

**UNITED STATES DISTRICT COURT  
DISTRICT OF COLORADO**

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| <p>GOOGLE INC.,</p> <p style="text-align: center;">Plaintiff,</p> <p style="text-align: center;">v.</p> <p>SHERIDAN ROSS P.C.</p> <p style="text-align: center;">Defendant.</p> | <p>Misc. Civil Action No. [            ]<br/>(District of Colorado)</p> |
| <p>TRACBEAM, L.L.C.,</p> <p style="text-align: center;">Plaintiff,</p> <p style="text-align: center;">v.</p> <p>GOOGLE INC.,</p> <p style="text-align: center;">Defendant.</p>  | <p>Civil Action No. 6:13-cv-00093<br/>(Eastern District of Texas)</p>   |

**GOOGLE INC.’S MOTION TO COMPEL  
PRODUCTION OF PERSONNEL FILE FROM SHERIDAN ROSS P.C.**

In the above-captioned case, Plaintiff TracBeam, LLC (“TracBeam”) has accused Google Inc. (“Google”) of infringing two U.S. patents. Dennis Dupray is a named inventor of these patents, and Dr. Dupray also prosecuted these patents while employed at Sheridan Ross P.C. (“Sheridan Ross”). Yet when Google subpoenaed Sheridan Ross to seek production of Dr. Dupray’s personnel file, Sheridan Ross refused to produce it.

There is no legitimate basis for Sheridan Ross’s refusal to produce this file. Given that Dr. Dupray purported to conceive and prosecute the asserted patents while employed at Sheridan Ross, Sheridan Ross’s personnel file on Dr. Dupray is relevant to numerous claims and defenses in this case. As one example, Google has a defense of prosecution laches, which alleges that Dr. Dupray unreasonably delayed during the decade-long prosecution of the patents. Sheridan Ross’s personnel file on Dr. Dupray is highly relevant to show whether Sheridan

Ross criticized Dr. Dupray for this protracted prosecution, commented on this protracted prosecution, or otherwise took a position on whether Dr. Dupray's prosecution behavior was reasonable. This in turn, could constitute highly relevant evidence for Google's prosecution laches defense. Of course, any discussion of his activities concerning the patents at issue could be relevant, and, as such, the request is reasonably calculated to lead to the discovery of admissible evidence. Indeed, Sheridan Ross has never claimed that the personnel files lacks any references to the asserted patents.

Sheridan Ross's primary objection to production of this personnel file was based on confidentiality concerns. While Google is sensitive to the fact that the personnel file may contain certain confidential information pertaining to Dr. Dupray, that is not grounds to refuse to produce the file. To the contrary, the Stipulated Protective Order in this case expressly contemplates that even highly confidential documents may be produced, and it sharply restricts who may view such documents in order to protect their confidential nature. Sheridan Ross is free to designate Dr. Dupray's personnel file as Highly Confidential under the Protective Order – but it is *not* free to refuse production of this file altogether.

In a further attempt to accommodate potential confidentiality concerns regarding the personnel file, Google stated that it “would not object to Sheridan Ross redacting out Dr. Dupray's social security number, address, salary, tax forms/tax information, and other sensitive personal and financial information which bears no relation to Dr. Dupray's conception, reduction-to-practice, or prosecution of the Asserted Patents.” (Ex. A,<sup>1</sup> 4.11.13 e-mail from Sohn to Eichmann)). This concession was still not enough for Sheridan Ross, which would not

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<sup>1</sup> All Exhibits (denoted with “Ex.”) are Exhibits to the Declaration of Joshua L. Sohn, filed concurrently herewith.

produce the personnel file even in such redacted form. Accordingly, Google has no choice but to bring the present motion to compel.

