

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

CERTAIN ELECTRONIC DEVICES
WITH COMMUNICATION
CAPABILITIES, COMPONENTS
THEREOF, AND RELATED SOFTWARE

Inv. No. 337-TA-808

**ORDER NO. 10: DENYING NON-PARTY OPENWAVE'S MOTION TO QUASH OR
LIMIT SUBPOENA *DUCEUS TECUM* AND SUBPOENA *AD
TESTIFICANDUM* OR, IN THE ALTERNATIVE, TO IMPOSE
COSTS UPON THE REQUESTING PARTY**

(March 9, 2012)

On November 28, 2011, Non-Party Openwave Systems Inc. ("Openwave") filed a motion to quash or limit the subpoena *duces tecum* and subpoena *ad testificandum* served by Respondent Apple Inc. ("Apple"), or to impose costs upon Apple. (Motion Docket No. 808-008.) On December 8, 2011, Apple filed an opposition to the motion. On December 8, 2011, the Commission Investigative Staff ("Staff") filed a response in opposition to the motion.

Openwave argues that Apple's subpoena *duces tecum* and subpoena *ad testificandum* impose an unreasonable burden upon Openwave, a non-party with no interest in the investigation. Additionally, Openwave argues that Apple disregarded Ground Rule 2.2, which requires a subpoena accommodate the time for filing a motion to quash, at a minimum ten days after receipt of the subpoena. Openwave argues that the subpoenas fail to establish the relevance of the information requested. Finally, Openwave argues that the costs for producing the documents and attending the sought after deposition should be shifted to Apple, because the request is unduly burdensome and complex.

Openwave argues that Apples's subpoena *duces tecum* and subpoena *ad testificandum* should be quashed because they impose an unreasonable burden on Openwave. Specifically, Openwave argues that they are a non-interested non-party to this investigation. Openwave relies on Apple's mention of "Ericson, Inc." in their subpoena application, instead of Openwave, to demonstrate they are not an interested party. Additionally, Openwave argues that Apple fails to meet its burden to show the reasonableness of the subpoena's scope. In defining the subpoena's reasonable scope, Openwave argues that Apple fails state the specific defenses it plans on asserting and how Openwave's evidence will support those defenses. Finally, Openwave argues that the subpoena requests impose an undue hardship on Openwave. Specifically, Openwave argues that the documents requested by Apple are historical in nature and require Openwave access inactive media. Openwave argues that, if the subpoenas are not quashed, then Apple should pay the production costs. Openwave also argues that Apple's subpoena *ad testificandum* is unduly burdensome, because Openwave must travel to Apple's counsel's office in Washington, D.C. Additionally, Openwave argues that the subpoena *ad testificandum* is excessively complex, because it requires them to conduct claim construction and explain the inner workings of long discontinued products.

Apple contends that Openwave fails to meet its evidentiary burden to quash the subpoenas. First, Apple argues that Openwave failed to comply with its obligations under Ground Rule 2.2 to make a reasonable, good-faith effort to resolve any issues related to the subpoenas before filing its motion. Apple argues that Openwave's motion should be denied on these grounds alone. Second, Apple argues that Openwave fails to meet its burden to prove the subpoenas are overbroad and unduly burdensome. Instead, Apple argues that Openwave relies solely on attorney argument without providing any evidence of a potential burden on Openwave.

Staff contends that Openwave's motion should be denied, because Openwave failed to comply with Ground Rule 2.2. Staff argues that Openwave's motion does not include certification that it has made a reasonable, good-faith effort to contact and resolve the matter with the other parties. Staff contends that Openwave's motion should be denied for this reason alone. However, Staff also argues that Openwave's motion should be denied on the merits, because Openwave fails to meet its heavy burden to support a motion to quash. Specifically, Staff argues that the information requested in the subpoenas is relevant, because Openwave's predecessor was the original assignee of three of the patents at issue in the investigation. Additionally, Staff argues that the requested discovery is relevant to the investigation as potential prior art to the asserted patents. Staff contends that it is clear Apple needs the discovery related to Openwave's patents at issue in the investigation. While Staff agrees with Openwave that the subpoena *duces tecum* did not allow sufficient time to respond, Staff does not find this limited time for reply sufficient evidence to quash the subpoena. Additionally, Staff argues that Openwave fails to provide sufficient evidence to show the documents requested are unduly burdensome or that travelling to Washington, D.C. would be overly burdensome for the witness. While Staff agrees with Openwave that the subpoenas could require Openwave to conduct claim construction on the patents in the investigation, Staff argues that limiting the subpoena's scope to the patent, not the claims, would not be overly burdensome to Openwave.

