Howard Holderness, CA Bar No. 169814
MORGAN, LEWIS & BOCKIUS LLP
1 Market Street, Spear Tower, 25th Floor
San Francisco, CA 94105
(415) 442-1000 (Telephone)
(415) 442-1001 (Facsimile)

Charles L. Babcock, IV, TX Bar No. 01479500
JACKSON WALKER L.L.P.
1401 McKinney, Suite 1900
Houston, Texas 77010
(Application for Pro Hac Vice Admission Pending.)
(713) 752-4200 (Telephone)
(713) 752-4221 (Facsimile)

George L. McWilliams
LAW OFFICE OF GEORGE L. MCWILLIAMS, P.C.
TX Bar No. 13877000; AR Bar No. 68078
406 Walnut, P.O. Box 58
Texarkana, ARK-TX 75504-0058
(Application for Pro Hac Vice Admission Pending.)
(903) 277-0098 (Telephone)
(870) 773-2967 (Facsimile)

Attorneys for Movant
RICHARD FRENKEL

4
44

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

JF

ILLINOIS COMPUTER RESEARCH, LLC,
Plaintiff and Counterclaim Defendant,

vs.

FISH & RICHARDSON P.C.,
Defendant, Counterclaimant and Third Party Plaintiff,

vs.

SCOTT C. HARRIS,
Third-Party Defendant and Counterclaimant

vs.

FISH & RICHARDSON P.C.,
Defendant, Counterclaimant, Third Party Plaintiff and Counterclaim Defendant

Miscellaneous Action No.

CV 08-80075 MISC HRL

RICHARD FRENKEL'S NOTICE OF MOTION; MOTION TO QUASH SUBPOENA; MOTION FOR PROTECTIVE ORDER; AND MEMORANDUM OF POINTS AND AUTHORITIES

NOTICE OF MOTION

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

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

Specifically, Frenkel respectfully requests an Order that the subpoena be quashed in its entirety. In the alternative, Frenkel requests that a protective order be entered which provides that: (i) the witness shall not be required to and will not produce any privileged material nor will he be required to testify about any privileged materials or on any privileged matter; (ii) any deposition testimony of third party Frenkel be limited to material issues in the Chicago case as enumerated in Harris/ICR's Motion to Proceed – namely, Fish's communications with third party Frenkel, if any, regarding Harris; and (iii) that the deposition shall not be provided to, disclosed to, or shared either directly or indirectly with any person related to the Arkansas or Texas litigation[1] and that counsel in the Chicago case will take appropriate steps to protect its confidentiality, thus insuring that it will not be available to counsel in the Arkansas and Texas cases.

Frenkel's motion is based upon this notice of motion; the following memorandum of points and authorities; the accompanying declarations of Richard Frenkel and George

[1] In these two cases, Frenkel and Cisco are defendants. *John Ward, Jr. v. Cisco Systems, Inc. and Rick Frenkel*; Cause No. 08-4022 in the United States District Court , Western District of 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.

L. McWilliams, any reply filed in support of this motion; all other papers filed and proceedings had in this action; oral argument of counsel; and such other matters as the Court may consider.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Illinois Computer Research, L.L.C. ("ICR") is the plaintiff/counterclaim defendant and Scott C. Harris is the third-party defendant and counterclaimant (collectively, the "Issuers") in the above-entitled action pending in the United States District Court for the Northern District of Illinois, Eastern Division, Case No. 07 C 5081 (the "Chicago case"). On March 29, 2008, Issuers served a subpoena from this Court (the "Subpoena") to Frenkel, who resides in this federal district.[2] Frenkel Decl. ¶¶ 11-12, incorporated herein by reference. (A copy of the Subpoena is attached as Exhibit A-1 to Frenkel's Declaration and is incorporated by reference.) Frenkel, an employee of Cisco Systems, Inc. ("Cisco"), is the author of the Patent Troll Tracker website (the "PTT"), a news-oriented website that reports on news about intellectual property litigation and advocates for reform of the patent law system. Frenkel Decl. ¶¶ 3-4, 9. Neither Frenkel nor Cisco are parties to the Chicago case.

