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LTD., SAMSUNG ELECTRONICS AMERICA,
15 INC. and SAMSUNG
TELECOMMUNICATIONS AMERICA, LLC
16

17 UNITED STATES DISTRICT COURT

18 NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

20 APPLE INC., a California corporation,

21 Plaintiff,

22 vs.

23 SAMSUNG ELECTRONICS CO., LTD., a
Korean business entity; SAMSUNG
24 ELECTRONICS AMERICA, INC., a New
York corporation; SAMSUNG
25 TELECOMMUNICATIONS AMERICA,
LLC, a Delaware limited liability company,

26 Defendant.
27

CASE NO. 11-cv-01846-LHK

**SAMSUNG'S NOTICE OF MOTION AND
MOTION TO COMPEL APPLE TO
PRODUCE DOCUMENTS AND THINGS
AND PROVIDE RESPONSIVE ANSWERS
TO PROPOUNDED DISCOVERY;
MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT THEREOF**

Date: December 16, 2011

Time: 10:00 a.m.

Place: Courtroom 5, 4th Floor

Judge: Hon. Paul S. Grewal

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1 **NOTICE OF MOTION AND MOTION**

2 TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

3 PLEASE TAKE NOTICE that on December 16, 2011 at 10:00 a.m., or as soon thereafter
4 as the matter may be heard by the Honorable Paul S. Grewal in Courtroom 5, United States
5 District Court for the Northern District of California, Robert F. Peckham Federal Building, 280
6 South 1st Street, San Jose, CA 95113, Samsung Electronics Co., Ltd., Samsung Electronics
7 America, Inc., and Samsung Telecommunications America, LLC (collectively –Samsung”) move
8 the Court for an order compelling Apple Inc. (–Apple”) to produce documents and things and
9 provide responsive answers to propounded discovery in response to Samsung’s Requests for
10 Production by December 23, 2011 (or by December 19, 2011, if needed for claim construction
11 briefing) and to supplement its response to Interrogatory No. 1 by December 23, 2011.

12 This motion is based on this notice of motion and supporting memorandum of points and
13 authorities; the supporting declaration of Diane Hutnyan and exhibits attached thereto; and such
14 other written or oral argument as may be presented at or before the time this motion is deemed
15 submitted by the Court.

16 Samsung has filed concurrently herewith an Administrative Motion for Temporary Relief
17 from Lead Counsel Meet and Confer Requirement, requesting limited relief from the provision in
18 the Court’s Minute Order and Case Management Order (Dkt. 187) that requires the parties’ lead
19 counsel to meet and confer in person before a discovery motion is filed. As detailed in the
20 Administrative Motion, and the Declaration of Diane Hutnyan in Support of that motion, Samsung
21 has made a diligent, good faith effort to confer with Apple’s lead trial counsel in person (and
22 otherwise) before filing this motion, but was unsuccessful in doing so.

23 **RELIEF REQUESTED**

24 Pursuant to Federal Rule of Civil Procedure 37(a)(1), Samsung seeks an order compelling
25 Apple to produce to Samsung the documents and things set forth in Samsung’s Civil L.R. 37-2
26 Statement (below), namely:

27 (1) documents and things related to Apple’s asserted utility patents, including all
28 pleadings, discovery, transcripts, statements and briefs relating to U.S. Patent Nos. 6,493,002 (the

1 —002 patent”), 7,663,607 (the —607 patent”), and 7,812,828 (the —828 patent) in two actions
2 where Apple asserted these patents against Motorola; source code, and a working copy of Mac OS
3 10.0, prior art to U.S. Patent No. 7,853,891 (the —891 patent”); and source code for SuperClock,
4 prior art to the _002 patent;

5 (2) documents and things related to Apple’s asserted design patents, including memory
6 cards containing photographs of Apple’s tablet mockups; documents and things pertaining to
7 Apple’s ██████████, including CAD drawings, model shop orders and records and other
8 materials; de-designated copies of photographs ██████████; a supplemental response to
9 Samsung’s Interrogatory No. 1; fulsome copies of Apple’s design inventor sketchbooks
10 (excluding only pages pertaining to future products); documents and things related to Apple’s
11 ██████████
12 ██████████
13 ██████████ and documents, models, and prototypes relating to
14 Apple’s 1989 flat panel display and the Apple Cinema Display; and

15 (3) transcripts of prior testimony of Apple witnesses where they testified in their
16 capacity as Apple employees.

17 **STATEMENT OF ISSUES TO BE DECIDED**

18 1. Whether Samsung is entitled to the production of (a) documents relating to Apple’s
19 assertions of the _828, _607, and _002 patents in other actions and (b) source code and working
20 copies of MAC OS 10.0 and SuperClock;

21 2. Whether Samsung is entitled to have Apple return its memory cards containing
22 photographs taken by Samsung during inspections of Apple’s tablet mockups;

23 3. Whether Samsung is entitled to the production of: (a) documents and things
24 pertaining to Apple’s ██████████ including CAD drawings, model shop orders and records and
25 other materials; (b) de-designated copies of photographs of ██████████ (c) documents and
26 prototypes associated with Apple’s ██████████
27 ██████████ (d) models, and prototypes

1 associated with Apple's 1989 flat panel display and the Apple Cinema Display, and (e) fulsome
2 copies of sketchbooks of Apple's design inventors (excluding only future product sketches).

3 4. Whether Samsung is entitled to transcripts of prior deposition testimony of Apple
4 witnesses where they testified in their capacity as Apple employees.

5 **SAMSUNG'S CIVIL L.R. 37-2 STATEMENT**

6 Pursuant to Civil L.R. 37-2, Samsung's discovery requests to Apple are set forth in full
7 below along with Apple's responses and objections:

8 **SAMSUNG'S REQUEST FOR PRODUCTION NO. 16:**

9 All DOCUMENTS used in the design and development of each of the APPLE ACCUSED
10 PRODUCTS, including, without limitation, all notebooks, diagrams, progress reports, studies,
11 internal memoranda, contracts for services, and COMMUNICATIONS.

12 **APPLE'S RESPONSE TO REQUEST FOR PRODUCTION NO. 16:**

13 Apple objects to this request on the grounds that it is overly broad, unduly burdensome,
14 vague and ambiguous, and seeks information that is neither relevant nor reasonably calculated to
15 lead to the discovery of admissible evidence, including without limitation because it seeks
16 documents regarding components and/or functionality not at issue in this lawsuit. Apple further
17 objects to the term "relating to" to the extent that it fails to provide reasonable particularity as to
18 the scope of the documents sought. Apple further objects to this request to the extent that it seeks
19 documents and things protected from disclosure by the attorney-client privilege, work product
20 doctrine, joint defense or common interest privilege, or other applicable privilege, doctrine, or
21 immunity.

22 Subject to and without waiving the foregoing General and Specific Objections, Apple is
23 willing to meet and confer to discuss the scope and relevance of the documents sought by
24 Samsung.

25 **SAMSUNG'S REQUEST FOR PRODUCTION NO. 75:**

26 All DOCUMENTS relating to any lawsuit, administrative proceeding, or other proceeding
27 involving any of the APPLE ACCUSED PRODUCTS, APPLE IP, or patents related to the
28 APPLE PATENTS-IN-SUIT, including, without limitation, any pleading, paper, motion, affidavit,

1 declaration, report, decision, or order, for cases to include, without limitation, C11- 80169 MISC
2 JF (HRL) (N.D. Cal.), 337-TA-794 (ITC), 1:2010cv23580 (S.D. Fla.), 1:2010cv06385 (N.D. Ill.),
3 1:2010cv06381 (N.D. Ill.), 337-TA-745 (ITC), 1:2010cv00166 (D. Del.), 1:2010cv00167 (D.
4 Del.), 337-TA-724 (ITC), 3:2010cv00249 (W.D. Wisc.), and 337-TA- 701 (ITC).

5 **APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 75:**

6 Apple objects to this request as overly broad, unduly burdensome, and not reasonably
7 calculated to lead to the discovery of admissible evidence, including without limitation because it
8 seeks documents related to components and/or functionality not at issue in this lawsuit. Apple
9 further objects to this request because it is improper for Samsung to use this lawsuit as a means to
10 obtain discovery pertaining to other proceedings. Apple further objects to the term “relating to” to
11 the extent that it fails to provide reasonable particularity as to the scope of the documents sought.
12 Apple further objects to this request to the extent that it purports to require the production of
13 documents and things protected from disclosure by the attorney-client privilege, attorney work
14 product doctrine, joint defense or common interest privilege, or any other applicable privilege,
15 doctrine, or immunity.

