witnesses competent to testify as to these Topics is critical to NetJumper's damages. These Topics are also related to Google's perception as to the value of its Toolbar—which incorporates Plaintiff's technology and invention. Google has produced the subject Agreements, but has not produced a witness to testify as to how or why the numbers that Google pays under the Agreements have been set; the decision-making process behind the Toolbar valuation; and associated topics. All of these may be relevant to NetJumper's reasonable royalty damages or to rebut Google's expected contention that the Toolbar has no value to Defendant.

**3. GOOGLE MUST BE MADE TO COMPLY WITH ITS PREVIOUS AGREEMENT TO PRODUCE PISCETELLO AND FREDRICKSON**

Finally, as to the requested depositions of John Piscetello and Eric Frederickson, NetJumper has given Google ample notice and opportunity to produce these witnesses for deposition. Mr. Piscetello was out of town for four months after the notices were served on Google. Google, through numerous letters by its counsel, has agreed to produce these witnesses and never objected to them being taken (**Exhibit E**). As a matter of fact, as recently as January 16, 2006, Google's counsel represented to NetJumper's counsel in a telephone conversation that he could produce John Piscetello on the afternoon of January 26 and that he would look into the availability of Eric Frederickson. For Google to now refuse to produce these witnesses would be nothing short of an act of bad faith.

FRCP 26(b)(1) expressly provides that “[p]arties may obtain discovery regarding any matter, not privileged, that is relevant to the claim or defense of any party . . . . For good cause, the court may order discovery of any matter relevant to the subject matter involved in the action.” As previously stated, the testimony sought is directly related to Google’s acts of infringement, Google’s ill-gotten financial gains from its wrongful and willful infringement, and NetJumper’s resulting damages. Relevance could not be any more clear.

Google contends that it has attempted to offer these witnesses for deposition before the close of discovery, however, there were various issues that kept postponing the depositions, whether counsel for NetJumper was in trial, whether Google’s counsel was unavailable, whether the witnesses were out of town or otherwise unavailable, etc. However, it was understood by counsel for the parties that depositions noticed prior to the close of discovery would be able to proceed upon availability of all counsel and the witness. For Google or its counsel to state otherwise, or attempt to thwart these depositions now because discovery has officially closed, would be a travesty to the effective administration of justice because NetJumper would be essentially precluded from fully pursuing its claims for damages. Understanding that discovery is officially closed, a party may nonetheless obtain relief from the “cut-off” date by demonstrating good cause for allowing further discovery. *Rosario v Livaditis*, 963 F.2d 1013, 1019 (7<sup>th</sup> Cir. 1992). The fact that John Piscetello was out of town until November 15, 2005 is good cause coupled with the various scheduling conflicts of counsel.

**REQUEST FOR RELIEF**

For the forgoing reasons, NetJumper respectfully requests the following relief:

- A. An Order compelling Google to produce a witness competent to testify as to Topics 1, 2, 20 and 22;
- B. An Order compelling Google to produce a witness competent to testify as to Topic 3, and specifically on the number of Google Toolbars “downloaded” regardless whether they are installed;
- C. An Order compelling Google to produce Eric Frederickson and John Piscetello for deposition
- D. NetJumper’s costs and fees incurred for the filing of this motion which was necessitated by Google’s deleterious conduct pursuant to FRCP 37(a)(4)(A).

Respectfully submitted,

Andrew Kochanowski (P55117)  
SOMMERS SCHWARTZ, P.C.  
Attorneys for Plaintiff  
2000 Town Center Drive, Suite 900  
Southfield, MI 48075  
(248) 355-0300  
akochanowski@sommerspc.com

DATED: January 24, 2006

**PROOF OF SERVICE**

I certify that on 1-24-06, I electronically filed the forgoing paper with the Clerk of the Court using the ECF system which will send notification of such filing to the following:

Kathleen A. Lang; klang@dickinsonwright.com  
L. Pahl Zinn; pzinn@dickinsonwright.com  
Michael H. Baniak; baniak@bpplaw.com

and I hereby certify that I have mailed by United States Postal Service First Class Mail the paper to the following non-ECF participants:

FISH & RICHARDSON P.C.  
Howard G. Pollack  
500 Arguello Street, Ste. 500  
Redwood City, CA 94063

FISH & RICHARDSON  
Jason M. Wolff  
12390 El Camino Real  
San Diego, CA 92130

FISH & RICHARDSON P.C.  
Frank E. Scherkenbach  
225 Franklin Street  
Boston, MA 02110-2804

s/Andrew Kochanowski (P55117)  
Sommers Schwartz, PC  
2000 Town Center, Suite 900  
Southfield, MI 48075  
(248) 355-0300  
akochanowski@sommerspc.com