

# EXHIBIT A

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14 AMERICA, INC. and SAMSUNG  
TELECOMMUNICATIONS AMERICA, LLC  
15

16 UNITED STATES DISTRICT COURT

17 NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

18 APPLE INC., a California corporation,

19 Plaintiff,

20 vs.

21 SAMSUNG ELECTRONICS CO., LTD., a  
Korean business entity; SAMSUNG  
22 ELECTRONICS AMERICA, INC., a New  
York corporation; SAMSUNG  
23 TELECOMMUNICATIONS AMERICA,  
LLC, a Delaware limited liability company,

24 Defendants.  
25

CASE NO. 11-cv-01846-LHK

**SAMSUNG'S PATENT LOCAL RULE  
3-3 AND 3-4 DISCLOSURES**

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1 Pursuant to the Court's Minute Order and Case Management Order, and Patent Local Rules  
2 3-3 and 3-4, Defendants Samsung Electronic Co., Ltd., Samsung Electronics America, Inc., and  
3 Samsung Telecommunications America, LLC (collectively, "Samsung") submit invalidity  
4 contentions and document productions for U.S. Patent Numbers 7,812,828 (the "828 Patent");  
5 6,493,002 (the "002 Patent"); 7,469,381 (the "381 Patent"); 7,844,915 (the "915 Patent");  
6 7,853,891 (the "891 Patent"); 7,663,607 (the "607 Patent"); 7,663,163 (the "163 Patent"); and  
7 7,920,129 (the "129 Patent") (collectively, "Apple Asserted Patents"). Apple Inc. is referred to  
8 herein as "Apple" or "Plaintiff."

9 **PATENT LOCAL RULE 3-3 DISCLOSURES**

10 1. This disclosure is directed to preliminary invalidity and unenforceability issues  
11 only and does not address claim construction or non-infringement. Samsung reserves all rights  
12 with respect to such issues, including but not limited to its position that claims of the Apple  
13 Asserted Patents are to be construed in a particular manner and are not infringed.

14 2. These invalidity contentions are preliminary and are based on Samsung's current  
15 knowledge, understanding, and belief as to the facts and information available as of the date of  
16 these contentions. Samsung has not yet completed its investigation, discovery, or analysis of  
17 information related to this action, and additional discovery may require Samsung to supplement or  
18 amend its invalidity contentions. For instance, Apple has failed to produce prior art, invalidity  
19 contentions, expert reports, dispositive motions, prehearing and posthearing briefs, and other  
20 relevant materials from its litigations with HTC, Motorola, and Nokia, which include many of the  
21 Apple Asserted Patents and related patents. As one example, Apple has not yet produced  
22 materials relating to NeXT computers, including the NeXTSTEP source code for multiple versions  
23 of the prior art NeXTSTEP operating system, even though Samsung has requested this prior art.  
24 Samsung reserves the right to amend or supplement its charts once it gains access to relevant  
25 materials Apple has not yet produced. While Samsung has made a good-faith effort to provide a  
26 comprehensive list of prior art relevant to this case, Samsung reserves the right to modify or  
27 supplement its prior art list and invalidity contentions at a later time with or based upon pertinent  
28 information that may be subsequently discovered from Apple or third-parties. Moreover,

1 discovery is ongoing and Samsung reserves the right to pursue all other defenses that may be  
2 available to it, including but not limited to defenses that the Apple Asserted Patents are  
3 unenforceable based on laches, estoppels, waiver acquiescence, inequitable conduct, patent  
4 misuse, patent exhaustion, express or implied license, or any other grounds.

5         3. Any invalidity analysis depends, ultimately, upon claim construction, which is a  
6 question of law reserved for the Court. The asserted claims have not yet been construed by the  
7 Court in this case and, thus, Samsung has not yet had the opportunity to compare the asserted  
8 claims of the Apple Asserted Patents (as construed by the Court) with the prior art. Samsung  
9 reserves the right to amend, supplement, or materially modify its invalidity contentions after the  
10 claims have been construed by the Court. Samsung also reserves the right to amend, supplement,  
11 or materially modify its invalidity contentions based on any claim construction positions that  
12 Apple may take in this case. Samsung also reserves the right to assert that a claim is indefinite,  
13 not enabled, or fails to meet the written description requirement based on any claim construction  
14 position Plaintiff may take in this case or based on any claim construction the Court may adopt in  
15 this case.

16         4. Samsung's invalidity contentions are directed to the claims asserted by Plaintiff that  
17 are identified in Plaintiff's August 26, 2011 Disclosure of Asserted Claims and Infringement  
18 Contentions. In its Infringement Contentions, however, Plaintiff states that it "reserves the right to  
19 supplement or amend these disclosures as further facts are revealed during the course of this  
20 litigation." Samsung therefore reserves the right to modify, amend, supplement or otherwise alter  
21 its invalidity contentions in the event that Plaintiff supplements or amends its infringement  
22 contentions or take a claim construction position that is different than or in addition to those set  
23 forth in its infringement contentions, or for any other reason constituting good cause to modify,  
24 amend, supplement or otherwise alter these invalidity contentions.

25         5. Samsung further contends that Plaintiff appears to be pursuing overly broad  
26 constructions of the asserted claims of the Apple Asserted Patents in an effort to piece together an  
27 infringement claim where none exists and to accuse products that do not practice the claims as  
28 properly construed. At the same time, Plaintiff's infringement contentions are in most places too

1 general and vague to discern exactly how Plaintiff contends each accused product practices each  
2 element of the asserted claims. Samsung has requested that Plaintiff remedy the deficiencies in its  
3 infringement contentions, but Plaintiff has not done so. Accordingly, these invalidity contentions  
4 are not intended to be, and are not, an admission that the asserted claims are infringed by any of  
5 Samsung's products or technology, that any particular feature or aspect of any of the accused  
6 products practices any elements of the asserted claims, or that any of Plaintiff's proposed  
7 constructions are supportable or proper. To the extent that any of the prior art references disclose  
8 the same functionality or feature of any of the accused products, Samsung reserves the right to  
9 argue that said feature or functionality does not practice any element of any of the asserted claims,  
10 and to argue, in the alternative, that if said feature or functionality is found to practice any element  
11 of any of the asserted claims of the Apple Asserted Patents, then the prior art reference  
12 demonstrates that that element is not novel to the invention and is not patentable.

13         6. Attached hereto are representative claim charts that demonstrate how the asserted  
14 claims of the Apple Asserted Patents are invalid in view of certain prior art. The references cited  
15 in the attached claim charts may disclose the limitations of the asserted claims of the Apple  
16 Asserted Patents either expressly and/or inherently. Moreover, the suggested obviousness  
17 combinations are in the alternative to Samsung's anticipated contentions. These obviousness  
18 combinations should not be construed to suggest that any reference included in any combination is  
19 not anticipatory in its own right.

20         7. In this action, Plaintiff asserts that Samsung infringes certain claims of the Apple  
21 Asserted Patents. Although Plaintiff asserts that these claims are either literally infringed or  
22 infringed under the doctrine of equivalents, Plaintiff has failed to provide any analysis or  
23 explanation regarding alleged infringement of the asserted claims of the patents-in-suit under the  
24 doctrine of equivalents. Samsung reserves its rights to modify, amend, supplement or otherwise  
25 alter its preliminary infringement contentions in the event Plaintiff is permitted to modify, amend,  
26 supplement, or clarify their infringement contentions with respect to direct infringement (literal  
27 and under the doctrine of equivalents).

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1 8. Samsung is providing invalidity contentions only for the claims asserted by  
2 Plaintiff, but hereby reserves the right to seek invalidation of all claims in each of the Apple  
3 Asserted Patents.

4 9. Samsung reserves the right to modify, amend, or supplement these disclosures as  
5 additional information becomes available, and as its discovery and investigation proceed.

6 **I. THE '828 PATENT**

7 **A. Local Patent Rule 3-3(a): Identification of Prior Art**

8 At this time, Samsung contends that at least the following prior art references anticipate or  
9 render obvious, either alone or in combination, the asserted claims of the '828 Patent:  
10

11 **1. Patent References<sup>1</sup>**

Chart No(s).	Country of Origin	Patent Number	Date of Issue	Priority Date
A-1	US	4,618,989	10/21/1986	1/21/1983
A-2	US	5,488,204	1/30/1996	6/8/1992
A-3	US	5,583,946	12/10/1996	9/30/1993
A-4	US	5,638,093	6/10/1997	12/7/1993
A-5	US	5,734,751	3/31/1998	7/22/1994
A-6	US	5,812,118	9/22/1998	6/25/1996
A-7	US	5,825,352	10/20/1998	1/4/1996

17 **2. Publications<sup>2</sup>**

Chart No(s).	Title	Date of Publication	Author	Publisher
A-8	Machine Vision: Theory, Algorithms, Practicalities (2d Ed.) (ISBN 012206092X)	Nov. 1996	E.R. Davies	Academic Press
A-9	Interpretation of Tactile Data from an FSR Pressure Pad Transducer Using Image Processing Techniques, Master's Thesis	Nov. 1994	Apurva M. Desai	Simon Fraser University, Canada

24 Additional prior art that has not been charted, but is still relevant to the invalidity of the  
25 '828 Patent is listed in Exhibit B. Samsung reserves the right to amend these invalidity

26 <sup>1</sup> Samsung incorporates by reference all prior art references cited in the patents listed herein  
27 and/or their file histories.

28 <sup>2</sup> Samsung incorporates by reference all prior art references identified in the publications  
listed herein.

1 contentions to assert these references depending on the claim construction and infringement  
2 positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these  
3 references in combination with other references to render the claims of the '828 Patent obvious in  
4 the event Apple takes the position that certain claim limitations are missing from the references  
5 charted in Exhibits A and C.

6 **B. Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders**  
7 **Obvious the Asserted Claims**

8 Plaintiff asserts claims 1-3, 6, 9-13, 15-16, 20-31, and 34-35 of the '828 Patent against  
9 Samsung in this lawsuit. All of those claims are invalid because the '828 Patent fails to meet one  
10 or more of the requirements for patentability. The individual bases for invalidity are provided  
11 below and in the claim charts attached as Exhibits A and C. Each of the foregoing listed prior art  
12 documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art  
13 under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

14 Although Samsung has identified at least one citation per limitation for each reference,  
15 each and every disclosure of the same limitation in the same reference is not necessarily identified.  
16 Rather, in an effort to focus the issues, Samsung has cited representative portions of identified  
17 references, even where a reference may contain additional support for a particular claim element.  
18 In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and  
19 in the context of other publications and literature. Thus, to understand and interpret any specific  
20 statement or disclosure within a prior art reference, such persons would rely on other information  
21 within the reference, along with other publications and their general scientific knowledge.  
22 Samsung may rely upon uncited portions of the prior art references and on other publications and  
23 expert testimony to provide context, and as aids to understanding and interpreting the portions that  
24 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed  
25 publications, and the testimony of experts to establish that a person of ordinary skill in the art  
26 would have been motivated to modify or combine certain of the cited references so as to render the  
27 claims obvious.  
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**1. Anticipation**

Some or all of the asserted claims of the '828 Patent are invalid as anticipated under 35 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts included in Exhibit A, which identify specific examples of where each limitation of the asserted claims is found in the prior art references. As explained above, the cited portions of prior art references identified in the attached claim charts are exemplary only and representative of the content and teaching of the prior art references, and should be understood in the context of the reference as a whole and as they would be understood by a person of ordinary skill in the art.

**2. Obviousness**

To the extent any limitation is deemed not to be exactly met by an item of prior art listed above and in Exhibit A, then any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge of those skilled in the art. The item of prior art would, therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

In addition, the references identified above render one or more asserted claims of the '828 Patent obvious when the references are read in combination with each other, and/or when read in view of the state of the art and knowledge of those skilled in the art. Each and every reference identified is also relevant to the state of the art at the time of the alleged invention. Any of the references disclosed above may be combined to render obvious (and therefore invalid) each of Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or all of the references identified above, including all references in Exhibits A, B, and C, for purposes of obviousness depending on the Court's claim construction, positions taken by Apple during this litigation, and further investigation and discovery.

