

Miscellaneous No. 106

United States Court of Appeals
for the
Federal Circuit

IN RE GOOGLE INC.,

Petitioner,

*On Petition for Writ of Mandamus to the United States District Court
for the Northern District of California in case no. 10-CV-3561,
Judge William H. Alsup.*

**RESPONSE IN OPPOSITION TO PETITION
FOR MANDAMUS**

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NOVEMBER 28, 2011

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NOVEMBER 28, 2011

FORM 9. Certificate of Interest

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

In re Google Inc. _____ v. _____

Misc. No. 106

CERTIFICATE OF INTEREST

Counsel for the (petitioner) (appellant) (respondent) (appellee) (amicus) (name of party) Oracle America, Inc. _____ certifies the following (use "None" if applicable; use extra sheets if necessary):

1. The full name of every party or amicus represented by me is:

Oracle America, Inc.

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

Oracle America, Inc.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

Oracle Corporation

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

Please see Attachment A.

11-28-2011
Date

Fred Norton
Signature of counsel
Fred Norton
Printed name of counsel

Please Note: All questions must be answered
cc: _____

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

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I. Introduction

Google's petition for mandamus arises from its repeated, unsuccessful efforts to conceal an email that Google engineer Tim Lindholm wrote to Google business executive (and non-lawyer) Andy Rubin in August 2010, shortly before this lawsuit was filed.

In that email, Mr. Lindholm told Mr. Rubin that he had been asked by Google founders (and non-lawyers) Larry Page and Sergey Brin to "investigate what technical alternatives exist to Java" for Google's Android and Chrome. Mr. Lindholm reported to Mr. Rubin that the "technical alternatives" to Java "all suck" and that consequently "we need to negotiate a license for Java under the terms we need." Mr. Lindholm also recommended that, as a negotiation strategy, Google should make the "threat" of using the "most credible alternative" in order to obtain a Java license from Oracle at "better terms and price," while asking Mr. Rubin whether this strategy was a "nonstarter for negotiation purposes."

After careful review of the email itself, as well as all of the other evidence submitted by the parties, the Magistrate Judge below found that "the contents of the email itself severely undermine" Google's claim of privilege. As the Magistrate Judge also found, nowhere does the email text mention lawyers or legal advice, nor does it seek input from lawyers or legal advice. Rather, the facts established by the email indicate that it is "a business discussion," not a "proffering

of research for an attorney preparing legal advice.” The Magistrate Judge further found that “[n]othing in the content of the Email indicates that Lindholm prepared it in anticipation of litigation or to further the provision of legal advice.” The Magistrate Judge gave Google leave to file as many declarations as it wanted, but she found, and the District Court affirmed, that the declarations Google offered suffered from numerous gaps that failed to rebut the plain meaning of the email itself. Accordingly, the Magistrate Judge found, and the District Court affirmed, that Google failed to prove that the engineer’s email to the business executive was a privileged communication or attorney work product.

Google now seeks to evade those factual findings through this petition for mandamus. The petition should be denied for at least five reasons.

First, the Magistrate Judge’s and District Court’s orders do not “undermine” *Upjohn Co. v. United States*, as Google now contends. Rather, the Magistrate Judge reviewed all of the evidence, including the email itself, and made the factual finding that Google “failed to meet its burden of *showing* that the Lindholm email was generated in a privileged scenario, whether of the type described in *Upjohn* or otherwise.” Although the Magistrate Judge specifically found that the email’s contents “severely undermine” the claim of privilege, Google never addressed those contents in any of its briefs or declarations, and still has not done so now.

Second, Google has failed to identify any error, much less the “clear error” it must establish to win mandamus relief. There was no error in requiring Google to make a “clear showing” that the Lindholm email was a privileged communication. That is the rule of now-Justice Ginsburg’s opinion for the D.C. Circuit in *In re Sealed Case*, 737 F.2d 94 (D.C. Cir. 1984) – a rule that has never been criticized, much less rejected, by any federal Court of Appeals; that has been applied repeatedly by district courts in nine circuits, including the Ninth Circuit; and that has been acknowledged by this Court in rejecting a mandamus petition arising out of the Ninth Circuit. *In re Diagnostics Systems Corp.*, 328 F. App’x 621, 622-23 (Fed. Cir. 2008). That rule does not rest on an “unwarranted distrust” of in-house counsel, as Google protests; it rests on the practical reality that in-house lawyers are frequently included on business communications that do not seek or provide legal advice. To *defy* such a rule would be clear error; to adhere to it is not.

There also was no error in the District Court’s review of the Magistrate Judge’s order. The District Court repeatedly quoted and applied the Rule 72(a) standard – “clearly erroneous or contrary to law” – throughout its analysis. Although Google’s statement of issues asserts that the District Court “deferred to the legal conclusions of the magistrate judge,” nowhere in its brief does Google identify any instance where the Court actually did so. In fact, the District Court

expressly noted that a “non-dispositive order entered by a magistrate must be deferred to *unless* it is ‘clearly erroneous or contrary to law.’” (emphasis added)

Third, even if there were some error – and there is none – Google has not established, as it must, that it is “clear and indisputable” that mandamus should issue. Specifically, there is no basis to conclude that, under some standard other than the “clear showing” rule, the Magistrate Judge or the District Court would have been compelled to find the Lindholm email privileged on the full evidentiary record presented below. To the contrary, the District Court found that *even if the “clear showing” rule did not apply*, and Google were entitled to a presumption that in-house counsel are most often giving legal advice, the evidence cited by the Magistrate Judge would rebut that presumption. Google still would lose.

Fourth, mandamus is not appropriate when disclosure has already occurred. The Magistrate Judge ordered Google to produce the document, and Google complied. The document’s full text has been published in a public order, available on Westlaw, on the internet, and in the press. Google’s petition would not prevent disclosure; it would only prevent Oracle from using the document as one of many pieces of evidence at trial. That is not a proper basis for mandamus relief.

