

Miscellaneous Docket No. _____

United States Court of Appeals
for the
Federal Circuit

RECEIVED
NOV 4 PM 4:00
U.S. COURT OF APPEALS
FEDERAL CIRCUIT

IN RE GOOGLE INC.,
Petitioner.

*Petition for Writ of Mandamus to the United States District Court,
Northern District of California, San Francisco Division
in 3:10-CV-03561-WHA*

PETITION FOR WRIT OF MANDAMUS

ROBERT A. VAN NEST
CHRISTA M. ANDERSON
STEVEN A. HIRSCH
KEKER & VAN NEST LLP
633 Battery Street
San Francisco, CA 94111
(415) 391-5400

IAN C. BALLON
GREENBERG TRAURIG, LLP
1900 University Avenue
East Palo Alto, CA 94303
(650) 328.8500

SCOTT T. WEINGAERTNER
BRUCE W. BABER
KING & SPALDING LLP
1185 Avenue of the Americas
New York, NY 10036
(212) 556.2100

Attorneys for Petitioner Google Inc.

NOVEMBER 4, 2011

CERTIFICATE OF INTEREST

Counsel for petitioner Google Inc. certifies the following:

1. The full name of every party we represent (which are the real parties in interest) are:

Google Inc.

2. All parent corporations and any publicly held companies that own 10 percent of more of the stock of the parties we represent are:

None.

3. The name of all law firms and the partners or associates that appeared in the trial court for the party we now represent or are appearing in this Court are:

KEKER & VAN NEST LLP

Robert A. Van Nest, Christa M. Anderson, Steven A. Hirsch,

Michael S. Kwun, Daniel E. Purcell, Eugene M. Paige,

Matthias A. Kamber, Reid P. Mullen

KING & SPALDING LLP

Donald F. Zimmer, Jr., Cheryl A. Sabnis, Scott T. Weingaertner,

Brian C. Banner, Bruce W. Baber, Christopher C. Carnaval,

Geoffrey M. Ezgar, Mark H. Francis, Robert F. Perry,

Steven T. Snyder, Truman H. Fenton

GREENBERG TRAURIG, LLP

Ian C. Ballon, Heather J. Meeker, Dana K. Powers, Joseph R. Wetzel


Luis Villa, IV, Valerie W. Ho, Wendy M. Mantell

GOOGLE INC.

Renny F. Hwang

Dated: November 4, 2011

KEKER & VAN NEST LLP

By:  _____

ROBERT A. VAN NEST
Attorneys for Defendant
GOOGLE INC.

TABLE OF CONTENTS

	<i>Page</i>
CERTIFICATE OF INTEREST	i
TABLE OF AUTHORITIES	v
I. Petition for Writ of Mandamus and Relief Sought.....	1
II. Introduction.....	1
III. Principal Issues Presented	6
IV. Statement of Facts.....	6
A. Soon after Oracle charged Google with patent infringement, Google began an <i>Upjohn</i> -type internal investigation of Oracle’s claims.	6
B. Mr. Lindholm’s August 6, 2010 email reported some results of Google’s <i>Upjohn</i> -type investigation of Oracle’s claims.	7
C. Oracle exploited Google’s inadvertent production of eight “auto-saves” of the Lindholm email to attack the email’s privileged status.....	9
D. The district court erroneously compelled production of the Lindholm email and drafts.	10
V. Reasons why the writ should issue	12
A. The district court’s order is clearly erroneous as a matter of law and raises new and important problems of first impression for mandamus review.	13
1. The district court erroneously held that a corporation must make a heightened showing that a communication from an employee to an in-house lawyer had a primarily legal purpose—even when both parties undisputedly were engaged in an <i>Upjohn</i> -type internal investigation.....	14

a.	Google proved that the Lindholm email was privileged under <i>Upjohn</i> and under Ninth Circuit precedents that treat in-house and outside counsel the same for privilege purposes.	14
b.	The district court adopted a distorted version of the D.C. Circuit’s <i>Sealed Case</i> standard, which allowed it to rule based on unwarranted assumptions about in-house counsel instead of the undisputed evidence.	19
2.	The district court’s expanded <i>Sealed Case</i> standard led it into additional legal errors.	25
3.	The district court erroneously denied work-product protection to the Lindholm email.	27
4.	The district court clearly erred by deferring to the magistrate’s erroneous legal conclusions, in violation of Rule 72(a).	27
B.	The remaining mandamus factors are satisfied as well.	29
1.	Google has no other means, such as an appeal, to obtain the desired relief.	29
2.	Google will be damaged or prejudiced in ways not correctable on appeal.	29
VI.	Conclusion	30

TABLE OF AUTHORITIES

Cases	<i>Page(s)</i>
<i>Admiral Ins. Co. v. U.S. Dist. Ct. for Dist. of Ariz.</i> , 881 F.2d 1486 (9th Cir. 1989)	13, 16, 22, 29
<i>Barthelemy v. Air Lines Pilots Ass’n</i> , 897 F.2d 999 (9th Cir. 1990)	26
<i>Barton v. U.S. Dist. Ct.</i> , 410 F.3d 1104 (9th Cir. 2005)	26
<i>Bauman v. U.S. Dist. Ct.</i> , 557 F.2d 650 (9th Cir.1977)	<i>passim</i>
<i>Boca Investering P’ship v. U.S.</i> , 31 F. Supp. 2d 9 (D.D.C. 1998)	22
<i>Brownlow v. Gen. Motors Corp.</i> , CIV. A. 3:05CV-414-R, 2007 WL 2712925 (W.D. Ky. Sept. 13, 2007)	28
<i>Burlington N. & Santa Fe Ry. Co. v. U.S. Dist. Ct.</i> , 408 F.3d 1142 (9th Cir. 2005)	2
<i>Computer Econ., Inc. v. Gartner Group, Inc.</i> , 50 F. Supp. 2d 980 (S.D. Cal. 1999)	28
<i>Gomez v. Vernon</i> , 255 F.3d 1118 (9th Cir. 2001)	11
<i>Hemstreet v. Spiegel, Inc.</i> , 851 F.2d 348 (Fed. Cir. 1988)	18
<i>Hercules, Inc. v. Exxon Corp.</i> , 434 F. Supp. 136, 196 U.S.P.Q. 401 (D. Del. 1977)	25
<i>Hernandez v. Tanninen</i> , 604 F.3d 1095 (9th Cir. 2010)	13
<i>Holly Farms Corp. v. N.L.R.B.</i> , 517 U.S. 392 (1996)	28

