

EXHIBIT 46

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ELAN MICROELECTRONICS CORPORATION

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

16 ELAN MICROELECTRONICS CORPORATION,

17 Plaintiff,

18 v.

19 APPLE, INC.,

20 Defendant.

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28)
AND RELATED COUNTERCLAIMS

) Case No. 5:09-cv-01531-RS

)
) **ELAN MICROELECTRONICS CORPORATION'S DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT CONTENTIONS**

1 Plaintiff Elan Microelectronics Corporation (“Elan”) submits its Disclosure of Asserted Claims
2 and Infringement Contentions regarding infringement of Elan’s U.S. Patent No. 5,825,352 (“the ‘352
3 patent”) and U.S. Patent No. 7,274,353 (“the ‘353 patent”) (collectively “Elan’s patents”) in accordance
4 with Patent Local Rule 3-1 and the Joint Case Management Statement and Order. Discovery is ongoing
5 in this matter between Elan and the Defendant Apple, Inc. (“Apple”), and, therefore, Elan reserves its
6 right to amend its disclosure of asserted claims and infringement contentions.

7 **I. THE CLAIMS ASSERTED TO BE INFRINGED**

8 Pursuant to Patent L. R. 3-1(a), Elan presently asserts that Apple has been and is now infringing
9 Elan’s ‘352 and ‘353 patents. Specifically, Elan believes that Apple has been or is now infringing at
10 least claims 1-2, 4, 7, 10, 12, 14, 16, 18-19, 21, 24, 26, and 30 of the ‘352 patent (“asserted claims of
11 ‘352 patent”) and claims 1, 3-4, 6-7, 9-10, and 12 of the ‘353 patent (“asserted claims of the ‘353
12 patent”). Discovery is ongoing between Elan and Apple and other claims may be found to infringe
13 Elan’s patents. Accordingly, Elan reserves its right to assert additional claims of Elan’s patents upon
14 completion of discovery in this matter.

15 **II. THE ACCUSED INSTRUMENTALITIES**

16 Pursuant to Patent L. R. 3-1(b), Elan asserts that certain of Apple’s MacBook, MacBook Pro,
17 MacBook Air, iBook G4, PowerBook G4, iPhone, iPod touch, and Magic Mouse products or product
18 families directly or indirectly infringe some or all of the asserted claims of the ‘352 patent. Those
19 families of Apple’s products that Elan contends to infringe the asserted claims of the ‘352 patent include
20 at least MacBook series or family, including but not limited to MacBook, MacBook Air, and MacBook
21 Pro, iBook G4 (Mid 2005) series, and at least the PowerBook G4 series or family released after
22 February 2005, iPhone series or family, including but not limited to iPhone, iPhone 3G, and iPhone
23 3GS, iPod touch series or family, and Magic Mouse series or family.

24 Elan further asserts that Apple’s iPhone and iPod touch products or product families directly or
25 indirectly infringe the asserted claims of the ‘353 patent. Those families of Apple products that Elan
26 contends to infringe the asserted claims include at least iPhone series or family, including but not limited
27 to iPhone, iPhone 3G, and iPhone 3GS, and iPod touch series or family. Discovery is ongoing between
28 Elan and Apple and other instrumentalities may be identified to infringe the Elan’s patents.

1 Accordingly, Elan reserves its right to assert additional claims of the Elan's patents upon completion of
2 discovery in this matter.

3 **III. INFRINGEMENT CHARTS**

4 Pursuant to Patent L. R. 3-1(c)-(e), **Exhibits A-G** set forth where in each of the accused products
5 each element of the asserted claims is found. Elan believes that each element of each asserted claim is
6 found within each of the accused products of Apple in touchpad or touch screen devices or the
7 combination of touchpad or touch screen devices with associated hardware and instructions, including
8 software, firmware, and/or device driver. Elan contends that each element of each asserted claim is
9 literally present or at a minimum present under the doctrine of equivalents in each of the accused
10 products of Apple. Apple has directly infringed the asserted method claims through its own use of the
11 accused products and the end users of the accused products in the United States directly infringe. Apple
12 has contributed and induced the direct infringement of the asserted method claims by providing the
13 products necessary to practice the claimed methods and instructing end users to use them to perform the
14 claimed method with the intention that the users perform those patented methods.

15 Discovery is ongoing between Elan and Apple and accordingly Elan reserves the right to amend
16 or otherwise modify its identification if further relevant information is revealed or circumstances change.

17 **IV. PRIORITY DATE OF ELAN'S PATENTS**

18 Pursuant to Patent L. R. 3-1(e), the asserted inventions claimed in the '352 patent are entitled to a
19 priority date of at least January 4, 1996, when U.S. Patent Application No. 582,768 was filed and
20 submitted to the U.S. Patent and Trademark Office. The asserted inventions claimed in the '353 Patent
21 are entitled to a priority date of at least April 2, 2003, when application Taiwan Patent Application No.
22 92205217 U was filed to the Taiwan Intellectual Property Office.

23 **V. ELAN'S ASSERTED PRACTICE OF THE CLAIMED INVENTIONS**

24 Pursuant to Patent L. R. 3-1(g), Elan contends that at least Elan's KTP3, KTP5, KTP6, and
25 SmartPad touchpad products, practice at least claims 18-21, 24 and 28 of the '352 patent. When
26 incorporated into computer systems and used as intended, end users in the United States practice at least
27 method claims 1, 2, 6 and 7. Elan, at this time, does not intend to rely on the assertion that any of its
28 products practice the asserted claims of the '353 patent. Elan is still conducting its investigation into its

1 disclosures pursuant to Patent L.R. 3-1(g), and reserves the right to modify, amend, and/or supplement
2 the disclosures contained herein.

3 **VI. APPLE'S WILLFUL INFRINGEMENT**

4 Pursuant to Pat. L. R. 3-1(h), Elan alleges that Apple's infringement of the '352 patent has been
5 and continues to be willful. Apple was put on actual notice in August 2006 that its touchpad products
6 infringed the '352 patent. Despite knowing of the objectively high risk that it was infringing the patent,
7 Apple continued its infringing acts and, in fact, greatly expanded the number of product practicing the
8 patent claims. On information and belief Apple continued its infringing acts willfully or in reckless
9 disregard of Elan's patent rights.

10 **VII. ACCOMPANYING DOCUMENTS PRODUCTION**

11 Pursuant to Patent L. R. Rule 3-2, Elan is producing documents along with its disclosure of
12 asserted claims and infringement contentions.

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14 Respectfully Submitted,

15 Dated: October 22, 2009

ALSTON + BIRD LLP

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17 By: _____



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