UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
NORFOLK DIVISION

I/P ENGINE, INC.,	)	
Plaintiff,	)	
v.	)	Civ. Action No. 2:11-cv-512
AOL, INC. et al.,	)	
Defendants.	)	

MEMORANDUM IN SUPPORT OF PLAINTIFF I/P ENGINE'S MOTION TO COMPEL DEFENDANT GOOGLE INC.'S CUSTODIAL DOCUMENT PRODUCTION

I. INTRODUCTION AND SUMMARY

More than six months ago, on November 7, 2011, I/P Engine, Inc. ("I/P Engine") served its initial document requests upon Defendant Google Inc. ("Google"). Those document requests were served pursuant to a stipulated agreement between the parties, whereby I/P Engine agreed to early disclosure of its infringement contentions, and Defendants agreed to engage in early document discovery. I/P Engine kept its part of the agreement. Six months later, however, Google has not produced a *single* custodial document, even though it acknowledges that it has collected those documents. I/P Engine repeatedly has been requesting Google for these documents, having conducted numerous meet-and-confers, but without success. On April 9, 2012, Google for the first time identified a target date for the production of those documents: June 15, 2012 – more than eight months after service of I/P Engine's document requests, and only a month before I/P Engine's expert reports are due.

Google's delays, and its proposed production date, are unreasonable, reflect a disregard for discovery procedures in this judicial district, and create tremendous prejudice for I/P Engine. Google has only itself to blame for this delay. I/P Engine understands that, as of April 9, Google had not yet even started reviewing the documents. Google should be obligated to immediately produce its custodial documents.

As explained by Google, the only reason it says it needs until June 15, 2012 to produce the custodial documents is because it claims it would take that long to review the documents it already has collected documents. In other words, Google's delay is nothing more than a question of allocation of resources. Google's counsel has the manpower and the resources to review the documents in whatever amount of time the Court orders. Reviewing the documents will take the same number of hours and will incur the same expense whether it is done over the next two weeks, or the next sixty days. It is not a matter of burden or expense – Google simply does not want to review and produce the documents quickly. This Court cannot allow Google to evade its discovery obligations simply by choosing to allocate fewer resources to a task so that it takes longer.

Google's proposed date of June 15, 2012 is unacceptable to I/P Engine, and should be unacceptable to the Court. Initial expert reports are due on July 18, 2012. Trial is set for October 16, 2012. Google's proposal to sandbag the end of discovery effectively would preclude I/P Engine from meaningfully reviewing and deposing the authors of the documents prior to the disclosure of expert reports. This Court should compel Google to produce all of its custodial documents by no later than April 30, 2012. If Google has not completed its review of the documents by that time, then the documents nonetheless should be produced subject to the clawback provisions of Rule 502 and the Agreed Protective Order entered in this case.

II. FACTUAL BACKGROUND

On November 4, 2011, the parties entered into a stipulation providing, among other things, that full discovery in the present litigation would commence. Ex. 1. On November 7, 2011, pursuant to the agreement, I/P Engine served written discovery including seventy-five (75) discovery requests on Google. Ex. 2. On December 7, 2011, Google produced technical documents that were pulled from Google's internal technical document repository, a collection of technical wikis prepared by and used by Google's engineers. That production did not include a single custodial document or any other relevant documents responsive to I/P Engine's document requests. Monterio Decl., ¶ 3.

The parties immediately began discussions towards identifying custodians and search terms for Google's custodial production. Google stalled, insisting that I/P Engine identify all of the proposed search terms and custodians that would help Google locate its own responsive documents. After several meet and confers, on December 23, 2011, I/P Engine sent Google an email concerning Google custodians and provided proposed search terms. Ex. 3. On January 9, 2012, Google responded requesting justification for certain custodians and calling I/P Engine's list of proposed search terms "useless": "[I/P Engine's] broad, meaningless [proposed] search terms [are] improper and [do] nothing to assist the parties in moving forward with discovery in a timely manner." Ex. 4. Prior to that point, however, Google had yet to propose a single search term that was associated with anything except Google's knowledge of the asserted patents.

Following another meet and confer, by January 10, 2012, the parties had agreed to eighteen (18) search terms. Ex. 5. Google's collection and review of documents related to these 18 agreed-upon search terms could have began more than four months ago.

