DORIAN DALEY (State Bar No. 129049)
JOHN V. WADSWORTH (State Bar No. 166838)
ORACLE USA, INC.
500 Oracle Parkway, MS5OP7
Redwood City, CA 94065
Telephone: (650) 506-5200

Attorneys for
ORACLE CORP.

FILED

JAN 27 2006

RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

MHP

CV 03 80058 MISC.

THE SCO GROUP, INC., a Michigan corporation, Plaintiff, v. INTERNATIONAL BUSINESS MACHINES CORPORATION, a New York corporation, Defendant.	**ORACLE CORP.'S MOTION TO QUASH THIRD PARTY SUBPOENA *DUCES TECUM* OR, IN THE ALTERNATIVE, FOR A PROTECTIVE ORDER; [PROPOSED] ORDER** **[CASE NO.: MISC., U.S. DISTRICT COURT FOR THE DISTRICT OF UTAH, CASE NO. 2:03CV-0294]**

NOTICE OF MOTION; MOTION

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE THAT at a time and date to be set by the Court, Non-Party Oracle Corp. ("Oracle") shall appear in the Northern District of California – San Francisco Division, 450 Golden Gate Avenue, San Francisco, California, and shall move

the Court for an order quashing a third-party Subpoena *Duces Tecum* to Oracle dated January 10, 2006 ("Subpoena"), which was served on Oracle by Plaintiff The SCO Group, Inc. ("SCO"). In the alternative, Oracle shall move the Court for a protective order prohibiting the discovery sought. Oracle shall also move the Court for a protective order prohibiting the taking of any deposition pursuant to a related Notice of 30(b)(6) Deposition ("Deposition Notice") served separately by SCO on Oracle. This motion shall be made pursuant to Rule 26(c) and Rule 45(c)(3)(A) of the Federal Rules of Civil Procedure and Local Rule 7-1. In support of its motion Oracle submits the Memorandum of Points and Authorities below, Declaration of John V. Wadsworth, Declaration of Monica Kumar, and the attached [proposed] Order.

RELIEF SOUGHT

Oracle moves the Court for an order quashing the Subpoena insofar as it purports to require deposition testimony or, in the alternative, for a protective order prohibiting the taking of any deposition testimony pursuant to the Subpoena.[1] Oracle also moves the Court for a protective order prohibiting the taking of any deposition testimony pursuant to the Deposition Notice.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION AND STATEMENT OF FACTS

SCO first filed suit against Defendant International Business Machines Corp. ("IBM") in March 2003 in Utah state court. The case was removed shortly thereafter and

[1] Oracle does not move for a protective order or an order quashing the Subpoena insofar as the Subpoena requests the production of documents. Oracle has timely served responses and objections to the document requests and expects that if SCO disagrees with Oracle's responses or objections and wishes to pursue the production of further documents pursuant to the Subpoena, SCO will do so pursuant to the procedures specified in Fed. R. Civ. P. 45(c)(2)(B).

is still pending in the U.S. District Court for the District of Utah, Central Division. IBM has counterclaimed against SCO. SCO's current operative complaint is the Second Amended Complaint, dated February 27, 2004 ("SAC"). A copy of the SAC is attached to the Declaration of John V. Wadsworth ("Wadsworth Decl.") as Exhibit A. IBM's current operative counterclaim is the Second Amended Counterclaim ("SACC") (Wadsworth Decl., Exh. B). The parties have been taking discovery for two years.

The action is a complex series of claims relating to the UNIX computer operating system software. (The SAC contains 214 paragraphs in 64 pages; the SACC contains 197 paragraphs in 48 pages.) SCO claims it owns the UNIX technology, and that IBM has misused and misappropriated SCO's software rights in distributing Linux open source software products. SCO has asserted claims for breach of various license agreements, copyright infringement, unfair competition, and interference with business relationships. In response, IBM claims that SCO has wrongly asserted rights over non-SCO products, including IBM's; and that SCO has infringed a number of IBM's patents and copyrights. IBM has asserted claims for breach of contract, Lanham Act violations, unfair competition, interference with business relationships, deceptive trade practices, promissory estoppel, copyright infringement, and patent infringement.

