

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

NOKIA CORPORATION,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 09-791-GMS
)	
APPLE INC.,)	JURY TRIAL DEMANDED
)	
Defendant.)	
)	
_____ APPLE INC.)	
)	
Counterclaim-Plaintiff,)	
)	
v.)	
)	
NOKIA CORPORATION and NOKIA INC.)	
)	
Counterclaim-Defendants.)	

**APPLE, INC’S UNOPPOSED MOTION FOR THE ISSUANCE
OF A LETTER OF REQUEST FOR INTERNATIONAL JUDICIAL
ASSISTANCE PURSUANT TO THE HAGUE CONVENTION OF MARCH 18, 1970**

Pursuant to Federal Rule of Civil Procedure 28 and The Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters, March 18, 1970, 23 U.S.T. 2555 (“Hague Convention”), Apple Inc. (“Apple”) respectfully requests that the Court issue a Letter of Request (in the form attached hereto as Exhibit A) so that Apple may obtain the sworn testimony in Germany of Friedhelm Hillebrand.

Mr. Hillebrand was extensively involved in the creation of the Global System for Mobile Communications (“GSM”) and Universal Mobile Telecommunications Systems (“UMTS”) standards at the European Telecommunications Standards Institute (“ETSI”). By virtue of that experience, he was a first-hand witness to the development of ETSI’s Intellectual Property Rights (“IPR”) Policy, the meaning of which is central to Apple’s counterclaims. When Nokia

litigated similar issues against Qualcomm—taking positions about the ETSI IPR Policy opposite of those it has taken in this case—it relied on Mr. Hillebrand as an expert witness to provide an explanation of the purpose and meaning of the Policy. But he is not merely an expert witness—he is a *fact witness* for significant issues in this case.

Because Mr. Hillebrand is a non-party resident of Germany, Apple will not be able to obtain his testimony without the Court issuing a Letter of Request under the Hague Convention, and Apple respectfully requests that the Court issue this Letter.¹

I. BACKGROUND

Apple’s antitrust and contract counterclaims against Nokia center on Nokia’s abuse of, and disregard for, the requirements of ETSI’s IPR Policy. Nokia’s violation of the Policy allowed Nokia unlawfully to gain monopoly power in the form of its claimed-essential patents that it now seeks to exploit to injure Apple. Similarly, Apple’s contract counterclaims are based on Nokia’s disregard for the binding commitments it made to ETSI to comply with its IPR Policy and for which Apple was a third-party beneficiary.²

As the basis for these claims, Apple alleges that Nokia engaged in deceptive conduct during the standard-setting process at ETSI by failing to disclose that it possessed IPR purportedly covering proposals it made for additions or changes to the standards under development, including GSM and UMTS, as required by the ETSI IPR Policy. Further, Apple alleges that when Nokia eventually disclosed its purportedly-essential IPR to ETSI and made untimely promises to license it on fair, reasonable, and non-discriminatory (“FRAND”) terms, as

¹ Counsel met and conferred regarding this Motion. Nokia does not oppose Apple’s request to depose Mr. Hillebrand.

² In addition, Nokia’s misconduct at ETSI is relevant to Apple’s defenses to Nokia’s infringement claims for ten of Nokia’s patents-in-suit that it claims are essential to standards promulgated by ETSI.

is required by the IPR Policy, those promises were false. That fact has been demonstrated by Nokia's unreasonably high and discriminatory, non-FRAND demands of Apple during the parties' licensing negotiations. Nokia has further violated those FRAND commitments by now seeking an injunction against Apple for its purportedly-essential patents. As Nokia argued in its litigation with Qualcomm, relying in part on Mr. Hillebrand's knowledge of the ETSI IPR Policy, once a FRAND commitment is made, a patent owner "is not entitled to an injunction or exclusion order that could prevent the implementation of the standard – except in extraordinary circumstances, such as where the manufacturer refuses to pay judicially determined FRAND compensation for the actual infringement of a valid essential patent." (Ex. C, Plaintiff's Opening Pre-Trial Brief, *Nokia Corp. v. Qualcomm Inc.*, CA. No. 2330-VCS (Del. Chancery), at 1-2.)

