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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

Before The Honorable Eumi K. Lee, District Judge

NUMBER 14 B.V., )  
 )  
Plaintiff, )  
 )  
vs. ) No. C 24-02435-EKL  
 )  
ANALOG DEVICES, INC., et al., )  
 )  
Defendants. )  
\_\_\_\_\_ )

San Jose, California  
Wednesday, May 14, 2025

TRANSCRIPT OF PROCEEDINGS OF THE OFFICIAL ELECTRONIC  
SOUND RECORDING 2:01 - 2:51 = 50 MINUTES

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1 Wednesday, May 14, 2025

2:01 p.m.

2 P-R-O-C-E-E-D-I-N-G-S

3 --oOo--

4 THE CLERK: Okay. We're going to be -- for our  
5 next case, we're calling Case Number 5:24-cv-2435-EKL,  
6 Number 14 B.V. versus Analog Devices, Inc., et al., for a  
7 further case management conference.

8 Counsel, please state your appearances for the record,  
9 starting with counsel for the Plaintiff.

10 MR. HARBIN (via Zoom): Yes. John Harbin with  
11 Meunier, Carlin and Curfman, your Honor, for the Plaintiff.  
12 Also with me is my partner, Warren Thomas.

13 And, Rachel, you want to do it yourself?

14 MS. THOMAS (via Zoom): Yes, and thank you, Mr.  
15 Harbin.

16 Rachel Thomas from Greenfield on behalf of Plaintiff.

17 THE COURT: All right. Good afternoon to you all.

18 MR. HARBIN: Good afternoon.

19 MR. ISAACSON (via Zoom): And good afternoon, your  
20 Honor. Kevin Isaacson and Michael Ioannou from Ropers  
21 Majeski on behalf of the Defendants, Analog Devices and  
22 Maxim Integrated.

23 THE COURT: Good. Good afternoon. It's good to  
24 see everybody again.

25 MR. ISAACSON: Good to see you, your Honor.

1 MR. IOANNOU (via Zoom): Good afternoon, your  
2 Honor.

3 THE COURT: All right. I understand you have a  
4 busy day of hearings today with the Northern District of  
5 California in this case. So we're here for a further case  
6 management conference, and yours is actually the  
7 technological issues that I had today, so let me just try to  
8 pull everything. Well, actually, we're here for our ICMC.  
9 So I actually had a couple different pieces of paper and  
10 schedules that I was looking at.

11 All right. So I'm sort of going to do a little agenda  
12 setting, as I understand it, and we will -- and then ask the  
13 parties for updates. So I understand generally there's a  
14 request to move our schedule, which we set during the ICMC,  
15 in large part because of the counterclaims which have been  
16 filed. I also wanted to -- so I've been looking at the  
17 schedule. I have some suggestions. We'll talk about that.

18 I also want to just follow up regarding ADR efforts. I  
19 know that you'd met with Mr. Fineman (phonetic), and there's  
20 some indication that additional mediation might be helpful.  
21 I know that there -- it didn't seem like there's anything  
22 further scheduled, but just wanted to make sure, and check  
23 in about that. There's also a pending motion to stay, which  
24 I've reviewed. I intend to issue a ruling today, and just  
25 rule on the papers.

1 Is there anything else -- and I'll just start with  
2 Plaintiff -- either update-wise or agenda-wise for today we  
3 should talk about?

4 MR. HARBIN: No, your Honor.

5 MR. ISAACSON: And no from the Defendants, your  
6 Honor.

7 THE COURT: Okay. Just thinking through  
8 sequencing. Let me actually start with ADR. So what about  
9 updates regarding ADR, and whether or not -- I know that you  
10 have gotten your marching orders regarding discovery from  
11 Judge Cousins, and that you have several other dates  
12 scheduled. In terms of ADR, is there anything -- would  
13 further mediation efforts at this point, at this time, be  
14 helpful?

15 MR. HARBIN: Your Honor, from the Plaintiff's  
16 perspective, not at this stage. We've had extensive  
17 mediation, three, if not four, days with Mr. Fineman. We've  
18 made some progress, but we're not there, and we -- as far as  
19 the Plaintiff -- and I can go into more detail if your Honor  
20 wants, but we do not think at this stage -- while we want to  
21 try to settle the case, we don't think expensive mediation  
22 is warranted right now.

23 We're waiting to hear back on specific issues from the  
24 Defendants, and we certainly think, before a trial,  
25 mediation will be certainly helpful, but not at this time.

1 That could change depending on what their response is, but  
2 that's our position right now.

3 THE COURT: Okay.

4 MR. ISAACSON: From the Defendants' perspective,  
5 we'd like to go to mediation tomorrow. We've spent -- we  
6 actually have some proposed dates from our mediator. We had  
7 exchanged -- we've made a lot of progress. We've exchanged  
8 draft settlement terms, redlines back and forth, and there  
9 are some hangup issues, but I think this is great, your  
10 Honor.

11 We sent a redline, and they sent a different redline,  
12 and I think sitting down together at a mediation might  
13 actually be able to get past that logjam, but, you know,  
14 we're willing to go in good faith, and no conditions, and  
15 not with ultimatums, if we want to go to mediation now.  
16 That's the Defendants' perspective.

