

CAUSE NO. 199-596-97

DSC COMMUNICATIONS CORPORATION,

Plaintiff,

v.

EVAN BROWN,

Defendant.

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IN THE DISTRICT COURT OF

COLLIN COUNTY, TEXAS

219TH JUDICIAL DISTRICT

DEFENDANT EVAN BROWN'S RESPONSE TO DSC'S SECOND MOTION TO COMPEL INTERROGATORY RESPONSES AND FOR SANCTIONS

TO THE HONORABLE JUDGE OF SAID COURT:

Defendant Evan Brown ("Brown") files this Response to DSC's Second Motion to Compel Interrogatory Responses and for Sanctions and would respectfully show the Court as follows:

FACTUAL BACKGROUND.

On April 24, 1997, DSC sued Evan Brown, its former employee, in the 199th Judicial District Court of Collin County, Texas. DSC contends that it owns an idea in Evan Brown's mind (sometimes referred to as the "Solution") which, if it works, will allow the user of a software program to convert machine executable binary code into a high-level source code using logic and data abstractions. DSC obtained from this Court a mandatory injunction requiring Brown to "disclose the Solution, in its entirety, to DSC" and an order permitting DSC to patent the idea. Brown exercised his right to challenge this Court's injunction through a duly perfected mandamus proceeding. After the mandamus was denied, DSC sought to force Brown to disclose his idea through an interrogatory and a motion to compel a response to such interrogatory. Despite the fact

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that this Court had denied DSC's motion to compel a response to the interrogatory while the mandamus was pending and the fact that DSC never requested that the answer be supplemented after the mandamus was denied, this Court granted DSC's motion to compel on December 8, 1998, ordered that Brown's idea be fully and completely disclosed to DSC and sanctioned Brown \$1000.00.

In its instant Motion, DSC wrongly contends that Brown has not disclosed his idea to DSC as ordered by this Court in its December 8, 1998 Order (the "Order"). In reality, Brown fully complied with the Order when he disclosed his idea in a supplemental interrogatory filed under seal with this Court on January 25, 1999. A more complete disclosure by Brown would require that he create something that does not currently exist. It would also undermine his pending summary judgment motion by forcing Brown to convert what is currently an abstract idea into an invention reduced to tangible, written form. The sanctions requested by DSC are clearly improper. Monetary sanctions against Brown are improper because he cannot afford them and death penalty sanctions are improper because they would deny Brown a ruling on the merits despite the fact that he has alleged numerous legal and factual defenses to DSC's claims. DSC's Motion should be denied.

ARGUMENT AND AUTHORITIES

I. Brown has Complied with this Court's Order by Fully and Completely Disclosing his Idea in his Supplemental Interrogatory Answer.

Brown fully complied with this Court's Order when he disclosed his idea in a supplemental interrogatory filed under seal with this Court on January 25, 1999. The only "evidence" DSC offers to the contrary is contained in the affidavits of DSC employees James McCarty and Robert McMurray attached to DSC's Motion. As set forth more fully below, those affidavits are insufficient

to carry DSC's burden to demonstrate that Brown has failed to disclose his idea pursuant to the Court's Order. DSC's Motion should be denied.

A. McCarty and McMurray are not qualified to assess Brown's disclosure.

First and foremost, the affidavits fail to establish that either McCarty or McMurray have the technical background, expertise and competence to evaluate Brown's disclosure.¹ In reality, they do not. As set forth in the Affidavit of Evan Brown attached hereto as Exhibit A, the very questions posed by the DSC employees in their affidavits reveals their lack of expertise in the area of computer programming. For example, their lack of experience in developing software tools similar to Brown's idea is apparent in their failure to understand the techniques described on page 6 of Brown's disclosure. *See* Ex. A at par. 3. The techniques referenced by Brown are commonly used in computer software development and would be understandable to anyone with substantial experience in the field of software engineering. *Id.* Other questions which McMurray and McCarty have regarding terminology used by Brown in his disclosure reveal their inexperience and expose their lack of qualification to evaluate the completeness of Brown's disclosure. For example, their questions regarding the meaning of the terms "CPU/ALU instruction simulator," "dependent hardware," "logical expression sequence," "logic flow structure," and "data reference" demonstrate their inexperience and lack of qualifications. *Id.* at par. 4. Each of these terms has a specific meaning in computer science terminology. *Id.* McMurray and McCarty's lack of familiarity with these terms shows their inability to evaluate Brown's disclosure. *Id.*

¹The McMurray and McCarty affidavits are essentially identical, except for what appear to be typographical errors in the McCarty affidavit. For brevity's sake, this Response will refer solely to the McMurray Affidavit.

McMurray and McCarty's inability to accurately assess Brown's disclosure is also demonstrated by the numerous questions in their affidavits regarding the operation of an instructor simulator. *See* McMurray Affidavit at par.6, p. 4. Each of their questions has a simple answer which should be obvious to anyone having the necessary skill and experience to evaluate Brown's disclosure. *See* Exh. A at par. 4. In sum, McCarty and McMurray lack the experience and expertise necessary to evaluate Brown's disclosure. *Id.* The only "evidence" of Brown's alleged non-compliance with the Court's Order is contained in the McMurray and McCarty Affidavits. Because these DSC employees lack the experience and expertise necessary to evaluate Brown's disclosure, their affidavits fail to carry DSC's burden of demonstrating that Brown has not fully and completely disclosed his idea to DSC in his supplemental interrogatory answer.

B. Brown's idea is not sufficiently developed to allow him to provide DSC the detailed information it seeks through its Motion to Compel.

