



1 without prejudice on October 8, 2013, Dkt. No. 112. On December 23, 2013, RR moved  
2 for leave to amend its infringement contentions. Dkt. No. 155. The Court denied RR's  
3 motion. Dkt. No. 212.

4 Fact discovery closed on December 20, 2013. Dkt. No. 154. Opening expert reports  
5 were due on January 8, 2014, and rebuttal expert reports were due on January 24, 2014. *Id.*  
6 On January 27, 2014, ASUS moved to strike certain expert testimony from Dr. David  
7 Taylor's and Dr. Martin Afromowitz's reports. Dkt. Nos. 196, 199, 221. On February 7,  
8 2014, expert discovery closed. Dkt. No. 154. On February 14, 2014, RR moved to strike  
9 portions of testimony from ASUS's experts, Dr. R. Jacob Baker and Dr. Keith R. Ugone.  
10 Dkt. Nos. 246, 247. Judge Jon S. Tigar referred the motions to strike to this Court under  
11 Local Rule 72-1. Dkt. Nos. 203, 204, 251. On March 5, 2014, the Court held a hearing  
12 regarding both parties' motions to strike. Dkt. No. 294. On March 20, 2014, ASUS moved  
13 to strike certain infringement and damages opinions rendered by Taylor and David  
14 Yurkerwich. Dkt. No. 330. The Court heard oral argument on this motion on April 3,  
15 2014. Dkt. No. 361.

16 On February 28, 2014, RR moved for summary judgment, Dkt. No. 271, and ASUS  
17 and ASUSTeK moved for summary judgment the following day, Dkt. No. 275. Both  
18 summary judgment motions are currently pending before Judge Tigar.

### 19 **LEGAL STANDARD**

20 Patent Local Rule 3 requires patent disclosures early in a case and streamlines  
21 discovery by replacing the "series of interrogatories that [parties] would likely have  
22 propounded" without it. *Network Caching Tech. LLC v. Novell Inc.*, No. 01-cv-02079  
23 VRW, 2002 WL 32126128, at \*4 (N.D. Cal. Aug. 13, 2002). It is "designed to require  
24 parties to crystallize their theories of the case early in the litigation and to adhere to those  
25 theories once they have been disclosed." *Nova Measuring Instruments Ltd. v. Nanometrics,*  
26 *Inc.*, 417 F. Supp. 2d 1121, 1123 (N.D. Cal. 2006). Given this requirement, a party may not  
27 use an expert report to introduce new infringement theories, new infringing  
28 instrumentalities, new invalidity theories, or new prior art references not disclosed in the

1 parties' infringement contentions or invalidity contentions. *See, e.g., Dynetix Design*  
2 *Solutions, Inc. v. Synopsys, Inc.*, No. 11-cv-05973 PSG, 2013 WL 4537838, at \*2 (N.D.  
3 Cal. Aug. 22, 2013) (striking plaintiff's infringement theories relating to infringing features  
4 within the accused products that were not disclosed in plaintiff's contentions); *Volterra*  
5 *Semiconductor Corp. v. Primarion, Inc.*, 796 F. Supp. 2d 1025, 1119 (N.D. Cal. 2011); *Life*  
6 *Techs.*, 2012 WL 4097740, at \*2 (striking portions of expert report relying on prior art  
7 references not disclosed in invalidity contentions); *Brilliant Instruments, Inc. v. GuideTech,*  
8 *Inc.*, No. 09-cv-05517 CW, 2011 WL 900369, at \*2 (N.D. Cal. Mar. 15, 2011) (same); *Life*  
9 *Techs. Corp. v. Biosearch Techs., Inc.*, No. 12-cv-00852 WHA, 2012 WL 4097740, at \*3-4  
10 (N.D. Cal. Sept. 17, 2012) (same).

11 Patent Local Rule 3-1 requires that a party claiming patent infringement serve a  
12 "Disclosure of Asserted Claims and Infringement Contentions" not later than 14 days after  
13 the initial case management conference. This disclosure must include "[e]ach claim of each  
14 patent in suit that is allegedly infringed by each opposing party, including for each claim the  
15 applicable statutory subsections of 35 U.S.C. §271 asserted[.]" Patent Local R. 3-1(a). In  
16 addition, the disclosure must identify "[s]eparately for each asserted claim, each accused  
17 apparatus, product, device, process, method, act, or other instrumentality ('Accused  
18 Instrumentality') of each opposing party of which the party is aware." Patent Local R.  
19 3-1(b). "This identification shall be as specific as possible." *Id.* "Each product, device,  
20 and apparatus shall be identified by name or model number, if known." *Id.* Patent Local  
21 Rule 3-1(c) requires a party claiming patent infringement to serve "[a] chart identifying  
22 specifically where each limitation of each asserted claim is found within each Accused  
23 Instrumentality . . . ." If a party alleges its patent has been indirectly infringed, it must  
24 identify for each claim any direct infringement and describe the acts of the alleged indirect  
25 infringer that contribute to or induce the direct infringement. Patent Local R. 3-1(d). In  
26 addition, the party must disclose "[w]hether each limitation of each asserted claim is alleged  
27 to be literally present or present under the doctrine of equivalents in the Accused  
28 Instrumentality." Patent Local R. 3-1(e).

1 Patent Local Rule 3-3 requires parties accused of infringement to serve invalidity  
2 contentions. The invalidity contentions must identify “each item of prior art that allegedly  
3 anticipates each asserted claim or renders it obvious[.]” Patent Local R. 3-3(a). Invalidity  
4 contentions must contain information on “[w]hether each item of prior art anticipates each  
5 asserted claim or renders it obvious.” Patent Local R. 3-3(b). “If obviousness is alleged,”  
6 the invalidity contentions must contain “an explanation of why the prior art renders the  
7 asserted claim obvious, including an identification of any combinations of prior art showing  
8 obviousness . . . .” *Id.* The invalidity contentions must further contain “[a] chart identifying  
9 where specifically in each alleged item of prior art each limitation of each asserted claim is  
10 found . . . .” Patent Local R. 3-3(c).

