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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

RAMBUS INC., Plaintiff, v. NVIDIA CORPORATION, Defendant.	Case No. C-08-03343 SI Consolidated with Case No. C-08-05500 SI **ORDER GRANTING IN PART AND DENYING IN PART RAMBUS'S MOTION TO COMPEL NVIDIA TO SUPPLEMENT ITS AMENDED INVALIDITY CONTENTIONS**

Rambus Corporation ("Rambus") has filed a motion to compel NVIDIA to supplement NVIDIA's Amended Invalidity Contentions. NVIDIA Corporation ("NVIDIA") has filed an opposition to the motion, and Rambus a response thereto. The Special Master has considered the submissions and arguments of counsel and rules as follows:[1]

Background

On September 20, 2011, Rambus sent NVIDIA a letter asserting deficiencies in NVIDIA's initial invalidity contentions. On September 30, 2011, NVIDIA filed Amended Patent L.R. 3-3 and 3-4 Invalidity Contentions (the "invalidity contentions"). Rambus believes that NVIDIA's invalidity contentions do not correct any of the deficiencies identified in Rambus's meet and confer correspondence. Further meet and confer efforts were unsuccessful. On October 11, 2011, Rambus submitted the present motion to compel NVIDIA to supplement its invalidity contentions, on the ground that the invalidity contentions do not comply with the Patent Local Rules.

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[1] The Special Master has determined that a hearing is unnecessary in as much as the parties' positions were thoroughly briefed.

Legal Standard

In general, the Northern District's Patent Local Rules "exist to further the goal of full and timely discovery and to provide all parties with adequate notice and information with which to litigate their cases." *Avago Technologies General IP PTE Ltd. v. Elan Microelectronics Corp.,* 2007 WL 951818 at *1 (N.D. Cal., Mar. 28, 2007, C04 05385 JW HRL). "The Rules are designed to require parties to crystallize their theories of the case early in the litigation and to adhere to those theories once they have been disclosed." *Id.* Patent L.R. 3-3(a) provides that "not later than 45 days after service upon it of the 'Disclosure of Asserted Claims and Infringement Contentions,' each party opposing a claim of patent infringement, shall serve on all parties its 'Invalidity Contentions' that must contain the following information:

> (a) The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. . . .
>
> (b) Whether each item of prior art anticipates each asserted claim or renders it obvious. . . .
>
> (c) A chart identifying where specifically in each alleged item of prior art each limitation of each asserted claim is found . . . ; and
>
> (d) Any grounds of invalidity based on 35 U.S.C. § 101, indefiniteness under 35 U.S.C. § 112(2) or enablement or written description under 35 U.S.C. § 112(1) of any of the asserted claims.

Discussion

Rambus contends that NVIDIA's invalidity contentions do not provide sufficient information for Rambus to understand NVIDIA's invalidity contentions, and identifies a number of deficiencies, each addressed below.

A.   Prior Art

1.   Section 102(b)/102(g)

Rambus first contends that NVIDIA does not adequately disclose its "section 102(b)/102(g)" alleged prior art. Rambus asserts that NVIDIA provides no information explaining its contentions with respect to its alleged "Section 102(b)/102(g)" prior art, does not explain which section of the Patent Act the alleged prior art would fall under (subsection (b) or (g), and otherwise fails to comply with Patent L.R. 3-3(a).

NVIDIA contends that it has identified systems and products that it contends are prior art to the asserted patents under sections 102(b) and (g) and provided information about those

references based upon its current knowledge. NVIDIA asserts that by identifying systems and products as section 102(b) and section 102(g) prior art and providing the earliest known date associated with each of the identified products and systems, NVIDIA is clearly stating its contentions that the products and systems were on sale/in public use/or were invented prior to the date of invention of the asserted patents. NVIDIA asserts that it identified each person or entity that it was aware of that might have knowledge regarding the sale, public use or invention of the prior art systems and products. Finally, NVIDIA asserts that:

> Given that discovery is ongoing, NVIDIA is properly continuing to investigate and ascertain additional information for these third-party systems and products. NVIDIA should not at this time be required to have completed all discovery regarding third-party prior art systems and products. In addition, part of NVIDIA's ongoing discovery is a determination as to what priority dates Rambus's patents are entitled to. Rambus has failed to provide discovery that NVIDIA has requested that supports the alleged priority date of Rambus's patents. See Contentions at 3. Without such information, even if NVIDIA's investigation were complete, NVIDIA could not determine with certainty which references are invalidating prior art under sections 102(b) or (g). Rambus's demands are therefore premature.

