

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19

FLEHR, HOHBACH, TEST,
ALBRITTON & HERBERT
ALDO J. TEST
THOMAS O. HERBERT
EDWARD S. WRIGHT
Suite 3400, Four Embarcadero Center
San Francisco, California 94111
Telephone: (415) 781-1989

WILSON, SONSINI, GOODRICH & ROSATI
HARRY B. BREMOND
MICHAEL A. LADRA
Two Palo Alto Square
Palo Alto, California 94304
Telephone: (415) 493-9300

Attorneys for Defendant

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

THE MAGNAVOX COMPANY,)
a Corporation, and)
SANDERS ASSOCIATES, INC.,)
a corporation,)
Plaintiffs,)
v.)
ACTIVISION, INC.,)
a Corporation,)
Defendant.)

Civil Action
C82 5270 JPV
Hearing Date: May 10, 1984
Time: 10:00 a.m.
CERTIFICATE OF SERVICE

1 FLEHR, HOHBACH, TEST,
2 ALBRITTON & HERBERT
3 ALDO J. TEST
4 THOMAS O. HERBERT
5 EDWARD S. WRIGHT
6 Suite 3400, Four Embarcadero Center
7 San Francisco, California 94111
8 Telephone: (415) 781-1989

6 WILSON, SONSINI, GOODRICH & ROSATI
7 HARRY B. BREMOND
8 MICHAEL A. LADRA
9 Two Palo Alto Square
10 Palo Alto, California 94304
11 Telephone: (415) 493-9300

12 Attorneys for Defendant

13 IN THE UNITED STATES DISTRICT COURT
14 FOR THE NORTHERN DISTRICT OF CALIFORNIA

13	THE MAGNAVOX COMPANY,)	
14	a Corporation, and)	
15	SANDERS ASSOCIATES, INC.,)	Civil Action
16	a corporation,)	C82 5270 JPV
17)	
18	Plaintiffs,)	
19)	
20	v.)	NOTICE OF MOTION FOR
21)	ORDER COMPELLING
22	ACTIVISION, INC.,)	DISCOVERY
23	a Corporation,)	
24)	Hearing Date: May 10, 1984
25	Defendant.)	
26)	Time: 10:00 a.m.

27 Please take notice that on Thursday, May 10, 1984 at 10:00
28 a.m. in Courtroom No. 10, 19th Floor, United States Courthouse, 450
Golden Gate Avenue, San Francisco, California, defendant will bring a
motion for an order compelling discovery with regard to defendant's
Interrogatories Nos. 32-37, 39, 40-41, 53, 65, 76-78, 84-87, 101-104,
105-112, 113-116, 126-134, 138-139, 140-152, 154, 159-162, 169-172
and 173-174. Defendant will also request an award of the reasonable
expenses incurred in obtaining the order, including attorneys' fees.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

This motion will be based upon Rule 37(a) of the Federal Rules of Civil Procedure, the accompanying memorandum, and the accompanying declaration of Edward S. Wright.

A Certification of Compliance with Local Rule 230-4(a) and a copy of a proposed form of Order are being filed herewith.

FLEHR, HOHBACH, TEST,
ALBRITTON & HERBERT

By Edward S. Wright
Edward S. Wright
Attorneys for Defendant

Date: April 12, 1984

1 FLEHR, HOHBACH, TEST,
2 ALBRITTON & HERBERT
3 ALDO J. TEST
4 THOMAS O. HERBERT
5 EDWARD S. WRIGHT
6 Suite 3400, Four Embarcadero Center
7 San Francisco, California 94111
8 Telephone: (415) 781-1989

9 WILSON, SONSINI, GOODRICH & ROSATI
10 HARRY B. BREMOND
11 MICHAEL A. LADRA
12 Two Palo Alto Square
13 Palo Alto, California 94304
14 Telephone: (415) 493-9300

15 Attorneys for Defendant

16
17 IN THE UNITED STATES DISTRICT COURT
18 FOR THE NORTHERN DISTRICT OF CALIFORNIA

19 THE MAGNAVOX COMPANY,)
20 a Corporation, and)
21 SANDERS ASSOCIATES, INC.,)
22 a corporation,)
23
24 Plaintiffs,)

Civil Action
C82 5270 JPV

25 v.)

