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

Case No. 11-cv-01846-LHK
**APPLE'S OPPOSITION TO SAMSUNG'S
 MOTION TO COMPEL APPLE TO
 SCHEDULE INVENTOR AND
 PROSECUTING ATTORNEY
 DEPOSITIONS**
 Date: October 4, 2011
 Time: 5:00 P.M.
 Place: Telephonic Hearing
 Judge: Hon. Paul. S. Grewal

1 view of Apple’s diligence in scheduling its witnesses, and Samsung’s insistence on that deadline,
2 Samsung’s motion should be denied.

3 **BACKGROUND**

4 **The Case Management Conference.** On August 24, 2011, Judge Koh heard Apple’s
5 motion for an expedited trial and held a case management conference. At the hearing, Apple
6 offered to allow Samsung to depose the prosecuting attorneys and inventors on its asserted
7 patents by December 1, 2011. (Bartlett Decl. Ex. A at 83.) In response, Samsung countered that
8 this proposed deadline was “too late,” as it allegedly would prevent Samsung from taking claim
9 construction discovery from these attorneys and inventors. (*Id.* at 84-87.) Samsung specifically
10 highlighted an alleged need to depose “32 inventors just on their side with respect to the patents,”
11 and “another seven lawyers that prosecuted the patents.” (*Id.* at 73-74.)

12 Judge Koh subsequently ordered that that Apple’s “inventors and prosecuting attorneys
13 [would be] deposed by November 1.” (*Id.* at 87.) The following day, she issued a minute order
14 to this same effect. Judge Koh’s order also set: (i) December 1, 2011 as the deadline for the
15 depositions of Samsung’s prosecuting attorneys and inventors; (ii) January 20, 2012 for the
16 *Markman* hearing date; and (iii) July 18, 2012 for the final pretrial conference. (*Id.* at 87;
17 D.N. 187)

18 **Samsung’s Deposition Notices.** Samsung served the first of its deposition notices and
19 subpoenas for Apple’s inventors and prosecuting attorneys on September 12, 2011. Samsung’s
20 notices and subpoenas, which numbered 48 in total, exceeded the 32 inventors and 7 lawyers
21 from whom it represented to the Court that it would seek discovery.

22 Upon receiving Samsung’s notices and subpoenas, Apple immediately began scheduling
23 these depositions. To date, Apple has confirmed dates for at least 37 of the requested deponents
24 — the inventors on Apple’s asserted utility patents and the prosecuting attorneys on all patents.
25 These depositions currently are scheduled for every business day between September 30 and
26 October 20, with some of these depositions, by necessity, being double-, triple-, and even
27 quadruple-tracked.
28

1 In correspondence and during the in-person meet and confer between lead counsel
2 preceding this motion, Apple has committed to providing dates for the remaining 9 individuals
3 who are active employees or represented by Apple's counsel by October 7² Apple also agreed to
4 ensure that these depositions are completed by November 1.

5 **The Parties' Agreement regarding Document Production.** To date, Apple has
6 produced documents from virtually all of the requested deponents who are Apple employees –
7 including the design patent inventors. Apple has already substantially completed the document
8 productions for the prosecuting attorneys and its utility patent inventors.

9 Apple never insisted, as Samsung contends, on producing documents *no more than* five
10 days before a given depositions. (Mot. at 2.) Instead, during the parties' discussions concerning
11 deposition scheduling, Apple volunteered to produce documents relevant to a given deposition *no*
12 *fewer than* five days before the deposition. Apple made this offer to avoid preparation issues
13 arising from late document production, as occurred during the preliminary injunction discovery
14 phase.³ For many of the witnesses at issue in this motion, Apple has produced documents weeks
15 in advance of their scheduled deposition.

16 ARGUMENT

17 I. SAMSUNG'S DEMAND FOR COURT INTERVENTION IS UNNECESSARY, IN 18 LIGHT OF APPLE'S DILIGENCE TO DATE.

19 Judge Koh's August 25, 2011 order requires Apple to produce its inventors and
20 prosecutors for deposition by November 1. It is undisputed that Apple has scheduled and
21 continues to schedule depositions to meet that deadline.

