

1 WILLIAM S. BOGGS (Bar No. 53013)  
 BRIAN A. FOSTER (Bar No. 110413)  
 2 TIMOTHY BLACKFORD (Bar No. 190900)  
 CHRISTOPHER J. BEAL (Bar No. 216579)  
 3 DLA PIPER US LLP  
 401 B Street, Suite 1700  
 4 San Diego, CA 92101-4297  
 Tel: (619) 699-2700  
 5 Fax: (619) 699-2701

6 EVAN R. CHESLER (admitted *pro hac vice*)  
 ELIZABETH L. GRAYER (admitted *pro hac vice*)  
 7 CRAVATH, SWAINE & MOORE LLP  
 825 Worldwide Plaza  
 8 New York, NY 10019  
 Tel: (212) 474-1000  
 9 Fax: (212) 474-3700

10 Attorneys for Plaintiff and Counterdefendant  
 QUALCOMM INCORPORATED

11  
 12 UNITED STATES DISTRICT COURT  
 13 SOUTHERN DISTRICT OF CALIFORNIA

14 QUALCOMM INCORPORATED,

15 Plaintiff,

16 v.

17 BROADCOM CORPORATION,

18 Defendant.

19 BROADCOM CORPORATION,

20 Counterclaimant,

21 v.

22 QUALCOMM INCORPORATED,

23 Counterdefendant.  
 24

05 CV 1958 B (BLM)

**MEMORANDUM OF POINTS AND  
 AUTHORITIES IN SUPPORT OF  
 QUALCOMM INCORPORATED'S  
 MOTION FOR PROTECTIVE ORDER**

Date: June 20, 2008  
 Time: 1:00 p.m.  
 Ctrm:  
 Judge: Hon. Barbara L. Major

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**TABLE OF CONTENTS**

	<b><u>Page</u></b>
I. PRELIMINARY STATEMENT .....	1
II. FACTUAL BACKGROUND.....	2
III. ARGUMENT.....	10
A. The Responding Attorneys’ and Broadcom’s Requests Seek Information That Is Not Relevant and Beyond the Permitted Scope of Disclosure .....	11
B. Disclosure Under the Self-Defense Exception Does Not Constitute a Waiver.....	12
IV. CONCLUSION.....	14

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**TABLE OF AUTHORITIES**

**Page**

**CASES**

*First Fed. Sav. & Loan Ass'n of Pittsburgh v. Oppenheim, Appel, Dixon & Co.,*  
110 F.R.D. 557 (S.D.N.Y. 1986) .....13

*In re Nat'l Mortgage Equity Corp. Mortgage Pool Certificates Sec. Litig.,*  
120 F.R.D. 687 (C.D. Cal. 1988).....11, 12, 13

*Phillips ex rel. Estates of Byrd v. General Motors Corp.,*  
307 F.3d 1206 (9th Cir. 2002) .....14

**STATUTES**

Fed. R. Civ. Proc. 26(c) .....14

Fed. R.Civ. Proc 34.....6

1 **I. PRELIMINARY STATEMENT**

2 Because this Court's sanctions order is final as to Qualcomm Incorporated ("Qualcomm"),  
3 the only issue that remains in these proceedings is whether sanctions should be imposed against  
4 Adam Bier, Lee Patch, Stanley Young, James Batchelder, Christian Mammen and Kevin Leung  
5 (collectively, the "Responding Attorneys") for records discovery failures during the course of the  
6 case. See Judge Brewster's Order Remanding in Part Order of Magistrate Court re Motion for  
7 Sanctions Dated 1/07/08 ("Remand Order"). For this reason, Qualcomm believes the Remand  
8 Order was intended to narrowly limit the scope of any privileged material disclosed and used in  
9 further proceedings relating to sanctions against the Responding Attorneys.

10 In applying the self-defense exception to the attorney-client privilege to this case, Judge  
11 Brewster ruled that the exception applies to a limited set of communications. Those  
12 communications concern records discovery relating to the JVT and the standard-setting process  
13 for video compression technology. Qualcomm will produce such documents pursuant to the self-  
14 defense exception and without waiver of its privilege. However, Broadcom Corporation  
15 ("Broadcom") and the Responding Attorneys seek production of privileged documents well  
16 beyond the scope of the exception found by Judge Brewster and well beyond what is relevant to  
17 these remand proceedings. Further, at least Broadcom (which is suing Qualcomm elsewhere on  
18 issues relating to the JVT and standard setting) contends that any production of Qualcomm's  
19 privileged material would be a waiver of privilege in the produced documents and perhaps be a  
20 basis for a broader subject matter waiver.

