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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

VIA TECHNOLOGIES, INC. (A  
CALIFORNIA CORPORATION), et al.,  
  
Plaintiffs,  
  
v.  
  
ASUS COMPUTER INTERNATIONAL, et  
al.,  
  
Defendants.

Case No. [14-cv-03586-BLF](#)

**ORDER GRANTING-IN-PART  
MOTION TO STRIKE DECLARATION  
OF MIGUEL GOMEZ**

**(Re: Docket No. 124)**

Plaintiffs VIA Technologies, Inc. and several related and similarly named companies allege that Defendants ASUS Computer International and its corporate siblings infringe several VIA patents.<sup>1</sup> The presiding judge has scheduled a claim construction tutorial for May 26 and a claim construction hearing for June 10.<sup>2</sup> Along with its opening claim construction brief, VIA submitted a declaration by VIA’s technical expert, Miguel Gomez, containing his opinions on the background of the technology and how the claims should be construed.<sup>3</sup> Defendants now move to strike large portions of that declaration on the grounds that VIA failed to disclose the opinions in those paragraphs as required by the Patent Local Rules of this district.<sup>4</sup> The motion is GRANTED-IN-PART.

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<sup>1</sup> See Docket No. 70 at ¶¶ 7-18, 54-75.

<sup>2</sup> See Docket No. 128.

<sup>3</sup> See Docket No. 116-16.

<sup>4</sup> See Docket No. 124.

I.

1 A party intending to support its claim construction positions with testimony from an expert  
2 first must “provide a description of the substance of that witness’ proposed testimony that includes  
3 a listing of any opinions to be rendered in connection with claim construction.”<sup>5</sup> The party should  
4 hand over this description when the parties exchange their preliminary claim constructions.<sup>6</sup>  
5 Another rule directs each party to “identif[y] any extrinsic evidence known to the party on which it  
6 intends to rely either to support its proposed construction or to oppose any other party’s proposed  
7 construction, including . . . testimony of percipient and expert witnesses.”<sup>7</sup> That identification  
8 must be contained within a joint claim construction and prehearing statement.<sup>8</sup> Claim construction  
9 discovery, “including any depositions with respect to claim construction of any witnesses,  
10 including experts,” must be completed no more than 30 days after the parties file their joint claim  
11 construction and prehearing statement.<sup>9</sup>

12 In this case, VIA included with its preliminary claim constructions high-level  
13 “[d]escription[s] of the substance of anticipated testimony of Miguel Gomez.”<sup>10</sup> For example, for  
14 the first disputed claim term, VIA provided this description of Gomez’ proposed testimony:

15 The term recites sufficiently definite structure to a person of  
16 ordinary skill. A person of ordinary skill would understand that the  
17 term has a generally understood plain and ordinary structural  
18 meaning, or, in general, means a module that converts parallel data  
19 into serial data and delayed serial data. A person of ordinary skill  
20 would find that the intrinsic record confirms that understanding. A  
person of ordinary skill would not view the term as a purely  
functional term. And a person of ordinary skill would understand,  
based on the claim language and intrinsic record, the scope of the  
term with reasonable certainty. A person of ordinary skill would

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22 <sup>5</sup> Pat. L.R. 4-2(b).

23 <sup>6</sup> *See id.*

24 <sup>7</sup> Pat. L.R. 4-3(b).

25 <sup>8</sup> *See* Pat. L.R. 4-3.

26 <sup>9</sup> Pat. L.R. 4-4.

27 <sup>10</sup> Docket No. 124-2, Ex. A at 2-16.

1 conclude that the extrinsic record confirms this understanding of the  
term.<sup>11</sup>

2 VIA did not indicate that Gomez intended to testify to the background of the technology. The  
3 joint claim construction statement included the following summary of his expected testimony:

4 Mr. Gomez may provide opinions regarding the disputed claim  
5 terms, the definition and qualifications of one of ordinary skill in the  
6 art, the state of relevant technology at the time the patents were  
filed, and rebuttal opinions to constructions offered by the  
Defendants or any expert on which the Defendants may rely.<sup>12</sup>

7 A more detailed listing of his opinions followed, using largely the same language from VIA’s  
8 preliminary contentions.<sup>13</sup> This time, VIA did say that Gomez “[wa]s expected to testify regarding  
9 . . . [a]n overview of the technology disclosed the [sic] asserted patents (including the background  
10 and context of the technology).”<sup>14</sup>

11 Defendants then deposed Gomez during claim construction discovery. Gomez testified  
12 that he did not “have a final declaration of any sort” yet, but that he had “been told that [he] may  
13 be working on one.”<sup>15</sup> After claim construction discovery closed, Gomez delivered that  
14 declaration, which VIA attached to its opening claim construction briefing.<sup>16</sup> The declaration  
15 contained 36 paragraphs of Gomez’ opinions on the technical background as well as his opinions  
16 on certain disputed claim terms.<sup>17</sup> Defendants filed this motion a month later.<sup>18</sup>

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18 <sup>11</sup> *Id.* at 2.

19 <sup>12</sup> Docket No. 109 at 7.

20 <sup>13</sup> *See id.* at 7-12.

21 <sup>14</sup> *Id.* at 7.

22 <sup>15</sup> Docket No. 124-5 at 139:9-18. In the same vein, he also told Defendants that he had not yet  
23 “been asked to render an opinion on any of the subject matter at this point.” *Id.* at 20:22-21:5, *see*  
24 *also id.* at 11:25-12:8, 78:24-79:4, 86:21-87:6, 89:4-13, 96:2-6, 187:15-21.

