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 12 Attorneys for Plaintiff and
 Counterclaim-Defendant APPLE INC.

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

18 APPLE INC., a California corporation,
 19 Plaintiff,
 20 v.
 21 SAMSUNG ELECTRONICS CO., LTD., a
 Korean business entity; SAMSUNG
 22 ELECTRONICS AMERICA, INC., a New York
 corporation; SAMSUNG
 23 TELECOMMUNICATIONS AMERICA, LLC, a
 Delaware limited liability company,
 24 Defendants.
 25

Case No. 11-cv-01846-LHK (PSG)

**APPLE'S MOTION TO ENFORCE
 COURT ORDERS REGARDING
 SONY DESIGNS**

1 Samsung's Trial Brief shows that Samsung intends to present at trial an invalidity theory
2 that Judge Grewal has already excluded, and that relies on deposition testimony which is
3 inadmissible under the Court's July 19, 2012 Minute Order. The Court should bar Samsung from
4 presenting this theory and evidence at trial.

5 **Samsung's Inadmissible Invalidity Theory.** Samsung's Trial Brief argues that Apple
6 "derived" the iPhone design "from the designs of a competitor—Sony." (Dkt. No. 1322 (trial
7 brief) at 6.) Citing an email from Tony Fadell with a news article about Sony design, Samsung
8 asserts that the design concepts in that article and Apple's study of Sony's designs led to the final
9 design of the iPhone. (*Id.* at 2-3, 7.) If this evidence were relevant at trial, it would be to prove
10 that Apple's patents are obvious in light of Sony prior art, but Judge Grewal has already excluded
11 this theory from the case.

12 Apple successfully moved to strike Samsung's invalidity theory based on Sony products
13 on the grounds the theory was not timely disclosed. Samsung's expert Itay Sherman opined that
14 Apple's design patents were obvious, in part on the basis of two Sony products, the Sony
15 Ericsson W950 Walkman Phone and the Sony K800i phone. (Dkt. No. 939-12, Ex. 27 (Sherman
16 report) at 48-50.) Mr. Sherman argued that a former Apple designer, Shin Nishibori, created
17 "Sony Style" designs for mobile phones based on those references. Mr. Sherman also pointed to
18 Apple CAD drawings that purportedly reflect the "influence" of Sony on Apple's designs – the
19 same CAD drawings appear in Samsung's Trial Brief. (compare *id.* at 48-49 with Dkt. No. 1322
20 (trial brief) at 6.) Judge Grewal agreed with Apple that Samsung had "never previously disclosed
21 [those theories] during discovery." (Dkt. No. 1144 (Order) at 5.) Specifically, Judge Grewal
22 found that Samsung violated Rule 26(e) by failing timely to disclose Mr. Sherman's obviousness
23 theories in response to Apple's Interrogatory No. 12 seeking Samsung's invalidity defenses to
24 Apple's design patents. Judge Grewal excluded those theories under Rule 37(c)(1) because the
25 late disclosure was neither substantially justified nor harmless. (*Id.* at 2 (adopting proposed
26 findings of prevailing party); Dkt. No. 939-12 (Wheeler Decl.) at 8-9 (Apple proposed order
27 excluding Sony products).)

1 Samsung should not be allowed to circumvent Judge Grewal’s Order at trial by advancing
2 an invalidity theory based on (unspecified) Sony products. Following its trial brief, Samsung
3 may attempt to articulate a derivation defense for the first time at trial. *See Gambro Lundia AB v.*
4 *Baxter Healthcare Corp.*, 110 F.3d 1573, 1576 (Fed. Cir. 1997) (derivation is a form of
5 anticipation arising from “prior conception of the invention by another and communication of that
6 conception to the patentee”). Or it may attempt to resurrect the obviousness theories already
7 stricken from Mr. Sherman’s report. Either way, the result should be the same. At trial, Samsung
8 should not be allowed to rely on Apple’s CAD drawings allegedly done in a “Sony style,” the
9 testimony from Mr. Nishibori, or the email from Tony Fadell as evidence that Apple’s designs
10 were not original. Judge Grewal has already stricken this invalidity theory under Rule 37(c)(1).

