

IN THE UNITED STATES DISTRICT COURT  
DISTRICT OF COLUMBIA

IN RE THIRD PARTY SUBPOENAS AD  
TESTIFICANDUM

Case No. \_\_\_\_\_

Nokia Corporation,

Plaintiff,

v.

Apple Inc.,

Defendant.

Case No. District of Delaware  
Civil Action No. 1:09-cv-00791- GMS

**NONPARTIES' MOTION TO QUASH NOKIA SUBPOENAS AND FOR A  
PROTECTIVE ORDER**

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***I. Introduction***

Robert Greene Sterne, Glenn Perry, Rich Coller, and Salvador Bezos, of the law firm Sterne, Kessler, Goldstein & Fox P.L.L.C., (collectively, the “Apple Attorneys”) move this Court to quash deposition subpoenas<sup>1</sup> served on them by Nokia and to enter a protective order, pursuant to Rule 26(c) of the Federal Rules of Civil Procedure, barring Nokia from further attempts to discover information through the Apple Attorneys. This motion is necessary because Nokia has subpoenaed the Apple Attorneys who are representing Apple in connection with the very patents Apple has asserted against Nokia in the underlying litigation, pending in the District Court for Delaware. The law prohibits a party from deposing its opponent’s lawyer if the information it seeks to obtain is available through another source, and the information Nokia is attempting to discover is available through other, non-attorney sources. Nokia has not attempted to obtain the information through those sources and instead made its first and only attempt to discover this information through the Apple Attorneys. And the information Nokia is seeking to discover through the Apple Attorneys is irrelevant and largely protected from disclosure by privilege. The Court should quash the subpoenas and issue a protective order.

***II. Background and Summary of Argument***

Nokia sued Apple for patent infringement in the U.S. District Court for the District of Delaware. *See Nokia Corporation v. Apple Inc.*, Civil Action No. 1:09-cv-00791-GMS. Apple counterclaimed asserting that Nokia infringed nine of its patents. On April 28, 2010, an attorney

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<sup>1</sup> The subpoenas are attached here as Exhibits 1-4. These subpoenas also sought the production of documents from the Apple Attorneys. All responsive, nonprivileged documents have been produced.

from Brient IP Law filed *ex parte* reexamination requests on behalf of an anonymous requester against all nine patents that Apple asserted in counterclaims against Nokia.

Nokia served deposition subpoenas on all of the Apple Attorneys, each of whom represent Apple Inc. in the reexaminations of six of the nine the patents Apple asserted against Nokia in the underlying litigation.<sup>2</sup> Four of these reexaminations are on-going, including one reexamination which is still in the early stages of prosecution.<sup>3</sup> The Apple Attorneys' prosecution of these patent reexaminations is closely tied to the issues in the underlying litigation because the basis of the validity challenges to the patents are largely the same in both. A patent reexamination is a challenge to the patentability of a patent before the United States Patent and Trademark Office (the "Office"). Because patent reexaminations provide accused patent infringers two bites at the invalidity apple—one in the District Court and the other at the Office—defendants often request patent reexaminations of the patents-in-suit as a defense tactic in patent litigations. This case is no different. Although the reexaminations handled by the Apple Attorneys were anonymously requested, the evidence shows that Nokia likely requested the reexaminations of the patents Apple asserted against Nokia as Nokia is the only counter-claim defendant for these patents.

The Court should quash these subpoenas and enter a protective order barring the depositions. Nokia may depose the Apple Attorneys only if it can show (1) the information it

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<sup>2</sup> Those reexaminations are (1) Control No. 90/010,964, involving U.S. Patent No. 5,634,074; (2) Control No. 90/010,967, involving U.S. Patent No. 5,315,703; (3) Control No. 90/010,965, involving U.S. Patent No. 5,455,854; (4) Control No. 90/010,966, involving U.S. Patent No. 6,239,795; (5) Control No. 90/010,970, involving U.S. Patent No. 6,189,034; and (6) Control No. 90/010,969, involving U.S. Patent No. 7,383,453.

<sup>3</sup> In three of the four pending reexaminations, the Reexam Certificate has not issued although the Notice of Intent to Issue a Reexam Certificate has been mailed. Control Nos. 90/010,964; 90/010,967; and 90/010,969.

seeks can only be obtained by deposing the Apple Attorneys; (2) the information it seeks by deposing the Apple Attorneys is both relevant and nonprivileged; and (3) the information it seeks is crucial to the case. Nokia cannot satisfy any of these elements.

First, the prosecution of these reexaminations was done on the written record that is found in the file histories of each reexamination. This written record includes the substance of the in-person interviews held in each of the reexaminations—both the examiner and Apple submitted a written interview summary for each interview conducted in these reexaminations. And, even assuming that this written record of the interviews was insufficient, Nokia can still discover the substance of the interviews by deposing the examiner or inventors, who were also present at the interviews. Nokia has also subpoenaed documents from the Apple Attorneys. In response to those document subpoenas, the Apple Attorneys have provided all requested prior art present in their files of these reexaminations.

