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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

APPLE INC.,	
	Plaintiff,
v.	
SAMSUNG ELECTRONICS CO., LTD., a Korean business entity; SAMSUNG ELECTRONICS AMERICA, INC., a New York corporation; SAMSUNG TELECOMMUNICATIONS AMERICA, LLC, a Delaware limited liability company,	
	Defendants.

Case No. 11-cv-01846 LHK (PSG)

**JOINT PRETRIAL STATEMENT
AND PROPOSED ORDER**

Date: July 24, 2012
Time: 1:30 p.m.
Place: Courtroom 4, 5th Floor
Judge: Hon. Lucy H. Koh

1 Pursuant to the Guidelines for Final Pretrial Conference in Jury Trials, the parties submit
2 the following Joint Proposed Pretrial Statement and Order.

3 **I. SUBSTANCE OF THE ACTION**

4 The parties to this action are Apple Inc., a California corporation having its principal place
5 of business in Cupertino, California, Samsung Electronics Co., Ltd., a Korean corporation having
6 its principal place of business in Suwon-City, Korea, Samsung Telecommunications America,
7 LLC, a Delaware corporation having its corporate headquarters in Richardson, Texas, and
8 Samsung Electronics America, Inc., a New York corporation having its principal place of
9 business in Ridgefield Park, New Jersey.

10 Apple asserts claims against Samsung for trade dress infringement and dilution, and
11 design and utility patent infringement relating to Samsung's smartphone and tablet products.
12 Samsung seeks declaratory judgment as to Apple's claims and asserts counterclaims of patent
13 infringement relating to Apple's iPhone and iPad products. Apple seeks declaratory judgment as
14 to Samsung's counterclaims and asserts counterclaims of monopolization under the Sherman Act,
15 violation of the California Unfair Competition Law, and breach of contract associated with
16 Samsung's assertion of patents that Samsung has declared to be essential to the UMTS wireless
17 telecommunication standard. In addition, Apple seeks a declaration that it is entitled to a fair,
18 reasonable and non-discriminatory ("FRAND") license to those declared essential patents, and
19 which sets forth the FRAND terms and conditions of that license.

20 The operative pleadings are Apple's Amended Complaint (Dkt. No. 75), Samsung's
21 Answer to Amended Complaint and Counterclaims (Dkt. No. 80), Apple's Amended Answer to
22 Counterclaims and Counterclaims in Reply (Dkt. No. 381), and Samsung's Answer to Apple's
23 Amended Counterclaims in Reply (Dkt. No. 983).

24 At the Court's direction, the parties have reduced the claims they will assert at trial. (Dkt.
25 Nos. 902, 907 and 1178.) Apple's design and utility patent and trade dress claims remaining for
26 trial, are:

27 1. Claims for infringement of the following patents:

- 28 a. U.S. Patent No. 7,469,381 (claim 19)

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- b. U.S. Patent No. 7,844,915 (claim 8)
- c. U.S. Patent No. 7,864,163 (claim 50)
- d. U.S. Patent No. D618,677
- e. U.S. Patent No. D593,087
- f. U.S. Patent No. D604,305
- g. U.S. Patent No. D504,889

2. In particular, Apple’s position is that it has accused the following products of infringing the following design and utility patents:

- a. Acclaim: ’163, ’915
- b. Intercept: ’381, ’163, ’915
- c. Vibrant: ’381, ’163, ’915, D’087, D’677, and D’305
- d. Captivate: ’381, ’163, ’915, D’305
- e. Epic 4G: ’381, ’163, ’915
- f. Fascinate: ’381, ’163, ’915, D’677, and D’305
- g. Galaxy Ace: ’381, ’163, ’915, and D’677
- h. Galaxy S (i9000): ’381, ’163, ’915, D’087, D’677, and D’305
- i. Galaxy S II (AT&T) ’381, ’163, ’915, D’087, and D’677
- j. Galaxy S II (i9100) ’381, ’163, ’915, D’087, and D’677
- k. Galaxy S II (T-Mobile) ’163, ’915, and D’677
- l. Galaxy S II (Epic 4G Touch) ’381, ’163, ’915, D’087, and D’677
- m. Galaxy S II (Skyrocket) ’163, ’915, D’087, and D’677
- n. Transform: ’163, ’915
- o. Mesmerize: ’381, ’163, ’915, D’677, and D’305
- p. Continuum: ’381, ’163, ’915, D’305
- q. Galaxy Tab: ’381, ’163, ’915
- r. Galaxy S Showcase (i500): ’381, ’163, ’915, D’677, and D’305
- s. Nexus S: ’381, ’163, ’915
- t. Galaxy S 4G: ’381, ’163, ’915, D’087, D’677, and D’305

- 1 u. Gem: '381, '163, '915, D'305
- 2 v. Sidekick: '381, '163, '915
- 3 w. Galaxy Prevail: '381, '163, '915
- 4 x. Nexus S 4G: '381, '163, '915
- 5 y. Replenish: '381, '163, '915
- 6 z. Droid Charge: '381, '163, '915, D'305
- 7 aa. Infuse 4G: '381, '163, '915, D'087, D'677, and D'305
- 8 bb. Indulge: '381, '163, '915, D'305
- 9 cc. Galaxy Tab 10.1 (WiFi and 4G LTE): '381, '163, '915, D'889
- 10 dd. Exhibit 4G: '381, '163, '915, D'305
- 11 ee. Gravity: '381, '163, '915

12 Samsung disputes that the Gem (with respect to the '381 patent), and the Galaxy S II
13 (AT&T), Galaxy S II (i9100), Galaxy S II (T-Mobile), Galaxy S II (Epic 4G Touch), and Galaxy
14 S II (Skyrocket) are at issue, as discussed in Samsung's MIL #3. Samsung also disputes that the
15 Galaxy Ace and Galaxy S (i9000) are at issue, as described in the Disputed Evidentiary Issues
16 section below.

- 17 3. Claims for dilution of iPhone trade dress, based on Registration No. 3,470,983, the
18 unregistered combination iPhone trade dress and the unregistered iPhone 3G trade
19 dress.
- 20 4. Claims for infringement and dilution of iPad trade dress based on unregistered
21 iPad/iPad 2 trade dress against Galaxy Tab 10.1 (WiFi) and Tab 10.1 (4G LTE).
- 22 5. Apple also intends to offer proof of Samsung's anticompetitive course of conduct
23 at 3GPP in connection with setting the UMTS standard – failure to make timely
24 disclosure of its claimed IPR during the standard-setting process and false FRAND
25 commitments with respect to seven patents that Samsung selected from its
26 portfolio of declared essential SEPs to assert against Apple. This anticompetitive
27 course of conduct continued when Samsung wrongfully failed to offer FRAND
28 licensing terms to Apple for the patents Samsung claimed were essential to the

1 UMTS standard and Samsung's wrongful efforts to obtain injunctive relief for
2 claims of infringement with respected to these patents.

3 Samsung objects to Apple's purported counterclaims for antitrust and unfair competition
4 as to the four patents that are no longer in the case. Samsung alleges that these claims are now
5 moot in view of Samsung's dismissal without prejudice of the three of these patents and the
6 court's summary judgment ruling as to the fourth.

