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Via CM/ECF

November 20, 2020

The Hon. Stewart D. Aaron
Daniel Patrick Moynihan United States Courthouse
500 Pearl Street
New York, NY 10007

Re: *SM Kids, LLC v. Google LLC, et al.* (18-cv-2637)

Dear Judge Aaron:

Pursuant to Rule II.B of the Court's Individual Practices, on behalf of Google, as well as third parties[1] Timothy Alger, Rose Hagan, and Pavni Diwanji, we write to request a pre-motion discovery conference to address a disagreement over Plaintiff's Notice of Subpoenas to the third parties under Rule 45. In a vexatious attempt to increase Google's cost and burden, Plaintiff seeks to depose Mr. Alger, Ms. Hagan, and Gina Paik, former Google in-house counsel, and Ramsey Al-Salam, former outside counsel, on topics centering on attorney-client privileged information, when it could obtain the same (or better) information from other witnesses. Plaintiff also seeks to depose Ms. Diwanji on Google children's entertainment offerings, a topic of no relevance on which it has already noticed as many as five other depositions, including a Rule 30(b)(6) deposition. Therefore, for the reasons set forth in this letter, pursuant to Rule 45(d)(3)(A), we respectfully request that this Court enter an order quashing the subpoenas of former Google attorneys Timothy Alger, Rose Hagan, Gina Paik, and Ramsey Al-Salam, and the subpoena of Pavni Diwanji.[2]

1. Timothy Alger, Rose Hagan, Gina Paik, and Ramsey Al-Salam

Plaintiff has subpoenaed four former Google attorneys for deposition: Timothy Alger, former Head of Litigation for Google who left the company in 2011; Rose Hagan, former Chief Trademark Counsel for Google who left in 2010; Gina Paik, former Legal Director for Google who left in 2019; and Ramsey Al-Salam of Perkins Coie, who represented Google as outside counsel in the litigation that resulted in the 2008 trademark coexistence agreement. Plaintiff has not identified the specific deposition topics it intends to question the deponents about or any specific personal knowledge that these individuals have about any issues in dispute in this litigation that would justify their depositions. Google has offered to designate a 30(b)(6) witness as to the settlement agreement topics in the 30(b)(6) deposition notice.

[1] In addition to this pre-motion letter, we have also served objections on behalf of each individual third party in accordance with the requirements of Rule 45. We also anticipate being able to represent Ms. Gina Paik, another third party, but we received notice of her subpoena only yesterday and therefore have not yet had the opportunity to engage her as a client.

[2] The procedural history concerning this pre-motion letter is set out in the Certification of Brendan Hughes, attached hereto as Exhibit A.

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Under Rule 45, a court "must quash or modify a subpoena that . . . requires disclosure of privileged or other protected matter, if no exception or waiver applies." Fed. R. Civ. P. 45(c)(3)(A)(iii). The policy considerations of Rule 45 are particularly heightened in the context of depositions of opposing counsel, which are "disfavored" in this Circuit. *United States v. Yonkers Bd. of Educ.*, 946 F.2d 180, 185 (2d Cir. 1991). Courts enforce this presumption against depositions of counsel because "even a deposition of counsel limited to relevant and nonprivileged information risks disrupting the attorney-client relationship and impeding the litigation." *Ferrari v. County of Suffolk*, No. cv-10-418, 2012 WL 13109925, at *2 (E.D.N.Y. Mar. 28, 2012). The same presumption governs regardless of whether the attorney is in-house or outside counsel, *Tailored Lighting, Inc. v. Osram Sylvania Products, Inc.*, 255 F.R.D. 340, 344 (W.D.N.Y. 2009), or whether the attorney still represents the party at the time of the subpoena, *see id.* (quashing subpoena of former attorney for defendant); *In re Subpoena Issued to Dennis Friedman*, 350 F.3d 65, 66 (2d Cir. 2003) (dismissing as moot an appeal from order quashing deposition of former counsel to defendant).

In deciding whether to permit the deposition of opposing counsel, courts generally consider four factors: (1) "the need to depose the lawyer," (2) "the lawyer's role in connection with the matter on which discovery is sought and in relation to the pending litigation," (3) "the risk of encountering privilege and work-product issues," and (4) "the extent of discovery already conducted." *Dennis Friedman*, 350 F.3d at 72. The Court should take into consideration "all of the relevant facts and circumstances to determine whether the proposed deposition would entail an inappropriate burden or hardship" on the party. *Id.*

Under this standard, the subpoenas of Google's former counsel should be quashed. *First*, Plaintiff has made no showing of a particular need – and there could be none – to depose four former attorneys for Google. Plaintiff has not identified any information that it can obtain only from them. That failure is dispositive as to the first factor. *KOS Building Group, LLC v. R.S. Granoff Architects, P.C.*, No. 19-cv-2918, 2020 WL 1989487, at *4 (S.D.NY. Apr. 24, 2020) (denying deposition of copyright attorney because the information sought either could be or was already obtained from another source). Plaintiff also has not identified any specific topics on which it plans to depose the attorneys. In fact, if the identical document requests accompanying the subpoenas for Mr. Alger, and Ms. Hagan, and Mr. Al-Salam are any indication, Plaintiff has subpoenaed the Google attorneys to testify about the same general topics. That is a far cry from the necessary showing of "need" required in order to depose opposing counsel under the law of this Circuit. *See Chord Assoc. LLC v. Protect 2003-D LLC*, No. cv-07-5138, 2011 WL 13302691, at *5 (E.D.N.Y. Mar. 31, 2011) (requiring a list of "highly specific topics" of information not obtainable from another source before considering permitting deposition of attorney). To the extent there is a need, a 30(b)(6) deposition (with proper limitations to minimize the risk to privilege) would be more than sufficient to meet it.

