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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

OAKLAND DIVISION

ORACLE USA, INC., et al.,

Plaintiffs,

v.

SAP AG, et al.,

Defendants.

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

**DEFENDANTS' OPPOSITION TO
ORACLE'S MOTION TO MODIFY
THE PROTECTIVE ORDER AND TO
COMPEL DEPOSITION TESTIMONY
AND FURTHER RESPONSES TO
REQUESTS FOR ADMISSION**

Date: January 26, 2010; Time: 9:00 am
Courtroom: E, 15th Floor
Judge: Hon. Elizabeth D. Laporte

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1 For the following reasons, Oracle’s Motion to Modify the Protective Order and to Compel
2 Deposition Testimony and Further Responses to Requests for Admissions (“Motion” or “Mot.”)
3 should be denied.

4 **I. UNDER THE PROPER STANDARD FOR EXPORTING U.S. DISCOVERY,**
5 **ORACLE’S MOTION TO MODIFY SHOULD BE DENIED.**

6 Oracle’s request that the Court modify the protective order to permit use of Defendants’
7 confidential business information in some unspecified and, as yet, un-filed litigation outside the
8 United States should be denied. Oracle’s Motion is based on cases modifying a protective order
9 to allow discovery to be used in another U.S. jurisdiction, see Mot. at 5-6, when the authority that
10 actually governs exportation of U.S. discovery for use in foreign litigation is 28 U.S.C. § 1782
11 (“Section 1782”). In a seminal decision, the Supreme Court defined the statutory prerequisites of
12 Section 1782 and set forth discretionary factors for courts to consider when deciding whether to
13 grant such a request. See *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 264-65
14 (2004) (“Intel”). Oracle fails to mention, let alone apply, the proper analytical framework
15 discussed in *Intel*. When the proper analysis is applied, it is evident that Oracle has not met the
16 threshold requirement that the foreign proceeding be “within reasonable contemplation.”

17 Further, because Oracle has not identified any specifics about its proposed foreign
18 litigation, it is impossible to evaluate the remaining discretionary factors under *Intel* or the risk
19 that Defendants’ confidential information will not be adequately protected if the motion is granted.
20 This concern is especially great because Oracle wants to send the confidential information outside
21 the United States where it is beyond this Court’s jurisdiction to enforce compliance with its orders.

22 Finally, not only is the authority on which Oracle relies inapposite, none of the cases cited
23 by Oracle permit the broad, unfettered release of confidential information that Oracle seeks.
24 Indeed, in the cited cases, the courts imposed restrictions upon the use of the discovery. Thus,
25 even under Oracle’s own authorities, such a broad modification is not permitted.

26 **A. Oracle’s Request to Modify the Protective Order does not Satisfy the**
27 **Threshold Requirements Under Section 1782.**

28 Section 1782 and the discretionary factors set forth in the *Intel* case govern this Court’s

1 consideration of Oracle’s request to modify the protective order, not the inapposite authority
2 Oracle cites. Section 1782 contains three threshold requirements for obtaining discovery to assist
3 in foreign litigation: (a) that the discovery is found in the district where the application is made;
4 (b) that the information sought is “for use in a proceeding in a foreign or international tribunal”;
5 and (c) that the petitioner is an “interested person” in the foreign proceeding. 28 U.S.C. § 1782.

6 To satisfy the second requirement, the foreign proceeding need not be pending, but it must
7 be “within reasonable contemplation.” *Intel*, 542 U.S. at 259. Since *Intel*, courts have had little
8 opportunity to clarify the meaning of “reasonable contemplation” because, unlike this case, in the
9 vast majority of Section 1782 cases, the foreign proceeding has actually been initiated. *See In re*
10 *Intel Corp. Microprocessor Antitrust Litig.*, No. 05-17171-JJF, 2008 WL 4861544, at *12 (D. Del.
11 Nov. 7, 2008). However, in *Crown Prosecution*—the case approved by the Supreme Court in
12 *Intel*—the D.C. Circuit considered the meaning of “reasonable contemplation” and concluded that
13 it turned on whether there was “sufficient indication that a proceeding in court would eventuate in
14 which the evidence gathered could be weighed impartially.” *In re Letter of Request from Crown*
15 *Prosecution Service*, 870 F.2d 686, 691 (D.C. Cir. 1989). The court emphasized, however, that to
16 guard against abuse of Section 1782, the district court must insist on reliable indications of the
17 likelihood that proceedings will be instituted within a reasonable time. *See id.* at 692.

18 Here, Oracle has provided no reliable indications that a foreign proceeding will be
19 instituted within a reasonable time. Indeed, Oracle has not even asserted that it will file a foreign
20 case; nor has it indicated when or where such a case might be filed. Instead, Oracle vaguely
21 states that it “*may* assert [claims] against Defendants in Europe.” Mot. at 2 (emphasis added).
22 Oracle’s noncommittal speculations fall well short of establishing that a foreign proceeding will
23 be instituted within a reasonable time.

24 This case is much like *Intel Corp. Microprocessor Antitrust Litigation*. *See* 2008 WL
25 4861544, at *12. In that case, a French consumer advocacy group (“QC”) sought discovery under
26 Section 1782, arguing that it intended to bring some foreign litigation somewhere against AMD
27 and Intel. Following the analysis in *Crown Prosecution*, the special master concluded that QC’s
28 proposed litigation was not “within reasonable contemplation.” Just as in this case, QC had “not

1 provided even the barest of ‘reliable indicators’ that any proceeding can or will be instituted
2 within a reasonable period.” *Id.*; see also *In re Babcock Borsig AG*, 583 F. Supp. 2d 233, 240 (D.
3 Mass. 2008) (denying Section 1782 request because, *inter alia*, the petitioner had not yet
4 instituted arbitration proceedings in the foreign venue). Oracle’s assertions that it might bring a
5 foreign action are insufficient and do not justify the modification sought.

6 **B. There is not Sufficient Information to Evaluate Oracle’s Request.**

7 Even had Oracle satisfied Section 1782’s statutory requirements—and it has not—the
8 district court is not required to grant Oracle’s request. See *Intel*, 542 U.S. at 264 (“[A] district
9 court is not required to grant a § 1782(a) discovery application simply because it has the authority
10 to do so.”). To assist lower courts exercise their discretion, *Intel* identified four factors to
11 consider when determining whether discovery should proceed under Section 1782: (1) whether
12 the producing party is a participant in the foreign proceeding; (2) whether the foreign tribunal
13 would be receptive to U.S. federal-court judicial assistance; (3) whether the request conceals an
14 attempt to circumvent foreign proof-gathering restrictions or other policies of a foreign country or
15 the United States; and (4) the burden to the producing party. See *id.* at 264-65.

16 The suggested *Intel* factors are not an exhaustive list of issues a court should consider
17 when exercising its discretion. See *id.* at 247 (characterizing the discretionary factors as
18 suggested considerations). Indeed, the Supreme Court noted that there may be other issues that
19 bear consideration. For example, the district court may impose conditions or restrictions as it
20 deems appropriate. See *id.* at 260-61. The district court may also need to consider international
21 comity and parity among the parties as they “may be important as touchstones for a district
22 court’s exercise of discretion in particular cases.” *Id.* at 261.

23 Oracle’s failure to initiate a foreign proceeding, or at least disclose the details of its
24 proposed foreign litigation, before requesting modification of the protective order makes it
25 impossible for the Court to exercise its discretion under Section 1782. For example, the second
26 *Intel* factor considers whether the foreign forum would be receptive to the discovery sought by
27 Oracle. Some foreign jurisdictions object to the use of U.S. discovery. See, e.g., *Schmitz v.*
28 *Bernstein Liebhard & Lifshitz, LLP*, 376 F.3d 79, 84-85 (2d Cir. 2004) (denying Section 1782

1 request because German government was “obviously unreceptive to the judicial assistance of an
2 American federal court”); *In re Application of Microsoft Corp.*, 428 F. Supp. 2d 188, 194
3 (S.D.N.Y. 2006) (denying request because European Commission stated it opposed the discovery
4 sought by Microsoft, and it was not receptive to U.S. judicial assistance). Moreover, this factor
5 cannot be analyzed because Oracle has not disclosed where it intends to file suit.

6 For the same reason, the third *Intel* factor, which considers whether Oracle’s request
7 would circumvent foreign proof-gathering restrictions, cannot be evaluated. Without knowing
8 what forum Oracle will choose, Defendants and the Court cannot even begin to identify whether
9 any foreign proof-gathering restrictions may be implicated.

10 Further, the risk that Defendants’ confidential business information will be improperly
11 disclosed warrants denying Oracle’s request to modify the protective order. Oracle claims that
12 the proposed modification “simply alters the permitted uses of Discovery Material to cover
13 European litigation while preserving all other restrictions on use and disclosure that are in the
14 protective order as it exists now.” Mot. at 9. Oracle’s proposal is not so simple. If its request is
15 granted, Oracle could send Defendants’ confidential business information outside the country to
16 be used as it deems fit, for any purpose related to its nebulous “European litigation.” Oracle
17 proposes no limits on the use of this information and offers no proposal to give Defendants
18 advance notice of its intent to use specific documents.¹ Indeed, Oracle’s request is tantamount to
19 a blank check. Because Oracle has not identified the forum in which it intends to bring suit, this
20 Court cannot fully consider the risk that Defendants’ confidential information may be improperly
21 disclosed. However, one thing is certain: once the documents leave the country, they will be
22 beyond this Court’s reach to enforce the terms of the protective order. Defendants’ legitimate
23 concern over the disclosure of their confidential information in Oracle’s as-yet-unidentified
24 European forum justifies denying Oracle’s proposed modification of the protective order.

