UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA

NOKIA CORPORATION, Keilalahdentie 4, Espoo, Finland, Plaintiff, v. APPLE INC., 1 Infinite Loop, Cupertino, CA 95014, Defendant.	Miscellaneous Action No. _____ Underlying Case in the District of Delaware Civil Action No. 09-791-GMS Assigned to: Honorable Gregory M. Sleet
APPLE INC., Counterclaim-Plaintiff, v. NOKIA CORPORATION and NOKIA INC., Counterclaim-Defendants.	

NOKIA CORPORATION'S MOTION TO COMPEL DEPOSITION TESTIMONY OF THIRD PARTY WITNESSES

INTRODUCTION

This motion is made necessary because counsel for the subpoenaed witnesses, four attorneys who were present at the reexamination interviews for US Patents 5,315,703 (the "703 patent") and 5,455,854 (the "854 patent"), have refused to appear for their depositions. Subpoenas on these attorneys were served on March 25 and the depositions were originally noticed for April 21 and 22, 2010. The individuals have delayed scheduling their depositions for weeks and most recently have indicated, through their attorney, that they will not appear in response to the subpoenas. While they have threatened to move for a protective order they have not done so. Hence, they are in contempt for failing to appear and the order compelling their attendance appropriate.

The information possessed by these deponents, with regard at least to their participation in a face to face meeting with the US PTO examiner, is part of Nokia's defense of the case as it relates to the 854 and 703 patents. For the reasons set forth herein, Nokia respectfully requests that this Court issue an order compelling Messrs. Robert Sterne, Glenn Perry, Richard Coller, and Salvador Bezos to appear for deposition on July 11, 12, 13 and 14, 2011 at Alston + Bird's Washington DC office..

BACKGROUND

I. Procedural Background of the Underlying Delaware Action

On October 22, 2009, Nokia instituted an action against Apple in the United States District Court for the District of Delaware for refusing to compensate Nokia for Apple's unauthorized use of ten of Nokia's patents declared essential to the GSM, UMTS, and/or IEEE 802.11 wireless

communication standards – *Nokia Corp. v. Apple Inc.*, No. 09-CV-791 (D. Del.) ("the Delaware Action") (Declaration of Rohan Kale ("Kale Dec."), ¶ 2, Ex. A). On December 11, 2009, Apple filed its Answer and Counterclaims, alleging Nokia of infringement of thirteen computer related patents (*id.* at ¶ 3, Ex. B). Two of the patents asserted by Apple against Nokia are US Patents 5,315,703 ("the 703 patent") and 5,455,854 ("the 854 patent") (*id.* at Ex. B, ¶ 224, 248).

Shortly thereafter, the 854 and 703 patents entered reexamination proceedings in the United States Patent and Trademark Office. On October 28, 2010 and December 23, 2010, the PTO issued office actions for the 854 and 703 patents, respectively, rejecting the claims as being either anticipated or obvious over prior art (*id.* at ¶ 4, Ex. C). On December 14, 2010, Attorneys Robert Sterne, Glenn Perry, Richard Coller, and Sal Bezos, from the law firm Sterne, Kessler, Goldstein, and Fox LLP, attended interviews with the PTO Examiner in an effort to distinguish the 854 patent over the invalidating prior art (*id.* at ¶ 5, Ex. D). The same attorneys attended a similar interview on February 8, 2010 in an effort to distinguish the 703 patent over invalidating prior art (*id.*).

The attorneys from Sterne, Kessler, Goldstein, and Fox LLP are not currently representing Apple in the pending Delaware action but were only involved during the reexamination patent prosecution for the 854 and 703 patents (*id.*).

II. Nokia's Subpoenas for Deposition Testimony from the Attorneys Present at the Examiner Interviews

The four witnesses at issue here are Robert Sterne, Glenn Perry, Richard Coller, and Sal Bezos. These witnesses personally attended the interviews with

the United States Patent and Trademark Office Examiner during the reexamination proceedings for the 854 and 703 patents, where discussions were held comparing the scope of the 854 and 703 patents to invalidating prior art (Kale Decl. at ¶ 5, Ex. D). On March 25, 2011, Nokia served the witnesses deposition subpoenas noticed for April 21 and 22, 2010 (*id.* at ¶ 6, Ex. E). On April 8, 2011, the witnesses provided Nokia with their objections to the subpoenas and each indicated that the witnesses would not appear, listing a litany of issues they wanted resolved (*id.* at ¶ 8, Ex. G).

