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 11 **UNITED STATES DISTRICT COURT**  
 12 **NORTHERN DISTRICT OF CALIFORNIA**  
 13 **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  
 Korean business entity, SAMSUNG  
 22 ELECTRONICS AMERICA, INC., a New  
 York corporation, and SAMSUNG  
 23 TELECOMMUNICATIONS AMERICA,  
 LLC, a Delaware limited liability company,

24 Counterclaim-Plaintiffs,

25 v.

26 APPLE INC., a California corporation,

27 Counterclaim-Defendant.  
 28

Case No. 11-CV-01846-LHK

**PLAINTIFF AND COUNTERCLAIM-  
 DEFENDANT APPLE INC.'S NOTICE OF  
 MOTION AND MOTION FOR  
 SUMMARY JUDGMENT OF NON-  
 INFRINGEMENT OF U.S. PATENT  
 NUMBER 7,362,867 AND INVALIDITY  
 OF U.S. PATENT NUMBERS 7,456,893  
 AND 7,577,460**

Date: June 21, 2012

Time: 1:30 p.m.

Place: Courtroom 4, 5<sup>th</sup> Floor

Judge: Hon. Lucy H. Koh

**ORAL ARGUMENT REQUESTED**

**PUBLIC REDACTED VERSION**

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1 **NOTICE OF MOTION AND MOTION**

2 TO DEFENDANTS SAMSUNG ELECTRONICS CO. LTD., SAMSUNG  
3 ELECTRONICS AMERICA, INC., AND SAMSUNG TELECOMMUNICATIONS  
4 AMERICA, LLC (COLLECTIVELY, "SAMSUNG") AND THEIR COUNSEL OF RECORD:

5 PLEASE TAKE NOTICE that on June 21, 2012, Plaintiff and Counterclaim-Defendant  
6 Apple Inc. ("Apple") shall and hereby does move for an order granting Apple summary  
7 judgment of non-infringement of claims 25 and 26 of U.S. Patent No. 7,362,867 ("the '867  
8 patent") and summary judgment of invalidity of claims 10 and 12 of U.S. Patent No. 7,456,893  
9 ("the '893 patent") and claim 1 of U.S. Patent No. 7,577,460 ("the '460 patent").

10 This motion is based on this notice of motion, the accompanying memorandum of points  
11 and authorities in support thereof, the Declaration of Mark D. Selwyn ("Selwyn Decl.") and  
12 exhibits attached thereto, and such other written or oral argument as may be presented at or  
13 before the time this motion is taken under submission by the Court.

14 **RELIEF REQUESTED**

15 Pursuant to Federal Rule of Civil Procedure 56, Apple seeks an order granting summary  
16 judgment of (1) non-infringement of claims 25 and 26 of the '867 patent; (2) invalidity of claims  
17 10 and 12 of the '893 patent as indefinite; and (3) invalidity of claim 1 of the '460 patent as  
18 indefinite.

19 **STATEMENT OF ISSUES TO BE DECIDED**

20 1. Whether Apple is entitled to summary judgment of non-infringement of the  
21 asserted claims of the '867 patent (claims 25 and 26) where the undisputed facts demonstrate that  
22 that the accused products do not satisfy the limitation requiring a "primary scrambling code" that  
23 is a "Gold code," either literally or under the doctrine of equivalents.

24 2. Whether Apple is entitled to summary judgment of invalidity of the asserted  
25 claims of the '893 patent (claims 10 and 12) as indefinite where the language of the apparatus  
26 claim requires user interaction.



1 [REDACTED] Further, neither Samsung's Infringement Contentions nor its  
2 expert articulate a theory of infringement under the doctrine of equivalents. Accordingly, the  
3 Court should enter summary judgment that Apple does not infringe the asserted claims of the  
4 '867 patent.

5 **B. INVALIDITY OF THE '893 PATENT**

6 The '893 patent is directed to a digital image processing apparatus that, through the use  
7 of modes, allows a user to switch from stored-image display mode, to photographing mode, and  
8 then back to stored-image display mode to view the same image the user was last viewing before  
9 switching from stored-image display mode.

10 Claim 10 is the only independent claim still asserted by Samsung. It is an apparatus  
11 claim that also includes method claim language requiring user action to practice the claim. That  
12 fact is undisputed: [REDACTED]

13 [REDACTED]  
14 Thus, pursuant to the Federal Circuit's ruling in *IPXL Holdings, L.L.C. v. Amazon.com,*  
15 *Inc.*, 430 F.3d 1377 (Fed. Cir. 2005), independent claim 10 and dependent claim 12 are indefinite  
16 because it is unclear whether infringement occurs when one creates an apparatus that *allows* the  
17 user to switch from the stored-image display mode to the photographing mode and back to the  
18 stored-image display mode, or whether infringement occurs only when the user *actually* switches  
19 from the stored-image display mode to the photographing mode and back to the stored-image  
20 display mode.

