

EXHIBIT H Part 2

Marvell is Not Entitled to a Presumption of Laches



Marvell ignores the evidence that CMU did not and could not have known of Marvell's infringement in May 2001

At trial, Marvell argued Dr. Moura's May 2001 notes and Dr. White's letters showed that CMU knew no one was using the invention

we're going to look at Greg Burd's lab book in a moment. But Dr. Moura's memos, his handwritten documents are saying all the same things. It's — you know, our patent is optimal, but people are out there working on suboptimal, suggesting ways around the patent. That is not infringing, finding ways, solutions that aren't as complex, that will actually work. And they're trying to do this either because they can get around the patent or they want a simpler solution; optimal implementation is complex.

12/20/12 Tr. at 71:2-10

like a hungry beast. Mr. Greenswag told us how a year in this business is like a lifetime, an eternity. Everybody out there is chasing the new thing, right? Here we have the license agreements where IBM, 3M and Seagate each have a right to these patents under these agreements for nothing, not a single more dollar. And we see that in 2001 CMU through this DSSC, they're pushing these guys to actually use the damn thing.

They write to Seagate -- there's Mr. Kryder again, right? He's over at Seagate. And they say: You know, we've got this hot new thing, why don't you use it? It's free, it's royalty free. They write the same letter to IBM in 2001. IBM, huge company, right, in the computer space. Why don't you use this thing? It's royalty free for you guys. They never use it. They never -- they never do it.

12/20/12 Tr. at 73:1-14

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Marvell ignores the evidence that CMU did not and could not have known of Marvell's infringement in May 2001

- Marvell argues that in 2001, Dr. Moura found a Marvell document on the internet that (somehow) disclosed Marvell's infringing conduct
 - Marvell failed to identify and produce such a document
- Marvell distorts the record: Dr. Moura was testifying about events in **April 2003**

Marvell failed to cite

Marvell cited

Q So is it your opinion, sir, that back in 2003, in this e-mail, you were -- you and Dr. Kavcic were speculating that Marvell was using your patents back then?

A We are not speculating. We are hearing rumors that these things are happening. Look at what it says: Today I got two more independent confirmations about what the industry is building in their next generation chips. Direct quotes.

They are now building chips to tackle media noise. Alek, the chip vendors are building chips exactly as you said in your autoregressive noise paper.

So this is people that are in the know, we assume, that are telling us. We didn't look at your circuits. You didn't -- actually, that's interesting, because more or less at this time or maybe sometime earlier we looked on the web. The web is already available at that time, as you know. And we figured there was a marketing document sometime on the web that mentioned exactly things like this and there was a paper. And then when we tried to recover those things, those things disappeared from the web.

Q So you don't have those papers, do you?

A Unfortunately not.

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Marvell ignores the evidence that CMU did not and could not have known of Marvell's infringement in May 2001

Marvell's *internal admissions* regarding its “must have” need for CMU's invention did not put CMU on a duty of inquiry

- CMU's “must have” theory arose from documents obtained only through discovery
- The core “must have” documents are all dated *no earlier than January 2002* – seven months after the May 2001 meeting at CMU
- Marvell ignores the fact that as late as April 2003, Dr. Kryder told CMU that Seagate knew of no one using the Kavcic-Moura detector

Marvell is Not Entitled to a Presumption of Laches



Marvell ignores the evidence that CMU did not and could not have known of Marvell's infringement in May 2001

- On laches, Marvell argues that Dr. Moura's notes regarding "optimal" detectors mean that CMU knew or should have known Marvell was *infringing*:

that CMU had applied to patent his work. By May 16, 2001, nearly *eight years* before it filed this suit, CMU's knowledge had matured *still further*. The evidence shows that CMU concluded the industry, including Marvell, was developing suboptimal versions of media-noise detectors that added "bells and whistles" in an attempt to circumvent its patent (to avoid having to license it) by claiming it was too complex. Such attempts, according to CMU's theory in this case, could not avoid infringement.

