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19 UNITED STATES DISTRICT COURT  
20 NORTHERN DISTRICT OF CALIFORNIA  
21 SAN FRANCISCO DIVISION

22 ORACLE USA, INC., et al.,  
23 Plaintiffs,  
24 v.  
25 SAP AG, et al.,  
26 Defendants.

Case No. 07-CV-1658 PJH (EDL)

**DEFENDANTS' OPPOSITION TO  
PLAINTIFFS' MOTION TO  
COMPEL PRODUCTION OF  
DOCUMENTS RELATED TO  
DAMAGES MODEL AND  
INTERROGATORY RESPONSES  
RELATED TO USE OF PLAINTIFFS'  
INTELLECTUAL PROPERTY**

**DISCOVERY MATTER**

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**Cases**

*Compagnie Francaise D’Assurance v. Phillips Petroleum Co.*,  
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*Goodrich Corp. v. Emhart Indus., Inc.*,  
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*Petroleum Ins. Agency, Inc. v. Hartford Accident and Indem. Co.*,  
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*Puerto Rico Aqueduct & Sewer Authority v. Clow Corp.*,  
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*Saddler v. Musicland Pickwick Int’l, Inc.*,  
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*T.N. Taube Corp. v. Marine Midland Mortgage Corp.*,  
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**Statutes**

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**Other Authorities**

4A Moore’s Federal Practice ¶ 33.25 (2d ed. 1990) ..... 4, 18

8A Wright, Miller & Marcus, *Federal Practice and Procedure* § 2178 ..... 4, 10

8A Wright, Miller & Marcus, *Federal Practice & Procedure* § 2008.1 (2d ed. 1994) ..... 3

1 **I. INTRODUCTION**

2 Oracle USA, Inc., Oracle International Corp. and Oracle EMEA Ltd.'s (collectively  
3 "Oracle" or "Plaintiffs") June 30, 2009 Motion to Compel (D.I. 329, "the Motion") seeks an order  
4 compelling SAP AG, SAP America and TomorrowNow, Inc. ("TN") (collectively, "Defendants")  
5 to: (1) produce documents allegedly related to Oracle's hypothetical license damages theory; and  
6 (2) supplement TN's responses to Interrogatories 13 and 14 relating to its downloading activities  
7 and use of environment components. For the first time in the Motion, Oracle substantially  
8 narrowed the documents it seeks that allegedly relate to its hypothetical license damages theory.  
9 In response, and while maintaining all objections to the underlying discovery requests,  
10 Defendants have agreed to produce data and/or provide information as described in Section IV  
11 below, which moots the request for relief contained in pages 7-11 of the Motion and numbered  
12 paragraphs 1 and 2 of Oracle's proposed order. Thus, the focus of this Opposition is the relief  
13 requested in pages 12-16 of the Motion and numbered paragraph 3 of Oracle's proposed order,  
14 which seeks supplemental responses to Interrogatories 13 and 14.

15 Oracle's request that Defendants further supplement their responses to Interrogatories 13  
16 and 14 is another attempt by Oracle to shift a large portion of its trial preparation burden and  
17 ultimate burden of proof to Defendants. Oracle has asserted damages "as much as a billion  
18 dollars," yet is unwilling to assume the proportionate burden to evaluate and present what it  
19 believes are the facts that would justify the award of such enormous damages. Instead, Oracle  
20 now requests that this Court order Defendants to marshal the evidence in a summary fashion,  
21 boiling down Defendants' documents, data and testimony that have already been given to Oracle  
22 numerous times, in numerous ways over the past two years.

23 The Motion completely ignores how forthright and fulsome Defendants' discovery  
24 responses have been. Oracle disregards Defendants' current responses to Interrogatories 13 and  
25 14, which are complete, detailed and directly on point. Moreover, Oracle fails to mention that  
26 Defendants have already voluntarily assumed enormous expense and burden to provide Oracle  
27 with all of the information responsive to Interrogatories 13 and 14, in a manner that is now as  
28 equally accessible and reviewable to Oracle as it is to Defendants, including: (1) the best and

1 most usable sources for the information requested (the SAS database) in exactly the same  
2 database format as it existed at TN; (2) virtually unlimited access to all of TN's services servers;  
3 (3) an extraordinary number of custodians' data provided in a searchable format with metadata  
4 and (4) extremely prepared 30(b)(6) witnesses who have testified regarding numerous download-  
5 related and environment-related topics. Oracle has had the majority of this material since late  
6 2007 and has consistently and extensively used the information in the more than 300 deposition  
7 hours that it has taken in this case thus far.

8 To be clear, Oracle is not seeking additional information. Oracle already has in its  
9 possession the **exact same** information that Defendants have, from which to derive the detailed  
10 supplements it seeks. Instead, Oracle's Motion improperly seeks to compel Defendants to  
11 summarize thousands of contemporaneous business records contained in TN databases, which  
12 chronicle TN's almost daily activities for hundreds of customers over several years. TN has  
13 provided complete and proper answers to Interrogatories 13 and 14 through both narrative  
14 responses and reference to Defendants' document production under Rule 33(d) of the Federal  
15 Rules of Civil Procedure 33(d) ("Rule 33(d)"). As a result, Oracle is in the same position as  
16 Defendants to prepare such detailed summaries, and it bears the burden to do so. Accordingly,  
17 this Court should deny Oracle's Motion to Compel.

## 18 **II. LEGAL STANDARDS**

19 The parties agree that each party has the right to discover non-privileged information  
20 "relevant to any party's claim or defense." Fed. R. Civ. P. 26(b)(1); *see also* Motion at 6.  
21 However, the Rules set reasonable limits to this right, including the Court's ability to weigh the  
22 benefit of the requested discovery against the cumulative nature of the request and the burden  
23 involved in responding.<sup>1</sup> Additionally, Rule 26(b)(2)(C) specifically describes the analysis that  
24 should be conducted to limit the "frequency or extent of discovery" otherwise allowed by the  
25 Rules:

26 \_\_\_\_\_  
27 <sup>1</sup> Moreover, a fundamental underpinning of the Federal Rules of Civil Procedure lies in  
28 Rule 1, which states in pertinent part: "[the Rules] should be construed and administered to secure  
the just, speedy, and *inexpensive* determination of every action and proceeding." Fed. R. Civ. P.  
1 (emphasis added).

1 When Required. On motion or on its own, the court must limit the frequency or  
 2 extent of discovery otherwise allowed by these rules or by local rule if it  
 3 determines that: (i) the discovery sought is unreasonably cumulative or  
 4 duplicative, or can be obtained from some other source that is more convenient,  
 5 less burdensome, or less expensive; (ii) the party seeking discovery has had ample  
 6 opportunity to obtain the information by discovery in the action; or (iii) the  
 7 burden or expense of the proposed discovery outweighs its likely benefit,  
 8 considering the needs of the case, the amount in controversy, the parties'  
 9 resources, the importance of the issues at stake in the action, and the importance  
 10 of the discovery in resolving the issues.

11 Fed. R. Civ. P. 26(b)(2)(C).<sup>2</sup>

12 Rule 33 includes additional burden protection:

13 Option to Produce Business Records. If the answer to an interrogatory may be  
 14 determined by examining, auditing, compiling, abstracting, or summarizing a  
 15 party's business records (including electronically stored information), and if the  
 16 burden of deriving or ascertaining the answer will be substantially the same for  
 17 either party, the responding party may answer by: (1) specifying the records that  
 18 must be reviewed, in sufficient detail to enable the interrogating party to locate  
 19 and identify them as readily as the responding party could; and (2) giving the  
 20 interrogating party a reasonable opportunity to examine and audit the records and  
 21 to make copies, compilations, abstracts, or summaries.

