

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA**

CARNEGIE MELLON UNIVERSITY,

Plaintiff,

v.

MARVELL TECHNOLOGY GROUP, LTD.
and MARVELL SEMICONDUCTOR, INC.,

Defendants.

Civil Action No. 2:09-cv-00290-NBF

Hon. Nora B. Fischer

**MARVELL'S MEMORANDUM IN SUPPORT OF ITS MOTION TO COMPEL OR TO
REVIEW *IN CAMERA* OF DOCUMENTS WITHHELD BY CMU THAT ARE
RELEVANT TO LACHES**

In its February 7, 2013 Order denying Marvell's motion for an evidentiary hearing on laches (Dkt. No. 781), this Court instructed that Marvell should include with its proposed findings of fact and conclusions of law "all evidence that it intends to proffer in support of its defense" of laches. *Id.* Among that evidence are documents on CMU's privilege log that at the very least suggest, on their face, CMU was analyzing—more than six years before it brought its instant suit and in all events before it became privy to Marvell's confidential material—the facts and theories giving rise to its instant suit. As submitted in Marvell's proposed findings of fact and conclusions of law, those log entries, along with other evidence and testimony adduced at trial, establish that CMU knew or should have known of Marvell's potentially infringing activities more than six years before it brought suit, such that laches presumptively applies—or else, at the very least, that CMU was capable of investigating its claims without resort to the confidential information it would now characterize as indispensable.

To the extent that CMU would nonetheless submit, and this Court would entertain, argument that the log entries themselves do not prove what they indicate on their face—namely, that CMU was alert to and pursuing its infringement claims as to the patents-in-suit years before it filed suit and years before it contends it could have—Marvell respectfully requests that the Court grant relief adequate to permit full and fair development of disputed facts. Specifically, Marvell requests that the Court compel production to Marvell of documents withheld by CMU to the extent they reflect CMU’s factual understanding of its patents-in-suit and claims in connection with same, or, in the alternative, simply order them produced for its *in camera* review. As grounds for this motion, Marvell respectfully states:

1. Several of CMU’s log entries reveal that CMU is withholding documents that stand to undermine its current contentions with respect to laches. These entries, and presumably the documents underlying them, at the very least suggest that CMU was aware of potential infringement claims and of facts supporting them long before it filed suit; correspondingly, they belie any contention that CMU could not have apprehended potential infringement by Marvell until Marvell was granted its patent. By way of example:

- A March 2, 1999 entry, authored by “Innovation Transfer Center–CMU,” describes a spreadsheet prepared at the direction of CMU’s Office of General Counsel “in anticipation of litigation” regarding “possible infringement of patents-in-suit.” (P-CMU 0002248-61; P-CMU 2356-70).
- A December 1, 2000 entry, authored by “CMU legal” describes legal research by counsel in “anticipation of litigation” (P-CMU 8825-37).
- Several entries dated December 7, 10, and 18 2002 were withheld on the grounds that they were prepared in “anticipation of litigation” and reflect legal theories, opinions, and mental impressions of counsel regarding the activities of the disk drive market and the data storage industry (P-CMU 10286-89; P-CMU 10285; P-CMU 10595; and P-CMU 10592-93).
- Twenty-nine entries from March 9, 2003 through the end of 2003 have been withheld on the ground that they were prepared “in anticipation of litigation”

regarding possible infringement of the patent-in-suit. (P-CMU 2262-79; P-CMU 2678-2695; P-CMU 3258; P-CMU 2855-56; P-CMU 3255; P-CMU 3256; P-CMU 2857; P-CMU 2858-59; P-CMU 2860-61; P-CMU 2862-63; P-CMU 1049-50; P-CMU 1768; P-CMU 2245-46; P-CMU 1769-70; P-CMU 1771-75; P-CMU 5212-16; P-CMU 5617; P-CMU 1776-80; P-Kavcic 1507-11; P-Kavcic 1512-17; P-Kavcic 1518-1525; P-CMU 1781-87; P-CMU 1788-96; P-CMU 9069; P-CMU 1797-99; P-Kavcic 545-547; P-CMU 2864-66; P-CMU 9667-76; P-CMU 9732-41). For example, a March 9, 2003 entry on CMU's privilege log describes notes prepared by Dr. Moura "at the direction of CMU's Office of General Counsel in anticipation of litigation," reflecting legal advice from counsel regarding possible infringement of the patents-in-suit (P-CMU 1049-50).

- Numerous entries dated from April–December 2003, including emails between Dr. Kavcic and Dr. Moura, are described as prepared in anticipation of litigation regarding possible infringement of the patents-in-suit (P-CMU 1768; P-CMU 1797-99; P-Kavcic 545-547).
- A March 10, 2005 entry describes a communication between K&L Gates (Holly Towle) and CMU's General Counsel, Ms. Mary Jo Dively that was prepared in anticipation of litigation regarding "CMU/Marvell litigation" (P-CMU 6480-86). There are also several undated entries concerning the anticipated "CMU/Marvell" litigation (P-CMU 1004-28; P-CMU 949-48; P-CMU 001279-86; P-CMU 0001287; P-CMU 1189; P-CMU 1190; P-CMU 1151-53; P-CMU 930-32; P-CMU 82-85).

