

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

**Case No. 1:10cv023580-Civ-RNS-TEB**

MOTOROLA MOBILITY, INC.,

Plaintiff,

v.

APPLE INC.,

Defendant.

**JURY TRIAL DEMANDED**

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APPLE INC.,

Counterclaim Plaintiff,

v.

MOTOROLA, INC. and  
MOTOROLA MOBILITY, INC.,

Counterclaim Defendants.

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**MOTOROLA'S OPPOSITION TO APPLE'S  
MOTION TO COMPEL RESPONSES TO INTERROGATORIES NOS. 7 AND 12  
REGARDING PRODUCTS EMBODYING MOTOROLA'S ASSERTED PATENTS**

## I. INTRODUCTION

Apple asks this Court to compel Motorola to supplement its responses to Apple's Interrogatory Nos. 7 and 12 (DE 225), which seek sweeping information about which of *all* of Motorola's products embody Motorola's asserted patents. Both interrogatories seek enormous amounts of information about Motorola's products that are not accused in this litigation, far in excess of what is relevant to either parties' claims and defenses. Apple asserts that it needs the information in its interrogatories to determine if Motorola has marked any embodiments with the numbers of the patents at issue in this case. But this argument is a red herring—Motorola already has admitted that it is not aware of having marked *any* of its products with the patents at issue.

Moreover, responding to these Interrogatories would require massive efforts on behalf of Motorola and its counsel. Motorola's asserted patents date back nearly two decades, during which time Motorola has had hundreds of products, in dozens of product lines, in numerous product divisions. To go back and identify every product Motorola has sold since its earliest asserted patent was filed, and make an analysis of whether each one meets every limitation of any of the 20 asserted claims of each of its six asserted patents, would alone take hundreds if not thousands of hours. And then on top of this, Apple seeks voluminous additional information about each such product, including names of persons with knowledge, prices of sales or offers for sale, and the identification of relevant documents. Even if it could be done, the task of responding to these requests would more than require the full time effort of all of Motorola's inside and outside counsel throughout the entire period of fact discovery.

Indeed, Apple's own arguments in another forum make clear Apple's overreaching here. In opposing a motion to compel this same information from Apple, Apple argued that such information is overbroad and irrelevant, relying on the same authority it cites now to support the

*opposite* position. Apple’s assertion that the information it seeks is “basic” and “vital to its defenses” (DE 225 at 1) therefore falls flat. The caselaw cited by Apple is inapposite, and does not hold that discovery of information about all embodying products is appropriate.

Accordingly, Apple’s Motion to Compel should be denied.

## II. **STATEMENT OF FACTS**

Interrogatory Nos. 7 and 12 from Apple’s First Set of Interrogatories to Motorola both request information about “all of [Motorola’s] products that embody its asserted patents.” (DE 225 at 8.) Motorola accordingly attempted to identify such products. However, when it recognized the enormous burden of doing so, and the fact that most such products would be irrelevant to both of the parties’ claims and defenses, Motorola met and conferred with Apple in an attempt to limit the number of embodying products to be identified. (*See* DiMuzio Decl. Ex. 17). At the same time, Motorola nonetheless identified numerous representative embodying products. (*See* DiMuzio Decl.<sup>1</sup> Ex. 6, 7). Motorola informed Apple that all of its products using the Android operating system or the Android Marketplace embodied certain of its patents. (*Id.*) As discovery continued, Motorola also explained that it would identify all of the Motorola embodying products on which Motorola would rely for its contentions in this litigation. (*See* DiMuzio Decl. Ex. 12).

