

EXHIBIT E

1 HIGHLY CONFIDENTIAL
2 IN THE UNITED STATES DISTRICT COURT
3 FOR THE SOUTHERN DISTRICT OF NEW YORK

4 J.T. COLBY & COMPANY, : Case Number
5 INC. d/b/a BRICK TOWER : 11-CV-40260
6 PRESS; J. BOYLSTON & : (DLC)
7 COMPANY, PUBLISHERS LLC :
8 and IPICTUREBOOKS :
9 LLC, :
10 Plaintiffs, :
11 vs. :
12 APPLE, INC., :
13 Defendant. :

14 - - -
15 October 3, 2012
16 HIGHLY CONFIDENTIAL

17 - - -
18 Videotaped deposition of GLENN
19 GUNDERSEN, ESQUIRE, taken at the offices of
20 Veritext National Court Reporting Company,
21 1801 Market Street, Suite 1800, Philadelphia,
22 Pennsylvania 19103, beginning at 9:24 a.m.,
23 before LINDA ROSSI RIOS, RPR, CCR and Notary
24 Public.

25 - - -
26 VERITEXT NATIONAL COURT REPORTING COMPANY
27 MID-ATLANTIC REGION
28 1801 Market Street - Suite 1800
29 Philadelphia, Pennsylvania 19103

1 GLENN GUNDERSEN, ESQUIRE - HIGHLY CONFIDENTIAL
2 we're describing.

3 Q. In the case of your trademark
4 clearance work on the iBooks potential mark,
5 did Dechert's opinion concerning that
6 clearance work constitute a series of
7 e-mails?

8 A. Yes.

9 Q. Did it also include telephone
10 conversations?

11 A. Yes.

12 Q. When was -- withdrawn.
13 What was the date of the last
14 e-mail in the series of e-mails that
15 constituted Dechert's opinion concerning the
16 iBooks potential mark?

17 A. There was probably an e-mail
18 sometime in February.

19 Q. So the final e-mail in a series
20 of e-mails constituting Dechert's opinion
21 concerning the iBooks trademark clearance
22 work took place after the announcement of the
23 availability --

24 MS. CENDALI: You know, I'm
25 ready to object.

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2 at the point that were on amazon.com?

3 Q. My testimony is not relevant to
4 this deposition. I'll represent to you that
5 they were there, but that's irrelevant.
6 What's relevant is whether you searched there
7 and you don't know. Right?

8 A. Amazon.com and other retail Web
9 sites have a number of issues in searching.
10 There are a great deal of -- there's a great
11 deal of merchandise that shows up on Amazon
12 and other places that is the online
13 equivalent of a card table at a flea market.
14 Old stock, overstock, leftover merchandise
15 that somebody has that they've put for sale
16 on the Internet. And Amazon is something
17 that we might look at from time to time, but
18 it is not strongly indicative that a mark is
19 actually in current use as a search tool.

20 Q. I'm going to -- I very much
21 appreciate your enthusiasm for the subject
22 matter and the extent of your expertise.
23 That being said, I need you to focus on my
24 questions because my time grows short and I'm
25 trying my best to ask you very focused

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2 questions.

3 Is it true that to the best of
4 your knowledge, you don't know whether Apple
5 or anyone acting on Apple's behalf searched
6 amazon.com in the course of the iBooks
7 trademark clearance search?

8 A. At this point, more than two
9 years later, I don't know if we searched
10 Amazon as part of this clearance project. We
11 look at Amazon and other retail sites
12 frequently, but we have doubts and
13 reservations about what we find on there
14 because most of what we find is not
15 representative of current use in commerce.

16 Q. So it is your testimony that
17 you look at amazon.com sites frequently?

18 MS. CENDALI: Objection.

19 THE WITNESS: No, I said retail
20 sites. It depends on -- I'll clarify,
21 you don't have to read that. We do
22 look at retail sites. I consider
23 Amazon to be a retail site. But they
24 are -- have shortcomings as search
25 tools because they contain vast

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2 amounts of merchandise that does not
3 represent current use in the
4 marketplace. So we are looking to
5 find evidence of current use in
6 commerce.

