

**EXHIBIT D**

**UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

**GARMIN LTD.,**

**Plaintiff,**

**v.**

**TOMTOM, INC.,**

**Defendant.**

**Civil Case No. 2-06CV-338-LED**

**JURY DEMANDED**

**TOMTOM, INC.'S OPPOSITION TO GARMIN'S MOTION FOR PROTECTIVE ORDER  
AND CROSS-MOTIONS TO COMPEL AND FOR SANCTIONS**

Defendant TomTom, Inc. ("TomTom") respectfully submits the following opposition to plaintiff Garmin Ltd.'s ("Garmin") Emergency Motion for Protective Order on Topics 1-3 of TomTom's First 30(b)(6) Notice (hereinafter, "Motion" or "Mot.").<sup>1</sup> "Topics 1-3" arise from TomTom's January 22, 2007 notice and are directed to Garmin's infringement allegations. Specifically, they are: (1) Garmin's infringement contentions, (2) Garmin's knowledge of the accused products, and (3) all facts pertaining to Garmin's determination that the accused products infringe Garmin's patent. Notwithstanding almost six months of delays and broken promises, it has now become clear that Garmin never had any intention of complying with discovery in this case. Because Garmin is withholding discoverable information and is not entitled to a protective order, TomTom hereby cross-moves for an order compelling Garmin to

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<sup>1</sup> The "emergency" nature of Garmin's motion is not longer applicable. Garmin filed its motion on the evening of Saturday, June 23 to prevent a deposition that was scheduled to begin at 9 a.m. on Monday, June 25. At the same time, Garmin sent an e-mail to TomTom's counsel stating Garmin's refusal to provide testimony on Topics 1-3. The undersigned then notified Garmin on Sunday, June 24, that he would not waste time and resources traveling to Kansas City for the deposition in light of Garmin's refusal to provide the requested discovery.

produce a knowledgeable Rule 30(b)(6) designee on the subjects covered by Topics 1-3 of TomTom's Notice of Deposition and for sanctions in light of Garmin's repeated refusal to comply with the discovery rules.

## **I. INTRODUCTION**

As Garmin readily admits, TomTom is simply seeking to discover "the full factual bases for Garmin's infringement contentions and allegations that TomTom infringes the patent in suit." Mot. at 1. In this district, a plaintiff's infringement contentions frame the case and place discovery on a specific trajectory. In aid of that purpose, depositions to explore a plaintiff's infringement contentions are not unusual. Indeed, all the while it has withheld this discovery, Garmin has proceeded apace to take discovery of TomTom. Garmin uses the discovery rules to its benefit, while denying any obligation to comply with those same rules when TomTom comes calling.

In resisting discovery, Garmin has actively concealed and/or delayed the disclosure of discoverable information, and thus, has effectively thwarted TomTom's efforts to explore Garmin's infringement contentions for six months now. Garmin initially resisted TomTom's January 22 Rule 30(b)(6) deposition notice on its contentions, then permitted it to be scheduled, then withheld all testimony related to infringement, then resisted scheduling another deposition, then consented to it being scheduled, and then withheld all testimony related to infringement again. Twice now the parties have scheduled a deposition only to have Garmin unilaterally announce just before the deposition that it would not permit discovery on infringement-related topics. Garmin's initial complaint was that its infringement contentions were protected attorney work product. Now, Garmin contends that its infringement discovery of TomTom has revealed

that its contentions are “outdated” (Mot. at 4-5), which is perhaps another way of saying “wrong.”

Garmin chose to file this case in this district. Garmin represented that it sought this Court’s rules as a way to ensure the efficient progress of the case toward trial. However, instead of providing the full disclosure required by the rules, Garmin has used delays and unilateral refusal to conceal its true positions in this case. The shell game Garmin is playing with its infringement contentions cannot continue.

## **II. FACTUAL BACKGROUND**

Garmin filed this case in August of 2006 and served its infringement contentions on January 19, 2007. Because Garmin’s infringement contentions were inadequate on a number of issues, TomTom noticed a deposition under Fed. R. Civ. P. 30(b)(6), which included as Topics 1-3:

1. Your infringement contentions.
2. Your knowledge of the accused products.
3. All facts and circumstances surrounding the determination of TomTom’s alleged infringement of the patent-in-suit, including any TomTom products, services, or technology tested by or for Garmin, and including any literature or documents related to any TomTom product reviewed by Garmin or on its behalf.