16 Subject to and without waiving the foregoing General and Specific Objections, Apple is
17 willing to meet and confer to discuss the scope and relevance of the documents sought by
18 Samsung.

19 **SAMSUNG’S REQUEST FOR PRODUCTION NO. 83:**

20 All DOCUMENTS and things relating to the conception of any alleged invention claimed
21 by the APPLE IP¹, including, without limitation, any documents or things which APPLE contends
22 corroborate such conception, including, without limitation, laboratory notebooks, schematics,
23 drawings, specifications, source code, artwork, formulas, and prototypes.

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¹ In Samsung’s Requests for Production, “APPLE IP” is defined to include the “APPLE PATENTS-IN-SUIT,” which are defined to include the “APPLE DESIGN PATENTS.”

1 **APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 83:**

2 Apple objects to the phrases —~~relating to the conception of any alleged invention~~” as vague
3 and ambiguous, and object to this request as vague and ambiguous to the extent it seeks
4 information regarding conception of an invention for Apple trademarks and trade dress. Apple
5 objects to this request as overly broad, unduly burdensome, and not reasonably calculated to lead
6 to the discovery of admissible evidence, especially because it requests ~~all~~ DOCUMENTS and
7 things,” and as it calls for information that is not relevant to the claims in this case to the extent it
8 seeks information regarding patents and patent claims not asserted by Apple. Apple objects to the
9 production of ~~laboratory notebooks, schematics, drawings, specifications, source code, artwork,~~
10 formulas, and prototypes” without adequate safeguards against unauthorized release of new
11 product information. Apple objects to this request to the extent it seeks production of documents
12 that: (i) are protected from discovery by the attorney-client privilege or the work product doctrine,
13 or any other applicable privilege or immunity, or any other applicable privilege or immunity; (ii)
14 are outside of Apple’s possession, custody, or control; (iii) would require Apple to draw a legal
15 conclusion to respond; or (iv) can be obtained as easily by Samsung, are already in Samsung’s
16 possession, or are publicly available.

17 Subject to and without waiving the foregoing General and Specific Objections, Apple has
18 produced or will produce responsive, non-privileged documents in the possession, custody, or
19 control of the named inventors of Apple’s asserted patents currently employed by Apple, if any,
20 located after a reasonable search, sufficient to show conception of Apple’s utility and design
21 patents at issue.

22 **SAMSUNG’S REQUEST FOR PRODUCTION NO. 86:**

23 All DOCUMENTS and things relating to the reduction to practice of any alleged invention
24 claimed by the APPLE IP, including, without limitation, any documents or things which APPLE
25 contends corroborate such reduction to practice.

26 **APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 86:**

27 Apple objects to the phrase ~~relating to the reduction to practice~~” as vague and ambiguous,
28 and the request is vague and ambiguous to the extent it seeks reduction to practice of Apple’s

1 asserted trademark and trade dress rights. Apple objects to this request as overly broad, unduly
2 burdensome, and not reasonably calculated to lead to the discovery of admissible evidence,
3 especially because it requests ~~all~~ DOCUMENTS and things.” Apple objects to this request to the
4 extent it seeks production of documents that: (i) are protected from discovery by the attorney-
5 client privilege or the work product doctrine, or any other applicable privilege or immunity; (ii)
6 are outside of Apple’s possession, custody, or control; (iii) would require Apple to draw a legal
7 conclusion to respond; or (iv) can be obtained as easily by Samsung, are already in Samsung’s
8 possession, or are publicly available.

9 Subject to and without waiving the foregoing General and Specific Objections, Apple has
10 produced or will produce responsive, non-privileged documents in the possession, custody, or
11 control of the named inventors of Apple’s asserted patents currently employed by Apple, if any,
12 located after a reasonable search, sufficient to show reduction to practice of the Apple utility and
13 design patents.

14 **SAMSUNG’S REQUEST FOR PRODUCTION NO. 95:**

15 All DOCUMENTS and COMMUNICATIONS concerning prior testimony of any inventor
16 of the APPLE IP.

17 **APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 95:**

18 Apple objects to the term ~~concerning~~” to the extent that it fails to provide reasonable
19 particularity as to the scope of the documents sought. Apple objects to the phrase ~~prior~~
20 testimony” as vague and ambiguous, and the request is vague and ambiguous to the extent it seeks
21 information regarding ~~inventors~~” of Apple trademarks and trade dress. Apple objects to this
22 request as overly broad, unduly burdensome, and not reasonably calculated to lead to the
23 discovery of admissible evidence, especially because it requests ~~all~~ DOCUMENTS and
24 COMMUNICATIONS.” Apple objects to this request as calling for information that is not
25 relevant to the claims in this case to the extent it seeks information regarding patents and patent
26 claims not asserted by Apple. Apple objects to this request to the extent it seeks production of
27 documents that: (i) are protected from discovery by the attorney-client privilege or the work
28 product doctrine, or any other applicable privilege or immunity; (ii) are outside of Apple’s

1 possession, custody, or control; (iii) can be obtained as easily by Samsung, are already in
2 Samsung's possession, or are publicly available; or (iv) are subject to a confidentiality or
3 nondisclosure agreement or governed by a protective order preventing its production.

4 Subject to and without waiving the foregoing General and Specific Objections, Apple has
5 produced or will produce responsive, non-privileged documents in its possession, custody, or
6 control, if any, located after a reasonable search, sufficient to show non-confidential deposition
7 and trial transcripts of the named Apple inventors currently employed by Apple regarding the
8 Apple patents in suit.

9 **SAMSUNG'S REQUEST FOR PRODUCTION NO. 98:**

10 All DOCUMENTS and things relating to any information, including patents, publications,
11 prior knowledge, public uses, sales, or offers for sale, that may constitute, contain, disclose, refer
12 to, relate to, or embody any PRIOR ART to any alleged invention claimed by the APPLE IP.

13 **APPLE'S RESPONSE TO REQUEST FOR PRODUCTION NO. 98:**

14 Apple objects to the phrase ~~“relating to any information”~~ as vague and ambiguous, and the
15 request is vague and ambiguous to the extent it seeks information regarding ~~“PRIOR ART”~~ for
16 Apple trademarks and trade dress. Apple objects to this request as overly broad, unduly
17 burdensome, and not reasonably calculated to lead to the discovery of admissible evidence,
18 especially because it requests ~~“all DOCUMENTS and things.”~~ Apple objects to this request as
19 calling for information that is not relevant to the claims in this case to the extent it seeks
20 information regarding patents and patent claims not asserted by Apple. Apple objects to this
21 request to the extent it seeks production of documents that: (i) are protected from discovery by the
22 attorney-client privilege or the work product doctrine, or any other applicable privilege or
23 immunity; (ii) are outside of Apple's possession, custody, or control; (iii) would require Apple to
24 draw a legal conclusion to respond; (iv) can be obtained as easily by Samsung, are already in
25 Samsung's possession, or are publicly available; or (v) would be duplicative of the production
26 sought in Requests Nos. 81, 92, 96, or 97.

27 Subject to these objections, Apple is willing to meet and confer to discuss the scope and
28 relevance of the documents sought by Samsung.

1 **SAMSUNG’S REQUEST FOR PRODUCTION NO. 184:**

2 Complete transcripts of testimony given at a deposition, hearing, trial, or other proceeding
3 by the named inventors of the APPLE that relate to any product.

4 **APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 184:**

5 Apple objects to the phrase ~~by~~ “by the named inventors of the APPLE” as vague and
6 ambiguous, to the extent it renders the request incomprehensible. Apple objects to this request as
7 overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of
8 admissible evidence, especially to the extent it seeks testimony that does not relate to the IP
9 asserted by Apple in this case. Apple objects to this request to the extent it seeks production of
10 documents that: (i) are not relevant to the claims or defenses at issue in this case; (ii) are outside of
11 Apple’s possession, custody, or control; (iii) can be obtained as easily by Samsung, are already in
12 Samsung’s possession, or are publicly available; or (iv) are subject to a confidentiality or
13 nondisclosure agreement or governed by a protective order preventing its production.

14 Subject to and without waiving the foregoing General and Specific Objections, Apple is
15 willing to meet and confer to discuss the scope and relevance of the documents sought by
16 Samsung.

17 **SAMSUNG’S REQUEST FOR PRODUCTION NO. 187:**

18 All DOCUMENTS from any prior or current litigation or dispute relating to infringement,
19 validity, enforceability, or ownership of the APPLE DESIGN PATENTS.

