

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
NORFOLK DIVISION

I/P ENGINE, INC.

Plaintiff,

v.

AOL INC., *et al.*,

Defendants.

Civil Action No. 2:11-cv-512

**MEMORANDUM IN SUPPORT OF DEFENDANTS' MOTION TO COMPEL
DEPOSITION OF DR. BECKER**

Plaintiff is seeking a significant enhancement for post-judgment royalties based solely on the opinion of an expert who Plaintiff is unwilling to make available for deposition without unreasonable conditions. Such a position is contrary to basic fairness and the law. Defendants ask the Court to compel Plaintiff to produce Dr. Becker for deposition to provide Defendants the opportunity to examine his new damages theory and to allow the Court to make a decision about ongoing royalties based on a complete and thorough record.

BACKGROUND

In seeking post-judgment royalties, Plaintiff filed a declaration from its damages expert that includes numerous factual allegations not before the jury, opinions about a hypothetical negotiation occurring more than eight years after the hypothetical negotiation at issue at trial and involving different parties, and a conclusion as to damages not at issue at trial, including a different (43% higher) royalty rate than Dr. Becker testified to at trial. (*See* D.N. 824.)

Defendants requested that Plaintiff make Dr. Becker available for deposition prior to January 22, 2013, to give Defendants time to question Dr. Becker about these new theories and then respond to Plaintiff's motion for post-judgment royalties by the current deadline of January 25, 2013. Despite Defendants' repeated attempt to reach a compromise, Plaintiff refused to produce Dr. Becker unless Defendants agreed to inappropriate, unrelated, and burdensome terms.¹ (*See* Noona Dec. Exs. 1, 2; Noona Dec. ¶ 3.)

ARGUMENT

As Defendants explained in previous filings, Dr. Becker's "declaration" is really a supplemental expert report that puts forth an entirely new damages theory. (*See* D.N. 848, 4-5; D.N. 853, 5-8.) It is black letter law that a party may depose opposing expert witnesses. *See* Fed. R. Civ. P. 26(b)(4)(A). Because Plaintiff's expert on damages submitted a supplemental report that relied on facts and reached a conclusion about which Defendants previously have not had the opportunity to examine him, Defendants should be able to question him about these new facts and opinions.

The right to depose experts that rely on additional evidence that was not presented at trial, as Dr. Becker has done here, is expressly supported in the post-judgment royalties context. *See Paice LLC v. Toyota Motor Corp.*, No. 2:04-cv-00211-DF, D.N. 241 (E.D. Tex. Mar. 13, 2008) (ordering discovery, including depositions, and briefing over a three month period leading up to an evidentiary hearing for purposes of determining an ongoing royalty). Indeed, the court in *Paice*, responding to the Federal Circuit's direction to allow the parties to present evidence

¹ Plaintiff's refusal to promptly make Dr. Becker available for deposition without unreasonable conditions has caused delay and further condensed an already brief period of time to respond to Plaintiff's Motion for an Award of Ongoing Royalties. This fact further supports Defendants' request to delay briefing and postpone ruling on that motion. Defendants ask the Court to consider this additional fact in deciding whether to grant Defendants' Motion to Postpone Briefing and Ruling on Plaintiff's Motion for Post-Judgment Royalties. (D.N. 847.)

before determining an ongoing royalty, also ruled that depositions may be taken of “any witness that execute[d] a declaration submitted with the other party’s brief” in addition to “experts that submitted expert reports.” *Paice*, No. 2:04-cv-00211-DF, D.N. 241 at 3; *see also Creative Internet Adver. Corp. v. Yahoo! Inc.*, 674 F. Supp. 2d 847, 856-57 (E.D. Tex. 2009) (citing to deposition testimony produced post-trial in discussing ongoing royalty determination). Thus, Dr. Becker should be made available for deposition even were his declaration not properly characterized as a supplemental expert report.

CONCLUSION

For the foregoing reasons, Defendants respectfully request this Court grant their Motion to Compel Deposition of Dr. Becker and order Plaintiff to make Dr. Becker available for deposition. Defendants further request that the Court order that the deadline for Defendants’ opposition to Plaintiff’s Motion for an Award of Post-Judgment Royalties be extended until at least seven days after Plaintiff makes Dr. Becker available for deposition.²

DATED: January 16, 2013

/s/ Stephen E. Noona
Stephen E. Noona
Virginia State Bar No. 25367
KAUFMAN & CANOLES, P.C.
150 West Main Street, Suite 2100
Norfolk, VA 23510
Telephone: (757) 624.3000
Facsimile: (757) 624.3169
senoona@kaufcan.com

² Defendants note this requested relief does not alter the relief sought in Defendants’ Motion to Postpone Briefing and Ruling on Plaintiff’s Motion for Post-Judgment Royalties. (D.N. 847.) Defendants request that the Court compel the deposition of Dr. Becker, and that the deposition be at least seven days prior to the deadline for Defendants’ opposition to Plaintiff’s Motion for an Award of Post-Judgment Royalties, whenever that deadline may be.

David Bilsker
David A. Perlson
QUINN EMANUEL URQUHART &
SULLIVAN, LLP
50 California Street, 22nd Floor
San Francisco, California 94111
Telephone: (415) 875-6600
Facsimile: (415) 875-6700
davidbilsker@quinnemanuel.com
davidperlson@quinnemanuel.com

*Counsel for Google Inc., Target Corporation, IAC
Search & Media, Inc., and Gannett Co., Inc.*

By: /s/ Stephen E. Noona

Stephen E. Noona
Virginia State Bar No. 25367
KAUFMAN & CANOLES, P.C.
150 W. Main Street, Suite 2100
Norfolk, VA 23510
Telephone: (757) 624-3000
Facsimile: (757) 624-3169

Robert L. Burns
FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER, LLP
Two Freedom Square
11955 Freedom Drive
Reston, VA 20190
Telephone: (571) 203-2700
Facsimile: (202) 408-4400

Cortney S. Alexander
FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER, LLP
3500 SunTrust Plaza
303 Peachtree Street, NE
Atlanta, GA 94111
Telephone: (404) 653-6400
Facsimile: (415) 653-6444

Counsel for Defendant AOL Inc.

CERTIFICATE OF SERVICE

I hereby certify that on January 16, 2013, I will electronically file the foregoing with the Clerk of Court using the CM/ECF system, which will send a notification of such filing (NEF) to the following:

Jeffrey K. Sherwood
Kenneth W. Brothers
DICKSTEIN SHAPIRO LLP
1825 Eye Street NW
Washington, DC 20006
Telephone: (202) 420-2200
Facsimile: (202) 420-2201
sherwoodj@dicksteinshapiro.com
brothersk@dicksteinshapiro.com

Donald C. Schultz
W. Ryan Snow
Steven Stancliff
CRENSHAW, WARE & MARTIN, P.L.C.
150 West Main Street, Suite 1500
Norfolk, VA 23510
Telephone: (757) 623-3000
Facsimile: (757) 623-5735
dschultz@cwm-law.com
wrsnow@cwm-law.com
sstancliff@cwm-law.com

Counsel for Plaintiff, I/P Engine, Inc.

/s/ Stephen E. Noona
Stephen E. Noona
Virginia State Bar No. 25367
KAUFMAN & CANOLES, P.C.
150 West Main Street, Suite 2100
Norfolk, VA 23510
Telephone: (757) 624.3000
Facsimile: (757) 624.3169
senoona@kaufcan.com