

**UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF COLUMBIA**

NOKIA CORPORATION,

Plaintiff,

v.

APPLE INC.,

Defendant.

Civil Action No. 1:11-mc-00295-RLW

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 OPPOSITION TO THIRD PARTY
WITNESSES' MOTION TO QUASH SUBPOENAS**

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INTRODUCTION

There is no dispute that Messrs. Sterne, Perry, Coller, and Bezos (“the Witnesses”) are in possession of facts directly relevant to the issues of validity and infringement of Apple’s patents asserted against Nokia in the pending litigation *Nokia Corp. v. Apple Inc.*, No. 1:09-cc-00791 (D. Del. Oct. 22, 2009) (“the Delaware action”). The Witnesses participated in face to face, public meetings with the United States Patent and Trademark Office (“PTO”) patent examiner, during which the patentability of the claims of two of the asserted patents was discussed.

The Witnesses’ only excuse for failing to appear for their properly subpoenaed depositions and the apparent basis for this belated motion is that the Witnesses are Apple’s patent lawyers – not Apple’s trial counsel. There is no prohibition from deposing a lawyer, who is not trial counsel for one of the parties, simply because they happen to be a lawyer. Each of these patent lawyers participated in arguments with the US PTO in an effort to distinguish the claims from the prior art. The public statements made by these patent lawyers to the patent examiner are admissions by Apple that Nokia can use to defend itself from infringement and establish that the patents are not valid.

The Court should accordingly deny the Witnesses’ motion to quash, and grant Nokia’s related motion to compel and order the Witnesses to appear for deposition on July 11, 12, 13, and 14, 2011. *Nokia Corp. v. Apple Inc.*, No. 1:11-mc-00284 (D.D.C. May 17, 2011).

BACKGROUND

The background facts are not in dispute. On October 22, 2009, Nokia instituted an action against Apple in the United States District Court for the District of Delaware,

asserting ten patents declared essential to wireless communications standards. *Nokia Corp. v. Apple Inc.*, No. 1:09-cv-00791 (Declaration of Rohan Kale (“Kale Dec.”), ¶ 2, Ex. A). Apple counterclaimed asserting that Nokia infringed nine of its implementation patents (*id.* at ¶ 3, Ex. B). Two of the patents asserted by Apple are US Patents 5,315,703 (“the 703 patent”) and 5,455,854 (“the 854 patent”) (*id.* at Ex. B, ¶ 224, 248). Subsequently, the asserted Apple patents entered reexamination in the United States Patent and Trademark Office (“PTO”). On December 14, 2010, Attorneys Robert Sterne, Glenn Perry, Salvador Bezos, and Rich Coller had face to face meetings with the patent examiner in an effort to distinguish invalidating prior art from the 854 patent (*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. The Examiner and attorneys submitted summaries of the interview. Unfortunately, these summaries do not contain a detailed account of what was said during the interview (*id.*). As part of its summary of the interview, Apple submitted a 41 page power point presentation. Again, unfortunately, the power point does not include the narrative that went along with the presentation to the examiner (*id.*).

To discover what admissions and statements the patent lawyers made to the Examiner at the reexamination interviews with respect to the 703 and 854 patents, Nokia served subpoenas for the production of documents and for the appearance of Apple’s representatives, the patent lawyers, who were present at the reexamination interviews for deposition. After a series of correspondence with the witnesses’ attorney, in which the witnesses refused to appear for deposition, Nokia filed its motion to compel the

appearance of the Witnesses for deposition. *Nokia Corp. v. Apple Inc.*, No. 1:11-mc-00284.

ARGUMENT

I. The *Shelton* Standard is inapplicable

The Witnesses' reliance on *Shelton v. American Motors Corp.*, 805 F.2d 1323 (8th Cir. 1986) is misplaced. Courts have expressly rejected the *Shelton* standard when the person sought to be deposed is re-examination counsel. *aaiPharma, Inc. v. Kremers Urban Dev. Co.*, 361 F. Supp. 2d 770, 775 (N.D. Ill. 2005). Furthermore, this Court has unambiguously held that the *Shelton* factors are limited to *trial or litigation* counsel, and even then *only* where there is a risk of exposing litigation strategy. *United States v. Philip Morris Inc.*, 209 F.R.D. 13, 17 (D.D.C. 2002). The Witnesses are not trial counsel in this case.

In *Philip Morris*, this Court refused to apply the *Shelton* factors even when the witnesses were trial attorneys because they were subpoenaed strictly as fact witnesses and the United States was not seeking information about litigation strategies (*id.* at *14-15). In the present case, the Witnesses are not trial counsel, have been subpoenaed strictly as fact witnesses, and Nokia is not seeking information about litigation strategies. Nokia wishes to depose the Witnesses to obtain facts about the non-privileged discussions that occurred at the reexamination interviews. The witnesses admit that they are not litigation counsel, hence litigation strategies are not at stake (Nonparties' Motion to Quash Nokia Subpoenas and for a Protective Order, P. 8). Indeed, the subpoenaed witnesses are not even involved in the underlying Delaware litigation between Apple and Nokia (*id.*).

None of the other cases cited by the Witnesses are applicable either. In *Evans v. Atwood*, No. 96-2746, 1999 U.S. Dist. LEXIS 17545 (D.D.C. Sept. 29, 1999), this Court

allowed the deposition of defendant's in house attorney, explaining that underlying facts are not protected by attorney-client privilege (*id.* at *15). In *Evans*, this Court even agreed that a blanket assertion of attorney-client privilege, which is what the witnesses are doing here, is inappropriate (*id.*). In *Corp. for Public Broadcasting. v. American Automobile Centennial Commission.*, No. 97-1810, 1999 U.S. Dist. Lexis 1072, at *4 (D.D.C. Feb. 2, 1999), also cited by the Witnesses, plaintiffs sought depositions of the defendant's attorneys for information about a potential oral contract. However, the defendant represented that the oral contract was negotiated between the parties, not their counsel. *Id.* at *4. Hence, the attorneys the plaintiff in *Corp. for Public Broadcasting* sought to depose were not percipient fact witnesses as the Witnesses are here.

