

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

TOT POWER CONTROL, S.L.,)	
)	
Plaintiff,)	
)	
v.)	Civil Action No. 21-1302-MN
)	
APPLE INC.,)	
)	
Defendant.)	

MEMORANDUM ORDER

At Wilmington this **16th** day of **May, 2024**, the court having considered the parties' discovery dispute letter submissions and associated filings (D.I. 206; D.I. 207; D.I. 208; D.I. 209; D.I. 210; D.I. 211; D.I. 212; D.I. 213), and the parties' arguments during the hearing on May 15, 2024, IT IS ORDERED that Defendant's motion to compel is GRANTED-IN-PART and Plaintiff's motion to compel is GRANTED-IN-PART as follows:

DEFENDANT'S ISSUES

1. Defendant's motion to compel Plaintiff to produce a 30(b)(6) witness on Topics 1, 14, 34, 39, 48, 49, and 50 is DENIED without prejudice. The topics identified by Defendant are identical, or nearly identical, to 30(b)(6) topics served by LG Electronics, Inc. ("LG") in related Civil Action No. 21-1304-MN. (*Compare* D.I. 207, Ex. A *with* C.A. No. 21-1304-MN, D.I. 150, Ex. 11) Defendant and LG share legal counsel and have coordinated their discovery efforts across the related cases, including jointly deposing witnesses. Last month, LG raised challenges to several of the 30(b)(6) deposition topics and the court denied LG's request for relief on those issues in a Memorandum Order dated April 23, 2024. (C.A. No. 21-1304-MN, D.I. 158) The disposition on each topic raised in this matter is consistent with the court's prior ruling and is set forth in the chart below. In summary, Apple has not identified with specificity

the additional information being sought that was not already disclosed through interrogatory responses and/or deposition testimony, nor has it provided the scope or contours of what it intends to explore with an additional 30(b)(6) witness.

TOPIC	TOPIC NOS.	OUTCOME
Conception and reduction to practice	Topic 1 in 21-1304-MN	Plaintiff agreed to produce a witness on this topic but withdrew its agreement shortly before the deposition. LG did not challenge Plaintiff's failure to provide testimony on this topic in its discovery dispute.
	Topic 1 in 21-1302-MN	DENIED without prejudice. Conception and reduction to practice is a legal question, and contention deposition topics directed to a corporate designee are disfavored in this district. (D.I. 213, Exs. 3-7); <i>see</i> C.A. No. 21-1304-MN, D.I. 158 at ¶ 11. Plaintiff disclosed on March 20 that Medrano would be prepared to answer factual questions about invention, timing, etc. (D.I. 213, Ex. 9 at 1)
Financial interests in Plaintiff held by investors, shareholders, directors, officers, board members, executives, and employees	Topic 17 in 21-1304-MN	Plaintiff did not agree to designate a witness on this topic. LG did not challenge Plaintiff's failure to provide testimony on this topic in its discovery dispute.
	Topic 14 in 21-1302-MN	DENIED without prejudice. Plaintiff did not agree to designate a witness on this topic in responses served on February 26, 2024. (D.I. 207, Ex. A at 16-17) Apple has not included any evidence showing it challenged Plaintiff's original response to this topic or proposed a narrowed topic prior to the fact discovery cutoff on April 1, 2024. Apple already deposed potential trial witnesses and has not established the relevance of this topic to individuals who will not be testifying at trial.
Dates and circumstances of Plaintiff's first awareness of each accused product	Topic 38 in 21-1304-MN	Plaintiff agreed to produce a witness on this topic but withdrew its agreement shortly before the deposition. LG did not challenge Plaintiff's failure to provide testimony on this topic in its discovery dispute.
	Topic 34 in 21-1302-MN	DENIED without prejudice. Plaintiff disclosed on March 20 that Medrano would be prepared to answer factual questions about Plaintiff's first

