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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

THE MAGNAVOX COMPANY, a corporation, and SANDERS ASSOCIATES, INC., a corporation Plaintiffs, vs. ACTIVISION, INC., a corporation, Defendant.	No. C 82 5270 JPV DECLARATION OF MARLA J. MILLER IN SUPPORT OF DEFENDANT'S MOTION FOR ORDER COMPELLING FURTHER ANSWERS TO INTERROGATORIES AND CERTIFICATE OF COMPLIANCE WITH LOCAL RULE 230-4(a) Date: September 21, 1984 Time: 1:30 p.m.

I, MARLA J. MILLER, declare:

1. I am a member of the Bar of the State of California and an associate with the law firm of Howard, Rice, Nemerovski, Canady, Robertson & Falk, A Professional Corporation, attorneys for

Activision, Inc. ("Activision") in the above-referenced action. Except as otherwise indicated, I have personal knowledge of the matters set forth below, and if called upon to do so, I could and would testify competently to them.

2. Counsel for Activision have used their best efforts to resolve the remaining discovery issues in this action without necessity of another motion to compel further answers to the interrogatories served on Defendants The Magnavox Company and Sanders Associates, Inc. ("Magnavox"). On July 27, 1984, I wrote and sent by express mail a letter to counsel for Magnavox, James T. Williams, outlining the specific interrogatory answers to which Activision sought further response. A true and correct copy of this letter is attached hereto as Exhibit A. I wrote this letter pursuant to my conversation with Martin R. Glick (my colleague at Howard, Rice and the lead trial counsel for Activision in this matter) who told me he had spoken to Mr. Williams the week before, had indicated Activision's dissatisfaction with certain of Magnavox' responses to interrogatories, and that Mr. Williams would be expecting my letter. By letter dated August 2, 1984, I sent Mr. Williams a follow-up letter to my letter of July 27, 1984. A true and correct copy of that letter is attached hereto as Exhibit B.

3. In my letter to Mr. Williams of July 27, 1984, I requested that Magnavox provide its complete and final responses to the interrogatories described therein by Friday, August 10, 1984. On August 2, 1984, I received a letter from Theodore W. Anderson, Mr. Williams' partner and co-counsel for Magnavox in this lawsuit,

informing me that Mr. Williams was out of the office until Monday, August 13, 1984 and that it would be "substantially impossible" for Magnavox to respond to my letter without him. A true and correct copy of this letter is attached hereto as Exhibit C. Mr. Anderson suggested in his letter that these matters could be taken up on August 14, 1984, when counsel were scheduled to be in Houston for a deposition. I am informed by my co-counsel, Mr. Glick, and believe that Mr. Williams indicated in Houston on August 14, 1984 that contrary to his co-counsel's statements, Mr. Williams was not prepared at that time to discuss Magnavox' further responses to interrogatories.

HOWARD RICE NEMEROVSKI CANADY ROBERTSON & FALK
A Professional Corporation

4. At the initiative of counsel for Activision, Mr. Glick and I finally spoke to Mr. Williams by telephone on Friday, August 17, 1984. The substance of our telephone conversation is set forth in a letter I wrote to Mr. Williams dated August 22, 1984, a true and correct copy of which is attached hereto as Exhibit D. During our conversation, Activision reached apparent accord with Magnavox' counsel as to the status of certain interrogatories: Activision dropped certain requests, and Magnavox responded to Activision's satisfaction to certain others. However, many key interrogatory responses remain incompletely answered. Mr. Glick and I informed Mr. Williams during our conversation of August 17, 1984 that although we hoped that the remaining issues could be resolved without necessity of a formal hearing, because of the advanced stage of this litigation, Activision had no choice but to file with the Court immediately a motion to compel further

responses to interrogatories.

5. While Magnavox' counsel indicated a willingness to seek further answers from his clients, no additional responses have been forthcoming as of the date of this declaration.