Fifth, Google did not give this Court the full record necessary to resolve the privilege issue, nor has any court yet reached Oracle’s waiver argument. Thus, this

Court cannot grant Google the relief it seeks: to hold that the Lindholm email is privileged, compel its return, and seal all court documents “referencing” it.

Google’s petition for a writ of mandamus should be denied.

II. Statement of Facts

Google’s petition challenges a non-dispositive order of a Magistrate Judge, which it concedes is subject to review under the “clearly erroneous or contrary to law” standard of Federal Rule of Civil Procedure 72(a). (Petition, 28) The Magistrate Judge made numerous, specific findings of fact adverse to Google, which were all affirmed by the District Court, and which Google does not directly challenge. Nonetheless, Google ignores those adverse findings, and instead advances a self-serving and incomplete recitation of the facts that was rejected on the record established below. At the same time, Google has submitted an appendix that omits one of its own declarations; includes only a few lines of the transcript of the hearing before the Magistrate Judge (A84-A90); includes a declaration Google submitted on a different motion *after* the Magistrate Judge had ruled (A33-A45); and omits all of the evidence that Oracle submitted and was considered in the proceedings below. The petition thus ignores the proper standard of review and fails to comply with Federal Rule of Appellate Procedure 21(a)(2)(C). Without assuming Google’s burden to provide this Court with the necessary record, Oracle submits the following statement of facts and attached supplemental appendix.

A. The text of the Lindholm email proves it is a business communication, not a request for legal advice.

On July 20, 2010, Oracle lawyers made a presentation to Google, asserting that Google's Android smartphone platform infringed specific patents related to Java. No one mentioned Chrome. (A173, ¶¶3-5) About two weeks later, on August 6, 2010, Google engineer Tim Lindholm sent an email to Google Vice President Andy Rubin, a non-lawyer in charge of Android. Mr. Lindholm had been a Sun Microsystems¹ engineer working on Java until July 2005, when he joined Google. At Google, Mr. Lindholm immediately began advising Mr. Rubin about Android, negotiating unsuccessfully with his former Sun colleagues for a Java license, and evaluating alternatives to Java for use in Android. (A132, ¶ 11; A144-A162) On behalf of himself and another Google engineer, Dan Grove, this is what Mr. Lindholm wrote in his August 6, 2010 email:

Hi Andy,

This is a short pre-read for the call at 12:30. In Dan's earlier email we didn't give you a lot of context, looking for the visceral reaction that we got.

What we've actually been asked to do (by Larry and Sergei) is to investigate what technical alternatives exist to Java for Android and Chrome. We've been over a bunch of these, and think they all suck. We conclude that we need to negotiate a license for Java under the terms we need.

¹ In 2010, Oracle acquired Sun Microsystems, Inc. and along with it, the Java patents and copyrights at issue.

That said, Alan Eustace said that the threat of moving off Java hit Safra Katz hard. We think there is value in the negotiation to put forward our most credible alternative, the goal being to get better terms and price for Java.

It looks to us that Obj-C provides the most credible alternative in this context, which should not be confused with us thinking we should make the change. What we're looking for from you is the reasons why you hate this idea, whether you think it's a nonstarter for negotiation purposes, and whether you think there's anything we've missed in our understanding of the option.

-- Tim and Dan

(A6:1-15) After he wrote the entire email, at literally the last moment, Mr. Lindholm added the words "Google Confidential" and "Attorney Work Product" at the top of the page, and added Ben Lee, a Google in-house lawyer, to the email's addressees. (A17-18; A197-A207)

As the Magistrate Judge found, the text of the email makes no reference, express or implied, to litigation, infringement, lawyers, or legal advice. (A41:3-5) Three of the four paragraphs refer to negotiation, and in particular, Google's business strategy in negotiating for a Java license. The facts considered by Mr. Lindholm are in no way legal or even inputs to providing legal advice, as the Magistrate Judge found. (A40:21-22; A207)

Indeed, as the Magistrate Judge noted, *every substantive sentence of the email* refers to a business or technical consideration, never a legal one. (A37:8-17; A40:21-A41:14) Google founders "Larry and Sergei," not any lawyer, gave Mr. Lindholm the task described in the email, which was to "to investigate what

technical alternatives exist to Java for Android and Chrome,” not evaluate claims of infringement or assist with legal analysis. His conclusion that the technical alternatives “all suck” was that of an engineer assessing business options; his conclusion that “we need to negotiate a license for Java under the terms we need” recognized the business consequences of having no viable alternatives to Java. Mr. Lindholm’s repetition of a statement by Alan Eustace (a non-lawyer Google executive) that “the threat of moving off Java hit [Oracle President] Safra Katz hard” focused on the business executives involved in the negotiation, not any lawyer, and the leverage of threatening to walk away from a business negotiation. Mr. Lindholm recommended that Google put forward its “most credible alternative” to “get better terms and price for Java,” not to obtain any litigation advantage. He then proposed that the “most credible alternative” to threaten was a move to Objective-C instead of Java. Finally, he asked Mr. Rubin to comment on that strategy, including whether Mr. Rubin believed that the tactic was “a nonstarter for negotiation purposes.”

The Magistrate Judge expressly relied on what Mr. Lindholm had written in finding that “the Email appears to be a strategy discussion intended to address business negotiations regarding a Java license.” (A41:12-13) “Nothing in the content of the Email indicates that Lindholm prepared it in anticipation of litigation or to further the provision of legal advice.” (A40:21-22) The email text appears to

be “a business discussion,” not a “proffering of research for an attorney preparing legal advice.” (A41:3-7) Accordingly, the Magistrate Judge found that that “the contents of the email itself *severely undermine* the claim that Lindholm generated this particular email as part of an attorney-directed effort to provide legal advice or prepare for litigation.” (A40:5-7 (emphasis added)) The District Court in turn affirmed these factual determinations as “true,” and rejected Google’s assertions that they were clearly erroneous. (A10:15-26)

B. Google did not rebut the facts established by the text of the email.

Just as it did in the proceedings below, Google ignores every single one of the statements Mr. Lindholm wrote in his email.