The only litigation strategy that appears to be at play here is the subpoenaed witnesses' effort to preclude Nokia from obtaining a detailed account of the arguments that they made to the Examiner. The subpoenaed witnesses attempt to conflate the invalidity challenges in the reexaminations with potential invalidity challenges that might arise in the pending litigation, arguing that there is equal harm in deposing reexamination counsel as there is in deposing litigation counsel. Setting aside the fact that the Witnesses were unable to find any case law to support this proposition, the fact of the matter is that the arguments for validity that they refer to are in fact public – not confidential – hence not protectable even if they are analogous. The crucial difference between reexamination counsel and litigation counsel is that reexaminations contain non-privileged communications to a patent examiner that discuss the scope of the patent. These communications are meant to exist in the public domain, which is why the *Shelton*

standard does not apply to reexamination counsel. *aaiPharma, Inc, supra*, 361 F. Supp. 2d at 775.

Since the witnesses are in possession of non-privileged, factual matters not related to the underlying litigation, the heightened test articulated in *Shelton* simply does not apply. Even if the *Shelton* factors are applied, however, all three prongs are satisfied.

A. The Information Sought is Relevant and Discoverable

The Witnesses argue that the discoverable facts are only relevant to an inequitable conduct defense. This is incorrect. Nokia is not attempting to seek these depositions for pleading inequitable conduct, but because the subpoenaed witnesses have unique, non-privileged personal knowledge related to what statements were made to the Examiner about the prior art and the Examiner's rejection of the claims. This testimony 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. *Gillespie v. Dywidag Sys. Int'l, USA*, 501 F.3d 1285, 1291 (Fed. Cir. 2007) ("The public notice function of a patent and its prosecution history requires that a patentee be held to what he declares during the prosecution of his patent") quoting *Springs Window Fashions L.P. v. Novo Indus., L.P.*, 323 F.3d 989, 995 (Fed. Cir. 2003).

Messrs. Sterne, Perry, Coller, and Bezos were present at the reexamination interviews and made statements to the patent examiner that define the scope of the invention, i.e., what infringes and what doesn't and what invalidates and what doesn't. The statements that were made and the details of the events that transpired are crucial to Nokia's understanding of the patents.

B. The Witnesses Admit that Information Nokia Seeks is Not Protected by the Attorney Client Privilege

In their Motion to Quash, the best the Witnesses could do with regard to whether the deposition would be directed to privileged matter, was to state that there is a “high likelihood” that Nokia will encounter privileged information during depositions. This is true of any deposition and should not be the basis for quashing the subpoenas. This Court has recognized that depositions of patent prosecution counsel are frequently allowed, refusing to uphold blanket invocations of attorney-client privilege as the witnesses here seem to do. *Amicus Commc’ns., L.P., v. Hewlett-Packard Co.*, No 99-0284 HHK/DAR, 1999 U.S. Dist. Lexis 20901 at *6 (D.D.C. 1999).

Further, if counsel for the subpoenaed witnesses believes a particular question calls for a privileged response, he or she can still interpose a privilege objection during the deposition. *Evans*, 1999 U.S. Dist. Lexis 17545 at *15-16.

C. No Other Means Exist to Obtain the Detailed Information for the Events that Transpired at the Reexamination Interviews

The details of the events of the interviews are discoverable from the people who attended the interviews. The witnesses cite the reexamination interview summaries as potential alternative sources of information, yet the summaries, as the name implies, are merely summaries. They do not include everything that was said or what transpired at the interviews. For example, the entire interview summary for US Patent 5,315,703 is shown below.

“Patent Owner’s representative provided an overview of the invention and discussed differences between the Cohen reference and the instant invention. Particularly, Patent Owner’s representative argued Cohen failed to teach a notification receiver object (e.g. “receiving the notification by the at least one of the plurality of objects”) and a connection object. Examiner agreed to consider Cohen in light of Patent Owner’s arguments.”

(Kale Dec. at ¶ 5, Ex. D.) Such a terse and overly simplified summary is hardly sufficient to explain what the witnesses said to the Patent Examiner and how the witnesses specifically characterized the scope of the patent in order to overcome the prior art. Certainly, Nokia is entitled to ask the Witnesses to provide Nokia with the same “overview” of the invention and the differences between the Cohen reference and the invention. The only mechanism to ensure that Nokia can obtain the best description of what was said is to depose all the individuals present.

The Witnesses, knowing that the written interviews are insufficient, also suggest that Nokia can depose the non-attorneys who were present such as the examiners and the inventors. Nokia is deposing the inventor. But that is not relevant here. Nokia is entitled to the recollections of *all* witnesses present at the interviews to ensure that Nokia obtains a complete picture of the events that transpired.

Moreover, as recognized by this Court, because the Witnesses are percipient fact witnesses that have non-privileged, personal knowledge of the events that transpired at the reexamination interviews, the Witnesses have and had every reason to expect that their depositions may be requested. *Amicus Commc’ns supra.*, No 99-0284 HHK/DAR, 1999 U.S. Dist. Lexis 20901 at *5 (“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)).

CONCLUSION

For the reasons set forth above and on the authorities cited, Nokia respectfully requests that the Court deny the Witnesses' motion to quash, and direct that the witnesses be made available for depositions on July 11, 12, 13, and 14, 2011.

Dated: June 3, 2011

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