

1 HAROLD J. MCELHINNY (CA SBN 66781)
 hmcclhinny@mofo.com
 2 MICHAEL A. JACOBS (CA SBN 111664)
 mjacobs@mofo.com
 3 RICHARD S.J. HUNG (CA SBN 197425)
 rhung@mofo.com
 4 MORRISON & FOERSTER LLP
 425 Market Street
 5 San Francisco, California 94105-2482
 Telephone: (415) 268-7000
 6 Facsimile: (415) 268-7522

MARK D. SELWYN (SBN 244180)
 mark.selwyn@wilmerhale.com
 WILMER CUTLER PICKERING
 HALE AND DORR LLP
 950 Page Mill Road
 Palo Alto, California 94304
 Telephone: (650) 858-6000
 Facsimile: (650) 858-6100

WILLIAM F. LEE (*pro hac vice*)
 william.lee@wilmerhale.com
 WILMER CUTLER PICKERING
 HALE AND DORR LLP
 60 State Street
 Boston, MA 02109
 Telephone: (617) 526-6000
 Facsimile: (617) 526-5000

Attorneys for Plaintiff
 APPLE INC.

12 UNITED STATES DISTRICT COURT
 13 NORTHERN DISTRICT OF CALIFORNIA
 14 SAN JOSE DIVISION

15 APPLE INC., a California corporation,
 16 Plaintiff,
 17 v.
 18 SAMSUNG ELECTRONICS CO., LTD., a
 Korean corporation; SAMSUNG
 19 ELECTRONICS AMERICA, INC., a New
 York corporation; and SAMSUNG
 20 TELECOMMUNICATIONS AMERICA,
 LLC, a Delaware limited liability company,
 21 Defendants.
 22

Case No. 11-cv-01846-LHK

**APPLE'S OPPOSITION TO SAMSUNG'S
 MOTION TO COMPEL REGARDING
 REQUEST FOR PRODUCTION NO. 1 AND
 INTEROGATORY NOS. 1, 3, AND 6**

Date: September 13, 2011
 Time: 10:00.
 Place: Courtroom 5, 4th Floor
 Judge: Hon. Paul Singh Grewal

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TABLE OF AUTHORITIES

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CASES

OKI Am., Inc. v. Advanced Micro Devices, Inc.,
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Polymer Techs. v. Bridwell,
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Securities & Exchange Commission v. Samuel H. Sloan & Co.,
369 F. Supp. 994 (S.D.N.Y. 1973)..... 14, 15

1 **INTRODUCTION**

2 At the outset of the preliminary injunction phase of this case, the Court set out the metes
3 and bounds of the expedited discovery in which the parties were to engage. The Court
4 emphasized that the discovery sought “must be relevant to the preliminary injunction motion,”
5 and admonished the parties to “make all efforts to keep discovery requests reasonable in scope
6 and narrowly tailored to address [that motion].” (D.N. 115 at 2.) Paying no heed to these
7 instructions, Samsung now seeks to compel Apple to provide it with: (1) expedited production of
8 documents that are burdensome to produce yet of extremely limited relevance compared to data
9 Apple has already produced; (2) [REDACTED] and
10 (3) interrogatory responses covering infringement contentions against not only Samsung products
11 that are *not* at issue in Apple’s preliminary injunction motion, but also third party products that
12 have *no* connection to the motion. Perhaps most troubling, however, are Samsung’s inaccurate
13 representations about the record, its unwillingness to accept any compromise short of the
14 production of everything that it has asked for, and its attempt to fault Apple for its own refusal to
15 take advantage of the broad discovery that Apple has made available to it. As demonstrated
16 below, Samsung has failed to put forth any legitimate basis for the relief that it has requested, and
17 accordingly, its motion to compel should be denied.

18 **STATEMENT OF FACTS**

19 On July 18, 2011, the Court issued an Order Setting Briefing And Hearing Schedule For
20 Preliminary Injunction Motion which set a deadline for expedited discovery on issues relevant to
21 that motion. (D.N. 115.) The Order set a deadline of August 8, 2011 for “Samsung’s discovery
22 from Apple.” (*Id.*) The Order explicitly states that “discovery sought under this schedule must
23 be relevant to the preliminary injunction motion,” and that the parties must “make all efforts to
24 keep discovery requests reasonable in scope and narrowly tailored to address [that motion].” (*Id.*
25 at 2.)

