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15 LTD., SAMSUNG ELECTRONICS AMERICA,
16 INC. and SAMSUNG
TELECOMMUNICATIONS AMERICA, LLC

17 UNITED STATES DISTRICT COURT

18 NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

19
20 APPLE INC., a California corporation,

21 Plaintiff,

22 vs.

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

27 Defendant.

CASE NO. 11-cv-01846-LHK

**SAMSUNG'S STATEMENT
IDENTIFYING CLAIMS IT WILL
ASSERT AT TRIAL**

1 Pursuant to the Court's instructions at the May 2, 2012 Case Management Conference and
2 the minute order issued today, Samsung submits this statement identifying the claims it will assert
3 at trial.

4 **I. SAMSUNG'S POSITION**

5 Unable to compete in the marketplace, Apple is instead seeking to compete through
6 litigation, requesting injunctions against the full lineup of Samsung's mobile phones and tablet
7 products. Against Samsung's remarkably successful products and innovative, independently
8 developed technologies, Apple has only been able to muster utility patents covering extremely
9 minor user interface features, and design patents and trade dresses that offer far narrower
10 protection than Apple urges. Apple has never connected the success of Samsung's products with
11 the alleged infringement of its design or utility patent rights. Unable to succeed on any
12 manageable subset of these claims, Apple's only choice is to assert far more intellectual properties
13 than can be reasonably adjudicated in one trial, including by continuing to assert a patent (the '607
14 patent) which was declared invalid by the International Trade Commission.

15 Thus, Apple has still refused to adequately narrow the case pursuant to the Court's prior
16 requests. Despite the Court's explicit instructions that, if Apple wants an expedited trial, it must
17 narrow the case significantly such that a jury can reasonably hear it in the 25 hours allotted per
18 side, Apple intends to press forward with the vast majority of its extensive utility patent, design
19 patent, and trade dress claims. Apple also still intends to assert antitrust claims for each of
20 Samsung's standards-related patents.

21 In essence, Apple has "narrowed" its case from five distinct trials—on utility patent
22 infringement, design patent infringement, trademark, trade dress, and antitrust—to four. And
23 Apple has never indicated it is willing to withdraw infringement claims against *any* of the 31
24 Samsung products it accuses. Apple has not crafted a case that any one jury could be expected to
25 adjudicate properly.

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1 **A. Apple Has Not Meaningfully Reduced The Scope Of Its Case**

2 1. Apple Has Not Narrowed Its Extensive Design Case

3 Apple has not narrowed its design case in any material way for an expedited trial, and
4 certainly not sufficiently that would allow it to be tried in fifty hours for both sides. Apple’s case
5 would not be triable even if no utility patents were at issue. Despite this Court’s directive to
6 narrow its case for expedited trial, Apple is still asserting many dozens of combinations of ten
7 alleged soft IP assets (both hardware and user interface), spanning seven claimed commercial
8 embodiments, against numerous Samsung products. And because Apple accuses many of those
9 Samsung products of infringing or diluting several assets, the Court, the parties and the jury will
10 have to make over 125 product to claimed soft IP asset comparisons. Apple’s “narrowed” design
11 patent and trade dress case *alone* is unmanageable for an expedited trial where 25 hours has been
12 allotted to each side.

13 More specifically, Apple’s “narrowed” design patent case has dropped only two of its
14 seven design patents and done so in a manner that does little or nothing to streamline the case for
15 trial. Apple still asserts that various combinations of at least fourteen Samsung products infringe
16 five design patents (including two embodiments of the D’087 patent) that purport to cover both the
17 external hardware and user interface of iPhone and iPad devices, as demonstrated in the following
18 table.¹

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Apple Design Patent	Number of Samsung Accused Products
D'677	13
D'087 (embodiment 2)	13
D'087 (embodiment 3)	13
D'334	13
D'305	13
D'889	1
Total Comparisons	66

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25 ¹ See Apple’s Second Amended Objections and Response to Samsung’s Interrogatory No. 5,
26 at pp. 2-3; Apple's Objections and Responses to Samsung's Frouth Set of Interrogatories, 99-110.
27 Samsung does not agree that all of the devices asserted by Apple are appropriately or timely
28 accused but for purposes of the present analysis uses Apple’s own statements about the scope of
its case.

