

PUBLIC VERSION

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

In the Matter of

**CERTAIN FILAMENT LIGHT-EMITTING DIODES
AND PRODUCTS CONTAINING SAME**

Inv. No. 337-TA-1172

Order No. 17

On December 30, 2019, respondent Target Corporation (“Target”) filed a motion for “an order compelling Complainant The Regents of the University of California (“Complainant”) to produce all communications related to the subject matter of two public presentations that Complainant gave during the early pendency of this ITC Investigation, *i.e.*, Complainant’s strategy for enforcing university IP rights against retailers and specifically its strategy to sue retailers at the ITC in this Investigation to enforce University patents. Alternatively, Complainant should be ordered to produce all communications related to the presentations, or at least provide such communications to the Commission for in camera review, to determine the scope of Complainant’s waiver of privilege.” Motion Docket No. 1172-22.

On January 13, 2020, complainant The Regents of the University of California (“The Regents”), and the Commission investigative attorney (“Staff”) filed responses in opposition. No other response was filed.

Target requests that complainant be ordered to “produce all communications related to the subject matter of two public presentations that Complainant gave during the early pendency of this ITC Investigation, *i.e.*, Complainant’s strategy for enforcing university IP rights against retailers and specifically its strategy to sue retailers at the ITC in this Investigation to enforce

University patents. Alternatively, Complainant should be ordered to produce all communications related to the presentations, or at least provide such communications to the Commission for *in camera* review, to determine the scope of Complainant's waiver of privilege." Mot. at 1.

Target argues, *inter alia*:

On two separate occasions during the early pendency of this Investigation, The Regents of the University of California ("Complainant")—represented by Sherylle Mills Englander, the Director of Office of Technology & Industry Alliances at the University of California, Santa Barbara, joined by Complainant's attorneys from Nixon Peabody LLP and a representative from Complainant's third-party litigation funder, Longford Capital Management, LP—took the highly unusual step of giving public presentations discussing Complainant's strategy of suing retailers in this Investigation to enforce their asserted patents.

The only records produced by Complainant for these two presentations are conference agendas, which identify the subject matter of the presentations as generally being "UC Santa Barbara's Enforcement of Patent Rights Against Retailers." These agendas specifically reference this very ITC Investigation, which is treated as a "case study," with specific topics including the actions Complainant undertook in "obtaining university support," "developing an effective enforcement strategy," "financing the campaign," and "taking control of the public message." Complainant has not produced any other documents for these presentations and it appears that Complainant intentionally avoided creating any contemporaneous records. Furthermore, when Ms. Englander was recently deposed—a mere two months after the presentations—she []

Following the deposition of Ms. Englander, Respondent asked Complainant to produce all communications relating to the subject matter of the presentations. Complainant refused based on its assertion that such materials are privileged and remain privileged despite the presentations. However, any privilege that might have attached to such communications has been waived due to Complainant's intentional public disclosures concerning the same subject matter. Accordingly, Complainant should be compelled to produce all of its communications related to the subject matter of the presentations, *i.e.*, Complainant's strategy for enforcing university IP rights against retailers, including its strategy to sue retailers at the ITC in this Investigation.

Mem. at 1-2 (footnotes omitted).

Complainant argues:

Target's Motion defies the law and logic and should be denied. In the admitted absence of any evidence of disclosure by The Regents or its counsel of privileged information, Target's Motion seeks to compel the production of privileged communications related to The Regents' strategy to sue the Respondents in this Investigation at the International Trade Commission ("Commission"). The purported basis for such draconian relief is Target's argument that the disclosure in a presentation, offered at both the AUTM Western and Eastern Region Meetings ("AUTM Presentations"), of generalized information meant to educate the audience on the basics of patent enforcement somehow results in waiver of privilege in this Investigation. Based on Target's reasoning, any educational discourse involving discussion of particular matters would waive privilege as to the litigation strategies reflected in those matters, which clearly is not the law.

Even more farfetched is Target's contention that the *absence of evidence* of a waiver forms the basis for finding that a waiver occurred because The Regents allegedly "intentionally avoided creating any contemporaneous records" from the AUTM Presentations. Target couples this assertion with a brazen allegation that The Regents may have destroyed evidence. All of this is akin to arguing that an attorney-client meeting or phone call that is not documented results in a waiver of privilege. While creative, this argument crosses the Rubicon from zealous advocacy into sanctionable frivolousness. Whether intentional or not, not generating notes for the AUTM Presentations, which are not otherwise created in the ordinary course of business, should not and cannot cause a negative inference to support waiver. Target provides no support for this self-serving position. Moreover, imposing a requirement that all presenters maintain any hand-written notes not normally kept in the ordinary course of business is another self-serving rule Target asserts with no support.

