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United States District Court
Northern District of California

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

IN RE EX PARTE APPLICATION OF
BAYERISCHE MOTOREN WERKE AG
AND BMW BANK GMBH,

Applicants.

Case No. [19-mc-80272-WHO](#) (VKD)

**ORDER RE BROADCOM'S MOTION
TO QUASH DEPOSITION SUBPOENA**

Re: Dkt. No. 66

Respondents Broadcom Corporation, Broadcom Inc., and Broadcom Technologies Inc. (collectively “Broadcom”) ask the Court to quash deposition subpoenas served by applicants Bayerische Motoren Werke AG and BMW Bank GmbH (collectively “BMW”) pursuant to this Court’s order authorizing discovery under 28 U.S.C. § 1782. Dkt. No. 66. The Court held a hearing on this dispute on September 22, 2020. Dkt. Nos. 74, 77.

For the reasons explained below, the Court grants in part and denies in part Broadcom’s motion to quash. The Court also orders that counsel confer further regarding certain matters.

I. BACKGROUND

On November 13, 2019, the Court granted BMW’s application pursuant to 28 U.S.C. § 1782 for an order authorizing issuance of identical document and deposition subpoenas to multiple Broadcom entities to obtain evidence for use in patent infringement and invalidity/nullity proceedings in Germany. Dkt. No. 11. That order permitted a subsequent motion to quash or to further modify the subpoenas by any of the subpoena recipients. *Id.* at 8.

According to the parties, there are three proceedings pending in Germany that involve issues of infringement and/or invalidity (nullity) as to three Broadcom patents: EP’531, EP ’181

1 and EP '052. None of the proceedings involves damages for infringement; however, the German
 2 court does consider the “value of litigation” in setting attorneys’ fees and court fees that are
 3 prescribed by statute. See Dkt. No. 77 at 5:23-8:9.

4 BMW seeks a Rule 30(b)(6) deposition of Broadcom¹ on 20 topics. Dkt. No. 66-2, Exs. A-
 5 C. Broadcom refuses to provide testimony on any topic and moves to quash BMW’s subpoenas in
 6 their entirety.

7 **II. LEGAL STANDARD**

8 Discovery in this matter is governed by the Federal Rules of Civil Procedure. See 28
 9 U.S.C. § 1782(a); *In re Letters Rogatory from Tokyo Dist. Prosecutor’s Office, Tokyo, Japan*, 16
 10 F.3d 1016, 1020 (9th Cir. 1994) (unless district court orders otherwise, discovery must be obtained
 11 in accordance with the Federal Rules of Civil Procedure); *Heraeus Kulzer, GmbH v. Biomet, Inc.*,
 12 633 F.3d 591, 594, 597 (7th Cir. 2011) (applicant may obtain discovery as if matter had been
 13 brought in domestic court).

14 A party may obtain discovery of any matter that is relevant to a claim or defense and that is
 15 “proportional to the needs of case, considering the importance of the issues at stake in the action,
 16 the amount in controversy, the parties’ relative access to relevant information, the parties’
 17 resources, the importance of the discovery in resolving the issues, and whether the burden or
 18 expense of the proposed discovery outweighs its likely benefit.” Fed. R. Civ. P. 26(b)(1).

19 **III. DISCUSSION**

20 The parties could not reach agreement on any aspect of any proposed deposition topic. As
 21 reflected in the discussion below, some topics clearly encompass information that both parties
 22 agree is discoverable, while others clearly encompass information that the Court has already found
 23 not discoverable. The Court is dismayed that the parties could not at least reach agreement on
 24 those matters. The Court expects better from sophisticated parties and experienced counsel.

25 The Court considers and decides each dispute, topic by topic.

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 27
 28 ¹ BMW served identical deposition subpoenas on each Broadcom entity. BMW advises that it
 contemplates only a single Rule 30(b)(6) deposition of Broadcom. Dkt. No. 67 at 24.