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Second, the involvement of the attorneys in the underlying litigation militates against deposing them, either because (in Ms. Paik's case), they were not involved or because (in Mr. Alger's, Ms. Hagan's and Mr. Al-Salam's cases), their involvement was only in their capacity as attorneys, such that their depositions would center on privileged matters. Ms. Paik was not involved in the 2008 negotiations, and her only subsequent involvement was as legal advisor to Google about the agreement. There is no relevant, non-privileged matter on which she could offer testimony. Mr. Alger, then Head of Litigation, was not involved in the day-to-day substance of the settlement negotiations in 2008, as he arrived at Google only in October 2008, two months before the execution of the agreement. Being Head of Litigation, Mr. Alger executed the agreement, but he has no personal knowledge of the specifics of its negotiation or meaning. Rose Hagan, then Chief Trademark Counsel, was somewhat involved in the negotiations of the settlement in her capacity as Google's counsel, making it likely that most if not all of her testimony would center on privileged information. Moreover, Ms. Hagan was already deposed in the underlying lawsuit in 2008. Any recollections of relevant facts were far fresher then than they would be years later and would be available in Ms. Hagan's 2008 deposition transcript. Finally, Mr. Al-Salam's only role in the negotiations was to advise Google as its outside litigation counsel. It is hard to imagine a greater risk to the attorney-client privilege than deposing Mr. Al-Salam. *KOS Building Group, LLC*, 2020 WL 1989487, at *5 (noting that the second factor militates against deposing the attorney where the "[attorney's] role in connection with the subjects as to which discovery is sought is as [a party's] lawyer . . . [s]ince deposing [attorney] would therefore encroach upon the attorney-client relationship"). Those same considerations here also weigh against permitting the depositions of Google's attorneys.

Third, the extent – or rather, lack thereof – of discovery conducted thus far militates against permitting any depositions of counsel until Plaintiff makes a showing that it cannot get that information from another deponent. *See Ferrari*, 2012 WL 13109925, at *2 (granting motion to quash deposition subpoena where "Plaintiff has provided no indication that [defendant's former attorney] is the only source for the information sought" and requiring that plaintiff look to other sources first). In fact, Plaintiff admitted as much when, during the meet-and-confer process, Plaintiff's counsel offered to hold the depositions of Ms. Hagan and Mr. Al-Salam (though not Mr. Alger or Ms. Paik) in abeyance pending a 30(b)(6) deposition and the deposition of Adam Barea (which Defendants also oppose). A mere delay is insufficient to cure the improper subpoenas of multiple former Google attorneys. At the very least, Plaintiff should be required to make a showing that the information it seeks from the Google attorneys cannot be obtained from another source before the Court permits depositions of any of the Google attorneys. Even then, it could not possibly be necessary to depose all four.

2. Pavni Diwanji

Plaintiff has also subpoenaed yet another witness to testify about Google's children's offerings, Pavni Diwanji. As stated in Defendant's November 20 letter seeking a protective order, Google has designated Rob Newton as a 30(b)(6) witness to testify about Google's various

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offerings for children, as well as Ruchi Bezoles who will testify in her individual capacity about similar topics. It would be cumulative and unduly burdensome to depose Ms. Diwanji, who left Google two years ago and who possesses no relevant documents, when current Google employees are better situated to testify on the same topics.

Accordingly, Google, as well as third party deponents Alger, Hagan, and Diwanji, respectfully request that the Court issue an order quashing the subpoenas of Tim Alger, Rose Hagan, Gina Paik, Ramsey Al-Salam, and Pavni Diwanji.[3]

Sincerely,

Cooley LLP

By: /s/ *Brendan Hughes*
Brendan Hughes
Attorneys for Defendants

[3] In the event that Plaintiff deposes other witnesses and is still unable to obtain the information it seeks, Plaintiff can move the Court to permit a deposition upon a showing (1) that the information could not be obtained elsewhere and (2) of particular, highly specific topics, on which the witness would be deposed, in order to avoid encroaching on attorney-client privileged topics. *See Chord Assoc. LLC v. Protect 2003-D LLC*, No. cv-07-5138, 2011 WL 13302691, at *5 (E.D.N.Y. Mar. 31, 2011) (denying motion for deposition without prejudice, to be renewed upon a showing that the information sought could not be obtained from another source and requiring a list of "highly specific topics" for any potential deposition).