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

14 APPLE INC., a California corporation,
 15 Plaintiff,
 vs.

16 SAMSUNG ELECTRONICS CO., LTD., a
 Korean business entity, SAMSUNG
 17 ELECTRONICS AMERICA, INC., a New
 York corporation, and SAMSUNG
 18 TELECOMMUNICATIONS AMERICA,
 LLC, a Delaware limited liability company,

19 Defendants.

20
 21 SAMSUNG ELECTRONICS CO., LTD., a
 Korean business entity, SAMSUNG
 22 ELECTRONICS AMERICA, INC., a New
 York corporation, and SAMSUNG
 23 TELECOMMUNICATIONS AMERICA,
 LLC, a Delaware limited liability company,

24 Counterclaim-Plaintiffs,

25 v.

26 APPLE INC., a California corporation,

27 Counterclaim-Defendant.
 28

Case No. 11-CV-01846-LHK

**APPLE INC.'S REPLY BRIEF IN
 SUPPORT OF ITS MOTION FOR
 SUMMARY JUDGMENT OF NON-
 INFRINGEMENT OF U.S. PATENT
 NUMBER 7,362,867 AND INVALIDITY
 OF U.S. PATENT NUMBERS 7,456,893
 AND 7,577,460**

Date: June 21, 2012
 Time: 1:30 p.m.
 Place: Courtroom 4, 5th Floor
 Judge: Hon. Lucy H. Koh

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1 **I. INTRODUCTION**

2 Apple Inc. (“Apple”) respectfully submits this reply brief in support of its motion for
3 summary judgment of non-infringement of claims 25 and 26 of U.S. Patent No. 7,362,867 (“the
4 ’867 patent”) and for summary judgment of invalidity of claims 10 and 12 of U.S. Patent No.
5 7,456,893 (“the ’893 patent”) and claim 1 of U.S. Patent No. 7,577,460 (“the ’460 patent”).¹

6 **II. NON-INFRINGEMENT OF THE ’867 PATENT**

7 The parties did not ask the Court to interpret any limitations of the ’867 patent. However,
8 faced with the prospect of summary judgment, Samsung belatedly seeks a proposed construction
9 for “scrambling code” and offers both intrinsic and extrinsic evidence in an attempt to support its
10 new construction, including a further declaration from its expert (Dr. Wesel) – who now offers
11 almost 16 pages of analysis in support of Samsung’s proposed construction. Putting aside the
12 untimeliness of these arguments, the greater problem for Samsung is that its arguments ignore
13 the plain meaning of the asserted claims. In light of the plain meaning and the undisputed facts,
14 Apple is entitled to summary judgment of non-infringement of the ’867 patent.

15 Samsung’s newly proposed construction of “scrambling code” is not only inconsistent
16 with the plain meaning, but would in fact eviscerate the meaning of the claim term “scrambling.”
17 Samsung’s expert agrees that a code is not a “scrambling code” unless it can be used for
18 “spreading” – put simply, to be a “scrambling” code, the code must actually be used to scramble,
19 or spread, the data. (See 4/23/12 Wesel Dep. at 164:15-17 (Selwyn Decl., Ex. 5, Dkt. 925-10).)
20 However, if one replaces the “scrambling code” limitation of claim 25 with Samsung’s proposed
21 construction (“a code generated by adding a first m-sequence and a second m-sequence” (Opp. at
22 3)), this fundamental concept of a code used to “scramble” or “spread” data disappears entirely:
23
24
25

26 ¹ Plaintiff and Counterclaim Defendant Apple Inc.’s Notice of Motion and Motion for
27 Summary Judgment of Non-Infringement of U.S. Patent Number 7,362,867 and Invalidity of U.S.
28 Patent Numbers 7,456,893 and 7,577,460, Dkt. 925-4 will be hereinafter referred to as “Mot.”
Samsung’s Opposition to Apple’s Motion for Summary Judgment, Dkt. 1005, will be hereinafter
referred to as “Opp.”