25
26 ¹ Defendants strongly oppose Oracle’s request to modify the protective order. If, however,
27 this Court decides to modify the protective order, such modifications should include, at a
28 minimum, a provision requiring Oracle to give Defendants at least five business days’ advance
notice before any documents are used for the proposed foreign litigation to allow Defendants an
opportunity to file a motion challenging Oracle’s proposed use of the documents overseas.

1 **C. The Authority Cited by Oracle is Inapposite.**

2 Oracle's reliance on *Foltz*, *CBS Interactive*, *DRAM Antitrust Litigation*, and *Verizon* is
3 misplaced. In each of these cases, the movant sought to modify a protective order to allow U.S.
4 discovery for use in another U.S. litigation.² Only one case Oracle cites, *In re Jenoptik AG*,
5 involved a request to modify a protective order so that U.S. discovery could be used in a foreign
6 proceeding. See 109 F.3d 721, 722 (Fed. Cir. 1997). However, *Jenoptik* was decided in 1997,
7 years before the *Intel* court ruled on the scope of federal district court authority to assist litigants
8 in using U.S. evidence in a foreign tribunal. See *Intel*, 542 U.S. at 246. In determining whether
9 to provide assistance to foreign litigants, courts should now apply the guidelines set forth in *Intel*.
10 *Jenoptik*, a pre-*Intel* Federal Circuit case, is not binding on this Court, and to the extent *Jenoptik*
11 conflicts with *Intel*, *Intel* controls.

12 Any attempt by Oracle to argue that *Intel*, which involved a petition to obtain discovery,
13 does not apply to requests to modify a protective order (the issue in *Jenoptik*) should be rejected.
14 This is a distinction without a difference. It makes no logical sense to use one set of factors to
15 decide a petition to obtain discovery for use overseas and a different set of factors to modify a
16 protective order to allow discovery already in hand to be used overseas. The result is the same: if
17 the request is granted, discovery obtained in the U.S. will be sent outside the U.S. to assist foreign
18 litigants. And because this confidential information is being sent to locations outside the
19 protective reach of the U.S. courts, a proper analysis under *Intel* fully considers the possible
20 ramifications *before* the use is permitted overseas.

21 **D. The Cases Cited by Oracle Dictate Denying the Proposed Modification.**

22 Not only are the cases cited by Oracle inapposite, none of them permit the broad,
23 unfettered release of confidential information that Oracle seeks. In *Foltz*, the Ninth Circuit

24 _____
25 ² See *Foltz v. State Farm Mut. Auto. Ins. Co.*, 331 F.3d 1122, 1127 (9th Cir. 2003)
26 (seeking discovery from federal case for use in state court action); *CBS Interactive, Inc. v. Etalize,*
27 *Inc.*, 257 F.R.D. 195, 200 (N.D. Cal. 2009) (same); *In re Dynamic Random Access Memory*
28 *(DRAM) Antitrust Litig.*, No. M 02-1486 PJH, 2008 WL 4191780, at *1 (N.D. Cal. Sept. 10, 2008)
(seeking discovery from federal antitrust case for use in federal securities actions); *Verizon*
California Inc. v. Ronald A. Katz Tech. Licensing, L.P., 214 F.R.D. 583, 584 (C.D. Cal. 2003)
(seeking discovery from patent infringement suit in California for use in patent infringement suit
in Pennsylvania).

1 explained that a showing of relevance is required before a protective order can be modified to
2 “prevent[] collateral litigants from gaining access to discovery materials merely to subvert
3 limitations on discovery in another proceeding.” 331 F.3d at 1132. As with the *Intel* factors, this
4 Court cannot determine whether Oracle’s proposed use would subvert limitations on discovery in
5 the foreign forum because Oracle has not yet identified the location of that forum. Nonetheless,
6 given that discovery is generally limited in European litigation, there is a great concern that
7 Oracle’s proposed modification might circumvent or subvert those foreign limitations.

8 Further, none of the cases cited by Oracle permit the unrestricted use of the discovery that
9 Oracle seeks in this case. In *Foltz*, the case was remanded to the district court to make the
10 required relevance determination before modifying the protective order. *See id.* at 1138. In
11 *Verizon*, the discovery was restricted only for use in pursuing modification of a judgment in the
12 collateral litigation. *See* 214 F.R.D. at 586-87. In *CBS Interactive*, the movant was allowed to
13 use the discovery only to the extent necessary to prepare and file its collateral litigation. *See* 257
14 F.R.D. at 206. And in *DRAM Antitrust Litigation*, the court did not allow direct access to the
15 confidential documents, but rather indicated it would allow access “only after the collateral courts
16 have decided upon the proper scope of discovery [in the collateral cases].” 2008 WL 4191780, at
17 *3. Oracle’s request for unrestricted access to Defendants’ confidential information for use
18 overseas is improper and should not be permitted.

19 **II. DEFENDANTS’ INSTRUCTIONS TO SCOTT TRAINOR AND REDACTION OF**
20 **THE TWO DOCUMENTS WERE PROPER.**

21 Oracle’s request for relief regarding the deposition of Scott Trainor seeks little more than
22 what Oracle has already obtained. To the extent it seeks more, that information is privileged.
23 Arguing to the contrary, Oracle makes broad assertions regarding improper “block[ing]” of topics
24 Oracle dubs “important.” Mot. at 9-11. For example, Oracle asserts that it “attempted to depose
25 Trainor” on two topics: “negotiate[ing] contract terms with prospective customers and
26 maintain[ing] his ethical obligations to PeopleSoft.” Mot. at 9-10 (emphasis added). That is
27 misleading. Oracle not only attempted to depose Mr. Trainor on these two topics, it questioned
28 him at length, and he repeatedly provided answers, on both topics:

1 Q. What did you do to ensure that you maintained all of PeopleSoft's information that
2 you had learned during your tenure as an attorney there in confidence? . . .

3 A. Okay. I simply didn't disclose it. The information that I had that was confidential, I
4 didn't disclose. . . .

5 Q. Did you reveal to anyone at TomorrowNow or SAP information that you had learned
6 at PeopleSoft that you did not consider was confidential or privileged? . . .

7 A. No. Not to my recollection.

8 Q. So you just walled everything off that you had learned at PeopleSoft, whether it was
9 confidential or privileged or not. Is that right? . . .

10 A. Without -- yes. On that general question, yes, without a more specific -- not to my
11 recollection did I disclose it.

12 *See Declaration of Jason McDonell in Support of Defendants' Opposition to Oracle's Motion to*
13 *Modify and to Compel ("McDonell Decl.") ¶ 1, Ex. 1 (Tr. at 11:10-13:11).*

14 Q. And when you started working with TomorrowNow, did that trigger any thoughts on
15 your part that your prior work for PeopleSoft was implicated? . . .

16 A. It was the similar thought that I had when I went -- when I went to SAP, that there was
17 confidential information that I needed to protect.

18 Q. Did you take any steps to ensure that you kept all confidential information secure? . . .

19 A. I simply ensured that I did not disclose that information in conversations.

20 Q. By self-policing your comments? . . .

21 A. Yes.

22 Q. And to your recollection, that worked? . . .

23 A. Yeah. As I have said, I did not disclose that information.

24 *Id.* ¶ 1, Ex. 1 (Tr. at 29:8-30:16).

25 Q. And you represented TomorrowNow in connection with negotiations with potential
26 customers and talked about the downloading from Customer Connection. True? . . .

27 A. To be precise, yes, I represented them.

28 The second part, I don't recall having that -- and the second part being, about Customer
Connection.

Q. Did you ever advise anyone at TomorrowNow or SAP on the general subject matter of
software licenses? . . .

A. Yes. . . .

1 Q. Did you ever utilize the information you developed at PeopleSoft regarding the terms
2 of the PeopleSoft licenses? . . .

3 A. I had a general understanding of the marketplace. I did not specifically use any
4 knowledge that I gained while working at PeopleSoft.

5 *Id.* ¶ 1, Ex. 1 (Tr. at 52:17-53:23).

6 Notwithstanding these examples and others throughout the deposition,³ Oracle moves to
7 compel further testimony and *in camera* review of two documents. See D.I. 570-1 at 2. For the
8 reasons discussed below, and because of the testimony Oracle has already obtained from Mr.
9 Trainor on the topics at issue in Oracle's motion, the requested relief should be denied.⁴

10 **A. Further Testimony is not Warranted.**

11 Scott Trainor is a lawyer licensed in California and was in-house counsel for PeopleSoft
12 before joining SAP, where he is currently in-house counsel.⁵ At both PeopleSoft and SAP, he
13 was involved in privileged attorney-client communications and generated protected work product
14 for his respective employers. At the outset of Mr. Trainor's October 13, 2009 deposition, which
15 covered time periods implicating both parties' privileged information, Oracle strictly instructed
16 Mr. Trainor not to reveal PeopleSoft's privileged information. See McDonell Decl. ¶1, Ex. 1 (Tr.
17 at 20:3-11). Likewise, Defendants' counsel instructed Mr. Trainor not to reveal Defendants'
18 privileged information, and Mr. Trainor's own counsel provided similar admonitions for any
19 information over which Mr. Trainor personally held a privilege. See, e.g., *id.* at (Tr. at 11:19-24
20 and 56:1-2).

