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Attorneys for Plaintiff and  
 Counterclaim-Defendant Apple Inc.

**United States District Court  
 Northern District of California  
 San Jose Division**

13 APPLE INC., a California corporation,  
 14 Plaintiff,  
 15 vs.  
 16 SAMSUNG ELECTRONICS CO., LTD., a  
 Korean business entity, SAMSUNG  
 17 ELECTRONICS AMERICA, INC., a New  
 York corporation, and SAMSUNG  
 18 TELECOMMUNICATIONS AMERICA,  
 LLC, a Delaware limited liability company,  
 19 Defendants.  
 20 SAMSUNG ELECTRONICS CO., LTD., a  
 Korean business entity, SAMSUNG  
 21 ELECTRONICS AMERICA, INC., a New  
 York corporation, and SAMSUNG  
 22 TELECOMMUNICATIONS AMERICA,  
 LLC, a Delaware limited liability company,  
 23 Counterclaim-Plaintiffs,  
 24  
 25 v.  
 26 APPLE INC., a California corporation,  
 27 Counterclaim-Defendant.

Civil Action No. 11-CV-01846-LHK

**APPLE INC.'S NOTICE OF MOTION  
 AND MOTION TO COMPEL  
 DISCOVERY RELATING TO APPLE'S  
 AFFIRMATIVE DEFENSES AND  
 COUNTERCLAIMS**

Date: TBA  
 Time: TBA

**ORAL ARGUMENT REQUESTED**

**PUBLIC REDACTED VERSION**

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1 **NOTICE OF MOTION AND MOTION**

2 **TO DEFENDANTS SAMSUNG ELECTRONICS CO. LTD., SAMSUNG ELECTRONICS**  
3 **AMERICA, INC., and SAMSUNG TELECOMMUNICATIONS AMERICA, LLC AND**  
4 **THEIR COUNSEL OF RECORD:**

5 **PLEASE TAKE NOTICE THAT** at a date and time to be set by the Court, Plaintiff and  
6 Counterclaim-Defendant Apple Inc. (“Apple”) will move pursuant to Federal Rule of Civil  
7 Procedure 37(a) for an order compelling Defendants and Counterclaim-Plaintiffs Samsung  
8 Electronics Co. Ltd., Samsung Electronics America, Inc. and Samsung Telecommunications  
9 America, LLC (collectively, “Samsung”) to complete production of three categories of  
10 documents by January 23, 2012: (1) documents from the files of Samsung’s named inventors;  
11 (2) documents relating to Samsung’s participation in standards-setting organizations (“SSOs”);  
12 and (3) documents relating to patent license negotiations.

13 In accordance with Local Rule 37-1(a), Apple certifies that it has attempted to meet and  
14 confer with counsel for Samsung in good faith to resolve these disputes without Court  
15 intervention, but those efforts have been unsuccessful. *See* Sections III(C) and (D), IV(A)(2),  
16 and V(A), *infra*, as well as the accompanying declaration of Samuel J. Maselli. The parties  
17 further held a lead counsel in-person meeting on January 5, 2012, where they were unable to  
18 resolve these issues.<sup>1</sup>

19 This motion is based on this Notice of Motion, the accompanying Memorandum of Points  
20 and Authorities in support thereof, the Declaration of Samuel Maselli, and any other matters  
21 properly before the Court.

22 <sup>1</sup> On the afternoon of January 10, 2012, as Apple was finalizing this Motion, Samsung indicated  
23 for the first time in an e-mail that it would agree to supplement its productions relating to SSO's  
24 and patent licensing negotiations, and stated that it would send a letter later in the day with  
further details. At 7:45 pm Pacific on January 10, 2012, Samsung sent Apple [REDACTED]

[REDACTED] (Declaration of Samuel J. Maselli  
25 (“Maselli Decl.”), Ex EE.) For the reasons discussed herein, these proposals are not acceptable  
26 to Apple, and thus Apple has filed this Motion on this date pursuant to the Stipulation of the  
27 parties to an expedited briefing schedule for motions to compel. Apple will review any future  
offers to compromise from Samsung, and will promptly advise the Court if any issues addressed  
in this Motion have been mooted.

1 **RELIEF REQUESTED**

2 Pursuant to Federal Rule of Civil Procedure 37 and Patent Local Rule 3-4, Apple seeks  
3 an order compelling Samsung to produce three discrete categories of highly relevant documents:  
4 (1) complete its production of documents from its inventor files; (2) ETSI and 3GPP related  
5 documents; and (3) patent license and licensing negotiation related documents. Samsung should  
6 complete its production of these documents by January 23, 2012.

7 **STATEMENT OF ISSUES TO BE DECIDED**

8 1. Whether Samsung should be compelled to complete production of documents  
9 from its inventor files by January 23, 2012, after those files have been collected in a thorough  
10 and forensically-sound manner, and after searches of electronic files are performed using  
11 appropriate search terms, including Korean-language terms (the native language of most of the  
12 named inventors).

13 2. Whether Samsung should be compelled to complete its production of documents  
14 related to its participation in ETSI and the 3GPP by January 23, 2012.

15 3. Whether Samsung should be compelled to complete production of documents  
16 related to patent licenses and license negotiations (whether resulting in a contract or not)  
17 covering patents declared essential to wireless standards by January 23, 2012.

18 **APPLE’S CIVIL L.R. 37-2 STATEMENT**

19 Pursuant to Local Rule 37-2, the Apple document requests at issue in this Motion and  
20 Samsung’s responses thereto are set forth below:<sup>2</sup>

21 **THIRD SET OF REQUESTS FOR PRODUCTION, REQUEST NO. 69:**

22 All engineering notebooks, laboratory notebooks, records, logs, files, and electronically  
23 stored information generated at or by the direction of any of the Samsung Named Inventors, and  
24 all engineering notebooks, laboratory notebooks, records, logs, files, and electronically stored  
25

26 \_\_\_\_\_  
27 <sup>2</sup> They are also attached as Exhibits A and B to the Declaration of Samuel J. Maselli in Support  
28 of Motion to Compel Production of Documents and Things (the “Maselli Decl.”).

1 information in which any of the Samsung Named Inventors made any entries that pertain in any  
2 way to any of the Samsung Patents-In-Suit or the subject matter disclosed or claimed therein.

3 **RESPONSE TO REQUEST FOR PRODUCTION NO. 69:**

4 In addition to its Objections and Responses Common to All Requests for Production,  
5 which it hereby incorporates by reference, Samsung objects to this Request to the extent that it  
6 seeks to elicit information subject to and protected by the attorney-client privilege, the attorney  
7 work-product doctrine, the joint defense privilege, the common interest doctrine, and/or any  
8 other applicable privilege or immunity. Samsung further objects to the Request to the extent it is  
9 unduly burdensome, and/or would require undue expense to answer. Samsung further objects the  
10 Request as vague and ambiguous. For example, the terms “generated at or by the direction of”  
11 and “subject matter” is vague and ambiguous. Samsung further objects to the Request as  
12 overbroad in that it is not limited to any reasonable time period and seeks documents and things  
13 from time periods not at issue in this litigation. Samsung further objects to the Request as  
14 duplicative of Apple’s Request For Production Nos. 64, 65, 66. Samsung further objects to the  
15 Request to the extent it seeks documents that are not within the possession, custody, or control of  
16 Samsung. Samsung further objects to the Request to the extent it seeks documents equally or  
17 more readily available to Apple than to Samsung. Samsung further objects to the Request to the  
18 extent the requested documents are publicly available. Samsung further objects to the Request as  
19 premature to the extent it seeks documents and things inconsistent with the timeframes set forth  
20 in the Northern District of California Patent Local Rules.

