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 13 Apple Inc.

14 UNITED STATES DISTRICT COURT
 15 NORTHERN DISTRICT OF CALIFORNIA
 16 SAN JOSE DIVISION

17 ELAN MICROELECTRONICS
 18 CORPORATION,
 19 Plaintiff and Counterclaim
 Defendant,

20 v.

21 APPLE INC.,
 22 Defendant and Counterclaim
 23 Plaintiff.

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

**APPLE'S OPPOSITION TO ELAN
 MICROELECTRONICS
 CORPORATION'S MOTION TO
 COMPEL DISCOVERY ON VARIOUS
 ISSUES**

DATE: August 30, 2011
 TIME: 10:00 a.m.
 JUDGE: Hon. Paul S. Grewal
 CTRM: 5

25 **CONFIDENTIAL – ATTORNEYS' EYES ONLY**
 26 **FILED UNDER SEAL**
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1 I.

2 INTRODUCTION

3 Every aspect of Elan’s motion on “various issues” suffers from fundamental problems,
4 whether they be logical, substantive, procedural, or some combination thereof. To start, roughly
5 half of the discovery Elan seeks in its motion is already in its possession. For instance, Elan seeks
6 detailed financial discovery on non-accused MacBook products without multiple-finger input.
7 However, there is no such information to be had because there are no such non-accused MacBook
8 products. To the contrary, all MacBook products that have ever been released are actually
9 accused of infringing. Accordingly, Apple has already produced to Elan relevant financial
10 information for these products. Likewise, Elan demands that Apple produce all correspondence it
11 has had with third parties in pursuing document subpoenas. However, Apple has already
12 produced this correspondence. Elan’s motion even includes as an exhibit an email that Apple sent
13 *before* Elan filed its motion in which Apple unambiguously agreed to produce the requested
14 correspondence.

15 Where Elan’s motion seeks discovery not already in its possession, or that Apple had not
16 already agreed to produce, its discovery demands suffer from different foundational problems.
17 Most notably, Elan seeks detailed financial discovery on 24 different non-accused iPod products
18 going back to 2003. This discovery—in addition to being invasive, irrelevant, potentially
19 prejudicial, unnecessary, and burdensome—was never actually requested in a proper Rule 34
20 document request. In fact, as set forth below, this portion of Elan’s motion represents a motion to
21 compel discovery that was informally demanded for the first time just a few weeks ago in a meet
22 and confer email.

23 The final portion of Elan’s “various issues” motion is a demand that Apple search for and
24 collect every single document ever generated by every single Apple engineer using internal
25 testing tools that date back as far as seven or eight years. On its face, this discovery demand for
26 seven to eight years worth of raw data—which is not stored in a central repository but would have
27 to be collected through a laborious search of custodial documents of dozens of engineers—is
28 fatally overbroad and unduly burdensome. Yet Elan confirmed during meet and confer that this is

1 precisely what it wanted, otherwise refusing to narrow the scope of its demand or propose any
2 compromise solution, even though it is undeniably in possession of information that would allow
3 it to formulate a meaningful narrowed request. Indeed, in the face of Elan’s refusal to narrow its
4 discovery request, Apple proposed a compromise *before* Elan filed its motion, the record of which
5 Elan failed to submit to the Court. Since that time, Elan has completely ignored Apple’s
6 narrowed discovery proposal, confirming that it is demanding the overbroad discovery called for
7 by the literal terms of its document requests.

8 Even standing in isolation, the over breadth of Elan’s requests is apparent. When viewed
9 in the context of the overall discovery effort in this litigation—as it must be under Rule 26—this
10 over breadth raises serious concerns about Elan’s recent hunger for discovery and motion
11 practice. Taking into account discovery in the parallel ITC Investigation that the parties have
12 agreed is usable in this action, Elan has served 67 Interrogatories, 72 requests for admission, and
13 142 requests for production relevant to this case. It has received over 2.8 million pages of Apple
14 documents (from countless custodians and central repositories), relevant source code, and the
15 opportunity to inspect and collect for itself data from multiple internal Apple testing tools. By the
16 close of discovery, Elan will have taken the depositions of at least 16 Apple witnesses. Any
17 reasonable appetite for discovery would have long since been sated. Yet Elan persists in seeking
18 discovery that it has not properly requested, does not need and cannot justify under applicable
19 discovery rules. This motion should be denied.

