Exhibit B

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF NEW YORK

EASTMAN KODAK COMPANY, *Plaintiff-Counterclaim Defendant,* **vs.** **APPLE INC.** *Defendant-Counterclaim Plaintiff.*	**6:10-cv-06022-MAT-JWF**

APPLE INC.'S OPPOSITION TO KODAK'S
MOTION TO COMPEL DOCUMENTS AND SOURCE CODE

I.

INTRODUCTION

Plaintiff Eastman Kodak Company ("Kodak") asks this Court to compel Apple Inc. ("Apple") to produce (1) voluminous amounts of irrelevant source code; (2) so-called "fundamental" documents that Apple has either already produced or agreed to produce; and (3) documents that have no bearing on any claim or defense in this case and are thus wholly irrelevant.

First, rather than request source code relating to the functionalities at issue in this litigation, Kodak sweepingly demands ***all*** source code from Apple's OS X and iOS operating systems ***and*** the programs/applications loaded onto all Accused Apple Products running those operating systems – tens of millions of lines of commercially sensitive and valuable source code. Pressed in meet–and-confer, Kodak never articulated why the ***entirety*** of Apple's source code is relevant to this litigation, and does not provide such an explanation in its motion. Instead, Kodak seeks to reverse the burden of proof and require Apple to prove that its remaining code is ***not***

relevant. This is not the law. It is beyond dispute that the vast majority of Apple's code is irrelevant to this litigation, and Kodak cites no authority that supports compelling production of the ***entirety*** of proprietary and highly sensitive source code when only small portions (all of which Apple has already voluntarily produced) are even arguably relevant to this litigation. In all of Apple's district court and International Trade Commission litigation, Apple has never been ordered to produce, and has never voluntarily produced, source code for its operating systems in their entirety.

In this case, Apple has gone to great lengths to comply with Kodak's demands concerning source code relevant to Kodak's claims. Apple coordinated with over a dozen software engineers to identify and produce over 10,000 directories and sub-directories of source code containing over 88,000 individual files, comprising many hundreds of thousands of lines of source code. *See* Declaration of David Melaugh ("Melaugh Decl.") filed with this Opposition, ¶ 4. That process resulted in the production of every source code file that Kodak has requested either specifically or by category during the meet-and-confer process. Kodak now has all source code ***relevant*** to its infringement claims. But by demanding ***all*** source code regardless of relevance, Kodak is effectively requesting the right to go on a massive fishing expedition, the likes of which are both unprecedented and wholly unwarranted.

Second, Kodak seeks an unnecessary order compelling Apple to produce supposedly "fundamental" documents, when Apple has either already produced those documents or agreed to produce them. Kodak attempts to portray Apple as producing few documents in this litigation, but the truth is that ***Apple has produced well over two million (2,000,000) pages*** of documents to Kodak. Declaration of Calvin Cheng ("Cheng Decl.") filed with this Opposition, ¶ 7. Noticeably absent from Kodak's Motion to Compel ("Motion" or "Mot.") is any mention of the

fact that the parties entered a cross-use agreement stipulating that documents produced in other, overlapping litigations between the parties regarding the same accused products would be deemed produced in this case. *See* Agreed Protective Order (Dkt. No. 34), at 17, ¶ 17. Finally, Kodak seeks an order compelling Apple to respond to document requests that are overly burdensome and seek the production of irrelevant documents. As just one example, Kodak seeks to compel Apple to produce documents relating to Apple products that are ***not accused*** in this litigation.

In short, Kodak's Motion to Compel should never have been brought at all, and should accordingly be denied.

II.

BACKGROUND

Kodak and Apple are engaged in multiple, ongoing patent litigations. Kodak first accused Apple's iPhones of infringement in International Trade Commission ("ITC") Investigation No. 337-TA-703 ("ITC 703 Investigation").[1] Apple then asserted two of its patents (not at issue here) against Kodak in ITC Investigation No. 337-TA-717 ("ITC 717 Investigation"), in which Kodak obtained discovery relevant to Apple's iMac, MacBook, MacBook Pro, MacBook Air, and Mac OS X products. In this litigation, Kodak accuses Apple's mobile devices (iPhones, iPads, iPod Touch), which use Apple's iOS operating system, and Apple's desktop and laptop products (iMac, eMac, iBook G4, Mac Mini, Mac Pro, MacBook, MacBook Pro, MacBook Air, Power Macintosh G5, PowerBook G4, and Xserve), which use Apple's OS X operating system.

[1] The Chief Administrative Law Judge found that Apple did not infringe Kodak's '218 patent (not at issue here), and that Kodak's patent was invalid. The Commission is currently reviewing that determination. Kodak also asserted the '218 patent in co-pending W.D.N.Y. Case No. 6:10-cv-06021-MAT-JWF, currently stayed pending final resolution of the ITC investigation.

