

MOSAID Technologies Inc. (“MOSAID”) hereby opposes Micron Technology, Inc’s (“Micron”) Motion to Compel 30(b)(6) Testimony and respectfully requests that the Court deny Micron’s motion.¹ Specifically, Micron’s motion should be denied because (1) MOSAID has no information that may be compelled,² (2) Micron’s two noticed topics are not described with reasonable particularity, as required by Rule 30, and (3) importantly, the 30(b)(6) testimony Micron apparently seeks is not relevant to claim construction, as Micron professes.

Further, Micron refused to engage in meaningful discussions to try to resolve this dispute. For instance, Micron never informed MOSAID of the boundaries of what the topics were supposed to include or that they related to prosecution disclaimer – MOSAID first learned of this from Micron’s motion. Micron continues to pursue this motion, despite knowing that MOSAID has no appropriate information to compel. Micron’s conduct is deserving of sanctions, including the imposition of attorneys’ fees and costs.

I. FACTUAL BACKGROUND

On January 23, 2008, Defendants served their First Notice of Deposition Pursuant to Federal Rule of Evidence 30(b)(6) [hereinafter “Notice”], containing two deposition topics. *See* Hamann Decl., Exh. 2. Each topic provides only the barest of identifying information.

¹ Micron’s motion is in reality an improper and premature claim construction brief on prosecution disclaimer. Micron included five highlighted pictures relating to the ‘515 patent reference and argued how statements in the ‘919 patent file history contradict MOSAID’s proposed claim constructions, while couching this as a motion to compel 30(b)(6) testimony. MOSAID does not address Micron’s misleading claim construction arguments here but will do so in accordance with the Court’ Order in MOSAID’s reply construction brief.

² MOSAID already has told this to Micron. *See* Declaration of John D. Hamann (“Hamann Decl.”), Exh. 1, February 26, 2008 letter from Hamann to Schmitt.

Areas of Testimony

1. June 16, 2003 Response to the Examiner's April 4, 2003 rejection of Application No. 10/348,062 over the U.S. Patent No. 5,440,515.
2. Content and disclosures of U.S. Patent No. 5,440,515.

See Hamann Decl., Exh 2 (excerpting the totality of the topics from the Notice).

The topics make no mention of prosecution disclaimer. *Id.* The topics do not describe any type of factual activity relating to the June 16th Response or to the '515 patent reference. *Id.* The topics do not recite anything about preparing and filing the identified documents. *Id.* Topic one, in fact, only identifies the June 16th Response and nothing more. *Id.* Further, the identified '515 patent is not even a MOSAID patent – it is a reference distinguished by MOSAID's outside prosecution counsel, Mr. James Smith, in the '919 patent file history. Simply put, MOSAID could not tell what testimony the Defendants were seeking.

MOSAID informed Micron of the defects in the noticed topics on Friday, February 1, 2008, during a teleconference and stated that it could not provide a Rule 30(b)(6) witness for the defective topics. Hamann Decl., Exh. 3, February 14, 2008 email from Hamann to Schmitt; Exh. 4, February 1, 2008 email from Hamann to Rokach (stating that MOSAID would not provide a witness "for this notice").

MOSAID served its written objections to the Notice, memorializing objections from the February 1st teleconference, on Monday, February 4, 2008. Hamann Decl., Exh. 5. Micron responded by characterizing MOSAID's legitimate objections as boilerplate and cited case law that is not on point. See Hamann Decl. Exh. 6, February 5, 2008 letter from Rokach to Hamann.

MOSAID and Micron met and conferred in person on February 13, 2008 concerning, *inter alia*, the defects with the noticed topics. See Hamann Decl., Exh. 7, February 13, 2008

email from Hamann to Schmitt. MOSAID reiterated that the noticed topics did not provide sufficient clarity to define what testimony was being sought. *See id.*; Hamann Decl., Exh. 8, February 14, 2008 email from Hamann to Schmitt. MOSAID also tried to discuss why Micron was relying on cases which were inapposite to the arguments Micron was making. Micron refused to discuss the cases.³ *Id.*

Micron has yet to provide legal authority that is on point and/or controlling, despite MOSAID's repeated requests. *See e.g.*, Hamann Decl., Exhs. 7&8. Micron also chose not to serve a revised notice correcting the defective topics. Tellingly, Micron also declined MOSAID's offer to extend the deadline for Micron to file its motion to compel, to allow time for further meet and confers. *See* Hamann Decl., Exh. 9, February 14, 2008 email from Schmitt to Hamann. Micron filed its motion to compel instead.

