

EXHIBIT 1

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CO., LTD., SAMSUNG ELECTRONICS

14 AMERICA, INC. and SAMSUNG

TELECOMMUNICATIONS AMERICA, LLC

16 UNITED STATES DISTRICT COURT

17 NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

18 APPLE INC., a California corporation,

19 Plaintiff,

20 vs.

21 SAMSUNG ELECTRONICS CO., LTD., a

Korean business entity; SAMSUNG

22 ELECTRONICS AMERICA, INC., a New

York corporation; SAMSUNG

23 TELECOMMUNICATIONS AMERICA,

LLC, a Delaware limited liability company,

24 Defendants.

CASE NO. 11-cv-01846-LHK

**SAMSUNG'S NOTICE OF MOTION AND
MOTION TO COMPEL PRODUCTION
OF DOCUMENTS RELATING TO
APPLE'S EFFORTS TO OBTAIN
DESIGN PATENTS RELATED TO THE
PATENTS-IN-SUIT**

Date: April 10, 2012

Time: 3:00 p.m.

Courtroom: 5, 4th Floor

Honorable Paul S. Grewal

FILED UNDER SEAL

1 **NOTICE OF MOTION AND MOTION**

2 TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

3 PLEASE TAKE NOTICE that on April 10, 2012, at 3:00 p.m., or as soon thereafter as the
4 matter may be heard by the Honorable Paul S. Grewal in Courtroom 5, United States District
5 Court for the Northern District of California, Robert F. Peckham Federal Building, 280 South 1st
6 Street, San Jose, CA 95113, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc.,
7 and Samsung Telecommunications America, LLC (collectively "Samsung") shall and hereby do
8 move the Court for an order compelling Apple Inc. ("Apple") to produce for inspection documents
9 and things in response to Samsung's Requests for Production Nos. 81, 82, 97, 98, and 362
10 including without limitation any documents relating to any Apple applications for design patents
11 related to the patents-in-suit, including those related to Apple's claimed commercial embodiments
12 of the patents-in-suit.

13 This motion is based on this notice of motion and supporting memorandum of points and
14 authorities; the declaration of Diane C. Hutnyan (the "Hutnyan Decl."); and such other written or
15 oral argument as may be presented at or before the time this motion is deemed submitted by the
16 Court.

17 **RELIEF REQUESTED**

18 Pursuant to Federal Rule of Civil Procedure 37(a)(1), Samsung seeks an order compelling
19 Apple to produce to Samsung the documents and things set forth in Samsung's Civil L.R. 37-2
20 Statement (below) by April 20, 2012.

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

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

24 **SAMSUNG'S REQUEST FOR PRODUCTION NO. 81:**

25 Prosecution histories of the APPLE IP, including all PRIOR ART cited therein, patents
26 related to the APPLE PATENTS-IN-SUIT, and any foreign counterpart patents, registrations, or
27 applications to the APPLE IP or patents related to the APPLE PATENTS-IN-SUIT, including,
28 without limitation, any reexamination and reissue applications.

1 **APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 81:**

2 [REDACTED]
3 [REDACTED]
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14 [REDACTED]
15 [REDACTED]
16 [REDACTED]

17 **SAMSUNG’S REQUEST FOR PRODUCTION NO. 82:**

18 All DOCUMENTS and things relating to the preparation, filing and/or prosecution of the
19 APPLE IP, patents related to the APPLE PATENTS-IN-SUIT, and any foreign counterpart patents
20 or patent applications to the APPLE PATENTS-IN-SUIT or patents related to the APPLE
21 PATENTS-IN-SUIT, including, without limitation, any reexamination and reissue applications.

22 **APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 82:**

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SAMSUNG’S REQUEST FOR PRODUCTION NO. 98:

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

APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 98:

[REDACTED]

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[REDACTED]

[REDACTED]

SAMSUNG’S REQUEST FOR PRODUCTION NO. 97:

All DOCUMENTS and COMMUNICATIONS concerning the patentability, novelty, scope, infringement, validity, invalidity, enforceability or unenforceability of any claim in any of the APPLE IP.

APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 97:

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

SAMSUNG’S REQUEST FOR PRODUCTION NO. 362:

All DOCUMENTS RELATING to any applications or other attempts by APPLE to obtain any design patent registration for the iPad 2, whether in a foreign country or in the U.S.

APPLE’S RESPONSE TO REQUEST FOR PRODUCTION NO. 362:

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

Samsung hereby certifies that it has in good faith conferred with Apple in an effort to obtain the discovery described immediately above without Court action. Samsung’s efforts to resolve this discovery dispute without court intervention are described in paragraphs 9-10 of the declaration of Diane C. Hutnyan, submitted herewith.

DATED: March 6, 2012

QUINN EMANUEL URQUHART &
SULLIVAN, LLP

By /s/ Victoria F. Maroulis
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LTD., SAMSUNG ELECTRONICS AMERICA,
INC., and SAMSUNG
TELECOMMUNICATIONS AMERICA, LLC

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213 F.R.D. 555 (N.D. Cal. 2003)5, 7

Tristrata Technology, Inc. v. Neoteric Cosmetics, Inc.,
35 F. Supp. 2d 370 (D. Del. 1998)7, 8

Zest IP Holdings, LLC v. Implant Direct MGG, LLC,
2011 WL 5525990 (S. D. Cal. 2011)5, 7

Statutes

37 C.F.R. § 1.566

Fed. R. Civ. P. 26(b)(1)4

Fed. R. Civ. P. 26(b)(2)4

Fed. R. Civ. P. 34(a)4

Local Rule 37-24

1 **MEMORANDUM OF POINTS AND AUTHORITIES**

2 I. **INTRODUCTION**

3 By this motion, Samsung seeks an order compelling Apple to produce any documents
4 relating to its efforts to secure design patent protection for designs related to the patents-in-suit,
5 including products Apple claims embody the patents-in-suit, such as the iPad2.

6 For example, Apple belatedly claimed during litigation of the preliminary injunction that
7 the iPad2 is a commercial embodiment of one of the design patents in suit, the D'889 patent. Its
8 motivation for doing so was to enhance its ability to contend that Samsung's Galaxy Tab 10.1
9 tablet device infringed its patent; the problem for Apple was that Samsung's product was nothing
10 like the design depicted in the D'889 patent. By claiming that the D'889 design was embodied in
11 the iPad 2, Apple argued, one could compare the iPad2 to Samsung's tablet device to analyze
12 infringement. The Court did just that in reaching its preliminary views on infringement.

13 But this has now created a dilemma for Apple. In order to secure design patent protection
14 for the design embodied in the iPad2, Apple would necessarily have to certify that the design was
15 "new" and "original" as compared to other designs, including its own previously patented designs.
16 If, as Apple has asserted in interrogatory responses and pleadings to the Court on the motion for
17 preliminary injunction, the iPad2 is a commercial embodiment of the D'889 patent, which was
18 issued back in 2005, a newly claimed design on the iPad2 can hardly be "new" and "original."
19 Thus, either the iPad2 is not, in fact, a commercial embodiment of the D'889 patent, which would
20 fundamentally undermine Apple's claims in this action, or Apple gave a false certification to the
21 Patent Office in its iPad2 design applications, and any issued patents would be invalid.
22 Regardless of which is true, documents relating to any design patents or design patent applications
23 for the iPad2, including unpublished applications, would be very relevant to determining to the
24 scope of coverage of the D'889 patent.

