

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

CARVANA, LLC,

Plaintiff,

v.

INTERNATIONAL BUSINESS
MACHINES CORPORATION,

Defendant.

Civ. No. 7:23-CV-8616 (KMK)(VR)

**PLAINTIFF CARVANA, LLC'S RULE 30(B)(6)
NOTICE OF DEPOSITION OF DEFENDANT INTERNATIONAL
BUSINESS MACHINES CORPORATION**

PLEASE TAKE NOTICE that, pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure, Defendant Carvana.com, LLC ("Carvana"), by and through its undersigned counsel, will take the deposition of IBM Inc. ("IBM") by oral examination. IBM is required to designate one or more officers, directors, or managing agents, or designate other persons who consent to testify on its behalf, regarding the matters set forth in Schedule A appended hereto.

The deposition will commence on August 1, 2024, at 9:00 AM MDT, or at such other time and date as may be agreed by the parties, with location and other logistical arrangements to be agreed upon by the parties one week in advance of the deposition, and it will continue from day to day until completed. The deposition will be conducted before a Notary Public or other officer authorized by law to administer oaths and will be recorded stenographically, through the instant visual

display of testimony, and will be recorded by audio-visual means. Carvana requests that prior to the commencement of the deposition, IBM supply a written designation of the person(s) who will testify on its behalf and identify the topic(s) for which each such person is designated.

Dated: July 12, 2024

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SCHEDULE A

The following definitions shall apply, except where the context necessarily dictates otherwise, and is only intended to apply to this document.

1. The terms “IBM,” “Defendant,” “you,” and “your” shall mean defendant International Business Machines, Inc., and includes, without limitation, (a) any of its divisions, departments, or other operational or organizational units; (b) all of its predecessor or successor companies, affiliates, subsidiaries, parent companies, partnerships, or corporations (whether or not formally incorporated or otherwise organized); (c) present and former officers, directors, employees, consultants, agents, attorneys, or others acting or purporting to act on its behalf.

2. The terms “Plaintiff” and “Carvana” shall mean plaintiff Carvana, LLC, as well as any agents, affiliates, or other persons acting on its behalf.

3. The terms “document” and/or “thing” are used herein under the broadest scope allowable under Rule 34 of the Federal Rules of Civil Procedure and shall be construed to mean, without limitation, any written, printed, typed, stored, photocopied, photographed, recorded or otherwise reproduced communication, compilation or reproduction, including computer or electronically generated or stored information or data, whether purportedly privileged or not. The term “document” specifically includes all forms of electronically stored information (“ESI”). A draft or non-identical copy is a separate document within

the meaning of this term. As used herein, “thing” also means any tangible item, other than a “document” as defined herein, which constitutes or contains matters within the scope of Rule 26 of the Federal Rules of Civil Procedure.

4. The terms “person” or “persons” shall include natural persons, firms, partnerships, associations, corporations, and business entities operating under an assumed name.

5. The term “date” means the exact date, month, and year, if ascertainable, or, if not, the best available approximation.

6. “Patents-in-Suit” shall mean U.S. Patent Nos. 7,543,234 (“the ’234 patent”), 7,631,346 (“the ’346 Patent”), and 7,702,719 (“the ’719 Patent”). (The ’234 Patent, ’346 Patent, and ’719 Patent patents shall be referred to collectively as “the Patents-In-Suit”).

7. The term “identify,” (1) when applicable to a natural person means to provide the person’s full name, any nickname or alias, last known address, last known occupation, last known business address, last known personal and business telephone numbers, and last known email address; (2) when applicable to an entity other than a natural person means to provide the entity’s full name, last known address of its principal place of business, state of incorporation, and type of entity (i.e. corporation, partnership, or other legal entity); (3) when applicable to a communication means to provide the date, time, and place of the communication,

the mode and subject matter of the communication, the names of all participants in the communication, and the identity of any documents reflecting the content of the communication.

