IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA

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

MOTOROLA MOBILITY, INC.,	
Plaintiff,	
v.	**JURY TRIAL DEMANDED**
APPLE INC.,	
Defendant.	
APPLE INC.,	
Counterclaim Plaintiff,	
v.	
MOTOROLA, INC. and MOTOROLA MOBILITY, INC.,	
Counterclaim Defendants.	

APPLE'S OPPOSITION TO
MOTOROLA'S MOTION TO COMPEL RULE 30(b)(6)
<u>DEPOSITION TESTIMONY FROM APPLE</u>

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I. INTRODUCTION

Motorola seeks to compel Apple to provide additional Rule 30(b)(6) testimony on two separate grounds, neither of which has merit. First, Motorola demands that Apple provide a witness for deposition regarding a functionality in Apple's products that is not accused of infringement and is therefore irrelevant to this case.

Second, Motorola demands that Apple provide an additional witness for deposition regarding Apple's MobileMe service, despite the fact that Apple has already provided such a witness, on the grounds that Apple produced certain source code files to Motorola the day before that deposition. Motorola neglects to mention that Motorola only requested these source code files *two days* before the deposition (one day before Apple produced them). Apple went to great lengths to collect the source code and produce it in less than 24-hours after Motorola's request. Motorola has no basis to complain about the timing of the production. Moreover, Apple has already offered Motorola an additional deposition on these source code files, thus rendering moot this aspect of Motorola's motion.

II. STATEMENT OF FACTS

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

Motorola asserts that its '161 patent covers the functionality by which an Apple device, upon receiving a message, checks the sender's address against the device's address book and then takes certain actions. In particular, Motorola accuses the following three functionalities:

- In iOS,[1] when the user taps on an unknown address while reading an email, the user can add that address to the address book.
- In OS X, when the user clicks on an unknown address while reading an email, the user can add that address to the address book.
- In iOS, when the user is reading a text message from an unknown sender, the device displays a button that allows the user to add that sender to the user's contacts list.

See Motorola Motion to Compel ("Mot. to Compel"), Ex. C at 10-13.

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[1] iOS is the operating system used by Apple iPhone and iPad devices. OS X is the operating system used by Apple laptops and desktop computers. Although the two are related, they run different operating system and application software, including different mail applications. Only iOS-based phones support text messaging ("SMS").

Apple designated Dr. Cris Baray as a 30(b)(6) witness to testify about the operation of

Apple's products "as they relate to the email functionalities accused in Motorola' s infringement

contentions for the '161 patent." Mot. to Compel, Ex. A at 1. During Dr. Baray's deposition,

Motorola asked him a number of questions about "email notifications." *See id.*, Ex. B. "Email

notifications" are a separate functionality, available only in iOS 5,[2] and unrelated to the

functionalities described in Motorola's infringement contentions. Dr. Baray, who had not been

designated to testify on this topic, could not discuss it. *See id.*

Motorola subsequently requested that Apple designate another 30(b)(6) witness to testify

about email notifications. As this functionality is *not* accused of infringing any Motorola patent

in this case, Apple did not designate such a witness on an issue outside the scope of this

litigation. Motorola then filed the instant motion to compel Apple to designate such a witness.

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

In this litigation, Motorola asserts that its '531 patent covers part of the email

functionality provided by Apple's MobileMe service. In December 2010, Motorola served

document requests, which included a number of extremely broad and vaguely worded requests

for source code. *See* Mot. to Compel, Ex. D. In addition to objecting to these requests as overly

broad and unduly burdensome, Apple agreed to produce responsive, non-privileged documents.

See id., Ex. E. Over the course of this litigation, the parties have met and conferred a number of

times in order to clarify and narrow the scope of these requests, including requests for source

code related to the functionalities accused of infringing the '531 patent. Haskett Decl. ¶ 1.

