

**PUBLIC VERSION**

**UNITED STATES INTERNATIONAL TRADE COMMISSION**

**Washington, D.C.**

**In the Matter of**

**CERTAIN SEMICONDUCTOR DEVICES,  
SEMICONDUCTOR DEVICE PACKAGES,  
AND PRODUCTS CONTAINING SAME**

**Inv. No. 337-TA-1010**

**ORDER NO. 50: GRANTING-IN-PART AND DENYING-IN-PART RESPONDENTS'  
RENEWED MOTION TO COMPEL PRODUCTION OF FACTUAL  
MATERIALS UNDERLYING TESTING**

(December 16, 2016)

On November 15, 2016, Respondents Broadcom Limited, Broadcom Corporation, Avago Technologies Limited, and Avago Technologies U.S. Inc. (collectively, "Broadcom") filed a renewed motion to compel the production of factual materials underlying the testing of Broadcom products and asserted third-party domestic industry products (Motion Docket No. 1010-050).<sup>1</sup> Complainants Tessera Technologies, Inc., Tessera, Inc., and Invensas Corporation (collectively, "Tessera") filed a response in opposition on November 25, 2016. Broadcom filed a reply brief on November 30, 2016.

**I. BACKGROUND**

Pursuant to Commission Rule 210.12(a)(9) subsections (viii) and (ix), Tessera attached claim charts to its complaint in this investigation, applying the limitations of each asserted independent claim to certain accused Broadcom devices and third-party domestic industry

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<sup>1</sup> Broadcom filed an earlier version of this motion, which was denied as premature. Order No. 40 (Oct. 6, 2016).

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products. *See* Complaint ¶¶ 59-61 (citing Exs. 9-29), ¶¶ 120-128 (citing Exs. 81-85, 88-90, 92).

When responding to Broadcom's first set of discovery requests on July 18, 2016, Tessera cited to these complaint exhibits in response to interrogatories and document requests seeking an identification of accused products, infringement contentions, and domestic industry contentions. Mot. Ex. 4 (Interrogatory Nos. 1, 2, 4, 5, 7, 8), Ex. 5 (Requests for Production Nos. 23, 27, 31), Ex. 10 (Interrogatory No. 38). On July 18 and August 26, 2016, Tessera responded to interrogatories seeking specific information regarding the pre-filing testing of accused products by claiming privilege as to any documents beyond those attached to the complaint. Mot. Ex. 2 (Requests for Production Nos. 75-80), Ex. 3 (Interrogatory Nos. 11, 12).

On August 26, 2016, Tessera responded to Broadcom's first set of requests for inspection, agreeing to an inspection of the products and facilities used for the testing of accused products cited in the complaint, subject to an agreement on protocol. Mot. Ex. 2 (Requests for Inspection Nos. 1-42). On October 26, 2016, Tessera responded to Broadcom's second set of requests for inspection, agreeing to an inspection of the products and facilities used for the testing of domestic industry products cited in the complaint, subject to an agreement on protocol. Mot. Ex. 7 (Requests for Inspection Nos. 43-60). Also on October 26, 2016, Tessera objected to providing any discovery beyond the complaint exhibits in response to discovery requests seeking specific information related to Tessera's pre-filing testing of domestic industry products. Mot. Ex. 7 (Requests for Production Nos. 81-86), Ex. 8 (Interrogatory Nos. 71-72).

On October 20, 2016, Tessera served supplemental responses to Broadcom's contention interrogatories regarding infringement and domestic industry purporting to replace its previous responses, attaching new claim charts that did not rely on evidence from the complaint. Mot. Ex. 4 (Interrogatory Nos. 1, 2, 4, 5, 7, 8), Ex. 10 (Interrogatory No. 38).

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On November 3, 2016, Tessera produced its privilege log, identifying numerous documents related to its pre-filing testing of Broadcom products. Mot. Ex. 11.<sup>2</sup>

### II. DISCUSSION

Broadcom seeks the production of documents and information regarding the testing of accused and domestic industry products, including the protocol(s) and processes used for testing and analysis (including any equipment and software used), the data and results generated by any such testing or analysis, the actual products tested, all images taken of such products or any portions thereof, and the identities of the individuals involved in the testing. Mot. at 2. Tessera does not dispute that this discovery is relevant, but claims that this discovery is properly withheld as work product or pursuant to Federal Rule of Civil Procedure 26(b)(4). Opp. at 11-19. Broadcom seeks discovery regarding testing that was performed before the filing of the complaint, and testing that was performed after the institution of the investigation.