7 BY MR. CHATTORAJ:

8 Q. Is it your position that retail
9 sites do not provide evidence of current use
10 in commerce?

11 A. I didn't say that.

12 Q. I'm asking you the question.

13 A. Retail sites can sometimes
14 provide evidence of use in commerce, but they
15 generate a large number of what I would refer
16 to as false positives. Products that may be
17 listed there, products that may be overstock,
18 products that are not actually representing
19 current use of the trademark in commerce and
20 products that often when you attempt to
21 purchase them, turn out not to be available,
22 so they're --

23 Q. I move to strike all of the
24 testimony subsequent to the first sentence of
25 Mr. Gundersen's answer. I apologize, but

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2 days. Right?

3 A. Yes.

4 Q. I'll represent to you that this
5 document was obtained from the New York State
6 Department of State, Division of
7 Corporations, and it constitutes a
8 certificate of assumed name that was filed.
9 Was this document identified in the course of
10 Apple's and those -- withdrawn.

11 Was this document identified in
12 the course of the trademark clearance search
13 for the iBooks mark?

14 A. I don't believe it was.

15 Q. Were assumed name registries
16 searched in the course of the trademark
17 clearance search for the iBooks mark?

18 A. If assumed names were part of
19 the a state trademark registration database,
20 they would have been included. Assumed name
21 registries are not -- were not separately
22 searched.

23 Q. Are assumed name registrations
24 a part of New York State's trademark
25 registration files?

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2 A. I can't tell you specifically
3 which ones we would have searched.

4 Q. Were any other databases
5 searched?

6 A. Yes.

7 Q. But you don't know which ones?

8 A. There would be ample
9 information of what was searched and found in
10 the advice to the client.

11 Q. What searches were reflected in
12 your communication with the client?

13 A. That information is in the
14 opinions to the client.

15 MS. CENDALI: Okay. Instruct
16 you not to answer about privilege
17 communications with the client.

18 MR. CHATTORAJ: Because Apple is
19 not relying on advice of counsel
20 defense. Right?

21 MS. CENDALI: Correct.

22 BY MR. CHATTORAJ:

23 Q. Let's just make a record.
24 Please describe to me the search query
25 results that were contained in your

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2 admissibility of Gundersen Exhibit 9 are
3 preserved, but I'll just ask questions based
4 on my representation that this is a photocopy
5 of the book. Is that acceptable?

6 MS. CENDALI: Okay.

7 BY MR. CHATTORAJ:

8 Q. Was this book published in
9 2000?

10 A. I believe it was.

11 Q. Did you update the contents of
12 the book at any time after 2000?

13 A. The book is a bound book.
14 There is no third edition of the book.

15 Q. So the answer is there is no
16 published updates of this book although
17 you've written other articles yourself?

18 A. There are no published updates
19 of this book. If there were to be a third
20 edition, the technology would likely be
21 different. We've had discussions about that.

22 Q. Please turn to page 111 of your
23 book. This page appears in the chapter
24 entitled: "Evaluating the Search Report."
25 In this paragraph number 2 which appears at

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2 the top of page 111, the last two sentences
3 read: "Compliance with fictitious name
4 statutes does not convey any substantive
5 rights, but fictitious names are a useful
6 source of common law marks. Unfortunately,
7 only certain states' fictitious names
8 registrations are included in state
9 registration databases."

10 Did I read that accurately?

11 A. You did read that accurately.

12 Q. I take it that those two
13 sentences reflected your views of this issue
14 in the year 2000. Is that right?

15 A. They did.

16 Q. Has your view changed since
17 that time?

18 A. Well, I think I would not say
19 fictitious names are a useful source of
20 common law marks because of fictitious name
21 filing, as I've said before, does not -- is
22 not evidence that a mark is actually being
23 used in commerce.

24 Q. Were fictitious name filings
25 evidence of a use of commerce in 2000?

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2 A. No.

3 Q. Why did your view change?

4 A. My view here is probably not
5 fully stated as I stated it now.

6 Q. So now you think that the
7 sentence "compliance with fictitious name
8 statutes does not convey any substantive
9 rights, but fictitious names are a useful
10 source of common law marks" is false.
11 Correct?

12 MS. CENDALI: Objection.

13 THE WITNESS: No, I'm not saying
14 it's false. I'm saying it's
15 incomplete.

16 BY MR. CHATTORAJ:

17 Q. You testified previously that
18 you think you would not say fictitious names
19 are useful sources of common-law marks.
20 Right?

21 A. If I were to rephrase this, I
22 would say fictitious -- I would not say that
23 they are a useful source of common-law marks
24 to the extent that that sentence may imply
25 that the existence of a fictitious name

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2 filing creates common-law rights.

3 Q. Understood. However, is it
4 your view that fictitious name databases or
5 registrations are useful in conducting a
6 search for common-law marks?