Dkt. 804 at 2

- On willfulness, Marvell argues that Dr. Moura's notes on "optimal" detectors mean that Marvell's *non-infringement defenses* were objectively reasonable:

Third, Dr. Moura's May 2001 handwritten notes, like Dr. Kavcic's article, describe the CMU patent as the "optimal" solution, but one that is too "complex," thus leading others to develop "suboptimal" solutions. (DX-1522, at 2.) The inventors' own statements thus confirm Marvell's understanding of the Kavcic detector's complexity and support the objective reasonableness of the conclusion that Marvell's technology was different.

Dkt. 834 at 9

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Marvell ignores the evidence that CMU did not and could not have known of Marvell's infringement in May 2001

- For laches, Marvell argues (without any evidence) that CMU *lay in wait to increase damages*:

On the other hand, it is unreasonable for a patent plaintiff to remain silent while damages are accruing, without inquiring about the defendant's activities or notifying the defendant of any infringement concerns. See, e.g., *Aukerman*, 960 F.2d at 1033 (“[A] patentee may [not] intentionally lie silently in wait watching damages escalate ... particularly where an infringer, if

Dkt. 804 at 7

- For willfulness, Marvell argues that CMU's delay was due to CMU's belief that Marvell had *good non-infringement defenses*:

- *CMU's Delay.* While CMU's unexplained delay in filing suit likewise does not insulate against infringement, such a delay helps negate objective willfulness, for it shows that CMU lacked any obvious or immediate basis to overcome Marvell's reasonable defenses to infringement.

Dkt. 851 at 4

Marvell Has Not Proven Laches

Summary

Marvell Has Not Proven Laches

**Marvell's Secrecy Precludes a
Finding of Constructive Knowledge
and Unreasonable Delay**

Marvell Has Not Proven Economic Prejudice

Marvell Has Not Proven Evidentiary Prejudice

Marvell Has Not Proven Laches



To establish a factual predicate for laches, an infringer has the burden to prove **both** that “plaintiff delayed filing suit an unreasonable and inexcusable length of time after [it] knew or reasonably should have known of its claim against the defendant **and** that the delay resulted in material prejudice to the defendant.”

State Contracting & Eng'g Corp. v. Condotte Am., 346 F.3d 1057, 1065 (Fed. Cir. 2003)

