

1
2
3
4
5
6
7 IN THE UNITED STATES DISTRICT COURT
8 FOR THE NORTHERN DISTRICT OF CALIFORNIA
9

10
11 MEIDATEK, INC.,

12 Plaintiff,

13 v.

14
15 FREESCALE SEMICONDUCTOR, INC.,

16 Defendant.
17

Case No. 11-5341 YGR (JSC)

**ORDER DENYING MOTION TO
COMPEL (DKT. NO. 74)**

18
19 Plaintiff Mediatek, Inc. (“Mediatek”) filed this suit against Defendant Freescale
20 Semiconductor, Inc. (“Freescale”) alleging patent infringement. Now pending before the
21 Court is the parties’ joint discovery letter regarding Mediatek’s motion to compel production
22 of documents. Mediatek seeks to compel Freescale to respond to discovery related to
23 products which Mediatek did not specifically identify as accused products in its Preliminary
24 Infringement Contentions (“PICs”). After careful review of the parties’ submissions, and
25 having had the benefit of oral argument on February 12, 2013, the Court DENIES Mediatek’s
26 motion. If Mediatek wishes to seek discovery of these products on the ground that they
27 infringe the patents-in-suit, it must first seek and be allowed to amend its PICs to include
28 these additional accused products.

United States District Court
Northern District of California

DISCUSSION

1
2 “The overriding principle of the Patent Local Rules is that they are designed [to] make
3 the parties more efficient, to streamline the litigation process, and to articulate with specificity
4 the claims and theory of a plaintiff’s infringement claims.” *Bender v. Maxim Integrated*
5 *Prods., Inc.*, 2010 WL 1135762, at *2 (N.D. Cal. Mar. 22, 2010) (alteration in original)
6 (internal citation omitted). Patent Local Rule 3-1 is a discovery device that “takes the place
7 of a series of interrogatories that defendants would likely have propounded had the patent
8 local rules not provided for streamlined discovery.” *Network Caching Tech., LLC v. Novell,*
9 *Inc.*, 2002 WL 32126128, at *4 (N.D. Cal. Aug. 13, 2002). The Rules are also intended to
10 require the party claiming infringement “to crystallize its theories of the case early in the
11 litigation and to adhere to those theories once disclosed.” *Bender v. Advanced Micro*
12 *Devices, Inc.*, 2010 WL 363341, at *1 (N.D. Cal. Feb. 1, 2010).

13 The Rules “place the burden of specifically identifying all accused devices on the
14 plaintiff.” *Infineon Technologies AG v. Volterra Semiconductor Corp.*, 2012 WL 6184394, at
15 *3 (N.D. Cal. Dec. 11, 2012). To that end, they require the party claiming infringement to
16 separately identify for each asserted claim, each accused apparatus, product, device,
17 process, method, act, or other instrumentality (“Accused Instrumentality”) of each
18 opposing party of which the party is aware. This identification shall be as specific as
19 possible. Each product, device, and apparatus shall be identified by name or model
number, if known.

20 Patent L.R. 3-1(b). This Rule requires “*specific* identification of particular accused products.”
21 *Oracle America v. Google Inc.*, 2011 WL 4479305, at *2 (N.D. Cal. Sep. 26, 2011). “It does
22 ‘not tolerate broad categorical identifications’ or ‘the use of mere representative examples.’”
23 *Infineon Technologies, AG*, 2012 WL 6184394, at *3 (quoting *Oracle America*, 2011 WL
24 4479305 *2). Further, if a party wishes to amend contentions to add additional accused
25 products, it may only do so “by order of the Court upon a timely showing of good cause.”
26 Patent L.R. 3-6. Good cause may include the “recent discovery of nonpublic information
27 about the Accused Instrumentality which was not discovered, despite diligent efforts, before
28 the service of the Infringement Contentions.” *Id.*

