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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.  
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 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

1 **NOTICE OF MOTION AND MOTION**

2 TO THE PARTIES AND THEIR ATTORNEYS OF RECORD:

3 PLEASE TAKE NOTICE THAT at a date and time to be set by the Court, Plaintiff and  
4 Counterclaim-Defendant Apple Inc. (“Apple”) shall and hereby does move for an order striking  
5 paragraphs 13-15, 17-23, 35-37, 39-42, 45-46, 51-57 and 64-65 of the Declaration of Joe Tipton  
6 Cole in Support of Samsung’s Proposed Claim Construction for U.S. Patent No. 7,698,711  
7 (“Cole Declaration”), Exhibits 2-4 and 6-12 of the Cole Declaration, and Section V.B.1,  
8 paragraphs 4-6 of Samsung’s Opening Claim Construction Brief, on the grounds that these  
9 portions of Samsung’s claim construction submissions contain or rely upon evidence that  
10 Samsung did not disclose in the parties’ Joint Claim Construction and Prehearing Statement as  
11 required by Patent Local Rule 4-3(b) and the Court’s Case Management Order.  
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14 This motion is based on this notice of motion and accompanying memorandum of points  
15 and authorities in support thereof, the Declaration of Mark D. Selwyn, and any other matters  
16 properly before the Court.  
17

18 **RELIEF REQUESTED**

19 Apple seeks an Order striking: (1) paragraphs 13-15, 17-23, 35-37, 39-42, 45-46, 51-57  
20 and 64-65 of the Cole Declaration; (2) Exhibits 2-4 and 6-12 of the Cole Declaration; and (3)  
21 Section V.B.1, paragraphs 4-6 of Samsung’s Opening Claim Construction Brief.

22 Apple also respectfully requests that the Court grant Apple’s Motion to Shorten Time for  
23 Briefing and Hearing on Apple’s Motion to Strike, submitted concurrently herewith, together  
24 with the accompanying Declaration of Mark D. Selwyn in Support of Apple’s Motion to Shorten  
25 Time.  
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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,”<sup>1</sup> 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 <sup>1</sup> The term “applet” appears in asserted claims 1, 9, and 17 of U.S. Patent No. 7,698,711  
28 (the “‘711 patent”).

- 1 • Deposition testimony and documentary evidence from the named inventor of the  
2 ‘711 patent (Cole Declaration Exs. 3 and 4);
- 3 • a page from [memidex.com](http://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](http://techimo.com), [codeproject.com](http://codeproject.com), [pctools.com](http://pctools.com),  
10 [realgeek.com](http://realgeek.com), [forums.windrivers.com](http://forums.windrivers.com), [geekgirls.com](http://geekgirls.com) and [freewarefiles.com](http://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](http://managingosx.wordpress.com), [fm.geckotribe.com](http://fm.geckotribe.com),  
14 [applefritter.com](http://applefritter.com), [macscripter.net](http://macscripter.net) and [mactipsandtricks.com](http://mactipsandtricks.com)) purportedly  
15 discussing applets in the context of AppleScript (Cole Declaration Ex. 8);
- 16 • three web pages (from [linux.softpedia.com](http://linux.softpedia.com), [pygtk.org](http://pygtk.org) and [ubuntuforums.org](http://ubuntuforums.org))  
17 purportedly discussing the use of applets in the Linux environment (Cole  
18 Declaration Ex. 9);
- 19 • a page from [justskins.com](http://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](http://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](http://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.<sup>2</sup>

26 During his deposition, Mr. Cole candidly acknowledged that Samsung did not even ask him to  
27 begin searching for references in support of Samsung’s proposed construction until November  
28 21, a week *after* the parties submitted the Joint Statement. *See* Deposition of Joe Tipton Cole  
29 (“Cole Dep.”) at 43:3-12 (Selwyn Dec. Ex. A).<sup>3</sup>

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

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

34 <sup>3</sup> Citations to “Selwyn Dec. Ex. \_\_\_” refer to the Declaration of Mark D. Selwyn in Support  
35 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  
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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”).  
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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. Samsung  
25 did not ask its expert to search for evidence in support of Samsung’s proposed construction until  
26 November 21, a week *after* the filing of the Joint Statement (Cole Dep. at 43:3-12 (Selwyn Dec.  
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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

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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