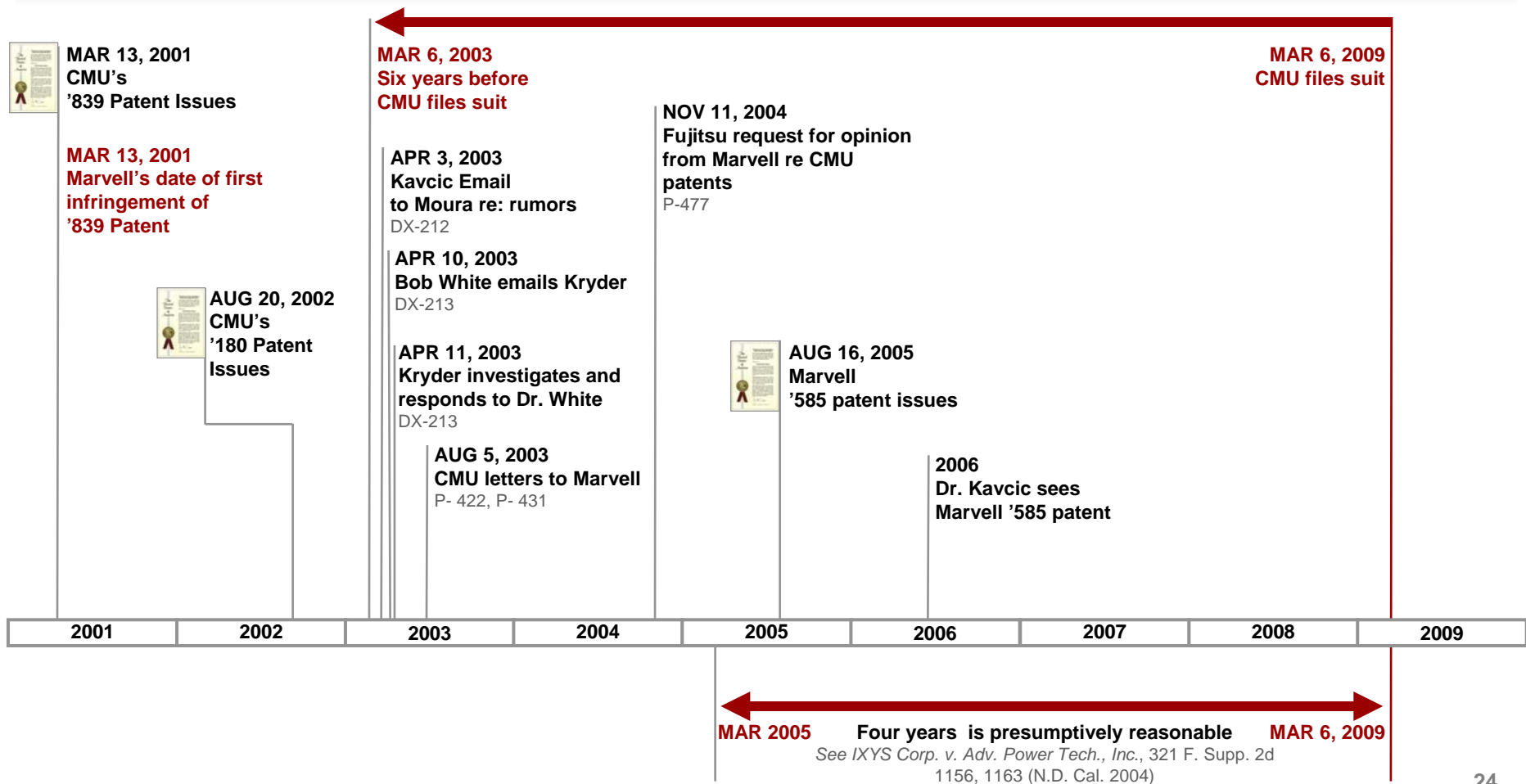


The Federal Circuit “has pronounced a three or four-year delay unreasonable **only when that delay was accompanied by extraneous improper tactics or misleading conduct by the plaintiff.**”

IXYS Corp. v. Adv. Power Tech., Inc., 321 F. Supp. 2d 1156, 1163 (N.D. Cal. 2004)

Marvell Has Not Proven Laches

CMU Fulfilled Its Duty of Inquiry and Did Not Unreasonably Delay



Marvell Has Not Proven Laches

CMU Fulfilled Its Duty of Inquiry and Did Not Unreasonably Delay

**April 2003: Dr. Kavcic hears rumors about Marvell's activities
and reports them to CMU**

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> -----Original Message-----  
> From: Jose' M. F. Moura [mailto:moura@ece.cmu.edu]  
> Sent: Saturday, April 05, 2003 9:07 AM  
> To: Aleksandar Kavcic  
> Subject: Re: patent  
>  
>  
> Alek  
> this is great, I will pursue it from this end.  
> Jose'  
>  
> Aleksandar Kavcic wrote:  
>  
> >Jose',  
> >  
> >Today I got two more independent confirmations about what the industry is  
> >building in their next generation chips. Direct quotes:  
> >  
> >a) "They are now building chips to tackle media noise"  
> >  
> >b) "Alek, the chip vendors are building chips EXACTLY as you said  
> >in your autoregressive noise paper"
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DX-212

Marvell Has Not Proven Laches

CMU Fulfilled Its Duty of Inquiry and Did Not Unreasonably Delay

April 2003: Dr. Kavcic's reference to an earlier "confirmation" was from this same time period, and he had no prior "suspicions" regarding Marvell

Dkt. 858-1 at 8;
Tr. 813

11 What other confirmation did you have
12 prior to April 5, 2003 when you sent this
13 e-mail to Jose Moura?
14 A. I don't recall what other confirmations of
15 building. Perhaps it was -- at that time, it
16 was Ara, and then these two were independent
17 on top of what Ara had said.
18 Q. And Ara is Ara Patapoutian?
19 A. Yes, sir.

Dkt. 858-1 at 9;
Tr. 815-816

15 Q. Okay. When did Ara Patapoutian tell you about
16 all the companies using your technology,
17 because it seems like it's before April 5,
18 2003, Professor Kavcic?
19 MR. GREENSWAG: Objection,
20 mischaracterizes his testimony and the
21 document.
22 A. My testimony was never that Ara Patapoutian
23 gave me information about all.
24 Can we go back as to what I said?
25 Q. Well, why don't you tell us what he told you
1 before April 5, 2003.
2 A. I don't know when, but I think Ara Patapoutian
3 was telling me about Agere, not all.

