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12 Attorneys for Plaintiff
 13 STREETSPLACE, INC.

14 UNITED STATES DISTRICT COURT
 15 SOUTHERN DISTRICT OF CALIFORNIA

16 STREETSPLACE, INC., a Delaware
 17 corporation,

18 Plaintiff,

19 vs.

20 GOOGLE INC., a Delaware corporation;
 21 ADMOB, INC., a Delaware corporation;
 22 APPLE INC., a California corporation;
 23 QUATTRO WIRELESS, INC., a Delaware
 24 corporation; NOKIA CORPORATION, a
 25 foreign corporation; NOKIA INC., a
 26 Delaware corporation; NAVTEQ
 27 CORPORATION, a Delaware corporation;
 28 MILLENNIAL MEDIA, INC., a Delaware
 corporation; JUMPTAP, INC., a Delaware
 corporation; and DOES 1 through 20,
 inclusive,

Defendants.

CASE NO. 10-CV-1747-LAB-AJB

**MEMORANDUM OF POINTS AND
 AUTHORITIES IN SUPPORT OF THE
 MOTION BY PLAINTIFF
 STREETSPLACE, INC. TO
 DISQUALIFY COUNSEL FOR
 DEFENDANT MILLENNIAL MEDIA**

Date: March 14, 2011
 Time: 11:15 a.m.
 Judge: Hon. Larry A. Burns
 Ctrm: 9

1 Plaintiff Streetspace, Inc. (“Streetspace”) respectfully submits the following memorandum
2 of points and authorities in support of its motion to disqualify Chris Campbell and the entire law
3 firm of Cooley LLP from representing Defendant Millennial Media, Inc. in this matter on the
4 ground that Mr. Campbell is a former intellectual property partner in the Washington, D.C. office
5 of Hunton & Williams—the *same office* of the *same firm* that prosecuted Streetspace’s patent in
6 this case (U.S. Patent No. 6,847,969 (“the ‘969 patent”)) to issuance—and was a partner with
7 Hunton & Williams for more than the same two-plus year period during which Hunton &
8 Williams prosecuted the ‘969 patent. As such, Mr. Campbell and Cooley LLP are by law
9 conclusively presumed to have confidential information belonging to Streetspace material to this
10 litigation and must therefore be disqualified.

11 **I. INTRODUCTION**

12 This Court is required to disqualify Chris Campbell of Cooley LLP from representing
13 defendant Millennial Media, Inc. in this case because he was a partner in the same office of the
14 same law firm that prosecuted Streetspace’s patent in this case. Specifically, Mr. Campbell was
15 an intellectual property partner in the Washington, D.C. office of Hunton & Williams during
16 precisely the same time period that Streetspace’s ‘969 patent was being prosecuted by Hunton &
17 Williams attorneys there. For that reason, it is conclusively presumed that Mr. Campbell had
18 access to confidential information belonging to Streetspace concerning the patent-in-suit.
19 California law does not require Streetspace to prove that Mr. Campbell had or has any actual
20 knowledge of any Streetspace confidential information in order to disqualify Mr. Campbell.

21 Rather, all that Streetspace must show is that the prosecution of its ‘969 patent is
22 “substantially related” to the present litigation. Whether two matters are substantially related for
23 disqualification purposes depends upon the factual and legal similarities of the former and current
24 representations. Here, the prosecution of the ‘969 patent by Mr. Campbell’s former law firm—
25 Hunton & Williams—is substantially related to this case because both matters involve the very
26 same patent—Streetspace’s ‘969 patent. Consequently, the factual and legal issues involved with
27 prosecuting and litigating the same patent are substantially similar. As just some examples,
28 issues concerning the interpretation of claim terms in the ‘969 patent, the significance of various

