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FILED
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 RICHARD W. WIEKING
 CLERK, U.S. DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA

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 9 **UNITED STATES DISTRICT COURT**
 10 **NORTHERN DISTRICT OF CALIFORNIA – SAN JOSE DIVISION**

LHK

CV 11 80286 MISC.

11
 12 ST. CLAIR INTELLECTUAL PROPERTY
 13 CONSULTANTS, INC.

USDC, District of Delaware
 Consolidated cases 09-354 LPS, 09-704 LPS

14 *Plaintiff,*

Civil Action No.

15 vs.

**PLAINTIFF ST. CLAIR INTELLECTUAL
 PROPERTY CONSULTANT INC.'S NOTICE
 OF MOTION AND MOTION FOR A
 PROTECTIVE ORDER TO QUASH OR
 MODIFY TIMING OF THE SUBPOENAED
 DEPOSITION OF ATTORNEY BJ OLSON**

16 ACER, INC., et al.

17 *Defendants.*

18
 19 DATE: December 20, 2011
 20 TIME: 10:00 a.m.
 JUDGE:
 21 CTRM:

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NOTICE OF MOTION AND MOTION

TO THE PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that, on December 20, 2011, at 10:00 a.m., or as soon thereafter as the matter may be heard, before the Hon. _____, United States District Judge, Courtroom ____, ____ Floor, of the United States District Court for the Northern District of California, _____ Division, _____, California, St. Clair Intellectual Property Consultants, Inc. ("St. Clair") hereby respectfully moves for a Protective Order in regard to two subpoenas of attorney BJ Olson issued in relation to a litigation pending between Plaintiff St. Clair and several computer company defendants, including Dell, Inc. and Microsoft Corp. (*See* Declaration of R. Terrance Rader ("Rader Dec."), ¶¶1-2, Exhibits A and B, respectively). Specifically, St. Clair objects to Dell and Microsoft's attempt to conduct Ms. Olson's deposition on Tuesday, November 15, 2011 without the presence of St. Clair's counsel. Dell and Microsoft – who both issued individual separate subpoenas which themselves were each deficient – failed to provide "reasonable written notice" to St. Clair of the deposition date as required by Fed.R.Civ.P 30(b)(1). In addition, the unilateral setting of the deposition date violates the "meet and confer" requirement of N.D. Cal. Local Rule 30-1, where the deposition was scheduled for a date for which counsel for St. Clair had explicitly informed Microsoft and Dell of their unavailability. Consequently, St. Clair requests that the Court enter a Protective Order prohibiting Microsoft and Dell from taking the deposition of Ms. BJ Olson, the outside attorney for a third party Vadem, on a date at which counsel for St. Clair cannot attend, pursuant to Fed.R.Civ.P. Rule 26(c), 30(b)(1) and 45.

I. CHRONOLOGY LEADING TO MOTION

Ms. Olson is outside counsel for a non-party to this action, Vadem Limited, who previously had an ownership interest in the patents now owned by Plaintiff St. Clair and asserted against the Defendants. Rader Dec. ¶4. She was provided with a subpoena issued by Dell on or about July 27, 2011. The nature of Ms. Olson's testimony is expected to relate to an alleged spoliation issue (and

1 presumably privileged on other potential matters). Rader Dec. ¶5. The subpoena requested the
2 production of documents and a deposition without including, as required, a “specified time and
3 place.” *Id.* ¶6, Exhibit A. Rather, the form merely stated that the deposition would occur at a
4 “date and time to be agreed by Olson and the parties.” *Id.*

5
6 Dell ultimately scheduled the deposition on a date that was not agreed to by the parties. *Id.*
7 ¶7. Specifically, on September 8, 2011, Dell contacted counsel for St. Clair to schedule Ms.
8 Olson’s deposition; counsel for St. Clair indicated that Dell should find out her dates of availability
9 directly from her. *Id.*, ¶¶9-14, Exhibit C (collection of three email strings). After Dell contacted
10 Ms. Olson to discuss scheduling her deposition, Dell emailed counsel for St. Clair of its intention
11 to schedule the deposition on November 11, 2011, without providing any alternative dates or
12 asking about St. Clair’s availability. *Id.* Specifically, on October 13, 2011, Dell counsel, Jennifer
13 Nall, emailed St. Clair counsel Glenn Forbis: “BJ Olson has agreed to a deposition on November
14 11th. So, I have scheduled the deposition for November 11th at the V&E offices in Palo Alto,
15 starting at 9am.” *Id.* On October 17, 2011, St. Clair counsel Forbis emailed back that it objected
16 to that date due to unavailability and proposed an alternative date provided by Ms. Olson:
17 “November 11 is not available for us. I spoke to BJ Olson, who is also available on November 7,
18 which will work for us. Please confirm November 7 instead of November 11.” *Id.* Having not
19 received a response, attorney Forbis sent a follow-up email on October 20, 2011: “Having not
20 received a response from you on this, we are proceeding with the understanding that the BJ Olson
21 deposition will be on November 7 at Vinson & Elkins in Palo Alto.” *Id.*