20 II.

21 **ELAN’S MOTION TO COMPEL FINANCIAL INFORMATION ON NON-ACCUSED** 22 **PRODUCTS SHOULD BE DENIED**

23 By its motion, Elan seeks “[s]ales, profit, cost information, in native spreadsheet format,
24 for iPod and MacBook products without the Multi-Touch feature since 2003.” Mot. at 2-3, 9.
25 However, Elan never actually served a discovery request seeking such information. Indeed,
26 putting aside Elan’s creative interpretation of its own discovery requests, the reality is that Elan’s
27 motion is based solely on a demand for information in a meet and confer email sent less than a
28 month ago on July 13, 2011. This alone warrants a denial of this portion of Elan’s motion.

1 Elan’s motion should be denied on Rule 26 grounds as well. Elan’s motion seeks detailed
2 and invasive discovery for at least 24 *non*-accused products and all variants thereof on the theory
3 that this information will help it with its damages case. *See* Dkt. No. 341. Briefly, Elan seeks
4 discovery that will purportedly allow it to compare financial information for products with
5 multiple-finger input to financial information for products without multiple-finger input. Elan
6 then hopes to somehow use the results to isolate the economic value of multiple-finger input
7 alone. However, the non-accused iPod products that Elan seeks full-financial discovery on are
8 vastly different from the accused iPod touch products. As set forth in detail below, although the
9 names of the products have one word in common, any meaningful similarity ends there. Indeed,
10 the products are so vastly different that it simply makes no sense to compare them for the purpose
11 of isolating the value of multiple-finger input. As to the MacBook products that Elan seeks
12 financial information on, all MacBook products that have ever been released are accused of
13 infringing in this case, and that Apple has already provided Elan with full financial information
14 for such products. This portion of Elan’s motion should be denied as moot.

15 **A. Elan Never Propounded Discovery Requests Directed to Financial**
16 **Information for Non-Accused Products**

17 Pursuant to Civil Local Rule 37-2, “a motion to compel further responses to discovery
18 requests must set forth each request in full” Thus, consistent with foundational discovery
19 principles, the Local Rules contemplate as a prerequisite to any motion to compel an underlying
20 discovery request. Yet, Elan’s motion—which seeks native format spreadsheets detailing
21 financial information for non-accused products—is not truly based on a discovery request, but on
22 a demand articulated for the first time in a meet and confer email sent less than one month ago.

23 Elan alleges in its motion that the detailed financial information it seeks is called for by
24 the following three Elan document requests:

25 **REQUEST FOR PRODUCTION NO. 79:**

26 All documents relating to any internal analysis or study of
27 anticipated and realized changes in profit price, profits per units and
28 sales volumes due to the incorporation of the Accused
Instrumentality and/or Multi-Touch technology into the Accused
Products.

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REQUEST FOR PRODUCTION NO. 80:

All documents related to customer acceptance of the iPod Touch compared to the iPod without the Multi-Touch technology.

REQUEST FOR PRODUCTION NO. 81:

All documents related to customer acceptance of MacBooks with Multi-Touch technology compared to those without.

According to Elan, these document requests call for “[s]ales, profit, cost information, in native spreadsheet format, for iPod and MacBook products without the Multi-Touch feature since 2003.” Mot. at 9. Elan’s position is simply not credible. All of these requests pertain, at most, to marketing information that addresses the “Multi-Touch” feature in Apple products. Indeed, Request No. 79 appears to seek analyses related to anticipated or realized profits from Multi-Touch—it says nothing about financial spreadsheets in native form for non-accused products. Likewise, Request Nos. 80-81, both seek documents related to “customer acceptance” of Multi-Touch. Although Elan’s “customer acceptance” language is not a beacon of clarity, it brings to mind such discovery as customer surveys and/or market research, of which Apple has produced tens of thousands of pages. One thing it decidedly does not capture, however, is sales and revenue spreadsheets for non-accused products.