In support of its privilege claim, Google submitted declarations from Mr. Lindholm and former Google in-house lawyer Ben Lee, none of which makes any reference to the words, facts, or persons described in the email. The declarations from Mr. Lindholm and Mr. Lee assert, in conclusory fashion, that Mr. Lindholm was reporting on investigations that he and Dan Grove (another Google engineer) conducted “at the request of Google General Counsel Kent Walker, under the supervision of Mr. Lee, and in anticipation of Oracle’s threatened lawsuit.” (A25

at ¶ 14) Google incorrectly suggests that the Magistrate Judge found those declarations credible.² (Petition, 10)

In its briefing below and before this Court, Google limits its discussion of the evidence to events around the time of the email, ignoring the specifics of the document itself. Google emphasizes that Oracle had threatened suit over Android’s infringement of Java patents, that Mr. Lindholm was gathering “information for Google’s lawyers and management to consider in evaluating technology issues related to Oracle’s infringement claims” (A23, at ¶ 7), and that the email concerns Java and Android, the technology at issue in those claims. Google says these facts establish that it was engaged in “an *Upjohn*-type internal investigation.” But Google did not persuade the Magistrate Judge or the District Court that the email Mr. Lindholm actually wrote on August 6, 2010, was in furtherance of such an investigation, as opposed to what the words of the email reveal it to be: “a strategy discussion intended to address business negotiations regarding a Java license.” (A41:12-13)

² The Magistrate Judge merely observed – at the hearing – that “*I don’t need to reach the question* of whether somebody is not credible or is lying, or anything like that.” (A180, at 24:17-19 (emphasis added)). Her actual written finding in the Order – that the “contents of the email itself severely undermine the claim” of privilege – must be credited over any contention that Google’s declarations credibly established that the email was for the purpose of seeking legal advice, or prepared in anticipation of litigation.

In particular, the Magistrate Judge found that “there are many basic gaps in the factual record that Google failed to fill, despite having had ample opportunity to do so.” (A40:7-8) For example, the Magistrate Judge made the following findings, each of which was expressly affirmed by the District Court:

- Google had “no rejoinder” to the “central facts” that the email is directed to Mr. Rubin, not Mr. Walker or Mr. Lee, or any other lawyer; and that it expressly states that Mr. Page and Mr. Brin, not a lawyer, instructed Lindholm to investigate technical alternatives to Java. (A40:21-41:2; *affirmed*, A9:17-10:9)
- The Lindholm and Lee declarations failed to foreclose “the reasonable explanation” that in August 2010 they were also communicating about non-privileged matters, “including the business of negotiating for a Java license.” (A40:11-16; *affirmed*, A12:1-13:4)
- Neither Mr. Lee nor Mr. Lindholm asserted that Mr. Rubin, Mr. Page or Mr. Brin was involved in the supposed efforts to formulate legal advice, or explained “why these individuals feature so prominently in the email.” (A40:22-25; *affirmed*, A13:5-14:2)
- The declaration of Mr. Lee, a former Google employee, “did not indicate that he reviewed the Email and could competently represent it was connected to work he requested from Lindholm as part of the provision of legal advice.” (A40:8-11; *affirmed*, A11:9-28)
- The email refers to investigation of alternatives to Java for Google’s Chrome product, not just Android, despite the fact that Chrome was not mentioned at the July 20, 2010, meeting and has played no role in this litigation. (A41:7-10; *affirmed*, A10:25-28; A9:12-15)

In an effort to refute the plain meaning of the email, Google asserts that “Mr. Lindholm also declares that his email *did not* contain ‘general business advice about Android.’”³ Even assuming Mr. Lindholm could credibly claim his email

³ Petition, 8, citing A31-32 at ¶ 7. Mr. Lindholm’s actual, somewhat fuzzier claim was that he “was not intending to give general business advice to anyone in connection with Android’s ongoing business operations.” A31-32 at ¶ 7.

contained no business advice – and he cannot – his conclusory statement does not preclude the finding that he gave Mr. Rubin specific advice about “technical alternatives to Java” and business strategies for negotiating for a Java license. The District Court specifically considered, and rejected, Google’s contention that Mr. Lindholm had foreclosed any non-privileged purpose for his email. (A12:24-13:2)

C. Google’s own lawyers understood that the email concerned business negotiations and an investigation requested by business executives– and said so to the Court.

Before Google asserted privilege, the substance of the email was discussed at two hearings in this case held on July 21, 2011: first, at a telephonic discovery hearing before the Magistrate Judge in which Oracle sought to compel Mr. Lindholm’s deposition, and then at a *Daubert* hearing before the District Court later that same day. At the discovery hearing, Google was represented by four outside lawyers and one in-house counsel. (A135, ¶ 18) At the *Daubert* hearing, Google again was represented by three of those same outside lawyers, and two in-house lawyers, including the in-house lawyer who had appeared at the discovery hearing. (A137, ¶ 27).

At each of the hearings, before discussing the document’s contents, Oracle’s counsel indicated that Google had designated the document as “Attorneys’ Eyes Only.” (A105:5-13; A112:19-A113:18; A135-A138, ¶¶ 17-37) Google claims that by using the documents, Oracle “willfully violated the protective order.” (Petition, 9) That claim is false. Both the District Court and the Magistrate Judge rejected it

each time Google raised it. No Google lawyer at the hearing objected to the email's disclosure; no Google lawyer asserted that the document was privileged. To the contrary, Google's trial counsel argued the substance of the email. Google's counsel argued that the email did not show willful infringement, but concerned "negotiations" and that Mr. Lindholm was responding to a "question from the CEO." (A121:18-A122:10; A138:5-18)⁴ The in-court discussion of the email was widely reported in the press, and the District Court published much of the email in a July 22 order, before Google claimed privilege. (A141, ¶¶ 46-47)

D. The Magistrate Judge and District Court properly compelled production of the email after a thorough review of the evidence.