## 11 DISCUSSION

### 12 A. ASUS’S Motions to Strike

#### 13 i. Doctrine of Equivalents (“DOE”)

14 ASUS moves to strike portions of Taylor’s and Afromowitz’s expert reports that  
15 opine on the DOE based on three arguments: 1) that RR’s infringement contentions state  
16 only boilerplate contentions that are insufficient to disclose its DOE theory; 2) that the DOE  
17 contentions are insufficient because they do not identify specific elements of allegedly  
18 infringing products that meet each claim under a DOE theory; 3) that the expert reports  
19 opine on new DOE theories all together. Dkt. No. 196 at 9. RR argues that its contentions  
20 were sufficient to put ASUS on notice that RR was pursuing a DOE theory, and that Judge  
21 Tigar already ruled that RR’s infringement contentions sufficiently disclosed a DOE theory.  
22 The Court agrees with ASUS.

23 First, the Court finds that Judge Tigar’s order denying summary judgment did not  
24 rule, as RR contends, that RR’s infringement contentions sufficiently disclosed a DOE  
25 theory. Rather, that order denied summary judgment based on Federal Rule of Civil  
26 Procedure 56(d), finding the motion premature and explicitly declining to rule on the  
27 substance of the motion. Dkt. No. 112 at 3. Judge Tigar did allow RR to proceed in  
28 discovery based on a representative theory. *Id.* But contending that a group of uncharted

1 products infringes in the same manner as a charted product is not equivalent to contending  
2 that a product or group of products infringe based on the DOE. A representative theory  
3 requires RR to demonstrate that an uncharted product infringes every accused claim of the  
4 patent in the same way as a charted product, whereas showing that a product infringes based  
5 on the DOE requires RR to demonstrate that a particular element of a product (charted or  
6 uncharted) “performs the substantially same function in substantially the same way with  
7 substantially the same result as each claim limitation of the patented product or method.”  
8 *AquaTex Indus., Inc. v. Techniche Solutions*, 479 F.3d 1320, 1326 (Fed. Cir. 2007); *see also*  
9 *Network Prot. Scis., LLC v. Fortinet, Inc.*, No. 12-cv-01106 WHA, 2013 WL 5402089, at  
10 \*3 (N.D. Cal. Sept. 26, 2013) (allowing representative charting and expert testimony  
11 supporting representative theory when expert stated “all versions of the code literally  
12 infringe all of the elements of the asserted claims.”).

13 Here, RR may have sufficiently put ASUS on notice that it would seek to prove that  
14 the uncharted products infringe in the same way as the charted products, but that does not  
15 excuse RR for blanket contentions that do not sufficiently identify the DOE as the manner  
16 that the products infringe. It is not sufficient in our District to simply “disclose ‘whether’  
17 [the patentee] will assert a theory of infringement under the doctrine of equivalents.”  
18 *France Telecom, S.A. v. Marvell Semiconductor, Inc.*, No. 12-cv-04967 WHA (NC), 2013  
19 WL 1878912, at \*5 (N.D. Cal. May 3, 2013). Rather, in infringement contentions, “a party  
20 looking to rely on equivalents still has to *describe how* [the function/way/result]  
21 requirements are met.” *Dynetix*, 2013 WL 4537838, at \*1 (emphasis added).

22 RR did not sufficiently describe how, for each claim element, a component of a  
23 charted product performed the same function, in the same way, to achieve the same result.  
24 Instead, RR included placeholder language stating that “to the extent that any claim element  
25 is found not to be literally embodied in the Accused Instrumentalities, Round Rock  
26 contends that the Accused Instrumentalities embody such claim elements under the doctrine  
27 of equivalents.” *See, e.g.*, Dkt. No. 196-7 at 3. This is insufficient to assert a DOE theory,  
28

1 and RR’s experts cannot now articulate that theory at this late stage.<sup>1</sup> *See OptimumPath,*  
2 *LLC v. Belkin Int’l, Inc.*, No. 09-cv-01398 CW, 2011 WL 1399257, at \*8 (N.D. Cal. Apr.  
3 12, 2011) *aff’d*, 466 F. App’x 904 (Fed. Cir. 2012) (finding that “blanket statements” which  
4 failed to link similarities to particular claims or limitations in the relevant patent barred  
5 claim under doctrine of equivalents); *CSR Tech. Inc. v. Freescale Semiconductor*, No. 12-  
6 cv-02619 RS (JSC), 2013 WL 503077, at \*8 (N.D. Cal. Feb. 8, 2013) (rejecting as  
7 insufficient under Rule 3-1(e) plaintiff’s “boilerplate recitation” that “functionality is at  
8 most unsubstantially different from the claimed functionality”); *Implicit Networks Inc. v.*  
9 *Hewlett-Packard Co.*, No. 10-cv-03746 SI, 2011 WL 3954809, at \*3 (N.D. Cal. Sept. 7,  
10 2011) (finding contentions must provide “specific analysis, on an element-by-element basis,  
11 as to its theory of why there is infringement under the doctrine of equivalents.”); *France*  
12 *Telecom*, 2013 WL 1878912, at \*5-6.

13 For this reason, the Court grants ASUS’s motion to strike portions of the expert  
14 reports of Taylor and Afromowitz opining on a DOE theory of infringement.

15 **ii. Indirect Infringement**

16 ASUS next argues that like the contentions regarding DOE, RR’s contentions  
17 asserting indirect infringement are boilerplate and RR now attempts to add new theories  
18 through expert reports. Dkt. No. 196 at 12. The Court agrees and therefore grants the  
19 motion to strike expert reports opining on indirect infringement.