21 Under these circumstances, Qualcomm seeks an order (1) limiting the production of  
22 privileged material in these remand proceedings to documents concerning records discovery  
23 relating to the JVT and the standards-setting process for video compression technology, (2)  
24 clarifying that such production neither waives the privilege in these documents nor establishes a  
25 basis for a later claim of subject matter privilege waiver, and (3) requiring that any disclosure of  
26 privileged material to the Court be done under seal or *in camera*.

27 ////

28 ////

1 **II. FACTUAL BACKGROUND**

2 On January 7, 2008, this Court entered an order sanctioning Qualcomm and the  
3 Responding Attorneys for certain discovery failures (the "Sanctions Order"). (Sanctions Order  
4 26-31.) As Judge Brewster noted, Qualcomm did not file objections to the Sanctions Order, and  
5 the Order is final as to Qualcomm. (Remand Order 2:6-7.) The Responding Attorneys filed  
6 objections to the Sanctions Order, and on March 5, 2008, Judge Brewster issued a Remand Order  
7 remanding the Sanctions Order with regard to the six Responding Attorneys.

8 The Remand Order allowed for certain limited proceedings before this Court regarding the  
9 Responding Attorneys' performance of discovery responsibilities. (*See, e.g.*, Remand Order  
10 5:21-26.) The Order defined the materials to which the self-defense exception to the attorney-  
11 client privilege applied as "communications and conduct relevant to the topic area of *records*  
12 (*electronic or other*) *discovery* pertaining to JVT and its parents, its ad-hoc committees, and any  
13 other topic regarding the standards-setting process for video compression technology." (*Id.* 6:1-  
14 4) (emphasis added).)

15 On April 11, 2008, the Responding Attorneys and Broadcom served document requests on  
16 Qualcomm as part of these remand proceedings. (Blackford Decl.<sup>1</sup> Ex. A - D, G.) Responding  
17 Attorney Stanley Young ("Young") also served document requests on Responding Attorney Lee  
18 Patch ("Young's Requests to Patch") and a subpoena on the law firm Day Casebeer Madrid &  
19 Batchelder ("Young's Subpoena of Day Casebeer"). (*Id.* Ex. E, F.) Broadcom also served three  
20 deposition notices on Qualcomm at that time. (*Id.* Ex. H - J.)

21 On April 28, 2008, Qualcomm served objections to the Responding Attorneys' and  
22 Broadcom's discovery requests, as well as to Young's Requests to Patch and Young's Subpoena  
23 of Day Casebeer. (*Id.* Ex. K - T.) After meet-and-confer discussions with the parties, Qualcomm  
24 served amended objections to Young's Subpoena to Day Casebeer on May 1, 2008 (*Id.* Ex. P),  
25 and to Broadcom's Requests (*Id.* Ex. Q) and deposition notices (*Id.* Ex. R - T) on May 5, 2008.

26 //

27 \_\_\_\_\_  
28 <sup>1</sup> References to "Blackford Decl. Ex. \_\_\_" refer to the exhibits attached to the Declaration of  
Timothy S. Blackford in Support of Qualcomm Incorporated's Motion for Protective Order.

1 In addition, Qualcomm has since written letters to the Responding Attorneys resolving certain  
2 discovery issues during the meet and confer process. (*Id.* Ex. U through W.)<sup>2</sup>

3 **Batchelder, Mammen and Leung's Requests**

4 Responding Attorneys Batchelder, Mammen and Leung's document requests to  
5 Qualcomm contain 19 specific requests for documents. (*See* Responding Attorneys' Req. for  
6 Prod. to Docs. to Qualcomm Inc. ("BML's Requests"), Blackford Decl. Ex. A.) These Requests  
7 seek production of, among other things, documents such as:

- 8 • "All notes and memoranda written by Qualcomm employees concerning  
9 interviews of any of the following individuals, that took place at any time from  
10 October 1, 2005 through August 6, 2007, and that related to the litigation: James  
11 Determan, Harinath Garudadri, Christine Irvine, Scott Ludwin, Roger Martin,  
12 Sandip Minhas, Viji Raveendran, Yuriy Reznik, Ammon Silberger, Edward  
13 Tiedemann, Kent Walker, and Jay Yun." (BML's Request No. 1.)
- 14 • "All communications . . . that were written at any time between July 1, 2005 and  
15 January 31, 2007, and that evidence Qualcomm's efforts to determine whether and  
16 to what extent Qualcomm participated in the JVT." (BML's Request No. 4.)
- 17 • "All communications . . . that evidence efforts by Qualcomm or its counsel to  
18 identify or prepare the appropriate individuals who would testify in the litigation,  
19 pursuant to Rule 30(b)(6), concerning Qualcomm's participation in the JVT and  
20 other standards-setting organizations." (BML's Request No. 10.)
- 21 • "All notes and memoranda written by Qualcomm personnel regarding meetings or  
22 other communications with attorneys who represented Qualcomm in the litigation,  
23 that took place after the trial of the litigation concluded, and that concerned any of  
24 the discovery issues that arose in the litigation." (BML's Request No. 11.)

