

United States District Court  
For the Northern District of California

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**UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION**

INTEGRATED GLOBAL CONCEPTS, INC.,	)	Case No.: 5:12-cv-03434-RMW (PSG)
	)	
Plaintiff and Counterclaim Defendant,	)	<b>ORDER GRANTING PLAINTIFF'S</b>
	)	<b>MOTION TO COMPEL</b>
v.	)	
	)	<b>(Re: Docket No. 86)</b>
j2 GLOBAL, INC. and ADVANCED	)	
MESSAGING TECHNOLOGIES, INC.,	)	
	)	
Defendant and Counterclaimant.	)	
	)	
	)	

Integrated Global Concepts, Inc. moves to compel j2 Global, Inc. and Advanced Messaging Technologies, Inc. (collectively "j2") to produce communications it exchanged with eFax, Inc. between July and November, 2000 and all communications EKMS.<sup>1</sup> Having considered the parties' papers and arguments the court GRANTS IGC's motion to compel both sets of documents.

**I. BACKGROUND**

The parties are familiar with the status and history of this case, so the court will focus its attention on the key events that are relevant here.

<sup>1</sup> See Docket No. 86.

1 On July 13, 2000 j2 and eFax entered into an Agreement and Plan of Merger, indicating  
2 that the two companies would merge if certain conditions were met over the next several months.  
3 Five months later, on November 29, 2000, j2 and eFax finally effectuated the merger. Later, at  
4 some point in 2002, j2 retained the services of EKMS as a patent licensing agent, for assistance  
5 expanding and improving its patent portfolio. IGC seeks to discover certain communications with  
6 these parties.

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8 On November 16, 2013, j2 produced a log to IGC claiming privilege over approximately  
9 1000 documents. Shortly thereafter, IGC objected to several of the entries, which j2 defended as  
10 protected by the common interest privilege. Following a brief meet and confer, IGC filed the  
11 instant motion. j2 then went over the documents again and withdrew its privilege claims with  
12 respect to approximately 100 documents. IGC still seeks discovery as to those documents  
13 that remain.

## 14 II. LEGAL STANDARDS

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16 The Federal Rules of Civil Procedure provide that a party “may obtain discovery regarding  
17 any non-privileged matter that is relevant to any party’s claim or defense.”<sup>2</sup> “Relevance for  
18 purposes of discovery is defined very broadly.”<sup>3</sup> If a party facing a discovery deadline is waiting  
19 for documents in response to a document request, the party may immediately move to compel  
20 production of the documents.<sup>4</sup> On a motion to compel, the party seeking to compel discovery has  
21 the initial burden of “establishing that its request satisfies the relevancy requirements of Rule  
22 26(b)(1).”<sup>5</sup> “In turn, the party opposing discovery has the burden of showing that the discovery  
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24  
25 <sup>2</sup> Fed. R. Civ. P. 26(b).

26 <sup>3</sup> See *Garneau v. City of Seattle*, 147 F.3d 802, 812 (9th Cir. 1998).

27 <sup>4</sup> See Fed. R. Civ. P. 37(a)(3)(B)(iv).

28 <sup>5</sup> See Fed. R. Civ. P. 26(b)(1); see *Soto v. City of Concord*, 162 F.R.D. 603, 610 (N.D. Cal. 1995).

1 should not be allowed, and also has the burden of clarifying, explaining or supporting its objections  
2 with competent evidence.”<sup>6</sup>

3 In order to claim the attorney-client privilege, the party asserting the privilege bears the  
4 burden of demonstrating that the communication: 1) sought legal advice; 2) from a legal adviser in  
5 his capacity as such; [such that] 3) the communications relating to that purpose; 4) made in  
6 confidence; 5) by the client; 6) are at his instance permanently protected; 7) from disclosure by  
7 himself or by the legal adviser; and 8) the privilege was not waived.<sup>7</sup> The common-interest is,  
8 essentially, an exception to the waiver rule of the attorney-client privilege.<sup>8</sup> It “protects not only  
9 the confidentiality of communications passing from a party to his or her attorney but also ‘from one  
10 party to the attorney for another party where a joint defense effort or strategy has been decided  
11 upon and undertaken by the parties and their respective counsel”<sup>9</sup> where “1) the communication is  
12 made by separate parties in the course of a matter of common interest; 2) the communication is  
13 designed to further that effort; and 3) the privilege has not been waived.”<sup>10</sup>