22 Fed. R. Civ. P. 33(d).

23 The 1970 Advisory Committee Note to Rule 33(d) further explain:

24 This subdivision gives the party an option to make the records available and place  
 25 the burden of research on the party who seeks the information. **"This provision,  
 26 without undermining the liberal scope of interrogatory discovery, places the  
 27 burden of discovery upon its potential benefitee,"** Louisell, *Modern California  
 28 Discovery*, 124-125 (1963), and alleviates a problem which in the past has  
 troubled Federal courts. *See* Speck, *The Use of Discovery in United States  
 District Courts*, 60 Yale L.J. 1132, 1142-1144 (1951). The interrogating party is  
 protected against abusive use of this provision through the requirement that the  
 burden of ascertaining the answer be the same for both sides.

Advisory Committee Note to 1970 Amendment to Fed. R. Civ. P. 33 (emphasis added). The  
 1970 Advisory Committee Note continues that "the respondent unable to invoke this subdivision  
 does not on that account lose the protection available to him under the new Rule [26(b)(2)(C)]  
 against oppressive or unduly burdensome or expensive interrogatories." *Id.*

<sup>2</sup> The 2000 Advisory Committee Note explains that a sentence was added to subdivision  
 (b)(1) to call attention to the limitations of subdivision (b)(2)(i), (ii) and (iii). The Note states that  
 "[t]hese limitations apply to discovery that is otherwise within the scope of subdivision (b)(1).  
**The Committee has been told repeatedly that courts have not implemented these limitations  
 with the vigor that was contemplated.**" Advisory Committee Note to 2000 Amendment to Fed.  
 R. Civ. P. 26 (emphasis added); *see also* 8A Wright, Miller & Marcus, *Federal Practice &  
 Procedure* § 2008.1 at 121 (2d ed. 1994).

1 Rule 33(d) permits a party to produce “business records (including electronically stored  
2 information)” in lieu of narrative responses. Fed. R. Civ. P. 33. Its primary purpose is to shift the  
3 burden of perusing documents to supply answers to discovery requests, from the producing party  
4 to the party seeking the information. See 8A *Federal Practice and Procedure* § 2178. Rule 33(d)  
5 may be invoked when: (1) the responding party “specif[ies] the records that must be reviewed, in  
6 sufficient detail to enable the interrogating party to locate and identify them as readily as the  
7 responding party could”; and (2) “the burden of deriving or ascertaining the answer will be  
8 substantially the same for either party.” Fed. R. Civ. P. 33(d).

9 Once Rule 33(d) is invoked, the propounding party has the burden of demonstrating “that  
10 the burden of deriving or ascertaining the answers is not substantially the same for both parties.”  
11 *T.N. Taube Corp. v. Marine Midland Mortgage Corp.*, 136 F.R.D. 449, 453 (W.D.N.C. 1991)  
12 (quoting 4A Moore’s *Federal Practice* ¶ 33.25 (2d ed. 1990)). Oracle cannot obtain an order to  
13 compel simply because it does not want to endure the cost of compiling the answer it seeks; it is  
14 not enough that “plaintiffs want this discovery but do not want to expend the effort and expense  
15 in procuring it.” *Petroleum Ins. Agency, Inc. v. Hartford Accident and Indem. Co.*, 111 F.R.D.  
16 318, 320 (D. Mass. 1983) (denying motion to compel further responses to all but one  
17 interrogatory).

18 Assertions made in a “conclusory fashion” do not establish an inequality in burdens. See  
19 *Goodrich Corp. v. Emhart Indus., Inc.*, No. EDCV 04-00759-VAP (SSx), 2005 U.S. Dist. LEXIS  
20 25158, at \*13-14 (C.D. Cal. Oct. 12, 2005) (denying “Motion to Compel Substantive Answers to  
21 Interrogatories” when moving party failed to demonstrate inequality of burdens). As the court  
22 explained in *Petroleum Ins. Agency*:

23 Plaintiffs’ expressions of general discontent with having to obtain discovery  
24 pursuant to the provisions of Rule 33(c),<sup>3</sup> F.R.Civ.P., however severe the  
25 discontent may be, is not a sufficient showing under the law for the Court to deny  
26 the defendants the option the rule provides. While it is true that the defendants  
27 are more familiar with their records, there has been no showing that the answers  
of the defendants delineating the records in which answers can be found and how  
the records are kept are wanting or that the plaintiffs have had difficulty dealing  
with defendants’ records as they have been identified and described.

28 <sup>3</sup> This quote cites to the former Rule 33(c) which is identical in all pertinent parts to the  
current Rule 33(d).

1 *Petroleum Ins. Agency*, 111 F.R.D. at 320-21.

2 To determine whether Oracle has demonstrated an inequality of burdens, three factors  
 3 should be weighed: “cost of the necessary research, nature of the relevant records, and  
 4 Defendant’s familiarity with its own records.” *T.N. Taube Corp.*, 136 F.R.D. at 454. Further,  
 5 “mere familiarity with a set of records cannot be dispositive in weighing the comparative burdens  
 6 upon plaintiff and defendant in eliciting relevant data from those records.” *Saddler v. Musicland*  
 7 *Pickwick Int’l, Inc.*, No. S-78-95-CA, 1980 U.S. Dist. LEXIS 16500, at \*3 (E.D. Tex. Dec. 22,  
 8 1980); *Compagnie Francaise D’Assurance v. Phillips Petroleum Co.*, 105 F.R.D. 16, 44  
 9 (S.D.N.Y. 1984). “If a disparity in familiarity necessarily created an inequality in the ease of  
 10 discovery, the procedure provided by Rule 33(c)<sup>4</sup> would rarely, if ever, be utilized.” *Saddler*,  
 11 1980 U.S. Dist. LEXIS, at \*3. For that reason, Rule 33 envisions evaluating the relative difficulty  
 12 in analyzing the records. *See id.* If both parties must complete identical steps to derive the  
 13 information, the burden is substantially the same. *See id.* Familiarity of the responding party  
 14 with its own documents is only one factor a court should use to determine if the relative burden is  
 15 substantially the same. *See Goodrich Corp.*, 2005 U.S. Dist. LEXIS 25158, at \*10. The court  
 16 should also balance the costs of research and the nature of the business records. *See id.*

17 As explained below, under the facts of this case, TN has properly responded to  
 18 Interrogatories 13 and 14 by providing appropriate narrative answers and appropriate references  
 19 to Rule 33(d). And, even if 33(d) was not available, the information that Defendants have already  
 20 provided to Oracle in response to Interrogatories 13 and 14 is more than sufficient given the  
 21 cumulative discovery safeguards and burden balancing protections provided by Rule 26(b)(2)(C).

### 22 **III. ARGUMENT**

23 Interrogatories 13 and 14 are only two of the 121 interrogatories served on Defendants to  
 24 date, but they provide excellent examples of the scorched earth, no stone unturned discovery  
 25 approach that Oracle is taking in this case.<sup>5</sup> *See* Declaration of Joshua L. Fuchs in Support of

26 <sup>4</sup> *See supra* n.3.

27 <sup>5</sup> Oracle’s characterization of the facts and the discovery requests at issue contains  
 28 numerous inaccuracies. The majority of those allegations should not impact the Court’s analysis;  
 thus, any failure by Defendants to address any specific alleged fact is not intended as a waiver.

1 Defendants' Opposition to Plaintiffs' Motion to Compel Production of Documents Related to  
 2 Damages Model ("Fuchs Decl."), ¶ 2. Defendants have incurred enormous expense and related  
 3 burdens associated with responding to Oracle's discovery requests. *See id.* at ¶¶ 3-7. Specifically,  
 4 and not even counting the substantial expense Defendants incurred responding to Oracle's written  
 5 discovery and preparing for and defending over 300 hours of depositions in this case, Defendants  
 6 are on track to spend in excess of \$14 million producing custodians' data, TN's databases and  
 7 dozens of TN servers via the Data Warehouse facility.<sup>6</sup> Oracle could have propounded focused,  
 8 targeted discovery, considerate of the responsive burdens created by such requests. Instead,  
 9 Oracle adopted a shot-gun/trot-line discovery strategy, which strategy logically results in the  
 10 production of enormous volumes of documents and data. Defendants have produced the  
 11 enormous volume of discovery requested by Oracle, and it is now time that Oracle accept the  
 12 burden that comes with the discovery approach it has taken in this case.