25 <sup>2</sup> In the past few weeks, Qualcomm has engaged in many meet and confer discussions with the  
26 Responding Attorneys to resolve discovery issues and conflicts and narrow differences in  
27 positions. While Qualcomm and the Responding Attorneys have not resolved all issues,  
28 Qualcomm will continue to work to resolve differences and will inform the Court if resolution of  
any outstanding issues is reached. As to Responding Attorney Bier's document requests, there  
are no longer any issues because Qualcomm and Bier resolved them during the meet and confer  
process. Therefore, his specific requests are not discussed here.

- 1 • “All communications between any Qualcomm personnel and Jordan Isailovic  
2 relating to the JVT.”<sup>3</sup> (BML’s Request No. 13.)
- 3 • “All communications written by any Qualcomm personnel prior to August 6, 2007,  
4 that refer to Jordan Isailovic by first name, last name, full name, nickname, or any  
5 combination thereof.” (BML’s Request No.15.)
- 6 • “All documents concerning Qualcomm’s evaluation and modification of  
7 procedures, policies, or preferred practices for searching for documents and  
8 information in connection with litigation matters that took place after the trial of  
9 the litigation . . .” (BML’s Request No. 19.)

10 The requests as written are not limited to the topic area of records discovery pertaining to  
11 the JVT and the standard-setting process for video compression technology, and have little or no  
12 relevance to what these attorneys knew and whether they took appropriate steps based upon what  
13 they knew—the issues to be addressed in this extended proceeding. Further, while the time frame  
14 of documents sought varies with each request, some requests call for the production of documents  
15 before commencement of the action on October 14, 2005, and after conclusion of the trial on  
16 waiver issues on February 9, 2007. For example, the requests seek documents such as: privileged  
17 interview memoranda of witnesses regarding the merits of the underlying claims in the case  
18 unrelated to records discovery efforts; substantive communications with Dr. Isailovic; and  
19 privileged post-trial analyses of the discovery failures that occurred during the litigation. None of  
20 these materials are related to the issue in the proceedings and are not necessary for the attorneys’  
21 defense.

22 In response, Qualcomm objected to BML’s Requests to the extent they sought production  
23 of documents outside the relevant time period and which do not relate to records discovery  
24 pertaining to JVT and the standard-setting process for video compression technology. But in  
25 response to BML’s Requests Nos. 2-10, 12, 15, and 17, Qualcomm agreed to produce documents  
26 that fall within the scope of the proceedings and the Remand Order, subject to entry of an order

27 <sup>3</sup> The Court identified Jordan Isailovic as an outside consultant hired by Qualcomm to attend  
28 JVT meetings on Qualcomm’s behalf as early as January 2002. *See* Order on Remedy for  
Finding of Waiver 10:2-4, Aug. 6, 2007.

1 protecting Qualcomm's privilege. (*See* Qualcomm Inc.'s Resp. to Responding Attorneys  
2 Batchelder, Mammen and Leung's Req. for the Prod. of Docs. ("Qualcomm's Responses to  
3 BML"), Blackford Decl. Ex. K.)

4 **Responding Attorney Patch's Requests**

5 Responding Attorney Patch sought two categories of documents from Qualcomm.  
6 (Responding Attorney Lee Patch's Reqs. for Prod. of Docs. to Qualcomm Inc. ("Patch's  
7 Requests"), Blackford Decl. Ex. C.) Patch seeks production of:

- 8 • "All notes, memoranda and communications in the possession of Qualcomm or its  
9 counsel by, from, to, copied to, or about Scott Ludwin, Chris Irvine, Viji  
10 Raveendran, or any other Qualcomm declarant or witness in the Order to Show  
11 Cause proceeding, relating to participation in any video compression standards  
12 organization by Qualcomm, generated from the date the litigation was filed to the  
13 present." (Patch's Req. No. 1.)
- 14 • "All notes, memoranda and communications in the possession of Qualcomm or its  
15 counsel by, from, to, copied to, or about Scott Ludwin, Chris Irvine, Viji  
16 Raveendran, or any other Qualcomm declarant or witness in the Order to Show  
17 Cause proceeding, relating to the declarant's or witness's involvement in the  
18 litigation, generated from the date the litigation was filed to the present." (Patch's  
19 Req. No. 2.)

