

EXHIBIT 1

Justin A. Nelson

From: John Lahad
Sent: Thursday, July 10, 2014 8:47 PM
To: Amanda Bonn; Andrea P Roberts; QE-Google-Rockstar; James Mark Mann; Gregory Blake Thompson
Cc: Max L. Tribble; Justin A. Nelson; Shawn Blackburn; Parker Folse; Alexander L. Kaplan; jrambin@capshawlaw.com; ederieux@capshawlaw.com; ccapshaw@capshawlaw.com; jw@wsfirm.com; claire@wsfirm.com; Cyndi Obuz; John Dolan; Stacy Schulze; Kristin Malone; Tammie J. DeNio
Subject: RE: Rockstar v. Google: Follow-Up Re Document Requests

Andrea,

Good to see you again today. Further to Amanda's email and our discussion, the following is the summary list of functionalities we referenced. As Amanda mentioned, we believe these to be within the scope of our infringement contentions, the list is not meant to be exhaustive, and the list does not narrow, limit, or otherwise modify the contentions. Happy to discuss. Thanks.

- Google's indexing systems, including but not limited to Knowledge Graph
- Google's F1 RDMBS
- How Google receives a search request from a user, analyzes that request to generate search results, analyzes that request to generate ads, and then sends the search results and ads back to the user. This includes:
 - o How Google determines which search results to present to a user
 - o How Google determines which advertisement to present to a user
 - o How Google targets search results and advertisements to a specific geographic location, including user-specified and auto-detected location
 - o How Google targets search results and advertisements to a specific IP address
 - o How Google targets search results and advertisements to a specific device
 - o How Google targets search results and advertisements to a user's age, language, or gender
 - o How Google targets search results and advertisements based on a user's prior searches
 - o How Google targets search results and advertisements based on a user's prior selections
 - o How Google targets search results and advertisements based on a user's Web History
 - o How Google targets search results and advertisements using Social Search
 - o How Google modifies search results and advertisements based on user refinement, e.g., date, type of result (videos, shopping, news, etc)
 - o How Google stores the data identified above
- Google's targeting functionality that allows advertisers to target specific groups, demographics, interests, placements, remarketing lists, content keywords, and search keywords
- YouTube Interest-based Advertising

- The structure, operation, and usage of the PREF cookie
- The structure, operation, and usage of the Ads Preferences Manager
- The structure, operation, and usage of the ___gads cookie
- The structure, operation, and usage of Personalized Search, including for signed-in and signed-out users
- The structure, operation, and usage of any “per-click” functionality, including “pay-per-click,” “cost-per-click,” “click through rate,” “Ad Clicks,” “Ad Impressions,” “Ad Rank,” “Ad Avg Position,” “max CPC,” “actual CPC,” and any other functionality to track ads served or selected
- The structure, operation, and usage of functionality to determine an advertisement’s “Quality Score”
- Google’s interface with non-Google sites, including sites that claim to be “powered by Google” or implement any of the foregoing functionality

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From: Amanda Bonn
Sent: Thursday, July 10, 2014 2:10 AM
To: Andrea P Roberts; QE-Google-Rockstar; James Mark Mann; Gregory Blake Thompson
Cc: Max L. Tribble; Justin A. Nelson; John Lahad; Shawn Blackburn; Parker Folse; Alexander L. Kaplan; jrambin@capshawlaw.com; ederieux@capshawlaw.com; ccapshaw@capshawlaw.com; jw@wsfirm.com; claire@wsfirm.com; Cyndi Obuz; John Dolan; Stacy Schulze; Kristin Malone; Tammie J. DeNio
Subject: Rockstar v. Google: Follow-Up Re Document Requests

Andrea,

I write to follow-up on our telephonic discussions over the past two days regarding Google’s responses and objections to Plaintiffs’ document requests and list of most significant custodians. Please advise if your understanding or recollection is different from ours.

Rule 3.4 Production:

We have expressed a concern that Google is often improperly seeking to rely on its Rule 3.4 production—which is a “sufficient to show” production—to satisfy its obligation to produce documents. Many of our document requests call for other categories of documents that we expect would likely not have been captured by Google’s Rule 3.4 production. We ask that Google please confirm that as to such requests, Google will agree to produce responsive, non-privileged documents per any limitations we have offered as set forth below. If Google is refusing to search for responsive, non-privileged documents beyond its Rule 3.4 production—which we believe violates the Court’s ESI Order and Discovery Order—please advise why.

