

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

**CERTAIN INTEGRATED CIRCUIT
CHIPS AND PRODUCTS CONTAINING
THE SAME**

Inv. No. 337-TA-859

**ORDER NO. 19: GRANTING RESPONDENTS' MOTION TO STRIKE UNTIMELY
SUPPLEMENTAL INTERROGATORY RESPONSE AND
DENYING REALTEK'S MOTION TO FILE RESPONSE OUT OF
TIME**

(May 9, 2013)

On April 3, 2013, Respondents LSI Corporation and Seagate Technology ("Respondents") filed a motion to strike Complainant Realtek Semiconductor Corporation's ("Realtek") supplemental response to Interrogatory No. 25. (Motion Docket No. 859-016) Respondents certified that pursuant to Ground Rule 3.2, at least two business days prior to the filing of this motion, Respondents made reasonable, good-faith efforts to contact the other parties to resolve the matter and notified all other parties in advance of the filing of the motion. Respondents also certified that it complied with Ground Rule 3.5.¹

On April 15, 2013, Realtek filed an untimely opposition to Respondents' motion. On April 16, 2013, Realtek filed a motion seeking permission to submit its response to Respondents' motion out of time by one day. (Motion Docket No. 859-018) Realtek says it contacted Respondents pursuant to Ground Rule 3.2 at 5:30 pm on April 15, 2013. Realtek said

¹ Respondents' motion provides details regarding its good faith efforts to resolve this discovery dispute as required by Ground Rule 3.5. (Mot. at 2-3)

Respondents would waive the two day notice requirement and take no position regarding its motion.

I. Parties' Positions

Respondents Position: On November 27, 2012, Respondents say that LSI served Realtek with Interrogatory No. 25 seeking information about the conception and reduction to practice of the invention claimed by asserted U.S. Patent No. 6,787,928 ("the '928 patent"). (Citing Respondent LSI Corporations' First Set of Interrogatories to Complainant Realtek Semiconductor Corporation at 13) On December 7, 2012, Respondents state that Realtek served its first "response" to Interrogatory No. 25, treating it as a contention interrogatory. (Citing Complainant Realtek Semiconductor Corporation's Objections and Responses to Respondent LSI Corporation's First Set of Interrogatories (No. 1-54) at 32-33) Respondents say that Realtek provided no substantive information. Following a list of boilerplate objections, Respondents say that Realtek merely stated that it would "provide responsive, nonprivileged information at such time that a response is required as per the Procedural Schedule in this Investigation."

On February 15, 2013, Respondents say that on a discovery committee call, Realtek stated that it was not aware of any documents indicating dates of conception and reduction to practice earlier than February 26, 2003, which is the filing date of the Taiwanese counterpart application for the asserted '928 patent. (Citing Declaration of Max Ciccarelli (April 3, 2013)) On February 19, 2013, the date set forth in the Procedural Schedule for responding to contention interrogatories, Respondents state that Realtek provided a first supplemental response to Interrogatory No. 25 confirming that "[c]onception and reduction to practice of the invention claimed in the '928 patent occurred at least as early as February 26, 2003." (Citing Complainant Realtek Semiconductor Corporation's First Supplemental Objections and Responses to

Respondent LSI Corporation's First Set of Interrogatories (Nos. 1-54)) On March 1, 2013, Respondents aver that Realtek filed second supplemental interrogatory responses, but did not further supplement its response to Interrogatory No. 25.

On March 12, 2013, at 9:30 pm, Respondents say that Realtek served a third supplemental response to Interrogatory No. 25. (Citing Email from Sue Shin (counsel for Realtek) to Respondents (Mar. 12, 2013) serving Realtek's Third Supplemental Responses) Respondents assert that, earlier that evening, the parties had conferred in a discovery-committee call during which they discussed several issues related to the deposition of Mr. Ying-His Lin, the named inventor of the '928 patent. (Citing Ciccarelli Decl. ¶ 5) Respondents aver that the deposition was scheduled for the following morning and that Mr. Lin was Realtek's 30(b)(6) corporate representative. Respondents assert that the topics to be covered by Mr. Lin included "the conception of the subject matter described in the Realtek Patent" and the "reduction to practice of the subject matter described in the Realtek Patent." (Citing Respondents' Notice of Intent to Take Deposition Upon Oral Examination of Realtek, Topics 46 and 47) Respondents say Realtek refused to state whether any of the roughly 70,000 pages of documents it had produced the day before Mr. Lin's deposition were relevant to the deposition. Respondents also say that Realtek never stated its intention to supplement its response to Interrogatory No. 25 later that evening with new alleged dates of conception and reduction to practice. (Citing Ciccarelli Decl. ¶ 5)

