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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

ELAN MICROELECTRONICS CORPORATION,	Case No. C-09-01531 RS (PVT)
Plaintiff and Counterclaim Defendant,	**NOTICE OF MOTION AND MOTION TO STRIKE PARAGRAPHS 26-34 OF THE CLAIM CONSTRUCTION DECLARATION OF ROBERT DEZMELYK [D.I. 89]**
v.	JURY TRIAL DEMANDED
APPLE INC.,	Hon. Richard Seeborg
Defendant and Counterclaim Plaintiff.	July 8, 2010, 1:30 pm Courtroom 3, 17th Floor

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RULES AND STATUTES

TO DEFENDANT ELAN MICROELECTRONICS AND ITS COUNSEL OF RECORD:

NOTICE IS HEREBY GIVEN that on July 8, 2010, Apple Inc. ("Apple") will move to strike portions of the May 7, 2010 Declaration of Robert Dezmelyk In Support of Elan Microelectronics Corporation's Opening Claim Construction Brief that introduce new and untimely opinions relating to claim construction. This motion is based upon the points and authorities in support of the motion set forth below as well as the declaration and exhibits filed concurrently with this motion. The relief sought by Apple is an order from the Court striking Paragraphs 26-34 of Mr. Dezmelyk's declaration. Because this issue is closely related to pending claim construction proceedings, Apple is moving concurrently herewith to shorten time such that this motion be heard on June 21, 2010, the date of the claim construction tutorial.

I.

INTRODUCTION

It is now apparent that Elan's attitude towards claim construction reflects precisely the forbidden "shifting sands" approach that the Patent Local Rules are designed to prevent. Indeed, Elan's claim construction positions have been a moving target, both substantively and procedurally. On the merits, Elan's shifting positions are perhaps best exemplified by Elan's last-minute change of course on key claim construction positions well into the claim construction proceeding. After pursuing and winning its preferred claim constructions in the prior *Synaptics* litigation and embracing those same constructions here, Elan decided—more than a month after the parties filed their Joint Claim Construction Statement and the night before the deposition of Elan's claim construction expert—to suddenly drop critical aspects of its proposed construction. *See* D.I. 85 [Apple's Opening Claim Construction Brief] at 6-9. Procedurally, Elan's shifting positions are reflected in its submission of a new claim construction expert declaration well after the completion of claim construction discovery. It is this declaration that is the subject of the instant motion.

Patent Local Rule 4-3(e) requires that, at the time of the Joint Claim Construction Statement, the parties disclose "[w]hether any party proposes to call one or more witnesses at the Claim Construction Hearing, the identity of each such witness, and for each witness, a summary

of his or her testimony ***including, for any expert, each opinion to be offered related to claim construction.***" Patent L.R. 4-3(e). Consistent with this process, the parties exchanged expert reports setting forth each opinion to be offered related to claim construction on February 22, 2010, and following that exchange, deposed one another's experts in advance of claim construction briefing. Then, on the day opening claim construction briefs were filed, Elan broke from the Patent Local Rules by submitting, without explanation or notice, a new expert declaration that includes new and substantively different opinions and evidence. Not only was this new expert declaration untimely under the Rules, but it came a month ***after*** Apple had already deposed Elan's expert on his previous report. As a result, Elan's late filing of the new report ensured that (1) Apple did not have the opportunity to depose Mr. Dezmelyk about his new opinions, (2) Apple did not have the opportunity to have its own expert rebut Mr. Dezmelyk's new opinions, and (3) Apple did not have the opportunity to consider these new opinions before submitting its own claim construction brief. Even more importantly, Elan's late filing ensured that Elan's new expert evidence will go untested before the Court will be asked to consider it. Because this result is plainly inconsistent with the Patent Local Rules and with basic principles governing the fair disclosure of expert opinions, the Court should strike Paragraphs 26-34 of Mr. Dezmelyk's new expert declaration as containing untimely new opinions.

II.

