Motorola Mobility, Inc. v. Apple, Inc. Doc. 323 Att. 5

EXHIBIT D

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From: Marshall Searcy <marshallsearcy@quinnemanuel.com>
Sent: Saturday, April 14, 2012 2:27 PM
To: Schmidt, Jill
Cc: David Perlson; Davis, Mark; HaskettCS@cov.com; Cappella, Anne; Graham Pechenik; emullins@astidavis.com; Matthew.Powers@tensegritylawgroup.com; Pace, Christopher
Subject: Re: Proposed Florida Schedule

Jill,
There appears to be a pattern emerging of Apple reneging on its agreements.

My email to you of yesterday accurately reflected our discussions. I also asked you to correct anything that you believed was incorrect. Yet, Apple corrected nothing (as there was nothing to correct) and waited until after our filing to say that it now opposed Motorola's motion.

Henceforth, we are really going to have to insist that Apple attorneys with authority take part in our discussions. It has become apparent that we can't rely on any of Apple's representations as the meet and confers are currently staffed.

As to Apple's insistence on a comprehensive schedule, your own e-mail acknowledges that HTC won't agree to participate in creating such a schedule at this point, so Apple is demanding something that it knows it cannot have. We have provided Apple with a proposed schedule for FLA1, which is what the Court has asked the parties to provide, and remain willing to work with Apple on creating a logical and efficient schedule. However, Apple's insistence that HTC be added to FLA1 is neither. Please let me know if someone on Apple's side wishes to--and can--participate in a discussion about sensible scheduling for FLA1.

On Apr 14, 2012, at 1:33 PM, "Schmidt, Jill" <jill.schmidt@weil.com> wrote:

> Hi Marshall,
>
> I write because you filed an unopposed motion for leave to amend Motorola's complaint before receiving a final response from us and because Motorola's motion does not accurately state Apple's position. As stated in my email on Friday morning, and as I reiterated on our call, Apple does not object in principle to Motorola's proposed amendment, but cannot agree to Motorola adding six new patents under the current schedule. As Apple made clear, Apple would not oppose Motorola's motion only if Motorola agreed to submit proposed comprehensive schedules for FL-1 and FL-2 to be raised with the Court prior to our hearing next Thursday:
>
> …Apple will not oppose Motorola's motion as long as Motorola agrees to submit a joint statement to the court with a comprehensive set of schedules for both FL cases (with input from HTC) in time to be addressed at the April 19 hearing.
>
> While the parties were unable to reach agreement on a schedule during the meet and confer on proposed schedules on Friday, although agreeing that the current FL-2 schedule is unworkable, Motorola's refusal to submit proposed schedules to the court for discussion at the Thursday hearing does not change Apple's position. Since Motorola is unwilling to submit proposed schedules to the Court, Apple opposes Motorola's motion to amend its FL-2 complaint to add six new patents. Please correct your characterization of Apple's position on Monday.

Also, since the parties appear to be at an impasse on the extensions to the FL-1 and FL-2 schedules, Apple will file its own motion to amend the procedural schedules in both FL-1 and FL-2 early next week. Apple believes that a quick resolution to the schedule is necessary given the approaching deadlines, even though HTC is unwilling to substantively engage in discussions regarding FL-2 schedules until after it responds to Apple's counterclaims on May 11. If Motorola changes its mind regarding a joint submission of proposed schedules to the Court, please let us know.

Best regards,
Jill

From: Marshall Searcy [mailto:marshallsearcy@quinnemanuel.com]
Sent: Friday, April 13, 2012 04:50 PM
To: Schmidt, Jill
Cc: David Perlson <davidperlson@quinnemanuel.com>; Davis, Mark; HaskettCS@cov.com <HaskettCS@cov.com>; Cappella, Anne; Graham Pechenik <grahampechenik@quinnemanuel.com>; emullins@astidavis.com
Subject: RE: Proposed Florida Schedule

Jill,
Thanks for speaking with us today. To follow up on our discussion:

Scheduling for FLA1--Apple's position is that the '721 patent—currently in the FLA2 case—should be included in the claims to be tried in FLA1. Motorola is willing to agree to this addition.