Respondents say the third supplemental response to Interrogatory No. 25 asserted for the first time a date of conception of August 2000 (two years and six months earlier than its prior assertion) and a date of reduction to practice of June 5, 2001 (one year and 8 months earlier than its prior assertion). (Citing Complainant Realtek Semiconductor Corporation's Third

Supplemental Objections and Responses to Respondent LSI Corporation's First Set of Interrogatories (Nos. 1-54) at 37-39) Respondents state that the third supplemental response also identified documents as evidence of conception and reduction to practice. (Realtek's Third Supplemental Responses at 38)

Respondents argue that Realtek's new contentions are based on information that was in its possession and accessible before the deadline for serving responses to contention interrogatories. Respondents aver that Mr. Lin is not only the named inventor on the '928 patent, but he is also Realtek's Vice President of Research and Development, where he has worked in various roles since 1999. (Citing Lin Deposition (Mar. 13, 2013) at 11:11-13:19) Respondents say that they learned during Mr. Lin's deposition that Realtek had the documents cited in the supplemental response to Interrogatory No. 25 before February 19, when it served its first substantive responses to Respondents' contention interrogatories. For example, Respondents state that Mr. Lin testified that Realtek has had one of the documents cited in its supplemental response (a design-rule document from Taiwan Semiconductor Manufacturing Company "TSMC") since November 2012 and that it was requested from TSMC for purposes of this investigation. (Lin Dep. at 77:19-80:9) Realtek avers that the other documents cited in Realtek's supplemental response bear dates showing when they were printed out by Realtek, confirming that they have been in Realtek's possession well before February 19. (Citing *id.* at 82:11-83:3, 86:1-7, 72:16-22; REAINV85900011888; REAINV85900012261; REAINV85900011883)

Respondents further argue that Realtek is withholding a document in its possession that is directly responsive to Interrogatory No. 25, and that contradicts Realtek's claimed conception date. Respondents say that during Mr. Lin's deposition, they asked him whether he had prepared

an invention-disclosure statement related to the '928 patent. (Citing Lin Dep. at 46:25-47:3) Respondent say that Mr. Lin testified that he had submitted one to Realtek's legal department on September 27, 2002 for the purpose of informing the company that he had an invention. (Citing *id.* at 91:11-92:6, 92:24-93:16, 97:15-19; 120:4-14) Respondents aver that after a break, Realtek produced the invention-disclosure statement.

Respondents argue that Commission Rule 210.27(c) governs the supplementation of discovery responses. Respondents assert that the rule does not allow parties to supplement their responses indiscriminately, but only contemplates supplemental discovery responses when new information is learned after the applicable discovery response is served that would make the original response incomplete or incorrect in some way. (Citing *Certain Starter Motors and Alternators*, Inv. No. 337-TA-755, Order No. 25, 2011 ITC LEXIS 1772, at *8 (Aug. 23, 2011)) Respondents contend that when a party has access to information before responding to discovery, it cannot later use that information to change or supplement its responses. Respondents argue that this is especially true in cases where the complainant attempts to supplement with information that was accessible to it before it filed the complaint. (Citing *id.* at *11; *Certain Printing and Imaging Devices*, Inv. No. 337-TA-690, Order No. 20 (Mar. 31, 2010); *Certain Projectors with Controlled-Angle Optical Retarders*, Inv. No. 337-TA-815, Order No. 22 (Oct. 15, 2012)) Respondents assert that I made the rule clear on supplementing contention interrogatories during the preliminary hearing in this Investigation.

Respondents argue that the information upon which Realtek relies to support its new contentions was in its possession and accessible even before it filed the Complaint in this Investigation. As such, Respondents assert that Realtek's new contentions regarding conception and reduction to practice of the invention claimed by the '928 patent should be struck as

untimely, and Realtek should be barred from asserting that conception and reduction to practice occurred any earlier than February 26, 2003.

Realtek's Position: Pursuant to 19 C.F.R. § 210.15, Realtek filed a motion seeking permission to submit its opposition out of time by one day. Realtek states that it began the process of filing its response at around 4:50 pm, "well before" the 5:15 pm filing deadline. (Citing Rothschild Decl. at ¶ 2) Realtek says that during the filing process, some of the appendices received errors though EDIS and could not be successfully uploaded until being reformatted, which caused an unexpected delay in the filing process. Realtek states that they completed the filing at 5:17 pm, which rendered the filing date April 15, 2013. Realtek avers that all parties were timely served with the motion. Realtek asserts that, upon realizing that the motion had not been filed until two minutes after the 5:15 pm deadline, it contacted Respondents and explained that technical issues caused the filing delay. Realtek says Respondents indicated that they neither oppose nor join its motion.