A. Topic No. 1

1 In Topic No. 1, BMW asks for testimony about “[t]he documents and other materials
2 produced in response to in BMW's Subpoena to Produce Documents, Information, or Objects or to
3 Permit Inspection of Premises in a Civil Action and the efforts to collect and produce such
4 documents and other materials.” BMW’s principal focus is the second part of this topic—i.e.,
5 Broadcom’s efforts to collect and produce documents responsive to BMW’s document requests.
6 BMW argues that Broadcom has not produced responsive, non-privileged documents in its
7 possession, custody or control, and BMW desires to uncover evidence of this failure of production
8 by taking Broadcom’s deposition. Broadcom acknowledges that it may not have produced some
9 documents that are responsive to BMW’s document requests, but that is because the parties agreed
10 in advance that Broadcom need not search for documents maintained by “privileged custodians”
11 or in “privileged repositories.” Relying on this agreement, Broadcom did not collect or produce
12 documents from outside counsel, in-house counsel, or any employee who works in Broadcom’s
13 legal department. See Dkt. No. 77 at 15:22-17:15. BMW contends that the agreement was
14 intended to relieve Broadcom of an obligation to search through all of the files of the in-house
15 legal department and outside counsel for responsive documents, but did not relieve Broadcom of
16 the obligation to produce discrete, known, non-privileged documents that just happen to be housed
17 in the legal department. Id. at 19:23-21:16.

18 The subject matter of Topic No. 1 is not directly relevant to any issue in the German
19 proceedings. More importantly, requiring a corporate representative to answer questions in
20 deposition on matters that are more appropriately resolved by discussions between counsel is not a
21 proportionate use of this discovery tool. The Court orders the parties to discuss and resolve their
22 inconsistent understandings of their prior agreement regarding the collection and production of
23 responsive documents. Broadcom’s motion to quash as to Topic No. 1 is granted.

B. Topic No. 2

24 In Topic No. 2, BMW asks for testimony about “[e]valuations regarding the value of the
25 Asserted Patents.” Broadcom asserts that it has no such evaluations. BMW insists that this topic
26 encompasses information relevant to the German court’s consideration of the “value of litigation,”
27
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1 and that this consideration includes anything that might also bear on damages, even though
2 damages are not at issue.

3 The Court has reviewed the declarations of German counsel for each party. Dkt. Nos. 66-
4 1, 67-2. From these declarations, the Court understands that the German court will estimate the
5 “value of litigation” for purposes of setting statutorily prescribed attorneys’ fees and court fees.
6 See Dkt. No. 66-1 ¶ 4; Dkt. No. 67-2 ¶¶ 12-13. The Court is not persuaded that BMW requires
7 any fact discovery beyond what the Court has already ordered and what the Court orders with
8 respect to Topic No. 9, below, in order to address the “value of litigation” in the German
9 proceedings. Broadcom’s motion to quash is granted as Topic No. 2, except that BMW may ask
10 Broadcom to confirm in deposition that it has not prepared or obtained an evaluation of the value
11 of any of the asserted patents, as Broadcom has represented to this Court. BMW may not use the
12 deposition to obtain advance notice of what Broadcom’s valuation-of-litigation arguments may be
13 to the German court.

14 **C. Topics Nos. 3 and 4**

15 In Topic No. 3, BMW asks for testimony about “[a]ssignments of the Asserted Patents and
16 the assignment authority of the individuals who executed such assignments.” In Topic No. 4,
17 BMW ask for testimony about “[a]ny merger within the last five years between Broadcom and
18 Avago or any affiliated entities, including, but not limited to, the merger between Avago
19 Technologies General IP (Singapore) Pte. Ltd. and Avago Technologies International Sales Pte.
20 Ltd., and the changed ownership of any Broadcom or Avago subsidiaries or affiliated entities,
21 including, but not limited to, the Broadcom and Avago entities located in the Northern District of
22 California.” BMW explains that these topics are relevant to the question of Broadcom’s standing,
23 and in particular, whether assignment of the patent rights was accomplished by persons with the
24 requisite authority under German law. Dkt. No. 67 at 14-15. Broadcom concedes this information
25 is relevant but argues that a deposition is not necessary because BMW already has responsive
26 documents. Dkt. No. 66 at 19.