THE COURT SHOULD STRIKE ELAN'S SUBMISSION OF UNTIMELY EXPERT OPINIONS IN PARAGRAPHS 26-34 OF MR. DEZMELYK'S DECLARATION

A.   The Patent Local Rules Provide A Specific Framework For The Disclosure Of Expert Opinions On Claim Construction

This Court (and many that have followed its lead) have developed an ordered process for presenting and testing relevant evidence related to claim construction. These rules were "designed to prevent [a] 'shifting sands' approach to claim construction." *LG Elecs., Inc. v. Q-Lity Computer, Inc.*, 211 F.R.D. 360, 367 (N.D. Cal. 2002); *see also O2 Micro Intern. Ltd. v. Monolithic Power Systems, Inc.*, 467 F.3d 1355, 1364 (Fed. Cir. 2006) (same).[1]

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[1]   Emphasis added and internal citations omitted throughout, unless otherwise noted.

1   To accomplish this goal, the Patent Local Rules establish that a specific series of

2   disclosures must be provided by each party by specific dates. These disclosures include not only

3   infringement and invalidity contentions to help elucidate the issues that will be in dispute, but a

4   sequence of specific claim construction disclosures that permit the parties to fully and fairly

5   consider, discuss, and, ultimately, litigate claim construction issues. *See* Patent L.R. 4-1–4-6.

6   Specifically with respect to expert opinion on claim construction issues, Patent Local Rule 4-2

7   requires, at the same time the parties exchange their proposed claim constructions, "a description

8   of the substance of that witness' proposed testimony that includes a listing of any opinions to be

9   rendered in connection with claim construction." Patent L.R. 4-2(b).

10   Following these submissions, the parties are to work jointly on a Joint Claim Construction

11   Statement, at which time they must disclose "[w]hether any party proposes to call one or more

12   witnesses at the Claim Construction Hearing, the identity of each such witness, and for each

13   witness, a summary of his or her testimony *including, for any expert, each opinion to be offered*

14   *related to claim construction."* Patent L.R. 4-3(e). Thereafter, "the parties *shall complete all*

15   *discovery* relating to claim construction, *including any depositions with respect to claim*

16   *construction of any witnesses, including experts,* identified in the Preliminary Claim

17   Construction statement (Patent L.R. 4-2) or Joint Claim Construction and Prehearing Statement

18   (Patent L.R. 4-3)." Patent L.R. 4-4. To emphasize the importance of this process, the Patent

19   Local Rules demand "Good Faith Participation" at the threat of sanctions under 28 U.S.C. § 1927.

20   Patent L.R. 4-7.

21   In short, the Patent Local Rules prescribe a specific sequence for claim construction

22   expert discovery: (1) expert opinions are exchanged, (2) experts are deposed concerning their

23   opinions, and then (3) claim construction briefs are filed. The result of this process is a full, fair

24   and ordered procedure for expert opinions on claim construction that yields both good case

25   management and a record on which the Court can be assured that expert evidence has been fairly

26   tested under the adversary process and cross-examination. *See Phillips v. AWH Corp.*, 415 F.3d

27   1303, 1318 (Fed. Cir. 2005) ("[E]xtrinsic evidence consisting of expert reports and testimony is

28   generated at the time of and for the purpose of litigation and thus can suffer from bias that is not

present in intrinsic evidence. The effect of that bias can be exacerbated if the expert is not one of skill in the relevant art or if the expert's opinion is offered in a form that is not subject to cross-examination.").

B.   Mr. Dezmelyk's New Declaration Discloses New Opinions For The First Time *After* The Patent Local Rules' Deadline For Expert Opinions

