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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

The CALIFORNIA INSTITUTE OF TECHNOLOGY, a California Corporation,

Plaintiff,

vs.

BROADCOM LIMITED, BROADCOM CORPORATION, AVAGO TECHNOLOGIES LIMITED, APPLE INC., AND CYPRESS SEMICONDUCTOR CORPORATION

Defendants.

CASE NO. 2:16-cv-3714-GW-AGRx

CALTECH'S RESPONSE TO DEFENDANTS' SUPPLEMENTAL SUBMISSION CONCERNING MOTION TO DISQUALIFY DR. MATTHEW SHOEMAKE

Hearing Date: May 1, 2017
Time: 8:30 A.M.
Judge: Hon. George H. Wu

Fact Discovery Cutoff: Aug. 18, 2017
Pretrial Conference: TBD
Trial Date: TBD

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I. INTRODUCTION

Plaintiff California Institute of Technology ("Caltech"), submits this response to Defendants' supplemental submission concerning their motion to disqualify Dr. Matthew Shoemake.

Defendants improperly filed their supplemental submission *in camera*, thereby depriving Caltech of its right to fully respond. Defendants not only failed to seek leave to make an *in camera* submission, in violation of Local Rule 79-6.2, but also do not, and cannot, justify an *in camera* submission.[1] It is well established in our adversary system that Defendants cannot ask for disqualification of an expert based on allegedly privileged information while at the same time denying the opposing party access to that information. Accordingly, Caltech respectfully submits that the Court should decline to consider Defendants' *in camera* submission and should deny Defendants' motion to disqualify forthwith.

On the merits, Defendants' have utterly failed to satisfy their burden of "point[ing] to specific and unambiguous disclosures that if revealed would prejudice" Defendants in this case. *Hewlett-Packard Co. v. EMC Corp.*, 330 F. Supp. 2d 1087, 1094 (N.D. Cal. 2004). In opposing Defendants' motion, Caltech demonstrated that Defendants did not previously share any confidential information with Dr. Shoemake that relates to the error correction coding technology in the present case. (Dkt. 154, Opposition Br. at 12-15). The only information that Defendants even alleged in their opening brief had been provided to Dr. Shoemake was technical information from the *Wi-LAN 1* case. (Dkt. 103 at 11-12).

[1] Before Defendants made their most recent filing, the parties corresponded about an offer by Defendants to withdraw their motion to disqualify, which Defendants have now apparently revoked (without explanation). (Dowd/Asperger April 21-26, 2017 email chain, Shyr Decl. Ex. 15.) Not once during the parties' exchanges did Defendants disclose that they intended to submit anything *in camera*, (footnote continued)

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Defendants provided no evidence, however, that the technical information available to Dr. Shoemake in the *Wi-LAN 1* case was confidential, or that it had any relevance to the present case. In fact, Defendants' opening brief did not even mention [redacted] Defendants' failure was not surprising since the *Wi-LAN* cases involved modulation carrier offset recovery, which [redacted] (Dkt. 155-1 at ¶¶ 29-32 ("Shoemake Decl.")). As the Court recognized in its tentative ruling, the patent at issue in the *Wi-LAN* cases related to "a technology for multiple access between transceivers in wireless communications using orthogonal frequency domain modulation ("OFDM") spread spectrum, and in no manner claims any sort of error correcting code technology, let alone IRA codes claimed in the Asserted Patents; and Defendants fail to show any overlap between the two." (Dkt. 171 at 5).

After failing to satisfy their burden in the moving papers, Defendants improperly submitted seven ***new*** exhibits from the *Wi-LAN 1* case with their reply brief. (Dkt. 164-2 to 8); *United States ex rel. Giles v. Sardie*, 191 F. Supp. 2d 1117, 1127 (C.D. Cal. 2000)("It is improper for a moving party to introduce new facts or different legal arguments in the reply brief than those presented in the moving papers."). These new exhibits did nothing to advance Defendants' motion. They do not contain information that is relevant to the present case, and the information in them that Defendants cited was not confidential. (Caltech's Apr. 20, 2017 Hearing Presentation Slides, Shyr Decl. Ex. 9 at pp. 9-12.) As a result, the Court correctly found in its tentative ruling that Defendants failed to "specifically and unambiguously identify confidential information that they purportedly disclosed to Shoemake and demonstrate whether (or how) that information is relevant to this action." (Dkt. 171 at 5).