II. LEGAL ANALYSIS

A. MOSAID Does Not Have Knowledge Concerning Topic Nos. 1 And 2 for Designating A Rule 30(b)(6) Witness

MOSAID undertook an investigation concerning what factual information it has relating to these topics, based on its understanding of the topics gained from reviewing Micron's motion. Hamann Decl., Exh. 1. From this, MOSAID determined that Mr. Adrian Earle, a former MOSAID employee, was the only MOSAID person who interacted with outside prosecution counsel, Mr. James Smith, concerning the topics, as characterized in Micron's motion. *Id.* In light of Mr. Earle's departure, MOSAID does not have factual information concerning the topics as expounded upon in Micron's brief. *Id.*; *see also Walden v. City of Chicago*, 2007 WL 328883, *3 (N.D. Ill. Feb. 1, 2007) (finding that when a party no longer has knowledgeable

³ Micron's flippant attitude towards the meet and confer requirements is evident. For example, Micron did not even bother (1) to seek a meet and confer before filing its Motion for Collateral Estoppel or (2) to comply with the Court's in person meet and confer requirement for its Motion to Compel regarding MOSAID's Licensing Practices, as it relates to MOSAID's interrogatory responses.

employees or information reasonably available, a 30(b)(6) witness not being provided does not warrant sanctions), Hamann Decl., Exh. 13. Accordingly, MOSAID requested that Micron withdraw its motion to compel. Hamann Decl., Exh. 1. Micron continues to pursue its motion, however.

Tellingly, Micron failed to inform the Court in its motion that it is scheduled to depose MOSAID's construction experts (Mr. Taylor and Dr. Huber) on March 5th and 6th respectively. *See* Order dated February 15, 2008 (Dkt. 277). MOSAID also failed to tell the Court that Mr. Smith, the outside prosecution counsel who signed the June 16th Response and distinguished the '515 patent reference, has agreed to make himself available to be deposed, in response to Micron's subpoena. Mr. Smith already has provided dates when he would make himself available, including March 7th, March 14th, or April 3rd, but Defendants have yet to accept a date. Hamann Decl., Exh. 10 February 14, 2008 Email from Hamann to Sangalli and Schmitt; Exh. 11, February 28, 2008 email from Hamann to Schmitt and Sangalli. Micron is apparently uninterested in pursuing its topics with the attorney who signed the June 16th Response.

B. Topic Nos. 1 And 2 of Defendants' Notice Lack Reasonable Particularity

Even if there was a witness, the deposition topics set forth in Defendants' Notice are vague and vastly overbroad. Rule 30(b)(6) requires that a notice or subpoena directed to an entity "must describe with reasonable particularity the matters for examination." Fed. R. Civ. P. 30(b)(6). Because Rule 30(b)(6) requires an entity to designate and prepare a person to testify on its behalf, a Rule 30(b)(6) notice is improper if the entity "cannot identify the outer limits of the areas of inquiry noticed." *Reed v. Bennett*, 193 F.R.D. 689, 692 (D. Kan. 2000) (quashing notice for testimony that "includ[e] but not [be] limited to" specifically enumerated subjects).

Defendants' notice is fatally defective because both topics therein fail to meet the

“reasonable particularity” requirement set forth in Rule 30(b)(6). The topics constitute little more than a bare identification of two documents, the June 16 Response and the ‘515 patent reference. Hamann Decl., Exh. 2. The topics fail to identify any factual activity in relation to those documents for which testimony is sought. As a result, Defendants placed the onus on MOSAID to figure out what Defendants were asking for, making investigation and appropriate designation of witnesses impossible. Pointing to documents and forcing MOSAID to play guessing games hardly constitutes the “reasonable particularity” mandated by Rule 30(b)(6). *See Sheehy v. Ridge Tool Co.*, 2007 WL 1548976, *3-4 (D. Conn. May 24, 2007) (notice requiring deposition by “[a] [r]epresentative . . . that is most knowledgeable as to the subject Complaint” improper), Hamann Decl., Exh. 14; *Michilin Prosperity Co., Ltd. v. Fellowes Mfg. Co.*, 2006 WL 1441575, *2 (D.D.C. May 23, 2006) (quashing notice for testimony “with respect to the approximately 2,000 pages produced . . . yesterday, May 15, 2006.”), Hamann Decl., Exh. 12; *Innomed Labs., LLC v. Alza Corp.*, 211 F.R.D. 237, 240 (S.D.N.Y. 2002) (denying motion to compel Rule 30(b)(6) testimony to “explain the contents” of twelve documents produced pursuant to subpoena).

