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15 INC. and SAMSUNG
TELECOMMUNICATIONS AMERICA, LLC

16 UNITED STATES DISTRICT COURT

17 NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

18
19 APPLE INC., a California corporation,

20 Plaintiff,

21 vs.

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

26 Defendant.

CASE NO. 11-cv-01846-LHK

**NOTICE OF MOTION AND MOTION TO
PERMIT SAMSUNG'S EXPERT SAMUEL
LUCENTE TO REVIEW MATERIALS
DESIGNATED UNDER THE
PROTECTIVE ORDER**

Date: February 7, 2012

Time: 10:00 a.m.

Place: Courtroom 5, 4th Floor

Judge: Hon. Paul S. Grewal

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NOTICE OF MOTION

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that on February 7, 2012 at 10:00 a.m. or as soon as the matter may be heard by the Honorable Paul S. Grewal in Courtroom 5, United States District Court for the Northern District of California, Robert F. Peckham Federal Building, 280 South 1st Street, San Jose, CA 95113, , Defendants Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively “Samsung”) shall and hereby do move the Court for an order granting Samsung’s Motion To Permit Samsung’s Expert Samuel Lucente To Review Materials Designated Under The Protective Order. This motion is based on this notice of motion and supporting memorandum of points and authorities; the supporting declaration of Albert Bedecarré; and such other written or oral argument as may be presented at or before the time this motion is taken under submission by the Court.

RELIEF REQUESTED

Samsung seeks an order allowing Samuel Lucente to view documents, transcripts and other discovery that have been designated or are subsequently designated by Apple under any operative protective order in this litigation.

DATED: January 30, 2012

Respectfully submitted,

QUINN EMANUEL URQUHART
& SULLIVAN, LLP

By/s/ Michael Zeller

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Kevin P.B. Johnson
Victoria F. Maroulis
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INC. and SAMSUNG
TELECOMMUNICATIONS AMERICA, LLC

1 **MEMORANDUM OF POINTS AND AUTHORITIES**

2 **I. PRELIMINARY STATEMENT**

3 Apple continues to misuse the protective order to prevent Samsung from showing relevant,
4 internal Apple documents to its design experts.¹ The Court should put an end to this pattern and
5 afford Samsung the right to prepare a robust defense to Apple’s design patent, trademark, and
6 trade dress claims by allowing Samsung's design expert, Samuel Lucente, to view Apple's highly
7 confidential materials.

8 Samsung disclosed Mr. Lucente over a month and half ago, and has received nothing from
9 Apple but unwarranted delay and unexplained objections. Mr. Lucente has signed the protective
10 order, made all the necessary factual disclosures, and proved that his business does not compete
11 with Apple in any way. Nevertheless, more than a month after Samsung disclosed Mr. Lucente,
12 Apple said that it had suddenly become aware of a graphical user interface utility patent that
13 Mr. Lucente invented in the 1990s. Apple's claim of surprise was quite false. The patent was
14 listed on the face of Mr. Lucente's curriculum vitae. And more importantly, Mr. Lucente's patent
15 provides no substantive basis for precluding Mr. Lucente from acting as an expert. Quite the
16 contrary. As Apple improperly did with Itay Sherman, another Samsung design expert, Apple
17 purports to turn these expert's qualifications into meritless grounds for disqualifying them.
18 Despite Samsung's repeated attempts to obtain from Apple an actual explanation as to how Apple
19 could possibly object on these grounds, Apple merely claimed that Mr. Lucente could not be
20 approved without some wholly unspecified restrictions on his access because he has a pending
21 patent application in Europe, which is related to his U.S. patent.

22 Samsung is running out of time to prepare its experts under the highly accelerated schedule
23 that *Apple* sought in this case. Apple should not be rewarded for its inexcusable delay.

24
25
26 _____
27 ¹ As the Court is aware, Samsung was forced to make a motion regarding Itay Sherman’s
28 obstructionist tactics in its December 22, 2011 and January 27, 2012 orders.

