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Filed

JAN 28 2013

RICHARD W. WIERING
 CLERK, U.S. DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 SAN JOSE

6 Attorneys for Non-Party
 APPLE INC.

8 UNITED STATES DISTRICT COURT
 9 NORTHERN DISTRICT OF CALIFORNIA

LHK

10 PARKERVISION, INC.,
 11 ~~Plaintiff,~~

CV 13 8001 8 MISC
 MISC CASE NO.

Plaintiff,

Pending in the United States District Court for
 the Middle District of Florida as
 Case No. 3:11cv719-J-37TEM H R I

v.

14 QUALCOMM INCORPORATED,

NON-PARTY APPLE INC.'S NOTICE OF
 MOTION AND MOTION TO QUASH
 PLAINTIFF/COUNTERCLAIM
 DEFENDANT PARKERVISION, INC.'S
 SUBPOENA DUCES TECUM

Defendant.

18 QUALCOMM INCORPORATED,

Date: t/b/d
 Time: t/b/d
 Dept.: t/b/d
 Judge: t/b/d

Counterclaim Plaintiff,

v.

21 PARKERVISION, INC. AND STERNE,
 22 KESSLER, GOLDSTEIN & FOX PLLC,

Counterclaim Defendants.

25 PLEASE TAKE NOTICE THAT on _____ at _____, or as soon thereafter as
 26 non-party Apple Inc. ("Apple") may be heard before this Court, Apple will and hereby does move
 27 to quash a third party subpoena *duces tecum* served upon it by ParkerVision, Inc.

28 APPLE INC.'S NOTICE OF MTN AND MTN TO QUASH PARKERVISION'S SUBPOENA - MISC. CASE NO.

1 ("ParkerVision"), and further moves for a protective order.

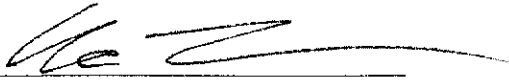
2 Pursuant to F.R.C.P Rule 45 (c), non-party Apple requests the Court to quash
3 ParkerVision's subpoena *duces tecum* to Apple for being untimely, invalid and void because it
4 was served by ParkerVision weeks after the fact discovery deadline in the underlying case, Case
5 No. 3:11cv719-J-37TEM pending in the Middle District of Florida, where ParkerVision is the
6 plaintiff. In addition, to prevent ParkerVision from harassing non-party Apple with further
7 untimely discovery, Apple requests that the Court enter a protective order.

8 Dated: January 28, 2013

FEINBERG DAY ALBERTI & THOMPSON LLP

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By: 

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Elizabeth Day
Yakov Zolotorev

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Attorneys for Non-Party
APPLE INC.

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1 **MEMORANDUM OF POINTS AND AUTHORITIES**
2 **IN SUPPORT OF APPLE INC.'S MOTION TO QUASH**
3 **PLAINTIFF/COUNTERCLAIM DEFENDANT PARKERVISION, INC.'S**
4 **SUBPOENA DUCES TECUM AND MOTION FOR PROTECTIVE ORDER**

5 **I. ISSUES TO BE DECIDED**

6 Apple requests the Court to decide whether ParkerVision's subpoena to Apple is untimely,
7 invalid and therefore should be quashed because it was served by ParkerVision without any
8 justification weeks after the fact discovery cutoff in the underlying case, Case No. 3:11cv719-J-
37TEM pending in the Middle District of Florida.

9 **II. ARGUMENT**

10 **A. Statement of Facts**

11 The present matter arises from a patent infringement complaint filed by ParkerVision
12 against Qualcomm, Inc. ("Qualcomm") on or about July 20, 2011, in the Middle District of
13 Florida, Case No. 3:11cv719-J-37TEM ("the Florida Case"). See Declaration of Yakov Zolotorev
14 in Support of Apple Inc.'s Motion to Quash ParkerVision's Subpoena *Duces Tecum* ("Zolotorev
15 Decl."), ¶ 2, Ex. A. The court in the Florida Case issued an Amended Case Management and
16 Scheduling Order ("Amended Case Management Order") dated May 10, 2012. See Zolotorev
17 Decl., ¶ 3, Ex. B. The Amended Case Management Order set a fact discovery deadline of
18 November 30, 2012. *Id.*, Ex. B at 2. On or about October 4, 2012, the parties in the Florida Case
19 filed a joint motion to extend discovery deadlines. *Id.*, ¶ 4, Ex. C. Among other issues, the
20 parties in the Florida Case requested the court to extend the fact discovery deadline to December
21 31, 2012. *Id.*, Ex. C at 2. On December 24, 2012 the court in the Florida Case, in response to the
22 joint motion, issued a Second Amended Case Management and Scheduling Order ("Second
23 Amended Case Management Order") modifying some deadlines, but leaving others, including the
24 fact discovery cutoff of November 30, 2012, as set forth in the Amended Case Management
25 Order. *Id.*, ¶ 5, Ex. D at 2-3. As a result, the Second Amended Case Management Order affirmed
26 the November 30, 2012 fact discovery cutoff deadline.

