

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

In the Matter of

**CERTAIN MOBILE ELECTRONIC
DEVICES AND RADIO FREQUENCY
AND PROCESSING COMPONENTS
THEREOF (II)**

Inv. No. 337-TA-1093

ORDER NO. 15:

**GRANTING RESPONDENT APPLE, INC'S
MOTION TO COMPEL CHIP SCHEMATICS
AND SOURCE CODE [MOTION DOCKET
NO. 1093-011]**

(June 11, 2018)

On May 29, 2018, Respondent Apple, Inc. ("Apple") filed a motion ("Motion") together with a memorandum of support ("Memorandum") to compel Complainant Qualcomm Incorporated ("Qualcomm" and with Apple, "the Private Parties") to produce chip-level schematics and source code for: (1) its domestic industry products and first embodiments of its patents; and (2) domestic industry products related to U.S. Patent No. 8,063,674 ("the '674 patent") that Qualcomm withdrew from its domestic industry contentions on May 21, 2018. (Motion Docket No. 1093-011; Mot. at 1, 2.).¹ Also on May 21, 2018, Qualcomm produced to Apple sales data showing that these products were on sale before the effective filing date (and, limitedly before the alleged priority date) of the '674 patent. (*Id.* at 1.). Similarly, Qualcomm contends that it has not received all domestic industry related document pertaining to

¹ Apple certified pursuant to Ground Rule 2.2 that it conferred with Staff and Qualcomm at least two (2) days before filing its Motion but was unable to resolve the disputes. (Mot. at 2.). Apple reported that Qualcomm said it would oppose Apple's Motion while Staff said he would take a position on Apple's Motion after reviewing the papers. (*Id.*).

Qualcomm's asserted patent, U.S. Patent No. 7,693,002 ("the '002 patent"). (*Id.* at 1.). On June 8, Commission Investigative Staff ("Staff") filed its response ("Staff Response") in which it supports Apple's Motion. (Doc. ID No. 647279; Staff Resp. at 1.). On June 8, 2018, Qualcomm filed its opposition ("Opposition") to Apple's Motion. (Doc. ID No. 647331; Opp'n at 1.). Qualcomm says that it notified Apple on June 6, 2018 that Apple could inspect all of the documents it had requested that Qualcomm was able to find through a "reasonable search." (*Id.*) Qualcomm contends that Apple's Motion is moot and that Apple had agreed to withdraw it. (Opp'n at 1.).

Apple has not withdrawn its Motion.

While Qualcomm and Apple disagree with each other with respect to what each other did or did not produce and the characterizations of their discovery discussions and production, Staff notes that while Qualcomm agreed to produce the source code and schematics for certain "missing" items related to its domestic industry products by May 26, 2018, it did not do so. (Staff Resp. at 2.). According to Apple, when one of Apple's experts inspected Qualcomm documents on May 29, 2018, Qualcomm did not make available either source code or chip schematics for more than two (2) dozen domestic industry products related to the '002 patent. (Mot. at 4; Staff Resp. at 2.). Similarly, Apple and Staff report that also on May 29, 2018, Qualcomm did not make chip schematics or source code related to the withdrawn '674 patent's domestic industry products available to Apple's expert. (*Id.*) Moreover, even though on or about May 21, 2018 Qualcomm withdrew domestic industry claims with respect to the '674 patent, Staff contends that documents related to the '674 products are still relevant to this Investigation. (Staff Resp. at 2.). Staff has adopted Apple's argument that Apple should be able to investigate the withdrawn products for purposes of its prior art invalidity arguments, for its

inequitable conduct defense, and for the state of the art at the time of the 2007 patent priority date for the '674 patent. (Staff Resp. at 3; *see also* Mot. at 13.).

Having considered the voluminous materials that each of the Private Parties submitted in violation of the page limitations contained in the Ground Rules, it is evident that Apple is entitled to the information it seeks.² The Commission precedent generally follows Federal Rules of Civil Procedure and case law that any relevant information to a claim or defense is discoverable. (*Accord*, Staff Resp. at 2 (citing *Certain Integrated Circuits, Chipsets, & Prods. Containing Same Including Televisions, Media Players, & Cameras* (“*Integrated Circuits*”), Inv. No. 337-TA 709, Order No. 8, at 8 (June 18, 2010); *see also* Commission Rule 210. 27(b).). The scope of discovery in a Section 337 investigation is broad, “generally somewhat broader than the scope of the investigation itself.” (*See* Staff Resp. at 2 (citing *Integrated Circuits*; *see also* *Certain Elec. Imaging Devices* Inv. No. 337- TA-726, Order No. 12 at 2 (Dec. 22, 2010) (citing *Certain CCFL Inverter Circuits*, Inv. No. 337- TA-666, Order No. 16 at 8; *Certain Optical Disk Controller Chips and Chipsets, and Products Containing Same, Including DVD Players and PC Optical Storage Devices*, Inv. No. 337-TA-506, Order No. 32 at 3 (Dec. 22, 2004); *Certain Anti-Theft Deactivatable Resonant Tags and Components Thereof*, Inv. No. 337-TA-347, Order No. 7 (May 13, 1993) and Order No. 14 (May 28, 1993).).