<i>In re Brand Names Prescription Drugs Litig.</i> , No. 94 C 897, 1995 WL 557412 (N.D. Ill. Sept. 19, 1995).....	18
<i>In re Columbia/HCA Healthcare Billing Practices Litig.</i> , 293 F.3d 289 (6th Cir. 2002).....	27
<i>In re Kaypro</i> , 218 F.3d 1070 (9th Cir. 2000).....	26
<i>In re Nintendo Co., Ltd.</i> , 589 F.3d 1194, 1197, 93 U.S.P.Q.2d 1152 (Fed. Cir. 2009).....	12
<i>In re OM Secs. Litig.</i> , 226 F.R.D. 579 (N.D. Ohio 2005).....	18
<i>In re Sealed Case</i> , 737 F.2d 94 (D.C. Cir. 1984)	<i>passim</i>
<i>Jacobs v. Nintendo of Am., Inc.</i> , 370 F.3d 1097 (Fed. Cir. 2004).....	18
<i>Lenz v. Universal Music Corp.</i> , C 07-3783 JF (RS), 2009 WL 3573990 (N.D. Cal. Oct. 30, 2009).....	17
<i>Med. Imaging Ctrs. of Am., Inc. v. Lichtenstein</i> , 917 F. Supp. 717 (S.D. Cal. 1996)	29
<i>Milwaukee Carpenter’s Dist. Council Health Fund v. Philip Morris, Inc.</i> , 70 F. Supp. 2d 888 (E.D. Wis. 1999).....	29
<i>Mohawk Indus., Inc. v. Carpenter</i> , 130 S. Ct. 599 (2009)	11, 12, 30
<i>Motley v. Marathon Oil Co.</i> , 71 F.3d 1547 (10th Cir. 1995).....	26
<i>Navajo Nation v. U.S. Forest Serv.</i> , 535 F.3d 1058 (9th Cir. 2008).....	28
<i>Perry v. Schwarzenegger</i> , 591 F.3d 1147 (9th Cir. 2010).....	12, 14, 28

<i>Potter v. United States</i> , No. 02-CV-0632-H (POR), 2002 WL 31409613 (S.D. Cal. July 26, 2002)	18
<i>PowerShare, Inc. v. Syntel, Inc.</i> , 597 F.3d 10 (1st Cir. 2010)	28
<i>Seegerstrom v. United States</i> , No. C 00-0833 SI, 2001 WL 283805 (N.D. Cal. Feb. 6, 2001)	18
<i>Therasense, Inc. v. Becton, Dickinson & Co.</i> , C 04-02123 WHA, 2008 WL 2323856 (N.D. Cal. May 22, 2008).....	19
<i>Transamerica Computer Co. v. IBM Corp.</i> , 573 F.2d 646 (9th Cir. 1978).....	11
<i>U.S. v. Ritchey</i> , 632 F.3d 559 (9th Cir. 2011).....	19
<i>United States v. Bergonzi</i> , 216 F.R.D. 487 (N.D. Cal. 2003)	27
<i>United States v. Chen</i> , 99 F.3d 1495 (9th Cir. 1996).....	16, 17, 19
<i>United States v. ChevronTexaco Corp.</i> , 241 F. Supp. 2d 1065 (N.D. Cal. 2002)	20
<i>United States v. KPMG LLP</i> , 237 F. Supp. 2d 35 (D.D.C. 2002)	22
<i>United States v. Rowe</i> , 96 F.3d 1294 (9th Cir. 1996)	16
<i>United States v. Ruehle</i> , 583 F.3d 600 (9th Cir. 2009).....	29
<i>Upjohn Co. v. United States</i> , 449 U.S. 383 (1981)	<i>passim</i>
<i>Wessel v. City of Albuquerque</i> , No. MISC 00-00532 ESH/AK, 2000 WL 1803818 (D.D.C. Nov. 30, 2000).....	22

Rules

Federal Rule of Civil Procedure 72(a) *passim*

Other Authorities

Grace M. Giesel, *The Legal Advice Requirement of the
Attorney-Client Privilege: A Special Problem for in-House
Counsel and Outside Attorneys Representing Corporations*,
48 Mercer L. Rev. 1169 (1997) 17, 23, 24

12 Wright & Miller, *Federal Practice & Procedure* § 3069, at
350 (2d ed. 1997) 29

I. Petition for Writ of Mandamus and Relief Sought

Google Inc. (“Google”), defendant in the above-captioned case, petitions this Court to issue a writ of mandamus directing the United States District judge presiding over the case to enter an order (1) confirming that the August 6, 2010 email (and all drafts thereof) authored by Tim Lindholm are privileged; (2) granting all of the relief detailed in the Proposed Order submitted below (A1);¹ (3) sealing its October 20, 2011 order denying Rule 72(a) relief (A4); and (4) vacating its November 2, 2011 order stripping the Lindholm email and drafts of their confidentiality designations (Dkt. 596).

II. Introduction

“[T]he [attorney-client] privilege exists to protect not only the giving of professional advice to those who can act on it but also the giving of information to the lawyer to enable him to give sound and informed legal advice.”

Upjohn Co. v. United States, 449 U.S. 383, 390 (1981).

“Adding the name of a lawyer to a list of business recipients is exceedingly easy and is very often done without any intention that it be used to frame legal advice.”

A14 at n.4.

Thirty years ago, the Supreme Court issued its landmark ruling in *Upjohn Co. v. United States*,² which recognized the importance of maintaining confidentiality in corporate internal investigations. *Upjohn* held that the

¹ “A” refers to the Appendix hereto.

² 449 U.S. 383 (1981).

effectiveness of such investigations depends upon a broad attorney-client privilege that protects communications between in-house lawyers and lower-level employees, who often possess the knowledge that lawyers need if they are to render sound legal advice.

Now—in a ruling that undermines *Upjohn* and reflects an unwarranted distrust of in-house lawyers—the district court³ has compelled production of a confidential email between Google engineer Tim Lindholm and Google in-house counsel Ben Lee (among others). The email concerned an investigation that Mr. Lindholm conducted at the direction of Google’s lawyers as part of the legal department’s effort to evaluate a major lawsuit for the company’s senior management. In that lawsuit, real party in interest Oracle America, Inc. (“Oracle”) asserts that Google’s Android operating system—now the world’s leading “smart phone” platform—infringes patents and copyrights that Oracle acquired in 2010 when it purchased Sun Microsystems. Oracle has claimed billions in damages.

The Lindholm email presents a classic *Upjohn* scenario—a corporation asking its counsel to communicate with a lower-level employee to investigate a threatened legal claim against the corporation. Google’s uncontradicted evidence showed that:

- Oracle lawyers met with Google lawyers on July 20, 2010 to present

³ Unless otherwise indicated, actions and statements attributed to “the district court” include those of the magistrate judge. *See Burlington N. & Santa Fe Ry. Co. v. United States Dist. Ct.*, 408 F.3d 1142, 1146 n.1 (9th Cir. 2005).

Oracle's claims that parts of Google's Android platform infringed on several Oracle patents. Oracle threatened to sue Google over those patents. Three weeks later, Oracle filed this lawsuit.

