

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

**CERTAIN HANDHELD ELECTRONIC
COMPUTING DEVICES, RELATED
SOFTWARE, AND COMPONENTS
THEREOF**

Inv. No. 337-TA-769

**ORDER NO. 30: DENYING MICROSOFT'S MOTION TO CERTIFY TO THE
COMMISSION A REQUEST FOR JUDICIAL ENFORCEMENT
OF SUBPOENAS *DUCES TECUM* AND *AD TESTIFICANDUM* TO
GOOGLE, INC.; AND**

**GRANTING MICROSOFT'S MOTION FOR LEAVE TO TAKE
THE DEPOSITION OF GOOGLE, INC. AFTER THE CLOSE OF
FACT DISCOVERY**

(January 3, 2012)

On November 9, 2011, complainant Microsoft, Inc. ("Microsoft") filed a motion seeking to certify a request to the Commission for enforcement of the subpoena *duces tecum* and *ad testificandum* issued to Google, Inc. ("Google").¹ (Motion Docket No. 769-029.) Microsoft seeks to enforce the subpoenas with regard to certain topics, namely Requests for Production Nos. 4, 5, 6, 15 and 16.² Specifically, these requests seek "all documents reflecting or relating to business evaluations, assessments, strategy discussions, or analyses of" (1) "the actual or potential impact, on Android distribution, of patents held by Microsoft;" (2) "the impact on Android distribution of actual, potential or threatened patent infringement lawsuits by Microsoft related to Android;" (3) "the impact on Android distribution of public claims by Microsoft or Microsoft executives or employees that Android infringes Microsoft patents;" (4) "Android's

¹ The motion also requested a shortened response time, which Google opposed. On November 14, 2011, Microsoft withdrew its request for a shortened response time.

² Google and Microsoft have come to an agreement on other topics listed in the subpoenas.

capability (current or projected) as a personal computer operating system;” and (5) “competing mobile operating systems from Microsoft.” Microsoft argues that these requests are relevant to respondent Barnes and Noble’s patent misuse defense against Microsoft and that evidence of the lack of anticompetitive effect on Android would dispose of the defense. Microsoft also seeks an order compelling Google to produce documents current to the date of Google’s responses to the subpoenas.³ Microsoft further argues that Google should still be required to search for responsive documents and create a privilege log regardless of its claims that Microsoft’s requests would create an undue burden on it since most of the documents are likely to touch on privileged information.

On November 21, 2011, Google filed a response opposing the motion.⁴ Google argues that the motion should be denied because Google has already agreed (and has begun) to produce documents and a witness to testify on many of the topics set forth in the subpoenas. Google further argues that Microsoft’s requests are overly broad and seek irrelevant information. Finally, Google argues that Microsoft’s requests and deposition topics seek privileged and protected information, including Google’s assessment of Microsoft’s patents, patent litigation and claims of patent infringement, and that the value of the responsive, non-privileged documents does not outweigh the heavy expense and burden required to review the documents and prepare the necessary privilege logs.

³ While not explicitly stating so, this request appears to be limited to the 5 topics at issue in this motion. Indeed, Microsoft’s argument only discusses Google’s “internal business evaluations of the alleged conduct’s purported impact on Android distribution.” As such, the ALJ considers Microsoft’s request to be limited to the 5 topics still in dispute.

⁴ Google argues that Microsoft’s motion should be denied for failure to comply with Ground Rule 3.5. To the extent that an *ex parte* application for a third party subpoena and any related motions to quash and/or limit those subpoenas do not require a Ground Rule 3.5 conference call, the ALJ declines to extend such a requirement to motions seeking judicial enforcement of the subpoenas. The ALJ is certainly willing, however, to hold a conference call if the parties believe it will more expeditiously and judiciously dispose of the dispute in such circumstances, but he will not require them as a prerequisite to filing a motion to seek judicial enforcement of a subpoena.

