

Misc. No. 04-762

---

**United States Court of Appeals  
for the Federal Circuit**

---

**In re RAMBUS INC.,**

*Plaintiff/Petitioner,*

---

**From an order of the United States District Court for  
the Eastern District of Virginia (No. 3:00-CV-524)**

**The Honorable Robert E. Payne**

---

**MOTION TO DISMISS MANDAMUS PETITION AS MOOT AND  
OPPOSITION TO MOTION TO HOLD PETITION "IN ABEYANCE"**

---

John M. Desmarais  
Gregory S. Arovas  
Steven J. Lever  
KIRKLAND & ELLIS LLP  
Citigroup Center  
153 East 53rd Street  
New York, NY 10022  
(212) 446-4800

Christopher Landau  
KIRKLAND & ELLIS LLP  
655 Fifteenth Street, N.W.  
Suite 1200  
Washington, D.C. 20005  
(202) 879-5000

*Attorneys for Respondents Infineon Technologies AG,  
Infineon Technologies North America Corp., and  
Infineon Technologies Holding North America Inc.*

March 24, 2004

## I. INTRODUCTION

On March 12, 2004, petitioner Rambus, Inc. filed a petition seeking a writ of mandamus from this Court “directing the District Court to vacate its February 26, 2004, order requiring Rambus to produce all documents containing information about or relating to the creation, preparation, or scope of its document retention policy.” Pet. 30. In the petition, Rambus noted that it had sought a stay from the district court, which “thus far has not acted on that motion.” Pet. 1.

Last week, on March 17, 2004, the district court acted on the motion, and *granted* Rambus the relief requested in the mandamus petition: the court *vacated* the challenged February 26 order, and entered an amended order retaining under consideration Infineon’s motion to compel production of documents relating to Rambus’ document retention policy pending completion of an *in camera* review. *See* 3/17/04 Order, 3/17/04 Amended Order (attached at Tabs D and E of Rambus’ Abeyance Mot.). Accordingly, Rambus is no longer under any compulsion to produce any allegedly privileged document, and its mandamus petition is moot.

Rather than withdrawing the petition, however, Rambus has now filed a motion asking this Court to “temporarily hold in abeyance its petition for writ of mandamus.” Abeyance Mot. 1. According to Rambus, a new order from the district court “may well expand on the reasoning in and breadth of the original order from which Rambus has sought relief,” and “will almost certainly raise many

if not most of the issues that are raised in Rambus’s currently pending mandamus petition.” *Id.* at 1-2. If that were to happen, Rambus proposes “to supplement or amend its petition for mandamus.” *Id.* at 1.

As explained below, that proposal is wholly irregular and should be rejected. Rambus’ predictions about what the district court *might* do in any further proceedings are speculative. If and when the district court rules against Rambus, Rambus is free to file another mandamus petition. If any of the original petition remains relevant, then Rambus can readily modify the petition on its word-processing system. But there is no basis in principle or precedent for leaving the original petition “in abeyance” once moot, and thereby potentially forcing this Court to review (and Infineon to respond to) multiple mandamus petitions, and effectively allowing Rambus to evade the 30-page limit. The proper course here, and the course this Court has followed on many occasions in unpublished orders, is to deny the petition as moot on the ground that the district court has vacated the challenged order.

## **II. BACKGROUND**

The underlying dispute in this case is described in this Court’s opinion in *Rambus, Inc. v. Infineon Tech. AG*, 318 F.3d 1081 (Fed. Cir. 2003). During proceedings on remand from that decision, it became clear that Rambus had failed to produce a significant number of documents during the initial discovery phase of

this case. Accordingly, last November, the district court ordered Rambus to review Infineon's original document requests and produce all responsive, non-privileged documents that previously had been requested but never produced to Infineon. In response to that order, Rambus produced approximately thirty boxes of documents and a vastly expanded privilege log, adding roughly 2,300 additional entries to its original log. *See* 3/17/04 Amended Mem. Op. (attached at Tab C of Rambus' Abeyance Mot.), at 7-9.

After reviewing these thirty boxes and the new privilege log, Infineon discovered the likelihood that Rambus had engaged in a massive scheme to destroy documents and evidence just before launching a series of patent infringement lawsuits. Based on this newly discovered evidence, on January 5, 2004, Infineon filed a motion in the district court to compel production of numerous documents (and related testimony) identified on the privilege log based on the "crime-fraud exception" to the attorney-client privilege and voluntary subject matter waiver. On February 26, 2004, in a 67-page opinion, the district court granted in part and retained for further consideration in part Infineon's motion. *See* 2/26/04 Order; 2/26/04 Mem. Op. (attached at Tabs A and B of Rambus' Abeyance Mot.). Specifically, the court granted Infineon's motion to compel based on the subject matter waiver and retained for consideration Infineon's crime-fraud exception

arguments pending completion of an *in camera* review of withheld documents identified on Rambus' privilege log.

On March 3, 2004, Rambus filed in the district court a Motion For Stay Of The Ordering Provisions Of The Second Paragraph Of The Court's February 26, 2004 Order ("Motion For Stay") in anticipation of filing a mandamus petition, and on March 12, Rambus filed its mandamus petition in this Court. Rambus expressly limited the relief requested to vacating that portion of the February 26 order compelling immediate production of documents containing information about or relating to the creation, preparation, or scope of Rambus' document retention policy. *See* Pet. 11 n.4, 30.