Realtek argues that no party will experience any prejudice in granting this motion because Respondents were timely served. Realtek contends that motions for leave to grant modest requests under similar circumstances have been granted in previous investigations. (Citing *Certain Electronic Imaging Devices*, Inv. No. 337-TA-726, Order No. 21 (granting motion for leave to file summary determination one business day late); *Certain Rubber Resins and Processes for Manufacturing Same*, Inv. No. 337-TA-849, Order No. 40 (granting motion for leave to file objections to proposed exhibits out of time))

In its opposition, Realtek argues that it "seasonably" supplemented its February 19, 2013 interrogatory response regarding the conception and reduction to practice dates for the inventions of the '928 patent. Realtek asserts that, based on information acquired after February 19, 2013,

through the restoration and review of archived chip database information, Realtek supplemented its response to identify a conception date “at least as early as August 2000” and a reduction to practice date “at least as early as June 5, 2001.” Realtek contends that the restoration and review process was time-intensive, involving the restoration and inspection of 200 to 300 individual chips in order to locate the test chip related to the inventions of the ‘928 patent. Realtek asserts that the process was not completed until shortly before the deposition of the inventor of the ‘928 patent, Y.H. Lin, held March 13, 2013. Realtek argues that its restored database information is “information thereafter acquired” under Commission Rule 210.27(c) because it was not readily available at the time Realtek served its original response on February 19, 2013. Realtek continues that its March 12, 2013 supplemental response has not prejudiced Respondents.

II. Analysis

As a threshold matter, I deny Realtek’s motion to file its response out of time by one day. At the initial prehearing conference, I emphasized Ground Rule 1.8, which requires that any request for an extension of time must be made by written motion no later than the day before the due date and that good cause must be established. I highlighted:

That means if you file something at 5:14 in the afternoon and realize that, A, something went wrong and it didn’t get filed or, B, the Secretary rejected it and you come in the next day and ask for an extension of time, you will not get it. That is not good cause. That’s you being late.

(Initial Prehearing Conf. Tr. at 12:23-13:12 (Nov. 13, 2012)) Thus, I find Realtek’s excuse of a technical error unpersuasive, and I find that it has waived its arguments opposing Respondents’ motion.

When a party responds to discovery requests, including contention interrogatories, it is required to provide complete and truthful responses. An attorney of record is required to sign the responses, and that signature “constitutes a certification that to the best of the signor’s

knowledge, information and belief formed after a reasonable inquiry, the ... response is” consistent with “other relevant provisions of this chapter” which includes, *inter alia*, 19 CFR § 210.29(b)(2), which requires that a party responding to interrogatories shall do so under oath. 19 CFR § 210.27(d)(2).

If the foregoing requirements are met, a situation does not arise to justify changing one’s discovery response, except as required by Commission Rule 210.27(c), which states:

(c) Supplementation of Responses.

(1) A party who has responded to a request for discovery with a response is ***under a duty to supplement or correct the response to include information thereafter acquired*** if ordered by the administrative law judge or the Commission or in the following circumstances: A party is under a duty ***seasonably*** to amend a prior response to an interrogatory, request for production, or request for admission if the party learns that the response is in some material respect incomplete or incorrect and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.

(2) A duty to supplement responses also may be imposed by agreement of the parties, or at any time prior to a hearing through new requests for supplementation of prior responses.

19 CFR § 210.27(c) (emphasis added).

To allow a party to change discovery responses as it wishes without the addition of “information thereafter acquired,” as provided for in Commission Rule 210.27(c), would render verified discovery responses meaningless. Hence, I conclude that Rule 210.27(c) not only prescribes a duty to supplement or correct discovery responses, it provides the rationale to limit a party’s ability to abandon or alter its previously verified response(s). In this case, as detailed below, I find that Realtek’s supplementations were either not based on information thereafter acquired, or were not made seasonably after the information was acquired.

I made the rule on supplementing contention interrogatories abundantly clear during the initial prehearing conference in this Investigation:

Now, make no mistake that once you have responded to the contention interrogatories, you are not going to be allowed to change it at your own whim. I expect that what you provide in your discovery responses, you are certifying it to be true and correct, and that includes your contentions. So halfway through this thing, don't expect that I am going to allow you to change your contentions, unless there is something that came up that you had no way of knowing about and changes something in your case dramatically.