Having reviewed the parties' motion papers in support and in opposition to the present motion, I find for the reasons discussed below that Openwave's motion to quash Apple's subpoena *duces tecum* and subpoena *ad testificandum* should be DENIED, along with Openwave's request to impose costs on Apple. However, I find for the reasons discussed below that Openwave's request to limit the subpoenas' scope should be GRANTED.

“All motions shall include a certification that the moving party has made a reasonable, good-faith effort to contact and resolve the matter with the other parties at least two (2) business days before filing the motion, and shall state, if known, the position of the other parties regarding the motion.” (Order No. 2 at ¶ 2.2 (October 4, 2011).) A motion to quash a subpoena can be denied solely for failing to include the required certification. *See Certain Light-Emitting Diodes and Products Containing Same*, Inv. 337-TA-798, Order No. 13 (November 2, 2011).

The Commission weighs three factors when considering whether to quash a subpoena: (i) the relevance of the discovery sought; (ii) the need of the requesting party for the information; and (iii) the potential hardship to the party responding to the subpoena. *Certain Optical Disk Controller Chips and Chipsets and Products Containing Same, Including DVD Players & PC Optical Storage Devices*, Inv. No. 337-TA-506, Order No. 38 (February 7, 2005). The party moving to quash a subpoena bears the burden to support its motion. *See Certain Hardware Logic Emulation Systems and Components Thereof*, Inv. No. 337-TA-383, Order No. 42 (September 6, 1996).

While a responding party ordinarily bears the cost of responding to a subpoena, under certain circumstances some or all of the costs of responding may be shifted to the requesting party. *See Certain Optical Disk Controller Chips and Chipsets and Products Containing Same, Including DVD Players and PC Optical Storage Devices*, Inv. No. 337-TA-506, Order No. 16 (September 17, 2004). A balancing approach is used to determine whether to shift costs. The approach considers the following factors: (1) the specificity of the discovery requests; (2) the likelihood of discovering critical information; (3) the availability of such information from other sources; (4) the purposes for which the responding party maintains the requested data; (5) the relative benefit to the parties of obtaining the information; (6) the total cost associated with

production; (7) the relative ability of each party to control costs and its incentive to do so; and (8) the resources available to each party. *Id.* (citing *Rowe Entertainment, Inc. v. The William Morris Agency, Inc.*, 205 F.R.D. 421, 429 (S.D.N.Y. 2002)).

Openwave's motion to quash fails to comply with Ground Rule 2.2. Openwave does not include a certification, or any evidence, that it made a reasonable, good-faith effort to contact and resolve the matter with the other parties before filing its present motion. Openwave's motion to quash the subpoenas *duces tecum* and *ad testificandum* is DENIED.

On the merits, I would also DENY Openwave's motion to quash.

First, Openwave fails to show the discovery being sought by Apple is not relevant to the investigation. Openwave is the original assignee of three patents at issue in this investigation: U.S. Patent No. 6,708,214 ("214"); U.S. Patent No. 6,473,006 ("006"); and U.S. Patent No. 7,020,849 ("849"). Therefore, the evidence being sought by these subpoenas is certainly relevant to the investigation, including, for example, issues of conception, reduction to practice and ownership of the patents-at-issue. Additionally, the evidence sought by Apple may be relevant as potential prior art to the patents-at-issue. Openwave fails to provide any evidence or argument to the contrary.

Second, Openwave fails to prove that Apple lacks a need for the discovery being sought. Openwave asserts Apple has failed to meet its burden to show its need for the discovery, but it is Openwave, as the moving party, that must adduce evidence in support of its motion. Openwave provides no such evidence. Apple, on the other hand, has made a showing that it needs the discovery from Openwave. In particular, Apple has shown that as the original assignee of three of the patents-at-issue in this investigation, Openwave is likely to have information specifically relevant to the patent-at-issue in the investigation.