20 **APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 187:**

21 Apple objects to the phrase ~~dispute relating to infringement, validity, enforceability, or~~
22 ownership” as vague and ambiguous. Apple objects to this request as overly broad, unduly
23 burdensome, and not reasonably calculated to lead to the discovery of admissible evidence,
24 especially because it requests ~~all DOCUMENTS.~~” Apple objects to this request to the extent it
25 seeks production of documents that: (i) are protected from discovery by the attorney-client
26 privilege or the work product doctrine, or any other applicable privilege or immunity; (ii) are
27 outside of Apple’s possession, custody, or control; (iii) can be obtained as easily by Samsung, are
28

1 already in Samsung's possession, or are publicly available; or (iv) are subject to a confidentiality
2 or non-disclosure agreement or governed by a protective order preventing its production.

3 Apple further objects to Samsung's request as overbroad to the extent it purports to require
4 Apple to conduct a search for documents that is more extensive than is reasonable under the
5 circumstances. Subject to and without waiving the foregoing General and Specific Objections,
6 Apple has produced or will produce responsive, non-privileged documents in its possession,
7 custody, or control, if any, located after a reasonable search as discussed in more detail above.

8 **SAMSUNG'S REQUEST FOR PRODUCTION NO. 219:**

9 All documents relating to the 828 PATENT, including but not limited to Notices of Prior
10 Art, prior art disclosures, prior art, invalidity contentions, discovery responses, expert reports,
11 pleadings, papers, motions, affidavits, declarations, reports, decisions, or orders from ITC
12 Investigation No. 337-TA-750.

13 **APPLE'S RESPONSE TO REQUEST FOR PRODUCTION NO. 219:**

14 Apple objects that this request is duplicative of Request for Production No. 75. Apple
15 objects to this request as overly broad, unduly burdensome, and not reasonably calculated to lead
16 to the discovery of admissible evidence, including without limitation because it seeks documents
17 related to components and/or functionality not at issue in this lawsuit. Apple further objects to this
18 request because it is improper for Samsung to use this lawsuit as a means to obtain discovery
19 pertaining to other proceedings. Apple further objects to the term "relating to" to the extent that it
20 fails to provide reasonable particularity as to the scope of the documents sought. Apple further
21 objects to this request to the extent it purports to require the production of documents and things
22 protected from disclosure by the attorney-client privilege, attorney work product doctrine, joint
23 defense or common interest privilege, or any other applicable privilege, doctrine, or immunity.

24 Subject to and without waiving the foregoing General and Specific Objections, Apple is
25 willing to meet and confer to discuss the scope and relevance of the documents sought by
26 Samsung.

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1 **SAMSUNG’S REQUEST FOR PRODUCTION NO. 220:**

2 All documents relating to the _828 PATENT, including but not limited to Notices of Prior
3 Art, prior art disclosures, prior art, invalidity contentions, discovery responses, expert reports,
4 pleadings, papers, motions, affidavits, declarations, reports, decisions, or orders from *Apple Inc. v.*
5 *Motorola Inc. et al.*, 3:10-CV00661 (W.D. WI).

6 **APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 220:**

7 Apple objects that this request is duplicative of Request for Production No. 75. Apple
8 objects to this request as overly broad, unduly burdensome, and not reasonably calculated to lead
9 to the discovery of admissible evidence, including without limitation because it seeks documents
10 related to components and/or functionality not at issue in this lawsuit. Apple further objects to this
11 request because it is improper for Samsung to use this lawsuit as a means to obtain discovery
12 pertaining to other proceedings. Apple further objects to the term “relating to” to the extent that it
13 fails to provide reasonable particularity as to the scope of the documents sought. Apple further
14 objects to this request to the extent it purports to require the production of documents and things
15 protected from disclosure by the attorney-client privilege, attorney work product doctrine, joint
16 defense or common interest privilege, or any other applicable privilege, doctrine, or immunity.

17 Subject to and without waiving the foregoing General and Specific Objections, Apple is
18 willing to meet and confer to discuss the scope and relevance of the documents sought by
19 Samsung.

20 **SAMSUNG’S REQUEST FOR PRODUCTION NO. 221:**

21 All documents relating to the _002 PATENT, including but not limited to Notices of Prior
22 Art, prior art disclosures, prior art, invalidity contentions, discovery responses, expert reports,
23 pleadings, papers, motions, affidavits, declarations, reports, decisions, or orders from *Apple Inc. v.*
24 *Motorola Inc. et al.*, 3:10-CV00661 (W.D. WI).

25 **APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 221:**

26 Apple objects that this request is duplicative of Request for Production No. 75. Apple
27 objects to this request as overly broad, unduly burdensome, and not reasonably calculated to lead
28 to the discovery of admissible evidence, including without limitation because it seeks documents

1 related to components and/or functionality not at issue in this lawsuit. Apple further objects to this
2 request because it is improper for Samsung to use this lawsuit as a means to obtain discovery
3 pertaining to other proceedings. Apple further objects to the term “relating to” to the extent that it
4 fails to provide reasonable particularity as to the scope of the documents sought. Apple further
5 objects to this request to the extent it purports to require the production of documents and things
6 protected from disclosure by the attorney-client privilege, attorney work product doctrine, joint
7 defense or common interest privilege, or any other applicable privilege, doctrine, or immunity.

8 Subject to and without waiving the foregoing General and Specific Objections, Apple is
9 willing to meet and confer to discuss the scope and relevance of the documents sought by
10 Samsung.

11 **SAMSUNG’S REQUEST FOR PRODUCTION NO. 227:**

12 All documents relating to the 607 PATENT, including but not limited to Notices of Prior
13 Art, prior art disclosures, prior art, invalidity contentions, discovery responses, expert reports,
14 pleadings, papers, motions, affidavits, declarations, reports, decisions, or orders from ITC
15 Investigation No. 337-TA-750.

16 **APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 227:**

17 Apple objects that this request is duplicative of Request for Production No. 75. Apple
18 objects to this request as overly broad, unduly burdensome, and not reasonably calculated to lead
19 to the discovery of admissible evidence, including without limitation because it seeks documents
20 related to components and/or functionality not at issue in this lawsuit. Apple further objects to this
21 request because it is improper for Samsung to use this lawsuit as a means to obtain discovery
22 pertaining to other proceedings. Apple further objects to the term “relating to” to the extent that it
23 fails to provide reasonable particularity as to the scope of the documents sought. Apple further
24 objects to this request to the extent it purports to require the production of documents and things
25 protected from disclosure by the attorney-client privilege, attorney work product doctrine, joint
26 defense or common interest privilege, or any other applicable privilege, doctrine, or immunity.

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1 Subject to and without waiving the foregoing General and Specific Objections, Apple is
2 willing to meet and confer to discuss the scope and relevance of the documents sought by
3 Samsung.

4 **SAMSUNG’S REQUEST FOR PRODUCTION NO. 228:**

5 All documents relating to the 607 PATENT, including but not limited to Notices of Prior
6 Art, prior art disclosures, prior art, invalidity contentions, discovery responses, expert reports,
7 pleadings, papers, motions, affidavits, declarations, reports, decisions, or orders from *Apple Inc. v.*
8 *Motorola Inc. et al.*, 3:10-CV00661 (W.D. WI).

9 **APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 228:**

10 Apple objects that this request is duplicative of Request for Production No. 75. Apple
11 objects to this request as overly broad, unduly burdensome, and not reasonably calculated to lead
12 to the discovery of admissible evidence, including without limitation because it seeks documents
13 related to components and/or functionality not at issue in this lawsuit. Apple further objects to this
14 request because it is improper for Samsung to use this lawsuit as a means to obtain discovery
15 pertaining to other proceedings. Apple further objects to the term “relating to” to the extent that it
16 fails to provide reasonable particularity as to the scope of the documents sought. Apple further
17 objects to this request to the extent it purports to require the production of documents and things
18 protected from disclosure by the attorney-client privilege, attorney work product doctrine, joint
19 defense or common interest privilege, or any other applicable privilege, doctrine, or immunity.

20 Subject to and without waiving the foregoing General and Specific Objections, Apple is
21 willing to meet and confer to discuss the scope and relevance of the documents sought by
22 Samsung.

23 **SAMSUNG’S CERTIFICATION PURSUANT TO FED. R. CIV. P. 37(a)(1)**

24 Samsung hereby certifies that it has in good faith conferred with Apple in an effort to
25 obtain the discovery described immediately above without Court action. Samsung’s efforts to
26 resolve this discovery dispute without court intervention are described in paragraphs 44-47 of the
27 declaration of Diane C. Hutnyan, submitted herewith.