25 <sup>16</sup> *See* Docket No. 116-16.

26 <sup>17</sup> *See id.* at ¶¶ 44-78, 82, 85, 99, 103, 104.1, 104.2.

27 <sup>18</sup> *See* Docket No. 124.

II.

1 The Patent Local Rules set up a straightforward process for parties to disclose expert  
2 opinions they intend to rely on during claim construction. At the outset, a party planning to call an  
3 expert must “provide a description of the substance of [the expert’s] proposed testimony.”<sup>19</sup> In  
4 particular, that description must “include[] a listing of any opinions to be rendered in connection  
5 with claim construction.”<sup>20</sup> And, in the joint claim construction and prehearing statement, the  
6 party must identify that the expert’s testimony is among the extrinsic evidence on which the party  
7 will rely.<sup>21</sup> If the party additionally proposes to call the expert witness to testify live at the  
8 hearing, it must include in the joint claim construction and prehearing statement “a summary of  
9 [the expert’s] testimony including . . . each opinion to be offered related to claim construction.”<sup>22</sup>  
10 Claim construction discovery commences thereafter.<sup>23</sup>

11 For this sequence of events to make any sense, the expert opinions disclosed must enable  
12 useful discovery about those opinions. To be sure, the Patent Local Rules have been amended to  
13 remove a requirement that the “summary of each opinion to be offered” be disclosed “in sufficient  
14 detail to permit a meaningful deposition of that expert.”<sup>24</sup> But that amendment preserved the  
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16 <sup>19</sup> Pat. L.R. 4-2(b).

17 <sup>20</sup> *Id.*

18 <sup>21</sup> *See* Pat. L.R. 4-3(b). If the party “proposes to call one or more [expert] witnesses at the Claim  
19 Construction Hearing,” the party must include in the joint claim construction and prehearing  
20 statement “a summary of [the expert’s] testimony including . . . each opinion to be offered related  
21 to claim construction.” Pat. L.R. 4-3(e). Taking the Rule’s plain language at face value, it only  
22 applies to witnesses who will testify live at the claim construction hearing. *But see HTC Corp. v.*  
23 *Tech. Props. Ltd.*, Case No. 08-cv-00882, 2010 WL 4973628, at \*1 (N.D. Cal. Dec. 1, 2010);  
*Friskit, Inc. v. RealNetworks, Inc.*, Case No. 03-cv-05085, 2005 WL 6249309, at \*1 (N.D. Cal.  
Mar. 22, 2005). Because VIA does not intend to call Gomez to testify at the hearing, this  
subsection does not apply.

24 <sup>22</sup> Pat. L.R. 4-3(e).

25 <sup>23</sup> *See* Pat. L.R. 4-4.

26 <sup>24</sup> *Friskit*, 2005 WL 6249309, at \*1; *see Reflex Packaging, Inc. v. Lenovo (U.S.), Inc.*, Case No.  
27 10-cv-01002, 2011 WL 7295479, at \*2 (N.D. Cal. Apr. 7, 2011).

1 disclosure requirement. Even if “a less detailed description is permissible” under the amended  
2 Rule,<sup>25</sup> that description cannot merely be a list of topics without “a listing of [the] opinions”  
3 themselves.<sup>26</sup>

4 Against this standard, VIA’s disclosure was insufficient. For example, with respect to the  
5 first disputed claim term, VIA simply told Defendants that Gomez would testify that “a person of  
6 ordinary skill in the art would understand . . . the scope of the term with reasonable certainty” and  
7 interpret “parallel-to-serial unit” to mean “a module that converts parallel data into serial data and  
8 delayed serial data.”<sup>27</sup> In his declaration, however, Gomez explained for the first time how the  
9 unit might be implemented and why the term “unit” would not confuse a POSITA.<sup>28</sup> Without this  
10 explanation, Defendants had no guidance on how to conduct a useful deposition; by the time they  
11 received it, the window for discovery had long since closed. And, of course, VIA’s initial  
12 disclosure made no mention of the fact that Gomez intended to offer pages of opinions on the  
13 background of the technology.<sup>29</sup>

14 All that said, striking testimony altogether is the court’s last resort.<sup>30</sup> Instead, given the  
15 relative banality of the opinions at issue and the weeks remaining until the claim construction  
16 hearing, a more appropriate remedy would be a further opportunity for Defendants to explore the  
17 opinions that Gomez did not disclose in advance. Accordingly, VIA shall make Gomez available  
18 for three hours of additional deposition by May 27, 2016. To the extent this deposition  
19 necessitates additional claim construction briefing, the parties should seek the presiding judge’s  
20 leave to file any supplemental briefs.

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22 <sup>25</sup> *Reflex Packaging*, 2011 WL 7295479, at \*2.

23 <sup>26</sup> Pat. L.R. 4-2(b).

24 <sup>27</sup> Docket No. 124-2, Ex. A at 2.

25 <sup>28</sup> Docket No. 116-16 at ¶¶ 82, 85.

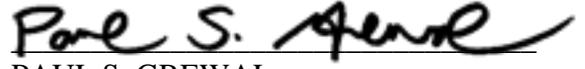
26 <sup>29</sup> See Docket No. 124-2, Ex. A; Docket No. 116-16 at ¶¶ 44-78.

27 <sup>30</sup> See *Reflex Packaging*, 2011 WL 7295479, at \*1 (citations omitted).

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**SO ORDERED.**

Dated: May 13, 2016



PAUL S. GREWAL  
United States Magistrate Judge