27 Broadcom’s argument is not convincing, and its refusal to provide deposition testimony
28 about matters Broadcom concedes are relevant is not reasonable. Broadcom’s motion to quash is

1 denied as to Topics Nos. 3 and 4. However, the Court notes that Topic No. 4 is broader than what
2 BMW says is the necessary scope for deposition testimony. The Court expects BMW to limit its
3 questioning under Topic No. 4 to matters relevant to Broadcom's standing.

4 **D. Topics Nos. 5 and 6**

5 In Topic No. 5, BMW asks for testimony about "[t]he methods, systems, or procedures
6 employed to disclose prior art to the attorney(s) prosecuting the applications that led to the
7 Asserted Patents and/or to the United States Patent and Trademark Office, the European Patent
8 Office, or any other national or international patent issuing entity." In Topic No. 6, BMW asks for
9 testimony about "[a]ny prior art search in connection to the Asserted Patents performed by, at the
10 direction of, or on behalf of Broadcom, Avago, or any affiliated entities." BMW argues that the
11 existence of prior art is relevant to the validity of the asserted patents. Dkt. No. 67 at 10, 11.
12 Broadcom agrees, but objects that the deposition topics seek testimony about how Broadcom
13 searched for prior art and how it shared what it found with attorneys prosecuting patents on
14 Broadcom's behalf—testimony that is likely privileged or mostly privileged. Dkt. No. 66 at 16-
15 17. Both parties agree that the German proceedings do not include a claim or defense analogous
16 to "inequitable conduct" in U.S. patent litigation. Dkt. No. 77 at 49:6-50:6, 52:17-53:8.

17 While the Court agrees with BMW that the existence of prior art is highly relevant to the
18 question of validity, Topics Nos. 5 and 6 do not ask for Broadcom's testimony about prior art.
19 Rather, the topics are directed to discovery about whether and how Broadcom searched for or
20 obtained prior art and how it communicated about that prior art with counsel. In addition, BMW
21 concedes that these topics are motivated in part by BMW's concern that Broadcom has not
22 produced prior art in response to BMW's documents requests. Dkt. No. 77 at 19:20-20:6, 57:22-
23 58:16.

24 Broadcom's motion to quash Topics Nos. 5 and 6 is granted. However, like Topic No. 1,
25 the parties' dispute here appears to derive in part from their different understandings of their
26 agreement excluding "privileged custodians" and "privileged repositories" from the scope of
27 Broadcom's document search and production obligations. The Court orders the parties to confer
28 regarding whether prior art documents they both agree are relevant can be collected and produced

1 by Broadcom without undue burden, notwithstanding that such documents may be located in files
2 maintained by Broadcom's legal department.

3 **E. Topic No. 7**

4 In Topic No. 7, BMW asks for testimony about "[i]nfringement or validity opinions and
5 any internal or external communications relating thereto that discuss: [1] EP '531, including, but
6 not limited to, the capability of the plurality of texture processors to process a second portion of
7 the plurality of the texture portions in parallel; [2] EP '181, including, but not limited to, the
8 implementation of the energy detect mode, the auto MDIX mode, and the generation/calculation
9 of the qualified energy; [3] EP '052, including, but not limited to, the integration of a shared LNA
10 in the WLAN radio." BMW argues that such opinions are relevant to issues of infringement and
11 validity of the asserted patents and that it is not clear whether all such opinions or communications
12 about them are privileged. Dkt. No. 67 at 13-14. Broadcom objects to this topic as seeking
13 information that is necessarily privileged. Dkt. No. 66 at 14.

14 During the hearing, BMW clarified that it wishes to confirm whether or not there are any
15 non-privileged infringement or validity opinions and whether Broadcom intends to rely on any
16 infringement or validity opinions in the German proceedings. BMW represents that if the answers
17 to these questions is "no," then BMW would not question Broadcom's witness further regarding
18 this topic. Dkt. No. 77 at 85:4-22. The Court will permit BMW to ask these questions within the
19 scope of Topic No. 7. Broadcom's motion to quash is denied as to non-privileged opinions.
20 BMW may not use the deposition to probe whether Broadcom obtained any privileged opinions
21 that it did not include on a privilege log.