8. The term “Accused Instrumentality” has the same meaning as set forth in IBM’s December 15, 2023 First Set of Requests for Production. Specifically, “Accused Instrumentality” means at least the Carvana website, including www.carvana.com, and subdomains thereof, and the Carvana mobile applications, including at least the iOS and Android Carvana applications, and any product, application, service, or method accused by IBM of infringing any claim of any of the Patents-In-Suit under any subsection of 35 U.S.C. § 271, including the instrumentalities identified in IBM’s Answer and Counterclaims, Amended Answer and Amended Counterclaims, forthcoming infringement contentions, and any amendments or supplementations thereto.

9. The term “Prior Art” means all prior art references for any of the Patents-in-Suit that are: (i) identified in any of Carvana’s invalidity contentions served in this Action; (ii) identified in any other case in which IBM has asserted one or more of the Patents-in-Suit; or (iii) otherwise known to IBM.

10. “Facebook” shall mean Facebook Inc., each of its predecessors, successors (including Meta Platforms, Inc.), and all past and present representatives, agents, employees, shareholders, officers, directors, executives,

subsidiaries, parent corporations, attorneys, and other persons or entities acting on their behalf.

11. “Google” shall mean Google LLC, each of its predecessors, successors, and all past and present representatives, agents, employees, shareholders, officers, directors, executives, subsidiaries, parent corporations, attorneys, and other persons or entities acting on their behalf.

12. “Apple” shall mean Apple Computer, Inc., each of its predecessors (including Apple Computer, Inc.), successors, and all past and present representatives, agents, employees, shareholders, officers, directors, executives, subsidiaries, parent corporations, attorneys, and other persons or entities acting on their behalf.

13. “Facebook License” shall mean the license agreement(s) dated as of December 29, 2011 and March 9, 2017, between IBM and Facebook, Inc., including any amendments thereto, and any agreements superseding such agreements.

14. “Google License” shall mean the license agreement dated as of September 29, 2006, as amended on December 17, 2010, between IBM and Google Inc., including any amendments thereto, and any agreements superseding such agreements.

15. “Apple License” shall mean the license agreement dated as of October 25, 2002 between IBM and Apple, including any amendments thereto, and any agreements superseding such agreements.

16. “Inventor(s)” shall mean the individual(s) listed as an inventor on any of the faces of the Patents-in-Suit.

17. “Orange” shall include Orange S.A., Orange UK, Orange France and all past and present representatives, agents, employees, shareholders, officers, directors, executives, subsidiaries, parent corporations, attorneys, affiliates, including but not limited to Orange Group, and other persons or entities acting on behalf of any of the foregoing.

18. “T. Rowe Price” shall include T. Rowe Price and all past and present representatives, agents, employees, shareholders, officers, directors, executives, subsidiaries, parent corporations, attorneys, affiliates, and other persons or entities acting on behalf of any of the foregoing.

19. “PTAB” shall refer to the Patent Trial and Appeal Board.

20. “USPTO” shall refer to the United States Patent and Trademark Office.

21. “Action” shall mean and is intended to refer to *Carvana, LLC vs. International Business Machines Corp.*, 7:23-cv-08616 (S.D.N.Y.).

Deposition Topics

1. The conception and inventorship of each of the Patents-in-Suit, including all priority claims and/or attempts to swear behind any of the earliest filing dates or priority claims for any of the Patents-in-Suit.

2. The ownership, assignment history, and complete chain-of-title for each of the Patents-in-Suit, including all terms of any agreements, financial or other compensation, business deals, collateral, valuations, and other considerations related thereto.

3. The reduction to practice of all embodiments or systems that IBM contends ever practiced any claim of the Patents-in-Suit including but not limited to the dates such embodiments or systems were created, the disclosure to any third party or the public of such embodiments or systems, the technical details relating to how any such embodiments or systems practiced the claim(s) of the Patents-in-Suit, and the nature and location of any evidence tending to prove the foregoing (e.g., source code).