Through the affidavits of McMurray and McCarty, DSC concedes that Brown's supplemental interrogatory answer provides "a very basic overview of the component parts of a conversion process" and "presents a very high-level overview of a software program used to convert an object code into a source language." *See* McMurray Affidavit at pars. 4, 6. It contends, however, that Brown's disclosure is *too much* of an overview and fails to provide sufficient detail for DSC to "understand how the Solution works or whether it works." *See* McMurray Affidavit at par. 11. The major shortcoming of the affidavits, in addition to the affiants' lack of qualification, is that they fail to establish that the details which are allegedly lacking from Brown's disclosure actually exist at this time. In other words, the affidavits fail to establish that Brown's idea is as detailed and developed

as DSC assumes it is such that Brown is capable of answering the myriad of detailed questions posed by McMurray and McCarty in their affidavits.

In reality, Brown's idea is far from developed. He has stated under oath that "the idea needs a great deal of further development and refinement before there is any chance of it functioning. It must be meticulously documented and thoroughly tested before I can even determine if my theory will work in practice. At this point, I have nothing more than an abstract idea to a perplexing problem." See September 29, 1997 Affidavit of Evan Brown attached hereto as Exh. B at par. 5. Brown has further stated that "no one, including myself, could reduce my idea to a tangible form without undue extensive research or experimentation. Rather, I believe it would take at least eighteen months of documentation, research and experimentation before my idea could ever achieve a tangible form." *Id.* at par 6. He testified in his deposition in May 1997 that his solution was "not a product, it is still an idea." See Exhibit 6 to DSC's Motion. Because Brown's idea is not fully developed, has never been tested, and has not been reduced to a tangible form, he cannot be expected to provide minute details of the idea's operation at this time. Simply put, Brown cannot divulge information to DSC which he does not currently possess.

Many of DSC's criticisms of Brown's disclosure as set forth in the McMurray and McCarty Affidavits are based on DSC's fundamental misconception of the degree of development of Brown's idea. For example, DSC complains that "no new or unique information, techniques, or approaches are presented in [Brown's supplemental interrogatory] answer beyond those currently known and in use in the computer software industry." See McMurray Affidavit at par. 7. As Brown has repeatedly stated, however, his idea "does nothing that cannot already be accomplished manually. Rather, it is

simply a method to automate by computer a process which companies are already undertaking by hand.” See Exh. A at par. 5; Exh. B at par. 2. Because Brown’s idea simply automates an already existing manual code conversion process, it should not be surprising that his disclosure reveals no “new or unique information, techniques, or approaches.” See Exh. A at par. 5.

Other complaints of DSC focus on the lack of information in Brown’s disclosure regarding the meaning of words used in the disclosure such as “machine executable binary code” and “target dependent processor.” See McMurray Affidavit at pars. 8-2, 8-4. In addition, DSC complains that Brown does not provide enough specific details as to how his idea works. See McMurray Affidavit at pars. 4, 9. These complaints of DSC cannot be addressed by Brown for the simple reason that his idea is not sufficiently developed to allow him to answer such questions. Brown cannot provide specific implementation details of his idea because much of his idea depends on the development platform, the specific target language to be converted and the specifics of the high-level language to be created. See Exh. A at par. 6. For example, the operation of a “target dependent processor” depends on the high-level language being converted to since each language has specific syntax, grammar rules, features and limitations. *Id.* at par. 7. The operation of a “function/subroutine library” similarly depends on the specific CPU/ALU being converted, the dependent hardware being used, the operating system being used and the specific target high-level language. *Id.*

At no time has Brown ever represented that his idea is based upon the conversion of a specific machine executable binary code to a specific high-level source code using a specific type of hardware. Rather, his idea is and always has been a theoretical approach to converting an unspecified binary code to an unspecified source code using an unspecified type of hardware. *Id.* Without targeting

specific codes and specific hardware -- which he has not done -- Brown cannot answer many of the questions posed by DSC in the McMurray and McCarty Affidavits. *Id.*

Several analogies come to mind to explain the reasons for Brown's inability to provide DSC the specific details it seeks. For example, suppose that Brown had developed a general idea or theory for converting one spoken language to another. He could not be expected to describe in detail such a process unless one were to specify the languages involved; the process of converting German to Italian would be different from the process of converting Latin to Hungarian. Because Brown's idea does not specify the computer languages being converted from and to, he cannot possibly answer the detailed questions posed by DSC. Taking a different approach, DSC has analogized what it perceives as Brown's failure to fully disclose his idea by referring to a manufacturing process. *See McMurray Affidavit at par. 5.* Its hypothetical actually proves Brown's point. Suppose that Brown had an idea for a new way of manufacturing an automobile. Suppose further that he had not yet decided what raw materials to use (the computer language being converted), what type of equipment to use to assemble the automobile (the computer hardware used for the conversion) or even what the finished product would look like (the high level source code converted to). Without such details, Brown could not possibly provide an inquisitor with a detailed outline of a manufacturing process. And yet that is precisely what DSC seeks through its Motion.

C. The brevity of his response does not prove that Brown has violated this Court's Order as DSC suggests.

Besides the McMurray and McCarty Affidavits, DSC's only "evidence" that Brown has not fully disclosed his idea is based upon the fact that his disclosure is only eight pages long whereas he has previously testified that "it would take me a month to simply write down the idea, which would

take 400 single spaced pages to document.” *See* Exh. B at par. 5. DSC assumes that the brevity of Brown’s disclosure is due to his refusal to fully and completely disclose his idea. This is simply not true. Rather, the brevity is due to the fact that he has not fully developed the idea in sufficient detail to provide the answers to the many questions posed by DSC. *See* Exh. A at par. 8.

The brevity of his disclosure can also be explained by the fact that Brown has omitted in his disclosure the pages and pages of background information which would be necessary for the jury in this case to fully understand and appreciate his idea. *Id.* at par. 9. For example, his disclosure omits information relating to basic principles of computer design and computer programming, the characteristics of various CPU designs, the basics of boolean logic, principles of operating system design and fundamentals of high-level programming languages. *Id.* Brown assumed that the DSC disclosure team would possess this basic knowledge and that he need not spend hundreds of pages explaining such details as he would if he were speaking to the jury in this case. *Id.* In fact, DSC does not seem interested in such details, since it has actually objected to the abbreviated background information provided by Brown in his disclosure. *See* DSC’s Motion at pp. 3-4 (stating that the background information provided by Brown is “completely non-responsive” and “not relevant to a description of the Solution”).