21 Subject to these objections, Samsung will produce relevant, non-privileged documents  
22 within its possession, custody, or control, if any, after conducting a reasonable search in  
23 accordance with the Patent Local Rules.

24 **THIRD SET OF REQUESTS FOR PRODUCTION, REQUEST NO. 72:**

25 All documents relating to the contribution of each of the Samsung Named Inventors to  
26 the Samsung Patents-In-Suit.

1 **RESPONSE TO REQUEST FOR PRODUCTION NO. 72:**

2 In addition to its Objections and Responses Common to All Requests for Production,  
3 which it hereby incorporates by reference, Samsung objects to this Request to the extent that it  
4 seeks to elicit information subject to and protected by the attorney-client privilege, the attorney  
5 work-product doctrine, the joint defense privilege, the common interest doctrine, and/or any  
6 other applicable privilege or immunity. Samsung further objects to the Request to the extent it is  
7 unduly burdensome, and/or would require undue expense to answer. Samsung further objects the  
8 Request as vague and ambiguous. For example, the term “contribution” is vague and ambiguous.  
9 Samsung further objects to the Request as duplicative of Apple’s Request For Production Nos.  
10 64, 65, 66, 69, 70, and 71. Samsung further objects to the Request to the extent it seeks  
11 documents that are not within the possession, custody, or control of Samsung. Samsung further  
12 objects to the Request to the extent it seeks documents equally or more readily available to Apple  
13 than to Samsung. Samsung further objects to the Request to the extent the requested documents  
14 are publicly available. Samsung further objects to the Request to the extent it calls for a legal  
15 conclusion.

16 Subject to these objections, Samsung will produce relevant, non-privileged documents  
17 within its possession, custody, or control, if any, after conducting a reasonable search in  
18 accordance with the Patent Local Rules.

19 **THIRD SET OF REQUESTS FOR PRODUCTION, REQUEST NO. 73:**

20 All documents sent to or from any of the Samsung Named Inventors relating to the  
21 Samsung Patents-In-Suit, the prosecution of the Samsung Patents-In-Suit, and/or the subject  
22 matter of any claim of the Samsung Patents-In-Suit.

23 **RESPONSE TO REQUEST FOR PRODUCTION NO. 73:**

24 In addition to its Objections and Responses Common to All Requests for Production,  
25 which it hereby incorporates by reference, Samsung objects to this Request to the extent that it  
26 seeks to elicit information subject to and protected by the attorney-client privilege, the attorney  
27 work-product doctrine, the joint defense privilege, the common interest doctrine, and/or any



1 other applicable privilege or immunity. Samsung further objects to the Request to the extent it is  
2 unduly burdensome, and/or would require undue expense to answer. Samsung further objects to  
3 the Request as duplicative of Apple’s Request For Production Nos. 64, 65, 66, 69, 70, 71, and  
4 72. Samsung further objects to the Request to the extent it seeks documents that are not within  
5 the possession, custody, or control of Samsung. Samsung further objects to the Request to the  
6 extent it seeks documents equally or more readily available to Apple than to Samsung. Samsung  
7 further objects to the Request to the extent the requested documents are publicly available.  
8 Samsung further objects to the Request as premature to the extent it seeks documents and things  
9 inconsistent with the timeframes set forth in the Northern District of California Patent Local  
10 Rules.

11 Subject to these objections, Samsung is willing to meet and confer with Apple about the  
12 relevance and scope of the information sought by this request.

13 **THIRD SET OF REQUESTS FOR PRODUCTION, REQUEST NO. 79:**

14 All documents, whether published or not, constituting or relating to writings,  
15 publications, abstracts, papers, presentations, memoranda, reports, or speeches authored or given  
16 by or for Samsung or any of the Named Inventors relating to the subject matter disclosed or  
17 claimed in any of the Samsung Patents-In-Suit, including without limitation such documents  
18 provided to SSOs.

19 **RESPONSE TO REQUEST FOR PRODUCTION NO. 79:**

20 In addition to its Objections and Responses Common to All Requests for Production,  
21 which it hereby incorporates by reference, Samsung objects to this Request to the extent that it  
22 seeks to elicit information subject to and protected by the attorney-client privilege, the attorney  
23 work-product doctrine, the joint defense privilege, the common interest doctrine, and/or any  
24 other applicable privilege or immunity. Samsung further objects to the Request to the extent it is  
25 unduly burdensome, and/or would require undue expense to answer. Samsung further objects the  
26 Request as vague and ambiguous. For example, the term “subject matter” is vague and  
27 ambiguous. Samsung further objects to the Request as overbroad in that it is not limited to any

1 reasonable time period and seeks documents and things from time periods not at issue in this  
2 litigation. Samsung further objects to the Request to the extent it seeks documents equally or  
3 more readily available to Apple than to Samsung. Samsung further objects to the Request to the  
4 extent the requested documents are publicly available. Samsung further objects to the Request as  
5 premature to the extent it seeks documents and things inconsistent with the timeframes set forth  
6 in the Northern District of California Patent Local Rules.

7 Subject to these objections, Samsung is willing to meet and confer with Apple about the  
8 relevance and scope of the information sought by this request.

9 **THIRD SET OF REQUESTS FOR PRODUCTION, REQUEST NO. 119:**

10 All documents concerning or comprising licenses of or agreements to license any IPR  
11 related to any of the Defined Wireless Standards, including without limitation licenses of such  
12 IPR from Samsung to third parties and licenses of such IPR from third parties to Samsung.

13 **RESPONSE TO REQUEST FOR PRODUCTION NO. 119:**

14 In addition to its Objections and Responses Common to All Requests for Production,  
15 which it hereby incorporates by reference, Samsung objects to this Request to the extent that it  
16 seeks to elicit information subject to and protected by the attorney-client privilege, the attorney  
17 work-product doctrine, the joint defense privilege, the common interest doctrine, and/or any  
18 other applicable privilege or immunity. Samsung further objects to the Request to the extent it is  
19 unduly burdensome, and/or would require undue expense to answer. Samsung further objects the  
20 Request as vague and ambiguous. For example, the term “IPR” is vague and ambiguous.  
21 Samsung further objects to the Request as overly burdensome for its use of the term “Defined  
22 Wireless Standards.” Samsung further objects to the Request to the extent it seeks documents  
23 that are not within the possession, custody, or control of Samsung. Samsung further objects to  
24 the Request to the extent it seeks documents equally or more readily available to Apple than to  
25 Samsung. Samsung further objects to the Request to the extent the requested documents are  
26 publicly available. Samsung further objects to the Request to the extent it seeks documents  
27

1 containing confidential third party information, including information subject to a non-disclosure  
2 or other agreement between Samsung and a third party.

3 Subject to these objections, Samsung will produce relevant, non-privileged documents  
4 within its possession, custody, or control, if any, after conducting a reasonable search in  
5 accordance with the Patent Local Rules.

6 **THIRD SET OF REQUESTS FOR PRODUCTION, REQUEST NO. 120:**

7 All documents relating to the negotiation of any license of or agreement to license any  
8 technology allegedly Essential to any Defined Wireless Standards, including without limitation,  
9 documents reflecting discussions between the parties, licensing presentations, claim charts, and  
10 documents identifying the Samsung personnel who negotiated or authorized any such licenses or  
11 license agreement.

