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 11 Attorneys for Plaintiff and
 Counterclaim-Defendant APPLE INC.

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

17 APPLE INC., a California corporation,
 18 Plaintiff,

19 v.

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

23 Defendants.
 24

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

**APPLE'S OPPOSITION TO
 SAMSUNG'S MOTION TO COMPEL**

Date: December 16, 2011
 Time: 10:00 a.m.
 Place: Courtroom 5, 4th Floor
 Judge: Hon. Paul S. Grewal

25 PUBLIC REDACTED VERSION
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35 U.S.C. § 102 12

RULES

Fed R. Civ. P.

26(b) 18

26(b)(2)..... 11

26(b)(2)(C) 21

26(b)(5)(B) 17

1 noticed before and shortly after Thanksgiving. (*Id.*) (Samsung offered a date for its first witness
2 just last night. (*Id.*))

3 Despite the imbalance between the parties' respective productions for Apple's offensive
4 case, Apple has actively continued to collect, process, review, and produce documents for its
5 rolling production. And even though Samsung has deposed literally dozens of Apple witnesses
6 but declined to make its witnesses available for deposition, Apple has dutifully chased down
7 Samsung's various "follow-on" requests from the depositions of its inventors and prosecutors.
8 Apple has also aggressively pursued Samsung's newly raised requests for documents, such as its
9 November 2011 requests for various items of alleged prior art.

10 Samsung's sudden imposition of deadlines in its motion to compel is the first time
11 Samsung ever requested production by a specific date. (Mazza Decl. ¶ 4.) As recently as the
12 parties' December 7, 2011, meet-and-confer call, Samsung specifically declined to set any
13 production deadlines. (*Id.*) Samsung instead stated that it was sufficient that Apple was working
14 diligently to search for and produce the requested information. (*Id.*)

15 In view of Apple's diligence in responding to Samsung's miscellaneous "to-do" list,
16 Samsung needed to manufacture deadlines for its motion or it would have little to say. To be
17 clear, unlike Apple's motion, Samsung's motion does not seek core documents that it needs
18 urgently to advance its defenses. Many of the requested items are 10 to 20 years old and have
19 been difficult to track down.

20 **II. APPLE HAS ALREADY PRODUCED OR AGREED TO PRODUCE MOST OF**
21 **THE ITEMS SAMSUNG'S MOTION DEMANDS.**

22 In addition to the million pages of documents, and the models, prototypes, source code,
23 CAD files, and Director files that Apple has already produced, Apple has either produced or has
24 committed to producing most of the information Samsung seeks in its motion to compel.

25 **A. Apple Has Already Produced Several of the Items Samsung Seeks**

26 Several of the categories of documents Samsung requests in its motion to compel have
27 already been produced, underscoring the hastiness of Samsung's motion. For example, Samsung
28 seeks the production of pleadings, briefs, discovery, and transcripts from *Apple v. Motorola*

1 has already met all of Samsung's demands in this first category, to the extent possible within the
2 limits of the ITC protective order governing the *Motorola* investigation.

3 [REDACTED]
4 [REDACTED]
5 [REDACTED]
6 [REDACTED] Apple produced the
7 photographs— *without* any confidentiality designation— last week, before Samsung filed its
8 motion. (Mazza Decl. ¶ 5.)

9 **B. Apple Will Have Substantially Completed Its Production of Several Other**
10 **Items by December 15, 2011**

11 As of the date of the hearing, Apple will have already produced at Morrison & Foerster's
12 Palo Alto office the following items for Samsung's inspection:

- 13 • An Apple computer specially configured and adapted to run the 10 year old Mac
14 OS 10.0 operating system.
- 15 • Portions of the Mac Operating System 10.0 and 10.1 source code believed to relate
16 to the functions described in Samsung's motion.
- 17 • Portions of the Mac Operating System 7.5—more than 15 years old—source code
18 believed to correspond to the [REDACTED]
19 [REDACTED]

20 (Mazza Decl. ¶ 9.) Apple informed Samsung no later than the parties' December 7, 2011 meet-
21 and-confer call that it planned to make this production by December 15th, (*id.* ¶ 8), but Samsung
22 moved to compel on these issues anyway.

23 **C. Apple Has Agreed to Produce Most of the Other Items As Quickly As**
24 **Possible and Has Been Diligently Working to Locate and Produce Them**

25 Apple has also been working on producing a large number of other items on Samsung's
26 list as quickly as possible. None of these items relate to the upcoming *Markman* proceedings.
27 And confirming the retaliatory nature of Samsung's motion, Samsung never suggested a deadline
28

1 of December 23rd before filing its motion. (Mazza Decl. ¶ 4.) Apple’s attorneys have been
2 diligently meeting and following up with the Industrial Design team about these items. (*Id.* ¶ 10.)

