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 Apple Inc.

11 UNITED STATES DISTRICT COURT
 12 NORTHERN DISTRICT OF CALIFORNIA
 13 SAN FRANCISCO DIVISION

14 ELAN MICROELECTRONICS
 CORPORATION,

15 Plaintiff and Counterclaim
 16 Defendant,

17 v.

18 APPLE INC.,

19 Defendant and Counterclaim
 20 Plaintiff.

Case No. C-09-01531 RS (PSG)

**APPLE'S OPPOSITION TO ELAN
 MICROELECTRONICS
 CORPORATION'S MOTION TO
 COMPEL APPLE TO PRODUCE
 TESTING TOOL**

DATE: June 7, 2011
 TIME: 2:00 p.m.
 JUDGE: Hon. Paul S. Grewal
 CTRM: 5

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 24 **FILED UNDER SEAL**
 25 **SUBJECT TO PROTECTIVE ORDER**
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1 **TABLE OF CONTENTS**

2 **Page**

3 I. INTRODUCTION 1

4 II. RELEVANT LEGAL PRINCIPLES 2

5 III. ELAN’S REASONS FOR DEMANDING A [REDACTED] INSPECTION
6 CONFIRM THAT IT IS ESSENTIAL TO VIDEOTAPE THE TESTING 3

7 A. The ’352 Patent Is A One-Dimensional Method With A Temporal
8 Restriction 3

9 B. The Apple Products Are Entirely Different From The Claimed Method 4

10 C. Elan’s Infringement Theory Depends On The Exact Placement, Pressure,
11 And Orientation Of Fingers Contacting The Touch Sensor, And The
12 Allegation That Certain Uses Are Common 6

13 IV. THERE IS NO VIABLE ALTERNATIVE TO VIDEOTAPING THE TESTS 10

14 V. THE PARTIES’ DISCOVERY AGREEMENTS DO NOT SUPPORT ELAN’S
15 POSITION, AND THERE ARE NO WORK PRODUCT CONCERNS 12

16 VI. APPLE COMPLIED FULLY WITH ITS DISCOVERY OBLIGATIONS AND
17 HAS COOPERATED WITH ELAN TO PROVIDE INSPECTIONS OF THE
18 [REDACTED] 15

19 VII. CONCLUSION 19

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TABLE OF AUTHORITIES

Page

RULES

Fed. R. Civ. P. 26..... 2, 3, 13

I.

INTRODUCTION

1
2
3 Elan’s motion seeks the “immediate production” of Apple’s proprietary [REDACTED]
4 [REDACTED] tool or, in the alternative, “unfettered access” to the tool by Elan’s testifying expert,
5 without any record of the expert’s testing or use of the tool. Motion at 1. Elan asserts that such
6 immediate production or unfettered access is necessary “to enable the analysis of all of the
7 accused products”—all of which have been adjudged as noninfringing on multiple independent
8 grounds in a parallel International Trade Commission (“ITC”) proceeding.¹ *Id.* Yet, Apple has
9 already allowed Elan’s counsel to inspect the [REDACTED] without hindrance, and has
10 even assisted in teaching counsel how to use the tool. Furthermore, Apple has agreed to allow
11 Elan’s expert to inspect the [REDACTED] to his heart’s content. In fact, the only actual
12 dispute between the parties is a narrow one: whether these expert witness tests should be
13 videotaped.

14 On this issue, Elan’s motion provides the Court with no information regarding how the
15 evidence Elan intends to collect using the [REDACTED] is relevant to Elan’s infringement
16 theory in this case. In fact, Elan’s infringement theory depends critically on the individual
17 placement, pressure, and orientation of fingers on the touch sensor. Likewise, it depends on the
18 allegation that certain types of contact are “common.” Thus, *how* Elan’s expert uses the
19 [REDACTED] tool in testing the accused products—and whether those uses are
20 “common”—will provide facts or data that will later form the basis of his inevitable opinion that
21 Apple infringes. Under the Federal Rules of Civil Procedure, Apple is entitled to a full record of
22 how Mr. Dezmelyk uses the [REDACTED] tool because that use will be *considered and*
23 *relied upon* directly by Mr. Dezmelyk in forming his opinions. Apple is aware of no way to
24 make an accurate record of this other than through videotape, and Elan’s motion includes no
25 viable alternative suggestion.

26
27 ¹ While Elan’s motion identifies the [REDACTED] tool as relevant to all accused
28 products, it is only relevant to Apple’s current products, which were also at issue in the parallel
ITC Investigation, and not to legacy products that are accused in this lawsuit but were not at issue
in the ITC.

1 At the same time, Elan’s motion lacks any legitimate claim that creating such a record
2 would prejudice it in any way. Instead, Elan’s motion focuses on the red herrings that the
3 [REDACTED] is not classified as “source code,” the assertion that an incomplete record
4 should suffice for cross-examination purposes because Apple’s attorneys have won some awards,
5 and the false assertion that aspects of the inspection are protected by the work product doctrine.
6 For good measure, Elan throws in a copious amount of false innuendo regarding Apple’s alleged
7 late-production of the [REDACTED] in the parallel ITC Investigation. Even setting aside
8 their lack of merit, none of Elan’s arguments has any bearing on the key issue here: the need for
9 a complete record of the facts or data relied upon by Elan’s expert in forming his opinions.
10 Because Apple is entitled to create such a record—especially so that it can fairly and fully cross-
11 examine Mr. Dezmelyk—Elan’s motion should be denied.

12 II.

13 RELEVANT LEGAL PRINCIPLES

14 As a general matter, any facts or data that an expert relies upon in forming his opinion are
15 discoverable. Indeed, FRCP 26(a)(2)(B) explains that an expert’s report “must contain” “the facts
16 or data considered” by the expert in forming his opinions. Fed. R. Civ. P. 26(a)(2)(B)(ii). The
17 Advisory Committee Notes provide critical guidance as to the scope of these rules. The Notes
18 explain that “the intention is that ‘facts or data’ be interpreted broadly to require disclosure of any
19 material considered by the expert, from whatever source, that contains factual ingredients. The
20 disclosure obligation extends to any facts or data ‘considered’ by the expert in forming the
21 opinions to be expressed, not only those relied upon by the expert.” Fed. R. Civ. P. 26 (advisory
22 committee’s notes for 2010 amendment).