7 Samsung's utility patent claims remaining for trial are claims for infringement of the
8 following patents ("Samsung's Asserted Patents"):

- 9 1. U.S. Patent No. 7,675,941 (Claims 10 and 15)
- 10 2. U.S. Patent No. 6,928,604 (Claims 17 and 18)
- 11 3. U.S. Patent No. 7,447,516 (Claims 15 and 16)
- 12 4. U.S. Patent No. 7,698,711 (Claim 9)
- 13 5. U.S. Patent No. 7,577,460 (Claim 1)
- 14 6. U.S. Patent No. 7,546,893 (Claim 10)

15 II. RELIEF SOUGHT

16 Both parties seek damages, enhanced damages, declaratory and injunctive relief. Apple
17 also seeks preliminary injunctive relief.

18 Apple seeks the following specific relief:

- 19 1. A judgment that Samsung has infringed each of Apple's asserted patents;
- 20 2. An order and judgment enjoining Samsung and its officers, directors, agents,
21 servants, employees, affiliates, attorneys, and all others acting in privity or in
22 concert with them, and their parents, subsidiaries, divisions, successors and assigns
23 from further acts of infringement of Apple's asserted patents;
- 24 3. A judgment awarding Apple all damages adequate to compensate for Samsung's
25 infringement of Apple's asserted patents, and in no event less than a reasonable
26 royalty for Samsung's acts of infringement, including all pre-judgment and post-
27 judgment interest at the maximum rate permitted by law;
- 28 4. A judgment awarding Apple all damages, including treble damages, based on any

1 infringement found to be willful, pursuant to 35 U.S.C. § 284, together with
2 prejudgment interest;

3 5. A judgment awarding Apple all of Samsung's profits pursuant to 35 U.S.C. § 289,
4 together with prejudgment interest;

5 6. An order enjoining Samsung and its officers, directors, agents, servants,
6 employees, affiliates, attorneys, and all others acting in privity or in concert with
7 them, and their parents, subsidiaries, divisions, successors and assigns, from
8 directly or indirectly diluting the Apple iPhone Trade Dress (based on the trade
9 dress Registration No. 3,470,983, the unregistered combination iPhone trade dress,
10 and the unregistered Apple iPhone 3G Trade Dress, or the Apple iPad Trade Dress
11 (based on unregistered iPad/iPad 2 trade dress) or using any other product or
12 design or designations similar to or likely to dilute the Apple iPhone Trade Dress
13 (based on the trade dress Registration No. 3,470,983, the unregistered combination
14 iPhone trade dress, and the unregistered Apple iPhone 3G Trade Dress, or the
15 Apple iPad Trade Dress (based on unregistered iPad/iPad 2 trade dress); from
16 infringing the iPad Trade Dress (based on unregistered iPad/iPad 2 trade dress), or
17 using any other product or design or designations similar to or likely to cause
18 confusion the Apple iPad Trade Dress (based on unregistered iPad/iPad 2 trade
19 dress); from passing off Samsung's products as being associated with and or
20 sponsored or affiliated with Apple; from committing any other unfair business
21 practices directed toward obtaining for themselves the business and customers of
22 Apple; and from committing any other unfair business practices directed toward
23 devaluing or diminishing the brand or business of Apple;

24 7. Actual damages suffered by Apple as a result of Samsung's unlawful conduct, in
25 an amount to be proven at trial, as well as prejudgment interest as authorized by
26 law;

27 8. An accounting of Samsung's profits pursuant to 15 U.S.C. § 1117;

28 9. A judgment trebling any damages award pursuant to 15 U.S.C. § 1117;

- 1 10. Punitive damages pursuant to California Civil Code § 3294;
- 2 11. Restitutionary relief against Samsung and in favor of Apple, including
- 3 disgorgement of wrongfully obtained profits and any other appropriate relief;
- 4 12. An adjudication and decree that Samsung is liable for breach of contract, violation
- 5 of Section 2 of the Sherman Act, 15 U.S.C. § 2, and/or violation of Cal. Bus. &
- 6 Prof. Code § 17200;
- 7 13. A judgment declaring that Samsung's purported essential patents, including the
- 8 Declared-Essential Patents, are unenforceable by virtue of standards-related
- 9 misconduct including (i) Samsung's breach of its FRAND commitments and/or (ii)
- 10 Samsung's breach of its disclosure obligations at ETSI;
- 11 14. Pursuant to Section 4 of the Clayton Act, 15 U.S.C. § 15, a judgment against
- 12 Samsung for treble the amount of Apple's damages and enjoining Samsung from
- 13 demanding from Apple non-FRAND terms for Samsung's purportedly essential
- 14 patents and an award of attorneys' fees and costs;
- 15 15. A judgment that Samsung has violated the California Unfair Competition Law and
- 16 enjoining Samsung from further violations of that Law;
- 17 16. A judgment declaring that, to the extent any of the alleged inventions described in
- 18 and allegedly covered by the Declared-Essential Patents are used, manufactured,
- 19 or sold by or for Apple, its suppliers, and/or its customers, Apple has the
- 20 irrevocable right to be licensed on FRAND terms under those patents, and which
- 21 sets forth the FRAND terms and conditions of that license;
- 22 17. A judgment declaring that Samsung is not entitled under any circumstances to seek
- 23 injunctive relief preventing Apple from practicing the UMTS standard, and that
- 24 Samsung is not otherwise entitled to use its purported essential patents to pursue
- 25 injunctive relief;
- 26 18. A judgment declaring that Samsung's purported essential patents, including the
- 27 Declared-Essential Patents, are unenforceable by virtue of Samsung's waiver of its
- 28 right to enforce its purported essential patents, including the Declared-Essential

1 Patents;

2 19. A declaration that Apple has not infringed, and is not infringing, each of the
3 Samsung asserted patents;

4 20. A declaration that one or more of the claims of each of the Samsung asserted
5 patents are invalid, void and/or unenforceable against Apple;

6 21. Costs of suit and reasonable attorneys' fees; and

7 22. Any other remedy to which Apple may be entitled, including all remedies provided
8 for in 15 U.S.C. §§ 1116, 1117, 35 U.S.C. §§ 284, 285, and 289, and Cal. Bus. &
9 Prof. Code § 17200, et seq., and under any other law.

10 Samsung seeks the following specific relief:

11 1. A judgment declaring that Apple has infringed, induced others to infringe and/or
12 committed acts of contributory infringement with respect to the claims of
13 Samsung's Asserted Patents;

14 2. A judgment that Apple and its officers, agents, servants, employees, and all those
15 persons acting or attempting to act in active concert or in participation with them
16 or acting on their behalf be immediately, preliminarily and permanently enjoined
17 from further infringement of Samsung's Asserted Patents;

18 3. A judgment that Apple be ordered to account for and pay to Samsung all damages
19 caused to them by reason of Apple's infringement of Samsung's Asserted Patents
20 pursuant to 35 U.S.C. § 284;

21 4. A judgment that Apple be ordered to pay treble damages for willful infringement
22 of each of Samsung's Asserted Patents pursuant to 35 U.S.C. § 284;

23 5. A judgment declaring this case "exceptional" under 35 U.S.C. § 285 and that
24 Samsung be awarded its attorneys' fees, expenses, and costs incurred in this
25 action;

26 6. A judgment granting Samsung pre-judgment and post-judgment interest on the
27 damages caused to it by reason of Apple's infringement of Samsung's Asserted
28 Patents;

