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 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-1757-LAB-AJB

**REPLY 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 reply
2 memorandum of points and authorities in support of its motion to disqualify Chris Campbell and
3 the entire law firm of Cooley LLP from representing Defendant Millennial Media, Inc.
4 (“Millennial Media”) in this matter on the ground that Mr. Campbell is a former intellectual
5 property partner in the Washington, D.C. office of Hunton & Williams (“Hunton”) —the *same*
6 *intellectual property group* of the *same office* of the *same firm* that prosecuted Streetspace’s
7 patent in this case (U.S. Patent No. 6,847,969 (“the ‘969 patent”)) to issuance. Simply put, Mr.
8 Campbell’s prior involvement with Hunton’s IP group – a group tasked with vigorously
9 advocating and advancing the patent rights of its clients – should prohibit him from representing
10 Millennial Media whose interests are adverse and polar opposite to the patent rights of former
11 Hunton client and plaintiff Streetspace.

12 **I. INTRODUCTION**

13 Contrary to Millennial Media’s false representation, Mr. Campbell did work out of the
14 same Washington, D.C. office of Hunton & Williams where the patent-in-suit was prosecuted—
15 not just its McLean, Virginia office.¹ Attached as Exhibits A, B & C to the Reply Declaration of
16 Trevor Q. Coddington are excerpts of three briefs listing Mr. Campbell as part of Hunton’s
17 Washington, D.C. office. Indeed, Mr. Campbell worked out of the Washington, D.C. office on
18 regular occasions in the 2003-2005 timeframe when the ‘969 patent was being prosecuted there.
19 Further, contrary to another of Mr. Campbell’s false representations, Mr. Coddington **reported**
20 **directly** to Mr. Campbell on at least one occasion and in fact prepared work product for Mr.
21 Campbell while he was an associate in Hunton’s Washington, D.C. office and working out of
22 Hunton’s McLean, VA office. Mr. Coddington is in possession of a memorandum prepared by
23 Mr. Coddington for Mr. Campbell that can be submitted to the Court *in camera* if it so requests.

24 Even more tellingly, Millennial Media completely ignores the California Supreme Court
25 *en banc* decision in *Flatt v. Superior Ct.*, 9 Cal.4th 275 (1994), which has not been overruled or

26 ¹ Hunton’s McLean, VA office is located roughly 12 miles from Hunton’s DC office. The patent groups
27 in these two offices were treated effectively as one because patent attorneys in each office worked on the
28 same matters, shared the same resources, shared the same paralegal personnel, followed the same general
patent procurement and litigation procedures, and even held firm meetings such as seminars and holiday
parties together. Reply Coddington Decl., ¶¶ 2, 5. -1-

1 limited in any way, and which stands for the rule that when, as here, the former and current
2 representations at issue are “substantially related,” the Court must conclusively presume that Mr.
3 Campbell has knowledge of confidential Streetspace information material to this case and must
4 therefore disqualify him. Both the prosecution and litigation of the ‘969 patent involve (among
5 other things) issues concerning the interpretation of various claim terms, the significance of
6 certain language in the patent specification and claims, and the significance of various alleged
7 prior art references. Because the former and current representations are substantially related, Mr.
8 Campbell is conclusively presumed to have knowledge of confidential Streetspace information
9 material to this case and must therefore be disqualified. Campbell’s assertion that he does not
10 possess any Streetspace confidential information is not only completely self-serving, but
11 irrelevant in view of *Flatt*. Moreover, because Mr. Campbell’s knowledge of confidential
12 information is by law imputed to all members of his firm, “**the disqualification extends**
13 **vicariously to the entire firm**” of Cooley LLP. *Flatt*, 9 Cal.4th at 283 (emphasis added).

14 In an apparent attempt to distract this Court’s attention from *Flatt* and several other cases
15 that the opposition also ignores, and instead citing *Adams v. Aerojet-General Corp.*, 86
16 Cal.App.4th 1324, 1340 (2001) and other lower court decisions, Millennial Media argues that
17 because Mr. Campbell did not personally represent Streetspace, this Court should apply a
18 “modified” substantial relationship test under which the court must determine whether
19 confidential information material to the current representation is of a type that “would normally
20 have been imparted to the attorney during his tenure at the old firm.” Critically, neither *Flatt* nor
21 any other California Supreme Court case Streetspace can find endorses this “modified version” of
22 the substantial relationship test.²

