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5 IN THE UNITED STATES DISTRICT COURT  
6 FOR THE NORTHERN DISTRICT OF CALIFORNIA  
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8 KEVIN L. KEITHLEY,

No. C-03-04447 SI (EDL)

9 Plaintiff,

**ORDER RE: ORDER ON DEFENDANTS'  
SECOND MOTION TO COMPEL  
DOCUMENTS WITHHELD OF BASIS  
OF PRIVILEGE AND WORK PRODUCT  
IMMUNITY AND PLAINTIFFS'  
MOTION FOR PROTECTIVE ORDER**

10 v.

11 HOMESTORE.COM, INC., et al,

12 Defendants.  
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14 On August 26, 2008, the Court held a hearing on Defendants' Motion to Compel Production  
15 of Documents Withheld on Basis of Privilege and Work Product Immunity and Plaintiffs' Motion  
16 for Protective Order. The Court ordered the parties to file a proposed order reflecting the Court's  
17 rulings from the bench. The parties filed the proposed order on September 12, 2008 and the Court  
18 entered it on September 16, 2008. The Court issues this Order to further explain its ruling with  
19 respect to the PatentBridge documents.

20 In response to Defendants' subpoena, PatentBridge produced numerous potentially  
21 privileged documents, including the '025 file wrapper, the pleadings in this case and Mr. Keithley's  
22 own files regarding prosecution and reexamination, that Mr. Keithley had years earlier given  
23 directly to PatentBridge. Defendants argued that Plaintiffs waived any attorney-client privilege with  
24 respect to those documents and urged a broad construction of that waiver.

25 The question was whether the documents are protected by the attorney-client privilege, and if  
26 so, whether the privilege was waived and the scope of that waiver. At his July 24, 2008 deposition,  
27 Plaintiff Kevin Keithley testified that he did not recall how he came to find, contact or meet Mr.  
28 Holmes, the Chief Executive Officer of PatentBridge, who is an attorney. See Rose Decl. Ex. 4 at  
360. Mr. Keithley also testified that he did not recall if Mr. Holmes ever told him that Mr. Holmes

1 was acting as his attorney, and that Mr. Keithley did not recall if he ever asked Mr. Holmes to be his  
2 attorney. Id. at 361. Mr. Keithley testified that he believed it to be true that he sought to engage Mr.  
3 Holmes to help in licensing the '025 patent, but that he did not recall the outcome of any licensing  
4 efforts. Id. at 363-64. Mr. Keithley did not recall turning over any documents to Mr. Holmes. Id. at  
5 364, 374.

6 By contrast, in his August 1, 2008 declaration in connection with this motion, Mr. Keithley  
7 stated that he approached Mr. Holmes with the "specific intention of seeking legal advice regarding  
8 the licensing" of his patent. See Keithley Decl. ¶ 3. Mr. Keithley believed that at all times during  
9 his discussions with Mr. Holmes that Mr. Holmes was providing legal advice to Me. Keithley. Id.  
10 Me. Keithley declared that he gave to Mr. Holmes a copy of the '025 patent file wrapper, the  
11 pleadings in this case and documents from his files regarding prosecution and reexamination,  
12 believing that the documents would be protected by the attorney-client privilege. Id. ¶ 4.

13 Mr. Holmes stated in his declaration that his company provides patent brokerage services,  
14 acting as a business representative for holders of patents. See Rose Decl. Ex. 5 ¶ 6. Patentbridge is  
15 not a law firm and, even though Mr. Holmes is a patent agent and attorney, PatentBridge does not  
16 provide legal services or advice, which it communicates to all new and potential customers. Id. ¶¶ 7,  
17 8. He stated that Mr. Keithley approached Mr. Holmes to identify revenue sources for his patent.  
18 Id. ¶ 12. Mr. Keithley provided documents in May 2006, and Mr. Holmes did not obtain documents  
19 about the patent from any other source. Id. ¶ 14. Mr. Keithley and PatentBridge did not enter into a  
20 business relationship, and Mr. Keithley never asked for his documents to be returned. Id. ¶¶ 16-17.  
21 PatentBridge did not render and was not asked to render legal advice and did not act as Mr.  
22 Keithley's law firm. Id. ¶ 19.

23 Plaintiffs argued that Mr. Keithley's merely subjective belief that he was in an attorney-  
24 client relationship with Mr. Holmes, without an objective basis therefore, controlled the application  
25 of the attorney-client privilege, but Plaintiffs have provided no binding or persuasive authority, and  
26 the Court can find none, to that effect. Moreover, the fact that Mr. Keithley's memory was so  
27 detailed only days after his deposition did not give the Court confidence that Mr. Keithley's  
28 subjective beliefs were reasonable.

22           Plaintiffs further argued that Defendants failed to meet and confer on this issue prior to filing  
23           their motion to compel. However, given the seriousness of the waiver issue, the Court declined to  
24           base its ruling on the alleged failure to meet and confer.

25     **IT IS SO ORDERED.**

26 Dated: September 17, 2008

*Elizabeth D. Laporte*  
ELIZABETH D. LAPORTE  
United States Magistrate Judge