

UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF VIRGINIA  
NORFOLK DIVISION

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I/P ENGINE, INC.,		)	
		)	
	Plaintiff,	)	
	v.	)	Civ. Action No. 2:11-cv-512
		)	
AOL, INC. et al.,		)	
		)	
	Defendants.	)	
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**OPPOSITION TO GOOGLE’S MOTION TO COMPEL  
PLAINTIFF TO PRODUCE DOCUMENTS**

**I. INTRODUCTION**

Google’s Motion to Compel (“Motion”) is unnecessary. In its brief, Google demands the production of wholly irrelevant information from non-parties – Innovate/Protect, Ken Lang and even litigation counsel, Dickstein Shapiro. It does this all under the guise that it is seeking production from I/P Engine, which it is not, and that true discovery disputes exist, which they do not. In a nutshell, Google demands that this Court compel I/P Engine to produce: (1) any pre-litigation documents created by Dickstein Shapiro relating to the patents-in-suit; (2) all of Mr. Lang’s responsive documents or an explanation, if necessary, why any such documents no longer exist; (3) the consulting agreement between *Dickstein Shapiro* and Mr. Kosak; and (4) two non-responsive, non-relevant documents provided by *Innovate/Protect* to potential investors. Google’s requests are meritless.

First, I/P Engine has no legal right to or control over third party documents held by Dickstein Shapiro; and thus, cannot be compelled to produce any such documents or be sanctioned for any failure to do so. Dickstein Shapiro has never been subpoenaed to produce documents in this litigation. Google’s attempt to make an end-run around the discovery rules by

arguing that I/P Engine has a duty to search and produce Dickstein Shapiro's files is improper and contradicted by the discovery rules and the laws.

Second, as I/P Engine (and its counsel) have repeatedly told Google (and its counsel) with respect to Mr. Lang's production, I/P Engine and Mr. Lang produced all responsive, relevant documents and they are complying with their discovery obligations as required by law and the rules. It is unclear as to what further assurances Google requires.

Third, Google's demand that Dickstein Shapiro produce an agreement that relates to its own consultant is improper because Dickstein Shapiro has not been subpoenaed, the agreement is protected under the work-product doctrine, and the agreement is not relevant to Mr. Kosak's credibility.

Fourth, the two Innovate/Protect documents demanded (and as repeatedly indicated to Google) are not responsive and irrelevant to this litigation; they do not discuss, mention, or make reference to this litigation, the patents-in-suit or the subject matter of the patents-in-suit – the topics of the document requests identified by Google in its moving papers.

Accordingly, and for the reasons set forth below, I/P Engine respectfully requests that Google's motion be denied.

## **II. ARGUMENT**

### **A. I/P Engine has No Discovery Obligation or Duty to Produce Documents Related to Its Counsel's Efforts for Other Clients Related to the Patents-in-Suit**

Google has couched this issue as a failure of I/P Engine to produce documents. But Google's real request is for Dickstein Shapiro to search and produce its own documents, specifically "documents related to Dickstein Shapiro's pre-litigation involvement in offers to sell the patents-in-suit." Motion at 1-2. Google states that "[t]here can be no legitimate dispute that such documents *would* be responsive to" Google Document Request Nos. 1, 14, 16, 25 and 37;

there is a dispute. Google does not say that any such documents “are” responsive to Google-referenced requests, because those requests are directed to I/P Engine, not Dickstein Shapiro.

Google’s demand for Dickstein Shapiro’s documents relating to any pre-litigation involvement (before Dickstein Shapiro represented I/P Engine) is improper for three reasons. First, I/P Engine has repeatedly confirmed that it produced responsive documents to the identified requests. Second, Dickstein Shapiro has not been subpoenaed to produce documents in this litigation. Google proffers no authority supporting its position I/P Engine accountable for the production of any documents from any involvement its litigation counsel had with third parties – even if that involvement related to the same or similar subject matter – indeed, the case law is directly oppose. And third, any “pre-litigation” involvement relating to Dickstein Shapiro’s opinions, valuations, studies, due diligence, and the like relating to the Lycos patents or patents-in-suit would necessarily be protected under attorney-client privilege and/or the work-product doctrine. Although without having been properly served with discovery requests, it is impossible for Dickstein Shapiro to know which objections may or may not apply.

**1. I/P Engine has repeatedly confirmed that it has produced Documents Responsive to Google’s Document Requests.**

As I/P Engine repeatedly told Google, it has produced its relevant, non-privileged documents in its possession, custody and control, including any relevant, non-privileged documents from or to Dickstein Shapiro or any third party responsive to Google’s document requests. To the extent that I/P Engine withheld any documents based upon privilege or some other protection or immunity, those documents were identified in its privilege log.

