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

16 UNITED STATES DISTRICT COURT

17 NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

18 APPLE INC., a California corporation,

19 Plaintiff,

20 vs.

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

24 Defendants.
 25

CASE NO. 11-cv-01846-LHK

**SAMSUNG'S NOTICE OF MOTIONS
 AND MOTIONS IN LIMINE**

Date: July 18, 2012

Time: 2:00 pm

Place: Courtroom 8, 4th Floor

Judge: Hon. Lucy H. Koh

26
 27 **FILED UNDER SEAL**
 28

1 **NOTICE OF MOTIONS AND MOTIONS**

2 TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

3 PLEASE TAKE NOTICE that on Wednesday, July 18, 2012, at 2:00 p.m., or as soon
4 thereafter as the matter may be heard by the Honorable Lucy H. Koh in Courtroom 8, United
5 States District Court for the Northern District of California, Robert F. Peckham Federal Building,
6 280 South 1st Street, San Jose, CA 95113, Samsung Electronics Co., Ltd., Samsung Electronics
7 America, Inc., and Samsung Telecommunications America, LLC (collectively “Samsung”) will,
8 and hereby does move the Court for an order to:

- 9 1. Exclude Evidence And Arguments Not Tied To The Specific Intellectual Property
10 Rights Claimed By Apple Inc. (“Apple”) In This Action;
- 11 2. Exclude Out-Of-Court Third Party Statements About Purported Similarities Or
12 Purported Confusion;
- 13 3. Exclude Accused Devices, Contentions, Theories, And Witnesses Not Timely
14 Disclosed By Apple In Infringement Contentions Or Interrogatory Responses;
- 15 4. Exclude References To Findings Or Rulings In Other Proceedings Not Involving
16 The Patents At Issue In This Action;
- 17 5. Exclude Disputes And Rulings In This Action, Including Discovery Disputes And
18 The Preliminary Injunction Ruling;
- 19 6. Exclude Generalizations Regarding The Operation Of Accused Samsung Products;
- 20 7. Exclude Resized Or Altered Photos Of Samsung's Products In Side-By-Side
21 Product Comparisons;
- 22 8. Exclude Opinions Of Terry Musika On Pre-Filing Damages, Unless And Until
23 Apple Makes A *Prima Facie* Showing Of Entitlement To Such Damages;
- 24 9. Exclude Samsung's Overall Revenues, Profits, Wealth And Value, And Evidence
25 Or Argument That Samsung Has Paid Lower Taxes Than It Should Have; and
- 26 10. Exclude Evidence And Argument That Apple Is Presently Licensed To The
27 Declared Essential Patents-In-Suit. This motion is unopposed.
- 28

1 These motions are based on this Notice of Motions, the supporting Memorandum of Points
2 and Authorities, the Declaration of John D'Amato in Support of Samsung's Motions *In Limine*
3 dated July 5, 2012, together with all accompanying exhibits, all pleadings on file in this action,
4 and such other evidence or argument as may be presented at or before the time these Motions are
5 deemed submitted by the Court, and such matters of which this Court may take judicial notice.

6 **SAMSUNG'S CERTIFICATION PURSUANT TO FEDERAL RULE OF CIVIL**
7 **PROCEDURE 16(a) AND THE COURT'S JANUARY 3, 2011 STANDING ORDER**

8 In accordance with Federal Rule of Civil Procedure 16(a) and the Court's January 3, 2011
9 Standing Order, Samsung hereby certifies that it has in good faith conferred with Apple in an
10 effort to resolve the parties' dispute over the admissibility of evidence that is subject to these
11 motions without the Court's intervention. Samsung's efforts to resolve these disputes are
12 described in the Declaration of John D'Amato and exhibits attached thereto.

13 **RELIEF REQUESTED**

14 Pursuant to the Federal Rules of Evidence, Samsung seeks an Order excluding: (1)
15 excluding evidence and arguments not tied to the specific intellectual property rights claimed by
16 Apple in this Action; (2) out-of-court third party statements about purported similarities or
17 purported confusion; (3) accused devices, contentions, theories, and witnesses not timely disclosed
18 by Apple in infringement contentions or interrogatory responses; (4) references to findings or
19 rulings in other proceedings not involving the patents at issue in this Action; (5) disputes and
20 rulings in this Action, including discovery disputes and the preliminary injunction ruling; (6)
21 generalizations regarding the operation of accused Samsung products; (7) resized or altered photos
22 of Samsung's products in side-by-side product comparisons; (8) opinions of Terry Musika on pre-
23 filing damages, unless and until Apple makes a *prima facie* showing of entitlement to such
24 damages; (9) Samsung's overall revenues, profits, wealth and value, and evidence or argument that
25 Samsung has paid lower taxes than it should have; and (10) evidence and argument that Apple is
26 presently licensed to the declared essential patents-in-suit.

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DATED: July 5, 2012

Respectfully submitted,

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INC. and SAMSUNG
TELECOMMUNICATIONS AMERICA, LLC

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1 **MEMORANDUM OF POINTS AND AUTHORITIES**

2 Pursuant to the Court’s May 2, 2012 Minute Order and Case Management Order, Samsung
3 moves *in limine* to exclude the categories of evidence and argument described below.

4 **A. Motion # 1: Exclude Evidence Or Argument Not Tied To The Specific IP**
5 **Rights Claimed By Apple in This Action**

6 As the Court is aware, Apple’s claims are premised on specific alleged utility and design
7 patent and trade dress rights. Apple’s trade dress claims identify particular claimed features of its
8 iPhone and iPad devices that collectively comprise the claimed trade dress. (Dkt. No. 75
9 (Apple’s Am. Compl.) ¶¶ 57-68.) For example, Apple alleges its “iPhone Trade Dress” to
10 include specific features such as: a rectangular product with four evenly rounded corners; a flat
11 clear surface covering the front of the product; the appearance of a metallic bezel around the flat
12 clear surface; a display screen under the clear surface; under the clear surface, substantial black
13 borders above and below the display screen and narrower black borders on either side of the
14 screen; and, when the device is on, both a matrix of colorful square icons with evenly rounded
15 corners within the display screen and a bottom dock of colorful square icons with evenly rounded
16 corners set off from the other icons on the display, which does not change as other pages of the
17 user interface are viewed. (*Id.* ¶ 57.) Notably, the claimed trade dress does not include such
18 prominent features as the home button on the front of the device, or the Apple logo on the back.
19 Nor, of course, does it include any of the features that determine how the device performs, as
20 opposed to how it looks, including the phone, web browsing, camera functions, or video face time
21 calls. Apple’s design patents are similarly limited in scope, claiming for example only the front
22 surface and/or the bezel of an electronic device, not the overall exterior. They do not claim
23 curved sides or rear surface, or even Apple’s “home screen” button, which it represented to the
24 PTO is a “distinctive” and “prominent” feature of every version of the iPhone since Apple
25 announced the original iPhone in 2007. (Dkt. No. 1068-13.)

26 Notwithstanding the limited scope of the purported rights at issue, Apple intends to turn
27 this trial into a popularity contest in its home town, by inundating the jury with hearsay evidence
28 from various media sources, presented by its “expert” witnesses, touting the greatness of all things

1 Apple. This strategy was previewed in Apple’s complaint, where, in a section called “Apple’s
2 Innovations,” Apple describes how the iPhone supposedly “revolutionized the telecommunications
3 industry” and references media coverage of the device. (Dkt. No. 75 ¶¶ 13-25.) More recently,
4 in opposition to Samsung’s summary judgment motion, Apple presented through its “expert” Peter
5 Bressler selected snippets from various publications touting the iPhone. For example, Mr.
6 Bressler quoted an RBC Capital Markets analyst report commenting that “Apple’s iPhone in June
7 2007 disruptively raised the standard for a new kind of Smartphone design and user experience,
8 breaking sales launch records, sparking competitive responses, and *defying accepted conventions.*”
9 (Dkt. No. 1022-02 (Bressler Decl.) ¶ 81 (emphasis in original).) Apple’s marketing “expert”
10 Russell Winer similarly relies on general media coverage of Apple’s products. (Dkt. No. 1023-
11 02a (Rebuttal Report of Russell Winer) ¶¶ 57-70.)