## I. FACTUAL BACKGROUND

On May 19, 2011, TracBeam added Google as a new defendant in an existing patent infringement suit, which alleged infringement of two U.S. Patents. *See TracBeam, LLC v. AT&T et al.*, No. 6:11-cv-00096, Dkt. 57 (May 19, 2011).<sup>2</sup> Dennis Dupray is a named inventor on both asserted patents. Dr. Dupray also prosecuted both patents, while he was employed at Sheridan Ross. (*See Ex. B (Dupray Dep.) 113:13-114:6.*) Indeed, he was the lone individual who prosecuted these patents. (*See id.*)

On December 28, 2012, Google served a document and deposition subpoena on Sheridan Ross. The document portion of this subpoena asked for, *inter alia*, “Dennis J. Dupray’s personnel file at Sheridan Ross.” (Ex. C).<sup>3</sup> On January 28, 2013, Sheridan Ross<sup>4</sup> objected to this document request as follows:

Sheridan Ross objects to the extent this topic calls for information subject to the attorney client privilege or work product doctrine. Sheridan Ross objects to this topic on the ground that it seeks irrelevant information. Sheridan Ross objects to this topic on the ground that it seeks information that is subject to state and federal privacy protection.

(Ex. D at 5). In a meet-and-confer on March 22, 2013, Sheridan Ross reiterated its position that Dr. Dupray’s personnel file is non-discoverable under Colorado

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<sup>2</sup> The Court subsequently severed the *TracBeam v. Google* case from the parent *TracBeam v. AT&T et al.* case, and the two cases are proceeding in parallel. (*See id.*, Dkt. 353 (Jan. 23, 2013)).

<sup>3</sup> As shown on the final pages of this Exhibit, the subpoena to Sheridan Ross issued out of the District of Colorado, which is why Google brings its Motion to Compel in this District.

<sup>4</sup> TracBeam’s counsel Jeffrey Eichmann is representing Sheridan Ross for purposes of the subpoena, and Sheridan Ross’s positions regarding the subpoena were all conveyed to Google through Mr. Eichmann.

employment/privacy laws. (Ex. A, 3.24.13 e-mail from O'Brien to Eichmann.) In subsequent correspondence, Google pointed out that courts in the District of Colorado have regularly ordered production of personnel files. (*Id.*, 3.26.13 e-mail from Schenck to Eichmann.) Sheridan Ross maintained its privacy objections, however, citing various Colorado state common law privacy doctrines. (*Id.*, 3.27.13 e-mail from Eichmann to Schenck.)

In a final attempt to avoid motion practice and obtain the voluntary production of Dr. Dupray's personnel file, Google wrote to Sheridan Ross to say that it "would not object to Sheridan Ross redacting out Dr. Dupray's social security number, address, salary, tax forms/tax information, and other sensitive personal and financial information which bears no relation to Dr. Dupray's conception, reduction-to-practice, or prosecution of the Asserted Patents." (*Id.*, 4.11.13 e-mail from Sohn to Eichmann.) Google pointed out that Colorado courts have endorsed such targeted subject-matter redactions as a way to honor confidentiality concerns while still facilitating production of relevant documents. (*See id.*) Sheridan Ross did not respond to this proposal. (Sohn Decl., ¶ 6).

## **II. ARGUMENT**

### **A. Discovery Into Dr. Dupray's Personnel File is Reasonably Calculated to Lead to Discovery of Admissible Evidence**

As an initial matter, there can be no genuine dispute that Dr. Dupray's personnel file meets the basic relevance threshold for discoverability under the Federal Rules. As noted above, Dr. Dupray was the lone individual who prosecuted the asserted patents, and Google has raised the defense of prosecution laches due to the decade-long prosecution of these patents. Prosecution laches requires a showing of "unreasonable and unexplained delay" in patent prosecution. *See Symbol Tech., Inc. v. Lemelson Medical, Educ. & Res. Found.*, 422 F.3d 1378, 1385 (Fed. Cir. 2005) ("[P]rosecution laches may render a patent unenforceable when it has

issued only after an unreasonable and unexplained delay in prosecution.”). Thus, the central question in the prosecution laches analysis is whether Dr. Dupray’s behavior in prosecuting these patents was unreasonable and unexplainable.

