

IN THE UNITED STATES DISTRICT COURT  
DISTRICT OF COLUMBIA

IN RE THIRD PARTY SUBPOENAS AD TESTIFICANDUM	Case No. 1:11-MC-00284-EGS
Nokia Corporation,  Plaintiff,  v.  Apple Inc.,  Defendant.	Case No. District of Delaware Civil Action No. 1:09-cv-00791- GMS

**NONPARTIES' OPPOSITION TO NOKIA'S MOTION  
TO COMPEL DEPOSITION TESTIMONY**

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## ***I. Introduction and Background***

Robert Sterne, Glenn Perry, Richard Coller, and Sal Bezos (the "Apple Attorneys") oppose Nokia's Motion to Compel, which was filed the same day the Apple Attorney's filed the Nonparties' Motion to Quash in Case No. 1:11-MC-00295-RLW (the "related case"). Both this motion and the related motion to quash concern the same deposition subpoenas of the Apple Attorneys. Briefing on the Nonparties' Motion to Quash in the related case is at a more advanced stage; the briefing on the Apple Attorneys' Motion to Quash closed today with the filing of a reply brief.<sup>1</sup> (Copies of the Apple Attorneys' Motion to Quash, Nokia's Opposition, and the Apple Attorneys' Reply (without exhibits) are attached here as Exhibits 1-3.)

In the underlying litigation, *Nokia Corporation v. Apple Inc.*, No. 1:09-cv-00791-GMS (D. Del.), Apple made a counterclaim against Nokia, asserting that Nokia infringed nine of its patents. On April 28, 2010, an attorney from Brient IP Law filed *ex parte* reexamination requests on behalf of an anonymous requester against those nine patents.

A patent reexamination is a challenge to the patentability of a patent before the United States Patent and Trademark Office (the "Office"). Because patent reexaminations provide accused patent infringers two bites at the invalidity apple—one in the District Court and the other at the Office—defendants often request patent reexaminations of the patents-in-suit as a defense tactic in patent litigations. This case is no different. Although the reexaminations handled by the Apple Attorneys were anonymously requested, the evidence shows that Nokia

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<sup>1</sup> Nokia did not effect service of its motion to compel until May 26, 2011.

likely requested the reexaminations of the patents Apple asserted against Nokia as Nokia is the only counterclaim defendant for these patents.

Nokia then served the deposition subpoenas at issue on the Apple Attorneys, each of whom represent Apple Inc. in six of the nine reexaminations.<sup>2</sup> The Apple Attorneys' prosecution of these patent reexaminations is closely tied to the issues in the underlying litigation because the basis of the validity challenges to the patents are largely the same in both.

Nokia's Motion to Compel and its Opposition in the related motion to quash articulate only one area of testimony that it believes is non-privileged and relevant—statements made at the interviews of two of the six patent reexaminations conducted by the Apple Attorneys. Initially, counsel for the Apple Attorneys offered to allow the depositions if Nokia would limit the scope of the depositions by serving a list of Rule 30(b)(6) deposition topics. Nokia refused. (Emails between Rohan Kale, Nokia's counsel, and Byron Pickard, Apple Attorneys' counsel, attached hereto as Exhibits 4 & 5.) And now for the first time in briefing on both motions, and only in an attempt to show relevance, does Nokia suggest that the depositions will be limited to the oral discussions that occurred during the interviews between the Apple Attorneys and the Patent Office. Apple's oral statements that are not in written file history are not relevant as they do not inform the question of claim construction. Those statements are not part of the prosecution history and are simply extrinsic evidence. But it is the intrinsic evidence which is the primary, and usually the sole, focus of claim construction. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1327 (Fed. Cir. 2005) (*en banc*); *PureChoice, Inc. v. Honeywell Int'l, Inc.*, No. 2:06-CV-244, 2008 WL 190317, at \*7 (E.D. Tex. Jan. 22, 2008) ("The lack of written record

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<sup>2</sup> Those reexaminations are (1) Control No. 90/010,964, involving U.S. Patent No. 5,634,074; (2) Control No. 90/010,967, involving U.S. Patent No. 5,315,703; (3) Control No. 90/010,965, involving U.S. Patent No. 5,455,854; (4) Control No. 90/010,966, involving U.S. Patent No. 6,239,795; (5) Control No. 90/010,970, involving U.S. Patent No. 6,189,034; and (6) Control No. 90/010,969, involving U.S. Patent No. 7,383,453.