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19 [REDACTED]

20 **3. Apple Cinema Display**

21 Samsung has asked that the Court order Apple to produce all documents relating to a line
22 of desktop monitors called the Apple Cinema Display, alleging that this display is prior art.
23 (Samsung Mot. at 19.) This is unnecessary, as Apple has agreed and already explained to
24 Samsung that it will produce the CAD files showing the final design of the Apple Cinema
25 Display. (Mazza Decl. ¶ 14.)

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27 [REDACTED]
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[REDACTED]

7. Other Requests

Apple has already agreed to search the documents of relevant witnesses to locate any additional documents relating to [REDACTED] [REDACTED] (Mazza Decl. ¶ 19.) Apple has also already agreed to supplement its responses to Interrogatory No. 1. (*Id.* ¶ 20; Mot. at 18.) While Samsung had previously declined to place any specific deadlines on these requests, Apple intends to do both of these things before December 23—the date requested in Samsung’s proposed order.

1 **III. SAMSUNG’S DEMANDS FOR “ALL” RELATED DOCUMENTS ARE**
2 **OVERBROAD AND UNDULY BURDENSOME.**

3 Under Civil Local Rule 37-2, a party moving to compel production “must detail the basis
4 for the party’s contention that it is entitled to the requested discovery and must show how the
5 proportionality and other requirements of Fed. R. Civ. P. 26(b)(2) are satisfied.” Apple has
6 produced, and has agreed to produce, the substantial categories of documents listed above.
7 Samsung has not, however, met its burden under Local Rule 37-2 with respect to additional
8 documents, materials, and other information “related” to the items Apple has agreed to produce.

9 **A. “All Documents Related” to Alleged Prior Art For Design Patents**

10 Apple has agreed to produce final CAD files for each item of purported prior art sought by
11 Samsung in its motion. (Mazza Decl. ¶ 21.) The parties have not specifically discussed any
12 additional items that Samsung believes it has good reason to request of Apple regarding that
13 alleged prior art. (*Id.*) The fleeting, vague references in Samsung’s motion to “all documents
14 related” to prior art do not meet Local Rule 37-2’s requirements.

15 **“All documents related to the Apple Cinema Display.”**

16 Apple denies Samsung’s claim that Apple’s 1999 “Cinema Display” computer monitor is
17 prior art for the D’889 or any other design patent at issue in this case. Nevertheless, as discussed
18 in Section II, Apple has agreed to produce final CAD files for that line of computer monitors.

19 Samsung’s motion states that Samsung “has also requested that Apple produce all
20 documents related to the Apple Cinema Display, . . . as well as any related models or prototypes.”
21 (Samsung Mot. at 19.) Samsung first made this request in a letter dated November 8, 2011,
22 asking Apple to produce “*all documents related to Apple Cinema Display, including but not*
23 *limited to notebooks, diagrams, progress reports, studies, internal memoranda, contracts for*
24 *services, and communications created or used in connection with the design of Apple Cinema*
25 *Display, as well as any related models or prototypes.”* (Mazza Decl. ¶ 22.)

26 Apple responded on November 10, 2011, asserting its disagreement that the Apple
27 Cinema Display monitor is prior art, and stating further that Samsung’s “request for ‘all
28 documents related to’ the monitor is overbroad and unduly burdensome given the alleged

1 relevance of the device.” (*Id.*) Samsung clarified in subsequent meet-and-confer
2 communications that it is only seeking information regarding the external appearance of the
3 monitor. (*Id.* ¶ 21.)

4 Apple has agreed to produce final CAD files for the Apple Cinema Display. (*Id.*)
5 Samsung’s motion to compel provides no basis for requiring Apple to provide anything more
6 regarding the Apple Cinema Display. To establish invalidity under 35 U.S.C. § 102 in the patent
7 design context, Samsung must show that an ordinary observer would find the overall appearance
8 of the prior art to be substantially identical to the overall appearance of the asserted design patent.
9 *See Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1243 (Fed. Cir. 2009). This
10 test is based solely on a visual comparison of the two designs. As a result, Samsung requires only
11 access to materials showing the three-dimensional design of the alleged prior art product—
12 information that the CAD files would readily supply. Samsung has not identified any additional
13 documents, let alone offered any reason why Apple should provide additional documents.

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IV. APPLE IS ENTITLED TO PROTECT THE CONFIDENTIALITY OF ITS UNRELEASED PRODUCTS.

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[REDACTED]

V. APPLE IS NOT REQUIRED TO PRODUCE HIGHLY SENSITIVE INFORMATION HAVING NOTHING TO DO WITH THIS CASE.

Under Fed R. Civ. P. 26(b), Apple is required to produce all relevant information. It is not required to produce irrelevant information.

