

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

MOTOROLA MOBILITY, INC.,	
	Plaintiff,
v.	
APPLE INC.,	
	Defendant.

JURY TRIAL DEMANDED

Consolidated Cases:
Case No. 1:10-cv-23580-RNS
Case No. 1:12-cv-20271-RNS

APPLE INC.,	
	Counterclaim Plaintiff
v.	
MOTOROLA MOBILITY, INC., HTC CORPORATION, HTC AMERICA, INC., ONE & COMPANY DESIGN, INC., and HTC AMERICA INNOVATION INC.,	
	Counterclaim Defendants.

**DECLARATION OF REBEKAH L. PUNAK IN SUPPORT OF
HTC COUNTERCLAIM DEFENDANTS' REPLY MOTION TO SEVER**

I, Rebekah L. Punak, declare as follows:

1. I am a member of the bar of the State of California, admitted *pro hac vice* in this action and an associate at the law firm of Kecker & Van Nest LLP, counsel of record for Defendants, HTC Corporation, HTC America, Inc., One & Company Design, Inc., and HTC America Innovation Inc. in the above-captioned action. Except where expressly stated, I have knowledge of the facts set forth herein, and if called to testify as a witness thereto, could do so competently under oath.

2. Attached hereto as Exhibit A is a true and correct copy of Apple's Motion to Compel Discovery of Documents, Information, or Objects from Non-Party Google, Inc., filed in *Apple Inc. v. Samsung et al.*, case no. 5:12-cv-00630 (N.D. Cal. Feb. 8, 2012) as Docket Number 135 on April 24, 2012.

3. Attached hereto as Exhibit B is a true and correct copy of High Tech Computer Corp., A/K/A HTC Corp., HTC (B.V.I.) Corp., HTC America, Inc. and Exedea, Inc.'s Answering Brief in Opposition to Apple Inc. and Next Software, Inc.'s Motion for Consolidation of the Captioned Cases, filed in *Apple et al. v. HTC et al.*, Case No. 1:10-cv-00167 (D. Del. June 21, 2010), as docket number 41 on June 21, 2010.

4. Attached hereto as Exhibit C is a true and correct copy of Apple, Inc. and Next Software, Inc.'s Brief in Support of their Motion for Consolidation of the Captioned Cases for the Purpose of Coordinating Pretrial Proceedings filed in *Apple et al. v. HTC et al.*, Case No. 1:10-cv-00167 (D. Del. June 21, 2010) as docket number 20 on May 24, 2010.

5. Attached hereto as Exhibit D is a true and correct copy of the Corrected Complainants Apple Inc. and Next Software Inc.'s Combined Opposition the Staff's, Nokia's

and HTC's Motions for Consolidation filed in *In re Certain Personal Data and Mobile Communications Devices and Related Software*, Inv. No. 337-TA-710 on April 22, 2010.

6. Attached hereto as Exhibit E is a true and correct copy of a Study of the Android Development Activity and its Authors (April 16, 2011) from the URL:
<http://sanacl.wordpress.com/2011/04/16/study-of-the-android-development-activity-and-its-authors/>.

7. Attached hereto as Exhibit F is a true and correct copy of the web page titled "projects/platform/external/Bluetooth/blueti.git/commit" as it appeared on June 8, 2012 from the URL:<http://omapzoom.org/?p=platform/external/bluetooth/blueti.git;a=commit;h=bc10bbdfa77e43f29c2368eb8ac6fe3e73bd7f81>, indicating that James W. Mills is associated with the email address jameswmills@ti.com.

8. Attached here to as Exhibit G is a true and correct copy of the webpage titled "projects/platform/external/chromium.git/commit" as it appeared on June 8, 2012 from the URL <http://omapzoom.org/?p=platform/external/chromium.git;a=commit;h=39ad9f5657323d3852f6741c79b830019baba4a8> indicating that Selim Gurun is associated with the email address sgurun@google.com.

9. Attached hereto as Exhibit H is a true and correct copy of the web page titled "projects / platform/external/chromium.git / commit" as it appeared on June 8, 2012 from the URL:<http://omapzoom.org/?p=platform/external/chromium.git;a=commit;h=1ab02c36bee95e85558f6815b2836e9ee6a26b19> indicating that Kristian Monsen is associated with the email address kristianm@google.com.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Executed this 8th day of June, 2012, in San Francisco, California.

/s/ Rebekah L. Punak

Rebekah L. Punak

EXHIBIT A

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

APPLE INC., a California Corporation,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD., a
Korean corporation; SAMSUNG
ELECTRONICS AMERICA, INC., a New
York corporation; and SAMSUNG
TELECOMMUNICATIONS AMERICA,
LLC, a Delaware limited liability company,

Defendants.

CASE NO. 12-cv-00630-LHK (PSG)

**APPLE INC.'S MOTION TO COMPEL
DISCOVERY OF DOCUMENTS,
INFORMATION, OR OBJECTS FROM
NON-PARTY GOOGLE, INC.**

Hearing:

Date: May 1, 2012
Time: 10 a.m.
Place: Courtroom 5, 4th Floor
Judge: Hon. Paul S. Grewal

NOTICE OF MOTION AND MOTION

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that on May 1, 2012 at 10 a.m., or as soon as the matter may be heard by the Honorable Paul S. Grewal, in in Courtroom 5, United States District Court for the Northern District of California, Robert F. Peckham Federal Building, 280 South 1st Street, San Jose, CA 95113, Apple, Inc. (“Apple”) shall and hereby does move the Court for an order compelling Google, Inc. (“Google”) to (1) produce certain documents in response to Apple’s Subpoena to Produce Documents, Information or Objects, (2) produce a witness to testify on certain topics in response to Apple’s Subpoena to Testify at a Deposition in a Civil Action and (3) apply the same provisions from the protective order in place in this litigation regarding a prosecution bar to Google and the documents it produces.

Apple has filed concurrently a Stipulation to Shorten Time for Briefing and Hearing on Apple’s Motion to Compel Discovery of Documents, Information, or Objects. As detailed in that stipulation, Apple and Google request that the Court consider this motion on an expedited basis. This would allow for the production of any documents the Court may order produced in time for Apple to consider them in drafting its reply brief for Apple’s pending Motion for a Preliminary Injunction, which is due on May 14, 2012 pursuant to the Court’s February 22, 2012 scheduling order. Apple and Google further requested that the hearing on this motion be set for May 1, 2012. This would allow for it to be heard concurrently with motions to compel that Apple has filed against Samsung regarding requests for much of the same discovery.

I. RELIEF REQUESTED

In order to obtain necessary discovery with regard to Apple’s preliminary injunction motion, and pursuant to Federal Rule of Civil Procedure 45, Apple seeks an order compelling Google to produce by no later than May 5, 2012, the following categories of documents that are responsive to Apple’s discovery requests, as set forth in the Subpoena to Produce Documents, Information or Objects (“Subpoena”) served on Google by Apple on April 5, 2012 and the Document Requests set forth in Document Request Nos. 3, 6-12, which can be generally categorized as follows:

- Documents generally relating to or otherwise constituting communications between Google and Samsung regarding the patented features;

- 1 • Documents relating to any analysis, inspection, design around, and copying of Apple's
- 2 products; and
- 3 • Documents relating to consumer purchasing decisions and consumer views of the patented
- 4 features.

5 In addition, Apple seeks an order compelling Google to produce by no later than May 11, 2012, a
6 witness to testify as to Topic Nos. 1-3, 5, and 7-12, which topics correlate to the document requests at
7 issue, as well as with the documents produced in response to those requests.

8 Apple also seeks an order applying the provisions from the protective order in place in this
9 litigation regarding a prosecution bar to Google and the information it provides in response to
10 Apple's subpoenas.

11 **II. STATEMENT OF ISSUES TO BE DECIDED**

12 Whether, in conjunction with the discovery permitted for Apple's Motion for a Preliminary
13 Injunction, for which Apple's reply brief is due on May 14 and with a hearing set for early June,
14 Google must make a complete production by May 5, 2012, of all readily accessible materials in
15 Google's possession, custody, and control responsive to the identified document requests at issue in
16 the present motion pursuant to the subpoena for documents served upon it on April 5, 2012.

17 Whether, in conjunction with the discovery permitted for Apple's Motion for a Preliminary
18 Injunction, for which Apple's reply brief is due on May 14 and with a hearing set for early June,
19 Google must provide a witness for testimony by May 11, 2012, regarding each of the identified topics
20 at issue in the present motion pursuant to the subpoena for documents served upon it on April 5,
21 2012.

22 Whether the provisions from the protective order in place in this litigation regarding a
23 prosecution bar should apply to Google and the documents it produces.

24 **III. APPLE'S CIVIL LOCAL RULE 37-2 STATEMENT**

25 Pursuant to Civil L.R. 37-2, Apple's subpoenas and accompanying discovery requests to
26 Google relating to Apple's Motion for Preliminary Injunction that are the subject of this motion are
27 set forth in full below, with Google's corresponding objections and/or answers following
28 immediately after each:

APPLE'S DOCUMENT REQUEST NO. 3:

1 Documents sufficient to show any and all differences between the Android mobile platform
2 source code in response to Request No. 1 and the Android 4.0 Ice Cream Sandwich code publicly
3 available from <https://android.google.com/platform/manifest>, or through the process described
4 at <http://source.android.com/source/downloading.html>.

5 GOOGLE'S RESPONSE TO DOCUMENT REQUEST NO. 3:

6 Google incorporates by reference its General Objections as though fully set forth herein.
7 Google further objects to this Request on the grounds that the term "any and all differences" is vague
8 and ambiguous. Google further objects to this Request on the grounds that the term "Android 4.0 Ice
9 Cream Sandwich code publicly available from <https://android.google.com/platform/manifest>,
10 or through the process described at <http://source.android.com/source/downloading.html>" is vague and
11 ambiguous. Google further objects to this Request on the grounds that it seeks information that is
12 neither relevant to any claims or defenses in this litigation nor reasonably calculated to lead to the
13 discovery of admissible evidence. Google further objects to this Request on the grounds that it is
14 overly broad, unduly burdensome, oppressive, and duplicative. Google further objects to this
15 Request on the grounds that it seeks information not within Google's possession, custody or control.
16 Google further objects to this Request on the grounds that it seeks information already in Apple's
17 possession or available to Apple from some other source that is more convenient, less burdensome or
18 less expensive, including information available to Apple from Samsung or from public sources.

19 APPLE'S DOCUMENT REQUEST NO. 6:

20 All documents that comprise, refer, or relate to communications between you and Samsung
21 relating to Slide to Unlock, Text Correction, Unified Search, and/or Special Text Detection software,
22 features, or functionality, including but not limited to any version of any such software, features, or
23 functionality used in the Samsung Galaxy Nexus or in any version of Android.

24 GOOGLE'S RESPONSE TO DOCUMENT REQUEST NO. 6:

25 Google incorporates by reference its General Objections as though fully set forth herein.
26 Google further objects to this Request on the grounds that the term "Slide to Unlock, Text Correction,
27 Unified Search, and/or Special Text Detection software, features, or functionality" is vague and
28 ambiguous. Google further objects to this Topic on the grounds that the term "used in the Samsung

1 Galaxy Nexus” is vague and ambiguous. Google further objects to this Request on the grounds that it
2 seeks information that is neither relevant to any claims or defenses in this litigation nor reasonably
3 calculated to lead to the discovery of admissible evidence. Google further objects to this Request on
4 the grounds that it is overly broad, unduly burdensome, oppressive, and duplicative. Google further
5 objects to this Request on the grounds that it seeks information not within Google’s possession,
6 custody or control. Google further objects to this Request on the grounds that it seeks information
7 protected from disclosure by the attorney-client privilege, the attorney work product doctrine, or any
8 other applicable privilege or immunity, including but not limited to the common interest or joint
9 defense privileges. Google further objects to this Request on the grounds that it calls for legal
10 conclusions. Google further objects to this Request on the grounds that it seeks information already
11 in Apple’s possession or available to Apple from some other source that is more convenient, less
12 burdensome or less expensive, including information available to Apple from Samsung or from
13 public sources.

14 Subject to and without waiving its general and specific objections, Google will produce
15 documents responsive to this Request as part of normal discovery under Federal Rule of Civil
16 Procedure 26.

17 APPLE’S DOCUMENT REQUEST NO. 8:

18 Documents sufficient to show the design of, development of, implementation of and/or
19 decision to implement in any version of Android the Slide to Unlock, Text Correction, Unified
20 Search, and/or Special Text Detection software, features, or functionality.

21 GOOGLE’S RESPONSE TO DOCUMENT REQUEST NO. 8:

22 Google incorporates by reference its General Objections as though fully set forth herein.
23 Google further objects to this Request on the grounds that the term “Slide to Unlock, Text Correction,
24 Unified Search, and/or Special Text Detection software, features, or functionality” is vague and
25 ambiguous. Google further objects to this Request on the grounds that it seeks information that is
26 neither relevant to any claims or defenses in this litigation nor reasonably calculated to lead to the
27 discovery of admissible evidence. Google further objects to this Request on the grounds that it is
28 overly broad, unduly burdensome, oppressive, and duplicative. Google further objects to this

1 Request on the grounds that it seeks information not within Google’s possession, custody or control.
2 Google further objects to this Request on the grounds that it seeks information protected from
3 disclosure by the attorney-client privilege, the attorney work product doctrine, or any other applicable
4 privilege or immunity, including but not limited to the common interest or joint defense privileges.
5 Google further objects to this Request on the grounds that it calls for legal conclusions. Google
6 further objects to this Request on the grounds that it seeks information already in Apple’s possession
7 or available to Apple from some other source that is more convenient, less burdensome or less
8 expensive, including information available to Apple from Samsung or from public sources.

9 Subject to and without waiving its general and specific objections, Google will produce
10 documents responsive to this Request as part of normal discovery under Federal Rule of Civil
11 Procedure 26.

12 APPLE’S DOCUMENT REQUEST NO. 9:

13 Documents relating to any efforts or attempts, including the analysis and decision-making to
14 engage in such efforts or attempts, to design around or otherwise imitate without directly copying
15 Apple’s products that incorporate any version of iOS operating system as well as the Slide to Unlock,
16 Text Correction, Unified Search, and/or Special Text Detection software, features, or functionality.

17 GOOGLE’S RESPONSE TO DOCUMENT REQUEST NO. 9:

18 Google incorporates by reference its General Objections as though fully set forth herein.
19 Google further objects to this Request on the grounds that the term “any efforts or attempts, including
20 the analysis and decision-making to engage in such efforts or attempts” is vague and ambiguous.
21 Google further objects to this Request on the grounds that the term “design around or otherwise
22 imitate without directly copying” is vague and ambiguous. Google further objects to this Request on
23 the grounds that the term “Slide to Unlock, Text Correction, Unified Search, and/or Special Text
24 Detection software, features, or functionality” is vague and ambiguous. Google further objects to this
25 Request on the grounds that it seeks information that is neither relevant to any claims or defenses in
26 this litigation nor reasonably calculated to lead to the discovery of admissible evidence. Google
27 further objects to this Request on the grounds that it is overly broad, unduly burdensome, oppressive,
28 and duplicative. Google further objects to this Request on the grounds that it seeks information not

1 within Google's possession, custody or control. Google further objects to this Request on the
2 grounds that it seeks information protected from disclosure by the attorney-client privilege, the
3 attorney work product doctrine, or any other applicable privilege or immunity, including but not
4 limited to the common interest or joint defense privileges. Google further objects to this Request on
5 the grounds that it calls for legal conclusions. Google further objects to this Request on the grounds
6 that it seeks information already in Apple's possession or available to Apple from some other source
7 that is more convenient, less burdensome or less expensive, including information available to Apple
8 from Samsung or from public sources.

9 APPLE'S DOCUMENT REQUEST NO. 10:

10 Documents relating to any analysis, review, consideration, evaluation, inspection, teardown
11 report, or copying of any Apple product, including but not limited to Apple's products that
12 incorporate any version of the iOS operating system as well as the Slide to Unlock, Text Correction,
13 Unified Search, and Special Text Detection software, features or functionality.

14 GOOGLE'S RESPONSE TO DOCUMENT REQUEST NO. 10:

15 Google incorporates by reference its General Objections as though fully set forth herein.
16 Google further objects to this Request on the grounds that the term "any analysis, review,
17 consideration, evaluation, inspection, tear-down report, or copying" is vague and ambiguous. Google
18 further objects to this Request on the grounds that the term "Slide to Unlock, Text Correction Unified
19 Search, and Special Text Detection software, features, or functionality" is vague and ambiguous.
20 Google further objects to this Request on the grounds that it seeks information that is neither relevant
21 to any claims or defenses in this litigation nor reasonably calculated to lead to the discovery of
22 admissible evidence. Google further objects to this Request on the grounds that it is overly broad,
23 unduly burdensome, oppressive, and duplicative. Google further objects to this Request on the
24 grounds that it seeks information not within Google's possession, custody or control. Google further
25 objects to this Request on the grounds that it seeks information protected from disclosure by the
26 attorney-client privilege, the attorney work product doctrine, or any other applicable privilege or
27 immunity, including but not limited to the common interest or joint defense privileges. Google
28 further objects to this Request on the grounds that it calls for legal conclusions. Google further

1 objects to this Request on the grounds that it seeks information already in Apple’s possession or
2 available to Apple from some other source that is more convenient, less burdensome or less
3 expensive, including information available to Apple from Samsung or from public sources.

4 APPLE’S DOCUMENT REQUEST NO. 11:

5 All documents constituting, reflecting or otherwise relating to any analysis, review, research,
6 survey, consideration, or evaluation of the importance to consumers and consumer purchasing
7 decisions of Slide to Unlock, Text Correction, Unified Search, and/or Special Text Detection on a
8 phone or other mobile device.

9 GOOGLE’S RESPONSE TO DOCUMENT REQUEST NO. 11:

10 Google incorporates by reference its General Objections as though fully set forth herein.
11 Google further objects to this Request on the grounds that the term “constituting, reflecting or
12 otherwise relating to any analysis, review, research, survey, consideration, or evaluation” is vague
13 and ambiguous. Google further objects to this Request on the grounds that the term “the importance
14 to consumers and consumer purchasing decisions” is vague and ambiguous. Google further objects
15 to this Request on the grounds that the term “Slide to Unlock, Text Correction Unified Search, and/or
16 Special Text Detection” is vague and ambiguous. Google further objects to the Request on the
17 grounds that the term “on a phone or other mobile device” is vague and ambiguous. Google further
18 objects to this Request on the grounds that it seeks information that is neither relevant to any claims
19 or defenses in this investigation nor reasonably calculated to lead to the discovery of admissible
20 evidence. Google further objects to this Request on the grounds that it is overly broad, unduly
21 burdensome, oppressive, and duplicative. Google further objects to this Request on the grounds that
22 it seeks information not within Google’s possession, custody or control. Google further objects to
23 this Request on the grounds that it seeks information protected from disclosure by the attorney-client
24 privilege, the attorney work product doctrine, or any other applicable privilege or immunity,
25 including but not limited to the common interest or joint defense privileges. Google further objects to
26 this Request on the grounds that it calls for legal conclusions. Google further objects to this Request
27 on the grounds that it seeks information already in Apple’s possession or available to Apple from
28 some other source that is more convenient, less burdensome or less expensive, including information

1 available to Apple from Samsung or from public sources.

2 Subject to and without waiving its general and specific objections, Google is available to meet
3 and confer with Apple regarding an appropriate scope of production in response to this Request.

4 APPLE'S DOCUMENT REQUEST NO. 12:

5 All documents constituting, reflecting, or otherwise relating to any analysis, review, research,
6 survey, consideration or evaluation of the importance to consumers and consumer purchasing
7 decisions of the ability or capability to search the Internet on a phone or other mobile device.

8 GOOGLE'S RESPONSE TO DOCUMENT REQUEST NO. 12:

9 Google incorporates by reference its General Objections as though fully set forth herein.
10 Google further objects to this Request on the grounds that the term "constituting, reflecting, or
11 otherwise relating to any analysis, review, research, survey, consideration or evaluation" is vague and
12 ambiguous. Google further objects to this Request on the grounds that the term "the importance to
13 consumers and consumer purchasing decisions" is vague and ambiguous. Google further objects to
14 this Request on the grounds that the term "the ability or capability to search the Internet on a phone or
15 other mobile device" is vague and ambiguous. Google further objects to this Request on the grounds
16 that it seeks information that is neither relevant to any claims or defenses in this investigation nor
17 reasonably calculated to lead to the discovery of admissible evidence. Google further objects to this
18 Request on the grounds that it is overly broad, unduly burdensome, oppressive, and duplicative.
19 Google further objects to this Request on the grounds that it seeks information not within Google's
20 possession, custody or control. Google further objects to this Request on the grounds that it seeks
21 information protected from disclosure by the attorney-client privilege, the attorney work product
22 doctrine, or any other applicable privilege or immunity, including but not limited to the common
23 interest or joint defense privileges. Google further objects to this Request on the grounds that it calls
24 for legal conclusions. Google further objects to this Request on the grounds that it seeks information
25 already in Apple's possession or available to Apple from some other source that is more convenient,
26 less burdensome or less expensive, including information available to Apple from Samsung or from
27 public sources.

1 APPLE'S DEPOSITION TOPIC 1:

2 All documents and source code produced pursuant to Apple's Subpoena to Produce
3 Documents, Information or Objects served upon you on April 5, 2012, including without limitation
4 the authenticity thereof.

