IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS

In re Chien-Min Sung Subpoena Upon 3M Company	C.A. No. 6:23-mc-2

CHIEN-MIN SUNG'S MEMORANDUM OF LAW IN SUPPORT OF HIS MOTION TO COMPEL 3M COMPANY'S RESPONSE TO SUBPOENA

Dated: November 27, 2023

Alex Chan
Texas Bar No. 24108051
DEVLIN LAW FIRM LLC
1526 Gilpin Avenue
Wilmington, DE 19806
Telephone: (302) 449-9010
achan@devlinlawfirm.com

Counsel for Plaintiff
Chien-Min Sung

I. INTRODUCTION

Movant Dr. Chien-Min Sung ("Dr. Sung") hereby moves the Court to compel Respondent 3M Company ("3M") to produce documents and testimony responsive to the subpoena issued to 3M ("Motion") in *Chien-Min Sung v. Texas Instruments, Inc.*, No. 4:23-cv-753-SDJ, pending in the U.S. District Court for the Eastern District of Texas ("Subpoena"), and more specifically, to substantially complete its document production within one week of the Court's ruling and to produce its corporate witness for deposition within a week thereafter. Dr. Sung, a 76-years-old individual inventor with limited financial resources, also moves the Court to award him reasonable expenses, including attorney's fees and costs, incurred by Dr. Sung in compelling 3M to comply with the Subpoena.

The Subpoena to 3M names 3M's ***own*** manufacturing facility in the Northern District of Texas as the place of compliance; yet, 3M intentionally disregarded this fact and filed a Motion to Quash in the District of Minnesota, which remains pending as of the date of this Motion, fully knowing that its challenge to the Subpoena should have been brought in this District. 3M has failed to meet its burden to show that the Subpoena is unduly burdensome or unreasonable because 3M has not identified any deficiency in the Subpoena itself; instead, 3M complains only that it wants more time to respond to the Subpoena and does not wish to commit to any timeline or date on which to fully comply with the Subpoena. Rule 45 does not offer 3M any relief because 3M had already been given 14 days (and counting) to comply with the Subpoena. Dr. Sung had also offered 3M more than five weeks to produce responsive documents and more than seven weeks to produce deposition testimony beyond the noticed date of November 17, 2023, which 3M twice rejected.

Further, 3M's protestations based on the purported unavailability of a single, unidentified witness and the upcoming holiday season are insufficient to resist compliance. 3M cannot postpone discovery indefinitely simply because it is inconvenient to 3M.

II. PROCEDURAL POSTURE

On November 3, 2023, Dr. Sung issued a third-party subpoena on 3M seeking documents and depositions (the "Subpoena") related to a pending action in the United States District Court for the Eastern District of Texas, *Chien-Min Sung v. Texas Instruments Incorporated*, 4:23-cv-00753-SDJ (E.D. Tex.) ("EDTX Litigation"). (*See* Ex. 1.)[1] Rather than responding to the Subpoena by the noticed deadline of November 17, 2023, 3M claimed that it was not provided sufficient time to respond. (*See* Ex. 2 at 4.) But 3M was given 14 days to comply with the Subpoena (Ex. 1 at 4)—a timeline that falls well within what many courts have considered presumptively reasonable for compliance by third parties. *See Cellspin Soft, Inc. v. FitBit, Inc.*, Case No. 17-cv-05928-YGR (KAW), slip op. at 5 (N.D. Cal. Sep. 13, 2021) ("Courts, however, have regularly held that at least ten days is a reasonable time to comply for a Rule 45 subpoena."); *see also Elliot v. Mission Tr. Servs., LLC*, No. 14 C 9625-JNC, 2015 U.S. Dist. LEXIS 45412, at *14 (N.D. Ill. Apr. 7, 2015) (*citing* a string of supporting cases in various courts and districts) ("Fed. R. Civ. P. 45(d)(2)(B) suggests that 14 days is the benchmark for time for compliance; and courts have found that fourteen days from the date of service is presumptively reasonable").

Rather than using this time to gather documents and prepare its corporate witness(es) for deposition, 3M chose to disregard its discovery obligation and instead improperly moved to

[1] All references to Exhibits in this Motion are to Exhibits to the co-filed Declaration of Alex Chan in Support of Movant Dr. Chien-Min Sung's Motion to Compel 3M Company's Response to Subpoena ("Chan Decl.").

quash the Subpoena in the United States District Court for the District of Minnesota ("Minnesota Motion"). *In re Chien-Min Sung Subpoena Upon 3M Company*, C.A. No. 23-mc-00104-JFD (D. Minn.). The 14-day deadline continues to accrue while this Motion (as well as the Minnesota Motion) remains pending, which affords 3M even more time to prepare and respond to the Subpoena. As of the date of filing this Motion, 3M still has refused to identify a date on which to produce the requested documents or make its corporate designee available for deposition.

III. ARGUMENT

A. This Court Has Jurisdiction Over the Subpoena

3M contends that the District of Minnesota, not this Court, has jurisdiction over the Subpoena because it "does not contemplate producing any one for a deposition who resides or works in Texas." (Ex. 4 at 10.) Rule 45 states that "[o]n timely motion, ***the court for the district where compliance is required*** must quash or modify a subpoena . . ." that fails to meet the rule's requirements. Fed. R. Civ. P. 45(d)(3). 3M does not dispute that the place of compliance on the face of the Subpoena for both responsive documents and testimony is 3M's ***own*** manufacturing facility in the Northern District of Texas (*i.e.*, Brownwood, Texas) where 3M regularly transacts business. (*See* Ex. 4 at 10.) This Court therefore has jurisdiction over the Subpoena under Rule 45. *CSS, Inc. v. Herrington*, Case No. 17-71, 354 F. Supp. 3d 702, 2017 WL 4750707, at *5-6 (N.D. Tex. Oct. 20, 2017) ("This Court takes the position that, for the purposes of a Rule 45(d)(2) or 45(d)(3) motion, the court or district 'where compliance is required' is determined by the location or 'place' for compliance identified on the subpoena as required by Rule 45(a)(1)(A)(iii).").

Rule 45 does not set the "place of compliance" based on who a subpoenaed party designates as a corporate witness and where that corporate witness "resides or works." If it were,

any third party could easily avoid complying with a properly served subpoena simply by designating a witness outside the "place of compliance" to testify.

Additionally, 3M does not dispute that Dr. Sung's Subpoena was properly served. Nor does 3M contend that it could not designate a witness outside of the District of Minnesota to testify pursuant to the Subpoena, and for good reason—3M is free to designate and prepare any corporate witness who can bind the company, including individuals inside and outside of this District. Nothing in Rule 45, nor the Subpoena itself, mandates 3M to designate a witness who must reside or work in the District of Minnesota. That 3M chose to designate a witness in that District does not unilaterally shift the enforcement power over the Subpoena to a court in that district and somehow remove this Court's jurisdiction explicitly authorized under Rule 45, as 3M advocates. It is simply "frivolous" for 3M to rest its jurisdictional argument solely on where 3M purports to designate its corporate witness for deposition while disregarding Brownwood, Texas as the place of compliance in the Subpoena. *Textile Computer Systems, Inc. v. Broadway National Bank d/b/a/ Broadway Bank, et. al.*, Case No. 6:21-cv-1050-ADA, at *4 (W.D. Tex. Nov. 9, 2022) (*citing* Fed. R. Civ. P. 45(d)(3) and cases in other districts) ("Unified's frivolous motion in California is no bar to this Court ruling. One day before a scheduled meet and confer, Unified filed an anticipatory motion to quash in the Northern District of California. ***That motion is frivolous: because the subpoenas specify Waco as the place of compliance, this Court is the proper forum for a motion to quash***.)

B. There is No Legal Basis for 3M to Not Comply with the Subpoena

1. The Subpoena Gave 3M Fourteen (14) Days to Respond, Which Many Courts Consider Presumptively Reasonable

In the Minnesota Motion, 3M does not identify any substantive problems in complying with the Subpoena's requests for document production or noticed deposition topics, nor does it

cite to any specific topics or discovery requests as being substantively improper. Rather, 3M's only basis for resisting compliance is its contention that it has not been provided sufficient time to comply with the Subpoena. 3M, however, had already been given 14 days to comply—a timeline that falls well within what many courts have considered presumptively reasonable for compliance by third parties. *See Cellspin Soft, Inc. v. FitBit, Inc.*, Case No. 17-cv-05928-YGR (KAW), slip op. at 5 (N.D. Cal. Sep. 13, 2021) ("Courts, however, have regularly held that at least ten days is a reasonable time to comply for a Rule 45 subpoena."); *see also Elliot v. Mission Tr. Servs.*, LLC, No. 14 C 9625-JNC, 2015 U.S. Dist. LEXIS 45412, at *14 (N.D. Ill. Apr. 7, 2015) (*citing* a string of supporting cases in various courts and districts) ("Fed. R. Civ. P. 45(d)(2)(B) suggests that 14 days is the benchmark for time for compliance; and courts have found that fourteen days from the date of service is presumptively reasonable"). This 14-day timeline continues to accrue while this Motion remains pending, which affords 3M even more time to prepare and respond to the Subpoena.

Despite multiple meet-and-confers between the parties, 3M had repeatedly refused to identify a firm date on which to produce the requested documents and deposition testimony. 3M's intent is clear—it wants to use its immense financial and legal resources to impose an indefinite delay on meeting its discovery obligation without regard to Rule 45 while imposing undue prejudice on Dr. Sung, an inventor over the age of 75 with limited financial resources (Chan Decl. at ¶ 4), from receiving the necessary third-party discovery from 3M to show infringement by the defendant in the EDTX Litigation that uses 3M's pad conditioners in manufacturing that defendant's accused products.

For example, during the parties' meet and confer on November 14, 2023, 3M made it clear to Dr. Sung that it was unwilling to provide a firm commitment to produce documents and

witnesses by a certain date—a point raised by Dr. Sung in a follow-up correspondence (See Ex. 2 at 4 ("While Dr. Sung is willing to work with 3M and agree to an extension where possible, Dr. Sung is unable to do so without a firm commitment from 3M to produce documents and witnesses by a certain date.").) On November 21, 2023, when prompted during the parties' meet and confer regarding this Motion, 3M "again refused to provide a date certain as to when 3M would comply with the subpoena." (Ex. 5 at 1.)

3M cites "school breaks, the holiday season, and year-end activities" (Ex. 4 at 12) as its purported justification to resist compliance of the Subpoena by the compliance deadline. None of these events and activities are legally recognized reasons to escape discovery obligations. If they were, it is difficult to imagine a scenario in which a court could deny a motion to quash where the subpoenaed party simply cites to summer/winter vacation or holidays to resist compliance. But what makes 3M's refusal to comply even more egregious in this case is that 3M attempts to delay compliance by at least ***two months*** and beyond. 3M was served with the Subpoena on November 3, 2023, and the holiday season does not end until January 1, 2024 at the earliest. If the celebration of Epiphany is included, the pause would last even longer, until January 5, 2024. But as will be discussed below, 3M had already rejected any effort to comply with the Subpoena by early January of 2024, all but reinforces 3M's intent to indefinitely delay discovery by Dr. Sung.

2. Dr. Sung Had, in Good Faith, Offered 3M Five Additional Weeks to Produce Documents and Seven Additional Weeks for Corporate Deposition, Which 3M Summarily Rejected

In response to 3M's claim that it could not comply with the noticed deadline, Dr. Sung initially offered to extend 3M's deadline to produce responsive documents by December 15, 2023 (*i.e.*, four additional weeks beyond the date of compliance on November 17, 2023). (Ex. 2 at 4.) 3M rejected this proposal. As a good faith compromise, Dr. Sung offered 3M another

week to produce responsive documents by December 22, 2023 (five additional weeks beyond the date of compliance on November 17, 2023) and to produce relevant testimony by January 5, 2024 (*i.e.*, seven additional weeks beyond the date of compliance). (*Id.* at 2.) 3M again rejected this proposal. (*Id.*) Dr. Sung had also offered to meet and confer with 3M to discuss the document requests and deposition topics during the week of November 13 and the week of November 20. (*See id.* at 3 (Dr. Sung "mentioned that we are available to meet and confer with 3M this week as well as next week").) 3M summarily rejected this proposal. (*See* Ex. 5 at 1 ("Plaintiff again proposed at today's meet and confer as well as the one held last Thursday, that the parties meet and confer today and tomorrow as well as anytime next week in the event 3M requires clarification as to the nature and scope of any of Dr. Sung's document requests and deposition topics—a proposal 3M rejected twice.").) Beyond its mere representation that it needs time to negotiate objections and prepare witnesses, 3M never cooperated and had offered no legitimate reason why it could not meet its discovery obligation and comply with the Subpoena under this proposed extended schedule (or *in between* "school breaks, the holiday season, and year-end activities"), particularly where Dr. Sung had made good faith efforts to accommodate 3M at every turn.

Even if 3M was not willing to comply with the Subpoena due to Thanksgiving in November and Christmas in December, 3M made no attempt to explain why it cannot produce responsive documents in between those dates. 3M also never explained why it is unable to prepare and produce a witness for deposition after the New Year on January 5, 2024. Dr. Sung had given 3M reasonable time to comply, and then some. The notion that 3M, the subpoenaed party, be given time to comply with the Subpoena should not be an open-ended license to delay discovery indefinitely.

For at least these reasons, should the Court retain jurisdiction over the Subpoena, deny 3M's Motion, and grant Dr. Sung's Cross Motion, it is respectfully requested that the Court compel 3M to produce all responsive documents within a week of its ruling and avail a corporate witness for deposition within two weeks of that ruling.

3. 3M Claims an "Impossible Burden" But Provides No Elements On Which the Court Could Determine Whether any Undue Burden Exists

3M argues that the Subpoena "imposes an impossible burden upon 3M Company," (Minnesota Motion at 11) but declines to identify with any specificity how the Subpoena is unduly burdensome other than for the same reasons it argues that it provides insufficient time to respond. The existence of other personal or business commitments during the time for compliance with the Subpoena does not constitute undue burden. *See VP Sales v. Guerra et al.*, No. 2:22-cv-00224, slip op. at 2 (S.D. Tex. May 17, 2023) (finding that a deponent's status as the "only person able to provide transportation to school for her young children" did not constitute an undue burden.). 3M's claim that "it is difficult for a non-party to produce an adequately prepared Rule 30(b)(6) designee on two-weeks' notice" (Ex. 4 at 11) is disingenuous because, as alluded to above, this 14-day timeline is presumptively reasonable and that Dr. Sung had already offered to extend 3M's deadline for both document production and deposition testimony by more than five and seven weeks, respectively, which 3M summarily rejected.

