

Miscellaneous No. 2006-830

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**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

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IN RE SEAGATE TECHNOLOGY, LLC.,  
Petitioner.

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On Petition for Writ of Mandamus to the  
United States District Court for the Southern District of New York  
in Case No. 00-CV-5141 (Hon. George B. Daniels)

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**BRIEF OF AMICUS CURIAE MEDIATEK, INC.  
IN SUPPORT OF PETITIONER  
AND IN SUPPORT OF REVERSAL**

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March 14, 2007

## CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rule 47.4, counsel for Amicus Curiae certifies that:

1. The full name of the amicus represented by me is:

MediaTek, Inc.

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

n/a

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the amicus curiae represented by me are:

None.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or are expected to appear in this Court are: Michael Barclay and Monica Mucchetti Eno of Wilson Sonsini Goodrich & Rosati, Palo Alto, California.

March 14, 2007

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## **STATEMENT OF IDENTITY AND INTEREST OF AMICUS CURIAE**

Amicus is a company that relies on the patent system to protect its innovations. MediaTek, Inc. is one of the world's largest fabless IC companies, and develops digital media integrated chipset solutions, among other things. Although amicus uses the patent system to protect its technology, amicus also deals with the costs of a patent system that arguably imposes an obligation to investigate every patent of which it may have become aware, and obtain an opinion of counsel or else risk a finding of willful infringement in any subsequent litigation. Amicus believes that the Federal Circuit's current "affirmative duty of care" standard, and the broad waiver of attorney-client privilege some district courts have imposed where opinions of counsel are relied upon, result in a legal framework that is one-sided and hurts innovation.

This brief is submitted in response to the Court's January 26, 2007 Order with the consent of petitioner and without the consent of respondents. No part of this brief was authored by counsel for any party and no party, person, or organization other than amicus and its counsel has made a monetary contribution to the preparation or submission of this brief.

## SUMMARY OF ARGUMENT

This brief discusses the “affirmative duty of care” standard for willful patent infringement. Though not based upon any statutory authority, Supreme Court precedent or pre-Federal Circuit authority, this Court’s “affirmative duty of care” standard has created a virtual obligation to get an opinion of patent counsel to rebut a claim of willful infringement. An accused infringer charged with willfulness will often rely on patent counsel’s opinion to show it acted with due care. This has led to plaintiffs seeking (and obtaining) discovery of a defendant’s otherwise privileged communications with both its patent opinion counsel *and* trial counsel. To avoid this unfair problem, the Court should clarify or change the law in this area.

As this brief discusses, the “affirmative duty of care” standard was promulgated by the Federal Circuit in *Underwater Devices*. However, a careful analysis of *Underwater Devices* reveals that the cases it relied upon do not stand for the proposition cited. Thus, the “affirmative duty of care” standard is not based upon any real precedent.

After this Court promulgated the “duty of care” standard, trial courts struggled with trying to determine the scope of the waiver of privilege when a defendant produced and relied upon an opinion in a patent case. Some district courts applied the general rule that a waiver of privilege as to one attorney-client communication waives the privilege as to all communications on the same subject

matter. Broad application of that rule resulted in orders allowing discovery of trial counsel's client communications, as has occurred in this writ proceeding. Other courts took the opposite approach, allowing discovery of opinion counsel but not trial counsel. Still other courts adopted various middle ground approaches. Simply stated, injecting opinions of counsel into patent cases has created an irreconcilable conflict between privilege law and this Court's willfulness jurisprudence.

Two of this Court's recent decisions have not clarified procedures in this area, and if anything have made the situation worse. The *Knorr-Bremse* decision eliminated adverse inferences from the failure to get an opinion or to produce it, but left the "affirmative duty of care" as the willfulness standard of this Circuit. The Court's *EchoStar* decision dealt with an issue not raised by this proceeding – waiver of uncommunicated work product – but the decision contained certain *dicta* that some trial courts have interpreted as requiring disclosure of trial counsel's client communications.

It is fundamentally unfair for an accused infringer to have to choose between surrendering its ability to communicate with its trial counsel, or else giving up an opinion of counsel and sacrificing its defense to willfulness and treble damages. Therefore, to resolve the problems caused by the conflicting case law, this Court should do one of two things. The Court should either (1) adopt a special rule in patent cases that there is no "subject matter waiver" so broad as to encompass trial

counsel's client communications, or (2) abolish the "duty of care" standard and modify the law of willful infringement so opinions of counsel are no longer needed.

## **ARGUMENT**

This brief has three major sections. The first section discusses the history and precedent behind the "affirmative duty of care" standard for willful patent infringement, and how this Court's adoption of that standard has injected attorney opinions into many patent cases. The second section analyzes the consequences of the use of those opinions, namely the creation of an insoluble conflict regarding the scope and waiver of attorney client privilege, particularly as to privileged communications with trial counsel. The third section contains recommendations for resolving the dilemma created by the historical development of the case law discussed in the first two sections.

