UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

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

Plaintiff,

v.

GOOGLE INC.,
a Delaware corporation

Defendant.

Civil Action No. 04-70366-CV
Hon. Julian Abele Cook, Jr.

Magistrate Judge R. Steven Whalen

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DEFENDANT GOOGLE INC.'S REPLY BRIEF IN SUPPORT OF ITS EMERGENCY MOTION FOR LEAVE TO TAKE THE DEPOSITION OF RANDALL STARK

NetJumper's opposition to Google's motion is misdirection. First, nowhere in its papers does NetJumper articulate any basis by which it might be prejudiced if Dr. Stark's trial testimony is taken now rather than at trial other than the mysterious route by which it has calculated the distance between Detroit and Bellevue on one hand, and England and Detroit on the other: Seattle and Cambridge are nowhere near "approximately the same distance" from Detroit.[1] Second regarding NetJumper's proposed alternative of taking Dr. Stark's testimony in England closer to trial, Google does not object to this, however logistical issues may preclude it. These include coordinating time in the United States embassy there, and if an agreement can be made to do this outside of the United States embassy, then administering the oath, which may also be problematic—in short, there would need to be an agreement from NetJumper that Dr. Stark's testimony could not be challenged on these grounds. Providing Dr. Stark at trial via live video testimony is a creative solution, but given the same logistical issues, the five hour time difference, and additional equipment and technical challenges, including review of computer demonstrative exhibits and physical evidence, this is impractical too. In short, the simplest and most convenient solution is to take Dr. Stark's deposition now while he is still in the United States and before he has begun his studies. We now turn to NetJumper's remaining arguments.

Regarding NetJumper's first argument, Google does not dispute that fact discovery closed on October 24, 2005; this is why Google sought leave to take Dr. Stark's deposition.[2] The point NetJumper misses is that throughout fact discovery Google had absolutely no reason to take the deposition of ***its own cooperating trial witness***. Had Google known prior to October 24,

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[1] *See* NetJumper's Opposition, at 3. According to Expedia.com, the shortest non-stop flight from Detroit to Seattle (Bellevue is a suburb of Seattle) is 1927 miles and takes 4 hours, 45 minutes. However, the shortest non-stop flight from London to Detroit is 3755 miles and takes 8 hours, 35 minutes. *See, e.g.,* Exhibit 7. Cambridge is approximately 75 miles from London.

[2] It is disappointing that NetJumper would object on this basis because, among other reasons, Google has permitted NetJumper to take two depositions after the close of discovery, even though there was no reason NetJumper could not have taken them during the discovery period. The most recent was a third-party witness John Piscitello, who was deposed on June 2, 2006, even though NetJumper cancelled its timely noticed deposition of Mr. Piscitello during the discovery period.

2005 that Dr. Stark would be unavailable during the scheduled trial (at that time trial was scheduled for March 7, 2006—when Dr. Stark would still be in the United States), it would have deposed him immediately to preserve his trial testimony. The issue at hand arose because of events that transpired after discovery closed, which are explained in Google's moving papers.[3] As soon as it became clear that Dr. Stark would not be available to attend trial due to his academic commitments outside of the United States, counsel for Google promptly notified counsel for NetJumper in an effort to reach agreement on a deposition schedule.[4]

On this point, NetJumper's reliance on Fed. R. Civ. P. 26(b)(2) is misplaced. Rule 26(b)(2) mandates that the court may curtail otherwise permissible discovery if the party seeking it "has had ample opportunity. . . to obtain the information sought." NetJumper's application of this section suffers from two problems: (1) the Court is ***not*** being asked to ***curtail*** discovery pursuant to Rule 26 but rather to ***grant*** an emergency motion that would ***allow*** discovery; and (2) as explained above, Google has ***not*** had ample opportunity to obtain the information it seeks, since it had no logical reason to seek such discovery of it own witness until it became clear that it had no choice but to do so. NetJumper's citation to language in a 1968 Supreme Court case referring to a "fully adequate opportunity for discovery" is perplexing.[5] Again, because Google had no reason to depose its own trial witness until now, due to events that have arisen since discovery closed—including the new trial date given by the Court on May 25, 2006, Google cannot be said to have had a fully adequate opportunity to take this critical testimony.[6]

Turning to NetJumper's second argument and its rose-colored view of the record, Dr. Stark's testimony, which concerns the prior art (primarily CyberPilot), is highly relevant to

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[3] Because NetJumper seems to challenge the veracity of counsel for Google's representations to the Court, it has attached a declaration and certificate of admission from Dr. Stark as Exhibits 8 and 9 respectively.

[4] If the trial date were moved to a date after Dr. Stark returns to the United States, something Google does not oppose, there may be no issue with regard to Dr. Stark's availability.

[5] *See First Nat'l Bank of Ariz. V. Cities Serv. Co.*, 391 U.S. 253, 290-299 (1968). Google has been unable to locate the particular quotation cited by NetJumper.

[6] *See* Exhibits 8 and 9.

Google's contention that the patents-in-suit are invalid. Google's summary judgment of invalidity was not denied because it had no merit, as NetJumper suggests, rather it was denied because the battling expert declarations made it unclear to the Court how to resolve the factual issues.[7] That the Court denied Google's summary judgment motion because the "differences of opinions among the experts strongly demonstrate[d] that the issue of anticipation is not ripe for a summary judgment"[8] in no way undermines Google's contention—which it intends to put forward at trial—that CyberPilot not only invalidates the patents-in-suit, but that NetJumper improperly withheld this material information from the United States Patent & Trademark Office thereby making the patents-in-suit unenforceable too. Without Dr. Stark's explanation of the creation and operation of CyberPilot, and his authentication of its underlying documentation and operating software, Google will be badly prejudiced in its ability to present its case. Of course, this is why NetJumper so vigorously opposes Dr. Stark's testimony.

Lastly, Google is ***not*** moving to make a wholesale re-opening of fact discovery but rather to take one trial witness's testimony now in lieu of his appearance at trial. This is standard practice in federal courts, including in this district.[9] Instead, it is ***NetJumper*** that seeks a blank check to re-open discovery to take numerous—although unidentified and unexplained—depositions.

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[7] If Google's invalidity and unenforceability arguments related to Dr. Stark's CyberPilot prior art had no merit, NetJumper surely would have filed its own motions for summary judgment of validity and enforceability. It did not.

[8] Order of March 29, 2006, at 10 (Document No. 84).

[9] *See* FRCP 32(a)(3)(B) and *In re Air Crash Disaster at Detroit Metropolitan Airport on Aug. 16, 1987*, 130 F.R.D. 647, 650-51 (E.D. Mich. 1989) (Cook, J.) (holding that the Federal Rules authorize "the use of deposition testimony at trial as the sole means of adducing testimony from a witness outside the subpoena power of the Court" and finding that the witnesses were indeed outside that subpoena power).

For the above reasons, Google requests that its motion be granted.

Respectfully submitted,
FISH & RICHARDSON P.C.

Dated: July 31, 2006

By: /s/ Jason W. Wolff

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CERTIFICATE OF SERVICE

I hereby certify that on July 31, 2006, I electronically filed DEFENDANT GOOGLE INC.'S REPLY BRIEF IN SUPPORT OF ITS EMERGENCY MOTION FOR LEAVE TO TAKE THE DEPOSITION OF RANDALL STARK, together with its attached Exhibits 7-9, with the Clerk of the Court using the ECF system, which will send notice of such filing upon the following attorneys: ANDREW KOCHANOWSKI and MICHAEL H. BANIAK.

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