

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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JT COLBY AND COMPANY, INC., D/B/A  
BRICK TOWER PRESS, J. BOYLESTON AND  
COMPANY PUBLISHERS, LLC, AND  
IPICTUREBOOKS, LLC,

Plaintiffs,

-against-

Index No.  
11-CV-4060 (DLC)

APPLE, INC.,

Defendant.

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VIDEOTAPED DEPOSITION OF  
SUSAN SCHWARTZ MCDONALD

New York, New York

December 12, 2012, 9:56 a.m.

Reported By:

Nicole Sesta

Ref: 8606

1 S. Schwartz McDonald

2 Q And what was said in that initial  
3 conversation?

4 A The case was described. I think  
5 some of the general same areas of discussion  
6 were recapitulated. There was an opportunity to  
7 both refresh and amplify for me the facts that  
8 -- what had transpired in this case, the history  
9 of Mr. Colby's company. And that really was  
10 pretty much it.

11 Q At that time, were you again  
12 relying on what counsel told you orally, or were  
13 you presented with any additional documents?

14 A I can't recall -- earlier, I  
15 think, before meeting with the attorneys from  
16 Quinn Emanuel, I did have -- had received a  
17 couple of documents from Mr. Morrison and may  
18 have skimmed them, didn't necessarily read them  
19 with great care at the time because I really  
20 didn't have a mission statement for myself.

21 Q Do you recall what documents you  
22 were provided?

23 A I think there was -- I'm guessing  
24 now because I really just don't have the  
25 chronology. I believe that I had some response

1                   S. Schwartz McDonald  
2           to a trademark office action from Apple, and I  
3           believe I was given, at some point, the  
4           complaint that had been filed, but I'm not --  
5           beyond that, I don't know. This is really kind  
6           of ancient history for me.

7           Q           Okay. Do you know when in the  
8           spring you were contacted by Quinn Emanuel?

9           A           The closest I can come is around  
10          April.

11          Q           Okay. And who at Quinn Emanuel  
12          contacted you?

13          A           I don't recall actually. I don't  
14          recall who I heard from first.

15          Q           Okay. When did you begin working  
16          on a survey design?

17          A           Sometime during the summer, I  
18          would say, I started to or very late spring.

19          Q           Did you consider other survey  
20          designs other than the one you ultimately  
21          reported on?

22                               MR. RASKOPF: Note my  
23                               objection to the form of the  
24                               question.

25          A           Well, that -- the process of

1 S. Schwartz McDonald

2 Colby's warehouse.

3 Q Did you ask for any particular  
4 type of book, or did you just simply say give me  
5 some books?

6 A I was just looking for examples.

7 Q Do you still have copies of these  
8 books?

9 A I have -- they've kind of  
10 distributed themselves. There might be one at  
11 home. I know there is one in my office.  
12 They've probably been put away, most of them, by  
13 my administrative assistant. I haven't seen  
14 them in a while.

15 MS. CENDALI: I call for  
16 the production of the books that  
17 were actually provided to Dr.  
18 McDonald, both physical and  
19 electronic.

20 MR. RASKOPF: We'll address  
21 your letter when we receive it.

22 Q Did you review the deposition  
23 testimony of any witness in this case?

24 A I mentioned at the outset that I  
25 reviewed the deposition of Dr. Jay and I

1 S. Schwartz McDonald

2 reviewed the deposition of Dr. Jacoby.

3 Q Okay. Did you review any of  
4 plaintiffs' marketing materials?

5 MR. RASKOPF: Objection to  
6 the form.

7 A I'm not sure what you mean by  
8 "marketing materials." So at the moment, I'm  
9 going to have to say no pending some  
10 clarification on that.

11 Q Okay. Other than the complaint,  
12 did you review any -- in the documents you  
13 previously identified, did you review any other  
14 documents relating to plaintiffs' business?

15 MR. RASKOPF: Objection to  
16 the form.

17 A Not that I'm aware of.

18 Q Do you know how much money  
19 plaintiffs have spent on advertising since it  
20 acquired the iBooks imprint in 2006?

21 MR. RASKOPF: Objection to  
22 the form.

23 A I have no idea.

24 Q Do you know whether it was  
25 collectively less than \$50,000 during this

1 S. Schwartz McDonald

2 I may not have done all my homework, but I don't  
3 recall. I don't recall seeing it.

4 Q So you don't recall one way or the  
5 other or you think you didn't see it?

6 A I don't think I've seen it. I  
7 don't think I've seen it.

8 Q Can you recall the titles of any  
9 of plaintiffs' electronic books that you did  
10 see?

11 A Dawn of Amber. There's another  
12 book by Clarke that I did see. I'm blocking on  
13 the name of it. Another one is Sentinel.