On two occasions (January 5 and January 20, 2012), Motorola was scheduled to depose

Apple engineer Phil Peterson on topics that included source code related to MobileMe Rules, and

on both occasions, Motorola cancelled the deposition. Haskett Decl. ¶ 2. On February 1, 2012,

one week before the third scheduled deposition of Mr. Peterson, Motorola first requested "[t]he

web application code that creates and handles the user interface and application logic for editing

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[2] iOS 5 is version 5 of the iOS operating system for iPhone and iPad devices. Both iOS 4 and
iOS 5 contain the functionality accused in Motorola's infringement contentions as described
above. However, only iOS 5 supports the notification functionality at issue here.

Junk Mail filtering settings, and for creating mail rules" and requested a meet and confer for two days later, on Friday, February 3. Mot. to Compel, Ex. G at 1-2.

During the Friday meet and confer, Apple's counsel explained that ███████ ████████████████████████████████████ and therefore asked for further explanation of the request. Haskett Decl. ¶ 3. Motorola responded that it could not provide that explanation, but would attempt to do so the following Monday, February 6, 2012. *Id.*; Korhonen Declaration in Support of Motorola's Motion to Compel ("Korhonen Decl.") ¶ 1; Mot. to Compel, Ex. I at 1. During the Monday meet and confer, Motorola narrowed its request and Apple agreed to produce the narrower set of source code that is the subject of this dispute. Mot. to Compel, Ex. I at 1.

Apple provided this code for inspection the next day, Tuesday, February 7. Korhonen Decl. ¶ 1; Mot. to Compel, Ex. I at 1. Immediately after doing so, Apple offered to waive the normal 24-hour notice requirement for access to the source code so that Motorola could review the code before Mr. Peterson's deposition. Motorola did not review the code or make any further requests regarding review of the code before Mr. Peterson's deposition. Haskett Decl. ¶ 4. On February 8, 2012, Motorola deposed Mr. Peterson for the full 7 hours permitted under the FRCP. Motorola then filed the instant motion to compel additional 30(b)(6) testimony.

III.   ARGUMENT

A.   Motorola Has Not Accused Email Notifications.

Because email notifications have not been accused by Motorola of infringing any of its patents at issue in this case, Motorola is not entitled to deposition testimony regarding that functionality. Motorola's Rule 30(b)(6) deposition notice sought testimony on:

> 59. The operation, structure, function, and implementation of capabilities in *Apple's Accused Instrumentalities*, including the source, operation, and implementation of Operation Code therein.
> 60. The file name(s) and directory location(s) for the source code referenced in Topic 59.

Mot. to Compel, Ex. A at 17 (emphasis added). 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." Mot. to Compel at 3; *see also id.*, Ex. A.

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During Dr. Baray's February 16 deposition, Motorola asked a series of questions of Dr. Baray relating to the email notification functions in iOS 5. Because the email notification functionality is nowhere mentioned in the infringement contentions for the '161 patent,[3] Dr. Baray was not prepared to testify about that functionality. ███████████████████████

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███████████████████████████████████ *See, e.g.*, Mot. to Compel, Ex. B at 41:2-10, 55:5-11, 55:15-56:2, 56:25-4, 57:15-22.

As Dr. Baray noted in his deposition, ██████████████████████████████

███

██ *See*

Mot. to Compel at 3; *id*., Ex. B at 40:4-6.[4] This functionality alerts users when a new email has come in, and occurs completely separately from, and is unrelated to, the process by which a user reads an email. *See* Mot. to Compel, Ex. B at 61:8-20.

Notably, in support of its contention that Motorola has accused this functionality, Motorola's motion contains only a single citation to their infringement contentions, and that cites generally to 4 pages of the contentions without a single quote: "Motorola's infringement contentions are directed, in part, at this functionality. Ex. C, at 10-13." Mot. to Compel at 4. Not once in these four pages of Motorola's infringement contentions, however, is the email notification functionality mentioned, discussed, or described. *See id.*, Ex. C at 10-13. Rather, in

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[3] Infringement contentions provide detailed assertions about what the plaintiff contends infringes an asserted patent. As described below in detail, in December 2011, Judge Ungaro struck Motorola's attempt to supplement its contentions, holding that the court had ordered that final contentions be served by June 1.