5 GOOGLE'S RESPONSE TO DEPOSITION TOPIC 1:

6 Google incorporates by reference its General Objections as though fully set forth herein.
7 Google further objects to this Topic on the grounds that it seeks information that is neither relevant to
8 any claims or defenses in this litigation nor reasonably calculated to lead to the discovery of
9 admissible evidence. Google further objects to this Topic on the grounds that it is overly broad,
10 unduly burdensome, oppressive, and duplicative. Google further objects to this Topic on the grounds
11 that it seeks information protected from disclosure by the attorney-client privilege, the attorney work
12 product doctrine, or any other applicable privilege or immunity, including but not limited to the
13 common interest or joint defense privileges. Google further objects to this Topic on the grounds that
14 it seeks information already in Apple's possession or available to Apple from some other source that
15 is more convenient, less burdensome or less expensive, including information available to Apple
16 from Samsung or from public sources.

17 APPLE'S DEPOSITION TOPIC 2:

18 The Android mobile platform (including any source code) used in the Samsung Galaxy
19 Nexus.

20 GOOGLE'S RESPONSE TO DEPOSITION TOPIC 2:

21 Google incorporates by reference its General Objections as though fully set forth herein.
22 Google further objects to this Topic on the grounds that the term "Android mobile platform" is vague
23 and ambiguous. Google further objects to this Topic on the grounds that the term "used in the
24 Samsung Galaxy Nexus" is vague and ambiguous. Google further objects to this Topic on the
25 grounds that it seeks information that is neither relevant to any claims or defenses in this litigation
26 nor reasonably calculated to lead to the discovery of admissible evidence. Google further objects to
27 this Topic on the grounds that it seeks information already in Apple's possession or available to
28 Apple from some other source that is more convenient, less burdensome or less expensive, including

1 information available to Apple from Samsung or from public sources.

2 APPLE'S DEPOSITION TOPIC 3:

3 The differences, if any, between the Android mobile platform source code produced in
4 response to Request No. 1 of Apple's April 5, 2012 Subpoena for Documents, Information, and
5 Objects to you and the Android 4.0 Ice Cream Sandwich code publicly available from
6 <https://android.google.com/platform/manifest>, or through the process described at
7 <http://source.android.com/source/downloading.html>.

8 GOOGLE'S RESPONSE TO DEPOSITION TOPIC 3:

9 Google incorporates by reference its General Objections as though fully set forth herein.
10 Google further objects to this Topic on the grounds that the term "differences, if any" is vague and
11 ambiguous. Google further objects to this Topic on the grounds that the term "Android 4.0 Ice
12 Cream Sandwich code publicly available from <https://android.google.com/platform/manifest>,
13 or through the process described at <http://source.android.com/source/downloading.html>" is vague and
14 ambiguous. Google further objects to this Topic on the grounds that it seeks information that is
15 neither relevant to any claims or defenses in this litigation nor reasonably calculated to lead to the
16 discovery of admissible evidence. Google further objects to this Topic on the grounds that it is
17 overly broad, unduly burdensome, oppressive, and duplicative. Google further objects to this Topic
18 on the grounds that it seeks information not within Google's possession, custody or control. Google
19 further objects to this Topic on the grounds that it seeks information already in Apple's possession or
20 available to Apple from some other source that is more convenient, less burdensome or less
21 expensive, including information available to Apple from Samsung or from public sources.

22 APPLE'S DEPOSITION TOPIC 5:

23 Communications between you and Samsung relating to Slide to Unlock, Text Correction,
24 Unified Search, and/or Special Text Detection software, features, or functionality, including but not
25 limited to any version of any such software, features, or functionality used in the Samsung Galaxy
26 Nexus or in any version of Android.

27 GOOGLE'S RESPONSE TO DEPOSITION TOPIC 5:

28 Google incorporates by reference its General Objections as though fully set forth herein.

1 Google further objects to this Topic on the grounds that the term “Slide to Unlock, Text Correction,
2 Unified Search, and/or Special Text Detection software, features, or functionality” is vague and
3 ambiguous. Google further objects to this Topic on the grounds that the term “used in the Samsung
4 Galaxy Nexus” is vague and ambiguous. Google further objects to this Topic on the grounds that it
5 seeks information that is neither relevant to any claims or defenses in this litigation nor reasonably
6 calculated to lead to the discovery of admissible evidence. Google further objects to this Topic on
7 the grounds that it is overly broad, unduly burdensome, oppressive, and duplicative. Google further
8 objects to this Topic on the grounds that it seeks information not within Google’s possession, custody
9 or control. Google further objects to this Topic on the grounds that it seeks information protected
10 from disclosure by the attorney-client privilege, the attorney work product doctrine, or any other
11 applicable privilege or immunity, including but not limited to the common interest or joint defense
12 privileges. Google further objects to this Topic on the grounds that it calls for legal conclusions.
13 Google further objects to this Topic on the grounds that it seeks information already in Apple’s
14 possession or available to Apple from some other source that is more convenient, less burdensome or
15 less expensive, including information available to Apple from Samsung or from public sources.

16 APPLE’S DEPOSITION TOPIC 7:

17 The design, development, and implementation in Android 4.0 Ice Cream Sandwich of the
18 Slide to Unlock, Text Correction, Unified Search, and/or Special Text Detection software, features,
19 or functionality.

20 GOOGLE’S RESPONSE TO DEPOSITION TOPIC 7:

21 Google incorporates by reference its General Objections as though fully set forth herein.
22 Google further objects to this Topic on the grounds that the term “Android 4.0 Ice Cream Sandwich”
23 is vague and ambiguous. Google further objects to this Topic on the grounds that the term “Slide to
24 Unlock, Text Correction, Unified Search, and/or Special Text Detection software, features, or
25 functionality” is vague and ambiguous. Google further objects to this Topic on the grounds that it
26 seeks information that is neither relevant to any claims or defenses in this litigation nor reasonably
27 calculated to lead to the discovery of admissible evidence. Google further objects to this Topic on
28 the grounds that it is overly broad, unduly burdensome, oppressive, and duplicative. Google further

1 objects to this Topic on the grounds that it seeks information not within Google’s possession, custody
2 or control. Google further objects to this Topic on the grounds that it seeks information protected
3 from disclosure by the attorney-client privilege, the attorney work product doctrine, or any other
4 applicable privilege or immunity, including but not limited to the common interest or joint defense
5 privileges. Google further objects to this Topic on the grounds that it calls for legal conclusions.
6 Google further objects to this Topic on the grounds that it seeks information already in Apple’s
7 possession or available to Apple from some other source that is more convenient, less burdensome or
8 less expensive, including information available to Apple from Samsung or from public sources.

9 APPLE’S DEPOSITION TOPIC 8:

10 The design of, development of, implementation of, and/or decision to implement in any
11 version of Android the Slide to Unlock, Text Correction, Unified Search, and/or Special Text
12 Detection software, features, or functionality.

13 GOOGLE’S RESPONSE TO DEPOSITION TOPIC 8:

14 Google incorporates by reference its General Objections as though fully set forth herein.
15 Google further objects to this Topic on the grounds that the term “Slide to Unlock, Text Correction,
16 Unified Search, and/or Special Text Detection software, features, or functionality” is vague and
17 ambiguous. Google further objects to this Topic on the grounds that it seeks information that is
18 neither relevant to any claims or defenses in this litigation nor reasonably calculated to lead to the
19 discovery of admissible evidence. Google further objects to this Topic on the grounds that it is
20 overly broad, unduly burdensome, oppressive, and duplicative. Google further objects to this Topic
21 on the grounds that it seeks information not within Google’s possession, custody or control. Google
22 further objects to this Topic on the grounds that it seeks information protected from disclosure by the
23 attorney-client privilege, the attorney work product doctrine, or any other applicable privilege or
24 immunity, including but not limited to the common interest or joint defense privileges. Google
25 further objects to this Topic on the grounds that it calls for legal conclusions. Google further objects
26 to this Topic on the grounds that it seeks information already in Apple’s possession or available to
27 Apple from some other source that is more convenient, less burdensome or less expensive, including
28 information available to Apple from Samsung or from public sources.

1 APPLE'S DEPOSITION TOPIC 9:

2 Any efforts or attempts, including the analysis and decision-making to engage in such efforts
3 or attempts, to design around or otherwise imitate without directly copying Apple's products that
4 incorporate any version of iOS operating system as well as the Slide to Unlock, Text Correction,
5 Unified Search, and/or Special Text Detection software, features, or functionality.

6 GOOGLE'S RESPONSE TO DEPOSITION TOPIC 9:

7 Google incorporates by reference its General Objections as though fully set forth herein.
8 Google further objects to this Topic on the grounds that the term "any efforts or attempts, including
9 the analysis and decision-making to engage in such efforts or attempts" is vague and ambiguous.
10 Google further objects to this Topic on the grounds that the term "design around or otherwise imitate
11 without directly copying" is vague and ambiguous. Google further objects to this Topic on the
12 grounds that the term "Slide to Unlock, Text Correction, Unified Search, and/or Special Text
13 Detection software, features, or functionality" is vague and ambiguous. Google further objects to this
14 Topic on the grounds that it seeks information that is neither relevant to any claims or defenses in this
15 litigation nor reasonably calculated to lead to the discovery of admissible evidence. Google further
16 objects to this Topic on the grounds that it is overly broad, unduly burdensome, oppressive, and
17 duplicative. Google further objects to this Topic on the grounds that it seeks information not within
18 Google's possession, custody or control. Google further objects to this Topic on the grounds that it
19 seeks information protected from disclosure by the attorney-client privilege, the attorney work
20 product doctrine, or any other applicable privilege or immunity, including but not limited to the
21 common interest or joint defense privileges. Google further objects to this Topic on the grounds that
22 it calls for legal conclusions. Google further objects to this Topic on the grounds that it seeks
23 information already in Apple's possession or available to Apple from some other source that is more
24 convenient, less burdensome or less expensive, including information available to Apple from
25 Samsung or from public sources.

26 APPLE'S DEPOSITION TOPIC 10:

27 Any analysis, review, consideration, evaluation, inspection, tear-down report, or copying of
28 any Apple product, including but not limited to Apple's products that incorporate any version of the

1 iOS operating system as well as the Slide to Unlock, Text Correction, Unified Search, and Special
2 Text Detection software, features, or functionality.

3 GOOGLE’S RESPONSE TO DEPOSITION TOPIC 10:

4 Google incorporates by reference its General Objections as though fully set forth herein.
5 Google further objects to this Topic on the grounds that the term “analysis, review, consideration,
6 evaluation, inspection, tear-down report, or copying of any Apple product” is vague and ambiguous.
7 Google further objects to this Topic on the grounds that the term “Slide to Unlock, Text Correction,
8 Unified Search, and Special Text Detection software, features, or functionality” is vague and
9 ambiguous. Google further objects to this Topic on the grounds that it seeks information that is
10 neither relevant to any claims or defenses in this litigation nor reasonably calculated to lead to the
11 discovery of admissible evidence. Google further objects to this Topic on the grounds that it is
12 overly broad, unduly burdensome, oppressive, and duplicative. Google further objects to this Topic
13 on the grounds that it seeks information not within Google’s possession, custody or control. Google
14 further objects to this Topic on the grounds that it seeks information protected from disclosure by the
15 attorney-client privilege, the attorney work product doctrine, or any other applicable privilege or
16 immunity, including but not limited to the common interest or joint defense privileges. Google
17 further objects to this Topic on the grounds that it calls for legal conclusions. Google further objects
18 to this Topic on the grounds that it seeks information already in Apple’s possession or available to
19 Apple from some other source that is more convenient, less burdensome or less expensive, including
20 information available to Apple from Samsung or from public sources.

21 APPLE’S DEPOSITION TOPIC 11:

22 The importance to consumers and consumer purchasing decisions of Slide to Unlock, Text
23 Correction, Unified Search, and/or Special Text Detection on a phone or other mobile device.

24 GOOGLE’S RESPONSE TO DEPOSITION TOPIC 11:

25 Google incorporates by reference its General Objections as though fully set forth herein.
26 Google further objects to this Topic on the grounds that the term “the importance to consumers and
27 consumer purchasing decisions” is vague and ambiguous. Google further objects to this Topic on the
28 grounds that the term “Slide to Unlock, Text Correction, Unified Search, and/or Special Text

1 Detection” is vague and ambiguous. Google further objects to this Topic on the grounds that the term
2 “on a phone or other mobile device” is vague and ambiguous. Google further objects to this Topic on
3 the grounds that it seeks information that is neither relevant to any claims or defenses in this
4 investigation nor reasonably calculated to lead to the discovery of admissible evidence. Google
5 further objects to this Topic on the grounds that it is overly broad, unduly burdensome, oppressive,
6 and duplicative. Google further objects to this Topic on the grounds that it seeks information not
7 within Google’s possession, custody or control. Google further objects to this Topic on the grounds
8 that it seeks information protected from disclosure by the attorney-client privilege, the attorney work
9 product doctrine, or any other applicable privilege or immunity, including but not limited to the
10 common interest or joint defense privileges. Google further objects to this Topic on the grounds that
11 it calls for legal conclusions. Google further objects to this Topic on the grounds that it seeks
12 information already in Apple’s possession or available to Apple from some other source that is more
13 convenient, less burdensome or less expensive, including information available to Apple from
14 Samsung or from public sources.

15 APPLE’S DEPOSITION TOPIC 12:

16 The importance to consumers and consumer purchasing decisions of the ability or capability
17 to search the Internet on a phone or mobile device.

18 GOOGLE’S RESPONSE TO DEPOSITION TOPIC 12:

19 Google incorporates by reference its General Objections as though fully set forth herein.
20 Google further objects to this Topic on the grounds that the term “the importance to consumers and
21 consumer purchasing decisions” is vague and ambiguous. Google further objects to this Topic on the
22 grounds that the term “the ability or capability to search the Internet on a phone or mobile device” is
23 vague and ambiguous. Google further objects to this Topic on the grounds that it seeks information
24 that is neither relevant to any claims or defenses in this investigation nor reasonably calculated to
25 lead to the discovery of admissible evidence. Google further objects to this Topic on the grounds that
26 it is overly broad, unduly burdensome, oppressive, and duplicative. Google further objects to this
27 Topic on the grounds that it seeks information not within Google’s possession, custody or control.
28 Google further objects to this Topic on the grounds that it seeks information protected from

1 disclosure by the attorney-client privilege, the attorney work product doctrine, or any other applicable
2 privilege or immunity, including but not limited to the common interest or joint defense privileges.
3 Google further objects to this Topic on the grounds that it calls for legal conclusions. Google further
4 objects to this Topic on the grounds that it seeks information already in Apple’s possession or
5 available to Apple from some other source that is more convenient, less burdensome or less
6 expensive, including information available to Apple from Samsung or from public sources.

7 **IV. APPLE’S CERTIFICATION PURSUANT TO FED. R. CIV. P. 37(A)(1)**

8 Apple hereby certifies that it has in good faith conferred with Google and Samsung in an
9 effort to obtain the discovery described immediately above without Court action. Apple’s efforts to
10 resolve this discovery dispute without court intervention are described in the Declaration of Jason C.
11 Lo in Support of Apple Inc.’s Motion to Compel Discovery of Documents, Information, or Objects
12 from Non-Party Google, Inc. (the “Lo Decl.”) and exhibits attached thereto, submitted concurrently
13 herewith.

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MEMORANDUM OF POINTS AND AUTHORITIES**I. INTRODUCTION**

On February 8, 2012, Apple filed a complaint in this Court against Samsung Electronics Co., Ltd. and several Samsung U.S. subsidiaries (“Samsung”) alleging that several Samsung smartphones and tablet devices infringe eight of Apple’s patents. Concurrent with its complaint, Apple filed a motion for preliminary injunction, which explained in detail how one of the Samsung devices, the Samsung Galaxy Nexus smartphone, infringes at least four of Apple’s patents, and why, absent immediate injunctive relief, the continued sale of the Galaxy Nexus will irreparably harm Apple. The case was assigned to Judge Koh, who ordered shortened, 21-day response times for discovery requests exchanged between Apple and Samsung and set a briefing schedule requiring that Samsung file its opposition by April 23, 2012 and Apple file its reply by May 14, 2012. Judge Koh further scheduled a hearing for Apple’s motion on June 7, 2012.

Although Apple focuses this motion to compel on third-party Google, characterizing Google as a third-party fails to capture the full extent of Samsung’s involvement, collaboration, and collusion with Google. Indeed, the accused Samsung Galaxy Nexus smartphone operates the Android 4.0 mobile platform, which is the latest mobile operating platform developed by Google, and which Google makes publicly available. As Apple explains in detail in its motion for preliminary injunction, Samsung’s infringement of Apple’s patents arises as a result of Samsung’s incorporation of the Android 4.0 platform, dubbed “Ice Cream Sandwich,” in the Galaxy Nexus – the first device to utilize Ice Cream Sandwich. (D.I. 10 at 7.) Given the obvious relevance of Ice Cream Sandwich to Apple’s motion, Apple immediately sought from Samsung information regarding Galaxy Nexus’ implementation of Ice Cream Sandwich. Rather than provide the information, Samsung stonewalled, claiming that only Google knew how the Galaxy Nexus implemented Ice Cream Sandwich, that it lacked power to obtain such information, and refused to provide the requested information. (Declaration of Jason Lo in Support of Apple Inc.’s Motion to Compel Discovery of Documents, Information, or Objects From Non-Party Google, Inc. (“Lo Decl.”), Ex. 2). Apple filed two motions to compel Samsung’s compliance with the discovery requests, which are currently pending before this court. (D.I. 94, D.I. 96).

1 After receiving Samsung's response, Apple promptly served Google with a subpoena seeking
2 the information that Samsung refused to produce. (Lo Decl., Ex. 3). Represented by the same law
3 firm that represents Samsung, Google responded that, although it would be submitting declarations
4 and other information in support of Samsung's opposition to Apple's Motion for Preliminary
5 Injunction, it too would not provide Apple with the requested information. And, in fact, Google did
6 submit four separate declarations supporting Samsung's opposition to Apple's Motion for
7 Preliminary Injunction. (Lo Decl., Ex. 5). Google's submission of these declarations – again, under
8 the supervision of the same counsel representing Samsung – highlights the extent to which these two
9 companies collaborate, not only technically, but in their efforts to stonewall Apple. Google should
10 not be permitted to arbitrarily, and without justification, evade compliance with a Rule 45 subpoena
11 served upon it, while simultaneously providing Samsung with an unidentified scope of discovery that
12 appears to include at least some of the very documents that Samsung confirms are held by Google
13 and yet that Google refuses to produce to Apple at this time.

14 Google also should not be permitted to impose additional restrictions on Apple's ability to
15 review and consider the Google-produced materials. In particular, Google should not be permitted to
16 insist on a more restrictive prosecution bar than the prosecution bar to which Apple and Samsung
17 already agreed, and which this Court already has approved, particularly when the same law firm that
18 represents Samsung represents Google in these proceedings. Google's selection of common counsel,
19 its active support of Samsung's opposition to Apple's preliminary injunction motion, and its assertion
20 of a "common interest or joint defense privilege" all belie Google – and Samsung's – claims that the
21 two companies are acting independently with respect to Apple. Accordingly, Apple requests that the
22 Court compel Google to fully and completely respond to the Subpoena by producing all responsive
23 documents by no later than May 5, 2012, and to produce a witness for testimony no later than May
24 11, 2012.

25 **II. PROCEDURAL HISTORY**

26 As noted above, on February 8, 2012, along with its Complaint, Apple filed a Motion for
27 Preliminary Injunction seeking to halt the sale of the Samsung Galaxy Nexus smartphone during the
28 course of this litigation. (D.I. 10). In its Motion for Preliminary Injunction, Apple asserts that the

1 Samsung Galaxy Nexus infringes four key Apple patents claiming various aspects of user interface
2 technology: U.S. Patent Nos. 5,946,647 (the “647 patent”); 8,086,604 (the “604 patent”); 8,046,721
3 (the “721 patent”); and 8,074,172 (the “172 patent”). (*See id.*) In general terms, these four patents
4 cover features that (1) enable a user to select a structure, such as a phone number or web address, and
5 execute one of multiple actions associated with that structure, including, for example, saving the
6 phone number to a contacts library or calling the number (“Special Text Detection”), (2) enable a
7 user simultaneously to search for information across multiple sources, such as files stored on the
8 phone as well as the Internet (“Unified Search”), (3) enable a user to unlock the Galaxy Nexus by
9 “sliding” an image across the screen (“Slide to Unlock”), and (4) enable the Galaxy Nexus to
10 automatically correct misspellings entered by the user (“Text Correction”).

11 Apple served on Samsung interrogatories and requests for production, which specifically
12 called for information relevant to these features of Samsung’s Galaxy Nexus. In its Responses to
13 those interrogatories and request for production, however, Samsung asserts that it does not possess
14 certain categories of development and other documents concerning the Galaxy Nexus and its accused
15 features. To support this unusual claim, Samsung points to Google, and particularly Google’s
16 development of Ice Cream Sandwich. For example, in response to an interrogatory seeking the
17 identification of analyses relating to each of the accused, patented features, Samsung hides behind
18 Google, responding: “The features identified in this interrogatory – Slide to Unlock, Text Correction,
19 Unified Search and Special Text Detection – were developed by Google, not Samsung. Samsung is
20 presently unaware of any consumer studies, analyses, or reports regarding these features.” (Lo Decl.,
21 Ex. 6).

22 Through the meet and confer process, Samsung made it clear that it would maintain its claims
23 of ignorance and lack of involvement of the implementation of Ice Cream Sandwich in the Galaxy
24 Nexus, as well as its lack of control over Google. Apple’s meet and confer efforts with Samsung
25 have culminated in two motions to compel, one with respect to interrogatories and another with
26 respect to requests for production, which motions are fully briefed and will be argued on May 1,
27 2012. (*See* D.I. 94, 96.)