23 ² Mr. Campbell is a member of the Virginia state bar and is appearing here *pro hac vice*. Courts
24 interpreting Virginia’s ethical rules as they relate to former client conflicts follow the general principles
25 enunciated in *Flatt*. See, e.g., *Sunbeam Products, Inc. v. Hamilton Beach Brands, Inc.*, 727 F. Supp. 2d
26 469, 472 (E.D. Va. 2010) (“Once an attorney-client relationship has been established, **an irrebuttable**
27 **presumption arises that confidential information was conveyed to the attorney in the prior matter;**
28 **the moving party does not have the evidentiary burden of showing actual disclosure of confidence.**”)
(internal citations omitted) (emphasis added). “Our Court of Appeals has directed that **ethical rules are**
not to be applied ‘with hair splitting nicety,’ but, rather ‘with the view of preventing ‘the appearance of
impropriety,’ [the Court] is to resolve all doubts in favor of disqualification.” *Id.* (quoting *Sanford v.*
Virginia, 687 F.Supp.2d 591, 602 (E.D.Va. 2009)) (quoting *United States v. Clarkson*, 567 F.2d 270, 273
n.3 (4th Cir. 1977))(emphasis added).

1 Regardless, even under this test, Mr. Campbell and Cooley should still be disqualified. In
2 determining whether the former client’s confidential information is of a type that would normally
3 have been imparted to the attorney facing disqualification, courts consider (1) any time spent by
4 the attorney working on behalf of the former client; (2) the attorney’s possible exposure to
5 formulation of policy or strategy in matters relating to the current dispute; (3) whether the
6 attorney worked out of the same branch office that handled the former representation; and (4)
7 whether his administrative or management duties may have placed him in a position where he
8 would have been exposed to matters relevant to the current dispute. Even under this “modified”
9 test, disqualification is still required because:

- 10 (1) confidential Streetspace information material to this litigation, such as firm
11 procedures for responding to Office Actions and procedures for disclosing alleged
12 prior art references to the United States Patent & Trademark Office, as well as
13 client billing and preferences, are precisely the type of confidential information
14 belonging to clients like Streetspace *that is normally imparted to partners like
15 Mr. Campbell within intellectual property groups at law firms such as Hunton &
16 Williams;*
- 17 (2) contrary to his false representation, Mr. Campbell appeared and worked on regular
18 occasions out of the same Washington, D.C. office of Hunton & Williams that
19 prosecuted the ‘969 patent to issuance;
- 20 (3) contrary to his false representation, Mr. Coddington reported to Mr. Campbell and
21 Mr. Campbell supervised and critiqued the work product of Mr. Coddington; and
- 22 (4) As one of only 5 or 6 patent attorney partners in electrical engineering-type cases
23 in Hunton’s Washington, D.C. office, Mr. Campbell’s “administrative or
24 management duties” unquestionably “*placed him in a position where he would
25 have been exposed to matters relevant to the current dispute,*” such as firm
26 procedures for responding to Office Actions and procedures for disclosing alleged
27 prior art references to the United States Patent & Trademark Office, as well as
28 client billing and preferences.

29 In short, even if this Court were to apply the modified substantial relationship test as set
30 forth in *Adams*, Mr. Campbell should be disqualified from representing Millennial Media or any
31 party in this matter. Moreover, in accordance with the California Supreme Court decision in
32 *Flatt*, that disqualification extends vicariously to the entire law firm of Cooley LLP.

1 **II. ARGUMENT**

2 **A. The “Substantial Relationship Test” Enunciated by the California Supreme**
3 **Court in *Flatt v. Superior Ct.*, 9 Cal.4th 275 (1994) Applies.**

4 Tellingly, Millennial Media completely ignores the seminal California Supreme Court *en*
5 *banc* decision in *Flatt v. Superior Ct.*, 9 Cal.App.4th 275 (1994)—and the only California
6 Supreme Court case cited by either party--which remains good law and which stands for the rule
7 that when, as here, the subjects of the former and current representations are “substantially
8 related” (which Millennial Media does not and cannot dispute), “access to confidential
9 information by the attorney in the course of the first representation (relevant, by definition, to the
10 second representation) is *presumed* and disqualification of the attorney’s representation of the
11 second client is **mandatory; indeed, the disqualification extends vicariously to the entire**
12 **firm.**” *Flatt*, 9 Cal.4th at 283 (emphasis in italics in original) (emphasis in bold added) (*citing*
13 *Rosenfeld Const. Co., Inc. v. Superior Ct.*, 235 Cal.App.3d 566, 575 (1991) (“if a substantial
14 relationship is established, the discussion should ordinarily end. The rights and interest of the
15 former client will prevail. Conflict would be presumed; disqualification will be ordered.”);
16 *Henriksen v. Great Am. Sav. & Loan*, 11 Cal.App.4th 109, 117 (1992) (“where an attorney is
17 disqualified because he formerly represented and therefore possesses confidential regarding the
18 adverse party in the current litigation, vicarious disqualification of the entire firm is compelled as
19 a matter of law.”).³ *Flatt* has not been overruled or limited in any way, and neither *Flatt* nor any
20 other California Supreme Court case that Streetspace can find endorses the so-called “modified”
21 substantial relationship test that Millennial Media urges here.

