

**UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.**

**Before The Honorable Theodore R. Essex
Administrative Law Judge**

In the Matter of

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

Investigation No. 337-TA-769

**RESPONDENTS BARNES & NOBLE, INC'S AND BARNESANDNOBLE.COM LLC'S
MOTION TO HOLD THE RECORD OPEN TO RECEIVE EVIDENCE OBTAINED
FROM NOKIA CORP. (OR ITS AFFILIATES) AND MOSAID TECHNOLOGIES INC.
(OR ITS AFFILIATES) AND REQUEST TO SHORTEN TIME TO RESPOND**

Respondents Barnes & Noble, Inc. and barnesandnoble.com llc (collectively, "Barnes & Noble") hereby request that the Court hold the record open to receive evidence obtained from Nokia Corporation ("Nokia") (or its employees or affiliates, such as Nokia Inc.) and MOSAID Technologies Inc. ("MOSAID") (or its employees or affiliates, such as MOSAID Corp. Ltd.). As explained in detail in the attached memorandum of law, there is good cause to grant the narrow relief requested.

Barnes & Noble requests that the time to respond to this Motion be shortened to two days. Barnes & Noble hopes to receive a ruling on the underlying motion as soon as possible so that Barnes & Noble may inform the Ontario Superior Court of Justice before a hearing on January 25 whether evidence produced in response to Barnes & Noble's Letter Rogatory will be considered in this Investigation.

Pursuant to Ground Rule 3.2, counsel for Barnes & Noble certifies that it has disclosed to Microsoft and the Office of Unfair Import Investigations its intention to file the present motion at least two business days prior to filing the motion. Microsoft stated that it opposes the motion, and the Staff's position is unknown.

Dated: January 19, 2011

Respectfully submitted,

/s/ Stuart W. Gold

Stuart W. Gold
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**UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.**

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In the Matter of

**CERTAIN HANDHELD ELECTRONIC
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Investigation No. 337-TA-769

**RESPONDENTS BARNES & NOBLE, INC'S AND BARNESANDNOBLE.COM LLC'S
MEMORANDUM OF LAW IN SUPPORT OF MOTION TO HOLD THE RECORD
OPEN TO RECEIVE EVIDENCE OBTAINED FROM NOKIA CORP. (OR ITS
AFFILIATES) AND MOSAID TECHNOLOGIES INC. (OR ITS AFFILIATES) AND
REQUEST TO SHORTEN TIME TO RESPOND**

Respondents Barnes & Noble, Inc. and barnesandnoble.com llc (collectively, "Barnes & Noble") hereby request that the Court hold the record open to receive evidence obtained from Nokia Corporation ("Nokia") (or its affiliates, such as Nokia Inc., and Jaakko Kaskinen, to whom a separate subpoena was issued) and MOSAID Technologies Inc. ("MOSAID") (or its affiliates, such as MOSAID Corp. Ltd.). There is good cause to grant the narrow relief requested.

Barnes & Noble requests that the time to respond to this Motion be shortened such that any response be due on January 23, 2012. Barnes & Noble hopes to receive a ruling on the underlying motion as soon as possible so that Barnes & Noble may inform the Ontario Superior Court of Justice before a hearing on January 25 whether evidence produced in response to Barnes & Noble's Letter Rogatory will be considered in this Investigation.

Pursuant to Ground Rule 3.2, counsel for Barnes & Noble certifies that it has disclosed to Microsoft and the Office of Unfair Import Investigations its intention to file the present motion at least two business days prior to filing the motion. Microsoft stated that it opposes the motion as untimely, and the Staff's position is unknown.

I. BACKGROUND.

As part of Barnes & Noble's affirmative defense of patent misuse, Barnes & Noble is alleging that Microsoft is improperly expanding the scope of trivial and outmoded patents in an attempt to impair the growth of mobile operating systems such as Android—which Barnes & Noble's Nook devices use—that pose a threat to Microsoft's dominance of PC operating systems. In the past year, Microsoft has allied itself with Nokia and MOSAID to further that strategy. Microsoft, at least in part through the threat of litigation against Nokia, has convinced Nokia to replace its Symbian operating system with Microsoft's Windows Phone operating system instead of Android. Moreover, the two companies have entered into an offensive patent arrangement with MOSAID, a patent licensing agent, whereby Nokia transferred 2,000 of its wireless communications patents to MOSAID in exchange for MOSAID's promise to license those patents (or sue those that refuse) and pay approximately two-thirds of any revenue from licensing fees or damages back to Microsoft and Nokia. One of Microsoft and Nokia's publicly stated motivations for the partnership is to combine the strength of their respective patent portfolios and to coordinate their offensive use of patents directed at the Android operating system, which is employed in Barnes & Noble devices.

On October 18, 2011, Barnes & Noble applied for the issuance of subpoenas *duces tecum* and *ad testificandum* on the U.S. subsidiaries of Nokia and MOSAID, Nokia Inc. and MOSAID Corporation Ltd., respectively. It was Barnes & Noble's understanding that this

Court requires parties seeking evidence abroad to first attempt to obtain discovery from United States subsidiaries of foreign entities when possible. *See Certain Display Devices, Including Digital Televisions and Monitors*, Inv. No. 337-TA-713, Order No. 8 (U.S.I.T.C. June 10, 2010) (Essex, ALJ). The Court issued the subpoenas on October 20, 2011.¹ (*See Declaration of Stuart W. Gold (“Gold Decl.”) Ex. 1.*) On November 7 and 8, Nokia Inc. and MOSAID Corp., respectively, moved to quash the subpoenas, which Barnes & Noble opposed. (Motion Nos. 769-024 and 769-027.) Nokia Inc. and MOSAID Corp. argued, *inter alia*, that the evidence sought was more likely located at their foreign corporate parents. Those motions are pending.

The U.S.-based subsidiaries also made clear to Barnes & Noble that the corporate parents would not voluntarily produce documents or witnesses in this Investigation. Accordingly, on November 14 and 16, Barnes & Noble moved for international judicial assistance in obtaining discovery from the corporate parents—Nokia in Finland and MOSAID in Canada. (Motion Nos. 769-031 and 769-034.) Those motions were unopposed.

On December 2, 2011, Your Honor granted both motions, issuing a Letter of Request to obtain evidence from Nokia and recommending that the United States District Court for the District of Columbia (“District Court”) issue a Letter Rogatory to obtain evidence from MOSAID.² (Order Nos. 24 and 25.) With respect to Canada, Barnes & Noble filed a motion on

¹ On November 15, 2011, Barnes & Noble also applied for the issuance of subpoenas *duces tecum* and *ad testificandum* to third party Jaakko Kaskinen upon information and belief that Mr. Kaskinen was a New York-based employee of Nokia during the relevant time period and was still present in New York. The Court issued those subpoenas on November 17, 2011.

² Barnes & Noble chose to pursue the Letter Rogatory through the District Court to avoid doubt as to whether the Canadian courts would honor a request from the ITC. *See, e.g., Certain Home Vacuum Packaging Machines*, Order, Inv. No. 337-TA-496 (U.S.I.T.C. Jan. 21, 2004) (suspending letters rogatory issued until Commission decides, *inter alia*, upon what authority it can issue letters rogatory); Ontario Evidence Act § 60 (recognizing a request for discovery from a “court or tribunal of competent jurisdiction in a foreign country” without defining “tribunal”);

December 9 in the District Court to grant a Letter Rogatory for evidence from MOSAID. There was no opposition to the District Court motion. The Clerk of the Court issued the Letter Rogatory to Canada on December 28. (Gold Decl. Ex. 2.) With respect to Finland, Barnes & Noble also promptly sent the Letter of Request to the Ministry of Justice, Finland's Central Authority. On January 3, 2012, Nokia filed what it called a "motion to quash" the Letter of Request that was approved by this Court and sent to the Finland Ministry of Justice. The fact discovery deadline on patent misuse issues closed on December 14, 2011, while the District Court motion and the U.S subsidiaries' motions to quash were still pending.

The foreign actions to enforce the Letter of Request to Nokia and Letter Rogatory to MOSAID are proceeding. Barnes & Noble has requested expedited treatment in both jurisdictions due to the fast-approaching hearing on February 6, 2012. In Canada, Barnes & Noble filed its application to enforce the Letter Rogatory in the Superior Court of Justice in Canada on January 10, 2012. (Gold Decl. Ex. 3.) An enforcement hearing is scheduled for January 25. In Finland, the Ministry of Justice did not reject the Letter of Request and instead forwarded the Letter of Request to the District Court of Espoo (the "Finland Court") for further proceedings.³ The Finland Court issued a summons⁴ to Nokia whereby Nokia was obliged to

Certain Display Devices Including Digital Televisions and Monitors, Order No. 19, Inv. No. 337-TA-713 (U.S.I.T.C. Oct. 5, 2010) (motion granted by Judge Essex recommending that the District Court issue letter rogatory).

³ In its motion for leave to submit a reply memorandum in support of its "motion to quash", Nokia claims that Barnes & Noble "misrepresented the status of the proceedings in Finland" in describing the actions of the Finland Ministry of Justice. (Nokia Proposed Reply in Support of Motion to Quash at 2.) That is false. In Finland, when processing a Letter of Request in accordance with the Hague Convention, the central authority (i.e., the Ministry of Justice) should not proceed with a Letter of Request which is not within the scope of the Convention and which does not fulfill the formal requirements of the Convention. See Hague Convention, art. 5 ("If the Central Authority considers that the request does not comply with the provisions of the present Convention, it shall promptly inform the authority of the State of origin which transmitted the

submit the documents mentioned in the Letter of Request or to submit a statement to the summons within seven days. (Gold Decl. Ex. 4.) The Finland Court also indicated that it would summon the requested witnesses to appear for depositions. Nokia requested that the Finland Court stay those proceedings until this Court rules on its “motion to quash” the Letter of Request. (Gold Decl. Ex. 5.) On January 18, 2012, the Finland Court granted Nokia’s motion to stay and extended Nokia’s time to respond to the document summons to one week from a decision on the pending “motion to quash”. (Gold Decl. Ex. 6.) The Finland Court based its ruling, in part, on the assumption that “the ITC will give its decision within a short period of time”. *Id.* at 3. Thus, all Finland proceedings are stayed until Your Honor rules on Nokia’s pending motion.

Contained in Microsoft’s discovery responses were documents pertaining to the Microsoft-Nokia-MOSAID agreements that were executed between April and September 2011, including some but not all of the relevant agreements, as well as e-mail communications between Microsoft and Nokia or MOSAID pertaining to the deal. Barnes & Noble located these documents among more than one million pages produced by Microsoft between early-October to

Letter of Request, specifying the objections to the Letter.”); *see also* Lappalainen et al, Prosessioikeus 1298–99 (2007), cited in Barnes & Noble’s Opposition to Nokia Corporation’s Motion to Quash. Accordingly, the Ministry of Justice makes a *prima facie* determination that the Letter of Request complies with Finland’s reservations to the Hague Convention, as Barnes & Noble correctly stated in its opposition to Nokia’s “motion to quash”. Nokia asserts that the Ministry of Justice supposedly told Nokia (without telling Barnes & Noble) that the Ministry of Justice “did not have jurisdiction to rule on Nokia’s argument” that the Letter of Request should be rejected, but the email cited in support of that assertion does not contain any ruling from or statement by any Finnish authority about jurisdiction or anything else. (See Proposed Reply at 3.) Nokia accuses Barnes & Noble of “misrepresenting” the procedure of the Finnish authorities but does not cite any primary or secondary authority of Finnish law whatsoever, other than the assertions of Finnish counsel.

⁴ In Finnish, “lausumapyyntö”.

early-November. Barnes & Noble deposed Microsoft executives concerning the content of these documents; however, Microsoft was unable to provide all of the information pertaining to the Microsoft-Nokia-MOSAID agreements that is relevant to and necessary for Barnes & Noble’s patent misuse defense. Accordingly, Barnes & Noble continues to seek information from Nokia and MOSAID that was not produced by Microsoft, that is internal to those companies, or that was shared between the two and not with Microsoft.

In these circumstances, Barnes & Noble has acted diligently and appropriately to secure this necessary evidence. The set of agreements were not executed until September, and most of the patent misuse documents produced by Microsoft were not in Barnes & Noble’s counsel’s possession until October and November. There is good reason to believe that as the Canadian and Finnish courts continue to enforce the requests from this Court and the U.S. District Court, the relevant evidence will be in Barnes & Noble’s possession before the end of the hearing on the merits, or soon thereafter.⁵ Therefore, Barnes & Noble requests that this Court keep the factual record in this Investigation open for the limited purpose of accepting any evidence obtained from Nokia and MOSAID, or their U.S. subsidiaries, Nokia Inc. and MOSAID Corp. Ltd., respectively, to the extent the evidence is admissible.

⁵ With regards to the Finland proceedings, Barnes & Noble’s belief that the relevant evidence will be in Barnes & Noble’s possession before the hearing on the merits, or soon thereafter, is subject to Your Honor’s decision on Nokia’s “motion to quash” the Letter of Request. The Finland Court did not accept Nokia’s request to extend the deadline for Nokia’s statement regarding the documents included in the Letter of Request to 14 days after the aforementioned decision, instead ordering Nokia to give its statement within 7 days of the decision.

II. ARGUMENT.

According to Ground Rule 2, limited discovery may occur beyond the discovery cutoff upon a showing of good cause. In addition, under Commission Rule 210.42(g), "At any time prior to the filing of the initial determination, the administrative law judge may reopen the proceedings for the reception of additional evidence." Your Honor recently approved Microsoft's request in this Investigation for fact discovery from third party Google, Inc. one month after the close of discovery (Order No. 30). Your Honor has granted a similar motion for third party discovery in another investigation. In *Certain Computer Products, Computer Components and Products Containing Same*, Order No. 18, Inv. No. 337-TA-628, 2008 ITC LEXIS 1770, at *1 (U.S.I.T.C. Sept. 30, 2008), the Court had issued third party subpoenas 10 days prior to the close of fact discovery, but the subpoenaed parties requested extensions in order to fully comply. The Court rejected respondents' argument that the third party subpoenas were untimely because the complainant did not seek approval from the Court prior to serving the subpoenas. *Id.* at *2. The Court held that there was good cause to grant the motion. *Id.*; see also *Certain Inkjet Ink Cartridges with Printheads and Components Thereof*, Order No. 23, Inv. No. 337-TA-723, 2010 ITC LEXIS 2666, at *1 (U.S.I.T.C. Dec. 21, 2010) (finding compelling circumstances to justify limited extension of fact discovery to obtain evidence from third parties).

Similarly, there is good cause in this Investigation to keep the record open in order to receive evidence obtained from Nokia and MOSAID, or their U.S. subsidiaries. First, Barnes & Noble believes that Nokia and MOSAID possess relevant, unique and non-privileged evidence which will help provide important support to Barnes & Noble's patent misuse defense. Specifically, much of the information that Barnes & Noble requests from Nokia and MOSAID,

or their U.S. subsidiaries, relates to internal business discussions regarding strategy, negotiations and long-term goals of the Microsoft-Nokia and Microsoft-Nokia-MOSAID patent agreements, as well as the threat posed by Android to the Microsoft-Nokia partnership. Documents and testimony concerning these and related topics are highly relevant and bear directly on Barnes & Noble's patent misuse defense. Accordingly, Barnes & Noble's defense would be prejudiced without such evidence.

Second, the Court approved both of Barnes & Noble's unopposed requests for international judicial assistance 12 days prior to the close of fact discovery, with full knowledge that the international process is lengthy and would not likely be complete before the cutoff. Under Ground Rule 4.4.5, the Court's granting of those requests constitutes advance approval of discovery requests that would require responses past the discovery cutoff.⁶ Since the time the unopposed motions were filed and granted, Barnes & Noble has incurred considerable time and expense pursuing the Letters of Request overseas. Microsoft should not be allowed to claim, after the fact, that the motions should not have been granted, when Barnes & Noble has already relied on the granting of those motions and when Microsoft chose not to exercise its right to oppose the motions. Moreover, Barnes & Noble filed its subpoenas on the U.S. subsidiaries well in advance of the close of fact discovery, and the U.S. subsidiaries' motions to quash were fully briefed one month prior to the close of fact discovery.

Third, as discussed above, Barnes & Noble promptly filed its applications for the U.S. subpoenas and the requests for international judicial assistance as soon as it had a sufficient basis for such applications. The agreements between Microsoft, Nokia and MOSAID were not

⁶ According to Ground Rule 4.4.5, "Discovery requests by any party that would require responses after the fact discovery cutoff and completion date must be approved in advance by the Administrative Law Judge upon a showing of compelling circumstances."

executed until September 2011, and Barnes & Noble began seeking documents from Nokia and MOSAID affiliates at the time the agreements were produced in mid-October.

Fourth, any claim that Microsoft would be prejudiced by keeping the record open would be not credible. Microsoft did not oppose the initial motions for international assistance even though the motions were filed one month before the close of discovery. Nor did Microsoft oppose the request in the U.S. District Court to issue a Letter Rogatory even though that request was filed less than one week before the close of discovery. It was not until Barnes & Noble gave notice of this motion that Microsoft ever expressed concern to Barnes & Noble that the requests were untimely or that Microsoft might be harmed if evidence from Nokia or MOSAID were produced after the close of discovery. Microsoft's newfound position that the Letters of Request are untimely is an attempt to reap improper advantage from its decision not to oppose the initial motions. Any arguments that the Letter of Request might result in discovery past the cutoff were available to Microsoft in December when the motions were filed and when Microsoft chose not to oppose them, and any such arguments should be deemed waived. In addition, the U.S. subpoenas were issued on October 20, 2011, almost two months prior to the close of fact discovery, and the U.S. subsidiaries' motions to quash were fully briefed by mid-November.

Microsoft's sudden objection to evidence from Nokia and MOSAID cannot be explained by any supposed unfair prejudice to Microsoft's ability to present its case. Microsoft is already familiar with the details of its ongoing business relationships with Nokia and MOSAID, whereas Barnes & Noble is still analyzing those relationships, and therefore the late production of this evidence in fact prejudices Barnes & Noble at least as much as, if not more than, Microsoft.

Ultimately, if any prejudice to Microsoft exists, it is due to Microsoft's refusal to produce documents in a timely manner. Microsoft possessed relevant documents related to Nokia yet withheld them until mid-October 2011, in clear violation of Your Honor's Ground Rules. Similarly, Microsoft has never explained the six-week delay in between the time the MOSAID agreements were executed and the time they were produced in October 2011. Barnes & Noble endeavored to wait until those documents were produced by Microsoft before burdening the courts of foreign jurisdictions, but Microsoft impeded that effort. Barnes & Noble has acted diligently in reviewing Microsoft's enormous and tardy production, identifying issues that were not sufficiently addressed in Microsoft's production, seeking subpoenas on the U.S. subsidiaries, preparing the necessary unopposed motions to initiate international discovery, obtaining Letters of Request through the proper channels and enforcing those Letters of Request in the appropriate judicial fora. Those efforts should not be rendered moot.

III. REQUEST TO SHORTEN TIME TO RESPOND.

Under all the circumstances of this matter, Barnes & Noble requests that the deadline to respond to this Motion be shortened such that any response is due January 23, 2012. Barnes & Noble hopes to receive a ruling on the underlying motion as soon as possible in order to inform the Canada court at a hearing on January 25, 2012, whether the evidence requested from MOSAID will be considered in the Investigation. In addition, the time to respond should be shortened given the upcoming hearing date in the Investigation and given Microsoft's failure to take advantage of its earlier opportunity to object to the Letters of Request.

IV. CONCLUSION.

For the foregoing reasons, Barnes & Noble respectfully requests that the Court hold the record open to receive evidence obtained from Nokia and MOSAID, or their U.S. subsidiaries, Nokia Inc. and MOSAID Corp. Ltd., respectively.

Dated: January 19, 2011

Respectfully submitted,

/s/ Stuart W. Gold

Stuart W. Gold
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*Counsel for Respondents Barnes & Noble, Inc.
and barnesandnoble.com llc*

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

Before the Honorable Theodore R. Essex
Administrative Law Judge

In the Matter of

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

Investigation No. 337-TA-769

DECLARATION OF STUART W. GOLD IN SUPPORT OF RESPONDENTS BARNES & NOBLE, INC.'S AND BARNESANDNOBLE.COM LLC'S MOTION TO HOLD THE RECORD OPEN TO RECEIVE EVIDENCE OBTAINED FROM NOKIA CORP. (OR ITS AFFILIATES) AND MOSAID TECHNOLOGIES INC. (OR ITS AFFILIATES) AND REQUEST TO SHORTEN TIME TO RESPOND

I, STUART W. GOLD, hereby declare the following under penalty of perjury:

1. I am a member of the firm of Cravath, Swaine & Moore LLP, attorneys for Respondents Barnes & Noble, Inc and barnesandnoble.com llc (collectively, "Barnes & Noble"). I respectfully submit this Declaration in support of Barnes & Noble's Motion to Hold the Record Open to Receive Evidence Obtained from Nokia Corp. (or its affiliates) and MOSAID Technologies Inc. (or its affiliates) and Request to Shorten the Time to Respond.

2. Attached hereto as Exhibit 1 is a true and correct copy of Barnes & Noble's Ex Parte Application for Issuance of Subpoenas *Duces Tecum* and *Ad Testificandum* to Nokia Inc. and MOSAID Corp. Ltd., filed October 18, 2011, and the subpoenas to Nokia Inc. and MOSAID Corp. Ltd. issued by Judge Essex on October 20, 2011 (excluding the Protective Orders at Attachment B).

3. Attached hereto as Exhibit 2 is a true and correct copy of Barnes & Noble's Request for International Judicial Assistance (Letter Rogatory) to MOSAID Technologies Inc.

issued by the Deputy Clerk of the United States District Court for the District of Columbia on December 28, 2011, and file stamped on December 23, 2011 (excluding the Protective Order at Addendum C).

4. Attached hereto as Exhibit 3 is a true and correct copy of Barnes & Noble's Application Record for enforcement of the Request for International Judicial Assistance (Letter Rogatory) to MOSAID Technologies Inc. filed in the Ontario Superior Court of Justice in Court File No. 12-53320 on January 10, 2012 (excluding the Exhibits attached to the Affidavit of Brendon DeMay sworn January 9, 2012), as well as the Factum of the Applicants filed January 11, 2012.

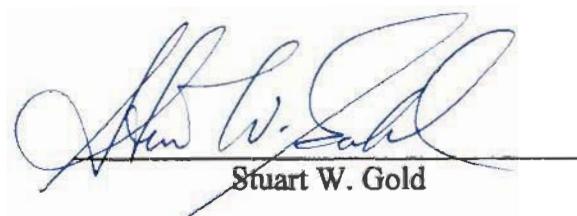
5. Attached hereto as Exhibit 4 is a true and correct copy of the District Court of Espoo's Request for Statement from Nokia Corp. in H11/16979, dated January 5, 2012, as well as a certified English translation.

6. Attached hereto as Exhibit 5 is a true and correct copy of Nokia Corp.'s Request that the District Court of Espoo stay the proceedings regarding the Letter of Request in H11/16979, dated January 11, 2012, as well as a certified English translation.

7. Attached hereto as Exhibit 6 is a true and correct copy of the District Court of Espoo's Decision regarding Nokia Corp.'s Request to stay the proceedings in H11/16979, dated January 18, 2012, as well as a certified English translation.

Dated: January 19, 2012

New York, New York



The image shows a handwritten signature in black ink, which appears to read "Stuart W. Gold". Below the signature, there is a horizontal line. Underneath the line, the name "Stuart W. Gold" is printed in a smaller, standard font.

EXHIBIT 1

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

Before The Honorable Theodore R. Essex
Administrative Law Judge

In the Matter of

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

Investigation No. 337-TA-769

**RESPONDENTS BARNES & NOBLE, INC.'S AND BARNESANDNOBLE.COM
LLC'S EX PARTE APPLICATION FOR ISSUANCE OF SUBPOENAS *DUCES
TECUM* AND SUBPOENAS *AD TESTIFICANDUM* TO NOKIA INC. AND
MOSAID CORP. LTD.**

Pursuant to 19 C.F.R. § 210.32, and Ground Rule 4.6.1, Respondents Barnes & Noble, Inc. and barnesandnoble.com LLC (collectively “Barnes & Noble”) respectfully apply for leave to serve subpoenas *duces tecum* and *ad testificandum* on third parties Nokia Inc. and MOSAID Corporation Ltd. Copies of Barnes & Noble's proposed subpoenas accompany this application as Exhibits 1 and 2.

Complainant Microsoft Corp. (“Microsoft”) and Nokia Corp. (“Nokia”) entered into a partnership agreement on or about April 21, 2010, whereby, among other things, Microsoft agreed to pay Nokia \$1 billion and Nokia agreed to replace its Symbian operating system with Microsoft’s Windows Phone 7 operating system as its principal smartphone strategy. According to statements by Nokia’s CEO Stephen Elop, as part of that agreement, Microsoft and Nokia discussed the strength of their combined intellectual property portfolio and agreed to a coordinated offensive strategy to assert patents against competitors, such as the Android™ Operating System that Microsoft alleges infringes on

its asserted patents.¹ Indeed, Mr. Elop has publicly stated that the Android™ Operating System poses the greatest threat to Nokia's and Microsoft's mobile businesses.²

In addition, Microsoft, Nokia and MOSAID Technologies Inc. ("MOSAID") entered into an agreement on or about September 1, 2011, whereby, among other things, MOSAID acquired 2000 Nokia patents for free and agreed to license the patents and pay 2/3 of any royalties to Microsoft and Nokia.

Given the stated goals and reasons for the Microsoft-Nokia partnership and related agreement, the scope of the documents and testimony requested is both reasonable and relevant to this investigation. It is expected that Nokia will provide documents and testimony concerning Nokia's and Microsoft's business partnership; Nokia's and Microsoft's agreement regarding the use of their combined intellectual property portfolio; the connection between Microsoft's demand that Barnes & Noble enter into a licensing agreement to use the Android™ Operating System and its coordinated intellectual property strategy with Nokia; Microsoft's and Nokia's attempt to increase their share of the mobile operating system and mobile device markets; and the competitive threat that the Android™ Operating System poses to their mobile businesses and to Microsoft's PC operating system business. It is expected that MOSAID will

¹ See "Nokia Conversations: Q&A videos, break down", available at <http://conversations.nokia.com/2011/02/22/qa-videos-break-down> ("It is the case, and it was absolutely discussed with Microsoft, that Microsoft plus Nokia has a remarkably strong intellectual property portfolio. That is something that we will use appropriately within the context of our ecosystem, which means both defending the ecosystem from outside attacks as well as appropriately ensuring that the value that we have created through our patents are properly collected from other people who may choose to take advantage of that technology.").

² See id.

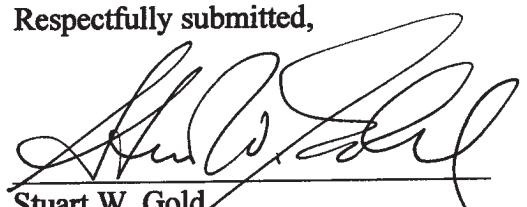
provide documents and testimony concerning its business arrangement with Microsoft and Nokia, as well as the connection between Microsoft's demand that Barnes & Noble enter into a licensing agreement to use the Android™ Operating System and its coordinated intellectual property strategy with Nokia and MOSAID.

This information, which Barnes & Noble believes it will be unable to obtain by alternate means, will bear directly on several issues in this investigation, including Barnes & Noble's First Affirmative Defense (Unenforceability Due to Patent Misuse). The requested information will demonstrate that Microsoft is broadening its patent portfolio as part of its campaign to use minor patents to suppress competition from Android and protect its monopoly in PC operating systems.

For the reasons set forth above, Barnes & Noble respectfully requests that the attached subpoenas be issued. Barnes & Noble will serve the subpoenas and this application on the next business day after the subpoenas are issued by overnight courier or by any other method specified by the Administrative Law Judge.

Dated: October 18, 2011

Respectfully submitted,



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**UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.**

**Before The Honorable Theodore R. Essex
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Investigation No. 337-TA-769

SUBPOENA DUCES TECUM

TO: NOKIA INC.
c/o National Registered Agents, Inc.
875 Avenue of the Americas, Suite 501
New York, NY 10001

**BY OVERNIGHT DELIVERY OR BY HAND WITHIN ONE BUSINESS DAY
OF ISSUANCE**

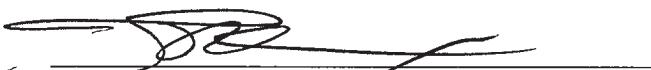
TAKE NOTE: By authority of sections 333 and 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), 5 U.S.C. § 556(c)(2), and pursuant to 19 C.F.R. § 210.32 of the Rules of Practice and Procedure of the United States International Trade Commission, and upon an application of subpoena made by Respondents Barnes & Noble, Inc. and barnesandnoble.com llc,

YOU ARE HEREBY ORDERED to produce at KENYON & KENYON, LLP, One Broadway, New York, NY 10004, on or before November 1, 2011, or at such other time and place agreed upon, all of the documents and things in your possession, custody or control which are listed and described in Attachment A hereto. Such production will be for the purpose of inspection and copying, as desired.

If production of any document listed and described in Attachment A hereto is withheld on the basis of a claim of privilege, each withheld document shall be separately identified in a privileged document list. The privileged document list must identify each document separately, specifying for each document at least: (1) the date; (2) author(s)/sender(s); (3) recipient(s), including copy recipient(s); and (4) general subject matter of the document. The sender(s) and recipient(s) shall be identified by position and entity (corporation or firm, etc.) with which they are employed or associated. If the sender or the recipient is an attorney or a foreign patent agent, he or she shall be so identified. The type of privilege claimed must also be stated, together with a certification that all elements of the claimed privilege have been met and have not been waived with respect to each document.

If any of the documents or things listed and described in Attachment A hereto are considered "confidential business information", as that term is defined in the Protective Order (Order No. 1) attached hereto, such documents or things shall be produced subject to the terms and provisions of the Protective Order. Any motion to limit or quash this subpoena shall be filed within ten (10) days after the receipt hereof. At the time of filing any motion concerning this subpoena, two courtesy copies shall be served concurrently on the Administrative Law Judge at his office.