20 These requests specifically seek documents up to the present day<sup>4</sup>, and are not limited to  
21 documents relating to records discovery pertaining to JVT and the standard-setting process for  
22 video compression technology. These requests seek, for example, documents such as post-trial  
23 communications by counsel that reference any of the declarants or witnesses in the Order to Show  
24 cause proceeding, regardless of whether such documents relate to records discovery. For these  
25 reasons, Qualcomm objected to Patch's Requests to the extent they call for the production of

26 //

27 <sup>4</sup> During meet-and-confer discussions, counsel for Broadcom and Responding Attorney Patch  
28 indicated that they did not seek production of privileged communications involving DLA Piper  
US LLP or Cravath, Swaine & Moore LLP.



1 documents not within the scope of the proceedings and the Remand Order. (Qualcomm Inc.'s  
2 Resp. to Responding Attorney Lee Patch's Req. for the Produc. of Docs., Blackford Decl. Ex. M.)

3 **Responding Attorney Young's Requests to Qualcomm**

4 Responding Attorney Young's document requests to Qualcomm contain four requests.  
5 (Req. for Prod. of Docs. Pursuant to FRCP 34 ("Young's Requests to Qualcomm"), Blackford  
6 Decl. Ex. D.) Young seeks production of documents such as:

- 7 • "All documents relating to the assignment and/or allocation of tasks and  
8 responsibilities as between Day Casebeer and Heller Ehrman in the 1958 case."  
9 (Young's Req. to Qualcomm No. 3.)
- 10 • "All documents relating to the discovery of documents located on the computer of  
11 Viji Raveendran after the trial of the 1958 case including the identity of the  
12 documents located, the identity of the persons locating such documents, the search  
13 terms utilized and the search methodology employed." (Young's Req. to  
14 Qualcomm No. 4.)

15 These requests either contain no limitation as to time period or specifically seek post-trial  
16 documents. Further, they are not limited in subject matter to records discovery pertaining to JVT  
17 and the standard-setting process for video compression technology. For these reasons,  
18 Qualcomm objected to Young's Requests to Qualcomm to the extent they call for the production  
19 of documents not within the scope of the proceedings and the Remand Order. (Qualcomm Inc.'s  
20 Resp. to Stanley Young's Req. for the Prod. of Docs., Blackford Decl. Ex. N.)

21 **Responding Attorney Young's Requests to Patch and Subpoena to Day Casebeer**

22 Young also submitted document requests with four specific requests to Responding  
23 Attorney Patch. (Young's Requests to Patch, Blackford Decl. Ex. E.) These requests are  
24 duplicated in Young's Subpoena to Day Casebeer (Young's Subpoena to Day Casebeer,  
25 Blackford Decl. Ex. F.) Young seeks documents such as:

- 26 • "All documents relating to communications between Day Casebeer and Heller  
27 Ehrman concerning the 1958 case," without limitation. (Young's Request to Patch  
28 No. 1.) Young specifically seeks documents such as those relating to "[t]he

1 preparation and service of the Expert Report of Ian Richardson in rebuttal to the  
2 Reader Report,” and “[t]he preparation and filing of the Motion for Summary  
3 Adjudication filed on November 6, 2006, and argued before Judge Brewster on  
4 December 5, 2006 including all opposition and reply briefs.” (Young’s Request to  
5 Patch No.1-B and 1-F.)

- 6 • “All documents relating to Heller Ehrman and concerning the 1958 case.”  
7 (Young’s Request to Patch No. 4.) This request similarly seeks all documents  
8 related to Heller Ehrman’s involvement in the case, with no limitation as to subject  
9 matter or time period.

10 Young’s discovery requests are not limited as to time period or subject matter, and  
11 specifically seek documents having no relation to records discovery pertaining to JVT or the  
12 standard-setting process for video compression technology. Qualcomm objected to both Young’s  
13 Requests to Patch and Young’s Subpoena to Day Casebeer to the extent they sought any  
14 Qualcomm privileged information beyond the scope of the proceedings and the Remand Order.  
15 (See Blackford Decl. Ex. O and P.)

#### 16 Broadcom’s Requests

17 Broadcom’s Requests to Qualcomm contained nine specific requests. (Broadcom’s Third  
18 Set of Requests for the Production of Documents and Things (Nos. 116-125) (“Broadcom’s  
19 Requests”), Blackford Decl. Ex. G.) Broadcom also served a Rule 30(b)(6) deposition notice on  
20 Qualcomm mirroring its document requests. (Def. Broadcom Corp.’s Notice of Rule 30(B)(6)  
21 Dep. to Pl. Qualcomm Inc., Blackford Decl. Ex. H.)<sup>5</sup> Broadcom seeks documents such as:

- 22 • “All documents relating to preparation of Qualcomm’s interrogatory responses and  
23 responses to request for production, and objections thereto, concerning the H.264  
24 standard and Qualcomm’s participation in the JVT, ISO, IEC, and ITU-T . . . .”  
25 (Broadcom’s Request No. 118.)