1 language in the claims and specification of the ‘969 patent, and the significance of alleged prior
2 art references that Hunton & Williams encountered during prosecution of the ‘969 patent are
3 some of the very same issues the parties and this Court will encounter in this litigation involving
4 the ‘969 patent. Because the prosecution of the ‘969 patent and the present patent infringement
5 action over the ‘969 patent are substantially related, this Court is required by law to *conclusively*
6 presume that Mr. Campbell possesses confidential information belonging to Streetspace. *Flatt v.*
7 *Superior Ct.*, 9 Cal.4th 275, 283 (1995); *San Gabriel Basin Water Quality Authority v. Aerojet-*
8 *General Corp.*, 105 F. Supp. 2d 1095, 1103-04 (C.D. Cal. 2000); *H.F. Ahmanson & Co. v.*
9 *Salomon Bros., Inc.*, 229 Cal.App.3d 1445, 1452 (1991). The law does not inquire into the nature
10 or extent of that knowledge because “only in this manner can the lawyer’s duty of absolute
11 fidelity be enforced and the spirit of the rule related to privileged communications be
12 maintained.” *River West, Inc. v. George W. Nickel*, 188 Cal.App.3d 1297, 1303 (1987).
13 Accordingly, this Court must disqualify Mr. Campbell from representing Millennial Media or any
14 party adverse to Streetspace in this case as a matter of law. Moreover, because confidential
15 information obtained by one lawyer in a law firm is imputed by law to all lawyers within that
16 same firm, this Court must also disqualify the entire law firm of Cooley LLP from representing
17 Millennial Media or any party adverse to Streetspace in this action.

18 **II. STATEMENT OF FACTS**

19 Streetspace’s ‘969 patent was based on a PCT patent application filed on May 3, 2000 and
20 was prosecuted by the law firm Hunton & Williams LLP from approximately January, 2003 to
21 issuance on January 25, 2005. D.E. No. 1, Ex. A. The front page of the ‘969 patent lists Hunton
22 & Williams as the “Attorney, Agent, or Firm.” *Id.* Specifically, attorneys in the Washington,
23 D.C. office of Hunton & Williams prosecuted the ‘969 patent to issuance. Declaration of Trevor
24 Q. Coddington (“Coddington Decl.”), ¶¶ 9-17. Significantly for purposes of this motion, Chris
25 Campbell (currently a partner with Cooley LLP, counsel of record for defendant Millennial
26 Media, Inc. in this action) was a partner in the Washington, D.C. office of Hunton & Williams
27 during precisely the same time period Streetspace’s ‘969 patent was prosecuted there. *Id.*, ¶¶ 5,
28 7-8. Specifically, Chris Campbell was a partner in the Intellectual Property practice of Hunton &

1 Williams from at least approximately January, 2003 when Streetspace became a client of Hunton
2 & Williams through January, 2005 when the '969 patent issued. *Id.*, ¶¶ 5, 12 & Ex. D. Mr.
3 Campbell remained a partner in Hunton & Williams' intellectual property group during the entire
4 time the '969 patent was being prosecuted. *Id.*

5 Trevor Coddington (currently a partner with San Diego IP Law Group LLP, counsel of
6 record for plaintiff Streetspace in this matter) was a patent agent and then later an associate in the
7 Washington, D.C. office of Hunton & Williams at the time when the '969 patent application was
8 prosecuted. *Id.*, ¶ 4. Mr. Coddington personally participated in the prosecution of the '969 patent
9 and participated in meetings of intellectual property attorneys at the Washington, D.C. office of
10 Hunton & Williams to discuss various intellectual property matters and issues, such as the status
11 of patent applications, responses to office actions, and other important issues. *Id.*, ¶ 9. While Mr.
12 Coddington cannot personally recall whether Mr. Campbell actually attended or participated in
13 meetings at which Streetspace or its intellectual property affairs were specifically discussed, it
14 was common practice for attorneys in the Washington, D.C. office of Hunton & Williams to meet
15 regularly to discuss intellectual property clients such as Streetspace and to discuss issues
16 concerning those clients' interests. *Id.*, ¶ 15. Moreover, as a partner in the intellectual property
17 practice of Hunton & Williams, Mr. Campbell was able to act on behalf of any Hunton client with
18 matters pending before the United States Patent & Trademark Office ("PTO") and had access to
19 client files and Streetspace confidential information while he was a partner there. *Id.*, ¶¶ 14, 16.

20 **III. ARGUMENT**

21 **A. Legal Standards**

22 Under Southern District Civil Local Rule 83.4(b), all attorneys who practice before this
23 Court must comply with the standards of professional conduct required of members of the State
24 Bar of California. This Court, therefore, applies California state law in deciding motions to
25 disqualify. *In re Cty. of Los Angeles*, 223 F.3d 990, 995 (9th Cir. 2000). The right to disqualify
26 counsel is a discretionary exercise of this Court's inherent powers. *U.S. v. Wunsch*, 84 F.3d 1110,
27 1114 (9th Cir. 1996). In exercising that discretion, the Court is required to make a reasoned
28 judgment that complies with the legal principles and policies applicable to the case. *Henriksen v.*

1 *Great Am. Savings & Loan*, 11 Cal.App.4th 109, 113 (1992). Discretion will thus be deemed to
2 have been abused if the trial court fails to exercise discretion when such exercise is required. *Id.*;
3 *Truck Ins. Exchange v. Fireman’s Fund Ins. Co.*, 6 Cal.App.4th 1050, 1055 (1992).