It is self-evident that the personnel file kept on him by his employer – Sheridan Ross – could contain critical information bearing on the reasonability or explainability of his prosecution actions. By way of illustration, the personnel file might show that Sheridan Ross criticized Dr. Dupray for his decade-long prosecution of these patents, disciplined him for this protracted prosecution, or otherwise took a position on the reasonableness of his prosecution. Conversely, the personnel file might show that Dr. Dupray had a valid excuse for the protracted nature of the prosecution.

All of this information would be highly relevant to Google’s prosecution laches defense, given that this defense centers on Dr. Dupray’s prosecution behavior. By way of analogy, courts in this District have ordered production of employee personnel files when the employment-related behavior of that employee is at issue in the litigation. *See, e.g., E.E.O.C. v. Dillon Cos., Inc.*, No. 09-2237, 2010 WL 3239262, at \*2 (D. Colo. Aug. 13, 2010) (in employment discrimination case, ordering production of personnel files for employees who allegedly harassed plaintiff). Such is the case here – Dr. Dupray’s employment-related behavior in prosecuting the asserted patents is absolutely at issue for Google’s prosecution laches defense, and thus Google is entitled to production of his personnel file.

Even outside the realm of prosecution laches, references to the asserted patents in the personnel file could be relevant to any number of claims and defenses in this case – for example, discussions of prior art to the asserted patents would be relevant to invalidity, while discussions

of the asserted patents' scope would be relevant to infringement. Indeed, Sheridan Ross has never claimed that the personnel files lacks any references to the asserted patents.

**B. Confidentiality Concerns Are No Basis to Deny Production of the Personnel File**

Google does not dispute that Dr. Dupray's personnel file – like any employee personnel file – may contain confidential information pertaining to Dr. Dupray. But the mere fact that personnel files may contain confidential information is no basis to deny their production, as evidenced by the fact that courts in this District have regularly ordered production of personnel files. *See E.E.O.C.*, 2010 WL 3239262 at \*2; *see also Enos-Martinez v. Bd. of Cnty. Comm'rs of Cnty. of Mesa*, No. 10-33, 2011 WL 836478, at \*1-\*2 (D. Colo. March 7, 2011) (ordering production of employee personnel files).

Furthermore, Google has already gone to great lengths to be sensitive to Dr. Dupray's legitimate confidentiality concerns. For example, despite the usual rule that documents should not be redacted for relevance or confidentiality, Google has stated that it would not object to Sheridan Ross producing Dr. Dupray's personnel file in a form that redacts out "Dr. Dupray's social security number, address, salary, tax forms/tax information, and other sensitive personal and financial information which bears no relation to Dr. Dupray's conception, reduction-to-practice, or prosecution of the Asserted Patents." (Ex. A, 4/11/13 e-mail from Sohn to Eichmann.) And if Sheridan Ross desires additional confidentiality protections beyond these subject-matter redactions, it is free to designate the entire personnel file as Highly Confidential under the Stipulated Protective Order, which would limit its disclosure to outside counsel and a very small number of additional individuals. *See Stipulated Protective Order (TracBeam, LLC v. Google, Inc.*, No. 6:13-cv-00093, Dkt. 8) at §§ I(B)(2); II(A)(2). Thus, Sheridan Ross can honor

Dr. Dupray's legitimate confidentiality interests without withholding the personnel file from production altogether.

In its prior correspondence, Sheridan Ross argued that Colorado state-law confidentiality doctrines preclude Google from discovering Dr. Dupray's personnel file. (Ex. A, 3.27.13 e-mail from Eichmann to Schenck.) But this position is incorrect for numerous reasons. First, it is Federal law – not Colorado law – that supplies the rules of discovery and privilege in this Federal-question patent case. *See* Fed. R. Evid. 501, Advisory Committee Note (1974) (“[I]n criminal and Federal question civil cases, federally evolved rules on privilege should apply since it is Federal policy which is being enforced.”). As noted above, several Federal courts in this District have ordered production of personnel files, and have not invoked any Colorado state-law doctrines to bar such production.