6. I certify that I have complied with the requirements of Local Rule 230-4(a) by conferring with counsel for Magnavox as more fully described above, in the exhibits attached hereto, and in the Memorandum of Points and Authorities In Support of Defendant's Motion For Order Compelling Further Answers to Interrogatories and the attachments thereto, all filed herewith.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct to the best of my knowledge.

Executed on August 24, 1984, at San Francisco, California.

Marla J. Miller

MARLA J. MILLER

HOWARD RICE NEMEROVSKI CANADY ROBERTSON & FALK
A Professional Corporation

Law Offices Of

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July 27, 1984

BY EXPRESS MAIL

James T. Williams, Esq.
Neuman, Williams, Anderson & Olson
77 W. Washington Street
Chicago, IL 60602

Re: Magnavox, et al. v. Activision

Dear Jim:

This letter follows your telephone conversation with Marty Glick last week in which you discussed Activision's need for certain further interrogatory responses from Magnavox. As you and Marty discussed last week, Activision hopes that this letter specifying which interrogatories need further response will enable us to resolve the remaining discovery issues without necessity of another motion to compel further answers.

I have listed below by interrogatory number those interrogatories which need further response. In reviewing Magnavox's interrogatory responses, we have traced through Magnavox's original and supplemental response for each interrogatory in order to determine the responses which require further amplification.

Interrogatory No. 38. At this advanced stage in the litigation, it is incumbent upon Magnavox to state with certainty which claims in the 507 patent are alleged to be infringed by the use of Activision game cartridges in combination with the consoles identified in Response to Interrogatory No. 50. For example, in light of Magnavox's Second Supplemental Response to Interrogatory Nos. 128 and 129, does Magnavox still contend that the combination of any Activision game cartridge with the

EXHIBIT A

consoles constitutes an infringement of Claim 44 or Claim 45 of the 507 patent?

Interrogatory No. 39(a)-(c). Magnavox must now identify the Activision game cartridges which constitute an infringement of each of the specific 507 patent claims.

Interrogatory Nos. 40-41. Activision must know which games described in the video game cartridge catalogue attached as Exhibit A to Activision's interrogatories do not infringe any of the claims of the 507 patent, and the reasons why each such game does not infringe. By this time, Magnavox's examination of the Activision game cartridges ought to be complete.

Interrogatory No. 50. Does Magnavox contend that there are any television game consoles, other than those in Response to Interrogatory No. 50, which combined with one of the Activision game cartridges and used in combination with a television receiver, constitutes an active infringement of the 507 patent?

Interrogatory No. 54. The most recent responses to this interrogatory were prepared in February, 1983. At this time, please state all the details which support the allegations referred to in this interrogatory.

Interrogatory No. 58(e). As to part (e), Activision requests Magnavox to identify any claims of the 507 patent, other than those listed, which cover each such Magnavox game listed in this interrogatory.

Interrogatory No. 73(b-j). The information sought in this interrogatory is not contained in the documents produced to Activision. Please respond to this interrogatory in its particulars now.

Interrogatory No. 75(a). Which portions of the subject matter described in the 480 patent are prior art with regard to the 507 reissue patent?

Interrogatory No. 76. Please respond to this Interrogatory in all its particulars.

Interrogatory No. 98(d). Describe in detail the circumstances under which the decision was made to reissue the 284 patent. Activision seeks to discover what prompted the persons identified in this Interrogatory to decide to seek reissue of the 284 patent.

Interrogatory No. 100(e). Activision requires Magnavox to identify any prior art (other than the references cited on the face of the 507 reissue patent) considered by Magnavox or Sanders in connection with the prosecution of the application, and determined not to be material to the examination of the application. Ted Wright's letter to you dated March 22, 1984 makes unambiguously clear that this is the substance of Interrogatory No. 100(e).

Interrogatory No. 108. Magnavox must indicate whether any additional discussion occurred with regard to the Spaceship game which James T. Williams observed at Stanford University, and to answer the particulars of Interrogatory No. 108.