- After the July 20, 2010 meeting, Google Senior Counsel Ben Lee asked Google engineer Tim Lindholm to gather information related to Oracle's infringement claims to assist Google's legal analysis of those claims.
- On July 30, 2010, Google General Counsel Kent Walker convened a meeting to formulate a response to Oracle's infringement claims. Attorney Lee and Mr. Lindholm attended that meeting, as did Google's top management. At the meeting, Attorney Walker instructed Mr. Lindholm and Google engineer Dan Grove to continue to work under Attorney Lee's supervision to gather information about the technology underlying Oracle's patent-infringement claims.
- On August 6, 2010, Lindholm sent Attorney Lee and others an email reporting on some of the results of his investigation stemming from Oracle's litigation threat and the July 30, 2010 meeting involving Google legal counsel and top management. The email concerned the very technology that Oracle—only days before—had told Google was infringing Oracle's patents (and also mentioned related technology potentially affected by Oracle's claims). The email was not intended to convey general business advice about Android.
- Lindholm's email said "Attorney Work Product" and "Google Confidential" at the top. During the five minutes that it took Lindholm to draft the email, Google's computer system "auto-saved" nine drafts.
- The final version of the Lindholm email was listed, twice, on Google's privilege log. Eight drafts were produced inadvertently and then "clawed back" pursuant to a protective order, triggering this discovery battle.

Despite this evidence, the district court compelled production of the final Lindholm email and of the auto-saved drafts (collectively, "the Lindholm email"). The district court held that Google had failed to establish that the Lindholm email

“constitutes a communication related to the purpose of obtaining legal advice from a legal advisor in his capacity as such.”

The district court reached that result by adopting and expanding upon a D.C. Circuit precedent, *In re Sealed Case*,⁴ which requires a heightened “clear showing” of the communication’s legal purpose where the lawyer in question is an in-house lawyer who is also a corporate officer with significant non-legal responsibilities. Going far beyond the D.C. Circuit’s holding, the district court extended this “clear showing” standard to *all* in-house lawyers because they are presumed to do more non-legal work than outside counsel. The district judge’s written opinion justified this approach by citing his long-held personal skepticism about privilege claims involving in-house counsel. He also endorsed the *Sealed Case* standard and urged this Court to adopt it in this anticipated writ proceeding.⁵

Based on its unfounded assumptions about in-house lawyers, and wielding its enhanced “clear showing” standard against Google, the district court *speculated* that Lindholm “may well have been” discussing non-privileged business negotiations rather than Google’s internal legal investigation of Oracle’s claims. The district court then held (in the face of copious contrary evidence) that Google had failed to disprove that possibility by submitting evidence linking the email to Google’s legal investigation. Under its “clear showing” standard, the district court

⁴ 737 F.2d 94 (D.C. Cir. 1984).

⁵ A14 at n.4.

held, in effect, that the entire basis for asserting the privilege must be evident from the face of the document.

That approach to privilege claims is contrary to *Upjohn*'s teachings and intent, because it effectively strips privilege from communications by lower- and mid-level employees to in-house counsel unless those employees are sufficiently savvy and detail-oriented to include specific references to the legal investigation in *each* of those communications. Under the district court's approach, the employee's failure to include such references in each communication cannot be remedied later by declarations explaining the connection between the communication and the legal investigation.

That is not how courts review privilege claims. Rather, courts read and evaluate extrinsic evidence that furnishes a context for, and explains, the privileged communication. Here, by contrast, the district court went so far as to discount the entire declaration of Mr. Lee—the in-house lawyer who received, described, and explained the context of Lindholm's email—because it didn't contain a superfluous affirmation that he "*read*" the email. This ultra-hyper-technical approach reflected the district court's extreme distrust of in-house lawyers and its consequent adoption (and overextension) of the *Sealed Case* standard.

For these and other reasons detailed below, this Court should issue a writ of mandamus ordering the district court to grant the relief set forth in Part I, above.

III. Principal Issues Presented

1. Did the district court commit clear error as a matter of law, warranting mandamus relief, when it held that a corporation must make a heightened “clear showing” that an email from an employee to an in-house lawyer had a primarily legal purpose—even when both parties undisputedly were engaged in the type of internal corporate investigation discussed in *Upjohn Co. v. United States*?

2. Did the district court violate Federal Rule of Civil Procedure 72(a), and thus commit clear error as a matter of law, warranting mandamus relief, when it deferred to the legal conclusions of the magistrate judge?

IV. Statement of Facts

A. **Soon after Oracle charged Google with patent infringement, Google began an *Upjohn*-type internal investigation of Oracle’s claims.**

The following undisputed facts were supported by Google’s *in camera* submission of the final Lindholm email,⁶ supplemented by five declarations of current and former Google employees.⁷ The declarations are attached.

On July 20, 2010, Google Senior Counsel Ben Lee attended a meeting at Google with attorneys representing Oracle.⁸ At that meeting, Oracle asserted that Google infringed several Oracle patents.⁹ Oracle threatened to sue Google over

⁶ Google does not submit those documents *in camera* here, because the district court’s unsealed, publicly filed order quotes the final Lindholm email in full.

⁷ See A19; A22; A26; A30; A33.

⁸ A20 at ¶ 5.

⁹ A20 at ¶ 5.

those patents.¹⁰ Just over three weeks later, Oracle made good on its threat, filing this lawsuit on August 12, 2010.¹¹

After the July 20, 2010 meeting, Google Senior Counsel Ben Lee asked Google engineer Tim Lindholm to gather information related to Oracle's infringement claims to assist Google's legal analysis of those claims.¹²

On July 30, 2010, Google General Counsel Kent Walker convened a meeting to formulate a response to Oracle's infringement claims.¹³ Attorney Lee and Mr. Lindholm attended that meeting, as did Google's top management.¹⁴ At the meeting, Attorney Walker instructed Mr. Lindholm and Google engineer Dan Grove to continue to work under Attorney Lee's supervision to gather information about the technology underlying Oracle's patent-infringement claims.¹⁵

B. Mr. Lindholm's August 6, 2010 email reported some results of Google's *Upjohn*-type investigation of Oracle's claims.

On August 6, 2010, Mr. Lindholm sent an email to Attorney Lee and to Andy Rubin (then a Google Vice President in charge of Android).¹⁶ The final version of the email, sent at 11:05 a.m., contained the phrases "Attorney Work

¹⁰ A20 at ¶ 5.

¹¹ Complaint [Dkt. No. 1].

¹² A20 at ¶ 6; A23 at ¶ 5.

¹³ A20 at ¶ 7.

¹⁴ A20 at ¶ 7; A23 at ¶ 6.

¹⁵ A20 at ¶ 8; A23 at ¶ 7; A31-A32 at ¶ 7-8.

¹⁶ A21 at ¶ 9; A24 at ¶ 8.

Product” and “Google Confidential” at the top, and later was listed twice on Google’s privilege log.¹⁷ Mr. Lindholm’s declaration states that his email “report[ed] investigations and analyses that Mr. Grove and I conducted at the request of Google General Counsel Kent Walker, under the supervision of Mr. Lee, and in anticipation of Oracle’s threatened lawsuit.”¹⁸ Likewise, Mr. Lee’s declaration states: “On or about August 6, 2010, I received an email from Mr. Lindholm regarding the investigation Mr. Walker and I had asked him to conduct. On information and belief, I understand that two copies of this email were listed on Google’s privilege log as entries 2551 and 5513 and that one copy of it has been submitted *in camera* to the Court.”¹⁹

Mr. Lindholm also declares that his email *did not* contain “general business advice” about Android.²⁰ Rather, he was following up on the July 30, 2010 meeting by reporting on the results of his continued investigation of Oracle’s infringement claims so that Attorneys Lee and Walker could develop legal advice and convey that advice to Google’s top management.²¹

Six days after Mr. Lindholm sent his email to Attorney Lee, Oracle filed its

¹⁷ A21 at ¶ 9; A24 at ¶ 9.