12 **RESPONSE TO REQUEST FOR PRODUCTION NO. 120:**

13 In addition to its Objections and Responses Common to All Requests for Production,  
14 which it hereby incorporates by reference, Samsung objects to this Request to the extent that it  
15 seeks to elicit information subject to and protected by the attorney-client privilege, the attorney  
16 work-product doctrine, the joint defense privilege, the common interest doctrine, and/or any  
17 other applicable privilege or immunity. Samsung further objects to the Request to the extent it is  
18 unduly burdensome, and/or would require undue expense to answer. Samsung further objects the  
19 Request as vague and ambiguous. For example, the term “IPR” is vague and ambiguous.  
20 Samsung further objects to the Request as overbroad in that it is not limited to any reasonable  
21 time period and seeks documents and things from time periods not at issue in this litigation.  
22 Samsung further objects to the Request as overly burdensome for its use of the term “Defined  
23 Wireless Standards.” Samsung further objects to the Request to the extent it seeks documents  
24 that are not relevant to the claims or defenses of any party and/or not reasonably calculated to  
25 lead to the discovery of admissible evidence. Samsung further objects to the Request to the  
26 extent it seeks documents that are not within the possession, custody, or control of Samsung.  
27 Samsung further objects to the Request to the extent it seeks documents equally or more readily

1 available to Apple than to Samsung. Samsung further objects to the Request to the extent the  
2 requested documents are publicly available. Samsung further objects to the Request to the extent  
3 it seeks documents containing confidential third party information, including information subject  
4 to a non-disclosure or other agreement between Samsung and a third party.

5 Subject to these objections, Samsung is willing to meet and confer with Apple about the  
6 relevance and scope of the information sought by this request.

7 **THIRD SET OF REQUESTS FOR PRODUCTION, REQUEST NO. 137:**

8 All documents relating to technical proposals, responses to others' technical proposals,  
9 reports, change requests, responses to others' change requests, emails or other communications,  
10 related to any Samsung technology, that were submitted or sent by Samsung to a working group  
11 or body operating under the auspices of any of the Defined Wireless SSOs, or were received by  
12 or sent to Samsung by a participant in such a Defined Wireless SSO working group or body.

13 **RESPONSE TO REQUEST FOR PRODUCTION NO. 137:**

14 In addition to its Objections and Responses Common to All Requests for Production,  
15 which it hereby incorporates by reference, Samsung objects to this Request to the extent that it  
16 seeks to elicit information subject to and protected by the attorney-client privilege, the attorney  
17 work-product doctrine, the joint defense privilege, the common interest doctrine, and/or any  
18 other applicable privilege or immunity. Samsung further objects to the Request to the extent it is  
19 unduly burdensome, and/or would require undue expense to answer. Samsung further objects to  
20 the Request as overbroad in that it is not limited to any reasonable time period and seeks  
21 documents and things from time periods not at issue in this litigation. Samsung further objects to  
22 the Request to the extent it seeks documents that are not relevant to the claims or defenses of any  
23 party and/or not reasonably calculated to lead to the discovery of admissible evidence. Samsung  
24 further objects to the Request as vague, ambiguous, and overly burdensome for its use of the  
25 terms "any Samsung technology," "body operating under the auspices of any of the Defined  
26 Wireless SSOs" and "Defined Wireless SSOs" Samsung further objects to the Request to the  
27 extent it seeks documents that are not within the possession, custody, or control of Samsung.

1 Samsung further objects to the Request to the extent it seeks documents equally or more readily  
2 available to Apple than to Samsung. Samsung further objects to the Request to the extent the  
3 requested documents are publicly available. Samsung further objects to the Request to the extent  
4 it seeks documents containing confidential third party information, including information subject  
5 to a non-disclosure or other agreement between Samsung and a third party.

6 Subject to these objections, Samsung is willing to meet and confer with Apple about the  
7 relevance and scope of the information sought by this request.

8 **THIRD SET OF REQUESTS FOR PRODUCTION, REQUEST NO. 142:**

9 All documents relating to Samsung's identification, disclosure, or notification to any of  
10 the Defined Wireless SSOs of any of Samsung's technology as Essential or allegedly Essential to  
11 any of the Defined Wireless Standards.

12 **RESPONSE TO REQUEST FOR PRODUCTION NO. 142:**

13 In addition to its Objections and Responses Common to All Requests for Production,  
14 which it hereby incorporates by reference, Samsung objects to this Request to the extent that it  
15 seeks to elicit information subject to and protected by the attorney-client privilege, the attorney  
16 work-product doctrine, the joint defense privilege, the common interest doctrine, and/or any  
17 other applicable privilege or immunity. Samsung further objects to the Request to the extent it is  
18 unduly burdensome, and/or would require undue expense to answer. Samsung further objects to  
19 the Request as overbroad in that it is not reasonably limited as to the scope of documents and  
20 things it seeks. Samsung further objects to the Request as overbroad in that it is not limited to  
21 any reasonable time period and seeks documents and things from time periods not at issue in this  
22 litigation. Samsung further objects to the Request as overly burdensome for its use of the overly  
23 broad terms "Defined Wireless SSOs," "Samsung's Alleged Essential Technology," and  
24 "Defined Wireless Standards." Samsung further objects to the Request to the extent it seeks  
25 documents that are not relevant to the claims or defenses of any party and/or not reasonably  
26 calculated to lead to the discovery of admissible evidence.

1 Subject to these objections, Samsung will produce relevant, non-privileged documents  
2 within its possession, custody, or control, if any, after conducting a reasonable search in  
3 accordance with the Patent Local Rules.

4 **THIRD SET OF REQUESTS FOR PRODUCTION, REQUEST NO. 144:**

5 All documents relating to Samsung’s understanding of, and compliance with, any IPR  
6 practice, policy, or procedure of any of the Defined Wireless SSOs to disclose Essential IPR  
7 during the standardization process of any of the Defined Wireless Standards.

8 **RESPONSE TO REQUEST FOR PRODUCTION NO. 144:**

9 In addition to its Objections and Responses Common to All Requests for Production,  
10 which it hereby incorporates by reference, Samsung objects to this Request to the extent that it  
11 seeks to elicit information subject to and protected by the attorney-client privilege, the attorney  
12 work-product doctrine, the joint defense privilege, the common interest doctrine, and/or any  
13 other applicable privilege or immunity. Samsung further objects to the Request to the extent it is  
14 unduly burdensome, and/or would require undue expense to answer. Samsung further objects the  
15 Request as vague and ambiguous. For example, the term “Samsung’s understanding of, and  
16 compliance with,” is vague and ambiguous. Samsung further objects to the Request as overbroad  
17 in that it is not reasonably limited as to the scope of documents and things it seeks. Samsung  
18 further objects to the Request as overbroad in that it is not limited to any reasonable time period  
19 and seeks documents and things from time periods not at issue in this litigation. Samsung further  
20 objects to the Request to the extent it seeks documents that are not relevant to the claims or  
21 defenses of any party and/or not reasonably calculated to lead to the discovery of admissible  
22 evidence. Samsung further objects to the Request as overly burdensome for its use of the overly  
23 broad terms “Defined Wireless SSOs” and “Essential IPR” and “Defined Wireless Standards.”

