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4 UNITED STATES DISTRICT COURT  
5 NORTHERN DISTRICT OF CALIFORNIA  
6 SAN JOSE DIVISION  
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8 VALEO SCHALTER UND SENSOREN  
9 GMBH,

10 Plaintiff,

11 v.

12 NVIDIA CORPORATION,

13 Defendant.

Case No. 23-cv-05721-EKL (VKD)

**ORDER GRANTING IN PART AND  
DENYING IN PART PLAINTIFF'S  
MOTION TO COMPEL PRODUCTION  
OF INVESTIGATION DOCUMENTS**

Re: Dkt. No. 92

14 Plaintiff Valeo Schalter und Sensoren GmbH ("Valeo") moves for an order compelling  
15 defendant NVIDIA Corporation ("NVIDIA") to produce certain documents NVIDIA claims are  
16 protected from disclosure by the attorney-client privilege and/or the attorney work product  
17 doctrine. Dkt. No. 92 (Dkt. No. 99-2). NVIDIA opposes the motion. Dkt. No. 102. The Court  
18 held oral argument on the motion on October 15, 2024. Dkt. No. 134; Dkt. No. 142.

19 Having considered the moving and responding papers and the parties' arguments at the  
20 hearing, the Court grants in part and denies in part Valeo's motion.

21 **I. BACKGROUND**

22 Valeo alleges that in early 2021, one of its employees, Mohammad Moniruzzaman,  
23 downloaded over 27,000 of the company's source code files and other confidential materials  
24 relating to Valeo's parking assistance technology. Dkt. No. 1 ¶¶ 65, 68. Shortly thereafter, Mr.  
25 Moniruzzaman left Valeo and joined NVIDIA, which was then developing competing parking  
26 assistance technology. *Id.* ¶¶ 10-11. Mr. Moniruzzaman's conduct was discovered six months  
27 into his employment at NVIDIA, and a criminal investigation of Mr. Moniruzzaman was  
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1 commenced in Germany where Valeo maintains its principal place of business.<sup>1</sup> *Id.* ¶ 12.

2           Upon learning of the criminal investigation of Mr. Moniruzzaman in May 2022, NVIDIA  
3 began an internal investigation into Mr. Moniruzzaman’s conduct. Dkt. No. 1-1 at 2; Dkt. No. 23  
4 ¶¶ 10-11, 14; Dkt. No. 102-1 ¶ 4. Meanwhile, Valeo initiated civil proceedings against NVIDIA  
5 in Germany, asserting copyright infringement and trade secret misappropriation claims. Dkt. No.  
6 1 ¶¶ 73, 81, 102; Dkt. No. 23 ¶ 10. On April 25, 2022, Valeo sought and obtained an order from the  
7 German court requiring NVIDIA “to perform comprehensive searches for Valeo code files in [its]  
8 systems and return any Valeo code it found.” Dkt. No. 23 ¶ 10; Dkt. No. 102-2 ¶ 5; *see also* Dkt.  
9 No. 101-4 at ECF 7 (April 25, 2022 Order required NVIDIA “to surrender the files that are the  
10 subject of the legal dispute for the purposes of sequestration, to the extent to which such files are  
11 stored in printed format or on electronic media at [NVIDIA].”). Subsequently, in May 2022, at  
12 Valeo’s request, the court appointed an independent expert to “inspect NVIDIA’s code base” for  
13 any indication of Valeo code. Dkt. No. 23 ¶ 12. NVIDIA retained outside counsel to represent it  
14 in the German civil proceedings. Dkt. No. 102-1 ¶ 4; Dkt. No. 1 ¶ 73.

15           NVIDIA says that it “conducted a search of its systems for specific files that Valeo  
16 identified.” Dkt. No. 102-1 ¶ 5. As part of that investigation, NVIDIA “interviewed Mr.  
17 Moniruzzaman and his NVIDIA colleagues who all confirmed that Mr. Moniruzzaman never  
18 shared Valeo code, documents, or other confidential information with them.” *Id.*; *see also* Dkt.  
19 99-7 at 18 (“NVIDIA also conducted a wide-ranging search across numerous NVIDIA file storage  
20 repositories and other resources and interviewed many NVIDIA employees.”). As directed by the  
21 German court, NVIDIA provided the court-appointed independent expert “a repository of its  
22 source code containing the full history of all changes made to the code from November 15, 2015,  
23 to June 22, 2022.” Dkt. No. 23 ¶ 12. The expert ultimately found “no evidence that NVIDIA’s  
24 code included any part of Valeo code.” *Id.* ¶ 13.

25           On July 8, 2022, NVIDIA filed an affidavit from its head of IT Security, Jason Recla, in  
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27 <sup>1</sup> Mr. Moniruzzaman was later convicted in Germany for unlawful acquisition, use, and disclosure  
28 of Valeo’s trade secrets. Dkt. No. 1 ¶ 12.