- 1 7. A judgment dismissing with prejudice any and all claims of Apple's Complaint
2 and order that Apple take nothing as a result of the Complaint and that all of
3 Apple's prayers for relief are denied;
- 4 8. An order finding and declaring, and entering judgment, in favor of Samsung and
5 against Apple that Samsung has not infringed any of the Apple Asserted Patents;
- 6 9. An order finding and declaring, and entering judgment, in favor of Samsung and
7 against Apple that each of the Apple Asserted Patents is invalid;
- 8 10. An order finding and declaring, and entering judgment, in favor of Samsung and
9 against Apple that Samsung has not engaged in any federal false designation of
10 origin or unfair competition under 15 U.S.C. § 1125(a);
- 11 11. An order finding and declaring, and entering judgment, in favor of Samsung and
12 against Apple that Samsung has not infringed the iPhone Trade Dress or the iPad
13 Trade Dress;
- 14 12. An order finding and declaring, and entering judgment, in favor of Samsung and
15 against Apple that Samsung has not violated the trade dress dilution provisions of
16 the Lanham Act with respect to Apple's iPhone and iPad products;
- 17 13. An order finding and declaring, and cancelling in its entirety, the '983 Registration
18 and certifying such cancellation to the Director of the USPTO, for appropriate
19 entry upon the records of the USPTO;
- 20 14. An order finding and declaring, and entering judgment, in favor of Samsung and
21 against Apple that Samsung has not violated California Business and Professions
22 Code §17200, *et seq.*;
- 23 15. An order finding and declaring, and entering judgment, in favor of Samsung and
24 against Apple that Samsung Defendants/Samsung Counterclaimants has not been
25 unjustly enriched;
- 26 16. A judgment awarding Samsung attorney's fees and costs of suit under the Lanham
27 Act as an exceptional case;
- 28 17. A judgment that Apple be ordered to pay all costs associated with this action;

1 18. A judgment granting to Samsung such other and further relief as may be deemed
2 just and appropriate;

3 19. A judgment dismissing with prejudice any and all claims of Apple's Counterclaims
4 in Reply (Dkt. No. 381) and order that Apple take nothing as a result of the
5 Counterclaims in Reply and that all of Apple's prayers for relief are denied.

6 Apple's Further Separate Statement Regarding Relief Requested

7 Apple's itemization of witnesses, documents, or other evidentiary material to be
8 presented concerning the amount of damages is attached as Exhibit 1.

9 Samsung's Further Separate Statement Regarding Relief Requested

10 Samsung's itemization of witnesses, documents, or other evidentiary material to be
11 presented concerning the amount of damages is attached as Exhibit 2.

12 **III. UNDISPUTED FACTS**

- 13 1. Apple is a corporation organized under the laws of the State of California, and its
14 principal place of business is in Cupertino, California.
- 15 2. Samsung Electronics Co., Ltd. (referred to individually herein as "SEC") is a
16 corporation organized and existing under the laws of the country of Korea having
17 its principal place of business at 416 Maetan-3dong, Yeongtong-gu, Suwon-City,
18 Gyeonggi-do, Korea 443-742.
- 19 3. Samsung Telecommunications America, LLC (referred to individually herein as
20 "STA") is a corporation organized and existing under the laws of the state of
21 Delaware having its principal place of business at 1301 East Lookout Drive,
22 Richardson, Texas 75082.
- 23 4. Samsung Electronics America, Inc. (referred to individually herein as "SEA") is a
24 New York corporation with its principal place of business at 105 Challenger Road,
25 Ridgefield Park, New Jersey 07660.
- 26 5. Venue is proper in this District.
- 27 6. The Court has personal jurisdiction over each of the parties, and each of them
28 transacts business within this District.

- 1 7. Apple owns all rights, title, and interest in United States patent numbers
2 7,469,381, 7,844,915, 7,864,163, D604,305, D593,087, D618,677, and D504,889,
3 and U.S. Registration No. 3,470,983.
- 4 8. SEC owns all rights, title, and interest in United States patent numbers 7,675,941,
5 6,928,604, 7,447,516, 7,362,867, 7,698,711, 7,577,460, and 7,456,893.
- 6 9. U.S. Patent No. 7,469,381 was filed on 12/14/2007, issued on 12/23/2008.
- 7 10. U.S. Patent No. 7,844,915 was filed on 1/7/2007, issued on 11/30/2010.
- 8 11. U.S. Patent No. 7,864,163 was filed on 9/4/2007, issued on 1/4/2011.
- 9 12. U.S. Patent No. D604,305 was filed on 6/23/2007, issued on 11/17/2009.
- 10 13. U.S. Patent No. D593,087 was filed on 7/30/2007, issued on 5/26/2009.
- 11 14. U.S. Patent No. D618,677 was filed on 11/18/2008, issued on 6/29/2010.
- 12 15. U.S. Patent No. D504,889 was filed on 3/17/2004, issued on 5/10/2005 and
13 expires on 5/10/2019.
- 14 16. U.S. Registration No. 3,470,983 was filed on 10/12/2007, was registered on
15 7/22/2008, and expires 7/22/2018, subject to renewal.
- 16 17. U.S. Patent No. 7,675,941 claims priority to a foreign application filed 5/4/2005,
17 was filed in the U.S. on 5/4/2006, issued on 3/9/2010.
- 18 18. U.S. Patent No. 6,928,604 claims priority to a foreign application filed 3/31/1998,
19 was filed in the U.S. on 3/21/2003, issued on 8/9/2005.
- 20 19. U.S. Patent No. 7,447,516 claims priority to a foreign application filed 6/9/2004,
21 was filed in the U.S. on 6/9/2005, issued on 11/4/2008.
- 22 20. U.S. Patent No. 7,362,867 claims priority to a foreign application filed 7/7/1999,
23 was filed in the U.S. on 7/7/2000, issued on 4/22/2008.
- 24 21. U.S. Patent No. 7,698,711 claims priority to a foreign application filed 8/30/2005,
25 was filed in the U.S. on 7/16/2007, issued on 4/13/2010.
- 26 22. U.S. Patent No. 7,577,460 claims priority to a foreign application filed 3/31/1999,
27 was filed in the U.S. on 7/26/2006, issued on 8/18/2009.
- 28 23. U.S. Patent No. 7,456,893 claims priority to a foreign application filed 3/15/2005,

1 was filed in the U.S. on 6/27/2005, issued on 11/25/2008.

2 24. One or more of SEC, STA or SEA first sold the following products in the United
3 States on the following dates:¹

4	Acclaim	7/9/2010
5	Intercept	7/11/2010
6	Galaxy S Vibrant	7/15/2010
7	Galaxy S Captivate	7/18/2010
8	Galaxy S Epic 4G	8/31/2010
9	Galaxy S Fascinate	9/8/2010
10	Transform	10/10/2010
11	Galaxy S Mesmerize	10/27/2010
12	Galaxy S Continuum	11/11/2010
13	Galaxy Tab	11/10/2010
14	Galaxy S Showcase i500	11/15/2010
15	Nexus S	12/16/2010
16	Galaxy S 4G	2/23/2011
17	Gem	4/1/2011
18	Sidekick 4G	4/20/2011
19	Galaxy Prevail	4/29/2011
20	Nexus S 4G	5/8/2011
21	Replenish	5/8/2011
22	Droid Charge	5/14/2011
23	Infuse 4G	5/15/2011
24	Indulge	6/7/2011
25	Galaxy Tab 10.1	6/8/2011

26 ¹ Some of the products above are the subject of a motion *in limine* and the dates provided
27 here are not intended as an admission that evidence relating to these products is admissible in this
28 case.

1	Exhibit 4G	6/22/2011
2	Gravity Smart	6/22/2011
3	Galaxy S 2	10/2/2011

4 25. Apple first sold the following products in the United States no later than the
5 following dates:

6	iPhone	6/29/2007
7	iPhone 3G	7/11/2008
8	iPhone 3GS	6/24/2009
9	iPhone 4	6/24/2010
10	iPad	4/3/2010
11	iPad 2	3/11/2011

12 26. US patent application number 11/417,219 issued as US Patent No. 7,675,941

13 27. US patent application number 11/148,181 issued as US Patent No. 7,447,516.

