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 17 BURST.COM, INC.

18
 19 UNITED STATES DISTRICT COURT
 20 NORTHERN DISTRICT OF CALIFORNIA
 SAN FRANCISCO DIVISION

21 APPLE COMPUTER, INC.,
 22 Plaintiff/Counterdefendant,
 23 v.
 24 BURST.COM, INC.,
 25 Defendant/Counterclaimant.
 26

§
 § CASE NO. C06-00019 MHP
 §
 § DEFENDANT BURST.COM, INC.'S
 § BRIEF IN OPPOSITION TO PLAINTIFF
 24 § APPLE COMPUTER, INC.'S MOTION TO
 § STRIKE THE DECLARATIONS OF DRS.
 25 § HEMAMI AND GERSHO
 §

27 TRIAL DATE: FEBRUARY 26, 2008

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 DEFENDANT BURST.COM, INC.'S BRIEF IN OPPOSITION TO PLAINTIFF APPLE COMPUTER, INC.'S
 MOTION TO STRIKE THE DECLARATIONS OF DRS. HEMAMI AND GERSHO

1 Apple Computer, Inc.'s ("Apple") motion to strike the declarations of Burst.com, Inc.'s
2 ("Burst") experts Dr. Sheila Hemami and Dr. Allen Gersho should be denied because it seeks
3 inappropriate relief from a problem that Apple itself has created. Apple created its procedural
4 difficulty by filing its invalidity summary judgment motion before any expert discovery had
5 taken place. One can speculate as to the reason that Apple chose this path: perhaps it wanted to
6 swamp Burst by forcing it to respond to two summary judgment motions at the same time that it
7 was preparing for the claim construction hearing; perhaps it wanted to color the claim
8 construction process by giving a preview of its summary judgment arguments. Whatever the
9 reason for this choice, the salient fact is that Apple chose this strategy. Now Apple seeks to
10 convert its ill-considered tactic into a fire drill for Burst by asking to depose Burst's experts
11 within a week of Apple's request, ahead of the schedule agreed to by the parties and ordered by
12 the Court, and before any expert reports have been issued.

15 Furthermore, Apple is seeking an inappropriate form of relief. Apple never issued a
16 deposition notice or a list of deposition topics by which Burst could gauge the extent of the
17 burden, and for this reason alone, it would be correct for the Court to deny Apple's request to
18 compel the depositions. And even if Apple were justified in taking these depositions at this early
19 stage in the litigation, striking the depositions is not an appropriate remedy for Burst's good faith
20 decision not to produce its experts ahead of schedule. Apple's decision to jump outside of the
21 sequence contemplated by the Court's Scheduling Order is an attempt to force an inappropriate
22 choice on the Court: *i.e.*, that the Court either take the draconian measure of striking the
23 Hemami and Gersho Declarations, or that the Court essentially reverse the burden of production
24 on Apple's invalidity defense by forcing Burst to produce its experts before Apple's own expert
25 has rendered an invalidity opinion and before Apple has produced its own expert for deposition.
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1 Finally, Apple's arguments regarding the substance of the Hemami and Gersho
2 Declarations are without merit. Burst introduced the declarations of its experts to help the Court
3 understand the extraordinarily complicated technical issues implicated by Apple's summary
4 judgment motion, and the Gersho and Hemami Declarations are, on their face, thorough, well-
5 cited, and well-reasoned.
6

7 Consequently, because Apple requests inappropriate relief from a problem that it has
8 created, we respectfully request the Court deny Apple's motion.