### **I. THE "AFFIRMATIVE DUTY OF CARE" STANDARD IS NOT BASED ON THE PATENT STATUTE, ANY SUPREME COURT AUTHORITY, OR EVEN THE PRECEDENT THAT THE STANDARD IS SUPPOSEDLY BASED UPON**

#### **A. The "Affirmative Duty of Care" Standard Is Not Based on the Patent Statute or any Supreme Court Authority**

This Court first articulated the "affirmative duty of care" standard in *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1389-90 (Fed. Cir. 1983). That test for willful infringement cannot be found in the patent statute or in any Supreme Court precedent. 35 U.S.C. § 284 sets forth the basis for a

damages award to the patent owner, but does not mention either willfulness or any “affirmative duty of care.” The statute merely provides that “the court may increase the damages up to three times the amount found or assessed.” 35 U.S.C. § 285 governs the award of attorney fees, but only states that “[t]he court in exceptional cases may award reasonable attorney fees to the prevailing party.” Again, there is no mention of willfulness or any duty of care. Versions of the statute before the Patent Act of 1952 did not discuss willfulness or a duty of care either. *See Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1349-50 (Fed. Cir. 2004) (*en banc*) (Dyk, J., concurring-in-part and dissenting-in-part).

No Supreme Court case has discussed, let alone approved, any “duty of care” standard, either before or after the creation of the Federal Circuit. The Court had implied that a high level of intent or willfulness was required to impose enhanced damages. For example, *Seymour v. McCormick*, 57 U.S. 480, 488 (1853), criticized as unjust the mandatory treble damage provisions that were in effect before the Patent Act of 1836. The Court reasoned that mandatory punitive damages meant that “[t]he defendant who acted in ignorance or good faith, claiming under a junior patent, was made liable to the same penalty with the wanton and malicious pirate.” *Seymour* instead spoke of awarding exemplary damages for “wanton or malicious” behavior. *Id.* at 489. *See also Aro Mfg. Co. v. Convertible Top Replacement Co.*,

377 U.S. 476, 508 (1964) which noted *in dicta* that treble damages would be available for “willful or bad faith” infringement.

Thus, the “affirmative duty of care” standard has no support either in the literal language of the Patent Act or in any Supreme Court authority. Indeed, the Supreme Court precedent indicates that treble damages can be awarded only if a defendant’s behavior is far more reprehensible than a mere breach of a “duty of care.”

**B. Properly Analyzed, the Pre-Federal Circuit Precedent that *Underwater Devices* Relied Upon Does Not Hold that an “Affirmative Duty of Care” Exists in All Patent Cases**

*Underwater Devices* relied upon certain pre-Federal Circuit authority as support for an “affirmative duty of care” as the willfulness standard in all patent cases. Properly analyzed, those cases do not support *Underwater Devices*’ holding.

In *Underwater Devices*, the Court recited two aspects of its standard for willful infringement. First, the Court held that where “a potential infringer has actual notice of another’s patent rights, he has an affirmative duty to exercise due care to determine whether or not he is infringing.” *Underwater Devices*, 717 F.2d at 1389. Second, the Court stated that the affirmative duty “includes, *inter alia*, the duty to seek and obtain competent legal advice from counsel *before* the initiation of any possible infringing activity.” *Id.* at 1390 (italics in original). Properly analyzed, however, the cited case law does not support *either* of those propositions.

1. On the first point – the “affirmative duty to exercise due care” point – *Underwater Devices* cited only one case: *Milgo Electronic Corp. v. United Business Communications, Inc.*, 623 F.2d 645, 666 (10th Cir.), *cert. denied*, 449 U.S. 1066 (1980). *Milgo* involved an accused infringer who surreptitiously obtained and reversed engineered one of Milgo’s products, “faithfully copied” the product, and thus had engaged in infringement that was not “merely accidental or negligent.” *Id.* at 652, 666. Given those facts, plus the lack of any opinion of counsel, the Tenth Circuit affirmed the trial court’s finding of willfulness. That court said that under those circumstances, the defendant “was under an affirmative duty to exercise due care” to determine whether or not it was infringing, but did not require or suggest that an opinion of counsel satisfied this duty. *Id.*

In support of its “affirmative duty to exercise due care” language, *Milgo* only cited *Coleman Co. v. Holly Mfg. Co.*, 269 F.2d 660, 666 (9th Cir.), *cert denied*, 352 U.S. 952 (1959). But in *Coleman*, the Ninth Circuit did *not* hold that there *was* any “affirmative duty” to exercise care as a legal standard. Rather, the Ninth Circuit merely held that the district court was justified in finding willful infringement based on its particular factual findings. These findings included, among other things, the fact that Coleman had “faithfully copied” Holly’s heater, that Coleman had “deliberately pirated” Holly’s invention, and that, as a *factual* matter, after Coleman

had notice of the patent, it did not “exercise due care” to determine whether or not it was infringing. *Id.* at 663, 666.

Thus, the “affirmative duty of care” standard crept into this Court’s case law in the absence of any real precedent holding that such a duty exists – *Milgo* relied upon *Coleman* for the alleged standard, but all *Coleman* did was affirm a trial court’s factual finding.