17 THE COURT: Okay.

18 MR. HARBIN: May I respond to that, your Honor?

19 THE COURT: Yes.

20 MR. HARBIN: Again, we are all in favor of trying  
21 to settle the case. My client is basically a company that's  
22 owned by two individuals, two inventors, under this  
23 contract. If you recall, they're not super-wealthy  
24 individuals. We've spent a significant amount of money on  
25 mediation.

1       We have exchanged written term sheets, but the last  
2 one, it appeared to us pretty clearly that the Defendants  
3 are going backwards on some very key issues from where we  
4 thought we were, and we've asked for them to stay where they  
5 are. If that's where they are in their -- if that's their  
6 position, mediation is going to be futile, because the case  
7 is not going to settle right now. They draw a redline  
8 issue.

9       So, as I told defense counsel, we are happy to  
10 continue. We'd like to continue to try to settle the case,  
11 are happy to talk directly with defense counsel. We don't  
12 think the mediation of a mediator is needed, because the  
13 issues are pretty clear, in our view, and they're pretty  
14 bright-line issues. They're either going to, you know, go  
15 one way or the other, and if they go one way, the  
16 Defendants' position is one way, the case is not going to  
17 settle right now. If they go the other way, then yes, but,  
18 you know, it's a -- these are clear issues, and we could  
19 talk directly. They can respond.

20       Our proposal was "You put your position in either a  
21 counterproposal, a global counterproposal," as we have been  
22 exchanging counterproposals directly, "or just address these  
23 four key issues, tell us where you are, if you don't want to  
24 do a full counterproposal. Then we'll see if mediation  
25 looks like it would be -- you know, that further expense

1 would be warranted. They haven't responded to that. They  
2 keep saying they want to mediate, but, unless their position  
3 is different than their last proposal, mediation is going to  
4 be futile.

5 THE COURT: Could I make a proposal?

6 MR. HARBIN: Sure.

7 THE COURT: It's just a suggestion, and we can --  
8 I hear the concerns regarding cost loud and clear from you,  
9 Mr. Harbin. I mean, perhaps something -- and I like the  
10 idea of -- you know, whether it's a counter -- and it seems  
11 like there are certain issues which are key sticking points,  
12 redline issues, as you -- as you're describing them. I'm  
13 wondering if there's some structure which you all can put on  
14 your informal direct negotiations, so, like you suggested,  
15 something in writing by X time period, something "This by  
16 this," and that's overlaid with the discovery which Judge  
17 Cousins is ordering, which I think Plaintiff also feels like  
18 they need in order to get further.

19 But there's a little bit of back-and-forth which is  
20 directly between the parties, and if, at a certain point, it  
21 looks like "Wow. We really do want to take this forward.  
22 We actually need facilitation," I mean, I'm happy to refer  
23 this to a magistrate judge, you know, perhaps one which  
24 has -- who has a considerable amount of -- well, I'm not  
25 going to promise, but, like, we have a lot of magistrate

1 judges who have patent and IP experience. I'm just  
2 wondering, if, like, overlying, you all try to put some  
3 structure on it, which corresponds with the discovery  
4 structure, and then seeing where you're at, and then saying,  
5 "Okay. No. Now we're to the point where it would actually  
6 be worth the effort, time and effort," both in terms of  
7 attorney time and magistrate judge time, which I try to  
8 protect.

9 MR. HARBIN: It makes sense. That's fine with us,  
10 your Honor. We could see where the parties are and whether  
11 it looks like, you know, sitting down with an mediator would  
12 be productive. We'd first have exchanges directly between  
13 the parties, and then we can advise the Court where we are.  
14 That makes sense to us.

15 THE COURT: Mr. Isaacson?

16 MR. ISAACSON: Yes. I think -- I mean, I think  
17 Mr. Fineman has been doing a great job as a mediator, and I  
18 think that, you know, from our perspective, I feel like  
19 we're being told there's this black-and-white issue, when we  
20 think there's a lot of area in there to discuss possible  
21 resolutions, and that's where a mediation might be -- I  
22 mean, a mediator might be conducive to help make sure, you  
23 know, that gets communicated, different shades, if you will,  
24 but, at the same time, not opposed to the concept of also  
25 having a magistrate judge, if the Plaintiff is willing to

1 have a magistrate judge serve as that intermediary.

2 THE COURT: Well, why don't -- let me just look at  
3 some dates I have going on.

4 MR. HARBIN: And if I could -- I actually had one  
5 thing, your Honor, while you're thinking about it. I don't  
6 want my thoughts, my comments, to be negative about Mr.  
7 Fineman. I've -- we have been happy with him. At some  
8 point, it may be productive to proceed with him. He knows a  
9 lot about the case already.

10 THE COURT: Yes. That's my one --

11 MR. HARBIN: We just don't think, right now, there  
12 are clear issues. The parties have been communicating  
13 directly about these issues, but not -- you know, there's --  
14 the parties ought to be able to talk directly, or correspond  
15 directly, and say, "Here's where we are," you know, "Is it  
16 acceptable or not?," rather than to delay in time, of  
17 attorney time, and paying the mediator the down time as the  
18 mediator goes back and forth. It's been tremendously  
19 expensive for our clients.

20 THE COURT: Yes.

21 MR. HARBIN: We've put a lot of effort into it.  
22 Again, we were making progress, but then, all of a sudden,  
23 the last proposal, on a couple key issues, we're going  
24 backwards, and if that's the case, then we don't want to  
25 incur the expense of mediation right now, either with Mr.