9 **I. Factual Background**

10 On September 26, 2006, the Court entered a Case Management Order that established,
11 among other things, the dates by which expert discovery should be completed. Docket No. 58.
12 The Order further mandated that, in the event changes must be made to the schedule, the parties
13 had to set discovery deadlines within a narrowly defined range of dates. These provisions were
14 agreed to by the parties after extensive negotiation.¹
15

16 With this schedule in mind, Apple filed two motions for summary judgment on January
17 4, 2007: one seeking a judgment of noninfringement, the other seeking a judgment that Burst's
18 patents are invalid. Docket Nos. 88 & 92. The noting date for both summary judgment motions
19 coincided with the date the Court had already chosen for its first claim construction hearing,
20 February 8, 2007. Because of this overlap, the Court vacated the usual motion briefing schedule
21 and noting date, temporarily relieving Burst of the duty to respond to Apple's motions. At the
22 February 8 Markman hearing, the Court ordered that Burst file its response to the summary
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25 ¹ As it turned out, the parties eventually did have to revise the schedule. On June 22, 2007, after further negotiation
26 between the parties, the Court entered a Revised Scheduling Order. Docket No. 118. This is the schedule that is
27 currently in effect, and it provides that all expert reports for which a party has the burden of proof must be served by
28 August 10, 2007; that all of the burden of proof experts must be produced for deposition by August 31, 2007; that all
rebuttal expert reports must be served by September 14, 2007; and that all rebuttal experts must be produced for
deposition by October 5, 2007.

1 judgment motions within 30 days of the Court's Markman ruling, and that Apple file its reply
2 two weeks after Burst's response.

3 The Court issued its claim construction ruling on May 8, 2007, and, shortly thereafter,
4 Apple acknowledged that its noninfringement summary judgment motion was moot and
5 withdrew it. Apple did not, however, withdraw its motion for summary judgment based on
6 invalidity, and Burst filed its responsive brief, as ordered by the Court, on June 7, 2007. In
7 support of its opposition, Burst also filed declarations (with supporting exhibits) from
8 itstechnical experts, Dr. Sheila Hemami and Dr. Allen Gersho. Docket Nos. 108 & 109.
9

10 On Friday, June 8, 2007, Apple attorney Nicholas Brown wrote to Burst's attorneys,
11 asking to depose Drs. Hemami and Gersho before the following Friday, June 15, 2007, or if
12 Burst could not produce the witnesses by then, to depose the experts on a later date and give
13 Apple an extension of time in which to file its reply brief. Walker Decl., Ex. 1. In addition to
14 requesting a deposition ahead of schedule, Apple presumably wanted to preserve its right to
15 depose Burst's experts again in accordance with the Court's Stipulated Scheduling Order. On
16 Monday, June 11, 2007, Burst informed Apple that it would not produce its experts for an extra
17 deposition in advance of the Court's schedule. Walker Decl., Ex. 2. Apple filed its reply brief
18 on June 21, 2007, but Apple did not submit any expert evidence to support its motion for
19 summary judgment, either in its opening brief or in its reply, although Apple remained free to do
20 so. On July 3, 2007, without having served a deposition notice, Apple filed this motion.
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23 II. Argument

24 A. Apple Is Not Entitled To Any Relief From The Problem It Created

25 Contrary to Apple's claims, it is not being "deprived of its right to cross-examine Dr.
26 Hemami and Dr. Gersho." Pl.'s Br. at 2. First, as explained below, Apple has no "right" to
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1 cross-examine Burst's experts ahead of schedule. Second, Burst has agreed to present these
2 experts for deposition in accordance with the schedule agreed upon by the parties and ordered by
3 the Court. Third, and perhaps most important, Apple's own strategic decisions are the root cause
4 of its current predicament.

5
6 Apple relies almost exclusively on one unreported case, *Sims v. Metropolitan Life Ins.*
7 *Co*, No. C-05-02980 (TEH), 2006 WL 3826716, *2 (N.D. Cal. Dec. 27, 2006), in support of its
8 argument that it is entitled to depose Burst's experts before it files its reply brief. However, *Sims*
9 does not support Apple's position. In particular, Apple quotes one sentence from *Sims* for the
10 simple proposition that Burst must allow Apple the opportunity to depose its experts because
11 Burst has submitted sworn declarations of those experts to the Court. Pl.'s Br. at 1. However,
12 *Sims* does not stand for the broader proposition, now advanced by Apple, that a party using
13 expert declarations in its summary judgment opposition must make those experts available for
14 deposition before the moving party files its reply brief.