Moreover, to the extent the foregoing references are found not to anticipate the asserted claims, the foregoing references render the asserted claims obvious either alone or in combination with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art



1 at the time of the alleged invention of the asserted claims of the '828 Patent to combine the various  
2 references cited herein so as to practice the asserted claims of the '828 Patent.

3 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,  
4 alone or in combination with other references, are outlined below and included in Exhibits A and  
5 C, which includes exemplary claim charts for the asserted claims of the '828 Patent showing  
6 specifically where in each reference or combinations of references each asserted claim is found,  
7 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the  
8 charts in Exhibit A and C include the motivation to combine references.  
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10 In particular, Samsung contends that the asserted claims of the '828 Patent would have  
11 been obvious in view of the prior art references identified above. For example, Exhibit C includes  
12 exemplary claim charts that describe how the asserted claims of the '828 Patent would have been  
13 obvious in view of the following references alone or in combination:  
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- 15 • All references identified in Exhibit A, if found not to anticipate the claims of the  
16 '828 Patent, render the claims of the '828 Patent obvious alone;
- 17 • Exhibit C-1: U.S. Patent No. 5,168,531 (“Sigel '531”) and Baker '951, Bisset  
18 '352, Bertram '157, Davies, Desai, Duwaer '381, and/or Tsukune;
- 19 • Exhibit C-2: U.S. Patent No. 6,738,154 (“Venable '154”) and Baker '951, Bisset  
20 '352, Bertram '157, Davies, Desai, Duwaer '381, Konrad, Shieh '118, Takahashi  
21 '093, and/or Tsukune '989

22 In addition to the specific combinations of prior art and the specific combinations of  
23 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any  
24 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations  
25 disclosed within the prosecution history of the references cited herein. These obviousness  
26 combinations reflect Samsung's present understanding of the potential scope of the claims that  
27 Plaintiff appears to be advocating and should not be seen as Samsung's acquiescence to Plaintiff's  
28 interpretation of the patent claims.

1 Samsung also reserves the right to amend or supplement these contentions regarding  
2 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,  
3 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has  
4 not identified what elements or combinations it alleges were not known to one of ordinary skill in  
5 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a  
6 particular prior art reference, Samsung reserves the right to assert that any such limitation is either  
7 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light  
8 of the same, or that the limitation is disclosed in another of the references disclosed above and in  
9 combination would have rendered the asserted claim obvious.

10 **C. Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**  
11 **Alleged item of Prior Art each Asserted Claim is Found**

12 Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged  
13 item of prior art each limitation of each asserted claim is found, including for each limitation that  
14 Apple contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or  
15 material(s) in each item of prior art that performs the claimed function is attached in Exhibits A  
16 and C.

17 **D. Local Patent Rule 3-3(d): Other Grounds for Invalidity**

18 Samsung identifies the following grounds for invalidity of the asserted claims of the '828  
19 Patent based on 35 U.S.C. §§ 101 and/or 112. Samsung reserves the right to supplement these  
20 disclosures based on further investigation and discovery.

21 **3. Invalidity Based on 35 U.S.C. § 101**

22 The asserted claims of the '828 Patent are invalid under 35 U.S.C. § 101 because they only  
23 claim abstract ideas. For example, each asserted claim of the '828 Patent contains the limitation  
24 “mathematically fit[ting] an ellipse” or “fitting an ellipse.”  
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1                   4.       **Invalidity Based on Enablement or Written Description Under 35**  
2                                   **U.S.C. § 112(1) and/or Invalidity Based on Indefiniteness Under 35**  
3                                   **U.S.C. § 112(2)**

4                   Based on Samsung's present understanding of Plaintiff's infringement contentions,  
5 Samsung asserts that claims 1-3, 6, 9-13, 15-16, and 20-31 of the '828 Patent are invalid for  
6 reciting at least the following claim terms/phrases:

- 7                   • “mathematically fit[ting] an ellipse to at least one of the [one or more] pixel  
8 groups”
- 9                   • “transmit[ting] one or more ellipse parameters as a control signal to an electronic or  
10 electromechanical device”
- 11                  • “means for producing a proximity image representing a scan of a plurality of  
12 electrodes of a touch-sensitive surface”
- 13                  • “means for segmenting the proximity image into one or more pixel groups”
- 14                  • “means for fitting an ellipse to at least one of the pixel groups”
- 15                  • “the touch object comprises at least a portion of a hand”
- 16                  • “the touch object comprises at least a portion of one or more fingers”
- 17                  • “the touch object comprises at least a portion of a body part”
- 18                  • “the body part comprises one or more of a hand, a finger, an ear, or a cheek”
- 19                  • “means for transmitting one or more ellipse parameters as a control signal to an  
20 electronic or electromechanical device”
- 21                  • “means for tracking a path of one or more pixel groups through a plurality of time-  
22 sequenced proximity images”
- 23                  • “means for fitting an ellipse to at least one of the pixel groups in a plurality  
24 successive proximity images”
- 25                  • “means for tracking a change in one or more ellipse parameters through a plurality  
26 of time-sequenced proximity images”

27                   These claim terms/phrases as apparently construed by Apple violate the written description,  
28 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

                  Based on Samsung's present understanding of Plaintiff's infringement contentions, at least  
one or more of these claim terms/phrases are indefinite because they are inconsistent with and

1 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent  
 2 constructions of the claims, any person of ordinary skill in the art at the time of the invention  
 3 would not understand what is claimed, even when the claims are read in light of the specification.  
 4 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each  
 5 of the asserted claims in which these claim terms/phrases appear lack written description because  
 6 the specification of the '828 Patent demonstrates that the patentee neither conceived of nor  
 7 demonstrated possession of all that Apple now contends the claims cover. In addition, based on  
 8 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted  
 9 claims in which these claim terms/phrases appear are invalid because the specification fails to  
 10 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,  
 11 or with which it is most nearly connected, to implement the invention without undue  
 12 experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

13 **II. THE '002 PATENT**

14 **A. Local Patent Rule 3-3(a): Identification of Prior Art**

15 At this time, Samsung contends that at least the following prior art references anticipate or  
 16 render obvious, either alone or in combination, the asserted claims of the '002 Patent:

17 **1. Patent References<sup>3</sup>**

Chart No(s).	Country of Origin	Patent Number	Date of Issue	Priority Date
D-1	US	5,754,174	05/19/1998	08/27/1992
D-2	US	5,825,357	10/20/1998	12/13/1993
D-3	US	5,745,096	04/28/1998	06/03/1991
D-4	US	5,542,088	07/30/1996	04/29/1994
D-5	US	5,491,795	2/13/1996	05/04/1993

22 **2. Publications<sup>4</sup>**

Chart No(s).	Title	Date of Publication	Author	Publisher
D-6	Using PC Tools For Windows	July 1993	Halliday, Caroline, et. al.	Que Corporation

26 <sup>3</sup> Samsung incorporates by reference all prior art references cited in the patents listed herein  
 27 and/or their file histories.

28 <sup>4</sup> Samsung incorporates by reference all prior art references identified in the publications  
 listed herein.

1                                   3.     **Systems**

2                   All versions of the following prior art systems commercially sold, publicly known or used  
3 before the priority date of the '002 Patent, including documents and source code describing the  
4 same:

Chart No(s).	System	Date Offered	Offering Entity
D-6	PC Tools for Windows 1.0	July 1993 or earlier	Central Point
D-7	NeXTSTEP Operating System ver. 3.0	Sep. 1992	Next Computer, Inc.

8  
9                   Additional prior art that has not been charted, but is still relevant to the invalidity of the  
10 '002 Patent is listed in Exhibit E. Samsung reserves the right to amend these invalidity  
11 contentions to assert these references depending on the claim construction and infringement  
12 positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these  
13 references in combination with other references to render the claims of the '002 Patent obvious in  
14 the event Apple takes the position that certain claim limitations are missing from the references  
15 charted in Exhibits D and F.

16                   **B.     Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders**  
17                   **Obvious the Asserted Claims**

18                   Plaintiff asserts claims 1-4, 6-7, 9-20, 25-29, 31-32, 34-45, and 50 of the '002 Patent  
19 against Samsung in this lawsuit. All of those claims are invalid because the '002 Patent fails to  
20 meet one or more of the requirements for patentability. The individual bases for invalidity are  
21 provided below and in the claim charts attached as Exhibits D and F. Each of the foregoing listed  
22 prior art documents, the underlying work, and/or the underlying apparatus or method qualifies as  
23 prior art under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

24                   Although Samsung has identified at least one citation per limitation for each reference,  
25 each and every disclosure of the same limitation in the same reference is not necessarily identified.  
26 Rather, in an effort to focus the issues, Samsung has cited representative portions of identified  
27 references, even where a reference may contain additional support for a particular claim element.  
28 In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and

1 in the context of other publications and literature. Thus, to understand and interpret any specific  
2 statement or disclosure within a prior art reference, such persons would rely on other information  
3 within the reference, along with other publications and their general scientific knowledge.  
4 Samsung may rely upon uncited portions of the prior art references and on other publications and  
5 expert testimony to provide context, and as aids to understanding and interpreting the portions that  
6 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed  
7 publications, and the testimony of experts to establish that a person of ordinary skill in the art  
8 would have been motivated to modify or combine certain of the cited references so as to render the  
9 claims obvious.

#### 10 4. **Anticipation**

11 Some or all of the asserted claims of the '002 Patent are invalid as anticipated under 35  
12 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts  
13 included in Exhibit D, which identify specific examples of where each limitation of the asserted  
14 claims is found in the prior art references. As explained above, the cited portions of prior art  
15 references identified in the attached claim charts are exemplary only and representative of the  
16 content and teaching of the prior art references, and should be understood in the context of the  
17 reference as a whole and as they would be understood by a person of ordinary skill in the art.

#### 18 5. **Obviousness**

19 To the extent any limitation is deemed not to be exactly met by an item of prior art listed  
20 above and in Exhibit D, then any purported differences are such that the claimed subject matter as  
21 a whole would have been obvious to one skilled in the art at the time of the alleged invention, in  
22 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,  
23 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

24 In addition, the references identified above render one or more asserted claims of the '002  
25 Patent obvious when the references are read in combination with each other, and/or when read in  
26 view of the state of the art and knowledge of those skilled in the art. Each and every reference  
27 identified is also relevant to the state of the art at the time of the alleged invention. Any of the  
28 references disclosed above may be combined to render obvious (and therefore invalid) each of

1 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or  
2 all of the references identified above, including all references in Exhibits D, E, and F, for purposes  
3 of obviousness depending on the Court's claim construction, positions taken by Apple during this  
4 litigation, and further investigation and discovery.

5 Moreover, to the extent the foregoing references are found not to anticipate the asserted  
6 claims, the foregoing references render the asserted claims obvious either alone or in combination  
7 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained  
8 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art  
9 at the time of the alleged invention of the asserted claims of the '002 Patent to combine the various  
10 references cited herein so as to practice the asserted claims of the '002 Patent.

11  
12 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,  
13 alone or in combination with other references, are outlined below and included in Exhibits D and  
14 F, which includes exemplary claim charts for the asserted claims of the '002 Patent showing  
15 specifically where in each reference or combinations of references each asserted claim is found,  
16 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the  
17 charts in Exhibit D and F include the motivation to combine references.

18  
19 In particular, Samsung contends that the asserted claims of the '002 Patent would have  
20 been obvious in view of the prior art references identified above. For example, Exhibit F includes  
21 exemplary claim charts that describe how the asserted claims of the '002 Patent would have been  
22 obvious in view of the following references alone or in combination:

- 23 • All references identified in Exhibit D, if found not to anticipate the claims of the  
24 '002 Patent or render the claims of the '002 Patent obvious alone;
- 25 • Exhibit F-1: U.S. Patent No. 5,394,521 ("Henderson '521"); U.S. Patent No.  
26 5,233,687 ("Henderson '687"); U.S. Patent No. 5,072,412 ("Henderson '412"); D.A.  
27 Henderson, Jr. & S. Card, K., "Rooms: The Use of Multiple Virtual Workspaces to  
28

1 Reduce Space Contention in a Window-Based Graphical User Interface," *ACM*  
2 *Transactions on Graphics*, vol. 5, no. 3, pp. 210-243 (Jul. 1986) ("Henderson  
3 1986); and Stuart K. Card & Austin Henderson, Jr., "A Multiple, Virtual-  
4 Workspace Interface to Support User Task Switching," *CHI '87 Proceedings of the*  
5 *SIGCHI/GI conference on Human factors in computing systems and graphics*  
6 *interface* (1987) ("Henderson 1987").

