

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

FINTIV, INC.,
Plaintiff,
v.
APPLE INC.,
Defendant.

Civil Action No. 1:21-cv-00896-ADA
PUBLIC VERSION

**SEALED ORDER REGARDING
THE DECEMBER 13, 2022 DISCOVERY DISPUTE HEARING**

Pursuant to the Standing Order Governing Proceedings (OGP) 4.2 - Patent Cases, the Minute Entry for proceedings held (Dkt. 448), and the Court's Standing Order for Discovery Hearings in Patent Cases, the parties jointly submit the below proposed order reflecting the Court's rulings at the December 13, 2022, discovery hearing regarding the parties' discovery disputes.

Issue 1: Apple's Objections to Fintiv's Proposed Email Custodians and Search Terms

Fintiv's Position

Fintiv requested that Apple search email for 44 Apple custodians. Each of the 44 custodians was either: (1) identified in the documents or emails this Court ordered Apple to produce in the Order on Emergency Motion because they were identified in Apple's Opposition; (2) identified in Apple's Initial Disclosures; or (3) identified by Fintiv as someone who had met with Fintiv. Of these custodians, 24 are listed on two emails/calendar invites related to: a meeting with CorFire in 2012; and a meeting listing Mozido as a "target" company related to "a larger Apple Pay play, growing payment and commerce services through acquisition." Apple objected on burdensome grounds because of the number of custodians, but Fintiv should not be

deprived of email communications simply because Apple chose to involve numerous, relevant Apple employees in the CorFire/Mozido meetings.

Apple also objected on burdensome grounds to the number of Fintiv's search terms. Fintiv's search terms relate to: (1) the asserted patent, the named inventors, and unique terms therein; (2) CorFire and its product names; (3) the names of former Fintiv employees; and (4) third-party vendors Fintiv believe attended the Apple-CorFire meeting(s). Many of the search terms are permutations of the names of CorFire employees listed Master Restrict Project Agreement Apple signed with CorFire related to the development of Apple Pay.

For these reasons, Fintiv respectfully requested that the Court order Apple to search all 44 email custodians and all 40 search terms requested by Fintiv and produce the results of the same.

Relief Sought: Order Apple to search all email custodians and search terms requested by Fintiv.

Apple's Position

Fintiv's request that Apple search the email of 44 Apple custodians for 40 search terms: (1) directly contravenes the Court's July 5, 2022, Order (ECF 441); (2) is contrary to the representations that Fintiv made to the Court during the June 24, 2022, hearing and the Court's clear statements to Fintiv at the hearing; (3) seeks information pertaining to communications between 2012 and 2014 that are neither relevant nor properly discoverable because there are no willfulness or indirect infringement claims and the patent-in-suit did not issue until September 23, 2014; (4) is neither proportional or fair; and (5) ignores that discovery closed over a year ago and excluded email discovery.

The Court's July 5, 2022, Order ordered "limited bilateral discovery" including requiring that "[b]oth parties . . . conduct additional searches through limited sets of email and ESI using

custodians and search terms . . .” See Order on Emergency Motion (ECF 441) (the “Order”) at ¶ 2(f). The subject matter addressed at the June 24, 2022, hearing that resulted in the Court’s Order pertained solely to pre-suit communications between Apple and the prior assignee of the asserted patent, SK C&C/CorFire, and with Fintiv (previously named “Mozido”). June 24, 2022, Hearing Transcript (“Tr.”) (ECF 439).

Pursuant to the Order and consistent with the subject addressed at the June 24, 2022, hearing, Apple timely served email discovery requests on Fintiv on August 1, 2022, in which Apple identified 11 Fintiv email custodians likely to have knowledge regarding pre-suit communications, and Apple identified 10 narrowly tailored search terms relating to that topic. Fintiv never objected to Apple’s proposed custodians or topics.

On August 4, 2022, Fintiv served discovery requests seeking four times the amount of discovery sought by Apple: 44 Apple email custodians and 40 search terms. On August 29, 2022, Apple objected to the overbreadth and irrelevance of many of the proposed custodians and search terms and, pursuant to the Court’s OGP, Apple proposed an “alternate plan” identifying the 11 custodians and 11 terms that (subject to running search term hit reports) Apple would be willing to run and that are most likely to lead to the discovery of responsive information.

