

**PUBLIC VERSION**

**UNITED STATES INTERNATIONAL TRADE COMMISSION**

**Washington, D.C.**

**In the Matter of**

**CERTAIN TELEVISION SETS,  
TELEVISION RECEIVERS,  
TELEVISION TUNERS, AND  
COMPONENTS THEREOF**

**Inv. No. 337-TA-910**

**ORDER NO. 37: GRANTING-IN-PART COMPLAINANT'S MOTION TO STRIKE**

(November 28, 2014)

On September 4, 2014, Complainant CrestaTech Technology ("CrestaTech") filed a motion to strike certain paragraphs of the Opening Expert Report of Dr. Hossein Hashemi Regarding Invalidity of U.S. Patent No. 7,075,585 and U.S. Patent No. 7,265,792 (the "Patents-in-Suit"). (Motion Docket No. 910-030.) On September 15, 2014, Respondents MaxLinear, Inc., Sharp Corporation, Sharp Electronics Corporation, VIZIO, Inc., TPV International (USA), Inc., Top Victory Investments Ltd., SIO International, Inc., Hon Hai Precision Industry Co., Ltd., Wistron Corp., and Wistron Infocomm Technology (America) (collectively, "Respondents") filed their opposition to CrestaTech's motion. On September 22, 2014, CrestaTech filed a motion for leave to reply in support of its motion. (Motion Docket No. 910-033.) On September 24, 2014, Respondents filed their opposition to CrestaTech's motion for leave to reply. CrestaTech's motion for leave to reply is hereby GRANTED. CrestaTech avers that it has made reasonable, good faith efforts to resolve this matter with Respondents at least two business days in advance of filing this motion.

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### **I. POSITIONS OF THE PARTIES**

#### **A. CrestaTech's Motion**

CrestaTech argues that the Hashemi Report contains 18 references that were not previously disclosed in support of Dr. Hashemi's opinion that the Patents-in-Suit are invalid. (Mot. at 1-2.) CrestaTech argues that because these new references were not disclosed before the close of fact discovery, they were untimely and should be stricken. (*Id.* at 2.) CrestaTech also argues that Respondents agreed to reduce the number of asserted prior art references, and that the inclusion of these new references violates that agreement. (*Id.* at 3-4.) CrestaTech argues that the Hashemi Report also purports to incorporate by reference all of the putative prior art references contained in Respondents' Notices of Prior Art, and is therefore not limited to the references actually charted by Respondents in their invalidity contentions. CrestaTech argues that the additional references are improper and prejudicial. (*Id.* at 6-7.)

#### **B. Respondents' Opposition**

Respondents first argue that CrestaTech has failed to make good faith efforts to meet and confer due to a failure to acknowledge issues raised during a discussion between the parties held on September 4, 2014. (Opp. at 2.)

Respondents admit that the Mitola '95, Efstathiou '99, and Python '05 references are not included in their Notice of Prior Art and that Dr. Hashemi will not rely on those references. (*Id.* at 3 n.1.)

Respondents argue that three of the references (Mitra '01, Razavi '97, and Oppenheim'97) were disclosed in the invalidity charts or as evidence of level of skill in the art in their invalidity contentions, and that Dr. Hashemi did not take the position that these references anticipate the asserted claims. (*Id.* at 4-5.) Respondents argue that these references instead were

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relied upon only for the purposes of obviousness and level of skill in the art and that they should therefore not be stricken. (*Id.* at 5-6.) Respondents also argue that the Yoshida '01 reference should not be stricken because it was contained within a book that was included in their invalidity contentions as a reference that anticipates and/or renders the asserted claims obvious. (*Id.* at 6.) Respondents assert that this book was also included within their notice of prior art. (*Id.* at 7.)

Respondents next argue at length about the relevance of the Xcieve demonstration to ██████ to the 102(b) on-sale bar. (*Id.* at 8-10.) Respondents also argue that Xcieve's demonstration to ██████ was the subject of a motion to amend their notice of prior art and was contained in an updated invalidity chart. (*Id.* at 7-8.) Respondents argue that they did not know about the ██████ demonstration until the deposition of Dominique Python, one of the named inventors and CrestaTech's 30(b)(6) witness on the issue of the first disclosure of the claimed inventions, who was not deposed until after the close of fact discovery by agreement of the parties. (*Id.* at 9-11.) Respondents argue that the remaining references (Ehrhardt '93, Mitola '99, Mitola '00, Efstathiou '00, Razavilar '99, STMicro '01, ED '98, Colin '01, Lee '98 and Coy '92) were all cited in their notice of prior art, and that Dr. Hashemi used these references to provide background regarding what a person of ordinary skill would have known at the time of the claimed invention. (*Id.* at 12-13.) Respondents argue that because these references were disclosed timely as evidence of the level of skill in the art, they should not be stricken. (*Id.* at 13.)

Respondents argue that CrestaTech did not point out the scope of the relief it seeks with particularity, instead improperly requesting that entire paragraphs be stricken. (*Id.* at 14.)