Because of the substantial overlap between the different Apple-Kodak actions, the parties entered into a cross-use agreement. *See* Agreed Protective Order (Dkt. No. 34), at 17, ¶ 17 (providing that "documents produced by the parties in United States [ITC] Investigation Nos. 337-TA-703…and 337-TA-717…shall be deemed produced in this case."). Apple produced 36,580 documents (totaling 1,789,253 pages) to Kodak in the ITC 703 Investigation covering financial, technical, and marketing aspects of Apple's various iPhone models, which include the iPhones accused in this litigation. Cheng Decl., ¶ 3. Apple produced 5,950 documents (totaling 130,894 pages) to Kodak in the 717 Investigation covering financial, technical, and marketing aspects of Apple's iMac, MacBook, MacBook Pro, MacBook Air, and Mac OS X. Cheng Decl., ¶ 4. In the present litigation, in addition to the foregoing 1.9 million pages of production, Apple has produced over 115,645 additional documents (totaling over 553,742 pages) (Cheng Decl., ¶ 5) and has made available for inspection over 10,000 directories and sub-directories of source code containing over 88,000 individual files, comprising many hundreds of thousands of lines of source code. *See* Melaugh Decl., ¶ 4. Thus, Apple has produced over two million (2,000,000) pages of documents and nearly 90,000 individual files of code to Kodak in this litigation. In addition, Apple has faithfully met-and-conferred with Kodak and, in an effort to avoid burdening this Court with an unnecessary discovery motion, agreed to supplement its document productions. Discovery is still open.[2] Apple is in the process of reviewing additional documents and has agreed to supplement its production as appropriate.

[2] On May 11, 2011, the parties filed a joint stipulation to extend the close of fact discovery to June 30, 2011, and Judge Feldman signed that stipulation on May 11, 2011 (Dkt. No. 72).

III.

ARGUMENT

A. Kodak Is Only Entitled To Relevant Source Code (Kodak's Document Request Nos. 24-26), Which It Has Received in Full

1. Kodak Bears The Burden Of Showing Its Requests Are Relevant

Although relevancy for the purposes of discovery is broad, it is not without "ultimate and necessary boundaries." *Hickman v. Taylor*, 329 U.S. 495, 507 (1947). A "threshold showing of relevance must be made before parties are required to open wide the doors of discovery to produce a variety of information which does not reasonably bear upon the issues of the case." *Sackman v. Liggett Group, Inc.*, 173 F.R.D. 358, 361 (E.D.N.Y. 1997), *citing Hofer v. Mack Trucks, Inc.*, 981 F.2d 377, 380 (8th Cir. 1993). "The party seeking discovery bears the burden of initially showing relevance." *Mandell v. Maxon Co.*, No. 06-cv-460, 2007 U.S. Dist. LEXIS 99238, at *1 (S.D.N.Y. Oct. 15, 2007), *see also Zanowic v. Reno*, No. 97-cv-5292, 2000 U.S. Dist. LEXIS 13845, at *14-15 (S.D.N.Y. Sept. 22, 2000) (explaining that movant's failure to explain the relevance of the information sought was "fatal to their motion to compel"). Mere speculation that information might be useful will not suffice; a litigant seeking to compel production must explain the importance of the information sought. *See Lyons v. McGinnis*, No. 04-cv-6157L, 2006 U.S. Dist. LEXIS 41894, at *4-5 (W.D.N.Y. June 22, 2006) (denying motion to compel where the burden of producing material outweighed "speculative relevance"); *see also Jones v. Goord*, No. 95-cv-8026, 2002 U.S. Dist. LEXIS 8707, at *40-41 (S.D.N.Y. May 15, 2002) (denying motion to compel electronic database containing a "huge volume of sensitive data" where movant only had a "vague hope" that the discovery would be useful and "made little showing of the importance of the proposed discovery").

In the special case of sensitive trade secrets such as a company's source code, the burden is even higher and it is generally recognized that discovery of such information should be denied unless the party seeking production can meet the burden of "establish[ing] that the information is ***sufficiently relevant and necessary*** to his case to outweigh the harm disclosure would cause to the person from whom he is seeking the information." 8 A. Wright & A. Miller, Federal Practice & Procedure: Civil § 2043 at 248 (3d ed. 2010) (emphasis added); *see also Hartley Pen Co. v. U.S. Dist. Court*, 287 F.2d 324, 331 (9th Cir. 1961). For example, in *Viacom Int'l Inc. v. YouTube Inc.*, the district court explained that the defendant "should not be made to place this vital asset in hazard merely to allay speculation" on the part of the plaintiff as to its relevance. 253 F.R.D. 256, 260 (S.D.N.Y. 2008); *see also Hartley Pen Co.*, 287 F.2d at 331 (finding that the lower court abused its discretion in ordering production of sensitive materials because the requesting party "did not sustain the burden that rested upon it of establishing that the trade secrets sought were relevant and necessary to its proper defense of the main action"); *In re Chronotek Sys., Inc.*, No. 07-cv-0279, 2007 U.S. Dist. LEXIS 54661, at *2 (S.D. Tex. July 27, 2007) ("There is no dispute in this case that the subpoenaed source code qualifies as a confidential trade secret…[thus, the movant] must demonstrate that it has a substantial need for the material."). Here, Kodak has not explained why the entirety of Apple's closely-guarded source code is relevant or necessary to Kodak's claims or defenses.