24 Subject to these objections, Samsung will produce relevant, non-privileged documents  
25 within its possession, custody, or control, if any, after conducting a reasonable search in  
26 accordance with the Patent Local Rules.

1                                    **APPLE’S CERTIFICATION PURSUANT TO FED. R. CIV. P. 37(A)(1)**

2                    Apple hereby certifies that it has in good faith conferred with Samsung in an effort to  
3 obtain the discovery described immediately above without Court action. Apple has held multiple  
4 meet-and-confer teleconferences with Samsung without resolution, and was also unable to  
5 resolve these discovery disputes during the lead counsel in-person meeting held January 5, 2012.  
6 Apple’s efforts to resolve these discovery disputes without court intervention are described in  
7 Sections III(C) and (D), IV(A)(2), and V(A), *infra*, and in the Declaration of Samuel J. Maselli  
8 in Support of Motion to Compel Production of Documents and Things (the “Maselli Decl.”) and  
9 exhibits attached thereto, submitted concurrently herewith.

10 Dated: January 10, 2012

/s/ Mark D. Selwyn  
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Facsimile: (650) 858-6100

11  
12  
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14  
15                                    Attorneys for Plaintiff and  
   Counterclaim-Defendant Apple Inc.

1 **MEMORANDUM OF POINTS AND AUTHORITIES**

2 **I. INTRODUCTION.**

3 Despite the issuance of applicable discovery requests in August, Samsung has not made a  
4 meaningful production of several categories of key documents as detailed below. Nor is  
5 Samsung willing to commit to making a complete production by a date certain. Given the  
6 looming March 8, 2012 fact discovery cut-off, it is essential that Samsung complete its  
7 production on a timely basis so that Apple can have sufficient time to review the documents,  
8 prepare for depositions, and conduct other necessary follow-up discovery. Accordingly, Apple  
9 hereby moves for an order compelling Samsung to complete its production of these documents  
10 by January 23, 2012.

11 **II. LEGAL STANDARD.**

12 Parties “may obtain discovery regarding any nonprivileged matter that is relevant to any  
13 party’s claim or defense[.]” *See* Fed. R. Civ. P. 26(b)(1). Information may be discoverable,  
14 even if not admissible at trial, “if the discovery appears reasonably calculated to lead to the  
15 discovery of admissible evidence.” *See id.* Further, “a party may move for an order compelling  
16 disclosure or discovery.” *See* Fed. R. Civ. P. 37(a)(1); *see also Kilopass Tech., Inc. v. Sidense*  
17 *Corp.*, No. C 10-92966, 2011 U.S. Dist. LEXIS 65610, at \*3-5 (N.D. Cal. June 21, 2011);  
18 *Genentech, Inc. v. Trs. of the Univ. of Pa.*, No. C 10-02037, 2011 U.S. Dist. LEXIS 64432, at \*5  
19 (N.D. Cal. June 16, 2011); *Del Campo v. Kennedy*, 236 F.R.D. 454, 457-58 (N.D. Cal. 2006).

20 In general, discovery of relevant evidence may be limited only when the “burden or  
21 expense of the proposed discovery outweighs its likely benefit, considering the needs of the case,  
22 the amount in controversy, the parties’ resources, the importance of the issues at stake in the  
23 action, and the importance of the discovery in resolving the issues.” *See* Fed. R. Civ. P.  
24 26(b)(2)(C)(iii). When there is doubt about relevance, a court should tend toward permitting  
25 discovery. *See, e.g., Heat & Control, Inc. v. Hester Indus., Inc.*, 785 F.2d 1017, 1024 (Fed. Cir.  
26 1986) (“[T]he court must be careful not to deprive a party of discovery that is reasonably  
27 necessary to afford a fair opportunity to develop and prepare the case.”) (quoting Fed. R. Civ. P.



1 26(b)(1), Advisory Committee Notes, 1983 Amendment).

2 In addition to the obligation to provide relevant discovery, parties must do so in a manner  
3 that facilitates the orderly discovery process. *See Multiven, Inc. v. Cisco Sys., Inc.*, No. 5:08-cv-  
4 05391 JW (HRL), 2010 U.S. Dist. LEXIS 71221, \*5-\*6 (N.D. Cal. July 9, 2010) (directing a  
5 Special Master to assist with the production of documents “with enough time before the close of  
6 discovery to allow Cisco time to actually do anything with them”); *Johnson & Johnson, v. R.E.*  
7 *Service Co. Inc.*, No. C 03-2549 SBA (JL), 2004 U.S. Dist. LEXIS 26973, \*7 (N.D. Cal. Nov. 2,  
8 2004) (ordering expedited production of documents to allow the requesting party sufficient time  
9 to prepare for fact witness depositions).

10 **III. THE COURT SHOULD ORDER SAMSUNG TO COMPLETE ITS**  
11 **PRODUCTION OF INVENTOR DOCUMENTS BY JANUARY 23, 2012.<sup>3</sup>**

12 **A. Background.**

13 Pursuant to the Court’s scheduling order, Samsung was required to make its inventors  
14 available for deposition before December 1, 2011. Necessarily, Samsung should have made a  
15 complete production of all responsive materials from the files of those inventions in advance of  
16 their depositions. Though Samsung did produce some documents prior to the depositions, it  
17 became apparent from the paucity of the productions and from the testimony of the inventors that  
18 Samsung did not conduct an adequate collection of documents from its inventors’ files. Instead,  
19 it is evident that Samsung’s attorneys placed the burden of locating relevant documents, and  
20 conducting electronic searches for documents, on the Samsung inventors themselves. Multiple  
21 inventors testified to the myriad, and unregulated, ways in which they conducted their self-  
22 searches. Further, once Apple received the “transparency disclosures” which set forth the search  
23 terms used by Samsung to search its inventors’ files, Apple became aware of additional  
24 deficiencies in Samsung’s inventor document collection and production. Not surprisingly, their  
25 searches often resulted in very few responsive documents being produced from their files.

26 \_\_\_\_\_  
27 <sup>3</sup> The documents discussed in this section are responsive to one or more of the following  
28 Requests for Production: Nos. 69, 72, 73, 79.

1 Indeed, Samsung's custodial metadata supplied along with its productions indicates that there  
 2 have been *zero* documents produced from the files of 15 of its 32 inventors, and just a handful of  
 3 documents produced for several others. The total number of documents produced from inventors  
 4 is 2,354, broken down by inventor as follows:

<b>Samsung Inventor</b>	<b>Number of Documents Produced from Inventor's Files</b>
Youn-Hyoung Heo	0
Ju-Ho Lee	663
Joon-Young Cho	175
Young-Bum Kim	85
Yong-Jun Kwak	125
Soeng-Hun Kim	293
Gert-Jan Van Lieshout	129
Himke Van Der Velde	152
Jae-Yoel Kim	68
Hee-Won Kang	0
Hun-Kee Kim	38
Gin-Kyn Choi	0
Jae-Seung Yoon	5
Noh-Sun Kim	12
Jun-Sung Lee	0
Yong-Suk Moon	0
Hye-Young Lee	0
Se-Hyoung Kim	0
Min-Goo Kim	309
Beong-Jo Kim	0
Soon-Jae Choi	11
Chang-Soo Park	157
Joong-Ho Jeong	0
Hyeon-Woo Lee	91
Young-Hwan Lee	0
Pyung-soo Kim	0
Hyuk-soo Son	0
Sung-ho Eun	0
Jae-Min Kim	0

<b>Samsung Inventor</b>	<b>Number of Documents Produced from Inventor's Files</b>
Jeong-Seok Oh	0
Sang-Ryul Park	17
Moon-Sang Jeong	24
<b>TOTAL DOCUMENTS</b>	<b>2354</b>

(Maselli Decl. at ¶ 4.)