14 **IV. DISPUTED FACTUAL ISSUES**

15 Joint Statement

16 The following disputed factual issues remain to be resolved:

17 **Apple's Claims Against Samsung**

18 1. Whether Samsung, through selling certain accused instrumentalities, infringes:

19 Claim 19 of U.S. Patent No. 7,469,381;

20 Claim 8 of U.S. Patent No. 7,844,915;

21 Claim 50 of U.S. Patent No. 7,864,163;

22 U.S. Patent No. D618,677;

23 U.S. Patent No. D593,087;

24 U.S. Patent No. D604,305; or

25 U.S. Patent No. D504,889.

26 2. Whether Apple's asserted patent claims are valid;

27 3. Whether, if Samsung has infringed Apple's asserted patents, such infringement is
28 willful;

- 1 4. Whether Samsung, through selling certain accused instrumentalities, has diluted
2 the iPhone trade dress (based on the trade dress Registration No. 3,470,983,
3 unregistered combination iPhone trade dress, or unregistered iPhone 3G trade
4 dress);
- 5 5. Whether Samsung, through selling certain accused instrumentalities, has diluted or
6 infringed the iPad trade dress (based on the unregistered iPad/iPad 2 trade dress);
7 and
- 8 6. Whether Apple is entitled to a license to patents Samsung has declared essential to
9 industry standards, and the terms and conditions of such license;
- 10 7. Whether Intel's sales of the baseband chips incorporated in the accused Apple
11 products exhaust Samsung's rights in the Declared-Essential patents;
- 12 8. Whether Samsung has breached contracts or violated antitrust or unfair
13 competition law in connection with its standards-related conduct or its assertion of
14 patents that it has declared essential to industry standards;
- 15 9. Whether the asserted patents that Samsung has declared essential to industry
16 standards are rendered unenforceable by virtue of Samsung's standards-related
17 conduct or by virtue of a waiver of the right to enforce those patents;
- 18 10. The remedies to which Apple is entitled, if any, as a result.
- 19 11. Whether any of Apple's claims are barred.

20 **Samsung's Claims Against Apple**

- 21 1. Whether Apple, through selling certain accused instrumentalities, infringes:
22 Claims 10 and 15 of U.S. Patent No. 7,675,941;
23 Claims 17 and 18 of U.S. Patent No. 6,928,604;
24 Claims 15 and 16 of U.S. Patent No. 7,447,516
25 Claim 9 of U.S. Patent No. 7,698,711;
26 Claim 1 of U.S. Patent No. 7,577,460; or
27 Claim 10 of U.S. Patent No. 7,456,893.
- 28 2. Whether Samsung's asserted patent claims are valid;

3. Whether, if Apple has infringed Samsung's asserted patents, such infringement is willful;
4. The remedies to which Samsung is entitled, if any, as a result; and
5. Whether any of Samsung's claims are barred.

V. AGREED STATEMENT

The parties concur that no part of the action may be presented upon an agreed statement of facts.

VI. STIPULATIONS

The parties have tentatively agreed to a stipulation concerning the authenticity of certain documents and expect to file the stipulation soon.

VII. WITNESSES TO BE CALLED.

Apple's and Samsung's witness lists are attached as Exhibits 3 and 4, respectively.

VIII. EXHIBITS, SCHEDULES, SUMMARIES

Apple's and Samsung's exhibit lists are attached as Exhibits 5 and 6, respectively. The parties agree that each may identify a certain number of additional exhibits from which each may select substitute exhibits in the event exhibits are removed from that party's exhibit list by action of the Court. The parties will meet and confer to determine the number each may include in its substitute list to determine when such lists would be exchanged.

Apple's Separate Statement

The parties disagree about the number and categories of evidence that can be included on the joint exhibit list authorized by the Court during proceedings held on June 29. Apple understands the joint list is to include both parties' products at issue, the patents-in-suit, the prosecution histories of the patents-in-suit, and, if requested, priority applications to the patents in suit. A reasonable number of *physical* prior art exhibits may also be included. Transcript of Proceedings June 29, 2012 at pages 73-76. Apple has prepared a list in accordance with the Court's guidance which is attached as Exhibit 7. Apple objects to Samsung's proposed joint list because it 1. does not include all accused products, 2. includes many items which are subject to striking orders, 3. includes non-physical alleged art in contravention of Samsung's representations

1 to the Court during the hearing, and 4. includes items to which Apple objects as inadmissible.

2 The parties have a dispute regarding timing of exchange of demonstratives and other
3 documents to be used in witness examinations. To allow any evidentiary disputes regarding
4 exhibits or demonstratives to be resolved outside the presence of the jury, Apple proposes the
5 following schedule for exchange:

6 1. Demonstratives: The deadline to exchange demonstrative exhibits not to be
7 entered into evidence shall be 7:00 pm PT two days before their use in court.
8 Excerpts, call-outs, blow-ups, or highlighting of exhibits, without more, are
9 exempt from exchange.

10 2. Witnesses and Exhibits:

- 11 a. Each party shall identify each witness that it intends to call no later than
12 7:00 pm PT two days before the witness is expected to testify.
13 b. At the same time, the party shall identify all exhibits to be used with the
14 witness and produce a marked copy of any exhibit not previously marked.
15 c. The opposing party shall identify any exhibits to be used on cross-
16 examination no later than 2:00 pm PT the next day.

17 Samsung's Separate Statement

18 Samsung proposes the "joint" exhibit list attached as Exhibit 8, which consists of the
19 patents and registered trade dress asserted in this suit and the corresponding file histories.

20 Samsung opposes Apple's competing proposal for a "joint" exhibit list, as it only contains
21 exhibits Apple seeks to introduce and thus violates the Court's order limiting the parties to 125
22 individual exhibits and is contrary to the Court's clear intent for the joint exhibit list to benefit
23 both parties equally. Specifically, it includes seven Apple products and 32 accused Samsung
24 products while not including a single one of Samsung's 23 requested prior art references. Unlike
25 Samsung's proposed list, there is nothing "joint" about Apple's proposed list, and it should be
26 rejected.

27 Samsung proposes the following procedure for identification of witnesses and exhibits.

28 1. Direct Exam: by 7 pm the night before a witness is to be called, the parties will

1 identify the witness and provide an exhibit and demonstrative list for that witness'
2 direct examination.

- 3 2. Cross Exam: all exhibits to be used on cross examination, except for demonstrative
4 exhibits, will be provided at the beginning of the cross exam.