2. Apple Has Produced All Relevant Source Code

To be clear, Apple does not dispute, and has never disputed, that it is appropriate for both parties to produce relevant source code. *See, e.g.*, Cheng Decl., Ex. 2 at 28-21 (responding to Kodak's source code requests by stating that "Apple will produce responsive, non-privileged, relevant source code modules and documents within its possession, custody or control, to the extent any exist."). Apple has made available for inspection relevant, responsive source code (in

this case nearly 90,000 individual files of source code). Apple went to great lengths to identify code relevant to Kodak's claims, coordinating with over a dozen software engineers to identify and produce over 10,000 directories and sub-directories of source code containing 88,899 individual files, comprising many hundreds of thousands of lines of source code. *See* Melaugh Decl. ¶ 4. This process resulted in the production of every source code file that Kodak has requested either specifically or by category during the meet-and-confer process.

Throughout the meet-and-confer process, Apple requested that Kodak specifically identify any alleged deficiency in Apple's production, so that in the event Kodak reasonably requests additional source code in order to investigate the functionality actually at issue in this litigation, Apple could supplement its production. *See* Cheng Decl., Ex. 1 at 2-3 (explaining to Kodak that "[i]f Kodak believes it is missing relevant source code, and if the request is reasonable, Apple would be happy to make such code available."). Apple has repeatedly acceded to these requests despite serious concerns about the relevance of some of them. At this time there is ***no*** source code that Kodak has specifically requested or identified by type as missing that Apple has refused to produce, including the source code for

identified in Kodak's Motion on page 8. *See* Cheng Decl., ¶ 11; *see also* Cheng Decl., Ex. 1 at 1-2 (listing code that had been produced as of March 9, 2011).

Since filing its Motion to Compel, Kodak has had the opportunity to test the completeness of Apple's source code production by way of numerous Apple technical witness depositions. As of May 18th, Kodak has now deposed six engineers concerning the accused functionality. Each of these witnesses testified for Apple in a Rule 30(b)(6) capacity. Kodak's

source code expert[3] has sat in on every deposition and Kodak has used source code files in the majority of these depositions. No engineer has identified any relevant code that Apple had not already produced to Kodak.[4]

3. The Entirety Of Apple's Source Code Contains Highly Sensitive Trade Secrets Not At Issue In This Litigation

The source code at issue comes from Apple's proprietary OS X and iOS operating systems and applications that run on those systems. Operating systems are collections of software that manage the hardware and the application software that runs on the device and provide an interface for users to interact with the device. Bundled with the iOS and OS X operating systems are certain preinstalled applications, such as Phone, Mail, Safari, Photos, Camera, Clock, Calculator, etc.

Declaration of John Wright ("Wright Decl."), filed herewith, at ¶ 4. The value and competitive sensitivity of Apple's iOS and OS X source code cannot be overstated – they are one of the main reasons for Apple's success.

[3] Conspicuously absent from Kodak's motion to compel is any statement by its experts that they lack any particular source code necessary to complete their analyses.

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Were Apple's iOS or OS X operating systems compromised due to the unnecessary disclosure of its sensitive, trade secret source code, the damage to the company would be severe.

All of these concerns must be balanced against, and substantially outweigh, Kodak's overbroad demand for irrelevant but highly sensitive and proprietary Apple source code – particularly given Kodak's failure to identify any relevant code that has not been produced.

The iOS and OS X operating systems are bundled with many preinstalled applications, such as Phone, Mail, Safari, Photos, Camera, Clock, Calculator, etc., the majority of which have ***no possible relevance*** to the patents at issue. The list of functionalities encompassed by OS X and iOS source code and applications ***not*** at issue in this litigation could fill the remainder of this brief. For the iPhone alone, such functionality includes: listening to music, watching movies, playing games, taking and reviewing photos and movies, and use of miscellaneous utilities, such as calculators, calendars, clocks, notes, etc.

Kodak is simply not entitled to the whole universe of Apple's code, when only a small portion is potentially relevant to this litigation. *See Microsoft Corp. v. Multi-Tech Sys.*, No. 00-cv-1412, 2001 U.S. Dist. LEXIS 23155, at *25-26 (D. Minn. Dec. 14, 2001) (finding that, although source code is relevant and discoverable, the party moving to compel was not entitled to "the whole universe of source code…because…there are many functions within the relevant products which have no bearing on this case."). As an analogy to paper documents: no Kodak patent concerns, for example, the iPhone's ability to play movies, so Apple did not collect and produce documents concerning the iPhone's movie playing functionality. It logically follows that Apple should not be required to collect and produce the source code responsible for that functionality.