1 Thus, the Court, the parties and the jury will be required to make at least 66 Samsung
2 product to design patent comparisons just for the infringement analysis of the design patent claims
3 under Apple's allegedly “narrowed” trial presentation. Furthermore, Samsung has obviousness,
4 anticipation, functionality, indefiniteness and other invalidity defenses against each of these
5 patents that must be the subject of documentary evidence, and percipient and expert witness
6 testimony.

7 Apple then adds on top of this an ostensibly “narrowed” trade dress case that asserts
8 dilution of five separate unregistered and registered phone and tablet trade dress combinations that
9 include the entirety of Apple’s external hardware and user interface. For phones, Apple has
10 defined three trade dresses (the '983 registration and two unregistered combinations) as used in
11 five commercial iPhone embodiments. According to Apple, these unregistered iPhone trade dress
12 combinations consist of the “original” iPhone trade dress and the iPhone 3G trade dress. *See, e.g.,*
13 *Expert Report of Russell Winer*, at pp. 3-4. Apple’s expert, Robert Winer, has made clear that
14 Apple’s unregistered trade dress claims rely not just on the “overall look and feel” of the
15 ostensible trade dress, but on Samsung’s alleged “misappropriation” of the “constituent elements
16 of the trade dress[es],” which Apple claims creates an “accretive effect” that “magnifies the
17 diminution” of its alleged trade dresses. *Id.* at p. 71. Here, these “constituent elements” that
18 Apple asserts include six sweeping elements of hardware and interface combinations for the
19 unregistered “combination” iPhone trade dress, and another eight elements of hardware and
20 interface combinations for the unregistered iPhone 3G trade dress. Apple then asserts that various
21 combinations of 17 Samsung products infringe these registered and unregistered trade dress
22 combinations.² All told, the Court, the parties and the jury will have to make 51 Samsung product
23 to trade dress comparisons just for the phone trade dress dilution claims and just for the dilution
24 analysis alone. Of course, comparing Samsung’s to Apple’s alleged trade dress on an element-by-

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27 ² Apple has accused 17 products of diluting each of its two unregistered trade dress
28 combinations and 17 products of diluting its claimed registered trade dress. *See, e.g.,* Apple’s
Objections and Responses to Samsung’s Fourth Set of Interrogatories, at pp. 68-70.

1 element basis, as Apple also claims for its dilution theory, would require hundreds of element to
 2 accused product comparisons. Furthermore, Samsung has functionality and other invalidity and
 3 non-dilution defenses against each of these purported trade dress combinations.

4 Finally, Apple adds on top of all of this further claims for both dilution and infringement of
 5 Apple’s purported iPad and iPad 2 trade dress combinations. According to Apple, each of the
 6 iPad and iPad 2 trade dress combinations has six elements, and Apple accuses four Samsung
 7 products of both infringing and diluting these trade dress combinations. *See, e.g.*, Apple’s
 8 Objections and Responses to Samsung’s Fourth Set of Interrogatories, at pp. 71; Expert Report of
 9 Russell Winer, at p. 6. As a result, the Court, the parties and the jury will be required to make yet
 10 another 8 product to trade dress comparisons, or 48 element-by-element comparisons, just for
 11 these iPad-related claims and just for infringement and dilution analysis purposes alone. In
 12 addition, Samsung has functionality, non-distinctiveness and other invalidity and merits defenses
 13 against each of these purported trade dress combinations.

14 All told, for its trade dress claims and even in addition to its design patent claims, Apple is
 15 seeking to try five trade dress combinations that will require the Court, the parties and the jury to
 16 make at least 59 allege trade dress to product comparisons (and almost 300 such comparisons if
 17 done element be element). To show the still substantial scope of all of this, Apple’s “narrowed”
 18 trade dress claims are summarized in the following table:

Apple Trade Dress	Number of “Constituent Elements” Claimed by Apple	Trade Dress to Samsung Product Comparisons	Trade Dress Element to Samsung Product Comparisons
'983 Registration	-	17	-
Combination iPhone Trade Dress	6	17	102
iPhone 3G Trade Dress	8	17	136
iPad Trade Dress	6	4	24
iPad2 Trade Dress	6	4	24
	Total Phone	51	238
	Total Tablet	8	48
	Grand Total	59	286