Notably, when Elan actually intended to ask for native format spreadsheets that set forth specific detailed financial information, it did so. For instance, Elan sought financial information for the “Accused Products” and “Accused Instrumentality” in its Request No. 78:

REQUEST FOR PRODUCTION NO. 78:

Monthly and annual summary documents, in excel format, from which the following may be determined regarding the Accused Instrumentality for each of the Accused Products, since January 1, 2003,

- g. total quantity of units purchased, first and last purchase date, purchasing price, identity of the suppliers, manufactures, vendors or sellers of the units
- h. cost of units purchased, including but not limited to, cost bills of material or negotiated prices for component costs, direct labor and materials, indirect labor and materials costs, manufacturing, production and overhead cost, and other standard costs and any associated variances;

- 1 i. any claimed relevant allocation of overhead, the detail of
- 2 costs included in such overhead and the bases and methods
- 3 for allocating such overhead to the Accused Products;
- 4 j. research and development costs for the Accused
- 5 Instrumentality;
- 6 k. total gross and net revenues that is generated by the Accused
- 7 Instrumentality from sales in the United States, if the
- 8 Accused Instrumentality is sold separately from the Accused
- 9 Products; and
- 10 l. the underlying documents reflecting or relating to the
- 11 method of determining revenue and costs in items (a)
- 12 through (e).

13 *Id.* In nearly 150 document requests served by Elan, there is no parallel request for products that
14 are not accused of infringement.

15 In short, there was never any such request for documents of the type Elan now seeks. In
16 fact, it was not until a July 13, 2011 discovery email that Elan stated for the first time “[i]n
17 addition, for this category of discovery, Elan further requests that Apple provide, in native
18 spreadsheet format, sales, pricing, profit and cost information for the accused products, and the
19 non-accused older versions of the same products without the multi-touch function or without the
20 use of multiple fingers.” Exh. 1 [July 25 email chain between D. Walter and J. Bu].¹ Elan’s
21 attempt to tack on a discovery request in a meet-and-confer email is inadequate, and its attempt to
22 then enforce its email demand through a motion to compel is improper. *See Jones v. Martinez*,
23 No. 04-cv-6318, 2008 U.S. Dist. LEXIS 103278, at *5 (E.D. Cal. Dec. 15, 2008) (“A review of
24 the discovery documents indicates that plaintiff never requested a copy of the videotape.
25 Therefore, plaintiff’s motion to compel production of the videotape of the incident is denied.”);
26 *Florer v. Cheryl Johnson-Bales*, No. C06-5561, 2010 U.S. Dist. LEXIS 20939, at *6 (W.D. Wash.
27 Feb. 16, 2010) (“Plaintiff did not request that the Defendants produce documents related to
28 interrogatory number 17. Plaintiff cannot use a motion to compel to obtain a response to a
question that was never posed to Defendants.”). In short, Elan’s RFPs 79-81 request a specific set

1 ¹ All exhibits are to the Declaration of Nathan A. Greenblatt in Support of Apple’s
Opposition to Elan Microelectronics Corporation’s Motion To Compel Discovery On Various
Issues.

1 of documents, not whatever documents Elan later decides it needs to conduct the “comparative
2 analysis” purportedly “called for” by the requests. *See* Mot. at 3.

3 **B. The Requested Discovery Is Irrelevant**

4 To the extent the Court entertains Elan’s discovery request despite its failure to propound
5 a proper Rule 34 document request, Elan’s motion should still be denied. As set forth below, the
6 discovery Elan seeks is either already in its possession, or irrelevant, burdensome, invasive, and
7 just plain unnecessary. As such, the Court should exercise its discretion pursuant to Rule 26 to
8 deny the discovery Elan now requests.

9 **1. There Is No Viable Comparison Between The Accused Products And
10 Non-Accused Products**

11 During the parties’ meet and confer, Elan stated that it “requests that Apple provide, in
12 native spreadsheet format, sales, pricing, profit and cost information for the accused products, and
13 the non-accused older versions of the same products without the multi-touch function or without
14 the use of multiple fingers. For example, we are requesting iPod touch sales information
15 compared to the iPod products without the multi-touch technology, and accused MacBook sales
16 information compared to those older versions without the multi-touch function.” Exh. 1 [July 25,
17 2011 email chain between D. Walter and J. Bu]. In its motion, Elan ultimately requested only
18 information for the “iPod and MacBook products without the Multi-Touch feature since 2003.”
19 Mot. at 9. As noted above, for the MacBook products, Elan already has full financial information
20 for all such products (including all version of the MacBook and MacBook Pro line of products)
21 because they are all accused of infringing in this case. As such, this portion of Elan’s motion
22 should be denied as moot.

