

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA**

CASE NO.: 1:10-CV-23580-UU

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MOTOROLA MOBILITY, INC.,)
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Plaintiff,)
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v.)
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APPLE INC.,)
)
Defendant.)
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APPLE INC.,)
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Counterclaim-Plaintiff,)
)
v.)
)
MOTOROLA, INC. and)
MOTOROLA MOBILITY, INC.,)
)
Counterclaim-Defendants.)
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**DEFENDANT AND COUNTERCLAIM-PLAINTIFF APPLE INC.'S RESPONSE TO
THE COURT'S OCTOBER 24, 2011 ORDER AND NOTICE OF FILING OF
MOTOROLA'S MAY 18, 2011 INFRINGEMENT CONTENTIONS**

In compliance with the Court's October 24, 2011 Order (D.E. 157), Defendant and Counterclaim-Plaintiff Apple, Inc. ("Apple") today filed under seal a copy of its infringement contentions, which were served on May 18, 2011 in accordance with the agreement of the parties and this Court's subsequent June 1, 2011 Order.¹

Apple has briefly reviewed Motorola's submission of today's date, which seeks to supplement Motorola's May 18, 2011 infringement contentions. Motorola's submission is not in compliance with the Court's October 24, 2011 Order, nor does it show "good cause" why Motorola should be permitted to supplement its contentions at this time. *See* Fed. R. Civ. P. 16(b)(4) ("A schedule may be modified only for good cause and with the judge's consent"). Instead, Motorola unilaterally filed its amended infringement contentions without the Court's consent. Apple, therefore, intends to file a motion to strike the submission.²

The Court-ordered deadline for infringement contentions, which does not provide for supplementation, passed almost five months ago, on June 1, 2011. *See* D.E. 88, Order on Motion to Modify Scheduling Order and Modified Scheduling Order. Motorola failed to supplement its infringement contentions by that Court-ordered deadline, and it would prejudice Apple to allow Motorola to add new products and infringement theories to the case now, especially as the parties' claim construction disputes have been fully briefed and a *Markman* hearing has already been held.

¹ The parties filed a joint motion to extend the case schedule on April 25, 2011. *See* D.E. 77. While awaiting the Court's ruling, the parties agreed to exchange infringement contentions on May 18, 2011. When the Court granted the joint motion (*see* D.E. 88), June 1, 2011 became the operative deadline for infringement contentions, but both parties chose to stand on their May 18, 2011 infringement contentions and did not supplement those disclosures on June 1, 2011.

² Motorola's May 18, 2011 infringement contentions are attached as Exhibit 1.

Pursuant to Federal Rule of Civil Procedure 16(b)(4), a showing of “good cause” is required to modify the Court’s scheduling order. Further, the Patent Local Rules of various jurisdictions also require a party requesting leave to supplement infringement contentions to show “good cause,” which the Federal Circuit has stated requires a showing that the party was diligent in amending its contentions. *See O2 Micro Int’l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1366 (Fed. Cir. 2006).³ Otherwise, as one court cautioned, “[p]arties would be encouraged to adopt a ‘rolling’ approach to infringement and invalidity contentions in the hope of hiding their true intentions until later in a case.” *Nike, Inc. v. Adidas Am. Inc.*, 479 F. Supp. 2d 664, 670 (E.D. Tex. 2007).

There is no good cause for Motorola’s supplementation, as Motorola cannot possibly show diligence in seeking discovery in this case, nor has it offered any explanation for its lack thereof. At the *Markman* hearing, Motorola implied that it did not have access to sufficient information to provide its final infringement contentions by the Court’s deadline. *See Markman Hrg. Tr* at 748:8-13. Contrary to Motorola’s representation, however, Motorola had access to an abundant amount of Apple confidential information relevant to the issues in this case before the jointly agreed deadline.⁴

Motorola filed this suit on October 6, 2010, and served its *only* set of document requests

³ The court in *O2 Micro* analyzed the patent local rules for the Northern District of California. 467 F.3d at 1362. Although the Southern District of Florida has not adopted patent local rules, at least one Southern District of Florida court found “the local patent rules of these other districts to provide instructive insight into identifying proper topics of discovery unique to a patent suit, and suggesting the correct sequencing of such discovery.” *Suncast Techs., LLC v. Patrician Prods., Inc.*, Case No. 07-80414-CIV, 2008 U.S. Dist. LEXIS 5072 at *27-28 (S.D. Fla. Jan. 17, 2008).