Second, the only other information that Nokia seeks to discover from the Apple Attorneys is protected from disclosure by the attorney–client privilege or the work-product doctrine. The only non-privileged information known by these attorneys is already in the public domain in the file histories of the patents-in-suit and the file histories of the reexaminations. The reason for that is simple: all prosecution of these patents is done on the written record. 37 C.F.R. § 1.2. The remaining communications and information, such as Apple Attorneys’ client communications, internal communications, and mental impressions, are protected from disclosure.

Third, any information outside the file histories of the patents in reexamination is not relevant, let alone crucial, to this suit. Those file histories contain the complete record of the Office’s determination as to the patentability of those patents. And, because Nokia has not

alleged inequitable conduct in this case, the mental impressions of the Apple Attorneys are not relevant and would be protected as attorney-work product in any event. Indeed, Nokia has never explained why the information it seeks is relevant to any claim or defense in this suit. The only issue that Nokia has articulated as being nonprivileged is the substance of the interviews conducted by the Apple Attorneys with the Office during the reexaminations of the patents-in-suit, but Nokia has never explained why it needs any more than the interview summaries that are publicly available.

Counsel for the Apple Attorneys objected to the subpoenas and explained to Nokia's counsel in follow-up communications that Nokia was not entitled to take the depositions.<sup>4</sup> The Apple Attorneys also advised that the deposition dates noticed in the subpoenas conflicted with each Apple Attorney's calendar and they could not appear on the noticed dates in any event. Nevertheless, counsel for the Apple Attorneys attempted a compromise on acceptable deposition topics with Nokia's counsel.<sup>5</sup> Hoping to avoid filing this motion, counsel for the Apple Attorneys suggested that Nokia narrow the scope of the information on which it wanted to conduct depositions and proposed that the parties proceed under Rule 30(b)(6), so that agreeable deposition topics could be identified in advance of any deposition. Because Nokia refused these suggestions and did not narrow the scope of its subpoenas, the Apple Attorneys and Nokia did not identify new dates for the depositions that did not conflict with the Apple Attorney's schedules.<sup>6</sup>

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<sup>4</sup> See Letter from Byron Pickard, Apple Attorneys' counsel, to Rohan Kale, Nokia's counsel (April 8, 2011), attached hereto as Exhibit 5.

<sup>5</sup> See *id.*

<sup>6</sup> See Emails between Rohan Kale, Nokia's counsel, and Byron Pickard, Apple Attorneys' counsel, attached hereto as Exhibits 6 & 7.

### **III. Legal Argument**

The Subpoenas should be quashed and a protective order should be entered because the depositions sought are neither appropriate nor necessary. Although parties may obtain discovery regarding any nonprivileged matter that is relevant to a party's claim or defense, courts have discretion to limit the scope of discovery when it is cumulative or can be obtained from other more convenient, less burdensome, or less expensive sources. Fed. R. Civ. P. 26(b)(1)-(2). The Court may also limit discovery "for good cause" and "issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense," including "forbidding the discovery." Fed. R. Civ. P. 26(c)(1).

Deposing an opposing party's attorney is disfavored. *See, e.g., Shelton v. Am. Motors Corp.*, 805 F.2d 1323, 1327 (8th Cir. 1986); *Evans v. Atwood*, No. CIV.A. 96-2746, 1999 WL 1032811, at \*2 (D.D.C. Sept. 29, 1999) ("[A] party seeking to depose its adversary's counsel must demonstrate the propriety of and need for such a deposition."); *Corp. for Public Broad. v. Am. Auto. Centennial Comm'n*, No. 1:97CV01810, 1999 WL 1815561, at \*1 (D.D.C. Feb. 2, 1999). The D.C. Circuit has not addressed what standard should be applied for depositions of attorneys representing a party in reexaminations that are concurrent with a pending litigation, but the standard for deposing opposing party's counsel as articulated by the Eighth Circuit in *Shelton v. American Motors Corp.* should be applied in this case and has been favorably applied or cited by this Court in deciding similar issues. *See, e.g., Corp. for Public Broad.*, 1999 WL 1815561, at \*1; *Evans*, 1999 WL 1032811, at \*3; *but see United States v. Philip Morris Inc.*, No. Civ. A. 99-2496, 209 F.R.D. 13, 16-18 (D.D.C. Aug. 23, 2002) (limiting the application of the *Shelton* factors to trial and litigation counsel or where there was a risk of exposing litigation strategy).