1 the German proceedings. Dkt. No. 99-3. The affidavit described a search overseen by Mr. Recla  
2 for Valeo files across NVIDIA computers and source-code repositories. *Id.* ¶¶ 2, 5-7. In his  
3 affidavit, Mr. Recla attested that the search “did not yield any hits for files of Valeo Schalter und  
4 Sensoren GmbH,” but he reported that no backup copies of Mr. Moniruzzaman’s laptop or  
5 workstation could be found because of the way Mr. Moniruzzaman had modified his computer.  
6 *Id.*

7 On July 29, 2022, the German court issued an order finding that NVIDIA failed to fully  
8 comply with its order to “produce the Valeo files in its possession or explain the impossibility of  
9 production,” and imposed penalties against NVIDIA. Dkt. No. 102-2 ¶ 5. NVIDIA appealed this  
10 order. Dkt. No. 142 at 64:3-13. Nevertheless, while the appeal was pending, NVIDIA filed  
11 several supplemental affidavits with the German court. *Id.* The supplemental affidavits included a  
12 second affidavit from Mr. Recla dated September 19, 2022. Dkt. No. 99-4. This affidavit  
13 disclosed additional details regarding NVIDIA’s efforts to search for Valeo files, including (1) the  
14 names of the individuals who performed the searches as well as other NVIDIA employees who  
15 were consulted; (2) details regarding the software tools and methodologies employed in the  
16 searches; (3) details regarding the locations searched; and (4) further details describing the results  
17 of those searches. *Id.*

18 NVIDIA also filed with the German court affidavits from its in-house counsel, Stephen  
19 Chandler and Azadeh Morrison, dated September 13 and 20, 2022, respectively. Dkt. No. 99-5;  
20 Dkt. No. 99-6. Mr. Chandler’s affidavit disclosed that he had conducted and/or participated in  
21 numerous interviews relating to NVIDIA’s investigation and included the names of the employees  
22 interviewed and the responses obtained during the interviews. Dkt. No. 99-5 ¶¶ 2-4. Mr.  
23 Chandler further attested that he received a list of NVIDIA employees who worked with Mr.  
24 Moniruzzaman, and that he emailed each of them asking for confirmation that the following  
25 statement was true: “To the best of my knowledge, information, and belief, I have never received  
26 any source code belonging to Valeo whether direct from Mohammad Moniruzzaman or from any  
27 other source.” *Id.* ¶¶ 5-6. His affidavit quoted directly from the responses he received and  
28 attached a copy of his original email to the employees. *Id.* ¶ 7.

1 Ms. Morrison’s affidavit disclosed that she was also a key participant in the investigation,  
2 with responsibility for overseeing the searches for Valeo files. Dkt. No. 99-6 ¶ 1. Her affidavit  
3 identified by name the numerous individuals in IT, e-Discovery, engineering and other  
4 departments at NVIDIA with whom she worked to investigate Valeo’s allegations. *See id.* ¶¶ 3, 6,  
5 7. Ms. Morrison attested that she worked with Mr. Recla to look for backup copies of Mr.  
6 Moniruzzaman’s laptop and computer but ultimately confirmed that “no such back-up copies  
7 exist.” *Id.* ¶ 3. She also described her involvement in collecting Mr. Moniruzzaman’s files, her  
8 “personal[] review” of some of the documents, and her findings that Valeo’s files were not  
9 present. *Id.* ¶¶ 11-13.

10 On January 9, 2023, in response to NVIDIA’s appeal, the German court reversed the  
11 decision imposing penalties against NVIDIA for failure to comply with the prior court order. Dkt.  
12 No. 142 at 70:16-24. On June 15, 2023, Valeo withdrew its requests for relief in the German  
13 proceedings, and, on October 5, 2023 the German court ordered Valeo to pay NVIDIA’s costs and  
14 fees incurred in the proceedings. Dkt. No. 23 ¶ 13.

15 On November 7, 2023, Valeo filed its complaint in this action, asserting violations of the  
16 Defend Trade Secrets Act, 18 U.S.C. §§ 1836, 1837, and the California Uniform Trade Secrets  
17 Act, Cal. Civ. Code §§ 3426 *et seq.* Dkt. No. 1 at 23, 27. NVIDIA filed its answer on January 8,  
18 2024. Dkt. No. 23. In its answer, NVIDIA asserts that no trade secret misappropriation has  
19 occurred and alleges that “the key issues involving NVIDIA have already been litigated and  
20 determined in NVIDIA’s favor in Germany.” *Id.* ¶ 1. NVIDIA further asserts that “a fulsome  
21 investigation revealed that Valeo’s claims had no merit.” *Id.* NVIDIA’s answer specifically  
22 references the affidavits it filed in the German action:

23 NVIDIA fully cooperated with German authorities and performed  
24 an extensive search for any Valeo source code files, finding no  
25 Valeo code files in NVIDIA systems. NVIDIA provided sworn  
affidavits detailing the searches it conducted.

26 *Id.* ¶ 11; *see also id.* ¶ 14 (“NVIDIA also undertook extensive searches for Valeo code on its  
27 systems and found nothing . . .”). NVIDIA asserts twelve affirmative defenses in its answer,  
28 including the following:

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**Fourth Defense**  
**No Misappropriation**

Valeo cannot prevail against NVIDIA on its claims for misappropriation, in whole or in part, because NVIDIA never improperly received, relied upon, or used any alleged Valeo trade secret.