20 A patentee cannot include a placeholder in its contentions that generally asserts  
21 indirect infringement, and then later clarify the exact infringement theory through an expert  
22 report. *See Dynetix*, 2013 WL 4537838, at \*1 (barring introduction of new theories through  
23 expert reports). Such a process would contravene our Local Rules, which require the  
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25 <sup>1</sup> To the extent that the infringement contentions are slightly more specific in asserting a DOE  
26 theory for the ’791 patent, those contentions still fail to meet the requirements of the Local Rules  
27 because they do not identify how specific components of the Accused Instrumentalities infringe  
28 under a DOE theory on a claim-by-claim basis. *See CSR Tech.*, 2013 WL 503077, at \*9 (finding  
DOE contentions insufficient because the contention “references the entire Accused Product, rather  
than discrete components[.]”).

1 parties to “crystallize their theories of the case early in the litigation and to adhere to those  
2 theories once they have been disclosed.” *Nova Measuring Instruments*, 417 F. Supp. 2d at  
3 1123. In its infringement contentions, RR states that ASUS “actively, knowingly, and  
4 intentionally induced” third parties to infringe its patents by “selling or otherwise  
5 supplying” accused products, and by “the creation and dissemination of promotional and  
6 marketing materials, supporting materials, instructions, product manuals, and/or technical  
7 information” related to the accused products. Dkt. No. 196-7 at 2. Such a broad contention  
8 could contemplate indirect infringement through sales of any number of products, with any  
9 number of components, to any number of customers. These type of boilerplate contentions  
10 are insufficient under the Local Rules. *See Creagri, Inc. v. Pinnaclife Inc., LLC*, No. 11-cv-  
11 06635 LHK (PSG), 2012 WL 5389775, at \*5 (N.D. Cal. Nov. 2, 2012) (“Although  
12 [plaintiff] is not obligated to identify the third-party infringers, it must still disclose how  
13 exactly it believes [defendant] indirectly or contributorily infringed.”); *France Telecom*,  
14 2013 WL 1878912, at \*5 (contention stating a “bare-boned recitation of the essential  
15 elements of a claim for indirect infringement” was insufficient, because the Local Rules  
16 require “a description of the acts of the alleged indirect infringer”); *Bender v. Maxim*  
17 *Integrated Prods., Inc.*, No. 09-cv-01152 SI, 2010 WL 2991257, at \*4 (N.D. Cal. July 29,  
18 2010) (contention that defendant “teaches, instructs, and explains in its datasheets how to  
19 carry out acts of direct infringement” not sufficient where plaintiff “[did] not identify the  
20 data sheets or the specific products to which he refers.”).

21 RR’s experts now seek to clarify the indirect infringement theories through their  
22 reports. For example, Taylor’s report opines that ASUS indirectly infringes by selling  
23 “server products that do not include DDR3 SDRAM memory modules as sold” and then  
24 directing “its customers through its server specification documents to incorporate the  
25 servers with DDR3 SDRAM.” Dkt. No. 196-2 at ¶¶ 224, 227. Although RR did not need  
26 to provide detailed evidence in its infringement contentions supporting this theory of  
27 indirect infringement, it did need to specifically include the theory. It cannot clarify its  
28 theory at this late stage of the litigation through an expert report.

1 The Court therefore grants ASUS’s motion to strike portions of the Taylor and  
2 Afromowitz’s reports regarding indirect infringement.

3 **iii. “Tran\_Speed” and “Bus\_Width Bit”**

4 Next, ASUS moves to strike references in Taylor’s report regarding “Bus\_Width bit”  
5 and “TRAN\_SPEED slice,” arguing that these data elements were not previously identified  
6 in RR’s infringement contentions as infringing elements and RR cannot now identify them  
7 through experts. Dkt. No. 196 at 9. The Court agrees.

8 In its infringement contentions, RR specifically identifies “a HS\_TIMING bit” as the  
9 element that operates to infringe the ’053 patent. Dkt. No. 196-7 at 8. Now, RR’s experts  
10 identify “Tran\_Speed” and “Bus\_Width Bit” as being the elements that possibly operate in  
11 an infringing manner. Dkt. No. 258-5 at 110, 121. Although the infringement contentions  
12 include the term “BUS\_WIDTH” in a copied and pasted chart, Dkt. No. 196-7 at 9,  
13 nowhere do the contentions explain this element or how it infringes a claim in the ’053  
14 patent. RR cannot now litigate a theory that the claim limitation reads on these two  
15 elements, and ASUS’s motion to strike references to “Tran\_Speed” and “Bus\_Width Bit” is  
16 therefore granted. *See Dynetix*, 2013 WL 4537838, at \*1 (finding a “separate feature” of an  
17 identified instrumentality could not be added on the eve of trial).

18 **iv. Infringement Under Section 271(g)**

19 ASUS next moves to strike testimony regarding ASUS’s alleged infringement under  
20 section 271(g). Dkt. No. 196 at 21. ASUS argues that, because RR contended that third  
21 parties—but not ASUS—infringed under § 271(g), RR’s expert cannot now opine as to  
22 whether ASUS itself infringed under § 271(g). The Court agrees with ASUS. The Local  
23 Rules require the patentee to assert how “each opposing party” infringes each claim,  
24 “including for each claim the applicable statutory subsections of 35 U.S.C. § 271 asserted.”  
25 Patent Local R. 3-1. Asserting that a non-party infringed based on § 271(g) is not sufficient  
26 to assert that a different party infringed under that section. RR’s infringement contentions  
27 did not put ASUS on notice that RR would allege ASUS itself infringed under this section,  
28 and RR’s expert cannot now raise that theory. The Court therefore strikes testimony



1 regarding ASUS's alleged infringement under § 271(g).