1 Fineman or a magistrate.

2       So I go back to your suggestion of the parties  
3 structuring correspondence or, you know, phone calls, or a  
4 videoconference, directly with each other, and then we can  
5 advise the Court, both parties, with a joint report, "We  
6 think, you know, mediation would be helpful right now," or  
7 not.

8           THE COURT: Yes. Well, here's what I'm going to  
9 propose. At any point, I'm going to -- you know, I welcome  
10 you all to provide me an update if you want court assistance  
11 with it. No matter what you -- under the schedule I'm  
12 proposing or adopting, it would include a further case  
13 management -- you know, Defendants' proposal to have a  
14 further case management conference in November, and along  
15 with that, with that case management conference, I want a  
16 robust discussion about ADR efforts, so whether or not  
17 they're well under way, or you need further assistance,  
18 or -- I want a more robust discussion about that there,  
19 then, because, given the longstanding relationship between  
20 the parties in this case, it just -- and given the history,  
21 I just feel like mediation might offer you all more, might  
22 be a better solution in this case.

23       Okay. So let me turn, also -- turn now to -- so the  
24 motion to stay. So I've reviewed Defendants' motion to stay  
25 this action pending inter partes review of the two patents,

1 and the Court is denying this motion today. I'm going to do  
2 this on the papers, and deny the motion today without  
3 prejudice to renewal, and I want to talk a little bit about  
4 my thinking with this, and the reason I'm telling you this  
5 today, and doing it on the papers, and in open court today,  
6 is to ensure that we don't slow down the progress of this  
7 case.

8       So the Court has considered the three factors which it  
9 must, you know, first, the stage of the proceedings, second,  
10 whether a stay will simplify the issues in question and  
11 trial in this case, and, third, whether a stay would unduly  
12 prejudice or present a clear tactical disadvantage to the  
13 non-moving party.

14       So, as to the first factor, the stage of the  
15 proceeding, it's somewhat neutral, right? We've been -- the  
16 parties have been engaged in seven months of discovery so  
17 far, but, given the counterclaims, and given what I'm  
18 hearing, there's a substantial amount of work still to be  
19 done, or which will be done, for the patent issues that were  
20 recently introduced.

21       Turning to the second factor, simplification of the  
22 case, this weighs against a stay at this time. Defendants'  
23 petition for IPR review on just two of the four patents --  
24 and this decision in terms of the review is not going to  
25 happen until September 17th, 2025, hopefully, and, given

1 that the petitions are still pending, any potential  
2 simplification is speculative, at best, at this point, and  
3 even if they are granted, the patent -- and the patent  
4 claims are invalidated, it would not simplify the remaining  
5 patent issues or the breach of contract issues, including  
6 the royalty calculations that we've -- that have been the  
7 focus of this case so far.

8       Turning to the third factor, the potential for  
9 prejudice or tactical disadvantage to Plaintiff, you know,  
10 I'm finding that this weighs against the stay. So mere  
11 delay, as counsel knows, of litigation by itself does not  
12 establish prejudice, and the Court acknowledges, you know,  
13 that the Defendant had filed IPR petitions well within the  
14 one-year time period, about nine months into the statutory  
15 period, but I'm also looking at the broader context.

16       So Defendants are seeking to validate patents that  
17 they've been profitably commercializing for more than a  
18 decade, and these questions regarding patent invalidity have  
19 not been raised until Plaintiff filed this action, claiming  
20 that Defendants are underpaying royalties.

21       So, against this backdrop, and for the -- like, and in  
22 this context, the Court is finding that staying the case  
23 would unfairly delay resolution of Plaintiff's claims, and  
24 would provide Defendant an unfair tactical advantage. So,  
25 for these reasons, I'm denying the motion to stay. I'm not

1 foreclosing the possibility that Defendants may be able  
2 to -- may renew this motion if the IPR petition is granted.

3       So, turning to -- within the motion to stay, Defendants  
4 also asked the Court to stay Defendants' obligations to pay  
5 royalties and to have royalties placed into an escrow  
6 account until the litigation concludes. The Court is  
7 denying this request. I think, essentially, Defendants are  
8 asking for a preliminary injunction, or the bond which is  
9 attached to a preliminary injunction, but this isn't  
10 squarely before the Court.

11       Defendants have not established that they are likely to  
12 succeed on the merits of their counterclaims, or that  
13 Defendants' and Plaintiff's claims -- Defendants' -- you  
14 know, all things which you must show for a preliminary  
15 injunction. Defendants at this point have not shown that  
16 they are likely to face irreparable harm in the absence of  
17 an escrow arrangement. Defendants indicate that if they do  
18 prevail, the inventors may cash out and possibly shut down,  
19 making it more difficult for Defendant to recover royalty  
20 payments, but, at this point, that is speculative, and  
21 there's not a motion before us proving those facts. Thus  
22 the Court will not require a stay or escrow for the royalty  
23 payments.

24       So I wanted to sort of spell out my reasoning to some  
25 degree, both in terms of whether or not, in September, we

1 are looking at a possible other motion to stay so that those  
2 concerns were addressed, but, in addition, to sort of  
3 indicate why I'm finding the way I am right now. Again,  
4 this might change in September, but, for right now, that is  
5 the Court's ruling.