5 **IX. DISPUTED LEGAL ISSUES**

6 Apple's Separate Statement Regarding Disputed Legal Issues

7 Apple identifies the following legal issues that, based on the parties' prior submissions,
8 appear to be disputed.

- 9 1. What is the correct claim construction of "electronic document" in the '381
10 patent?
- 11 2. What is the correct claim construction of "structured electronic document" in the
12 '163 patent?
- 13 3. Whether proof that the accused product appears substantially the same as the
14 claimed design to an ordinary observer familiar with the prior art is sufficient to
15 show infringement, regardless of whether an ordinary observer would be deceived
16 into purchasing a Samsung product thinking it as an Apple product. 35 U.S.C. §
17 289; *Gorham Co. v. White*, 81 U.S. 511, 526-29 (1872); *L.A. Gear, Inc. v. Thom*
18 *McAn Shoe Co.*, 988 F.2d 1117, 1126, 1128, 1134 (Fed. Cir. 1993); *Braun, Inc. v.*
19 *Dynamics Corp.*, 975 F.2d 815, 821 (Fed. Cir. 1992).
- 20 4. Whether patents that are not prior art to the asserted design patents are irrelevant to
21 the analysis of design patent infringement. *See* 6/30/2012 Order, Dkt. No. 1157, at
22 5; *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 676 (Fed. Cir. 2008); *Tone*
23 *Bros., Inc. v. Sysco Corp.*, No. 90-cv-60011, 1992 WL 200128, at *5 (S.D. Iowa
24 Mar. 17, 1992), *vacated on other grounds*, 28 F.3d 1192 (Fed. Cir. 1994); *see also*
25 *Gorham Co. v. White*, 81 U.S. 511, 528-31 (1872); *Leatherman Tool Group v.*
26 *Cooper Indus.*, 131 F.3d 1011, 1015 (Fed. Cir. 1997).
- 27 5. Whether the Court should instruct the jury on any purely functional elements only
28 after all evidence has been presented at trial. *Richardson v. Stanley Works, Inc.*,

1 597 F.3d 1288, 1294 (Fed. Cir. 2010); *Dexas Int'l, Ltd. v. Tung Yung Int'l, Inc.*,
2 No. 6:07-cv-334, 2008 U.S. Dist. LEXIS 48324, at *35-36 (E.D. Tex. June 24,
3 2008); *Sofpool, LLC v. Intex Rec. Corp.*, No. 2:07-cv-097, 2007 U.S. Dist. LEXIS
4 93057, at *5 (E.D. Tex. Dec. 19, 2007).

- 5 6. Whether the asserted claims of the Apple utility and design patents are invalid as
6 obvious under 35 U.S.C. § 103.
- 7 7. Whether Apple should be awarded treble damages and attorneys' fees in view of
8 the willful nature of Samsung's patent infringement and the exceptional nature of
9 this case.
- 10 8. Whether Apple should be awarded enhanced damages and attorneys' fees in view
11 of the willful nature of Samsung's dilution and infringement of Apple's trade dress
12 rights and the exceptional nature of this case.
- 13 9. Whether the asserted claims of the Samsung patents are invalid as obvious under
14 35 U.S.C. § 103.
- 15 14. Whether any argument for infringement of the '711 patent claim term "applet"
16 under the doctrine of equivalents is prohibited by prosecution history estoppel.
- 17 15. Whether the asserted claim of the '460 patent is invalid as indefinite and insolubly
18 ambiguous under 35 U.S.C. § 112, ¶ 2 and as described in the Federal Circuit's
19 decisions in, *e.g.*, *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1249
20 (Fed. Cir. 2008) and *Honeywell Int'l, Inc. v. Int'l Trade Comm'n*, 341 F.3d 1332,
21 1340 (Fed. Cir. 2003).
- 22 16. Whether any argument for infringement of the '460 patent claim limitation
23 "sequentially displaying other images stored in a memory through the use of scroll
24 keys" under the doctrine of equivalents is prohibited by prosecution history
25 estoppel.
- 26 17. Whether the asserted claims of the '893 patent are invalid as indefinite under 35
27 U.S.C. § 112, ¶ 2 and as described in the Federal Circuit's decisions in, *e.g.*, *IPXL*
28 *Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1383-84 (Fed. Cir. 1996) and

1 *In re Katz Interactive Call Processing Patent Litig.*, 639 F.2d 1303, 1318 (Fed.
2 Cir. 2011).

3 18. Whether any argument for infringement of the '893 patent claim term "irrespective
4 of a duration" under the doctrine of equivalents is prohibited by prosecution
5 history estoppel.

6 19. If Apple is found to infringe, whether Samsung is entitled to injunctive relief. *See*
7 *eBay Inc. v. MercExchange, LLC*, 547 US 388, 391 (2006).

8 20. Whether Samsung breached enforceable contractual commitments under the ETSI
9 IPR Policy by failing timely to disclose one or more of the Asserted Declared
10 SEPs under that Policy.

11 21. The terms and conditions under which Apple would be entitled to license the
12 Samsung Declared Essential UMTS Patents.

13 22. If Apple infringes, the terms and conditions under which Apple would be entitled
14 to license the Asserted Declared SEPs in Suit individually.

15 Apple believes that due to the substantial overlap of evidence between its equitable and
16 other claims and defenses, the jury should render an advisory verdict on at least its equitable
17 defenses of waiver and estoppel.

18 Apple also identifies the following legal issues which were disputed, but which Apple
19 believes have been resolved in previous court orders:

20 1. The term "invoke" as used in the '915 patent is construed to mean "causes" or
21 "causes a procedure to be carried out," rather than being narrowly construed to
22 require calling the function itself. This issue was resolved in Dkt. No. 1158 (order
23 on motion for summary judgment) at 18-20.

24 2. If Samsung is found to infringe Apple's design patents, Apple is entitled to recover
25 all of Samsung's profits relating to the accused products without apportionment.
26 This issue was resolved in Dkt. No. 1157 (Daubert order) at 9, which excluded
27 Samsung's expert testimony as "contrary to law."

28 3. It is sufficient under the first prong of *Panduit* for Apple to show demand for the

1 patented product to obtain lost profits. A showing of demand for specific patented
2 features is not required. This issue was resolved in Dkt. No. 1157 at 11, which
3 excluded Samsung expert testimony to the contrary.

4 4. Whether the test for design patent obviousness (1) requires Samsung to identify a
5 primary prior art reference that creates basically the same visual impression as the
6 claimed design; and (2) allows Samsung to use a secondary reference to modify
7 the primary reference only if it is so related to the primary reference that the
8 appearance of certain ornamental features in one would suggest the application of
9 those features in the other. This issue was resolved in the Federal Circuit's recent
10 decision and this Court's recent order denying Samsung's Motion to Stay. *Apple,*
11 *Inc. v. Samsung Electronics Co., Ltd.*, 2012 U.S. App. LEXIS 9720, *32-*36 (Fed.
12 Cir. May 14, 2012); 7/2/2012 Order Denying Samsung's Motion to Stay, Dkt. No.
13 1170, at 7-8.

14 5. Whether invalidating the asserted Apple design patents as "functional" requires
15 Samsung to prove that the claimed design as a whole is "dictated by" function,
16 rather than that aspects of the design have a function on an element-by-element
17 basis. The Court resolved this issue in its December 2, 2011 Preliminary
18 Injunction Order (Dkt. No. 452 at 12-13), but Samsung and its experts seem to be
19 attempting to change the standard, so it may lead to disputes at trial.

20 Samsung's Separate Statement Regarding Disputed Legal Issues

21 1. Whether design patent infringement requires that the accused product be so similar
22 to the patented design that it would deceive an ordinary observer, inducing him to
23 purchase the accused product believing it to be the patented design. *Gorham Co.*
24 *v. White*, 81 U.S. 511, 528 (1872); *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d
25 665, 681 (Fed. Cir. 2008); *Crocs v. ITC*, 598 F.3d 1294, 1303 (Fed Cir. 2010);
26 *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010); *Amini*
27 *Innovation Corp. v. Anthony California, Inc.*, 439 F.3d 1365, 1371 (Fed. Cir.
28 2006); *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1313 (Fed. Cir.

1 2001); *Arminak & Assocs. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1321
2 (Fed. Cir. 2007).