NVIDIA Opposition at 2.

In reply, Rambus contends that NVIDIA failed to provide § 102(b)/102(g) information required by Patent L.R. 3-3(a).

Patent L.R. 3-3(a) requires that defendant's invalidity contentions contain *inter alia*:

> The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. . . . Prior art under 35 U.S.C. § 102(b) shall be identified by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known or to whom it was made known. . . . Prior art under 35 U.S.C. § 102(g) shall be identified by providing the identities of the person(s) or entities involved in and the circumstances surrounding the making of the invention before the patent applicant(s);

A patent is invalid if the claimed invention was in public use or on sale for more than one year prior to the date of the patent application. 35 U.S.C. § 102(b). Under 35 U.S.C. § 102(g), a person is entitled to a patent unless "before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it."

Section II.A. of NVIDIA's invalidity contentions is entitled "Identification of Prior Art References: Patent L.R. 3-3(a)," and provides in pertinent part as follows:

> Pursuant to Patent L.R. 3-3(a), Exhibit A identifies the prior art references used in

support of NVIDIA's Preliminary Invalidity Contentions. The omission of any reference in Exhibit A is not an admission that any omitted reference, alone or in combination, does not invalidate or affect the validity of Rambus's asserted claims.

With respect to the Section 102(b)/102(g) prior art identified in Exhibit A, discovery is ongoing and NVIDIA is still investigating the identities of the individuals involved in the first sale, offer for sale, or public use of the products or systems, as well as the exact date that such products or systems were first sold, offered for sale, or publicly used. In addition, NVIDIA has not yet completed its investigation of the dates of conception and reduction to practice of the prior inventions, including when the inventions were first known or used by others, and the complete functionality and operation of this prior art. Rambus has also failed to provide requested discovery to support the alleged priority date of its inventions. The dates and individuals identified in Exhibit A are based on the currently available information and NVIDIA reserves the right to amend, supplement or modify these disclosures as more information becomes available.

See Rambus's Exhibit 7 (NVIDIA invalidity contentions) at 2-3. Exhibit A to NVIDIA's invalidity contentions first identifies "prior art patents" and "prior art articles." On pages 10-13 of exhibit A, NVIDIA identifies "102(b)/102(g) Prior Art" as follows:

Referenced As	Item	Date	Entity w/Knowledge
iAPX System	iAPX System	1982	Intel Corporation; David L. Budde; David G. Carson; . . .
iRAM Devices	Intel 2186A Family of integrated RAM (iRAM)	1985	Intel Corporation
CVAX Controller	CVAX Memory Controller (CMCTL)	1986/1987	Digital Equip. Corp./ David K. Morgan
Intel 8-MBIT Flash	8-MBIT (512k X 16, 1024K X 8) SmartVoltage BOOT BLOCK FLASH MEMORY	1995	Intel Corporation
Cydra 5	The Cydra 5 Departmental Supercomputer	1989	Cydrome, Inc.; B. Ramakrishna Rau; David W.L. Yen; . . .
M68000	Motorola M68000 8-/16-/32-Bit Microprocessors User's Manual . . .	1993	FreeScale Semiconductor, Inc.
MC68030	Motorola Enhanced 32-Bit Microprocessor User's Manual	1990	Motorola
. . .	. . .	. . .	. . .