12 This strategy includes Apple’s experts testifying to Apple’s “brand identity” and “brand
13 equity” even though it has no claim in this case for infringement or dilution of Apple’s “brand.”
14 (*See e.g., id.* ¶¶ 38-46 (brand identity) and ¶¶ 73-81 (brand equity); Dkt. No. 927-29 (Expert
15 Report of Sanjay Sood) ¶¶ 31, 57-62 (brand equity and value of the Apple brand not tied to the
16 specific rights claimed by Apple in this action).) Apple’s experts even opine on the purported
17 importance of design to Apple and/or Steve Jobs, without any connection to the specific
18 intellectual property rights claimed by Apple in this action. (*See e.g.,* Dkt. No. 927-29 ¶¶ 39-43.)

19 All of this evidence is hearsay. It consists of out-of-court statements being offered by
20 Apple to prove the truth of the statements made therein. Because there is no relevant exception to
21 the hearsay rule covering these articles, they are inadmissible. *See generally* Fed. R. Evid. 801-
22 803. They are also legally irrelevant. Apple has argued that this evidence is relevant to establish
23 secondary considerations of non-obviousness. But in order for secondary consideration evidence
24 to be relevant, it must be tied to the patented features of the device. *Asyst Techs, Inc. v. Emtrak,*
25 *Inc.*, 544 F.3d 1310, 1316 (Fed. Cir. 2008) (citation omitted) (noting that no evidence showed that
26 the commercial success of the “overall system” was attributable to the patented invention). The
27 evidence Apple seeks to introduce is directed generally to the success of Apple’s iPhone and/or
28 iPad products, rather than the specific claimed features of the design patents-in-suit. And even

1 the articles that do identify specific features – such as the “shiny” bezel – those particular features
2 are not part of the asserted design patents or claimed trade dress. Moreover, while Apple cites to
3 articles, studies, and surveys purporting to show that the appearance of the iPhone is something
4 people find attractive or even important, Apple presents no evidence suggesting that purchasers
5 buy iPhones *because of* the patented features or its claimed trade dress as opposed to buying it for
6 other reasons – such as the ability to browse the internet, watch videos, play games, read and
7 compose emails, download applications or numerous other functions. (*See* Dkt. No 1068-09 (A.
8 Hedge 4/30/12 Dep. at 194:17-20 (“if a smartphone was extremely attractive but didn’t work as a
9 smartphone, then you might buy it as a piece of sculpture, but you wouldn’t buy it as a
10 smartphone”).)¹ As such, there is no nexus between the evidence and the asserted claims of the
11 patents, and the evidence cannot therefore support a finding of commercial success. *Tokai Corp.*
12 *v. Easton Enters.*, 632 F.3d 1358, 1369 (Fed. Cir. 2011) (“[A] nexus must exist between the
13 commercial success and the claimed invention”). *See also In re GPac*, 57 F.3d 1573, 1580 (Fed.
14 Cir. 1995) (patentee’s burden to establish a nexus between any secondary considerations, such as
15 commercial success, and the limitations recited in the asserted claims). *Wm. Wrigley Jr. Co. v.*
16 *Cadbury Adams USA LLC*, -- F.3d ---, 2012 WL 2367947, at *5 (Fed. Cir. 2012) (“for commercial
17 success to be probative evidence of nonobviousness, a nexus must be shown between the claimed
18 invention and the evidence of commercial success”).

19 In addition to seeking to introduce “puffery” concerning the success of the iPhones or
20 iPads that is unrelated to the particular design patents or trade dress at issue, Apple also seeks to
21 introduce at trial evidence Apple and its “experts” claim shows that Samsung copied Apple’s
22 designs. (*See, e.g.* Dkt. No. 1022-02 ¶¶ 88-104.) But the articles Apple claims show “copying”
23 are both hearsay and untethered to the particular features claimed in the design patents and trade
24

25 ¹ Apple’s consumer survey data does not accurately attribute any percentage of sales to the
26 iPhone’s industrial design, and Apple’s own expert Winer testified that he did not know what
27 percentage of people purchased certain Apple products because of how they look as opposed to
28 other iPhone features or functions. (*See, e.g.*, Dkt. No. 1068-10 (R. Winer 4/27/12 Dep. at
271:10-16).)

1 dress at issue. The internal Samsung documents that Apple relies on also fail to provide the
2 required nexus between the claimed rights and the alleged copying. For example, Mr. Bressler
3 refers to an internal Samsung design strategy document noting that Samsung’s own designers
4 prefer a “simple” and “minimal” design philosophy. (*Id.* ¶ 96.) None of Apple’s IP at issue in
5 this case claims exclusive rights to a “simple” or “minimal” design philosophy. The kind of
6 internal competitive analyses Apple and its experts rely upon constitute a normal part of the
7 cellular and consumer electronics industries; they are prepared by every company, including
8 Apple. *Wm. Wrigley Jr. Co.*, -- F.3d at --, 2012 WL 2367947, at *6 (“[i]n some cases, evidence
9 that a competitor has copied a product *embodying a patented invention* can be an indication of
10 nonobviousness. . . . [However,] just as with the commercial success analysis, a nexus between the
11 copying and the novel aspects of the claimed invention must exist for evidence of copying to be
12 given significant weight in an obviousness analysis.”) (emphasis added) (citations omitted).

13 Similarly, Apple points to documents such as an internet article entitled: “Samsung Vibrant
14 Rips Off iPhone 3G Design” (D’Amato Decl. Ex. A) and an internet article in PC World saying
15 “[t]he design is actually very iPhone 3GS-like with an all black, shiny plastic body and minimal
16 buttons on the phone’s face” (*Id.* Ex. B) and an email from a third party saying (as translated by
17 Apple): “[n]ot just the shape, but even the packaging looks like it copied the iPhone too much, and
18 innovation is needed” -- as purported evidence of “copying.” (*Id.* Ex. C.) The third party
19 statements are inadmissible as hearsay, and all of these materials are inadmissible because there is
20 no demonstrated connection to the specific IP rights in this case. Nor do they filter out any
21 similarities resulting from functionality considerations, as is required for a proper assessment of
22 similarity for design patent purposes. *Richardson v. Stanley Works*, 597 F.3d 1298, 1293 (Fed.
23 Cir. 2010) (“[w]here a design contains both functional and non-functional elements, the scope of
24 the claim must be construed in order to identify the non-functional aspects of the design as shown
25 in the patent.”) (quoting *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir.
26 1997)).

27 Without reference to an alleged invention of any of the patents-in-suit, such evidence
28 cannot constitute either acceptance of the desirability of the invention by Samsung or evidence of

1 Samsung’s copying of that invention. As a result, these documents have no relevance to the
2 issues to be presented at trial. See *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d
3 1343, 1366 (Fed. Cir. 2001) (“[E]vidence of copying [the patentee’s product] is legally irrelevant
4 unless the [product] is shown to be an embodiment of the claims”).

5 For similar reasons, the Court should preclude Apple from presenting evidence regarding
6 former Apple CEO Steve Jobs, unless that evidence is specifically related to one of the claimed
7 patents at issue. Mr. Jobs is a popular figure to some and has become even more so since his
8 recent death. Yet while he was a named inventor on some of the patents-in-suit, he was not
9 deposed before his death, and his relevance to the particular issues raised by Apple’s claims is
10 minimal, at best. Apple should not be permitted to curry favor with the jury unrelated to the
11 substance of its claims by presenting evidence relating to its former CEO.

12 Apple’s attempt to turn an IP trial into a popularity contest was recently rejected in another
13 case. Sitting by designation, Seventh Circuit Judge Richard Posner excluded this very sort of
14 evidence, including purported secondary considerations evidence of commercial success and
15 copying:

16 Apple will not be permitted to present media articles or equivalent publicity praising
17 features of the iPhone or iPad (or the Apple company, Steve Jobs, or Apple products in
18 general) unless they mention (or can be shown to be referring to) claim elements that
19 Apple alleges Motorola infringes or that Motorola argues were anticipated or obvious and
20 that that are actually in dispute. If the articles or other publicity do not praise an element
21 in suit, they are irrelevant to any legal issue in the case, and can only confuse the jury. . . .