Following a series of correspondence in which Nokia attempted to schedule these depositions and alleviate the concerns of the witnesses, the witnesses offered to provide a corporate representative pursuant to Federal Rule of Civil Procedure 30(b)(6) if Nokia withdrew the subpoenas (*id.* at ¶ 9). Nokia rejected this proposal and repeated its request for dates for the depositions (*id.* at ¶ 10). The witnesses, however, refused to even propose alternative dates (*id.*). On April 29, after 10 days of silence from the witnesses, Nokia made a final attempt to obtain alternative deposition dates (*id.* at ¶ 11). The witnesses finally responded on May 4, demanding that Nokia withdraw the subpoenas and indicating that they would not comply with the deposition subpoenas (*id.* at ¶ 13).

Because the witness have refused to appear for these important depositions, an order compelling their appearance is now appropriate.

ARGUMENT

I. THE HEIGHTENTED TEST CITED BY THE SUBPOENAED WITNESSES IN THEIR OBJECTIONS DOES NOT APPLY

The excuses the witnesses have advanced for failing to appear for their depositions and not comply with the subpoenas cannot withstand even a cursory examination. As an initial matter, the witnesses have cited, in their correspondence with Nokia, a test articulated by the 8th Circuit in *Shelton v. Am. Motors Corp.*, 805 F.2d 1323 (8th. Cir. 1986) to determine when opposing *trial* counsel should be deposed. The test is satisfied when: 1) no other means exist to obtain the information; 2) the information sought is relevant and non-privileged; and 3) the information sought is crucial to the preparation of the case (*id.* at 1327). The witnesses' reliance on *Shelton*, however, is misplaced, as the test only applies when the witness sought to be deposed is opposing *trial* counsel involved in an ongoing litigation. *Pamida, Inc. v. E.S. Originals, Inc.*, 281 F.3d 726, 730 (8th Cir. 2002).

In this case the witnesses are not trial counsel. The subpoenaed witnesses served only as prosecution attorneys during reexamination. Since they are not trial counsel in the ongoing Delaware action, the *Shelton* test does not apply here. Non trial lawyers are often deposed if they are percipient witnesses with discoverable facts related to the ongoing litigation. *See United States v. Philip Morris,* 209 F.R.D. 13 at 14 (D.D.C. 2002) (not applying the *Shelton* factors for counsel who were involved with non-privileged, factual matters separate from on going litigation). Indeed, when dealing with prosecution attorneys the courts have specifically rejected the *Shelton* test. *See, aaiPharma, Inc. v. Kremers Urban*

Dev. Co., 361 F. Supp. 2d 770, 775 (N.D. Ill. 2005) (not applying the *Shelton* test where Defendants sought testimony from counsel regarding prosecution of the patents in suit and not about the underlying litigation).

Even if the heightened test articulated in *Shelton* applies, however, all three prongs are satisfied.

II. THE WITNESSES CLEARLY POSSESS RELEVANT, NON-PRIVILEGED FACTS,

A. The Witnesses are percipient witnesses to the public interview with the Examiner and their testimony is relevant to the preparation of Nokia's case.

The scope of permissible discovery in district court actions is governed by Rule 26(b)(1), which provides that "parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense." Furthermore, "[d]iscovery requests are relevant when they seek admissible evidence or evidence that is 'reasonably calculated to lead to the discovery of admissible evidence.'" *Wiwa v. Royal Dutch Petroleum Co.*, 392 F.3d 812, 820 (quoting *McLeod, Alexander, Powel & Apffel, P.C. v. Quarles,* 894 F.2d 1482, 1484 (5th Cir. 1990).

The deposition testimony sought by Nokia is foundational – it is the key to understanding how Apple has characterized the 854 and 703 patents in order to overcome prior art rejections made during reexamination. Messrs. Sterne, Perry, Coller, and Bezos were present at the reexamination and were subpoenaed in their individual capacities as percipient fact witnesses that have non-privileged, personal knowledge of events that transpired at the reexamination interviews. *See*

Amicus Commc'ns., L.P., v. Hewlett-Packard Co., No 99-0284 HHK/DAR, 1999 U.S. Dist. Lexis 20901 *5 (D.D.C. 1999) ("when a party employs a counsel to represent it in a case where an attorney has played a role in the underlying facts, both the attorney and the party have every reason to expect that the attorney's deposition may be requested") (quoting *United Phosphorus, Ltd. v. Midland Fumigant, Inc., 164 F.R.D. 245, 249* (D.Kan. 1995)).