IN WITNESS WHEREOF the undersigned of the United States International Trade Commission has hereunto set his hand and caused the seal of said United States International Trade Commission to be affixed at Washington, D.C. on this 20th day of October, 2011.



Theodore R. Essex
Administrative Law Judge
United States International Trade Commission

**UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.**

**Before The Honorable Theodore R. Essex
Administrative Law Judge**

In the Matter of

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

Investigation No. 337-TA-769

SUBPOENA AD TESTIFICANDUM

TO: NOKIA INC.
c/o National Registered Agents, Inc.
875 Avenue of the Americas, Suite 501
New York, NY 10001

**BY OVERNIGHT DELIVERY OR BY HAND WITHIN ONE BUSINESS DAY
OF ISSUANCE**

TAKE NOTE: By authority of sections 333 and 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), 5 U.S.C. § 556(c)(2), and pursuant to 19 C.F.R. § 210.32 of the Rules of Practice and Procedure of the United States International Trade Commission, and upon an application of subpoena made by Respondents Barnes & Noble, Inc. and barnesandnoble.com llc,

YOU ARE HEREBY ORDERED to identify and cause the most knowledgable individual(s) to appear for purposes of a deposition upon oral examination on November 8, 2011, at Cravath, Swaine & Moore LLP, 825 Eighth Avenue, New York, NY 10019, at 9:30 a.m., or at such other time and place agreed upon, concerning the subject matter set forth in Attachment A hereto.

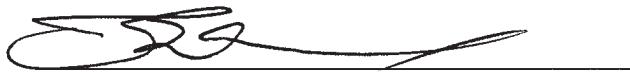
This deposition will be taken before a Notary Public or other person authorized to administer oaths and will continue from day to day until completed.

If any of your testimony is considered "confidential business information", as that term is defined in the Protective Order (Order No. 1) attached hereto, such testimony shall be so designated and treated according to the terms and provisions of the Protective Order

Any motion to limit or quash this subpoena shall be filed within ten (10) days after the receipt hereof. At the time of filing any motion concerning this subpoena, two

courtesy copies shall be served concurrently on the Administrative Law Judge at his office.

IN WITNESS WHEREOF the undersigned of the United States International Trade Commission has hereunto set his hand and caused the seal of said United States International Trade Commission to be affixed at Washington, D.C. on this 20th day of October, 2011.



Theodore R. Essex
Administrative Law Judge
United States International Trade Commission

ATTACHMENT A

REQUESTS FOR PRODUCTION

REQUEST FOR PRODUCTION NO. 1

All documents and things, including any document or thing exchanged between Nokia and Microsoft or MOSAID, relating to Barnes & Noble's Nook™ and Nook Color™ products.

REQUEST FOR PRODUCTION NO. 2

All documents and things, including any document or thing exchanged between Nokia and Microsoft or MOSAID, relating to any agreement, partnership, joint venture, understanding, negotiation, discussion or communication with Microsoft or MOSAID concerning the assertion of intellectual property rights against devices using the Android operating system.

REQUEST FOR PRODUCTION NO. 3

All documents relating to the agreement or partnership announced with Microsoft announced on or about February 11, 2011, including Nokia's or Microsoft's strategy or rationale regarding its decision to enter into the agreement or partnership.

REQUEST FOR PRODUCTION NO. 4

All documents and things relating to Nokia CEO Stephen Elop's statements to the press on or about February 13, 2011 that "More than anything else, this Windows phone ecosystem must compete effectively with Android" and that "[Nokia's] number one priority is to compete with Android".

REQUEST FOR PRODUCTION NO. 5

All documents and things relating to Nokia CEO Stephen Elop's statement on or about February 13, 2011, that "It is the case, and it was absolutely a topic of discussion with Microsoft, that Microsoft plus Nokia has a remarkably strong intellectual property portfolio. That is something that we will use appropriately within the context of our ecosystem, which means both defending the ecosystem from outside attacks as well as appropriately ensuring that the value that we have created through our patents are properly collected from other people who may choose to take advantage of that technology".

REQUEST FOR PRODUCTION NO. 6

All documents and things relating to the agreement entered into by Microsoft and Nokia on or about April 21, 2011.

REQUEST FOR PRODUCTION NO. 7

All documents and things, including any document or thing exchanged between Microsoft and Nokia, relating to any evaluation, assessment, analysis, discussion or communication concerning Microsoft's and Nokia's combined intellectual property portfolio.

REQUEST FOR PRODUCTION NO. 8

All documents and things, including any document or thing exchanged between Nokia and Microsoft or MOSAID, relating to the Patents-in-Suit or to any patent(s) that Nokia, Microsoft or MOSAID believes controls or dominates the Android™ Operating System.

REQUEST FOR PRODUCTION NO. 9

All documents and things relating to any evaluation, assessment or analysis of Nokia's offensive or defensive use of intellectual property rights, including all documents and

things relating to any evaluation, assessment or analysis of its licensing practices or litigation strategy concerning intellectual property rights.

REQUEST FOR PRODUCTION NO. 10

All documents and things, including any document or thing exchanged between Nokia and Microsoft or MOSAID, relating to the Android™ Operating System or any other open source operating system.

REQUEST FOR PRODUCTION NO. 11

All documents and things, including any document or thing relating to or constituting meeting minutes, handouts or notes, relating to the impact of the Android™ Operating System or any other open source operating system on Nokia's or Microsoft's businesses, including all documents and things relating to any evaluation, assessment, analysis, plan or strategy regarding mobile devices or tablet computers, including mobile devices or tablet computers running open source operating systems.

REQUEST FOR PRODUCTION NO. 12

All documents and things, including any document exchanged between Nokia and Microsoft or MOSAID, relating to Nokia's and Microsoft's plans, strategies or efforts to increase their collective share or individual shares of the mobile device market, mobile operating system market or PC operating system market.

REQUEST FOR PRODUCTION NO. 13

All documents and things relating to any evaluation, assessment or analysis of current or projected market share, including global market share and U.S. market share, of mobile devices and/or mobile operating systems.

REQUEST FOR PRODUCTION NO. 14

All documents and things relating to the agreement entered into by MOSAID and Core Wireless on or about September 1, 2011.

REQUEST FOR PRODUCTION NO. 15

All documents relating to Nokia's strategy or rationale regarding its decision, announced on or about September 1, 2011, to enter into a revenue sharing arrangement with Microsoft and MOSAID.

REQUEST FOR PRODUCTION NO. 16

All documents and things relating to any discussion, evaluation, assessment, plan, strategy or analysis of MOSAID's planned or predicted offensive or defensive use of intellectual property rights, including all documents and things relating to any discussion, evaluation, assessment, plan or analysis of its potential licensing or litigation strategy regarding the patent portfolio of Core Wireless or any potential role played or to be played by Microsoft or Nokia in licensing or asserting MOSAID's patents.

DEPOSITION TOPICS

1. The subject matter of the documents responsive to this subpoena, including the documents produced by you in response to this subpoena.
2. Any discussions with Microsoft or MOSAID relating to Barnes & Noble's Nook™ and Nook Color™ products.
3. Any agreement, partnership, joint venture, understanding, negotiation, discussion or communication with Microsoft or MOSAID concerning the assertion of intellectual property rights against devices using the Android operating system.

4. The agreement or partnership announced with Microsoft announced on or about February 11, 2011, including Nokia's or Microsoft's strategy or rationale regarding its decision to enter into the agreement or partnership.

5. The role of Nokia's CEO Stephen Elop in developing a coordinated strategy with Microsoft to compete with the Android™ Operating System or any other open source operating system.

6. Any discussion between Nokia and Microsoft, including any discussions between CEO Stephen Elop and Microsoft CEO Steven Ballmer, about Nokia's and Microsoft's partnership agreement, Nokia's and Microsoft's combined intellectual property portfolio, the Android™ Operating System or any other open source operating system.

7. The agreement entered into by Microsoft and Nokia on or about April 21, 2011.

8. Any evaluation, assessment, analysis, discussion or communication concerning Microsoft's and Nokia's combined intellectual property portfolio.

9. Nokia's knowledge of the Patents-in-Suit or any other patent(s) that Nokia, Microsoft or MOSAID claims controls or dominates the Android™ Operating System or any other open source operating system.

10. Nokia's offensive and defensive use of its intellectual property portfolio, including its licensing practices and litigation strategy.

11. Nokia's business plans or strategies relating to open source software, including its business plans relating to the Android™ Operating System or any other open source operating system.

12. The impact or effect of the Android™ Operating System or any other open source operating system on Nokia's or Microsoft's businesses, including businesses relating to mobile devices and tablet computers.

13. Nokia's and Microsoft's plans, strategies or efforts to increase their collective share or individual shares of the mobile device market, mobile operating system market or PC operating system market.

14. Any evaluation, assessment or analysis of current or projected market share, including global market share and U.S. market share, of mobile devices and mobile operating systems.

15. The agreement entered into by MOSAID and Core Wireless on or about September 1, 2011.

16. Nokia's strategy or rationale regarding its decision, announced on or about September 1, 2011, to enter into a revenue sharing arrangement with Microsoft and MOSAID.

17. Any discussion, evaluation, assessment, plan, strategy or analysis of MOSAID's planned or predicted offensive or defensive use of intellectual property rights, including all documents and things relating to any discussion, evaluation, assessment, plan or analysis of its potential licensing or litigation strategy regarding the patent portfolio of Core Wireless or any potential role played or to be played by Microsoft or Nokia in licensing or asserting MOSAID's patents.

DEFINITIONS

The Requests for Production and Deposition Topics, as well as the Definitions themselves and the Instructions, are subject to and incorporate the following definitions, regardless of whether upper or lower case letters are used:

1. The phrase "this Investigation" shall mean the above-captioned investigation,
Certain Handheld Electronic Computing Devices, Related Software and Components Thereof,
Inv. No. 337-TA-769.

2. "Nokia", "you" and "your" refer to Nokia Corporation, including, without limitation, all of its corporate locations, and all predecessors, predecessors-in-interest, subsidiaries, parents, and affiliates, and all past or present directors, officers, agents, representatives, employees, consultants, attorneys, entities acting in joint venture, licensing agreements, or partnership relationships with Nokia and others acting on behalf of Nokia.

3. "Microsoft" refers to Complainant Microsoft Corporation, including, without limitation, all of its corporate locations, and all predecessors, predecessors-in-interest, subsidiaries, parents, and affiliates, and all past or present directors, officers, agents, representatives, employees, consultants, attorneys, entities acting in joint venture, licensing agreements, or partnership relationships with Microsoft and others acting on behalf of Microsoft.

4. "MOSAID" refers to MOSAID Technologies Incorporated, including, without limitation, all of its corporate locations, and all predecessors, predecessors-in-interest, subsidiaries, parents, and affiliates, and all past or present directors, officers, agents, representatives, employees, consultants, attorneys, entities acting in joint venture, licensing agreements, or partnership relationships with MOSAID and others acting on behalf of MOSAID.

5. "Core Wireless" refers to Core Wireless Licensing S.a.r.l., including, without limitation, all of its corporate locations, and all predecessors, predecessors-in-interest, subsidiaries, parents, and affiliates, and all past or present directors, officers, agents,

representatives, employees, consultants, attorneys, entities acting in joint venture, licensing agreements, or partnership relationships with Core Wireless and others acting on behalf of Core Wireless.

6. “Barnes & Noble” refers collectively to Respondents Barnes & Noble, Inc. and barnesandnoble.com llc.

7. “Nook™” shall mean Barnes & Noble’s black & white Nook™ referenced in the Complaint filed in this Investigation, as well as the All-New Nook™.

8. “Nook Color™” shall mean Barnes & Noble’s Nook Color™ product referenced in the Complaint filed in this Investigation.

9. “Patents-in-Suit” refers collectively and individually to U.S. Patent No. 5,778,372, U.S. Patent No. 5,889,522, U.S. Patent No. 6,339,780, U.S. Patent No. 6,891,551, and U.S. Patent No. 6,957,223, as well as those patents identified by Microsoft in discussions that led to this Investigation, including U.S. Patent No. 5,579,517, U.S. Patent No. 5,652,913, U.S. Patent No. 5,758,352, U.S. Patent No. 6,791,536 and U.S. Patent No. 6,897,853.

10. The term “U.S.” shall mean the fifty states, the District Columbia and Puerto Rico.

11. “Communication” or “communications” shall mean, without limitation, any transmittal, conveyance or exchange of a word, statement, fact, thing, idea, document, instruction, information, demand, question or other information by any medium, whether by written, oral or other means, including electronic communications and electronic mail.

12. “Relating to”, “Related to”, “Referring” and “Concerning” shall mean in whole or in part constituting, containing, embodying, reflecting, describing, analyzing, identifying,

mentioning, stating, referring directly or indirectly to, dealing with or in any way pertaining to.

13. "Documents" shall be construed under the broadest possible construction under Federal Rule of Civil Procedure 34 and Federal Rule of Evidence 1001. The term shall include without limitation any written, recorded, graphic, or other matter, whether sent or received or made or used internally, however produced or reproduced and whatever the medium on which it was produced or reproduced (whether on paper, cards, charts, file, or printouts; tapes, discs, belts, video tapes, audiotapes, tape recordings, cassettes, or other types of voice recording or transcription; computer tapes, databases, e-mails; pictures, photographs, slides, films, microfilms, motion pictures; or any other medium), and any other tangible item or thing of readable, recorded, or visual material of whatever nature including without limitation originals, drafts, and all non-identical copies of each document (which, by reason of any variation, such as the presence of absence of hand-written notes or underlining, represents a distinct version). By way of example, the term "document(s)" as used herein shall include, without limitation: correspondence; blueprints; memoranda; notes; diaries; letters; telegraphs; telegrams; telexes; e-mails; metadata; minutes; agendas; contracts; reports; studies; checks; statements; receipts; returns; summaries; pamphlets; circulars; press releases; advertisements; books; inter-office and intra-office communications; handwritten or typewritten notes; notations or summaries of telephone conversations, meetings, or conferences; bulletins; computer printouts; databases; teletypes; telefax; invoices; worksheets; photographs; tape recordings; and all other tangible items of readable, recorded, or visual material of any kind.

14. "Thing" shall be construed under the broadest possible construction under the Federal Rules of Civil Procedure.

15. The terms "and" and "or" shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the request for production all responses that might otherwise be construed to be outside of its scope.

16. The terms "any" and "all" shall mean "any and all".

17. The term "including" shall mean "including but not limited to".

18. The use of the singular form of any word includes the plural and vice versa.

19. The use of a verb in any tense shall be construed as the use of the verb in all other tenses.

INSTRUCTIONS

1. Produce all documents and things, wherever located, described in the Requests for Production, that are in your possession, custody or control, or in the possession, custody or control of your agents, attorneys, employees, affiliates or other persons acting or purporting to act under your control or on your behalf, including any documents or communications on any personal computer, disk or drive, or any similar data storage device.

3. Identify and designate the most knowledgeable individual(s) to appear and give testimony as it relates to the Deposition Topics described above.

2. Written responses to the Requests for Production are required pursuant to 19 C.F.R. § 210.30(b)(2).

3. State, for each Request for Production, whether or not there exist any documents or things within the scope of the request and whether any such documents or things are in your possession, custody or control.

4. All documents that respond, in whole or in part, to any portion of any request shall be produced in their entirety, including all attachments and enclosures.

5. If you object to any Request for Production, please state with specificity the grounds for each such objection.

6. Any response made by reference to documents shall identify each responsive document by its Bates number(s).

7. Documents and things shall be produced exactly in the manner in which they are maintained in your files. Electronic data and computerized information must be produced in an intelligible format, together with a description of the system from which they were derived sufficient to permit rendering the records and information intelligible.

8. Responsive documents and things are to be clearly designated so as to reflect their owner and/or custodian and the location from where they were produced.

9. Where an identified document is in a language other than English, state whether an English translation of such document exists. If a document is in a language other than English and an English translation exists, identify and provide both documents.

10. If any document is being withheld under a claim of privilege or otherwise, provide a privileged document list in accordance with the requirements set forth in the Subpoena issued by Administrative Law Judge Essex within ten (10) days of the date on which the answers and objections to these requests are due.

11. If your response to a particular Request for Production is a statement that you lack the ability to comply with that request, you must specify whether the inability to comply is because the particular item or category of information never existed, has been destroyed, has been lost, misplaced, or stolen, or has never been, or is no longer, in your possession, custody, or control, in which case the name and address of any person or entity known or

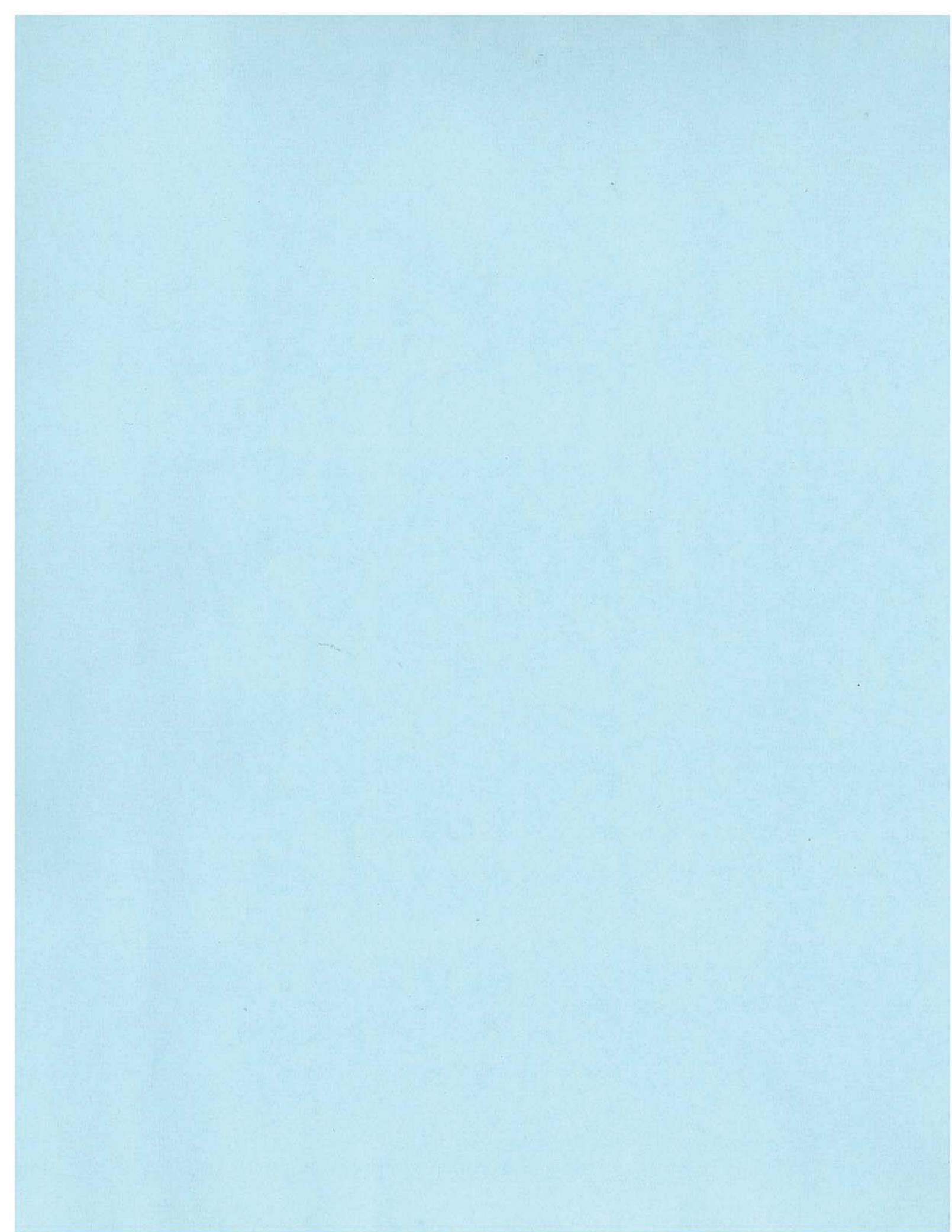
believed by you to have possession, custody, or control of that information or category of information must be identified.

12. For any information requested that is not readily available from your records in the form requested, furnish carefully prepared estimates, designated as such. Attach a statement of the basis for such estimates and identify the person or persons making them.

13. In the event that any responsive document called for by these Requests for Production or subsequent requests has been destroyed or discarded then, separately for each such document, identify: (a) the author(s), addressee(s) and any indicated or blind copyee(s); (b) the document's date, number of pages and attachments or appendices; (c) the document's subject matter; (d) the date of destruction or discard, manner of destruction or discard, and reason for destruction or discard and by whom it was destroyed or discarded; (e) the persons who were authorized to carry out such destruction or discard; (f) whether any copies of the document presently exist and, if so, the name of the custodian of each copy; and (g) the circumstances under which the document was destroyed or discarded.

14. If no documents exist that are responsive to a particular request for production, that fact should be stated in each of your responses to such requests.

15. Please mark each page which you consider to contain confidential business information in accordance with the Protective Order, attached hereto, issued in this Investigation.



**UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.**

**Before The Honorable Theodore R. Essex
Administrative Law Judge**

In the Matter of

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

Investigation No. 337-TA-769

SUBPOENA DUCES TECUM

TO: **MOSAID CORPORATION LTD.**
c/o John Lindgren
5700 Granite Parkway
Suite 960
Plano, TX 75024

TAKE NOTE: By authority of sections 333 and 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), 5 U.S.C. § 556(c)(2), and pursuant to 19 C.F.R. § 210.32 of the Rules of Practice and Procedure of the United States International Trade Commission, and upon an application of subpoena made by Respondents Barnes & Noble, Inc. and barnesandnoble.com llc,

YOU ARE HEREBY ORDERED to produce at KENYON & KENYON, LLP, One Broadway, New York, NY 10004, on or before November 1, 2011, or at such other time and place agreed upon, all of the documents and things in your possession, custody or control which are listed and described in Attachment A hereto. Such production will be for the purpose of inspection and copying, as desired.

If production of any document listed and described in Attachment A hereto is withheld on the basis of a claim of privilege, each withheld document shall be separately identified in a privileged document list. The privileged document list must identify each document separately, specifying for each document at least: (1) the date; (2) author(s)/sender(s); (3) recipient(s), including copy recipient(s); and (4) general subject matter of the document. The sender(s) and recipient(s) shall be identified by position and entity (corporation or firm, etc.) with which they are employed or associated. If the sender or the recipient is an attorney or a foreign patent agent, he or she shall be so identified. The type of privilege claimed must also be stated, together with a certification that all elements of the claimed privilege have been met and have not been waived with respect to each document.

If any of the documents or things listed and described in Attachment A hereto are considered "confidential business information", as that term is defined in the Protective Order (Order No. 1) attached hereto, such documents or things shall be produced subject to the terms and provisions of the Protective Order. Any motion to limit or quash this subpoena shall be filed within ten (10) days after the receipt hereof. At the time of filing any motion concerning this subpoena, two courtesy copies shall be served concurrently on the Administrative Law Judge at his office.

IN WITNESS WHEREOF the undersigned of the United States International Trade Commission has hereunto set his hand and caused the seal of said United States International Trade Commission to be affixed at Washington, D.C. on this 20TH day of OCTOBER, 2011.



Theodore R. Essex
Administrative Law Judge
United States International Trade Commission

**UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.**

**Before The Honorable Theodore R. Essex
Administrative Law Judge**

In the Matter of

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

Investigation No. 337-TA-769

SUBPOENA AD TESTIFICANDUM

TO: MOSAID CORPORATION LTD.
c/o John Lindgren
5700 Granite Parkway
Suite 960
Plano, TX 75024

**BY OVERNIGHT DELIVERY OR BY HAND WITHIN ONE BUSINESS DAY
OF ISSUANCE**

TAKE NOTE: By authority of sections 333 and 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), 5 U.S.C. § 556(c)(2), and pursuant to 19 C.F.R. § 210.32 of the Rules of Practice and Procedure of the United States International Trade Commission, and upon an application of subpoena made by Respondents Barnes & Noble, Inc. and barnesandnoble.com llc,

YOU ARE HEREBY ORDERED to identify and cause the most knowledge individual(s) to appear for purposes of a deposition upon oral examination on November 9, 2011, at Cravath, Swaine & Moore LLP, 825 Eighth Avenue, New York, NY 10019, at 9:30 a.m., or at such other time and place agreed upon, concerning the subject matters set forth in Attachment A hereto.

This deposition will be taken before a Notary Public or other person authorized to administer oaths and will continue from day to day until completed.

If any of your testimony is considered “confidential business information”, as that term is defined in the Protective Order (Order No. 1) attached hereto, such testimony shall be so designated and treated according to the terms and provisions of the Protective Order

Any motion to limit or quash this subpoena shall be filed within ten (10) days after the receipt hereof. At the time of filing any motion concerning this subpoena, two

courtesy copies shall be served concurrently on the Administrative Law Judge at his office.

IN WITNESS WHEREOF the undersigned of the United States International Trade Commission has hereunto set his hand and caused the seal of said United States International Trade Commission to be affixed at Washington, D.C. on this 20TH day of OCTOBER, 2011.



Theodore R. Essex
Administrative Law Judge
United States International Trade Commission

ATTACHMENT A

REQUESTS FOR PRODUCTION

REQUEST FOR PRODUCTION NO. 1

All documents and things, including any document or thing exchanged between MOSAID and Microsoft or Nokia, relating to Barnes & Noble's Nook™ and Nook Color™ products, or any alleged infringement by Barnes & Noble.

REQUEST FOR PRODUCTION NO. 2

All documents and things relating to the agreement entered into by MOSAID and Core Wireless on or about September 1, 2011, including MOSAID's strategy or rationale regarding its decision to acquire Core Wireless, the patent portfolio of Core Wireless and the licensing of the patent portfolio of Core Wireless.

REQUEST FOR PRODUCTION NO. 3

All documents relating to MOSAID's revenue sharing arrangement with Microsoft and Nokia, announced on or about September 1, 2011.

REQUEST FOR PRODUCTION NO. 4

All documents and things from July 1, 2009 to date, including any document or thing exchanged between MOSAID and Microsoft or Nokia, relating to any agreement, partnership, joint venture, understanding, negotiation, discussion or communication with Microsoft or Nokia concerning the assertion of intellectual property rights.

REQUEST FOR PRODUCTION NO. 5

All documents and things, including any document or thing exchanged between MOSAID and Microsoft or Nokia, relating to the Patents-in-Suit or to any patent that Microsoft or MOSAID believes controls or dominates the Android™ Operating System.

REQUEST FOR PRODUCTION NO. 6

All documents and things relating to any evaluation, assessment or analysis of MOSAID's offensive or defensive use of intellectual property rights, including all documents and things relating to any evaluation, assessment or analysis of its licensing practices or litigation strategy concerning mobile devices or tablet computers, including mobile devices or tablet computers running open source operating systems.

REQUEST FOR PRODUCTION NO. 7

All documents and things relating to any discussions or analyses of any potential role played or to be played by Microsoft or Nokia in licensing or asserting MOSAID's patents.

REQUEST FOR PRODUCTION NO. 8

All documents and things, including any document or thing exchanged between MOSAID and Microsoft or Nokia, relating to the Android™ Operating System.

REQUEST FOR PRODUCTION NO. 9

All documents and things, including any document exchanged between MOSAID and Microsoft or Nokia, relating to Nokia's or Microsoft's plans, strategies or efforts to increase their collective share or individual shares of the mobile device or mobile operating system markets.

DEPOSITION TOPICS

1. The subject matter of the documents responsive to this subpoena, including the documents produced by you in response to this subpoena.
2. Any relationship between MOSAID and Barnes & Noble's Nook™ and Nook Color™ products, including any alleged infringement by Barnes & Noble of any of the Patents-in-Suit or any other Microsoft or MOSAID patent.

3. The agreement entered into by MOSAID and Core Wireless on or about September 1, 2011, including MOSAID's strategy or rationale regarding its decision to acquire Core Wireless, the patent portfolio of Core Wireless and the licensing of the patent portfolio of Core Wireless.

4. MOSAID's revenue sharing arrangement with Microsoft and Nokia, announced on or about September 1, 2011.

5. Any agreement, partnership, joint venture, understanding, negotiation, discussion or communication with Microsoft or Nokia concerning the assertion of intellectual property rights.

6. The Patents-in-Suit or any patent that MOSAID, Microsoft or Nokia believes controls or dominates the Android™ Operating System.

7. Any evaluation, assessment or analysis of MOSAID's offensive or defensive use of intellectual property rights concerning mobile devices, tablet computers or PCs, including any evaluation, assessment or analysis of its licensing practices or litigation strategy concerning mobile devices or tablet computers, including mobile devices or tablet computers running open source operating systems.

8. Any discussions or analyses of any potential role played or to be played by Microsoft or Nokia in licensing or asserting MOSAID's patents.

9. Any relationship between MOSAID and the Android™ Operating System.

10. Nokia's or Microsoft's plans, strategies or efforts to increase their collective share or individual shares of the mobile device or mobile operating system markets.

DEFINITIONS

The Requests for Production and Deposition Topics, as well as the Definitions themselves and the Instructions, are subject to and incorporate the following definitions, regardless whether upper or lower case letters are used:

1. The phrase "this Investigation" shall mean the above-captioned investigation, *Certain Handheld Electronic Computing Devices, Related Software and Components Thereof*, Inv. No. 337-TA-769.
2. "MOSAID", "you" and "your" refer to MOSAID Technologies Incorporated, including, without limitation, all of its corporate locations, and all predecessors, predecessors-in-interest, subsidiaries, parents, and affiliates, and all past or present directors, officers, agents, representatives, employees, consultants, attorneys, entities acting in joint venture, licensing agreements, or partnership relationships with MOSAID and others acting on behalf of MOSAID.
3. "Nokia" refers to Nokia Corporation, including, without limitation, all of its corporate locations, and all predecessors, predecessors-in-interest, subsidiaries, parents, and affiliates, and all past or present directors, officers, agents, representatives, employees, consultants, attorneys, entities acting in joint venture, licensing agreements, or partnership relationships with Nokia and others acting on behalf of Nokia.
4. "Microsoft" refers to Complainant Microsoft Corporation, including, without limitation, all of its corporate locations, and all predecessors, predecessors-in-interest, subsidiaries, parents, and affiliates, and all past or present directors, officers, agents, representatives, employees, consultants, attorneys, entities acting in joint venture, licensing agreements, or partnership relationships with Microsoft and others acting on behalf of Microsoft.