D. Conclusion.

Only by further developing and refining his idea can Brown provide the level of detail DSC seeks in its Motion. The current situation is analogous to a situation involving a writer who developed an idea for a novel while working for a publishing house. After being fired, the publisher sued the writer claiming an ownership interest in the idea and obtained a court order requiring the

former employee to fully and completely disclose his idea. The employee then disclosed the characters of his novel, the beginning and the end of the book and the basic plot lines. Unsatisfied, the publisher sought to compel the employee to document all 400 pages of his novel despite the fact that he had not yet written it. That is what DSC seeks in the instant Motion -- to force Brown to write a novel despite the fact that all he has in his head is the basic premise for a story. For Brown to disclose his idea in sufficient detail to answer DSC's many questions, he would have to "write the novel" so to speak. He would have to take his idea as currently formulated and revise it, refine it and develop it further. Discovery cannot be used for such a purpose. *See, e.g., In re Colonial Pipeline Co.*, 968 S.W.2d 938, 941 (Tex. 1998).

While DSC claims it owns what is in Evan Brown's mind, it actually seeks much more through its Motion. It seeks to force Brown to spend weeks of his time and energy further developing and refining his idea so that DSC can answer every conceivable question it might have; even then, DSC would likely have more questions for Brown to answer. This Brown will not do. He has obeyed this Court's Order by fully and completely disclosing his idea as it currently exists. He may not be compelled to do more. DSC's Motion must be denied.

II. The Relief Sought by DSC's Motion is improper.

A. A party may not force its adversary to create a document or tangible thing which does not already exist.

By insisting that Brown provide it with more details than he currently possesses, DSC seeks to force Brown to convert the abstract idea or theory in his mind into a fully developed, fully functional invention. DSC seeks to compel Brown to answer questions which he has not yet answered in his own mind regarding the refinement and execution of his idea. In short, DSC seeks

to compel Brown to create something that does not yet exist and then disclose his new creation to DSC. Such relief is wholly inappropriate under the Texas Rules of Civil Procedure.

Several courts have held that a party cannot use the discovery rules as a tool to force their adversary to create something tangible which does not already exist. In the case of *In re Colonial Pipeline Co.*, 968 S.W.2d 938 (Tex. 1998), the trial court ordered the plaintiffs to produce an inventory of all discovery produced in related cases pending in other counties. The plaintiffs sought mandamus relief, claiming that the trial court abused its discretion by ordering the plaintiffs to create such a document. The Texas Supreme Court agreed, holding that the discovery rules “cannot be used to force a party to make lists or reduce information to tangible form.” *Id.* at 941. As the Court noted, a party cannot be forced to produce something that does not exist because “a document that does not exist is not within a party’s ‘possession, custody or control.’” *Id.* at 942; *see also McKinney v. National Union Fire Ins. Co.*, 772 S.W.2d 72, 74 fn 2 (Tex. 1989)(a request for production “cannot be used to force a party to make lists or reduce information to tangible form”); *Loftin v. Martin*, 776 S.W.2d 145 (Tex. 1989)(a request for production must seek “an actual document in existence because a party will not be compelled to create or construct it for his opponent”).

While the foregoing cases dealt with requests for production, the same principles apply with respect to interrogatories as well. Simply put, a party cannot be forced to create and then divulge something that does not already exist, whether the information sought is a tangible document or an intangible idea. Through its interrogatories, DSC seeks to compel Brown to provide it with something he does not currently possess: a complete, refined and fully functioning version of his idea. DSC seeks to compel Brown to convert what is an abstract, unrefined and incomplete idea or theory

which is solely in his head to a detailed, refined and tangible invention documented on paper in the form of an interrogatory response. What DSC seeks, Brown simply does not have; rather, he is being asked to create it for DSC. As the cases above hold, this is an improper use of the discovery process. DSC's Motion should be denied.

B. The relief sought by DSC would undermine the basis of Brown's Summary Judgment Motion by essentially converting his idea to an invention.

Brown's Motion for Summary Judgment filed on September 29, 1997 rests on the distinction between an invention and an idea. As stated in the Motion, the portions of the employee agreement between Brown and DSC which purportedly obligate Brown to make disclosures to DSC, and which purportedly award DSC the ownership rights upon which it bases its suit, apply only to "inventions made or conceived" by Brown while working for DSC. The idea in Brown's mind, however, is merely an idea and not an invention. Moreover, Brown has not "made" anything and has not "conceived", an "invention" as those terms have been defined in the relevant case law. For these reasons, as set out in his September 29, 1997 summary judgment motion, Brown is entitled to judgment on DSC's claims as a matter of law.²

As held by the cases cited in Brown's Motion, there is a critical distinction between an invention and an idea; "courts will not consider an idea to be an invention until it is made tangible." *Jamesbury Corp. v. Worcester Valve Co.*, 443 F.2d 205, 211 (1st Cir. 1971). As another court has stated, "the development of an invention requires its mental conception by the inventor, its

² Despite the fact that Brown fully disclosed his idea to DSC and that a full disclosure of Brown's idea is nevertheless unnecessary to allow DSC to respond to Brown's Motion, the Court has granted DSC's motion to continue the hearing on Brown's summary judgment motion. The summary judgment motion has now been on file since September 1997 without a ruling.

embodiment in a working model and the refinement of such so as to prove its fitness for the intended purpose or purposes and to substantially embody therein the claims sought to be patented.” *Rodgard v. Miner Enter.*, 914 F. Supp. 907, 917 (W.D.N.Y. 1995). “Conception” of an invention, another requirement in DSC’s employee agreement with Brown, has been defined as “the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.” *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996). Moreover, “conception is complete only when the idea is so clearly defined in the inventor’s mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.” *Burroughs Wellcome Company v. Barr Laboratories, Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994).

