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9 UNITED STATES DISTRICT COURT
 10 NORTHERN DISTRICT OF CALIFORNIA
 11

12 APPLE COMPUTER, INC.,

13 Plaintiff,

14 v.

15 BURST.COM, INC.,

16 Defendant.

Case No. C 06-0019 MHP

**PLAINTIFF APPLE COMPUTER,
 INC.'S MOTION TO STRIKE THE
 DECLARATIONS OF DRS. GERSHO
 AND HEMAMI, AND RICHARD
 LANG**

Date: September 18, 2007

Time: 2:00 p.m.

Hon. Marilyn Hall Patel

Complaint Filed: January 4, 2006

Trial Date: February 26, 2008

1 **I. APPLE’S MOTION TO STRIKE BURST’S DECLARATIONS**

2 In this case, Burst has repeatedly instructed its witnesses not to answer important
3 questions. This tactic has successfully limited Apple’s ability to cross-examine Burst’s witnesses.
4 Accordingly, Apple now moves to strike the declarations submitted by Dr. Gersho, Dr. Hemami,
5 and Mr. Lang in support of Burst’s oppositions to Apple’s motions for summary judgment.¹ As
6 shown below, Burst’s refusal to allow its witnesses to answer important questions was not an
7 isolated occurrence. Rather, it was a repeated problem that has unfairly limited Apple’s ability to
8 cross-examine Burst’s witnesses about the subject matter of their declarations.

9 In the alternative, Apple moves the Court to draw an adverse inference from
10 Burst’s refusal to allow its witnesses to respond to Apple’s questions.

11 **A. The Court Should Strike Dr. Gersho’s Declaration, Or In The Alternative**
12 **Draw An Adverse Inference From Burst’s Instructions Not To Answer**

13 The two declarations submitted by Dr. Gersho focus on the Kramer reference, and
14 also provide opinions about the Kepley and CompuSonics references. Yet, under the guise of
15 limiting the deposition to the “scope of his declaration,” Burst repeatedly refused to allow Apple
16 to use these same references to cross-examine Dr. Gersho, even when the questions were
17 specifically directed to the statements in his declaration.

18 Q. And this is, to be clear, your Declaration in Opposition to
19 Apple's Second Motion for Summary Judgment of
Invalidity. Right?

20 A. Yes.

21 Q. If you turn to paragraph 38. Could you just read the first
sentence out loud?

22 A. "Not only does Kramer not suggest faster than real-time
23 transmission, it would have been entirely surprising and
24 unexpected for anyone to conceive of or propose the idea of
transmitting audio in a burst mode given the statement of
technology and the consumer product market in the late

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26 ¹ Burst initially refused to allow Apple to even depose the experts who submitted declarations in
27 support of Burst’s oppositions to Apple’s summary judgment motions. Accordingly, Apple
28 moved to strike those declarations. Burst then reconsidered and offered depositions of its experts
on the subject matter of their declarations if Apple would agree to withdraw its motion to strike.
Apple agreed, and took the depositions of Burst’s experts. Accordingly, Apple hereby withdraws
its previously filed motion to strike, which is now moot.

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1980s and early 1990s."

Q. What did you mean by that sentence?

A. I think it's pretty clear. I'm not sure how to answer.

Q. I guess what I'm asking is, is that sentence intended to mean only that it wouldn't have been obvious to send audio in a burst mode in view of Kramer or something more general?

A. At the time I was thinking about Kramer. So I don't know if -- I don't remember if -- at the time I wrote this, if I was thinking more broadly or not.

Q. Would it have been obvious to a person of ordinary skill in the art to transmit audio in a burst mode if they had the Kepley patent in their possession in 1987?

MR. PAYNE: Same objection. Don't answer that. Beyond the scope of the declaration.

Brown Decl., Exh. A [Gersho Depo. at 54:13-55:17].

Q. Now, looking back at your declaration, we started to look at paragraph 38. And this is, again, the paragraph where in the first sentence you say that "it would have been entirely surprising and unexpected for anyone to conceive of or propose the idea of transmitting audio in a burst mode given the state of the technology and the consumer product market in the late '80s and early '90s." Right?

