

EXHIBIT E

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

J.T. COLBY & COMPANY, INC.
d/b/a BRICK TOWER PRESS,
J. BOYLSTON & COMPANY
PUBLISHERS LLC, and
IPICTURES LLC,

Plaintiffs,

vs.

Civil Action
No. 11-cv-4060 (DLC)

APPLE, INC.,

Defendant.

-----)

VIDEOTAPED DEPOSITION OF

JACOB JACOBY, Ph.D.

New York, New York

Thursday, December 6, 2012

Reported by:

SHAUNA STOLTZ-LAURIE

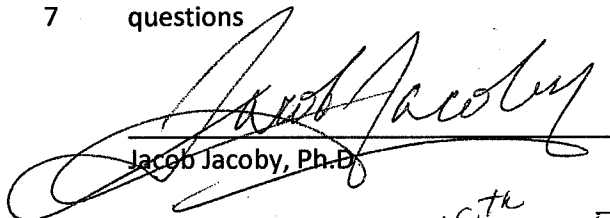
Ref: 8576

ERRATA SHEET FOR DEPOSITION OF
JACOB JACOBY, PH.D.
Thursday, December 6, 2012
In the Matter of
J.T. COLBY ET AL. V. APPLE, INC.

<u>Page</u>	<u>Line</u>	<u>Change from:</u>	<u>Change to:</u>
8	20	understand – or I	understand I
13	17	with	with all
16	6	Advanced	Advance
21	2	question.	criticism.
21	8	answer	ask
21	15	the case and	the case, not
22	17	report	reports
28	5	the serial	the survey
28	12	survey	surveys
30	10	Stamford	Stanford
31	7	specification	specialization
51	10	amending a	amending of a
65	2	says it	says "it
65	3	weapons,	weapons,"
65	4	bin Laden has nuclear weapons	"bin Laden has nuclear weapons"
65	5	it's	"it's
65	6	weapons.	weapons."
72	19	20102	2010
73	24	their	they're
83	20	writing the	writing a
83	21	that	this
88	13	dwarT	dwarf
91	23	(inaudible)	name for my students as
131	22	MR. RASKOPF	MS. BOGDANOS
134	17	(inaudible)	place
144	25	McDonald's.	McDonald's report.
145	16	avast	a vast ---
145	17	have a confusion	have an opinion
146	13	amounts in cognitive (inaudible)	areas in cognitive and social psychology
150	4	reaching	repeat
151	18	screen	screener
152	21	be in	be represented in
153	22	couldn't be	could be
154	14	Edvardi (ph.) 702	at FRE 702
156	14	properly and	properly conducted and
157	4	principle	principal
157	21	pocket	pockets
158	7	take	make
160	7	long	wrong
171	6	an M.	a noun.
183	13	member	memory

<u>Page</u>	<u>Line</u>	<u>Change from:</u>	<u>Change to:</u>
185	12	not in it	not do it in
190	2	it's not an	it's an
192	6	manual	handle
199	6	month	many
199	15	the books.	the book
202	12	Misouri	Suri
212	20	grade	read
212	21	his name. This	his name ... this
216	15	a he ever ready	the Eveready
216	24	ready	Ready
217	22	Jerry V Swan	Jerre B Swann
217	24	Jerry	Jerre
217	25	Jerry	Jerre
221	3	and the	and looked at the
225	13	defendant, and plaintiff	plaintiff, and defendant
225	19	Plaintiff.	Defendant.
229	24	think ibooks	think ibooks is realted to ibooks
235	25	or _ , right?	or put out, right?
236	3	but the	but asking about the
239	16	publishing	publisher
239	22	there is synonymous	they're synonymous
245	22-23	sub institutes	substitutes
246	2	seemed	seem
251	15	Jerry Swan's	Jerre Swann's
251	20	squirt	Squirt
254	4	delaying	using
254	9	tracks the section	tracks Section
259	3	the need	the "need
259	4	formulation than that did get	formulation" than the "did get
		Formulation	formulation"
259	16-17	supreme court	Supreme Court
259	25	did A	"did A
260	2	vice versa	vice versa"
260	23	how I	how she
261	8	I don't	you don't
263	24	right	write
264	3	oh	so
264	22	out i prior	out a priori
264	24	be in	at the end
270	9	no opinions,	no opinions,"
272	18	which is.	which is
272	19	Software but	software. But
273	4	Do you	"Do you
282	18	hope	note
295	21	whose	who
297	25	been chief	been Editor-in-Chief