Nor do 3M's concerns regarding the Protective Order constitute an undue burden. The Protective Order in force in the overarching lawsuit explicitly limits access to Confidential Information to Qualified Persons which are defined as outside counsel of record for the parties, their employees and the court. Dr. Sung has also agreed to treat any information designated by 3M as confidential information as Protected Documents under the Protective Order and to limit their disclosure to counsel for TI and its employees and the Court accordingly. That is more than

sufficient to address any potential concerns regarding confidential information in 3M's possession, custody or control that is responsive to the Subpoena.

4. 3M Does Not Identify Its Purportedly Essential Witness Nor Explain Why No Alternative Witness Is Available

3M also attempts to excuse itself from its obligations pursuant to the Subpoena based on the purported unavailability of its corporate designee. (Ex. 4 at 11.) As an initial matter, the fact that 3M has identified a witness who will serve as corporate designee contradicts 3M's claims that it cannot prepare within the ample time remaining under the current schedule or Dr. Sung's proposed extended schedule. More importantly, Rule 45 does not recognize the unavailability of an individual witness as a reason to indefinitely delay compliance with a subpoena. There is no legitimate reason for a large and sophisticated corporation like 3M to justify delaying compliance based on the unavailability of a single witness when 3M does not dispute that there are other witnesses who are available for deposition during this time period.

Additionally, 3M's reliance on the unspecified "personal commitments" (Ex. 4 at 8) of this unidentified corporate representative should not be taken at face value. While 3M states that "the individual would most likely designate for any deposition is unavailable until early next year" (Ex. 4 at 8), 3M does not provide any basis for the Court to understand why the person alluded to is an essential witness, including such basic information as the person's name and title while working at 3M.

Moreover, 3M also does not represent that there are no other witnesses who have relevant knowledge and documents. In fact, 3M's email communications refer to the need for 3M Company "***to prepare any designee***" (Ex. 2 at 3), which suggests that 3M does not intend to rely on a single designee for all of the deposition topics. If that is the case, then the unavailability of a single witness does not explain why testimony cannot be timely provided on all other topics for

which 3M will designate a different witness.

Finally, without any explanation of why 3M's mystery designee is "the individual most likely able to help 3M Company and its attorneys understand the issues" (Ex. 4 at 11) or the subjects on which he has personal knowledge, Dr. Sung and this Court are without any basis to understand why this witness's testimony is essential or why he cannot be substituted or replaced by a different witness unencumbered by the same set of personal commitments.

It is axiomatic that the selected corporate designee need not be the most knowledgeable person—and, in fact, does not need any personal knowledge of the noticed topics as long as the selected corporate designee is adequately prepared to provide corporate testimony that binds the subpoenaed party. 3M cannot manufacture an undue burden where none exists based on a single employee's unavailability, particularly where it has made no showing that there are no other corporate designees available who could take his place and where 3M, a publicly traded company, has more than a single employee in its manufacturing facility in Brownwood, Texas.

IV. CONCLUSION

For all of the foregoing reasons, this Court should grant this Motion and compel 3M to substantially complete production of all responsive documents within a week of the Court's ruling and to produce relevant testimony within two weeks of the Court's ruling.

Dated: November 27, 2023

s/ Alex Chan
Alex Chan
Texas Bar No. 24108051
DEVLIN LAW FIRM LLC
1526 Gilpin Avenue
Wilmington, DE 19806
Telephone: (302) 449-9010
Facsimile: (302) 353-4251
achan@devlinlawfirm.com

Attorneys for Movant
CHIEN-MIN SUNG

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS

In re Chien-Min Sung Subpoena Upon 3M Company	C.A. No. 6:23-mc-2

DECLARATION OF ALEX CHAN IN SUPPORT OF MOVANT CHIEN-MIN SUNG'S MOTION TO COMPEL 3M COMPANY'S RESPONSE TO SUBPOENA

I, Alex Chan, Esq., declare as follows:

1. I am a partner at the Devlin Law Firm LLC. I am currently in good standing and licensed to practice in the State of Texas and the District Court for the Northern District of Texas.

2. I am counsel of record for Movant Dr, Chien-Min Sung ("Dr. Sung") in this action, and make this Declaration in support of Dr. Sung's contemporarily-filed Motion to Compel 3M Company's ("3M") Response to Subpoena.

3. The facts set forth herein are true to my personal knowledge, and if called upon to testify thereto, I could and would competently do so under oath.

4. I attest that Dr. Sung was born in 1947 and has limited financial resources.

5. Attached as Exhibit 1 to this Declaration is true and correct copy of the Subpoena served by Dr. Sung on 3M, dated November 3, 2023.

6. Attached as Exhibit 2 to this Declaration is true and correct copy of an email chain between counsel for Dr. Sung and counsel for 3M Company dated between November 14 and 16, 2023.

7. Attached as Exhibit 3 to this Declaration is true and correct copy of Dr. Sung's Opposition to 3M's Motion to Quash the Subpoena in the United States District Court for the District of Minnesota. *In re Chien-Min Sung Subpoena Upon 3M Company*, C.A. No. 23-mc-00104-JFD (D. Minn.).

8. Attached as Exhibit 4 to this Declaration is true and correct copy of 3M's Motion to Quash the Subpoena in the United States District Court for the District of Minnesota. *In re Chien-Min Sung Subpoena Upon 3M Company*, C.A. No. 23-mc-00104-JFD (D. Minn.).

9. Attached as Exhibit 5 to this Declaration is true and correct copy of an email chain between counsel for Dr. Sung and counsel for 3M Company dated between November 20 and 21, 2023.

I declare under penalty of perjury under the laws of the United States that to the best of my knowledge and recollection the foregoing is true and correct.

Executed this 27th day of November, 2023.

/s/ Alex Chan
Alex Chan

EXHIBIT 1

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
SHERMAN DIVISION

CHIEN-MIN SUNG, Plaintiff, v. TEXAS INSTRUMENTS INCORPORATED Defendant.	C.A. No. 4:23-cv-00753-SDJ DEMAND FOR JURY TRIAL

NOTICE OF SERVICE OF SUBPOENA TO TESTIFY AT A DEPOSTION
AND FOR PRODUCTION OF DOCUMENTS ON 3M COMPANY

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that pursuant to Rule 45 of the Federal Rules of Civil Procedure, Plaintiff CHIEN-MIN SUNG ("Dr. Sung" or "Plaintiff") intends to serve a subpoena to testify at a deposition and for the production of documents on 3M Company ("3M"). A copy of the subpoena is attached hereto.

Pursuant to Rule 45 of the Federal Rules of Civil Procedure, Plaintiff respectfully requests that on or before November 17, 2023, Saesol produce the documents described in Attachment A of the attached Subpoena to Plaintiff either electronically or at 4501 Highway 377 South Brownwood, Texas 76804. Additionally, Plaintiff requests that on December 1, 2023, or such other date as mutually agreed upon, 3M appear to testify at a deposition on topics described in Attachment A either remotely via videoconference, at 4501 Highway 377 South Brownwood, Texas 76804, or at a location to be agreed.

Dated: November 3, 2023

By: */s/ Alex Chan*

Alex Chan
achan@devlinlawfirm.com
DEVLIN LAW FIRM LLC
1526 Gilpin Avenue
Wilmington, Delaware 19806
Telephone: (302) 449-9010
Facsimile: (302) 353-4251

Attorney for Plaintiff,
Dr. Chien-Min Sung

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the above and foregoing document has been served on all counsel of record via email on November 3, 2023.

/s/ Alex Chan
Alex Chan

UNITED STATES DISTRICT COURT

for the

Eastern District of Texas

CHIEN-MIN SUNG *Plaintiff* v. TEXAS INSTRUMENTS INCORPORATED *Defendant*	))))))	Civil Action No. 4:23-cv-753-SDJ

SUBPOENA TO TESTIFY AT A DEPOSITION IN A CIVIL ACTION

To: 3M Company, c/o CORPORATION SERVICE CO., 251 LITTLE FALLS, WILMINGTON, DE 19808

(Name of person to whom this subpoena is directed)

☑ Testimony: YOU ARE COMMANDED to appear at the time, date, and place set forth below to testify at a deposition to be taken in this civil action. If you are an organization, you must promptly confer in good faith with the party serving this subpoena about the following matters, or those set forth in an attachment, and you must designate one or more officers, directors, or managing agents, or designate other persons who consent to testify on your behalf about these matters:

Place:	Date and Time:
Remote/Virtual (or 3M Company at 4501 Highway 377 South Brownwood, TX 76804 by mutual agreement)	11/17/2023 9:00 am

The deposition will be recorded by this method: Video and Stenographic

☑ *Production:* You, or your representatives, must also bring with you to the deposition the following documents, electronically stored information, or objects, and must permit inspection, copying, testing, or sampling of the material:

See Attachment A.

The following provisions of Fed. R. Civ. P. 45 are attached – Rule 45(c), relating to the place of compliance; Rule 45(d), relating to your protection as a person subject to a subpoena; and Rule 45(e) and (g), relating to your duty to respond to this subpoena and the potential consequences of not doing so.

Date: 11/03/2023

CLERK OF COURT

OR

	/s/Alex Chan
Signature of Clerk or Deputy Clerk	*Attorney's signature*

The name, address, e-mail address, and telephone number of the attorney representing *(name of party)* Plaintiff Dr. Chien-Min Sung, Ph.D., who issues or requests this subpoena, are:

Alex Chan, Devlin Law Firm LLC, 1526 Gilpin Ave, Wilmington, DE 19806, achan@devlinlawfirm.com, (302) 449-9010

Notice to the person who issues or requests this subpoena

If this subpoena commands the production of documents, electronically stored information, or tangible things before trial, a notice and a copy of the subpoena must be served on each party in this case before it is served on the person to whom it is directed. Fed. R. Civ. P. 45(a)(4).

Civil Action No. 4:23-cv-753-SDJ

PROOF OF SERVICE

(This section should not be filed with the court unless required by Fed. R. Civ. P. 45.)

I received this subpoena for *(name of individual and title, if any)* _____
on *(date)* _____ .

❒ I served the subpoena by delivering a copy to the named individual as follows: _____

_____ on *(date)* _____ ; or

❒ I returned the subpoena unexecuted because: _____

_____ .

Unless the subpoena was issued on behalf of the United States, or one of its officers or agents, I have also tendered to the witness the fees for one day's attendance, and the mileage allowed by law, in the amount of $ _____ .

My fees are $ _____ for travel and $ _____ for services, for a total of $ 0.00 .

I declare under penalty of perjury that this information is true.

Date: _____

_____
Server's signature

_____
Printed name and title

_____
Server's address

Additional information regarding attempted service, etc.:

ATTACHMENT A

You are hereby subpoenaed and commanded to appear to testify and produce the documents as requested below:

DEFINITIONS

When used in the below topics, the following definitions apply:

1. "3M," "You," or "Your" shall each mean and refer, individually and collectively, to 3M Company, and all of its corporate locations, and all predecessors, successors, assigns, parents, subsidiaries and divisions, affiliates, partners; and all past and present directors, officers, employees, agents, and representatives (including accountants, consultants, and attorneys) of any of the foregoing, and all persons acting, or purporting to act, on their behalf.

2. "Action" shall mean *Chien-Min Sung v. Texas Instruments Incorporated*, 4:23-cv-00753-SDJ (E.D. Tex.).

3. "TI" shall mean Texas Instruments Incorporated, as well as all predecessors, successors, assigns, parents, subsidiaries and divisions, affiliates, partners of any of the foregoing, and all persons acting, or purporting to act, on behalf of any of the foregoing.

4. "Samsung" shall mean Samsung Electronics Co. LTD., Samsung Electronics America, Inc., Samsung Semiconductor, Inc., and Samsung Austin Semiconductor LLC, as well as all predecessors, successors, assigns, parents, subsidiaries and divisions, affiliates, partners of any of the foregoing, and all persons acting, or purporting to act, on behalf of any of the foregoing.

5. "Defendant" or "Defendants" shall mean TI and Samsung.

6. "Asserted Patents" shall mean U.S. Patent Nos. 9,138,862 ("'862 Patent"), 9,724,802 ("'802 Patent"), and 8,974,270 ("'270 Patent").

7. "CMP" shall mean any chemical mechanical polishing or planarization for cutting, leveling, polishing, planarizing, and/or otherwise smoothing the surfaces, films, or layers of semiconductor wafers or substrates during, for example, the manufacture, fabrication, assembly and/or production of semiconductor systems, devices, components, and/or integrated circuits, such as that described on Your website at https://www.3m.com/3M/en_US/semiconductor-us/solutions/cmp-materials.

8. "Polishing pad" shall mean any disk, pad, substrate, device, tool, or system used to polish, planarize, or smoothen a surface, film, or layer of a semiconductor wafer or substrate during CMP, as described, for example, on Your website at https://www.3m.com/3M/en_US/p/c/electronics-components/cmp-materials/cmp-pads/i/electronics/semiconductor/.

9. "Pad Conditioner" or "Pad Dresser" shall mean any disk, pad, substrate, device, tool, or system used to cut, level, smoothen, dress, or condition a surface, film, or layer of a Polishing Pad in order to, for example, minimize pad wear and maintain consistent or uniform asperities of the Polishing Pad, as described, for example, on Your website at https://www.3m.com/3M/en_US/semiconductor-us/solutions/cmp-materials/.

10. "Pad Conditioning" or "Pad Dressing" shall mean a method or process by which a Polishing Pad is conditioned or dressed, including, without limitations, conditioning the polishing surface, removing polishing debris, and/or maintaining the surface roughness or asperities of the Polishing Pad.

11. "Conditioning Elements" shall mean any crystalline and/or polycrystalline materials (e.g., diamond, polycrystalline diamond, cubic boron nitride, polycrystalline cubic boron nitride, corundum, and sapphire), particles, grits, films, layers, segments, and/or fragments used or

configured to cut, level, smoothen, dress, or condition a surface, film, or layer of a Polishing Pad, where the Conditioning Elements are bonded, assembled, embedded, attached, or affixed to the Polishing Pad.

12. "Cutting Depth" shall mean the depth or height of asperities or grooves that are cut into a Polishing Pad when the Polishing Pad is conditioned or dressed.

13. "CMP Products" shall mean pads, disks/discs, plates, and/or substrates designed, developed, manufactured, installed, implemented, used, or otherwise configured for executing, performing, achieving, or carrying out cutting, leveling, dressing or conditioning a surface, film, or layer of a Polishing Pad, including, for example, Your Diamond Pad Conditioners as described on Your website at https://multimedia.3m.com/mws/media/667824O/design-characteristics-performance-of-diamond-pad-conditioners.pdf?fn=DesignCharDiaPadCond.pdf.

