

(Counsel listed on signature page)

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

TECHNOLOGY PROPERTIES LIMITED
LLC, et al.,

Plaintiffs,

v.

BARNES & NOBLE, INC.,

Defendants.

Case No. 3:12-cv-03863-VC (PSG)

**PLAINTIFFS' MOTION TO LIMIT
DEFENDANTS' SUBPOENAS TO THIRD
PARTY CHARLES MOORE OR
ALTERNATIVELY FOR A PROTECTIVE
ORDER**

Hearing:

Date: August 11, 2015

Time: 10:00 a.m.

Place: Courtroom 5, 4th Floor

Judge: Hon. Paul S. Grewal

TECHNOLOGY PROPERTIES LIMITED
LLC, et al.,

Plaintiffs,

v.

HUAWEI TECHNOLOGIES CO., LTD.,
HUAWEI DEVICE CO., LTD., HUAWEI
DEVICE USA INC., FUTUREWEI
TECHNOLOGIES, INC., HUAWEI
TECHNOLOGIES USA INC.,

Defendants.

Case No. 3:12-cv-03865-VC (PSG)

TECHNOLOGY PROPERTIES LIMITED
LLC, et al.,

Plaintiffs,

v.

GARMIN LTD., GARMIN
INTERNATIONAL, INC., and GARMIN
USA, INC.,

Defendants.

Case No. 3:12-cv-03870-VC (PSG)

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TECHNOLOGY PROPERTIES LIMITED
LLC, et al.,

Plaintiffs,

v.

ZTE CORPORATION and ZTE (USA) INC.,

Defendants.

Case No. 3:12-cv-03876-VC (PSG)

TECHNOLOGY PROPERTIES LIMITED
LLC, et al.,

Plaintiffs,

v.

SAMSUNG ELECTRONICS CO., LTD.
and SAMSUNG ELECTRONICS
AMERICA, INC.,

Defendants.

Case No. 3:12-cv-03877-VC (PSG)

TECHNOLOGY PROPERTIES LIMITED
LLC, et al.,

Plaintiffs,

v.

LG ELECTRONICS, INC. and LG
ELECTRONICS U.S.A., INC.,

Defendants.

Case No. 3:12-cv-03880-VC (PSG)

TECHNOLOGY PROPERTIES LIMITED
LLC, et al.,

Plaintiffs,

v.

NINTENDO CO., LTD. and NINTENDO OF
AMERICA, INC.,

Defendants.

Case No. 3:12-cv-03881-VC (PSG)

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(The Rutter Group 2010).....5

NOTICE OF MOTION AND MOTION

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that on August 11, 2015, at 10:00 a.m., or as soon as the matter may be heard by the Honorable Paul S. Grewal, in Courtroom 5, United States District Court for the Northern District of California, Robert F. Peckham Federal Building, 280 South 1st Street, San Jose, CA 95113, Plaintiffs Phoenix Digital Solutions LLC, Technology Properties Limited LLC, and Patriot Scientific Corporation (together, "Plaintiffs") shall and hereby do move the Court for an order limiting Defendants' document and deposition subpoenas to third party Charles H. Moore, served on June 9, 2015.

RELIEF REQUESTED

Pursuant to Fed. R. Civ. P. 45, Plaintiffs seek entry of an order: (1) limiting Defendants' subpoena for documents to Moore to the extent that it seeks privileged information or confidential information of Plaintiffs, including information protected by a common interest privilege held jointly by Plaintiffs, and prohibiting Moore from producing documents that contain privileged information belonging to Plaintiffs; and (2) limiting Defendants' subpoena for the deposition testimony of Moore to the extent that it seeks privileged information or confidential information of Plaintiffs, and prohibiting Moore from testifying such that he would reveal privileged information belonging to Plaintiffs.

To facilitate the relief sought and provide Plaintiffs the opportunity to prevent the disclosure of its privileged information, Plaintiffs propose the following procedure: Moore shall produce documents directly to Plaintiffs. Plaintiffs will review Moore's production within 10 days of receipt, log and withhold any materials it determines are privileged, and subsequently produce the remaining documents to Defendants.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Pursuant to Federal Rule of Civil Procedure 45(d)(3)(A)(iii), Plaintiffs Technology Properties Limited LLC, Phoenix Digital Solutions LLC, and Patriot Scientific Corporation (together, “Plaintiffs”) hereby submit this motion to limit the document and deposition subpoenas served on third party Charles H. Moore by Defendants¹ on June 9, 2015. Plaintiffs ask the Court to limit Defendants’ subpoenas because they seek disclosure of information that is protected from discovery by a common interest privilege held jointly by Plaintiffs, and disclosure of Plaintiffs’ privileged or protected information.

II. BACKGROUND

Charles H. Moore is a named inventor of the three patents that are asserted in this case— U.S. Patent Nos. 5,440,749 (the ‘749 Patent), 5,530,890 (the ‘890 Patent), and 5,809,336 (the ‘336 Patent). Defendants served a subpoena for documents and a deposition subpoena on Charles H. Moore on June 9, 2015. (*See Decl.*,² Ex. 1 at pp. 13-27, 28-43). Defendants provided Plaintiffs with notice of the subpoenas on June 9, 2015. (*See Decl.*, Ex. 1). Plaintiffs object to Defendants’ subpoenas to the extent that they seek Plaintiffs’ privileged or protected information.

As this Court is aware, the currently pending district court cases are related to a series of prior proceedings involving the asserted patents, and in which many of the Defendants were also named parties. Certain privilege issues were hotly contested regarding two documents that were inadvertently produced by Mr. Moore in response to a third party subpoena issued by Acer. *See Acer Inc., et al. v. Technology Properties Ltd., et al.*, Case No. 5:08-CV-00887, Dkt. No. 210 (N.D. Cal. Nov. 19, 2010) (*Decl.*, Ex. 2).³ The documents at issue in the prior litigation were two

¹ As used herein, the “Defendants” refers to all defendants in the above-captioned matters.

² References herein to “Decl.” refers to the Declaration of Barry Bumgardner filed concurrently with this motion.

³ Although the Court’s Order is marked “Not for Citation,” Plaintiffs refer to the factual background and the Court’s findings and Order based on their relationship to the issues in this case.

1 August 2008 emails between TPL Officers (including Moore) and TPL's patent attorneys
2 concerning Moore's recent interview with the U.S.P.T.O. and its impact on the reexamination of
3 the '336 Patent, which was pending at the time.⁴ Acer argued that the documents at issue were
4 not privileged, and that even if they were privileged, TPL had nevertheless waived any claim of
5 privilege over the documents when it failed to file a motion to quash the subpoena or move for a
6 protective order before the date on which Moore was required to respond to the subpoena. (*See*
7 *Decl.*, Ex. 2 at pp. 3-4). Although TPL was given notice of Acer's subpoena to Moore at the time
8 it was served, TPL did not have notice that Moore could produce privileged information in
9 response to the subpoena because (i) Moore was expected to have returned all his materials to
10 TPL upon his departure in 2009, per TPL's electronic communications policy, and (ii) Moore
11 was prohibited from producing any privileged materials without TPL's express consent, per
12 Moore's commercialization agreement with TPL. (*See Decl.*, Ex. 2 at p. 4). However, TPL
13 promptly asserted the attorney-client privilege once it saw the documents that Moore had
14 produced. (*See Decl.*, Ex. 2 at p. 6).

15 The Court ultimately exercised its discretion under Rule 26 to *sua sponte* enter a
16 protective order preventing discovery of the privileged communications. (*See Dkt. No. 210* at p.
17 6). The Court's determination was based on its express finding that the documents produced by
18 Moore were privileged. (*See Decl.*, Ex. 2 at p. 6). The Court found that the circumstances were
19 similar in the case *McCoy v. Southwest Airlines Co., Inc.*, 211 F.R.D. 381 (C.D. Cal. 2002), and
20 adopted the court's reasoning, noting:

21 The Court acknowledged that (1) the defendants cannot object to
22 a subpoena directed to a nonparty, (2) a nonparty's failure to
23 object normally requires the court to find that any objection,
24 including those related to privilege, has been waived, and (3) the
25 subpoena at issue was not overbroad so the 'unusual
26 circumstances' exception did not apply. Instead, the court relied
27 on Rule 26 and its discretion to consider granting *sua sponte* a
28 protective order."

⁴ *See Acer Inc. v. Technology Properties Ltd., et al.*, Case No. 5:08-CV-00877, Dkt. No. 200 (N.D. Cal. Oct. 20, 2010).

1 (Dkt. 210 at p. 5) (citing *McCoy*, 211 F.R.D. at 385). The Court found that *McCoy* was
2 distinguishable because, in that case the Court ultimately declined to enter a protective order
3 based on the finding that the documents at issue in that case were not privileged. (*Id.*). In the
4 prior litigation, the Court went on to explain that the “good cause” standard had been met for its
5 *sua sponte* entry of a protective order based on its finding that the documents were privileged,
6 TPL’s prompt assertion of privilege, and the “Court’s preference to handle cases before it on the
7 merits, rather than procedural missteps.” (*See Decl.*, Ex. 2 at p. 6).

8 Accordingly, Plaintiffs’ instant motion to limit the subpoena to Moore is submitted in an
9 effort to avoid any “procedural missteps” that could permit the discovery of Plaintiffs’ privileged
10 or protected information.

11 **III. LEGAL STANDARDS**

12 **A. Privilege**

13 The attorney-client privilege protects from discovery “confidential communications
14 between attorneys and clients, which are made for the purpose of giving legal advice.” *United*
15 *States v. Richey*, 632 F.3d 559, 566 (9th Cir. 2011) (internal citation omitted). The privilege
16 attaches when “(1) legal advice of any kind is sought (2) from a professional legal adviser in his
17 capacity as such, (3) the communications relating to that purpose, (4) made in confidence (5) by
18 the client, (6) are at his instance permanently protected (7) from disclosure by himself or by the
19 legal adviser, (8) unless the protection be waived.” *Id.* (internal quotations omitted). The
20 privilege is strictly construed. *United States v. Ruehle*, 583 F.3d 600, 607 (9th Cir. 2009). The
21 work product doctrine protects “from discovery documents and tangible things prepared by a
22 party or his representative in anticipation of litigation.” *Richey*, 632 F.3d at 567. The doctrine
23 provides an attorney working on a case “with a certain degree of privacy” so that he may
24 “prepare his legal theories and plan his strategy without undue and needless interference.”
25 *Hickman v. Taylor*, 329 U.S. 495, 511 (1947).

26 The common interest doctrine is a narrow exception to the general rule that disclosing
27 information to a third party constitutes a waiver of privilege. *Integrated Global Concepts, Inc. v.*
28 *j2 Global, Inc.*, 2014 WL 232211, at *2 (N.D. Cal. Jan. 21, 2014) (citing *United States v.*

1 *Bergonzi*, 216 F.R.D. 487, 495 (N.D. Cal. 2003)). It applies where “(1) the communication is
2 made by separate parties in the course of a matter of common interest; (2) the communication is
3 designed to further that effort; and (3) the privilege has not been waived.” *Pulse Eng’g, Inc. v.*
4 *Mascon, Inc.*, 2009 WL 3234177, at *3 (S.D. Cal. Oct. 2, 2009). It applies “where allied lawyers
5 and clients work together in prosecuting or defending a lawsuit so that they may exchange
6 information among themselves without waving the privilege[.]” *Elan Microelectronics Corp. v.*
7 *Apple, Inc.*, 2011 WL 3443923, at *2 (N.D. Cal. Aug. 8, 2011). “[A]lthough it may, in rare
8 cases, be extended to situations where there is anticipated joint litigation, but nothing pending
9 imminently,” *Integrated Global*, 2014 WL 232211, at *2 (citing *Elan Microelectronics*, 2011 WL
10 3443923, at *2), it “does not extend to communications about a joint business strategy that
11 happens to include a concern about litigation.” *Elan Microelectronics*, 2011 WL 3443923, at *2
12 (citation omitted). “[T]he doctrine applies to cases where ‘allied lawyers and clients’ work
13 together in prosecuting or defending a lawsuit so that they may exchange information among
14 themselves without waving the privilege.” *Id.* (quoting *United States v. Mass. Inst. of Tech.*, 129
15 F.3d 96, 100 (2d Cir. 1999)).