2 **v. Incorrect Claim Construction for BARC Limitation**

3 ASUS seeks to strike Afromowitz's opinions relating to the BARC limitation of the  
4 '276 patent because ASUS contends that Afromowitz applied the wrong claim construction,  
5 making his opinions irrelevant and unreliable. Dkt. No. 196 at 20-21. ASUS argues that  
6 Afromowitz relied on RR's earlier proposed construction of BARC ("a coating that has an  
7 index of refraction, an extinction coefficient, and a thickness"), which RR later abandoned  
8 in favor of ASUS's proposed construction ("a coating that is disposed between a patterning  
9 resist layer and underlying reflective structures to enhance control of critical dimensions in  
10 the patterning resist layer by suppressing reflective notching, standing wave effects, and the  
11 swing ratio caused by thin film interference."). *Id.* at 20. In response, RR contends that  
12 Afromowitz's opinions about the BARC limitation are relevant and reliable because: 1) the  
13 Court never adopted ASUS's claim construction; and 2) Afromowitz stated that his opinion  
14 would not change even if he adopted ASUS's claim construction. Dkt. No. 222-3 at 19-20.  
15 The Court agrees with RR.

16 Under the Federal Rules of Evidence, expert testimony is only admissible if it is  
17 relevant and reliable. *Kumho Tire Co., Ltd. v. Carmichael*, 526 U.S. 137, 149 (1999).  
18 "[E]vidence based upon a mistaken construction of a patent is irrelevant." *Chicago*  
19 *Mercantile Exch., Inc. v. Tech. Research Grp., LLC*, 782 F. Supp. 2d 667, 673 (N.D. Ill.  
20 2011). It is therefore appropriate to exclude expert opinion based on an incorrect claim  
21 construction. *See Liquid Dynamics Corp. v. Vaughan Co., Inc.*, 449 F.3d 1209, 1224 n.2  
22 (Fed. Cir. 2006) (holding that district court did not abuse its discretion by excluding expert  
23 testimony based on an incorrect claim construction); *Hochstein v. Microsoft Corp.*, No.  
24 04-cv-073071 PDB, 2009 WL 2022815, at \*1 (E.D. Mich. July 7, 2009) (excluding expert  
25 testimony based on incorrect claim construction).

26 Although Afromowitz states that he agrees with RR's proposed construction, he  
27 recites ASUS's proposed claim construction and expressly states that "[t]o the extent the  
28 Court adopts ASUS's proposed construction for any of the above terms, that construction

1 would not change my opinion that the accused ASUS products infringe the '276 patent.”  
2 Dkt. No. 197-6 at ¶ 38. Even if RR agreed to use ASUS’s proposed claim construction,  
3 Afromowitz’s opinion is relevant because he expressly considered ASUS’s proposed claim  
4 construction when he formed his opinion. The Court therefore denies ASUS’s motion to  
5 strike Afromowitz’s opinions relating to the BARC limitation of the '276 patent.

6 **vi. Theories New to Proposed Supplemental Contentions**

7 When ASUS moved to strike infringement opinions in Taylor and Afromowitz’s  
8 reports that relate to theories first introduced in RR’s proposed supplemental contentions,  
9 the Court had not yet ruled on RR’s motion to amend its infringement contentions. Dkt.  
10 Nos. 155; 196 at 22; 212. The Court has since denied RR’s motion. Dkt. No. 212. Because  
11 the parties have not briefed the issue and ASUS has not identified which portions of the  
12 reports should be stricken based on denial of the motion for leave to amend the  
13 infringement contentions, the Court is not in a position to rule on this portion of ASUS’s  
14 motion to strike. The Court therefore denies the motion without prejudice.

15 **vii. Expert Testimony Based on New Reverse Engineering Reports**

16 ASUS moves to strike expert testimony regarding new reverse engineering reports for  
17 image sensors, as part of the discussion of the '276 and the '353 patents. Dkt. No. 196 at  
18 11. ASUS claims that because these image sensors were not reverse engineered in the  
19 initial infringement contentions, including that evidence now is akin to introducing a new  
20 theory of infringement. The Court disagrees with ASUS.

21 RR must be permitted to provide evidence supporting its argument that the uncharted  
22 products infringe in the same way as the charted products. ASUS points to several  
23 differences between the alleged manner of infringement for the newly reverse engineered  
24 sensors, and the originally charted sensors. *Id.* ASUS should direct these arguments to  
25 Judge Tigar or the jury. Whether RR can prove the representative nature of infringement,  
26 i.e., that the products containing newly reverse engineered sensors infringe in the same  
27 manner as the charted products, is a matter to be determined at summary judgment or trial.  
28 Alleged differences between the charted and uncharted products are not a reason to strike

1 evidence regarding the uncharted products.

2 **viii. Taylor Opinions Based on Third Party Documents Not Produced**

3 ASUS next moves to exclude testimony regarding Kingston documents that RR  
4 admits it inadvertently withheld during discovery. *Id.* When a party fails to produce  
5 discovery as required, his opponent may move to strike references to the undisclosed  
6 discovery based on Federal Rule of Civil Procedure 37. On such a motion, “[t]he violating  
7 party . . . has the burden of proving substantial justification and lack of prejudice.” *Nesby v.*  
8 *City of Oakland*, No. 05-cv-03555 JL, 2006 WL 3388629, at \*2 (N.D. Cal. Nov. 22, 2006).  
9 Here, although RR alleges that some of the documents withheld are identical to documents  
10 already in ASUS’s possession, they have not demonstrated that *every* undisclosed Kingston  
11 document was already in ASUS’s possession. Similarly, although ASUS’s expert testified  
12 regarding some of the Kingston documents, ASUS states that had it received the Kingston  
13 documents sooner, it could have “conducted discovery of Kingston with respect to the  
14 circuits discussed in the documents to test whether the various options are actually  
15 implemented in the relevant components.” Dkt. No. 258-4 at 16. RR has not met its burden  
16 of demonstrating that its withholding of the Kingston documents was justified or will not  
17 prejudice ASUS. Therefore, the Court grants ASUS’s motion to strike references in RR  
18 expert reports regarding the withheld Kingston documents. The Court finds it appropriate  
19 and fair to also exclude references to the withheld documents in ASUS’s rebuttal expert  
20 report.