14 Q I'll represent to you that this is  
15 in fact an excerpt of one of plaintiffs'  
16 electronic books. Could you please take a look  
17 at this exhibit, Arthur C. Clarke's Venus Prime,  
18 excerpts from McDonald 2, and let me know what  
19 type of source information do you see in the  
20 document?

21 A Well, other than the author, which  
22 I will consider to be source information, I'm  
23 using the word source rather broadly. I hope  
24 that that's acceptable, iBooks.

25 Q Can you do it by page?

1 S. Schwartz McDonald

2 A They're not numbered. So if I go  
3 through on the first page all I can see is the  
4 author and title, and then there's a quote from  
5 the Chicago Sun Times, so it's setting aside the  
6 author as source information. And I'm not sure  
7 what Paul Preuss has to do with this, because I  
8 can't read it. It's the lower left-hand corner.

9 Q So then turning to the second  
10 page.

11 A I'm assuming this would not be  
12 something you consider to be potentially  
13 relevant or information I should be commenting  
14 on.

15 Q Fair enough.

16 A I want to make that clear.

17 Q Honest question and fair enough.

18 A So then we see Arthur Clarke and  
19 Paul Preuss on the first inside page and then we  
20 get to the third inside page and I see iBooks  
21 science fiction, and then I see some other  
22 books.

23 Q So you're saying at the top of  
24 this third page in there's a reference to iBooks  
25 science fiction, is that what you're referring

1 S. Schwartz McDonald

2 to?

3 A Yes. And then at the bottom of  
4 the book after there's other volumes that  
5 referenced by other authors. There is a  
6 reference to www.iBooksInc.com. Then on the  
7 next page there's another kind of an inside  
8 title page and here's reference to iBooks with a  
9 light bulb and the lower case "I" in it and  
10 there's reference to iBooks, Inc., www again and  
11 then there's Simon & Schuster as the  
12 distributor. Then on the next page there is a  
13 copyright for Byron Preiss Visual Publications.  
14 There is an iBooks, Inc., ebooks reference.  
15 There's an iBooks, Inc. reference and then more  
16 iBooks. So I think I've probably gone  
17 through --

18 Q On the last page is there after  
19 under iBooks, Inc. is there a New York, New York  
20 address?

21 A Yes. I didn't mention that  
22 because the address isn't normally material to  
23 me relating to source. It's more location, not  
24 source.

25 Q In some circumstances the source



1                   S. Schwartz McDonald  
2           could provide a clue as to, excuse me, in some  
3           situations an address could provide a clue as to  
4           source; is that fair to say?

5                               MR. RASKOPF:  Objection to  
6                   the form.

7           A           That wouldn't really be my thought  
8           actually.  I mean I think in general addresses,  
9           companies have many, potential many addresses  
10          and satellite offices and so on.  So I don't  
11          think about it in that way.  It's something that  
12          may be it's a characteristics or a fact about  
13          the source, but I don't think of the address in  
14          the same way as the source, not the way I would  
15          think of an author, a distributor, or a  
16          publisher.

17          Q           Do you think logos as being source  
18          identifying material?

19          A           Potentially, yes.

20          Q           And have you seen this light bulb  
21          logo before in the course of your work on this  
22          case?

23          A           Yes.

24          Q           Are you aware that plaintiffs  
25          typically include this logo on their books?

1 S. Schwartz McDonald

2 A Well, I don't know about  
3 typically. I've seen it. I believe I've seen  
4 things that didn't have it but I have seen it.

5 Q Have you ever undertaken to  
6 analyze how often plaintiffs' light bulb logo is  
7 used on their books?

8 A I have not.

9 Q If I told you that it's used  
10 virtually all the time on their books would you  
11 have reason to believe that's not true?

12 A I will stipulate that you are a  
13 truthful woman.

14 Q Fair enough. Let's take a look at  
15 what we'll mark as McDonald 4.

16 (McDonald Exhibit 4, Dawn  
17 of Amber excerpt, marked for  
18 identification, as of this date.)

19 Q Is McDonald Exhibit 4 an excerpt  
20 from the Roger Zelazny the Dawn of Amber  
21 electronic book that was published by plaintiffs  
22 that you referred to earlier?

23 A Yes, I have this on my Kindle.

24 Q And in terms of this particular  
25 book, McDonald 4, could you take us through once

1                   S. Schwartz McDonald  
2           again what you believe to be source identifying  
3           information?