The Subpoena seeks not only to compel Frenkel to testify in a deposition, but also to produce documents, including privileged attorney/client communications and attorney work product, sources of material used by Frenkel on his website, and background on the website itself. The subpoenaed testimony and documents have no apparent relevance to the Chicago case. On this point, Frenkel fully incorporates by reference the arguments in Cisco's Memorandum of Points and Authorities in support of its Motion to Quash Subpoena Served on Richard Frenkel, filed concurrently herewith in this Court. Moreover, the minute order from the Court in the Chicago case indicates that discovery

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

may be premature due to the contemplated joinder of additional parties. Accordingly, Frenkel objects to being deposed for purposes of discovery in the Chicago case before all parties are joined.

The Subpoena is overly broad and not properly limited to relevant and non-privileged information and therefore is unduly burdensome, and the Subpoena does not allow a reasonable time for compliance. Even if the burdens of complying with the Subpoena could be justified, there are serious constitutional ramifications of issuing such a subpoena to a non-party journalist, such as Frenkel, in a civil action. Accordingly, Frenkel seeks an order from the Court quashing the Subpoena, or in the alternative, the entry of a protective order as outlined above.

II. STATEMENT OF FACTS

A. BACKGROUND FACTS

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

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

8.

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

Frenkel and Cisco are defendants in litigation filed in Arkansas and Texas federal courts[3] over an October 18, 2007, PTT posting which is claimed to be defamatory. *Id.* at ¶ 9. An initial scheduling conference has been set for the Texas case on June 5, 2008. The Arkansas suit has not yet been answered.

B. SUBPOENA FACTS

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

The subpoena calls for Frenkel to provide information about the Troll Tracker, including: "Factual bases for Patent Troll Tracker blog articles" (Request No. 5); "Investigative materials, sources for, and procedure for Patent Troll Tracker blog articles ..." (Request No. 6); "The origin and history of the Patent Troll Tracker blog" (Request No. 8); and "The decisions on subjects, including but limited to Scott Harris, Raymond P. Niro, NSHN, James B. Parker, Courtney Sherrer, addressed in the Patent Troll Tracker blog" (Request No. 9). The subpoena also calls for "Communications with Kathi Lutton concerning ... Fish and Richardson ..." (Request No. 1) and "All lawsuits where Fish was

[3] *John Ward, Jr. v. Cisco Systems, Inc. and Rick Frenkel*; Cause No. 08-4022 in the United States District Court, Western District of 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.

retained by Cisco for representation, including any in which Kathi Lutton filed an appearance" (Request No. 4).

An attorney for Frenkel, George L. McWilliams, has conferred with the Issuers' counsel, but agreement on the scope of the subpoena could not be reached. McWilliams Decl. ¶ 2, incorporated herein by reference.

III. ARGUMENT

A court must quash a subpoena if the subpoena (1) requires disclosure of privileged or protected material and no exception or waiver applies, (2) does not allow a reasonable time for compliance, or (3) subjects a person to undue burden. FED. R. CIV. P. 45(c)(3)(A). Because the Subpoena fails to comply with Rule 45, as demonstrated below, the Court must quash it. *Id.*

A. The Subpoena Requires Disclosure of Privileged or Protected Material, and No Exemption or Waiver Applies.

The Subpoena seeks to compel Frenkel to testify about and produce documents regarding sources and unpublished information Frenkel used to report news about intellectual property litigation on his Patent Troll Tracker website. Frenkel Decl. ¶ 15. The requests at issue are numbers 5-9. The free press and speech protections of the First Amendment to the United States Constitution, as recognized by the common law Reporter's Privilege doctrine, and the California Shield Law protect reporters such as Frenkel from such compelled testimony and forced production.

As an initial matter, Frenkel properly asserts the Reporter's Privilege and protection under the California Shield Law because he is and was a reporter engaged in newsgathering activities for the purpose of reporting on news about intellectual property litigation on his website. Frenkel Decl. ¶¶ 3-5, 9, 16-17; *O'Grady v. Superior Court*, 139 Cal. App. 4th 1423, 1466, 1468 (Cal. Ct. App. 2006) (holding that the California Shield Law and the Reporter's Privilege doctrine apply to authors of news-oriented websites). Because the Issuers cannot demonstrate that an exemption or waiver applies to these two well-established privileges and protections, the Subpoena must be quashed.