#### A. Discovery of Pre-Filing Testing

Because Commission Rule 210.12 requires complainants to conduct significant pre-filing investigation before bringing a complaint, several other administrative law judges have addressed motions to compel discovery of pre-filing testing. In *Certain Encapsulated Integrated Circuit Devices and Products Containing Same* (“Encapsulated IC Devices”), the complainant was ordered to produce discovery regarding its pre-filing investigation of infringement, including X-rays and photographs of accused products, when exhibits attached to the complaint were cited in contention interrogatory responses. Inv. No. 337-TA-501, Order No. 53 (May 20, 2004).

Although the administrative law judge recognized that work-product protection applied to

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<sup>2</sup> Pursuant to a stipulation, the parties agreed not to log privileged documents created on or after May 23, 2016. Stipulation Among the Parties Regarding Certain Procedural and Discovery Matters at 14 (Aug. 5, 2016).

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documents prepared in anticipation of litigation, any such privilege was waived when the complainant sought to use the complaint exhibits as a “sword” to prove infringement. *Id.* at 6-13. This waiver was construed narrowly, specifically excluding legal advice and analysis from complainant’s attorneys. *Id.* at 13. In *Certain Network Controllers and Products Containing Same* (“*Network Controllers*”), the complainant was similarly ordered to produce discovery concerning exhibits attached the complaint when these exhibits were referenced in interrogatory responses and cited by one of the complainant’s experts. Inv. No. 337-TA-531, Order No. 15 (July 19, 2015). In *Certain Ceramic Capacitors and Products Containing Same* (“*Ceramic Capacitors*”), the administrative law judge relied on *Encapsulated IC Devices* and *Network Controllers* to compel discovery regarding a declaration attached to the complaint where the complainant cited this evidence in response to contention interrogatories. Inv. No. 337-TA-692, Order No. 16 (Apr. 19, 2010). The waiver of work-product privilege was construed narrowly, applying only to the testing described in the declaration and specifically excluding the mental impressions, conclusions, or legal theories of attorneys. *Id.* at 7-8.

In other cases where complainants did not rely on complaint exhibits during discovery, administrative law judges have upheld the work-product protection for pre-filing testing. In *Certain Bulk Welding Wire Containers and Components Thereof and Welding Wire* (“*Welding Wire*”), the administrative law judge refused to compel the testimony of an attorney regarding pre-filing testing where there was no waiver of work-product protection. Inv. No. 337-TA-686, Order No. 37 (Feb. 22, 2010). Similarly, in *Certain Sintered Rare Earth Magnets, Methods of Making Same and Products Containing Same* (“*Rare Earth Magnets*”), the complainant did not cite any pre-filing documents as evidence of infringement during discovery, and there was thus no waiver of the work-product doctrine. Inv. No. 337-TA-855, Order No. 75 (Mar. 11, 2013).

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In *Certain Lithium Silicate Materials and Products Containing the Same* (“*Lithium Silicate Materials*”), documents reflecting pre-filing testing were properly withheld when this information was not relied upon during the course of the investigation. Inv. No. 337-TA-911, Order No. 13 (Sept. 8, 2014).

The facts on this motion more closely match the cases like *Encapsulated IC Devices*, *Network Controllers*, and *Ceramic Capacitors*, where the work-product doctrine was deemed to have been waived. Tessera cited to its complaint exhibits in its initial responses to discovery requests in July. See Mot. Ex. 4, 5, 10. Although Tessera now represents that it will not rely upon the complaint exhibits to prove infringement, this same argument was rejected in *Network Controllers*, where early interrogatory responses gave the impression that the complaint exhibits were to be used to prove infringement. *Network Controllers*, Order No. 15 at 6. Tessera’s initial interrogatory responses represent a waiver of work-product protection for the documents cited therein, and Tessera should not be permitted to use its pre-filing investigation as a “sword” in answer to interrogatory responses while relying on the “shield” of the work-product doctrine. See *Encapsulated IC Devices*, Order No. 53 at 9-10 (citing *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, 1997 WL 801454, \*1 (S.D.N.Y. 1997)). The scope of the waiver must be construed narrowly, however. See *In re Seagate Technology, LLC*, 497 F.3d 1360, 1375-76 (Fed. Cir. 2007) (“[T]he same rationale generally limiting waiver of the attorney-client privilege with trial counsel applies with even greater force to so limiting work product waiver because of the nature of the work product doctrine.”), *abrogated on other grounds by Halo Electronics, Inc. v. Pulse Electronics, Inc.*, 136 S.Ct. 1923 (2016). Tessera’s discovery responses cite to the complaint exhibits for a limited purpose, and any waiver of the work-product doctrine must be limited to the same scope.