1 Apple's decision to proceed on dilution, and not infringement, of the iPhone trade dress
2 combinations does nothing to narrow trial as a practical matter. Apple is still asserting both
3 infringement and dilution of the alleged iPad trade dress combinations, so the jury must be
4 instructed on and deliberate about infringement, and the parties will have to present evidence on
5 infringement as a result. Furthermore, much of the same evidence and all of the same witnesses
6 will still have to be presented at trial for Apple's phone trade dress dilution claim, even if it drops
7 infringement for trial. This is because many of the factors for infringement overlap with dilution.
8 For example, evidence regarding the distinctiveness of trade dress (or lack thereof) is usually
9 relevant to the requirement dilution element of fame, and evidence regarding the similarity of the
10 trade dress to the accused product is relevant to the required dilution element that the accused
11 product be identical or virtually identical to the claimed trade dress. *E.g., Avery Dennison Corp. v.*
12 *Sumpton*, 189 F.3d 868, 876 (9th Cir. 1999) ("We note the overlap between the statutory
13 famousness considerations [for dilution] and the factors relevant to establishing acquired
14 distinctiveness").³ Indeed, Apple's expert's analysis expressly relies on many same claimed facts
15 for trade dress dilution as he does for infringement. *E.g., Expert Report of Russell Winer*, at pp.
16 12-37 (relying on same alleged evidence for famousness under dilution and for distinctiveness
17 under infringement), p. 68-69 (relying on same facts for similarity of phone trade dress and
18 association in dilution as for infringement), p. 69 (relying on same facts for exclusivity of use for
19 dilution of phone trade dress as for infringement), p. 69 (relying on same facts for intent of junior
20 user for dilution of phone trade dress as for infringement), pp. 69-71 (relying on same facts for
21 actual association for dilution of phone trade dress as for infringement), pp. 71-74 (relying on
22 same facts for dilution of iPad/iPad 2 trade dress as for infringement). In short, Apple's professed
23 abandonment of its infringement claim for phones (but not computer tablets), while still
24 proceeding on dilution, will not narrow trial in any meaningful way.

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³ While the standard for fame is higher than distinctiveness, evidence that a trade dress is not distinctive necessarily also tends to show that it is not famous. *See id.*

2. Apple Has Not Sufficiently Narrowed Its Utility Case When Considered With Its Design Case

Apple has not sufficiently narrowed its utility patent case in a way that would allow it to be tried in the 50 hours allotted for both sides. Apple’s claim that it reduced its utility case in half is based on a meaningless metric. Utility patents have always been a small subset compared to Apple’s vast design case, of close to 30 different IP assets.

Apple has agreed to remove four of its eight patents and move forward at trial on its ‘381, ‘915, ‘607 and ‘163 patents. However, there are numerous non-infringement and invalidity issues that will be tried with respect to each of these patents regardless of the number of claims that Apple asserts for each patent. Apple accuses up to 31 products of infringing each patent, each product with its own body of source code.⁴ The following chart illustrates the significant scope of Apple’s proposed utility patent case.

Apple Patent	Accused Feature	Accused Products Identified in Apple’s Expert Reports
‘381	Gallery	Captivate; Continuum; Droid Charge; Epic 4G; Exhibit 4G; Fascinate; Galaxy Ace; Galaxy Prevail; Galaxy S (i9000); Galaxy S II (i9100, AT&T, and Epic 4G Touch variants); Galaxy S 4G; Galaxy S Showcase; Galaxy Tab 7.0; Galaxy Tab 10.1; Gravity Smart; Indulge; Infuse 4G; Mesmerize; Nexus S; Nexus S 4G; Replenish; Sidekick; and Vibrant.
‘381	Contacts	Captivate; Continuum; Droid Charge; Epic 4G; Exhibit 4G; Fascinate; Galaxy Ace; Galaxy S (i9000); Galaxy S II (i9100, AT&T, and Epic 4G Touch variants); Galaxy S 4G; Galaxy S Showcase (i500); Gem; Gravity Smart; Indulge; Infuse 4G; Mesmerize; Sidekick; and Vibrant.
‘381	Browser	Exhibit 4G; Galaxy Ace; Galaxy S II (i9100, AT&T, and Epic 4G Touch variants); Galaxy Tab 7.0; Galaxy Tab 10.1; and Gravity Smart.
‘381	ThinkFree Office	Continuum, Droid Charge, Epic 4G, Exhibit 4G, Fascinate,

⁴ Apple’s contention that there are only “four versions of Samsung’s operating system software” the jury need evaluate is incorrect. There are many more versions of operating system software at issue with respect to Samsung’s products, and Apple must independently prove infringement for each version.