16 **B. Objecting to a Subpoena**

17 Although a third party served with a document subpoena may challenge the subpoena on
18 privilege grounds by serving written objections within the period for compliance, the same rules
19 do not apply to a party to the action. *See* Fed. R. Civ. P. 45. A party may only challenge a Rule
20 45 subpoena by (i) moving to quash or modify the subpoena pursuant to Rule 45(c)(3)(A), or (ii)
21 moving for a protective order pursuant to Rule 26(c). Rule 45 permits a third party to make
22 objections within 14 days from service of the subpoena, or before the time for compliance. *See*
23 Fed. R. Civ. P. 45(d)(2)(B). “Only the witness can prevent disclosure by objection. The party to
24 whom the subpoenaed records pertain *cannot* simply object. Rather, a protective order or motion
25 to quash the subpoena is required.” Schwarzer, et al., *Cal. Prac. Guide: Fed. Civ. Proc. Before*
26 *Trial*, §11:2291 (The Rutter Group 2010) (emphasis in original).

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IV. THE COURT SHOULD LIMIT DEFENDANTS' SUBPOENAS TO MOORE BECAUSE THEY ARE IMPROPER UNDER RULE 45

Defendants' subpoenas to Moore should be limited because they improperly seek disclosure of information that is privileged or otherwise protected. *See* Fed. R. Civ. P. 45 (d)(3)(A) (stating that, upon timely motion, a court "must quash or modify a subpoena that ... requires disclosure of privileged or other protected matter"). More specifically, Plaintiffs move to limit Defendants' subpoenas for documents and deposition testimony of Moore because they seek disclosure of information that is protected from discovery by a common interest privilege held jointly by Plaintiffs, and because they seek disclosure of Plaintiffs' privileged or protected information.

A. Defendants' Subpoenas Improperly Seek Disclosure of Privileged Information

Defendants' deposition and document subpoenas seek information that is protected from disclosure by a common interest privilege that is held jointly by Plaintiffs, and may not be waived without Plaintiffs' express consent. Plaintiffs have not waived privilege or their objections based on privilege, and no exception applies that would otherwise permit discovery of such privilege or protected information. Because Defendants' subpoenas exceed the scope of permissible discovery under Rule 45, and to protect against the disclosure of Plaintiffs' privileged information, the Court should limit Defendants' subpoenas to Moore. *See* Fed. R. Civ. P. 45 (d)(3)(A).

In the prior litigation, the Court found that certain emails inadvertently produced by Moore were, in fact, privileged and therefore protected from disclosure. (*See* Decl., Ex. 2 at p. 3) ("As the emails at issue describe confidential conversations between only TPL executives (including Moore) and TPL's attorneys about Moore's USPTO interview in relation to the 336 Patent, these emails are clearly protected by the attorney client privilege."). Despite the Court's express findings that these materials were privileged, Defendants' subpoenas nevertheless command Moore to provide documents and testimony pertaining to these very same facts and circumstances. For example, Request for Production Numbers 28 and 31 in Defendants' document subpoena to Moore ask for:

1 Request for Production No. 28: All Documents and Things
2 relating to any communication to or from any inventor relating
3 to the subject matter of any claim of the Asserted Patents.

4 Request for Production No. 31: All Documents and Things that
5 relate to any presentation or meeting between named inventors
6 Charles H. Moore and/or Russell H. Fish, III, the purpose of
7 which was, at least in part, to discuss the Asserted Patents
8 (including any patent applications or other proceedings related to
9 the asserted patents).

10 Decl., Ex. 1 at p. 26.⁵ Likewise, the Deposition Topics in Defendants’ subpoena for the
11 deposition testimony of Moore also seeks testimony on these same facts and circumstances. For
12 example, Deposition Topics 10 and 26 as duplicated below, specifically seek testimony
13 concerning these matters:

14 Deposition Topic 10: The claims of the asserted patents,
15 including their scope and meaning, and any previous related
16 declarations or testimony by You in Related Proceedings or
17 before the United States Patent and Trademark Office.

18 Deposition Topic 26: The patentability, validity, enforceability,
19 value, and/or marketability of the Asserted Patents and/or the
20 subject matter disclosed or claimed therein, and any related
21 studies, reports, opinions, or Documents.

22 Decl., Ex. 1 at pp. 39, 42. Defendants’ discovery requests to Moore are improper, and exceed the
23 scope of permissible discovery under Rule 45. Because Moore and Plaintiffs share a common
24 legal interest in the enforceability and validity of the ‘336 Patent and related patents, Defendants’
25 discovery requests call for information that is protected from disclosure by the common interest
26 privilege shared by Moore and Plaintiffs.

27 Defendants’ subpoenas also seek other categories of documents and information that is
28 privileged or otherwise protected from disclosure. For example, Deposition Topic No. 32 seeks
information concerning “The bankruptcy proceeding filed by Plaintiff Technology Properties
Limited LLC.” Decl., Ex. 1 at p. 43. Apart from information that may be garnered from publicly

⁵ Defendants LG and Samsung served the same requests for production on Plaintiffs. In their responses, Plaintiffs objected to each request on privilege grounds.

1 available sources, information concerning a bankruptcy proceeding filed “by Plaintiff
2 Technology Properties Limited LLC” is Plaintiffs’ confidential information and not Moore’s. As
3 a further example, Deposition Topic No. 27 seeks information about settlement discussions,
4 negotiations, and agreements entered into in relation to litigation or other disputes about the
5 asserted patents. *See* Decl., Ex. 1 at pp. 42. This topic is drafted so as to request privileged,
6 confidential, and/or sensitive information of Plaintiffs pertaining to matters that have no
7 discernable relevance to the issues in this case. Plaintiffs object to Defendants’ deposition topics
8 and document requests to the extent that they seek disclosure of Plaintiffs’ privileged or
9 confidential information.

10 Given Moore’s unique position and his shared legal interests as to the validity and
11 enforceability of the asserted patents, much of the information requested in Defendants’
12 subpoenas is subject to the common interest privilege that is held jointly with Plaintiffs.
13 Accordingly, Plaintiffs respectfully request that the Court limit the subpoena to Moore and
14 prohibit the disclosure of Plaintiffs’ privileged or confidential information.

15 **B. Alternatively, the Court Should Enter a Protective Order**

16 Should the Court decline to modify Defendants’ deposition and document subpoenas to
17 Moore, for the reasons discussed above, Plaintiffs respectfully request that the Court enter a
18 protective order prohibiting the discovery or disclosure of privileged or other protected
19 information of Plaintiffs, including information protected by a common interest privilege held
20 jointly by Plaintiffs.

21 **V. CONCLUSION**

22 For the reasons discussed herein, Plaintiffs respectfully request that the Court enter an
23 order: (1) limiting Defendants’ subpoena for documents to Moore to the extent that it seeks
24 privileged information or confidential information of Plaintiffs, including information protected
25 by a common interest privilege held jointly by Plaintiffs, and prohibiting Moore from producing
26 documents that contain privileged information belonging to Plaintiffs; and (2) limiting
27 Defendants’ subpoena for the deposition testimony of Moore to the extent that it seeks privileged
28 information or confidential information of Plaintiffs, and prohibiting Moore from testifying such

1 that he would reveal privileged information belonging to Plaintiffs. Moore shall produce
2 documents directly to Plaintiffs. Plaintiffs will review Moore's production within 10 days of
3 receipt, log and withhold any materials it determines are privileged, and subsequently produce
4 the remaining documents to Defendants.

5
6 Dated: June 23, 2015

Respectfully submitted,

7 /s/ Barry J. Bumgardner

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CERTIFICATE OF SERVICE

I declare under the penalty of perjury that the following is true and correct: Pursuant to Civil L.R. 5-5, on June 23, 2015, I caused the foregoing document to be served by e-mail on all attorneys of record in each above-captioned action. The following electronic addresses were used:

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21 Dated: June 23, 2015

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Defendants.

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TECHNOLOGY PROPERTIES LIMITED
LLC, et al.,

Plaintiffs,

v.

NINTENDO CO., LTD. and NINTENDO OF
AMERICA, INC.,

Defendants.

Case No. 3:12-cv-03881-VC (PSG)

1 I, Barry J. Bumgardner, submit this declaration in support of Plaintiffs’ Motion to Limit
2 Defendants’ Subpoenas to Third Party Charles Moore or Alternatively for a Protective Order, and
3 declare as follows:

4 1. I am a partner at the law firm of Nelson Bumgardner, P.C., attorneys of record for
5 Plaintiff Phoenix Digital Solutions LLC (“PDS”). If called as a witness, I could and would
6 testify competently to the information set forth in this declaration.

7 2. Attached as **Exhibit 1** is a true and correct copy of Defendants’ Notice of
8 Subpoenas to Charles H. Moore, which includes Subpoena to Produce Documents, Information,
9 or Objects or to Permit Inspection of Premises in a Civil Action to Charles H. Moore on June 26,
10 2015 at 9:00 a.m. at Regus Reno, 200 S. Virginia Street, Reno, Nevada 89501 and Subpoena to
11 Testify at a Deposition in a Civil Action on July 7, 2015 at 9:00 a.m. at Regus Reno, 200 S.
12 Virginia Street, Reno, Nevada 89501, which were served on counsel for Plaintiffs on June 9,
13 2015.

14 3. Attached as **Exhibit 2** is a true and correct copy of the Order Denying Plaintiffs’
15 Motion and Entering Protective Order [DOC. 210] in the Acer Inc. et al., v. Technology
16 Properties Ltd., et al. case, No. C08-00877 JF (HRL), N.D. Cal., San Jose Division, on November
17 19, 2010.

18 I declare under penalty of perjury under the laws of the United States of America that the
19 foregoing is true and correct. This declaration is executed on June 23, 2015 in Fort Worth,
20 Texas.

21
22 Dated: June 23, 2015

By: /s/ Barry J. Bumgardner
Barry J. Bumgardner

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Exhibit 1

1 (counsel listed on signature page)

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

TECHNOLOGY PROPERTIES LIMITED LLC,
PHOENIX DIGITAL SOLUTIONS LLC, and
PATRIOT SCIENTIFIC CORPORATION,

Plaintiffs,

v.

LG ELECTRONICS, INC. AND LG
ELECTRONICS U.S.A., INC.,

Defendants.

3:12-cv-03880-VC (PSG)

**DEFENDANTS' NOTICE OF SUBPOENAS
TO CHARLES H. MOORE**

Honorable Vince Chhabria
Honorable Paul S. Grewal

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TECHNOLOGY PROPERTIES LTD. LLC, et al.,
Plaintiffs,
v.
BARNES & NOBLE, INC.,
Defendant.

Case No.: 3:12-CV-03863-VC (PSG)

TECHNOLOGY PROPERTIES LIMITED LLC, PHOENIX DIGITAL SOLUTIONS LLC, and PATRIOT SCIENTIFIC CORPORATION,

Case No. 3:12-cv-03870-VC (PSG)

Plaintiffs,
v.
GARMIN LTD., GARMIN INTERNATIONAL, INC., AND GARMIN USA, INC.,
Defendants.

TECHNOLOGY PROPERTIES LIMITED LLC, PHOENIX DIGITAL SOLUTIONS LLC, and PATRIOT SCIENTIFIC CORPORATION,

Case No. 2:12-cv-03865-VC (PSG)

Plaintiffs,
v.
HUAWEI TECHNOLOGIES CO., LTD. and HUAWEI NORTH AMERICA,
Defendants.

