

1 HAROLD J. MCELHINNY (CA SBN 66781)
 hmcclhinny@mofocom
 2 MICHAEL A. JACOBS (CA SBN 111664)
 mjacobs@mofocom
 3 RICHARD S.J. HUNG (CA SBN 197425)
 rhung@mofocom
 4 MORRISON & FOERSTER LLP
 425 Market Street
 5 San Francisco, California 94105-2482
 Telephone: (415) 268-7000
 6 Facsimile: (415) 268-7522

WILLIAM F. LEE (*pro hac vice*)
 william.lee@wilmerhale.com
 WILMER CUTLER PICKERING
 HALE AND DORR LLP
 60 State Street
 Boston, Massachusetts 02109
 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

Attorneys for Plaintiff and
 Counterclaim-Defendant Apple Inc.

**UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 SAN JOSE DIVISION**

14 APPLE INC., a California corporation,
 15
 Plaintiff,
 16
 vs.
 17 SAMSUNG ELECTRONICS CO., LTD., a
 Korean business entity, SAMSUNG
 18 ELECTRONICS AMERICA, INC., a New
 York corporation, and SAMSUNG
 19 TELECOMMUNICATIONS AMERICA,
 LLC, a Delaware limited liability company,
 20
 Defendants.
 21
 SAMSUNG ELECTRONICS CO., LTD., a
 22 Korean business entity, SAMSUNG
 ELECTRONICS AMERICA, INC., a New
 23 York corporation, and SAMSUNG
 TELECOMMUNICATIONS AMERICA,
 24 LLC, a Delaware limited liability company,
 25
 Counterclaim-Plaintiffs,
 26
 v.
 27 APPLE INC., a California corporation,
 28
 Counterclaim-Defendant.

Civil Action No. 11-CV-01846-LHK

**APPLE INC.'S MOTION TO STRIKE
 EVIDENCE NOT DISCLOSED AS
 REQUIRED BY PATENT LOCAL RULE
 4-3(b)**

Hearing: TBD
 Time: TBD

PUBLIC REDACTED VERSION

1 **STATEMENT OF ISSUES TO BE DECIDED**

2 Whether the Court should strike certain portions of Samsung’s claim construction
3 submissions that contain or rely upon evidence that Samsung did not disclose in the parties’ Joint
4 Statement as required by Patent Local Rule 4-3(b) and the Court’s Case Management Order.
5

6 **MEMORANDUM OF POINTS AND AUTHORITIES**

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8 **I. FACTUAL BACKGROUND**

9 Patent Local Rule 4-3(b) and the Court’s Case Management Order required Apple and
10 Samsung to submit a Joint Claim Construction and Prehearing Statement (“Joint Statement”) on
11 November 14, 2011 that set forth “all references” and “any extrinsic evidence” on which each
12 party intends to rely to support its proposed claim constructions or to oppose the other party’s
13 proposed constructions. With respect to the disputed claim term “applet,”¹ Apple cited twelve
14 pieces of intrinsic and extrinsic evidence in the Joint Statement in support of its proposed
15 construction. See Joint Statement (Dkt. 394-A) at 12-13. Samsung cited only the ‘711 patent
16 itself and the 2004 Wiley Electrical and Electronic Engineering Dictionary (without providing a
17 specific page number from that 896-page dictionary). *Id.* at 12.
18

19
20 Two weeks later, on November 28, Samsung served the declaration of its claim
21 construction expert, Joe Tipton Cole, who relied upon extensive evidence not listed in the Joint
22 Statement in support of Samsung’s proposed construction of “applet.” Through Mr. Cole’s
23 declaration, Samsung introduced 22 *new pieces of evidence* (in 10 exhibits), none of which was
24 disclosed by Samsung in the Joint Statement:

- 25
- 26 • Excerpts from the file history of the ‘711 patent, including U.S. Pat. No. 7,123,945 (Cole Declaration Ex. 2);

27 ¹ The term “applet” appears in asserted claims 1, 9, and 17 of U.S. Patent No. 7,698,711
28 (the “‘711 patent”).