Furthermore, it is no help to Micron to argue that “[t]he preparation and filing” of the patents-in-suit are acceptable topics for Rule 30(b)(6) testimony. *See* Hamann Decl., Exh. 6. Micron’s argument ignores a glaring fact: Neither of the deposition topics mentions “preparation and filing.” Defendant’s deposition topics do not refer to “preparation and filing,” or, for that matter, any activity at all. As discussed above, mere identification of a document does not constitute compliance with Rule 30(b)(6). *See, e.g., Innomed*, 211 F.R.D. at 240. For this reason, Micron’s reliance on *Sprint Communs. Co., L.P. v. TheGlobe.com, Inc.*, 236 F.R.D. 524 (D. Kan. 2006) and *Biovail Corp. Intern. v. Andrx Pharmacy, Inc.*, 158 F. Supp. 2d 1318 (S.D.

Fla. 2000) is misplaced.⁴

C. Defendants Seek Only Irrelevant Opinion Testimony From A Lay Witness

Moreover, Micron’s motion to compel should be denied because it improperly seeks irrelevant testimony from a lay witness (MOSAID) for purposes of claim construction.⁵ It is well-settled that claim construction issues, including prosecution disclaimer, are matters of law determined by the Court. *SanDisk Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278, 1286 (Fed. Cir. 2005) (prosecution disclaimer is a claim construction issue); *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1358 (Fed. Cir. 2004) (noting that “all claim construction issues [are] a question of law for the court, even though it is a question on which evidence from experts may be relevant.”). Prosecution disclaimer is found only if the disclaimed matter is “clear and unmistakable” from the prosecution history. *See SanDisk*, 415 F.3d at 1286. Because prosecution disclaimer focuses on the contents of the intrinsic evidence, extrinsic evidence, including Rule 30(b)(6) testimony, is not necessary to the analysis, much less “particular[ly] important,” as Micron would have the Court believe.

In construing claims, courts may consider extrinsic evidence, including expert reports and testimony. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (en banc). Lay opinion testimony, however, is not included in the universe of extrinsic evidence and is irrelevant to claim construction, and for good reason: Opinion testimony from lay witnesses sheds no light as to how claims terms are understood by one of ordinary skill in the art. Simply put, the content of the ‘515 Patent and the June 16th Response speak for themselves.

⁴ Micron’s citation of *Biovail* is particularly inapposite, as 1) it is unclear what the particular Rule 30(b)(6) topics were; 2) the Rule 30(b)(6) designee was an inventor of the patent-in-suit; and 3) the court in that case held that the claims of the patent-in-suit could be interpreted without recourse to extrinsic evidence. *Biovail*, 158 F. Supp. 2d at 1323, 1329.

⁵ Again, Micron’s reliance on the *Sprint* and *Biovail* cases is misplaced. It is unclear whether the Rule 30(b)(6) notice at issue in *Sprint* occurred in the context of claim construction discovery. Regardless, neither case stands for the proposition that Rule 30(b)(6) testimony is acceptable extrinsic evidence for purposes of claim construction. *See also* n.4.

III. MICRON SHOULD BE SANCTIONED BECAUSE ITS MOTION AND DEFENDANTS' RULE 30(B)(6) NOTICE ARE INTENDED FOR IMPROPER PURPOSES

Micron should be sanctioned for its frivolous attempts to force MOSAID to provide Rule 30(b)(6) opinion testimony on the claim construction issue of prosecution disclaimer. The Court has the inherent authority to sanction litigation abuses, even where such abuses are beyond the reach of a statute or rule. *See ClearValue, Inc. v. Pearl River Polymers, Inc.*, 242 F.R.D. 362 (E.D. Tex. 2007).