5. “Core Wireless” refers to Core Wireless Licensing S.a.r.l., including, without limitation, all of its corporate locations, and all predecessors, predecessors-in-interest, subsidiaries, parents, and affiliates, and all past or present directors, officers, agents, representatives, employees, consultants, attorneys, entities acting in joint venture, licensing agreements, or partnership relationships with Core Wireless and others acting on behalf of Core Wireless.

6. “Barnes & Noble” refers collectively to Respondents Barnes & Noble, Inc. and barnesandnoble.com llc.

7. “Nook™” shall mean Barnes & Noble’s black & white Nook™ referenced in the Complaint filed in this Investigation, as well as the All-New Nook™.

8. “Nook Color™” shall mean Barnes & Noble’s Nook Color™ product referenced in the Complaint filed in this Investigation.

9. “Patents-in-Suit” refers collectively and individually to U.S. Patent No. 5,778,372, U.S. Patent No. 5,889,522, U.S. Patent No. 6,339,780, U.S. Patent No. 6,891,551, and U.S. Patent No. 6,957,223, as well as those patents identified by Microsoft in discussions that led to this Investigation, including U.S. Patent No. 5,579,517, U.S. Patent No. 5,652,913, U.S. Patent No. 5,758,352, U.S. Patent No. 6,791,536 and U.S. Patent No. 6,897,853.

10. “Communication” or “communications” shall mean, without limitation, any transmittal, conveyance or exchange of a word, statement, fact, thing, idea, document, instruction, information, demand, question or other information by any medium, whether by written, oral or other means, including electronic communications and electronic mail.

11. "Relating to", "Related to", "Referring" and "Concerning" shall mean in whole or in part constituting, containing, embodying, reflecting, describing, analyzing, identifying, mentioning, stating, referring directly or indirectly to, dealing with or in any way pertaining to.

12. "Documents" shall be construed under the broadest possible construction under Federal Rule of Civil Procedure 34 and Federal Rule of Evidence 1001. The term shall include without limitation any written, recorded, graphic, or other matter, whether sent or received or made or used internally, however produced or reproduced and whatever the medium on which it was produced or reproduced (whether on paper, cards, charts, file, or printouts; tapes, discs, belts, video tapes, audiotapes, tape recordings, cassettes, or other types of voice recording or transcription; computer tapes, databases, e-mails; pictures, photographs, slides, films, microfilms, motion pictures; or any other medium), and any other tangible item or thing of readable, recorded, or visual material of whatever nature including without limitation originals, drafts, and all non-identical copies of each document (which, by reason of any variation, such as the presence of absence of hand-written notes or underlining, represents a distinct version). By way of example, the term "document(s)" as used herein shall include, without limitation: correspondence; blueprints; memoranda; notes; diaries; letters; telegraphs; telegrams; telexes; e-mails; metadata; minutes; agendas; contracts; reports; studies; checks; statements; receipts; returns; summaries; pamphlets; circulars; press releases; advertisements; books; inter-office and intra-office communications; handwritten or typewritten notes; notations or summaries of telephone conversations, meetings, or conferences; bulletins; computer printouts; databases; teletypes; telefax; invoices; worksheets; photographs; tape

recordings; and all other tangible items of readable, recorded, or visual material of any kind.

13. "Thing" shall be construed under the broadest possible construction under the Federal Rules of Civil Procedure.

14. The terms "and" and "or" shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the request for production all responses that might otherwise be construed to be outside of its scope.

15. The terms "any" and "all" shall mean "any and all".

16. The term "including" shall mean "including but not limited to".

17. The use of the singular form of any word includes the plural and vice versa.

18. The use of a verb in any tense shall be construed as the use of the verb in all other tenses.

INSTRUCTIONS

1. Produce all documents and things, wherever located, described in the Requests for Production, that are in your possession, custody or control, or in the possession, custody or control of your agents, attorneys, employees, affiliates or other persons acting or purporting to act under your control or on your behalf, including any documents or communications on any personal computer, disk or drive, or any similar data storage device.

3. Identify and designate the most knowledgeable individual(s) to appear and give testimony as it relates to the Deposition Topics described above.

2. Written responses to the Requests for Production are required pursuant to 19 C.F.R. § 210.30(b)(2).

3. State, for each Request for Production, whether or not there exist any documents or things within the scope of the request and whether any such documents or things are in your possession, custody or control.

4. All documents that respond, in whole or in part, to any portion of any request shall be produced in their entirety, including all attachments and enclosures.

5. If you object to any Request for Production, please state with specificity the grounds for each such objection.

6. Any response made by reference to documents shall identify each responsive document by its Bates number(s).

7. Documents and things shall be produced exactly in the manner in which they are maintained in your files. Electronic data and computerized information must be produced in an intelligible format, together with a description of the system from which they were derived sufficient to permit rendering the records and information intelligible.

8. Responsive documents and things are to be clearly designated so as to reflect their owner and/or custodian and the location from where they were produced.

9. Where an identified document is in a language other than English, state whether an English translation of such document exists. If a document is in a language other than English and an English translation exists, identify and provide both documents.

10. If any document is being withheld under a claim of privilege or otherwise, provide a privileged document list in accordance with the requirements set forth in the Subpoena issued by Administrative Law Judge Essex within ten (10) days of the date on which the answers and objections to these requests are due.

11. If your response to a particular Request for Production is a statement that you lack the ability to comply with that request, you must specify whether the inability to comply is because the particular item or category of information never existed, has been destroyed, has been lost, misplaced, or stolen, or has never been, or is no longer, in your possession, custody, or control, in which case the name and address of any person or entity known or believed by you to have possession, custody, or control of that information or category of information must be identified.

12. For any information requested that is not readily available from your records in the form requested, furnish carefully prepared estimates, designated as such. Attach a statement of the basis for such estimates and identify the person or persons making them.

13. In the event that any responsive document called for by these Requests for Production or subsequent requests has been destroyed or discarded then, separately for each such document, identify: (a) the author(s), addressee(s) and any indicated or blind copyee(s); (b) the document's date, number of pages and attachments or appendices; (c) the document's subject matter; (d) the date of destruction or discard, manner of destruction or discard, and reason for destruction or discard and by whom it was destroyed or discarded; (e) the persons who were authorized to carry out such destruction or discard; (f) whether any copies of the document presently exist and, if so, the name of the custodian of each copy; and (g) the circumstances under which the document was destroyed or discarded.

14. If no documents exist that are responsive to a particular request for production, that fact should be stated in each of your responses to such requests.

15. Please mark each page which you consider to contain confidential business information in accordance with the Protective Order, attached hereto, issued in this Investigation.

EXHIBIT 2

FILED

DEC 23 2011

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

Clerk, U.S. District & Bankruptcy
Courts for the District of Columbia

Microsoft Corporation,

Plaintiff (Complainant),

v.

Barnes & Noble, Inc., barnesandnoble.com
LLC, Hon Hai Precision Industry Co., Ltd.,
Foxconn Electronics, Inc., Foxconn Precision
Component (Shen Zhen) Co. Ltd., Foxconn
International Holdings Ltd., Inventec
Corporation,

Defendants (Respondents).

Civil Action No. Misc. 11-673

**REQUEST FOR INTERNATIONAL JUDICIAL ASSISTANCE
(LETTER ROGATORY)**

The United States District Court for the District of Columbia presents its compliments to the Appropriate Judicial Authority of Canada, and requests international judicial assistance to obtain evidence to be used at trial in a pending administrative proceeding as approved by this Court in the above-captioned matter. This Court has authority to submit this Letter Rogatory under 28 U.S.C. §§ 1651 and 1781(b)(2).

Specifically, this Court requests that the Appropriate Judicial Authority of Canada, by the proper and usual process of Canada's courts, compel the appearance of MOSAID Technologies Incorporated, 11 Hines Road, Suite 203, Ottawa, Ontario, Canada K2K 2X1 ("MOSAID"), to testify under oath through John Lindgren, the Chief Executive Officer of MOSAID, the person most knowledgeable about the topics below, and to compel the production of the documents identified below from MOSAID.

Based on the representations made by Respondents Barnes & Noble, Inc. and barnesandnoble.com llc (collectively, "Barnes & Noble"), this Court believes that

justice cannot be served between the parties in the above-captioned matter unless the evidence requested herein is made available by the Appropriate Judicial Authority of Canada for use in an investigation being conducted by the International Trade Commission into whether Barnes & Noble's Nook and Nook Color infringe patents owned by Microsoft. The Court believes that MOSAID has knowledge regarding material facts and is in possession of documents that are highly relevant to Barnes & Noble's patent misuse defense that cannot be obtained without the assistance of the Appropriate Judicial Authority. Barnes & Noble attempted to obtain this information from MOSAID's United States subsidiary or have MOSAID directly produce the documents and furnish its corporate witness for deposition on the topics requested herein. But MOSAID's United States subsidiary moved to quash the subpoena served upon it and indicated that MOSAID was unwilling to provide the information voluntarily. Thus, Barnes & Noble had no other option but to seek international judicial assistance.¹

In light of the foregoing, this Court respectfully requests that the Appropriate Judicial Authority of Canada give this matter urgent attention in order that the evidence requested herein may be obtained before the period for fact discovery concludes on December 14, 2011, and available for use at trial on February 6, 2012.

I. SUMMARY OF THIS ACTION

The nature of the proceeding for which the evidence is requested is a civil patent infringement action based upon an amended verified complaint filed by Microsoft Corporation ("Microsoft") on April 8, 2011. The complaint alleges that Barnes & Noble,

¹ The documents and testimony set forth below extend beyond those likely to be in the possession or knowledge of the opposing party in this action, Complainant Microsoft Corporation ("Microsoft").

Inc., barnesandnoble.com LLC, Foxconn Electronics, Inc., Foxconn Precision Component (Shen Zhen) Co. Ltd., Foxconn International Holdings Ltd. and Hon Hai Precision Industry Co., Ltd. and Inventec Corporation (“Respondents”) import, sell for importation and/or sell within the United States after importation certain handheld electronic computing devices, related software and components thereof that allegedly infringe U.S. Patent No. 5,778,372, U.S. Patent No. 5,889,522, U.S. Patent No. 6,339,780, U.S. Patent No. 6,891,551 and U.S. Patent No. 6,957,233, in violation of Section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337). As a remedy, Microsoft seeks an injunction barring importation of the allegedly infringing devices, software and components.

The Tariff Act of 1930 prohibits importing goods into the United States that infringe a United States patent, among other things. Pursuant to Microsoft’s complaint, the Commission instituted Investigation No. 337-TA-769, which was assigned to Administrative Law Judge Theodore R. Essex to preside over pretrial matters, conduct a trial and issue an initial determination on the merits of the Investigation. The initial determination of Judge Essex is subject to possible review by the Commission, with a right of appeal to the U.S. Court of Appeals for the Federal Circuit and further appeal to the Supreme Court of the United States.

Respondents have raised several defenses against Microsoft’s allegations of patent infringement, including patent misuse, non-infringement, invalidity of the patents, unenforceability of the patents, public interest and lack of domestic industry. This Letter Rogatory is intended to obtain information material to the patent misuse defense asserted by Barnes & Noble. As part of that defense, Barnes & Noble has alleged that Microsoft is using its licensing practices to broaden improperly the scope of

its patent grant in an attempt to dominate open source mobile operating systems (like the one Barnes & Noble’s handheld devices use) that threaten Microsoft’s monopoly in personal computer (“PC”) operating systems. Information about Microsoft’s arrangement with MOSAID—which Barnes & Noble claims was entered into to facilitate Microsoft’s strategy of leveraging its patents with anticompetitive effect—is necessary in the interest of justice for Barnes & Noble to defend fairly against the allegations made by Microsoft on the basis of patent misuse.

Specifically, Microsoft and Nokia Corporation (“Nokia”) recently entered into an agreement with MOSAID to share in royalties derived from licensing (or suing those that do not take a license) approximately 2,000 Nokia patents acquired by MOSAID. On September 1, 2011, MOSAID acquired Core Wireless Licensing S.a.r.l. (“Core Wireless”), a company which holds a portfolio of 400 patent families, consisting of 2,000 wireless patents and patent applications originally filed by Nokia. Nokia had previously assigned its patents to a trust, which then assigned the patents to Core Wireless. Microsoft secured a license in the Nokia patents acquired by MOSAID.

Barnes & Noble believes that the MOSAID deal is a key element of Microsoft’s horizontal partnership with Nokia, which was announced earlier this year, and included an agreement by Nokia to replace its current operating system with the Windows Phone operating system. One of the publicly stated motivations for the Microsoft-Nokia partnership was to combine the parties’ respective patent portfolios and to coordinate their offensive use of patents directed at open source operating systems, specifically including the Android™ Operating System (“Android”). Microsoft’s new deal with MOSAID—which began negotiations around the time the Microsoft-Nokia partnership was announced—appears to be the mechanism by which Microsoft and Nokia

will use Nokia's patents to attack Android-based devices that threaten Microsoft's monopoly. Thus, the MOSAID deal bears directly on Barnes & Noble's patent misuse defense.

To develop these facts further, Barnes & Noble seeks testimony and documents about MOSAID's business arrangement with Microsoft and Nokia, as well as the connection between Microsoft's demand that Barnes & Noble enter into a licensing agreement to use the Android Operating System, and its coordinated intellectual property strategy with MOSAID and Nokia. Any materially relevant evidence uncovered as a result of this Letter Rogatory will be adduced at trial, if admissible.

II. DOCUMENTS AND TESTIMONY REQUESTED

This Court requests the Appropriate Judicial Authority of Canada to compel MOSAID to produce to Barnes & Noble documents responsive to the requests for production in Addendum A to this Letter Rogatory, to the extent that they are in the possession, control or power of MOSAID and are not privileged under the applicable laws of Canada or the United States. This Court also requests the Appropriate Judicial Authority of Canada to compel MOSAID to make Mr. Lindgren, the person most knowledgeable about the topics listed in Addendum B to this Letter Rogatory, to appear and give a deposition on oral examination concerning those topics.

In addition to the privileges applicable to MOSAID under the Canadian laws, under the laws of the United States Mr. Lindgren may refuse to answer any question if such answer would subject him to a real and appreciable danger of criminal liability in the United States. Likewise, Mr. Lindgren may refuse to answer a question or produce a document if such answer or document would disclose a confidential

communication between him and MOSAID's attorney(s) in connection with seeking legal advice.

The Court also understands the confidential nature of the documents requested from MOSAID, and there is a protective order in this case to protect the confidentiality of any documents MOSAID produces. The protective order is Addendum C to this Letter Rogatory.

III. SPECIAL METHODS AND PROCEDURES REQUESTED TO BE FOLLOWED

To the extent permitted by the applicable laws of Canada, this Court respectfully requests that the Appropriate Judicial Authority of Canada require that the following methods and procedures be followed in connection with the deposition and document production requested herein:

- A. The examination be conducted orally;
- B. The parties' legal representatives or their designees and a stenographer be permitted to be present during the examination;
- C. There be excluded from the examination all persons other than the parties' legal representatives or their designees, a stenographer, and any judicial officer of Canada;
- D. The stenographer be permitted to record verbatim the examination;
- E. The attorneys from the law firm of Cravath, Swaine & Moore LLP, acting as legal representatives of Barnes & Noble, or their designees, be permitted to conduct the examination;
- F. The attorneys conducting the examination be permitted to ask questions regarding the topics listed in Addendum B; or, if a judicial officer is conducting the examination, the parties' legal representatives or their designees be permitted to submit questions to that officer for presentation to the witness;
- G. Seven (7) hours be allotted for the examination of the witness; and
- H. The witness be examined as soon as practicable, but before December 14, 2011, the date for the close of discovery; and the documentary evidence be

produced or provided for inspection and copying at least ten (10) days before the examination.

IV. RECIPROCITY AND REIMBURSEMENT FOR COSTS

This Court stands ready to extend similar assistance to the judicial tribunals of Canada. To the extent that there are expenses associated with providing assistance in response to this Letter Rogatory, this Court will see that the Appropriate Judicial Authority of Canada is reimbursed by Barnes & Noble.

Dated: 12/28, 2011
Month, Day

The Honorable _____
~~United States District Court Judge~~
~~U.S. District Court for the District of Columbia~~ *(PDS)*

ANGELA D. CAESAR, CLERK

By: *Reg not Jdn*
DEPUTY CLERK

ADDENDUM A

REQUESTS FOR PRODUCTION

REQUEST FOR PRODUCTION NO. 1

All documents, including any document or thing exchanged between MOSAID and Microsoft or Nokia, relating to any possible infringement claims involving Barnes & Noble's Nook™ and Nook Color™ products.

REQUEST FOR PRODUCTION NO. 2

All documents relating to the agreement entered into by MOSAID and Core Wireless on or about September 1, 2011, including MOSAID's strategy or rationale regarding its decision to acquire Core Wireless, the patent portfolio of Core Wireless and the licensing of the patent portfolio of Core Wireless.

REQUEST FOR PRODUCTION NO. 3

All documents relating to MOSAID's revenue sharing arrangement with Microsoft and Nokia, announced on or about September 1, 2011.

REQUEST FOR PRODUCTION NO. 4

All documents, including any document exchanged between MOSAID and Microsoft or Nokia, relating to U.S. Patent No. 5,778,372, U.S. Patent No. 5,889,522, U.S. Patent No. 6,339,780, U.S. Patent No. 6,891,551, U.S. Patent No. 6,957,223, U.S. Patent No. 5,579,517, U.S. Patent No. 5,652,913, U.S. Patent No. 5,758,352, U.S. Patent No. 6,791,536 and U.S. Patent No. 6,897,853, or to any patent that Microsoft or MOSAID believes controls or dominates the Android™ Operating System.

REQUEST FOR PRODUCTION NO. 5

All documents since January 1, 2010 relating to any evaluation, assessment or analysis of MOSAID's offensive or defensive use of patent rights concerning mobile

devices or tablet computers, including mobile devices or tablet computers running open source operating systems.

REQUEST FOR PRODUCTION NO. 6

All documents relating to any discussions or analyses of any potential role played or to be played by Microsoft or Nokia in licensing or asserting MOSAID's patents.

REQUEST FOR PRODUCTION NO. 7

All documents since January 1, 2010 relating to communications between or among MOSAID and Microsoft or Nokia, relating to the Android™ Operating System.

REQUEST FOR PRODUCTION NO. 8

All documents since January 1, 2010, including any document exchanged between MOSAID and Microsoft or Nokia, relating to Nokia's or Microsoft's plans, strategies or efforts to increase their collective share or individual shares of the mobile device or mobile operating system markets.

ADDENDUM B

DEPOSITION TOPICS

1. The subject matter of the documents produced in response to the requests in Addendum A to this Letter Rogatory.
2. Any relationship between MOSAID and Barnes & Noble's Nook™ and Nook Color™ products, including any alleged infringement by Barnes & Noble of any other Microsoft or MOSAID patent.
3. The agreement entered into by MOSAID and Core Wireless on or about September 1, 2011, including MOSAID's strategy or rationale regarding its decision to acquire Core Wireless, the patent portfolio of Core Wireless and the licensing of the patent portfolio of Core Wireless.
4. MOSAID's revenue sharing arrangement with Microsoft and Nokia, announced on or about September 1, 2011.
5. U.S. Patent No. 5,778,372, U.S. Patent No. 5,889,522, U.S. Patent No. 6,339,780, U.S. Patent No. 6,891,551, U.S. Patent No. 6,957,223, U.S. Patent No. 5,579,517, U.S. Patent No. 5,652,913, U.S. Patent No. 5,758,352, U.S. Patent No. 6,791,536 and U.S. Patent No. 6,897,853, or any patent that MOSAID, Microsoft or Nokia believes controls or dominates the Android™ Operating System.
6. Any evaluation, assessment or analysis since January 1, 2010 of MOSAID's offensive or defensive use of patent rights concerning mobile devices, tablet computers or PCs, including mobile devices or tablet computers running open source operating systems.
7. Any discussions or analyses of any potential role played or to be played by Microsoft or Nokia in licensing or asserting MOSAID's patents.

8. Any relationship between MOSAID and Microsoft and Nokia relating to the Android™ Operating System since January 1, 2010.

9. Nokia's or Microsoft's plans, strategies or efforts to increase their collective share or individual shares of the mobile device or mobile operating system markets since January 1, 2010.

EXHIBIT 3

**ONTARIO
SUPERIOR COURT OF JUSTICE**

BETWEEN:

BARNES & NOBLE, INC. and BARNESANDNOBLE.COM LLC

Applicants

- and -

MOSAID TECHNOLOGIES INCORPORATED

Respondent

APPLICATION UNDER s. 60 of the *Evidence Act*, R.S.O. 1990, c. E.23
and s. 46 of the *Canada Evidence Act*, R.S.C. 1985, c. C.5

**APPLICATION RECORD
(returnable January ___, 2012)**
(VOLUME I OF II)

January 10, 2012

STIKEMAN ELLIOTT LLP
Barristers & Solicitors
5300 Commerce Court West
199 Bay Street, P.O. Box 85
Toronto, Ontario M5L 1B9

Nicholas McHaffie, LSUC #37924D
Tel: (613) 566-0546
Megan MacDonald, LSUC #60781M
Tel: (613) 566-0551
Fax: (613) 230-8877

Solicitors for the Applicants

TO: **MOSAID Technologies Incorporated**
11 Hines Road, Suite 203
Ottawa, Ontario
Canada K2K 2X1

Court File No. 12- -

**ONTARIO
SUPERIOR COURT OF JUSTICE**

B E T W E E N :

BARNES & NOBLE, INC. and BARNESANDNOBLE.COM LLC

Applicants

- and -

MOSAID TECHNOLOGIES INCORPORATED

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APPLICATION UNDER s. 60 of the *Evidence Act*, R.S.O. 1990, c. E.23
and s. 46 of the *Canada Evidence Act*, R.S.C. 1985, c. C.5

I N D E X

| <u>TAB</u> | <u>DOCUMENT</u> | <u>PAGE</u> |
|------------------------------|---|--------------------|
| <u>VOLUME I of II</u> | | |
| 1 | Notice of Application issued January 10, 2012 | 1 |
| A | Schedule "A" – Letter of Request dated December 28, 2011 | 9 |
| 2 | Affidavit of Brendon DeMay sworn January 9, 2012 | 34 |
| A | Exhibit "A" – Letter of Request dated December 28, 2011 issued pursuant to an Order of Chief Judge Royce C. Lamberth of the United States District Court for the District of Columbia | 42 |
| B | Exhibit "B" – Amended Verified Complaint dated April 8, 2011 | 71 |
| C | Exhibit "C" – Response dated May 10, 2011 | 130 |

| <u>TAB</u> | <u>DOCUMENT</u> | <u>PAGE</u> |
|------------------------|--|-------------|
| 2 | D Exhibit "D" – Subpoena <i>duces tecum</i> and subpoena <i>ad testificandum</i> issued October 20, 2011, by the United States International Trade Commission | 193 |
| | E Exhibit "E" – Email from Mark Whitaker dated November 7, 2011 | 239 |
| <u>VOLUME II of II</u> | | |
| 2 | F Exhibit "F" – Motion to United States International Trade Commission to Quash and/or Limit Subpoenas dated November 8, 2011 | 243 |
| | G Exhibit "G" – Motion for Recommendation to the United States District Court for the District of Columbia to Issue a Letter Rogatory for Evidence dated November 16, 2011 | 333 |
| | H Exhibit "H" – Motion for the Issuance of a Letter Rogatory for International Judicial Assistance dated December 9, 2011 | 418 |

**ONTARIO
SUPERIOR COURT OF JUSTICE**

BETWEEN:

BARNES & NOBLE, INC. and BarnesandNoble.com LLC

Applicants



- and -

MOSAID TECHNOLOGIES INCORPORATED

Respondent

APPLICATION UNDER s. 60 of the *Evidence Act*, R.S.O. 1990, c. E.23
and s. 46 of the *Canada Evidence Act*, R.S.C. 1985, c. C.5

NOTICE OF APPLICATION

TO THE RESPONDENT:

A LEGAL PROCEEDING HAS BEEN COMMENCED by the applicants. The claim made by the applicants appears on the following page.

THIS APPLICATION will come on for a hearing on _____ day, January _____, 2012, at 10:00 a.m., or as soon thereafter as the matter may be heard, at 161 Elgin Street, Ottawa, Ontario.

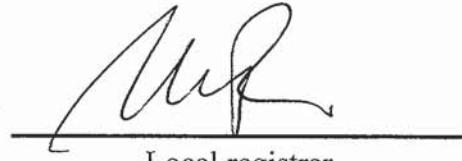
IF YOU WISH TO OPPOSE THIS APPLICATION, to receive notice of any step in the application or to be served with any documents in the application, you or an Ontario lawyer acting for you must forthwith prepare a notice of appearance in Form 38A prescribed by the Rules of Civil Procedure, serve it on the applicants' lawyer or, where the applicants does not have a lawyer, serve it on the applicants, and file it, with proof of service, in this court office, and you or your lawyer must appear at the hearing.

IF YOU WISH TO PRESENT AFFIDAVIT OR OTHER DOCUMENTARY EVIDENCE TO THE COURT OR TO EXAMINE OR CROSS-EXAMINE WITNESSES ON THE APPLICATION, you or your lawyer must, in addition to serving your notice of appearance, serve a copy of the evidence on the applicants' lawyer or, where the applicants does not have a lawyer, serve it on the applicants, and file it, with proof of service, in the court office where the application is to be heard as soon as possible, but not later than 2 days before the hearing.

IF YOU FAIL TO APPEAR AT THE HEARING, JUDGMENT MAY BE GIVEN IN YOUR ABSENCE AND WITHOUT FURTHER NOTICE TO YOU. IF YOU WISH TO OPPOSE THIS APPLICATION BUT ARE UNABLE TO PAY LEGAL FEES, LEGAL AID MAY BE AVAILABLE TO YOU BY CONTACTING A LOCAL LEGAL AID OFFICE.

Date January 10, 2012

Issued by



Local registrar

Address of 161 Elgin St.
court office Ottawa, Ontario K2P 2K1

TO: **MOSAID Technologies Incorporated**
 11 Hines Road, Suite 203
 Ottawa, Ontario K2K 2X1

APPLICATION

1. The applicants make application for:
 - (a) such Orders as may be necessary to give effect to the urgent Request for International Judicial Assistance (Letter Rogatory) ("Letter of Request") issued on December 28, 2011 by the United States District Court for the District of Columbia (the "US District Court") in Civil Action No. Misc. 11-673, attached as Schedule A to this Notice of Application, and, in particular and without limiting the foregoing:
 - (i) an Order that the Respondent, MOSAID Technologies Incorporated ("MOSAID"), produce to the Applicants, Barnes & Noble, Inc. and barnesandnoble.com llc (collectively, "Barnes & Noble"), all documents in its possession, control or power and not privileged under the applicable laws of Canada or the United States that are responsive to the requests for production set out in Addendum A to the Letter of Request found at Schedule A to this Notice of Application, prior to January 23, 2012;
 - (ii) an Order that the Respondent, MOSAID, appear through John Lindgren, the Chief Executive Officer of MOSAID and the person most knowledgeable about the topics set out in Addendum B to the Letter of Request (the "Deposition Topics") found at Schedule A to this Notice of Application, to give evidence under oath with respect to the Deposition Topics at the offices of Cornell Catana, 800-170 Laurier Ave., W., Ottawa, ON, or such other location as may be mutually agreed between the parties, on January 23, 2012, or the first available date thereafter, but in any event prior to January 30, 2012;
 - (b) an Order abridging the time required for service of this Notice of Application, if necessary; and
 - (c) such further and other relief as to this Honourable Court seems just.