22 **F. Topics Nos. 8 and 15**

23 In Topic No. 8, BMW asks for testimony about "[a]ny investigation regarding the
24 functionality of the Accused Technology or any component of the Accused Technology." In
25 Topic No. 15, BMW asks for testimony about "[i]nvestigations regarding the functionality of the
26 Texas Instruments DRA746 with power VRSGX544 dual core, the Texas Instruments OMAP5432
27 with power VRSGX544 dual core, the MICREL chip KSZ8864RMNU, or the Marvell Avastar
28 Chip 88W8787 SoC." BMW argues that it seeks testimony about non-privileged investigations

1 conducted by Broadcom of the accused technology and disavows any intention of questioning
2 Broadcom about privileged investigations. Dkt. No. 67 at 9-10, 11-12. Broadcom objects to these
3 topics as seeking information that is necessarily privileged. Dkt. No. 66 at 14-15.

4 Broadcom's investigations of the accused technology are not directly relevant to any issue
5 of infringement in the German proceedings, which will consider whether there is or is not
6 infringement based on whatever evidence and argument is presented to the German court.
7 However, the Court agrees with BMW that if Broadcom previously conducted an investigation
8 and concluded that a now-accused product did not infringe and now takes a contrary position, the
9 reasons for Broadcom's different views may inform the German court's consideration of the
10 evidence and arguments presented. See Dkt. No. 77 at 63:13-64:16.

11 BMW may question Broadcom about non-privileged investigations of the accused
12 technology, if any exist. The Court denies Broadcom's motion to quash as to Topics Nos. 8 and
13 15 for this purpose. However, BMW may not use the deposition to explore the adequacy or
14 inadequacy of Broadcom's investigations, and BMW also may not use the deposition to probe
15 whether Broadcom conducted any privileged investigations that it did not include on a privilege
16 log.

17 **G. Topic No. 9**

18 In Topic No. 9, BMW asks for testimony about "[a]ny efforts to sell, license, or monetize
19 the Asserted Patents, including any agreements, licenses, contracts, settlements, or proposals,
20 relating to the Asserted Patents or the technology described in the Asserted Patents." This
21 deposition topic encompasses both consummated licenses and agreements and proposed licenses
22 and agreements, or other efforts to monetize the patents.

23 Broadcom concedes that it should be required to provide testimony about the responsive
24 licenses and agreements it has already produced to BMW. Dkt. No. 77 at 26:13-23, 33:4-12.
25 Broadcom's motion to quash with respect to this aspect of Topic No. 9 is denied. For the
26 avoidance of doubt, Broadcom's witness should be prepared to answer questions about how the
27 royalty rates in the agreements were set and what considerations they reflect, to the extent that
28 information is known to Broadcom. In addition, the Court will permit BMW to obtain testimony

1 about Broadcom's licensing practices with respect to the asserted patents along the lines discussed
2 at the hearing. See *id.* at 29:21-30:2.

3 In considering the parties' document production disputes, the Court has already concluded
4 that Broadcom's efforts and proposals to sell, license, or monetize the asserted patents are not
5 relevant. See Dkt. No. 29 at 4-5; Dkt. No. 58 at 6-7. For the same reasons, the Court concludes
6 that deposition testimony regarding this same subject matter also is not relevant. Broadcom's
7 motion to quash with respect to this aspect of Topic No. 9 is granted.

8 Separately, based on discussion at the hearing, the Court orders Broadcom to investigate
9 whether one or more of the asserted patents has been expressly carved out of a license or
10 agreement involving a patent portfolio in which those patents would otherwise have been
11 included, or whether, instead of being carved out, such patents have been treated differently in the
12 license or agreement. See *id.* at 37:21-39:8. If such licenses or agreements exist, the Court
13 expects Broadcom to produce them and permit testimony about them as contemplated above for
14 the license agreements that Broadcom has already produced.