26 ACTIVISION, INC.,)
27 a Corporation,)
28
29 Defendant.)

Hearing Date: May 10, 1984

Time: 10:00 a.m.

30
31
32 MEMORANDUM IN SUPPORT OF MOTION
33 FOR ORDER COMPELLING DISCOVERY
34
35
36
37
38

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

TABLE OF AUTHORITIES

Page No.

Rules

Rule 1 Federal Rules of Civil Procedure	11
Rule 26(b)(1) Federal Rules of Civil Procedure	4
Rule 33(c) Federal Rules of Civil Procedure	2,8
Northern District of California Local Rule 230-4(a)	2

TABLE OF CONTENTS

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Page No.

TABLE OF AUTHORITIES

BACKGROUND	1
Interrogatories 32-37 and 76-78	4
Interrogatories 39, 40-41, 53, 65 and 126-134	5
Interrogatories 84-87 and 159-162	6
Interrogatories 138-139 and 140-152	7
Interrogatories 101-104 and 113-116	9
Interrogatories 105-112 and 154	10
CONCLUSION	10

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

MEMORANDUM IN SUPPORT OF MOTION
FOR ORDER COMPELLING DISCOVERY

This motion is necessitated by plaintiffs' failure to answer certain interrogatories propounded by defendant, including Interrogatories Nos. 32-37, 39, 40-41, 53, 65, 76-78, 84-87, 101-104, 105-112, 113-116, 126-134, 138-139, 140-152, 154, 159-162, 169-172 and 173-174.¹

Copies of these interrogatories and plaintiffs' responses are attached hereto as Exhibit A.

BACKGROUND

Plaintiffs in their Complaint have alleged infringement of U. S. Patent Re. 28,507 by defendant. In its Answer and First Counterclaim, defendant has placed in issue the validity, enforceability and infringement of the Re. '507 patent. Defendant's Second Counterclaim seeks a declaratory judgment that U.S. Patent 3,728,480 is likewise invalid, unenforceable and not infringed. Defendant's Third Counterclaim alleges that plaintiffs have unfairly competed with defendant by misusing the Re. '507 patent and other patents in plaintiffs' family of television gaming patents, by misleading customers of defendant and others with regard to the scope of plaintiffs' patents and by falsely claiming and asserting that products sold by defendant are an infringement of the Re. '507 patent. In reply to defendant's Counterclaims, plaintiffs have denied the allegations regarding the invalidity, unenforceability and noninfringement of the Re. '507 and '480 patents and misuse of the Re. '507 patent.

Defendants First Set of Interrogatories to Plaintiffs (Nos. 1-125) was served on plaintiffs on December 17, 1982. An unsigned and unverified copy of

¹ Plaintiffs have also failed to answer a number of other interrogatories and to comply with defendant's request for production. However, in the interest of judicial economy, this motion is limited to the unanswered interrogatories which bear directly on the issues of validity and infringement since these issued are of paramount importance in any patent infringement suit.

1 plaintiffs' response to this set of interrogatories was received by defendant's
2 counsel on February 10 or 11, 1983. These answers were largely incomplete
3 and evasive, and by letter dated February 16, 1983 defendant requested
4 complete responses and a conference regarding all disputed issues as required
5 by Local Rule 230-4(a). A copy of the February 16, 1983 letter is attached
6 hereto as Exhibit B. Plaintiffs responded in general terms to this letter by a
7 letter dated March 9, 1983, a copy of which is attached as Exhibit C. Counsel
8 for plaintiffs and defendant met on March 14, 1983 to discuss the unanswered
9 interrogatories in greater detail, and at that time it was agreed that plaintiffs
10 would supplement their responses. An unsigned and unverified copy of plain-
11 tiffs' supplemental response to Defendant's First Set of Interrogatories was
12 given to defendant's counsel on September 1, 1983, with a letter bearing that
13 date. A copy of that letter is attached hereto as Exhibit D.