However, Apple also wishes to try its claims on the '721 against HTC in FLA1, even though HTC is not a party to FLA1, HTC has not even answered in FLA2 and Apple already has slide-to-unlock claims pending against HTC in Delaware. During the call, you stated that Apple wanted to include HTC in FLA1 because it wished to avoid duplicative discovery from Motorola and HTC on the '721 patent in FLA1 and FLA2, respectively. However, as I stated, it seems the easiest solution to this problem would be to leave the '721 patent in the FLA2 case, where it is currently pending. In any event, Motorola does not agree to the addition of HTC in FLA1.

Because you were not in a position to agree to reach an agreement on the phone, you stated that you would check with the partners on the Apple side as to whether Apple could agree that HTC not be included in FLA1, or alternatively, that the '721 patent simply stays in FLA2. Please let me know as soon as possible.

Motion to Amend—You stated that Apple would not oppose the motion so long as the parties, including HTC, were able to come up with a comprehensive schedule for FLA2 by April 19. As Motorola advised, it is not in position to force HTC to an agreement on dates, nor is it reasonable to expect HTC to agree to dates considering the current procedural posture of FLA2. I did confirm, however, that Motorola recognizes that the current FLA2 schedule will have to be adjusted, and Motorola will be willing to engage in discussions on that schedule. You stated that, in light of this statement, Apple did not oppose Motorola's motion to amend. Please let me know right away if I have misunderstood Apple's position on the motion to amend.

Have a great weekend.

From: Schmidt, Jill [mailto:jill.schmidt@weil.com]
Sent: Friday, April 13, 2012 8:52 AM

To: Marshall Searcy
Cc: David Perlson; Davis, Mark; HaskettCS@cov.com; Cappella, Anne; Graham Pechenik; emullins@astidavis.com
Subject: RE: Proposed Florida Schedule

Hi Marshall,

Although Apple does not object in principle to Motorola's proposed amendment to add six new patents to the FL-2 case, Apple does object to such an amendment in light of the current schedule. First, the current FL-2 schedule was adopted before Apple answered the complaint and Motorola itself reserved the right to "revisit these dates if necessary" if Apple asserted new patents. Now that Motorola seeks to add six additional patents (and additional patents may be added by HTC when it files its responsive pleading on May 11), the current FL-2 schedule is unworkable. Also, even if the parties agree that some of the FL-2 issues should be consolidated with FL-1, Motorola's currently proposed schedule does not allow sufficient time for discovery on those new issues and, unless Apple's claim against HTC for the '721 patent is included in FL-1, would require duplicative discovery in FL-1 and FL-2.

Therefore, Apple will not oppose Motorola's motion as long as Motorola agrees to submit a joint statement to the court with a comprehensive set of schedules for both FL cases (with input from HTC) in time to be addressed at the April 19 hearing. Please let us know if Motorola agrees.

I am available at 1pm PT to discuss. Please circulate a dial-in.

Best regards,
Jill

From: Marshall Searcy [mailto:marshallsearcy@quinnemanuel.com]
Sent: Friday, April 13, 2012 7:45 AM
To: Marshall Searcy
Cc: Schmidt, Jill; David Perlson; Davis, Mark; HaskettCS@cov.com; Cappella, Anne; Graham Pechenik; emullins@astidavis.com
Subject: Re: Proposed Florida Schedule

All,
Motorola will be filing its motion to amend today. Despite our repeated requests, and despite having provided the proposed complaint to Apple on Tuesday, we still have not heard anything from Apple. Please advise by no later than 10:30 a.m. Pacific time whether Apple intends to oppose Motorola' motion.

In addition, we have not received any response to our scheduling proposal, notwithstanding the Court's direction that the parties meet and confer and try to come to an agreement on scheduling. We suggest that the parties conduct a telephonic conference at 1 pm Pacific time today to see if we can make any headway on this issue.

On Apr 12, 2012, at 2:44 PM, "Marshall Searcy" <marshallsearcy@quinnemanuel.com> wrote:

> Jill and Anne,
> Now that Apple has had the proposed amended complaint for a couple of days, would you let us know if Apple intends to oppose Motorola's motion to amend?

From: Marshall Searcy
Sent: Tuesday, April 10, 2012 10:59 PM
To: 'Schmidt, Jill'
Cc: David Perlson; 'Davis, Mark'; 'HaskettCS@cov.com'; 'Cappella, Anne'; Graham Pechenik
Subject: RE: Proposed Florida Schedule

Jill,
Please find attached Motorola's proposed amended complaint and a redline version.