22 On October 24, 2011, Ms. Nall, counsel for Dell, nixed the November 7 deposition date
23 without explanation and sought alternative dates, to which attorney Forbis immediately responded
24 that same day that he “*will contact BJ Olson and get her availability.*” *Id.* On October 25, 2011,
25 Mr. Forbis emailed that:

26 Ms. Olson tells me that the only other date available that she has available this year is
27 November 14, but we are not available that day because we will be in Raleigh for a deposition
28 of Lenovo. Given the fact that the topics of the Olson deposition are not germane to the issues

1 to be addressed in the expert reports, I suggest that we agree to schedule this deposition after
2 January 3, 2012, notwithstanding that it is after the close of discovery. *Id.*

3 At that point, on October 27, 2011, Microsoft attorney Tara Elliot again requested that "*the*
4 *witness provide a date(s) in the month of December.*" *Id.* Mr. Forbis immediately responded, also
5 on October 27, 2011: "I'm not particularly interested in pushing her deposition into January either.
6 But this is what Ms. Olson told me. Keeping in mind that she is a third-party witness (indeed,
7 outside counsel for a third-party), how would you like to proceed?" *Id.*

8 St. Clair heard nothing further until Ms. Olson submitted a query concerning the deposition
9 on November 2, 2011: "I understand that the deposition originally scheduled for 11/11 has been
10 cancelled. Please contact me directly via email if your team wishes to re-schedule." *Id.* Microsoft
11 attorney Elliot communicated with Ms. Olson on November 2 that "we do need to schedule your
12 deposition and wanted to get your dates of availability over the next eight weeks." *Id.* Ms. Olson
13 indicated that she was "currently available on November 14 and possibly November 15. Thereafter,
14 my earliest availability is January 4, 2012." *Id.* Counsel for Microsoft then asked for dates in
15 December: "Is it possible for you to provide a date of availability in December, even if it is more
16 convenient for you that the deposition occur on a weekend? Fact discovery in this case closes on
17 December 16." *Id.* Likewise, on the same day, November 4, 2011, St. Clair counsel Forbis
18 emailed to Dell and Microsoft: "Note that St. Clair is not available on the 14th and 15th of
19 November because I will Raleigh, deposing Lenovo, and Terry is not available on those days either."
20 *Id.*

21 Notwithstanding Mr. Forbis' expression of unavailability of the only two attorneys for St.
22 Clair that have been involved in depositions in this case for November 14 and 15 (in part due to
23 back-to-back 30(b)(6) depositions occurring across the country of a co-Defendant), Dell counsel
24 Nall unilaterally scheduled the deposition on November 15, 2011. *Id.*, ¶8. On November 07,
25 2011, at 5:06 PM, attorney Nall emailed Mr. Forbis of its intention to proceed on November 15,
26 2011, with or without St. Clair. *Id.*, ¶15, Exhibit D. Attorney Forbis immediately objected within
27 the hour:

1 We are not available on November 15. Ms. Olson also offered to do the deposition on
2 November 7, but you declined because it did not fit your schedule. Please advise immediately
3 if you intend to attempt to push this deposition forward on the 15th, and we will file a motion
4 for a protective order. *Id.*

5 On November 8 and 9, counsels for Microsoft/Dell and St. Clair exchanged emails
6 concerning the basis of St. Clair's objection and the feasibility of scheduling Ms. Olson on January
7 4 or shortly thereafter. *Id.*, ¶¶16-17, Exhibit . On November 9, St. Clair had a formal meet and
8 confer with counsel for Dell, at which time Dell refused to change its position but asked that St.
9 Clair agree to dates in January for its two 30(b)(6) depositions of co-defendant Lenovo. *Id.* St. Clair
10 indicated a willingness to potentially accommodate Dell's requested adjournment of its deposition
11 until January. *Id.* However, thereafter, in a series of emails on November 10 and 11, was unable to
12 come to an agreement with Lenovo, who was unable to re-schedule the depositions on consecutive
13 days before the week of January 23, 2012. *Id.*, ¶17, Exhibit E. Given Ms. Olson's availability
14 beginning the first week of January (and the non-substantive nature of her testimony), Mr. Forbis
15 insisted that the adjournment of the long-scheduled and substantive Lenovo 30(b)(6) testimony (crucial
16 to expert reports) could not be agreed to absent Lenovo's ability to schedule two consecutive days in
17 either the first or second week of January. *Id.* On November 11, 2011, Lenovo responded that
18 "*Lenovo's depositions will go forward as scheduled next week.*" *Id.* November 11 was a Federal
19 holiday and this motion could not be filed on that day.