28 After receiving Samsung’s responses to its discovery requests, and simultaneously with its

1 meet and confer discussions with Samsung, pursuant to Federal Rule of Civil Procedure 45, Apple
 2 served Google with a subpoena that sought many of the same documents Samsung refused to
 3 produce, as well as a deposition concerning the requested documents. For instance, Apple sought:

- 4 • A copy of the source code provided to and used by Samsung in the Galaxy Nexus as
 5 well as documents sufficient to show differences between the publicly available
 6 version of Ice Cream Sandwich and the code implemented on the Galaxy Nexus. *See*
 Document Requests Nos. 1-3.¹
- 7 • Documents relating to communications between Google and Samsung regarding the
 8 (i) Android platform, (ii) the accused, patented features found in the Galaxy Nexus,
 and (iii) Apple and Apple's products. *See* Document Requests Nos. 4-6.²
- 9 • Documents relating to the design and implementation of the accused, patented features
 10 in Ice Cream Sandwich. *See* Document Requests Nos. 7 and 8.
- 11 • Documents relating to any analysis of, attempts to imitate or design around the four
 12 accused, patented features as implemented by Apple in its products. *See* Document
 Requests Nos. 8 and 9.
- 13 • Documents relating to the importance to consumers of the four accused, patented
 14 features as well as the importance to consumers of the ability to search the Internet
 using a mobile device. *See* Document Requests Nos. 10 and 11.
- 15 • Apple also sought a Rule 30(b)(6) deposition covering similar topics.

16 On April 16, 2012, Google responded to Apple's subpoenas, lodged several pages of
 17 objections, including a "common interest or joint defense privilege," stating, essentially, that (1) it
 18 will meet and confer with Apple regarding the production responsive to certain of the requests, (2)
 19 the information sought is equally in Apple's possession, or (3) it "will produce documents responsive
 20 to [the Requests] as part of normal discovery under Federal Rule of Civil Procedure 26." (Lo Decl.,
 21 Ex. 4). Apple immediately and diligently pursued informal resolution with Google, including
 22 through multiple telephonic meet and confer discussions with Google's counsel – Quinn Emanuel
 23 Urquhart and Sullivan LLP, which is also Samsung's counsel of record in the present action. During
 24 these meet and confer discussions, and despite the fact that Google submitted declarations in support
 25

26 ¹ Because Google has asserted that Request Nos. 1 and 2 are coterminous, and that it will produce
 27 materials responsive to those requests, Apple is not seeking relief with respect to either request.

28 ² Apple seeks relief only with respect to Request No. 6, and not with respect to Request Nos. 4 and
 5.

1 of Samsung's Opposition to Apple's Motion for Preliminary Injunction, Google has maintained that,
2 other than source code, it will not produce any of the requested information, or a witness for
3 deposition (other than the declarants supporting Samsung's opposition), prior to the June 7, 2012
4 hearing on Apple's Motion for Preliminary Injunction. At bottom, Google seeks to excuse its non-
5 compliance with Apple's subpoena because it has voluntarily provided certain information and
6 documents in support of Samsung's opposition brief.

7 Although Google has professed a willingness to produce certain source code in response to
8 Apple's requests, it refuses to permit Apple to inspect those materials unless Apple agrees to do so
9 under a more onerous protective order than the one already in place in this litigation. As the Court is
10 aware, Apple and Samsung are parties to an earlier-filed litigation, *Apple v. Samsung*, Case No. 11-
11 cv-1846-LHK (PSG) ("the 1846 case"). In the 1846 case, the parties agreed to a stipulated protective
12 order, which this Court then approved and entered. Subsequently, the parties agreed to adopt the
13 protective order from the 1846 case for interim use in this case. The parties also agreed that
14 documents produced in two separate ITC investigations, Investigations No. 337-TA-794 (the "794
15 investigation") and Investigation No. 337-TA-796 (the "796 investigation") shall be deemed
16 produced in the current case. In other words, the protective order in effect in this case has been
17 deemed to be sufficient to protect materials produced in four different cases – this case, the 1846
18 case, as well as the 794 Investigation and the 796 Investigation. Notwithstanding the foregoing, and
19 notwithstanding the fact that lawyers at the same law firm that now represents Google negotiated the
20 protective order in the 1846 case, Google is effectively holding hostage the few materials it proposes
21 to produce unless Apple agrees to more restrictive terms.

22 Google's willingness to aid Samsung in this litigation, while simultaneously claiming its non-
23 party status shields it from discovery, has resulted in an impasse between Google and Apple. In light
24 of the fast-approaching deadline for Apple's preliminary injunction reply brief, Apple respectfully
25 requests that the Court order Google to comply fully with Apple's subpoena and produce all
26 documents responsive to the subpoena no later than May 5, 2012, as well as a witness by May 11,
27 2012.

1 III. LEGAL STANDARD

2 Federal Rule of Civil Procedure 45 “authorizes issuance of a subpoena to command a
3 nonparty to produce designated documents, electronically stored information, or tangible things in its
4 possession, custody or control.” *Viacom Int’l, Inc. v. YouTube, Inc.*, 2009 U.S. Dist. LEXIS 4220, at
5 *7 (N.D. Cal. Jan. 14, 2009) (citing Fed. R. Civ. P. 45(a)(1)(A)(iii)). “[T]he scope of discovery
6 through subpoena is the same as that applicable to Rule 34 and the other discovery rules.” *Id.*
7 (quoting Advisory Committee Notes (1970)). Thus, through a subpoena, “[p]arties may obtain
8 discovery regarding *any nonprivileged matter that is relevant to any party’s claim or defense.*” Fed.
9 R. Civ. P. 26(b)(1) (emphasis added).

10 “Where relevance is in doubt . . . the court should be permissive.” *Truswal Sys. Corp. v.*
11 *Hydro-Air Eng’g, Inc.*, 813 F.2d 1207, 1212 (Fed. Cir. 1987). Furthermore, where “[a] person
12 withhold[s] subpoenaed information under a claim that it is privileged,” that person must “describe
13 the nature of the withheld documents, communications, or tangible things in a manner that, without
14 revealing information itself privileged or protected, will enable the parties to assess the claim.” Fed.
15 R. Civ. P. 45(d)(2)(A)(ii). Indeed, when a party asserts a privilege or immunity from discovery, that
16 party bears the burden of disclosing the specific nature of the materials withheld from discovery, and
17 further providing the basis for invoking the privilege. *See Union Pac. R.R. v. Mower*, 219 F.3d 1069,
18 1077 (9th Cir. Or. 2000) (“When a party withholds information . . . by claiming that it is privileged . . .
19 ., the party shall make the claim expressly and shall describe the nature of the documents,
20 communications, or things . . . in a manner that, without revealing information itself privileged or
21 protected, will enable other parties to assess the applicability of the privilege or protection.” (quoting
22 Fed. R. Civ. P. 26(b)(5); *Perry v. Schwarzenegger*, 591 F.3d 1126, 1133 (9th Cir. Cal. 2010) (holding
23 that some form of privilege log is required).) And, in the context of an assertion of a “common
24 interest” privilege, beyond making a threshold showing that privilege applies, a party must further
25 show that such a common interest truly exists. *See Elan Microelectronics Corp. v. Apple, Inc.*, 2011
26 U.S. Dist. LEXIS 87989, 16-17 (N.D. Cal. Aug. 8, 2011) (finding that the common interest privilege
27 did not apply where plaintiff offered nothing more than “mere post hoc rationalizations that it or its
28 customers anticipated being drawn into a joint suit,” where there was no joint defense or common

1 interest agreement, and where plaintiff failed to show there was a suit or even threat of suit against
2 any of the parties who received the documents at issue).

3 Through its active support of Samsung, Google has demonstrated the relevance of the
4 materials sought by Apple, while, on the other hand, Google has failed to make any showing that its
5 boilerplate objections or a common interest privilege apply.

6 Google also failed to meet its burden regarding its requested modifications to the protective
7 order. The Federal Circuit held that “[a] party seeking a protective order carries the burden of showing
8 good cause for its issuance. *See* Fed. R. Civ. P. 26(c); *Truswal Sys. Corp. v. Hydro-Air Eng’g, Inc.*, 813
9 F.2d 1207, 1209-10 (Fed.Cir.1987). The same is true for a party seeking to include in a protective order a
10 provision effecting a patent prosecution bar.” *In re Deutsche Bank Trust Co. Americas*, 605 F.3d 1373,
11 1378 (Fed. Cir. 2010). Google has not shown good cause for why the prosecution bar included in the
12 current protective order is not sufficient.

13 **IV. ARGUMENT**

14 **A. Google Is Not Entitled to Arbitrarily Refuse to Produce Responsive Documents until a** 15 **Later Time**

16 With respect to several of Apple’s requests, *i.e.*, Requests 6-8, after interposing several
17 boilerplate objections regarding clarity, relevance, privilege, and legal conclusions, Google responds
18 that it “will produce documents responsive to this Request as part of normal discovery under Federal
19 Rule of Civil Procedure 26.” Given that the scope of discovery under Federal Rule of Civil
20 Procedure 45 equates to the scope of discovery under Rule 26, it is unclear what Google means by the
21 phrase “normal discovery.” Through the meet and confer process, however, it appears that Google’s
22 response refers to timing, and that Google will respond to the request after the Court decides Apple’s
23 preliminary injunction motion. (Lo Decl., Ex. 4.) Google cites to no rule or authority that permits it
24 to unilaterally dictate the timing of its responses to Apple’s Rule 45 discovery requests.

25 Indeed, Rule 45 requires only that third parties be permitted a “reasonable time to comply.”
26 Fed. R. Civ. P. 45(c)(3)(A)(i). The Rule makes no distinction regarding the procedural state of the
27 case or the substantive matter to which the subpoena is directed; rather, the Rule requires objections
28 to be filed within 14 days unless an earlier time is specified in the subpoena. Fed. R. Civ. P.

1 45(c)(2)(B). Although Rule 45 does not define what constitutes a “reasonable time,” it must be
2 “judged depending on the underlying circumstances,” *Romano v. City of Hammond Police Dep’t*,
3 2010 U.S. Dist. LEXIS 79166, at *19 (N.D. Ind. Aug. 5, 2010), and “many courts” have relied on
4 Rule 45’s provision of a 14-day period for objections to find that “fourteen days from the date of
5 service [i]s presumptively reasonable.” *Cris v. Fareri*, 2011 U.S. Dist. LEXIS 108362, at *6 (D.
6 Conn. Sept. 22, 2011); *Romano*, 2010 U.S. Dist. LEXIS 79166, at *19. Here, Google was given over
7 *three* weeks to submit to a deposition, which would be presumptively reasonable even absent the
8 expedited proceeding in this case. Similarly, Google was initially given eleven days to produce the
9 requested documents, which is reasonable given the expedited nature of this proceeding and the fact
10 that Google, which is represented by the same counsel as Samsung and has voluntarily agreed to
11 assist Samsung, would have been on notice that these materials were requested from Samsung and, if
12 Samsung’s allegation that it does not possess the documents is true, that it would ultimately be called
13 upon to provide them. Regardless, and most importantly, Google has identified no reason during the
14 meet and confer process that it could not produce the requested documents even on a rolling basis.
15 Google cannot refuse to produce documents until it determines that “normal Rule 26 discovery” has
16 begun.

17 Google’s timing objections also ring hollow in light of the declarations that it has submitted in
18 support of Samsung’s Opposition to Apple’s Motion for Preliminary Injunction. These declarations
19 provide detailed explanations of the development of the accused features – issues central to the
20 document requests served upon Google. It is thus clear that Google – represented by the same
21 counsel as Samsung – has already engaged in, and collected at least some information responsive to
22 Apple’s subpoena. Google cannot, on the one hand, provide self-serving information in support of
23 Samsung’s efforts to oppose Apple’s preliminary injunction, while on the other hand, assert that
24 providing Apple with similar information must wait until “normal Rule 26 discovery.” Respectfully,
25 the Court should not condone such game playing, particularly when executed through common
26 counsel.

1 **B. Google’s Unsupported, Boilerplate Objections Do Not Excuse Google’s Refusal To**
 2 **Provide Relevant Documents**

3 After lodging thirty-two “general” objections, Google “specifically” responds to Apple’s
 4 requests with numerous additional and unsupported boilerplate objections. Google’s so-called
 5 specific objections, for example, state:

- 6 • That each and every request “seeks information that is neither relevant to any claims
 7 or defenses in this litigation nor reasonably calculated to lead to the discovery of
 8 admissible evidence;”
- 9 • That the terms “Android mobile platform” and “Android 4.0 Ice Cream Sandwich,”
 10 among others, are “vague and ambiguous;”
- 11 • That, with the exception of Requests 1 and 2, the Requests are “overly broad, unduly
 12 burdensome, oppressive, and duplicative;”
- 13 • That, with the exception of Requests 1 and 2, the Requests seek “information not
 14 within Google’s possession, custody or control;”
- 15 • That the Requests seek “information already in Apple’s possession or available to
 16 Apple from some other source that is more convenient, less burdensome or less
 17 expensive, including available to Apple from Samsung or from public sources;”
- 18 • That the Requests call for “legal conclusions;” and
- 19 • That the Requests seek “information protected from disclosure by attorney-client
 20 privilege, the attorney work product doctrine, or any other applicable privilege or
 21 immunity, including but not limited to the common interest or joint defense
 22 privileges.”

23 As Apple explains below, each of these boilerplate objections lack merit and should be overruled.

24 **1. The Requests Seek Relevant Information**

25 To begin, the courts review relevance under Rule 45, like relevance under Rule 26, broadly.
 26 *See, e.g., Negotiated Data Solutions LLC v. Dell, Inc.*, 2009 U.S. Dist. LEXIS 25026 (N.D. Cal. Mar.
 27 17, 2009) (“The scope of discovery through a Fed. R. Civ. P. 45 subpoena is the same as that
 28 applicable to Fed. R. Civ. P. 34 and other discovery rules. . . . ‘Relevant information need not be
 admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of
 admissible evidence.’ FED.R.CIV.P. 26(b)(1).”); *Gonzales v. Google, Inc.*, 234 F.R.D. 674, 679-80
 (N.D. Cal. 2006) (“The Advisory Committee Notes to the 1970 Amendment to Rule 45 state that the
 ‘scope of discovery through a subpoena is the same as that applicable to Rule 34 and other discovery
 rules.’ . . . [The rules] permit[] the discovery of any non-privileged material ‘relevant to the claim or

1 defense of any party,’ where ‘relevant information need not be admissible at trial if the discovery
 2 appears reasonably calculated to lead to the discovery of admissible evidence.’ Rule 26(b)(1).”
 3 Google makes no attempt to justify its relevance objections, and any such attempt would fail because
 4 each of Apple’s requests focus on information relevant to the four preliminary injunction factors – (1)
 5 likelihood of success on the merits, (2) irreparable harm, (3) balance of the hardships, and (4) public
 6 interests.

7 ***Likelihood of Success on the Merits.*** As explained above, several of Apple’s Requests (*e.g.*,
 8 Requests 1-3,³ and 7) seek information regarding the computer code supplied by Google to Samsung
 9 for incorporation into the Galaxy Nexus, information regarding any differences between the publicly
 10 available versions of Ice Cream Sandwich and the version of Ice Cream Sandwich implemented by
 11 the Galaxy Nexus, and information regarding the design and implementation of the four accused
 12 features – Slide to Unlock, Text Correction, Unified Search and Special Text Detection – in Ice
 13 Cream Sandwich. Given that Apple predicates its infringement allegations, at least in part, on the
 14 manner in which the Galaxy Nexus implements and executes Ice Cream Sandwich, there can be no
 15 dispute regarding the relevance of these requests to Apple’s preliminary injunction motion. Indeed,
 16 even Samsung has acknowledged that “all of the features of the Samsung Galaxy Nexus that Apple
 17 alleges are infringed are part of *Google’s* Android 4.0 Ice Cream Sandwich operating system.”
 18 (D.I.103 at 2.)

19 Other Apple Requests (*e.g.*, Request Nos. 9 and 10) seek information about copying of
 20 Apple’s products, and particularly, the four accused features. Evidence of copying is also relevant to
 21 success on the merits, as Google’s efforts to copy the patented features is strong evidence that the
 22 patents are not obvious, *i.e.*, invalid. *See, e.g., Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d
 23 675, 679 (Fed. Cir. 1988) (“Copying is an indicium of nonobviousness, and is to be given proper
 24 weight. Further, it is not necessary for the patentee to prove that the customer knew of and desired
 25 every attribute set out in the patent document.”) (internal citations omitted). Google’s inability to
 26 _____

27 ³ In response to Request No. 2, Google has stated that it “will produce up-to-date source code
 28 concerning the accused functionality compiled into binary images used on the Galaxy Nexus phones
 sold in the United States.”

1 design around the four patented features, moreover, relates to non-obviousness, and, hence, the
2 likelihood of success issue as well. *See, e.g., Advanced Display Sys., Inc. v. Kent State Univ.*, 212
3 F.3d 1272, 1285 (Fed. Cir. 2000) (“Objective considerations such as failure by others to solve the
4 problem and copying ‘may often be the most probative and cogent evidence’ of nonobviousness.”).
5 Because Apple’s Requests go directly to the issue of likelihood of success on the merits, they are
6 relevant to the preliminary injunction motion and properly discoverable at this time.

7 ***Irreparable Harm.*** Apple’s Requests also seek information relevant to the irreparable harm
8 component of the preliminary injunction inquiry. For example, Request Nos. 4-6 seek information
9 regarding communications between Google and Samsung regarding the Android mobile platform
10 used in the Galaxy Nexus, regarding Apple’s products, and regarding the four accused features of the
11 Galaxy Nexus – Slide to Unlock, Text Correction, Unified Search and Special Text Detection.
12 Similarly, Request No. 8 seeks information regarding Google’s decision to implement the four
13 accused features in any version of Android, while Request Nos. 9 and 10 seek information regarding
14 efforts to copy and/or design features found in Apple’s products, including the four accused features.
15 And, Request Nos. 11 and 12 seek information, such as analysis or surveys, regarding the importance
16 of the accused features, including the ability to search the Internet, to consumers and consumer
17 purchasing decisions.

18 In sum and substance, these requests focus on the importance of the accused features to
19 Google and its Android mobile platform. In a different case between Apple and Samsung, while
20 ruling on a motion for preliminary injunction, Judge Koh held that the importance of the patented
21 features is directly relevant to the issue of irreparable harm. *Apple, Inc. v. Samsung Elecs. Co.*, 2011
22 U.S. Dist. LEXIS 139049, at *65 (N.D. Cal. Dec. 2, 2011) (finding that Apple must show “a nexus
23 between Apple’s harm of lost customers and loss in market share and Samsung’s allegedly infringing
24 conduct.”). To the extent Google and Samsung communicated regarding the accused features, even
25 with respect to earlier versions of the Android mobile platform, such communications will likely
26 demonstrate the importance of the accused features. Additionally, Google’s efforts to copy the
27 features – again, even in earlier versions of the Android mobile platform – or its inability to design
28 around such features, while concluding it must nonetheless include the features, clearly demonstrate

1 importance of the features to the accused Galaxy Nexus smartphone. And, finally, Google cannot
2 reasonably dispute that its analysis regarding the importance of the accused features explicitly relates
3 to the irreparable harm element of Apple's preliminary injunction.

4 ***Balance of the Hardships.*** In addition to relating to likelihood of success on the merits and
5 irreparable harm, Google's efforts to copy, particularly if done while communicating and in concert
6 with Samsung, tip the balance of hardships in Apple's favor. Indeed, as the Federal Circuit explained
7 in *Windsurfing Int'l, Inc. v. AMF, Inc.*, 782 F.2d 995, 1003 n.12 (Fed. Cir. 1986), "[o]ne who elects
8 to build a business on a product found to infringe cannot be heard to complain if an injunction against
9 continuing infringement destroys the business so elected." See also *Jacobson v. Cox Paving Co.*,
10 1991 U.S. Dist. LEXIS 17787 (Ariz. 1991) (the balance of hardships tipped in plaintiff's favor
11 because defendant was "well aware" of plaintiff's patents "and made a calculated decision to bring an
12 infringing product to market"); *Southwest Aerospace Corp. v. Teledyne Indus., Inc.*, 702 F. Supp.
13 870, 886 (N.D. Ala. 1988), aff'd 884 F.2d 1398 (Fed. Cir. 1989) (holding that "the balance of
14 hardships in this case tips decidedly in favor" of the patent holder in the court's preliminary
15 injunction analysis, in part because the alleged infringer had "undertaken a deliberate pattern of
16 manufacturing and marketing products" "with full knowledge of" the patent holder's "proprietary
17 rights"). In view of this authority, Google can hardly assert that Apple's Requests seek information
18 that is not relevant to any claims or defenses in this litigation nor reasonably calculated to lead to the
19 discovery of admissible evidence.

20 ***Public Interests and Policy.*** Finally, evidence that Google and Samsung copied or
21 implemented the accused features in other products is relevant to the public interests and policy. See,
22 e.g., *Southwest Aerospace Corp., v. Teledyne Industries, Inc.*, 702 F. Supp 870 (N.D. Ala. 1988)
23 (granting Preliminary Injunction because, "[i]n view of the evidence that Teledyne deliberately
24 copied the claimed invention developed by Southwest the Court finds that, at this stage, the public
25 policy of protecting patent rights is more strongly implicated here such that Southwest should be able
26 to prevent Teledyne from selling what Teledyne admits are copies of Southwest's turbine air vent
27 reeling containing the '368 Patent art.").