4 While clients generally have a right to counsel of their own choosing, that right is not
5 sacrosanct. The “paramount concern must be the preservation of public trust both in the
6 scrupulous administration of justice and in the integrity of the bar.” *Fujitsu Ltd. v. Belkin Intern.,*
7 *Inc.*, 2010 WL 5387920, at *4 (N.D. Cal. Dec. 22, 2010) (citing *State Farm Mut. Auto. Ins. Co. v.*
8 *Federal Ins. Co.*, 72 Cal.App.4th 1422, 1428 (1999)). Consequently, the right to choose one’s
9 counsel “must yield to the ethical considerations that embody the moral principles of our judicial
10 process.” *Id.*

11 **B. This Court Should Disqualify Chris Campbell and Cooley LLP From**
12 **Representing Defendant Millennial Media In This Case**

13 Under Rule 3-310 of the California Rules of Professional Conduct, an attorney “shall not
14 accept employment adverse to a client or former client where, by reason of the representation of
15 the client or former client, the member [attorney] has obtained confidential information material
16 to the employment except with the informed written consent of the client or former client.” Rule
17 3-310(D) (emphasis added). When such a conflict of interest exists, and the former client has not
18 consented to the current representation, disqualification of the attorney is mandatory. *Ahmanson*,
19 229 Cal.App.3d at 1451. The Court may not engage in a “balancing of equities” between the
20 former and current clients; rather, the rights and interests of the former client must prevail. *Id.*
21 (citing *River West*, 188 Cal.App.3d at 1304).

22 When, as here, the potential conflict is one that arises from the successive representation
23 of clients with adverse interests, the chief fiduciary value jeopardized is that of client
24 confidentiality. *Flatt*, 9 Cal.4th at 283. Thus, when a former client seeks to disqualify a previous
25 attorney from serving as counsel to a successive client in litigation adverse to the first client, the
26 first client need only show a “substantial relationship” between the former and current
27 representations. *Id.*; *Global Van Lines, Inc. v. Superior Ct.*, 144 Cal.App.3d 483, 489 (1983)).
28 Importantly, “actual possession of confidential information **need not be proved** in order to

1 disqualify the former attorney.” *Ahmanson*, 229 Cal.App.3d at 1452 (emphasis added). If proof
2 of actual knowledge were required to disqualify former counsel from representing adverse
3 interests, that would “tear[] aside the protective cloak drawn about the lawyer-client relationship.”
4 *Elan Transdermal Ltd. v. Cygnus Therapeutic Systems*, 809 F. Supp. 1383, 1388 (N.D. Cal. 1992)
5 (citing *T.C. Theatre Corp. v. Warner Bros. Pictures*, 113 F. Supp. 265, 269 (S.D.N.Y. 1953)).

6 Under California law, if the former client can establish the existence of a “substantial
7 relationship” between the former and current representations, the court must **conclusively**
8 presume the attorney possesses confidential information adverse to the former client and must
9 disqualify that attorney from representing any party adverse to the former client in the present
10 litigation. *Flatt*, 9 Cal.4th at 283; *San Gabriel*, 105 F. Supp. 2d at 1103-04; *Ahmanson*, 229
11 Cal.App.3d at 1452. Moreover, because the disqualification extends vicariously to the attorney’s
12 entire firm, the court must also disqualify the attorney’s entire firm from representing any party
13 adverse to the former client in the present litigation if the matters are “substantially related.”
14 *Flatt*, 9 Cal.4th at 283 (“the disqualification extends vicariously to the entire firm”); *Henriksen*, 11
15 Cal.App.4th at 117 (“vicarious disqualification of the entire firm is compelled as a matter of law”).

16 Whether a substantial relationship exists depends on (1) the similarities between the two
17 factual situations; (2) the legal questions posed; and (3) the nature and extent of the attorney’s
18 involvement in the former and current representations. *Ahmanson*, 229 Cal.App.3d at 1455;
19 accord *Rosenfeld Const. Co., Inc. v. Superior Ct.*, 235 Cal.App.3d 566, 576 (1991). The Court
20 may also consider whether confidential information material to the current dispute would
21 normally have been imparted to the attorney by virtue of the nature of the former representation.
22 *Ahmanson*, 229 Cal.App.3d at 1454. Application of these factors clearly shows that a “substantial
23 relationship” exists between Mr. Campbell’s former representation of plaintiff Streetspace, Inc.
24 during prosecution of the ‘969 patent and Mr. Campbell’s current representation of defendant
25 Millennial Media in this litigation involving the same patent. Indeed, the former and current
26 representations are simply two sides of the same coin.

