

EXHIBIT A

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9 Apple Inc.

10 UNITED STATES DISTRICT COURT
11 NORTHERN DISTRICT OF CALIFORNIA
12 SAN JOSE DIVISION

13 ELAN MICROELECTRONICS
14 CORPORATION,

15 Plaintiff and Counterclaim
16 Defendant,

17 v.

18 APPLE INC.,

19 Defendant and Counterclaim
20 Plaintiff.

Case No. C-09-01531 RS

APPLE INC.'S PATENT L.R. 3-1
DISCLOSURE OF ASSERTED CLAIMS
AND INFRINGEMENT CONTENTIONS
FOR U.S. PATENT NOS. 5,764,218,
7,495,659, AND 6,933,929

Hon. Richard Seeborg

1 In accordance with Patent L.R. 3-1, Apple Inc. ("Apple") hereby makes the
2 following Disclosure of Asserted Claims and Infringement Contentions for U.S. Patent Nos.
3 5,764,218 ("the '218 patent"), 7,495,659 ("the '659 patent"), and 6,933,929 ("the '929 patent").
4 These disclosures are made based on information ascertained to date, and Apple reserves the right
5 to modify or amend the disclosures contained herein as appropriate as the case progresses.

6 **A. Patent L.R. 3-1(a) Disclosures**

7 Based upon presently known information, Apple contends that at least Claim 5 of
8 the '218 patent has been infringed by Elan Microelectronics Corporation ("Elan") under 35
9 U.S.C. 271(a)-(c). Based upon presently known information, Apple contends that at least Claims
10 1-3 of the '218 patent have been infringed by Elan under 35 U.S.C. 271(b)-(c).

11 Based upon presently known information, Apple contends that at least Claims 1-2,
12 6, 8, 10, 12, 13 of the '659 patent have been infringed by Elan under 35 U.S.C. 271(a)-(c).

13 Based upon presently known information, Apple contends that at least Claims 10-
14 13, 15-17 of the '929 patent have been infringed by Elan under 35 U.S.C. 271(b).

15 Apple reserves the right to update its infringement contentions to reflect the results
16 of its investigation and of discovery in this matter.

17 **B. Patent L.R. 3-1(b) Disclosures**

18 Based on information presently known, Apple asserts infringement of Claims 1-3
19 and 5 of the '218 patent, Claims 1-2, 6, 8, 10, 12, and 13 of the '659 patent and Claims 10-13 and
20 15-17 of the '929 patent by Elan's Smart-Pad and Smart-Pad assembly and related components.

21 Apple reserves the right to update its infringement contentions to reflect the results
22 of its investigation and of discovery in this matter.

23 **C. Patent L.R. 3-1(c) Disclosures**

24 Charts that identify where each limitation of each asserted claim of the '218
25 patent, '659 patent and '929 patent are found within the accused products are attached hereto as
26 Attachments A-1, A-2, and A-3, respectively.

27 Apple reserves the right to update its infringement contentions to reflect the results
28 of its investigation and of discovery in this matter.

1 **D. Patent L.R. 3-1(d) Disclosures**

2 Based on information presently known, Apple alleges the following with respect to
3 Elan's indirect infringement of the '218, '659 and '929 patents.¹

4 Elan designs, markets, manufactures and sells touch-sensitive input devices or
5 touchpads, including the Smart-Pad product. Laptop computers including Elan touchpads and
6 related components are available for purchase throughout the United States, including in this
7 judicial district. These products are available for purchase in this judicial district from retailers,
8 distributors and middle-men, including for example, at retail outlets (e.g., Best Buy) and on the
9 internet (e.g., www.amazon.com). Upon information and belief, Elan touchpads and related
10 components are used by consumers and users of the laptop computers including such touchpads
11 and components throughout the United States, including in this judicial district.

12 Upon information and belief, Elan markets, sells and supports its touch-sensitive
13 input devices or touchpads and related components in the United States directly and through its
14 agent Elan Information Technology Group ("EITG"). EITG is Elan's wholly-owned subsidiary,
15 with its principle place of business in this judicial district. *See* Order Denying Defendant Elan
16 Microelectronics' Motion to Dismiss in *Agilent Technologies, Inc. v. Elan Microelectronics*
17 *Corp.*, Case No. 04-5385-JW (N.D. Cal. Nov. 29, 2005). Elan maintains a "worldwide network
18 of sales channels and technical support," including in North America. *Id.* EITG is the North
19 American hub for that network. *Id.* Elan's co-founder, chief-engineer and head of R&D served
20 as President and registered agent of EITG. *Id.* EITG directly purchases products from Elan and
21 turns around to sell them to California companies. *Id.* Elan has caused its products to be
22 imported into the United States, specifically to the Northern District of California. *Id.* Elan
23 maintains a continuous business relationship with the United States through its EITG office. *Id.*
24 Elan directs its customers in North America to contact EITG for products and services. *Id.*

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27 ¹ Although Elan denies certain of these allegations, Apple believes that discovery will
28 confirm them.