6 MR. HARBIN: Thank you, your Honor.

7 THE COURT: Any questions about that?

8 MR. HARBIN: Not for the Plaintiff.

9 THE COURT: Mr. Isaacson?

10 MR. ISAACSON: Not at this time, your Honor.

11 THE COURT: Okay. All right. So let's turn to  
12 schedule, and I -- so, schedule, big picture-wise. The  
13 Court is -- I love the idea that this will only require a  
14 three additional-month extension that the Plaintiffs  
15 propose, but I am more inclined to think that this will take  
16 closer to six months. So I'm basically adopting the dates  
17 proposed by Defendant, but I'm adding a little bit of patent  
18 infrastructure, I'm going to call it, just a little bit,  
19 from our patent local rules.

20 So, if you have Defendants' schedule -- and I will  
21 issue an amended scheduling order -- it begins with the  
22 further CMC on November 19th, 2025. The Court will set  
23 that, and the updated case management statement would be due  
24 November 4th, 2025. Before then -- and this is the patent  
25 infrastructure -- there are some other dates, and so I'm

1 adding three dates.

2       The Defendants will serve -- pursuant to Patent Local  
3 Rule 3-5, Defendants will serve invalidity contentions by  
4 May 28th, 2025. By June 11th, 2025, the parties will  
5 exchange proposed terms for construction, per Patent Local  
6 Rule 4-1. My hope is that there's none, but, just in case  
7 there are more than you think there may be, I want you all  
8 to meet and confer, so that we know what's happening.

9       Parties are to file a joint statement regarding their  
10 proposed terms for construction by June 25th, 2025, so  
11 that's two weeks after the exchange. I think that two weeks  
12 should be enough for you all to meet and confer. That way,  
13 I can look at your proposed terms, and if there are any  
14 disputes or not any disputes, and make some decisions, like,  
15 maybe you're right that we can just deal with this in terms  
16 of the dispositive motions, but, if I think that no, we  
17 actually -- and you may think no, we actually need to have a  
18 Markman. We'll deal with that.

19       So, close of fact discovery being moved from the June  
20 20th date it currently is to December 17th, 2025. Expert  
21 witness disclosure is being moved to January 9th, 2026.  
22 These are all the dates which Defendant had. Rebuttal  
23 expert witness disclosure is February 13th, 2026, close of  
24 expert discovery, April 1st, 2026, deadline to file  
25 dispositive and Daubert motions, May 6th, last day to hear,

1 July 1st.

2       You heard my admonition. These are deadlines. These  
3 are last days. Do not -- I will warn, if you push it to the  
4 last day, some of the last days have three summary judgment  
5 motions. You may get pushed. Right? So let's not.

6       Pretrial conference, September 28, 2026, with a trial  
7 date of October 21st, 2026. I just realized that the  
8 September -- I was looking at 2025. That date, of course,  
9 is 2026 -- or I just hadn't double-checked the date in  
10 Defendants' proposal.

11       Let's go ahead and do -- move the trial dates and  
12 the -- to comport with the Court's calendar, so September  
13 30th, 2026, for the pretrial conference, and a trial date of  
14 October 19th, 2026.

15       So I know this extends discovery six months. It's not  
16 a reason -- all your efforts and all the -- if there were  
17 admonishments with Judge Cousins, but everything which was  
18 said today in terms of deadlines, those stick. Like, this  
19 is only to accommodate the counterclaims, right? All the  
20 rest of discovery still needs to be happening on the track  
21 it should have been happening. This is merely to make sure  
22 that we have created space for the patent counterclaims. So  
23 please continue to put forth your best efforts in terms of  
24 with Judge Cousins and the upcoming discovery motions, and  
25 the homework which he gave you.

1           So let me double-check, because I have many pieces of  
2 paper involving you all. I just want to make sure that I've  
3 done everything that I needed to do today, or raised  
4 anything I needed to raise.

5           Okay. I think I have covered my agenda. Is there  
6 anything you all -- parties would like to -- counsel would  
7 like to raise with me?

8           MR. ISAACSON: If I could just clarify one thing,  
9 beginning with our time about ADR. Your Honor mentioned  
10 having an update in November 19th, final case management,  
11 but there is no other deadline in terms of conducting an ADR  
12 session or anything like that, correct?

13          THE COURT: Not at this point. If you all don't  
14 have a structure in place, I will be making orders in  
15 November.

16          MR. ISAACSON: Right. I just wanted to make sure  
17 that that what was I understood you and was correct. So,  
18 thank you. I have nothing else, your Honor.

19          THE COURT: Thank you, Mr. Isaacson.

20          Mr. Harbin?

21          MR. HARBIN: Yes, your Honor. We addressed an  
22 issue in the new proposed scheduling submission about the  
23 burden of proof, and it relates to your decision on  
24 addressing patent issues earlier, rather than later, which  
25 probably will save us from further delays later on, which

1 we, as Plaintiff, are all in favor of, but there is -- I  
2 just wanted to clarify. There is another patent issue that  
3 the counter-claimant, Defendant counter-claimants, have  
4 raised, in addition to alleged invalidity, and that is that  
5 they are claiming that some products on which they had paid  
6 royalties actually are not covered by the licensed patents.  
7 Essentially, it's similar as, you know, your -- you know,  
8 it's a situation like, in a patent infringement case, the  
9 Defendant say, I'm not infringing that patent. It doesn't  
10 read on my product."

