

**UNITED STATES OF AMERICA  
BEFORE FEDERAL TRADE COMMISSION**

**Public**

In the Matter of

RAMBUS INCORPORATED,

a corporation.

Docket No. 9302

**MEMORANDUM IN SUPPORT OF MOTION *IN LIMINE* TO BAR PRESENTATION,  
ON COLLATERAL-ESTOPPEL GROUNDS, OF TESTIMONY AND ARGUMENTS  
REGARDING ISSUES THAT RAMBUS HAS PREVIOUSLY LITIGATED AND LOST**

Complaint Counsel hereby moves to bar Respondent Rambus Inc. from presenting testimony and arguments regarding issues that it fully litigated in *Rambus Inc. v. Infineon Technologies AG*, 155 F. Supp. 2d 668 (E.D. Va. 2001), *aff'd in part, rev'd in part, and vacated in part*, 318 F.3d 1081 (Fed. Cir. 2003). Rambus is properly barred from presenting evidence or arguments on such issues on collateral-estoppel grounds, because it has already had a full and fair opportunity to litigate these issues in another forum. Permitting Rambus to relitigate these issues here would waste the resources of the Commission, create needless delay, and would create the risk of inconsistent decisions.

**Argument**

Collateral estoppel may be used to bar a party from relitigating an issue on which it has been fully heard and lost. “[A] party who has had one fair and full opportunity to prove a claim and has failed in that effort, should not be permitted to go to trial on the merits of that claim a second time.” *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313, 324-25 (1971). The purpose of the doctrine is to “protect[] adversaries from, the expense and vexation



*Weems*, 49 F.3d 528, 531-32 (9th Cir. 1995).

Each of the findings discussed below satisfies the rule of collateral estoppel that the findings be “necessary.” See Order Granting Complaint Counsel’s Motion for Collateral Estoppel (Feb. 26, 2003). That rule seeks “to prevent the incidental or collateral determination of a nonessential issue from precluding reconsideration of that issue in later litigation.” *Mother’s Restaurant Inc.*, 723 F.2d at 1571. This means that a court need determine only that “the disposition in the first suit was the basis for the holding with respect to the issue and not ‘mere dictum’ . . . [or] merely incidental to the first judgment.” *McLaughlin*, 803 F.2d at 1204 (internal citations omitted). Put differently, although “[d]iscussion of the necessity prong of collateral estoppel analysis is usually framed in terms of determinations that were necessary to the ‘judgment’ or the ‘verdict,’” “[t]he primary purpose of the rule . . . is to ensure that the finder of fact in the first case took sufficient care in determining the issue.” *Pettaway v. Plummer*, 943 F.2d 1041, 1044 (9th Cir. 1991) (internal citations omitted), *cert. denied*, 506 U.S. 904 (1992), *overruled on other grounds Santamaria v. Horsley*, 133 F.3d 1242 (9th Cir.) (en banc), *modified*, 138 F.3d 1280 (9th Cir.), *cert. denied*, 525 U.S. 823 (1998); *see also Weems*, 49 F.3d at 534 (because party had fully litigated issue and had opportunity to challenge ruling on appeal, case warranted an “exception to general rule that preclusive effect should be given only to determinations that are . . . necessary to a previous judgment”) (Norris, J., concurring). Rambus had a full opportunity to litigate these issues, as explained below, and each of the courts considering the issues addressed them. In other words, this “is not a case where the court reached out to make determinations as to issues which were not before it.” *Mother’s Restaurant*, 723 F.2d at 1571.

Here, in ruling on Rambus’s appeal, the Federal Circuit held that a number of facts had been established as a matter of law for purposes of the *Infineon* case. It is thus appropriate to give them

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<sup>3</sup> “[I]ssue preclusion can avoid the costly litigation of issues already determined.”  
*Delaware River Port Auth. v. Fraternal Order of Police*, 290 F.3d 567, 572 n.7 (3d Cir. 2002).

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<sup>4</sup> Rambus advanced a position in its motion for summary decision that under JEDEC's rules, disclosure of patents was "was merely voluntary." Memorandum in Support of Respondent

which JEDEC's members understood and applied the organization's rules. Because JEDEC members "treated" the rules "as imposing a disclosure duty," the majority concluded that it "likewise" must interpret JEDEC's rules to "impos[e] a disclosure duty." *Id.* at 1098. Rambus has therefore been heard and lost on this contention as well: Members of JEDEC understood the disclosure duty to be mandatory. In the interests of fairness and expediency, Rambus should not be permitted to litigate that issue again here.