Betraying its current professed interest in moving this case forward promptly, Fintiv sat silent in September. And in October. Fintiv then requested to meet and confer in December, but refused to withdraw any of its 44 Apple proposed custodians or any of its 40 search terms.

Fintiv’s sweeping requests directly contravene the Court’s Order permitting “limited bilateral discovery”—there is nothing limited about 44 custodians and 40 search terms, particularly in the context of discovery that was ordered long after the close of formal discovery that did not include any email discovery. Moreover, the Court made it clear to Fintiv during the

June 24, 2022, hearing that the Court would permit only a “small number” of search terms. Tr. at 55. And Fintiv itself told the Court during the June 24, 2022, hearing that Fintiv was requesting “a very brief surgical process” that would be “limited” and “not . . . a fishing expedition.” Tr. at 54-55. Indeed, the breath of the email discovery that Fintiv seeks is now well beyond what likely would have been permitted had Fintiv requested it before the discovery cut-off.

But beyond the sheer number of custodians and terms, many of them have little to no bearing on the limited subject matter to which this discovery was to be directed. For example, the search terms include such widely used terms in the mobile payment space like “se” (short for secure element), “Provision!,” “widget,” “rule engine,” “filter,” and “register.” And the list of witnesses includes apex witnesses Steve Jobs and Tim Cook. The over breath of Fintiv’s search terms is exemplified by the fact that running Fintiv’s 40 search terms over a single custodian’s (Chris Sharp’s) email from 2011-2016 returned over 78,000 documents.

Relief Sought: Order Fintiv to limit: (1) its custodians to the following 11 custodians on its list: Ben Vigier, Charlie Buchbinder; Pascal Caillon; Jason Miller; Ahmer Khan; David Haggerty; Joakim Linde; Chris Sharp; Brian Tucker; Baris Cetinok; and David Parker; and (2) limit its search terms to the following 11 search terms on its list: CorFire; SK C&C; Incomm; CorPay; CorTSM; Eubank; Warra; CorTrust; Caillon; 8843125; and Mozido.

The Court’s Ruling:

Fintiv and Apple each may identify 12 custodians and 11 search terms for email discovery. If a party objects to one or more custodians or one or more search terms identified by the other party (for example, if the search term results in an excessive number of emails), the parties shall meet and confer to attempt to resolve the objections. If the parties are unable to resolve their objections, then the parties may submit their dispute to the Court. If the Court hears

and sustains an objection to one or more custodians or search terms, then the number of custodians or search terms will be reduced accordingly. For example, if Fintiv includes Tim Cook in its list of custodians and Apple objects to that custodian and the Court sustains that objection, then Fintiv will thereafter be limited to 11 custodians.

Issue 2: Apple’s Failure to properly designate produced documents

Fintiv’s Position

Apple wrongly produced the following two CorFire slide presentations without labelling them confidential under the Court’s Protective Order in this action: (1) APPLE-FINTIV_00706345-706390; and (2) APPLE-FINTIV_00706447-706458. Both documents are confidential and meet the Protective Order’s definition of confidential information as they contain confidential business information of Fintiv. *See* D. I. 56 at ¶ 9.

Moreover, Fintiv obtained these two documents subject to an NDA with CorFire. Apple has not identified any prejudice from marking these documents AEO.

For these reasons, Fintiv respectfully requests that the Court order Apple to re-produce these documents designated as Confidential under the Protective Order.

Relief Sought: Order Apple to re-produce these documents with a Confidential label under the Protective Order.

Apple’s Position

The two documents at issue are not confidential, contain no confidential information, and therefore are not properly subject to a confidentiality designation under the Protective Order. The first presentation (APPLE-FINTIV_00706345) is titled “CorFire Merchant Workshop—New York, 12th September,” which was apparently held for Crédit Mutuel bank (not Apple). It primarily consists of an overview of CorFire and its products (*id.* at 347-58) and an overview of

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