27 First, the factual issues involved with prosecution of Streetspace’s patent-in-suit while it
28 was a client of Hunton & Williams when Mr. Campbell was a partner there are substantially

1 similar to those involved with the present litigation. Specifically, the ‘969 patent was prosecuted
2 by the very same Washington, D.C. office of Hunton & Williams in which Mr. Campbell was an
3 intellectual property partner. Coddington Decl., ¶¶ 4-5. Indeed, the ‘969 patent that was
4 prosecuted by Mr. Campbell’s former Hunton & Williams office is the *very same patent* being
5 asserted by Streetspace against Mr. Campbell’s current client, Millennial Media. D.E. No. 1, Ex.
6 A.

7 Second, the legal issues involved with prosecution of Streetspace’s patent are substantially
8 similar to those raised by this patent infringement action. As just some examples, both the
9 prosecution of the ‘969 patent and this patent infringement case involving the ‘969 patent involve
10 (among other things) issues concerning the interpretation of various claim terms, the significance
11 of certain language in the patent specification and claims, the significance of various alleged prior
12 art references, and other such matters. It was common practice for attorneys at Hunton &
13 Williams to discuss these sorts of issues while the ‘969 patent was being prosecuted there.
14 Coddington Decl., ¶ 15. These are precisely some of the same legal issues that the parties and
15 this Court will necessarily confront in this patent infringement case. The first and second factors
16 therefore strongly weigh in favor of disqualifying Mr. Campbell.

17 Third, while the nature and extent of Chris Campbell’s actual involvement with
18 prosecution of Streetspace’s patent-in-suit may be a factor, they must be viewed in the practical
19 context of how information is shared among lawyers in a law firm.¹ Indeed, at any law firm such
20 as Hunton & Williams or Cooley LLP, it is customary for attorneys in the same office (and
21 particularly attorneys in the same practice group) to discuss the nature and status of various issues
22 affecting their clients’ intellectual property rights and to share information with partners and other
23 attorneys in the same office. Certainly, issues concerning the status of clients’ patent prosecution
24 matters and strategy decisions affecting patent rights are among those “normally imparted” to
25 intellectual property attorneys such as Mr. Campbell. *Ahmanson*, 229 Cal.App.3d at 1454. While

26 ¹ It is unclear whether the third factor is relevant to the analysis. At least one case has held that
27 courts will not inquire into the nature and extent of the attorney’s involvement in the former
28 representation for “[o]nly in this manner can the lawyer’s duty of absolute fidelity be enforced
and the spirit of the rule relating to privileged communications be maintained.” *River West*, 188
Cal.App.3d at 1303. Nevertheless, out of abundance of caution, Streetspace will address it here.

1 Mr. Campbell may dispute that any Streetspace confidential information was shared with him,
2 that contention is completely irrelevant. As California courts have observed:

3 “The presumption of shared confidences is based on the common-
4 sense notion that people who work in close quarters talk with each
5 other, and sometimes about their work. It is also common sense
6 that when there is no hard evidence of the subjects of years of
7 office conversation, and firm conversation, and there is a
8 significant amount of business to be gained by not remembering
9 that anything relative to a particular former client’s representation
10 was discussed, there are strong incentives to claim no actual
11 knowledge.”

12 *Elan*, 809 F. Supp. at 1390. Indeed, while Mr. Coddington was an associate in Hunton &
13 Williams’ Washington, D.C. office (where Mr. Campbell was a partner), it was customary for
14 attorneys in the intellectual property group to meet and discuss intellectual property and patent
15 issues regarding clients such as Streetspace. Coddington Decl., ¶ 15. Finally, Mr. Campbell is
16 trial counsel for Defendant Millennial Media and thus will be intimately involved in this case.
17 Therefore, the nature and extent of Mr. Campbell’s involvement in the matters also weigh in
18 favor of disqualifying Mr. Campbell.