<p>1 '867 Patent, Claim 25 (“Scrambling Code” Limitation)</p>	<p>“Scrambling code” limitation replaced with Samsung’s proposed construction</p>
<p>2 3 at least one adder for generating a ... Gold code as a ... primary scrambling code by adding a ... shifted first m-sequence and the second m-sequence</p>	<p>4 at least one adder for generating a ... Gold code as a ... primary <u>[code generated by adding a first m-sequence and a second m-sequence]</u> by adding a ... shifted first m-sequence and the second m-sequence</p>

7 As a matter of law, because Samsung’s proposed construction would therefore eliminate the
8 “scrambling” limitation of claim 25, it cannot be correct. *See, e.g., Cat Tech LLC v. TubeMaster, Inc.*, 528 F.3d 871, 885 (Fed. Cir. 2008) (refusing to adopt a claim construction which would
9 render a claim limitation meaningless).

11 Claim 25 of the '867 patent requires “generating a ... Gold code as a ... primary
12 scrambling code.” That portion of the claim imposes two separate requirements: (1) a Gold
13 code must be generated and (2) the primary scrambling code must *be* a Gold code. Samsung’s
14 attempt to conflate these two separate requirements of claim 25 is improper. A product cannot
15 infringe simply by generating a Gold code. Similarly, a product cannot infringe simply by
16 generating a scrambling code. The plain language of claim 25 requires generating a Gold code
17 that *is* a scrambling code.

18 Samsung’s opposition fails to make this showing. Samsung’s infringement argument
19 hinges on the contention that [REDACTED] but
20 that is insufficient under the plain meaning of claim 25. Samsung can go no further because the
21 undisputed facts demonstrate that [REDACTED]

22 [REDACTED]
23 [REDACTED]

24 (*See id* at 5.) As detailed in Apple’s opening brief, under the standard, “scrambling codes” and
25 “Gold codes” are distinct entities, [REDACTED]

26 [REDACTED] (*See Mot.*

1 at 5-7.²) [REDACTED]

2 [REDACTED]
3 [REDACTED]³

4 Samsung's opposition also misapprehends Apple's view of the "plain meaning" of claim
5 25. It is not Apple's position that a "scrambling code" must be a complex code sequence or
6 cannot be a sum of two m-sequences. (See Opp. at 3.) Rather, a code is not a "scrambling code"
7 within the meaning of claim 25 unless the code is used for scrambling (or spreading) the data.
8 (See Mot. at 6.) As explained in Apple's opening brief, [REDACTED]

9 [REDACTED]
10 [REDACTED]
11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 Finally, there is no merit to Samsung's claim that Apple "essentially admitted
15 infringement" of the '867 patent (Opp. at 7) by arguing in its earlier motion for partial summary
16 judgment that it is licensed to practice the patent under FRAND terms. The suggestion that
17 Apple somehow "admitted that this patent is essential to the 3GPP standards" (*id.*) ignores the
18 express language of Apple's partial summary judgment motion – which Samsung omits from its
19 Opposition to the present motion. As is evident on its face, Apple's partial summary judgment
20 motion was based upon Samsung's FRAND declarations and Samsung's own assertions that its

21 _____
22 ² As set forth in Apple's opening brief, Samsung's expert admitted at his deposition that
23 [REDACTED] (See Mot. at 6
24 (quoting Dr. Wesel's deposition testimony).) Notably, while Dr. Wesel submitted a 45-page
25 declaration in opposition to Apple's motion for summary judgment on the '867 patent, Dkt. 1003,
there is nothing in that new declaration that addresses this key admission.

26 ³ Samsung asserts only literal infringement of claim 25 of the '867 patent. As noted in
27 Apple's opening brief (Mot. at 11-12), Samsung's Infringement Contentions did not articulate a
28 theory of infringement under the doctrine of equivalents, and Samsung's expert offered no
opinion in his opening report under the doctrine of equivalents. Samsung's opposition is
similarly devoid of any argument for infringement under the doctrine of equivalents.

1 patents are standards-essential, which Apple assumed to be true “solely for purposes of [its]
2 motion.” (Apple’s Motion for Partial Summary Judgment at 3, 20-24 (Dkt. 660-3).) However,
3 that motion also included an express statement that “Apple disputes that any of the declared-
4 essential patents that Samsung has asserted against Apple is actually essential to the UMTS
5 standard and actually embodied in the [] chipsets incorporated into Apple products.” (*Id.* at 3.)
6 Plainly, there was no admission of infringement or that the ’867 patent is *in fact* essential to the
7 standard.