TomTom, Inc.’s First Notice of Deposition Pursuant to Rule 30(b)(6) to Garmin Ltd. (Jan. 22, 2007) at 3, Ex. A. Garmin initially resisted producing a witness on topics 1-3, but eventually agreed to produce a corporate deponent on March 9, 2007, E-mail from Seitz to Kopsidas dated Feb. 24, 2007, Ex. B. On the evening of March 8, 2007, Garmin’s counsel informed TomTom’s counsel that Garmin’s witness would not testify about topics pertaining to infringement because Garmin contended that the subject matter of its infringement contentions was privileged and protected from discovery as attorney work product. *See* Ltr. from Seitz to Kopsidas dated Mar.

8, 2007 (identifying topics upon which Garmin witness was being designated to testify for Mar. 9, 2007 deposition, not including topics 1 and 3, and stating that “[t]his witness only will be provided on the identified topics . . .”), Ex. C; *see also* Garmin Ltd.’s Responses and Objections to TomTom, Inc.’s First Notice of Deposition Pursuant to Rule 30(b)(6) at 3 (objecting to providing testimony on topic 1, Garmin’s infringement contentions, on basis of “attorney-client privilege [and] work product doctrine” and stating that “Garmin will not produce a deponent as to Topic 1.”) (included with Ex. C). The March 9 deposition proceeded on other topics about which the witness was permitted to testify.

TomTom’s counsel attempted to persuade Garmin’s counsel that he was improperly withholding discovery on Garmin’s infringement contentions, and included a prior order of this Court reflecting that Garmin’s actions were improper. Ltr. from Kopsidas to Buresh dated Mar. 13, 2007, Ex. D. Following more delay, Garmin eventually consented to produce a witness on its infringement contentions and the deposition was scheduled for Monday, June 25, 2007. E-mail from Seitz to Kopsidas dated Jun. 14, 2007 (“We will produce Mr. Ayres on June 25 on topics 1-3, 7 and 8 . . .”), Ex. E.

In the meantime, Garmin served its Notice of Deposition Pursuant to Rule 30(b)(6) on May 3, 2007. Ltr. from Seitz to Kopsidas dated May 3, 2007, Ex. F. A few weeks later, TomTom identified the witness, Mr. Sven Jurgens, and his deposition was scheduled for Friday, June 22, 2007. During that deposition, Garmin took wide ranging infringement discovery of Mr. Jurgens. The evening following Mr. Jurgens’s deposition, with TomTom scheduled to depose Garmin’s witness the ensuing Monday, Garmin’s counsel unilaterally cancelled discovery of Garmin’s infringement contentions flatly stating that, “we [Garmin] will not be presenting a witness on Topics 1-3. . . .” E-mail from Buresh to Kopsidas dated Jun. 22, 2007, Ex. G.

### III. GARMIN CANNOT WITHHOLD DISCOVERY ON ITS INFRINGEMENT CONTENTIONS

Protective orders are permitted under Fed. R. Civ. P. 26(c) and are generally granted “for good cause shown . . .to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense. . . .” Fed. R. Civ. P. 26(c). When evaluating whether a movant has satisfied his burden of establishing “good cause” for a protective order preventing a deposition, “the court is required to balance the competing interests of allowing discovery and protecting the parties and deponents from undue burdens.” Hussey v. State Farm Lloyds Ins. Co., 216 F.R.D. 591, 596 (E. D. Tex. 2003) (Davis, J.). Protective orders prohibiting depositions, however, are rarely granted. *See, e.g.,* Salter v. Upjohn Co., 593 F.2d 649, 651 (5th Cir. 1979) (“It is very unusual for a court to prohibit the taking of a deposition altogether and absent extraordinary circumstances, such an order would likely be in error.”); Bucher v. Richardson Hosp. Authority, 160 F.R.D. 88, 92 (N. D. Tex. 1994) (protective orders prohibiting depositions are rarely granted and require showing of “extraordinary circumstances”). “If the motion for a protective order is denied in whole or in part, the court may, on such terms and conditions as are just, order that any party. . .provide or permit discovery.” Fed. R. Civ. P. 26(c).

Garmin contends it is entitled to a protective order because: (1) “TomTom is improperly attempting to press ahead with a deposition on what it knows to be out-dated factual bases. . . .” Mot. at 2; (2) Garmin supposedly cannot educate its corporate designee with respect to Mr. Jurgens’s testimony and TomTom’s source code, *id.*; and (3) Garmin feels a Rule 30(b)(6) deposition on infringement contentions is not proper, *id.* These reasons do not come close to the “extraordinary circumstances” needed to establish good cause to quash a deposition. Note that Garmin no longer contends that the information sought is privileged or protected work product (except with respect to part of topic 3, which will be discussed in more detail below, *see* Mot. at

7-8). Furthermore, Garmin does not contend that the information sought is not relevant or discoverable.

