

United States District Court
For the Northern District of California

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

APPLE INC.,)	Case No.: C 11-1846 LHK (PSG)
)	
Plaintiff,)	ORDER GRANTING-IN-PART
v.)	DEFENDANT’S MOTION TO
)	COMPEL
SAMSUNG ELECTRONICS CO., LTD, a)	
Korean corporation; SAMSUNG)	(Re: Docket No. 346)
ELECTRONICS AMERICA, INC., a New York)	
corporation; and SAMSUNG)	
TELECOMMUNICATIONS AMERICA, LLC,)	
a Delaware limited liability company,)	
Defendants.)	

Defendants Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, "Samsung") move to compel a complete response by Plaintiff Apple Inc. (“Apple”) to Samsung’s requests for production nos. 82, 83, and 86. Specifically, Samsung moves for production of: (1) the physical tablet computer mockup depicted in certain photographs produced to Samsung as part of the prosecution history file for Apple’s D504,889 patent (‘889 patent) application; (2) the originals of and digital files reproducing those photographs produced to Samsung as part of the same file, whichever are most legible; (3) the originals of and digital files reproducing photographs submitted by Apple to the

1 U.S. Patent and Trademark Office in the prosecution of the '889 patent; and (4) Apple's database
2 relating to its mockups, prototypes, and models for specified tablet computer projects.

3 Apple does not dispute that the materials sought by Samsung are within the scope of
4 allowable discovery under Fed. R. Civ. P. 26(b)(1). However, Apple represents that it has
5 undertaken more than reasonable efforts to search for and produce the responsive photographs and
6 mockups. Samsung disputes that Apple has produced the clearest available copies of the
7 photographs submitted to the PTO and questions Apple's lack of transparency in revealing the
8 parameters of its search.
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10 After the filing of Samsung's motion and the parties' appearance for hearing on November
11 1, 2011, Apple submitted a supplemental statement explaining its production to date. Apple states
12 that it has produced:

- 13 • over 40 physical objects and models, including one model recently verified to be the
14 mockup depicted in the photographs; and
- 15 • the best images that it has been able to locate after numerous searches of files and locations
16 in Apple's control, as well as in files and locations in the control of the Sterne Kessler and
17 Beyer law firms.

18 Apple declares that these searches "reflect all of the attorneys or individuals that were involved in
19 the prosecution of the D'889 patent or who had possession of the prosecution file." Apple further
20 states that it is willing to search other locations that Samsung's attorneys reasonably believe would
21 contain the images.


22 Based on Apple's representations, the court finds that Samsung's motion is largely moot.
23 Yet Samsung is correct that Apple's explanation of its search locations and parameters remains
24 insufficient to afford Samsung finality, or the opportunity to suggest additional locations that
25 might reasonably contain clearer versions of the images sought. Consistent with the court's
26 previous orders, the court finds that Apple must provide more transparency, and hereby orders as
27 follows:
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1. Apple shall stipulate that the specific model identified by Apple industrial designer Christopher Stringer during his November 4th deposition is the same model or mockup appearing in the photographs of the '889 patent prosecution history.
2. Apple shall stipulate that the photographs produced are the highest quality that it has found.
3. Apple shall identify specifically which custodians' files were searched, any search terms that were used, and the time frame included in those searches.

IT IS SO ORDERED.

Dated: November 16, 2011



PAUL S. GREWAL
United States Magistrate Judge

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For the Northern District of California