The day after the hearing, Google clawed back all versions of the Lindholm email. Oracle complied with the clawback demand, and promptly moved to compel the document's production on the grounds that the email was not privileged, and, alternatively, that Google had waived any otherwise applicable privilege by deliberately producing the Lindholm email, failing to object to its use at two separate court hearings, and arguing the email's substance at those two hearings. (A:73-A78; A130-A143) The Magistrate Judge directed Google to submit the email for *in camera* review, and allowed both parties to submit as many declarations as they wished, as well as additional declarations in response. (A126)

⁴ Google has never disclaimed these representations to the Court. Instead, it has argued in its briefs that its trial counsel were "taken by surprise" by the use of the Lindholm email at the hearing. (Petition, 10) The District Court properly rejected that claim as lacking any evidentiary basis. (A15:18-19)

After argument and consideration of all the evidence, the Magistrate Judge held that the email was not privileged and was not subject to the work product doctrine, making the waiver issue moot. (A36-A44). Google was ordered to produce the email back to Oracle, and it immediately did so.

Google then objected to the Magistrate Judge's order, and the District Court allowed full briefing and yet another oral argument. In overruling Google's objections, the District Court cited Ninth Circuit law that a "non-dispositive order entered by a magistrate must be deferred to *unless* it is 'clearly erroneous or contrary to law.'" (A8:4-5 (quoting *Grimes v. City and Cty. of San Francisco*, 951 F.2d 236, 241 (9th Cir. 1991) (emphasis added))). The Court then carefully considered each of Google's objections, and affirmed the order in its entirety.

The District Court specifically rejected Google's argument that the "clear showing" rule *Sealed Case* is contrary to the law of the Ninth Circuit, holding that no Ninth Circuit decision had addressed the issue, but that "the rule adopted by now Justice Ginsburg . . . makes considerable sense and addresses real world practices." (A14:9-A15:3 & n.4) The District Court then considered Google's argument that, under the "clear showing" rule, there is a "rebuttable presumption that in-house counsel are most often giving legal advice" when the attorney is in the legal department or general counsel's office. The District Court found that such a presumption would not make any difference, as the Magistrate Judge's order "cited sufficient record evidence to rebut any such presumption." (A15:4-7)

The District Court also considered and rejected Google’s argument that the Magistrate Judge’s order was contrary to *Upjohn*. The Court acknowledged the need for corporate counsel to communicate freely with employees to provide legal advice, but noted that “the privilege protecting such communications must be shown to apply before it can be invoked as to a particular document.” (A16:12-15) In this case, Google “failed to meet its burden of *showing* that the Lindholm email was generated in a privileged scenario, whether of the type described in *Upjohn* or otherwise.” (A16:16-17 (emphasis in original))

III. Argument

Google’s burden is a heavy one. Mandamus is a “drastic” remedy, “to be invoked only in extraordinary circumstances.” *Allied Chem. Corp. v. Daiiflon, Inc.*, 449 U.S. 33, 34 (1980). Google must show that there is no other way to obtain the relief it seeks and that its right to issuance of a writ is “clear and indisputable.” *Id.* at 35. Google cannot meet that burden if a “rational and substantial legal argument can be made in support of the rule in question.” *In re Cordis Corp.*, 769 F.2d 733, 737 (Fed. Cir. 1985).⁵ This burden is particularly heavy where, as here, the challenged order rests on factual determinations that may be set aside – even on direct appeal – only on a showing of clear error. *See* FED. R. CIV. P. 72(a).

⁵ Google argues that the Ninth Circuit’s five-factor *Baumann* test applies here. It does not. “A request for mandamus relief is determined under Federal Circuit law, except to the extent that underlying procedural issues may be governed by the law of the regional circuit” *In re Shared Memory Graphics LLC*, ___ F.3d ___, 2011 WL 4390020, at *3 (Fed. Cir. Sept. 22, 2011).

A. Google cannot establish the required “clear and indisputable right to relief” because the orders of the Magistrate Judge and District Court are correct under Supreme Court and Ninth Circuit precedent.

Google argues that the Magistrate Judge’s and the District Court’s orders are “clearly erroneous as a matter of law” because their application of the clear showing rule of *Sealed Case* would undermine *Upjohn Co. v. United States*, 449 U.S. 383 (1980) and Ninth Circuit precedent. Google is wrong.

1. Google did not prove that the Lindholm email is privileged under *Upjohn* or Ninth Circuit law.

Google’s argument centers on the holding of *Upjohn*, and as a result, Google misses the point.⁶ The Magistrate Judge, the District Court, and Oracle all agree that a communication from an employee to an in-house lawyer for the purpose of obtaining legal advice from the lawyer is subject to the attorney-client privilege. As the District Court found, however, Google “failed to meet its burden of *showing* that the Lindholm email was generated in a privileged scenario, whether of the type described in *Upjohn* or otherwise.” (A16:16-18). Google’s own cited case reinforces the point:

Prior to *Upjohn*, in claiming the protection of the attorney-client privilege the corporation had the burden of showing that the communication was made for the purpose of securing *legal* advice. Where the attorney was asked for business (as opposed to legal) counsel, no privilege attached. *Upjohn* did not eliminate this distinction.