Garmin first contends that TomTom is trying to “trap” Garmin into disclosing the factual bases of its infringement contentions. Mot. at 4. However, a deposition on a six month old Rule 30(b)(6) notice is hardly a trap; it is discovery. The Patent Rules were specifically designed to “provide structure to discovery and enable the parties to move efficiently toward claim construction and the eventual resolution of their dispute.” Am. Video Graphics, L.P. v. Electronic Arts, Inc., 359 F.Supp.2d 558, 560 (E. D. Tex.2005) (Davis, J.). Garmin is not permitted to disrupt TomTom’s preparation of its defense by refusing to answer questions about its infringement contentions.

Second, Garmin’s claims that the factual bases for its infringement contentions are now “outdated,” Mot. at 2, ignores the fact that infringement contentions are final in this district absent good cause to amend. Am. Video Graphics, 359 F.Supp.2d at 560; *see also* E. D. Tex. General Order 06-15 at 27-28 (amending Patent Rules by removing all references to “preliminary” contentions to make clear that “contentions are final, unless amendment is permitted.”). Accepting Garmin’s argument would hollow P.R. 3-6, as infringement contentions could be modified whenever a deposition is taken (or interrogatory response received) in which new facts are learned. Rather than continuing to conceal its contentions and the factual bases therefore, Garmin should be as forthcoming as possible as it prepares to seek the Court’s leave to amend its contentions. Moreover, under Garmin’s reasoning, its infringement contentions would not be final (and, thus, discoverable) until discovery closes, as Garmin undoubtedly has other depositions to take, each of which will “add[] to the factual bases now underlying Garmin’s

infringement contentions.” Mot. at 3. Garmin’s reasoning is clearly contrary to the Patent Rules and practice in this district.

This Court rejected Garmin’s argument in MyMail Ltd. v. America Online, Inc., Case No. 6:04-CV-189 (Sept. 28, 2004 E. D. Tex.), Ex. H. In that case, the patentee MyMail sought a protective order to prevent AOL from taking MyMail’s Rule 30(b)(6) deposition on its infringement contentions. *Id.* at 1. MyMail argued that the deposition should not occur until discovery was “substantially completed” because to permit otherwise would be forcing MyMail to disclose its final infringement contentions. *Id.* at 1-2. The Court rejected MyMail’s argument, noting that MyMail’s infringement contentions are its final contentions unless amendment is permitted under the rules, and compelled MyMail to produce a corporate witness to testify on its infringement contentions. *Id.* at 3. The Court specifically took issue with MyMail unilaterally withholding infringement contentions discovery, explaining that, under the Court’s policy of liberal, open, and forthright discovery, “all discoverable material should always be produced without delay. . . . Information is discoverable as soon as it becomes relevant; parties do not have authority to determine when information will be disclosed.” *Id.* at 2. Finally, the Court issued a stern warning that it “will not tolerate gamesmanship that attempts to conceal or delay the production of discoverable items.” *Id.* at 3.

Garmin’s claim that Mr. Jurgens’s testimony somehow revealed “previously undiscoverable” facts, Mot. at 2, and “additional specificity not previously available,” *id.* at 3, is absolutely false, and does not provide a basis for Garmin to withhold discovery. Mr. Jurgens’s testimony pertained primarily to TomTom’s source code. However, Garmin has been in possession of TomTom’s source code for months now. In accordance with P.R. 3-4(a), TomTom produced all relevant source code for the accused products by March 15, 2007. In fact, the bulk



of TomTom's source code was produced in July 2006, in connection with a previous litigation Garmin brought against TomTom in the Western District of Wisconsin.<sup>2</sup> Moreover, in Garmin's counsel's own words, Mr. Jurgens simply "confirmed a number of facts that form the basis of Garmin's infringement contentions." Ex. G. Consequently, Mr. Jurgens's testimony concerning the source code should not have changed Garmin's infringement contentions.<sup>3</sup>

Garmin's next argument—that it cannot educate its corporate designee on TomTom's infringement evidence because that information has been designated "Highly Confidential—Attorneys' Eyes Only"—is no more persuasive. *See* Mot. at 5-6. In fact, the dilemma is illusory. Garmin's infringement contentions are not based upon any confidential information. Indeed, months have passed since Garmin received the last of TomTom's source code and Garmin has not seen the need to supplement its infringement contentions. Therefore, Garmin's witness need not have access to TomTom's confidential information; that is, unless Garmin needs to adjust its contentions in light of Mr. Jurgens's testimony. Moreover, nothing precludes Garmin from designating a corporate representative who is permitted to view TomTom's confidential information, such as Garmin's expert. *See* Fed. R. Civ. P. 30(b)(6) (corporation may designate "officers, directors, or managing agents, *or other persons who consent to testify on its behalf*") (emphasis added). Under the protective order in this case, experts have access to all levels of

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<sup>2</sup> The parties agreed at the outset of this case that discovery from the Wisconsin litigation could be used in this litigation.