- 3 2. Whether an element of a design patent is functional, and therefore unprotectable,
4 where the element "is essential to the use or purpose of [the] design or if it affects
5 the cost or quality of the article." *Amini Innovation Corp. v. Anthony California,*
6 *Inc.*, 439 F.3d 1365, 1371 (Fed. Cir. 2006).
- 7 3. Whether an element of a trade dress is functional, and therefore unprotectable,
8 where the element "is essential to the use or purpose of the device or when it
9 affects the cost & quality of the device." *TrafFix Devices, Inc. v. Marketing*
10 *Displays, Inc.*, 532 U.S. 23, 29 (2001); *Au-Tomotive Gold, Inc. v. Volkswagen of*
11 *America, Inc.*, 457 F.3d 1062, 1072 (9th Cir. 2006).
- 12 4. Whether a patentee must show that any alleged alternative designs to a patented
13 design would not "adversely affect the utility of the specified article." *PHG*
14 *Technologies v. St. John Companies, Inc.*, 469 F.3d 1361, 1367-69 (Fed. Cir.
15 2006); *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1456 (Fed.
16 Cir. 1997).
- 17 5. Whether evidence of sales success is probative of fame/distinctiveness in a product
18 configuration case. *Continental Laboratory Products, Inc. v. Medax Intern., Inc.*,
19 114 F.Supp.2d 992, 1002-03 (S.D.Cal. 2000); *Duraco Prods., Inc. v. Joy Plastic*
20 *Enters., Ltd.*, 40 F.3d 1431, 1452-53(3d Cir. 1994); 4 MCCARTHY ON
21 TRADEMARK § 15:47 at 15-67 (2012 ed.).
- 22 6. Whether advertising that does not depict the as-claimed trade dress and/or does not
23 identify or feature it is probative of fame. *First Brands Corp. v. Fred Meyer, Inc.*,
24 809 F.2d 1378, 1383 (9th Cir. 1987); *Autodesk, Inc., v. Dassault Systems*
25 *Solidworks Corp.*, 685 F. Supp. 2d 1001, 1014 (N.D. Cal. 2009).
- 26 7. Whether Apple is entitled to recover infringer's profits for trade dress damages
27 without apportionment where it is undisputed that the accused products are
28 complex technology products combining many innovations and that their value is

1 overwhelmingly a result of technology, not the trade dress. *Sheldon*, 309 U.S. at
2 408; *Sands, Taylor & Wood v. The Quaker Oats Co.*, 978 F.2d 947 (7th Cir. 1992),
3 *on remand*, 1993 WL 204092 (N .D. Ill. 1993), *aff'd in part and rev'd in part*, 34
4 F.3d 1340, 32 U.S.P.Q.2d 1065 (7th Cir. 1994).

5 8. Whether Apple is eligible to recover damages in the form of a reasonable royalty
6 for infringement or dilution of its trade dress without proving that before the filing
7 of this lawsuit Apple and Samsung had or contemplated a license for the trade
8 dress. *A&H Sportswear Inc. v. Victoria's Secret Stores, Inc.*, 166 F.3d 197, 208-09
9 (3rd Cir. 1999).

10 9. Whether Apple may obtain a reasonable royalty for trade dress infringement
11 and/or dilution where (a) Apple failed to disclose that it was seeking this form of
12 relief either in its initial disclosures or during discovery; and (b) Apple has failed
13 to provide any legal support for such relief.

14 10. Whether there is a *per se* rule that willingness to license, as a matter of law,
15 precludes injunctive relief. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391
16 (2006); *Acumed LLC v. Stryker Corp.*, 551 F.3d 1323, 1328 (Fed. Cir. 2008).

17 11. Whether the United States patent system has extraterritorial effect such that a
18 patentee's authorization of an international first sale affects exhaustion of that
19 patentee's rights in the United States. *Jazz Photo Corp. v. Int'l Trade Comm'n*, 264
20 F.3d 1094, 1105 (Fed. Cir. 2001); *Fuji Photo Film Co., Ltd. v. Jazz Photo Corp.*,
21 394 F.3d 1368, 1373 (Fed. Cir. 2005).

22 **X. FURTHER DISCOVERY OR MOTIONS.**

23 Magistrate Judge Grewal has ordered limited depositions of three party experts to be taken
24 by July 13. Additionally, the following motions are currently pending before the Court:

- 25 1. Apple's Motion for Clarification of April 12, 2012 Order (Dkt. Nos. 885, 886).
- 26 2. Samsung's Motion for Rule 37 Sanctions for Apple's Violation of December 22,
27 2011 Court Order (Dkt. No. 968)
- 28 3. Samsung's Motion to Enforce April 12, 2012 Order (Dkt. No. 965)

1 4. Apple's Motion for Adverse Jury Inference Instructions Due to Samsung's
2 Spoliation of Evidence (Dkt. No. 895)

3 5. Samsung's Conditional Motion for Relief from Nondispositive Pretrial Order of
4 Magistrate Judge (Dkt. No. 953)

5 Samsung also intends to file a Motion for Relief from Portions of Nondispositive Pretrial
6 Order of Magistrate Judge, Dkt. No. 1144.

7 **XI. DISPUTED EVIDENTIARY ISSUES**

8 **A. Apple's Separate Statement of Disputed Evidentiary Issues:**

9 Apple is moving *in limine* to exclude the following from evidence:

10 1. ***The 035 tablet mock-up and photographs thereof.*** These photographs are not
11 relevant to the scope of the D'889 patent and should be excluded as irrelevant and potentially
12 confusing to the jury.

13 2. ***Evidence and argument regarding non-prior art Apple or Samsung design***
14 ***patents.*** These patents cannot affect the scope of a design patent because they are not prior art.

15 3. ***Evidence and argument regarding claimed prior art devices and documents***
16 ***that do not qualify as prior art.*** Devices or documents that are not shown to have been publicly
17 available in the United States before the effective filing date of the patents-in-suit are not
18 invalidating prior art, and where Samsung has relied on them as if they were these references
19 should be excluded.

20 4. ***Testimony or exhibits regarding misleading partial views of patented designs.***
21 The Federal Circuit has made clear the importance of considering multiple views of a reference,
22 yet Samsung questions witnesses and argues its case showing only the single most favorable view
23 of a design. This is misleading and Samsung should be precluded from doing so at trial.

24 5. ***Evidence or argument that Samsung received legal advice regarding the***
25 ***patents-in-suit.*** Samsung invoked the attorney-client privilege to shield these communications
26 from discovery and should not be allowed to invoke the advice of counsel to rebut an inference
27 that its infringement was willful.

28 6. ***Evidence or argument as to how courts or tribunals have in other cases***

1 *construed—or ruled on the validity, enforceability, or infringement of—any Apple or Samsung*
2 *patent.* While other tribunals have construed and adjudicated certain of the patents-in-suit or their
3 family members or foreign counterparts, these decisions are irrelevant, potentially prejudicial
4 hearsay and should therefore not be mentioned before the jury.

5 7. *Evidence or argument as to statements allegedly made by Steve Jobs to Walter*
6 *Isaacson.* Out-of-court statements by Mr. Isaacson about what Mr. Jobs allegedly said to his
7 biographer are inadmissible hearsay irrelevant to any issue in this case.

8 8. *Evidence or argument as to the Parties’ alleged corporate behavior or*
9 *financial circumstances unrelated to this case, including but not limited to the size of Apple’s*
10 *tax bill, the compensation paid to Apple’s employees, or working conditions related to the*
11 *manufacture of Apple’s products.* Samsung’s proffering of this evidence would be an obvious
12 attempt to tar Apple’s corporate reputation with irrelevant hearsay.