21 **C. INVALIDITY OF THE '460 PATENT**

22 The '460 patent is generally directed to a data transmitting method for a portable  
23 composite communication terminal. Claim 1 of the '460 patent is insolubly ambiguous on its  
24 face. Based on the plain language of the claim, the specification, and the prosecution history, a  
25 person of ordinary skill in the art would not be able to determine whether the claimed method is  
26 practiced by: (1) sending two separate email messages from two separate email transmission sub-  
27 modes; (2) sending one email message from one email transmission sub-mode if the email has an

1 image attached and sending a different email message from a different email transmission sub-  
2 mode if the email does not have an image attached; or (3) sending one email message from one  
3 email transmission sub-mode only, whereby the email is created by transmitting certain  
4 information to the email transmission sub-mode through a user interface in a different email  
5 transmission sub-mode. [REDACTED]

6 [REDACTED] Moreover, Samsung and its experts have asserted three different  
7 conflicting interpretations of the claim. For all of these reasons, claim 1 is invalid as indefinite.

8 **II. STATEMENT OF UNDISPUTED FACTS**

9 **A. UNDISPUTED FACTS MATERIAL TO THE '867 PATENT**

10 [REDACTED]  
11 [REDACTED]  
12 [REDACTED] and Samsung's Statement Identifying Claims It Will Assert At Trial at 9  
13 (Dkt. 907). Claim 25 is an independent claim from which claim 26 depends.

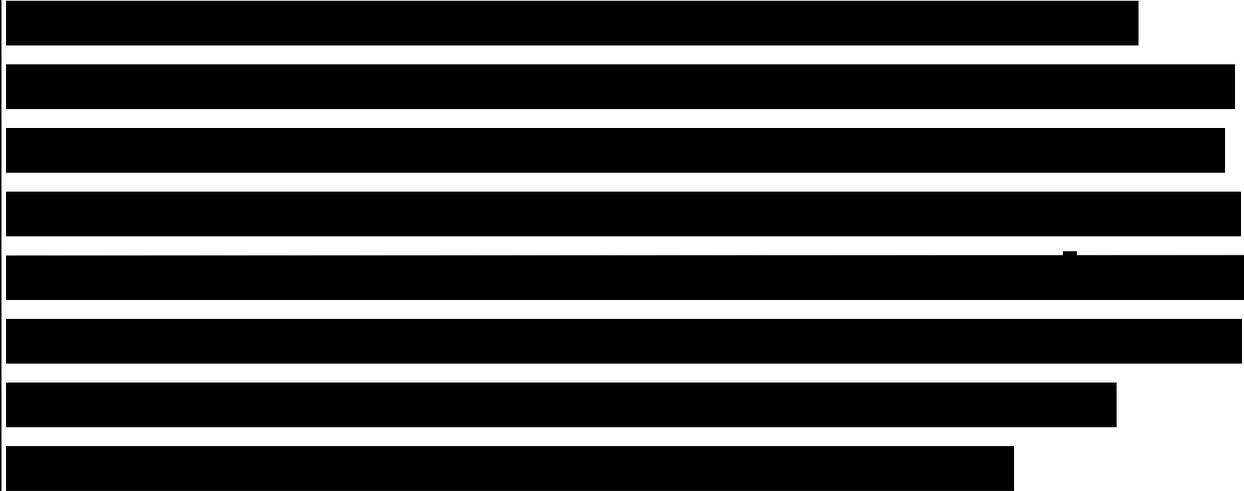
14 Claim 25 is directed to "an apparatus for generating scrambling codes in mobile  
15 communication system having a scrambling code generator." A scrambling code is a numeric  
16 sequence that cell phone systems use to separate communication channels from one another.<sup>2</sup> As  
17 shown in Figures 1 and 3 of the '867 patent, a base station can encode, or "spread," one channel  
18 with a scrambling code and, upon reception, a cell phone can use a corresponding scrambling  
19 code to recover, or "despread," the original signal for that channel.

20 Claim 25 includes an express requirement that the scrambling code be a "Gold code."<sup>3</sup>  
21 The claim requires the code generator to include:

22 \_\_\_\_\_  
23 <sup>2</sup> "As a method for increasing capacity in addition to separation of base stations, which is  
24 the objective of using the scrambling codes in the CDMA system, orthogonal codes for multiple  
25 scrambling code groups are used to separate channels. That is, when all orthogonal codes for  
26 channel separation are used up for a scrambling code group, the mobile communication system  
may utilize a second scrambling code group to increase the number of available communication  
links." '867 patent at 1:29-37 (Selwyn Decl., Ex. 1).