For the reasons set forth below, the ALJ DENIES Motion No. 769-029. Commission

Rule 210.32(g) provides that:

In order to obtain judicial enforcement of a subpoena issued under paragraphs (a)(3) or (c)(2) of this section, the administrative law judge shall certify to the Commission, on motion or sua sponte, a request for such enforcement. The request shall be accompanied by copies of relevant papers and a written report from the administrative law judge concerning the **purpose, relevance, and reasonableness of the subpoena**. The Commission will subsequently issue a notice stating whether it has granted the request and authorized its Office of the General Counsel to seek such enforcement.

(emphasis added). Administrative law judges have previously certified requests for judicial enforcement to the Commission when the requisite showings of purpose, relevance, and reasonableness have been made and, when appropriate, the Commission has sought to enforce the subpoenas in U.S. District Court.⁵

The ALJ finds that Microsoft has failed to show how a third party's (Google's) opinions relating to Microsoft's patents are relevant to respondent Barnes and Nobles' patent misuse defense. Microsoft simply states that Google must be in possession of the requested documents and conclusorily states that such documents are relevant to its defense against Barnes and Nobles' patent misuse claims. Microsoft simply asserts that "[e]vidence demonstrating a lack of anticompetitive effect on Android would dispose of Barnes and Noble's patent misuse defense," but Microsoft fails to show how a *third party's* evaluation of Microsoft's own patents are relevant to Barnes and Noble's claims of patent misuse. Even assuming that Google's evaluations and assessments are tenuously relevant, the ALJ finds that the breadth of Microsoft's requests, *i.e.*, all documents relating to all Microsoft patents, and the burden that this will

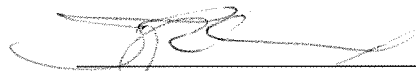
⁵ See *Certain NAND Flash Memory Circuits and Products Containing Same*, Inv. No. 337-TA-526, Order No. 19 (July 18, 2005) ("NAND Flash Memory") & Notice of Commission Determination Granting a Request by the Administrative Law Judge for Judicial Enforcement of a Subpoena (August 23, 2005); *Certain Encapsulated Integrated Circuit Devices and Products Containing Same*, Inv. No. 337-TA-501, Order No. 63 (June 7, 2004) & Order No. 102 (September 8, 2005) ("Encapsulated Circuits") & Notice of Commission Determination Granting a Request by the Administrative Law Judge for Judicial Enforcement of a Subpoena (July 12, 2004).

undoubtedly impose on a third party is not reasonable. As such, the ALJ finds that Microsoft has failed to show that the remaining disputed topics are relevant or that the subpoena is reasonable. Therefore, Motion No. 769-029 is hereby DENIED.

On December 14, 2011, Microsoft filed a motion for leave to take the deposition of Google, Inc. after the close of discovery, namely an extension to January 13, 2012. (Motion Docket No. 769-052.) The motion states that the respondents and the Commission Investigative Staff have not taken a position on the motion. The motion further states that Google will not oppose the extension. As of the date of this order, no responses were received.

Microsoft seeks the extension as both Microsoft and Google agree that the most efficient and complete course of action is to await resolution of Motion No. 769-029 and determination of the proper scope of the deposition. Good cause being shown and there being no opposition, Motion No. 769-052 is hereby GRANTED. The deadline for deposing Google is extended to January 13, 2012, and all the parties are granted leave to amend their direct and/or rebuttal exhibits lists to include (1) any documents produced by Google after the due date for the submission of exhibit lists and (2) excerpts from the Google deposition transcript should the deposition occur after the exhibit submission deadline.

SO ORDERED



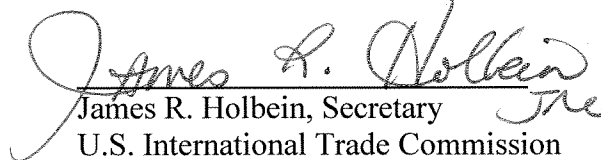
Theodore R. Essex
Administrative Law Judge

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PUBLIC CERTIFICATE OF SERVICE

I, James R. Holbein, hereby certify that the attached **ORDER 30** has been served by hand upon the Commission Investigative Attorney, **Jeffrey Hsu, Esq.**, and the following parties as indicated on **January 3, 2012**.


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PUBLIC CERTIFICATE3 OF SERVICE – PAGE TWO

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