21 ³ See McDonell Decl. ¶ 1, Ex. 1 (Tr. at 12:3-13:11; 15:19-16:21; 17:18-23; 27:7-28:18;
22 29:8-30:16; 79:19-80:6) (multiple *additional* examples of similar questions).

23 ⁴ Oracle broadly asks the Court to compel not only further testimony about Exhibit 1683
24 and responses to certain questions Mr. Trainor was instructed not to answer, but also "reasonable
25 follow up questions." Mot. at 18. This final request for relief is improper. The Court should not
26 compel Trainor to answer questions that have not been asked. See *Tardiff v. County of Knox*, 246
F.R.D. 66, 67 (D. Me. 2007) (limiting judicial review to questions asked at a deposition of
plaintiffs' counsel and declining to review whether to compel answers to unasked questions in
"areas of inquiry"). If, however, the Court grants the Motion, Defendants seek guidance from the
Court limiting the follow-up questions. Such guidance will help prevent further dispute or
requests for judicial review.

27 ⁵ See Declaration of Chad Russell in Support of Oracle's Motion to Modify and to Compel
28 ("Russell Decl.") ¶ 14, Ex. H at 9:10-18, 22:15-23:4, 24:11-26:21 (employment); See Declaration
of Scott Trainor in Support of Defendants' Opposition to Oracle's Motion to Modify and to
Compel ("Trainor Decl.") ¶ 1 (licensed in California).

1 It should not be surprising that Mr. Trainor's deposition involved numerous efforts by
2 both parties' counsel and the witness to prevent inadvertent disclosure of privileged information,
3 given that Mr. Trainor is a lawyer and acted in that capacity for both PeopleSoft and Defendants
4 and because Oracle alleges that Mr. Trainor improperly shared PeopleSoft confidential
5 information with Defendants. Furthermore, in the context of this particular deposition, it should
6 also not be surprising that there was some difficult line-drawing done in the interest of preserving
7 the privileged status of the protected information.⁶

8 In determining whether further testimony is warranted, the only issue before the Court is
9 whether the questions at issue called for the disclosure of protected information.⁷ Oracle moves
10 to compel Mr. Trainor to answer ten questions that can be bundled into six groups. See Mot. at
11 11-18. Through this response, Defendants have met their burden of establishing that either the
12 attorney-client privilege and/or work product doctrine is applicable in each instance. See *United*
13 *States v. Chevron*, 241 F. Supp. 2d 1065, 1069 (N.D. Cal. 2002) (placing burden for attorney-
14 client privilege), *id.* at 1080-81 (work product). Where Defendants concede that there is
15 unprotected information responsive to certain questions at issue, the testimony Oracle seeks is
16 cumulative, not material, and thus does not warrant further examination.

17 **1. All of the Withheld Testimony is Privileged.**

18 Defendants hold the attorney-client privilege over some of Mr. Trainor's communications
19 at SAP. For example, while at SAP, TomorrowNow ("TN") was one of his clients. See

21 ⁶ Moreover, the liberal clawback provisions in the Stipulated Protective Order that allow
22 "clawing back" testimony were not designed with this particular "lawyer as a witness" scenario in
23 mind, and thus would have been neither particularly easy to implement nor practically effective in
24 protecting the privileged information placed at issue by Oracle's motion. See D.I. 32.

25 ⁷ Defendants have offered to present Mr. Trainor again to testify about Exhibit 1683. See
26 Russell Decl. ¶ 25, Ex. S. With regard to TN-OR00852363, Oracle's request to depose him on
27 the redacted sections suffers from two procedural defects. First, Oracle's motion is the first time
28 Oracle has challenged the redactions. See McDonell Decl. ¶ 2. Second, that document was not
introduced, let alone clawed back, during the deposition of Mr. Trainor; its only relationship to
the deposition is that Defendants announced its clawback in the same letter that announced the
clawback of Exhibit 1683 and a number of other documents wholly unrelated to the deposition.
See Russell Decl. ¶ 5, Ex. C (Exhibit 1683 is identified by its Bates number, SAP-OR00677719).
Oracle's inclusion of this document in its Motion to Compel is an attempt to circumvent this
Court's limitation of issues for review. Moreover, Oracle should not be allowed to compel
testimony that it never sought in the first place.

1 McDonnell Decl. ¶ 1, Ex. 1(Tr. at 52:17-52:3). Where, as here, the client is a corporation, the
2 attorney-client privilege may attach to communications with any corporate employee when those
3 communications relate to the scope of the employee’s corporate duties and the employee is aware
4 that the information is being furnished to enable the attorney to provide legal advice to the
5 corporation. *See Upjohn Co. v. United States*, 449 U.S. 383, 394 (1981). Challenges to the
6 privilege must be evaluated on a case-by-case basis. *See id.* at 396.

7 Mr. Trainor was asked during the deposition to generate protected work product for
8 anticipated and actual litigation matters and to disclose work product he had previously
9 generated. First, he was asked about the legal analysis of potential claims between Defendants
10 and Defendants’ customers. Second, he was asked to analyze hypothetical legal questions about
11 his own alleged exposure to a claim of a professional ethics violation. Finally, several lines of
12 questions at issue effectively asked Mr. Trainor to perform an extemporaneous legal analysis
13 about the application of law to facts pertinent to the case at bar.

14 Protected work product “is reflected, of course, in interviews, statements, memoranda,
15 correspondence, briefs, mental impressions, personal beliefs, and countless other tangible and
16 intangible ways” *Hickman v. Taylor*, 329 U.S. 495, 511 (1947).⁸ In-house counsel can
17 generate protected work product in a pending case. *See, e.g., Shelton v. American Motors Corp.*,
18 805 F.2d 1323, 1325 (8th Cir. 1986) (reversing district court’s imposition of sanctions upon
19 defendant for instructing in-house counsel not to answer deposition questions on the basis of
20 protected work product). Asking an in-house attorney to do legal analysis or provide mental
21 impressions in a deposition reaches for protected work product. *See Sony Computer Entm’t Am.,*
22 *Inc. v. Great Am. Ins. Co.*, 229 F.R.D. 632, 635 (N.D. Cal. 2005) (holding that a party may not
23 ask opposing in-house counsel “individual understandings” to explain the legal obligations
24 created by the insurance policy issued by the deposing party “since that would contain mental
25 impressions protected by the work product privilege”). Protected work product is discoverable

26
27 ⁸ In contrast to the attorney-client privilege, Mr. Trainor *and* his employers, PeopleSoft
28 *and* SAP, hold the privilege for the work product he generated while in their employ. *See, e.g.,*
Pastrana v. Local 9509, Commc’ns Workers, No. 06cv1779 W, 2007 U.S. Dist. LEXIS 73219, at
*12 n.6 (S.D. Cal. Sept. 28, 2007).

1 only when the moving party demonstrates an “otherwise unsatisfiable need” for it. *Chevron*, 241
2 F. Supp. 2d at 1081. Significantly, Oracle does not argue or demonstrate that it has such a need.
3 It merely asserts that Mr. Trainor has no relevant protected work product. *See, e.g.*, Mot. at 14-
4 15. Oracle, however, cannot compel Mr. Trainor to analyze the facts of this case and offer his
5 opinion on their legal significance—that is a job that Oracle’s own counsel can do. *See Hickman*,
6 329 U.S. at 516 (Jackson, J., concurring) (doctrine prevents one side from “perform[ing] its
7 functions . . . on wits borrowed from the adversary”).

8 2. **The Questions at Issue in Oracle’s Motion are Improper.**

9 *First Group of Improper Questions (“Compartmentalize”)* (Mot. at 11-12). Oracle asked
10 Mr. Trainor what “steps” he took to avoid relying on his memory of PeopleSoft’s license
11 agreements and whether he “compartmentalize[d]” his PeopleSoft experience. Mot. at 11-12. In
12 substance, these broad and vague questions are essentially the same.

13 Oracle’s earlier, and repeated, questions on this topic created some confusion. For
14 example, before posing these questions, Oracle had *already* examined Mr. Trainor on the subject
15 of what he did to maintain PeopleSoft’s confidences, how he used information he learned at
16 PeopleSoft, and how he had complied with his ethical obligations. *See, e.g., infra* pp. 7-8.
17 Oracle’s use of the term “compartmentalize” apparently then sought greater detail about what
18 confidential information Mr. Trainor knew and how he mentally organized it. Understood this
19 way, the question reaches for information protected by the attorney work product doctrine. *See*
20 *Hickman*, 329 U.S. at 511 (mental impressions are protected); *Tardiff*, 246 F.R.D. at 70-74
21 (upholding instructions not to answer a multitude of questions when questions posed to attorney
22 called for protected work product and moving party had not demonstrated need for information).⁹
23 In order to answer this question with any more detail than he already provided, Mr. Trainor would
24 have to disclose information that is privileged and confidential to both PeopleSoft and SAP.
25 Trainor Decl. at ¶ 2. Such a response would run afoul of the very instruction that Plaintiffs’

26

⁹ Oracle misreads the exchange by arguing that the attorney-client privilege cannot support
27 an instruction not to answer. *See* Mot. at 12, 14 (similar misreading of the “Communications with
28 Prospective Customers” questions). It may or it may not; this is why Defendants *cautioned*
Trainor not to reveal privileged information rather than *instructing* him not to answer. *See id.*

1 counsel gave him at the outset of the deposition. See McDonell Decl. ¶ 1, Ex. 1 (Tr. at 20:3-11).
2 Thus, if such detail is compelled, then Defendants request guidance from the Court that Mr.
3 Trainor can provide answers without risk of being accused by Oracle of disclosing too much. If,
4 however, Defendants' understanding of this exchange is wrong, and Oracle was simply asking Mr.
5 Trainor if or how he used his knowledge of PeopleSoft practices while working for SAP, then that
6 question has already been repeatedly answered. See, e.g., *infra* pp. 7-8.