TECHNOLOGY PROPERTIES LIMITED LLC, PHOENIX DIGITAL SOLUTIONS LLC, and PATRIOT SCIENTIFIC CORPORATION,

Case No. 3:12-cv-03876-VC (PSG)

Plaintiffs,
v.
ZTE CORPORATION and ZTE (USA) INC.,
Defendants.

1 TECHNOLOGY PROPERTIES LIMITED
2 LLC, PHOENIX DIGITAL SOLUTIONS
3 LLC, and PATRIOT SCIENTIFIC
CORPORATION,

4 Plaintiffs,

5 v.

6 SAMSUNG ELECTRONICS CO., LTD. and
7 SAMSUNG ELECTRONICS AMERICA,
INC.,

8 Defendants.

Case No. 3:12-cv-03877-VC (PSG)

9 TECHNOLOGY PROPERTIES LIMITED
10 LLC, PHOENIX DIGITAL SOLUTIONS
11 LLC, and PATRIOT SCIENTIFIC
CORPORATION,

12 Plaintiffs,

13 v.

14 NOVATEL WIRELESS, INC.,

15 Defendant.

Case No. 3:12-cv-03879-VC (PSG)

16 TECHNOLOGY PROPERTIES LIMITED
17 LLC, PHOENIX DIGITAL SOLUTIONS
18 LLC, and PATRIOT SCIENTIFIC
CORPORATION,

19 Plaintiffs,

20 v.

21 NINTENDO CO., LTD. and NINTENDO OF
22 AMERICA INC.,

23 Defendants.

Case No. 3:12-cv-03881-VC (PSG)

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TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

NOTICE IS HEREBY GIVEN that, pursuant to Rule 45 of the Federal Rules of Civil Procedure, Charles H. Moore is being served with the attached subpoenas to produce documents and appear for deposition at the time, date, and location indicated in the subpoenas, or at such other time, date, and location as may be agreed upon.

June 9, 2015

Respectfully submitted,

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By: /s/ Timothy C. Bickham

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TECHNOLOGIES USA INC.

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By: /s/ Wasif Qureshi

Wasif Qureshi

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U.S.A., INC.

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By:

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GARMIN USA, INC.

PROOF OF SERVICE

I am employed in the County of San Diego. My business address is Fish & Richardson P.C., 12390 El Camino Real, San Diego, California 92130. I am over the age of 18 and not a party to the foregoing action. I am readily familiar with the business practice at my place of business for collection and processing of correspondence for personal delivery, for mailing with United States Postal Service, for facsimile, and for overnight delivery by Federal Express, Express Mail, or other overnight service.

On June 9, 2015, I caused a copy of the foregoing document to be served on the interested parties in this action by attaching a PDF version of the document to an email message addressed as follows:

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6 **ELECTRONIC** Such document was transmitted by electronic mail to the addressees'
7 **MAIL:** email addresses as stated above.

8 I declare that I am employed in the office of a member of the bar of this Court at whose
9 direction the service was made.

10 I declare under penalty of perjury that the above is true and correct. Executed on June 9,
11 2015, at San Diego, California

12 /s/ Olga May
13 _____
14 Olga May

UNITED STATES DISTRICT COURT
for the
Northern District of California

See list of cases and parties in Attachment A

Plaintiff

v.

See list of cases and parties in Attachment A

Defendant

Civil Action No. See list of cases in Att. A

**SUBPOENA TO PRODUCE DOCUMENTS, INFORMATION, OR OBJECTS
OR TO PERMIT INSPECTION OF PREMISES IN A CIVIL ACTION**

To: Charles H. Moore

(Name of person to whom this subpoena is directed)

Production: **YOU ARE COMMANDED** to produce at the time, date, and place set forth below the following documents, electronically stored information, or objects, and to permit inspection, copying, testing, or sampling of the material: See Attachment B.

Place: Regus Reno 200 S Virginia St. Reno, NV 89501	Date and Time: 06/26/2015 9:00 am
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Inspection of Premises: **YOU ARE COMMANDED** to permit entry onto the designated premises, land, or other property possessed or controlled by you at the time, date, and location set forth below, so that the requesting party may inspect, measure, survey, photograph, test, or sample the property or any designated object or operation on it.

Place:	Date and Time:
--------	----------------

The following provisions of Fed. R. Civ. P. 45 are attached – Rule 45(c), relating to the place of compliance; Rule 45(d), relating to your protection as a person subject to a subpoena; and Rule 45(e) and (g), relating to your duty to respond to this subpoena and the potential consequences of not doing so.

Date: 06/09/2015

CLERK OF COURT

OR

<i>Signature of Clerk or Deputy Clerk</i>	/s/ Wasif Qureshi <i>Attorney's signature</i>
---	--

The name, address, e-mail address, and telephone number of the attorney representing *(name of party)* _____
LG Electronics, Inc. and LG Electronics USA, Inc. _____, who issues or requests this subpoena, are:
Wasif Qureshi, 1221 McKinney St., Suite 2800, Houston, TX 77010, 713-654-5333, qureshi@fr.com

Notice to the person who issues or requests this subpoena

If this subpoena commands the production of documents, electronically stored information, or tangible things or the inspection of premises before trial, a notice and a copy of the subpoena must be served on each party in this case before it is served on the person to whom it is directed. Fed. R. Civ. P. 45(a)(4).

Civil Action No. See list of cases in Att. A

PROOF OF SERVICE

(This section should not be filed with the court unless required by Fed. R. Civ. P. 45.)

I received this subpoena for *(name of individual and title, if any)* _____

on *(date)* _____ .

I served the subpoena by delivering a copy to the named person as follows: _____

_____ on *(date)* _____ ; or

I returned the subpoena unexecuted because: _____

Unless the subpoena was issued on behalf of the United States, or one of its officers or agents, I have also tendered to the witness the fees for one day's attendance, and the mileage allowed by law, in the amount of \$ _____ .

My fees are \$ _____ for travel and \$ _____ for services, for a total of \$ _____ 0.00 .

I declare under penalty of perjury that this information is true.

Date: _____

Server's signature

Printed name and title

Server's address

Additional information regarding attempted service, etc.:

Federal Rule of Civil Procedure 45 (c), (d), (e), and (g) (Effective 12/1/13)**(c) Place of Compliance.**

(1) For a Trial, Hearing, or Deposition. A subpoena may command a person to attend a trial, hearing, or deposition only as follows:

- (A) within 100 miles of where the person resides, is employed, or regularly transacts business in person; or
- (B) within the state where the person resides, is employed, or regularly transacts business in person, if the person
 - (i) is a party or a party's officer; or
 - (ii) is commanded to attend a trial and would not incur substantial expense.

(2) For Other Discovery. A subpoena may command:

- (A) production of documents, electronically stored information, or tangible things at a place within 100 miles of where the person resides, is employed, or regularly transacts business in person; and
- (B) inspection of premises at the premises to be inspected.

(d) Protecting a Person Subject to a Subpoena; Enforcement.

(1) Avoiding Undue Burden or Expense; Sanctions. A party or attorney responsible for issuing and serving a subpoena must take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena. The court for the district where compliance is required must enforce this duty and impose an appropriate sanction—which may include lost earnings and reasonable attorney's fees—on a party or attorney who fails to comply.

(2) Command to Produce Materials or Permit Inspection.

(A) *Appearance Not Required.* A person commanded to produce documents, electronically stored information, or tangible things, or to permit the inspection of premises, need not appear in person at the place of production or inspection unless also commanded to appear for a deposition, hearing, or trial.

(B) *Objections.* A person commanded to produce documents or tangible things or to permit inspection may serve on the party or attorney designated in the subpoena a written objection to inspecting, copying, testing, or sampling any or all of the materials or to inspecting the premises—or to producing electronically stored information in the form or forms requested. The objection must be served before the earlier of the time specified for compliance or 14 days after the subpoena is served. If an objection is made, the following rules apply:

- (i) At any time, on notice to the commanded person, the serving party may move the court for the district where compliance is required for an order compelling production or inspection.
- (ii) These acts may be required only as directed in the order, and the order must protect a person who is neither a party nor a party's officer from significant expense resulting from compliance.

(3) Quashing or Modifying a Subpoena.

(A) *When Required.* On timely motion, the court for the district where compliance is required must quash or modify a subpoena that:

- (i) fails to allow a reasonable time to comply;
- (ii) requires a person to comply beyond the geographical limits specified in Rule 45(c);
- (iii) requires disclosure of privileged or other protected matter, if no exception or waiver applies; or
- (iv) subjects a person to undue burden.

(B) *When Permitted.* To protect a person subject to or affected by a subpoena, the court for the district where compliance is required may, on motion, quash or modify the subpoena if it requires:

- (i) disclosing a trade secret or other confidential research, development, or commercial information; or

- (ii) disclosing an unretained expert's opinion or information that does not describe specific occurrences in dispute and results from the expert's study that was not requested by a party.

(C) *Specifying Conditions as an Alternative.* In the circumstances described in Rule 45(d)(3)(B), the court may, instead of quashing or modifying a subpoena, order appearance or production under specified conditions if the serving party:

- (i) shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship; and
- (ii) ensures that the subpoenaed person will be reasonably compensated.

(e) Duties in Responding to a Subpoena.

(1) Producing Documents or Electronically Stored Information. These procedures apply to producing documents or electronically stored information:

(A) *Documents.* A person responding to a subpoena to produce documents must produce them as they are kept in the ordinary course of business or must organize and label them to correspond to the categories in the demand.

(B) *Form for Producing Electronically Stored Information Not Specified.* If a subpoena does not specify a form for producing electronically stored information, the person responding must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms.

(C) *Electronically Stored Information Produced in Only One Form.* The person responding need not produce the same electronically stored information in more than one form.

(D) *Inaccessible Electronically Stored Information.* The person responding need not provide discovery of electronically stored information from sources that the person identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the person responding must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the court may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of Rule 26(b)(2)(C). The court may specify conditions for the discovery.

(2) Claiming Privilege or Protection.

(A) *Information Withheld.* A person withholding subpoenaed information under a claim that it is privileged or subject to protection as trial-preparation material must:

- (i) expressly make the claim; and
- (ii) describe the nature of the withheld documents, communications, or tangible things in a manner that, without revealing information itself privileged or protected, will enable the parties to assess the claim.

(B) *Information Produced.* If information produced in response to a subpoena is subject to a claim of privilege or of protection as trial-preparation material, the person making the claim may notify any party that received the information of the claim and the basis for it. After being notified, a party must promptly return, sequester, or destroy the specified information and any copies it has; must not use or disclose the information until the claim is resolved; must take reasonable steps to retrieve the information if the party disclosed it before being notified; and may promptly present the information under seal to the court for the district where compliance is required for a determination of the claim. The person who produced the information must preserve the information until the claim is resolved.

(g) Contempt.

The court for the district where compliance is required—and also, after a motion is transferred, the issuing court—may hold in contempt a person who, having been served, fails without adequate excuse to obey the subpoena or an order related to it.