22 More broadly, I forbid Apple to insinuate to the jury that this case is a popularity contest
23 and that jurors should be predisposed to render a verdict for Apple if they like Apple
24 products or the Apple company or admire Steve Jobs, or if they dislike Motorola or
25 Google. The overall quality of the products involved in the litigation is irrelevant to the
26 legal issues. (D’Amato Decl. Ex. D (*Apple, Inc. v. Motorola, Inc.*, Case No.
27 1:11-cv-08540, Order of May 25, 2012 (N.D. Ill.)) at 3.)²

28 ² Judge Posner reaffirmed his rationale in a more recent decision denying Apple injunctive
relief:

“[T]he quality of the iPhone (and of related Apple products, primarily the iPad) and
consumers’ regard for it have, so far as the record shows, nothing to do with the handful of patent
claims that I had ruled presented triable issues of infringement. Apple’s ‘feel good’ theory does
not indicate that infringement of *these* claims (if they were infringed) reduced Apple’s sales or
market share, or impaired consumer goodwill toward Apple products. Typical is the statement in
(footnote continued)

1 The potential prejudice to Samsung from Apple’s proffered “feel good” evidence is even
2 greater here, where the case is being tried before a jury in Apple’s home town. Accordingly, the
3 Court should bar Apple from presenting any evidence of supposed third-party praise, copying, or
4 regarding Steve Jobs, that does not expressly relate to the claimed features of the design or utility
5 patents or trade dress at issue. To the extent Apple believes any of the evidence it seeks to
6 introduce satisfies this requirement, the Court should require it to submit the evidence in advance,
7 so Samsung and the Court can address it before it is shown to the jury.

8 Conversely, Apple should not be allowed to make allegations of wrongdoing by Samsung
9 that are not tied to the claims asserted by Apple in this case. During the deposition of former
10 Samsung Vice Chairman and CEO Gee-Sung Choi, Apple counsel asked whether Samsung had
11 improperly shared with its Mobile Communications division information regarding the volume of
12 Apple’s purchases of Samsung microchips from Samsung’s Semiconductor business unit known
13 as System LSI. Over relevance objections by Samsung counsel, Mr. Choi denied the accusation,
14 and affirmed that “[a]s a matter of principle, the company does not disclose [this] kind of
15 information.” (D’Amato Decl. Ex. E (G.S. Choi 4/17/2012 Dep.) at 17:23-20:8.)
16 Unsubstantiated allegations regarding improper sharing of Apple confidential information are
17 entirely irrelevant to the issues to be tried, and can only serve to prejudice Samsung. The Court
18 should bar Apple from asking witnesses questions regarding any such allegations, or including any
19 such references in its argument to the jury.

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23 _____
24 Apple’s brief of June 18 that ‘an Apple survey identified watching streaming videos from
25 YouTube among the top ten planned activities for consumers using iPads in the United States.’
26 The ’263 patent in issue in this litigation is not a claim to a monopoly of streaming video! Apple
27 is complaining that Motorola’s phones *as a whole* ripped off the iPhone *as a whole*. But
28 Motorola’s desire to sell products that compete with the iPhone is a separate harm – and a
perfectly legal one – from any harm caused by patent infringement.” (D’Amato Decl. Ex. F
(*Apple, Inc. v. Motorola, Inc.*, Case No. 1:11-cv-08540, Order of June 22, 2012) at 30-31.)

1 **Motion #2: Exclude Out-of-Court Third-Party Statements About Purported**
2 **Similarities or Purported Confusion**

3 Apple has questioned witnesses at deposition regarding documents it claims show actual
4 confusion between Samsung’s accused products and Apple’s claimed designs or trade dress.
5 Each of the documents contains multiple levels of hearsay, and none of them are relevant to show
6 actual confusion, as they do not address Apple’s specific claimed designs or trade dress. Because
7 they do not address the claims at issue in this case, the prejudicial effect of these documents far
8 outweighs their probative value.

9 One set of documents relate to an internal Samsung report of a mid-2011 task force visit by
10 Samsung personnel to a number of Best Buy stores in three regions of the United States, seeking
11 information regarding the reasons for returns of Samsung’s tablet device. (D’Amato Decl. Ex.
12 G.) The report was based upon conversations with Best Buy employees, one of whom is reported
13 to have said that an unidentified number of customers returned their Samsung tablet device
14 because they thought they had purchased an Apple iPad2. (*See id.* Ex. H (S. Lee 2/24/12 Dep. at
15 20-21, 27.)) This evidence is quadruple hearsay being introduced for the truth of purported
16 statements by unidentified customers trying to justify a refund that they had mistakenly believed a
17 Samsung tablet was an Apple iPad2. The customer statements are hearsay level 1. The
18 statement is then reported by a Best Buy representative to a Samsung representative, representing
19 hearsay level 2. The report of that Best Buy conversation was then made to the Samsung
20 employee who prepared the report, hearsay level 3. The resulting report is hearsay level 4.

21 Courts have recognized that this sort of internal survey-based evidence is inadmissible
22 hearsay and does not qualify for admission under the business records exception, Fed. R. Evid.
23 803(6). That rule only applies “where the person furnishing the information is ‘acting routinely,
24 under a duty of accuracy, with the employer reliance on the result, or in short ‘in the regular
25 course of business.’” *Shimozono v. May Department Stores Co.*, 2002 WL 34373490, at *14 (C.
26 D. Cal. 2002) (quoting *United States of America v. Pazsint*, 703 F.2d 420, 424 (9th Cir. 1983)).
27 “If the records contain information obtained from a customer, thus constituting hearsay within
28 hearsay, the records will come within the business records exception only ‘if it is shown that the

1 business’s standard practice was to verify the information provided.” *Id.* “The problem is that
2 the customer is under no duty to report accurately.” *Id.* (excluding customer survey response
3 cards). *See also QVC, Inc. v. MJC America*, 2012 WL 33026, at *2 (E.D. Pa. 2012) (business
4 records exception cannot be used to admit customer complaints or customer complaint logs for
5 their truth); *Alkhatib v. Steadman*, 201 WL 5553775, at * 8 (S.D. Ala. 2011) (business records
6 exception inapplicable to anonymous university faculty survey results). In *T. Harris Young &*
7 *Assoc., Inc. v. Marquette Electronics, Inc.*, 931 F.2d 816 (11th Cir. 1991), the court considered the
8 admissibility of a telephone survey, where interviewers allegedly wrote down what hospital
9 employees reported that they had been told by employees of the defendant. In rejecting
10 application of the business records exception, the Eleventh Circuit noted that “[f]or this exception
11 to be available, all persons involved in the process must be acting in the regular course of business
12 – otherwise, an essential link in the trustworthiness chain is missing.” *Id.* at 828.

13 Here, Apple seeks to introduce the task force report for the truth of the matter asserted –
14 namely, that customers supposedly were confused into believing that a Samsung tablet was
15 actually an iPad2. But neither the customers whose statements were taken by Best Buy
16 employees, nor the Best Buy employees themselves, were acting in the regular course of
17 *Samsung’s* business. Nor is there any evidence that it was Samsung or Best Buy’s regular
18 practice to prepare this very kind of customer report. Indeed, it is at least as likely that the
19 customer intended to purchase the Samsung product (whose packaging prominently features the
20 Samsung logo and labeling), decided they did not want it, and feigned confusion as an excuse to
21 justify their request for an iPad2 instead. Given that none of the supposedly confused customers
22 —nor the Best Buy employee—is available for cross-examination, the Court should exclude this
23 evidence as inadmissible hearsay.

24 Hearsay aside, the evidence should be excluded under Fed. R. Evid. 401 and 403. There
25 is no evidence that any confusion reported in the document was predicated on the particular
26 features Apple is claiming as part of its patented designs or trade dress, as opposed to unclaimed
27 features. Absent such a showing, a general report of confusion is not relevant and would be
28 highly misleading and prejudicial to Samsung. Nor is there any evidence tending to show that the

1 customers in question are typical consumers of Samsung’s tablets or that, even if accurate, the
2 experience of a few customers can be extrapolated into reliable evidence of confusion. *See, e.g.,*
3 *Nora Beverages, Inc. v. Perrier Group of America, Inc.*, 269 F.3d 114, (2d Cir. 2001) (“we do not
4 believe that the district court erred in finding that two anecdotes of confusion over the entire
5 course of competition constituted de minimis evidence insufficient to raise triable issues.”);
6 *Universal Money Ctrs., Inc. v. Am. Tel. & Tel. Co.*, 22 F.3d 1527, 1535 (10th Cir. 1994) (“De
7 minimis evidence of actual confusion does not establish the existence of a genuine issue of
8 material fact regarding the likelihood of confusion[.]”).

