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28UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

INFINEON TECHNOLOGIES,

No. C-11-06239 DMR

Plaintiff,

**ORDER RE JOINT DISCOVERY
LETTER DATED MARCH 29, 2013
[DOCKET NO. 223]**

v.

VOLTERRA SEMICONDUCTOR,

Defendant.

Before the court is the March 29, 2013 joint discovery letter (“Letter”) filed by Plaintiff Infineon Technologies AG (“Infineon AG”) and Defendant Volterra Semiconductor Corp. (“Defendant”). [Docket No. 223.] Defendant seeks documents as well as depositions pursuant to Federal Rule of Civil Procedure 30(b)(6) from Plaintiff and nonparty Infineon Technologies North America Corp. (“Infineon NA”). For the reasons stated below, as well as at the April 18, 2013 hearing, Defendant’s motion to compel is granted in part.

I. BACKGROUND

On December 11, 2012, the court ruled that Plaintiff must seek leave of the court to add additional model numbers to its infringement contentions. Order Denying Defendant’s Motion to Strike [Docket No. 162] at 6. The court stated that “if at a future date Plaintiff seeks to amend its infringement contentions to include other Volterra products other than the fifteen already specified,

1 Plaintiff will need to show that it could not have discovered those models when it served its initial
2 infringement contentions absent discovery.” *Id.*

3 On February 14, 2013, Plaintiff sought leave of the court to add three additional model
4 numbers (the “Additional Model Numbers”) to its infringement contentions. Motion for Leave to
5 Amend Infringement Contentions (“Motion for Leave to Amend”) [Docket No. 199] at 8. Plaintiff’s
6 position is that it did not identify the Additional Model Numbers until its counsel conducted an
7 Internet search in January 2013. *Id.* at 11, Letter at 2.

8 II. DEPOSITION NOTICES

9 On March 11, 2013, Defendant served Rule 30(b)(6) deposition notices on Plaintiff and
10 Infineon NA. The notices aim to discover evidence regarding whether Plaintiff was aware of or
11 could have discovered the Additional Model Numbers sooner. The deposition notices to Plaintiff
12 and Infineon NA are identical. They each list four subject matters and two document requests.
13 Letter Ex. A at 4, 12. The four subject matters are:

- 14 1. The company’s knowledge of the Additional Model Numbers;
- 15 2. The identity of persons who have the knowledge regarding the foregoing subject matter
16 and the identity of all documents which refer to the company’s knowledge of the above;
- 17 3. “The identity of any other Defendant products of which [the company is] aware that are
18 ‘integrated power fcQFN (flip-chip quad flat no-lead) products with two or more ground
19 pins and two or more switching node pins’ but are not identified by model number in
20 Infineon AG’s Third Amended Infringement Contentions”; and
- 21 4. The identity of persons who have the knowledge regarding the foregoing subject matter
22 and the identity of all documents which refer to the company’s knowledge of the above.

23 *Id.* at 4-5, 12-13. The two document requests ask for the following:

- 24 1. All documents relating to the company’s knowledge of the Additional Model Numbers;
- 25 2. All documents which mention or refer to “any other Defendant products which are
26 ‘integrated power fcQFN (flip-chip quad flat no-lead) products with two or more ground
27 pins and two or more switching node pins’ but are not identified by model number in
28 Infineon AG’s Third Amended Infringement Contentions.”

1 *Id.* at 7, 17. Thus, broadly speaking, Defendant seeks each entity’s documents and knowledge
2 regarding (1) the Additional Model Numbers and (2) any other relevant products not listed by model
3 number in Plaintiff’s infringement contentions (“Other Unlisted Model Numbers”).

4 Plaintiff raises three main objections to the discovery requests:

- 5 1. They are overbroad because they are not limited to the Additional Model Numbers that
6 Plaintiff seeks to add to the case, in that they seek discovery on the Other Unlisted Model
7 Numbers;
- 8 2. They seek discovery regarding nonparty Infineon NA’s knowledge of the Additional
9 Model Numbers and Other Unlisted Model Numbers, and the separate knowledge of a
10 party’s corporate affiliate should not be imputed onto the party for purposes of denying a
11 party leave to amend infringement contents;
- 12 3. They seek documents and testimony that are covered by the attorney-client privilege

13 Letter at 6. As discussed below, Plaintiff has already produced some responsive documents culled
14 from the search of a database of documents produced in a related case before the Hon. Joseph C.
15 Spero. Plaintiff has also offered additional documents and testimony from both Plaintiff and
16 Infineon NA, but made the offer subject to conditions that Defendant rejected.

17 Defendant requests that this court order Plaintiff and Infineon NA to “produce promptly their
18 documents reflecting knowledge or awareness of the [Additional Model Numbers] and the [Other
19 Unlisted Model Numbers], including all such documents from the litigation database in the action
20 pending before Judge Spero.” Letter at 11. Defendant also requests that it be allowed to depose
21 Plaintiff and Infineon NA witnesses with respect to those entities’ knowledge of the Additional
22 Model Numbers and the Other Unlisted Model Numbers.