Evan Brown’s idea as it currently exists does not fit any of these definitions of an “invention” or “conception” of an invention; as such, his idea does not fit the parameters of his agreement with DSC. First and foremost, his idea has not been reduced to tangible form. *See* Exh. B at par. 5. In addition, he does not have a definite and permanent idea of a complete and operative invention. The idea needs a great deal of further development and refinement before there is any chance of it functioning. *Id.* It also must be meticulously documented and thoroughly tested before Brown can even determine if his theory will work in practice. *Id.* At this point, Brown has nothing more than an abstract idea to a perplexing problem. Moreover, Brown has not currently “conceived” an “invention” as those terms have been defined. As stated in his affidavit, it would take someone of extraordinary skill to reduce Brown’s idea to a working computer program. A person of “ordinary skill” would have virtually no chance of converting his raw idea into a workable program. *Id.* at par.

6. This conclusion is supported by the McMurray and McCarty affidavits submitted by DSC in support of its Motion wherein its two employees, who allegedly have the technical competence to evaluate Brown's disclosure, claim that they cannot convert Brown's idea to a workable program without extensive additional information Brown does not currently possess. Moreover, no one, not even Brown himself, could reduce his idea to a tangible form "without unduly extensive research or experimentation."

As it currently exists in his mind, Brown's idea or theory clearly does not fit within the parameters of his employee agreement with DSC. That agreement ostensibly gives DSC ownership interest in "inventions made or conceived" by Brown, a definition which clearly does not fit his abstract idea. DSC's Motion to Compel would effectively gut Brown's summary judgment motion by requiring him to further refine his idea and convert it to tangible form, essentially converting what is currently but an abstract idea or theory into a tangible invention. Having forced Brown to "make" or "conceive" an "invention," DSC will have then trapped Brown into creating something which it will then argue fits into the parameters of Brown's employee agreement with DSC. Such a use of the discovery process is unwarranted, unprecedented and unjust.

III. DSC's Motion for Sanctions should be denied.

A. Brown has obeyed the Court's Order.

First and foremost, any sanctions are inappropriate since Brown has complied with this Court's Order by fully and completely disclosing his idea to DSC. As the party seeking sanctions, DSC must first prove that Brown has engaged in sanctionable conduct. *GTE Communications Corp. v. Tanner*, 856 S.W.2d 725, 729 (Tex. 1993) ("A party seeking sanctions has the burden of

establishing his right to relief”). To do so, DSC must prove that the details it claims are missing from Brown’s disclosure as set forth in the McMurray and McCarty Affidavits are details which Brown currently possesses. As set forth above, a party cannot be compelled to produce that which it does not have or which does not exist. *GTE*, 856 S.W.2d at 729 (“when a motion for sanctions asserts that a respondent to a discovery request has failed to produce a document within its possession, custody or control, the movant has the burden to prove the assertion”).

In the instant case, Brown has denied under oath in the attached affidavit that he currently possesses the answers to the questions raised by McMurray and McCarty in their affidavits. In other words, Brown simply does not possess the detailed information DSC seeks to compel Brown to divulge. Rather, he has fully and completely disclosed the idea as it currently exists in his mind. DSC has not met and cannot meet its burden to demonstrate that Brown has engaged in sanctionable conduct by failing to fully and completely disclose his idea. The idea is known only to Brown, who swears under oath that he has fully and completely disclosed it in his supplemental interrogatory answer. DSC’s contention that Brown is holding back details is mere speculation and supposition. DSC has clearly failed to meet its burden of demonstrating sanctionable conduct by Brown. Its request for sanctions must therefore be denied.

B. Brown cannot afford to pay further monetary sanctions.

As stated above, any sanctions are inappropriate since Brown has complied with this Court’s Order by fully and completely disclosing his idea to DSC. In addition, monetary sanctions are improper because Brown is incapable of paying any further fines or sanctions rendered by this Court. *See* Exh. A at par. 10. Any such sanctions will likely force Brown to file for bankruptcy, severely

endangering his ability to continue the instant litigation. *Id.* at par, 12. Further, his financial difficulties have been caused directly by DSC, who fired Brown from a well-paying position after ten years of loyal service and then obtained an injunction essentially rendering him unemployable by companies who fear that DSC will lay claim to any product of Brown's intellect as they have done in this lawsuit.

As stated above, Brown is unable to pay any costs or fees assessed against him as sanctions for his alleged failure to disclose his idea to DSC. It would therefore be an abuse of discretion to impose such sanctions or to punish Brown in the future for failing to pay such sanctions if they are imposed. In short, given Brown's inability to pay monetary sanctions, such sanctions would restrict his access to the courts by significantly impairing his ability and willingness to continue this litigation. *Id.* Under such circumstances, any monetary sanctions imposed against Brown prior to the rendition of final judgment in this case would constitute a violation of the Texas Open Courts Doctrine and the Due Process Clause of the U.S. Constitution. *See, e.g., Braden v. Downey*, 811 S.W.2d 922, 929 (Tex. 1991); *Equitable General Ins. Co. of Texas v. Yates*, 684 S.W.2d 669, 671 (Tex. 1984).

C. DSC's delay in filing its Motion weighs against the imposition of sanctions.

In its instant Motion, DSC asks this Court to compel Brown to disclose his idea in response to an Interrogatory propounded by DSC. DSC's Motion also seeks to impose sanctions on Brown despite DSC's history of a lack of diligence in seeking the relief sought in its Motion. After DSC filed its first motion to compel, Brown pursued his right to appeal this Court's June 30, 1997 injunction. On January 6, 1998, the Court of Appeals denied the appeal. On February 11, 1998, the Court of Appeals denied Brown's Motion for Rehearing. From February 11, 1998 to the date DSC filed its

first Motion to Compel on or about November 13, 1998 -- a period of more than nine months -- DSC did nothing to obtain the discovery sought. After this Court ordered Brown to fully and completely disclose his idea in its December 8, 1998 Order, Brown did so in his supplemental interrogatory answer filed on January 22, 1999. DSC then waited another four and a half months, until May 7, 1999, to file its second Motion to Compel. Moreover, DSC filed its Motion only in response to Brown having set his summary judgment motion for hearing on May 19, 1999.