28 Google's relevance objections blatantly overlook and purposefully ignore the issues in before

1 the Court – issues that Google’s counsel, as also counsel for Samsung, are fully aware. Apple
2 respectfully requests that the Court overrule Google’s vacuous relevance objections and order that
3 Google immediately produce the requested information.

4 **2. Google’s Generic and Unsupported Objections to the Requests Lack Merit**

5 According to the Federal Rules, “[t]he party seeking to compel discovery has the burden of
6 establishing that its request satisfies the relevance requirement of Rule 26.” *Aho v. AmeriCredit Fin.
7 Serv., Inc.*, slip op, 2012 WL 928243 *2 (S.D. Cal. 2012). As demonstrated above, Apple’s Requests
8 more than satisfy the relevance requirement of Rule 26. In view of Apple’s substantial showing,
9 Google now bears the burden of justifying its objections.

10 Indeed, the cases uniformly explain that a party resisting discovery bears the “burden of
11 showing that the discovery should be prohibited, and the burden of ‘clarifying, explaining, and
12 supporting its objections.’” *Id.* (citing *DIRECTV, Inc. v. Trone*, 209 F.R.D. 455, 458 (C.D. Cal.
13 2002) citing *Blankenship v. Hearst Corp.*, 519 F.2d 418, 429 (9th Cir.1975)). “Given the broad scope
14 of discovery in federal cases, a party objecting to discovery on the basis of vagueness, overbreadth,
15 oppression or burden must state specific facts in support of its objection.” *Johnson & Johnston v.
16 R.E. Service*, 2004 WL 3174428, at *2 (N.D. Cal. 2004). Furthermore, it is well-settled law that
17 generic and conclusory statements, without more, do not satisfy a party’s burden of supporting its
18 objections. *Aho*, 2012 WL 928243, at *6 (granting motion to compel because while “the party
19 opposing discovery has the burden of showing that the discovery should be prohibited, and the
20 burden of ‘clarifying, explaining, and supporting its objections.’ . . . Defendant does not describe in
21 detail precisely why producing this relevant information would constitute an undue burden; instead,
22 Defendant provides general and conclusory statements that . . . requesting the auto auction invoices
23 ‘would be very burdensome both to the auctions and AmeriCredit.’”) (internal citations omitted).

24 As explained above, Google has objected to every single one of Apple’s Requests included in
25 this Motion by stating boilerplate objections such as that Apple’s requests are “overly broad and
26 unduly burdensome,” “vague” and “ambiguous.” During the meet and confer process, however,
27 Google failed to articulate any specific facts detailing in what ways Apple’s requests are “overly
28 broad and unduly burdensome,” “vague” or “ambiguous.” Again, these thoughtless, boilerplate

1 objections should be overruled.

2 Another objection that Google has failed to support is its frequent objection that Apple's
3 Requests seek "information already in Apple's possession or available to Apple from some other
4 source that is more convenient, less burdensome or less expensive, including available to Apple from
5 Samsung or from public sources." Given that it comes from counsel that also represents Samsung,
6 this objection is particularly suspect. Indeed, in Samsung's objections to Apple's Requests for
7 Production, Samsung asserted that the information requested by Apple was in Google's possession.
8 (*See e.g.*, Lo Decl., Ex. 1.) Google's – and Samsung's – lawyers cannot have it both ways. Either
9 Google has the information or Samsung has the information. Regardless, Apple is entitled to obtain
10 it.

11 Finally, Google objects to nearly all of Apple's requests as purportedly "call[ing] for legal
12 conclusions." *See* Google Objection to Requests Nos. 4-12. But Google fails to explain or apply this
13 objection, and for good reason: the requests at issue seek only specifically identified documents, and
14 do not rely on any legal conclusion. For example, Requests Nos. 4-6 seek communications between
15 Google and Samsung relating to Android, Apple, or the accused features. No legal conclusion is
16 required to determine whether a document pertains to these topics. Similarly, Requests Nos. 7-8 seek
17 documents relating to design, development, and implementation of the features at issue and Request
18 Nos. 9-10 seek documents relating to copying of or attempts to design around Apple's products.
19 Google does not need to reach a legal conclusion to determine that particular documents pertain to
20 the development of Android features or copying. Finally, Requests Nos. 11-12 seek consumer survey
21 information on the importance of the features and the ability to search the Internet, which could be
22 easily identified by their content and again includes no legal term to be construed. Moreover, as
23 discussed above, boilerplate objections such as these, with no indication of *what* in the request is
24 objectionable, do not suffice to preserve, much less prevail on, an objection. *See Aho*, 2012 WL
25 928243, at *6.

26 **3. Google Cannot Shield Documents through the Common Interest Exception to**
27 **Waiver of the Attorney-Client Privilege**

28 Finally, Google asserts privilege as an objection to Request Nos. 4-12, specifically including

1 “the common interest or joint defense privileges.” But “boilerplate objections or blanket refusals
2 inserted into a response to a Rule 34 request for production of documents are insufficient to assert a
3 privilege.” *Burlington Northern & Santa Fe Rwy. v. United States District Court*, 408 F.3d 1142,
4 1149 (9th Cir. 2005). A party asserting privilege or immunity from discovery must make a rigorous
5 showing that the specific nature of the materials entitle that party to invoke privilege. *See Union Pac.*
6 *R.R. v. Mower*, 219 F.3d 1069, 1077 n. 9 (9th Cir. 2000) (“When a party withholds information . . .
7 by claiming that it is privileged . . ., the party shall make the claim expressly and shall describe the
8 nature of the documents, communications, or things . . . in a manner that, without revealing
9 information itself privileged or protected, will enable other parties to assess the applicability of the
10 privilege or protection.” (citing Fed. R. Civ. P. 26(b)(5)). The same is true of a claim to a common
11 interest; without a specific showing that “‘allied lawyers and clients’ work together in prosecuting or
12 defending a lawsuit so that they may exchange information among themselves without waiving the
13 privilege,” the material is unprotected. *Elan Microelectronics Corp. v. Apple, Inc.*, Case No. C 09-
14 01531 RS (PSG), 2011 U.S. Dist. LEXIS 87989, at *16-17 (N.D. Cal. Aug. 8, 2011) (finding that the
15 common interest privilege did not apply where plaintiff offered nothing more than “mere post hoc
16 rationalizations that it or its customers anticipated being drawn into a joint suit,” where there was no
17 joint defense or common interest agreement, and where plaintiff failed to show there was a suit or
18 even threat of suit against any of the parties who received the documents at issue); *FSP Stallion 1,*
19 *LLC v. Luce*, Case No. 2:08-cv-01155-PMP-PAL, 2010 U.S. Dist. LEXIS 110617, at *64-65 (D.
20 Nev. Sept. 30, 2010) (finding failure to establish common interest privilege absent proof that the
21 parties agreed to treat the documents as privileged and confidential at the time the documents were
22 exchanged); *Brill v. Walt Disney Pictures & TV*, No. 00-55592, 2000 U.S. App. LEXIS 31179, at *2-
23 3 (9th Cir. Cal. Dec. 1, 2000). Google’s unexplained invocation of privilege fails to meet this
24 standard.

25 In any event, the common interest doctrine cannot create privilege where none exists, but
26 merely serves as an exception to waiver of the attorney-client or work product privilege. *See Elan*
27 *Microelectronics Corp. v. Apple, Inc.*, 2011 WL 3443923 at *2 (N.D. Cal. Aug. 8, 2011) (“The
28 common interest doctrine, also known as the joint defense privilege, is a narrow exception that

1 provides that disclosure to a third party does not waive privilege or work product protection where
2 the third party shares a common interest with the disclosing party that is adverse to that of the party
3 seeking the discovery.”). The common interest doctrine, in any event, cannot protect the majority of
4 the communications responsive to the document requests in question. The common interest privilege
5 “does not extend to communications about a joint business strategy that happens to include a concern
6 about litigation,” a perfect description of Google’s communications with Samsung. *Id.* (quotation
7 omitted). Indeed, in its oppositions to Apple’s motion to compel regarding similar discovery
8 requests, Samsung confirmed that the common interest privilege cannot cover ordinary business
9 discussions between Google and Samsung, including discussions relating to the design and
10 development of accused products. (D.I. 104 at 9.) Similarly, in its responses to Apple’s requests for
11 production, its responses to Apple’s interrogatories, and its meet and confer correspondence,
12 Samsung has characterized the nature of its relationship with Google as one intended to develop a
13 technical system, the Ice Cream Sandwich platform – not one specifically arising in the context of
14 litigation. (*See, e.g.*, Samsung’s Supplemental Response to Interrogatory No. 10, Lo. Decl., Ex. 8
15 (admitting that at least communications relating to bug reports and other discussions of the
16 implementation and operability of the Ice Cream Sandwich platform exist and are engineering or
17 business discussions that will be produced).)

18 This Court should therefore order that all communications between Samsung and Google
19 relevant to Apple’s Requests for Production be produced and require that Google provide sufficient
20 information regarding any documents it seeks to withhold based on a common interest privilege to
21 justify the assertion of this privilege by no later than May 5, 2012.

22 **C. Google’s Objections to Apple’s Subpoena Seeking a Deposition Also Fail**

23 In addition to seeking documents relevant to Google’s development of Ice Cream Sandwich,
24 communications with Samsung regarding the features at issue, and customer surveys regarding the
25 importance of those features, Apple sought to depose a Google corporate representative, pursuant to
26 Fed. R. Civ. P. 30(b)(6), on similar topics. In particular, Apple sought deposition testimony on
27 twelve topics, each of which closely paralleled one of the twelve document requests. Deposition
28 testimony on each of Topic Nos. 1-3, 5, and 7-12 is relevant for the same reasons, discussed above,

1 that the requested documents are relevant. And, as noted above, and despite Google’s assertion that it
2 lacks “sufficient time . . . to prepare a witness” for a deposition on April 27, Apple’s provision of
3 over three weeks to prepare exceeds the 14-day notice period that is “presumptively reasonable.”
4 *Cris*, 2011 U.S. Dist. LEXIS 108362, at *6; *Romano*, 2010 U.S. Dist. LEXIS 79166, at *19.

5 Google, nonetheless, has refused to produce a witness in a sufficiently timely fashion to
6 permit Apple to use information obtained in its reply brief in support of its requested preliminary
7 injunction. Instead, it suggests that the witnesses who signed declarations in support of Samsung’s
8 opposition to Apple’s motion can be deposed, and that such depositions are sufficient. But Google is
9 not entitled to dictate whether Apple needs a Rule 30(b)(6) deposition on the noticed topics, nor to
10 limit Apple’s depositions to the topics to which its carefully crafted declarations pertain. Moreover,
11 Google’s other boilerplate objections – which closely parallel Google’s objections to Apple’s
12 documents and are similarly conclusory in nature – fail to shield Google from discovery for the same
13 reasons that those objections fail when invoked as a defense to Apple’s document requests.

14 This Court should therefore order that Google provide a witness for testimony on the topics at
15 issue no later than May 11, 2012.

16 **D. Google’s Arguments Regarding the Prosecution Bar in the Current Protective Order**
17 **Fall Short**

18 The Federal Circuit held that “[a] party seeking a protective order carries the burden of showing
19 good cause for its issuance. *See* Fed. R. Civ. P. 26(c); *Truswal Sys. Corp. v. Hydro-Air Eng’g, Inc.*, 813
20 F.2d 1207, 1209-10 (Fed.Cir.1987). The same is true for a party seeking to include in a protective order a
21 provision effecting a patent prosecution bar.” *In re Deutsche Bank Trust Co. Americas*, 605 F.3d 1373,
22 1378 (Fed. Cir. 2010). Google has not shown good cause for why the prosecution bar included in the
23 current protective order is insufficient. The language regarding a prosecution bar in the current protective
24 order reads as follows:

25 Absent the written consent of the Producing Party, anyone who receives one or more
26 items designated “HIGHLY CONFIDENTIAL – ATTORNEYS’ EYES ONLY” or
27 “HIGHLY CONFIDENTIAL – OUTSIDE ATTORNEYS’ EYES ONLY – SOURCE
28 CODE” shall not be involved, directly or indirectly, in any of the following activities:
advising on, consulting on, preparing, prosecuting, drafting, editing, and/or amending of
patent applications (whether for design or utility patents), specifications, claims, and/or
responses to office actions, or otherwise affecting the disclosure in patent applications or

1 specifications or the scope of claims in patents or patent applications relating to the
2 subject matter of the patents-in-suit before any foreign or domestic agency, including the
3 United States Patent and trademark Office. These prohibitions are not intended to and
4 shall not preclude (i) participating in or advising on any reexamination or reissue
5 proceeding by Samsung's Outside Counsel with respect to any patents in which Apple
6 has any interest, or participating in or advising on any reexamination or reissue
7 proceeding (except for participating in or advising on, directly or indirectly, claim
8 drafting or amending claims) by Apple's Outside Counsel with respect to any patents in
9 which Apple has any interest; and (ii) participating in or advising on any reexamination
10 or reissue proceeding by Apple's Outside Counsel with respect to any patents in which
11 Samsung has any interest, or participating in or advising on any reexamination or reissue
12 proceeding (except or participating in or advising on, directly or indirectly, claim drafting
13 or amending claims) by Samsung's Outside Counsel with respect to any patents in which
14 Samsung has any interest.

15 (Lo Decl., Ex. 7.)

16 Google insists that the last sentence be removed. In other words, although the current
17 prosecution bar already prohibits the relevant attorneys from "participating in or advising on, directly
18 or indirectly, claim drafting or amending claims," Google cannot show good cause that would justify
19 such a modification, would go even further and present the relevant attorneys from participating in
20 such reexamination or reissue proceedings at all.

21 It is, of course, no secret that defendants often initiate reexamination proceedings specifically
22 to impact the course of District Court proceedings. Indeed, Quinn Emanuel – the law firm advising
23 both Samsung and Google in this litigation – counsels as follows on its firm website: "Initiating
24 proceedings before the Patent Office to reexamine the validity of a plaintiff's issued patent can be a
25 valuable tool that impacts litigation."⁴ Accordingly, it is of critical importance to Apple that its
26 District Court counsel – who may have valuable accumulated knowledge on claim construction and
27 prior issues – be permitted to provide advice in reexamination proceedings of Apple's patents. At the
28 same time, of course, both Apple and Samsung recognized that knowledge specific to a party or third
parties' should not be utilized to craft claims specifically to cover a party's or third party's products
or services.

The current protective order was crafted with an intentional aim to balance these two

⁴ <http://www.quinnemanuel.com/news/article-july-2011-best-practices-for-defending-against-patent-trolls.aspx>

1 concerns. In particular, Samsung and Apple agreed that the reviewing counsel would be permitted to
2 generally participate in reexamination and reissue proceedings, but that that participation must fall
3 short of having any hand in “participating in or advising on, directly or indirectly, claim drafting or
4 amending claims.” This provision, then, was designed to balance the need for Apple and Samsung to
5 be able to rely on the accumulated knowledge of its District Court counsel, while at the same time
6 preventing counsel who have reviewed prosecution bar materials from participating in the claim-
7 crafting process.

8 Google’s proposed change to the protective order would upset this balance and tip it entirely
9 in favor of Google, which will not be reviewing any Apple documents in connection with this case.
10 There is no good cause for Google’s proposed modifications, and Google should be required to
11 provide responsive materials and testimony pursuant to the existing protective order.

12 **V. CONCLUSION**

13 For the foregoing reasons, Apple respectfully requests that the Court GRANT Apple’s Motion
14 to Compel and order Google to produce by no later than May 5, 2012, all readily accessible materials
15 in Google’s possession, custody, and control responsive to Document Request Nos. 3, and 6-12 of the
16 Subpoena to Produce Documents, Information or Objects served on Google by Apple on April 5,
17 2012, to produce a witness or witnesses prepared to testify regarding Apple’s Rule 30(b)(6)
18 deposition Topic Nos. 1-3, 5, and 7-12 no later than May 11, 2012 and to operate under the
19 prosecution bar included in the protective order governing this case.

20
21 Dated: April 24, 2012

22 Respectfully submitted,

23
24 By: /s/ H. Mark Lyon
25 H. Mark Lyon

26 Attorney for Plaintiff
27 APPLE, INC.
28

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was filed electronically in compliance with Civil 5 Local Rule 5,4, and will be served on all counsel for Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC who have consented to electronic service in accordance with Civil Local Rule 5.4 via the Court's ECF system.

And counsel listed below was served in the manner so indicated.

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Dated: April 24, 2012

/s/ H. Mark Lyon

H. Mark Lyon

EXHIBIT B

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

NOKIA CORPORATION,

Plaintiff,

v.

APPLE INC.

Defendant.

C.A. No. 09-791 GMS

NOKIA CORPORATION,

Plaintiff,

v.

APPLE INC.

Defendant.

C.A. No. 09-1002 GMS

Caption continued on next page

**HIGH TECH COMPUTER CORP., A/K/A HTC CORP., HTC (B.V.I.) CORP.,
HTC AMERICA, INC., AND EXEDEA, INC.'S
ANSWERING BRIEF IN OPPOSITION TO APPLE INC. AND NEXT SOFTWARE,
INC.'S MOTION FOR CONSOLIDATION OF THE CAPTIONED CASES**

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HTC America, Inc., and Exedeia, Inc.*

Dated: June 21, 2010

APPLE INC., NeXT SOFTWARE, INC.,
f/k/a/ NeXT COMPUTER, INC.,

Plaintiffs,

v.

HIGH TECH COMPUTER CORP., a/k/a HTC
CORP., HTC (B.V.I.) CORP., HTC
AMERICA, INC., EXEDEA, INC.,

Defendants.

C.A. No. 10-166-RK

APPLE, INC.,

Plaintiff,

v.

HIGH TECH COMPUTER CORP., a/k/a HTC
CORP., HTC (B.V.I.) CORP., HTC
AMERICA, INC., and EXEDEA, INC.,

Defendants.

C.A. No. 10-167-RK

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I. NATURE AND STAGE OF PROCEEDINGS

For whatever reason, Apple is dead-set against having its two cases against HTC proceed in the Northern District of California, Apple's home district and the district without question most closely connected to this case. As explained in HTC's pending motion to transfer (D.I. 8 in C.A. 10-166-RK; D.I. 8 in C.A. No. 10-167-RK), the Northern District of California is more convenient for the key non-party and party witnesses and would offer subpoena power over several non-parties, most notably Google, whose revolutionary Android operating system is the target of several of Apple's alleged infringement claims in both cases. The interest of justice also favors transfer to the Northern District of California, where the claimed inventions were allegedly conceived and reduced to practice and where Apple and non-party Google are headquartered. Apple's only point of any substance in opposition to the transfer motion relies on consolidation of the cases—hence Apple, months after it sued HTC, moved to consolidate *the very day* that it opposed HTC's motion to transfer. That timing is no coincidence. The Court should reject Apple's consolidation motion for what it is: a collateral opposition to HTC's transfer motion that Apple cannot meet on the merits.

Arguing for consolidation, Apple overstates the common factors linking the two Apple-HTC cases and the two Nokia-Apple cases—and in the process, takes a completely opposite position from what it argued in opposing consolidation in the ITC. These four cases share a mere *three patents* out of nineteen patents that Apple has asserted against both HTC and Nokia that are not stayed on account of parallel ITC proceedings. *See* Declaration of Karen L. Pascale ("Pascale Decl.") ¶ 2, Ex. 1. As to the ten non-stayed Apple patents asserted against HTC, only *four* of the 69 total inventors are named on those three overlapping patents. Given this minimal commonality, consolidation would in fact *impede* efficiency by subjecting HTC (and Nokia) to an overwhelming volume of irrelevant discovery produced by Apple in a consolidated

proceeding. Apple has thus not carried its burden to show both that common legal or factual questions predominate and that consolidation would streamline the proceedings and promote efficiency. Even if Apple could show that sufficient benefit might result from consolidation, any benefit would be outweighed by the prejudice HTC would suffer from being forced into consolidation where Apple and Nokia are asserting the lion's share of patents against one another. This prejudice would be compounded by the fact that the Court's schedule in the Nokia-Apple litigation is incompatible with the procedural posture of the Apple-HTC cases.

The Court should reject Apple's gambit to avoid transfer and deny Apple's consolidation motion—and also grant HTC's pending transfer motion.

II. SUMMARY OF THE ARGUMENT

1. The four captioned cases do not involve common questions of law or fact sufficient to justify consolidation under Rule 42(a) of the Federal Rules of Civil Procedure. Out of the *44 total patents* at issue in these cases, only eleven patents are relevant to both HTC and Nokia. Moreover, only two of these four cases are active, while the other two are stayed pending parallel ITC investigations. The non-stayed cases share *only three patents in common*. Ignoring this important fact, Apple relies on generalized statements that the non-overlapping patents are somehow related. But Apple has already admitted the opposite in resisting ITC consolidation, and the conclusory statements supporting its about-face are not enough to satisfy Apple's burden to show that consolidation is appropriate.

2. Even were consolidation found to offer some benefit, that benefit would be far outweighed by overcomplication, new delays, increased expense, and unavoidable prejudice to HTC and Nokia. Consolidating stayed cases with non-stayed cases would quickly result in litigation with suits at materially different stages. Consolidation would also force HTC to deal with a large amount of irrelevant discovery and numerous issues unique to Nokia, including an

antitrust claim entirely unrelated to HTC. Consolidation in this District would result in further prejudice because, as set forth in HTC's pending motion to transfer, this District is far less convenient than the Northern District of California for the parties and witnesses.