4. IBM's analysis of Next.js and/or React, and communications with any persons or developers affiliated with Next.js and/or React, including but not limited to any communications stating that the use of Next.js or React infringes any Patent-in-Suit or requires a license to any Patent-in-Suit.

5. All valuations, analyses, reports, offers to sell, offers to purchase, purchases, sales, and attempts to sell or purchase, for each of the Patents-in-Suit.

6. The facts and circumstances surrounding the negotiation and execution of all actual or contemplated prior licenses, settlement agreements, and other agreements licensing, transferring or conveying any right in or relating to any Patent-in-Suit.

7. Marking (in the broadest sense with reference to 35 U.S.C. § 287), by any person or entity, of any of the following with the number of any of the Patents-in-Suit: (a) any product, service, system, apparatus, or website; or (b) any documents referring or relating to any product, service, system, apparatus, or website; as well as any efforts by IBM and/or its licensees to enforce marking requirements regarding any of the Patents-in-Suit.

8. IBM's historical knowledge, awareness, discussions, mentions, and evaluations of Carvana, its principals and/or the intellectual property rights or patents of Carvana.

9. IBM's first knowledge or awareness of any Accused Instrumentality, including the circumstances leading up to and surrounding such knowledge or awareness and IBM's actions in response thereto, IBM's infringement allegations against Carvana, including a complete definition of the "Accused Instrumentalities," IBM's infringement contentions related to the Patents-in-Suit,

and IBM's investigations thereof.

10. IBM's prior communications and dealings with Carvana, all individuals affiliated with or representing IBM in the same, and all non-privileged documents related thereto.

11. IBM's drafting of, transmission of, and follow-up communications regarding IBM's notices of purported infringement, including but not limited to, IBM's letters dated October 27, 2021, February 8, 2023, and August 11, 2023, and pre-litigation communications between Mr. Tom McBride and Carvana.

12. IBM's history of enforcement or decisions not to enforce any of the Patents-in-Suit, including any prior communications relating to demand letters that IBM sent to a third party but where IBM did not ultimately sue that third party and the reasons therefor.

13. The facts and circumstances underlying IBM's lack of enforcement of the Patents-in-Suit against CarNow or any CarNow customers including but not limited to those listed on www.carnow.com/customers (last visited July 12, 2024).

14. The interpretation of claim terms that are in dispute or will require construction by the court.

15. The nature and history of IBM's relationships and business dealings with Orange S.A. and T. Rowe Price, including all offers to sale made by IBM and agreements signed by Orange S.A. and T. Rowe Price prior to April 1, 2005, and

the technical details and documentation related to the software, systems or services offered for sale by IBM to Orange S.A., and T. Rowe Price, prior to April 1, 2005.

16. IBM's search for written offers for sale made to, and agreements executed between IBM and Orange S.A., and between IBM and T. Rowe Price.

17. All contributions, suggestions, parameters, requirements, ideas, or concepts proposed or made in writing or orally by Orange or T. Rowe Price to IBM regarding software, systems or services prior to April 1, 2005.

18. The nature and extent of IBM's interest in the financial outcome of this Action, including the percentage of and damages award to which IBM will be entitled if it succeeds on its claims against Carvana at trial.

19. All non-infringing alternatives to the claims of the Patents-in-Suit that IBM knows of or that have been alleged by any third party or defendant in any IBM lawsuit, including when it was available, how it operates, any differences from the inventions allegedly claimed by the Patents-in-Suit, all documents relating to any such alleged non-infringing alternative, and whether and to what extent IBM knows of any such alternative having been used or implemented.

20. The nature, scope, and content of the Prior Art, including Prior Art identified in Carvana's invalidity contentions and in the prosecution histories of the Patents-in-Suit, all prior and current challenges to the validity of the Patents-in-Suit before the USPTO, PTAB (e.g., IPRs and *ex parte* reexaminations), or federal

court.