8 **III. INVALIDITY OF THE ’893 PATENT**

9 Samsung’s opposition fails to address or even mention the issue central to Apple’s
10 motion: Apple’s and Samsung’s experts agree that claim 10 of the ’893 patent requires user
11 action. (*See* Mot. at 15.) [REDACTED]

12 [REDACTED]
13 [REDACTED]; *see also* *IPXL*
14 *Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005); *In re Katz*
15 *Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1318 (Fed. Cir. 2011) (“Katz’s claims .
16 . . . create confusion as to when direct infringement occurs because they are directed both to
17 systems and to actions performed by ‘individual callers.’”). On the point, Apple’s expert, Dr.
18 Dourish opined that

19 the language [of claim 10] indicates that user action is required by the claim. Thus
20 it is unclear to me whether the language of claim 10 is met when one creates an
21 apparatus that allows the user to switch from the stored-image display mode to the
22 photographing mode and back to the stored image display mode, or when the user
23 actually switches from the stored-image display mode to the photographing mode
24 and back to the stored-image display mode.

(Dourish ’893 Invalidation Report ¶ 204 (Selwyn Decl., Ex. 10, Dkt. 925-15); Mot. at 15.)

25 Similarly, Samsung’s expert, Dr. Yang, testified:

26 [REDACTED]
27 [REDACTED]
28 [REDACTED]

1 [REDACTED]
2 [REDACTED]
3 [REDACTED]
4 [REDACTED]
5 (5/9/12 Yang Rough Dep. at 80:25-81:12 (Selwyn Decl., Ex. 12, Dkt. 925-17); Mot. at 15.) The
6 parties' experts therefore agree that user action is required to practice claim 10.⁴

7 While Samsung cited a litany of cases in support of its Opposition, those cases are readily
8 distinguishable, as in none of those cases did the parties' experts agree (as they do here) that user
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17 ⁴ Although Dr. Yang testified under oath as quoted above, Samsung submitted a further
18 declaration from Dr. Yang with its Opposition, in which he seemingly recants or contradicts his
19 sworn testimony. (Yang Decl. at 3-6 (Dkt. 1001).) Apparently realizing that it would be
20 improper (or at least unconvincing) to rely on a declaration that contradicts sworn testimony, in
21 its Opposition, with respect to the '893 patent, Samsung *only* cites the Yang Declaration for a
22 description of the '893 patent. (Opp. at 7.) However, to the extent Samsung seeks to rely on the
23 Yang Declaration more broadly, Apple respectfully requests that ¶¶ 20-23 of the Yang
24 Declaration be struck or otherwise disregarded by the Court. Paragraphs 20 and 23 contain new
25 opinion that could have been and should have been stated in Dr. Yang's rebuttal report, but were
26 not. (*Compare* Yang Decl., Dkt. 1001, ¶¶ 20-23 *with* Yang Validity Report, Declaration of Peter
27 Kolovos in Support of Apple's Motion for Summary Judgment ("Kolovos Decl.") Ex. 1, at ¶
28 142.) Further, paragraphs 20-22 of Dr. Yang's new declaration contradict his prior deposition
testimony and are therefore improper. *See Cleveland v. Policy Mgmt. Sys. Corp.*, 526 U.S. 795,
806-07 (1999) (requiring an explanation when affidavits submitted with summary judgment
oppositions contradict earlier sworn deposition testimony); *Davis v. Brouse McDowell, L.P.A.*,
596 F.3d 1355, 1362 (Fed. Cir. 2010) cert. denied, 131 S. Ct. 118, 178 (2010) ("In view of
[plaintiff's expert's] inconsistent deposition testimony and his failure to include the patentability
opinion of paragraph 5 in his expert report, the court did not abuse its discretion in striking
paragraph 5.").

1 action was required to practice the claim.⁵ Moreover, unlike the cases on which Samsung relies,
2 claim 10 of the '893 patent clearly implicates user action.⁶ Therefore, on this record, granting
3 summary judgment of indefiniteness in favor of Apple would not disturb precedent that the
4 holding of *IPXL* is limited and narrow.

