



UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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INTELLECTUAL VENTURES II LLC,	:	ORDER DENYING
	:	DEFENDANTS' MOTION TO
Plaintiff,	:	STRIKE PLAINTIFFS'
	:	INFRINGEMENT
	:	CONTENTIONS AND
v.	:	GRANTING IN PART AND
	:	DENYING IN PART
JP MORGAN CHASE & CO., JPMORGAN	:	PLAINTIFFS' AND
CHASE BANK, NATIONAL ASSOCIATION,	:	DEFENDANTS' MOTIONS TO
CHASE BANK USA, NATIONAL	:	COMPEL
ASSOCIATION, CHASE PAYMENTECH	:	
SOLUTIONS LLC, and PAYMENTECH LLC,	:	
	:	
Defendants.	:	13-cv-3777 (AKH)
	:	
	:	
	:	
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ALVIN K. HELLERSTEIN, U.S.D.J.:

Plaintiff Intellectual Ventures II LLC (“IV”) asserts claims of patent infringement against J.P. Morgan Chase & Co. (“JPMC”) (together with IV, the “Parties”) arising from JPMC’s use of certain products and systems related to network security. On November 4, 2014, the Court heard argument on several pending motions and rule as follows:

1. I deny JPMC’s Motion to Strike Plaintiff’s Infringement Contentions.

Although IV’s initial infringement contentions were inadequate, *see Yama Capital LLC v. Canon Inc.*, No. 12 Civ. 7159, 2013 WL 6588589 (S.D.N.Y. Dec. 13, 2013), JPMC did not seek to strike those contentions at that time but, rather, made an initial production. On the record before me, it is unclear whether IV has improvidently expanded the scope of its case or simply added detail to its initial infringement contentions. Accordingly, I hold that discovery with respect to IV’s September 30, 2014 infringement contentions is appropriate at this time.

2. The Court heard argument on IV's Motion to Compel Defendants to Produce Documents. With respect to IV's requests for documents related to damages and royalties calculations, IV seeks a large volume of sensitive financial information without a clear indication that it is so entitled. Accordingly, I deny IV's motion at this time and hold that all damages-related discovery, including discovery of patent licenses, be deferred. The relevant document requests are stricken with leave to renew at a later date.

3. The Court heard argument on IV's Motion to Compel Defendants to Answer Interrogatories. With respect to Interrogatory No. 1 of Plaintiff's Revised 1st Set of Interrogatories, the objection is sustained and the interrogatory is stricken.

4. The Parties informed the Court that they had resolved the disagreements at issue in JPMC's 1st Omnibus Motion to Compel during a meet-and-confer held November 3, 2014. Accordingly, the motion is denied as moot.

5. The Court heard argument on JPMC's 2nd Omnibus Motion to Compel. With respect to Interrogatory No. 3 of Defendants Revised First Set of Interrogatories, the interrogatory and response, including the general objection, are stricken as overbroad and non-responsive, respectively. JPMC has 10 days to serve an amended interrogatory and IV has 10 additional days to respond. With respect to Interrogatory No. 24, IV's objection is overruled. IV has 10 days to amend its response.

6. The Court also heard argument on an additional dispute that arose after the Parties had filed the various motions. IV asked the Court to compel JPMC to produce documents responsive to Request Nos. 3 and 4 of IV's document requests relating to the "666" Patent, which were served on March 19, 2014. The requests are overbroad and JPMC's

objections are sustained. IV has 10 days to serve amended document requests. JPMC has 10 days to respond.

7. Finally, the Court heard argument on a dispute that has arisen with respect to IV's withholding of certain documents on the basis of the attorney-client privilege. The Court reviewed *in camera* two documents from IV's privilege logs (document identification nos. 287226 and 1062). After reviewing both I held that their purpose was the evaluation of a patent's validity related to the decision to acquire the patent. IV's business being the acquisition and litigation of patents, these communications serve a predominantly business, rather than legal, purpose and are, therefore, not protected by the attorney-client privilege. The Parties are instructed to work together to apply this ruling to the remaining disputed documents. IV is to produce an amended privilege log within 30 days.

The Clerk shall mark the following motions in 13-cv-3777 as terminated: Doc. No. 184, Doc. No. 190, Doc. No. 201, Doc. No. 204, and Doc. No. 231.

SO ORDERED.

Dated: New York, New York
November 5, 2014



ALVIN K. HELLERSTEIN
United States District Judge