**2. I/P Engine has no legal right to or control over third party documents held by Dickstein Shapiro; and thus, cannot be compelled to produce any such documents or be sanctioned for any failure to do so.**

To begin with the obvious, Dickstein Shapiro is not a party to the present litigation; nor is Lycos, Altitude Capital Partners or Eidos. I/P Engine is the responsive party in this litigation. To the extent that Google's request relates to documents in the possession, custody or control of other third parties such as Lycos, Altitude Capital Partners or Eidos, its request and motion to compel are improper. I/P Engine has no discovery obligation or duty to produce documents related to its counsel's efforts for others. *See Poppino v. Jones Store Co.*, 1 F.R.D. 215, 219 (W.D. Mo. 1940) ("Attorneys have numerous clients and the documents of one client do not simply come within the control of another client merely because both clients have retained the services of the same lawyer or law firm.").

Google fails to cite to a single piece of authority in support of its position that I/P Engine has a duty to have its litigation counsel search and produce or log documents that it may have created or collected prior to counsel's representation of I/P Engine; that is because there are not any.<sup>1</sup> To the contrary, the law directly refutes Google's position.

For clarification, Google is seeking documents it believes to exist related to work Dickstein Shapiro may have done on behalf of other third-party clients such as Lycos, Altitude

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<sup>1</sup> Instead, to justify its request, Google asserts that "Mr. Berger's and Mr. Blais' testimony demonstrates that Dickstein Shapiro was involved in offers to sell or purchase Lycos' patent portfolio." Motion at 10. And it goes on to state that "it did not appear that all of the documents related to this involvement were included in Plaintiff's document production" *Id.* First, Google misconstrues the testimony of both Mr. Berger and Mr. Blais. Neither witness testified that "Dickstein Shapiro was involved in offers to sell or purchase Lycos' patent portfolio." *Id.* Indeed, Mr. Blais specifically stated that "Dickstein made the introductions, but they were not involved in the discussions." Ex. 1 at 134, line 24 – 135, line 3. Mr. Berger also testified that he contacted Mr. Blais on his own, and was provided a list of patents potentially for sale by and negotiated with Mr. Blais. Regardless, even if Dickstein Shapiro was somehow more involved, the same arguments discussed in this section apply.

Capital Partners, and/or Eidos.<sup>2</sup> Under the Federal Rules of Civil Procedure, document requests served upon a party – here I/P Engine – encompass all documents in that party’s “possession, custody or control.” Fed. R. Civ. P. 34(a)(1).<sup>3</sup> “Because a client has the right, and the ready ability, to obtain copies of documents gathered or created by its attorneys pursuant to their representation of that client, such documents are clearly within the client’s control.” *Am. Soc’y For Prevention of Cruelty To Animals v. Ringling Brothers and Barnum & Bailey Circus*, 233 F.R.D. 209, 212 (D.D.C. 2006); *see also Poppino*, 1 F.R.D. at 219 (“It is quite true that if an attorney for a party comes into possession of a document as attorney for that party his possession of the document is the possession of the party.”). However, where a party has no legal right to a document held by a third party, and thus no control over that document, the party cannot be compelled to produce the document or be sanctioned for its failure to do so. *Cochran Consulting, Inc. v. Uwatec USA, Inc.*, 102 F.3d 1224, 1229-30 (Fed. Cir. 1996).

Neither is Rule 34 the correct discovery tool for gaining access to Dickstein Shapiro’s work product for other clients. *Hickman v. Taylor*, 329 U.S. 495, 504 (1947) (explaining that Rule 34 “is limited to parties to the proceeding, ***thereby excluding their counsel or agents***”) (emphasis added); 8 Charles A. Wright, et al., *Federal Practice and Procedure* § 2208 (Rule 34 creates a discovery device only against parties and does not run against a party’s counsel or nonparty witnesses). When documents are sought from a nonparty, the usual method of compelling production is via a subpoena under Fed. R. Civ. P. 45. *See* Fed. R. Civ. P. 34(c); 9A Charles A. Wright, et al., *Federal Practice and Procedure* § 2456 (“The subpoena duces tecum is the only way to compel a nonparty to produce documents or other materials.”). This includes

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<sup>2</sup> Dickstein Shapiro did represent Lycos, Altitude Capital Partners and Eidos at one time with respect to pending litigation or potential litigation.

<sup>3</sup> “Control is defined not only as possession, but as the legal right to obtain the documents requested upon demand.” *Searock v. Stripling*, 736 F.2d 650, 653 (11th Cir. 1984).

work product held by a nonparty attorney. Again, Dickstein Shapiro has not been subpoenaed in the present litigation. Google has, however, subpoenaed documents from Lycos, Altitude Capital Partners and Eidos.