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[REDACTED]

B. Apple’s Production of Prior Witness Testimony Is Properly Limited to Cases With a “Technological Nexus” to This Case.

Apple has not refused to produce deposition transcripts that are relevant to this case. (Mazza Decl. ¶ 34.) For the inventors of the patents in suit, it has already produced prior testimony that bears a technological nexus to the patents at issue in this case. (*Id.*) It is willing to produce similar transcripts for other deponents. (*Id.*) This “technological nexus” standard is based on the very cases Samsung cites in support of its motion. *See Inventio AG v. Thyssenkrupp Elevator Americas Corp.*, 662 F. Supp. 2d 375, 381 (D. Del. 2009). Samsung, however, wants a

1 much broader range of deposition transcripts—all transcripts of all depositions of all Apple
2 witnesses in all cases where the witness was testifying in his or her capacity as an Apple
3 employee. (See Mot. at 20; Proposed Order at 2.) Samsung’s request is unjustifiably overbroad.

4 As Samsung’s own authorities acknowledge, Samsung bears the burden of showing why
5 the information sought is relevant to the issues in this case. *Inventio* AG, 662 F. Supp. 2d at 381.
6 Without any explanation or support, Samsung claims that the transcripts it is seeking “almost of
7 necessity relate to the same or similar technologies at issue in this case.” (Samsung Mot. at 20.)
8 That assertion is simply untrue. Samsung’s demand for all deposition transcripts of Apple
9 employees, regardless of subject matter, encompasses a wide array of transcripts that have
10 nothing to do with the issues in this case. Apple is involved in consumer class actions,
11 employment cases, antitrust, and even personal-injury cases. (Mazza Decl. ¶ 34.) Even for patent
12 disputes, the patents at issue are often unrelated to the patents here. (*Id.*) Apple’s dispute with
13 Kodak, for example, involves digital imaging patents. (*Id.*) None of the transcripts from that
14 case are likely to be relevant to the issues in this case which does not involve digital imaging
15 technology.

16 Moreover, Samsung’s requested relief, which demands that Apple produce all prior
17 testimony of “Apple witnesses,” is broader than Samsung’s document requests. (See Prop. Order
18 at 2.) Samsung bases its motion on four requests for production: Nos. 75, 95, 184, and 187.
19 Requests Nos. 95 and 184 are both limited to transcripts of testimony given by Apple’s inventors,
20 not every Apple employee. Requests 75 and 187 both request documents related to Apple’s
21 intellectual property or products at issue, which generally fall within the scope of documents
22 Apple is willing to produce. In addition, despite Samsung’s current demand that Apple list and
23 describe all cases that it has ever participated in, Samsung has never served Apple with an
24 interrogatory request making this request.

25 As discussed above, Samsung has not provided an adequate basis for demanding these
26 documents from Apple. On the contrary, it has previously admitted during the parties’ meet and
27 confer sessions that the only basis for its broad request is that Apple’s employees might have said
28 something in a wholly unrelated case that might have some sort of impeachment value in the

1 present action. (Mazza Decl. ¶ 35.) That is the definition of a fishing expedition. Such discovery
2 is not allowed under the Federal Rules of Civil Procedure. Fed. R. Civ. P. 26(b)(2)(C)
3 (instructing the court to limit discovery if it determines that, among other things, “the discovery
4 sought is unreasonably cumulative or duplicative” or “the burden or expense of the proposed
5 discovery outweighs its likely benefit.”); *see also, Inventio AG v. Thyssenkrupp Elevator*
6 *Americas Corp.*, 662 F. Supp. 2d 375, 381 (D. Del. 2009) (noting that rule 26(b)(2)(C) imposes a
7 balancing test).

8 Finally, Samsung’s supposed “compromise”—whereby each party creates an “irrelevance
9 log” justifying why each irrelevant transcript is irrelevant—is not a compromise at all. Samsung
10 cites no precedent for this request or provides no good reason why these irrelevant depositions
11 transcripts (as opposed to, for example, sketchbooks) should be singled out for special treatment.
12 Apple has provided Samsung with its proposed definition of “technological nexus”:

13 Apple interprets “technological nexus” to include prior cases
14 involving the patents-in-suit or patents covering the same or similar
15 technologies, features, or designs as the patents-in-suit. For the
16 sake of clarity, with respect to design patent inventors, this would
17 include prior cases involving the asserted design patents or other
18 design patents covering the same designs or design elements. With
19 respect to utility patent inventors, this would include the asserted
20 utility patents or other utility patents covering touch-based interface
21 functions, display elements, touch-screen hardware, or touch-screen
22 logic.

23 This is a sufficiently clear standard for both parties to follow. Apple requests that the
24 Court reject Samsung’s overly-broad and unduly burdensome request for transcripts.

25 CONCLUSION

26 For these reasons, Apple respectfully requests that Samsung’s Motion to Compel be

27 DENIED.

28 Dated: December 15, 2011

MORRISON & FOERSTER LLP

By: /s/ Richard S.J. Hung
Richard S.J. Hung

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APPLE INC.