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generally identify what the purportedly privileged information was, or propose a mechanism for making the filing without prejudicing Caltech's ability to respond.

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Having failed twice before, Defendants have made a last ditch effort to convince the Court by improperly shielding their "evidence" in an *in camera* submission. (Dkt. 172, "Defs. Supp. Submission"). But even though Caltech improperly has been denied access to the substance of the *in camera* information, it is clear that Defendants have simply re-hashed their same flawed arguments. Defendants once again make misleading and incorrect assertions about the scope of Caltech's discovery requests (an argument that was raised in their Reply brief and rejected in the Court's tentative ruling). Contrary to Defendants assertions, however, the record makes clear that both parties have focused discovery on the accused error correction coding functionality. Defendants also list ten additional documents from the *Wi-LAN 1* case in their attorney declaration. (Dkt. 172-1). Regardless of what is in these documents, they cannot change the fact that [redacted] that provided access to information of "particular significance or [that] can readily be identified as either attorney work product or within the scope of the attorney-client privilege." *Hewlett-Packard*, 330 F. Supp. 2d at 1094. Even if the documents cited by Defendants, or similar materials, were somehow relevant to this case (which they are not), they cannot support disqualification because "[o]nly the disclosure of confidential information that the opposing party would be unable to obtain through discovery should form a basis for disqualification of an expert witness." *Twin City Fire Ins. Co. v. Mitsubishi Motors Credit of Am., Inc.*, No. 04-0043, 2006 WL 5164249, at *4 (C.D. Cal. Nov. 6, 2006).

The delays resulting from Defendants' unsupportable allegations are causing prejudice to Caltech by precluding its expert from reviewing material that is critical to this case. Accordingly, for the reasons set forth herein, Caltech respectfully asks the Court to reject Defendants' recent tactic of filing material *in camera* such that Caltech cannot provide a substantive response, and deny Defendants' motion.

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II. ARGUMENT

A. Defendants' *In Camera* Filing Was Improper

There is no dispute that Defendants bear the burden of proving that disqualification of Dr. Shoemake is proper. *Stencel v. Fairchild Corp.*, 174 F. Supp. 2d 1080, 1083 (C.D. Cal. 2001). Unable to meet this burden, Defendants instead resort to improperly filing material *in camera*, thereby depriving Caltech of its right to respond.

It is a fundamental tenet of our judicial system that "[a] party in civil litigation cannot put the contents of a document at issue and ask the Court to consider the contents of that document in deciding an issue on the merits while at the same time shielding its adversary from also considering the contents of that document. ***Litigating a case in that fashion is inconsistent with both the adversary system and due process***." *Apple Inc. v. Samsung Elecs. Co.*, No. 11-CV-01846-LHK, 2015 WL 3863249, at *12 (N.D. Cal. June 19, 2015)(emphasis added). Indeed, Defendants themselves concede that this is the law. (Defs. Supp. Submission at p. 3). For example, in *Oracle Am., Inc. v. Innovative Tech. Distribs., LLC*, Oracle moved to disqualify certain of ITD's counsel and requested permission to submit privileged documents in support of its motion for *in camera* review. No. 11-CV-01043-LHK, 2011 WL 2559825, at *1-2 (N.D. Cal. June 28, 2011). The court flatly rejected Oracle's request, holding emphatically that "[i]f Oracle wants the Court to consider the documents it considers privileged in connection with the disqualification motion, then Oracle cannot, at the same time, deny ITD access to the same materials. . . . Otherwise, Oracle would obtain the ***improper advantage*** of using the privileged documents as both shield and sword." *Id.* at *2 (emphasis added).

