

1 Apple has failed to comply with earlier court orders relating to the return of work product and the
2 production of materials relating to certain Apple tablet mockups. Samsung alleges that Apple has
3 refused to search adequately or with specified search terms for Samsung's requested material, has
4 not contacted obvious potential witnesses to search, and has refused to negotiate a reasonable
5 solution to both parties' requests for litigation materials from other cases.

6 Apple responds generally that it already has produced or agreed to produce most of the
7 items being sought. Apple further argues that much of Samsung's motion is based on requests for
8 peripheral materials not central to its case, as well as dates conjured up suddenly by Samsung.
9 Apple has represented that it will keep Samsung informed of the status of its ongoing efforts to
10 respond. Samsung argues that this is insufficient. As of the hearing, Apple confirmed that it had
11 completed its production responsive to several items included in Samsung's motion.

12 The parties appeared for hearing on December 16, 2011. Having considered the arguments
13 and evidence presented by both sides, the court rules as follows.

14 1. Documents and things relating to Apple's asserted utility patents, specifically: (a)
15 documents from other actions involving three of the patents-at-issue, and (b) source code and
16 documents pertaining to earlier Apple inventions that Samsung seeks to offer as prior art to the
17 asserted utility patents. Samsung's requests relating to the alleged prior art include source code for
18 the Mac OS 10.0 software, and documents and source code for Apple's SuperClock program.
19 Based on the representations of the parties at hearing, the court understands that these requests
20 have largely been resolved.¹ The court therefore will deny as moot Samsung's motion with respect
21 to Apple's asserted utility patents.
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26 ¹ The remaining issue is whether Apple properly redacted from production certain information that
27 it had received from third parties in those actions. The parties have initiated a process whereby
28 Samsung will seek consent from those third parties for Apple to produce the unredacted
information. Should this process prove unsuccessful, Samsung is free to request court intervention
and properly brief the issue of disclosing confidential third-party documents.

1 2. Documents and things relating to Apple’s asserted design patents. Samsung’s design
2 patent-related requests comprise numerous topics that the court will address individually.

3 A. Memory cards containing Samsung’s photos of Apple’s tablet mockups.
4 Samsung argues that Apple has not returned memory cards containing photos taken during
5 Samsung’s inspection of Apple mockups and therefore is not in compliance with the court’s
6 December 2, 2011 order² and Fed. R. Civ. P. 26(b)(5)(B). Samsung also argues that Apple has
7 improperly designated the photos as “highly confidential,” even though similar photos were
8 disclosed to the United States Patent and Trademark Office during the patent application process.
9 Apple responds that what is styled as nothing more than a “clawback” of work product is actually
10 an attempt to disclose highly confidential photos of unreleased tablet designs, as opposed to photos
11 of the 035 tablet model that previously had been made public.

12 Consistent with its earlier ruling, the court finds that Apple must return the memory cards
13 containing Samsung’s work product. But as noted in the December 2 Order, the inspection of
14 proprietary systems as opposed to public prior art may be subject to the provisions of the parties’
15 interim protective order. Apple therefore may maintain its confidentiality designation on only those
16 photos that display details or aspects of the tablet mockups that were not disclosed in the earlier
17 patent filings and that remain proprietary to Apple.³

18 B. Documents and things relating to Apple’s 035 tablet mockup, including CAD
19 files, model shop orders and records, and copies of Apple’s original tablet photos as submitted to
20 the Patent and Trademark Office that have been de-designated from highly confidential. Based on

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24 ² See Docket No. 447 (Order re December 2, 2011 Discovery Dispute) (“December 2 Order”).

25 ³ The court emphasizes that the burden of establishing the proprietary nature of any of the photos at
26 issue is squarely on Apple. Having reviewed the photos of the 035 tablet mockup taken by
27 Samsung and currently designated by Apple as “highly confidential – attorneys’ eyes only” (*see*
28 Docket No. 487-1, Ex. 3) and Apple’s original photos (*see* Docket No. 475-8, Ex. 8), the court
notes the primary difference between the photos submitted seems to be in quality. But for a few of
Samsung’s photos taken close-up and at an angle (*see* APLNDC-X000005883 - APLNDC-
X000005887), no additional details appear to be revealed by the majority of Samsung’s photos.