[concerning statements made at an interview], however, does not provide this court or the public with any information in the prosecution history to determine the scope of these claim terms."). Nokia has not shown why the claims at issue in its litigation with Apple require the consideration of extrinsic evidence. Instead, Nokia offers the vague assertions "[t]he 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" and "[t]he disclosures the [Apple Attorneys] 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 ." (Nokia Mot. to Compel 6-7.) These assertions do not establish relevancy.

In Nokia's Opposition in the related case, Nokia further contends that "[t]his testimony [concerning statements at the two interviews] goes to the heart of why the patent office distinguished the patents from highly anticipatory prior art and serves as public notice to what infringes or invalidates the claims." (Nokia Opp. 5, Exhibit 2.) This reasoning does not make sense. First, oral statements made at an interview that are not included in interview summaries as a practical matter can serve no public-notice function for the simple reason that they do not appear in the written file history. Second, the question of why the Patent Office allowed the claims cannot be answered by considering the oral statements at the interview that are not included in the interview summary. The Patent Office's rules only allow patentability decisions to be based on the written record. 37 C.F.R. § 1.2; M.P.E.P §§ 713.04, 2281. And, the Patent Office is presumed to follow its own rules. *Rite-Hite Corp. v. Kelley Co.*, 819 F.2d 1120, 1122-23 (Fed. Cir. 1987) ("[Defendant] Kelley has provided neither evidence nor inference to overcome the presumption that the PTO complied with its own rules.") Third, the reasons why

the patent office confirmed Apple's patent claims are found in the examiner's written reasons for allowance, contained in the Notices of Intent to Issue Reexam Certificates (commonly referred to as "NIRCs").<sup>3</sup> (Notice of Intent to Issue a Reexam Certificate mailed March 29, 2011, Control No. 90/010,967 (U.S. Patent No. 5,315,703), attached here as Exhibit 6; Notice of Intent to Issue a Reexam Certificate mailed January 13, 2011, Control No. 90/010,965 (U.S. Patent No. 5,455,854), attached here as Exhibit 7.) Nokia's Motion to Compel in this case and its Opposition in the related case completely ignore the Patent Office's rules and practices that make the oral statements irrelevant to issues of patentability and not part of the prosecution history.

Further supporting the denial of Nokia's Motion to Compel is that there is no real dispute that privilege issues will be encountered. (*See* Nokia Opp. 6, Exhibit 2.) Additionally, the information Nokia seeks is available from other sources including the inventor, who Nokia has not deposed, and the Examiners, who Nokia ignores in its Opposition as a source of the information it wants. Nokia instead argues it should be allowed discovery of the same information from "all witnesses present at the interviews." (Nokia Opp. 7; *see also* Nokia Mot. to Compel 8.) Given the lack of relevance of the information sought and the likelihood of intruding on privileged information, the Court should not allow Nokia to take this discovery of the Apple Attorneys because that exercise would be cumulative, duplicative, and unnecessarily burdensome. Fed. R. Civ. P. 26(b)(2)(C).

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<sup>3</sup> Notably, in the '854 patent reexamination, the examiner stated that that Apple's written remarks filed on December 23, 2010 were "persuasive" and therefore withdrew the rejections and confirmed the claims. ('854 patent reexamination NIRC, Exhibit 7, p. 2, ¶4.) There was no mention of the interview as a reason for confirming the '854 patent's claims. The NIRC for the '704 patent reexamination also references Apple's written responses to the Office as the reasons for confirming the claims in reexamination. ('704 patent reexamination NIRC, Exhibit 6.) Again the NIRC in that case does not mention any statements made at the interview as a reason for confirming the claims.

## ***II. Oral Conversations During the Interviews Are Not Relevant***

Oral statements to the Patent Office are not part of the patent's intrinsic evidence. *See PureChoice, Inc. v. Honeywell Int'l, Inc.*, No. 2:06-CV-244, 2008 WL 190317, at \*7 (E.D. Tex. Jan. 22, 2008). It is the intrinsic evidence—the patent and the written file history—that governs claim construction, except in rare cases. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1327 (Fed. Cir. 2005) (*en banc*). Thus, the information Nokia seeks is not relevant to claim construction as Nokia implies. Because Nokia has failed to show relevancy, depositions of the Apple Attorneys on the reexaminations are not appropriate or necessary.