1 Mr. Lucente must have access to the relevant evidence Apple has designated as highly confidential
2 so that Samsung can defend itself against Apple's asserted claims.

3 **II. STATEMENT OF FACTS**

4 On December 13, 2011, Samsung disclosed Samuel Lucente as an expert in this case. *See*
5 Declaration of Albert Bedecarré (“Bedecarré Decl.”) ¶ 2, Exh. A. Attached to the disclosure was
6 Mr. Lucente’s curriculum vitae, which listed his issued patents, and his signed undertaking to
7 abide by the terms of the Interim Model Protective Order. *Id.* Mr. Lucente is a member of the
8 Industrial Designers Society of America, and worked as a designer for 20 years at IBM
9 Corporation, Netscape Corporation and Hewlett-Packard Company (“HP”). *Id.* Mr. Lucente
10 oversaw the design of user interfaces, laptop and tablet computers, and other electronic devices,
11 and is now the lead designer and principal of Lucente Design, LLC. *Id.*

12 On December 27, 2011, counsel for Apple objected to Mr. Lucente and asked “whether
13 Mr. Lucente has ever participated in, or consulted on, developing or designing a mobile phone”
14 and requested a list of clients of Lucente Design. *Id.* ¶ 3, Exh. B. Lead counsel subsequently met
15 and conferred regarding the status of Mr. Lucente as an expert on January 5, 2012, and Samsung
16 agreed to provide responsive information, which it did on January 8, 2012, confirming that Mr.
17 Lucente's business was not in competition with Apple. *Id.* ¶ 4, Exh. C; ¶ 5, Exh. D. Nevertheless,
18 Apple still would not withdraw its objections.

19 On January 16, 2012, at a second lead counsel meet and confer, Samsung again tried to
20 resolve the issue. *Id.* ¶ 6, Exh. E. Prior to the meeting, Apple’s counsel said they would “be
21 prepared to close the loop on Apple’s objections to Samsung’s expert Lucente, assuming Samsung
22 will close the loop on its objections to Apple’s expert Peter Bressler.” *Id.* ¶ 7, Exh. F. Instead of
23 honoring that promise, the next day counsel for Apple asked for the first time about Mr. Lucente’s
24 ownership interest in two patents and any pending priority applications, erroneously claiming that
25 “[t]he information about Mr. Lucente’s patents has only recently surfaced.” *Id.* ¶ 8, Exh. G.² In

26
27 ² Although the letter is dated January 16, it was not emailed to counsel for Samsung until the
28 afternoon of January 17, 2012. *See* Bedecarré Decl., ¶ 8, Exh. G.

1 reality, and as Samsung's counsel responded, the patents could not have "recently surfaced"
2 because the first patent was listed on Mr. Lucente's curriculum vitae provided over a month before
3 and the second was a continuation-in-part that shown on the face of the listed patent. *Id.* ¶ 9, Exh.
4 H. Nevertheless, Samsung once again provided the information Apple requested and sought
5 approval of Mr. Lucente. *Id.* Apple did not respond.

6 On January 24, 2012, Samsung's counsel asked yet again for withdrawal of Apple's
7 objections, informing Apple that it would allow Mr. Bressler to see its highly confidential
8 materials. *Id.* ¶ 10, Exh. I. Rather than reciprocate, Apple refused and stated vaguely that it had
9 "concerns regarding Mr. Lucente's ownership of pending patent applications relating to user
10 interfaces." *Id.* ¶ 11, Exh. J. Despite Samsung's repeated inquiries regarding this objection, Apple
11 has failed to offer any reason for how Mr. Lucente's pending patent application could possibly
12 harm Apple's business. Apple's only solution was to say — without any commitment or guidance
13 — that it was "willing to consider [] reasonable restrictions on the disclosure to Mr. Lucente of
14 Apple's Highly Confidential Attorneys' Eyes Only materials." *Id.*