27 <sup>3</sup> A "Gold code" is numeric sequence that can be formed by summing two "Maximal  
28 Length Sequences" ("m-sequences"). See '867 patent at 4:3-4 ("Referring to FIG. 5, a gold

1 “...at least one adder for generating a ((K-1)\*M+K)<sup>th</sup> Gold code as  
2 a K<sup>th</sup> primary scrambling code by adding a (((K-1)\*M+K)-1)-  
3 times shifted first m-sequence and the second m-sequence, wherein  
4 K is a natural number and M is a total number of secondary  
5 scrambling codes per one primary scrambling code.” ‘867 patent,  
6 cl. 25 (Selwyn Decl., Ex. 1).  
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12 The cited portion of the standard relied upon by Samsung includes a mathematical  
13 definition of the scrambling codes required by the standard. It states:

14 The n<sup>th</sup> Gold code sequence  $z_n$ ,  $n=0, 1, 2, \dots, 2^{18}-2$ , is then defined as:

15 -  $z_n(i) = x((i+n) \text{ modulo } (2^{18} - 1)) + y(i) \text{ modulo } 2$ ,  $i=0, \dots, 2^{18}-2$ .

16 These binary sequences are converted to real valued sequences  $Z_n$  by the following transformation:

17 
$$Z_n(i) = \begin{cases} +1 & \text{if } z_n(i) = 0 \\ -1 & \text{if } z_n(i) = 1 \end{cases} \text{ for } i = 0, 1, \dots, 2^{18} - 2.$$

18 Finally, the n<sup>th</sup> complex scrambling code sequence  $S_{n,a}$  is defined as:

19 -  $S_{n,a}(i) = Z_n(i) + j Z_n((i+131072) \text{ modulo } (2^{18}-1))$ ,  $i=0, 1, \dots, 38399$ .

20 Note that the pattern from phase 0 up to the phase of 38399 is repeated.

21 3GPP TS 25.213 v6.0.0 at 23 (emphasis added) (Selwyn Decl., Ex. 6); *see also* Expert Report of  
22 Wayne Stark (“Stark Rep.”) ¶ 51 (Selwyn Decl., Ex. 7).<sup>5</sup>

23 A detailed understanding of this formula is unnecessary to a finding of non-infringement.  
24 As noted above, claim 25 of the ‘867 patent requires the generation of a scrambling code that is a  
25 sequence is normally generated through binary adding to two distinct m-sequences.” (Selwyn  
26 Decl., Ex. 1).

27 <sup>4</sup> The two versions of the standard are identical with respect to the issues in this motion.  
28 <sup>5</sup> *See also* Declaration of Wayne Stark, dated May 16, 2012 (Selwyn Decl., Ex. 8).



1 [REDACTED]

2 [REDACTED]

3 **B. UNDISPUTED FACTS MATERIAL TO THE ‘893 PATENT**

4 Samsung is currently asserting claims 10 and 12 against Apple’s iPhone 3GS, iPhone 4,  
5 iPod Touch 4th generation and iPad 2. *See* Expert Report of Woodward Yang Regarding the  
6 Infringement of U.S. Patent Nos. US 7,577,460, US 7,456,893, US 7,698,711, and US 7,079,871  
7 (“Yang Report”) ¶ 17 (Selwyn Decl., Ex. 9) and Samsung’s Statement Identifying Claims It Will  
8 Assert At Trial at 9 (Dkt. 907).

9 Claim 10 is an independent claim that recites in pertinent part “[a] digital image  
10 processing apparatus comprising: . . . a controller connected with the photoelectric conversion  
11 module, the recording medium and the display screen, the controller being operative in a  
12 photographing mode to process the image data for storage in the recording medium and, in a  
13 stored-image display mode, being operative to control the display screen for displaying a single  
14 image relative to the image data, *wherein upon a user performing a mode-switching operation*  
15 *defined by switching from the stored-image display mode to the photographing mode and back*  
16 *to the stored-image display mode the controller causes the display screen to first display a*  
17 *single image file that was most recently displayed before the mode-switching operation . . .*”  
18 (emphasis added). ‘893 patent, cl. 10 (Selwyn Decl., Ex. 2.)

19 Claim 12 is a dependent claim that depends on claim 10 and therefore incorporates all the  
20 limitations recited in claim 10. ‘893 patent, cl. 12 (Selwyn Decl., Ex. 2.) Apple’s expert Dr.  
21 Paul Dourish opined that the language of claim 10 emphasized above “indicates that user action  
22 is required by the claim.” *See* Expert Report of J. Paul Dourish Regarding Invalidity of the  
23 Asserted Claims of U.S. Patent No. 7,456,893 (“Dourish ‘893 Invalidity Report”), ¶¶ 203-204  
24 (Selwyn Decl., Ex. 10).<sup>6</sup>

25  
26  
27 <sup>6</sup> *See also* Declaration of Paul Dourish, dated May 16, 2012 (Selwyn Decl., Ex. 11).

1 [REDACTED]

2 [REDACTED]

3 [REDACTED]

4 [REDACTED]

5 [REDACTED]

6 **C. UNDISPUTED FACTS MATERIAL TO THE ‘460 PATENT**

7 Samsung asserts claim 1 of the ‘460 patent against Apple’s iPhone 3G, iPhone 3GS,  
8 iPhone 4, iPod Touch 4th generation, and iPad 2. *See* Yang Report ¶ 47 (Selwyn Decl., Ex. 9).

