PUBLIC VERSION

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION

MAXELL, LTD., *Plaintiff,* v. APPLE INC., *Defendant.*	Case No. 5:19-cv-00036-RWS **JURY TRIAL DEMANDED** PUBLIC VERSION

MAXELL, LTD.'S OPPOSITION TO APPLE INC.'S MOTION FOR PROTECTIVE ORDER TO PREVENT DEPOSITION OF IN-HOUSE LITIGATION COUNSEL

When Apple wanted to show the Court it could not identify relevant components in its own products—however far-fetched the claim—it offered to have Mr. Stein testify regarding his experience trying to identify just one component. Apple stated [redacted]. Ex. A (September 17, 2019 Hearing Tr. at 98:3-15). Apple expected the Court to rely on these representations regarding Mr. Stein's experience, and to rule based on them. But having made its representations to the Court, Apple now insists that having Mr. Stein testify on these same issues is an "abuse of the discovery process." Apple is playing games, asking the Court to rely on "facts" that it refuses to have questioned.

Apple waived its ability to object to Maxell's deposition of Mr. Stein on the limited issue that **Apple** made relevant by putting it squarely before the Court. To avoid responding to an interrogatory identifying select components, Apple told this Court [redacted]. *Id.* at 83:5-13. Apple represented it "[redacted]." *Id.* at 98:3-15. "[redacted]. *Id.*

Since that day, Apple has backed away from its in-Court statements. For example, on October 2 Apple stated "Maxell mischaracterizes Apple's representation to the Court as being unable to 'identify the relevant components in response to Interrogatory No. 6.' Apple has never made any such representation. Apple has instead correctly represented that filling out the 10,000-cell spreadsheet … is burdensome and oppressive, if it is even possible." Ex. B (Excerpt of Apple 10/2/19 Letter). Because Apple has not fully responded to Interrogatory No. 6, and is now changing its positions regarding its in-Court statements, it is

necessary to seek Mr. Stein's deposition to determine the facts.[1]

Apple's response confirms the importance of Mr. Stein's deposition. Although Apple stated to the Court that it "[redacted]" referring to the chart accompanying Interrogatory No. 6, Apple now states Mr. Stein [redacted] but rather that his efforts were for some undefined **different** case. Ex. A (September 17, 2019 Hearing Tr. at 98:3-15); Mot. at 5; *see also, e.g.,* Apple Mot. at Ex. A (11/4/19 Meet and Confer Tr. at 10:16-19) ("Mr. Stein has not attempted to collect information and that's not what he was going to say to the Court to fill out one of the lines in the chart… in this case."). Furthermore, Apple later stated that "[t]he allegation … that Apple represented '[redacted]' is a mischaracterization of the statement actually made to the Court." Ex. C (Excerpt of Apple 10/11/19 letter). Apple and Mr. Stein have offered two different and conflicting stories. Maxell is entitled to question Mr. Stein's and Apple's representation in its effort to get fulsome discovery responses from Apple.

Additionally, Apple offered Mr. Stein as a fact witness to "explain[] the heavy burden associated with tracking down component-level information based on his experience attempting to do so…," stating [redacted]. Mot. at 5; Ex. A (September 17, 2019 Hearing Tr. at 98:3-15). Maxell seeks to depose Mr. Stein in this capacity as well. Maxell will limit the deposition to the details of and circumstances surrounding [redacted] proffered to the Court and Apple's burden in collecting component information. Such a limited deposition will not harass or waste time, nor will it risk disclosure of legal theories or strategy. It will, however, enable the parties and the Court to determine the facts relating to Apple's discovery burden and close this issue.

[1] This explains why Maxell served its deposition notice on October 8 rather than immediately following the hearing. Such timing does not establish that the information sought is not crucial, as Apple asserts, but rather that Maxell did not have reason to believe that Apple was misrepresenting its discovery efforts until later.

I. ARGUMENT

A. *Shelton* Does Not Apply to Mr. Stein's Noticed Deposition

Maxell does not contest that Mr. Stein is Senior Litigation Counsel. However, *Shelton* does not apply here due to the subject matter of the sought deposition. As the Eighth Circuit stated in *Pamida, Inc. v. E.S. Originals, Inc.*, "the *Shelton* test was intend[ed] to protect against the ills of deposing opposing counsel in a pending case which could potentially lead to the disclosure of the attorney's litigation strategy." 281 F.3d 726, 729-30 (8th Cir. 2002). Although the facts of *Pamida* may differ from those here, the rationale is the same. No heightened protection is necessary in a situation such as this one, where Maxell seeks to depose Mr. Stein regarding [redacted] that he allegedly performed in connection with a different matter (as Apple now claims). There is no danger that questioning Mr. Stein on an effort to collect information in an **unrelated matter** would reveal litigation theories or strategy with respect to **this** litigation. Mr. Stein would be deposed in his capacity as a fact witness regarding the unrelated matter, not as counsel to Apple in the current litigation. *See, e.g., Am. Cas. Co. of Reading, Pennsylvania v. Krieger*, 160 F.R.D. 582, 588 (S.D. Cal.1995) (stating deposition of opposing counsel may be appropriate where attorney is a fact witness); *aaiPharma, Inc. v. Kremers Urban Development Co.*, 361 F. Supp. 2d 770, 775 (E.D. Ill. 2005) (declining to apply *Shelton* in part because discovery was sought "regarding the prosecution of the patents in suit, and not about the underlying litigation").

Apple's complaints that Mr. Stein's deposition would unnecessarily add to the time and costs of litigation or otherwise implicate *Shelton's* reasons for prohibiting his deposition are without merit. Preparing and sitting for a short deposition would not detract from Mr. Stein's representation. Given that Mr. Stein [redacted], offering up anyone else for this issue would actually require more of Mr. Stein's time. [redacted]

[redacted] Deposing Mr. Stein directly is the most efficient course.

Maxell's proposed deposition would not result in voluminous privilege objections requiring resolution. Apple waived any claims of privilege related to t[redacted] when it disclosed details thereof in full expectation that the Court would rely on such disclosure in rendering a decision on Maxell's motion to compel. Thus, a waste of time would only result if Apple insists on raising improper objections.

B. A Deposition is Warranted even under the *Shelton* Three-Factor Test

Even if *Shelton* applies, the deposition is warranted. Apple acknowledges depositions of opposing counsel are permitted in certain circumstances. *See* Mot. at 2 (citing *Nguyen v. Excel Corp.*, 197 F.3d 200, 209 (5th Cir. 1999)). This is one such circumstance. Maxell does not seek a roving deposition of counsel that will get into the contours of how it intends to litigate this case. Rather, Maxell seeks a deposition of an individual offered to the Court regarding a specific alleged attempt to collect discovery that Apple asked the Court to rely on for a motion to compel.

Even if *Shelton* applies, the factors are met. No other means exist for Maxell to obtain this information. Apple stated that Mr. Stein hi[redacted] that would be the subject of the deposition, and that [redacted]. Ex. A (Tr. at 98:3-15). As Apple offered Mr. Stein's experience to the Court, there is no doubt that he is the only possible deponent suited to provide information regarding **his** experience. Any other deponent could only provide second-hand knowledge, which is bound to be incomplete.

That Maxell also noticed a corporate deposition on discovery-related topics does not make Mr. Stein's deposition cumulative or suggest there are other means for Maxell to obtain **this** requested information. Maxell seeks to depose Mr. Stein on a narrow issue—the circumstances surrounding [redacted]

[2] Moreover, if Mr. Stein is as involved in managing the litigation as Apple argues, he would be involved in the preparations and depositions of any Apple witnesses regardless of his knowledge on the topic.

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