26 <sup>5</sup> Broadcom also served deposition notices for the depositions of Chris Irvine and Viji  
27 Raveendran. (Blackford Decl. Ex. I and J.) Qualcomm believes that it would be inefficient and  
28 wasteful for these individuals to be deposed until after document production is complete and  
issues relating to scope and privilege have been resolved, as stated in its amended objections to  
those notices. (Blackford Decl. Ex. S and T.)

- 1 • “All documents relating to identification and preparation of Qualcomm’s Rule
- 2 30(b)(6) witnesses concerning the H.264 standard and Qualcomm’s participation
- 3 in the JVT, ISO, IEC, and ITU-T . . .” (Broadcom’s Request No. 119.)
- 4 • “All documents relating to identification and preparation of Qualcomm’s
- 5 deposition and trial witnesses concerning the H.264 standard and Qualcomm’s
- 6 participation in the JVT, ISO, IEC, and ITU-T . . .” (Broadcom’s Request No.
- 7 120.)

8 None of Broadcom’s Requests are limited as to time period. Many of the requests also do  
 9 not relate to records discovery pertaining to JVT and the standard-setting process for video  
 10 compression technology. For example, the requests seek documents such as attorney notes in  
 11 preparing Qualcomm’s trial witnesses, or communications regarding the underlying merits of the  
 12 case as they relate to 30(b)(6) preparation.

13 Notably, Broadcom originally sought sanctions against Qualcomm, but not its individual  
 14 attorneys. (*See* Broadcom Corp.’s Resp. to Pleadings and Decls. of Qualcomm and Its Attorneys  
 15 in Resp. to Order to Show Cause 3:21-28.) Even during these remand proceedings, Broadcom  
 16 has reminded the Court that “Broadcom brought its sanctions motion against Qualcomm, not  
 17 against the outside attorneys” and reconfirmed that “we [Broadcom] really don’t have a position  
 18 in this . . .” (Tr. of Misc. Hr’g 19:1-3, 5-6, Mar. 20, 2008.)

19 Further, Broadcom has previously admitted that it seeks discovery in this action because  
 20 of other current litigations against Qualcomm.<sup>6</sup> Broadcom has sued Qualcomm in the United  
 21 States District Court for the District of New Jersey alleging violations of the Sherman Act, breach  
 22 of contract, tortious interference, promissory estoppel, fraud, and unfair business practices. Those  
 23 claims are based, in part, on allegations relating to Qualcomm’s conduct concerning the H.264  
 24 standard and in certain standard setting organizations including the JVT, ISO, IEC and ITU. (*See*  
 25 Second Am. Compl. (“New Jersey Complaint”) ¶¶ 170-246, 275-329, Broadcom Corp. v.

26 <sup>6</sup> In Broadcom’s opposition to Qualcomm’s motion regarding remand proceedings, it stated that  
 27 “as a result of its ongoing litigation with Qualcomm, Broadcom has a vested interest in fully  
 28 participating in the Remand Proceedings . . .” (Broadcom Corp.’s Opp’n to Qualcomm Inc.’s  
 Mem. of Points and Authorities in Supp. of Qualcomm Inc.’s Mot. Regarding Remand  
 Proceedings (“Broadcom Remand Opposition”) 1, 6-8.)

1 Qualcomm Inc., 3:05-CV-03350 (MLC) (the “New Jersey Action”) (Blackford Decl. Ex. X.))

2 For example, in that Complaint:

- 3 • Broadcom alleges that “Qualcomm’s failure to disclose its patents to the JVT, the  
4 ITU, and the ISO/IEC has allowed Qualcomm unfairly and fraudulently to obtain,  
5 or claim to have obtained, a monopoly in the aspects of the H.264 technology  
6 markets governed by each element of the standard that Qualcomm claims is  
7 covered by its patents.” (*Id.* ¶ 243.)
- 8 • Broadcom’s Fourth Claim for breach of contract in the New Jersey Complaint is  
9 based on an allegation that “Qualcomm entered into actual or implied contractual  
10 commitments with ETSI, the ITU, ATIS, ARIB, ISO/IEC, and the JVT, relating to  
11 the GSM, GPRS, EDGE, UMTS, and H.264 standards.” (*Id.* ¶ 290.)
- 12 • Broadcom’s Seventh Claim for fraud alleges that “Qualcomm intentionally failed  
13 to disclose its patents with ETSI, the ITU, ATIS, ARIB, ISO/IEC, and the JVT.  
14 (*Id.* ¶ 309.)
- 15 • Broadcom’s Eighth Claim alleges that “Qualcomm’s conduct in connection with  
16 ETSI, the ITU, ATIS, ARIB, ANSI, ISO/IEC, and the JVT . . . and its claim of  
17 ownership of intellectual property rights in the GSM, GPRS, EDGE, UMTS, and  
18 H.264 standards” constitutes an unlawful business practice. (*Id.* ¶ 320.)