From: Schmidt, Jill [mailto:jill.schmidt@weil.com]
Sent: Monday, April 09, 2012 12:46 PM
To: Marshall Searcy
Cc: David Perlson; Davis, Mark; 'HaskettCS@cov.com'; Cappella, Anne
Subject: RE: Proposed Florida Schedule

Hi Marshall,

To the extent Motorola is intending to move for leave to amend its FL-2 complaint in lieu of filing its response to Apple's counterclaims today, please send us your proposed amendment immediately so we can evaluate whether we are going to oppose Motorola's motion.

Thanks,
Jill

From: Cappella, Anne
Sent: Sunday, April 08, 2012 10:21 AM
To: Marshall Searcy
Cc: David Perlson; Davis, Mark; Schmidt, Jill; 'HaskettCS@cov.com'
Subject: RE: Proposed Florida Schedule

Marshall,
We'll need to see the proposed amended complaint before we can take a position.

Also, we haven't heard back from you regarding our proposal for the Florida schedules. Please let us know Motorola's position. Thanks.

-Anne

<image001.jpg>

Anne Cappella

Weil, Gotshal & Manges LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065-1134
anne.cappella@weil.com
+1 650 802 3141 Direct
+1 650 303 0309 Mobile
+1 650 802 3100 Fax

From: Marshall Searcy [mailto:marshallsearcy@quinnemanuel.com]
Sent: Saturday, April 07, 2012 6:09 PM
To: Cappella, Anne
Cc: David Perlson; Davis, Mark; Schmidt, Jill
Subject: Re: Proposed Florida Schedule

Anne,
Just to follow up on this, Motorola will be moving for leave to amend its complaint to add new patents. Please let me know if Apple will oppose Motorola's motion.

On Mar 29, 2012, at 2:57 PM, "Marshall Searcy" <marshallsearcy@quinnemanuel.com> wrote:

> Anne,
> Motorola does intend to add several additional patents.
>
> ---
>
> **From:** Cappella, Anne [mailto:anne.cappella@weil.com]
> **Sent:** Wednesday, March 28, 2012 3:31 PM
> **To:** Marshall Searcy; David Perlson
> **Cc:** Davis, Mark; Schmidt, Jill
> **Subject:** RE: Proposed Florida Schedule
>
> Marshall,
> We are still discussing your proposal with our client.
>
> You mentioned on our previous call that Motorola may be adding additional patents to the FL-2 case. For scheduling discussions, it would be helpful to know whether Motorola will be adding any patents (and how many) on Monday. Thanks.
>
> -Anne
>
> <image001.jpg>
>
> **Anne Cappella**
>
> Weil, Gotshal & Manges LLP
> 201 Redwood Shores Parkway
> Redwood Shores, CA 94065-1134
> anne.cappella@weil.com
> +1 650 802 3141 Direct
> +1 650 303 0309 Mobile
> +1 650 802 3100 Fax
>
> ---
>
> **From:** Marshall Searcy [mailto:marshallsearcy@quinnemanuel.com]
> **Sent:** Tuesday, March 27, 2012 1:53 PM
> **To:** Cappella, Anne; David Perlson
> **Cc:** Davis, Mark; Schmidt, Jill
> **Subject:** RE: Proposed Florida Schedule
>
> Anne and Mark,

Just to follow up, could you guys let me know Apple's position on the proposal that we discussed on Thursday, i.e., that Motorola's current claims in FLA2 and certain of Apple's claims from FLA2 be tried in FLA1?

From: Cappella, Anne [mailto:anne.cappella@weil.com]
Sent: Thursday, March 22, 2012 11:11 AM
To: Marshall Searcy; David Perlson
Cc: Davis, Mark; Schmidt, Jill
Subject: RE: Proposed Florida Schedule

Yes. We can use this dial-in: 1-800-782-1473 (passcode 3999740).
-Anne

<image001.jpg>

Anne Cappella

Weil, Gotshal & Manges LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065-1134
anne.cappella@weil.com
+1 650 802 3141 Direct
+1 650 303 0309 Mobile
+1 650 802 3100 Fax

From: Marshall Searcy [mailto:marshallsearcy@quinnemanuel.com]
Sent: Thursday, March 22, 2012 10:03 AM
To: Cappella, Anne; David Perlson
Cc: Davis, Mark; Schmidt, Jill
Subject: RE: Proposed Florida Schedule

Hi Anne, are you available at 4 today for a discussion on this?