5 Samsung's attempt to distinguish *In re Katz*, 639 F.3d at 1318, is similarly unavailing, as
6 a side-by-side comparison of the claim at issue in that case and claim 10 of the '893 patent
7 demonstrates:

8
9
10 ⁵ See *Vistan Corp. v. Fadei USA, Inc.*, No. C 10-4862 JCS, 2012 U.S. Dist. LEXIS 59348,
11 at *25 (N.D. Cal. Apr. 27, 2012) (no agreement between experts that claim required user action
12 to be practiced); *Yodlee, Inc. v. Cashedge, Inc.*, No. C 05-01550 SI, 2006 U.S. Dist. LEXIS
13 86699, at *6-19 (N.D. Cal. Nov. 29, 2006) (same); *Collaboration Props. v. Tandberg ASA*, No.
14 C 05-01940 MHP, 2006 U.S. Dist. LEXIS 42465, at *19-20 (N.D. Cal. June 22, 2006) (same);
15 *Collegenet, Inc. v. Xap Corp.*, 442 F. Supp. 2d 1036, 1062 (D. Or. 2006) (same); *Toshiba Corp. v.*
16 *Juniper Networks, Inc.*, C.A. No. 03-1035-SLR, 2006 U.S. Dist. LEXIS 44348, at *13-14 (D.
17 Del. June 28, 2006) (same); *SynQor, Inc. v. Artesyn Techs., Inc.*, C.A. NO. 2:07-CV-497-TJW-
18 CE, 2010 U.S. Dist. LEXIS 74808, at *96 (E.D. Tex. July 26, 2010) (same); *CSB-Sys. Int'l, Inc.*
19 *v. SAP Am., Inc.*, C.A. No. 10-2156, 2012 U.S. Dist. LEXIS 45847, at *40 (E.D. Pa. Mar. 30,
20 2012) (same); *Wago Verwaltungsgesellschaft Mbh v. Rockwell Automation*, 2012 U.S. Dist.
21 LEXIS 30703, at *19 (N.D. Ohio Mar. 7, 2012) (same); *Leader Techs., Inc. v. Facebook, Inc.*,
22 770 F. Supp. 2d 686, 710 (D. Del. 2011) (same); *Freedom Wireless, Inc. v. Alltel Corp.*, No.
23 2:06cv504 (TJW-CE), 2008 U.S. Dist. LEXIS 82785, at *40-41 (E.D. Tex. Oct. 17, 2008) (same);
24 *Ricoh Co. v. Katun Corp.*, 486 F. Supp. 2d 395, 403 (D.N.J. 2007) (same); *Sienna, LLC v. CVS*
25 *Corp.*, No. 06 Civ. 3364 (DLC), 2007 U.S. Dist. LEXIS 2, at *22 (S.D.N.Y. Jan. 3, 2007) (same).

19 ⁶ Compare the language in claim 10 of the '893 patent requiring extensive user
20 involvement ("A digital image processing apparatus comprising: ... wherein upon a **user**
21 **performing** a mode-switching operation defined **by switching from** the stored-image display
22 mode **to** the photographing mode **and back to** the stored image display mode...") with the claims
23 at issue in cases cited by Samsung where summary judgment has been denied. See, e.g.,
24 *Collaboration Properties*, 2006 U.S. Dist LEXIS 42465 at *1 ("A teleconferencing system for
25 conducting a teleconference among a plurality of participants, comprising: ... wherein, the
26 system is **configured** to reproduce images, based on data signals shared along the data path...")
27 (emphasis added); *Toshiba*, 2006 U.S. Dist. LEXIS 44348 at *11 n.1 ("A network
28 interconnection **apparatus** for transferring packets at a boundary of a plurality of networks, the
apparatus comprising: a control message processing **unit configured to communicate with** a
previous hop node...") (emphasis in original); *Wago Verwaltungsgesellschaft*, 2012 U.S. Dist.
LEXIS 30703 at *2, *15-16 ("An input/output **device** for a data bus, said device being located on
a support rail and being adapted to be positioned adjacent other such devices, said device
comprising: ... **configuring** the device with other such devices as series terminals ...) (emphasis
added).

