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11 Attorneys for Plaintiff and
 12 Counterclaim-Defendant APPLE INC.

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

17 APPLE INC., a California corporation,
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 Plaintiff,
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 v.
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 21 SAMSUNG ELECTRONICS CO., LTD., a
 Korean corporation; SAMSUNG ELECTRONICS
 AMERICA, INC., a New York corporation; and
 22 SAMSUNG TELECOMMUNICATIONS
 AMERICA LLC, a Delaware limited liability
 23 company,
 24
 Defendants.

Case No. 11-cv-01846-LHK (PSG)
**APPLE'S OPPOSITION TO
 SAMSUNG'S MOTION TO
 COMPEL PRODUCTION OF
 MATERIALS FROM RELATED
 PROCEEDINGS AND TO
 ENFORCE DECEMBER 22, 2011
 COURT ORDER**

1 Samsung's motion to compel "production of materials from related proceedings" jumbles
2 up four completely distinct issues:

- 3 • An unnecessary motion to enforce the Court's December 22 Order relating to
4 transcripts of prior inventor depositions. Apple has already complied with this
5 Order.
- 6 • A motion to compel Apple to produce "other documents" from proceedings
7 involving one or more of the patents-in-suit. Apple has already produced or made
8 reasonable arrangements to allow Samsung to access all such materials.
- 9 • A new motion to compel Apple to produce "documents" from other proceedings
10 involving an alleged "technological nexus" with the case. This motion is
11 overbroad, unreasonable and untimely.
- 12 • An improper motion to amend the Protective Order in either this case or the
13 pending ITC Investigation, erroneously styled as a motion to compel Apple to
14 "produce" documents from that investigation to Samsung (even though Samsung
15 already has them).

16 Apple addresses each of Samsung's motions in turn. All should be denied.

17 **I. Apple Complied with the December 22 Order**

18 Apple has complied with the December 22 Order by producing transcripts of the prior
19 deposition testimony of Apple witnesses in cases bearing a technological nexus with the instant
20 case, and by meeting and conferring with Samsung about what additional transcripts to produce.

21 In its December motion, Samsung explained that it was seeking prior transcripts of
22 witnesses in the present action for purposes of impeachment. Samsung reasoned that it is
23 "entitled to these transcripts to assess the credibility of the *witnesses testifying in this case.*" (Dkt.
24 No. 483 at 21 n.11 (emphasis added).) In support of its rationale, Samsung quoted from a case
25 that held that certain transcripts from another case were *not* discoverable because "[m]ost
26 importantly, Defendants [did] not intend to call any of these individuals to *testify in the current*
27 *proceeding.*" (*Id.* at 20-21 (citing *Inventio AG v. Thyssenkrup Elevator Am. Corp.*, 662 F. Supp.
28 2d 375, 384(D. Del. 2009) (emphasis added).) Samsung's motion made it clear that it was

1 directed towards prior deposition transcripts of Apple employees who are testifying in the present
2 action where the prior testimony was in cases bearing a technological nexus to the present action.

3 The Court's December 22 Order is consistent with this reading of Samsung's request. It
4 states:

5 3. Transcripts of Prior Deposition Testimony of **Apple Witnesses**
6 Testifying in their Employee Capacity. The court finds Apple's
7 proposed definition of "technological nexus" [n.6] to be an
8 appropriate measure under the balancing provisions of Fed. R. Civ.
9 P. 26(b)(2)(C)(iii) for the production of relevant employee
10 testimony from other actions. Apple shall apply this standard and
11 complete its production of all responsive transcripts on a rolling
12 basis and no later than January 15, 2012. To the extent that
13 Samsung identifies as relevant any cases that fall outside of Apple's
14 production as limited by the "technological nexus" standard, the
15 court will entertain a further motion to compel the production of
16 transcripts from those cases, if the parties are unable to come to an
17 agreement regarding production after engaging in appropriate meet
18 and confer.