ATTACHMENT A

This subpoena is issued in the following cases pending in the United States District Court for the Northern District of California:

- *Technology Properties Ltd., et al. v. Barnes & Noble, Inc.*; Case No. 3:12-cv-03863
- *Technology Properties Ltd., et al. v. Huawei Tech. Co., Ltd., et al.*; Case No. 2:12-cv-03865
- *Technology Properties Ltd., et al. v. Garmin Ltd. et al.*; Case No. 3:12-cv-03870
- *Technology Properties Ltd., et al. v. ZTE Corporation et al.*; Case No. 3:12-cv-03876
- *Technology Properties Ltd., et al. v. Samsung Elec. Co. et al.*; Case No. 3:12-cv-03877
- *Technology Properties Ltd., et al. v. Novatel Wireless, Inc.*; Case No. 3:12-cv-03879
- *Technology Properties Ltd., et al. v. LG Electronics, Inc. et al.*; Case No. 3:12-cv-03880
- *Technology Properties Ltd., et al. v. Nintendo Co., Ltd. et al.*; Case No. 3:12-cv-03881

ATTACHMENT B

DEFINITIONS

1. “You,” “Your,” and “Yours” means Charles H. Moore.
2. “Plaintiffs” means Plaintiffs Technology Properties Limited LLC, Phoenix Digital Solutions LLC, and Patriot Scientific Corporation, both individually and in any combination, including past and present officers, directors, employees, agents, consultants, predecessors, subsidiaries, parents, affiliates, and contractors.
3. “Asserted Patents” means any one or more of United States Patent Nos. 5,440,749 (“the ’749 patent”), 5,530,890 (“the ’890 patent”), and 5,809,336 (the ’336 patent”), together with any patents Plaintiffs may later attempt to assert in this action.
4. “Asserted Claims” means: claims 1, 43 and 59 of the ’749 patent; claims 7, 9, 11, 12, 13, 17 and 19 of the ’890 patent; and claims 6, 7, 9, 13, 14, and 15 of the ’336 patent, together with any claims Plaintiffs may later attempt to assert in this action.
5. “Prior Art” means anything that constitutes prior art under any subsection of 35 U.S.C. § 102 or § 103, including, without limitation, any publication, patent, use, sale, offer for sale, prior invention, knowledge, or other activity.
6. “Document(s)” is used in the broadest sense to include everything contemplated by Rule 34(a)(1)(A) of the Federal Rules of Civil Procedure and by Rule 1001 of the Federal Rules of Evidence. If a draft Document has been prepared in several copies that are not identical, or if the original identical copies are no longer identical due to subsequent notation, each non-identical Document is a separate Document.
7. “Thing(s)” is used in the broadest sense to include everything contemplated by Rule 34(a)(1)(B) of the Federal Rules of Civil Procedure.

8. “Person” or “Entity” and their plural forms include, without limitation, natural persons, partnerships, corporations, associations, and any other legal entities and units thereof.

9. “Communication” means any transmission of information, whether oral or in writing, including drafts.

10. “Relating to” and “concerning” are used in its broadest sense to include any connection, relation, or relevance.

11. The words “and” and “or” shall be construed conjunctively or disjunctively, whichever makes the request most inclusive.

12. “Related Proceedings” means cases alleging infringement or seeking declaratory judgment of non-infringement of one or more of the Asserted Patents, including, without limitation:

- a. In the Matter of Certain Wireless Consumer Electronics Devices and Components Thereof, United States International Trade Commission Proceeding No. 337-TA-853;
- b. Sirius XM Radio Inc. v. Technology Properties Ltd. et al, Case No. 3-10-cv-00816, United States District Court for the Northern District of California;
- c. Sirius XM Radio Inc. v. Technology Properties Ltd., et al., 1-09-cv-04083, United States District Court for the Southern District of New York;
- d. Technology Properties Limited et al. v. Acer Inc., et al., Case No. 2-08-cv-00176, United States District Court for the Eastern District of Texas;
- e. Technology Properties Limited et al. v. ASUSTeK Computer, Inc., Case No. 2-08-cv-00177, United States District Court for the Eastern District of Texas;

- f. Technology Properties Limited et al. v. HTC Corporation et al., Case No. 2-08-cv-00172, United States District Court for the Eastern District of Texas;
- g. Acer, Inc. et al. v. Technology Properties Limited et al., Case No. 5-08-cv-00877, United States District Court for the Northern District of California;
- h. HTC Corporation et al. v. Technology Properties Limited et al., Case No. 5-08-cv-00882, United States District Court for the Northern District of California;
- i. Asustek Computer Inc. v. Technology Properties Limited et al., Case No. 5-08-cv-00884 United States District Court for the Northern District of California;
- j. Toshiba America, Inc. et al. v. Patriot Scientific Corporation et al., Case No. 3-05-cv-04838, United States District Court for the Northern District of California;
- k. JVC Americas Corporation v. Patriot Scientific Corporation et al., Case No. 3-05-cv-04845, United States District Court for the Northern District of California;
- l. Panasonic Corporation of North America et al. v. Patriot Scientific Corporation et al., Case No. 3-05-cv-04844, United States District Court for the Northern District of California;
- m. Fujitsu Computer Systems Corporation, et al. v. Patriot Scientific Corporation, et al., Case No. 3-05-cv-04837;
- n. Technology Properties Limited, Inc., v. Fujitsu Limited et al., Case No. 2-05-cv-00494, United States District Court for the Eastern District of Texas;
- o. Patriot Scientific Corporation v. Moore et al., Case No. 5-04-cv-00618, United States District Court for the Northern District of California;

- p. Intel Corporation v. Patriot Scientific Corporation, Case No. 4-04-cv-00439, United States District Court for the Northern District of California;
- q. Patriot Scientific v. Matsushita Electric, Case No. 2-03-cv-06210, United States District Court for the District of New Jersey;
- r. Patriot Scientific Corporation v. NEC USA, Inc., Case No. 2-03-cv-06432, United States District Court for the Eastern District of New York;
- s. Patriot Scientific Corporation v. Fujitsu Microelectronics America, Inc., Case No. 4-03-cv-05787, United States District Court for the Northern District of California;
- t. Patriot Scientific Corporation v. Toshiba America, Inc., Case No. 1-03-cv-10180, United States District Court for the Southern District of New York;
- u. Patriot Scientific Corporation v. Sony Corporation of America, Case No. 1-03-cv-10142, United States District Court for the Southern District of New York.
- v. Technology Properties Limited, et al. v. Barnes & Noble, Inc., Case No. 3:12-cv-03863;
- w. Technology Properties Limited, et al. v. Huawei Technologies Co., Ltd., Case No. 2:12-cv-03865;
- x. Technology Properties Limited, et al. v. Garmin Ltd., Case No. 3:12-cv-03870;
- y. Technology Properties Limited, et al. v. ZTE Corporation, Case No. 3:12-cv-03876;
- z. Technology Properties Limited, et al. v. Samsung Electronics Co., Case No. 3:12-cv-03877;

aa. Technology Properties Limited, et al. v. Novatel Wireless, Inc., Case No. 3:12-cv-03879;

bb. Technology Properties Limited, et al. v. Nintendo Co., Ltd., Case No. 3:12-cv-03881.

INSTRUCTIONS

1. These Requests shall apply to all Documents and Things in Your actual or constructive possession, custody, or control at the present time, or coming into Your actual or constructive possession, custody, or control during the litigation, including all such responsive Documents and Things located in the personal files of any and all past or present directors, officers, principals, managers, employees, attorneys, agents, representatives, contractors, consultants, or accountants of Plaintiffs. If You know of the existence, past or present, of any Documents and Tangible Things requested herein, but are unable to produce such Documents and Tangible Things because they are not presently in Your possession, custody, or control, You shall so state and shall identify such Documents or Tangible Things, and the Person who has possession, custody, or control of such Documents or Tangible Things.

2. All Documents requested are to be produced in the same file or other organizational environment in which they are maintained. For example, a Document that is part of a file, docket, or other grouping, should be physically produced together with all other Documents from said file, docket, or grouping in the same order or manner of arrangement as the original. File folders with tabs or labels identifying Documents should be produced intact with such Documents.

3. For any responsive Documents or tangible Things that have been lost, destroyed or withheld from production based on any ground, provide a written statement setting forth:

- a. the identity of the Document;
 - b. the nature of the Document (e.g., letter, memorandum, chart);
 - c. the identity of the person(s) who received copies of the Document;
 - d. the date of the Document;
 - e. a brief description of the subject matter of the Document; and
 - f. the circumstances of the loss or destruction of the Document and any fact, statute, rule or decision upon which you rely in withholding the Document.
4. If you withhold from production any Document or part thereof based upon a claim of privilege or any other claim, describe the nature and basis of your claim and the information withheld in a manner sufficient to:
- a. disclose the facts upon which you rely in asserting your claim;
 - b. permit the grounds and reasons for withholding the information to be identified unambiguously; and
 - c. permit the information withheld to be identified unambiguously.
5. You shall keep and produce a record of the source of each Document produced. This shall include the name and location of the file where each Document was located and the name of the person, group or department having possession, custody or control of each Document.
6. Each Document is to be produced along with all drafts, without abbreviation or redaction.

REQUESTS FOR PRODUCTION OF DOCUMENTS

Request for Production No. 1: All Documents and Things relating to conception, reduction to practice, and diligence between conception and reduction to practice, including

corroboration thereof, of the subject matter of the alleged inventions claimed in the Asserted Patents, including any failed attempts at such reduction to practice.

Request for Production No. 2: All Documents and Things identifying any Person or Entity involved in or contributing to the conception, design, development, or initial implementation of the subject matter described or claimed in the Asserted Patents and this Person's or Entity's role and extent of their participation.

Request for Production No. 3: All Documents and Things relating to any contractual or other agreement relating to any work including or leading to the conception or reduction to practice of each alleged invention claimed in the Asserted Patents.

Request for Production No. 4: All Documents and Things relating to inventorship of any claims of the Asserted Patents, including identification of any inventor, the contribution that any named inventor made to conception or reduction to practice, and any claim of inventorship by a Person not named as an inventor on the Asserted Patents.

Request for Production No. 5: All Documents and Things related to inventor files and records, including lab notebooks, related to the subject matter described or claimed in the Asserted Patents.

Request for Production No. 6: All Documents and Things relating to any mode, including the best mode, for practicing the subject matter of the claims of the Asserted Patents known to or contemplated by any inventor prior to allowance of the claim by the USPTO examiner.

Request for Production No. 7: All Documents and Things that relate to the first drawing or sketch, and the first written description of the subject matter disclosed or claimed in the Asserted Patents.

Request for Production No. 8: All Documents and Things that relate to any testing, development, design, experimental, or research activity conducted in connection with any and all alleged inventions described in the Asserted Patents, including, but not limited to, the design, construction and operation of the first device or prototype embodying or intended to embody any of the alleged inventions.

Request for Production No. 9: All Documents and Things relating to any development, beta testing, manufacture, use (including experimental use), publication, knowledge, offer to sell or license, importation, or the sale or license (in the U.S. and worldwide) of any product or process embodying all or part of any of the alleged inventions claimed or disclosed by the Asserted Patents, including all Documents and Things sufficient to show all names, model numbers and any other commercial and/or developmental designation for any product or process, the name and address of the seller, the name and address of the prospective purchaser, the article(s) that was (were) offered for sale, the quantity that was offered for sale, the date of the offer for sale, and the total dollar amount of the offer for sale, prior to the filing date of the first United States patent application describing that subject matter and up to two years after the filing date.

Request for Production No. 10: All Documents and Things that relate to the first offer for sale of the “Sh-boom” microprocessor.

Request for Production No. 11: All written works, whether published or unpublished, which discuss or relate to the first “Sh-boom” microprocessor.

Request for Production No. 12: All sworn statements of the Asserted Patents’ named inventors Charles H. Moore and/or Russell H. Fish, III, whether in the Related Proceedings or before the United States Patent and Trademark Office (“USPTO”), including any

declarations, affidavits, deposition and trial testimony and related transcripts, audio recordings, video recordings, and exhibits.

Request for Production No. 13: All Documents and Things that relate to the scope and meaning of claim terms in the Asserted Patents.

Request for Production No. 14: All Documents and Things that relate to the infringement, non-infringement, validity, invalidity of the Asserted Claims, or to the enforceability or unenforceability of the Asserted Patents, including opinions of counsel.