7 *Second Group of Improper Questions ("Communications with Prospective Customers")*
8 (*Mot. at 13*). Oracle asked Mr. Trainor to analyze a note in a draft contract provided to a
9 prospective customer (Waste Management), which states "think this is to WM's advantage
10 because you don't want us accessing production and testing development environment." Russell
11 Decl. ¶ 24, Ex. R. In response, Mr. Trainor testified that he did not recall if he wrote the note.
12 See *Mot. at 14*. Oracle nevertheless persisted in asking him to analyze the note, specifically
13 asking him, "How did you read it?" *Id.* In response, Mr. Trainor testified "I feel like I'm going
14 into where I'm drawing legal conclusions as I interpret this," at which point defense counsel
15 instructed him not to disclose his mental legal analysis. *Id.*

16 Mr. Trainor and Oracle appear to have been talking past each other in this exchange. At
17 the time of the deposition, Mr. Trainor understood the question as asking him to explain why TN
18 represented this to Waste Management, which he believed would require him to provide legal
19 analysis. Trainor Decl. ¶ 3. Oracle now reads the transcript as asking for Mr. Trainor's factual
20 understanding of the phrase "you don't want us accessing" at the time the document at issue was
21 created (as opposed to his interpretation of that phrase at the time of the deposition). *Mot. at 13*.
22 If Oracle was truly seeking his contemporaneous understanding of the phrase, then Defendants
23 withdraw the instruction. However, re-deposing Mr. Trainor simply to answer this question is
24 unlikely to yield any material information because Mr. Trainor already testified that he did not
25 recall if he wrote the note, and the note largely speaks for itself.

26 *Third Group of Improper Questions ("Misrepresentations to Customers") (Mot at 15).*
27 Oracle asked Mr. Trainor about the position that TN took with customers regarding Oracle's
28 intellectual property and, specifically, if TN's rights to use PeopleSoft software depended on the

1 customers' licenses with PeopleSoft. See Mot. at 14-15. Mr. Trainor confirmed what Oracle
2 already knew from prior discovery, acknowledging that TN took this position with customers.
3 See McDonell Decl. ¶ 1, Ex. 1 (Tr. at 114:15-23). Indeed, Mr. Trainor reiterated Oracle's public
4 allegations in the Fourth Amended Complaint: the rights to use its intellectual property are
5 governed by the contracts with its customers. D.I. 348 at ¶¶ 51-53. However, the current dispute
6 about this group of questions stems from Oracle's counsel's use of that answer to ask Mr. Trainor,
7 an SAP attorney, argumentative questions that call for legal analysis of Oracle's core allegations.
8 See, e.g., D.I. 348 at ¶¶ 193, 203 (alleging "deceptive representations"). Specifically, Oracle
9 asked if this legal position was "a true statement" so far as Mr. Trainor knew. See Mot. at 15. In
10 that line of questions, Oracle asked Mr. Trainor if "SAP or TomorrowNow ever misrepresent[ed]
11 facts to customers during negotiation of terms?" *Id.* Since both questions call for
12 contemporaneous legal analysis by an SAP in-house lawyer, Mr. Trainor was instructed not to
13 answer. See Mot. at 15; Trainor Decl. ¶ 5.

14 The work product instructions to these questions are proper. There is a dispositive
15 difference between Oracle asking Mr. Trainor if either (a) TN ever represented a certain fact or (b)
16 TN ever made a "misrepresentation." The first is an example of a question seeking a non-
17 privileged fact, while the second is an example of a question seeking the legal analysis of an in-
18 house counsel in the case at bar.¹⁰ Because Oracle's questions sought legal analysis rather than
19 facts, Oracle has no basis on which to compel Mr. Trainor to answer. See *Tardiff*, 246 F.R.D. at
20 70-71, 73-74; *Sony Computer*, 229 F.R.D. at 635.

21 Both questions also raise attorney-client privilege issues. The "true statement" question
22 asks Mr. Trainor to confirm if "TomorrowNow's rights to use the PeopleSoft software come
23 entirely by way of the Waste Management license with PeopleSoft." That is, it asks him to testify
24 about the specifics of PeopleSoft's confidential licenses. At other points in the deposition, Oracle
25 asked Mr. Trainor to explain his non-confidential, non-privileged understanding of PeopleSoft's
26 licenses, and he did. See McDonell Decl. ¶ 1, Ex. 1 (Tr. at 53:21-54:19). If the "true statement"

27 ¹⁰ *Cf., e.g., Rondberg v. McCoy*, No. 09-CV-1672-H, 2009 U.S. Dist. LEXIS 118869, at
28 *18-19 (S.D. Cal. Dec. 21, 2009) (describing elements of intentional and negligent
misrepresentation).

1 question asks him to repeat that answer, the Motion seeks cumulative testimony. Conversely, if
2 Oracle seeks a more detailed answer, then Mr. Trainor is being asked to reveal PeopleSoft or
3 Defendants' privileged information. See Trainor Decl. at ¶ 4. Thus, if the Court compels such an
4 answer, Defendants' seek guidance from the Court that Mr. Trainor may reveal privileged
5 PeopleSoft information as needed. With regard to the second question, *i.e.* "misrepresentations,"
6 if the Court compels an answer based only on what non-privileged facts Mr. Trainor knows (as
7 opposed to separately analyzing the facts and forming his own opinion), the result will be
8 uninformative.

9 *Fourth Group of Improper Questions ("Indemnification Policy") (Mot. at 15).* Oracle's
10 fourth group of improper questions focuses on a non-privileged, internal statement by TN and
11 SAP: namely, that TN's indemnification provision was a "Key term -- no removing this." After
12 Oracle asked Mr. Trainor if TN and SAP adopted this position, it then pushed further and asked if
13 this position was "true." Mot. at 15. In effect, Oracle asked Mr. Trainor to provide legal analysis
14 and advice regarding language in a TN contract. Specifically, Oracle asked him what value the
15 indemnification clause had within TN and SAP during contract negotiations, *i.e.*, whether it was a
16 "key term." *Id.* Had Mr. Trainor answered (either with a "yes," "no," or anything else), he would
17 have revealed how SAP attorneys, including himself, evaluated the language of TN's contracts,
18 which in turn would have revealed privileged work product and/or attorney-client
19 communications because he had privileged and confidential communications with TN employees
20 about this subject matter. See Trainor Decl. ¶ 6. Thus, the instructions were proper. See *Tardiff*,
21 246 F.R.D. 66; *Sony Computer*, 229 F.R.D. at 635.

22 *Fifth Group of Improper Questions ("Compliance with ethical obligations") (Mot. at 16).*
23 In this group of questions, Oracle attempted to conduct a real-time legal debate with Mr. Trainor
24 about whether certain hypothetical scenarios would have violated his ethical duties. See Mot.
25 at 17. In response to the questioning, Mr. Trainor acknowledged his ethical duties and his
26 obligation to respect the confidential information of a prior client. See *id.* Oracle then followed
27 up with two hypothetical questions. First, "if" Mr. Trainor had disclosed "information [he]
28 learned from a former -- client [PeopleSoft]" to a TN employee, whether that would have

1 constituted an ethical violation. *See id.* Oracle then probed further, asking whether Mr. Trainor
2 would have “felt comfortable” if he had conveyed certain information to a TN employee; that
3 question was colored by Oracle’s suggestion, posed immediately prior, that conveying such
4 information was “wrong.” *See McDonell Decl.* ¶ 1, Ex. 1 (Tr. at 137:23-25). Here, Oracle did
5 nothing less than ask Mr. Trainor to conduct a live legal analysis that, assuming certain
6 hypothetical facts were true, would result in Mr. Trainor providing a legal opinion in response to
7 a legal ethics question relating to his duties as a lawyer to his former client.¹¹

8 As an initial matter, Mr. Trainor had his own personal counsel prior to and at the
9 deposition who had given him legal advice on this subject matter. *Trainor Decl.* ¶ 7. He is unable
10 to answer these questions without disclosing privileged information. *Id.*

11 Moreover, to the extent that Oracle seeks a legal analysis regarding whether certain facts
12 evidence any ethical violation, Oracle must turn to its current counsel, not Mr. Trainor. *See*
13 *Tardiff*, 246 F.R.D. at 71, 77 (upholding instruction given to an attorney in a deposition not to
14 answer whether the attorney violated the Professional Rules of Responsibility). In arguing to the
15 contrary, Oracle’s Motion improperly conflates factual questions about what actions Mr. Trainor
16 took (as they relate to his knowledge about PeopleSoft licenses) with questions requiring an
17 application of law to non-privileged facts. *See Mot.* at 17 (asserting “Oracle is entitled to ask
18 whether its predecessor’s former counsel complied with his legal ethical obligations toward
19 PeopleSoft”). Oracle’s argument fails. Answering either question would invade privileged work
20 product and reveal privileged attorney-client communications; thus, the instructions not to answer
21 were proper. *See Tardiff*, 246 F.R.D. at 70-71, 73-74 (work product); *Trainor Decl.* ¶ 7 (attorney-
22 client privileged communications).