2. The grounds for the application are:

- (a) an investigation is currently being conducted by the United States International Trade Commission (“ITC”) in the nature of a civil patent infringement action based upon an amended verified complaint by Microsoft Corporation alleging that certain products imported, sold for importation or sold within the United States after importation by the Barnes & Noble infringe patents owned by Microsoft Corporation (“Microsoft”) (the “ITC Action”);
- (b) Barnes & Noble has raised several defences against Microsoft’s allegations of patent infringement, including the defence of patent misuse;
- (c) the trial for the investigation is scheduled to begin on February 6, 2012;
- (d) the ITC has granted leave for Barnes & Noble to examine and obtain documents from MOSAID, and such leave was granted in advance of the December 14, 2011, deadline for fact discovery;
- (e) Barnes & Noble is presently applying to the ITC to keep the record open past the December 14, 2011, deadline for fact discovery so that admissible evidence from the letter of request process may be considered;
- (f) the Respondent, MOSAID, has knowledge regarding material facts relevant to the ITC Action, specifically relating to the allegations of patent misuse, and is in possession of documents that are highly relevant to Barnes & Noble’s patent misuse defence;
- (g) as part of its patent misuse defence, Barnes & Noble has alleged that Microsoft is using its licensing practices to broaden improperly its patent grant in an attempt to dominate open source mobile operating systems (like the one Barnes & Noble’s handheld devices use) that threaten Microsoft’s monopoly in personal computer (“PC”) operating systems;

- (h) Barnes & Noble alleges that Microsoft and MOSAID entered into a patent licensing arrangement to facilitate Microsoft's strategy of improperly leveraging its patents with anticompetitive effect;
- (i) information about this patent licensing arrangement between Microsoft and MOSAID is necessary in the interest of justice for Barnes & Noble to defend fairly against the allegations made by Microsoft on the basis of patent misuse;
- (j) the documents and testimony requested from MOSAID herein extend beyond those likely to be in the possession or knowledge of the opposing party in the ITC action, namely Microsoft;
- (k) Barnes & Noble attempted to obtain this information from Microsoft through depositions and document requests, but Microsoft was unable to supply all the necessary information;
- (l) Barnes & Noble attempted to obtain this information from MOSAID's United States subsidiary or to have MOSAID directly produce the documents and furnish its corporate witness for deposition on the topics requested herein;
- (m) MOSAID's United States subsidiary moved to quash the subpoena served upon it on the ground that the requested evidence was in the exclusive control of MOSAID in Canada, and the United States subsidiary indicated that MOSAID was unwilling to provide the information voluntarily;
- (n) Barnes & Noble opposed MOSAID's motion to quash in the ITC Action, and the motion is still pending;
- (o) MOSAID is a company incorporated pursuant to the laws of Canada with its head office located in Ottawa, Ontario;
- (p) based on MOSAID's refusal, statutory time limitations on ITC investigations, and the fact that a trial is scheduled for February 6, 2012, Barnes & Noble brought a motion for the expedited issuance of Letters Rogatory requiring

MOSAID to produce designated documents and provide deposition testimony through John Lindgren, MOSAID's Chief Executive Officer;

- (q) on December 2, 2011, Theodore R. Essex, Administrative Law Judge for the ITC, issued a recommendation to the US District Court, finding that the evidence sought by Barnes & Noble is reasonably necessary to investigate its defense of patent misuse, and recommending that the US District Court issue Letters Rogatory;
- (r) on December 28, 2011, based on the recommendation of the ITC Administrative Law Judge, the US District Court issued a Letter of Request in Civil Action No. Misc. 11-673 requesting the urgent attention of this Honourable Court to secure the pre-trial evidence and documentation from the Respondent;
- (s) the US District Court properly exercised jurisdiction over the parties to the ITC Action and had authority to submit the Letter of Request under 28 U.S.C. §§ 1651 and 1781(b)(2);
- (t) the evidence and documentation sought is relevant and necessary to the trial of the ITC Action, and without such information Barnes & Noble will not be able to properly prepare their defence;
- (u) the evidence and documentation contemplated by the Letter of Request are not otherwise obtainable;
- (v) compelling the Respondent to produce the specified documents will not place an undue burden on it;
- (w) the evidence and documentation will be subject to a Protective Order issued in the ITC Action, set out at Addendum C to the Letter of Request;
- (x) documents will only be produced to the extent that they are not privileged under the applicable laws of Canada or the United States, and the Respondent is entitled to refuse to answer any question if such answer would subject it to a

real and appreciable danger of criminal liability in the United States or to answer a question or produce a document if such answer or document would disclose a confidential communication with MOSAID's attorney(s) in connection with seeking legal advice;

- (y) it is in the interest of justice that this application be granted in the circumstances of this case and it would not be contrary to the Ontario public policy to grant the application;
 - (z) section 60 of the *Evidence Act*, R.S.O. 1990, c. E.23, as amended;
 - (aa) section 46 of the *Canada Evidence Act*, R.S.C. 1985, c. C.5, as amended;
 - (bb) Rules 1.04, 3.02, 14.05, 30.10, 31.05.1, 31.10, 34 and 38 of the *Rules of Civil Procedure*, R.R.O. 1990, Reg. 194, as amended;
 - (cc) the further and other grounds set out in the affidavits and written arguments filed in support hereof; and
 - (dd) such further and other grounds as counsel may submit and this Honourable Court may permit.
3. The following documentary evidence will be used at the hearing of the application:
- (a) the affidavit of Brendon DeMay, sworn January 9, 2012, and the exhibits attached thereto;
 - (b) the Request for International Judicial Assistance (Letter Rogatory) from the US District Court to the Superior Court of Justice of the Province of Ontario, Canada, dated December 28, 2012; and
 - (c) such further and other evidence as counsel may advise and this Honourable Court may permit.

January 10, 2012

STIKEMAN ELLIOTT LLP
Barristers & Solicitors
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Ottawa, Ontario K1P 6L2

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Fax: (613) 230-8877

Solicitors for the Applicants

SCHEDULE A

**REQUEST FOR INTERNATIONAL JUDICIAL ASSISTANCE
(LETTER ROGATORY)**

**FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

FILED

DEC 23 2011

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Clark, U.S. District & Bankruptcy
Courts for the District of Columbia

Microsoft Corporation,

Plaintiff (Complainant),

v.

Barnes & Noble, Inc., barnesandnoble.com
LLC, Hon Hai Precision Industry Co., Ltd.,
Foxconn Electronics, Inc., Foxconn Precision
Component (Shen Zhen) Co. Ltd., Foxconn
International Holdings Ltd., Inventec
Corporation,

Defendants (Respondents).

Civil Action No. Misc. 11-673

**REQUEST FOR INTERNATIONAL JUDICIAL ASSISTANCE
(LETTER ROGATORY)**

The United States District Court for the District of Columbia presents its compliments to the Appropriate Judicial Authority of Canada, and requests international judicial assistance to obtain evidence to be used at trial in a pending administrative proceeding as approved by this Court in the above-captioned matter. This Court has authority to submit this Letter Rogatory under 28 U.S.C. §§ 1651 and 1781(b)(2).

Specifically, this Court requests that the Appropriate Judicial Authority of Canada, by the proper and usual process of Canada's courts, compel the appearance of MOSAID Technologies Incorporated, 11 Hines Road, Suite 203, Ottawa, Ontario, Canada K2K 2X1 ("MOSAID"), to testify under oath through John Lindgren, the Chief Executive Officer of MOSAID, the person most knowledgeable about the topics below, and to compel the production of the documents identified below from MOSAID.

Based on the representations made by Respondents Barnes & Noble, Inc. and barnesandnoble.com llc (collectively, "Barnes & Noble"), this Court believes that

justice cannot be served between the parties in the above-captioned matter unless the evidence requested herein is made available by the Appropriate Judicial Authority of Canada for use in an investigation being conducted by the International Trade Commission into whether Barnes & Noble's Nook and Nook Color infringe patents owned by Microsoft. The Court believes that MOSAID has knowledge regarding material facts and is in possession of documents that are highly relevant to Barnes & Noble's patent misuse defense that cannot be obtained without the assistance of the Appropriate Judicial Authority. Barnes & Noble attempted to obtain this information from MOSAID's United States subsidiary or have MOSAID directly produce the documents and furnish its corporate witness for deposition on the topics requested herein. But MOSAID's United States subsidiary moved to quash the subpoena served upon it and indicated that MOSAID was unwilling to provide the information voluntarily. Thus, Barnes & Noble had no other option but to seek international judicial assistance.¹

In light of the foregoing, this Court respectfully requests that the Appropriate Judicial Authority of Canada give this matter urgent attention in order that the evidence requested herein may be obtained before the period for fact discovery concludes on December 14, 2011, and available for use at trial on February 6, 2012.

I. SUMMARY OF THIS ACTION

The nature of the proceeding for which the evidence is requested is a civil patent infringement action based upon an amended verified complaint filed by Microsoft Corporation ("Microsoft") on April 8, 2011. The complaint alleges that Barnes & Noble,

¹ The documents and testimony set forth below extend beyond those likely to be in the possession or knowledge of the opposing party in this action, Complainant Microsoft Corporation ("Microsoft").

Inc., barnesandnoble.com LLC, Foxconn Electronics, Inc., Foxconn Precision Component (Shen Zhen) Co. Ltd., Foxconn International Holdings Ltd. and Hon Hai Precision Industry Co., Ltd. and Inventec Corporation (“Respondents”) import, sell for importation and/or sell within the United States after importation certain handheld electronic computing devices, related software and components thereof that allegedly infringe U.S. Patent No. 5,778,372, U.S. Patent No. 5,889,522, U.S. Patent No. 6,339,780, U.S. Patent No. 6,891,551 and U.S. Patent No. 6,957,233, in violation of Section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337). As a remedy, Microsoft seeks an injunction barring importation of the allegedly infringing devices, software and components.

The Tariff Act of 1930 prohibits importing goods into the United States that infringe a United States patent, among other things. Pursuant to Microsoft’s complaint, the Commission instituted Investigation No. 337-TA-769, which was assigned to Administrative Law Judge Theodore R. Essex to preside over pretrial matters, conduct a trial and issue an initial determination on the merits of the Investigation. The initial determination of Judge Essex is subject to possible review by the Commission, with a right of appeal to the U.S. Court of Appeals for the Federal Circuit and further appeal to the Supreme Court of the United States.

Respondents have raised several defenses against Microsoft’s allegations of patent infringement, including patent misuse, non-infringement, invalidity of the patents, unenforceability of the patents, public interest and lack of domestic industry. This Letter Rogatory is intended to obtain information material to the patent misuse defense asserted by Barnes & Noble. As part of that defense, Barnes & Noble has alleged that Microsoft is using its licensing practices to broaden improperly the scope of

its patent grant in an attempt to dominate open source mobile operating systems (like the one Barnes & Noble's handheld devices use) that threaten Microsoft's monopoly in personal computer ("PC") operating systems. Information about Microsoft's arrangement with MOSAID—which Barnes & Noble claims was entered into to facilitate Microsoft's strategy of leveraging its patents with anticompetitive effect—is necessary in the interest of justice for Barnes & Noble to defend fairly against the allegations made by Microsoft on the basis of patent misuse.

Specifically, Microsoft and Nokia Corporation ("Nokia") recently entered into an agreement with MOSAID to share in royalties derived from licensing (or suing those that do not take a license) approximately 2,000 Nokia patents acquired by MOSAID. On September 1, 2011, MOSAID acquired Core Wireless Licensing S.a.r.l. ("Core Wireless"), a company which holds a portfolio of 400 patent families, consisting of 2,000 wireless patents and patent applications originally filed by Nokia. Nokia had previously assigned its patents to a trust, which then assigned the patents to Core Wireless. Microsoft secured a license in the Nokia patents acquired by MOSAID.

Barnes & Noble believes that the MOSAID deal is a key element of Microsoft's horizontal partnership with Nokia, which was announced earlier this year, and included an agreement by Nokia to replace its current operating system with the Windows Phone operating system. One of the publicly stated motivations for the Microsoft-Nokia partnership was to combine the parties' respective patent portfolios and to coordinate their offensive use of patents directed at open source operating systems, specifically including the AndroidTM Operating System ("Android"). Microsoft's new deal with MOSAID—which began negotiations around the time the Microsoft-Nokia partnership was announced—appears to be the mechanism by which Microsoft and Nokia

will use Nokia's patents to attack Android-based devices that threaten Microsoft's monopoly. Thus, the MOSAID deal bears directly on Barnes & Noble's patent misuse defense.

To develop these facts further, Barnes & Noble seeks testimony and documents about MOSAID's business arrangement with Microsoft and Nokia, as well as the connection between Microsoft's demand that Barnes & Noble enter into a licensing agreement to use the Android Operating System, and its coordinated intellectual property strategy with MOSAID and Nokia. Any materially relevant evidence uncovered as a result of this Letter Rogatory will be adduced at trial, if admissible.

II. DOCUMENTS AND TESTIMONY REQUESTED

This Court requests the Appropriate Judicial Authority of Canada to compel MOSAID to produce to Barnes & Noble documents responsive to the requests for production in Addendum A to this Letter Rogatory, to the extent that they are in the possession, control or power of MOSAID and are not privileged under the applicable laws of Canada or the United States. This Court also requests the Appropriate Judicial Authority of Canada to compel MOSAID to make Mr. Lindgren, the person most knowledgeable about the topics listed in Addendum B to this Letter Rogatory, to appear and give a deposition on oral examination concerning those topics.

In addition to the privileges applicable to MOSAID under the Canadian laws, under the laws of the United States Mr. Lindgren may refuse to answer any question if such answer would subject him to a real and appreciable danger of criminal liability in the United States. Likewise, Mr. Lindgren may refuse to answer a question or produce a document if such answer or document would disclose a confidential

communication between him and MOSAID's attorney(s) in connection with seeking legal advice.

The Court also understands the confidential nature of the documents requested from MOSAID, and there is a protective order in this case to protect the confidentiality of any documents MOSAID produces. The protective order is Addendum C to this Letter Rogatory.

III. SPECIAL METHODS AND PROCEDURES REQUESTED TO BE FOLLOWED

To the extent permitted by the applicable laws of Canada, this Court respectfully requests that the Appropriate Judicial Authority of Canada require that the following methods and procedures be followed in connection with the deposition and document production requested herein:

- A. The examination be conducted orally;
- B. The parties' legal representatives or their designees and a stenographer be permitted to be present during the examination;
- C. There be excluded from the examination all persons other than the parties' legal representatives or their designees, a stenographer, and any judicial officer of Canada;
- D. The stenographer be permitted to record verbatim the examination;
- E. The attorneys from the law firm of Cravath, Swaine & Moore LLP, acting as legal representatives of Barnes & Noble, or their designees, be permitted to conduct the examination;
- F. The attorneys conducting the examination be permitted to ask questions regarding the topics listed in Addendum B; or, if a judicial officer is conducting the examination, the parties' legal representatives or their designees be permitted to submit questions to that officer for presentation to the witness;
- G. Seven (7) hours be allotted for the examination of the witness; and
- H. The witness be examined as soon as practicable, but before December 14, 2011, the date for the close of discovery; and the documentary evidence be

produced or provided for inspection and copying at least ten (10) days before the examination.

IV. RECIPROCITY AND REIMBURSEMENT FOR COSTS

This Court stands ready to extend similar assistance to the judicial tribunals of Canada. To the extent that there are expenses associated with providing assistance in response to this Letter Rogatory, this Court will see that the Appropriate Judicial Authority of Canada is reimbursed by Barnes & Noble.

Dated: 12/28, 2011
Month, Day

The Honorable _____
~~United States District Court Judge~~
~~U.S. District Court for the District of Columbia~~ *(PAC)*

ANGELA D. CAESAR, CLERK
By: Reg not Jde
DEPUTY CLERK

ADDENDUM A

REQUESTS FOR PRODUCTION

REQUEST FOR PRODUCTION NO. 1

All documents, including any document or thing exchanged between MOSAID and Microsoft or Nokia, relating to any possible infringement claims involving Barnes & Noble's Nook™ and Nook Color™ products.

REQUEST FOR PRODUCTION NO. 2

All documents relating to the agreement entered into by MOSAID and Core Wireless on or about September 1, 2011, including MOSAID's strategy or rationale regarding its decision to acquire Core Wireless, the patent portfolio of Core Wireless and the licensing of the patent portfolio of Core Wireless.

REQUEST FOR PRODUCTION NO. 3

All documents relating to MOSAID's revenue sharing arrangement with Microsoft and Nokia, announced on or about September 1, 2011.

REQUEST FOR PRODUCTION NO. 4

All documents, including any document exchanged between MOSAID and Microsoft or Nokia, relating to U.S. Patent No. 5,778,372, U.S. Patent No. 5,889,522, U.S. Patent No. 6,339,780, U.S. Patent No. 6,891,551, U.S. Patent No. 6,957,223, U.S. Patent No. 5,579,517, U.S. Patent No. 5,652,913, U.S. Patent No. 5,758,352, U.S. Patent No. 6,791,536 and U.S. Patent No. 6,897,853, or to any patent that Microsoft or MOSAID believes controls or dominates the Android™ Operating System.

REQUEST FOR PRODUCTION NO. 5

All documents since January 1, 2010 relating to any evaluation, assessment or analysis of MOSAID's offensive or defensive use of patent rights concerning mobile

devices or tablet computers, including mobile devices or tablet computers running open source operating systems.

REQUEST FOR PRODUCTION NO. 6

All documents relating to any discussions or analyses of any potential role played or to be played by Microsoft or Nokia in licensing or asserting MOSAID's patents.

REQUEST FOR PRODUCTION NO. 7

All documents since January 1, 2010 relating to communications between or among MOSAID and Microsoft or Nokia, relating to the Android™ Operating System.

REQUEST FOR PRODUCTION NO. 8

All documents since January 1, 2010, including any document exchanged between MOSAID and Microsoft or Nokia, relating to Nokia's or Microsoft's plans, strategies or efforts to increase their collective share or individual shares of the mobile device or mobile operating system markets.

ADDENDUM B

DEPOSITION TOPICS

1. The subject matter of the documents produced in response to the requests in Addendum A to this Letter Rogatory.
2. Any relationship between MOSAID and Barnes & Noble's Nook™ and Nook Color™ products, including any alleged infringement by Barnes & Noble of any other Microsoft or MOSAID patent.
3. The agreement entered into by MOSAID and Core Wireless on or about September 1, 2011, including MOSAID's strategy or rationale regarding its decision to acquire Core Wireless, the patent portfolio of Core Wireless and the licensing of the patent portfolio of Core Wireless.
4. MOSAID's revenue sharing arrangement with Microsoft and Nokia, announced on or about September 1, 2011.
5. U.S. Patent No. 5,778,372, U.S. Patent No. 5,889,522, U.S. Patent No. 6,339,780, U.S. Patent No. 6,891,551, U.S. Patent No. 6,957,223, U.S. Patent No. 5,579,517, U.S. Patent No. 5,652,913, U.S. Patent No. 5,758,352, U.S. Patent No. 6,791,536 and U.S. Patent No. 6,897,853, or any patent that MOSAID, Microsoft or Nokia believes controls or dominates the Android™ Operating System.
6. Any evaluation, assessment or analysis since January 1, 2010 of MOSAID's offensive or defensive use of patent rights concerning mobile devices, tablet computers or PCs, including mobile devices or tablet computers running open source operating systems.
7. Any discussions or analyses of any potential role played or to be played by Microsoft or Nokia in licensing or asserting MOSAID's patents.

8. Any relationship between MOSAID and Microsoft and Nokia relating to the Android™ Operating System since January 1, 2010.

9. Nokia's or Microsoft's plans, strategies or efforts to increase their collective share or individual shares of the mobile device or mobile operating system markets since January 1, 2010.

ADDENDUM C

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. 1: PROTECTIVE ORDER

(April 25, 2011)

WHEREAS, documents and information may be sought, produced or exhibited by and among the parties to the above captioned proceeding, which materials relate to trade secrets or other confidential research, development or commercial information, as such terms are used in the Commission's Rules, 19 C.F.R. § 210.5;

IT IS HEREBY ORDERED THAT:

1. Confidential business information is information which concerns or relates to the trade secrets, processes, operations, style of work, or apparatus, or to the production, sales, shipments, purchases, transfers, identification of customers, inventories, amount or source of any income, profits, losses, or expenditures of any person, firm, partnership, corporation, or other organization, or other information of commercial value, the disclosure of which is likely to have the effect of either (i) impairing the Commission's ability to obtain such information as is necessary to perform its statutory functions; or (ii) causing substantial harm to the competitive position of the person, firm, partnership, corporation, or other organization from which the

information was obtained, unless the Commission is required by law to disclose such information. The term "confidential business information" includes "proprietary information" within the meaning of section 777(b) of the Tariff Act of 1930 (19 U.S.C. § 1677f(b)).

2(a). Any information submitted, in pre hearing discovery or in a pleading, motion, or response to a motion either voluntarily or pursuant to order, in this investigation, which is asserted by a supplier to contain or constitute confidential business information shall be so designated by such supplier in writing, or orally at a deposition, conference or hearing, and shall be segregated from other information being submitted. Documents shall be clearly and prominently marked on their face with the legend: "CONFIDENTIAL BUSINESS INFORMATION, SUBJECT TO PROTECTIVE ORDER," or a comparable notice. Such information, whether submitted in writing or in oral testimony, shall be treated in accordance with the terms of this protective order.

(b). The Administrative Law Judge or the Commission may determine that information alleged to be confidential is not confidential, or that its disclosure is necessary for the proper disposition of the proceeding, before, during or after the close of a hearing herein. If such a determination is made by the Administrative Law Judge or the Commission, opportunity shall be provided to the supplier of such information to argue its confidentiality prior to the time of such ruling.

3. In the absence of written permission from the supplier or an order by the Commission or the Administrative Law Judge, any confidential documents or business information submitted in accordance with the provisions of paragraph 2 above shall not be disclosed to any person other than: (i) outside counsel for parties to this investigation, including necessary secretarial and support personnel assisting such counsel; (ii) qualified persons taking testimony involving such

documents or information and necessary stenographic and clerical personnel thereof; (iii) technical experts and their staff who are employed for the purposes of this litigation (unless they are otherwise employed by, consultants to, or otherwise affiliated with a non-governmental party, or are employees of any domestic or foreign manufacturer, wholesaler, retailer, or distributor of the products, devices or component parts which are the subject of this investigation); (iv) the Commission, the Administrative Law Judge, the Commission staff, and personnel of any governmental agency as authorized by the Commission; and (v) the Commission, its employees, and contract personnel who are acting in the capacity of Commission employees, for developing or maintaining the records of this investigation or related proceedings for which this information is submitted, or in internal audits and investigations relating to the programs and operations of the Commission pursuant to 5 U.S.C. Appendix 3.1

4. Confidential business information submitted in accordance with the provisions of paragraph 2 above shall not be made available to any person designated in paragraph 3(i)2 and (iii) unless he or she shall have first read this order and shall have agreed, by letter filed with the Secretary of this Commission: (i) to be bound by the terms thereof; (ii) not to reveal such confidential business information to anyone other than another person designated in paragraph 3; and (iii) to utilize such confidential business information solely for purposes of this investigation.

5. If the Commission or the Administrative Law Judge orders, or if the supplier and all parties to the investigation agree, that access to, or dissemination of information submitted as confidential business information shall be made to persons not included in paragraph 3 above, such matter shall only be accessible to, or disseminated to, such persons based upon the conditions pertaining to, and obligations arising from this order, and such persons shall be

considered subject to it, unless the Commission or the Administrative Law Judge finds that the information is not confidential business information as defined in paragraph 1 thereof.

6. Any confidential business information submitted to the Commission or the Administrative Law Judge in connection with a motion or other proceeding within the purview of this investigation shall be submitted under seal pursuant to paragraph 2 above. Any portion of a transcript in connection with this investigation containing any confidential business information submitted pursuant to paragraph 2 above shall be bound separately and filed under seal. When any confidential business information submitted in accordance with paragraph 2 above is included in an authorized transcript of a deposition or exhibits thereto, arrangements shall be made with the court reporter taking the deposition to bind such confidential portions and separately label them "CONFIDENTIAL BUSINESS INFORMATION, SUBJECT TO PROTECTIVE ORDER." Before a court reporter or translator receives any such information, he or she shall have first read this order and shall have agreed in writing to be bound by the terms thereof. Alternatively, he or she shall sign the agreement included as Attachment A hereto. Copies of each such signed agreement shall be provided to the supplier of such confidential business information and the Secretary of the Commission.

7. The restrictions upon, and obligations accruing to, persons who become subject to this order shall not apply to any information submitted in accordance with paragraph 2 above to which the person asserting the confidential status thereof agrees in writing, or the Commission or the Administrative Law Judge rules, after an opportunity for hearing, was publicly known at the time it was supplied to the receiving party or has since become publicly known through no fault of the receiving party.

8. The Commission, the Administrative Law Judge, and the Commission investigative attorney acknowledge that any document or information submitted as confidential business information pursuant to paragraph 2 above is to be treated as such within the meaning of 5 U.S.C. § 552(b)(4) and 18 U.S.C. § 1905, subject to a contrary ruling, after hearing, by the Commission or its Freedom of Information Act Officer, or the Administrative Law Judge. When such information is made part of a pleading or is offered into the evidentiary record, the data set forth in 19 C.F.R. § 201.6 must be provided except during the time that the proceeding is pending before the Administrative Law Judge. During that time, the party offering the confidential business information must, upon request, provide a statement as to the claimed basis for its confidentiality.

9. Unless a designation of confidentiality has been withdrawn, or a determination has been made by the Commission or the Administrative Law Judge that information designated as confidential, is no longer confidential, the Commission, the Administrative Law Judge, and the Commission investigative attorney shall take all necessary and proper steps to preserve the confidentiality of, and to protect each supplier's rights with respect to, any confidential business information designated by the supplier in accordance with paragraph 2 above, including, without limitation: (a) notifying the supplier promptly of (i) any inquiry or request by anyone for the substance of or access to such confidential business information, other than those authorized pursuant to this order, under the Freedom of Information Act, as amended (5 U.S.C. § 552) and (ii) any proposal to redesignate or make public any such confidential business information; and (b) providing the supplier at least seven days after receipt of such inquiry or request within which to take action before the Commission, its Freedom of Information Act Officer, or the

Administrative Law Judge, or otherwise to preserve the confidentiality of and to protect its rights in, and to, such confidential business information.

10. If while an investigation is before the Administrative Law Judge, a party to this order who is to be a recipient of any business information designated as confidential and submitted in accordance with paragraph 2 disagrees with respect to such a designation, in full or in part, it shall notify the supplier in writing, and they will thereupon confer as to the status of the subject information proffered within the context of this order. If prior to, or at the time of such a conference, the supplier withdraws its designation of such information as being subject to this order, but nonetheless submits such information for purposes of the investigation; such supplier shall express the withdrawal, in writing, and serve such withdrawal upon all parties and the Administrative Law Judge. If the recipient and supplier are unable to concur upon the status of the subject information submitted as confidential business information within ten days from the date of notification of such disagreement, any party to this order may raise the issue of the designation of such a status to the Administrative Law Judge who will rule upon the matter. The Administrative Law Judge may sua sponte question the designation of the confidential status of any information and, after opportunity for hearing, may remove the confidentiality designation.

11. No less than 10 days (or any other period of time designated by the Administrative Law Judge) prior to the initial disclosure to a proposed expert of any confidential information submitted in accordance with paragraph 2, the party proposing to use such expert shall submit in writing the name of such proposed expert and his or her educational and detailed employment history to the supplier. If the supplier objects to the disclosure of such confidential business information to such proposed expert as inconsistent with the language or intent of this order or on other grounds, it shall notify the recipient in writing of its objection and the grounds therefore

prior to the initial disclosure. If the dispute is not resolved on an informal basis within ten days of receipt of such notice of objections, the supplier shall submit immediately each objection to the Administrative Law Judge for a ruling. If the investigation is before the Commission the matter shall be submitted to the Commission for resolution. The submission of such confidential business information to such proposed expert shall be withheld pending the ruling of the Commission or the Administrative Law Judge. The terms of this paragraph shall be inapplicable to experts within the Commission or to experts from other governmental agencies who are consulted with or used by the Commission.

12. If confidential business information submitted in accordance with paragraph 2 is disclosed to any person other than in the manner authorized by this protective order, the party responsible for the disclosure must immediately bring all pertinent facts relating to such disclosure to the attention of the supplier and the Administrative Law Judge and, without prejudice to other rights and remedies of the supplier, make every effort to prevent further disclosure by it or by the person who was the recipient of such information.

13. Nothing in this order shall abridge the right of any person to seek judicial review or to pursue other appropriate judicial action with respect to any ruling made by the Commission, its Freedom of Information Act Officer, or the Administrative Law Judge concerning the issue of the status of confidential business information.

14. Upon final termination of this investigation, each recipient of confidential business information that is subject to this order shall assemble and return to the supplier all items containing such information submitted in accordance with paragraph 2 above, including all copies of such matter which may have been made. Alternatively, the parties subject to this order may, with the written consent of the supplier, destroy all items containing confidential business

information and certify to the supplier (or his counsel) that such destruction has taken place. This paragraph shall not apply to the Commission, including its investigative attorney, and the Administrative Law Judge, which shall retain such material pursuant to statutory requirements and for other recordkeeping purposes, but may destroy those additional copies in its possession which it regards as surplusage.

Notwithstanding the above paragraph, confidential business information may be transmitted to a district court pursuant to Commission Rule 210.5(c).

15. If any confidential business information which is supplied in accordance with paragraph 2 above is supplied by a nonparty to this investigation, such a nonparty shall be considered a "supplier" as that term is used in the context of this order.

16. Each nonparty supplier shall be provided a copy of this order by the party seeking information from said supplier.

17. The Secretary shall serve a copy of this order upon all parties.



Theodore R. Essex
Administrative Law Judge

Attachment A

NONDISCLOSURE AGREEMENT FOR REPORTER/STENOGRAPHER/TRANSLATOR

I, _____, do solemnly swear or affirm that I will not divulge any information communicated to me in any confidential portion of the investigation or hearing in the matter of *Certain Handheld Electronic Computing Devices, Related Software, and Components Thereof*, Investigation No. 337-TA-769, except as permitted in the protective order issued in this case. I will not directly or indirectly use, or allow the use of such information for any purpose other than that directly associated with my official duties in this case.

Further, I will not by direct action, discussion, recommendation, or suggestion to any person reveal the nature or content of any information communicated during any confidential portion of the investigation or hearing in this case.

I also affirm that I do not hold any position or official relationship with any of the participants in said investigation.

I am aware that the unauthorized use or conveyance of information as specified above is a violation of the Federal Criminal Code and punishable by a fine of up to \$10,000, imprisonment of up to ten (10) years, or both.

Signed _____

Dated _____

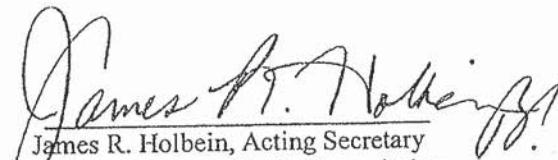
Firm or affiliation _____

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

Inv. No. 337-TA-769

PUBLIC CERTIFICATE OF SERVICE

I, James R. Holbein, hereby certify that the attached **ORDER 1** has been served by hand upon the Commission Investigative Attorney, Jeffrey Hsu, Esq, and the following parties as indicated on April 25 , 2011.