13 9. *Evidence or argument that Samsung’s “profits” are anything less than the*
14 *total economic profits recognized on a consolidated basis by Samsung.* Samsung should be
15 precluded from introducing evidence of its “profits” calculated based on a tax agreement with the
16 United States Internal Revenue Service. The jury must award damages based on Samsung’s
17 *economic* profits and losses, and would likely be confused by conflicting numbers that result from
18 tax-based accounting.

19 10. *Evidence or argument regarding the financial terms of Apple’s acquisition of*
20 *Fingerworks.* The Fingerworks acquisition did not involve any of the patents-in-suit and should
21 be excluded as irrelevant.

22 In addition, Apple has *not* brought a motion *in limine* to exclude certain prior art
23 references on which Samsung relied in opposing Apple’s motion for a preliminary injunction, but
24 Apple would like to alert the Court that it may at trial seek limiting instructions to prevent the
25 jury from using this evidence in an improper manner. Samsung may attempt to introduce the
26 Fidler tablet as a primary reference and the 2002 Hewlett-Packard Compaq Tablet TC1000
27 (“TC1000”) as a secondary reference to argue obviousness of the D’889 patented design.
28 However, the Federal Circuit has already held that the Fidler tablet cannot be relied upon as a

1 primary reference because it does not give the same visual impression as the D'889 patent.
2 *Apple v. Samsung*, 678 F.3d 1314, 1332 (Fed. Cir. 2012). The Federal Circuit also ruled that,
3 even if the Fidler tablet qualified as a primary reference, the TC1000 does not qualify as a
4 secondary reference that could be combined with it against the D'889 patent. *Id.* at 1331.
5 Similarly, Samsung may attempt to introduce Japanese Patent No. 1,241,638 as an anticipatory
6 reference to the D'087 patent, but the Federal Circuit has already held that the D'087 patent is
7 likely not anticipated by the '638 patent. *Id.* at 1327. In light of these Federal Circuit's rulings,
8 Apple would object to any attempt on Samsung's part to introduce the Fidler and TC1000
9 references for the purpose of establishing invalidity of the D'889 patent or the '638 patent as
10 anticipating the D'087.² Apple acknowledges that the references may be admissible for other
11 limited purposes and is not seeking to exclude them entirely.

12 Below is Samsung's list of disputed evidentiary issues. It reads like a list of motions *in*
13 *limine* – Samsung seeks to exclude four different categories of evidence. Apple objects to the
14 inclusion of these issues in this Joint Pre-Trial Statement as an end-run around the limits this
15 Court placed on motions *in limine*.

16 **B. Samsung's Separate Statement of Disputed Evidentiary Issues:**

17 Samsung requests that the Court exclude the following:

- 18 1. Evidence or argument not tied to the specific Intellectual Property rights claimed
19 by Apple in this action (MIL #1)
- 20 2. Out-of-court third-party statements about purported similarities or purported
21 confusion (MIL #2)
- 22 3. Accused devices, contentions, theories and witnesses not timely disclosed in
23 infringement contentions or interrogatory responses (MIL #3)
- 24 4. Reference to findings or rulings in other proceedings not involving the patents at
25 issue in this case (MIL #4)

26 ² Apple would have made the same argument with respect to the D'037 patent and the "Brain Box" in light
27 of this Court's recent order, had Judge Grewal not already excluded both references based on Samsung's failure to
28 disclose them properly during fact discovery. *See* Dkt. 1170 at 8-9.

- 1 5. Disputes and rulings in this action, including discovery disputes and the
2 preliminary injunction ruling (MIL #5)
- 3 6. Generalizations regarding the operation of accused Samsung products (MIL #6)
- 4 7. Resized or altered photos of Samsung's products in side-by-side product
5 comparisons (MIL #7)
- 6 8. Mr. Musika's opinion on pre-filing damages unless and until Apple makes a *prima*
7 *facie* showing of entitlement to such damages (MIL #8)
- 8 9. Evidence of Samsung's overall revenues, profits wealth and value and evidence or
9 argument that Samsung has paid lower taxes than it should have (MIL #9)
- 10 10. Evidence and argument that Apple is presently licensed to the declared essential
11 patents in suit (MIL #10)
- 12 11. Evidence that Mr. Wagner's opinions were excluded in the Motorola case, which
13 constitutes hearsay, is irrelevant to this case and is likely to confuse the jury. Fed.
14 R. Evid. 401, 403, 801; *Bank Brussels Lambert v. Credit Lyonnaise (Suisse) S.A.*,
15 2000 U.S. Dist. LEXIS 13459 (S.D.N.Y. September 19, 2000); .
- 16 12. Evidence of Apple's offer to license its declared-essential patents produced after
17 the close of discovery should be excluded as untimely produced. *Yeti by Molly*
18 *Ltd., v. Deckers Outdoor Corp.*, 259 F.3d 1101, 1106 (9th Cir. 2001).
- 19 13. Evidence relating to the Galaxy S (i9000) and Galaxy Ace products, which are not
20 sold in the United States and therefore not relevant to any relief the Court can
21 grant. Fed. R. Evid. 401, 402.
- 22 14. Testimony about irreparable harm to Apple in front of the jury. Dkt. No. 1157 at
23 13:21-25; *Apple v Samsung Elecs.*, No. 12-1105, Op. Cit. at 16 (Fed. Cir. May 14,
24 2012).

25 **XII. BIFURCATION, SEPARATE TRIAL OF ISSUES**

26 Apple's Separate Statement

27 Despite the Court's repeated admonitions to the parties to reduce the number of patents to
28 be tried, Samsung has not meaningfully narrowed its case. In early May, Samsung dropped five

1 of its original twelve patents-in-suit, leaving seven asserted patents. Two months later, that is
2 where the case still stands. This is despite the Court's admonition during the June 21 hearing that
3 it was "more satisfied with Apple's narrowing" than Samsung's and that Samsung still had "a lot
4 of very, very complex, difficult to understand utility patents." Transcript of Hearing June 21,
5 2012 at 102. Even in the face of these explicit comments, the only additional reduction in the
6 number of Samsung patents in the case arose from the Court having granted Apple's motion for
7 summary judgment against Samsung's '867 patent.

8 Samsung continues to assert infringement of a mixture of three patents purportedly
9 essential to practice the UMTS wireless standard and three "feature" patents purportedly relating
10 to various aspects of music, photo, and e-mail functionality in Apple's iPhones and iPad products.
11 None of Samsung's patents belongs to the same family, has common inventors, or relates to the
12 same technology. Samsung's misconduct before ETSI for each of the declared essential patents
13 requires Apple to present different standards-related evidence for each patent.

14 In contrast, Apple has complied with the Court's orders and focused its case, so that it is
15 now asserting a total of only three claims from three utility patents in addition to its
16 straightforward design and trade dress claims. This places Apple at a strategic disadvantage to
17 Samsung at trial, as Apple will be required to present its defenses and counterclaims related to six
18 distinct and complex technologies (including three different communications standards) in the
19 same amount of time, and subject to the same limitations on trial exhibits, as Samsung is afforded
20 to respond to Apple's claims.

21 Apple respectfully requests that the Court take into account Samsung's failure to simplify
22 its counterclaims as the Court continues to deliberate the structure of the trial commencing July
23 30, 2012 and subsequent proceedings. One method to reduce the prejudice to Apple arising from
24 Samsung's failure to narrow its counterclaims would be to sever them and try them in a
25 subsequent proceeding. Alternatively, the case could be tried in two separate phases to the same
26 jury. Allowing the jury to retire and decide Apple's claims before moving on to trial of
27 Samsung's claims would reduce the risk of juror confusion.