1. The Reporter's Privilege.

In *Branzburg v. Hayes*, 408 U.S. 665, 681 (1972), the United States Supreme Court recognized that the newsgathering process and the editorial process are entitled to protection under the First Amendment. "Without some protection for seeking out the news, freedom of the press could be eviscerated." *Branzburg*, 408 U.S. at 681. Courts have subsequently held that "[s]ociety's interest in protecting the integrity of the newsgathering process, and in insuring the free flow of information to the public is an interest 'of sufficient social importance to justify some incidental sacrifice of sources of facts needed in the administration of justice.'" *Shoen v. Shoen*, 5 F.3d 1289, 1292 (9th Cir. 1993) (quoting *Herbert v. Lando*, 441 U.S. 153, 183 (1979) (Brennan, J. dissenting)). Courts repeatedly have acknowledged the chilling effect and resulting self-censorship that discovery of a reporter's unpublished information would have on the gathering and reporting of news. Consequently, eight federal circuits have held that the First Amendment protections for the newsgathering process rise to a level of a qualified privilege in favor of journalists when faced with a subpoena seeking discovery of confidential sources or unpublished information.[4]

Courts since *Branzburg v. Hayes* have found on such a consistent basis that a qualified privilege exists for reporters that such a privilege must certainly exist as a matter of state and federal common law. Indeed, the Supreme Court of California has recognized a qualified First Amendment privilege for reporters to prevent disclosure of their confidential sources and other unpublished information. *Mitchell v. Superior Court*, 37 Cal. 3d 268, 279 (1984); *Miller v. Superior Court*, 21 Cal. 4th 883, 899 (1999). While

[4] *See, e.g., Clyburn v. New World Communications, Inc.*, 903 F.2d 29 (D.C. Cir. 1990); *United States v. LaRouche Campaign*, 841 F.2d 1176 (1st Cir. 1988); *LaRouche v. National Broadcasting Co.*, 780 F.2d 1134 (4th Cir. 1986), *cert denied*, 479 U.S. 818 (1986); *United States v. Burk*, 700 F.2d 70 (2d Cir. 1983), *cert denied*, 464 U.S. 816 (1983); *United States v. Cuthbertson*, 630 F.2d 139 (3d Cir. 1980), *cert denied*, 449 U.S. 1126 (1981); *Miller v. Transamerican Press, Inc.*, 621 F.2d 721 (5th Cir.), modified on rehearing, 628 F.2d 932 (1980), *cert denied*, 450 U.S. 1041 (1981); See *Shoen v. Shoen*, 5 F.3d at 1292 (9th Cir. 1993); *Silkwood v. Kerr-McGee Corp.*, 563 F.2d 433 (10th Cir. 1977).

recognizing the judicial policy "favoring full disclosure of relevant evidence," the *Mitchell* court found that in civil cases, such as the one before this Court, "courts must recognize that the public interest in a non-disclosure of journalists' confidential news sources will often be weightier than the private interest in compelled disclosure." *Id.* at 276-7 (quoting *Baker v. F&F Investment*, 470 F.2d 778, 784-5 (2d Cir. 1972)).

The privilege is so well-established that the Ninth Circuit, in holding that a reporter's newsgathering activities were entitled to protection regardless of whether there had been a promise of confidentiality, concluded that the "body of circuit case law and scholarly authority [is] so persuasive that we think it unnecessary to discuss the question further." *Shoen*, 5 F.3d at 1295.

The policy behind providing the press with such protection relates to the preservation of the public's right to receive information about matters of public interest which, in turn, depends upon the press's ability to gather such information. As the Third Circuit held in *United States v. Cuthbertson*, 630 F.2d at 147:

> The compelled production of a reporter's resource materials can constitute a significant intrusion into the newsgathering and editorial processes. Like the compelled disclosure of confidential sources, it may substantially undercut the public policy favoring the free flow of information to the public that is the foundation for the privilege. Therefore, we hold that the privilege extends to unpublished materials in the possession of CBS.