*Id.* ¶ 135.

**Fifth Defense**  
**Defendant’s Good Faith**

Valeo’s claims for misappropriation of trade secrets are barred, in whole or in part, because NVIDIA acted in good faith and had no reason to believe that the former Valeo employee that Valeo identifies in the Complaint retained any alleged trade secrets. Moreover, NVIDIA took affirmative steps to prevent the unintentional receipt of third-party confidential information. Every employee at NVIDIA and its affiliates, including the former Valeo employee identified in the Complaint, is required to agree in writing not to bring or disclose to NVIDIA, or use, any confidential information or trade secrets from their prior employer.

*Id.* ¶ 136.

**Ninth Defense**  
**No Willful Misappropriation**

NVIDIA has not willfully or maliciously misappropriated any of Valeo’s alleged trade secrets. NVIDIA took every reasonable step it could to prevent trade secrets from entering the company. Even if an employee violated their agreement with NVIDIA, NVIDIA could not have known that any trade secrets entered NVIDIA given the practices NVIDIA employed to prevent such confidential information from infecting NVIDIA.

*Id.* ¶ 140.

During discovery in this action, Valeo served interrogatories on NVIDIA, including Interrogatory No. 4 which asks NVIDIA to:

[d]escribe the circumstances of Mohammad Moniruzzaman’s recruitment by, hiring by, and departure from NVIDIA, including the date NVIDIA and/or any third party working on behalf of NVIDIA (such as a recruiter or otherwise) first had contact with Mohammad Moniruzzaman; who at NVIDIA and/or any third party working on behalf of NVIDIA (such as a recruiter or otherwise) had contact with Mohammad Moniruzzaman before he began his employment at NVIDIA and the scope of each interaction between

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NVIDIA and/or any third party working on behalf of NVIDIA (such as a recruiter or otherwise) and Mohammad Moniruzzaman before his employment at NVIDIA began; whether, when, and why Mr. Moniruzzaman was terminated from NVIDIA, including all details of any investigation conducted by NVIDIA into the claims asserted in this action; and Mr. Moniruzzaman's current status with respect to NVIDIA, including whether he continues to consult, be paid by, subject to any legal or contractual obligations with, or interact with NVIDIA.

Dkt. No. 99-7 at 16. NVIDIA's response to this interrogatory states in relevant part:

NVIDIA also conducted a wide-ranging search across numerous NVIDIA file storage repositories and other resources and interviewed many NVIDIA employees. NVIDIA found no evidence that any copies of the allegedly retained Valeo code were present on NVIDIA's platforms. Further, it found no evidence that Mr. Moniruzzaman had shown or otherwise disclosed the allegedly retained Valeo code to any NVIDIA employee who had collaborated with Mr. Moniruzzaman during the brief period of his employment at NVIDIA.

...

In the course of the German proceeding, as contained in the pleadings already available to Valeo from that proceeding, NVIDIA described the investigations conducted into Mr. Moniruzzaman's conduct with respect to the alleged use of Valeo code. The details of those investigations are set out in the statements of Arthur Rajala, Jason Recla, Stephen Chandler, and Azadeh Morrison, as well as in letter correspondence between the parties.

*Id.* at 18. Valeo also served Interrogatory No. 7 on NVIDIA, which asks:

If you contend that any of the Valeo trade secrets set forth in Valeo's Section 2019.210 Trade Secret Disclosure are not trade secrets, were not misappropriated, or were not reasonably protected by Valeo as trade secrets, explain the factual and legal bases for any such contentions, including a specific identification of any documents and testimony supporting any such contentions.

Dkt. No. 117-3 at 22. NVIDIA responded in relevant part:

With respect to Valeo's allegations that NVIDIA misappropriated or otherwise used Valeo Trade Secrets, such claims are without evidence. NVIDIA has conducted investigations, e.g., in the course of the German proceeding and in this lawsuit, which included wide-ranging searches across numerous NVIDIA file storage repositories and other resources, as well as interviews with many NVIDIA

1 employees. The investigations discovered no copies of the allegedly  
2 retained Valeo code and no evidence that Mr. Moniruzzaman  
disclosed the allegedly retained Valeo code or any Valeo Trade  
Secret to any NVIDIA employee.

3 *Id.* at 24.

4 Valeo also served requests for production, including Request for Production (“RFP”) 79  
5 which requests in relevant part:

6 [d]ocuments sufficient to show any investigation, analysis, study,  
7 and/or forensics analysis conducted by NVIDIA or on behalf of  
NVIDIA by a third party regarding the allegations described in  
8 Valeo’s Complaint, such as NVIDIA’s misappropriation, misuse,  
and possession of Valeo’s trade secrets, including, without  
9 limitation, documents sufficient to show the date on which the  
investigation began and the outcome of such investigation.

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11 Dkt. No. 67-2 at 51. NVIDIA responded that it would “conduct a reasonably diligent search and  
12 produce nonprivileged documents responsive to this Request, to the extent they exist.” *Id.* at 52.