1 DATED: December 12, 2011

QUINN EMANUEL URQUHART &
SULLIVAN, LLP

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By /s/ Victoria F. Maroulis
Charles K. Verhoeven
Kevin P.B. Johnson
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Michael T. Zeller
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LTD., SAMSUNG ELECTRONICS AMERICA,
INC., and SAMSUNG
TELECOMMUNICATIONS AMERICA, LLC

1 **MEMORANDUM OF POINTS AND AUTHORITIES**

2 **I. INTRODUCTION**

3 Apple initiated this litigation and secured an early trial date, yet it refuses to deal with its
4 resulting responsibility to provide Samsung with timely and thorough discovery responses. For
5 weeks, Samsung has requested the expedited production of several very narrow, limited sets of
6 specifically identified materials in Apple’s possession that are vital to Samsung’s case and that are
7 needed right away for ongoing claim construction briefing, invalidity contentions, continuing
8 depositions and follow-on discovery. These materials all go to the core of Samsung’s defenses
9 with respect to the utility and design patents Apple has asserted against it, yet Apple contends they
10 are “peripheral,” and after weeks of claiming to have diligently searched for these materials, still
11 cannot even provide an estimate of when they will be produced. Thus, while seeking the broadest
12 and most unreasonable scope of discovery from Samsung, Apple conveniently chooses to exclude
13 from its own discovery these unquestionably relevant materials, including:.

14 (1) documents and source code needed immediately for claim construction briefing
15 with respect to of Apple’s asserted utility patents and which must be produced pursuant to Patent
16 Local Rule 3-4;

17 (2) documents, tangibles, and other information Apple has been deliberately
18 withholding, which are key to the validity of Apple’s asserted design patents and which have
19 prevented Samsung from being able to question Apple’s witnesses in these key areas or
20 conducting follow-on discovery; and

21 (3) transcripts of prior testimony of Apple witnesses where they testified in their
22 capacity as Apple employees, which are needed to protect Samsung from having to take any more
23 depositions without the benefit of this prior, relevant testimony.

24 Apple does not deny the relevance of the documents, things, and other information
25 Samsung is moving to compel. Rather, Apple has been stringing Samsung along for weeks, even
26 with respect to photographs related to the mockup for which it was previously ordered to search.
27 Apple has also been withholding or concealing discrete pieces of relevant evidence – for example,
28 confiscating Samsung’s work product photographs and only producing them with improper

1 confidentiality designations, or filing public photographs under seal – to prevent Samsung from
2 being able to use these items. Apple then squandered the valuable resources of this Court to argue
3 that its own photographic records of product inspections are work product that could not be shared
4 with Samsung.

5 Samsung cannot wait any longer for Apple’s compliance. Apple should be ordered to
6 produce the requested materials and information no later than December 23, with two exceptions:
7 (1) the missing documents from Apple’s Motorola cases, along with the Mac OS v. 10 and
8 SuperClock programs and source code, should be produced no later than December 19 so as to
9 permit inclusion in Samsung’s claim construction briefing; and (2) the memory cards containing
10 Samsung’s work product should be returned immediately.

11 **II. FACTS**

12 For several weeks, Samsung has been requesting that Apple actively search for and
13 produce, as soon as possible, specific key items that are crucial to Samsung’s case, the production
14 of which needs to be expedited for use in connection with claim construction, invalidity
15 contentions, depositions and follow-on third-party discovery.

16 To varying degrees, Apple generally agreed to search for and/or produce at least some of
17 the items in the requested categories. However, despite numerous letters and meet-and-confer
18 sessions, with few exceptions, the items have not been produced. Moreover, while Apple has
19 claimed diligence in searching for the requested items, for several weeks it would make no
20 representation whatsoever as to when the items would be produced, or even which of the requested
21 items would be produced. Only after Samsung indicated it was planning to move to compel these
22 items, on Wednesday, December 7, did Apple say that it would “either produce [the items] by
23 December 15 or tell Samsung on December 15 the status of its search and what remained to be
24 done.” (Hutnyan Decl. ¶ 6.) On December 7, Apple’s counsel also revealed that it was not
25 expediting production of these items because it regarded them as “peripheral.” (Hutnyan Decl. ¶
26 21.)

27 This pattern of obstructionism has not been limited to the documents and tangible items
28 Samsung had requested. Besides failing to produce these key items, week after week, Apple:

- 1 • has also refused to provide basic information responsive to Samsung’s
2 Interrogatory No. 1 concerning the conception and reduction to practice of its purportedly seminal
3 design patent (Hutnyan Decl. ¶ 19) ;
- 4 • has improperly redacted almost all the information out of its inventors’ sketchbooks
5 (Hutnyan Decl. ¶ 36);
- 6 • has used improper search parameters for searches related to inventorship (Hutnyan
7 Decl. ¶ 19);
- 8 • has confiscated and improperly withheld Samsung’s work product photographs
9 (Hutnyan Decl. ¶ 9); and
- 10 • despite its representations to this Court that it ~~–[had]~~ done and is doing all it can to
11 make the requested materials and information available to Samsung in an expedited manner,”²
12 has [REDACTED]
13 [REDACTED]
14 [REDACTED]. (Hutnyan Decl. ¶¶ 13-15.)

15 *The Parties’ Lead Counsel Meet and Confer*

16 On November 20, 2011, Samsung requested dates when Apple would make its lead
17 counsel available for a meet and confer, as numerous other meet-and-confers had been
18 unsuccessful, and time was running out for Samsung to receive the requested materials. (Hutnyan
19 Decl. ¶ 44.) On December 6, 2011, Samsung recognized that it could not move forward with a
20 motion without meeting the Court’s in-person meet and confer requirement – and further
21 recognizing the likely impossibility of placing lead counsel within a thousand miles of each other,
22 much less in the same room, anytime before December 19. Samsung thus requested that Apple
23 join in stipulating to a request to relieve both parties from having to meet the ~~–in-~~person”
24 requirement. (Hutnyan Decl. ¶ 45.) Apple refused to stipulate, and unilaterally sought a one-time
25 exception to the in-person meet and confer requirement for itself, which was granted. (*Id.*; *see*

26 _____
27 ² Apple's Opposition to Samsung's Motion to Compel Documents and Things (Dkt. 351a) at
28 11.

1 also D.N. 472.) Apple further refused to timely provide its lead counsel for even a telephonic
2 meet and confer on any of Samsung's discovery issues.³ (Hutnyan Decl. ¶ 47.)

3 **III. LEGAL STANDARDS**

4 A party is entitled to seek through discovery ~~any~~ nonprivileged matter that is relevant to
5 any party's claim or defense." Fed. R. Civ. P. 26(b)(1). ~~A~~ party may serve on any other party a
6 request within the scope of Rule 26(b): (1) to produce (A) any designated documents . . . ; or
7 (B) any designated tangible things." Fed. R. Civ. P. 34(a).

8 ~~T~~he moving papers [on a motion to compel] must detail the basis for the party's
9 contention that it is entitled to the requested discovery and must show how the proportionality and
10 other requirements of Fed. R. Civ. P. 26(b)(2) are satisfied." Civil Local Rule 37-2.

11 **IV. ARGUMENT**

12 A. Documents Relevant To the Claim Construction And Validity Of the Utility
13 Patents-In-Suit Should Be Produced Immediately

14 Despite repeated requests over several weeks, Apple continues to withhold specific, readily
15 available categories of documents and source code needed for Samsung's rebuttal claim
16 construction brief, which is due December 22.

17 1. Apple Has Failed To Produce Many Documents From The ITC and
18 Wisconsin Actions In Which It Asserted Three Of The Patents-In-Suit

19 Apple previously asserted two of the patents asserts in this action – the 828 and 607
20 patents – against Motorola in the International Trade Commission, Investigation No. 337-TA-750.
21 It also previously asserted a third – the 002 patent – against Motorola in Apple Inc. v. Motorola
22 Inc. et al., 3:10-CV00662 (W.D. Wis.). In those actions, Apple made admissions in pleadings,
23 briefs, and transcripts, and took various positions that may or may not be consistent with positions
24

25 ³ After the Court excused Apple from having its lead counsel meet and confer ~~in person~~"
26 with respect to the issues raised in its motion, Samsung renewed its request that Mr. McElhinny
27 make himself available for a telephonic meet-and-confer with Mr. Verhoeven on December 11 (as
28 there was no possibility of an in-person meeting) to try to resolve Samsung's discovery issues.
(Hutnyan Decl. ¶ 46). Apple refused that invitation. (Hutnyan Decl. ¶ 47).