Nonetheless, during further meet-and-confer efforts, Apple maintained that it would not further narrow the number of embodying products to be identified, relying on the cases cited in its Motion, *Facebook* and *Aristocrat*. (*See* DiMuzio Decl. Ex. 17). Motorola disputed Apple’s characterization of those cases, and countered that neither case offers support for the extensive discovery that Apple seeks. (*Id.*) Although the information Motorola already provided

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<sup>1</sup> “DiMuzio Decl.” refers to the Decl. of Elena DiMuzio in Support of Apple’s Motion to Compel.

substantively responds to Apple’s request for embodying products, in a continued attempt at cooperation, Motorola reiterated that it was still amenable to finding a compromise. (*Id.*) Apple however refused to further narrow its requests, and persisted in seeking the far-reaching and irrelevant discovery that it now asks the Court to compel.

### III. ARGUMENT

#### A. **Apple’s Interrogatory No. 12, Seeking All Devices that Embody Motorola’s Patents and that Are Not Accused in this Case, is Improper and Objectionable**

Apple seeks information from Motorola “identifying all of [Motorola’s] own products that embody or embodied any asserted claim of its asserted patents.” (DE 225 at 8.) Apple’s Interrogatory, however, is overbroad, unduly burdensome, and seeks irrelevant information.<sup>2</sup>

##### 1. *Information About All Motorola Products Embodying its Patents is Irrelevant*

Apple bases its entitlement to the information in Interrogatory No. 12 on two legal theories, asserting that all of Motorola’s embodiments are relevant: (1) to determine whether Motorola should be barred from recovering damages, for failure to mark its products; and (2) to assess “reasonably royalty” damages under *Georgia-Pacific Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970). However, most of the information sought by Apple’s Interrogatory lacks any relevance under either theory.

First, despite Apple’s claim that “[w]hether any of Motorola’s unmarked products practiced the Patents-in-Suit” is of “paramount importance” to damages under § 287 (DE 225 at

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<sup>2</sup> Although Apple notes that Motorola complained about the burden of identifying all of its embodying products, it argues that Motorola waived any objection to overbreadth or undue burden for not raising them in its response. But this is not so, as Motorola raised them in its General Objections, incorporated into its Response to Interrogatory No. 12. (*See* Elihu Decl. Ex. A; DE 225 at 7.) In any event, these objections are referenced in response to the related Interrogatory No. 7 and the parties specifically discussed the overbreadth and undue burden issue in the meet and confer. (DE 225 at 9; DiMuzio Decl. Ex. 17.)

2), Motorola has admitted that it is not aware of having marked any products with the numbers of the patents in suit. (See DiMuzio Decl. Ex. 1.) As such, Apple’s argument is moot: whatever the embodiments that may be identified, Motorola has already conceded they are not marked. Apple’s argument is also irrelevant to Motorola’s method patent claims—“[t]he law is clear that the notice provisions of § 287 *do not apply* where the patent is directed to a process or method.” *Fujitsu Ltd. v. Netgear Inc.*, 620 F.3d 1321, 1332 (Fed. Cir. 2010) (quoting *Crown Pkg’g Tech., Inc. v. Rexam Beverage Can Co.*, 559 F.3d 1308, 1316 (Fed. Cir. 2009)) (emphasis added). Hence, Apple’s argument has no application to the patents from which Motorola asserted method claims.

Second, nothing in the law indicates that a patent holder must show all the embodiments of its patent to support a reasonable royalty analysis. To the contrary, under *Georgia Pacific*, numerous independent factors go into the determination of a reasonable royalty. *Mars, Inc. v. Coin Acceptors, Inc.*, 527 F.3d 1359, 1364 (Fed. Cir. 2008) (discussing “the fifteen *Georgia-Pacific* factors”). In any event, “the amount of a prevailing party’s damages is a finding of fact on which the [patent owner] bears the burden of proof by a preponderance of the evidence.” *Smithkline Diagnostics, Inc. v. Helena Labs. Corp.*, 926 F.2d 1161, 1164 (Fed. Cir. 1991); *see also Kearns v. Chrysler Corp.*, 32 F.3d 1541, 1551 (Fed. Cir. 1994) (“A patent owner bears the burden of proof on damages.”). To reach a compromise, Motorola explained to Apple that it would provide information about embodying products on which Motorola would rely to support a *Georgia Pacific* analysis. (See DiMuzio Decl. Ex. 12.) Apple’s demand that Motorola provide more—i.e., that Motorola provide detailed information on products that would *not* be part of its reasonable royalty analysis—by definition seeks irrelevant information. Thus, neither of Apple’s theories provides a basis for the sweeping discovery it seeks.