3. To the extent consolidation would increase judicial economy or convenience, these same benefits can be achieved by the parties themselves through informal coordination.

III. STATEMENT OF FACTS

Apple's claim that it would prove efficient to consolidate the four pending actions is belied by Apple's failure from the time it filed suit against HTC to express any interest in consolidation. Apple filed its patent counterclaims against Nokia on December 11, 2009 and February 24, 2010. Answers and Counterclaims, C.A. No. 09-791-GMS (D.I. 14); C.A. No. 09-1002-GMS (D.I. 12). When it filed its two district-court actions against HTC a week later on March 2, 2010, it neglected to indicate that any of these actions were related as it was obliged to do under District of Delaware Local Rule 3.1(b).¹ See Civil Cover Sheets, C.A. No. 10-166-RK (D.I. 1); C.A. No. 10-167-RK (D.I. 1); Declaration of Karen L. Pascale in Support of Reply Brief [of HTC] in Support of Motion to Transfer Venue Pursuant to 28 U.S.C. § 1404 (D.I. 31 in C.A. No. 10-166-RK; D.I. 32 in 10-167-RK), Ex. 2, 3. Three weeks later, rather than move to consolidate, Apple took the unusual step of writing Chief Judge Sleet and explaining that the four cases "involve *some* of the same technology" and that they should be "identified" as related. Letter to The Honorable Gregory M. Sleet from Richard K. Herrmann dated March 24, 2010 (D.I. 5 in C.A. No. 10-166-RK; D.I. 5 in C.A. No. 10-167-RK) (emphasis added). Only after HTC moved to transfer its cases to the Northern District of California did Apple file its motion for consolidation—on the same day it filed its opposition to the transfer motion.

¹ Local Rule 3.1(b) requires parties to indicate at the time of filing when cases, among other things, involve the same patent or the same trademark, or for other reasons would entail substantial duplication of labor if heard by different judges.

IV. ARGUMENT

Federal Rule of Civil Procedure 42(a) provides in pertinent part that “[w]hen actions involving a common question of law or fact are pending before the court . . . it *may* order all the actions consolidated; and it *may* make such orders concerning proceedings therein as may tend to avoid unnecessary costs or delay.” Fed. R. Civ. P. 42(a) (emphasis added). “The mere existence of common issues, however, does not require consolidation.” *Liberty Lincoln Mercury, Inc. v. Ford Marketing Corp.*, 149 F.R.D. 65, 81 (D.N.J. 1993). Indeed, a “common question of law or fact shared by all of the cases” is merely a threshold requirement. *In re Consolidated Parlodel Litig.*, 250 F.R.D. 441, 444 (D.N.J. 1998). A court should not grant consolidation if it will burden the parties and the court with an “overcomplication of issues.” *Atkinson v. Roth*, 297 F.2d 570, 575 (3d Cir. 1961). Thus, courts contemplating consolidation must “weigh the interests of judicial economy against the potential for new delays, expense, confusion, or prejudice.” *Parlodel*, 250 F.R.D. at 444 (quotation omitted). Here, as the moving party, Apple carries the “burden of persuading the court that consolidation is proper.” *Watkinson v. Great Atlantic & Pacific Tea Co., Inc.*, 585 F. Supp. 879, 883 (E.D.Pa. 1984); *see also Borough of Olyphant v. PPL Corp.*, 153 Fed. Appx. 80, *2 (3d Cir. 2005) (same).

When two cases have different defendants, even a substantial overlap in the asserted patents may not be enough to render consolidation proper. To take one example, in *Powervip, Inc. v. Static Control Components, Inc.*, the court recognized that party-specific issues can erode the benefits of consolidation, even when two cases share four out of five patents. 2009 WL 152106, at *9 (W.D. Mich. 2009) (dismissing the possibility of consolidation when deciding a transfer motion). Here, there are numerous issues of law and fact unique to HTC or Nokia. Apple has not carried its burden of showing the benefits of consolidation on these facts.²

² Apple’s opening brief in support of its motion to consolidate (“Op. Brf.”) cites a handful of patent-infringement suits where courts ordered consolidation, and implies that this situation is

A. Apple fails to demonstrate that common questions of law or fact predominate across the four pending actions.

1. Contrary to Apple's claimed count, at most three patents overlap.

Federal Rule of Civil Procedure 42(a) allows consolidation “when common questions of law or fact *predominate.*” *Vallero v. Burlington Northern R. Co.*, 749 F. Supp. 908, 913 (C.D. Ill. 1990) (emphasis added). Apple’s motion relies heavily on the claim that, of the 27 patents it asserts in these four cases, it has asserted eleven of them against both HTC and Nokia. (Op. Brf. at 4.) But Apple’s patent count is misleading for two reasons. *First*, Apple inappropriately urges consolidation of two actions that Chief Judge Sleet and Judge Kelly have already stayed on account of parallel ITC proceedings. *See* Orders Staying Cases, C.A. No. 09-1002-GMS (D.I. 13); C.A. No. 10-166-RK (D.I. 17). But the extent to which the stayed cases overlap with the non-stayed cases is irrelevant, because the stayed cases cannot be litigated until the related ITC proceedings conclude. Accordingly, consolidating these stayed cases now could not result in any meaningful increase in convenience, as it may be years before those cases become active. Focusing on the non-stayed cases, Apple asserts against HTC and Nokia nineteen total patents, only *three* of which Apple asserts against *both* HTC and Nokia. Pascale Decl., Ex. 1. Thus, the number of overlapping Apple patents is at most three.³

similar. (Op. Brf. at 6) (D.I. 22 in C.A. No. 10-166-RK; D.I. 20 in C.A. No. 10-167-RK). But those cases present facts materially distinct from those here. Those courts consolidated separate cases involving *the same single patent* (*Magnavox Co. v. APF Electronics, Inc.*, 496 F. Supp. 29, 31-32 (N.D. Ill. 1980); *Kohus v. Toys “R” Us, Inc.*, 2006 WL 1476209 (S.D. Ohio May 25, 2006)), *two mirror-image cases* involving the same parties who were each asserting “blocking patents” so similar that neither party could sell its product without infringing the other’s patent (*Rohm and Haas Co. v. Mobile Oil Corp.*, 525 F. Supp. 1298, 1301 (D. Del. 1981)), and alleged infringement of patents *that all claimed the same chemical compound* (*Smithkline Beecham Corp. v. Geneva Pharm., Inc.*, 2001 WL 1249694 (E.D. Pa. Sep. 26, 2001)). In contrast to these situations, Apple has demonstrated a relatively small overlap of only three patents between the non-stayed cases.

³ These three overlapping patents are U.S. Patent Nos. 5,848,105; 7,383,453; and 7,469,381. Pascale Decl., Ex. 1. That number may soon fall to only two patents, as HTC has filed a motion to dismiss the ’453 Patent because its claims were in fact not allowed by the USPTO. *See*

Furthermore, Apple's emphasis on its own patents ignores the ten patents originally asserted by Nokia against Apple in the non-stayed Nokia case.⁴ Pascale Decl., Ex. 1. It would be a case of the scheduling tail wagging the dog for a three-patent overlap to force HTC into a consolidated proceeding in which *sixteen* other non-stayed patents (six asserted by Apple against only Nokia, and ten asserted by Nokia against Apple) have nothing at all to do with HTC.⁵

Even indulging in Apple's assessment of overlap among stayed and non-stayed proceedings reveals no predomination of common questions of law or fact. Counting both stayed and non-stayed cases, the Nokia-Apple litigation began with Nokia asserting seventeen total patents against Apple. Pascale Decl., Ex. 1. Apple *counterclaimed* against Nokia for infringement of a total of eighteen patents. *Id.* Then, in separate suits assigned to a different judge, Apple alleged that HTC infringes a total of twenty patents as well, eleven of which are patents that Apple has also asserted against Nokia. *Id.* If Apple's motion is granted, by Apple's own count the resulting litigation combining stayed and non-stayed cases would involve a total of at least **44 different patents**. HTC and Nokia would share an interest in only eleven of these patents, meaning that three-quarters of the litigation would be a waste of time for one or the other. And if patents in only the non-stayed cases are counted, then the resulting number is that HTC and Nokia would share an interest in only *three* out of a total of 26 non-stayed patents.

Motion to Dismiss Count VIII of Complaint Pursuant to Rule 12(b)(6), C.A. No. 10-167-RK (D.I. 26).

⁴ Furthermore, if and when HTC answers Apple's complaint, it may assert patents against Apple (and not Nokia), further increasing the amount of non-overlapping issues and diminishing any efficiency to be gained by consolidation.

⁵ Additionally, Apple has asserted non-patent antitrust counterclaims against Nokia in the non-stayed Nokia case. Apple Answer and Counterclaims, C.A. No. 09-791 GMS (D.I.14). These counterclaims raise issues entirely unique to the Apple-Nokia dispute, further reducing the commonality among these four cases.

Under either scenario, Apple's desired result would require the Court needlessly to coordinate activities where one defendant has no involvement most of the time.

2. Apple overstates the witness and technological overlap the four pending actions present.

As with its count of overlapping patents, Apple inflates the number of overlapping inventors by counting patents in the stayed and non-stayed matters. (Op. Brf. at 4.) Of the 69 inventors named in the ten Apple patents asserted against HTC in the non-stayed action, a mere *four* inventors are on the three patents that Apple has also asserted against Nokia in that non-stayed action. Thus, there is little efficiency to be gained by consolidation—as needed, the parties in separate proceedings can always coordinate the scheduling of inventor depositions.

Apple also claims that the patents asserted against only HTC or Nokia are technologically “related” to the three overlapping patents. (Op. Brf. at 4.) But Apple advanced the *exact opposite position* in opposing partial consolidation of overlapping patents in the ITC investigations instigated by Apple against HTC and Nokia. *See* Apple's Opposition to Consolidation, Pascale Decl. ¶ 3, Ex. 2. In those proceedings:

- Apple admitted that its complaints against HTC and Nokia were “more different than alike.” Pascale Decl., Ex. 2 at 5.
- Apple characterized HTC and Nokia as “two separate infringers that sell completely different infringing products,” *Id.* at 1, and provided a detailed explanation of the issues unique to HTC and Nokia. *Id.* at 6-8.
- Apple represented that the cases against HTC and Nokia would entail “significant amounts of distinct, non-overlapping evidence such as Finnish and Taiwanese testimony from product developers, source code for the accused products, third party testimony and documents from Nokia's and HTC's third party vendors, and financial/marketing evidence unique to Nokia and HTC.” *Id.* at 7.

- Ironically, Apple accused HTC of “minimiz[ing] the important differences in the patents asserted in the respective cases and instead rely[ing] on sweeping generalizations about the claimed subject matter,” and pointed out that these patents would require “different sets of experts and witnesses for the sub-specialties within the technology.” *Id.* at 7-8.
- Apple ultimately concluded that consolidating just those two investigations “would create an unmanageable mega-investigation and render it nearly impossible to complete the combined investigation in a timely fashion.” *Id.* at 3.

The ITC partly agreed with Apple, and followed the Staff’s recommendation to consolidate only the five patents that actually overlapped. ITC Order Granting Partial Consolidation, Pascale Decl. ¶ 4, Ex. 3. Here, of course, there is no recourse for partial consolidation.

3. Consolidation would provide limited efficiency and streamlining of issues.

Apple’s motion asks the Court to consolidate stayed cases with non-stayed cases. But that approach would necessarily create scheduling inefficiency and confusion by combining suits moving at different paces. Courts consistently refuse to consolidate cases that are at different stages of litigation.⁶ Here, the ITC proceedings corresponding to the stayed cases have just recently commenced, and the stay may not be lifted for several years, during which the gap between the stayed and non-stayed cases will necessarily increase. Thus, if Apple’s motion were

⁶ For example, in *Rendon v. City of Fresno*, 2006 WL 1582307 (E.D. Cal. June 2, 2006), a court decided not to consolidate three related actions where two actions were filed between seven and ten months prior to the third action. *Id.* at *7. Another district court pointed out that, even if there are “questions of law common to both actions, this does not justify consolidation, particularly where, as here, parties would be prejudiced . . . from the circumstance that the cases are in different phases of pre-trial procedures.” *Schacht v. Javits*, 53 F.R.D. 321, 324-25 (S.D.N.Y. 1971). “[P]roper judicial administration does not recommend consolidation where two actions are at such widely separate stages of preparation.” *Id.*; see also *Habitat Educ. Ctr., Inc. v. Kimbell*, 250 F.R.D. 390, 395 (E.D. Wis. 2008) (deciding against consolidation partly because the cases were in “slightly different procedural postures,” which might have caused unnecessary delay).

granted, the Court and the parties would eventually end up with consolidated cases at radically different stages—reason enough on its own *not* to consolidate the stayed and non-stayed cases.

Apple suggests that failure to consolidate could lead to redundant discovery, duplicative depositions and hearings, and inconsistent rulings. Apple is wrong for several reasons. *First*, consolidation actually poses a greater risk of discovery inefficiency. Apple, HTC, and Nokia are large technology companies, and the vast majority of discovery will deal with electronically-stored information produced in electronic form. To the extent materials gathered in one case are relevant to another case, reproduction would require only minimal effort. But if the four pending cases are consolidated, HTC would be forced to wade through gigabytes of undifferentiated documents just to determine whether they were relevant to its case or the Nokia litigation.

Second, to the extent discovery overlaps, the parties will have an incentive to coordinate their efforts so as to minimize cost. Such coordination occurs all the time in complex litigation. As Apple explained in opposing consolidation before the ITC, “there is no reason why depositions of common inventors from overlapping patents cannot be scheduled in a coordinated fashion without combining otherwise wholly disparate cases.” Pascale Decl., Ex. 2.

Third, Apple overstates the potential for inconsistent *Markman* rulings. As discussed above, there are at most three patents that overlap between the non-stayed cases. Even if Apple asserts the same claims of those patents against HTC and Nokia, if one court construes the three patents first, the second court presumably would be guided but not bound by that construction—as happens routinely in cases where a patent has already been litigated before another court. *See, e.g., Johnson & Johnson Vision Care, Inc. v. CIBA Vision Corp.*, 540 F. Supp. 2d 1233, 1242 (M.D. Fla. 2008) (noting that even where another district court has construed a patent's terms, “the Court has an independent obligation to determine the meaning of the claims, and to render its own independent claim construction”); *American Piledriving Equip., Inc. v. Equipment Corp.*

of Am., 2009 WL 3401726, *7 (W.D. Pa. 2009) (same). In any event, by asserting several patents both against HTC in this Court and against Nokia in the ITC, Apple has guaranteed that they will be construed by different decision-makers regardless of this Court's consolidation ruling. Apple itself agrees that "[j]udges all the time have to deal with issues that may have been ruled on, in one form or another, by another judge." Pascale Decl., Ex. 2 at 13. And that minimal risk is more than offset by the inappropriateness of forcing HTC into a consolidated case in which 33 patents, asserted by Apple and Nokia against only each other, would also be contested. Pascale Decl., Ex. 1.

B. Consolidation would prejudice HTC and non-party witnesses in the extreme.

Even if Apple had carried its burden to show the potential benefits of consolidation in this case (which it has not), the prejudice to HTC would still outweigh these benefits for two reasons.

First, consolidation would disrupt the schedule established in the Nokia-Apple litigation. Contrary to Apple's claim, the non-stayed Nokia case is materially further along than the non-stayed HTC case. In the non-stayed Nokia case, the pleadings have closed and the parties have commenced discovery. Chief Judge Sleet has already issued a scheduling order in that case setting a *Markman* hearing on May 16, 2011, with opening briefing due on March 15, 2011, a fact-discovery cut-off of July 15, 2011, and a trial date of May 21, 2012. *See, e.g.*, April 9, 2010 Minute Order and D.I. 42 in C.A. No. 09-791-GMS. In contrast, HTC has recently moved to dismiss one of the patents Apple has asserted against it and also moved to transfer. C.A. No. 10-167 RK (D.I. 26, 8). HTC has not yet filed its answer and the Court has not yet set a case schedule. Consolidation would result in either rushing the HTC suit through pretrial proceedings or delaying the established Nokia schedule.

Second, the cases against HTC should be transferred for the convenience of non-party witnesses and the interest of justice to the Northern District of California. As explained more fully in the briefs in support of HTC's pending motion to transfer (D.I. 9, 30 in C.A. No. 10-166-RK; D.I. 9, 31 in C.A. No. 10-167-RK), nearly all of the 28 U.S.C. § 1404(a) factors support transfer of the HTC cases to the Northern District of California:

- **The Northern District of California is the most convenient forum for non-party witnesses.**

In support of its Motion to Transfer Venue, HTC has submitted evidence conclusively showing that there are a large number of non-party witnesses located in California, including:

- 54 named inventors of the Apple patents at issue, 30 of whom are not Apple employees;
- the majority of Google personnel responsible for the research, design, development, and marketing of the Android Operating System relevant to several patents;
- the majority of Google personnel responsible for working with HTC to develop certain accused products; and
- Qualcomm, Inc. employees responsible for designing and selling the baseband chips identified in Apple's infringement allegations.

The availability of witnesses is generally considered to be the "most crucial factor" in deciding motions to transfer. *Pennwalt Corp. v. Purex Indus., Inc.*, 659 F. Supp. 287, 291 (D. Del. 1986). In contrast, Apple has failed to identify a single witness in Delaware. *See In re Genentech*, 566 F.3d 1338, 1345 (Fed. Cir. 2009) (transfer required where "a substantial number of material witnesses reside within the transferee venue and state" and no witnesses are found in the transferor district).

- **Apple's choice of venue in this District merits no deference.**

Under Delaware law, a plaintiff's choice of forum receives only minimal deference when that plaintiff resists transfer from a district that is neither its "home turf" nor meaningfully connected to the lawsuit. *Virgin Wireless, Inc. v. Virgin Enters., Ltd.*, 201 F. Supp. 2d 294, 300 (D. Del. 2002). In this case, Apple is a California corporation with its principal place of business in California. It cannot dispute that HTC's transfer motion seeks to move this litigation to Apple's "home turf." Further, Apple has been unable to point to a single fact demonstrating a significant connection between the Apple-HTC litigation and this District. Like Apple, HTC is not incorporated in Delaware and has no meaningful connection to this forum.

- **The Northern District of California is the most convenient forum for the parties themselves.**

Despite Apple's protests, venue in the Northern District of California would serve its convenience as well. Apple is based in Cupertino, California and employs a number of potential witnesses there. Similarly, HTC has employee-witnesses in that judicial district as well as in venues more convenient to that district.

- **The interest of justice requires transfer.**

The only response of any substance that Apple has mounted to HTC's motion to transfer is that there is a small overlap with the Nokia cases already pending in this District. Hence Apple's failing to move to consolidate or relate the cases until the very day that its opposition to HTC's motion to transfer came due. Even if that collateral-attack strategy were procedurally sound, it is inconsistent with Supreme Court law. "The power to defeat a transfer to the convenient federal forum should derive from rights and privileges conferred by federal law and not from the deliberate conduct of a party favoring trial in an inconvenient forum." *Van Dusen v. Barrack*, 376 U.S. 612, 624 (1964).

V. CONCLUSION

Because consolidation would result in a litigation with 44 total patents, only three of which are going forward and involve the same parties, and would unnecessarily disrupt the schedule and proper venue of those cases, consolidation is improper and Apple's motion should be denied.

June 21, 2010

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CERTIFICATE OF SERVICE

I, Karen L. Pascale, Esquire, hereby certify that on June 21, 2010, I caused to be electronically filed a true and correct copy of the foregoing document with the Clerk of the Court using CM/ECF, which will send notification of such filing to the following counsel of record:

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EXHIBIT C

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

NOKIA CORPORATION,)
)
Plaintiffs,)
v.) C.A. No. 09-791 GMS
)
APPLE INC.,)
)
Defendants.)

NOKIA CORPORATION,)
)
Plaintiff,)
v.) C.A. No. 09-1002 GMS
)
APPLE INC.,)
)
Defendants.)

Caption continued on next page

**APPLE INC. AND NEXT SOFTWARE, INC.'S BRIEF IN SUPPORT OF THEIR
MOTION FOR CONSOLIDATION OF THE CAPTIONED CASES FOR
THE PURPOSE OF COORDINATING PRETRIAL PROCEEDINGS**

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May 24, 2010

APPLE INC., and NeXT SOFTWARE, INC.,)
f/k/a NeXT COMPUTER, INC.,)

Plaintiffs,)

v.)

C.A. No. 10-166-RK

HIGH TECH COMPUTER CORP., a/k/a)
HTC CORP., HTC (B.V.I.) CORP., HTC)
AMERICA, INC., and EXEDEA, INC.,)

Defendants.)

APPLE INC.,)

Plaintiff,)

v.)

C.A. No. 10-167-RK

HIGH TECH COMPUTER CORP., a/k/a)
HTC CORP., HTC (B.V.I.) CORP., HTC)
AMERICA, INC., and EXEDEA, INC.,)

Defendants.)

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Rules

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I. THE NATURE AND STAGE OF PROCEEDINGS

There currently are four patent infringement actions pending in this District asserting that Nokia Corporation (“Nokia”) and/or High Tech Computer Corp. and its subsidiaries (collectively, “HTC”) infringe a number of Apple patents.¹ The first two cases filed were assigned to Chief Judge Sleet. The second two cases were assigned to Judge Robert Kelly, who is sitting in this District by designation. Pursuant to Federal Rule of Civil Procedure 42(a), Apple requests that the Court consolidate the second set of cases—at least for purposes of coordinating pre-trial activities—with the first two that are pending before Chief Judge Sleet.