14. "Accused Products" shall mean, without limitation, semiconductor products and devices, such as amplifiers (e.g., current sense amplifiers, difference amplifiers, fully differential amplifiers, instrumentation amplifiers, operational amplifiers, programmable & variable gain amplifiers, and special function amplifiers), audio solutions (e.g., audio amplifiers, audio converters, audio interface ICs, and specialty audio ICs), clock & timing (e.g., clock buffers, clock generators, clock jitter cleaners & synchronizers, oscillators, real-time clocks (RTCs) & timers, RF PLLs & synthesizers), dies and wafers (e.g., amplifiers, data converters, interfaces, switches, voltage regulators, microcontrollers, x-ray detectors, controllers, comparators, processors, transceivers, receivers, temperature sensors, diodes, and current sources), data converters (e.g., analog-to-digital converters, digital potentiometers, digital-to-analog converters, and integrated/special function data converters), DLP products (imaging products such as near-infrared, near-UV, UV, and visible products, scan & machine vision products, automotive products

including display, exterior lighting and projection products, and array products such as array pico and array products, and spectroscopy & optical networking products), interface solutions (e.g., CAN & LIN transceivers & SBCs, circuit protection ICs, ethernet ICs, HDMI/DisplayPort/MIPI ICs, high-speed SerDes, I2 ICs, IO-Link & digital I/Os, LVDS/M-LVDS/PECL ICs, multu0switch detection interface ICs, optical networking ICs, PCIe, SAS & SATA ICs, RS-232 transceivers, RS-485 & RS-422 transceivers, SDI ICs, UARTs, and USB ICs), isolation (e.g., digital isolators, isolated ADCs, isolated amplifiers, isolated comparators, isolated gate drivers, isolated interface ICs, signal isolators, and solid-state relays), logic & voltage translation (e.g., buffers, drivers, & transceivers, flip-flops, latches, registers, logic gates, specialty logic ICs, and voltage translators and level shifters), microcontrollers & processors (e.g., ARM-based microcontrollers, C2000 real-time microcontrollers, MSP 430 microcontrollers, digital signal processors, and ARM-based processors), motor drivers (e.g., actuator drivers, brushed DC motor drivers, brushless D motor drivers, half-bridge drivers, isolated gate drivers, low-side drivers, optical-disk drivers, solenoid drivers, stepper motor drivers), power management (AC/DC and isolated DC/DC switch regulators, battery management ICs, DC/DC switching regulators, DDR memory power ICs, digital power ICs, LED drivers, Linear & low-dropout regulators, MOSFETS, multi-channel ICs, power-over ethernet ICs, power switches, sequencers, supervisor & reset ICs, USB power witches & charging port controllers, USB-type C & USB power delivery ICs, and voltage reference products), RF & microwave products (e.g., mixers, modulators, mmWave radar sensors, RF amplifiers, RF PLLs & synthesizers, RF power detectors, and wideband transceivers, receivers, and transmitters), sensors (humidity sensors, magnetic sensors, mmWave radar sensors, specialty sensors, and temperature sensors), switches & multiplexers (analog switches & mux, digital demux and decoders, digital mux and encoders, power switches, and protocol-specific switches & muxes),

and wireless connectivity products (e.g., Bluetooth products, multi-protocol products, sub-1 GHz products, thread products, Wi-Fi products, Wi-SUN products, and Zigbee products), and similar systems, products, devices, and integrated circuits.

15. "Person" shall mean any natural person or any business, proprietorship, firm, partnership, corporation, association, organization, or other legal entity. The acts of a Person shall include the acts of directors, officers, owners, members, employees, agents, attorneys, or other representatives acting on the Person's behalf.

16. The term "Documents" is defined, without limitation, to be synonymous in meaning and equal in scope to the usage of the phrase "documents or electronically stored information" in Federal Rule of Civil Procedure 34(a)(1)(A), and includes, without limitation, "writings," "recordings," and "photographs," both "originals" and "duplicates," as those terms are defined in Federal Rule of Evidence 1001. The term "Documents" specifically includes all electronic versions of any particular document and any associated metadata.

17. "Thing" shall be construed using the broadest possible construction under the Federal Rules of Civil Procedure.

18. The terms "sale" and "sold" means the transfer of title to property from one party to another and includes the granting of a license with respect to products containing software or firmware.

19. "Communication" shall mean any transmission of information in any context or situation by or between two or more persons by any means or medium whatsoever, whether in the form of an original, a draft, or a copy; whether stored in hard copy, electronically or digitally, or on tape; either orally or in writing, including but not limited to, conversations, correspondence, electronic mails, telexes, facsimile transmissions, telecopies, recordings in any medium of oral,

written, or typed communications, telephone or message logs, notes or memoranda relating to written or oral communications, and any translation thereof.

20. "Identify" and "identity" shall each mean:

a. as applied to an individual: to state the individual's full name, present or last known address and telephone number, present or last known employer, present or last known business address and telephone number, present and prior employment positions and corresponding dates of such positions, and a description of his or her present employment responsibilities;

b. as applied to a Person other than a natural person (including but not limited to any business or other entity): to state the Person's full name, place and date of incorporation or formation, principal place of business or activity, and the identity of the natural persons within that entity having knowledge of the matter with respect to which that entity is named;

c. as applied to a Document (whether or not any claim of privilege is made in respect thereof): to state the type of Document, the date of creation of the Document, the date of communication of the Document, the names and Identities of the individuals who drafted, authored, or signed the Document or to whom a copy thereof was addressed or sent, a summary of the subject matter of the Document, the number of pages of the Document, the present whereabouts of the Document, including, without limitation, all originals and copies, and the name and address of the present or last-known custodian of the Document;

d. as applied to a Thing (including, without limitation, any products or software manufactured, developed, or sold by You): to state the date that the Thing was

first utilized or made available for use in commerce, all versions, parts, or revision numbers or codes, all product names, and all team names or project titles used in connection with the design, development, testing, or engineering of that product or software;

e. as applied to a process: to state the date that the process was first used, the date that products or goods sold through the process were first sold, all numbers or codes used to refer to the process, including but not limited to, process revision numbers or codes, all process names, and all team names or project titles used in connection with the design, development, testing, or engineering of that process; or

f. as applied to a Communication: to state the type of the Communication, the date and the parties to such Communication, and if such Communication has been recorded in documentary form, to identify all Documents recording such Communication.

21. "Software" shall mean instructions, statements, procedures, modules, objects, libraries, subroutines, or programs written in a programming language, design description language or assembly language, including source code, firmware, or microcode, which includes, without limitation, source files, make files, intermediate output files, header files, resource files, library files, module definition files, map files, object files, linker files, browse information files, and debug files.

22. "Information" shall mean information in any form, including but not limited to, documentary, electronic, graphical, or tabular, and communicated by any means, including but not limited to, orally, in writing, or via electronic Communication.

23. "Describe," when used in relation to an act, event, instance, occasion, transaction, conversation, or Communication, shall mean: (1) to state the date and place thereof; (2) to identify the individual participants; (3) to summarize separately for each individual participant what was

said or done; and (4) to identify each Document used or prepared in connection therewith or making any reference thereto.

24. "Date" shall mean the exact date, if known, or the closest approximation to the exact date as can be specified, including, without limitation, the year, month, week in a month, or part of a month.

25. "Relate to," "related to," "relating to," or "concerning" shall mean in whole or in part, constituting, containing, embodying, reflecting, describing, involving, supporting, contradicting, evidencing, analyzing, identifying, mentioning, stating, referring directly or indirectly to, dealing with, or in any way pertaining to.

26. The term "possession" means all Information or Documents actually within Your (including any employee, consultant, aide or other representative (including without limitation attorneys and accountants) and any other Person acting or purporting to act on Your behalf or in concert with You) knowledge, possession, custody or control, and includes any temporary placing of possession, custody or control in any third party by any of the foregoing Persons.

27. As used herein, the singular form of a term shall be interpreted to include the plural and vice versa.

28. As used herein, the masculine form of a term shall be interpreted to include the feminine form and vice versa.

29. Except where the context does not permit, the term "including" shall be without limitation.

30. Except where the context does not permit, the terms "and" and "or" shall be both conjunctive and disjunctive.

31. "Any" means "any and all."

32. The term "Product" or "Products" means any and all components, subcomponents, auxiliary components, and accessory products.

33. If You object to any of the Document requests made herein, You must state a basis for said objection in Your response. If You intend to withhold any potentially responsive Document or redact any portion of a Document produced in response to this Subpoena as privileged, You must Identify the privilege being asserted in Your response.

INSTRUCTIONS

1. Each request shall be answered pursuant to Fed. R. Civ. P. Rule 45.

2. If You object to any portion of the subpoena, please state the grounds for the objection and the categories of information to which the objection applies. Please provide a response to the request to the extent that it is not deemed objectionable.

3. If You have no documents responsive to a particular subpoena request, please state that You have no such responsive documents.

4. Please produce documents: (1) as they are kept in the ordinary course of business, complete with the original file folders, binders or other containers in which they are stored (or legible copies of the labels from those folders, binders, or containers); or (2) organized according to document requests to which they are responsive.

5. Please affix production numbers to each page that You produce.

6. In lieu of making documents available for inspection and copying at the date and time specified on the face of the subpoena, You may produce exact copies of the requested documents on, or before, the date specified on the face of the subpoena directed to the attention of the issuing officer of the subpoena.

7. A Protective Order (Dkt. 8 ("PO")) has been entered in the above-captioned matter that contains provisions governing the disclosure of confidential information. A copy of the PO is enclosed herewith. The PO allows You to designate information that You consider confidential by placing the appropriate designation on each page of such document.

DOCUMENTS TO BE PRODUCED

REQUEST FOR PRODUCTION NO. 1

Documents sufficient to identify any and all CMP Products designed, developed, manufactured and/or sold by You since 2017.

REQUEST FOR PRODUCTION NO. 2

Documents sufficient to show the structure, profile, characteristic, and/or configuration of Your CMP Products, including the distribution, placement, and/or location of the Conditioning Elements in Your CMP Products.

REQUEST FOR PRODUCTION NO. 3

Documents sufficient to show the use, utilization, installation, implementation, and/or deployment of Your CMP Products in any manufacturing and/or fabrication facility owned, operated, or controlled by Defendant in connection with the manufacture, fabrication, and/or assembly of any and all systems, devices, components, and/or integrated circuits, including the Accused Products, including: (i) the identification of all versions and models of any such systems, devices, components, and/or integrated circuits; and (ii) the location of such use, utilization, installation, implementation, and/or deployment, including the location of any and all such manufacturing and/or fabrication facilities.

REQUEST FOR PRODUCTION NO. 4

Purchase or sales orders, invoices, purchase agreements, partnership agreements, license agreements, sales agreements, importation agreements, and/or supplier agreements between You and Defendant relating to Your CMP Products.

REQUEST FOR PRODUCTION NO. 5

Documents sufficient to show the height or height variation (e.g., in microns) of each

Conditioning Element in each of Your CMP Products, including the height as measured from the substrate of a CMP Product to the tip of a Conditioning Element.

REQUEST FOR PRODUCTION NO. 6

Documents sufficient to show the difference in height or height variation (e.g., in microns) between the highest or tallest Conditioning Element and the second highest or tallest Conditioning Element in each of Your CMP Products.

REQUEST FOR PRODUCTION NO. 7

Documents sufficient to show the height or height variation of the highest or tallest one percent (1%) of the Conditioning Elements in each of Your CMP Products, including the difference in height (e.g., in microns) between the highest or tallest one percent of the Conditioning Elements.

REQUEST FOR PRODUCTION NO. 8

Documents sufficient to show the difference in height or height variation (e.g., in microns) between the highest or tallest Conditioning Element, the second highest or tallest Conditioning Element, the 10th highest or tallest Conditioning Element, and the 100th highest or tallest Conditioning Element in each of Your CMP Products.

REQUEST FOR PRODUCTION NO. 9

Documents sufficient to show the Cutting Depth (e.g., in microns) of each of Your CMP Products.

REQUEST FOR PRODUCTION NO. 10

For each of Your CMP Products, documents sufficient to show the total number of Conditioning Elements that have a Cutting Depth of 10 microns or more when conditioning or dressing a Polishing Pad.

REQUEST FOR PRODUCTION NO. 11

Documents sufficient to show the total number of Conditioning Elements in each of Your CMP Products.

REQUEST FOR PRODUCTION NO. 12

For each of Your CMP Products, documents sufficient to show the total number of Conditioning Elements that are in physical contact with a Polishing Pad when conditioning or dressing the Polishing Pad.

REQUEST FOR PRODUCTION NO. 13

For each of Your CMP Products, documents sufficient to show the total number of Conditioning Elements that are not in physical contact with a Polishing Pad when conditioning or dressing the Polishing Pad.

REQUEST FOR PRODUCTION NO. 14

For each of Your CMP Products, documents sufficient to show the distance or spacing (e.g., in microns) between the Conditioning Elements in each of Your CMP Products.

REQUEST FOR PRODUCTION NO. 15

For each of Your CMP Products, documents sufficient to show the tip variation (e.g., in micron) between the highest tips of the Conditioning Elements in Your CMP Products.

REQUEST FOR PRODUCTION NO. 16

Documents sufficient to identify Your CMP Products that are double-sided or include two opposite sides having different sets of Conditioning Elements.

REQUEST FOR PRODUCTION NO. 17

Documents sufficient to show the percentage of a radius between an outer edge and a center point of a CMP Product that includes, or is occupied by, the Conditioning Elements.

REQUEST FOR PRODUCTION NO. 18

Documents relating to, or reflecting, any contract or agreement by You to indemnify, or to be indemnified by Defendant for patent infringement in connection with any use, utilization, installation, implementation, and/or deployment of Your CMP Products.

REQUEST FOR PRODUCTION NO. 19

Documents reflecting sales negotiations with, or sales, importation, delivery, shipment, or marketing of Your CMP Products to, Defendant between 2003 and the present.

REQUEST FOR PRODUCTION NO. 20

Documents relating to, or reflecting, any technical evaluation, testing, or inspection of Your CMP Products by Defendant.

REQUEST FOR PRODUCTION NO. 21

Documents sufficient to show how Your CMP Products are used, utilized, installed, implemented, and/or deployed during CMP.

REQUEST FOR PRODUCTION NO. 22

Documents related to, or reflecting, the obtaining, or attempting to obtain, of an intellectual property license related to Your CMP Products, including, but not limited to, communications with any Person regarding royalty rates, licensing fees, and license agreements.

REQUEST FOR PRODUCTION NO. 23

All non-privileged Documents that refer to Plaintiff or the Action, including communications with Defendant, communications between You and any third party, and minutes from Your Board of Directors meetings that mention Plaintiff or any of the Actions.

REQUEST FOR PRODUCTION NO. 24

All Documents that refer, or relate, to the Asserted Patents, any of the patent application(s) to which the Asserted Patents claim priority, or any named inventor(s) of the Asserted Patents.