DSC attempts to excuse its lack of diligence in its Motion by claiming that Eric Pinker, one of the attorneys for DSC, was busy in trial during January, February and March of this year. DSC further claims that its delay is actually Brown's fault because Brown allegedly insisted that Pinker be the only attorney of record on the Disclosure Team authorized to view Brown's disclosure. *See* DSC's Motion at p. 2, fn 1. This is simply not true. By letter dated January 18, 1999, attached hereto as Exhibit C, counsel for DSC wrote to the undersigned and identified 6 persons who DSC wanted to be on the disclosure team. Four of these persons, including Eric Pinker, were licensed attorneys. Despite Brown's objections, these six persons were included on the disclosure team as persons to whom Brown's supplemental interrogatory response was to be disclosed. Simply put, any delay in seeking to compel a further response from Brown is the sole fault of DSC. Such delay mitigates against the imposition of sanctions against Brown.

D. Death penalty sanctions are inappropriate under the facts of this case.

In its Motion, DSC requests that the Court "enter an Order striking Defendant's Answer and awarding DSC a default judgment" based on Brown's allegedly incomplete response to DSC's interrogatory. *See* Motion at p. 2. Such an "[i]mposition of a death penalty sanction is of particular

concern because a court thereby renders judgment without regard to the merits of the case.” *Hamill v. Level*, 917 S.W.2d 15, 16 (Tex. 1996). Because of such concerns, “there are constitutional limitations upon the power of courts, even in aid of their own valid processes, to dismiss an action without affording a party the opportunity for a hearing on the merits of his cause.” *Transamerican Natural Gas Corp. v. Powell*, 811 S.W.2d 913, 918 (Tex. 1991); *Hamill*, 917 S.W.2d at 16. Specifically, such sanctions are not justified unless a direct relationship exists between the offensive conduct and the sanction imposed and the sanctions are not excessive given the facts of the discovery abuse at issue. *Transamerican*, 811 S.W.2d at 917; *see also Chrysler Corp. v. Blackmon*, 841 S.W.2d 844, 849 (Tex. 1992)(“a permissible sanction should, therefore, be no more severe than required to satisfy legitimate purposes”).

In the instant case, death penalty sanctions fail to pass either of the two tests articulated by the Texas Supreme Court. First, there is no direct relationship between Brown’s alleged discovery abuse and the sanctions sought by DSC. Brown’s alleged failure to fully and completely disclose his idea to DSC prior to a trial on the merits of DSC’s claim to ownership of that very idea does not justify striking his pleadings and awarding a default judgment to DSC. DSC has made no showing that it will prevail on its claims herein. Brown has raised numerous legal and factual defenses to DSC claims. DSC has likewise failed to demonstrate that the disclosure provided by Brown is inadequate to allow it to respond to Brown’s pending summary judgment motion or to litigate the claims raised herein. Under these facts, death penalty sanctions would bear no relationship to Brown’s alleged failure to fully respond to the interrogatory at issue. Rather, like the injunction DSC sought and obtained, such sanctions are simply another attempt by DSC to obtain legal victory without ever

having to face this Court's scrutiny of its legal claims and Brown's legal defenses or the jury's scrutiny of its factual assertions.

Death penalty sanctions are also inappropriate because they are more severe than necessary. There are a host of other, lesser sanctions which could be used to secure compliance with the Court's Order in the event the Court concludes that Brown has not already complied through his supplemental interrogatory answer. Rather than seek a lesser sanction, DSC seeks complete victory in this case through the imposition of death penalty sanctions. Because death penalty sanctions are more severe than necessary, they should not be assessed.

Death penalty sanctions are also inappropriate because Brown's allegedly sanctionable conduct does not demonstrate that his claims or defenses lack merit. "Discovery sanctions cannot be used to adjudicate the merits of a party's claims or defenses unless a party's hindrance of the discovery process justifies a presumption that its claims or defenses lack merit." *Transamerican*, 811 S.W.2d at 918 (overturning death penalty sanctions); *Hamill*, 917 S.W.2d at 16 (overturning death penalty sanctions where "the sanctioned conduct does not justify the presumption that Hamill's claims are meritless") ; *GTE Communications Systems Corp. v. Tanner*, 856 S.W.2d 725, 730 (Tex. 1993)(overturning death penalty sanctions where "no such presumption is warranted here"); *Chrysler Corp.*, 841 S.W.2d at 850 (overturning death penalty sanctions where the record contained "no evidence that would justify the presumption of lack of merit of Chrysler's defense").

In the case of *Zappe v. Zappe*, 871 S.W.2d 910 (Tex. App.-Corpus Christi 1994, no writ), the trial court granted death penalty sanctions against the respondent in a child support modification case after the wife failed to fully answer the husband's discovery requests. Noting that the court's

ruling effectively disposed of the wife's lawsuit, the court stated that such a sanction "is not warranted unless the party's hindrance of the discovery process justifies a presumption that its claims or defenses lack merit" *Id.* at 913. The court then noted that the sanctions, like those sought by DSC in the instant Motion, resulted from allegedly incomplete answers to written discovery. It concluded that "Rice's incomplete answers do not justify a conclusion that Rice's claims or defenses lack merit." *Id.* The court of appeals therefore reversed the trial court's sanction order and remanded the case for a trial on the merits.