- 7 • Exhibit F-2: "Archie RISC OS," PERSONAL COMPUTER WORLD, January 1989;  
8 Acorn A3000 Welcome Guide; Acorn A5000 Welcome Guide; RISC OS 2 User  
9 Guide; RISC OS 3 User & Apps Guide; RISC OS 2 Programmer's Reference  
10 Manual; and RISC OS 3 Programmer's Reference Manual.

11 In addition to the specific combinations of prior art and the specific combinations of  
12 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any  
13 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations  
14 disclosed within the prosecution history of the references cited herein. These obviousness  
15 combinations reflect Samsung's present understanding of the potential scope of the claims that  
16 Plaintiff appears to be advocating and should not be seen as Samsung's acquiescence to Plaintiff's  
17 interpretation of the patent claims.

18 Samsung also reserves the right to amend or supplement these contentions regarding  
19 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,  
20 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has  
21 not identified what elements or combinations it alleges were not known to one of ordinary skill in  
22 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a  
23 particular prior art reference, Samsung reserves the right to assert that any such limitation is either  
24 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light  
25 of the same, or that the limitation is disclosed in another of the references disclosed above and in  
26 combination would have rendered the asserted claim obvious.

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1           **C. Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**  
2           **Alleged item of Prior Art each Asserted Claim is Found**

3           Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged  
4 item of prior art each limitation of each asserted claim is found, including for each limitation that  
5 Apple contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or  
6 material(s) in each item of prior art that performs the claimed function is attached in Exhibits D  
7 and F.

8           **D. Local Patent Rule 3-3(d): Other Grounds for Invalidity**

9           Samsung identifies the following grounds for invalidity of the asserted claims of the '002  
10 Patent based on 35 U.S.C. §§ 101 and/or 112. Samsung reserves the right to supplement these  
11 disclosures based on further investigation and discovery.

12           1.       **Invalidity Based on 35 U.S.C. § 101**

13           The asserted claims of the '002 Patent are invalid under 35 U.S.C. § 101 because they only  
14 claim abstract ideas. Many limitations in the asserted claims are common abstractions in  
15 computer systems and programming languages. For example, "a cursor," "an operating  
16 environment," "individual programming modules," "application programs," "status and/or control  
17 functions," "first window region," "display areas," "independently displayed," "independently  
18 active," "associated with [a] programming module," "window layer," "appears on top,"  
19 "information for display," "sensitive to user input," "message-based communication," "interactive  
20 display activity," "variably sized," "control information," "additional display element," "user  
21 sensitive graphics," "initiates a response," and "private window layer," are all programming  
22 abstractions; these are concepts, not physical objects, machines, or transformations.

23           2.       **Invalidity Based on Enablement or Written Description Under 35**  
24           **U.S.C. § 112(1) and/or Indefiniteness Under 35 U.S.C. § 112(2)**

25           Based on Samsung's present understanding of Plaintiff's infringement contentions,  
26 Samsung asserts that the asserted claims of the '002 Patent are invalid for reciting at least the  
27 following claim terms/phrases:

- 28           • "independent display areas"

- 1 • "independently active of any application program"
- 2 • "private window layer"
- 3 • "control strip"
- 4 • Claim 25: "an indicia generation logic coupled to the data display screen"

5  
6 These claim terms/phrases as apparently construed by Apple violate the written description,  
7 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

8 Based on Samsung's present understanding of Plaintiff's infringement contentions, at least  
9 one or more of these claim terms/phrases are indefinite because they are inconsistent with and  
10 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent  
11 constructions of the claims, any person of ordinary skill in the art at the time of the invention  
12 would not understand what is claimed, even when the claims are read in light of the specification.  
13 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each  
14 of the asserted claims in which these claim terms/phrases appear lack written description because  
15 the specification of the '002 Patent demonstrates that the patentee neither conceived of nor  
16 demonstrated possession of all that Apple now contends the claims cover. In addition, based on  
17 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted  
18 claims in which these claim terms/phrases appear are invalid because the specification fails to  
19 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,  
20 or with which it is most nearly connected, to implement the invention without undue  
21 experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

### 22 **III. THE '381 PATENT**

#### 23 **A. Local Patent Rule 3-3(a): Identification of Prior Art**

24 At this time, Samsung contends that at least the following prior art references anticipate or  
25 render obvious, either alone or in combination, the asserted claims of the '381 Patent:





1 content and teaching of the prior art references, and should be understood in the context of the  
2 reference as a whole and as they would be understood by a person of ordinary skill in the art.

3 **4. Obviousness**

4 To the extent any limitation is deemed not to be exactly met by an item of prior art listed  
5 above and in Exhibit G, then any purported differences are such that the claimed subject matter as  
6 a whole would have been obvious to one skilled in the art at the time of the alleged invention, in  
7 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,  
8 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

9 In addition, the references identified above render one or more asserted claims of the '381  
10 Patent obvious when the references are read in combination with each other, and/or when read in  
11 view of the state of the art and knowledge of those skilled in the art. Each and every reference  
12 identified is also relevant to the state of the art at the time of the alleged invention. Any of the  
13 references disclosed above may be combined to render obvious (and therefore invalid) each of  
14 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or  
15 all of the references identified above, including all references in Exhibits G and H, for purposes of  
16 obviousness depending on the Court's claim construction, positions taken by Apple during this  
17 litigation, and further investigation and discovery.

18 Moreover, to the extent the foregoing references are found not to anticipate the asserted  
19 claims, the foregoing references render the asserted claims obvious either alone or in combination  
20 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained  
21 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art  
22 at the time of the alleged invention of the asserted claims of the '381 Patent to combine the various  
23 references cited herein so as to practice the asserted claims of the '381 Patent.

24 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,  
25 alone or in combination with other references, are outlined below and included in Exhibits G,  
26 which includes exemplary claim charts for the asserted claims of the '381 Patent showing  
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1 specifically where in each reference or combinations of references each asserted claim is found,  
2 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the  
3 charts in Exhibit G include the motivation to combine references.

4 In particular, Samsung contends that the asserted claims of the '381 Patent would have  
5 been obvious in view of the prior art references identified above. For example, the asserted claims  
6 of the '381 Patent would have been obvious in view of the following references alone or in  
7 combination:  
8

- 9 • All references identified in Exhibit G, if found not to anticipate the claims of the  
10 '381 Patent, render the claims of the '381 Patent obvious alone;

11 In addition to the specific combinations of prior art and the specific combinations of  
12 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any  
13 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations  
14 disclosed within the prosecution history of the references cited herein. These obviousness  
15 combinations reflect Samsung's present understanding of the potential scope of the claims that  
16 Plaintiff appears to be advocating and should not be seen as Samsung's acquiescence to Plaintiff's  
17 interpretation of the patent claims.

18 Samsung also reserves the right to amend or supplement these contentions regarding  
19 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,  
20 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has  
21 not identified what elements or combinations it alleges were not known to one of ordinary skill in  
22 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a  
23 particular prior art reference, Samsung reserves the right to assert that any such limitation is either  
24 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light  
25 of the same, or that the limitation is disclosed in another of the references disclosed above and in  
26 combination would have rendered the asserted claim obvious.

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- 1 • “first direction”
- 2 • "second direction"
- 3 • “display” or “displayed” or “displaying”
- 4 • "translate" or "translated" or "translating" or "translation"
- 5 • "first portion" or "second portion" or "third portion" or "fourth portion"
- 6 • "visually distinct"
- 7 • "programs"
- 8 • "instructions"
- 9 • "computer readable storage medium"
- 10 • "near the touch screen"
- 11 • "elastically attached"
- 12 • "damped motion"
- 13 • "in accordance with a simulation of an equation of motion having friction"

14 These claim terms/phrases as apparently construed by Apple violate the written description,  
15 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

16 Based on Samsung's present understanding of Plaintiff's infringement contentions, at least  
17 one or more of these claim terms/phrases are indefinite because they are inconsistent with and  
18 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent  
19 constructions of the claims, any person of ordinary skill in the art at the time of the invention  
20 would not understand what is claimed, even when the claims are read in light of the specification.  
21 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each  
22 of the asserted claims in which these claim terms/phrases appear lack written description because  
23 the specification of the '381 Patent demonstrates that the patentee neither conceived of nor  
24 demonstrated possession of all that Apple now contends the claims cover. In addition, based on  
25 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted  
26  
27  
28



1 claims in which these claim terms/phrases appear are invalid because the specification fails to  
 2 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,  
 3 or with which it is most nearly connected, to implement the invention without undue  
 4 experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

5 **IV. THE '915 PATENT**

6 **A. Local Patent Rule 3-3(a): Identification of Prior Art**

7 At this time, Samsung contends that at least the following prior art references anticipate or  
 8 render obvious, either alone or in combination, the asserted claims of the '915 Patent:

9 1. **Patent References<sup>12</sup>**

Chart No(s).	Country of Origin	Patent Number	Date of Issue	Priority Date
J-6	Japan	(Publication No.) 2000-163031	(Published) June 16, 2000	(Filed) November 25, 1998

13 2. **Publications<sup>13</sup>**

Chart No(s).	Title	Date of Publication	Author	Publisher
J-1	<i>Multi-user, Multi-display Interaction with a Single-user, Single-display Geospatial Application.</i> Reprinted as <u>Mitsubishi Electronic Research Laboratories ("MERL") Technical Report No. TR2006-083.</u>	October 15, 2006	Chris Forlines, C., Esenther, A., Shen, C., Wigdor, D., and Ryall, K.	UIST '06 (ACM Oct. 15-18 2006) printed in original at pp. 273-276; reprinted by Mitsubishi
J-1	<i>DiamondTouch: a multi-user touch technology</i> Reprinted as <u>MERL TR No. TR2003-125.</u>	2001 (original); 2003 (reprinting)	P.H. Dietz and Leigh, D.	<u>Proc ACM UIST</u> , (ACM 2001) printed in original at pp. 219-226,; reprinted by Mitsubishi
J-1	<i>DiamondTouch SDK: Support for Multi-User, Multi-Touch Applications,</i> <u>MERL TR No. TR2003-125</u>	2003	Alan Esenther, Cliff Forlines, Kathy Ryall, Sam Shipman.	Mitsubishi
J-1	<i>Enabling interaction with single</i>	December	Edward Tse,	<u>Advanced</u>

12 Samsung incorporates by reference all prior art references cited in the patents listed herein and/or their file histories.