NVIDIA's invalidity contentions do not comply with Patent L.R. 3-3(a) with respect to its identification of prior art under 35 U.S.C. § 102(b) and 35 U.S.C. § 102(g). As an initial matter, NVIDIA does not identify which specific references are asserted under section 102(b) and which

are asserted under section 102(g). NVIDIA's general reference to "102(b)/102(g) Prior Art" is improper. Once NVIDIA properly identifies the prior art relied upon, it must then provide the information required by Patent L.R. 3-3(a). NVIDIA's existing invalidity contentions fail to do so. Rather than providing all of the requested information, NVIDIA instead states that its investigation for the additional information required by Patent L.R. 3-3(a) is ongoing. NVIDIA's lack of information to support its claims does not justify non-compliance with Patent L.R. 3-3(a). NVIDIA must complete its investigation, and provide the information required by Patent L.R. 3-3(a), or it must remove the prior art references for which it lacks the required information.

Accordingly, Rambus's motion compel NVIDIA to supplement its invalidity contentions is GRANTED with respect to NVIDIA's identification of prior art under 35 U.S.C. § 102(b) and 35 U.S.C. § 102(g).

2. Omission of References

As noted above, NVIDIA's identification of prior art references begins as follows "Pursuant to Patent L.R. 3-3(a), Exhibit A identifies the prior art references used in support of NVIDIA's Preliminary Invalidity Contentions. The omission of any reference in Exhibit A is not an admission that any omitted reference, alone or in combination, does not invalidate or affect the validity of Rambus's asserted claims." Rambus Ex. & at 2-3.

Rambus contends that to the extent NVIDIA's statement means that NVIDIA is omitting one or more alleged prior art references from its contentions, yet intends to later argue that such a reference "invalidate[s] or affect[s] the validity" of the asserted claims, is inconsistent with NVIDIA's obligations. Rambus asserts that NVIDIA must include in its contentions the alleged prior art references on which it may rely, and cannot simply state that certain references may be omitted from its contentions. Rambus requests that the Special Master "preclude NVIDIA from relying on any alleged prior art reference that allegedly invalidates or affects the validity of Rambus's asserted claims if such reference is not included in NVIDIA's amended invalidity contentions."

NVIDIA contends that it has identified the references that it intends to rely upon at this time to show that Rambus's claims are invalid, and that it has not omitted any prior art references that it currently intends to rely upon. NVIDIA asserts that Rambus's request that the Special Master preclude NVIDIA from relying on any other prior art reference, Rambus ignores Patent Local Rule 3-6, which allows for amendments to contentions by order of the Court upon a

showing of good cause.

Rambus's request that the Special Master preclude NVIDIA from relying on any prior art reference not included in NVIDIA's amended invalidity contentions is improper. Patent L.R. 3-6 provides that amendment of invalidity contentions "may be made only by order of the Court upon a timely showing of good cause." Consistent therewith, NVIDIA, upon a showing of good cause, may seek leave to amend its invalidity contentions to include new or different prior art references. Accordingly, Rambus's request for a preclusion order is DENIED.

B.   Obviousness Combinations

Rambus next contends that NVIDIA does not provide adequate disclosure of its contentions regarding alleged obviousness combinations. Rambus asserts that NVIDIA's contentions do not, as required by Patent L.R. 3-3(b): (1) disclose any precise combinations of alleged prior art upon which it will rely to show obviousness; and (2) explain why any alleged prior art combinations would render the claims obvious.

In opposition, NVIDIA contends that it has sufficiently disclosed its obviousness combinations. NVIDIA asserts that it has provided charts that "explicitly set forth its obviousness contentions and showed exactly how the various references could be combined," i.e., "NVIDIA provided charts for each primary reference that included all of the secondary references that, when combined with the primary reference, NVIDIA contends render the asserted claims obvious." NVIDIA further asserts that it has explained in detail why Rambus's claims are rendered obvious by the prior art, citing pages 5-21 of its invalidity contentions.

In reply, Rambus states that it "is willing to accept NVIDIA's representations to Your Honor regarding its obviousness disclosure, provided that NVIDIA not attempt to renege on its representations in the future," and that given that NVIDIA asserts that its claim charts "explicitly" set forth its obviousness contentions and combinations, "Rambus accordingly will look to NVIDIA's claim charts for a disclosure of NVIDIA's obviousness contentions and combinations." Rambus, however, requests that the Special Master "should provide that Rambus may review NVIDIA's claim charts with the understanding that the charts 'explicitly set forth its obviousness contentions and showed exactly how the various references could be combined,' as NVIDIA has represented."