15 **H. Topics Nos. 10, 11 and 12**

16 Each of these topics seeks testimony on the question of whether any of the asserted patents
17 is essential to a standard. In Topic No. 10, BMW asks for testimony about "[i]nvestigations
18 regarding the standards-essential nature of the Asserted Patents, including any comparison of any
19 Broadcom product or technology, including, but not limited to, the BCM5411, the BCM5201, and
20 the BCM5202, to the OpenGL ES Standard or the IEEE 802.3 Standard." In Topic No. 11, BMW
21 asks for testimony about "[m]eetings, including working groups, contributions of members, and IP
22 declarations of the Khronos Group or the IEEE Ethernet Working Group or their members relating
23 to the Asserted Patents in connection to the OpenGL ES Standard after January 2003 or the IEEE
24 802.3 Standard after January 1998." In Topic No. 12, BMW asks for testimony about "[t]he use
25 of Broadcom or Avago products or chipsets—including the BCM5411, the BCM5201, and the
26 BCM5202—that allegedly practice the Asserted Patents, the OpenGL ES Standard, or the IEEE
27 802.3 Standard."

28 BMW says that in the German proceeding involving EP '531, it has expressly asserted as a

1 defense that if that patent is construed as Broadcom proposes, the patent is essential to a standard
2 or standards, and Broadcom abuses its dominant market position by not licensing the patent on
3 fair, reasonable, and non-discriminatory terms. Dkt. No. 67-2 ¶ 8. In support of that defense,
4 BMW argues that it should be permitted to question Broadcom about the assessments and
5 representations, if any, it has made about whether EP '531 is standard-essential, and about any of
6 Broadcom's own products that Broadcom contends practice that patent and a standard or
7 standards. Dkt. No. 67 at 16-17. Broadcom asserts that it has not made any assessments or
8 representations that EP '531 is standard-essential and that BMW's justification for these topics is
9 speculative. Dkt. No. 66 at 17-18.

10 Because BMW has shown that the question of whether EP '531 is standard-essential is at
11 issue in the German proceeding, it has articulated a reasonable basis for the deposition testimony it
12 seeks regarding that patent. However, BMW has not made a similar showing as to the other
13 asserted patents, and the Court agrees with Broadcom that testimony concerning the standard-
14 essential nature of the other asserted patents is not warranted. Accordingly, with respect to Topics
15 Nos. 10-12, Broadcom's motion to quash is granted as to EP '181 and EP '052, but denied as to
16 EP '531, to the extent BMW seeks testimony concerning whether the patent is standard-essential
17 or whether a practicing product is standard-essential.

18 As BMW observes in its opposition to Broadcom's motion to quash, Topic No. 12 also
19 encompasses testimony concerning which Broadcom products practice the asserted patents.
20 Specifically, BMW argues that Broadcom's sale of chips that embody the inventions claimed in
21 the asserted patents may anticipate those patents. Dkt. No. 67 at 15-16. Broadcom concedes such
22 discovery may be relevant to the question of the validity of the asserted patents. Dkt. No. 77 at
23 78:19-25. Accordingly, with respect to the portion of Topic No. 12 that asks for testimony about
24 "[t]he use of Broadcom or Avago products or chipsets—including the BCM541 I, the BCM5201,
25 and the BCM5202—that allegedly practice the Asserted Patents," BMW may inquire as to all
26 three asserted patents regarding the following matters: (1) which products practice or practiced
27 the asserted patent, and (2) the date of first sale of each such practicing product. However, BMW
28 may not use Topic No. 12 to explore Broadcom's document search and collection efforts. Instead,

1 the Court orders the parties to confer regarding whether documents identifying the first sale (date
2 and customer) of each practicing product are responsive to a BMW document request and, if so,
3 whether such documents can be collected and produced by Broadcom without undue burden,
4 notwithstanding that such documents may be located in files maintained by Broadcom's legal
5 department.

