

1 YITAI HU (SBN 248085)
 yitai.hu@alston.com
 2 SEAN P. DEBRUINE (SBN 168071)
 sean.debrune@alston.com
 3 ELIZABETH H. RADER (SBN 184963)
 elizabeth.rader@alston.com
 4 JANE HAN BU (SBN 240081)
 jane.bu@alston.com
 5 JENNIFER LIU (SBN 268990)
 celine.liu@alston.com
 6 PALANI P. RATHINASAMY (SBN 269852)
 palani.rathinasamy@alston.com
 7 **ALSTON & BIRD LLP**
 275 Middlefield Road, Suite 150
 8 Menlo Park, CA 94025-4008
 Telephone: 650-838-2000
 9 Facsimile: 650-838-2001

10 Attorneys for Plaintiff and Counterdefendant
 ELAN MICROELECTRONICS
 11 CORPORATION

12
 13 UNITED STATES DISTRICT COURT
 14 NORTHERN DISTRICT OF CALIFORNIA
 15 SAN FRANCISCO DIVISION
 16

17 ELAN MICROELECTRONICS
 18 CORPORATION,
 19 Plaintiff and Counterdefendant,
 20 v.
 21 APPLE, INC.,
 22 Defendant and Counterplaintiff.

Case No. 5:09-cv-01531 RS (PSG)

**PLAINTIFF ELAN
 MICROELECTRONICS
 CORPORATION'S NOTICE OF
 MOTION AND MOTION TO COMPEL
 APPLE, INC. TO PRODUCE TESTING
 TOOL**

Date: June 7, 2011
 Time: 2:00 p.m.
 Courtroom 5
 Hon. Paul S. Grewal

23
 24 AND RELATED COUNTERCLAIMS
 25

PUBLIC VERSION

1 **NOTICE OF MOTION AND MOTION**

2 TO APPLE, INC. AND ITS ATTORNEYS OF RECORD:

3 PLEASE TAKE NOTICE that on June 7, 2011, at 2:00 p.m., in Courtroom 5, located at
4 280 South First Street, Fifth Floor, San Jose, California, Plaintiff Elan Microelectronics
5 Corporation (“Elan”) will and hereby does move this Court, pursuant to L.R. 37-1(a) and Fed. R.
6 Civ. P. 37(a)(1) and 37(a)(4), to Compel defendant Apple, Inc. (“Apple”) to produce copies of the
7 [REDACTED] test tool application for use with each of the accused Apple products.

8 As its basis for this motion, as more fully set forth in the following Memorandum of Points
9 and Authorities, Elan states that Apple has developed an internal testing program it calls the
10 [REDACTED] which [REDACTED] and [REDACTED] the [REDACTED] by the [REDACTED] [REDACTED] in the
11 accused products. This program is called for by Elan’s document requests served in August 2009,
12 yet Apple has not produced that testing tool to Elan. Apple has flatly refused to produce a copy of
13 the program, and refuses to permit inspection by Elan’s expert witness without undue condition.
14 Apple has no justification for the limits it seeks to impose on the production of this highly relevant
15 discovery. Rather, Apple’s action (or more appropriately inaction) demonstrates that the Court
16 should order the immediate production of a copy or copies of the testing program to enable the
17 analysis of all of the accused products. At a minimum, the Court must order Apple to provide
18 unfettered access to the full range of programs, in both Apple counsel’s Boston and Redwood
19 Shores offices within 48 hours of a request to inspect, with Apple counsel’s supervision limited to
20 the minimum necessary to prevent Elan’s counsel or expert from absconding with a copy of the
21 program.