Kodak's complaint, in essence, is that the production of source code has been partly an iterative process, *i.e.*, the parties have had to meet-and-confer regarding Apple's production, and in response to the meet-and-confers, Apple has supplemented its production on several occasions. However, the fact that such meet-and-confers have occurred, and that Apple has supplemented its source code productions, shows that Apple is not attempting to withhold any relevant information from Kodak, and in no way justifies a motion to compel ***all*** source code without regard to relevance. Such conferences are a standard part of litigation; indeed, in response to meet-and-confer conferences regarding deficiencies in Kodak's own discovery obligations, Kodak has made numerous supplemental productions. Just as conferences between

parties regarding conventional document production and rolling productions of conventional documents are standard and appropriate, they are appropriate for the production of source code as well. *See Microsoft Corp.*, 2001 U.S. Dist. LEXIS 23155, at *25-26 (directing parties to meet-and-confer to determine which portions of the source code for the products at issue were relevant). Kodak's Motion is akin to filing a motion to compel the production of ***every single*** document in a party's possession, regardless of relevance, to avoid meeting and conferring and supplemental productions. Notwithstanding Kodak's abandonment of this process in favor of filing its overreaching Motion to Compel, Apple will continue to work with Kodak to produce any relevant additional code that Kodak identifies or describes to Apple – and indeed Apple has done so since the filing of Kodak's Motion. Melaugh Decl. ¶¶ 5-6. This is entirely reasonable and all Kodak is entitled to under the Federal Rules.

4. The Existence Of Protective Order Provisions Regarding Source Code Does Not Justify Requiring Apple To Produce All Of Its Source Code, Including Code Not Relevant To This Investigation

Kodak may argue that all of Apple's concerns regarding production of its source code are accounted for and protected against by the Protective Order in this case. *See* Agreed Protective Order (Dkt. No. 34) at 4, ¶ 6. But that would be incorrect. Even in cases where, like here, "the protections set forth in [a] stipulated confidentiality order are careful and extensive," they are "nevertheless not as safe as nondisclosure [and] [t]here is no occasion to rely on them, without a preliminary proper showing justifying production of the search code." *Viacom Intl Inc*., 253 F.R.D. at 260; *see also Microsoft Corp.*, U.S. Dist. LEXIS 23155, at *19-21 (D. Minn. Dec. 14, 2001) (denying motion to compel disclosure of sensitive information where there was merely a "bald proclamation of relevance").

The Protective Order was designed to provide a level of protection for source code within the permissible scope of discovery. It does not provide absolute protection and was never

intended to be sufficient to protect the entirety of Apple's iOS and OS X source code. Although Apple of course expects that all those who subscribe to the Protective Order will abide by its terms and not use any information obtained in this litigation for any impermissible purpose, Kodak's requests for production of vast amounts of highly sensitive materials, irrelevant to this litigation, unnecessarily increase the risk of inadvertent disclosure and use. Wright Decl., ¶ 9.

B. Kodak Cites No Authority Requiring The Production Of Irrelevant Source Code

None of the cases cited by Kodak for the proposition that courts "routinely" compel source code required the production of voluminous amounts of irrelevant source code (as Kodak seeks here). *See* Kodak's Mot. at 6-7 *citing Forterra Systems, Inc. v. Avatar Fact.*, 2006 WL 2458804, at *1 (N.D. Cal. Aug. 22, 2006) (distinguishable because the court found that "the entire source code was relevant"); *3Com Corp. v. D-Link Sys. Inc.*, 2007 WL 949596, at *1 (N.D. Cal. 2007) (same).[5] The following cases relied upon by Kodak are also inapplicable.

- *Leader Tech. Inc. v. Facebook Inc.* is distinguishable because the plaintiff accused the ***entirety*** of Facebook's website of infringement. 2009 WL 3021168, at *3 (D. Del. Sep. 4, 2009). Moreover, the plaintiff "sufficiently articulated its infringement contentions to demonstrate the relevance of the ***entirety*** of the source code" by providing detailed infringement charts showing just how the entirety of Facebook's website was alleged to infringe. *Id*. Here, Kodak has not accused the entirety of OS X and iOS functionality, but rather has only accused certain features and applications. And Kodak has not articulated how the entirety of Apple's tens of millions of lines of code relates to its infringement contentions.

- *Negotiated Data Solutions, LLC v. Dell, Inc.* is distinguishable because the ***entirety*** of the accused infringer's code was not at issue – only a specific portion of code related to the accused computer chips called Registered Transfer Level ("RTL") code was at issue and

[5] Kodak relies mainly upon case law from the Northern District of California to support its request to compel Apple's source code. The Northern District of California has a local rule requiring that an accused infringer produce source code "sufficient to show the operation of any aspect or elements of an Accused Instrumentality." N.D. Cal. Patent L.R. 3-1(c). Thus, even this rule, cited by case law relied upon by Kodak, explicitly states that only portions of source code (not the entirety) are required to be produced.

ordered to be produced. 2009 WL 733876, at * 2, 4 (N.D. Cal. Mar. 17, 2009). In contrast, Apple has already produced the relevant portions of code in this case.