Patent L.R. 3-3(b) provides that invalidity contentions must include "[w]hether each item

of prior art anticipates each asserted claim or renders it obvious," and that "if obviousness is alleged, an explanation of why the prior art renders the asserted claim obvious, including an identification of any combinations of prior art showing obviousness." In *Keithley v. The Homestore.com, Inc.*, 553 F.Supp.2d 1148, 1149-51 (N.D. Cal. 2008), the plaintiff filed a motion to strike the defendants' invalidity contentions. The plaintiff argued *inter alia* that the defendants violated Patent Local Rule 3-3(b) by failing to identify each combination of prior art relied upon to render plaintiffs' patent obvious, and that the method in which defendants grouped the references could lead to "thousands or perhaps millions of possible combinations." The defendants argued that given the abundance of invalidating prior art, their approach efficiently and fairly identified the potential obviousness combinations without violating Patent Local Rule 3-3(b). Judge Illston denied the motion, stating in pertinent part that:

> Defendants argue that they utilized the method approved in *Avago Technologies General IP PTE Ltd. v. Elan Microelectronics Corp.*, 2007 WL 951818 (N.D.Cal. Mar.8, 2007) for disclosing obviousness combinations for large groups of prior art documents. In *Avago*, the defendant organized the prior art references into two groups and claimed that the theory of obviousness was true for every possible combination within the two groups. *See Avago*, 2007 WL 951818 at *4. The court held that although the approach resulted in billions of possible obviousness combinations, the defendant still satisfied Patent Local Rule 3-3(b) because it "reasonably specifies the combination of prior art references that allegedly render Avago's patents obvious." *Id.* The Court agrees with the *Avago* court and finds that defendants' grouping method is permissible under the Local Rules.

Keithley, 553 F.Supp.2d at 1150.

Section II.B. of NVIDIA's invalidity contentions is entitled "Anticipation or Obviousness: Patent L.R. 3-3(b)," and provides in pertinent part as follows:

> Pursuant to Patent Local Rule 3-3(b), NVIDIA has identified in Exhibit B1 whether each item of prior art anticipates each asserted claim and/or renders it obvious. References identified in Exhibit B1 may disclose the elements of the asserted claims explicitly and/or inherently and/or may be relied upon to show, among other things, the state of the art in the relevant timeframes and/or motivations to combine references, predictable results of combining known elements, the interrelated teachings of the patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art.
>
> Anticipatory prior art references are listed under the title "§ 102 Prior Art References" of Exhibit B1. The prior art references that render the asserted claims obvious are listed under the title "§ 103 Prior Art References" of Exhibit B1. If any reference identified as anticipating is found not to teach, explicitly or inherently, any element of any asserted claim, any such missing element would have been obvious to one of ordinary skill in the art at the time of the alleged invention. Also, to the extent that any prior art

identified is found not to teach, explicitly or inherently, any element of the asserted claims, any such missing element is supplied by a combination of that prior art with any or all of the other references disclosed in Exhibit B that are found to teach that element, such that the combination of two or more prior art references includes each element of the asserted claims. Specific combinations are shown in the claim charts provided pursuant to Patent Local Rule 3-3(c) (Exhibit C), where the primary reference shown in each chart may be combined with one or more of the secondary references shown in the chart. To the extent NVIDIA relies on the same prior art for both anticipation and obviousness, obviousness contentions are in the alternative and should not be construed to suggest that any prior art included in the combination is not anticipatory.

See Rambus's Exhibit 7 at 3-4. Pages 4-21 of NVIDIA's invalidity contentions provide an explanation of why NVIDIA believes that the prior art renders the asserted claims obvious.