### 14 III. DISCUSSION

15 The common interest doctrine is a narrow exception to the general rule that disclosing  
16 information to a third party constitutes a waiver of the attorney-client privilege.<sup>11</sup> It generally  
17 applies “where allied lawyers and clients work together in prosecuting or defending a lawsuit so  
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21 <sup>6</sup> See *Louisiana Pacific Corp. v. Money Market 1 Institutional Investment Dealer*, Case No. 09-  
22 cv-03529-JSW, 2012 WL 5519199, at \*3 (N.D. Cal. Nov. 14, 2012); *United States v. Warner*, Case  
23 No. 11-cv-04181-LB, 2012 WL 6087193, at \*3 (N.D. Cal. Dec. 6, 2012).

24 <sup>7</sup> See *Aronson v. McKesson HBOC, Inc.*, Case No. 99-cv-20743, 2005 WL 93433, at \*3 (N.D. Cal.  
25 Mar. 31, 2005) (citing *In re Grand Jury Investigation*, 974 F.2d 1068, 1071 n.2 (9th Cir.1992)).

26 <sup>8</sup> See *United States v. Austin*, 416 F.3d 1016, 1021 (9th Cir. 2005).

27 <sup>9</sup> *Id.*

28 <sup>10</sup> *United States v. Bergonzi*, 216 F.R.D. 487, 495 (N.D. Cal. 2003).

<sup>11</sup> See *id.*

1 that they may exchange information among themselves without waving the privilege,”<sup>12</sup> although it  
2 may, in rare cases, be extended to situations where there is anticipated joint litigation, but nothing  
3 pending imminently.<sup>13</sup>

4 Here, j2 relies on the common interest doctrine to shield communications with two entities  
5 when it faced no litigation, no impending threat of litigation, and which do not provide any form of  
6 legal service as their business.<sup>14</sup> Moreover, j2 has failed to proffer any evidence of any written  
7 agreement with these two entities whatsoever, giving the court no evidence on which to base a  
8 finding that the communications are covered by the privilege. “While such a writing may not  
9 always be required, [j2] also has not shown that the [communications] disclosed that which the  
10 common interest privilege was designed to protect—‘a pre-existing privileged document’ shared  
11 among ‘allied lawyers and clients—who are working together in prosecuting or defending a lawsuit  
12 or in certain other legal transaction.’”<sup>15</sup> In the absence of any agreement, written or otherwise, or  
13 any evidence of a common legal foe, the communications in question fall outside the scope of the  
14 common-interest privilege.  
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#### 17 IV. CONCLUSION

18 IGC’s motion to compel is GRANTED as to both sets of documents. All documents at  
19 issue are to be produced by no later than January 28, 2014.

20 <sup>12</sup> *Elan Microelectronics Corp. v. Apple, Inc.*, Case No. 09-cv-01531-RS (PSG), 2011 WL  
21 3443923, at \*2 (N.D. Cal. Aug. 8, 2011).

22 <sup>13</sup> *See id.*

23 <sup>14</sup> Although j2 attempts to liken their relationship with EKMS to the hiring of a law firm to provide  
24 outside counsel on their patent portfolio, EKMS is described in business publications as  
25 “provid[ing] technical and business expertise to help companies identify, assess, protect and  
26 leverage IP assets to enhance market leadership and profitability.” *UTEK Corporation Acquires  
27 EKMS, Inc., A Leading Intellectual Property Management Firm*, THE BUSINESS WIRE, (Jan. 16,  
28 2014) (<http://www.businesswire.com/news/home/20041202005100/en/UTEK-Corporation-Acquires-EKMS-Leading-Intellectual-Property#.UthMMfuQmZQ>). This is a quintessential example of a business relationship which may, nonetheless, touch on certain areas of legal expertise.

<sup>15</sup> *Elan*, 2011 WL 3443923, at \*4.

**IT IS SO ORDERED.**

Dated: January 21, 2014

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PAUL S. GREWAL  
United States Magistrate Judge

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