22 Samsung sent its first notices of deposition to Apple on September 12, 2011. Apple
23 quickly responded to Samsung's requests for dates, initiating contact that same week. Over the
24 next two weeks, Apple proposed potential dates for dozens of these depositions.

25 ² The exceptions are: (i) current Apple employee Shin Nishibori, who is on an extended
26 leave of absence; (ii) Douglas Satzger, a former Apple employee for whom representation by
counsel has not yet been confirmed.

27 ³ For example, Samsung produced a sizable number of documents the evening before the
28 deposition of Samsung's 30(b)(6) designee, Justin Denison.

1 As of this morning, Apple has provided dates for 37 of Samsung’s 48 requested deponents
2 (with 34 dates confirmed). Apple also has committed in correspondence and during the in-person
3 meeting among lead counsel to provide dates for 9 more by the end of this week – well in
4 advance of their depositions. Moreover, it is undisputed that Apple has met (and often exceeded)
5 the parties’ agreement to produce relevant documents five days in advance of the depositions that
6 have occurred thus far. For all of these reasons, the Court’s intervention is unnecessary.

7 The only remaining inventors to be scheduled are Apple design patent inventors. Apple
8 prioritized scheduling the depositions of its utility patent inventors and patent prosecutors based
9 on Samsung’s position that depositions were relevant to the *Markman* proceedings. (Bartlett Decl.
10 Ex. A at 83-87.) Under Federal Circuit authority, by contrast, the depositions of Apple’s design
11 patent inventors are not relevant to the claim construction process because there are no “claims”
12 to construe. *See Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (*en*
13 *banc*) (explaining that there is no need “to attempt to provide a detailed verbal description of the
14 claimed design, as is typically done in the case of utility patents”).

15 Regardless, Apple has already committed to providing deposition dates between
16 October 20 and 31 for the remaining inventors. (Bartlett Decl. at ¶ 5 & Ex. D.) Apple has
17 advised Samsung that it will provide 9 of those dates by the end of this week. (*Id.*) In view of
18 these representations, Samsung’s demand for immediate relief is improper.

19 **II. SAMSUNG’S FAILURE TO OFFER DATES FOR ITS OWN DEONENTS**
20 **UNDERScores APPLE’S DILIGENCE.**

21 Samsung’s own conduct belies its indignation at Apple’s not having finished providing
22 deposition dates. Alongside the Court’s order that Apple produce inventors and prosecuting
23 attorneys for deposition before November 1, Samsung was ordered to produce its inventors and
24 prosecutors for deposition before December 1. (D.N. 187.)

25 In the 21 days since Samsung first requested deposition dates for 48 witnesses, Apple has
26 proposed and confirmed dates for 37. But in the 19 days since Apple first requested deposition
27 dates for 45 witnesses, Samsung has proposed dates for *zero*. (Bartlett Decl. Exs. B & C.)
28 Samsung’s refusal to discuss deposition scheduling for its own witnesses comes despite multiple

1 follow-up requests from Apple via e-mail, letter, and telephone. Samsung has no basis to fault
2 Apple's diligence in scheduling when Samsung is unwilling to provide even a semblance of
3 parity in its own conduct.

4 **III. ADDITIONAL DEPOSITION DATES IN EARLY OCTOBER ARE INFEASIBLE,**
5 **IN VIEW OF THE CURRENT CASE ACTIVITY AND SCHEDULE.**

6 As noted above, the November 1, 2011 deadline for the depositions of Apple's inventors
7 and patent prosecutors was at Samsung's request. Although Samsung now might prefer that the
8 depositions of design patent inventors be less concentrated, Apple cannot reasonably
9 accommodate that request.

10 First, it is undisputed that Apple expedited the production and deposition scheduling of
11 the patent prosecutors and utility patent inventors. Apple now is in the midst of collection and
12 review efforts for the design patent inventor depositions. Apple has already produced native
13 CAD data and the relevant portions of designer sketchbooks, and it is now working as quickly as
14 possible to complete its review and production of the designers' responsive emails and other
15 electronic documents. In order for this production to occur no later than five days before each
16 deposition, as Apple has agreed, the depositions of these individuals cannot occur before mid-
17 month. (*Id.* Ex. D.)