13 **A. TN Properly Responded to Interrogatory 13.**

14 Oracle mischaracterizes the information requested in Interrogatory 13. A careful reading  
 15 of the interrogatory and Defendants' response demonstrates that Defendants completely answered  
 16 it.

17 **1. Oracle's Actual Request.**

18 Oracle's Interrogatory 13 to TN reads as follows:

19 Describe in as much detail as possible all Software and Support Materials that  
 20 'have been downloaded beyond those that, according to TN's records, related to  
 21 applications licensed to the particular customer on whose behalf the downloads  
 were made,' *as alleged in ¶ 15 of Your Answer*, including but not limited to  
 Identifying the 'records' You referenced in making Your determination.

22 Howard Decl., Ex. A (emphasis added).<sup>7</sup> Oracle now asserts that Interrogatory 13 seeks more  
 23 than just a description of the downloads to which Defendants referred in Defendants' Answer to  
 24 Plaintiffs' First Amended Complaint, at ¶ 15 ("Answer to FAC").<sup>8</sup> For example, the Motion

25 <sup>6</sup> *See* Fuchs Decl., ¶ 7.

26 <sup>7</sup> It is worth noting that Oracle did not raise Defendants' response to Interrogatory 13 as  
 27 one of the nineteen responses that were allegedly objectionable in its first Motion to Compel  
 hearing before Judge Legge on February 13, 2008.

28 <sup>8</sup> The plaintiffs named in the First Amended Complaint included now former plaintiff  
 Oracle Corporation and current plaintiffs Oracle International Corporation and Oracle USA, Inc.

1 states that Interrogatory 13 also calls for information on “how [TN] got its downloads . . . and  
 2 how it used them to support specific customers,” the identity of those materials that “were  
 3 downloaded using credentials of a customer not entitled to those materials”<sup>9</sup> and “which materials  
 4 [TN] improperly downloaded from Customer Connection.” Motion at 13, 16. That information  
 5 was not requested in Interrogatory 13. Instead, variations of those requests are contained in other  
 6 interrogatories that Oracle has propounded on Defendants and that Defendants have answered in  
 7 detail.<sup>10</sup>

8 **2. Defendants Gave a Specific, Narrative Response to Interrogatory 13.**

9 Defendants appropriately responded to Interrogatory 13 by identifying the information  
 10 used and citing the specific records relied upon to make the statement in paragraph 15 of the  
 11 Answer to FAC. Specifically, Defendants responded in part:

12 [TN]’s downloads on behalf of customers using JDE’s OneWorld products were  
 13 made based on instructions set forth on a Download Request Form. The  
 14 Download Request Forms for Merck, OCE, SPX, Metro Machine and Yakazi  
 15 instructed the download team to download all ESUs for all system codes on a  
 16 particular release level. [TN]’s records did not show that those customers had  
 17 represented that they were licensed to all system codes on a particular release  
 18 level.

19 TN’s Response to Oracle Corporation’s First Set of Interrogatories to TN, No. 13 (Howard Decl.,  
 20 Ex. C).

21 **3. Defendants Properly Relied on Rule 33(d).**

22 In addition to providing a specific, narrative response to Interrogatory 13, Defendants  
 23 further responded by referencing, under Rule 33(d), the customer contracts, onboarding  
 24 documentation and downloaded materials that they relied upon in drafting paragraph 15 of the

25 <sup>9</sup> Plaintiffs attempt to frame the issue as relating to which customers’ Customer  
 26 Connection password was used to download specific materials; however, Interrogatory 13 does  
 27 not ask for this information. *Compare* Interrogatory 13, Howard Decl., Ex. C, *with* Interrogatory  
 28 10, Fuchs Decl., ¶ 17, Ex. E (Interrogatory 10 of Oracle Corp.’s First Set of Interrogatories to  
 TN). Moreover, Plaintiffs are well aware that TN’s typical procedure was to download materials  
 for a customer using that customer’s Customer Connection ID and password and to store those  
 downloads in a customer-specific folder. *See, e.g., id.* (Defendant TN’s Fourth Amended and  
 Supplemental Response to Plaintiff Oracle Corp.’s First Set of Interrogatories to TN, No. 3, 12).  
 Plaintiffs have had access to all of the download folders on TN’s systems, and Defendants have  
 always acknowledged that there is no known technical way to specifically tie a downloaded item  
 on TN’s systems to a Customer Connection ID and password.

<sup>10</sup> *See* part III.A.4. below for a description of the information provided to Oracle in  
 response to these other interrogatories.

1 Answer to FAC. *See id.* Defendants directed Oracle to the production of Download Request  
2 Forms, which “instructed the download team to download all ESUs for all system codes on a  
3 particular release level.” *Id.* Oracle has demonstrated an ability to locate these forms in  
4 Defendants’ production, having used these forms as exhibits in various depositions. *See* Fuchs  
5 Decl., ¶ 16, Ex. D (Depo. Exs. 66, 1445, 1469). Further, in addition to identifying the specific  
6 Bates ranges for over 85 Download Request Forms, Defendants also provided Oracle with the file  
7 path for a central repository of Download Request Forms in response to Interrogatory 10, which  
8 was incorporated by reference into Interrogatory 13. *See* Fuchs Decl. ¶ 17, Ex. E (Defendant  
9 TN’s Fourth Amended and Supplemental Response to Plaintiff Oracle Corp.’s First Set of Rogs  
10 (Set One), No. 10). Thus, Oracle cannot truthfully claim that the documents were not identified  
11 in “sufficient detail to enable the interrogating party to locate and identify them.” Fed. R. Civ.  
12 P. 33(d).

13 Moreover, due to the nature of the Download Request Forms, the burden of deriving  
14 answers from these documents is substantially the same for both sides, because they are user-  
15 friendly forms that state the categories and limits of the materials to be downloaded. *See* Fuchs  
16 Decl., ¶ 16, Ex. D (Depo. Exs. 66, 1445, 1469). Once Defendants invoked Rule 33(d), it became  
17 Oracle’s burden as the propounding party to demonstrate that the burden was not substantially  
18 similar between the parties. *See T.N. Taube Corp.*, 136 F.R.D. at 453. Oracle makes no effort at  
19 all in its Motion to provide any evidence that demonstrates that the cost to Oracle of the necessary  
20 research, nature of the relevant records or Defendants’ familiarity with their own records is such  
21 that establishes an inequality of burdens. *See id.* at 454. Because Defendants either identified the  
22 specific forms relied upon or explained where the forms could be located in a central repository,  
23 the burden of deriving a further response to Interrogatory 13 is substantially the same between the  
24 parties, and Defendants’ reliance on Rule 33(d) is appropriate.

25 To the extent that Interrogatory 13 requests that Defendants actually identify the specific  
26 downloads beyond those to which customers told TN they were entitled, Defendants have made  
27 clear to Oracle that TN can not provide that level of detail without specific product mapping  
28 information from Oracle. To undertake an analysis to determine which of the downloads are

1 beyond those to which customers told TN they were entitled, Defendants would need the ability  
2 “to map each of the specific downloads to each of the specific products. . . . Thus, without such  
3 mapping information (provided in a manner that permits an electronic ‘download to product’  
4 comparison), it is not possible for TN to evaluate the appropriateness of each download it made  
5 on behalf of its customers.” Howard Decl., Ex. C. Defendants have requested such mapping  
6 information from Oracle since the outset of this case, and Oracle has refused to produce this  
7 information. *See* Fuchs Decl., ¶ 13, Ex. A (Plaintiffs’ Second Amended and Supplemental  
8 Responses and Objections to Defendant TN, Inc.’s First Set of Interrogatories, No. 7). In  
9 response to Defendants’ Motion to Compel on this very issue, Oracle’s counsel even told Judge  
10 Legge that it would be too burdensome to provide the necessary product information to  
11 Defendants. *See* Fuchs Decl., ¶ 21, Ex. I (February 13, 2008 Hearing on Discovery Issues, at  
12 32:20-34:20). Oracle’s refusal to provide the product mapping information necessary to  
13 determine the appropriateness of the downloads, coupled with Defendants’ production of the  
14 downloaded materials, demonstrates that Oracle actually has the lesser burden in answering its  
15 own question upon which it has the burden of proof.