1 Elan admits that it has had knowledge of Apple's '218, '659 and '929 patents at
2 least as early as July 1, 2009.

3 Elan indirectly infringes Claims 1-3 and 5 of the '218 patent. Manufacturers and
4 others in the distribution channel of laptop computers directly infringe these claims by using,
5 selling, offering for sale, or importing into the United States laptop computers that include Elan's
6 Smart-Pad. Elan contributes to and induces the infringement of the asserted claims of the '218
7 patent through its provision and intentional marketing, sale and/or support, including technical
8 support, of its Smart-Pad in the United States, including through its agent EITG, and through the
9 intentional design, marketing, manufacture, sale and/or support, including technical support, of
10 Elan's products abroad to induce direct infringement in the United States. Elan supplies its
11 Smart-Pad and actively encourages the use, sale, offer for sale and/or importation in the United
12 States of Elan's products, including through the promotion and provision of software drivers and
13 marketing literature that induces and results in direct infringement. Elan has known or should
14 have known that these actions would cause direct infringement of the '218 patent and did so with
15 specific intent to encourage direct infringement.

16 Elan indirectly infringes Claims 1-2, 6, 8, 10, 12, and 13 of the '659 patent.
17 Manufacturers and others in the distribution channel of laptop computers directly infringe these
18 claims by using, selling, offering for sale, or importing into the United States laptop computers
19 that include Elan's Smart-Pad. Elan contributes to and induces the infringement of the asserted
20 claims of the '659 patent through its provision and intentional marketing, sale and/or support,
21 including technical support, of its Smart-Pad in the United States, including through its agent
22 EITG, and through the intentional design, marketing, manufacture, sale and/or support, including
23 technical support, of Elan's products abroad to induce direct infringement in the United States.
24 Elan supplies its Smart-Pad and actively encourages the use, sale, offer for sale and/or
25 importation in the United States of Elan's products, including through the promotion and
26 provision of touchpads and related controllers and marketing literature that induces and results in
27 direct infringement. Elan has known or should have known that these actions would cause direct
28 infringement of the '659 patent and did so with specific intent to encourage direct infringement.

1 Elan indirectly infringes Claims 10-13 and 15-17 of the '929 patent.²
2 Manufacturers and others in the distribution channel of laptop computers directly infringe these
3 claims by using, selling, offering for sale, or importing into the United States laptop computers
4 that include Elan's Smart-Pad. Elan induces that infringement through its intentional marketing,
5 sale and/or support of Elan's Smart-Pad in the United States, including through its agent EITG,
6 and through the intentional design, marketing, manufacture, sale and/or support of Elan's
7 products abroad to induce direct infringement in the United States. Elan's inducement includes
8 active encouragement, participation and/or assistance in the design and manufacture of touchpad
9 systems or housing assemblies that infringe the '929 patent as part of its activities in conjunction
10 with the manufacture, marketing, sale and support of touchpads employed in such systems or
11 housing assemblies in laptop computers. Elan has known or should have known that these
12 actions would cause direct infringement of the '929 patent and did so with specific intent to
13 encourage direct infringement.

14 Apple reserves the right to update its infringement contentions to reflect the results
15 of its investigation and of discovery in this matter.

16 **E. Patent L.R. 3-1(e) Disclosures**

17 Based on presently known information, Apple contends that the products identified
18 in response to Patent L.R. 3-1(b) literally infringe the asserted claims. In addition, Apple
19 contends that the products identified in response to Patent L.R. 3-1(b) infringe the asserted claims
20 under the doctrine of equivalents.

21 **F. Patent L.R. 3-1(f) Disclosures**

22 Based on presently known information, all of the asserted claims of the '218 patent
23 are entitled to a priority date at least as early as January 31, 1995, based on U.S. Application No.
24 08/381,471.

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27 ² As explained in Apple's Second Amended Answer, pursuant to Rule 11(b)(3), Apple
28 expects that further investigation or discovery will confirm the truth of the statements herein
relating to the '929 patent.

1 Based on presently known information, all of the asserted claims of the '659 patent
2 are entitled to a priority date at least as early as November 25, 2003, based on U.S. Application
3 No. 10/722,948.

4 Based on presently known information, all of the asserted claims of the '929 patent
5 are entitled to a priority date at least as early as May 14, 1999, based on U.S. Provisional
6 Application No. 60/134,084.

7 Apple reserves the right to update its infringement contentions to reflect the results
8 of its investigation and of discovery in this matter.

9 **G. Patent L.R. 3-1(g) Disclosures**

10 Based on presently known information, and as will be further specified as
11 discovery proceeds, Apple believes that the claimed subject matter of each asserted claim of the
12 '218 patent is embodied by products sold by Apple, including versions of Apple laptop computers
13 such as the iBook, MacBook, MacBook Pro, and MacBook Air with touchpads able to distinguish
14 between multiple cursor control operations by detecting contact and gap intervals, and with
15 respect to claims 1 and 5, versions of the iPhone and iPod Touch with touchpads able to
16 distinguish between multiple cursor control operations by detecting gap and contact intervals, in
17 accordance with the claims.