18 Second, even if it were possible to further expedite the design patent inventors' document
19 productions, the first half of October is already double-, triple-, or quadruple-tracked. (*Id.*) For
20 example, four depositions currently are scheduled to occur on October 14, 2011. (*Id.*) Notably,
21 this date is the start of the four-week period over which Samsung requests that Apple's design
22 patent inventors be compelled to testify. For these reasons, compliance with Samsung's
23 requested deadline of November 1, 2011 naturally requires that depositions be concentrated to
24 some degree.

25 **IV. JUDGE KOH'S SCHEDULE SHOULD REMAIN IN PLACE.**

26 According to the plain text of Judge Koh's August 25, 2011 order, "[t]he depositions of
27 the inventors and prosecuting attorneys for Apple's patents must be completed by November 1,
28 2011" (D.N. 187.) In its proposed order (but not its moving papers), Samsung seeks to adjust this

1 deadline. In particular, Samsung asks that Apple be required to “offer one design patent inventor
2 deposition on approximately every other business day from October 14 through November 14.”

3 Samsung’s requested relief is inconsistent with Judge Koh’s November 1st deadline – a
4 deadline that was imposed at Samsung’s request and in contemplation of the expedited *Markman*
5 and trial schedule that was concurrently ordered. Samsung’s desire to extend the November 1st
6 deadline risks upsetting Judge Koh’s planned case schedule. Because the deadline for the
7 depositions of Samsung’s own prosecuting attorneys and deponents is December 1, 2011, moving
8 the November 1, 2011 deadline for Apple’s witnesses would simply defer scheduling difficulties
9 to November.

10 Contrary to Samsung’s representation, Apple is not using deposition scheduling as a
11 “tactic” to “cram” depositions into the latter half of the month. (Mot. at 2.) As Apple’s
12 scheduling of 37 depositions to date and its agreement to schedule the remainder by week’s end
13 confirms, Apple is cooperating fully with Samsung to meet the Court’s schedule.⁴

14 To the extent that Samsung complains about the number of depositions scheduled for the
15 month of October, this is a problem of its own making. After all, it was Samsung’s decision to
16 notice all 48 depositions – a number exceeding the 39 that it indicated to Judge Koh was required
17 for claim construction. (Bartlett Decl. Ex. A at 73-74.)

18 Importantly, none of the four prosecutor depositions that Samsung has taken to date has
19 approached three hours, and two of these depositions have been under two hours.⁵ This suggests
20

21
22 ⁴ Although Apple previously proposed a joint stipulation to extend the deadline for design
23 patent inventor depositions, Apple did so to promote efficiency. First, as noted above, the design
24 patent inventors are not necessary for the *Markman* hearing. Second, Apple and Samsung are
25 involved in a co-pending International Trade Commission Investigation (No. 337-TA-796).
26 Samsung also has noticed the depositions of the same Industrial Design Group members in
27 connection with that investigation. Apple therefore suggested an extension to allow these
28 individuals to be deposed just once – a proposal that Apple believed would benefit both sides.
Samsung rejected Apple’s proposal, however, out-of-hand.

⁵ *See, e.g.*, Sept. 30, 2011 Deposition of Billy Allen (approximately 1:39 in length);
Sept. 30, 2011 Deposition of Judith Szepesi (approximately 1:50 in length); Oct. 3, 2011
Deposition of Jeremy Schweigert (approximately 2:19 in length); Oct. 3, 2011 Deposition of
Kenneth Xie (approximately 2:33 in length).

1 that all of Samsung's noticed depositions may unnecessary, and Samsung may be able to ease the
2 burdens of its requested schedule by focusing its deposition activity.

3 **V. CONCLUSION**

4 Apple has been diligently scheduling depositions in light of the November 1, 2011
5 deadline. Samsung's motion should be denied.

6

7 Dated: October 4, 2011

MORRISON & FOERSTER LLP

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Michael A. Jacobs

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Attorneys for Plaintiff
APPLE INC.

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