2. Not only may the withheld documents be probative, quite possibly dispositive, of CMU's awareness of its potential infringement claim against Marvell, but they may uniquely preserve factual content otherwise lost to CMU documents that have spoliated. For example, Dr. Kavcic's document production in this case omitted his 1998 emails to Marvell about his GLOBECOM 98 paper, as well as other emails regarding his work on his media-noise detector during the 1996–2000 timeframe that might reveal the understanding and course of proceeding between the parties (DX-1023)¹. Similarly, Dr. Moura's documents reflecting his contributions

¹ Although Marvell produced an email from Dr. Kavcic to Dr. Nazari at Marvell dated March 1998, Dr. Kavcic's files did not contain the email or any related documents during this timeframe.

and understanding from 1996–2000 are altogether missing (P-156)². The documents withheld, however, may well record the contemporaneous observations and understanding of the inventors as to their conception, enablement, and validity of their inventions, as well as the scope of CMU’s patents relative to other inventions, including Marvell’s, as disseminated within CMU.

3. Any interest CMU has in withholding documents on the ground that they were prepared in anticipation of litigation must yield to Marvell’s current needs for the documents. In *Bird v. Penn Central Co.*, the defendants successfully secured compulsion of documents otherwise shielded by work-product protection because defendants had a compelling need for documents showing what plaintiffs knew, and when, about their relevant claims for purposes of illuminating a laches defense. *See generally* 61 F.R.D. 43 (E.D. Pa. 1973). “Defendants have asserted that plaintiffs are barred from bringing this action because they knew or should have known of the grounds alleged as the basis for rescission long before they filed suit Since the relevant inquiry is into what plaintiffs knew or should have known concerning grounds for their rescission action, only through discovery of information in the hands of plaintiffs, and their agents, can defendants substantiate their defense.” *Id.* at 46-47. The court held that, to overcome work product claims in support of a laches defense, “it is sufficient to show that[,] to prepare their case adequately, defendants need to know why plaintiffs, through the direction of their attorneys, failed to bring a rescission action sooner.” *Id.* at 47.

4. Given the extraordinary stakes and the surprising dimensions of CMU’s novel claim presented here, it is difficult to imagine a stronger, more compelling need than Marvell would have for these documents in connection with its laches defense now at issue if CMU

² The “Disclosure of Invention” (P-156), signed and dated March 7, 1997 by Dr. Moura, states that he contributed 50% to the invention; yet no documents were produced related to his contributions during the critical 1996-2000 time frame.

continues to advance arguments at odds with what its privilege log spells out on its face. Indeed, fundamental fairness and justice would be compromised if CMU continues to withhold these documents reflecting the facts of what it perceived and when about infringement of its patents even as it insists it could not have perceived any infringement before it obtained discovery in this case.

5. If the Court is not inclined to compel production of the documents at issue to Marvell, then it should at least order them produced for its own *in camera* review, consistent with its prior practice in this case. Shortly before trial, the Court ordered Marvell, at the urging of CMU, to produce for *in camera* review relevant documents Marvell had withheld on grounds of privilege. On December 18, 2012, in considering the issue of Marvell's pre-suit communications with counsel, as raised by CMU's Motion in Limine to Strike Testimony and to Preclude Argument Relating to Marvell's Pre-suit Communications with Counsel about the Patents-in-Suit (Dkt. 722), the Court ordered Marvell to produce *in camera* all documents identified on Marvell's privilege log (P-953) involving or referencing Marvell inventors, Mr. Burd and Dr. Wu; Marvell's in-house attorney, Mr. Janofsky; or mentioning CMU, Kavcic, or Seagate between the years of 2001 to 2003 (Dkt. 737). On December 19, 2012, Marvell provided the Court with copies of the documents from its privilege log. The same procedure commends itself here. Adjudication of any applicable protection relative to Marvell's countervailing need could be safely entrusted to the Court, as could determinations whether factual content is due to be produced to Marvell following appropriate redactions.

Recognizing as much, sister courts have undertaken *in camera* review of documents withheld on privilege grounds that were potentially needed by a party advancing a laches defense. *See Omax v. Flow Int'l Corp.*, No. C04-2334L, 2007 WL 1830631 at *2 (W.D. Wash.

June 22, 2007) (ordering *in camera* inspection of allegedly-privileged documents based on argument that the documents may not be privileged and, “even if the documents do contain some privileged information[,] they should be produced in redacted form because they may contain factual statements that are highly relevant to [defendant’s] laches defense”); *see also Parsons v. Jefferson-Pilot Corp.*, 141 F.R.D. 408, 416-20 (M.D.N.C. 1992) (ordering *in camera* inspection of allegedly-privileged documents where movant asserted they were necessary for a laches defense as well as relevant to equitable remedies).

6. Marvell has consulted CMU in connection with its instant motion, which CMU opposes.

* * *

For the foregoing reasons, Marvell respectfully requests that the Court compel CMU to produce to Marvell, or, alternatively, to the Court for *in camera* review, all documents withheld in anticipation of litigation and/or concerning legal advice regarding: (1) the patents-in-suit, (2) possible infringement, (3) litigation, (4) the disk drive market, (5) the data storage industry, or (6) the CMU/Marvell litigation, up to the filing of the instant lawsuit (including all undated documents), as identified in Ex. A.³ In the alternative, if the Court finds that these documents are too voluminous, Marvell respectfully requests that the Court compel CMU to produce to Marvell, or, alternatively, to the Court for *in camera* review, the subset of these withheld documents dated prior to 2006 (including all undated documents). The CMU, Kavcic and K&L Gates privilege logs are attached hereto as Exs. B-D.⁴

³ Exhibit A includes a list of these documents compiled by Marvell’s counsel based on the entries found in CMU, Kavcic, and K&L Gates privilege logs, including the dates (where provided), descriptions, authors, and bates ranges of the documents.

⁴ The exhibits will follow upon grant of authorization to seal.

Dated: February 11, 2013

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on February 11, 2013, the foregoing was filed electronically on ECF.

I also hereby certify that on February 11, 2013, this filing will also be served on counsel for CMU by electronic mail.

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