23 **III. DISCUSSION**

24 **A. Discovery Regarding Other Unlisted Model Numbers**

25 Plaintiff contends that Defendant’s discovery requests regarding the Other Unlisted Model
26 Numbers are overbroad because they “seek[] discovery on model numbers that Plaintiff might seek
27 leave to add at some point in the future” and “[e]ven assuming arguendo that such discovery would
28 be relevant in the future if Plaintiff actually seeks leave to add any such model numbers, it is
certainly not relevant to any issue in the case now.” Letter at 5. The court has previously stated that
“if at a future date Plaintiff seeks to amend its infringement contentions to include other Volterra

1 products other than the fifteen already specified, Plaintiff will need to show that it could not have
2 discovered *those models* when it served its initial infringement contentions absent discovery.”
3 Order Denying Defendant’s Motion to Strike at 6 (emphasis added). The court agrees that discovery
4 into the Other Unlisted Model Numbers is inappropriate at this time. Plaintiff has not attempted to
5 put additional models at issue beyond the three models that are the subject of Plaintiff’s motion to
6 amend the infringement contentions. Any other models are beyond the scope of claims in this case,
7 and information about them is therefore irrelevant and beyond the scope of discovery.

8 **B. Scope of Document Discovery**

9 Defendant’s discovery requests seek documents from Plaintiff and Infineon NA regarding
10 the Additional Model Numbers and the Other Unlisted Model Numbers. The latter, as discussed
11 above, is not an appropriate topic for discovery at this time.

12 Plaintiff, Infineon NA, and Defendant are parties to a patent case pending before Judge
13 Spero. *See Volterra Semiconductor Corporation v. Primarion, Inc. et al.*, Case No. 08-CV-5129-
14 JCS (N.D. Cal.). In *Primarion*, Plaintiff and Infineon NA produced nearly six million pages of
15 documents to Defendant (the “Litigation Database”). Letter at 4. Defendant and Plaintiff agree that
16 the Litigation Database may contain documents responsive to the discovery requests currently at
17 issue:

18 Because [Plaintiff and Infineon NA were] under Court Order in [*Primarion*] to produce all
19 documents in their possession relating to Volterra or Volterra’s products, this database would
20 necessarily contain documents showing the knowledge about the existence of the three products
21 at least as of 2010 and 2011 (the time period of Infineon’s document production in that action.)
22 *Id.* at 9 (Defendant’s description of Litigation Database). *See also id.* at 4 (describing Plaintiff’s
23 search for relevant documents in the Litigation Database). The parties also agree that any search for
24 documents responsive to the current discovery requests should begin with the documents already in
25 the Litigation Database. Letter at 8 (“As a starting point for the sought discovery and to minimize
26 any burden on Infineon, Volterra requested that Infineon search the [Litigation Database].”).

27 Defendant requested that Plaintiff search the Litigation Database for documents relating to
28 both Plaintiff and Infineon NA’s knowledge and awareness of both the Additional Model Numbers

1 and the Other Unlisted Model Numbers. *Id.* at 11. Plaintiff did perform a search of the Litigation
2 Database, but not to the extent that Defendant requested.

3 As discussed above, this court has already held that discovery into the Other Unlisted Model
4 Numbers is not appropriate. However, limiting the search for responsive documents to Plaintiff
5 only, and to the Litigation Database, is too restrictive. Plaintiff is therefore ordered to search the
6 Litigation Database to produce all documents involving Plaintiff and/or Infineon N.A. that mention
7 any of the Additional Model Numbers. Because the Litigation Database does not cover all the
8 relevant dates, Plaintiff and Defendant are ordered to meet and confer regarding a search for and
9 production of documents that may be responsive to the discovery requests but that may not be
10 captured by the Litigation Database.

11 **C. Scope of 30(b)(6) Deposition**

12 Plaintiff and Infineon NA are ordered to produce witnesses for deposition, subject to the
13 conditions on the subject matter discussed above. The issue of whether Infineon N.A.'s knowledge
14 should be imputed to Plaintiff is not currently before this court. However, the court finds that
15 information relating to Infineon N.A.'s knowledge of the three additional models is relevant for
16 purposes of discovery.

17 **D. Motion for Leave to Amend and Motion to Strike Dismissed Without Prejudice**

18 Previously, this court vacated the briefing schedule on Defendant's Motion to Strike
19 Infineon's Third Amended Infringement Contentions [Docket No. 209] and Plaintiff's Motion for
20 Leave to Amend its Infringement Contentions [Docket No. 199], and ordered parties to file
21 oppositions to the Motion to Strike and Motion for Leave to Amend within one week after the court
22 issues an order on this Letter. *See* Order Vacating Hearing Date dated March 20, 2013 [Docket No.
23 219] and Order Vacating Hearing Date [Docket No. 220].

24 Because the Motion for Leave to Amend and the Motion to Strike may be contingent on the
25 discovery at issue in this order, both motions are dismissed without prejudice. The parties are
26 directed to meet and confer regarding new briefing schedules for the Motion to Strike and Motion
27 for Leave to Amend and whether the motions will be filed separately, and to file a stipulation and
28 proposed order by **April 24, 2013**.

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IT IS SO ORDERED.

Dated: April 22, 2013



DONNA M. RYU
United States Magistrate Judge