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17 The *Sims* court noted that "[t]here is no clear weight of authority" on even the more basic
18 issue of whether Burst must present its experts for deposition simply because it submitted
19 declarations from them.² *Sims*, 2006 WL 3826716, *2. But even if the holding in *Sims* were
20 well-established law, Burst would be in compliance with it because Burst has agreed to produce
21 its experts for deposition in accordance with the Court's Stipulated Scheduling Order. What
22 *Sims* does not establish is Apple's right to depose Burst's expert at this point in the litigation, and
23 indeed, Apple points to no law supporting that position.

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26 ² Indeed, the passage quoted by Apple does not originally come from *Sims* itself, as Apple's citation suggests.
27 Rather, it comes from *Cox v. Commonwealth Oil Co.*, 31 F.R.D. 583, 584 (S.D.Tex.1962), which is quoted in *Sims*.
28 *Cox* merely held that a party cannot refuse to present an expert for deposition on the basis that the expert is only a
consulting expert when a sworn declaration of that expert has been presented to the Court as evidence. Like *Sims*,
Cox does not support Apple's belief that Burst must make its experts available on short notice for an extra
deposition outside of the Court's Stipulated Scheduling Order.

1 Federal Rule of Civil Procedure 30(d)(2) provides that, “[u]nless otherwise authorized by
2 the court or stipulated by the parties, a deposition is limited to one day of seven hours.” In
3 contemplation of this rule and anticipated discovery needs, the parties carefully negotiated and
4 filed with the Court a stipulation which provided a global plan for discovery, including expert
5 discovery. Apple’s decision to file its summary judgment motion when it did should not let it
6 usurp the procedure that it had already agreed to and that the Court ordered. Putting aside the
7 undue burden on Burst, discussed *infra* Section II.C, Apple’s motion should be denied on the
8 equitable basis that Apple should not now be allowed to complain about the problem that it has
9 created.
10

11
12 B. Apple’s Requested Relief Is Highly Atypical and Inappropriate

13 Even if Burst were unjustified in its refusal to produce its experts for depositions before
14 the time established by the Court’s Scheduling Order, striking the Hemami and Gersho
15 Declarations is simply not an appropriate remedy.
16

17 First, Apple had available several ways to avoid the current situation. Apple could have
18 negotiated a scheduling order that would accommodate expert discovery earlier in the case to
19 coincide with its plans for moving for early summary judgment. Conversely, it could have
20 waited to move for summary judgment until after expert discovery had taken place, as is typical
21 in patent infringement cases. Indeed, Apple’s motion for summary judgment based on
22 noninfringement proved premature when it was mooted by the Court’s Markman Order.
23

24 Apple cites no legal authority as a basis for its motion to strike, and Burst can only guess
25 as to the basis for its motion. If Apple’s motion is brought pursuant to Rule 12(f), the motion
26 must fail because Rule 12(f) applies only to striking pleadings, which, under Rule 7(a), does not
27 include witness declarations. *See* FED. R. CIV. P. 12(f); *see also* FED. R. CIV. P. 7(a) (listing
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1 “pleadings” governed by the Federal Rules of Civil Procedure).³ If Apple’s motion to strike
2 seeks a discovery sanction under Rule 37(b)(2), the motion must fail because the rule only
3 applies where a party refuses to obey a discovery order.⁴ Here, there is no discovery order,
4 Apple has not moved to compel the depositions, and indeed, Apple has not even served a proper
5 deposition notice. Finally, striking is generally a remedy for substantive deficiencies, not for a
6 good faith refusal to present a witness for deposition at a particular time. As noted below, Apple
7 does not raise any credible claims of substantive deficiencies in the declarations.
8

9 Assuming for the sake of argument that Apple deserves any remedy, it would be properly
10 sought through a motion to compel the depositions. (Of course, to legitimately seek such relief,
11 Apple would have to show that it properly noticed the depositions, which it did not.) Apple has
12 not identified the authority under which it moves to strike the declarations, nor has it pointed to
13 any case law suggesting that a motion to strike is an appropriate remedy for Burst’s decision not
14 to present its experts for deposition before the time required by the Court.
15