Second, even if Colorado law did apply to this dispute, Google can satisfy the Colorado standards for production of confidential information with respect to Dr. Dupray's personnel file. The leading Colorado case articulating the standard for production of highly confidential information is the *Stone* case, in which the Colorado Supreme Court held that such information should only be produced if the propounding party shows a “compelling need” for the information and the discovery request is the “least intrusive alternative” to obtain the requested information. *See Stone v. State Farm Mut. Auto. Ins. Co.*, 185 P.3d 150, 159 (Colo. 2008). As for “compelling need,” Google has explained above how Dr. Dupray's behavior during prosecution is central to Google's prosecution laches defense, and Dr. Dupray's personnel file is likely the most comprehensive summary and evaluation of his prosecution behavior. As for “least intrusive alternative,” Google has explained how it has offered to permit generous subject-matter redactions, so that production of the personnel file will be as non-intrusive as possible and will

not result in unnecessary disclosure of Dr. Dupray's personal or confidential information. The *Stone* case expressly endorses such targeted redactions as a way of protecting confidentiality concerns while still facilitating the production of relevant materials. *See id.* at 159 (explaining, in the context of confidential tax returns, that "if a court determines that a compelling need for the returns does exist, the court should focus on the specific information that the party requesting discovery is actually seeking, and limit the permitted discovery to the necessary materials – by, for example, redacting irrelevant information – as opposed to ordering blanket disclosure of the entire returns.").

Sheridan Ross's final argument against production is that the personnel file is somehow superfluous or irrelevant because Google has already taken Sheridan Ross's deposition, and thus could question Sheridan Ross about Dr. Dupray's behavior during prosecution. (Ex. A, 4.2.13 e-mail from Eichmann to Sohn.) But document production and depositions are complementary discovery techniques, not mutually exclusive ones. Thus, the fact that a deposition has occurred on a given subject does not diminish the importance of document production on that subject. *See, e.g., Tennison v. City & Cnty. of S. F.*, 226 F.R.D. 615, 622 (N. D. Cal. 2005) ("Mr. Adachi's documents . . . are vital to the defense given their materiality to the substantive constitutional claims asserted by Mr. Tennison and to the question of causation. Although Mr. Tennison argues they are not vital because Mr. Adachi may be deposed on these matters, the contention lacks merit . . . Discovery under the Federal Rules of Civil Procedure affords litigants an array of tools which are often complementary; documents and depositions are two such complementary tools.").

Moreover, prosecution of the asserted patents began in the late 1990's and concluded in 2010. Thus, almost all of the prosecution is several years old, and some of it is well more than a



decade old. Accordingly, contemporaneous documents about Dr. Dupray's behavior during prosecution (such as portions of his personnel file) may provide more thorough and accurate information than a Rule 30(b)(6) deposition conducted many years after the relevant prosecution events.

### **III. CONCLUSION**

For the foregoing reasons, Google respectfully requests that this Court order Sheridan Ross to produce Dr. Dupray's personnel file. In keeping with its prior concessions to Sheridan Ross, Google has no objection to Sheridan Ross producing this personnel file in a form that redacts out Dr. Dupray's social security number, address, salary, tax forms/tax information, and other sensitive personal and financial information which bears no relation to Dr. Dupray's conception, reduction-to-practice, or prosecution of the Asserted Patents.

Dated: April 19, 2013

Respectfully submitted,

By: /s/ Sam S. Sheldon

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**CERTIFICATE OF CONFERENCE**

Pursuant to Civil Local Rule 7.1, Counsel for Google hereby certifies that they met and conferred with opposing counsel in an attempt to narrow the issues and avoid motions practice. Google's conferences and attempts to reach agreement are detailed in Section I of this Motion and the attached Declaration of Joshua L. Sohn.

**CORPORATE DISCLOSURE STATEMENT**

Google hereby certifies that it has no parent companies and that no other publicly-traded company owns more than 10% of Google's stock.

**CERTIFICATE OF SERVICE**

Google hereby certifies that it served a copy of this motion, and all supporting papers, on counsel of record for Sheridan Ross.

Dated: April 19, 2013

By: /s/ Sam S. Sheldon