<u>In re Katz Interactive Call Processing Claim</u>	<u>'893 Patent, Claim 10</u>
<p>1 1. An interface control system for use with, 2 (1) a communication facility including remote 3 terminals for individual callers to make calls, 4 wherein said remote terminals comprise a 5 telephone capability including voice 6 communication means and some of said 7 remote terminals comprise digital input means 8 for providing data, (2) a multiple port, multiple 9 format processor for concurrently processing 10 data from a substantial number of callers in 11 anyone of a plurality of formats, said 12 communication facility automatically 13 providing call data signals, as to indicate called 14 data (DNIS), to select a specific format from 15 said plurality of formats, and (3) a plurality of 16 live operator attended terminals, for a plurality 17 of formats, said interface control system 18 comprising: 19 ... 20 interface means for providing automated 21 voice messages relating to said specific format 22 to certain of said individual callers, <i>wherein</i> 23 <i>said certain of said individual callers digitally</i> 24 <i>enter data, including at least caller</i> 25 <i>information data, through said digital input</i> 26 <i>means;</i> 27 ...</p>	<p>10. A digital image processing apparatus comprising: an optical system for receiving a light reflected from a subject; ... <i>wherein upon a user performing a mode-</i> <i>switching operation defined by switching</i> <i>from the stored-image display mode to the</i> <i>photographing mode and back to the stored</i> <i>image display mode</i> the controller causes the display screen to first display a single image file that was most recently displayed before the mode-switching operation, the single image file being different from a most recently stored image file, and the single image file being first displayed irrespective of a duration that the camera was used in the photographing mode during the mode switching operation.</p>
<p>(Kolovos Decl. Ex. 2, U.S. Patent No. 5,917,893, claim 1, cited in <i>In re Katz</i>, 639 F.3d at 1308, 1318.⁷)</p>	<p>(Samsung's '893 Patent (Selwyn Decl., Ex. 2, 925-7).)</p>

19 The Federal Circuit found that the claims in *Katz* fell under the rationale of *IPXL* because “*Katz's*
20 *claims ... create confusion as to when direct infringement occurs because they are directed both*
21 *to systems and to actions performed by ‘individual callers.’” In re Katz*, 639 F.3d at 1318. In
22 both the claim at issue in *Katz* and the asserted Samsung claim, the user is the subject performing
23 the action. (Compare the *In re Katz* claim language “wherein said certain of said *individual*
24 *callers ... enter data...*” to Samsung’s ’893 Patent’s requirement of a “user performing a mode-
25 switching operation defined by switching from the stored-image display mode to the

26 _____
27 ⁷ Coincidentally and confusingly, the patent in issue in *In re Katz* and Samsung’s patent
28 both end in “’893.”

1 photographing mode and back to the stored image display mode”). Both claims require the user
2 to perform an action. For the reasons stated herein and in Apple’s opening brief, Dkt. 925-4 at
3 12-16, independent claim 10 and dependent claim 12 are invalid under 35 U.S.C. § 112, ¶ 2,
4 because the claims do not apprise a person of ordinary skill in the art of their scope.

5 **IV. INVALIDITY OF THE ’460 PATENT**

6 **A. Samsung Does Not Dispute that the Plain Language of the Claim Is Ambiguous**

7 Samsung does not dispute that the plain language of claim 1 of the ’460 patent has no
8 clear meaning. Unlike the *S3* case cited by Samsung – where the court found that the
9 specification and figures “explain[] and illustrate[]” the contested interaction between claim
10 terms (*see S3 Inc. v. NVIDIA Corp.*, 259 F.3d 1364, 1368–369 (Fed. Cir. 2001)) – here Samsung
11 attempts to manufacture “support” in the specification and file history for its current
12 interpretation of claim 1 where none exists. Rather, as described below, the specification and file
13 history provide no support for Samsung’s (or any other) interpretation of claim 1. Because claim
14 1 is insolubly ambiguous to a person of ordinary skill in the art, the Court should find it invalid
15 as indefinite.