18 Based on presently known information, and as will be further specified as
19 discovery proceeds, Apple believes that the claimed subject matter of at least asserted claims 1-2,
20 10, 12, 13 of the '659 patent is embodied by products sold by Apple, including versions of
21 Apple's iPod Classic after the third generation and versions of the iPod Nano and iPod Mini with
22 touchpad assemblies that map a touchpad into native coordinates and adjusts those coordinates
23 into logical device units to be filtered and reported to the host device, in accordance with the
24 claims.

25 Based on presently known information, and as will be further specified as
26 discovery proceeds, Apple believes that the claimed subject matter of at least asserted claims 10-
27 12 of the '929 patent is embodied by products sold by Apple, including versions of Apple laptop
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1 computers such as the MacBook Pro and the MacBook Air with a touchpad that rests in a recess
2 in the housing of the computer, in accordance with the claims.

3 Apple reserves the right to update its infringement contentions to reflect the results
4 of its investigation and of discovery in this matter.

5 **H. Patent L.R. 3-1(h) Disclosures**

6 Based on presently known information, Apple does not currently allege willful
7 infringement of the '218, '659, or '929 patents.

8 Apple reserves the right to update its infringement contentions to reflect the results
9 of its investigation and of discovery in this matter.

10 **I. Patent L.R. 3-2 Document Production**

11 Based on presently known information, and as will be further specified as
12 discovery proceeds, Apple provides the following documents pursuant to Patent L.R. 3-2(a):
13 APEL0006456-APEL0006464.

14 Based on presently known information, and as will be further specified as
15 discovery proceeds, Apple provides the following documents pursuant to Patent L.R. 3-2(b):
16 APEL0006465-APEL0006475.

17 Based on presently known information, and as will be further specified as
18 discovery proceeds, Apple provides the following documents pursuant to Patent L.R. 3-2(c):
19 APEL0001021-APEL0006402.

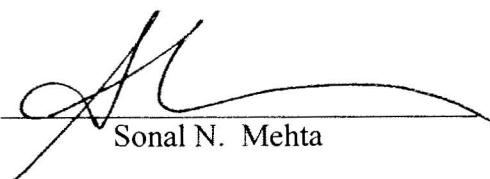
20 Based on presently known information, and as will be further specified as
21 discovery proceeds, Apple provides the following documents pursuant to Patent L.R. 3-2(d):
22 APEL0006403-APEL0006455.

23 Based on presently known information, and as will be further specified as
24 discovery proceeds, Apple provides the following documents pursuant to Patent L.R. 3-2(e):
25 APEL0006487-APEL0006496.

26 Apple reserves the right to update its document production to reflect the results of
27 its investigation and of discovery in this matter.
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1 Dated: October 22, 2009

WEIL, GOTSHAL & MANGES LLP

2
3 By: 
4 Sonal N. Mehta

5 Attorney for Defendant and
6 Counterclaim Plaintiff Apple Inc.
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1 **CERTIFICATE OF SERVICE**

2 I declare that I am employed with the law firm of Weil, Gotshal & Manges LLP,
3 whose address is 201 Redwood Shores Parkway, Redwood Shores, California 94065-1175. I am
4 not a party to the within cause, and I am over the age of eighteen years. I further declare that on
5 October 22, 2009, I served a copy of:

6 **APPLE INC.'S PATENT L.R. 3-1 DISCLOSURE OF**
7 **ASSERTED CLAIMS AND PRELIMINARY INFRINGEMENT CONTENTIONS**
8 **FOR U.S. PATENT NOS. 5,764,218, 7,495,659, AND 6,933,929**

9 ☐ **BY U.S. MAIL** by placing a true copy thereof enclosed in a sealed
10 envelope with postage thereon fully prepaid, addressed as follows, for collection and mailing in
11 accordance with the firm's ordinary business practices. I am readily familiar with the practice for
12 collection and processing of mail, and know that in the ordinary course of business practice that
13 the document(s) described above will be deposited with the U.S. Postal Service on the same date
14 as sworn to below.

15 ☒ **BY ELECTRONIC SERVICE** by electronically mailing a true and
16 correct copy through the electronic mail system to the email address(es) set forth in the service
17 list below.

18 ☐ **BY OVERNIGHT DELIVERY** by placing a true copy thereof enclosed
19 in a sealed envelope with overnight delivery fees provided for, addressed as follows, for
20 collection by Federal Express in accordance with ordinary business practices. I am readily
21 familiar with the practice for collection and processing of correspondence for overnight delivery
22 and know that in the ordinary course of business practice the document(s) described above will be
23 deposited by an employee or agent in a box or other facility regularly maintained by Federal
24 Express for collection on the same day that the document(s) are deposited.

25 ☐ **BY PERSONAL SERVICE** by placing a true copy thereof enclosed in a
26 sealed envelope to be delivered by messenger to the offices of the addressee(s) (and left with an
27 employee or person in charge of addressee's office), as stated below, during ordinary business
28 hours.

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29 I declare under penalty of perjury under the laws of the United States of America
30 that the foregoing is true and correct.

31 Executed on October 22, 2009, at Redwood Shores, California.

32 
33 Sonal N. Mehta