Nokia also ignores the basic fact that anything said at an interview that is not part of a written interview summary cannot be considered by the Patent Office. M.P.E.P. § 713.04 (citing 37 C.F.R. § 1.2). This Patent Office rule dovetails with the important public-notice function that the file history and patent provide—because the public must be able to rely on the file-wrapper and the patent, everything relevant to patentability must be written in the file history or the patent itself. 37 C.F.R. § 1.2; M.P.E.P §§ 713.04, 2281. In Nokia's Opposition in the related case, Nokia recognizes the public-notice function of the patent and the file wrapper, but it tries to turn this notion on its head by arguing that oral statements made at an interview (and not made a part of the administrative record of the patent by including them in an interview summary) can somehow serve a public-notice function. But that does not make sense. How can unwritten statements recorded only in human memory serve as notice to the public?

Indeed, Nokia's Opposition in the related case does not cite a single case where an applicant's or patent owner's oral statements at an interview were considered as relevant for any purpose by a District Court. To be sure, the two cases Nokia cites for patent-owner statements being relevant, both involved statements in the written file history of the patents-in-suit.

*Gilliespie v. Dywidag Sys. Int'l, USA*, 501 F.3d 1285, 1291 (Fed. Cir. 2007); *Springs Window Fashions L.P. v. Novo Indus., L.P.*, 323 F.3d 989, 995 (Fed Cir. 2003).

**III. Other More-Accessible and Less-Burdensome Sources of Relevant Information Exist**

Everything relevant to the reexamination of the patents-in-suit is contained in the publicly available file wrappers. The file wrappers include the written interview summaries provided by the examiners, Apple's detailed multi-page slide presentations from the interviews, Apple's statements of substance of the interview, and most significantly, Apple's written responses to the Office Actions. See M.P.E.P. § 713.04; 37 C.F.R. § 1.560(b); e.g., *Ex Parte* Reexamination Interview Summaries, attached here as Exhibits 8-11; Detailed Slide Presentation, attached here as Exhibits 12-15; Statements of Substance of the Interviews, attached here as Exhibits 16-19. This written record, not oral conversations, is what provides the public notice function referenced by Nokia in its Opposition in the motion to quash. See *Phillips v. AWH Corp.*, 415 F.3d at 1327. Further, Nokia concedes in its Opposition that it can depose the inventor that was present during the interviews. Notably, Nokia ignores that it can also depose the examiners who were present. And Nokia seems to argue that it will depose everyone present at the interviews. (Nokia Opp. 7, Exhibit 2.) But that exercise is wasteful because it would merely create cumulative and duplicative discovery, while unnecessarily impinging on issues of attorney-client privilege. Federal Rule 26(b)(2)(C) gives this Court the discretion to protect against that kind of duplicative and cumulative discovery. That discretion should be exercised here.

Accordingly, all non-privileged information Nokia asserts is needed concerning the reexaminations is already available in the file wrappers or by deposing the examiners as well as the inventor.



#### ***IV. Nokia Concedes Privileged Information Will Be Encountered***

In its Opposition in the related case, Nokia does not deny privileged information will be encountered by deposing the Apple Attorneys. (Nokia Opp. 8, Exhibit 2.) In fact, Nokia admits that there is a high likelihood that it will encounter privileged information, and only states that the Apple Attorneys should object to each question that calls for a privileged response. (Nokia Opp. 8, Exhibit 2.)

#### ***V. The Shelton Standard Should Apply***

Nokia's arguments, in its Motion to Compel and its Opposition in the motion to quash, that the *Shelton* standard does not or should not apply misses the point. The Federal Rules of Civil Procedure grant this Court ample discretion to provide the relief that the Apple Attorneys seek by their Motion to Quash. Fed. R. Civ. P. 26(b)(2)(C). As one example, the court in *ResQnet* denied a party's efforts to depose prosecution counsel, even though court expressly did not apply the *Shelton* standard. *ResQNet.com, Inc. v. Lansa, Inc.*, No. 01Civ3578, 2004 WL 1627170, at \*4 (S.D.N.Y. July 1, 2004.) In *ResQNet* the party seeking to depose prosecution counsel raised arguments similar to Nokia's argument here, but the Court rejected those arguments: "The prosecution histories speak for themselves, and the relevant inquiry in terms of prior art and claim construction is how one of ordinary skill in the art would interpret and understand those prosecution histories." *Id.* at \*5.