16 Moreover, if Oracle were to provide the requisite “download-to-product” mapping  
17 information necessary to undertake the analysis, then at that point, the cost and related burdens of  
18 the necessary analysis of that information, in conjunction with the information Defendants have  
19 already produced, would be substantially similar between the parties. Oracle concedes that it is a  
20 “complex and difficult task,” yet Oracle ignores that both parties must take identical steps to  
21 derive the information from Defendants’ records. *See* Motion at 15. Both sides would have to  
22 review the downloaded materials and the onboarding documentation with this specific mapping  
23 analysis in mind.<sup>11</sup> Oracle’s argument that Defendants are more familiar with their own records  
24 is not the determining factor. *See* Motion at 14. Instead, “mere familiarity with a set of records  
25 cannot be dispositive in weighing the comparative burdens,” and Oracle has not demonstrated, as

26 \_\_\_\_\_  
27 <sup>11</sup> To the extent that Oracle seeks to broaden its request to include the appropriateness of  
28 the downloaded materials beyond those considered in paragraph 15 of the Answer to FAC, an  
analysis of the DotProject and SAS databases would be necessary, as further described in Part  
III.A.4. below.

1 required, how the cost of research or nature of the relevant records lead to an inequality of  
2 burdens. *Saddler*, 1980 U.S. Dist. LEXIS 16500, at \*3.

3 The ultimate irony in Oracle's attack on Defendants' use of Rule 33(d) in response to  
4 Interrogatory 13 is Oracle's reliance on Rule 33(d) in response to an interrogatory Defendants  
5 propounded on Oracle requesting information on each item TN customers were entitled to  
6 download. *See* Fuchs Decl., ¶ 13, Ex. A (Plaintiffs' Second Amended and Supplemental  
7 Responses and Objections to Defendant TN, Inc.'s First Set of Interrogatories, No. 7). Oracle's  
8 application of this double-standard is glaringly evident in its response to TN's Interrogatory 7, in  
9 which it refuses to create a "compilation, abstract, or summary from business records"—the very  
10 act Oracle now seeks to compel Defendants to perform in response to Interrogatory 13.<sup>12</sup>

11 Defendants' Rule 33(d) reliance is proper because: (1) Oracle continues to withhold  
12 information necessary to map the downloads to specific products; (2) Oracle is the party in a  
13 position to provide the underlying data that must be used to perform any reasonably effective  
14 mapping exercise; (3) Oracle has had access for more than a year to all of Defendants' records  
15 that would be pertinent to the mapping exercise; (4) Oracle would have to undertake identical  
16 steps as Defendants to determine the appropriateness of the downloads and (5) Oracle has  
17 demonstrated an equal ability to use and analyze the data from Defendants' records. This is the  
18 quintessential case "where the burden of perusing documents in order to supply answers to  
19 discovery requests should be shifted from the producing party to the party seeking the  
20 information." 8A *Federal Practice and Procedure* § 2178.

21 **4. Oracle's Characterization of Interrogatory 13 is Cumulative and**  
22 **Creates an Undue Burden on Defendants.**

23 Under the guiding principles in Rule 26(b)(2)(C), the information that Defendants have  
24 provided to Oracle in response to Interrogatory 13 is more than adequate to preclude any  
25 additional undue effort and expense by Defendants. Although Defendants did not specifically  
26 object to the actual text of Interrogatory 13—which only called for information related to

27 \_\_\_\_\_  
28 <sup>12</sup> This is just one of many examples of Oracle's reliance on similar objections and on  
Rule 33(d). For a list of examples, *see* Fuchs Decl. ¶¶ 12, 13, 14, Exs. A, B.

1 Defendants' statement in paragraph 15 of the Answer to FAC—Defendants object to Oracle's  
2 overly broad request as it is characterized in the Motion. Specifically, the information sought, as  
3 characterized in the Motion, is unreasonably cumulative or duplicative of numerous other  
4 requests propounded by Oracle, which Defendants have properly answered. Further, Oracle has  
5 had ample opportunity to acquire the information it now seeks, and the undue burden and expense  
6 of the sought information is outweighed by its likely benefit. Any of these reasons, by itself,  
7 provides a basis under Rule 26(b)(2)(C) for the Court to prevent or limit the excess discovery.

8 Oracle now claims that Interrogatory 13 requests all information on how TN obtained and  
9 used downloads, the credentials used for downloading for each customer and what materials TN  
10 improperly downloaded. *See* Motion at 13, 16. These requests are unreasonably cumulative  
11 and/or duplicative of numerous other requests propounded by Oracle and Defendants' extensive  
12 document production in response to those requests. When coupled with Defendants' answers to  
13 over twenty other interrogatories related to TN's downloading (about which Oracle is not  
14 complaining), Defendants have more than satisfied their discovery burdens with respect to these  
15 requests.<sup>13</sup> Generally, Defendants' other interrogatory responses provide narrative information  
16 and document cites on topics that include, but are not limited to, what downloads TN did on  
17 behalf of its customers, TN's downloading policies, TN's access to the downloads and knowledge  
18 and investigation into the appropriateness of the downloads, TN's use of the downloads, the  
19 entities for whom TN has downloaded, TN's storage and maintenance of the downloads, TN's  
20 training procedures for the downloads, TN's procedure for completing the downloads, the  
21 credentials TN used for the downloads and TN's justification for downloading on behalf of its  
22 customers. *See* Fuchs Decl. ¶¶ 17, 18, 19, Exs. E, F, G.

23 Defendants' business records cited in response to these interrogatories include, but are not  
24 limited to, the DotProject database, the SAS database, the actual downloads produced through the

25 <sup>13</sup> *See, e.g.*, Fuchs Decl. ¶¶ 17, 18, 19, Exs. E, F, G (Defendant TN, Inc.'s Second  
26 Amended and Supplemental Responses to Plaintiff Oracle Corp.'s Third Set of Rogs and SAP  
27 America and SAP AG's Second Amended and Supplemental Responses to Plaintiff Oracle  
28 Corp.'s Second Set of Rogs, Nos. 8, 10; Defendant TN's Fourth Amended and Supplemental  
Response to Plaintiff Oracle USA's First Set of Rogs (Set One), No. 2; Defendant TN's Fourth  
Amended and Supplemental Response to Plaintiff Oracle Corp.'s First Set of Rogs (Set One),  
Nos. 3, 7, 8, 9, 10, 11, 16).

1 Data Warehouse and onboarding documentation.<sup>14</sup> Oracle has demonstrated an ability to locate  
2 and use the information contained in these sources. *See* Fuchs Decl., ¶¶ 3, 4, 5, 6, 8, 15, Ex. C.<sup>15</sup>  
3 And Oracle has had access to many of these records, including the downloaded materials, for well  
4 over a year, which is more than ample time for Oracle to have compiled and summarized the  
5 information it seeks related to the appropriateness of the downloads. *See id.* ¶¶ 3, 5, 6.

6 Further, the undue burden and expense of the information Oracle now seeks outweighs its  
7 likely benefit. Oracle has completely failed to adequately explain how the information it requests  
8 justifies the extraordinary expense of mapping millions of downloads to specific products.<sup>16</sup>  
9 Oracle has not explained why that level of detail is needed. Conversely, Oracle has all the  
10 information it needs to undertake this analysis and assume the burden, itself should it deem it  
11 necessary to prosecute its claims.

