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 11 ELAN MICROELECTRONICS CORPORATION

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

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

Case No. 09-cv-01531 RS

ELAN MICROELECTRONICS CORPORATION'S MOTION PURSUANT TO CIV. L.R. 6-3 TO ENLARGE CLAIM CONSTRUCTION BRIEFING DEADLINES

22 AND RELATED COUNTERCLAIMS
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1 Plaintiff and Counterdefendant Elan Microelectronics Corporation (“Elan”) hereby moves,
2 pursuant to Civil Local Rule 6-3, for an order extending the deadlines for the parties to file their
3 claim construction briefs by three weeks. In particular, Elan moves to change the deadline for
4 opening briefs from this Friday, April 16 to Friday May 7, 2010. Elan also moves to change the
5 deadline for reply briefs from April 30 to May 28, 2010.

6 As grounds for this motion, Elan states that several important issues have arisen since the
7 present claim construction briefing schedule was adopted. The requested extension will allow the
8 parties to resolve those issues, without impacting the *Markman* hearing currently scheduled for
9 June 23, 2010. When that schedule was adopted, this action included claims based on all five
10 United States patents then asserted. *See* Declaration of Sean DeBruine In Support of Elan’s
11 Motion to Amend Claim Construction Briefing Schedule (DeBruine Decl.) ¶ 3 and Docket No.
12 60. On March 29, 2010, Elan filed a complaint in the United States International Trade
13 Commission (ITC) seeking an exclusion order based on Apple’s infringement of U.S. Patent
14 5,825,352 (“the ’352 Patent”). *Id.*

15 Under its rules, the ITC will determine whether to institute the investigation Elan has
16 requested by April 29, 2010. Should the investigation be instituted, Apple may stay this case as to
17 the ’352 Patent as a matter of right until the ITC investigation is finally resolved. 28 U.S.C.
18 §1659. Should Apple not request such a stay, Elan may make such a request. Elan has sought to
19 engage Apple in a discussion of whether the case or parts of it will be stayed in light of the ITC
20 investigation. *See* DeBruine Decl. ¶ 9. The brief continuance requested by Elan would allow the
21 parties to consider their options in light of any action taken by the ITC.

22 On March 31, 2010, Elan received an e-mail from Apple’s counsel proposing to file a
23 “Corrected Joint Claim Construction Statement” changing certain of Apple’s proposed
24 constructions. However, after an initial exchange of emails last week, this issue remains
25 unresolved, as Apple has not provided any response to Elan’s proposal.

26 Finally, on April 7, 2010, Apple advised Elan that, in order to streamline this action, it
27 would drop its claims for infringement of U.S. Patent 6,933,929 and asked Elan to confirm that it
28 would drop its corresponding counterclaims for declaratory judgment that the ’929 patent is

1 invalid. DeBruine Decl. ¶ 6 and Exh. A.

2 In light of these developments, on April 8, 2010, Elan tried to initiate discussions with
3 Apple with respect to staying all or part of the district court action in light of the soon-to-be-
4 pending ITC action. DeBruine Decl. ¶ 9. Apple's initial response was that that no decision had
5 been made yet as to whether to stay. *Id.*, ¶ 10. In response, Elan suggested the continuance of the
6 briefing schedule as set forth here. Apple's counsel indicated that Apple would consider that
7 option. Having received no concrete response, today Elan again contacted Apple, noting that
8 Apple had not decided whether it will seek to stay the district court case in light of Elan's ITC
9 complaint and further noting that the period for the ITC to institute an investigation based on that
10 complaint runs on April 29. *Id.* ¶ 11 and Exh. D. Elan proposed that the current briefing schedule
11 does not make sense when there is a likelihood that all or part of the case will be stayed and there
12 is still some uncertainty regarding what *Markman* issues will be briefed. *Id.* Elan advised that
13 Elan intended to move today for an order continuing the briefing until May 7 and May 28
14 respectively to allow time to resolve the status of the case after the ITC institutes the investigation
15 and asked if Apple would stipulate to such a continuance. *Id.* Apple responded, refusing to agree.
16 *Id.*, ¶ 12, and Exh. E.

17 As such, the scope of the upcoming *Markman* hearing is unclear and both parties and the
18 Court will benefit from time to see which claims and counterclaims will be stayed in light of the
19 new ITC proceeding between the parties. At least one of the "most significant" claim terms the
20 parties have been preparing to brief ("housing" in the 929 patent) has become irrelevant and moot.
21 If claims and counterclaims with respect to the '352 patent are stayed, they also will not be before
22 the Court in the upcoming *Markman* hearing. The parties should have the opportunity to revise the
23 list of most significant terms based on the remaining patents so that the terms briefed are those that
24 are most likely to resolve disputed issues with respect to infringement and validity of the patents
25 that will remain in the district court action.

26 The proposed amendment to the briefing schedule would not affect the timing of the Claim
27 Construction Hearing already scheduled for June 23, 2010. If the parties complete their claim
28 construction briefing, as proposed, on May 28, the Court will still have almost one month after

1 having received the briefs to prepare for the June 23, 2010 hearing. No other deadlines have been
2 set in this matter, and as such this motion will not affect any other dates.

3 For the foregoing reasons, Elan respectfully requests that the Court amend the briefing
4 schedule and order that Opening Briefs be due no later than May 7, 2010 and Reply Briefs no later
5 than May 28, 2010.

6 DATED: April 13, 2010

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/s/ Sean P. DeBruine
Sean P. DeBruine

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