9 Claim 1 is reproduced below:

10 1. A data transmitting method for a portable composite communication terminal  
11 which functions as both a portable phone and a camera, comprising the steps of:

12 *entering a first E-mail transmission sub-mode* upon user request for E-mail  
13 transmission while operating in a portable phone mode, the first e-mail  
14 transmission sub-mode performing a portable phone function;

15 *entering a second E-mail transmission sub-mode* upon user request for Email  
16 transmission while operating in a display sub-mode, the second e-mail  
17 transmission sub-mode displaying an image most recently captured in a camera  
18 mode;

19 sequentially displaying other images stored in a memory through the use of scroll  
20 keys;

21 *transmitting* the address of the other party and a message received through a user  
22 interface in the first E-mail transmission sub-mode; and

23 *transmitting* the address of the other party and the message received through the  
24 user interface and the image displayed on the display as an E-mail in the second  
25 E-mail transmission sub-mode.

26 ‘460 patent, cl. 1 (emphases added) (Selwyn Decl., Ex. 3).

27 [REDACTED]

28 [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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Additionally, Samsung and its experts have advanced several different interpretations of claim 1 in this case. *See* Samsung’s Patent L.R. 3-1 Disclosures, Exhibit J at 3, 5, 9-10, 12 (Selwyn Decl., Ex. 15); Yang Report ¶¶ 43–46, 54 (Selwyn Decl., Ex. 9); May 8, 2012 Yang Rough Deposition Transcript (“5/8/12 Yang Dep.”) at 240:10-24 (Selwyn Decl., Ex. 16); Results from A Survey Measuring Use and Valuation of Four Patented Features (Patented Features: 460, 893, 711, 871) and A Survey of World Clock Patented Feature Usage (Patented Feature 055) (“Sukumar Report”), March 22, 2012, at 3 (Selwyn Decl., Ex. 17).

**III. ARGUMENT**

**A. SUMMARY JUDGMENT STANDARD**

Rule 56(c) of the Federal Rules of Civil Procedure authorizes summary judgment if there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986). The moving party bears the initial burden of demonstrating the basis for the motion and identifying the portions of the pleadings, depositions, answers to interrogatories, affidavits, and admissions on file that establish the absence of a triable issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). If the moving party meets this initial burden, the burden then shifts to the non-moving party to present specific facts showing that there is a genuine issue for trial. Fed. R. Civ.

1 P. 56(e); *Celotex*, 477 U.S. at 324; *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S.  
2 574, 586-87 (1986). The non-movant’s bare assertions, standing alone, are insufficient to create  
3 a material issue of fact and defeat a motion for summary judgment. *Anderson*, 477 U.S. at 247-  
4 48. An issue of fact is material if, under the substantive law of the case, resolution of the factual  
5 dispute might affect the case’s outcome. *Id.* at 248. Factual disputes are genuine if they  
6 “properly can be resolved in favor of either party.” *Id.* at 250. Thus, a genuine issue for trial  
7 exists if the non-movant presents evidence from which a reasonable jury, viewing the evidence  
8 in the light most favorable to that party, could resolve the material issue in its favor. *Id.*  
9 However, “[i]f the [non-movant’s] evidence is merely colorable, or is not significantly probative,  
10 summary judgment may be granted.” *Id.* at 249-50 (internal citations omitted).

11 **B. THE COURT SHOULD GRANT SUMMARY JUDGMENT OF NON-**  
12 **INFRINGEMENT OF THE ‘867 PATENT**

13 A determination of infringement requires the Court to compare the accused products to  
14 the limitations of the properly construed claims. *Biagro Western Sales, Inc. v. Grow More, Inc.*,  
15 423 F.3d 1296, 1301 (Fed. Cir. 2005) (citing *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448,  
16 1454 (Fed. Cir. 1998) (*en banc*)). If the accused products fail to satisfy even a single limitation  
17 of the claims, they do not infringe. *Hutchins v. Zoll Med. Corp.*, 492 F.3d 1377, 1380 (Fed. Cir.  
18 2007); *Biagro Western Sales*, 423 F.3d at 1301.

19 Here, the parties did not request the Court to interpret the limitations of the ‘867 patent.  
20 Claim 25 requires the generating of a “Gold code as a K<sup>th</sup> primary scrambling code.” The plain  
21 meaning of the claim requires that the scrambling code *be* a Gold code.<sup>7</sup>

---

22 <sup>7</sup> The plain meaning of the claims is confirmed by the specification. *See, e.g.*, ‘867 patent  
23 at 6:23-24 (“A gold code used herein as a scrambling code is generated through binary adding of  
24 two distinct m-sequences.”); 6:64-7:32; 10:40-48 (Selwyn Decl., Ex. 1). Likewise, the role of the  
25 Gold code as a scrambling code was emphasized during prosecution. For example, Samsung  
26 stated:

27 Regarding new [pending] Claim 59 [issued claim 25], new Claim  
28 59 recites, “an apparatus for generating scrambling codes in mobile  
communication system having a scrambling code generator”, “a  
first m-sequence generator to generate a first m-sequence”, and “a  
second m-sequence generator to generate a second m-sequence”.