Apple has asked Samsung to remedy the deficiencies in its inventor collection methodology and search terms on multiple occasions, and Samsung has refused, including at the lead counsel in-person meeting between the parties. Accordingly, Apple seeks an order directing Samsung to remedy these deficiencies on an expedited basis by conducting a thorough and comprehensive collection of documents from its inventor files, and then making complete production of relevant documents from those files (using a complete set of search terms).

**B. Samsung's Inventor Documents Are Relevant and Discoverable.**

There can be no doubt that documents from the files of the named inventors of the Samsung patents-in-suit are relevant and discoverable. Such documents likely describe the conception and reduction to practice of the asserted patents, and may be relevant to potential inequitable conduct claims. To the extent that inventors participated in activities before SSOs, there may also be documents in the inventors' files that bear on Apple's counterclaims stemming from Samsung's SSO-related activities. *See* Section IV *supra*. Samsung itself has acknowledged the relevance of inventor files in its Motion to Compel Production of Documents and Things and Responsive Answers to Propounded Discovery ("Samsung's Motion to Compel"), filed December 12, 2011 (Dkt. 483), in which it argued that materials in Apple inventor files were "obviously central to the issues in this action, including anticipation, obviousness . . ." *See* Samsung's Motion to Compel, p. 15.

Pursuant to this Court's Local Rules, a motion to compel must "show how the proportionality and other requirements of Fed. R. Civ. P. 26(b)(2) are satisfied." *See* Civil L. R.

1 37-2. The proportionality requirement of Local Rule 37-2 is easily satisfied here, as the burden  
2 on Samsung in producing the requested documents does not outweigh the probative value.  
3 These documents are plainly relevant. Additionally, there is no legitimate dispute that Samsung  
4 has the resources to produce these documents on a timely basis, particularly given that Samsung  
5 has already agreed to produce relevant, non-privileged documents.

6 **C. Samsung's Manner of Collecting from Its Inventors Was Deficient.**

7 The deposition testimony from Samsung's named inventors confirms that Samsung's  
8 counsel placed undue reliance on its inventors to search for, identify, and collect documents from  
9 their own files, which they have appeared to have done, at best, in an incomplete and non-  
10 systematic fashion. For example:

- 11 • [REDACTED]
- 12 [REDACTED]
- 13 [REDACTED]
- 14 [REDACTED]
- 15 [REDACTED]
- 16 • [REDACTED]
- 17 [REDACTED]
- 18 [REDACTED]
- 19 [REDACTED]
- 20 [REDACTED]
- 21 [REDACTED]
- 22 [REDACTED]
- 23 [REDACTED]
- 24 • [REDACTED]
- 25 [REDACTED]
- 26 [REDACTED]
- 27 [REDACTED]

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- [REDACTED]
- [REDACTED]

In response to these and other revelations from the inventor depositions, Apple requested more information about the manner in which Samsung conducted its searches. Apple sent Samsung letters on December 2 and 6 raising concerns it had with Samsung’s collection of inventor documents. (*See* Maselli Decl., Ex. H (Dec. 2 Letter Maselli to Kassabian); *Id.*, Ex. I (Dec. 6 Letter Maselli to Kassabian).) In these letters, Apple requested the following specific information:

- (i) Were additional searches of the files of these witness conducted in addition to the self-searches described in their depositions? If the answer is yes, provide details regarding the searching that was performed (including, for each witness, a description of which hard-copy documents and electronic depositories were searched, whether e-mails (and attachments to e-mails) were searched, and the search terms utilized);
- (ii) Whether the self-searching methodology described in the aforementioned testimony has been the standard method employed by Samsung in its search for and collection of custodial documents from inventors still employed by Samsung; and
- (iii) Provide a description of the inventor self-searches, including, for each witness, (a) explain whether the witness searched for both hard-copy and electronic documents, (b) list the electronic repositories that were searched (e.g., desk-top computer, lap-top computer, external hard-drives, shared-drives, dedicated servers, etc.), (c) for each repository searched, provide a list of the search terms employed and an explanation how the contents of the repository were searched (e.g., were searches conducted of document metadata only? Were searches conducted of the content of all the documents in the repository? Were searches conducted of the content of only some of the documents in the repository (e.g., Word documents searched, PDF’s not searched?, etc.), and (d) explain whether the witness searched any repositories containing e-mail, and, if so, whether the search of the repository included a search of e-mail attachments.

1 Apple continued to follow up on the issue of the deficiency of Samsung’s inventor collection in  
2 letters and during meet-and-confer teleconferences as well as the in-person lead counsel meeting.  
3 (Maselli Dec., Ex. Z (Dec. 5 Letter Mazza to Kassabian); *Id.*, Ex. AA (Dec. 24 Letter Mazza to  
4 Hutnyan).) In response to these inquiries, Samsung asserted that its collections were sufficient,  
5 but failed to provide the information requested above. (*See* Maselli Decl., Ex. J (Dec. 6 Letter  
6 Jenkins to Maselli); *Id.*, Ex. K (Dec. 20 Letter Jenkins to Maselli).) Nor has Samsung provided  
7 any details regarding any additional searches performed beyond the inventors’ “self-searches.”

8 This manner of unguided self-searching is clearly insufficient. *See Play Visions, Inc. v.*  
9 *Dollar Tree Stores, Inc.*, No. C09-1769, 2011 WL 2292326, at \*6 (W.D. Wash. June 8, 2011)  
10 (imposing sanctions for, among other reasons, “counsel’s failure to assist and guide his client’s  
11 production of discovery responses.”); *Wachtel v. Health Net, Inc.*, 239 F.R.D. 81, 82 (D.N.J.  
12 2006) (granting sanctions where defendant “relied on the specified business people within the  
13 company to search and turn over whatever documents they thought were responsive, without  
14 verifying that the searches were sufficient”); *Jones v. Bremen High School District 228*, No. 08  
15 C 3548, 2010 WL 2106640, at \*7 (N.D. Ill. May 25, 2010) (finding unreasonable that defendant  
16 directed employees “to search their own email without help from counsel” and allowed them “to  
17 make the decision about the relevance of such documents, especially when those same  
18 employees have the ability to permanently delete unfavorable email from a party’s system.”).  
19 “Most non-lawyer employees . . . do not have enough knowledge of the applicable law to  
20 correctly recognize which documents are relevant to a lawsuit and which are not.” *Jones*, 2010  
21 WL 2106640, at \*7. Samsung’s reliance on inventor self-searching is particularly suspect here  
22 because several of the inventors in question are expressly accused of misconduct before SSOs in  
23 Apple’s amended counterclaims in reply (*see* Section IV(A) below), and, as such, Samsung’s  
24 counsel is improperly relying on these inventors to turn over evidence of their own misconduct.  
25 *See id.* (finding it improper for a party’s employees “to make the decision about the relevance of  
26 such documents, especially when those same employees have the ability to permanently delete  
27 unfavorable email from a party’s system”). Accordingly, the Court should order Samsung to

1 conduct new, systematic searches for responsive documents, under the guidance of counsel with  
2 the search terms described in Section III(D) below, and to produce the responsive documents by  
3 January 23, 2012.