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Broadcom seeks discovery regarding all Broadcom products that Tessera may have tested prior to filing the complaint, arguing for a broad subject-matter waiver. Mot. Mem. at 14-15; Reply at 7. None of the precedents cited by Broadcom support such a broad waiver, however. *See Fort James Corp. v. Solo Cup Co.*, 412 F.3d 1340, 1349-50 (Fed. Cir. 2005) (“There is no bright line test for determining what constitutes the subject matter of a waiver, rather courts weigh the circumstances of the disclosure, the nature of the legal advice sought and the prejudice to the parties of permitting or prohibiting further disclosures.”). Tessera’s July interrogatory responses identify specific exhibits to the complaint as evidence for infringement by specific Broadcom products. Mot. Ex. 4 (Interrogatory Nos. 1, 2, 4, 5, 7, 8); *see also* Mot. Ex. 10 (Interrogatory No. 38). Tessera’s contentions regarding additional Broadcom products do not rely on exhibits to the complaint or any other pre-filing evidence but merely rest on assertions that other products within the scope of the investigation also infringe. *Id.* at Interrogatory Nos. 1, 4, 7. Accordingly, Tessera’s waiver of work-product protection only applies to the pre-filing testing of products that are specifically identified in the cited exhibits to the Complaint, and not to every product that may have been tested.

Broadcom’s motion identifies hundreds of entries in Tessera’s privilege log, which represents a much broader set of documents than the waiver of work-product protection. Mot. Ex. 11. For example, responses to inquiries from Tessera’s outside counsel regarding pre-filing analysis identified in entries 978-1028 are likely to remain protected by attorney-client privilege even if work-product protection has been waived. *Id.* at 45-50. Many other entries in Tessera’s privilege log appear to be incorrectly marked as attorney-client privileged, however. Reports from third parties analyzing accused products, such as entries 1130-49, are not attorney-client privileged merely because they were received by an attorney. *Id.* at 56-58. The same is

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true for the photographs, optical images, scanning electron microscope results, X-ray images, and X-ray spectroscopy reports prepared by Tessera Labs identified in entries 2408-5621. *Id.* at 147-493. These documents may be work product because they were prepared for litigation, but as discussed above, this protection has been waived if the documents relate to products that were identified in the complaint exhibits cited in Tessera's interrogatory responses. *Id.* at 56-58. The descriptions of several other entries in the privilege log are insufficient to determine whether they fall within the scope of the waiver, such as the documents identified in entries 1354-1516 described only as "Materials re Broadcom pre-filing analysis and investigation collected for Covington & Burling." *Id.* at 72-82.

Accordingly, in response to Broadcom's requests for production nos. 75-86, Tessera shall produce the subset of documents from its privilege log that relate to the preparation of complaint exhibits 9-29, 81-85, 88-90, and 92, excluding documents that constitute legal advice and analysis or are protected by the attorney-client privilege. As discussed above, Tessera's waiver of work-product protection does not extend to products that were not identified in the complaint exhibits, but Tessera's production of documents should include all images and test results for the products identified in the complaint exhibits, even if these results were not used. In addition, in response to Broadcom's interrogatory nos. 11 and 71, Tessera shall identify the protocol(s) and processes used for testing and analysis (including any equipment and software used) and the individuals involved in the testing of the products identified in the complaint exhibits, to the extent that this information is not reflected in the documents.

### **B. Discovery of Post-Institution Testing**

Broadcom also seeks discovery regarding the testing of accused products and domestic industry products by Tessera after the institution of the Investigation. Mot. Mem. at 19-21;

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Reply at 9-14. Tessera argues that this testing was performed at the direction of its expert witnesses and is thus subject to the limitations of Federal Rule of Civil Procedure 26(b)(4), which the parties agreed to follow pursuant to a stipulation. Opp. at 17 (citing Stipulation Among the Parties at 4 (Aug. 5, 2016)). Moreover, Tessera argues that the parties agreed not to log privileged documents created after the filing of the complaint, which precludes any motion to compel pursuant to Ground Rule 4.9.2. *Id.* at 17-18; *see* Stipulation Among the Parties at 14; Order No. 2 at 14-15 (June 22, 2016).

Tessera's arguments regarding privilege are contradicted by its own representation that the infringement analysis was prepared at the direction of Tessera's experts rather than Tessera's attorneys. Opp. at 4-5, 9-10, 18. There is no work-product or any other privilege that precludes discovery regarding testing performed by or for an expert. The parties' agreement to follow Federal Rule of Civil Procedure 26(b)(4) also does not protect these documents, as the Advisory Committee Notes regarding the 2010 amendment to this rule explains:

Rules 26(b)(4)(B) and (C) do not impede discovery about the opinions to be offered by the expert or the development, foundation, or basis of those opinions. **For example, the expert's testing of material involved in litigation, and notes of any such testing, would not be exempted from discovery by this rule.** Similarly, inquiry about communications the expert had with anyone other than the party's counsel about the opinions expressed is unaffected by the rule. Counsel are also free to question expert witnesses about alternative analyses, testing methods, or approaches to the issues on which they are testifying, whether or not the expert considered them in forming the opinions expressed.