1 it is taking now. The pleadings, briefs, discovery and transcripts are all directly relevant to claim
2 construction and other defenses, and should be produced without further delay, as claim
3 construction briefing has already begun and Samsung's last opportunity to include this
4 information in its briefing is December 22.

5 Apple does not, and cannot, refute the relevance of the documents Samsung has requested
6 from these three cases and, has propounded requests for production seeking similar materials from
7 Samsung.⁴ Several weeks after Samsung specifically requested these documents, on December 1,
8 Apple finally produced some of the documents for use in this case. (Hutnyan Decl. Ex. 5.)
9 However, Samsung has since identified many documents that are still missing.⁵ (Hutnyan Decl. ¶¶
10 10-11.) Further, because Samsung is not involved in those proceedings, Samsung cannot
11 determine what else might be missing, and Apple has refused to represent that the production is
12 otherwise complete. (Hutnyan Decl. ¶ 12.)

13 Apple is out of time. It should be ordered to complete its production of all pleadings,
14 briefs, and discovery no later than December 18, so that Samsung can have a meaningful
15 opportunity to use them for its claim construction briefing.

16 2. Apple's Mac OS 10.0 Source Code is Relevant to Invalidity, Inequitable
17 Conduct, and Claim Construction for the 891 Patent

18 [REDACTED]
19 [REDACTED]. (Hutnyan Decl. ¶ 7; Ex. 1 at 7:17-9:17; 25:7-41:16.) Samsung's subsequent
20 investigation revealed that in fact, Mac OS 10.0 appears to disclose each and every limitation of
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22 ⁴ For example: —REQUEST FOR PRODUCTION NO. 302: All court files from the Related
23 Foreign Proceedings, including pleadings, motions, statements, and Your responses to discovery
24 requests. REQUEST FOR PRODUCTION NO. 303: All Documents that Samsung has produced
25 in the Related Foreign Proceedings.”

26 ⁵ Samsung has notified Apple that at least the following documents are still missing: John
27 Elias' witness statement, testimony and cross-examination; Jeffrey Brown's witness statement,
28 testimony and cross examination; Martin Simmons' witness statement; and Staff's pre-hearing
hearing brief in the 750 Investigation. (Hutnyan Decl. ¶ 4.) Furthermore, Apple produced only a
redacted copy of significant amounts of testimony from that investigation. (*Id.*) The redactions
demonstrate that the redacted testimony is Apple, and not Motorola confidential information. (*Id.*)

1 the asserted claims of the 891 patent. The 891 patent claims a transparent window that closes in
2 response to a timer, as does Mac OS 10.0:



23 Because Mac OS 10.0 was released on March 24, 2001, it is prior art to the 891 patent.
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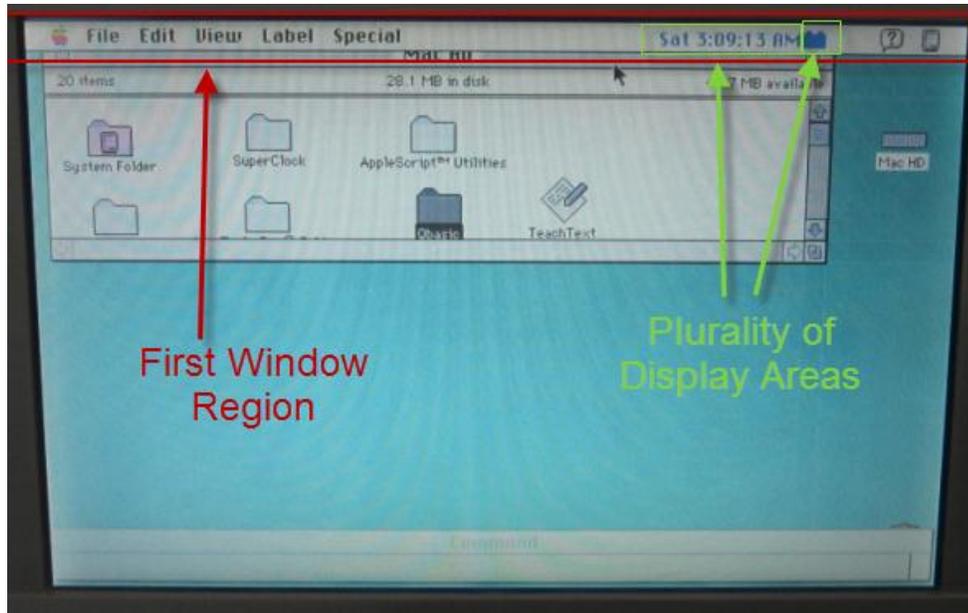
1 Besides being relevant to Samsung's invalidity and inequitable conduct defenses, the
2 source code for Mac OS 10.0⁶ is relevant to claim construction. Mac OS 10.0 was developed by
3 the inventor of the 891 patent, and the source code is therefore relevant to conception and
4 reduction to practice. If the source code is not prior art, as Apple contends, a comparison of the
5 disputed claim terms to this source code will be relevant to demonstrate why Apple's proposed
6 claim constructions are litigation-induced as opposed to firmly rooted in the relevant intrinsic and
7 extrinsic evidence.

8 Because Mac OS 10.0 is Apple source code, Samsung has no other way to obtain access to
9 it. (Hutnyan Decl. ¶¶ 5-6.) Despite the fact that this source code is solely in Apple's possession,
10 custody, and control and readily identifiable within Apple, and claim construction briefing is
11 already in progress, Apple will not produce the source code by any date certain. (Hutnyan Decl. ¶
12 6.) At least 8 weeks have passed since Samsung discovered this prior art and Apple will only
13 represent that it will let Samsung know the status of its search on December 15. (*Id.*) So that it
14 will be available for rebuttal claim construction briefing, Samsung asks the Court to compel
15 production of the Mac OS 10.0 working copy and source code by December 18.

16 3. The SuperClock Source Code is Relevant to Invalidity, Inequitable
17 Conduct, and Claim Construction for 002 Patent

18 [REDACTED]
19 [REDACTED] (Hutnyan Decl. ¶ 8;
20 Ex. 1 at 161:18-184:5.) [REDACTED]
21 [REDACTED] (Hutnyan Decl. Ex. 1 at 164:24-165:13), Samsung's
22 subsequent investigation determined that SuperClock displays both a clock and a battery meter on
23 a status bar, which precisely matches Apple's interpretation of the 002 patent:
24
25

26 ⁶ In addition to the source code, Samsung also requests an order requiring Apple to produce a
27 working copy of Mac OS 10.0 source code on a computer, so that Apple cannot refute the
28 authenticity and admissibility of the source code at trial.



SuperClock was an incredibly popular program that was distributed to millions of people.

(*Id.* at 168:15-21.)

(*Id.* at 169:13-22, 191:17-

20.) SuperClock was available years before the issuance of the 002 patent, and both Mr. Christensen and Apple were well aware of this product. Like the Mac OS 10.0 source code, SuperClock is relevant to invalidity, inequitable conduct, and claim construction.

(*Id.* at 181:16-20, 182:17-183:1.) Samsung has no other way to obtain the source code, other than from Apple.

(*Id.* at 183:8-184:5), Apple has continued to refuse to provide a date certain, or even an estimated date, when it would produce the source code. (Hutnyan Decl. ¶ 6.) So that it will be available for rebuttal claim construction briefing, Samsung asks the Court to compel production of the SuperClock source code by December 18.

1 B. The Court Should Compel Apple to Produce Documents and Things Related to
2 Apple's Design Patents.

3 The design patent items Samsung seeks through this motion are limited, narrow categories
4 of documents that bear directly on the validity of the D'889 patent and other asserted patents, and
5 are central to Samsung's defense. (Hutnyan Decl. ¶¶ 9-20.) Samsung requested most of these
6 items weeks ago so that it could use them with Apple's witnesses and to conduct follow-on
7 discovery where necessary. (Hutnyan Decl. ¶¶ 17, 21, 26, 28, 30-31, 36.) Although Apple has
8 theoretically agreed to produce some subset of the materials requested, it has never agreed to
9 produce all the requested materials and has never committed to even an estimated time when these
10 items would be provided.⁷ (Hutnyan Decl. ¶¶ 18, 29, 33, 36.) Apple has further resisted
11 Samsung's requests to expedite search and production of these items on the basis that they are
12 merely "peripheral." (Hutnyan Decl. ¶ 21.) Samsung has no other way to obtain these vital
13 materials, which are internal to Apple. Having recently noticed nearly fifty new depositions of
14 Apple witnesses – and having attempted, unsuccessfully, for several weeks to obtain these
15 materials – Samsung can afford to wait no longer for these essential items.

