

Judge Albright Orders Plaintiff to Produce Documents Related to Defendants' Marking Defense

SEPTEMBER 27, 2023

On September 19, 2023, Judge Albright issued a discovery dispute order ordering plaintiff Viasat Inc. (Viasat) to produce “documents and information sufficient to identify which of its products were sold or offered for sale in the United States that incorporate flash memory, and the dates that Viasat sold or offered for sale such products, and identify the flash memory product incorporated in each of such products.” This order resolved a discovery dispute submitted by email.

Viasat alleges that certain flash-memory products of defendants Western Digital Corporation and Western Digital Technologies, Inc. (WDT) infringe Viasat’s patents. Viasat purchases flash-memory products from WDT and third parties and incorporates those products into its own commercial products.

WDT contended that Viasat’s products incorporating flash memory should have been marked pursuant to 35 U.S.C. § 287(a). WDT requested that Viasat produce information sufficient to identify which of its products incorporate flash memory and to identify the incorporated flash memory.

WDT relied on *Carnegie Mellon University v. Marvell Technology Group, Ltd.*, 906 F. Supp. 2d 399 (W.D. Pa. 2012), to argue that marking was required under similar facts. In *Carnegie Mellon*, the facts were similar but with computer chip components incorporated.

Viasat argued that it was not required to produce information until WDT satisfied a preliminary burden under *Arctic Cat Inc. v. Bombardier Recreational Products Inc.*, 876 F.3d 1350, 1368 (Fed. Cir. 2017), to articulate products it believes are unmarked “patented articles” subject to § 287. Viasat contended that WDT’s request is based on an incorrect understanding of § 287 that accused products incorporated into a Viasat product become “patented articles.” Viasat also argued that WDT’s request would be “immensely burdensome” because (i) Viasat did not keep records of flash-memory products it purchased and incorporated into other products and (ii) Viasat would have to search through parts lists by component manufacturers to identify which ones contain flash controllers and then correlate those to specific Viasat programs and products.

Despite Viasat’s reliance on *Arctic Cat* and the claimed burden, Judge Albright granted WDT’s request for production, ordering that Viasat “produce documents and information sufficient to identify which of its products were sold or offered for sale in the United States that incorporate flash memory, and the dates that Viasat sold or

offered for sale such products, and identify the flash memory product incorporated in each of such products.” Judge Albright did not rule on the meaning of “patented article” under § 287.

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