Agreement:

In order to facilitate production of documents in response to many requests, we have agreed to preliminarily limit our requests to seeking documents regarding current versions of Google’s search and documents concerning historical

versions as they relate to user profile data and as necessary to prove how Google searches at a “medium-view” technical level since the first allegation of infringement in 2007. We also have agreed to limit our request for technical documentation of other products such as AdSense for Content, Google Play, and Android to how Google incorporates user profile data (broadly defined) into the methodology for returning ads. We also have agreed to provide you with a summary list of functionalities we believe are within the scope of our Infringement Contentions and where we specifically expect to see documents (technical, code, marketing, importance of the product/functionality, etc.) both historical and current. This list is not meant to be an exhaustive description of our Infringement Contentions or to waive or change anything in the sum or substance of our Infringement Contentions; rather, it is intended as a summary merely to aid Google’s search for responsive documents. Once Google has produced such documents, we reserve our right to seek further documents. We believe this agreement—including Google’s agreement to produce the responsive, non-privileged documents as limited above—applies to our Requests Nos. 2, 3, 8.

Requests 1, 5, 6, and 7: Google agrees to produce responsive, non-privileged documents

Request No. 4: Withdrawn.

Request Nos. 9-10: Google agrees to produce responsive, non-privileged documents The types of documents we expect to be produced would include technical design documents and specifications showing how the systems work; testing or development documents; marketing or other business strategy documents; and other documents showing how such systems work and why they are important to Google. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 11: You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request Nos. 12-13, 15-16: The types of documents we expect to be produced would include technical design documents and specifications showing how the systems work; testing or development documents; marketing or other business strategy documents; documents showing why these systems are important to Google; and documents relating to the creation of these products and their benefits. We expect the types of documents responsive to this request would include not only the type of technical documents included in Google’s Rule 3.4 production, but may also include things like Power Point presentations or other responsive ESI. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 14: We have clarified that this request seeks not only documents about how Google uses the listed data in Accused Instrumentalities, but also how it may use such data in other products, which may be relevant to damages or to the importance of the patented features to Google’s business. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 17: This request seeks documents regarding the importance or significance of the Accused Instrumentalities to Google’s revenue. We would expect documents responsive to this request to include, for example, marketing presentations, presentations regarding board financials, documents regarding historical implementation of AdWords in the pre-IPO period, and the like. To facilitate searching for such documents, we are willing to agree to limit the search to documents or presentations presented to, prepared by, or in the possession of the Director-level executives, Executive Management Group (“EMG”) level executives (or whatever term Google now uses or has used for such senior management group), and group-lead managers. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 18: This request meant to refer to Request No. 14 in stating “information immediately above.” You have indicated you now understand the request and will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 19: This request seeks documents relating to the impact on revenue (regarding click-through rates or any other metric for measuring success) that the incorporation of user profile data into Google’s search and search plus

advertising functionalities may have had. The types of documents responsive to this request would include, for example, documents regarding the click-through rate before and after user-profile data was implemented, any documents analyzing that issue, any documents discussing the importance or significance of the Accused Instrumentalities to changes in click-through rates or other metrics by which Google measures success of an advertisement, and the like. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 20: Google agrees to produce responsive, non-privileged documents (including video).

Request No. 21: Google agrees to produce responsive, non-privileged documents after we produce the agreed-upon summary list of functionalities.