1 MediaTek’s infringement contentions identified “by name all of the Freescale products
2 that, as of the PICs’ date, MediaTek had been able to identify from public sources as
3 containing one or more features” which MediaTek contend infringe. (Dkt. No. 74 at 1.) The
4 contentions also “identified” as accused products all “products that operate in the same or
5 substantially similar manner” as the named products. (*Id.*)

6 Mediatek subsequently propounded written discovery on “Freescale Accused
7 Products,” which Mediatek defined as

8 all Freescale products that contain one of the features that MediaTek’s PICs identified
9 as infringing. These infringing features are: (i) a Multi-Layer AHB Crossbar Switch
10 (AHBMAX); (ii) an External Memory Controller (EXTMC) or External Memory
11 Interface (EMI); (iii) a Multi Master Multi Memory Interface (M41F); (iv) QUICC
12 Engine module; (v) an Arbiter Module capable of operating in Fixed Mode and/or
13 Round Robin Mode; (vi) Clock Control Module (CCM) or DVFS load tracking block
14 that enables dynamic voltage frequency scaling.

15 (Dkt. No. 74 at 1.) In other words, even if MediaTek did not identify a Freescale product by
16 name in its PICs, it demands that Freescale produce discovery as to that unnamed product if
17 Freescale determines that the product contains one of the above-identified features.

18 The Court is unpersuaded that MediaTek is entitled to such broad discovery. As the
19 court explained in *Infinion Technologies*—a case upon which MediaTek relies—a party need
20 not identify an accused product by name in the narrow circumstance of when “the plaintiff
21 does not know of the allegedly infringing product when its serves its infringement contentions
22 and could not have discovered the product absent discovery.” 2012 WL 6184394 at *3.
23 MediaTek has failed to meet this standard. The joint discovery letter does not explain why
24 publicly available documents allowed it to identify nine Freescale product families, but
25 Freescale’s publicly available documents as to other products are insufficient. Instead,
26 MediaTek appears to be asking that Freescale conduct MediTek’s pre-filing investigation for
27 it. The Local Rules do not envision nor permit such a process. Since the additional products
28 on which MediaTek seeks discovery have not been accused in this case, MediaTek is not
entitled to discovery as to those products (unless such discovery is somehow related to the
claims involving the accused products). *See Kelora Systems, LLC v. Target Corp.*, 2011 WL

1 5444419, at *2 (N.D. Cal. Nov. 9, 2011). To require Freescale to produce voluminous
2 discovery related to every product which Freescale determines contains any particular feature
3 eviscerates the goal of the Patent Local Rules to streamline discovery by requiring the party
4 claiming infringement to identify with particularity how each accused product infringes the
5 patents-in-suit. It would also render meaningless the requirement of Patent Local Rule 3-6
6 that a party show “good cause” before being allowed to amend its PICs to include additional
7 accused products.

8 The other cases upon which MediaTek relies highlight the lack of support for its
9 position. In *Epicrealm Licensing, LLC v. Autoflex Leasing, Inc.*, 2007 WL 2580969 (E.D.
10 Tex. 2007), a case in the Eastern District of Texas, the court relied on cases from its own
11 district allowing discovery on the “technical operation of any products reasonably similar to
12 any accused product,” *id.* at *3, as well as the local rules in the Northern District of Texas
13 which expressly direct that “the scope of discovery is not limited to the preliminary
14 infringement contentions or preliminary invalidity contentions but is governed by the Federal
15 Rules of Civil Procedure.” *Id.* A different standard applies here. See *Kelora Systems, LLC*,
16 2011 WL 5444419 at *2. Similarly, *EPOS Technologies v. Pegasus Technologies*, 842
17 F.Supp.2d 31, 32 (D.D.C. 2012), was not applying the Local Rules of this District. Finally, in
18 *Advanced Micro Devices, Inc. v. Samsung Electronics Co*, 2009 WL 1834147, at *3 (N.D.
19 Cal. 2009), the plaintiff identified the specific product on which it was seeking discovery, and
20 established that it had only learned of the product’s infringement from deposition testimony.
21 *Id.* Neither of those circumstances is present here. Moreover, the case was decided before
22 the amendments to the Patent Local Rules which require the infringement plaintiff to identify
23 with specificity the accused products and how they infringe. See *Kelora Systems, LLC*, 2011
24 WL 5444419 at *2.

