

**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**

APPLE INC.,

Counterclaim Plaintiff,

v.

MOTOROLA, INC. and  
MOTOROLA MOBILITY, INC.,

Counterclaim Defendants.

**MOTOROLA'S MOTION TO COMPEL RULE 30(b)(6)  
DEPOSITION TESTIMONY FROM APPLE  
AND ACCOMPANYING MEMORANDUM OF LAW IN SUPPORT**

Pursuant to Federal Rule of Civil Procedure 30(b)(6), 37(a) and S.D. Local Rule 26.1, Plaintiff and Counterclaim Defendant Motorola Mobility, Inc. (“Motorola”) respectfully moves this Court to compel Defendant and Counterclaim Plaintiff Apple Inc. (Apple”) to produce proper Rule 30(b)(6) testimony relating to Rule 30(b)(6) First Notice Topics 59 and 60 regarding the email notification function for iOS 5 and the source code for the webmail functionality of Apple’s accused MobileMe product.

## **I. PRELIMINARY STATEMENT**

Motorola brings this motion seeking 30(b)(6) witnesses on behalf of Apple relating to Apple products accused of infringing U.S. Patent Nos. 6,377,161 (“the ’161 patent”) and 6,101,531 (“the ’531 patent”). Apple cannot be permitted to deny Motorola testimony directly related to Motorola’s allegations that Apple infringes these two patents.

The '161 patent describes an invention for facilitating the exchange of address information between mobile devices. Motorola alleges, in part, that the Apple accused devices infringe the '161 patent because after Apple’s accused devices receive an email, they check the sender's email address against email addresses stored in the receiving device’s address book to see if the sender's email address is already associated with an existing contact. Then, depending on the result of that address book check, the accused devices process the address information in a predetermined manner, including, but not limited to, by offering the user the option to add the address to their contacts or viewing the sender's contact information.

Apple provided Dr. Cristobal Baray as a 30(b)(6) witness on Apple’s products relating to those email functions. During his deposition, Dr. Baray testified that devices running Apple iOS 5 offer notifications for new email messages, including summary information for those

messages. However, other than testifying that such notifications exist, Dr. Baray was unable to provide much, if any, additional information regarding how they function or whether the device checks its address book. Motorola has twice requested Apple to provide an additional corporate representative witness to testify on this Topic, but Apple has refused – claiming that the email notification functions are not accused of infringing the '161 patent. But, that is not correct—they are accused.

Accordingly, Apple should be compelled to provide a corporate designated witness prepared to testify regarding the email notifications on devices running iOS 5.

Apple likewise cannot deny Motorola 30(b)(6) testimony relating to the webmail application of Apple's accused MobileMe service. Apple designated a witness to testify on the source code for MobileMe, including webmail. But despite Motorola's requests, Apple did not grant access to the source code until the day before the Rule 30(b)(6) deposition on MobileMe. By that time, it was too late for Motorola to use the source code at deposition. The Protective Order requires that Motorola review the source code at the office of Apple's counsel and select the pages it wants printed, at which point Apple has two business days to deliver the printed pages. There was no way for Motorola's expert, or anyone else, to review the source code and identify and print relevant portions in time for the deposition of Apple's witness.

The MobileMe webmail source code is highly relevant, under Apple's control, and its production imposes almost no burden on Apple. Apple had no excuse for failing to provide that source code in time for deposition. Motorola therefore respectfully requests that the Court enter an order compelling Apple to provide a 30(b)(6) witness on the webmail source code.

## II. STATEMENT OF FACTS

### A. 30(b)(6) Testimony Regarding Email Notifications

Motorola's Deposition Notice to Apple. On July 27, 2011, Motorola served on Apple its Notice of Deposition of Apple, Inc. pursuant to Federal Rule of Civil Procedure 30(b)(6). That notice included topics seeking information about Apple's accused products, including the following topics 59 and 60:

59. The operation, structure, function, and implementation of capabilities in Apple's Accused Instrumentalities, including the source, operation, and implementation of Operation Code therein. [Operation code was defined to include source code.]

60. The file name(s) and directory location(s) for the source code referenced in Topic 59.

See Ex. A.<sup>1,2</sup>

Apple designated Dr. Baray to testify regarding topics 59 and 60 "as they relate to the email functionalities accused in Motorola's infringement contentions for the '161 patent," and Motorola took his deposition on February 16, 2012.