14 Defendant's Second Set of Interrogatories to Plaintiffs (Nos. 126-182)
15 was served on plaintiffs on March 16, 1983, and plaintiffs' response to those
16 interrogatories was served on August 15, 1983. Like plaintiffs' responses to
17 defendant's first set of interrogatories, the responses to defendant's second set
18 of interrogatories were largely incomplete and evasive.

19 Plaintiffs have responded to a number of defendant's interrogatories
20 by stating that the information requested could be derived or ascertained from
21 the files of plaintiffs. However, rather than specifying the records with the
22 detail required by Rule 33(c), plaintiffs simply identified the records as files
23 relating to the subject matter of the interrogatories. In the February 16, 1983
24 letter, defendant's counsel objected to this tactic and requested proper iden-
25 tification of the records but such identification was never made.

26 On August 31 and September 1, 1983, defendant's counsel went to the
27 offices of plaintiffs' counsel in Chicago for the purpose of inspecting documents
28 which plaintiffs' counsel had indicated would be produced in response to certain

1 ones of the interrogatories propounded by defendant. At that time, plaintiffs'
2 counsel produced approximately sixty boxes of documents without any indication
3 as to which documents were being produced in response to which interrogatory,
4 other than a general indication that documents relating to licensing were in
5 about twelve boxes in one corner of the room, the documents relating to liti-
6 gation were in another part of the room, and that some additional documents
7 would be brought into the room as they became available. Without a proper
8 identification of the documents and the interrogatories to which they pertained,
9 it was virtually impossible to obtain the answers to many of the interrogatories.
10 Moreover, it appeared that no documents relating to some of the interrogatories
11 were produced, that a number of files were missing and that certain documents
12 might have been removed from the files which were produced.

13 Following this document production, and at defendant's request,
14 plaintiffs provided defendants with copies of deposition transcripts from prior
15 litigation involving plaintiffs' television game patents and copies of a number of
16 documents which had been requested by Mattel in one of the earlier cases. The
17 Mattel documents filled seven file transfer boxes, and defendant has spent
18 several months trying to correlate them to the interrogatories. Even so, defen-
19 dant still does not have answers to many of its interrogatories.

20 By letter dated March 22, 1984, a copy of which is attached as
21 Exhibit E, defendant asked plaintiffs to make further discovery on a number of
22 matters, including the interrogatories to which the present motion is directed.
23 In that letter, defendant indicated that it would proceed with a motion to compel
24 discovery unless plaintiffs provided complete answers to the unanswered
25 interrogatories before April 4, 1984.

26 Counsel for the respective parties discussed the matters raised in the
27 March 22 letter by telephone on April 3, 1984, at which time it was agreed that
28 defendant would limit the number of interrogatories to be answered and that

1 plaintiffs would supplement their answers to the interrogatories. By letter
2 dated April 6, 1984, a copy of which is attached as Exhibit F, defendant
3 significantly reduced the number of interrogatories outstanding and identified
4 the interrogatories to be answered by plaintiffs. In this letter, defendant
5 advised plaintiff that it would proceed with a motion to compel discovery if it
6 did not receive the supplemental responses to the remaining interrogatories by
7 April 12. The supplemental responses have not been received.

8 Interrogatories 32-37 and 76-78

9 Interrogatories 32-37 relate directly to the validity and/or enforce-
10 ability of plaintiffs' video game patents, and defendant has agreed to limit this
11 interrogatory to the two patents in suit. More specifically, Interrogatories
12 32-35 relate to studies and conclusions on the part of plaintiffs regarding the
13 validity and enforceability of the patents, and Interrogatories 36-37 relate to
14 suggestions by others that the patents might be invalid or unenforceable.
15 Plaintiffs' only response to these interrogatories has been a relevancy objection,
16 which is clearly not proper when the validity of the patents is squarely at issue
17 in this case. In so doing, plaintiffs have completely ignored Rule 26(b)(1) of
18 the Federal Rules of Civil Procedure which provides

19 Parties may obtain discovery regarding any matter, not privileged,
20 which is relevant to the subject matter involved in the pending
action...