23 Elan’s request for financial discovery related to Apple’s iPod products, on the other hand,
24 should be denied under a basic Rule 26 analysis. Indeed, Elan’s theory as to why such
25 information is relevant does not withstand even the most basic scrutiny. In short, Elan would like
26 to compare financial information for Apple’s iPod products, which do not include multiple-finger
27 input, to financial information for Apple’s iPod touch products, which do include multiple-finger
28 input. Ostensibly, Elan contends that the differential in such information may be attributed to the

1 presence of multiple-finger input in the iPod touch products. Although the Court is likely familiar
2 with these products and does not require an explanation as to just how dissimilar they are, Apple
3 summarizes the stark difference between these products for completeness.

4 At the outset, although the iPod classic, iPod shuffle, iPod nano, and iPod touch products
5 all have the word “iPod” in their names, they actually represent completely different product
6 families. Indeed, former Apple engineer Greg Marriott, who worked on iPod products, testified
7 as follows just a few weeks ago that the iPod classic and iPod touch are in “whole different
8 product famil[ies]”:

9 Q. Do you recall any conversations about that with regard to
10 the iPod touch product?

11 A. No. Our team wasn’t involved in developing that product.

12 Q. What team was involved in developing the iPod touch?

13 A. I don’t know. It just wasn’t ours. ***It shipped with the name
14 iPod, but it's a whole different product family, so . . .***

15 Exh. 2 [Marriott July 26, 2011 Dep. Tr.] at 74:15-24 (objections omitted).²

16 A picture showing an iPod classic on the left and an iPod touch on the right confirms this
17 testimony and vividly reveals the major differences between the two classes of products:



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28 ² Emphasis added throughout, unless otherwise noted.

1 Compare Exh. 3 [iPod classic] with Exh. 4 [iPod touch]. The iPod classic product on the left is a
2 device primarily for the purpose of storing and playing back media. As such, it includes a limited
3 list of menu items, most notably menu items for music, videos, photos, and podcasts. While it is
4 capable of displaying videos and images, it does not include a sophisticated graphical user
5 interface. Rather, it incorporates a scrollable text based menu system that the user scrolls through.

6 The iPod touch shown on the right is a completely different product. See, e.g., Exh. 5
7 [iPod touch features] (“In fact, the iPod touch has so much technology, you’ll forget it’s an
8 iPod.”). It is lighter, thinner, and has longer battery life compared to the iPod classic. In addition
9 to including functionality for music, videos, photos, and podcasts, the iPod touch has WiFi
10 capability that allow users to access email and Internet using the Mail and the Safari web browser
11 applications. Unlike the iPod classic, the iPod touch includes front and back-mounted cameras
12 that take photos and HD video, and allow users to engage in video calls using the FaceTime
13 application. See *id.* The iPod touch also comes standard with a stock monitoring application, a
14 Google Maps application, a weather application, a YouTube application, and productivity
15 applications including notes, an alarm clock, and a calculator, among others. See *id.* In addition,
16 unlike the iPod classic, the iPod touch may also be used to access Apple’s iOS “App Store,”
17 where users may browse and download hundreds of thousands of different individual applications
18 of a range of different types for use with the device. See *id.* These apps, once stored on the
19 device, may then be organized into user-defined groups and folders, and may later be accessed
20 using a customizable graphical user interface. In short, the iPod touch is, in essence, a portable
21 computing device with a wildly different feature set from any of the other iPod products, which is
22 why within Apple “it’s [in] a whole different product family.”