13 On September 3, 2024, NVIDIA served a privilege log identifying more than 3,000  
14 documents related to its earlier investigation of Mr. Moniruzzaman’s conduct. Dkt. No. 93-7. For  
15 all entries on the log, NVIDIA asserts that the documents are withheld on the basis of attorney-  
16 client privilege and/or attorney work product. *Id.* Valeo moves to compel production of all such  
17 documents.<sup>2</sup>

18 **II. LEGAL STANDARD**

19 As this action is premised on federal question jurisdiction, federal common law governs  
20 issues of privilege. Fed. R. Evid. 501; *United States v. Ruehle*, 583 F.3d 600, 608 (9th Cir. 2009).

21 “The attorney-client privilege protects confidential communications between attorneys and  
22 clients, which are made for the purpose of giving legal advice.” *United States v. Sanmina Corp.*,  
23 968 F.3d 1107, 1116 (9th Cir. 2020). The privilege extends to a client’s confidential disclosures  
24 to an attorney in order to obtain legal advice, as well as an attorney’s advice in response to such  
25 disclosures. *Ruehle*, 583 F.3d at 607 (citations and quotations omitted). The party claiming the

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27 <sup>2</sup> For purposes of this motion, Valeo does not challenge individual entries on NVIDIA’s privilege  
28 log or NVIDIA’s compliance with the requirements of Rule 26(b)(5) and the Ninth Circuit’s  
standard for *prima facie* assertions of privilege and other protections. *See* Dkt. No. 142 at 4:19-  
5:18.

1 privilege has the burden to establish that it applies. *See United States v. Martin*, 278 F.3d 988,  
2 999–1000 (9th Cir. 2002).

3 The attorney work product doctrine protects from discovery documents and tangible things  
4 prepared by a party or his representative in anticipation of litigation or for trial. Fed. R. Civ. P.  
5 26(b)(3); *Sanmina*, 968 F.3d at 1119 (citation omitted). “At its core, the work-product doctrine  
6 shelters the mental processes of the attorney, providing a privileged area within which he can  
7 analyze and prepare his client’s case.” *United States v. Nobles*, 422 U.S. 225, 238 (1975). The  
8 doctrine protects both “material prepared by agents for the attorney as well as those prepared by  
9 the attorney himself,” *id.* at 238-39, and its primary purpose is to “prevent exploitation of a party’s  
10 efforts in preparing for litigation,” *Admiral Ins. Co. v. U.S. Dist. Ct.*, 881 F.2d 1486, 1494 (9th Cir.  
11 1989). Typically, work product protection extends to interview notes, memoranda, summaries,  
12 and analyses, as well as to verbatim witness statements. *See Hickman v. Taylor*, 329 U.S. 495,  
13 511 (1947); *Hatamian v. Advanced Micro Devices, Inc.*, No. 14-cv-00226-YGR (JSC), 2016 WL  
14 2606830, at \*3 (N.D. Cal. May 6, 2016). A party asserting work product protection bears the  
15 burden of demonstrating that the protection applies. *See, e.g., Visa U.S.A., Inc. v. First Data*  
16 *Corp.*, No. C-02-1786 JSW (EMC), 2004 WL 1878209, at \*5 (N.D. Cal. Aug. 23, 2004).

17 The protections afforded by the attorney-client privilege and the work product doctrine are  
18 not absolute. The attorney-client privilege may be waived expressly or by implication. A party  
19 “may implicitly waive the privilege by asserting a claim or defense that relies on privileged  
20 materials as its basis.” *Dukes v. Wal-Mart Stores, Inc.*, No. 01-cv-2252 CRB (JSC), 2013 WL  
21 1282892, at \*6 (N.D. Cal. Mar. 26, 2013) (citing *Weil v. Inv./Indicators, Research & Mgmt.*, 647  
22 F.2d 18, 24 (9th Cir. 1981)). “In practical terms, this means that parties in litigation may not abuse  
23 the privilege by asserting claims the opposing party cannot adequately dispute unless it has access  
24 to the privileged materials.” *Bittaker v. Woodford*, 331 F.3d 715, 719 (9th Cir. 2003); *see also*  
25 *Chevron Corp. v. Pennzoil Co.*, 974 F.2d 1156, 1162 (9th Cir. 1992) (“Where a party raises a  
26 claim which in fairness requires disclosure of the protected communication, the privilege may be  
27 implicitly waived.”). By contrast, “[a]n express waiver occurs when a party discloses privileged  
28 information to a third party who is not bound by the privilege, or otherwise shows disregard for



1 the privilege by making the information public.” *Bittaker*, 331 F.3d at 719. “A party need not  
2 have intended to waive privilege when it made the disclosure,” *Dukes*, 2013 WL 1282892 at \*7  
3 (citing *Weil*, 647 F.2d at 24), and “an express waiver need not be effectuated by words or  
4 accompanied by the litigant's subjective intent,” *Bittaker*, 331 F.3d at 719 n.4.