Interrogatory Nos. 119-120. At the time of Magnavox's supplemental response to this Interrogatory, Magnavox was "presently unable to ascertain" that either Magnavox or Sanders ever considered reissuance of the 480 patent in view of the Althouse patent. Please finally inform Activision of your response to this Interrogatory, and if the answer is other than an unqualified negative, please respond to Interrogatory No. 120.

Interrogatories Nos. 126-127, 130-134. Through these interrogatories, Activision seeks to discover precisely which elements of the allegedly infringed claims of the 507 patent are infringed by the Activision game cartridges. By this time, Magnavox should be able to state fully what contentions it will make at trial as to the subject matter of these interrogatories. To the extent these interrogatories have not been fully answered, complete and final answers should be provided now. For example, for each allegedly infringing Activision game cartridge, all of the applicable subparts of each of these interrogatories should be answered. In addition, to the extent that Magnavox has responded with the qualifying phrase "at least" preceding an answer (see, e.g., Response to Interrogatory 126(b), (d), (f), (h); Response

to Interrogatory 129(c)), those interrogatories should be answered finally and completely now.

Interrogatory No. 128. Please clarify whether Magnavox contends that the use of any Activision game cartridge in combination with the named consoles infringes Claim 44 of the 507 patent.

Interrogatory No. 129. Please clarify whether Magnavox contends that the use of any Activision game cartridge in combination with the named consoles infringes Claim 45 of the 507 patent.

Interrogatory No. 139. Magnavox has failed entirely to respond to this Interrogatory, although response was compelled by court order. Because Magnavox contends in its Response to Interrogatory No. 138 that certain portions of the subject matter of the 480 patent were not prior art with regard to the 507 patent, Magnavox must now elaborate on that response, as requested by Interrogatory No. 139.

Interrogatory Nos. 140-152. Parts (e) through (i) of these Interrogatories have not been answered with specificity. Please do so now.

Interrogatory Nos. 184-192. Through these interrogatories, Activision seeks to discover precisely which elements of the allegedly infringed claims of the 507 patent are infringed by the use of Activision game cartridges. Activision believes that by this time, Magnavox should be able to state fully what contentions they will make at trial as to the subject matter of these interrogatories. For example, for each allegedly infringing Activision game cartridge, all of the applicable subparts of each of these interrogatories should be answered. In addition, to the extent that Magnavox has responded with the qualifying phrase "at least" preceding an answer (see, e.g., Response to Interrogatory 184(b), (d), (f), (h); Response to Interrogatory 190(a), (d), (g), (i), (k), (m)), those interrogatories should be answered finally and completely now.

* * *

It is important that Activision have Magnavox's complete responses to these interrogatories by Friday, August 10, 1984. If you have any questions about the further information Activision seeks, please call me. I look forward to receiving Magnavox's responses, and to completing the discovery in this lawsuit in an expeditious and amicable fashion.

Sincerely yours,

Marla J. Miller

MARLA J. MILLER
Attorney for Defendant Activision

MJM:wpc

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August 2, 1984

EXPRESS MAIL

James T. Williams, Esq.
Neuman, Williams, Anderson & Olson
77 W. Washington Street
Chicago, IL 60602

Re: Magnavox, et al. v. Activision

Dear Jim:

This letter follows my letter to you of July 27, 1984, and should be considered a part of that letter. We request clarification from Magnavox as to the substance of certain of its responses to interrogatories concerning the 480 patent.