13 (Dkt. No. 536 at 5 (emphasis added).) The Court accepted Apple's definition of cases bearing a
14 "technological nexus" as:

15 prior cases involving the patents-in-suit or patents covering the
16 same or similar technologies, features, or designs as the patents-in-
17 suit ... [W]ith respect to design patent inventors, this would include
18 prior cases involving the asserted design patents or other design
19 patents covering the same designs or design elements. With respect
20 to utility patent inventors, this would include the asserted utility
21 patents or other utility patents covering touch-based interface
22 functions, display elements, touch-screen hardware, or touch-screen
23 logic.

20 (*Id.* at 5 n.6.)¹

21 Subsequently, Apple produced all transcripts that it believed bore a technological nexus to
22 the present case. Consistent with the process the Court contemplated in its Order as quoted above

23 _____
24 ¹ Samsung's claim that Apple "finally" clarified its definition of "technological nexus" in
25 its opposition to Samsung's December 22 motion is false. (Motion at 3.) The definition proposed
26 by Apple in its opposition was a direct quote from a letter it sent weeks earlier, after Samsung
27 cited a case to Apple that appeared to use a "technological nexus" standard. (Declaration of
28 Nathan B. Sabri in Support of Apple's Opposition to Samsung's Motion to Compel Production of
Materials from Related Proceedings ("Sabri Decl.") Exs. 1, 2.) The parties also discussed this
definition in a meet-and-confer session weeks before Samsung filed its December motion to
compel. (*Id.* Ex. 3.)

1 (*Id.* at 5), Samsung identified after this production a list of cases that it believed bore a
2 technological nexus to the present case, consisting of eight cases between Apple and third parties
3 and also listing the *Apple v. Samsung* dispute currently pending before the ITC.² (Sabri Decl. Ex.
4 4.) Apple responded that Samsung’s list was overbroad, and Samsung replied to revise and
5 narrow its list. (*Id.* Exs. 5-6.) After receiving Samsung’s revised list, Apple searched for prior
6 deposition transcripts for Apple employees who are witnesses in the present matter from
7 Samsung’s list of eight cases between Apple and third parties that had not already been produced.
8 (*Id.* ¶¶ 8-9.)

9 With two exceptions, the only transcripts Apple identified that had not already been
10 produced were from depositions that occurred *after* January 15. Specifically, Apple identified
11 and produced transcripts from the following post-January 15 depositions: 1) February 22, 2012
12 deposition of Brian Huppi in ITC Investigation No. 337-TA-797; 2) February 28, 2012 deposition
13 of Freddy Anzures in *Apple v. Motorola* (N.D. Ill.); 3) February 27, 2012 deposition of Stan Ng
14 in *Apple v. Motorola*, (N.D. Ill.); and 4) January 24, 2012 deposition of Steve Hotelling in ITC
15 Investigation No. 337-TA-797. (*Id.* ¶ 10.) Apple had inadvertently not previously identified or
16 produced a transcript from the November 10, 2010 deposition of Eric Jue in ITC Investigation
17 No. 337-TA-714, which it promptly produced after receiving Samsung’s final list of “related
18 proceedings” sent on March 3. (*Id.* ¶ 11.) Apple has not produced transcripts from prior
19 depositions of Apple 30(b)(6) representative Mark Buckley. Mr. Buckley testifies for Apple
20 solely on financial issues. His testimony therefore has no technological nexus to this lawsuit.
21 (*Id.* ¶ 12.)

22 To the extent that Samsung’s motion seeks Apple to produce “all” transcripts from
23 proceedings that have an alleged “technological nexus” with the present case (not just prior
24 transcripts of Apple employees who are witnesses in this case) that request should be denied.
25 When Samsung first propounded its Request for Production No. 75, Apple objected. Over several

26
27 ² Samsung’s demand for “production” of transcripts from the ongoing ITC case in which
28 it is a party is discussed *infra*, Section IV.

1 conferences, Samsung agreed to narrow the request, specifically focusing on deposition and trial
2 transcripts that would allow Samsung to “assess [the] credibility of [Apple’s] witnesses” and
3 bearing a “technological nexus” to the issues in the litigation. (Sabri Decl. Ex. 1.) Samsung
4 never before requested that Apple produce *all* transcripts for those actions, which would not be
5 relevant to assess the credibility of Apple’s witnesses in this action. The discovery period is
6 closed and it is far too late to make such a broad request now.

