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24 **UNITED STATES DISTRICT COURT**
 25 **NORTHERN DISTRICT OF CALIFORNIA**
 26 **SAN JOSE DIVISION**

27 IN RE SUBPOENA TO BAYTSP, INC.
 28 VIACOM INTERNATIONAL INC., *et al.*,
 Plaintiffs,

v.

YOUTUBE, INC., *et al.*,
 Defendants.

THE FOOTBALL ASSOCIATION PREMIER
 LEAGUE LIMITED, *et al.*,
 Plaintiffs,

v.

YOUTUBE, INC. *et al.*,
 Defendants.

CASE NO.: 08-MC-80211 JF (PVTx)

**JOINT BRIEF REGARDING COURT'S
 AUTHORITY TO ISSUE PROTECTIVE
 ORDER**

(S.D.N.Y. Case Nos. I :07-cv-021 03 (LLS)
 (FM); I :07-cv-3582 (LLS) (FM))
 Judge: Honorable Patricia V. Trumbull

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of Civil Procedure, 139 F.R.D. 197 (1992)4

1 [Proposed] Stipulated Pretrial Protective Order, as modified by the Court's July 2, 2009 *sua*
2 *sponte* Order and attached hereto as Exhibit A.

3 PROCEDURAL HISTORY

4 On September 27, 2007, YouTube served a subpoena *duces tecum* on nonparty BayTSP
5 (the "BayTSP Subpoena"). After BayTSP served objections, YouTube filed a motion to compel
6 production on October 20, 2008. A hearing was held December 9, 2008 before the Honorable
7 Patricia V. Trumbull, United States Magistrate Judge. On January 14, 2009, Judge Trumbull
8 entered an order granting the motion to compel, ordering the parties to meet and confer regarding
9 "a stipulated protective order to address BayTSP's [confidentiality] concerns about its source
10 code and non-Viacom related entities," and allowing the parties to agree that such a protective
11 order could "govern from this district." Order Granting YouTube's Motion to Compel (the
12 "Document Production Order") at 11, Docket #19, January 14, 2009.

13 On January 29, 2009, BayTSP filed its Objection to the Document Production Order. *See*
14 Docket #20, January 29, 2009. On April 24, 2009, the Court, the Honorable Jeremy Fogel
15 presiding, entered an order overruling BayTSP's objection to the Document Production Order.
16 *See* Order Overruling Objection to Magistrate Judge's Order Dated January 14, 2009, Docket
17 #27, April 24, 2009 (the "April 24 Order"). The April 24 Order noted that a "protective order
18 should be adequate to address any confidentiality concerns BayTSP may have." *Id.* At 2-3.
19 Accordingly, on June 30, 2009, the parties filed a proposed protective order to safeguard the
20 confidentiality of documents produced pursuant to the BayTSP Subpoena. *See* [Proposed]
21 Stipulated Pre-Trial Protective Order, Docket #30, June 30, 2009.

22 On July 2, 2009, the Court issued its *sua sponte* order calling on the parties to:

23 brief whether this court may enter a stipulated pretrial protective
24 order in the above-captioned action in light of its pendency in
25 another district and the language set forth in Rule 26(c)(1) ("A
26 party from whom discovery is sought may move for a protective
27 order in the court where the action is pending – or as an alternative
28 on matters relating to deposition, in the court for the district where
the deposition will be taken."). In the order granting defendant
YouTube's motion to compel dated January 14, 2009, the court
had stated that the parties may agree that a stipulated protective
order relating to BayTSP's other clients shall govern from this
district. ("January 14, 2009 Order"). Upon further consideration,

1 Given that Rule 45(c)(3) was expressly intended to be co-extensive with Rule 26(c), the
2 issuing court has the power to enter protective orders relating to its subpoenas, just as it has the
3 power to enforce, quash, modify, or condition its subpoenas. *See* Fed. R. Civ. P. 45, advisory
4 committee notes, 1991 Amendment Subdivision (c) (“Paragraph (c)(3) explicitly authorizes the
5 quashing [or modification or conditioning] of a subpoena as a means of protecting a witness
6 from misuse of the subpoena power. It ... tracks the provisions of Rule 26(c). While largely
7 repetitious, this rule is addressed to the witness who may read it on the subpoena, where it is
8 required to be printed by the revised paragraph (a)(1) of this rule.”).³ Indeed, many courts have
9 recognized the need to read the two rules together in determining their authority to protect
10 nonparty subpoena recipients, whether by motion to quash or motion for protective order. *See*,
11 *e.g.*, *Peterson v. Douglas County Bank & Trust Co.*, 940 F.2d 1389, 1391 (10th Cir. 1991)
12 (reading Rule 45 in conjunction with Rule 26(c) as granting both the issuing court and the court
13 where the underlying action is pending authority over discovery subpoenas); *Socialist Workers*
14 *Party v. Att’y Gen. of the United States*, 73 F.R.D. 699, 701 (D. Md. 1977) (same). *See also U.S.*
15 *ex rel. Pogue v. Diabetes Treatment Ctrs. of Am., Inc.*, 444 F.3d 462, 469 n.4 (6th Cir. 2006)
16 (interpreting provision of multidistrict litigation statute, 28 U.S.C. § 1407(b), consistent with
17 Rules 26(c) and 45, such that reference to “pretrial *depositions*” would apply equally “to both
18 deposition subpoenas and documents-only subpoenas”) (emphasis added).