Consistent with the Patent Local Rules, the exchange of evidence for claim construction in this case proceeded smoothly at first. The parties reached an agreement to exchange expert claim construction reports over three months ago, on February 22, 2010, and timely exchanged reports on that date. *See* Exh. A [Feb. 22, 2010 Dezmelyk Summary];[2] Exh. B [Feb. 22, 2010 Von Herzen Decl.]. As required by the Patent Local Rules, these reports included "each opinion to be offered related to claim construction." Patent L. R. 4-3(e). Following the exchange of these reports, and as permitted by the Patent Local Rules, the parties deposed one another's claim construction experts. Apple's claim construction expert Dr. Brian Von Herzen was deposed on the opinions contained in his report on April 1, 2010. Elan's claim construction expert, Mr. Robert Dezmelyk, was deposed on April 9, 2010. That deposition uncovered a number of important inconsistencies in the opinions expressed in Mr. Dezmelyk's February 22, 2010 report, as highlighted in Apple's opening claim construction briefing. *See, e.g.*, D.I. 85 [Apple Opening Claim Construction Brief] at 4, 11, 13, 14. Counsel for Elan declined the opportunity to examine Mr. Dezmelyk during his deposition and Mr. Dezmelyk declined to provide any corrections to his testimony. *See* Exh. C [Dezmelyk Tr.] at 266:22-267:6; *id.* at 268:17-21.

At that point, claim construction discovery was closed and the parties were to proceed to claim construction briefing in accordance with Patent Local Rule 4-5 and this Court's scheduling orders. Nevertheless and without any notice, on May 7, 2010, Elan filed a supplemental report by Mr. Dezmelyk along with its opening claim construction brief. *See* D.I. 89. The supplemental report was styled as a "declaration in support" of Elan's claim construction brief and was filed at 11:33 pm the evening the parties were to file opening claim construction briefs—nearly three

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[2]   All citations to "Exh. __" are to the Declaration Of Nathan Greenblatt In Support Of Apple's Motion To Strike Paragraphs 26-34 Of The Claim Construction Declaration Of Robert Dezmelyk.

hours *after* Apple had already filed its opening brief and the supporting declaration of its expert that Apple had provided to Elan back in February. *See* D.I. 85, 86.

Mr. Dezmelyk's May 7, 2010 declaration contained new opinions and evidence on substantive issues that were not expressed in his prior report and thus were not available to Apple until the very evening briefs were exchanged. For example, Paragraph 26 of the new declaration provides opinions related to the term "cursor control operation" in U.S. Patent 5,764,218 ("the '218 patent") that extend far beyond anything in Mr. Dezmelyk's original report on that term. The new declaration contains new opinions based on ostensibly different uses of the terms "control operation" and "cursor control operation" that were not disclosed anywhere in Mr. Dezmelyk's original report, and also relies upon new citations to intrinsic evidence that Mr. Dezmelyk did not rely upon or discuss in his original report. The following table highlights the extent to which Mr. Dezmelyk's new declaration reflects a departure form his original report:

February 22, 2010 Summary of Opinions	May 7, 2010 Declaration
36. I may provide my opinion that the term "cursor control operation" means "providing cursor positioning data to effect movement of the cursor." One of ordinary skill in the art would understand that term on its face to involve the control, i.e. movement, of the cursor on a display screen. That understanding is confirmed by the patent. At 6:9-13 the '218 patent expressly states that a "cursor control operation" is a cursor tracking operation. That is, an operation that controls the movement of the cursor on the screen.	26. In my opinion, the term "cursor control operation" means "providing positional data to effect movement of the cursor (i.e. cursor tracking operation)." One of ordinary skill in the art would understand that term on its face to involve controlling the movement of the cursor on a display screen. Reading the patent specification confirms my understanding. At 6:9-13 the '218 patent expressly states that a "cursor control operation" is a cursor tracking operation. Cursor "tracking" refers to controlling the movement of the cursor on the screen to reflect the user's interaction with the input device. The '218 patent states, "[t]hus, positional data relating to the user's contact with the touch-sensitive input device is supplied to the computer system in order to effectuate cursor movement on the computer screen." 6:14-17. Nowhere in the patent is the phrase "cursor control operation" used to describe operations that do not involve providing positional information.[2] Rather, when the patent describes button functions (click, double click, etc.) it uses the term "control operation." Thus I understand that the inclusion of the word "cursor" in the phrase "cursor control operation" refers to control of the cursor on the screen, i.e. its location and movement, rather that operations performed at

Compare Exh. A [Feb. 22, 2010 Dezmelyk Summary] *with* Exh. D [May 7, 2010 Dezmelyk Declaration].