Request No. 22: We agree to limit this request to documents presented to, created by, or in the possession of the Board of Directors, members of the EMG (or equivalent), or officers, as located pursuant to the ESI Order. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request Nos. 23-24: You have indicated that you had questions regarding holdback studies or A/B testing for searches and/or advertisements and how to locate and produce them without undue burden. We have suggested that, to our knowledge, there is a department or group within Google responsible for such studies or testing, and that it would not be unduly burdensome for Google to identify such studies or testing relating to Accused Instrumentalities, particularly upon our production of the agreed-upon list of functionalities. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request Nos. 25 and 27: We are requesting documents describing how Google prices advertisements, what goes on in the back-end that creates the payment, how functionalities relating to the creation of a fee record and creation and extraction of a toll, and the like. We are not demanding documents regarding pricing of particular advertisements or every record of every fee for an ad that Google has ever charged. Understanding the scope of our request, you have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 26: We have clarified that this request seeks documents regarding AdSense for Content, Doubleclick, and Google Display Network because we want to know if Google is using user profile data or other information gleaned from its search plus advertising, which may be relevant to damages, use of the data in the Accused Instrumentalities, and importance of the patented technology. Similarly included within the scope of this request is documents concerning whether data gleaned from products like AdSense for Content, DoubleClick, and Google Display Network is used by Google's search-plus-advertising products. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 28: This request relates to the international agreements between Google and its affiliated companies regarding how they license technology, which we believe is relevant to a reasonable royalty analysis. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 29: We are requesting that Google produce documents or presentations that identify or list the largest 50 publisher affiliates. At this point, we are not asking for the underlying revenue-sharing agreements themselves. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 30: We have clarified that this is not a "sufficient-to-show" request. Google has agreed to produce responsive, non-privileged documents.

Request No. 31: Google has indicated it would be unduly burdensome to produce all Dashboard information. We have requested that Google produce documents describing what categories of Dashboard information for the Accused Instrumentalities are maintained so that we can further refine our request and minimize any burden. You have indicated you will check with your client and get back to us on this proposal.

Request No. 32: Google has agreed to produce responsive, non-privileged documents.

Request No. 33: We will defer discussion of this request until we discuss it with our experts.

Request No. 34: We have explained that this is not a sufficient-to-show request and expect Google to produce responsive, non-privileged documents requested. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request Nos. 35-37: You objected that you did not know the source of the statements or terms described in these requests. We have sent you links to Google's websites which include these statements or terms. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request Nos. 38-39: We have clarified that these are not "sufficient-to-show" requests. In addition, we have clarified that "device location" could refer to things other than an IP address, for example, GPS coordinates, etc. Google has agreed to produce responsive, non-privileged documents.

Request No. 40: We are requesting documents relating to the design, development, marketing, importance, and benefit of the "PREF" cookie, which directly relates to our infringement contentions. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 41: You suggested Google did not understand what "Advertising IDs in Android" is. We explained that "Advertising IDs" is a term that Google itself uses to describe accused functionalities relating to search and search plus advertising delivery in Android. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request Nos. 42-43: As with other requests above, we clarified that we are seeking documents relating to the design, development, testing, modification, marketing, importance, and benefits of the cookies at issue. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 44: We have clarified that this is not a "sufficient to show" production, nor is it merely limited to technical documents. As with other requests above, we are interested in documents regarding the design, development, testing, modification, marketing, importance, and benefits of the Accused Instrumentalities' ability to collect and use prior purchasing information (whether through Google Wallet or otherwise). You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 45: We have clarified that AdWords' "language targeting" feature is directly relevant to claims reading on language-targeting in addition to claims including user profile data. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 46: We have clarified that we have asserted claims reading on search-refinement, which is precisely what "Google Instant" does. You indicated you had conducted a word-search for "Google Instant" in our Infringement Contentions and did not see those words come up. We indicated that a word search was unlikely to return information since our infringement contentions include screen-captures and that our screen captures demonstrated this functionality. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 47: Google agrees to produce responsive, non-privileged documents.

Request No. 48: We have clarified that documents concerning the “Query Understanding” functionality are relevant to our search refinement and user profile data claims. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 49: Google agrees to produce responsive, non-privileged documents, but indicated it believed this request was likely duplicative of other requests. We agree this is a catch-all requests, but wanted to ensure source code was captured insofar as Google may assert source code is not called for by PLR 3.4 or by our other requests.

Request No. 50: We agreed to limit the scope of this request to functionalities relating to ordering of search results, use of user profile data to order search results, and searching of databases. We explained that these functionalities relate directly to our asserted claims, including claims reading on searching a database, use of user profile data, and search-refinement, among others. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 51: We sent you a link to a Google website that describes the “Search Lab” and includes a video called “The Evolution of Search,” which was the basis for this request. We clarified that we expect documents responsive to this request to include those discussing the development, testing, and improvement of search plus advertisements, including, for example, what tests have been done to improve search plus advertising functionalities, the results of those tests, presentations regarding those tests, and the like. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 52: Google agrees to produce responsive, non-privileged documents.