4 **D. The Search Terms Used by Samsung to Search Its Inventors' Files Are**  
5 **Insufficient.**

6 The overly narrow search terms employed to by Samsung to search the files of its named  
7 inventors (identified by Samsung in its "transparency disclosures" of December 1, 2011) are a  
8 further deficiency in its inventor production. The searches employed by the inventors are  
9 deficient in at least the following respects:

- 10 • **No Searches for Two of the Asserted Patents:** No searches have been conducted  
11 whatsoever for two of Samsung's asserted patents, the '055 and '871 patents. Instead,  
12 Samsung claims those searches will be conducted at some undefined future time.
- 13 • **No Searches Using Korean Search Terms:** According to the disclosures served by  
14 Samsung on December 1, with the exception of the single term ("interleaver"), no Korean  
15 language search terms were run for any of the inventors' electronic files. (Maselli Decl.,  
16 Ex. L.) Since nearly all of the inventors are native Korean speakers (and indeed were  
17 deposed through a Korean translator), it is logical to assume that many, if not most,  
18 responsive documents are likely to be in Korean.<sup>4</sup>
- 19 • **Inadequate Searches Employing SSO-Related Search Terms:** Despite the fact that  
20 many of the inventors were involved in Samsung's activities before standards setting  
21 organizations, Samsung did not search most inventor files using SSO-related terms.
- 22 • **Inadequate Searches Using Patent-Specific Search Terms:** The search terms for ten  
23 of Samsung's asserted patents (the '711, '460, '893, '516, '001, '941, '604, '410, '792,  
24 and '867 patents) fail to include either obviously-relevant and patent-specific terms, or  
25 commonly-used variants of patent-specific terms.

26 Apple identified these deficiencies by letter dated December 13, 2011, and included in its  
27 correspondence a set of supplemental search terms which Apple believed would remedy these  
28 deficiencies and lead to a more complete production of responsive materials from the Samsung  
inventor files. (Maselli Decl., Ex. M (Dec. 13, 2011 Letter Kolovos to Maroulis and

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25 <sup>4</sup> In a letter dated January 6, Samsung asserted (for the first time) that "Korean equivalents of the  
26 search terms [were] applied to the inventors' files whenever it was necessary or appropriate."  
27 (Maselli Decl., Ex. N (Jan. 6 Letter Jenkins to Kolovos).) Given that this was inconsistent with  
28 the information in Samsung's December 1 disclosures, Apple asked Samsung to disclose which  
search terms other than "interleaver" (if any) were also run using an equivalent Korean term.  
(Maselli Decl., Ex. O (Jan. 7 E-Mail Kolovos to Jenkins).) Samsung has not responded.

1 Kassabian).) Though Samsung took several weeks to respond to Apple’s letter, it did not agree  
2 to supplement *any* of its searches using additional terms. (Maselli Decl., Ex. N (Jan. 6, 2012  
3 Letter Jenkins to Kolovos).) Nor did Samsung agree at the lead counsel in-person meeting to use  
4 any additional search terms.

5 Samsung’s use of grossly insufficient search terms likely has limited its production to a  
6 fraction of the responsive materials that should have been produced, and may explain the paucity  
7 of Samsung’s inventor production. Accordingly, the Court should order Samsung to conduct  
8 new searches of its inventor documents, once properly collected, using a more robust set of  
9 search terms. The search terms proposed by Apple are set forth in its proposed Order (which  
10 tracks the search terms proposed by Apple in its correspondence with Samsung).

11 **IV. THE COURT SHOULD ORDER SAMSUNG TO COMPLETE PRODUCTION OF**  
12 **DOCUMENTS REFLECTING ITS ACTIVITIES BEFORE STANDARDS**  
13 **SETTING ORGANIZATIONS BY JANUARY 23, 2012.**<sup>5</sup>

14 **A. Background.**

15 In this action, Samsung asserts that Apple infringes twelve patents, including seven  
16 patents that Samsung has declared “essential” to the European Telecommunications Standards  
17 Institute (“ETSI”), a leading wireless communications standards setting organization. ETSI is  
18 part of a telecommunications industry collaboration called the Third Generation Partnership  
19 Project (“3GPP”); 3GPP has developed the UMTS (Universal Mobile Telecommunications  
20 System) telecommunications standard. Samsung has declared seven of the twelve patents that it  
21 has asserted against Apple in this action as essential to the UMTS standard (the “declared-  
22 essential patents”).<sup>6</sup>

23 Apple’s Amended Counterclaims in Reply (Dkt. 381), filed on November 8, 2011,  
24 include affirmative defenses that Samsung’s patents are unenforceable, and counterclaims  
25 against Samsung for breach of contract, promissory estoppel, violation of the Sherman Act, and

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26 <sup>5</sup> The documents discussed in this section are responsive to one or more of the following  
27 Requests for Production: Nos. 137, 142, 144.

28 <sup>6</sup> The seven patents are U.S. Patent Nos. 7,447,516, 7,200,792, 6,928,604, 7,386,001, 7,050,410,  
7,675,941 and 7,362,867.



1 unfair competition under Cal. Bus. & Prof. Code. Apple also seeks a declaration that Apple is  
2 licensed to Samsung’s declared-essential patents.<sup>7</sup>

3 Apple’s Amended Counterclaims assert, *inter alia*, that Samsung deliberately and  
4 deceptively failed to disclose to ETSI and 3GPP in a timely fashion the intellectual property  
5 rights (“IPR”) that Samsung now claims are essential to the UMTS standard, and that Samsung  
6 delayed this disclosure in order to encourage the incorporation of Samsung’s technologies into  
7 the standard. *See* Amended Counterclaims ¶¶ 44, 57. In particular, Apple asserts that Samsung  
8 personnel frequently participated in 3GPP working groups during the relevant timeframe (1999-  
9 2005), championed Samsung’s technical proposals, affirmatively steered the SSOs to adopt  
10 Samsung’s technical proposals, and then disclosed Samsung’s IPR only *after* the relevant  
11 standard or technical specification was finalized. *Id.* Apple’s Amended Counterclaims provide  
12 specific instances for each declared-essential patent where Samsung personnel (including named  
13 inventors of the patents in suit) made presentations to 3GPP working groups in support of the  
14 adoption of Samsung technology in the standard, without disclosing (as required by ETSI policy)  
15 that Samsung *was already pursuing* patent protection for that technology. *See id.* at ¶ 57(a)-(g).<sup>8</sup>

16 **1. Samsung Witness Testimony Establishes the Sources of Potentially**  
17 **Relevant Documents Regarding Samsung’s Participation in Standards**  
18 **Setting Organizations.**

19 To date, Apple has taken the depositions of twenty-four Samsung inventors, several of  
20 whom were involved in presentations made by Samsung to 3GPP working groups. Several of  
21 these inventors testified about Samsung’s involvement in ETSI and the development of the

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22 <sup>7</sup> These counterclaims were also all included in Apple’s original Counterclaims in Reply filed on  
23 July 21. Apple also seeks a declaratory judgment of non-infringement and invalidity for each  
24 patent asserted by Samsung.