12 In sum, Defendants thoroughly and completely answered Oracle's request in Interrogatory  
13 13 for information regarding the statement in paragraph 15 of the Answer to FAC. Oracle now  
14 mischaracterizes the information sought in Interrogatory 13 in an attempt to broaden the scope of  
15 the request, claiming that the interrogatory seeks the "materials [TN] improperly downloaded,"  
16 among other topics. Motion at 13. Defendants' reliance on Rule 33(d) is entirely justified under  
17 these circumstances, as Oracle itself holds the key to the product mapping information that Oracle  
18 deems necessary. Further, the limitations imposed by Rule 26(b)(2)(C) dictate that the  
19 information Oracle now seeks is unreasonably cumulative and duplicative of other interrogatory  
20 requests propounded by Oracle. Moreover, Oracle has totally failed to demonstrate that the likely

---

21 <sup>14</sup> Defendants did not specifically cite to all of these sources in response to Interrogatory  
22 13 because the actual interrogatory is more narrowly tailored than Oracle now describes, as  
23 explained in Part III.A.1 above. However, Defendants did rely on these sources in response to  
24 other interrogatory requests that more closely resemble what Oracle is requesting in its Motion.  
25 *See* Part III.A.4 below.

26 <sup>15</sup> If Oracle is permitted to broaden its requests as described in its Motion, citing these  
27 records in response to Rule 33(d) would be appropriate. Both sides would need to take the same  
28 steps to derive the information from Defendants' records, including review of the DotProject  
database, the SAS database, the downloaded materials produced in the Data Warehouse and the  
onboarding documentation. Plaintiffs have demonstrated an intimate familiarity with these  
records.

<sup>16</sup> In total, there are over 5 terabytes of downloaded materials to evaluate, and to extract  
the relevant information for each of the data sources would easily take thousands of man hours.  
*See* Fuchs Decl., ¶ 3.

1 benefit from the information now sought outweighs the burden and expense to compile,  
 2 summarize and abstract data produced by Defendants that Oracle, as the party with the burden of  
 3 proof, is equally capable of doing itself.

4 **B. TN Properly Objected and Responded to Interrogatory 14.**

5 Interrogatory 14 essentially asks TN to summarize daily customer support activities from  
 6 early 2002 to April 30, 2008. *See* Howard Decl., Ex. D. Because it is humanly impossible for  
 7 anyone to remember day-in and day-out activity over a number of years, TN used a database,  
 8 referred to as SAS, to track the exact type of information Oracle is requesting. As Oracle is well  
 9 aware, Defendants have stressed the importance of this database from the very beginning of this  
 10 case and started providing it to Oracle in the exact form used at TN as one of the very first  
 11 productions in the case.<sup>17</sup> Defendants also provided to Oracle (early in discovery) all other user-  
 12 friendly databases that TN maintained to track any information regarding environment  
 13 components. *See* Fuchs Decl., ¶¶ 3-6. Again, Oracle does not seek new information regarding  
 14 TN's use of the environments. What Oracle wants this Court to do is to relieve Oracle of its  
 15 burden<sup>18</sup> to analyze the documents, testimony and data Defendants have made available,  
 16 regardless of the fact that the burden of conducting that analysis is substantially equal. In  
 17 essence, even though Oracle has the ultimate burden of proof on its claims, Oracle wishes to  
 18 forego the expense and effort of extracting the information it requests and would rather that  
 19 Defendants be required to do it for Oracle.

20 \_\_\_\_\_  
 21 <sup>17</sup> Defendants produced the entire SAS database with respect to the six customers  
 22 identified in paragraphs 76-80 of Oracle's First Amended Complaint on September 21, 2007.  
 23 Defendants produced the entire SAS database with respect to 69 additional customers identified  
 24 by Oracle on October 5 and November 9, 2007. Finally, Defendants produced the entire SAS  
 database containing ALL of TN's PeopleSoft and J.D. Edwards' customers on December 4, 2007.  
 As part of the parties' expanded discovery timeline agreement, on February 13, 2009, Defendants  
 further updated the SAS production to include activity through October 31, 2008. *See* Fuchs  
 Decl., ¶ 5.

25 <sup>18</sup> Oracle incorrectly states that Defendants have refused and are unwilling to agree to fact  
 26 stipulations. *See* Motion at 13, 15. Defendants have attempted to negotiate an acceptable  
 27 stipulation and are willing to continue to negotiate towards a possible stipulation. It is true that  
 28 Defendants have not accepted any of Oracle's proposed draft stipulations, and it is also true that  
 there are several major issues that must be resolved before Defendants would ever agree to a fact  
 stipulation. However, Defendants have never indicated to Oracle that they have refused or are  
 otherwise unwilling to continue to negotiate in an effort to attempt to reach an agreement to some  
 form of fact stipulation.

1                   **1. Oracle's Actual Request.**

2                   Oracle attempts to broaden its already overly-broad request. Oracle repeatedly cites to  
3 Catherine Hyde as the former TN employee who is able to provide additional information about  
4 the "source" of environments, while ignoring that Interrogatory 14 does not request the source of  
5 environments. *See* Motion at 14:18-22, 15:5-10.<sup>19</sup> What Interrogatory 14 actually requests is a  
6 chronicling of the daily use of the TN customer environments and/or environment components  
7 (collectively referred to as "TN customer environments"). The request specifically states:

8                   For each local environment Identified in Your responses to Interrogatories 12 and  
9 13, Identify all Customers who received support based on the Use of that  
10 environment, and a detailed description of that support (such as, for example, the  
11 retrofit tax updates testified to by Shelley Nelson (Shelley Nelson Dep. at 32:19-  
34:13 (Oct. 30, 2007)) including, where applicable, Identification of the name,  
number, version or other Identifying information of the product provided as part  
of the support.

12                   Howard Decl., Ex. D. The request asks for: (1) a list of all customers who received support based  
13 on the use of environments, (2) a detailed description of that support and (3) the fix (product) that  
14 came from the support. The "source" of the TN customer environments is not sought anywhere  
15 in the request.

16                   **2. TN Properly Objected and Responded to the Request.**

17                   TN originally responded to the request on December 27, 2007 and objected that the  
18 request is "cumulative, compound, unduly burdensome and oppressive to the extent it seeks to  
19 require TN to attempt to evaluate millions of pages of documents and data relating to customer  
20 support that have been created over several years." *See* Howard Decl., Ex. D. Subject to those  
21 objections, TN provided the following narrative response:

22                   Generally, to the extent a particular entity is or was a [TN] customer, and when  
23 [TN] maintains an environment on that customer's behalf, [TN] provided or  
24 provides support to that customer utilizing that environment. For updates and/or  
25 fixes to Peoplesoft and JDE products, [TN] has generally used the customer's  
environment(s) (whether maintained by [TN] or the customer) to create or test the  
updates and/or fixes. [TN] is aware of certain instances where an environment

26 <sup>19</sup> *See* Catherine Hyde's Declaration for a description of how she studied SAS and  
27 BakTrak to provide that testimony referenced and for her statement that she believes that her  
28 knowledge has been exhausted on the source subject. *See* Declaration of Catherine Hyde ("Hyde  
Decl."), ¶ 6. Information relating to the "source" of an environment can be located in the  
spreadsheets prepared and the data referenced in responses to Interrogatory Nos. 12 and 13 from  
Oracle USA, Inc.'s Second Set of Interrogatories to TN. *See* Fuchs Decl. ¶ 20, Ex. H.

1 maintained on behalf of one customer may have been used to create or test  
2 updates and/or fixes for other customers. *See, e.g.*, Tr. of October 30, 2007  
3 Deposition of Mark Kreutz, at 197:8-199:25; Tr. of October 30, 2007 Deposition  
of Shelley Nelson at 32:19-41:17, 53:13-55:7; Dec. 6, 2007 Deposition of Shelley  
Nelson at 126:4-139:3, 145:1-14, 160:16-161:5, 185:3-16, 195:24-196:20.

4 Howard Decl., Ex. D. TN further responded by relying on Rule 33(d) and pointing Oracle  
5 directly to the SAS database. *See id.*

6 TN supplemented its response on May 22, 2009 to provide updated Rule 33(d) cites to the  
7 SAS database and to further raise as an issue the cumulative and burdensome nature of the  
8 request by directing Oracle to the January 22, 2008 Rule 30(b)(6) Notice on the exact same topic  
9 and to all of the depositions Oracle has taken to date on the topic. *See id;* *see also* Fuchs Decl.,  
10 ¶ 22, Ex. J (Amended Rule 30(b)(6) Notice on the TN customer environment topic).