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### C. CrestaTech's Reply

CrestaTech argues that Respondents' claims that CrestaTech did not meet and confer in good faith are untrue. (Repl. at 1-2.)

CrestaTech says Respondents' arguments that the Mitra '01, Razavi '97, and Oppenheim '97 references are only being offered to show obviousness of level of skill in the art is without merit. (*Id.* at 3.) CrestaTech argues that the Mitra '01, Razavi '97, and Oppenheim '97 references are offered both for the purposes of anticipation and obviousness in Dr. Hashemi's report. (*Id.*)

CrestaTech acknowledges that the Yoshida '01 reference was disclosed in Respondents' invalidity contentions and withdraws its motion as to Yoshida '01. (*Id.* at 3 n.1.)

CrestaTech also argues that Respondents' reliance on the [REDACTED] demonstration is improper. (*Id.*) CrestaTech does not dispute that Respondents disclosed the Morton2 chip as a prior art reference. (*Id.*) CrestaTech argues instead that the Morton2 [REDACTED]

[REDACTED] (*Id.* at 4.) CrestaTech also argues that referring to the [REDACTED] demonstration in its invalidity chart for the Morton2 was not sufficient disclosure. (*Id.*)

CrestaTech states that the remaining references at issue were only disclosed in the Notice of Prior Art, but not disclosed or incorporated by reference into Respondents' invalidity contentions as invalidating references. (*Id.* at 4-5.) CrestaTech states that although Respondents contend they will only offer these references to show the level of skill in the art, Dr. Hashemi's report lists these references as showing anticipation and/or obviousness. (*Id.* at 5.) CrestaTech argues that because the references were not disclosed in Respondents' invalidity contentions, Dr. Hashemi may not rely on them to show invalidity. (*Id.* at 5-6.)

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CrestaTech argues that it is not seeking to strike entire paragraphs of Dr. Hashemi's report, but only those portions which discuss the references at issue. (*Id.* at 6.) CrestaTech also argues that it was prejudiced because it was forced to respond to these references in its expert rebuttal reports. (*Id.*)

### II. DISCUSSION

#### A. Mitola '95, Efstathiou '99, Python '05

Respondents do not dispute that the Mitola '95, Efstathiou'99, and Python '05 references were not disclosed in their Notice of Prior Art. (Opp. at 3 n.1.) Respondents have also agreed that Dr. Hashemi will not rely on these three references. (*Id.*) Accordingly, CrestaTech's motion as to Mitola '95, Efstathiou '99, and Python '05 is GRANTED. The portions of Dr. Hashemi's expert report that discuss those references shall be stricken from the report.

#### B. Mitra '01, Razavi '97, Oppenheim '97

The parties do not dispute that the Mitra '01, Razavi '97, and Oppenheim '97 were disclosed in Respondents' invalidity contentions as references that show the level of skill in the art or obviousness. (Mot. at 4 n.8; Opp. at 4-5.) Respondents state that Dr. Hashemi is only relying on these references to show the level of skill in the art or obviousness, and not to show anticipation. (Opp. at 5.) Accordingly, CrestaTech's motion as to Mitra '01, Razavi '97, and Oppenheim '97 is GRANTED to the extent Dr. Hashemi relies on these references for purposes other than showing the level of ordinary skill in the art or obviousness. The portions of Dr. Hashemi's expert report that discuss those references for purposes other than showing the level of ordinary skill in the art or obviousness shall be stricken from the report.

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C. [REDACTED] Demonstration

The parties do not dispute that Respondents disclosed the Morton2 chip as an invalidating reference in their invalidity contentions. (Repl. at 4; Opp. at 8-9.) CrestaTech argues, however, that the [REDACTED] demonstration could not have disclosed the Morton2 chip [REDACTED] [REDACTED] or alternatively, that Respondents' disclosure of the Morton2 chip was insufficient to put CrestaTech on notice that the [REDACTED] demonstration would be relied upon to show an invalidating public use and/or on-sale bar. (Repl. at 4.) Both arguments are unavailing. First, CrestaTech's allegations that the [REDACTED] demonstration could not have disclosed the Morton2 chip do not preclude Respondents from presenting evidence to the contrary. Indeed, Respondents have presented the deposition testimony of CrestaTech's 30(b)(6) witness that a demonstration of the Morton2 chip [REDACTED] (See Opp., Ex. 4.)

Second, Respondents' invalidity contentions provided adequate notice that Respondents intended to use the public use or sale of the Morton2 chip as an invalidating reference. (See Opp., Ex. 1, Ex. 2B17 at 1 ("Xceive's Morton2 products were offered for sale at least as early as May 18, 2003, and were ready for patenting on or before that date".)) Even assuming this was not an adequate disclosure, Respondents could not have provided more information because, by agreement of the parties, Respondents were unable to depose Dominique Python until after the close of fact discovery. Therefore, Respondents had good cause to disclose the public use or sale of the Morton2 chip as an invalidating reference after the close of fact discovery. Accordingly, CrestaTech's motion as to the Sharp demonstration is DENIED.

