IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

PERSONAL AUDIO, LLC,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 17-1751-CFC-CJB
	)	
GOOGLE LLC,	)	
	)	
Defendant.	)	

MEMORANDUM ORDER

At Wilmington, Delaware this 27th day of September, 2018.

WHEREAS, Plaintiff Personal Audio, LLC ("Plaintiff" or "PA") has moved for relief against Defendant Google LLC ("Defendant" or "Google") regarding six discovery disputes, (D.I. 221),[1] and the Court[2] has considered the parties' letter briefs, (D.I. 226, 230), and heard argument on September 17, 2018, (D.I. 245 (hereinafter, "Tr."));

NOW, THEREFORE, IT IS HEREBY ORDERED that:

1. With regard to PA's request that Google provide "download information by device, total monthly downloads, etc." in regard to the "2000 accused devices capable of operating the accused Google Software[,]" (responsive to Requests for Production ("RFP") Nos. 39, 79, 80, 101 and Interrogatory ("Rog.") Nos. 4-5), (D.I. 226 at 1), the Court GRANTS-IN-PART the request as follows. Google represents that it has produced data setting out

[1] The parties filed a joint motion seeking resolution of discovery disputes, because in addition to the six disputes pressed by PA, Google sought adjudication of two other disputes. (D.I. 221) On September 20, 2018, the Court issued a separate Memorandum Order addressing Google's disputes. (D.I. 243)

[2] This case has been referred to the Court to hear and resolve all pretrial matters, up to and including the resolution of case-dispositive motions. (Docket Items, December 13, 2017 and September 10, 2018)

(Tr. at 35, 37, 39) When pressed about why such information remained deficient, PA's counsel explained that they needed such data on a "device by device" basis. (*Id.* at 42-43) On that front, Google does not currently seem to be asserting that such data simply does not exist at Google. Instead, Google seems to be saying

(*Id.* at 36; *see also id.* at 39 (acknowledging that with work on Google's part, it may be possible for Google

2. Federal Rule of Civil Procedure 34(a)(1)(A) permits a party to request that another party produce "[a]ny designated documents or electronically stored information . . . stored in any medium from which information can be obtained either directly, or, if necessary, after translation by the responding party into a reasonably usable form[.]" Rule 34(b)(2)(E) requires a responding party to "produce documents as they are kept in the usual course of business or . . . organize and label them to correspond to the categories in the request[.]" Under these circumstances, where it appears that Google may maintain responsive raw data, and where Google has made no specific showing that production of such data would be unduly burdensome or costly, *see* Fed. R. Civ. P. 26(b)(1), the Court hereby ORDERS that by no later than **October 11, 2018**, Google shall further investigate whether it has the capability to produce the requested information on a device-by-device basis, regardless of whether Google relies on such information in the ordinary course of business, and shall submit a status report to the Court regarding this investigation. This status report shall also include the results of Google's ongoing investigation into whether there exists responsive information in the form of

[REDACTED] (D.I. 230 at 2; Tr. at 41) To the extent that Google does have responsive information in its possession on a device-by-device basis, the Court's current inclination is that it will order Google to produce the information. *See, e.g.*, *North Shore-Long Island Jewish Health Sys., Inc. v. MultiPlan, Inc.*, 325 F.R.D. 36, 51-52 (E.D.N.Y. 2018) (requiring the defendant to produce responsive information, where it held raw data in several databases and could input search parameters and produce varying configurations of this raw data); *Apple Inc. v. Samsung Elecs. Co. Ltd.*, Case No.: 12-CV-0630-LHK (PSG), 2013 WL 4426512, at *2-3 (N.D. Cal. Aug. 14, 2013) ("Courts regularly require parties to produce reports from dynamic databases, holding that the technical burden . . . of creating a new dataset for the instant litigation does not excuse production[.]") (internal quotation marks and citation omitted).

3. With regard to PA's request that Google produce documents and information regarding Google's United States and worldwide advertising revenues and profits directly or indirectly attributable to Google Play Music, (responsive to RFP Nos. 24, 44, 81, 123-25 and Rog. Nos. 1 and 12), (D.I. 226 at 2), Google represented that it has recently produced [REDACTED] (D.I. 230 at 2), [REDACTED] (Tr. at 45, 47). PA seems to believe that Google's response remains deficient because PA is unaware of what filters were used to create the spreadsheet and what source information was used to generate the spreadsheet. (*Id.* at 45, 47) But it does not appear that the parties have actually discussed what the spreadsheet is meant to convey or why PA is asserting that the spreadsheet is deficient. (*Id.* at 48) The Court hereby ORDERS that by no later than **October 11, 2018**, the parties shall: (1) meet and confer to, *inter alia*, enable Google to "explain what the information is[,]" (*id.* at 49); and (2) submit a joint letter of no more than

two single-spaced pages that informs the Court whether there remains a dispute regarding this issue and, if so, provides the parties' positions as to that remaining dispute.

4. The next issue relates to PA's request that Google produce United States revenues and profits associated with Google Play Music users and paid subscribers, songs and videos downloaded via Google Play Music, the business division within which Google Play Music falls, and costs associated with the development and maintenance of Google Play Music, (responsive to RFP Nos. 24, 44, 81, 94, 123 and Rog. Nos. 1 and 12), (D.I. 226 at 3).[3] Google represents that it has already produced a spreadsheet containing

(D.I. 230 at 2; D.I. 231, ex. 3) When pressed as to why the produced spreadsheet was not sufficient, PA's counsel asserted that it does not seem to include "evidence of costs of what appear to be indirect revenues, advertising, third-party agreements . . . . [i]t seems to be a very basic spreadsheet showing and nothing more." (Tr. at 54) In response, Google's counsel explained that the spreadsheet reflects

—other cost information "just doesn't exist as far as I'm aware." (*Id.* at 60-61) In light of Google's representations, the Court DENIES this request. The Court cannot order Google to produce specific cost allocations that do not exist and it does not otherwise have a basis to believe that Google has failed to produce responsive, non-privileged information that is in its possession. Furthermore, to the extent that PA has questions regarding how this document

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[3] PA has also requested this information on a worldwide basis, (D.I. 226 at 3), and the Court will take up that dispute next.

was prepared and what filters were used, it can question appropriate witness(es) on that front during depositions.