25 And this is just one example. [REDACTED]
26 [REDACTED]
27 [REDACTED]
28

1 Numerous courts have recognized the relevance of such documents, and Apple no longer
2 disputes that prosecution history documents related to the patents-in-suit, or related to design
3 patents or applications related to the products it has claimed are commercial embodiments, are
4 relevant to Apple's claims and Samsung's defenses in this action. With respect to the file
5 wrappers of issued patents and published applications, Apple agreed over two weeks ago to
6 produce any such materials, in particular, those relating to a published foreign application
7 claiming the iPad2 as a commercial embodiment. Yet it has not produced them.

8 In addition, Apple is refusing to produce any prosecution documents relating to any of its
9 *unpublished* applications. Apple claims that to produce these unpublished applications would
10 allow Samsung to "design around" Apple's patents, but this is absurd. The protective order in
11 this case would not allow Samsung employees or in-house lawyers to see such applications and
12 does not allow uses of produced documents other than for this litigation. And Apple's claimed
13 concern that production of documents would allow Samsung to *avoid* infringing Apple's design
14 patents – while not surprising given Apple's clear preference for litigating over competing in the
15 marketplace – is hardly a reason to withhold critical discovery.

16 II. FACTS

17 A. Apple's Claims Based on the D'889 Design Patent

18 The relevance of these prosecution documents is best illustrated with an example:

19 Among the claims being asserted in this case are infringement claims based on the D'889
20 design patent, which depicts a design for a electronic device. During the preliminary injunction
21 proceedings, Apple belatedly supplemented an interrogatory response and asserted that the D'889
22 patent was embodied in the iPad2.¹

23 In its Order denying Apple's motion for a preliminary injunction, after considering the
24 prior art cited by Samsung, the Court concluded that "Samsung has raised a substantial question
25 regarding the validity of the D'889 patent on obviousness grounds." Order at 44. The Court

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27 ¹ See Hutnyan Decl., Exh. D (Apple Inc's Amended Objections and Responses to
28 Samsung's Interrogatory No. 7 to Apple Relating to Apple Inc's Motion for a Preliminary
Injunction, at 5.)

1 also relied on a comparison between the iPad2 and Samsung's Galaxy Tab 10.1 tablet to support
2 its conclusion that "Apple will likely be able to establish infringement of the D'889 patent at
3 trial." Order at 47-48.

4 [REDACTED]
5 [REDACTED]
6 [REDACTED]
7 [REDACTED]²
8 B. Samsung's Effort To Obtain Documents Relating To Any Apple Design Patent
9 Applications For The Designs Embodied In The iPad2

10 In its initial and subsequent discovery requests, Samsung has requested that Apple produce
11 documents relating to its efforts to secure design patent protection for inventions relating to the
12 patents-in-suit, including those related to products Apple claims embody the patents-in-suit such
13 as the iPad2. With respect to the iPad2 in particular, Samsung has requested in Request 362
14 "[a]ll DOCUMENTS RELATING to any applications or other attempts by APPLE to obtain any
15 design patent registration for the iPad 2, whether in a foreign country or in the U.S."

16 Correspondence between the parties demonstrates Apple's continuing intransigence on this
17 issue.³ Samsung followed up on its Requests for Production Nos. 81 and 82 on January 16, and
18 then, after hearing no response from Apple, again on January 24.⁴ After asserting that it would,
19 at some unspecified time in the future, "update its production of applications and patents relating
20 to the patents-in-suit,"⁵ Samsung was unable to secure further promises from Apple.⁶

21 The parties met and conferred in person on February 6, when Apple agreed to inform
22 Samsung of what "specific information it is willing to provide with respect to unissued patent
23

24 ² See Hutnyan Decl., Exh. F (February 15, 2012 ITC Deposition of Christopher Stringer,
Exh. 7 at 1-2.)

25 ³ See Hutnyan Decl. ¶ 10.

26 ⁴ Hutnyan Decl., Exh. C (Letter, Scott C. Hall to Jason Bartlett, Jan. 16, 2012); *id.* (Letter,
Scott C. Hall to Jason Bartlett, Jan. 24, 2012).

27 ⁵ *Id.* (Letter, Jason Bartlett to Scott C. Hall, Jan. 30, 2012).

