



August 19, 2020

**VIA E-FILING**

The Honorable Jennifer L. Hall  
J. Caleb Boggs Federal Building  
844 N. King Street  
Room 3124, Unit 17  
Wilmington, DE 19801-3556

**RE: *Elm 3DS Innovations, LLC v. Samsung Electronics Co., Ltd. et al.,***  
**(C.A. No. 14-cv-1430-LPS)**  
***Elm 3DS Innovations, LLC v. Micron Technology, Inc., et al.,***  
**(C.A. No. 14-cv-1431-LPS)**  
***Elm 3DS Innovations, LLC v. SK hynix Inc. et al.***  
**(C.A. No. 14-cv-1432-LPS)**

Dear Judge Hall,

Plaintiff Elm 3DS Innovations, LLC respectfully moves to compel Defendants to produce documents and product samples that Defendants admit are responsive to Elm's requests and non-privileged. Defendants are withholding these documents and samples solely because they are allegedly subject to non-disclosure or confidentiality agreements with third parties. The Court's Protective Orders in these cases will protect these confidential materials. (*See* D.I. 117 (14-cv-1430); D.I. 71 (14-cv-1431); D.I. 112 (14-cv-1432).) Elm should not be forced to provide third parties with more assurances than this Court's Protective Orders already provide, or be forced to wait months to receive relevant information while the Defendants re-negotiate their third-party confidentiality agreements.

As one example, Elm served a request for production for "purchase orders and/or other contracts or agreements" related to the sale of the Accused Products. (Ex. 1 at 2.) Defendant Micron Technology, Inc. acknowledges that it has agreements with third-party Apple for the sale of accused semiconductors that are responsive to this request. (*See id.*) But Micron has said that third-party Apple will not allow Micron to produce these documents unless Elm agrees to all of the following four conditions:

1. Should the Agreements appear on either party's trial exhibit list, the parties must agree to let Apple know at the time trial exhibit lists are first exchanged.
2. Should the Agreements be discussed at hearing or trial, the parties must agree to use reasonable efforts to seal the courtroom and redact any related transcript person.
3. To the extent either party seeks to disclose the Agreements to any experts or consultants pursuant to Sections I.A.5.b and III of the Protective Order, the parties must agree to provide the name [and] materials for each

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individual to Apple so it can evaluate whether it has any objections. Similarly, if any individuals have been disclosed pursuant to the Agreement, the parties must agree to provide the names and materials of those individuals to Apple.

4. To the extent either party seeks permission to disclose the Agreements to anyone pursuant to Section I.A.5.f., the parties must agree to notify Apple the name of the individual so Apple can evaluate whether it has any objections.

(*Id.*) Elm explained during a meet and confer that it did not oppose Defendant Micron agreeing to these provisions with Apple. That would be the most reasonable solution given that Micron and Apple are the two companies that have an ongoing business relationship. Micron itself could meet at least some of Apple's demands without Elm's agreement at all. For example, if any party lists these documents on an exhibit list before trial, Micron can notify Apple. Elm also informed Micron that Elm has no objection to Micron sharing the names of the experts disclosed pursuant to the Protective Orders. That way Apple can determine whether it has any concerns with the disclosed experts. But Micron responded that Apple refuses to allow Micron to produce these documents unless Elm agrees to these conditions as is.

At this point, despite Elm's attempts to negotiate conditions that would satisfy all the parties involved, Micron has stated that it "cannot produce the requested materials absent a court order." (*Id.* at 1.) Micron made clear in a meet and confer that it does not oppose this motion to compel it to produce the requested documents.

Defendant Samsung Electronics Co., Ltd. refuses to produce responsive, non-privileged documents and product samples for the same reason. Samsung has explained that it is withholding "[o]ne of the [responsive] licenses . . . based on an objection by the licensor." (Ex. 2 at 2.) Samsung has also explained that it is currently withholding responsive communications, including communications with dielectric suppliers that are likely to address some of the key contested issues in this case. In addition to those documents, Samsung also refuses to produce samples of products that it claims "are subject to NDAs." (Ex. 3 at 1.) Samsung stated that it was "collecting the NDAs so [it could] determine next steps" related to the requested samples. (*Id.*) But during the parties' meet and confer almost a month later, Samsung did not provide any proposed next steps to resolve this issue but instead wrongfully claimed that Elm had not requested these samples. To be clear, Elm served a request for production for "[t]en (10) samples of each Product." (Ex. 4 at 6.) Elm served that request on February 6, 2020. (*Id.*) Elm specifically asked for these products by product number on July 5, 2020. (Ex. 3 at 2.) Samsung's position—that each sample allegedly covered by an NDA be addressed separately, and Elm's access to the sample be negotiated over the course of many months—will unreasonably delay a case that has already dragged on for far too long.

Finally, Defendant SK hynix Inc. is withholding purchase agreements with Apple, Microsoft, and Intel. In discussing this issue, SK hynix shared the confidentiality provisions that it claims prevents the production of some of these documents. But the language of these provisions actually supports Elm's position. Both agreements make clear that these documents can be produced as long as they are marked confidential under the Protective Order. (Ex. 5 at 2 ("Receiving Party may disclose Confidential Information of Disclosing Party in accordance with

a judicial or other governmental order, provided that Receiving Party . . . obtains written assurance from the applicable judicial or governmental entity that it will afford the Confidential Information the highest level of protection afforded under applicable law or regulation.”); *id.* (“Recipient may disclose Confidential Information to the extent required by law, provided Recipient makes reasonable efforts to give Discloser written notice of such requirement before disclosure and takes reasonable steps to obtain protective treatment of the Confidential Information.”).) Most nondisclosure or confidentiality agreements have provisions like these allowing for the production of confidential materials based on legal obligations, such as requests for production. Yet, SK hynix refuses to produce these documents without a Court order. Though similar to Micron, SK hynix made clear in a meet and confer that it will take no position in response to this motion.

The Court’s Protective Orders already provide these third parties protection over confidential documents—the same protection afforded the parties’ confidential documents produced in these cases. Forcing Elm to agree to different protections demanded by different third parties will lead to confusion that will make it difficult for Elm and the Defendants to meet each third parties’ demands. That is one reason that it is preferable to have one Protective Order issued by the Court that governs all documents in a case. The Defendants all agree these documents and product samples are responsive. The Defendants also agree that these documents and samples are not privileged. Therefore, Elm believes the Defendants should mark the documents confidential under the Protective Orders and produce them without any additional conditions.

For these reasons, Elm 3DS respectfully requests that the Court grant this motion and order that Defendants produce all responsive, non-privileged documents protected by nondisclosure or confidentiality agreements.

Respectfully submitted,

/s/ Brian E. Farnan

Brian E. Farnan

cc: Counsel of Record (via E-File)