9 Q. Okay. We went over the meeting, and so now
10 I'm focused on whether you have any
11 information that would lead you to believe or
12 give you suspicions regarding whether Marvell
13 was building a chip that was using your
14 technology prior to April 5th of 2003, and if
15 you have no information, just tell me.
16 A. I don't think I had any information about
17 suspicions.
18 Q. Okay. So from the time that you put your list
19 together in Exhibit 47 on April 13, 2001, for
20 almost two years, to April 5, 2003, you had no
21 suspicions regarding what Marvell was building
22 until April 5, 2003?
23 A. From which date to which date?
24 Q. From the date of Exhibit 47 to the date of
25 Exhibit 48.
1 MR. GREENSWAG: Can you read the
2 question back, please.
3 ----
4 (The record was read back by the Reporter.)
5 ----
6 A. I had no reason to have any suspicions.
7 Q. Okay. No other information?
8 A. I believe there was no other information.

Dkt. 858-1 at 9;
Tr. 817-818

Marvell Has Not Proven Laches

CMU Fulfilled Its Duty of Inquiry and Did Not Unreasonably Delay

CMU investigates these rumors by contacting Dr. Kryder at Seagate

```
>Mark,  
>  
> You may recall a year or so ago I was trying to get our sponsors  
>who make drives to consider  
>pushing the Kavcic-Moura algorithm dealing with correlated media noise with  
>  
>their channel-chip vendors.  
>At InterMag Alex heard rumors that several chip suppliers are in fact  
>developing chips that employ  
>this algorithm. Is there any way you could help us confirm these rumors?  
>This is obviously IP that  
>Seagate has funded and has rights to through the DSSC.  
>  
>Bob
```

DX-213 at 1

- The email confirms that prior to April 2003 CMU had no suspicions that channel-chip vendors (such as Marvell) were infringing
- CMU asks Dr. Kryder if he can confirm the rumors
- CMU reminds Dr. Kryder that Seagate has no exposure because it is a licensee

Marvell Has Not Proven Laches

CMU Fulfilled Its Duty of Inquiry and Did Not Unreasonably Delay

Dr. Kryder consults with Seagate's signal processing expert and reports that no one is using the CMU invention

- Dr. Kryder recommends that CMU give notice of the patents to industry and invite them to take a license

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>X-Sieve: cmu-sieve 2.0
>Subject: Re: Kavcic-Moura algorithm
>To: white@ece.cmu.edu
>Cc: Dee.Frazzini@seagate.com
>X-Mailer: Lotus Notes Release 5.0.8 June 18, 2001
>From: Mark H. Kryder@seagate.com
>Date: Fri, 11 Apr 2003 22:22:13 -0400
>X-MIMETrack: Serialize by Router on SV-GW1/Seagate Internet(Release
>5.0.11 [July 24, 2002]) at
> 04/11/2003 09:05:01 PM
>
>
>Bob,
>
>
>We are not aware of anyone utilizing the claims in the Kavcic-Moura patent,
>although channel vendors may well be working in the area of designing
>detectors for signal dependent noise. Even before Kavcic and Moura filed
>their patent, there had been work by others on signal dependent noise.
>Hence, their patent does not read on every implementation of channels that
>are designed for signal dependent noise. To really answer the question of
>whether their patent was being used or not, one would have to carefully
>look at the claims in their patent and then look, very carefully at how the
>channel chips being manufactured were implementing their detection
>algorithms. That is not easy to do.
>
>
>What you might want to do is send the patent to relevant people in each of
>the channel vendors making them aware of the patent and indicating that, if
>they are building channel chips that incorporate algorithms for signal
>dependent noise, they may be violating that patent, and if they are not,
>they may want to consider designing a chip based upon that patent. In
>either case, they may be interested in obtaining a license to that patent.
>If they are using something claimed by the patent, this may cause them to
>take a license, because, as I understand the law, they are liable for
>considerably higher damages if they knowingly use your patent after you
>have notified them of it.
>
>
>Mark
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DX-213