22 This motion is based upon this Notice of Motion and Memorandum of Points and
23 Authorities, the Declarations of Palani P. Rathinasamy (“Rathinasamy Decl.”) and Sean P.
24 DeBruine (“DeBruine Decl.”), in Support of the Motion to Compel, and on such other argument
25 and evidence as may be presented to the Court at or prior to the hearing on this motion.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

MEMORANDUM OF POINTS AND AUTHORITIES

I. STATEMENT OF MATERIAL FACTS

Elan filed its Complaint in this matter on April 7, 2009, alleging that Apple's products including multi-touch touchpads and touchscreens infringe, *inter alia*, U. S. Patent No. 5,825,352 (the 352 patent) (Dkt. No. 1). The accused Apple products include laptop computers with touchpad input devices, other devices with touchscreen input such as the iPhone and iPod Touch product, and other peripheral touchpads. Rathinasamy Decl., ¶ 2. On August 6, 2009, Elan served Apple its First Set of Request for Productions [Nos. 1-65]. Request for Production No. 20 and 21 requests that Apple produce:

REQUEST FOR PRODUCTION NO. 20:

All documents and things concerning the design, research, development, and/or testing of Apple's Products.

REQUEST FOR PRODUCTION NO. 21:

Documents concerning or relating to the structure, function, or operation of the Apple Product(s), including, but not limited to specifications, data sheets, drawings, diagrams, circuits, schematics, notebooks, project reports, workbooks, lab books, notes, code, memoranda, test plans, test results, CAD, simulation files, and marketing and sales materials.

(Rathinasamy Decl., Ex. A at 8). On September 8, 2009, Apple responded to Elan's request stating that it would produce "non-privileged documents sufficient to show the design, development, and/or testing of the relevant functionalities in the accused Apple products" (*id.*, Ex. B at 14-15). Despite this agreement to produce documents regarding the "testing of the relevant functionalities" Apple did not produce the [REDACTED].

However, during the Hearing in the parties' parallel case in the United States International Trade Commission ("ITC") in February 2011, one of Apple witness testified of the existence of the [REDACTED] tool¹ (Rathinasamy Decl., Ex. C [Westerman Tr.] at 380:11-16). Apple's witness explained that the testing tool used by Apple [REDACTED] and

¹ The discovery cut off in the ITC investigation was November 15, 2010, with a November 10 deadline for Motion to compel. Apple produced a user manual relating to the [REDACTED] on November 12, 2010 along with more than 250,000 pages of other documents (Rathinasamy Decl., ¶ 5).

1 [REDACTED] of the [REDACTED] with the ability for [REDACTED] (*id.*). Although Apple was
2 in possession of the testing tool, and although that tool was specifically requested by Elan but not
3 produced, Apple emphasized in its post-hearing brief to the ITC that Elan’s expert witness Mr.
4 Dezmelyk “*did not* base his opinion on any actual [REDACTED] to confirm infringement”
5 (Rathinasamy Decl., Ex. D [Apple’s Post-Hearing Brief] at 33) (emphasis added). In other words,
6 Apple argued that Elan did not prove its case because it did not have the very evidence Apple had
7 withheld from production (*id.* at 50).

8 After the Hearing at the ITC, on March 17, 2011 and again on March 26, 2011, Elan
9 specifically requested that Apple immediately produce a working copy of the [REDACTED]
10 [REDACTED] testing tool described by Apple’s 30(b)(6) witness as well as “any other software or
11 hardware tools that test, demonstrate or capture the function of the accused products”
12 (Rathinasamy Decl., Ex. E [03/17/2011 Letter from S. DeBruine to S. Mehta]; Ex. F [03/26/2011
13 S. DeBruine e-mail to S. Mehta]). Apple responded on April 4, 2011 stating that:

14 As you know, the [REDACTED] is a working tool and not simply something we can produce on
15 paper or on a hard drive, especially given its highly proprietary nature. Given your
16 request, however, Apple is willing to consider making the tool available for live testing by
Elan’s outside counsel or Mr. Dezmelyk, subject to the protective order...

17 (Rathinasamy Decl., Ex. G [04/04/2011 S. Mehta e-mail to S. DeBruine] at 1).