⁶ Google never cited *Upjohn* to the Magistrate Judge, in its briefs or at oral argument. (A16:7-8; A78-83; A175-182)

United States v. Rowe, 96 F.3d 1294, 1297 (9th Cir. 1996) (internal citations and alterations omitted; emphasis in original). Google cannot meet its burden of establishing attorney-client privilege by simply claiming that there was an “*Upjohn*-type internal investigation.” It must show that the claimed privileged communication was made primarily for the purpose of obtaining legal advice – a showing that it simply could not make for this email, for the reasons detailed in the Magistrate Judge’s and the District Court’s orders. (A8:12-A10:12; A16:9-20; A39:15-44:2) *See United States v. Richey*, 632 F.3d 559, 566 (9th Cir. 2011) (setting out required elements of privilege claim); *Griffith v. Davis*, 161 F.R.D. 687, 697 (C.D. Cal. 1995) (party asserting attorney-client privilege must prove that all of the communications it seeks to protect were made “**primarily** for the purpose of generating legal advice”) (emphasis in original).

The cases Google cites do not help it – indeed, they only demonstrate further that Mr. Lindholm’s email did not seek legal advice as courts apply that requirement. Google argues that the “controlling question is whether the lawyer was employed to give legal advice based on his ‘knowledge and discretion in the law,’” (Petition, 17) yet Google has never offered any evidence or argument that the **actual information** contained in Mr. Lindholm’s email called upon Mr. Lee’s

“knowledge and discretion in the law” in any way. Indeed, Mr. Lindholm’s email asks for Mr. Rubin’s thoughts, but does not ask Mr. Lee to do anything at all.⁷

In each of the cases Google cites, *lawyers* were giving “*legal* advice regarding the client’s business affairs.” *United States v. Chen*, 99 F.3d 1495, 1501 (9th Cir. 1996) (emphasis added). For example, in *Upjohn*, company lawyers used questionnaires to gather information from employees about payments to foreign government officials, which Upjohn suspected were illegal. *Upjohn*, 449 U.S. at 386–87. The magistrate judge in *Upjohn* had already found that the purpose of that information was to allow company lawyers to “determine the nature and extent of the questionable payments *and to be in a position to give legal advice to the company with respect to the payments.*” *Id.* at 394 (emphasis in original).

In *Chen*, the defendants’ lawyers filed disclosures with U.S. Customs that purported to correct prior customs disclosures. The government claimed that the amended disclosures were actually part of a tax evasion scheme, and sought to compel the testimony of the lawyers. 99 F.3d at 1498. The Ninth Circuit rejected the government’s conclusory assertion that the lawyers were engaged in non-privileged “business decision-making” when they filed the disclosures. Rather, the

⁷ Further, the fact that non-legal executives are included on the communication and non-legal executives are asked to comment on the strategy – as was the case here – indicates that the communication is not primarily for the purpose of obtaining legal advice. *See, e.g., In re CV Therapeutics, Inc. Sec. Litig.*, 2006 WL 2585038, at *3 (N.D. Cal. Aug. 30, 2006) (finding no privilege where “documents on their face” sought comments from non-attorneys).

lawyers had been employed to use their “knowledge and discretion in the law” to “bring their clients into compliance with the law in the least burdensome way possible,” such that their communications were privileged. *Id.* at 1501-02.

In *Admiral Insurance v. U.S. Dist. Ct.*, the company had been sued for securities fraud and other torts related to financial transactions with another entity, JNC. 881 F.2d 1486, 1488-89 (9th Cir. 1989). Company lawyers interviewed two company employees in order to “render legal advice to Admiral regarding its potential interests and liabilities arising from the JNC transactions.” *Id.* at 1489. The Ninth Circuit held that those interviews were privileged. *Id.* at 1493.

Mr. Lindholm’s email about “technical alternatives” and tactics to get a Java license for Android and Chrome, at “better terms and price,” is nothing like the *Upjohn* questionnaires to assess the extent and legality of payments to foreign governments, the *Chen* lawyers’ advice about tax and customs compliance, or the *Admiral Insurance* lawyers’ fact gathering to assess potential liability for fraud.

Google’s argument that license negotiations can be a component of litigation settlements adds nothing. “Licensing decisions may contain a legal component, but are not inherently dependent on legal advice; they are essentially business decisions.” *SCM Corp. v. Xerox Corp.*, 70 F.R.D. 508, 517 (D. Conn. 1976) (Newman, J.). Business reasons for or against a course of action “are like any other business evaluations and motivations and do not enjoy any protection

because they were alluded to by conscientious counsel. To protect the business components in the decisional process would be a distortion of the privilege.” *Id.*⁸

2. The Magistrate Judge’s and District Court’s reliance on the *Sealed Case*’s “clear showing” rule was entirely proper under Supreme Court, Ninth Circuit, and this Court’s precedents.

Countless courts and commentators have made the common-sense observation that in-house counsel are often copied on communications that do not concern legal advice, or are asked to provide advice that is not legal at all. *See, e.g.,* Paul R. Rice, 1 ATTORNEY-CLIENT PRIVILEGE IN THE UNITED STATES, § 7:1 (2d ed. 1999) (collecting cases). In recognition of that fact, now-Justice Ginsburg, writing for the D.C. Circuit, held that the party asserting privilege must make “a clear showing” that an in-house lawyer gave advice “in a professional legal capacity.” *Sealed Case*, 737 F.2d at 99. As Google concedes (Petition, 20), the clear showing rule does not “dilute the privilege”; it concerns the standard of proof for establishing the existence of the privilege.⁹ *Sealed Case* is not inconsistent

⁸ *See also Griffith*, 161 F.R.D. at 697 (“no privilege can attach to any communication . . . that would have been made because of a business purpose”); *Adams v. Gateway, Inc.*, 2003 WL 23787856, at *15 (D. Utah Dec. 30, 2003) (“Documents showing business or negotiation strategy are not matters of litigation strategy protected by the work product privilege.”); *Hardy v. New York News*, 114 F.R.D. 633, 644-45 (S.D.N.Y. 1987) (“When the ultimate corporate decision is based on both a business policy and a legal evaluation, the business aspects of the decision are not protected simply because legal considerations are also involved.”).