		knowledge or awareness of the accused products. (D.I. 207, Ex. D at 5; D.I. 213, Ex. 9 at 2)
Communications re: asserted patents with any named inventors, prior assignee, or alleged infringers, and any actual or potential acquirers, investors and/or lenders	Topic 43 in 21-1304-MN	Plaintiff did not originally agree to produce a witness on this topic but produced a witness in response to LG's narrowing of the topic. (D.I. 213, Ex. 13)
	Topic 39 in 21-1302-MN	DENIED without prejudice. Plaintiff did not agree to designate a witness on this topic in responses served on February 26, 2024. (D.I. 207, Ex. A at 33-34) Apple has not included any evidence showing it challenged Plaintiff's original response to this topic or proposed a narrowed topic prior to the fact discovery cutoff on April 1, 2024. Medrano already testified about communications with third parties in response to LG's narrowed topic, (<i>See, e.g.</i> , D.I. 213, Ex. 11 at 420:19-422:7), and Plaintiff designated a witness on communications with inventors and alleged infringers, (<i>id.</i> , Ex. 12 at 11, 31-32).
Secondary considerations of non-obviousness	Topic 52 in 21-1304-MN	Plaintiff agreed to produce a witness on this topic but withdrew its agreement shortly before the deposition. LG did not challenge Plaintiff's failure to provide testimony on this topic in its discovery dispute.
	Topic 48 in C.A. No. 1302-MN	DENIED without prejudice. Secondary considerations present a legal question, and contention deposition topics directed to a corporate designee are disfavored in this district. (D.I. 213, Exs. 3-8); <i>see</i> C.A. No. 21-1304-MN, D.I. 158 at ¶ 11.
Commercial success of the technology embodied in the asserted patents	Topic 53 in 21-1304-MN	Plaintiff agreed to produce a witness on this topic but withdrew its agreement shortly before the deposition. LG did not challenge Plaintiff's failure to provide testimony on this topic in its discovery dispute.
	Topic 49 in C.A. No. 21-1302-MN	DENIED without prejudice. Secondary considerations present a legal question, and contention deposition topics directed to a corporate designee are disfavored in this district. (D.I. 213, Exs. 3-8); <i>see</i> C.A. No. 21-1304-MN, D.I. 158 at ¶ 11.

Industry recognition of technology embodied in the asserted patents	Topic 54 in C.A. No. 21-1304-MN	Plaintiff agreed to produce a witness on this topic but withdrew its agreement shortly before the deposition. LG did not challenge Plaintiff's failure to provide testimony on this topic in its discovery dispute.
	Topic 50 in C.A. No. 21-1302-MN	DENIED without prejudice. Secondary considerations presents a legal question, and contention deposition topics directed to a corporate designee are disfavored in this district. (D.I. 213, Exs. 3-8); <i>see</i> C.A. No. 21-1304-MN, D.I. 158 at ¶ 11.

2. Defendant's motion to compel the production of communications with Plaintiff's witnesses is GRANTED-IN-PART. Defendant moves to compel Plaintiff to produce communications between Plaintiff or Plaintiff's counsel and the five witnesses discussed in Defendants' motions for issuance of letters rogatory: Lucía Rey, Javier Fernández, José Hernando Rabanos, Luis Mendo Tomas, and Isabel Pérez. (D.I. 206 at 3-4) The court addressed this issue in paragraph 9 of the April 23, 2024 Memorandum Order in related Civil Action No. 21-1304-MN. (C.A. No. 21-1304-MN, D.I. 158 at ¶ 9)

3. Defendant's motion is GRANTED with respect to the production of communications between Plaintiff or Plaintiff's counsel and Mendo Tomas, consistent with the court's Memorandum Order on the motion for issuance of letters rogatory issued this same date. (D.I. 223) To the extent that Plaintiff asserts privilege over any of the communications, the parties shall meet and confer on the production of a privilege log. Defendant's motion is **DENIED** in all other respects.

PLAINTIFF'S ISSUES

4. Plaintiff's motion to compel Defendants to produce documents responsive to Request for Production Nos. 122 and 124 is DENIED without prejudice to renew. During the hearing on May 15, 2024, the parties agreed to table this issue pending further meet and confer efforts.

5. Plaintiff's motion to compel Defendant to produce a 30(b)(6) witness on Topics 24, 27, 28, and 46 is DENIED without prejudice. Plaintiff argues that a supplemental deposition on these topics is warranted because Defendant's designated witness was not prepared to answer questions about lower-layer Qualcomm source code on outer loop power control ("OLPC"), even though Defendant has the relevant Qualcomm source code in its possession.

(D.I. 208 at 2-3) Defendant responds that its [REDACTED]

[REDACTED] which has not been produced. (D.I. 211 at 1-2) In accordance with the court's Memorandum Order on Plaintiff's motion for reconsideration issued on this same date, the deposition of Qualcomm will go forward on May 17, 2024. (D.I. 222) These topics can be explored with Qualcomm during the Qualcomm deposition and then discussed in a meet and confer between the parties.