REQUEST FOR PRODUCTION NO. 25

Documents relating to any efforts to design around, or otherwise avoid, any claims of the Asserted Patents.

REQUEST FOR PRODUCTION NO. 26

Documents sufficient to identify all entities, and the role played by such entities, including any of Your subsidiaries or affiliates or any third-party entity including Defendant, involved in the design, development, manufacture, fabrication, assembly, testing, importation, distribution, marketing, sales, and/or support of Your CMP Products.

DEPOSITION TOPICS

Topic No. 1. Explanation of the context or content of the documents that You produced, or are producing, in response to Ocean's Subpoena for Production of Documents.

Topic No. 2. The source and authenticity of any documents or information provided by You in response to the Requests for Production of Documents, including, without limitation, the processes, systems, Persons and locations that are involved in creating, generating, storing, and/or maintaining any of the produced documents as business records.

Topic No. 3. Your business or professional relationship[s] with the Defendant.

Topic No. 4. The design, development, structure, function, operation, and/or maintenance of Your CMP Products sold, leased, or provided to Defendant.

Topic No. 5. The design, development, structure, function, operation, and/or maintenance of Your CMP Products used by Defendant to manufacture, fabricate, and/or assemble any Accused Product.

Topic No. 6. Manufacturing or fabrication facilities owned, controlled, or operated by, or on behalf of, Defendant that use or deploy Your CMP Products.

Topic No. 7. Any sale of, lease of, or other financial arrangement relating to Your CMP Products sold, leased, or provided to Defendant, including any payments received by You related thereto and any payments in connection with the Accused Products, and the quantity sold, leased, or provided to Defendant.

Topic No. 8. Your warranty of product criteria, including, but not limited to, warranties as to debris removal rate; pad cut rate or cutting depth; dress time; diamond distribution, placement, and location; diamond shape, size, density, protrusion and structural profile; pad wear rate; polishing rate; pad contact area; cost and resource usage; and quality performance in connection with Your CMP Products.

Topic No. 9. Any contracts or agreements between You and any third party (including, but not limited to, customers, partners, distributors, and/or resellers) pertaining to the sale or lease of any of Your CMP Products, including, without limitation, the terms of such agreements.

Topic No. 10. The importation of, or intent to import, any of Your CMP Products into the United States by You or Defendant.

Topic No. 11. Commercial success of Your CMP Products, including: (a) revenues attributable to, the value of, or the benefits to You of Your CMP Products; (b) cost savings; (c) customer retention; and/or (d) customer attraction since 2017.

Topic No. 12. The value and the benefits of Your CMP Products to Your business, including, but not limited to, the direct and indirect costs, revenues, profits, royalties and

other consideration, as well as any monetary or nonmonetary benefit to You (including but not limited to increased goodwill) resulting directly or indirectly from Your CMP Products.

Topic No. 13. The effect, benefit, importance, or value of Your CMP Products to Your business, including its impacts on sales, costs, cost savings, customer retention, customer attraction, marketing, or revenues.

Topic No. 14. Pricing and cost for the design, development, implementation, configuration, and operation of Your CMP Products.

Topic No. 15. All facts and documents relating to contracts or agreements concerning sales, leases, services, warranties or shipment of Your CMP Products used for the manufacture, fabrication, and/or assembly of any system, device, component and/or integrated circuit, including any standard terms of such agreements since 2017, whether the agreements were negotiated in the United States, whether United States laws apply to them, whether the offer to sell was made in the United States, and whether the agreements provide for shipment of any product from, or outside, the United States.

Topic No. 16. Your provision of technical support for any customers, clients, users, operators, partners, distributors, and/or resellers relating to Your CMP Products, including, without limitation, the Persons providing such technical support, the means of providing such technical support, and locations from which such technical support is provided.

Topic No. 17. Your licensing or assigning of patents in any industry or market in which any of Your CMP Products.

Topic No. 18. Any action taken by You and/or Defendant to avoid infringement of the Asserted Patents.

Topic No. 19. The circumstances surrounding when You first became aware of each of the Asserted Patents or any of the inventions claimed in the Asserted Patents, and any actions taken as a result of that awareness, including any attempts to design around the Asserted Patents.

Topic No. 20. Any communications between You and Defendant concerning these Actions, Plaintiff, the Asserted Patents, or any of the Accused Products.

Topic No. 21. All facts and Documents relating to the name and geographic location of each of Your customers in connection with the use, utilization, installation, implementation, and/or deployment of Your CMP Products.

Topic No. 22. Your patent licensing policies and practices, including licensing in and licensing out practices, royalty rates, and royalty bases.

Topic No. 23. Patent royalties actually or customarily paid in the industry involving Your CMP Products.

Topic No. 24. Research, analyses, studies, evaluations, opinions, commercialization plans, revenue forecasts, and any other activity that You undertook, or are undertaking, to determine the past, current, or potential marketability, sales, distribution, revenues, costs, profits, pricing, packaging, market share, or end user perceptions of Your Manufacturing Equipment.

Topic No. 25. The extent of use or operation of Your CMP Products by Your customers or end users.

Topic No. 26. The creation, custody, retention, destruction, and storage of Documents and Information related to any of the above-listed topics.

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
SHERMAN DIVISION

CHIEN-MIN SUNG	§	
	§	
v.	§	CIVIL NO. 4:23-CV-753-SDJ
	§	
TEXAS INSTRUMENTS	§	
INCORPORATED	§	

PROTECTIVE ORDER
(Appendix A)

The Court, *sua sponte*, issues this Protective Order to facilitate document disclosure and production under the Local Rules of this Court and the Federal Rules of Civil Procedure. Unless modified pursuant to the terms contained in this Order, this Order shall remain in effect through the conclusion of this litigation.

In support of this order, the Court finds that:

1. Documents or information containing confidential proprietary and business information and/or trade secrets ("Confidential Information") that bear significantly on the parties' claims or defenses is likely to be disclosed or produced during the course of discovery in this litigation;
2. The parties to this litigation may assert that public dissemination and disclosure of Confidential Information could severely injure or damage the party disclosing or producing the Confidential Information and could place that party at a competitive disadvantage;
3. Counsel for the party or parties receiving Confidential Information are presently without sufficient information to accept the representation(s) made

by the party or parties producing Confidential Information as to the confidential, proprietary, and/or trade secret nature of such Confidential Information; and

4. To protect the respective interests of the parties and to facilitate the progress of disclosure and discovery in this case, the following Order should issue:

IT IS THEREFORE ORDERED THAT:

1. Documents or discovery responses containing Confidential Information disclosed or produced by any party in this litigation are referred to as "Protected Documents." Except as otherwise indicated below, all documents or discovery responses designated by the producing party as "Confidential" and which are disclosed or produced to the attorneys for the other parties to this litigation are Protected Documents and are entitled to Confidential Treatment as described below.
2. Protected Documents shall not include (a) advertising materials, (b) materials that on their face show that they have been published to the general public, or (c) documents that have submitted to any governmental entity without request for Confidential Treatment.
3. At any time after the delivery of Protected Documents, counsel for the party or parties receiving the Protected Documents may challenge the Confidential designation of all or any portion thereof by providing written notice thereof to counsel for the party disclosing or producing the Protected Documents. If the parties are unable to agree as to whether the confidential designation of

discovery material is appropriate, the party or parties receiving the Protected Documents shall certify to the Court that the parties cannot reach an agreement as to the confidential nature of all or a portion of the Protected Documents. Thereafter, the party or parties disclosing or producing the Protected Documents shall have ten (10) days from the date of certification to file a motion for protective order regarding any Protected Documents in dispute. The party or parties producing the Protected Documents shall have the burden of establishing that the disputed Protected Documents are entitled to confidential treatment. If the party or parties producing the Protected Documents do not timely file a motion for protective order, then the Protected Documents in dispute shall no longer be subject to Confidential Treatment as provided in this Order. All Protected Documents are entitled to Confidential Treatment pursuant to the terms of this Order unless and until the parties agree in writing to the contrary, a party fails to timely move for a protective order, or a contrary determination is made by the Court as to whether all or a portion of a Protected Document is entitled to Confidential Treatment.

4. Confidential Treatment means that Protected Documents and any information contained therein shall not be used or shown, disseminated, copied, or in any way communicated to anyone for any purpose whatsoever, except as provided for below:

    a. Protected Documents and any information contained therein shall be disclosed only to the following persons ("Qualified Persons"):

i. Outside counsel of record in this action for the party or party receiving Protected Documents or any information contained therein;

ii. Employees of such counsel (excluding experts and investigators) assigned to and necessary to assist such counsel in the preparation and trial of this action; and

iii. The Court.

b. Protected Documents and any information contained therein shall be used solely for the prosecution of this litigation.

5. Outside counsel of record for the party or parties receiving Protected Documents may create an index of the Protected Documents and furnish it to attorneys of record representing or having represented parties involved in litigation involving the claims alleged in this suit against the party or parties disclosing or producing the Protected Documents. The index may only identify the document, date, author, and general subject matter of any Protected Document, but may not reveal the substance of any such document. Counsel for the party or parties receiving Protected Documents shall maintain a current log of the names and addresses of persons to whom the index was furnished.

6. The term "copy" as used herein means any photographic, mechanical, or computerized copy or reproduction of any document or thing, or any verbatim transcript, in whole or in part, of such document or thing.

7. To the extent that Protected Documents or information contained therein are used in depositions, such documents or information shall remain subject to the provisions of this Order, along with the transcript pages of the deposition referring to the Protected Documents or information contained therein.
8. Any court reporter or transcriber who reports or transcribes deposition testimony in this action shall agree that all "confidential" information designated as such under this Order shall remain "confidential" and shall not be disclosed by them, except pursuant to the terms of this Order, and that any notes or transcriptions of such deposition testimony (and any accompanying exhibits) will be retained by the reporter or delivered to counsel of record.
9. Inadvertent or unintentional production of documents or information containing Confidential Information which are not designated "confidential" shall not be deemed a waiver in whole or in part of a claim for confidential treatment.
10. The party or parties receiving Protected Documents shall not under any circumstances sell, offer for sale, advertise, or publicize Protected Documents or any information contained therein.
11. After termination of this litigation, the provisions of this Order shall continue to be binding, except with respect to those documents and information that become a matter of public record. This Court retains and shall have continuing jurisdiction over the parties and recipients of the Protected Documents for

enforcement of the provisions of this Order following termination of this litigation.

12. Upon termination of this action by dismissal, judgment, or settlement, counsel for the party or parties receiving Protected Documents shall return the Protected Documents to the counsel for the party or parties disclosing or producing the Protected Documents. The party or parties receiving the Protected Documents shall keep their attorney work product which refers or relates to any Protected Documents. Attorney work product may be used in subsequent litigation provided that such use does not disclose Protected Documents or any information contained therein.

13. This Order shall be binding upon the parties and their attorneys, successors, executors, personal representatives, administrators, heirs, legal representatives, assigns, subsidiaries, divisions, employees, agents, independent contractors, or other persons or organizations over which they have control.

The Court anticipates that the parties may file a motion to modify the terms hereof with respect to the sharing of Protected Documents with experts and consultants, shifting the cost burden of production equitably, and other terms that may be reasonably required to protect a party as provided in Rule 26(b) or (c) of the Federal Rules of Civil Procedure.

Federal Rule of Civil Procedure 45 (c), (d), (e), and (g) (Effective 12/1/13)

(c) Place of Compliance.

(1) ***For a Trial, Hearing, or Deposition.*** A subpoena may command a person to attend a trial, hearing, or deposition only as follows:
(A) within 100 miles of where the person resides, is employed, or regularly transacts business in person; or
(B) within the state where the person resides, is employed, or regularly transacts business in person, if the person
(i) is a party or a party's officer; or
(ii) is commanded to attend a trial and would not incur substantial expense.

(2) ***For Other Discovery.*** A subpoena may command:
(A) production of documents, electronically stored information, or tangible things at a place within 100 miles of where the person resides, is employed, or regularly transacts business in person; and
(B) inspection of premises at the premises to be inspected.

(d) Protecting a Person Subject to a Subpoena; Enforcement.

(1) ***Avoiding Undue Burden or Expense; Sanctions.*** A party or attorney responsible for issuing and serving a subpoena must take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena. The court for the district where compliance is required must enforce this duty and impose an appropriate sanction—which may include lost earnings and reasonable attorney's fees—on a party or attorney who fails to comply.

(2) ***Command to Produce Materials or Permit Inspection.***
(A) *Appearance Not Required.* A person commanded to produce documents, electronically stored information, or tangible things, or to permit the inspection of premises, need not appear in person at the place of production or inspection unless also commanded to appear for a deposition, hearing, or trial.
(B) *Objections.* A person commanded to produce documents or tangible things or to permit inspection may serve on the party or attorney designated in the subpoena a written objection to inspecting, copying, testing, or sampling any or all of the materials or to inspecting the premises—or to producing electronically stored information in the form or forms requested. The objection must be served before the earlier of the time specified for compliance or 14 days after the subpoena is served. If an objection is made, the following rules apply:
(i) At any time, on notice to the commanded person, the serving party may move the court for the district where compliance is required for an order compelling production or inspection.
(ii) These acts may be required only as directed in the order, and the order must protect a person who is neither a party nor a party's officer from significant expense resulting from compliance.

(3) ***Quashing or Modifying a Subpoena.***

(A) *When Required.* On timely motion, the court for the district where compliance is required must quash or modify a subpoena that:

(i) fails to allow a reasonable time to comply;
(ii) requires a person to comply beyond the geographical limits specified in Rule 45(c);
(iii) requires disclosure of privileged or other protected matter, if no exception or waiver applies; or
(iv) subjects a person to undue burden.
(B) *When Permitted.* To protect a person subject to or affected by a subpoena, the court for the district where compliance is required may, on motion, quash or modify the subpoena if it requires:
(i) disclosing a trade secret or other confidential research, development, or commercial information; or
(ii) disclosing an unretained expert's opinion or information that does not describe specific occurrences in dispute and results from the expert's study that was not requested by a party.
(C) *Specifying Conditions as an Alternative.* In the circumstances described in Rule 45(d)(3)(B), the court may, instead of quashing or modifying a subpoena, order appearance or production under specified conditions if the serving party:
(i) shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship; and
(ii) ensures that the subpoenaed person will be reasonably compensated.

(e) Duties in Responding to a Subpoena.

(1) ***Producing Documents or Electronically Stored Information.*** These procedures apply to producing documents or electronically stored information:
(A) *Documents.* A person responding to a subpoena to produce documents must produce them as they are kept in the ordinary course of business or must organize and label them to correspond to the categories in the demand.
(B) *Form for Producing Electronically Stored Information Not Specified.* If a subpoena does not specify a form for producing electronically stored information, the person responding must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms.
(C) *Electronically Stored Information Produced in Only One Form.* The person responding need not produce the same electronically stored information in more than one form.
(D) *Inaccessible Electronically Stored Information.* The person responding need not provide discovery of electronically stored information from sources that the person identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the person responding must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the court may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of Rule 26(b)(2)(C). The court may specify conditions for the discovery.