As discussed in detail below, the record reflects that the AUTM Presentations contained discussions of publicly available, non-privileged information only. As confirmed by both The Regents and its corporate representative witness, Ms. Sherylle Englander, the presentations were oral in nature and resulted in little paper record. Target concedes that there is no evidence in the record that privileged information was disclosed, and this necessarily means that no waiver has occurred, not the contrary. *See* Ex. A, E-mail Correspondence from A. Ott to S. Hansen (Dec. 20, 2019, 3:04PM PT) (noting the "lack of contemporaneous records"); Mot. at 6 ("[T]he only evidence of what was actually disclosed by Complainant and its counsel are the two conference agendas that describe the matters to be discussed.").

Target's Motion offers no compelling reason for finding that waiver occurred, nor does it offer good cause for why The Regents—and its counsel—should now be compelled to go on an e-mail fishing expedition to produce *all* communications regarding The Regents' strategy for enforcing university IP

rights against the Respondents in this Investigation—information that remains privileged. The publicly available, non-privileged information disclosed in the AUTM Presentations is cumulative of The Regents’ documents production, interrogatory responses, and witness deposition testimony, thus, Target has failed to provide good cause to seek e-mail discovery. Even if Target would have been entitled to e-mail discovery of communications regarding the AUTM presentations—which it is not—Target failed to serve targeted requests for production that seek such e-mails as the Parties had agreed to in the Joint Discovery Statement.

Target has provided no authority supporting its position that disclosure of public information coupled with the absence of evidence of waiver together somehow result in a broad subject matter waiver of privilege. Accordingly, The Regents respectfully requests that Target’s Motion be denied in its entirety.

Opp’n at 1-3 (emphasis in original).

The Staff argues:

It appears to the Staff that there are three categories of documents relevant to Target’s motion to compel: (i) non-email documents and communication regarding to the two identified presentations; (ii) email communications regarding the those presentations; and (iii) documents subject to an alleged waiver of attorney client communication.

With respect to the first category of documents, Complainant has indicated that a reasonable search failed to identify any responsive documents. Mot. Exh. E at 2. In this respect, Target has failed to show that any documents have been purposely withheld. The Regents, however, cannot be compelled to produce that which does not exist or is not within its possession, custody, or control.

With respect to the second category of documents, the parties have agreed that that “no email[s] (including attachments) need to be searched unless good cause for their search and production can be shown.” *See* Joint Discovery Statement, EDIS Doc. ID 689256 (Sept. 25, 2019). Target contends that the absence of any documents or testimony regarding the substance of the two presentations constitutes good cause to require The Regents to search and produce emails regarding the same. *See* Mot. Memo. at 6-7. The Staff disagrees. Target did receive testimony regarding the subject matter of the two presentations. *See* Mot. Exh. B at 115:4- 118:8. Ms. Englander testified that the two presentations were based on the content of U.C. Santa Barbara’s website regarding its filament LED patent portfolio. *See* Mot. Exh. B. at 118:3-7 (“But, again, we used the microsite content, so I think the content of our talk, you – I can absolutely testify that it was based on the information on the USCB microsite on filamentpatent.ucsb.edu.”). In light of Ms. Englander’s testimony on the subject matter of the two presentations, the Staff does not believe that good cause exists to warrant the search and production emails.

Finally, with respect to the third category of documents, Target contends that The Regents waived privilege by publicly speaking regarding its enforcement strategy. *See* Mot. Memo. at 4-7. The Staff disagrees. “Under the doctrine of implied subject-matter waiver, also known as the ‘fairness doctrine,’ one who asserts the attorney-client privilege or attorney work-product privileges may not do so selectively by disclosing favorable privileged information as a ‘sword’ in support of his position against an opposing litigant while at the same time asserting privilege as a ‘shield’ against the disclosure of unfavorable information concerning the same subject matter.” According to the Federal Circuit, this doctrine “is grounded in principles of fairness and serves to prevent a party from simultaneously using the privilege as both a sword and a shield.” *In re Seagate Technology, LLC*, 497 F.3d 1360, 1372 (Fed. Cir. 2007).