1 [REDACTED]  
2 [REDACTED]  
3 [REDACTED]  
4 [REDACTED]  
5 [REDACTED]  
6 [REDACTED]  
7 [REDACTED]

8 Nor can Samsung salvage its infringement case under the doctrine of equivalents. “The  
9 doctrine of equivalents is not a talisman that entitles a patentee to a jury trial on the basis of  
10 suspicion; it is a limited remedy available in special circumstances, the evidence for which is the  
11 responsibility of the proponent.” *Schoell v. Regal Marine Industries Inc.*, 247 F.3d 1202, 1210  
12 (Fed. Cir. 2001). To make out a case of infringement under the doctrine of equivalents,

13 a patentee must...provide particularized testimony and linking  
14 argument as to the ‘insubstantiality of the differences’ between the  
15 claimed invention and the accused device or process, or with  
16 respect to the function, way, result test when such evidence is  
17 presented to support a finding of infringement under the doctrine  
of equivalents. Such evidence must be presented on a limitation-  
by-limitation basis. Generalized testimony as to the overall  
similarity between the claims and the accused infringer’s product  
or process will not suffice.

18 *Texas Instruments, Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1567 (Fed. Cir. 1996).  
19 This requirement is as true on summary judgment as at trial. *Network Commerce, Inc. v.*  
20 *Microsoft Corp.*, 422 F.3d 1353, 1363 (Fed. Cir. 2005).

21 [REDACTED]  
22 [REDACTED]

---

24 In this context, the description on page 7 discloses in lines 14 and  
25 15 that a Gold code used herein as a scrambling code is generated  
through binary adding of two distinct m-sequences.

26 April 28, 2006 response at 15 (emphasis added) (Selwyn Decl., Ex. 18). *See also* December 11,  
27 2006 response at 16 (Selwyn Decl., Ex. 19); September 13, 2007 appeal brief at 4, 20 (Selwyn  
Decl., Ex. 20).

1 Nor do Samsung's Infringement Contentions for the '867 patent (Selwyn Decl., Ex. 21)  
2 articulate a theory of infringement under the doctrine of equivalents. Therefore, the record is  
3 devoid of "particularized testimony and linking argument" supporting a doctrine of equivalents  
4 finding.

5 **C. THE COURT SHOULD GRANT SUMMARY JUDGMENT OF**  
6 **INVALIDITY OF THE '893 AND '460 PATENTS**

7 1. *The Definiteness Requirement of 35 U.S.C. § 112, ¶ 2*

8 A patent claim must "particularly point out and distinctly claim the subject matter which  
9 the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2. The determination of claim  
10 indefiniteness is a matter of law appropriate for summary judgment. *See, e.g., Athletic*  
11 *Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996) (affirming summary  
12 judgment of indefiniteness).

13 "[T]he purpose of [Section 112 ¶ 2's] definiteness requirement is to ensure that the claims  
14 delineate the scope of the invention using language that adequately notifies the public of the  
15 patentee's right to exclude." *Haemonetics Corp. v. Baxter Healthcare Corp.*, 607 F.3d 776, 783  
16 (Fed. Cir. 2010). A claim fails to meet this requirement "where a person of ordinary skill in the  
17 art could not determine the bounds of the claims, i.e. the claims [are] insolubly  
18 ambiguous." *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1249 (Fed. Cir.  
19 2008). A claim is insolubly ambiguous "where an accused infringer shows by clear and  
20 convincing evidence that a skilled artisan could not discern the boundaries of the claim based on  
21 the claim language, the specification, and the prosecution history, as well as her knowledge of  
22 the relevant art area." *Id.* at 1249-50; *see also Honeywell Int'l, Inc. v. Int'l Trade Comm'n*, 341  
23 F.3d 1332, 1340 (Fed. Cir. 2003) (affirming patent invalidation for indefiniteness because "the  
24 claims, the written description, and the prosecution history fail to give . . . any guidance as to  
25 what one of ordinary skill in the art would interpret the claim to require").