11 We've had a bit of a discussion back and forth about  
12 who has the burden of proof, and to your point about the  
13 study, I think, and to support that, your Honor, there are  
14 some claims that the Defendants, in their counterclaim, seek  
15 to say are invalid. There are other claims that the  
16 licensed patents, as I stated, don't infringe. So, to the  
17 point about there not -- the IRP not resolving all the  
18 issues, there will still be patent cases to try.

19 Given this, you know, if we're going to go ahead and  
20 address the patent cases, the question of claim construction  
21 is going to come up on infringement, as well as, you know,  
22 an invalidity is -- your Honor I'm sure is aware claims have  
23 to be construed the same way for infringement as invalidity.

24 Given the posture of the matter, the relationship in  
25 the case, where the Defendants have paid royalties for over

1 a decade on patents that they prosecuted -- they controlled  
2 the prosecution of the patents, and then said, "Oh, we've  
3 determined, after 12, 13 years, that some of the claims are  
4 not even covering the products." They've taken the position  
5 that we have the burden of proving claims do cover the  
6 products.

7 In this case, they filed a DJ action of non-coverage,  
8 where they bear the burden of proving they're entitled to GJ  
9 relief, and they're not seeking it as to all the patent  
10 claims, and there is an, obviously, your Honor, principle of  
11 waiver of conditions precedent, which I think has happened  
12 here. If this was a condition precedent, the Defendants  
13 waived it long ago.

14 So my question is, if we're going to address invalidity  
15 early, should we go ahead and address which patents the  
16 Defendants claim are not covering the products, the product,  
17 you know, not, you know, the -- they say the products don't  
18 practice. So we can address that issue if it's -- if  
19 they -- if it's only the ones in -- that are listed in the  
20 counterclaim, that's great, and then, you know, we may want  
21 to do -- I would propose the Defendants, if they've raised  
22 this DJ action, do not infringement contentions (sic), and  
23 we can respond to their, you know, non-infringement or  
24 non-coverage contentions as to whatever claims they identify  
25 they they're not infringing, or not -- you know, they've not

1 covering the products, if that makes sense.

2 THE COURT: I think I got 70 percent of it, which  
3 I think is pretty good, because you have -- I have all these  
4 notes regarding this issue about the burdens. I feel like  
5 this is being framed slightly differently than it was in the  
6 papers, and so I'm thinking through, and the -- than it --  
7 I'm thinking through what you're proposing.

8 While I do that -- and, actually, I'm going to mute for  
9 one minute, video mute for one minute, because I'm just  
10 going to grab my local -- my patent local rules. Give me  
11 one moment.

12 MR. HARBIN: All right.

13 THE COURT: While I'm pulling these up, Mr.  
14 Isaacson, let me hear from you, and your reaction, too.

15 MR. ISAACSON: Sure. I guess, in this action, the  
16 Plaintiff has brought a claim for breach of contract for  
17 failure to pay royalties, and our view is, if you look at  
18 the language of the license itself, the license -- royalties  
19 are only owed on products which actually express --  
20 specifically practice the patent, utilize the patent.

21 And so our position is that, you know, even if  
22 Defendants are claiming there's invalidity or  
23 non-infringement, that, on Plaintiff, claims that they've  
24 brought in the affirmative on a breach of contract, there  
25 can't be a presumption that that condition is met, but it

1 still remains Plaintiff's burden to demonstrate that -- a  
2 product on which their claims of royalties are owed, which  
3 would include a determination on whether they practice,  
4 whether those products utilized the patented technology, and  
5 I disagree that there's some sort of waiver or anything that  
6 would shift that burden at this stage, because that has not  
7 been established or proved or briefed at this point.

8 THE COURT: Do you agree that the declaratory  
9 judgment claim is essentially one for non-infringement?

10 MR. ISAACSON: I believe it's less about  
11 non-infringement and more about an affirmative showing that  
12 the products don't utilize patent claims, and that may seem  
13 like mincing words, but, even if it's labeled as  
14 non-infringement, the focus is that there's no patented  
15 technology in these products. So they do seem like two  
16 sides of the same coin, yes.

17 MR. HARBIN: If I could address that, your Honor?

18 THE COURT: Yes. Yes, and I guess -- I mean, let  
19 me say a couple things, too, and then I'm going to have you  
20 address it, and then I'm also going to ask, Mr. Harbin, if  
21 there's anything specific that you are asking the Court to  
22 do or change in terms of the schedule which I just set  
23 forth, or if there's anything else from the patent local  
24 rules that you're asking the Court to add.

25 MR. HARBIN: Maybe we could just address it with

1 interrogatories, but, at some point --

2           THE COURT: That's exactly what I was going to --  
3 that's where I was starting. So where I was starting when I  
4 read through your joint case management conference (sic) --  
5 and, you know, frankly, I kicked this around a bit with the  
6 law clerk who was working on this case, because we were just  
7 thinking through, and my initial thoughts were, "Hey. Can't  
8 this be" -- a lot of the questions which you were raising in  
9 the CMC statement were -- to my thought, was like "These  
10 seem like perfect, you know, contention interrogatories,"  
11 right, to, like, get down to which products, which are at  
12 issue, and what are the contentions around those, right?