<u>Page</u>	<u>Line</u>	<u>Change from:</u>	<u>Change to:</u>
298	7	question does	question "does
298	8	source,	source,"
298	11	denominator	anonymous
304	3	won't	wasn't
340	21	another	they're
341	12	which is	which is not
351	17	field-research-validated	Field Research validated
365	19	express	expressed
366	4	surveyors	surveys
369	21	that identified	that I identified
378	6	"The?	"The"
379	12	things	thinks
385	2	did see	didn't see
388	23	to	two
389	3	have you	have I
391	17	Ob	On
395	19	MS. RASKOPF	MS. CENDALI
395	22	MS. RASKOPF	MS. BOGDANOS
403	6	ask any	offer any
403	7	questions	opinions


 Jacob Jacoby, Ph.D.

Subscribed and sworn to before me this 18th day of Dec, 2012

Sheryl D. Limpert
 state of New York, County of New York

SHERYL D. LIMPert
 Notary Public, State of New York
 No. 01LI5072374
 Qualified in New York County
 Commission Expires Jan. 27, 2015

1 Jacoby

2 Q. Were you first contacted about this
3 case in the context of doing a rebuttal
4 report?

5 MR. RASKOPF: Objection to the
6 form.

7 A. I was not asked to do a survey, so
8 I -- you know, presumably was in the context
9 of doing a rebuttal report.

10 Q. Well, who contacted you about this
11 case?

12 A. I think initially it was Ms.
13 Bogdanos.

14 Q. And what was said in that initial
15 conversation?

16 A. Go through the normal conflicts
17 checks, and I had no conflict. Most
18 likely -- well, I don't know exactly what was
19 said.

20 I can tell you what most likely was
21 said. Would you like me to tell you that?

22 Q. Sure.

23 MR. RASKOPF: Don't guess, Jack. I
24 you can say --

25 Q. Your -- your best recollection.

1 Jacoby

2 A. Well, that ibooks online,
3 Plaintiffs' ibooks online, and defendants use
4 the term iBooks for its app and -- online,
5 and that's where the overlap is.

6 Q. Can you get any of Plaintiffs'
7 books on Defendant's app?

8 A. I don't believe so.

9 Q. Okay. Apple doesn't use the mark
10 iBooks as an imprint on books, does it?

11 MR. RASKOPF: Objection to the
12 form.

13 A. You know, it's interesting, you
14 asked me before about when plaintiff started
15 using I -- lower case I capital B. If I
16 remember reading material in this case, there
17 came a point where defendant stopped using
18 iBooks in the way that would have fostered --
19 I don't remember specifics -- could have
20 fostered greater confusion (speaking
21 simultaneously) --

22 Q. Did you discuss that with counsel
23 during the break, and did they tell you to
24 make that comment?

25 A. Absolutely not.

Jacoby

expert should not deprive respondents of contextual clues that might be helpful to them one way or the other in assessing confusion?

A. I do.

MS. BOGDANOS: Objection.

(Discussion off the record.)

Q. Now -- now, in your report, paragraph ten again that we're still talking about, Exhibit 3, you say at the end of that paragraph "I am of the opinion that while point of sale confusion may occur, it is post sale confusion that is more likely." Do you see that?