Request for Production No. 15: All Documents and Things constituting or concerning Prior Art or potential Prior Art, public uses, sales, or offers of sale that relate to an Asserted Patent or applications therefor.

Request for Production No. 16: All Documents and Things prepared, used, relied on, or created in connection with the development, research, investigation, or study of any of the alleged inventions claimed by an Asserted Patent, including any work papers, notebooks, laboratory papers, engineers' notebooks, reports, invention proposals, invention disclosures, patent applications, or other similar materials.

Request for Production No. 17: All Documents and Things that relate to the subject matter described or claimed in the Asserted Patents, including published or unpublished articles, memoranda, reports, papers, manuscripts, technical reports, conference papers, or other publications authored, coauthored, written or co-written by You or any other individual who participated in or contributed to the research or development of the subject matter described in the Asserted Patents, or by any other employee, agent, or representative of a Plaintiff.

Request for Production No. 18: All Documents and Things relating to any design or development activities relating to the subject matter of any claim of the Asserted Patents.

Request for Production No. 19: The identity, name, design, features, function, structure, and operation of any products (including, without limitation, any product, apparatus, method, invention, system, service, prototype, drawing, design, schematic, invention, embodiment or item), covered by any of the subject matter disclosed or claimed in the Asserted Patents.

Request for Production No. 20: All Documents and Things constituting or relating to any search, investigation, evaluation, report, opinion, or Communication relating to alleged infringement by the accused infringers in Related Proceedings.

Request for Production No. 21: All Documents and Things relating to any actual, perceived, or alleged commercial success, licensing, copying, initial professional skepticism or praise, unexpected results (whether successful or not), long felt need, copying, widespread acceptance, improvement over the prior art, or any other secondary indicia of nonobviousness of the alleged inventions claimed or disclosed in the Asserted Patents.

Request for Production No. 22: All Documents and Things constituting or relating to Prior Art relating to the subject matter of the Asserted Patents, public uses, sales, or offers of sale that relate to an Asserted Patent or applications therefor.

Request for Production No. 23: All Documents pertaining to any information or reference asserted by any party to the Related Proceedings or any third party, including but not limited to, during litigation or license negotiations, to be prior art to the Asserted Patents.

Request for Production No. 24: All studies, reports, opinions, or other Documents that relate to the patentability of any of the alleged inventions claimed in the Asserted Patents, including all patents and other references or Things identified, considered, or analyzed in any such studies, reports, opinions, or Documents.

Request for Production No. 25: All Documents and Things considered or evaluated by You regarding, or that relate to, the alleged novelty, unenforceability, or validity of the Asserted Patents.

Request for Production No. 26: All Documents and Things that relate to or considered in connection with the preparation, filing, or prosecution of the Asserted Patents or any of their parent or progeny, including:

- a) the complete prosecution history;
- b) all Documents referred to or relied upon in preparing the application;
- c) all Documents that refer or relate to communications between You and any patent attorney, agent, prior art searcher, or draftsman relating to the subject matter of any claim of any Asserted Patent;
- d) all drafts of the application or of any papers filed during prosecution;
- e) all drawings prepared in connection with the application;
- f) all Documents and Things relating to any communication to or from the USPTO relating to the subject matter of any claim;
- g) all Documents and Things relating to any reexamination, or any request for reexamination, whether or not granted, or any decision to request or not to request reexamination, relating to any Asserted Patent;
- h) all Documents and Things relating to any examiner interview relating to any Asserted Patent;
- i) all Documents and Things relating to any arguments made to the USPTO or a foreign patent office relating to any Asserted Patent;
- j) all Documents concerning ownership of the application.

Request for Production No. 27: All Documents and Things identifying any individual who was involved in the preparation, filing, or prosecution of the Asserted Patents, including Documents identifying the roles and dates of involvement for these individuals.

Request for Production No. 28: All Documents and Things relating to any communication to or from any inventor relating to the subject matter of any claim of the Asserted Patents.

Request for Production No. 29: All Documents and Things, including any communications including or intended for You, that relate to Russell H. Fish.

Request for Production No. 30: All Documents and Things related to any agreement between named inventors Charles H. Moore and/or Russell H. Fish, III, and any Plaintiff, assignee, or any Person now or previously having an ownership or license interest in the Asserted Patents.

Request for Production No. 31: All Documents and Things that relate to any presentation or meeting, the purpose of which was, at least in part, to discuss the Asserted Patents (including any patent applications or other proceedings related to the Asserted Patents).

Request for Production No. 32: All Documents and Things that relate to any actual, attempted, potential, or proposed negotiations, settlements or agreements, entered into in connection with any litigation, proceeding, or dispute resolution process related to the Asserted Patents.

Request for Production No. 33: All Documents regarding Your or a Plaintiff's efforts to license or assign the Asserted Patents.

Request for Production No. 34: All Documents and Things that relate to a Plaintiff.

Request for Production No. 35: All Documents and Things that relate to Your relationship with Plaintiffs, including any negotiations, employment, engagement, agreements

(whether oral or written, including drafts thereof) between You and a Plaintiff or Plaintiff's counsel.

Request for Production No. 36: All Documents and Things that relate to any payments, compensation, or incentives you received from Plaintiffs, directly or indirectly.

Request for Production No. 37: All Documents that pertain to, mention, or discuss any of the parties in the Related Proceedings a Plaintiff accused of infringement, or any of their products.

Request for Production No. 38: All Documents and Things that relate to the bankruptcy proceedings filed by Plaintiff Technology Properties Limited LLC.

Request for Production No. 39: All Documents and Things that You identify or on which You rely in responding to any discovery requests (including this subpoena) served in this action.

Request for Production No. 40: All Documents and Things relating to Your preparation for Your deposition(s) in this action.

Request for Production No. 41: All Documents and Things relating to Your collection, review, and production of Documents in response to this subpoena.

AO 88A (Rev. 02/14) Subpoena to Testify at a Deposition in a Civil Action

UNITED STATES DISTRICT COURT
for the
Northern District of California

See list of cases and parties in Attachment A

Plaintiff

v.

See list of cases and parties in Attachment A

Defendant

Civil Action No. See list of cases in Att. A

SUBPOENA TO TESTIFY AT A DEPOSITION IN A CIVIL ACTION

To: Charles H. Moore

(Name of person to whom this subpoena is directed)

Testimony: YOU ARE COMMANDED to appear at the time, date, and place set forth below to testify at a deposition to be taken in this civil action. If you are an organization, you must designate one or more officers, directors, or managing agents, or designate other persons who consent to testify on your behalf about the following matters, or those set forth in an attachment:

See Attachment B

Table with 2 columns: Place (Regus Reno, 200 S Virginia St, Reno, NV 89501) and Date and Time (07/07/2015 9:00 am)

The deposition will be recorded by this method: by stenographic, video, audio, and/or realtime means

Production: You, or your representatives, must also bring with you to the deposition the following documents, electronically stored information, or objects, and must permit inspection, copying, testing, or sampling of the material:

The following provisions of Fed. R. Civ. P. 45 are attached – Rule 45(c), relating to the place of compliance; Rule 45(d), relating to your protection as a person subject to a subpoena; and Rule 45(e) and (g), relating to your duty to respond to this subpoena and the potential consequences of not doing so.

Date: 06/09/2015

CLERK OF COURT

OR

/s/ Wasif Qureshi

Signature of Clerk or Deputy Clerk

Attorney's signature

The name, address, e-mail address, and telephone number of the attorney representing (name of party) LG Electronics, Inc. and LG Electronics USA, Inc., who issues or requests this subpoena, are:

Wasif Qureshi, 1221 McKinney St., Suite 2800, Houston, TX 77010, 713-654-5333, qureshi@fr.com

Notice to the person who issues or requests this subpoena

If this subpoena commands the production of documents, electronically stored information, or tangible things before trial, a notice and a copy of the subpoena must be served on each party in this case before it is served on the person to whom it is directed. Fed. R. Civ. P. 45(a)(4).

Civil Action No. See list of cases in Att. A

PROOF OF SERVICE

(This section should not be filed with the court unless required by Fed. R. Civ. P. 45.)

I received this subpoena for *(name of individual and title, if any)* _____
on *(date)* _____ .

I served the subpoena by delivering a copy to the named individual as follows: _____

_____ on *(date)* _____ ; or

I returned the subpoena unexecuted because: _____
_____ .

Unless the subpoena was issued on behalf of the United States, or one of its officers or agents, I have also
tendered to the witness the fees for one day's attendance, and the mileage allowed by law, in the amount of
\$ _____ .

My fees are \$ _____ for travel and \$ _____ for services, for a total of \$ _____ 0.00 .

I declare under penalty of perjury that this information is true.

Date: _____

Server's signature

Printed name and title

Server's address

Additional information regarding attempted service, etc.:

Federal Rule of Civil Procedure 45 (c), (d), (e), and (g) (Effective 12/1/13)**(c) Place of Compliance.**

(1) For a Trial, Hearing, or Deposition. A subpoena may command a person to attend a trial, hearing, or deposition only as follows:

- (A) within 100 miles of where the person resides, is employed, or regularly transacts business in person; or
- (B) within the state where the person resides, is employed, or regularly transacts business in person, if the person
 - (i) is a party or a party's officer; or
 - (ii) is commanded to attend a trial and would not incur substantial expense.

(2) For Other Discovery. A subpoena may command:

- (A) production of documents, electronically stored information, or tangible things at a place within 100 miles of where the person resides, is employed, or regularly transacts business in person; and
- (B) inspection of premises at the premises to be inspected.

(d) Protecting a Person Subject to a Subpoena; Enforcement.

(1) Avoiding Undue Burden or Expense; Sanctions. A party or attorney responsible for issuing and serving a subpoena must take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena. The court for the district where compliance is required must enforce this duty and impose an appropriate sanction—which may include lost earnings and reasonable attorney's fees—on a party or attorney who fails to comply.

(2) Command to Produce Materials or Permit Inspection.

(A) *Appearance Not Required.* A person commanded to produce documents, electronically stored information, or tangible things, or to permit the inspection of premises, need not appear in person at the place of production or inspection unless also commanded to appear for a deposition, hearing, or trial.

(B) *Objections.* A person commanded to produce documents or tangible things or to permit inspection may serve on the party or attorney designated in the subpoena a written objection to inspecting, copying, testing, or sampling any or all of the materials or to inspecting the premises—or to producing electronically stored information in the form or forms requested. The objection must be served before the earlier of the time specified for compliance or 14 days after the subpoena is served. If an objection is made, the following rules apply:

- (i) At any time, on notice to the commanded person, the serving party may move the court for the district where compliance is required for an order compelling production or inspection.
- (ii) These acts may be required only as directed in the order, and the order must protect a person who is neither a party nor a party's officer from significant expense resulting from compliance.

(3) Quashing or Modifying a Subpoena.

(A) *When Required.* On timely motion, the court for the district where compliance is required must quash or modify a subpoena that:

- (i) fails to allow a reasonable time to comply;
- (ii) requires a person to comply beyond the geographical limits specified in Rule 45(c);
- (iii) requires disclosure of privileged or other protected matter, if no exception or waiver applies; or
- (iv) subjects a person to undue burden.

(B) *When Permitted.* To protect a person subject to or affected by a subpoena, the court for the district where compliance is required may, on motion, quash or modify the subpoena if it requires:

(i) disclosing a trade secret or other confidential research, development, or commercial information; or

(ii) disclosing an unretained expert's opinion or information that does not describe specific occurrences in dispute and results from the expert's study that was not requested by a party.

(C) *Specifying Conditions as an Alternative.* In the circumstances described in Rule 45(d)(3)(B), the court may, instead of quashing or modifying a subpoena, order appearance or production under specified conditions if the serving party:

- (i) shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship; and
- (ii) ensures that the subpoenaed person will be reasonably compensated.