Similarly, in *Shoen*, 5 F.3d at 1294-95 (quoting *United States v. The* LaRouche *Campaign*, 841 F.2d 1176 (1st Cir. 1988)), the court held that news organizations should be free from:

> the threat of administrative and judicial intrusion into the newsgathering and editorial process; the disadvantage of a journalist appearing to be an investigative arm of the judicial system or a research tool of government or of a private party; the disincentive to compile and preserve non-broadcast material; and the burden on journalist's time and resources in

responding to subpoenas.

Based on these principles, before a reporter can be forced to testify or surrender materials regarding the newsgathering process, there must be a showing that (1) the information sought is highly material and relevant to the inquiry at hand; (2) there is a compelling need for the information; and (3) the information is not obtainable from other available sources. *See, e.g., Shoen*, 5 F.3d at 1296; *In re Petroleum Prods. Antitrust Litigation*, 680 F.2d (2d Cir. 1982) (per curiam), *cert denied,* 459 U.S. 909 (1982).

The Issuers have not, and cannot, make such a showing in this case. First, the Issuers have not explained – much less proven – how the information sought by the Subpoena is "highly material and relevant." Second, even if the information sought is highly material and relevant, there is an additional requirement that there be a "compelling need" for the information beyond mere relevancy – no such compelling need has been articulated, must less proven. Finally, whatever relevant information may be in the hands of Frenkel is obtainable from other sources.

Frenkel is particularly concerned with the forced production and compelled testimony regarding sources and unpublished information, especially to Issuers' counsel who has publicly stated his editorial opposition to Frenkel. Frenkel Decl. ¶¶ 15-16. If forced to testify about and produce such material, it would result in a serious detriment to Frenkel's future ability to gather and disseminate news. *Id.* at ¶ 16. The newsgathering efforts of a reporter such as Frenkel should not be made part of civil discovery between parties without a showing of the required elements set forth above to ensure that reporters are not burdened with civil lawsuits to which they are not parties.

This type of burden is exactly what the federal and state common law and constitutional protections are designed to prevent. The forced production and compelled testimony regarding confidential sources and unpublished information would make it far more difficult in the future for reporters to secure information or interviews and to report news involving matters of public concern. Ultimately, both public and private litigants would suffer. There is no compelling reason in this civil case to contribute to such a

result. Accordingly, the Court must quash the Subpoena. Fed. R. Civ. P. 45(c)(3)(A)(iii).

2. Federal Common Law.

Federal common law under Federal Rule of Evidence 501 likewise recognizes a qualified reporter's privilege. *See Jaffee v. Redmond*, 518 U.S. 1 (1996). The factors to be considered in determining whether to apply the privilege are:

> (1) whether important private and public interests would be served by recognition of the privilege; (2) whether the evidentiary cost of recognizing the privilege is likely to be modest; and (3) whether similar protections are afforded by the states, either through legislation or the common law.

See Jaffee, 518 U.S. at 10-15; *see also In re Williams*, 766 F.Supp. 358, 367 (W.D. Pa. 1991), *aff'd*, 963 F.2d 567 (3d Cir. 1992) (*en banc*); *New York Times v. Gonzalez*, 382 F. Supp. 2d 457, 492-508 (S.D.N.Y. 2005), *vacated on other grounds*, 459 F.3d 160, 168 (2d Cir. 2006). *But see In re Grand Jury Subpoenas*, 438 F. Supp. 2d 1111 (N.D. Cal. 2006) (declining to apply *Jaffee* factors to a grand jury subpoena.)

3. The California Shield Law.

The California Shield Law is enshrined in the state constitution, CALIF. CONST. Art. I § 2(b), and it precludes compelling a reporter from disclosing confidential sources or any unpublished material. *Id.*; *see also* CAL. EVID. CODE § 1070(a); CAL. CIV. PRO. CODE § 1986.1; *O'Grady*, 139 Cal. App. 4th at 1466. Where, as here, the reporter from whom such information is sought is not a party to the underlying civil litigation, the protections afforded by the California Shield Law are absolute. *New York Times Co. v. Superior Court*, 51 Cal.3d 453, 458 (Cal. App. 1990).[5]

Indeed, the California courts recognize that the protections afforded to reporters by the California Shield Law must not yield to the competing interests of civil litigants seeking discovery from a nonparty:

[5] This is a federal proceeding but the claims remaining in the Chicago case are governed by state law and thus state law privileges apply. *See* FED. R. EVID. 501.