23 Given the radical differences in the feature sets of the various other iPod products and the
24 iPod touch, it simply does not follow that any difference in cost, revenue, or pricing information
25 between the iPod touch and other iPod products can be meaningfully attributed to or even
26 correlated to multiple-finger input. In fact, Elan has never suggested any manner of disentangling
27 economic information related to multiple-finger input from the bulk economic information related
28 to the multiplicity of features in the iPod touch and iPod products. Consistent with this, there are

1 24 different iPod products—from the iPod classic to the iPod shuffle—that have been released by
2 Apple since 2003, yet Elan makes no effort to try and narrow its request to iPod products that it
3 could reasonably compare to the iPod touch, presumably because there is no reasonable
4 comparison. *See* Exh. 6 [iPod models]. Indeed, the other Apple products sold under the “iPod”
5 name include even fewer features than the iPod classic and are even more different from the iPod
6 touch. For example, Apple’s iPod shuffle product lacks any display screen, measures one square
7 inch and can only play music. Exh. 7 [iPod shuffle]. Elan’s motion does nothing to suggest any
8 comparison that would pass muster as sound economic analysis for any iPod product at all, let
9 alone all versions of all iPod products since 2003.

10 Notably, Elan argues in its motion that “the issue for discovery is relevance, not the
11 alleged strength or weakness of a party’s ultimate position.” Mot. at 5. Elan’s request that the
12 Court ignore the “strength or weakness” of Elan’s position in ordering Apple to produce extensive
13 financial information about products that are not at issue in this case is contrary to both law and
14 logic. “While the standard of relevancy is a liberal one, it is not so liberal as to allow a party to
15 roam in shadow zones of relevancy and to explore matter which does not presently appear
16 germane on the theory that it might conceivably become so.” *In re Fontaine*, 402 F. Supp. 1219,
17 1221 (E.D.N.Y. 1975). Here, Elan has not even attempted to articulate a theory of relevance
18 beyond asserting that it later plans to undertake some unspecified comparison based on nothing
19 more than the fact that several vastly different products all share the name “iPod.” Accordingly,
20 the Court is well-justified in keeping the door to further discovery shut.

21 **2. The Burden of the Requested Discovery Outweighs Any Alleged** 22 **Benefit**

23 The Federal Rules of Civil Procedure embody a rule of proportionality, providing that
24 even if requested discovery is relevant, it should nonetheless be denied if the Court determines
25 that “the burden or expense of the proposed discovery outweighs its likely benefit, considering the
26 needs of the case, the amount in controversy, the parties’ resources, the importance of the issues at
27 stake in the action, and the importance of the discovery in resolving the issues.” Fed. R. Civ. P.
28 26(b)(2)(c)(iii).

1 The totality of these factors weighs against additional discovery relating to the non-
2 accused iPod products. First, given the marked differences between the iPod and iPod touch
3 products, it makes no sense to compare them for the purpose of determining the value of just one
4 feature in the iPod touch products (*i.e.*, multiple-finger input), and such comparisons will thus
5 shed no light on Elan’s case. *See supra* Part II.B. At the same time, the burden and scope of what
6 Elan demands is disproportionate. According to Elan, it is “merely requesting the same type of
7 spreadsheets of accused products’ sales information for a few additional previous generations of
8 the accused products.” Mot. at 6. In fact, Elan is asking for financial data for all iPods going
9 back eight years to 2003. This encompasses 24 different iPod models, and includes all but three
10 iPod models that have ever been released. *See* Exh. 6 [iPod models]. Such discovery, in addition
11 to being burdensome, is invasive, particularly in light of the fact that none of the iPod products are
12 actually accused in this case. In its motion, Elan makes no effort to try and cabin its discovery
13 request or identify the specific iPod products it believes might make a reasonable comparison to
14 the iPod touch. Instead, it just demands a mass of financial information for 24 previous products,
15 none of which are accused.

16 The burden of collecting this discovery is exacerbated by the tardiness of Elan’s discovery
17 motion. Indeed, this action has been pending since April 2009, yet as set forth below, Elan never
18 actually propounded discovery seeking the information sought in the instant motion. The
19 discovery requests that Elan alleges pertain to the instant motion were not served until April 12,
20 2011, roughly two years into the case. Elan then waited three additional months—until July 13,
21 2011—to tell Apple for the first time that it was interpreting its discovery requests creatively to
22 require financial information for non-accused products. Now, with the parties busy trying to
23 complete discovery efforts, Elan demands that Apple provide extensive unnecessary discovery on
24 a topic that will yield no meaningful information.