¹⁸ A25 at ¶ 14.

¹⁹ A21 at ¶ 9.

²⁰ A31-A32 at ¶ 7.

²¹ A31-A32 at ¶¶ 7-8.

complaint in this action.²² The Lindholm email addressed some of the technology that, according to Oracle, infringed Oracle's patents (and the email also mentioned related technology potentially affected by Oracle's claims).²³

C. Oracle exploited Google's inadvertent production of eight "auto-saves" of the Lindholm email to attack the email's privileged status.

Google inadvertently produced to Oracle eight drafts of the Lindholm email.²⁴ As the district court found, the drafts are "auto-save" snapshots of the email that Mr. Lindholm ultimately sent, taken at eight different stages of preparation during the five-minute period in which he drafted the email.²⁵ The drafts slipped through Google's privilege-review system because they depicted the email before Lindholm had added the attorney's name or any privilege legend.²⁶

This privilege battle arose because Oracle willfully violated the protective order to which the parties had agreed. Indeed, one disturbing aspect of this dispute is that the district court's ultimate order compelling disclosure rewarded Oracle's misconduct. Twice on July 21, 2011, Oracle disclosed in court proceedings the contents of an inadvertently produced and incomplete draft of the Lindholm email, without providing prior notice to Google as the protective order requires.²⁷ Google

²² Dkt. No. 1.

²³ A20-A21 at ¶¶7-10; ¶¶ A23-A24 7-8.

²⁴ A ninth draft of the email was listed on Google's privilege log as entry 5512.

²⁵ A5; A37; *see also* A24 at ¶ 11.

²⁶ A29 at ¶13.

²⁷ A52:1-4.

was taken by surprise because that version of the draft lacked Lee’s name or the work-product heading. Google immediately investigated the document and learned that it was an auto-saved draft of a privileged document listed twice on Google’s privilege log. Google clawed back the drafts the very next day.²⁸

D. The district court erroneously compelled production of the Lindholm email and drafts.

Oracle then moved the magistrate to compel production of the Lindholm email and all drafts thereof.²⁹ The magistrate did not question the honesty or integrity of Google’s declarants.³⁰ Yet she stated that Google had failed to “connec[t] the dots” by specifically linking the Lindholm email to the pre-litigation investigation described in the declarations.³¹ The magistrate applied a variant of the D.C. Circuit’s *Sealed Case* “clear showing” standard for communications with in-house counsel and concluded that, under that standard, Google had failed to establish that the Lindholm email was “a communication related to the purpose of obtaining legal advice from a legal advisor in his capacity as such.”³² Instead, the magistrate speculated that Lindholm “may well have been communicating with Lee about other non-privileged matters, including the business of negotiating for a

²⁸ A71.

²⁹ A73.

³⁰ A87:15-21; A88:23 –A89:19.

³¹ A89:9-12.

³² A39:18-21.

Java license.”³³ The magistrate speculated that this was “a simple and reasonable explanation for the Email that Google ma[de] no effort to foreclose.”³⁴

Google then produced the documents—prominently stamped with privilege legends—under a written reservation of the right to claw them back (again) if a court later confirmed their privileged status.³⁵

The district court later denied Google’s Rule 72(a) motion for relief from the magistrate’s order. The district court noted that the “clear showing” standard applied by the magistrate originated in the D.C. Circuit’s *Sealed Case* decision and acknowledged that the Ninth Circuit had “yet to address” that standard.³⁶ The district court also expressed skepticism about the role and intentions of in-house counsel, praised the *Sealed Case* standard, and effectively urged this Court to adopt that standard:

In his prior career, the undersigned judge practiced in a large civil litigation firm for 25 years and had considerable experience with and exposure to the practice of company officers and employees routinely copying

³³ A40.

³⁴ A40.

³⁵ Producing documents under compulsion does not waive privilege if reasonable efforts are taken to protect the privilege. *See Gomez v. Vernon*, 255 F.3d 1118, 1131-32 (9th Cir. 2001); *Transamerica Computer Co. v. IBM Corp.*, 573 F.2d 646, 650-51 (9th Cir. 1978). Here, Google has pursued every means available to protect the privilege, including filing this petition. The Supreme Court recognizes that seeking mandamus is a viable alternative to the strategy of defying a discovery order and later appealing from a resulting order imposing sanctions or finding contempt. *See Mohawk Indus., Inc. v. Carpenter*, 130 S. Ct. 599, 607-08 (2009).

³⁶ A14.

internal (and even external) counsel on all manner of business communications as an attempt to cloak a business message in privilege. Adding the name of a lawyer to a list of business recipients is exceedingly easy and is very often done without any intention that it be used to frame legal advice. For that reason, the rule adopted by now-Justice Ginsburg in *In re Sealed Case* makes considerable sense and addresses real-world practices. This experience is added for the benefit of the record and for any appellate review. It has not colored the outcome of this order save and except to reinforce the wisdom of the holding in *In re Sealed Case*.³⁷

V. Reasons why the writ should issue

“[L]itigants confronted with a particularly injurious or novel privilege ruling” may obtain a writ of mandamus “in extraordinary circumstances—*i.e.*, when a disclosure order ‘amount[s] to a judicial usurpation of power or a clear abuse of discretion,’ or otherwise works a manifest injustice.” *Mohawk Indus., Inc. v. Carpenter*, 130 S. Ct. 599, 607-08 (2009) (citation omitted). Federal appellate courts “rely on mandamus to resolve ‘new [privilege] questions that otherwise might elude appellate review’ or ‘to protect important or clear claims of privilege.’” *Perry v. Schwarzenegger*, 591 F.3d 1147, 1157 (9th Cir. 2010) (citation omitted).

The Ninth Circuit³⁸ applies five criteria, known as the “*Bauman* factors,”³⁹

³⁷ A14 at n.4.

³⁸ Because this petition does not involve substantive patent-law issues, this Court applies the laws of the circuit in which the district court sits. *See In re Nintendo Co., Ltd.*, 589 F.3d 1194, 1197, 93 U.S.P.Q.2d 1152 (Fed. Cir. 2009).

³⁹ *See Bauman v. United States Dist. Ct.*, 557 F.2d 650 (9th Cir.1977).

to determine whether mandamus is appropriate in a given case: (1) whether the petitioner has no other means, such as an appeal, to obtain the desired relief; (2) whether the petitioner will be damaged or prejudiced in any way not correctable on appeal; (3) whether the district court order is clearly erroneous as a matter of law; (4) whether the district court's order is an oft-repeated error or manifests a persistent disregard of the federal rules; (5) whether the district court's order raises new and important problems or issues of first impression. *See Admiral Ins. Co. v. U.S. Dist. Ct. for Dist. of Ariz.*, 881 F.2d 1486, 1490-91 (9th Cir. 1989). The factors serve as “guidelines”—“a point of departure” for the Court’s analysis of the propriety of mandamus relief. *Id.* at 1491. The petitioner need not satisfy all five factors—indeed, “the fourth and fifth *Bauman* factors are rarely, if ever, present at the same time.” *Id.*; *see Hernandez v. Tanninen*, 604 F.3d 1095, 1101-02 (9th Cir. 2010) (granting writ where only first three *Bauman* factors were satisfied and challenged privilege ruling was “particularly injurious”).