Here, Target merely speculates that The Regents or their representatives may have revealed attorney-client communication during the two presentations at issue. *See* Mot. Memo. at 4-7. Although it is possible that an attorney could reveal attorney client communication when discussing litigation strategies employed in a particular case, Target has not identified any specific disclosure of attorney-client communication that would give rise to waiver, and Target has not shown that The Regents are relying upon the selective disclosure of privileged information as a “sword” in support of its positions in this Investigation. *See id.* The fairness doctrine thus fails to offer any basis for subject matter waiver. Accordingly, the Motion fails to show any waiver of privilege.

Staff Resp. at 2-4 (emphasis in original) (certain citations omitted).

With respect to the non-email documents and communication regarding the two presentations, complainant stated that it “has already searched for and produced all information in its possession, custody, and control relating to the content of the AUTM Presentations and confirmed that aside from e-mail communications—which were not searched due to the Parties’ prior agreement—no additional communications or written materials are available.” *See* Opp’n at 9-10; Opp’n Ex. G (email correspondence from Hansen to Ascarrunz (Dec. 6, 2019)).

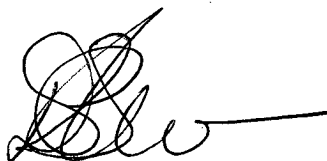
As to the email communications concerning the two presentations, the parties have agreed that “no email[s] (including attachments) need to be searched unless good cause for their search and production can be shown.” *See* Joint Discovery Statement (EDIS Doc. ID No. 689256) (Sept. 25, 2019). Target argues that the absence of any documents or testimony regarding the substance of the two presentations constitutes good cause to require complainant to search and produce emails.

However, there was testimony regarding the subject matter of the two presentations. *See* Opp'n Ex. C (Englander Dep. Tr.) at 114-118. Ms. Englander testified that the two presentations were based on the content of U.C. Santa Barbara's website regarding its filament LED patent portfolio. *See* Opp'n Ex. C (Englander Dep. Tr.) at 118 ("But, again, we used the microsite content, so I think the content of our talk, you – I can absolutely testify that it was based on the information on the USCB microsite on filamentpatent.ucsb.edu."). In light of Ms. Englander's testimony on the subject matter of the two presentations, Target has not shown that good cause exists to warrant the search and production of emails.

With respect to the documents subject to an alleged waiver of attorney client communication, Target argues that complainant waived privilege by publicly speaking regarding its enforcement strategy. *See* Mem. at 5-6. The evidence does not show that the two public presentations involved discussion of any confidential or privileged information. Thus, complainant did not waive privilege as to communications with counsel regarding the enforcement efforts and strategies particular to this investigation. Those communications are properly protected by attorney-client privilege. *See* Opp'n at 6-8.

Motion No. 1172-22 is denied.

So ordered.



David P. Shaw
Administrative Law Judge

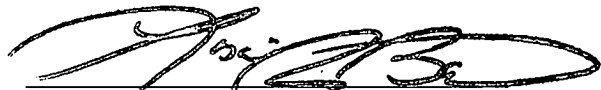
Issued: February 21, 2020

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PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **Order No. 17** has been served by hand upon the Commission Investigative Attorney, **Whitney Winston, Esq.**, and the following parties as indicated, on FEB 21 2020.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street SW, Room 112A
Washington, DC 20436

For complainant The Regents of the University of California:	
Evan H. Langdon, Esq. Nixon Peabody LLP 799 9th Street NW, Suite 500 Washington, DC 20001	<input type="checkbox"/> Via Hand Delivery <input checked="" type="checkbox"/> Express Delivery <input type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____
For respondents Amazon.com, Inc.; and Amazon.com Services, Inc.:	
Stefani E. Shanberg, Esq. Morrison & Foerster LLP 425 Market Street San Francisco, CA 94105	<input type="checkbox"/> Via Hand Delivery <input checked="" type="checkbox"/> Express Delivery <input type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____
For respondents IKEA of Sweden AB; IKEA Supply AG; IKEA Distribution Services Inc.; and IKEA North America Services, LLC:	
David F. Nickel, Esq. Foster, Murphy, Altman & Nickel, PC 1150 18th Street NW, Suite 775 Washington, DC 20036	<input type="checkbox"/> Via Hand Delivery <input checked="" type="checkbox"/> Express Delivery <input type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____

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For respondent Bed Bath & Beyond Inc.:	
Christian E. Samay, Esq. Lerner, David, Littenberg, Krumholz & Mentlik, LLP 20 Commerce Drive Cranford, NJ 07016	<input type="checkbox"/> Via Hand Delivery <input checked="" type="checkbox"/> Express Delivery <input type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____
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