### 11 **3. TN Properly Relied on Rule 33(d).**

12 The SAS database is the most complete and organized record that TN has relating to its  
13 customer support and how TN used TN customer environments in providing that support. *See*  
14 Hyde Decl., ¶¶ 2, 4. TN provided the entire SAS database to Oracle well over 19 months ago in  
15 exactly the same form it was used at TN. *See* Fuchs Decl., ¶¶ 4, 5; Hyde Decl., ¶ 5. Oracle is  
16 able to search, organize and see the data in the same way a former TN employee could, and  
17 Oracle has demonstrated that it has that ability in the more than 300-plus hours of deposition  
18 testimony it has taken to date.<sup>20</sup> Given that Oracle has demonstrated an ability to use SAS in the  
19 same way as a former TN employee, the burden of extracting the relevant data is substantially the  
20 same for both parties.

21  
22  
23  
24 <sup>20</sup> Defendants' production of SAS is vastly different from Oracle's attempt to produce and  
25 point Defendants to 2 terabytes of data from its Customer Connection website. While Defendants  
26 took on the burden of providing SAS with the same usability as it had at TN, Oracle provided the  
27 Customer Connection data to Defendants in raw form without the interface it actually uses to  
28 view the data. Despite the lack of usability, Oracle has consistently pointed Defendants to the  
Customer Connection data pursuant to Rule 33(d). *See* Fuchs Decl., ¶ 13, Ex. A (Plaintiffs'  
Second Amended and Supplemental Responses and Objections to Defendant TN, Inc.'s First Set  
of Interrogatories, No. 7 – the cite to ORCL00313462-3 and ORCL0485842 is the 2 terabytes of  
raw data).

1 (a) The first criterion under Rule 33(d) is satisfied because Oracle  
 2 is able to locate the “records to be reviewed” “as readily as”  
 3 TN.

4 TN specifically identified the SAS database in response to Interrogatory 14. *See* Howard  
 5 Decl., Ex. D. While the SAS database has substantial content, it is user friendly. Catherine  
 6 Hyde’s declaration states that “[t]he database has a self-contained index and is fully searchable.  
 7 The data can be sorted and reviewed in a number of different ways including, but not limited to,  
 8 by customer, fix, case, and product line. All of the different ways to view the data can be  
 9 determined by the index.” *See* Hyde Decl., ¶ 4.

10 TN produced SAS in the same form and with the same functionality as it had while used  
 11 at TN. *See* Fuchs Decl., ¶ 4.<sup>21</sup> When Oracle first raised this issue with Judge Legge in January  
 12 2008,<sup>22</sup> Defendants provided Judge Legge with a demonstration of the SAS database as produced  
 13 to Oracle.<sup>23</sup> *See* Fuchs Decl., ¶ 10. In response to that demonstration, Judge Legge  
 14 recommended that

15 ...defendants be compelled to send, at their expense, an appropriate engineer,  
 16 together with an attorney if defendants desire, to the offices of Oracle to meet  
 17 with Oracle’s engineers about how to access the database. The purpose of the  
 18 meeting is not to discuss the information, or to state contentions with respect to it,  
 but is simply to assist Oracle to find the information in the database which has  
 been provided.

19 Howard Decl., Ex. E (emphasis in original). Likely due to the SAS database’s ease of use, Oracle  
 20 never sought Defendants’ engineers’ assistance under Judge Legge’s recommendation, although  
 21 Defendants were and remain willing to provide the assistance Judge Legge recommended. Since  
 22 the time of Judge Legge’s recommendation, Oracle has clearly demonstrated an ability to access  
 23 and locate material in SAS by using 109 printouts from the SAS database as deposition exhibits.  
 24 *See* Fuchs Decl., ¶ 8; *see also* Hyde Decl., ¶ 5.

25 <sup>21</sup> TN could have attempted to produce the data from SAS in a number of different ways,  
 26 including providing it in static .tiff form, but instead TN chose to recreate the database and  
 produce it in its dynamic native form to make it the most useable for the Plaintiffs.

27 <sup>22</sup> Oracle’s original motion in front of Judge Legge included Interrogatory 14.

28 <sup>23</sup> Defendants will be prepared to provide the Court with a similar demonstration at the  
 August 4 hearing on the Motion.

1 In this case, although it will no doubt require effort for Oracle to locate the answers in the  
 2 SAS database, it would be no easier for TN to do so, especially in light of the TN wind down.<sup>24</sup>  
 3 See Hyde Decl., ¶¶ 4, 5, 7. Numerous witnesses have made it clear that SAS is the best record of  
 4 the activity requested and that the witness would need to reference SAS to have the necessary  
 5 information.<sup>25</sup> TN has identified a specific, organized, searchable database that contains the  
 6 information Oracle seeks in a manner that provides Oracle the ability to electronically index, sort  
 7 and analyze that information. See Fuchs Decl., ¶¶ 4, 5, 9 (screenshot exemplar showing  
 8 information contained in SAS). What Oracle wants is for TN to do that indexing, sorting and  
 9 analysis for it. Rule 33(d) is specifically designed to permit a responding party to shift the burden  
 10 back to the requesting party in this situation. Ultimately, the overbreadth of Oracle's  
 11 interrogatories has required and warranted a reference to TN's best database on the issue. See  
 12 *Goodrich Corp. v. Emhart Indus., Inc.*, 2005 U.S. Dist. LEXIS 25158 (C.D. Cal. Oct. 12, 2005)  
 13 (denying motion to compel further supplementation of responses made in reliance upon 33(d)  
 14 when propounding party failed to establish that responding party had withheld documents that  
 15 might more "clearly identify" answers it sought).

16  
 17  
 18 <sup>24</sup> As Plaintiffs point out, TN was wound down on October 31, 2008. And, with the  
 19 exception of a few consultants who occasionally help with locating and understanding  
 20 information, Defendants' counsel has limited to no access to TN's former employees. See Fuchs  
 21 Decl., ¶ 11. Oracle argues that if the TN wind down somehow complicates TN's ability to  
 22 provide the information Oracle seeks, then that is a problem of TN's own making. See Motion at  
 15-16. However, the wind down was publicly announced on July 21, 2008, and Oracle could  
 have moved to compel the information it now seeks at a time when many of the relevant TN  
 employees were still employed by TN.

23 <sup>25</sup> See e.g., Fuchs Decl., ¶ 15, Ex. C (February 6, 2008 Deposition of John Baugh, 70:17-  
 71:11 (testifying that the only way to determine how local environments were created is to  
 24 consult e-mails and the SAS database); 73:16-74:3 (same); February 7, 2008 Deposition of John  
 Baugh, 155:21-156:14 (testifying that would review SAS records to determine how environment  
 was used); April 1, 2008 Deposition of Katherine Walker Williams, 53:15-55:8 (testimony that  
 25 would need to refer to SAS to obtain more information about environment), 62:20-63:16  
 (testimony that uncertain how certain environments were used), 77:16-78:9 (testimony that would  
 26 review SAS database to obtain more information about environment); April 1, 2008 Deposition of  
 Catherine Lee Hyde, 47:7-12 (testifying that would need to refer to SAS to obtain more  
 27 information about environment); April 2, 2008 Deposition of Catherine Lee Hyde, 85:25-86:4  
 (testifying that would need to refer to SAS and BakTrak to obtain more information about  
 28 environment), 130:19-132:3 (testifying that would need to refer to SAS to obtain more  
 information about environment)).

1                                   **(b) The second criterion under Rule 33(d) is satisfied because the**  
 2                                   **burden is comparable.**

3           Business records may be produced when the “burden of deriving or ascertaining the  
 4 [interrogatory] answer” from them is “substantially the same” for both parties. Fed. R. Civ. P.  
 5 33(d). The *propounding* party must demonstrate “that the burden of deriving or ascertaining the  
 6 answers is not substantially the same for both parties.” *T.N. Taube Corp.*, 136 F.R.D. at 453  
 7 (quoting 4A Moore’s *Federal Practice* par. 33.25 (2d ed. 1990)). Oracle has not met its burden.