25 In addition to being unduly burdensome, the discovery Elan seeks also creates a
26 significant risk of prejudice to Apple. Apple’s iPods are among the most successful consumer
27 electronics products of the last ten years and the sales figures for all iPods going back to 2003
28 represent an enormous dollar figure completely untied to Elan’s infringement allegations in the

1 case. The introduction of such massive revenue numbers—in the billions of dollars—under the
2 guise of some sort of comparative analysis invites prejudice to Apple.

3 Finally, there is little benefit to the discovery Elan now seeks given the other discovery
4 already available to Elan. Apple has already expended significant resources to provide Elan with
5 extensive damages-related discovery, including detailed financial information for the accused
6 products and the components of the accused products that actually embody the accused
7 functionality, Apple has also provided Elan with extensive licensing, marketing, market research
8 and technical information. This extensive discovery sheds light on the *Georgia-Pacific* factors,
9 including the value of the accused functionalities relative to the products as a whole. In light of
10 the discovery that Elan already has at its disposal, any additional discovery regarding eight years
11 of financial information for non-accused iPod products would be irrelevant, prejudicial, and
12 burdensome and unnecessary.

13 III.

14 **ELAN’S DEMAND FOR COMMUNICATIONS REGARDING THIRD PARTY** 15 **SUBPOENAS WAS MOOT BEFORE ELAN EVEN FILED ITS MOTION**

16 The second part of Elan’s motion pertains to communications that counsel for Apple has
17 had with third parties in pursuing document subpoenas. Briefly, Apple served subpoenas on a
18 number of Elan’s putative customers in an effort to collect information regarding the presence of
19 Elan touchpads and touchscreens in the United States. In its motion, Elan contends that “Apple
20 has ignored Elan’s repeated requests for production of all of its communications with Elan
21 customers” Mot. at 7. Yet, Elan’s motion includes as an exhibit a six-page chain of email
22 correspondence between the parties on this issue. *See* Dkt. No. 358, Exh. E. Importantly, the
23 final part of that correspondence includes Apple’s unambiguous agreement “to produce the
24 correspondence you seek this week, along with any formal responses you have not already
25 received.” *Id.* Apple produced that correspondence just days later as promised, and this portion
26 of Elan’s motion is thus moot. Indeed, given that Apple agreed to produce the correspondence
27 Elan demands *before* Elan even filed its motion, this portion of Elan’s motion simply never
28 should have been presented to the Court.

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IV.

ELAN’S DEMAND FOR TESTING TOOL DATA IS OVERLY BROAD AND UNDULY BURDENSOME

In its motion, Elan innocuously requests that Apple simply produce “[a]ll documents responsive to RFPs 101-104 relating to the accused functionality of the accused products.” Mot. at 9. Yet, Elan never sets forth these document requests in its motion, nor does it state with any precision the magnitude and scope of what it is actually seeking. In fact, Elan’s request—made with only a few weeks left in the fact discovery period—is vast, excessive, and unduly burdensome. Elan Request for Production Nos. 101-104 seek raw data from testing tools that date back to 2003. Elan thus demands eight years worth of raw data. This data is not maintained in some sort of central repository or database, nor is it even generated systematically during operation of the tools, but is logged in raw data files in “one-off circumstances” or reflected in one-off screen captures, and accordingly, if it exists, resides on the hard drives and in the email files of engineers on an *ad hoc* basis. See Exh. 8 [Aug. 7, 2011 S. Cinereski Dep. Tr. (Rough)] at 101:21-102:7. As a result, Elan effectively demands that Apple investigate and identify which of its many engineers may have used the testing tools in question, determine whether they ever chose to log or capture any data from their use of the tools, and then search through the custodial documents and email to identify, collect, and produce data sets and screenshots that may have been recorded.

Had this request come at the start of discovery two years ago, it would still be staggeringly overbroad and unduly burdensome. That burden is only exacerbated by Elan’s delay. Elan has long been in possession of information regarding the tools themselves and the individuals who designed and/or used those tools. Weeks ago, Elan even filed an emergency motion to compel the unrecorded inspection of one of those tools, and has since inspected both tools from which it now seeks discovery. As such, Elan is in possession of information that would enable it narrow its request to what it reasonably believes it needs for its case. Yet, it has consistently refused to do so, and has ignored—and failed to submit to the Court—a compromise proposal that Apple made before Elan filed its motion. Thus, it is clear that Elan truly does seek to have Apple try to track

1 down eight years worth of raw data from the hard drives and email files of engineers who may
2 have used these testing tools. This sweeping discovery request violates the requirements of Rule
3 26, and Elan’s motion should accordingly be denied.