23 Consistent with that basic principle, the Rules specifically contemplate that parties cannot
24 shield information considered or relied upon by an expert from discovery under the guise of
25 communications with counsel. While the most recently amended version of the Federal Rules
26 include an exception to “protect communications between the party’s attorney and any witnesses
27 required to provide a report under Rule 26(a)(2)(B) . . . ,” they also confirm that any such
28 communications are not protected from discovery to the extent they “identify facts or data that the

1 party’s attorney provided and that the expert considered in forming the opinions to be expressed .
2 . . .” Fed. R. Civ. P. 26(a)(4)(C). Importantly, the Notes explain that “Rules 26(b)(4)(B) and (C)
3 do not impede discovery about the opinions to be offered by the expert or the development,
4 foundation, or basis of those opinions.” Fed. R. Civ. P. 26 (advisory committee’s notes for 2010
5 amendment). Indeed, the Notes specifically contemplate that “*the expert’s testing of material*
6 *involved in litigation, and notes of any such testing, would not be exempted from discovery by*
7 *this rule.*” *Id.*²

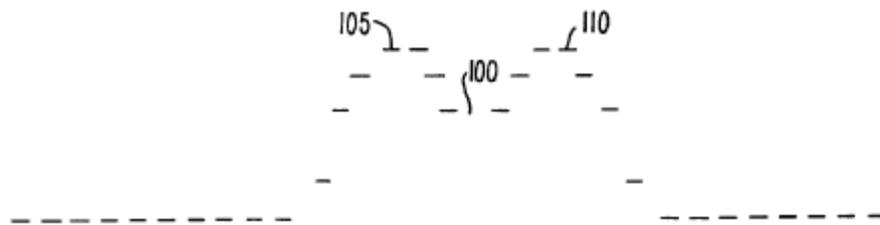
8 **III.**

9 **ELAN’S REASONS FOR DEMANDING A [REDACTED] INSPECTION CONFIRM**
10 **THAT IT IS ESSENTIAL TO VIDEOTAPE THE TESTING**

11 Elan’s motion includes no background regarding the technology or issues in this case, and
12 no corresponding explanation for why it wants an inspection of the [REDACTED] tool to
13 conduct tests of the accused products, let alone a non-videtaped inspection. Elan’s motion
14 assumes that it is obvious that such discovery is relevant. However, a basic understanding of the
15 asserted patent, accused products, and Elan’s infringement theory is required to understand why
16 Elan believes this discovery is relevant, and precisely why it is essential to videotape any expert
17 testing of the tool.

18 **A. The ’352 Patent Is A One-Dimensional Method With A Temporal Restriction**

19 Elan’s ’352 patent pertains to a very specific method for detecting the simultaneous
20 presence of two fingers on the surface of a touchpad or touchscreen. The method entails using a
21 one-dimensional profile of data obtained from scanning a touch sensor in a specific way to
22 determine whether two fingers are present. Such a profile is shown below:



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28 ² Emphasis added throughout, unless otherwise noted.

1 Exh. 1 [’352 patent] at Fig. 4.³ In the ’352 patent, the individual elements of this profile are
2 sequentially stepped through one-by-one to identify the first maxima (105), then a minima (100),
3 and then finally the second maxima (110), in precisely that order. Each peak (105 and 110) is
4 presumed to correspond to a finger contact.

5 This method is reflected in the Court’s claim construction rulings in this case. First, as
6 confirmation of the one-dimensional nature of the method, the Court has, in view of an agreement
7 by the parties, construed the claims to require identification of the extrema in a “finger profile
8 taken on a line.” *See* Dkt. No. 183 at 7-10. Second, as confirmation that the claims require
9 identification of the extrema in precisely the order described above (*i.e.*, first a maxima, then a
10 minima, and then another maxima), the Court has also construed the claims to include a temporal
11 requirement. *Id.* at 7-10 (construing the claims to call for a temporal order, explaining that “the
12 claim language plainly implies, or even explicitly calls for, a particular order”). Notably, Chief
13 ALJ Luckern in the ITC independently construed the claims in a consistent manner. *See* Exh. 2
14 [ITC Claim Construction Order] at 9-18. In short, both this Court and Chief ALJ Luckern found
15 that the method of the ’352 patent is limited very specifically to a temporal analysis of one-
16 dimensional data.