16 **B. None of the Three Possible Interpretations of Claim 1 Finds Support in the Specification**

17 Even when read in light of the specification, claim 1 does not reasonably apprise those
18 skilled in the art of the scope of the invention. Contrary to Samsung’s assertions, the first
19 interpretation of claim 1 identified by Apple and adopted by Samsung as its interpretation
20 (sending two separate email messages from two separate email transmission sub-modes) finds no
21 support in the specification or file history.⁸

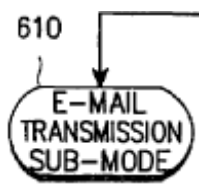
22 As set forth in Apple’s opening brief, the specification only describes *one* “E-mail
23 transmission sub-mode.” (Mot. at 16-17.) Apparently acknowledging this, Samsung does not
24 even assert that the ’460 patent discloses two [REDACTED]

25
26 _____
27 ⁸ [REDACTED]
28 [REDACTED]

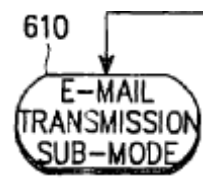
1 [REDACTED]

2 [REDACTED]

3 [REDACTED] Samsung also attempts to concoct “support” for the first interpretation
4 through its submission of the Yang Declaration. (See Yang Decl. ¶¶ 27–28 (Dkt. 1001).⁹)
5 However, the new arguments raised in the Yang Declaration ignore the fact that the specification
6 only ever refers to a single E-mail transmission sub-mode, denoted consistently by the single
7 reference number 610 in Figs. 6, 8, and 9 (and throughout the specification) of the patent.



11 FIG. 6 (excerpt)



12 FIG. 8 (excerpt)



13 FIG. 9 (excerpt)

14 In paragraph 27 of his Declaration, Dkt. 1001, Dr. Yang unsuccessfully attempts to find
15 support for Samsung’s interpretation in FIG. 9 and the related detailed description, i.e., “[u]pon
16 selection of *the* E-mail transmission sub-mode, the portable phone controller 32 controls the
17 OSD 40 to display a message requesting entry of the address of the other party on the color LCD
18 48 in step 900 of FIG. 9.” (’460 patent at 12:4–7 (Selwyn Decl. Ex. 3, Dkt. 925-8) (emphasis
19 added); Srivastava Invalidity Report ¶ 338 (Selwyn Decl. Ex. 22, Dkt. 925-27).) Tellingly, Dr.
20 Yang chooses to omit the entirety of FIG. 9 in his declaration, deleting the depiction of “E-mail
21 transmission sub-mode 610,” the single and only E-mail transmission sub-mode disclosed in the
specification, at the top of FIG. 9.

22 Put simply, there is no support in the specification for a “first” and a “second” E-mail
23 transmission sub-mode, let alone for how to practice the claimed method.

24
25 ⁹ Apple objects to Paragraphs 27-34 of the Yang Declaration as untimely expert opinions
26 under Fed. R. Civ. P. 26(a)(2). These paragraphs contain new opinions that could have been and
27 should have been stated in Dr. Yang’s rebuttal report, but were not. (Compare Yang Decl. ¶¶
28 27–34, Dkt. 1001, with Yang Validity Report, Declaration of Peter Kolovos in Support of
Apple’s Motion for Summary Judgment (“Kolovos Decl.”) Ex. 1, at ¶¶ 103–111.) See also
supra n.4.

1 Samsung also incorrectly asserts that because Apple’s expert argued that certain prior art
2 references anticipate claim 1, the claim cannot be indefinite. This argument is contrary to
3 common sense, legal precedent, and the Federal Rules of Civil Procedure, which expressly allow
4 parties to argue in the alternative. F.R.C.P. 8(d)(2)-(3). *See also Amgen, Inc. v. Chugai Pharm.*
5 *Co.*, 927 F.2d 1200, 1204 (Fed. Cir. 1991) (affirming finding of indefiniteness where defendant
6 argued non-infringement in the alternative). Indeed, Samsung ignores Dr. Srivastava’s explicit
7 statement in his expert report that his primary opinion is that claim 1 is indefinite. (Srivastava
8 Invalidity Report ¶ 61 (Stake Decl., Ex. 3, Dkt. 1002-3) (“Likewise, it is my opinion that the
9 claims of the ’460 patent are indefinite, for the reasons articulated below. Nothing stated here or
10 in the attached claims charts should be construed as an admission or suggestion that I believe the
11 claims of the ’460 patent are not indefinite. I offer these opinions as alternative grounds for
12 invalidating the ’460 patent, if the fact finder were to disagree with my opinion that the claims
13 are indefinite.”).) The deposition testimony of Dr. Srivastava cited by Samsung underscores this
14 point:

15 Q: Can we agree that at the very least this claim requires the three core functions that
16 Dr. Yang opined on? . . .

17 A: ***I do find the claim overall confusing as to what method it is citing. Whether***
18 ***there are two E-mail sub-modes or not, the claim language does use the first E-***
19 ***mail and the second E-mail sub-mode. As I alluded to in my report, the***
20 ***specification is at variance with that.*** But in terms of does [claim 1] talk about
sending an E-mail text alone, an E-mail with text and image and sequentially
scrolling through the images, yes, the claim does talk about these three things.