- *Display Link Corp. v. Magic Control Tech. Corp.* is distinguishable because the defendant promised to produce the source code and "said little in opposition to the motion [to compel]." 2008 WL 2915390, at *1-2 (N.D. Cal. Jul. 23, 2008). In contrast, Apple never suggested it would produce the entirety of its source code to Kodak. *See* Cheng Decl., Ex. 1 at 3.

- *Adams & Assoc., LLC v. Dell, Inc.* is distinguishable because *Adams* is not about an order compelling source code at all. 2008 WL 4966902, at *3-5 (D. Utah Nov. 19, 2008). Rather, it concerns a party who ***voluntarily*** produced source code and then sought a protective order barring the opposing side from showing the produced source code to its experts. *Id.* This case is inapplicable.

In sum, Kodak provides no authority or explanation for why Apple should be made to produce the entirety of its tens of millions of lines of highly proprietary source code. Kodak's Motion to Compel should be denied.

C. Kodak's Discovery Requests Seek "Fundamental" Documents That Apple Already Produced Or Agreed To Produce, Or Are So Overbroad They Would Require the Production of Wholly Irrelevant Documents[6]

1. Financial Data Relating to Accused Apple Products

a. Kodak's Request For Customer Identities Is Overly Broad And Irrelevant

Kodak complains that the sales information Apple has provided is missing information relating to Kodak's Mot. at 9-10. Kodak's request for Apple's customers' identities is overly broad and irrelevant to Kodak's claims of infringement, and Kodak has made no showing of necessity for this information. *See Lemanik v. McKinley Allsopp, Inc.*, 125 F.R.D. 602, 608 (S.D.N.Y. 1989) (denying portions of motion to compel seeking identities of nonmovant's clients because movant made "no showing of a legitimate need to know their identities"); *Boas Box Co. v. Proper*

[6] For ease of the Court's review, Apple responds to Kodak's Motion in like numbered paragraphs, *i.e.*, C.1., C.2., C.3., etc.

Folding Box Corp., 1968 U.S. Dist. LEXIS 8852 (E.D.N.Y. 1968) (denying motion to compel customer list because "[d]isclosure could constitute a threat to business prospects and good will. . . [and] here there is no great showing of necessity."); *Chubb Integrated Sys. Ltd. v. Nat'l Bank of Washington*, 103 F.R.D. 52, 57 (D.D.C. 1984) (interrogatory seeking names of customers not appropriate, and interrogatory seeking yearly sales broken down by customer "not likely to lead to evidence of market share, growth in the market place, etc.").

Even more fundamental, Kodak's requests for Apple's customers' identities and quantities sold to each customer call for an enormous amount of data compilation and the invasion of the privacy of millions of individuals. Apple sells millions of its products each month, mainly from its stores and websites, to individual, private customers. Essentially, Kodak is asking Apple to provide information disclosing the identities of millions of private citizens who are not involved in this lawsuit. All Kodak offers in support is the naked assertion that knowing the names of millions of Apple's customers is "[a]mong other things, relevant to Kodak's damages analyses and bases for infringement." Kodak's Mot. at 10. Kodak's assertion in no way provides a basis for compelling Apple to produce this information. Moreover,

The burden of compiling this information on Apple and the invasion of privacy of Apple's customers outweighs whatever need Kodak has for this information (and Kodak has articulated no such need).

Nonetheless, as a compromise, Apple has agreed to produce

Given that Kodak has not articulated any reason for customer lists at all, this production should be more than sufficient for its needs.

b. Apple Has Already Produced, And Has Agreed To Continue To Produce, Other Financial Documents

Apple has already produced or agreed to produce financial information for the Accused Apple Products (other than

). Kodak's Mot. at 9-10, § C.1.

Specifically, Apple agreed to "produce responsive, non-privileged documents" in response to Kodak's Document Request Nos. 1, 3-5, 8-10, 13, 14, 136, 150, 153, 155, 174-176, 183, and 191-193.[7] *See* Cheng Decl., Exs. 2 & 3. Apple and Kodak met and conferred regarding the scope of Kodak's Document Request Nos. 86 (purchase orders, quotes), 156 (sales, distribution, importation agreements), 160 (importation records, receipts), 162 (identity of resellers, distributors), and 178-180 (discontinuance, first public use, and date placed on sale, respectively) because Kodak failed to identify the specific models or versions of Apple products that Kodak accuses of infringement. Kodak only recently provided this information on April 7, 2011 – less than two (2) weeks before filing its Motion to Compel. Cheng Decl., Ex. 4. Apple agreed to produce responsive, non-privileged documents for the specific models and versions of Apple products identified by Kodak.

Apple has already produced the following financial information:

- On March 15, 2011, Apple produced 136 for most of the Apple Accused Products, including the Apple iMac, eMac, iBook, PowerBook, Power Macintosh, Mac Mini, MacBook, MacBook Air, MacBook Pro, Mac Pro, Xserve, iPod Touch, Mac OS X, and Mac OS X Server, dated from 2001 to 2011. And Apple recently supplemented this production with updated information.[8]

[7] Kodak also references its Document Request Nos. 84 and 114 in the financial section of its Motion to Compel, but these requests are about products embodying Apple's Asserted Patents, and so these Requests are addressed in Section C.4.a., *infra*.