28 ⁶ See, e.g., *id.* (Letter, Scott C. Hall to Jason Bartlett, Feb. 3, 2012); *id.* (Letter, Jason
Bartlett to Scott C. Hall, Feb. 3, 2012) (simply reiterating that Apple would "update its production
of patents and applications").

1 applications.”⁷ Apple did not dispute that it agreed to do so, but has completely failed to provide
2 the promised information.⁸ At the next lead counsel meet and confer meeting on February 14,
3 Apple said it agreed to produce the documents relating to any design patents or *published* design
4 patent applications, including with respect to the iPad2 by Friday, February 17, 2012 -- but it has
5 yet to do so.⁹ In short, at *both* meet and confer sessions, Apple has promised to provide specific
6 information to Samsung, and Apple has failed to follow through on *both* occasions.

7 In addition to the foregoing, Apple has declined to produce any documents relating to
8 unpublished applications, claiming that Samsung has failed to satisfy the “heightened relevancy
9 standard” that it claims governs such documents, and asserting in the most recent lead counsel
10 meet and confer that it did not want such documents to be produced because that might allow
11 Samsung to “design around” Apple’s patents.¹⁰ As explained below, neither of these arguments
12 provides a valid basis to withhold this critical evidence.

13 III. LEGAL STANDARDS

14 A party is entitled to seek through discovery “any nonprivileged matter that is relevant to
15 any party’s claim or defense.” Fed. R. Civ. P. 26(b)(1). “A party may serve on any other party
16 a request within the scope of Rule 26(b): (1) to produce . . . (A) any designated documents . . . ;
17 or (B) any designated tangible things.” Fed. R. Civ. P. 34(a). “[T]he moving papers [on a
18 motion to compel] must detail the basis for the party’s contention that it is entitled to the requested
19 discovery and must show how the proportionality and other requirements of Fed. R. Civ. P.
20 26(b)(2) are satisfied.” Civil Local Rule 37-2.

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⁷ *Id.* (Letter, Diane C. Hutnyan to Jason Bartlett, et. al, Feb. 7, 2012).

24 ⁸ *See, e.g., id.* (Letter, Marc J. Pernick to Diane C. Hutnyan, Feb. 9, 2012) (setting out
25 disagreements with the Feb. 7, 2012 Diane Hutnyan letter *but making no mention of a*
26 *disagreement as to information on unissued patents*); *id.* (Letter, Jason Bartlett to Scott C. Hall,
Feb. 14, 2012) (providing disclosures but not as to unissued patents)).

⁹ *See* Hutnyan Dec. ¶ 11.

27 ¹⁰ *See* Hutnyan Decl., Exh. C (Letter, Jason Bartlett to Scott C. Hall, Feb. 3, 2012
28 (heightened relevancy standard)); *id.* (Letter, Diane C. Hutnyan to Jason Bartlett, et al, Feb. 17,
2012 (“design around” argument)).

1 IV. ARGUMENT

2 A. Apple's Patent Applications Relating To The Patents-In-Suit Or Their Claimed
3 Commercial Embodiments Are Relevant To Samsung's Defenses

4 "Many courts have concluded that [pending and abandoned patent applications] are
5 relevant because they 'may contain information or admissions that clarify, define or interpret the
6 claims of the patent in suit.'" *Caliper Technologies Corp. v. Molecular Devices Corp.*, 213
7 F.R.D. 555, 561 (N.D. Cal. 2003). *See also Zest IP Holdings, LLC v. Implant Direct MGG, LLC*,
8 2011 WL 5525990 at *1 (S. D. Cal. 2011) (same). In *Caliper*, the Court ordered the plaintiff to
9 produce pending patent applications, including unpublished applications, finding that they
10 described similar technology to that at issue in the pending action and had the same inventor as the
11 patent-in-suit. 213 F.R.D. at 561. "This and any similar application will also shed light on the
12 technology claimed in the patent-in-suit as well as the language used to claim it." *Id.*