16
17 C. Apple’s Demand Is Unduly Burdensome

18 Apple seeks not only to depose the experts before the schedule allows, but also to
19 preserve its right to depose Burst’s experts again under the Court’s Scheduling Order. If
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21
22 ³ It is also well-settled that “[m]otions to strike [under Rule 12(f)] are disfavored, and the remedy of striking a
23 pleading should generally be used only when necessary to discourage parties from raising allegations that are
24 completely unrelated to the relevant claims and when the interests of justice so require.” *Tercica, Inc. v. Insmad*
Inc., No. C 05-5027 SBA, 2006 WL 1626930, *8 (N.D. Cal. June 9, 2006).

25 ⁴ Apple casually notes at the end of its motion that Burst’s declarations should be stricken because Burst did not
26 disclose the professional expert history of Dr. Gersho before filing the declaration. We presume that Apple’s motion
27 to strike on those grounds is essentially a motion pursuant to Rule 37(c). However, to state a claim under Rule
28 37(c), the moving party must show that the other party’s failure to comply with Rule 26 was both unjustified and
prejudicial. *See Dukas v. Wal-Mart*, 222 F.R.D. 189, 195-196 (N.D. Cal. 2004). Apple has shown neither ground
here, nor could it, as the obligation to disclose Dr. Gersho’s professional history had not yet arisen under the Court’s
Scheduling Order, and Apple has not alleged any prejudice due to the lack of disclosure. In any event, Burst has
since served this disclosure on Apple on July 12, 2007. *See Walker Decl.*, Ex. 3.

1 allowed, Apple's request would unduly burden Burst's experts and Burst's counsel, and it would
2 unfairly shift onto Burst the burden of proof on Apple's invalidity defense.

3 Apple's request is unduly burdensome because it gave Burst's experts and counsel less
4 than a week to prepare for the depositions. Apple's attorney, Nicholas Brown, wrote an email to
5 Burst's attorneys on Friday, June 8, requesting depositions of Burst's experts by Friday, June 15.
6 Putting aside the extraordinarily busy schedules of Burst's experts, Burst's counsel could not
7 possibly accommodate this rushed request, especially given trial commitments in other cases and
8 the requirements of preparing for the upcoming summary judgment hearing in this case.
9

10 It would also be unfair, and a violation of Rule 30(d)(2), for Apple to have two
11 opportunities to depose Burst's experts, while Apple would be allowed to wait to produce its
12 experts in the ordinary course. Despite Apple counsel's assurances that Apple only intends to
13 take "[s]hort depositions" that are "limited to the topics of their declarations," Pl. Br. at 2, such
14 an offer is illusory. Even if Apple's counsel confined itself to questions that could legitimately
15 be considered as relating to the declarations, that leaves open a wide range of issues, many of
16 which would be likely to come up again in later depositions. In any event, Burst has no way of
17 knowing what exactly Apple intended to ask Burst's experts because Apple never provided Burst
18 with a list of topics. Simply confining the depositions to the issues implicated by the
19 declarations leaves an unacceptably broad range of topics, particularly where defendants will
20 have the opportunity to depose Burst's experts a second time.
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24 Perhaps more important to Burst is the concern that Apple's request would unfairly shift
25 its burden of proof as to invalidity and would give Apple a sneak peek into Burst's expert
26 evidence. The Court's Scheduling Order is based, in part, on the burdens of production of each
27 party. The first round of expert reports and expert depositions must relate to the issues for which
28

1 each party has the burden of proof. Accordingly, Apple is required to produce an opening expert
2 report on invalidity and to make its expert available for deposition before Burst's experts have to
3 issue a report and undergo deposition. Apple's current request attempts to reverse the burden of
4 production by requiring Burst's experts to sit for depositions before Apple's expert has issued a
5 report or been deposed. If allowed, this would give Apple an unfair advantage by allowing its
6 expert a peek at Burst's counterarguments and rebuttal evidence well in advance of the
7 Scheduling Order's deadlines.
8