[8] *See* 6022-APPLE-00045393 – 6022-APPLE-00045932.

- On May 5, 2011, Apple produced two financial spreadsheets disclosing domestic sales figures, including units sold, revenue, and costs, for most of the Apple Accused Products, including the Apple iMac, eMac, iBook, Mac Mini, Mac Pro, MacBook, Power Macintosh, PowerBook, Xserve, iPhone 3G, iPhone 3GS, iPhone 4, iPad, and iPod Touch, from as early as 2004 up until 2011.[9]

- On May 5, 2011, Apple also produced eight financial spreadsheets for most of the Apple Accused Products, including the Apple iMac, iPad, iPhone, iPod, iBook, MacBook, PowerMac, MacPro, PowerBook, MacBook Air, MacBook Pro, and servers, from as early as 2000 up until 2011.[10]

Discovery is still open, and Apple will continue to produce any other responsive documents within its custody and control. As such, this portion of Kodak's Motion to Compel is moot. *E.g.*, *Nastasia v. New Fairfield Sch. Dist.*, No. 3:04-cv-925, 2006 U.S. Dist. LEXIS 40316, at *5-6 (D. Conn. June 19, 2006) (denying motion to compel as moot where nonmovant represented that it would produce documents if they were found); *Microsoft Corp.*, 2001 U.S. Dist. LEXIS 23155, at *25 n.4 (denying portion of motion to compel as moot where nonmovant agreed to produce document at issue).

2. Apple Already Produced, And Has Agreed To Continue To Produce, Marketing Documents Relating To Accused Apple Products

Apple has already produced or agreed to produce marketing documents demanded by Kodak. *See* Kodak's Mot. at 10, § C.2. Specifically, Apple agreed to "produce responsive, non-privileged documents" in response to Kodak's Document Request Nos. 8-10, 85-88, 112, 136, 138, 181, and 194. *See* Cheng Decl., Exs. 2 & 3. Apple and Kodak met and conferred regarding the scope of Request Nos. 170 (customer support service) and 199 (marketing research or analysis) because Kodak failed to identify the specific models or versions of Apple products that Kodak accuses of infringement. Kodak only recently provided this information on April 7, 2011

[9] *See* 6022-APPLE-00126592 – 6022-APPLE-00126593.

[10] *See* 6022-APPLE-00126592 – 6022-APPLE-00126601.

– less than two (2) weeks before filing its Motion to Compel. Cheng Decl., Ex. 4. Apple agreed to produce responsive, non-privileged documents for the specific models and versions of Apple products identified by Kodak.

Since that time, Apple has produced the following marketing information:

- On May 5, 2011, Apple produced 677 marketing) related to the Apple Accused Products
- On May 9, 2011, Apple produced 13,196 marketing documents related to the Apple Accused Products.[12]
- On May 13, 2011, Apple produced 3,150 marketing documents related to the Apple Accused Products.[13]

Discovery is still open, and Apple will produce any other responsive documents within its custody and control. As such, this portion of Kodak's Motion to Compel is moot.

3. Apple Already Produced, And Has Agreed To Continue To Produce, Technical Documents Relating To Accused Apple Products

Apple has already produced or agreed to produce technical documents demanded by Kodak. *See* Kodak's Mot. at 11, § C.3. Specifically, Apple agreed to "produce responsive, non-privileged documents" in response to Kodak's Document Request Nos. 20-26, 59, 157, 158, 166, 171, and 190. *See* Cheng Decl., Exs. 2 & 3. Apple and Kodak met and conferred regarding the scope of Request Nos. 40, 41, 159, 161, 163, 165, 170, 177, and 184 because Kodak failed to identify the specific models or versions of Apple products that Kodak accuses of infringement.[14]

[11] *See* 6022-APPLE-00125915 - 6022-APPLE-00126591.

[12] *See* 6022-APPLE-00126602 – 6022-APPLE-00159353; 6022-APPLE-00385339 – 6022-APPLE-00385869.

[13] *See* 6022-APPLE-00385870 – 6022-APPLE-00392814; 6022-APPLE-00553670 – 6022-APPLE-00553742.

[14] Interrogatory No. 164 asks for "[a]ll documents relating to the assembly or packaging of the Accused Apple Products." Apple objected due to a lack of relevance, particularly because none

Again, Kodak only recently provided this information on April 7, 2011 – less than two (2) weeks before filing its Motion to Compel. Cheng Decl., Ex. 4. Apple agreed to produce responsive, non-privileged documents for the specific models and versions of Apple products identified by Kodak.