21 **ix. Taylor and Yurkerwich Testimony Based on Newly Identified Infringing**  
22 **Products**

23 ASUS moves to strike references in the expert reports of Taylor and Yurkerwich to  
24 allegedly infringing products that ASUS claims were not specifically identified in RR’s  
25 infringement contentions. Dkt. No. 330-3. RR argues that all the products at issue were  
26 identified in the infringement contentions because: 1) RR identified products that include  
27 DDR3 memory; 2) RR identified products that have different names but are substantially  
28 similar to other identified products; or 3) RR identified specific series of infringing ASUS

1 products.

2 The Court finds that identifying products “that include DDR3 SDRAM memory” or  
3 otherwise practice the JEDEC standard is not sufficient to specifically identify products that  
4 may fall into those categories. Although identifying that a component practices a standard  
5 may be useful for proving an infringement theory across several products that contain that  
6 component, identifying a standard is not sufficient to specifically name an accused product.  
7 *See Oracle Am., Inc. v. Google Inc.*, No. 10-cv-03561 WHA, 2011 WL 4479305, at \*2  
8 (N.D. Cal. Sept. 26, 2011) (finding that accusing all products running Android did not  
9 specifically identify products, because “[r]epresentative examples may be a useful tool for  
10 proving an infringement case at trial, but a full list of accused products must be disclosed as  
11 part of a party’s infringement contentions.”).

12 The Local Rules place the burden on the patentee to specifically identify accused  
13 products for each claim. The Rule requires that “[t]his identification shall be as specific as  
14 possible. Each product, device, and apparatus shall be identified by name or model number,  
15 if known.” Patent Local R. 3-1(b). RR does not assert that it could not have specifically  
16 identified ASUS products it alleges contain DDR3 memory in the initial infringement  
17 contentions, which appear for the first time in Taylor and Yurkerwich’s expert reports.  
18 Although RR argues that identifying the standard was sufficient to put ASUS on notice of  
19 the accused products practicing the standard, the Local Rules required RR to do the work of  
20 identifying those products. *See Oracle Am.*, 2011 WL 4479305, at \*2 (“Even if it would  
21 have been easy for Google to compile an accurate list of all the devices Oracle considered to  
22 be Android devices, Rule 3-1(b) required Oracle to provide such a list in its disclosure of  
23 infringement contentions.”); *see also EON CorpIP Holding LLC v. Spring Spectrum, L.P.*,  
24 No. 12-cv-01011 JST, 2014 WL 1022536, at \*3 (N.D. Cal. Mar. 13, 2014) (“The Local  
25 Patent Rules do not tolerate broad categorical definitions.”). ASUS’s motion to strike  
26 references to newly accused products that RR alleges were identified as practicing the  
27 JEDEC standard is therefore granted.

28 Similarly, the Court finds that identifying a product that has a different name, but

1 which RR claims is substantially similar to a named product, is not sufficient identification  
2 under the Local Rules. RR points to evidence showing that the EP101, TF201, and the  
3 TF300TL have the same components or are otherwise similar to products identified in the  
4 infringement contentions. RR provides no explanation for why it did not specifically  
5 identify these three products and, for the same reasons as discussed above, RR cannot now  
6 accuse these newly identified products through expert reports. The Court therefore strikes  
7 the portions of the expert reports referencing allegedly infringing products that have  
8 different names, but which RR claims are substantially similar to a named product.

9 Finally, the Court finds that although somewhat more specific than identifying a  
10 product based on practicing a standard, RR's identification of a "series" of products was not  
11 sufficient under the Local Rules to identify the products within a series, as the infringement  
12 contentions did not identify each accused product as specifically as possible.

13 No court appears to have answered whether identifying a line or series of products is  
14 sufficient to identify the products within that series, although several cases have discussed  
15 infringement contentions identifying series of allegedly infringing products without directly  
16 addressing the issue. *See DCG Sys. v. Checkpoint Techs., LLC*, No. 11-cv-03792 PSG,  
17 2012 WL 1309161, at \*2 (N.D. Cal. Apr. 16, 2012) (finding infringement contentions  
18 sufficiently identified infringement theory as to the "Checkpoint 300-Series"); *Elantech*  
19 *Devices Corp. v. Synaptics, Inc.*, No. 06-cv-01839 CRB, 2007 WL 3256229, at \*2 (N.D.  
20 Cal. Nov. 5, 2007) (infringement contentions accused "TM41 series of touchpad devices");  
21 *Nilssen v. Osram Sylvania, Inc.*, 528 F.3d 1352, 1354 (Fed. Cir. 2008) (infringement  
22 contentions charted "five accused Osram product lines"). These cases do not discuss  
23 whether the series was a single product or multiple products, whether the patentee identified  
24 the products within that series or line in its infringement contentions, or whether the  
25 patentee could not have more specifically identified the products within the series.

26 Here, RR's list of Accused Instrumentalities itself demonstrates that naming a  
27 "series" of products was not identification that was "as specific as possible" for "[e]ach  
28 product, device, and apparatus" as required by the Local Rules. Patent Local R. 3-1(b). For

1 some series, next to the series name RR more specifically identified, by model number,  
2 certain products within the series. For example, for the “N61 Series,” RR more specifically  
3 identified in a parenthetical four devices within that series, “(N61DA; N61Ja; N61Jq;  
4 N61Jv).” Dkt. No. 223-4 at 4. But now, RR’s expert opines on the N61V product, which  
5 was not specifically identified.