James R. Holbein, Acting Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, D.C. 20436

On Behalf of Complainant Microsoft Corporation:

Jonathan J. Engler, Esq.
ADDUCI MASTRIANI & SCHAUMBERG LLP
1200 17th Street, NW, 5th Floor
Washington, DC 20036

() Via Hand Delivery
() Via Overnight Delivery
() Via First Class Mail
() Other: _____

On Behalf of Respondents Barnes & Noble, Inc. and barnesandnoble.com LLC:

Marcia H. Sundeen, Esq.
KENYON & KENYON, LLP
1500 K Street, NW
Washington, DC 20005

() Via Hand Delivery
() Via Overnight Delivery
() Via First Class Mail
() Other: _____

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

Inv. No. 337-TA-769

CERTIFICATE OF SERVICE – PAGE TWO

Respondents:

Hon Hai Precision Industry Co., Ltd.
2 Zihyou Street, Tucheng City
Taipei County; 236
Taiwan

() Via Hand Delivery
() Via Overnight Mail
() Via First Class Mail
() Other: _____

Foxconn Electronics, Inc.
2 Zihyou Street, Tucheng City
Taipei County; 236
Taiwan

() Via Hand Delivery
() Via Overnight Mail
() Via First Class Mail
() Other: _____

Foxconn Precision Component (Shenzhen) Co.Ltd
No. 2, East Ring Road
No. 10 Industrial Zone
Yousong, Longhua, Shenzhen
Guandong 518109
China

() Via Hand Delivery
() Via Overnight Mail
() Via First Class Mail
() Other: _____

Foxconn International Holdings, Ltd
8F Peninsula Tower
538 Castle Peak Road
Cheung Sha Wan Kowloon
New Territories
Hong Kong

() Via Hand Delivery
() Via Overnight Mail
() Via First Class Mail
() Other: _____

Inventee Corporation
Inventee Building
No. 66 Hou-Kang Street
Shin-Lin District
Taipei County, 111
Taiwan

() Via Hand Delivery
() Via Overnight Mail
() Via First Class Mail
() Other: _____

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

Inv. No. 337-TA-769

PUBLIC CERTIFICATE OF SERVICE -PAGE THREE

PUBLIC MAILING LIST:

Heather Hall
LEXIS - NEXIS
9443 Springboro Pike
Miamisburg, OH 45342

Via Hand Delivery
 Via Overnight Mail
 Via First Class Mail
 Other: _____

Kenneth Clair
THOMSON WEST
1100 Thirteenth Street, NW, Suite 200
Washington, D.C. 20005

Via Hand Delivery
 Via Overnight Mail
 Via First Class Mail
 Other: _____

BARNES & NOBLE, INC.,
BARNESANDNOBLE.COM LLC
Applicants

And
INCORPORATED
Respondent

Court File No: 12-~~AV-~~

12 - 53320

ONTARIO
SUPERIOR COURT OF JUSTICE

Proceeding commenced at Ottawa

NOTICE OF APPLICATION

STIKEMAN ELLIOTT LLP

Barristers & Solicitors
Suite 1600, 50 O'Connor Street
Ottawa, Canada K1P 6L2

Nicholas McHaffie, LSCU# 37924D

Tel: (613) 566-0546

Megan MacDonald, LSUC# 60781M

Tel: (613) 566-0551

Fax: (613) 230-8877

Solicitors for the Applicants

Court File No. 12-CV-

**ONTARIO
SUPERIOR COURT OF JUSTICE**

B E T W E E N :

BARNES & NOBLE, INC. and BARNESANDNOBLE.COM LLC

Applicants

- and -

MOSAID TECHNOLOGIES INCORPORATED

Respondent

APPLICATION UNDER s. 60 of the *Evidence Act*, R.S.O. 1990, c. E.23
and s. 46 of the *Canada Evidence Act*, R.S.C. 1985, c. C.5

**AFFIDAVIT OF BRENDON DEMAY
(sworn January 9, 2012)**

I, BRENDON DEMAY, of the City of New York, in the State of New York, solicitor,
MAKE OATH AND SAY:

1. I am an attorney associated with the firm of Cravath, Swaine & Moore LLP, attorneys for Applicants Barnes & Noble, Inc. and barnesandnoble.com llc (collectively, "Barnes & Noble"), and as such have knowledge of the matters set forth herein, except where such information is stated to be on information and belief, and in such cases I verily believe that information to be true. I swear this affidavit in respect of relevant matters of fact and not opinion. By swearing this affidavit, neither I nor Barnes & Noble intends to waive any privilege over communications between Barnes & Noble and Cravath, Swaine & Moore LLP or other Barnes & Noble counsel in respect of the giving or receiving of legal advice or in respect of the litigation described herein.

2. I submit this affidavit in support of Barnes & Noble's application for enforcement of the urgent Request for International Judicial Assistance (Letter Rogatory) ("Letter of

Request") issued by the United States District Court for the District of Columbia (the "US District Court") to the Appropriate Judicial Authority of Canada to compel the production of evidence from MOSAID Technologies Incorporated ("MOSAID").

3. The Letter of Request was issued by the US District Court in Civil Action No. Misc. 11-673, entitled *Microsoft Corporation v. Barnes & Noble, Inc., barnesandnoble.com llc et al.*, at the recommendation of an Administrative Law Judge of the United States International Trade Commission ("ITC"). As set out in further detail below, Barnes & Noble and Microsoft Corporation ("Microsoft") are engaged in patent infringement proceedings before the ITC in Investigation No. 337-TA-769, entitled *Certain Handheld Electronic Computing Devices, Related Software, and Components Thereof* (the "ITC Action").

4. A true copy of the Letter of Request is attached hereto as **Exhibit "A"**. I understand that the original Letter of Request will be held by counsel and be available to the Court at the hearing of the within application.

The Parties

5. Barnes & Noble is a public company incorporated in the State of Delaware, with its head office in the city of New York. Barnes & Noble, a content, commerce and technology company, is in the business, *inter alia*, of providing customers with easy and convenient access to books, magazines, newspapers and other content across its multi-channel distribution platform.

6. The Respondent, MOSAID, is a Canadian incorporated company with its head office in Ottawa, Ontario. MOSAID is in the business, *inter alia*, of monetizing patented intellectual property in the areas of semiconductors and communications.

The ITC Action

7. The ITC Action is a civil patent infringement action based upon an amended verified complaint filed by Microsoft on April 8, 2011. In response to Microsoft's allegations in the complaint that Barnes & Noble's Nook™ and Nook Color™ e-book reader products, which run the Android operating system, infringe certain Microsoft patents, Barnes & Noble has raised several defences, including an affirmative defence of patent misuse. A true copy of

Microsoft's Amended Verified Complaint, dated April 8, 2011, is attached hereto as **Exhibit "B"**. A true copy of Barnes & Noble's Response, dated May 10, 2011, is attached hereto as **Exhibit "C"**.

8. Microsoft recently entered into a series of agreements with Nokia Corporation ("Nokia") and MOSAID, whose strategy as a patent licensing company includes expanding its patent portfolio through licensing partnerships and patent acquisitions.

9. To Barnes & Noble's understanding, through these agreements, Nokia transferred ownership of approximately 2,000 Nokia patents to MOSAID in exchange for MOSAID's promise to license those patents and pay approximately two-thirds of any royalties back to Microsoft and Nokia. In the words of John Lindgren, CEO of MOSAID, "the force of [its newly acquired patent portfolio] is overwhelming," and MOSAID is targeting "over a trillion dollars of unlicensed revenues" from mobile devices over the next ten years of sales.¹ MOSAID's Vice President has stated that, "all cell phones and smartphones operating in compliance with certain 2G, 3G and 4G wireless telecommunications standards" practice the patents.²

10. Barnes & Noble believes and alleges that the MOSAID deal is a key element of Microsoft's horizontal partnership with Nokia, which was announced within the past year and included an agreement by Nokia to use Microsoft's Windows Phone, instead of the rival Android, as Nokia's primary mobile operating system. One of the publicly stated motivations for the Microsoft-Nokia partnership is to combine the strength of the parties' respective patent portfolios and to coordinate their offensive use of patents directed at open source operating systems, including the Android operating system specifically.

11. In particular, on February 13, 2011, two days after Nokia and Microsoft announced their strategic agreement, Stephen Elop, Nokia's CEO, engaged in a videotaped question and

¹ Interview, "John Lindgren, CEO of MOSAID talks magnitude of Nokia/Microsoft deal", Sept. 9, 2011, <http://www.youtube.com/watch?v=37yzFT9xpys> (last visited Jan. 3, 2011).

² Statement of MOSAID Vice President, Dr. Nima Ahmadvand, "MOSAID acquires 2,000 Nokia Wireless Patents", Sept. 13, 2011, http://www.youtube.com/watch?v=Bdq3_jtOy_E (last visited Jan. 3, 2011).

answer session. In response to a question about Nokia's pending litigation against Apple's iOS, Mr. Elop stated that:

It is the case, and it was absolutely a topic of discussion with Microsoft, that Microsoft plus Nokia has a remarkably strong intellectual property portfolio. That is something that we will use appropriately within the context of our ecosystem, which means both defending the ecosystem from outside attacks as well as appropriately ensuring that the value that we have created through our patents are properly collected from other people who may choose to take advantage of that technology.³

Mr. Elop then stated that the “[n]umber one priority is to compete with Android which is why as part of the transaction that we intend to enter into with Microsoft..., we are contributing assets to the ecosystem from which our competitors will develop competitive advantage against Android.”⁴

12. Barnes & Noble now seeks to obtain non-public testimony and documents about MOSAID's business arrangement with Microsoft and Nokia, as well as the connection between Microsoft's demand that Barnes & Noble enter into a licensing agreement to use Android and its coordinated intellectual property strategy with MOSAID and Nokia.

13. Within the past three months, I or other attorneys of my firm made various efforts to obtain the discovery sought by this application without burdening this Honourable Court or the ITC or the judicial authorities of other jurisdictions. Barnes & Noble has requested documentary evidence from Microsoft pertaining to each of the Requests for Production sought from MOSAID through the Letter of Request. Barnes & Noble has deposed 15 Microsoft executives or former employees on patent misuse, several of whom were involved in the series of agreements with Nokia and MOSAID, and has questioned these witnesses on the Deposition Topics described in the Letter of Request. Microsoft was unable to supply

³ “Conversations by Nokia: Q&A videos, break down”, <http://conversations.nokia.com/2011/02/22/qa-videos-break-down> (last visited Jan. 3, 2011).

⁴ *Id.*

certain requested documents that should have been in its possession, which documents are believed to be in the possession of MOSAID. Testimony from Microsoft executives also demonstrates that Microsoft does not possess documents and information that are being sought and requested from MOSAID on this application. For example, some information requested is internal to MOSAID—such as MOSAID’s descriptions of its strategic discussions with Microsoft, as well as MOSAID’s analyses pertaining to the series of agreements and patents—and is unavailable from any other source. Other information involves communications between MOSAID and third parties, which again is not in the possession of Microsoft. Barnes & Noble on this application and in the requests for production and discovery seeks MOSAID’s information and records unavailable from Microsoft or any other source, in the context of the ITC Action.

14. For example, on October 20, 2011, the ITC granted Barnes & Noble’s application for the issuance of a subpoena *duces tecum* and subpoena *ad testificandum* requiring MOSAID’s United States subsidiary, MOSAID Corp. Ltd. (“MOSAID US”) to produce documents and submit a corporate deposition about the topics described in the Letter of Request, among others. A true copy of these subpoenas is attached hereto as **Exhibit “D”**.

15. In an e-mail from Mark Whitaker of Baker Botts LLP, counsel for MOSAID US, to Stuart W. Gold, a partner at Cravath, Swaine & Moore LLP, sent on November 7, 2011, at 2:01p.m., Mr. Whitaker stated, “the transactions for which Barnes & Noble seeks related documents and information from MOSAID involved MOSAID’s parent company, MOSAID Technologies Incorporated, not the US subsidiary.” Mr. Whitaker further indicated that MOSAID’s position was that if Barnes & Noble wished to “pursue the requested information from the parent company [*i.e.*, MOSAID], [it] will need to use Hague Convention or letters rogatory procedures.” A true copy of this e-mail is attached hereto as **Exhibit “E”**.

16. MOSAID US then moved to quash the subpoena served upon it on the ground that the requested evidence was in the exclusive control of MOSAID in Canada, and MOSAID US indicated that MOSAID was unwilling to provide the information voluntarily. A true copy of MOSAID Corp. Ltd.’s motion to quash and/or limit Barnes & Noble’s third-party subpoenas *duces tecum* and *ad testificandum* is attached hereto as **Exhibit “F”**.

17. Upon learning of this position, Barnes & Noble proceeded quickly to commence the procedure necessary to obtain a Letter of Request for international judicial assistance. An affidavit sworn by Mr. Gold on November 15, 2011 was presented to Administrative Law Judge Theodore R. Essex of the ITC in support of a request that the ITC make a recommendation to the US District Court for the issuance of a Letter Rogatory. A true copy of Barnes & Noble's Motion for Recommendation to the United States District Court for the District of Columbia to Issue a Letter Rogatory for Evidence from MOSAID Technologies Inc. is attached hereto as **Exhibit "G"**.

18. The ITC subsequently sealed and signed a Recommendation for Issuance of a Letter Rogatory for International Judicial Assistance to the District Court on December 2, 2011, requesting that the US District Court assign a judge and schedule a hearing to expedite the issuance of the Letter Rogatory in order to comply with the statutory time limitations on ITC investigations. Barnes & Noble filed a motion for issuance of Letter Rogatory with the US District Court on December 9, 2011. A true copy of Barnes & Noble's Motion for the Issuance of a Letter Rogatory for International Judicial Assistance is attached hereto as **Exhibit "H"**.

19. On December 12, 2011, United States District Judge Royce C. Lambert made an order that the Clerk of the Court issue a Letter Rogatory. The order was certified on December 15, 2011, and filed on December 23, 2011. The Letter of Request was issued by Deputy Clerk Angela D. Caesar on December 28, 2011. As noted above, a true copy of the Letter Rogatory is attached hereto as Exhibit "A".

20. The hearing in the ITC Action is scheduled to begin on February 6, 2012. The timing of obtaining the requested documents and evidence from MOSAID is therefore urgent.

21. The Letter of Request is necessary in the interest of justice because, as stated above, the evidence to be obtained from MOSAID directly bears on Barnes & Noble's patent misuse affirmative defence and is unobtainable without the assistance of this Honourable Court. The Letter of Request has been narrowly tailored to seek information that will provide evidence of the details of and reasons for the Microsoft-Nokia-MOSAID agreement beyond the facts already available, including information about MOSAID's business arrangement with

Microsoft and Nokia, as well as the connection between Microsoft's demand that Barnes & Noble enter into a licensing agreement to use the Android operating system and its coordinated intellectual property strategy with MOSAID and Nokia.

22. Based on statements made by counsel for MOSAID US, there is a substantial likelihood that the documents and testimony set out in the Letter of Request are within the possession, control or power of MOSAID, and thus obtainable by Barnes & Noble in this manner. The MOSAID entity that entered into the relevant agreements is in Canada. Barnes & Noble's attempts to obtain the same documents and testimony from MOSAID US or from Microsoft have been unsuccessful, and MOSAID has been unwilling to produce relevant documents or furnish a corporate witness in or outside of Canada voluntarily. Moreover, Barnes & Noble has non-public evidence that MOSAID is in possession of highly relevant information establishing that Microsoft coordinated its patent offensive with Nokia and MOSAID. Barnes & Noble is currently seeking Microsoft's approval to provide the Court with this confidential information. Barnes & Noble will provide this information to the Court if and when such use is approved.

SWORN BEFORE ME at the City of
New York, in the State of New York on
January 9, 2012.

Tracey J. Murtha
Commissioner for Taking Affidavits


BRENDON DEMAY

Tracey J. Murtha
Notary Public State of New York
No. 43-4768543
Qualified in Richmond County
Certificate Filed in New York County
Comm. Expires November 30, 2014

BARNES & NOBLE, INC.,
BARNESANDNOBLE.COM LLC
Applicants

MOSAID TECHNOLOGIES
INCORPORATED
Respondent

Court File No: 12-CV-

ONTARIO
SUPERIOR COURT OF JUSTICE

Proceeding commenced at Ottawa

AFFIDAVIT OF BRENDON DEMAY

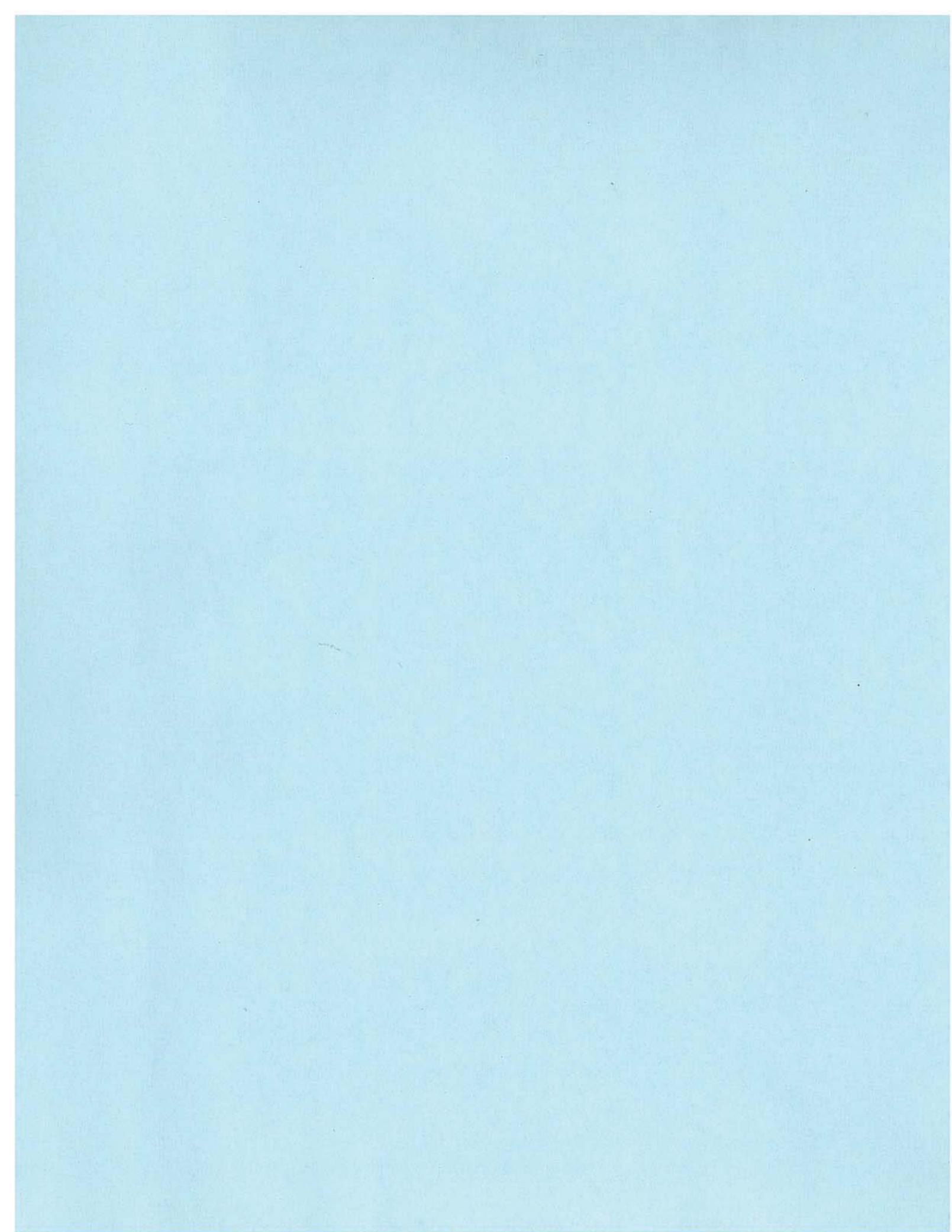
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Solicitors for the Applicants



Court File No. 12-53320

**ONTARIO
SUPERIOR COURT OF JUSTICE**

B E T W E E N :

BARNES & NOBLE, INC. and BarnesandNoble.com LLC

Applicants

- and -

MOSAID TECHNOLOGIES INCORPORATED

Respondent

APPLICATION UNDER s. 60 of the *Evidence Act*, R.S.O. 1990, c. E.23
and s. 46 of the *Canada Evidence Act*, R.S.C. 1985, c. C.5

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January 11, 2012

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TABLE OF CONTENTS

| | | |
|------------|---|----|
| PART I - | OVERVIEW | 4 |
| PART II - | FACTS | 5 |
| A. | The Parties and the ITC Action..... | 5 |
| B. | Efforts to Obtain Information Regarding MOSAID's Business Arrangements with Microsoft..... | 6 |
| C. | Procedural History of the Letter of Request | 7 |
| D. | The Letter of Request..... | 8 |
| E. | The Urgency of the Request..... | 10 |
| PART III - | ISSUES | 11 |
| PART IV - | LAW..... | 11 |
| A. | Statutory Provisions | 11 |
| B. | General Principles | 11 |
| C. | The Six-Part Test for Enforcement of Letters of Request..... | 12 |
| 1) | The Evidence Sought is Relevant | 13 |
| 2) | The Evidence is Necessary for and Will be Used at Trial | 15 |
| 3) | The Evidence Requested is Not Otherwise Obtainable | 16 |
| 4) | Recognizing the Letter of Request is Not Contrary to Public Policy | 17 |
| 5) | The Documents and Evidence Have Been Identified With Reasonable Specificity | 18 |
| 6) | The Requested Order Is Not Unduly Burdensome | 19 |
| PART V - | ORDER REQUESTED..... | 20 |
| | SCHEDULE "A": LIST OF AUTHORITIES | 23 |
| | SCHEDULE "B": STATUTES AND REGULATIONS REFERRED TO | 23 |

PART I - OVERVIEW

1. Barnes & Noble, Inc. and barnesandnoble.com llc (collectively, “Barnes & Noble”) seek orders recognizing and giving effect to a Request for International Judicial Assistance (Letter Rogatory) from the United States District Court for the District of Columbia (the “US District Court”) dated December 28, 2011, in Civil Action No. Misc. 11-673 (the “Letter of Request”) in respect of the Respondent, MOSAID Technologies Incorporated (“MOSAID”).
2. In the Letter of Request, the US District Court asks this Honourable Court for judicial assistance in obtaining evidence to be used at trial in a civil patent infringement action before the United States International Trade Commission (“ITC”), which is scheduled to commence on February 6, 2012 (the “ITC Action”). In particular, the US District Court asks this Court to compel MOSAID to produce certain documents and to testify under oath through its CEO, John Lindgren. The US District Court has noted its belief that MOSAID has “highly relevant” documents in its possession and knowledge regarding materials facts. The US District Court has also stated that it believes that justice cannot be served between the parties without the requested evidence being made available. The evidence requested was found similarly by an Administrative Law Judge of the ITC to be “reasonably necessary to investigate fully Barnes & Noble’s affirmative defense of patent misuse” in the ITC Action.
3. It is respectfully submitted that the evidence requested meets this Court’s criteria for the enforcement of letters of request. In particular, as set out further below, the evidence sought is relevant to and necessary for trial in the ITC Action and is not otherwise obtainable by Barnes & Noble. Barnes & Noble has identified with specificity the documents required, and the order sought is neither contrary to public policy nor unduly burdensome to MOSAID.
4. Barnes & Noble therefore asks that this Honourable Court give effect to the Letter of Request by ordering MOSAID to produce to Barnes & Noble the documents described in Addendum A to the Letter of Request; and to appear through Mr. Lindgren to give evidence under oath with respect to the topics set out in Addendum B to the Letter of Request; all within a time frame sufficient to allow the evidence to be obtained in time for the trial that will commence on February 6, 2012.

PART II - FACTS

The Parties and the ITC Action

5. Barnes & Noble, a public company incorporated in the State of Delaware and headquartered in the city of New York, is a content, commerce and technology company that provides customers with access to books, magazines, newspapers and other content through a multi-channel distribution platform. Barnes & Noble is a defendant in the ITC Action, in which Microsoft Corporation (“Microsoft”) has alleged that Barnes & Noble’s Nook™ and Nook Color™ e-book readers infringe various patents held by Microsoft.

Affidavit of Brendon DeMay, sworn January 9, 2012 (“DeMay Affidavit”), Application Record, Tab 2, at pp. 35-36, paras. 5 and 7.

Amended Verified Complaint of Microsoft Corporation, dated April 8, 2011, Exhibit B to the DeMay Affidavit, Application Record, Tab 2B, at pp. 80-81, 86, paras. 1-6, 27.

6. In response to Microsoft’s allegations, Barnes & Noble has raised several defences, including an affirmative defence of patent misuse. As part of this defence, Barnes & Noble has alleged that Microsoft is using its licensing practices to broaden improperly its patent grant in an attempt to dominate open source mobile operating systems (like the Android operating system used in Barnes & Noble’s handheld devices) that threaten Microsoft’s monopoly in personal computer (“PC”) operating systems.

DeMay Affidavit, Application Record, Tab 2, at p. 35, para. 7.

Response of Barnes & Noble, dated May 10, 2011, Exhibit C to the DeMay Affidavit (“Response”), Application Record, Tab 2C, at pp. 154-171, paras. 1-56.

7. MOSAID is a Canadian company headquartered in Ottawa that is in the business, *inter alia*, of monetizing patented intellectual property by licensing patents. To this end, its strategy as a licensing company includes expanding its patent portfolio through licensing partnerships and patent acquisitions.

DeMay Affidavit, Application Record, Tab 2, at pp. 35-36, paras. 6 and 8.

8. Microsoft recently entered into a series of agreements with Nokia Corporation (“Nokia”) and MOSAID, pursuant to which Nokia transferred approximately 2,000 patents to

MOSAID in exchange for MOSAID's promise to license those patents and pay approximately two-thirds of any royalties back to Microsoft and Nokia.

DeMay Affidavit, Application Record, Tab 2, at p. 36, paras. 8-9.

9. Barnes & Noble alleges that the MOSAID transaction is a key element of the recently announced horizontal partnership between Microsoft and Nokia, particularly given the parties' publicly-stated motivations of combining the strength of their respective patent portfolios and coordinating their offensive use of patents against open-source operating systems, including the Android operating system specifically.

DeMay Affidavit, Application Record, Tab 2, at p. 36, para. 10.

Efforts to Obtain Information Regarding MOSAID's Business Arrangements with Microsoft

10. Given the nature of Barnes & Noble's affirmative defence and the importance of the transaction described above, documents and evidence pertaining to MOSAID's business arrangements with Microsoft and Nokia are highly relevant to the ITC Action. Barnes & Noble has therefore made efforts throughout the ITC Action to obtain this information. In particular, Barnes & Noble has made documentary production requests from Microsoft and has examined 15 Microsoft executives or former employees on the issue of patent misuse, several of whom were involved in the transactions between Microsoft, MOSAID and Nokia.

DeMay Affidavit, Application Record, Tab 2, at p. 37, para. 13.

11. Nonetheless, Microsoft was unable to provide certain documents that ought to have been in its possession, and was of course also not able to provide documents or other evidence that is internal to MOSAID or between MOSAID and Nokia.

DeMay Affidavit, Application Record, Tab 2, at pp. 37-38, para. 13.

12. Barnes & Noble therefore applied to the ITC for subpoenas requiring MOSAID's United States subsidiary, MOSAID Corp. Ltd. ("MOSAID US"), to produce documents and submit corporate depositions about the topics described in the Letter of Request, among others. On October 20, 2011, the ITC granted this application and issued the subpoenas.

DeMay Affidavit, Application Record, Tab 2, at para. 14.

Subpoena *duces tecum* and subpoena *ad testificandum* issued October 20, 2011, Exhibit D to the DeMay Affidavit, Application Record, Tab 2D, pp. 197-210.

13. MOSAID US moved to quash the subpoenas served upon it on the ground that the requested evidence was in the exclusive control of MOSAID in Canada, and indicated that MOSAID was unwilling to provide the information voluntarily. This motion has not yet been determined by the ITC.

DeMay Affidavit, Application Record, Tab 2, at p. 38, paras. 15-16.

Email from Mark Whitaker dated November 7, 2011, Exhibit E to the DeMay Affidavit, Application Record, Tab 2E, p. 240.

MOSAID US Motion to Quash and/or Limit Subpoenas, dated November 8, 2011, Exhibit F to the DeMay Affidavit, Application Record, Tab 2F, pp. 244-268.

Procedural History of the Letter of Request

14. Having learned on November 7, 2011, that neither MOSAID US nor MOSAID would voluntarily produce the requested documents, Barnes & Noble promptly sought a recommendation from Administrative Law Judge Theodore R. Essex – the judge assigned to preside over pretrial matters, conduct the trial and issue an initial determination on the merits of the matter – for the issuance of a letter rogatory for international judicial assistance.

DeMay Affidavit, Application Record, Tab 2, at p. 39, para. 17.

Motion for Recommendation to the United States District Court for the District of Columbia to Issue a Letter Rogatory for Evidence dated November 16, 2011, Exhibit G to the DeMay Affidavit, Application Record, Tab 2G.

15. On December 2, 2011, Judge Essex issued the requested Recommendation for the Issuance of a Letter Rogatory for International Judicial Assistance, recommending that the US District Court issue a letter rogatory to allow Barnes & Noble to obtain the evidence in Canada. In the Recommendation, Judge Essex noted the relevance of the requested evidence:

The undersigned Administrative Law Judge finds that the evidence that [Barnes & Noble] seek pursuant to the Request for International Judicial Assistance (Letter Rogatory) (“Letter Rogatory”) is reasonably necessary to investigate fully Barnes & Noble’s affirmative defence of patent misuse against Complainant Microsoft Corporation. [emphasis added]

DeMay Affidavit, Application Record, Tab 2, at para. 18.

Recommendation For Issuance of a Letter Rogatory for International Judicial Assistance, dated December 2, 2011, contained in Motion for the Issuance of a Letter Rogatory, Exhibit H to the DeMay Affidavit, Application Record, Tab 2H, at p. 433.

16. Judge Essex also asked that in order to comply with the statutory time limitations on ITC investigations, “the Court assign a judge and schedule a hearing to expedite the issuance of the Letter Rogatory”.

Recommendation For Issuance of a Letter Rogatory for International Judicial Assistance, dated December 2, 2011, Application Record, Tab 2H, at p. 433.

17. On the basis of Judge Essex’s Recommendation, Barnes & Noble promptly filed a motion for issuance of Letter Rogatory with the US District Court.

DeMay Affidavit, Application Record, Tab 2, at para. 18.

Motion for the Issuance of a Letter Rogatory for International Judicial Assistance dated December 9, 2011, Exhibit H to the DeMay Affidavit, Application Record, Tab 2H.

18. On December 12, 2011, the Honourable Chief Judge Royce C. Lamberth agreed that MOSAID’s evidence is relevant and necessary for trial and granted Barnes & Noble’s motion, ordering that the Letter Rogatory be issued in the form attached. Pursuant to this order, the Clerk of the US District Court issued the Letter Rogatory on December 28, 2011.

Order for the Issuance of a Letter Rogatory, dated December 12, 2011, Exhibit A to the DeMay Affidavit, Application Record, Tab 2A, at p. 67.

Letter of Request, dated December 28, 2011, Schedule A to the Notice of Application, Application Record, Tab 1A, at pp. 10-16.