13           MR. HARBIN: Your Honor --

14           THE COURT: And then, after that, you know, then  
15 we can start talking about burdens and such down the road,  
16 closer to the summary judgment motions, but, for right now,  
17 it really seemed to me that the first step which needed to  
18 happen was discovery.

19           MR. HARBIN: Now that you say that, your Honor, I  
20 just remembered the parties have -- we've gone back and  
21 forth about this, and we just -- we agree that the parties  
22 will address -- will provide interrogatory answers about  
23 what patents cover or don't cover the products, but it will  
24 be in the form of expert opinion, because that really is --  
25 because you have to construe the claims, you know, as you

1 are aware, and lawyers and experts can argue about whether a  
2 claim is infringed. It's not something a lay witness can  
3 really do, so that it's really going to be expert discovery,  
4 so it's going to put it off, but I just raise it because it  
5 is another patent-related issue that's going to have to be  
6 addressed, and I disagree a little bit with Defendants'  
7 counsel.

8       Claim coverage under a license is determined exactly  
9 like whether a patent is infringed for somebody who doesn't  
10 have the license that they're -- the difference is the  
11 remedies. You know, a licensor suing for breach of contract  
12 or a licensee suing for declaratory judgment, they don't  
13 practice this patent that doesn't cover their product. The  
14 coverage of the patent on the product is exactly the same  
15 analysis. The difference is the remedies. So -- and, you  
16 know, the terms of art, you know, a licensee --

17       THE COURT: Right.

18       MR. HARBIN: There's a product. Is it covered,  
19 versus is it infringing? But the analysis is the same. But  
20 we don't want to go a road of having an expert have to  
21 analyze all the claims of the patents, only to find out that  
22 the Defendants, after 13 years, only contest certain of the  
23 claims, which is -- you know, their counterclaim only  
24 specifies a few claims that they content are not practiced.  
25 And I'm not saying their claim is necessarily limited to

1 that, but, as far as what's specified in there, there's only  
2 a few claims in it.

3 THE COURT: And discovery -- I mean, discovery, at  
4 least in terms of that, should -- before expert discovery,  
5 it seems as though, should -- well, Mr. Isaacson, let me --

6 MR. ISAACSON: I was going to say, if I could jump  
7 in, I think we share that same -- which is, from the  
8 Defendants' side, we'd also like to know which claims the  
9 Plaintiff claims are practiced, are used. Right? So I  
10 think that kind of goes both ways on that, and we would  
11 welcome a meet-and-confer that -- if we can all agree that  
12 half the claims are not at issue, then that's good for all  
13 of us.

14 THE COURT: Because I think that that should try  
15 to be overlaid with the fact discovery, rather than waiting  
16 all the way -- I'm just thinking it through, like that some  
17 of that can happen, and just the identification can at least  
18 happen earlier.

19 MR. HARBIN: Okay. That's a good thought, and  
20 then you can get it in analysis and expert discovery.

21 THE COURT: Yes.

22 MR. HARBIN: Right. Okay.

23 THE COURT: So that's what I would strongly  
24 propose with that, because I think that will control for  
25 both of sides (sic), the universe --

1 MR. HARBIN: Right.

2 THE COURT: -- and also may help, frankly  
3 speaking, with settlement discussions. And I think, down  
4 the road, once we have that universe, it will then shape  
5 your discovery. It will then shape your dispositive motions  
6 and so forth.

7 MR. HARBIN: Can you put that in an order, part of  
8 your order after this, that the parties should do that?

9 THE COURT: Yes. I'm going to have each of you  
10 try to state it, and articulate in a manner so I can take  
11 notes while we're talking, because I think I know what I  
12 said, but it would be great if you all repeat what I said.  
13 So, Mr. Harbin, what order would you like the Court to make?

14 MR. HARBIN: That the parties will identify during  
15 fact discovery, as part of fact discovery -- Plaintiffs will  
16 identify what claims we believe the products cover -- or  
17 what claims we contend cover the -- one or more of the  
18 products at issue, and then the Defendants will identify,  
19 you know, "This product is not covered by that," and which  
20 products are not covered by which patents. We won't get  
21 into, like, an analysis of how, but that the contentions  
22 will be laid out.

23 THE COURT: Mr. Isaacson, does that seem accurate?

24 MR. ISAACSON: Mr. Harbin does a wonderful -- it's  
25 kind of, I guess -- from the Defendants side, I think it

1 would -- the parties both identifying which claims are  
2 utilized by the product at issue in the case, which I don't  
3 think we have a disagreement on the list of products, and I  
4 think both parties have -- or both sides have wanted an  
5 identification, kind of, of which of those claims are  
6 practiced in which products.

7 I don't know if that's part of what we can have as that  
8 exchange, or if that needs to come later on in discovery --  
9 in expert discovery. But it would be a deadline to exchange  
10 an identification of which claims of the patents are at  
11 issue, which I believe is something that, in the local  
12 rules, does happen in an infringement action.

13 THE COURT: Okay. I'm looking at the two  
14 different proposals. Can -- I -- so I think I can craft our  
15 of what you all have so far -- if you all would rather meet  
16 and confer and propose joint language, jointly, like, you  
17 might -- you know, that's always -- you all always know  
18 better than I do in terms of something gained, this specific  
19 in terms of -- I'm happy to go with that, as well, and  
20 include it within the amended scheduling order.