**A. *The Shelton Standard for Deposing Opposing Party's Counsel Applies Because the Apple Attorneys Are Dealing with Invalidity Challenges in the Pending Reexaminations That Are Also at Issue in the Litigation***

The *Shelton* standard limits depositions of opposing party's counsel to situations where (1) the party seeking the deposition can only obtain the information by deposing the opposing party's counsel; (2) the information sought is relevant and nonprivileged; and (3) the information is crucial to the case. *Philip Morris*, 203 F.R.D. at 15 (citing *Shelton*, 805 F.2d at 1327).

The *Shelton* standard does not apply to all depositions of the opposing party's counsel. See *Philip Morris*, 209 F.R.D. at 15-18. In *Philip Morris*, this Court noted that "*Shelton* was not intended to provide heightened protection to attorneys who represented a client in a *completed case* and then also happened to represent that same client in a pending case where the information *known only* by the attorneys regarding the prior concluded case was crucial." *Id.* at 17 (quoting *Pamida, Inc. v. E.S. Originals, Inc.*, 281 F.3d 726, 730-31 (8th Cir. 2002)). The *Philip Morris* court concluded that *Shelton* should be limited to depositions of trial counsel or counsel directly representing the party in the pending litigation and when the deposition would reveal litigation strategy in the pending case. *Id.* at \*18.

Here, the Apple Attorneys directly represent Apple in four reexaminations that are ongoing and have not concluded. These reexaminations are an extension of the underlying litigation and were likely initiated by Nokia. The harm to Apple from having its reexamination counsel deposed is no less harmful than if the Apple Attorneys were litigation counsel in the underlying litigation. Similar to Apple's litigation counsel in the underlying litigation, the Apple Attorneys advocate the validity of the patents-in-suit, except before the Office instead of the Court. Many of the same validity issues raised during the reexaminations will be raised in the underlying litigation. Effective prosecution of the reexaminations is an essential component to



the underlying litigation; if the patent is ultimately determined to be invalid, Apple cannot assert that patent against any infringer, including Nokia.

Because the validity issues raised by patent reexaminations are largely the same as those in the underlying litigation, Nokia will likely encounter issues common to the litigation during the depositions of the Apple Attorneys, which could impermissibly allow Nokia to inquire into Apple's strategies regarding its patents. *See Philip Morris*, 209 F.R.D. at 17-18 ("The animating concern of *Shelton* is that discovery rules must not be used-or abused-to 'enable a learned profession to perform its functions . . . on wits borrowed from the adversary.'").

Further, the Apple Attorneys are not the only source of any nonprivileged information Nokia seeks. Such information is available through non-attorney witnesses, for example, the examiners and the inventors, and from publically available sources such as the patent file wrappers as further discussed below.

Thus, deposing the Apple Attorneys would result in the same kind of harassment and prejudice as would result from deposing Apple's litigation counsel, and thus the *Shelton* standard should apply in this case. Applying the *Shelton* standard, the Subpoenas seeking the depositions of the Apple Attorneys should be quashed and a protective order should be entered. The information Nokia seeks can be obtained from other sources, the information Nokia seeks is largely privileged and irrelevant, and the information is not crucial to any issue in this case.

***B. All Nonprivileged Information That Nokia Seeks Can Be Obtained from Other More-Accessible and Less-Burdensome Sources***

Under the *Shelton* standard, the party seeking to depose counsel first must show that the information cannot be obtained through other sources. *Shelton*, 805 F.2d at 1327. Nokia cannot make that showing because everything relevant to the reexamination of the patents-in-suit is

contained the publicly available file wrappers. Under the Patent Office's rules, all business with the Patent Office must be conducted in writing. 37 C.F.R. § 1.2. This requirement is significant; everything relevant to patentability in these reexaminations must be and is in the file histories for these patents. *See* 37 C.F.R. § 1.2 ("The action of the Patent and Trademark Office will be based exclusively on the written record in the Office."); M.P.E.P § 2281.

The requirement that prosecution proceed on the written record applies to the interviews as well. The Office cannot conduct business in writing as required under 37 C.F.R. § 1.2 regarding oral interviews unless the Office keeps records of the substance of the interviews. M.P.E.P. § 713.04 ("The action of the U.S. Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews."). First, the Examiners must, and in these reexaminations have, complete interview summaries identifying the substance discussed during the interviews. M.P.E.P § 713.04; *Ex Parte* Reexamination Interview Summaries, attached hereto as Exhibits 8-11.<sup>7</sup> There is a similar requirement for the patent owner to submit an interview summary, which Apple has filed in each of these cases. 37 C.F.R. § 1.560(b); Statements of Substance of the Interviews, attached hereto as Exhibits 12-15. Further, the Examiners must ensure that the patent owner's statements of substance of the interview are accurate, M.P.E.P. § 713.04, and the Examiners have not objected to or corrected the content of Apple's statements of substance of the interviews in any of the reexaminations. In addition to the interview summary, the file wrappers in the Reexamination also contain the detailed slide

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<sup>7</sup> Interviews have not been conducted for reexaminations Control Nos. 90/010,969 and 90/010,970.

presentations, attached hereto as Exhibits 16-19, that were used during the interviews. And most significantly, each interview was followed by Apple's written Responses to the Office actions, and it was these submissions to the Office that constitute Apple's official, formal response to the rejections raised by the Office in these reexaminations. 37 C.F.R. § 1.560(b) ("An interview does not remove the necessity for response to Office actions as specified in § 1.111.").