In any event, the *Shelton* standard applies in this case—at a minimum its reasoning should apply. In its Opposition in the motion to quash, Nokia opens its argument with a false and unsupported claim: "Courts have expressly rejected the *Shelton* standard when the person sought to be deposed is re-examination counsel." (Nokia Opp. 3.) First, Nokia states that multiple courts have expressly rejected the *Shelton* standard for reexamination counsel, yet cites only one case to support this assertion. Second, the case that Nokia cites involved patent counsel

that prepared a patent opinion, not reexamination counsel. *See aaiPharma, Inc. v. Kremers Urban Dev. Co.*, 361 F. Supp. 2d 770, 775 (N.D. Ill. 2005) ("MBHB does not set forth any authority showing that rendering a patentability opinion does not constitute 'substantive involvement' in patent prosecution."), attached here as Exhibit 20; aaiPharma and McDonnell Boehnen Hulbert & Berghoff's Reply to Defendants' Opp. to Mot. to Quash Defendants' Rule 45 Subpoena, *aaiPharma Inc. v. Kremers Urban Development Co.*, No. 05-CV-0537, at 2-3 (N.D. Ill. Mar. 14, 2005) ("MBHB prepared an opinion directed to patentability or patent strategy, but their efforts ended there."), attached here as Exhibit 21. Thus, despite Nokia's assertions, it failed to cite any authority that expressly supports the proposition that the *Shelton* standard does not apply to reexamination counsel regarding a patent subject to a concurrent litigation in either its Motion to Compel or its Opposition.

Nokia's assertion that the *Shelton* standard does not apply to the Apple Attorneys because they are not "trial counsel" ignores the role reexamination counsel plays in the concurrent litigation. In the reexaminations, the Apple Attorneys have been tasked with the responsibility of defending the patentability of the patented claims, otherwise Apple cannot assert these patents against Nokia in the concurrent litigation. Thus, the Apple Attorneys' responsibilities are directly related to the concurrent litigation unlike the deponents in *United States v. Philip Morris Inc.* or *Evans v. Atwood*. *See United States v. Philip Morris Inc.*, 209 F.R.D. 13, 17 (D.D.C. 2002) (noting that the deponents had been delegated non-legal and non-litigation responsibilities); *Evans v. Atwood*, No. CIV.A. 96-2746, 1999 WL 1032811, at \*3 (D.D.C. Sept. 29, 1999) (stating that the deponent did not play a major role in the litigation).

Accordingly, the *Shelton* standard should apply to the depositions of the Apple Attorneys.

**VI. *Alternatively, if the Motion to Compel Is Granted, the Depositions Should Be Limited to Any Non-privileged Discussions That Occurred During the Interviews***

Although Nokia suggests that it only wants to depose the Apple Attorneys to obtain information about oral conversations during the interviews for the '703 and '854 patent reexaminations and does not seek information about litigation strategies, the deposition subpoenas served on the Apple Attorneys are not so limiting.<sup>4</sup> Nokia's Motion to Compel and its Opposition in the motion to quash is the first time Nokia has even hinted at limiting the scope of the depositions. When counsel for the Apple Attorneys suggested that Nokia narrow the scope of depositions by serving a Rule 30(b)(6) list of topics, Nokia refused.<sup>5</sup>

Further, Nokia has only identified the discussions that occurred during the interviews with the Patent Office as being allegedly relevant and discoverable. (Nokia Opp. 5, Exhibit 2.) Accordingly, if Nokia's Motion to Compel is granted, the depositions should at least be limited to any non-privileged discussions that occurred during the examiner interviews of the '703 and '854 patent reexaminations.

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<sup>4</sup> The subpoenas are attached here as Exhibits 22-25.

<sup>5</sup> See Emails between Rohan Kale, Nokia's counsel, and Byron Pickard, Apple Attorneys' counsel, attached hereto as Exhibits 4 & 5.

**VII. Conclusion**

For these reasons, it is respectfully requested that this Court deny Nokia's Motion to Compel and forbid Nokia from deposing the Apple Attorneys or, in the alternative, limit the scope of the depositions to any non-privileged discussions that occurred during the interviews.

Dated: June 13, 2011

Respectfully Submitted,

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