9 Another document Apple has relied upon is a tracking survey report provided to Samsung
10 by a third-party vendor. (D’Amato Decl. Ex. I; *see also* Ex. J (Benner 2/22/12 Dep. at 127-29).)
11 Respondents of the tracking survey were shown still photos of a Samsung television ad for the
12 original Galaxy Tab, and asked whether they recalled seeing the ad within the last 5 to 7 days.
13 If they said yes, they were then asked what product was featured in the ad. The document in
14 question reports that in the relevant period, 46% of the respondents mis-identified the ad as
15 promoting an Apple tablet. (*Id.* Ex. I at SAMNDCA00352140; Ex. J at 142:22-143:4.

16 This document should also be excluded. First, Apple is no longer claiming that version of
17 the Tab infringes the iPad trade dress. (Dkt. No. 1178 (Joint Case Narrowing Statement) ¶ A.)
18 Accordingly, it is no longer relevant and should be excluded under Rule 401 and 403. Second, it
19 contains multiple layers of hearsay and does not fall within the business records exception or any
20 other hearsay exception. The document is produced by a third party vendor, and purports to
21 reflect customer responses to survey questions. Third, the survey was done at a time when
22 Samsung’s first Tab had only just been introduced, whereas Apple’s iPad had been on the market
23 for more than six months, saturating the media as *the* tablet computer. (D’Amato Decl. Ex. J at
24 145:14-18; 146:19-24.) According to Timothy Benner, the Samsung employee listed as the
25 “owner” of the document, “[t]he issue wasn’t that it was confusing, the issue was that the iPad had
26 been very firmly established in the marketplace, and so when people saw an ad on TV that had a
27 large tablet-like display, the immediate reaction is it must be an iPad.” (*Id.* at 147:25-148:5.)

1 Moreover, the photos that were shown to the respondents in the survey were not restricted
2 to the particular features that Apple is claiming comprise its patented design features or iPad trade
3 dress. In fact, respondents were not shown a photo of the Samsung tablet device at all; rather
4 they were looking at a photo which showed six different scenes from the advertisement for that
5 product. Not all of those photos had product in the images. (*Id.* at 144:8-17.) It would be
6 highly misleading and prejudicial for Apple to present this evidence to the jury, claiming it shows
7 that customers were confused about the Galaxy 10.1 based on supposed similarities between the
8 original Galaxy Tab (a 7” device with a different industrial design) and the claimed features of
9 Apple’s iPad trade dress.³

10 **C. Motion #3: Exclude Accused Devices, Contentions, Theories, and Witnesses**
11 **Not Timely Disclosed In Infringement Contentions Or Interrogatory**
12 **Responses**

13 On multiple occasions during the course of this litigation, the rules of this Court and the
14 Federal Rules of Civil Procedure have required Apple to provide adequate and timely notice to
15 Samsung regarding what products Apple alleges infringe its trade dress, trademark and design and
16 utility patents. On August 26, 2011, Apple served its Infringement Contentions per Local Patent
17 Rule 3-1, which required that Apple identify for the asserted utility patents “[s]eparately for each
18 asserted claim, each accused apparatus, product, device, process, method, act, or other
19 instrumentality (“Accused Instrumentality”) of each opposing party of which the party is aware. . .
20 as specific as possible” and a chart “identifying specifically where each limitation of each asserted
21 claim is found within each Accused Instrumentality, including for each limitation that such party
22 contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s)
23 in the Accused Instrumentality that performs the claimed function.” L.P.R. 3-1(b)-(c). In its
24 Infringement Contentions, Apple identified 26 specific accused devices. (Dkt. No. 801-5.)

25 ³ Apple’s use of such evidence has not been limited to these two documents. (*See, e.g.*
26 D’Amato Decl. Ex. K (alleged comments from developers); Ex. L (alleged comments from
27 Google meeting); Ex. M at SAMNDCA10167857 (alleged comment from Google); Ex. N at
28 SAMNDCA10969930-932 (alleged comment from professor); Ex. Y at SAMNDCA00250866
(alleged consumer comment).) Any such types of evidence should be excluded.

1 Apple also served an Addendum to its Disclosure of Asserted Claims and Infringement
2 Contentions, identifying one additional specific device – the Galaxy S II. (Dkt. No. 801-6.)
3 Apple did not identify the Epic 4G Touch, Skyrocket, Galaxy Tab 10.1 LTE, Gravity Smart, or
4 Galaxy S Showcase (i500) in its infringement contentions, nor did it provide any detailed charts
5 required under L.P.R. 3-1(b)-(c) for the Galaxy S II product.

6 Samsung’s Interrogatory No. 5 also required Apple to identify, by September 12, 2011,
7 “every product manufactured, used, sold, offered for sale, or imported into the United States since
8 2005 that [Apple] believe[d] uses or may use any protected design, trademark, trade dress, or
9 invention of the APPLE PATENTS-IN-SUIT, APPLE TRADE DRESS, and APPLE
10 TRADEMARKS and the date(s) on which you believe that use occurred.” Apple served its
11 response on September 12, 2011. (D’Amato Decl. Ex. P (Apple’s Objections and Responses to
12 Samsung Electronics Co. Ltd.’s First Set of Interrogatories).) Apple did not identify the Galaxy S
13 II, the Epic 4G Touch, the Skyrocket, Gravity Smart or the Galaxy Tab 10.1 LTE in its response.
14 (*See id.*)

15 Since then—for nearly *6 months*—Apple did not amend either its Infringement
16 Contentions or its response to Interrogatory No. 5. Not until March 2012, on the very last day of
17 discovery, and after the scheduled discovery cut-off, did Apple serve an amended response to
18 Interrogatory No. 5 that purported to expand the scope of Apple’s infringement allegations and
19 accuse *new products* of infringing Apple’s utility patents, design patents, trademarks and trade
20 dress. (D’Amato Decl. Ex. Q (Apple’s Second Amended Objections and Response to Samsung
21 Electronics Co. Ltd.’s Interrogatory No. 5).)

22 The Court should reject Apple’s last minute effort to expand the scope of the accused
23 Samsung products. Indeed, in February 2012, Apple vigorously opposed Samsung’s request to
24 amend its infringement contentions to add Apple’s iPhone 4S, arguing that adding a new device
25 with only a month remaining in discovery would leave the parties “little time to conduct
26 discovery” and risk “delaying the existing expedited trial schedule.” (Dkt. No. 713 at 1.) But
27 Apple went even further, arguing that the parties’ dispute over the scope of any discovery relating
28 to the additional products both parties wanted to add “confirm[ed] that no additional products –

1 *whether Apple's or Samsung's* – should be added to this case at this time.” (*Id.* at 7 (emphasis
2 added).) Based on Apple's representations, the Court denied Samsung's request to add the
3 iPhone 4S. (Dkt. No. 836 at 12.)

4 Having succeeded in defeating Samsung's request to add one product to this case by
5 amending its complaint, and having argued that neither party should be permitted to add new
6 products after February 3, 2012, when it filed its opposition to Samsung's motion to amend its
7 infringement contentions, Apple should be barred from asserting at trial any utility patent claims
8 with respect to Samsung products that were not identified in its Infringement Contentions served
9 on August 26, 2011. Apple clearly knew that at least the Skyrocket, Epic 4G Touch, Gravity
10 Smart, and Galaxy 10.1 LTE were *not* covered by its infringement contentions: Apple asked
11 Samsung to stipulate that these new products should be added to the case in March 2012 (Dkt. No.
12 801-8), and after Apple failed to get a stipulation, Apple unilaterally added the new products to its
13 interrogatory response. Such amendment would not have been necessary if Apple had complied
14 with its obligations under the local patent rules to identify the products in its Infringement
15 Contentions.