Like the incomplete discovery answers in *Zappe*, the allegedly incomplete interrogatory answer by Brown does not justify the presumption that his claims or defenses lack merit. In fact, all evidence is to the contrary. Specifically, Brown filed a motion for summary judgment on or about July 3, 1997 contending that the employee agreement between Brown and DSC on which DSC bases all of its claims for relief is unenforceable due to a lack of consideration. He also filed a second motion for summary judgment on September 27, 1997 alleging that his idea does not fit within the legal definition of an "invention" which has been "made or conceived" and therefore does not fit within the parameters of his employee agreement with DSC. Brown has also denied that his idea was conceived while employed by DSC, denied that the idea is along the lines of DSC's business and otherwise refuted DSC's claim that the idea falls under the scope of its employee agreement with Brown. In summary, Brown has raised numerous legal and factual defenses to DSC's claims which would be disregarded if death penalty sanctions were imposed. Clearly, Brown's alleged failure to fully and completely disclose his idea to DSC raises no presumption that his claims or defenses lack

merit; the evidence indicates to the contrary. Under these facts, death penalty sanctions are inappropriate.

Finally, DSC may assert that death penalty sanctions are necessary to punish Brown for his alleged discovery violations or to deter Brown and others from future violations. Such goals, however noble, simply do not justify the imposition of death penalty sanctions denying a party its right to a trial on the merits. As the Texas Supreme Court has stated, "although punishment, deterrence, and securing compliance with our discovery rules continue to be valid reasons to impose sanctions, these considerations alone cannot justify a trial by sanction." *Chrysler Corp.*, 841 S.W.2d at 849; *see also Transamerican*, 811 S.W.2d at 918 ("Although punishment and deterrence are legitimate purposes for sanctions, they do not justify trial by sanctions"). DSC's request for death penalty sanctions should be denied.

CONCLUSION AND PRAYER

DSC's Motion should be denied for the simple reason that Evan Brown fully complied with this Court's December 8, 1998 Order when he disclosed his idea in a supplemental interrogatory filed under seal with this Court on January 25, 1999. Moreover, a more complete disclosure by Brown would require that he create something that does not currently exist. It would also undermine his pending summary judgment motion by forcing Brown to convert what is currently an abstract idea into an invention reduced to tangible, written form. In addition to the portion of its Motion seeking to compel Brown to further disclose his idea, the sanctions requested by DSC in its Motion are likewise improper. Monetary sanctions against Brown are improper because he cannot afford them and their imposition would restrict his access to the courts by significantly impairing his ability and

willingness to continue this litigation. Death penalty sanctions are improper because they would deny Brown a ruling on the merits despite the fact that he has alleged numerous legal and factual defenses to DSC's claims. For the foregoing reasons, set out more fully above, DSC's Motion should be denied.

WHEREFORE, PREMISES CONSIDERED, Defendant Evan Brown respectfully requests that after hearing, this Court deny DSC's Second Motion to Compel Interrogatory Responses and for Sanctions in its entirety and grant him such other and further relief to which he may be justly entitled.

Respectfully submitted,



RICHARD A. SAYLES

State Bar No. 17697500

ERIC D. PEARSON

State Bar No. 15690472

SAYLES & LIDJI, P.C.

A Professional Corporation

4400 Renaissance Tower

1201 Elm Street

Dallas, Texas 75270

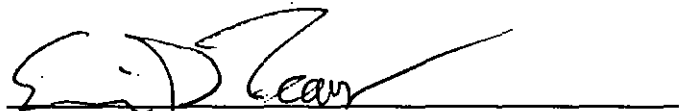
(214) 939-8700

(214) 939-8787 (fax)

Attorneys for Defendant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing instrument has been served upon all counsel of record on this 7th day of June, 1999, pursuant to Rule 21a of the Texas Rules of Civil Procedure.



**Defendant Evan Brown's Response to DSC's Second
Motion to Compel Interrogatory Responses and for Sanctions: Page 21**

CAUSE NO. 199-596-97

DSC COMMUNICATIONS CORPORATION,

Plaintiff,

v.

EVAN BROWN,

Defendant.

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IN THE DISTRICT COURT OF

COLLIN COUNTY, TEXAS

219TH JUDICIAL DISTRICT

AFFIDAVIT OF EVAN BROWN

STATE OF TEXAS §
 §
COUNTY OF DALLAS §

BEFORE ME, the undersigned authority, on this date personally appeared Evan Brown who, being by me first duly sworn, upon his oath deposed and stated as follows:

1. My name is Evan Brown. I am the Defendant in the above-styled and numbered case. I have personal knowledge of the facts recited in this affidavit, and they are all true and correct.

2. I am aware that DSC has filed its Second Motion to Compel and for Sanctions claiming that I have not obeyed this Court's December 8, 1998 Order. DSC is wrong. I fully complied with this Court's Order when I disclosed my idea in a supplemental interrogatory filed under seal with this Court on January 25, 1999.

3. The only "evidence" DSC offers to support its claim that I have not fully disclosed my idea is contained in the affidavits of DSC employees James McCarty and Robert McMurray attached to DSC's Motion. The affidavits fail to establish that either McCarty or McMurray have the technical background, expertise and competence to evaluate my disclosure. In reality, they do not. The very



questions posed by the DSC employees in their affidavits reveals their lack of expertise in the area of computer programming. For example, their lack of experience in developing software tools similar to my idea is apparent in their failure to understand the techniques described on page 6 of my disclosure. The techniques referenced on page 6 commonly used in computer software development and would be understandable to anyone with substantial experience in the field of software engineering.

4. Other questions which McMurray and McCarty have regarding terminology used in my disclosure reveal their inexperience and expose their lack of qualification to evaluate the completeness of my disclosure. For example, their questions regarding the meaning of the terms "CPU/ALU instruction simulator," "dependent hardware," "logical expression sequence," "logic flow structure," and "data reference" demonstrate their inexperience and lack of qualifications. Each of these terms has a specific meaning in computer science terminology. McMurray and McCarty's lack of familiarity with these terms shows their inability to evaluate my disclosure. McMurray and McCarty's inability to accurately assess my disclosure is also demonstrated by the numerous questions in their affidavits regarding the operation of an instructor simulator. *See* McMurray Affidavit at par.6, p. 4. Each of their questions has a simple answer which should be obvious to anyone having the necessary skill and experience to evaluate my disclosure. In sum, McCarty and McMurray lack the experience and expertise necessary to evaluate my disclosure.