If Google's position is that representing a client opens an attorney's files to search for all relevant documents, then that same argument may be made that all of opposing counsel's documents related to search advertising systems and the accused products, e.g., Google's AdWords and AdSense for Search systems, in its files are in the possession, custody and control of Google for purposes of this litigation and should be searched for and produced in response to I/P Engine's pending document requests. In this situation, Google is a constant client, whereas Google now seeks documents from litigation counsel of other third parties.

**3. Any "pre-litigation" involvement by Dickstein Shapiro relating to the Lycos patents or patents-in-suit would be protected under attorney-client privilege and/or the work-product doctrine.**

Any investigations, communications or due diligence performed by Dickstein Shapiro relating to the patents-in-suit are privileged and/or work product. A majority of courts have held (and Google cannot now dispute) that the privilege endures after termination of the proceedings or representation for which the documents were created, especially if the old and new matters are related. *See In re Grand Jury Proceedings*, 43 F.3d 966, 971 (5th Cir. 1994); *In re Murphy*, 560 F.2d 326, 333-34 and 334 n. 13 (8th Cir. 1977).

**B. Mr. Lang's Relevant and Responsive Documents Have Been Produced**

In its moving brief, Google demands that this Court compel I/P Engine to produce "all of Mr. Lang's documents responsive to Defendants' discovery requests, and to the extent that any such documents have not been maintained or no longer exist provide an explanation for their destruction." Motion at 9. But I/P Engine has done both (confirming multiple times); it therefore fails to understand what Google is compelling with respect to Mr. Lang's documents.

As acknowledged in Google's *own* July 20 letter, I/P Engine confirmed that:

[a]n investigation had been conducted, [I] confirmed that you had found the copies of these emails in Lang's production and that they were inadvertently withheld from production, and you confirmed that there were no other documents being improperly withheld from production.

D.I. 211, Ex. L at 9.

This issue stems from two emails between Mr. Lang and Mr. Kosak. Mr. Kosak produced copies, but Mr. Lang's copies were inadvertently withheld from Mr. Lang's production. They had been produced in Mr. Kosak's production. Despite I/P Engine's subsequent confirmation that all documents had been produced, Google also demanded that I/P Engine "confirm that Mr. Lang's documents are being properly maintained and have been properly maintained throughout the pendency of this litigation." *Id.* This was the only issue regarding Mr. Lang's production open when Google filed this current motion.

I/P Engine promptly responded on July 24 (the same day) stating that it was "complying with its discovery obligations as required by law and the rules." D.I. 211, Ex. M. Despite this confirmation, Google again demanded that I/P Engine confirm that Mr. Lang's documents are being properly maintained. And I/P Engine once again promptly responded saying:

Regarding Mr. Lang's documents, if Defendants have something specific that they are concerned with please explain it. Otherwise, it is unclear as to what the issue is here. Again, our clients are in compliance with their discovery requirements. We do not understand why we have to repeatedly confirm this fact for Defendants with respect to an individual or a company. Again, if Defendants have a specific concern we will try to address it.

D.I. 211, Ex. I at 1. I/P Engine heard nothing further regarding this issue until Google filed the present motion. Accordingly and again, I/P Engine fails to understand what Google is seeking to compel regarding Mr. Lang's documents.

**C. Mr. Kosak’s Consulting Agreement with Dickstein Shapiro is Protected Attorney-Work Product**

In its moving brief, Google declares that “Plaintiff has failed to justify its refusal to provide the [Kosak] consulting agreement.” Motion at 7. But the agreement that Google is demanding be produced is not between I/P Engine and Mr. Kosak; it is between Dickstein Shapiro and Mr. Kosak. Mr. Kosak has a separate agreement with Innovate/Protect, which Google acknowledges was produced. *Id.* at 5. Google’s demand that Dickstein Shapiro produce an agreement that relates to its own consultant is improper for several reasons, including again, that Dickstein Shapiro has not been subpoenaed, the agreement is protected under the work-product doctrine, and the agreement is not relevant to Mr. Kosak’s credibility.

Mr. Kosak was retained by Dickstein Shapiro as a consultant. Dickstein Shapiro is litigation counsel in this matter. Dickstein Shapiro has not been subpoenaed to produce any of its documents, which (although unclear from its brief) is what Google is demanding. Google cites to no rules or authority that requires the production by litigation counsel of consulting agreements – even if it had been properly subpoenaed, which again it was not.<sup>4</sup>

The agreement is also protected under the attorney-work product doctrine. The authority relied upon by Google is inapposite. In *New York v. Solvent Chem. Co.*, 166 F.R.D. 284, 291 (W.D.N.Y. 1996), which was between a party and a hostile fact witness – opposed to here where it is litigation counsel and a consultant, the court found it improper that Solvent had paid a hostile fact witness, who had left the company on bad terms, to serve as a litigation consultant to presumably secure sympathetic testimony from that witness. *See also Montgomery v. Aetna*

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<sup>4</sup> This fact is also why Mr. Kosak’s consulting agreement is not listed on any privilege log. Dickstein Shapiro has not been served with discovery requests; accordingly, it has not produced or withheld any documents. For the same reason, it has not provided a privilege log or waived any privileges.