6 RR does not even argue, yet alone demonstrate, that at the time it served its  
7 infringement contentions it was unable to identify more specifically products within the  
8 product series, and the Court will not make that assumption. Even if RR did not know at  
9 the time of serving its contentions about the specific model numbers of products within the  
10 series, it should have amended its contentions to add this information once ASUS provided  
11 discovery for these products and the specific model became known to RR. *See Dynetix*,  
12 2013 WL 4537838, at \*1 (stating “if our local rules are to have any teeth, [infringing  
13 products or theories] must be adequately disclosed and supplemented along the way, should  
14 new evidence arise in discovery.”). It was not unreasonable for ASUS to believe that only  
15 those products specifically identified in parentheses by model number, organized by  
16 series, were the accused products. ASUS would be prejudiced by adding new products into  
17 the case at this late stage, and RR has not demonstrated that its failure to name the products  
18 was justified. The Court therefore grants ASUS’s motion to strike products within a series  
19 not specifically identified by model number.

## 20 **B. RR’s Motion to Strike**

### 21 **i. Baker’s Reports on Prior Art and Invalidity Theories Not Disclosed in** 22 **Contentions**

23 RR moves the Court to strike portions of Baker’s reports that rely on prior art and  
24 invalidity theories not disclosed in ASUS’s invalidity contentions. Dkt. No. 246-3 at 16.  
25 RR alleges that ASUS’s invalidity contentions did not disclose the following references:  
26 Robinson for the ’053 patent; Wolf, Pike, and Gehoel for the ’276 patent; Wolf for the ’353  
27 patent; JESD79R1 and Atsumi for the ’791 patent; JESD79R1, Item 1198 at Meeting 96,  
28 and Li for the ’949 patent. Dkt. No. 246-3 at 16.

1 At the hearing, counsel for ASUS indicated that new information may appear in its  
2 expert reports because ASUS did not yet know the scope of the infringement contentions, as  
3 the Court had not ruled on RR’s motion to amend or ASUS’s first motion to strike. ASUS  
4 provided the Court with a chart listing those references that ASUS would agree to strike if  
5 the Court were to apply the Local Rules to limit RR’s newly disclosed theories. Dkt. No.  
6 301-1. The Court orders all references stricken as agreed by ASUS in Dkt. No. 301-1. The  
7 Court addresses only those references and theories that appear to still be in dispute.

8 **a) New References**

9 **1. Robinson for the ’053 Patent**

10 RR moves to strike the portions of Baker’s report on the invalidity of the ’053 patent  
11 that rely on Robinson because Robinson was not disclosed in ASUS’s Invalidation  
12 Contentions. Dkt. No. 246-3 at 16. ASUS concedes that Robinson was not disclosed in its  
13 Invalidation Contentions, but contends that RR’s motion is moot because ASUS does not rely  
14 on Robinson to support its invalidity case. Dkt. No. 274-3 at 11 n.8. Regardless of whether  
15 ASUS is relying on Robinson for its invalidity case, the Court finds that Robinson was not  
16 disclosed in ASUS’s Invalidation Contentions but is repeatedly referenced in Baker’s report  
17 on the invalidity of the ’053 patent. Dkt. Nos. 246-6, 247-7. The Court therefore strikes the  
18 portions of Baker’s report that rely on Robinson.

19 **2. Wolf, Pike, and Gehoel for the ’276 Patent; Wolf for the ’353**  
20 **Patent**

21 RR moves to strike the portions of Baker’s report on the ’276 patent that rely on  
22 Wolf, Pike, and Gehoel, as well as the portions of Baker’s report on the ’353 patent that rely  
23 on Wolf, because those references were not disclosed in ASUS’s Invalidation Contentions.  
24 Dkt. No. 246-3 at 10-11. ASUS argues that the Court should not strike expert opinion  
25 relying on Wolf because Baker only relied on Wolf as “evidence of the knowledge of one of  
26 skill in the art at the time of the invention” and “evidence that planarization techniques were  
27 well known in the art.” Dkt. No. 274-3 at 9-10. ASUS does not dispute that Pike and  
28 Gehoel were not disclosed in its Invalidation Contentions. Rather, ASUS argues that Baker’s

1 reliance on those references will not prejudice RR because ASUS identified those  
2 references in its responses to interrogatories. *Id.* at 11-12.

3 Because Wolf was not disclosed in ASUS's Infringement Contentions, the Court  
4 strikes Baker's report to the extent that Baker relied on Wolf as an anticipation or  
5 obviousness reference. However, Baker may use Wolf for other purposes, e.g., to show the  
6 knowledge of a PHOSITA. *See Brilliant Instruments*, 2011 WL 900369, at \*2 (striking  
7 portions of expert report relying on undisclosed prior art only to the extent that the reference  
8 was used as anticipatory prior art).

9 Because ASUS did not disclose Pike in its Invalidity Contentions, the Court strikes  
10 the portions of Baker's report that use Pike as an anticipation or obviousness reference.  
11 ASUS had a duty to amend its Invalidity Contentions, and it did not discharge that duty by  
12 disclosing Pike and Gehoel in its discovery responses. *Volterra Semiconductor*, 796 F.  
13 Supp. 2d at 1119 (“[T]he fact that Defendants may have produced some of the prior art  
14 references in discovery or disclosed them in expert reports does not excuse Defendants from  
15 their obligation to amend their invalidity contentions under the Patent Local Rules.”).