Likewise, Paragraphs 27-30 of Mr. Dezmelyk's new declaration contain additional opinions about U.S. Patent No. 7,495,659 ("the '659 patent"), as shown below. For instance, Mr. Dezmelyk's new opinions, which relate to the terms "sensors configured to map the touchpad surface into native sensor coordinates" and "logical device units," encompass new and different analysis of the limitations as well as numerous additional citations to the record that Mr. Dezmelyk claims support his opinions.

February 22, 2010 Summary of Opinions	May 7, 2010 Declaration
41. I may provide in my opinion that, "Native sensor coordinates" are coordinates indicating the absolute position of an object on or near the touch pad. Those coordinates (x,y, r,θ, etc.) are calculated from the data acquired from the sensors and reflect a point on the surface of the touchpad. See 5:38-48. Apple's proposed construction does not clarify or further define this term. Rather, Apple substitutes the term "sensor coordinates of the touchpad" for the claim term "native sensor coordinates." I am not certain what Apple means by "sensor coordinates of the touchpad" and so do not know if there is a disagreement between the parties. 42. I may also testify that "Sensors configured to map the touchpad surface into native sensor coordinates" means sensors configured to produce signals indicating native sensor coordinates. The mapping of the surface into native sensor coordinates depends upon the type of sensor, and the design of the sensing electronics as discussed.	27. I understand that the parties have provided different proposed constructions of the claim element "sensors configured to map the touchpad surface into native sensor coordinates." In the first place, in my opinion, one of ordinary skill in the art would understand "native sensor coordinates" to mean coordinates indicating the absolute position of an object on or near the touch pad." As the patent explains, the coordinates are used to determine the point where the finger makes contact with the touchpad surface. 2:17-25 (x,y coordinates define the position of a finger for a Cartesian coordinate system, for polar coordinates the radius r, and the angle θ define the position of a finger); Those coordinates (x,y, r,θ, etc.) are calculated from the data acquired from the sensors and reflect a point on the surface of the touchpad. See 2:49-52 "The sensors of the touch pad 36 are configured produce signals associated with the absolute position of an object on or near the touch pad 36. In most cases, the sensors of the touch pad 36 map the touch pad plane into native or physical sensor coordinates 40." 5:38-48.

	28. Apple's proposed construction does not clarify or further define this term. Rather, Apple substitutes the term "sensor coordinates of the touchpad" for the claim term "native sensor coordinates." In my view the phrase "sensor coordinates" implies the coordinates of the sensors themselves. While the sensors may be located at particular coordinates, those locations do not define the native sensor coordinates, because the sensors are configured to provide data that allows a finger position to be detected with considerable accuracy when the finger location is between the physical sensors.
	29. In my opinion, "sensors configured to map the touchpad surface into native sensor coordinates" would be understood by one of ordinary skill in the art to mean "sensors configured to produce signals indicating native sensor coordinates." The patent explains that "The touch pad assembly includes a touch pad having one or more sensors that map the touch pad plane into native sensor coordinates. The touch pad assembly also includes a controller that ... receives the native values of the native sensor coordinates from the sensors..." 3:24-30 The mapping of the surface into native sensor coordinates depends upon the kind of sensor, and the design of the sensing electronics, as discussed above.
43. I may offer in my opinion that "logical device units" would be understood by one of ordinary skill in the art to mean "discrete user actuation zones representing areas of the touchpad encompassing groups of native sensor coordinates." This definition is consistent with the usage of this term by those skilled in the art and with the description in the patent.	30. In my opinion, "logical device units" would be understood by one of ordinary skill in the art to mean "discrete user actuation zones representing areas of the touchpad encompassing groups of native sensor coordinates." The patent explains that "clusters of native sensor coordinates ... define one logical device unit." 10:23-25 and "[i]n most cases, the raw number of slices in the form of native sensor coordinates are grouped into a more logical number of slices in the form of logical device units (e.g., virtual actuation zones). 10:42-45 This definition is consistent with the use of this term by those skilled in the art and with the description in the patent.