19 Accordingly, a nonparty subpoena recipient may seek from the issuing court a protective
20 order under Rule 26(c) as an alternative to a motion to modify or quash the subpoena under Rule
21 45(c)(3), and the same result may be accomplished through either procedural route. *See, e.g.*,
22 *Micro Motion, Inc. v. Kane Steel Co., Inc.*, 894 F.2d 1318, 1322-23 (Fed. Cir. 1990) (nonparty
23 served with document subpoena may seek relief by moving either to quash under Rule 45(c) or
24 for protective order under Rule 26(c)); *U.S. v. Star Scientific, Inc.*, 205 F. Supp. 2d 482, 484 n.2
25 (D. Md. 2002) (same). Since there is no doubt this Court has the power to modify the BayTSP

26 _____
27 ³ *See also* David D. Siegel, *Federal Subpoena Practice Under the New Rule 45 of the Federal Rules of Civil*
28 *Procedure*, 139 F.R.D. 197, 233 (1992) (“The citation to Rule 26(c) in the revisors’ notes will make it easy to import
for application on a motion to quash or modify under Rule 45 just about everything that would support a vacating,
quashing, modifying, conditioning, *or other protection* under [Rules 26-37].”) (emphasis added).

1 Subpoena or to specify the conditions under which the documents are to be produced pursuant to
2 Rule 45(c)(3), it follows that this Court can also establish those conditions by means of a
3 protective order under Rule 26(c), as the parties seek herein. Indeed, as the Sixth Circuit has
4 emphasized, “the Federal Rules are designed to ensure that district courts remain firmly in
5 control of those depositions and document productions involving nonparties located in their
6 districts.” *Pogue*, 444 F.3d at 468.

7 Moreover, pursuant to Rule 1, this Court should enter the BayTSP Protective Order to
8 avoid the unnecessary expense and risk of inconsistent rulings that would result if the parties
9 were required to have the Order entered in the Southern District of New York. Rule 1 provides
10 that the Federal Rules of Civil Procedure “should be construed and administered to secure the
11 just, speedy, and inexpensive determination of every action and proceeding.” Because this Court
12 has already issued its January 14, 2009 Document Production Order, any future questions as to
13 the scope of, or compliance with, that Order must be litigated in this Court. Entry of the BayTSP
14 Protective Order in this Court will allow for “the just, speedy, and inexpensive” resolution of any
15 potential disputes that may arise with respect to BayTSP’s production. Otherwise, discovery
16 disputes relating to the BayTSP production would have to be litigated in two different forums,
17 with the Document Production Order being interpreted and enforced by this Court and the
18 Protective Order being interpreted and enforced by the trial court. Accordingly, the BayTSP
19 Protective Order should be entered in this Court.

20 **II. AS EVIDENCED BY ITS LEGISLATIVE HISTORY, RULE 26(C)(1) APPLIES**
21 **TO DOCUMENT SUBPOENAS AS WELL AS TO DEPOSITION SUBPOENAS**

22 Although Rule 26(c)(1) refers on its face to protective orders being sought from “the
23 court for the district where the deposition will be taken,” several courts have recognized that the
24 rule applies to document subpoenas as well. *See, e.g., Micron Tech., Inc. v. Tessera, Inc.*, 2006
25 WL 1646132, at *3 (N.D. Cal. Jun. 14, 2006) (granting motion to compel discovery pursuant to a
26 document subpoena and noting that “[i]f there is not an existing [protective] order entered in the
27 Texas court which will serve, this court can provide one.”); *In re Bextra and Celebrex Mktg.*
28 *Sales Practices and Prod. Liab. Litig.*, 249 F.R.D. 8 (D. Mass. 2008) (granting motion for

1 protective order relating to document subpoena served on nonparties in Massachusetts where
2 underlying litigation was pending in Northern District of California); *Kearney v. Jandernoa*, 172
3 F.R.D. 381, 383 n.4 (N.D. Ill. 1997) (holding that motion for protective order and to quash
4 document subpoena must be decided by the court that issued the subpoena); *see also Star*
5 *Scientific*, 205 F. Supp. 2d at 485 (“Rule 26(c), governing protective orders, expressly permits
6 flexibility in cases in which discovery disputes involve multiple courts.”). These holdings are
7 firmly supported by the legislative histories of Rule 26 and Rule 45, as explained below.