5 Similarly, work product protection also may be waived. *Nobles*, 422 U.S. at 239. An  
6 express or voluntary disclosure of work product waives the protection where such disclosure is  
7 made to an adversary in litigation or where the disclosure is made in a manner that substantially  
8 increases the opportunities for potential adversaries to obtain the work product. *Sanmina*, 968  
9 F.3d at 1121 (citing 8 Charles Alan Wright & Arthur R. Miller, *Federal Practice & Procedure*  
10 § 2024 (3d ed. 2020)); *see also Nidec Corp. v. Victor Co. of Japan*, 249 F.R.D. 575, 578 (N.D.  
11 Cal. 2007) (“[T]he work-product privilege may be waived by disclosure to third parties which  
12 results in disclosure to an adversary party.”). Work product protection may also be waived  
13 implicitly by putting the protected work product at issue, such as by asserting claims that the  
14 opposing party cannot adequately dispute unless it has access to that protected work product. *See*  
15 *Bittaker*, 331 F.3d at 719; *Chevron*, 974 F.2d at 1162-63; *Sanmina Corp.*, 968 F.3d at 1124  
16 (“While we are generally guided by the same fairness principle underlying waivers by implication  
17 in the attorney-client privilege context, the overriding concern in the work-product context is not  
18 the confidentiality of a communication, but the protection of the adversary process.”). Moreover,  
19 even if the protection is not waived, work product may be discoverable if the materials meet the  
20 requirements of Rule 26(b)(1) and if the party seeking production shows a “substantial need for  
21 the materials to prepare its case and cannot, without undue hardship, obtain their substantial  
22 equivalent by other means.” Fed. R. Civ. P. 26(b)(3)(A). Upon such a showing, a court must  
23 nevertheless “protect against disclosure of the mental impressions, conclusions, opinions, or legal  
24 theories of a party’s attorney or other representative concerning the litigation,” Fed. R. Civ. P.  
25 26(b)(3)(B).

### 26 **III. DISCUSSION**

27 Valeo asserts two principal arguments in support of its motion to compel. First, Valeo  
28 argues that NVIDIA is improperly withholding at least some non-privileged documents that

1 contain factual information about the investigation NVIDIA conducted. *See* Dkt. No. 99-2 at 8-  
2 11. Second, Valeo argues that NVIDIA has waived any privilege or protection that might  
3 otherwise apply to these documents, either expressly by disclosing the information they contain or  
4 impliedly by putting the investigation at issue in this action. *Id.* at 6, 9-13; *see also* Dkt. No. 116  
5 at 2. The Court addresses each of these arguments.

6 **A. Facts of the Investigation**

7 Valeo argues that it is entitled to discovery of all facts regarding the investigation NVIDIA  
8 conducted of Mr. Moniruzzaman’s conduct, including documents responsive to RFP 79. *See* Dkt.  
9 No. 99-2 at 10. Valeo says that NVIDIA has produced no documents responsive to RFP 79. *Id.* at  
10 7. NVIDIA does not disagree that Valeo is entitled to discovery of all facts regarding NVIDIA’s  
11 investigation, and NVIDIA concedes that it has produced no documents responsive to Valeo’s  
12 request. Dkt. No. 102 at 5, 13-14. NVIDIA takes the position that all of the documents  
13 responsive to RFP 79 are privileged or protected. *Id.* at 5-7; *see also* Dkt. No. 142 at 49:12-18  
14 (“We’re talking about free flowing narrative emails that, yes, do report on searches but don’t just  
15 touch on one topic, touch on a lot of privileged topics, a lot of legal advice and work product, and,  
16 yeah again they do repeat the search results, but—but it’s not like there’s a screenshot that says no  
17 results. If there was, we’d produce it.”). NVIDIA suggests that Valeo may obtain all of the  
18 discovery it requires from the affidavits it already has from the German action, interrogatories, and  
19 depositions. Dkt. No. 102 at 5.

20 NVIDIA’s position is difficult to square with its argument that *none* of the information  
21 disclosed in the affidavits filed in the German action is privileged or protected. Those affidavits  
22 disclose details of NVIDIA’s investigation, including (1) the nature and extent of the  
23 investigation, (2) searches run in an effort to locate Valeo information, (3) the identities of  
24 witnesses, (4) the contents of witnesses’ statements, and (5) communications between in-house  
25 counsel and witnesses. Valeo advises that, among the documents NVIDIA has withheld are  
26 communications between its in-house counsel, Mr. Chandler, and several NVIDIA employees.  
27 *See* Dkt. No. 142 at 35:25-36:2; Dkt. No. 93-7 (line 273); Dkt. No. 99-2 at 8. These  
28 communications are *quoted verbatim* in Mr. Chandler’s affidavit, and yet they have not been

1 produced. If, as NVIDIA contends, it has disclosed only factual information in the affidavits it  
2 filed in the German action, it may not now rely on a different characterization of that  
3 information—e.g., as a privileged communication—in identifying documents responsive to  
4 Valeo’s document requests.

5 However, because the parties have not briefed this dispute with respect to any particular  
6 entry on NVIDIA’s privilege log, the Court cannot conclude that NVIDIA is withholding specific  
7 documents that are simply factual records of its investigation. Thus, the Court turns to the  
8 question of waiver.