18 During an April 5, 2011 meet and confer call, Elan understood Apple to state that it
19 would only produce the [REDACTED] tool for inspection subject to the provisions for
20 Highly Confidential Attorneys Eyes Only – Source Code in the Amended Protective Order
21 (Rathinasamy Decl., ¶ 11). In an effort to expedite access to the [REDACTED] and avoid bringing
22 a discovery motion to the Court, Elan agreed that it would make a preliminary inspection of the
23 [REDACTED] and then further discuss an inspection procedure (Rathinasamy Decl., Ex. H
24 [4/12/2011 P. Rathinasamy e-mail to D. Walter]). On April 12, 2011 Elan proposed to Apple
25 that:
26

27 As such, for a starting point, we propose to have an initial inspection of the tool, at the
28 facility of Apple’s choice, subject to the source code provision of the protective order, for
our outside counsel and/or expert to simply get familiar with the operation of the tool.
After the initial inspection, the parties then can meet and confer to agree upon the contour

1 and details of the live testing and the related document production resulted from such tests.
2 Please let us know by Friday, April 15, whether you are agreeable to this proposal.

3 (*id.*).

4 On April 15, 2011 Apple responded that it would make the tool available for an initial
5 inspection but would restrict the inspection “to outside counsel only, and not expert witnesses”
6 (Rathinasamy Decl., Ex. I [4/15/2011 D. Walter e-mail to P. Rathinasamy]). Elan’s outside
7 counsel thereafter requested an inspection of the tool to get familiar with its operation,
8 (Rathinasamy Decl., Ex. J [5/2/2011 P. Rathinasamy to D. Walter]), and inspected the tool on May
9 11, 2011 (Rathinasamy Decl. at ¶ 15).

10 Contrary to counsel’s representation that the tool “could not be produced on a hard drive”
11 the ██████ test tool is an application program loaded on the hard drive of a MacBook laptop
12 computer (*id.*). It ran on that computer and ██████ the ██████ from the computer’s ██████
13 ██████ (*id.*). During the inspection on May 11, Apple only produced the version of the ██████
14 ██████ tool for the MacBook Pro product. It did not have the tool available for use with any of
15 the other Accused Products, such as the iPhone or iPad (Rathinasamy Decl., at ¶ 15; DeBruine
16 Decl., at ¶ 2). At the inspection, Elan’s counsel specifically asked Apple’s counsel about
17 inspecting the tool to analyze the other Accused Products, namely the iPhone, iPad and iPod touch
18 products running Apple’s “iOS” operating system. Apple’s counsel supervising the inspection
19 expressed surprise at the request and stated that counsel had not asked Apple for such a version of
20 the tool and had never seen such a version. He stated that Apple would get back to Elan on that
21 request (DeBruine Decl., at ¶ 3). A full week later, having heard nothing from Apple, Elan
22 repeated its request in writing. In addition, since the deposition of Elan’s expert had been
23 scheduled for May 24 in Apple’s counsel’s offices, Elan informed Apple that Mr. Dezmelyk
24 would join counsel for that initial, informal inspection (Rathinasamy Decl., Ex. K [05/18/2011 P.
25 Rathinasamy e-mail to D. Walter]). When Apple failed to respond to Elan’s request, on May 23,
26 2011 Elan was forced to repeat its request: “I write following-up on my emails regarding Apple’s
27 ██████ tool and production of videos. Regarding Apple’s ██████
28 tool, please confirm that the tool will be made available for our inspection on Wednesday, May 25

1 at 9:30 AM for the iPhone, iPad, and MacBook products” (Rathinasamy Decl., Ex. L [5/23/2011 P.
2 Rathinasamy e-mail to D. Walter]).

3 Despite being on notice as of May 11 that it had failed to provide the [REDACTED]
4 [REDACTED] for inspection with all Apple products, Apple responded that it could not produce the
5 tool in time for the May 25 inspection and, for the first time stated that it would not allow
6 Elan’s expert to inspect the tool absent videotaping “regardless of whether he is able to collect
7 printed data.” (Rathinasamy Decl., Ex. M [5/23/2011 D. Walter e-mail to P. Rathinasamy]).
8 Elan responded explaining that, since the [REDACTED] Tool is not source code it
9 should be immediately produced (Rathinasamy Decl., Ex. N [5/23/2011 P. Rathinasamy e-mail
10 to D. Walter]). Elan further explained that even if it were source code, the protective order
11 allows for visual monitoring only to prevent unauthorized electronic records from being created,
12 and that videotaping would capture conversations between counsel and the expert is
13 inconsistent with the parties’ agreement regarding communications with experts (*id.*).