22 Whether a substantial relationship exists depends on (1) the similarities between the two
23 factual situations; (2) the legal questions posed; and (3) the nature and extent of the attorney’s
24 involvement in the former and current representations. *H.F. Ahmanson & Co. v. Salomon Bros.,*
25 *Inc.*, 229 Cal.App.3d 1445, 1455 (1991); *accord Rosenfeld*, 235 Cal.App.3d at 576. The Court
26 may also consider whether confidential information material to the current dispute would

27 ³ Likewise, Millennial Media completely ignores and fails to address *Rosenfeld* or *Henriksen* in its
28 opposition, both of which remain good law.

1 normally have been imparted to the attorney by virtue of the nature of the former representation.
2 *Ahmanson*, 229 Cal.App.3d at 1454.

3 Here, Milliennial Media does not dispute (nor can it) that the factual and legal issues
4 involved with prosecution of Streetspace’s ‘969 patent are “substantially related” to those raised
5 by the present litigation over the same patent. Both the prosecution and litigation of the ‘969
6 patent involve (among other things) the validity of the ‘969 patent, e.g., issues concerning the
7 interpretation of various claim terms, the significance of certain language in the patent
8 specification and claims, and the significance of various alleged prior art references, as well as
9 client billing, preferences, and strategic decision-making.

10 In short, the “substantial similarity” test as articulated by the California Supreme Court in
11 *Flatt* has not been jettisoned by any case and remains applicable. Because Hunton’s prosecution
12 of the ‘969 patent while Mr. Campbell was a patent litigation and prosecution partner there is
13 substantially similar to this litigation, the Court must conclusively presume that Mr. Campbell
14 had access to confidential Streetspace information material to this dispute and must therefore
15 disqualify Mr. Campbell from representing Millennial Media or any party in this matter. Further,
16 that “**disqualification extends vicariously to the entire firm**” of Cooley LLP. *Flatt*, 9 Cal.4th at
17 283 (emphasis added). Hair-splitting investigation into Mr. Campbell’s memory and his direct
18 involvement with Streetspace is not necessary in view of *Flatt*.

19 **B. Even If The “Modified Substantial Relationship” Test Were to Apply, Mr.**
20 **Campbell and Cooley LLP Should Still Be Disqualified**

21 Blatantly ignoring *Flatt* and instead citing *Adams v. Aerojet-General Corp.*, 86
22 Cal.App.4th 1324, 1340 (2001) and other lower court cases (which have no effect on *Flatt*),
23 Millennial Media argues that the “substantial relationship” test applies only when the movant
24 adequately shows that “the attorney was *in a position vis-à-vis the client to likely have acquired*
25 confidential information material to the current representation.” *Adams*, 86 Cal.App.4th at 1340;
26 *Ochoa*, 146 Cal.App.4th at 908 (emphasis added). Because Mr. Campbell supposedly had no
27 direct involvement with Streetspace, Millennial Media argues that a “modified” version of the
28 substantial relationship test should apply.

1 Importantly, however, neither *Adams* nor *Ochoa* require an affirmative showing that
2 confidential information was *actually* provided to the attorney in order to disqualify him—
3 perhaps because the courts in *Adams* and *Ochoa* recognized (as did the Northern District of
4 California in *Elan*) that an attorney facing disqualification naturally has “strong incentives to
5 claim no actual knowledge.” *See Elan Transdermanl Ltd. v. Cygnus Therapeutic Systems*, 809 F.
6 Supp. 1383, 1390 (N.D. Cal. 1992). Instead, “once the attorney is shown to have ***had probable***
7 ***access*** to former client confidences, the court ***will impute such knowledge to the entire firm***,
8 prohibiting all members of the firm from participating in the case.” *Adams*, 86 Cal.App.4th at
9 1333 (emphasis added).