⁹ Although Google complains that “clear showing” is a “heightened standard” for in-house lawyers, many courts apply a clear showing rule to *any* privilege claim. *See, e.g., Peat, Marwick, Mitchell & Co. v. W.*, 748 F.2d 540, 542 (10th Cir. 1984) (per curiam), *cert. denied*, 469 U.S. 1199 (1985); *Navigant Consulting, Inc. v. Wilkinson*, 220 F.R.D. 467, 473-74 (N.D. Tex. 2004); *Ali v. Douglas Cable Comm’cns, Ltd. P’ship*, 890 F. Supp. 993, 994 (D. Kan. 1995).

with *Upjohn*; in fact, it cites *Upjohn* in the very paragraph that sets out the clear showing rule. *Id.*

Google argues that it was clear error to apply that rule to Mr. Lindholm's email. First, Google contends that the Ninth Circuit has "rejected" the premise of *Sealed Case*. (Petition, 16-18) The two cases Google cites say no such thing. *United States v. Rowe* rejected an argument that in-house lawyers advising their employer had no "client" for purposes of the attorney-client privilege, holding that inside and outside counsel were no different for that purpose. 96 F.3d 1294, 1296 (9th Cir. 1996). As the District Court held here, the *Rowe* court never purported to address the **showing** necessary to establish privilege for in-house counsel communications, and no case has ever cited *Rowe* as addressing that issue. (A14:17-A15:3) *Chen*, which is discussed above, involved communications with **outside** counsel, and never addressed what showing would be required for communications with inside counsel. 99 F.3d at 1498.¹⁰

Google next argues that the District Court improperly expanded the clear showing rule to apply to all in-house counsel, not just in-house counsel with

¹⁰ Google attempts to bolster its argument by asserting that the Supreme Court in *Upjohn* made no distinction between inside and outside counsel. (Petition, 16) But there was no need to do so, as the magistrate judge in that case had already found that the purpose of the communications with employees was "to give legal advice to the company[.]" *Upjohn*, 449 U.S. at 394; *see also id.* at 386 ("We decline to lay down a broad rule or series of rules to govern all conceivable future questions in this area, even if we were able to do so.").

business responsibilities. (Petition, 21-22) Recognizing that titles may not be informative and certainly are not dispositive, other courts have applied the clear showing rule to in-house counsel generally.¹¹ Google itself has successfully argued in this very case that Oracle lawyers with responsibility for litigation should not be allowed to see highly confidential discovery material because those lawyers also have responsibility for making business decisions.¹²

Google complains that it should have been given the benefit of a “rebuttable presumption that a lawyer in the legal department or working for the general counsel is most often giving legal advice.” (Petition, 22). There are at least three flaws in this argument, each fatal. First, the District Court specifically held that even if this presumption applied, ***Google would still lose***: the Magistrate Judge’s order “cited sufficient record evidence to rebut any such presumption in this instance.” (A15:4-9) Second, Google – the party with the burden of proof on all issues – provided no evidence whatsoever about Mr. Lee’s role at Google. (A19-21; A180 at 21:4-14) *Compare Boca Investering P’ship v. United States*, 31 F. Supp. 2d 9, 12 (D.D.C. 1998) (cited by Google) (observing that in-house lawyer’s place on organizational chart is an important, though not dispositive, factor in

¹¹ See, e.g., *United States v. ChevronTexaco Corp.*, 241 F. Supp. 2d 1065, 1076 (N.D. Cal. 2002); *Amway Corp. v. Procter & Gamble Co.*, 2001 WL 1818698, at *5 (W.D. Mich. Apr. 3, 2001); *United States v. Chevron Corp.*, 1996 WL 264769 at *4 (N.D. Cal. Mar. 13, 1996).

¹² A208-A217.

assessing the lawyer’s role, and quoting inside lawyer’s detailed description of his responsibilities). Third, the Ninth Circuit has expressly rejected the claim that “[w]here an attorney-client relationship exists, communications made in the context of that relationship are *prima facie* subject to the privilege.” *United States v. Ruehle*, 583 F.3d 600, 608 n.8 (9th Cir. 2009) (finding that this argument “directly conflicts with our case law”).

Finally, Google argues that *Sealed Case* is an outlier that has “languished” outside the D.C. Circuit. (Petition, 22 n.52) But no Circuit Court has ever rejected, much less criticized, that holding. District courts in *nine* different circuits, including the Ninth, have followed it repeatedly.¹³ And this Court has refused to grant a mandamus petition arising from the Ninth Circuit, where the

¹³ In addition to courts in the D.C. Circuit, see *Borase v. M/A COM, Inc.*, 171 F.R.D. 10, 14 (D. Mass. 1997); *Acumen Re Mgmt. Corp. v. Gen. Sec. Nat. Ins. Co.*, 2010 WL 3260166, at *2 (S.D.N.Y. July 30, 2010); *Ames v. Black Entm't Television*, 1998 WL 812051, at *8 (S.D.N.Y. Nov. 18, 1998); *Teltron, Inc. v. Alexander*, 132 F.R.D. 394, 396 (E.D. Pa. 1990); *Neuberger Berman Real Estate Income Fund, Inc. v. Lola Brown Trust No. 1B*, 230 F.R.D. 398, 411 n.20 (D. Md. 2005); *Amway Corp. v. Procter & Gamble Co.*, 2001 WL 1818698, at *5 (W.D. Mich. Apr. 3, 2001); *In re Rospach Sec. Litig.*, 1991 WL 574963, at *8 (W.D. Mich. Mar. 14, 1991); *Argenyi v. Creighton Univ.*, 2011 WL 3497489, at *4 (D. Neb. Aug. 10, 2011); *O’Shea v. Epson Am., Inc.*, 2010 WL 2305863, at *4 (C.D. Cal. June 4, 2010); *U.S. ex rel. Parikh v. Premera Blue Cross*, 2006 WL 3733783, at *5 (W.D. Wash. Dec. 15, 2006); *United States v. ChevronTexaco Corp.*, 241 F. Supp. 2d 1065, 1076 (N.D. Cal. 2002); *United States v. Chevron Corp.*, 1996 WL 264769, at *4 (N.D. Cal. Mar. 13, 1996); *Lindley v. Life Investors Ins. Co. of Am.*, 267 F.R.D. 382, 390 (N.D. Okla. 2010); *Marten v. Yellow Freight System, Inc.*, 1998 WL 13244, at *6 (D. Kan. Jan. 6, 1998); *Pizza Mgmt., Inc. v. Pizza Hut, Inc.*, 1989 WL 9334 at *4 (D. Kan. Jan. 10, 1989).