<sup>3</sup> Garmin's insinuations that TomTom delayed the timing of Mr. Jurgens's deposition until it was fortuitous to TomTom are disproved by the facts. *See* Mot. at 4-5. Garmin served its Rule 30(b)(6) deposition notice in May and took Mr. Jurgens's deposition in June. TomTom has been very diligent and courteous in deposition scheduling. Garmin, on the other hand, has stonewalled TomTom's efforts to obtain infringement contentions discovery for six months now, including twice rescinding the topic of infringement contentions on the eve of the deposition.

confidential material. Therefore, Garmin presents a false dilemma—the choice between designating an uneducated witness or its trial counsel—that it could easily avoid.

Garmin’s final argument is also its weakest. Garmin argues that the Court should enter a protective order on Garmin’s behalf because “a 30(b)(6) deposition is not a proper means for obtaining Garmin’s infringement contentions” and that interrogatories should suffice. Mot. at 2. Garmin cites a number of non-controlling cases from other jurisdictions for the questionable proposition that “[c]ourts generally disfavor 30(b)(6) depositions as a means of discovering a party’s infringement contentions.” *See id.* at 6. Even assuming that is the law in other jurisdictions, it is not the law in this jurisdiction where “the Court’s policy of liberal, open, and forthright discovery” routinely involves Rule 30(b)(6) depositions on infringement contentions. *E.g.*, MyMail Ltd. v. America Online, Inc., Case No. 6:04-CV-189 (Sept. 28, 2004 E. D. Tex.), Ex. H. Garmin sought the jurisdiction of this Court; it must abide by this Court’s unwavering and well known rules regarding full and forthright discovery.

Finally, as an adjunct argument, Garmin contends that topic 3 encompasses information that would be protected from discovery by the attorney work product doctrine. Mot. at 7. Topic 3 recites:

All facts and circumstances surrounding the determination of TomTom’s alleged infringement of the patent-in-suit, including any TomTom products, services, or technology tested by or for Garmin, and including any literature or documents related to any TomTom product reviewed by Garmin or on its behalf.

Ex. A at 3. Clearly, this topic is broad enough to encompass non-privileged information, such as the alleged evidence of infringement (products and manuals) depicted in Garmin’s infringement contentions. Moreover, TomTom is also entitled to explore facts surrounding any claim of privilege or immunity Garmin asserts in order to determine whether the claim is justified. For example, it may be the case that Garmin waived its alleged work product immunity. TomTom

cannot discover this if a deposition on this topic is quashed. The most reasonable solution would be to permit the deposition to go forward on this topic, knowing that Garmin is represented by counsel who is capable of instructing Garmin witnesses to not answer questions that implicate privileged information or work product.

#### **IV. GARMIN SHOULD BE SANCTIONED FOR WITHHOLDING RELEVANT DISCOVERY**

The provisions of Fed. R. Civ. P. 37(a)(4) provide for sanctions in relation to motions for protective orders and motions to compel. Fed. R. Civ. P. 26(c). Under Rule 37(a)(4), the Court may require Garmin, as “the party whose conduct necessitated the motion,” to reimburse TomTom for “reasonable expenses incurred in making the motion” or impose other sanctions within the Court’s discretion. Fed. R. Civ. P. 37(a)(4). The Court may award any relief it deems just to alleviate prejudice to TomTom as a result of Garmin’s withholding of infringement contention discovery well into the claim construction phase of the case. Early in this process, TomTom made sure that Garmin’s counsel could not claim unfamiliarity with this Court’s rules and orders by providing Garmin with copies of some of the orders cited herein. It is incredible that six months into this process, Garmin persists in refusing to provide full disclosure.

#### **V. CONCLUSION**

For the foregoing reasons, Garmin’s motion for protective order should be denied and Garmin should be compelled to produce a knowledgeable witness on Topics 1-3 of TomTom’s First Notice of Deposition Pursuant to Rule 30(b)(6). In addition, the Court should impose a reasonable and just sanction upon Garmin for its willful discovery violations.

Dated: June 28, 2007

Respectfully submitted,

By: /s/ Andrew R. Kopsidas

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 28th day of June, 2007, a true and accurate copy of the above and foregoing TOMTOM, INC.'S OPPOSITION TO GARMIN'S MOTION FOR PROTECTIVE ORDER AND CROSS-MOTIONS TO COMPEL AND FOR SANCTIONS was served on the following parties via electronic mail and first class mail, postage prepaid to:

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