13 Samsung incorporates by reference all prior art references identified in the publications listed herein.

Chart No(s).	Title	Date of Publication	Author	Publisher
	<i>user applications through speech and gestures on a multi-user tabletop. Reprinted as <u>MERL TR No. TR2005-130</u></i>	2005	Chia Shen, Saul Greenberg, Clifton Forlines:	<u>Visual Interfaces</u> ; reprinted by Mitsubishi
J-1	<i>Multi-User Multi-Touch Games on DiamondTouch with the DTFlash Toolkit , printed as <u>MERL Technical Report No. TR2005-105</u></i>	December 2005	Alan Esenther and Kent Wittenburg,	Mitsubishi
J-2	<i>SmartSkin: An Infrastructure for Freehand Manipulation on Interactive Surfaces</i>	2002	Jun Rekimoto	<u>Proceedings of the SIGCHI Conference on Human Factors in Computing Systems: Changing our world, Changing ourselves,</u>
J-2	<i>Concurrent Manipulation of Multiple Components on Graphical User Interface, <u>PhD Dissertation</u></i>	2006	K. Fukuchi	Tokyo Institute of Technology
J-2	<i>Interaction Techniques for SmartSkin</i>	2002	K. Fukuchi and J. Rekimoto	<u>Proceedings of UIST'02, 2002</u>
J-3	<i>The Automatic Recognition of Gestures, <u>PhD Dissertation</u></i>	1991	Dean Rubine	<u>N/A</u>
J-3	<i>Specifying Gestures of Example</i>	July 1, 1991	Dean Rubine	<u>Computer Graphics Vol. 25, No. 4</u>
J-3	<i>Integrating Gesture Recognition and Direct Manipulation</i>	1991	Dean Rubine	<u>Proceedings of '91 USENIX Technical Conference (Summer)</u>
J-3	<i>Combining Gestures and Direct Manipulation</i>	1992	Dean Rubine	<u>CHI-92</u>
J-4	<i>HybridTouch: an intuitive manipulation technique for PDAs using their front and rear surfaces</i>	2006	Masanori Sugimoto and Keiichi Hiroki	<u>Proceedings of the 8th Conference on Human-Computer Interaction with Mobile Devices and Services 2006 ("MobileHCI" '06).</u>
J-5	<i>. <u>Multi-touch interaction wall</u></i>	2006	Jefferson Y. Han.	ACM SIGGRAPH

Chart No(s).	Title	Date of Publication	Author	Publisher
				2006 Emerging technologies (SIGGRAPH '06). ACM, New York, NY, USA, , Article 25 . ("Multi-touch Wall")
J-5	<i>Synthesis and control on large scale multi-touch sensing displays.</i>	2006	Philip L. Davidson and Jefferson Y. Han	In Proceedings of the 2006 conference on New interfaces for musical expression (NIME '06).
J-5	<i>Low-cost multi-touch sensing through frustrated total internal reflection.</i>	2006	Jefferson Y. Han	In Proceedings of the 18th annual ACM symposium on User interface software and technology (UIST '05).
J-5	<i>Unveiling the Genius of Multi-Touch Interface Design (a/k/a "TED Video")</i>	2006	Jefferson Y. Han	<u>available at <a href="http://www.ted.com/talks/jeff_han_demos_his_breakthrough_touchscreen.html">http://www.ted.com/talks/jeff_han_demos_his_breakthrough_touchscreen.html</a></u>

### 3. Systems

All versions of the following prior art systems commercially sold, publicly known or used before the priority date of the '915 Patent, including documents and source code describing the same:

Chart No(s).	System	Date Offered	Offering Entity
J-1	Diamond Touch Table	At Least as Early as November 2002	Mitsubishi Electronic Research Laboratory
J-2	Sony SmartSkin System	At Least as Early as 2002	Sony Corp.
J-3	Dean Rubine GDP and MDP Systems	1991	Dean Rubine/SGI Inc.
J-4	HybridTouch System	2006	Various
J-5	Jeff Han Multi-Touch System(s)	2004	Jeff Han, Perceptive Pixel, New York University

1 Additional prior art that has not been charted, but is still relevant to the invalidity of the  
2 '915 Patent is listed as background or combinatory references in Exhibits J-1 through J-6.  
3 Samsung reserves the right to amend these invalidity contentions to assert these references  
4 depending on the claim construction and infringement positions Apple may take as the case  
5 proceeds. Moreover, Samsung reserves the right to use these references in combination with other  
6 references to render the claims of the '915 Patent obvious in the event Apple takes the position  
7 that certain claim limitations are missing from the references charted in Exhibits J and L.

8 **B. Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders**  
9 **Obvious the Asserted Claims**

10 Plaintiff asserts claims 1-21 of the '915 Patent against Samsung in this lawsuit. All of  
11 those claims are invalid because the '915 Patent fails to meet one or more of the requirements for  
12 patentability. The individual bases for invalidity are provided below and in the claim charts  
13 attached as Exhibit J. Each of the foregoing listed prior art documents, the underlying work,  
14 and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35  
15 U.S.C. § 102 and/or 35 U.S.C. § 103.

16 Although Samsung has identified at least one citation per limitation for each reference,  
17 each and every disclosure of the same limitation in the same reference is not necessarily identified.  
18 Rather, in an effort to focus the issues, Samsung has cited representative portions of identified  
19 references, even where a reference may contain additional support for a particular claim element.  
20 In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and  
21 in the context of other publications and literature. Thus, to understand and interpret any specific  
22 statement or disclosure within a prior art reference, such persons would rely on other information  
23 within the reference, along with other publications and their general scientific knowledge.  
24 Samsung may rely upon uncited portions of the prior art references and on other publications and  
25 expert testimony to provide context, and as aids to understanding and interpreting the portions that  
26 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed  
27 publications, and the testimony of experts to establish that a person of ordinary skill in the art  
28

1 would have been motivated to modify or combine certain of the cited references so as to render the  
2 claims obvious.

3 **4. Anticipation**

4 Some or all of the asserted claims of the '915 Patent are invalid as anticipated under 35  
5 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts  
6 included in Exhibit J, which identify specific examples of where each limitation of the asserted  
7 claims is found in the prior art references. As explained above, the cited portions of prior art  
8 references identified in the attached claim charts are exemplary only and representative of the  
9 content and teaching of the prior art references, and should be understood in the context of the  
10 reference as a whole and as they would be understood by a person of ordinary skill in the art.

11 **5. Obviousness**

12 To the extent any limitation is deemed not to be exactly met by an item of prior art listed  
13 above and in Exhibit J, then any purported differences are such that the claimed subject matter as a  
14 whole would have been obvious to one skilled in the art at the time of the alleged invention, in  
15 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,  
16 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

17 In addition, the references identified above render one or more asserted claims of the '915  
18 Patent obvious when the references are read in combination with each other, and/or when read in  
19 view of the state of the art and knowledge of those skilled in the art. Each and every reference  
20 identified is also relevant to the state of the art at the time of the alleged invention. Any of the  
21 references disclosed above may be combined to render obvious (and therefore invalid) each of  
22 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or  
23 all of the references identified above, including all references in Exhibits J and K, for purposes of  
24 obviousness depending on the Court's claim construction, positions taken by Apple during this  
25 litigation, and further investigation and discovery.

26 Moreover, to the extent the foregoing references are found not to anticipate the asserted  
27 claims, the foregoing references render the asserted claims obvious either alone or in combination  
28

1 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained  
2 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art  
3 at the time of the alleged invention of the asserted claims of the '915 Patent to combine the various  
4 references cited herein so as to practice the asserted claims of the '915 Patent.

5  
6 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,  
7 alone or in combination with other references, are outlined below and included in Exhibits J and L,  
8 which includes exemplary claim charts for the asserted claims of the '915 Patent showing  
9 specifically where in each reference or combinations of references each asserted claim is found,  
10 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the  
11 charts in Exhibit J and L include the motivation to combine references.

12  
13 In particular, Samsung contends that the asserted claims of the '915 Patent would have  
14 been obvious in view of the prior art references identified above. For example, Exhibit L includes  
15 exemplary claim charts that describe how the asserted claims of the '915 Patent would have been  
16 obvious in view of the following references alone or in combination:

- 17 • All references identified in Exhibit J-1 through J-6, if found not to anticipate the  
18 claims of the '915 Patent, render the claims of the '915 Patent obvious alone;
- 19 • Exhibit J-2: Sony SmartSkin references disclosed explicitly above under chart J-2  
20 for anticipation purposes in combination with one or more of (a) U.S. Patent  
21 Publication 2007/0132789 to Ording et al, (b) the LaunchTile system, (c) the XNav  
22 system.
- 23 • Exhibit J-3: Rubine references disclosed explicitly above under chart J-3 for  
24 anticipation purposes in combination with one or more of (a) U.S. Patent  
25 Publication 2007/0132789 to Ording et al, (b) the LaunchTile system, (c) the XNav  
26 system, Masanori Sugimoto and Keiichi Hiroki. *HybridTouch: an intuitive*  
27 *manipulation technique for PDAs using their front and rear surfaces*; Proceedings

1                    of the 8th Conference on Human-Computer Interaction with Mobile Devices and  
2                    Services 2006 (“MobileHCI” ’06). ACM, New York, NY, USA, 137-140.

- 3                    •     Exhibit J-4: HybridTouch reference disclosed explicitly above under chart J-4 for  
4                    anticipation purposes in combination with one or more of (a) U.S. Patent  
5                    Publication 2007/0132789 to Ording et al, (b) the LaunchTile system, (c) the XNav  
6                    system.
- 7                    •     Exhibit J-5: Han references disclosed explicitly above under chart J-5 for  
8                    anticipation purposes in combination with one or more of (a) U.S. Patent  
9                    Publication 2007/0132789 to Ording et al, (b) the LaunchTile system, (c) the XNav  
10                  system.
- 11                  •     Exhibit J-6: Nomura Patent disclosed explicitly above under char J-5 for  
12                  anticipation purposes in combination with one or more of (a) U.S. Patent  
13                  Publication 2007/0132789 to Ording et al, (b) the LaunchTile system, (c) the XNav  
14                  system, (d) “The Automatic Recognition of Gestures,” Dean Rubine, PhD Thesis,  
15                  1991.

16                  In addition to the specific combinations of prior art and the specific combinations of  
17 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any  
18 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations  
19 disclosed within the prosecution history of the references cited herein. These obviousness  
20 combinations reflect Samsung’s present understanding of the potential scope of the claims that  
21 Plaintiff appears to be advocating and should not be seen as Samsung’s acquiescence to Plaintiff’s  
22 interpretation of the patent claims.

23                  Samsung also reserves the right to amend or supplement these contentions regarding  
24 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,  
25 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has  
26 not identified what elements or combinations it alleges were not known to one of ordinary skill in  
27 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a  
28 particular prior art reference, Samsung reserves the right to assert that any such limitation is either

1 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light  
2 of the same, or that the limitation is disclosed in another of the references disclosed above and in  
3 combination would have rendered the asserted claim obvious.

4 **C. Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**  
5 **Alleged item of Prior Art each Asserted Claim is Found**

6 Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged  
7 item of prior art each limitation of each asserted claim is found, including for each limitation that  
8 Apple contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or  
9 material(s) in each item of prior art that performs the claimed function is attached in Exhibits J and  
10 L.

11 **D. Local Patent Rule 3-3(d): Other Grounds for Invalidity**

12 Samsung identifies the following grounds for invalidity of the asserted claims of the '915  
13 Patent based on 35 U.S.C. §§ 101 and/or 112. Samsung reserves the right to supplement these  
14 disclosures based on further investigation and discovery.

15 **6. Invalidity Based on 35 U.S.C. § 101**

16 The asserted claims of the '915 Patent are invalid under 35 U.S.C. § 101 because they only  
17 claim abstract ideas. Many limitations in the asserted claims are common abstractions in  
18 computer systems and programming languages. For example, both “event object” and “invoking a  
19 call” are programming language abstractions; these are concepts, not physical objects or tangible  
20 classes.