On March 17, 2004, the district court vacated the specific portion of its February 26 order upon which Rambus had based its petition, *see* 3/17/04 Order (attached at Tab D to Rambus Abeyance Mot.), and entered an amended memorandum opinion and order (attached at Tabs C and E to Rambus Abeyance Mot.). Nonetheless, on March 19, 2004, Rambus filed in this Court a motion to hold its original mandamus petition "in abeyance." Infineon now opposes that motion, and moves to dismiss Rambus' mandamus petition as moot.<sup>1</sup>

---

<sup>1</sup> Rambus does not consent to this motion. When Rambus contacted Infineon to ask whether Infineon consented to Rambus' motion to hold the petition "in abeyance," Infineon responded that it did not, on the ground that the petition was moot. By proceeding to file the motion anyway, over Infineon's objection, (Continued...)

### III. ARGUMENT

Rambus' mandamus petition is moot for the simple reason that the district court has vacated the order challenged in that petition, and Rambus is under no compulsion to produce any allegedly privileged documents. *See* 3/17/04 Order at 1-2 (“[I]t is hereby ORDERED that the February 26 Opinion and the Order implementing it ... *are vacated.*”) (emphasis added); *see also* 3/17/04 Amended Order at 2 (“[T]he Motion to Compel Production of Documents Relating to Rambus' Document Retention Policy of the Defendants ... is RETAINED UNDER CONSIDERATION pending completion of the *in camera* review.”). That should be the beginning and end of the matter.

While acknowledging that “Rambus is not under an immediate obligation to produce privileged materials to Infineon,” Mot. 9, Rambus nonetheless asks this Court to keep its mandamus petition “in abeyance until the District Court issues a new or amended order,” *id.* at 2. That course of action is appropriate, Rambus asserts, because “it is a *virtual certainty* that, once the District Court completes its *in camera* review, it will order Rambus to make a production of privileged communications that will be at least as extensive as the production that the District Court ordered on February 26.” *Id.* at 9 (emphasis added); *see also id.* (“Once the

---

Rambus clearly indicated its belief that the petition should not be dismissed as moot.

*in camera* review is completed and a new order is issued, ... Rambus will almost certainly have to renew virtually all of the arguments that have been raised in its petition for mandamus.”).

That assertion is not only speculative, but insulting to the district court. The district court has ordered a new round of briefing on the issue of subject matter waiver (the subject of the petition), and has scheduled oral argument on that issue for April 15, 2004. *See* 3/23/04 Order (attached hereto). Rambus is essentially saying that it already knows the outcome of that proceeding, and knows not only that future mandamus relief will be necessary, but also the basis for such future mandamus relief. That is not the way our system works. Unless and until the district court orders Rambus to take some action, relief from this Court is premature, and the fact that Rambus thinks it will lose below (and thinks it knows the reasons for that loss) does not make relief any less premature. It is telling that Rambus cites no authority supporting its request to place its mandamus petition in appellate limbo.

If Rambus’ prediction were to prove correct, and the district court were to order Rambus to produce the disputed documents for essentially the same reasons as before, then Rambus could simply amend its original petition accordingly. The suggestion that keeping that 30-page petition “in abeyance,” and filing an “amended” or “supplemental” petition (presumably also up to the 30-page limit)

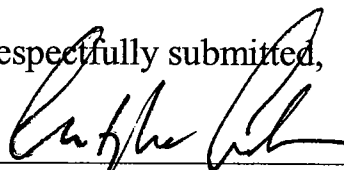
would “promote judicial economy” is baseless: to the contrary, Rambus’ proposal would force this Court not only to review (and Infineon to respond to) *multiple* petitions, but to figure out which portions of the original petition remain intact in light of subsequent proceedings and orders. For example, the subject matter waiver issue may become moot if the district court were to order the production of all the disputed documents on “crime/fraud” grounds, which may explain why the district court decided to retain that issue under consideration until it resolves the “crime/fraud” issue. There is simply no need to walk into this thicket of complexity: Rambus can always file a new mandamus petition if and when the district court requires it to produce allegedly privileged documents.

#### IV. CONCLUSION

For the foregoing reasons, this Court should dismiss as moot Rambus’ petition for writ of mandamus, and deny Rambus’ motion to hold that petition “in abeyance.”

John M. Desmarais  
Gregory S. Arovas  
Steven J. Lever  
KIRKLAND & ELLIS LLP  
Citigroup Center  
153 East 53rd Street  
New York, NY 10022  
(212) 446-4800

Respectfully submitted,



---

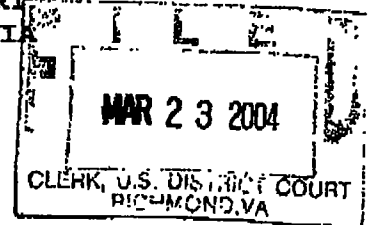
Christopher Landau  
KIRKLAND & ELLIS LLP  
655 Fifteenth Street, N.W.  
Suite 1200  
Washington, D.C. 20005  
(202) 879-5000



*Attorneys for Respondents Infineon Technologies AG,  
Infineon Technologies North America Corp., and  
Infineon Technologies Holding North America Inc.*

March 24, 2004

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF VIRGINIA  
Richmond Division



RAMBUS, INC.,  
Plaintiff,

v.

Civil No. 3:00CV524

INFINEON TECHNOLOGIES AG,  
et al.,

Defendants.

ORDER

For the reasons stated on the record on March 23, 2004, the parties shall file papers addressing the topic of subject matter waiver as it pertains to the attorney-client and work product privileges on the following schedule:

- The Plaintiff shall file its memorandum addressing the issue by March 30, 2004;
- The Defendants shall file a response by April 6, 2004;
- The Plaintiff may file a reply by April 9, 2004;
- A hearing on the issue shall be held on April 15, 2004 at 8:00 AM.

The Clerk is directed to send a copy of this Order to all counsel of record.

It is so ORDERED.

  
UNITED STATES DISTRICT JUDGE

Date: March 23, 2004  
Richmond, VA