

United States District Court
For the Northern District of California

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

APPLE INC., a California Corporation)
)
 Plaintiff,)
)
 v.)
)
 SAMSUNG ELECTRONICS CO., LTD, a)
 Korean corporation; SAMSUNG)
 ELECTRONICS AMERICA, INC., a New York)
 corporation; and SAMSUNG)
 TELECOMMUNICATIONS AMERICA, LLC,)
 a Delaware limited liability company,)
)
 Defendants.)

Case No.: 12-CV-00630-LHK (PSG)
**ORDER GRANTING-IN-PART
APPLE’S MOTIONS TO COMPEL**
(Re: Docket Nos. 96, 99, 135)

In this patent infringement suit, Plaintiff Apple Inc. (“Apple”) moves to compel Defendants Samsung Electronics Co., LTD., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively “Samsung”) to respond to interrogatories and produce documents relevant to Apple’s discovery requests. Apple also moves to compel third-party Google to produce documents relevant to Apple’s request for production, and for Google to make a 30(b)(6) witness available to Apple for deposition. On May 1, 2012, the court heard oral argument

1 on Apple's discovery motions. Having considered the arguments and evidence presented, the court
2 hereby GRANTS-IN-PART Apple's motions.

3 **I. BACKGROUND**

4 *A. Apple's Motion to Compel Responses to Interrogatory Nos. 4 and 8-10*

5 On February 8, 2012, Apple filed a complaint for patent infringement and a motion for a
6 preliminary injunction seeking to enjoin Samsung from making, using, offering to sell, selling
7 within the United States, or importing into the United States, Samsung's Galaxy Nexus
8 smartphone.¹ The parties are in the midst of active preparations for the June 7, 2012 hearing on
9 Apple's pending Motion for a Preliminary Injunction. On March 6, 2012, Apple served Samsung
10 ten interrogatories pertaining to its Preliminary Injunction Motion.² Samsung responded to Apple's
11 interrogatories on March 27, 2012, but did not respond to Interrogatory Nos. 4 and 8-10.³

12 Interrogatory No. 4 asks about Samsung's knowledge of the four Apple utility patents at
13 issue in the Preliminary Injunction (the "Preliminary Injunction Patents"), and any Samsung efforts
14 to avoid infringement. Interrogatory No. 8 asks about any comparison Samsung made between any
15 Apple product and any Samsung smartphone or tablet computer. Interrogatory No. 9 asks about
16 Samsung's discussions regarding the relationship between the features accused of infringing the
17 Preliminary Injunction Patents and consumer preference for these features. Interrogatory No. 10
18 asks about Samsung's discussions regarding the Preliminary Injunction Patents and their
19 implementation into any Samsung product. Samsung objects to Interrogatory No. 4 on the grounds
20 that Samsung's knowledge of the Preliminary Injunction Patents, and its efforts to design around
21
22
23

24 _____
25 ¹ See Docket Nos. 1 (Compl.) and 10 (Mot. for Prelim. Inj.).

26 ² See Docket No. 96 (Apple Mot. to Compel) at 3.

27 ³ See *id.*

1 them, are irrelevant to Apple's Preliminary Injunction Motion.⁴ Samsung objects to Interrogatory
2 Nos. 8-10 on the grounds that they are not limited to the Galaxy Nexus smartphone.⁵

3 *B. Apple's Motion to Compel Production of Documents Nos. 8, 16, 18, 21-22, 45, 48-50, 53-*
4 *55, 57, 59, 61-64, 67, 68, 70, 72, 74, 75, 77, 79, 81, and 91*

5 On March 6, 2012, Apple served Samsung with 91 document requests in its First Set of
6 Preliminary Injunction Requests for Production of Documents.⁶ Samsung responded on March 27,
7 2012, but refused to respond to the requests set forth in the subsection heading.⁷

8 Request Nos. 8, 21 and 22 seek documents that identify Samsung employees intimately
9 involved with entering text in applications, Samsung's discussions regarding the Android 4.0 Ice
10 Cream Sandwich, and Samsung's discussions with third-parties regarding the Galaxy Nexus.⁸
11 Samsung objects to these three requests, in relevant part, because they are not limited to the Galaxy
12 Nexus and its four accused features.⁹

13 Request Nos. 16 and 18 seek documents regarding Samsung's efforts to avoid infringing
14 the Preliminary Injunction Patents, and documents relating to Android-supported Samsung
15 products that also discuss the redesign of any Samsung product in light of Apple products.¹⁰
16 Samsung objects to Request No. 16 because copying is irrelevant to liability for patent
17

18
19 ⁴ See Docket No. 104 (Samsung Opp. to Mot. to Compel) at 1-2.

20 ⁵ See *id.*

21 ⁶ See Docket No. 99 (Apple Mot. to Compel) at 3.

22 ⁷ Apple originally claimed that Samsung also failed to respond to Request No. 15. In its
23 Opposition, Samsung claims that it changed its mind and produced documents responsive to
24 Request No. 15. Apple's Reply does not dispute this. The court therefore will not address this
25 request.