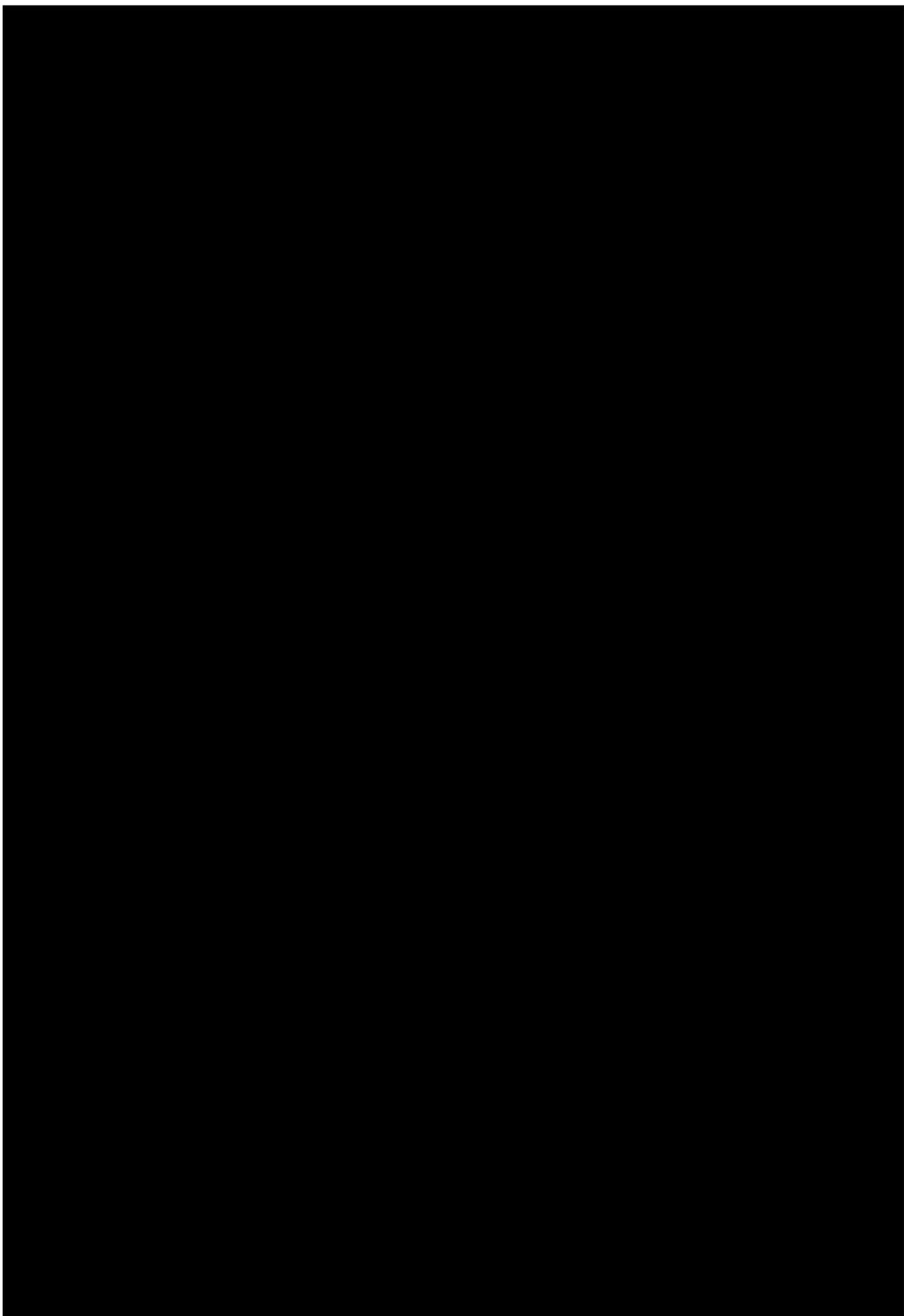
17 **B. The Apple Products Are Entirely Different From The Claimed Method**

18 In contrast to the one-dimensional technique described and claimed in the ’352 patent,
19 Apple’s Multi-Touch™ products use a modern, sophisticated set of algorithms that analyze
20 touches to a touchpad or touchscreen in two dimensions. Stripped down to its most basic
21 elements, the algorithms employed in the Apple products [REDACTED]

22 [REDACTED]
23 [REDACTED]
24 [REDACTED]
25 [REDACTED]

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27 ³ All exhibits citations are to the Declaration Of Derek C. Walter In Apple’s Opposition To
28 Elan Microelectronics Corporation’s Motion To Compel Apple To Produce Testing Tool,
submitted concurrently herewith.

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1 [REDACTED]
2 [REDACTED]
3 Importantly, these algorithms are fully two-dimensional, and do not use a “finger profile
4 taken on a line” for anything. Such a concept is entirely foreign to the products at issue in this
5 motion. Moreover, the Apple products, [REDACTED]
6 [REDACTED] let alone in the precise order required by the claims. In short, the Apple
7 products operate in a completely different manner than the ’352 patent, as reflected in the claim
8 constructions from two independent tribunals. In the ITC, the Chief ALJ rejected Elan’s
9 infringement arguments on multiple independent grounds. *See, e.g.*, Exh. 3 [ITC Final Initial
10 Determination] at 14 [REDACTED]

11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED]
15 [REDACTED] *id.* at 15-17 [REDACTED]
16 [REDACTED]
17 [REDACTED]
18 [REDACTED]
19 [REDACTED]

20 **C. Elan’s Infringement Theory Depends On The Exact Placement, Pressure,
21 And Orientation Of Fingers Contacting The Touch Sensor, And The
22 Allegation That Certain Uses Are Common**

23 Notwithstanding the Chief ALJ’s resounding rejection of Elan’s post-claim construction
24 infringement theory, Elan apparently intends to pursue its theory again here and ostensibly seeks
25 unrecorded testing of the accused products using the [REDACTED] tool to support that
26 theory. At the outset, Elan concedes that, under its theory, the vast majority of uses of the
27 accused Apple products are not even alleged to infringe the ’352 patent. Instead, Elan alleges that
28 the accused Apple products infringe only “sporadically or occasionally,” namely, when three very
specific hypothetical uses of the products are made that supposedly produce data sets that meet

1 certain very specific conditions. *See, e.g.*, Exh. 4 [Elan ITC Petition for Review] at 2 (arguing
2 that “[t]he law is clear that Apple’s products will infringe a method claim even where it [sic]
3 embodies the claim sporadically or occasionally.”). Specifically, Elan alleges that the products
4 will infringe when used in such a way so as to produce [REDACTED]