A. Yes, I said that.

Q. But Kepley did conceive of it. Right?

MR. PAYNE: Objection. Form. I'm going to instruct him not to answer. It's beyond the scope.

THE WITNESS: May I answer?

MR. PAYNE: He's asking a specific question about Kepley. So that's beyond the scope of your declaration. So I'm going to instruct you not to answer.

Brown Decl., Exh. A [Gersho Depo. at 90:16-91:6].

These instructions were improper and unfair. Dr. Gersho's expert declarations discuss the Kepley reference. Dr. Gersho declares that he has "read and studied" Kepley. [First Gersho Decl., Docket #108 at ¶ 8]. As Apple has shown, Kepley expressly describes transmitting audio faster than real-time. Yet Burst refused to allow Apple to use Kepley to cross-examine Dr. Gersho about his statement that "it would have been entirely surprising and unexpected for anyone to conceive of or propose the idea of transmitting audio in a burst mode given the state of the technology and the consumer product market in the late '80s." Given that Kepley directly contradicts this statement, and that Dr. Gersho had "read and studied" Kepley, this was an

1 important line of questioning. Burst prevented it from occurring.

2 This was not an isolated incident or a mistake. On twenty-eight separate occasions
3 Burst instructed Dr. Gersho not to answer deposition questions. And as shown by the following
4 excerpts, Burst deliberately foiled Apple's repeated attempts to use the Kepley reference to cross-
5 examine Dr. Gersho about the opinions he expressed about the validity of the Burst patents:

6 Q. And the next sentence there [in Kepley] says,
7 "Advantageously, the transmission facilities are high-speed
8 digital facilities of the type used for computer data file
9 transfers." Right?

10 A. That's what it says.

11 Q. Then it goes on to say, "The use of digital high-speed
12 transmission facilities of speed greater than 9.6 kilobits per
13 second enables the exchange of digitally encoded and
14 compressed voice mail messages faster than real-time
15 speech." Do you see that?

16 A. Yes, I see it.

17 Q. Do you have any reason to disagree with that?

18 MR. PAYNE: I'm going to object and instruct him not to answer.
19 It's beyond the scope of his declaration. It's in transmission
20 areas.

21 Brown Decl., Exh. A [Gersho Depo. at 79:3-17].

22 Q. What is your understanding of what Mr. Lang invented?

23 A. Well, first of all, I guess every claim is a separate
24 invention. So I don't know if I could say in general, but I
25 could address specific -- like claim 1 of '995 is the one that
26 comes to mind most.

27 Q. Okay. Let's go with that one.

28 A. And his invention has four major components: the input
means -- let's see -- random access storage means, and
compression means, and output means, if I recall. Those
are --

Q. Okay. And is it your testimony that Mr. Lang is the first
person ever to have combined those?

A. I didn't comment on that in my depositions. I don't recall
testifying to that specifically.

Q. Do you have a view?

MR. PAYNE: This is beyond the scope of his declaration. I
guess, yeah, you can answer in the context of your
declarations.

THE WITNESS: I believe so, yes.

BY MR. STEPHENS:

Q. And what's the basis for that belief?

A. Well, I haven't seen -- I haven't seen these four elements
combined in -- in any of the prior art references that I've
seen before.

Q. Of course you did see them combined in Kepley. Right?

MR. PAYNE: Objection. Form.

MR. STEPHENS: Are you going to instruct him not to answer?

1 MR. PAYNE: Yeah. It's beyond the scope of the declaration.

2 Brown Decl., Exh. A [Gersho Depo. at 131:2-132:8].

3 Q. Do you have an opinion about whether or not it would have
4 been surprising or unexpected for anyone to conceive of or
5 propose the idea of transmitting voice audio in a burst
6 mode in the late '80s?