6 **I. Topic No. 13**

7 In Topic No. 13, BMW asks for testimony about “[i]nfringement, validity, nullity, or
8 standing positions or defenses put forth by any party in any lawsuit or proceeding involving the
9 Asserted Patents,” including eight specific matters. During the hearing, BMW explained that it is
10 only interested in positions taken by Broadcom (not other parties) so that BMW can anticipate
11 whether Broadcom will assert a similar position or positions against BMW. Dkt. No. 77 at 91:5-
12 13, 92:6-20. In addition, it appears that BMW's principal goal is to use this deposition topic to ask
13 about alleged gaps in Broadcom's production of documents about these prior matters. Dkt. No. 77
14 at 91:19-92:5.

15 It is neither feasible nor an appropriate use of deposition testimony to require a fact witness
16 to be prepared to explain each of Broadcom's positions or defenses in eight or more prior disputes.
17 Such discovery imposes an unreasonable burden on Broadcom's corporate designee and is only
18 tangentially relevant to the matters before the German court. It is equally inappropriate for BMW
19 to use this deposition topic as a means to inquire about disputed gaps in Broadcom's document
20 production, which is an issue that should be addressed between counsel. Broadcom's motion to
21 quash as to Topic No. 13 is granted. The Court orders the parties to confer regarding alleged gaps
22 in Broadcom's production of documents relating to these prior matters and to discuss whether any
23 missing documents can be supplied by Broadcom without undue burden, notwithstanding that
24 such documents may be located in files maintained by Broadcom's legal department.

25 **J. Topic No. 14**

26 In Topic No. 14, BMW asks for testimony about “[t]he conception and reduction to
27 practice of the alleged inventions disclosed in the Asserted Patents.” Broadcom objects that such
28 testimony is irrelevant, as Germany is a “first to file” jurisdiction, not a “first to invent”

1 jurisdiction, such that the date of invention is no earlier than the filing date of the patents. Dkt.
2 No. 66 at 18. BMW does not disagree but argues that conception and reduction to practice are
3 relevant to questions of proper inventorship and claim scope. Dkt. No. 67 at 8-9.

4 The parties agree that the German proceedings currently involve no assertions that
5 Broadcom has made improper inventorship claims. Dkt. No. 68 at 13; Dkt. No. 77 at 103:12-15.
6 BMW insists that the German court nevertheless would consider an inventor's conception of the
7 invention relevant extrinsic evidence of claim scope, although it identifies no particular question
8 of claim scope or interpretation at issue for which such testimony would be relevant. Dkt. No. 77
9 at 108:9-109:16. Again, it appears that BMW's principal goal is to obtain testimony regarding
10 Broadcom's collection and production of documents relating to the prosecution of the asserted
11 patents. Dkt. No. 67 at 8, 9 n.12; Dkt. No. 77 at 103:12-104:17.

12 Based on the record before the Court, including the declarations of each party's German
13 counsel, the German proceedings do not appear to involve any matter as to which an inventor's
14 conception or reduction to practice of the claimed invention is relevant. Even if BMW could
15 demonstrate that testimony about an inventor's conception or reduction to practice for a particular
16 asserted patent is relevant to a question of claim interpretation or scope, BMW does not explain
17 how a deposition of a corporate representative of Broadcom (as opposed to the inventor himself or
18 herself) is an appropriate tool for obtaining discovery of such matters. In any event, BMW may
19 not use this deposition topic as a means to inquire about whether Broadcom has produced all
20 relevant prosecution history materials, which is an issue that should be addressed between counsel.
21 Accordingly, Broadcom's motion to quash as to Topic No. 14 is granted. The Court orders the
22 parties to confer regarding Broadcom's production of prosecution history materials and whether
23 any missing documents can be supplied by Broadcom without undue burden, notwithstanding that
24 such documents may be located in files maintained by Broadcom's legal department.