Deposition of Dr. Baray. At his deposition, Dr. Baray testified that for devices running iOS 5, when a new email is received, the devices "[REDACTED] [REDACTED]." Ex. B, Baray Tr. at 40:5-6.<sup>3</sup> This notification feature indicates that iOS devices running iOS 5 check the address book whenever a

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<sup>1</sup> "Ex \_\_" refers to the exhibits attached to the declaration of Cathleen G. Garrigan filed in support of this motion.

<sup>2</sup> Because Apple's failure to designate a witness on the topic and failure to provide source code in time constitutes a failure to provide discovery as opposed to an objection to discovery, there is no ability to set forth the question and objection as required for certain motions to compel.

<sup>3</sup> For the record, Motorola filed a redacted copy of this Motion on March 9, 2012, and redacted material that had been designated Confidential by Apple pursuant to the Court's Protective Order. (DE67.) On March 12, 2012, Motorola filed an unredacted version under seal.

new email is received in order to provide contact information for the sender as part of the summary information that is included with notifications for new emails. Motorola's infringement contentions are directed, in part, at this functionality. Ex. C at 10-13. Dr. Baray testified that the team he supervises at Apple handles source code relating to email on iOS devices, and he admitted that that "[REDACTED]" worked on the source code that relates to the notifications. Ex. B, Baray Tr. 55:15-17.

While Dr. Baray identified the existence of these email notifications, he stated he was **not** prepared to testify about them:

[REDACTED]

Ex. B, Baray Tr. 170:25-171:4. And while Dr. Baray acknowledged that there were two ways the email notifications could provide the name of the sender, he did not know which approach iOS 5 used—whether the system checks the address book to see if the sender's email address was present in the address book or uses whatever display name is included with the email address, if any. *Id.* at 57:17-58:13; 55:9-11 ("[REDACTED]"). Nor, could Dr. Baray say which source code files were responsible for the notification feature. *Id.* at 56:3-6.

Nevertheless, Apple refused at Dr. Baray's deposition to give Motorola a witness on the notification issue, and Apple maintained that refusal when the parties met and conferred on the issue on February 24. While Apple contended this notification is not accused, this is not correct,

as discussed above. Given Apple's position on the matter—and the rapidly approaching close of fact discovery on March 28<sup>4</sup>—is forced to bring this motion to compel.

**B. 30(b)(6) Testimony Regarding Source Code For MobileMe Webmail**

Motorola's Infringement Contentions. Motorola Mobility filed the complaint in this lawsuit, accusing Apple of infringing six of its patents, including the '531 patent. The '531 patent relates to methods for sending data, such as email messages, over a wireless network, in which a server filters the data based on user-selected criteria. For example, a user could select that emails from certain senders all be filtered into a folder for junk mail, instead of the user's inbox, and a server would apply that criteria to filter emails sent to the user.

Motorola's Requests For Source Code. Motorola has diligently sought production of the portions of Apple's source code relating to the methods recited in the '531 patent claims and discovery related thereto. On December 29, 2010, Motorola served its First Set of Request for Production to Apple seeking production of, among other things, Apple source code relevant to the functionalities of the accused products. *See* Ex. D at Request Nos. 1, 56, 64, 66, and 67. On January 31, 2011, Apple agreed to produce "responsive, non-privileged documents" in response to Request Nos. 56, 64, 66, and 67. *See* Ex. E.

On July 27, 2011, Motorola served on Apple its first Rule 30(b)(6) notice on Apple. Ex. A. That notice included topics seeking testimony on the source code for Apple's accused products relating to infringement of Motorola's patents. Topic 59 sought testimony on "the operation, structure, function, and implementation of capabilities" in Apple's accused products, including the "Operation Code," which was defined to include source code. *Id.* Topic 60 sought

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<sup>4</sup> The Court stated at the hearing on March 9, 2010, that it would grant the parties' joint motion to modify certain pretrial deadlines (DE 256), including the discovery deadline from March 16, 2012, to March 28, 2012.

testimony on “the file name(s) and directory location(s) for the source code referenced in Topic 59.” *Id.* On February 6, 2012, Apple designated Phil Peterson to testify regarding Topics 59 and 60 “as they relate to the MobileMe Rules functionality, and the MobileMe junk mail filtering functionality to the extent that Apple has information regarding that functionality, accused in Motorola’s infringement contentions for the ‘531 patent.” Ex. F.