Oracle is the world's second largest independent software company. Oracle is primarily engaged in the business of creating, licensing, marketing, and distributing database software and business application software for financial, manufacturing, human resources, customer relationship management, and other business functions. The database software designed and licensed by Oracle enables the user to store, manage, and process very large amounts of data. The application software designed and licensed by

Oracle allows users to perform a variety of business functions such as managing employee records, maintaining financial statements, and monitoring product inventories. Declaration of Monica Kumar ("Kumar Decl."), ¶ 2.

Oracle designs its products to operate with the various products of many other computer software and hardware vendors, including IBM. For example, IBM designs and licenses operating system software widely used in corporate information technology departments, and Oracle designs versions of all of its products that will interoperate with IBM's operating system. Those specific versions of Oracle products may not work with any other operating system licensed by other software makers. Thus Oracle has many different "flavors" of its products, each of which is designed to interoperate with the hardware or software of another vendor. Kumar Decl., ¶ 3.

Oracle's corporate headquarters are located in Redwood Shores, California. All of the employees who would be designated to testify in response to the Deposition Notice are located at Oracle's headquarters. Wadsworth Decl., ¶ 6.

Oracle is not a party to this action. However, Oracle has already received and responded to a number of subpoenas in this action. The first subpoena was issued by IBM on March 19, 2004 and requested various documents relating to Oracle's business relationships with SCO and another affiliated company called The Canopy Group, Inc. The subpoena also requested documents relating to the Unix or Linux operating systems. IBM served a copy of the subpoena on SCO. Given the broad scope of the requests and the marginal relevancy to the action, Oracle objected to the vast majority of the requests and produced several documents. IBM agreed not to pursue the requests further. Wadsworth Decl., ¶ 7.

Oracle was served with a second subpoena from IBM on or about January 13, 2005. IBM served a copy of the subpoena on SCO. This subpoena requested testimony pursuant to Fed. R. Civ. P. 30(b)(6) relating to a series of topics similar to the topics in the previous request. Oracle responded to that subpoena to IBM's satisfaction. Wadsworth Decl., ¶ 8.

Oracle was served with a third subpoena dated October 24, 2005. This subpoena was issued by SCO and sought documents relating to any meetings, conversations, etc. between a group of seven large technology vendors, including Oracle, relating to creation of a so-called Linux Consortium. Oracle searched for any responsive documents and found none (the Oracle employee who had interfaced with this group no longer works for Oracle). However, Oracle worked with the other members of the group, who had also been subpoenaed, and documents were produced to SCO. Wadsworth Decl., ¶ 9.

The Subpoena at issue in this motion – the *fourth* in this case served on Oracle – was served on Oracle's agent for service of process, Corporation Service Company, on January 11, 2006. *See* Wadsworth Decl., ¶ 10 & Exh. C. Oracle received the Subpoena from CSC on January 12, 2006. *Id.* ¶ 10. No witness fees were tendered at that time, or since. *Id.* ¶¶ 10-12. The Subpoena calls for production of seven categories of documents. *Id.* Exh. C. The Subpoena also calls for Oracle to appear on January 27, 2006 in Oakland, California and provide deposition testimony, though the Subpoena does not specify the subject matter of the testimony. *Id.* Separate from the Subpoena, SCO served, via U.S. mail, the Deposition Notice on Oracle. *See id.* Exh. D. SCO also faxed, to the "Oracle Corp. Legal Department," a copy of the Deposition Notice on January 11, 2006. The subject matters of the testimony specified in the Deposition Notice pursuant to

Fed. R. Civ. P. 30(b)(6) are the same seven subject matter areas specified in the Subpoena with respect to production of documents. *Id.* However, the Deposition Notice provides that the deposition is to take place in Armonk, New York, on January 27, 2006. *Id.*

At no time prior to serving the Subpoena or the Deposition Notice did SCO confer with Oracle about the date on which it wished to conduct the deposition. Nor did SCO confer with Oracle after it served them. Wadsworth Decl., ¶ 10.