Under the controlling law, Defendants in this case should not be permitted to rely on information submitted *in camera* in support of their disqualification motion. As an initial matter, Defendants violated the local rules because they did not even

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request permission to submit information *in camera*. Local Rule 79-6.2 states that "No document may be presented for review *in camera* without prior approval of the Court." Defendants neither sought nor obtained prior approval. Although the Court indicated at the hearing that it would [redacted] the Court did not give Defendants authorization to file anything *in camera*, and certainly did not order Defendants to do so. (Apr. 20, 2017 Hearing Tr. at p. 31; Defs. Supp. Submission at p. 4)(emphasis added). Thus, the portions of Defendants supplemental submission submitted *in camera* should not be considered by the Court. *See generally Reed v. NBTY, Inc.,* No. EDCV130142JGBOPX, 2014 WL 12284044, at *2, fn. 5 (C.D. Cal. Nov. 18, 2014) ("Plaintiffs did not attempt to comply with the rules for filing documents under seal. The Court therefore does not consider the chambers copy of the unredacted opposition.")

Defendants have also failed to comply with the Local Rules because they have not described the general nature of the information, or established "why it should be reviewed *in camera*, citing the applicable legal standard." Local Rule 79-6.2. To the contrary, the legal authority cited by Defendants establishes that the information should not be admitted *in camera*. Moreover, it appears likely that the information submitted *in camera* by Defendants is not even privileged. The Declaration of James Dowd filed with Defendants' supplemental submission includes the following as exhibits: (1) Dr. Shoemake's expert report from the *Wi-LAN 2* case, (2) his witness statement from the *Ericsson* case, and (3) ten documents that were produced by Broadcom in the *Wi-LAN 1* case. (Dkt. 172-1). Based on their descriptions, none of those documents can possibly be privileged, yet Defendants filed them *in camera* and did not provide copies to Caltech. And considering that Defendants' attorneys in this case did not represent Broadcom in

the *Wi-LAN 1* case, or Apple in the *Ericsson* case, it is unlikely that anything in Defendants' supplemental submission is privileged.[2] Rather than legitimately seeking to protect privilege, it appears that Defendants' *in camera* submission is merely an attempt to prejudice Caltech by improperly withholding the very information that Defendants' contend supports their motion.

Even if Defendants' supplemental submission contains privileged information, the Court nevertheless should disregard it. "In camera review is generally disfavored, as it prevents any other party in the litigation from seeing the materials produced to the court." *S.P.E.P. Acquisition Corp. v. Douglas Trailer Supply Co.*, LLC, No. 13-cv-09237 (C.D. Cal. Feb. 18, 2014). As in *Oracle*, by moving to disqualify Dr. Shoemake, Defendants have taken the affirmative act of placing privileged information from their prior cases at issue here. If Defendants now wish to rely on such information, they were required produce it to Caltech so Caltech could respond. *See Oracle Am., Inc.*, No. 11-CV-01043-LHK, 2011 WL 2559825, at *2.

B. Defendants' Arguments About The Scope Of Discovery Are Incorrect And Irrelevant

Rather than meeting their burden of showing specific and unambiguous disclosures that, if revealed, would prejudice Defendants in this case, Defendants instead attempt to manufacture a relationship between their prior cases and the present case by mischaracterizing Caltech's discovery requests. Defendants argue that Dr. Shoemake's prior work is relevant because Caltech has supposedly sought discovery of all aspects of the accused Wi-Fi chips, and not just those aspects

[2] Because Defendants did not submit any substantive declarations with their supplemental submission, it would appear that Defendants have failed to provide evidence of any attorney work product or privileged information from their prior cases that is relevant to the current case. Mere attorney argument in their supplemental submission is not evidence.

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relating to error correction codes. Defendants also argued at the April 20 hearing [redacted] Neither of these assertions is correct.

First, correspondence between the parties makes clear that Caltech has focused discovery on documents relating to the accused LDPC error correction coding functionality. For example, in an October 28, 2016 letter Caltech emphasized that it is focused on [redacted] (Oct. 28, 2016 Briggs Ltr., Shyr Decl. Ex. 11) (emphasis added). Likewise, during a meet and confer earlier this year, Caltech confirmed that its request for documents [redacted] (Feb. 21, 2017 Dowd Ltr., Shyr Decl. Ex. 12.) Although Caltech's requests may refer generally to the accused Wi-Fi chips, Defendants are simply incorrect in asserting that Caltech seeks discovery about "all aspects of 802.11n and 802.11ac, including not only error correcting codes, but the complete set of features defined by the 802.11n and 802.11ac standards." (Defs. Supp. Submission at p. 2).