4 **A. Elan’s Discovery Request Is Overly Broad and Unduly Burdensome**

5 The document requests upon which Elan moves are as follows:

6 **REQUEST FOR PRODUCTION NO. 101:**

7 All documents and things relating to the tools described in
8 APEL0497107, including data or screenshots obtained from the
9 tools.

10 **REQUEST FOR PRODUCTION NO. 102:**

11 All documents and things generated through the use of Apple’s
12 [REDACTED], including but not limited to data files and
13 screenshots.

14 **REQUEST FOR PRODUCTION NO. 103:**

15 All documents and things related to or generated by Apple’s
16 [REDACTED] Tool, including screenshots.

17 **REQUEST FOR PRODUCTION NO. 104:**

18 All documents and things generated by the [REDACTED] or [REDACTED]
19 algorithms, e.g. APEL0497107, APEL0500763, APEL0500875,
20 APEL0501220

21 Thus, by these requests, Elan seeks “[a]ll documents” ever generated by Apple’s [REDACTED] or
22 [REDACTED] algorithms, “[a]ll documents” obtained from Apple’s [REDACTED] tool, and
23 “[a]ll documents” generated by Apple’s [REDACTED] Tool. The tools Elan refers to have been in use
24 by Apple engineers for years, dating back as far as 2003, and, as Elan indicates, may be used to
25 generate voluminous log files recording the raw data that results from finger contact on an Apple
26 touchpad or touchscreen or may be used to generate screenshots. Although not all engineers at
27 Apple utilize these tools, the full scope of the group of engineers that have used them over the
28 years remains unclear. Accordingly, the magnitude of what Elan seeks by the literal terms of its
document requests is vast, and would require substantial amounts of onerous detective work on
the part of Apple and its legal team to collect. For instance, even if particular custodians are
identified, counsel is unaware of any way to search for the screenshots that Elan seeks or to

1 ensure that all data generated by the tools has been identified. The screenshots are images that
2 cannot be searched using search terms. While some log files can be identifiable using search
3 terms, data generated from the “one-off” use of the testing tools can also simply be sets of
4 numbers pasted directly in an email or other document. Therefore, at best Apple could hope to
5 conduct a reasonable search for log files from a reasonably small set of custodians. On the other
6 hand, there is no reasonable way of systematically and comprehensively collecting screenshots or
7 data not in log files. Thus, on July 14, 2011 Apple objected to Elan’s discovery request seeking
8 “all documents and things related to or generated by Apple’s” tools as overly broad and unduly
9 burdensome.

10 As with Elan’s other last-minute discovery requests, the burden of these already excessive
11 discovery demands has been exacerbated by Elan’s lack of diligence in seeking discovery.
12 Indeed, Elan did not even serve the above discovery requests until June 14, 2011, more than two
13 years into the case and long after Elan had notice of the tools in question. As Elan acknowledges
14 in its motion, the tools in question were the subject of testimony during a hearing in a parallel ITC
15 Investigation that took place in February 2011 *See* Mot. at 7. Shortly after the hearing, Elan
16 requested an inspection of one of these tools, and the parties even conducted motion practice on
17 the issue of whether the inspections should be videotaped. *See generally* Dkt. No. 249; Dkt. No.
18 263. As Apple explained during the briefing process, Apple had produced documents relating to
19 these tools beginning over a year ago. *See generally* Dkt. No. 263 at 15-19 (public version of
20 Apple’s Opposition to Elan’s Motion to Compel Apple to Produce Testing Tool). This production
21 included documents that are precisely the sorts of testing results Elan is now seeking, which, as
22 noted above, Elan proudly identifies by Bates number in its discovery requests. Thus, there can
23 be no doubt that months, if not years, ago Elan was in a position to seek precisely the discovery it
24 now seeks. Now, with the parties busy trying to fulfill numerous other discovery obligations and
25 conclude discovery, Elan demands that Apple undertake a sweeping search through unknown
26 custodial files for raw data that may have been generated and recorded *ad hoc* over the last eight
27 years. This request is inappropriate and should be denied.