(e) Duties in Responding to a Subpoena.

(1) Producing Documents or Electronically Stored Information. These procedures apply to producing documents or electronically stored information:

(A) *Documents.* A person responding to a subpoena to produce documents must produce them as they are kept in the ordinary course of business or must organize and label them to correspond to the categories in the demand.

(B) *Form for Producing Electronically Stored Information Not Specified.* If a subpoena does not specify a form for producing electronically stored information, the person responding must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms.

(C) *Electronically Stored Information Produced in Only One Form.* The person responding need not produce the same electronically stored information in more than one form.

(D) *Inaccessible Electronically Stored Information.* The person responding need not provide discovery of electronically stored information from sources that the person identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the person responding must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the court may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of Rule 26(b)(2)(C). The court may specify conditions for the discovery.

(2) Claiming Privilege or Protection.

(A) *Information Withheld.* A person withholding subpoenaed information under a claim that it is privileged or subject to protection as trial-preparation material must:

- (i) expressly make the claim; and
- (ii) describe the nature of the withheld documents, communications, or tangible things in a manner that, without revealing information itself privileged or protected, will enable the parties to assess the claim.

(B) *Information Produced.* If information produced in response to a subpoena is subject to a claim of privilege or of protection as trial-preparation material, the person making the claim may notify any party that received the information of the claim and the basis for it. After being notified, a party must promptly return, sequester, or destroy the specified information and any copies it has; must not use or disclose the information until the claim is resolved; must take reasonable steps to retrieve the information if the party disclosed it before being notified; and may promptly present the information under seal to the court for the district where compliance is required for a determination of the claim. The person who produced the information must preserve the information until the claim is resolved.

(g) Contempt.

The court for the district where compliance is required—and also, after a motion is transferred, the issuing court—may hold in contempt a person who, having been served, fails without adequate excuse to obey the subpoena or an order related to it.

ATTACHMENT A

This subpoena is issued in the following cases pending in the United States District Court for the Northern District of California:

- *Technology Properties Ltd., et al. v. Barnes & Noble, Inc.*; Case No. 3:12-cv-03863
- *Technology Properties Ltd., et al. v. Huawei Tech. Co., Ltd., et al.*; Case No. 2:12-cv-03865
- *Technology Properties Ltd., et al. v. Garmin Ltd. et al.*; Case No. 3:12-cv-03870
- *Technology Properties Ltd., et al. v. ZTE Corporation et al.*; Case No. 3:12-cv-03876
- *Technology Properties Ltd., et al. v. Samsung Elec. Co. et al.*; Case No. 3:12-cv-03877
- *Technology Properties Ltd., et al. v. Novatel Wireless, Inc.*; Case No. 3:12-cv-03879
- *Technology Properties Ltd., et al. v. LG Electronics, Inc. et al.*; Case No. 3:12-cv-03880
- *Technology Properties Ltd., et al. v. Nintendo Co., Ltd. et al.*; Case No. 3:12-cv-03881

ATTACHMENT B

DEFINITIONS

1. “You,” “Your,” and “Yours” means Charles H. Moore.
2. “Plaintiffs” means Plaintiffs Technology Properties Limited LLC, Phoenix Digital Solutions LLC, and Patriot Scientific Corporation, both individually and in any combination, including past and present officers, directors, employees, agents, consultants, predecessors, subsidiaries, parents, affiliates, and contractors.
3. “Asserted Patents” means any one or more of United States Patent Nos. 5,440,749 (“the ’749 patent”), 5,530,890 (“the ’890 patent”), and 5,809,336 (the ’336 patent”), together with any patents Plaintiffs may later attempt to assert in this action.
4. “Asserted Claims” means: claims 1, 43 and 59 of the ’749 patent; claims 7, 9, 11, 12, 13, 17 and 19 of the ’890 patent; and claims 6, 7, 9, 13, 14, and 15 of the ’336 patent, together with any claims Plaintiffs may later attempt to assert in this action.
5. “Prior Art” means anything that constitutes Prior Art under any subsection of 35 U.S.C. § 102 or § 103, including, without limitation, any publication, patent, use, sale, offer for sale, prior invention, knowledge, or other activity.
6. “Document(s)” is used in the broadest sense to include everything contemplated by Rule 34(a)(1)(A) of the Federal Rules of Civil Procedure and by Rule 1001 of the Federal Rules of Evidence. If a draft Document has been prepared in several copies that are not identical, or if the original identical copies are no longer identical due to subsequent notation, each non-identical Document is a separate Document.
7. “Thing(s)” is used in the broadest sense to include everything contemplated by Rule 34(a)(1)(B) of the Federal Rules of Civil Procedure.

8. “Person” or “Entity” and their plural forms include, without limitation, natural persons, partnerships, corporations, associations, and any other legal entities and units thereof.

9. “Communication” means any transmission of information, whether oral or in writing, including drafts.

10. “Relating to” and “concerning” are used in its broadest sense to include any connection, relation, or relevance.

11. The words “and” and “or” shall be construed conjunctively or disjunctively, whichever makes the request most inclusive.

12. “Related Proceedings” means cases alleging infringement or seeking declaratory judgment of non-infringement of one or more of the Asserted Patents, including, without limitation:

- a. In the Matter of Certain Wireless Consumer Electronics Devices and Components Thereof, United States International Trade Commission Proceeding No. 337-TA-853;
- b. Sirius XM Radio Inc. v. Technology Properties Ltd. et al, Case No. 3-10-cv-00816, United States District Court for the Northern District of California;
- c. Sirius XM Radio Inc. v. Technology Properties Ltd., et al., 1-09-cv-04083, United States District Court for the Southern District of New York;
- d. Technology Properties Limited et al. v. Acer Inc., et al., Case No. 2-08-cv-00176, United States District Court for the Eastern District of Texas;
- e. Technology Properties Limited et al. v. ASUSTeK Computer, Inc., Case No. 2-08-cv-00177, United States District Court for the Eastern District of Texas;

- f. Technology Properties Limited et al. v. HTC Corporation et al., Case No. 2-08-cv-00172, United States District Court for the Eastern District of Texas;
- g. Acer, Inc. et al. v. Technology Properties Limited et al., Case No. 5-08-cv-00877, United States District Court for the Northern District of California;
- h. HTC Corporation et al. v. Technology Properties Limited et al., Case No. 5-08-cv-00882, United States District Court for the Northern District of California;
- i. Asustek Computer Inc. v. Technology Properties Limited et al., Case No. 5-08-cv-00884 United States District Court for the Northern District of California;
- j. Toshiba America, Inc. et al. v. Patriot Scientific Corporation et al., Case No. 3-05-cv-04838, United States District Court for the Northern District of California;
- k. JVC Americas Corporation v. Patriot Scientific Corporation et al., Case No. 3-05-cv-04845, United States District Court for the Northern District of California;
- l. Panasonic Corporation of North America et al. v. Patriot Scientific Corporation et al., Case No. 3-05-cv-04844, United States District Court for the Northern District of California;
- m. Fujitsu Computer Systems Corporation, et al. v. Patriot Scientific Corporation, et al., Case No. 3-05-cv-04837;
- n. Technology Properties Limited, Inc., v. Fujitsu Limited et al., Case No. 2-05-cv-00494, United States District Court for the Eastern District of Texas;
- o. Patriot Scientific Corporation v. Moore et al., Case No. 5-04-cv-00618, United States District Court for the Northern District of California;

- p. Intel Corporation v. Patriot Scientific Corporation, Case No. 4-04-cv-00439, United States District Court for the Northern District of California;
- q. Patriot Scientific v. Matsushita Electric, Case No. 2-03-cv-06210, United States District Court for the District of New Jersey;
- r. Patriot Scientific Corporation v. NEC USA, Inc., Case No. 2-03-cv-06432, United States District Court for the Eastern District of New York;
- s. Patriot Scientific Corporation v. Fujitsu Microelectronics America, Inc., Case No. 4-03-cv-05787, United States District Court for the Northern District of California;
- t. Patriot Scientific Corporation v. Toshiba America, Inc., Case No. 1-03-cv-10180, United States District Court for the Southern District of New York;
- u. Patriot Scientific Corporation v. Sony Corporation of America, Case No. 1-03-cv-10142, United States District Court for the Southern District of New York.
- v. Technology Properties Limited, et al. v. Barnes & Noble, Inc., Case No. 3:12-cv-03863;
- w. Technology Properties Limited, et al. v. Huawei Technologies Co., Ltd., Case No. 2:12-cv-03865;
- x. Technology Properties Limited, et al. v. Garmin Ltd., Case No. 3:12-cv-03870;
- y. Technology Properties Limited, et al. v. ZTE Corporation, Case No. 3:12-cv-03876;
- z. Technology Properties Limited, et al. v. Samsung Electronics Co., Case No. 3:12-cv-03877;

aa. Technology Properties Limited, et al. v. Novatel Wireless, Inc., Case No. 3:12-cv-03879;

bb. Technology Properties Limited, et al. v. Nintendo Co., Ltd., Case No. 3:12-cv-03881.

INSTRUCTIONS

1. To the extent this deposition concerns production of documents, such production shall apply to all Documents and Things in Your actual or constructive possession, custody, or control at the present time, or coming into Your actual or constructive possession, custody, or control during the litigation, including all such responsive Documents and Things located in the personal files of any and all past or present directors, officers, principals, managers, employees, attorneys, agents, representatives, contractors, consultants, or accountants of Plaintiffs. If You know of the existence, past or present, of any relevant Documents and Tangible Things, but are unable to produce such Documents and Tangible Things because they are not presently in Your possession, custody, or control, You shall so state and shall identify such Documents or Tangible Things, and the Person who has possession, custody, or control of such Documents or Tangible Things.

2. All Documents are to be produced in the same file or other organizational environment in which they are maintained. For example, a Document that is part of a file, docket, or other grouping, should be physically produced together with all other Documents from said file, docket, or grouping in the same order or manner of arrangement as the original. File folders with tabs or labels identifying Documents should be produced intact with such Documents.

3. For any responsive Documents or tangible Things that have been lost, destroyed or withheld from production based on any ground, provide a written statement setting forth:

- a. the identity of the Document;
- b. the nature of the Document (e.g., letter, memorandum, chart);
- c. the identity of the person(s) who received copies of the Document;
- d. the date of the Document;
- e. a brief description of the subject matter of the Document; and
- f. the circumstances of the loss or destruction of the Document and any fact, statute, rule or decision upon which you rely in withholding the Document.

4. If you withhold from production any Document or part thereof based upon a claim of privilege or any other claim, describe the nature and basis of your claim and the information withheld in a manner sufficient to:

- a. disclose the facts upon which you rely in asserting your claim;
- b. permit the grounds and reasons for withholding the information to be identified unambiguously; and
- c. permit the information withheld to be identified unambiguously.

5. You shall keep and produce a record of the source of each Document produced. This shall include the name and location of the file where each Document was located and the name of the person, group or department having possession, custody or control of each Document.

6. Each Document is to be produced along with all drafts, without abbreviation or redaction.

DEPOSITION TOPICS

Deposition Topic No. 1: Your education, professional training, employment history, and current employment.

Deposition Topic No. 2: Any patent or patent application naming You as an inventor (including the Asserted Patents).

Deposition Topic No. 3: The conception, reduction to practice, and diligence between conception and reduction to practice, including corroboration thereof, of the subject matter of the alleged inventions claimed in the Asserted Patents, including any failed attempts at such reduction to practice, and any corroborating Documents or Things.

Deposition Topic No. 4: Any contractual or other agreement relating to any work including or leading to the conception or reduction to practice of each alleged invention claimed in the Asserted Patents.

Deposition Topic No. 5: Any Person or Entity involved in or contributing to the conception, design, development, or initial implementation of the subject matter described or claimed in the Asserted Patents and this Person's or Entity's role and extent of their participation.