(2) ***Claiming Privilege or Protection.***
(A) *Information Withheld.* A person withholding subpoenaed information under a claim that it is privileged or subject to protection as trial-preparation material must:
(i) expressly make the claim; and
(ii) describe the nature of the withheld documents, communications, or tangible things in a manner that, without revealing information itself privileged or protected, will enable the parties to assess the claim.
(B) *Information Produced.* If information produced in response to a subpoena is subject to a claim of privilege or of protection as trial-preparation material, the person making the claim may notify any party that received the information of the claim and the basis for it. After being notified, a party must promptly return, sequester, or destroy the specified information and any copies it has; must not use or disclose the information until the claim is resolved; must take reasonable steps to retrieve the information if the party disclosed it before being notified; and may promptly present the information under seal to the court for the district where compliance is required for a determination of the claim. The person who produced the information must preserve the information until the claim is resolved.

(g) Contempt.
The court for the district where compliance is required—and also, after a motion is transferred, the issuing court—may hold in contempt a person who, having been served, fails without adequate excuse to obey the subpoena or an order related to it.

For access to subpoena materials, see Fed. R. Civ. P. 45(a) Committee Note (2013).

EXHIBIT 2

Joel Glazer

From: Jeya Paul <JPaul@greeneespel.com>
Sent: Thursday, November 16, 2023 5:56 PM
To: Alex Chan
Cc: Mark L. Johnson; Sung-TI-DLF_Intl
Subject: RE: Sung v. Texas Instruments Inc. - Subpoena to 3M

Alex,

We'll be in touch shortly. But, as we have repeatedly made clear, there will not be a deposition tomorrow.

Thanks,

Jeya

From: Alex Chan <achan@devlinlawfirm.com>
Sent: Thursday, November 16, 2023 4:30 PM
To: Jeya Paul <JPaul@greeneespel.com>
Cc: Mark L. Johnson <MJohnson@greeneespel.com>; Sung-TI-DLF_Intl <Sung-TI-DLF_Intl@devlinlawfirm.com>
Subject: Re: Sung v. Texas Instruments Inc. - Subpoena to 3M

Jeya—

Please confirm by 5pm CT whether the parties have an agreement. We need to notify our deposition vendor whether 3M is proceeding with the noticed deposition. Your prompt response is appreciated.

Thanks much,
Alex

From: Alex Chan <achan@devlinlawfirm.com>
Date: Thursday, November 16, 2023 at 12:01 PM
To: Jeya Paul <JPaul@greeneespel.com>
Cc: Mark L. Johnson <MJohnson@greeneespel.com>, Sung-TI-DLF_Intl <Sung-TI-DLF_Intl@devlinlawfirm.com>
Subject: Re: Sung v. Texas Instruments Inc. - Subpoena to 3M

Jeya—

I have already stated that we are willing to reschedule the deposition to 1/5/24 but Dr. Sung is not willing to take the deposition "off the calendar." Rule 45 does not allow 3M to avoid deposition or set its own deposition schedule. If this is not acceptable, please confirm so that we can move to compel and notify the court that 3M is unwilling to provide a date on which to produce both documents and deposition testimony as requested by the subpoena.

Thanks much,
Alex

From: Jeya Paul <JPaul@greeneespel.com>
Date: Thursday, November 16, 2023 at 11:54 AM
To: Alex Chan <achan@devlinlawfirm.com>

Cc: Mark L. Johnson <MJohnson@greeneespel.com>, Sung-TI-DLF_Intl <Sung-TI-DLF_Intl@devlinlawfirm.com>
Subject: RE: Sung v. Texas Instruments Inc. - Subpoena to 3M

Alex,

As I have now stated multiple times, we cannot commit to any dates at this point before we have (a) served objections and the parties have had a chance to try to resolve them; and (b) 3M has had time to obtain input from appropriate client representatives to determine what material it has available that might be produced. We also note that almost every request seeks confidential information and the protective order you enclosed does not cover discovery from nonparties to the litigation. So, there is a lot to be resolved before we can commit to any production or deposition dates.

Again, I ask that you confirm that the deposition is off the calendar for tomorrow--without demanding that we make commitments we have already told you we cannot make. We can then reengage after you have had a chance to review our objections.

Thanks,

Jeya

From: Alex Chan <achan@devlinlawfirm.com>
Sent: Thursday, November 16, 2023 11:15 AM
To: Jeya Paul <JPaul@greeneespel.com>
Cc: Mark L. Johnson <MJohnson@greeneespel.com>; Sung-TI-DLF_Intl <Sung-TI-DLF_Intl@devlinlawfirm.com>
Subject: Re: Sung v. Texas Instruments Inc. - Subpoena to 3M

Jeya—

We will accept service of 3M's objection by email. As to the deposition, Dr. Sung is willing to reschedule the deposition to no later than 1/5/24 on the condition that 3M substantially completes its document collection and production by 12/22/23, two weeks before the deposition. This is one week more than what I initially proposed as a good faith compromise in order to provide 3M more time to produce the requested documents. Please confirm if 3M agrees.

Also, while Dr. Sung is not in any position to dictate who 3M should designate to testify, if the individual 3M intends to designate for this deposition is unavailable, it is advisable that a different witness who is available be designated instead. A corporate witness need not be someone with the most knowledge; a witness who can bind the company is sufficient. As such, that the witness 3M "would most likely designate . . . is unavailable" is not a proper justification to delay or resist discovery, nor does it permit 3M to set its own schedule without offering any certainty as to when it will fully comply with Dr. Sung's subpoena.

Thanks much,
Alex

From: Jeya Paul <JPaul@greeneespel.com>
Date: Thursday, November 16, 2023 at 10:26 AM
To: Alex Chan <achan@devlinlawfirm.com>
Cc: Mark L. Johnson <MJohnson@greeneespel.com>, Sung-TI-DLF_Intl <Sung-TI-DLF_Intl@devlinlawfirm.com>
Subject: RE: Sung v. Texas Instruments Inc. - Subpoena to 3M

Alex,

I wasn't trying to restate your proposal or our discussion. I was offering a new proposal—one that reflects the reality that we don't yet know how much time it will take to collect, review, and produce documents, so we cannot yet commit to a timeline for 3M's production.

Rather than continue to debate this, we will serve formal objections tomorrow. **Please confirm that you will accept service of papers related to this matter by email.** (If not, then we will serve any documents upon you by U.S. mail with a courtesy copy by email.) Once you have reviewed our objections, we can pick up the meet-and-confer process.

Meanwhile, will you agree to take the deposition off the calendar for tomorrow? We note that the notice you enclosed to parties to the litigation refers to a different date and party than the subpoena document itself. Also, due to personal circumstances, the individual 3M would most likely designate for any deposition is unavailable until early next year. Even if he were available today, we would need reasonable time to assert and attempt to resolve scope and other objections with you, and then to prepare any designee. I also assume you would want documents before taking a deposition. We would attempt to reschedule the deposition by mutual agreement, but both sides would reserve the right to seek judicial relief. **Let me know whether you agree the deposition is off the calendar for tomorrow.**

Thanks,

Jeya

From: Alex Chan <achan@devlinlawfirm.com>
Sent: Wednesday, November 15, 2023 9:42 PM
To: Jeya Paul <JPaul@greeneespel.com>
Cc: Mark L. Johnson <MJohnson@greeneespel.com>; Sung-TI-DLF_Intl <Sung-TI-DLF_Intl@devlinlawfirm.com>
Subject: Re: Sung v. Texas Instruments Inc. - Subpoena to 3M

Hi Jeya—

Dr. Sung disagrees with 3M's position. Rule 26(d)(1) governs party discovery, not third-party discovery. And Rule 45, which covers third-party discovery, does not prescribe any defense to a responding party for resisting third party discovery on the basis that the propounding party has not completed its Rule 26(f) conference. But as discussed during the call, this issue is moot now because the Rule 26(f) conference has been completed. Of course, Dr. Sung would be willing to consider re-serving the subpoena if 3M insists. In that case, however, it would be difficult to justify any extension for 3M to serve its responses and objections given that 3M has been on notice of the pending discovery since the beginning of November.

Also, your proposal does not accurately reflect what the parties discussed yesterday. Specifically, in exchange for Dr. Sung agreeing to the proposed extension for 3M to serve its objections and responses by 12/1 and produce the requested documents and witness(es) at a later date, I mentioned that 3M would need to at least agree to identifying those documents or document requests for which 3M will have decided to withhold on that same day in order to facilitate prompt judicial intervention where necessary. The same is true for deposition topics—to the extent 3M is not willing to produce a corporate witness to testify on a particular deposition topic, 3M would also notify us on that same day (i.e., 12/1).

Further, I mentioned that we are available to meet and confer with 3M this week as well as next week. I also stated that there is no legitimate reason for 3M to put off until the week of December 4, or almost three weeks from today and more than a month after the subpoena was served, before seeking clarification from Dr. Sung as to the nature and scope of any of the pending discovery requests. This makes sense particularly where, as here, you have already stated succinctly that 3M would not be able to produce any documents "until we understand the scope of relevancy and what 3M has that is responsive, relevant and reasonably available." This is why the parties should meet and confer now to the extent 3M needs clarification on any of Dr. Sung's document requests. Otherwise, it's not clear how 3M would be able to serve accurate and good faith responses and objections to Dr. Sung's subpoena.

Additionally, I made it abundantly clear that Dr. Sung has certain deadlines that require completion of this discovery in advance, including contentions-related deadlines. While Dr. Sung is willing to work with 3M and agree to an extension where possible, Dr. Sung is unable to do so without a firm commitment from 3M to produce documents and witnesses by a certain date. Absent such a commitment, 3M would be free to set its own production and deposition schedule. I suspect this is not your intent but this is the net result. That said, Dr. Sung's proposal still stands—he will agree to 3M's proposed extension up to 12/1 provided that 3M: (1) identify those responsive/non-privileged documents and testimony 3M intends to withhold from Dr. Sung on 12/1; and (2) substantially complete its document production by 12/15, which is a month from now and more than six weeks from when the subpoena was served. Dr. Sung believes this is a reasonable counteroffer and remains hopeful that the parties can resolve their differences on the production schedule. Otherwise, Dr. Sung intends to seek judicial relief on Friday and reserves all rights to recover fees and costs in connection with such a motion.

Thanks much,
Alex

From: Jeya Paul <JPaul@greeneespel.com>
Date: Wednesday, November 15, 2023 at 10:31 AM
To: Alex Chan <achan@devlinlawfirm.com>
Cc: Mark L. Johnson <MJohnson@greeneespel.com>
Subject: RE: Sung v. Texas Instruments Inc. - Subpoena to 3M

Alex,

Thanks for the call yesterday.

I had requested that your client agree to withdraw the subpoena served on 3M since it did not comply with F.R.C.P. 26(d)(1), which prevents a party from "seek[ing] discovery from any source before the parties have conferred as required by Rule 26(f)…" You indicated that the F.R.C.P. 26(f) conference would be occurring today (November 15). Assuming that is the case, 3M is amenable to trying to reach a compromise. You have served over 25 document requests and deposition topics in a multiple-patent case. As I emphasized, 3M needs adequate time, accounting for the upcoming holidays and travel schedules, to engage the appropriate client representatives to respond to your client's requests. We also cannot produce a knowledgeable witness for deposition until at least January; we certainly cannot produce a witness this Friday.

With that in mind, here is what we propose:

- 3M will provide substantive objections to your subpoena by December 1.
- 3M will confer with you to try to resolve those objections during the week of December 4.
- We will do our best to begin producing documents (to which no objections apply) by December 15. But until we understand the scope of relevancy and what 3M has that is responsive, relevant, and reasonably available, we cannot even begin to gather and review all documents that might be produced. So we cannot commit, at this stage, to a particular date for substantial completion of any document production.
- Subject to resolving objections to scope and topics of a Rule 30(b)(6) deposition, we will endeavor to make one or more witnesses available for a deposition in Minnesota in January 2024.

In light of the November 17 deadline in subpoena, please let us know by 4 p.m. today, whether this proposal is acceptable. If we cannot reach an agreement, we reserve all rights.

Best,

Jeya

From: Jeya Paul
Sent: Tuesday, November 14, 2023 10:49 AM
To: achan@devlinlawfirm.com
Cc: Mark L. Johnson <MJohnson@greeneespel.com>
Subject: Sung v. Texas Instruments Inc. - Subpoena to 3M

Hello Alex,

We have been retained by 3M in connection with the subpoena you served it in the Sung. V. Texas Instruments (E.D. Tex. 4:23-cv-00753) matter. I tried to reach you by phone, but am unable to get through or leave a message at the number listed on the subpoena. Can you please give me a call today at 612.373.8320?

Thanks so much.

Jeya

Jeya Paul
Partner
612.373.8320 direct
JPaul@greeneespel.com

GREENE ESPEL PLLP 222 South Ninth Street | Suite 2200 | Minneapolis, MN 55402-3362
612.373.0830 *phone* | 612.373.0929 *fax* | www.greeneespel.com

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EXHIBIT 3

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA

In re Chien-Min Sung Subpoena Upon 3M Company	C.A. No. 23-mc-00104-JFD

RESPONDENT CHIEN-MIN SUNG'S MEMORANDUM OF LAW IN OPPOSITION TO 3M COMPANY'S MOTION TO QUASH SUBPOENA AND IN SUPPORT OF CROSS-MOTION TO COMPEL AND FOR SANCTIONS

Dated: November 22, 2023

Alex Chan (*pro hac vice pending*)
DEVLIN LAW FIRM LLC
1526 Gilpin Avenue
Wilmington, DE 19806
Telephone: (302) 449-9010
tdevlin@devlinlawfirm.com
Counsel for Plaintiff
Dr. Chien-Min Sung

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I. INTRODUCTION

The Motion to Quash ("Mot." or "Motion") filed by Movant 3M Company ("3M") brings a claim for relief that according to the plain letter of Fed. R. Civ. P. 45 (d)(3)(B) should never have been brought in this Court. The subpoena ("Subpoena") issued by Respondent Dr. Chien-Min Sung ("Dr. Sung") to 3M names 3M's own manufacturing facility in the Northern District of Texas as the place of compliance; yet, 3M intentionally disregarded this fact and filed its Motion fully knowing that its challenge to the Subpoena should have been brought there. Also, as neither of 3M's counsel of record is barred in Texas, it appears that Minnesota was selected merely for 3M's convenience to counsel and 3M.