The topics specified in the Deposition Notice appear to relate to SCO's claims that IBM interfered with SCO's business relations with Oracle. In the SAC, SCO alleges that it "had existing or potential economic relationships with a variety of companies in the computer industry," and that IBM has intentionally interfered with those relationships. SAC ¶¶ 209-214. The SAC claims that "at Linux World in January, 2003 IBM representatives contacted various companies with whom SCO had existing or potential economic relations," that "IBM was discontinuing doing business with SCO," and that these other companies, "some of whom are business partners with IBM, also should discontinue doing business with SCO." SAC ¶ 210.

The deposition topics broadly cover several different areas:

- Communications between Oracle and IBM relating to SCO or this lawsuit (Deposition Notice, Topics, ¶¶ 1, 2),
- Oracle's decisions whether to certify "any version of any software product" to operate with SCO's operating system products (Deposition Notice, Topics, ¶¶ 3, 4).
- Without any time or scope limitation whatsoever, Oracle's "business and contractual relationships" with SCO or two SCO-related companies (Deposition Notice, Topics, ¶ 5),
- "All versions of all Oracle software products" certified since 1995 to operate with "any version of any Unix-based operating system" designed by any of the various companies that produce such products (Deposition Notice, Topics, ¶ 6), and

- All instances in which Oracle has refused to certify "any version of any Oracle software product" to operate with "any operating system" since 1995 (Deposition Notice, Topics, ¶ 7).

On January 19th, counsel for Oracle contacted counsel for SCO and advised him that the Subpoena and related Deposition Notice were defective because, among other things, the applicable witness fees were not tendered; the Subpoena was issued out of the "District of California," which does not exist; and because the Deposition Notice specifies that the deposition is to take place in Armonk, New York (even though the Subpoena specifies the deposition site as Oakland, California). Oracle also stated that the topics are overbroad, seek irrelevant testimony, and would require the production of several different witnesses. Oracle requested that SCO confer to discuss the possibility of agreeing to narrow the scope, or else Oracle would be required to file a motion to quash. Finally, Oracle's counsel advised that he was already scheduled to be in Burbank, California on the date specified for the deposition for a long-planned board of directors meeting. Wadsworth Decl., ¶ 11.

SCO's counsel responded on January 21st (January 21st was a Saturday and thus Oracle did not receive the response until Monday, January 23rd). SCO stated that SCO might be willing to agree to modify the scope of the Subpoena. However, SCO stated that the discovery cutoff in the case was Friday, January 27th, and SCO could not agree to move the date of the deposition. SCO did not respond as to where SCO expected the deposition to take place, Armonk or Oakland. Nor did Mr. Normand offer to tender the necessary witness fees. SCO simply stated that it expected "that Oracle would file a motion for protective order regarding (at least) the timing of the subpoena before January 27." Wadsworth Decl., ¶ 12. This motion followed.

II. ARGUMENT

Non-parties are afforded "special protection" from intrusive discovery requests served by parties to litigation. *Exxon Shipping Co. v. Dep't of the Interior,* 34 F.3d 774, 779 (9th Cir. 1994) (the Federal Rules "afford nonparties special protection against the time and expense of complying with subpoenas"); *Dart Industries Co. v. Westwood Chemical Co.,* 649 F.2d 646, 649, 651 (9th Cir. 1980) (trial court properly quashed Rule 45 subpoena served on a nonparty); *Cmedia, LLC v. Lifekey Healthcare, LLC,* 216 F.R.D. 387, 389 (N.D. Tex. 2003). Under the Federal Rules, a court *shall* quash or modify a subpoena if the subpoena "fails to allow reasonable time for compliance," requires the party to travel more than 100 miles, or "subjects a person to undue burden." Fed. R. Civ. P. 45 (c)(3)(A). *All* of those factors are presented by SCO's Subpoena and Deposition Notice. In addition, the Subpoena and Deposition Notice are rife with defects that render them void and/or that render their service incomplete. Accordingly, this Court should quash the Subpoena and enter a protective order commanding that the deposition sought by SCO not be taken.

