

**United States District Court**  
EASTERN DISTRICT OF TEXAS  
SHERMAN DIVISION

ROUND ROCK RESEARCH, LLC

v.

DELL INC.

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Case No. 4:11-CV-332  
Judge Clark/Judge Mazzant

**ORDER**

Pending before the Court are Plaintiff's Motion to Compel Non-Infringement Contentions from Dell, Inc. (Dkt. #76) and Defendant Dell Inc.'s Motion to Limit Number of Asserted Claims (Dkt. #71). Having considered the relevant pleadings, the responses thereto, the Court finds that both motions should be granted.

**BACKGROUND**

Plaintiff asserts violations of ten patents against one hundred and twenty different products of Defendant. On February 22, 2012, Plaintiff filed a Motion to Compel Non-Infringement Contentions from Defendant (Dkt. #76). On March 12, 2012, Defendant filed a response to the motion (Dkt. #82). On March 22, 2012, Plaintiff filed a reply (Dkt. #88)

On January 23, 2012, Defendant filed its Motion to Limit the Number of Asserted Claims (Dkt. #71). Defendant contends that Plaintiff has asserted between 82 different claims with respect to 120 different products from the ten patents-at-issue against it. Defendant argues that the large number of claims is unmanageable for claim construction, fact discovery, expert reports, depositions, and trial. On February 9, 2012, Plaintiff filed its response to the motion (Dkt. #74). On February 21, 2012, Defendant filed a reply (Dkt. #75). On February 28, 2012, Plaintiff filed a sur-reply (Dkt. #78).

## ANALYSIS

### *Motion to Compel Non-Infringement Contentions*

Generally, parties may obtain discovery regarding any matter, not privileged, that is relevant to any party's claim or defense. Fed. R. Civ. P. 26. A party may specifically and timely object to an interrogatory, but otherwise an interrogatory must be answered fully. Fed. R. Civ. P. 33. "An evasive or incomplete disclosure, answer, or response must be treated as a failure to disclose, answer, or respond." Fed. R. Civ. P. 37. Local Patent Rule 2-5 provides that a party may not object to an opposing party's discovery request or decline to provide information otherwise required to be disclosed on the basis that the disclosure is premature in light of the Patent Rules. However, a party may object to responding to some categories of discovery requests on the basis that the requests are premature in light of the timetable provided by the rules. P.R. 2-5. One of those categories includes requests seeking to elicit a party's claim construction position. P.R. 2-5.

Plaintiff argues that it is entitled to substantive responses regarding its Interrogatory No. 6, which reads as follows:

Separately for each Dell product listed in Exhibit 2 of Round Rock Research's Disclosure of Asserted Claims and Infringement Contentions or identified in Dell's response to Interrogatory No. 4, identify all factual and legal bases for Dell's contention that each such product does not infringe the Patents-in-Suit directly (either literally or under the doctrine of equivalents) and indirectly (either by inducement or contributory infringement).

Specifically, Plaintiff requests Defendant provide non-infringement contentions in response to Interrogatory No. 6. Defendant asserts that the request prematurely seeks to elicit Defendant's claim construction positions. Further, Defendant argues that the request is unduly burdensome and unreasonable given the amount of claims alleged by Plaintiff.

Plaintiff's request is not designed to elicit Defendant's claim construction position, and is attempting to specifically determine Defendant's non-infringement contentions. Therefore, under Patent Rule 2-5, Defendant's objection that Interrogatory No. 6 is premature is an improper objection. Further, Defendant's argument has been rejected by other courts in this district. *See Personal Audio, LLC v. Apple, Inc.*, No. 9:09-CV-111, slip op. at 1-4 (E.D. Tex. June 1, 2010). Therefore, the Court finds Plaintiff's Motion to Compel should be granted.

***Motion to Limit Number of Asserted Patent Claims***

The Court may limit the number of Plaintiff's claims prior to claim construction. *In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1311-1312 (Fed. Cir. 2011). "When the claimant is in the best position to narrow the dispute, allocating the production burden to the claimant will benefit the decision-making process and therefore will not offend due process unless the burden allocation unfairly prejudices the claimant's opportunity to present its claim." *Id.* at 1311. Further, courts in the Eastern District of Texas have required plaintiffs to "limit the number of asserted claims in cases for patent infringement when the number of claims is so large as to make the case inefficient and unmanageable." *Realtime Data, LLC v. Packeteer*, No. 6:08-CV-144 (E.D. Tex. March 16, 2009) (citing *Negotiated Data Solutions, LLC v. Dell, Inc.*, No. 2:06-CV-528 (E.D. Tex. July 31, 2008) (Everingham, J.) (ordering plaintiff to limit asserted claims to 40 on or before the due date for its opening *Markman* brief); *Hearing Components, Inc. v. Shure, Inc.*, No. 9:07-CV-104, 2008 WL 2485426, at \*1 (E.D. Tex. June 13, 2008) (Folsom, J.) (ordering parties to elect no more than ten claim terms for construction and further ordering plaintiff to select no more than three representative claims from each asserted patent for claim construction and trial)).

The Court finds that limiting the amount of claims asserted by Plaintiff is appropriate at this

time to aid in efficiency and narrowing the claims prior to claim construction. Therefore, the Plaintiff should reduce the number of asserted claims to forty (40) total claims across all ten (10) patents-at-issue in this case. Plaintiff may move the Court to add additional claims that present a distinct issue of infringement or invalidity, upon a showing of good cause.

**CONCLUSION**

Based on the foregoing, the Court finds the Plaintiff's Motion to Compel Non-Infringement Contentions from Defendant (Dkt. #76) should be GRANTED. Further, the Court finds Defendant's Motion to Limit Number of Asserted Claims (Dkt. #71) should be GRANTED.

Plaintiff is ORDERED to limit the number of patent claims asserted to forty (40) total claims across all ten (10) patents-at-issue within seven (7) days following the date of this Order.

Defendant is ORDERED to respond to Interrogatory No. 6 regarding its non-infringement contentions within fourteen (14) days following the date of this Order.

IT IS SO ORDERED.

**SIGNED this 26th day of March, 2012.**

  
AMOS L. MAZZANT  
UNITED STATES MAGISTRATE JUDGE