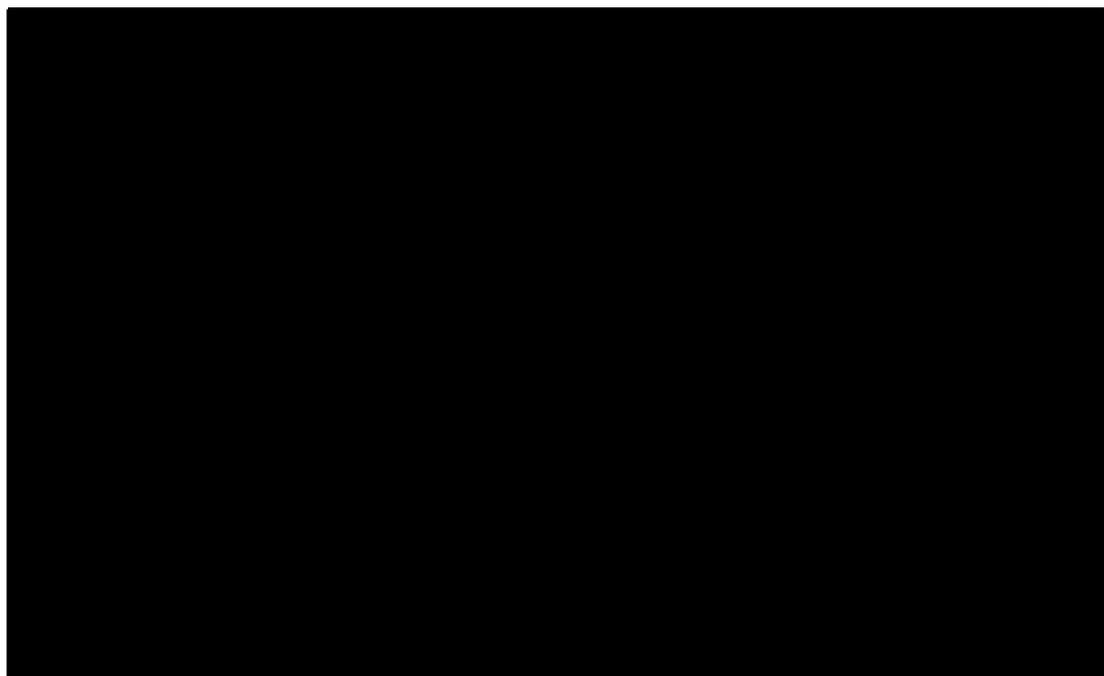
5 [REDACTED]

6 [REDACTED]

7 [REDACTED]

8 [REDACTED] *See* Exh. 5

9 [Apple’s 3/4/2011 ITC Posthearing Br.] at 48. Elan illustrated the first of these hypothetical
10 scenarios with the following graphic in its ITC Posthearing Reply Brief:



22 Exh. 6 [3/18/2011 Elan Posthearing Reply Br.] at 13. [REDACTED]

23 [REDACTED]

24 [REDACTED]

25 [REDACTED] *Id.*

26 Elan’s post-claim construction infringement theory is admittedly so narrow that, at the
27 ITC hearing, Elan’s expert testified that changes to even one pixel value in the hypothetical data
28 sets he presented would eliminate even the allegation of infringement. *See, e.g.*, Exh. 7

1 [Dezmelyk, ITC Hearing Tr.] at 653:2-654:25 (“Q. [REDACTED]
2 [REDACTED]
3 [REDACTED]; *id.* at 667:10-16 (“Q. [REDACTED]
4 [REDACTED]
5 [REDACTED]; *see also*
6 *id.* at 657:5-658:2 [REDACTED]
7 [REDACTED]); *id.* at 668:8-12
8 (same).

9 Of course, whether the particular narrow data conditions posited by Elan are produced in
10 the actual operation of the accused products depends directly on *how the touchpad or touchscreen*
11 *is used*, a point Elan plainly acknowledges. For instance, Elan’s expert testified in the ITC
12 hearing as follows:

13 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED]

17 *Id.* at 653:25-654:7. Elan further contended that certain hypothetical uses that lead to Elan’s
18 narrow allegedly-infringing scenarios represent allegedly “common” modes of use. For instance,
19 Elan’s expert opined at the ITC hearing that certain “common” “curl[ed]” finger orientations that
20 are used to achieve “better control” might generate Elan’s three infringement scenarios. *See, e.g.*,
21 Exh. 8 [3/4/2011 Elan ITC Posthearing Br.] at 63 (“Based on his extensive experience with touch
22 input devices, Mr. Dezmelyk testified that it is common for users to curl their fingers and use the
23 tips of their fingers on the touch sensor surface for better control when executing two finger
24 gestures.”) (citation omitted). Elan’s ITC Posthearing Reply Brief makes clear the extent to
25 which Elan’s infringement theory relies upon both particular data patterns and the allegation that
26 such data patterns will occur during allegedly “common” usage of Apple’s products:

27 [REDACTED]
28 [REDACTED]

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Exh. 6 [3/18/2011 Elan ITC Posthearing Reply Br.] at 13-14.

As a result, as a threshold matter and completely apart from the merits of its theory, it is undisputed that Elan’s infringement *allegation* hinges on *how the Apple products are used*.⁴ Thus, Elan must show that, taking into account factors such as the angle, orientation and pressure of contacts to the touch sensor, the three specific scenarios it has come up with can exist in operation of the accused products and, if so, how “common” or uncommon they are. It is thus clear that Elan’s intention in demanding an inspection of the [REDACTED] tool is to test the accused products to somehow support Mr. Dezmelyk’s opinion that certain uses at a “steep angle” with the right “orientation and pressure” will lead to the specific conditions upon which Elan’s theory rests. The form and manner in which Elan’s expert *uses* the accused Apple products during his testing will necessarily form the basis for any opinion he ultimately presents.