20 In addition, Microsoft purportedly filed a second subpoena to Ms. Olson on November 10,
21 2011 for a deposition on the same November 15, 2011 date. *Id.*, ¶2, Exhibit B.

22 **III. ARGUMENT**

23 Fed. R. Civ. P. 26(c), 30(b)(1) and 45(c)(3)(i) authorizes the Court the enter an Order that
24 the deposition be rescheduled so that counsel for plaintiff may appear. First, the subpoenas of Dell
25 and Microsoft are deficient under Fed. R. Civ. P. 45. Second, the required written notice to St.
26 Clair was deficient pursuant to Fed. R. Civ. P. 30(b)(1) and the local rules of both the District of
27 Delaware (the court of jurisdiction over the underlying litigation) and the local rules of the
28 Northern District of California. Attendance by counsel for St. Clair is important here, since Ms.

1 Olson is an outside attorney for a third party Vadem, and counsel for St. Clair represents Vadem.
2 Rader Dec. ¶18. In addition, as a third party, counsel for Plaintiff St. Clair is entitled to appear and
3 cross examine her. *Id.* Ms. Olson would have reasonable grounds to object to a second deposition
4 by St. Clair.

5 The Dell subpoena is defective under Fed. R. Civ. P. 45(a)(1)(A)(iii) because it did not
6 include a “specified time and place” for testimony but instead stated the “Date and Time to be
7 agreed by Olson and the parties.” *See* Rader Dec., Exhibit A. The subpoena should be quashed
8 because it failed to include information required under the Federal Rules and because Dell failed to
9 satisfy its own explicit condition in the subpoena that the time and place would be agreed to by “the
10 parties.” Microsoft’s subpoena, filed only days ago, is likewise deficient under Fed. R. Civ. P. 45, as
11 insufficient notice.¹ *See Id.*, Exhibit B. Under the Federal Rules, a subpoena can be quashed or
12 modified if the subpoena “fails to allow reasonable time for compliance.” Fed.R.Civ.P.
13 45(c)(3)(A)(i).

14 St. Clair moreover objects to its exclusion from the deposition. Fed. R. Civ. P. 30(b)(1)
15 requires written notice to St. Clair including the date and place of the deposition; such notice must
16 provide “reasonable” notice: “A party who wants to depose a person by oral questions must give
17 reasonable written notice to every other party. The notice must state the time and place of the
18 deposition . . .” The very first time that Dell set the date of November 15 was on November 7 (at
19 5:06 PM) via email. *See* Rader Dec. ¶7, Exhibit D. Even assuming that email constitutes written
20 notice of a time and place of a subpoenaed deposition, the email cannot constitute “reasonable”
21 notice as it is less than the requisite ten (10) days notice. The District of Delaware explicitly
22 defines “reasonable notice” for the taking of depositions was defined to be not less than 10 days:

23 **Reasonable Notice for Taking Depositions.** Unless otherwise ordered by the Court,
24 “reasonable notice” for the taking of depositions under Fed. R. Civ. P. 30(b)(1) and
25 30(b)(6) shall be not less than 10 days. District of Delaware Local Rule 30.1

26 _____
27 ¹ In addition, neither Dell nor Microsoft ever submitted any proof of service (which has been
28 interpreted in the Ninth Circuit as personal hand-delivery) or the tendering of the required witness
fees to St. Clair.

1 Accordingly, Dell and Microsoft provided insufficient notice to St. Clair of the November 15,
2 2011 deposition date, effectively excluding counsel of St. Clair from attending. This violation of
3 Rule 30(b)(1) alone warrants a Protective Order.