21 The rule further states

22 It is not ground for objection that the information sought will be
23 inadmissible at the trial if the information sought appears reasonably
calculated to lead to the discovery of admissible evidence.

24 Given this breadth of discovery, plaintiffs' relevancy objection still would not
25 be proper even if the information sought did not relate directly to one of the
26 major issues in the case.

27 Interrogatories 76-78 also relate to the issue of validity. More
28 specifically, Interrogatory No. 76 addresses plaintiffs' contentions regarding the

1 manner in which the claims identified as being infringed define patentable
2 subject matter over certain prior art. Interrogatory No. 77 requests an
3 identification of documents relating to this prior art, and Interrogatory 78
4 requests an identification of persons employed by plaintiffs who have knowledge
5 of this particular art. Plaintiffs have objected to Interrogatory 76 as being
6 premature, they have made vagueness and relevancy objections to Interrogatory
7 77, and they have made a relevancy objection to Interrogatory 78.
8 Interrogatory 76 was intended to reduce the number of issues to be tried in the
9 case by ascertaining plaintiffs' position with regard to prior art deemed to be of
10 particular relevance. This art is well known to plaintiffs from prior litigation
11 involving the patents in suit, and defendant should not have to wait until the
12 eve of trial for plaintiffs' position with regard to this art. Interrogatory 77
13 and 78 relate to plaintiffs' knowledge of the particular art, and this can have a
14 direct bearing on both the validity and the enforceability of the patents in suit.
15 Interrogatory 77 is clear in requesting the identification of documents which
16 refer or relate to the particular art, and the relevancy objection to
17 Interrogatories 77 and 78 is certainly not well founded.

18 Interrogatories 39, 40-41, 53, 65 and 126-134

19 These interrogatories all relate to plaintiffs' position on the question
20 of infringement and the manner in which they apply the claims of the Re. '507
21 patent to defendant's television game cartridges and the consoles in which those
22 cartridges are used. In their original and supplemental responses to Interro-
23 gatories 38 and 39 and their response to Interrogatory 50, plaintiffs have
24 identified nine claims which they contend to be infringed and thirteen cart-
25 ridges and three consoles, the use of which they contend constitute the
26 infringement. However, plaintiffs have refused to give any indication as to how
27 these products infringe or where the elements of the infringed claims are found
28 in the accused products. Plaintiffs have objected to the majority of these

1 interrogatories as being premature because plaintiffs have not completed their
2 discovery with regard to the cartridges and the consoles. However, it is
3 difficult for defendant to understand how plaintiffs can identify specific claims
4 as being infringed and specific products as infringing without being able to
5 indicate how the claims are being interpreted or where the claimed elements are
6 found in the accused products. Defendant is entitled to have the information
7 upon which these conclusions were based at the time the conclusions were made,
8 plus any additional information which plaintiffs may have obtained in the
9 meantime. Even if plaintiffs still have not have completed their discovery on
10 the design and the inner workings of the cartridges and consoles, a number of
11 the elements addressed by the interrogatories are visual phenomena which are
12 observable on the screen of the television receiver, e.g. hitting and hit
13 symbols, coincidence and distinct motion. Plaintiffs should be able to respond
14 to the interrogatories at least with regard to these visible elements, and they
15 cannot expect defendant to wait until the eve of trial for plaintiffs' position on
16 these matters.

17 Interrogatories 84-87 and 159-162

18 These interrogatories also relate to the issue of infringement, and
19 more particularly to plaintiffs' interpretation of the allegedly infringed claims,
20 with specific reference to certain terms used in those claims.