9 **B. Waiver of Attorney Work Product**

10 Valeo argues that NVIDIA has waived work product protection with respect to its  
11 investigation of Mr. Moniruzzaman’s conduct and Valeo’s misappropriation claims by relying on  
12 the details of the investigation and its results in this action. Dkt. No. 99-2 at 10; Dkt. No. 116 at  
13 2; *see also* Dkt. No. 142 at 7:2-11. Valeo points to NVIDIA’s affirmative defenses and its  
14 answers to Interrogatories Nos. 4 and 7, all of which rely to some extent on the investigation and  
15 the affidavits describing the investigation. Dkt. No. 99-2 at 6-7; Dkt. No 142 at 12:6-13:9.  
16 NVIDIA responds that because it has only disclosed *factual* information about its investigation,  
17 there has been no waiver of any work product. Dkt. No. 102 at 7. In addition, NVIDIA argues  
18 that to the extent the Court considers the affidavits filed by its in-house counsel in the German  
19 proceedings, these affidavits cannot be considered “voluntary” disclosures because NVIDIA was  
20 required to file these affidavits by the German court. *Id.* at 7-8.

21 As an initial matter, it is not entirely clear which attorneys’ work product is at issue, as  
22 neither party refers the Court to specific disputed privilege log entries. However, it appears that,  
23 at a minimum, Valeo contests NVIDIA’s assertion of work product protection for materials  
24 prepared by its in-house counsel, Mr. Chandler and Ms. Morrison, both of whom filed affidavits  
25 with the German court. Dkt. No. 99-2 at 10-11. As to these attorneys’ work product, the Court  
26 considers whether NVIDIA has expressly or implicitly waived work product protection.

27 For express waiver, the Court considers whether NVIDIA voluntarily disclosed work  
28 product information to an adversary and whether this disclosure constitutes “more than the fact of

1 [a document’s] existence,” such that otherwise protected content has been disclosed. *Sanmina*,  
2 968 F.3d at 1123. The Court easily concludes that NVIDIA expressly waived work product  
3 protection with respect to the information disclosed in Mr. Chandler’s and Ms. Morrison’s  
4 affidavits filed with the German court. Nothing in the record suggests that NVIDIA was ordered  
5 by the German court to submit affidavits from its attorneys; rather, NVIDIA chose to rely on  
6 affidavits from its in-house counsel. *See* Dkt. No. 142 at 43:15-18 (German court did not require  
7 NVIDIA to provide declarations of counsel). As summarized above, these affidavits disclosed  
8 details of NVIDIA’s investigation, including the nature and extent of the investigation, the  
9 identities of witnesses, the contents of witness interviews, the contents of communications with  
10 witnesses, and efforts to search for and collect files containing Valeo materials. Furthermore,  
11 while these affidavits were originally filed in connection with the German proceedings, NVIDIA  
12 now affirmatively relies upon the contents of these same affidavits in support of its defenses to  
13 Valeo’s claims in this action. *See* Dkt. No. 99-7 at 18 (“The details of those investigations are set  
14 out in the statements of Arthur Rajala, Jason Recla, Stephen Chandler, and Azadeh Morrison”);  
15 *see also* Dkt. No. 93 ¶¶ 9-10 (pointing Valeo to “the declarations of NVIDIA employees that  
16 detail the investigation at a high level”). In short, NVIDIA has made its in-house counsel fact  
17 witnesses. *See Rubalcava v. City of San Jose*, No. 20-cv-04191-BLF (VKD), 2022 WL 484988, at  
18 \*4 (N.D. Cal. Feb. 16, 2022) (finding waiver of work product where plaintiff “did not disclose  
19 merely that his attorney had done an investigation that included witness interviews; he disclosed  
20 the contents (or partial contents) of those interviews.”).

21 In any event, NVIDIA has certainly put its in-house counsel’s work product at issue by  
22 relying on the investigation these attorneys conducted in defending against Valeo’s claims. This  
23 reliance on the nature and quality of the investigation conducted by in-house counsel is  
24 inconsistent with NVIDIA’s efforts to shield its attorneys’ work from Valeo in this action, and  
25 thus NVIDIA has also implicitly waived work product protection as to these matters. *See*  
26 *Sanmina*, 968 F.3d at 1124 (“Presumably, Sanmina could have chosen to substantiate the  
27 deduction with other documents that did not make reference to the [attorney memoranda] but did  
28 not. Such conduct seems inconsistent with Sanmina’s purported goal of keeping the memoranda

1 secret from the IRS.”).

2 Valeo argues that NVIDIA’s waiver of work product protection extends beyond factual  
3 matters to any opinion work product related to the investigation based on NVIDIA’s purported  
4 intention to rely on the opinions of in-house counsel. Dkt. No. 99-2 at 11-12. Specifically, Valeo  
5 argues that NVIDIA intends to rely on counsel’s conclusions that NVIDIA’s internal investigation  
6 was (1) fulsome, comprehensive, and wide-ranging, and (2) did not reveal any evidence of  
7 misappropriation, access, or misuse. Dkt. No. 99-2 at 12-13; *see also* Dkt. No. 142 at 20:24-21:22  
8 (statements go beyond the factual “the files don’t exist” and instead relate the opinion that there is  
9 “no evidence that [Valeo code] was ever disclosed”), 24:23-25 (“[I]f it’s [Ms. Morrison’s] opinion  
10 about how comprehensive the search was, then . . . the only basis for her having that opinion  
11 would be as a lawyer.”). NVIDIA denies that it has relied, or will rely, on the opinions or  
12 conclusions of its in-house counsel. Dkt. No. 102 at 10-13.