Marvell Has Not Proven Laches

CMU Fulfilled Its Duty of Inquiry and Did Not Unreasonably Delay

At trial, Marvell argued that Dr. Kryder's email meant that CMU "knew" no one was using the invention

And don't take my word for it. Mr. Kryder in 2003, remember he's — CMU and Seagate are close as kittens, right? Seagate is one of the DSSC associates. Kryder has been at both places. I mean they really know each other well. Seagate is here in Pittsburgh. They have a presence, as we heard. He says: We're not aware of anyone using the claims in the Kavcic/Moura patent.

And that's from Kryder. And remember he's being told — this is obviously IP that Seagate has funded and has rights to. So it's not just: Hey, is there some sort of claim here or something we can do with this? It's: You can make some money here, you've funded this. And what does Kryder say? He says: Well, I talked to the experts on signal processing, and I'm not aware of anybody in the industry using it. And Seagate never took a license themselves either.

12/20/12 Tr. at 82:14-20 and 83:3-10

Marvell Has Not Proven Laches

CMU follows Dr. Kryder's advice

Exhibit 100-0
Name _____
Date _____
Page _____
AKF

Innovation Transfer Center
Carnegie Mellon University
1501 Forbes Avenue, Suite 502
Pittsburgh, PA 15213
Phone: 412-268-4387
Fax: 412-268-7195
Email: cmu@cmu.edu

Dr. Pentas Sutardja
Chief Technical Officer
Marvell Semiconductor, Inc.

August 4, 2002

Dr. Pentas Sutardja
Chief Technical Officer
Marvell Semiconductor, Inc.
700 First Ave.
Sunnyvale, CA 94089

Dear Dr. Sutardja:

It has come to the attention of Carnegie Mellon University ("CMU") that in recent months there has been an upsurge of interest on the part of industry in coordination-sensitive adaptive sequence detectors for signal-dependent noise and their application in data storage and retrieval using magnetic media. CMU is pleased to have been among the very first parties to have performed research in this area and has been awarded two United States patents, namely US Patent number 6,304,899 B1 and US Patent number 6,458,180 B1. I have taken the liberty of including copies of these patents along with this letter.

CMU has a long history of working with industry in order to bring the benefits of its research to the public and I would be happy to work with you to negotiate a license to these patents if that would be of interest to you. It is CMU's intention to work with interested parties such as Marvell Semiconductor to establish reasonable terms that allow these companies to commercialize products derived by our previous work and equitable terms that benefit all the parties involved.

If you find the attached patents to be of interest, please feel free to contact me at the address given above so that together we can further investigate whether you would find it attractive to license CMU's proprietary technology.

Sincerely,

Carl P. B. Mahler, II

CMU/ITC

PLAINTIFF'S TRIAL EXHIBIT
P-422

P-422

Innovation Transfer Center
Carnegie Mellon University
1501 Forbes Avenue, Suite 502
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Phone: 412-268-4387
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Email: cmu@cmu.edu

Mr. Matthew Gloss
Vice President for Business Affairs and General Counsel
Marvell Semiconductor, Inc.

Mr. Matthew Gloss
Vice President for Business Affairs and General Counsel
Marvell Semiconductor, Inc.
700 First Ave.
Sunnyvale, CA 94089

Dear Mr. Gloss:

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CMU has a long history of working with industry in order to bring the benefits of its research to the public and I would be happy to work with you to negotiate a license to these patents if that would be of interest to you. It is CMU's intention to work with interested parties such as Marvell Semiconductor to establish reasonable terms that allow these companies to commercialize products derived by our previous work and equitable terms that benefit all the parties involved.

If you find the attached patents to be of interest, please feel free to contact me at the address given above so that together we can further investigate whether you would find it attractive to license CMU's proprietary technology.

Sincerely,

Carl P. B. Mahler, II

CMU/ITC

PLAINTIFF'S TRIAL EXHIBIT
P-431

P-431

- Marvell does not respond to CMU's letters – which are within the six-year laches period
- Marvell claims to have responded to all the "invitations to license" it received – *except CMU's*