16 Apple also should be barred from asserting at trial any design patent or trade dress claims
17 with respect to any products not identified in Apple's original response to Samsung's contention
18 Interrogatory No. 5, served on September 12, 2011. Apple waited until March 2012 to identify
19 the following products as accused products for Apple's design patent, trade dress, and trademark
20 claims: Galaxy S2 i9100, Galaxy S2 Epic 4G Touch, Galaxy S2 (T-Mobile), Galaxy S2 (AT&T),
21 and Galaxy S2 Skyrocket. Apple also waited until March 2012 to accuse the Captivate, Galaxy
22 Ace, Droid Charge, Continuum, Epic 4G, and Galaxy Tab 7.0 Plus of trade dress claims. Apple
23 further delayed until March 2012 to identify the Acclaim, Indulge, Intercept, Galaxy S i9000, and
24 Galaxy Tab 7.0 Plus as accused products for its trademark claims.

25 Apple thus should be barred from asserting at trial infringement or trade dress claims
26 against the following products identified for the first time in Apple's recently served supplemental
27 interrogatory response: Galaxy S2 Epic 4G Touch; Galaxy S2 i9100; and Galaxy S2 Skyrocket
28 ('002, '891, '163 '915, and '828 patents); Galaxy S2 Epic 4G Touch ('381 patent); Galaxy S2

1 Epic 4G Touch; Galaxy S2 i9100; and Galaxy S2 Skyrocket; Galaxy S2 (T-Mobile); Galaxy S2
2 (AT&T) (D'087, D'677 and D'270 patents); Galaxy S2 i9100, Galaxy S2 Epic 4G Touch, Galaxy
3 S2 (AT&T), Galaxy S2 (T-Mobile), Galaxy S2 Skyrocket (all iPhone Trade Dress claims); and
4 Galaxy Tab 7.0 Plus (all iPad Trade Dress claims). Apple should also be precluded from
5 broadening its claims against existing accused products based on the late notice provided in its
6 March 2012 interrogatory responses.

7 Apple should similarly be prevented from offering argument or testimony on theories and
8 contentions it withheld during discovery despite interrogatory requests from Samsung. In
9 particular, Apple should be limited in its infringement arguments for its design patents to the level
10 of detail it included in its interrogatory responses. Samsung's Interrogatory No. 72 sought the
11 following: "Separately for each SAMSUNG product that YOU contend infringes any APPLE
12 DESIGN PATENT, state fully and in detail on a patent-by-patent basis all facts supporting YOUR
13 contention of infringement." (D'Amato Decl. Ex. R (Samsung's Fourth Set of Interrogatories to
14 Apple) at 23.) Apple's response was beyond perfunctory. Here are the responses it provided by
15 patent:

- 16 • D'305: "Each accused Samsung product incorporates an array of icons that is
17 substantially the same in overall visual appearance as the design claimed in the
18 D'305 Patent." (*Id.* Ex. S (Apple's Objections and Responses to Samsung's
19 Fourth Set of Interrogatories) at 144.)
- 20 • D'087: "Each accused Samsung product incorporates a front face and bezel that is
21 substantially the same in overall visual appearance as the design claimed in the
22 D'087 Patent." (*Id.* at 99.)
- 23 • D'677: "Each accused Samsung product incorporates a front face that is
24 substantially the same in overall visual appearance as the design claimed in the
25 D'677 Patent." (*Id.* at 111.)
- 26 • D'889: "Each accused Samsung product incorporates a body and front face that is
27 substantially the same in overall visual appearance as the design claimed in the
28 D'889 Patent." (*Id.* at 97.)

1 Apple then included side-by-side images of the patents and Samsung products. (*Id.* at 97-
2 122, 144-51.)

3 Apple should also be prevented from arguing or submitting evidence that it factored out
4 any functional elements from its patented designs before performing the infringement analysis to
5 determine whether any purported similarities between the accused products and the Apple patents
6 were due only to the remaining ornamental features. The reason for this is that Apple continues
7 to maintain that no aspect of its designs are functional, despite this Court’s ruling and their
8 experts’ admissions to the contrary. (*See* Dkt. No. 449 (Order on Preliminary Injunction Motion)
9 at 15, 39-40; Dkt. No. 1136 (Apple’s Response to Samsung’s Opening Design Patent Claim
10 Construction Brief) at 9-13; Dkt. No. 1090 (Samsung’s Opening Design Patent Claim
11 Construction Brief (Filed Under Seal on June 12, 2012) at 5, 12.) Apple’s discovery responses
12 confirm that it believes there are no functional elements in its designs. (*Id.* Ex. S at 61-65.) So,
13 as in its infringement interrogatory responses above, Apple refused to factor out any features as
14 functional in its infringement contentions. (*Id.* at 72 (“No aspect of the designs in the asserted
15 design patents is dictated by function. Thus, no aspect of the designs should be factored out for
16 purposes of determining whether Samsung’s devices infringe the D’889, D’087, D’677, D’270,
17 D’790, D’334, and D’305 Patents.”) Apple should be precluded from offering new and
18 previously undisclosed evidence or argument purporting to show that any similarity between the
19 Apple patent and the Samsung product is due to the remaining ornamental features.

20 Finally, Apple should also be precluded from introducing any evidence at trial solely
21 directed to supporting an indirect theory of infringement of its design patents. Apple failed to
22 articulate any such theory in its Complaint, Amended Complaint, Interrogatory Responses, or
23 Expert Reports. In its Interrogatory No. 7, Samsung asked Apple to “Separately for each of the
24 APPLE PATENTS-IN-SUIT, APPLE TRADE DRESS and APPLE TRADEMARKS state all
25 facts supporting any contention by APPLE that Samsung has willfully infringed, diluted, or falsely
26 designated the origin of its products for each patent, trade dress, and trademark, including when
27 and how APPLE asserts Samsung had actual notice of the APPLE PATENTS-IN-SUIT, APPLE
28 TRADE DRESS, and APPLE TRADEMARKS.” (*See* D’Amato Decl. Ex. O (Samsung’s First

1 Set of Interrogatories to Apple, Inc.) at 13-14.) In response, Apple merely stated in pertinent part:
2 “Samsung manufactured, distributed, imported into the United States, used in the United States,
3 offered for sale in the United States, and sold in the United States products that infringed the
4 Apple patents, trade dress, and trademarks at issue in this lawsuit despite an objectively high
5 likelihood that its actions constituted infringement of valid patents.” (*Id.* Ex. T (Apple’s
6 Corrected Amended Objections and Responses to Samsung Electronics Co. Ltd.’s Interrogatory
7 Nos. 4, 6, 7, 16, 17, 18) at 7.) All of the identified conduct are acts of direct infringement. (*See*
8 *id.* at 7-9.) Similarly, in its Interrogatory No. 72, Samsung requested that Apple “state fully and
9 in detail on a patent-by-patent basis all facts supporting YOUR contention of infringement.” (*Id.*
10 Ex. R at 23.) Nowhere in its response did Apple articulate any theory or acts of indirect
11 infringement of any design patent. (*Id.* Ex. S at 94-96.) Indeed, Apple recently confirmed that it
12 was proceeding only on a direct infringement theory when it stated “Samsung’s sales of the
13 accused products are the infringing act.” (Dkt. No. 759-02 at 14.)

14 Because Apple failed to plead indirect infringement, disclose an indirect infringement
15 theory in discovery, or include an indirect infringement theory in its expert reports, Apple should
16 be precluded at trial from arguing such a theory or presenting evidence solely directed to it. *See,*
17 *e.g., Fed. R. Civ. P. 26(e)(1); Microstrategy Inc. v. Business Objects, S.A.*, 429 F.3d 1344, 1356-
18 57 (Fed. Cir. 2005); *Transclean Corp. v. Bridgewood Servs., Inc.*, 77 F. Supp. 2d 1045, 1061-62
19 (D. Minn. 1999), *aff’d*, 290 F.3d 1364 (Fed. Cir. 2002) (party violated Rule 26(e) by failing to
20 “completely disclose its position” on patent invalidity in response to contention interrogatories).
21 A party must exercise “due diligence” in supplementing its disclosures, *SPX Corp. v. Bartec USA,*
22 *LLC*, 2008 U.S. Dist. LEXIS 29235, at *22 (E.D. Mich. Apr. 10, 2008), and supplementation
23 should occur “during the discovery period.” Fed. R. Civ. P. 26 Advisory Committee’s Note to
24 1993 Amendments.