19 Broadcom’s Requests mirror the claims Broadcom has raised in the New Jersey Action. It  
20 is clear that Broadcom’s goal is to use these proceedings as an adjunct discovery vehicle for its  
21 pending lawsuit in New Jersey.

22 Accordingly, Qualcomm objected to Broadcom’s Requests to the extent they seek  
23 documents outside the relevant time period which do not relate to the subject matter of these  
24 proceedings or records discovery pertaining to JVT or the standard-setting process for video  
25 compression technology. But Qualcomm agreed to produce documents—subject to entry of an  
26 order protecting its privilege—falling within the scope of the proceedings and the Remand Order.

27 ////

28 ////

1 (Qualcomm Inc.'s Am. Resp. to Broadcom Corp.'s Third Set of Reqs. for the Produc. of Docs.  
2 and Things (Nos. 116-125), Blackford Decl. Ex. Q.)<sup>7</sup>

3 **III. ARGUMENT**

4 The Responding Attorneys' and Broadcom's discovery requests seek privileged  
5 documents and information having no relation to the Responding Attorneys' performance of  
6 records discovery pertaining to the JVT and the standards-setting process for video compression  
7 technology. Thus, they are overbroad and seek privileged information (1) not relevant to the  
8 issue of these remand proceedings, and (2) beyond the scope of disclosure of privileged material  
9 provided by the Remand Order.

10 Qualcomm will suffer real and distinct harm if it is required to produce privileged material  
11 responsive to the Responding Attorneys' and Broadcom's requests without a scope limitation and  
12 entry of a protective order would cause real and distinct harm to Qualcomm. First, Qualcomm's  
13 privileged material would be made available to Broadcom, who otherwise would not be entitled  
14 to see such material. Second, to the extent the Responding Attorneys or Broadcom obtain such  
15 privileged material without a specific finding that such production is made pursuant to the self-  
16 defense exception, Broadcom may argue such production constitutes a waiver and seek to  
17 introduce such material in the New Jersey Action or other litigations. Finally, Qualcomm faces  
18 the additional threat that Broadcom will contend that any disclosure of privileged information  
19 made as part of the remand proceedings constitutes a broader subject matter waiver, and seek  
20 further production of additional privileged documents in the New Jersey Action or other  
21 litigations.

22 Any of these results would cause irreparable harm to Qualcomm and would be  
23 inconsistent with the District Court's finding that sanctions as to Qualcomm are final. Therefore,  
24 Qualcomm moves for a protective order (a proposed form of which is submitted concurrently)  
25 that limits the scope of disclosure of Qualcomm privileged information and the manner in which

26 \_\_\_\_\_  
27 <sup>7</sup> As the subject matters of Broadcom's 30(b)(6) deposition notice mirror Broadcom's Requests,  
28 Qualcomm also objected to producing any 30(b)(6) witness to testify on topics outside the  
appropriate scope of disclosure. In addition, Qualcomm has objected on the grounds that this  
30(b)(6) deposition is not appropriate in these proceedings.

1 it will be disclosed. Further, to the extent Young's Requests to Patch and Young's Subpoena of  
 2 Day Casebeer call for the production of Qualcomm privileged information, Qualcomm objects to  
 3 such production on the same grounds and requests that any protective order apply equally to such  
 4 production.

5 **A. The Responding Attorneys' and Broadcom's Requests Seek Information That**  
 6 **Is Not Relevant and Beyond the Permitted Scope of Disclosure**

7 Under the self-defense exception to the attorney-client privilege, disclosure of privileged  
 8 information must be limited to those materials that are "reasonably necessary" to "vindicate  
 9 innocence." *In re Nat'l Mortgage Equity Corp. Mortgage Pool Certificates Sec. Litig.*, 120  
 10 F.R.D. 687, 692 (C.D. Cal. 1988) (omitting internal citations.). Here, the Court has already  
 11 decided the appropriate scope of disclosure and use of attorney-client privileged material. The  
 12 Remand Order provided for a limited disclosure and use of "records (electronic or other)  
 13 discovery pertaining to JVT and its parents, its ad-hoc committees, and any other topic regarding  
 14 the standards-setting process for video compression technology." (Remand Order 6:1-4.)<sup>8</sup>