[4] In its motion, Motorola follows this quote with a statement that "[t]his notification feature indicates that iOS devices running iOS 5 check the address book whenever a 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 Motion to Compel Rule 30(b)(6) Deposition Testimony from Apple at 3-4. However, Motorola does not provide any citations for this assertion, presumably because Motorola has adduced *no* evidence— including simple user testing—that it does so and because Dr. Baray testified at deposition ████ ████████████ Mot. to Compel, Ex. B at 55:4-11.

the infringement contentions, Motorola identifies three separate functionalities that are accused of infringing the '161 patent, all of which are completely separate and different from the email notification functionality. In particular, each of the accused functionalities occurs while a user is already reading the message in question, and only one of the three even applies to email on iOS devices. As a result, *none* of these is or includes email notifications.

> 1. *A user tapping on an address while reading an email is <u>not</u> email notifications.*

First, Motorola identifies tapping on an email address *in an open email*:

> (1) Where the second portable messaging unit is an Apple iPhone, iPad, or iPod Touch, after receiving an email's address information (address information), the user of the second portable messaging unit can check to determine whether information identical to the email address information is stored in the Contacts App (the address book) of that Apple iPhone, iPad, or iPod Touch. If not, the Apple iPhone, iPad, or iPod Touch creates a prompt screen upon user selection of the email address, which allows the user to select the email address and either create a new contact or add it to an existing contact:

Add an email recipient to your contacts list	Tap the message and, if necessary, tap Details to see the recipients. Then tap a name or email address and tap Create New Contact or "Add to Existing Contact."
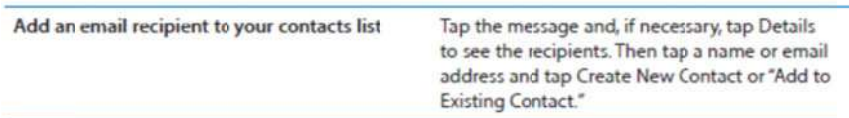
> *Id.* at MOTO-APPLE-0006037953_126751.

Motorola Motion to Compel, Ex. C. at 10-11. As cited by Motorola, this functionality requires that the user "[t]ap the message, and, if necessary tap Details to see the recipients. Then tap a name …." *Id.* This is therefore not the email notification functionality.

> 2. *A user clicking on an address while reading an email in OS X is <u>not</u> iOS email notifications.*

Second, Motorola identifies clicking on an email address *in an open email* on a computer running *OS X*:

> 2) Where the second portable messaging unit is an Apple Computer, after receiving an email's address information (address information), the user of the second portable messaging unit can check to determine whether information identical to the email address information is stored in the Address Book Application (the address book) of that Apple Computer. If not, the Apple Computer creates a drop-down list upon user selection of the email address, from which the user can create a new contact or add it to an existing contact:

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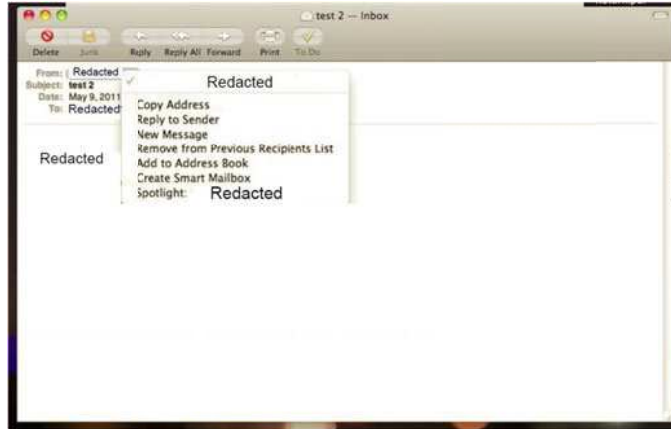
Screenshot of Apple Computer Screen, taken May 9, 2011,
MOTO-APPLE-0006037953_126641.

Mot. to Compel, Ex. C. at 11-12. First, this accused functionality is once again based on an

email that is already open. Second, this functionality is an OS X "Apple Computer," *not* an iOS

device for which Motorola argues notifications are accused. This, also, is therefore not the email

notification functionality.