6. Plaintiff's motion to compel Defendant to produce a 30(b)(6) witness on Topic 31 is GRANTED-IN-PART. Topic No. 31 seeks testimony on "U.S. mobile network operators' requirements for outer loop power control." (D.I. 208, Ex. 5) On its face, Topic No. 31 is directed to third-party product requirements. (*Id.*) Defendant represents that it searched for and found no U.S. mobile network requirement documents mentioning OLPC. (D.I. 211 at 3) Defendant cannot be compelled to provide information or documents it has verified it does not possess. *See, e.g., What A Smoke, LLC v. Duracell U.S. Operations, Inc.*, 2022 WL 1442227, at

*6 (D.N.J. May 6, 2022). However, Defendant has offered to collect and produce product requirements received from U.S. mobile network operators in lieu of a deposition, even though those requirements do not mention OLPC. (*Id.*; D.I. 207, Ex. D at 4) During the hearing on May 15, Plaintiff agreed to accept Defendant’s compromise offer and reserved the right to renew the issue. Consequently, Defendant shall produce product requirement documents and information received from U.S. mobile network operators on or before June 15, 2024. Plaintiff’s motion is denied without prejudice to renew in all other respects as to Topic No. 31.

7. Plaintiff’s motion to compel Defendant to produce a 30(b)(6) witness on Topic 52 is DENIED without prejudice to renew. Topic No. 52 seeks testimony on Defendant’s “decision to implement the accused functionalities into the Accused Products.” (D.I. 208, Ex. 5) During the hearing on May 15, the parties agreed to table this issue as to the Qualcomm chipsets until after the Qualcomm deposition and further meet and confer efforts between the parties. The parties also agreed to table the issue as to the Intel chipsets until the oral argument set for June 6, 2024 on Plaintiff’s motion to amend the complaint.

8. Conclusion. For the foregoing reasons, IT IS ORDERED that:

- Defendant’s motion to compel Plaintiff to produce a 30(b)(6) witness on Topics 1, 14, 34, 39, 48, 49, and 50 is DENIED without prejudice.
- Defendant’s motion to compel the production of communications with Plaintiff’s witnesses is GRANTED-IN-PART. The motion is GRANTED with respect to the production of communications between Plaintiff or Plaintiff’s counsel and Mendo Tomas, and it is DENIED without prejudice in all other respects.

- Plaintiff's motion to compel Defendants to produce documents responsive to Request for Production Nos. 122 and 124 is DENIED without prejudice to renew.
- Plaintiff's motion to compel Defendant to produce a 30(b)(6) witness on Topics 24, 27, 28, and 46 is DENIED without prejudice.
- Plaintiff's motion to compel Defendant to produce a 30(b)(6) witness on Topic 31 is GRANTED-IN-PART. Defendant shall produce product requirement documents and information received from U.S. mobile network operators on or before June 15, 2024. Plaintiff's motion is denied without prejudice to renew in all other respects as to Topic No. 31.
- Plaintiff's motion to compel Defendant to produce a 30(b)(6) witness on Topic 52 is DENIED without prejudice to renew.

9. Given that the court has relied upon material that technically remains under seal, the court is releasing this Memorandum Order under seal, pending review by the parties. In the unlikely event that the parties believe that certain material in this Memorandum Order should be redacted, the parties shall jointly submit a proposed redacted version by no later than **May 23, 2024**, for review by the court, along with a motion supported by a declaration. Any argument that portions of the Memorandum Order should be sealed must be supported by "a particularized showing of the need for continued secrecy" sufficient to overcome the strong presumption of public access to court records. *See In re Avandia Mktg., Sales Practices & Prods. Liab. Litig.*, 924 F.3d 662, 672, 675 n.10 (3d Cir. 2019) (quoting *Leucadia, Inc. v. Applied Extrusion Techs., Inc.*, 998 F.2d 157, 166 (3d Cir. 1993) (internal quotation marks omitted)). If the parties do not file a proposed redacted version and corresponding motion, or if the court determines the motion

lacks a meritorious basis, the documents will be unsealed within fourteen (14) days of the date the Memorandum Order issued.

10. This Memorandum Order is filed pursuant to 28 U.S.C. § 636(b)(1)(A), Fed. R. Civ. P. 72(a), and D. Del. LR 72.1(a)(2). The parties may serve and file specific written objections within fourteen (14) days after being served with a copy of this Memorandum Order. Fed. R. Civ. P. 72(a). The objections and responses to the objections are limited to four (4) pages each.

11. The parties are directed to the court's Standing Order For Objections Filed Under Fed. R. Civ. P. 72, dated March 7, 2022, a copy of which is available on the court's website, www.ded.uscourts.gov.



Sherry R. Fallon
United States Magistrate Judge