Mr. Hillebrand has a long history at ETSI that gives him personal, first-hand knowledge about the ETSI IPR Policy. He served as Chairman of ETSI's Technical Committee Special Mobile Group from 1996 to 2000 with responsibility for leading ETSI's work on the standardization of UMTS and GSM. (See Ex. 1 to Ex. A, Expert Report of Friedhelm Hillebrand, *Nokia Corp. v. Qualcomm Inc.*, C.A. No. 2330-VCS (Del. Chancery), May 22, 2008 ("Hillebrand Report"), at 3-4.) In addition, Mr. Hillebrand was involved in the development of the principles for the IPR policy for GSM standardization. (See Ex. D, Hillebrand & Partners Profile of Friedhelm Hillebrand.) Mr. Hillebrand also edited a book that provides a history of the development of GSM and UMTS: *GSM and UMTS: The Creation of Global Mobile Communication* (Friedhelm Hillebrand ed., Wiley 2002).

Based on Mr. Hillebrand's knowledge of ETSI, Nokia retained him to offer his understanding about ETSI and its IPR Policy in Nokia's litigation with Qualcomm—an understanding that now directly contradicts many of the new positions that Nokia has taken

against Apple, including that it may enjoin Apple for patents it claims are standards-essential. For instance, in its pre-trial brief in that case, Nokia quoted Mr. Hillebrand describing his understanding that the “heart of the IPR Policy” is that a FRAND commitment precludes seeking an injunction:

The intention in ETSI was that once the undertaking is given, the owner would have no possibility to use his blocking rights as long as the licensee is prepared to accept FRAND terms and conditions. . . . This was commonly understood, and is very much at the heart of the IPR Policy.

(Ex. C at 45 (quoting Hillebrand Report ¶19) (alterations supplied).) Mr. Hillebrand also stressed that FRAND royalties must be set at low rates, to facilitate industry adoption of standardized technology:

In GSM and UMTS standardization there was always recognition and concern that high royalties might make the handsets so expensive that the creation of a global mass market would fail. During the UMTS radio decision a lot of parties, especially network operators expressed great concern about the level of IPR they expected for WCDMA in December 1997. Even the European Commission made a formal statement that “[it] would consider appropriate action if the behavior of IPR holders were to threaten the development of UMTS in Europe and at global level. This was expressed by the supporters of WCDMA in the UMTS radio decision in January 1998 requested “The cumulative maximum cost should be set at a reasonable level.” The UMTS IPR working group created in the spring of 1998 came to an agreement that a single digit percentage would be the maximum bearable.

(Ex. 2 to Ex. A, Rebuttal Report of Friedhelm Hillebrand, *Nokia Corp. v. Qualcomm Inc.*, C.A. No. 2330-VCS (Del. Chancery), June 6, 2008, at p.14.) Despite earlier advocating—with Mr. Hillebrand’s support—these positions, Nokia has reversed itself and sought unreasonably high royalties from, and an injunction against, Apple.

As set forth in the proposed questions for the German court to ask Mr. Hillebrand (contained in Schedule A to Exhibit A), Apple seeks to elicit testimony about the ETSI IPR

Policy and to confirm the accuracy of the positions he took about the Policy in his expert reports on Nokia's behalf in its litigation with Qualcomm.³ This testimony is within Mr. Hillebrand's personal capacity as a *fact witness*, and Nokia cannot shield this testimony by retaining Mr. Hillebrand as a paid consultant (for this or other litigations).

II. ARGUMENT

A. The Hague Convention is the Appropriate Means To Seek Testimony From Mr. Hillebrand

Rule 28(b) of the Federal Rules of Civil Procedure provides that a deposition may be taken in a foreign country by, among other means, proceeding under “an applicable treaty or convention.” Fed. R. Civ. P. 28(b); *see also* 28 USC § 1781(b)(2) (permitting the “transmittal of a letter rogatory or request directly from a tribunal in the United States to the foreign or international tribunal, officer, or agency to whom it is addressed and its return in the same manner”). Both the United States and Germany are signatories to the Hague Convention. *See* 23 U.S.T. 2555. Under Article 1 of the Convention, “[i]n civil or commercial matters a judicial authority of a Contracting State may . . . request the competent authority of another Contracting State, by means of a Letter of Request, to obtain evidence, or to perform some other judicial act.” *Id.*, Art. 1. Article 3 of the Convention sets forth the requirements for a Letter of Request and specifically provides that an issuing court may identify “persons to be examined” and request that such examination “be given on oath or affirmation.” *Id.*, Art. 3(e), (h).