25 **D. Motion #4: Exclude Reference to Findings or Rulings In Other Proceedings**
26 **Not Involving The Patents At Issue In This Case**

27 Both Apple and Samsung are currently or have been involved in other proceedings, some
28 of which involved the same or related IP rights. These include litigation in foreign jurisdictions,

1 as well as investigations before the ITC. Apple should be precluded from referencing any
2 findings or rulings from those proceedings, as they would not be relevant to the issues in this case.
3 Furthermore, any introduction of, or reference to, findings or orders of those proceedings could
4 only serve to mislead and/or confuse the jury, warranting exclusion under Fed. R. Evid. 403.⁴
5 Judge Posner granted a similar motion that both *Apple* and Motorola filed in the Motorola
6 proceeding. (D’Amato Decl. Ex. U (*Apple, Inc. v. Motorola, Inc.*, Case No. 1:11-cv-08540,
7 Order of May 31, 2012) at 10.)

8 **E. Motion #5: Exclude Disputes and Rulings in this Action, Including Discovery**
9 **Disputes and the Preliminary Injunction Ruling**

10 Both sides in this action have presented a number of discovery disputes for resolution by
11 the Court. Both sides have prevailed on some but not others. In none of these disputes has the
12 Court imposed any remedy of which the jury should be made aware: there have been no deemed
13 findings of fact, and no adverse inference instructions. Accordingly, the mere fact that discovery
14 disputes arose and the results of those disputes, whether they be motions to compel, motions for
15 sanctions, orders on motions to compel or orders on motions for sanctions, which happen in every
16 major litigation, is of no relevance to any issue to be decided by the jury and will likely distract
17 the jury from the dispositive issues of the case. Apple should be precluded from making any
18 reference to any such disputes, motions or orders.

19 Similarly, the Court’s rulings on Apple’s preliminary injunction motion should not be
20 referenced to the jury. A preliminary injunction proceeding is by nature interim. A court need
21 only find a likelihood of success on the merits, not make a final adjudication. *See, e.g., Sierra*
22 *On-Line, Inc. v. Phoenix Software, Inc.*, 739 F.2d 1415, 1423 (9th Cir. 1984). Moreover, a court
23 can change its mind on the merits of the case as later developments clarify the relevant facts and
24 law. *See, Jack Guttman, Inc. v. Kopykake Enterprises, Inc.*, 302 F.3d 1352, 1361 (Fed. Cir.

25 _____
26 ⁴ This motion does not seek to exclude evidence or attorney argument from other
27 proceedings to the extent it is relevant to the issues here, including from the related ’796
28 Investigation Apple brought in the ITC. Further, the motion does not seek to exclude evidence or
attorney argument on issues for the Court’s (not the jury’s) determination.

1 2002). Any reference to the Court’s ruling on the preliminary injunction motion might have an
2 undue impact on the jury. It should be excluded under Fed. R. Evid. 403.

3 **F. Motion #6: Exclude Generalizations Regarding the Operation of Accused**
4 **Samsung Products**

5 To prove that each of the accused Samsung products infringes Apple’s design and utility
6 patents, Apple must demonstrate that each accused model contains all of the limitations in the
7 allegedly infringed patent claim. *CVI/Beta Ventures, Inc. v. Tura L.P.*, 112 F.3d 1146, 1161 (Fed.
8 Cir. 1997) (“In order for there to be infringement, each and every limitation set forth in a patent
9 claim must be found in the accused product, either literally or under the doctrine of equivalents”).
10 Apple has accused over two dozen Samsung models of infringement; accordingly, Apple must
11 present evidence that each and every one of those models practice all of the limitations of the
12 asserted claims.

13 Apple’s experts, however, have not satisfied that burden in their reports. Instead, Apple
14 repeatedly provides analysis only for a limited sample of what it deems “representative” products.
15 For example, while Apple’s expert Dr. Ravin Balakrishnan starts his report with a detailed list of
16 the products that Apple has accused of infringement of the ‘381 patent by virtue of their
17 incorporation of the Gallery, Contacts, Browser and ThinkFree Office applications (D’Amato
18 Decl. Ex. V (Expert Report of Ravin Balakrishnan, Ph.D. Regarding Infringement of U.S. Patent
19 No. 7,469,381) ¶ 37), Balakrishnan’s subsequent analysis fails to analyze each of these products
20 and each of the applications against the asserted claims. Instead, for each claim, Balakrishnan
21 only analyzes *one* application for *one* product. (*See, e.g., id.* Ex. 3 (providing infringement chart
22 for Claim 1 only for the Gallery application of the Exhibit 4G and infringement chart for Claim 6
23 only for the Browser application of the Galaxy Tab 10.1).) He then generally notes that the
24 “ordinary and intended use” of the remaining accused products and remaining accused
25 applications also infringe each claim. (*See, e.g., id.* ¶¶ 63, 66, 68, 73, 75, 77, 79, 84, 87, 92, 96,
26 99, 101.)

27 Apple’s other experts apply similar shortcuts to their infringement analyses. Dr. Karan
28 Singh, for example, admits that for the ’163 patent, he only reviewed source code on *four* (out of

1 over 30) accused products, and that based on his review of that small sample of products, “for
2 each major Android release, *all of the Accused Products* based on that release implement the
3 accused functionalities of the ’163 patent in substantially the same way as the representative
4 device for that release whose source code I have analyzed.” (D’Amato Decl. Ex. W (Expert
5 Report of Karan Singh) ¶ 39 (emphasis added).) Dr. Singh’s discussion of the ’915 patent suffers
6 from the same generalizations. (*Id.* ¶¶ 316-18 (concluding that all accused products behave in the
7 same way after only analyzing the Galaxy Tab 10.1 and Galaxy S II).)

8 Apple’s experts—by relying on their own interpretation of what products are
9 “representative” of all of the accused products—have performed and presented only an incomplete
10 analysis of the accused product models. The parties have not reached an agreement regarding
11 representative products, and indeed such an agreement would be virtually impossible since there
12 are numerous variations in the operation of the accused features or applications on each of the
13 accused models, each of which is capable of running one of the many different versions of
14 Android. Thus Apple certainly has no basis to say that all or even some of the accused products
15 operate in the same way as the sample products Apple did analyze. The Court therefore should
16 bar Apple from making broad sweeping generalizations that all or any of the accused products
17 operate in the same way for purposes of the infringement analysis.

18 **G. Motion # 7: Exclude Resized or Altered Photos of Samsung’s Products in**
19 **Side-by-Side Product Comparisons**

20 Apple has repeatedly presented the Court with manipulated images of the accused
21 Samsung products that are intended to make the Samsung phones or tablets look like they are
22 identical in height or width to the iPhone or iPad. (*See, e.g.*, Dkt. No. 1 ¶ 61 (side-by-side
23 comparison of Apple iPhone 3GS and Galaxy S i9000); Dkt. No. 75 ¶¶ 94-95 (same); Dkt. No. 86
24 (Apple’s Motion for Preliminary Injunction) at 2 (side-by-side comparisons of iPhone 3GS versus
25 Galaxy S 4G and iPhone 4 versus Infuse 4G), 3 (side-by-side comparison of iPad 2 and Galaxy
26 Tab 10.1), 9-12 (comparison of Apple iPhone 4 with Galaxy S 4G and Infuse 4G); Dkt. No. 90
27 (Declaration of Cooper C. Woodring in Support of Apple’s Motion for Preliminary Injunction) Ex.
28 9 (side-by-side comparisons of iPhone 3GS and Galaxy S 4G), Ex. 12 (side-by-side comparisons

1 of iPhone 4 and Infuse 4G), Ex. 15 (side-by-side comparisons of iPhone 1 and Galaxy S 4G), Ex.
2 18 (side-by-side comparisons of iPhone 1 and Infuse 4G).) Apple’s expert Cooper Woodring
3 admitted that he “scaled the drawings and photographs such that the phones and tablet computers
4 correspond with one another.” (Dkt. No. 90 ¶ 12.)

5 Most, if not all, of the accused Samsung products have different dimensions than Apple’s
6 phone and tablet products, and users can perceive those differences by looking at the products
7 themselves. In the mobile and tablet computer industries, where a tenth of an inch makes a
8 difference for user experience, Apple cannot alter images of the Samsung products to eliminate
9 these dimensional differences and then argue copying on that basis.