Request Nos. 53-54: These requests relate to “Knowledge Graph” and “Social Search,” which we believe are relevant to user profile data and search refinement. We are seeking documents relating to the design, development, testing, modification, marketing, importance, and benefits of “Knowledge Graph” and “Social Search.” You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 55: We are concerned by Google’s indication that it does not understand the relevance of the “Ad Preferences Manager,” which is a coined term by Google and which we understand relates to users adjusting settings for returning ads with search and is thus directly relevant to our asserted claims. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 56: Google agrees to produce responsive, non-privileged documents.

Request No. 57: We have clarified that this requests seeks documents concerning returning ads based on a search in Youtube, which is directly relevant to our infringement contentions. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 58: Similarly, our understanding is that AdWords for Video returns ads based on searches for video, and is thus directly relevant to our Infringement Contentions. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request Nos. 59-60: These requests relate to “pay-per-click,” “cost-per-click,” “actual cost-per-click,” and “click-through rates.” We are seeking documents including technical and non-technical documents relating to the design, development, testing, modification, marketing, importance, and benefits of such functions. Such documents would include, for example, documents regarding when Google began using cost-per-click, why it did so, the advantages of cost-per-click

over other methods, and documents showing how such functionalities work. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 61: Google agrees to produce responsive, non-privileged documents.

Request Nos. 62-63: These requests relate to Quality Score and placement of ads. David indicated yesterday that he did not believe we had discussed Quality Score in our Infringement Contentions. That is incorrect—please see, for example, Pages 215-216 of the '969 chart and Pages 69, 72, 161, 164, 204, 211 of the '970 chart. However, it appears that Google has agreed to produce responsive, non-privileged documents. Please confirm.

Request Nos. 64-65: Google agrees to produce responsive, non-privileged documents.

Request No. 66: This relates to "Display URL" and "Designation URL." We are checking with our experts about this and will get back to you.

Request No. 67: This request seeks presentations regarding Google's Ad System, Google Front End, Ads Database, AdWords Front End, or AdWords Back End. These are directly relevant to our Infringement Contentions. We have agreed that Google may narrow its search to presentations presented to, prepared by, or in the possession of the Director-level executives, Executive Management Group ("EMG") level executives (or whatever term Google now uses for such persons), and group-lead managers. Such documents would include any presentations discussing the design, development, marketing, importance, and benefits of such systems. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request No. 68: We clarified that we believe this request relates to Google's testing group, which we discussed in relation to other requests. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request Nos. 69-70: We agreed to limit this request to documents presented to, prepared by, or in the possession of the Director-level executives, Executive Management Group ("EMG") level executives (or whatever term Google now uses for such persons), and group-lead managers. You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request Nos. 71-72: We agreed to limit these requests to documents that are not public (*i.e.*, Google's non-public patent applications and file histories, for now), to such documents that reference patents or applications within the Skillen patent family, and to communications with the PTO (as opposed to the language in No. 72 regarding other government agencies). You have indicated you will check with your client and get back to us on whether Google agrees to produce responsive, non-privileged documents.

Request Nos. 73-80: Google agrees to produce responsive, non-privileged documents, subject to the caveat that in response to Request No. 73, Google will produce responsive, non-privileged documents relating to the auction and communications with Nortel related to intellectual property and not all Nortel interactions across all business units.

Request No. 81: Google has agreed to produce patent license agreements related to the Accused Instrumentalities. We are further seeking technology, transfer, and authorization to use agreements. You have indicated you will check with your client and get back to us on whether Google agrees to produce such responsive, non-privileged documents.

Request Nos. 82-83: We are limiting this request to studies that relate to the accused functionalities. As an example of the type of document we are seeking, we indicated we believe there have been studies conducted during the merger-process that segregate the value of Google's intellectual property and that such documents have been produced in other cases. For example, any such studies relating to Google's acquisition of DoubleClick and Applied Semantics or functionalities relating to search plus advertising would be responsive to this request. You have indicated you will check with your client and get back to us on whether Google agrees to produce such responsive, non-privileged documents.

Request No. 84: Google agrees to produce responsive, non-privileged documents, although it believes this request may be subsumed within others.