21 **7. Invalidity Based on Enablement or Written Description Under 35**  
22 **U.S.C. § 112(1) and/or Indefiniteness Under 35 U.S.C. § 112(2)**

23 Based on Samsung's present understanding of Plaintiff's infringement contentions,  
24 Samsung asserts that claims 1-21 of the '915 Patent are invalid for reciting at least the following  
25 claim terms/phrases:

- 26 • “event object”
- 27 • “integrated with the device”
- 28 • “invokes a scroll or gesture operation”



- 1 • “view associated with the event object”
- 2 • “based on an amount of a scroll”
- 3 • “predetermined position in relation to the user input”
- 4 • “predetermined maximum displacement”
- 5 • “rubberbanding”
- 6

7 These claim terms/phrases as apparently construed by Apple violate the written description,  
8 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

9 Based on Samsung's present understanding of Plaintiff's infringement contentions, at least  
10 one or more of these claim terms/phrases are indefinite because they are inconsistent with and  
11 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent  
12 constructions of the claims, any person of ordinary skill in the art at the time of the invention  
13 would not understand what is claimed, even when the claims are read in light of the specification.  
14 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each  
15 of the asserted claims in which these claim terms/phrases appear lack written description because  
16 the specification of the '915 Patent demonstrates that the patentee neither conceived of nor  
17 demonstrated possession of all that Apple now contends the claims cover. In addition, based on  
18 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted  
19 claims in which these claim terms/phrases appear are invalid because the specification fails to  
20 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,  
21 or with which it is most nearly connected, to implement the invention without undue  
22 experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

23 **V. THE '891 PATENT**

24 **A. Local Patent Rule 3-3(a): Identification of Prior Art**

25 At this time, Samsung contends that at least the following prior art references anticipate or  
26 render obvious, either alone or in combination, the asserted claims of the '891 Patent:  
27  
28

1                                    1.        **Patent References**<sup>14</sup>

Chart No(s).	Country of Origin	Patent Number	Date of Issue	Priority Date
M-1	US	6,907,447	6/14/2005	4/30/2001
M-2	US	7,155,729	12/26/2006	3/28/2000
M-3	US	7,249,326	7/24/2007	4/6/2000
M-4	US	7,417,650	8/26/2008	3/16/2000
M-5	US	2002/0143630	10/3/2002	1/10/2001
M-6	EP	1 022 650	7/26/2000	1/19/1999
M-7	WO	01/69387	9/20/2001	3/16/2000

7                                    2.        **Publications**<sup>15</sup>

Chart No(s).	Title	Date of Publication	Author	Publisher
M-8	Popout Prism: Adding Perceptual Principles to Overview+Detail Document Interfaces	4/2002	Suh et al.	Association for Computing Machines
M-9	TransPort LT User's Guide	1/20/2000	Micron Electronics Inc.	Micron Electronics Inc.

12                                    3.        **Systems**

13                                    All versions of the following prior art systems commercially sold, publicly known or used  
14 before the priority date of the '891 Patent, including documents and source code describing the  
15 same:  
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Chart No(s).	System	Date Offered	Offering Entity
M-10	ATI Multimedia Center	Before 7/10/2002	ATI Technologies Inc.
M-11	Crusader: No Remorse and Crusader: No Regret	Before 7/10/2002	Electronic Arts
M-12	Grand Theft Auto III	Before 7/10/2002	Rockstar Games
M-13	Micron Computers	Before 7/10/2002	Micron
M-14	Sony Computer Displays, including Sony Trinitron, and Computers with Sony Computer Displays	Before 7/10/2002	Sony
M-15	Windows XP and Computers with Windows XP	Before 7/10/2002	Microsoft and/or Various Computer Manufacturers

26                                    <sup>14</sup> Samsung incorporates by reference all prior art references cited in the patents listed herein  
27 and/or their file histories.

28                                    <sup>15</sup> Samsung incorporates by reference all prior art references identified in the publications  
listed herein.

1 Additional prior art that has not been charted, but is still relevant to the invalidity of the  
2 '891 Patent is listed in Exhibit N. Samsung reserves the right to amend these invalidity  
3 contentions to assert these references depending on the claim construction and infringement  
4 positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these  
5 references in combination with other references to render the claims of the '891 Patent obvious in  
6 the event Apple takes the position that certain claim limitations are missing from the references  
7 charted in Exhibits M and O.

8 **B. Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders**  
9 **Obvious the Asserted Claims**

10 Plaintiff asserts claims 1-3, 5-7, 14-21, 23, 24, 26-28, 30-32, 39-46, 48, 49, 51-53, 55-57,  
11 64-71, 73, and 74 of the '891 Patent against Samsung in this lawsuit. All of those claims are  
12 invalid because the '891 Patent fails to meet one or more of the requirements for patentability.  
13 The individual bases for invalidity are provided below and in the claim charts attached as Exhibits  
14 M and O. Each of the foregoing listed prior art documents, the underlying work, and/or the  
15 underlying apparatus or method qualifies as prior art under one or more sections of 35 U.S.C. §  
16 102 and/or 35 U.S.C. § 103.

17 Although Samsung has identified at least one citation per limitation for each reference,  
18 each and every disclosure of the same limitation in the same reference is not necessarily identified.  
19 Rather, in an effort to focus the issues, Samsung has cited representative portions of identified  
20 references, even where a reference may contain additional support for a particular claim element.  
21 In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and  
22 in the context of other publications and literature. Thus, to understand and interpret any specific  
23 statement or disclosure within a prior art reference, such persons would rely on other information  
24 within the reference, along with other publications and their general scientific knowledge.  
25 Samsung may rely upon uncited portions of the prior art references and on other publications and  
26 expert testimony to provide context, and as aids to understanding and interpreting the portions that  
27 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed  
28 publications, and the testimony of experts to establish that a person of ordinary skill in the art

1 would have been motivated to modify or combine certain of the cited references so as to render the  
2 claims obvious.

3 **4. Anticipation**

4 Some or all of the asserted claims of the '891 Patent are invalid as anticipated under 35  
5 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts  
6 included in Exhibit M, which identify specific examples of where each limitation of the asserted  
7 claims is found in the prior art references. As explained above, the cited portions of prior art  
8 references identified in the attached claim charts are exemplary only and representative of the  
9 content and teaching of the prior art references, and should be understood in the context of the  
10 reference as a whole and as they would be understood by a person of ordinary skill in the art.

11 **5. Obviousness**

12 To the extent any limitation is deemed not to be exactly met by an item of prior art listed  
13 above and in Exhibit M, then any purported differences are such that the claimed subject matter as  
14 a whole would have been obvious to one skilled in the art at the time of the alleged invention, in  
15 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,  
16 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

17 In addition, the references identified above render one or more asserted claims of the '891  
18 Patent obvious when the references are read in combination with each other, and/or when read in  
19 view of the state of the art and knowledge of those skilled in the art. Each and every reference  
20 identified is also relevant to the state of the art at the time of the alleged invention. Any of the  
21 references disclosed above may be combined to render obvious (and therefore invalid) each of  
22 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or  
23 all of the references identified above, including all references in Exhibits M, N, and O, for  
24 purposes of obviousness depending on the Court's claim construction, positions taken by Apple  
25 during this litigation, and further investigation and discovery.

26 Moreover, to the extent the foregoing references are found not to anticipate the asserted  
27 claims, the foregoing references render the asserted claims obvious either alone or in combination  
28

1 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained  
2 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art  
3 at the time of the alleged invention of the asserted claims of the '891 Patent to combine the various  
4 references cited herein so as to practice the asserted claims of the '891 Patent.

5  
6 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,  
7 alone or in combination with other references, are outlined below and included in Exhibits M and  
8 O, which includes exemplary claim charts for the asserted claims of the '891 Patent showing  
9 specifically where in each reference or combinations of references each asserted claim is found,  
10 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the  
11 charts in Exhibit M and O include the motivation to combine references.

12  
13 In particular, Samsung contends that the asserted claims of the '891 Patent would have  
14 been obvious in view of the prior art references identified above. For example, Exhibit O includes  
15 exemplary claim charts that describe how the asserted claims of the '891 Patent would have been  
16 obvious in view of the following references alone or in combination:

- 17 • All references identified in Exhibit M, if found not to anticipate the claims of the  
18 '891 Patent, render the claims of the '891 Patent obvious alone;
- 19 • Exhibit O-1: US 2003/0016253 (Aoki '253) and Cooperman '447, Andrew '729,  
20 Stoakley '326, Horvitz '650, Steinman '630, Sakaguchi '650, Suh, Micron, ATI,  
21 Crusader, GTA3, Micron Computers, Sony Trinitron, Windows XP, and/or U.S.  
Patent Application No. 2003/0051228 ("Martinez")

22 In addition to the specific combinations of prior art and the specific combinations of  
23 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any  
24 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations  
25 disclosed within the prosecution history of the references cited herein. These obviousness  
26 combinations reflect Samsung's present understanding of the potential scope of the claims that  
27 Plaintiff appears to be advocating and should not be seen as Samsung's acquiescence to Plaintiff's  
28 interpretation of the patent claims.

1 Samsung also reserves the right to amend or supplement these contentions regarding  
2 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,  
3 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has  
4 not identified what elements or combinations it alleges were not known to one of ordinary skill in  
5 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a  
6 particular prior art reference, Samsung reserves the right to assert that any such limitation is either  
7 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light  
8 of the same, or that the limitation is disclosed in another of the references disclosed above and in  
9 combination would have rendered the asserted claim obvious.

10 **C. Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**  
11 **Alleged item of Prior Art each Asserted Claim is Found**

12 Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged  
13 item of prior art each limitation of each asserted claim is found, including for each limitation that  
14 Apple contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or  
15 material(s) in each item of prior art that performs the claimed function is attached in Exhibits M  
16 and O.

17 **D. Local Patent Rule 3-3(d): Other Grounds for Invalidity**

18 Samsung identifies the following grounds for invalidity of the asserted claims of the '891  
19 Patent based on 35 U.S.C. §§ 101 and/or 112. Samsung reserves the right to supplement these  
20 disclosures based on further investigation and discovery.

21 **1. Invalidity Based on 35 U.S.C. § 101**

22 The asserted claims of the '891 patent are invalid under 35 U.S.C. § 101 because they only  
23 claim abstract ideas. For example, “starting a timer”; “closing the first window in response to a  
24 determination that the timer expired”; “the first window has been displayed independently from a  
25 position of a cursor on the screen”; “displaying a first window”; “the first window being  
26 translucent; “at least a portion of a second window being capable of being displayed on the digital  
27 processing system under the first window, the portion of the second window, when present, being  
28 visible under the first window on a screen”; and “closing the first window without user input” are

1 each programming language abstractions; these are concepts, not physical objects, machines, or  
2 transformations.

3                   2.       **Invalidity Based on Enablement or Written Description Under 35**  
4                               **U.S.C. § 112(1) and/or Indefiniteness Under 35 U.S.C. § 112(2)**

5                   Based on Samsung's present understanding of Plaintiff's infringement contentions,  
6 Samsung asserts that claims 1-3, 5-7, 14-21, 23, 24, 26-28, 30-32, 39-46, 48, 49, 51-53, 55-57, 64-  
7 71, 73, and 74 of the '891 Patent are invalid for reciting at least the following claim terms/phrases:

- 8                   •   “starting a timer”
- 9                   •   “closing the first window in response to a determination that the timer expired”
- 10                  •   “the first window does not close in response to any input from a user input device  
11                   of the digital processing system”
- 12                  •   “the first window has been displayed independently from a position of a cursor on  
13                   the screen”
- 14                  •   “translucent”
- 15                  •   “the first window is at a top level in a window displaying hierarchy”
- 16                  •   “the first window does not respond to any input from a user input device of the  
17                   digital processing system”
- 18                  •   “determining a position on a display of the digital processing system independent  
19                   of a position of a cursor on the display”
- 20                  •   “restarting the timer in response to receiving a second input for the first window”
- 21                  •   “closing the first window without user input”
- 22                  •   “determining whether or not a condition is met”
- 23                  •   “said closing the first window is in response to a determination that the condition is  
24                   met”
- 25                  •   “means for displaying a first window in response to receiving a first input from a  
26                   user input device of the digital processing system”
- 27                  •   “means for starting a timer”
- 28                  •   “means for closing the first window in response to a determination that the timer  
                      expired”

- 1 • “means for fading out an image of the first window”
- 2 • “means for determining a position on a display of the digital processing system
- 3 independent of a position of a cursor on the display”
- 4 • “means for restarting the timer in response to receiving a second input for the first
- 5 window”
- 6 • “means for displaying a first window, the first window being translucent”
- 7 • “means for closing the first window without user input”
- 8 • “means for determining whether or not a condition is met”

9 These claim terms/phrases as apparently construed by Apple violate the written description,  
10 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

11 Based on Samsung's present understanding of Plaintiff's infringement contentions, at least  
12 one or more of these claim terms/phrases are indefinite because they are inconsistent with and  
13 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent  
14 constructions of the claims, any person of ordinary skill in the art at the time of the invention  
15 would not understand what is claimed, even when the claims are read in light of the specification.  
16 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each  
17 of the asserted claims in which these claim terms/phrases appear lack written description because  
18 the specification of the '891 Patent demonstrates that the patentee neither conceived of nor  
19 demonstrated possession of all that Apple now contends the claims cover. In addition, based on  
20 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted  
21 claims in which these claim terms/phrases appear are invalid because the specification fails to  
22 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,  
23 or with which it is most nearly connected, to implement the invention without undue  
24 experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