3. The JEDEC Disclosure Duty Extends to Patent Applications as Well as Issued Patents.

The question of whether the JEDEC rules required disclosure of pending patent applications has been conclusively resolved in the affirmative. Rambus should not be permitted to relitigate that issue here, having lost its argument at each stage of the *Infineon* litigation.<sup>6</sup> This argument stands in direct conflict with the consistent conclusions of the *Infineon* jury, trial court, and both appellate opinions. The *Infineon* trial court, in denying Rambus's post-trial motion for judgment as a matter of law ("JMOL"), concluded "on the basis of clear and convincing evidence, that . . . all [JEDEC] members, at all times here pertinent, had a known duty to disclose patent applications," as well as issued patents. 10eoxm. Sppo. 0.66T427 s4

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<sup>6</sup> Despite the rulings adverse to it, Rambus argued in support of its motion for summary decision that JEDEC's rules, while they may have required disclosure of relevant patents, "did not require disclosure of pending patent applications." Rambus SD Mem. at 21.

*Infineon* trial court. According to the majority, “At least by 1993, the EIA/JEDEC patent policy required members to disclose patents and patent applications ‘related to’ the standardization work of the committees.” *Id.* at 1085 (emphasis added); *see also id.* at 1097 (noting that JEDEC Manual JEP 21-I, published in October 1993, “included a policy revision expressly adding ‘patent applications’ to the policy language”). Rambus has lost this argument repeatedly. It should be barred by collateral estoppel from relitigating it once again here.

4. JEDEC’s Rules Require Disclosure of All Patents and Applications That “Relate to” JEDEC’s Work.

Rambus has already litigated and lost on the scope of the disclosure rule: patents and patent applications that “relate to” standards under consideration at JEDEC must be disclosed.<sup>7</sup> The *Infineon* trial court concluded that all JEDEC members, at all pertinent times, “had a known duty to disclose patent applications that related to the SDRAM standard-setting effort.” 164 F. Supp. 2d at 752 (emphasis added); *see also id.* at 748 (“JEDEC policy required members to disclose patents and patent applications that related to JEDEC’s standard- setting work.”) (emphasis added). Echoing the language of the Commission’s Complaint and the literal words of JEDEC’s JEP 21-I Manual (adopted in October 1993), Judge Prost, in her dissenting opinion, similarly concludes that JEDEC’s rules require members to “disclose patents and pending patent applications that might be involved in the standard setting process.” *Infineon*, 318 F.3d at 1110 (Prost, J., dissenting). The Federal Circuit majority – using language closely tracking the trial court’s ruling, but also consistent with the dissent – likewise concluded that, “[a]t least by 1993, the EIA/JEDEC patent policy required members to disclose

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<sup>7</sup> Rambus now seeks to argue that “there is nothing in either the written policies or the actual practices of JEDEC’s members to support” a requirement that “any patent or patent application that relates to a proposed JEDEC standard” must be disclosed. Rambus SD Mem. at 29.

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<sup>8</sup> Given the *Infineon* majority’s observation that Rambus and Infineon “consistently agree[d]” with this interpretation of what “the JEDEC policy language requires,” 318 F.3d at 1085, it

proceeded to conclude that Rambus’s acknowledged duty to disclose extended not only to patents, but to patent applications as well. *See id.* at 752 (concluding that “all members” of JEDEC, including Rambus, “had a known duty to disclose patent applications that related to the SDRAM standard-setting effort”). The Federal Circuit majority certainly agreed that Rambus was subject to the same disclosure duty that applied to all Rambus members, 318 F.3d at 1100 (referring to “Rambus’s duty to disclose”), as did the Federal Circuit dissent, *id.* at 1110 (Prost, J., dissenting) (same).

Thus, like the other arguments highlighted above, Rambus’s contention that the JEDEC disclosure rules somehow were not applicable to Rambus is contradicted by the unanimous conclusions of all of the judges (trial and appellate) that reviewed these issues in the context of the *Infineon* litigation. Again, Rambus should not be permitted to relitigate this question.

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Based on the forgoing, Rambus should be barred from relitigating the issues set out above on the basis of collateral estoppel.

Respectfully submitted,

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