Second, contrary to Defendants' representations about source code, Caltech has consistently made clear that it is only interested in source code relating to the accused error correction coding functionality. In October 2016, Caltech emphasized its need for [redacted] Shyr Decl. Ex. 11. Defendants own statements to this Court show that they plainly understood Caltech was focused on the LDPC coding functionality, as Defendants expressly represented to the Court in December that "[t]he amount of code that's at issue in this case is actually quite discrete. . . . [W]e're talking about a very small portion of the chip

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and, correspondingly, a very small portion of the source code." (Dec. 28, 2015 Hearing Tr. at p. 8). When the Court ordered Defendants to produce relevant source code last year, Defendants produced only the code relating to the accused functionality, and Caltech never took issue with the narrow scope of that production. To the contrary, it was only after [redacted] (Jan. 28, 2017 Hammon Email, Shyr Decl. Ex. 13). Thus, to the extent that Defendants have produced [redacted] Caltech never asked for that production, nor has anyone associated with Caltech ever even looked at that additional code.[3] Defendants current characterizations to this Court are inaccurate at best, and appear to be affirmatively misleading.

Defendants' arguments about Caltech's email discovery requests are similarly misleading. (Defs. Supp. Submission at p. 2). Caltech identified "802.11*" as a search term in connection with custodians whose work is specifically focused on the accused error correction coding. For example, Andrew Blanksby's LinkedIn page states that he led "development of Low-Density Parity-Check (LDPC) technology for WLAN used in all major smart phones, tablets, and access points by companies such as Apple, Samsung, and LG." (Shyr Decl. Ex. 14). Thus, it is reasonable for Caltech to expect that these custodians' emails will inherently be focused on error correction coding, as opposed to other aspects of 802.11. These requests by Caltech do not somehow make anything that Dr. Shoemake did in any prior cases relevant to the current case.

[3] Defendants inaccurately asserted at the April 20th hearing that Defendants [redacted] (*See* Apr. 20, 2017 Hearing Tr. at p. 29).

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Defendants also incorrectly argue that information from their prior cases is relevant because Caltech is required to apportion the value attributable to the claimed inventions for damages purposes. (Defs. Supp. Submission at pp. 2-3). This argument is a strawman. The law does not require Caltech to apportion the value of the patents by analyzing each of the features of Defendants' chips. Apportionment can be done in many ways, including by looking at comparable licenses. *See Commonwealth Scientific and Industrial Research Organization v Cisco*, 809 F.3d 1295, 1303-04 (Fed. Cir. 2015) (finding that "comparable license valuations . . . may be the most effective method of estimating the asserted patent's value"). But even if Caltech were to apportion by isolating the value of the accused error correction coding functionality, that analysis would involve a damages expert (not Dr. Shoemake) ***excluding*** from the royalty base the features in the chip other than accused error correction coding. In other words, those other features would be excluded because they are not relevant. Moreover, Defendants' assertions involve rank speculation, and there is no reason to believe that any apportionment analysis on damages issues would involve any of the information from the *Wi-LAN* cases, let alone any information that is confidential. For example, contrary to Defendants' assertions at the April 20 hearing, there is no indication at all in Dr. Shoemake's *Wi-LAN 1* report that he [redacted] (Apr. 20, 2017 Hearing Tr. at 13:20-14:8.) [redacted] (Dkt. 105-1 (Thompson Decl. Ex. A) at ¶¶ 19-20).

C. Defendants' Prior Cases Did Not Involve Error Correction Coding

Caltech's patents in the present case involve a specific and novel form of error correction codes. In opposing Defendants' motion, Caltech demonstrated that Defendants had failed to identify any confidential information that they previously shared with Dr. Shoemake relating to error correction coding. (Dkt. 154, Opposition

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Br. at 12-15). In fact, [redacted] The only confidential information that Defendants even alleged in their opening brief had been provided to Dr. Shoemake was some technical information that was purportedly shared by Broadcom during the *Wi-LAN 1* case, over six years ago. (Dkt. 103 at 11-12). Defendants provided no evidence, however, that the technical information available to Dr. Shoemake in the *Wi-LAN 1* case was confidential, or that it had any relevance to the present case.