2. The second aspect of the “affirmative duty of care” standard recited by *Underwater Devices* is the “duty” to obtain “advice of counsel” before the initiation of any possible infringing activity. *Underwater Devices* relied upon two cases for this proposition (*see* 717 F.2d at 1390): *General Electric Co. v. Sciaky Bros., Inc.*, 415 F.2d 1068, 1073-74 (6th Cir. 1969); and *Marvel Specialty Co. v. Bell Hosiery Mills, Inc.*, 386 F.2d 287 (4th Cir. 1967), *cert. denied*, 390 U.S. 1030 (1968).

As is the situation for the first part of the *Underwater Devices* standard, neither of the cited cases supports the proposition that there is any “affirmative duty” to get an opinion of counsel. In *General Electric*, the Sixth Circuit affirmed the trial court’s finding of General Electric’s willful infringement based upon GE having “pirated” the patents in question, deliberately copying the inventions, doing so in the face of “serious competitive pressure” to use the patented inventions, having no opinions of outside counsel that such piracy was being done in good faith, and a host of other detailed factors. *Id.* at 1072-74. Significantly, *General*



*Electric* nowhere held that opinions were part of any “affirmative duty of care.” At most, the court stated that “a good faith opinion by competent and independent patent counsel *may* be important evidence to be weighed on the issue of ‘honest doubt’ of patent validity.” *Id.* at 1073 (italics added).

Similar to the other three cases that form the so-called basis for the *Underwater Devices* rule, *Marvel Specialty* also involved a situation of intentional copying of the patent owner’s machines, including the defendant’s president’s admission that his machine was “quite similar” to the patented machine. On these facts, including the failure to seek any opinion of counsel, the Tenth Circuit merely affirmed the trebling of some (but not all) damages. There was no holding in *Marvel* that either “an affirmative duty of care” exists or that such “duty” requires an opinion of counsel. 386 F.2d at 289, 292.

Thus, the four pre-Federal Circuit cases *Underwater Devices* relied upon for an “affirmative duty of care” do not support that rule as the willfulness standard that now exists in all patent cases. At most, those four cases involved active, intentional copying or piracy by the accused infringer which is not present in most patent cases litigated today. They certainly do not represent the situation common in many patent cases, where an accused infringer has independently created his technology, built up a large business, and done so without any knowledge or notice of the patent in question.

In *Underwater Devices*, it was unclear whether the defendant was a deliberate copyist (as in the four pre-Federal Circuit cases discussed above), or rather instead had no knowledge of the patent until after the defendant had successfully bid to use its own technology to construct the infringing project. 717 F.2d at 1384. *Underwater Devices* nevertheless stated the “affirmative duty of care” as a general standard, and following *Underwater Devices*, the pre-Federal Circuit correlation between intentional copying and any possible “duty of care” has simply disappeared.

Therefore, at best, the *Underwater Devices* standard is based upon an unwarranted extension of pre-Federal Circuit precedent. At worst, it is made up out of whole cloth.

**C. Post-*Underwater Devices* Cases Have Compounded the Problem by Elevating the Duty of Care to a Virtual Obligation to Obtain a Patent Opinion**

The Court’s cases following *Underwater Devices* expanded upon the “affirmative duty of care” standard to impose a virtual obligation to get an opinion of counsel in all patent cases. By “virtual obligation,” it is meant that, as the Court’s caselaw makes clear, an opinion of counsel is not mandatory in order to avoid willful infringement. However, the Court has dealt with willful infringement in such a manner as to make opinions of counsel a practical necessity in most if not all circumstances. For example, *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 1428-

29 (Fed. Cir. 1988), stated that the lack of an opinion of counsel was “not determinative.” The Court nevertheless reversed the district court’s factual finding of no willfulness because of the very lack of an opinion. According to *Ryco*, this meant “the complete absence of any possible basis for the [district] court’s finding” that the accused infringer believed that the patent was invalid or not infringed. *Id.*

This Court’s broad applicability of the duty of care standard is most notable in two cases where the first notice of the patent to the defendant was the filing of the lawsuit. In such cases, there is no argument of copying of the patent, and one might think that the assertion of good faith defenses to infringement during the lawsuit would be sufficient to avoid willfulness. However, this Court has rejected that proposition. *See Crystal Semiconductor Corp. v. TriTech Microelectronics Int’l, Inc.*, 246 F.3d 1336, 1352 (Fed. Cir. 2001) (stating that “defenses prepared for a trial are not equivalent to the competent legal opinion of non-infringement or invalidity which qualify as ‘due care’ before undertaking any potentially infringing activity”); *Advanced Cardiovascular Sys., Inc. v. Medtronic, Inc.*, 265 F.3d 1294, 1310 (Fed. Cir. 2001) (where suit was filed only one month after the patent issued, defendant could have “precluded any possibility that willful infringement would be alleged by taking appropriate steps,” namely an opinion of counsel).