Because the third and fifth elements—clear error as a matter of law raising new and important problems—are critical to this petition, we discuss them first.

A. The district court’s order is clearly erroneous as a matter of law and raises new and important problems of first impression for mandamus review.

The third and fifth *Bauman* factors are met here because the district court’s ruling not only misinterprets and misapplies the law, but throws a wrench into corporate internal investigations by undermining the confidentiality that the

Upjohn ruling was intended to protect. It does so by adopting a radically broadened version of the D.C. Circuit’s *Sealed Case* standard, which the Ninth Circuit and this Court have yet to address.

Under the third *Bauman* factor, when the Court of Appeals is “firmly convinced that a district court has erred in deciding a question of law, [it] may hold that the district court’s ruling is ‘clearly erroneous as a matter of law as that term is used in mandamus analysis.’” *Perry*, 591 F.3d at 1158. For all the reasons set forth below, the district court’s privilege rulings are clearly erroneous.

- 1. The district court erroneously held that a corporation must make a heightened showing that a communication from an employee to an in-house lawyer had a primarily legal purpose—even when both parties undisputedly were engaged in an *Upjohn*-type internal investigation.**

The district court relied on an erroneous legal standard to hold that Google had failed to establish “the first three prongs of the attorney-client privilege test, namely that the Lindholm Email constitutes a communication related to the purpose of obtaining legal advice from a legal advisor in his capacity as such.”⁴⁰ This erroneous standard infected its entire analysis and spawned additional legal errors, discussed below.

- a. Google proved that the Lindholm email was privileged under *Upjohn* and under Ninth Circuit precedents that treat in-house and outside counsel the same for privilege purposes.**

The lodestar for Google’s privilege claim is the Supreme Court’s landmark

⁴⁰ A39:18-21.

Upjohn decision, which established the importance of preserving the confidentiality of communications made between employees and in-house counsel during internal corporate investigations.

Upjohn involved communications generated in the course of a company's internal investigation of possible illegal payments to foreign governments. The company's chairman asked its general counsel to conduct the investigation; and the general counsel (after consulting with outside counsel) distributed a questionnaire to certain managers about the payments. *See* 449 U.S. at 386-87. The general counsel and outside counsel also interviewed those managers and other company officers and employees. *See id.* The IRS later began an investigation to determine the tax consequences of the questionable payments. The IRS demanded production of the completed questionnaires, memoranda, and interviews generated by the company's internal investigation. *See id.* at 387-88. The district court and court of appeals ordered disclosure. *See id.* at 388.

The Supreme Court reversed in a decision that recognized the importance of allowing both in-house counsel and outside counsel to communicate confidentially with low- and mid-level employees when investigating possible legal claims against the corporation. The Court held that the effectiveness of such investigations depends upon a broad attorney-client privilege, extending beyond the corporation's "control group" of top officers to embrace communications with

lower-level employees, who often possess the knowledge that an attorney needs in order to render sound legal advice. *See id.* at 388-97.

As the *Upjohn* court observed, the attorney-client privilege “recognizes that sound legal advice or advocacy serves public ends and that such advice or advocacy depends upon the lawyer’s being fully informed by the client.” 449 U.S. at 383. “The first step in the resolution of any legal problem is ascertaining the factual background and sifting through the facts with an eye to the legally relevant.” *Id.* at 390-91. The attorney-client privilege therefore “protect[s] not only the giving of professional advice to those who can act on it but also the giving of information to the lawyer to enable him to give sound and informed advice.” *Id.* at 390; *see also United States v. Chen*, 99 F.3d 1495, 1501 (9th Cir. 1996); *Admiral Ins.*, 881 F.2d at 1492-93.

Significantly, *Upjohn* involved communications with both in-house and outside counsel—and the decision drew no distinction between them for purposes of establishing privilege. In keeping with *Upjohn*’s teachings, the Ninth Circuit adheres to a general principle that, “[i]n determining the existence of a privilege, no attempt is made to distinguish between ‘inside’ and ‘outside’ counsel.” *United States v. Rowe*, 96 F.3d 1294, 1296 (9th Cir. 1996) (citation, brackets, and internal quotation marks omitted). “This position accords with the traditional view in the United States that no difference exists for professional or ethical purposes between an in-house counsel and an outside counsel.” Grace M. Giesel, *The Legal Advice*

Requirement of the Attorney-Client Privilege: A Special Problem for in-House Counsel and Outside Attorneys Representing Corporations, 48 Mercer L. Rev. 1169, 1207 (1997) [hereinafter, “*In-House Counsel*”].

The Ninth Circuit has rejected the contention—endorsed by the district court in this case—that in-house counsel are different from other lawyers for privilege purposes because they sometimes become involved in the corporation’s “business,” as opposed to its legal issues.⁴¹ Rather, the controlling question is whether the lawyer was employed to give legal advice based on his “knowledge and discretion in the law,” regardless of whether the subject of that advice is “criminal or civil, business, tort, domestic relations, or anything else.” *Chen*, 99 F.3d at 1501-02. When deciding this question, “[c]alling the lawyer’s advice ‘legal’ or ‘business’ advice does not help in reaching a conclusion; it *is* the conclusion. That the lawyers were ‘involved in business decision-making’ . . . is irrelevant.” *Id.* at 1502 (emphasis in original).⁴² “A client is entitled to hire a lawyer, and have his secrets kept, for legal advice regarding the client’s business

⁴¹ A42:9-18; A14:4-8.

⁴² Google does not rely on *Chen*’s additional holding that, “[i]f a person hires a lawyer for advice, there is a rebuttable presumption that the lawyer is hired ‘as such’ to give ‘legal advice[.]’” *Chen*, 99 F.3d at 1501. Some district-court cases interpret the *Chen* presumption as limited to the retention of outside counsel. *See, e.g., Lenz v. Universal Music Corp.*, C 07-3783 JF (RS), 2009 WL 3573990, at *2 (N.D. Cal. Oct. 30, 2009). The presumption aside, *Chen* bars reliance on an artificial “legal/business” distinction when determining whether the lawyer was acting “as such” when communicating with a client.

affairs.” *Id.* at 1501.⁴³

Under these principles, Google clearly made out its privilege claim. This was a classic *Upjohn* scenario in which corporate counsel (Ben Lee and Kent Walker) enlisted the help of lower-level employees (Tim Lindholm and Dan Grove) to investigate potential legal claims against the corporation. The fact that the Lindholm email refers to licensing as an alternative to litigation in no way suggests that Attorney Lee was not being consulted in his legal capacity. Indeed, no bright line can be drawn between IP litigation and license negotiations because licenses are a typical component of settlements involving an intellectual-property dispute. *See, e.g., Jacobs v. Nintendo of Am., Inc.*, 370 F.3d 1097, 1098-99 (Fed. Cir. 2004).⁴⁴