5. With regard to PA's request that Google produce worldwide revenue, profits, and costs information, (D.I. 226 at 3), the Court GRANTS that request. PA asserts that such information is responsive to its claims for infringement under 28 U.S.C. § 271(f) ("Section 271(f)"). (*Id.*) According to Google, PA's infringement theory under Section 271(f) precludes liability as a matter of law because PA contends that Google supplies software from the United States, but software is not a "component" for purposes of Section 271(f). (D.I. 230 at 3 (citing *Microsoft Corp. v. AT & T Corp.*, 550 U.S. 437, 449-52 (2007)). Based on this position, Google has refused to produce worldwide financial information. (*Id.*) However, the *Microsoft* Court did not hold that software could *never* constitute a component under Section 271(f). Rather, the *Microsoft* Court held that software did not constitute such a component unless it was embodied in a computer-readable copy such as a CD-ROM. *Microsoft Corp.*, 550 U.S. at 449-50; *see also* (Tr. at 51-53). In *Microsoft*, the defendant supplied a master disk to foreign manufacturers that the manufacturers would then use to generate copies; the copies were ultimately installed on the foreign manufacturers' computers. *Microsoft Corp.*, 550 U.S. at 445. The Court found that supplying such a master disk fell outside of Section 271(f), because "the copies of Windows actually installed on the foreign computers were not themselves supplied from the United States" as required by Section 271(f). *Id.* at 453. In this case, PA asserts that Google "conceded that it did not use a master disc for foreign delivery" and it is evaluating whether Google's conduct falls within Section 271(f). (D.I. 226 at 3) The Court cannot say at this juncture that the sought-after information is irrelevant to PA's claims, and now is not the proper time for the Court to definitively resolve legal and/or factual arguments as to whether Google's conduct falls within

Section 271(f)'s boundaries. Such a challenge would be more appropriate at the summary judgment stage. (Tr. at 58 (Google's counsel acknowledging that "facts underlying how Google does distribute Google Play Music would . . . render the issue appropriate to be dealt with at summary judgment on those facts")) The Court ORDERS that Google shall produce all such "worldwide" documents responsive to this request by no later than **October 11, 2018**.

6. With regard to PA's request that Google produce documents and information regarding the way Google provides Google Play Music and related content from within the United States to users and manufacturers inside and outside the United States, (responsive to RFP Nos. 46, 57, 58, 60, 61 and 107 and Rog. No. 10), (D.I. 226 at 3), the Court accepts Google's representation that it has "conducted a reasonable search for such documents and ha[s] produced all non-privileged documents found in that search[,]" (D.I. 230 at 3; *see also* D.I. 231, ex. 2 at 1; D.I. 226, ex. 1 at 9; Tr. at 59). Therefore, PA's request is DENIED as MOOT.

7. With regard to PA's request that Google produce all manuals and user guides for each publicly released version of Google Play Music, (responsive to RFP No. 5), (D.I. 226 at 4; *id.*, ex. 1 at 9), the Court accepts Google's representation that "[t]here are no 'manuals and user guides'" for Google Play Music, (D.I. 230 at 3). Google represents that it is producing publicly available help pages related to Google Play Music that were generated before September 2016 and that it anticipates that this production will have been completed by September 21, 2018. (*Id.*) Therefore, PA's request is DENIED as MOOT.

8. With regard to PA's request that the Court rule that its infringement contentions are sufficient and that discovery is not being withheld on this basis, (D.I. 226 at 4), and Google's contrary request that PA be compelled to provide supplemental infringement contentions for each of the accused devices that "specifically identify the accused hardware components, the

basis for any contention of 'compatibility' with [Google Play Music], the basis for any contention that the device is not already licensed, and the basis for any contention that the device was available in or exported from the United States prior to October 2, 2016 (the expiration date of the asserted patents)[,]" (D.I. 230 at 4), the Court requires more information. Thus, it hereby ORDERS as follows: By no later than **October 4, 2018**, Google shall provide the Court with: (1) one or two examples of PA's infringement contentions (i.e., PA's contentions as to one or two exemplary asserted claims), and an accompanying letter specifically pointing out: (a) where in the contentions PA should have, but did not, include detail identifying the accused hardware components; (b) where in the contentions PA should have, but did not, include detail as to compatibility with Google Play Music; and (c) the type of detail Google is looking for in revised contentions as to those issues; and (2) an explanation of why such infringement contentions would normally be expected to contain information about "any contention that the device is not already licensed [as well as] the basis for any contention that the device was available in or exported from the United States." (*Id.*)

9. Because this Memorandum Order may contain confidential information, it has been released under seal, pending review by the parties to allow them to submit a single, jointly proposed, redacted version (if necessary) of the document. Any such redacted version shall be submitted by not later than **October 2, 2018** for review by the Court, along with a motion for redaction that includes a clear, factually detailed explanation as to why disclosure of any proposed redacted material would "work a clearly defined and serious injury to the party seeking closure." *Pansy v. Borough of Stroudsburg*, 23 F.3d 772, 786 (3d Cir. 1994) (internal quotation marks and citation omitted). The Court will subsequently issue a publicly-available version of its Memorandum Order.

[signature]

Christopher J. Burke
UNITED STATES MAGISTRATE JUDGE