25 <sup>8</sup> As further outlined in Apple’s counterclaims, individuals at Samsung made false promises to  
26 standards-setting organizations regarding the licensing of its standards-essential patents.  
27 Specifically, Samsung disclosed its asserted patents and falsely promised to license these patents  
28 on fair, reasonable, and non-discriminatory (“FRAND”) terms in declarations signed by various  
Samsung representatives. *See* Apple’s Amended Counterclaims in Reply, ¶ 44 (“Samsung did  
not intend to meet its FRAND commitments”); ¶ 47 (alleging Samsung’s “intentional failure to  
disclose to the 3GPP that it would not offer to all UMTS implementers FRAND license terms”).

1 UMTS standard, and further identified the groups within Samsung with responsibility in those  
2 areas. These witnesses established at least the following about Samsung's participation in SSOs:

- 3 • [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]
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[REDACTED]

**2. Samsung Has Not Made a Complete Production Of Documents Relating to Its Participation in Standards Setting Organizations, and Has Not Committed to Remedy this Deficiency in a Timely Manner.**

The deposition testimony obtained by Apple to date confirms that Samsung’s production of documents relating to its participation in ETSI/3GPP is woefully inadequate, as it has consisted mostly of publicly-available documents, as well as a limited production from certain inventor files. Samsung’s SSO production is deficient in at least three ways:

- First, Samsung has not produced any policies or procedures (or equivalent documents) relating to Samsung’s understanding of and/or compliance with ETSI and/or 3GPP disclosure requirements.
- Second, Samsung has not produced entire categories of documents related to its participation in ETSI and the 3GPP, including: internal reports concerning Samsung employees’ attendance at 3GPP meetings, meeting minutes and other documents prepared for or during internal meetings held to improve proposals to be submitted to 3GPP standards meetings, draft agendas, draft proposals, PowerPoint presentations, and email correspondence.
- Third, Samsung has not produced documents from the files of many witnesses likely to have discoverable SSO information. Indeed, it appears that the *only* SSO documents produced by Samsung thus far bearing bates-numbers for this action have come from the files of inventors.

[REDACTED]

1 [REDACTED]  
2 [REDACTED]  
3 [REDACTED]  
4 [REDACTED]  
5 [REDACTED]  
6 [REDACTED]  
7  
8 While Samsung's production of SSO-related documents is thus plainly deficient, it has  
9 been unwilling to remedy this deficiency in a timely manner. Apple sent letters detailing  
10 particular deficiencies in Samsung's SSO document production, and demanding a substantially  
11 complete production of SSO documents, on November 8, 15, 18, 20, 23, and December 5 and 24,  
12 2011. (*See id.*, at ¶ 15.) In its responses, Samsung has refused to make a substantially complete  
13 production of SSO documents, including ETSI and 3GPP documents. (*See, e.g., id.*, Ex. BB (Oct.  
14 21 Letter Chan to Walden); *Id.*, Ex. CC (Nov. 20 Letter Kassabian to Maselli and Mazza).)  
15 Instead, in a December 6, 2011 letter, Samsung stated that it "views these [SSO] documents as  
16 largely within the scope of the reciprocal agreement currently being negotiated between the  
17 parties . . . the scope of Samsung's production of these documents will depend on the parties'  
18 agreement." (*See id.*, Ex. DD (Dec. 6 Letter Chan to Walden).) The "reciprocal agreement"  
19 referred to by Samsung is a draft agreement the parties have been negotiating that would obligate  
20 both sides to produce particular categories of documents. However, when Samsung proposed a  
21 "reciprocal" category for the production of SSO documents, it limited its proposal to *public*  
22 *documents directly disclosed to ETSI only.*<sup>9</sup> (*See id.*, Ex. FF (Dec. 13 Email Chan to Mazza and  
23 attached redline to Exhibit B).) Although Samsung has offered at the eleventh hour to produce  
24 [REDACTED]  
25 [REDACTED]

26 <sup>9</sup> On the parties' meet-and-confer teleconferences, and during the lead counsel in-person  
27 meeting, Samsung has similarly been unwilling to commit to producing anything other than  
28 publicly-available SSO documents. (Maselli Decl. ¶ 19 (Nov. 16, Nov. 30, Dec. 7 and Dec. 21  
meet and confers).)

1 [REDACTED]  
2 (Maselli Dec., Ex. EE), Samsung's proposal is still deficient in several significant ways:

- 3
- 4 • Samsung has not agreed to produce documents which show its general policies and/or practices with regard to the disclosure of purportedly essential IPR to ETSI and 3GPP;
  - 5 • Samsung has not agreed to produce documents which show the structure of the departments or teams at Samsung that work on SSO-related issues so that Apple may identify pertinent fact witnesses to depose; and
  - 6 • Samsung has not agreed to produce documents related to Samsung's decision to disclose (or not to disclose) the patents-in-suit to ETSI and 3GPP.
- 7

8 Finally, Samsung has not expressly agreed that its production of SSO documents will  
9 extend beyond the files of Samsung's named inventors. For at least these reasons, Samsung's  
10 proposal is inadequate.

11 **B. Samsung's Documents Related to Its Participation in Standards Setting  
12 Organizations are Relevant and Discoverable.**

13 The ETSI/3GPP documents requested above are discoverable because they are relevant at  
14 least to Apple's affirmative defenses that Samsung's patents are unenforceable, as well as many  
15 of Apple's counterclaims in reply. As detailed in Section IV(A) above, Apple's amended  
16 counterclaims incorporate several specific factual allegations regarding SSO-related misconduct  
17 by Samsung and its employees. The testimony of Samsung's inventors has thus far provided  
18 additional support for these allegations. *See* Section IV(A)(1) above. Accordingly, there can be  
19 little doubt that documents related to Samsung's standards-setting activities are relevant and that  
20 Samsung is obligated to produce them.<sup>10</sup> *See, e.g., In Re Rambus Inc.*, 7 Fed. Appx. 925, 926  
21 (Fed. Cir. 2001) (denying petition for writ of mandamus regarding district court order granting  
22 motion to compel production of documents related to the disclosure of intellectual property  
23

24 <sup>10</sup> The proportionality requirement of Local Rule 37-2 is easily satisfied here, as the burden on  
25 Samsung in producing the requested documents does not outweigh the probative value. By  
26 asserting patents which are purportedly essential to the UMTS standard against Apple, Samsung  
27 has made its activities regarding the adoption of those standards a core issue in this litigation.  
28 Additionally, there is no legitimate dispute that Samsung has the resources to produce these  
documents on a timely basis, particularly given that Samsung has already agreed to produce  
relevant, non-privileged documents.

1 rights to an SSO); *LG Elecs., Inc. v. Motorola, Inc.*, No. 10-CV-3179, 2010 U.S. Dist. LEXIS  
2 79047, \*9-10 (N.D. Ill. Aug. 5, 2010) (granting motion to compel production of documents  
3 pertaining to standards-setting activities); *SmithKline Beecham Corp. v. Apotex Corp.*, No. 99-  
4 CV-4304, 2006 U.S. Dist. LEXIS 4276, \*9-\*11 (E.D. Pa. Jan. 31, 2006) (granting motion to  
5 compel production of communications with standards-setting organization because “[i]t is clear  
6 that communications between a corporation and a standards-setting organization can form the  
7 basis of an antitrust claim”) (citing *Allied Tube & Conduit Corp. v. Indian Head, Inc.*, 486 U.S.  
8 492, 499-500 (1988)).

