

1 **NOTICE OF MOTION**

2 TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

3 PLEASE TAKE NOTICE THAT on June 20, 2008, at 9:00 a.m. or as soon thereafter as
4 this case may be heard, in the courtroom of the Honorable Ronald M. Whyte, United States
5 District Court, Northern District of California, located at 280 South 1st Street, San Jose,
6 California, non-party Cisco Systems, Inc. ("Cisco") hereby moves pursuant to Federal Rules of
7 Civil Procedure 45 to quash the deposition subpoena served by Illinois Computer Research
8 ("ICR") and Scott C. Harris ("Harris") on Richard Frenkel ("Frenkel"), an employee of Cisco, in
9 a case pending in federal court in Chicago (the "Chicago case") where Fish & Richardson
10 ("Fish") is the defendant and counter-plaintiff, and for a protective order.

11 Specifically, Cisco respectfully requests an Order that the subpoena be quashed in its
12 entirety. In the alternative, Cisco requests that a protective order be entered which provides that:
13 (i) the witness shall not be required to and will not produce any privileged material nor will he be
14 required to testify about any privileged materials or on any privileged matter; (ii) any deposition
15 testimony of third party Frenkel be limited to material issues in the Chicago case as enumerated
16 in Harris/ICR's Motion to Proceed – namely, Fish's communications with third party Frenkel, if
17 any, regarding Scott Harris; and (iii) that the deposition shall not be provided to, disclosed to, or
18 shared either directly or indirectly with any person related to the Arkansas or Texas litigation¹ and
19 that counsel in the Chicago case will take appropriate steps to protect its confidentiality thus
20 insuring that it will not be available to counsel in the Arkansas and Texas cases.

21 Cisco's motion is based upon this notice of motion, the following memorandum of points
22 and authorities; the accompanying declarations of William Friedman, Richard Frenkel, George L.
23 McWilliams and Charles L. Babcock; any reply filed in support of this motion; all other papers
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26 ¹ In these two cases, Frenkel and Cisco are defendants. *John Ward, Jr. v. Cisco Systems,*
27 *Inc. and Rick Frenkel*; Cause No. 08-4022 in the United States District Court, Western District of
28 Arkansas, Texarkana Division; and *Eric Albritton v. Cisco Systems, Inc. and Richard Frenkel*;
Cause No. 6:08-cv-89 in the United States District Court for the Eastern District of Texas, Tyler
Division.

1 filed and proceedings had in this action; oral argument of counsel; and such other matters as the
2 Court may consider.

3 **MEMORANDUM OF POINTS AND AUTHORITIES**

4 **I. INTRODUCTION**

5 On Saturday, March 29, 2008, Frenkel was served² at home with a subpoena duces tecum
6 calling for a deposition and production of documents at Cisco's offices on April 7, 2008. Frenkel
7 Decl. ¶¶ 11-12, incorporated herein by reference. (A copy of the Subpoena is attached as Exhibit
8 A-1 to Frenkel's Declaration and is incorporated herein by reference.) The subpoena comes from
9 a case pending in the United States District Court for the Northern District of Illinois, Eastern
10 Division (the "Chicago case") and was issued at the request of the Plaintiff/Counterclaim
11 Defendant Illinois Computer Research ("ICR") and the third party defendant and counterclaimant
12 Scott C. Harris ("Harris") (collectively "Issuers"). The Defendant and Counter-Plaintiff is Fish &
13 Richardson P.C. ("Fish"). Neither Cisco nor Frenkel are parties to this litigation.

14 The subpoena is overbroad and burdensome, is not relevant to any issue in the Chicago
15 case nor would enforcement reasonably lead to the discovery of admissible evidence and it goes
16 beyond the information the Issuers told the Chicago judge was necessary. In addition, the
17 subpoena calls for information which is protected by the work product and attorney client
18 privileges (privileges Cisco owns and asserts) and is protected by the First Amendment to the
19 United States Constitution, the federal common law and the California Shield Law (Cal. Evid.
20 Code § 1070; California Constitution Art. I § 2; and California Code of Civil Procedure §
21 1986.1). Furthermore, parts of the subpoena seek information related to two cases pending in
22 federal courts in Arkansas and Texas, where Frenkel and Cisco are defendants. The subpoenaed
23 information has no relevance to the Chicago case but could be used to circumvent the discovery
24 orders of the Texas and Arkansas courts.

