

# EXHIBIT 1

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

13 ELAN MICROELECTRONICS  
CORPORATION,

14 Plaintiff and Counterclaim  
15 Defendant,

16 v.

17 APPLE INC.,

18 Defendant and Counterclaim  
19 Plaintiff.

Case No. C-09-01531 RS

APPLE INC.'S FIRST SET OF  
INTERROGATORIES TO ELAN  
MICROELECTRONICS  
CORPORATION  
(INTERROGATORY NOS. 1 - 17)

Hon. Richard Seeborg

Demand for Jury Trial

20 Pursuant to Federal Rules of Civil Procedure 26 and 33, Apple Inc. ("Apple")  
21 requests that Elan Microelectronics Corporation ("Elan") respond separately, fully, in writing,  
22 and under oath, to these interrogatories within 30 days after service hereof.  
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1 **DEFINITIONS AND INSTRUCTIONS**

2 1. "Apple" means Defendant and Counterclaim Plaintiff Apple Inc.

3 2. "Elan," "you," and "your" means Plaintiff and Counterclaim Defendant  
4 Elan Microelectronics Corporation, its predecessors and successors, past and present parents,  
5 subsidiaries, divisions, affiliates, and other organizational or operating units of any of the  
6 foregoing, and all past and present directors, officers, employees, agents, and representatives  
7 (including consultants and attorneys) of any of the foregoing.

8 3. "Elan Patents-in-Suit" means all patents asserted or to be asserted in the  
9 future by Elan in this action, including, without limitation, U.S. Patent Nos. 5,825,352 and  
10 7,274,353 individually and collectively.

11 4. "The '352 Patent" and "The '353 Patent" mean U.S. Patent No. 5,825,352  
12 and U.S. Patent No. 7,274,353 respectively.

13 5. "Apple Patents-in-Suit" means all patents asserted or to be asserted in the  
14 future by Apple in this action, including, without limitation, U.S. Patent Nos. 5,764,218,  
15 7,495,659, and 6,933,929 individually and collectively.

16 6. "The '218 Patent," "The '659 Patent," and "The '929 Patent" mean U.S.  
17 Patent No. 5,764,218, U.S. Patent No. 7,495,659, and U.S. Patent No. 6,933,929 respectively.

18 7. "Patents-in-Suit" means the Apple Patents-in-Suit and Elan Patents-in-Suit  
19 individually and collectively.

20 8. "Elan Accused Products" means touch-sensitive input devices or touch  
21 pads designed, marketed, manufactured, and/or sold by Elan, including but not limited to the  
22 Smart-Pad.

23 9. "Prior art" is used herein in the same sense that it is used in 35 U.S.C.  
24 §§ 102-103, and includes, without limitation, any patent or printed publication, or any prior  
25 knowledge, prior use, prior sale or offer for sale in the United States, or other act, event, or thing  
26 defined in 35 U.S.C. § 102, taken individually or in combination, including without limitation,  
27 any system, method, apparatus, publication, patent or use which has been cited to Elan by any  
28 person or entity as prior art.

1           10.    “Related Patents” means all patents and patent applications relating to any  
2 of the Elan Patents-in-Suit or Apple Patents-in-Suit, including any patents or patent applications  
3 (including all published and unpublished pending and abandoned applications) from or through  
4 which any of the Elan Patents-in-Suit or Apple Patents-in-Suit claim priority, any patents or  
5 patent applications (including all published and unpublished pending and abandoned applications)  
6 that claim priority from or through any of the Elan Patents-in-Suit or Apple Patents-in-Suit, and  
7 any foreign counterpart patents or patent applications (including all published and unpublished  
8 pending and abandoned applications) of any of the foregoing.

9           11.    “Communication” means any form of oral or written interchange, whether  
10 in person, by telephone, by facsimile, by telex, by electronic email, or by any other medium.

11           12.    “Document” shall be interpreted to the full extent permitted by the Federal  
12 Rules of Civil Procedure and includes, without limitation, e-mail, files stored on electronic media,  
13 copies of letters, notes and records of telephone conversations, intra-corporate communications,  
14 minutes, bulletins, specifications, instructions, advertisements, literature, patents, patent  
15 applications, specification sheets and diagrams, work assignments, reports, memoranda,  
16 memoranda of conversations, notes, notebooks, drafts, data sheets, work sheets, contracts and  
17 agreements, memoranda of agreements, assignments, licenses, sublicenses, opinions and reports  
18 of experts and consultants, books of account, orders, invoices, statements, bills, checks and  
19 vouchers, brochures, photographs, drawings, charts, catalogs, pamphlets, magazines, copies of  
20 magazines, decals, world-wide web and/or internet postings, trade letters, notices and  
21 announcements, and press releases, and all other printed, written, recorded, taped, electronic,  
22 graphic, computerized printout or other tangible materials of whatever kind known to, or in the  
23 possession, custody, or control of Elan. A draft or nonidentical copy is a separate document  
24 within the meaning of this term.