14 On May 24, Apple simply abandoned its position that the [REDACTED] Tool is
15 “source code” subject to the heightened protections of the Amended Protective Order.
16 (Rathinasamy Decl., Ex. O [5/24/2011 D. Walter email to P. Rathinasamy]). Apple’s
17 continuing failure to even provide the tool on all version of Apple products to Elan’s counsel as
18 requested, the fact that those requests were still being ignored by Apple, its about-face on the
19 reasons for its obstruction and its unreasonable restrictions it was placing on any such
20 inspection, made it clear that the Court’s intervention was necessary. Because Elan’s expert
21 was scheduled to return to New Hampshire the following day, Elan sought the expedited
22 intervention of the Court.

23 On May 24 the parties held a telephonic discovery conference with Magistrate Judge
24 Grewal. During that telephone conference Apple’s counsel flatly, and as shown above falsely,
25 represented that Elan had never requested that the [REDACTED] testing tool be made
26 available for the iOS products (DeBruine Decl., ¶ 5). Moreover, counsel misleadingly
27 represented that it would not be able to make “the full range” of the [REDACTED] tool available
28 for inspection the next day even if ordered (*id.*). Only when counsel for Elan explained that the

1 testing tool was *already* available on the MacBook laptop did Apple’s counsel agree that it
2 could have made that version available for Elan’s expert to inspect (*id.*). Because all of these
3 facts were not available to the Court, it ordered that this motion be filed and considered on
4 shortened time (Dkt. No. 208).

5 Elan hereby states that it has satisfied its meet and confer obligation pursuant to L.R.
6 37-1(a) and Fed. R. Civ. P. 37(a)(1).

7 **II. ARGUMENT**

8 “[P]arties may obtain discovery regarding any non-privileged matter that is relevant to any
9 party’s claim or defense” or “appears reasonably calculated to lead to the discovery of admissible
10 evidence.” Fed. R. Civ. P. 26(b)(1). Therefore, it is well-established that the federal discovery
11 rules reflect a broad and liberal approach to achieving the goal of informing parties in civil cases
12 of all material facts prior to trial. *In re Google Litig.*, 2011 U.S. Dist. LEXIS 9924 (N.D. Cal. Jan.
13 27, 2011) (Mag. J. Grewal). “This standard applies with no less force in patent cases.” *Id.*
14 Further, “[f]or good cause, the court may order discovery of any matter relevant to the subject
15 matter involved in the action.” Fed. R. Civ. P. 26(b)(1). A motion to compel is appropriate when
16 a party provides an “incomplete disclosure, answer, or response” to a discovery request. Fed. R.
17 Civ. P. 37(a)(3)(A) & (a)(4). Here, there is no dispute that the [REDACTED] testing tool
18 is highly relevant to Elan’s claims, nor that Apple has refused to either produce a copy or make
19 reasonable arrangements for Elan to inspect and test that tool. As such, an order compelling
20 production is necessary.

21 **A. The Court Should Compel Apple to Immediately Produce Copies of the**
22 **[REDACTED] Test Tool to Elan**

23 The [REDACTED] Tool is a test tool used by Apple employees to [REDACTED] and
24 [REDACTED] from [REDACTED] in each of the Accused Products. Production of a
25 working copy of the tool was required by Elan’s document requests served on Apple on
26 September 8, 2009 and expressly requested by Elan in March 2011 (Rathinasamy Decl., Exs. A
27 [Elan’s First Set of Request For Production [Nos. 1-65] at RFP Nos. 20-21], E [03/17/2011 S.
28 DeBruine letter to S. Mehta], F [03/26/2011 S. DeBruine e-mail to S. Mehta], P [05/24/2011 S.