Compare Exh. A [Feb. 22, 2010 Dezmelyk Summary] *with* Exh. D [May 7, 2010 Dezmelyk Declaration].

In addition to the new opinions on Apple's patents described above, Mr. Dezmelyk's late report includes significant changes with respect to the means-plus-function limitations of claim 19 in Elan's '352 patent. Mr. Dezmelyk's original report contains a scant three paragraphs on the

subject. The first paragraph merely recites Mr. Dezmelyk's understanding of the appropriate legal test and his conclusion. Exh. A [Feb. 22, 2010 Dezmelyk Summary] at ¶29. The next paragraph states that the patent discloses an algorithm based on (1) Fig. 6 and 10:31-45; and (2) calculating the "centroid" of a finger was well known to those of skill in the art. *Id.* at ¶30. Completing the disclosure of "any opinions to be rendered in connection with claim construction," the final paragraph on means-plus-function in the original report states that "firmware or software may be programmed to perform the [control] function," and that "finger movements, taps, and the like . . . "can be analyzed in firmware or software . . . to implement any necessary control function." *Id.* at ¶31. The paragraph refers to "examples" of controls signals in Figs. 7 to 9 and related text. *Id.*

In contrast, Mr. Dezmelyk's new report devotes two and a half pages to the means-plus-function topic, and contains completely new opinions not even hinted at in Mr. Dezmelyk's prior report. Exh. D [May 7, 2010 Dezmelyk Declaration] at ¶31-34. In his late report, he opines for the first time that "Analog multiplexer 45; Capacitance measuring circuit 70; A/D convertor 80, Microcontroller 60; and/or software, firmware, or hardware" provide the required structure. *Id.* at ¶31. From that starting point, the new opinions snowball, and include opinions related to at least ten new citations, as well as expanded opinions relating to Figures 7 to 9 far beyond what was original discussed:[3]

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[3] When pressed to identify structure for claim 19 of the '352 patent at his April 9, 2010 deposition, Mr. Dezmelyk also deviated from his original report by identifying hardware as well as software elements for performing the required function, and by pointing to a few alleged examples of disclosed software algorithms. However, Mr. Dezmelyk did not supply the same alleged analysis at his deposition as in his May 7, 2010 declaration. In any event, even if Mr. Dezmelyk had provided a complete statement of the opinions in his late report during his deposition, that would not excuse the lateness or cure the prejudice to Apple. Expert depositions are meant to test previously expressed opinions, not provide vehicles for presentation of new opinions that counsel must test without preparation. *See, e.g., OFS Fitel, LLC v. Epstein, Becker and Green, P.C.*, 549 F.3d 1344, 1362 (11th Cir. 2008) (noting that information required by expert reports "is required in the expert's written report precisely because it is important information necessary to attorneys in preparation for deposing the expert.").