A. The Subpoena And Deposition Notice Are Procedurally Defective And Thus Void.

The Subpoena and Deposition Notice are procedurally defective and must be quashed for that reason alone. First, SCO has never attempted to confer with Oracle about the scheduling of the deposition, either before or after serving the Subpoena and the Deposition Notice. Wadsworth Decl., ¶ 10. On the day unilaterally selected by SCO for the deposition (January 27th), the Oracle in-house attorney who has handled all of the subpoenas in this action and who is familiar with the complicated history of this case is

scheduled to be in Burbank, California for a long-scheduled Board of Directors meeting for a board on which he sits. *Id.* ¶ 11. Thus this date is inconvenient for Oracle. SCO's failure to meet and confer violates Local Rule 30-1.

Second, the place set for the deposition – Armonk, New York – is more than 100 miles from Oracle's headquarters in Redwood City, California. Wadsworth Decl., ¶ 6. The Oracle employees that Oracle would be required to designate for these topics all work out of Oracle's headquarters, and thus they individually are more than 100 miles from Armonk, New York. *Id.* Oracle's counsel is also located at Oracle's headquarters in Redwood City, California. *Id.* The site designated in the Deposition Notice thus violates the 100-mile rule stated in Fed. R. Civ. P. 45(b)(2). Rule 45 provides that a court *shall* quash a Subpoena if the subpoena violates this rule. Fed. R. Civ. P. 45(c)(3)(A)(ii).

Third, SCO did not tender any witness fees with either the Subpoena or the Deposition Notice, and has not since tendered any witness fees despite having been advised of this omission. Wadsworth Decl., ¶¶ 10-12. This violates Fed. R. Civ. P. 45(b)(1), which provides that where attendance at a deposition is required, service *shall* include the "tendering to that person the fees for one day's attendance." Indeed the Ninth Circuit has held that Rule 45 "*requires the simultaneous tendering of witness fees and the reasonably estimated mileage allowed by law with service of a subpoena.*" *CF&I Steel Corp. v. Mitsui & Co. (U.S.A.), Inc.,* 713 F.2d 494, 496 (9th Cir. 1983) (emphasis added); *see also In re Stratosphere Corp. Securities Litigation,* 183 F.R.D. 684, 687 (D. Nev. 1999). The Ninth Circuit held that since the subpoenaing party in that case had not tendered the requisite fees, the District Court had properly quashed the subpoena. *CF&I*

Steel, 713 F.2d at 496; *In re Stratosphere Corp. Securities Litigation,* 183 F.R.D. at 687 (following *CF&I Steel* and quashing a third party Rule 45 subpoena)

Fourth, the Subpoena was signed, and thus "issued," by SCO's attorney Edward Normand, who is located in Armonk, New York. Under Rule 45, a subpoena may only be issued and signed by an attorney who is either "authorized to practice" in the court in whose name it is issued (here, the Northern District of California) or who is "authorized to practice" in the court in which the subject action is pending (here, the District of Utah). Fed. R. Civ. P. 45(a)(3). If Mr. Normand is not authorized to practice in either this District or the District of Utah, the Subpoena is defective and thus void.

Finally, the Subpoena purports to be issued out of the "District of California." There is no such federal judicial district. This defect violates Fed. R. Civ. P. 45(a)(2).

Each of the foregoing renders the Subpoena and/or the Deposition Notice void. SCO should not be permitted to impose such slapdash discovery requests on nonparties at the very end of discovery, after it has had years to obtain the information in a more orderly fashion. This Court should accordingly quash the Subpoena and enter an order commanding that the deposition not take place.