1 DeBruine e-mail to D. Walter]). Apple refused to produce the testing tool and instead argued that
2 the testing tool is “highly proprietary” and would be “willing to consider making the tool available
3 for live testing by Elan’s outside counsel or Mr. Dezmelyk, subject to the protective order”
4 (Rathinasamy Decl., Ex. G [4/4/2011 S. Mehta e-mail to S. DeBruine]). Under the Amended
5 Stipulated Protective Order, “source code” is entitled to additional protections. The entirety of
6 such code may only be inspected at counsel’s offices, while only portions may be printed and
7 produced, subject to producing counsel’s objections as to the amount of code printed (Dkt. No. 64
8 at 10). Documents and things other than “source code” are to be copied and produced, marked
9 with the “Confidential Outside Counsel’s Eyes Only” designation as appropriate (*id.* at 8-9).

10 Apple now admits that the [REDACTED] Tool is not “Source Code” and it is
11 therefore not subject to the extra protections provided by the Protective Order (Rathinasamy Decl.,
12 Ex. O [5/24/2011 D. Walter email to P. Rathinasamy]). As such, Apple has no basis whatsoever
13 for not immediately producing the copies of that tool sufficient to analyze all of the accused
14 products. There are neither technical nor confidentiality issues preventing such a production.
15 Contrary to counsel’s earlier representation, the testing tool can easily be “loaded on a hard drive”
16 (DeBruine Decl., ¶ 2). In fact, that is exactly how it is used at Apple (*id.*). Elan is more than
17 willing to either reimburse Apple at its cost for the computers on which the tool is loaded or to
18 provide such computers to Apple. Therefore, Apple has no basis to complain that it is too difficult
19 or burdensome to produce the tool to Elan. *In re Google Litig.*, 2011 U.S. Dist. LEXIS at *19-20
20 (finding the defendant has not offered “concrete, particularized evidence regarding the undue
21 burden of production” of all requested data and rejecting the “generic attorney argument”
22 regarding burden of production).

23 Apple similarly cannot complain that the Protective Order is insufficient to prevent
24 dissemination of the tool. Assuming it is designated as “Confidential – Outside Counsel’s Eyes
25 Only” access will be restricted to Elan’s litigation counsel and its expert approved by Apple to
26 receive such information. Elan’s counsel and expert will be obligated to protect the confidentiality
27 of that tool, to use it only for purposes of this litigation and to destroy or return it to Apple at the
28 conclusion of the litigation (Dkt. No. 64 at 8-10). These protections are more than sufficient to

1 protect the [REDACTED] Tool. *Displaylink Corp. v. Magic Control Tech. Corp.*, 2008
2 U.S. Dist. LEXIS 111401, *5 (N.D. Cal. July 23, 2008) (granting plaintiff's motion to compel
3 defendant's source code because "there is a stipulated protective order in place which addresses
4 [defendant's] confidentiality concerns"). *See, also Perez v. State Farm Mut. Auto. Ins. Co.*, 2011
5 U.S. Dist. LEXIS 41009 (N.D. Cal. Apr. 11, 2011) (Mag. J. Grewal) (rejecting defendant's basis
6 for withholding "sensitive financial information" in light of the stipulated protective order already
7 entered). Accordingly, in light of the protective order already entered in this case, the Court
8 should order Apple immediately produce a copy of the requested tool.

9 **B. As An Alternative, The Court Should Permit Elan's Expert and Counsel
10 to Inspect the Tool On Demand Without Videotaping**