Request No. 85: To the extent the request was confusing to Google, we have clarified that we are seeking documents concerning the policies or practices as they relate to patent clearances, right-to-use opinions, or other mechanisms to avoid infringement of patents (and not underlying patent clearances themselves, for example). Such policies or practices are relevant to our willfulness claims and damages claims, for example. We further indicated that this request is broader than formal, written policies. We indicated that Google may be able to produce responsive documents consisting of its Rule 30(b)(6) deposition testimony regarding patent clearances, licensing policies, and the like, from prior cases. You have indicated you will check with your client and get back to us on whether Google agrees to produce such responsive, non-privileged documents.

Request No. 86: Google agrees to produce responsive, non-privileged documents.

Request Nos. 87-89: Google agrees to produce responsive, non-privileged documents with the caveat that it believes certain documents responsive to Request No. 87 may not need to be produced until November 18, 2014. We believe the deadline Google refers to is for producing otherwise privileged materials on which Google intends to rely on for its defense against willfulness, but does not excuse Google from producing any responsive, non-privileged documents earlier. Please confirm that you agree.

Request No. 90: We agree to limit this request to non-public information concerning Google referencing the Skillen patent family (and their applications) in other litigation (for example, as prior art) or to the patent office. We believe this is clearly reasonably calculated to lead to the discovery of admissible evidence concerning Google's knowledge of the patents-in-suit, characterization of the patents-in-suit, and validity of the patents-in-suit. You indicated you will check with your client.

Request No. 91: Google agreed to produce responsive, non-privileged documents.

Request No. 92: We are only seeking non-public patent applications and file histories for now. We suggested that you generate a list of the titles and abstracts of patent applications you believe may fall within this category so that we can narrow further. You indicated you would check with your client.

Request No. 93: This request seeks documents produced in prior litigation. We believe it would not be unduly burdensome—and, indeed, would reduce the burden on Google to conduct searches from scratch—to immediately produce documents like exhibit lists, admitted exhibits, deposition testimony, interrogatory responses, and expert reports from other cases. In addition, we indicated that we were interested in obtaining all documents that it produced in such other cases to the extent that you could not segregate information such as prior art you produced. You brought up licenses and third party consent, and we indicated that you would have to obtain such consent in this case as well. You indicated you would check with your client and get back to us.

Request No. 94: You asked us to explain the relevance of this request. The fact that a third party may have asked Google to indemnify it for claims relating to the Patents-in-Suit seems patently relevant to a host of issues including willfulness, damages, and direct infringement, at the very least. You indicated you would check with your client and get back to us.

Request No. 95: This request relates to indemnification of Accused Instrumentalities and is relevant to issues including revenue recognition, generation, control, and any defenses Google may attempt to raise regarding divided infringement and the like. You indicated you would check with your client and get back to us.

Request No. 96: This request goes to what sales are U.S. sales as opposed to international sales. We are requesting documents sufficient-to-show how international data flow works. We don't need documents showing the exact location of data centers. But we need to know, for example, for users in Asia, how does data flow when they are using Accused

Instrumentalities—is it international to international, how is it backed up, is it ever sent to the U.S., and the like. This has come up in other cases involving Google. You indicated you would check with your client and get back to us.

Request Nos. 97-109: These claims relate to storage of data and are therefore similar to Request No. 96 above. We are seeking sufficient-to-show documentation regarding data flow, where data is stored, master-client relationships, etc., as called for in the requests. This has come up in other cases involving Google. You indicated you would check with your client and get back to us.

Request No. 110: Google agrees to produce responsive, non-privileged documents.

Request No. 111: You had a question regarding our definition of “witness.” We are seeking any communications between Google and any third party (i.e., anyone other than a party or party-witness) regarding this lawsuit. You indicated you would check with your client and get back to us.

Request No. 112: Google agrees to produce responsive, non-privileged documents.

Request No. 113: This request seeks marketing and technical documents concerning the accused products and is likely encompassed by other requests, discussed above. The request is limited to functionalities accused of infringement. We are looking for documents regarding presentations, letters, or the like that Google has made or sent to third parties regarding how the accused products work, what’s done with them, why they’re important, marketing, importance, benefits, etc. You indicated you would check with your client and get back to us.

