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E-Filed 12/1/2010

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

HTC CORPORATION, HTC AMERICA,
INC.,

Plaintiffs,

v.

TECHNOLOGY PROPERTIES
LIMITED, PATRIOT SCIENTIFIC
CORPORATION, and ALLIACENSE
LIMITED,

Defendants.

And Related Counterclaims

Case No. 5:08-cv-00882 JF/HRL

**ORDER¹ GRANTING IN PART
PLAINTIFFS’ MOTION FOR
ADMINISTRATIVE RELIEF FROM
CLAIM CONSTRUCTION SCHEDULING
ORDER**

[Docket No. 206]

Plaintiffs HTC Corporation and HTC America, Inc. (collectively, “HTC”) move pursuant to Civil L.R. 7-11 for administrative relief from the Court’s claim construction scheduling order, seeking to delay the deposition of Dr. David May. Defendants Technology Properties Limited and Alliacense Limited (collectively, “TPL”) oppose the motion. The Court has read the moving and responding papers and has considered the declarations counsel. For the reasons set forth below, the motion will be granted in part as set forth below.

///

¹ This disposition is not designated for publication in the official reports

1 **I. BACKGROUND**

2 TPL owns a collection of patents referred to as the Moore Microprocessor Portfolio
3 patents (“MMP patents”). HTC seeks a judicial declaration that the MMP patents are invalid
4 and/or not infringed. TPL has counterclaimed, alleging that HTC has infringed the patents.² On
5 October 25, 2010, the Court approved a stipulated claim construction schedule. (Docket No.
6 188.) Pursuant to that schedule, the parties’ Joint Claim Construction and Prehearing Statement
7 was due on October 28, 2010. Claim construction discovery closed on November 29, 2010.
8 TPL’s opening claim construction brief is due on December 9, 2010. HTC’s responsive claim
9 construction brief is due on January 21, 2011. TPL’s reply claim construction brief is due on
10 February 11, 2011.

11 HTC has disclosed Dr. David May as a “potential” claim construction expert. In the Joint
12 Claim Construction and Prehearing Statement, HTC represented that it “does not plan to call
13 expert witnesses to testify live at the claim construction hearing, but will have . . . Dr. David May
14 . . . available should the Court believe that such testimony would be useful in resolving the
15 dispute between the parties.” (Docket No. 189 at 4:2-5.) HTC also stated that it “may submit [a]
16 declaration[] from . . . Dr. May in connection with claim construction briefing and will provide a
17 summary of [the] expert opinion[] as part of Exhibit C [to the Joint Claim Construction and
18 Prehearing Statement].” (*Id.* at 4:5-7.) In Exhibit C to the Joint Claim Construction and
19 Prehearing Statement, HTC explained that “David May [] is expected to discuss why Plaintiffs’
20 construction is consistent with how one of ordinary skill in the art would understand the terms in
21 context of the patents.” (Docket No. 189, Ex. C.)

22 TPL has agreed to delay the deposition of Dr. May until December 3, 2010 (Mar Decl. ¶
23 6), and has subpoenaed documents related to Dr. May’s expert opinion, (Mar Decl. ¶ 10). HTC
24 has declined to produce the documents and will agree to produce Dr. May for a deposition only
25

26 ² This action is related to two other actions, 5:08-cv-00877-JF/HRL and 5:08-cv-05398-
27 JF/HRL, in which Acer Inc., Acer America Corporation, and Gateway, Inc. (collectively, “Acer”)
28 and Barco, N.V. (“Barco”), respectively, each seek judicial declarations that the MMP patents are
invalid and/or not infringed.

1 within five days after Dr. May submits a declaration in support of HTC’s responsive claim
2 construction brief. (HTC’s Mot. at 1:1-6.) If Dr. May does not submit such a declaration, HTC
3 will not agree to produce Dr. May for a deposition at any time.

4 II. DISCUSSION

5 TPL contends that this Court’s Patent Local Rules require HTC to make any expert
6 witnesses disclosed in the Joint Claim Construction and Prehearing Statement available for
7 deposition before TPL’s opening claim construction brief is due. Patent L.R. 4-3(e) requires
8 parties to indicate “whether any party proposes to call one or more witnesses at the Claim
9 Construction Hearing” Patent L.R. 4-4 provides that “[n]ot later than 30 days after service
10 and filing of the Joint Claim Construction and Prehearing Statement, the parties shall complete
11 all discovery relating to claim construction, including any depositions with respect to claim
12 construction of any witnesses, including experts, identified in the . . . Joint Claim Construction
13 and Prehearing Statement” While HTC has indicated that it does not necessarily intend to
14 call Dr. May as a live witness at the Claim Construction Hearing, it clearly has reserved the right
15 to use Dr. May’s testimony in connection with its claim construction briefing. Whether it is
16 offered live at the hearing or in the form of a declaration in support of HTC’s briefing, the
17 testimony clearly would be part of the claim construction record. Read in context, Patent L.R. 4-
18 3(e) and 4-4 are intended to apply in this situation. *See Friskit, Inc. v. RealNetworks, Inc.*, No. C
19 03-5085 FMS, 2005 WL 6249309, at *1 (N.D. Cal. March 22, 2005) (concluding that Patent L.R.
20 4-3(e) applies when a party intends to rely on an expert’s declaration rather than live testimony).