8 In 1970, Rule 26(c)(1) was amended to allow protective orders to be filed in the court
9 issuing a subpoena. *See Lampshire v. Procter & Gamble Co.*, 94 F.R.D. 58, 59 (N.D. Ga. 1982).
10 But at that time, Rule 45 did not allow federal courts to subpoena documents from nonparties,
11 except in connection with a deposition. *See Fed. R. Civ. P. 45* (1990); *Turner v. Parsons*, 596 F.
12 Supp. 185, 186 (E.D. Pa. 1984) (“Certainly, this rule permits a non-party to be subpoenaed for a
13 deposition. Additionally, this non-party can be required to bring certain documents to a
14 deposition. Nowhere in the rule is it stated that documents can be subpoenaed alone, that is,
15 without requesting their production in conjunction with a deposition or trial”). Therefore, at the
16 time of Rule 26(c)(1)’s amendment in 1970, *all* discovery subpoenas were deposition subpoenas,
17 whether or not they also commanded the production of documents. The use of the word
18 “deposition” in the amended rule merely reflected the state of the law and did not limit the
19 application of Rule 26 in any way.

20 In 1991, Rule 45 was amended to allow the issuance of documents-only subpoenas. *See*
21 *Fed. R. Civ. P. 45*, advisory committee notes, 1991 Amendment Subdivision (a) (“Fourth,
22 Paragraph (a)(1) authorizes the issuance of a subpoena to compel a nonparty to produce evidence
23 independent of any deposition. This revision spares the necessity of a deposition of the
24 custodian of evidentiary material required to be produced.”); *Federal Subpoena Practice, supra*
25 *n.2*, 139 F.R.D. at 205-206 (“Under the new Rule 45, a subpoena *duces tecum* seeking the
26 production of documents (or other materials) from a nonparty may be used independently of the
27 regular testimonial subpoena; the two are no longer wedded, as they were under the prior version
28 of Rule 45.”). No corresponding change was made to the “deposition” language in Rule

1 26(c)(1). There is nothing to suggest that this apparent oversight was intended to limit the
2 authority of courts to enter protective orders. *See* Fed. R. Civ. P. 45, advisory committee notes,
3 1991 Amendment (noting that the 1991 amendment was “not intended to diminish rights
4 conferred by Rules 26-37 or any other authority”). Rather, the purposes of the 1991 amendments
5 to Rule 45 were “to clarify and enlarge the protections afforded” to nonparties “who are required
6 to assist the court by giving information or evidence,” as well as to facilitate “productions of
7 evidence at places distant from the district in which an action is proceeding.” *Id.* It would be
8 contrary to both of these stated aims if the amendment were interpreted to require a subpoenaed
9 nonparty to travel thousands of miles to the court in which the action is pending in order to
10 obtain a protective order, as would be the case here. *Cf. Star Scientific*, 205 F. Supp. 2d at 485
11 (“it is of course the nonparty whose convenience Rule 45 is most concerned about protecting.”)
12 (internal quotation marks omitted).⁴

13 In short, the legislative history of Rules 26 and 45 clearly indicate that Rule 26 applies
14 with equal force to document subpoenas. Given this clear interpretive guidance, this Court
15 should enter the proposed Protective Order, which provides that this Court will have authority to
16 enforce its provisions, rather than the Court overseeing the underlying actions.⁵ *See*
17 *Amalgamated Transit Union Local 1309 v. Laidlaw Transit Services, Inc.*, 435 F.3d 1140, 1146
18 (9th Cir. 2006) (noting that courts may look to legislative history for interpretive guidance to
19 resolve ambiguities in a statute, and “even where the plain language appears to settle the
20 question, [courts] may nonetheless look to the legislative history to determine whether there is
21 clearly expressed legislative intention contrary to that language”).

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25 ⁴ In any event, the stipulated protective order at issue here does not apply solely to the documents-only subpoena
26 served on BayTSP in September 2007. By its own terms, the protective order will apply to all “documents and
27 information that BayTSP produces in response to this *or any other* Subpoena issued by any SDNY Party,” and
28 therefore applies to deposition subpoenas as well. [Proposed] Stipulated Pre-Trial Protective Order, Docket #30 at 1
(emphasis added). Since the scope of the protective order includes deposition subpoenas as well as those seeking
only documents, the plain language of Rule 26(c) permits the order to be entered in this court.

⁵ Of course, it is worth noting that this enforcement provision was negotiated and consented to by all parties to the
proposed Protective Order.

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CONCLUSION

For the reasons stated above, the parties respectfully request that this Court enter the [Proposed] Stipulated Pretrial Protective Order, attached hereto as Exhibit A, as modified by the Court’s July 2, 2009 Order, attached hereto as Exhibit B.

July 24, 2009

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Filer’s Attestation: Pursuant to General Order No. 45, Section X(B), the filer hereby attests that the signatories’ concurrence in the filing of this document has been obtained.