Fed. R. Civ. P. 26(b)(4), Advisory Committee Notes – 2010 Amendment (emphasis added).

Rule 26(b)(4) protects draft expert reports and communications between experts and attorneys, but it does not protect testing documents generated by an expert or communications between experts and persons engaged in testing. *See, e.g., Republic of Ecuador v. Mackay*, 742 F.3d 860,



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871 (9th Cir. 2014) (“We conclude that Rule 26(b)(3) does not provide presumptive protection for all testifying expert materials as trial preparation materials.”).

Accordingly, Tessera must identify and produce all non-privileged documents related to its post-institution testing of accused products and third-party products in response to Broadcom’s interrogatory nos. 12 and 72, and request for production no. 27. This production shall not be limited to the analysis conducted for Tessera’s infringement contentions but shall include all analysis performed by or for Tessera’s experts. In addition, Tessera must supplement its responses to interrogatory nos. 2, 5, and 8 to identify the persons most knowledgeable regarding its infringement contentions, and to specifically identify the products depicted in the images used in Tessera’s claim charts, citing to the relevant underlying documents.<sup>3</sup>

### III. CONCLUSION

For the reasons discussed above, Motion Docket No. 1010-050 is hereby GRANTED-IN-PART and DENIED-IN-PART. In response to Broadcom’s requests for production nos. 75-86, Tessera shall produce non-privileged documents reflecting its pre-filing analysis of the Broadcom products identified in the exhibits to the complaint. In response to Broadcom’s interrogatory nos. 11 and 71, Tessera shall identify the protocol(s) and processes used for testing and analysis (including any equipment and software used) and the individuals involved in the testing of the products identified in the complaint exhibits, to the extent that this information is not reflected in the documents. In response to Broadcom’s interrogatory nos. 12 and 72, and

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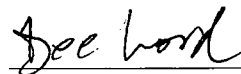
<sup>3</sup> Broadcom’s motion seeks disclosure of additional information regarding Tessera’s testing, including the locations, persons that participated, equipment and protocols, *see* Mot. Mem. at 18 (citing Mot. Ex. 12), but Broadcom’s contention interrogatories do not seek this information, asking only for “the factual and legal bases” for Tessera’s contentions, an “identification of the Person(s) most knowledgeable,” and “an identification of all Documents.” Mot. Ex. 4 (Interrogatory Nos. 2, 5, 8).

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request for production no. 27, Tessera shall identify and produce all non-privileged documents related to its post-institution testing of accused products and third-party products. In response to Broadcom's interrogatory nos. 2, 5, and 8, Tessera shall identify the persons most knowledgeable regarding its infringement contentions, and specifically identify the products depicted in the images used in Tessera's claim charts. Tessera must produce this discovery no later than December 23, 2016.

This Order is being issued with a confidential designation, and pursuant to Ground Rule 1.10, each party shall submit to the Administrative Law Judge a statement as to whether or not it seeks to have any portion of this order deleted from the public version within seven (7) days. *See* 19 C.F.R. § 210.5(f). A party seeking to have a portion of the order deleted from the public version thereof must attach to its submission a copy of the order with red brackets indicating the portion(s) asserted to contain confidential business information. The parties' submissions under this subsection shall not be filed with the Commission Secretary but shall be submitted by paper copy to the Administrative Law Judge and by e-mail to the Administrative Law Judge's attorney advisor.<sup>4</sup>

**SO ORDERED.**



Dee Lord  
Administrative Law Judge

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<sup>4</sup> To avoid depriving the public of the basis for understanding the result and reasoning underlying the decision, redactions should be limited. Parties who submit excessive redactions may be required to provide an additional written statement, supported by declarations from individuals with personal knowledge, justifying each proposed redaction and specifically explaining why the information sought to be redacted meets the definition for confidential business information set forth in Commission Rule 201.6(a).

**CERTAIN SEMICONDUCTOR DEVICES,  
SEMICONDUCTOR DEVICE PACKAGES, AND  
PRODUCTS CONTAINING SAME**

**Inv. No. 337-TA-1010**

**PUBLIC CERTIFICATE OF SERVICE**

I, Lisa R. Barton, hereby certify that the attached **ORDER** has been served by hand upon the following parties as indicated, on **January 13, 2017**



Lisa R. Barton, Secretary  
U.S. International Trade Commission  
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