26 ⁸ See Docket No. 99 (Apple Mot. to Compel).

27 ⁹ See Docket No. 103 (Samsung Opp. to Mot. to Compel) at 9-10.

28 ¹⁰ See Docket No. 99 (Apple Mot. to Compel).

1 infringement, and to Request No. 18 because it does not relate to the Samsung Galaxy Nexus and
2 the Preliminary Injunction Patents.¹¹

3 Request Nos. 45, 48-50, 53-55, 57, 59, 61-64, 67, 68, 70, 72, 74, 75, 77, 79, and 81 seek, in
4 relevant part, documents relating to the “sale of smartphones” and “competition between Apple and
5 Samsung.”¹² Samsung objects to these requests on the grounds that they seek documents regarding
6 all Samsung smartphones and tablets, rather than documents cabined to the Galaxy Nexus.¹³

7 Request No. 91 seeks documents regarding instances of consumers confusing an Apple product for
8 the Galaxy Nexus, or vice versa.¹⁴ Samsung objects to this request because consumer confusion is
9 irrelevant to Apple’s Preliminary Injunction Motion—Samsung argues that the Galaxy Nexus may
10 properly be compared to the Preliminary Injunction Patents only, and not to “the commercial
11 embodiment of the patentee’s products.”¹⁵

12 *C. Apple’s Motion to Compel Certain Discovery from Third-Party Google*

13 Apple claims that after conferring with Samsung, Apple learned that certain responsive
14 documents were in Google’s possession.¹⁶ Apple thereafter served Google with a subpoena dated
15 April 5, 2012. The subpoena contains twelve requests.¹⁷

16 Requests Nos. 1 and 2 request a copy of the Android source code as provided to Samsung,
17 and a copy of the source code as implemented by Samsung in the Galaxy Nexus.¹⁸ Request No. 3
18 seeks documents sufficient to show the difference between the Android code provided to Samsung,

19 _____
20 ¹¹ *See id.*

21 ¹² *See* Docket No. 103 (Samsung Opp. to Mot. to Compel) at 5.

22 ¹³ *See id.* at 5-6.

23 ¹⁴ *See id.* at 8.

24 ¹⁵ *See id.*

25 ¹⁶ *See* Docket No. 135 (Apple Mot. to Compel) at 1.

26 ¹⁷ *See id.*

27 ¹⁸ *See id.* at 4.

1 and the publically available open source Android 4.0 Ice Cream Sandwich source code.¹⁹ Requests
2 Nos. 4-12 seek documents regarding communications between Samsung and Google on the
3 following topics: Android, Apple's products, the accused features and their implementation,
4 design-around efforts, analysis of Apple products, and consumer behavior regarding not only the
5 accused features, but also searching the Internet on a mobile device.²⁰ Apple also served Google
6 with a Notice of Deposition on April 5, 2012.²¹ In it, Apple requested that Google make a 30(b)(6)
7 witness available to testify concerning these twelve categories.²² Google objects to Apple's
8 requests to the extent Apple seeks documents or information beyond the functionalities accused in
9 Apple's Preliminary Injunction Motion.²³

10 On May 3, 2012, Apple filed a Supplemental Declaration in Support of its Motion to
11 Compel Discovery from third-party Google.²⁴ In it, Apple claims Google failed to provide its
12 source code expert with information sufficient to complete his analysis. Apple also claims Google
13 failed to load software programs vital to its expert's review on the machine that houses this code,
14 as well as the publicly available version of the Android code. Google, in its May 4, 2012 response,
15 argues that it has provided the source code pursuant to the terms of the protective order, and thus is
16 in compliance with the court's orders.²⁵ Google also urges the court to deny Apple's Request No.
17 3, which seeks documents sufficient to show the difference between the Android source code
18

19 ¹⁹ *See id.*

20 ²⁰ *See id.*

21 ²¹ *See id.*

22 ²² *See id.* at 16-17.

23 ²³ *See* Docket No. 142 (Google Opp. to Mot. to Compel) at 1-3.

24 ²⁴ *See* Docket No. 155 (Supplemental Decl. in Support of Apple's Motion).

25 ²⁵ *See* Docket No. 158 (Google's Resp. to Supplemental Decl. in Support of Apple's Motion) at 2.
26
27

1 provided to Samsung, and the publically available open source Android 4.0 Ice Cream Sandwich
2 source code.²⁶

3 II. LEGAL STANDARDS

4 Parties may obtain discovery regarding any nonprivileged matter that is relevant to any
5 party's claim or defense. Relevant information need not be admissible at trial if the discovery
6 appears reasonably calculated to lead to the discovery of admissible evidence. The court must limit
7 the frequency or extent of discovery if it is unreasonably cumulative or duplicative, or can be
8 obtained from some other source that is more convenient, or the burden or expense of the proposed
9 discovery outweighs its likely benefit.²⁷ Upon a showing of good cause, “the court may order
10 discovery of any matter relevant to the subject matter involved in the action.”²⁸