Google continued to refuse to propose its own search terms, even though it knew its own documents, and had received I/P Engine's infringement contentions more than two months ago.

On January 13, 2012, Google insisted that I/P Engine "formulate reasonable, targeted search terms relevant to its case." Ex. 6. Trying to move the ball forward, at a meet and confer on January 17, 2012, the parties finally agreed that Google would search the files of nine employees. I/P Engine also proposed twenty-two narrowly tailored search terms with an explanation why I/P Engine included each particular search term. Ex. 7. Google did nothing for three weeks. On February 9, 2012, I/P Engine reminded Google of its discovery obligations with respect to its custodial production. Ex. 8. On February 13, 2012, Google retreated from its agreement to produce custodial documents from the agreed-upon employees. Ex. 9. After a meet and confer on February 21, 2012, Google agreed to search the files of its nine custodians, as agreed January 17. Ex. 10. On March 1, 2012, Google objected to many of I/P Engine's search terms that were proposed in January. For example, Google vaguely stated that one term "retrieves too high a percentage of hits" without proposing any alternatives or solutions. Ex. 11.

Patiently trying to resolve Google's incessant objections, I/P Engine continued to work towards a solution. During communications on March 2, 2012, Google demanded that I/P Engine provide support for certain terms that I/P Engine identified on January 24. Ex. 12. Because I/P Engine's January 24 letter specifically explained the basis for each proposed search term, Google's demand was nothing more than a stalling tactic, as I/P Engine pointed out on March 5, 2012. Ex. 13. The parties again communicated on March 7, 9, and 16, 2012 concerning search terms resulting in little forward progress. Exs. 14 and 15.

On March 18, 2012, I/P Engine stated that "Google's continuous negotiations with respect to search terms for Google's custodial search and the resulting delay in producing responsive documents [was] becoming a significant problem in the litigation." Ex. 16.

Threatening a motion to compel finally prompted Google to move forward; the parties finally agreed to search terms on March 27, 2012. Ex. 17.

Having agreed to the search terms, Google's review of responsive documents should have started immediately. On March 28, 2012, Google stated:

> Now that the parties have agreed to a final list of search terms, Google is running the search terms against the nine custodians' documents, and reviewing the results of those terms. We are endeavoring to determine the total number of documents to be reviewed so that we can provide an estimated date for completion of review and production. We will provide this estimated date as soon as possible.

Ex. 18.

Ever since then, I/P Engine has been pressing Google for an estimated date for production. On April 3, 2012, Google stated "[w]ith respect to Google's custodial production, we indicated that we will have a better idea of an estimated completion date at the end of this week and will give you our estimate then." Ex. 19. On April 6, 2012, Google stated that it needed until April 9, 2012 to provide an estimated completion date and requested a meet and confer on that date. Ex. 20.

During the April 9, 2012 meet and confer, Google stated that it had collected 250,000 custodial documents, stated that it needed to review those documents, and that it would produce all of those documents by June 15, 2012. Monterio Decl., ¶ 5. There was little discussion of whether these documents were relevant and responsive, because these documents were identified pursuant to the parties' negotiated search terms, which were closely tied to the issues in the litigation. Google's primary argument was that that it needed more than two months to review the documents for privilege. Monterio Decl., ¶ 6. Google tacitly admitted that it had not begun its review of the custodial documents. Google refused to agree to an earlier production date for all or even any portion of those documents. When I/P Engine stated that it would move to compel, Google's counsel stated that such a motion would be futile, because it would not be

ruled upon until May at the earliest, and that the Court would not order Google to immediately turn over all of its documents.[1]

III. APPLICABLE LAW

Rule 26(b)(1) governs the scope of discovery, providing that "[p]arties may obtain discovery regarding any non-privileged matter that is relevant to any party's claim or defense" or "appears reasonably calculated to lead to the discovery of admissible evidence." Fed. R. Civ. P. 26(b)(1). Rule 26(b) provides "very broad boundaries." *Gutshall v. New Prime, Inc.* (W.D. Va. 2000). This is because, "[i]n practice, a party cannot pursue its claims or defenses without an adequate opportunity to obtain evidence through the broad discovery contemplated by the Federal Rules." *Steward v. VCU Health System Authority*, 2011 WL 7281603 at *8 (E.D. Va. Nov. 22, 2011). "The provisions of Fed. R Civ. P. 26 afford district courts broad discretion over discovery matters." *Scott & Stringfellow, LLC v. AIG Commercial Equipment Finance, Inc.*, 2011 WL 1827900 at *2 (E.D. Va. May 12, 2011) (citing *Crawford-El v. Britton*, 523 U.S. 574, 598-99 (1998)). A party requesting discovery may move to compel the disclosure of any materials requested so long as such discovery is relevant and otherwise discoverable. *See* Fed. R. Civ. P. 37.