15 Samsung tried one final time this past weekend to avoid motion practice, informing Apple
16 that it still did not understand the basis for Apple's objections and noting that Samsung could not
17 propose any limitations on Mr. Lucente's access because Apple had failed to explain its alleged
18 concerns and that Apple itself had proposed none. *Id.* ¶ 13, Exh. L. Instead of curing these
19 deficiencies, Apple then purported to state just this evening yet an entirely new objection, stating
20 *for the first time* that two websites appear to contradict the representations that Samsung and Mr.
21 Lucente have made that he no longer works or consults for HP. *Id.* ¶ 14, Exh. M. Yet again,
22 Apple's accusations are baseless. Both websites are outdated, and neither are owned or operated
23 by Mr. Lucente. The first was a page from the Industrial Designers Society of America website,
24 and plainly states at the bottom that the information was submitted on June 2, 2010, while Mr.
25 Lucente was still consulting for HP. *See id.* (citing <http://idsa.org/sam-lucente>). The second
26 website is an advertisement for a design conference that was going to happen in May 2011, and
27 states in the program that Mr. Lucente was a consultant for HP. *See id.* (citing
28 http://www.dmi.org/dmi/html/conference/europe11/s_hp.htm). Neither of these websites, even if

1 they were accurate at the time they were created, contradict Samsung's representations that Mr.
2 Lucente no longer consults for HP. In any event, this evening counsel for Samsung contacted Mr.
3 Lucente yet again and confirmed that he ended his relationship with HP in November 2010 and
4 that all the information and disclosures he has provided to Apple in response to their numerous
5 requests are accurate. *Id.* ¶ 15. Apple's newly minted objection based on such thin, facially
6 spurious "evidence" only confirms that Apple's purpose is delay and obstruction, not on any
7 legitimate concern about Mr. Lucente's abiding by the protective order.

8 **III. ARGUMENT**

9 **A. Apple Has No Legal Basis for its Objections to Mr. Lucente**

10 For an expert to opine on the design patents that Apple chose to put at issue in this case,
11 that expert should be one with knowledge of the prior art in the field. *See Egyptian Goddess, Inc.*
12 *v. Swisa, Inc.*, 543 F.3d 665, 676-77 (Fed. Cir. 2008). Issues such as functionality also are the
13 proper subject of expert testimony, since only ornamental elements are protectable. *See OddzOn*
14 *Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) (“A design patent only
15 protects the novel, ornamental features of the patented design.”). Accordingly, opinion and
16 testimony from an expert with extensive experience with mobile device and graphical user
17 interface design is warranted and key to Samsung's ability to defend itself in this litigation. Mr.
18 Lucente has these qualifications and no business conflicts with Apple.

19 Despite Samsung's forthright responses to Apple's ever evolving, irrelevant questions and
20 inappropriate delay, Apple persists in objecting to Mr. Lucente for the meritless reason that he has
21 a pending utility patent application in Europe, which relates to a U.S. patent he invented in the
22 1990s. To date, Apple has never articulated any reason why Mr. Lucente's pending utility patent
23 application should prevent him from seeing Apple's confidential material and deposition
24 testimony under the protective order. Apple is merely using Mr. Lucente's qualifications as a
25 Catch-22, blocking him from confidential Apple documents because of his highly relevant
26 experience in the design field. This is untenable and unreasonable, especially because Mr.
27 Lucente has confirmed that he does not design mobile devices for anyone, nor does he have any
28 clients who do so. Apple should not be allowed to force Samsung to defend itself against charges

1 of design patent, trademark, and trade dress infringement and also prevent Samsung from
2 mounting that defense through relevant expert testimony. And Apple's latest, eleventh hour
3 suggestion that Samsung and Mr. Lucente have lied to Apple about his representation of HP,
4 based on two outdated websites Apple found this evening, is further proof that Apple is using the
5 protective order for procedural games to obstruct and delay at any cost.