Having failed to satisfy their burden in the moving papers, Defendants submitted seven ***new*** exhibits from the *Wi-LAN 1* case with their reply brief that pertain generally to 802.11n. (Dkt. 164-2 to 8). These new Exhibits were not only improperly submitted as part of Defendants' reply brief, but they also failed to demonstrate that Dr. Shoemake previously received confidential information that is relevant to the present case.[4] Of the seven new exhibits submitted with Defendants' Reply brief, Defendants only argued that two of them [redacted] (Dkt. 164-7 and 8, Reply at 2-3 and 6-7). But, as Caltech demonstrated at the April 20 hearing, [redacted] (Caltech's Apr. 20, 2017 Hearing Presentation Slides, Shyr Decl. Ex. 9 at 8-12).

After twice failing to identify any relevant, confidential information, Defendants have now submitted additional purported "evidence" that they have improperly shielded from Caltech. Despite having been deprived of the ability to fully respond to the substance of Defendants' submission, Caltech is confident that Defendants have not "point[ed] to specific and unambiguous disclosures that if revealed would prejudice" Defendants in this case. *Hewlett-Packard Co. v. EMC*

[4] Defendants even refused to allow Dr. Shoemake to see their Reply Brief in a transparent effort to prejudice Caltech's ability to respond at the hearing to the new (footnote continued)

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Corp., 330 F. Supp. 2d 1087, 1094 (N.D. Cal. 2004). The simple fact is that [redacted]

1. *Wi-LAN 1* and *Wi-LAN 2*

Ten of the new exhibits that Defendants submitted with their supplemental submission are documents that Broadcom apparently produced in the *Wi-LAN 1* case. (Dkt. 172-1). Caltech has not had an opportunity to review these documents, but from their descriptions in the Dowd Declaration, they appear to be more of the same type of information submitted with Defendants prior briefs, which was plainly insufficient to carry Defendants' burden.

As is clear from his expert report cited in Defendants' moving papers, Dr. Shoemake's work in the *Wi-LAN 1* case was focused on [redacted] (*See* Dkt. 105-1). The *Wi-LAN 2* case involved the [redacted] but Dr. Shoemake's work for Apple in *Wi-LAN 2* was limited to [redacted] Shoemake Decl. at ¶ 38.

The '222 patent in the *Wi-LAN* cases was filed on March 31, 1992, issued on January 25, 1994, and describes systems and methods for performing a type of differential modulation that avoids the need for clock or carrier offset recovery. (*Id.* at ¶¶ 30-32). The '222 patent in the *Wi-LAN 1* case has nothing to do with error correction coding. (*Id.*). (Dkt. 105-1 at p. 29). The '222 patent relates to a form of differential signal modulation that eliminated the need for carrier offset recovery. Carrier offset recovery has to do with automatically tuning to the correct channel

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evidence and arguments that Defendants had submitted. (Apr. 19, 2017 Thompson Email, Shyr Decl. Ex. 10).

[5] Broadcom was not involved in *Wi-LAN 2*.

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and has no relationship to error correction coding. Shoemake Decl. at ¶¶ 30-32. Dr. Shoemake's report in the *Wi-LAN 1* case focused on [redacted] (Dkt. 105-1 at pp. 59-130).

None of Dr. Shoemake's work in the *Wi-LAN 1* case involved [redacted] (Shoemake Decl. at ¶ 32). Dr. Shoemake never [redacted] (*Id.*) In fact, Dr. Shoemake stated in his declaration that he does not [redacted] (*Id.*). The accused IRA codes were not a part of the 802.11 standard until the 802.11n amendment was adopted in 2008.

Based on their descriptions, the documents provided with Defendants' supplemental submission appear to relate to 802.11n and to certain Broadcom Wi-Fi chips, such as the BCM4318, 4329, 4321 and 4331. It is not surprising, however, that Dr. Shoemake would have had access to this information. [redacted] LDPC codes were not part of 802.11a or 802.11g. And because 802.11n was relatively new at that time, and LDPC codes were an optional part of 802.11n, many early 802.11n products did not use LDPC codes. For example, Defendants submitted a document with their reply brief concerning [redacted] (Dkt. 164-4 at BCM1093510). In any event, [redacted] the scope of Dr. Shoemake's engagement in *Wi-LAN 1* did not encompass such issues nor can Defendants meet their burdens of confidentiality or prejudice.