21 But let me ask you now, what deadlines would you  
22 suggest?

23 MR. HARBIN: It depends. I think we're in part  
24 agreement, but, to me, it depends on whether this initial  
25 designation is just a general designation of we contend --

1 for example, "We, the Plaintiff contend claims one, three,  
2 and five of this, that, and then claims four, one, four, and  
3 six of the other patent apply to one or more of the  
4 products," or are we going to break it down to apply to  
5 these specific products, and the Defendant, conversely, are  
6 they just going to generally say, "We think that" -- from  
7 the Defendants' perspective, it would -- they would be  
8 listing, if it was generally, just what patents they think  
9 are not practiced by any products. I think, to be more  
10 meaningful, it needs to be "We think these products don't  
11 practice this patent claim. These products don't practice  
12 this patent claim."

13 I do worry about it a little bit, your Honor, and we've  
14 talked it more (sic) with Judge Cousins mor about this. I  
15 worry a little bit about whether, effectively, you're just  
16 going to get a blanket denial, "We don't think any of the  
17 patents cover any of the claims," but -- or "any of the  
18 products" -- but that is what --

19 THE COURT: Is this something which -- you know, I  
20 think there has to be a level of meaning. I agree that  
21 there needs to be a meaningfulness to this. I also  
22 understand -- I think you all actually agree with that.  
23 It's just, I think everyone is trying to decide, "Okay.  
24 Well, I don't want to exclude -- like, accidentally miss  
25 something," is what I'm -- is my guess, that there's some

1 concern about that.

2 I'm wondering if this -- well, I had two ideas. One  
3 was like, "Okay. Can I give you all, you know, 14 days to  
4 submit a stipulation to me, so that you can hash out some of  
5 these details?" I mean, the other thing which I was going  
6 to suggest is -- or another idea would be "Hey. Does it  
7 make sense for me to -- with everything you all are dealing  
8 with Judge Cousins on this, say -- refer to Judge Cousins,  
9 like, if an agreement isn't reached?," that you hash this  
10 out at your next conference with him?

11 MR. HARBIN: Makes sense to me, your Honor.

12 MR. ISAACSON: Yes, and I agree. We have a date  
13 scheduled with Judge Cousins on the 29th, which is about two  
14 weeks from now. So perhaps that joint submission would be  
15 about by the end of next week, so that Judge Cousins can  
16 review, or you can, and give comments to Judge Cousins, that  
17 we -- both of us let us know that you talk about it, so it's  
18 not really behind our backs, entirely, but, yes, I would  
19 agree with meeting and conferring with Mr. Harbin and Mr.  
20 Thomas, and submitting something by the end of next week  
21 with a proposal, hopefully, a joint proposal, or different  
22 proposals, and let Judge Cousins help clear up what the plan  
23 should be.

24 THE COURT: Mr. Harbin?

25 MR. HARBIN: Yes, I think that's fine, your Honor.

1 The -- only I would say, to make it meaningful, the -- we'd  
2 need to report a little bit before the conference with Judge  
3 Cousins.

4 THE COURT: Well, let's see. Your conference with  
5 Judge Cousins on the 29th -- and what it may end up being is  
6 him being like, "Okay. Great. You all didn't sign the  
7 stipulation. You guys have submitted a joint statement to  
8 me. Let's set another date in terms of addressing this  
9 joint statement."

10 But I'm hoping what it is, is "Oh, the stipulation got  
11 entered. Judge Lee has signed it, and I don't need to worry  
12 about it," because what I'm going to -- I'm just going to  
13 look at the calendar, because what I think I'm going to  
14 propose is a deadline to submit a stipulation to me by --  
15 and if a stipulation is not reached, that you submit a joint  
16 report or a joint -- yes, a joint letter to Judge Cousins  
17 about the outstanding disputes.

18 MR. HARBIN: Sounds good to us, your Honor. We  
19 may -- within that, we may again propose an idea of filing a  
20 motion to determine with the Court -- that was you, I  
21 think -- in showing the burden of proof at trial, and, you  
22 know, burden of production and burden of proof at trial.

23 THE COURT: I just don't think I'm going to know  
24 enough until we have all this sorted out. Like, I feel like  
25 discovery needs to happen. I need to have an understanding

1 of, like, sort of the scope of what is being -- and then, I  
2 mean, I -- to me, that burden of proof and production is  
3 much closer to the dispositive motion time frame, for me  
4 to --

5 MR. HARBIN: It is. It's more about -- we're  
6 focusing more on the issue that, you know, the sophisticated  
7 companies making the products paid royalties for 13 years.  
8 Nobody ever specified, "This is payment on this claim" or  
9 "this patent," but, again, the Defendants are the ones --  
10 Maxim more than ADI -- ADI came into the picture in 2021.  
11 Maxim prosecuted the patents, hired attorneys, was very  
12 involved, made the decision to pay the royalties, and now  
13 it's saying, "Well, now we've decided, 13 years later, that  
14 some patents don't cover some products," and it's  
15 potentially a huge expense and burden to go in and have to  
16 say, as the Defendants' contention is, "We are the  
17 Plaintiff. We have to prove we're entitled to the -- that  
18 the claim covers the product."

19 I think, in this case, there's very solid ground for  
20 saying, "No, the Defendants have waived that condition for  
21 us, that you're now saying specific claims are not covered.  
22 You know, we're going to limit it to whatever you contend is  
23 not covered," not make the Plaintiff have to prove every  
24 single claim when, in fact, that's not really a dispute.  
25 That's the issue that concerns us. This is a potentially

1 very expensive process. So, you know, I think your initial  
2 proposal is good. Have the parties confer, see if we can  
3 work it out, report to your Honor.