16 1. Items Related to the Conception and Reduction to Practice of the D'889
17 Design Patent Are Essential to Samsung's Case and Should Be Produced

18 Apple's assertion that Samsung's products infringe the D'889 patent – the patent that
19 Apple claims is embodied in the iPad 2 – is at the core of this case. (Hutnyan Decl. Ex. 20.) Yet,
20 Apple refuses to produce to Samsung documents that are essential to probing the validity of the
21 D'889 patent, including photographs and documents relating to physical models on which the
22 patent is based, as well as materials related to the conception date and development of the D'889
23 patent. (Hutnyan Decl. ¶¶ 9-19.) Samsung simply cannot effectively litigate this case without
24 these documents, and Apple, having brought this action asserting infringement of the D'889
25 patent, should not be permitted to withhold these materials.

26 _____
27 ⁷ With the exception of the supplement to Interrogatory No. 1, which Apple has represented it
28 will complete by December 31, 2011. (Hutnyan Decl. ¶ 19).

1 (a) Memory Cards Containing Samsung's Photographs of Apple's
2 Tablet Mockups

3 To begin with, Samsung seeks the immediate return of three memory cards containing its
4 *own attorney work product* photographs of [REDACTED] and other Apple tablet models. On
5 October 20 and November 1, 2011, Samsung inspected various Apple tablet models, including [REDACTED]
6 [REDACTED] and other [REDACTED] and took photographs of these items. (Hutnyan
7 Decl. ¶ 9.) Over Samsung's objections at the time, Apple confiscated three memory cards from
8 Samsung containing the photographs taken during the inspection. (*Id.*)

9 Pursuant to this Court's December 2, 2011 Order (Dkt. 447), the photographs taken by
10 Samsung during its inspections of Apple's tablet mockups constitute attorney work product, which
11 Samsung is entitled to retain —without having to disclose any portion thereof" to Apple. The
12 return of these memory cards is also required by Federal Rule of Civil Procedure 26(b)(5)(B),
13 which states that when a party notifies another party that certain information is subject to a claim
14 of privilege or protection as trial-preparation material, the party that received the information
15 —must promptly return, sequester, or destroy the specified information and any copies it has."'
16 Apple's conduct in withholding Samsung's own work product is inexcusable, and the Court
17 should order Apple to immediately return the three memory cards containing the photographs
18 taken by Samsung, as well as any and all copies of images created from those photographs.

19 Moreover, Apple has actually *used Samsung's work product* photographs to justify
20 withholding the three memory cards, and has improperly designated those photographs as —Highly
21 Confidential – Attorneys' Eyes Only," preventing Samsung from uses consistent with their public
22 nature. (Hutnyan Decl. ¶¶ 10-12; Ex. 3.) [REDACTED]

23 [REDACTED]
24 [REDACTED] (Hutnyan Decl. ¶ 11; Exhs. 5, 18 (November 28, 2011 Stipulation of
25 Michael Jacobs; November 4, 2011 Deposition of Christopher Stringer, Tr. 95:5-21).) The design,
26 appearance and existence of [REDACTED] is public knowledge, and Apple has no legitimate
27 basis for claiming a highly confidential designation with respect to these or any of Samsung's
28 photographs of [REDACTED] Indeed, in meeting and conferring on this issue, Apple has had a hard

1 time even articulating a rationale for its actions, weakly [REDACTED]

2 [REDACTED]

3 [REDACTED].⁸ (Hutnyan Decl. ¶ 12.)

4 Enough is enough. Samsung requests an order requiring the immediate return of
5 Samsung’s memory cards and the immediate de-designation of the photographs of [REDACTED]
6 [REDACTED] taken by Samsung designated as “Highly Confidential – Attorneys’ Eyes Only.”

7 (b) Production of [REDACTED] Photos Attached to Olson Declaration

8 Pursuant to the Court’s November 16, 2011 Order (Dkt. 398), Apple was required to
9 stipulate that it had *produced* the highest quality photos of [REDACTED] that it had found. It so
10 stipulated, but revealed in subsequent correspondence that it had not actually produced those
11 photographs to Samsung. (Hutnyan Decl. ¶¶ 14, 16; Ex. 5.) Instead, it has pointed to the Olson
12 declaration, to which it attached the photographs from the Patent Office’s files as Exhibit 8.
13 (Hutnyan Decl. ¶ 14.)

14 Apple concedes that it sent those photographs to the Patent Office and that those
15 photographs are public. (*Id.*) But Apple filed the Olson Declaration under seal, again to prevent
16 Samsung’s unfettered use of [REDACTED] photographs, and has refused to “produce” the photographs
17 directly because, having sent these items to the Patent Office, it will not be able to control the use
18 of those photographs through improper confidentiality designations. (Hutnyan Decl. ¶¶ 14, 16.)
19 Again, enough is enough. Apple should be ordered, again, to produce these photographs to
20 Samsung and to immediately de-designate these photographs as “Highly Confidential – Attorneys’
21 Eyes Only.”

22 (c) High-Quality Photographs of [REDACTED]

23 _____

24 ⁸ [REDACTED]
25 [REDACTED]
26 [REDACTED]
27 [REDACTED]
28 [REDACTED]

1 The grainy, black and white photographs Apple attached to the Olson declaration are very
2 likely not the best available in Apple's possession, custody or control. Pursuant to the Court's
3 November 16, 2011 Order, [REDACTED]

4 [REDACTED]
5 [REDACTED]
6 (Hutnyan Decl. Ex. 5) [REDACTED]
7 [REDACTED]
8 [REDACTED] (Hutnyan Decl. ¶ 15; Ex. 6.) [REDACTED]
9 [REDACTED]
10 [REDACTED] (*Id.*)

11 Apple has been noncommittal about running any supplemental searches, much less within a
12 reasonable timeframe. (Hutnyan Decl. ¶ 16.)

13 Apple should not be permitted to discharge its discovery obligations as to such an essential
14 piece of evidence through inadequate searches and evasive responses regarding the details of those
15 searches. Because Apple submitted the photos of [REDACTED] to the U.S. Patent and
16 Trademark Office in connection with the D'889 patent application, it must have been in
17 possession of, or had access to, the original photographs. Apple should be ordered to conduct the
18 supplemental searches requested by Samsung, and to produce the results by December 23.

19 (d) CAD Drawings, Model Shop Orders and Other Records

20 Apple has dragged its feet every step of the way with regard to materials related to [REDACTED]
21 [REDACTED]. In fact, Apple was only able to "find" [REDACTED] after Samsung filed a motion to
22 compel on the issue.⁹ Since November 8, Samsung has been requesting CAD drawings, model
23 shop records and other materials related to [REDACTED]. (Hutnyan Decl. ¶ 17; Ex. 7.)

24
25 _____
26 ⁹ [REDACTED]
27 [REDACTED]
28 [REDACTED]

1 These materials related to [REDACTED] go to the core of Samsung’s defense to Apple’s
2 design patent claims. Apple has admitted that [REDACTED] is the mockup depicted in
3 photographs submitted to the U.S. Patent and Trademark Office in connection with the D’889
4 patent application. (Hutnyan Decl. Exhs. 5, 18 (11/28 Jacobs Stipulation; Stringer Depo Tr. 95:5-
5 21).) Work orders, model shop records and other materials are directly relevant to the timing of
6 [REDACTED] creation, which is relevant to the date of conception and reduction to practice of
7 the D’889 patent. Moreover, all documents and things related to this mockup, including CAD
8 drawings, photographs, model shop orders and other records, are of the highest importance to
9 claim construction and to determining the scope of Apple’s invention, as well as to the scope of
10 protection in the asserted D’889 patent. *See Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665,
11 679 (Fed. Cir. 2008) (“[T]his court has held that trial courts have a duty to conduct claim
12 construction in design patent cases as in utility patent cases.”).

13 Additionally, Apple contends in this case that the iPad 2 is a commercial embodiment of
14 the D’889 patent. (Hutnyan Decl. Ex. 20.) Although Apple claims that the iPad 2 has a “flat clear
15 surface covering the front of the product” (Dkt. No. 75 (Apple’s Am. Compl.)), [REDACTED]
16 [REDACTED]
17 [REDACTED]
18 [REDACTED] (Hutnyan Decl. Exhs. 18, 19 (November 4, 2011 Deposition of Christopher
19 Stringer, Tr. 93:9-21; November 8, 2011 Deposition of Douglas Satzger, Tr. 66:16-67:8.)) It is
20 therefore critical that Apple produce all documents and things pertaining to this mockup without
21 further delay, so that [REDACTED] can be further compared to the iPad 2 and so that witnesses
22 in the upcoming depositions noticed by Samsung can be adequately questioned about [REDACTED]
23 [REDACTED] and about documents relating to it.