23 *Sixth Group of Improper Questions (“Willfulness of copyright infringement”)* (*Mot.* at 17).
24 Oracle asked whether “SAP or TomorrowNow [took] any steps to determine whether a particular
25 customer’s allowance of access to software constituted copyright infringement” and whether
26 “TomorrowNow or SAP ever analyze[d] in connection with a negotiation of a contract the

27
28 ¹¹ As noted above, the instruction here did not prohibit Oracle from gathering non-privileged facts about Trainor. *See, e.g., infra* pp. 7-8.

1 general topic of a customer's rights to provide access to software.” Mot. at 18.¹² Oracle’s motion
2 concedes that instructions not to answer are appropriate with respect to this topic and limits its
3 complaint to the contention that “Defendants’ instructions not to answer came too early and were
4 too sweeping.” *Id.*

5 These questions, however, are not foundational questions. They seek information about
6 potential legal analysis performed for TN or SAP “in connection with” possible specific instances
7 of potential “copyright infringement” and specific instances of customer negotiations, rather than
8 asking for general foundational information. *Id.* That is a degree of detail beyond that required
9 by Federal Rule of Civil Procedure 26(b)(5). By comparison, the appropriate foundational
10 information is contained in paragraph 7 of the Trainor Declaration. By asking if advice in a
11 general subject matter was ever given or received in a specific context, Oracle is reaching for
12 privileged information. *See Tardiff*, 246 F.R.D. 66 (work product); Trainor Decl. ¶ 8 (privilege).

13 **B. Defendants’ Redactions are Proper.**

14 Oracle seeks *in camera* review of two documents, Deposition Exhibit 1683 and TN-
15 OR00852363. As noted above, the inclusion of TN-OR00852363 in Oracle’s motion is
16 inappropriate. It was neither introduced in Mr. Trainor’s deposition nor clawed-back as a result
17 of it. *See McDonell Decl.* ¶ 2. Moreover, Oracle failed to follow proper procedure by first
18 establishing a legal basis for this Court’s *in camera* review of the two documents.
19 Notwithstanding these omissions, and as part of Defendants’ continued good faith efforts to
20 maintain the proper contours for privilege claims in this case, Defendants agree to submit both
21 documents for *in camera* review so that the Court can determine whether the redactions are
22 proper.

23 **1. Exhibit 1683 is Properly Redacted.**

24 Deposition Exhibit 1683 is a string of e-mails between SAP and TN employees.¹³

25 ¹² Questions answered by other deponents, *e.g.*, Chris Faye, are inapposite. *See Russell*
26 *Decl.* ¶ 16, Ex. J. The questions to Mr. Faye were more general than those posed to Mr. Trainor;
27 they were not in regard to a “particular customer[]” or “in connection with a negotiation of a
28 contract.” *Id.*

¹³ Oracle also seeks additional testimony from Mr. Trainor regarding Exhibit 1683. Any
additional examination regarding Exhibit 1683 would be cumulative and is not warranted at this
late date. While it is true that Exhibit 1683 was clawed back during the deposition and then

1 See Russell Decl. ¶ 25, Ex. S. It reflects a dialogue between multiple persons, some of whom
2 were not attorneys, some of whom were attorneys acting within a business capacity during the
3 exchange, and some of whom were attorneys acting within a legal capacity. See McDonell Decl.
4 ¶ 3. Given the various roles of the authors and recipients of the document (some of whom are not
5 obvious from the face of the document), Defendants' document review process resulted in three
6 differently-redacted versions being produced. See Russell Decl. ¶ 7, Ex. E. Ultimately, after
7 Exhibit 1683 was used in Mr. Trainor's deposition and was then subjected to additional scrutiny,
8 Defendants revised their document production in a way that resulted in only one redaction of that
9 document and its counterparts. See *id.* ¶ 25, Ex. S. Specifically, portions of an e-mail from Mia
10 Lee to Mr. Trainor are redacted, and that portion reflects a communication from Ms. Lee seeking
11 legal advice from Mr. Trainor. See Declaration of Mia Lee in Support of Defendants' Opposition
12 to Oracle's Motion to Modify and to Compel ("Lee Decl.") ¶ 1. Thus, the one redaction in
13 Exhibit 1683 is appropriate. See *Chevron*, 241 F. Supp. 2d at 1076 ("It is clear that
14 communications between corporate personnel and their in-house counsel made for the purpose of
15 securing legal advice are protected by the privilege").

16 2. TN-OR00852363 is Properly Redacted.

17 This document is an e-mail from Bob Geib, TN's Vice President of Sales, to other
18 executives at TN and Mr. Trainor. It reflects comments by Mr. Geib regarding changes made to
19 the TN Support Services Agreement, which was a form agreement for TN customers. See Trainor
20 Decl. ¶ 9. The redacted portions reflect the content of legal communications from Mr. Trainor to
21 Mr. Geib and requests for legal advice from Mr. Geib to Mr. Trainor. See *id.* Thus, the
22 redactions are appropriate. See *Chevron*, 241 F. Supp. 2d at 1076 ("It is clear that
23

24 (continued...)

25 produced again after the deposition, the general subjects contained in that document were covered
26 at length during the deposition. Compare Russell Decl. ¶ 25, Ex. S with McDonell Decl. ¶ 1,
27 Ex. 1. Defendants nevertheless offered to present Mr. Trainor for further examination on Exhibit
28 1683. See Russell Decl. ¶ 10, Ex. G. That offer remains open. See McDonell Decl. ¶ 3. For the
sake of efficiency, Defendants insisted that the related issues be resolved first so the deposition
would not be fragmented, with an initial examination of Exhibit 1683 and then possible additional
examination on other issues. See Russell Decl. ¶ 10, Ex. G.

communications between corporate personnel and their in-house counsel made for the purpose of securing legal advice are protected by the privilege.”).

III. TO THE EXTENT REASONABLY POSSIBLE, AND WITHOUT WAIVING THEIR PROPER OBJECTIONS, DEFENDANTS HAVE FULLY RESPONDED TO ORACLE’S REQUESTS FOR ADMISSION.

Oracle seeks amended responses to 316 of Plaintiffs’ 1,315 requests for admissions (“RFAs”). See Declaration of Joshua L. Fuchs in Support of Defendants’ Opposition to Oracle’s Motion to Modify and to Compel (“Fuchs Decl.”) ¶¶ 2-3. Subject to Defendants’ timely and proper objections, Defendants have responded to Oracle’s complex, compound, and unduly burdensome requests, and Part IV of Oracle’s motion should be denied.

A. Oracle’s Definitions of “Copy,” “Fix,” “Update,” and “Generic Environment” are Improper.

Oracle’s Requests for Admission (“RFA”) Nos. 496-680 in Set No. 2 and 13-50 in Set No. 3 do not, as Oracle suggests, present a series of basic facts about TN’s business process.¹⁴ See Mot. at 19-20 and 24-25. Instead, these 223 RFAs are complicated, detailed requests seeking information about technical conduct that varied greatly, took place over several years, and involved numerous employees, business operations, and thousands of varying objects.¹⁵ Moreover, Oracle readily admits that each of the “thirty-two” requests contained in RFAs 13-44 from Set No. 3 actually contain separate sub-requests relating to 33,186 separate objects, which totals 1,061,952 individual requests for admission (*i.e.*, 32 x 33,186). See *infra* pp. 24-30. In answering the RFAs at issue, Defendants did their best to deal with Oracle’s complicated, compound requests by providing precise, accurate answers that were intended to be subject to only a single interpretation.

¹⁴ Oracle’s grouping of RFAs 496-680 and 13-50 is misplaced. RFAs 496-680 are directed at whether certain types of conduct always happened, happened the majority of the time, happened sometimes, or happened at least once. In contrast, RFAs 13-50 request admissions about the specific scoping, developing, and testing conduct for all objects that TN has a systematic record of attempting to deliver to its customers. See *infra* pp. 24-30. Because of the burden issue discussed in detail below, TN did not provide substantive answers to RFAs 13-50, while TN did provide detailed substantive answers to RFAs 496-680.

¹⁵ With respect to PeopleSoft application software, an “object” is a broad term referring to one of a variety of things used in running the software, including code (such as SQR, SQC, and COBOL files), data files, data mover script files, project files, and things known as “online objects” (such as fields, records, pages, menus, etc.).

1 **1. Defendants Answered Where Reasonably Possible.**

2 As Oracle acknowledges, the 223 RFAs at issue stem from the parties' inability to reach a
3 factual stipulation regarding the exact steps taken to scope, develop, test, and deliver objects to
4 TN's PeopleSoft HRMS payroll customers. *See* Mot. at 3; Fuchs Decl. ¶¶ 11-12. Each of RFAs
5 496-680 asks Defendants to admit, in some form, each sentence contained in Oracle's last
6 proposed stipulation. Oracle seeks either a stipulation or admission regarding wide-ranging
7 conduct that took place over numerous years and that was very technical in nature. In response to
8 some of Defendants' concerns raised during the stipulation negotiations, Oracle drafted RFAs
9 496-680 in a way that allowed Defendants to answer on a continuum of whether the conduct at
10 issue occurred always, a majority of the time, sometimes, or at least once. Defendants responded
11 in good faith, providing answers as precise as possible in light of the detailed, complex, and
12 technical requests.