Request No. 114: Withdrawing for now. We may send a narrower request later.

Request No. 115: This is likely subsumed within other requests discussed above, except that we are seeking documents concerning projected and future activities. You indicated you would check with your client and get back to us.

Request No. 116: Now that we are no longer asserting the ‘065, we don’t need the request to go back so far in time. We are requesting documents for 3 months before the incorporation of user profile data into search functionalities for now. We may later need to come back and ask for specific information from earlier time periods. You indicated you would check with your client and get back to us. We also indicated that we may need high-level revenue and profit information since the introduction of the product in order to show secondary considerations of non-obviousness.

Request No. 117: The basis for our request is revenue recognition for third party payments. You indicated you would check with your client and get back to us.

Request No. 118: Market share information relates to secondary indicia of non-obviousness, and we have sent you cases to that effect. Please confirm that Google will produce responsive, non-privileged documents.

Request No. 119-22: These requests are relevant to damages issues. Please confirm that Google will produce responsive, non-privileged documents.

Request No. 123-125: Google agrees to produce responsive, non-privileged documents.

Request No. 126: We agree to limit documents regarding Nortel to those that relate to the auction, the Skillen family of patents, discussions between Google and Nortel in 2010, and Nortel intellectual property. With respect to employees, we are not expecting you to know every Nortel employee, but we are expecting you to know the names that Google interacted with in the 2010-2012 timeframe. Please confirm that Google will produce responsive, non-privileged documents.

Request No. 127-142: Google agreed to produce responsive, non-privileged documents and not to limit its production to only documents that support its contentions (as opposed to any documents that relate to the issues discussed in these requests).

Request No. 143: These documents are likely covered by other requests and this provision is a catch-all. We agreed to limit it to the Accused Instrumentalities since you dispute infringement. Please confirm that you will produce.

Request Nos. 144-145: These requests relate to secondary considerations of non-obviousness, including copying of an alleged embodiment of the invention (Google's Accused Instrumentalities) and praise, criticism, discussion of the significance of the Patents-in-Suit or alleged embodiments of their invention (Google's Accused Instrumentalities). You expressed skepticism that copying of an alleged embodiment of an invention (*i.e.*, copying of an Accused Instrumentality) is relevant. Please see, for example, *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1366 (Fed. Cir. 2001), in which the Federal Circuit held that copying of a commercial "embodiment of the claims" (in that case, Amazon's 1-Click® feature) is a relevant secondary consideration of non-obviousness. Please confirm that Google will produce responsive, non-privileged documents.

Request Nos. 146 and 148: Google says it does not maintain "organizational charts." It does, apparently, have a directory that indicates the reporting structure within the company and the identities and locations of employees. We are seeking such directory information for the relevant departments relating to the Accused Instrumentalities starting with the senior-most employees, then direct reports, senior vice presidents, team leads (product and technical), and then one level below that. We can follow up from there if we require anything further. You indicated you would check with your client and get back to us.

Request No. 147: This request is relevant to the technology transfer agreements we have discussed elsewhere. You indicated you would check with your client and get back to us.

Request No. 149: This request is similar to requests 82 and 83.

Request No. 150: Google agreed to produce responsive, non-privileged documents and not to limit its response to interrogatories expressly seeking identification of documents or documents Google chooses to cite per Rule 33(d).

Request No. 151: We agreed that this topic was premature but you understood that it calls for documents responsive to any 30(b)(6) topics when issued.

Request No. 152: We agreed to limit this to Google's document retention policies and any other policies concerning the preservation of documents, including email and chat transcripts, from August 1, 2000 to present. You indicated you would check with your client and get back to us.

Request No. 153: We similarly agreed to limit this to Google. We disagree that a litigation hold is privileged and you are following up with your client.

In addition, we informed you of our concern that Google's list of 20 most significant custodians does neither-- it includes fewer than 20 custodians and omits plainly significant custodians. We wish to discuss the inclusion of Larry, Sergey, the Senior Vice Presidents for the accused products who participate in the EMG (or equivalent), the most relevant custodian on the introduction of AdWords in 2000, the product and technical leads for the Accused Instrumentalities, and the custodians involved in the Nortel auction.

We look forward to our meeting tomorrow.

Regards,

Amanda Bonn | Susman Godfrey LLP

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