## 25 **VI. THE '607 PATENT**

### 26 **A. Local Patent Rule 3-3(a): Identification of Prior Art**

27 At this time, Samsung contends that at least the following prior art references anticipate or  
28 render obvious, either alone or in combination, the asserted claims of the '607 Patent:



1                    1.        **Patent References**<sup>16</sup>

2

Chart No(s).	Country of Origin	Patent Number	Date of Issue	Priority Date
P-1	US	7,372,455	4/13/2008	2/10/2003
P-2	US	6,790,160	11/19/2005	12/19/2002
P-3	US	4,686,332	8/11/1987	6/26/1986
P-4	US	7,218,314	5/15/2007	6/7/2001
P-5	JP	2002-342033	11/29/2001	5/21/2001
P-6	US	5,920,309	7/6/1999	1/4/1996
P-7	US	5,543,588	8/6/1996	12/3/1993
P-8	US	2003/0069653	4/10/2003	10/9/2001

8                    2.        **Publications**<sup>17</sup>

9

Chart No(s).	Title	Date of Publication	Author	Publisher
P-9	“Integration of a Clear Capacitive Touch Screen with a 1/8-VGA FSTN-LCD To Form and LCD-Based TouchPad”	5/21/2002	A.K Leeper (Synaptics Inc.)	Society for Information Display
P-10	“Smartskin: An Infrastructure for Freehand Manipulation on Interactive Surfaces”	2001	Jun Rekimoto	Association for Computing Machinery
P-11	“DiamondTouch: A Multi-User Touch Technology”	2001	Paul Dietz and Darren Leigh	Association for Computing Machinery

15                    3.        **Systems**

16                    All versions of the following prior art systems commercially sold, publicly known or used  
17 before the priority date of the ’607 Patent, including documents and source code describing the  
18 same:  
19

20

Chart No(s).	System	Date Offered	Offering Entity
P-7	Synaptics clearPad (cPad)	April 2001	Synaptics Incorporated
P-10	Sony Smartskin	2002	Sony Corp.
P-11	MERL DiamondTouch	2002	Mitsubishi Electric
P-8	Quantum Research Group QT603xx sensor	2002	Quantum Research Group

24                    Additional prior art that has not been charted, but is still relevant to the invalidity of the  
25 ’607 Patent is listed in Exhibit Q. Samsung reserves the right to amend these invalidity

26                    \_\_\_\_\_  
27                    <sup>16</sup> Samsung incorporates by reference all prior art references cited in the patents listed herein  
and/or their file histories.

28                    <sup>17</sup> Samsung incorporates by reference all prior art references identified in the publications  
listed herein.

1 contentions to assert these references depending on the claim construction and infringement  
2 positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these  
3 references in combination with other references to render the claims of the '607 Patent obvious in  
4 the event Apple takes the position that certain claim limitations are missing from the references  
5 charted in Exhibits P and R.

6 **B. Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders**  
7 **Obvious the Asserted Claims**

8 Plaintiff asserts claims 1-3, 6-8, and 10-11 of the '607 Patent against Samsung in this  
9 lawsuit. All of those claims are invalid because the '607 Patent fails to meet one or more of the  
10 requirements for patentability. The individual bases for invalidity are provided below and in the  
11 claim charts attached as Exhibits P and R. Each of the foregoing listed prior art documents, the  
12 underlying work, and/or the underlying apparatus or method qualifies as prior art under one or  
13 more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

14 Although Samsung has identified at least one citation per limitation for each reference,  
15 each and every disclosure of the same limitation in the same reference is not necessarily identified.  
16 Rather, in an effort to focus the issues, Samsung has cited representative portions of identified  
17 references, even where a reference may contain additional support for a particular claim element.  
18 In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and  
19 in the context of other publications and literature. Thus, to understand and interpret any specific  
20 statement or disclosure within a prior art reference, such persons would rely on other information  
21 within the reference, along with other publications and their general scientific knowledge.  
22 Samsung may rely upon uncited portions of the prior art references and on other publications and  
23 expert testimony to provide context, and as aids to understanding and interpreting the portions that  
24 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed  
25 publications, and the testimony of experts to establish that a person of ordinary skill in the art  
26 would have been motivated to modify or combine certain of the cited references so as to render the  
27 claims obvious.  
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**4. Anticipation**

Some or all of the asserted claims of the '607 Patent are invalid as anticipated under 35 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts included in Exhibit P, which identify specific examples of where each limitation of the asserted claims is found in the prior art references. As explained above, the cited portions of prior art references identified in the attached claim charts are exemplary only and representative of the content and teaching of the prior art references, and should be understood in the context of the reference as a whole and as they would be understood by a person of ordinary skill in the art.

**5. Obviousness**

To the extent any limitation is deemed not to be exactly met by an item of prior art listed above and in Exhibit P, then any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge of those skilled in the art. The item of prior art would, therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

In addition, the references identified above render one or more asserted claims of the '607 Patent obvious when the references are read in combination with each other, and/or when read in view of the state of the art and knowledge of those skilled in the art. Each and every reference identified is also relevant to the state of the art at the time of the alleged invention. Any of the references disclosed above may be combined to render obvious (and therefore invalid) each of Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or all of the references identified above, including all references in Exhibits P, Q, and R, for purposes of obviousness depending on the Court's claim construction, positions taken by Apple during this litigation, and further investigation and discovery.

Moreover, to the extent the foregoing references are found not to anticipate the asserted claims, the foregoing references render the asserted claims obvious either alone or in combination with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art

1 at the time of the alleged invention of the asserted claims of the '607 Patent to combine the various  
2 references cited herein so as to practice the asserted claims of the '607 Patent.

3 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,  
4 alone or in combination with other references, are outlined below and included in Exhibits P and  
5 R, which includes exemplary claim charts for the asserted claims of the '607 Patent showing  
6 specifically where in each reference or combinations of references each asserted claim is found,  
7 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the  
8 charts in Exhibit P and R include the motivation to combine references.  
9

10 In particular, Samsung contends that the asserted claims of the '607 Patent would have  
11 been obvious in view of the prior art references identified above. For example, Exhibit R includes  
12 exemplary claim charts that describe how the asserted claims of the '607 Patent would have been  
13 obvious in view of the following references alone or in combination:  
14

- 15 • All references identified in Exhibit P, if found not to anticipate the claims of the  
16 '607 Patent, render the claims of the '607 Patent obvious alone;
- 17 • Exhibit R-1: Philipp U.S. Patent No. 6,452,5154 in view of Caldwell et al. U.S.  
18 Patent No. 5,572,205
- 19 • Exhibit R-2: Gerpheide et al. U.S. Patent No. 5,565,658 in view of Gerpheide U.S.  
20 Patent No. 5,305,017

21 In addition to the specific combinations of prior art and the specific combinations of  
22 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any  
23 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations  
24 disclosed within the prosecution history of the references cited herein. These obviousness  
25 combinations reflect Samsung's present understanding of the potential scope of the claims that  
26 Plaintiff appears to be advocating and should not be seen as Samsung's acquiescence to Plaintiff's  
27 interpretation of the patent claims.  
28

1 Samsung also reserves the right to amend or supplement these contentions regarding  
2 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,  
3 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has  
4 not identified what elements or combinations it alleges were not known to one of ordinary skill in  
5 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a  
6 particular prior art reference, Samsung reserves the right to assert that any such limitation is either  
7 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light  
8 of the same, or that the limitation is disclosed in another of the references disclosed above and in  
9 combination would have rendered the asserted claim obvious.

10 **C. Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**  
11 **Alleged item of Prior Art each Asserted Claim is Found**

12 Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged  
13 item of prior art each limitation of each asserted claim is found, including for each limitation that  
14 Apple contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or  
15 material(s) in each item of prior art that performs the claimed function is attached in Exhibits P  
16 and R.

17 **D. Local Patent Rule 3-3(d): Other Grounds for Invalidity**

18 Samsung identifies the following grounds for invalidity of the asserted claims of the '607  
19 Patent based on 35 U.S.C. §§ 101 and/or 112. Samsung reserves the right to supplement these  
20 disclosures based on further investigation and discovery.

21 **1. Invalidity Based on Enablement or Written Description Under 35**  
22 **U.S.C. § 112(1) and/or Indefiniteness Under 35 U.S.C. § 112(2)**

23 Based on Samsung's present understanding of Plaintiff's infringement contentions,  
24 Samsung asserts that claims 1-3, 6-8, 10, and 11 of the '607 Patent are invalid for reciting at least  
25 the following claim terms/phrases:

- 26 • “configured to detect multiple touches or near touches that occur at a same time and  
27 at distinct locations”
- 28 • “produce distinct signals”

- 1 • “detect changes in charge coupling between the first conductive lines and the
- 2 second conductive lines”
- 3 • “substantially parallel”
- 4 • “substantially perpendicular”
- 5 • “pixilated image”
- 6 • “recognizing multiple touch events that occur at different locations on the touch
- 7 panel at a same time”
- 8 • “dummy features”
- 9

10 These claim terms/phrases as apparently construed by Apple violate the written description,  
11 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

12 Based on Samsung's present understanding of Plaintiff's infringement contentions, at least  
13 one or more of these claim terms/phrases are indefinite because they are inconsistent with and  
14 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent  
15 constructions of the claims, any person of ordinary skill in the art at the time of the invention  
16 would not understand what is claimed, even when the claims are read in light of the specification.  
17 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each  
18 of the asserted claims in which these claim terms/phrases appear lack written description because  
19 the specification of the '607 Patent demonstrates that the patentee neither conceived of nor  
20 demonstrated possession of all that Apple now contends the claims cover. In addition, based on  
21 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted  
22 claims in which these claim terms/phrases appear are invalid because the specification fails to  
23 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,  
24 or with which it is most nearly connected, to implement the invention without undue  
25 experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.  
26  
27  
28

1 **VII. THE '163 PATENT**

2 **A. Local Patent Rule 3-3(a): Identification of Prior Art**

3 At this time, Samsung contends that at least the following prior art references anticipate or  
4 render obvious, either alone or in combination, the asserted claims of the '163 Patent:

5 1. **Patent References<sup>18</sup>**

Chart No(s).	Country of Origin	Patent Number	Date of Issue
S-1	United States	6,211,856	April 3, 2001
S-2	United States	7,327,349	February 5, 2008
S-3	United States	5,615,384	March 25, 1997
S-4	United States	5,579,037	November 26, 1996
S-5	United States	4,899,292	February 6, 1990
S-6, U	United States	5,877,751	March 2, 1999
U	United States	7,933,632	April 26, 2011
U	United States	7,089,507	August 8, 2006
U	United States	6,054,990	April 25, 2000
U	United States	7,289,102	October 30, 2007
U	United States	6,157,935	December 5, 2000
U	United States	5,463,725	October 31, 1995
U	United States	7,138,983	November 21, 2006
U	United States	7,522,198	April 21, 2009
U	United States	7,852,357	December 9, 2010
U	United States	7,327,932	February 5, 2008
U	Japan	20000163031A	June 16, 2000

16 2. **Publications<sup>19</sup>**

Chart No(s).	Title	Date of Publication	Author	Publisher
S-7, U	AppLens and LaunchTile: Two Designs for One-Handed Thumb Use on Small Devices	2005 (submitted to CHI Conference by Sep. 13, 2004)	Karlson, Amy; Bederson, Benjamin, SanGiovanni, John	Association for Computing Machinery
S-8	West: A Web Browser for Small Terminals	1999	Bjork	Association for Computing Machinery
S-6	2002/0030699 Hand-Held with Auto-Zoom for Graphical Display of Web Page	March 14, 2002	Jan Van Ee (Inventor)	United States Patent Office
S-2	ZoneZoom: Map Navigation for	January 2004	Robbins, Daniel C.; Cutrell,	Association for Computing

18 <sup>18</sup> Samsung incorporates by reference all prior art references cited in the patents listed herein  
19 and/or their file histories.