21 Interrogatories 84-87 ask whether plaintiffs consider the dis-
22 appearance or a change in the color of a symbol to constitute imparting
23 distinct motion to the symbol within the meaning of Claim 51 of the Re. '507
24 patent. This is a crucial issue in the case, and plaintiffs have responded with
25 a relevancy objection. Claim 51 is one of the claims which plaintiffs have
26 identified as being infringed. Although plaintiffs have never indicated what
27 they contend constitutes imparting a distinct motion in any of defendant's
28 games, it is possible that plaintiffs are relying disappearance or a change in

1 color in at least some of these games. Since plaintiffs have identified certain
2 games as infringing, they have undoubtedly formulated their position on this
3 issue. Defendant is entitled to know what this position is so that defendant
4 can prepare its case, and defendant should not have to wait until the time of
5 trial to learn plaintiffs' position on this crucial issue.

6 Interrogatories 159-162 are directed specifically to plaintiffs' inter-
7 pretation of the terms "hitting symbol", "hit symbol", "hitting spot", and "hit
8 spot" in the claims of the Re. '507 patent which they have identified as being
9 infringed. In response to these interrogatories, plaintiffs have simply indicated
10 that they contend that examples of each of the symbols or spots are set forth
11 in the specification of the Re. '507 patent, and they have made a relevancy
12 objection to these interrogatories to the extent they may require any further
13 response. Plaintiffs' contentions regarding the interpretation of the claims are
14 certainly relevant to the issue of infringement, and unless plaintiffs are willing
15 to limit their interpretation to the specific examples disclosed in the patent, the
16 objection is not well founded.

17 Interrogatories 138-139 and 140-152

18 These interrogatories relate to the validity of the Re. '507 patent,
19 and more specifically to information uniquely within the knowledge of plaintiff
20 Sanders Associates which bears directly on the issue of validity.

21 Interrogatories 138-139 seek identification of the portions of the
22 subject matter described in the '480 patent which plaintiffs contend are not
23 prior art with regard to the Re. '507 patent. In responding to Interrogatory
24 75, plaintiffs admitted that at least portions of the subject matter disclosed in
25 the '480 patent are prior art with regard to the Re. '507 patent, and Interro-
26 gatories 138-139 were intended to reduce the issues at trial by identifying those
27 portions of the '480 patent. Rather than answering the interrogatories, plain-
28 tiffs have objected to the interrogatories as being burdensome and irrelevant,

1 and they have suggested that defendant can ascertain the requested information
2 from documents relating to the development of the inventions of the two patents
3 and the deposition and trial transcripts of persons having knowledge of the
4 facts relating to the developments. Plaintiffs have not specified the documents
5 and transcripts with the detail required by Rule 33(c), and even if they did
6 so, an offer to produce business records would not be a proper response to the
7 interrogatories because the interrogatories seek contentions which cannot be
8 ascertained from business records. The information requested bears directly on
9 the issue of validity, and the relevancy objection is not well founded. With
10 regard to the burdensomeness objection, defendant has offered to limit the
11 interrogatory to certain portions of the '480 patent which are set forth in the
12 April 6, 1984 letter (Exhibit F).

13 Interrogatories 140-152 seek specific information about the subject
14 matter claimed in Claim 13 of the '480 patent and the claims of the Re. '507
15 patent which plaintiffs have identified as being infringed. The dates of inven-
16 tion and the other information sought by these interrogatories is relevant to the
17 issue of validity with respect to both of the patents in suit. Plaintiffs have
18 objected to these interrogatories as being vague and irrelevant, and they have
19 stated that defendant can ascertain the information from documents relating to
20 the developments of the inventions and from the deposition and trial transcripts
21 of persons having knowledge of the facts relating to the developments. Once
22 again, plaintiffs have failed to specify the documents and transcripts with the
23 detail required by Rule 33(c). Moreover, reference to business records is not
24 a proper response to these interrogatories since the information requested is
25 believed to be largely within the knowledge of plaintiffs' employees and not
26 ascertainable from business records. The vagueness objection is largely a
27 matter of semantics regarding the use of the term "invention", and as plaintiffs
28 well know, in each of the interrogatories the term is used to designate a

1 specific element of a specific claim. Notwithstanding the use of the term
2 "invention", the meaning of the interrogatories is clear, the information sought
3 bears directly on the issue of validity, and defendants are entitled to have
4 answers to these interrogatories.