26 The Federal Circuit has recognized that one example of such an ambiguous claim is a  
27 claim that mixes different statutory classes of subject matter, e.g., method and apparatus. *See*  
28 *IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1383-84 (Fed. Cir. 2005); *see also In*

1 *re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1318 (Fed. Cir. 2011)  
2 (affirming district court’s holding that various claims were indefinite on *IPXL* grounds for  
3 including the claim language “interface means for providing automated voice messages . . . to  
4 certain of said individual callers, wherein said certain of said individual callers digitally enter  
5 data” in an apparatus claim); *Rembrandt Data Techs., LP v. AOL, LLC*, 641 F.3d 1331, 1338-39  
6 (Fed. Cir. 2011) (affirming district court’s grant of summary judgment on *IPXL* grounds; “This  
7 court has held that reciting both an apparatus and a method of using that apparatus renders a  
8 claim indefinite under section 112, paragraph 2.”).

9 2. *Claims 10 and 12 of the ‘893 Patent are Indefinite under 35 U.S.C. § 112,*  
10 ¶ 2

11 Asserted claims 10 and 12 of the ‘893 patent are invalid as indefinite under 35 U.S.C. §  
12 112, ¶ 2 because they are indisputably “mixed method-apparatus” claims, which the Federal  
13 Circuit found to be indefinite in *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377 (Fed.  
14 Cir. 2005). In *IPXL*, the claim at issue (claim 25) recited both an apparatus and a method for  
15 using the apparatus — a “system of claim 2 [including an input means] wherein the predicted  
16 transaction information comprises both a transaction type and transaction parameters associated  
17 with that transaction type, and *the user uses* the input means to either change the predicted  
18 transaction information or accept the displayed transaction type and transaction parameters.” *Id.*  
19 at 1384 (emphasis added). The Federal Circuit identified two independent reasons such claims  
20 are invalid. First, an accused infringer could not determine whether it infringes the claim when it  
21 made the system, or when a user used the system. *See id.* Second, a manufacturer of a system  
22 could not know whether it additionally may be liable for contributory infringement if a purchaser  
23 of the system later used the system. *Id.* In *IPXL*, the Federal Circuit further enunciated the  
24 rationale behind the rule and the unfairness to the public of mixed apparatus and method claims:

25 [I]t is unclear whether infringement of claim 25 occurs when one  
26 creates a system that allows the user to change the predicted  
27 transaction information or accept the displayed transaction, or  
28 whether infringement occurs when the user actually uses the input  
means to change transaction information or uses the input means to  
accept a displayed transaction. Because claim 25 recites both a  
system and the method for using that system, it does not apprise a

1 person of ordinary skill in the art of its scope, and it is invalid  
2 under section 112, paragraph 2.

3 *Id.*

4 More recently, the Federal Circuit again held that a system with an “interface means for  
5 providing automated voice messages . . . to certain of said individual callers, *wherein said*  
6 *certain of said individual callers digitally enter data*” impermissibly claimed both a system and  
7 a method, and was therefore invalid.<sup>8</sup> *In re Katz Interactive Call Processing Patent Litig.*, 639  
8 F.3d 1303, 1318 (Fed. Cir. 2011) (emphasis added). Applying its holding in *IPXL* to the claims,  
9 the Federal Circuit explained that “Katz’s claims. . . create confusion as to when direct  
10 infringement occurs because they are directed both to systems and to actions performed by  
11 ‘individual callers.’ Katz’s claims therefore fall squarely within the rationale of *IPXL* and are  
12 indefinite.” *Id.* at 1318.

13 Claims 10 and 12 of the ‘893 patent are invalid for the same reasons as the claims in  
14 *IPXL* and *Katz*. As shown below, [REDACTED], claim 10 is an  
15 apparatus claim that contains a method step that must be performed by the user of the apparatus.  
16 Independent claim 10 (and dependent claim 12) recites, among other things, “[a] digital image  
17 processing apparatus comprising: . . . a controller connected with the photoelectric conversion  
18 module, the recording medium and the display screen, the controller being operative in a

19 <sup>8</sup> In a few instances, courts in this district did not find claims invalid under the *IPXL* line of  
20 cases when the claim language recites a “functional” description of an apparatus claim element.  
21 *See, e.g., Datamize, LLC v. Plum-Tree Software, Inc.*, No. C 04-2777-VRW, 2007 U.S. Dist.  
22 LEXIS 97965, at \*29-\*35 (N.D. Cal. Aug. 7, 2007); *Yodlee, Inc. v. Cashedge, Inc.*, No. C 05-  
23 01550 SI, 2006 US Dist. LEXIS 86699, at \*6-19 (N.D. Cal. Nov. 29, 2006); *Collaboration*  
24 *Properties, Inc. v. Tandberg ASA*, No. C 05-01940, 2006 U.S. Dist. LEXIS 42465 (N.D. Cal.  
25 June 23, 2006). The Federal Circuit addressed this exact issue in *Katz*, where the plaintiff sought  
26 “to distinguish *IPXL* on the ground that the term ‘wherein’ does not signify a method step but  
27 instead defines a functional capability.” *In re Katz*, 639 F.3d at 1318. The Federal Circuit flatly  
28 rejected this argument and upheld the district court’s ruling: “Like the language used in the claim  
at issue in *IPXL* (‘wherein . . . the user uses’), the language used in *Katz*’s claims (‘wherein . . .  
callers digitally enter data’ and ‘wherein . . . callers provide . . . data’) is directed to user actions,  
not system capabilities.” *Id.* Claims 10 and 12 of the ‘893 patent, while including the offending  
language after the word “wherein,” bears close resemblance to the claims in *Katz* and *IPXL*—  
they require user actions of the apparatus; they do not merely recite functional capabilities of the  
claimed apparatus.