Consolidation is appropriate in this instance because the four cases involve numerous common issues of law and fact, including eleven patents that Apple has asserted against both Nokia and HTC. Given the overlapping patents and technologies at issue in the cases, consolidation offers the benefit of conserving resources and promoting judicial economy by avoiding the need for duplicative discovery or any other redundant litigation activities, such as multiple *Markman* hearings concerning the same patents. Importantly, consolidation before a single judge will also ensure that there are no inconsistent pretrial rulings—most notably inconsistent constructions of claim terms in the eleven overlapping patents.

There is no danger of prejudice to any of the parties in these cases as a result of consolidation. All four litigations are still in the very early stages, with only one having reached discovery and two having been stayed pending the outcome of proceedings in the International Trade Commission. HTC has not yet answered, and there is no schedule in place yet in the non-stayed HTC case. Consolidating that case with the non-stayed Nokia case should present no

¹ The four cases are *Nokia Corporation v. Apple Inc.*, C.A. No. 09-791 GMS (the “791 Case”), *Nokia Corporation v. Apple Inc.*, C.A. 09-1002 GMS (the “1002 Case”), *Apple Inc. et al. v. High Tech Computer Corp. et al.*, C.A. No. 10-166 RK (the “166 Case”), and *Apple Inc. v. High Tech Computer Corp. et al.*, C.A. No. 10-167 RK (the “167 Case”).

complications, and the new case would benefit from the fact that Chief Judge Sleet has already considered relevant procedural issues and recently set a schedule in the related Nokia action. Indeed, Nokia and HTC themselves recently argued the merits of consolidation with respect to a set of parallel proceedings at the ITC involving many of the same Apple patents. Nokia and HTC successfully argued that two investigations regarding their infringement of five overlapping patents should be consolidated into a single investigation, contending that consolidation was necessary to “eliminate the waste of the parties’ and [the tribunal’s] time and [of the] expense that would otherwise result from redundant discovery, unnecessarily repetitive briefings and duplicative hearings featuring the same exhibits, witnesses, and evidence.”² These arguments apply with equal force to the present district court actions, which involve the same defendants and multiple overlapping patents—including several of the same patents at issue in the consolidated ITC cases.

The benefits of ensuring consistency and avoiding a waste of judicial resources strongly favor consolidation. Having argued for full consolidation of Apple’s cases in the ITC, HTC and Nokia cannot credibly contend that the cases pending before two judges in this District should not be consolidated for efficient case management and to eliminate duplicative activity and potential inconsistencies. Apple therefore respectfully requests that the Court consolidate the HTC case with the Nokia case.

II. SUMMARY OF ARGUMENT

1. “If actions before the court involve a common question of law or fact, the court may . . . join for hearing or trial any or all matters at issue in the actions.” FED. R. CIV. P. 42(a).

² Ex. 1, Nokia’s Mot. for Full Consolidation of Invest. Nos. 337-TA-704 and 337-TA-710 (the “Nokia ITC Br.”) at 8; Ex. 2, HTC Resp.’s Mot. for Full Consolidation of Invest. Nos. 337-TA-704 and 337-TA-710 (the “HTC ITC Br.”) at 8. Unless otherwise noted, all exhibits referred herein are attached to the Declaration of Richard K. Herrmann submitted with this motion.

This Court has broad authority to consolidate actions—or parts of actions—that involve common questions of fact or law if, in the Court’s discretion, consolidation would facilitate the administration of justice.

2. Consolidation of pretrial activities is warranted in this instance because the four pending cases include patent-infringement allegations brought by Apple against a common pair of defendants, based on an overlapping set of Apple patents and similar sets of accused products (smart phones). The requested consolidation would facilitate the administration of justice by: avoiding the need for redundant pretrial activities, thus reducing the time and resources that the Court and parties must invest in these proceedings; serving the convenience of the many witnesses who will be relevant to the related cases, including potential third parties such as inventors; and eliminating the possibility that separate judges will render inconsistent rulings based on the same issues of fact and law.

3. Given the preliminary posture of all four cases, the parties will not suffer any prejudice from consolidation. Nokia and HTC themselves recently sought and obtained a similar consolidation in a set of related ITC proceedings involving many of the same patents and claims, thus indicating that the result Apple proposes would not pose any genuine prejudice to them.

III. STATEMENT OF FACTS

Four actions are now pending in the District of Delaware in which Apple has asserted patent-infringement claims against Nokia and/or HTC. The first two cases filed are presently pending before Judge Sleet, and the second two have been assigned to Judge Kelly.

The 791 Case. On October 22, 2009, Nokia filed an infringement action in this Court against Apple (the “791 Case”). On February 19, 2010, Apple filed its amended answer to Nokia’s complaint, asserting counterclaims against Nokia for infringement of nine Apple patents. (*See* 791 Case D.I. 21.)

The 1002 Case. On December 29, 2009, Nokia filed a second infringement suit in this Court against Apple (the “1002 Case”). On January 15, 2010, Apple filed a complaint against Nokia at the ITC, asserting infringement of nine Apple patents. The ITC subsequently opened an investigation (the “704 Investigation”). On February 24, Apple filed its answer and counterclaims in the 1002 Case, and asserted the nine patents from the 704 Investigation against Nokia. (*See* 1002 Case D.I. 12.) On March 3, 2010, this Court stayed the 1002 Case pending the outcome of two ITC proceedings, including the 704 Investigation. (*See* D.I. 13.)

The 166 and 167 Cases. On March 2, 2010, Apple filed two complaints in this District for patent infringement against HTC, asserting a total of twenty Apple patents (the “166” and “167 Cases”). Apple filed a corresponding complaint at the ITC asserting infringement of the patents at issue in the 166 Case, and the ITC opened an investigation (the “710 Investigation”). On April 26, this Court stayed the 166 Case pending the outcome of the 710 Investigation. (*See* 166 Case D.I. 17.)

There are numerous commonalities of fact and law among the claims that Apple has brought against Nokia and/or HTC in the 791, 1002, 166, and 167 Cases that are now pending. Significantly, of the 27 total Apple patents being asserted, Apple has asserted *eleven* against both Nokia and HTC.³ Only seven patents are asserted solely against Nokia, and only nine are asserted solely against HTC. Even the individually-asserted patents bear numerous relations to the commonly-asserted ones, as thirteen inventors named on the individually-asserted patents are also named on one or more of their commonly-asserted counterparts. Moreover, many of the individually-asserted patents are directed to related technologies, including object-oriented programming and software architecture, user interfaces and touch screens, networking, and

³ See Ex. 3 for a list of the specific patents asserted in the 791, 1002, 166, and 167 Cases.

computer start-up procedures.

Given the overlapping parties and patents and the similar technologies at issue in these four cases, counsel for Apple sent a letter to this Court on March 24, 2010, explaining the common facts among the litigations and requesting that they be identified as related cases. (*See* Ex. 4.) Apple respectfully submits the present motion as a formal reiteration of that request.

IV. ARGUMENT

In the interest of judicial economy, Apple respectfully requests that the 791, 1002, 166, and 167 Cases be consolidated so that pre-trial matters such as discovery and claim construction can be coordinated by a single judge. Given the numerous overlapping factual and legal issues underlying Apple’s claims against Nokia and HTC—including eleven commonly-asserted patents, many substantially similar claim terms, related sets of patented and accused technologies, and consolidated ITC proceedings on overlapping patents—these matters would best be coordinated by a single chambers, at least through the pre-trial stage.⁴

A. The Legal Standard for Consolidation

Federal Rule of Civil Procedure 42(a) provides: “If actions before the court involve a common question of law or fact, the court may . . . join for hearing or trial any or all matters at issue in the actions.” FED. R. CIV. P. 42(a). “Rule 42(a) gives a district court broad powers to consolidate actions involving common questions of law or fact if, in its discretion, such consolidation would facilitate the administration of justice.” *Alexander v. Minner*, No. 07-041-JJF, 2009 WL 1176456, at *6 (D. Del. May 1, 2009) (citing *In re Lucent Techs. Inc. Securities Litig.*, 221 F. Supp. 2d 472, 480 (D.N.J. 2001)); *see also Tracinda Corp. v. DaimlerChrysler AG*,

⁴ Consistent with common practice, Apple requests that the consolidation occur before the judge assigned to the first-filed of the related cases, Judge Sleet. *See, e.g., Kohus v. Toys “R” Us, Inc.*, Nos. C-1-05-517, C-1-05-671, 2006 WL 1476209, at *2 (S.D. Ohio May 25, 2006) (noting that it is common practice to consolidate cases “into the first-filed case”).

No. CIV. A. 00-984-JJF, et al, 2001 WL 849736, at *1 (D. Del. July 26, 2001) (granting consolidation for pretrial and discovery purposes). Consolidation may be ordered on one party's motion or on the Court's own initiative. *See Ellerman Lines, Ltd. v. Atlantic & Gulf Stevedores, Inc.*, 339 F.2d 673, 675 (3d Cir. 1964). The consolidation of related patent cases to coordinate pretrial proceedings and thus avoid duplicative pretrial activities or contradictory rulings is routine. *See, e.g., Rohm & Haas Co. v. Mobil Oil Corp.*, 525 F. Supp. 1298, 1309-10 (D. Del. 1981) (consolidating actions involving six patents).⁵

B. Nokia and HTC Successfully Moved to Consolidate the Parallel 704 and 710 Investigations at the ITC.

After the ITC opened the 710 Investigation (which involves claims parallel to those in the 166 Case) on March 31, 2010, Nokia and HTC moved for consolidation of all issues relating to the overlapping Apple patents asserted against them in the 704 and 710 Investigations. Nokia and HTC argued that there was “extensive overlap of legal, factual and procedural issues among the two investigations, including substantial overlap among the parties, technology, asserted patents and claims, claim construction arguments, validity arguments, witnesses, third parties, evidence [and] defenses.” (Ex. 1, Nokia ITC Br. at 1; Ex. 2, HTC ITC Br. at 1.) They contended that consolidation “would simplify and reduce duplicative discovery and proceedings, make more efficient use of the Commission’s resources, and prevent [inconsistent rulings].” (*Id.* at 2.) Indeed, HTC and Nokia argued that consolidation of the investigations was the *only* way to avoid

⁵ *See also Kohus*, 2006 WL 1476209, at *1 (“[C]onsolidating the cases for discovery and a *Markman* hearing would prevent two trials from going forward on the basis of inconsistent adjudications of the meaning of the exact same claims.”); *SmithKline Beecham Corp. v. Geneva Pharmaceuticals, Inc.*, No. 99-CV-2926, et al, 2001 WL 1249694, at *5–6 (E.D. Pa. Sept. 26, 2001) (noting that issues of validity and the ability to “separate duplicative discovery” warranted consolidation for pretrial purposes); *Magnavox Co. v. APF Electronics, Inc.*, 496 F. Supp. 29, 32 (N.D. Ill. 1980) (noting that Rule 42(a) “contemplates consolidation for purposes of particular segments of the litigation, such as pretrial proceedings” and that issues of validity and, to some extent, infringement warranted consolidation of pretrial proceedings).

such problems. (*See id.* at 1.)

On April 26, 2010, the ITC ordered partial consolidation of the 704 and 710 Investigations, and reassigned the commonly-asserted patents and all issues relating to them to a single investigation and ALJ. However, despite Nokia and HTC's previous positions, as of the time of filing Nokia failed to respond to Apple's inquiry and HTC confirmed that it will oppose consolidating the present cases—even though many of the same patents that overlap at the ITC also overlap in these cases and many of the same issues that formed the basis for consolidation in the ITC are present here.

C. Consolidating the Four Pending Cases Will Conserve Resources, Promote Judicial Economy, and Protect Against the Possibility of Inconsistent Rulings.

As described above, the 791, 1002, 166, and 167 Cases involve numerous common issues of law and fact that militate in favor of consolidation. All four cases involve patent infringement allegations brought by Apple, and nearly half of the Apple patents asserted are directed at both defendants, Nokia and HTC. Further, as Nokia and HTC recently argued at the ITC, even those patents that are only asserted against one of them still involve the same technology.⁶ Given the overlapping patents and technologies among the four cases, issues regarding claim construction, expert and fact discovery, witnesses (including third parties, inventors, and experts), validity and enforceability, and damages will all be related. Indeed, Nokia and HTC recently argued in the parallel ITC proceedings, “*the only unique legal issue* raised in the two investigations may be

⁶ See Ex. 1, Nokia ITC Br. at 5 (“[E]ven [the] patents that do not overlap share the same technology and the same types of accused products.”); see also Ex. 2, HTC ITC Br. at 5-6 (noting that the ’867 and ’983 patents and the ’852 and ’486 patents “both derive from largely identical specifications filed on the same day,” the ’337, ’354, and ’750 patents all relate to “software event handling,” the ’721 and ’705 patents relate to “interprocess communication,” the ’599 and ’431 patents involve “object-oriented technology” and “[t]he remaining four patents also implicate the accused handsets’ operating systems and related software”).

the respondents' technical implementation of the [accused] operating software.” (Ex. 1, Nokia ITC Br. at 8 (emphasis added); Ex. 2, HTC ITC Br. at 8 (same).)

The existence of this overwhelming number of common issues plainly indicates that consolidating these cases would facilitate their orderly and efficient resolution. Judicial economy will be served because there will be no need for duplicative hearings, depositions, or document production. Moreover, given the related nature of the asserted patents and accused devices, similar discovery issues are likely to arise, which it would be most efficient for a single judge to address. Indeed, given the nature of the claims, there is no reason for Nokia and HTC not to coordinate their efforts—as they themselves previously noted to the ITC.⁷ As HTC and Nokia both argued, consolidation “will eliminate the waste of the parties’ and [the tribunal’s] time and [of the] expense that would otherwise result from redundant discovery, unnecessarily repetitive briefings and duplicative hearings featuring the same exhibits, witnesses, and evidence.” (Ex. 1, Nokia ITC Br. at 8; Ex. 2, HTC ITC Br. at 8.) These arguments apply equally in this Court. *Cf. Ford v. Christiana Care Health Systems*, Civil Action No. 06-301-MPT, 2008 WL 1985229, at *1 (D. Del. May 5, 2008) (“The purpose of [Rule 42] is to promote judicial economy and convenience and to avoid unnecessary costs or delay.”).

In addition, consolidation will eliminate the risk of inconsistent pretrial rulings, which is an especially important consideration in patent cases, given the key role of the court’s claim construction rulings in shaping the course of the litigation. To avoid the possibility of

⁷ See Ex. 1, Nokia ITC Br. at 6-7; Ex. 2, HTC Br. at 6 (“There is certain to be substantial overlap . . . in the depositions of experts and fact witnesses—particularly of third parties who are expected to possess prior art critical to both respondents’ defenses. . . . [C]onsolidation will reduce these redundancies and will also relieve experts, inventors, and other deponents . . . from the burden of multiple depositions and multiple appearances during separate proceedings.”).

contradictory outcomes based on the same facts, it would be expedient to have a single judge rule on common issues relating to claim construction, summary judgment of validity and/or enforceability, as well as discovery issues concerning the patents. Indeed, this Circuit recognizes that preventing conflicting rulings in cases involving similar issues of fact and law is a key purpose of consolidation. *See In re TMI Litig.*, 193 F.3d 613, 724 (3d Cir. 1999) (“The purpose of consolidation is to streamline and economize pretrial proceedings so as to avoid duplication of effort, and to prevent conflicting outcomes in cases involving similar legal and factual issues.”) (internal quotes omitted). HTC and Nokia themselves stressed the need to avoid inconsistent rulings when they sought a similar consolidation of Apple’s claims at the ITC.⁸ Under the circumstances, this consideration strongly favors Apple’s motion.

D. Consolidation Will Not Prejudice Nokia or HTC.

Nokia and HTC will not suffer any prejudice if Apple’s motion is granted. All four cases are still in their early stages. The 1002 and 166 Cases are both stayed, pending the outcomes of the parallel ITC investigations, and discovery has only recently commenced in the 791 Case. The defendants have not answered Apple’s complaints in the 166 and 167 Cases, and HTC’s motion to transfer those cases to the Northern District of California remains pending.⁹ Thus, the

⁸ *See* Ex. 1, Nokia ITC Br. at 7 (“Having separate ALJs assess the same patents presents substantial risk of inconsistent initial determinations being presented to the Commission for review.”); Ex. 2, HTC Br. at 7 (noting that “legal arguments as to claim construction are likely to be similar in both Investigations”).

⁹ HTC’s argument that the 166 and 167 Cases should be transferred lacks any merit, in part because a transfer would prevent these four cases from being heard before a single judge. *See* FED. R. CIV. P. 42 (only permitting consolidation of “actions before the court”); *Swindell-Dressler Corp. v. Dumbaule*, 308 F.2d 267, 273 (3d Cir. 1962) (“a cause of action pending in one jurisdiction cannot be consolidated with a cause of action pending in another jurisdiction”). As a result, HTC’s motion seeks to *prevent*—rather than promote—all of the economies and conveniences that would be achieved via consolidation. *See, e.g., In re Volkswagen of Am., Inc.*, 566 F.3d 1349, 1351 (Fed. Cir. 2009) (denying request to vacate district court’s denial of motion

parties have yet to devote significant resources to these cases, and consolidation would not pose any possibility of prejudicial delay in any of the cases.¹⁰

Indeed, Nokia and HTC cannot credibly argue that they will face any prejudice from consolidating these cases, as they both vigorously—and successfully—argued for consolidation of the parallel cases at the ITC. Nokia and HTC both made clear that prejudice was not an issue when they asserted that even “partial consolidation . . . for the purposes of overlapping patents . . . is still preferable to the status quo” (Ex. 5, Nokia Resp. to ITC Staff Mot. at 4) and that “[p]utting the identical patents in the Investigations . . . before the same ALJ from the start resolves the difficult issues inherent in having the Investigations proceed separately” (Ex. 6, HTC ITC Rep. Br. at 5). It would be disingenuous for either of them to argue that Apple’s request for consolidation of these related cases poses any prejudice to them now.

V. CONCLUSION

For the foregoing reasons, given the overwhelming commonality of issues of law and fact among these four patent cases and the significant economies and conveniences that would result from consolidating them, Apple respectfully requests that this Court grant its Motion to Consolidate the Captioned Cases for the Purpose of Coordinating Pretrial Proceedings.

to transfer, where related patent cases were pending in the same court, and noting that “the existence of multiple lawsuits involving the same issues is a paramount consideration.”).

¹⁰ Although the 791 Case has begun to move forward, courts have granted motions for consolidation of cases that are much further apart in their progress than the non-stayed cases here. *See e.g., Fields v. Provident Life & Acc. Ins. Co.*, No. CIV.A. 99-CV-4261, 2001 WL 818353 (E.D. Pa. Jul. 10, 2001), at *6 (ordering consolidation even though one action was ready for trial, while the other was still only in its preliminary stages, because “the discovery and trial preparation necessary for the [second case] will overlap significantly with the work already completed” and “[t]he efficiency achieved by consolidation will far outweigh any inconvenience that may result therefrom”); *Monzo v. American Airlines, Inc.*, 94 F.R.D. 672, 673 (D.C.N.Y. 1982) (“The fact that the cases are at different discovery stages is not fatal to the consolidation motion.”).

Dated: May 24, 2010

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EXHIBIT D

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

Before the Honorable Charles E. Bullock
Administrative Law Judge

In the Matter of

**CERTAIN MOBILE
COMMUNICATIONS AND
COMPUTER DEVICES AND
COMPONENTS THEREOF**

Inv. No. 337-TA-704

Before the Honorable Carl C. Charneksi
Administrative Law Judge

In the Matter of

**CERTAIN PERSONAL DATA AND
MOBILE COMMUNICATIONS
DEVICES AND RELATED
SOFTWARE**

Inv. No. 337-TA-710

**CORRECTED COMPLAINANTS APPLE INC. AND NEXT SOFTWARE INC.'S
COMBINED OPPOSITION TO THE STAFF'S, NOKIA'S AND HTC'S MOTIONS FOR
CONSOLIDATION**

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I. INTRODUCTION

Complainants Apple Inc. and Next Software Inc. (collectively, “Apple”) oppose (1) the Investigative Staff’s Motion for Partial Consolidation of Investigation Nos. 337-TA-704 and 337-TA-710 and (2) Respondents Nokia and HTC’s Motions for Full Consolidation of Investigation Nos. 337-TA-704 and 337-TA-710. The Staff and Respondents Nokia and HTC seek unprecedented relief and propose conflicting forms of consolidation that will radically complicate and delay the investigations ordered by the Commission. Apple commenced these investigations against two separate infringers that sell completely different infringing products based on different software platforms. Consolidation will lead to an unmanageable investigation structure and prevent the Commission from meeting its statutory mandate to complete the investigations “at the earliest practicable time.” In short, the consolidation “solutions” proposed by the Staff and Respondents would create more problems than they allegedly solve.

The Staff and Respondents rely on Commission Rule 201.7(a) for authority to consolidate Section 337 investigations, but ignore that this Rule permits consolidation only “in order to *expedite* the performance of [the Commission’s] functions.” It is undisputed that the consolidation options presented by the Staff and Respondents will not expedite these investigations. Nokia and HTC pay lip service to the requirements of efficiency and expediency – contending a fully consolidated case can be completed “without unreasonable delays” – but the facts reveal a more tactical motive.¹ The 704 investigation is scheduled for a hearing beginning October 4, 2010 with a 16-month target date in June 2011, while Judge Charneski just recently set a schedule for the 710 investigation with a March hearing date and a target date in October

¹ Apple recognizes that the Staff does not have any such motive.