13 **2. Oracle's RFAs are Improper Because They are not "Simple, Direct,**
14 **and Limited to Singular Facts."**

15 "It is well settled that requests for admissions . . . are required to be simple and direct, and
16 should be limited to singular relevant facts." *Safeco of Am. v. Rawstron*, 181 F.R.D 441, 446
17 (C.D. Cal. 1998) (quoting *S.E.C. v. Micro-Moisture Controls*, 21 F.R.D. 164, 166 (S.D.N.Y.
18 1957)). Moreover, "Rule 36 should not be used unless the statement of facts sought to be
19 admitted is phrased so that it can be admitted or denied without explanation." *Id.* at 447 (quoting
20 *United Coal Cos. v. Powell Constr. Co.*, 839 F.2d 958, 968 (3d Cir. 1988)). "[W]hen good faith
21 requires that a party qualify an answer or deny only a part of a matter, the answer must specify
22 the part admitted and qualify or deny the rest." Fed. R. Civ. P. 36(a)(4). Before ordering a matter
23 admitted, the Court ordinarily should first order an amended answer and deem the matter
24 admitted only if a sufficient answer is not timely filed. *See Asea, Inc. v. S. Pac. Transp. Co.*, 669
25 F.2d 1242, 1247 (9th Cir. 1981). Such a severe sanction is only warranted where there is an
26 intentional disregard for the obligations imposed by Rule 36. *See id.*

27 Here, Oracle's requests are neither simple nor direct and are not limited to singular facts.
28 Rather, the requests involve extremely complex definitions and factual predicates that often

1 depend on references to exhibits and/or prior requests, thereby requiring that answers contain
2 precise explanations to parse out which facts are undisputed and which Defendants reasonably
3 believe are in dispute. See Mot. at 19-20 and 24-25. The fact that Defendants could have, but did
4 not, deny these requests outright based on the wholesale failure of Oracle's RFAs to comply with
5 the rules and controlling case law evidences Defendants' good faith in responding and attempting
6 to narrow the material facts in dispute for trial. Defendants have not intentionally disregarded
7 their obligations under Rule 36, and Oracle does not suggest otherwise.

8 **3. Oracle's Definition of the Term "Copy" is Overly Broad and Vague.**

9 Oracle's use and definition of the term "copy" is not as obvious as it contends.¹⁶ The fact
10 that this is a copyright case does not support Oracle's position that the term "copy" should be
11 broadly construed. To the contrary, the fact that this is a copyright case highlights the need for
12 Defendants to be very precise when referring to an activity that may not be "copying" as a matter
13 of law, regardless of whether a lay person might broadly describe the activity as being, or at least
14 involving, some form of "copying" according to the plain meaning of that term. "Copy" is a term
15 of art under the U.S. Copyright Act. Whether particular conduct constitutes illegal "copying"
16 under that Act is to be decided on the specific facts and conduct at issue in each instance, not on a
17 general, non-legal definition. Just as a cross examiner in a deposition cannot make a witness
18 agree to the cross-examiner's characterization of a fact, Oracle cannot make Defendants concede
19 to its overbroad definition of "copy". Rule 36 allows Defendants to qualify their answer, and thus
20 that is why Defendants responded on an RFA by RFA basis and admitted those facts which they
21 agree to and denied those facts which they dispute.

22 In responding to Oracle's requests using the defined term "copy," Defendants attempted to
23 be as precise as possible about the specific actions which they were admitting. Defendants have
24 that right under Rule 36 when it is necessary to qualify an answer to leave no room for debate
25 about what fact is being admitted. For example, in the request and response that Oracle cites,
26 RFA 501, Defendants specifically used the term "download" to define the precise action at issue.

27
28 ¹⁶ For a complete list of the RFAs put at issue in Oracle's Motion that contain the term
"copy" see the Fuchs Decl ¶¶ 4-6.

1 Defendants should not be required to admit to all of the additional conduct and constructions
2 associated with Oracle's broadly defined term "copy," which includes not only the term
3 "download," but also many other terms.

4 Oracle concedes that Defendants were, in good faith, willing to reexamine certain of
5 Oracle's RFAs using the term "copy." See Fuchs Decl. ¶¶ 17-18. Oracle's request for this
6 reexamination, however, was not limited to the 223 RFAs put at issue by its motion, but included
7 all of the 1,315 RFAs served in the case. See Fuchs Decl. ¶¶ 17-18.¹⁷ If Oracle were willing to
8 define "copy" as "the word's plain meaning" and withdraw its previous definitions of that term,
9 then Defendants indicated they would no longer rely on their objection to "copy" and would
10 constructively remove that objection from Defendants' responses.¹⁸

11 **4. Where Reasonably Possible, Defendants Precisely and Accurately**
12 **Responded to RFAs Containing the Terms "Update" and "Fix."**

13 Oracle imprecisely defines and uses the terms "update" and "fix" by suggesting that: (a)
14 "fixes" and "updates" are interchangeable terms; and (b) fixes and updates are the smallest
15 component of the actual customer deliverables.¹⁹ See Mot. at 23-25. Neither statement is correct.
16 Oracle argues that TN employees used, and were familiar with, these terms, but that is irrelevant
17 to Defendants' objection in the context of these RFAs. Whether TN's employees used these
18 terms over the course of many years does not provide any clarity regarding the definition of the
19 terms "fix" or "update" in the context of these RFAs.

20 Fixes are made up of objects that can be several things, including file-based objects,
21 online objects, or data files. See Declaration of Catherine Hyde in Support of Defendants'
22 Opposition to Oracle's Motion to Modify and to Compel ("Hyde Decl.") ¶¶ 2-5. A fix is simply

23 ¹⁷ Out of the 1,315 RFAs, 539 contain the term "copy." Out of the 223 RFAs, 118 contain
24 the term "copy." See Fuchs Decl. ¶¶ 4-6.

25 ¹⁸ Because there are hundreds of requests that contain the term "copy" and many of those
26 will not need to be supplemented simply because of the definition change, Defendants seek to
27 avoid any unnecessary time and burden to amend each set of objections for those requests to take
28 out the objection to the term "copy." Instead, Defendants proposed a blanket statement that, in
light of the new definition, Defendants are not relying on their objection to the term "copy" in
providing these responses.

¹⁹ For a complete list of the RFAs put at issue in Plaintiffs' Motion that contain the terms
"fix" or "update," see the Fuchs Decl. ¶¶ 7-8.

1 the name given to a container (typically a .zip file) of one or more objects grouped together in a
2 certain manner that resolves a defined issue. *See id.* ¶ 5.²⁰ Moreover, the specific name given to
3 any particular fix container for a specific customer is also referenced to a broader master fix
4 record. *See id.* ¶ 5.²¹ A master fix record is the identifier for the internal TN record of a
5 particular reported issue affecting one or more TN customers. *See id.* ¶ 4. Fixes and master fixes
6 are not developed or tested. It is the objects contained within them for which the actual
7 development and testing work is completed. *See id.* ¶ 5. RFA 597, referenced in Oracle's
8 Motion, refers to Exhibit B which simply consists of a list of master fix records from the TN SAS
9 database and is not a list of what was developed, tested, and/or delivered to any specific TN
10 customer.²² Updates are simply containers of a group of fixes delivered together. *See id.* ¶ 6.²³
11 Although TN employees colloquially referred to fixes and updates as what was delivered to
12 customers, that general reference says nothing about the underlying facts regarding how each
13 object inside a given fix was developed or tested. *See id.* ¶ 7.

14 To the extent the creation, testing, and delivery of any object is knowable, one must
15 examine the history of each object contained in each fix, not the fix "container" itself or the larger
16 update "container" that typically holds several fix "containers." *See id.* ¶ 7.²⁴ Additionally,
17 although some fixes may have the same name, this does not require that each similarly-named fix
18 contains the same objects.²⁵ Similarly, even if an object has the same name as another, that does

19 ²⁰ The fix container WMI-TN-0102085972 listed by Oracle in footnote 8 of its Motion is
20 exemplary. That fix container contains seven .sqr objects, one .dat object, and one .dms object—
21 nine objects in total. *See Fuchs Decl.* ¶¶ 19-30 (providing explanatory screen shots). The history
of each object must be evaluated individually to determine how it was scoped, developed, tested,
and delivered, which is what the RFAs at issue seek. *See id.* ¶¶ 26-28.

22 ²¹ As demonstrated by footnote 8 in Oracle's Motion, Waste Management's fix WMI-TN-
0102085972 is referenced to TN master fix record CSS-TN-0102085972.

23 ²² In fact, there were 96 objects prepared for ten different customers associated with
24 master fix record CSS-TN-0102085972. *See Fuchs Decl.* ¶ 30 and 32.

25 ²³ Updates are also often referred to as bundles. Exhibit A, as referenced in example RFA
501, is a list of master bundle records from the SAS database. And, like master fix records,
26 master bundle records are simply an identifier for a collection of master fix records for which
specific objects would be developed, tested, and/or delivered to specific customers. *See Fuchs*
Decl. ¶ 31.

27 ²⁴ Oracle's technical expert, Kevin Mandia, expressly acknowledges this construct in his
28 definition of "Fix." *See Fuchs Decl.* ¶ 35.