Since that time, Apple has produced the following technical information:

- On March 15, 2011, Apple produced 14 technical documents related to .[15]
- On May 5, 2011, Apple produced 4,081 technical documents related to .[16]
- On May 9, 2011, Apple produced 28,959 technical documents related to .[17]
- On May 13, 2011, Apple produced 61,689 technical documents related to .[18]
- By the time this opposition was filed, Apple expects to produce an additional 119,379 technical documents .[19]

Discovery is still open, and Apple will produce any other responsive documents within its custody and control. As such, this portion of Kodak's Motion to Compel is moot.

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of the patents asserted in this action, by either side, relate to manufacturing or packaging apparatus, processes or methods. Despite this, documents relating to the packaging of the Accused Apple Products have been produced – beginning with Apple's May 5, 2011 production.

[15] *See* 6022-APPLE-00066546 – 6022-APPLE-00067237.

[16] *See* 6022-APPLE-00109010 – 6022-APPLE-00125510.

[17] *See* 6022-APPLE-00159354 – 6022-APPLE-00385338.

[18] *See* 6022-APPLE-00392815 – 6022-APPLE-00553669.

[19] *See* 6022-APPLE-00553743 – 6022-APPLE-00673121; *see also* Cheng Decl. ¶ 6.

4. Documents Relating To The Asserted Apple Patents

a. Kodak's Requests For Materials Relating To Apple Products That Embody Apple's Asserted Patents And That Are Not Accused In This Case Are Overly Broad And Irrelevant

Kodak seeks "materials related to any product embodying any of the inventions claimed in the Asserted Apple Patents, and the design, development, and manufacture of any technology or product embodying any of the inventions claimed in the Asserted Apple Patents." Kodak's Mot. at 12. But "it is overbroad to require a patentee to disclose all of its products that practice any claim of the patent-in-suit, including those products that only practice claims that are not asserted in this litigation." *Leader Tech. Inc. v. Facebook Inc.*, No. 08-cv-862, 2009 WL 3021168, at *2 (D. Del. Sep. 4, 2009). Apple's counterclaims are fundamentally about whether Kodak infringes Apple's patents, not about whether Apple practices its own patent. *See id.* (finding that, after a proper weighing of burdens, the accused infringer was entitled to "nothing more" than the names of the products embodying the asserted claims of the patent in suit and an identification of which claims the products practice). Kodak, like the accused infringer in *Leader Tech*., cites no authority to support requiring a patentee to prove how its own (by definition "unaccused") products practice its own patent. Therefore, Kodak's Motion should be denied with respect to Document Request Nos. 84, 86-88, 112, 114, and 136.

b. Apple Has Already Produced, And Has Agreed To Continue To Produce, Other Documents Relating To The Asserted Apple Patents

Apple has already produced or agreed to produce documents relating to the conception, reduction to practice, and inventorship of the Asserted Apple Patents demanded by Kodak. *See* Kodak's Mot. at 12, § C.4. Specifically, Apple agreed to "produce responsive, non-privileged documents" in response to Kodak's Document Request Nos. 32, 52-61, 63, 64-66, 68, 71-75, 78, 80-83, 89-92, 107, 110, 200, and 201. *See* Cheng Decl., Exs. 2 & 3. Apple only has privileged

documents responsive to Kodak's Request No. 97. Apple and Kodak met and conferred regarding the scope of Request Nos. 76, 77, and 128. As a result, Apple agreed to produce responsive, non-privileged documents for these Requests within the boundaries agreed by the parties.

Apple has already produced the following documents relating to the conception, reduction to practice, and inventorship of the Asserted Apple Patents:

- On December 6, 2010, Apple produced .
- On March 2, 2011, Apple produced:
  - ;
  - ;[22]
  - ;[23]
  - ;
  - ;[25]
  - ;[26] and

[20] *See* 6022-APPLE-00004276 – 6022-APPLE-00004648; 6022-APPLE-00014477 – 6022-APPLE-00014849.

[21] *See* 6022-APPLE-00051955 – 6022-APPLE-00051957; 6022-APPLE-00051963 – 6022-APPLE-00051964.

[22] *See* 6022-APPLE-00053668 – 6022-APPLE-00053847.

[23] *See* 6022-APPLE-00023032 – 6022-APPLE-00023141; 6022-APPLE-00047941 – 6022-APPLE-00048087; 6022-APPLE-00048580 – 6022-APPLE-00048685.

[24] *See* 6022-APPLE-00054080 – 6022-APPLE-00054119.

[25] *See* 6022-APPLE-00048686 – 6022-APPLE-00050689.

[26] *See* 6022-APPLE-00053367 – 6022-APPLE-00053567.

- .[27]

- On March 15, 2011, Apple produced:
  - ;[28]
  - ;[29]
  - ;[30]
  - ;
  - ;[32]
  - .[33]

Apple also produced all development documents in its possession, custody or control related to the asserted '726 patent in the ITC 717 Investigation, and is in the process of collecting for production similar documents for the asserted '074 and '925 patents. Kodak acknowledges that Apple has produced

Kodak's Mot. at 13, § C.4. Discovery is still open, and Apple will produce any other responsive,

[27] *See* 6022-APPLE-00054770 – 6022-APPLE-00055005; 6022-APPLE-00055112 – 6022-APPLE-00055283.