Where the first notice of a patent is the filing of the lawsuit, there is a serious problem with this Court’s virtual obligation of obtaining an opinion of counsel as it

relates to the issues presented by this writ petition. Necessarily, any such opinion of counsel will be obtained during the lawsuit, after the defendant has already retained trial counsel – as in *Advanced Cardiovascular v. Medtronic*, for example. When such opinions are obtained from separate opinion counsel, nevertheless trial counsel will simultaneously be advising the client on the strengths and weaknesses of the case, including the infringement and validity issues that would be the subject of any opinion so obtained during the litigation. The Court’s virtual requirement of an opinion of counsel under these circumstances emphatically highlights the problem of waiver of privilege as to trial counsel.

**D. The Court’s *Knorr-Bremse* Decision only Partially Solved the Problem by Eliminating the Negative Inference Rule**

Cases before the 2004 *Knorr-Bremse* decision had gone even further than the cases discussed in the previous section, and had created the so-called “negative inference” rule, where the jury could infer willfulness merely from the failure to produce an opinion of counsel or from the assertion of privilege if opinions had been obtained. 383 F.3d at 1343. Realizing the deleterious effect that such a rule has on the attorney-client privilege, *Knorr-Bremse* overruled that precedent and abolished the negative inference. *Id.* at 1344-46.

However, *Knorr-Bremse* did not go so far as to abolish the “affirmative duty of care” standard, and hold that the existence of a substantial defense to infringement is sufficient to defeat willfulness even if no legal advice had been

secured. *Id.* at 1347 (answering Question 4 in the negative). *Knorr-Bremse* thus retained the virtual obligation to obtain opinions of counsel discussed above. The current state of the law therefore remains that in virtually all patent cases, even including ones where the first notice of the patent is the filing of the lawsuit, an opinion of counsel is likely necessary to show “whether a prudent person would have sound reason to believe that the patent was not infringed or was invalid or unenforceable.” *Id.*, quoting *SRI Int’l, Inc. v. Advanced Tech. Labs. Inc.*, 127 F.3d 1462, 1465 (Fed. Cir. 1997).

## **II. THE INJECTION OF PRIVILEGED OPINIONS IN PATENT CASES HAS CREATED AN INSOLUBLE CONFLICT REGARDING THE SCOPE OF THE WAIVER OF ATTORNEY-CLIENT PRIVILEGE**

Following the Court’s 1983 *Underwater Devices* opinion, defendants in patent cases began obtaining and using opinions of counsel as a regular practice. It was generally accepted that such opinions waived privilege between the client and opinion counsel. However, many plaintiffs were not satisfied with obtaining just the opinions themselves. Rather, many plaintiffs used the waiver of privilege caused by the production of the opinion as an excuse to seek far greater and more invasive discovery of the defendant and its various counsel. Thus, in parallel with this Court’s development of the duty of care standard discussed in the previous section, trial courts across the country began struggling with how to deal with the

scope of the privilege waiver. As will now be shown, that struggle is notable for its lack of uniformity among the trial courts.

**A. The General Rule in Non-Patent Cases Is that Waiver of Privilege as to One Communication Waives the Privilege on All Communications on the Same Subject Matter**

As a starting point in analyzing the waiver of privilege, many trial courts turned to the general rules in non-patent cases. The general rule is that a voluntary disclosure of the content of a privileged attorney communication constitutes waiver of the privilege as to all other communications on the same subject. *See, e.g., U. S. v. Workman*, 138 F.3d 1261, 1263-64 (8th Cir.1998); *Glenmede Trust Co. v. Thompson*, 56 F.3d 476, 486-87 (3d Cir. 1995); *U.S. v. Jones*, 696 F.2d 1069, 1072 (4th Cir. 1982); *Weil v. Investment/Indicators Research and Management, Inc.*, 647 F.2d 18, 24 (9th Cir. 1981). The rule is based upon a notion of fairness – that it would be unfair for the party waiving the privilege to selectively disclose some privileged communications while protecting others that may not be as favorable to the party’s position. *Glenmede*, 56 F.3d at 486-87; *Weil*, 647 F.2d at 24.

This Court has also applied this general rule, albeit in situations different than ones seeking communications with trial counsel. *Fort James Corp. v. Solo Cup Co.*, 412 F.3d 1340, 1349 (Fed. Cir. 2005), *cert. denied*, 126 S.Ct. 1768 (2006); *GFI, Inc. v. Franklin Corp.*, 265 F.3d 1268, 1273 (Fed. Cir. 2001).

**B. Trial Courts Have Reached Wildly Conflicting Results on the Scope of Waiver of Privilege Involving Patent Opinions, Especially as to Communications With Trial Counsel**

Applying the general principle of subject matter waiver has proven to be difficult and controversial in the context of patent opinions, however. In non-patent cases, the disclosure of some privileged communications is usually truly voluntary, and not mandated by any substantive legal principle requiring the use of opinions of counsel – unlike the situation in patent cases. For example, in *Weil v. Investment/Indicators*, the defendant in a securities law case voluntarily chose to disclose certain privileged communications to establish lack of intent to deceive. 647 F.2d at 23. It does not appear that the substantive securities law *required* the disclosure of such privileged materials.