25           13.    The words “identify,” “identity,” and “identification” mean:

- 26           a.       as applied to an individual, state the individual’s full name; present  
27                    or last known address and telephone number; present or last known  
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employer; and present or last known business address and telephone number;

b. as applied to a document, state the type of document; date of the document; names of the individuals who drafted, authored, or signed the document; names of the individuals to whom the document or a copy thereof was addressed or sent; a summary of the subject matter of the document; the number of pages of the document; the present whereabouts of the document; the name and address of the current custodian; and the Bates number(s), if the document has been produced.

c. as applied to a patent or patent application, state the country where it was filed or granted; the patent or patent application number; the filing date; the dates of publication and issue, if any; the identity of all inventors; the title; and the identity of all related applications and patents.

d. as applied to oral communications, state the name of the person making the communication and the name(s) of the person(s) present while the communication was made, and, where not apparent, the relationship of the person(s) present to the person making the communication; the date and place of the communication; and a summary of the subject matter of the communication.

e. as applied to an event or chain of events, state the date(s) of each occurrence relevant to the event; identify all individuals having information concerning the event, including but not limited to those involved in witnessing, supervising, controlling, supporting, requesting, or otherwise participating in the event and/or those who can corroborate or refute the described circumstances of the event;

1 and describe the role and/or contribution of each person so  
2 identified.

3 14. "Concerning means relating or referring to, discussing, describing,  
4 summarizing, evidencing, or constituting.

5 15. The words "any," "all," and "each" shall mean any, all, each, and every.

6 16. The terms "and" and "or" should be understood as either conjunctive or  
7 disjunctive, whichever is necessary to bring within the scope of the interrogatory any responses  
8 that might otherwise have been understood to be outside its scope.

9 17. Use of the singular includes the plural and vice versa.

10 18. The term "person" refers to both natural persons and to corporate or other  
11 business entities (including Elan), whether or not in the employ of Elan, and the "acts" of a  
12 person (including Elan) are defined to include the acts of directors, officers, owners, members,  
13 employees, agents or attorneys acting on the person's behalf.

14 19. Pursuant to Federal Rules of Civil Procedure 26(e), these interrogatories  
15 are continuing in nature and therefore require Elan to furnish supplemental responses whenever it  
16 obtains different or additional knowledge, information, or belief relating to these interrogatories.  
17 These requests are being propounded in light of the discovery served thus far in this case. Apple  
18 stands ready to meet and confer to discuss the best and most efficient way to conduct discovery  
19 bilaterally.

20 20. If you withhold any information based upon a claim of privilege or any  
21 other claim of immunity from discovery, then state in writing in response the claim being asserted  
22 and describe the facts and circumstances giving rise to it in sufficient detail so as to permit  
23 defendants and declaratory relief claimants to evaluate, and the Court to adjudicate, the merits of  
24 the claim.

25 **INTERROGATORIES**

26 **INTERROGATORY NO. 1:**

27 Separately for each claim of the Elan Patents-in-Suit, describe in detail the  
28 conception and reduction to practice of the claimed invention and any acts of diligence, including

1 the dates on which Elan contends the claimed invention was conceived and reduced to practice  
2 and each person and all documents that can corroborate such conception, reduction to practice  
3 and/or diligence.

4 **INTERROGATORY NO. 2:**

5 Separately for each claim of the Elan Patents-in-Suit, identify the individual and/or  
6 individuals that Elan contends conceived the subject matter of that claim or participated in the  
7 reduction to practice of the subject matter of that claim, including the subject matter he or she  
8 contributed to that claim or the contribution of that individual to the reduction to practice of that  
9 claim, including a full description of all facts and circumstances (including documents and  
10 persons with knowledge) and reasons supporting such contention.

11 **INTERROGATORY NO. 3:**

12 Separately for each claim of the Elan Patents-in-Suit, identify the first written  
13 description, first offer for sale, first sale, first public disclosure, first public use, and first  
14 disclosure to another of the claimed invention, including, without limitation, the date on which  
15 such event occurred, the identity of each person with knowledge of any of the foregoing and the  
16 identity of all documents relating to the foregoing.

17 **INTERROGATORY NO. 4:**

18 Identify all Prior Art to the Elan Patents-in-Suit that Elan is aware of, and describe  
19 in detail when, by whom and under what circumstances such Prior Art was discovered or  
20 identified.

21 **INTERROGATORY NO. 5:**

22 Separately for each Elan Patent-in-Suit, state whether Elan contends that it has  
23 satisfied the marking requirements of 35 U.S.C. § 287, and if so, describe in detail all facts and  
24 circumstances supporting or otherwise relating to that contention (including documents and  
25 persons with knowledge).

26 **INTERROGATORY NO. 6:**

27 Separately for each Elan Patent-in-Suit, state the date on which Elan contends that  
28 Apple first became aware of that patent (whether through actual or constructive notice) and

1 describe in detail all facts and circumstances supporting or otherwise relating to that contention  
2 (including documents and persons with knowledge).