27 On or about November 29, 2012, just one day before the close of fact discovery in the
28 Florida Case, ParkerVision served on Apple a first subpoena *ad testificandum* generally relating

1 to certain Apple products alleged by ParkerVision to contain certain Qualcomm chipsets and
2 technologies. (“First Subpoena”) *Id.*, Ex. E. Almost a month later, on December 21, 2012
3 ParkerVision withdrew the First Subpoena following a telephonic meet and confer conference
4 with an in-house attorney at Apple. *See* Declaration of Jackie Harlow in Support of Apple Inc.’s
5 Motion to Quash ParkerVision’s Subpoena *Duces Tecum* (“Harlow Decl.”), ¶¶ 2-4, Ex. 1. That
6 same day, over **three weeks after** the close of fact discovery in the Florida Case, ParkerVision
7 served by email and process server a second subpoena (“Second Subpoena”), this time *duces*
8 *tecum*, but generally covering the same subject matter as set forth in the withdrawn First
9 Subpoena. *See* Harlow Decl., ¶¶ 4-6, Ex. 2.

10 **B. ParkerVision’s Subpoena Should Be Quashed As Untimely and Invalid**

11 This Court should quash the Second Subpoena as invalid and void because it was served
12 by ParkerVision many weeks after the close of fact discovery in the Florida Case. “Case law
13 establishes that subpoenas under Rule 45 are discovery, and must be utilized within the time
14 period permitted for discovery in a case.” *Integra Lifesciences I, Ltd. v. Merck KGaA*, 190 F.R.D.
15 556, 561 (S.D. Cal. 1999); *see also, e.g., Marvin Lumber & Cedar Co. v. PPG Industries, Inc.*,
16 177 F.R.D. 443, 445 (D. Minn. 1997) (subpoenas under Rule 45, invoking the authority of the
17 court to obtain the pretrial production of documents and things, are discovery within the
18 definition of Fed.R.Civ.P. 26(a)(5) and are therefore subject to the time constraints that apply to
19 all other methods of formal discovery); *Rice v. United States*, 164 F.R.D. 556, 558 (N.D. Okl.
20 1995) (subpoenas *duces tecum* for particular records, issued to third parties after close of
21 discovery for purposes of discovering impeachment material, were quashed as improper attempt
22 to engage in discovery after designated time period). As explained by one court that granted a
23 motion for a protective order prohibiting a party from serving Rule 45 subpoenas after the close
24 of fact discovery, “to allow a party to continue with formal discovery—that is, discovery which
25 invokes the authority of the Court—whether in the guise of Rule 45, or any of the other discovery
26 methods recognized by Rule 26(a)(5), after the discovery deadline unnecessarily lengthens
27 discovery process, and diverts the parties’ attention, from the post-discovery aspects of preparing
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1 a case for Trial, to continued involvement in the discovery.” *Marvin Lumber*, 177 F.R.D. at 445.

2 A small number of cases in other jurisdictions have held that Rule 45 subpoenas are not
3 subject to the discovery periods set under Rule 26; however, “California federal courts and the
4 majority of jurisdictions hold that . . . requests for production of documents and things under Rule
5 45 constitute pre-trial discovery and must be served within the designated discovery period.

6 *nSight, Inc. v. PeopleSoft, Inc.*, WL 988807 at *3 (N.D. Cal. Apr. 13, 2006). The *nSight* Court
7 elaborated that the only exception is where a party seeks a *trial* subpoena under Rule 45. *Id.* at
8 *2-3. This exception is inapplicable here – the Second Subpoena is without a doubt a pre-trial
9 discovery subpoena, as evidenced by the fact that it seeks production of documents in Cupertino,
10 California on January 28, 2013, thousands of miles and many months away from the September
11 19, 2013 trial date in the Florida Case. *See* Harlow Decl., Ex. 2 at 1; Zolotorev Decl., Ex. D at 2.

12 ParkerVision’s Second Subpoena is an improper attempt to obtain discovery beyond the
13 discovery period. *nSight*, WL 988807 at *3. ParkerVision had been aware of the November 30,
14 2012 fact discovery cutoff at least since May 10, 2012, the date of the Amended Case
15 Management Order. Yet, ParkerVision chose to wait until a single day before the close of
16 discovery to issue its First Subpoena, and issued the Second Subpoena that is the subject of the
17 present motion well after the fact discovery cutoff. ParkerVision’s inexcusable attempt to engage
18 in post-discovery case investigation violates both the letter and the spirit of the Federal Rules of
19 Civil Procedure and must be rejected. The Second Subpoena should be quashed, and the Court
20 should enter a protective order preventing ParkerVision from issuing further untimely discovery.
21 *nSight*, WL988807 at *4 (“Plaintiff is improperly attempting to obtain additional discovery after
22 the discovery cut-off. Plaintiff seeks the authority of the Court to engage in what the Court finds
23 to be post-discovery case investigation. However, using the Court’s subpoena power for this
24 purpose is improper. Accordingly, the Court finds that Plaintiff’s subpoena *duces tecum*
25 constitutes pre-trial discovery and is, therefore, untimely.”) (internal citations omitted).

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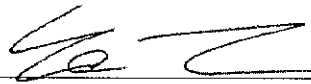
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1 **III. CONCLUSION**

2 For the foregoing reasons, Apple respectfully requests that ParkerVision's Second
3 Subpoena be quashed as untimely and invalid, and that the Court enter a protective order
4 prohibiting ParkerVision from issuing further untimely discovery to non-party Apple.

5 Dated: January 28, 2013

FEINBERG DAY ALBERTI & THOMPSON LLP

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7 By: 

8 Elizabeth Day
9 Yakov Zolotorev

10 Attorneys for Non-Party
11 APPLE INC.

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