²⁵ For example, RHI-TN-0102085972 is another fix container associated with CSS-TN-

1 not mean that both objects were developed or tested in the same environment. To fairly and
2 precisely respond to the specific facts and conduct implicated by such broad and complex
3 requests, like RFA 597, Defendants, therefore, made admissions, to the extent they were
4 reasonably knowable, at the object level.²⁶ Defendants appropriately denied the remainder of the
5 requests as allowed by Rule 36. This level of granularity is needed to properly admit to actual
6 facts which are not in dispute, and to delineate the facts which are in dispute. In responding in
7 this manner, Defendants also maintained their burden arguments, as discussed below.

8 **5. Defendants Precisely and Accurately Responded to RFAs Containing**
9 **the Term “Generic Environment.”**

10 To precisely respond to RFA 542, Defendants specifically admitted that the environment
11 being used was “one environment specific to TomorrowNow’s retrofit support of specific
12 TomorrowNow customers.”²⁷ Mot. at 26. Oracle’s definition of “generic environment” does not
13 capture the important point that the environment being referenced in the RFA is an environment
14 that was used for retrofit support and, as such, had limitations on customers, scope, and purpose.²⁸
15 Moreover, Oracle misstates Defendants’ current objection to the term “generic environment,”
16 which states in relevant part:

17 “Generic Environment” is a term created by Plaintiffs and as used
18 and defined by Plaintiffs is misleading by attempting to suggest that
19 any such environment or environment component was not used for
limited customers, scope or purpose.

20 See Russell Decl., Ex. W at 9 (page numbered (“pg”) 8); See Fuchs Decl. ¶¶ 13-14 and Ex. A.

21 (continued...)

22 0102085972, which was identified in footnote 8 to Oracle’s motion. Like fix container WMI-TN-
23 0102085972, fix container RHI-TN-0102085972 contains nine objects with the exact same names
24 as that of WMI-TN-0102085972. However, a careful examination of the objects actually reveals
that they are completely different and were developed and tested in a different manner. See Fuchs
Decl. ¶¶ 26-28 (providing example of ctx910au.sqr).

25 ²⁶ Defendants included substantial detail regarding this breakdown in their 136 page
26 response to interrogatory number 14, referenced below.

27 ²⁷ For a complete list of the RFAs put at issue in Oracle’s Motion that contain the term
“generic environment,” see the Fuchs Decl. ¶¶ 9-10.

28 ²⁸ In fact, during the meet and confer process, Defendants proposed, and Oracle rejected, a
solution which reiterated this concept and further explained this point. See Fuchs Decl. ¶ 16.

1 Oracle incorrectly asserts that the term “generic environment” had some sort of a common
2 meaning or usage by TN employees. This term, however, was not used in the frequent fashion or
3 with any type of a uniform meaning as suggested by Oracle. For example, John Baugh, head of
4 the environments team at TN, only used the term once during two days of testimony and only
5 after Oracle’s counsel had used the term at least 21 times in his questioning, including in the
6 question to which Mr. Baugh responded using the term. See Fuchs Decl. ¶ 15. Additionally, out
7 of the millions and millions of documents produced by TN in this litigation, there are only a
8 relative handful of documents that use the term “generic environment,” further demonstrating that
9 it was not a term commonly used by TN employees. See Fuchs Decl. ¶ 15; Hyde Decl. ¶ 8.

10 To the extent an environment or environment component was not directly tied to a
11 specific customer, the environment or environment component was tied to a specific use or group
12 of customers, like those serviced under the retrofit model and who were continuing to pay
13 maintenance to PeopleSoft/Oracle. The term “generic environment” is a term posited by Oracle
14 in deposition questioning²⁹ in an attempt to create a record and manufacture use of a phrase that
15 was neither frequently used nor had a common meaning at TN. Although Oracle may like the
16 connotations of the phrase “generic environment,” if that phrase does not accurately describe the
17 facts that Defendants can in good faith admit, then the RFA at issue should be either denied or
18 qualified in such a way as to describe the actual conduct at issue. Defendants are under no
19 obligation to accept as true a term and related definition that Defendants dispute.

20 **B. RFAs Nos. 13-50 in Set No. 3 and 4-63 and 130-162 in Set No. 5 Are Unduly**
21 **Burdensome.**

22 With these RFAs, Oracle seeks separate admissions concerning: (a) the creation,
23 development, and testing of every object for which TN has a record of preparing to deliver to TN
24 customers (RFAs Nos. 13-50 in Set No. 3 and 130-162 in Set No. 5); and (b) every file that TN
25 may have conceivably downloaded from Oracle (RFAs Nos. 4-63 in Set No. 3) over the entire
26

27 ²⁹ During Mr. Baugh’s deposition, Oracle’s counsel also expressly noted that “generic
28 environment” was a term that he created for the purpose of his questioning. See Fuchs Decl. ¶ 15,
Ex. B (“Mr. Howard: . . . for extended support financials customers using a, as I’ve called it,
generic environment, similar to what was done for HR customers”) (emphasis added).

1 history of the company. These RFAs are actually millions and millions of separate requests
2 seeking specific and detailed information regarding data that has already been produced and is
3 equally accessible to Oracle. In arguing that Defendants should be compelled to further respond,
4 Oracle attempts to combine two substantively different types of RFAs and, more importantly,
5 misses the crux of Defendants' position—that Defendants objected to these requests primarily
6 because they are compound and unduly burdensome. Oracle does not address either of these
7 objections in its Motion.

8 **1. There is no Legal Basis to Support Oracle's Request that this Court**
9 **Shift the Burden to Defendants to Analyze Information that is Equally**
10 **Accessible to Both Parties.**

11 The Federal Rules set reasonable limits on discovery, including the Court's ability to
12 weigh the benefit of the requested discovery against the cumulative nature of the request and the
13 burden involved in responding. *See* Fed. R. Civ. P. 1. Additionally, Rule 26(b)(2)(C) specifically
14 describes the analysis that should be conducted to limit the "frequency or extent of discovery"
15 otherwise allowed by the Rules and states in pertinent part:

16 [T]he court must limit the frequency or extent of discovery
17 otherwise allowed by these rules . . . if it determines that: (i) the
18 discovery sought is unreasonably cumulative or duplicative, or can
19 be obtained from some other source that is more convenient, less
20 burdensome, or less expensive; . . . or (iii) the burden or expense of
21 the proposed discovery outweighs its likely benefit . . .

22 Fed. R. Civ. P. 26(b)(2)(C).

23 Under Rule 36, "[e]ach matter must be separately stated." Fed. R. Civ. P. 36(a)(2).
24 Additionally, requests for admission should be limited to singular relevant facts. *See Rawstron*,
25 181 F.R.D. at 446. Rule 36 also specifically allows for objections to any requests. *See* Fed. R.
26 Civ. P. 36(a)(3). Further, "[t]he answering party may assert lack of knowledge or information as
27 a reason for failing to admit or deny only if the party states that it has made reasonably inquiry
28 and that the information it knows or can readily obtain is insufficient to enable it to admit or
deny." Fed. R. Civ. P. 36(a)(4).

29 **2. Brief Description of RFAs and Defendants' Objections and Responses.**

30 With regard to RFAs 13-50 in Set No. 3 and 130-162 in Set No. 5, Oracle seeks

1 admissions relating to the manner in which specific objects were created, developed, and tested
2 by TN.³⁰ Exhibit D is a 973 page, small font spreadsheet with 33,186 listings of file paths that
3 contain objects.³¹ It lists every object from a central server that Defendants reasonably believe
4 were made available to TN customers. This means that Oracle's RFAs referencing Exhibit D
5 (13-50 and 130-162) total more than 1 million separate requests. See Fuchs Decl. ¶¶ 33-34.

6 Defendants specifically objected to these requests by stating:³²

7 . . . Further, Defendants object to this request as compound and
8 unduly burdensome in that this request asks 33,185³³ separate
9 questions, and the request would require Defendants to review
substantial business records to determine an answer, if possible, for
each of the 33,185 separate requests. . . .

10 Russell Decl., Exs. Y at 10 (pg 16) and Z at 76-77 (pg 120-121).

11 With regard to RFAs Nos. 4-63 in Set No. 5, Oracle seeks specific information regarding
12 each and every file under the specific file paths that were potentially downloaded from an Oracle
13 website.³⁴ Under this folder path alone, there are 3,740,254 files spread over four hard drives (all
14 of which have been produced to Oracle). See Fuchs Decl. ¶ 41. This means that Oracle's RFAs
15 referencing these file paths alone total millions and millions of separate requests.

16 Defendants specifically objected to each of these requests at issue stating:

17 . . . Further, Defendants object to this request as compound and

18 ³⁰ Using Oracle's examples, RFA 13 states: "**For each item** 1-33186 on Exhibit D, admit
19 that a Copy of the listed Fix Object was Created using a Local Environment." Mot. at 28
(emphasis added). Oracle's RFA 130 states: "**For each item** 1-33186 on Exhibit D to Plaintiffs'
20 Third Set of Requests for Admission, admit that Defendants do not have reasonable access to any
readily obtainable information indicating that a Copy of the listed Fix Object was not created
21 using a Local Environment." Mot. at 28-29 (emphasis added).

22 ³¹ Exhibit X to the Russell Decl. only contains the final page of Exhibit D.

23 ³² Defendants' objections across all of the requests vary slightly, but all contain this same
basic language. The full objections and language can be found in Exhibits Y and Z to the Russell
Decl.

24 ³³ Defendants' original objection notes 33,185 separate questions, but as admitted by
Oracle in its Motion, the number is 33,186. See Mot. at 27.