6 Apple's position is all the more frivolous because Apple is not even producing information
7 related to unreleased products or other projects in development. Instead, it has broadly refused to
8 produce such discovery and is producing documents related to technologies and designs it has
9 already released to the public. Apple cannot credibly contend that these documents are so
10 sensitive that Mr. Lucente cannot be allowed to see them. Indeed, as Samsung demonstrated on
11 the Sherman motion that this Court recently granted in the face of Apple's baseless objections to
12 him, many of Apple's internal documents relating to its design of these public products are literally
13 many years old and contain no sensitive business information. (*See* Samsung's Motion for
14 Clarification at 6, submitted under seal on January 11, 2012; *see also* Samsung's Motion for Entry
15 of a Protective Order at 3-4, submitted under seal on January 11, 2012.)

16 **B. Apple's Attempted Horse Trade Illustrates That Its Objections Are Meant to**
17 **Delay and Gain a Tactical Advantage**

18 Apple's flimsy legal ground is further belied by its "offers" to withdraw its objections to
19 Mr. Lucente if Samsung withdrew objections to Mr. Bressler. This is essentially an admission that
20 Apple had no reason to object to Mr. Lucente but was doing so only as a bargaining chip. But
21 even after Samsung withdrew its objections to Mr. Bressler, Apple reneged and continued to
22 maintain its objections merely to delay Samsung's expert from receiving essential information.
23 Such delays are unreasonable given the expedited timeframe of the litigation. With expert reports
24 due on March 22, 2012, less than two months away, these dilatory tactics are inexcusable.

1 **C. Apple Is Inappropriately Using The Protective Order To Impede Samsung**
2 **From Presenting Its Invalidity and Non-Infringement Defenses on Design**
3 **Patent and Trademark/Trade Dress Issues**

4 By prohibiting Samsung from sharing directly relevant discovery with its experts, Apple is
5 misusing the protective order to thwart Samsung's ability to defend itself on the very issues *Apple*
6 raised in its complaint. The protective order is founded on the trust the Court places on the parties'
7 outside counsel and experts to protect confidential information from being distributed
8 inappropriately. And Apple has provided Samsung with absolutely no basis for its concerns that
9 Mr. Lucente would violate the protective order or otherwise infringe on Apple's proprietary rights.
10 *See* Court Order at Dkt No. 535 at 3 n.3 (citing *Advanced Semiconductor Materials Am. Inc. v.*
11 *Applied Materials Inc.*, No. 95-20169 RMW (EAI), 1996 WL 908654 (N.D. Cal. Oct. 28, 1996)
12 and *Telular Corp. v. VOX2, Inc.*, No. 00 C 6144, 2001 WL 641188, at *1 (N.D. Ill. June 4, 2001)
13 for proposition that defendant's concern that plaintiff's expert would consult in the relevant
14 industry in the future was insufficient to deny the expert access under the terms of the protective
15 order.)

16 Apple put its interface design patents, trademarks, and trade dress at issue and has
17 produced relevant documents and testimony that it alleges are highly confidential. Apple should
18 be required to prove its case on the merits without withholding these highly relevant materials
19 from Samsung's chosen expert.

20 **IV. CONCLUSION**

21 Apple has no basis supporting its objections to the disclosure of confidential information to
22 Mr. Lucente. Nothing in this record justifies any restriction on Mr. Lucente's access to the
23 information, and Apple has already delayed too long in a case that has been expedited at Apple's
24 insistence. The Court should allow Samsung to make disclosure of confidential materials to Mr.
25 Lucente without further obstruction by Apple.

1 DATED: January 30, 2012

Respectfully submitted,

2 QUINN EMANUEL URQUHART
3 & SULLIVAN, LLP

4
5 By /s/ Michael Zeller

6 Charles K. Verhoeven

7 Kevin P.B. Johnson

8 Victoria F. Maroulis

9 Michael T. Zeller

10 Attorneys for SAMSUNG ELECTRONICS CO.,
11 LTD., SAMSUNG ELECTRONICS AMERICA,
12 INC. and SAMSUNG

13 TELECOMMUNICATIONS AMERICA, LLC
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General Order 45 Attestation

I, Victoria F. Maroulis, am the ECF user whose ID and password are being used to e-file this Declaration. In compliance with General Order 45(X)(B), I hereby attest that Michael Zeller has concurred in this filing.

/s/ Victoria Maroulis