13 Similarly, in *Zest*, the court concluded that "[t]he relevance of the patent applications is
14 obvious to the Court, as both applications make extensive reference to Plaintiffs' patents, . . .
15 which are the subject of this action. The Court does not share Defendants' restrictive view of
16 relevance that the only comparison that need be made is between Plaintiffs' patent claims and
17 Defendants' allegedly infringing products. . . . Relevant evidence regarding willful infringement,
18 prior art, and equivalency may be present within Defendants' two patent applications." 2011 WL
19 5525900 at *1.

20 Apple said it did not object to the production of documents relating to issued patents or
21 published patent applications – including with regard to the iPad2 design. But it has refused to
22 produce them, even weeks later, and should be required to produce them promptly as part of the
23 relief in this motion. Although it continues to object with regard to pending but unpublished
24 applications, there is no valid distinction for relevance purposes between published and
25 unpublished applications. As the cases above make clear, they are highly relevant to a number of
26 issues. Among other things, Samsung will defend against Apple's D'889 patent infringement
27 claims by establishing that the iPad2 is not an embodiment of the D'889 patent, contrary to what
28

1 Apple now claims, and that therefore Samsung's products should not be compared to the iPad2 in
2 order to determine whether the D'889 patent has been infringed.

3 In support of this defense, Samsung is entitled to obtain all documents relating to any
4 effort by Apple to obtain design patent protection for the iPad2, including published *and*
5 *unpublished* applications. The reason these documents are highly relevant is that any such
6 application by Apple would have had to certify that the designs that are the subject of the
7 application are "new" and "original" as compared to other designs, including its own patented
8 designs. See Hutnyan Decl., Exh. E (Excerpts from the Certified File Wrapper for U.S. Design
9 Patent D504, 889, as produced to Samsung by Apple).

10 If Apple gave a truthful certification, then the iPad2 cannot possibly be an embodiment of
11 the D'889 design, which was issued years earlier in 2005. If the iPad2 is not an embodiment of
12 the D'889 design, then the iPad2 cannot be used by Apple to support its infringement claims with
13 regard to that patent. This, in turn, would significantly undermine Apple's infringement claims,
14 given the absence of similarity between Samsung's tablet devices and the D'889 design.

15 On the other hand, if Apple continues to maintain that the iPad2 is an embodiment of the
16 D'889 patent, then its certifications in connection with any new design applications would have
17 been false, and any subsequently issued patents would be invalid on that basis.¹¹ Either way, the
18 documents relating to any applications, published or unpublished, are highly relevant to
19 Samsung's defense to the D'889 claims.

20 Similar reasoning would justify production of documents relating to patent applications for
21 any design patents relating to any other products Apple claims are embodied in the patents-in-suit
22 – whether published or not. These documents will necessarily contain admissions by Apple
23 regarding what distinguishes the patent from prior art, including other Apple patents. These
24 admissions are relevant to establish whether the patents Apple is asserting in this action satisfy the

25
26 ¹¹ Indeed, this is likely the reason Apple has not claimed the first iPad as an additional
27 embodiment of D'889. Apple has two subsequently issued patents on the iPad: D627,777 and
28 D637,596. Aside from being nearly identical, these patents preclude Apple from claiming that
the first iPad also embodies the D'889 patent. So far, Apple's ability to hide its pending U.S.
patent applications from Samsung has allowed it to avoid this problem with the iPad2.

1 novelty requirement, or are invalid under the bar against double patenting, or defenses of
2 obviousness or anticipation. These admissions will also bear directly on whether Samsung's
3 accused products infringe, as they will constitute Apple's own view of differences in features or
4 design that distinguish one patent from another. Samsung will establish that the products Apple
5 has claimed infringe are far more distinct from the patents-in-suit than the distinctions Apple has
6 articulated between its own patents and prior art.