25 ³⁴ RFA 5 states: "**For each file** located in DCITBU01_G\PeopleSoft, as identified in
26 Defendants' responses to Interrogatory 11 from Oracle Corp.'s first set, admit that the file was
originally downloaded from an Oracle website by TN." Russell Decl., Ex. Z at 10-11 (pg 10-11)
(emphasis added). RFA 35 states: "**For each file** located in DCITBU01_G\PeopleSoft, admit that
27 Defendants do not have reasonable access to any readily obtainable information indicating that
the file was not originally downloaded from an Oracle website by TN." Russell Decl., Ex. Z at
28 42-43 (pg 42-43) (emphasis added).

1 unduly burdensome in that this request asks for “each file” and,
2 thus, asks hundreds if not thousands of separate questions and
3 would require the review of substantial amounts of data. This
4 request, therefore, does not separately state each matter sought.
5 Moreover, Defendants object to this request on the basis that
6 Defendants’ burden associated with responding to this request is
7 substantially similar to the burden for Plaintiffs to obtain the
8 information sought through this request, especially because the
9 available documents, data and other information sought from which
10 the answer, if any, could be derived in response to this request have
11 been produced by Defendants in response to Plaintiffs’ other
12 discovery requests and thus any relevant, available information is
13 now as equally accessible to Plaintiffs as it is to Defendants. . . .

14 Russell Decl., Ex. Z at 10-11 (pg 10-11).

15 Oracle’s motion also does not mention that despite the forgoing objection and to extent it
16 was reasonably knowable, Defendants provided a substantive response to these RFAs. For
17 example, in response to RFA 5, Defendants answered as follows:

18 ADMITTED on the following qualified basis: Defendants
19 reasonably believe and thus ADMIT that it is likely that the
20 majority (meaning at least one more than half of the total files) of
21 the files located in DCITBU01_G\PeopleSoft were obtained at
22 some point in time from a PeopleSoft, J.D. Edwards, or Oracle
23 website. Defendants, however, have not undertaken the extreme
24 burden of evaluating each file as this information is as equally
25 accessible to Plaintiffs as it is to Defendants. To the extent this
26 request is not admitted, it is DENIED.

27 Russell Decl., Ex. Z at 11 (pg 11).

28 **3. Rule 26(b)(2)(C) Requires that Oracle’s Requests be Limited and that
Defendants’ Objections be Sustained.**

Oracle seeks (1) information that is unreasonably duplicative of other discovery requests
and information in Oracle’s possession, and (2) to improperly shift the burden of proof to
Defendants with respect to information that is equally accessible to both parties. Defendants’
objections should be sustained, and Oracle’s requests should be denied.

a. Interrogatory 14.

Interrogatory 14, which directly relates to RFAs 13-50 and 130-162, asks for detailed
descriptions of how all environments were used to create, develop and test all objects. *See* Fuchs
Decl. ¶ 36, Ex. C; *see also* D.I. 334 (Defendants’ Opposition to Plaintiffs’ Motion to Compel

1 Production of Documents Related to Damages Model and Interrogatory Responses Related to Use
2 of Plaintiffs' Intellectual Property) ("Defs. Opp.") at 17 (pg 14).³⁵ Defendants objected to the
3 request as unduly burdensome, among other things, and relied on Rule 33(d) citing documents
4 and data already produced and made available to Oracle. Oracle moved to compel further
5 responses to Interrogatory No. 14, arguing in part that such information was necessary to
6 understand TN's "routine business conduct" and the manner in which TN serviced its customers.

7 After full briefing and a hearing, and taking into account the heavy burden imposed by
8 such a request, this Court ordered Defendants to evaluate and provide detailed information about
9 the support provided, including all information relating to how and what environments were used
10 at every stage of the TN support process for the objects associated with only ten master fix
11 records. See D.I. 460. To comply with that order, Defendants expended over 500 attorney hours
12 in examining the environments used for the creation, development, and testing of the objects
13 referenced by each of the ten master fix records. See Fuchs Decl. ¶ 39, Ex. C. This examination
14 involved analyzing data from the SAS and BakTrak databases, TN's servers, deposition
15 testimony, and produced documents. See *id.* ¶ 37, Ex. C. Moreover, this review further revealed
16 that just for the ten example master fix records for which Defendants responded, there were
17 approximately 1,772 objects reasonably believed to be made available to specific customers under
18 those records. See *id.* ¶ 38, Ex. C. Defendants have already satisfied the Court's order to respond
19 to Interrogatory No. 14. Based on the prior time and costs associated with Interrogatory 14,
20 Defendants anticipate having to spend thousands of hours and millions of dollars to respond to the
21 millions of these RFA requests. See *id.* ¶ 40. Oracle has provided no new basis for this Court to
22 impose any further burden on Defendants to evaluate additional information that is equally
23 accessible to Oracle.

24 b. Interrogatory 11.

25 Interrogatory 11, which directly relates to RFAs Nos. 4-63, states "Identify all Software

26
27 ³⁵ Defendants will not restate every argument or resubmit all of the evidence presented in
28 support of its response to Oracle's Motion to Compel on Interrogatory 14. However, Defendants
do incorporate by reference their prior response, all declarations, and supporting evidence
regarding the associated burden cited and submitted in their Opposition. See Defs. Opp.

1 and Support Materials You have Downloaded.” Fuchs Decl. ¶ 41, Ex. D. In responding to this
2 request, Defendants incurred the extreme expense and burden of presenting data from TN’s
3 servers that Defendants reasonably believed was used in servicing TN’s PeopleSoft, J.D. Edwards,
4 and Siebel customers through an electronic “Data Warehouse.” *See id.* In total, Oracle was
5 presented 93 server partitions, consisting of approximately 10.2 terabytes of data for review, and
6 was allowed to select the files it wanted produced. *See id.* Throughout this process, Oracle was
7 able to examine and request production of possible software and support materials that were
8 downloaded by TN on behalf of its customers and kept in a centralized location. *See id.* To
9 respond to this request, relying on Rule 33(d), TN specifically stated “TN is aware of the
10 following specific locations where materials downloaded by TN on behalf of its customers can be
11 located” *Id.* Oracle did not move to compel further responses to this Interrogatory.

12 Oracle’s RFAs 4-63 concern these file paths and ask Defendants whether each file under
13 each file path was originally downloaded from an Oracle website (RFAs 4-33) or not originally
14 downloaded from an Oracle website (RFAs 34-63). As noted above, such a determination would
15 require reviewing and evaluating millions of files, and would take thousands of hours and
16 millions of dollars to complete. *See* Fuchs Decl. ¶ 42. There is no basis for such a heavy burden
17 to be imposed on Defendants when: (a) Oracle has already sought and received more than
18 substantial discovery on this issue; (b) Defendants admitted at the highest level they could (*e.g.*,
19 majority) without conducting a file-by-file review; and (c) Defendants would be required to incur
20 the heavy burden and cost of reviewing the millions of files on top of the extreme expense already
21 incurred to make the data available to Oracle in such a user-friendly format.

22 **4. Defendants do not Seek to “Have It Both Ways” as Oracle Asserts.**

23 Defendants position, as outlined above, is that Defendants have produced more than
24 sufficient documents and data for Oracle to obtain the information sought by RFAs Nos. 13-50 in
25 Set No. 3 and 4-63 and 130-162 in Set No. 5. Defendants have never taken the position that the
26 documents and data that Defendants have produced to Oracle are not “readily obtainable.” What
27 Defendants state in their response to RFA No. 13, for example, is that “the information sought
28 was not tracked, recorded, or maintained by TomorrowNow in a “readily obtainable manner.”

1 Mot. at 28. Defendants do not state as Oracle inaccurately quotes (with no citation) that
2 Defendants “do not have reasonable access to any readily obtainable information”. *Id.*

3 Defendants and Oracle both have reasonable access to readily obtainable information (*i.e.*,
4 the documents and data Defendants have produced to Oracle) from which the information
5 addressed by RFA 13 could, to the extent it is ascertainable, be compiled. Defendants’ objection
6 to RFA 13 is that the ***information sought by that request*** was not tracked, recorded, or
7 maintained in a “readily obtainable manner.” RFA 13 does not seek re-production of the
8 information Defendants have produced to Oracle (*i.e.*, the readily obtainable information), but
9 instead seeks to require Defendants to analyze, compile, abstract and summarize Defendants’
10 production in order to arrive at an answer to the request (*i.e.*, the information that was not tracked,
11 recorded, or maintained by TomorrowNow in a “readily obtainable manner”). Defendants
12 reiterated this very point when responding to RFA 130 by stating that “there is no readily
13 obtainable way to review TomorrowNow’s records and other information to determine for each
14 listed item whether a copy of each listed fix object was not created using a local environment”
15 and that “Defendants have not undertaken the extreme burden of evaluating each item and have
16 objected on that basis because the requested information is as equally accessible to Plaintiffs as it
17 is to Defendants.” Mot. at 29. Thus, both RFA 13 and RFA 130 evidence Oracle’s continued
18 attempt to shift its burden to Defendants by seeking through two RFAs essentially the same
19 information that, to the extent it is ascertainable, is equally accessible to both parties.

20 **IV. CONCLUSION**

21 For all of these reasons, Defendants respectfully request that the Court deny Oracle’s
22 Motion to Modify the Protective Order and to Compel Deposition Testimony and Further
23 Responses to Requests for Admission.

24 Dated: January 5, 2010

JONES DAY

25 By: /s/ Jason McDonell
26 Jason McDonell

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