9 **C. Samsung Should Be Ordered to Complete Production of Its Standards**  
10 **Setting Organization Documents by January 23, 2012.**

11 Fact discovery closes on March 8, 2012. Apple thus has approximately eight weeks to  
12 receive Samsung’s document production, identify witnesses, depose them, and determine  
13 whether further discovery is necessary and warranted. Indeed, the effects of any further delays  
14 in the production of relevant documents in this case are likely to be exacerbated because many of  
15 Samsung’s relevant documents may be produced in Korean and will therefore need to be  
16 translated. Apple cannot fairly develop its case if Samsung does not produce its SSO-related  
17 documents on a timely basis, including its internal policies, drafts proposals, and internal  
18 communications concerning Samsung’s participation in SSO’s and its decisions when, and when  
19 not, to disclose technology and IPR to SSO’s. Thus, Samsung should be ordered to complete  
20 production of SSO documents by January 23, 2012.

21 **V. THE COURT SHOULD ORDER SAMSUNG TO COMPLETE PRODUCTION OF**  
22 **LICENSES AND LICENSE NEGOTIATION DOCUMENTS BY JANUARY 23,**  
23 **2012.<sup>11</sup>**

24 **A. Background.**

25 Apple’s document requests, as narrowed through the meet and confer process, seek: (1)  
26 executed license agreements (only) for those licenses to relevant technologies that cover only

27 <sup>11</sup> The documents discussed in this section are responsive to one or more of the following  
28 Requests for Production: Nos. 119, 120.

1 patents that have not been declared “essential” to a standards body; and (2) license agreements  
2 *and* license negotiation documents relating to patents that Samsung has declared essential to the  
3 ETSI and/or 3GPP standards. (*See* Maselli Decl. at ¶ 20; *Id.*, Ex. A (Apple’s Document  
4 Requests); *Id.*, Ex. FF (Dec. 13 Email Chan to Mazza and attached redline of Apple’s Exhibit  
5 A).)

6 Despite Apple’s requests, Samsung has not yet made a substantial production of  
7 documents reflecting the negotiation of licenses to patents that have been declared essential to  
8 ETSI and/or 3GPP standards. As with the SSO documents, Apple has repeatedly requested that  
9 Samsung provide a date certain by which it will complete its production of patent licensing  
10 negotiation documents. (Maselli Decl., Ex. Z (Dec. 5 Letter Mazza to Kassabian); *Id.*, Ex. AA  
11 (Dec. 24 Letter Mazza to Huntyan).) Apple also proposed that the parties reach agreement on a  
12 reciprocal production in this regard of (1) executed license agreements (only) for those licenses  
13 (in the relevant technologies) that cover only patents that have not been declared “essential” to a  
14 standards body; and (2) license agreements *and* license negotiation documents relating to patents  
15 that Samsung has declared standards essential to ETSI and/or 3GPP. (*See id.*, Ex. FF (Dec. 13  
16 Email Chan to Mazza and attached redline of Apple’s Exhibit A).) In response, Samsung  
17 proposed a reciprocal production only of executed licenses to the patents-in-suit, and struck out  
18 *any* reciprocal obligation to produce documents reflecting patent license negotiations. (*See id.*)  
19 Similarly, during the parties’ meet-and-confer teleconferences, and at the lead counsel in-person  
20 meeting, Samsung has been unwilling to commit to producing anything other than executed  
21 licenses. (Maselli Decl. ¶ 21 (Nov. 16, Nov. 30, Dec. 7, and Dec. 21 meet and confers).) While  
22 Samsung's latest proposal (sent the evening this Motion was filed) [REDACTED]

23 [REDACTED]  
24 [REDACTED]  
25 [REDACTED]  
26 [REDACTED] (*See* Maselli Dec., Ex. EE.)  
27  
28

1           **B. Samsung’s Licenses and Licenses Negotiation Documents are Relevant and**  
2           **Discoverable.**

3           Documents reflecting Samsung’s licenses covering declared-essential patents and the  
4 related license negotiations are plainly relevant to Apple’s affirmative defenses and to the  
5 calculation of a reasonable royalty. First, licenses and documents reflecting negotiations of  
6 licenses to the asserted patents may reflect Samsung’s (or its counterparty’s) understanding of  
7 the breadth of the licenses granted to the patents in suit, and thus bear directly on Apple’s  
8 defenses that the Samsung patents-in-suit are unenforceable against Apple by virtue of an  
9 express or implied license or other exhaustion of rights. *See, e.g.*, Dkt. 381, ¶ 196; *see also*  
10 *Quanta Computer, Inc. v. LG Electronics, Inc.*, 553 U.S. 617, 625 (2008) (the first authorized  
11 sale of a patented item terminates all patent rights to that item).

12           Second, documents reflecting patent license negotiations for declared-essential patents  
13 (even declared-essential patents not asserted in this action) are relevant to the determination of an  
14 appropriate “Fair, Reasonable, and Non-Discriminatory” (FRAND) royalty rate, if any. This  
15 Court has recognized on several occasions that license agreements and documents related to the  
16 negotiation of license agreements are relevant, particularly if they predate the litigation. *See,*  
17 *e.g., C&C Jewelry Mfg. v. West*, No. C09-01303, 2010 U.S. Dist. LEXIS 110587, at \*6 (N.D.  
18 Cal. Oct. 7, 2010) (granting motion to compel production of all documents related to the  
19 licensing of the patents-in-suit, including documents pertaining to licenses granted to third  
20 parties); *Phoenix Sols. Inc. v. Wells Fargo Bank, N.A.*, 254 F.R.D. 568, 582 (N.D. Cal. 2008)  
21 (granting motion to compel production of communications with third parties related to the  
22 licensing of the patents-in-suit in part because such communications were relevant to the  
23 calculation of damages and what the patent owner perceived to be a reasonable royalty rate);  
24 *Sorensen v. Lexar Media Inc.*, No. C 08-0095, 2008 U.S. Dist. LEXIS 105503, at \*6-\*7 (N.D.  
25 Cal. Dec. 22, 2008) (granting motion to compel production of draft licensing agreements because  
26 they “could have relevance on the damages question of what constitutes a reasonable royalty”).  
27  
28



1 Accordingly, the documents sought will be relevant to the calculation of any alleged damages  
2 and to the determination of a FRAND royalty rate, if any, for the declared-essential patents.

3 While there can be no legitimate dispute that the negotiation documents sought by Apple  
4 are highly relevant and discoverable, the burden on Samsung in producing the requested  
5 documents does not outweigh the probative value of these documents. *See Atmel Corp. v.*  
6 *Authentec Inc.*, No. C-06-02138, 2008 U.S. Dist. LEXIS 10850, at \*4 (N.D. Cal. Jan. 31, 2008)  
7 (granting motion to compel production of all relevant licensing agreements, including those that  
8 “do not involve the precise patents-in-suit”). There is no legitimate dispute that Samsung has the  
9 resources to produce these documents on a timely basis, and the Court should order Samsung to  
10 do so. Given the looming fact discovery deadline and Apple’s need to review any license  
11 production in advance of completing its depositions of the appropriate Samsung personnel, the  
12 Court should order Samsung to complete production of licenses and licensing negotiation  
13 documents by January 23, 2012.

14 **VI. CONCLUSION**

15 For the foregoing reasons, Apple respectfully requests that the Court grant its Motion to  
16 Compel Discovery from Samsung.

1 Dated: January 10, 2012

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1 **CERTIFICATE OF SERVICE**

2 The undersigned hereby certifies that a true and correct copy of the above and foregoing  
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