4 In addition to violating the Federal Rules and the local rules of the district court of the
5 underlying jurisdiction, Dell and Microsoft violated the local rules of the Northern District of
6 California, as Dell and Microsoft failed to confer with St. Clair about the deposition date as
7 required by Local Rule 30-1:

8 **Northern District of California: 30-1. Required Consultation Regarding Scheduling**

9 For the convenience of witnesses, counsel and parties, before noticing a deposition of a
10 party or witness affiliated with a party, the noticing party must confer about the scheduling
11 of the deposition with opposing counsel or, if the party is pro se, the party. A party noticing
12 a deposition of a witness who is not a party or affiliated with a party must also meet and
13 confer about scheduling, but may do so after serving the nonparty witness with a subpoena.

14 Dell and Microsoft violated this provision by scheduling the deposition of the non-party witness on
15 a date that counsel for St. Clair specified that both attorneys involved were unavailable, having
16 failed to properly confer with St. Clair on scheduling the deposition. *See* Rader Dec., ¶20, Exhibit
17 E.

18 There are no other attorneys for St. Clair with the level of involvement in this case as Mr.
19 Rader and Mr. Forbis; Mr. Rader and Mr. Forbis are also the attorneys most familiar with the
20 spoliation issue alleged by Microsoft and Dell. *Id.*, ¶20. St. Clair's counsel Mr. Rader has a
21 meeting with clients travelling from Japan scheduled long ago, and Mr. Forbis is scheduled across
22 the country in Raleigh, North Carolina on both November 15 and 16 to take the deposition of
23 another defendant in this matter, which counsel for Dell and Microsoft have long been aware. *Id.*

24 Counsel for St. Clair indicated that the schedule of the third party should be accommodated
25 and has no objection to a deposition in January. *Id.*, ¶21. The issue of prejudice and the witness's
26 availability should be paramount. Ms. Olson takes an annual family vacation every year in
27 December, which has been scheduled for some time and as she informed the parties. *Id.* Dell's
28 insistence on a November 15 deposition is not reasonable. Up until November 4, 2011, *Dell was
still seeking a deposition on a date up to December 16.* Ms. Olson has notified the parties that she

1 would be available again beginning on January 4, 2012, just over two weeks later. *Id.*, ¶14.

2 Dell should take the deposition in early January. Dell itself suggested St. Clair clear its
3 schedule by taking its previously-scheduled deposition of Lenovo in January 2012, which St. Clair
4 attempted to schedule throughout the day on November 10. *Id.*, ¶17, Exhibit E. St. Clair was far
5 more flexible in attempting to accommodate the November 15, 2011 date than Microsoft and Dell
6 have been in insisting upon that particular date when they could have simply scheduled the
7 deposition for January 4, or a date shortly thereafter. Whereas Lenovo witnesses could not be
8 available on consecutive days until January 23, 2011, Ms. Olson indicated that she could be
9 available for deposition on January 4, 2011. *Id.*, ¶¶14, 21-22, Exhibit C. The Lenovo depositions
10 concern substantive issues of damages; Ms. Olson's deposition is directed to an alleged spoliation
11 issue. *Id.*, ¶22. The Lenovo depositions are across the country (Raleigh, North Carolina) from the
12 location of the majority of depositions to be conducted; Ms. Olson's deposition will be in the same
13 vicinity of California as most of the remaining depositions in the case. *Id.*

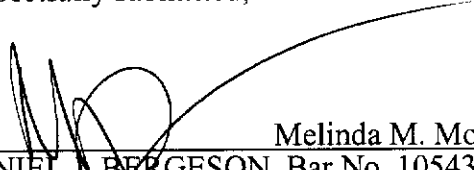
14 Dell and Microsoft face no prejudice since Ms. Olson is not a party or party witness and
15 her testimony has nothing to do with the substantive issues in the patent case or in relation to the
16 preparation of expert reports or expert discovery. *Id.* Ms. Olson will presumably be questioned
17 only in relation to the production of documents by third party Vadem Ltd. *Id.* Further, St. Clair
18 may also have a need to question her on the record. *Id.*, ¶23. She is outside the jurisdiction of the
19 trial court, and given that she is a third party and she would have grounds to object to being
20 deposed again as that would be unnecessarily burdensome. For all of the above reasons, a
21 Protective Order is warranted to protect the rights of both St. Clair and the witness.

22 **IV. RELIEF REQUESTED**

23 St. Clair respectfully requests that this Court issue a Protective Order quashing the
24 subpoena as to a deposition date of Ms. Olson on November 15, 2011 – when counsel for St. Clair
25 is unavailable – and ordering the deposition be rescheduled to a date when counsel for St. Clair is
26 available in early January 2012.

1 Dated: November 14, 2011

Respectfully submitted,

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3 

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