16 **3. JESD79R1 and Atsumi for the '791 Patent; JESD79R1, Item**  
17 **1198 at Meeting 96, and Li for the '949 Patent**

18 RR moves to strike the portions of Baker's report on the '791 patent that rely on  
19 JESD79R1 and Atsumi, as well as the portions of Baker's report on the '949 patent that rely  
20 on JESD79R1, Item 1198 at Meeting 96, and Li because ASUS did not disclose those  
21 references in its Invalidity Contentions. Dkt. No. 246-3 at 11. ASUS does not dispute that  
22 it did not disclose JESD79R1, Item 1198 at Meeting 96, and Li. Instead, ASUS argues that  
23 RR was aware of these references because ASUS used JESD79R1 as extrinsic evidence in  
24 claim construction, JESD79R1 is the standard that the '949 patent is based on, RR and  
25 ASUS both became aware of Item 1198 when they were produced by JEDEC, and Li is  
26 incorporated by reference into the '949 patent itself. Dkt. No. 274-3 at 11. ASUS concedes  
27 that Atsumi was not disclosed in its Invalidity Contentions, but argues that RR's objections  
28 are moot because ASUS is not relying on Atsumi to prove invalidity. *Id.*



1 Because ASUS did not disclose JESD79R1 and Atsumi in its Invalidity Contentions,  
2 the Court grants RR’s motion to strike the portions of Baker’s reports that rely upon those  
3 references to opine that the ’791 patent is invalid. *See Volterra Semiconductor*, 796 F.  
4 Supp. 2d at 1119.

5 **b) New Anticipation and Obviousness Theories or Combinations**

6 RR alleges that Baker presented anticipation theories and obviousness combinations  
7 not disclosed in ASUS’s invalidity contentions. Dkt. No. 246-3 at 16-17. The Court  
8 considers RR’s arguments in turn.

9 **1. The ’276 Patent**

10 RR moves to strike the portions of Baker’s report that opine that Chen-981 and  
11 Fossum anticipate the ’276 patent because ASUS’s Invalidity Contentions allegedly did not  
12 disclose that anticipation theory. *Id.* at 10. ASUS argues that its Invalidity Contentions did  
13 disclose an anticipation theory based on Chen-981 because ASUS provided a chart showing  
14 where in Chen-981 each limitation of the ’276 patent is found. Dkt. No. 274-3 at 7-8.

15 The Court agrees with ASUS. ASUS’s Invalidity Contentions do in fact show where  
16 in Chen-981 each limitation of claim 1 of the ’276 patent is found, which adequately  
17 identifies the “item of prior art that allegedly anticipates each asserted claim . . . , [indicates]  
18 [w]hether each item of prior art anticipates each asserted claim . . . . [and identifies] where  
19 specifically in each alleged item of prior art each limitation of each asserted claim is  
20 found[.]” Patent Local R. 3-3. The Court therefore denies RR’s motion to strike Baker’s  
21 anticipation opinions based on Chen-981.

22 As to Fossum, ASUS argues that Baker did not opine that Fossum anticipates the ’276  
23 patent, but instead said that Fossum “discloses and/or renders obvious each *limitation of*  
24 claims 1, 3, 5, 8, 9, and 11.” Dkt. No. 274-3 at 8. Even if the Court adopted ASUS’s  
25 distinction between anticipating a claim and disclosing each limitation in a claim, Fossum’s  
26 opinion is not supported by ASUS’s Invalidity Contentions, which do not list Fossum as a  
27 reference for each claim limitation. Dkt. No. 247-4 at 9. The Court therefore strikes  
28 portions of Baker’s report to the extent that Baker opines that Fossum anticipates the ’276

1 patent. To the extent that ASUS did not list Fossum as a reference for particular limitations  
2 of claim 1, Baker's report may not opine that Fossum discloses those limitations, and the  
3 Court therefore strikes those portions of the report.

#### 4 **2. The '353 Patent**

5 RR moves to strike Baker's opinions on the invalidity of the '353 patent based on  
6 AAPA-353 in view of Wolf. *Id.* As discussed above, the Court strikes Baker's opinions to  
7 the extent that they use Wolf as an obviousness reference because Wolf was not disclosed in  
8 ASUS's Invalidation Contentions.

#### 9 **3. The '949 Patent**

10 RR moves to strike portions of Baker's report opining that JESD79R1 anticipates the  
11 '949 patent, Li anticipates the '949 patent, and Item 1198 at Meeting 96 renders the '949  
12 patent obvious in view of JESD79R1. *Id.* at 17. As discussed above, because these  
13 references were not disclosed in ASUS's Invalidation Contentions, the portions of Baker's  
14 report that rely on these references are stricken.

15 RR moves to strike Baker's opinion that Dodd renders the '949 patent obvious in  
16 view of JESD79R1, Miki, Li, Delaluz, Volk, and AAPA-939; Delaluz renders the '949  
17 patent obvious in view of JESD79R1, Miki, and the AAPA-949; and Volk renders the '949  
18 patent obvious in view of JESD79R1, Miki, and the AAPA-949. *Id.* Because ASUS's  
19 Invalidation Contentions only disclose Dodd, Delaluz, and Volk as anticipation references, the  
20 Court strikes the portions of Baker's report that use those references in obviousness  
21 combinations.

#### 22 **4. The '791 Patent**

23 RR moves to strike Baker's opinions that Mills renders the '791 patent obvious in  
24 view of Atsumi, Lee, and JESD79R1; Choi renders the '791 patent obvious in view of Lee  
25 and JESD79R1; and Hwang renders the '791 patent obvious in view of Atsumi, Lee, and  
26 JESD79R1. *Id.* Because ASUS's Invalidation Contentions did not disclose those obviousness  
27 combinations, the Court strikes Baker's opinions based on those combinations.