25 **K. Topic No. 16**

26 In Topic No. 16, BMW asks for testimony about "[m]eetings, correspondence, or
27 communication between Broadcom's CEO Hock Tan and BMW's senior vice president Dr.
28 Christoph Grote." Broadcom objects to this deposition topic on the ground that BMW's own

1 executive was a participant in the meetings and communications to which the topic refers and that
2 such meetings and communications have no bearing on any matter at issue in the German
3 proceedings. Dkt. No. 66 at 15. In its opposition to the motion to quash, BMW says that it wishes
4 to inquire about Mr. Tan's preparations for his meetings and communications with Dr. Grote, not
5 the meetings and communications themselves. Dkt. No. 67 at 22-23. BMW points out that the
6 Court previously concluded a related document request sought relevant information to the extent
7 the preparation materials included a discussion of infringement or validity of the asserted patents.
8 See Dkt. No. 32 at 4:26-5:1. However, during the hearing, BMW conceded that the only reason it
9 wishes to take Broadcom's deposition on the topic of meetings and communications between Mr.
10 Tan and Dr. Grote is to explore Broadcom's collection and production of documents concerning
11 these meetings and communications and to investigate why more such documents do not appear
12 on Broadcom's privilege log. Dkt. No. 77 at 112:7-113:8.

13 The Court grants Broadcom's motion to quash as to Topic No. 16. On its face, this
14 deposition topic does not seek deposition testimony about Mr. Tan's preparations for his meetings
15 and communications with Dr. Grote and is not limited to infringement or validity of the asserted
16 patents. For these reasons, the topic does not seek any testimony relevant to any matter at issue in
17 the German proceedings. Moreover, it is not appropriate for BMW to use this deposition topic as
18 a means to investigate Broadcom's production of documents responsive to BMW's Request No.
19 14 or Broadcom's preparation of a privilege log.

20 **L. Topic No. 17**

21 In Topic No. 17, BMW asks for testimony about "[t]he materials or information produced
22 in response to any discovery requests" in two matters in which Broadcom sought discovery
23 pursuant to 28 U.S.C. § 1782 "relating to Nvidia's chip RIVA TNT." BMW says this discovery is
24 relevant to the validity and scope of the asserted patents because Nvidia's RIVA TNT chip is prior
25 art to those patents. Dkt. No. 67 at 12-13. Broadcom acknowledges that the materials it received
26 pursuant to its own § 1782 applications regarding Nvidia's RIVA TNT chip may be relevant and
27 states that it has already produced information responsive to BMW's corresponding document
28 request for these materials. Dkt. No. 66 at 20.

1 It is not clear what information BMW hopes to obtain about the “materials or information”
2 produced by a third party to Broadcom concerning the Nvidia prior art. BMW characterizes this
3 topic as encompassing information about Broadcom’s “awareness” of Nvidia’s RIVA TNT and
4 Broadcom’s “response” to the materials about Nvidia’s product that it received in discovery. Dkt.
5 No. 67 at 13. But these matters are not fairly within the scope of Topic No. 17, which is limited to
6 the “materials and information” Broadcom obtained through discovery about a prior art chip. To
7 the extent BMW wishes to inquire about the contents of these third-party materials, it has not
8 explained how a Broadcom fact witness will be able to supply any relevant information about
9 materials that Broadcom did not prepare. Finally, to the extent BMW wishes to use this
10 deposition topic to explore what other documents Broadcom may have about Nvidia’s RIVA TNT
11 (see Dkt. No. 77 at 114:15-115:3), this inquiry is both outside the scope of Topic No. 17 and not
12 an appropriate use of a deposition. Broadcom’s motion to quash is granted as to Topic No. 17.

13 **M. Topic No. 18**

14 In Topic No. 18, BMW asks for testimony about “Broadcom’s or Avago’s current ability
15 to access information owned, stored, housed, possessed, or controlled by any other entity affiliated
16 with or related to Broadcom or Avago, including, but not limited to Avago Technologies
17 International Sales Pte. Ltd. (Singapore), and policies or procedures regarding Broadcom's or
18 Avago's access to such information.” BMW says that it wishes to confirm that Broadcom has
19 produced documents responsive to BMW’s document requests, regardless of which Broadcom
20 entity maintains possession of the documents. Dkt. No. 67 at 23. Broadcom says that it has
21 already informed BMW that it would not withhold information or documents from BMW based
22 on which Broadcom entity controls those materials. Dkt. No. 66 at 21. BMW says it requires
23 sworn testimony to that effect.