10 In determining whether Mr. Campbell had “probable access” (not certain access) to
11 confidential Streetspace information, the Court should further consider (1) any time spent by the
12 attorney working on behalf of the former client; (2) the attorney’s possible exposure to
13 formulation of policy or strategy in matters relating to the current dispute; (3) whether the
14 attorney worked out of the same branch office that handled the former representation; and (4)
15 “whether his administrative or management duties may have placed him in a position where he
16 would have been exposed to matters relevant to the current dispute.” *Id.* Here, all but possibly
17 one of these factors actually support disqualification of Mr. Campbell and Cooley LLP.⁴

18 First, while Mr. Campbell represents that he has not billed a “second of time” to
19 Streetspace,

20 ***“The presumption of shared confidences is based on the***
21 ***common-sense notion that people who work in close quarters talk***
22 ***with each other, and sometimes about their work.*** It is also
23 common sense that when there is no hard evidence of the subjects
24 of years of office conversation, and firm conversation, and there is
25 a significant amount of business to be gained by not remembering
26 that anything relative to a particular former client’s representation
27 was discussed, ***there are strong incentives to claim no actual***

26 ⁴ Millennial Media’s citation to *Dieter v. Regents of the Univ. of Calif.*, 963 F. Supp. 908 (E.D. Cal. 1997),
27 is unavailing. There, the court refused to disqualify three former attorneys with a law firm largely because
28 they “worked out of the San Francisco office, as opposed to the Palo Alto office, which had” the former
clients’ accounts. *Id.* at 912. In contrast here, and contrary to his representation to this Court, Mr.
Campbell worked at least in part out of Hunton & Williams’ Washington, D.C. office and filed briefs out
of Hunton’s Washington, D.C. office. Reply Coddington Decl., ¶¶ 5, 8 & Exs. A, B, and C.

knowledge.”

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2 *Elan*, 809 F. Supp. at 1390 (emphasis added). In light of the falsity of Mr. Campbell’s other
3 representations regarding his work with Mr. Coddington and the location of his office, and the
4 obviously “strong incentives to claim no actual knowledge,” it is not entirely clear whether this
5 factor definitively weighs against disqualification.

6 Second, Mr. Campbell was likely exposed to the formulation of policy or strategy in
7 matters relating to this dispute. Indeed, while Mr. Coddington was a patent agent and later an
8 associate in Hunton & Williams’ Washington, D.C. office (where Mr. Campbell was a partner), it
9 was customary for attorneys in the intellectual property group to meet and discuss general
10 intellectual property and patent issues regarding Hunton clients such as Streetspace. D.E. No. 29
11 [Coddington Decl., ¶ 15]. From approximately January, 2003 to January, 2005 when the ‘969
12 patent issued, there were only 11 or 12 patent litigation and prosecution partners (of 20 or 21 total
13 patent litigation and prosecution attorneys) in the intellectual property practice of Hunton &
14 Williams’ Washington, D.C. office. Reply Coddington Decl., at ¶ 6. Thus, contrary to Millennial
15 Media’s suggestion, it is not as though Hunton & Williams in the early 2000s were a behemoth
16 law firm with thousands of attorneys in discrete offices who never worked or communicated with
17 one another. Rather, the intellectual property practice group in Hunton & Williams’ Washington,
18 D.C. office was very much a “firm within a firm,” consisting of 4 or 5 electrical patent partners.
19 *Id.*, at ¶ 6. Moreover, although Mr. Campbell denies accessing any Streetspace files, that is
20 irrelevant: as a partner, Mr. Campbell undeniably had “probable access” to Hunton’s central
21 database of confidential client documents and Streetspace files. *Adams*, 86 Cal.App.4th at 1340.
22 In short, as **one of only 4 or 5** intellectual property partners in electrical cases at Hunton’s
23 Washington, D.C. office, Mr. Campbell was likely if not certainly exposed to the formulation of
24 policy or strategy regarding intellectual property clients such as Streetspace. *See Adams*, 86
25 Cal.App.4th at 1340; *Ochoa*, 146 Cal.App.4th at 908. This factor therefore strongly supports
26 disqualification.