district court rejected a privilege claim because that petitioner – like Google – “failed to make a clear showing that the primary purpose of the communication was securing legal advice[.]” *See In re Diagnostics Sys. Corp.*, 328 F. App’x at 622-23.

3. The Magistrate Judge properly considered all of the evidence in making her factual findings and committed no error in her evidentiary ruling.

Google contends that the Magistrate Judge committed two additional “legal errors” as a result of her reliance on *Sealed Case*. Both assertions are meritless.

First, Google argues that the Magistrate Judge held “in effect” that unless the document on its face establishes the privilege, the privilege claim fails, even if there is “undisputed evidence” that the document “relates to an *Upjohn* investigation” and “even if the document itself is not facially inconsistent with that evidence.” (Petition, 25) This nonsensical contention is directly at odds with the detailed factual findings by the Magistrate Judge. As described above, the Magistrate Judge considered *all* of the evidence submitted by the parties, and carefully analyzed Google’s declarations. (A39:21-A42:22) As the District Court found, the Magistrate Judge’s order “set forth a detailed review of the email itself and the extrinsic evidence bearing on the question of privilege” and reached a conclusion “based on holistic consideration of all the intrinsic and extrinsic evidence.” (A8:13-17) In the course of that review, the Magistrate Judge

explicitly rejected the idea that the email was “not facially inconsistent” with the privilege claim: “the contents of the email itself *severely undermine* the claim that Lindholm generated this particular email as part of an attorney-directed effort to provide legal advice or prepare for litigation.” (A40:5-7) (emphasis added)

Second, Google argues that the Magistrate Judge “apparently” extended the clear showing rule to the evidentiary requirement of foundation and dismissed Mr. Lee’s “declaration in its entirety.” (Petition, 26) But nothing in the Magistrate Judge’s or the District Court’s orders suggests any connection between the clear showing rule and the Court’s proper insistence that Federal Rule of Evidence 602 be satisfied.

A witness may not testify to a matter absent sufficient evidence to show that he has personal knowledge of the matter. FED. R. EVID. 602. As the party offering the testimony, Google had the burden under Rule 602 of laying a foundation demonstrating that Mr. Lee “had an adequate opportunity to observe and presently recalls the observation.” Kenneth S. Broun *et al.*, 1 MCCORMICK ON EVIDENCE § 10. In establishing that predicate, “the source of the knowledge must be disclosed; it is not sufficient for a witness merely to say that he or she is aware of a fact.” *Lewis v. Pacific Maritime Ass’n*, 2007 WL 2429554, at *5 (N.D. Cal. Aug. 24, 2007) (citing *Ward v. First Federal Savings Bank*, 173 F.3d 611, 617-18 (7th Cir. 1999)). The Magistrate Judge credited parts of the Lee declaration, but correctly

found that Mr. Lee “did not indicate that he reviewed the Email and could competently represent that it was connected to work that he requested from Lindholm as part of the provision of legal advice he describes in his declaration”; consequently Google failed to provide a sufficient foundation to permit Mr. Lee to testify about it. (A11:16-28; A40:9-11). Google has not shown that this evidentiary ruling was clearly erroneous. *See Hakim v. Cannon Avent Group, PLC*, 479 F.3d 1313, 1320 (Fed. Cir. 2007).

4. The Magistrate Judge and the District Court properly rejected Google’s claim of work-product protection.

Under Ninth Circuit law, to establish work-product protection, Google must show that the “document was created because of anticipated litigation, and would not have been created in substantially similar form but for the prospect of that litigation.” *In re Grand Jury Subpoena (Torf)*, 357 F.3d 900, 908 (9th Cir. 2004). Google failed to make that showing. In its argument to the Magistrate Judge, Google devoted only two sentences to its work product claim. The Magistrate Judge found that Google waived any dual-purpose argument, which Google did not challenge. (A43:15-21 & n.6) Thus, Google can establish work product protection only if the email was created exclusively in preparation for litigation, a showing that Google has never tried to make, and which is foreclosed by the content of the email itself. Indeed, the investigation that Mr. Lindholm describes in his email is

much like the Android-related work he did in 2005 and 2006. (A132-34 ¶¶ 10-11; A144-A162)

B. The District Court correctly applied Ninth Circuit law and Federal Rule of Civil Procedure 72(a) in rejecting Google’s objections.

Google claims the District Court committed reversible error by “deferring” to the Magistrate Judge’s “erroneous legal conclusions.” (Petition 27-29) The Court did no such thing. It began by stating the rule that Google itself advocates: a “non-dispositive order entered by a magistrate must be deferred to *unless* it is ‘clearly erroneous or contrary to law.’” (A8:4-5 (quoting *Grimes*, 951 F.2d at 241 (emphasis added))). The District Court then quoted *Grimes*’s holding that orders of a magistrate judge on non-dispositive matters “are not subject to *de novo* determination.” *Grimes*, 951 F.2d at 241.