The Letter of Request

19. In the Letter of Request, the US District Court requests the assistance of the Appropriate Judicial Authority of Canada (*i.e.*, this Honourable Court) to compel “the appearance of MOSAID [...] to testify under oath through John Lindgren, the Chief Executive Officer of MOSAID, the person most knowledgeable about the topics below, and to compel the production of the documents identified below from MOSAID.” In this regard, the US District Court states that based on Barnes & Noble’s submissions:

[T]his Court believes that justice cannot be served between the parties in the above-captioned matter unless the evidence requested herein is made available by the Appropriate Judicial Authority of Canada for use in an investigation being conducted by the International Trade Commission into whether Barnes & Noble's Nook and Nook Color infringe patents owned by Microsoft. The Court believes that MOSAID has knowledge regarding material facts and is in possession of documents that are highly relevant to Barnes & Noble's patent misuse defense that cannot be obtained without the assistance of the Appropriate Judicial Authority. [...] Barnes & Noble has no other option but to seek international judicial assistance. [emphasis added]

Letter of Request, Application Record, Tab 1A, at pp. 10-11.

20. The Letter of Request contains three addenda. Addendum A sets out the request for documentary production, divided into eight categories. Each category sets out with specificity a category of documents requested that is relevant to the ITC Action. For example, the first request for production is for “[a]ll documents, including any document or thing exchanged between MOSAID and Microsoft or Nokia, relating to any possible infringement claims involving Barnes & Noble's Nook™ and Nook Color™ products.” Each request for documentary production pertains to aspects of the ITC Action and Barnes & Noble's affirmative defence of patent abuse.

Letter of Request, Application Record, Tab 1A, at Addendum A, pp. 17-18.

21. Addendum B to the Letter of Request delineates nine specific topics for the examination of MOSAID through John Lindgren. Again, the topics are set out with specificity, and essentially parallel the documentary requests. The Letter of Request notes that with respect to the examination, Mr. Lindgren may refuse to answer questions on grounds of privilege under Canadian law, if they would subject Mr. Lindgren to criminal liability in the United States, or disclose confidential solicitor-client communications.

Letter of Request, Application Record, Tab 1A, at pp. 14-15 and Addendum B, pp. 19-20.

22. Addendum C to the Letter of Request is a copy of the Protective Order issued by Judge Essex in the ITC Action, which the US District Court confirms applies to protect the confidentiality of records produced by MOSAID.

Letter of Request, Application Record, Tab 1A, at p. 15 and Addendum C, pp. 22-30.

23. The documents and evidence set out in the Letter of Request are unobtainable without the assistance of this Court, and have been narrowly tailored to seek evidence of the Microsoft-Nokia-MOSAID agreement beyond the facts already available.

DeMay Affidavit, Application Record, Tab 2, at paras. 21.

The Urgency of the Request

24. As noted above, the trial in the ITC Action is to begin on February 6, 2012. In light of this, the US District Court has respectfully asked this Court to give this matter urgent attention.

Letter of Request, Application Record, Tab 1A, at p. 11.

25. The US District Court also refers to the period for fact discovery, which concluded on December 14, 2011. However, the US District Court ultimately issued the Letter of Request after this date had passed. Barnes & Noble initiated the request for evidence from MOSAID prior to the December 14, 2011 date and is, in any event, currently applying to the ITC to keep the record open for fact discovery to confirm that admissible evidence from the within process may be considered for use at trial.

Letter of Request, Application Record, Tab 1A, at p. 11.

PART III - ISSUES

26. The sole issue to be determined in this Application is whether this Court ought to recognize and enforce the Letter of Request issued by the US District Court, thereby permitting Barnes & Noble to obtain the relevant and necessary evidence for use at the trial in the ITC Action.

PART IV - LAW

A . S t a t u t o r y P r o v i s i o n s

27. Both the Ontario *Evidence Act* and the *Canada Evidence Act* provide statutory authority for the granting of foreign judicial requests for assistance. The relevant provisions provide, *inter alia*, that, upon fulfillment of the conditions set out therein, a Court in this jurisdiction may order the examination of witnesses and the production of documents.

Evidence Act, R.S.O. 1990, c. E. 23, s. 60(1), Tab A hereto.

Canada Evidence Act, R.S.C. 1985 c. C-15, s. 46(1), Tab B hereto.

B . G e n e r a l P r i n c i p l e s

28. International judicial co-operation is founded upon the concept of the comity of nations. In *Zingre v. R.*, Dickson J. (as he then was) stated for the Supreme Court of Canada:

It is upon [the] comity of nations that international legal assistance rests. Thus the courts of one jurisdiction will give effect to the laws and judicial decisions of another jurisdiction, not as a matter of obligation but out of mutual deference and respect. A foreign request is given full force and effect unless it be contrary to the public policy of the jurisdiction to which the request is directed ... or otherwise prejudicial to the sovereignty or the citizens of the latter jurisdiction.
[emphasis added]

Zingre v. R., [1981] 2 S.C.R. 392, at p. 401 (“*Zingre*”).

Bank of Credit & Commerce International S.A. (in Liquidation) v. Hague (1996), 30 O.R. 3d. 477 at 479 (Gen. Div.) (“*Bank of Credit*”).

Germany (Federal Republic) v. Canadian Imperial Bank of Commerce (1997), 31 O.R. (3d) 684 at 695 (Gen. Div.) (“*Germany v. CIBC*”).

Re Friction Division Products, Inc. and E. I. Du Pont de Nemours & Co. Inc. et al. (No. 2) (1986), 56 O.R. (2d) 722 at 732 (H.C.J.) (“*Friction v. Du Pont*”).

Treat America Ltd. v. Nestlé Canada Inc., 2011 ONCA 560, 9 C.P.C. (7th) 1 at para. 17 (“*Treat America*”).

29. This Honourable Court has stated that requests of foreign courts for assistance should be viewed without rigidity and has noted the relaxation of those circumstances in which such requests will be given effect in Ontario.

Friction v. Du Pont, supra, at 733.

Mulroney v. Coates (1986), 54 O.R. (2d) 353 at para. 19 (H.C.J.) (“*Mulroney*”).

30. Although an Ontario court must verify that the findings of a foreign judge are supported on the record, the Ontario Court of Appeal has held that: “The law is clear that [a foreign judge’s] decision is entitled to considerable deference in the Canadian application and that the court receiving the request for assistance does not sit in appeal from the decision of the requesting court” [emphasis added]. The observations and conclusions of a foreign court are thus entitled to deference and respect, and should be given “full faith and credit” by an Ontario court.

Treat America, supra, at para. 19.

Connecticut Retirement Plans & Trust Funds v. Buchan (2007), 225 O.A.C. 106 at para. 13 (Ont. C.A.) (“*Connecticut*”).

O.P.S.E.U. Pension Trust Fund (Trustee of) v. Clark (2006), 270 D.L.R. (4th) 429 at para. 22 (Ont. C.A.) (“*O.P.S.E.U.*”).

AstraZeneca LP v. Wolman, [2009] O.J. No. 5344 at para. 19 (Ont. S.C.J.) (“*AstraZeneca*”)

C . T h e S i x - P a r t T e s t f o r E n f o r c e m e n t o f L e t t e r s o f R e q u e s t

31. In *Friction v. Du Pont, supra*, Osborne J. (as he then was) articulated the following criteria for the enforcement of letters of request:

Before an order giving effect to letters rogatory will be made, the evidence (including the letters rogatory) must establish that:

- (1) the evidence sought is relevant;
- (2) the evidence sought is necessary for trial and will be adduced at trial, if admissible;

- (3) the evidence is not otherwise obtainable;
- (4) the order sought is not contrary to public policy;
- (5) the documents are identified with reasonable specificity; and
- (6) the order sought is not unduly burdensome, having in mind what the relevant witnesses would be required to do, and produce, were the action to be tried here.

Friction v. Du Pont, supra, at 732.

Bank of Credit, supra, at 479-480.

Fidelity Bankers Life Insurance Co. v. Dowsley, [1996] O.J. No. 2371, 2 C.P.C. (4th) 45 at para. 6 (Ont. Gen. Div.) (“*Fidelity Bankers*”).

32. This Court has, with consideration given to the factors set out above, given effect to foreign letters of request compelling parties to give evidence in relation to foreign proceedings, even where such parties were not themselves named in the foreign proceedings and where such proceedings were merely at the pre-trial or discovery stage. Indeed, the Supreme Court of Canada has stated that a foreign request is to be given full force and effect unless it is contrary to the public policy of the jurisdiction to which the request is directed or otherwise prejudicial to its sovereignty and further that the Court should not refuse to make the order solely because the testimony relates to a pre-trial proceeding.

Fidelity Bankers, supra, at para. 7.

Germany v. CIBC, supra, at 695-697.

Zingre, supra, at 401, 403-404.

33. Barnes & Noble submits that each of the factors set out in *Friction* have been satisfied in the present case, as explained and established below.

1) The Evidence Sought is Relevant

34. The evidence sought with respect to the patent licensing arrangement between Microsoft, MOSAID and Nokia is relevant to the Amended Verified Complaint of Microsoft in the ITC Action and Barnes & Noble’s affirmative defence of patent misuse thereto.

35. In assessing the relevance of requested evidence, with due deference to the findings of a foreign court, Ontario courts have considered whether links between evidence sought and claims in the foreign litigation demonstrate that the evidence is “likely relevant” or more likely than not to be relevant. In other words, while the admissibility of any evidence requested is to be determined by the foreign court, an applicant must demonstrate relevance on a balance of probabilities.

AstraZeneca, supra, at paras. 23-25.

Connecticut, supra, at para. 10.

Friction v. Du Pont, supra, at para. 28.

36. The US District Court’s finding that MOSAID has knowledge regarding material facts and is in possession of documents that are “highly relevant” should thus be given full force and effect unless contrary to the public policy of Ontario.

AstraZeneca, supra, at para. 23.

37. On the record alone, the links between Barnes & Noble’s affirmative defence of patent misuse and the evidence sought in Addenda “A” and “B” to the Letter of Request, namely evidence related to those exchanges between MOSAID, Microsoft and Nokia in respect of Barnes & Noble’s alleged infringement of certain Microsoft patents, are manifest. This is attested to in the DeMay Affidavit and has been further demonstrated by the Administrative Law Judge in the ITC Action who, intimately acquainted with the foreign litigation, recommended that international judicial assistance be requested in obtaining “critical evidence” for the investigation in the ITC Action and issued a subpoena *duces tecum* and subpoena *ad testificandum* requiring MOSAID US to produce documents and submit a corporate deposition about the topics described in the Letter of Request, among others.

Letter of Request, Application Record, Tab 1A.

DeMay Affidavit, Application Record, Tab 2, at paras. 7-12 and 21.

Recommendation For Issuance of a Letter Rogatory for International Judicial Assistance, dated December 2, 2011, Application Record, Tab 2H, at p. 434.

38. In light of the above, it is respectfully submitted that this Court should show considerable deference to the US District Court’s findings regarding the relevance of the

requested evidence, and that, in any event, Barnes & Noble has demonstrated the relevance of the requested evidence on the record.

2) The Evidence is Necessary for and Will be Used at Trial

39. The Letter of Request is expressly directed to evidence “to be used at trial”. The “highly relevant” evidence sought in the Letter of Request is necessary to the ITC Action since, as recognized by the US District Court, “justice cannot be served between the parties” to the ITC Action unless the requested evidence is obtained in relation to Barnes & Noble’s affirmative patent misuse defence.

Letter of Request, Application Record, Tab 1A, at p. 2

40. This Honourable Court has assessed the necessity criterion on the basis of an evidentiary link between the parties to the foreign litigation and the Ontario objects of the request, taking into account the issues in the foreign litigation.

AstraZeneca, supra, at para. 26.

Friction v. Du Pont, supra, at para. 29.

41. The record establishes that it would be unfair to Barnes & Noble to proceed to trial in the ITC without an opportunity to obtain the requested information from MOSAID. The requests in Addenda “A” and “B” of the Letter of Request have been narrowly tailored to go beyond what is available from public sources or what is likely to be in the possession or knowledge of the opposing party in the ITC Action, Microsoft. Given Barnes & Noble’s belief and allegations that the MOSAID deal is a key element of Microsoft’s improper efforts to use patent licenses to impair competition from Android and other open-source operating systems, Barnes & Noble requires the production of documents and deposition of Mr. Lindgren of MOSAID in order to mount a full and fair defence to Microsoft’s Amended Verified Complaint pursuant to the facts set out in Barnes & Noble’s Response.

DeMay Affidavit, Application Record, Tab 2, at paras. 10 and 22.

Amended Verified Complaint dated April 8, 2011, Exhibit B to DeMay Affidavit, Application Record, Tab 2B .

Response, Exhibit C to DeMay Affidavit, Application Record, Tab 2C.

42. It is thus respectfully submitted that the facts of this case as set out in the record demonstrate the evidence requested in the Letter of Request is necessary in the interest of justice and will be adduced at trial, if admissible.

3) The Evidence Requested is Not Otherwise Obtainable

43. The addenda to the Letter of Request setting out requested documents and topics of examination have been narrowly tailored to go beyond what is available from public sources or what is or is likely to be in the possession or knowledge of Microsoft, the opposing party in the ITC Action. While 15 Microsoft witnesses were deposed, they could not supply all necessary information. For example, certain evidence is internal to MOSAID or was exchanged only between MOSAID and Nokia.

DeMay Affidavit, Application Record, Tab 2, at paras. 13 and 22.

Letter of Request, Application Record, Tab 1A, at Addenda A and B, pp. 17-20.

44. Despite efforts made over the course of several months, the issuance of a subpoena *duces tecum* and subpoena *ad testificandum* requiring MOSAID US to produce documents and submit a corporate deposition about the topics described in the Letter of Request, among others, Barnes & Noble has been unable to obtain the requested documents and testimony from MOSAID US. MOSAID US moved to quash the subpoena served upon it on the grounds, *inter alia*, that the requested evidence was in the exclusive control of MOSAID in Canada and indicated that MOSAID was unwilling to provide the information voluntarily. As such, there is a substantial likelihood that the documents and testimony set out in the Letter of Request are within the possession, control or power of MOSAID. Moreover, Barnes & Noble has non-public evidence that MOSAID is in possession of highly relevant information establishing that Microsoft coordinated its patent offensive with Nokia and MOSAID.

DeMay Affidavit, Application Record, Tab 2, at paras. 13-15 and 22.

45. In assessing whether information is otherwise attainable, this Court has held that the criterion should not be interpreted so narrowly as to require an applicant to establish that no evidence on the subject is otherwise available. Instead, an applicant need only show that “evidence of the same value” as that sought cannot otherwise be obtained. In particular, this

Court has held that it is not an answer to say that some information pertaining to the requested production and depositions might be obtained from the production and depositions of other parties to a proceeding if such evidence is not of the same value as that sought.

AstraZeneca, supra, at para. 27.

Connecticut, supra, at para. 19.

Treat America, supra, at para. 24.

46. As noted above, the production and depositions sought from MOSAID in Addenda “A” and “B” to the Letter of Request have been narrowly tailored to solicit information beyond that which is publicly available or within the possession or knowledge of Microsoft. To the extent that certain elements of the addenda could nevertheless be alleged to be otherwise obtainable, evidence from any other source would not have the same value as that sought in the Letter of Request due to MOSAID’s unique and specific insight into Microsoft’s horizontal partnership with Nokia as a patent licensing company and its positioning and strategy in relation to the Microsoft-Nokia-MOSAID agreement.

DeMay Affidavit, Application Record, Tab 2, at paras. 6-11 & 22.

47. In light of the above, it is respectfully submitted that the evidence sought in the Letter of Request is not obtainable by Barnes & Noble from another source.

4) Recognizing the Letter of Request is Not Contrary to Public Policy

48. Enforcement of the US District Court’s Letter of Request is necessary in the interests of justice and not contrary to public policy in any way.

49. The order sought would be conducted according to the *Rules of Civil Procedure* and the *Evidence Acts* of Ontario and Canada. Indeed, the order sought would be consistent with Ontario’s own *Rules of Civil Procedure* which provide for the production of documents from non-parties and the discovery of non-parties to a proceeding. While these rules may serve as useful guideposts to a Court, overlap substantially with the conditions for the enforcement of a letter of request, and would be satisfied in this case, the enforcement of a letter of request by an Ontario court is not limited to those cases in which it would make an order under those rules. The circumstances in which an Ontario court will grant an order enforcing letters of

request where non-parties are the target of the request should, however, not be any rarer than those in which a similar request might emanate from an Ontario court to a foreign jurisdiction.

Rules of Civil Procedure (Ontario), R.S.O. 1990, Reg. 194, Rules 30.10 & 31.10 (*Rules of Civil Procedure*), Tab C hereto.

AstraZeneca, supra, at para. 20.

Friction v. Du Pont, supra, at paras. 14-15.

5) The Documents and Evidence Have Been Identified With Reasonable Specificity

50. The documents requested in Addendum A to the Letter of Request specifically target information related to Barnes & Noble's products (No. 1), MOSAID's strategy in acquiring the Nokia patents (No. 2), the MOSAID-Microsoft-Nokia agreement (No.'s 3 and 6), patents asserted in Microsoft's Amended Verified Complaint and patents or patent rights asserted against open source operating systems (No.'s 4, 5 and 7), and Microsoft's coordinated intellectual property strategies in relation to mobile devices or mobile device operating systems (No. 8). Barnes & Noble's request is specifically targeted in part because Barnes & Noble has already examined the documents produced by Microsoft in the ITC Action and has therefore been able to better identify the evidence that must be obtained from MOSAID. Each request, while reasonably specific, is more generally relevant to Barnes & Noble's affirmative defence of patent misuse.

Letter of Request, Application Record, Tab 1A, at Addendum A, pp. 17-18.

51. While each request for production in the US District Court's Letter of Request is reasonably specific, Ontario courts have found letters of request to be valid even where specific requests are framed broadly provided the targeted deponent has some information within the broadly framed request that is relevant to the issues in the foreign litigation. The level of specificity required is fact-dependent such that documents need only be "sufficiently identified", whether specifically or by class, and production may in some cases be wide, provided it is not unreasonable or unduly onerous. In *Friction*, the court noted that:

In many instances it will be impossible for a party on the outside, denied a look inside, to determine what documents are relevant to the issues and what documents may be reasonably ancillary to the evidence of a witness sought to be examined. Requiring a witness to

search a number of files may in one case be burdensome, and in another quite reasonable.

O.P.S.E.U., supra, at para. 25.

Friction v. Du Pont, supra, at paras. 38 and 42-43.

AstraZeneca, supra, at para. 28.

52. Each of the requests for production in the Letter of Request are both relevant and necessary to the ITC Action. Given the specificity of the requests set out in Addenda A and B to the Letter of Request and the importance of Barnes & Noble's patent misuse defence within the context of the ITC Action, it is respectfully submitted that the "reasonable specificity" criterion has been plainly satisfied in this case.

6) The Requested Order Is Not Unduly Burdensome

53. The "unduly burdensome" criterion involves asking whether the proposed witness is being asked to do anything that would be considered burdensome or oppressive, measured against the witnesses' obligations in Ontario if the matter were to be tried here.

AstraZeneca, supra, at para. 29.

Friction v. Du Pont, supra, at para. 34.

54. The order sought by Barnes & Noble would not be unduly burdensome to MOSAID since the documents and oral evidence sought are identified with sufficient specificity in Addenda A and B to the Letter of Request to identify their connection and relevance to the ITC Action. Not only are the documents and testimony of significant importance to the ITC Action but the burden, if any, to MOSAID in providing the evidence is outweighed by the benefit to be derived therefrom.

55. The production and testimony requested of MOSAID would not be considered unduly burdensome or oppressive if the ITC Action were to be heard in Ontario, and, in fact, is largely similar to the requests made of MOSAID US in the ITC subpoenas.

56. The Letter of Request establishes a number of conditions that ensure that MOSAID's interests are protected. Specifically, the evidence and documentation will be subject to a strict Protective Order issued in the ITC Action, as set out at Addendum C to the Letter of Request,

documents will only be produced to the extent that they are not privileged under the applicable laws of Canada or the United States, and the Respondent is entitled to refuse to answer any question if such answer would subject it to a real and appreciable danger of criminal liability in the United States or to answer a question or produce a document if such answer or document would disclose a confidential communication with MOSAID's attorney(s) in connection with seeking legal advice. In addition, examination of the proposed witness will be limited to the narrowly defined topics set out in Addenda B to the Letter of Request and to a time period of seven hours (consistent with the requirements of Rule 31.05.1 of Ontario's own *Rules of Civil Procedure*).

Letter of Request, Application Record, Tab 3, at p. 6.

Rules of Civil Procedure, Rule 31.05.1, Tab C hereto.

57. It is well established that the technical rules of evidence of the requesting state should apply to a requested examination, unless the proceedings are dealing with fundamental values and the rights of witnesses. As such, it should not be considered either burdensome or contrary to public policy that the Letter of Request proposes that the examination be conducted by the attorneys from the law firm of Cravath, Swaine & Moore LLP, acting as legal representatives of Barnes & Noble, or their designees.

AstraZeneca, supra, at para. 64.

Connecticut, supra, at paras. 23-27.

58. In light of all of the above, the procedural and substantive protections offered, and the fact that the evidence sought is relevant, that it is necessary for trial and will be adduced at trial, if admissible, that it is not otherwise obtainable, that the Order sought is not contrary to public policy, and that the documents sought are identified with reasonable specificity, it is respectfully submitted that the order sought is not unduly burdensome, having in mind what MOSAID would be required to do, and produce, were the action to be tried in Ontario.

PART V - ORDER REQUESTED

59. Barnes & Noble therefore respectfully requests an order recognizing and enforcing the Letter of Request and in particular ordering that MOSAID produce to Barnes & Noble, all non-privileged documents in its possession, control or power that are responsive to the

requests for production set out in Addendum A to the Letter of Request; and appear through John Lindgren, CEO of MOSAID, to give evidence under oath with respect to the Deposition Topics set out in Addendum B to the Letter of Request, all within time frames that will permit the evidence to be obtained in advance of the trial of the ITC Action.

ALL OF WHICH IS RESPECTFULLY SUBMITTED

January 11, 2012



Nicholas McHaffie
Megan MacDonald
Of Counsel for the Applicants

SCHEDULE “A”
LIST OF AUTHORITIES

1. *Zingre v. R.*, [1981] 2 S.C.R. 392
2. *Bank of Credit & Commerce International S.A. (in Liquidation) v. Hague* (1996), 30 O.R. 3d. 477 (Gen. Div.)
3. *Germany (Federal Republic) v. Canadian Imperial Bank of Commerce* (1997), 31 O.R. (3d) 684 (Gen. Div.)
4. *Re Friction Division Products, Inc. and E. I. Du Pont de Nemours & Co. Inc. et al.* (No. 2) (1986), 56 O.R. (2d) 722 (H.C.J.)
5. *Treat America Ltd. v. Nestlé Canada Inc.*, 2011 ONCA 560, 9 C.P.C. (7th) 1
6. *Mulroney v. Coates* (1986), 54 O.R. (2d) 353 (H.C.J.)
7. *Connecticut Retirement Plans & Trust Funds v. Buchan* (2007), 225 O.A.C. 106 (Ont. C.A.)
8. *O.P.S.E.U. Pension Trust Fund (Trustee of) v. Clark* (2006), 270 D.L.R. (4th) 429 (Ont. C.A.)
9. *AstraZeneca LP v. Wolman*, [2009] O.J. No. 5344 (Ont. S.C.J.)
10. *Fidelity Bankers Life Insurance Co. v. Dowsley* (1996), 2 C.P.C. (4th) 45 (Gen. Div.)

SCHEDULE “B”

STATUTES AND REGULATIONS REFERRED TO

- A. *Evidence Act*, R.S.O. 1990, c. E. 23, s. 60
- B. *Canada Evidence Act*, R.S.C. 1985 c. C-5, s. 46
- C. *Rules of Civil Procedure*, Rules 3.02, 14.05, 30.10, 31.05.1, 31.10, 34 and 38,

A. *Evidence Act, R.S.O. 1990, c. E. 23, s. 60(1)*

Evidence for foreign tribunals

60. (1) Where it is made to appear to the Superior Court of Justice or a judge thereof, that a court or tribunal of competent jurisdiction in a foreign country has duly authorized, by commission, order or other process, for a purpose for which a letter of request could be issued under the rules of court, the obtaining of the testimony in or in relation to an action, suit or proceeding pending in or before such foreign court or tribunal, of a witness out of the jurisdiction thereof and within the jurisdiction of the court or judge so applied to, such court or judge may order the examination of such witness before the person appointed, and in the manner and form directed by the commission, order or other process, and may, by the same or by a subsequent order, command the attendance of a person named therein for the purpose of being examined, or the production of a writing or other document or thing mentioned in the order, and may give all such directions as to the time and place of the examination, and all other matters connected therewith as seem proper, and the order may be enforced, and any disobedience thereto punished, in like manner as in the case of an order made by the court or judge in an action pending in the court or before a judge of the court.

R.S.O. 1990, c. E.23, s. 60 (1); 2000, c. 26, Sched. A, s. 7 (2).

B. *Canada Evidence Act, R.S.C. 1985 c. C-5, s.46*

Procedure

Order for examination of witness in Canada

46. (1) If, on an application for that purpose, it is made to appear to any court or judge that any court or tribunal outside Canada, before which any civil, commercial or criminal matter is pending, is desirous of obtaining the testimony in relation to that matter of a party or witness within the jurisdiction of the first mentioned court, of the court to which the judge belongs or of the judge, the court or judge may, in its or their discretion, order the examination on oath on interrogatories, or otherwise, before any person or persons named in the order, of that party or witness accordingly, and by the same or any subsequent order may command the attendance of that party or witness for the purpose of being examined, and for the production of any writings or other documents mentioned in the order and of any other writings or documents relating to the matter in question that are in the possession or power of that party or witness.

Video links, etc.

(2) For greater certainty, testimony for the purposes of subsection (1) may be given by means of technology that permits the virtual presence of the party or witness before the court or tribunal outside Canada or that permits that court or tribunal, and the parties, to hear and examine the party or witness.

R.S., 1985, c. C-5, s. 46; 1999, c. 18, s. 89.

C. ***Rules of Civil Procedure, Rules 1.04, 3.02, 14.05, 30.10, 31.05.1, 31.10, 34 and 38***

INTERPRETATION

General Principle

1.04 (1) These rules shall be liberally construed to secure the just, most expeditious and least expensive determination of every civil proceeding on its merits. R.R.O. 1990, Reg. 194, r. 1.04 (1).

Proportionality

(1.1) In applying these rules, the court shall make orders and give directions that are proportionate to the importance and complexity of the issues, and to the amount involved, in the proceeding. O. Reg. 438/08, s. 2.

Matters Not Provided For

(2) Where matters are not provided for in these rules, the practice shall be determined by analogy to them. R.R.O. 1990, Reg. 194, r. 1.04 (2).

Party Acting in Person

(3) Where a party to a proceeding is not represented by a lawyer but acts in person in accordance with subrule 15.01 (2) or (3), anything these rules require or permit a lawyer to do shall be done by the party. R.R.O. 1990, Reg. 194, r. 1.04 (3); O. Reg. 575/07, s. 1.

“Party and Party” Costs

(4) If a statute, regulation or other document refers to party and party costs, these rules apply as if the reference were to partial indemnity costs. O. Reg. 284/01, s. 3.

“Solicitor and Client” Costs

(5) If a statute, regulation or other document refers to solicitor and client costs, these rules apply as if the reference were to substantial indemnity costs. O. Reg. 284/01, s. 3.

EXTENSION OR ABRIDGMENT

General Powers of Court

3.02 (1) Subject to subrule (3), the court may by order extend or abridge any time prescribed by these rules or an order, on such terms as are just. R.R.O. 1990, Reg. 194, r. 3.02 (1).

(2) A motion for an order extending time may be made before or after the expiration of the time prescribed. R.R.O. 1990, Reg. 194, r. 3.02 (2).

Times in Appeals

(3) An order under subrule (1) extending or abridging a time prescribed by these rules and relating to an appeal to an appellate court may be made only by a judge of the appellate court. R.R.O. 1990, Reg. 194, r. 3.02 (3).

Consent in Writing

(4) A time prescribed by these rules for serving, filing or delivering a document may be extended or abridged by filing a consent. O. Reg. 555/96, s. 1; O. Reg. 427/01, s. 2; O. Reg. 438/08, s. 5.

APPLICATIONS — BY NOTICE OF APPLICATION

Notice of Application

14.05 (1) The originating process for the commencement of an application is a notice of application (Form 14E, 68A or 73A) or an application for a certificate of appointment of an estate trustee (Form 74.4, 74.5, 74.14, 74.15, 74.21, 74.24, 74.27 or 74.30). R.R.O. 1990, Reg. 194, r. 14.05 (1); O. Reg. 484/94, s. 5.

Information for Court Use

(1.1) Form 14F (Information for court use) shall be filed together with a notice of application in Form 14E, 68A or 73A. O. Reg. 260/05, s. 2.

Application under Statute

(2) A proceeding may be commenced by an application to the Superior Court of Justice or to a judge of that court, if a statute so authorizes. R.R.O. 1990, Reg. 194, r. 14.05 (2); O. Reg. 292/99, s. 1 (2).

Application under Rules

(3) A proceeding may be brought by application where these rules authorize the commencement of a proceeding by application or where the relief claimed is,

- (a) the opinion, advice or direction of the court on a question affecting the rights of a person in respect of the administration of the estate of a deceased person or the execution of a trust;
- (b) an order directing executors, administrators or trustees to do or abstain from doing any particular act in respect of an estate or trust for which they are responsible;
- (c) the removal or replacement of one or more executors, administrators or trustees, or the fixing of their compensation;
- (d) the determination of rights that depend on the interpretation of a deed, will, contract or other instrument, or on the interpretation of a statute, order in council, regulation or municipal by-law or resolution;

- (e) the declaration of an interest in or charge on land, including the nature and extent of the interest or charge or the boundaries of the land, or the settling of the priority of interests or charges;
- (f) the approval of an arrangement or compromise or the approval of a purchase, sale, mortgage, lease or variation of trust;
- (g) an injunction, mandatory order or declaration or the appointment of a receiver or other consequential relief when ancillary to relief claimed in a proceeding properly commenced by a notice of application;
- (g.1) for a remedy under the *Canadian Charter of Rights and Freedoms*; or
- (h) in respect of any matter where it is unlikely that there will be any material facts in dispute. R.R.O. 1990, Reg. 194, r. 14.05 (3); O. Reg. 396/91, s. 3.