⁴ Of course, this is only a threshold inquiry. Even if Elan were correct that Apple’s products are used in one or more of the three highly-contrived scenarios it accuses of infringement, Elan would have to prove that the two-dimensional method employed by Apple’s products practices the one-dimensional method of the patent. In the ITC Investigation, the Chief ALJ rejected this infringement theory as legally deficient for method claim 1 because it relies on an apples-to-oranges comparison between the happenstance *results* of Apple’s algorithm for particular data conditions and the *method* of the ’352 patent:

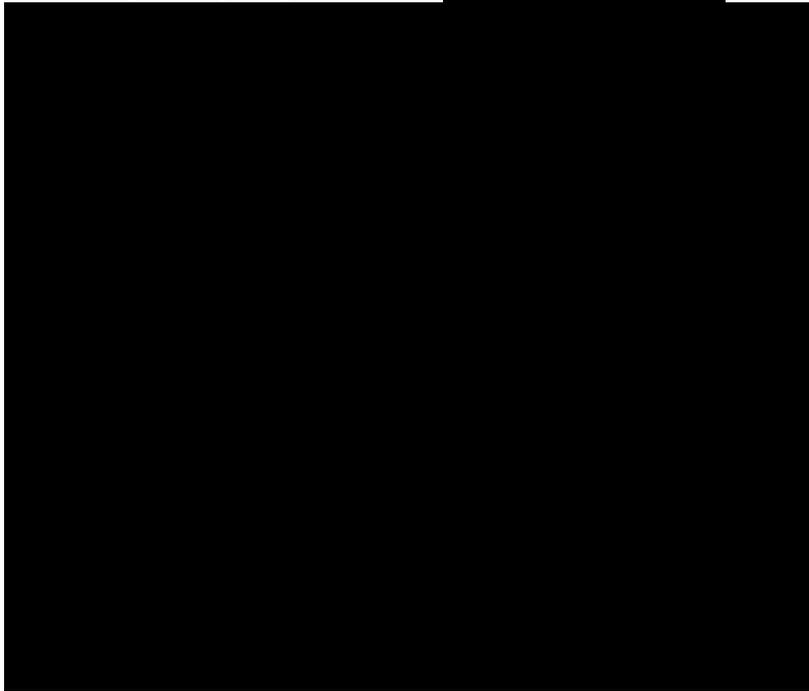
Complainant [Elan] has argued that, for certain finger positions on a touchpad, respondent’s [Apple’s] algorithm will result in an infringing set of data; *i.e.*, [REDACTED] (CBr at 44.) However, the administrative law judge notes that it is a *method* claim that is asserted, and therefore, it is a *method* that is at issue, not the results of that method. (*See, inter alia, Joy Techs. Inc. v. Flakt, Inc.*, 6 F.3d 770, 775 (Fed. Cir. 1993); *Surfware, Inc. v. Celeritive Techs., Inc.*, 2009 WL 605803 at *5; *GTX Corp. v. Kofax Image Prods Inc* 571 F Supp 2d 742 748 (E D Tex 2008)) Thus [REDACTED] [REDACTED] said algorithm does not infringe, even if certain hypothetical resulting datasets appear to track a straight line.

Exh. 3 [ITC Final Initial Determination] at 14 (emphasis in original) (footnote omitted). Consistent with that, the Chief ALJ determined that Apple’s products do not infringe the ’352 patent on multiple grounds, each of which is completely independent of any specific use scenario (hypothetical or otherwise).

1 IV.

2 **THERE IS NO VIABLE ALTERNATIVE TO VIDEOTAPING THE TESTS**

3 As explained above, Elan has acknowledged unequivocally that not all uses of Apple
4 products infringe and that its infringement theory relies upon *how* the Apple products are used. It
5 now wishes to have its expert runs tests with the [REDACTED] tool so that he may later
6 testify that, when he used Apple products in a certain way, it led to infringement. To illustrate
7 the types of tests Mr. Dezmelyk will carry out, the images below show an exemplary two finger
8 touch on the touchpad with corresponding output from the [REDACTED].



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20 Exh. 9 [REDACTED] at APEL397521. In the figure, [REDACTED]
21 [REDACTED]. Mr. Dezmelyk, however, will conduct his test with
22 bare fingers, experimenting with various angles and orientations of finger contact and with
23 different finger pressures to try and achieve the three allegedly infringing uses described above.

24 Rather than allow Apple to videotape such tests so that it will have adequate discovery of
25 the basis for Mr. Dezmelyk’s inevitable infringement opinions, Elan seeks to have its testifying
26 expert (in concert with its counsel) conduct unrecorded testing behind closed doors. Elan does
27 not explain how this request can be squared with basic rules governing expert disclosures.
28 Instead, Elan complains that “Apple makes this extraordinary request for the sole purpose of

1 making its cross-examination more convenient.” Motion at 9. This has nothing do with
2 “convenience.”⁵ Rather, it is a necessary part of an inspection so that Apple may conduct a
3 meaningful cross-examination of Mr. Dezmelyk on *how* he used the products during his testing,
4 including what “steep angle” or “orientation and pressure” he used and how common or
5 uncommon that use will be in operation of the products. Notwithstanding Elan’s compliments to
6 Apple’s counsel, even the most skilled cross examiner needs discovery of the underlying facts
7 with which to cross examine the witness. That is precisely why the Federal Rules require full and
8 fair disclosure of expert opinions and the bases therefor. Here, Apple is aware of no meaningful
9 way it can test Mr. Dezmelyk on how he used the product during his testing without some video
10 record of those uses, and Elan presents no viable alternative in its motion.

11 Elan notes that the basis for Mr. Dezmelyk’s opinions will be in his expert report. Motion
12 at 9. However, his report, which is not due to be served for three months, will include no
13 objective record of how he used the Apple products during his testing to arrive at his infringement
14 opinions. Rather, it will include, at best, his untested (and, without a record of the inspection,
15 untestable) recollection or recount of the tests he conducted months earlier during the inspection,
16 and, at worst, his self-serving conclusions without any explanation of the uses he tested to arrive
17 at those conclusions. In either case, Apple will have no way of confirming that he did not use the
18 products in some contrived or unusual way to generate the allegedly-infringing data scenarios.
19 Elan also alleges that Apple can “test any opinions based on data obtained from the [REDACTED]
20 [REDACTED] through cross examination during a deposition or at trial.” Motion at 9. Yet, even if a
21 voluminous record of every data set Mr. Dezmelyk generates through every touch of the touchpad
22 is created (the output of Mr. Dezmelyk’s tests), there will still be no information regarding *how*
23 Mr. Dezmelyk touched the touchpad to generate that data (the input that generated that output).
24 With only half the story, Apple will still be entirely unable to test whether Mr. Dezmelyk was
25 forced to use the touchpad in non-standard or contrived ways to generate the alleged
26 infringement.