Apple fails to produce key source code relating to the MobileMe Rules functionality in time for Motorola to prepare for Mr. Peterson’s deposition. During the week of January 30, Motorola’s expert reviewed Apple source code at the office of Apple’s counsel, as Motorola prepared for Mr. Peterson’s deposition. Motorola’s expert determined that Apple had not yet made available source code relating to Apple’s webmail service provided as a part of the accused MobileMe product. Motorola notified Apple on Wednesday, February 1, that while its source code review was still ongoing, Apple needed to provide “the web application code that creates and handles the user interface and application logic for editing Junk Mail filtering settings, and for creating mail rules.” Ex. G. Motorola then met and conferred with Apple regarding the source code on February 3 and February 6. Korhonen Decl. ¶ 1. It was not until February 7 that Apple finally indicated it had made the MobileMe webmail source code available. *Id.*

That did not mean that Motorola had immediate access to the code. The protective order agreed to by the parties establishes specific procedures governing source code. (D.E. 69.) Under that protective order, Motorola could not simply take the source code and show it to Mr. Peterson – the code must be reviewed on a laptop computer kept in a locked safe at the office of Apple’s counsel, Weil Gotshal & Manges in Redwood Shores, California. The reviewer must identify the particular source code files that relate to MobileMe webmail, print those files, then wait 2 business days for the printed pages to be produced by Apple. (D.E. 69.) By waiting until the

afternoon before Mr. Peterson's deposition, when Motorola's expert on source code was not available, Apple made it impossible for Motorola identify the particular files that needed to be printed. Moreover, even if he were available, Motorola would not have sufficient time print a hard copy, receive the production version, and show it to Mr. Peterson at his deposition.

On February 6, Motorola notified Apple that it would not be able to depose Mr. Peterson on February 8 on the source code for webmail, and that it would need an additional deposition on that topic. Ex. H. Apple refused to postpone Mr. Peterson's February 8 deposition, suggesting that Motorola somehow was at fault for Apple's tardy, February 7 production. Ex. I. Motorola requested a further deposition on the source code in multiple emails, at Mr. Peterson's deposition, and at a meet and confer with Apple on this issue on February 24, 2012. Korhonen Decl. ¶ 2. Apple continues to refuse to provide this discovery to Motorola. Motorola will be significantly prejudiced if it does not have an opportunity to depose an Apple 30(b)(6) witness on the source code for MobileMe webmail and thus brings this motion to compel.

### **III. LEGAL STANDARD**

“Rule 30(b)(6) obligates the responding corporation to provide a witness who can answer questions regarding the subject matter listed in the notice. *King v. Pratt & Whitney*, 161 F.R.D. 475, 476 (S.D.Fla.1995); Fed. R. Civ. P. 30(b)(6). “If the designated deponent cannot answer those questions, then the corporation has failed to comply with its Rule 30(b)(6) obligations and may be subject to sanctions.” *Id.*; *Quantachrome Corp. v. Micromeritics Inst. Corp.*, 189 F.R.D. 697, 699 (S.D. Fla. 1990) (“Micromeritics must designate persons who have knowledge of the matters sought by Quantachrome and must also prepare those persons so that they are able to give complete and knowledgeable answers.”). In particular, the corporation can be required to provide a witness to testify regarding the subject matter for which the first deponent was



unprepared. *E.E.O.C. v. Thurston Motor Lines, Inc.*, 124 F.R.D. 110, 114 (M.D.N.C. 1989) (“Brown had absolutely no right under the rules to refuse to designate a witness.... The Court now orders that the Rule 30(b)(6) deposition (and 30(b)(5) production of documents) of Brown be conducted in accordance with such notice as the Commission may give.”).

#### **IV. ARGUMENT**

##### **A. Apple Is Obligated To Provide A 30(b)(6) Witness To Testify Regarding Email Notifications And It Refuses To Do So**

Motorola’s Rule 30(b)(6) notice sought testimony on “the operation, structure, function, and implementation of capabilities” of the instrumentalities that Motorola accused of infringing Motorola’s ‘161 patent, including the related source code. *See* Ex. A at Topics 59 and 60. One of the instrumentalities accused of infringing the ‘161 patent is the way that Apple products process email. The email notification functionality of iOS is part of that process.