The cases relied upon by Apple do not hold otherwise. In *Aristocrat*, the party moving to compel had not sought information about *every* product embodying the asserted patents, as Apple does here. Rather, its interrogatory was specifically limited to *ten products*. See *Aristocrat Techs. v. Int'l Game Tech.*, No. C 06-03717 RMW (RS), 2009 WL 3573327, at \*2 (N.D. Cal. Oct. 30, 2009) (“In this interrogatory, IGT requests Aristocrat to ‘[e]xplain fully whether the following games, products, systems, software and/or controllers do or do not practice, or are or are not capable of practicing, any method claimed in the Asserted Patents, and your factual and legal bases for that.’ *The request goes on to list ten such games or products.*” (emphasis added)).

2. *Apple’s Interrogatory Seeking Information About All Motorola Products Embodying its Patents is Overbroad and Unduly Burdensome*

Even if some of the information sought by Apple’s Interrogatory No. 12 were relevant, the Interrogatory is also objectionable because it is overbroad and unduly burdensome, as Apple’s own authority demonstrates. In *Leader Technologies, Inc. v. Facebook Inc.*, Civ. No. 08-862-JJF-LPS, 2009 WL 3021168 (D. Del. Sept. 4, 2009), the court explained that “[t]his case is fundamentally about whether Facebook infringes Leader’s patent, *not about* whether Leader practices its own patent.” *Id.* at \*2 (emphasis added). Although the court granted some additional discovery, it only did so after “a proper weighing of the relative burdens on the parties, as well as the relevance of the discovery Facebook seeks.” *Leader Technologies* is a comparatively small company with only a small handful of products or services. (See Elihu Decl.<sup>3</sup> Ex. D.).

Motorola, by contrast, has a large number of product portfolios, and literally hundreds of

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<sup>3</sup> “Elihu Decl.” refers to the Declaration of David M. Elihu in Support of Motorola’s Opposition to Apple’s Motion to Compel Interrogatories Nos. 7 and 12 Regarding Products Embodying Motorola’s Asserted Patents, filed herewith.

products. Hence, the heavy burden on Motorola, particularly given the negligible relevance of identifying *every* Motorola embodying product, demonstrates that Apple is not entitled to the information it seeks.<sup>4</sup>

Moreover, Motorola already has identified numerous products that it contends relate to the patents in suit. (*See* DiMuzio Decl. Exs. 6, 7.) Motorola informed Apple that all of Motorola's products using the Android operating system or the Android Marketplace embody its asserted patents. (*Id.*) Furthermore, Motorola informed Apple that it would identify the products on which Motorola would rely at trial. (*See* DiMuzio Decl. Ex. 12.) As both *Facebook* and *Aristocrat* demonstrate, Apple is simply not entitled to information about the whole universe of Motorola's embodying products, when only a small portion is relevant to this litigation. Indeed, while in this case Apple has persisted in claiming that the identification of such information is proper, elsewhere it has argued just the opposite, as discussed below.

3. *Apple's Assertion that there is "No Dispute" that it is Entitled to Information About All Embodying Products is Belied by its Own Arguments made Elsewhere*

Apple asserts that "[t]here can be no dispute that Apple requires information about Motorola's embodying products for its defense." (DE 225 at 8.) However, Apple's own arguments made elsewhere show just the opposite.

In May of last year, in litigation with Eastman Kodak Co. in the Western District of New York, Apple—represented by the same counsel as here—opposed a motion to compel brought by Kodak seeking the same information that Apple seeks here. In that case, Kodak asked for discovery "related to any product embodying any of the inventions claimed in the Asserted

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<sup>4</sup> Accordingly, that Apple provided information about its own embodying products (DE 225 at 8) does not dictate that Motorola must do likewise, given Apple's far smaller product line; in its responses Apple identified just nine embodying products for one patent, and eleven for another. (*See* DiMuzio Decl. Ex. 2.)