The Hague Convention “procedures are available whenever they will facilitate the gathering of evidence by the means authorized in the Convention.” *Société Nationale Industrielle Aéropostiale v. U.S. Dist. Ct. for the S. Dist. of Iowa*, 482 U.S. 522, 541 (1987). Use

³ Apple also may offer Mr. Hillebrand's expert reports from Nokia's litigation with Qualcomm directly into evidence at trial, including through Fed. R. Evid. 807.

of the Convention is particularly appropriate where, as here, the witness to be examined (i) is not a party to the litigation, (ii) has not voluntarily subjected himself to discovery, (iii) is a foreign citizen, and (iv) is not otherwise subject to the jurisdiction of the Court. *See Pronova Biopharma Norge AS v. Teva Pharmaceuticals USA, Inc.*, 708 F.Supp.2d 450, 453 (D. Del. 2010) (granting request to issue Letters of Request for examination of non-party witnesses in Norway and Sweden); *Abbott Labs. v. Impax Labs., Inc.*, 2004 WL 1622223, at *2-3 (D. Del. July 15, 2004) (same for witnesses in France); *Tulip Computers Int'l B.V. v. Dell Computer Corp.*, 254 F.Supp.2d 469, 474-75 (D. Del. 2003) (same for witnesses in the Netherlands).

The proposed Letter of Request submitted as Exhibit A conforms to the requirements of Article 3 of the Convention (as well as the model Letter of Request reprinted in 28 U.S.C. § 1781).⁴ Specifically, Apple's Letter of Request describes the nature of the proceedings for which the evidence is required, the identity of the person to be examined, the evidence to be obtained, and includes a request that the examination be conducted under oath. *See* 23 U.S.T. 2555, Art. 3. In addition, consistent with Germany's procedure of having courts conduct examination of witnesses, the Letter of Request sets forth specific questions to be posed to Mr. Hillebrand and attaches copies of the expert reports about which he is to be examined. *See* Ex. E, Germany's Response to the 2008 Hague Convention Questionnaire, ¶ 64 ("The questions to be addressed to the person to be interrogated are to be asked already in the Letter of Request"); *see also id.* ¶¶ 36, 51, and 63; 23 U.S.T. 2555, Art. 3(f) (requiring a Letter of Request to specify "the questions to be put to the persons to be examined or a statement of the subject-matter about which they are to be examined").

⁴ Under Article 4 of the Convention, a "Letter of Request shall be in the language of the authority requested to execute it or be accompanied by a translation into that language." 23 U.S.T. 2555, Art. 4. Apple submits as Exhibit B a German translation of Exhibit A and the attached expert reports of Mr. Hillebrand.

B. Mr. Hillebrand Possesses Relevant Evidence

Invoking the procedures of the Hague Convention to compel testimony is appropriate where doing so is reasonably calculated to lead to the discovery of admissible evidence. *See Ethypharm S.A. France v. Abbott Labs.*, 748 F.Supp.2d 354, 359 (D.Del. 2010) (applying Fed. R. Civ. P. 26 to determination of whether to grant request for testimony under Hague Convention); *see also In re Urethane Antitrust Litig.*, 267 F.R.D. 361, 364 (D. Kan. 2010) (“in considering motions for the issuance of letters of request, courts ordinarily will not weigh the evidence that is to be adduced”) (quotations omitted).

Here, as set forth above, through his work at ETSI, Mr. Hillebrand was a first-hand fact witness to the development and application of the ETSI IPR Policy. Accordingly, he will be able to offer testimony that is relevant to Apple’s antitrust and contract counterclaims centering on Nokia’s failure to abide by the IPR Policy. The relevance of this testimony is underscored by the fact that in litigating similar claims against Qualcomm (albeit from a position that now appears closer to Apple’s than its current one), Nokia retained Mr. Hillebrand to testify concerning the same topics about which Apple seeks to examine him. But again, he is not merely an expert witness, but rather a fact witness for key issues in this case.

III. CONCLUSION

For the foregoing reasons, Apple respectfully requests that the Court grant its Motion and execute the Letter of Request attached hereto as Exhibit A along with the German translation attached hereto as Exhibit B, providing the undersigned counsel with an original signed copy of each to transmit to the appropriate authorities in Germany.

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CERTIFICATE OF SERVICE

I, David E. Moore, hereby certify that on May 16, 2011, the attached document was electronically filed with the Clerk of the Court using CM/ECF which will send notification to the registered attorney(s) of record that the document has been filed and is available for viewing and downloading.

I hereby certify that on May 16, 2011, the attached document was electronically mailed to the following person(s)

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