

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

TIVO, INC., §
§
Plaintiff, §
vs. §
AT&T Inc., et al. § CIVIL ACTION NO. 2:09-CV-259 (DF)
§
Defendants, §
§
and §
MICROSOFT CORPORATION, §
§
Intervenor. §

ORDER

Before the Court is Plaintiff TiVo, Inc’s (“TiVo”) Emergency Motion to Compel (Dkt. No. 236). Also before the Court is the AT&T Defendants’ (“AT&T”) response and Plaintiff’s reply. Dkt. Nos. 255 and 261.

TiVo moves to compel production of an email (hereinafter, “the Email”) that AT&T had produced and the “clawed back” pursuant to the Protective Order. AT&T produced the Email on November 22, 2011. On November 30, 2011, TiVo took the deposition of AT&T pursuant to Fed. R. Civ. Proc. 30(b)(6) (hereinafter, “the Deposition”). During the Deposition, TiVo introduced and marked the Email as an exhibit and questioned the deponent for anywhere from six to eight minutes about the Email before counsel for AT&T demanded that TiVo return the Email. Counsel for AT&T explained that the Email may be subject to a common interest agreement with a third party. TiVo returned the Email to AT&T, in compliance with the Protective Order.

TiVo moves the Court to compel Defendants to re-produce the Email. Dkt. No. 236.

TiVo argues that the Email does not contain attorney-client privileged information or work product information. TiVo states that neither the sender nor the recipient of the Email are attorneys, the communication is between AT&T and a third-party, and the subject matter of the Email is not legal advice. TiVo urges that the Email is also not immune from discovery as attorney work product because the Email was created for business purposes and not in anticipation of litigation. TiVo states that there is no suggestion that any attorney requested or initiated the communication between AT&T and the third-party. TiVo further argues that the Email was not created in anticipation of litigation because TiVo had not approached AT&T at that time.

TiVo also argues that even if any privilege protection applied to the Email, AT&T had waived that privilege because the Email is already part of the record. TiVo submits that by allowing the Email to be marked as an exhibit and to allow several minutes of questioning of the Email during a deposition, AT&T has effectively waived any privilege that the Email might have enjoyed. TiVo further argues that AT&T cannot rely on the “common interest” doctrine to protect the Email because the doctrine is not a privilege itself. Finally, TiVo argues that the Email is discoverable under the crime-fraud exception. TiVo submits that the contents of the Email constitute *prima facie* evidence of an antitrust violation.

AT&T responds that the Email contains line after line of attorney-client privileged information. Dkt. No. 255. AT&T points out that a document does not need to be written by or addressed to an attorney to be protected by attorney-client privilege. Furthermore, AT&T argues that when the client is a corporation, attorney-client privileged documents may be transmitted between non-attorneys involved in corporate decision-making so that the corporation may act on

the attorney's advice. AT&T further argues that AT&T and the third-party corporation entered into a common interest and joint defense agreement prior to the sending of the Email. Thus, argues AT&T, the Email is protected.

AT&T argues that the attorney-client privilege of the Email was not waived at the Deposition. AT&T submits that the facts surrounding the Deposition are not the type of facts that will leave to inadvertent waiver by disclosure. AT&T states that AT&T's counsel asserted privilege during the Deposition as soon as counsel realized that there had been an inadvertent production. Finally, AT&T argues that the crime-fraud exception is not applicable because TiVo has not provided any independent evidence that a crime has been committed.

TiVo replies that AT&T has not established its claim of attorney-client privilege. Dkt. No. 261. TiVo argues that AT&T has not identified the legal advice contained in the Email, where it appears in the Email, or any attorney who communicated the legal advice contained in the Email. TiVo also argues that AT&T has not established the common legal interest that is the subject of the communication.

The common interest doctrine covers two types of privileged communications: (i) "communications between co-defendants in actual litigation and their counsel"; and (ii) "communications between *potential* co-defendants and their counsel." *In re Santa Fe*, 272 F.3d at 710 (internal citations omitted) (emphasis in original). With respect to the second category, the Fifth Circuit held in *Santa Fe* that "there must be a palpable threat of litigation at the time of the communication, rather than a mere awareness that one's questionable conduct might some day result in litigation, before communications between one possible future co-defendant and another . . . could qualify for protection." *Id.* at 711. Even where a common interest exists, that alone

does not create a privilege; it merely extends a recognized privilege, commonly the attorney-client or work product privileges, to cover those communications to parties with the common interest. *Power Mosfet Techs v. Siemens AG*, 206 F.R.D. 422, 424 (E.D. Tex. 2000).

Accordingly, for the common interest doctrine to apply to the Email, the Court must first find that the Email is protected under the attorney-client privilege. A party asserting a privilege has the burden of demonstrating its applicability. Fed. R. Civ. P. 26(b)(5)(B). To maintain its claim of attorney-client privilege, AT&T must establish that: (1) the asserted holder of the privilege is or sought to become a client; (2) the person to whom the communication was made is a member of a bar of a court, or his subordinate, and in connection with this communication is acting as a lawyer; (3) the communication relates to a fact of which the attorney was informed by his client without the presence of strangers for the purposes of securing primarily an opinion, legal services, or assistance in some legal proceeding and not for the purpose of committing a crime or a tort; and (4) the privilege has been claimed and not waived by the client. *Blum v. Spectrum Rest. Grp. - Emps. Grp. Life and Supplemental Life Plan*, 2003 WL 367059 at *1 (E.D. Tex. Feb. 18, 2003) (citing *US v. Kelly*, 569 F.2d 928, 938 (5th Cir. 1978), cert. denied, 439 U.S. 829 (1978)).

AT&T argues that information contained in the Email is attorney-client privileged information. After reviewing the Email *in camera*, it is not obvious to the Court what statement(s) in the Email are protected under attorney-client privilege. As the parties have stated, neither the author nor the recipient of the Email are licensed attorneys. AT&T has not identified for the Court what information contained in the Email is privileged nor has AT&T identified the source of the privileged information. The declaration submitted by AT&T in

support of its response also suffers from these same defects in that it does not identify the privileged statements nor does it identify the source of the information conveyed in the statements.

It is AT&T's burden, as the producing party, to show that the Email is protected under attorney-client privilege. AT&T has not met its burden. Accordingly, the Court finds that the Email is not protected by attorney-client privilege. Because the Court has found that the Email is not protected by attorney-client privilege, the Court does not need to reach the issues of whether the common-interest doctrine applies, whether or not the privilege has been waived, or if the Email is discoverable under the crime-fraud exception.

TiVo's Emergency Motion to Compel (Dkt. No. 236) is hereby **GRANTED**. The Court hereby **ORDERS** AT&T to produce the Email to TiVo within one day of the entry of this order. The Court further **ORDERS** that AT&T shall pay TiVo's reasonable costs, including attorneys' fees, incurred in making this Emergency Motion to Compel. In the event that the parties are unable to come to agreement on attorneys' fees and costs, TiVo shall submit by motion their proposed attorneys' fees and costs incurred in making this motion.

IT IS SO ORDERED.

SIGNED this 27th day of December, 2011.



DAVID FOLSOM
UNITED STATES DISTRICT JUDGE