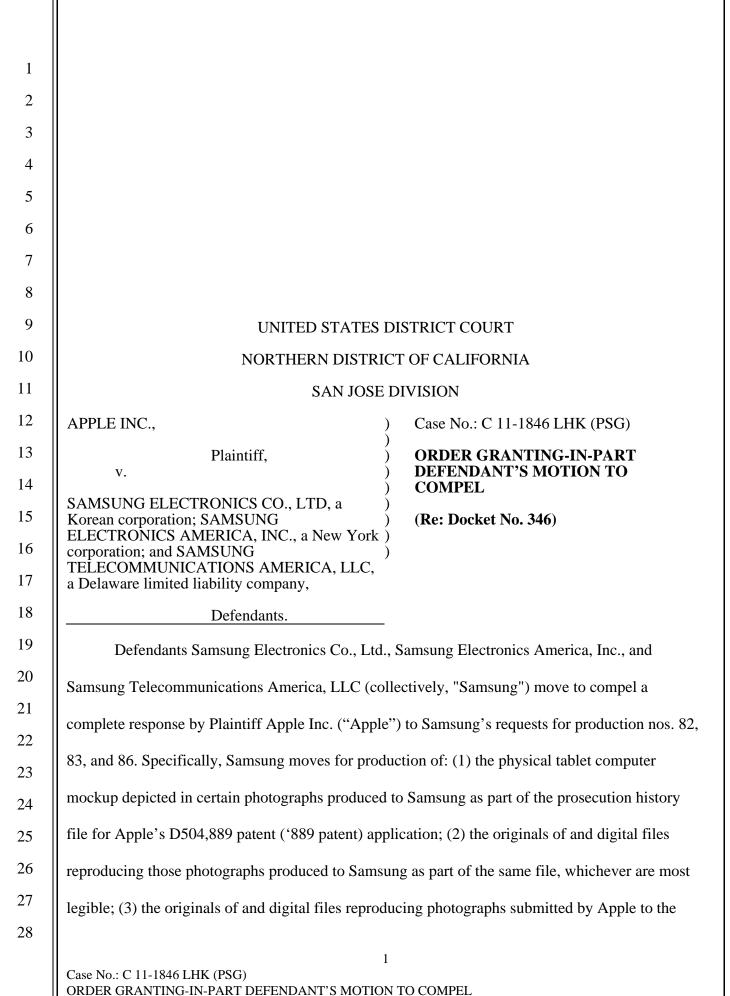
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United States District Court For the Northern District of California 1

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U.S. Patent and Trademark Office in the prosecution of the '889 patent; and (4) Apple's database relating to its mockups, prototypes, and models for specified tablet computer projects.

Apple does not dispute that the materials sought by Samsung are within the scope of allowable discovery under Fed. R. Civ. P. 26(b)(1). However, Apple represents that it has undertaken more than reasonable efforts to search for and produce the responsive photographs and mockups. Samsung disputes that Apple has produced the clearest available copies of the photographs submitted to the PTO and questions Apple's lack of transparency in revealing the parameters of its search.

After the filing of Samsung's motion and the parties' appearance for hearing on November 1, 2011, Apple submitted a supplemental statement explaining its production to date. Apple states that it has produced:

- over 40 physical objects and models, including one model recently verified to be the mockup depicted in the photographs; and
- the best images that it has been able to locate after numerous searches of files and locations in Apple's control, as well as in files and locations in the control of the Sterne Kessler and Beyer law firms.

Apple declares that these searches "reflect all of the attorneys or individuals that were involved in the prosecution of the D'889 patent or who had possession of the prosecution file." Apple further states that it is willing to search other locations that Samsung's attorneys reasonably believe would contain the images.

Based on Apple's representations, the court finds that Samsung's motion is largely moot. Yet Samsung is correct that Apple's explanation of its search locations and parameters remains insufficient to afford Samsung finality, or the opportunity to suggest additional locations that might reasonably contain clearer versions of the images sought. Consistent with the court's previous orders, the court finds that Apple must provide more transparency, and hereby orders as follows:

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Case No.: C 11-1846 LHK (PSG) ORDER GRANTING-IN-PART DEFENDANT'S MOTION TO COMPEL

- 1. Apple shall stipulate that the specific model identified by Apple industrial designer Christopher Stringer during his November 4th deposition is the same model or mockup appearing in the photographs of the '889 patent prosecution history.
- 2. Apple shall stipulate that the photographs produced are the highest quality that it has found.
- 3. Apple shall identify specifically which custodians' files were searched, any search terms that were used, and the time frame included in those searches.

IT IS SO ORDERED.

Dated: November 16, 2011

Pore S. Anne

PAUL S. GREWAL United States Magistrate Judge

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