24 All materials related to [REDACTED] are in Apple’s possession, and Samsung has no
25 other way to obtain further information regarding this important piece of evidence. This is a very
26 reasonable request for limited and very pertinent materials related to a specific item, and there is
27 no reason for Apple not to have produced them long ago. Apple should be compelled to produce
28 all documents and things related to [REDACTED] without further delay.

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(e) [REDACTED]

Again, this is targeted information that is solely within Apple’s knowledge and is easy to produce. Samsung needs it now, so that it can ensure that Apple performs sufficient searches of inventor documents, and so that witnesses in the upcoming depositions can be adequately questioned regarding such documents and the conception of the D’889 patent, the relevant prior art, and other issues central to this case. Apple must be able to search for, review and produce the documents to Samsung with enough time for Samsung to review these documents for use in the upcoming depositions. Apple should therefore be compelled to provide Samsung with the conception date of the D’889 patent immediately and to conduct new searches of the design inventor documents for at least a year prior to that date. For the same reasons, Apple should also be required to provide a complete response to the balance of the interrogatory by December 23, setting forth the *precise* dates of conception for the Apple patents-in-suit, as well as the precise dates of actual or constructive reduction to practice and the steps constituting diligence from conception to actual or constructive reduction to practice.

2. Other Requested Items Related To The Validity of Apple’s Design Patents Are Essential to Samsung’s Case and Should Be Produced Without Further Delay

1 Apple has also refused to produce to Samsung specific materials Samsung has requested
2 that are prior art for the design patents, as well as evidence of functionality that go directly to the
3 validity of the design patents at issue. Samsung needs these documents now.

4 (a) Apple's Design Inventor Sketchbooks

5 On September 13, this Court ordered Apple to produce all relevant inventor sketchbooks
6 relating to certain of Samsung's design patents. (Order of September 13, 2011 (Dkt. 233).)

7 [REDACTED]
8 [REDACTED] (Hutnyan Decl. Ex. 15 (October 20, 2011 Deposition of Peter Russell-
9 Clarke, Tr. 61:6-62:6).) Samsung therefore requests that this Court enforce its prior order by
10 compelling Apple to produce more fulsome copies of Apple's design inventor sketchbooks
11 without further delay.

12 Apple's design inventor sketchbooks – which contain the inventors' original drawings and
13 notes relating to the conception, design and development of the relevant Apple products – are
14 obviously central to the issues in this action, including anticipation, obviousness and functionality
15 of Apple's asserted design patents. Indeed, Apple just moved for production of sketchbooks in its
16 own motion, noting that they are directly relevant to infringement, functionality and obviousness
17 issues and admitting the importance of receiving them in order to review and analyze them in a
18 timely manner for use in upcoming depositions. (See Apple's Motion to Compel (Dkt. 467-1).)
19 Samsung needs Apple's design inventor sketchbooks for the very same reason and has agreed to
20 produce its own within a few weeks. Apple should be compelled to do the same. [REDACTED]

21 [REDACTED]
22 [REDACTED] (Hutnyan Decl. Exhs. 15, 17 (Russell-Clarke Depo, Tr.
23 51:13-52:16; October 24 Deposition of Matthew Rohrbach, Tr. 36:24-37:10).)

24 Apple does not dispute the relevance of the sketchbooks, nor has it asserted that the burden
25 of production is too great. Rather, Apple has stated that it plans to improperly redact or withhold
26 portions of inventor sketchbooks containing otherwise relevant material where it deems certain
27 drawings or portions to be irrelevant. (Hutnyan Decl. ¶ 36.) Although Samsung agrees that
28 information on future products may be redacted, the rest of these sketchbooks likely are relevant

1 and should be produced in their entirety. Apple has claimed that it will redact only drawings of
2 devices, such as laptop computers, that are not at issue in this case, but it is difficult – if not
3 impossible – to distinguish between drawings of ~~“relevant”~~ and ~~“irrelevant”~~ products, because
4 Samsung is entitled to sketchbook drawings regarding alternate designs for what eventually
5 became the iPhone, iPod Touch or iPad products. [REDACTED]

6 [REDACTED]
7 [REDACTED]
8 [REDACTED]
9 [REDACTED]
10 [REDACTED]
11 [REDACTED]
12 [REDACTED]

13 [REDACTED] The parties’ protective order is more
14 than enough to protect the information Apple seeks to improperly redact, and Apple should be
15 required to produce complete versions of its design inventor sketchbooks, redacted only for future
16 products, as Samsung has committed to do.

17 (b) Phone Prior Art and Evidence

18 [REDACTED]
19 [REDACTED]
20 [REDACTED] (Hutnyan Decl. ¶ 29.) Apple has
21 essentially acknowledged its refusal to make a good faith effort to locate these items, stating that
22 these are ~~“peripheral”~~ issues, and indicating that these issues are therefore not important enough
23 for Apple to track down. (Hutnyan Decl. ¶ 21.) Apple’s responses in this regard are inappropriate
24 and incorrect. These materials are directly relevant to the development of the iPhone and are
25 crucial to the claims and defenses in this action.

26 (i) [REDACTED]
27 [REDACTED]
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1 Far from being a “peripheral” issue, [REDACTED]
2 [REDACTED]
3 [REDACTED] Hutnyan Decl. Exhs. 8, 10, 16 (APLNDC-NCC00000267-
4 273; October 27, 2011 Deposition of Eugene Whang, Tr. 88:10-89:6; October 31, 2011 Deposition
5 of Richard Howarth, Tr. 18:18-21:18.) All information, documents, drawings and models based
6 on or [REDACTED] thus go directly to the validity of the D'677 and D'087
7 patents, which Apple has stated are embodied in the various versions of the iPhone. (Hutnyan
8 Decl. Ex. 20 (Apple’s Second Am. Obj. & Resp. to Samsung’s Preliminary Injunction
9 Interrogatory No. 7).) Information showing that Apple used or incorporated [REDACTED]
10 [REDACTED] or any other prior art is central to Samsung’s case. *See Int’l Seaway Trading Corp. v.*
11 *Walgreens Corp.*, 589 F.3d 1233, 1239-40 (Fed. Cir. 2009) (noting the “ordinary observer”
12 standard for determining infringement and invalidity in design patents requires comparison of
13 designs in the context of prior art); *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372,
14 1380-81 (Fed. Cir. 2009) (same). Apple must be compelled to produce any further materials on
15 this subject by December 23 so that Samsung can review them and question witnesses about this
16 issue in upcoming depositions.

17 (ii) [REDACTED]
18 [REDACTED]
19 [REDACTED]
20 [REDACTED] (Hutnyan Decl.
21 Ex. 9 (APLNDC0000036646, 36657, 36892, 37167, 37177).) Again, these documents bear
22 directly on the design and development of the patents Apple has asserted against Samsung, and are
23 vital to Samsung’s case. Moreover, as with materials related to [REDACTED], the
24 documents Samsung seeks are a discrete, limited set of documents that are not burdensome for
25 Apple to identify and produce, and Apple has not suggested that it would be burdensome for it to
26 produce these documents. Rather, Apple appears to have avoided any searches for them due to
27 Apple’s opinion that this is a “peripheral” and unimportant issue. (Hutnyan Decl. ¶ 21.) To date,
28

1 Apple has refused to explain what it has done to search for these documents (Hutnyan Decl. ¶ 29),
2 and Apple should be compelled to produce these materials by December 23.

3 (iii) [REDACTED]

4 [REDACTED]
5 [REDACTED]
6 [REDACTED]
7 [REDACTED]
8 [REDACTED]
9 [REDACTED]
10 [REDACTED]
11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED]
17 [REDACTED]

18 [REDACTED] which would render the design invalid. *See Lee v.*
19 *Dayton-Hudson Corp.*, 838 F.2d 1186, 1188 (Fed. Cir. 1988) (“If the patented design is primarily
20 functional rather than ornamental, the patent is invalid.”). Nothing could be more central to the
21 issues in this case than these materials, and Apple should be compelled to produce them by
22 December 23.

