

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

OASIS RESEARCH, LLC	§	
	§	
v.	§	CASE NO. 4:10-CV-435
	§	consolidated with
	§	
	§	CASE NO. 4:12-CV-526
	§	Judge Mazzant
EMC CORP., ET AL	§	

**MEMORANDUM OPINION AND ORDER**

Pending before the Court is Motion of Defendants EMC Corporation and Decho Corporation to Amend the Court’s Order Compelling Production of Documents to Certify It for Interlocutory Appeal (Dkt. #987). After reviewing the motion and the relevant pleadings, the Court finds that the motion should be denied.

**BACKGROUND**

The action before the Court consists of patent infringement claims and Racketeer Influenced and Corrupt Organizations Act (“RICO”) counterclaims. Plaintiff Oasis Research, LLC (“Oasis”) asserts counterclaims against Defendants, Carbonite, Inc. (“Carbonite”), Decho Corporation, and EMC Corporation (collectively with Decho, Corporation, “EMC”) arising under RICO, 18 U.S.C. § 1961 *et seq.* (Dkt. #462). Specifically, Oasis contends that Defendants violated 18 U.S.C. § 1962(c) and 18 U.S.C. § 1962(d) (Dkt. #462).

In December 2011, counsel for EMC called Chuk Campos (“Campos”), informed him of the litigation, and that Christopher Crawford (“Crawford”) had applied for patents relating to online backup (Dkt. #722, Ex. B, at 443:3-7; Ex. D, at 76:13-77:2). Subsequently, Campos called Don Atwood (“Atwood”) to discuss the calls and litigation (Dkt. #722, Ex. A, at 227:6-10, 229:11-23). Both indicated an unwillingness to participate initially, and did not claim at that

time that they were inventors. (Dkt. #722, Ex. E, PX 41) (Campos stating “if money were not an issue for me right now, the right thing would be to focus our efforts on getting the patent approvals taken away;”; Atwood stating “I agree with you, no patent should have issued, however, it was, so the game becomes who are we more valuable to in this charade.”).

Subsequently, Campos and Atwood were again contacted by Defendants to discuss their potential involvement in the litigation. Oasis argues that Defendants threatened, “badgered,” and coerced Campos and Atwood to get involved. Defendants state that they informed Campos and Atwood of the issues in the litigation, and notified them that they could be subpoenaed to testify in the litigation, regardless of whether they cooperated or not. Campos conveyed to Atwood that working with Defendants would be an “opportunity [for them] to make a few bucks.” (Dkt. #722, Ex. A, at 230:23-231:1).

Atwood, Campos, and Teri Todd (“Todd”) were subpoenaed to testify during June and July of 2012. A week before these depositions, counsel for Defendants hosted a joint conference call between Atwood, Campos, and counsel for Defendants in which they reviewed the documents and the testimony for the depositions. (Dkt. #722, Ex. D, at 328:19-330:22, 337:2-338:11, 346:2-11; Ex. A, at 250:12-252:16, Ex. B, 649:5-13, 649:19-651:24, 832:25-834:13). Oasis argues that this conference gave the witnesses a preview of each other’s testimony.

At Atwood’s deposition, Atwood stated that Defendants offered to pay Atwood, Campos, and Todd \$75,000 for their testimony approximately 45 days before their depositions (Dkt. #722, Ex. A, at 232:6-234:9). Oasis argues that Atwood repeatedly testified that this amount was in exchange “for testimony;” however, Defendants note that Atwood later clarified in his deposition that the payment was license for his rights under the patents-in-suit. These individuals declined Defendants’ “initial offer” because it was too low, “just didn’t seem appropriate,” and was not

reasonable “for what [Defendants] were expecting.” (Dkt. #722, Ex. A, at 233:2-9, 234:5-9; Ex. D, at 381:24-382:13, 383:23-384:6). In a written agreement, dated August 30, 2012, Defendants agreed to pay Campos, Atwood, and Todd \$200,000 upfront and an additional \$140,000 once the litigation was completed, plus expenses and legal fees (Dkt. #722, Ex. C, PX 517). At trial, the three witnesses indicated that they were required by their agreement to come to trial and testify that they were co-inventors.

Oasis alleges that “the Defense Group pursued a scheme of offering and providing improper inducements to fact witnesses Atwood, Campos, and Todd in exchange for fact testimony and production of ‘evidence’ that the Defense Group believed would help prove its allegations” (Dkt. #462). On January 29, 2013, Defendants filed their motion for summary judgment on RICO counterclaims (Dkt. #595). On April 15, 2013, Plaintiff filed its response (Dkt. #722). On April 25, 2013, Defendants filed their reply (Dkt. #723). On May 6, 2013, Plaintiff filed its sur-reply (Dkt. #731). On February 5, 2015, the Court denied Defendants’ motion for summary judgment finding “that there is a fact issue as to whether there is a pattern of activity sufficient to amount to or post a threat of continued criminal activity.” (Dkt. #749 at p. 7).