27
28 ⁵ Indeed, it is rather inconvenient to arrange for and manage the videotaping of Mr. Dezmelyk’s inspection.

1 Likewise, to the extent Elan is contending that Mr. Dezmelyk can be cross-examined
2 during his deposition or at trial based on live use of the [REDACTED] tool, such a cross-
3 examination will shed no light on the extent to which Mr. Dezmelyk needed to experiment and/or
4 train himself to use the Apple products in such a way so as to consistently generate an allegedly
5 infringing scenario. Such considerations are directly relevant here because any use that relies
6 upon experimentation or training or trial-and-error to generate the allegedly-infringing conditions
7 does not reflect a normal use of the accused products and thus may not support a finding that the
8 alleged uses actually happen outside of closed-door testing by Elan’s litigation team. At a
9 minimum, the extent to which Mr. Dezmelyk had to test extraordinary uses of the products to
10 generate allegedly-infringing conditions is pertinent to the question of damages, such that Apple
11 must be given a full record of his testing.

12 Finally, Elan contends that Apple can rely on its own fact witnesses and engineers, or
13 even its own expert, to challenge whether Mr. Dezmelyk is “misusing or misrepresenting the
14 [REDACTED] and its data.” *Id.* at 9. However, testimony from other witnesses is no substitute for
15 core evidence that goes directly to the credibility or weight of Mr. Dezmelyk’s testimony.
16 Furthermore, Elan fails to explain how such individuals can challenge whether Mr. Dezmelyk is
17 “misusing” the tool without a record of how he actually used the tool in the first place. As Elan’s
18 testifying expert on infringement, whether Mr. Dezmelyk is “misrepresenting” the data from the
19 tool is, of course, an important issue. But, with respect to the specific question of whether the
20 [REDACTED] inspections should be videotaped, this is a non-issue, because the driving
21 concern here is to create an accurate record of *how* Mr. Dezmelyk uses the Apple products during
22 his inspection, something that the raw data sheds little light upon.

23 **V.**

24 **THE PARTIES’ DISCOVERY AGREEMENTS DO NOT SUPPORT ELAN’S POSITION,**
25 **AND THERE ARE NO WORK PRODUCT CONCERNS**

26 In its motion, Elan states that its attorneys intend to be present with their testifying expert
27 when he conducts tests using the [REDACTED] tool, and that videotaping any testing
28 would therefore violate the parties’ agreement that expert work product and communications

1 between attorneys and experts are not discoverable. Motion at 8. Elan makes a similar argument
2 with regard to the parties' agreement on the manner of conducting source code inspections. *Id.* at
3 8-9. Neither of these arguments supports Elan's position.

4 At the outset, the proposed videotaping is *not* of work product or communications
5 between Elan's counsel and its testifying expert, but of the tests conducted by its expert using the
6 [REDACTED] tool—facts that will form the basis of his opinions. Despite that, to address
7 Elan's apparent concern that videotaping Mr. Dezmelyk's testing would compromise Elan's
8 counsel's ability to protect as work product conversations between counsel and the expert, Apple
9 even offered to provide a breakout room so that Elan's team could conduct private conversations
10 with Mr. Dezmelyk during breaks in the testing. *See* Rathinasamy Decl, Exh. O [5/24/2011 D.
11 Walter email to P. Rathinasamy]. That Elan rejected this offer and instead believes that its
12 lawyers need to be behind closed doors with its expert while he is conducting the tests he will
13 later rely upon in support of his opinions (or, as Apple expects, the many failed tests that will
14 show how contrived Elan's allegedly-infringing scenarios are) highlights precisely why Apple
15 would be prejudiced by unrecorded testing by Elan's testifying expert and litigation team.
16 Indeed, the risk that such unreliable opinions will prejudice the opposing party or compromise the
17 process is precisely why protections afforded to communications between experts and counsel
18 "do not impede discovery about the opinions to be offered by the expert or the development,
19 foundation, or basis of those opinions," and why "*the expert's testing of material involved in*
20 *litigation, and notes of any such testing, would not be exempted from discovery by this rule.*"
21 Fed. R. Civ. P. 26 (advisory committee's notes for 2010 amendment).

22 Contrary to Elan's suggestion, the parties' agreement on the discovery of expert work
23 product is fully in line with this. The full text of the agreement, which Elan does not include in
24 its motion, is as follows:

25 The parties further agree that draft expert reports, including notes, and
26 communications between expert witnesses and counsel for the purpose of
27 preparing expert reports are not discoverable *except insofar as relied upon or*
28 *considered by the expert witness in rendering his or her opinion.*

1 Dkt. No. 41 at 5. Importantly, the final sentence of this agreement confirms the baseline rule that
2 anything the expert relies upon in forming his opinions will, in fact, be discoverable. *See supra*
3 Part II. An objective record of how Mr. Dezmelyk uses the Apple products during his testing—as
4 reflected in a video recording—is neither a draft expert report nor a communication between him
5 and Elan’s counsel for the purpose of preparing an expert report. Rather, as set forth above, Mr.
6 Dezmelyk’s testing constitutes the underlying facts and data that Mr. Dezmelyk will ultimately
7 rely upon in forming his infringement opinion in this case. Thus, if anything, the parties’
8 discovery agreement on expert work product *confirms* that Mr. Dezmelyk’s [REDACTED]
9 [REDACTED] inspection should be recorded.