24 This dispute reflects a concerning lack of cooperation and trust between the parties’
25 counsel. It is not the kind of dispute the Court should have to resolve. The Court orders counsel
26 for Broadcom to make a clear and specific written representation to counsel for BMW regarding
27 whether and to what extent there is any limitation on Broadcom’s or Avago’s current ability to
28 access information owned, stored, housed, possessed, or controlled by any other entity affiliated

1 with or related to Broadcom or Avago, with respect to information responsive to BMW's
2 discovery requests. The written representation must be provided no later than **October 16, 2020**.
3 Broadcom's motion to quash as to Topic No. 18 is granted.

4 **N. Topic No. 19**

5 In Topic No. 19, BMW asks for testimony about "[t]he factual basis for the infringement
6 allegations of Broadcom Corp. and Avago Technologies International Sales Pte. Ltd. against
7 BMW based on the Asserted Patents." The information BMW seeks is certainly relevant to
8 Broadcom's infringement claims, but it has already obtained this information directly in the
9 German proceedings. BMW acknowledges that the purpose of this deposition topic is to
10 investigate whether Broadcom has additional facts that it has not yet disclosed, but may disclose,
11 in the German proceedings. See Dkt. No. 77 at 55:10-57:2.

12 The Court questions whether it is appropriate to require a corporate representative to testify
13 regarding the factual basis for a party's infringement contentions. See *McCormick-Morgan, Inc. v.*
14 *Teledyne Indus., Inc.*, 134 F.R.D. 275, 286-87 (N.D. Cal. 1991) (discussing considerations
15 weighing against proposed deposition of fact witness regarding infringement
16 contentions), overruled on other grounds, 765 F. Supp. 611 (N.D. Cal. 1991); *TV Interactive Data*
17 *Corp. v. Sony Corp.*, No. C 10-475 PJH MEJ, 2012 WL 1413368, at *3 (N.D. Cal. Apr. 23, 2012)
18 (same). BMW has not adequately addressed this concern. Moreover, as the German court
19 apparently has its own procedures for considering amendments to a party's infringement positions,
20 the deposition of a corporate fact witness is not appropriate vehicle for BMW to obtain advance
21 notice of amendments Broadcom may seek to make to its infringement contentions. Broadcom's
22 motion to quash as to Topic No. 19 is granted.

23 **O. Topic No. 20**

24 In Topic No. 20, BMW asks for testimony about "[t]he systems and procedures Broadcom
25 and Avago use or used to monitor their patent portfolios for standard-essentiality, including, but
26 not limited to, investigating the standards for which a given patent is essential and investigating
27 which patents are essential for a given standard since January 1998." BMW says that this
28 testimony is relevant to its abuse of dominant market position defense. Dkt. No. 67 at 17. As

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1 noted above, this defense concerns only EP '531, and BMW may take deposition testimony
2 concerning this defense with respect to Topics No. 10-12 as to that patent. However, BMW
3 provides no justification for requiring a Broadcom witness to testify about whether and how
4 Broadcom monitored its patent portfolio with regard to the standard-essentiality of the patents
5 over the course of a 22-year period. There is no legal requirement for Broadcom to engage in such
6 monitoring, and whether it did or did not has no bearing on any claim or defense in the German
7 proceedings. Broadcom's motion to quash as to Topic No. 20 is granted.

8 **IV. CONCLUSION**

9 As discussed above, Broadcom's motion to quash is granted in whole or in part as to
10 Topics Nos. 1-2 and 5-20, and denied in whole or in part as to Topics Nos. 2-4, 7-12 and 15.
11 Where the Court has ordered the parties to confer, they shall do so promptly and must jointly
12 report back to the Court on the status of their discussions on those specific points no later than
13 **October 27, 2020**. The joint report is limited to five pages without attachments or other
14 supporting submissions.

15 **IT IS SO ORDERED.**

16 Dated: October 14, 2020

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19 VIRGINIA K. DEMARCHI
20 United States Magistrate Judge
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