1 Apple's representations and earlier stipulation that it has produced the highest-quality photos after
2 an extensive search, but nonetheless agrees to continue and expand its search to designer files and
3 emails between the patent prosecution counsel and Apple designers from fall 2004, the court finds
4 Apple's search, as expanded, to be sufficient. Apple shall produce the results, if any, of the
5 expanded search no later than December 31, 2011. Apple further shall remove the "highly
6 confidential – attorneys' eyes only" designation from the photos of the 035 tablet mockup that
7 were submitted to the Patent and Trademark Office and filed under seal with the court.⁴ Apple
8 similarly shall produce any CAD files connected to the 035 tablet no later than December 31, 2011.
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10 With respect to the model shop orders, the court accepts Apple's representations that no such
11 documents exist, and therefore will deny Samsung's motion with respect to those documents and
12 any unspecified references to "other materials" relating to the 035 tablet mockup.

13 C. Supplemental response to Interrogatory No. 1 providing a conception date for the
14 D'889 patent. As represented in its opposition papers, Apple shall supplement its response to
15 Interrogatory No. 1 no later than December 23, 2011.

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17 D. Copies of Apple's design inventor sketchbooks containing all pages and date
18 references, and redactions only to those sections or pages revealing future product designs. Apple
19 shall produce re-scanned inventor sketchbooks with all pages and date references intact on a rolling
20 basis and no later than December 31, 2011. In accordance with its earlier order that "Apple has
21 every right to review and withhold from production those sketches not at issue in the preliminary
22 injunction motion,"⁵ the court finds that Apple may redact from production sketchbook material
23 not at issue in this lawsuit, either because such material reveals future product designs or because it
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26 ⁴ See Docket No. 487-1, Ex. 5 (Stipulation Regarding Physical Model and Related Photographs);
27 Docket No. 475-8, Ex. 8.

28 ⁵ See Docket No. 233 (Sept. 13 Order Granting-In-Part and Denying-In -Part Samsung's Motion to
Compel).

1 is not relevant to the patents-in-issue, within the meaning of relevance provided by Fed. R. Civ. P.
2 26(b)(1).

3 E. Documents and things relating to Apple’s investigations into other smartphone
4 designs and languages. Apple shall complete its search for and production of these materials no
5 later than January 15, 2012.

6 F. Documents and things relating to earlier Apple flat panel and Apple Cinema
7 displays. Apple shall complete its reasonable search for and production of these materials no later
8 than January 15, 2012, including CAD drawings for the Apple Cinema display.

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10 3. Transcripts of Prior Deposition Testimony of Apple Witnesses Testifying in their
11 Employee Capacity. The court finds Apple’s proposed definition of “technological nexus”⁶ to be an
12 appropriate measure under the balancing provisions of Fed. R. Civ. P. 26(b)(2)(C)(iii) for the
13 production of relevant employee testimony from other actions. Apple shall apply this standard and
14 complete its production of all responsive transcripts on a rolling basis and no later than January 15,
15 2012. To the extent that Samsung identifies as relevant any cases that fall outside of Apple’s
16 production as limited by the “technological nexus” standard, the court will entertain a further
17 motion to compel the production of transcripts from those cases, if the parties are unable to come to
18 an agreement regarding production after engaging in appropriate meet and confer.
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20 As noted in the court’s companion order on Apple’s motion to compel, issued today, the
21 parties shall continue to prioritize those categories of production identified as most urgent in light
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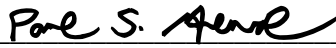
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25 ⁶ See Docket No. 502-3 at 21(Pl.’s Opp’n to Def.’s Mot. To Compel) (“Apple interprets
26 ‘technological nexus’ to include prior cases involving the patents-in-suit or patents covering the
27 same or similar technologies, features, or designs as the patents-in-suit ... [W]ith respect to design
28 patent inventors, this would include prior cases involving the asserted design patents or other
design patents covering the same designs or design elements. With respect to utility patent
inventors, this would include the asserted utility patents or other utility patents covering touch-
based interface functions, display elements, touch-screen hardware, or touch-screen logic.”).

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of the scheduled depositions, such that a complete production of responsive documents shall be made available to opposing counsel no later than three (3) days before inventor depositions.

IT IS SO ORDERED.

Dated: December 22, 2011



PAUL S. GREWAL
United States Magistrate Judge