5. Many of DSC's criticisms of my disclosure as set forth in the McMurray and McCarty Affidavits are based on DSC's fundamental misconception of the degree of development of my idea. For example, DSC complains that "no new or unique information, techniques, or approaches are

presented in [my supplemental interrogatory answer] beyond those currently known and in use in the computer software industry.” *See McMurray Affidavit at par. 7.* As I have repeatedly stated, however, my idea does nothing that cannot already be accomplished manually. Rather, it is simply a method to automate by computer a process which companies are already undertaking by hand. Because my idea simply automates an already existing manual code conversion process, it should not be surprising that his disclosure reveals no “new or unique information, techniques, or approaches.”

6. Other complaints of DSC focus on the lack of information in my disclosure regarding the meaning of words used in the disclosure such as “machine executable binary code” and “target dependent processor.” *See McMurray Affidavit at pars. 8-2, 8-4.* In addition, DSC complains that I have not provided enough specific details as to how my idea works. *See McMurray Affidavit at pars. 4, 9.* These complaints of DSC cannot be addressed for the simple reason that my idea is not sufficiently developed to allow me to answer such questions. I cannot provide specific implementation details of my idea because much of my idea depends on the development platform, the specific target language to be converted and the specifics of the high-level language to be created.

7. Moreover, the answers to many of DSC’s questions depend on the specific code being converted, the specific hardware used to complete the conversion process and the specific high-level source code being converted to. For example, the operation of a “target dependent processor” depends on the high-level language being converted to since each language has specific syntax, grammar rules, features and limitations. Similarly, the operation of a “function/subroutine library” depends on the specific CPU/ALU being converted, the dependent hardware being used, the operating system being used and the specific target high-level language. At no time have I ever

represented that my idea is based upon the conversion of a specific machine executable binary code to a specific high-level source code using a specific type of hardware. Rather, my idea is and always has been a theoretical approach to converting an unspecified binary code to an unspecified source code using an unspecified type of hardware. Without targeting specific codes and specific hardware -- which I have not done -- I cannot answer many of the questions posed by DSC in the McMurray and McCarty Affidavits.

8. Besides the McMurray and McCarty Affidavits, DSC's only "evidence" that I have not fully disclosed my idea is based upon the fact that my disclosure is only eight pages long whereas I previously stated in an affidavit that "it would take me a month to simply write down the idea, which would take 400 single spaced pages to document." DSC assumes that the brevity of my disclosure is due to my refusal to fully and completely disclose my idea. This is simply not true; I assumed that DSC's employees had the necessary technical background and did not need hundreds of pages of computer programming fundamentals. Much of the brevity of my disclosure is due to the fact I have not fully developed the idea in sufficient detail to provide the answers to the many questions posed by DSC. I cannot provide specific implementation details of my idea because much of my idea depends on the development platform, the specific target language to be converted and the specific of the high-level language to be created.

9. When I said earlier that it would take me a month and more than 400 pages to fully document the idea, I was referring both to the idea itself and to the theories, techniques and terminology of software engineering behind the idea necessary for a lay person to understand it. The brevity of my disclosure can in part be explained by the fact that I omitted in my disclosure the pages

and pages of background information which would be necessary for the jury in this case to fully understand and appreciate my idea. For example, my disclosure omits information relating to basic principles of computer design and computer programming, the characteristics of various CPU designs, the basics of boolean logic, principles of operating system design and fundamentals of high-level programming languages. I omitted this information in my disclosure because I assumed the members of the DSC Disclosure Team would have the necessary background and expertise to evaluate my idea without providing such basic background information.

10. I am aware that in its Motion, DSC seeks to have the Court sanction me \$5000 for violating this Court's Order. This relief is improper. First, I have obeyed the Court's Order by fully disclosing my idea to DSC in my supplemental interrogatory answer. Secondly, I cannot afford to pay any monetary sanctions assessed against me by the Court because my monthly expenses exceed my income and assets. I receive monthly income of approximately \$15.00 in the form of a dividend check from First Trust of Insured Municipal Bonds. I have no real property of any value outside of my homestead and a 1989 Ford F-150 truck which is of little if any real value and constitutes my only means of transportation.. I have approximately \$200.00 in my checking account, \$1700.00 in municipal bonds and \$2500 cash in hand, which was a gift from a family member.

11. My monthly living expenses are approximately \$250.00 for food, \$200.00 for gasoline, \$50.00 for my electric bill, \$35.00 for my gas bill and \$100.00 for my phone bill. I am unable to pay my health insurance and life insurance premiums. I am unable to pay nearly \$80,000.00 in outstanding credit card debt. Given the foregoing, I cannot qualify for a loan of any amount.

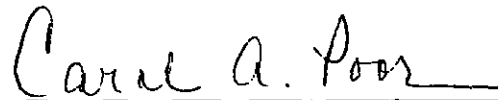
12. If sanctions are imposed against me, I will likely be unable to continue to defend this litigation. Because DSC fired me and obtained an injunction which has rendered me unemployable, I have had to sell my home in Plano and move to a family farm near Cranfills Gap, Texas, several hours from Dallas. The only means of communicating with my attorneys is by long distance telephone, by e-mail and in person if I make the drive to Dallas. Each of these forms of communication costs money which I will not have if I am forced to pay DSC monetary sanctions. Moreover, any monetary sanctions against me will likely force me to file for bankruptcy, severely endangering my ability to continue the instant litigation. Given my inability to pay monetary sanctions, such sanctions would restrict my access to the courts by significantly impairing my ability and willingness to continue this litigation.

FURTHER AFFIANT SAITH NOT.