21 (Srivastava Dep. at 76:4-24 (Stake Decl. Ex. 2, Dkt. 1002-2) (emphasis added).¹⁰)

22 Finally, Samsung asserts – in another newly offered argument by Dr. Yang – that the
23 second and third possible interpretations identified by Apple (resulting in sending a single E-mail
24 message) do not require performance of all claimed functions. (Yang Decl. ¶ 34 (Dkt. 1001).)
25 This is a red herring. Samsung seems to be arguing that because the first interpretation is correct

26 ¹⁰ Further, whether or not claim 1 refers to certain “core functions” does not clarify what
27 those functions mean, how those functions must be performed, and even whether all of them
28 must be performed in order to infringe claim 1.

1 (which it is not), the second and third interpretations are necessarily incorrect because they do
2 not require all the functions required by the first interpretation. In addition, although a person of
3 ordinary skill in the art would not be able to determine whether claim 1 requires sending one or
4 two E-mail messages, each of the three possible interpretations identified by Apple includes the
5 recited “first” and “second” E-mail transmission sub-mode and sequentially displaying “other”
6 images through the use of scroll keys. Claim 1’s insoluble ambiguity lies in *how* the “first” and
7 “second” E-mail transmission sub-modes are used to carry out the claimed data transmission
8 method. For example, even accepting for the sake of argument that claim 1 recites Samsung’s
9 three “core functions,” it is impossible to determine whether the claimed method requires that
10 emailing text, and emailing text and an image, are performed together, separately, or as
11 alternatives, and whether the result is one or two E-mail messages. The specification simply
12 provides no description that helps to clarify this insoluble ambiguity.

13 **C. The Prosecution History also Fails to Clarify the Meaning of Claim 1**

14 Samsung places undue weight on the prosecution history. Contrary to Samsung’s
15 assertions, the Examiner’s mere repetition of the claim limitations in rejecting the claims
16 provides no information about whether the Patent Office “readily understood” or “readily
17 recognized” any aspect of claim 1. (Opp. at 17; Yang Decl. ¶ 30 (Dkt. 1001).) The prosecution
18 history similarly does not provide any guidance as to which of the three possible interpretations
19 should be attributed to the claimed method as a whole. The Examiner’s identification of certain
20 individual claim limitations in the prior art does not favor any one of the three interpretations or
21 shed light on how to practice the claim.

22 Apple does not dispute that the prior art teaches a “first” and “second” E-mail
23 transmission sub-mode. However, the prosecution history (like the specification) is silent on
24 *how* the first and second E-mail transmission sub-modes are related to one another and/or to the
25 claimed sequential display of “other” images, and on what exactly is required to practice the
26 claimed method. As set forth in Apple’s opening brief, a person of ordinary skill in the art would
27 not understand whether claim 1 is infringed by: (1) transmission of an E-mail message from the
28

1 first E-mail transmission sub-mode *and* transmission of another E-mail from the second E-mail
2 transmission sub-mode; (2) transmission of a text E-mail from the first E-mail transmission sub-
3 mode *or* transmission of an E-mail with an image from the second E-mail transmission sub-
4 mode; or (3) transmission of information from the first E-mail transmission sub-mode to the
5 second E-mail transmission sub-mode, followed by transmission of an E-mail with an image
6 from the second E-mail transmission sub-mode. Therefore, claim 1 is invalid as indefinite.

7 **D. Samsung Does Not Dispute the Inventors' Inability to Understand Claim 1**

8 Despite downplaying the importance of inventor testimony, Samsung attempts to use it to
9 salvage claim 1. (*See* Opp. at 18.) According to Samsung, the inventor testimony [REDACTED]

10 [REDACTED] As an initial matter, whether or not claim 1
11 discloses three functions is irrelevant to whether a person of ordinary skill in the art would
12 understand whether and how the claim requires performance of all or some subset of those
13 functions. Further, Mr. Oh's testimony, [REDACTED]

14 [REDACTED]
15 [REDACTED] *see* Oh Dep. 35:9-36:16 (Stake Decl., Ex. 10, Dkt. 1002-10), [REDACTED]
16 [REDACTED] (See Mot. at
17 19.)