Finally, Openwave argues that the subpoenas are unduly burdensome, but fails to provide adequate support for its argument. Specifically, Openwave asserts that the subpoena *deuces tecum* requires production of old documents that are inaccessible, but does not provide any evidence that these documents are, in fact, inaccessible or that the discovery request is unduly burdensome. Instead, Openwave merely relies on the age of the documents. Additionally, Openwave argues that the subpoena *ad testificandum* is unduly burdensome because it requires Openwave to travel to Washington, D.C. from California, but fails to show that, in fact, a designated witness will have to travel from California to Washington, D.C. or that this travel would be unduly burdensome. Notably, Openwave is a Delaware company that received the subpoena in Wilmington, Delaware. Moreover, I note the subpoena allows for the deposition to be held “at such a time and place agreed upon.” (Staff Resp., Ex. 1.)

With regard to Openwave’s request for costs, I find that Openwave fails to prove that the costs of its production should be shifted to Apple. Openwave argues that the subpoenas require Openwave to “delve in to inactive media.” (Mot. Mem. at 7-8.) However, Openwave fails to provide any evidence that the documents are excessively difficult or burdensome to obtain. On the other hand, I find Apple’s requests reasonably specific and likely to lead to the discovery of information relevant to this investigation. Thus, Openwave’s request to shift the cost of production to Apple is hereby DENIED.

I have held herein that Openwave’s motion to quash should be denied on procedural grounds for failing to comply with the Ground Rules in this investigation. However, I have decided in the exercise of my discretion, as discussed in more detail below, to GRANT Openwave’s request to limit the scope of the subpoenas.

Openwave argues that the subpoenas are unduly burdensome because they require Openwave to perform claim construction. In particular, the subpoena *deuces tecum* includes Document Request Nos. 33-44 that request documents relating to the subject matter “described or claimed in” the ‘006, ‘214 and ‘849 patents. Similarly, the subpoena *ad testificandum* includes Deposition Topics 11-15 that requests information regarding “the subject matter described or claimed in” the ‘006, ‘214 and ‘849 patents. To resolve any confusion caused by the wording of Document Request Nos. 33-44 and Deposition Topics 11-15 in the subpoena *ad testificandum*, I hereby limit Document Request Nos. 33-44 and Deposition Topics 11-15 to “the subject matter of the” ‘006, ‘214, and ‘849 patents instead of “the subject matter described or claimed in” the ‘006, ‘214 and ‘849 patents. To the extent any lingering confusion exists, I strongly encourage Apple and Openwave to work together to reach a resolution.

SO ORDERED.



Thomas B. Pender
Administrative Law Judge

**IN THE MATTER OF CERTAIN ELECTRONIC DEVICES WITH 337-TA-808
COMMUNICATION CAPABILITIES, COMPONENTS THEREOF AND RELATED
SOFTWARE**

CERTIFICATE OF SERVICE

I, James R. Holbein, hereby certify that the attached **ORDER NO. 10** has been served upon, **R. Whitney Winston, Esq.**, Commission Investigative Attorney, and the following parties via first class mail and air mail where necessary on MAR - 9 2012

James R. Holbein, Secretary
U.S. International Trade Commission
500 E Street, S.W., Room 112A
Washington, DC 20436

FOR COMPLAINANT HTC CORP.:

Thomas L. Jarvis, Esq.
**FINNEGAN, HENDERSON, FARABOW
GARRETT & DUNNER LLP**
901 New York Avenue, NW
Washington, DC 20001

() Via Hand Delivery
() Via Overnight Mail
() Via First Class Mail
() Other: _____

FOR RESPONDENT APPLE, INC.

Michael J. McKeon, Esq.
FISH & RICHARDSON P.C.
1425 K Street, NW, 11TH Floor
Washington, DC 20005

() Via Hand Delivery
() Via Overnight Mail
() Via First Class Mail
() Other: _____

PUBLIC MAILING LIST

Heather Hall
LEXIS - NEXIS
9443 Springboro Pike
Miamisburg, OH 45342

() Via Hand Delivery
() Via Overnight Mail
() Via First Class Mail
() Other: _____

Kenneth Clair
THOMSON WEST
1100 - 13th Street NW
Suite 200
Washington, DC 20005

() Via Hand Delivery
() Via Overnight Mail
() Via First Class Mail
() Other: _____