From: Cappella, Anne [mailto:anne.cappella@weil.com]
Sent: Wednesday, March 21, 2012 3:23 PM
To: David Perlson
Cc: Marshall Searcy; Davis, Mark; Schmidt, Jill
Subject: Proposed Florida Schedule

David and Marshall,
Mark Davis asked me to respond to the email you sent to him last night since he is traveling.

If the only remaining discovery concerned our subpoena to Rovi, an additional month may have been sufficient. Unfortunately, that is far from the case.

As we mentioned at the hearing, an amendment to your invalidity contentions will require more than a sole Neonode deposition and Rovi's compliance with Apple's subpoena. For one, given that the '185 reference is not prior art on its face, Apple will have to locate and depose the inventors of the '185 patent about what they invented, when they invented it, and about any relevant documentation that

allegedly corroborates the earlier invention date. Apple may also have to depose additional individuals who worked with or who are relied on by Motorola to otherwise corroborate the inventors' testimony. Further, Apple will need to obtain and thereafter conduct an extensive review of any documentation allegedly corroborating the inventors' statements. On top of all this, it will require additional time if these third-parties do not voluntarily provide Apple the discovery it needs. This process alone will require more than one month to complete.

Second, despite Apple's request, Motorola still has not provided its invalidity contentions with respect to the '185 reference unless Motorola intends to drop this reference. Only until we receive and evaluate Motorola's contentions for a patent that is not prior art on its face will Apple be able to judge the extent of discovery that will be required. At a minimum, Apple cannot further narrow its claims under the current schedule without Motorola's contentions and further discovery.

Third, Apple will need to conduct further discovery into the first US sales of the Neonode N1 device in order to determine whether it even qualifies as prior art. As neither of Neonode's 30(b)(6) designees was able to state definitively when the first US sales occurred, further depositions may be required.

Fourth, unless Motorola intends to drop the Juels prior art reference against the '849 patent, the depositions of both of these third-party inventors will need to be sought and taken. Again, if they do not appear voluntarily, it will take additional time to compel their depositions.

Fifth, there may be other and currently unforeseen issues that call for additional discovery. For example, Motorola has not yet served its amended invalidity contentions on Apple. If these contentions raise new issues (e.g., other Neonode references, etc.), Apple will certainly need to take all of the appropriate steps to explore those matters. This would involve further time and effort to locate documents and witnesses, review documents, and depose witnesses.

Sixth, there are many outstanding 30b6 topics and missing document production that has been and is just now coming to light. Motorola delayed in providing STB witness until the end of February (and has only provided 3 total witnesses thus far). It is during these depositions that Apple has learned that Motorola has failed to produce a significant number of relevant documents. Further, Apple continues to learn through discussions with third party IPG maker Rovi and cable service providers of additional documents in Motorola's possession it failed to produce. For example, Rovi stated that it has thousands of communications with Motorola, which Apple has not been able to locate in Motorola's production.

Invalidity contentions aside, there are other reasons that justify our proposed extension. Apple is still pursuing much-needed discovery

from uncooperative third-parties. For example, despite serving Rovi with a subpoena back in January, Rovi has not agreed to put up witnesses for deposition until just this week. Rovi has also finally agreed to look into and produce certain documents Apple requested several months ago. We are expecting those documents sometime next week and are in the midst of negotiating deposition dates. If it turns out that Rovi's productions remain deficient, Apple will have to pursue further discovery from Rovi. Of course, Apple is not just seeking third-party discovery from Rovi. Apple also is still in negotiations with various cable providers to produce requested documentation and deposition witnesses. For at least some of these third-parties, it appears that motions to compel will need to be filed. It will take well over a month for the motions to be heard and for those depositions to be ultimately scheduled in the various jurisdictions governing the subpoenas. Motorola's promises to these third parties and Apple to produce documents on their behalf has only contributed to delay this process because: Motorola does not appear to have produced all the documents it promised, Motorola forced Apple to seek the court's intervention to obtain the information, and Motorola engaged in protracted rolling productions of responsive documents.