*Plywood, Inc.*, 1996 U.S. Dist. LEXIS 9213, \*8 (N.D. Ill. June 28, 1996) (“The consulting agreements were solicited in anticipation of litigation. These documents are protected by the work product privilege.”).

Neither has any protection or privileges attached to the Dickstein/Kosak agreement been waived, as claimed by Google. Motion at 7. As previously indicated, Dickstein Shapiro has never been served with discovery requests; accordingly, it has not produced or withheld any documents. For the same reason, it has not provided a privilege log or waived any privileges or protections relating to the Dickstein/Kosak Agreement.

The only reason that Google provides in its brief for why the Dickstein/Kosak agreement should be produced is that it relates to Mr. Kosak’s credibility. But Google already deposed Mr. Kosak regarding his consulting relationship with Dickstein Shapiro. If Mr. Kosak’s credibility is really the issue, the fact that the agreement exists and that he is a paid consultant has already been established through Mr. Kosak’s own deposition testimony. In fact, and as Google has pointed out, Mr. Kosak is also a co-inventor of the patents in suit, owns shares of I/P Engine and has been contracted as a consultant by I/P Engine. Google may attempt to make whatever hay about Mr. Kosak’s credibility it wants using each of these facts. Its suggestion that there is something additional within the four corners of the agreement that it will glean related to his credibility is baseless. *See Synopsis, Inc. v. Ricoh Co., Ltd.*, 2006 WL 2458721, \*2 (N.D. Cal. Aug. 22, 2006) (“As for the consulting agreement and documents related to payment for Dr. Foo’s services, Ricoh does not cite any authority to support its claim that those documents should be produced. . . . Ricoh will be able to impeach Dr. Foo at trial with the fact that he is a consultant for Defendants.”).

**D. Non-Party Innovate/Protect’s Purchase Agreement and Compiled Financial Statements Are Not Responsive or Relevant to Google’s Document Requests**

Google is first seeking the production of two documents: (1) the form purchase agreement provided to potential investors, and (2) its compiled financial statements provided to potential investors. Motion at 3.<sup>5</sup> According to Google, these documents are responsive to Google’s Document Request Nos. 37 and 49.

Document Request No. 37 seeks “[a]ll DOCUMENTS concerning any communications with third parties regarding the subject matter of this Action or the PATENTS-IN-SUIT.” D.I. 211, Ex. F at 13.

Document Request No. 49 seeks “[a]ll DOCUMENTS concerning any litigation, threatened litigation or possible litigation involving the PATENTS-IN-SUIT.” *Id* at 15.

D.I. 211, Ex. F at 13 and 15.

As shown, these two requests seek documents and communications concerning (1) the subject matter of this litigation, (2) the subject matter of any other actual or possible litigation involving the patents-in-suit, and/or (3) the patents-in-suit themselves. As I/P Engine has repeatedly informed Google, neither of the two requested documents concerns the subject matter of this litigation, the subject matter of any other litigation involving the patents-in-suit, or the patents-in-suit themselves.

These documents generally relate to the stock terms between *Innovate/Protect* (not I/P Engine) and a potential investor and the financial statements of Innovate/Protect. They are neither relevant (nor likely to lead to relevant information relating) to any claims or defenses in

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<sup>5</sup> The third and fourth documents requested by Google’s Motion have either already been produced or are readily available to Google. I/P Engine has already produced the executive summary (e.g., IPE 0017715-722), and the complaint in this case is readily available to the parties.

this litigation, nor responsive to Document Request Nos. 37 and 49. And Google has failed to even explain how they might be.

Indeed, Google's only reason for why I/P Engine should produce them is because it claims that "[t]he business of Innovate/Protect and its subsidiary I/P Engine is this litigation" and because of that "such documents are responsive to Google's document requests and relevant to claims or defenses in this case." Motion at 3-4. This is unsupported rhetoric by Google. Google's opinion regarding the efficacy of I/P Engine's business (even if true, which it is not) is irrelevant. Again, Google does not identify, and cannot identify, one issue, claim or defense to which the communications with potential investors and Innovate/Protect's financial statements are relevant or why they are responsive to Document Request Nos. 37 and 49. The demanded documents are not publicly available, and contain highly confidential information. Google should at a minimum identify a valid reason why they are responsive, much less relevant to any issue in this litigation.

### **III. CONCLUSION**

Accordingly, Google's Motion to Compel should be denied in all respects.

Dated: August 28, 2012

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 28th day of August, 2012, the foregoing **OPPOSITION TO GOOGLE'S MOTION TO COMPEL PLAINTIFF TO PRODUCE DOCUMENTS**, was served via the Court's CM/ECF system, on the following:

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