By contrast, in patent cases, the “affirmative duty of care” standard virtually requires obtaining and producing an opinion of counsel as to non-infringement and/or invalidity, while at the same time the defendant and its trial counsel are litigating, and discussing, those very issues. For perhaps such reasons, one trial court questioned whether the law in non-patent cases should even apply, and criticized other trial court decisions that said so. *Steelcase, Inc. v. Haworth, Inc.*, 954 F. Supp. 1195, 1199 (W.D. Mich. 1997) (“[T]hese cases do not attempt to divine from Federal Circuit authority any controlling principle grounded in

substantive patent law. In fact, these cases . . . rely upon district court opinions in patent cases or in general civil litigation.”)

In any event, in trying to apply the general legal principle of privilege waiver but at the same time recognizing the difficulty of applying that waiver to trial counsel communications, trial courts have issued wildly varying opinions on the subject over the last two decades.

**1. Some Trial Courts, Including the One in This Case, Have Found a Waiver of Privilege as to Trial Counsel**

Some trial courts, including the trial court in this case, have held that the waiver of privilege applied to communications from all attorneys, including trial counsel. *See, e.g., Convolve, Inc. v. Compaq Computer Corp.*, 224 F.R.D. 98, 102-04 (S.D.N.Y. 2004) (finding waiver of privilege as to both Seagate’s opinion and trial counsel with essentially no temporal limitation); *Akeva L.L.C. v. Mizuno Corp.*, 243 F.Supp.2d 418, 423 (M.D.N.C. 2003); *McCormick-Morgan, Inc. v. Teledyne Indus., Inc.*, 134 F.R.D. 275, 280 (N.D. Cal. 1991), *rev’d in part by McCormick-Morgan, Inc. v. Teledyne Indus., Inc.*, 765 F. Supp. 611, 613-14 (N.D. Cal. 1991).

Such courts have applied the “fairness” principle of privilege waiver strictly, finding that waiver as to one attorney (opinion counsel) serves as waiver as to all attorneys, including trial counsel. *See, e.g., Convolve*, 224 F.R.D. at 103-04; *Akeva*, 243 F.Supp.2d at 423.



## **2. Some Trial Courts Have Not Found a Waiver of Privilege as to Trial Counsel, or at Least Have Limited Any Such Waiver**

In contrast, other trial courts refused to order discovery about communications with trial counsel, or at least imposed practical limitations on any such discovery. For example, some courts imposed temporal limitations, refusing to allow discovery from trial counsel after the complaint was filed, so as to preserve the sanctity of litigation strategy. *See, e.g., Dunhall Pharmaceuticals, Inc. v. Discus Dental, Inc.*, 994 F.Supp. 1202, 1205-06, 1210 (C.D. Cal. 1998) (noting that it “is neither equitable nor fair” to require the defendant to chose “between surrendering its litigation files or sacrificing a fair defense to exceptional damages”); *Electro Scientific Indus., Inc. v. General Scanning, Inc.*, 175 F.R.D. 539, 546-47 (N.D. Cal. 1997); *Hoover Universal, Inc. v. Graham Packaging Corp.*, 44 U.S.P.Q.2d 1596, 1598 (C.D. Cal. 1996); *Kelsey-Hayes Co. v. Motor Wheel Corp.*, 155 F.R.D. 170, 172 (W.D. Mich. 1991).

Other trial courts limited the scope of waiver by only allowing discovery into communications by trial counsel which “contradict” or “cast doubt” upon the opinion counsel’s conclusion. *See, e.g., Beneficial Franchise Co. v. Bank One N.A.*, 205 F.R.D. 212, 217-19 (N.D. Ill. 2001); *Nitinol Med. Techs., Inc. v. AGA Med. Corp.*, 135 F. Supp.2d 212, 220 (D. Mass. 2000); *Micron Separations, Inc. v. Pall Corp.*, 159 F.R.D. 361, 365 (D. Mass. 1995).

Notably, in this case the trial court imposed neither a temporal limitation on the subject matter waiver, nor a limitation restricting discovery to “contradictory” opinions. 224 F.R.D. at 104-05.

### **3. At Least One Trial Court Has Recognized the Implications of Trial Counsel Waiver and Has Changed Its Position**

At least one trial judge, having surveyed the wreckage caused by the split in trial court authority over the years, has changed his mind. In an initial opinion during the 1990’s, Magistrate Judge Brazil of the Northern District of California ordered broad discovery as to all attorneys. *McCormick-Morgan*, 134 F.R.D. 275. Subsequently, in a 2004 opinion, Judge Brazil stated that he had “changed [his] mind about the scope of the waivers.” *Sharper Image Corp. v. Honeywell Intern., Inc.*, 222 F.R.D. 621, 625 (N.D. Cal. 2004), *modified to clarify lack of waiver as to trial counsel*, *Sharper Image Corp. v. Honeywell Intern., Inc.* (N.D. Cal. No. C 02-4860, Docket No. 216, September 8, 2004). In *Sharper Image*, Judge Brazil conducted a lengthy historical discussion of the law on privilege waivers as it existed as of that time, and discussed the interplay between the law of willfulness and privilege waivers. *Id.* at 624-25, 628-34. Judge Brazil stated:

Because the waivers with which the law is generally most comfortable are truly voluntary, and because substantive patent law has evolved in a direction that injects a substantial element of involuntariness into waivers in the setting we address here, courts should be careful not to define the scope of these waivers more broadly than is justified by the fairness objectives on which waiver doctrine is supposed to turn.