Micron ignored MOSAID's requests for a revised Rule 30(b)(6) notice and for a substantive discussion of the legal issues. *See Hamann Decl. Exh. 7; Exh. 8; Exh. 1.* Micron rebuffed MOSAID's offer to allow for further discussion by agreeing to extend the deadline for filing a motion to compel. MOSAID did not learn that the deposition topics sought lay opinion testimony on the claim construction issue of prosecution disclaimer until Micron filed its motion to compel. *See Hamann Decl. Exh. 1.* Micron continues to pursue the instant motion to compel even after having been informed that MOSAID cannot designate a Rule 30(b)(6) witness because it has no knowledge relating to the topics, as characterized in Micron's motion.

Under the circumstances, Micron's discovery conduct warrants sanctions. In view of the bad faith conduct involved, such sanctions should include at least an award of attorneys' fees and costs in responding to Defendants' First Notice of Rule 30(b)(6) Deposition and to Micron's motion to compel. *See ClearValue*, 242 F.R.D. at 383 (awarding attorneys' fees and costs for discovery abuse pursuant to court's inherent authority); *see also* Fed. R. Civ. P. 37(a)(5)(B) (authorizing reasonable expenses, including attorneys' fees, to party or deponent successfully opposing discovery motion).

IV. CONCLUSION

For the foregoing reasons, MOSAID respectfully requests that the Court deny Micron's

motion to compel and grant MOSAID's cross-motion for sanctions. Further, MOSAID hereby respectfully moves the Court for an Order:

1. denying Micron's Motion to Compel 30(b)(6) Testimony;
2. awarding attorneys' fees and costs to MOSAID incurred in responding to Defendants' First Notice of Rule 30(b)(6) Deposition and in opposing Micron's Motion to Compel 30(b)(6) Testimony; and
3. any other sanctions that the Court deems appropriate.

Otis W. Carroll
State Bar No. 03895700
IRELAND CARROLL AND KELLEY, P.C.
6101 South Broadway, Suite 500
Post Office Box 7879
Tyler, Texas 75711
Telephone: (903) 561-1600
Facsimile: (903) 561-1071
Email: nancy@icklaw.com

Attorneys for Plaintiff
MOSAID TECHNOLOGIES INC.

21049451

CERTIFICATE OF CONFERENCE

I certify that I conferred with counsel for Micron Technologies, Inc. (“Micron”) in a good faith effort to resolve the items presented to the Court in MOSAID’s cross-motion. Counsel for Micron indicated that Micron would oppose this motion.

/s/ John D. Hamann

John D. Hamann
Attorney for MOSAID TECHNOLOGIES
INC.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on February 29, 2008 a copy of PLAINTIFF
MOSAID TECHNOLOGIES, INC.'S OPPOSITION TO MICRON'S MOTION TO COMPEL
30(B)(6) TESTIMONY AND CROSS-MOTION FOR THE IMPOSITION OF SANCTIONS
was served via U.S. Mail upon the following counsel:

Mr. Gregory S. Arovas
Ms. Alexis Gorton
Mr. Todd M. Friedman
Kirkland & Ellis, LLP
Citigroup Center
153 E. 53rd Street
New York, NY 10022

Mr. Dan C. Hu
Ms. Diana M. Sangalli
Mr. Reed Joseph Hablinski
Trop, Pruner, & Hu, PC
1616 S. Voss Road, Suite 750
Houston, TX 77057

Mr. Christian Taylor
Mr. Bao Nguyen
Ms. Kimberly Schmitt
Ms. Cortney Hoecherl
Mr. Roy Wang
Kirkland & Ellis, LLP
555 California Street, 27th Floor
San Francisco, CA 94104

Mr. John David Crisp
Crisp, Boyd, Poff
2301 Moores Lane
Texarkana, TX 75505

Mr. Thomas W. Sankey
Thomas W. Sankey, PC
6 Gessner Road
Houston, TX 77024

Mr. Kurt Truelove
Mr. Nicholas H. Patton
Patton, Tidwell & Schroeder, LLP
4605 Texas Boulevard
PO Box 5398
Texarkana, TX 75505-5398

Mr. Edwin E. Richards, II
Trop, Pruner & Hu, PC
7718 Wood Hollow Drive, Suite G-50
Austin, TX 79731

By: /s/ John D. Hamann
John D. Hamann