As a result of 3M's improperly filed motion, Dr. Sung, an individual inventor over the age of 75 and with limited financial resources, has been forced to incur unnecessary expenses in retaining counsel in Minnesota and opposing 3M's Motion. Should this Court find jurisdiction lacking over the Subpoena, Dr. Sung respectfully requests that the Court award him reasonable expenses, including attorney fees and costs, associated with responding to 3M's Motion.

To the extent the Court finds jurisdiction sufficient over the Subpoena, 3M still fails to meet its burden to show that the Subpoena is unduly burdensome or unreasonable because its Motion does not identify ***any*** deficiency in the Subpoena itself; instead, 3M complains only that it wants more time to respond to the Subpoena but does not wish to commit to any timeline or date on which to fully comply with the Subpoena. Rule 45 does not offer 3M any relief because 3M had already been given 14 days (and counting)

to comply with the Subpoena. Dr. Sung had also offered 3M more than five weeks to produce responsive documents and seven weeks to produce deposition testimony beyond the noticed date of November 17, 2023, which 3M twice rejected. Further, 3M's protestations based on the purported unavailability of a single, unidentified witness and the upcoming holiday season are insufficient to meet its burden on a motion to quash. 3M cannot postpone discovery indefinitely based on reasons which it has failed to disclose fully to either Dr. Sung or this Court.

For at least these reasons, should the Court retain jurisdiction and grant Dr. Sung's Cross Motion, it is respectfully requested that the Court compel 3M to produce all responsive documents within a week of its ruling and avail a corporate witness for deposition within two weeks of that ruling.

II. ARGUMENT

A. This Court Lacks Jurisdiction Over the Subpoena

The plain text of Rule 45 states that "[o]n timely motion, ***the court for the district where compliance is required*** must quash or modify a subpoena . . ." that fails to meet the rule's requirements. Fed. R. Civ. P. 45(d)(3). 3M does not dispute that the place of compliance on the face of the Subpoena is its own manufacturing facility in the Northern District of Texas (and Brownwood, Texas, more specifically) where 3M regularly transacts business. (*See* Doc. 4-1 at 117.)

Based on these facts, 3M has no reasonable basis to assert that this Court has jurisdiction over its Motion. *See In re Pork Antitrust Litig.*, Case No. 18-cv-1776 (JRT/HB), 2021 U.S. Dist. LEXIS 258229, at *23 (D. Minn. Sep. 3, 2021) (holding that

there is "no authority for the proposition that, absent consent or an order from the United States District Court for the Northern District of Texas finding exceptional circumstances and transferring the motion to quash to this District, this Court may usurp the role assigned to that court by Rule 45.")

3M's position that the Court has the power to quash the Subpoena simply because 3M's headquarters are located in this District (Mot. at 10) runs roughshod over the text of Rule 45 and seeks to impose a non-existent corporate exception to the mandates of the Federal Rules. Worst, 3M posits that it "does not contemplate producing any one for a deposition who resides or works in Texas" (*id.*) but does not demonstrate why it cannot do so. Indeed, Rule 45 does not set the "place of compliance" based on who a subpoenaed party designates as a corporate witness and where that corporate witness "resides or works." If it were, any third party could avoid complying with a properly served subpoena simply by designating a witness outside the "place of compliance" to testify.

Here, 3M does not dispute that Dr. Sung's Subpoena was properly served because the Subpoena clearly identifies 3M's ***own*** manufacturing facility in Brownwood, Texas as the "place of compliance" for both responsive documents and testimony, which satisfies Rule 45(c). Nor does 3M contend that it could not designate a witness outside of the District of Minnesota to testify pursuant to the Subpoena, and for good reason—3M is free to designate and prepare ***any*** corporate witness who can bind the company, including individuals outside of this District. Nothing in Rule 45, nor the Subpoena itself, mandates 3M to designate a witness who "resides or works" in this District. That 3M

chooses to do so is not a proper legal basis to confer this Court's jurisdiction over the Subpoena.

1. 3M's Cited Cases Are Inapposite

3M cites four cases purporting to support this Court's jurisdiction over the Subpoena but each of these cases recognizes that, at best, a court may assert jurisdiction over a foreign subpoena where the foreign subpoena ***fails*** to identify a place of compliance that meets the requirements of Rule 45. Here, even setting aside that these cases are not from this District and thus are not binding on this Court, these cases are inapplicable at least because the Subpoena has specified 3M's manufacturing facility in Brownwood, Texas where 3M regularly transacts business as a place of compliance. *C.f. Raap v. Brier & Thorn, Inc.*, No. 17-MC-3001, 2017 U.S. Dist. LEXIS 87004, at *8 (C.D. Ill. Jun. 7, 2017) ("Bank of Springfield asserts—and Plaintiff has not disputed—that it is located and regularly transacts business in Springfield, Illinois, and is not located within and does not regularly transact business within 100 miles of Madison, Wisconsin."); *Westfield v. Simpson*, No. 1:20-cv-01747-TWP-MG, 2022 U.S. Dist. LEXIS 163778, at *4-5 (S.D. Ind. Sep. 12, 2022) (denying a motion to compel where the subpoenaing party named its counsel's office as the place of compliance); *Europlay Capital Advisors, LLC v. Does*, 323 F.R.D. 628, 629 (C.D. Cal. 2018) (same); *Burnett v. Wahlburgers Franchising LLC*, 16 CV 4602 (WFK) (CLP), 2018 U.S. Dist. LEXIS 234797, at *5-6 (E.D.N.Y. Oct. 4, 2018) (same). Unequivocally, these cases stand for the relatively uncontroversial proposition that a court in another district may step in where

the court in the place of compliance named on the face of the subpoena has no jurisdiction at all. Such is not the case here.

Rather than complying with or challenging the Subpoena in the proper forum, 3M would have this Court assert its authority over it, ***even though it has not disputed, and indeed cannot dispute, that it regularly transacts business at the place of compliance named in the Subpoena***. 3M can identify no court that has extended its jurisdiction so far beyond the scope of Rule 45, and there is no legitimate reason for this Court to do so here. In fact, another court has already explicitly rejected the same argument made by 3M. *See Ocean Semiconductor LLC v. STMicroelectronics, Inc. (In re Subpoena to Advanced Micro Devices, Inc.)*, Case No. 22-mc-80146-VKD, 2022 U.S. Dist. LEXIS 130503, at *4 (N.D. Cal. July 22, 2022) (finding that *Europlay* did not authorize the filing of a motion to compel a subpoena in the district where the subpoenaed party's headquarters were located when the place of compliance was in another district).

Thus, 3M's speculative argument that it "does not contemplate producing any one for a deposition who resides or works in Texas" (Mot at 10) is a red-herring. The identity and location of a person who might serve as 3M's corporate designee is not relevant to where a motion to quash can be brought under Rule 45.

At a minimum, it would be appropriate for the Court to decline to assert its authority in deference to the prevailing rule in the Fifth Circuit, which is where the Subpoena originated and where the place of compliance is located. *See Schnelle v. Swift Tech. Servs. LLC*, CIVIL ACTION NO. 4:21-mc-02466, 2022 U.S. Dist. LEXIS 41490, at *3 (S.D. Tex. Mar. 9, 2022) ("An emerging consensus in the Fifth Circuit—or at least

among the district courts in Texas—follows the former line of authority, holding that the address listed on the subpoena determines the court of compliance.")

B. Even if Jurisdiction Exists, There Is No Legal Basis to Quash the Subpoena and the Court Should Grant Dr. Sung's Cross Motion to Compel

1. The Subpoena Gave 3M Fourteen (14) Days to Respond, Which Many Courts Consider Presumptively Reasonable

Even if the Court has jurisdiction over the Subpoena, it should still deny 3M's Motion. 3M does not identify any substantive problems in complying with the Subpoena's requests for document production or noticed deposition topics. The Motion does not cite to any specific topics or discovery requests as being improper. Rather, 3M's only basis for seeking to quash the Subpoena is its contention that it has not been provided sufficient time to comply with the Subpoena. 3M, however, had already been given 14 days (*see* Doc. 41 at 114-117) to comply—a timeline that falls well within what many courts have considered presumptively reasonable for compliance by third parties. *See Cellspin Soft, Inc. v. FitBit, Inc.*, Case No. 17-cv-05928-YGR (KAW), slip op. at 5 (N.D. Cal. Sep. 13, 2021), attached as Exhibit A[1] ("Courts, however, have regularly held that at least ten days is a reasonable time to comply for a Rule 45 subpoena."); *see also Elliot v. Mission Tr. Servs., LLC*, No. 14 C 9625-JNC, 2015 U.S. Dist. LEXIS 45412, at *14 (N.D. Ill. Apr. 7, 2015) (*citing* a string of supporting cases in various courts and

[1] All references to Exhibits in this Memorandum of Law are to Exhibits to the co-filed Declaration of Alex Chan in Support of Respondent Chien-Min Sung's Opposition to 3M Company's Motion to Quash Subpoena and Cross-Motion to Compel and for Sanctions ("Chan Decl.").

districts) ("Fed. R. Civ. P. 45(d)(2)(B) suggests that 14 days is the benchmark for time for compliance; and courts have found that fourteen days from the date of service is presumptively reasonable"). This 14-day timeline continues to accrue while this Motion remains pending, which affords 3M even more time to prepare and respond to the Subpoena.

Despite 3M's contention that it "simply needs reasonable time to state its objections, to confer on its concerns in an orderly fashion, to bring any unresolved issues to the Court for consideration, and to identify and prepare any deponents" (Mot. at 12), 3M had repeatedly refused to identify a firm date to produce the requested documents and deposition testimony. 3M's intent is clear—it wants to use this Motion to empower it to set its own production and deposition schedule without regard to Rule 45 while imposing undue prejudice on Dr. Sung, an inventor over the age of 75 with limited financial resources (Chan Decl. at ¶ 7), from its indefinite delay in fully complying with the Subpoena.

For example, during the parties' meet and confer on November 14, 2023, 3M made it clear that it was unwilling to provide a firm commitment to produce documents and witnesses by a certain date—a point raised by Dr. Sung in a follow-up correspondence (*See* Doc. 4-1 at 147) ("While Dr. Sung is willing to work with 3M and agree to an extension where possible, Dr. Sung is unable to do so without a firm commitment from 3M to produce documents and witnesses by a certain date.") On November 21, 2023, when prompted during the parties' meet and confer regarding this

Motion, 3M "again refused to provide a date certain as to when 3M would comply with the subpoena." (Ex. B at 1.)

In its Motion, 3M cites "school breaks, the holiday season, and year-end activities" (Mot. at 12) as its purported justification to resist compliance of the Subpoena by the compliance deadline. None of these are legally recognized reasons to escape discovery obligations. If they were, it is difficult to imagine a scenario in which a court could deny a motion to quash where the subpoenaed party simply cites to summer/winter vacation or holidays to resist compliance.

Here, 3M attempts to postpone compliance by at least ***two months*** and beyond. 3M was served with the Subpoena on November 3, 2023 and the holiday season does not end until January 1, 2024 at the earliest. If the celebration of Epiphany is included, the pause would last even longer, until January 5, 2024. But as will be discussed below, 3M had already rejected any effort to comply with the Subpoena by early January of 2024, all but reinforces 3M's intent to indefinitely delay discovery by Dr. Sung.

2. Dr. Sung Had, in Good Faith, Offered 3M Five Additional Weeks to Produce Documents and Seven Additional Weeks for Corporate Deposition, Which 3M Summarily Rejected

In response to 3M's claim that it could not comply with the noticed deadline, Dr. Sung initially offered to extend 3M's deadline to produce responsive documents by December 15, 2023 (*i.e.*, four additional weeks beyond the date of compliance on November 17, 2023). (Doc. 4-1 at 147.) 3M rejected this proposal. As a good faith compromise, Dr. Sung offered 3M another week to produce responsive documents by December 22, 2023 (*i.e.*, five additional weeks beyond the date of compliance on

November 17, 2023) and to produce relevant testimony by January 5, 2024 (*i.e.*, seven additional weeks beyond the date of compliance). (Doc. 4-1 at 145-46.) 3M still rejected this proposal. (*Id*. at 145.) Dr. Sung had also offered to meet and confer with 3M to discuss the document requests and deposition topics during the week of November 20 and the week of November 27. (Doc. 4-1 at 147; Ex. B at 1.) 3M summarily rejected this proposal. (*See* Doc. 4-1 at 147 (Dr. Sung "mentioned that we are available to meet and confer with 3M this week as well as next week") and Ex. B at 1 ("Plaintiff again proposed at today's meet and confer as well as the one held last Thursday, that the parties meet and confer today and tomorrow as well as anytime next week in the event 3M requires clarification as to the nature and scope of any of Dr. Sung's document requests and deposition topics—a proposal 3M rejected twice.").) Beyond its mere representation that it needs time to negotiate objections and prepare witnesses (Mot. at 9), 3M never cooperated and had offered no legitimate reason why it could not meet its discovery obligation and comply with the Subpoena under this proposed extended schedule, particularly where Dr. Sung had made good faith efforts to accommodate 3M at every turn.

Even if 3M was not willing to comply with the Subpoena due to Thanksgiving in November and Christmas in December, 3M made no attempt to explain why it cannot produce responsive documents in between those dates. 3M also never explained why it is unable to prepare and produce a witness for deposition *after* the New Year on January 5, 2024. Dr. Sung had given 3M reasonable time to comply, and then some. The notion that 3M, the subpoenaed party, be given time to comply with the Subpoena should not be

an open-ended license to delay discovery indefinitely. For at least these reasons, should the Court retain jurisdiction over the Subpoena, deny 3M's Motion, and grant Dr. Sung's Cross Motion, it is respectfully requested that the Court compel 3M to produce all responsive documents within a week of its ruling and avail a corporate witness for deposition within two weeks of that ruling.

3. 3M Claims an "Impossible Burden" But Provides No Elements On Which the Court Could Determine Whether any Undue Burden Exists

3M argues that the Subpoena "imposes an impossible burden upon 3M Company," (Mot. at 11) but declines to identify with any specificity how the Subpoena is unduly burdensome other than for the same reasons it argues that it provides insufficient time to respond. The existence of other personal or business commitments during the time for compliance with the Subpoena does not constitute undue burden. *See VP Sales v. Guerra et al*., No. 2:22-cv-00224, slip op. at 2 (S.D. Tex. May 17, 2023) attached as Exhibit C, (finding that a deponent's status as the "only person able to provide transportation to school for her young children" did not constitute an undue burden.). 3M's claim that "it is difficult for a non-party to produce an adequately prepared Rule 30(b)(6) designee on two-weeks' notice" (Mot. at 11) is disingenuous because, as alluded to above, Dr. Sung had already offered to extend the deadlines for both document production and deposition testimony by more than five and seven weeks, respectively, which 3M summarily rejected.