This case bears no resemblance to those in which the privilege has been held inapplicable because the lawyer was employed for “business” purposes, “without

⁴³ Accordingly, documents setting forth “economic or business data” may be privileged if they were created “for the purpose of receiving legal advice” and were “intended to be confidential.” *In re Brand Names Prescription Drugs Litig.*, No. 94 C 897, 1995 WL 557412, at *2 (N.D. Ill. Sept. 19, 1995). It is wrong to suppose that “economic or business information sent to an attorney can never fall under the protection of the attorney-client privilege.” *Id.* “In the context of the attorney-client privilege, documents prepared for the purpose of obtaining or rendering legal advice are protected even though the documents also reflect or include business issues.” *In re OM Secs. Litig.*, 226 F.R.D. 579, 587 (N.D. Ohio 2005); *see also Potter v. United States*, No. 02-CV-0632-H (POR), 2002 WL 31409613, at *4 (S.D. Cal. July 26, 2002); *Segerstrom v. United States*, No. C 00-0833 SI, 2001 WL 283805, at **2-5 (N.D. Cal. Feb. 6, 2001).

⁴⁴ *See also Hemstreet v. Spiegel, Inc.*, 851 F.2d 348, 349 (Fed. Cir. 1988); *Therasense, Inc. v. Becton, Dickinson & Co.*, C 04-02123 WHA, 2008 WL 2323856 (N.D. Cal. May 22, 2008) (Alsup, J).

‘reference to his knowledge and discretion in the law.’” *Chen*, 99 F.3d at 1502.

That conclusion may be justified, for example, “where a counterfeiter hired a man who was a lawyer to buy printing equipment for him,” or where the clients hired the attorney to find investment opportunities, *see id.* at 1501, or to provide valuation services. *See U.S. v. Ritchey*, 632 F.3d 559, 566-67 (9th Cir. 2011).

Here, by contrast, the uncontradicted evidence submitted by Google shows that Attorney Lee was tasked by Google General Counsel Kent Walker with overseeing an investigation of facts relating to Oracle’s infringement claims and threat of litigation—a quintessentially legal task calling upon Lee’s “knowledge and discretion in the law.”” *Id.* at 1502.

Accordingly, the Lindholm email was privileged, and only the district court’s clear errors of law—discussed below—allowed it hold otherwise.

b. The district court adopted a distorted version of the D.C. Circuit’s *Sealed Case* standard, which allowed it to rule based on unwarranted assumptions about in-house counsel instead of the undisputed evidence.

The district court cast the governing legal principles aside in holding that Google had failed to prove that the Lindholm email constitutes “a communication related to the purpose of obtaining legal advice from a legal advisor in his capacity as such.”⁴⁵ Instead, the district court adopted an erroneous and overbroad variant of the “clear showing” standard announced 27 years ago by the D.C. Circuit in *In*

⁴⁵ A39:18-21.

re Sealed Case, 737 F.2d 94. As applied by the district court, that standard erects a nearly insuperable obstacle to establishing that *Upjohn*-type communications involving in-house counsel are privileged.

In *Sealed Case*, a corporation asserted the right to instruct a grand-jury witness who had been the corporation's vice president, general counsel, and sole in-house attorney not to answer questions concerning some putatively privileged communications. *See* 737 F.2d at 96-97. The district court disagreed and granted most of the government's requests to compel the attorney to testify. *See id.* at 97.

On appeal, the D.C. Circuit affirmed as to some rulings and reversed as to others. The court observed that, because the attorney had been the company's vice president with "responsibilities outside the lawyer's sphere," the company had to make a "clear showing" that he had given his advice "in a professional legal capacity." *Id.* at 99. Notably, the D.C. Circuit stated that the mere fact that the attorney had served as an in-house counsel did *not* "alone . . . dilute the privilege." *Id.*

In this case, the district court went further by holding, in effect, that "the mere fact" that Lee served as an in-house counsel *did* "dilute the privilege," even though there was no evidence that Lee had any "responsibilities outside the lawyer's sphere." Citing a single district-court case that relied on *Sealed Case*,⁴⁶

⁴⁶ *United States v. ChevronTexaco Corp.*, 241 F. Supp. 2d 1065 (N.D. Cal. 2002).

the magistrate opined that “Lee’s role as in-house counsel warrants heightened scrutiny.”⁴⁷ She held that Google therefore was required to make “a ‘clear showing’” that the “‘primary purpose’ of the [Lindholm email] was securing *legal* advice”;⁴⁸ and she then concluded that “Google ha[d] made no such showing.”⁴⁹ The district judge (improperly)⁵⁰ deferred to the magistrate’s legal conclusions and applied the same test.⁵¹

The district court’s interpretation and use of the *Sealed Case* doctrine was prejudicial error, for three reasons.

First, the Ninth Circuit has never adopted *Sealed Case*. As discussed above, the Ninth Circuit takes a much more nuanced, case-specific approach to privilege claims involving in-house counsel. Under Ninth Circuit precedents, a court has to consider the actual evidence about what the lawyer was doing, rather than relying on unfounded assumptions about in-house counsel generally.

Second, the district court expanded the “clear showing” standard far beyond its original context (concerning communications with in-house counsel who are also corporate officers with non-legal duties) to cover communications with *all* in-house counsel. That was clear error. Even district courts in the D.C. Circuit

⁴⁷ A42.

⁴⁸ A42 (emphases in original; citations and brackets omitted).

⁴⁹ A42.

⁵⁰ See Part V.A.4., below.

⁵¹ A15:2-3.

(where *Sealed Case* governs)⁵² recognize that a different rule applies to ordinary in-house counsel: “There is a [rebuttable] presumption that a lawyer *in the legal department* or *working for the general counsel* is most often giving legal advice, while the opposite presumption applies to a lawyer . . . who works for . . . some other seemingly management or business side of the house.” *Boca Investering P’ship v. United States*, 31 F. Supp. 2d 9, 12 (D.D.C. 1998) (emphasis added).⁵³ Had that presumption been applied here, the Lindholm email should have been found privileged, because it is undisputed that Mr. Lee works for Google’s legal department and was directed by Google’s general counsel to conduct an *Upjohn*-type investigation of Oracle’s claims;⁵⁴ and there was no evidence that Lee had

⁵² Outside the D.C. Circuit, the *Sealed Case* standard has languished. No other federal appellate court has adopted it, and only a handful of district courts outside the D.C. Circuit have applied it.

⁵³ See also *United States v. KPMG LLP*, 237 F. Supp. 2d 35, 47 (D.D.C. 2002) (applying *Boca* presumption); *Wessel v. City of Albuquerque*, No. MISC 00–00532 ESH/AK, 2000 WL 1803818, at *5 (D.D.C. Nov. 30, 2000) (same).