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27 ² The subpoena was not technically served. It was left on Frenkel's doorstep at his home
28 on a Saturday. Frenkel Decl. ¶ 11.

1 **II. STATEMENT OF FACTS**

2 **A. BACKGROUND FACTS**

3 Frenkel is an attorney employed by Cisco as a Director, Intellectual Property--Consumer
4 and Emerging Technologies and as such oversees certain litigation involving the company.
5 Frenkel Decl. ¶¶ 1-2. Fish represents Cisco on certain matters and Frenkel has been indirectly
6 involved in some of them. *Id.* at ¶ 14.

7 Starting in May of 2007, Frenkel anonymously created the Patent Troll Tracker website
8 ("PTT") to report on issues of interest to the patent community and the general public. *Id.* at ¶ 3.
9 The PTT advocates reform of the patent law system. *Id.* at ¶¶ 3-5, 9. The Issuers' counsel,
10 Raymond Niro ("Niro"), a lawyer specializing in intellectual property disputes, including patent
11 cases, has a competing editorial viewpoint contrary to the PTT. *Id.* at ¶¶ 6-7. The two attorneys
12 have traded lively, and sometimes heated, exchanges over patent issues, Niro in interviews with
13 the press, and Frenkel on his website. *Id.* at ¶ 6. Niro publicly alleged that a death threat aimed
14 at him and his family was sponsored by the PTT, an allegation Frenkel denied. *Id.* at ¶ 7. Niro
15 also established a reward for anyone who would unmask the identity of the person behind the
16 PTT, raising it from an initial offer of \$5000 to \$10,000 and finally \$15,000 before Frenkel
17 revealed himself as the author of the PTT. *Id.* at ¶¶ 7-8. The reward, we understand, remains
18 unclaimed. *Id.* at ¶ 8.

19 Niro was a guest on an internet radio program ("Lawyer 2 Lawyer") on March 27, 2008,
20 and repeated his criticisms of Frenkel's website, announcing that "I am going to be taking his
21 deposition in a case shortly." *Id.* at ¶ 10. He also made reference to the Arkansas and Texas
22 litigation where Frenkel and Cisco are defendants, stating that "I know Johnny Ward (the
23 Arkansas Plaintiff) very well and I know Eric [Albritton] (the Texas plaintiff) too." *Id.* He then
24 commented on the litigation in a way unfavorable to Frenkel. *Id.*

25 Frenkel and Cisco are defendants in litigation filed in Arkansas and Texas federal courts³

26 ³ *John Ward, Jr. v. Cisco Systems, Inc. and Rick Frenkel*; Cause No. 08-4022 in the
27 United States District Court, Western District of Arkansas, Texarkana Division; and *Eric*
28 *Albritton v. Cisco Systems, Inc. and Richard Frenkel*; Cause No. 6:08-cv-89 in the United States
District Court for the Eastern District of Texas, Tyler Division.

1 over an October 18, 2007, PTT posting which is claimed to be defamatory. *Id.* at ¶ 9. An initial
2 scheduling conference has been set for the Texas case on June 5, 2008. The Arkansas suit has not
3 yet been answered.

4 B. SUBPOENA FACTS

5 The subpoena duces tecum at issue was left on Frenkel's doorstep at home on Saturday,
6 March 29, 2008, (two days after Niro told his radio audience that he was going to take Frenkel's
7 deposition). *Id.* at ¶ 10-11.

8 The subpoena calls for Frenkel to provide information about the Troll Tracker, including:
9 “Factual bases for Patent Troll Tracker blog articles” (Request No. 5); “Investigative materials,
10 sources for, and procedure for Patent Troll Tracker blog articles ...” (Request No. 6); “The origin
11 and history of the Patent Troll Tracker blog” (Request No. 8); and “The decisions on subjects,
12 including but limited to Scott Harris, Raymond P. Niro, NSHN, James B. Parker, Courtney
13 Sherrer, addressed in the Patent Troll Tracker blog” (Request No. 9). The subpoena also calls for
14 “Communications with Kathi Lutton concerning ... Fish and Richardson ...” (Request No. 1) and
15 “All lawsuits where Fish was retained by Cisco for representation, including any in which Kathi
16 Lutton filed an appearance” (Request No. 4).