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**D. Remaining References Identified in the Notice of Prior Art (Ehrhardt '93, Mitola '99, Efstathiou '00, Razavilar '99, STMico '01, ED '98, Colin '01, Lee '98, and Coy '92)**

The parties do not dispute that the remaining references were disclosed in Respondents' Notice of Prior Art and may be relied upon to show the level of skill in the art. (Repl. at 5; Opp. at 12.) Respondents state that Dr. Hashemi is only relying on these references to show the level of skill in the art. (Opp. at 12-13.) Accordingly, CrestaTech's motion as to the remaining references at issue (Ehrhardt '93, Mitola '99, Efstathiou '00, Razavilar '99, STMico '01, ED '98, Colin '01, Lee '98, and Coy '92) is GRANTED to the extent Dr. Hashemi relies on these references for purposes other than showing the level of ordinary skill in the art. The portions of Dr. Hashemi's expert report that discuss those references for purposes other than showing the level of ordinary skill in the art shall be stricken from the report.

ORDER

Motion Docket No. 910-030 is hereby GRANTED-IN-PART. Motion Docket No. 910-033 is hereby GRANTED.

Within seven (7) days of the date of this Order, each party shall submit to the Office of the Administrative Law Judges a statement as to whether or not it seeks to have any portion of this document deleted from the public version. The parties' submissions may be made by facsimile and/or hard copy by the aforementioned date.

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Any party seeking to have any portion of this document deleted from the public version thereof must submit to this office a copy of this document with red brackets indicating any portion asserted to contain confidential business information. The parties' submissions concerning the public version of this document need not be filed with the Commission Secretary.

**SO ORDERED.**

*Dee Lord*

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Dee Lord  
Administrative Law Judge

**CERTAIN TELEVISION SETS,  
TELEVISION RECEIVERS, TELEVISION  
TUNERS, AND COMPONENTS THEREOF**

Inv. No. 337-910

**PUBLIC CERTIFICATE OF SERVICE**

I, Lisa R. Barton, hereby certify that the attached **ORDER** has been served by hand upon the Commission Investigative Attorney, **Peter J. Sawert, Esq.**, and the following parties as indicated, on

**NOV 28 2014**



Lisa R. Barton, Secretary  
U.S. International Trade Commission  
500 E Street SW, Room 112A  
Washington, D.C. 20436

**FOR COMPLAINANT CRESTA TECHNOLOGY CORPORATION:**

Louis S. Mastriani, Esq.  
**ADDUCI MASTRIANI & SCHAUMBERG LLP**  
1133 Connecticut Avenue NW  
Washington, DC 20036

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: \_\_\_\_\_

**FOR RESPONDENT MAXLINEAR, INC.:**

Gregory C. Schodde, Esq.  
**MCANDREWS, HELD & MALLOY, LTD.**  
500 West Madison Street, 34<sup>th</sup> Floor  
Chicago, IL 60661

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: \_\_\_\_\_

**FOR RESPONDENTS SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS  
AMERICA, INC., and SILICON LABORATORIES, INC.:**

Aaron Wainscoat, Esq.  
**DLA PIPER LLP (US)**  
2000 University Avenue  
East Palo Alto, CA 94303

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: \_\_\_\_\_

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FOR RESPONDENTS LG ELECTRONICS INC., and LG ELECTRONICS U.S.A. (LG):

Christian A. Chu, Esq.  
FISH & RICHARDSON P.C.  
1425 K Street, N.W.  
11<sup>th</sup> Floor  
Washington, DC 20005

- Via Hand Delivery  
 Via Express Delivery  
 Via First Class Mail  
 Other: \_\_\_\_\_

FOR RESPONDENTS VIZIO, INC.; HON HAI PRECISION INDUSTRY CO., LTD; SIO  
INTERNATIONAL; TOP VICTORY INVESTMENTS LTD. and TPV INTERNATIONAL  
(USA), INC.:

Cono A. Carrano, Esq.  
AKIN GUMP STRAUSS HAUER & FELD LLP  
1333 New Hampshire Avenue NW  
Washington, DC 20036

- Via Hand Delivery  
 Via Express Delivery  
 Via First Class Mail  
 Other: \_\_\_\_\_

FOR RESPONDENTS SHARP CORPORATION and SHARP ELECTRONICS  
CORPORATION:

Josh Krevitt, Esq.  
GIBSON, DUNN & CRUTCHER LLP  
200 Park Avenue  
New York, NY 10166

- Via Hand Delivery  
 Via Express Delivery  
 Via First Class Mail  
 Other: \_\_\_\_\_

FOR RESPONDENTS WISTRON CORPORATION and WISTRON INFOCOMM  
TECHNOLOGY (AMERICA) CORPORATION:

Harold E. Davis, Jr. Esq.  
K&L GATES LLP  
Four Embarcadero Center, Suite 1200  
San Francisco, CA 94111

- Via Hand Delivery  
 Via Express Delivery  
 Via First Class Mail  
 Other: \_\_\_\_\_