The disclosures the witnesses made to the patent examiner in order to distinguish prior art cuts toward the very scope of the patents at issue and are thus crucial to the preparation of Nokia's ongoing case in the Delaware action. These non-privileged, factual disclosures regarding the scope of the claims are also relevant because they can potentially undermine Apple's interpretations of the claims used as the basis for Apple's patent infringement arguments in the Delaware action.

B. Because Apple's attorneys made disclosures that define the scope of the inventions to the patent examiner, the details of the disclosures are not privileged and do not fall under the work product doctrine.

Nokia has the right to obtain the details of the events that transpired at the reexamination interviews, including what was said to the examiner directly from the person who said it. Nokia has a right to investigate fully and to obtain this information directly from the witnesses involved.

The deposition testimony requested from the subpoenaed witnesses is not protected by attorney-client privilege. Messrs. Sterne, Perry, Coller, and Bezos made specific disclosures regarding the scope of the 854 and 703 patents to the patent examiner, thereby waiving any attorney-client privilege claims as to those

disclosures. If counsel for the subpoenaed witnesses believes a particular question calls for a privileged response, he or she can still interpose a privilege objection. *See Evans v. Atwood*, No. 96-2746 (RMU), 1999 U.S. Dist. Lexis 17545 at *15-*16 (D.D.C. 1999) (allowing the deposition of a defendant's attorney and recognizing that defendants are free to invoke the attorney client privilege on a question by question basis). This Court has also recognized that depositions of patent prosecution counsel are frequently allowed and has refused to uphold blanket invocations of attorney-client privilege (*Amicus Commc'ns, L.P.*, 1999 U.S. Dist. Lexis 20901 at *6-*7 (D.D.C. 1999).

C. No other means exist to obtain the detailed information for the events that transpired at the reexamination interviews.

The witnesses have also objected to the deposition subpoenas claiming that Nokia can obtain the information regarding the reexamination interviews by other means. The details of the events of the interviews, however, are discoverable from the people who attended the interview. The terse and overly simplified interview summaries, prepared entirely by Apple's own counsel, are hardly sufficient to explain in detail the non-privileged discussion that occurred at the interviews. The only mechanism in which to obtain the detailed information regarding the specific disclosures of prosecution counsel to the patent examiner is through deposition testimony of the prosecution attorneys themselves. There is no complete written record of what was said at the reexamination interviews of the 854 and 703 patents.

As such, Nokia is entitled to the recollections of all witnesses present at the reexamination interviews to ensure that Nokia obtains a complete picture of

what transpired at the interviews.

CONCLUSION

Nokia respectfully requests that the Court order that Messrs. Robert Sterne, Glenn Perry, Richard Coller, and Salvador Bezos be made available for depositions at reasonable times on July 11, 12, 13, and 14, 2011, at Alston + Bird's Washington D.C. offices.

This 17th day of May, 2011.

PATRICK A. FITCH
D.C. Bar No. 989829

ALSTON & BIRD LLP
The Atlantic Building
950 F Street, NW
Washington, D.C. 20004-1404

Jack B. Blumenfeld (#1014)
Rodger D. Smith II (#3778)
MORRIS, NICHOLS, ARSHT &
TUNNELL LLP
1201 North Market Street
P.O. Box 1347
Wilmington, DE 19899
(302) 658-9200
jblumenfeld@mnat.com
rsmith@mnat.com

Attorneys for NOKIA CORPORATION and NOKIA INC.

Of Counsel:
Patrick J. Flinn
Peter Kontio
John D. Haynes
Mark A. McCarty
Adam J. Biegel
ALSTON & BIRD LLP
1201 W. Peachtree Street
Atlanta, GA 30309-3424
(404) 881-7000

CERTIFICATE OF SERVICE

I hereby certify that copies of the foregoing were caused to be served on May 17, 2011, upon the following in the manner indicated:

Richard L. Horwitz, Esq.
David E. Moore, Esq.
POTTER, ANDERSON & CORROON LLP
Hercules Plaza – 6th Floor
1313 North Market Street
Wilmington, DE 19801

Via Electronic Mail

William F. Lee, Esq.
Mark D. Selwyn, Esq.
WilmerHale
60 State Street
Boston, MA 02109

Via Electronic Mail

Kenneth H. Bridges, Esq.
Michael T. Pieja, Esq.
Bridges & Mavrakakis LLP
540 Cowper Street
Suite 100
Palo Alto, CA 94301

Via Electronic Mail

Dated: May 17, 2011

Patrick A. Fitch
D.C. Bar No. 989829

ALSTON & BIRD LLP
The Atlantic Building
950 F Street NW
Washington, DC 20004-1014