[28] *See* 6022-APPLE-00047116 – 6022-APPLE-00047298; 6022-APPLE-00056837 – 6022-APPLE-00057114; 6022-APPLE-00057115 – 6022-APPLE-00057414; 6022-APPLE-00058359 – 6022-APPLE-00058671; 6022-APPLE-00058672 – 6022-APPLE-00058973.

[29] *See* 6022-APPLE-00046056 – 6022-APPLE-00046657.

[30] *See* 6022-APPLE-00045252 – 6022-APPLE-00045255.

[31] *See* 6022-APPLE-00059251 – 6022-APPLE-00059759; 6022-APPLE-00044736 – 6022-APPLE-00044736.

[32] *See* 6022-APPLE-00101431 – 6022-APPLE-00101487; 6022-APPLE-00101503 – 6022-APPLE-00101510.

[33] *See* 6022-APPLE-00045256 – 6022-APPLE-00045312; 6022-APPLE-00059942 – 6022-APPLE-00059944.

non-privileged documents within its custody and control. As such, this portion of Kodak's Motion to Compel is moot.

5. Apple Has Already Produced Licensing Documents, And Kodak Does Not Explain What Documents Are "Missing"

Kodak complains that Apple has produced "a very limited number of joint development agreements, royalty reports, or patent license agreements relating to the Asserted Apple Patents." Kodak's Mot. at 13, § C.5. But Kodak's statement demonstrates that Apple has produced documents responsive to Kodak's requests. Kodak has not explained what documents are missing or what number of agreements would satisfy Kodak. Nevertheless, Apple agreed to "produce responsive, non-privileged documents" in response to Kodak's Document Request Nos. 11, 49-51, 54-56, 60, 61, 67-71, 131-135, 139-141, 185, 188, and 190. Apple and Kodak met and conferred regarding the scope of Request Nos. 12, 31, and 117-120. As a result, Apple agreed to produce responsive, non-privileged documents for these Requests within the boundaries agreed by the parties.

Apple has already produced the following patent license agreements relating to the Asserted Apple Patents:

[34] *See* 6022-APPLE-00101511 – 6022-APPLE-00101527.

[35] *See* 717-Apple0129705 – 717-Apple0129735.

[36] *See* 717-Apple0129736 – 717-Apple0129757.

Apple has diligently searched for the aforementioned documents, and has not, thus far, discovered any other patent license agreements, joint development agreements, or royalty reports relating to the Asserted Apple Patents. Discovery is still open, and Apple will produce any responsive, non-privileged documents in its possession. Thus, this portion of Kodak's Motion to Compel is moot.

6. Apple Agreed To Produce And Has Produced Documents Relating To The Enforcement Of The Asserted Apple Patents

Apple agreed to produce documents relating to the enforcement of the Asserted Apple Patents as demanded by Kodak. *See* Kodak's Mot. at 13-14, § C.6. Apple agreed to "produce responsive, non-privileged documents" in response to Kodak's Document Request Nos. 79, 93-96, 102-104, 109, 141-144, 146, 148, 149. *See* Cheng Decl. Ex. 2. Apple has either produced, or has collected and is readying for production, responsive documents within its possession from other litigations involving the '074, '726, '293, and '434 patents.[37] Moreover, Apple only has privileged documents responsive to Request Nos. 100 and 101. Apple and Kodak met and conferred regarding the scope of Request Nos. 145 and 147. As a result, Apple agreed to produce responsive, non-privileged documents for these Requests within the boundaries agreed by the parties. Discovery is still open, and Apple will produce any other responsive documents within its custody and control. As such, this portion of Kodak's Motion to Compel is moot.

7. Apple Agreed To Produce And Has Produced Documents Showing Apple's Relationship With Third Parties

Apple has already produced or agreed to produce documents relating to Apple's relationship with third party manufacturers or suppliers with respect to Apple's Accused Products as demanded by Kodak. *See* Kodak's Mot. at 13-14, § C.6. Apple agreed to "produce

[37] *See* 717-Apple0129736 – 717-Apple0129757.

responsive, non-privileged documents" in response to Kodak's Document Request Nos. 11, 13, 14, 18, 19, 59, 108, and 137. Apple and Kodak met and conferred regarding the scope of Request Nos. 12 and 41 because Kodak failed to identify the specific models or versions of Apple products that Kodak accuses of infringement. Kodak only recently provided this information on April 7, 2011 – less than two (2) weeks before filing its Motion to Compel. Cheng Decl., Ex. 4. Apple agreed to produce responsive, non-privileged documents for the specific models and versions of Apple products identified by Kodak.

Discovery is still open, and Apple will produce any responsive documents within its custody and control. As such, this portion of Kodak's Motion to Compel is moot.

IV.

CONCLUSION

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

Dated: May 20, 2011

Respectfully submitted,

s/David Rothenberg

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