1 photographing mode to process the image data for storage in the recording medium and, in a  
2 stored-image display mode, being operative to control the display screen for displaying a single  
3 image relative to the image data, *wherein upon a user performing a mode-switching operation*  
4 *defined by switching from the stored-image display mode to the photographing mode and back*  
5 *to the stored-image display mode the controller causes the display screen to first display a*  
6 *single image file that was most recently displayed before the mode-switching operation . . .”*

7 ‘893 patent, cl. 10 (emphasis added) (Selwyn Decl., Ex. 2).

8 The claim language highlighted above shows that, just as in the claims found indefinite in  
9 *IPXL* and *Katz*, user action is required in the midst of this apparatus claim. See Dourish ’893  
10 Invalidation Report ¶ 204 (Selwyn Decl., Ex. 10). [REDACTED]

11 [REDACTED]

12 [REDACTED]

13 [REDACTED]

14 [REDACTED]

15 [REDACTED]

16 [REDACTED]

17 [REDACTED]

18 [REDACTED]

19 [REDACTED]

20 [REDACTED]

21 [REDACTED]

22 [REDACTED] As a result, the claims are indefinite under *IPXL* and *Katz*. It is unclear whether  
23 infringement of claims 10 and 12 occurs when one creates an apparatus that allows the user to  
24 switch from the stored-image display mode to the photographing mode and back to the stored-  
25 image display mode, or whether infringement occurs when the user actually switches from the  
26 stored-image display mode to the photographing mode and back to the stored-image display  
27 mode. See Dourish ’893 Invalidation Report ¶ 204 (Selwyn Decl., Ex. 10).

1 Accordingly, independent claim 10 and dependent claim 12 are invalid under §112, ¶ 2,  
2 because the claims improperly do not apprise a person of ordinary skill in the art of their scope.

3 3. *Claim 1 of the '460 Patent Is Indefinite Under 35 U.S.C. § 112, ¶ 2*

4 **a. The language of claim 1 is insolubly ambiguous**

5 As quoted above, claim 1 of the '460 patent recites a data transmitting method, which  
6 includes (among other things) “entering a first E-mail transmission sub-mode”; “entering a  
7 second E-mail transmission sub-mode”; “transmitting the address of the other party and a  
8 message received through a user interface in the first E-mail transmission sub-mode”; and  
9 “transmitting the address of the other party and the message received through the user interface  
10 and the image displayed on the display as an E-mail in the second E-mail transmission sub-  
11 mode.” *See supra* Part II.C. Based on the plain language of the claim, a person of ordinary skill  
12 in the art would not be able to determine whether the claimed method is practiced by: (1) sending  
13 *two separate email messages* from two separate email transmission sub-modes; (2) sending one  
14 email message from the “first E-mail transmission sub-mode” *if* the E-mail does not have an  
15 image attachment and sending one email message from the “second E-mail transmission sub-  
16 mode” *if* the email has an image attachment; or (3) sending one email message from the “second  
17 E-mail transmission sub-mode” only, whereby the email is created by transmitting the address of  
18 the other party and a message received through a user interface in the “first E-mail transmission  
19 sub-mode” to the “second E-mail transmission sub-mode.” *See* Expert Report of Mani  
20 Srivastava, Ph.D., Regarding Invalidity of the Asserted Claim of U.S. Patent No. 7,577,460  
21 (“Srivastava Report”) ¶¶ 333-336 (Selwyn Decl., Ex. 22).<sup>9</sup> Because claim 1 is thus insolubly  
22 ambiguous to a person of ordinary skill in the art, the Court should find it invalid as indefinite.

23 **b. The specification adds no clarity to the meaning of claim 1**

24 The specification provides no guidance as to how one of ordinary skill in the art would  
25 interpret the confusing claim language. In fact, while claim 1 recites two distinct “E-mail  
26

27 <sup>9</sup> *See also* Declaration of Mani Srivastava, dated May 16, 2012 (Selwyn Decl., Ex. 23).