9 D. The Declarations Easily Comply With F.R.C.P. 26(a)(2)(B)

10 Burst agrees with Apple that the requirements of Rule 26(a)(2)(B) apply to the Hemami
11 and Gersho Declarations. However, Burst disagrees with Apple's complaints about the adequacy
12 of the declarations. If Apple's arguments prove anything, it is that the Declarations are more
13 than sufficient to pass muster under Rule 26.
14

15 For example, Apple's complaints about the Hemami Declaration are fairly technical and
16 specific and support the conclusion that the Hemami Declaration is sufficient under Rule 26.
17 Apple's only real complaint about the insufficiency of the Hemami Declaration is that it fails to
18 show why a poem recorded on a voicemail would be excluded from her definition of a "work."
19 Pl. Br. at 4. This point is offered in rebuttal to Dr. Hemami's argument, but it does not show that
20 her declaration was insufficient. Indeed, Dr. Hemami makes clear the reasons for her conclusion
21 and supports it with citations to various sources, a dictionary among them.
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24 Apple's argument for striking the Gersho Declaration is similarly misguided. Apple is
25 wrong in arguing Dr. Gersho does not support his conclusions, as a brief read through the
26 affidavit – which is 13 pages long and cites to 13 technical sources that were attached as exhibits
27 – shows that the opinion contains enough specificity to make clear the arguments being advanced
28

1 and the reasons for them. Apple's quibbles about Dr. Gersho's conclusions are more appropriate
2 as arguments in its reply brief, and in any event, the nature of Apple's disagreements is further
3 evidence that Dr. Gersho's declaration was sufficient under Rule 26.
4

5 The appropriate response by Apple to these alleged deficiencies would have been to
6 introduce its own expert declarations in support of its motion, which it did not do, or to argue
7 against the conclusions of Drs. Hemami and Gersho in its reply brief, which it did do. It is clear
8 from Apple's motion that its real complaint is that Burst refused to let Apple depose Burst's
9 experts ahead of the agreed-upon schedule, and Apple's arguments as to the sufficiency of the
10 declarations are plainly an attempt to muddy the distinction between the grounds for striking
11 declarations and the grounds for compelling depositions. *See, e.g.*, Pl. Br. at 2-3 ("Burst's
12 refusal to allow Apple to depose Drs. Hemami and Gersho has prevented Apple from obtaining
13 information it is entitled to under Fed. R. Civ. P. 26(a)(2)(B)."); Pl. Br. at 3 ("Again, Burst's
14 refusal to provide a deposition [sic] highlights this deficiency.") In any event, the distinction
15 does not need to be clearly defined here because Apple is entitled to neither remedy.
16
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18 III. Conclusion

19 Apple has advanced no legitimate argument for striking the declarations or compelling
20 the depositions. At bottom, Apple has created this problem through its procedural
21 brinksmanship, and it should not be allowed to shift the consequences onto Burst. Burst will
22 produce its experts in the ordinary course of discovery, under the schedule that was negotiated
23 between the parties and ordered by the Court, and in accordance with the respective burdens of
24 production of each of the parties.
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Respectfully submitted,



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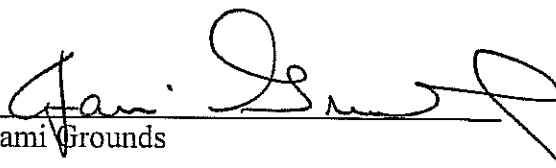
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CERTIFICATE OF SERVICE

I hereby certify that on the date written above, that I electronically filed the foregoing document with the Clerk of the Court using the CM/ECF system. The Court or the CM/ECF system will send notification of such filings to all CM/ECF participants. I further certify that a true and correct copy of this document was sent via U.S. first-class mail, postage pre-paid to all non-CM/ECF participants.


Jami Grounds