3. A button visible while reading a text message is not email notifications.

Finally, Motorola identifies the display of an "Add to Contacts" button when viewing a

received text message ("SMS"):

> (2) [sic] Where a text message containing address information
> (address information) is received by a second Apple iPhone
> (second messaging unit), the user of the second portable messaging
> unit can check to determine whether information identical to the
> email address information is stored in the Contacts App (the
> address book) of that Apple iPhone. If not, the Apple iPhone
> creates a prompt screen upon user selection of the email address,
> which allows the user to select the email address and either create a
> new contact or add it to an existing contact:

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See iPhone 4 Screenshots, taken January 3, 2011, MOTO-APPLE-
p0006037953_126643 (arrows and labels added).

Mot. to Compel, Ex. C. at 12-13. First, as above, this only accuses functionality in messages that

have already been opened by the user. Further, the above functionality is related to SMS

messages, and not to emails. Dr. Baray was only designated to testify on "email functionality,"

and Motorola seeks to compel testimony "regarding the email notification function." The email

notification function is separate and unrelated to the "Add to Contacts" button when reviewing a

text message. Moreover, email and text messaging are separate applications.

    *4. Motorola is legally precluded from accusing the email notification
        functionality.*

On December 6, 2011, Judge Ungaro granted Apple's motion to strike a set of

"Supplemental Infringement Contentions" put forth by Motorola in October 2011, over four

months after the court-ordered June 1, 2011 deadline. Order Granting Motion to Strike, Dkt.

198. It is undisputed that the email notification functionality did not exist until iOS 5, which was

first previewed to the public on June 6, 2011, and released on October 12, 2011, both of which

are after the deadline to supplement infringement contentions. Motorola cannot argue in good

faith that when it served its infringement contentions on May 18, 2011, *see* Cathleen Garrigan

Declaration in Support of Mot. to Compel ¶ 3, it was accusing functionality that was

unannounced to the public. The email notification function was not available for almost five

months after Motorola served its infringement contentions. In any event, under Judge Ungaro's

order, Motorola's infringement contentions are final and Motorola is precluded from accusing

additional products or functionality.[5]

In sum, Motorola has not accused—and cannot accuse—the email notification

functionality. Testimony on functionality that Motorola has not accused is not reasonably

calculated to lead to admissible evidence, and Motorola is not entitled to a designated 30(b)(6)

witness on functionality which is not alleged to infringe. S*ee* Fed. R. Civ. P. 26(b)(1).

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[5] The "Supplemental Infringement Contentions" Motorola sought to use are identical to the
original contentions with respect to the pages cited by Motorola in its motion. *See* Motorola
Supplemental Infringement Contentions at 12-15, Dkt 160.

Therefore, the Court should deny Motorola's motion to compel production of a 30(b)(6) witness on any topics relating to email notifications.

B. Motorola is Not Entitled to an Additional 30(b)(6) Witness on MobileMe Because Apple Provided the Requested Source Code in a Timely Manner.

Because Apple provided access to the MobileMe webmail source code as soon as it was requested—and indeed, went out of its way to make the code available as quickly as possible for use at deposition—Motorola is not entitled to an additional deposition.

1. Motorola was not diligent in seeking the relevant MobileMe source code.

Motorola points out that it discovered that Apple had not produced the source code in question during the week before Mr. Peterson's February 8 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.[6]

Mot. to Compel at 6. However, Motorola does not mention that this was the *third time* that Mr. Peterson had been scheduled to be deposed on these topics, that Motorola had cancelled both previous scheduled dates, and that the previously scheduled date was January 20—before Motorola even reviewed the MobileMe source code production. Haskett Decl. ¶ 2; Mot. to Compel, Ex. F at 1-2. If any of the previous depositions had gone forward as planned, Motorola would likely not even have reviewed the code, let alone notified Apple of perceived deficiencies.

2. Apple responded in a timely manner to Motorola's requests for source code.

After reviewing the source, on Wednesday, February 1—exactly a week before Mr. Peterson's *third* scheduled deposition—Motorola notified Apple of nineteen perceived deficiencies in Apple's source code production on various topics and included a request for "[t]he web application code that creates and handles the user interface and application logic for editing Junk Mail filtering settings, and for creating mail rules." Mot. to Compel, Ex. G at 1-2.