"Exhibit B1: Amended Patent L.R. 3-3(b) Disclosure" provides in limited part as follows:

Asserted Claim	§102 Prior Art References	§103 Prior Art References
U.S. Pat. 6,564,281, Claim 36	Novak iAPX Manual Budde Dosaka iAPX System Barth Park JEDEC 21-C	Novak iAPX Manual Budde Barth Park SCI-A through J Bennett Baror Johnson Olson Wicklund Rosen Bowater Chappell Diefendorff Dosaka Itoh Etoh Houston iRAM/iRAM Devices Lu Moussouris iAPX System SCI Systems & Products AM29000/ AM29000 DS AM29C668/ AM29C668 DS TMS626162/ TMS626162 DS,TR TMS626802/ TMS626802 DS JEDEC 21-C

NVIDIA's invalidity contentions first set forth the prior art references that it contends

anticipate or render the asserted claims obvious. While NVIDIA's invalidity contentions do not expressly identify each specific possible combinations of prior art showing obviousness, pages 3-4 of the invalidity contentions, along with exhibits B-1 and C, reasonably specify the possible combinations of prior art references that allegedly render Rambus's patents obvious. Similar allegations have been found to comply with Patent L.R. 3-3(b). *See Keithley, supra.* NVIDIA also adequately explains why the identified prior art allegedly renders the asserted claims obvious. In sum, NVIDIA's invalidity contentions comply with Patent L.R. 3-3(b). Accordingly, Rambus's motion to compel NVIDIA to supplement its invalidity contentions to comply with Patent L.R. 3-3(b) is DENIED.

C.   Section 112 Contentions

Finally, Rambus contends that NVIDIA's section 112 contentions are deficient for three reasons. Each will be addressed in turn.

1.   Written Description

Rambus argues that while section II.D.1 of NVIDIA's invalidity contentions lists seven claim term categories for the Farmwald/Horowitz patents and two claim term categories for the Barth II patents that allegedly fail to comply with the written description and enablement requirements, NVIDIA's categories are not specific (i.e., do not identify the patents, claims, or claim terms that allegedly fall within each category constructed by NVIDIA) and that therefore the invalidity contentions do not provide Rambus with fair notice of how NVIDIA's § 112 allegations relate to specific patents, claims, or claim terms.

NVIDIA contends that Patent L.R. 3-3(d) does not require a claim by claim analysis for invalidity contentions based on Section 112, and that moreover, the claim features that NVIDIA has identified are sufficiently detailed to allow Rambus to discern the relevant limitations of the asserted claims that each category applies to.

In reply, Rambus asserts that "NVIDIA should identify the claim limitations to which it refers, rather than using vague 'features' which may have meanings that could be disputed by the parties."

Patent L.R. 3-3(d) provides that invalidity contentions shall contain "[a]ny grounds of invalidity based on . . . enablement or written description under 35 U.S.C. § 112(1) of any of the asserted claims." 35 U.S.C. § 112(1) provides that "[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full,

clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

Section II.D.1 of NVIDIA's invalidity contentions addresses NVIDIA's invalidity defenses based on the violation of the written description and enablement requirements of 35 U.S.C. § 1121 with respect to the asserted Farmwald patents, and the asserted Barth II patents. *See* Rambus Exhibit 7 at 22-29.   For example, with respect to the Barth II patents, the invalidity contentions provide as follows:

> The Barth II patents all claim priority to provisional Application No. 60/061,770 (the "'770 application") and share the same specification. Deficiencies in the written description and failure to satisfy the enablement requirement therefore apply to each of Barth II patents claiming a feature unsupported by the Barth II specification.

> (1)   The Written Description And Enablement Requirements are not Met for Claims That Fail to Require Precharging

> The Barth II specification does not describe or enable a method of operating an integrated circuit memory device that does not include a precharge command. Barth II teaches that a precharge command must precede a row access by the sense command. '050 Patent, Fig. 13; Fig. 14; Fig. 21; Fig. 23; Fig. 31-32; Fig 34-35; Fig. 40-45; Fig 47. Specifically, Barth II discloses "the sequence of memory operations is relatively limited. In particular, there is a universal sequence: precharge, sense, transfer (read or write), and close." '050 Patent, 3:27-34. The asserted claims, however, call for a method of operating an integrated circuit memory device whereby a sense command is issued first, without a precharge command, and followed by a write command. The asserted claims do not follow the necessary command sequence disclosed in the Barth II specification and therefore are not supported by the written description and are not enabled.