21. Any Prior Art gathering or searching by IBM, any named inventor on the Patents-in-Suit, or any other non-lawyer.

22. The status of all appeals of judicial and administrative decisions related to any Patent-in-Suit.

23. The facts and circumstances surrounding any alleged objective considerations of non-obviousness, including any alleged commercial success, long felt but unsolved need, unexpected results, expressions of disbelief by experts, copying by others, and/or failure of others relating to the claimed inventions of the Patents-in-Suit, including all facts and evidence upon which IBM may rely to prove any objective considerations of non-obviousness relating to the Patents-in-Suit, and the factual basis for any purported nexus between such objective considerations and the Patents-in-Suit.

24. IBM's practices, considerations, and factors in evaluating third parties' or competitors' products, including but not limited to how IBM determines whether such products infringe any claim of the Patents-in-Suit.

25. The negotiation, drafting, due diligence for, interpretation, execution, scope, construction, enforceability, application and performance of the Facebook License, Apple License, and Google License.

26. Any non-privileged analysis, and communications concerning whether the use of Facebook's, Apple's, or Google's authentication services by a third party app or website to authenticate a user and to create a user account is licensed under the Facebook License, Apple License, or Google License, respectively.

27. All business plans, strategic plans, marketing plans, financial plans, sales plans, third-party market research utilized by IBM, and any other analysis of market demand, market share, market segments, or competition and the existence, location, and substance of documents concerning the Patents-in-Suit.

28. IBM's strategy, meetings, board meetings, agendas, and planning sessions relating to its enforcement, licensing, or other monetization of the Patents-in-Suit.

29. Whether IBM combined any other products or services with any commercial embodiment of the '234 Patent.

30. Whether IBM combined any other products or services with any commercial embodiment of the '346 Patent.

31. Whether IBM combined any other products or services with any commercial embodiment of the '719 Patent.

32. All facts supporting IBM's contentions that it is entitled to any monetary damages in this Action, including but not limited to the alleged factual

support for IBM's assertion that it is entitled to a reasonable royalty, the amount of that royalty, the revenue or royalty base, and any apportionment thereof.

33. Any patent, technology, or intellectual property license agreements that IBM contends are reasonably comparable in technological subject matter to the alleged inventions of the Patents-in-Suit, and the royalty rates provided for in any such agreements.

34. IBM's damages claims and analysis in other cases asserting any of the Patents-in-Suit, including all reasonably royalty rates proposed or agreed upon by IBM in those cases.

35. The existence and location of documents responsive to Carvana's document requests, IBM's efforts to collect and produce documents and materials responsive to those requests, and from which sources and custodians documents were collected.

36. IBM's responses to Carvana's interrogatories.

37. The facts and circumstances relating to IBM's decision to add infringement allegations to its Amended Counterclaims regarding the '719 Patent on April 3, 2024. (*See* Dkt. No. 63).

38. The facts and circumstances that support or refute IBM's contention that Carvana willfully infringes the Patents-in-Suit and that enhanced damages should be awarded, including but not limited to IBM's knowledge of all prior and

current challenges to the validity of the Patents-in-Suit before the USPTO, PTAB (e.g., IPRs and *ex parte* reexaminations), or a federal court.

39. The facts and circumstances that support or refute IBM's contention that this is an exceptional case.

40. The facts and circumstances that support or refute IBM's contention that IBM is entitled to injunctive relief.

CERTIFICATE OF SERVICE

I hereby certify that on July 12, 2024, a true and correct copy of **PLAINTIFF
CARVANA, LLC'S RULE 30(B)(6) NOTICE OF DEPOSITION OF
DEFENDANT INTERNATIONAL BUSINESS MACHINES CORPORATION**
was served via electronic mail, pursuant to the parties' agreement, to the following
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