- 1 • [REDACTED] (Cole Declaration Exs. 3 and 4);
- 2
- 3 • a page from memidex.com which purportedly shows a composite search result on
- 4 the meaning of “applet” from various online dictionaries and reference sites,
- 5 including Wikipedia, Encarta Dictionary, Cambridge Dictionary, Oxford
- 6 Dictionary, Macmillan British Dictionary, Merriam-Webster Dictionary,
- 7 American Heritage Dictionary, Random House Dictionary, Wiktionary and New
- 8 World Dictionary (Cole Declaration Ex. 6);
- 9 • seven web pages (from techimo.com, codeproject.com, pctools.com,
- 10 realgeek.com, forums.windrivers.com, geekgirls.com and freewarefiles.com)
- 11 purportedly discussing the use of applets in the Microsoft Control Panel tools and
- 12 environment (Cole Declaration Ex. 7);
- 13 • five additional web pages (from managingosx.wordpress.com, fm.geckotribe.com,
- 14 applefritter.com, macscripter.net and mactipsandtricks.com) purportedly
- 15 discussing applets in the context of AppleScript (Cole Declaration Ex. 8);
- 16 • three web pages (from linux.softpedia.com, pygtk.org and ubuntuforums.org)
- 17 purportedly discussing the use of applets in the Linux environment (Cole
- 18 Declaration Ex. 9);
- 19 • a page from justskins.com purportedly discussing the use of applets in the Ruby
- 20 programming language (Cole Declaration Ex. 10);
- 21 • a page from scripts.top4download.com purportedly discussing the use of applets
- 22 in the Flash programming language (Cole Declaration Ex. 11); and
- 23 • a page from www-personal.umich.edu purportedly discussing programming
- 24 designed to overcome Java security restrictions (Cole Declaration Ex. 12).

25 Cole Declaration, ¶¶ 13-15, 17-23, 35-37, 39-42, 45-46, 51-57 and 64-65 and Exs. 2-4 and 6-12.²

26 [REDACTED]

27 [REDACTED]

28 [REDACTED] See Deposition of Joe Tipton Cole

(“Cole Dep.”) at 43:3-12 (Selwyn Dec. Ex. A).³

By letter dated December 5, 2011, Apple informed Samsung that its untimely disclosure of supporting claim construction evidence violated the Court’s scheduling order and the Patent

² The Cole Declaration is attached as Ex. 4 to the Declaration of Brett Arnold in Support of Samsung's Administrative Motion to File Documents Under Seal (Dkt. 468-6).

³ Citations to “Selwyn Dec. Ex. ___” refer to the Declaration of Mark D. Selwyn in Support of Apple’s Motion to Strike and the exhibits thereto.

1 Local Rules and prejudiced Apple. *See* Dec. 5, 2011 Letter from Bethany Stevens to Todd
2 Briggs (Selwyn Dec. Ex. B). Apple requested that Samsung (1) withdraw those portions of Mr.
3 Cole’s declaration that rely upon the late-disclosed evidence and (2) confirm that it would not
4 rely upon that newly disclosed evidence in its upcoming *Markman* briefing. *Id.* Samsung never
5 responded to this letter, and instead relied extensively on Mr. Cole’s declaration and the late-
6 disclosed evidence in its Opening Claim Construction Brief. *See* Samsung’s Opening Claim
7 Construction Brief (Dkt. 466-1) at 14-15.

9 Samsung’s untimely disclosure has prejudiced Apple’s ability to respond fully to
10 Samsung’s claim construction arguments. Because Samsung waited to disclose its new
11 supporting evidence until after Apple’s expert, Professor Tony Givargis of the University of
12 California, Irvine, had submitted his declaration in support of Apple’s proposed construction,
13 Apple’s expert was unable to address this evidence (and the arguments made by Samsung and its
14 expert based on this evidence) in his declaration. Given Samsung’s clear, unexcused violation of
15 the Patent Local Rules and the resulting prejudice to Apple, Apple requests that the Court strike
16 the late-disclosed evidence and those portions of Samsung’s opening claim construction brief
17 that rely upon these materials.

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20 **II. ARGUMENT**

21 The Patent Local Rules dictate when and how parties must disclose evidence in support
22 of their proposed claim constructions. Patent Local Rule 4-3(b) requires parties to identify in the
23 Joint Statement “all references from the specification or prosecution history that support that
24 construction,” and “any extrinsic evidence known to the party on which it intends to rely either
25 to support its proposed construction or to oppose any other party’s proposed construction.”
26 These rules are designed to ensure that the parties “crystallize their theories of the case early in
27
28