10 Elan further argues that the parties’ agreement on source code inspections allows only for
11 visual monitoring to confirm that no unauthorized copies of source code are made, and therefore
12 that no videotaping should be allowed of the [REDACTED] tool inspections. Elan’s
13 argument is misplaced. To be sure, the [REDACTED] tool is a proprietary tool that
14 reveals details about the highly confidential inner-workings of the Apple products, and is thus
15 entitled to the utmost security and protection. Declaration of Wayne Westerman In Support of
16 Apple’s Opposition to Elan’s Motion To Compel ¶¶ 4, 10 . For that reason and given the nature
17 of the tool, Apple proposed that the tool could not just be turned over to Elan like a document or
18 end-user device could be, and instead proposed an appropriate initial inspection procedure
19 pursuant to the protective order. Rathinasamy Decl., Exh. G [4/4/2011 S. Mehta email to S.
20 Debruine]. Elan agreed. *See* Rathinasamy Decl., Exh. H [4/12/2011 P. Rathinasamy email to D.
21 Walter]. Elan now seeks to leverage that agreement into some sort of license for secret testing by
22 Elan’s testifying expert. However, while the [REDACTED] tool is more akin to source
23 code than normal documents or product samples for purposes of confidentiality, the tool is of
24 course of a different ilk than source code. Source code is static. The content of source code does
25 not depend on what sections one reads or how it is accessed. Both parties have access to this
26 source code, and it will be the same every single time either party reviews it. Thus, videotaping a
27 source code inspection would, in the first instance, make little sense, and, in any event, offer no
28 insight into the bases for expert opinion that the static source code itself does not provide. The

1 same is not true of the [REDACTED], which will have decidedly different output
2 depending on how the underlying Apple product is used, including where the fingers are placed,
3 how they are positioned, etc. As such, Elan's argument that the parties' discovery agreement on
4 source code inspections should govern the live testing it now proposes to conduct with the
5 [REDACTED] fails.

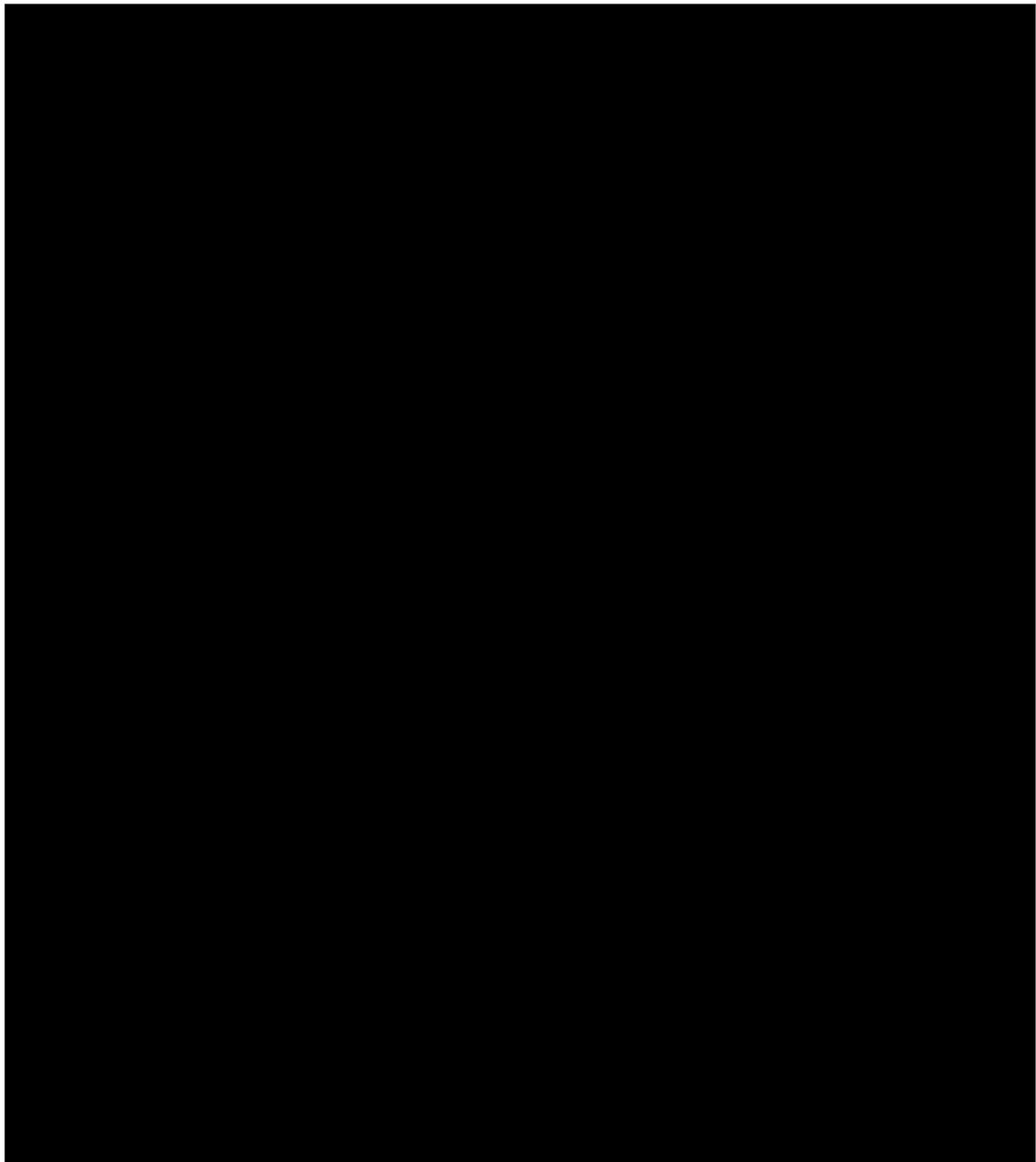
6 **VI.**

7 **APPLE COMPLIED FULLY WITH ITS DISCOVERY OBLIGATIONS AND HAS**
8 **COOPERATED WITH ELAN TO PROVIDE INSPECTIONS OF THE [REDACTED]**

9 Elan's motion is laced with innuendo and allegations that Apple has repeatedly evaded
10 Elan's specific requests for the [REDACTED] tool and otherwise failed to comply with its
11 discovery obligations. To put it mildly, Elan's motion paints an incomplete and inaccurate
12 picture of discovery in both the ITC action and this case.