13 The Court agrees with NVIDIA. As a general matter, a waiver of fact work product does  
14 not automatically extend to opinion work product, which typically includes counsel’s mental  
15 impressions, conclusions, opinions, or legal theories. *See* Fed. R. Civ. P. 26(b)(3)(B) (“If the court  
16 orders discovery of [work product], it must protect against disclosure of the mental impressions,  
17 conclusions, opinions, or legal theories of a party’s attorney or other representative concerning the  
18 litigation.”); *In re Lidoderm Antitrust Litig.*, No. 14-MD-02521-WHO, 2016 WL 4191612, at \*22  
19 (N.D. Cal. Aug. 9, 2016) (“Opinion work product ‘receives greater protection than ordinary work  
20 product and is discoverable only upon a showing of rare and exceptional circumstances.’”).  
21 Opinion work product *may* be waived where “a party affirmatively places attorney opinions at  
22 issue . . . or engages in selective disclosure,” such as where “a party intentionally disclos[es]  
23 materials helpful to its case while . . . conceal[ing] detrimental information on the same topic.”  
24 *Resilient Floor Covering Pension Fund v. Michael’s Floor Covering, Inc.*, No. 11-cv-5200 JSC,  
25 2012 WL 3062294, at \*7 (N.D. Cal. July 26, 2012). Here, in-house counsel’s description of the  
26 investigation as “extensive” and similar characterizations cannot fairly be described as a disclosure  
27 of opinion, and the Court is not persuaded that NVIDIA’s affirmative defenses necessarily put its  
28 in-house counsel’s opinions or advice at issue. As for NVIDIA’s responses to Valeo’s

1 interrogatories describing the outcome of the investigation, these responses likewise state factual  
2 conclusions or contentions—namely, that the investigation revealed “no copies of the allegedly  
3 retained Valeo code and no evidence that Mr. Moniruzzaman disclosed the allegedly retained  
4 Valeo code or any Valeo Trade Secret to any NVIDIA employee”—that do not reveal or  
5 necessarily depend upon counsel’s opinions or advice. *See* Dkt. No. 117-3 at 24.

6 Accordingly, if NVIDIA is withholding from production documents responsive to RFP 79  
7 on the basis of attorney work product, it may not do so to the extent those documents include  
8 factual information commensurate with the disclosures made by NVIDIA employees, including its  
9 in-house counsel, in the affidavits filed with the German court. If the documents contain fact work  
10 product that is intertwined with opinion work product, only those portions of the documents  
11 comprising fact work product must be produced to Valeo; NVIDIA may redact the portions  
12 containing opinion work product.

13 **C. Waiver of Attorney-Client Privilege**

14 Valeo also argues that NVIDIA has waived its attorney-client privilege with respect to its  
15 investigation of Mr. Moniruzzaman’s conduct and Valeo’s misappropriation claims by relying on  
16 the details of the investigation and its results in this action. Dkt. No. 99-2 at 6-9, 11-13. NVIDIA  
17 responds that it has not disclosed any privileged communications, and that it has not relied, and  
18 will not rely, on any advice or opinion of counsel in defending against Valeo’s claims. Dkt. No.  
19 102 at 7-8, 10-13.

20 The Court first considers whether NVIDIA has expressly waived the attorney-client  
21 privilege by disclosing a privileged communication to a third party who is not within the scope of  
22 the privilege. The record reflects that, at a minimum, NVIDIA has expressly waived the attorney-  
23 client privilege with respect to Mr. Chandler’s communications with NVIDIA employees, the  
24 contents of which are disclosed in Mr. Chandler’s affidavit filed in the German court. In view of  
25 this disclosure, NVIDIA may not protect these communications from disclosure by asserting they  
26 are privileged. *See Bittaker*, 331 F.3d at 719. All of the communications Mr. Chandler described  
27 in his affidavit must be produced in their entirety. The Court is not aware of any other express  
28 waivers by NVIDIA of its attorney-client privilege. However, as noted above, the Court is

1 skeptical of NVIDIA’s claim that no non-privileged records responsive to RFP 79 exist with  
2 respect to those portions of the investigation conducted by non-attorney NVIDIA employees, such  
3 as Mr. Recla and his subordinates. The Court reminds NVIDIA that a communication is not  
4 privileged merely because an attorney is copied on it; nor does the privilege encompass a record  
5 that is attached to, linked with, or pasted into a communication seeking advice of counsel, where  
6 the record itself is not privileged. *See, e.g., In re Google Play Store Antitrust Litig.*, No. 20-cv-  
7 05671-JD, 2024 WL 3302068, at \*14 (N.D. Cal. July 3, 2024) (admonishing defendant Google re  
8 abuse of the attorney-client privilege).