*Id.* at 632. He noted the “quandary” posed by forcing defendants to choose between two unfair situations: (1) losing confidentiality of communications with trial counsel to the benefit of their opponent/competitor, or (2) losing the ability to present the “most effective defense” to willful infringement. *Id.* at 637. Thus, Judge Brazil concluded that there should be no waiver of privilege as to trial counsel after the time the complaint was served:

We base this holding on the following considerations. First, in patent litigation between competitors, disabling a defendant from having a confidential relationship with its lead trial counsel about matters central to the case would cause considerable harm to the values that underlie the attorney-client privilege and the work product doctrine. Second, because of the perceived centrality to this kind of litigation of word gaming, there is a considerable risk that a defendant in these kinds of cases who could not have a confidential relationship with its lead trial counsel would be at a considerable disadvantage. In some circumstances, the magnitude of that disadvantage could threaten basic due process (fairness) values and could dislodge essential underpinnings of the adversary system. Third, in patent litigation a *perception* that the defendant’s ability to maintain a confidential relationship with its trial counsel was seriously impaired would distort the balance of power between the parties, giving plaintiffs unfair leverage in settlement negotiations. Such a perception also would encourage the filing of claims of willful infringement without regard to their merit.

*Id.* at 643 (italics in original). *See also Collaboration Properties, Inc. v. Polycom, Inc.*, 224 F.R.D. 473, 476-77 (N.D. Cal. 2004), following *Sharper Image*.

**C. Although This Court’s *EchoStar* Decision Did Not Address or Resolve the Trial Counsel Waiver Issue, *EchoStar* Has Caused Further Confusion Among the District Courts**

**1. Properly Analyzed, *EchoStar* Was Limited to the Issue Before It – Discovery of Uncommunicated Work Product by Opinion Counsel – and Did Not Hold that Trial Counsel’s Communications Are Waived**

After the case law discussed in the previous section, this Court decided *In re EchoStar Communications Corp.*, 448 F.3d 1294 (Fed. Cir.), *cert. denied*, 127 S.Ct. 846 (2006). Properly analyzed, *EchoStar* has no bearing on the issue presented in this case, that of waiver of privilege with trial counsel. *EchoStar* decided the scope of waiver of attorney work product in the possession of EchoStar’s opinion counsel, but that was not communicated to the client as part of the attorney opinion. *Id.* at 1297. The Court noted the distinction between the attorney-client privilege and the work product doctrine. *Id.* at 1300-01. After analyzing the issues, the Court concluded that the advice of counsel defense was not implicated by uncommunicated work product, and held that such uncommunicated work product was not subject to discovery. *Id.* at 1304-05.

*EchoStar* did not deal with the issue, and therefore did not decide the issue, of communications with trial counsel. At issue in *EchoStar* were opinions of counsel from (1) in-house counsel; and (2) the Merchant & Gould firm. *Id.* at 1297. EchoStar had different counsel – the Morrison & Foerster firm – as its trial counsel.

*Id.* at 1296. The balance of the opinion was directed to Merchant & Gould's uncommunicated work product.

Nevertheless, certain *dicta* in *EchoStar*, made as merely part of a general discussion of the law of privilege, could be read as applying to communications with more than just EchoStar's two types of opinion counsel. For example, the Court stated that "when EchoStar chose to rely on the advice of in-house counsel, it waived the attorney-client privilege with regard to any attorney-client communications relating to the same subject matter, including communications with counsel other than in-house counsel, which would include communications with Merchant & Gould." *Id.* at 1299. Footnote 4 of *EchoStar* also rejected the concept that waiver does not extend to work product created after the litigation began, stating that this "is not the case when the advice is relevant to ongoing willful infringement, so long as that ongoing infringement is at issue in the litigation." *Id.* at 1302 n.4. Again, this language in *EchoStar* is at most *dicta*, or at most applies solely to the second opinion counsel, Merchant & Gould.

Regrettably, as it has turned out, these statements in *EchoStar* have led to further confusion by the trial courts on the issue of waiver of privilege as to trial counsel.

