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 11 Apple Inc.

12 UNITED STATES DISTRICT COURT
 13 NORTHERN DISTRICT OF CALIFORNIA
 14 SAN JOSE DIVISION

15 ELAN MICROELECTRONICS
 CORPORATION,
 16
 17 Plaintiff and Counterclaim
 Defendant,
 18 v.
 19 APPLE INC.,
 20 Defendant and Counterclaim
 21 Plaintiff.

Case No. C-09-01531 RS (PVT)
**UNOPPOSED MOTION FOR LEAVE
 TO AMEND INVALIDITY
 CONTENTIONS**
 JURY TRIAL DEMANDED
 DATE: October 26, 2010
 TIME: 10:00 a.m.
 JUDGE: Patricia V. Trumbull
 CTRM: 5, 4th Floor

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**APPLE’S UNOPPOSED MOTION
FOR LEAVE TO AMEND INVALIDITY CONTENTIONS**

Pursuant to Patent L.R. 3-6, Apple Inc. (“Apple”) files this Unopposed Motion for Leave to Amend Its Invalidity Contentions to add the below-listed prior art references that Apple’s legal team has recently discovered and analyzed, and to further clarify Apple’s obviousness and indefiniteness contentions. Elan Microelectronics Corp. (“Elan”) does not oppose Apple’s motion.

I. APPLE PROVIDED ELAN TIMELY NOTICE OF ITS SUPPLEMENTAL INVALIDITY CONTENTIONS

Apple provided timely notice to Elan of Apple’s supplemental invalidity contentions. Apple provided its First Supplemental Invalidity Contentions to Elan on June 22, 2010. *See* Declaration of Sonal Mehta in Support of Apple’s Unopposed Motion for Leave to Amend Invalidity Contentions (“Mehta Decl.”), Exh. A [Email chain from S. Mehta to S. DeBruine including June 22, 2010, June 25, 2010, and August 23, 2010 emails]; *see also* Exh. B [Apple Inc.’s First Supplemental Invalidity Contentions]. Elan responded on June 25, 2010 that it was reviewing Apple’s amended invalidity contentions, did not expect to object, and expected to propose its own supplemental invalidity contentions within a week for possible inclusion in a joint motion. *See* Mehta Decl., Exh. A. However, Elan did not provide its proposal the following week or at any time thereafter. Apple therefore stated on August 23, 2010 that it intended to proceed with a motion to amend its invalidity contentions, which it understood would be unopposed. *Id.* Elan has not stated any opposition to this motion.

II. APPLE HAS GOOD CAUSE TO AMEND ITS INVALIDITY CONTENTIONS

Since serving its original Invalidity Contentions pursuant to Patent L.R. 3-3 on December 7, 2009, Apple’s legal team has continued to search for, locate, and analyze prior art relevant to the patents-in-suit, including the following references:

U.S. Patent No. 5,825,352

- Stansfield. Haptic Perception With an Articulated, Sensate Robot Hand, (Mar. 1990)(“Haptic Perception”)

- 1 • Rubine et al., Programmable Finger-tracking Instrument Controllers, Computer Music Journal, Vol. 14, No. 1, Spring 1990 (“Finger-tracking”)
- 2 • JP06-161661 (June 10, 1994)
- 3 • BOIE0011-33 (Nov. 18, 1983) (“BOIE0011”)
- 4 • U.S. Pat. No. 5,483,261, Yasutake, Jan. 9, 1996
- 5 • U.S. Pat. No. 4,914,624, Dunthorn Apr. 3, 1990
- 6 • Son et al., Comparison of contact sensor localization abilities during manipulation, Robotics and Autonomous System 17 (1996), p. 217-233, (“Contact Sensor Localization”)
- 7 • Myron Krueger, Videoplacement, Responsive Environment, 1972-1990s, www.youtube.com/watch?v=dmmxVA5xhuo (“Krueger”)
- 8 • Rubine, Automatic Recognition of Gestures, Thesis, Carnegie Mellon University (1991) (“Rubine Thesis”).

9 U.S. Patent No. 7,274,353

- 10 • U.S. Pat. No. 5,468,947, Danielson, Nov. 21, 1995
- 11 • GB 2,327,558, Charlier, Jan. 27, 1999
- 12 • Pogue, Palm Pilot, the Ultimate Guide, O’Reilly, pp. 1-597 (Jun. 1999) (“Pogue”)
- 13 • Newton MessagePad 2000 User’s Manual, pp. 1-278 (1997) (“Newton”)
- 14 • U.S. Pat. No. 5,233,547, Kapp, Aug. 3, 1993
- 15 • Wacom Intuos User’s Manual for Windows, May 22, 2000 (“Wacom”)

16 Apple is timely seeking leave to amend its invalidity contentions based on this newly
17 located prior art and Apple’s amendment will not prejudice Elan. Some of the newly located
18 prior art provides further details regarding prior art systems that Apple disclosed as prior art in its
19 original invalidity contentions. For example, Apple disclosed the Boie System in its original
20 invalidity contentions. The additional Boie documents referenced in Apple’s amended
21 contentions were produced by third party Robert Boie on June 21, 2010. Apple analyzed the Boie
22 documents and provided its amended contentions to Elan on the following day, June 22, 2010.
23 Other prior art was located during the course of Apple’s continuing investigation in this case. *See*
24 *Mehta Decl.* ¶ 3.

25 In addition to the identification of new art, Apple’s supplemental invalidity contentions
26 provide further clarification as to Apple’s contentions. Specifically, Apple’s supplemental
27 contentions provide greater specificity as to the combinations of prior art that Apple may rely
28 upon to show obviousness under Section 103 and the bases for those combinations. Apple’s
supplemental contentions also update and clarify Apple’s indefiniteness positions in view of the
parties’ claim construction disclosures.

1 Elan will not be unfairly prejudiced by Apple's supplemental invalidity contentions.
2 Apple disclosed the additional prior art around the time of the claim construction hearing in this
3 case and while there is an opportunity for Elan to take discovery related to the additional
4 references and invalidity theories set forth in Apple's supplemental contentions. Moreover, there
5 is no fact discovery cutoff, no expert discovery cutoff, and no trial date set in this case yet. In
6 addition, the amended contentions will not create any additional burden on the Court. Apple's
7 amended contentions will not affect any pending or previously decided motion.

8 **III. CONCLUSION**

9 For the reasons stated, Apples respectfully requests that the Court enter an Order granting
10 Apple's Unopposed Motion for Leave to Amend Its Invalidity Contentions to add the above-cited
11 prior art references to its contentions.

12
13 Dated: September 20, 2010

WEIL, GOTSHAL & MANGES LLP

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15 By: /s/ Nathan Greenblatt
16 Nathan Greenblatt
17 Attorneys for 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 September 20, 2010 , I served a copy of:

6 **UNOPPOSED MOTION FOR LEAVE TO AMEND INVALIDITY**
7 **CONTENTIONS**

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

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

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

24 Sean DeBruine
25 Alston + Bird LLP
26 Two Palo Alto Square
27 3000 El Camino Real
28 Palo Alto, CA 94306
Sean.Debruine@Alston.com

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 September 20, 2010, at Redwood Shores, California.

32 /s/ Judi Tallet
33 Judi Tallet