15 The production of responsive privileged material pursuant to the Remand Order should  
 16 therefore be limited to documents (1) concerning the subjects identified in the Remand Order—  
 17 *i.e.*, the selection of custodians and the collection of documents for review and production on the  
 18 subjects of JVT, its parents, its ad-hoc committees, and the standards-setting process for video  
 19 compression technology, and (2) created during the relevant time period—from the filing of  
 20 Qualcomm's complaint on October 14, 2005 through the end of trial on February 9, 2007.

21 Construing Judge Brewster's use of the term "records discovery" as relating to "the  
 22 selection of custodians and the collection of documents for review and production" encompasses  
 23 the entirety of records discovery and will provide greater focus and clarity to the parties regarding  
 24 what privileged materials may be appropriately sought here. Documents beyond the subject

25 <sup>8</sup> The Remand Order cannot sensibly be read as contemplating "any other topic regarding the  
 26 standards-setting process for video compression technology" as a separate broad topic area for  
 27 disclosure, exclusive of and in addition to the topic of "records (electronic or other) discovery."  
 28 This is made clear in the sentence by the singular form of "topic area" and the singular verb "is,"  
 which convey that only one "topic area . . . is not privileged information." Any other  
 interpretation would render the sentence grammatically incorrect and nonsensical. If the Remand  
 Order had intended for there to be two separate topic areas of disclosure, it would have said so.

1 matter of records discovery are not relevant to these proceedings and are outside the scope of  
2 permissible disclosure. Further, the only documents that would be relevant to the topic area of  
3 records discovery in this case would fall within the time period between the commencement of  
4 the action on October 14, 2005 and the conclusion of the trial on February 9, 2007. Documents  
5 outside this time period would not be relevant to the issue in the proceedings and similarly fall  
6 outside the scope of appropriate disclosure.

7 **B. Disclosure Under the Self-Defense Exception Does Not Constitute a Waiver**

8 Qualcomm also requests that the Court enter a protective order clarifying that disclosure  
9 of Qualcomm privileged information in these remand proceedings is made pursuant to the self-  
10 defense exception of the attorney-client privilege and the Remand Order, that such disclosure  
11 does not waive any privilege, and direct that no one can assert, in this action or elsewhere, that by  
12 reason of the production or testimony there has been any waiver of any privilege. Further, to  
13 protect against the waiver of any privileged information in these proceedings, Qualcomm also  
14 requests the protective order require (1) that any court filings disclosing privileged information be  
15 filed under seal, and (2) that any discussion or argument regarding the content of privileged  
16 information be conducted *in camera*.

17 Importantly, the Remand Order focuses on the self-defense exception to the attorney-  
18 client privilege and does not find a waiver to that privilege here. In invoking the self-defense  
19 exception, Judge Brewster went as far as he needed to address the Responding Attorneys' due  
20 process complaint. That is, to provide due process, it was not necessary for the Court to find a  
21 waiver, or to require or permit that the Responding Attorneys publicly disclose Qualcomm's  
22 privileged information. Instead, it is sufficient that the Responding Attorneys can use privileged  
23 material to defend themselves. Other courts have permitted disclosure of attorney-client  
24 privileged information under the self-defense exception without finding that the privilege has  
25 been waived. *See, e.g., Nat'l Mortgage*, 120 F.R.D. at 692. The Court may find that  
26 Qualcomm's privilege has not been waived and still allow for the limited disclosure of privileged  
27 material for the Responding Attorneys to conduct their defense. This will enable the Court to  
28 achieve its goal of allowing the Responding Attorneys to defend themselves, but not at the price

1 of needlessly compromising Qualcomm's privilege in ways that potentially reach beyond these  
2 proceedings.

3 To ensure that the self-defense exception is applied in as limited a manner as possible,  
4 other courts that have allowed for the disclosure of privileged material have reviewed the  
5 disclosed materials *in camera* and maintained them under seal, even after determining that the  
6 self-defense exception to privilege applies. *See id.* (Court "made an *in camera* review of the self  
7 defense material" and entered order that materials be maintained in confidence by counsel for  
8 interested parties); *First Fed. Sav. & Loan Ass'n of Pittsburgh v. Oppenheim, Appel, Dixon &*  
9 *Co.*, 110 F.R.D. 557, 568 (S.D.N.Y. 1986) (court directed disclosing party to submit materials for  
10 *in camera* review). Therefore, Qualcomm requests that its privileged information only be  
11 disclosed to the participants in the remand proceedings—the Responding Attorneys and their  
12 counsel, Broadcom and its counsel, Qualcomm, and the Court.<sup>9</sup> Further, any discussion or  
13 argument relating to the content of Qualcomm privileged information should occur *in camera*,  
14 and any filings that disclose or reflect any Qualcomm privileged information should be filed  
15 under seal.