(Initial Prehearing Conf. Tr. at 7:24-8:11)

Interrogatory No. 25 seeks information about the conception and reduction to practice of the invention claimed in the '928 patent:

Describe in detail the circumstances relating to the alleged inventions that resulted in the Realtek Patents. To be complete, your response should, by way of example and not limitation, address the circumstances relating to the conception, including the earliest conception date of each of the alleged inventions; the first reduction to practice (whether actual or constructive); the documents you rely on as evidence of conception and reduction to practice; all diligence in reducing to practice the alleged inventions; and the person who were involved in the conception and reduction to practice of the claimed inventions including, but not limited to, all individuals who directly supervised or had knowledge of the conception or reduction to practice of the inventions.

(Mot. Ex. 3 at 13 (emphasis added)) The procedural schedule in this Investigation set February 19, 2013 as the deadline for the parties to serve responses to contention interrogatories on the issues for which the party bears the burden. *See* Order No. 5. On that date, Realtek filed a first supplemental response to Interrogatory No. 25, indicating that “[c]onception and reduction to practice of the invention claimed in the ‘928 patent occurred at least as early as February 26, 2003.” (Mot. Ex. 5 at 36) Realtek did not assert that any relevant information is privileged. (*Id.*)

On March 12, 2013, Realtek provided a third supplemental response to Interrogatory No. 25, which stated, *inter alia*:

Conception of the invention claimed in the '928 Patent occurred at least as early as August 2000. The invention was actually reduced to practice at least as early as July 5, 2001. Realtek relies on the following documents as evidence of conception and reduction to practice: REAINV85900011883 – REAINV85900012261. Ying-Shi Lin was involved in the conception and reduction to practice of the invention claimed in the '928 Patent.

(Mot. Ex. 6 at 37-39) Realtek argues that this supplemental response was necessitated because it had to restore and review archived chip database information in order to locate the test chip related to the inventions of the '928 patent. Realtek asserts that the process was time-intensive. (Realtek Opp. at 1)

Even if Realtek's arguments were not waived, I would still find them unpersuasive. Realtek should have performed its "restoration and review" of archived chip data information before the deadline for responses to contention interrogatories for issues for which the party bears the burden on February 19, 2013. Realtek did not "seasonably" amend its contention interrogatory responses. Rather, Realtek's new contentions are based on information that was in its possession far in advance of the deadline for serving responses to contention interrogatories, as confirmed by the deposition testimony of Mr. Lin, Realtek's Vice President of Research and Development. (Lin Dep. Tr. 11:11-13:19) Mr. Lin testified that he had one of the documents cited in Realtek's supplemental response since November 2012. (Lin Dep. Tr. 77:19-80:9) Other documents cited in Realtek's supplemental response to Interrogatory No. 25 bear dates showing that they have been in Realtek's possession as early as July 2008. (*Id.* at 82:11-83:3; 86:1-7)

The information Realtek learned through its restoration and review is not "information thereafter acquired" contemplated by Commission Rule 210.27(c), because Realtek had access to the information before responding to Interrogatory No. 25, and has had access since prior to the start of this investigation. *Certain Starter Motors and Alternators*, Inv. No. 337-TA-755, Order

No. 25 (Aug. 23, 2011). Realtek could have, and should have, provided its conception and reduction to practice dates in its first response to Interrogatory No. 25 on December 7, 2012, and at the very least, by the contention interrogatory response deadline of February 19, 2013.

Based upon the foregoing, Realtek's third supplemental response to Respondents' Interrogatory No. 25 is stricken. Realtek is barred from asserting that conception and reduction to practice occurred any earlier than February 26, 2003, the date provided in its February 19, 2013 response. Realtek shall not be permitted to advance any argument first disclosed in, or to rely upon any documents first cited in its third supplemental response to Interrogatory No. 25.

ORDER

Motion Docket No. 859-016 is hereby GRANTED. Realtek's third supplemental response to Interrogatory No. 25 is stricken. Realtek is bound by its February 19, 2013 response to Respondents' Interrogatory No. 25, and shall not be permitted to advance any argument first disclosed in, or to rely upon any documents first cited in its third supplemental response to Interrogatory No. 25. Motion Docket No. 859-018 is DENIED.

SO ORDERED.



Robert K. Rogers, Jr.
Administrative Law Judge

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PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **ORDER** was served upon the following parties via first class mail delivery on MAY 10 2013



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