In Magnavox's initial response to Interrogatory No. 28, Magnavox indicated that if its motion to dismiss Activision's Second Counterclaim alleging the invalidity, unenforceability and non-infringement of the 480 patent were granted, neither plaintiff would sue Activision for infringement of either any claim of the 480 patent, or any identical claim in the 480 reissue for any activity of Activision in relation to its game cartridges marketed prior to October 25, 1982. As you know, the Court denied Magnavox's motion to dismiss Activision's Second Counterclaim, and the 480 patent is thus an issue in this lawsuit. In Magnavox's Supplemental Response to Interrogatory Nos. 28 and 29, filed after the Court's ruling on the counterclaim, Magnavox and Sanders would not admit that Activision has not infringed the 480 patent, but stated that they did "not contend in this action that they are entitled to any relief against

EXHIBIT B

Activision based upon any acts of infringement by Activision of [the 480 patent]." Magnavox and Sanders, based on the foregoing, indicated that it was not relevant for them to define Activision infringement of the 480 patent.

We assume, as we must, from your responses that you do not oppose Activision's Second Counterclaim on any basis other than that advanced in your motion to dismiss and that, in no event, will you seek to prove in this lawsuit that Activision infringed the 480 patent. Please notify us by August 14, 1984 if we have not correctly interpreted your position. If you desire to amend or augment your answers to Interrogatories 28 or 29, please let us know by that date what changes or additions you would make.

Sincerely yours,

Marla J. Miller

Marla J. Miller

MJM:cal

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July 31, 1984

Ms. Marla J. Miller
Howard, Rice, Nemerovski,
Canady, Robertson & Falk
Three Embarcadero Center - 7th Floor
San Francisco, California 94111

Re: Magnavox, et al. v. Activision

Dear Ms. Miller:

We received your letter of July 27, 1984 late yesterday afternoon. As you are probably aware, Jim Williams of our office has been primarily responsible for the discovery activities in this case. Jim is out of the office and is not expected to return until Monday, August 13. Thus, it will be substantially impossible for us to respond to your letter by August 10.

I understand that there is a deposition scheduled in this case in Houston for Tuesday, August 14. I suggest that you and Jim Williams discuss the interrogatory responses referred to in your letter at the time of that deposition.

Very truly yours,

NEUMAN, WILLIAMS, ANDERSON & OLSON

By _____
Theodore W. Anderson

TWA:de

cc: James T. Williams

EXHIBIT C

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August 22, 1984

BY EXPRESS MAIL

James T. Williams, Esq.
Neuman, Williams, Anderson & Olson
77 W. Washington Street
Chicago, IL 60602

Re: Magnavox, et al. v. Activision

Dear Jim:

This letter follows up on our telephone conversation last Friday, August 17, 1984, in which you, Marty Glick and I discussed Activision's outstanding requests for further responses to interrogatories by your clients. As you know, that telephone conversation was held in connection with my letters to you of July 27, 1984 and August 2, 1984, in which Activision specified which of your clients' answers to interrogatories required further response. I have outlined below by interrogatory number the substance of our conversation.

Interrogatory No. 38. You informed us that Magnavox/Sanders ("Magnavox") does not contend that claims 44 and 45 of the 507 patent are infringed by the use of any Activision game cartridges, and that the remaining claims identified in your response to Interrogatory No. 38 are the only claims at issue. This letter will confirm that this is your final response.

Interrogatory No. 39(c). You informed us that Magnavox still has not determined which additional game cartridges, if any, are alleged by Magnavox to infringe the 507 patent. You indicated that whether Magnavox alleges that the Activision game cartridge known as "Pitfall" is infringing is still undecided. With the trial less than two months away, your clients

EXHIBIT D

unquestionably must decide which games are alleged to infringe. Activision will in all events contend that any games other than those already listed in interrogatory responses cannot be made the subject of this lawsuit.

Interrogatory Nos. 40-41. Activision has decided not to pursue a further response to these interrogatories.

Interrogatory No. 50. You indicated that Magnavox contends that in addition to the television game consoles identified in your earlier response to this interrogatory, the Coleco Gemini and the Atari 5200 with adapter, when combined with one of the named Activision game cartridges and used in combination with a television receiver constitute an active infringement of the 507 patent. This letter will confirm that this is your final response.