27 Third, contrary to Mr. Campbell’s representation, he **did** work out of the same
28 Washington, D.C. branch office of Hunton & Williams that prosecuted the ‘969 patent. Attached

1 as Exhibits A, B, and C to the Reply Coddington Declaration are excerpts from three Hunton
2 briefs listing Mr. Campbell as part of Hunton’s Washington, D.C. office. Indeed, while Mr.
3 Campbell’s Washington, D.C. telephone number may have been forwarded to his McLean,
4 Virginia office, Mr. Campbell personally appeared and worked in the Washington, D.C. on
5 regular occasions during the time when the ‘969 patent was being prosecuted there. Reply
6 Coddington Decl., ¶ 8. This factor therefore also supports disqualification.

7 Finally, as one of only a few partners in the intellectual property practice group of the
8 Washington, D.C. office of Hunton, Mr. Campbell’s administrative and management duties
9 unquestionably placed him in a position where he would have been exposed to matters relevant to
10 the current dispute. As a partner, Mr. Campbell had access to Hunton’s central database of client
11 documents, billing records, and other information. D.E. No. 29 [Coddington Decl., ¶ 15].
12 Regardless of whether any showing of actual knowledge of confidential information has been
13 made (and none is required), it simply strains credulity to believe that partners in a specialized
14 practice group would not have communicated about such matters as the status of ongoing patent
15 prosecution matters, billing and budget issues, and client preferences – all of which are highly
16 relevant to this dispute.

17 In short, even if the modified substantial relationship test stated in *Adams* were to apply,
18 Mr. Campbell had “probable access” to confidential Streetspace information material to this
19 dispute. *Adams*, 86 Cal.App.4th at 1333. Further, the confidential Streetspace information as
20 noted above is of a type that would “normally have been imparted” to Mr. Campbell as one of just
21 4 or 5 electrical patent partners in Hunton’s Washington, D.C. office. *Id.* Accordingly, Mr.
22 Campbell should be disqualified even under *Adams*. Moreover, in accordance with the California
23 Supreme Court decision in *Flatt* and even the cases cited by Millennial Media, “**the**
24 **disqualification extends vicariously to the entire firm.**” *Flatt*, 9 Cal.4th at 283 (emphasis
25 added); *see also Adams*, 86 Cal.App.4th at 1333 (“once the attorney is shown to have had
26 probable access to former client confidences, the court will *impute such knowledge to the entire*
27 *firm, prohibiting all members of the firm* from participating in the case.”) (emphasis added).
28 This firm-wide disqualification is mandatory because of “the practical impossibility of a private

1 law firm creating an ‘ethical wall’ around an attorney who has been exposed to confidential
2 information about the former client . . .” *Adams*, 86 Cal.App.4th at 1333.

3 **C. Millennial Media Will Suffer Little if any Prejudice From Disqualification**

4 No scheduling order has been entered in this case, no Rule 26 dates have been set, and no
5 discovery has commenced. Indeed, none of the Defendants has even filed an answer in this case.
6 Thus, contrary to Millennial Media’s mistaken argument, disqualification of its chosen counsel at
7 this very early stage of the litigation would not unduly prejudice Millennial Media. *See In re*
8 *Complex Asbestos Litig.*, 232 Cal.App.3d 572, 600-01 (1991) (holding that the disqualification of
9 the defendant’s knowledgeable counsel of its choice, even on the eve of trial, was “not the type of
10 prejudice” that should result in denial of the motion to disqualify) (*citing Western Continental*
11 *Operating Co. v. Natural Gas Corp.*, 212 Cal.App.3d 752, 763-64 (1989)).

12 **III. CONCLUSION**

13 For all the foregoing reasons, this Court must conclusively presume that Mr. Campbell
14 possesses confidential Streetspace information material to this case and must therefore disqualify
15 Mr. Campbell from representing Millennial Media, Inc. in this action. Further, because
16 confidential information obtained by one member of a law firm is by law imputed to all members
17 of that same firm, this Court must also disqualify Cooley LLP from representing Millennial
18 Media, Inc. or any party adverse to Streetspace in this case. *Flatt*, 9 Cal.4th at 283; *Rosenfeld*, 235
19 Cal.App.3d at 573; *Elan*, 809 F. Supp. at 1390 n.11. This firm-wide disqualification is mandatory
20 even if Cooley LLP proclaims it will take “measures to insulate” Mr. Campbell “from any
21 involvement in the current litigation.” *Henriksen*, 11 Cal.App.4th at 111; *Dill*, 158 Cal.App.3d at
22 304, neither of which Millennial Media rebuts or even addresses in its opposition.

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Dated: March 7, 2011

SAN DIEGO IP LAW GROUP LLP

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