4           A           Before we do this, I think I  
5           remember now why I didn't actually see this.

6                               MR. RASKOPF: Referring to  
7                               Exhibit 2 which is Arthur C.  
8                               Clarke's Venus Prime online book  
9                               allegedly referred to in Exhibit 3  
10                              or allegedly sent to counsel under  
11                              Exhibit 3.

12           A           I think I can solve this mystery.  
13           When it arrived in my inbox it was corrupt and I  
14           couldn't open it and forgot to do anything about  
15           it because it wasn't represented to me as  
16           something I absolutely had to have seen to  
17           arrive at any conclusion or determination. So  
18           it's why the name sounded familiar and it just  
19           at this moment came back to me with a little  
20           message on my screen. The mystery is solved.

21           Q           Fair enough. So going back to  
22           McDonald 4, the Roger Zalazny Dawn of Amber book  
23           that was published by plaintiffs, could you  
24           please take us through page by page once again  
25           the source identifying information?

1 S. Schwartz McDonald

2 A The first page has nothing. The  
3 second page is a list of other books by  
4 Betancourt, which has -- and I have to say I  
5 don't really know, understand sort of the  
6 hierarchy of authors and authors authoring  
7 authors' materials. So I'm not going to comment  
8 on the relationship between Zelazny and  
9 Betancourt. The next page inside is more  
10 repetition of the title and then there's iBooks  
11 New York.

12 Q You understand that to be source  
13 information?

14 A Yes. I'll try to be more  
15 explicit. And then there is on the next and  
16 last page, I believe, there is reference to the  
17 original publication of iBooks with reference to  
18 a copyright and iBooks is repeated. Then  
19 there's reference to iPicturebooks and there's  
20 an address, which I think is of interest to you  
21 but I would not have thought to mention as a  
22 source, per se.

23 Then there's reference to Brick  
24 Tower Press and then there's the printer, Weston  
25 and Company, which is listed as publishers but

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2 the printer in this case. Then there's  
3 reference if you read in the fine print the  
4 iPicturebooks Calfon is a registered trademark  
5 of J. Boyleston and Company. Then we come down  
6 to the reference to the first iBooks printing,  
7 and I think that probably is the sum of anything  
8 other than credits given to editors and jacket  
9 designers, that's the only thing that's  
10 contained here that I would think is at all  
11 relevant.

12 Q You mentioned that there is a  
13 reference to iPicturebooks. Did you render any  
14 opinions in this case with regard to  
15 iPicturebooks?

16 A I have not been asked to, no.

17 Q Do you know in what circumstances  
18 plaintiffs use the imprint iPicturebooks?

19 A Well, it's my understanding that  
20 they have a library of children's titles but  
21 they also have other titles which are graphic in  
22 nature. I cannot be more specific than that. I  
23 just know that not only children's books but  
24 some adult books with presumably graphic  
25 elements are housed within that. I'm not sure

1 S. Schwartz McDonald

2 A Because there is usually I think  
3 an analog of that page in most books and that's  
4 referenced to the by convention. What I was  
5 alluding earlier in the paragraph that I read to  
6 you when we discussed, it was a discussion of  
7 how typically and certainly it's easy to  
8 visualize in print books, where the most copious  
9 amounts of information about source are housed  
10 about a book.

11 Q So you wanted then the respondents  
12 to envision this page but you didn't actually  
13 provide them with any of the source information  
14 that they might find on one of plaintiffs'  
15 actual iBooks, right?

16 A That's correct, yes.

17 Q Why did you say to look at a  
18 particular page as opposed to look at an  
19 electronic book as a whole?

20 A It was a point of reference, just  
21 simply to set the stage for information about  
22 the book source. Essentially I was obliging  
23 respondents. I was putting in mind for  
24 respondents a particular piece of information  
25 and assuming they received that information on

1                   S. Schwartz McDonald  
2       that page. I could have said on the spine of  
3       the book too. I was referencing a page in which  
4       there might be a lot of information and asking  
5       them to stipulate that they had seen iBooks on  
6       that page.

7                   Q       But the respondents are not  
8       provided with what that actual contextual  
9       information would be?

10                  A       That's correct. That's absolutely  
11       correct.

12                  Q       Turning, if you would turn, to  
13       McDonald Exhibit 2, which of the pages on that  
14       exhibit would you have wanted the respondents to  
15       envision?

16                  A       I didn't have this in mind. In  
17       fact, the multiplicity, the incredibly diverse  
18       ways in which information can appear was  
19       precisely the problem. So I wasn't asking  
20       anyone to imagine Venus Prime. I wasn't asking  
21       them to imagine the Dawn of Amber. I was asking  
22       them to put in mind a page in the book or a  
23       screen, as it happens with digital books, where  
24       there is information about the source of the  
25       book and to actually place in front of them the