16 Some of the Responding Attorneys have contended that because Qualcomm publicly filed  
17 the declarations that Judge Brewster found gave rise to the self-defense exception, the  
18 Responding Attorneys should similarly be allowed to respond publicly. This argument lacks  
19 logical force for at least three reasons. First, Qualcomm did not file its declarations under seal  
20 because they contained no privileged matter. Nor did they contain any other matter that the

21 //

22 \_\_\_\_\_  
23 <sup>9</sup> Qualcomm continues to believe that Broadcom is not a proper party to be propounding  
24 discovery in the remand proceedings. Broadcom has previously stated that its request for relief in  
25 connection with these issues was directed at Qualcomm and not at the individual attorneys. (*See*  
26 *Broadcom Corp.'s Resp. to Pl. and Decls. of Qualcomm and Its Attorneys in Resp. to Order to*  
27 *Show Cause 3:21-28; Tr. of Misc. Hr'g 19:1-3, 5-6, Mar. 20, 2008.*) Qualcomm has been  
28 sanctioned and these proceedings do not apply to it. (Remand Order 3:3-7.) Therefore,  
Broadcom should have no role here. Nevertheless, we understand that Judge Brewster has ruled  
that Broadcom is to participate, and this Court has stated its intentions to follow that directive.  
But, we respectfully submit that Broadcom is seeking, through its requested discovery, to expand  
its role—and its access to Qualcomm privileged material—well beyond the scope set forth in the  
Remand Order, and for the purpose of assisting Broadcom in other pending litigations against  
Qualcomm.



1 courts generally allow to be filed under seal. *See* Fed. R. Civ. Proc. 26(c); *see also Phillips ex rel.*  
2 *Estates of Byrd v. General Motors Corp.*, 307 F.3d 1206, 1212 (9th Cir. 2002) (citing examples).

3 Second, due process does not require that Qualcomm lose its attorney-client privilege  
4 through public disclosure of its privileged communications and information. This Court should  
5 go no further than what due process requires.

6 Further, should the Court conclude on the basis of the evidence that sanctions are not  
7 appropriate, the Court can then so order as a matter of public record and that would be sufficient  
8 public vindication. On the other hand, if the Responding Attorneys are allowed to make public  
9 otherwise privileged matter, but the Court then finds that the evidence does not exonerate them,  
10 then Qualcomm would have suffered irreparable harm to its privilege for no compelling reason.

11 Qualcomm believes that requiring any portion of the record containing or reflecting  
12 Qualcomm's privileged information to be reviewed *in camera* and kept under seal will still permit  
13 the Responding Attorneys to defend their conduct consistent with their due process rights.

14 Moreover, it will allow the Court to make all determinations necessary to the proceeding, while  
15 also preventing further harms and sanctions as to Qualcomm in this action and in other litigations.

#### 16 IV. CONCLUSION

17 For the foregoing reasons, Qualcomm respectfully requests that the Court issue an order  
18 (in the proposed form submitted concurrently) that:

19 1. Limits the disclosure of Qualcomm's privileged information to documents from  
20 the relevant time period of October 14, 2005 through February 9, 2007 concerning the selection  
21 of custodians and the collection of documents for review and production on the subjects of JVT,  
22 its parents, its ad-hoc committees, and the standards-setting process for video compression  
23 technology;

24 2. Limits the disclosure or sharing of any Qualcomm privileged information to the  
25 Court, the Responding Attorneys and their counsel, Broadcom and its counsel and to Qualcomm;

26 3. Establishes that Qualcomm's production of any privileged material or testimony  
27 on privileged subject matter is pursuant to the self-defense exception to the attorney-client  
28 privilege and the Remand Order, that such production or testimony will not waive any privilege,

1 and that no one can assert, in this action or elsewhere, that by reason of the production or  
2 testimony there has been any waiver of any privilege;

3 4. Requires that any court filings that disclose or reflect any privileged information  
4 will be filed under seal; and

5 Requires that any discussion or argument relating to the content of such privileged  
6 information may only occur *in camera*.

7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Dated: May 23, 2008

DLA PIPER US LLP

By /s/ William S. Boggs

Attorneys for Plaintiff and Counterdefendant  
QUALCOMM Incorporated  
william.boggs@dlapiper.com