7 **II. Apple Has Produced or Offered to Cooperate in Production of Documents**
8 **Relating to Litigation Involving the Patents-In-Suit.**

9 Apple has agreed to assist in the production of court documents, *Markman* filings, and
10 other documents from litigation involving the patents-in-suit. The December 22 Order directed
11 *Samsung* to obtain third party consent to the disclosure of confidential business information.
12 (Dkt. No. 536 at 2 n.1 (“The parties have initiated a process whereby *Samsung* will seek consent
13 from those third parties for Apple to produce the unredacted information”) (emphasis added);
14 Sabri Decl. Ex. 5.) Apple offered to produce promptly documents after Samsung obtained
15 necessary consents. Samsung did not *begin* to attempt to obtain such third party consent until
16 *February*. (Sabri Decl. Exs. 7-8.)

17 Samsung then *failed* to obtain such consent. Instead, Samsung purported to send (on
18 behalf of the third parties) complicated “guidelines” for redacting third party material. For
19 instance, Samsung’s letter of February 19 represented in part:

20 Google does not object to sharing any of its confidential business
21 information contained in court papers in Apple’s prior Android-
22 related actions against HTC or Motorola, on the condition that all
23 the documents are produced with the HIGHLY CONFIDENTIAL –
24 ATTORNEY’S EYES ONLY designation. Also, Google’s consent
is limited to technical materials, such as those regarding validity
and infringement issues, and does not extend to any documents
concerning purely business information such as agreements with
OEMs.

25 * * *

26 Motorola will not consent to the disclosure of its confidential
27 business information. Therefore, please redact all Motorola
28 confidential business information from the materials Apple will
produce from the 15 identified actions and produce it.

1 (Id. Ex. 8.)

2 Apple never agreed to perform detailed redactions of third party confidential information
3 according to instructions received second-hand through Samsung’s counsel. Nor did the Court
4 direct Apple to do so. The Court’s December Order directed Samsung to obtain *consent to*
5 *produce*. Two months later, having failed in its mission, Samsung purported to put Apple in an
6 untenable position—one which would at best have been a huge distraction from Apple’s efforts to
7 conclude discovery.

8 There is a simpler way. Samsung’s counsel in this action, Quinn Emanuel, also represents
9 Motorola and HTC in the pending overlapping cases. Charles Verhoeven, lead counsel for
10 Samsung in this case, is lead counsel in all of them. In effect, Samsung is asking Apple to collect
11 documents already sitting in one pile on Mr. Verhoeven’s desk (the “HTC” pile, for example) and
12 “produce” them back to Mr. Verhoeven so he can put copies of them in a different pile on his
13 desk (the “Samsung” pile). There is no reason why Mr. Verhoeven cannot more reliably and
14 efficiently do that himself. Indeed, Apple understands that is exactly the system Quinn Emanuel
15 agreed to in the HTC case. As Apple wrote in letter of February 29:

16 A more logical and efficient approach would be for Samsung’s
17 counsel to implement the redactions itself. . . . Quinn Emanuel has
18 received instructions from HTC, Motorola and others regarding the
19 redactions they are requested to make. Quinn Emanuel is thus in the
20 best position to prepare redacted documents, consistent with the
21 instructions its clients have provided.

22 In fact, we understand that this exact process has been agreed to in
23 the *HTC* case. In that case, Quinn Emanuel agreed to provide
24 Apple a list of documents that it intends to redact and produce.
25 Apple will review the list and, barring any objections, promptly
26 give written permission for the production of materials.

27 (Sabri Decl. Ex. 5.) Had Samsung taken Apple up on this offer, it would have had the requested
28 materials already in hand by the time it filed its motion to compel on March 8.

29 **III. Apple Should Not Be Required to Produced Litigation Documents (Other
30 Than Transcripts) from Other Cases Having a “Technological Nexus”**

31 Samsung further asks the Court to compel Apple to produce “other materials” from
32 proceedings that bear a technological nexus to this action. Samsung defines “other materials” to

1 include deposition transcripts from witnesses other than Apple employees, affidavits and
2 declarations, expert reports, claim construction briefing, other pleadings, hearing transcripts, and
3 court rulings. Samsung's request should be rejected because it is untimely and overbroad.
4 Samsung slips this broad request into two paragraphs of its motion on page 12. It fails to explain
5 why it did not request production of these materials in connection with its December motion. It
6 fails to explain why the first time Samsung *ever* mentioned production of "all documents" from
7 litigation involving an alleged "technological nexus" was in a footnote in a February 13, 2012
8 letter. (Sabri Decl. Ex. 4.)