1 transmission sub-mode[s],” the specification only describes *one* “E-mail transmission sub-  
2 mode.” *See* Srivastava Report ¶ 338 (Selwyn Decl., Ex. 22). The specification states that  
3 “[u]pon request for E-mail transmission in the portable phone mode in step 608, the portable  
4 phone controller 32 enters *an* E-mail transmission sub-mode in **step 610.**” ‘460 patent at 9:42-  
5 44 & Fig. 6 (emphases added) (Selwyn Decl., Ex. 3). In the context of discussing the “play  
6 mode,” the specification continues that “[u]pon user request for *the* E-mail transmission, the  
7 portable controller 32 returns to *the* E-mail transmission sub-mode in **step 610.**” *Id.* at 11:4-12  
8 & Fig. 8 (emphases added). Moreover, Figures 6 and 8, which illustrate the portable phone  
9 mode and the play mode, respectively, both use the same reference number, Email transmission  
10 sub-mode **610**, to refer to the single E-mail transmission sub-mode. *Id.*, Figs. 6 & 8. The figures  
11 and text of the specification do not identify any other email transmission sub-mode. *See*  
12 *generally id.* Because the specification does not even disclose the claimed “second E-mail  
13 transmission sub-mode,” it provides no information regarding how this sub-mode might function  
14 in conjunction with a “first E-mail transmission sub-mode” in the claimed method. Therefore,  
15 the specification only serves to compound the ambiguity of claim 1.

16 **c. The prosecution history sheds no light on claim 1’s meaning**

17 The prosecution history likewise provides no guidance as to what one of ordinary skill in  
18 the art would interpret the claim language to require. The ‘460 patent was allowed in a first  
19 action without any substantive prosecution. *See* ‘460 file history, 4/6/09 Notice of Allowability  
20 (Selwyn Decl., Ex. 24). The examiner’s reasons for allowance state simply that “the prior art of  
21 record in combination or alone fails to teach these elements of claim 1 in combination with other  
22 elements.” The examiner’s reasons for allowance then quote the limitations of claim 1 verbatim.  
23 *See id.* at 2.

24 The claim that eventually became claim 1 of the ‘460 patent was originally filed as claim  
25 20 in Application No. 09/540,830, which issued as U.S. Patent No. 7,139,014. All amendments,  
26 claim rejections, and arguments relating to the ‘460 patent were made in prosecution of the  
27 parent ‘014 patent. After original claim 20 was withdrawn from consideration in the parent case  
28

1 and the divisional child application was filed that eventually issued as the '460 patent, there were  
2 no further amendments, claim rejections, or arguments relevant to what became claim 1 of the  
3 '460 patent.

4 The prosecution of the parent '014 patent likewise provides no guidance as to how one of  
5 ordinary skill in the art would interpret claim 1. During prosecution of the parent '014 patent,  
6 the applicants amended the claim to add the step of “sequentially displaying other images stored  
7 in a memory through the use of scroll keys” to overcome prior art. *See* '014 file history,  
8 11/14/02 Amendment in Response to Office Action at 4, 6–7, 10 (Selwyn Decl., Ex. 25). The  
9 applicants also amended the claim language “the second e-mail transmission sub-mode  
10 displaying an image captured in a camera mode” to add “most recently” before “captured.” *Id.*  
11 As with the rest of the prosecution history, neither of these amendments sheds light on the  
12 meaning of the “first” and “second” E-mail transmissions sub-mode portions of claim 1.

13 **d.** [REDACTED]

14 [REDACTED]

15 [REDACTED]

16 [REDACTED]

17 [REDACTED]

18 [REDACTED]

19 [REDACTED]

20 [REDACTED]

21 [REDACTED]

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[REDACTED]

**e. Samsung and its experts have advanced multiple conflicting interpretations of claim 1**

The insoluble ambiguity of claim 1 is underscored by the fact that even Samsung and its experts cannot agree on what the claim requires. Samsung has advanced multiple conflicting interpretations based on (1) its Patent Local Rule 3-1 disclosures, (2) Samsung expert Dr. Yang’s report and deposition testimony, and (3) Samsung expert Dr. Sukumar’s report.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[REDACTED]

For the reasons discussed above, claim 1 of the '460 patent is insolubly ambiguous. The specification and prosecution history provide no guidance as to how one of ordinary skill in the art would interpret the confusing claim language. [REDACTED]

[REDACTED] Finally, Samsung and its experts have asserted three different, conflicting interpretations of claim 1 in this litigation. All of this serves to underscore the insoluble ambiguity of claim 1. Accordingly, the Court should find claim 1 of the '460 patent invalid as indefinite.

1 **IV. CONCLUSION**

2 For the foregoing reasons, Apple respectfully requests that the Court grant its motion for  
3 summary judgment of non-infringement of the '867 patent, and for summary judgment of  
4 invalidity of claims 10 and 12 of the '893 patent and claim 1 of the '460 patent.

5 Dated: May 17, 2012

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1 **CERTIFICATE OF SERVICE**

2

3 The undersigned hereby certifies that a true and correct copy of the above and foregoing

4 document has been served on May 17, 2012, to all counsel of record who are deemed to have

5 consented to electronic service via the Court's CM/ECF system per Civil Local Rule 5.4. Any

6 other counsel of record will be served by electronic mail, facsimile and/or overnight delivery.

7

8 /s/ Mark. D Selwyn

9 Mark D. Selwyn

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