A. I do.

Q. What is your basis for your view that point of sale confusion is more likely?

A. No. I think I said post sale is more likely.

Q. Forgive me.

What is the basis for your view that post sale confusion is more likely than point of sale confusion?

A. My own experience, and the way I

1 Jacoby

2 where it says "The nature of Apple's business
3 suggests that the present matter more likely
4 times of confusion with confusion as to
5 affiliation, association, or connection and
6 confusion as to sponsor PIP authorization or
7 permission." Do you see that?

8 A. Yes.

9 Q. What's your basis for that
10 statement?

11 A. Well, they might not think Apple
12 was the publisher of a book, I think, because
13 of the iBooks that is used by Apple -- well,
14 you didn't study that here. I -- I think
15 that given the "i" with the book, that as you
16 said before, that's the paradigm that Apple
17 uses, they would think that there was some
18 kind of relationship or business connection
19 between them. By the way this -- this really
20 is important and it has nothing to do with
21 this case and I just want to make you feel
22 good because it makes me feel good and that
23 is there is research that shows the longer
24 the sentences you right if they're correct
25 sentences, the less likely you are to get

1 Jacoby

2 the whole thing.

3 Q. Um-hm.

4 A. But that then gives me all the more
5 reason to think that people upon coming --
6 first you have the iBook by Apple, which was
7 hardware. Now you have the iBook which is a
8 software application and you have the iBook
9 which is plaintiffs' mark for its books. I
10 think give that Apple's prior use of iBook
11 for hardware coupled with its use of iBook
12 for an app would make it more likely that
13 there would be confusion.

14 Q. But isn't it true that if consumers
15 thought of Apple because when it saw the --
16 the imprint iBooks because of Apple's prior
17 use of iBook or because Apple had a family of
18 marks with "i" something else, those would be
19 not probative of the -- whether the marking
20 issue has led to confusion?

21 A. Which then leads me to think that
22 an "i" something might not be an appropriate
23 control. We were talking before about using
24 "i", ilit or whatever, "i", full word, as a
25 control. Perhaps under those circumstances,

Jacoby

you would need to use something like a generic "ebook" or something else as a control, because the "i" by itself would be sufficient to elicit an Apple response among controls.

Q. And did you discuss your --

A. Controls' response.

Q. -- testimony with counsel --

(Discussion off the record.)

Q. Did you discuss your prior testimony on this subject with counsel during the break?

A. We discussed a lot of my testimony.

On this part? Tangentially.

Q. And were you advised that your testimony about how ebooks would not be a good control, was harmful to Plaintiffs' case, because Dr. McDonald used "ebooks" as her control?

A. Don't know what the -- again, they kept me carefully shielded from what Dr. McDonald has done.

Q. So you didn't read that portion of Dr. Nowlis's report that you read and

1 Jacoby

2 A. Right.

3 Q. Dr. Jacoby, have you ever in the
4 course of this litigation or in the course of
5 any litigation that we've worked on together
6 instructed you to take a position with which
7 you did not agree?

8 A. Never.

9 Q. Has Mr. Raskopf?

10 A. Never.

11 Q. Have I ever in the course of this
12 litigation, as an example, provided you with
13 information for your consideration that you
14 might not have previously thought of?

15 A. Yes.

16 Q. In connection with this case, did
17 you ever study what would have been an
18 appropriate control to use, the selection of
19 a control?

20 A. The question is did I ever do a
21 thorough consideration? Did I do an analysis
22 of what was (speaking simultaneously) --

23 Q. Yes. I apologize for the word
24 study. That's misleading in this context.
25 Yes.

1 Jacoby

2 A. I did not.

3 Q. If you were informed that some
4 people might consider the term ibooks to be a
5 shorthand reference for Internet books, would
6 that in any way affect what you consider to
7 be an appropriate control in this case?

8 A. I think I'd have to think about
9 that some more, but maybe it would require a
10 different kind of control than something with
11 the -- the letter "i" -- lower case "i"
12 beforehand.