February 22, 2010 Summary of Opinions	May 7, 2010 Declaration
30. The patent discloses that the exemplary algorithms shown in the patent, including Fig. 6, may include a step for calculating the centroid for each finger. 10:31-45. The term "centroid" and the centroid calculation to determine the precise coordinates of finger contact were well known to those skilled in the art and included in nearly all prior art touchpads. As such, this structure – a firmware or software routine running on the touchpad controller or host computer to determine a centroid – is disclosed and well defined to one of ordinary skill in the art. 31. The patent also discloses that firmware or software may be programmed to perform the function of selecting a click function or any other appropriate control signal. The patent gives a number of examples of such control signals in Figs. 7 – 9 and related text. Those examples include emulating mouse button click and double click signals, selecting an object, dragging an object and other traditional input functions. The click function is included in the algorithm disclosed in Figs. 8 and 9. The patent also discloses that any series of finger movements, taps and the like involving one or more than one finger can be analyzed in firmware or software on the touchpad or on the host to implement any necessary control function. Determining a control function and writing a software or firmware routine to interpret contact sequences to implement that control function was well within the knowledge of those skilled in the art at the time of the '352 patent.	31. In my opinion, the "means for selecting an appropriate control function" limitation found in Claim 19 of the '352 patent has a structure which consists of Analog multiplexer 45; Capacitance measuring circuit 70; A/D convertor 80, Microcontroller 60; and/or software, firmware or hardware performing the claimed function. Practitioners of ordinary skill in the art at the time of the filing of the '352 patent, based on their training, and the techniques already known to them, would know how to program controller firmware, driver software running on the host or the like in order to assign particular control functions to specific gestures, where the gestures are defined by combinations of the number of fingers detected, the amount of time the fingers are detected,[3] and any movement of the fingers. The '352 patent sets forth a number of possible assignments of functions to gestures, and provides algorithms for determining the number of fingers detected, the amount of time during which the fingers are detected in contact, and the position and movement of the fingers on the touchpad, and explains that "[i]f a control function is intended, the specific control function can then be identified. 12:11-13. The patent explains how the combinations of finger contacts shown in Figure 7 can be assigned to "any number of cursor movement and control functions" including "cursor movement", a "select" function, a "drag" function, a "double-click" function, a click of a middle button, a right mouse button click, a "multi-sequence function", such as scrolling, an "ink" function, and the "entry of variable values". *See* 13:1-57. The listed control functions themselves were well known to practitioners at the time the application for the '352 patent was filed, and they all existed in the prior art. The select, drag, double-click, middle button click, and right mouse button click functions all had standardized representations both at the device level and at the host system software level which involved setting and clearing single data bits either in data packets reported by the device to the host, or in data structures in the host memory. The cursor movement, scroll, ink and entry of variable values functions also all had well known standardized representations both at the device data packet level and at the host system software level which involved setting one or two (in the case of the cursor coordinates) variables in a the standardized data structure.

32. The patent provides Figs. 8 and 9 as an example of a flowchart illustrating the software or firmware to perform the claimed function, which it also states is analogous to the flowcharts of Figs. 5 and 6. In particular, Figs. 8 and 9 illustrate the sticky dragging gesture illustrated in Figs. 7F-1 and 7F-2, but is "applicable to the remaining functions". 13:59-61. One of ordinary skill in the art would understand Figs. 8 and 9 to be an example, and would know how to adapt or modify the flowcharts shown to reflect the particular sensing devices, host computer and application programs to implement an appropriate control function.

33. The patent also explains that the function of selecting an appropriate control function, like the other aspects of the claimed invention, can be performed in firmware running on the microcontroller 60, but can also be implemented as software running on the host, 15:74-16:5, or in hardware logic. 7:1-3.

34. In addition to hardware, software or firmware implementing the necessary steps, the patent also discloses that the sensing hardware is associated with this function. The processing of Fig. 8 starts at step 405 to "scan the conductors; store in RAM." Fig. 8-1; 14:3-6. The patent states that this step is achieved using the multiplexer, capacitance measuring circuit, and A/D convertor under the control of the microcontroller 60. "Under the control of microcontroller 60, the analog multiplexor 45 selects which traces of the matrix 30 will be sampled, and the output of those traces is then supplied to a capacitance measuring circuit 70." 5:32-35. The A/D converter supplies the signal to the microcontroller to "form, among other things, a finger profile for one or more fingers, X-Y cursor data, and control signals." 5:50-52. The repetitive scanning of the touchpad generates "...a series of scans in which one or more fingers [are] found to be either present or absent in any given scan, with motion, or lack thereof, of the finger or fingers across the touch sensor interspersed between changes in the number of fingers in contact with the touchpad." 12:5-9. In light of this extensive disclosure of methods of selecting an appropriate control function based on a user's contacts with the touch pad, and the knowledge of those skilled in the art in the area of integrating input devices to host programs, it is my opinion that the '352 patent

	discloses ample structure corresponding to the function of "selecting a control function based upon a combination of a number of fingers detected, an amount of time said fingers are detected, and any movement of said fingers." [3] As an example, the '218 patent which describes methods to generate button values based on the timing and duration of finger contact with a touchpad is prior art to the '352 patent.