Deposition Topic No. 6: Inventorship of any claims of the Asserted Patents, including identification of any inventor, the contribution that any named inventor made to conception or reduction to practice, and any claim of inventorship by a Person not named as an inventor on the Asserted Patents.

Deposition Topic No. 7: Your decision to undertake research and development concerning the alleged invention(s) claimed in the Asserted Patents.

Deposition Topic No. 8: Any testing, development, design, experimental, or research activity conducted in connection with any alleged inventions described in the Asserted Patents, including, but not limited to, the design, construction and operation of the first device or prototype embodying or intended to embody any of the alleged inventions, and any persons who participated in or have knowledge of the foregoing.

Deposition Topic No. 9: The first demonstration, publication or otherwise making available to the public (in the U.S. and worldwide), first use (in the U.S. and worldwide), first offer to sell or license (in the U.S. and worldwide) and first sale or license (in the U.S. and worldwide) of any product or prototype covered by the Asserted Patents, including but not limited to the date(s) of such demonstration, use, and/or sale or license.

Deposition Topic No. 10: Any attempts by You, Plaintiffs, or any third parties to design, develop, make, market, sell, offer to sell, advertise, license or otherwise commercialize any product or prototype covered by any of the Asserted Patents, including but not limited to the date(s) when such activity began, the identity of each person involved in such activity, and Documents relating to any of the foregoing.

Deposition Topic No. 11: The claims of the Asserted Patents, including their scope and meaning, and any previous related declarations or testimony by You in Related Proceedings or before the United States Patent and Trademark Office (“USPTO”).

Deposition Topic No. 12: The disclosures in the Asserted Patents, including whether such disclosures enable one of ordinary skill in the art to make and use the subject matter claimed in the Asserted Patents.

Deposition Topic No. 13: Any mode, including the best mode, for practicing the subject matter of the claims of the Asserted Patents known to or contemplated by any inventor prior to allowance of the claim by the USPTO examiner.

Deposition Topic No. 14: The prosecution and post-issuance activities regarding the Asserted Patents, including, without limitation, any and all parent applications, divisionals, continuations, continuations-in-part, foreign equivalents, applications claiming the benefit of the filing date of any of the foregoing (whether abandoned or not), and maintenance, including but not limited to the identity of the persons who drafted, reviewed, contributed to, or were otherwise involved in the preparation, filing, or prosecution of said patent applications and maintenance of said patent (including Plaintiffs' prior and present employees, agents, and attorneys).

Deposition Topic No. 15: All Prior Art or preexisting technology known to You, to any person working at Your or Plaintiffs' request, to any person working on Your or Plaintiffs' behalf, or to any third party in connection with any analysis or consideration of the claims of the Asserted Patents.

Deposition Topic No. 16: All results of Prior Art searches, investigations or analyses conducted by You, by Your or Plaintiffs' request, or on Your or Plaintiffs' behalf relating to the validity and/or enforceability of the Asserted Patents, including but not limited to, the identity of the individuals involved in conducting Prior Art searches, and Documents relating to any of the foregoing.

Deposition Topic No. 17: All analysis, research and/or testing that compares the alleged invention(s) claimed in the Asserted Patent with any Prior Art.

Deposition Topic No. 18: Your knowledge regarding the disclosure or non-disclosure of Prior Art (including information relating to preexisting technology) to the USPTO in connection

with the prosecution of the applications that matured into the Asserted Patents, its parent applications, divisionals, continuations, continuations-in-part, foreign equivalents, and applications claiming the benefit of the filing date of any of the foregoing (whether abandoned or not) or the parent or progeny of the Asserted Patents, including the knowledge and/or compliance with any duty of disclosure to the USPTO respecting the Asserted Patents, by You, any other Inventors or any other person having such duty.

Deposition Topic No. 19: The factual bases for any benefits that are generated by using a product or method covered by the Asserted Patents as compared to what was known in the Prior Art when the applications for the Asserted Patents were filed.

Deposition Topic No. 20: Any disclosures that relate to the subject matter described or claimed in the Asserted Patents, including published or unpublished articles, memoranda, reports, papers, manuscripts, technical reports, conference papers, symposiums, conventions, seminars and/or speeches.

Deposition Topic No. 21: Any agreement between named inventors Charles H. Moore and/or Russell H. Fish, III, and any Plaintiff, assignee, or any Person now or previously having an ownership or license interest in the Asserted Patents.

Deposition Topic No. 22: Any design or development activities relating to the subject matter of any claim of the Asserted Patents.

Deposition Topic No. 23: The identity, name, design, features, function, structure, and operation of any products (including, without limitation, any product, apparatus, method, invention, system, service, prototype, drawing, design, schematic, invention, embodiment or item), covered by any of the subject matter disclosed or claimed in the Asserted Patents.

Deposition Topic No. 24: Any facts that support or negate actual, perceived, or alleged commercial success ((including any facts supporting a nexus between the claims of the Asserted Patents and such success), licensing, copying, initial professional skepticism or praise, unexpected results (whether successful or not), long felt need, copying, widespread acceptance, improvement over the Prior Art, or any other secondary indicia of nonobviousness of the alleged inventions claimed or disclosed in the Asserted Patents.

Deposition Topic No. 25: Infringement or non-infringement with respect to the products Plaintiffs accused of infringement in the Related Proceedings, and any related studies, reports, opinions, or Documents.

Deposition Topic No. 26: The patentability, validity, enforceability, value and/or marketability of the Asserted Patents and/or the subject matter disclosed or claimed therein, and any related studies, reports, opinions, or Documents.

Deposition Topic No. 27: Any actual, attempted, potential, or proposed negotiations, settlements or agreements, entered into in connection with any litigation, proceeding, or dispute resolution process related to the Asserted Patents.

Deposition Topic No. 28: Any efforts by You, Plaintiffs, or any third party to license or assign the Asserted Patents.

Deposition Topic No. 29: Your knowledge of Plaintiffs.

Deposition Topic No. 30: Your relationship with Plaintiffs, including any negotiations, employment, engagement, agreements (whether oral or written, including drafts thereof) between You and a Plaintiff or Plaintiff's counsel.

Deposition Topic No. 31: Any payments, compensation, or incentives you received from Plaintiffs, directly or indirectly.

Deposition Topic No. 32: The bankruptcy proceedings filed by Plaintiff Technology Properties Limited LLC.

Deposition Topic No. 33: All Documents that pertain to, mention, or discuss any of the parties in the Related Proceedings a Plaintiff accused of infringement, or any of their products.

Deposition Topic No. 34: Your knowledge of and participation in any legal action involving the Asserted Patents, including the Related Proceedings, including any declarations, affidavits, reports, deposition or trial testimony You provided.

Deposition Topic No. 35: All Documents and Things that You identify or on which You rely in responding to any discovery requests (including this subpoena) served in this action.

Deposition Topic No. 36: Your preparation for Your deposition(s) in this action.

Deposition Topic No. 37: Your collection, review and production of Documents in response to this subpoena.

Exhibit 2

**** E-filed November 19, 2010 ****

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NOT FOR CITATION
IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

ACER INC. et al,

No. C08-00877 JF (HRL)

Plaintiffs,

**ORDER DENYING PLAINTIFFS’
MOTION AND ENTERING
PROTECTIVE ORDER**

v.

TECHNOLOGY PROPERTIES LTD., et al,

[Re: Docket No. 195]

Defendants.

BACKGROUND

Plaintiffs Acer, Inc., Acer American, Corp., and Gateway, Inc. (collectively, “Plaintiffs”) filed this action against defendant Technology Properties Limited (“TPL”) and others for declaratory judgment of non-infringement and invalidity of, among others, United States Patent No. 5,809,336 (the “’336 patent”). Non-party Charles Moore (“Moore”) is a named inventor of the ‘336 patent. In 2002, Moore executed a commercialization agreement with TPL which granted TPL co-ownership (along with Moore) of the ‘336 patent and obligated Moore to support the commercialization activities of TPL. (Docket No. 205 (“Supp. Leckrone Decl.”), Ex. 2.)

In conjunction with his obligations under the commercialization agreement, Moore was orally appointed as Chief Technology officer (“CTO”) of IntellaSys, a TPL-related enterprise in the fall of 2005. (Docket No. 208 (“Leckrone Decl.”), ¶ 3; Docket No. 206 (“Moore Decl.”), ¶¶ 5-6.) He later became the CTO of TPL when IntellaSys was merged into TPL in September 2006.

1 (Leckrone Decl., ¶ 3; Moore Decl., ¶¶ 5-7.) Moore was the CTO of TPL from September 2006 to
2 January 2009. (Leckrone Decl., ¶ 3; Moore Decl., ¶¶ 5-7.)

3 From 2006 to 2009, the USPTO conducted three reexamination proceedings of the ‘336
4 patent. As part of these proceedings, Moore, then TPL’s CTO¹, was interviewed by the United
5 States Patent and Trademark Office (“USPTO”) in August 2008. (Leckrone Decl., ¶ 4; Moore
6 Decl., ¶¶ 7-8.) Shortly thereafter, emails discussing the interview were sent among TPL executives
7 Dan Leckrone, Mac Leckrone, Larry Henneman (a TPL-retained patent attorney at Henneman &
8 Associates, PLC), George Yee (a TPL-retained patent attorney at Townsend and Townsend and
9 Crew LLP (“Townsend”)), other Townsend attorneys, and Moore. (Docket No. 195-2 (“Dhillon
10 Decl.”), Exs. 6, 7.) In one email (file name “mac336.htm”), Yee, Henneman, and Mac Leckrone
11 discuss the attorneys’ impressions of the interview and their conclusions about the patentability of
12 the ‘336 patent’s claims. (Dhillon Decl., Ex. 6.) In a second email (Bates-stamped “Moore0058”),
13 Moore responds to the others’ questions and comments. (Dhillon Decl., Ex. 7.)

14 Much more recently, Plaintiffs served Moore with a document and deposition subpoena on
15 September 30, 2010. Plaintiffs provided TPL with a copy of the subpoena, so it was on notice of the
16 documents sought. Moore produced responsive documents on October 15 and 18. Inadvertently
17 included within these productions were the two emails discussing Moore’s interview with the
18 USPTO.²

19 Although Plaintiffs provided TPL with advance notice of the subpoena to Moore, TPL did
20 not object to it or move to quash the subpoena or for a protective order. In fact, TPL did not do
21 anything until October 19 — the day after Moore finished producing the documents — when, after

22 ¹ Moore states in his declaration that “[i]n or about August 2008, while I served as Chief
23 Technology Officer of Intellasis and TPL, one or more of the MMP portfolio patents was the
24 subject of a patent reexamination procedure before the United States Patent and Trademark Office
(the ‘PTO’).” (Moore Decl., ¶ 6.)

25 ² Moore states that he “inadvertently included, among the documents and materials I gave to [his
26 counsel], an August 14, 2008 memorandum I sent to the TPL Reexamination Attorneys. My
27 memorandum, which bears the Bates stamp Number ‘MOORE0058,’ was an attorney-client
28 privileged response to a request for information from the TPL Reexamination Attorneys. As such,
the memorandum was a privileged documents that should not have been produced in the present
litigation, but should have been listed as attorney-client privileged and withheld from production.”
(Moore Decl., ¶ 13.) He goes on: “Similarly, a digitally stored file known as ‘MAC336.htm,’ was
also inadvertently produced, despite it being a privileged communication by and between the TPL
Reexamination Attorneys and TPL in connection with the then-ongoing PTO reexamination
process.” (Moore Decl., ¶ 14.)

1 reviewing Moore's production, it notified Plaintiffs via email that the "mac336.htm" and
2 "Moore0058" emails are privileged.