1           **ii. Baker’s Report Based on Undisclosed Technical Documents and Reverse**  
2           **Engineering Report**

3           RR next moves to strike portions of Baker’s expert report that rely on technical  
4 documents and a Chipworks image sensor testing report that ASUS did not produce during  
5 discovery. Dkt. No. 246-3 at 18.

6           As for the Chipworks image sensor engineering report, the Court grants RR’s motion  
7 to strike portions of Baker’s report referring to or relying upon the engineering report.  
8 ASUS admits that the document was relevant and that it did not produce this report until it  
9 served Baker’s report. Dkt. No. 274-3 at 4. ASUS’s justification is that the report was  
10 attorney work product until ASUS decided to waive the privilege. Even assuming, without  
11 deciding, that the report was protected as attorney work product, the Court finds that ASUS  
12 waived the privilege when it used portions of the report at the Rhodes deposition. *See*  
13 *Ampa Ltd. v. Kentfield Capital LLC*, No. 00-cv-00508 NRB (AJP), 2000 WL 1156860, at  
14 \*1 (S.D. N.Y. Aug. 16, 2000). (“Ampa’s counsel waived any privilege in the Gross letter  
15 when he marked it as an exhibit at a deposition he was conducting and asked a question  
16 about it.”). ASUS should have produced the report to RR at that time. Instead, ASUS  
17 refused to answer questions regarding the origins of the documents at the deposition, and  
18 provided portions of the report that did not include any identifying information. Dkt. No.  
19 246-12 at 26:18-27:9. ASUS thus effectively blocked RR from conducting discovery  
20 regarding the image sensor report. ASUS was not permitted to lie in the weeds with the  
21 report and turn it over at the time it found preferable, despite having evidenced a clear  
22 intention to rely on the report as early as the Rhodes deposition. Therefore, the Court grants  
23 RR’s motion to strike the portions of Baker’s report that reference or rely upon the  
24 Chipworks image sensor report.

25           Similarly, ASUS admits the relevance and responsiveness of the NVIDIA Tegra 2  
26 manual that its expert references, despite ASUS not having identified or produced the  
27 manual to RR prior to serving its expert reports. Dkt. No. 274-3 at 6. As discussed earlier  
28 when analyzing ASUS’s motion to strike based on withheld documents, on a Rule 37

1 motion, “[t]he violating party . . . has the burden of proving substantial justification and lack  
2 of prejudice.” *Nesby*, 2006 WL 3388629, at \*2 (citations omitted). ASUS has not met its  
3 burden. ASUS does not explain why it could not have identified or produced the document  
4 sooner, and RR has shown it was prejudiced by the late disclosure. References to this  
5 document are therefore stricken.

6 **iii. Ugone’s Report based on Facts Withheld on Privilege**

7 RR moves to strike portions of the expert report of Dr. Keith Ugone, ASUS’s  
8 damages expert, which relied on information that ASUS previously withheld on the basis of  
9 privilege. Dkt. No. 246-3 at 20. In the deposition of ASUS employee Jacky Lu, ASUS  
10 objected on privilege grounds when RR attempted to ask Lu about the factors that ASUS  
11 considers when entering into patent license agreements. *See* Dkt. No. 246-9. But in  
12 Ugone’s report, it is clear that Lu shared that privileged information with Ugone, as Ugone  
13 references in his expert report the conversations that he had with Lu on this topic. *See* Dkt.  
14 No. 246-8. RR therefore claims that it is prejudiced by ASUS sharing the information with  
15 its expert, but not allowing RR to question Lu on the same topic.

16 ASUS does not deny that Ugone references information that it previously withheld on  
17 privilege grounds. Instead, ASUS argues that the prejudice to RR is minimal because  
18 Ugone did not exclusively rely on information obtained from Lu in reaching any of his  
19 conclusions, and that whatever prejudice exists can be cured by allowing RR a further  
20 deposition of Lu on this topic. The Court agrees with ASUS. After reviewing Ugone’s  
21 report, it appears that Ugone had several bases for reaching each of his conclusions, and did  
22 not rely exclusively on the information gathered from Lu. Nonetheless, Ugone did rely on  
23 this information to some extent, and therefore some prejudice remains because RR was  
24 denied a fair opportunity during discovery to explore this issue with Lu. The Court  
25 therefore orders ASUS to provide Lu for a further deposition, to be held in the Bay Area  
26 and not to exceed two hours, on the subject of ASUS’s negotiation of patent licenses. The  
27 Court notes that it is very late in the game for depositions to take place, and the parties must  
28 therefore complete this additional deposition within 14 days of this order. If RR wishes to

1 amend its expert reports based on the information it obtains from Lu, it must do so within 7  
2 days of receipt of the deposition transcript.

3 **CONCLUSION**

4 The Court grants in part and denies in part each party's motion to strike portions of  
5 expert reports, as discussed above. Because the parties did not provide the Court with a list  
6 of the paragraphs or lines of reports that they seek to strike, organized argument by  
7 argument, the Court is not in a position to order the specific paragraphs to be stricken. The  
8 parties must immediately exchange their expert reports redacted to comply with this order.  
9 If the parties cannot agree as to the portions that should be stricken based on this order, then  
10 they must submit a joint letter brief to the undersigned judge, within 7 days of this order,  
11 explaining the disagreement and including each party's list of proposed paragraphs or lines  
12 of expert reports to be stricken, organized by argument, as set forth in this order. The Court  
13 recognizes that this is a tight time frame, but finds it necessary based on the stage of this  
14 litigation. The parties are encouraged to take reasonable positions and come to an  
15 agreement as to the sections to be stricken.

16 Any party may object to this order to Judge Tigar within 14 days. Fed. R. Civ. P.  
17 72(a).

18 IT IS SO ORDERED.

19 Date: April 11, 2014

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Nathanael M. Cousins  
22 United States Magistrate Judge  
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