21 Accordingly, the Patent Local Rules require HTC to produce Dr. May for a deposition
22 before the end of claim construction discovery. At the same time, the Court may modify the
23 Patent Local Rules subsequent to the initial case management conference upon a showing of
24 good cause. Patent L.R. 1-3. HTC contends that it should not be required to produce either Dr.
25 May or the documents relevant to his opinion unless and until Dr. May submits a declaration in
26 support of HTC’s briefing. Dr. May resides in the United Kingdom, (HTC’s Mot. at 1:22-23),
27 and HTC seeks to avoid the expense of a deposition and the inconvenience to Dr. May unless is
28 it sure that it will rely upon his testimony.

1 The Patent Local Rules “are designed to require parties to crystallize their theories of the
2 case early in the litigation and to adhere to those theories once they have been disclosed.” *Atmel*
3 *Corp. v. Information Storage Devices*, No. C 95-1987 FMS, 1998 WL 775115, at *2 (N.D. Cal.
4 Nov. 4, 1998). While HTC ultimately may decline to use Dr. May’s opinion, HTC has disclosed
5 Dr. May as an expert witness, and the rules require HTC to disclose its theory of the claim
6 construction, including Dr. May’s opinion of “how one of ordinary skill in the art would
7 understand the terms in context of the patents.” (Docket No. 189, Ex. C.) HTC has provided
8 only a sparse summary of Dr. May’s potential expert testimony. If HTC delays both the
9 production of documents relevant to Dr. May’s opinion and the deposition of Dr. May until after
10 December 9, 2010, TPL will be deprived of the opportunity to conduct discovery with respect to
11 Dr. May’s opinion before its opening claim construction brief is due. Such a delay may be
12 grounds for the exclusion of an expert. *See Friskit*, 2005 WL 6249309, at *1-2 (excluding a
13 party’s expert from the *Markman* hearing and claim construction briefing (but not from the patent
14 tutorial) because the party failed to disclose adequately the expert, “den[ying] . . . a reasonable
15 opportunity to conduct discovery into the expert’s opinions”). *See also Rambus Inc. v. Hynix*
16 *Semiconductor, Inc.*, 569 F. Supp. 2d 946, 980 (N.D. Cal. 2008) (noting that the accused
17 infringers’ shift in a proposed claim construction caused a “clear inequity” because it denied the
18 patentee an opportunity to depose the accused infringers’ “expert on their new proposed claim
19 constructions prior to filing its opening and reply briefs.”).

20 While the Court recognizes that Dr. May’s residency in the United Kingdom likely will
21 add significantly to the cost of his deposition, that fact standing alone is insufficient to warrant a
22 substantive deviation from the Patent Local Rules. HTC has not argued that Dr. May is uniquely
23 qualified in comparison to other potential expert witnesses who may reside in more convenient
24 locations. If an expert’s foreign location alone were sufficient, parties could avoid their
25 discovery obligations with respect to claim construction expert witnesses simply by retaining an
26 expert at a distant location.

27 HTC indicates separately that TPL has delayed the deposition of its own claim
28 construction expert until December 10, 2010. (Chen Decl. ¶ 6.) Considering all of the relevant

1 circumstances, the Court concludes that it is equitable to allow HTC to produce Dr. May for a
2 deposition on or before the same date. However, because TPL's opening claim construction brief
3 is due on December 9, 2010, HTC shall produce documents relevant to Dr. May's opinion on or
4 before December 3, 2010. This will provide TPL with sufficient time to review the documents
5 relevant to Dr. May's opinion before its opening brief is due and will allow TPL the opportunity
6 to depose Dr. May before its reply brief is due.

7 **III. ORDER**

8 The claim construction schedule is hereby modified to allow the deposition of Dr. May to
9 occur on or before December 10, 2010. HTC shall produce documents relevant to Dr. May's
10 opinion on or before December 3, 2010.

11
12 IT IS SO ORDERED.

13 DATED: 12/1/2010

14 
15 JEREMY FOGEL
16 United States District Judge