

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

CERTAIN LOCATION-SHARING
SYSTEMS, RELATED SOFTWARE,
COMPONENTS THEREOF, AND
PRODUCTS CONTAINING SAME

Inv. No. 337-TA-1347

**ORDER NO. 22: DENYING NON-PARTIES FABRICANT LLP AND CERTAIN
FABRICANT LLP ATTORNEYS' MOTION TO QUASH
SUBPOENAS PROPOUNDED BY GOOGLE LLC**

(June 12, 2023)

I. BACKGROUND AND INTRODUCTION

This dispute arises out of discovery relating to Respondent Google LLC's ("Google") defense of inequitable conduct. On April 10, 2023, Google moved to amend its response to the complaint and notice of investigation to add a defense of inequitable conduct.¹ EDIS Doc. 794093. On April 27, 2023, I granted Google's motion. Order No. 11 (Apr. 27, 2023). Google's defense of inequitable conduct is based on the alleged withholding of certain litigation history from the U.S. Patent and Trademark Office during *ex parte* reexamination proceedings for U.S. Patent No. 8,213,970 ("the '970 patent"). *See generally* EDIS Doc. 795085 at 58–77. The claim of inequitable

¹ The remaining Respondents, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc. (collectively, "Samsung"), OnePlus Technology (Shenzhen) Co., Ltd. ("OnePlus"), TCL Technology Group Corporation, TCL Electronics Holdings Limited, TCL Communication Technology Holdings Limited, TCT Mobile (US) Inc. (collectively, "TCL"), Lenovo Group Ltd., Lenovo (United States) Inc., Motorola Mobility LLC (collectively, "Lenovo"), HMD Global, HMD Global OY (collectively, "HMD"), Sony Corporation, Sony Mobile Communications, Inc. (collectively, "Sony"), ASUSTek Computer, Inc., ASUS Computer International (collectively, "ASUS"), BLU Products ("BLU"), Panasonic Holdings Corporation (substituted by Panasonic Holdings Corporation), Panasonic Corporation of North America ("Panasonic"), Xiaomi Corporation, Xiaomi H.K. Ltd., Xiaomi Communications Co., Ltd., and Xiaomi Inc. (collectively, "Xiaomi"), have also moved for leave to amend their responses to add the same inequitable conduct defense. EDIS Doc. 797451 (Mot. 1347-011).

conduct identifies four individuals who represented Complainants Advanced Ground Information Systems, Inc. and AGIS Software Development LLC (“Complainants” or “AGIS”) before the USPTO as having allegedly acted with intent to deceive the USPTO: Vincent Rubino, Enrique Iturralde, Jialin Zhong, and Peter Lambrianakos. *Id.* at 60, 68, 71–75. Messrs. Rubino, Iturralde, and Lambrianakos are counsel of record for AGIS in this investigation. EDIS Doc. 787098. The potential of depositions of Messrs. Rubino, Iturralde, and Lambrianakos was raised as an argument against permitting Google’s amendment. EDIS Doc. 794981 at 12. In granting Google’s motion, I explained that the potential depositions of its litigation counsel did not cause the kind of prejudice that could defeat the amendment. Order No. 11 at 6.

After I granted Google’s motion, Google submitted *ex parte* applications for subpoenas to Fabricant LLP and Messrs. Rubino, Iturralde, and Lambrianakos (collectively, “Fabricant”). EDIS Doc. 797173 (“Fabricant Mot.”) Exs. 1–4 (subpoenas to Fabricant LLP, Iturralde, Lambrianakos, and Rubino, respectively). The subpoenas were issued on May 12, 2023.² The subpoenas were sent by Google via email on May 12, 2023, and served via FedEx Priority Overnight on May 15, 2023. EDIS Doc. 797173 (“Fabricant Mot.”) at 2–3.

The subpoena to Fabricant LLP included one Request for Production and one Deposition Topic. Fabricant Mot. Ex. 1, Attachment A at 7–8, Attachment B at 1. The Request for Production reads:

² Fabricant argued, in a footnote, that the subpoenas should be quashed for failure to comply with Ground Rule 6.5.1 because Google did not include the Amended Protective Order which was issued on May 12, 2023. Fabricant Mot. at 2–3 n.2. Fabricant’s argument, which was only raised in a footnote, is waived. *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1383 (Fed. Cir. 2015) (citing cases). But even if it were not, there was no violation of Ground Rule 6.5.1. I issued these subpoenas before the Amended Protective Order was issued on EDIS. And any alleged violation of Ground Rule 6.5.1 would have been harmless here because the subpoena’s recipients are counsel in this investigation who were served the Amended Protective Order when it issued.