Second, even assuming this written evidence of the interviews were insufficient, Nokia can depose several non-attorneys who were present at the interviews, including the examiners and the inventors, but Nokia has not done this.

In short, all nonprivileged information Nokia may contend it needs concerning the reexaminations is already available in the file wrappers or through non-attorney witnesses. Under the Shelton standard, Nokia is not entitled to depose the Apple Attorneys.

***C. The Information Nokia Seeks Is Neither Relevant Nor Crucial***

To depose an opposing party's counsel, the information sought must be both relevant and crucial to the case. *Shelton*, 805 F.2d at 1327. Here, the information Nokia seeks to obtain from the Apple Attorneys that is not already in the file wrappers of the patents is not relevant and, thus, not crucial to Nokia's case.

Nokia has not pled any inequitable-conduct defense in this case, so the mental impressions of the Apple Attorneys are not relevant. *See, e.g., ResQNet.com, Inc. v. Lansa, Inc.*, No. 01 Civ. 3578, 2004 WL 1627170, at \*4 (S.D.N.Y. July 1, 2004) (finding that when the plaintiff had not pled inequitable conduct and even alleged the prior art was concealed, the plaintiff was not entitled to oppose plaintiff's counsel on the topic of inequitable conduct).

Indeed, the only area of inquiry that Nokia attorneys could identify as possibly relevant and nonprivileged on which it wished to depose the Apple Attorneys was the communications between the Apple Attorneys and the Office, including the substance of the in-person interviews.

As explained above, that information is already available through other sources, and any information relevant to patentability is found in the file wrapper of the patents. Thus, because Nokia has failed to identify any relevant topics, much less crucial topics, depositions of the Apple Attorneys in the reexaminations are not appropriate under the *Shelton* standard.

***D. Nokia Will Encounter Privileged Information by Deposing the Apple Attorneys***

Under the *Shelton* standard, a deposition of an opposing party's counsel is appropriate only when the information sought is nonprivileged. *Shelton*, 805 F.2d at 1327. There is a high likelihood that Nokia will encounter privileged information if it deposes the Apple Attorneys. Aside from the items in the file histories of the patents, nearly everything known by the Apple Attorneys is protected by attorney-client privilege or the work-product doctrine. For example, internal attorney-to-attorney discussions, draft papers, attorney's mental impressions about the patents and the prior art, and communications with the client are all clearly protected from disclosure. Nokia will learn little, if any, information about the reexaminations through the Apple Attorneys without running afoul of the attorney-client privilege or the work-product limits on disclosure.

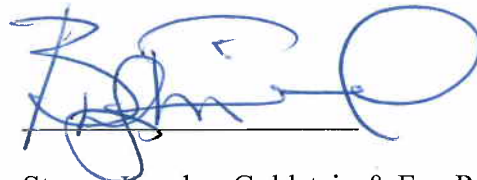
In sum, Nokia will encounter privileged information if it deposes Apple's Counsel in the reexaminations, and thus such depositions are not appropriate.

***IV. Conclusion***

For the foregoing reasons, it is respectfully requested that this Court quash the deposition subpoenas of the Apples Attorneys and issue a protective order forbidding Nokia from deposing the Apple Attorneys.

Dated: May 17, 2011

Respectfully Submitted,

A handwritten signature in blue ink, appearing to be "David K.S. Cornwell", written over a horizontal line.

Sterne, Kessler, Goldstein & Fox P.L.L.C.  
David K.S. Cornwell (Bar ID: 431216)  
Byron L. Pickard (Bar ID: 499545)  
1100 New York Avenue, N.W.  
Washington, DC 20005  
202.371.2600  
dcornwell@skgf.com  
bpickard@skgf.com

Counsel for Apple Attorneys

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**Order**

AND NOW, this \_\_\_\_ day of \_\_\_\_\_, 20\_\_\_\_, upon consideration of  
Nonparties' Motion to Quash Nokia Subpoenas and for Protective Order, it is hereby

ORDERED, that the Nonparties' Motion to Quash Nokia Subpoenas and for Protective  
Order is GRANTED.

SO ORDERED.

\_\_\_\_\_  
United States District Judge