⁴ Motorola also suggests that Apple characterized its infringement contentions as “preliminary” and indicated that Apple would supplement its contentions as additional discovery becomes available. The Court’s Order setting the deadline for infringement contentions, however, does not provide for supplementation. It unambiguously states that the deadline for infringement contentions is June 1, 2011. Moreover, Apple has not sought to supplement its contentions.

on December 29, 2010. Apple timely responded to Motorola's requests on January 31, 2011. On March 23, 2011, the parties entered into a cross-use agreement, whereby documents produced in any action currently pending between Apple and Motorola could be used as if the documents had been exchanged in this proceeding. *See* D.E. 69, Joint Protective Order at ¶ 1. The parties agreed that allowing cross-use between cases would be the most efficient use of resources, given the overlap of accused products and technical issues between the various litigations. By May 18, 2011, Apple had already produced over 8,000,000 pages of documents to Motorola across the pending litigations.

With knowledge of the cross-use agreement and the vast volume of documents produced in the pending litigations, on April 25, 2011, the parties jointly agreed to exchange "element-by-element infringement contentions" by June 1, 2011. *See* D.E. 77, Joint Motion for Setting of Contention Deadlines and for Extending Claim Construction Briefing Deadlines. Thereafter, the parties continued to produce documents relevant to this case. Motorola, therefore, had a tremendous amount of discovery from Apple from which it could prepare infringement contentions before the Court-ordered deadline.

Moreover, even if the voluminous material produced by Apple prior to June 1 was insufficient, Motorola cannot show diligence in seeking any additional discovery in this case. Indeed, it appears that Motorola did not even review Apple's document production until August 17, 2011. Only then—over seven months after Motorola served its discovery requests and over two months after the Court's deadline for serving infringement contentions—did Motorola first complain about alleged deficiencies in Apple's production.⁵ In fact, Motorola did not take a

⁵ When Apple promptly responded that the cross-use agreement allowed the parties to rely on materials produced in other actions, however, Motorola did not press the issue.

single deposition relating to its patents or the Apple accused products before the Court's June 1, 2011 deadline and did not serve its Rule 30(b)(6) deposition notice until the end of July. Simply put, Motorola failed to diligently take discovery prior to the Court-ordered deadline of June 1, 2011.

Even if Motorola could demonstrate the requisite diligence (which it cannot), supplementation of Motorola's infringement contentions at this time would prejudice Apple and create great inefficiencies for the Court. The parties jointly proposed that the Court enter a deadline for infringement contentions "[t]o streamline the claim construction process in this case." *See* D.E. 77, Joint Motion for Setting of Contention Deadlines and for Extending Claim Construction Briefing Deadlines. As noted above, the *Markman* process in this case is nearly complete. Apple has relied upon Motorola's May 18, 2011 infringement contentions to prepare its invalidity contentions, formulate its non-infringement defenses, and advance its claim construction positions. Were Motorola to revise its infringement contentions now, Apple likely would be required to revise its defensive strategies to cure any potential prejudice, resulting in much wasted effort to date on the part of the Court and the parties.

Accordingly, Apple respectfully requests that the Court reject Motorola's attempt to supplement its infringement contentions in violation of the Court-ordered June 1, 2011 deadline.

Dated: October 28, 2011

Respectfully submitted,

/s/ Christopher R. J. Pace

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CERTIFICATE OF SERVICE

I hereby certify that on October 28, 2011, I filed the foregoing document with the Clerk of the Court. I also certify that the foregoing document is being served this day on all counsel of record identified on the attached Service List via email and CM/ECF.

/s/ Christopher R. J. Pace

Christopher R.J. Pace (Fla. Bar No. 0721166)

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