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For example, even if the documents cited by Defendants, or similar materials, were somehow relevant to this case (which they are not), Defendants would be required to produce them during discovery. Thus, these documents cannot support a claim of prejudice because, if relevant, Caltech should already have access to the documents. *See Twin City Fire Ins. Co. v. Mitsubishi Motors Credit of Am., Inc.*, No. 04-0043, 2006 WL 5164249, at *4 (C.D. Cal. Nov. 6, 2006) ("Only the disclosure of confidential information that the opposing party would be unable to obtain through discovery should form a basis for disqualification of an expert witness."); *Finisar Corp. v. Nistica, Inc.*, No. 13-cv-03345, 2015 U.S. Dist. LEXIS 94975 at *28 (N.D. Cal. July 15, 2015) ("'technical information as opposed to legal advice is not considered confidential for the purpose of this analysis.'"). Notably, Defendants do not appear to have produced any of the cited documents in this case.

The bottom line is that Dr. Shoemake's work on the *Wi-LAN* cases took place over six years ago and involved numerous Defendants [redacted] Dr. Shoemake did not [redacted] in those cases that involved Dr. Shoemake gaining access to information of "particular significance or [that] can readily be identified as either attorney work product or within the scope of the attorney-client privilege." *Hewlett-Packard*, 330 F. Supp. 2d at 1094. [redacted] And Defendants have not pointed to a single piece of evidence that any Broadcom or Apple attorney ever even spoke with Dr. Shoemake in connection with those cases.

2. *Ericsson*

Defendants also appear to have cited to portions of the sealed ITC hearing transcript from the *Ericsson* case. As previously established, however, [redacted]

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[redacted] The patents describe an "enhanced radio telephone [that] can selectively operate as either a conventional radio telephone or as an improved IP telephone." (U.S. Patent No. 6,157,620, Shyr Decl. Ex. 16 at 2:2-4.) Thus, the patents did not have anything to do with Wi-Fi technology and neither patent even mentions 802.11, Wi-Fi, error correction codes, LDPC codes, or IRA codes.

Furthermore, anything that Dr. Shoemake may have testified about at the ITC hearing "undermines [Defendants'] claim of a confidential relationship, since testifying experts must reveal the underlying sources relied upon in reaching their conclusions at deposition and on cross examination." *Stencel*, 174 F. Supp. 2d at 1084; *see also Broadcom v. Qualcomm*, No. 05-467, Dkt. 1600, at 2 (C.D. Cal. Jan. 9, 2009). Certainly, Dr. Shoemake's testimony at the ITC hearing did not involve matters that were privileged or attorney work product. And given the lack of similarity in subject matter, there is no reason to believe that the testimony is of significance to the present case. Indeed, the most that Defendants have ever said about the *Ericsson* case (in any of the briefs that Caltech has been able to see) is that the *Ericsson* case involved [redacted] (Dkt. 105-10 at 4). This district squarely rejected such an overly broad relatedness argument when it was advanced by Broadcom in the *Qualcomm* case. *See Broadcom*, No. 05-467, Dkt. 1600, at 2 ("While the '051 Patent and the Agere Litigation Patents all deal with telecommunications, there is virtually no substantive overlap with the Agere Litigation Patents."). The Northern District similarly flatly reject such a field of use argument. *Life Techs. Corp. v. Biosearch Techs., Inc.* No. C-12-00852 WHA JCS, 2012 WL 1604710, at *7 (N.D. Cal. May 7, 2012) (rejecting movant's argument that both cases "exist in the same field" and finding that "such a superficial similarity, without more" did not support disqualification.)

III. CONCLUSION

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For the foregoing reasons, Caltech respectfully requests that the Court refuse to consider Defendants' *in camera* submission and deny Defendants' motion to disqualify Dr. Shoemake. In the alternative, if the Court wishes to give any further consideration to Defendants' submission, Caltech respectfully requests that it be provided access to that submission and a further opportunity to respond.

DATED: April 27, 2017

Respectfully submitted,

By */s/ James R. Asperger*

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