3 Plaintiffs filed the instant motion for the immediate resolution of the parties' dispute over
4 whether these two emails are protected by the attorney-client privilege. (Docket No. 195
5 ("Motion").) TPL filed its opposition brief on October 28 (Docket No. 200 (Opp'n")), and the oral
6 argument was heard on November 2. Plaintiffs have sequestered the two documents in question as
7 required by Rule 26(b)(5)(B) pending this Court's resolution of the dispute.

8 DISCUSSION

9 A. The Emails Are Privileged

10 Despite Plaintiffs' doubt, the two emails in question, "mac336.htm" and "Moore0058," are
11 protected by the attorney- privilege. "The attorney-client privilege protects the confidentiality of
12 communications between attorney and client made for the purpose of obtaining legal advice."
13 *Genentech, Inc. v. U.S. Intern. Trade Com'n.*, 122 F.3d 1409, 1415 (Fed. Cir. 1997) (citing
14 *American Standard Inc. v. Pfizer Inc.*, 828 F.2d 734, 745 (Fed.Cir. 1987)). Here, TPL hired
15 attorneys Henneman and Yee (along with the other Townsend attorneys) in relation to the '336
16 patent reexamination proceedings before the USPTO. Moore, Daniel Leckrone, and Max Leckrone
17 were all executives of TPL in August 2008. As the emails at issue describe confidential
18 conversations between only TPL executives (including Moore) and TPL's attorneys about Moore's
19 USPTO interview in relation to the '336 patent reexamination, these emails are clearly protected by
20 the attorney-client privilege.

21 B. Whether the Emails Should Nevertheless Be Produced

22 Plaintiffs contend that even if the two emails are privileged (which they are), TPL waived its
23 right to assert the attorney-client privilege. It argues that "[w]hile a nonparty may challenge a
24 document subpoena on the grounds of privilege via written objection, a party such as TPL may only
25 challenge the subpoena by moving to quash or modify the subpoena pursuant to FRCP 45(c)(3)(A),
26 or by moving for a protective order pursuant to FRCP 26(c)." (Motion at 6.) Indeed, under Rule 45,
27 a nonparty served with a subpoena may make objections within 14 days after service, or before the
28 time for compliance if it is less than 14 days. FED. R. CIV. P. 45(c)(2)(B). "Only the witness can

1 prevent disclosure by objection. The party to whom the subpoenaed records pertain *cannot* simply
2 object. Rather, a protective order or motion to quash the subpoena is required.” SCHWARZER, ET
3 AL., CAL. PRAC. GUIDE: FED. CIV. PROC. BEFORE TRIAL, § 11:2291 (The Rutter Group 2010)
4 (emphasis in original). Thus, Plaintiffs argue that “the onus was squarely on TPL to either
5 communicate with Moore concerning any privilege issues, or as expressly provided by Rule 45, to
6 diligently seek a protective order to ensure that Moore did not produce any alleged privileged
7 documents.” (Motion at 7.) They say that TPL failed to file such a motion before the date upon
8 which Moore was required to comply with the subpoena, thereby waiving any claim of privilege
9 over Moore’s production. (*Id.* at 6.)

10 TPL does not agree. It contends that it was not on notice that privileged documents might
11 be produced. This was so, it says, for several reasons, namely: (1) Moore was no longer affiliated
12 with TPL; (2) per TPL’s Policy on Use of Electronic Communications, Moore was expected to have
13 returned to TPL all of its material upon his 2009 departure; and (3) Moore was barred from
14 producing any privileged materials without TPL’s express consent pursuant to the
15 commercialization agreement. (Opp’n at 3, 8.) Under these circumstances, it had no basis to move
16 to quash the subpoena prior to production. (*Id.* at 8.)

17 TPL also argues that FRCP 45 allows for the post-production assertion of the attorney-client
18 privilege and does not require that a party so asserting have previously objected or moved to quash
19 on privilege grounds. (*Id.* at 9.) It cites FRCP 45(d)(2)(B), which provides that “[i]f any
20 information produced in response to a subpoena is subject to a claim of privilege or of protection as
21 trial-preparation material, the person making the claim may notify any party that received the
22 information of the claim and the basis for it,” whereupon any dispute over the information can be
23 resolved by a court.

24 While “a nonparty’s failure to timely make objections to a Rule 45 subpoena generally
25 requires the court to find that any objections have been waived, . . . ‘[i]n unusual circumstances and
26 for good cause, . . . the failure to act timely will not bar consideration of objections [to a Rule 45
27 subpoena].’ Courts have found unusual circumstances where, for instance, the subpoena is
28 overbroad on its face and exceeds the bounds of fair discovery and the subpoenaed witness is a non-

1 party acting in good faith.” *Moon v. SCP Pool Corp.*, 232 F.R.D. 633, 636 (C.D. Cal. 2005)
2 (internal citations omitted). Here, the subpoena served upon Moore does not appear to be overly
3 broad or exceed to bounds of fair discovery, and neither Moore nor TPL have made such a claim.
4 *See* Dhillon Decl., Ex. 4. The Court, therefore, does not believe that “unusual circumstances”
5 exception applies.

6 However, “under Rule 26(c), the Court may *sua sponte* grant a protective order for good
7 cause shown.” *McCoy v. Southwest Airlines Co., Inc.*, 211 F.R.D. 381, 385 (C.D. Cal. 2002); *see*
8 *also, Coleman v. Schwarzenegger*, Nos. CIV S-90-0520 LKK JFM P, C01-1351 THE, 2007 WL
9 4276554, at *1 (E.D. Cal. Nov. 29, 2007) (“Under Federal Rule of Civil Procedure 26(c), and in the
10 inherent discretion of a court to manage its own discovery, a court may *sua sponte* enter a protective
11 order for good cause shown. A protective order may include an order that “discovery not be had.”)
12 (internal citations omitted); *Lesal Interiors, Inc. v. Resolution Trust Corp.*, 153 F.R.D. 552, 558 n.4
13 (D.N.J. 1994) (“[U]nder Fed.R.Civ.P. 26(c), and the discretion allocated this court in the
14 management of discovery generally, where a court determined to deny a motion to compel, it may,
15 if circumstances so justify, enter a protective order *sua sponte*. The converse is likewise a
16 possibility.”).

17 In *McCoy*, for example, the court dealt with a similar situation to the one here. In that case,
18 the plaintiffs served a Rule 45 subpoena on a nonparty for documents concerning the defendants.
19 *McCoy*, 211 F.R.D. at 383. Although the defendants objected, they did not move to quash the
20 subpoena or for a protective order, and the nonparty produced documents without objecting at all.
21 *Id.* The court acknowledged that (1) the defendants cannot object to a subpoena directed to a
22 nonparty, (2) a nonparty’s failure to object normally requires the court to find that any objection,
23 including those related to privilege, has been waived, and (3) the subpoena at issue was not
24 overbroad and so the “unusual circumstances” exception did not apply. *Id.* at 385. Instead, the
25 court relied upon Rule 26 and its discretion to consider *sua sponte* granting a protective order. *Id.*
26 After determining that the documents at issue were not privileged (as the defendants had claimed
27 they were), the court decided not to enter a protective order and granted the plaintiffs’ motion to
28 compel. *Id.* at 386-88.

1 But here, the emails are privileged. Given TPL’s prompt assertion of the attorney-client
2 privilege once it saw the documents Moore produced and this Court’s preference for decisions based
3 on the merits rather than on procedural missteps, the Court believes that good cause has been shown
4 for its *sua sponte* entry of a protective order requiring Plaintiffs to either destroy or return to Moore
5 any copies of the privileged emails they have sequestered.

6 **CONCLUSION**

7 Based on the foregoing, Plaintiffs’ motion is DENIED. Plaintiffs shall either destroy or
8 return to Moore any and all copies of the two emails at issue (“mac336.htm” and “Moore0058”)
9 within 5 days from the date of this order.

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11 **IT IS SO ORDERED.**

12 Dated: November 19, 2010

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15 HOWARD R. LLOYD
16 UNITED STATES MAGISTRATE JUDGE

1 **C08-00877 JF (HRL) Notice will be electronically mailed to:**

2 Eugene Y. Mar	emar@fbm.com, calendar@fbm.com, mclaros@fbm.com
3 Harold H. Davis , Jr	harold.davis@klgates.com, cathy.williams@klgates.com
4 Jas S Dhillon	jas.dhillon@klgates.com, cathy.williams@klgates.com, james.boston@klgates.com
5 Jeffrey M. Fisher	jfisher@fbm.com, calendar@fbm.com, renterig@fbm.com, wpemail@fbm.com
6 Jeffrey Michael Ratinoff	jeffrey.ratinoff@klgates.com, jennifer.johnson@klgates.com, jennifer.smith@klgates.com
7 John L. Cooper	jcooper@fbm.com, brestivo@fbm.com, calendar@fbm.com
8 Kyle Dakai Chen	kyle.chen@cooley.com, jmcintosh@cooley.com, lfass@cooley.com
9 Mark R. Weinstein	mweinstein@cooley.com, lfass@cooley.com, mkenny@cooley.com
10 Nan E. Joesten	njoesten@fbm.com, calendar@fbm.com, llaflamme@fbm.com
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13 Stephanie Powers Skaff	sskaff@fbm.com, bwestburg@fbm.com, calendar@fbm.com
14 Timothy Paar Walker	timothy.walker@klgates.com, carol.ridgeway@klgates.com, perry.brooks@klgates.com
15 William Sloan Coats , III	william.coats@kayescholer.com, ervin.upton@kayescholer.com

16 **Counsel are responsible for distributing copies of this document to co-counsel who have not**
17 **registered for e-filing under the court's CM/ECF program.**

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TECHNOLOGY PROPERTIES LIMITED
LLC, et al.,

Plaintiffs,

v.

ZTE CORPORATION and ZTE (USA) INC.,

Defendants.

Case No. 3:12-cv-03876-VC (PSG)

TECHNOLOGY PROPERTIES LIMITED
LLC, et al.,

Plaintiffs,

v.

SAMSUNG ELECTRONICS CO., LTD.
and SAMSUNG ELECTRONICS
AMERICA, INC.,

Defendants.

Case No. 3:12-cv-03877-VC (PSG)

TECHNOLOGY PROPERTIES LIMITED
LLC, et al.,

Plaintiffs,

v.

LG ELECTRONICS, INC. and LG
ELECTRONICS U.S.A., INC.,

Defendants.

Case No. 3:12-cv-03880-VC (PSG)

TECHNOLOGY PROPERTIES LIMITED
LLC, et al.,

Plaintiffs,

v.

NINTENDO CO., LTD. and NINTENDO OF
AMERICA, INC.,

Defendants.

Case No. 3:12-cv-03881-VC (PSG)

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Before the Court is Plaintiffs’ Motion to Limit Defendants’ Subpoenas to Third Party Charles Moore or Alternatively for a Protective Order. Having considered Plaintiffs’ Motion, the Court finds that it is well taken and should be GRANTED, and as such, hereby enters the following order:

1. Defendants’ subpoena for documents to Moore is limited to the extent that it seeks privileged information or confidential information of Plaintiffs, including information protected by a common interest privilege held jointly by Plaintiffs – Moore shall not produce documents that contain privileged information belonging to Plaintiffs;
2. Defendants’ subpoena for the deposition testimony of Moore is limited to the extent that it seeks privileged information or confidential information of Plaintiffs – Moore shall not testify such that he would reveal privileged information belonging to Plaintiffs.

In order to provide Plaintiffs the opportunity to prevent the disclosure of its privileged information, Moore shall produce documents directly to Plaintiffs. Plaintiffs will review Moore’s production within 10 days of receipt, log and withhold any materials it determines are privileged, and subsequently produce the remaining documents to Defendants.

SO ORDERED.

Dated: _____

Hon. Paul S. Grewal
United States Magistrate Judge