10 To ensure that the jury is not improperly swayed and that Samsung is not prejudiced by
11 such altered or resized pictures that give the inaccurate sense of similarity, the Court should bar
12 Apple from presenting any altered or resized or manipulated pictures of the accused Samsung
13 products, especially in side-by-side comparisons with Apple products.

14 **H. Motion # 8: Exclude Any Evidence of Pre-Filing Notice Other Than**
15 **Identified In Apple’s Interrogatory Response and Provisionally Exclude Mr.**
16 **Musika’s Opinions on Pre-Filing Damages Unless and Until Apple Makes a**
Prima Facie Showing of Entitlement to Such Damages

17 Apple admits it has not marked its products. (Dkt. No. 991-04c at 2:18-20.) Therefore,
18 Apple cannot recover damages before the date that it put Samsung on actual notice of its patents.
19 35 U.S.C. § 287; *Am. Med. Sys., Inc. v. Med. Eng’g Corp.*, 6 F.3d 1523, 1537 (Fed. Cir. 1993);
20 *Nike, Inc. v. Walmart Stores, Inc.*, 138 F.3d 1437, 1446 (Fed. Cir. 1998) (marking applies to
21 design patents). Notice requires not only identifying the patent allegedly infringed, but also the
22 affirmative communication of a specific charge of infringement by a specific accused product.
23 *See Amsted Indus. Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 187 (Fed. Cir. 1994) (“Actual
24 notice requires the affirmative communication of a specific charge of infringement by a specific
25 accused product or device.”).

26 The earliest date that Samsung even arguably received notice of alleged infringement of
27 the ‘381 patent was August 2010. Samsung did not receive notice of alleged infringement of the
28 ‘915 and D’677 patents until April 15, 2011, with the filing of Apple’s Complaint. Samsung did

1 not receive notice of the ‘163, D’305, D’889, or D’087 patents until Apple filed its First Amended
2 Complaint on June 16, 2011. (Dkt. No. 927-11.)

3 In its Interrogatory No. 7, Samsung asked Apple to state “when and how APPLE asserts
4 Samsung had actual notice of the APPLE PATENTS-IN-SUIT . . .” (D’Amato Decl. Ex. T
5 (Apple’s Corrected Amended Objections and Responses to Samsung Electronics Co. Ltd.’s
6 Interrogatory Nos. 4, 6, 7, 16, 17, 18) at 6.) In response, Apple did not mention its ‘915, ‘163 or
7 D’087 patents at all. (*Id.* at 6-8.) Apple failed to provide any information as to how and when
8 Samsung had actual notice of these patents. With respect to its D’889 and D’305 patents, Apple
9 merely stated that “Samsung was aware” of these patents “at least as early” as April 14, 2008, and
10 November 27, 2009, respectively. (*Id.* at 8.) But, as noted above, mere awareness of a patent
11 without more – assuming Samsung was even aware at those times – is insufficient to constitute
12 actual notice for the purpose of triggering damages. *See Amsted*, 24 F.3d at 187. And, Apple
13 never sought to supplement its response. Accordingly, Apple’s response to Samsung’s
14 Interrogatory No. 7 fails to allege legally sufficient actual pre-suit notice for anything other than
15 the ‘381 patent.

16 In ruling on Samsung’s *Daubert* motions, the Court declined to exclude Mr. Musika’s
17 opinions on pre-notice damages on the basis that “Samsung’s objection turns on a factual dispute
18 as to when Samsung received actual notice.” (Dkt. No. 1157 at 13:17.) But Apple should be
19 held to the information it chose to disclose during discovery. And the information contained in
20 Apple’s interrogatory response raises no factual dispute as to Samsung’s notice of any asserted
21 patent – Apple said nothing at all about the ‘915, ‘163 and D’087 patents, and its response
22 regarding the D’889 and D’305 patents does not meet the *Amsted* standards. Accordingly, at very
23 least, Mr. Musika should be precluded from offering any opinions regarding pre-filing damages
24 for these specific patents.

25 Indeed, having successfully argued for this standard to apply to Samsung in the context of
26 its motion to strike, Apple has no credible argument to the contrary. (*See* Dkt. No. 939, at 3
27 (“Rule 26(e)(1) of the Federal Rules of Civil Procedure requires parties to seasonably supplement
28 their interrogatory responses if the prior responses are incomplete or incorrect. . . . Rule 37(c)(1)

1 ‘mandates that a party’s failure to comply with . . . the supplemental disclosure obligations under
2 [Rule] 26(e) results in that party being precluded from use’ of the withheld information. *Oracle*
3 *USA, Inc. v. SAP AG*, 264 F.R.D. 541, 544 (N.D. Cal. 2009); *see also Yeti by Molly Ltd. v.*
4 *Deckers Outdoor Corp.*, 259 F.3d 1101, 1106 (9th Cir. 2001) (preclusion of evidence under Rule
5 37(c)(1) is ‘automatic’ and ‘self-executing’ unless an exception applies”).

6 Even were the Court inclined to permit Apple to offer evidence at trial not previously
7 disclosed in discovery, Apple should not be allowed to have Mr. Musika testify to pre-notice
8 damages unless and until Apple first places admissible evidence before the jury that creates a
9 genuine dispute of fact concerning when Samsung received actual notice. (*Id.*) Almost half of
10 Mr. Musika’s extraordinary damages figure pertains to the period before Samsung contends it
11 received notice of Apple’s asserted intellectual property. (Dkt. No. 991-19c (Supp’l Expert
12 Report of Terry Musika) Exs. 17.2-S, 17.3-S, 17.4-S, 18.2-S, 18.3-S, 18.4-S.) It would be highly
13 prejudicial to allow Mr. Musika to put this large figure before the jury without Apple first making
14 at least a *Prima Facie* showing that Samsung is liable for pre-notice damages (which, frankly,
15 Apple’s interrogatory response shows it cannot do).

16 Accordingly, Samsung requests that the Court either: (a) hold Apple to its interrogatory
17 response and preclude Mr. Musika from testifying as to pre-filing damages with respect to the
18 ‘915, ‘163, D’087, D’889 and D’305 patents; or at very least (b) provisionally exclude Mr.
19 Musika’s opinions on pre-notice damages unless and until Apple first makes a *prima facie*
20 showing that it is entitled to pre-notice damages; or alternatively, grant Samsung a hearing outside
21 the presence of the jury before Mr. Musika takes the stand in order for the Court to determine
22 whether there is indeed a material factual dispute sufficient to provide a basis for Mr. Musika’s
23 pre-notice testimony.

24 **I. Motion #9: Exclude Evidence of Samsung’s Overall Revenues, Profits,**
25 **Wealth and Value and Evidence or Argument that Samsung has paid Lower**
Taxes Than It Should Have

26 Apple has suggested that it intends to present at trial evidence of Samsung’s overall
27 revenues, profits, wealth and value – as opposed to revenues, profits, wealth or value attributable
28 to the intellectual property at issue in this case. These figures are irrelevant to the parties’ claims

1 and are likely to confuse and distract the jury from the issues in dispute. The only purpose for
2 Apple putting such figures before the jury would be to suggest that Samsung has the means to pay
3 a very large damages award and the jury should thus give Apple one. But such evidence and
4 argument would be irrelevant to any damages determination, highly prejudicial, and should be
5 excluded under Rule 403. *See, e.g., La Plante v. Am. Honda Motor Co., Inc.*, 27 F.3d 731, 740
6 (1st Cir. 1994) (“Although the evidence of Honda’s profits from ATV sales was of some probative
7 value, we believe the danger that this evidence would unfairly prejudice the jury was
8 overwhelming.”); *Jones v. C.H. Robinson Worldwide, Inc.*, 558 F. Supp. 2d 630, 651 (W.D. Va.
9 2008).