3 **INTERROGATORY NO. 7:**

4 Describe in detail all facts and circumstances relating to each communication  
5 between Elan and any third party concerning licensing, contracts, agreements, covenants not to  
6 sue, settlement agreements, actual or potential infringement, invalidity, or unenforceability of any  
7 of the Patents-in-Suit and the identities of all such third parties, including, but not limited to, the  
8 identity of each entity contacted by Elan regarding any of the Elan Patents-in-Suit and each  
9 license granted, obtained, or offered by Elan to any of the Elan Patents-in-Suit.

10 **INTERROGATORY NO. 8:**

11 Describe in detail all facts and circumstances supporting or otherwise relating to  
12 Elan's calculation of damages allegedly resulting from Apple's alleged infringement, including,  
13 but not limited to, the type and dollar amount of damages and the method(s) and calculation(s)  
14 used to compute that calculation of damages, including a full description of all facts (including  
15 documents and persons with knowledge) and reasons supporting such contention.

16 **INTERROGATORY NO. 9:**

17 Describe in detail all facts and circumstances supporting or otherwise relating to  
18 Elan's contention that Apple has willfully infringed or is willfully infringing the Elan Patents-in-  
19 Suit, including a full description of all facts (including documents and persons with knowledge)  
20 and reasons supporting such contention.

21 **INTERROGATORY NO. 10:**

22 Separately for each of the Elan Patents-in-Suit, state the date on which Elan  
23 contends that Apple's alleged infringement of that patent began and the date on which Elan first  
24 became aware of such infringement, and explain in detail why Elan did not commence this action  
25 against Apple between the date Elan became so aware and April 2009.

26 **INTERROGATORY NO. 11:**

27 Separately for each of the Apple Patents-in-Suit, describe in detail the facts and  
28 circumstances relating to Elan's first awareness of the patent, including *inter alia*, the date Elan



1 first became aware of the existence of the patent, the person(s) who first became aware of the  
2 patent, the circumstances surrounding Elan's first awareness of the patent, the content of any  
3 related communications or documents and any actions taken by you as a result (including  
4 documents and persons with knowledge).

5 **INTERROGATORY NO. 12:**

6 Identify (by product name, including all trade names and designations, internal  
7 names, and names during development; part number; model; manufacturer; designer; supplier;  
8 and dates first sold or offered for sale) all products or designs of all touch-sensitive input devices  
9 or touch pads designed, marketed, made, used, sold, offered for sale, imported, exported,  
10 licensed, or distributed by or for Elan.

11 **INTERROGATORY NO. 13:**

12 Separately for each product or design the identification of which is requested by  
13 Interrogatory No. 12, describe in detail each sale, license, or other instance in which a customer  
14 or other third party has obtained rights to the product or design, including inter alia the name and  
15 address of the customer or third party, the date on which the third party or customer first obtained  
16 rights to the product or design, what software, hardware or know-how were provided by Elan, and  
17 all written or oral communications between Elan and the customer or third party concerning the  
18 design, operation, structure, testing, use or maintenance of the product or design (including  
19 documents and persons with knowledge).

20 **INTERROGATORY NO. 14:**

21 Separately for each product or design the identification of which is requested by  
22 Interrogatory No. 12, describe in detail each individual that participated in the design or  
23 development of that product or design and their role in the design or development.

24 **INTERROGATORY NO. 15:**

25 Separately for each product or design the identification of which is requested by  
26 Interrogatory No. 12, state the total quantity of the product or design made, used, sold, offered for  
27 sale, imported, exported, leased, distributed, or licensed in the United States, and the gross and  
28 net revenues and profits derived from each such activity (including documents and persons with

1 knowledge).

2 **INTERROGATORY NO. 16:**

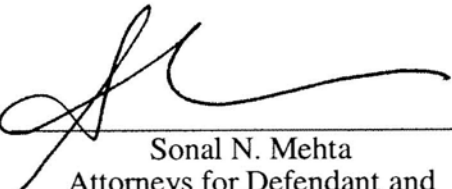
3 For each claim of each Apple Patent-in-Suit that you contend is not infringed by  
4 Elan Accused Products, describe in detail the factual basis of such contention.

5 **INTERROGATORY NO. 17:**

6 Describe in detail Elan's activities and business in the United States with regard to  
7 Elan Accused Products, including without limitation, marketing, sales, product development,  
8 and/or product support and instructions directed to or conducted in the United States by Elan,  
9 including without limitation by Elan's ELAN Information Technology Group office in Cupertino,  
10 CA.

11  
12 Dated: August 21, 2009

WEIL, GOTSHAL & MANGES LLP

13  
14 By:   
15 Sonal N. Mehta  
16 Attorneys for Defendant and  
17 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 August 21, 2009, I served a copy of:

6 **APPLE INC.'S FIRST SET OF INTERROGATORIES TO**  
7 **ELAN MICROELECTRONICS CORPORATION**  
8 **(INTERROGATORY NOS. 1 - 17)**

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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Palo Alto, CA 94306  
Telephone: 650-838-2000; Facsimile: 650-838-2001

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 August 21, 2009, at Redwood Shores, California.

32   
33 Sonal N. Mehta