17 An attorney for Frenkel, George L. McWilliams, has conferred with the Issuers' counsel,
18 but agreement on the scope of the subpoena could not be reached. McWilliams Decl. ¶ 2,
19 incorporated herein by reference; Babcock Decl. ¶ 2, incorporated herein by reference. Frenkel
20 objected to the subpoena's request for documents in Richard Frenkel's Objections to Subpoena
21 Duces Tecum (attached to Babcock Declaration as Exhibit C-1 and incorporated herein by
22 reference). Babcock Decl. ¶ 3.

23 III. ARGUMENT

24 A. Cisco Has Standing.

25 Federal Rule of Civil Procedure 45(c)(3)(B) provides that a party “affected by a
26 subpoena” may move to quash or modify. Frenkel is an attorney, employed by Cisco as a
27 Director, Intellectual Property--Consumer and Emerging Technologies, and as such oversees
28 certain litigation involving the company. Frenkel Decl. ¶ 2. By way of example only, the

1 subpoena calls for “all documents that refer to, relate to, comment upon or constitute ... all
2 lawsuits where Fish was retained by Cisco for representation, including any in which Kathi
3 Lutton⁴ filed an appearance.” This request (as well as others) call for attorney client and work
4 product privileged information on its face.

5 Under these circumstances, Cisco has standing to file this motion. *See Brown v. Braddick*,
6 595 F.2d 961, 967 (5th Cir. 1979); *Abbott Diabetes Care, Inc. v. Roche Diagnostics Corp.*, No.
7 C05-3117 MJJ (BZ), 2007 WL 2255236, *1 n.1 (N.D. Cal. Aug. 3, 2007) (Rule 45 allows “a
8 party to file a motion to quash a third-party subpoena so long as the party demonstrates some
9 right or interest in the documents requested.”) (A copy of the unpublished opinion is attached as
10 Exhibit C-5 to Babcock’s Declaration.) Babcock Decl. ¶ 7.

11 B. Certain Categories of Documents Call for Privileged Information.

12 Fish has served as counsel for Cisco in certain litigation and Frenkel has been involved in
13 some of these matters. Frenkel Decl. ¶ 14. Accordingly, the attorney client and/or attorney work-
14 product privileges would attach to some or all of the documents in the following requests from
15 the subpoena:

16 1. Communications with Kathi Lutton concerning Scott Harris, Raymond P. Niro, NSHN,
17 James B. Parker, Courtney Sherrer, Fish and Richardson or the relevant lawsuit⁵;

18 3. Communications with Fish or its counsel concerning Scott Harris, NSHN, James B.
19 Parker, Courtney Sherrer, Raymond P. Niro or the relevant lawsuit, including without limitation,
20 an identity of the individuals from Fish with whom communications were made and the substance
21 of those communications; and

22 4. All lawsuits where Fish was retained by Cisco for representation, including any in
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24 ⁴ Ms. Lutton is a Fish partner. ICR Amended Complaint at § 11, p. 4 (“Fish partner Kathi
25 Lutton...wanted to get Dell as a client.”) (relevant excerpts of which are attached as Exhibit C-2
26 to Babcock’s Decl.). Babcock Decl. ¶ 4. We attach only excerpts of pleadings from the Chicago
case. The pleadings are, however, contained on Pacer and we ask the Court to take judicial notice
of them.

27 ⁵ The relevant lawsuit is defined in the subpoena as the Chicago case. Frenkel’s motion
28 indicates he has no documents responsive to category three and no documents regarding Harris,
Niro, NSHN, Parker and Sherrer in response to category one.

1 which Kathi Lutton filed an appearance.