8           Indeed, Oracle has demonstrated, in its almost 32 hours of Rule 30(b)(6) deposition  
 9 testimony on a Rule 30(b)(6) Notice that included this very topic, that it has an equal ability to  
 10 access and locate the requested data in SAS.<sup>26</sup> Oracle has also demonstrated this ability in the  
 11 300-plus other depositions hours it has taken to date.<sup>27</sup> The majority of the deposition cites

12                                   <sup>26</sup> In Oracle’s January 22, 2008 Rule 30(b)(6) Notice, Oracle requested deposition  
 13 testimony on TN’s “creation and [u]se of Customer Local Environments, including without  
 14 limitation: . . . (b) The manner and method by which Customer Local Environments were created,  
 15 stored and Used by You; . . . . (d) The total number of Customer Local Environments created for  
 16 each identified Customer; (e) The name, release, and version of all PSFT or JDE branded  
 17 Software obtained and/or copied to create each identified Customer Local Environment; (f) The  
 18 identity and description of all Customer Local Environments maintained in any way by You  
 19 relating to Customers for whom You had ceased to provide support services; (g) The identity and  
 20 description of all Customer Local Environments Used by You in any way to support any  
 21 Customer other than the one that provided the Software Used to create the Customer Local  
 22 Environment; . . . [and] (l) The process by which Customer Local Environments were Used as  
 23 part of the ordinary course of business for SAP TN, including without limitation to on-boarding  
 24 of new Customers; support of Customer cases, issues, and problems; reactive and proactive  
 25 development of bug fixes, updates, patches, explanations, or regulatory changes for Customers;  
 26 research into and design of those changes; troubleshooting for Customers; and testing of other  
 27 operating systems levels. . . .” See Fuchs Decl., ¶¶ 8, 22, Ex. J.

28                                   <sup>27</sup> See e.g., Fuchs Decl., ¶¶ 2, 15, 16, Ex. C, D (April 1, 2008 Deposition of Katherine  
 Walker Williams, 179:19-182:18 (testifying regarding use of environment as set forth in SAS  
 record, Plaintiffs’ Exhibit 83); April 2, 2008 Deposition of Catherine Lee Hyde, 284:15-286:10  
 (testifying regarding use of environment as set forth in SAS record, Plaintiffs’ Exhibit 103); June  
 25, 2008 Deposition of Larry Garcia, 12:5-10 (testifying regarding use of environment as set forth  
 in SAS record, Plaintiffs’ Exhibit 302); 19:17-20:3 (testifying regarding use of environment as set  
 forth in SAS record, Plaintiffs’ Exhibit 287); June 25, 2008 Deposition of Roderic Russell, 31:19-  
 32:21 (testifying regarding use of environments as set forth in SAS record, Plaintiffs’ Exhibit  
 287), 47:25-49:19 (testifying regarding use of environments as set forth in SAS record, Plaintiffs’  
 Exhibit 290), 61:19-63:13 (testifying regarding use of environments as set forth in SAS record,  
 Plaintiffs’ Exhibit 293), 91:18-92:2 (testifying regarding use of environments as set forth in SAS  
 record, Plaintiffs’ Exhibit 299), 116:1-18 (testifying regarding use of environments as set forth in  
 SAS record, Plaintiffs’ Exhibit 300); December 5, 2008 Deposition of Matthew Bowden, 158:14-  
 160:15 (confirming written statements in SAS record, Plaintiffs’ Exhibit 538); 227:14-22  
 (testifying regarding use of environment as set forth in Plaintiffs’ Exhibit 289); 249:5-250:2  
 (testifying regarding use of environment as set forth in Data Warehouse record, Plaintiffs’ Exhibit  
 558), 279:7-280:2 (testifying regarding use of environments as set forth in SAS record, Exhibit

1 included in footnote 27 establish that the witness is doing little more than confirming what is  
2 included in SAS. *See* Hyde Decl., ¶ 5 (stating that “a substantial portion of those questions  
3 involved simply asking me to confirm the information in the SAS database printouts”).

4 While it is true that it will be burdensome to extract the information Oracle seeks out of  
5 SAS, the burden and cost is substantially equal for both sides. Oracle has demonstrated and  
6 cannot ignore, that once minimal training on the use of SAS is obtained and the information  
7 requested is provided, it takes no special expertise to locate and extract the sought-after material.  
8 *See* Hyde Decl., ¶¶ 4-5. The cost and burden, although significant, is simply the time required to  
9 review the data in SAS.

10 Oracle’s argument that TN former employees are more familiar with SAS misses the point  
11 and misstates Oracle’s competency (and frequency) in using and compiling the information from  
12 that database for over a year. Contrary to Oracle’s suggestion, whether TN is more familiar with  
13 its business records than Oracle is not dispositive of whether TN should carry Oracle’s burden of  
14 building Oracle’s own case. Indeed, it is difficult to image an instance in which the responding  
15 party would not be more familiar with its business records than the propounding party. If a  
16 propounding party only had to show that the producing party was more familiar with the records  
17 than the receiving party, Rule 33(d) would lose almost all efficacy. *Cf. Puerto Rico Aqueduct &*  
18 *Sewer Authority v. Clow Corp.*, 108 F.R.D. 304, 308-09 (D.P.R. 1985) (noting that responding  
19 party’s greater familiarity is inevitable and focusing on feasibility of deriving answers from  
20 business records). Accordingly, former TN employees’ familiarity with TN’s historic records is  
21 not and should not be dispositive. *See, e.g., Petroleum Ins. Agency*, 111 F.R.D. at 320-21  
22 (denying plaintiff’s motion to compel further responses to all but one interrogatory despite the  
23 fact “it is true that the defendants are more familiar with their records”). In fact, Oracle’s counsel

24  
25 (continued...)

26 566); February 5, 2009 Deposition of Roderic Russell, 143:4-145:25 (no independent memory of  
27 fix documented in SAS record, Plaintiffs’ Exhibits 816 and 817); May 12, 2009 Deposition of  
28 Catherine Hyde, 125:17-126:25 (testifying regarding written statements in SAS record, Plaintiffs’  
Exhibit 1276), 132:3-132:19 (testifying regarding use of environment as documented in SAS  
record, Plaintiffs’ Exhibit 1277), 157:2-159:8 (testifying regarding use of environment as  
documented in SAS record, Plaintiffs’ Exhibit 1283)).

1 and experts have now spent over a year becoming more familiar with TN's business records than  
2 most TN former employees currently are.

3 **4. Interrogatory 14 "Must" Be Limited under Rule 26(b)(2)(C).**

4 Under Rule 26(b)(2)(C), the Court "must" limit the frequency or extent of discovery if it  
5 determines that the discovery is: (1) unreasonably cumulative or duplicative, (2) can be obtained  
6 from other sources that are more convenient, (3) the party seeking discovery has had ample  
7 opportunity to obtain the information by discovery in the action or (4) the burden or expense of  
8 the proposed discovery outweighs the likely benefit. *See* Fed. R. Civ. P. 26(b)(2)(C). Although  
9 Rule 26(b)(2)(C) provides four alternative grounds under which this Court must limit Oracle's  
10 request, under the facts in this case, there is substantial evidence supporting all four grounds.

11 As discussed above, Interrogatory 14 is unreasonably cumulative or duplicative of  
12 Defendants' document production, 30-plus hours of Rule 30(b)(6) testimony on the topic and  
13 numerous other hours of individual testimony on this topic. Defendants have already gone to  
14 great expense and burden to provide Oracle with the information TN possesses on the topic.<sup>28</sup>  
15 Further, as stated above, the data TN has on the topic has already been provided in the most  
16 convenient source, which is SAS. What Oracle is really asking is that Defendants be required to  
17 incur the burden and expense of summarizing certain data points that exist in SAS and that Oracle  
18 believes are relevant to its claims. There is no legal basis whatsoever to justify the burden  
19 shifting that Oracle improperly seeks.