⁵⁴ The district court made much of the fact that the Lindholm email indicates that Lindholm was performing some tasks requested by Google’s founders, Larry Page and Sergey Brin, rather than by its general counsel. The court appears to have believed that a legal investigation can be ordered and supervised *either* by top management *or* by the general counsel—but never by both. That assumption is incorrect and contradicted by the undisputed evidence of record. Leading cases on this subject involve facts where both top management and corporate counsel order and supervise the investigation—*e.g.*, where “senior management” instructed managers to give statements to the corporation’s counsel (*see Admiral Ins.*, 881 F.2d at 1493) or a board chairman asked general counsel to investigate corporate conduct by interviewing lower-level employees (*see Upjohn*, 449 U.S. at 387). And it stands to reason that top management would get involved in an investigation of multibillion-dollar claims by a large corporate adversary. Indeed, Mr. Lindholm’s declaration confirms that Google’s “top management” attended the

“responsibilities outside the lawyer’s sphere.” *Sealed Case*, 737 F.2d at 99.

Third, the district court’s expanded version of *Sealed Case* substitutes speculation and bias for evidence. A commentator points out that *Sealed Case* and similar district-court holdings are founded upon the “unsubstantiated and odd” assumptions that in-house counsel “abuse the privilege” and “do not render legal assistance.” *In-House Counsel* at 1208. But a survey of New York executives, law firm partners, in-house counsel, and judges revealed that outside attorneys give “business” advice at about the same frequency as do in-house attorneys who have no official nonlegal responsibilities. *Id.* at 1211. By relying on mere assumptions about the conduct and role of in-house lawyers, this expanded and misinterpreted *Sealed Case* doctrine excuses courts from carefully considering the evidence in the cases before them. That is both inappropriate and deeply corrosive of the privilege:

[C]ourts should not assume that abuse of the privilege is occurring in particular cases and should not assume that communications involving attorneys relate to or do not relate to legal advice, service, or assistance. Such assumptions are, at best, based on speculation and guessed probabilities. Courts should require all types of privilege claimants to prove that the privilege applies. Because of the nature of corporations, they may find doing so more difficult. A different standard of proof, however, seems inappropriate absent specific evidence of abuse or specific evidence of inapplicability of the privilege.

July 30, 2010 meeting where Oracle's infringement claims were discussed. A23 at ¶ 6.

In-House Counsel at 1216.

The district court's approach to privilege law creates new and important problems of first impression (thereby satisfying the fifth *Bauman* mandamus factor). Extending *Sealed Case* to all in-house lawyers introduces substantial uncertainty as to whether the privilege will apply to any given communication generated by an *Upjohn*-type internal corporate investigation. The *Upjohn* court sought to facilitate corporate internal investigations by guaranteeing that the extensive attorney-client communications they generate will remain confidential. As the *Upjohn* court observed, “[a]n uncertain privilege, or one which purports to be certain but results in widely varying applications by the courts, is little better than no privilege at all.” 449 U.S. at 393.

The district court's approach returns corporate privilege law to its uncertain, pre-*Upjohn* state. Corporate counsel and employees will have to worry again about whether some future reviewing court will view each and every communication generated by the investigation as having the “primary purpose” of obtaining legal advice. The resulting uncertainty as to the scope or applicability of the attorney-client privilege will chill internal investigations by making in-house lawyers reluctant to reach out to lower-level employees for fear that one of those employees will respond with a privilege-destroying email or memo. The quality of legal advice to corporate clients will decline; for it is “only natural that [low- and mid-level] employees would have the relevant information needed by corporate

counsel if he is adequately to advise the [corporate] client” *Id.* at 391.

1. The district court’s expanded *Sealed Case* standard led it into additional legal errors.

The district court’s misinterpretation of the *Sealed Case* standard—which substitutes assumptions about in-house counsel for case-specific facts—led the court into two additional legal errors, which we briefly address.

First, the district court held, in effect, that unless the face of the allegedly privileged document furnishes a “clear showing” that its “primary purpose” was to secure legal advice, the privilege claim fails—even if the privilege proponent submits credible and undisputed extrinsic evidence that the document relates to an *Upjohn* investigation, and even if the document itself is not facially inconsistent with that evidence.

That approach was clearly erroneous as a matter of law. There is no requirement that a document expressly request or refer to legal advice in order to qualify as privileged. “Client communications intended to keep the attorney apprised of continuing business developments, with an implied request for legal advice based thereon . . . may also be protected.” *Hercules, Inc. v. Exxon Corp.*, 434 F. Supp. 136, 144, 196 U.S.P.Q. 401 (D. Del. 1977). And courts do *not* confine themselves to the face of the allegedly privileged document when making privilege determinations; they also consider extrinsic evidence of the document’s context. For example, in *Barton v. United States District Court*, 410 F.3d 1104

(9th Cir. 2005), the Ninth Circuit granted a writ of mandamus to prevent disclosure of interview questionnaires that potential plaintiffs had submitted to class-action lawyers. In so doing, the court weighed such extrinsic evidence as “the context of supplying information to lawyers who apparently were bringing a Paxil class action,” “the ultimate representation of these four plaintiffs,” and the law firm’s statements about its purpose for distributing the questionnaires. *Id.* at 1110. Likewise, the Tenth Circuit upheld a claim of privilege based on an in-house lawyer’s declaration that he “did not render business advice” when he prepared a facially business-oriented document (a list of employees slated for termination). *See Motley v. Marathon Oil Co.*, 71 F.3d 1547, 1550-51 (10th Cir. 1995).

Second, apparently extending its harsh “clear showing” standard to matters of evidentiary foundation, the district court dismissed Attorney Lee’s declaration in its entirety because he did not expressly state: “I read the Lindholm email.” The district court therefore concluded that he lacked personal knowledge of what the email said or how it related to Google’s *Upjohn*-type investigation. But the Ninth Circuit has held that personal knowledge and competence to testify may be “reasonably inferred” from an affiant’s “positio[n] and the nature of [his] participation in the matters to which [he] swore.” *Barthelemy v. Air Lines Pilots Ass’n*, 897 F.2d 999, 1018 (9th Cir. 1990); *see also In re Kaypro*, 218 F.3d 1070, 1075 (9th Cir. 2000). Lee declared under oath that he was one of the recipients of the Lindholm email; that he supervised Mr. Lindholm’s work on the investigation

discussed in the email; and that that he could competently testify to the circumstances under which the email was created.⁵⁵ It was simply wrong to hold that his declaration could not be considered because he failed to say the magic words, “I read it.” This requirement, too, apparently flows from the “clear showing” standard.

2. The district court erroneously denied work-product protection to the Lindholm email.

“The work product doctrine extends beyond confidential communications between the attorney and client to ‘any document prepared in anticipation of litigation by *or for* the attorney.’” *United States v. Bergonzi*, 216 F.R.D. 487, 494-95 (N.D. Cal. 2003) (emphasis added) (quoting *In re Columbia/HCA Healthcare Billing Practices Litig.*, 293 F.3d 289, 304 (6th Cir. 2002)). The Lindholm email is exactly that—a document prepared in anticipation of Oracle’s lawsuit for Google attorney Ben Lee, among others. But the district court denied the Lindholm email work-product protection for the same reasons it denied attorney-client privilege protection.⁵⁶ That ruling, too, was clearly erroneous as a matter of law.