4 THE COURT: So let's do this. How about -- would  
5 the 23rd by sufficient time to either file a stip or tell  
6 me, you know -- or to cry mercy, saying that you need court  
7 intervention? That's a week and a half.

8 MR. ISAACSON: I believe so, your Honor, for  
9 Defendant.

10 MR. HARBIN: Yes, I believe so, your Honor. I  
11 don't think it would be enough to specify product by  
12 product, but we don't necessarily need to do that.

13 THE COURT: This is saying you do.

14 MR. HARBIN: Yes. No, definitely, but that's --

15 THE COURT: So this is the parameters of what  
16 you're agreeing to do on the early side.

17 MR. HARBIN: Right.

18 THE COURT: So you can really direct your  
19 arguments, discovery, response motions -- and I think it  
20 will make -- if this actual works, which I'm hopeful that it  
21 will, I think it will resolve a lot of the burden questions,  
22 my hope is, of your concern, Plaintiff's concern that it's  
23 going to spiral out of control in terms of what to prove up,  
24 and I think it will also actually address Defendants'  
25 concerns on the back side of -- yes, in terms of scope, as

1 well, in terms of patent.

2       So let's do that. Let's say, by next Friday, you will  
3 either file a joint -- you will file a joint stip, basically  
4 setting forth a time line for fact discovery regarding the  
5 claims, product and product coverage. I know there's a  
6 little bit more to that, but I'm just going to leave it  
7 there for right now. I think --

8               MR. HARBIN: Your Honor --

9               MR. ISAACSON: Actually, no, it was well put, your  
10 Honor.

11              THE COURT: Thank you.

12              MR. HARBIN: We understand --

13              THE COURT: That will happen by Friday if it's --  
14 you know, you're -- if it's -- you can't reach an agreement,  
15 you'll file a joint report saying you can't reach an  
16 agreement, and sort of both the parties' positions, and I'll  
17 tell you what I'm then going to do is say, "Okay. You're  
18 going to hash -- I'm going to refer this to Judge Cousins.  
19 I'm going to ask him to schedule and take over the" --  
20 whatever he needs to do to get into the grist of that, to  
21 help you all, and I'm going to have him do that in tandem  
22 with your discovery.

23              MR. ISAACSON: Understood, your Honor.

24              MR. HARBIN: Understood.

25              THE COURT: Great. All right. Mr. Harbin, thank

1 you. Even though that took a considerable amount of time,  
2 thank you for raising that. It was on my many notes. I  
3 just forgot to raise that issue about the burdens of proof.

4 Anything else?

5 MR. HARBIN: Not from the Plaintiff's perspective,  
6 your Honor.

7 MR. ISAACSON: Yes. Not from Defendants, your  
8 Honor.

9 THE COURT: Okay. So we will go from there. I  
10 will see your reports next week, hopefully stip them, just  
11 going to sign by next week, and so -- and we'll issue a  
12 scheduling order, an amended scheduling order.

13 MR. ISAACSON: Okay.

14 THE COURT: Yes, Mr. Thomas. I think you may need  
15 to unmute.

16 MR. ISAACSON: We can't hear you.

17 THE COURT: No?

18 MR. HARBIN: You're muted, Warren. Now you're  
19 unmuted.

20 THE COURT: Still not coming out. Oh, no. I  
21 don't know what is -- you're not muted on our side.

22 MR. HARBIN: Can you text me?

23 MR. IOANNOU: I see a hand up there.

24 MR. HARBIN: Well, we can get a transcript, right,  
25 if we want a transcript?

1 THE COURT: Yes. You'll just order, and a court  
2 reporter will transcribe.

3 Mr. Thomas, was that the question?

4 MR. HARBIN: Yes.

5 THE COURT: Perfect. Okay. Yes. You can just  
6 order a transcript like you normally would, and we'll just  
7 have a court reporter listen to the recording.

8 And I think that covers everything. All right. Thank  
9 you, everybody.

10 MR. ISAACSON: Thank you, your Honor.

11 MR. IOANNOU: Thank you, your Honor.

12 MR. HARBIN: Thanks, everybody.

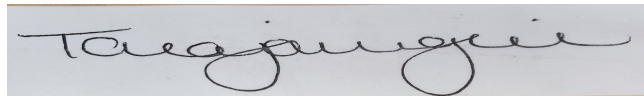
13 THE COURT: All right. We are now adjourned.

14 (Proceedings adjourned at 2:51 p.m.)  
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CERTIFICATE OF TRANSCRIBER

I certify that the foregoing is a true and correct transcript, to the best of my ability, of the above pages of the official electronic sound recording provided to me by the U.S. District Court, Northern District of California, of the proceedings taken on the date and time previously stated in the above matter.

I further certify that I am neither counsel for, related to, nor employed by any of the parties to the action in which this hearing was taken; and, further, that I am not financially nor otherwise interested in the outcome of the action.

A handwritten signature in black ink, appearing to read "Tara Jungi", is centered on a light gray rectangular background.

Echo Reporting, Inc., Transcriber

Friday, May 16, 2025

*Echo Reporting, Inc.*