7 A. Well, the context here is to
8 say that if you are searching in some states,
9 you may be getting fictitious name
10 registrations. There is no recommendation
11 here to go beyond that and search all 50
12 states.

13 Q. I understand that there's no
14 recommendation contained in this text that a
15 trademark professional review fictitious name
16 databases in all 50 states. My question is,
17 is it still your view that fictitious name
18 registrations are a useful source of
19 information in searching for common-law
20 marks?

21 A. My current view is the one that
22 I just stated.

23 Q. Please turn to the following
24 page, page 112. There are several bullet
25 points here concerning abandoned marks. The

STATE OF NEW YORK)
 ss:
 COUNTY OF NEW YORK)

I wish to make the following changes, for the following reasons:

PAGE	LINE	
<u>35</u>	<u>13</u>	CHANGE FROM: <u>corporate</u> CHANGE TO: <u>Corporate and</u> REASON: <u>Transcription error.</u>
<u>89</u>	<u>5</u>	CHANGE FROM: <u>event</u> CHANGE TO: <u>advent</u> REASON: <u>Transcription error.</u>
<u>106</u>	<u>21</u>	CHANGE FROM: <u>have</u> CHANGE TO: <u>has</u> REASON: <u>Transcription error.</u>
<u>119</u>	<u>20</u>	CHANGE FROM: <u>may in</u> CHANGE TO: <u>May be in</u> REASON: <u>Transcription error.</u>
<u>172</u>	<u>5</u>	CHANGE FROM: <u>well,</u> CHANGE TO: <u>Well,</u> REASON: <u>Transcription error.</u>
<u>179</u>	<u>21</u>	CHANGE FROM: <u>wet</u> CHANGE TO: <u>whet</u> REASON: <u>Transcription error.</u>
<u>196</u>	<u>16</u>	CHANGE FROM: <u>of</u> CHANGE TO: <u>the</u> REASON: <u>Transcription error.</u>
<u>199</u>	<u>15</u>	CHANGE FROM: <u>If when</u> CHANGE TO: <u>When</u>

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2 - - - - -

E R R A T A

3 - - - - -

PAGE LINE CHANGE

4 246 23 presentations

5 Reason for "

6 Change: change presentation" to plural

7 256 4 opinion

8 Reason for

9 Change: change from "bin"

10 297 6/7 Actually the

11 Reason for

12 Change: reverse order from "the actually"

13 297 12 is

14 Reason for

15 Change: add "is" between "other" and "TDR"

16 8 5 Beech

17 Reason for

18 Change: chang from "Beach"

19 - - - - -

20 Reason for

21 Change: - - - - -

22 - - - - -

23 Reason for

24 Change: - - - - -

25

REASON: Transcription error.

218

12

CHANGE FROM: began back

CHANGE TO: began, back

REASON: Clarification.

221

3

CHANGE FROM: a lot choices

CHANGE TO: a lot of choices

REASON: Transcription error.

225

17

CHANGE FROM: formal

CHANGE TO: Former

REASON: Transcription error.

252

17

CHANGE FROM: You

CHANGE TO: It

REASON: Transcription error.

254

14

CHANGE FROM: Hall

CHANGE TO: Hal

REASON: Transcription error.

269

17-18

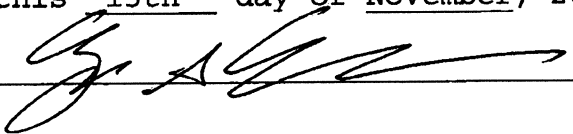
CHANGE FROM: LexisNexis whether

CHANGE TO: LexisNexis. Whether

REASON: Transcription error.

Subscribed and sworn to before me

this 15th day of November, 2012.



1 GLENN GUNDERSEN, ESQUIRE - HIGHLY CONFIDENTIAL
2 ACKNOWLEDGMENT OF DEPONENT
3

4 I, Glenn A Gundersen, do
5 hereby certify that I have read the foregoing
6 pages _1_ to _351_ and that the same is a
7 correct transcription of the answers given by
8 me to the questions therein propounded,
9 except for the corrections or changes in form
10 or substance, if any, noted in the attached
11 Errata Sheet.

12
13 _____
14 DATE

13 _____
14 SIGNATURE 

15
16
17 Subscribed and sworn to before me this
18 _____ day of _____, 2012.

19
20 My commission expires:

21 _____

22
23 _____

24 Notary Public

25 Assignment Number: 1525833