B. The Subpoena And Deposition Notice Seek Information That SCO Can Obtain From Parties To The Litigation Or That SCO Itself Should Already Possess.

A court *shall* quash a subpoena if the subpoena "subjects a person to undue burden." Fed. R. Civ. P. 45(c)(3)(A)(iv); *Mattel, Inc. v. Walking Mountain Productions,* 353 F.3d 792, 814 (9th Cir. 2003). Oracle has learned that SCO has only recently noticed Rule 30(b)(6) depositions of IBM on the same topics on which SCO seeks Oracle testimony. Wadsworth Decl., ¶ 13. SCO should be required to take these depositions

first and determine whether further discovery is needed of Oracle or any other third party before it seeks such non-party discovery. It is well settled under the law that litigants should seek discovery from parties to the litigation before attempting to burden nonparties with discovery requests. *See, e.g., Haworth, Inc. v. Caruthers-Wallace Coutenay, Inc.*, 998 F.2d 975, 978 (Fed. Cir. 1993 (affirming trial court's decision to require litigant to seek discovery from opposing party before subpoenaing non-party); *Richards of Rockford, Inc. v. Pacific Gas & Elec. Co.*, 71 F.R.D. 388, 391 (N.D. Cal. 1993) (refusing to require non-parties to produce discovery that litigant could obtain from opponent). In this case, SCO should be required to exhaust all means of obtaining such information from IBM before it burdens Oracle with yet another non-party subpoena.

The same reasoning applies with even greater force to the topics requiring SCO-related information. For example SCO demands that Oracle testify as to Oracle's "business and contractual relationships" with SCO or two SCO-related companies, at any time whatsoever in the past. Deposition Notice, Topics, ¶ 5. If SCO requires any such information in order to pursue its case, surely it can obtain such information within its own documents and from its own employees and executives, whether past or present. Why should SCO be permitted to force Oracle to produce a witness to testify on a contract Oracle may have signed with SCO eight years ago? This exceeds the scope of permissible discovery and imposes an undue burden on Oracle.

C. The Subpoena And Deposition Notice Seek Irrelevant Information.

A court *shall* quash a subpoena if the subpoena "subjects a person to undue burden." Fed. R. Civ. P. 45(c)(3)(A)(iv). SCO seeks deposition testimony from Oracle

on topics that are irrelevant to this case. The gist of SCO's claim is that IBM sought to interfere with SCO's relationship with other technology companies, including Oracle. *See* SAC. Presumably SCO contends that IBM somehow persuaded Oracle to decide not to certify its products with SCO's products.

Yet SCO demands that Oracle testify as to its decision whether or not to certify *any* of its products with *any* Unix-based operating system (whether or not SCO's) over the past *twelve years*. Deposition Notice, Topics, ¶ 6. This information is not relevant to SCO's claims. And producing this information would be very burdensome because Oracle has many dozens of different products, and virtually *all* of those products have many different individual versions. The request would likely require Oracle to produce information on literally hundreds of discrete product-version combinations. Kumar Decl., ¶ 4. Even more egregious is SCO's demand for testimony relating to any instance in which Oracle has refused to certify "any version of any Oracle software product" to operate with "*any operating system*" over the past twelve years. Deposition Notice, Topics, ¶ 7. Again, this is much too far removed from the subject matter of this case to be permitted. *See Mattel, Inc.*, 353 F.3d at 813-14 (quashing nonparty subpoena that was "way too broad" and where "no attempt had been made to try to tailor the information request to the immediate needs of the case"); *Cmedia*, 216 F.R.D. at 389-90 (barring subpoena requests that were "facially overbroad because they seek extremely broad categories of documents evidencing communications and agreements between [the nonparty] and Lifekey as well as companies who are not party to the underlying litigation").

Several of the deposition topics are particularly problematic because they likely would require Oracle to discuss its confidential business relationships and product design strategies relating to technology products that are not SCO's and that have nothing to do with this case. This also constitutes an undue burden, particularly in light of the fact that the information is irrelevant to the litigation anyway. *Cmedia,* 216 F.R.D. at 389-90 (barring subpoena requests that called for production of confidential information).