There is no dispute that the witness Apple offered on email relating to Motorola’s ‘161 patent assertions—Dr. Baray—was not prepared to testify on the operation or function of email notifications. Ex. B, Baray Tr. at 166:3-7. Nevertheless, Apple contends that it need not provide a witness on the email notifications because, according to Apple, the notification function is not accused. As detailed above, however, this is false. Motorola’s infringement contentions for the ‘161 Patent are directed, in part, to the way that email functions on iOS devices. In particular, those contentions relate to the way that email on Apple’s iOS devices processes address information from incoming emails, including checking the address book to see if the sender's address is stored in the address book and processing the address information in response to that address check.

The testimony sought from Dr. Baray is reasonably calculated to lead to the discovery of admissible evidence. Indeed, Dr. Baray’s existing testimony establishes that email notifications

may involve checking the email address of the email's sender against the address book. Though he hypothesized that the notification function may not involve such a check, he admitted that he did not know. In any event, email notifications are covered by Motorola's infringement contentions and therefore are covered by Motorola's 30(b)(6) Topics 59 and 60. Apple has no justification for its continued refusal to provide Motorola with a 30(b)(6) witness on email notifications.

**B. Apple Should Be Compelled To Provide A 30(b)(6) Witness To Testify Regarding The Source Code For MobileMe Webmail**

Apple likewise has no basis for denying Motorola 30(b)(6) testimony on source code for functionalities of Apple products that have been accused of infringement. Motorola is entitled to discovery on the source code for the webmail functionality for Apple's accused MobileMe product. Motorola propounded document requests directed to the source code for Apple's accused products and a Rule 30(b)(6) notice seeking a witness on that source code. Apple does not dispute that MobileMe, including webmail, is an accused product in this case. The source code that determines how that webmail functions is highly probative to Motorola's infringement case relating to the '531 patent. *See McKesson Information Solutions LLC v. Epic Sys. Corp.*, 495 F. Supp. 2d 1329, 1334 (N.D. Ga. 2007) (requiring defendant to produce its entire source code within ten days of order).

Apple, however, denied Motorola the opportunity to depose Apple's 30(b)(6) witness about that critical source code. Apple designated Mr. Peterson to testify on the source code for Apple's products accused of infringing the '531 patent, including MobileMe webmail. But, Apple did not make the source code for that function available for Motorola's expert to review at the office of Apple's counsel until the afternoon before Mr. Peterson's deposition. That late production meant that Motorola could not show Mr. Peterson the source code at his deposition.

Apple's refusal to provide deposition on that source code prejudices Motorola. Motorola bears the burden of proving that Apple's accused products infringe the '531 patent. Apple's 30(b)(6) witness and Apple documents show that MobileMe webmail meets the limitations of the '531 patent claims. MobileMe webmail allows users to select criteria (called "rules") and modify those rules. Those rules are sent to the webmail server and the webmail server then uses those rules to filter the user's email. A 30(b)(6) deposition on the source code that underlines these operations will provide further evidence of Apple's infringement. Thus, if Apple is allowed to deny Motorola a 30(b)(6) deposition with adequate time to review the relevant source code, it would deprive Motorola of valuable evidence that would help meet Motorola's burden of proving that Apple's products infringe the '531 patent. As a result, Apple should be compelled to provide a 30(b)(6) deposition relating to the source code for MobileMe webmail.

## V. CONCLUSION

For the foregoing reasons, Motorola respectfully requests this Motion to Compel be granted in its entirety.

### **CERTIFICATE OF GOOD FAITH CONFERENCE**

Pursuant to Local Rule 7.1(a)(3), I hereby certify that counsel for Motorola has conferred with counsel for Apple in a good faith effort to resolve the issues raised in the motion and has been unable to do so.

/s/ Matthew O. Korhonen  
Matthew O. Korhonen

Dated: March 9, 2012

Respectfully submitted,

MOTOROLA SOLUTIONS, INC. (f/k/a  
MOTOROLA, INC.) AND MOTOROLA  
MOBILITY, INC.

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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that on March 9, 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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Annette C. Escobar