On May 22, 2015, Plaintiff wrote Defendants requesting the production of documents relating to Defendants’ co-inventorship claims, and the payments allegedly made or offered in connection with Plaintiff’s RICO allegations (Dkt. #823 at p. 3). Specifically, Oasis requested:

All documents related to any payment or offer of payment to, or for the benefit of, Charles Campos, Don Atwood, Teri Todd, and/or their counsel, including communications internal to EMC/Carbonite as well as communications between any members of the joint Defense Group.

All communications relating to Charles Campos, Don Atwood, Teri Todd, Donald Doss, Jack Byrd, Robert Lynch, and/or any of their attorney/agents, including

communications internal to EMC/Carbonite as well as communications between any members of the joint Defense Group.

All communications relating to the inventorship of the Patents-in-Suit, including any communications internal to EMC/Carbonite as well as communications between any members of the joint Defense Group.

All documents related to any potential causes of action against Oasis, [Christopher] Crawford, and/or Intellectual Venture including communications internal to Carbonite/EMC as well as communications between any members of the joint Defense Group.

Defendants joint defense agreement in this case and all documents related to any party joining or withdrawing from the joint defense group.

(Dkt. #823 at pp. 3-4). Defendants refused to produce the documents asserting attorney-client privilege, common interest privilege, and the work product doctrine. Plaintiff alleged that the documents should be produced under the crime-fraud exception of the attorney-client privilege.

On June 23, 2015, Plaintiff filed its Motion to Compel Defendants to Produce Documents Related to Alleged Co-Inventors Under the Crime-Fraud Exception to the Attorney-Client Privilege and to Compel Production of Defendants' Joint Defense Agreement (Dkt. #823). On June 30, 2015, Defendants filed their responses (Dkt. #838; Dkt. #840). On July 2, 2015, Plaintiff filed its reply (Dkt. #843). On July 6, 2015, Defendants filed their sur-replies (Dkt. #856; Dkt. #858). On July 13, 2015, EMC filed their Unopposed Motion to Allow for Supplemental Briefing on Plaintiff's Motion to Compel (Dkt. #870; Dkt. #871). The Court granted EMC's motion on July 14, 2015 (Dkt. #880). On July 17, 2015, Plaintiff filed its response to EMC's supplemental briefing (Dkt. #888). On July 22, 2015, the Court granted in part and denied in part Plaintiff's Motion to Compel Defendants to Produce Documents Related to Alleged Co-Inventors Under the Crime-Fraud Exception to the Attorney-Client Privilege and to Compel Production of Defendants' Joint Defense Agreement (Dkt. #898). The Court required Defendants to produce the Joint Defense Agreement to Plaintiff at that time, and required

Defendants to produce for *in camera* inspection documents related to the RICO allegations (*See* Dkt. #898). However, the Court found that the documents related to potential causes of action against Oasis, Crawford, and/or Intellectual Ventures were privileged, as those communications were not relevant to Plaintiff's RICO counterclaims (*See* Dkt. #898).

On July 24, 2015, the Court held a telephone conference with the parties to clarify its Order. On July 28, 2015, EMC filed notice with Court that it complied with the Court's Order, and produced the Joint Defense Agreement to Plaintiff (Dkt. #922). On August 11, 2015, EMC filed notice with the Court that it complied with the Court's Order, and produced the relevant documents for *in camera* review by the Court (Dkt. #936).

On August 28, 2015, after reviewing the *in camera* submissions, the Court ordered that EMC produce 357 documents to Plaintiff, as they met the criteria under the crime-fraud exception of the attorney-client privilege, by September 4, 2015 (Dkt. #968). On September 3, 2015, the Court received a letter from EMC's counsel informing the Court that they did not agree with the Court's ruling, and intended to seek appellate review of the Court's Order (Dkt. #989, Exhibit E).

On September 4, 2015, EMC filed the instant motion arguing that the Court's Order compelling the production of documents should be certified to the Federal Circuit for interlocutory appeal (Dkt. #987). Specifically, EMC asserts that the Court should submit the following questions to the Federal Circuit:

- (a) [W]hether the crime-fraud exception to the attorney-client privilege may be invoked on the basis of a patent Assignment Agreement, in light of the Federal Circuit's express recognition that such agreements are "very common" and do not demonstrate that a party has paid for witnesses' testimony (*See* Dkt. #840 at p. 9) (quoting *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1459 (Fed. Cir. 1998)); and
- (b) [W]hether the common-place investigatory steps undertaken here by EMC (including interviewing witnesses, asking them documents, and informing

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