2 Indeed, some or all of the testimony and material covered by these requests concerns
3 confidential communications between Cisco and its lawyers regarding legal advice sought on
4 behalf of Cisco for the purpose of protecting its legal rights. Friedman Decl. ¶ 4, incorporated
5 herein by reference. Accordingly, the requests seek to compel material protected by Cisco's
6 attorney client privilege, a privilege that Cisco has not waived. *Id.* Moreover, some or all of the
7 testimony and material covered by the requests concerns the impressions, opinions, conclusions,
8 legal theories, and research prepared by Cisco's lawyers for the purpose of protecting Cisco's
9 legal rights in litigation or in anticipation of litigation. *Id.* at ¶ 5. Accordingly, the requests seek
10 to compel material protected by the work product privilege, a privilege that has not been waived.
11 *Id.*

12 The Issuers have not, and cannot, explain – much less prove – how these requests are
13 exempt from the protections afforded to Cisco by the attorney-client privilege and the work-
14 product privilege, or how such privileges were waived. Thus, the Court must quash the subpoena
15 because it “requires disclosure of privileged or other protected material, [and] no exemption or
16 waiver applies.” FED. R. CIV. P. 45(c)(3)(A)(iii).

17 B. Certain Categories of Documents Call For Information Not Relevant to the
18 Chicago Case But Which May Be at Issue In the Arkansas and Texas cases.

19 1. The Chicago Case

20 In the Chicago case ICR sued Google for alleged infringement of the so-called "252"
21 patent. On October 5, 2007, the suit was amended to add Fish as a defendant. Google was
22 dismissed with prejudice. ICR claims Fish tortiously interfered with ICR's prospective economic
23 advantage by claiming ownership in the 252 patent and by threatening a key witness, the inventor
24 of the 252 patent who, it turns out, was an employee (and perhaps a principal) of Fish. The law
25 firm is also said to have accessed privileged communications between Harris and his counsel,
26 Raymond Niro of Niro, Scavone, Haller and Niro (“NSHN”).

27 Fish counterclaimed against ICR and added Harris as a third party defendant. As to
28 Harris, the law firm claims that:

1 While a principal of Fish & Richardson, Mr. Harris: (a) obtained and
2 prosecuted numerous patents for his own benefit with misappropriated
3 Firm resources and in violation of his duties to the Firm; (b) specifically
4 targeted Firm clients for lawsuits on the patents; (c) purported to sell the
5 patents for his own personal gain to parties that he knew would sue Firm
6 clients; and (d) pledged to assist in those lawsuits against Firm clients and
7 likely retained a financial interest in the proceeds of those suits.

8 Fish Third Party Complaint, § 6 at pp. 2-3 (relevant excerpts of which are attached as
9 Exhibit C-3 to Babcock's Declaration). Babcock Decl. ¶ 5.

10 Fish alleges Breach of Contract against Harris (Count I), Breach of Fiduciary Duty against
11 Harris (Count II), Declaratory Judgment Against ICR and Harris (Count III); and Constructive
12 Trust against ICR and Harris (Count IV). Harris then Counterclaimed against Fish asserting
13 claims for tortious interference with prospective economic advantage, defamation and a claim for
14 wrongful withholding of wages under California law.

15 The connection of the Chicago case to either Frenkel or Cisco is not readily apparent from
16 a review of the live pleadings. What can be discerned, however, is that ICR and Harris' counsel,
17 Niro, appears to have some animus towards Frenkel, although Niro denied this in his radio
18 remarks. Niro offered a reward to anyone who would uncover the identity of the Patent Troll
19 Tracker but Frenkel unmasked himself so Niro claims the reward was never collected. Frenkel
20 Decl. ¶¶ 7-8.

21 In any event, Niro claims (erroneously) that the Patent Troll Tracker "has launched
22 numerous attacks on the Niro firm and Mr. Harris" resulting "in the posting of a death threat
23 against Mr. Niro and separate calls for vigilante action against him, his partners and their
24 families..." which "is creating prejudice to Mr. Harris' counsel." Harris and ICR Motion to
25 Proceed With Discovery ("Motion to Proceed"), § 4 at p. 2 (relevant excerpts of which are
26 attached as Exhibit C-4 to Babcock's Declaration). Babcock Decl. ¶ 6. The only cited
27 relationship to the Chicago case is that, according to the issuers, Frenkel "is now identified as a
28 close associate of Fish." *Id.* The last accusation is not true. Frenkel Decl. ¶ 13.