Interrogatory No. 54. You informed us that you would check with Magnavox to confirm your belief that other than James Levy's deposition testimony in this action, Magnavox has no other basis for its allegation that Activision's alleged infringements were willful and with full knowledge of the 507 patent.

Interrogatory No. 58(e). Activision has decided not to pursue a further response to this interrogatory.

Interrogatory No. 73(b-j). Activision has decided not to pursue a further response to this interrogatory.

Interrogatory No. 75(a). Activision has decided not to pursue a further response to this interrogatory.

Interrogatory No. 76. Activision has decided not to pursue a further response to this interrogatory.

Interrogatory No. 98(d). You informed us that you would check with your client to confirm your belief that the circumstances under which the decision was made to seek reissue of the 284 patent are set forth in the Reissue Oath.

Interrogatory No. 100(e). You informed us that you would check with your client to confirm that no prior art other

than the references cited on the face of the 507 reissue patent was considered by Magnavox or Sanders in connection with the prosecution of the 507 reissue.

Interrogatory No. 108. You informed us that you would check to see whether you had any additional discussions before the 507 reissue about the spaceship games you observed at Stanford.

Interrogatory Nos. 119-120. You informed us that you would check with your client to determine whether either of them ever considered reissuance of the 480 patent in view of the Althouse patent.

Interrogatory Nos. 126-127, 130-134, 184-192. You informed us that as to the allegedly infringing Activision game cartridges which Magnavox has named to date, these interrogatories reflect Magnavox' final position as to whether and how each such game allegedly infringes each element of the claims of the 507 patent at issue. You expressly would not state, however, that there were no other Activision game cartridges which might also be alleged by Magnavox to infringe the 507 patent, such as "Pitfall." Moreover, to the extent that Magnavox has responded to these interrogatories with the qualifying phrase "at least" preceding an answer, you indicated that Magnavox meant the interaction or interrelationship of "essentially the following parts," rather than to imply that it was leaving open the possibility of additional grounds for alleging infringement. In sum, you indicated that Magnavox' responses to these interrogatories were final based on the present state of your knowledge, but that as to a number of game cartridges you had not finished your discovery and could thus not commit to whether there would be any further response. We, of course, are entitled to know in a timely fashion precisely which Activision game cartridges are alleged to infringe which claims, and your clients' explanation for their contentions regarding infringement.

Interrogatory Nos. 128-129. In the context of our discussions regarding Interrogatory No. 38, you stated that Magnavox does not contend that claims 44 and 45 of the 507 patent are infringed by the use of any Activision game cartridges. If this is so, Interrogatory Nos. 128-129 require no further

response. This letter will confirm that this is your final response.

Interrogatory Nos. 138-139. Interrogatory No. 138 required Magnavox to state whether certain portions of the 480 patent were prior art with regard to the 507 patent. Since we spoke, Activision has narrowed its request under these Interrogatories and seeks only to know whether Magnavox contends that the circuits described at column 7, line 15 to column 8, line 22 are not prior art with regard to the 507 patent. If your answer is that these circuits are not prior art, please elaborate on that response as requested by Interrogatory No. 139.

Interrogatory Nos. 140-152, Part (g). Since we spoke on Friday, Activision has narrowed its request for further responses to this Interrogatory simply to part (i), which seeks the identification of all prototypes and other physical models of Magnavox' alleged inventions.

Interrogatory Nos. 184-192. We covered these interrogatories in our discussion of Interrogatory Nos. 126-127, 130-134, above.

It is our understanding from our telephone conversation that Magnavox has committed finally and definitively to the answers set out above to Interrogatory Nos. 38, 50, 128 and 129. If this is indeed the case, we will accept your answers as fully responsive to these interrogatories.

We are still hopeful that the remaining discovery issues can be resolved between us without necessity of a formal hearing. However, as Marty and I told you when we spoke, because of the advanced stage of this litigation we must file with the Court immediately a motion to compel further responses as described in this letter.

Sincerely yours,

Marla J. Miller

MARLA J. MILLER

MJM/wpc