Apple Patents.” (Elihu Decl. Ex. B at 19.) Apple, however, refused.

In opposing Kodak’s motion to compel, Apple argued that it is overbroad to require a patentee to disclose all of its embodying products. Remarkably, Apple cited in support the same case it relies on now to stand for exactly the *opposite* proposition, *Leader Technologies, Inc. v. Facebook Inc.*, 2009 WL 3021168 (D. Del. Sept. 4, 2009). Relying on *Facebook*, Apple explained that its “counterclaims are fundamentally about whether Kodak infringes Apple’s patents, not about whether Apple practices its own patent.” (*Id.*) Since there was “no authority” before the court “to support requiring a patentee to prove how its own (by definition ‘unaccused’) products practice its own patent,” Apple argued that it did not need to disclose all of its embodying products, and it requested that Kodak’s motion to compel be denied. (*Id.*)

Apple’s own arguments thus belie its claim to be entitled to relief here. Motorola should not be compelled to produce information of the same sort that Apple itself has argued is irrelevant. *Cf. U.S. v. Campa*, 459 F.3d 1121, 1178 n.156 (11th Cir. 2006) (suggesting that, even where judicial estoppel does not apply, parties nonetheless should be prevented “from playing fast and loose with the courts,” including by “a change in their subsequent position in unrelated litigation based upon the same set of facts”) (internal citations omitted and quotations altered).

**B. Apple’s Interrogatory No. 7 Seeking Information About The First Manufacture, Use, Offer for Sale and Sale of All Devices that Embody Motorola’s Patents is Likewise Improper and Objectionable**

Apple also asks the Court to compel Motorola to supplement its response to Interrogatory No. 7, asserting that Motorola “promised” to do so, and arguing that Interrogatory No. 7 calls for “relevant information vital to Apple’s defense.” (DE 225 at 10.) However, neither of Apple’s theories has merit.

As an initial matter, Apple failed to confer with Motorola on this issue pursuant to Local Rule 7.1(a)(3). Although Apple did meet and confer regarding Interrogatory No. 12 in advance



of filing its motion to compel, Apple did not do so regarding Interrogatory No. 7. (*See* Elihu Decl. Ex. C; DiMuzio Decl. Ex. 17.) This itself is cause for the Court to deny Apple relief. *See, e.g., Marler v. U-Store-It Mini Warehouse Co.*, No. 09–60613–CIV, 2011 WL 1430262 (S.D. Fla. April 14, 2011); *Horowitch v. Diamond Aircraft Indus., Inc.*, No. 6:06-CV-1703-Orl-19JGG, 2007 WL 1192401, at \*4 (M.D. Fla. April 23, 2007). However, even were Apple to be able to pursue its Motion to Compel on Interrogatory No. 7, relief should still be denied.

1. *Interrogatory No. 7 is Improper and Objectionable*

Apple’s Interrogatory No. 7 is overbroad, unduly burdensome, and seeks irrelevant information. Apple asks Motorola to identify “the first manufacture, use, public use, offer for sale, and sale of *any embodiment* of the asserted claims of any of Motorola’s asserted patents, including identification of” dates, persons with knowledge, sales prices, and documents.” (DE 225 at 10 (emphasis added).) As discussed above with regard to Interrogatory No. 12, information about *any embodiment* of Motorola’s patents is overbroad, unduly burdensome, and irrelevant. Accordingly, just as Motorola need not identify all of its embodying products in response to Interrogatory No. 12, it need not produce information about all of its embodying products in response to Interrogatory No. 7. Indeed, the breadth and burden of Interrogatory No. 7 is all the greater, as it does not simply ask Motorola to *identify* all of its embodying products, but it goes far further, asking Motorola to obtain, analyze, and produce a vast amount of information *about* every one of these irrelevant products.