> (2)   The Written Description And Enablement Requirements are not Met for Claims Directed to Providing At Least Two Consecutive Bits of Write Data During a Clock Cycle of the Clock Signals

> The written description of the original disclosure does not describe or enable providing two consecutive bits of write data during a clock cycle of the clock signals. The original disclosure does not disclose providing data on both the rising and falling edge of an external clock signal or otherwise. Claims that require providing two consecutive bit of write data during a clock cycle are not supported by the written description in the '770 application.

Rambus Exhibit 7 at 29.

As noted by Rambus, NVIDIA's invalidity contentions with respect to the enablement and written description requirements of section 112(1) do not specify the specific claims and claim elements that fall within the categories identified by NVIDIA. Patent L.R. 3-3(d) does not specifically require such a showing. However, the relevant question for purposes of this motion is whether NVIDIA's invalidity contentions crystallize NVIDIA's theories with respect to the enablement and written description requirements of section 112(1). The Special Master concludes that the claim features identified by NVIDIA are insufficient to state NVIDIA's theories with the requisite specificity. In order to crystallize its claims, NVIDIA must identify the actual claim limitations (including the specific patents and the specific claims or claim terms) supporting its contentions with respect to written description.

Accordingly, Rambus's motion to compel NVIDIA to supplement its invalidity contentions is GRANTED with respect to NVIDIA's contentions regarding written description under 35 U.S.C. § 112(1).

2. Lack of Enablement

Rambus contends that while NVIDIA states in a conclusory manner that the claim term categories constructed by Rambus are not enabled, NVIDIA does not provide any analysis of the reason(s) for the alleged lack of enablement, and does not explain how any of the factors identified in *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988) apply to the patent claims in issue.

NVIDIA contends that Patent L.R. 3-3(d) requires NVIDIA to lay out "[a]ny grounds of invalidity based on enablement or written description under 35 U.S.C. § 112(1)," and that nothing in Rule 3-3(d) requires NVIDIA to engage in a *Wands* analysis in its invalidity contentions.

In reply, Rambus asserts that NVIDIA's invalidity contentions do not state NVIDIA's grounds of invalidity based on enablement as is required by Patent L.R. 3-3(d). Rambus asserts that while NVIDIA could do so by use of the *Wands* factors, it need not, and may instead provide any description that adequately describes its "grounds of invalidity" for enablement as opposed to a superficial statement that certain claim features are not enabled.

Again, Patent L.R. 3-3(d) provides that invalidity contentions shall contain "[a]ny grounds of invalidity based on . . . enablement or written description under 35 U.S.C. § 112(1) of any of the asserted claims." The parties appear to agree that Patent L.R. 3-3(d) does not require that NVIDIA engage in a *Wands* analysis in its invalidity contentions. NVIDIA's invalidity contentions, however, must crystallize its enablement and written description arguments. Section

II.D.1 of NVIDIA's invalidity contentions does not adequately set forth the reasons for the alleged lack of enablement of the identified claim term categories.

Accordingly, Rambus's motion to compel NVIDIA to supplement its invalidity contentions is GRANTED with respect to NVIDIA's contentions regarding lack of enablement under 35 U.S.C. § 112(1).

3. Indefiniteness

Rambus contends that with respect to the indefiniteness issue, while NVIDIA groups together certain claim terms and alleges that "at least the claim limitations" it recites are indefinite for various reasons, NVIDIA's use of "at least" is impermissibly vague because NVIDIA does not identify the precise limitations alleged to be indefinite.

NVIDIA contends that Rambus provides no support for its conclusion that NVIDIA's indefiniteness arguments are deficient. With respect to its use of the language "at least," NVIDIA asserts that it "has identified a finite number of claims that it contends are indefinite; the number of limitations is therefore also finite," and that "NVIDIA's use of the phrase is proper in light of the fact that discovery is ongoing and that legal determinations by the Court, including claim construction, may have an effect on which claims of Rambus's asserted patents are indefinite."