Further, Apple is still in need of discovery from Motorola. For instance, we are still waiting for Motorola to complete its rolling production of documentation connected to its set-top boxes and Motorola continues to refuse to identify exactly when it will be complete. These documents include agreements with cable providers, US-only sales, global sales, statements of work or amendments to agreements that show the terms and rates for post-sale set-top box related services, bills of materials, documentation of the bootloader running on all the accused set-top boxes, etc. Apple also needs further depositions, including depositions for Mr. Rossi and designees for certain topics that previously-designated Rule 30(b)(6) witnesses were not adequately able to address (see, e.g., Jason Lang's March 9 email to John Duchemin, cc'ing you). While we have addressed the immediate discovery issues known to Apple, other 30b6 topics and discovery from Motorola are yet to be fulfilled by Motorola (see, e.g., Jason Lang's March 21 email to John Duchemin). In addition to the reasons stated above, addressing these discovery matters with Motorola will require an extension of more than a month.

Finally, as Apple made clear to Motorola earlier in the year, one of Apple's trial counsel has a conflict with the current trial schedule, which would not be cured by a one month extension. Apple's proposed schedule would avoid this conflict.

For the sake of efficiency and fairness, we believe our proposed schedule will address our currently anticipated needs and will prevent us from having to go back to court to ask for further extensions of time. If you would like to discuss this further, please do not hesitate to contact Mark Davis or me. If we cannot reach agreement by tomorrow, however, we intend to move the court to implement our proposed schedule.

Thanks,

-Anne

<image001.jpg>

Anne Cappella

Weil, Gotshal & Manges LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065-1134
anne.cappella@weil.com
+1 650 802 3141 Direct
+1 650 303 0309 Mobile
+1 650 802 3100 Fax

From: David Perlson <davidperlson@quinnemanuel.com>
Date: March 20, 2012 9:53:48 PM EDT
To: "'Davis, Mark'" <mark.davis@weil.com>
Cc: Marshall Searcy <marshallsearcy@quinnemanuel.com>
Subject: RE: Proposed Florida Schedule

+ Marshall

Mark, as I indicated in the call, we understand what the Court stated regarding granting Apple a reasonable extension of expert and discovery dates to account for the amendment of the invalidity contentions. But the three months or more you propose is unnecessary for that. As we stated at the hearing, the Neonode depo already occurred and Apple already subpoenaed Rovi quite some time ago. Any additional discovery you claim to need should easily be completed within a month of the current schedule. In any event, to date you have not provided us with a particularized showing of what specific additional discovery you need. Please provide us with that information and we will consider whether an extension of more than one month is appropriate.

Further, your email references Apple's refusal to allow the addition of new products in FLA 1. As I stated before, Motorola would be willing to agree to Apple adding its proposed amendment provided that Apple likewise agree to Motorola's amending its infringement contentions with new products. My understanding is that Apple will not agree to this. So the record is clear, however, Motorola would be willing to agree to a longer extension – one closer to the extension you propose – in the event you were to accept Motorola's proposal for bilateral amendment.

Thanks,

David

From: Davis, Mark [mailto:mark.davis@weil.com]
Sent: Tuesday, March 20, 2012 3:03 PM
To: David Perlson
Subject: RE: Proposed Florida Schedule

any thoughts on the proposed extensions?

From: Davis, Mark
Sent: Monday, March 19, 2012 9:13 PM
To: davidperlson@quinnemanuel.com
Subject: Proposed Florida Schedule

David,

Pursuant to our call earlier today, I've attached a new proposed schedule for Florida 1 given the recent developments in that case, including the new invalidity issues and the outstanding Motorola and third party discovery issues. Please let me know if you agree to the proposed extension.

As Jill outlined in her recent email, we also do not agree with Motorola's proposed reasons to combine portions of Florida 2 with Florida 1. The Court already rejected Motorola's attempt to add new products to Florida 1 - which would require the reopening of numerous depositions to deal with new products.

	FL-1 (current)	FL-1 (proposed extension)
Deadline to serve amended invalidity contentions	--	3/26/12
Apple to substantially narrow asserted claims	3/22/12	4/26/12
Close of fact discovery	3/28/12	6/29/12
Opening expert reports	3/30/12	7/13/12
Rebuttal expert reports	4/27/12	8/17/12
Close of expert discovery	5/15/12	8/31/12
Deadline to file dispositive motions	5/18/12	9/7/12
Deadline to file pretrial motions	6/1/12	10/29/12
Deadline to file joint pretrial stipulations / jury instructions	9/13/12	1/11/13
Calendar call	10/16/12	1/22/13
Trial	10/22/12	1/28/13

Thanks,
Mark

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