20 Oracle has had the majority of SAS for over 19 months and should have been evaluating  
21 and summarizing what it believes is the relevant information during that time. By now, Oracle  
22 should be able to substantially narrow its requests to only those specific information items, if any,  
23 that are not ascertainable from the documents, data or testimony Defendants have already  
24 provided. Oracle has failed to make any attempt to narrow its requests and continues with its

25  
26  
27 <sup>28</sup> As the Court is already aware, Defendants are on pace to spend in excess of \$13 million  
28 on the custodian production alone. Defendants have also incurred over a quarter of a million  
dollars producing the SAS databases, and in excess of half a million dollars in providing native  
images of all of TN's support services servers for the products at issue. *See* Fuchs Decl., ¶ 7.

1 scorched earth discovery approach. Instead of narrowing its requests, Oracle now reads its  
2 requests more broadly than ever.<sup>29</sup>

3 The burden on Defendants of attempting to provide a narrative response to Interrogatory  
4 14 greatly outweighs the benefit to Plaintiffs. It will take thousands of hours to try to extract,  
5 compile and summarize the requested information from SAS. *See* Hyde Decl., ¶ 7. It took  
6 Defendants approximately 1,000 hours to review SAS for potentially privileged content. *See*  
7 Fuchs Decl., ¶ 7. It would take numerous multiples of that time to extract and chart the data  
8 Oracle is requesting. As described above, Oracle has an equal ability to take on that burden.  
9 Oracle has the ultimate burden of proof on its claims and should be required to assume the effort  
10 associated with that burden.

11 For any one of the reasons stated above, both Rule 33(d) and Rule 26(b)(2)(C) provide a  
12 separate and sufficient basis for this Court to deny the relief Oracle seeks and instead require  
13 Oracle to assume whatever burden it believes is appropriate to extract, compile and summarize  
14 the information it seeks.

15 **C. Oracle Is Not Entitled to the Declaration It Seeks.**

16 Oracle is well aware of Defendants' efforts to preserve data in this case. Starting with the  
17 Rule 26(f) conference and continuing through numerous negotiations regarding a potential  
18 preservation order, Defendants have provided Oracle with great detail regarding TN's efforts to  
19 make a preservation copy of every TN computer and server, including the computers, servers and  
20 databases at issue in this motion. *See* Fuchs Decl., ¶ 11. TN also made reasonable efforts to  
21 collect and preserve every original TN computer and server as part of the TN wind down. *See id.*  
22 Oracle is further aware that TN entered into consulting agreements with seven former TN  
23 employees to help locate and provide information on an as needed basis. *See id.* Those  
24 consultants, however, are not always accessible and are not in any way prevented from seeking  
25

26 \_\_\_\_\_  
27 <sup>29</sup> During a June 6, 2009 meet and confer conference call, Defendants specifically  
28 requested that Oracle provide a proposal on a form of response that would not require Defendants  
to do a fix-by-fix answer on how each TN customer environment was used. Oracle refused to  
entertain the request.

1 other employment. *See id.*; *see also* Hyde Decl., ¶ 7. In fact, most of these consultants are  
 2 currently employed on a full-time basis by other employers. *See* Fuchs Decl., ¶ 11.

3 To the extent that Oracle seeks additional information regarding Defendants' counsel's  
 4 efforts, that would likely invade the attorney-client privilege and/or the attorney work product  
 5 immunity provided in Rule 26(b)(3)(A) and thus, Defendants object to that request on these bases.

6 **IV. ORACLE'S REQUEST FOR "DAMAGES-RELATED" DISCOVERY IS MOOT.**

7 Oracle's Motion to Compel is moot by agreement of the parties because Defendants have  
 8 agreed to produce documents or information that satisfy Oracle's substantially narrowed requests.  
 9 Specifically, Oracle moved to compel production of "certain documents responsive to Requests  
 10 for Production 21-23 and 27 from Oracle's Second Set of Requests for Production of Documents  
 11 and subpart (l) of Oracle's First Targeted Search Request" claiming that such discovery is  
 12 relevant to a hypothetical license between the parties and Defendants' forthcoming summary  
 13 judgment motion regarding Oracle's hypothetical license damages theory. *See* Motion at 1, 3-4,  
 14 7-11. In particular, Oracle requested that the Court compel production of the following:

- 15 1. ". . .documents sufficient to show (a) the existence, scope, and terms of any licenses with  
 16 independent (non-affiliated, non-partner) software support service providers for SAP-  
 17 branded software applications or any licenses Defendants deem comparable to the type of  
 18 license that would have been required between Oracle and SAP TN for the type of  
 19 activities engaged in by Defendants; (b) Defendants' intellectual property and intangible  
 20 asset valuations resulting from SAP's acquisitions of Business Objects, MaXware, and  
 OutlookSoft Corporation; and (c) the license or valuation documents for any acquisitions  
 that Defendants contend are a more appropriate benchmark."
- 21 2. ". . .documents sufficient to show SAP's application sales close rate and support renewal  
 22 rate over the relevant period."

23 *See* [Proposed] Order Granting Plaintiffs' Motion to Compel Production of Documents Related to  
 24 Damages Model and Interrogatory Responses Related to Use of Plaintiffs' Intellectual Property,  
 25 ¶¶ 1-2.

26 Oracle's Motion, for the first time, substantially narrowed the requested damages-related  
 27 discovery Oracle contends it needs in anticipation of Defendants' motion for summary judgment.  
 28 Prior to filing the Motion, including in meet and confer communications with opposing counsel,  
 Oracle had sought much broader discovery on this topic, claiming to need all documents  
 responsive to the above-referenced discovery requests. This included: all documents relating to

1 agreements between SAP and any non-partner that provides third party support of SAP software,  
2 all documents relating to SAP's valuation of the IP of any company it has acquired, including  
3 Business Objects, all documents related to the allocation of the purchase price for Business  
4 Objects and all documents related to SAP's historic applications sales close rates and service  
5 contract renewal rates. Defendants made various objections to these requests, including  
6 overbreadth, undue burden and relevance, and continue to stand on these objections.

7 Although Defendants continue to believe that such documents are not relevant to any  
8 aspect of the case, including their upcoming summary judgment motion, and maintain all  
9 objections to the underlying discovery requests noted above, in the interest of a compromise and  
10 to avoid an unnecessary Rule 56(f) motion, Defendants agreed to produce non-privileged  
11 documents sufficient to show the information sought in the more limited requests above, to the  
12 extent that such documents exist. Defendants informed Oracle of this agreement on July 13, 2009,  
13 and Oracle confirmed that this mooted that portion of the Motion seeking "damages-related"  
14 discovery. *See* Fuchs Decl., ¶ 23, Ex. K.

## 15 **V. CONCLUSION**

16 Defendants' agreement (as memorialized in their counsel's July 13 e-mail to Oracle's  
17 counsel) to produce certain data and provide certain information in response to the substantially  
18 limited relief Oracle seeks in pages 7-11 of the Motion and numbered paragraphs 1 and 2 of  
19 Oracle's proposed order moots that request for relief. There is no reason to compel Defendants to  
20 produce data or information they have voluntarily agreed to produce.

21 As for the relief requested in pages 12-16 of the Motion and numbered paragraph 3 of  
22 Oracle's proposed order, which seeks supplemental responses to Interrogatories 13 and 14,  
23 Defendants have already produced more than sufficient documents, data and testimony in  
24 satisfaction of those requests. To the extent that Oracle seeks a guide of information related to  
25 the topics covered by Interrogatories 13 and 14, then it, as the party with the ultimate burden of  
26 proof on its claims, should assume all costs and related burdens of extracting, compiling and  
27 summarizing the documents, data and testimony Defendants have already provided.

28

1 Defendants respectfully request that this Court deny the Motion in its entirety.

2 Dated: July 14, 2009

JONES DAY

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By: /s/ Joshua L. Fuchs

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Joshua L. Fuchs

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Counsel for Defendants  
SAP AG, SAP AMERICA, INC., and  
TOMORROWNOW, INC.

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