20 <sup>19</sup> Samsung incorporates by reference all prior art references identified in the publications  
21 listed herein.

Chart No(s).	Title	Date of Publication	Author	Publisher
	Smartphones with Recursive View Segmentation		Edward; Sarin, Raman; Horvitz, Eric	Machinery
S-9	2005/0195221 System and Method for Facilitating the Presentation of Content via Device Displays	September 8, 2005	Berger et al.	United States Patent Office
U	2004/0107403 Presenting HTML Content on a Small Screen Terminal Display	June 3, 2004	Jon Stephenson Von Tetzchner	United States Patent Office
U	2006/0048051 Method for Rendering Formatted Content on a Mobile Device	March 2, 2006	Mihal Lazaridis	United States Patent Office
U	2002/0069220 Remote Data Access and Management System Utilizing Handwriting Input	June 6, 2002	Bao Q. Tran	United States Patent Office
U	2009/0135162 System and Method for Detecting the Location, Size, and Shape of Multiple Objects that Interact with a Touch Screen Display	May 28, 2009	Wijdeven et al.	United States Patent Office
U	2006/0101354 Gesture inputs for a Portable Display Device	May 11, 2006	Hashimoto et al.	United States Patent Office
U	2006/0026535 Mode Based Graphical User Interfaces for Touch Sensitive Input Devices	February 2, 2006	Hotelling et al.	United States Patent Office
U	2004/0236790 Systems and Methods for Digital Document Processing	November 25, 2004	Majid Anwar	United States Patent Office
U	2002/0060701 Graphical user interface for displaying and navigating in a directed graph structure	May 23, 2002	Patrick J. Naughton et al.	United States Patent Office



1                                    3.        **Systems**<sup>20</sup>

2                    All versions of the following prior art systems commercially sold, publicly known or used  
3 before the priority date of the '163 Patent, including documents and source code describing the  
4 same:

5

<b>Chart No(s).</b>	<b>System</b>	<b>Date Offered/Known</b>	<b>Offering Entity</b>
6        S-7	LaunchTile Software <sup>21</sup>	September 2004	Ben Bederson <i>et al.</i>
7        S-2	ZoneZoom Flash Prototype	At least as early as January 2004	Microsoft <sup>22</sup>
8        S-2	SmartPhlow Traffic Monitoring Application	At least as early as January 2004	Microsoft <sup>23</sup>
9        S-10	XNav	At least as early as August 25, 2005	Ben Bederson <i>et al.</i>
10       U	Jeff Han's Breakthrough Touchscreen, <i>See</i> <a href="http://blog.ted.com/2006/08/01/jeff_han_on_ted">http://blog.ted.com/2006/08/01/jeff_han_on_ted</a>	At least as early as August 1, 2006	Jeff Han

11

12

13                    Additional prior art that that is relevant to the invalidity of the '163 Patent is listed in  
14 Exhibit T. Samsung reserves the right to amend these invalidity contentions to assert these  
15 references depending on the claim construction and infringement positions Apple may take as the  
16 case proceeds. Moreover, Samsung reserves the right to use these references in combination with

17                    <sup>20</sup> Discovery, and in particular, third party discovery is ongoing. As discovery is in the early  
18 stages, Samsung is not yet in possession of all evidence regarding the systems that invalidate the  
19 '163 patent. Where possible, Samsung has cited to documentation that evidences the systems'  
20 practicing of the invention. However, Samsung anticipates amending these contentions as  
21 discovery progresses.

22                    <sup>21</sup> The LaunchTile software is described in AppLens and LaunchTile: Two Designs for One-  
23 Handed Thumb Use on Small Devices, *Bederson et al.*, CHI 2005, ACM, Apr. 2-7, 2005 (Exhibits  
24 A-C to the Bederson Declaration filed Aug. 22, Dkt. No. 165); Video Demonstration of  
25 LaunchTile (Exhibit D to the Bederson Declaration filed Aug. 22, Dkt. No. 165); PowerPoint  
26 slides displayed at the CHI conference (Exhibit E to the Bederson Declaration filed Aug. 22, Dkt.  
27 No. 165); Executable version of LaunchTile (Exhibit F to the Bederson Declaration filed Aug. 22,  
28 Dkt. No. 165). In addition to being attached the Bederson declaration filed on August 22, these  
documents have been previously produced in this litigation.

29                    <sup>22</sup> *See* ZoneZoom: Map Navigation for Smartphones with Recursive View Segmentation,  
Robbins *et al.*, ACM Press (Jan. 2004) at 4.1.

30                    <sup>23</sup> *See* ZoneZoom: Map Navigation for Smartphones with Recursive View Segmentation,  
Robbins *et al.*, ACM Press (Jan. 2004) at 4.2. Samsung is seeking third party discovery on these  
31 products. Also relevant is "ZoneZoom: map navigation for smartphones with recursive view  
32 segmentation", Robbins et al., AVI '04 Proceedings of the working conference on advanced visual  
33 interfaces.

1 other references to render the claims of the '163 Patent obvious in the event Apple takes the  
2 position that certain claim limitations are missing from the references charted in Exhibits S and U.

3 **B. Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders**  
4 **Obvious the Asserted Claims**

5 Plaintiff asserts claims 2, 4-13, 17-18, 27-42, and 47-52 of the '163 Patent against  
6 Samsung in this lawsuit. All of those claims are invalid because the '163 Patent fails to meet one  
7 or more of the requirements for patentability. The individual bases for invalidity are provided  
8 below and in the claim charts attached as Exhibits S and U. Each of the foregoing listed prior art  
9 documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art  
10 under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

11 Although Samsung has identified at least one citation per limitation for each reference,  
12 each and every disclosure of the same limitation in the same reference is not necessarily identified.  
13 Rather, in an effort to focus the issues, Samsung has cited representative portions of identified  
14 references, even where a reference may contain additional support for a particular claim element.  
15 In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and  
16 in the context of other publications and literature. Thus, to understand and interpret any specific  
17 statement or disclosure within a prior art reference, such persons would rely on other information  
18 within the reference, along with other publications and their general scientific knowledge.  
19 Samsung may rely upon uncited portions of the prior art references and on other publications and  
20 expert testimony to provide context, and as aids to understanding and interpreting the portions that  
21 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed  
22 publications, and the testimony of experts to establish that a person of ordinary skill in the art  
23 would have been motivated to modify or combine certain of the cited references so as to render the  
24 claims obvious.

25 **4. Anticipation**

26 Some or all of the asserted claims of the '163 Patent are invalid as anticipated under 35  
27 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts  
28 included in Exhibit S, which identify specific examples of where each limitation of the asserted

1 claims is found in the prior art references. As explained above, the cited portions of prior art  
2 references identified in the attached claim charts are exemplary only and representative of the  
3 content and teaching of the prior art references, and should be understood in the context of the  
4 reference as a whole and as they would be understood by a person of ordinary skill in the art.

#### 5                   5.       **Obviousness**

6           To the extent any limitation is deemed not to be exactly met by an item of prior art listed  
7 above and in Exhibit S, then any purported differences are such that the claimed subject matter as  
8 a whole would have been obvious to one skilled in the art at the time of the alleged invention, in  
9 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,  
10 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

11           In addition, the references identified above render one or more asserted claims of the '163  
12 Patent obvious when the references are read in combination with each other, and/or when read in  
13 view of the state of the art and knowledge of those skilled in the art. Each and every reference  
14 identified is also relevant to the state of the art at the time of the alleged invention. Any of the  
15 references disclosed above may be combined to render obvious (and therefore invalid) each of  
16 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or  
17 all of the references identified above, including all references in Exhibits S, T, and U, for purposes  
18 of obviousness depending on the Court's claim construction, positions taken by Apple during this  
19 litigation, and further investigation and discovery.

20           Moreover, to the extent the foregoing references are found not to anticipate the asserted  
21 claims, the foregoing references render the asserted claims obvious either alone or in combination  
22 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained  
23 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art  
24 at the time of the alleged invention of the asserted claims of the '163 Patent to combine the various  
25 references cited herein so as to practice the asserted claims of the '163 Patent.

26           In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,  
27 alone or in combination with other references, are outlined below and included in Exhibits S and  
28

1 U, which includes exemplary claim charts for the asserted claims of the '163 Patent showing  
2 specifically where in each reference or combinations of references each asserted claim is found,  
3 and an explanation of why the prior art renders the asserted claim obvious.

4 In particular, Samsung contends that the asserted claims of the '163 patent would have  
5 been obvious in view of the prior art references identified above and in Exhibits S, T and U. For  
6 example, Exhibits S and U include exemplary claim charts that describe how the asserted claims  
7 of the '163 Patent would have been obvious in view of the following references alone or in  
8 combination:  
9

- 10 • All references identified above and in the claim charts in Exhibit S, if found not to  
11 anticipate the claims of the '163 Patent, render the claims of the '163 patent  
12 obvious alone;
- 13 • Any reference identified above and in the claim charts in Exhibit S, if found not to  
14 anticipate the claims of the '163 patent, can be combined with any other reference  
15 identified above and in the claim charts in Exhibit S to render the claims of the  
16 '163 patent obvious;
- 17 • To the extent any element is found to be missing from any reference charted in  
18 Exhibit S, that reference can be combined with any reference or combination of  
19 references disclosing the allegedly missing element and identified in Exhibit U to  
20 render the claims of the '163 patent obvious.
- 21 • Any reference identified in Exhibit U may be combined with any other reference or  
22 combination of references identified in Exhibit U to render the claims of the '163  
23 patent obvious.

24 In addition to these specific combinations of prior art and the specific combinations of  
25 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any  
26 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations  
27 disclosed within the prosecution history of the references cited herein. These obviousness  
28

1 combinations reflect Samsung’s present understanding of the potential scope of the claims that  
2 Plaintiff appears to be advocating and should not be seen as Samsung’s acquiescence to Plaintiff’s  
3 interpretation of the patent claims.

4 Samsung also reserves the right to amend or supplement these contentions regarding  
5 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,  
6 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has  
7 not identified what elements or combinations it alleges were not known to one of ordinary skill in  
8 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a  
9 particular prior art reference, Samsung reserves the right to assert that any such limitation is either  
10 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light  
11 of the same, or that the limitation is disclosed in another of the references disclosed above and in  
12 combination would have rendered the asserted claim obvious.

13 **C. Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**  
14 **Alleged item of Prior Art each Asserted Claim is Found**

15 Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged  
16 item of prior art each limitation of each asserted claim is found, including for each limitation that  
17 Apple contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or  
18 material(s) in each item of prior art that performs the claimed function is attached in Exhibits S  
19 and U.

20 **D. Local Patent Rule 3-3(d): Other Grounds for Invalidity**

21 Samsung identifies the following grounds for invalidity of the asserted claims of the ’163  
22 Patent based on 35 U.S.C. §§ 101 and/or 112. Samsung reserves the right to supplement these  
23 disclosures based on further investigation and discovery.

24 **1. Invalidity Based on 35 U.S.C. § 101**

25 The asserted claims of the ’163 patent are invalid under 35 U.S.C. § 101 because they only  
26 claim abstract ideas. For example, each asserted claim of the ’163 Patent contains the limitations  
27 “detecting a first gesture at a location on the displayed portion of the structured electronic  
28

1 document” and “determining a first box in the plurality of boxes at the location of the first  
2 gesture.” Furthermore, the claims merely contain abstract software instructions.