IV. ARGUMENT

I/P Engine is entitled to the discovery of any non-privileged information relevant to its claims or defenses or that appears reasonably calculated to lead to the discovery of admissible

[1] After the close of business on April 10, 2012, as I/P Engine was finalizing this motion, Google's counsel sent a letter proposing to produce custodial documents for three custodians by May 11, 2012, and would try to complete the final custodial production by May 30, 2012, "assuming that no significant issues arise as a result of the review process." Ex. 21. This proposal does little to advance the ball. I/P Engine has noticed Rule 30(b)(6) depositions for late April, and has proposed that fact depositions of Defendants take place in May and early June. Google's proposal would ensure that no fact depositions would take place until late June and July – on the eve of the expert report deadline.

evidence. Fed. R. Civ. P. 26(b)(1). This Court expects that the parties will produce documents in a timely and efficient manner and not intentionally delay given this Court's fast-paced schedule. There is not a dispute as to whether Google possesses relevant custodial documents and communications related to the present litigation. In fact, Google admits to possessing 250,000 relevant, responsive custodial documents. Moreover, Google does not dispute that it has not produced the custodial documents relevant to the present litigation. The only dispute between the parties is **when** Google will produce the relevant, responsive 250,000 custodial documents.

Google's sole basis for not having produced the documents is because it needs more than two months to review the documents for privilege. This assertion is without merit, for four reasons.

First, Google has already had more than six months to produce the documents. I/P Engine's document requests have been pending for 125 days. It has been 77 days since the parties agreed-upon the initial list of search terms, which account for approximately half of the search terms being used for Google's custodial search. Google's time has run out.

Second, Google's delays create tremendous prejudice to I/P Engine. Under Google's proposed schedule, I/P Engine would receive Google's document production 191 days after it was due, and 33 days before initial expert reports are due. I/P Engine would be unable to properly review the documents, prepare for, notice, negotiate dates, then depose those fact witnesses, and then incorporate that discovery into the expert reports. No doubt this is Google's intention. This conduct, however, should be not be acceptable to this Court.

Third, the only reason for review is for privilege. The documents are presumptively relevant, having been located through search terms specifically tied to the case. Privilege can be preserved pursuant to Rule 502 and the clawback provision in the protective order, which states:

> If information subject to a claim of attorney-client privilege, work product immunity, or other privilege, doctrine, right or immunity is nevertheless inadvertently or unintentionally produced, such production shall in no way prejudice or other constitute a waiver or estoppel as to any such privilege, doctrine, right or immunity. Any party that inadvertently produces materials protected by the attorney-client privilege, work product privilege or other privilege, doctrine, right or immunity may obtain the return of those materials by promptly notifying the recipient(s) and providing a privilege log for the inadvertently produced materials.

D.I. 85, Agreed Protective Order, Section 7.

Fourth, this issue is nothing more than a manpower issue. Google has the ability – whether through contract attorneys, a team of attorneys at Google's counsel, or otherwise, to review these documents faster than Google proposes to do so. What can be done in 60 days can be done in two weeks at the same cost using additional readily available resources. I/P Engine should not be punished because Google has delayed more than six months. The documents should be produced by no later than April 30, 2012.

V. CONCLUSION

For the foregoing reasons, this Court should compel Google to produce all relevant, non-privileged documents relating to I/P Engine's pending document requests by no later than April 30, 2012.

Dated: April 11, 2012

By: /s/ Jeffrey K. Sherwood

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CERTIFICATE OF SERVICE

I hereby certify that on this 11th day of April, 2012, the foregoing **MEMORANDUM IN SUPPORT OF PLAINTIFF I/P ENGINE'S MOTION TO COMPEL DEFENDANT GOOGLE INC.'S CUSTODIAL DOCUMENT PRODUCTION**, was served via the Court's CM/ECF system, on the following:

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