7 B. Any Confidentiality Or Competitive Concerns Are Satisfied By The Protective
8 Order

9 In the most recent meet and confer, Apple claimed it should not have to produce the
10 unpublished application documents because these documents would allow Samsung to "design
11 around" Apple's patents. Even putting aside the reality that Apple has already disclosed these
12 patent applications to the U.S. Patent and Trademark Office, Apple's "objection" is meritless. A
13 party's concern that its opponent will use documents to avoid infringement cannot justify
14 withholding highly relevant documents where, as here, is an attorneys' eyes only protective order
15 in place. In *Zest*, for example, the court recognized that the parties were "fierce competitors" but
16 concluded:

17 this intense rivalry does not trump Plaintiffs' right and access to
18 relevant information they need to prosecute this case. The Court has
19 approved a two-tier protective Order . . . proposed by the parties in
20 this action. The Protective Order, at paragraph 4, allows the party
21 producing a document to designate the document as "Confidential"
22 and "Confidential – For Counsel Only." Moreover, the Protective
23 Order, at paragraph 22, allows a party to object to the disclosure of
24 information on any ground "other than the mere presence of
25 Confidential Information." Clearly, the parties, and especially
Defendants, in a case involving highly sensitive information
regarding products which are the life-blood of their respective
businesses, contemplated the necessity of having to release such
information to each other and took positive steps to propose such a
Protective Order. Defendants' unease with the protection provided
by the Protective Order, which was jointly submitted to the Court,
lacks justification.

26 2011 WL 5525990 at *1. The Court also rejected Defendants' argument that opposing counsel
27 may not honor the protective order, because he is a member of the same firm that prosecutes
28 Plaintiffs' patent applications. *Id.* at *2. See also *Caliper*, 213 F.R.D. at 562 (ordering

1 production of pending patent applications subject to protective order); *Tristrata Technology, Inc.*
2 *v. Neoteric Cosmetics, Inc.*, 35 F. Supp. 2d 370, 372 (D. Del. 1998) (competitor’s interest in
3 maintaining secrecy of information in pending applications “can be adequately preserved with a
4 particularized protective order”).

5 The Court has entered a two-tier protective order in this case that specifically prohibits the
6 parties from using any produced information for any purpose other than this case. And any
7 discovery materials marked “Highly Confidential – Attorneys Eyes Only” cannot be viewed by
8 any Samsung personnel, or even by outside counsel that is involved in competitive decision-
9 making. See *Apple Inc. v. Samsung Electronics Co., Ltd.*, Agreed Upon Protective Order
10 Regarding Disclosure and Use of Discovery Materials, No. 11-CV-01846, Document 687
11 (“Protective Order”), at ¶ 9 (N.D. Cal. Jan. 30, 2012). Apple’s concern that Samsung will obtain
12 and misuse the information – much less in order to *avoid* inadvertently infringing Apple’s IP – is
13 premised on multiple, solely theoretical, violations of the Protective Order, not on any legitimate
14 confidentiality concern.

15 Finally, with respect to each application that has been filed on the designs embodied in
16 the iPad2, the iPhone, the iPhone 3G, or any other products Apple has identified as its commercial
17 embodiments, the designs being claimed are already public. Again, not only has Apple disclosed
18 them to a third party – the U.S. Patent Office – but the designs are visible on the products.

19 Apple’s objection should be overruled and production of these prosecution documents
20 should be ordered without further delay.

1 V. CONCLUSION

2 For the foregoing reasons, Samsung respectfully requests that the Court grant this motion
3 and Order Apple to produce all documents relating to any efforts by Apple to obtain design
4 patents relating to the inventions of the patents-in-suit, including any related to products Apple
5 claims embody the patents-in-suit, including the iPad2.

6
7 DATED: March 6, 2012

QUINN EMANUEL URQUHART &
SULLIVAN, LLP

8
9 By /s/ Victoria F. Maroulis

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12 INC., and SAMSUNG
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