> If every civil litigant who postulates that some information material to his case is contained within the undisseminated materials of a newsperson may compel that nonparty newsperson to present his information to the trial court for inspection, balancing of interests, and probable disclosure, the protection afforded newspersons would be greatly reduced, if not wholly vitiated.

Playboy Enterprises, Inc. v. Superior Court, 154 Cal. App. 3d 14, 27 (Cal. App. 1984).

Specifically, the California Shield Law protects from disclosure any "unpublished information obtained or prepared in gathering, receiving, or processing of information for communication to the public." CALIF. CONST. ART. I § 2(b); CAL. EVID. CODE § 1070(a). "Unpublished information" is broadly defined, and extends to all information not literally published. *Id.*; *New York Times Co.*, 51 Cal. 3d at 456. To be entitled to protection by the Shield Law, the reporter must be engaged in "the gathering and dissemination of news." *O'Grady*, 139 Cal. App. 4th at 1457.

As in *O'Grady*, Frenkel is and was engaged in the gathering and dissemination of news about intellectual property litigation on his Patent Troll Tracker website. Frenkel Decl. ¶ 16. The fact that Frenkel chose to disseminate news on a website, as opposed to a more traditional source of journalism, is irrelevant. *O'Grady*, 139 Cal. App. 4th at 1466. Moreover, the Subpoena seeks to compel testimony and force production of documents regarding unpublished information Frenkel obtained or prepared for communication to the public on his Patent Troll Tracker website. Frenkel Decl. ¶ 15. Accordingly, the Subpoena falls squarely within the absolute protections afforded to Frenkel by the California Shield Law, and the Court thus must quash the Subpoena in its entirety. FED. R. CIV. P. 45(c)(3)(A)(iii).

B. The Subpoena Does Not Allow a Reasonable Time for Compliance.

Frenkel received service of the Subpoena on March 29, 2008, a mere nine days before the Subpoena requires him to produce a litany of documents and a mere ten days before the Subpoena compels him to testify at a deposition. Frenkel Decl. ¶¶ 11-12.

Federal courts interpreting Rule 45's requirement that subpoenas allow a reasonable time for compliance have held that such a short time between the issuance of a subpoena and the deadline for compliance is unreasonable. *Mann v. Univ. of Cincinnati*, 824 F. Supp. 1190, 1202 (S.D. Ohio 1993), *aff'd* 152 F.R.D. 119 (S.D. Ohio) (holding that "issuance of the subpoena on one week's notice was unreasonable" and therefore violated Rule 45). Likewise, the Subpoena at issue here is unreasonable. Accordingly, Frenkel moves to quash the Subpoena because it fails to allow a reasonable time for compliance. FED. R. CIV. P. 45(c)(3)(A)(i).

C. The Subpoena is Unduly Burdensome.

Pursuant to Federal Rule of Civil Procedure 26(b)(1), all of the document requests contained in the Subpoena are grossly overbroad and not properly limited to relevant and non-privileged information and therefore compliance would impose an undue burden upon Frenkel. Frenkel Decl. ¶ 18. The specific nature of the breadth and burden objections for each document request is set forth in Richard Frenkel's Objections to Subpoena Duces Tecum (attached as Exhibit B-1 to McWilliams' Declaration and incorporated herein by reference). McWilliams Decl. ¶ 3. Accordingly, Frenkel moves to quash the Subpoena on grounds that the document requests are overly broad and not properly limited to relevant and non-privileged information and therefore unduly burdensome. FED. R. CIV. P. 45(c)(3)(A)(iv).

IV. CONCLUSION

The subpoena calls for information of no relevance to the Chicago case as more fully explained in Cisco's Memorandum of Points and Authorities in support of its Motion to Quash, which is incorporated by reference.

As explained above, the subpoena calls for privileged and protected information, fails to allow a reasonable time for compliance, and is unduly burdensome, and accordingly, the Motion to Quash or, in the alternative, for a Protective Order should be granted.