Misc. Docket No. 04-762

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

In Re RAMBUS INC.,

Petitioner

On Writ of Mandamus from the United States District Court for the Eastern District of Virginia, Case No. 3:00-CV-524 (Judge Robert E. Payne)

Opposition of Rambus Inc. to Infineon's Motion To Dismiss Mandamus Petition As Moot

Infineon's Motion to Dismiss Rambus's Petition for Writ of Mandamus is based entirely on the premise that any predictions "about what the district court *might* do in any further proceedings are speculative." Motion to Dismiss at 2. But as Rambus has pointed out in its Reply Memorandum In Support Of Motion To Hold Petition For Writ Of Mandamus In Abeyance, the District Court has neither reconsidered nor withdrawn its fundamental (and fundamentally erroneous) conclusion that Rambus must be deemed to have waived the attorney-client privilege by adopting and disseminating a corporate policy after receiving legal advice with respect to that policy. On the contrary, as explained in Rambus's Reply Memorandum, the District Court has reaffirmed its waiver ruling based on

the very grounds that Rambus has challenged in its petition for mandamus. *See* District Court Opinion of March 17, 2004, at 63-64 (attached as Exh. C to Motion to Hold in Abeyance); *see also* Transcript of March 26, 2004 District Court Hearing, at 219 (attached as Exh. F to Reply to Motion to Hold in Abeyance).

The District Court has ordered the parties to address the *scope* of the subject-matter of Rambus's supposed waiver of its privilege. Infineon has continued to maintain that the scope of that waiver is extraordinarily broad, encompassing (at a minimum) all documents and communications pertaining to Rambus's document retention policy, at least up to the time of the first trial and perhaps longer. And the District Court has suggested that the waiver might extend as far as Rambus's entire patent-litigation strategy. *See* March 17 Opinion at 65. Thus, it is only the exact scope of Rambus's obligation to disclose privileged communications that has not been definitively settled. In light of the District Court's March 17 Opinion reaffirming its conclusion that Rambus waived the privilege, however, it is a virtual certainty that Rambus will be required to disclose privileged documents forthwith.

The District Court will very likely rule on the scope of the waiver within a matter of days. The District Court has scheduled a hearing on this topic for a week from today, April 15. Now pending, after a hearing (without a ruling) on March 26, is Rambus's Motion to Dismiss Infineon's new California Civil Code § 17200

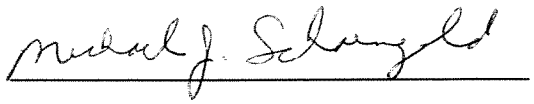
unfair business practices claim that underlies this discovery. The discovery cutoff in this case is April 26, and the scope of discovery will be directly affected by the District Court's scope of waiver ruling. Trial is scheduled for June 10. Given the rapidly-advancing schedule in District Court, holding Rambus's mandamus petition in abeyance until the District Court issues an amended order remains the most efficacious manner of conserving the resources of this Court and of the parties. The only possible prejudice to Infineon that might result if this Court holds the petition in abeyance would be that Infineon would lose its tactical advantage of forcing Rambus to re-file from scratch a petition to protect its privileged documents while simultaneously preparing for the impending trial date of June 10. Infineon, on the other hand, does not have to do anything with respect to the petition unless and until the District Court enters a revised order and this Court directs Infineon to file an answer to the mandamus petition that, to this date, Infineon has never written. The equities, in the unique circumstances of this case, weigh in favor of holding the petition in abeyance.

As pointed out in Rambus's Reply Memorandum, avoiding needless dismissal and re-filing of appellate proceedings is hardly unprecedented. *Cf.* Fed. R. App. Proc. 4(a)(4)(B) (establishing that a notice of appeal is not mooted simply because a district court considers post-judgment motions filed after a notice of appeal has been filed). Indeed, Infineon has cited no case (published or otherwise)

holding that dismissal is mandated in these circumstances. In these circumstances, the best use of judicial resources, where a panel of Judges has already reviewed the Mandamus Petition and related papers, is for this Court to hold the petition in abeyance until such time as the District Court issues an amended order and opinion on the scope of the waiver, at which time Rambus will supplement, if necessary.

For the foregoing reasons, as well as those stated in Rambus's Motion to Hold in Abeyance and its Reply Memorandum, this Court should deny Infineon's Motion to Dismiss Rambus's Petition for Writ of Mandamus.

Respectfully submitted,



Michael J. Schaengold
PATTON BOGGS LLP
2550 M Street, NW
Washington, DC 20037
Telephone: (202) 457-6523
Facsimile: (202) 457-6315

Attorney for RAMBUS INC.

Dated: April 8, 2004