In reply, Rambus asserts that NVIDIA has not explained why it should be permitted to use an open-ended phrase like "at least" to identify the claim limitations alleged to be indefinite, and that if NVIDIA is alleging that claim limitations are indefinite, it should identify those claim limitations.

Patent L.R. 3-3(d) provides that invalidity contentions shall contain "[a]ny grounds of invalidity based on . . . indefiniteness under 35 U.S.C. § 112(2) of any of the asserted claims." 35 U.S.C. § 112(2) states that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

Pages 30-34 of NVIDIA's invalidity contentions set forth NVIDIA's contentions with respect to why the Farmwald and Barth II patents are indefinite under 35 U.S.C. § 112(2). The following portion of the invalidity contentions with respect to the Farmwald patents is exemplary of the remainder of NVIDIA's contentions with respect to indefiniteness:

> NVIDIA contends that at least the claim limitations "the output driver circuitry to:
> output a value . . . output a first operation code . . . and output the second operation code,"
> "wherein the first operation code instructs the memory device to store the value in a

register in the memory device," "wherein the second operation code instructs the memory device to perform a read operation," "wherein the second operation code includes precharge information that indicates to the memory device whether the memory device should precharge sense amplifiers on the memory device after sensing data," and "the input receiver circuitry to sample the first portion of the read data after a read delay" in claim 19 of the '997 patent (and incorporated into dependent claims) makes the claims indefinite as it attempts to claim both an apparatus and a method for using that apparatus.

NVIDIA contends that at least the claim limitations "the output driver circuitry to: output a value . . . output a first operation code . . . output a block size value . . . and output the second operation code," "the second operation code includes an indication to the memory device as to whether the memory device should precharge sense amplifiers," and "the input receiver circuitry to sample the first portion of the read data after a read delay" in claim 38 of the '997 patent makes the claim indefinite as it attempts to claim both an apparatus and a method for using that apparatus.

NVIDIA contends that at least the claim limitation "wherein in response to the operation code, the memory device outputs a first portion of data synchronously with respect to a rising edge transition of an external clock signal and a second portion of data synchronously with respect to a falling edge transition of the external clock signal" in claim 18 of the '937 patent (and incorporated into dependent claims) makes the claims indefinite as it attempts to claim both an apparatus and a method for using that apparatus.

Rambus Exhibit 7 at 30.

NVIDIA's invalidity contentions with respect to indefiniteness do not comply with Patent L.R. 3-3(d). NVIDIA's repeated statements that "at least the claim limitations" in a claim of a specific patent make the claims indefinite do not specifically identify the precise limitations alleged to be indefinite, and instead suggests that NVIDIA has not included all allegedly known indefinite claim limitations. NVIDIA's inclusion of the "at least the claim limitations" statements avoids its obligation to specifically identify the claims limitations it asserts are indefinite. NVIDIA must amend its invalidity contentions to remove the "at least" language from indefiniteness allegations.

Accordingly, Rambus's motion to compel NVIDIA to supplement its invalidity contentions is GRANTED with respect to NVIDIA's indefiniteness contentions under 35 U.S.C. § 112(2).

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D. Conclusion

Consistent with the foregoing, Rambus's motion to compel NVIDIA to supplement its invalidity contentions is GRANTED IN PART AND DENIED IN PART. NVIDIA shall file second amended invalidity contentions consistent with this Order no later than December 15, 2011.

IT IS SO ORDERED.

Dated: November 29, 2011

_____/s/_____
Edward A. Infante
Special Master

PROOF OF SERVICE BY E-Mail

Re: Rambus, Inc. vs. Nvidia Corporation
Reference No. 1100058440

I, Sandra Chan, not a party to the within action, hereby declare that on November 29, 2011

served the attached ORDER GRANTING IN PART AND DENYING IN PART RAMBUS'S MOTION TO

COMPEL NVIDIA TO SUPPLEMENT ITS AMENDED INVALIDITY CONTENTIONS on the parties in

the within action by electronic mail at San Francisco, CALIFORNIA, addressed as follows:

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    Parties Represented:

I declare under penalty of perjury the foregoing to be true and correct. Executed at San

Francisco, CALIFORNIA on November 29, 2011.

Schan@jamsadr.com