3                   2.       **Invalidity Based on Enablement or Written Description Under 35**  
4                               **U.S.C. § 112(1) and/or Indefiniteness Under 35 U.S.C. § 112(2)**

5                   Based on Samsung's present understanding of Plaintiff’s infringement contentions,  
6 Samsung asserts that claims 2, 4-13, 17-18, 27-42, & 47-52 of the ’163 Patent are invalid for  
7 reciting at least the following claim terms/phrases:

- 8                   • “at least a portion of a structured electronic document”
- 9                   • “boxes of content,” “first box,” and “second box”
- 10                  • “translating”
- 11                  • “substantially centered”
- 12                  • “enlarging and translating the structured electronic document so that the first box is  
13                       substantially centered on the touch screen display”
- 14                  • “while the first box is enlarged, detecting a second gesture on a second box other  
15                       than the first box; and translating the structured electronic document so that the  
                          second box is substantially centered on the touch screen display”
- 16                  • “the plurality of boxes are defined by a style sheet language”
- 17                  • “the width of the first box is substantially the same as the width of the touch screen  
18                       display”
- 19                  • “means for displaying at least a portion of a structured electronic document on the  
20                       touch screen display, wherein the structured electronic document comprises a  
                          plurality of boxes of content”
- 21                  • “means for detecting a first gesture at a location on the displayed portion of the  
22                       structured electronic document”
- 23                  • “means for determining a first box in the plurality of boxes at the location of the  
24                       first gesture”
- 25                  • “means for enlarging and translating the structured electronic document so that the  
                          first box is substantially centered on the touch screen display”
- 26                  • “means for, while the first box is enlarged, a second gesture is detected on a second  
27                       box other than the first box”

- “means for, in response to detecting the second gesture, the structured electronic document is translated so that the second box is substantially centered on the touch screen display”

These claim terms/phrases as apparently construed by Apple violate the written description, enablement, and/or definiteness requirements of 35 U.S.C. § 112.

Based on Samsung's present understanding of Plaintiff's infringement contentions, at least one or more of these claim terms/phrases are indefinite because they are inconsistent with and broader than the alleged invention disclosed in the specification and given Plaintiff's apparent constructions of the claims, any person of ordinary skill in the art at the time of the invention would not understand what is claimed, even when the claims are read in light of the specification. Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted claims in which these claim terms/phrases appear lack written description because the specification of the '163 Patent demonstrates that the patentee neither conceived of nor demonstrated possession of all that Apple now contends the claims cover. In addition, based on Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted claims in which these claim terms/phrases appear are invalid because the specification fails to provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains, or with which it is most nearly connected, to implement the invention without undue experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

## VIII. THE '129 PATENT

### A. Local Patent Rule 3-3(a): Identification of Prior Art

At this time, Samsung contends that at least the following prior art references anticipate or render obvious, either alone or in combination, the asserted claims of the '129 Patent:

#### 1. Patent References<sup>24</sup>

Chart No(s).	Country of Origin	Patent Number	Date of Issue	Priority Date
V-1	US	4,571,454	2/18/1986	11/11/1982
V-2	US	5,083,118	1/21/1992	4/16/1990
V-3	US	5,113,041	5/12/1992	12/28/1990

<sup>24</sup> Samsung incorporates by reference all prior art references cited in the patents listed herein and/or their file histories.

Chart No(s).	Country of Origin	Patent Number	Date of Issue	Priority Date
V-4	US	5,565,658	10/15/1996	7/13/1992
V-5	US	7,218,314	5/15/2007	6/7/2001
V-6	US	7,932,898	4/26/2001	9/20/2005
V-7	WO	2005/114369	12/1/2005	5/6/2004

## 2. Systems

All versions of the following prior art systems commercially sold, publicly known or used before the priority date of the '129 Patent, including documents and source code describing the same:

Chart No(s).	System	Date Offered	Offering Entity
V-8	Whirlpool Velos™ Touchscreen	At least as early as December 2005	Whirlpool

Additional prior art that has not been charted, but is still relevant to the invalidity of the '129 Patent is listed in Exhibit W. Samsung reserves the right to amend these invalidity contentions to assert these references depending on the claim construction and infringement positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these references in combination with other references to render the claims of the '129 Patent obvious in the event Apple takes the position that certain claim limitations are missing from the references charted in Exhibits V and X.

### B. Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders Obvious the Asserted Claims

Plaintiff asserts claims 1-3, 5, 7, 9-12, 14, 16-19, 21-22, 24-26, and 28 of the '129 Patent against Samsung in this lawsuit. All of those claims are invalid because the '129 Patent fails to meet one or more of the requirements for patentability. The individual bases for invalidity are provided below and in the claim charts attached as Exhibits V and X. Each of the foregoing listed prior art documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.



1           Although Samsung has identified at least one citation per limitation for each reference,  
2 each and every disclosure of the same limitation in the same reference is not necessarily identified.  
3 Rather, in an effort to focus the issues, Samsung has cited representative portions of identified  
4 references, even where a reference may contain additional support for a particular claim element.  
5 In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and  
6 in the context of other publications and literature. Thus, to understand and interpret any specific  
7 statement or disclosure within a prior art reference, such persons would rely on other information  
8 within the reference, along with other publications and their general scientific knowledge.  
9 Samsung may rely upon uncited portions of the prior art references and on other publications and  
10 expert testimony to provide context, and as aids to understanding and interpreting the portions that  
11 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed  
12 publications, and the testimony of experts to establish that a person of ordinary skill in the art  
13 would have been motivated to modify or combine certain of the cited references so as to render the  
14 claims obvious.

### 15                           3.       **Anticipation**

16           Some or all of the asserted claims of the '129 Patent are invalid as anticipated under 35  
17 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts  
18 included in Exhibit V, which identify specific examples of where each limitation of the asserted  
19 claims is found in the prior art references. As explained above, the cited portions of prior art  
20 references identified in the attached claim charts are exemplary only and representative of the  
21 content and teaching of the prior art references, and should be understood in the context of the  
22 reference as a whole and as they would be understood by a person of ordinary skill in the art.

### 23                           4.       **Obviousness**

24           To the extent any limitation is deemed not to be exactly met by an item of prior art listed  
25 above and in Exhibit V, then any purported differences are such that the claimed subject matter as  
26 a whole would have been obvious to one skilled in the art at the time of the alleged invention, in  
27 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,  
28 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

1 In addition, the references identified above render one or more asserted claims of the '129  
2 Patent obvious when the references are read in combination with each other, and/or when read in  
3 view of the state of the art and knowledge of those skilled in the art. Each and every reference  
4 identified is also relevant to the state of the art at the time of the alleged invention. Any of the  
5 references disclosed above may be combined to render obvious (and therefore invalid) each of  
6 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or  
7 all of the references identified above, including all references in Exhibits V, W, and X, for  
8 purposes of obviousness depending on the Court's claim construction, positions taken by Apple  
9 during this litigation, and further investigation and discovery.

10 Moreover, to the extent the foregoing references are found not to anticipate the asserted  
11 claims, the foregoing references render the asserted claims obvious either alone or in combination  
12 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained  
13 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art  
14 at the time of the alleged invention of the asserted claims of the '129 Patent to combine the various  
15 references cited herein so as to practice the asserted claims of the '129 Patent.

17 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,  
18 alone or in combination with other references, are outlined below and included in Exhibits V and  
19 X, which includes exemplary claim charts for the asserted claims of the '129 Patent showing  
20 specifically where in each reference or combinations of references each asserted claim is found,  
21 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the  
22 charts in Exhibit V and X include the motivation to combine references.

24 In particular, Samsung contends that the asserted claims of the '129 Patent would have  
25 been obvious in view of the prior art references identified above. For example, Exhibit X includes  
26 exemplary claim charts that describe how the asserted claims of the '129 Patent would have been  
27 obvious in view of the following references alone or in combination:  
28

- 1 • All references identified in Exhibit V, if found not to anticipate the claims of the  
2 '129 Patent, render the claims of the '129 Patent obvious alone;
- 3 • Exhibit X-1: Exhibit X-1: U.S Patent No. 7,372,455 to Perski (“Perski ’455”) and  
4 U.S. Patent No. 5,083,118 to Kazama (“Kazama ’118”)

5 In addition to the specific combinations of prior art and the specific combinations of  
6 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any  
7 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations  
8 disclosed within the prosecution history of the references cited herein. These obviousness  
9 combinations reflect Samsung’s present understanding of the potential scope of the claims that  
10 Plaintiff appears to be advocating and should not be seen as Samsung’s acquiescence to Plaintiff’s  
11 interpretation of the patent claims.

12 Samsung also reserves the right to amend or supplement these contentions regarding  
13 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,  
14 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has  
15 not identified what elements or combinations it alleges were not known to one of ordinary skill in  
16 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a  
17 particular prior art reference, Samsung reserves the right to assert that any such limitation is either  
18 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light  
19 of the same, or that the limitation is disclosed in another of the references disclosed above and in  
20 combination would have rendered the asserted claim obvious.

21 **C. Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**  
22 **Alleged item of Prior Art each Asserted Claim is Found**

23 Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged  
24 item of prior art each limitation of each asserted claim is found, including for each limitation that  
25 Apple contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or  
26 material(s) in each item of prior art that performs the claimed function is attached in Exhibits V  
27 and X.  
28

1           **D.      Local Patent Rule 3-3(d): Other Grounds for Invalidity**

2           Samsung identifies the following grounds for invalidity of the asserted claims of the '129  
3 Patent based on 35 U.S.C. §§ 101 and/or 112. Samsung reserves the right to supplement these  
4 disclosures based on further investigation and discovery. Invalidity Based on Enablement or  
5 Written Description Under 35 U.S.C. § 112(1) and/or Indefiniteness Under 35 U.S.C. § 112(2)

6           Based on Samsung's present understanding of Plaintiff's infringement contentions,  
7 Samsung asserts that claims 1-3, 5, 7, 9-12, 14, 16-19, 21-22, 24-26, and 28 of the '129 Patent are  
8 invalid for reciting at least the following claim terms/phrases:

- 9           • "one or more widths including a maximum width"
- 10          • "one or more widths including a minimum width"
- 11          • "the minimum width"
- 12          • "substantially greater"
- 13          • "substantially greater"
- 14          • "maximum width"
- 15          • "substantially electrically isolate"
- 16          • "substantially cover"
- 17          • "substantially constant width"

18           These claim terms/phrases as apparently construed by Apple violate the written description,  
19 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

20           Based on Samsung's present understanding of Plaintiff's infringement contentions, at least  
21 one or more of these claim terms/phrases are indefinite because they are inconsistent with and  
22 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent  
23 constructions of the claims, any person of ordinary skill in the art at the time of the invention  
24 would not understand what is claimed, even when the claims are read in light of the specification.  
25 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each  
26 of the asserted claims in which these claim terms/phrases appear lack written description because  
27 the specification of the '129 Patent demonstrates that the patentee neither conceived of nor  
28

1 demonstrated possession of all that Apple now contends the claims cover. In addition, based on  
2 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted  
3 claims in which these claim terms/phrases appear are invalid because the specification fails to  
4 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,  
5 or with which it is most nearly connected, to implement the invention without undue  
6 experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

7 **PATENT LOCAL RULE 3-4 DISCLOSURES**

8 Pursuant to Patent Rule 3-4(a), Defendants will produce, make available for inspection, or  
9 identify publicly available information sufficient to show the operation of any specifically  
10 identified aspects or elements of an Accused Instrumentality identified by Plaintiff in its Patent  
11 L.R. 3-1(c) chart to the extent such information is in Defendants' possession, custody or control.  
12 If such information comprises source code, Defendants will make such source code available for  
13 inspection pursuant to the entry of a suitable protective order in this action. Documents produced  
14 pursuant to Patent Local Rule 3-4(a) include the following: 43983-44537.

15 Pursuant to Patent Rule 3-4(b), Defendants are producing or making available for  
16 inspection copies of each item of prior art identified pursuant to Patent Rule 3-3(a) which does not  
17 appear in the file history of the Asserted Patent to the extent such prior art is in Samsung's  
18 possession, custody or control. Documents produced pursuant to Patent Local Rule 3-4(a) include  
19 the following: SAMNDCA00028457-36167; 36833-43982; and 44538-44674.

20 Defendants reserve the right to identify and produce additional documents pursuant to the  
21 Patent Rules and the orders of the Court.

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DATED: October 7, 2011

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1 **CERTIFICATE OF SERVICE**

2 I hereby certify that on October 7, 2011, I caused **SAMSUNG'S PATENT LOCAL**  
3 **RULE 3-3 AND 3-4 DISCLOSURES** to be electronically served on the following via email:

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24 I declare under penalty of perjury that the foregoing is true and correct. Executed in Redwood  
25 Shores, California on October 7, 2011.

26

/s/ Mark Tung

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