2011.² But the consolidation proposed by Respondents, unsurprisingly, will move the date back for both. Consolidating some or all of patent assertions against Nokia into the 710 investigation would extend Nokia's target date by at least four months. And HTC and Nokia would no doubt seek, and the Staff has already indicated its support for, an even longer schedule of a consolidated action, potentially granting Nokia (and HTC) an even greater windfall. There is thus no question that Respondents are attempting to use consolidation to engineer delay, in contravention of Commission Rules.

Although the delay resulting from consolidation would severely prejudice Apple, that is not the only prejudice Apple will suffer. Either full or partial consolidation will result in an unworkably complex investigation with different products based on different software platforms, and witnesses from Respondents from different foreign countries speaking different languages requiring interpretation. The complexity multiplies when one considers that Nokia's accused products are based on at least three different operating systems and HTC's products implicate the Android operating system developed by Google and the Open Handset Alliance.

Respondents and the Staff vaguely point to efficiencies that would allegedly result from consolidation. But the efficiencies of consolidation, even ignoring the inefficiencies of the non-overlapping patents, are grossly overstated. Neither the Staff nor the Respondents have suggested that there are common issues of fact on infringement – there are not. The differences in the products make it likely that Nokia and HTC will advance different non-infringement arguments. Infringement is a fact-intensive analysis and it would not be inconsistent for one set of accused products to infringe and another to not infringe. Likewise, different decisions on invalidity and unenforceability would likely reflect only that respondents often advance or

² This 18 month target is an Initial Determination subject to possible review by the Commission. *See* 19 C.F.R. § 210.51(a).

emphasize different invalidity defenses because they are driven to do so by different positions on infringement. In any event, to the extent efficiencies in discovery can be achieved it should be through coordination among the Staff and private parties, not a cumbersome and prejudicial consolidation. For example, there is no reason why depositions of common inventors from overlapping patents cannot be scheduled in a coordinated fashion without combining otherwise wholly disparate cases. And if HTC feels the need to participate in *Markman* or other proceedings in the 704 investigation to have its views considered on the overlapping patents, Apple will not object.

Perhaps most telling of the perils of consolidation is that the Staff and Respondents cannot even agree on the form of consolidation. On the one hand, Respondents complain that the Staff's partial consolidation proposal would result in an unworkable piecemeal approach to at least one investigation. On the other hand, the Staff rightfully notes that complete consolidation would create an unmanageable mega-investigation and render it nearly impossible to complete the combined investigation in a timely fashion. The admitted flaws in both proposals, pointed out by the parties that are conceptually in favor of consolidation, demonstrate that consolidation of any kind is simply not workable in this circumstance. The investigations are thus best left in the structure the Commission and Chief Judge Luckern put in place.

The International Trade Commission was chartered to protect intellectual property of companies like Apple by preventing the importation of infringing articles into the United States from abroad. When Congress granted the Commission investigative authority, it mandated that these important investigations be completed in the most expeditious manner possible. Apple's products, including those it relies on in these investigations to demonstrate a very significant domestic industry, have achieved acclaim, commercial success, and protection under the U.S.

Patent laws. Like any Complainant, Apple is entitled to an expeditious resolution of the 704 and 710 investigations. The consolidation proposals of the Staff and Respondents will deny Apple that right, and undermine the very tenets upon which the Commission is founded.

Accordingly, Apple respectfully requests denial of the Staff's and Respondents' motions and adherence to the investigation structure determined to be appropriate by the Commission and Chief Judge Luckern.

II. FACTUAL BACKGROUND

A. The Disputes Between Apple and Nokia

Apple and Nokia are involved in a number of lawsuits and investigations involving allegations of patent infringement. Nokia originally sued Apple for alleged infringement of seven patents in October 2009 in the United States District Court for the District of Delaware. Apple answered this complaint and asserted counterclaims of its own, alleging infringement of thirteen patents and also non-patent claims for antitrust violations and related causes of action. These disputes are pending before Chief Judge Sleet.

Nokia subsequently filed a complaint with the Commission, asserting that Apple infringes seven patents, which the Commission instituted as Investigation No. 337-TA-701 and Chief Judge Luckern assigned to Judge Gildea. Apple also filed its own complaint with the Commission, asserting that Nokia infringes nine patents. The Commission issued a Notice of Investigation with respect to Apple's complaint on February 22, 2010, and Chief Judge Luckern assigned Investigation No. 337-TA-704 to Judge Bullock.

The schedules in the various Apple-Nokia disputes in Delaware and the 701 and 704 investigations have been established and the matters are proceeding. In the 701 investigation, Judge Gildea originally set a target date in late May 2011, and has subsequently extended it to August 1, 2011 to allow for a *Markman* Hearing. Nokia is seeking reconsideration of Judge

Gildea's order modifying the schedule, claiming that it will be severely prejudiced by the two-month delay of the hearing and target dates. (Ex. 1, Nokia Motion for Reconsideration.) In the 704 investigation, Judge Bullock has ordered a 16 month target date with an evidentiary hearing currently set to begin on October 4, 2010.

B. The Disputes Between Apple and HTC

Apple filed its complaint with the Commission against HTC Corporation, HTC America, Inc., and Exedea, Inc. on March 2, 2010. On the same day, Apple filed two separate cases against HTC in Delaware. One of the Delaware cases is a mirror-image case asserting the 10 patents against HTC that are also asserted in the Commission complaint. The other case alleges infringement of 10 separate patents, for a total of 20 different patents asserted against HTC. The Commission issued its Notice of Investigation on March 30, 2010 and Chief Judge Luckern assigned Investigation No. 337-TA-710 to Judge Charneski. In the 710 investigation, Judge Charneski has issued an Initial Determination setting an 18 month target date with an evidentiary hearing in March 2011. The Staff and HTC had originally proposed that a 20 month target date would be necessary given the complexity of the investigation and the possibility of consolidation, foreshadowing that they may seek further delay if consolidation is ordered.³ (Ex. 2, Staff's Discovery Statement; Ex. 3, HTC's Discovery Statement.)

C. The 704 and 710 Investigations Are More Different Than Alike.

The 704 and 710 investigations relate to two different complaints filed by Apple against two unrelated companies. As shown above, these investigations are part of broader and unrelated disputes between Apple and Nokia and Apple and HTC. Nokia and HTC are in fact fierce competitors in the marketplace, and agree on little except that they want to achieve delay

³ The Staff's proposed schedule assumes that its proposed consolidation option – moving the five overlapping patents into the 710 investigation – would be adopted. It is unclear whether the Staff or the Respondents might seek an even longer target date than 20 months for a fully-consolidated investigation.

of the investigations of their products' infringement of Apple's patents. In the 701, 704 and 710 investigations there are seven, nine and ten patents asserted respectively. As indicated in the Staff's Motion, the 704 and 710 investigations assert five of the same patents, although different claims may be implicated. On the other hand, there are nine *non*-overlapping patents between the 704 and 710 investigations.

Nokia's accused products are based on three different software platforms – S40, Symbian, and Maemo – that have been developed by Nokia and/or Nokia with its partners. Most of the development work was done in, and thus the potential witnesses come from, Finland or from other European countries (*e.g.* Norway and the UK). Several other important witnesses are in India and elsewhere. The S40 and Symbian operating systems that Nokia installs on its infringing handsets are proprietary Nokia software about which Complainants must seek detailed discovery from Nokia and its legions of software architects and other technical witnesses. Nokia itself is a Finnish company that has no ties whatsoever to HTC and (on information and belief) has not shared its software or other technology with HTC.

HTC's accused products are based on a different software platform, called Android, and have a very different history. In stark contrast to Nokia's proprietary S40 and Symbian operating systems, Android is an open-source software platform that uses a modified version of the Linux kernel. Android was originally developed by Android, Inc. until that company was purchased by Google. Android is now developed by the Open Handset Alliance, a consortium of approximately sixty hardware, software, and technology companies. Notably, Nokia is *not* a member of the Open Handset Alliance, and instead directly competes with the Open Handset Alliance and its members. In addition to the discovery of HTC in Taiwan, HTC has already noted that “much of the technical information regarding the operation of the accused products

resides with third parties.” (Ex. 3, HTC Discovery Statement at 6.) Presumably Apple will be required to take extensive discovery from Google and other third parties, further separating the issues in the 710 investigation from issues in the 704 investigation.

Although some of Apple’s patents apply to both HTC and Nokia products, it cannot be disputed that Android is different from the S40, Symbian and Maemo implementations in Nokia’s accused products. And, given the speed with which the telecommunications market progresses, it is likely that additional Nokia and HTC products will come into the 704 and 710 investigations. Further, the software platforms themselves change – for example, it appears that Nokia is moving to new versions of Symbian and has recently made available its “Qt” cross-platform software development framework, which on information and belief may also be involved in infringing activity, and HTC has moved or is moving to new versions of Android software with possibly further evolution to come in the near future.

It is further beyond dispute that there will be significant amounts of distinct, non-overlapping evidence such as Finnish and Taiwanese testimony from product developers, source code for the accused products, third party testimony and documents from Nokia’s and HTC’s third party vendors, and financial/marketing evidence unique to Nokia and HTC for the remedy phases of the investigations. The investigations are just beginning, and additional differences between them will almost certainly be illuminated with further discovery.

Beyond their silence with the respect to the different product platforms, Respondents disingenuously minimize the important differences in the patents asserted in the respective cases and instead rely on sweeping generalizations about the claimed subject matter. For example, Respondents rely heavily on the fact that many (but not all) of the asserted patents relate to “object oriented software” in some way. This generic description of “object oriented software”

glosses over the differences among the patents that will require different sets of experts and witnesses for the sub-specialties within the technology. As Respondents know, the patents-at-issue in the two investigations involve diverse subjects such as the generation of graphics, camera power management, and booting operations.

III. ARGUMENT

Despite having the burden of justifying consolidation, the Staff and the Respondents both fail to provide any authority for reassigning an investigation in part or in whole from Judge Bullock to Judge Charneski. That is unsurprising as precedent suggests that such a reassignment is not permissible. For example, in *Certain NAND Flash Memory Devices and Products Containing the Same*, Inv. No. 337-TA-553, Order No. 3, 2005 WL 3549542 (Dec. 21, 2005), Judge Harris noted that “no Administrative Law Judge has ever issued a determination to reassign an investigation to another judge for the purpose of consolidation.” (*Id.* at 7.) Judge Harris emphasized that “the Commission has already instituted two distinct investigations, *and assigned them to different Administrative Law Judges.*” *Id.* at 8 (emphasis added). Here too the Staff’s and the Respondents’ invitation to reassign part or all of the 704 case from Judge Bullock to Judge Charneski should be rejected.

A. The Motions To Consolidate Threaten To Create An Unmanageable Investigation That Will Not Be Completed Within The Appropriate Time Limits.

Although the Staff and the Respondents propose different consolidation options, both of their proposals would result in an over-sized investigation that will not meet the statutory mandates and Commission Rules requiring investigations to be completed in an expedited manner. Commission Rule 201.7(a) provides the Commission authority to consolidate investigations only if it “will expedite the performance of [the Commission’s] functions”:

In order to expedite the performance of its functions, the Commission may engage in investigative activities preliminary to and in aid of any authorized investigation, consolidate proceedings before it, and determine the scope and manner of its proceedings.

19 C.F.R. § 201.7(a) (emphasis added). Consolidation leading to *delay*, as opposed to expediting the performance of Commission functions, is not permitted by Commission Rules. *See* 61 Fed. Reg. 43429, 43432 (Aug. 23, 1996) (“It is expected that the administrative law judge will abide by the intent of Congress and the Commission” in setting expedited target dates); *Certain Personal Watercraft and Components Thereof*, Inv. No. 337-TA-452, Order No. 5, 2001 WL 301292, at *1 (March 27, 2001) (“[T]he public interest favors an expeditious resolution of the investigation.”)

This Commission Rule emphasizing that consolidation should only be granted to “expedite” completion of investigations is consistent with the statutory framework upon which the Commission is founded. Prior to 1994, the Commission’s statutory mandate fixed a 12 month target date for most cases and an 18 month target date for “complicated” cases. 19 U.S.C. § 1337(b)(1) (1988) (amended by Pub. L. 103-465. §§ 261(d)(1)(B)(ii) and 321(a), 108 Stat. 4909 (Dec. 8, 1994). After the fixed time limits were determined to violate GATT principles, Congress amended the ITC’s statutory mandate to require that an investigation be completed “at the earliest practicable time.” 19 U.S.C. § 1337(b)(1). Despite no longer having a hard cap on target dates, Congress nevertheless made clear that it intended to maintain the Commission’s objective of expedited investigations:

Although the fixed deadlines for completion of section 337 investigations have been eliminated, the [Senate Finance] Committee expects that, given its experience in administering the law under the deadlines in current law, the ITC will nonetheless normally complete its investigations in approximately the same amount of time as is currently the practice.

See S. Rep. No. 103-412, at 119 (Nov. 22, 1994).

Consistent with the statutory mandate, Commission Rule 210.51(a) sets a presumptive ceiling on target dates of sixteen months. 19 C.F.R. § 210.51(a). Target dates longer than 16 months can be set by initial determination only and are subject to immediate interlocutory review. Indeed, the Commission has relied upon the preceding Senate Report in vacating ALJ decisions that unreasonably extend target dates, reasoning that “section 337 investigations [should] be conducted as expeditiously as possible and that *extension of targets beyond 15 months is the exception, not the rule.*” See *Certain Organizer Racks and Products Containing the Same and Certain Sortation Systems, Parts Thereof, And Products Containing the Same*, Inv. Nos. 337-TA-460 and 466, at 2 (Feb. 8, 2002) (emphasis added).

It is undeniable that the consolidation proposals of the Staff and the Respondents would frustrate completion of the 704 and 710 investigations “at the earliest practicable time.” HTC and Nokia should not be permitted to use their infringement of some of the same patents as an invitation to extend these two investigations and meld them into one delayed, mixed investigation involving disparate companies and products. Although careful in their briefs not to discuss the impact that consolidation would have on the schedule of a consolidated case, the Staff and HTC have already acknowledged the delay inherent in their proposal. Given the different schedules that have been adopted, consolidating the 704 investigation with the 710 investigation would delay the investigation of Nokia’s infringement a minimum of 4 months. Because Nokia already has agreed to a case schedule with a 16-month target date for the 704 investigation, it cannot seriously argue that the 704 investigation will be completed “at the earliest practicable time” if even partially consolidated with the 710 investigation.

Even worse, Nokia and HTC wholly fail to specify how much additional time will be necessary to account for their proposed mega-consolidation. They acknowledge that there will

be delay, but contend that any delay will not be “unreasonable.” (*See, e.g.*, Nokia Br. at 12.) But we already know Respondents will seek an unreasonably long target date for a consolidated investigation – they already have. Based on the Staff’s proposed 20 month target date for a ten patent case with five overlapping patents, one can only assume that Nokia and HTC might later argue that a fully consolidated investigation will require an even later (and more unreasonable) target date.

B. The Prejudice To Apple Outweighs Any Benefits of Consolidation.

Apple has invested significant time and money in its patents and commercial products. Apple suffers a continuing and irreparable injury every day that infringing goods are imported by Nokia and HTC. Nokia’s tactically-driven request for a consolidation is clear given the position it has taken in the investigation where it is the Complainant. Specifically, in the 701 investigation, Nokia has vigorously protested Judge Gildea’s proposal to extend the target date by *two months* to allow time for a *Markman* Hearing, arguing that *any* delay prejudices Nokia:

Apple is currently getting a “free-ride” on the billions of dollars that Nokia has invested in research and development to provide the public with the mobile phones it enjoys today. Every day that Apple is allowed to continue its infringing activities is severely prejudicial to Nokia, and Nokia is entitled to an expeditious adjudication.

(Ex. 1, Nokia Motion for Reconsideration at 2.) Nokia cannot credibly argue that a two month extension for Judge Gildea to perform a *Markman* hearing is an impermissible and prejudicial “free-ride” for Apple while also arguing that a far longer extension resulting from an unprecedented consolidation and reassignment to another Judge is not far more prejudicial to Apple.

On the other hand, contrary to Nokia’s and HTC’s arguments, HTC’s alleged prejudice can be minimized or avoided altogether. HTC essentially complains that absent consolidation it will not be able to meaningfully participate in events like inventor depositions in the first

instance, giving Apple a “trial run” at the case. HTC is simply wrong. Close coordination between the Staff, Apple, and Respondents, which is well established in Commission investigations, can avoid and/or cure the majority of HTC’s alleged prejudice. For example, in *Certain Programmable Logic Devices and Products Containing Same*, Order No. 3, 2001 WL 396718 (April 17, 2001), Hynix moved to have its investigation against Toshiba consolidated with an earlier filed Toshiba investigation against Hynix. Despite the fact that there were some similarities between the accused products, Judge Harris denied consolidation. Nevertheless, recognizing that there would be, for example, depositions common to both investigations, Judge Harris directed the Staff and the private parties to coordinate discovery subject to his supervision:

[M]ost of the benefits that [the moving party] seeks by consolidation can be met by other means... There are economies that can be achieved from close coordination of the two cases, as the parties and the Staff have already acknowledged in their briefs.

Id. at *8.⁴ Further, in *Certain Liquid Crystal Display Devices*, Judge Luckern denied a request to consolidate competing investigations instituted by Samsung and Sharp despite the fact that there would be overlapping discovery. *Certain Liquid Crystal Display Devices and Products Containing Same*, Inv. No. 337-TA-631, Order No. 7, 2008 WL 3175268 (May 30, 2008). Instead, Judge Luckern opined that “the possibility of duplicate document production or the possibility of witnesses having to appear for multiple depositions” could be avoided through coordination between the Staff and the private parties. *Id.* at 6 & n.1.

⁴ Similarly, in *Certain NAND Flash Memory Device*, Judge Harris also denied consolidation, reasoning that coordination of discovery would achieve the same benefits as consolidation. *Certain NAND Flash Memory Device*, Order No. 3, at 10, 2005 WL 3549542 (“While the Administrative Law Judge does not find a sufficient basis for determining that ... the investigations should be consolidated, the Administrative Law Judge concurs that there may be opportunities for cooperation and coordination during the discovery phase of the pending investigations.”)

The Staff and the private parties can coordinate in the 704 and 710 investigations to avoid duplication wherever possible. Apple has every desire to handle discovery in the investigations efficiently, and commits to work with the Staff, Nokia or HTC to achieve efficiencies.

Further, HTC and Nokia are wrong that *Certain 3G Mobile Handsets and Components*, Inv. No. 337-TA-613, Order No. 5 (October 24, 2007),⁵ dictates consolidation in this instance. In *3G Handsets*, Administrative Judge Luckern was assigned to both investigations, and therefore the later-sued respondent had a concern about presenting its arguments to Judge Luckern on legal issues such as claim construction in the first instance. *Id.* at 11. Here, the 704 and 710 investigations have different Judges, both of whom will do their job of independently analyzing the facts and law when presented with party arguments. Apple does not agree with HTC's purported concern that Judge Charneski will have "difficulty ... not favorably considering a colleagues' earlier determination". Judges all the time have to deal with issues that may have been ruled on, in one form or another, by another judge.

Moreover, HTC has presented no basis supporting its contention that the issues before the two Judges will necessarily be identical. What will drive the respondents' defenses will be the products at issue, not just the patents. It often is the case that different claim terms are disputed,

⁵ Rather than supporting consolidation here, the 601/613 consolidation presents a cautionary tale arguing against consolidation. In Order No. 5 from Investigation 337-TA-601 and the simultaneously issued Order No. 12 from Investigation 337-TA-613, Judge Luckern consolidated these investigations and set target date of 14 months for Inv. 337-TA-613 and 18 ½ months for Inv. 337-TA-601. Shortly after obtaining consolidation, the respondents in the 613 investigation (ironically including Nokia), moved to terminate or stay the consolidated investigation based on an arbitration defense. *See* 337-TA-613, Order No. 33 at 4 (May 22, 2008). Although that motion was denied, Judge Luckern subsequently found it necessary to suspend the scheduled hearing for the consolidated investigation because of an injunction obtained by Nokia in District Court. *See id.* at 5-6 (citing 337-TA-613 Order No. 31 (April 14, 2008)). Finding "no reason ... to further delay the investigation against Samsung [the respondent in the 601 investigation]", the ALJ proceeded to de-consolidate the investigations. *See id.* at 10. Nevertheless, as a result of the delays arising from the suspension of the consolidated hearing, the target date in the 601 investigation was extended to 23 months. *See* 337-TA-601, Order No.14 (May 22, 2008). The target date for the 613 investigation was extended to 27 months. *See* 337-TA-613, Order No. 38 (Oct. 10, 2008). The course of events in the 601/613 investigations illuminate that the "alleged efficiencies" of consolidation are very difficult to predict. *See* 337-TA-601, Order No. 14 at 1.

the constructions of terms differ and different defenses are advanced based on the products at issue. One construction might benefit Nokia but not HTC or vice-versa. One party might favor non-infringement, the other invalidity. The analysis here is far more complex than a declaration that these investigations have overlapping patents.

Despite relying on *3G Handsets*, Nokia and HTC already have shown that they are prepared to coordinate across the two investigations as necessary. Indeed, in moving for full consolidation, Nokia and HTC have not only taken the same position but they filed near verbatim briefs in support of their position. Thus, even if issues common to both investigations are briefed to Judge Bullock in the first instance, HTC has shown that it will be able to provide its input to Nokia. And if HTC desires to participate in *Markman* or other proceedings in the 704 investigation to ensure that its views will be heard by Judge Bullock, Apple will not object.