26 Thereafter, Samsung served 30 broad requests for production. (Declaration of Sara
27 Jenkins in Support of Samsung’s Motion to Compel (“Jenkins Decl.”), D.N. 205, Ex. A.) For
28 example, Request for Production No. 1 calls for all “DOCUMENTS RELATING to the

1 conception and reduction to practice of the DESIGN PATENTS and the '381 PATENT." The
2 requests define DESIGN PATENTS and the '381 PATENT to include:

3 all parents, progeny, continuations, applications, divisional
4 applications, reexaminations, or reissues thereof and all foreign
5 counterpart applications and patents which claim the same subject
6 matter.

7 (*Id.* at 4.) Samsung also served 9 broad interrogatories. (Jenkins Decl., Ex. B.) Interrogatory No.
8 1, for example, seeks the date Apple "first became aware" of "each and every" Samsung product
9 that Apple alleges infringes "one or more of the DESIGN PATENTS or the '381 PATENT." (*Id.*
10 at 6-7.) Despite being "preliminary injunction discovery," the interrogatory contains no explicit
11 statement that limits it to the accused products which are the subject of Apple's preliminary
12 injunction motion. (*Id.*) Interrogatory Nos. 3 and 6 ask Apple to identify "by product name,
13 product manufacturer, telecommunications carrier (if applicable), date of product announcement,
14 date of product release, and appearance of product – including front, back, and side images"
15 every product that Apple alleges use "any patented design or invention of the DESIGN
16 PATENTS or the '381 PATENT" and every product "currently available for purchase in the
17 market" that Apple believes use those patents. (*Id.* at 7-8.) Again, Samsung defines DESIGN
18 PATENTS and the '381 PATENT to include a whole host of other patents. (*Id.* at 4.) Moreover,
19 Nos. 3 and 6 are not explicitly limited to Samsung's products, or even to products sold in the
20 United States. (*Id.* at 7-8.)

21 Given the Court's Order on preliminary injunction discovery, Apple objected to
22 Samsung's requests and took the position that responsive discovery must be relevant to the
23 preliminary injunction motion. (Jenkins Decl., Exs. C-D.) Notwithstanding those objections,
24 Apple has produced over 35,000 pages of documents, provided detailed responses to Samsung's
25 interrogatories, has offered over ten witnesses on topics relevant to the injunction motion, [REDACTED]

26 [REDACTED]. (Declaration of Jason Bartlett in
27 Support of Apple's Opposition to Samsung's Motion to Compel ("Bartlett Decl."), ¶ 2.)

28 Apple has also made every effort to compromise and accommodate Samsung's demands.
[REDACTED]

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[REDACTED]

ARGUMENT

I. SAMSUNG’S REQUEST FOR [REDACTED] SEEKS UNREASONABLY BURDENSOME DISCOVERY NOT NARROWLY TAILORED TO PRELIMINARY INJUNCTION ISSUES.

A. Apple Has Already Gone Above and Beyond the Requirements of the Court’s Order in Providing Expedited Discovery Relating to the Design Patents at Issue in its Preliminary Injunction Motion.

Samsung requested “documents relating to the conception and reduction to practice of [Apple’s] design patents.” (D.N. 205 at 4.) [REDACTED]

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[REDACTED]

In short, Apple has been extremely reasonable. Samsung has only itself to blame for refusing to inspect the very evidence that it now claims it was denied.

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[REDACTED]

To understand the consequences of a leak, the Court need look no further than Samsung’s slavish copying of Apple’s designs that is the subject of this dispute. (Bartlett Decl., Ex. F (article noting Samsung redesigned its tablet to look more like the iPad 2).) [REDACTED]

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[REDACTED]

[REDACTED]

This Court faced a request substantively identical to that made by Samsung in *OKI Am., Inc. v. Advanced Micro Devices, Inc.*, No. C 04-3171 CRB (JL), 2006 U.S. Dist. LEXIS 66441 (N.D. Cal. Aug. 31, 2006). Specifically, a party had moved to compel a more open procedure for reviewing OKI’s “product layouts” or product schematics for “the convenience of its counsel.” *Id.* at *10-11. The court denied the motion because the layouts were “among OKI’s most valuable and secret assets” and “[e]ven an inadvertent disclosure of such information could spell economic catastrophe for OKI.” *Id.* at *11. This Court therefore provided for the layouts to be “produced at the office of OKI outside counsel” and reviewed “under OKI’s direct control and supervision.”

Id.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

B. [REDACTED]

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[REDACTED]

The record speaks for itself regarding Apple’s continuing efforts to accommodate Samsung’s unreasonable discovery requests. Despite the substantial expense and confidentiality risks presented by these compromises, Samsung failed to take advantage of these opportunities for further review or print-outs. (*Id.*, Ex. D.) Given the unreasonableness of Samsung’s demands and refusal to engage in good faith negotiations regarding discovery issues, Samsung’s motion should be denied.