EVAN BROWN

Sworn and subscribed before me on this 7th day of June, 1999, to certify which witness my hand and seal of office.



Notary Public in and for the State of Texas



CAUSE NO. 199-596-97

DSC COMMUNICATIONS
CORPORATION,

Plaintiff,

v.

EVAN BROWN,

Defendant.

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IN THE DISTRICT COURT OF

COLLIN COUNTY, TEXAS

219TH JUDICIAL DISTRICT

AFFIDAVIT OF EVAN BROWN

STATE OF TEXAS §
 §
COUNTY OF DALLAS §

BEFORE ME, the undersigned authority, on this date personally appeared Evan Brown who, being by me first duly sworn, upon his oath deposed and stated as follows:

1. My name is Evan Brown. I am the Defendant in the above-styled and numbered case. I have personal knowledge of the facts recited in this affidavit, and they are all true and correct.

2. In 1975, well before my employment with DSC, I began mentally developing an algorithm for a software program that could convert machine executable binary code into a high level source code using logic and data abstractions. My idea essentially amounts to a computer program which would reverse engineer a computer program from its machine language to a source code of any type. My idea does nothing that cannot already be accomplished manually. Rather, it is simply a method to automate by computer a process which companies are already undertaking by hand. Prior to going to work with DSC, I had a mental image of 80% of the ultimate idea.



3. On April 21, 1987, I began working for DSC. After one week of employment, DSC told me to sign an Employee Patent, Copyright and Proprietary Information Agreement (the "Agreement") or face immediate termination. I was not given any opportunity to negotiate over the terms of the Agreement. My understanding was that the Agreement was a form agreement that all DSC employees had to sign as-is or face termination. Not wanting to lose a job I had had for only six days, I did as I was instructed and signed the Agreement on April 27, 1987.

4. In March 1996, I mentally pictured the remaining 20% of my idea while I was in my car coming home from a long weekend. In April 1996, I sought a release from DSC to pursue my idea. After several months of no response from DSC, I inquired of several managers at DSC as to whether DSC would be interested in engaging me to develop the idea. DSC then began negotiating an agreement whereby DSC would pay me a percentage of savings realized by the company if the idea were successful and a percentage of income from third party sales, if any. In early 1997, DSC suddenly discontinued negotiations and ordered me to fully disclose my idea or be fired. When I refused to reveal my idea, DSC abruptly fired me and initiated this lawsuit.

5. The idea which I have developed is only in my mind. There is no computer program, computer model or any other tangible representation of his idea. Moreover, I have not written the idea down on paper. In fact, it would take me a month to simply write down the idea, which would take 400 single spaced pages to document. In addition, it would be at least 18 months before the idea could actually be put into practice. The idea needs a great deal of further development and refinement before there is any chance of it functioning. It must be meticulously documented and

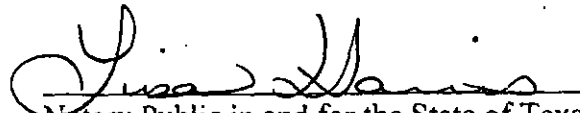
thoroughly tested before I can even determine if my theory will work in practice. At this point, I have nothing more than an abstract idea to a perplexing problem.

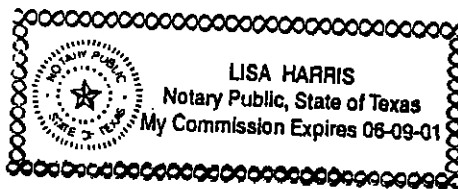
6. It would take someone of extraordinary skill to reduce my idea to a working computer program. A person of ordinary skill would have virtually no chance of converting my idea into a workable program. Moreover, no one, including myself, could reduce my idea to a tangible form without unduly extensive research or experimentation. Rather, I believe it would take at least eighteen months of documentation, research and experimentation before my idea could ever achieve a tangible form.

FURTHER AFFIANT SAITH NOT.


EVAN BROWN

Sworn and subscribed before me on this 29 day of September, 1997, to certify which witness my hand and seal of office.


Notary Public in and for the State of Texas



LYNN STODGHILL MELSHEIMER & TILLOTSON, L.L.P.
ATTORNEYS AND COUNSELORS

DIRECT DIAL NUMBER:

(214) 981-3837

epinker@lsmt.com

ERIC W. PINKER

750 NORTH ST. PAUL STREET

SUITE 1400

DALLAS, TEXAS 75201

(214) 981-3800

OF COUNSEL

ROBERT E. GOODFRIEND, P.C.

TELECOPIER: (214) 981-3839

January 18, 1999

Via Telecopy: (214) 939-8787

Eric D. Pearson, Esq.
Sayles & Lidji, P.C.
1201 Elm Street, Suite 4400
Dallas, Texas 75270

Re: Cause No. 199-00596-97
DSC Communications Corporation v. Evan Brown

Dear Eric:

Pursuant to the Court's Order regarding DSC's Motion to Compel Interrogatory Responses and for Sanctions. Alcatel USA, Inc. f/k/a DSC Communications Corporation would like the following persons to be members of the Development Team for the purpose of receiving a full and complete disclosure of the Solution, and subsequently evaluating and taking the necessary steps to preserve and protect the Solution:

1. Dan McMurray
2. Mike McCarty
3. Wayne Jones, Esq.
4. Eric Pinker, Esq.
5. Tim Loomis, Esq.
6. Steve Levine, Esq.

As members of the disclosure team, these persons would be permitted to review the Solution, subject to the Court's confidentiality requirements.

While Alcatel has identified the above-named persons in a good faith effort to include all persons who Alcatel believes will need to have access to the Solution, Alcatel reserves the right to seek leave to designate additional persons to be members of the Alcatel Development Team.

EXHIBIT

C

Eric D. Pearson, Esq.
January 18, 1999
Page 2

Please contact my office by Wednesday, January 27, 1999 if Mr. Brown has an objection to the persons listed above.

Very truly yours,



Eric W. Pinker, P.C.

EWP:vjr

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