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3 **UNITED STATES DISTRICT COURT**  
4 **NORTHERN DISTRICT OF CALIFORNIA**  
5 **SAN JOSE DIVISION**

6  
7 TESSERA, INC.,  
8 Plaintiff,

9 v.

10 TOSHIBA CORPORATION,  
11 Defendant.

Case No. [15-cv-02543-BLF](#)

**ORDER RE JOINT STATUS REPORT  
FOLLOWING CASE MANAGEMENT  
CONFERENCE**

[Re: ECF 249]

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13 On October 16, 2016, this Court granted in part Toshiba Corporation's ("Toshiba") motion  
14 for summary judgment and denied Tessera, Inc.'s ("Tessera") motion for partial summary  
15 judgment. ECF 241. In its order, the Court held that the TCC License Agreement is an  
16 infringement-based license that requires the payment of royalties only if Toshiba practices the  
17 claims of the unexpired, valid, and enforceable licensed Tessera patents. *Id.* at 21. Therefore, to  
18 prove breach of contract, Tessera must prove that Toshiba infringes or infringed the patents  
19 covered by the contract.

20 The parties then appeared for a case management conference ("CMC") to discuss the status  
21 of the case on November 17, 2016. During the CMC, the Court confirmed Magistrate Judge  
22 Nathanael Cousins' ruling that the Patent Local Rules would apply to the discovery process in this  
23 case. *See* ECF 243. The Court also ordered the parties to submit a joint statement concerning the  
24 applicability of the Patent Local Rules.


25 Pursuant to the Court's order, the parties submitted a joint status report concerning the  
26 applicability of the Patent Local Rules. ECF 249. Although Tessera states that it does not intend  
27 to present infringement contentions in the present contract litigation, Toshiba requests that the  
28 Court set a deadline for Tessera to identify asserted patents and to provide disclosures pursuant to

1 Patent Local Rules 3-1 and 3-2. *Id.* at 2, 4. Given the status of the case, the Court will require  
2 Tessera to identify any asserted patents and provide disclosures pursuant to Patent Local Rules 3-1  
3 and 3-2 by no later than December 2, 2016.

4 Although Toshiba requests that the Court set the remainder of the deadlines under the  
5 Patent Local Rules as “N/A,” the Court declines to do so as it is not precluding Tessera from  
6 disclosing any patent infringement contentions. Thus, in the event that Tessera submits  
7 infringement contentions by the December 2, 2016, deadline, then the Patent Local Rules will be  
8 triggered and all of the time lines set forth therein will apply to this case. Insofar as Tessera has  
9 indicated it does not intend to file infringement contentions, the Court will not, at this time,  
10 modify the trial date or any other dates set in the case schedule. Should Tessera disclose  
11 infringement contentions, the parties may request further modification of the case schedule.

12 **IT IS SO ORDERED.**

13 Dated: November 29, 2016

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15 BETH LABSON FREEMAN  
16 United States District Judge  
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