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 11 ELAN MICROELECTRONICS
 CORPORATION

12
 13 UNITED STATES DISTRICT COURT
 14 NORTHERN DISTRICT OF CALIFORNIA
 15 SAN JOSE DIVISION
 16

17 ELAN MICROELECTRONICS
 18 CORPORATION,
 19 Plaintiff,
 20 v.
 21 APPLE, INC.,
 22 Defendant.

Case No. 09-cv-01531 RS (PVT)

**DECLARATION OF SEAN P.
 DEBRUINE IN SUPPORT OF ELAN'S
 UNOPPOSED MOTION FOR LEAVE
 TO AMEND INVALIDITY
 CONTENTIONS PURSUANT TO
 PATENT L.R. 3-6**

JURY TRIAL DEMANDED

23
 24 AND RELATED COUNTERCLAIMS
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 26
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 28

DATE: November 30, 2010
 TIME: 10:00 a.m.
 JUDGE: Patricia V. Trumbull
 CTRM: 5, 4th Floor

1 I, Sean DeBruine, declare:

2 I am a partner with the law firm of Alston & Bird, LLP, counsel for Plaintiff and Counter-
3 Defendant Elan Microelectronics Corporation (“Elan”) in the above-captioned matter. I submit
4 this declaration based on personal knowledge and following a reasonable investigation. If called
5 upon as a witness, I could competently testify to the truth of each statement herein.

6 1. Pursuant to Pat. L.R. 3-3, on December 7, 2009 Elan served Apple with Elan’s
7 Invalidation Contentions concerning Apple’s asserted U.S. patents no. 5,764,218 (“the ’218 patent”),
8 7,495,659 (“the ’659 patent”) and 6,933,929 (“the ’929 patent”). On May 25, 2010 Apple filed its
9 Third Amended Answer and Counterclaims [Dkt. No. 96] in which Apple dropped its allegation
10 that Elan was infringing the ‘929 patent.

11 2. Elan’s December 7, 2009 Invalidation Contentions disclosed the prior invention, sale,
12 offer for sale and public use Cirque Corporation GlidePoint product as invalidating prior art to the
13 ‘218 patent, and the *GlidePoint User’s Guide* as an invalidating publication. During a previous
14 case, Elan had taken discovery of Cirque. That discovery, including source code produced by
15 Cirque and discussed by its deposition witnesses, was designated as “Attorneys’ Eyes Only.” As
16 of the parties’ initial invalidity contentions the Stipulated Protective Order had not yet been
17 entered, Elan did not disclose the details of the confidential Cirque materials in those disclosures.
18 Upon entry of the Protective Order Elan produced the confidential discovery, including source
19 code and deposition transcripts for the Cirque witnesses, as well as Elan’s invalidity contentions
20 applying that evidence to claims asserted in the previous litigation that are very similar to the
21 asserted claims of Apple’s ‘218 patent in this matter.

22 3. In its December 7, 2009 Invalidation Contentions Elan also disclosed various
23 products and publications from MicroTouch Systems, Inc. as prior art. On April 28, 2010,
24 pursuant to a subpoena served by Elan to 3M Inc., the current owner of MicroTouch produced
25 documents to Elan and Apple. Several of those documents evidence additional prior art relevant
26 to the asserted Apple patents.

27 4. U.S. patent 5,463,388 to Boie *et al* (“the ’388 patent”) was cited by the PTO during
28 prosecution of Elan’s asserted ’352 patent. Upon further review of the ’352 file history last

1 spring, it became apparent that the '388 patent was also relevant prior art to Apple's '218 patent.
2 On April 22, 2010 in an email to Ms. Sonal Mehta, Esq., Apple's counsel, I notified Apple of its
3 intention to supplement its invalidity contentions to disclose the '388 patent and provide the
4 proposed amended invalidity contentions and claim chart. A true and correct copy of that email is
5 attached hereto as Exhibit A.

6 5. Elan's Preliminary Invalidity Contentions also asserted a patent granted to
7 Synaptics, Inc. as prior art to Apple's '659 patent. Upon further investigation, Elan concluded that
8 another Synaptics patent, U.S. Patent No. 5,943,052 is also additional prior art. Elan's
9 Supplemental Contentions add analysis of that new Synaptics patent.

10 6. Two months after Elan proposed that the parties stipulate to Elan's proposed
11 amended invalidity contentions, Apple proposed amending its contentions. Attached as Exhibit B
12 is a true and correct copy of an email chain between Ms. Sonal Mehta and myself, which includes
13 emails dated June 22, 2010, June 25, 2010, and August 23, 2010. As set forth in that email
14 correspondence, Elan agreed with that proposal, and indicated that it anticipated it would further
15 amend its contentions. In June, 2010 the parties prepared for and participated in the Claim
16 Construction Hearing in this matter, and in August 2010 the parties conducted a Claim
17 Construction hearing in the parallel International Trade Commission investigation. For these and
18 other reasons the matter of amended invalidity contentions was not pursued further by the parties.

19 7. On September 20, 2010 Apple filed its Unopposed Motion for Leave to Amend
20 Invalidity Contentions.

21 8. On October 12, 2010 Elan provided its current proposed Amended Invalidity
22 Contentions. Apple initially agreed that the parties stipulate to each other's proposed amended
23 invalidity contentions. Attached as Exhibit C is a true and correct copy of an email chain between
24 Ms. Sonal Mehta and my colleague Ms. Jane Bu between October 12 to October 20, 2010,
25 reflecting that agreement. However, on October 18, 2010 the Court granted Apple's Unopposed
26 Motion for Leave to File its amended contentions. As such, Apple indicated that it would no
27 longer stipulate, but that it would not oppose Elan's motion.

28 I declare under the penalty of perjury under the laws of the United States of America that

1 the foregoing is true and correct.

2 Executed on October 25, 2010, at Menlo Park, California.

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/s/ Sean P. DeBruine
Sean P. DeBruine

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