18 Moreover, as Samsung recognizes, inventor testimony can support an indefiniteness
19 finding when the specification and prosecution history shed no light on the claim language. *See,*
20 *e.g., Amgen v. Chugai Pharm. Co.*, 927 F.2d 1200, 1218 (Fed. Cir. 1991).¹² As discussed above

21 _____
22 ¹¹ Incredibly, [REDACTED]
23 [REDACTED]
24 [REDACTED] (Oh Dep. at 47:7-13 (Stake Decl., Ex. 10, Dkt. 1002-10).)
25 This testimony sheds no light on the proper interpretation of claim 1.

26 ¹² Samsung's reliance on *Solomon v. Kimberly-Clark Corp.* is inapposite. In *Solomon*, the
27 inventor testified about her subjective understanding of her invention which defendants
28 interpreted to be different from what was claimed. 216 F.3d 1372, 1376 (Fed. Cir. 2000). In
contrast, the inventors here cannot even understand what was claimed.

1 and in Apple’s opening brief, that is the case here. With one exception, Samsung does not
2 dispute that its inventors could not explain or define what claim 1 means, including whether
3 claim 1 requires sending two E-mail messages. (Mot. at 18-19.) [REDACTED]

4 [REDACTED]
5 [REDACTED] This testimony speaks for itself, despite Samsung’s attempts to
6 devalue it by denigrating the question. At bottom, the inventors’ inability to understand their
7 own patent claim underscores the insoluble ambiguity of claim 1 to those skilled in the art.

8 **E. Samsung and Its Experts Cannot Agree on the Interpretation of Claim 1**

9 Samsung does not dispute that its infringement contentions describe performing the
10 claimed steps in order by first opening the Mail application, returning to the Home screen to
11 open the Photos application, navigating between image files, opening the Mail application again,
12 and opening the Photos application again. (Mot. at 19-20.) [REDACTED]

13 [REDACTED]
14 Neither of these two interpretations bears any relation to Samsung counsel’s description to Dr.
15 Sukumar of the patented feature as the transmission of a *single* email message with an image in
16 the body and not as an attachment. Samsung suggests that Dr. Sukumar had focused on only the
17 final limitation of claim 1 because that was the “inventive aspect[] of the ’460 patent.” (Opp. at
18 20.) But as Samsung itself has admitted, the final limitation already existed in the prior art, and
19 it was not until the applicants added two *other* limitations during prosecution that claim 1 was
20 allowed. (Opp. at 16-18.) Curiously, Dr. Sukumar does not even address those limitations in his
21 expert report. Ultimately, Samsung and its experts have advanced interpretations of claim 1 that
22 are inconsistent with one another, let alone with any “clear meaning” of the claim, which only
23 further underscores the indefiniteness of claim 1. (Mot. at 19-21.)

24
25
26 _____
27 ¹³ Apple has moved to strike the new infringement theory, among others, from Dr. Yang’s
28 expert report as untimely disclosed pursuant to Patent Local Rule 3-1. (See Apple’s Motion to
Strike Portions of Samsung’s Expert Reports (Dkt. 939-1).)

1 **V. CONCLUSION**

2 For the foregoing reasons, as well as the reasons stated in its Opening Brief, Dkt. 925-4,
3 Apple respectfully requests that the Court grant its motion for summary judgment of non-
4 infringement of the '867 patent, and for summary judgment of invalidity of claims 10 and 12 of
5 the '893 patent and claim 1 of the '460 patent.

6
7 Dated: June 7, 2012

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1 **CERTIFICATE OF SERVICE**

2 The undersigned hereby certifies that a true and correct copy of the above and foregoing
3 document has been served on June 7, 2012, to all counsel of record who are deemed to have
4 consented to electronic service via the Court's CM/ECF system per Civil Local Rule 5.4. Any
5 other counsel of record will be served by electronic mail, facsimile and/or overnight delivery.
6

7 /s/ Mark D. Selwyn
8 Mark D. Selwyn
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