Apple Patent	Accused Feature	Accused Products Identified in Apple's Expert Reports
		Galaxy Ace, Galaxy Prevail, Galaxy S (i9000), Galaxy S 4G, Galaxy S Showcase, Galaxy Tab 7.0, Indulge, Intercept, Mesmerize, Replenish, and Sidekick.
'915	All applications that involve scroll or gesture operations.	Acclaim, Galaxy S 4G, Galaxy Tab, Galaxy Tab 10.1, Captivate, Continuum, Droid Charge, Epic 4G, Exhibit 4G, Fascinate, Galaxy Ace, Galaxy Prevail, Galaxy S (i9000), Gem, Gravity, Indulge, Infuse 4G, Intercept, Mesmerize, Nexus S, Nexus S 4G, Replenish, Showcase Galaxy S, Sidekick, Transform, Vibrant
'163	Browser	Acclaim, Captivate, Continuum, Droid Charge, Epic 4G, Exhibit 4G, Fascinate, Galaxy Ace, Galaxy Prevail, Galaxy S (i9000), Galaxy S 4G, Galaxy S II (including the i9100, T-Mobile, AT&T, Epic 4G Touch and Skyrocket variants), Galaxy S Showcase (i500), Galaxy Tab 7.0, Galaxy Tab 10.1, Gem, Gravity Smart, Indulge, Infuse 4G, Intercept, Mesmerize, Nexus S, Nexus S 4G, Replenish, Sidekick, Transform, and Vibrant.
'607	Touchscreen circuitry ⁵	Tab 7.0 and Tab 10.1

As demonstrated by the table above, trial on Apple's four patents alone will necessarily require the jury to compare the claims of four different Apple patents to scores of Samsung products and different software and hardware features within those products. For example, the '915 patent will require an in-depth understanding of object-oriented programming and source code, whereas the '607 patent will require an in-depth understanding of touchscreen hardware technology, including an understanding of capacitive touchscreens, virtual ground charge amplifier circuitry, and scanning electron microscopy technology.

Furthermore, significant disputes remain with respect to each of Apple's patents. The meaning of the term "invoke" as used in the claims of the '915 patent is central to a determination of non-infringement. The term "substantially centered" as used in the claims of the '163 patent will also require construction (if it is not deemed indefinite) as Apple's expert has taken the position that a document that is aligned with the left or right side of a display is somehow "substantially centered." With respect to the '607 patent, there are significant disputes with

⁵ The touchscreen circuitry in the Tab 7.0 and Tab 10.1 is different and raises different claim construction and non-infringement issues for each product.

1 respect to the following terms: “conductive lines” (whether a conductive “line” needs to have a
2 substantially constant width or can include irregular patterns and shapes), “configured to detect
3 changes in charge coupling between the first conductive lines and the second conductive lines”
4 (whether this limitation requires the detection of charge coupling between all the first lines and all
5 the second lines or can include configurations where one transmit line is driven and all the receive
6 lines are sensed), and “virtual ground charge amplifier” (whether this is a term of art and the
7 precise circuitry that is encompassed by this term). With respect to the ‘381 patent, the parties
8 have significant disputes regarding the meaning of the term “electronic document” (whether a list
9 of items is an electronic document) and “beyond the edge” (whether a background layer
10 underneath a scrolled document is beyond the edge). And although the Court recently construed
11 the meaning of “edge of electronic document,” Apple is attempting to circumvent this order by
12 reading out internal edges that purportedly do not surround “internal electronic documents.”
13 There are also disputes relating to the application of the Court’s construction of the ‘381 patent’s
14 claims from its Preliminary Injunction Order. Specifically, the parties dispute the application of
15 the requirement that an electronic document “always” bounce back to the accused Samsung
16 products and the prior art.