19 Streetspace anticipates that Mr. Campbell will argue he was not at all involved in
20 Streetspace patent prosecution matters while he was a partner at Hunton & Williams and that he
21 was unaware of Streetspace’s existence until the filing of this lawsuit. Critically, however, **actual**
22 **possession of confidential information is not required for an order of disqualification.**

23 *Ahmanson*, 229 Cal.App.3d at 1452; *Dill v. Superior Ct.*, 158 Cal.App.3d 301, 304 (1984).
24 Therefore, Mr. Campbell’s expected representation that he “saw nothing, heard nothing and, in
25 fact, know[s] nothing of what transpired” regarding Streetspace when he was a partner at Hunton
26 & Williams where the ‘969 patent was prosecuted to issuance is immaterial and cannot defeat the
27 motion to disqualify. *Elan*, 809 F. Supp. at 1390.

28 The *Elan* case is instructive. There, plaintiff *Elan* brought a patent infringement action
against *Cygnus* involving nicotine patch technology. After *Elan* retained the law firm of *Irell &*
Manella to represent it, *Cygnus* moved to disqualify *Irell & Manella* because it had previously
represented *Cygnus* in connection with patent applications on *Cygnus*’ nicotine patch technology.

1 During that time, Irell provided Cygnus with advice concerning patent “claims that are similar to
2 those before the Court in this [present] action” and advice concerning the “very patent-in-suit.”
3 *Id.* at 1385. For those reasons, the Court disqualified the entire Irell & Manella firm from
4 representing Elan in the subsequent lawsuit, even though the actual attorneys representing Elan
5 may only have billed “only a short period of time” to Cygnus in the previous representation. *Id.*
6 at 1388.

7 Likewise here, the prosecution of Streetspace’s ‘969 patent by the Washington, D.C.
8 office of Hunton & Williams while Mr. Campbell was a partner in that same office is
9 “substantially related” to the present patent infringement action and in fact involves the very same
10 patent-in-suit. Because the two matters are substantially related, this Court must conclusively
11 presume that Mr. Campbell has confidential information belonging to Streetspace and material to
12 this litigation—regardless of how little if any time Mr. Campbell may have billed to the
13 prosecution matter. *Flatt*, 9 Cal.4th at 283; *San Gabriel*, 105 F. Supp. 2d at 1103-04; *Ahmanson*,
14 229 Cal.App.3d at 1452. Accordingly, this Court must disqualify Mr. Campbell from
15 representing defendant Millennial Media in this case. *Ahmanson*, 229 Cal.App.3d at 1451; *River*
16 *West*, 188 Cal.App.3d 1297.

17 Moreover, Mr. Campbell’s presumed knowledge of confidential information belonging to
18 Streetspace is by law imputed to all members of his law firm. Accordingly, this Court must also
19 disqualify the entire firm of Cooley LLP from representing Millennial Media or any party adverse
20 to Streetspace in this case. *Id.*; *Elan*, 809 F. Supp. at 1390 n.11 (“**the presumption that the prior**
21 **attorney’s firm possesses confidential information is also ‘conclusive’**) (*citing Rosenfeld*, 235
22 Cal.App.3d at 577) (emphasis added)). Cooley LLP’s anticipated protestation that none of its
23 attorneys has actual knowledge of any Streetspace confidential information is irrelevant and must
24 be disregarded. As California courts have held, there is “no authority that supports the notion that
25 standing alone, the present recollection of the members of the firm is an adequate criterion.”
26 *Elan*, 809 F. Supp. at 1390 (*citing Rosenfeld*, 235 Cal.App.3d at 576)).

27 **IV. CONCLUSION**

28 For all the foregoing reasons, the prosecution of Streetspace’s ‘969 patent by Hunton &

1 Williams while Chris Campbell was a partner there is “substantially related” to the present patent
2 infringement action involving the ‘969 patent. This Court, therefore, must conclusively presume
3 that Mr. Campbell possesses confidential information material to this case and must therefore
4 disqualify Mr. Campbell from representing Millennial Media, Inc. in this action. Further, because
5 confidential information obtained by one member of a law firm is by law imputed to all members
6 of that same firm, this Court must also disqualify Cooley LLP from representing Millennial
7 Media, Inc. or any party adverse to Streetspace in this case. *Rosenfeld*, 235 Cal.App.3d at 573;
8 *Elan*, 809 F. Supp. at 1390 n.11. This firm-wide disqualification is mandatory even if Cooley
9 LLP proclaims it will take “measures to insulate” Mr. Campbell “from any involvement in the
10 current litigation.” *Henriksen*, 11 Cal.App.4th at 111; *Dill*, 158 Cal.App.3d at 304.

11 Dated: January 28, 2011

SAN DIEGO IP LAW GROUP LLP

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13 By: /s/James V. Fazio, III

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