In short, all of the problems that consolidation allegedly solves can be addressed through coordination, thereby avoiding the drastic consequences of consolidation. The prejudice to Apple resulting from consolidation thus outweighs any alleged prejudice to the Staff or Respondents on the current structure and dictates that consolidation should be denied.

C. The Overlap Between The Factual And Legal Issues Is Not Significant Enough To Justify Consolidation.

The moving parties fail to account for the complexity of a 14 patent case against disparate sets of accused products developed and sold by different foreign companies. In fact, in submissions to Judge Gildea, Nokia has emphasized the “complexity” of the patents asserted by Apple in the 704 investigation, arguing that “most would need extensive education to understand [them.]” (Ex. 1, Nokia Motion for Reconsideration at 4.) HTC similarly has noted that “[t]he complexity of the technology and products-in-issue will require extensive technical discovery,

including extensive third party discovery, and extensive expert analysis.” (Ex. 3, HTC Discovery Statement at 6).

Ignoring these prior representations, Nokia and HTC now attempt to brush over the complexities and admitted differences between the accused products. But the fact is that analysis of those accused products with respect to the “complex” patents-at-issue will require intensive analysis of the software and hardware of the accused products. As noted above, the accused Nokia products are based on at least three different software platforms – S40, Symbian, and Maemo – with additional complications introduced across different phones based on these platforms (including those having an additional software download known as “Qt”). The accused HTC products are based on the Android software platform, introducing the complication of the Android platform, developed by Google and now the Open Handset Alliance.

The potential for confusion at the hearing is yet another reason to reject the consolidation proposals. *See Certain Liquid Crystal Display Devices and Products Containing Same*, Inv. No. 337-TA-631, Order No., 7 2008 WL 3175268 (May 30, 2008), at 4 (“The administrative law judge finds that the various postures of the parties and their relationships could lead to confusion during an evidentiary hearing”); *Certain NAND Flash Memory Devices*, Inv. No. 337-TA-553, Order No. 3, at 8 (“The various postures of the parties and their relationships to the patents and the goods at issue could lead to confusion during the hearing or remedy phase.”). Here, the hearing will inevitably be highly confusing with either partial or full consolidation. Even under the Staff’s partial consolidation proposal, there will be five patents in the partially combined proceeding that are only asserted against HTC. These five patents will at least require fact and expert testimony pertaining to infringement and validity issues -- all of which will be completely irrelevant to Nokia during the evidentiary hearing. The Staff fails to suggest how to avoid the

inevitable confusion that will result where Nokia has no interest for significant portions of the hearing. And as is consistently the case, the Respondents' 14 patent proposal just makes matters worse -- adding another four patents that are asserted against Nokia only and are not implicated in the investigation of HTC. The logical result is to keep these separate investigations separate and not introduce more confusion into investigations that are already complex.

Even if there were complete overlap in the asserted patents and the technology was not complex, consolidated investigations would still result in an unworkable hearing. When considering a request for consolidation, "considerations of convenience and economy must yield to a paramount concern for a fair and impartial trial." *See Certain Liquid Crystal Display Devices and Products Containing the Same*, Inv. No. 337-TA-631, Order No. 7, at 2. . The reality is that the evidentiary hearing will involve witnesses from Finland, Taiwan and potentially other countries. Many of these witnesses may require translators. Hearing the foreign language testimony from one party regarding its implementation of complex technology will be complicated enough. Where the Commission has left the investigations as separate, there is no need to cause further complication by introducing another language at the hearing.⁶ *Cf. Certain Sucralose, Sweeteners Containing Sucralose, and Related Intermediate Compounds Thereof*, Inv. No. 337-TA-604, Order No. 39, 2008 WL 164311 (Jan. 14, 2008) (noting the difficulties associated with witness statements for foreign language witnesses).

IV. CONCLUSION

For reasons discussed above, consolidation in whole or in part should be denied. Most (if not all) of the benefits of consolidation can be achieved through coordination without the

⁶ Finally, Nokia and HTC exaggerate the alleged efficiencies the Commission will enjoy if it only needs to review a single Initial Determination. First, the evidence and argument for the non-overlapping patents should be no different regardless of whether the investigations are consolidated or not. Second, the Commission will need to review different evidence pertaining to infringement of unrelated products whether presented in one Initial Determination or two.

problems resulting from formal consolidation. Full consolidation into a mega-investigation would result in intolerable delay, severe confusion and prejudice. While slightly better than the Respondents' proposed mega-case, the Staff's proposal of partial consolidation would still be unworkable and result in confusion and prejudicial delay. Accordingly, Apple respectfully requests denial of the Respondents' and Staff's motions for consolidation, and for the cases to proceed in their present posture.

Dated: April 22, 2010

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I, Marc Sernel, HEREBY CERTIFY that on this 22nd day of April 2010, I caused a true and correct copy of the foregoing CORRECTED APPLE INC. AND NEXT SOFTWARE INC.'S COMBINED OPPOSITION TO THE STAFF'S, NOKIA'S AND HTC'S MOTION FOR CONSOLIDATION to be served upon the following Persons:

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Secretary
U.S. International Trade Commission
500 E Street, S.W., Room 112A
Washington, D.C. 20436

(via EDIS)

The Honorable Charles E. Bullock-
Administrative Law Judge 337-704
Administrative Law Judge
U.S. International Trade Commission
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(via hand delivery on 4/22/2010)

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EXHIBIT E

Libre Software People's Front

don't confuse it with People's Front of Open Source

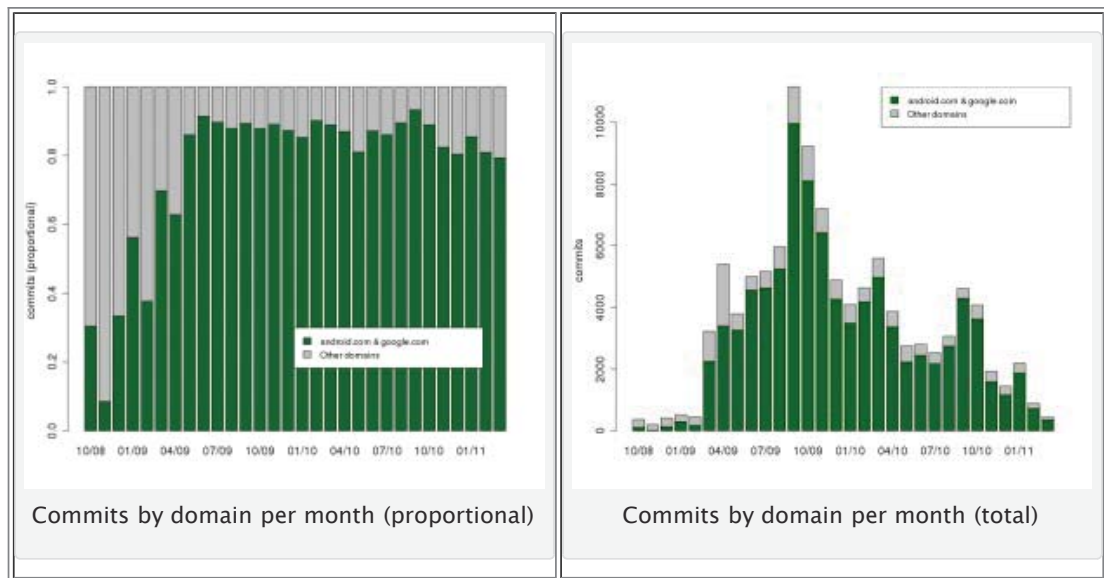
Study of the Android development activity and its authors

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Libre software is changing the way applications are built by companies, while the traditional software development model does not pay attention to external contributions, libre software products developed by companies benefit from them. These external contributions are promoted creating communities around the project and will help the company to create a superior product with a lower cost than possible for traditional competitors. The company in exchange offers the product free to use under a libre software license.

Android is one of these products, it was created by Google a couple of years ago and it follows a single vendor strategy. [As Dirk Riehle introduced](#) some time ago it is a kind of an economic paradox that a company can earn money making its product available for free as open source. But companies are not NGOs, they don't give away money without expecting something in return, so where is the trick?

As a libre software project Android did not start from scratch, it uses software that would be unavailable for non-libre projects. Besides that, it has a community of external stakeholders that improve and test the latest version published, help to create new features and fix errors. It is true that Android is not a project driven by a community but driven by a single vendor, and Google does it in a very restricted way. For instance external developers have to sign a *Grant of Copyright License* and *they do not even have a roadmap*, Google publish the code after every release so *there are big intervals of time where external developers do not have access to the latest code*. Even with these barriers there are a significant part of the code that is being provided from external people, it is done directly for the project or reused from common dependencies (GIT provides ways to reuse changes done to remote repositories).



The figures above reflect the monthly number of commits done by people split up in two, in green colour commits from mail domains google.com or android.com, the study assumes that these persons are Google employees. On the other hand in grey colour the rest of commits done by other mail domains, these ones belong to different companies or volunteers.

According to the first figure (on the left), which shows the proportion of commits, during the first months that were very active (March and April 2009) the number of commits from external contributors was similar to the commits done by Google staff. The number of external commits is also big in October 2009, when total amount of commits reached its maximum. Since April 2009 the monthly activity of the external contributors seems to be between 10% and 15%.

The figure on the left provides an interesting view of the total activity per month, two very interesting facts here: the highest peak of development was reached during late 2009 (more than 8K commits per month



Hi folks, my name is Luis Cañas Díaz and I've been working with libre software since 2003. During these years I've worked as developer with LAMP platforms, system administrator and lately as researcher in the LibreSoft group.

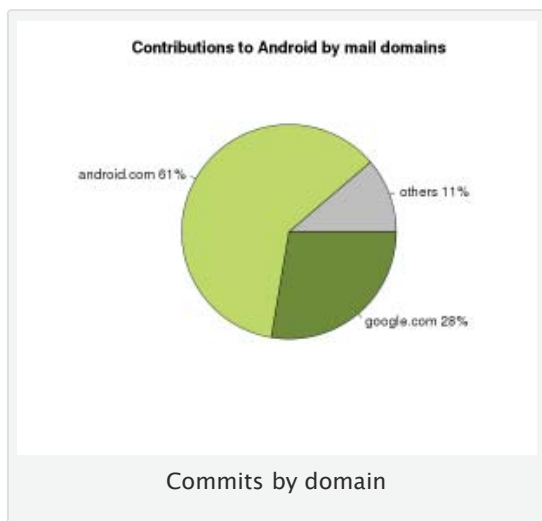
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during two months). The second is the activity during the last months, as it was mentioned before the Google staff work in private repositories so until they publish the next version of Android, we won't see another peak of development (take into account that commits in GIT will modify the history when the code is published, thus the last months in the timeline will be overwritten during the next release)



More than 10% of the commits used by Google in Android were committed using mail domains different to google.com or android.com. At this point the question is: *who did it?*

(Since October 2008)

# Commits	Domain
69297	google.com
22786	android.com
8815	(NULL)
1000	gmail.com
762	nokia.com
576	motorola.com
485	myriadgroup.com
470	sekiwake.mtv.corp.google.com
422	holtmann.org
335	src.gnome.org
298	openbossa.org
243	sonyericsson.com
152	intel.com

Having a look at the name of the domains, it is very surprising that Nokia is one of the most active contributors. This is a real paradox, the company that [states that Android is its main competition](#) helps it!. One of the effects of using libre software licenses for your work is that even your competition can use your code, currently there are Nokia commits in the following repositories:

- git://android.git.kernel.org/platform/external/dbus
- git://android.git.kernel.org/platform/external/bluetooth/bluez

This study is a ongoing process that should become a scientific paper, if you have feedback please let me know.

CVSAnalY was used to get data from [171 GIT repositories](#) (the Linux kernel was not included). Our tool allow us to store the metadata of all the repositories in one SQL database, which helped a lot. The study assumes that people working for Google use a domain `@google.com` or `@android.com`.

References:

- <http://dirkriehle.com/publications/2009/the-commercial-open-source-business-model/>
- <http://source.android.com/source/downloading.html>

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[SanACL said on twitter:](#)

Teo Romera about Igalia and the FLOSS mobile products and communities
url.ca/9ggsq 6 hours ago

Now it is possible to get the issues from a Github project using Bicho. Check out the code at url.ca/9g79w
[#libresoft](#) 3 days ago

Linux Tag, another Europe's leading Open Source event where most of the talks are not in English. [#fail](#)
[2 weeks ago](#)

At 2pm I'm presenting an evaluation we performed to identify the reused code between two 2 FLOSS projects using FLOSS tools in [#linuxtag](#)
[2 weeks ago](#)

In a few hours I'm attending Linux Tag. I'm presenting an analysis we made to identify reused code between projects. See you there! [2 weeks ago](#)

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About my dear
Bridgekeeper

Bridgekeeper: Stop. Who would cross the Bridge of Death must answer me these questions three, ere the other side he see.

What... is your name?

What... is your quest?

What... is your favourite colour?



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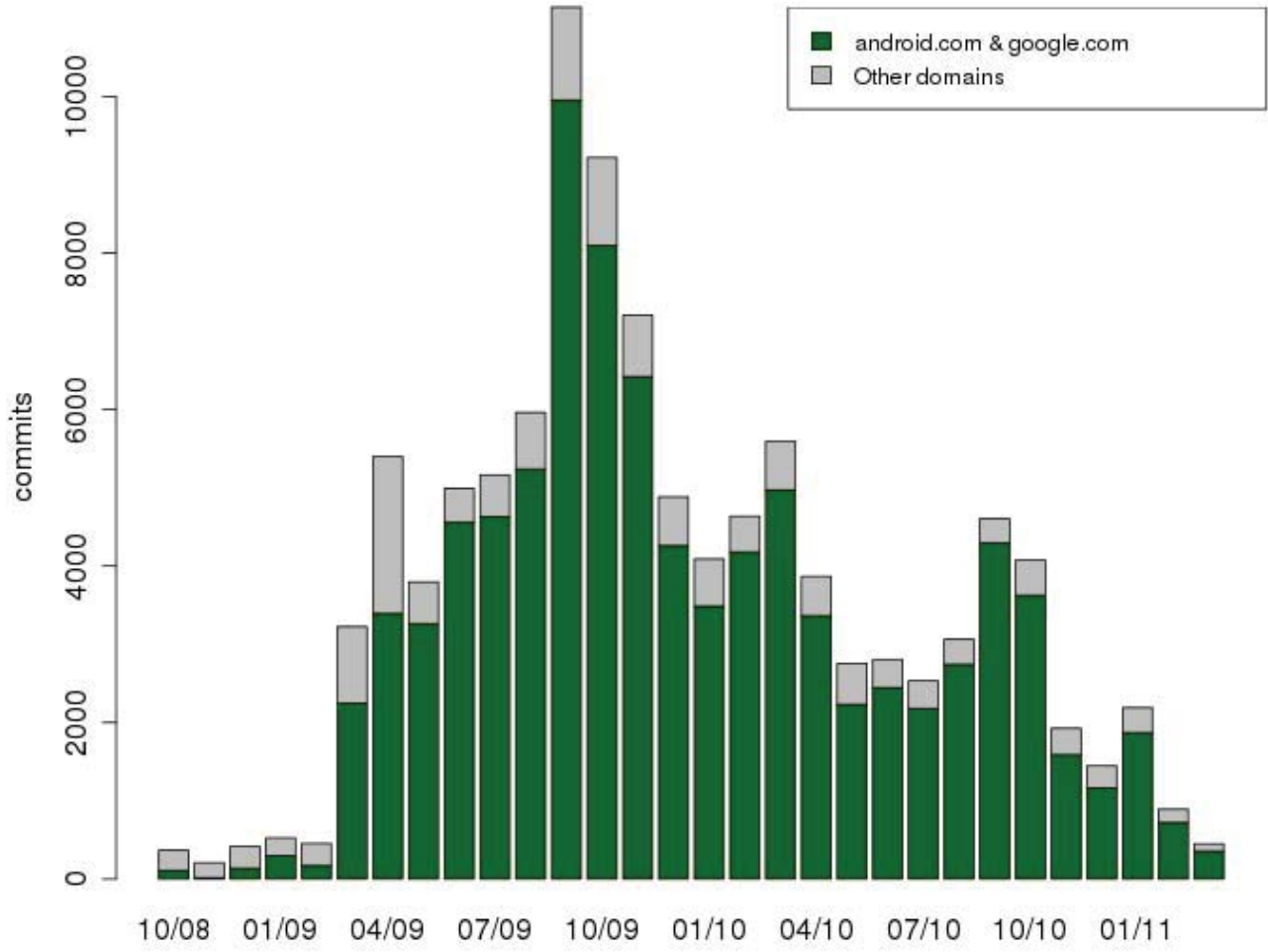
Written by [sanacl](#)
April 16, 2011 at 5:29 pm

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Contributions to Android by mail domains

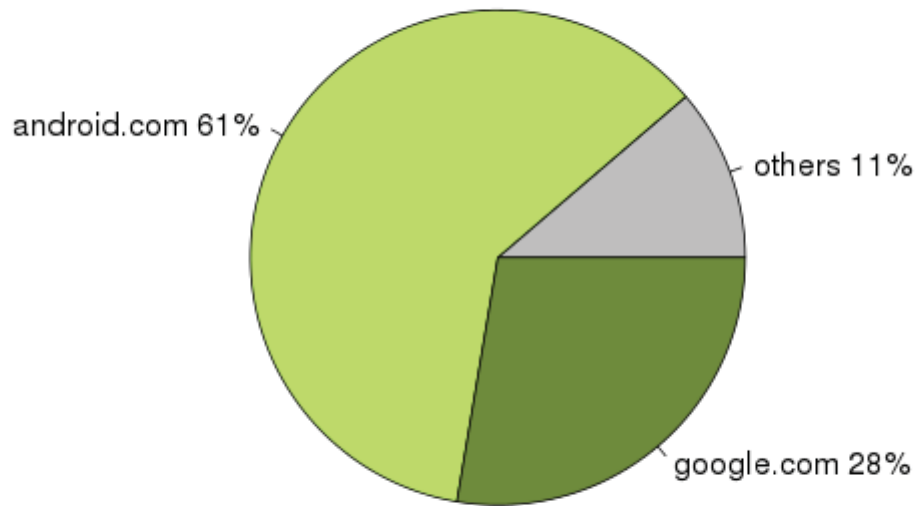


EXHIBIT F

projects / platform/external/bluetooth/blueti.git / commit



[summary](#) | [shortlog](#) | [log](#) | [commit](#) | [commitdiff](#) | [tree](#)
(initial)

[?](#) search: re

Initial empty repository [master](#) [p-master](#)

```
author    James W. Mills <jameswmills@ti.com>
          Mon, 12 Mar 2012 20:57:10 +0000 (15:57 -0500)
committer Gerrit Code Review <gerrit2@git.omapzoom.org>
          Mon, 12 Mar 2012 20:57:10 +0000 (15:57 -0500)
commit    bc10bbdfa77e43f29c2368eb8ac6fe3e73bd7f81
tree      4b825dc642cb6eb9a060e54bf8d69288fbee4904 tree
```

Initial empty repository

[Atom](#) [RSS](#)

EXHIBIT G

projects / platform/external/chromium.git / commit



[summary](#) | [shortlog](#) | [log](#) | [commit](#) | [commitdiff](#) | [tree](#)
(merge: [efe273f](#) [088da08](#))

[?](#) search: re

Merge "Defer closing idle sockets." into ics-mr1

```
author      Selim Gurun <sgurun@google.com>
            Thu, 17 Nov 2011 19:31:21 +0000 (11:31 -0800)
committer   Android (Google) Code Review <android-gerrit@google.com>
            Thu, 17 Nov 2011 19:31:21 +0000 (11:31 -0800)
commit      39ad9f5657323d3852f6741c79b830019baba4a8
tree        fdeade2e4fc5d5223dd83121241dc9d248cf5d6f
parent      efe273f2861c2ea723aa1f9edd20a73356da2b6b
parent      088da08b1e594e2e3cae7114394145e8268ab6c9
```

[tree](#)
[commit](#) | [diff](#)
[commit](#) | [diff](#)

Merge "Defer closing idle sockets." into ics-mr1

Mirror of chromium.git



EXHIBIT H

[projects](#) / [platform/external/chromium.git](#) / **commit**



[summary](#) | [shortlog](#) | [log](#) | [commit](#) | [commitdiff](#) | [tree](#) re
 (parent: [93bed14](#))

Part of fix for bug 5523834, backporting cache fixes

```
author      Kristian Monsen <kristianm@google.com>
            Tue, 1 Nov 2011 14:56:51 +0000 (14:56 +0000)
committer   Kristian Monsen <kristianm@google.com>
            Tue, 15 Nov 2011 21:51:33 +0000 (21:51 +0000)
commit      1ab02c36bee95e85558f6815b2836e9ee6a26b19
tree        d0cb945cc7a86deeb1c48449e0cbc6fc7bec1d6b tree
parent      93bed14e13dd5a6dd3d68bcf6d3c7c1f691f669b commit | diff
```

Part of fix for bug 5523834, backporting cache fixes

This is hopefully a fix for bug 5255299

Cherry-picking CL

<http://src.chromium.org/viewvc/chrome?view=rev&revision=93059>

Change-Id: [I2295cb29dc4ac1f97ceb492ea77a205a2b5c7a05](#)

```
net/disk_cache/backend_impl.cc diff | blob | history
net/disk_cache/entry_impl.cc diff | blob | history
net/disk_cache/entry_impl.h diff | blob | history
net/disk_cache/entry_unittest.cc diff | blob | history
```

Mirror of chromium.git