17 3. Apple's Alleged “Reduction” Does Not Materially Reduce the Number of
18 Witnesses

19 A trial under Apple’s current proposal will require testimony from only two fewer experts
20 than its May 1 proposal. Only Apple’s expert Alex Snoeren (for the ’002 utility patent) and
21 Samsung’s expert Trevor Darrell (for the ’002 and ’891 utility patents) would not have to testify.
22 Apple would present eleven utility, design, and damages experts only to meet its burden. To
23 adequately respond to Apple’s claims, Samsung will need to present fourteen utility, design, and
24 damages experts. Apple would then have to re-call at least seven experts to rebut Samsung’s
25 defenses and present its antitrust claims. Plainly, the testimony of *thirty-two* experts, and a
26 considerable number of fact witnesses, only to address Apple’s affirmative case, will run far
27 beyond the limits the Court has imposed.
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1 4. Apple Is Not Fully Dropping the Claims as the Court Requires

2 In its submission, Apple proposed, for the first time, bifurcating the remaining claims and
3 having them tried in a bench trial immediately following the jury trial. Apple’s proposal does
4 nothing to alleviate the burden on this Court of resolving the parties’ dispute. To the contrary,
5 Apple adds to the Court’s burden, requesting the Court hear its extensive claims after almost a
6 month of presiding over a jury trial. Apple already made this proposal at the last Case
7 Management Conference, and the Court expressly stated that if Apple wanted multiple staged
8 trials, it would need to find some other forum to bring its case.

9 If Apple wishes to move forward with the trial date as currently set by the Court, it should
10 be required to dismiss its additional claims with prejudice. Samsung is willing to dismiss its
11 claims with prejudice, but cannot agree to do so while Apple maintains that its dropped claims are
12 “ripe for trial.”

13 **B. Samsung Has Significantly Reduced The Scope Of Its Case**

14 Unlike Apple, Samsung is willing to make significant and meaningful reductions in the
15 number of claims it asserts. Samsung will proceed to trial on fifteen claims from seven patents.
16 With these reductions, Samsung has narrowed its case from twelve patents to seven, dropping
17 42% of its affirmative counterclaims. From a total of 75 claims identified by Samsung's experts as
18 infringed by Apple's products, Samsung will drop 60 and only proceed on 15—a reduction in total
19 claims of 80%. Samsung’s claims are identified below:

- 20 • U.S. Patent No. 7,675,941 (Claims 10, 11 and 15)
- 21 • U.S. Patent No. 6,928,604 (Claims 17 and 18)
- 22 • U.S. Patent No. 7,447,516 (Claims 15, 16 and 17)
- 23 • U.S. Patent No. 7,362,867 (Claims 25 and 26)
- 24 • U.S. Patent No. 7,698,711 (Claims 9 and 10)
- 25 • U.S. Patent No. 7,577,460 (Claim 1)
- 26 • U.S. Patent No. 7,546,893 (Claims 10 and 12)

27 Samsung agreed to reduce its offensive case by dismissing three of its offensive patents
28 (U.S. Patent No. 7,200,792, U.S. Patent No. 7,386,001, and U.S. Patent No. 7,079,871) in the

1 parties Joint Case Management Statement dated April 30, 2012. (Docket No. 893). Samsung is
2 now willing to drop an additional two patents from its offensive case:

- 3 • U.S. Patent No. 7,050,410
- 4 • U.S. Patent No. 7,069,055

5 Samsung would have been willing to reduce its claims even further. However, in light of
6 Apple's refusal to narrow its case,⁶ and insistence on proceeding with a full range of design patent,
7 trade dress, utility patent, and antitrust claims against over thirty Samsung products, any further
8 reductions in Samsung's case at this time would be highly prejudicial and unfair.

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⁶ Apple's characterization of the parties' meet-and-confer efforts is misleading. It was Samsung who first contacted Apple's counsel right after the CMC on May 2nd to arrange for a meet and confer to discuss narrowing the case. Apple suggested meeting at its offices in the afternoon of Thursday, May 3rd. At that meeting, Apple's counsel stated it could not share any proposal to narrow the case until Saturday. Samsung's counsel asked to have Apple's proposal sooner because it would take Samsung time to analyze and respond to Apple's proposal particularly given the time difference with Korea and the necessity to confer with different teams within Samsung. Samsung received Apple's proposal on Saturday May 5th at 11am (which is 4am in Korea). Samsung worked diligently to complete its second round analysis of reducing its case and notified Apple early afternoon Monday that its portion of the joint statement was forthcoming. In response, Apple indicated that it intended to file its own statement with the Court. Samsung's counsel responded by saying that it was preparing a response and was waiting for client approval to share it with Apple but that the morning had just begun in Korea. Samsung's counsel also told Apple it was improper for Apple to file its own proposal without waiting for Samsung's.

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