1 **B. Elan Has Refused Any Compromise to Balance the Burden of Its Request**

2 Notwithstanding the burden—indeed impossibility—of giving Elan what it claims to want,
3 Elan has repeatedly refused to make any effort to narrow the scope of its overbroad requests. For
4 example, at the outset of the meet and confer, Apple explained that there was no central source or
5 repository for the data Elan seeks, and repeatedly asked Elan if, in these circumstances, it was
6 truly demanding that Apple search custodial documents to identify and produce every document
7 generated by every use of either the [REDACTED] Tool or [REDACTED] tool by any Apple
8 engineer. *See* Exh. 9 [July 26, 2011 email chain between D. Walter and P. Rathinasamy] at 1-2
9 (Elan “request[ing] all relevant documents produced by the Apple testing tools.”). Elan
10 confirmed repeatedly that this was precisely what it was seeking. *Id.* at 1. Elan took the position
11 that because these tools have been available since 2003, there is an appropriate time limit on the
12 scope of Elan’s request. *See id.* This is an empty concession. As an initial matter, Elan’s alleged
13 time limitation encompasses the entire lifetime of the tools in question. And, even if it did not, a
14 demand that Apple search through the files of individual engineers going back as far as seven to
15 eight years to try to determine whether some subset of them may have generated screenshots or
16 log files using one of multiple testing tools is the paradigm of an overbroad and unduly
17 burdensome request. Elan further takes the position that it has reduced the burden of its discovery
18 requests because it is “assisting Apple to locate relevant documents” by listing in its discovery
19 requests “exemplary documents already produced by Apple in this matter.” *Mt.* at 8. However,
20 during the meet and confer, Elan unambiguously confirmed that it was seeking *every single*
21 *instance* of the types of documents identified in its discovery requests. *See* Exh. 9 [July 26, 2011
22 email chain between D. Walter and P. Rathinasamy] at 1-2. In this regard, Elan’s “assistance”
23 does nothing meaningful to limit the scope of its requests or alleviate the burden of its request.

24 Given the vast scope of its requests and the associated burden, Elan should at least make a
25 reasonable effort to narrow the scope of its discovery requests based on information already
26 available to it. As noted above, Apple’s production includes numerous documents related to the
27 tools in question, the design and development of the accused products and related individuals,
28 such that Elan could capably identify a reasonable set of Apple engineers whose custodial

1 documents it proposes that Apple search. *See, e.g.*, Exh. 10 [Document produced as
2 APEL0404758]. Accordingly, Apple suggested that Elan propose custodians for the search, but
3 Elan refused. *See, e.g.*, Exh. Exh. 9 [July 26, 2011 email chain between D. Walter and P.
4 Rathinasamy] at 2-3. In an effort to resolve this issue, Apple itself proposed a reasonable set of
5 custodians that it could search for the type of data Elan is now seeking. *See* Exh. 9 [July 26, 2011
6 email chain between D. Walter and P. Rathinasamy] at 1. However, Elan never responded.
7 Instead, Elan pressed ahead with its motion, and in the process, chose not to provide the Court
8 with the correspondence confirming that Apple had proposed custodians for the search before
9 Elan filed its motion. *Compare* Bu Decl. (Dkt. No. 358) Exh. F *with* Exh. 9 [July 26, 2011 email
10 chain between D. Walter and P. Rathinasamy]. Notably, since Elan filed its motion, it has
11 remained silent and has failed to respond to Apple’s proposal or suggest any other sort of
12 compromise.

13 In short, the scope of Elan’s discovery requests is troubling, as is its refusal to work with
14 Apple to arrive at a reasonable scope of discovery in response to Elan’s requests. While Elan
15 complains that Apple’s over breadth and undue burden objections are “boilerplate,” the objections
16 are fully recognized under Rule 26 and are fully applicable here. Elan’s motion should be denied.

17 V.

18 CONCLUSION

19 For the foregoing reasons, Apple respectfully requests that Elan’s motion to compel be
20 denied on each of the “various issues” presented.

21
22 Dated: August 9, 2011

WEIL, GOTSHAL & MANGES LLP

23
24 By: /s/ Sonal N. Mehta
25 Sonal N. Mehta
26 Attorneys for Defendant and
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