13 Q. What would your opinion be of
14 "iNotes" as a control in this case?

15 A. I think that would get very close
16 to suggesting maybe Apple.

17 Q. How about "iPrinters"?

18 A. It might suggest a product from
19 Apple.

20 Q. How about "iFries"?

21 A. No, I don't think so.

22 Q. Why not?

23 A. It's not in the context of
24 hardware. It has nothing to do with the
25 Internet.

1 Jacoby

2 Well, you know, then again, iFries
3 it's a food, an Apple is a food. It's remote
4 possibility somebody might make an
5 association, but I think much less likely
6 than --

7 What were your examples, iNotes --

8 Q. IPrinters.

9 A. -- an iPrinters? Right.

10 Q. So would you consider "iFries" to
11 be an appropriate control in this case?

12 MS. CENDALI: Objection.

13 A. More so than iNotes or iPrinter,
14 much more so because of its distance. It's
15 not in the same category of goods. I -- I
16 don't know if iFries is a food.

17 Ob the other hand iAppple refers to
18 a fruit, I think the iPear as an example of
19 being a problem. But I'd have to think that
20 through. I haven't. What you have to do
21 with controls is really think them through.

22 Q. Okay. Apart from the issue of 'i"
23 as -- as registering Apple potentially for
24 people, if there was an underlying issue that
25 "i" might register the word Internet for

1 Jacoby

2 people, can you think of a control that might
3 be appropriate?

4 And we'll go back to your
5 testimony.

6 Is this an example where ebooks
7 might be an appropriate control to weed out
8 the concept of "i" as being shorthand for
9 Internet?

10 MS. CENDALI: Objection, leading.

11 A. It might be, and I think, you know,
12 in some ways analogous to what Dr. Jay did
13 with her X control, using some other letter.

14 But, again, I'd want to think that
15 one through.

16 Q. You're not criticizing Dr. Jay for
17 the X books control, are you?

18 A. No, not at all.

19 Q. Have you ever been retained by
20 Kirkland & Ellis?

21 A. Yes.

22 Q. In a litigation?

23 A. I did two -- two things for the New
24 York office. I've done stuff for the Chicago
25 office. One of the things I did for the New

1 Jacoby

2 A. I would say it definitely is
3 fiction.

4 Q. And turning to page 35 of the same
5 exhibit, the reproduced page, could you read
6 for me, please, the first sentence?

7 A. Oh. This book is a work of
8 fiction.

9 Q. Thank you.
10 You weren't asked to comment or
11 evaluate the issue of secondary meaning in
12 this case, were you?

13 A. Correct.

14 Q. Have you ever examined the strength
15 of Plaintiffs' mark?

16 A. No.

17 Q. Have you ever surveyed niche
18 science fiction readers in connection with
19 their recognition of Plaintiffs' mark?

20 A. No.

21 MS. BOGDANOS: I have no further
22 questions.

23 BY MS. CENDALI:

24 Q. Dr. Jacoby, did you know that
25 counsel was going to ask you questions at the

1 Jacoby

2 end of my exam?

3 A. I did.

4 Q. Did she give you a preview of what
5 she was going to ask?

6 A. Not really. She said she would
7 have some questions.

8 Q. Did she tell you that she was going
9 to go back and ask you more questions about
10 the control because you gave lots of
11 admissions she didn't like?

12 MS. BOGDANOS: Objection.

13 A. Absolutely not!

14 Q. Let's talk about exhibit or
15 appendix E to your corrected report. That's
16 the one that counsel just asked you about,
17 The Dawn of Amber. Is that right?

18 A. Yes.

19 Q. And that's the books that when I
20 questioned you earlier today, you identified
21 as a hard copy book --

22 MS. BOGDANOS: Objection.

23 Q. -- that you are now saying from
24 counsel's questions you think it might be
25 pages of an electronic book; is that right?