Compare Exh. A [Feb. 22, 2010 Dezmelyk Summary] *with* Exh. D [May 7, 2010 Dezmelyk Declaration]. All told, Mr. Dezmelyk's new opinions are starkly and substantively different from those he offered before.

C.   Elan's Untimely Expert Opinions Should Be Stricken

The Federal Circuit has confirmed that the Patent Local Rules are "essentially a series of case management orders" and "[t]he court may impose any 'just' sanction for the failure to obey a scheduling order, including 'refusing to allow the disobedient party to support or oppose designated claims or defenses, or prohibiting that party from introducing designated matters in evidence.' Fed. R. Civ. P. 16(f); Fed. R. Civ. P. 37(b)(2)(B)." *O2 Micro*, 467 at 1363. In *O2 Micro*, the Federal Circuit upheld the district court's exclusion of theories in an expert report that were beyond the scope of the infringement contentions. *See id.* at 1369; *see also Trilogy Communications, Inc. v. Times Fiber Communications, Inc.,* 109 F.3d 739, 745 (Fed. Cir. 1997) ("Rule 16(b) of the Federal Rules of Civil Procedure authorizes a district court to control and expedite pretrial discovery through a scheduling order, and may prohibit a party that violates a scheduling order from introducing designated matters in evidence."); *Anchor Wall Systems, Inc. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298 (Fed. Cir. 2003) (affirming district court order striking untimely expert report).

The same result is warranted where a party fails to timely disclose expert opinions on claim construction. By any measure, Elan's proffer of Mr. Dezmelyk's untimely claim construction declaration has violated the very premise underlying the Patent Local Rules. The Patent Local Rules plainly require that the parties must disclose by the time of the Joint Claim Construction Statement "[w]hether any party proposes to call one or more witnesses at the Claim

Construction Hearing, the identity of each such witness, and for each witness, a summary of his or her testimony ***including, for any expert, each opinion to be offered related to claim construction.***" Patent L.R. 4-3(e). It is beyond dispute that Elan's late-filed claim construction expert report offers new opinions related to claim construction after that date.

Elan's failure to comply with this requirement is not a mere technicality. In violating the Patent Local Rules schedule, Elan has prejudiced not only Apple but the Court. Apple has not had an opportunity to depose Mr. Dezmelyk concerning the opinions expressed in his May 7 declaration. Thus, Apple has not had the opportunity to test Mr. Dezmelyk's new opinions to highlight issues that the Court may wish to focus on during claim construction, let alone to reveal further inconsistencies in Mr. Dezmelyk's opinions for the Court to consider as part of its reasoned claim construction analysis. *See Phillips*, 415 F.3d at 1318. The prejudice to Apple—and this Court's claim construction proceedings—is self-evident. The cure for that prejudice is to strike Elan's new declaration and hold Elan to the expert opinions it timely disclosed. *See In re Static Random Access Memory (SRAM) Antitrust Litigation*, 257 F.R.D. 580, 581, 585 (N.D. Cal. 2009) (precluding experts from submitting new opinions or analyses with reply brief, and precluding reliance on late-disclosed information, where "Defendants were prejudiced by these violations in preparing for and conducting the depositions of [the experts] and in preparing the opposition to Plaintiffs' Motion"); *Internet Servs. LLC v. Immersion Corp.*, 2008 WL 2051028, at *2 (N.D. Cal. May 13, 2008) (striking untimely "rebuttal" expert report used to support summary judgment motion where report would require additional expert discovery and would likely delay trial).

III.

CONCLUSION

For the foregoing reasons, Apple respectfully requests that the Court grant its Motion To Strike Paragraphs 26-34 Of The Claim Construction Declaration Of Robert Dezmelyk.

Dated: June 2, 2010   WEIL, GOTSHAL & MANGES LLP

                                              By: /s/ *Matthew D. Powers*

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