9 Once again, Samsung is attempting to engage in a fishing expedition for documents
10 having no relationship to the case at issue with no basis other than the mere surmise that relevant
11 statements might have been made. Such discovery is not allowed under the Federal Rules of
12 Civil Procedure. Fed. R. Civ. P. 26(b)(2)(C) (instructing the court to limit discovery if it
13 determines that, among other things, "the discovery sought is unreasonably cumulative or
14 duplicative" or "the burden or expense of the proposed discovery outweighs its likely benefit.");
15 *see also Inventio AG v. Thyssenkrupp Elevator Americas Corp.*, 662 F. Supp. 2d 375, 381
16 (D. Del. 2009) (noting that rule 26(b)(2)(C) imposes a balancing test).

17 Samsung waited until *the day before the close of discovery* to move to compel Apple to
18 produce this broad new category of documents. Samsung's motion would have been improper
19 whenever it was brought, and it is certainly improper when brought at the very conclusion of
20 discovery.

21 **IV. Samsung Already Has All Documents From the 796 ITC Investigation**

22 Finally, Samsung moves to compel Apple to "produce" transcripts and other materials
23 from the Investigation Regarding Certain Electronic Digital Media Devices (Apple v. Samsung),
24 337-TA-796 (ITC) ("the 796 ITC Investigation"). *Samsung already has those materials* because
25 it is a party to the Investigation. There is nothing for Apple to "produce."

26 Of course, Samsung does not actually want Apple to "produce" the materials. It wants
27 Apple to "re designate" materials already produced in the ITC action. The parties have agreed to
28 allow documents produced in the ITC action to be used in the Northern District of California

1 action, and vice versa, and have used documents accordingly. (Sabri Decl. ¶ 15.) The parties
2 have *not* agreed to cross-use of deposition transcripts. (*Id.*) In fact, when the parties filed
3 competing motions for entries of a Protective Order before this Court, *both parties'* Proposed
4 Protective Orders set out explicitly that deposition transcripts were not covered by the parties'
5 cross-use agreement. (*See* Dkt. No. 607-2 at 33 (Samsung's Proposed Protective Order), Dkt. No.
6 599-7 at 31 (Apple's Proposed Protective Order) (both stating, "This cross-use provision also
7 does not apply to other forms of discovery, including, without limitation, deposition
8 transcripts[.]").) As a result, the active Protective Order that the Court entered explicitly states
9 that the cross-use provision extends to documents, but not deposition transcripts. (Dkt. No. 687 at
10 33.) Similarly, the ITC Protective Order prohibits cross-use of transcripts. Samsung's motion to
11 compel is a transparent attempt to circumvent this intentional distinction between cross-use of
12 documents and cross-use of transcripts.

13 The distinction is *critical* to keeping the parties honest with respect to discovery limits.
14 (Sabri Decl ¶ 15.) The Northern District of California action has a 250 hour limit on depositions.
15 (*Id.*) The ITC Investigation has *none*. (*Id.*) In the ITC, there are *no* limits on the number of
16 depositions and *no* limits on the length of time depositions can run. (*Id.*) If the parties were
17 allowed freely to use ITC deposition transcripts in the Northern District of California action, the
18 250 hour limit on deposition time would become virtually a dead letter. The parties could easily
19 have circumvented limits by taking depositions in the ITC Investigation and "cross-using" those
20 depositions here in the Northern District of California.

21 If Samsung wishes to bring a motion to amend the Protective Order, whether before this
22 Court or the ITC, processes exist for doing so. There is no basis for its present "motion to compel
23 production," however. Samsung already has the documents it seeks.

24 CONCLUSION

25 Samsung's motion should be denied.
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MORRISON & FOERSTER LLP

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APPLE INC.