25 At oral argument MediaTek explained that it had, in fact, identified some additional
26 products, but that it did not know whether the products were manufactured or sold in the
27 United States such that they can be sued upon in this lawsuit. It is apparently MediaTek’s
28 belief that consistent with Federal Rule of Civil Procedure 11 it cannot include such products

1 in its PICs until it has a good faith belief in a United States nexus. While MediaTek's PICs
2 contain no hint that is withholding the identification of products solely because of a lack of
3 information as to a United States nexus, and Freescale does not agree that MediaTek must
4 allege a United States nexus in order to include a product as accused in its PICs, Freescale has
5 nevertheless agreed (with some encouragement from the Court) to advise MediaTek whether
6 particular products as identified by MediaTek were sold or manufactured in the United States.
7 The parties shall meet and confer and agree on a process for the prompt provision of such
8 information to MediaTek in a useful form.

9 MediaTek also explained that it believes there are additional products that infringe, but
10 that these products are not sufficiently identifiable from publicly available websites.
11 According to the representations made at oral argument, its belief is based upon its review of
12 documents already produced by Freescale. In other words, MediaTek contends that Freescale
13 produced non-publicly available documents that reveal additional infringing products that
14 MediaTek could not have identified from publicly available sources. Freescale disagrees. As
15 the parties have never met and conferred to discuss whether these documents actually reveal
16 previously unidentifiable products they shall do so. After a meaningful meet and confer,
17 MediaTek can decide whether to move to amend its PICs to include the products it claims it
18 was only able to identify from non-public sources, as well as whether to renew its motion for
19 specific discovery based on a particularized showing—a showing which it was unable to
20 make in the joint letter brief.

21 Finally, a third category of products are those that were released after the submission
22 of MediaTek's PICs. If MediaTek desires discovery related to those products as infringing, it
23 must seek and obtain permission to amend its PICs to include such products as accused,
24 although the parties may stipulate to such amendment.

25 CONCLUSION

26 Under the Patent Local Rules a party claiming infringement must do everything it
27 reasonably can do to identify all accused products in its PICs; it may not transfer the burden
28 of identifying accused products to the defendant. If a party identifies additional infringing

1 products after service of the PICs, then it must move to amend the PICs to include the
2 additional accused products before seeking discovery on them. This is the orderly process
3 required by the Patent Local Rules and the caselaw in this District.

4 At the same time, however, the Rules do not require the party alleging infringement to
5 perform the impossible. There may be circumstances where publicly available information
6 does not disclose a potentially infringing product and therefore some directed, proportional
7 discovery may be appropriate, but only upon a showing of a reasonable belief that such
8 additional products actually exist and that they cannot be discovered with publicly available
9 information. As such showing has not been made here, MediaTek's motion is denied.

10 The parties shall nevertheless meet and confer in person as directed above. Such meet
11 and confer shall occur on or before February 26, 2013, unless the parties agree otherwise.
12 The parties shall utilize the procedure set forth in this Court's Civil Standing Order with
13 respect to any future discovery disputes. The parties should note that the idea behind the joint
14 discovery letter is to consolidate into one document the motion/opposition/reply of a 35-day
15 noticed motion. Thus, the moving party should file the letter and have the last word; that is, it
16 should be able to respond to the opposing party's portion of the letter just as it would in a
17 reply memorandum. Further, the parties should submit any declarations or exhibits necessary
18 to support their positions with the joint letter.

19 This Order disposes of Docket No. 74.

20
21 **IT IS SO ORDERED.**

22
23 Dated: February 13, 2013

24 
25 _____
26 JACQUELINE SCOTT CORLEY
27 UNITED STATES MAGISTRATE JUDGE
28