11 III. DISCUSSION

12 Apple’s Preliminary Injunction Motion seeks to halt Samsung from selling its Galaxy
13 Nexus smartphone during the course of this litigation.²⁹ Apple’s Motion accuses Samsung of
14 infringing four Apple patents claiming “key” product features, which include “Slide to Unlock,”
15 “Text Correction,” “Unified Search,” and “Special Text Detection.”³⁰

16 At their heart, each of these discovery disputes, whether between Apple and Samsung, or
17 Apple and Google, involves a fundamental disagreement over the scope of Preliminary Injunction
18 discovery and the order by the presiding judge setting the briefing and hearing schedule for the
19 Preliminary Injunction: “The parties may obtain discovery *relevant to the preliminary injunction*

20
21
22 _____
23 ²⁶ See *id.* at 4.

24 ²⁷ See generally Fed. R. Civ. P. 26.

25 ²⁸ Fed. R. Civ. P. 26(b)(1).

26 ²⁹ See Docket No. 10 (Apple Mot. for Prelim. Inj.).

27 ³⁰ See *id.*

1 *motion*. . . . The Court encourages the parties to make all efforts to keep discovery requests
2 reasonable in scope and *narrowly tailored to address the preliminary injunction motion*.³¹

3 Apple argues that inquiries outside of the Galaxy Nexus and its four accused features are
4 nevertheless relevant to the Preliminary Injunction analysis. For example, Apple argues that if the
5 accused features appeared earlier on a Samsung product, information about this earlier iteration of
6 the feature is materially relevant to its cause, as is the same feature in an accused product. Apple
7 also urges that a wider net is necessary to highlight for the court the systematic and widespread
8 effort Samsung has made to copy Apple products. Samsung responds by highlighting the
9 overwhelming burden that would be imposed by Apple's demands.

10 Because the parties require a resolution to their dispute on an expedited basis, the court will
11 keep its analysis brief. While Apple's argument is conceptually appealing, Apple offers no basis
12 upon which the court could reasonably limit Samsung's burden. In other words, the court can think
13 of no line it could draw, other than one focused on the accused features, that would respect the
14 norms of proportionality applicable under Rule 26 even in a well-resourced, high-stakes case like
15 this. Because Apple's Preliminary Injunction Motion is targeted to Samsung's Galaxy Nexus and
16 the four accused features, Apple is entitled to take discovery on the four accused features as they
17 are contained on that device. But to the extent Apple's Preliminary Injunction discovery requests
18 extend beyond the scope of the Galaxy Nexus smartphone and the four accused features, such
19 discovery is properly left until after the Preliminary Injunction Motion is resolved.³²

20
21 _____
22 ³¹ Docket No. 37 (Order Setting Br'ing and Hr'ing Schedule) (emphasis added).

23 ³² Apple cites no case law to support its assertion that all evidence of copying is rightfully within
24 the scope of Preliminary Injunction discovery. Evidence of copying in general is therefore outside
25 the scope of Preliminary Injunction discovery. At the same time, evidence of copying the four
26 accused features contained in the Samsung Galaxy Nexus is properly within the scope of
27 Preliminary Injunction discovery. Indeed, Samsung has already admitted as much. *See Apple Inc. v.*
28 *Samsung Elecs. Co.*, Case No. C 11-1846 LHK (PSG), 2011 U.S. Dist. LEXIS 110616, at *8 (N.D.
Cal. Sept. 28, 2011) (“[W]illful infringement, including deliberate copying, may be relevant to a
preliminary injunction motion . . .”).

1 For the same reasons, Apple may take discovery from Google to the extent its requests
2 address the Galaxy Nexus smartphone and the four accused features as they are implemented in
3 that device. Google also shall make available for deposition the five declarants who submitted
4 declarations supporting Samsung's opposition to Apple's Motion for a Preliminary Injunction who
5 have not yet sat for deposition, as well as the 30(b)(6) witness Apple has requested. Google also
6 shall produce to Apple documents relevant to each deposition at least 72 hours before the dates set
7 for each witness's deposition. Any witness who has already been deposed may be deposed again
8 for three hours after the production of relevant documents. Google shall identify any Android
9 version whose source code is produced to Apple with the specificity Apple requests in its papers,
10 and shall load the publicly available version of the source code onto the same machine. Finally,
11 Google shall load Cygwin and software with the ability to compare the relevant source code
12 versions.

13 **V. CONCLUSION**

14 In accordance with the foregoing and subject to the limitations outlined above, the court
15 GRANTS-IN-PART Apple's motions to compel responses and production from Samsung, and
16 GRANTS-IN-PART Apple's motion to compel production and deposition testimony from Google.
17 Samsung and Google shall comply with this order as follows: All interrogatory responses and
18 documents shall be produced no later than May 6, 2012. All depositions shall take place no later
19 than May 11, 2012.

20 **IT IS SO ORDERED.**

21 Dated: 5/4/2012

22 
23 PAUL S. GREWAL
24 United States Magistrate Judge