PRODUCTION FROM NON-PARTIES WITH LEAVE

Order for Inspection

30.10 (1) The court may, on motion by a party, order production for inspection of a document that is in the possession, control or power of a person not a party and is not privileged where the court is satisfied that,

- (a) the document is relevant to a material issue in the action; and
- (b) it would be unfair to require the moving party to proceed to trial without having discovery of the document. R.R.O. 1990, Reg. 194, r. 30.10 (1).

Notice of Motion

(2) A motion for an order under subrule (1) shall be made on notice,
(a) to every other party; and
(b) to the person not a party, served personally or by an alternative to personal service under rule 16.03. R.R.O. 1990, Reg. 194, r. 30.10 (2).

Court may Inspect Document

(3) Where privilege is claimed for a document referred to in subrule (1), or where the court is uncertain of the relevance of or necessity for discovery of the document, the court may inspect the document to determine the issue. R.R.O. 1990, Reg. 194, r. 30.10 (3).

Preparation of Certified Copy

(4) The court may give directions respecting the preparation of a certified copy of a document referred to in subrule (1) and the certified copy may be used for all purposes in place of the original. R.R.O. 1990, Reg. 194, r. 30.10 (4).

Cost of Producing Document

(5) The moving party is responsible for the reasonable cost incurred or to be incurred by the person not a party to produce a document referred to in subrule (1), unless the court orders otherwise. O. Reg. 260/05, s. 5.

TIME LIMIT

Not to Exceed Seven Hours

31.05.1 (1) No party shall, in conducting oral examinations for discovery, exceed a total of seven hours of examination, regardless of the number of parties or other persons to be examined, except with the consent of the parties or with leave of the court. O. Reg. 438/08, s. 29.

Considerations for Leave

(2) In determining whether leave should be granted under subrule (1), the court shall consider,

- (a) the amount of money in issue;
- (b) the complexity of the issues of fact or law;
- (c) the amount of time that ought reasonably to be required in the action for oral examinations;
- (d) the financial position of each party;
- (e) the conduct of any party, including a party's unresponsiveness in any examinations for discovery held previously in the action, such as failure to answer questions on grounds other than privilege or the questions being obviously irrelevant, failure to provide complete answers to questions, or providing answers that are evasive, irrelevant, unresponsive or unduly lengthy;
- (f) a party's denial or refusal to admit anything that should have been admitted; and
- (g) any other reason that should be considered in the interest of justice. O. Reg. 438/08, s. 29.

DISCOVERY OF NON-PARTIES WITH LEAVE

General

31.10 (1) The court may grant leave, on such terms respecting costs and other matters as are just, to examine for discovery any person who there is reason to believe has information relevant to a material issue in the action, other than an expert engaged by or on behalf of a party in preparation for contemplated or pending litigation. R.R.O. 1990, Reg. 194, r. 31.10 (1).

Test for Granting Leave

- (2) An order under subrule (1) shall not be made unless the court is satisfied that,
- (a) the moving party has been unable to obtain the information from other persons whom the moving party is entitled to examine for discovery, or from the person the party seeks to examine;
 - (b) it would be unfair to require the moving party to proceed to trial without having the opportunity of examining the person; and
 - (c) the examination will not,
 - (i) unduly delay the commencement of the trial of the action,
 - (ii) entail unreasonable expense for other parties, or
 - (iii) result in unfairness to the person the moving party seeks to examine. R.R.O. 1990, Reg. 194, r. 31.10 (2).

Costs Consequences for Examining Party

(3) A party who examines a person orally under this rule shall serve every party who attended or was represented on the examination with the transcript free of charge, unless the court orders otherwise. R.R.O. 1990, Reg. 194, r. 31.10 (3).

(4) The examining party is not entitled to recover the costs of the examination from another party unless the court expressly orders otherwise. R.R.O. 1990, Reg. 194, r. 31.10 (4).

Limitation on Use at Trial

(5) The evidence of a person examined under this rule may not be read into evidence at trial under subrule 31.11 (1). R.R.O. 1990, Reg. 194, r. 31.10 (5).

BARNES & NOBLE, INC.,¹
BARNESANDNOBLE.COM LLC
Applicants

MOSAID TECHNOLOGIES
INCORPORATED
Respondent

Court File No: 12-53320

ONTARIO
SUPERIOR COURT OF JUSTICE

Proceeding commenced at Ottawa

FACTUM

STIKEMAN ELLIOTT LLP

Barristers & Solicitors
Suite 1600, 50 O'Connor Street
Ottawa, ON K1P 6L2

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Solicitors for the Applicants

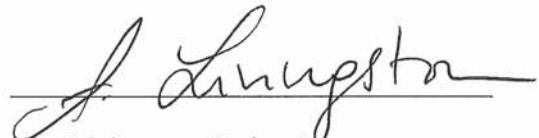
EXHIBIT 4



STATE OF NEW YORK)
)
)
) ss
COUNTY OF NEW YORK)

CERTIFICATION

This is to certify that the attached translation is, to the best of my knowledge and belief, a true and accurate translation from Finnish into English of the attached Request for Statement, dated January 5, 2012.



Ann Livingston, Project Manager
Geotext Translations, Inc.

Sworn to and subscribed before me

this 13th day of January, 20 12.



KRISTEN DUFFY

NOTARY PUBLIC-STATE OF NEW YORK

No. 01DU6121852

Qualified in Queens County

My Commission Expires January 31, 2013
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THE DISTRICT COURT OF ESPOO
2nd Department
Vitikka 1
02630 ESPOO
FINLAND

REQUEST FOR STATEMENT

January 5, 2012 H 11/16979

Nokia Corporation
Keilalahdentie 2-4
00045 NOKIA GROUP
FINLAND

| | |
|------------------------|--|
| Applicant | Ministry of Justice / Department of international affairs c/o Tuuli Kainulainen P.O. Box 25 00023 VALTIONEUVOSTO FINLAND |
| Party concerned | Nokia Corporation Keilalahdentie 2-4 00045 NOKIA GROUP FINLAND |
| Matter | International judicial assistance to a foreign court |
| Pending date | December 21, 2011 |

RESPONSE TO THE APPLICATION

Section 8 in the request for legal assistance includes a list of documents which are requested to be presented in order to settle the dispute in the legal proceedings pending in the United States.

The Company is obliged to submit the documents mentioned in the request for legal assistance to the District Court of Espoo, which will deliver them further to the Ministry of Justice.

SUBMISSION OF THE STATEMENT TO THE DISTRICT COURT

You are obliged to submit your statement to the secretariat of the District

Court within 7 days of the service of this request. At your own risk, you may also deliver it to the secretariat by postal service, telecopy, other electronic message or by courier.

If you request an extension of time before the deadline, the District Court may, for a special reason, extend the time for submitting the statement.

CONTENTS OF THE WRITTEN STATEMENT

You are asked to state in your statement whether you accept the application or object to it.

If you object to the application, you are requested to

- present such grounds for objection which may have significance in the settlement of the matter
- state, where possible, the evidence which you are going to present, and state what you are going to prove with each piece of evidence;
- present your demand in euro for reimbursement of your legal expenses so far, if you find it relevant;
- state your claim that the District Court cannot take the matter for consideration.

You shall also enclose with your statement the document upon which your objection is based and the written evidence which you invoke in your statement. The document shall be enclosed either as an original or as a copy. The statement shall also include the phone number during office hours and the address of the witness or other party to be heard.

You can prepare the statement yourself or assign it to a counsel. The preparer shall sign the statement and in addition state his/her profession, place of residence, address and telephone number where he/she can be reached during office hours. The submission shall also include the postal address to which invitations, requests and notifications can be sent. You may be served these documents via postal service to the address announced in the statement.

The District Court number of matter H11/16979 shall be given in the statement.

District Court Judge

Eeva Tikka

Tel. 029 56 45099 Fax 029 56 45157

Appendices

Request for legal assistance

ESPOON KÄRÄJÄOIKEUS
2. osasto
Vitikka 1
02630 ESPOO

LAUSUMAPYYNTÖ

5.1.2012

H 11/16979

Nokia Corporation
Keilalahdentie 2-4
00045 NOKIA CROUP

| | |
|-------------------------|---|
| Hakija | Oikeusministeriö/kansainvälinen yksikkö c/o Tuuli Kainulainen PL 25 00023 VALTIONEUVOSTO |
| Asiaan osallinen | Nokia Corporation Keilalahdentie 2-4 00045 NOKIA CROUP |
| Asia | Virka-apu ulkomaalais. tuomioistuimelle |
| Vireille | 21.12.2011 |

HAKEMUKSEEN VASTAAMINEN

Oikeusapupyyntön kohdassa 8 on luettelo asiakirjoista, joita pyynnössä pyydetään esittäviksi Yhdysvalloissa vireillä olevassa oikeudenkäynnissä riita-asian ratkaisemiseksi.

Yhtiön on toimitettava oikeusapupyyntössä mainitut asiakirjat Espoon käräjäoikeudelle, joka toimittaa ne edelleen oikeusministerölle.

LAUSUMAN TOIMITTAMINEN KÄRÄJÄOIKEUDELLE

Teidän on toimitettava lausumanne käräjäoikeuden kansliaan 7 päivän

kuluessa tämän pyynnön tiedoksiannosta. Voitte omalla vastuullanne toimittaa sen kansliaan myös postitse, telekopiona, muuna sähköisenä viestinä tai lähetin välityksellä.

Jos pyydätte ennen määrääjan päättymistä sen pidentämistä, käräjäoikeus voi erityisestä syystä pidentää määrääikaa lausuman antamiselle.

KIRJALLISEN LAUSUMAN SISÄLTÖ

Teitä kehotetaan lausumassanne ilmoittamaan hyväksyttekö hakemuksen vai vastustatko sitä.

Jos vastustatte hakemusta, Teitä kehotetaan

- esittämään sellaiset vastustamisen perusteet, joilla voi olla merkitystä asian ratkaisemisessa;
- ilmoittamaan mahdollisuksien mukaan ne todisteet, jotka aiotte esittää, ja ilmoittamaan mitä kullakin todisteella aiotte näyttää toteen;
- esittämään euromääräisen vaatimuksenne tähänastisten oikeudenkäyntikulujenne korvaamisesta, jos pidätte sitä aiheellisena;
- tekemään väitteenne siitä, ettei käräjäoikeus voi ottaa asiaa tutkittavaksi.

Teidän tulee myös liittää lausumaanne asiakirja, johon vastustaminen perustuu, ja ne kirjalliset todisteet, joihin lausumassanne vetoatte. Asiakirja on liitettävä lausumaan joko alkuperäisenä tai jäljennöksenä. Lausumassa on myös ilmoitettava todistajan ja muun kuultavan postiosoite ja puhelinnumero virka-aikana.

Voitte laatia lausuman itse tai antaa sen asiamiehen tehtäväksi. Laatijan on allekirjoitettava lausuma ja lisäksi ilmoitettava ammattinsa, kotipaikkansa, osoitteensa ja puhelinnumeronsa, josta hänet virka-aikana tavoittaa. Lausumassa on myös ilmoitettava se postiosoite, johon kutsut, kehotukset ja ilmoitukset voidaan lähettää. Nämä asiakirjat voidaan antaa Teille tiedoksi lähettämällä ne postitse lausumassa ilmoitettuun osoitteeseen.

Lausumassa on mainittava käräjäoikeuden asianumero H11/16979.

käräjätuomari

Eeva Tikka

Puh. 029 56 45099 Faksi 029 56 45157

Liitteet

Oikeusapupyyntö

EXHIBIT 5



STATE OF NEW YORK)
)
)
) ss
COUNTY OF NEW YORK)

CERTIFICATION

This is to certify that the attached translation is, to the best of my knowledge and belief, a true and accurate translation from Finnish into English of the attached Request to Stay the Proceedings Regarding the Request for Legal Assistance, dated January 11, 2012.

A handwritten signature in black ink, appearing to read "A. Livingston".

Ann Livingston, Project Manager
Geotext Translations, Inc.

Sworn to and subscribed before me

this 13th day of January, 20 12

A handwritten signature in black ink, appearing to read "Kristen Duff".

NOTARY PUBLIC-STATE OF NEW YORK

No. 01DU6121852

Qualified in Queens County

My Commission Expires January 31, 2013

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Hong Kong 20th Floor, Central Tower, 28 Queen's Road, Central, Hong Kong tel +852.2159.9143 fax +852.3010.0082

translations@geotext.com | www.geotext.com

[stamp:] Roschier Attorneys Ltd

To the District Court of Espoo

Matter: Request to stay the proceedings regarding the request for international judicial assistance to a foreign court based on the Hague Convention 1970 concerning the acceptance of evidence in civil and commercial law

District Court of Espoo Record no. H 11/16979

Party concerned: Nokia Corporation ("Nokia")
P.O. Box 226
00045 NOKIA GROUP
FINLAND

Counsel: Mr. Petri Taivalkoski, Attorney-at-Law
Mr. Aapo Saarikivi, LL.M.
Roschier, Attorneys Ltd.
Keskuskatu 7 A, 00100 Helsinki, FINLAND
Tel. 020 506 6237, telefax 020 506 6100
e-mail petri.taivalkoski@roschier.com
aapo.saarikivi@roschier.com

Party making the Request for International judicial assistance:

Barnes & Noble Inc. and barnesandnoble.com LLC
(together "Barnes & Noble")
New York, the United States of America

Counsel and addresses for Proceedings: Mr. Patrik Lindfors, Attorney-at-Law
Ms. Petra Kiurunen, Attorney-at-Law
Lindfors & Co Attorneys at Law Ltd
Kluuvikatu 3, 00101 Helsinki, FINLAND
Tel. 020 762 2511, telefax 020 762 2519
e-mail patrik.lindfors@lindforsco.com
petra.kiurunen@lindforsco.com

January 11, 2012

- 1. Request to stay the proceedings regarding the request for legal assistance**
 1. Nokia respectfully request that the District Court of Espoo stays the above specified request for legal assistance dated December 2, 2011 to all parts in accordance with 14:4 § of the Code of Judicial Procedure and continues with the hearing of the matter only after the International Trade Commission of the United States ("ITC") has given a decision regarding the motion to quash filed by Nokia.
 2. In addition, Nokia requests that the deadline for Nokia's statement regarding the documents included in the request for legal assistance be postponed so that it will be two (2) weeks counted from the abovementioned ITC decision.
- 2. Background to the matter**
 3. The request for legal assistance pertains to a civil procedure regarding a patent infringement, which is based on a claim filed by Microsoft Corporation ("Microsoft") from the United States, on April 8, 2011, in ITC. In the claim Microsoft holds that Barnes & Noble from the United States and certain other companies¹ import and sell a certain handheld computer device as well as related software and components, all of which infringes Microsoft's patents in the USA. Barnes & Noble has presented as its defense, among other things, that Microsoft misuses its patents and that the patents in question are irrelevant.
 4. Nokia is not a party in the process in question nor has the claim filed by Microsoft links to Nokia or to Finland, as Nokia understands the matter. Despite this, Barnes & Noble has presented an international request for legal assistance, which, in addition to a broad request to submit documents, includes a demand that persons from the upper management (president and chief executive officer Stephen Elop, development director Kai Öistämö, director for the unit of mobile phones Mary T. McDowell, head of mergers and acquisitions Jaakko Kaskinen and the head of business development Jukka Kaskinen) be heard as witnesses in the matter. Barnes & Noble has in no way been in contact with Nokia prior to the submitting of the request or delivered the request to Nokia for comments. The request for legal assistance has also been delivered to the Ministry of Justice *ex parte* without giving Nokia the opportunity to be heard. Nor has Barnes & Noble strived to present evidence that it would be likely that the information possessed by the

¹ Foxconn Electronics, Inc., Foxconn Presision Component (Shen Zen) Co. Ltd., Foxconn International Holdings Ltd. and Hon Hai Precision Industry Co., Ltd. and Inventec Corporation.

witnesses, which has been named to be heard, or the requested documents could be pertinent to the claims regarding Microsoft's patents.²

5. In addition, Barnes & Noble has without cause delayed the filing of its request for legal assistance. It became aware of the alleged need for the evidence at the latest on May 10, 2011, when it presented its claim regarding the misuse of patents in the ITC proceeding. However, the request for legal assistance is dated only six months later, i.e. December 2, 2011, very close to the deadline for submitting evidence given by the ITC December 14, 2011 and extremely close to the main hearing, which was ordered to commence on February 6, 2012. Barnes & Noble has not presented any reason why it did not present the request earlier. Nor has Barnes & Noble requested any extension of time or in some other way striven to minimize the harm caused to Nokia by the delay of the request.
6. Taking into account the circumstances, it is clear that the request for legal aid submitted by Barnes & Noble is by its nature a classic "fishing expedition" directed at Nokia's licensing- and business strategy and confidential business information, which is essential for its operations. Its fulfillment is intended to cause Nokia and its managers sustainable damage, harm and costs. Nokia's legal protection requires that the matter is left in abeyance until the ITC has had a possibility to commit itself to Nokia's claims regarding the groundlessness of the request for legal aid.

3. **Hearing of the matter in ITC**

7. On January 3, 2012, Nokia filed a request to quash to ITC (**Appendix 1**), in accordance with its procedural rules, in which it proposes that the request for legal assistance is unfounded, inappropriate and abusive to Nokia's rights on several parallel grounds. As it has been previously noted, the request for legal assistance was filed and been relayed to Finland without giving Nokia the opportunity to present its view on the grounds of the request. The motion to quash is then Nokia's first opportunity to comment on the request.
8. The hearing of Nokia's motion to quash is still pending. Barnes & Noble has had the opportunity to answer to Nokia's motion to quash at any point from the filing of the motion, and it has to answer to it by **this week's Friday January 13, 2012**.³ In the light of the forthcoming main hearing in the ITC it is presumable that the ITC will give its decision in the matter a short time after Barnes

² See. Nokia's Motion to Quash.

³ According to Section 3.6 of the ITC Ground Rules, attached to this request, the deadline for filing a response to motion is 2 calendar days.

& Noble's answer has been submitted to the ITC. Nokia has strong grounds to believe that its motion to quash will be accepted and that the request for legal assistance by Barnes and Noble will be rejected in turn. This implies that there is no longer any legal grounds for this case to be heard in Finland.

9. The procedural rules for the proceedings in the ITC (**Appendix 2, Ground Rules for Section 337 Investigation**, "Ground Rules") Section 4.6.4 opines on the effect of the motion to quash the subpoena⁴ as follows:

"4.6.4 Motion to Quash: Filing of any motion to quash an issued subpoena automatically stays such subpoena pending disposition of the motion to quash by the Administrative Law Judge."

10. According to the above cited section 4.6.4 filing a motion to quash to the ITC automatically stays the pending disposition of the subpoena. If the matter should concern enforcement of a subpoena in the United States, it would have, on account of the above cited rule, been stayed without question. It is difficult to see grounds why the execution of the ITC subpoena would, despite this, be continued abroad in accordance with the Hague Convention for as long as the ITC has not had the opportunity to give a ruling regarding the quashing of the order.

4. **Grounds for staying the proceedings**

4.1. **General**

11. The request for legal assistance submitted by Barnes & Noble is unfounded, irrelevant and it breaches the rights of Nokia and its management personnel that have been named to witness. The request is unspecified and it is intended to try to get information covered by Nokia's protection of business secrets. For these and other reasons presented in the motion to quash filed by Nokia there are strong grounds for staying the decision in the matter, until ITC has had the opportunity to give its decision to Nokia's motion to quash.
12. The subpoena was issued solely on the application of Barnes & Noble *ex parte* without giving Nokia the opportunity to be heard. If the order is enforced without giving the ITC the opportunity to give its decision on the validated objections, this would lead to a serious breach of Nokia's legal security and would, in addition, breach the right to be heard, which is a fundamental part of our legal system (Section 21.1 § of the Finnish Constitution).

⁴ "Todistelumääräys" is our free translation of the meaning of the English "subpoena." It refers to an authority's ruling requiring a person, on pain of a fine, to give oral or written testimony or other testimonial materials (see, for example, <http://en.wikipedia.org/wiki/Subpoena>).

13. The Hague Convention does not expressly take a stand on the conditions such as here at hand. However, it would be contrary to the objectives of the Hague Convention and the premises of the international legal system that Nokia and its senior managers have to present evidence through legal assistance in Finland for which there are no grounds pursuant to the procedural rules and practice valid in the United States. If the request is implemented before ITC has been given the opportunity to take a stand on its permissibility, Barnes & Noble achieves the result which they are also pursuing in the event that the request for legal assistance is later ruled unfounded.
14. In the ITC proceedings, the legal protection of a third party (here Nokia) ordered to be heard as a witness was arranged in section 4.6.4 of the aforementioned Ground Rules where it is prescribed on the effects of the revocation request on the implementation of the subpoena. As noted above, according to the section, the submission of the revocation request automatically discontinues the handling of the subpoena.
15. Should the request be implemented, this would result in that Barnes & Noble would by exploiting international instruments achieve a better result than what it would have obtained in purely national proceedings. This is without doubt contrary to the purpose of the Hague Convention.
16. The acceptance of the request would also in practice lead to Barnes & Noble's being offered the opportunity of evading the regulations and limitations concerning the presentation of evidence in the United States. In practice, it is very difficult for the Finnish courts of law to assess Nokia's objections based on the laws and regulations of the United States to the presentation of evidence referred to in the request for legal assistance. Unless the handling of Barnes & Noble's request for legal assistance is postponed, the consequence will be that it will not be possible to appropriately control the grounds and relevance of the request prior to its implementation.
17. The significance of the aforementioned aspects is also increased by the fact that Barnes & Noble has in fact already once before presented a corresponding request for the presentation of evidence to Nokia's subsidiary in the United States, Nokia, Inc. (**Appendix 3, request for evidence addressed to Nokia, Inc.**). However, Nokia, Inc. was not in reality the correct addressee of the request, but Barnes & Noble evidently tried to circumvent the need to present an international legal assistance request to the parent company Nokia Oyj. After Nokia, Inc. presented a revocation request (Motion to Quash) (**Appendix 4, Nokia, Inc.'s Motion to Quash**), Barnes & Noble's request for the presentation of evidence was automatically left in abeyance pursuant to section 4.6.4 of the Ground Rules. There is no reason why Barnes & Noble should, through

proceedings pursuant to the Hague Convention, be able to present evidence which it cannot obtain in national proceedings before ITC's decision on the matter has been received.

18. In the matter at hand, Nokia has proved that Barnes & Noble's request for legal assistance is unfounded. The unfounded nature of the request will be settled by ITC's decision and prior to the decision, there is no reason to implement the request.

4.2 **The actual purpose of the request is to circumvent the regulations of the legislation of the United States, which restricts the right to request the highest management of a company to present evidence.**

19. In Barnes & Noble's request for legal assistance, it asks to bring as witnesses persons who, according to the rules of the ITC proceedings and to the legal practice of the United States cannot be requested to be heard as witnesses unless certain specific conditions are met.

20. In the legal practice of the United States it has been consistently opined that the senior management of a company that is a third party in legal proceedings, such as Nokia, can only be requested to present evidence if two conditions are met. First of all, such a person must have unique and personal information that is relevant to the matter to be settled. Secondly, a person can only be heard if attempts have been made to obtain the information through other, less burdensome means.⁵

21. In the matter at hand, neither of the preconditions is met. As is evident from Nokia's Motion to Quash attached⁶, the specified themes in the request for legal assistance are partially overlapping regarding those themes where the management of Microsoft, party to the matter, has already been heard. Barnes & Noble has also not been in contact with Nokia or otherwise tried to obtain the information by less radical means.

4.3 **Urgency of the implementation is due to Barnes & Noble's own actions**

22. In case Barnes & Noble were to strive to argue to the District Court that the application for abeyance should not be accepted due to the urgent nature of the matter, it should be noted that any urgency and the closeness of the main hearing of ITC commencing on February 6, 2012 are solely a result of Barnes & Noble's own actions. As already noted above, Barnes & Noble has been aware of its alleged need for evidence since May 2011 at the latest. Despite this, the request for legal assistance addressed to Nokia was dated as late as December 2, 2011. Barnes & Noble has

⁵ Nokia's Motion to Quash, p. 15.

⁶ Nokia's Motion to Quash, pp. 18-19.

not presented any reason for its procrastination, the principal motives of which are probably of procedural tactical nature. For this reason as well, Barnes & Noble's legal protection expectations are not justified and the self-caused urgency of the matter cannot constitute an obstacle to Nokia's legal protection not being appropriately taken into account.

4.4 ITC has had the opportunity to postpone the main hearing

23. Should ITC consider the evidentiary material requested from Nokia as relevant, it always has the opportunity to postpone the commencement date of the main hearing. However, this has so far not been done. This is a weighty additional reason why ITC's decision should be awaited in the matter.

5. Conclusion

24. We also note, for the sake of order, that Nokia will, among other things, separately present its objection grounds based on the Hague Convention regarding Barnes & Noble's request for documents within the time frame set by the District Court, the stay of which was requested at the beginning of this brief.

Nokia Oyj

In Helsinki on January 11, 2012

Prepared by

[signature]

[signature]

Petri Taivalkoski

Aapo Saarikivi

Attorney at Law, Helsinki

LL.M., Helsinki



Roschier Asianajotoimisto Oy

Espoon käräjäoikeudelle

Asia:

Pyyntö Haagin vuoden 1970 yleissopimukseen todisteiden vastaanottamisesta ulkomailla siviili- ja kauppaoikeudellisissa asioissa perustuvan oikeusapupyyynnön lepäämään jättämisestä

Espoon käräjäoikeuden dnr H 11/16979

Asiaan osallinen:

Nokia Oyj ("Nokia")
PL 226
00045 Nokia Group
Suomi

**Asiaan osallisen
asiamiehet ja
prosessiosoite:**

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aapo.saarikivi@roschier.com

**Oikeusapupyyynnon
tekijä:**

Barnes & Noble Inc. ja barnesandnoble.com LLC
(yhdessä "Barnes & Noble")
New York, Yhdysvallat

**Oikeusapupyyynnon
tekijän aslamiehet ja
prosessiosoite:**

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Asianajaja Petra Kiurunen
Asianajotoimisto Lindfors & Co Oy
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Sähköposti patrik.lindfors@linforsco.com
petra.kiurunen@lindforsco.com

11. tammikuuta 2012

1. Pyyntö oikeusapupyynnön lepäämään jättämisestä

1. Nokia pyytää kunnioittavasti, että Espoon käräjäoikeus jättää yllä yksilöidyn 2.12.2011 päivätyn oikeusapupyynnön käsittelyn kaikilta osin OK 14:4 §:n nojalla lepäämään ja jatkaa asian käsittelyä vasta sen jälkeen, kun Yhdysvaltain kansainvälisen kaupan komissio (International Trade Commission, "ITC") on antanut ratkaisun Nokian sille osoittaman kumoamispyyynnön (*Motion to Quash*) johdosta.
2. Lisäksi Nokia pyytää, että oikeusapupyynnön sisältämiä dokumenttipyyntöjä koskevan Nokian kirjallisen lausuman määräaikaa lykätään siten, että se on kaksi (2) viikkoa luvien ITC:n edellä mainitusta ratkaisusta.

2. Asian taustaa

3. Oikeusapupyntö liittyy patentiloukkausta koskevaan siviiliprosessiin, joka perustuu yhdysvaltalaisen Microsoft Corporationin ("Microsoft") 8.4.2011 ITC:ssä nostamaan kanteeseen. Kanteessa Microsoft katsoo yhdysvaltalaisen Barnes & Noblen sekä eräiden muiden yritysten¹ tuovan maahan ja myyvän tiettyjä kädessä pidettäviä sähköisiä tietokonelaitteita sekä niihin liittyviä ohjelmistoja ja komponentteja, jotka loukkaavat Microsoftin yhdysvaltalaisia patentteja. Puolustuksenaan Barnes & Noble on esittänyt muun muassa, että Microsoft väärinkäyttää patenttejaan ja että kyseiset patentit ovat mitättömiä.
4. Nokia ei ole asianosaisena kyseisessä prosessissa, eikä Microsoftin kanteella ole Nokian käsityksen mukaan muutoinkaan liittymäkohtia Nokiaan tai Suomeen. Tästä huolimatta Barnes & Noble on esittänyt kansainvälisen oikeusapupyynnön, jossa laajojen asiakirjakategorioiden toimituspyyntöjen lisäksi Nokian ylimpään johtoon kuuluvia henkilöitä (pääjohtaja Stephen Elop, kehitysjohtaja Kai Öistämö, matkapuhelinyleksiköstä vastaava johtaja Mary T. McDowell, yrityskaupoista vastaava johtaja Jaakko Kaskinen, sekä liiketoiminnan kehitysjohtaja Jukka Kaskinen) vaaditaan kuultavaksi todistajina asiassa. Barnes & Noble ei ole ollut millään tavalla yhteydessä Nokiaan ennen pyyntöön esittämistä tai toimittanut pyyntöä Nokialle kommentteja varten. Oikeusapupyntö on myös lähetetty Suomen oikeusministeriölle *ex parte* antamatta Nokialle tilaisuutta tulla kuulluki. Barnes & Noble ei ole myöskään pyrkinyt saattamaan todennäköiseksi,

¹ Foxconn Electronics, Inc., Foxconn Presision Component (Shen Zen) Co. Ltd., Foxconn International Holdings Ltd. ja Hon Hai Precision Industry Co., Ltd. sekä Inventec Corporation.

että kuultavaksi nimettyjen todistajien tiedoilla tai pyydetyillä asiakirjoilla voisi olla merkitystä Microsoftin patentteja koskevien väitteiden kannalta.²

5. Barnes & Noble on lisäksi aiheettomasti viivyttänyt oikeusapupyynnön esittämistä. Se on tullut tietoiseksi väitetystä todisteiden tarpeesta viimeistään 10.5.2011, jolloin se esitti patenttien väärinkäytöä koskevan väitteensä ITC-menettelyssä. Oikeusapupyntö on kuitenkin päivätty vasta yli kuusi kuukautta myöhemmin eli 2.12.2011, hyvin lähellä ITC:n todistelulle antamaa takarajaa 14.12.2011 ja tavattoman lähellä 6.2.2012 alkavaksi määrätyä ITC:n pääkäsittelyä. Barnes & Noble ei ole esittänyt mitään syytä sille, ettei se ole esittänyt pyyntöä aikaisemmin. Barnes & Noble ei myöskään ole pyytänyt määräajanpidennystä tai muutoin pyrkinyt vähentämään pyynnön viivästymisestä Nokialle aiheutunutta haittaa.
6. Olosuhteet huomioon ottaen on selvää, että Barnes & Noblen oikeusapupyntö on luonteeltaan klassinen "kalasteluryritys" (*fishing expedition*) Nokian lisensointi- ja liiketoimintastrategiaan ja sen toiminnan kannalta keskeiseen luottamukselliseen yritystietoon. Sen toteuttaminen on omiaan aiheuttamaan Nokialle ja sen johtajille merkittävä vahinkoa, vaivaa ja kustannuksia. Nokian oikeusturva edellyttää, että asia jätetään lepäämään kunnes ITC:llä on ollut mahdollisuus ottaa kantaa Nokian väitteisiin oikeusapupyynnön perusteettomuudesta.