28 Samsung's Separate Statement

1 Samsung does not believe bifurcation is needed. Samsung also objects to Apple's
2 mischaracterization of Samsung's good faith narrowing efforts. In fact, Samsung started this
3 litigation with 12 patents and dozens of asserted claims. It is now pursuing only half of these
4 patents and has reduced the total number of its claims to nine. Moreover, Samsung is only
5 accusing a handful of products. By contrast, Apple is, despite the multiple requests by this Court,
6 proceeding on 3 utility patents, 4 design patents, 1 registered and 1 unregistered trade dress
7 claims, and is asserting multiple antitrust-related claims. Moreover, Apple is accusing at least 26
8 products each of which require separate analysis. Samsung should not be penalized for Apple's
9 tactical choices to assert this many intellectual property assets against this many products.

10 However, if the Court is inclined to consider structuring the trial, the Court should
11 bifurcate Apple's antitrust, unfair competition, and contractual counterclaims as well as its
12 defenses relating to license. The parties' pending patent, design, and trade dress claims concern
13 overlapping subject matter. In trying these claims, the parties will introduce evidence regarding
14 the features, functionality, and design of the products at issue. By contrast, Apple's antitrust,
15 unfair competition, and contractual counterclaims and related defenses involve issues relating to
16 the requirements of standard-setting organizations, including whether Samsung's offer for a
17 license to certain asserted patents was consistent with any such obligations. Further, these
18 counterclaims and defenses involve complex questions of law that may not need to be decided if
19 the case is bifurcated as suggested by Samsung. For example, these counterclaims and defenses
20 would not need to be addressed if the jury were to find that Apple does not infringe the relevant
21 Samsung patents or that the patents are not essential to the UMTS standard. Moreover, it is
22 standard practice for courts to bifurcate such claims in order to prevent jury confusion and to
23 avoid prejudice to Samsung.

24 **XIII. ESTIMATE OF TRIAL TIME**

25 Trial is set to start on July 30 and continue on Mondays, Tuesdays and Fridays, plus
26 Wednesday and Thursday August 15 and 16. The Court has allocated to each side 25 hours of
27 court time for direct examination, cross-examination and rebuttal combined.
28

1 **XIV. MISCELLANEOUS**

2 In order to address the parties' concerns regarding confidential information in documents
3 to be used at trial, the parties have agreed to review the exhibit lists, once exchanged, to propose
4 any redactions they feel are necessary, to meet and confer regarding those redactions and to
5 present the proposed redactions to the Court for approval.

6 Apple's Separate Statement

7 In view of the importance of design patents to this lawsuit, Apple urges this Court *not* to
8 show to the jury the Federal Judicial Center video, "An Introduction to the Patent System." The
9 FJC video addresses exclusively utility patents, and fails even to mention design patents. The
10 FJC video thus does not explain that a design patent protects the ornamental design of a product,
11 instead of how a product works; that in a design patent the figures, rather than words, represent
12 the claimed invention; that examination focuses not on a textual specification and written claims
13 but rather on comparisons of drawings; and that design patents are for a shorter term than utility
14 patents. (*See* FJC video at 5:50, 9:45, 13:15.) Utility patents and design patents protect
15 fundamentally different types of inventions. By not distinguishing between these two types of
16 patents and not mentioning design patents at all, the FJC's video risks confusing the jury. The
17 jury may misunderstand design patents based on the video or, noticing their absence, may
18 conclude that design patents are insignificant or aberrational. Because of this substantial risk of
19 confusing the issues and misleading the jury, the Court should not show the jury the FJC's video.
20 FED. R. EVID. 403.

21 Samsung's Separate Statement

22 Samsung proposes to show the jury the FJC video concerning the patent system. This
23 case involves 9 utility patents asserted by both sides (and four design patents asserted by Apple).
24 The patent video at issue is a neutral, judicially approved guide to the United States Patent Office
25 and its procedures that is routinely shown in most patent cases. To the extent that Apple is
26 concerned that the jurors will be confused by a distinction between design patents and utility
27 patents, their differences will be explained by jury instructions.

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The foregoing admissions having been made by the parties, and the parties having specified the foregoing issues of fact and law remaining to be litigated, this order shall supplement the pleadings and govern the course of trial in this action, unless modified to prevent manifest injustice.

1 Dated: July 5, 2012

2

3 MORRISON & FOERSTER LLP
4 HAROLD J. McELHINNY (CA SBN 66781)
5 hmcclhinny@mofo.com
6 MICHAEL A. JACOBS (CA SBN 111664)
7 mjacobs@mofo.com
8 JENNIFER LEE TAYLOR (CA SBN
9 161368)
10 jtaylor@mofo.com

11 ALISON M. TUCHER (CA SBN 171363)
12 atucher@mofo.com

13 RICHARD S.J. HUNG (CA SBN 197425)
14 rhung@mofo.com

15 JASON R. BARTLETT (CA SBN 214530)
16 jasonbartlett@mofo.com

17 MORRISON & FOERSTER LLP
18 425 Market Street
19 San Francisco, California 94105-2482
20 Telephone: (415) 268-7000
21 Facsimile: (415) 268-7522

22 WILLIAM F. LEE
23 william.lee@wilmerhale.com
24 WILMER CUTLER PICKERING
25 HALE AND DORR LLP
26 60 State Street
27 Boston, MA 02109
28 Telephone: (617) 526-6000
Facsimile: (617) 526-5000

MARK D. SELWYN (SBN 244180)
mark.selwyn@wilmerhale.com
WILMER CUTLER PICKERING
HALE AND DORR LLP
950 Page Mill Road
Palo Alto, California 94304
Telephone: (650) 858-6000
Facsimile: (650) 858-6100

By: /s/ Michael A. Jacobs
Michael A. Jacobs

Attorneys for Plaintiff and
Counterclaim-Defendant APPLE

QUINN EMANUEL URQUHART &
SULLIVAN, LLP
Charles K. Verhoeven (Cal. Bar No. 170151)
charlesverhoeven@quinnemanuel.com
50 California Street, 22nd Floor
San Francisco, California 94111
Telephone: (415) 875-6600
Facsimile: (415) 875-6700

Kevin P.B. Johnson (Cal. Bar No. 177129)
kevinjohnson@quinnemanuel.com
Victoria F. Maroulis (Cal. Bar No. 202603)
victoriamaroulis@quinnemanuel.com
555 Twin Dolphin Drive 5th Floor
Redwood Shores, California 94065
Telephone: (650) 801-5000
Facsimile: (650) 801-5100

Michael T. Zeller (Cal. Bar No. 196417)
michaelzeller@quinnemanuel.com
865 S. Figueroa St., 10th Floor
Los Angeles, California 90017
Telephone: (213) 443-3000
Facsimile: (213) 443-3100

By: /s/ Victoria Maroulis
Victoria Maroulis

Attorneys for Defendants and
Counterclaim-Plaintiffs

SAMSUNG ELECTRONICS CO.,
LTD., SAMSUNG ELECTRONICS
AMERICA, INC. and SAMSUNG
TELECOMMUNICATIONS
AMERICA, LLC

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IT IS SO ORDERED.

Dated: _____, 2012 By: _____

Honorable Lucy H. Koh

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ATTESTATION OF E-FILED SIGNATURE

I, Michael A. Jacobs, am the ECF User whose ID and password are being used to file this Joint Pretrial Statement and Proposed Order. In compliance with General Order 45, X.B., I hereby attest that Victoria Maroulis has concurred in this filing.

Dated: July 5, 2012

/s/ Michael A. Jacobs
Michael A. Jacobs