1 the litigation and to adhere to those theories once they have been disclosed.” *Atmel Corp. v.*
2 *Info. Storage Devices, Inc.*, No. C 95-1987 FMS, 1998 WL 775115, at *2 (N.D. Cal. Nov. 5,
3 1998). The timely disclosure of such evidence is essential to identifying the issues and focusing
4 the claim construction process. *See Pulse Engineering, Inc. v. Mascon, Inc.*, No. 08CV0595 JM
5 (AJB), 2009 WL 250058 (S.D. Cal. Feb. 3, 2009) (“Under Patent L.R. 4, parties must provide
6 adequate and timely disclosure of extrinsic evidence they will rely on during claim construction
7 hearings. This requirement serves to focus the issues, not only for the parties but also for the
8 court.”). As such, untimely disclosures in violation of Patent Local Rule 4-3 may be stricken by
9 the Court. *See Nordic Naturals, Inc. v. J.R. Carlson Laboratories, Inc.*, No. C 07-2385 PJH,
10 2008 WL 2357312, at *11 (N.D. Cal. June 6, 2008) (striking late-disclosed declaration filed “in
11 violation of Patent Local Rules 4-2 and 4-3”).
12

13
14 Despite the Court’s clear rule requiring disclosure in the Joint Statement of all evidence
15 that a party intends to rely upon for purposes of claim construction, Samsung identified 22 new
16 pieces of evidence in support of its proposed construction two weeks after the filing of the Joint
17 Statement, and relies upon this late-disclosed evidence in its opening claim construction brief.
18 Not only does this violate Patent Local Rule 4-3(b), but it prejudiced Apple because by the time
19 of Samsung’s untimely disclosure, Apple’s expert had already submitted his declaration in
20 support of Apple’s proposed construction. Therefore, Professor Givargis was unable to address
21 this new evidence (and the arguments advanced by Samsung and Mr. Cole based on this
22 evidence) in his expert report.
23

24 Nor should the Court excuse this late disclosure by Samsung for good cause. [REDACTED]

25 [REDACTED]
26 [REDACTED]
27 [REDACTED] (Cole Dep. at 43:3-12 (Selwyn Dec.
28

1 Ex. A)) – even though (1) the parties have been on notice of the deadlines for exchanging their
2 proposed claim constructions and supporting evidence since late August, and (2) Samsung had
3 been on notice of Apple’s proposed construction and supporting evidence since October 31.

4 As a result of Samsung’s violation of Patent Local Rule 4-3(b) and the Court’s Case
5 Management Order, the Court should strike the late-disclosed evidence and those portions of
6 Samsung’s opening claim construction brief that rely upon these materials. *See Nordic Naturals*,
7 2008 WL 2357312, at *11 (striking late-disclosed extrinsic evidence); *see also See Genentech*,
8 *Inc. v. The Trustees of the University of Pennsylvania*, No. 10-CV-02037-LHK, 2011 WL
9 866599 (N.D. Cal. Mar. 10, 2011) (denying motion to exclude late-disclosed evidence but
10 allowing moving party additional time to file responsive brief).
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13 **III. CONCLUSION**

14 For the foregoing reasons, Apple requests that the Court strike paragraphs 13-15, 17-23,
15 35-37, 39-42, 45-46, 51-57 and 64-65 of the Cole Declaration, Exhibits 2-4 and 6-12 of the Cole
16 Declaration, and Section V.B.1, paragraphs 4-6 of Samsung’s Opening Claim Construction
17 Brief.
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1 Dated: December 22, 2011

/s/ Mark D. Selwyn
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

7 William F. Lee (admitted *pro hac vice*)
(william.lee@wilmerhale.com)
8 WILMER CUTLER PICKERING
9 HALE AND DORR LLP
60 State Street
10 Boston, Massachusetts 02109
Telephone: (617) 526-6000
11 Facsimile: (617) 526-5000

12 Harold J. McElhinny (SBN 66781)
(HMcElhinny@mofocom)
13 Michael A. Jacobs (SBN 111664)
(MJacobs@mofocom)
14 Richard S.J. Hung (CA SBN 197425)
rhung@mofocom
15 MORRISON & FOERSTER LLP
425 Market Street
16 San Francisco, California 94105
Telephone: (415) 268-7000
17 Facsimile: (415) 268-7522

19 Attorneys for Plaintiff and
20 Counterclaim-Defendant Apple Inc.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on December 22, 2011 to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Civil Local Rule 5.4. Any other counsel of record will be served by electronic mail, facsimile and/or overnight delivery.

/s/ Mark. D Selwyn _____
Mark D. Selwyn