11 Even if Samsung’s invalidity theory were somehow different from the theories Judge
12 Grewal has stricken, the Court should exclude it as untimely. Rule 37(c)(1) “mandates” the
13 exclusion from trial of theories or evidence that a party failed to disclose pursuant to Rule 26(e),
14 unless the party can show that the failure was substantially justified or harmless. *Oracle USA,*
15 *Inc. v. SAP AG*, 264 F.R.D. 541, 544 (N.D. Cal. 2009). Samsung’s original response to Apple’s
16 Interrogatory No. 12 disclosed no invalidity theories based on Sony products. (Dkt. No. 939-4
17 (Pernick Decl.) Ex. 25 at 8-15.) Samsung’s supplemental responses on March 19 and 29—which
18 came after the close of fact discovery—likewise disclosed no such theories. Samsung cannot
19 show that its failure to disclose was substantially justified, because Apple produced the alleged
20 “Sony style” CAD drawings for inspection in July 2011, physical printouts of the CAD drawings
21 in October 2011, and the Fadell email in November 2011. (Declaration of Jason R. Bartlett in
22 Support of Motion to Enforce Orders Regarding Sony Designs ¶ 3.) Samsung should not be
23 permitted to ambush Apple by basing a new invalidity theory on this evidence at trial.

24 Samsung cannot evade Judge Grewal’s Order or Rule 37(c)(1) by claiming that it intends
25 to rely on Sony products or design concepts for purposes other than to argue patent invalidity.
26 The evidence has no other relevance to this case. It should thus be excluded under Rule 402. It
27 could also be excluded under Rule 403, since it is prejudicial to Apple and not probative of any
28 remaining issue in the litigation. The news article on which Samsung relies has no picture of any

1 Sony product, making it impossible for the jury to assess from the article whether Apple in fact
2 “derived” its designs from Sony products. (Dkt. No. 1322-9 (Martin Decl.) Ex. 18.) The best
3 way for Apple to rebut Samsung’s argument would be to show the jury the Sony Walkman
4 product that Samsung claims as the inspiration
5 for the iPhone. It looks nothing the same.



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20 But it is unfair in a timed trial to require Apple to take the time to rebut such evidence, when
21 Judge Grewal has already excluded Samsung’s reliance on the Sony Walkman to support its
22 invalidity theories.

23 **Inadmissible Deposition Testimony.** Samsung attributes to Mr. Nishibori the view that
24 “his ‘Sony-style’ design changed the direction of the project that yielded the final iPhone
25 designs.” (Dkt. 1322 (trial brief) at 2.) Samsung does not cite supporting evidence, but appears
26 to rely on testimony from Mr. Nishibori’s deposition, taken on May 2, 2012.

27 This testimony is inadmissible. The Court’s July 19, 2012 Minute Order expressly states
28 that any “[d]eposition[] conducted after the close of discovery without the authorization of

1 Judge Grewal or stipulation of the parties is not admissible.” (Dkt. No. 1267 (order) at 2.)
2 Mr. Nishibori’s deposition was nearly two months after the March 8 close of fact discovery, and
3 five days after the close of expert discovery. Judge Grewal never authorized the deposition to go
4 forward and Apple never stipulated to it. Samsung deposed Mr. Nishibori in the ITC
5 Investigation pursuant to an order by Judge Pender, over Apple’s objections. (Declaration of
6 Kristin L. Yohannan in Support of Motion to Enforce Orders Regarding Sony Designs ¶ 3.)
7 Although counsel for Samsung gave the court reporter a caption that listed both this case and the
8 ITC Investigation, Apple never stipulated that the May 2 deposition would also be for this case.
9 (*Id.*) Samsung is thus precluded from relying on Mr. Nishibori’s deposition testimony at trial.¹

10 In sum, Apple moves to exclude Mr. Nishibori’s testimony, evidence of Apple’s Sony-
11 style CAD drawings, the email from Tony Fadell circulating a news article about Sony design,
12 and any other evidence or argument that Apple’s designs were derived from Sony’s products.

13 Dated: July 27, 2012

MORRISON & FOERSTER LLP

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16 By: /s/ Michael A. Jacobs
Michael A. Jacobs

17 Attorneys for Plaintiff
18 APPLE INC.

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27 ¹ The statement that Samsung attributes to Mr. Nishibori is inadmissible for a second,
28 independent reason: it is an incorrect translation of his testimony, which he gave in Japanese.
Mr. Nishibori timely corrected the deposition transcript, but Samsung cites only to the incorrect
translation.