Nor do 3M's concerns regarding the Protective Order constitute an undue burden. The Protective Order in force in the overarching lawsuit explicitly limits access to

Confidential Information to Qualified Persons which are defined as outside counsel of record for the parties, their employees and the court. (Doc. 4-1 at 138.) Dr. Sung has also agreed to treat any information designated by 3M as confidential information as Protected Documents under the Protective Order and to limit their disclosure to counsel for TI and its employees and the Court accordingly. That is more than sufficient to address any potential concerns regarding confidential information in 3M's possession, custody or control that is responsive to the Subpoena.

4. 3M Does Not Identify Its Purportedly Essential Witness Nor Explain Why No Alternative Witness Is Available

3M also attempts to excuse itself from its discovery obligations pursuant to the Subpoena based on the purported unavailability of its corporate designee. (Mot. at 8.) As an initial matter, the fact that 3M has identified a witness who will serve as corporate designee contradicts 3M's claims that it cannot prepare within the ample time remaining under the current schedule or Dr. Sung's proposed extended schedule. More importantly, Rule 45 does not recognize the unavailability of an individual witness as a reason to indefinitely delay compliance with a subpoena. There is no legitimate reason for a large and sophisticated corporation like 3M to justify delaying compliance based on the unavailability of a single witness when 3M does not dispute that there are other witnesses who are available for deposition during this time period.

Additionally, 3M's reliance on the unspecified "personal commitments" (Mot. at 8) of this unidentified corporate representative should not be taken at face value. While 3M states that "the individual would most likely designate for any deposition is

unavailable until early next year" (Mot. at 11), 3M does not provide any basis for the Court to understand why the person alluded to is an essential witness, including such basic information as the person's name and title while working at 3M.

Moreover, and as alluded to above, 3M does not represent that there are no other witnesses available. In fact, 3M's Motion expressly refers to "the need for 3M Company . . . ***to prepare its witnesses***" (Mot. at 12), which suggests that 3M does not intend to rely on a single designee for all of the deposition topics. If that is the indeed case, then the unavailability of a single witness does not explain why testimony cannot be timely provided on all other topics for which a different witness will be designated.

Finally, without any explanation of why 3M's mystery designee is "the individual most likely able to help 3M Company and its attorneys understand the issues" (Mot. at 11) or the subjects on which he has personal knowledge, Dr. Sung and this Court are without any basis to understand why this witness's testimony is essential or why he cannot be substituted or replaced by a different witness unencumbered by the same set of personal commitments.

In that regard, Rule 45 (and Rule 30(b)(6)) does not mandate a "knowledgeable" witness; 3M only needs to designate a witness who can testify and bind the company. There is no legal requirement that a witness who is (most) knowledgeable must be designated. *See Prairie River Home Care, Inc. v. Procura, LLC*, Case No. 17-cv-5121 (JRT/HB), 2019 U.S. Dist. LEXIS 247642, at *59 (D. Minn. Aug. 15, 2019) ("Even if Walles and Junker could have been described as the individuals most knowledgeable within the organization on the topics for which they were designated (which, as to nearly

every topic, they clearly were not), that is not the obligation Rule 30(b)(6) imposes.") 3M cannot manufacture an undue burden where none exists based on a single employee's unavailability, particularly where it has made no showing that there are no other corporate designees available who could take his place.

C. Sanctions Are Warranted for 3M's Baseless Motion

As argued in Section A above, 3M's choice to file its Motion in this District was supported only by its apparently willful misreading of non-binding caselaw, while flagrantly ignoring contrary authorities from this District. 3M's attempt to argue that its intention to produce a witness who resides in Minnesota (Mot. at 8, 10) favors this Court's jurisdiction was not supported by any authority and is not a basis for filing a motion to quash a subpoena in the wrong district. Indeed, given that neither of 3M's counsel of record is barred in Texas, it appears that Minnesota was selected merely for its convenience to counsel and 3M.

The Court should sanction 3M for this improperly-brought Motion by "requir[ing] [3M and its counsel], or both, to pay [Dr. Sung] reasonable expenses incurred in making the motion, including attorney's fees." Fed. R. Civ. P. 37(a)(5)(B); *see, e.g.*, *Cardona v. Mohabir*, 14 Civ. 1596 (PKC), 2014 U.S. Dist. LEXIS 62637, at *12-13 (S.D.N.Y. May 6, 2014) ("[I]nitially filing in the wrong district with the expectation that a party would then move to transfer to the proper district—or the Court would do so on its own initiative—does not promote the 'just, speedy, and inexpensive determination' of an action.").

As a result of 3M's improperly filed motion, Dr. Sung has been forced to unnecessarily consume significant resources to obtain discovery to which he is entitled, including but not limited to the expenses incurred for filing this brief and retaining counsel in Minnesota. Dr. Sung respectfully requests that the Court award him all reasonable expenses, including attorney fees and costs, associated with responding to 3M's Motion.

III. CONCLUSION

For all of the foregoing reasons, the Court should deny 3M's Motion to Quash the Subpoena and grant Dr. Sung's Cross-Motion to Compel and for Sanctions.

Dated: November 22, 2023

s/ Jessica M. A. Thomas
David R. Fairbairn (No. 28,125)
Jessica M. A. Thomas (No. 395,245)
KINNEY & LANGE, P.A.
333 S. 7th Street, Suite 2700
Minneapolis, MN 55402-2438
Email: drfairbairn@kinney.com
jthomas@kinney.com
Telephone: (612) 339-1863
Facsimile: (612) 339-6580

Alex Chan (*pro hac vice pending*)
DEVLIN LAW FIRM LLC
1526 Gilpin Avenue
Wilmington, DE 19806
Telephone: (302) 449-9010
Facsimile: (302) 353-4251
achan@devlinlawfirm.com

Attorneys for Respondent
CHIEN-MIN SUNG

EXHIBIT 4

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA

	Case No. 23-mc-104
In re Chien-Min Sung Subpoena Upon 3M Company	**MEMORANDUM IN SUPPORT OF MOTION TO QUASH OR MODIFY SUBPOENA**

3M Company moves to quash or modify a non-party deposition subpoena served upon it by Plaintiff Chien-Min Sung in patent litigation pending in the Eastern District of Texas. Plaintiff served the subpoena on November 3, 2023. The subpoena demands that 3M Company produce one or more Rule 30(b)(6) witnesses on November 17, 2023—prepared on some twenty-six separate topics relating to multiple products, multiple patents, highly technical issues, and sales records dating back more than twenty years. It is impossible for 3M Company to comply with this subpoena as written.

Rather than agreeing to work through 3M Company's concerns in an orderly fashion, Plaintiff has insisted that the deposition go forward on November 17, 2023, unless 3M Company agrees to produce documents responsive to the subpoena by December 22, 2023 and produce witnesses by January 5, 2024. 3M Company cannot make such commitments before it has stated and resolved its

objections to the scope of the subpoena, reviewed potentially responsive documents, and had the opportunity to meet with potential witnesses to understand what preparation they will need and what dates they can accommodate. All of this is particularly challenging, given year-end activities and upcoming holidays.

This leaves 3M Company with no choice but to seek the Court's assistance by quashing the subpoena or, at a minimum, modifying it to give 3M reasonable time to state and resolve any objections to Plaintiff's document requests and deposition topics, to identify and adequately prepare witnesses, and otherwise to comply without being subjected to undue burden.

FACTS AND PROCEDURAL HISTORY

3M Company is a diversified manufacturing company with its headquarters in Maplewood, Minnesota. Snustad Dec. ¶ 2. Among its many products, 3M Company manufactures and sells a range of chemical mechanical planarization products ("CMP Products") used in the manufacture of semiconductors. *Id.* ¶ 3. CMP Products include specially prepared polishing pads, pad conditioners, and other materials used to polish and planarize (i.e., smooth) semiconductor wafers to ensure that they are flat and free of extraneous material before other semiconductor layers are placed. *Id.*

3M Company sells CMP Products to various semiconductor manufacturers for use in their manufacturing processes. *Id.* ¶ 4. 3M Company manufactures and

sells many different CMP Products. *Id.* ¶ 5. Different manufacturers purchase different CMP Products from 3M Company (or other competitors) depending upon their specific needs. *Id.*

On August 21, 2023, Plaintiff Chien-Min Sung commenced a patent lawsuit against Texas Instruments in the Eastern District of Texas (Case No. 4:23-cv-00753). Paul Dec. Ex. 1 (Complaint). The complaint asserts that Texas Instruments has purchased (and used to manufacture products that Texas Instruments then sells) various CMP Products from multiple manufacturers, including 3M Company. *Id.* ¶¶ 5 – 9. The complaint asserts that Texas Instrument's activities violate Plaintiff's rights under U.S. Patent Numbers 8,974,270; 9,138,862; and 9,724,802. *Id.* ¶ 19 – 98. The complaint does not name 3M Company as a defendant. *See generally id.*

After a series of agreed extensions, Texas Instruments answered the complaint and asserted counterclaims on October 16, 2023. *See* Paul Dec. Exs. 2 and 3. The court in the underlying matter has set an initial Rule 16 case management conference for January 3, 2024. Paul Dec. Ex. 4.

On November 3, 2023, Plaintiff served a subpoena upon 3M Company in Case No. 4:23-cv-00753 purporting to command 3M to produce documents and deponents by November 17, 2023. Paul Dec. Ex. 5. The subpoena defines CMP Products to mean "pads, disks/discs, plates, and/or substrates designed,

developed, manufactured, installed, implemented, used, or otherwise configured for executing, performing, achieving, or carrying out cutting, leveling, dressing or conditioning a surface, film, or layer of a Polishing Pad . . ." *Id.* at definition 13. It defines "Defendant" and "Defendants" to mean *both* Texas Instruments and *Samsung*, even though Samsung is not a party to Case No. 4:23-cv-00753. It purports to command 3M Company to produce twenty-six broad categories of documents—none of which is limited to the CMP Products 3M sells to Texas Instruments (or even to non-party Samsung). *See generally id.* at RFPs 1 to 26. And it purports to demand documentation regarding 3M Company's sales of these products dating back to 2003, *see id.*, even though the earliest of the asserted patents did not issue until 2015. *See* Ex. 1 (Complaint) ¶¶ 19, 21, 23.

Since receiving the subpoena, undersigned counsel has conferred repeatedly with Plaintiff's attorney in an attempt to secure an extension of time to serve objections to Plaintiff's requests for the production of documents. *See generally* Paul Dec. Ex. 6. Plaintiff's counsel refused, and so undersigned counsel is in the process of preparing written objections for service on November 17, 2023. (As a result, 3M Company's objections to the document requests are not before the Court at this time.)

As relevant to the present motion, the November 3, 2023 subpoena also demands that 3M Company produce one or more witnesses for deposition in Texas

on November 17, 2023 at 9am. *See* Ex. 5. It demands that 3M Company "designate one or more officers, directors, or managing agents, or designate other persons who consent to testify on your behalf" regarding a list of twenty-six separate deposition topics, as follows:

> **Topic No. 1**. Explanation of the context or content of the documents that You produced, or are producing, in response to Ocean's Subpoena for Production of Documents.
>
> **Topic No. 2**. The source and authenticity of any documents or information provided by You in response to the Requests for Production of Documents, including, without limitation, the processes, systems, Persons and locations that are involved in creating, generating, storing, and/or maintaining any of the produced documents as business records.
>
> **Topic No. 3**. Your business or professional relationship[s] with the Defendant.
>
> **Topic No. 4**. The design, development, structure, function, operation, and/or maintenance of Your CMP Products sold, leased, or provided to Defendant.
>
> **Topic No. 5**. The design, development, structure, function, operation, and/or maintenance of Your CMP Products used by Defendant to manufacture, fabricate, and/or assemble any Accused Product.
>
> **Topic No. 6**. Manufacturing or fabrication facilities owned, controlled, or operated by, or on behalf of, Defendant that use or deploy Your CMP Products.
>
> **Topic No. 7**. Any sale of, lease of, or other financial arrangement relating to Your CMP Products sold, leased, or provided to Defendant, including any payments received by You related thereto and any payments in connection with the Accused Products, and the quantity sold, leased, or provided to Defendant.
>
> **Topic No. 8**. Your warranty of product criteria, including, but not limited to, warranties as to debris removal rate; pad cut rate or

cutting depth; dress time; diamond distribution, placement, and location; diamond shape, size, density, protrusion and structural profile; pad wear rate; polishing rate; pad contact area; cost and resource usage; and quality performance in connection with Your CMP Products.

Topic No. 9. Any contracts or agreements between You and any third party (including, but not limited to, customers, partners, distributors, and/or resellers) pertaining to the sale or lease of any of Your CMP Products, including, without limitation, the terms of such agreements.

Topic No. 10. The importation of, or intent to import, any of Your CMP Products into the United States by You or Defendant.

Topic No. 11. Commercial success of Your CMP Products, including: (a) revenues attributable to, the value of, or the benefits to You of Your CMP Products; (b) cost savings; (c) customer retention; and/or (d) customer attraction since 2017.

Topic No. 12. The value and the benefits of Your CMP Products to Your business, including, but not limited to, the direct and indirect costs, revenues, profits, royalties and other consideration, as well as any monetary or nonmonetary benefit to You (including but not limited to increased goodwill) resulting directly or indirectly from Your CMP Products.

Topic No. 13. The effect, benefit, importance, or value of Your CMP Products to Your business, including its impacts on sales, costs, cost savings, customer retention, customer attraction, marketing, or revenues.

Topic No. 14. Pricing and cost for the design, development, implementation, configuration, and operation of Your CMP Products.

Topic No. 15. All facts and documents relating to contracts or agreements concerning sales, leases, services, warranties or shipment of Your CMP Products used for the manufacture, fabrication, and/or assembly of any system, device, component and/or integrated circuit, including any standard terms of such agreements since 2017, whether the agreements were negotiated in the United States, whether United States laws apply to them, whether the offer to sell was made in the

United States, and whether the agreements provide for shipment of any product from, or outside, the United States.

Topic No. 16. Your provision of technical support for any customers, clients, users, operators, partners, distributors, and/or resellers relating to Your CMP Products, including, without limitation, the Persons providing such technical support, the means of providing such technical support, and locations from which such technical support is provided.

Topic No. 17. Your licensing or assigning of patents in any industry or market in which any of Your CMP Products.

Topic No. 18. Any action taken by You and/or Defendant to avoid infringement of the Asserted Patents.

Topic No. 19. The circumstances surrounding when You first became aware of each of the Asserted Patents or any of the inventions claimed in the Asserted Patents, and any actions taken as a result of that awareness, including any attempts to design around the Asserted Patents.

Topic No. 20. Any communications between You and Defendant concerning these Actions, Plaintiff, the Asserted Patents, or any of the Accused Products.