1 What may be afoot, and what Cisco fears, is that this subpoena is being used for the
2 improper purpose of conducting discovery in the Arkansas and Texas cases.

3 2. The Arkansas and Texas cases

4 Frenkel's Patent Troll Tracker is a popular website that provides interesting, timely and
5 important information to the patent community and others. As the name would suggest, its point
6 of view was sometimes critical of shell corporations established solely for the purpose of filing
7 patent litigation (colloquially known as "patent trolls") and thus, a counterpoint to Harris's
8 website and Niro's written articles which generally extolled their virtue. A posting on October
9 18, 2007 of the Patent Troll Tracker has resulted in defamation litigation in separate federal
10 courts in Arkansas (Texarkana) and Texas (Tyler) brought by two attorneys (not Niro or his firm).

11 The following Deposition Topics from the subpoena might have relevance to the
12 Texas/Arkansas Suit but would seem to have nothing to do with the claims and defenses of the
13 Chicago case:

14 5. Factual bases for Patent Troll Tracker blog articles identified in Exhibits A to C.

15 6. Investigative materials, sources for, and procedure for Patent Troll Tracker blog articles
16 identified in Exhibits A to C.

17 7. All Patent Troll Tracker blog entries concerning Scott Harris, Raymond P. Niro,
18 NSHN, James B. Parker, Courtney Sherrer, or the relevant lawsuit.

19 8. The origin and history of the Patent Troll Tracker blog.

20 9. The decisions on subjects, including but not limited to Scott Harris, Raymond P. Niro,
21 NSHN, James B. Parker, Courtney Sherrer, addressed in the Patent Troll Tracker blog.⁶

22 Using the subpoena power of the court to divulge information for an unrelated case is, of
23 course, improper. *See U.S. v. Santiago-Lugo*, 904 F. Supp. 43, 47-48 (D.P.R. 1995) (holding that
24 the use of civil subpoenas to discover evidence for an unrelated case was an improper "fishing
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26 ⁶ Frenkel's motion and his objections to the subpoena duces tecum indicate he has no
27 responsive documents related to Scott Harris, Raymond P. Niro, NSHN, James B. Parker, or
28 Courtney Sherrer but that these topics raise important free speech and press concerns, which
Cisco shares. Cisco thus joins in those portions of Frenkel's motion and objections but will not
repeat the arguments here except by reference.

1 expedition” and an abuse of the subpoena power).

2 D. The Subpoena is Broader than the Discovery Allowed in the Chicago Case.

3 Harris and ICR filed a Motion to Proceed with discovery in the Chicago case, which was
4 granted. The Motion to Proceed, however, was sought on “a number of topics, including at least:

5 (1) Fish’s knowledge and authorization of Mr. Harris’s investorship

6 activities; (2) Fish’s communications with third parties about Mr. Harris;

7 (3) Fish’s investigation of Mr. Harris; (4) Fish’s knowledge and treatment

8 of so-called ‘side businesses’ of its attorneys; and (5) Fish’s purported

9 damages, including purported requests for indemnification.”

10 Motion to Proceed at 1.

11 The subpoena relates only tangentially, if at all, to these topics.⁷

12 The Patent Troll Tracker is mentioned in paragraph 4 (p. 2) of the Motion to Proceed but
13 only to suggest that delay in discovery “is creating prejudice to Mr. Harris’ counsel.” It is also
14 mentioned in paragraph 5 (p. 3) because it is claimed, “discovery will reveal the close connection
15 between Frenkel and Fish.” Even if true (which it is not) it is not clear how that advances the
16 Chicago litigation for any of the parties. (Relevant excerpts of the Motion to Proceed are attached
17 as Exhibit C-4 to Babcock’s Declaration). Babcock Decl. ¶ 6.

18 **IV. CONCLUSION**

19 The subpoena calls for information of no relevance to the Chicago case as more fully
20 explained in the Memorandum of Points and Authorities above. As explained, the subpoena calls
21 for privileged information and the motion to quash should be granted or, in the alternative, the
22 motion for protective order should be granted.

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27 ⁷ The Court’s minute order also indicates that the discovery may be premature due to the
28 contemplated joinder of additional parties. Cisco objects to having its employee deposed before
all parties are joined.