3. The district court clearly erred by deferring to the magistrate’s erroneous legal conclusions, in violation of Rule 72(a).

The district court clearly erred by deferring to the magistrate’s erroneous legal conclusions, thereby violating the *de novo* standard of review mandated by

⁵⁵ A20-A21 at ¶¶ 4, 8-10.

⁵⁶ A43:15-:21; A17:4-8.

Federal Rule of Civil Procedure 72(a). Rule 72(a) governs objections to a magistrate’s nondispositive pretrial order and states that “[t]he district judge in the case must consider timely objections and modify or set aside any part of the order that is *clearly erroneous* or is *contrary to law*.”⁵⁷

Because the disjunctive term “or” connects the term “clearly erroneous” with the term “contrary to law,” those terms must have different meanings. *See Holly Farms Corp. v. N.L.R.B.*, 517 U.S. 392, 413 (1996). And they do. “Clearly erroneous” echoes the general Rule 52(a) standard for reviewing findings of fact made after bench trials, while “contrary to law” echoes the *de novo* standard for reviewing legal conclusions reached after bench trials. *See generally Navajo Nation v. United States Forest Serv.*, 535 F.3d 1058, 1067 (9th Cir. 2008) (en banc). Accordingly, courts overwhelmingly hold that that, “[w]hen . . . review of a non-dispositive motion by a district judge turns on a pure question of law, that review is *plenary* under the ‘contrary to law’ branch of the Rule 72(a) standard.” *PowerShare, Inc. v. Syntel, Inc.*, 597 F.3d 10, 14-15 (1st Cir. 2010) (emphasis added). Accordingly, “[t]he Magistrate’s legal conclusions are reviewed *de novo* to determine whether they are contrary to law.” *Perry v. Schwarzenegger*, 268 F.R.D. 344, 348 (N.D. Cal. 2010).⁵⁸

⁵⁷ Emphases added.

⁵⁸ *See also Brownlow v. Gen. Motors Corp.*, CIV. A. 3:05CV-414-R, 2007 WL 2712925, at *4 (W.D. Ky. Sept. 13, 2007); *Computer Econ., Inc. v. Gartner Group, Inc.*, 50 F. Supp. 2d 980, 983 (S.D. Cal. 1999); *Milwaukee Carpenter’s*

Here, however, the district court erased any distinction between Rule 72(a)'s "clearly erroneous" and "contrary to law" standards by deferring not only to the magistrate's factfinding but also to her legal conclusions. Ninth Circuit law, by contrast, holds generally that the existence and scope of the attorney-client privilege is reviewed de novo. *See United States v. Ruehle*, 583 F.3d 600, 606 (9th Cir. 2009) (citation omitted). The district court's deference on matters of law was prejudicial to Google, because it effectively sheltered the magistrate's erroneous legal conclusions from Rule 72 review.

B. The remaining mandamus factors are satisfied as well.

1. Google has no other means, such as an appeal, to obtain the desired relief.

The first *Bauman* factor is satisfied where, as here, the petitioner seeks review of a district court's order compelling production of an allegedly privileged communication. *See Admiral Ins. Co.*, 881 F.2d at 1491.

2. Google will be damaged or prejudiced in ways not correctable on appeal.

The second *Bauman* factor also is satisfied. Mandamus is proper to prevent the irreparable harm likely to result from the erroneously compelled disclosure of privileged communications. *Admiral Ins.*, 881 F.2d at 1491.

Dist. Council Health Fund v. Philip Morris, Inc., 70 F. Supp. 2d 888, 892 (E.D. Wis. 1999); *Med. Imaging Ctrs. of Am., Inc. v. Lichtenstein*, 917 F. Supp. 717, 719 (S.D. Cal. 1996); 12 Wright & Miller, *Federal Practice & Procedure* § 3069, at 350 (2d ed. 1997) (observing that Rule 72(a)'s phrase "'contrary to law' indicates plenary review as to matters of law").

Oracle may argue that Google cannot satisfy this factor because it already has complied with the district court’s order to produce the documents (albeit stamped with large privilege legends,⁵⁹ and subject to a written reservation of clawback rights). That argument fails. If the Lindholm email is stripped of privilege, it may be shown to the jury. In that event, Oracle intends to use the document to suggest that Mr. Lindholm conducted an infringement analysis and concluded that Google was in the wrong.⁶⁰ Although that is untrue,⁶¹ the email cannot be properly explained without disclosing the nature of Google’s internal investigation and of Mr. Lindholm’s role in it. Google therefore will be confronted with a choice of failing to explain a facially prejudicial document, or explaining it and thereby risking a broad subject-matter waiver that never can be undone—even if the case is retried after an appeal.⁶²

VI. Conclusion

This Court should direct the district court to grant the relief requested in Part I, above.

⁵⁹ The district court now has ordered the legends removed. *See* Dkt. 596.

⁶⁰ Oracle has filed a “motion in limine,” based on the Lindholm email, to preclude Google from disputing that Lindholm investigated Java and all alternatives to Java and that Google needed a license for Java and the patents-in-suit. A91.

⁶¹ *See* A34 at ¶ 4.

⁶² Adding to the prejudice, the district court has refused to grant Google’s requests to seal transcripts and documents that reference the Lindholm email. Indeed, the court quoted the entire final email in its order and then refused to seal the order. The Supreme Court has noted that “protective orders are available to limit the spillover effects of disclosing sensitive information.” *Mohawk Indus.*, 130 S. Ct. at 608.

Dated: November 4, 2011

Respectfully submitted,

KEKER & VAN NEST LLP

By: 

ROBERT A. VAN NEST

Attorneys for Petitioner
GOOGLE INC.

CERTIFICATE OF SERVICE

**United States Court of Appeals
for the Federal Circuit**

No. _____

-----)
IN RE GOOGLE INC.
Petitioner,
-----)

I, John C. Kruesi, Jr., being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

Counsel Press was retained by KEKER & VAN NEST LLP, Attorneys for Petitioner to print this document. I am an employee of Counsel Press.

On the **4th Day of November, 2011**, I served the within **Petition for Writ of Mandamus** upon:

David Boies
Boies Schiller & Flexner LLP
333 Main Street
Armonk, NY 10504
914-749-8201
Fax: 914-749-8300
Email: dboies@bsflp.com
Attorneys for Plaintiff
ORACLE AMERICA. INC.

Michael A. Jacobs
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304
650-813-5600
Fax: 650-494-0792
Email: mjacobs@mofo.com
Attorneys for Plaintiff
ORACLE AMERICA, INC.

The Honorable William Alsup
United States District Court
Northern District of California
450 Golden Gate Avenue
San Francisco, CA 94102
(overnight only)

Magistrate Judge Donna M. Ryu
United States District Court
Northern District of California
1301 Clay Street
Oakland, CA 94612
(overnight only)

via Federal Express and Email, by causing 2 true copies of each to be deposited, enclosed in a properly addressed wrapper, in an official depository of FedEx.

Unless otherwise noted, 5 copies have been hand-delivered to the Court on the same date as above.

November 4, 2011