2. *The Legal Grounds on which Apple Seeks a Response are Flawed*

Nor do the flawed legal grounds on which Apple seeks a response to Interrogatory No. 7—under 35 U.S.C. §§ 102(b) and 287—compel further discovery.

Apple explains that information about the first public use, offer for sale, and first sale of a product practicing a patent is required to determine the validity of a patent, because these

activities can invalidate a patent under § 102(b) if they occur more than one year before a patent application is filed. (DE 225 at 4.) But although Apple correctly notes that public use or sale of an invention more than one year prior to the date the patent was applied for may render a patent invalid, Apple fails to take into account the priority dates that Motorola already has provided for each of its asserted patents.

Motorola has explained in its response to Apple's Interrogatory No. 6 that, for every asserted patent, Motorola is not relying in this case on a conception and reduction to practice date earlier than one year before filing of the patent application. (*See* Elihu Decl. Ex. A at 21-23; DE 1, Exs. 1-6.) Given that conception and reduction to practice necessarily must precede the creation of a working embodiment of the invention, *cf. Solvay S.A. v. Honeywell Int'l., Inc.*, 622 F.3d 1367, 1376 (Fed. Cir. 2010), it is therefore already clear that Motorola's patents cannot be invalidated in this case by Motorola's own products under § 102(b). Compelling Motorola to provide additional and burdensome discovery on this issue would therefore serve no purpose.

Apple's argument that it requires a response to determine whether Motorola made sales of embodying products without marking also falls short. Apple claims that such sales would bar a recovery of damages. (DE 225 at 2.) But as explained above, Motorola has conceded that it is not aware of having marked any of its products with the patents at issue in this case. (*See* DiMuzio Decl. Ex. 1.) Hence, Apple's argument is irrelevant. Motorola should not be compelled to respond to Interrogatory No. 7—which is even broader and more burdensome than Interrogatory No. 12 discussed above—so that Apple can obtain irrelevant information, to which it is still not entitled.

### C. Apple's Assertion that Motorola "Promised" to Supplement is False

Furthermore, Apple's assertion that Motorola "promised to update its response" to these interrogatories (DE 225 at 10) is simply untrue. None of the correspondence cited by Apple shows otherwise. Neither Exhibit No. 9 or 10 to the DiMuzio Declaration states, or even suggests, that Motorola promised to supplement its response to Interrogatory Nos. 7 or 12. Exhibit 9 in fact states that Apple "*proposed* that the parties mutually agree to supplement their responses," and that Motorola "look[s] forward to discussing this matter" at the next meet and confer. This instead makes clear that an agreement as to supplementing the enumerated interrogatories was *not* yet reached. Similarly, Exhibit 10 states that for certain Interrogatories, Motorola would be serving supplemental responses, but that "[f]or the remaining interrogatories"—including Nos. 7 and 12—"we are continuing to work on our responses."

Indeed, during further meet-and-confer efforts, Apple explained that it would not narrow the number of embodying products to be identified, relying on the cases cited in its Motion, *Facebook* and *Aristocrat*. (See DiMuzio Decl. Ex. 17.) Motorola disputed Apple's characterization of those cases, and countered that neither case offers support for the extensive discovery that Apple seeks. (*Id.*) Motorola nonetheless explained that it is "still amenable to finding a compromise." (*Id.*) Apple responded that, unless Motorola came forth with a specific proposal on providing embodiments, there would be "nothing further to discuss." (*Id.*) For Apple therefore to assert that Motorola promised to supplement the very interrogatories where it declared that parties to be at an impasse defies belief.

Nonexistent "promises" thus provide no grounds on which to compel further discovery.

## IV. CONCLUSION

For the foregoing reasons, Motorola respectfully requests that Apple's Motion to Compel be denied in its entirety.

Dated: February 6, 2012

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that on February 6, 2012, I served the foregoing document via electronic mail on all counsel of record identified on the attached Service List.

*/s/ Annette C. Escobar*

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