## 2. Some Trial Courts Have Relied on *Dicta* in *EchoStar* to Find a Waiver of Privilege as to Trial Counsel

Following *EchoStar* some trial courts relied on this Court's opinion to justify a waiver of privilege as to trial counsel. *See, e.g., Informatica Corp. v. Business Objects Data Integration, Inc.*, 454 F.Supp.2d 957, 963-65 (N.D. Cal. 2006) ("it is immaterial whether BODI's opinion counsel and trial counsel are from the same firm, different firms or are even the same person"), *aff'd*, 2006 WL 2329460 (N.D. Cal. August 9, 2006); *Affinion Net Patents, Inc. v. Maritz, Inc.*, 440 F.Supp.2d 354, 356-57 (D. Del. 2006); *Beck Systems Inc. v. ManageSoft Corp.*, No. 05-C-2036, 2006 WL 2037356 (N.D. Ill. July 14, 2006).

In contrast, another district court recognized that *EchoStar* did not address the issue of communications with trial counsel, and rejected any reading of *EchoStar* to extend the waiver to trial counsel. *Ampex Corp. v. Eastman Kodak Co.*, No. 04-1373, 2006 W.L. 1995140 (D. Del. July 17, 2006).

Still another district court took a third or "middle" ground, permitting discovery as to trial counsel communications, but only those that "contradict" the trial counsel's opinions. *Intex Recreation Corp. v. Team Worldwide Corp.*, 439 F.Supp.2d 46, 51-53 (D.D.C. 2006). Finally, yet another trial court adopted even a different "middle ground" approach. *Genentech, Inc. v. Insmmed Inc.*, 442 F.Supp.2d 838, 846-47 (N.D. Cal. 2006). Instead of allowing discovery as to contradictory advice of trial counsel, *Genentech* allowed discovery of communications "that are

most akin” to formal or informal opinions, but not allowing discovery as to “lower level documents” that are “more akin to discussions of trial strategy.” *Id.* at 847.

In sum, trial court rulings regarding waiver of privilege as to trial counsel communications had become wildly divergent even by the time of this Court’s *EchoStar* decision last year. Unfortunately, *EchoStar* has only made things worse.

**III. THIS COURT SHOULD RESOLVE THIS DILEMMA BY EITHER  
(A) SQUARELY ESTABLISHING A SPECIAL RULE OF WAIVER FOR TRIAL  
COUNSEL IN PATENT CASES, OR (B) OVERRULING THE AFFIRMATIVE  
DUTY OF CARE STANDARD AND HOLDING THAT WILLFULNESS  
REQUIRES INTENTIONAL COPYING OR OTHER REPREHENSIBLE  
BEHAVIOR, THUS ELIMINATING THE ROLE OF OPINIONS OF COUNSEL**

**A. The Court Should Resolve the Muddled Precedent by a  
Definitive En Banc Resolution**

The previous two sections of this brief show that the result of superimposing the Court’s “affirmative duty of care” standard on the general law of privilege waiver has been to create an unworkable mess among the trial courts. The analysis of privilege waiver varies greatly from district to district, and indeed even between different judges within the same district (the Northern District of California and the District of Delaware being two examples). Parties and their counsel cannot rationally predict how a court will rule on privilege waiver. Trial counsel communications might be subject to discovery, or they might not. There might be limitations as to timeframe or not. Discovery might or might not be limited to

opinions that contradict opinion counsel's conclusions, or they might or might not be limited to trial counsel's communications that are "akin" to opinion counsel's conclusions, but not "akin" to trial strategy.

This Court should resolve the muddled precedent if for no other reason than to eliminate the present state of chaos before the district courts.

**B. Trial Counsel's Communications Should Not Be Discoverable**

There are several possible resolutions of the issues presented by this writ petition. One resolution which is *not* workable would be to deny the writ and hold the trial counsel's communications are discoverable. This is the case for both substantive and procedural reasons.

Substantively, cases such as *Sharper Image* point out how such a ruling would unfairly intrude upon a defendant's ability to defend itself in a patent case. Allowing discovery of trial counsel communications would effectively leave a patent infringement defendant unable to defend itself. Neither a defendant nor its trial counsel could have the slightest communications about the merits of the case without it being subject to discovery by the plaintiff. No defendant could ever obtain competent counseling regarding litigation strategy without fear that opposing counsel would become a party to all such discussions. The only way a defendant could avoid this unworkable scenario would be to refrain from obtaining or



producing an opinion of counsel, which would leave the defendant virtually defenseless against a finding of willful infringement.

It is bad enough that discovery of opinion counsel often provides the plaintiff with a road map to the defense theories in a case; giving the plaintiff unfettered access to defendant's trial strategy, up until the very trial, would tip the balance of power dangerously far in favor of the plaintiff. Trial preparation and strategy are a sacrosanct part of the American judicial system, and an open and honest attorney-client relationship is needed to make the system work. In this context, this Court has noted "the fundamental values sought to be preserved by the attorney-client privilege." *Quantum Corp. v. Tandon Corp.*, 940 F.2d 642, 643 (Fed. Cir. 1991). Discovery of trial counsel communications is thus unwarranted. *See Sharper Image*, 222 F.R.D. at 643.