10 Likewise, Apple has indicated that it intends to suggest to the jury that SEA and STA have
11 improperly avoided paying their fair share of taxes in the United States. For example, in his
12 Opening Report, Apple’s damages expert, Mr. Musika, refers to “a transfer pricing agreement *to*
13 *avoid U.S. taxation.*” (Dkt. No. 991-19b (Expert Report of Terry Musika) ¶ 148 (emphasis
14 added).) Mr. Musika also frames one calculation by saying “that Samsung enjoys an advantage
15 over Apple by paying *virtually no income taxes in the U.S.* on infringing sales and a very low 16.5
16 percent rate outside the U.S.” (*Id.* ¶ 230 (emphasis added).) He attributes an “additional value
17 [to] the fact that Samsung pays an effective tax rate of less than 1% in the U.S. on its sale of
18 accused products.” (*Id.* ¶ 252.) And he even suggests that an accounting would have to be done
19 to quantify “the full extent of tax benefits enjoyed *by avoiding U.S. taxes.*” (Dkt. No. 996-15d
20 (Rebuttal Expert Report of Terry Musika) ¶ 64.) In short, Mr. Musika goes out of his way to
21 insinuate that Samsung has not paid its fair share of taxes in this country.

22 As an initial matter, Apple well knows that SEA’s and STA’s U.S. tax arrangements have
23 been carefully considered, vetted, and blessed by the U.S. Government in the form of an Advance
24 Pricing Agreement (“APA”) with the U.S. Internal Revenue Service (“IRS”). (*See* Dkt. No. 991-
25 19b ¶ 253.) Mr. Musika’s suggestion that Samsung sought to “avoid U.S. taxation” is thus not
26 only highly prejudicial and inflammatory, but dead wrong. (*Id.* ¶ 148.)

27 It also is irrelevant. Apple will likely argue that it should be entitled to show that SEA’s
28 and STA’s profits would have been higher but for the APA, and that Apple’s damages should be

1 based on those notional higher amounts. (*See, e.g.*, Dkt. No. 822-02 at 7:11-12 (“STA earns a
2 minimal artificial profit, designed purely as a tax construct to limit what is paid to the IRS, and the
3 remaining profits are recognized abroad.”); 12:28-13:1 (“As we have seen, anything less allows
4 Samsung to move profits around artificially and escape a full reckoning for its infringement of
5 Apple’s intellectual property.”) Putting aside for the moment the merits of that argument (or lack
6 thereof), it does not justify the baseless and highly prejudicial allegation of tax avoidance. To
7 make the argument that STA’s and SEA’s profits were lower than they otherwise would have been
8 because of the APA does not require Apple to level the scurrilous accusation that Samsung paid
9 less taxes than it should have. Indeed, the opposite is true. Because, as noted above, SEA’s and
10 STA’s tax arrangements have been reviewed and endorsed by the IRS, any accusation of tax
11 avoidance is nonsensical.

12 In any event, Apple’s proposed argument is unsupported by any relevant law. If Apple
13 prevails on its claims, and satisfies the relevant legal standards, it may be entitled to STA’s and/or
14 SEA’s actual profits from sales of the accused Samsung products. *See* 15 U.S.C. § 1117(a) (the
15 plaintiff shall be entitled to recover, upon the finding of an infringement and “subject to the
16 principles of equity”: [¶] (1) *defendant’s profits*”) (emphasis added); 35 U.S.C. § 289 (An accused
17 design patent infringer “shall be liable to the owner to the extent of *his total profit*”). Apple has
18 not – and cannot – cite any relevant law for the proposition that an infringer should be required to
19 disgorge *more* than its actual profits merely because its profits could have been higher, whether
20 because its profits were set by an agreement with the federal government or otherwise.

21 Indeed, to allow Apple to argue at trial that the jury should order the disgorgement of *more*
22 than STA’s and/or SEA’s actual profits would be an error of law. 15 U.S.C. 1117(a)(3) provides
23 that, “If the *court* shall find that the amount of the recovery based on profits is either inadequate or
24 excessive the *court* may in its discretion enter judgment for such sum as the *court* shall find to be
25 just, according to the circumstances of the case.” (Emphasis added.) Section 1117(a)(3) thus
26 entrusts the Court – not the jury – with the discretion of increasing the plaintiff’s recovery if the
27 disgorgement of defendant’s actual profits is inadequate. It does not permit the jury to increase
28 plaintiff’s recovery by simply deeming the defendant to have made more profit than it actually did.

1 See *The Coryn Group II, LLC v. O.C. Seacrets, Inc.*, 2011 WL 862729, at *9 n.29 (D. Md. March
2 10, 2011) (the “language of the Lanham Act is clear-a successful plaintiff in a trademark
3 infringement may recover the ‘defendant’s profits,’ and to prove the defendant’s profits, the
4 plaintiff must show the ‘defendant’s sales.’) 15 U.S.C. § 1117(a). ***The Act does not allow for
5 recovery of profits not attributable to the defendant.***” (Emphasis in original).

6 The Federal Circuit has repeatedly held that a corporation must accept both the benefits
7 and the consequences of its structure, one significant consequence being preclusion from claiming
8 an affiliate’s lost profits in utility patent infringement cases. In *Poly-America, L.P. v. GSE Lining
9 Technology, Inc.*, 383 F.3d 1303, 1311 (Fed. Cir. 2004) (citing *General Motors Corp. v. Devex
10 Corp.*, 461 U.S. 648, 654 (1983)), the Federal Circuit held that the patentee was not entitled to
11 claim the alleged lost profits of its sister corporation, despite the fact that both the patentee and the
12 sister corporation were wholly owned by the same corporate parent. Similarly, in *Mars, Inc. v
13 Coin Acceptors, Inc.*, 527 F.3d 1359, 1367 (Fed. Cir. 2008), the Federal Circuit rejected the parent
14 patentee’s assertion that its subsidiary’s lost profits are, by virtue of the corporate relationship,
15 inherently its lost profits.

16 So too here. STA and SEA are corporate entities distinct from SEC. STA and SEA each
17 made certain profits from the sale of certain accused products in accordance with an agreement
18 blessed by the federal government. SEC also made certain profits from selling those products to
19 STA and SEA, which then sold them in the United States. That STA and SEA *could* have made
20 more profits, and SEC *could* have made less profits, if the transfer pricing arrangement blessed by
21 the federal government had been different, is irrelevant. Absent an *alter ego* or veil piercing
22 theory that Apple has never pled or articulated (undoubtedly, because it knows it could not sustain
23 any such theory), it should not be permitted to argue to the jury that STA’s and SEA’s profits
24 should be artificially inflated by attributing to them the profits of a separate corporate entity, SEC.

25 For these reasons, the Court should preclude Apple from: (a) referencing Samsung’s
26 overall revenues, profits, wealth or value in front of the jury; (b) suggesting to the jury that
27 Samsung has avoided U.S. taxation or paid less U.S. taxes or foreign taxes than it should have; or
28

1 (c) suggesting or arguing to the jury that it should deem STA's and SEA's profits to be higher than
2 they actually were.

3 **J. Unopposed Motion# 10: Exclude Evidence and Argument that Apple is**
4 **Presently Licensed to the Declared Essential Patents-in-Suit**

5 The Court previously rejected as a matter of law Apple's counterclaim defense that it has
6 an existing license to Samsung's asserted declared essential patents. (Dkt. No. 920 at 19-21.) In
7 doing so, the Court ruled explicitly: "Apple's theory that it has an existing license of Samsung's
8 Declared-Essential Patents is implausible, and Apple may not proceed under this theory." (*Id.* at
9 21.) Recently, at the hearing on the parties' motions for summary judgment, Apple represented to
10 the Court that Apple was going to assert the dismissed claim, stating that, "We have a
11 license." (Dkt. Nos. 1164-65 (6/21/12 Hr'g Tr. at 25:17-23.) Because Apple's automatic
12 licensing defense has been dismissed, it is now the law of the case, and any and all evidence or
13 argument that Apple is presently licensed to the declared essential patents-in-suit should be
14 excluded. *Mennick v. Smith*, 459 F. App'x 649, 651 (9th Cir. 2011) (holding that "a court is
15 generally precluded from reconsidering an issue that has already been decided by the same court,
16 or a higher court in the identical case." (quoting *United States v. Alexander*, 106 F.3d 874, 876
17 (9th Cir. 1997))).

18 On the afternoon of this filing, Apple indicated it would not oppose this motion.
19 (D'Amato Decl. Ex. X (7/5/2012 E-Mail from A. Tucker) at 1.)

20
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