9 The Court next considers whether NVIDIA has impliedly waived the attorney-client  
10 privilege. “Substantial authority holds the attorney-client privilege to be impliedly waived where  
11 the client asserts a claim or defense that places at issue the nature of the privileged material.”  
12 *Bittaker*, 331 F.3d at 719 (citing Christopher B. Mueller & Laird C. Kirkpatrick, *Evidence:*  
13 *Practice Under the Rules* § 5.30, at 549 (2d ed. 1999)). Valeo has not shown that NVIDIA’s  
14 defenses in this action necessarily depend upon counsel’s opinions or advice, and NVIDIA has  
15 disavowed any intention to rely on advice of counsel in its defense. As explained above, the Court  
16 is not persuaded that NVIDIA’s in-house counsel’s characterizations of the investigation amount  
17 to a disclosure of attorney opinion or advice, or that NVIDIA has otherwise put its in-house  
18 counsel’s opinions or advice at issue. However, if it develops that NVIDIA’s subjective beliefs  
19 about the reliability of its investigation were informed by attorney advice, and if these subjective  
20 beliefs turn out to be critical to its defenses, such as good faith, then fairness may dictate a  
21 disclosure of the underlying advice. *See Lamartina v. VMware, Inc.*, No. 20-cv-02182-EJD  
22 (VKD), 2024 WL 3049450, at \*6 (N.D. Cal. June 17, 2024) (citing *In re Lidoderm*, 2016  
23 4191612, at \*5).

24 **D. Scope of Waiver or Privilege or Protection**

25 Although the parties did not brief any specific privilege log entries, NVIDIA contends that  
26 its log includes at least four categories of information that are necessarily protected from  
27 disclosure by the attorney-client privilege or the attorney work product doctrine. These categories  
28 are:

- 1 1. communications between NVIDIA’s legal team and its outside  
2 counsel regarding the investigation into Mr. Moniruzzaman’s  
3 conduct;
- 4 2. the exchange of drafts of filings to be made with the German court  
5 in response to Valeo’s civil actions against NVIDIA;
- 6 3. communications between NVIDIA employees and NVIDIA’s legal  
7 team regarding the employees’ contacts and communications with  
8 Mr. Moniruzzaman related to Valeo’s allegations; and
- 9 4. internal discussions between NVIDIA’s legal team and NVIDIA’s  
10 German outside counsel regarding the strategy for contending with  
11 the litigation Valeo brought against NVIDIA in Germany.

12 Dkt. No. 102-1 ¶ 7. During the hearing on its motion, Valeo asserted that NVIDIA’s privilege log  
13 contains a fifth category—investigation notes and search results which are definitely *not*  
14 privileged or protected. Dkt. No. 142 at 27:16-19.

15 In response to questions from the Court, Valeo clarified that it does not seek any  
16 documents concerning legal advice on issues of German law, litigation holds, legal strategies and  
17 defenses, or other documents reflecting legal advice generally concerning preparation for  
18 litigation. Dkt. No. 142 at 27:21-33:9. Instead, Valeo seeks: “every single fact and detail . . . and  
19 legal conclusion that NVIDIA relied on to justify” the conclusion that the internal investigation  
20 “was thorough” and found no evidence of Valeo source code. *See id.* at 32:13-15, 17-19.

21 Given the manner in which this dispute was briefed, the Court finds it difficult to  
22 definitively exclude or include any of the parties’ categories from the scope of the waivers of work  
23 product and privilege found in this order. However, it appears that the parties may be able to  
24 reach substantial agreement regarding which privilege log entries identify documents that are  
25 properly withheld, and the Court orders the parties to confer further on this point, as provided  
26 below.

#### 27 **IV. CONCLUSION**

28 For the reasons set forth above, the Court grants in part and denies in part Valeo’s motion  
as set forth above. That is, if NVIDIA is withholding from production documents responsive to  
RFP 79 on the basis of attorney work product, it may not do so to the extent those documents



1 include factual information commensurate with the disclosures made by NVIDIA employees,  
2 including its in-house counsel, in the affidavits filed with the German court. If the documents  
3 contain fact work product that is intertwined with opinion work product, only those portions of the  
4 documents comprising fact work product must be produced to Valeo; NVIDIA may redact the  
5 portions containing opinion work product. Additionally, NVIDIA may not withhold from  
6 production on the basis of attorney-client privilege Mr. Chandler’s communications with NVIDIA  
7 employees, the contents of which are disclosed in Mr. Chandler’s affidavit filed in the German  
8 court. All such communications must be produced in their entirety. The parties must confer  
9 regarding the remaining entries on NVIDIA’s privilege log.

10 The parties shall file a status report no later than **January 21, 2025**, advising the Court of  
11 the status of NVIDIA’s compliance with this order. If disputes regarding NVIDIA’s privilege log  
12 remain, the parties shall include their agreed or respective proposals for resolving the remaining  
13 disputes in their status report.

14 **IT IS SO ORDERED.**

15 Dated: January 6, 2025

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18 Virginia K. DeMarchi  
19 United States Magistrate Judge  
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