III. APPLE HAS ALREADY ANSWERED SAMSUNG’S INTERROGATORIES AND NO SUPPLEMENTATION IS REQUIRED FOR THE PRELIMINARY INJUNCTION MOTION

Like its allegations concerning Apple’s document production, Samsung’s attempt to compel a supplemental response to interrogatories numbers 1, 3 and 6 also fails to meet the exacting standard for preliminary injunction discovery established by this Court.

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Interrogatory 1

Samsung’s Interrogatory No. 1 asks for the date that Apple first became aware of the “manufacture, use, sale, offer for sale, or importation” of the accused instrumentalities. (Jenkins Decl., Ex. B at 6-7.) Apple has already responded to that question in full by identifying the dates that the accused instrumentalities were first sold in the U.S. (*Id.*, Ex. D at 6.)

Samsung now apparently wishes that it had asked a different question. It asks that Apple be compelled to amend its response to Interrogatory No. 1 to state the date that it became aware of the *public announcement* anywhere in the world of the Samsung products at issue in Apple’s preliminary injunction motion. Even if Apple did have a duty to respond to a question other than the one posed (which it does not), there is no need for Apple to further supplement its response because Apple has *already provided* ample discovery on this issue in the form of both documents and deposition testimony.

[REDACTED]

Beyond having failed to propound the question at issue, and lacking any basis for its demand that Apple provide a supplemental response to a different interrogatory, Samsung cannot seriously contend that it is entitled to additional discovery on this subject, especially where Apple has already provided the answers that Samsung seeks in the form of documents and deposition testimony.

Interrogatories 3 and 6

In violation of the Court’s Order, Samsung seeks via interrogatories what amounts to infringement contentions on “every product manufactured” not only by Samsung, but also by *any*

1 *other company that might infringe Apple's patents*—not just those products subject to potential
2 injunctive relief. (Jenkins Decl., Ex. B at 7-8.) This is a clear violation of the Court's Order, and
3 would not be proper in any case. Apple has no duty to develop infringement contentions
4 regarding the entire universe of phones and tablets for the purposes of this litigation. Whether
5 other products not at issue in the motion do or do not infringe Apple's patents has nothing to do
6 with whether a narrow set of specific Samsung products should be enjoined. Samsung cannot
7 maintain that what it now seeks is "relevant to the preliminary injunction motion," "reasonable in
8 scope," or "narrowly tailored" as the Court required. (D.N. 115 at 2.)

9 The parties' dispute regarding the "irreparable harm" Apple has suffered as a result of
10 Samsung's misappropriation of Apple's patents and design is not a reason for Samsung to
11 demand that Apple develop infringement contentions relating to products not at issue in the
12 preliminary injunction motion. Moreover, *Polymer Techs. v. Bridwell*, 103 F.3d 970 (Fed. Cir.
13 1996) simply does not support Samsung's assertion that "(t)he date (on which) Apple first
14 became aware of these devices is directly relevant to Apple's claim of irreparable harm." Rather,
15 that decision stands for the *opposite* proposition:

16 The fact that other infringers may be in the marketplace does not
17 negate irreparable harm. A patentee does not have to sue all
18 infringers at once. Picking off one infringer at a time is not
inconsistent with being irreparably harmed.

19 *Id.* at 975. Under *Polymer Techs.*, there is no basis for Samsung's contention that Apple's
20 awareness of infringement by other Samsung devices (or any other party's devices that Apple has
21 accused of infringing its intellectual property, such as Nokia's) is relevant to Apple's claim of
22 irreparable harm.

23 [REDACTED]
24 [REDACTED] information about other companies Apple has sued on the patents-in-suit is a
25 matter of public knowledge. (See Bartlett Decl. ¶ 12.); *see also Securities & Exchange*
26 *Commission v. Samuel H. Sloan & Co.*, 369 F. Supp. 994, 995 (S.D.N.Y. 1973) ("It is well
27 established that discovery need not be required of documents of public record which are equally
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1 accessible to all parties”). Any further supplementation with respect to interrogatory numbers
2 three and six is therefore unnecessary.

3 **CONCLUSION**

4 Samsung’s motion to compel does not meet the standard for preliminary injunction
5 discovery set forth in this Court’s previous Order. Rather, Samsung’s motion seeks to harass
6 Apple on issues that are wholly irrelevant to the case. Consequently, Samsung’s motion to
7 compel should be DENIED.

8 Dated: September 9, 2011

MORRISON & FOERSTER LLP

10
11 By: /s/ Michael A. Jacobs
Michael A. Jacobs

12 Attorneys for Plaintiff
13 APPLE INC.