13 From the earliest stages of the ITC case, Apple's document production has included
14 documents related to the [REDACTED] tool. For instance, on April 30, 2010, Apple
15 produced the following document related to [REDACTED]
16 which explicitly refers to the [REDACTED] tool, describes how it should be used, and
17 includes the following figure illustrating its use and output:

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Exh. 9 [REDACTED] at APEL397521; *see also* Exh. 10 [REDACTED] at APEL0399166 (Apple spreadsheet produced on April 30, 2010 showing results from testing with the [REDACTED] tool): Walter Decl. ¶¶ 9-10. Additionally, on June 23, 2010, months before the fact discovery cutoff in the ITC Investigation and more than a year before the cutoff in this case, Apple produced additional documents that further referred to and/or described the [REDACTED] tool. *See, e.g.*, Exh. 11 [Multitouch Algorithm Debugging] at APEL1164016; Exh. 12 [REDACTED] [REDACTED] at APEL1164012; Exh. 13 [REDACTED] at APEL1164014 [REDACTED]

1 [REDACTED]: Walter Decl. ¶¶ 11-13. Thereafter, in
2 November 2010, Elan deposed the lead engineer on the touchpad functionality at issue in the
3 instant motion. It failed to ask any questions about these documents, let alone any general
4 questions regarding the [REDACTED] tool or whether Apple had any other similar tools.
5 Given the foregoing, any suggestion by Elan that Apple was somehow tardy in producing
6 discovery related to the [REDACTED] simply cannot be credited.⁶ If, in fact, Elan failed
7 to learn of the [REDACTED] until late in the ITC proceedings, as Elan now appears to
8 allege, this was only the result of Elan's own failure to diligently review Apple's thorough
9 document production.

10 In any event, any allegations regarding tardy document production in the ITC are
11 irrelevant to the instant motion in this Court, where Apple has undisputedly produced on time
12 abundant documentation related to the [REDACTED], and has otherwise cooperated fully
13 with Elan's efforts to seek additional discovery on the [REDACTED]. Most importantly,
14 when Elan made a request about the [REDACTED] in this case, Apple agreed with Elan to
15 make it available to outside counsel on an informal basis, after which the parties could meet and
16 confer regarding the details of further inspections by expert witnesses. As Elan itself stated,
17 "[a]fter the initial inspection, the parties then can meet and confer to agree upon the contour and
18 details of the live testing and of the related document production resulted from such test." *See*
19 Rathinasamy Decl., Exh. H [4/12/2011 P. Rathinasamy email to D. Walter]. Thereafter, Elan
20 failed to request an informal inspection for more than two weeks. *See* Motion at 4-5. When Elan
21 finally did so, Apple presented the tool, and Elan carried out its informal inspection.⁷

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23 ⁶ Specifically, Elan appears to allege that Apple prejudiced Elan's ability to pursue its case
24 in the ITC because it did not produce one particular manual for the [REDACTED] tool
25 until a few days before the close of discovery but after the motion to compel deadline. *See*
26 Motion at 2 n.1. However, these complaints are not credible given the numerous other documents
(described above) that Apple produced months earlier, which describe and refer to the [REDACTED].
In any event, if Elan truly felt that this allegedly-late production warranted a motion to
compel in the ITC, it could and should have raised that issue before the ITC.

27 ⁷ Elan asserts that during its informal inspection of the [REDACTED] tool it asked
28 that the tool be made available with iPhone, iPad, and iPod touch but that Apple has unreasonably
delayed in making the tool available with those products. In fact, Elan made no such request
during its inspection. At most, Elan merely made an initial inquiry as to whether it would be
possible for the tool to be used with those devices. *See* Declaration of A. Percer In Support of

1 Unfortunately, at this point, the process broke down, though not through the fault of
2 Apple. One week after its informal inspection, Elan unilaterally chose to unwind the meet and
3 confer framework that the parties had put in place for arranging inspections of the [REDACTED]
4 [REDACTED]. Indeed, on May 18, Elan informed Apple that it wanted to continue its inspection the
5 following week and would do so with its expert witness. In noticing up this inspection without
6 the agreed-upon meet and confer, Elan suggested that “[t]hereafter, we can meet and confer
7 regarding how Elan will specify data from the [REDACTED] tool for production.”
8 Rathinasamy Decl., Exh. K [5/18/2011 P. Rathinasamy email to D. Walter]. When Apple
9 informed Elan that it wished to videotape any such inspections, Elan insisted on a telephonic
10 discovery hearing with the Court the very next day. At this telephonic hearing, the Court opened
11 with a salient question: why, after, all this time, was Elan suddenly demanding on an emergency
12 basis that it be given an unfettered inspection of the [REDACTED] tool. The only answer
13 Elan gave—besides alleged discovery misdeeds by Apple—was that its expert witness was in
14 town from the East Coast and did not want to purchase an airline ticket for him to fly back for an
15 inspection at a later date. Of course this is not an emergency situation, a point that is confirmed
16 by the months of delay that Elan indulged in before deciding to actually seek discovery on the
17 [REDACTED]. In reality, the instant motion—which comes long after Apple agreed to
18 make the [REDACTED] available to Elan’s expert—is simply a demand that Elan be
19 allowed to manipulate the tool behind closed doors to generate some scraps of evidence to
20 support infringement theories that have already been rightfully rejected. Any suggestion that this
21 situation is somehow a result of Apple misconduct must be rejected.

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26 Apple’s Opposition to Elan’s Motion To Compel ¶¶ 2-3 In response counsel for Apple
27 promptly investigated the issue and learned that [REDACTED] [REDACTED]
28 [REDACTED]. See *id.* ¶ 4; Westerman Decl. ¶¶ 5-10. Apple has been working
diligently to prepare the tool for testing with these devices and does not object to Elan’s
inspection as soon as it is ready, so long as the inspection is videotaped.

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VII.
CONCLUSION

For the foregoing reasons, Apple respectfully requests that Elan’s motion to compel be denied.

Dated: June 3, 2011

WEIL, GOTSHAL & MANGES LLP

By: /s/ Sonal N. Mehta
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