11 Although the tool is not source code, in an attempt to resolve this issue Elan at first agreed
12 inspect the [REDACTED] at a facility of Apple's choosing and to thereafter meet and confer regarding
13 formal testing and the production of any data produced from that testing tool (Rathinasamy Decl.,
14 Ex. H [4/12/2011 P. Rathinasamy e-mail to D. Walter]). Now, after two months, Elan has not
15 even been able to secure that initial inspection for its expert or for all the Accused Products.
16 Moreover, Apple now makes the blanket demand that any inspection by Elan's expert be
17 videotaped by Apple's counsel. The unreasonable delay Apple has so far imposed, and its
18 unreasonable demand to videotape Elan's counsel and its expert, underscores that Apple should
19 simply be ordered to immediately provide Elan's counsel with a copy of the Tool as it is used for
20 each Accused Product. Should the Court nevertheless restrict Elan's access to the Tool to
21 inspection at Apple's counsel's office, any such inspection may not be videotaped. First, Elan's
22 counsel would be present with Elan's expert during at least the initial inspection and likely for
23 future evaluations. The parties have agreed that expert's work product and communications
24 between experts and counsel are not discoverable and any such videotaping would violate this
25 agreement. Second, even if the [REDACTED] tool is considered "source code" (the only reason under
26 the protective order to enforce limited inspections), the provisions of the Amended Stipulated
27 Protective Order that Apple itself drafted and insisted upon *bars* Apple from videotaping. That
28 Order states in relevant part that "[t]he Producing Party may visually monitor the activities of the

1 Receiving Party’s representatives during any Source Code review, *but only* to ensure that no
2 unauthorized electronic records of Source Code are being created or transmitted in any way” (Dkt.
3 No. 64 at 11-12) (emphasis added). Importantly, none of the Source Code inspections by either
4 side have involved any videotaping.

5 Certainly the intrusive nature of Apple’s request is extraordinary, but Apple has not and
6 cannot justify this request. Apple’s insistence on videotaping is not based on analogous case law
7 supporting Apple’s position. Rather, Apple makes this extraordinary request for the sole purpose
8 of making its cross-examination of Elan’s expert more convenient. As justification for its demand
9 Apple argues that “any testimony that [Elan’s expert] offers on these issues will no doubt be
10 informed by his testing” of the [REDACTED] tool (Rathinasamy Decl., Ex. O [5/24/2011 D. Walter e-
11 mail to P. Rathinasamy]). While that may be true, any such opinions, and the factual bases for
12 them, will be provided in Elan’s expert’s report. *See* Fed. R. Civ. P. 26(a)(2). To the extent there
13 is any confusion or suspicion on Apple’s part as to the soundness of those opinions it has all of the
14 ways available to test those opinions are available in every other patent litigation context. *See,*
15 *e.g., Melender-Diaz v. Mass.,* 129 S. Ct. 2527, 2536-38 (2009) (noting the utility of cross-
16 examination to weed out questionable scientific analysis). First, Apple can test any opinions
17 based on data obtained from the [REDACTED] through cross examination during a
18 deposition or at trial. Certainly Apple has capable counsel in this regard. For example its lead
19 counsel, Mr. Powers, and Mr. Bobrow have both recently been recognized as “Leading IP
20 Lawyers in California” (Rathinasamy Decl., Ex. Q [Press Release obtained from Weil.com]).
21 Presumably either one or both of these gentlemen can arrange to videotape any such deposition
22 and fully examine Elan’s expert on this topic. Furthermore, to the extent Elan’s expert were
23 somehow misusing or misrepresenting the [REDACTED] and its data, Apple has available to it as fact
24 witnesses the engineers who created and use the tool, as well as its own expert familiar with the
25 tool. Any or all of these individuals could provide evidence to counter any suspect opinion. In
26 short, Apple fails to explain why such a drastic restriction on Elan’s ability to prepare its case for
27 trial is justified in this, a common patent litigation situation.

1 **CONCLUSION**

2 For the reasons stated above, the Court should grant Elan's motion to compel Apple
3 immediately produce a copy of the [REDACTED] Tool. In the alternative, should the
4 Court nevertheless find the need to restrict Elan's access to the tool, the Court should grant Elan's
5 motion to compel Apple to provide unfettered access to the full range of programs, without video
6 taping, in both Apple counsel's Boston and Redwood Shores offices within 24 hours of a request
7 to inspect.
8
9

10
11 DATED: May 27, 2011 Respectfully submitted,
12 ALSTON & BIRD LLP

13
14 By: /s/ Sean P. DeBruine
15 Sean P. DeBruine
16 Attorneys for Plaintiff and Counterdefendant
17 ELAN MICROELECTRONICS CORPORATION
18
19
20
21
22
23
24
25
26
27
28

LEGAL02/32654220v5