Procedurally, given the plethora of sub-issues dealing with the scope of trial counsel discovery, the Court would either have to make a broad, sweeping ruling that is highly unfair to defendants, or adopt some narrower "middle ground" decision that would still result in an ongoing morass of litigation in the trial courts about the scope of waiver. For instance, an *in camera* review of trial counsel communications (as the trial court here and other courts have suggested) would be an enormous burden to impose on trial courts in patent cases generally, and would

still imprudently force the defendant to disclose its trial strategy to the very judges that will rule on the merits of the case.

**C. There are Two Workable Resolutions of the Issues Presented by This Writ Petition**

Thus, the only two workable resolutions to the issues are as follows. First, the Court could hold that the client's communications with its trial attorneys are not waived when a client obtains and relies upon an opinion by different opinion attorneys. (Note that this writ proceeding does not involve the somewhat rare situation these days where the opinion attorney is also one of the trial attorneys. *Convolve*, 224 F.R.D. at 103.) This approach has the advantage that it would provide uniform guidance to the district courts without any need for revisiting this Court's substantive jurisprudence on willful infringement, including Question 3 of the January 26, 2007 Order.

However, that resolution does have its problems. As to the law of privilege waiver, it would create a split in authority between this circuit and between virtually every other circuit. Indeed, *Knorr-Bremse* stated that “[w]e conclude that a special rule affecting attorney-client relationships in patent cases is not warranted.” 383 F.3d at 1344. Therefore, if no special rule in patent cases is to be created, then resolving this issue requires squarely addressing Question 3 and the root of the problem: the Court's “affirmative duty of care” jurisprudence.

As illustrated in section I of this brief, the need for any special rule of privilege affecting trial counsel only arises because the “affirmative duty of care” standard imposes a virtual obligation to obtain an opinion of counsel and waive the privilege as to that opinion. (The need for a special rule is enhanced in most cases where the alleged infringement continues following filing of the suit, so trial counsel continues to advise the client on the same subjects as the opinion.) Eliminating the duty of care standard would eliminate the need for opinions and eliminate any issue of waiver of privileged communications with trial counsel.

However, to do this, the Court would need to change its substantive law on willful infringement. A “duty of care” standard implies that the defendant must do something to show that it exercised care – i.e., it is essentially a negligence standard. That “something” could be satisfied by an opinion of counsel as long as the standard exists. If the standard is abolished, it would have to be replaced with a higher standard of willfulness. As discussed in section I of this brief, that standard should require some sort of higher degree of culpability before treble or punitive damages would be required, such as deliberate copying of the patent, or other reprehensible behavior traditionally justifying punitive damages. *Knorr-Bremse*, 383 F.3d at 1349-52 (Dyk, J. concurring-in-part and dissenting-in-part).

While abolishing the “affirmative duty of care” standard would significantly change the precedential law regarding willfulness, the majority in *Knorr-Bremse*

noted that abandoning stare decisis is justified where the “conceptual underpinnings” of precedent “have significantly diminished in force.” 383 F.3d at 1344. In this situation, (1) section I of this brief showed that the “conceptual underpinnings” of the duty of care standard rested on shaky grounds to begin with, and (2) section II of this brief showed that problems with privilege waiver mean that the standard has caused more difficulties than could ever have been anticipated by the 1983 *Underwater Devices* decision. Thus, there is no analytical bar to overruling precedent in this situation.

### CONCLUSION

The Court should therefore either answer Question (1) of the January 26 Order in the negative – declining to extend waiver of the privilege to communications with trial counsel – or answer Question (3) in the affirmative, to reconsider and abolish the *Underwater Devices* duty of care standard for willful infringement.

March 14, 2007

Respectfully submitted,

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## CERTIFICATE OF SERVICE

I hereby certify that the foregoing Brief of Amicus Curiae MediaTek, Inc., was filed on this date pursuant to Fed. R. App. P. 25(a)(2)(B)(ii) by dispatch of the original and thirty copies by Federal Express for delivery to the clerk on the next business day, addressed as follows:

Clerk of the United States Court of Appeals for the Federal Circuit  
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On the same date, two true and correct copies of the foregoing Brief of Amicus Curiae MediaTek, Inc. were served on counsel for all parties on this date by Federal Express, addressed as follows:

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**CERTIFICATE OF COMPLIANCE  
WITH TYPE-VOLUME LIMITATION,  
TYPEFACE REQUIREMENTS, AND TYPE STYLE REQUIREMENTS  
PURSUANT TO FED. R. APP. P. 32(a)(7)(C)**

I hereby certify as follows:

1. The foregoing Brief of Amicus Curiae MediaTek, Inc. complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B). The brief is printed in proportionally spaced 14-point type, and there are 6628 words in the brief according to the word count of the word-processing system used to prepare the brief (excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii), that is, the tables of contents and citations, and certificates of counsel, and by Fed. Cir. R. 32(b), that is, the certificate of interest, the statement of related cases, and the addendum in an initial brief of an appellant).

2. The brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5), and with the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). The brief has been prepared in a proportionally spaced typeface using Microsoft Word 2003 (11.6568.8005) SP2 in 14-point Times New Roman.

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