The District Court then correctly cited and applied the “clearly erroneous or contrary to law” standard on nearly every page of its analysis. (A8:5, A8:12-13, A8:25, A9:15-16, A9:19-20; A10:11-12, A11:19-20, A11:7-8, A11:16-17, A11:27-28, A12:8-9, A13:3-4, A13:17-18, A14:2, A14:9, A15:2-3, A15:7-9, A15:13-14, A15:27, A17:4-5) Google does not identify any actual instance in which the District Court “deferred” to the Magistrate Judge’s conclusions of law. Indeed, the only “error of law” that Google objected to in the Magistrate Judge’s order was the application of *Sealed Case*, which the District Court clearly agreed with. (A15 n.4

(holding that *Sealed Case* “makes considerable sense and addresses real world practices” and endorsing its “wisdom”))

C. Google cannot establish a “clear and indisputable right” to the writ because the Magistrate Judge and the District Court would not have reached a different result if a different legal standard applied.

Not only has Google failed to establish “clear error,”¹⁴ it has failed to establish that it would have obtained a different result absent the supposed errors. The Magistrate Judge plainly did not see the privilege question as a close call, and nothing in her order suggests that the result would have been different if she had applied a lower standard of proof. To the contrary, the District Court expressly held that even if it presumed that the Lindholm email was for the purpose of obtaining legal advice, the evidence cited by the Magistrate Judge would rebut that presumption, and Google would lose. (A15:4-7) It is a general principle of appellate review that harmless errors are not reversible. *McDonough Power Equip., Inc. v. Greenwood*, 464 U.S. 548, 553 (1984). If there would be no error that would merit correction on a direct appeal, there can be no error that warrants a writ of mandamus.

D. Google has failed to show that it cannot obtain the same relief by other means, or that the alleged errors cannot be corrected on direct appeal.

As Google concedes, mandamus exists to correct errors that cannot be corrected by other means. Even if Google’s claims of error had merit – and they

¹⁴ Under Ninth Circuit law, which Google relies on, failure to show clear error alone necessarily defeats a petition for mandamus. *In re Van Dusen*, 654 F.3d 838, 841 (9th Cir. 2011).

do not – the only practical relief that Google seeks at this late stage of the proceedings is to prevent Oracle from using the email at trial.¹⁵ As discussed above, the email has been produced and is publicly available, so preventing disclosure (or “spillover effects” of disclosure (Petition, 30 n.62)) is impossible.

Trying to prevent Oracle from using the document at trial is not a proper basis for mandamus relief. The Ninth Circuit and other courts consistently have held that, while interlocutory appeals were available to prevent disclosure in the first place, they serve no purpose once disclosure has already occurred. Thus, in *Truckstop.net, LLC v. Spring Corp.*, the Ninth Circuit held that there could be no interlocutory review of a discovery order that had already mandated release of an entire document, as the fact of disclosure would make “the issue of privilege effectively moot.” 547 F.3d 1065, 1068-70 & 1069 n.2 (9th Cir. 2008). The Court held that although the inadvertent disclosure of the allegedly privileged email “may be unfortunate, the chicken has already flown the coop – the alleged harm from disclosure had already occurred.” *Id.* at 1070. Any other harm would be

¹⁵ Google failed to inform this Court that it has a pending motion *in limine* with the District Court, seeking to exclude the Lindholm email on Rule 403 grounds – the very issue it argues to this Court on page 30 of the petition. (A183) Thus, Google cannot claim it has no other means of obtaining the only practical relief it seeks from this Court. Even if that motion is denied – as it should be – any claimed error in the use of the document at trial can and should be reviewed on direct appeal.

effectively reviewable on appeal from a final judgment. *Id.* See also *In re EchoStar Comm'cns Corp.*, 448 F.3d 1294, 1298 (Fed. Cir. 2009).¹⁶

E. This Court cannot grant Google the relief it seeks because Google has failed to submit the complete evidentiary record on the privilege issue and the courts below have not decided the waiver issue.

Finally, this Court cannot grant Google the relief it seeks: to hold that the Lindholm email is privileged, compel its return by Oracle, and seal all court documents “referencing” it. (A1-A3). First, Google has provided this Court with only a portion of the evidentiary record below, making it impossible for this Court to determine that the Lindholm email is privileged. Second, Oracle argued below that Google waived any otherwise applicable privilege, a question that the courts below did not need to answer. Consequently, even if there were error – and there is not – and even if that error warranted mandamus – and it would not – the only relief that this Court could grant would be remand to the District Court to decide the privilege and waiver issues applying some other legal standard.

IV. Conclusion

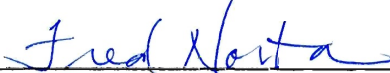
There is no error in the rulings below, and any harm resulting from disclosure has already occurred. The petition should be denied.

¹⁶ The Supreme Court’s decision in *Mohawk Industries v. Carpenter*, 130 S.Ct. 599 (2009) precludes appeals of privilege questions under the collateral order doctrine. Nonetheless, the logic of these decisions remains sound: courts of appeal should not intervene, by interlocutory appeal or mandamus, if the allegedly irreparable harm has already occurred and any other injury can be reviewed on direct appeal.

Dated: November 28, 2011

Respectfully submitted,

BOIES, SCHILLER & FLEXNER LLP

By: 
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Oracle America Inc.

**United States Court of Appeals
for the Federal Circuit**
IN RE GOOGLE INC., Miscellaneous Docket No. 106

CERTIFICATE OF SERVICE

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 BOIES, SCHILLER & FLEXNER LLP, Attorneys for Respondent to print this document. I am an employee of Counsel Press.

On the **28th Day of November, 2011**, I served the within **Response in Opposition to Petition for Mandamus** upon:

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via Federal Express (and Email to counsel for petitioner), 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, the 5 copies have been hand-delivered to the Court on the same date as above.

November 28, 2011