Topic No. 21. All facts and Documents relating to the name and geographic location of each of Your customers in connection with the use, utilization, installation, implementation, and/or deployment of Your CMP Products.

Topic No. 22. Your patent licensing policies and practices, including licensing in and licensing out practices, royalty rates, and royalty bases.

Topic No. 23. Patent royalties actually or customarily paid in the industry involving Your CMP Products.

Topic No. 24. Research, analyses, studies, evaluations, opinions, commercialization plans, revenue forecasts, and any other activity that You undertook, or are undertaking, to determine the past, current, or potential marketability, sales, distribution, revenues, costs,

> profits, pricing, packaging, market share, or end user perceptions of Your Manufacturing Equipment.
>
> **Topic No. 25**. The extent of use or operation of Your CMP Products by Your customers or end users.
>
> **Topic No. 26**. The creation, custody, retention, destruction, and storage of Documents and Information related to any of the above-listed topics.

Id. at A-16 to A-18.

3M Company's counsel has requested that Plaintiff agree to postpone the requested deposition. *See* Paul Dec. Ex. 6. Among other things, she expressed that "the individual 3M would most likely designate for any deposition is unavailable until early next year." *Id.* She made this point because she understands the individual most knowledgeable about the issues encompassed by the subpoena recently retired from 3M Company. Paul Dec. ¶ 9. She understands this individual cannot be available to 3M Company due to personal commitments until early 2024. *Id.* That individual resides in Minnesota. *Id.*

Beyond this, 3M Company's counsel expressed to Plaintiff's attorney that even if a knowledgeable witness were available today, "we would need reasonable time to assert and attempt to resolve scope and other objections with you, and then to prepare any designee." *Id.* Ex. 6. For these reasons, 3M Company's counsel asked Plaintiff's attorney to take the deposition off the calendar for November 17, 2023. *Id.* She noted that "[w]e would attempt to reschedule the deposition by

mutual agreement, but both sides would reserve the right to seek judicial relief." *Id.*

Shortly before 3M Company filed this motion, Plaintiff's attorney responded that Plaintiff is "willing to reschedule the deposition to no later than 1/5/24 on the condition that 3M substantially completes its document collection and production by 12/22/23, two weeks before the deposition." *Id.* Ex. 6. This is a Hobson's choice. As 3M Company's counsel explained (again) in response, "we cannot commit to any dates at this point before we have (a) served objections and the parties have had a chance to try to resolve them; and (b) 3M has had time to obtain input from appropriate client representatives to determine what material it has available that might be produced. We also note that almost every request seeks confidential information and the protective order you enclosed does not cover discovery from nonparties to the litigation. So, there is a lot to be resolved before we can commit to any production or deposition dates." *Id.* Ex. 6.

3M Company's attorney therefore asked that Plaintiff's counsel "confirm that the deposition is off the calendar for tomorrow [i.e., for November 17, 2023]—without demanding that we make commitments we have already told you we cannot make. We can then reengage after you have had a chance to review our objections." *Id.* Plaintiff's counsel responded that if this was 3M Company's position, then motions practice would be necessary. *Id.*

ARGUMENT

An attorney serving a subpoena "must take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena." Fed. R. Civ. P. 45(d). Under the rules, "[t]he court for the district where compliance is required must enforce this duty and impose an appropriate sanction—which may include lost earnings and reasonable attorney's fees—on a party or attorney who fails to comply." *Id.*

Here, 3M Company maintains its corporate headquarters in Maplewood, Minnesota, and 3M Company does not contemplate producing any one for a deposition who resides or works in Texas. As such, the place of any compliance relative to the deposition subpoena will be here in Minnesota. For this reason, even though the subpoena purports to compel 3M Company to produce a witness for deposition (in person or remotely) in Texas, this Court has authority to hear a motion to quash or modify the subpoena. *See, e.g., Raap v. Brier & Thorn, Inc.*, No. 17-MC-3001, 2017 WL 2462823, at *2-3 (C.D. Ill. July 7, 2017) ("The purpose of protecting nonparties is defeated if a party could demand compliance in a location more than 100 miles from where the nonparty resides, is employed, or regularly transacts business in person and still require the nonparty to adjudicate a dispute over that subpoena in a distant forum."). *See also Europlay Capital Advisors, LLC v. Does*, 323 F.R.D. 628, 629 (C.D. Cal. 2018) (district of compliance is where a corporate subpoena recipient is headquartered); *Westfield v. Simpson*, Civ. No. 20-

cv-01747, 2022 WL 4131681, at *2 (S.D. Ind. Sep. 12, 2022) (same); *Burnett v. Wahlburgers Franchising LLC*, Civ. No. 16 CV 4602, 2018 WL 10466827, at *2 (E.D.N.Y. Oct. 4, 2018) (same).

As written, the subpoena imposes an impossible burden upon 3M Company. Even in the best of circumstances, it is difficult for a non-party to produce an adequately prepared Rule 30(b)(6) designee on two-weeks' notice. Here, the subpoena purports to compel 3M Company to produce witnesses to testify on more than two dozen topics, which are unusually broad and highly technical in nature.[1] Many of the topics are untethered to the patents and parties at issue in the underlying lawsuit. They seek the production of financial records dating back twenty years—more than a decade before the asserted patents even issued. They also seek confidential business information from 3M, and the protective order currently in place in the Eastern District of Texas case does not cover nonparty discovery. Beyond this, the individual most likely able to help 3M Company and its attorneys understand the issues recently retired and is unavailable to meet with 3M Company's counsel until the beginning of January. Other knowledgeable individuals (understandably) have significant work and family commitments over the next six weeks, as the year draws to a close.

[1] 3M will be serving objections to the topics and intends to meet and confer with Plaintiff to try to resolve them. As such, 3M Company's specific scope and relevancy objections are not yet before the Court.

Plaintiff's proposed solution—forcing 3M Company to commit to producing documents by December 22, 2023 and deponents by January 5, 2024—is no solution at all. It entirely ignores the need for 3M Company—a non-party to the underlying action—to develop its understanding of the issues, to state and resolve its objections (by agreement or through motions practice), to gather and produce untold numbers of documents, and to prepare its witnesses—all in the thick of school breaks, the holiday season, and year-end activities. As a practical matter, that will be difficult or impossible.

Through the meet and confer process, Plaintiff's attorney has argued that it needs 3M Company documents and testimony ahead of Plaintiff's infringement contentions, which are due in late January. This is not a problem of 3M Company's making. Plaintiff needed a Rule 11 basis to accuse Texas Instruments of patent infringement the day he filed the complaint in the underlying action. If Plaintiff and his attorney cannot state and support their infringement contentions without first obtaining information from others, then perhaps they should not have filed their lawsuit. In any event, Plaintiff's inability to meet his obligations under a scheduling order—that 3M Company had no part in negotiating—cannot justify imposing an undue burden upon a non-party, its employees, or retirees.

To be clear, 3M Company is not seeking to escape all subpoena obligations. 3M Company simply needs reasonable time to state its objections, to confer on its

concerns in an orderly fashion, to bring any unresolved issues to the Court for consideration, and to identify and prepare any deponents without creating unnecessary or undue burdens upon a non-party.

CONCLUSION

3M Company therefore requests that the Court quash the deposition subpoena or, at a minimum, modify it to set any deposition to occur on or after January 22, 2024 (without prejudice to moving for or agreeing to additional time, if necessary). In the meantime, 3M Company will promptly serve and attempt in good faith to resolve its objections to Plaintiff's requests for production and to the scope of the deposition subpoena.

3M Company further requests that the Court retain jurisdiction over this subpoena so that any objections the parties are unable to resolve can be addressed in this district, where 3M Company is headquartered, where 3M Company will gather and produce documents, and where 3M Company's likely witnesses reside. Among other things, that might include a future request that this Court enter a protective order (stipulated or otherwise) to ensure that 3M Company's trade secret or other confidential research, development, or commercial information be appropriately protected.

Dated: November 16, 2023

GREENE ESPEL PLLP

/s Mark L. Johnson
Mark L. Johnson, Reg. No. 0345520
Jeya Paul, Reg. No. 0386950
222 S. Ninth Street, Suite 2200
Minneapolis, MN 55402
mjohnson@greeneespel.com
jpaul@greeneespel.com
(612) 373-0830

Attorneys for 3M Company

EXHIBIT 5

Joel Glazer

From: Alex Chan
Sent: Tuesday, November 21, 2023 8:22 PM
To: Jeya Paul
Cc: Mark L. Johnson; Sung-TI-DLF_Intl
Subject: Re: Sung Subpoena to 3M - Motion to Quash Hearing Date

Jeya—

Your summary below contains several misstatements. First, we stated during the meet and confer that Dr. Sung will be moving to compel 3M to comply with the subpoena, including producing the requested documents and deposition testimony by the noticed date. Also, your summary conveniently omits that Plaintiff again proposed at today's meet and confer as well as the one held last Thursday, that the parties meet and confer today and tomorrow as well as anytime next week in the event 3M requires clarification as to the nature and scope of any of Dr. Sung's document requests and deposition topics—a proposal 3M rejected twice. Instead, 3M proposed December 4 without any willingness to compromise. Further, you again refused to provide a date certain as to when 3M would comply with the subpoena, including the date on which 3M would produce the requested documents or a corporate witness to testify on the noticed deposition topics.

As to the protective order between Texas Instruments ("TI") and Dr. Sung, 3M provided no justification or authority as to why TI and Dr. Sung would need to engage 3M, a third party, in finalizing and filing that protective order ("PO"). Also, we stated that we would take 3M's request under advisement and check with TI. Additionally, your summary conveniently omits that Dr. Sung proposed that 3M circulate any specific provisions that it would like to be incorporated into that PO. If 3M intends to do so, please confirm by tomorrow and send us your suggestions by next Monday for Dr. Sung to consider incorporation.

Finally, as to Dr. Sung's impending motion for sanctions, your summary conveniently omits that Dr. Sung had already stated during the meet and confer that the "controlling authority" is the subpoena itself, which identifies 3M's own manufacturing facility in Brownwood as the place of compliance. 3M's motion to quash does not dispute this point; instead, 3M relies on the location of its headquarters in Minnesota, as opposed to the noticed place of compliance in Texas, in seeking the Court to retain jurisdiction over Dr. Sung's subpoena, which 3M knew, or should have known, is improper. Our opposition will fully address the inapplicability of the four cases 3M has cited in its motion, none of which is binding on the Court.

Without any mandatory authority on this issue, Dr. Sung maintains that it was improper for 3M to file its motion to quash in the District of Minnesota. We reiterate that 3M withdraw this motion and do so by tomorrow at 4pm CT. Otherwise, Dr. Sung would be forced to move on these issues, including filing a second motion to compel in parallel in Texas.

Thanks much,
Alex

From: Jeya Paul <JPaul@greeneespel.com>
Date: Tuesday, November 21, 2023 at 6:02 PM
To: Alex Chan <achan@devlinlawfirm.com>
Cc: Mark L. Johnson <MJohnson@greeneespel.com>, Sung-TI-DLF_Intl <Sung-TI-DLF_Intl@devlinlawfirm.com>
Subject: RE: Sung Subpoena to 3M - Motion to Quash Hearing Date

Alex and Peter,

Following up on our call today, I would like to recap a few points.

First, you indicated that you will be moving to compel compliance with both the deposition subpoena and the document subpoena as written. We noted that doing so would be inappropriate without conferring on the specific objections we had raised. With that in mind, we proposed a follow-up discussion on the morning of December 4 at 10am. We suggested that timing because we need to meet with our client next week (after the Thanksgiving holiday) to ascertain what's available and the burdens associated with its collection/production. We will circulate a meeting invite, and we hope it is a meaningful, productive session.

Second, we inquired whether you had any proposal to address our confidentiality concerns. You stated that the existing protective order covers third parties, but paragraph 2 on page 8 makes clear it applies to "parties to this litigation." Beyond this, we raised other concerns in our objections, including who exactly will have access to our client's documents later on in the litigation. You said there is a new protective order under discussion. Please send us the draft so we can comment, as that may allow us to eliminate this concern. If you are unwilling to do that, we reserve our rights.

Third, you stated that you would be moving for sanctions because we filed our motion in the "wrong court." We looked into this before filing, and we obviously disagree. But I'll reiterate the request that you send any controlling authority on point. As I noted, if 3M is forced to respond to an unfounded sanctions motion, we will seek appropriate remedies.

We look forward to a productive call on December 4. Meanwhile, have a happy thanksgiving.

Jeya

From: Jeya Paul
Sent: Monday, November 20, 2023 11:42 AM
To: Alex Chan <achan@devlinlawfirm.com>
Cc: Mark L. Johnson <MJohnson@greeneespel.com>; Sung-TI-DLF_Intl <Sung-TI-DLF_Intl@devlinlawfirm.com>
Subject: RE: Sung Subpoena to 3M - Motion to Quash Hearing Date

Alex,

We are available to meet tomorrow at 1 p.m. CT. Please circulate a dial-in. Thanks.

Jeya

From: Alex Chan <achan@devlinlawfirm.com>
Sent: Monday, November 20, 2023 11:25 AM
To: Jeya Paul <JPaul@greeneespel.com>
Cc: Mark L. Johnson <MJohnson@greeneespel.com>; Sung-TI-DLF_Intl <Sung-TI-DLF_Intl@devlinlawfirm.com>
Subject: Re: Sung Subpoena to 3M - Motion to Quash Hearing Date

Thanks Jeya. 12/21 works for us. Going forward, please include our team's listserv for all communications relating to 3M, which is cc'ed here.

Also, in opposition to 3M's motion to quash, Dr. Sung intends to cross move to compel and for sanctions on the basis that 3M failed to comply with the subpoena and intentionally filed the motion to quash in the wrong court with no jurisdiction over the subpoena. Please let me know if you are available to meet and confer tomorrow or Wednesday, or in the alternative, simply confirm that this email exchange dispenses with the MC requirement.

Thanks much,
Alex

From: Jeya Paul <JPaul@greeneespel.com>
Date: Monday, November 20, 2023 at 10:04 AM

To: Alex Chan <achan@devlinlawfirm.com>
Cc: Mark L. Johnson <MJohnson@greeneespel.com>
Subject: Sung Subpoena to 3M - Motion to Quash Hearing Date

Alex,
Attached is the amended notice of hearing for 3M's motion to quash. The hearing date is currently set for December 21, as that was the earliest hearing date the Court had available. Please let us know if that does not work for you and we can ask to have it rescheduled. The next availability the Court had was during the week of January 22.
Best,
Jeya

Jeya Paul
Partner
612.373.8320 direct
JPaul@greeneespel.com

GREENE ESPEL PLLP 222 South Ninth Street | Suite 2200 | Minneapolis, MN 55402-3362
612.373.0830 *phone* | 612.373.0929 *fax* | www.greeneespel.com