D. The Subpoena And Deposition Notice Do Not Provide Oracle Adequate Time To Identify And Prepare Witnesses.

A court *shall* quash a subpoena if the subpoena "fails to allow reasonable time for compliance." Fed. R. Civ. P. 45(c)(3)(A)(i). As described above, SCO has set this Rule 30(b)(6) deposition without any regard whatsoever to the realities of business and without any respect for the time of Oracle's employees or counsel. A mere two weeks is not adequate time for any counsel to identify the witnesses who would be required to testify, prepare those witnesses, and also determine a host of other issues such as whether any testimony would breach any nondisclosure obligation or whether any testimony would constitute Oracle confidential information that Oracle might wish to seek to protect even given that a protective order may be in place in this action. That is especially true in because Oracle is not a party. Oracle cannot be expected to drop everything and in two weeks, prepare and produce what would likely be the several witnesses that would be necessary in order for Oracle to meet its Rule 30(b)(6) obligations. And needless to say SCO cannot possibly claim that it had no choice on the timing because of the discovery cutoff. SCO has had ample time to notice these depositions – two years, to be precise. SCO's tactics are not allowed under the Federal Rules. The Subpoena should be quashed

and the Court should order that the deposition called for in the Deposition Notice not proceed.

III. CONCLUSION

For all of the foregoing reasons, Oracle respectfully requests that the Court order that the Subpoena be quashed or, in the alternative, that the Court issue a protective order prohibiting the discovery sought pursuant to the Subpoena. Oracle also respectfully requests that the Court issue a protective order prohibiting the taking of any deposition pursuant to the Deposition Notice.

DATED: January 26, 2006

ORACLE CORP.

By: _____
John V. Wadsworth
Attorney for Non-Party Oracle Corp.

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

THE SCO GROUP, INC., a Michigan corporation, Plaintiff, v. INTERNATIONAL BUSINESS MACHINES CORPORATION, a New York corporation, Defendant.	**[PROPOSED] ORDER** **[CASE NO.: MISC., U.S. DISTRICT COURT FOR THE DISTRICT OF UTAH, CASE NO. 2:03CV-0294]**

For good cause shown, IT IS HEREBY ORDERED that Nonparty Oracle Corp.'s Motion to Quash Subpoena *Duces Tecum* is GRANTED.

Judge, United Stated District Court

PROOF OF SERVICE
THE SCO GROUP, INC. v. INTERNATIONAL BUSINESS MACHINES CORP.

I, Maya Beech, declare:

I am employed in the County of San Mateo, State of California, in the office of a member of the bar of this court, at whose direction the service was made. I am over the age of eighteen (18) years, and not a party to the within action. My business address is 500 Oracle Parkway, Mailstop 5op7, Redwood City, California, 94065. On the date set forth below I served the following:

ORACLE CORP.'S MOTION TO QUASH THIRD PARTY SUBPOENA *DUCES TECUM* OR, IN THE ALTERNATIVE, FOR A PROTECTIVE ORDER and [PROPOSED] ORDER

(X) By placing such a copy enclosed in a sealed envelope postage thereon fully prepaid, in the United States Postal Service for collection and mailing this day.

( ) By hand delivery on this date.

( ) By consigning such a copy to an express mail service for guaranteed delivery on this date.

( ) By consigning such a copy to a facsimile operator for transmittal on this date.

I served the above on:

Edward Normand, Esq.
Boies, Schiller & Flexner LLP
333 Main St.
Armonk, NY 10504

Amy F. Sorenson, Esq.
Snell & Wilmer LLP
15 West South Temple, Suite 1200
Salt Lake City, UT 84101

I declare under penalty of perjury that the foregoing is true and correct. Executed in Redwood City, California on January 26, 2006.

Maya Beech
Legal Assistant