In this instance, the information Apple seeks is relevant to its defenses, including information related to the '674 patent's domestic industry products that Qualcomm says it has withdrawn. Accordingly, Apple's Motion, Motion Docket 1093-011, is *granted* as follows:

- (1) Qualcomm must produce to Apple, or make available to Apple to inspect

² The Private Parties violated the Ground Rule page limitations both for their Motions and for their attached exhibit. If any party violates the page limitations for Motions that have not yet been filed, the Motions will be sent back for revision, or denied. Requests for Leave to file in excess of page limitations should be limited. Moreover, an Order will be filed on EDIS specifying limits on the numbers of motions *in-limine* and high priority objections each party may file, with page limits.

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and copy, the chip level schematics and source code for all domestic industry products upon which Qualcomm is relying for any aspect of its domestic industry case to the extent it has not done so. All such documents, including those for the '002 patent related products that were not made available to Apple when Apple's expert attempted to inspect on May 29, 2018, and that Qualcomm has not yet made available, should be made available to Apple within 10 days of the date of this Order. If Apple chooses to inspect and copy, it should so notify Qualcomm and then inspect and copy within 14 days of the date of this Order. Apple's experts and/or attorneys covered by the Protective Order may inspect if they choose to do so.

(2) Even though Qualcomm may no longer be relying upon certain domestic products related to the '674 patent, Apple is entitled to all documents pertaining to that patent, including chip-level schematics and source code for those products that Qualcomm has withdrawn, including but not limited to: RTR6236, RTR6237, RTR6280, RTR6285 and WCN1312. All such documents should be made available to Apple within 10 days of the date of this Order. If Apple chooses to inspect and copy, it should so notify Qualcomm and then inspect and copy within 14 days of the date of this Order. Apple's experts and/or attorneys covered by the Protective Order may inspect if they choose to do so.

(3) Categorically, Qualcomm may not rely upon any documents or arguments related thereto that it does not produce to Apple.

(4) The Parties should file jointly on EDIS within seven (7) days of the date of this Order a report whether this Order will affect the Procedural Schedule even if the Parties do not agree on the effects this delayed discovery will have on the Procedural Schedule. Additionally, Qualcomm should report whether it will have difficulty meeting the deadlines contained in this

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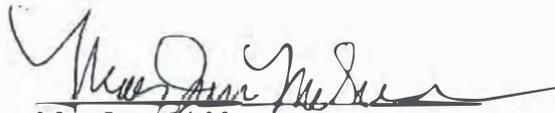
Order, and if it will, the additional amount of time it may need to produce documents covered by this Order.

Within seven (7) business days of the date of this document, each party shall submit to the Office of the Administrative Law Judges a statement as to whether or not³ it seeks to have any confidential portion of this document deleted from the public version.

Any party seeking redactions to the public version must submit to this Office two (2) copies of a proposed public version of this document pursuant to Ground Rule 1.10 with red brackets and the word REDACTED, which clearly indicates any portion asserted to contain confidential business information, and consistent with the Commission's recent regulation.

The Parties' submissions may be made by facsimile and/or hard copy by the aforementioned date. In addition, an electronic courtesy copy is required pursuant to Ground Rule 1.3.2. The Parties' submissions concerning the public version of this document need not be filed with the Commission Secretary.

SO ORDERED.


MaryJoan McNamara
Administrative Law Judge

³ This means that if the Parties do not seek to have any portion of this Order redacted, they are still required to submit a statement to that effect.

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PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **ORDER** has been served by hand upon the Commission Investigative Attorney, **Paul Gennari, Esq.** and the following parties as indicated, on **October 4, 2018**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

On Behalf of Complainants Qualcomm Incorporated:

S. Alex Lasher, II, Esq.
QUINNN EMANUEL URQUHART & SULLIVAN LLP
1300 I Street NW, Suite 900
Washington, DC 20005

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: _____

On Behalf of Respondents Apple Inc.:

Indranil Mukerji, Esq.
FISH & RICHARDSON PC
1000 Maine Ave. SW
Suite 1000
Washington, DC 20024

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: _____