5 MR. PAYNE: Yeah, I'm going to instruct him not to answer.

6 Brown Decl., Exh. A [Gersho Depo. at 96:22-97:12]

7 As these passages show, Burst repeatedly prevented Apple from cross-examining
8 Dr. Gersho about the core subject matter of the pending summary judgment motion his
9 declaration was submitted to oppose. Accordingly, the Court should strike Dr. Gersho's
10 declaration. In the alternative, the Court should draw an adverse inference from Burst's refusal to
11 allow Dr. Gersho to respond to these questions such as "Would it have been obvious to a person
12 of ordinary skill in the art to transmit audio in a burst mode if they had the Kepley patent in their
13 possession in 1987?"

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15 **B. The Court Should Strike Richard Lang's Declaration, Or Draw An Adverse
16 Inference From His Refusal To Answer Questions**

16 As with Dr. Gersho, on multiple occasions Burst instructed Richard Lang not to
17 answer deposition questions. With Mr. Lang, Burst's basis for its instructions was an off-the-
18 record conversation in which Mr. Lang apparently concluded that he "could not separate" his
19 attorney's advice from his own opinions on a range of significant issues. Based on this, Mr.
20 Lang refused to explain how he believed his invention differed from what was disclosed in
21 Walter:

22 MR. FOLSE: While we were off the record and before Mr. Lang spent
23 much time looking at this patent [Walter], I determined from
24 speaking with him that he had had extensive conversations about
25 the patent and points of distinction with counsel from Carr &
26 Ferrell. And so based on that, I need to instruct the witness on the
27 record to avoid waiver of the attorney/client privilege not to
28 respond to the pending question or questions concerning the extent
to which this patent does or does not anticipate the patents-in-suit,
to the extent that in so responding he would be disclosing the
content of privileged communications that he had with his
attorneys at Carr Ferrell, or any other counsel. If he's able to
answer the question without doing that, fine. But if he is not, then I
would instruct him not to answer.

1 Brown Decl., Exh. C [Lang Depo. at 368] (emphasis added).

2 Q. ... Well, first of all, did you take any time to read the patent on the
3 break?

4 A. I started to read it.

5 Q. How much time did you spend reading it?

6 A. About a minute.

7 Q. And then what happened?

8 A. Well, then I discussed the fact with my attorney that it's -- I can't -- I
9 can't separate my views on this patent and how it compares to my
10 patents from the views that came about as a result of the
11 conversations that I had with my patent attorneys. And as a result
12 of that discussion, my attorney has asked me to not answer these
13 questions.

14 Brown Decl., Exh. C [Lang Depo. at 369-370].

15 Q. So you don't have an independent understanding of how your
16 invention differs from Walter, correct?

17 A. That's not what I said. I said I can't separate my independent opinions
18 from those that have resulted from my conversations with patent
19 counsel.

20 Q. Well, to the extent you have an independent understanding of how
21 your invention is different from Walter, please tell me what it is.

22 A. I can't identify it.

23 Q. Okay. If you're asked at trial to tell how your invention is different
24 from Walter, how would you answer that question?

25 A. I don't know what I'll say at trial.

26 Q. I'm asking you to think now about what you would say if you were
27 asked at trial how your invention is different from Walter.

28 A. You're asking me to speculate on a future event.

Q. I'm asking you to think about a future event and if you have any idea
or can come up with an idea of what you'll tell the jury about how
your invention is different than Walter, tell me that.

MR. FOLSE: By the way, despite the phraseology of that question, my
instruction regarding disclosure of privileged communications at
this deposition still stands.

Q. Can you answer the question?

A. No.

21 Brown Decl., Exh. C [Lang Depo. at 378-379].

22 Burst's use of privilege to shield the sole named inventor of the patents in this
23 case from testifying about how his invention differed from Walter is inconsistent with its current
24 effort to use Mr. Lang's testimony to defend its patents from Walter.²

25 In addition to refusing to explain how his invention differed from Walter, Mr.

26 _____
27 ² See *Bittaker v. Woodford*, 331 F.3d 715, 719 (9th Cir, 2003) ("The privilege which protects
28 attorney-client communications may not be used both as a sword and a shield"); *In re Echostar*,
448 F.3d 1294, 1301 (Fed. Cir. 2006) (describing use of "the attorney-client privilege as both a
sword and a shield" as an "abuse" to be prevented).