All Documents related to proceedings associated with the Asserted Patents before United States Patent Office or the Patent Trial and Appeal Board, including without limitation the following reexamination proceedings, related interviews, new claims and amendments added during the reexaminations, and communications with co-counsel in the reexaminations:

- U.S. Patent No. 8,213,970: 90/014,507

This request includes, but is not limited to, the following specific materials concerning Reexamination 90/014,507:

- All Documents (including drafts and notes) concerning the interviews conducted with individuals at the Patent Office on or about May 17, 2021, September 13, 2021, and October 19, 2021.
- All Documents (including drafts and notes) concerning new claims and amendments to existing claims proposed during the reexamination process.
- All Documents concerning Your indication during the interview on or about May 17, 2021 that “corresponding disclosure” for “proposed new claims 15 and 16” was “found in the ’728 patent, incorporated by reference into the ’970 patent disclosure” (i.e., as reflected in the Continuation Sheet of the Ex Parte Reexamination Interview Summary)
- All Documents embodying or reflecting communications with co-counsel involved in the reexamination, including but not limited to Jialin Zhong

Id. Attachment A at 7–8. The subpoena seeking a deposition of Fabricant LLP has since been withdrawn by Google. EDIS Doc. 797868 (“Google Resp.”) at 2.

The subpoenas to Messrs. Iturralde, Lambrianakos, and Rubino did not include any deposition topics. Fabricant Mot. Exs. 2–4. However, the applications for issuance of those subpoenas, included with each subpoena, noted that each of these individuals were involved in *ex parte* reexamination proceedings and may possess relevant information about the reexamination, which was relevant to Google’s inequitable conduct defenses. *Id.*

On May 24, 2023, Fabricant filed its motion (Motion 1347-010). In the motion, Fabricant’s Ground Rule 5.1 Certification stated that it “contacted Respondents’ counsel and the Commission Investigative Staff in a good faith effort to obtain their position on the Motion.” Fabricant Mot. at

cover. On June 6, 2023, Google filed a brief opposing this motion. Google Resp. The Commission Investigative Staff also filed a brief opposing this motion. EDIS Doc. 797807 (“Staff Resp.”). On June 9, 2023, Fabricant moved (Mot. 1347-013) for leave to file a reply in support of their motion. EDIS Doc. 798139 (Fabricant Reply).³

After Fabricant filed its motion, on May 26, 2023, Google proposed narrowing the scope of the subpoena as follows:

- The document request and deposition topic for the subpoena to Fabricant LLP would be narrowed only to Reexamination 90/014,507 concerning the ’970 patent, and only to the bullets given at the end of the document request and deposition topic.
- The individual subpoenas’ depositions would be limited to the same narrowed topic as the Fabricant subpoena, and to the attorneys’ awareness of and involvement in the *Life360* litigation.
- Fabricant and the individuals could maintain privilege and work product objections as appropriate under the ITC’s rules and the relevant case law.

Google Resp., Ex. A at 1. Google identified specific, narrower document requests for Fabricant LLP:

For Reexamination No. 90/014,507:

- All Documents (including drafts and notes) concerning the interviews conducted with individuals at the Patent Office on or about May 17, 2021, September 13, 2021, and October 19, 2021.
- All Documents (including drafts and notes) concerning new claims and amendments to existing claims proposed during the reexamination process.
- All Documents concerning Your indication during the interview on or about May 17, 2021 that “corresponding disclosure” for “proposed new claims 15 and 16” was “found in the ’728 patent, incorporated by reference into the

³ Fabricant’s motion for leave to file a reply is granted. Motions for leave to file a reply are disfavored and are rarely granted. In this case, however, good cause exists for Fabricant to file a reply. Because Google offered proposals to attempt to narrow the subpoena after Fabricant’s motion and, in one case, for the first time in its opposition brief, Fabricant did not have an opportunity to address the narrowed subpoenas in its motion.

'970 patent disclosure" (i.e., as reflected in the Continuation Sheet of the Ex Parte Reexamination Interview Summary)

- All Documents embodying or reflecting communications with co-counsel involved in the reexamination, including but not limited to Jialin Zhong

Id. at 1. Google also withdrew its deposition subpoena to Fabricant LLP. Google Resp. at 2. And

Google identified specific deposition topics for Messrs. Rubino, Iturralde, and Lambrianakos:

1. For Reexamination No. 90/014,507:
 - Interviews conducted with individuals at the Patent Office on or about May 17, 2021, September 13, 2021, and October 19, 2021.
 - New claims and amendments to existing claims proposed during the reexamination process.
 - Your indication during the interview on or about May 17, 2021 that "corresponding disclosure" for "proposed new claims 15 and 16" was "found in the '728 patent, incorporated by reference into the '970 patent disclosure" (i.e., as reflected in the Continuation Sheet of the Ex Parte Reexamination Interview Summary)
 - Communications with co-counsel involved in the reexamination, including but not limited to Jialin Zhong
2. Your awareness of and involvement in the Life360 litigation (*i.e.*, *Advanced Ground Information Systems, Inc. v. Life360, Inc.*, SDFL-9-14-cv-80651), including the district court's Nov. 21, 2014 Markman decision and the Federal Circuit's July 28, 2016 decision.

Google Resp., Ex. A at 2.

On June 1, 2023, Fabricant provided its own proposal to narrow and resolve the dispute:

1. Google agrees it is not seeking any privileged documents, information, or testimony.
2. Fabricant LLP and the Fabricant Attorneys do not otherwise have any non-privileged documents or information in their possession, custody, or control.
3. Google will take the deposition of the Zhong Law Firm in response to its subpoena. Thereafter, Google will only seek the deposition of a Fabricant Attorney upon a showing of good cause and that the Fabricant Attorneys are the "only means to obtain" relevant, necessary, and non-privileged information that Google could not otherwise obtain from the Zhong Law Firm.

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