23 (c) Tablet Prior Art

24 (i) Materials Related to the 1989 Flat Panel Display

25 Samsung has also requested, since November 1, that Apple produce or make available for
26 production all documents and things, including all models and prototypes, related to the 1989 Flat
27
28

1 Panel Display associated with the “Brain Box” designed in 1989 by Apple designers.¹⁰ (Hutnyan
2 Decl. ¶ 30.) Again, Apple claims that the D’889 patent, as embodied, has a “flat clear surface
3 covering the front of the product”. (Dkt. No. 75 (Apple’s Am. Compl.)) Apple’s 1989 flat panel
4 display therefore constitutes potential prior art relating to the D’889 patent and other asserted
5 patents, are central to the validity of those patents, and are therefore essential to Samsung’s case.
6 *See Int’l Seaway*, 589 at 1240. Moreover, unlike Apple’s sweeping and unspecific demands of
7 Samsung, this is a narrow, specific request related to a single item of prior art, which should not be
8 burdensome for Apple to locate or produce. Yet, to date, Apple has refused to provide any
9 materials responsive to this request or any details regarding what it has done to search for
10 materials related to the 1989 Flat Panel Display. (Hutnyan Decl. ¶¶ 33-34). Because the Flat
11 Panel Display is important prior art, and because Samsung needs to be able to adequately question
12 witnesses in the upcoming depositions regarding this prior art, Apple should be compelled to
13 produce these materials by December 23.

14 (ii) Materials Related to the Apple Cinema Display

15 Samsung has also requested that Apple produce all documents related to the Apple Cinema
16 Display, a line of flat panel computer monitors introduced into the market by Apple in 1999, as
17 well as any related models or prototypes. (Hutnyan Decl. ¶ 31.) As with the 1989 Flat Panel
18 Display, the Apple Cinema Display is critical prior art for the D’889 patent and other asserted
19 patents and is central to the validity of Apple’s asserted patents. Apple recently stated that it
20 would provide Samsung with CAD drawings of the Apple Cinema Display but none of the related
21 materials. (Hutnyan Decl. ¶ 33.) When pressed as to why Apple would not provide other
22 materials, Apple refused to give Samsung an explanation, instead asking Samsung why it believed
23 the materials were relevant. (*Id.*) Apple has not stated that it possesses no other materials relating
24 to the Apple Cinema Display aside from CAD drawings, nor has it provided any details regarding
25 the searches it has performed to locate other materials. (*Id.*) The burden to Apple of producing

26
27 ¹⁰ A photograph of Apple’s 1989 Flat Panel Display is attached hereto as Exhibit 14 to the
28 Hutnyan Declaration.

1 materials related to this single item is minimal, but these materials are essential to Samsung so that
2 they can be reviewed and used in adequately questioning witnesses in upcoming depositions.
3 Apple should be compelled to produce the CAD drawings related to the Apple Cinema Display, as
4 well as any other documents and things it has located by December 23, and provide a detailed
5 explanation of its searches so that Samsung can assess the adequacy of those searches.

6 C. Transcripts of Prior Deposition Testimony of Apple Employees

7 Samsung's First Set of Requests for Production, served on August 3, 2011, included
8 requests for documents related to any lawsuit, litigation, or legal proceeding involving Apple's
9 relevant products and patents, including deposition transcripts and prior testimony of Apple's
10 employees. *See* Samsung's Requests for Production Nos. 75, 95, 184, and 187. Samsung
11 subsequently narrowed the scope of this request to only those transcripts from cases in which
12 Apple's employees testified their capacity as such. (Hutnyan Decl. ¶ 43.) Although Apple has
13 produced certain deposition transcripts of inventors of the patents-in-suit from previous cases in
14 which those patents were asserted, as well as a few additional transcripts, Apple has refused to
15 produce the balance of Samsung's request. (*Id.*)

16 The remaining transcripts from Apple's witnesses that Samsung seeks are few in number
17 and highly relevant to this case. Samsung has requested only the prior testimony of witnesses
18 from cases in which they testified in their capacity as Apple employees, because those transcripts
19 would almost of necessity relate to the same or similar technologies at issue in this case.
20 Whatever inventions they invented or whatever products and features they worked on, certainly
21 have a "technological nexus" to the inventions, products and features at issue in the instant action.

22 For example, in *Inventio AG v. Thyssenkrup Elevator Am. Corp.*, 662 F. Supp.2d 375 (D.
23 Del. 2009), the court ordered the plaintiff to produce transcripts of testimony from a prior
24 proceeding that involved "tangentially related" technology. *See id.* at 381-83. The court held that
25 this testimony—including the testimony of non-inventors—was relevant and discoverable because
26 the witnesses possessed certain critical knowledge of issues involved in the litigation. *Id.* at 383.
27 For the transcripts that the court held were not discoverable, the court reasoned that "the requested
28 information [was] not related to claims or defenses," and "most importantly, Defendants [did]

1 not intend to call any of these individuals to testify in the current proceeding.” *Id.* at 384
2 (emphasis added).¹¹

3 Apple agrees that Samsung is entitled to the transcripts of Apple witnesses who testified on
4 topics that bear a “technological nexus” to the issues in this litigation. *See generally id.* But Apple
5 has debated the meaning of that term and proposed to produce in accordance with very narrow or
6 vague interpretations of that phrase, rather than something both parties can discuss concretely.
7 (Hutnyan Decl. ¶ 43.)

8 To address Apple’s concerns about production of transcripts taken in a witness’ capacity as
9 an Apple employee that might be entirely irrelevant, Samsung proposed a compromise whereby
10 both parties would exchange lists of cases in which their employees testified, and explain why
11 certain transcripts from certain cases were irrelevant. (*Id.*) This compromise would not only
12 increase transparency, but would also obviate the need to engage in a drawn-out exercise to reach
13 a mutually agreeable definition of “technological nexus.” Apple has flatly dismissed Samsung’s
14 proposal, instead insisting on defining the term “technological nexus” and applying it unilaterally
15 to determine which transcripts to produce. (*Id.*) Meanwhile, Apple has propounded numerous
16 requests to Samsung seeking broad production of its witnesses’ prior deposition transcripts.¹²

17 Apple should not be permitted to determine on its own which transcripts it needs to
18 produce. Apple’s vague definitions are antithetical to the Court’s efforts to promote discovery
19 transparency, and inevitably lead to wasteful, time-consuming disputes in the future. The Court
20 should compel Apple to produce all transcripts of prior Apple witness testimony in which the

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22 ¹¹ Further, Samsung is entitled to these transcripts to assess the credibility of the witnesses
23 testifying in this case. *See* 9th Circuit Model Civil Jury Instruction No. 2.8 (evidence that a
24 witness lied under oath on a prior occasion may be considered, along with all other evidence, in
25 deciding whether or not to believe the witness and how much weight to give to the testimony of
the witness.).

26 ¹² *See, e.g.,* Apple RFP No. 296 (seeking all trial or deposition transcripts of each witness
27 identified in Samsung’s initial disclosures or each person responsible for the design, development
28 or marketing of the Products at Issue, without limiting the subject matter of the prior testimony);
RFP No. 304 (seeking all transcripts from related foreign proceedings without any limitation as to
the identity of the witness).

1 witness testified in his or her capacity as an Apple employee, or alternatively, to exchange lists
2 with Samsung describing the actions in which its witnesses have testified, so that the parties can
3 work together to determine which transcripts should be produced.

4 **V. CONCLUSION**

5 For the foregoing reasons, the Court should GRANT Samsung's Motion to Compel. In
6 particular, the Court should compel Apple to produce:

7 (1) documents and thing related to Apple's asserted utility patents, including all
8 pleadings, discovery, transcripts, statements and briefs relating to the _002 patent, the _607 patent,
9 and the _828 patent in two actions where Apple asserted these patents against Motorola; source
10 code, and a working copy of Mac OS 10.0, prior art to the _891 patent; and source code for
11 SuperClock, prior art to the _002 patent;

12 (2) documents and things related to Apple's asserted design patents, including memory
13 cards containing photographs of Apple's tablet mockups; documents and things pertaining to
14 Apple's ██████████, including CAD drawings, model shop orders and records and other
15 materials; de-designated copies of photographs ██████████; a supplemental response to
16 Samsung's Interrogatory No. 1; fulsome copies of Apple's design inventor sketchbooks
17 (excluding future products); documents and things related to Apple's ██████████
18 ██████████
19 ██████████ in connection with the
20 development of the iPhone; and documents, models, and prototypes relating to Apple's 1989 flat
21 panel display and the Apple Cinema Display; and

22 (3) transcripts of prior testimony of Apple witnesses where they testified in their
23 capacity as Apple employees.

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DATED: December 12, 2011

Respectfully submitted,

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