1 Lang refused to explain what basis Burst has for its assertion that Apple's success with the iPod
2 shows the "commercial success" of Burst's alleged invention. Appearing as Burst's
3 representative under F.R.C.P. 30(b)(6) regarding alleged commercial success of Burst's
4 invention, Mr. Lang testified as follows:

5 Q. Do you have any basis to believe that Burst's patented technology has
6 contributed to the success of the iPod, and if so, what's your basis?

7 MR. YORIO: Objection on the ground that it's compound, but go ahead.
8 In the interests of expediting things, go right ahead.

9 A: I -- I do believe it's contributed. My basis is rooted in -- in an
10 understanding of which of the -- which of the various aspects of
11 the Burst patents are -- are practiced by the iPod and various Apple
12 products. And the -- the specifics regarding which ones and in what
13 way are -- my opinion in those areas are precisely what I -- I cannot
14 separate from the opinions that I now hold as a result of the
15 conversations that I've had with my attorneys.

16 Q. Okay. Can you give me your best understanding sitting here today as
17 to how Burst's patented technology contributed to the success of
18 the iPod?

19 A. I think -- you know --

20 MR. YORIO: Same objection.

21 A. Just -- my answer is just the same one that I just gave. I don't have a
22 different answer for that.

23 Q. So you can't answer that question without revealing communications
24 you've had with your attorneys; is that right?

25 A. That's correct.

26 MR. BROWN: And Bob, I take it you're instructing him not to reveal
27 those communications?

28 MR. YORIO: I am.

Brown Decl., Exh. D [Lang Depo. at 768-69].

Here again, Burst's use of privilege to shield Mr. Lang from explaining how
Burst's claimed invention allegedly contributed to the iPod's success is inconsistent with its
current effort to use the iPod's success as evidence of nonobviousness. Accordingly, the Court
should strike Mr. Lang's declaration. In the alternative, the Court should draw an adverse
inference from Burst's refusal to allow Mr. Lang to respond to these questions. It would be
patently unfair to allow Burst to shield Mr. Lang from cross-examination about how his
invention allegedly differs from Walter, and how his invention allegedly contributed to the
success of the iPod, while still allowing his testimony to support Burst's oppositions to the
pending summary judgment motions.

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C. The Court Should Strike Dr. Hemami’s Declaration, Or In The Alternative Draw An Adverse Inference

Burst used a similar tactic when it presented Dr. Hemami for deposition, albeit to a lesser degree that with Dr. Gersho and Mr. Lang:

Q. (By Mr. Stephens) Sure. So, when you're copying an audio file from one disk to another disk in a Unix workstation in the mid Eighties, the time required to make that copy isn't restricted to the amount of time required to play that file back, right?

MR. PAYNE: Objection, form. Where -- what are you talking about, Unix-based workstations? That's not a declaration --

MR. STEPHENS: Make your objection. Stop --

MR. PAYNE: I'm going to instruct her not to answer the question.

MR. STEPHENS: You're going to -- okay.

MR. PAYNE: It's beyond the declaration.

MR. STEPHENS: All right. You're going to instruct her not to answer?

MR. PAYNE: If you've got a specific prior art --

THE WITNESS: I'm sorry, could I take a break and --

MR. STEPHENS: No. There's a question pending.

MR. PAYNE: -- you've got specific prior art in the declaration. You're suggesting hypotheticals that assume facts not in evidence. And, so, I have no choice but to instruct her not to answer.

Brown Decl., Exh. B [Hemami 9/4/2007 Depo. at 81:3-82:1].

This instruction, like the instructions to Dr. Gersho, unfairly constrained Apple’s ability to cross-examine Dr. Hemami. Accordingly, the Court should strike the Hemami declarations, or in the alternative draw an adverse inference from Burst’s refusal to let Dr. Hemami respond to this question.

Dated: September 17, 2007

WEIL, GOTSHAL & MANGES LLP

By: _____
/s/
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