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[6] Motorola's initial Requests for Production were overbroad and provided Apple with no guidance as to which source code—out of the enormous quantities of source Apple possesses—was sought. As a result, extensive meet and confer discussions were required in order for Apple to determine which code it was that Motorola was legitimately seeking.

Motorola also requested to meet and confer on that Friday, February 3. *Id.* at 2. The parties met and conferred that Friday, as requested. Korhonen Decl. ¶ 1; Mot. to Compel, Ex. I at 1.

During the Friday meet and confer, Apple's counsel explained that ████████████ ██████████████████████ and therefore asked for further explanation for what was meant by "[t]he web application code that creates and handles the user interface and application logic for editing Junk Mail filtering settings, and for creating mail rules." Haskett Decl. ¶ 3. Motorola's counsel responded that he could not provide that explanation, but would attempt to answer the question during a meet and confer the following Monday. *Id.* ¶ 3; Korhonen Decl. ¶ 1; Mot. to Compel, Ex. I at 1.

During the meet and confer on Monday, February 6, Apple agreed to produce the source code that is the subject of this dispute: certain webmail source code relating to MobileMe Rules functionality.[7] Mot. to Compel, Ex. I at 1. Through significant effort, Apple produced this code the *next day*, Tuesday, February 7. Korhonen Decl. ¶ 1; Mot. to Compel, Ex. I at 1. Any delay in the production of this source code was due to Motorola's lack of diligence, and inability to clarify its source code requests until two days before the relevant deposition, and not to any delay or "waiting" on Apple's part. Motorola created its own problem that it now complains about and is not entitled to additional deposition testimony related to the source code in question.

3. *Apple provided extremely rapid access to the relevant MobileMe source code.*

Not only did Apple produce the code in a single day, less than a week after Motorola first informed Apple of its request for additional production, but Apple went out of its way to ensure that Motorola had access to the code before the deposition. First, Motorola argues that the protective order rendered it impossible to print the source code in time for the deposition:

> 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

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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."

Mot. to Compel at 6-7. However, as described above, Apple produced the code in a timely fashion, and as Motorola notes, it was their expert's unavailability rather than any printing delay that prevented it from examining the source code in time. *See id.* Apple should not be now punished for a circumstance—unavailability of Motorola's expert—beyond Apple's control.

Further, to the extent Motorola blames the protective order for its inability to make use of the source code, it neglects to mention that immediately after informing Motorola of the source code's availability, Apple explicitly waived the notice period required under the protective order:

> To be clear, even though Motorola has not given the requisite 24-hour notice that it intends to inspect Apple's source code today, we will waive the notice requirement if you or your experts wish to inspect source code this afternoon.

Haskett Decl., Ex. 1 at 1. To the extent it believed that there would be a delay in printing, Motorola did not request any additional waiver, *see id.* ¶ 4, and as it admits, any perceived inability to print did not affect its ability to review or make use of the source code.

Finally, notwithstanding the fact that Apple diligently and timely responded to Motorola's belated and last-minute request for additional source code, in an effort to resolve this dispute between the parties, Apple has offered Motorola an additional one-hour deposition limited to questions relating to the webmail source code produced on February 7. One hour is more than sufficient time for Motorola to be able to ask questions about the source code in question. Further, Mr. Peterson's deposition on February 8 consisted of 7 hours and 2 minutes of testimony on the record. Accordingly, Apple has offered an hour *over* the time Motorola would have had, consistent with the 7-hour limit on depositions, if they had asked Mr. Peterson about the source code at the deposition. Accordingly, in light of this offer, Motorola's motion should be denied as moot, in any event.

IV. CONCLUSION

For the foregoing reasons, the Court should deny Motorola's Motion to Compel.

Dated: March 16, 2012   WEIL, GOTSHAL & MANGES LLP

                                                          _ */s/* Christopher R. J. Pace___ _ _____

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CERTIFICATE OF SERVICE

I hereby certify that on March 16, 2012, 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 via ECF.

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