5 Interrogatories 101-104 and 113-116

6 These interrogatories relate to the validity and enforceability of the
7 Re. '507 patent, and more particularly to the question of whether the Patent
8 Office Examiner who examined the application leading to the Re. '507 patent was
9 aware of certain prior art known to the attorneys who filed and prosecuted the
10 application. Plaintiffs' initial response to these interrogatories was a relevancy
11 objection. In their supplemental responses, plaintiffs indicated that the extent
12 of their present knowledge on the subject matter of these interrogatories is set
13 forth in the prosecution file history of the Re. '507 patent and in certain
14 deposition transcripts.

15 Interrogatories 101-102 ask whether plaintiffs ever disclosed the
16 existence of the '480 patent and its teaching of coincidence to the Examiner in
17 charge of the Re. '507 application, and Interrogatories 103-104 ask whether the
18 Examiner ever indicated to plaintiffs that he was aware of the '480 patent and
19 its teaching of coincidence. Patent applicants have a duty to disclose to the
20 Patent Office any information they are aware of which is material to the exam-
21 ination of the application, and these interrogatories are directed to plaintiffs'
22 compliance with that duty. The information sought by the interrogatories is
23 something within the personal knowledge of plaintiffs and their attorneys, and
24 it is not proper for plaintiffs to avoid answering these interrogatories by refer-
25 ence to the file history and deposition transcripts. One of the reasons that the
26 information is of particular interest is that it is not found in the file history.

27 Interrogatories 113-116 relate to the Examiner's awareness of the '480
28 patent and a prior art video game which one of the attorneys who

1 participated in the Re. '507 patent application has admitted seeing. The
2 information sought by these interrogatories is known to plaintiffs' attorneys,
3 and the interrogatories should be answered directly rather than by reference to
4 a deposition transcript.

5 Interrogatories 105-112 and 154

6 These interrogatories relate to the validity and enforceability of the
7 patents in suit, and more particularly to plaintiffs' own knowledge of a prior
8 art video game known as "Spacewar". Plaintiffs' initial response to Interro-
9 gatories 105-112 was a relevancy objection, and this was supplemented by a
10 reference to a deposition transcript. Plaintiffs' only response to Interrogatory
11 No. 154 has been a reference to unidentified deposition transcripts of witnesses
12 having knowledge of the subject.

13 Interrogatories 105-112 relate to a prior art video game which was
14 known to one of the attorneys involved in the issuance of the Re. '507 patent
15 and the apparent failure of that attorney to disclose that information to the
16 Patent Office. The interrogatories seek specific information which defendant is
17 entitled to know, and it is not proper for plaintiffs to try to conceal this
18 information by reference to a deposition transcript in which the information may
19 or may not be found.

20 Interrogatory 154 relates to plaintiffs' knowledge of the "Spacewar"
21 game played at MIT in the early 1960's. This interrogatory seeks specific
22 information, and plaintiffs cannot conceal this information by a vague reference
23 to unidentified deposition transcripts.

24 CONCLUSION

25 The interrogatories to which this motion is directed all relate to major
26 issues in the case. Plaintiffs' continued refusal to make proper discovery with
27 respect both to these interrogatories and to defendant's other interrogatories
28 and requests for production is nothing more than a stalling tactic designed to

1 reduce defendant's time for investigation and to obfuscate the issues in the
2 case. Such conduct violates the explicit mandate of Rule 1 of the Federal Rules
3 of Civil Procedure that the rules "shall be construed to secure the just,
4 speedy, and inexpensive determination of every action."

5 It is respectfully submitted that plaintiffs should be ordered to make
6 proper discovery and that defendant should be awarded its reasonable
7 expenses, including attorneys' fees, in obtaining this order.

8 Respectfully submitted

9 FLEHR, HOHBACH, TEST,
10 ALBRITTON & HERBERT

11 Date: APRIL 12, 1984

12 By

Edward S. Wright
13 Edward S. Wright
14 Attorneys for Defendant
15
16
17
18
19
20
21
22
23
24
25
26
27
28