3. Käsittely ITC:ssä

7. Nokia on **3.1.2012** toimittanut ITC:lle sen prosessisääntöjen mukaisen kumoamispwynnon (Liite 1), jossa se osoittaa oikeusapupyynnön olevan perusteeton, epäasiallinen ja Nokian oikeutta loukkaava lukuisilla rinnakkaisilla perusteilla. Kuten edellä on todettu, oikeusapupyntöä on haettu ja se on välitetty Suomeen antamatta Nokialle tilaisuutta ottaa kantaa pyynnön perusteisiin. Kumoamispwyntö on siis Nokian ensimmäinen tilaisuus kommentoida pyyntöä.
8. Nokian kumoamispwynnon käsittely on vielä kesken. Barnes & Noblella on ollut mahdollisuus vastata Nokian kumoamispwyntöön koska tahansa sen jättämisestä lukuun, ja sen on vastattava siihen **viimeistään tämän viikon perjantaina 13.1.2012**.³ Lähestyvä ITC:n pääkäsittelyn valossa on oletettavaa, että ITC antaa ratkaisunsa lyhyen ajan kuluessa siitä kun Barnes & Noblen vastaus on toimitettu ITC:lle. Nokialla on vahvoja perusteita uskoa, että sen kumoamispwyntö tullaan hyväksymään ja Barnes & Noblen

² Ks. Nokia's Motion to Quash.

³ Tämän pyynnön liitteenä 2 olevissa jäljempänä yksilötävien ITC:n prosessisääntöjen (Ground Rules) kohdan 3.6 mukaan vastausaika kaikkiin hakemuksiin (motion) on kymmenen kalenteripäivää.

oikeusapupyyntö pyyntö vastaavasti hylkäämään. Tämä johtaa siihen, ettei asian käsitelyllä Suomessa enää ole oikeusperustetta.

9. ITC:n menettelyä koskevien prosessisääntöjen (**Liite 2, Ground Rules for Section 337 Investigation**, "Ground Rules") kohdassa 4.6.4 määritään kumoamispyyynnön vaikutuksista todistelumääräyksen⁴ käsitellyyn seuraavasti:

"4.6.4 Motion To Quash: Filing of any motion to quash an issued subpoena automatically stays such subpoena pending disposition of the motion to quash by the Administrative Law Judge".

10. Yllä siteeratun kohdan 4.6.4 mukaan kumoamispyyynnön jättäminen ITC:lle keskeyttää automaattisesti todistelumääräyksen käsitelyn. Mikäli kysymys olisi ITC:n todistelumääräyksen täytäntöönpanosta Yhdysvalloissa, se olisi yllä siteeratun säännön perusteella kiistatta keskeytynyt. On vaikea nähdä perusteita sille, että ITC:n todistelumääräyksen täytäntöönpanoa tästä huolimatta kuitenkin jatkettaisiin ulkomailta Haagin yleissopimuksen perusteella niin kauan kuin ITC:llä ei ole ollut tilaisuutta antaa ratkaisuaan määräyksen kumoamisesta.

4. Perusteet lepäämään jättämiselle

4.1 Yleistä

11. Barnes & Noblen oikeusapupyyntö on perusteeton, epäasiallinen ja se loukkaa Nokian sekä todistajiksi nimettyjen Nokian johtohenkilöiden oikeutta. Pyyntö on yksilöimätön, ja sillä pyritään selkeästi saamaan Nokialta liikesalaisuuksien suojan piiriin kuuluvia tietoja. Näistä ja muista Nokian kumoamispyyynnössä esitetyistä syistä on painavat perusteet lykätä asian ratkaisua, kunnes ITC:llä on ollut tilaisus antaa ratkaisunsa Nokian kumoamispyyntöön.
12. Todistelumääräys on annettu yksinomaan Barnes & Noblen hakemuksen perusteella *ex parte* ilman että Nokialla on ollut tilaisuutta tulla kuulluksi. Jos määräys pannaan täytäntöön ennen kuin ITC:llä on ollut mahdollisuus antaa ratkaisunsa Nokian perustelujen vastalauseiden johdosta, johtaisi tämä vakavaan Nokian oikeusturvan loukkauseen ja loukkaisi lisäksi oikeusjärjestyksemme perusteisiin kuuluvaan kuulemisperiaatteita (perustuslain 21.2 §).

⁴ Todistelumääräys on vapaamuotoinen käännyöksemme englanninkielisestä käsitteestä *subpoena*. Se tarkoittaa viranomaisen määräystä, jolla henkilöä edellytetään sakon uhalla toimittamaan suullista todistelua tai kirjallista tai muuta todistusaineistoa (ks. esim. <http://en.wikipedia.org/wiki/Subpoena>).

13. Haagin yleissopimus ei ota nimenomaisesti kantaa käsillä olevan tilanteen kaltaisiin olosuhteisiin. Olisi kuitenkin Haagin yleissopimuksen tarkitusperien ja kansainvälisen oikeusjärjestelmän lähtökohtien vastaista, että Nokia ja sen johtohenkilöt joutuvat Suomessa esittämään oikeusaputeitse todistelua, johon ei ole Yhdysvalloissa voimassa olevien prosessisääntöjen ja -käytännön mukaan perusteita. Jos pyyntö pannaan täytäntöön ennen kuin ITC saa tilaisuuden ottaa sen sallittavuuteen kantaa, Barnes & Noble pääsee tavoittelemansa lopputulokseen siinäkin tapauksessa, että oikeusapupyntö todetaan myöhemmin perusteettomaksi.
14. ITC-prosessissa todistelua esittämään määrätyn kolmannen tahon (tässä Nokia) oikeusturva on järjestetty edellä mainittujen *Ground Rules*:ien kohdassa 4.6.4, jossa säädetään kumoamispyyynnön vaikutuksista todistelumääräykseen täytäntöönpanoon. Kuten edellä on todettu, kohdan mukaan kumoamispyyynnön jättäminen keskeyttää automaattisesti kyseisen todistelumääräykseen käsitelyn.
15. Mikäli pyyntö pannaan täytäntöön, johtaisi tämä siihen että Barnes & Noble pääsisi kansainväliä instrumentteja hyödyntämällä parempaan lopputulokseen, kuin mihin se olisi päässyt puhtaasti kansallisessa prosessissa. Tämä on kiistatta vastoin Haagin yleissopimuksen tarkoitusta.
16. Pyynnön hyväksyminen johtaisi käytännössä myös siihen, että Barnes & Noblelle tarjottaisiin mahdollisuus kiertää Yhdysvaltojen todistelua koskevia säännöksiä ja rajoituksia. Suomen tuomioistuinten on käytännössä hyvin vaikeaa arvioida Nokian Yhdysvaltojen lakeihin ja säännöksiin perustuvia vastalauseita oikeusapupyynnön tarkoittaman todistelun esittämiselle. Jollei Barnes & Noblen oikeusapupyynnön käsittelyä jätetä lepäämään, tämä johtaa siihen, ettei pyynnön perusteita ja asiallisuutta ole mahdollisutta asianmukaisesti kontrolloida ennen sen täytäntöönpanoa.
17. Edellä esitettyjen näkökohtien painavuutta lisää vielä se, että Barnes & Noble on tosi-asiassa jo kerran esittänyt vastaavan pyynnön todisteiden esittämisestä Nokian yhdysvaltalaiselle tytäryhtiölle Nokia, Inc.:lle (**Liite 3, Nokia, Inc.:ille kohdistettu todistelupyntö**). Nokia, Inc. ei kuitenkaan todellisuudessa ollut pyynnön oikea kohde, vaan pyynnöllään Barnes & Noble pyrki mitä ilmeisimminkin kiertämään tarvetta esittää kansainvälistä oikeusapupyntöä emoyhtiö Nokia Oyj:lle. Nokia Inc:in esitettyä kumoamispyyynnön (*Motion to Quash*) (**Liite 4, Nokia, Inc.:in kumoamispyyntö**) Barnes & Noblen todistelupyntö jäi automaattisesti lepäämään *Ground Rules*:ien kohdan 4.6.4 nojalla. Ei ole mitään syytä, miksi Barnes & Noblen tulisi Haagin yleissopimuksen mukaisen prosessin kautta saada esitetyksi todistelua, jota se ei voi saada kansallisessa prosessissa, ennen kuin asiaan on saatu ITC:n ratkaisu.

18. Käsillä olevassa tapauksessa Nokia on osoittanut Barnes & Noblen oikeusapupyyynön perusteettomaksi. Pyynnön perusteettomuus ratkeaa ITC:n ratkaisulla, ja ennen ratkaisun antamista pyyntöä ei ole perusteltua panna täytäntöön.

4.2 Pyynnön tosiasiallisena tarkoituksesta on kiertää Yhdysvaltojen lainsäädännön säännöksiä, jotka rajoittavat oikeutta vaatia yrityksen ylin-tä johtoa todistamaan

19. Barnes & Noblen oikeusapupyyynössä vaaditaan kutsumaan todistajiksi henkilötä, joita ei ITC-menettelyssä noudatettavien sääntöjen ja yhdysvaltalaisen oikeuskäytän-nön mukaan saa vaatia kuultavaksi kuin erityisten edellytysten tätyyessä.
20. Yhdysvaltojen oikeuskäytännössä on johdonmukaisesti katsottu, että oikeudenkäyntiin nähdyn kolmantena tahona olevan yhtiön, kuten Nokian, ylintä johtoa voidaan vaatia todistamaan vain jos kaksi edellytystä täytyy. Ensinnäkin kyseisellä henkilöllä on oltava ainutlaatuista ja henkilökohtaista ratkaistavana olevan asian kannalta relevanttia tietoa. Toiseksi todistajana kuuleminen tulee kyseeseen vain silloin, kun tietoja on en-sin yritetty saada muilla, vähemmän raskailla keinolla.⁵
21. Käsillä olevassa tapauksessa kumpikaan edellytys ei täyty. Kuten liitteenä olevasta Nokian kumoamispyyntöstä käy ilmi⁶, oikeusapupyyynössä yksilöidyt teemat ovat osittain päällekkäisiä niiden teemojen osalta, joista on jo kuultu asianosaisena olevan Microsoftin johtoa. Barnes & Noble ei myöskään ole ollut yhteydessä Nokiaan tai muuten-kaan pyrkinyt saamaan tietoja vähemmän radikaaleilla keinilla.

4.3 Täytäntöönpanon kiireellisyys on Barnes & Noblen oman toiminnan seurausta

22. Sikäli kun Barnes & Noble pyrkii esittämään käräjäoikeudelle, että lepäämään jättämistä koskevaa hakemusta ei tulisi hyväksyä asian kiireellisyyden vuoksi, on syytä todeta, että mahdollinen kiire ja ITC:n 6.2.2012 alkavan pääkäsittelyn läheisyys on yksin-omaan Barnes & Noblen oman toiminnan seurausta. Kuten edellä jo todettiin, Barnes & Noble on ollut tietoinen väitetystä todisteluntarpeestaan viimeistään toukokuusta 2011 lähtien. Tästä huolimatta oikeusapupyyntö Nokialle on päivätty vasta 2.12.2011. Barnes & Noble ei ole esittänyt mitään syytä viivyttylyleen, jonka pääasialliset motiivit lienevät prosessitaktista. Tästäkin syystä Barnes & Noblen oikeussuojaodotukset eivät

⁵ Nokian kumoamispyyntö, s. 15.

⁶ Nokian kumoamispyyntö, s. 18-19.

ole perusteltuja, eikä asian itse aiheutettu kiireellisyys voi olla esteenä Nokian oikeus-suojan asianmukaiselle huomioonottamiselle.

4.4 ITC:llä on ollut mahdollisuus lykätä pääkäsittelyä

23. Mikäli ITC pitäisi Nokialta vaadittavaa todistusaineistoa relevanttina, on sillä aina mah-dollisuus lykätä pääkäsittelyn alkamispäivämäärää. Tätä ei kuitenkaan ole ainakaan toistaiseksi tehty. Tämä on painava lisäperuste sille, että asiassa tulee odottaa ITC:n ratkaisua.

5. Lopuksi

24. Toteamme vielä järjestyksen vuoksi, että Nokia esittää muun muassa Haagin yleisso-pimukseen perustuvat, Barnes & Noblen asiakirjapyytöjä koskevat vastustamisperus-teensa erikseen käräjäoikeuden osoittamassa määräajassa, johon on tämän kirjelmän alussa pyydetty pidennystä.

Nokia Oyj

Helsingissä, 11. tammikuuta 2012

Laativat:


Petri Taivalkoski
Asianajaja, Helsinki


Aapo Saarikivi
OTK, Helsinki

EXHIBIT 6

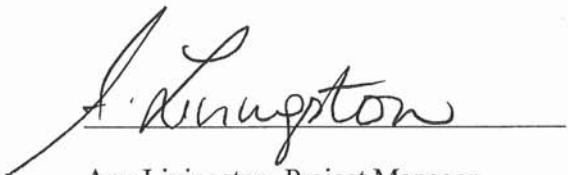


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CERTIFICATION

This is to certify that the attached translation is, to the best of my knowledge and belief, a true and accurate translation from Finnish into English of the attached Decision of the District Court of Espoo, dated January 18, 2012.



Ann Livingston, Project Manager
Geotext Translations, Inc.

Sworn to and subscribed before me

this 19th day of January 2012.



KRISTEN DUFF
NOTARY PUBLIC-STATE OF NEW YORK
No. 01DU6121852

Qualified in Queens County

My Commission Expires January 31, 2013

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THE DISTRICT COURT OF ESPOO DECISION
2nd Department
Vitikka 1
02630 ESPOO

12/1008

January 18, 2012

H 11/16979

| | |
|------------------------|---|
| Applicant | Ministry of Justice / Department of International Affairs c/o Tuuli Kainulainen P.O. Box 25 00023 VALTIONEUVOSTO |
| | Barnes & Noble Inc. barnesandnoble.com LLC c/o Attorney at Law Patrik Lindfors, Attorneys at Law Lindfors & Co Ltd |
| Party concerned | Nokia Corporation c/o Attorney at Law Petri Taivalkoski, Roschier Attorneys at Law Ltd |
| Matter | Judicial assistance to a foreign court |
| Pending | December 21, 2011 |

ACCOUNT OF THE MATTER

With a letter dated December 29, 2011, the Ministry of Justice has delivered a request to the District Court of Espoo from the authority of the United States, which has requested judicial assistance to be given to a foreign court. It has been requested that the District Court take evidence, specified in the request, for a judicial proceeding being conducted in the United States.

Request to Stay the Proceeding

Nokia Corporation has requested that the District Court fully stay the request, and continue the proceeding only after the International Trade Commission (ITC) of the United States has given its decision concerning the motion to quash filed by Nokia. Furthermore, Nokia Corporation has requested that the deadline for Nokia's written response concerning the production of documents identified in the request be postponed, so that the documents would be produced within two weeks after the above mentioned decision of the ITC.

Grounds

The request pertains to a civil proceeding regarding a patent infringement claim filed by U.S. company Microsoft Corporation on April 8, 2011. Nokia is not a party in the aforementioned proceeding and the claim does not, according to Nokia's view, have any connection to Nokia or to Finland.

On January 3, 2012, Nokia has filed with the ITC a motion to quash in accordance with the procedural rules of the ITC, in which Nokia has contended that the request is unfounded, inappropriate and abusive of Nokia's rights. The request has been filed and forwarded to Finland without giving Nokia the opportunity to present its views regarding the merits of the request. The proceedings on Nokia's motion to quash are still pending. It is presumed that the ITC will give its decision in the matter within a short period of time and that there are grounds to believe that the motion to quash will be accepted. According to the procedural rules of the ITC, a motion to quash automatically stays the proceedings as regards a pending subpoena if the question concerns an enforcement of a subpoena in the United States. Although the Hague Convention does not expressly take a stand on such circumstances, it would be contrary to the objectives of the Hague Convention and the international system of law that Nokia and its senior managers would be obliged to produce evidence sought on judicial assistance in Finland, when there would be no obligation for such document production pursuant to the procedural rules of the United States.

The urgency of the execution is due to reasons attributable to Barnes & Noble. Barnes & Noble has been aware of the alleged need for evidence as of May 2011, at the latest. In spite of this, the request was not delivered until December 2, 2011.

The Response by Barnes & Noble Inc.

Claims

Barnes & Noble has objected to Nokia's request to stay the proceedings with respect to the handling of the request dated December 2, 2011 and has demanded that the District Court dismiss Nokia's request for a stay.

Grounds

Nokia's purpose is to delay processing the request so that it would not be possible to take evidence prior to the commencement of the main hearing of the ITC on February 6, 2012. It is expected that the ITC will give a decision within a short period of time, but it is possible that the hearing of the matter may be delayed by several weeks. The motion to quash will presumably be dismissed, and therefore staying the proceedings, which would also mean suspending any steps toward taking the evidence referred to in the request, would necessarily cause a loss of rights. Instead, even if the evidence were received in time for the ITC's decision, it would not cause a loss of rights to the parties involved, because it would then be up to the ITC to decide whether the evidence received could be taken into account in the ITC's proceedings.

Staying the proceeding is clearly contrary to the purpose of the Hague Convention. It is the duty of the officials to reject requests that do not fall within the scope of

application of the Convention and do not comply with the formal requirements of the Convention. According to the Hague Convention, action requested must be taken without delay. Also for this reason, the approval of the request for a stay is clearly contrary to the purpose of the Convention.

Statement by the Ministry of Justice

The District Court has given the Ministry of Justice, as the applicant, the opportunity to make a statement regarding the request for stay. The Ministry of Justice has not made a statement in the matter.

DECISION BY THE DISTRICT COURT

The handling of the request is stayed until the International Trade Commission of the United States has given its decision concerning Nokia's motion to quash.

The District Court extends the deadline and requests Nokia to submit its response regarding the evidence within one week of the above mentioned decision.

Grounds

It is undisputed in the matter that the request has been issued by the International Trade Commission of the United States, on the order of which Barnes & Noble has presented an international request for taking evidence. It is also undisputed that the ITC has received a motion to quash the request on January 2, 2012. Barnes & Noble has submitted a response to the motion to quash on January 13, 2012. On the basis of the given account, it is evident that the hearing of the motion to quash would automatically have stayed the handling of the pending subpoena, if the matter concerned an enforcement of a subpoena in the United States.

Barnes & Noble and Nokia have opposing perceptions of the prospect of success of the motion to quash. Based on the presented materials the District Court cannot assess the probability of the success of the motion to quash in the ITC. However, both parties expect that the ITC will give its decision within a short period of time. Although the request should, in accordance with the Hague Convention, be rendered without delay, the District Court holds that there are no grounds to enforce the request before the ITC, in which the main issue is pending, has given its decision on the motion to quash. For this reason the request is stayed fully in accordance with Chapter 14 Section 4 of the Code of Judicial Procedure, until the ITC has given its decision.

The District Court has granted a seven-day deadline for Nokia Corporation to submit its response regarding the documents identified in the request for judicial assistance. Because the matter is stayed fully, it is appropriate to extend this deadline correspondingly. Because Nokia is now aware of the request regarding

the documents, the District Court holds that the one-week deadline is sufficient under these circumstances.

Legal Provisions

Chapter 14 Section 4 of the Code of Judicial Procedure

Appeal

This decision can be appealed to the Helsinki Court of Appeal. Notice of Intention to Appeal shall be given at the latest on January 25, 2012. Guidance for filing the appeal is available.

District Court Judge

Eeva Tikka

Tel. 029 56 45099/secretary Fax 029 56 45157

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18.1.2012

H 11/16979

Hakija Oikeusministeriö/kansainvälinen yksikkö
c/o Tuuli Kainulainen
PL 25
00023 VALTIONEUVOSTO

Barnes & Noble Inc.
barnesandnoble.com LLC
c/o asianajaja Patrik Lindfors, Asianajotoimisto Lindfors & Co Oy

Asiaan osallinen Nokia Oyj
c/o asianajaja Petri Taivalkoski, Roschier Asianajotoimisto Oy

Asia Virka-apu ulkomaalais. tuomioistuimelle

Vireille 21.12.2011

SELOSTUS ASIASTA

Oikeusministeriö 29.12.2011 päivämällään kirjeellä toimittanut Espoon käräjäoikeudelle Yhdysvaltain viranomaiselta tulleen oikeusapupyyynnön toimenpiteitä varten. Oikeusapupyyynnössä on pyydetty, että käräjäoikeus ottaa vastaan pyynnössä tarkemmin yksilöityä todistelua Yhdysvalloissa vireillä olevaa oikeudenkäytää varten.

Lepäämäänjättämistä koskeva pyyntö

Nokia Oyj on pyytänyt, että käräjäoikeus jättää oikeusapupyyynnön käsittelyn kaikilta osin lepäämään ja jatkaa asian käsittelyä vasta sitten, kun Yhdysvaltain kansainvälisen kaupan komissio (International Trade Commission ITC) on antanut ratkaisun Nokian sille osoittaman kumoamispyyynnön johdosta sekä vielä pyytänyt, että dokumenttipyyntöä koskevan kirjallisen lausuman määräaikaa lykätään niin, että se on kaksi

viikkoja lukien ITC:n edellä mainitusta ratkaisusta.

Perustelut

Oikeusapupyyntö liittyy patenttiloukkausta koskevaan siviiliprosessiin, joka perustuu yhdysvaltalaisen Microsoft Corporationin 8.4.2011 nostamaan kanteeseen. Nokia ei ole asianosaisena kyseisessä prosessissa eikä kanteella Nokian käsitksen mukaan ole muutoinkaan liittymäkohtia Nokiaan tai Suomeen.

Nokia on 3.1.2012 toimittanut ITC:lle sen prosessisääntöjen mukaisen kumoamispyyynnön, jossa se osoittaa pyynnön olevan perusteeton, epäasiallinen ja Nokian oikeutta loukkaava. Oikeusapupyyntöä on haettu ja se on välitetty Suomeen antamatta Nokialle tilaisuutta ottaa kantaa pyynnön perusteisiin. Kumoamispyyynnön käsittely on kesken. On oletettavaa, että ITC:n päätös asiassa annetaan lyhyen ajan kuluessa ja on perusteita uskoa, että kumoamispyyntö tullaan hyväksymään. ITC:n menettelyä koskevien prosessisääntöjen mukaan kumoamispyyntö keskeyttäisi automaattisesti todistelumääräyksen käsittelyn, mikäli kyse olisi todistelumääräyksen täytäntöönpanosta Yhdysvalloissa. Vaikka Haagin yleissopimus ei ota nimenomaisesti kantaa nyt kyseessä oleviin olosuhteisiin, olisi yleissopimuksen tarkitusperien ja kansainvälisen oikeusjärjestelmän lähtökohtien vastaista, että Nokia ja sen johtohenkilöt joutuisivat Suomessa esittämään oikeusaputeitse todistelua, johon ei ole Yhdysvalloissa voimassa olevien prosessisääntöjen ja -käytännön mukaan perusteita.

Täytäntöönpanon kiireellisyys on Barnes & Noblen oman toiminnan seurausta. Se on ollut tietoinen väitetystä todistelutarpeestaan viimeistään toukokuusta 2011 lähtien. Kuitenkin oikeusapupyyntö on toimitettu vasta 2.12.2011.

Barnes & Noble Inc. vastaus

Vaatimukset

Barnes & Noble on vastustanut Nokian pyyntöä jättää 2.12.2011 päivätyyn oikeusapupyyynnöön käsittely kaikilta osin lepäämään ja vaatii, että käräjäoikeus hylkää lepäämäänjättämispyyynnön.

Perustelut

Nokian tarkoituksesta on kaikin tavoin viivästyttää oikeusapupyyynnön käsittelyä, jotta todistelun vastaanottaminen ei onnistuisi ennen ITC:n pääkäsittelyn alkamista 6.2.2012. On oletettavaa, että ITC antaa kumoamispyyntöä koskevan ratkaisunsa lyhyen ajan kuluessa, mutta on mahdollista, että asian ratkaisu siirtyy useilla viikoilla. Kumoamispyyntö tullaan todennäköisesti hylkäämään, joten lepäämäänjättäminen, mikä merkitsisi myös todistelun vastaanottamiseen tähtäävien valmistelujen pysäyttämistä, aiheuttaisi välttämättä oikeudenmenetyksiä. Sen sijaan vaikka todistelu ehdittäisiinkin ottamaan vastaan ennen ITC:n ratkaisua, se ei aiheuttaisi asianosaisille oikeudenmenetyksiä, koska ITC:n asiana olisi tällöin ratkaista, onko vastaanotettu todistelu mahdollista ottaa huomioon sen käsitellyssä.

Lepäämäänjättäminen on selvästi vastoin Haagin yleissopimuksen tarkoitusta. Keskusviranomaisten tehtävänä on torjua sellaiset

oikeusapupyyntö, jotka eivät kuulu yleissopimuksen soveltamisalaan tai jotka eivät täytä yleissopimuksen asettamia muodollisia vaatimuksia. Haagin sopimuksen mukaan pyydettyyn toimenpiteeseen on ryhdyttävä viivytyksettä. Tämänkin vuoksi lepäämäänjättäminen on selvästi vastoin yleissopimuksen tarkoitusta.

Oikeusministeriön lausuma

Käräjäoikeus on varannut oikeusministeriölle hakijana tilaisuuden lausua lepäämäänjättämistä koskevan pyynnön johdosta. Oikeusministeriö ei ole antanut asiassa lausumaa.

KÄRÄJÄOIKEUDEN RATKAISU

Todisteiden vastaanottamista koskeva oikeusapupyyntö jätetään lepäämään siihen saakka, kunnes Yhdysvaltain kansainvälisen kaupan komissio (International Trade Commission, ITC) on antanut ratkaisun Nokian sillalle osoittaman kumoamispyynnön (Motion to Quash) johdosta.

Käräjäoikeus pidentää Nokia Oyj:lle todisteiden esittämistä koskevan lausumapyynnön määräaikaa niin, että Nokia Oyj:n on annettava lausumansa asiassa viikon kuluessa edellä mainitusta ratkaisusta.

Perustelut

Asiassa on riidatonta, että oikeusapupyynnön on esittänyt Yhdysvaltain kansainvälisen kaupan komissio, jonka määräyksestä Barnes & Noble on esittänyt kansainvälisen, todisteiden vastaanottamista koskevan pyynnön, ja että kyseiselle tuomioistuimelle on 2.1.2012 jäetty oikeusapupyynnön kumoamista koskeva vaatimus. Barnes & Noble on antanut kumoamispyynnön johdosta siltä pyydetyn vastauksen 13.1.2012. Esitetyn selvityksen perusteella on ilmeistä, että kumoamispyyntö myös Yhdysvalloissa olisi johtanut todistelumääräyksen käsitelyn keskeytymiseen, mikäli kyse olisi sen täytäntöönpanosta Yhdysvalloissa.

Barnes & Noblen ja Nokia Oyj:n käsitykset kumoamispyynnön menestymisestä ovat vastakkaiset. Esitetyn selvityksen perusteella käräjäoikeudella ei ole edellytyksiä arvioida kumoamispyynnön menestymisen todennäköisyyttä ITC:ssä. Kumpikin osapuoli on kuitenkin pitänyt todennäköisenä, että ITC:n ratkaisu tullaan antamaan lyhyen ajan sisällä. Vaikka oikeusapupyyntö on Haagin sopimuksen perusteella käsiteltävä viivytyksettä, käräjäoikeus katsoo, että oikeusavun täytäntöönpanoon ei ole perusteita ryhtyä, ennenkuin ITC, jossa myös pääasia on vireillä, on antanut kumoamista koskevan hakemuksen johdosta päätöksensä. Tämän vuoksi oikeusapupyyntö kaikilta osin jätetään oikeudenkäymiskaaren 14 luvun 4 §:n mukaisesti lepäämään siihen saakka, kunnes ITC on ratkaissut pyynnön.

Käräjäoikeus on asettanut Nokia Oyj:lle seitsemän päivän määräajan oikeusapupyyntöön sisältyvien asiakirjojen esittämistä koskevan lausuman osalta. Koska asia kaikilta osin jää lepäämään, on tarkoitukseenmukaista pidentää myös tästä määräaikaa vastaavasti. Koska

asiakirjoja koskeva vaatimus on jo nyt Nokia Oyj:n tiedossa, käräjäoikeus pitää viikon määräaikaa tältä osin riittävänä.

Lainkohdat Oikeudenkäymiskaari 14 luku 4 §

Muutoksenhaku Tähän päätökseen saa hakea muutosta valittamalla Helsingin hovioikeuteen. Tyttymättömyydenilmoitus viimeistään 25.1.2012. Muutoksenhakuohjaus.

käräjätuomari Eeva Tikka

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CERTIFICATE OF SERVICE

I hereby certify that copies of the foregoing **RESPONDENTS BARNES & NOBLE, INC'S AND BARNESANDNOBLE.COM LLC'S MOTION TO HOLD THE RECORD OPEN TO RECEIVE EVIDENCE OBTAINED FROM NOKIA CORP. (OR ITS AFFILIATES) AND MOSAID TECHNOLOGIES INC. (OR ITS AFFILIATES) AND REQUEST TO SHORTEN TIME TO RESPOND** were served upon the following parties as indicated on this 19th day of January, 2012.

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U.S. International Trade Commission
500 E Street, S.W., Room 112
Washington, D.C. 20436

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 Via Overnight Federal Express Delivery
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/s/ Robert Greenfield

Robert Greenfield
Case Manager